

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC. and NOKIA OF AMERICA CORPORATION,
Petitioner,

v.

XR COMMUNICATIONS LLC,
Patent Owner.

IPR2024-00314
Patent 7,177,369 B2

Before BARBARA A. PARVIS, JAMES J. MAYBERRY, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Request to File a Reply
to Patent Owner's Preliminary Response
37 C.F.R. § 42.108

I. BACKGROUND

Ericsson Inc. and Nokia of America Corporation (collectively “Petitioner”) filed a Petition challenging claims in U.S. Patent No. 7,177,369 B2 (the “’369 patent”). Paper 3. XR Communications LLC (“Patent Owner”) filed a Preliminary Response. Paper 7. Petitioner requests leave to file a Preliminary Reply to Patent Owner’s Preliminary Response. A conference call was conducted between the panel and counsel for Petitioner and Patent Owner on May 1, 2024.

II. DISCUSSION

“A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause.” 37 C.F.R. 42.108(c) (2023). Petitioner specifically requests a Reply to address Patent Owner’s proposed construction of the term “pre-equalization parameter,” and to explain how the prior art of record discloses the pre-equalization parameter even under Patent Owner’s proposed construction.

Petitioner argues that good cause exists for a Reply, as Petitioner could not have anticipated at the time the Petition was filed that Patent Owner would propose its construction for the term “pre-equalization parameter.” Petitioner explains that Patent Owner relies on an isolated passage in the Specification of the ’369 patent for its construction. Petitioner adds that the “modifying” step of independent claim 1 provides the necessary context for the construction of the term “pre-equalization parameter.”

Petitioner also argues that, although expressed in different language, that Wong (Ex. 1005) performs the same steps are described in the

'369 patent of pre-equalization, such that Wong discloses a pre-equalization parameter even under Patent Owner's construction. Petitioner argues that providing an explanation in the Reply of Wong's disclosure would help the panel in determining if institution is appropriate.

Patent Owner argues that good cause does not exist for a Reply. Patent Owner argues that, given the subject matter of the '369 patent and the express disclosure upon which Patent Owner relies directed to the term "pre-equalization parameter," Petitioner should have anticipated Patent Owner's argument. Patent Owner adds that Petitioner's declarant's testimony also demonstrates that Petitioner should have anticipated Patent Owner's construction.

We determine that Petitioner has demonstrated that good cause exists for a Preliminary Reply. We agree with Petitioner that Patent Owner's proposed construction could not have been foreseen at the time the Petition was filed. We find, on the limited record before us, that the language of the "modifying" step provides proper context for the construction of the term "pre-equalization parameter," and it is unclear how the claim language relates to Patent Owner's proposed construction.

Accordingly, we authorize Petitioner to file a Preliminary Reply to address the propriety of Patent Owner's claim construction of the term "pre-equalization parameter." Based on Petitioner's explanation during the call, the remainder of Petitioner's request is too expansive because Petitioner's request is not limited to discussing Wong's teachings in connection with just Patent Owner's proposed construction. We, therefore, do not authorize any discussion in the Reply directed to how the prior art satisfies the claim language under Patent Owner's construction.

We also authorize Patent Owner to file a Preliminary Sur-reply to respond to Petitioner's arguments.

III. ORDER

Accordingly, it is:

ORDERED that Petitioner is authorized to file a Preliminary Reply to Patent Owner's Preliminary Response, limited to addressing Patent Owner's claim construction of the term "pre-equalization parameter," and limited to five (5) pages and due on May 8, 2024; and

FURTHER ORDERED that Patent Owner is authorized to file a Preliminary Sur-reply in response to the Preliminary Reply, limited to five (5) pages and due five (5) business days after the Preliminary Reply is filed.

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