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To: [Holt, Benjamin](#); [Trials](#)
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Subject: RE: IPR2024-00338 – Qualcomm Inc. v. Network System Technologies, LLC
Date: Tuesday, February 11, 2025 1:57:52 PM

Good afternoon counsel,

From the Board –

In response to the February 7, 2025, email from Patent Owner’s counsel, the Board authorizes Patent Owner to file a motion to strike the allegedly new obviousness theories identified in that email. The motion must not exceed five pages and must be filed within five business days of the date of this email. The Board also authorizes Petitioner to file an opposition to the motion. The opposition must not exceed five pages and must be filed within ten business days of the date of this email. The Board does not at this time authorize a reply to the opposition.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Holt, Benjamin <bholt@nixonpeabody.com>
Sent: Friday, February 7, 2025 5:37 PM
To: Trials <Trials@USPTO.GOV>
Cc: Christopher, Angelo <achristopher@nixonpeabody.com>; Hayes, Jennifer <jenhayes@nixonpeabody.com>; Stringfield, Daniel <dstringfield@nixonpeabody.com>; Krusiewicz, Peter <pkrusiewicz@nixonpeabody.com>; Girgis, Diana <dgirgis@nixonpeabody.com>; Derek Vandenburg <DVandenburg@carlsoncaspers.com>; Peter M Kohlhepp <PKohlhepp@carlsoncaspers.com>; Ryan Rypka <RRypka@carlsoncaspers.com>; Nate D Louwagie <NLouwagie@carlsoncaspers.com>; Aaron W. Pederson <APederson@carlsoncaspers.com>; skruse@carlsoncaspers.com
Subject: IPR2024-00338 – Qualcomm Inc. v. Network System Technologies, LLC

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Your Honors,

Patent Owner respectfully requests authorization to file a motion to strike or, in the alternative, to file a supplemental expert declaration with its Sur-Reply to respond to new theories that were improperly asserted for the first time in Petitioner’s Reply (Paper 43) and in Petitioner’s expert’s reply declaration (EX1043). *See, e.g.,* PTAB Consolidated Trial Practice Guide (Nov. 2019) at 73-74; *Peloton Interactive, Inc. v. NEC Corp.*, IPR2023-01239, Paper 27 (PTAB Sept. 13, 2024) (granting authorization to file declaration with sur-reply).

Patent Owner contends that the following improper new theories in the Reply and corresponding expert declaration warrant a motion to strike and/or a supplemental expert declaration to allow Patent Owner to respond:

- New obviousness theories relating to the claimed “first module,” including disavowing any reliance on Drake for the “first module” and associating Drake’s application 11 (instead of source station 10) with the “first module.” *E.g.*, Reply at 3-4, 15-17, 21; *compare with* IPR2024-01081, Paper 14 (Institution Decision) at 23-24) (finding that Petitioner consistently identifies Drake’s source station 10, not application 11, as the “first module”).
- New obviousness theories relating to “interfacing” or “network interface,” including (i) a new interpretation of Drake as having a network interface that includes Drake’s QoS requestor manager 12 as a network interfacing component, (ii) a new theory regarding how the primary references (Goossens2002 and Goossens2003) and Drake would allegedly be combined, i.e., that Drake’s QoS requestor manager 12 would be incorporated into a network interface in Goossens2002/Goossens2003, and (iii) a new theory regarding “interfac[ing]” as a motivation to combine, i.e., to incorporate Drake’s QoS requestor manager 12 into Goossens2002/Goossens2003. *E.g.*, Reply at 9-15; *compare with* Petition (never mentioning “network interface” or “interfacing” in relation to Drake or its QoS requestor manager 12).

The Parties have conferred regarding the requested relief, and Petitioner has indicated that it opposes Patent Owner’s request. If the Board authorizes Patent Owner to submit a supplemental declaration, Patent Owner would not oppose a request from Petitioner for a 3-page Sur-Sur-Reply, along with cross-examination of Patent Owner’s supplemental declarant, but would oppose the submission of any further supplemental evidence by Petitioner.

* * * * *

Petitioner’s position:

Petitioner opposes both requests, and Petitioner does not believe there is good cause for a supplemental declaration. Petitioner’s reply does not present new theories. For example, as to the claimed “first module,” both the Petition and the Reply identify the Goossens references as disclosing a first module, and further Petitioner and Dr. Mowry have consistently identified the application 11 within Drake’s source station as the thing that actually makes the QoS request. And as to “interfacing,” for example, Patent Owner argued that a portion of Drake’s QoS management system would be “redundant” if implemented in the Goossens references; Petitioner’s reply merely explains that one reason it would not have been expected to be redundant.

In the event the Board were to authorize briefing on a motion to strike and/or Patent Owner’s request for a supplemental declaration, Petitioner would request an opportunity to respond with a brief of equivalent length.

Also, if the Board were inclined to allow a supplemental declaration, Petitioner would request an opportunity to depose Patent Owner’s expert regarding such declaration and prepare and file a responsive brief, including with evidence as appropriate.

* * * * *

The parties are available for a call with the Board next week at the following dates and times (ET):

- Monday (2/10) at 4-5pm
- Wednesday (2/12) at 1-4:30pm
- Thursday (2/13) after 10:30am
- Friday (2/14) before 4pm

Respectfully submitted,

Benjamin Holt
Counsel for Patent Owner

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