

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED*
Petitioner

v.

NETWORK SYSTEM TECHNOLOGIES, LLC
Patent Owner

Patent No. 7,373,449

Inter Partes Review No. IPR2024-00338

**PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW OF THE
FINAL WRITTEN DECISION**

* Qualcomm Incorporated filed a petition and a motion for joinder in IPR2024-01081 and was joined as a petitioner in this proceeding.

LISTING OF EXHIBITS

Exhibit No.	Description
2001	WITHDRAWN
2002	<i>Curriculum vitae</i> of Dr. Erik Chmelar
2003	Neil Weste & David Harris, CMOS VLSI DESIGN: A CIRCUIT AND SYSTEMS PERSPECTIVE (4th ed. 2010)
2004	Jan Rabaey, Anantha Chandrakasan & Borivoje Nikolic, DIGITAL INTEGRATED CIRCUITS: A DESIGN PERSPECTIVE (2nd ed. 2003)
2005	William J. Dally & Brian Towles, <i>Route Packets, Not Wires: On-Chip Interconnection Networks</i> , PROC. 38TH DESIGN AUTOMATION CONF. (2001)
2006	John F. Wakerly, DIGITAL DESIGN: PRINCIPLES AND PRACTICES (4th ed. 2005)
2007	Fayez Gebali, Haytham Elmiligi & Mohamed Watheq El-Kharashi, NETWORKS-ON-CHIPS: THEORY AND PRACTICE (2009)
2008	Kurt Shuler, <i>Busses, Crossbars and NoCs: The 3 Eras of SoC Interconnect History</i> , ARTERISIP (Oct. 22, 2010), https://www.arteris.com/blog/busses-crossbars-and-nocs-the-3-eras-of-soc-interconnect-history/
2009	Kurt Shuler, <i>The SoC Interconnect Fabric: A Brief History</i> , ARTERISIP (Aug. 6, 2013), https://www.arteris.com/blog/the-soc-interconnect-fabric-a-brief-history/
2010	William Stallings, DATA & COMPUTER COMMUNICATIONS (6th ed. 1999)
2011	RESERVED
2012	United States District Courts — National Judicial Caseload Profile
2013-2020	RESERVED
2021	Order Resetting Jury Trial, <i>Network System Technologies, LLC v. Texas Instruments Incorporated</i> , Civil Action No. 2:22-cv-00482-

Exhibit No.	Description
	RWS (E.D. Tex.), Dkt. 182 (Mar. 18, 2024)
2022	Claim Construction Order, <i>Network System Technologies, LLC v. Texas Instruments Incorporated</i> , Civil Action No. 2:22-cv-00482-RWS (E.D. Tex.), Dkt. 150 (Jan. 3, 2024)
2023-2027	RESERVED
2028	Docket Control Order, <i>Network System Technologies, LLC v. Samsung Electronics Co., Ltd. et al.</i> , Civil Action No. 2:22-cv-00481-JRG (E.D. Tex.), Dkt. 59 (Jun. 16, 2023)
2029	Samsung's First Amended Answer and Counterclaims, <i>Network System Technologies, LLC v. Samsung Electronics Co., Ltd. et al.</i> , Civil Action No. 2:22-cv-00481-JRG (E.D. Tex.), Dkt. 96 (Jan. 24, 2024) (Public Version)
2030	Samsung's P.R. 4-1 Identification of Proposed Terms and Claim Elements for Construction, <i>Network System Technologies, LLC v. Samsung Electronics Co., Ltd.</i> , Civil Action No. 2:22-cv-00482-RWS (E.D. Tex.) (Nov. 28, 2023)
2031	Samsung's Amended P.R. 4-1 Identification of Proposed Terms and Claim Elements for Construction, <i>Network System Technologies, LLC v. Samsung Electronics Co., Ltd.</i> , Civil Action No. 2:22-cv-00482-RWS (E.D. Tex.) (Dec. 18, 2023)
2032	Samsung's Preliminary Claim Construction and Extrinsic Evidence Pursuant to Local Patent Rule 4-2, <i>Network System Technologies, LLC v. Samsung Electronics Co., Ltd.</i> , Civil Action No. 2:22-cv-00482-RWS (E.D. Tex.) (Dec. 19, 2023)
2033	P.R. 4-3 Claim Construction and Prehearing Statement, <i>Network System Technologies, LLC v. Samsung Electronics Co., Ltd.</i> , Civil Action No. 2:22-cv-00482-RWS (E.D. Tex.), Dkt. 91 (Jan. 9, 2024)
2034	Plaintiff Network System Technologies, LLC's Opening Claim Construction Brief, <i>Network System Technologies, LLC v. Samsung Electronics Co., Ltd.</i> , Civil Action No. 2:22-cv-00482-RWS (E.D. Tex.), Dkt. 100 (Feb. 20, 2024)

Exhibit No.	Description
2035	Defendant Samsung Electronics Co., Ltd.'s Responsive Claim Construction Brief, <i>Network System Technologies, LLC v. Samsung Electronics Co., Ltd.</i> , Civil Action No. 2:22-cv-00482-RWS (E.D. Tex.), Dkt. 112 (March 12, 2024)
2036	Plaintiff Network System Technologies, LLC's Reply Construction Brief, <i>Network System Technologies, LLC v. Samsung Electronics Co., Ltd.</i> , Civil Action No. 2:22-cv-00482-RWS (E.D. Tex.), Dkt. 116 (March 19, 2024)
2037	RESERVED
2039	Second Amended Scheduling Order, <i>Network System Technologies, LLC v. Qualcomm Incorporated et al.</i> , Civil Action No. 1:22-cv-1331-DAE (W.D. Tex.) Dkt. 80 (Oct. 23, 2023)
2040	Defendants' Joint Opening Claim Construction Brief, <i>Network System Technologies, LLC v. Qualcomm Incorporated et al.</i> , Civil Action No. 1:22-cv-1331-DAE (W.D. Tex.), Dkt. 77 (Oct. 12, 2023)
2041	Plaintiff Network System Technologies, LLC's Responsive Claim Construction Brief, <i>Network System Technologies, LLC v. Qualcomm Incorporated et al.</i> , Civil Action No. 1:22-cv-1331-DAE (W.D. Tex.), Dkt. 81 (Nov. 16, 2023)
2042	Defendants' Joint Reply Claim Construction Brief, <i>Network System Technologies, LLC v. Qualcomm Incorporated et al.</i> , Civil Action No. 1:22-cv-1331-DAE (W.D. Tex.), Dkt. 83 (Nov. 30, 2023)
2043	Plaintiff Network System Technologies, LLC's Sur-Reply Claim Construction Brief, <i>Network System Technologies, LLC v. Qualcomm Incorporated et al.</i> , Civil Action No. 1:22-cv-1331-DAE (W.D. Tex.), Dkt. 86 (Dec. 14, 2023)
2044	Defendants' Supplemental Claim Construction Brief, <i>Network System Technologies, LLC v. Qualcomm Incorporated et al.</i> , Civil Action No. 1:22-cv-1331-DAE (W.D. Tex.), Dkt. 105 (Mar. 1, 2024)

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2045	Plaintiff Network System Technologies, LLC’s Supplemental Claim Construction Brief, <i>Network System Technologies, LLC v. Qualcomm Incorporated et al.</i> , Civil Action No. 1:22-cv-1331-DAE (W.D. Tex.), Dkt. 106 (Mar. 1, 2024)
2046	Defendants’ Supplemental Invalidity Contention Cover Pleading, <i>Network System Technologies, LLC v. Qualcomm Incorporated et al.</i> , Civil Action No. 1:22-cv-1331-DAE (W.D. Tex.) (Jan. 23, 2024)
2047-2049	RESERVED
2050	Defendants’ Invalidity and Ineligibility Contentions And Disclosures Pursuant to Patent Rule 3-3 Cover Pleading, <i>Network System Technologies, LLC v. Samsung Electronics Co., Ltd., et al.</i> , Civil Action No. 2:22-cv-00481-JRG (E.D. Tex.) (July 11, 2023)
2051-2061	RESERVED
2062	Statutory Disclaimer dated March 25, 2024
2063-2064	RESERVED
2065	Terms & Disclosures for Use of IEEE Websites (https://www.ieee.org/about/help/site-terms-conditions.html) (last accessed Sept. 20, 2024)
2066	RESERVED
2067	Transcript of Aug. 27, 2024 Deposition of Dr. Nikil Dutt in IPR2024-00343
2068	2014 Design, Automation and Test in Europe Conference (“DATE”) Website Main Page
2069	H. Nejatollahi et al., “Software and Hardware Implementation of Lattice-based Cryptography Schemes,” Center for Embedded and Cyber-Physical Systems (2017)
2070	Declaration of Dr. Nader Bagherzadeh

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2071	<i>Curriculum vitae</i> of Dr. Nader Bagherzadeh
2072	A survey of Research and Practices of Network on Chip
2073	Routing Algorithms for On Chip Networks
2074	McGraw Hill Dictionary
2075	IEEE Dictionary
2076	Supported Token-Ring Functions – IBM Documentation
2077	Token Ring Solutions
2078	Transcript of Nov. 4, 2024 Deposition of Dr. Todd Mowry
2079	Transcript of Nov. 15, 2024 Deposition of Sean O’Bryan
2080	Transcript of Sept. 20, 2024 Deposition of Gordon MacPherson
2081	IEEE - Terms & Disclosures for Use of IEEE Websites
2082	IEEE XPlore Metrics (Radulescu)
2083	IEEE Xplore Metrics (Goossens2002)
2084	<i>Markman</i> Hearing Transcript, <i>Network System Technologies, LLC v. Samsung Electronics Co., Ltd.</i> , Civil Action No. 2:22-cv-00481-JRG (E.D. Tex.) (Apr. 9, 2024)
2085	Declaration of Peter Krusiewicz
2086	Declaration of Peter Krusiewicz in Support of <i>Pro Hac Vice</i> Motion
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2088	Transcript of Feb. 11, 2025 Deposition of Dr. Todd Mowry
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37 C.F.R. § 42.75 1, 5

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Pursuant to 37 C.F.R. § 42.75, Patent Owner Network System Technologies, LLC (“PO”) respectfully requests Director Review of the Board’s Final Written Decision (Paper 69, “FWD”) on U.S. Patent No. 7,373,449 (EX1001, “’449 patent”).

I. INTRODUCTION

Director Review is required here to address important issues of law or policy, namely whether *all* petitions—whether accompanied by a request for joinder under § 315(c) or not—are subject to the one-year time bar of § 315(b). The plain language of the statute answers this question in the affirmative, barring any and all petitions “filed more than 1 year after the date on which the petitioner ... is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b).

However, the FWD, and the underlying orders it relies upon, found otherwise, misreading § 315(b)’s provision about “request[s] for joinder” as applying to untimely petitions accompanied by a joinder request. Not so. The statute makes clear that joinder under § 315(c) requires a “properly file[d],” i.e., *timely*, petition.

Here, Petitioner Qualcomm Inc. (“Qualcomm”) could have timely filed a petition challenging the ’449 patent before its December 23, 2023 statutory deadline under § 315(b). Indeed, another party facing allegations of infringement by PO, Samsung Electronics Co., Ltd. (“Samsung”), did so on December 18, 2023. Paper 2¹

¹ Paper and Exhibit citations refer to IPR2024-00338 unless otherwise indicated.

(“Samsung Petition”). Qualcomm was plainly aware of Samsung’s IPR activity, including the Samsung Petition, because Qualcomm joined Samsung as co-petitioner of two other IPR petitions filed two days later. And yet, for this IPR, Qualcomm affirmatively declined to either join the Samsung Petition as a co-petitioner or file its own petition before its December 23, 2023 statutory deadline.

The effort for Qualcomm to meet the statutory deadline would have been miniscule; indeed, its (belated) petition was nothing more than an admitted “copycat” of the Samsung Petition. IPR2024-01081, Paper 10 at 5; IPR2024-01081, Paper 1 (“Qualcomm’s [Petition or Pet.]”) at 1. Qualcomm’s fatal mistake is that it withheld its copycat petition until nearly six months after its statutory deadline. According to the plain language of § 315(b), Qualcomm’s Petition was time-barred.

However, the Board’s misapplication of § 315(b), for which PO respectfully requests Director Review, led to institution of Qualcomm’s Petition well beyond the statutory time bar, prejudicing PO and undermining the intent behind the time bar, which includes limiting duplicative litigation and giving courts and patentees repose.

Compounding the error of institution, once (improperly) joined to this IPR, Qualcomm was permitted to belatedly present a new obviousness theory in its Reply to explain how the asserted prior art references were purportedly combined.

Therefore, the FWD, and the underlying orders it relies upon, erred in permitting institution and joinder and allowance of an improper new Reply theory.

II. FACTUAL AND PROCEDURAL BACKGROUND

A. Qualcomm's Time-Barred Petition

Samsung and Qualcomm were served with complaints alleging infringement of the '449 patent on December 22 and 23, 2022, respectively. *Network Sys. Tech., LLC v. Samsung Elecs. Co., Ltd. et al.*, 2:22-cv-00481-JRG, Dkts. 1, 3 (E.D. Tex.); *Network Sys. Tech., LLC v. Qualcomm Inc. et al.*, 1:22-cv-01331-DAE, Dkts. 1, 10 (W.D. Tex.) (“Qualcomm Case”). The Samsung Petition initiating this IPR was filed on December 18, 2023. Qualcomm did not join Samsung as co-petitioner at that time despite joining Samsung as co-petitioner in other IPRs filed two days later. *Qualcomm Inc. et al. v. Network Sys. Techs., LLC*, Nos. IPR2024-00343, -00355.

Samsung and PO settled their disputes and moved to terminate this IPR (Paper 14). On June 21, 2024—after learning of the settlement and nearly 1.5 years after being served in the Qualcomm Case—Qualcomm filed its own petition and moved to join this IPR. Qualcomm's Pet.; IPR2024-01081, Paper 3 (“Joinder Motion”).

PO opposed both institution of Qualcomm's Petition and granting of Qualcomm's Joinder Motion, arguing, *inter alia*, that Qualcomm's Petition was time-barred and not properly filed under 35 U.S.C. § 315(b)-(c). IPR2024-01081, Paper 9 (“POPR”) at 3; IPR2024-01081, Paper 7 (“PO Resp. to Joinder Mot.”) at 1-3, 5, 14-15. The Board rejected PO's arguments. Paper 16 (“Qualcomm [Decision or Dec.]”) at 15-17. PO's Response reasserted that Qualcomm's Petition and Joinder

Motion should have been denied. Paper 35 (“POR”) at 68. Qualcomm’s Reply merely pointed to the Board’s Qualcomm Decision. Paper 43 (“Reply”) at 28.

The FWD decided that “[f]or the reasons explained in” the Qualcomm Decision, “§ 315(b)’s one-year time bar does not preclude [Qualcomm] from participating in this proceeding.” FWD 157-58 (citing Qualcomm Dec. 16-17).

B. Qualcomm’s New Reply Theory of Obviousness

The challenged claims recite a “communication manager” (“[CM]”) and its relationship with other claimed components. *See* ’449 patent at claims 2, 6, 10. For this element, Qualcomm’s Petition relies on a secondary reference, Drake, and its QoS requestor manager 12 (“QoS-12”), arguing that it would have been obvious to implement QoS-12 in either primary reference, Goossens2002 or Goossens2003 (herein, collectively or individually as “Goossens”). Qualcomm’s Pet. 17, 35-38, 40-42, 52, 63, 65-66. Qualcomm’s Petition failed to explain how Drake’s QoS-12 would be implemented with respect to Goossens’ existing, relied-upon components and functions—particularly *where* QoS-12 would be implemented in Goossens relative to Goossens’ IP, network interface (“NI”), or NoC. *See id.*; Paper 53 (“MTS”) at 3; Paper 55 (“POSR”) at 5, 13; EX2089 at 5, 13. Qualcomm’s Reply argued for the first time that Drake’s QoS-12 would have been implemented *in Goossens’ NI*, and the FWD repeatedly relied on this new Reply theory. *See* Reply 9-15; MTS 3-5; POSR 5-6; FWD 84-89, 92-93.

The Board—in an order denying PO’s motion to strike and again in the FWD—held that Qualcomm’s new Reply theory was not required in Qualcomm’s Petition. FWD 82-83; Paper 64 (“MTS Order”) at 24-25; *see also* Paper 68 at 19.

III. LEGAL STANDARD

Director Review under 37 C.F.R. § 42.75 may be warranted when a final written decision includes: “(a) an abuse of discretion, (b) important issues of law or policy, ... or (d) erroneous conclusions of law.” Director Review Process, § 2.B.

IV. ARGUMENT

A. The Board Erred in Instituting Qualcomm’s Time-Barred Petition and Joining Qualcomm to This IPR

The Director should review and reverse the FWD’s erroneous conclusion of law that Qualcomm’s Petition was not time-barred.

1. Qualcomm’s Petition Was Time-Barred and Should Have Been Denied Institution

Qualcomm’s Petition was time-barred under § 315(b) and should not have been instituted. POR 68; PO Resp. to Joinder Mot. 5, 14-15; POPR 3. Section 315(b) bars a petition “filed more than 1 year after the date on which the petitioner ... is served with a complaint alleging infringement of the patent,” and Qualcomm’s Petition was undisputedly filed after this one-year time bar. *See* Section II.A *supra*.

Although the second sentence of § 315(b) provides that this one-year time bar “shall not apply to a *request for joinder* under [§ 315(c)]” (emphasis added), that second sentence does not apply to petitions. Requests for joinder are separate and

distinct from petitions. Indeed, the statute’s plain language distinguishes between a “petition” and “request for joinder.” § 315(b); § 315(c). What’s more, the Board’s own rules recognize the distinction between a “request for joinder,” which “must be filed[] as a motion,” and a “petition.” 37 C.F.R. § 42.122(b). Indeed, Qualcomm’s Petition and its Joinder Motion are separate papers, and the Board separately granted each. Qualcomm Dec. 1 (Title), 2, 14-28, 38-49, 50; *see Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020) (“[T]he joinder decision is a separate and subsequent decision to the intuition decision.”).

The first and second sentences in § 315(b) have separate and distinct applications according to their plain statutory text: the first sentence applies to a “petition” and the second to a “request for joinder.” Thus, while the second sentence in § 315(b) clarifies that “request[s] for joinder” are not subject to the first sentence’s time limitation for “petition[s],” it critically says nothing about exempting petitions accompanied by joinder requests. This purposeful omission of language underscores the distinction between petitions and requests for joinder, as discussed above, and the distinct time limits for each. *Russello v. United States*, 464 U.S. 16, 23 (1983) (“[W]here Congress includes particular language in one section of a statute but omits it in another ... , it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion.” (internal quotation omitted)).

If the second sentence of § 315(b) also applied to a “petition,” then the statute

could have and would have said so, as § 311(c) does. *Compare* § 315(b) (separately addressing “petition” and “request for joinder,” and applying the provision in § 315(b)’s second sentence to only the latter) *with* § 311(c) (referencing “petition” expressly when exempting petitions from the timing provision of either subpart (1) or (2)); *Russello*, 464 U.S. at 23 (holding that disparate inclusion or exclusion of particular statutory language in one place but not another is presumed intentional).

The FWD, which relied entirely on the Board’s analysis in the Qualcomm Decision, erred in determining that Qualcomm’s Petition was not time-barred. FWD 157-58 (relying on “the reasons explained” in Qualcomm Dec. 16-17); POR 68. The Board’s analysis underpinning the FWD only examined the language of § 315(b) in a single sentence, stating that “the Federal Circuit has explained that § 315(b) ‘includes a specific exception to the time bar’ because ‘[b]y its own terms, “[t]he time limitation . . . shall not apply to a request for joinder under subsection (c).”’” Qualcomm Dec. 16-17 (quoting *Facebook*, 973 F.3d at 1333). But *Facebook* merely confirms that § 315(b)’s second sentence applies to a “request for joinder”; it says nothing about applying that provision to the requesting party’s petition. *Facebook*, 973 F.3d at 1333. The Board’s reliance on *Facebook* is error because, as the Director has confirmed, “the Federal Circuit,” including in *Facebook*, “has not yet squarely determined the proper application of Section 315(b) and (c) to these circumstances.” IPR2024-01081, EX2068, 13-15 (native pages).

Rather than examine and acknowledge the plain statutory language of § 315(b), the Board instead erroneously interpreted the statute through the lens of the Board’s rules, specifically 37 C.F.R. §§ 42.101(b) and 42.122(b). FWD 158 (relying on the “reasons” in Qualcomm Dec. 16-17). This was a mistake because where, as here, there is a material difference between those rules and the statute, the statute governs. *See U.S. ex rel. Steinmetz v. Allen*, 192 U.S. 543, 565 (1904) (“If there is inconsistency between the [Patent Office] rules and statute, the latter must prevail.”).² That is, § 42.101(b) imposes a one-year time bar for petitions like § 315(b)’s first sentence, and § 42.122(b) addresses the one-year time bar similar to § 315(b)’s second sentence, but with one critical inconsistency: § 42.122(b) states that the time bar for petitions shall not apply “*when the petition is accompanied by a request for joinder*,” whereas § 315(b)’s second sentence states that the time bar for petitions shall not apply “*to a request for joinder*” (emphases added). Section 42.122(b) therefore applies to certain petitions (i.e., petitions accompanied

² *See also Loper Bright Enters. v. Raimondo*, 603 U.S. 369, 412-13 (2024) (holding that agency interpretation is given no deference); *Supernus Pharms., Inc. v. Iancu*, 913 F.3d 1351, 1361 (Fed. Cir. 2019) (giving no deference, even under *Chevron*, to USPTO regulation inconsistent with statute); *Wyeth v. Kappos*, 591 F.3d 1364, 1369-72 (Fed. Cir. 2010) (rejecting USPTO’s interpretation at odds with statute).

by a request for joinder) whereas § 315(b)'s second sentence does not. Thus, the Board's rules improperly extend the deadline for such petitions beyond the deadline set in the statute. The Board's analysis fails to recognize this critical distinction and incorrectly states that the Board's rules are "[c]onsistent with" § 315(b). Qualcomm Dec. 17; FWD, 158. They are not. Therefore, the Board erred by determining PO's statutory time-bar argument based on Board rules that are inconsistent with (and therefore overridden by) the language of § 315(b).

The Board's error is further shown by its rejection of PO's explanation that § 315(b)'s second sentence allows a party whose one-year deadline has passed to nonetheless request to join another IPR that is instituted after that one-year deadline, as long as the party's own petition was filed before that deadline. PO Resp. to Joinder Mot. 15; *see* POR 68. The Board held that this explanation "does not accord with the Board's rules regarding filing the two papers together," referring to § 42.122(b)'s provision about a "petition ... accompanied by a request for joinder." Qualcomm Dec. 17; *see* FWD 158. This holding suggests that the two papers may only ever be filed at the same time, which is not true, and again relies on a Board rule inconsistent with § 315(b), which contains no such provision about filing those two papers together. Here, Qualcomm could have timely filed its copycat Petition *before* its statutory deadline and then filed a joinder request *after* that deadline as allowed by § 315(b)'s second sentence.

Under a proper statutory interpretation of § 315(b), Qualcomm’s Petition was time-barred, and institution of such was improper.

2. Qualcomm Should Not Have Been Joined to This IPR Due to Qualcomm’s Time-Barred Petition

Because Qualcomm’s Petition was time-barred, the Board legally erred by joining Qualcomm as a petitioner in this IPR. Under § 315(c), the Director may join a party to an instituted IPR only if that party “*properly files a petition* under section 311” (emphasis added). A time-barred petition is not “*properly file[d]*” and thus provides no basis for its filer to be joined to another IPR. *See* § 311(c) (providing that petitions must be filed “[s]ubject to the provisions of this chapter,” which includes § 315(b)’s one-year time bar); *Pace v. DiGuglielmo*, 544 U.S. 408, 417 (2005) (“properly filed” includes “time limits”); *Artuz v. Bennett*, 531 U.S. 4, 8 (2000) (same); *Allen v. Siebert*, 552 U.S. 3, 6-7 (2007) (per curiam) (similar); 154 Cong. Rec. S9988 (daily ed. Sept. 27, 2008) (“properly filed” means “time deadlines for filing petitions must be complied with in all cases”); 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (confirming this “meaning of ‘properly filed’ ... in [§]315(c)”; Matal, *A Guide to the Legislative History of the AIA: Part II of II*, 21 Fed. Cir. B.J. 539, 613-14 (2012) (indicating “properly filed” means timely).

The FWD fails to address PO’s argument that § 315(c) does not permit joinder based on a time-barred petition and that Qualcomm’s Joinder Motion should therefore have been denied. *See* POR 68 (citing PO Resp. to Joinder Mot. 14-15);

FWD 157-58 (citing Qualcomm Dec. 16-17). Indeed, the FWD relies on the Board’s *institution* analysis (i.e., Qualcomm Dec. 14-28), not *joinder* analysis (i.e., *id.*, 38-49). FWD 158 (citing Qualcomm Dec. 16-17). It does not analyze § 315(c) or even reference its requirement of a “properly file[d]” petition. *Id.* And while PO’s time-bar arguments are mentioned in other portions of the Qualcomm Decision not relied on by the FWD, those portions likewise do not analyze whether joinder is permitted under § 315(c) based on a time-barred petition. *See* Qualcomm Dec. 42-43.

3. Institution and Joinder Based on a Time-Barred Petition Presents Important Issues of Law and Policy

The issues herein involve important issues of law and policy regarding the one-year time bar, joinder based on an otherwise time-barred petition, and related statutory interpretation of § 315(b)-(c). The FWD relies on the Board’s rules rather than the subject statutes, and the Board’s rules materially differ from those statutes regarding the issues here. Section 315(b)’s second sentence does not apply to petitions according to the plain language of that statute, which is what governs.

Additionally, Director Vidal confirmed, “the Federal Circuit has not yet squarely determined the proper application of Section 315(b) and (c) to these circumstances.” IPR2024-01081, EX2068, 13 (native page). The same issue is presented in a pending Federal Circuit appeal in which Acting Director Brent filed a brief as intervenor that disagrees with PO’s position herein by arguing that § 315(b)’s second sentence “reasonably refers back to the first sentence’s time

limitation on petitions.” *VLSI Tech. LLC v. Patent Quality Assurance LLC*, Appeal Nos. 23-2298, 23-2354, Dkt. 93 at 41-43. PO respectfully submits that this argument is inconsistent with the statutory language, as explained in Section IV.A.1 above, and requests that the Director confirm PO’s reading of § 315(b) is the correct one.

B. The Board Erred in Allowing Qualcomm’s New Reply Theory of Obviousness

Additionally or alternatively to the time-bar issue addressed above, the Director should review and reverse the FWD’s erroneous conclusion of law that Qualcomm’s theory for implementation of Drake’s QoS-12 in Goossens was not required in Qualcomm’s Petition for *prima facie* obviousness.

1. The Board Erroneously Held that Combination Implementation Details Were Not Required in the Petition

For *prima facie* obviousness, a petitioner must explain specifically how asserted references would be combined and work together. *See, e.g., ActiveVideo Networks, Inc. v. Verizon Commc’ns, Inc.*, 694 F.3d 1312, 1327-28 (Fed. Cir. 2012) (party failed to explain specifically how the references would be combined and operate together); *PersonalWeb Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993-94 (Fed. Cir. 2017) (Board failed to explain “*how* the combination of the two references was supposed to work” (emphasis in original)). To make its *prima facie* case here, Qualcomm was required to explain how Drake’s QoS-12, mapped to the claimed “[CM],” would be combined with Goossens, including where, within Goossens,

QoS-12 would be implemented. *See* Section II.B *supra*. Indeed, multiple sections of the FWD address this issue. FWD 82-89, 93-94. Qualcomm was required to present this *prima facie* case in its petition and not for the first time in its Reply. PTAB Consolidated Trial Practice Guide (Nov. 2019) at 73-74.

As the FWD acknowledged, Qualcomm eventually argued that Drake’s QoS-12 would be implemented in Goossens’ NI (herein, “NI Implementation Theory”), but did so for the first time in its Reply. FWD 82-83 (recognizing the NI Implementation Theory was only argued “in the Reply,” “[a]fter [PO] argued ... that the Petition lacked implementation details for the proposed combination”), 84-88 (no citations to the Petition for “Implementing Drake’s [QoS-12]”), 89, 93-94 (similar); *see* MTS 3-5; POSR 5-6. The FWD, and the MTS Order on which it relies, allowed this belated NI Implementation Theory by holding that it was not necessary for *prima facie* obviousness. MTS Order 24-25 (“those implementation details were not necessary for *prima facie* obviousness” (internal quotation omitted)); FWD 82-83 (same, relying on “reasons stated” in MTS Order).

This was incorrect. As explained above, such implementation details *are* required for *prima facie* obviousness, and the Board’s holding and acceptance of the Reply’s new NI Implementation Theory was thus improper. *See ActiveVideo and PersonalWeb, supra; Medtronic, Inc. v. Teleflex Innovations S.a.r.l.*, 70 F.4th 1331, 1346-47 (Fed. Cir. 2023) (disregarding “modifications not presented in [the]

petition”); *Intuitive Surgical, Inc. v. Ethicon LLC*, No. 2020-1480, 2022 WL 421189, at *4 (Fed. Cir. Feb. 11, 2022) (disregarding argument for “relocat[ing] Giordano’s [component] into Wallace’s tool [] portion” first raised after Ethicon “pointed out the [petition’s] deficiencies”); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1331 (Fed. Cir. 2019) (disregarding theory combining Iwaguchi and Kauffman’s sensors, as petition only argued “integrating Iwaguchi’s sensor” into “Kauffman’s [overall] system”); *South-Tek Sys., LLC v. Eng’red Corrosion Sols., LLC*, 748 F. App’x 1003, 1006-07 (Fed. Cir. 2018) (disregarding “substitut[ion]” argument, as petition only argued “add[ition]”); *see also Ariosa Diag. v. Verinata Health, Inc.*, 805 F.3d 1359, 1367 (Fed. Cir. 2015) (rejecting reply’s reliance on “previously unidentified portions of a ... reference to make a meaningfully distinct contention”).

The only purported reasoning in the FWD and MTS Order for the Board’s erroneous holding is that “[t]he challenged claims do not specify a location for” the claimed “[CM]” to which QoS-12 is mapped. FWD 82-83; MTS Order 24-25. This reasoning is contrary to the cases cited above in this Section IV.B.1, which analyze the *prima facie* obviousness requirement of explaining how references would be combined, including relative location of relied-upon components (*e.g.*, *Intuitive*), irrespective of any location recited in the claim or not. Indeed, tellingly, neither the FWD nor MTS Order cite any authority for the Board’s erroneous holding or its reasoning. FWD 82-83; MTS Order 24-25.

The Board erred because, as explained above, the NI Implementation Theory was required in Qualcomm's Petition for its *prima facie* obviousness case.

2. Presentation of a Prima Facie Obviousness Theory in Reply Presents Important Issues of Law and Policy

If the Board is correct that petitions may omit implementation details for combining references, then petitioners are empowered and incentivized to delay and first present such obviousness theories in their reply, such as in response to arguments about the petition's insufficiency. And patent owners, whose sur-reply may not be accompanied by an expert declaration, are thereby precluded from addressing those obviousness theories with expert evidence. 37 C.F.R. § 42.23(b).

For example, here, because Qualcomm's NI Implementation Theory was not disclosed in Qualcomm's Petition or during Qualcomm's expert's first deposition, PO had no notice of this theory until Qualcomm's Reply and thus no opportunity to respond with expert evidence. This prejudiced PO, as the FWD's analyses regarding the NI Implementation Theory can, and do, only cite Qualcomm's expert on the issue. *See* FWD 82-89. To allow petitioners to submit vague petitions and not explain specifically how references would be combined until the reply creates an unfair advantage for petitioners and should be prohibited.

V. CONCLUSION

For at least the foregoing reasons, the Director should grant review and reverse the FWD's determinations on the time-bar issue and new Reply theory issue.

Respectfully submitted,

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By: /s/ Jennifer Hayes

Jennifer Hayes
Reg. No. 50,845
NIXON PEABODY LLP
300 South Grand Avenue
Suite 4100
Los Angeles, CA 90071-3151
Tel. 213-629-6179
Fax 213-629-6001

Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Patent Owner's Request for Director Review of the Final Written Decision** was served on July 14, 2025, via email:

J. Derek Vandenburg
Aaron W. Pederson
Nathan D. Louwagie
Ryan D. Rypka
Peter M. Kohlhepp
Carlson Caspers Vandenburg & Lindquist, P.A.
225 South Sixth Street, Suite 4200
Minneapolis, MN 55402
dvandenburg@carlsoncaspers.com
apederson@carlsoncaspers.com
nlouwagie@carlsoncaspers.com
rrypka@carlsoncaspers.com
pkohlhepp@carlsoncaspers.com

Counsel for Petitioner

By: /s/ Jennifer Hayes

Counsel for Patent Owner