

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED
Petitioner¹

v.

NETWORK SYSTEM TECHNOLOGIES, LLC
Patent Owner

Case: IPR2024-00338
U.S. Patent No. 7,373,449 B2

**PETITIONER QUALCOMM INCORPORATED'S AUTHORIZED
RESPONSE TO DIRECTOR REVIEW REQUEST**

¹ Qualcomm Incorporated filed a petition and motion for joinder in IPR2024-01081 and has been joined as a petitioner in this proceeding.

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Statutes

35 U.S.C. § 315	1, 2, 3
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37 C.F.R. § 42.122(b).....	1, 2, 4
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There was no legal error with the Board’s finding that Qualcomm’s Petition was not time-barred. To the contrary, the Board applied the law as implemented by Office rules, which state that the one-year bar “shall not apply when the petition is accompanied by a request for joinder.” 37 C.F.R. § 42.122(b). Confirming that there was no legal error: the Acting Director recently explained why 37 C.F.R. § 42.122(b) is a correct implementation of 35 U.S.C. § 315, rejecting arguments that mirror the ones PO makes here. Finally, PO’s request for review of institution and joinder decisions now—after the FWD has already issued—is untimely.

PO’s request for Director Review, including its add-on request regarding a purportedly new obviousness theory in Petitioner’s Reply, does not identify any error of law or important issue of law or policy and should be denied.

I. BACKGROUND

This IPR concerns a patent that the applicant obtained by withholding the inventors’ own prior art publications on the same subject matter. Samsung filed a petition in December 2023, raising grounds based on the withheld prior art publications. Paper 2.² PO then statutorily disclaimed some challenged claims, and in June 2024 the Board instituted review as to the remaining claims. Qualcomm then promptly filed a Petition and Motion for Joinder seeking to join the instituted IPR, in accordance with 35 U.S.C. §§ 315(b)-(c). IPR2024-01081, Papers 1, 3.

² All cites to IPR2024-00338, unless otherwise noted.

The Board instituted Qualcomm’s Petition and granted its request for joinder in October 2024. Paper 16. The Board rejected PO’s time-bar argument because the one-year time bar “shall not apply when the petition is accompanied by a request for joinder.” *Id.* at 16 (quoting 37 C.F.R. § 42.122(b), citing 35 U.S.C. § 315(b)).

PO did not request Director Review of the October 2024 institution decision after receiving it, or at any point during the subsequent trial. The Board has now issued a Final Written Decision finding the challenged claims unpatentable.

II. ARGUMENT

A. The Board Did Not Legally Err in Finding Qualcomm’s Petition and Accompanying Request for Joinder Not Time-Barred

There was no legal error in the Board’s conclusion that the Petition was not time-barred. *See* Paper 70, 5. First, as PO concedes (Paper 70, 8), the Board applied the existing Office rule in finding that Qualcomm’s Petition was not time-barred (Paper 16, 17). This is not an error of law meriting Director Review. The rule plainly states that “[t]he time period set forth in § 42.101(b) [the one-year bar for a petition] shall not apply when the petition is accompanied by a request for joinder.” 37 C.F.R. § 42.122(b). The Board correctly found Qualcomm’s Petition was accompanied by a timely request for joinder and therefore was not barred.

Second, the C.F.R. rule is consistent with the text of 35 U.S.C. § 315 as applied by the Office. PO makes two arguments—one, that the second sentence of Section 315(b) applies only to motions for joinder (not petitions), and two, that

Section 315(c) applies only to “properly file[d]” a petition (and a petition filed after the one-year bar is not “properly filed”). Paper 70, 5-9 and 10-11. The Acting Director recently rejected nearly identical arguments in a Federal Circuit brief:

Section 315(b) includes two sentences. . . . The only “time limitation set forth in the preceding sentence” is the time limitation on filing an IPR petition; the first sentence does not address requests for joinder. Thus, the “time limitation set forth in the preceding sentence” that “shall not apply” refers to the one-year bar on filing a petition. VLSI’s alternative reading...means that § 315(b)’s exception to the time-bar for “requests for joinder” does no work. . . .

VLSI also argues that Intel’s petition was not properly filed within the meaning of § 315(c) because “properly filed” in § 315(c) excludes untimely petitions. But VLSI’s premise—that Intel’s petition was untimely—is incorrect because, as explained above, § 315(b) excepts joinder petitions from the one-year time limitation.

Brief for Intervenor—Director of the USPTO, *VLSI Tech. LLC v. OpenSky Indus., LLC et al.*, Nos. 2023-2158, 23-2159, at 39-41 (Fed. Cir. May 23, 2025). PO has provided no compelling reason the Acting Director’s explanation and reasoning is incorrect.

PO also asserts that its statutory interpretation arguments present “important issues of law and policy.” Paper 70, 11-12. But there are no novel issues to decide

here. The Acting Director has already explained why PO's arguments are wrong.³

B. PO's Request for Review of the Institution Decision Is Untimely

Director Review should also be denied because PO chose to not file a timely review request in October 2024. Instead, PO waited nearly nine months, and sought review of the trial-initiating decisions only after the full IPR trial concluded. Under then-existing guidance, a party was required to request Director Review within 14 days of the entry of a non-final decision/decision to institute trial. *See Superseded-Revised Interim Director Review Process*, 3.B (adopting time limits of 37 C.F.R. § 42.71(d)); *see also id.*, 2.A and 3.A. The current rule provides for the same “unless an extension is granted by the Director upon a showing of good cause.” 37 C.F.R. § 42.75(c)(1); *see also Director Review process*, 3.B.

PO had the opportunity to file a timely request for Director Review. But PO chose not to do that. PO's request for director review of the case-initiating decision now—after the Board conducted a trial and issued a FWD—is untimely. PO has not shown good cause for why the Director should allow an untimely request.

C. The Board Did Not Commit Any Legal Error by Finding Petitioner's Reply Arguments Properly Responsive

PO also argues that Petitioner was obligated to explain in the Petition

³ Even were the Acting Director to agree with PO, PO has not shown the Director could permissibly disregard the governing Office Rule (37 C.F.R. § 42.122(b)).

exactly where and how the communication manager teachings (what PO calls Drake's "QoS-12") would be physically implemented on the chip to establish *prima facie* obviousness. Paper 70, 12-15. The Board correctly rejected this three times: Paper 64, 20-26, Paper 68, 16-20, and Paper 69, 82-83.

The Board's decisions were not legally erroneous and do not raise important issues of law or policy. PO leans heavily on arguments regarding *ActiveVideo* and *PersonalWeb Techs.* But as Petitioner explained, those cases are inapposite. Paper 43, 7-8. The Board correctly found the arguments properly responsive under Federal Circuit precedent. Paper 69, 84. The Board also properly explained the claims do not specify a particular on-chip location for the claimed functionality (*id.* at 69, 82), and the combination was not beyond a POSITA's skill (*id.* at 97-99).

Nor is there any issue of fairness. The Board properly found the Reply directly responsive. *E.g.*, Paper 64, 24-25. For example, Petitioner properly responded to PO assertions "about the 'complexity' of implementing QoS requestor manager 12 in an NoC." Paper 64, 25-26. And PO's contention that "Qualcomm's NI Implementation Theory was not disclosed . . . during Qualcomm's expert's first deposition" (Paper 70, 15) is just wrong. PO's expert *did* testify at his *first* deposition that the NI would be a "natural place" to implement the QoS-12 functionality. Paper 43, 10 (citing Ex-2078, 203:24-204:9).

Petitioner respectfully requests that PO's Director Review request be denied.

Respectfully submitted,

Dated: July 22, 2025

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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e) and the agreement of the parties, the undersigned certifies that on July 22, 2025, a true and correct copy of the foregoing Petitioner Qualcomm Incorporated's Authorized Response to Director Review Request was served via electronic mail upon the following:

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