

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Nokia of America Corp., Ericsson Inc., AT&T Services, Inc., Cellco Partnership
d/b/a Verizon Wireless, T-Mobile USA, Inc.,
Petitioners

v.

Wireless Alliance, LLC
Patent Owner

Case IPR2024-00619
Patent 10,045,383

**PETITIONERS' REPLY TO THE PATENT OWNER'S RESPONSE TO
THE PETITION**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
US Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

Petitioners provide the following Reply pursuant to the Board’s July 17, 2024, authorization. Paper 16. In the authorization, the Board requested briefing on whether Acharya qualifies as prior art and whether changing statutory basis for qualifying prior art is a material change. *Id.* Acharya is prior art under § 102(a)(2). Moreover, Petitioners do not need to “change” the statutory basis in the Petition because Petitioners stated they would rely on “*at least* 102(a)(1),” not *exclusively* 102(a)(1). If the Petition does need to be changed, all factors favor the Petitioners.

ANALYSIS

The Petition relies on Publication No. 2013/0089034 to Acharya (“Acharya”) as a prior art reference. The Petition stated, “Acharya is prior art under *at least* 35 U.S.C. § 102(a)(1).” Paper 1 at 5 (emphasis added). In its POPR, Patent Owner incorrectly stated that the Petition “assumes that Acharya is prior art under 35 U.S.C. § 102(a)(1)” and that Acharya is not prior art under § 102(a)(1). POPR at 1. Patent Owner mischaracterizes the Petition and ignores that Acharya is prior art.

I. Acharya is prior art under § 102(a)(2)

Acharya is prior art under § 102(a)(2). As stated in the Petition, Acharya was filed on October 5, 2011, and was published on April 11, 2013.

(22) Filed: Oct. 5, 2011

(10) Pub. No.: US 2013/0089034 A1 (43) Pub. Date: Apr. 11, 2013
--

Ex. 1004 at (22), (43).

The 383 Patent’s alleged priority date is March 28, 2013 (over a year later).

(30)	Foreign Application Priority Data	
	Mar. 28, 2013	(KR) 10-2013-0033568

Ex. 1001 at (30).

Acharya unquestionably qualifies as prior art under 35 U.S.C. § 102(a)(2), which states “the claimed invention was described in . . . an application for patent published or deemed published under section 122(b), in which the . . . application . . . names another inventor and was effectively filed before the effective filing date of the claimed invention.” 35 U.S.C. § 102(a)(2).

II. The Petition did not state Acharya was prior art only under § 102(a)(1)

In the POPR, Patent Owner stated that the Petition “assumes that Acharya is prior art under 35 U.S.C. § 102(a)(1).” POPR at 1. However, the Petition actually stated, “Acharya is prior art under *at least* 35 U.S.C. § 102(a)(1).” Therefore, while the Petition inadvertently stated that Acharya was prior art under § 102(a)(1) (when it is, in fact, prior art under § 102(a)(2)), the Petition did not limit its analysis of Acharya based on that fact. The Petition also assumed that Acharya was prior art under alternative sub-parts, which would include § 102(a)(2). Indeed, under the AIA rubric, the only *possible* alternative the “at least” was referring to is the correct § 102(a)(2) sub-part. Moreover, the Petition expressly states the relevant facts about Acharya that establish it as prior art. Specifically, the Petition provided the date that Acharya was filed (October 5, 2011), and the date it was published (April 11, 2013). Paper 1 (Pet.) at 5. Patent Owner does not dispute these facts, and thus the Petition

provided the basis for finding Acharya as prior art under § 102. Accordingly, Petitioner does not seek to “change” the statutory basis for qualifying prior art because the “at least” language put Patent Owner on notice of the correct sub-part.

Importantly, the Board has previously found that failing to list the correct sub-part is immaterial. *Purdue Pharma, L.P., v. Depomed, Inc.*, IPR2014-00377, Paper 72 at 14 (P.T.A.B. July 8, 2015) (“Patent Owner’s complaint that the Petition did not identify the ’837 patent as § 102(a) prior art is immaterial to whether the reference, in fact, qualifies as § 102(a) prior art.”). This is because relying on the reference is full and fair notice that the Petitioner is applying the reference regardless of the listed sub-part. *Id.* The Board in *Purdue Pharma* found that “Patent Owner does not persuade us that the alleged misidentification in any way prejudiced Patent Owner’s defense of its interests in this proceeding.” *Id.* The same should be the result here.

III. If the sub-part needs to be changed, the change is immaterial

Patent Owner requested that the Reply Brief address “whether changing statutory basis for qualifying prior art is a material change.” As noted above, Petitioners do not believe a change is necessary.

If the sub-part in the Petition needs to be “changed,” however, the change is immaterial. *Conmed Corp. et al. v. Bonutti Skeletal Innovations LLC*, IPR2013-00624, Paper 22 (2014 Pat. App. LEXIS 1614), *6 (March 14, 2014) (“[T]he Board may grant appropriate relief under 37 C.F.R. § 42.104(c) whether the party making

the error admits to it or not.”). Under 37 C.F.R. § 42.104(c), the Board can consider various non-exclusive factors, each of which support the Petitioner here. *Ivantis, Inc. v. Glaukos Corp.*, IPR2018-01180, Paper 14 at 9 (P.T.A.B December 6, 2018).

The error was inadvertent and unintentional. First, the Board can consider the nature of the error. *Ivantis*, IPR2018-01180, Paper 14 at 9. Here, the misidentification of the sub-part was inadvertent and unintentional. Reference to one sub-sub-part of § 102 instead of a second sub-sub-part of § 102 (*e.g.*, 102(a)(2) instead of 102(a)(1)) was an oversight in the final review of 75 pages of substantive discussion. The Board has previously found these type of errors (*e.g.*, listing 102(b) instead of 102(e)) to be insignificant, especially when none of the arguments in the Petition are materially affected, which is the case here. *Sensus USA, Inc., v. Certified Meas., LLC*, IPR2015-01262, Paper 14 at 1-2 (P.T.A.B. Aug. 3, 2015).

Petitioners timely notified the Board. Second, the Board can consider whether it was timely notified. *Ivantis, Inc.*, IPR2018-01180, Paper 14 at 9. Here, Petitioners acted quickly to bring this issue to the Board’s attention. The issue was discovered upon reviewing the POPR. After considering the issue, on July 3 Petitioners reached out to Patent Owner. After negotiating the e-mail to the Board (in addition to the July 4 weekend), Petitioners reached out on July 12, 2024, to the Board. This factor favors granting Petitioners’ request.

There is no prejudice to Patent Owner. Third, the Board can consider

prejudice to the other party, if any. *Ivantis*, IPR2018-01180, Paper 14 at 9. Here, there is no prejudice. The language “at least 102(a)(1)” put Patent Owner on notice that Petitioners may rely on a different sub-part of the statute (with the only other alternative being 102(a)(2)). But even relying on that different sub-part of the statute does nothing to affect the underlying substance of the Petition. The exact same arguments and issues apply whether 102(a)(1) or 102(a)(2) applies. And, importantly, there is no question that Acharya qualifies as prior art.

Patent Owner may argue that it would have substantively responded to the arguments regarding Acharya’s disclosures in the Petition had it believed Acharya was prior art. This argument has no merit. After reviewing the “at least” language and the relevant filing date (October 5, 2011) recited in the Petition, Patent Owner could have conducted its own analysis under the only other sub-part 102(a)(2) and concluded that Acharya is in fact prior art. *See Syntroleum Corp. v. Neste Oil Oyj*, IPR2013-00178, Paper No. 21 at 5 (P.T.A.B. July 22, 2013).

The change would have no impact on the proceeding. Fourth, the Board can consider any impact on the proceeding. Here, there is no impact. The Board has not issued an institution decision, and Patent Owner can file a sur-reply.

CONCLUSION

The Board should consider Acharya prior art. 37 C.F.R. § 42.5(a).

Date: July 24, 2024

By: / John D. Haynes /
John D. Haynes

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§42.6(e), 42.105, the undersigned hereby certifies that true and correct copies of the above-captioned **PETITIONERS' REPLY TO THE PATENT OWNER'S RESPONSE TO THE PETITION** were served via electronic mail to the following attorneys of record for Patent Owner:

Andrew D Weiss
Dale Chang
Qi Tong
Benjamin T Wang

aweiss@raklaw.com
dchang@raklaw.com
ptong@raklaw.com
bwang@raklaw.com

RUSS AUGUST & KABAT
12424 Wilshire Blvd. 12th Floor
Los Angeles, CA 90025
United States

Date: July 24, 2024

By: / John D. Haynes /
John D. Haynes