

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA OF AMERICA CORPORATION, T-MOBILE USA, INC., AT&T
SERVICES, INC., CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,
ERICSSON INC.,

Petitioners,

v.

WIRELESS ALLIANCE, LLC,

Patent Owner.

Case IPR2024-00619
U.S. Patent No. 10,045,383

PATENT OWNER'S SUR-REPLY TO PETITIONERS' REPLY

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Rules

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PATENT OWNER’S EXHIBIT LIST

Exhibit	Description
2001	First Amended Docket Control Order from <i>Wireless Alliance, LLC v. AT&T Mobility LLC</i> , No. 2:2[3]-cv-00095-RWS-RSP, Dkt. 86 (E.D. Tex. May 2, 2024)
2002	Defendants’ And Intervenors’ Preliminary Invalidity Contentions Regarding U.S. Patent Nos. 9,144,106; 9,565,662; 10,045,383
2003	Scheduling Order from <i>Intellectual Ventures I LLC v. MVware, Inc.</i> , No. 1:19-cv-01075-ADA (W.D. Tex. Dec. 10, 2019).
2004	Memorandum Opinion and Order [Denying Stay] from <i>Force MOS Tech., Co., Ltd. v. ASUSTek Computer, Inc.</i> , No. 2:22-cv-00046-JRG (E.D. Tex. Apr. 10, 2024)
2005	Order [Denying Stay] from <i>General Access Solutions, Ltd. v. Cellco Partnership D/B/A Verizon Wireless</i> , No. 2:22-cv-00394-JRG (E.D. Tex. May 22, 2024)
2006	Docket Report from <i>Wireless Alliance, LLC v. AT&T Mobility LLC</i> , No. 2:23-cv-00095-RWS-RSP (E.D. Tex. June 9, 2024).
2007	Claim Construction Order from <i>Wireless Alliance, LLC v. AT&T Mobility LLC</i> , No. 2:23-cv-00095-RWS-RSP (E.D. Tex. Apr. 24, 2024).

Petitioners' Reply admits it did not articulate the reasons why Acharya was prior art "with particularity." As a result, 35 U.S.C. § 312(a)(3) mandates that the Petition be denied. Petitioners argue that non-exclusive language ("at least") absolves them of their obligations, but statutory, Supreme Court, and Federal Circuit authority contradict their argument.

I. Petitioners failed to present their arguments "with particularity" because they did not cite Section 102(a)(2), precluding institution

35 U.S.C. § 312(a)(3) allows the PTAB to consider the Petition "only if . . . the petition identifies, in writing and *with particularity* . . . the grounds on which the challenge to each claim is based." (emphasis added). Compliance with the "with particularity" requirement is of "the utmost importance." *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016). This includes identifying with particularity "*the specific statutory grounds under* 35 U.S.C. 102." 37 C.F.R. § 42.104(b)(2) (emphasis added).

The Petition makes no mention of reliance on Section 102(a)(2). On reply, Petitioners argue this does not matter because Acharya is prior art under "*at least* 35 U.S.C. § 102(a)(1)," arguing that the words "at least" means Petitioner can later rely on any portion of Section 102 they need to. Paper 17 at 1 (emphasis in original). This effectively admits that the Petition was not drafted "with particularity" but instead uses an ambiguity phrase in place of a statutory provision *missing* from the Petition.

Section 312(a)(3) exists “to ensure that a patent owner has sufficient notice of the challenge against which it must defend.” *Eik Eng’g Sdn. Bhd. v. Wilco Marsh Buggies & Draglines, Inc.*, No. IPR2020-00344, Paper 7 at 15–16 (PTAB June 23, 2020). Arguing that “at least 102(a)(1)” should be interpreted as 102(a)(2) (or any other paragraph of Section 102) directly contradicts both the statute and *Eik*.

Federal Circuit precedent emphasizes the importance of requiring the Petition to plead the basis for grounds “with particularity.” *See Microsoft Corp. v. FG SRC, LLC*, 860 F. App’x 708, 712–13 (Fed. Cir. 2021). Because “the petitioner is the ‘master of its complaint’” and must identify arguments “with particularity,” it is appropriate for the PTAB to hold a petitioner to the particular statements in the petition. *Id.* at 713 (citing *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018)). For example, the Federal Circuit upheld a Board decision holding the petitioner to the § 102 arguments expressly made in the petition, despite ambiguous references to § 103 arguments, and despite the patent owner’s acknowledgement of the obviousness arguments. *Microsoft*, 860 F. App’x at 712-13; *see also Intelligent Bio-Sys.*, 821 F.3d at 1369 (new arguments may not be raised in reply); PTAB Consolidated Trial Practice Guide at 74 (Nov. 2019) (same).

Petitioners argue that their grounds were “inadvertently stated” and that “[t]he error was inadvertent and unintentional.” Paper 17 at 2, 4. But § 312(a)(3) does not consider intent. The proper analysis looks at the disclosure of the Petition, not

Petitioners’ intent or purportedly inadvertent error. Petitioners also lack evidence of inadvertent error.

Petitioners’ cited authority does not support institution. *Purdue Pharma* was decided before the Supreme Court’s decision in *SAS* and the Federal Circuit’s rulings in *Intelligent Bio-Sys.* and *Microsoft*, all of which emphasize the importance of a petitioner pleading “with particularity.” *Purdue Pharma L.P. v. Depomed, Inc.*, No. IPR2014-00377, Paper 72 at 13–14 (PTAB July 8, 2015). Moreover, *Purdue Pharma* is a Final Written Decision, not an institution decision, and the patent owner suffered no unfair prejudice at the institution stage. *Id.* The issue was not even raised before institution. See *Purdue Pharma L.P. v. Depomed, Inc.*, No. IPR2014-00377, Paper 8 (PTAB May 2, 2014); *Purdue Pharma L.P. v. Depomed, Inc.*, No. IPR2014-00377, Paper 9 (PTAB July 10, 2014). In contrast, here the Patent Owner has been unfairly prejudiced, as addressed below.

Petitioners’ remaining cited decisions are about § 42.104(c), a motion Petitioners have **not** made here, and based on facts that are not present here. *E.g.*, *Sensus USA, Inc. v. Certified Meas., LLC*, IPR2015-01262, Paper 10 at 4 (PTAB July 27, 2015) (granting an ***unopposed*** motion to correct filed ***before*** the POPR); *Syntroleum Corp. v. Neste Oil Oyj*, IPR2013-00178, Paper No. 21 at 2–5 (PTAB July 22, 2013) (correcting a paralegal’s copying error; granting a motion supported by a declaration not present here).

If Petitioner’s error was clerical, Petitioners should have filed a motion for correction. 37 C.F.R. § 42.104(c). But even a 42.104(c) motion would be futile because the error here (statutory analysis) required lead counsel “to exercise original thought or judgement,” so it cannot qualify for a “clerical” correction. *Zhongshan Broad Ocean Motor Co., Ltd. v. Nidec Motor Corp.*, No. IPR2014-01121, Paper 20 at 9–12 (PTAB Jan. 21, 2015); *see also Ivantis, Inc. v. Glaukos Corp.*, No. IPR2018-01147, Paper 14 (PTAB Dec. 6, 2018) (denying a pre-institution § 42.104(c) motion that was supported by declarations (unlike here) about the error of using a -B2 reference instead of the -A1 version, and then denying the petition). Without a § 42.104(c) correction, the Petition *as written* cannot be instituted.

II. Allowing a change in statutory grounds is unfairly prejudicial

Patent Owner submitted its POPR relying on the Petition as written. Had Petitioners taken the care mandated by the statutes, Supreme Court, and Federal Circuit in crafting their Petition, Patent Owner would have submitted a POPR addressing the many substantive failings of the Petition. For example, Patent Owner could have responded to Petitioners’ proposed construction of “uplink control channel” that is contrary to the challenged claims (Pet. at 24-25) as well as Petitioners’ failure to come forward with evidence of such a channel (under either Petitioners’ faulty construction or the plain and ordinary meaning) in either Yu or Acharya (Pet. at 38-42). Patent Owner did not do so in the POPR because there was

no need to. The Petition’s failure to establish Acharya as prior art is undisputed. *Ivantis*, No. IPR2018-01147, Paper 14 at 5–15 (denying institution because the -B2 version of the reference did not qualify as prior art).

Patent Owner cannot address these issues here. The Board has limited this sur-reply in both length (five pages) and content (responding only to Petitioners’ reply argument without new evidence). Paper 16 at 2.

As a result, if the Board allows Petitioners to effectively correct their Petition, without making such a motion or demonstrating the applicability of § 42.104(c) and the decisions interpreting it, Patent Owner will suffer the unfair disadvantage of not being able to make its substantive arguments in a POPR. Such a result would be directly contrary to *SAS*, *Intelligent Bio-Sys.*, and *Microsoft* that emphasize the importance of deciding institution based on the Petition as written.

III. The Board has wide discretion to deny, and limited power to institute

35 U.S.C. § 312(a)(3) cannot be waived by the Board. A Petition can be instituted “*only if*” it meets the “with particularity” requirement. *Id.* (emphasis added). While Congress empowered the Board with wide discretion to decline to institute review under 35 U.S.C. § 314(a), § 312(a)(3) imposes strict requirements for institution. It is undisputed those requirements are not satisfied here. The Board should deny institution.

Respectfully submitted,

Dated: July 31, 2024

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on July 31, 2024, by filing this document through the P-TACTS system as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioners:

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