

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,

Petitioner

v.

TELEFONAKTIEBOLAGET L M ERICSSON (publ),

Patent Owner.

Case No. IPR2024-00728

Patent No. 7,151,430 B2

Before Daveina B. Williams, *Trial Paralegal*

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

TABLE OF CONTENTS

TABLE OF CONTENTS.....	I
TABLE OF AUTHORITIES	II
I. STATEMENT OF RELIEF REQUESTED	1
II. ERICSSON OBJECTED TIMELY.....	1
III. INTEL RELIED ON THE SIMULATION EVIDENCE.....	2
IV. THE BOARD SHOULD EXCLUDE THE SIMULATION EVIDENCE.....	3
A. LEGAL STANDARDS.....	3
B. ARGUMENT	4
V. CONCLUSION.....	6

TABLE OF AUTHORITIES

Cases

<i>Hulu, LLC v. Sound View Innovations, LLC</i> , 2019 Pat.App. LEXIS 11904, IPR2018-01039, Paper 29 (PTAB 2019).....	3
<i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	3
<i>Qualcomm Inc. v. Apple, Inc.</i> , 24 F.4th 1367 (Fed. Cir. 2022)	6

Statutes

35 U.S.C. § 135(a)	3
35 U.S.C. § 311(b)	5
35 U.S.C. § 311(c)	3
35 U.S.C. § 312(a)(3).....	2

Other Authorities

Consolidated Trial Practice Guide 2019	3
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Regulations

37 C.F.R. § 42.23(b)	1, 3, 4, 5
37 C.F.R. § 42.64(b)(1).....	1
37 C.F.R. § 42.64(c).....	1
37 C.F.R. § 42.123	3

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner, Telefonaktiebolaget L M Ericsson (publ) (“Ericsson”), moves to exclude opinions and new evidence in the Supplemental Declaration of Manos Tentzeris (INTEL EX1043, ¶¶ 6-36, hereafter the “Simulation Evidence”). Intel did not include the Simulation Evidence with the Petition. The Simulation Evidence exceeds Ericsson’s arguments in its Patent Owner Response (Paper 16). 37 C.F.R. § 42.23(b) (“A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution.”) The Reply (Paper 19) references the Simulation Evidence in Section V.A. discussing PCB and IC teachings and in Section V.C.2 discussing Ground 1. The Board should exclude the Simulation Evidence.

II. ERICSSON OBJECTED TIMELY

On April 15, 2025, Intel filed EX1043 as an exhibit to its Reply to Patent Owner’s Response. Paper 19. On April 21, 2025, Ericsson filed its Objections to Petitioner’s Reply Evidence within five business days. Paper 21. 37 C.F.R. § 42.64(b)(1). Ericsson’s Objections identified EX1043, ¶¶ 6-36, 41 & 53 as impermissible new evidence. Paper 21, 2.

III. INTEL RELIED ON THE SIMULATION EVIDENCE

Dr. Tentzeris provided the Simulation Evidence as new evidence in his Supplemental Declaration. EX1043, § II. Because paragraphs 6-36 relate to visualizing EM fields produced by various shapes of current-carrying conductors, the Board may consider paragraphs 6-36 collectively. EX1043, ¶ 7. These simulations were performed on substrates of the same size. *Id.* Each of the paragraphs is new, and the basis for exclusion is the same for each paragraph.

Intel relied on paragraphs 25-30 of EX1043. Paper 19, 17. (“Petitioner’s expert performed simulations demonstrating the electromagnetic field produced by the eight-shaped antenna/inductor is constrained both laterally and vertically, such that the field strength decreases rapidly with increasing distance.”)

Intel relied on paragraphs 24-25 of EX1043. Paper 19, 18. (“The flux lines of the magnetic field generated by the two loops of Taniguchi’s eight-shaped antenna/inductor are equal and opposite in direction and therefore cancel, *as shown in Dr. Tentzeris’ simulations.*”) (italics added).

Intel relied on ¶ 26. Paper 19, 9-10, 24, 26 (referencing EX1043, ¶ 51 that incorporates ¶ 26). (“In either application, the fundamental physics governing the electromagnetic fields produced by inductors is the same.”)

Dr. Tentzeris also incorporated by reference and relied on ¶¶ 31-32 in ¶ 65 of EX1043. Intel relied on ¶ 65. Paper 19, 23. (“As explained above, a POSITA designing inductors for ICs would have sought out art related to inductor design, regardless of whether such designs were implemented on PCBs or ICs and thus would have been motivated to combine the teachings of Midya and Raghavan.”)

Dr. Tentzeris incorporated by reference and relied on ¶¶ 22-30 in paragraph 62. EX1043, ¶ 62. Ericsson could not find a reference to ¶ 62 in the Reply.

IV. THE BOARD SHOULD EXCLUDE THE SIMULATION EVIDENCE

A. Legal Standards

“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369-70 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)) (affirming Board’s decision to exclude argument and evidence presented for first time in petitioner’s reply brief). After institution, Intel “may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability.” *Hulu, LLC v. Sound View Innovations, LLC*, 2019 Pat.App. LEXIS 11904, * 7, IPR2018-01039, Paper 29 (PTAB 2019) (Precedential Opinion) (citing Consolidated Trial Practice Guide

2019 (“CTPG”), 73). A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution. 37 C.F.R. § 42.23(b). Intel did not move to submit supplemental information under 37 C.F.R. § 42.123.

B. Argument

Intel relies on the Simulation Evidence to bolster both its obviousness argument regarding the “reduced far field” claim terms and its motivation to combine argument. Paper 19, respectively at 16-17 & 9-10. “The petition must be filed with the Board consistent with any time period required by statute and be accompanied by the evidence the petitioner seeks to rely upon. *See, e.g.*, 35 U.S.C. §§ 135(a), 311(c); 37 C.F.R. § 42.3.” CTPG, 3.

The Simulation Evidence is new. The Petition did not include simulations of EM fields from different sized antennas. Paper 2 and EX1003. The Simulation Evidence constitutes new evidence the Petition does not discuss. Dr. Tentzeris did not include simulations relating to the EM fields created by Taniguchi’s antennas in his original Declaration. EX1003. The word “simulation” appears twice in the declaration, both times quoting text from the ‘430 Patent. EX1003, ¶¶ 38, 177.

Dr. Tentzeris points to the Institution Decision as the reason for submitting the Simulation Evidence. EX1043, ¶ 6. The Board’s encouragement “develop the

record during trial” was in the context of what a POSITA would have understood regarding EM fields emanating from Taniguchi’s antennas. Paper 10, 19. Ericsson submits that is not an argument raised in the institution decision in the context of § 42.23(b). Nor is it an invitation to submit new evidence beyond the scope of the Petition (Paper 2). Ericsson does not have an opportunity to respond to this new evidence and will be prejudiced if the Simulation Evidence is considered. The Board should not permit Intel to bolster its invalidity arguments when it could have included the Simulation Evidence with the Petition. *Hulu* holds Intel cannot use the Simulation Evidence to satisfy its burden of proving unpatentability by a preponderance of the evidence. The Board should exclude the Simulation Evidence on this basis.

The Simulation Evidence does not respond to an argument Ericsson made in its Patent Owner Response. Paper 16. Ericsson’s expert, Dr. Prucnal, did not provide EM field simulations produced by Taniguchi’s antennas. EX1043, ¶ 6. Rather, Ericsson argued Taniguchi requires its antennas to be positioned concentrically without EM coupling with each other. Paper 16, 33. The Petition failed to show Taniguchi would reduce magnetic coupling if its antennas were laterally offset as the Challenged Claims require. *Id.*, 35. The Simulation Evidence is not responsive to Ericsson’s arguments; it purports to fill an evidentiary gap

missing in the Petition. The Board should exclude the Simulation Evidence as exceeding the scope of a proper reply.

If the Board excludes the Simulation Evidence, Intel suffers no prejudice. Use of the Simulation Evidence to support Intel's obviousness position is improper because it is not "prior art consisting of patents or printed publications." 35 U.S.C. § 311(b); *Qualcomm Inc. v. Apple, Inc.*, 24 F.4th 1367, 1374 (Fed. Cir. 2022) (concluding patents or printed publications do not include admitted prior art). Intel's use of the Simulation Evidence to support its motivation to combine argument is improper because such evidence must also be presented with the Petition. If the Board excludes the Simulation Evidence, it does not prejudice Intel.

V. CONCLUSION

Intel's Simulation Evidence is new and exceeds the proper scope of reply. Ericsson would be prejudiced if the Simulation Evidence is considered. The Board should exclude it. 37 C.F.R. § 42.23(b).

Date: June 17, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on Tuesday, June 17, 2025 a copy of the foregoing Patent Owner Response was served via email the following attorneys for the Petitioner:

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