

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 REPLY IN SUPPORT OF
MOTION TO EXCLUDE EVIDENCE**

TABLE OF CONTENTS

TABLE OF CONTENTS.....	i
TABLE OF AUTHORITIES	ii
I. INTRODUCTION	1
II. THE BOARD SHOULD EXCLUDE THE SIMULATION EVIDENCE.....	1
A. LEGAL STANDARDS.....	1
B. THE INSTITUTION DECISION WAS NOT AN INVITATION TO SUBMIT EVIDENCE THAT SHOULD HAVE BEEN SUBMITTED WITH THE PETITION...	3
C. THE SIMULATION EVIDENCE DOES NOT RESPOND TO ARGUMENTS IN THE PATENT OWNER’S RESPONSE.	4
D. PREJUDICE TO ERICSSON BUT NOT TO INTEL	5
III. CONCLUSION.....	5

TABLE OF AUTHORITIES

Cases

<i>Anacor Pharms. v. Iancu</i> , 889 F.3d 1372 (Fed. Cir. 2018)	2, 3
<i>Axonics, Inc. v. Medtronic, Inc.</i> , 75 F.4th 1374 (Fed. Cir. 2023)	2
<i>Aylo Freesites Ltd et al v. Dish Technologies LLC</i> , IPR2024-00046, Paper 60 (PTAB April 14, 2025)	2
<i>Belden Inc. v. Berk-Tek LLC</i> , 805 F.3d 1064 (Fed. Cir. 2015)	1
<i>Chamberlain Grp., Inc. v. One World Techs., Inc.</i> , 944 F.3d 919 (Fed. Cir. 2019)	2, 3
<i>F5 Networks, Inc. v. Radware, Ltd.</i> , IPR2017-00124, Paper 48 (PTAB April 23, 2018)	3
<i>Hulu, LLC v. Sound View Innovations, LLC</i> , 2019 Pat.App. LEXIS 11904, IPR2018-01039, Paper 29 (PTAB 2019)	4
<i>Intri-Plex Technologies, Inc. and MMI Holdings, Ltd. v. Saint-Gobain Performance Plastics Rencol Ltd.</i> , 2014 Pat. App. LEXIS 9069, IPR2014-00309, Paper 83 (PTAB March 23, 2014)	1

Other Authorities

Consolidated Trial Practice Guide 2019 (“CTPG”)	2
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Regulations

37 C.F.R. § 42.64(b)(1)	1
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I. INTRODUCTION

The Board should not permit Intel Corporation to rely on new evidence it could have submitted with its Petition. The Simulation Evidence exceeds the scope of proper reply and introduces substantive content the Petition did not present. The Simulation Evidence is a patch, not rebuttal, that the Board should exclude and ignore.

II. THE BOARD SHOULD EXCLUDE THE SIMULATION EVIDENCE

A. Legal Standards

“A Reply that belatedly presents evidence will not be considered.” *Intri-Plex Technologies, Inc. and MMI Holdings, Ltd. v. Saint-Gobain Performance Plastics Rencol Ltd.*, 2014 Pat. App. LEXIS 9069, * 19, IPR2014-00309, Paper 83 (PTAB March 23, 2014) (routine opinion) (excluding paragraphs from an expert declaration submitted on reply). “Among other things, one indication that a new issue has been raised in a Reply is “new evidence that could have been presented in a prior filing.”” *Id.* at * 18.

“Thus, if the petitioner submits a new expert declaration with its Reply, the patent owner can respond in multiple ways. [...] It can move to exclude the declaration. [...] The options are not mutually exclusive.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081 (Fed. Cir. 2015)).

A petitioner may introduce new evidence as a legitimate reply to evidence introduced by the patent owner or to document the knowledge of a POSITA. *Anacor Pharms. v. Iancu*, 889 F.3d 1372, 1380-1 (Fed. Cir. 2018). Parties may elaborate on their arguments on issues previously raised. *Chamberlain Grp., Inc. v. One World Techs., Inc.*, 944 F.3d 919, 925 (Fed. Cir. 2019). However, Intel cannot “submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability.” *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1380 (Fed. Cir. 2023). (citing Consolidated Trial Practice Guide 2019 (“CTPG”) 73)

The Board may treat Ericsson’s Motion as a motion to strike. *Aylo Freesites Ltd et al v. Dish Technologies LLC*, IPR2024-00046, Paper 60, 85, n. 19 (PTAB. April 14, 2025) (“We note that certain aspects of Petitioner’s motion to exclude would be characterized more precisely as a motion to strike. [. . .] To the extent necessary, and as discussed below, we exercise our discretion to treat these aspects of Petitioner’s motion to exclude as a motion to strike.”) The Board has also denied a motion to exclude, evaluated the scope of the petitioner’s reply, and declined to consider new argument

and evidence. *F5 Networks, Inc. v. Radware, Ltd.*, IPR2017-00124, Paper 48 at 68 (PTAB April 23, 2018).

Intel’s Petition did not contain, suggest, or reserve any indication that EM simulations would be necessary to meet its burden to demonstrate unpatentability. Paper 2. The Simulation Evidence does more than just elaborate on prior arguments; it patches a hole in the evidence submitted with the Petition. None of the cited authorities permit the Simulation Evidence.

B. The Institution Decision was not an invitation to submit evidence that should have been submitted with the petition.

The Institution Decision invited the parties to develop the record regarding a POSITA’s understand of EM field characteristics from Taniguchi’s loop structure. Paper 10, 19. Intel exceeded that purpose and relied on the Simulation Evidence to patch its obviousness argument regarding the *reduced far field* and *reduced electromagnetic field* claim limitations.¹ Paper 19, 17.

Intel should not use the invitation in the ID to “develop the record” to introduce new evidence to fill holes in its substantive arguments regarding specific

¹ Intel states it does not need the Simulation Evidence to make a *prima facie* case.

Paper 29, 9.

claim limitations. *Hulu, LLC v. Sound View Innovations, LLC*, 2019 Pat. App. LEXIS 11904, * 7, IPR2018-01039, Paper 29 (PTAB 2019) (Precedential Opinion) (citing CTPG, 73). The Board did not authorize new simulations or technical analyses. A responsive reply does not license Petitioner to cure omissions central to its unpatentability burden.

C. The Simulation Evidence does not respond to arguments in the Patent Owner's Response.

Although Ericsson referenced the '430 Patent's discussion of simulations, it did not submit simulation evidence through Dr. Prucnal in its Patent Owner Response ("POR"). Paper 16, 16. The Simulation Evidence has no relevance to the simulations in the '430 Patent and exceeds the scope of the portions of POR that Intel identified. Paper 29, 8.

Page 17 of the POR discusses Taniguchi's antenna 1 has a strong magnetic field that induces opposing currents in antenna 2 thereby reducing EM field, not because antenna 1 has a reduced EM far field. Paper 16, 17-8.

Pages 32, 46-7, 55-6 & 65 argue a POSITA would not look to PCB art for solving problems with inductors on ICs, *i.e.*, motivation to combine. Paper, 29, 8. Intel does not explain how the Simulation Evidence supports the motivation to combine inquiry.

Page 42 of the POR explains why Taniguchi does not disclose reducing the far field at a predetermined distance. Paper 16, 42.

Pages 43 of the POR relates to the *closely spaced terminals* limitation not the *reduced far field* limitation. Paper 16, 43. Page 51 discusses the lack of motivation to combine Taniguchi and Rostoker. Paper 16, 51.

The Simulation Evidence impermissibly augments Intel's *prima facie* case by injecting technical simulations that establish core unpatentability arguments absent from the Petition. Expansion is not mere clarification. The Simulation Evidence introduces untested field models, graphical outputs, and empirical measurements omitted from the Petition.

D. Prejudice to Ericsson but not to Intel

Ericsson had several choices to address the new Simulation Evidence. It chose to seek to exclude it. Intel argues it does not need the Simulation Evidence. Paper 29, 9 (“In other words, the Simulation Evidence is not needed to meet Petitioner’s burden to make out a *prima facie* case of obviousness.”). If the Board excludes the Simulation Evidence, it does not prejudice Intel.

III. CONCLUSION

The Simulation Evidence was not disclosed with the Petition and exceeds the scope of permissible reply. The Motion to Exclude should be granted.

Date: July 1, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on Tuesday July 1, 2025 a copy of the foregoing Patent Owner Response was served via email the following attorneys for the Petitioner:

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