

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.
NOKIA OF AMERICA CORPORATION,

Petitioners,

v.

ACTIVE WIRELESS TECHNOLOGIES LLC,

Patent Owner.

Patent No. 10,531,443
Filing Date: June 14, 2018
Issue Date: January 7, 2020

Inventors: Zhanping Yin and Toshizo Nogami
Title: PHYSICAL UPLINK CONTROL CHANNEL (PUCCH) FORMAT
ADAPTATION FOR 5TH GENERATION (5G) NEW RADIO (NR)

PATENT OWNER'S PRELIMINARY SUR-REPLY

Case No. IPR2024-00951

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LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	First Amended Docket Control Order, Dkt. 63, <i>Active Wireless Techs. LLC v. T-Mobile USA, Inc.</i> , No. 2:23-cv-00261-JRG-RSP (E.D. Tex. June 14, 2024)
2002	Defendants' Joint Patent L.R. 3-3 Invalidity Contentions and Subject Matter Ineligibility Contentions, <i>Active Wireless Techs. LLC v. T-Mobile USA, Inc.</i> , No. 2:23-cv-00261-JRG-RSP (E.D. Tex.), served June 28, 2024

I. PETITIONER FAILS TO SHOW ANY INCONSISTENCY

Patent Owner's expert report is consistent with Paper No. 7, Patent Owner's Preliminary Response (the "POPR"). Both parties agreed to the plain and ordinary meaning of "the CBG based HARQ-ACK corresponding to the PDSCH which is *scheduled in* a [common] / [UE-specific] search space [(CSS)] / [(USS)]." See POPR at 7 (citing Paper No. 1 ("Pet."), at 9); Paper No. 8 ("Reply"), 1. Petitioners agree that Patent Owner's expert report in the related District Court Litigation uses this interpretation. To manufacture a claim construction dispute, Petitioner creates a strawman interpretation of the claim limitation (which no party followed) that "the PDSCH itself is transmitted in a search space (CSS/USS)" and attributes that different interpretation to the POPR. Reply at 1, 3 (alleging that the POPR "argued the prior art was deficient for not showing *PDSCH [itself is transmitted] in the search spaces.*") (emphasis added). This strawman is not confirmed by the POPR.

First, as a preliminary matter, if Petitioners believed any claim terms had multiple interpretations, as they assert, they had a duty to identify "how the challenged claim is to be construed" in their Petition. 37 CFR. § 42.104(3); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide, at 48. Petitioners' failure to do so is another reason the Petition should be denied institution.

Second, as the Reply acknowledges, the POPR argues that "the Petition [] assumes with no evidence that the disclosed downlink data (DL data) somehow

corresponds to the PDSCH scheduled in a CSS.” Reply at 3 (citing POPR at 17). Every single other one of the Reply’s citations to the POPR highlights Patent Owner’s consistent position disputing that the disclosure of DCI or downlink data in Wang and Yang “*somehow corresponds* to the PDSCH scheduled in a [CSS] / [USS].” POPR at 11, 14, 17, 19 (emphasis added). Nowhere does the POPR describe that the disclosed DCI must be the PDSCH itself, but only that it “corresponds” to the scheduled PDSCH. It is unclear how Patent Owner’s recitation of the verbatim claim language, “scheduled in a [CSS] / [USS],” is a new interpretation that “the PDSCH itself is transmitted in a search space,” rather than the plain and ordinary meaning that the PDSCH is scheduled in a CSS/USS through, for example but not limited to, a PDCCH, the same interpretation utilized by the expert report in the related District Court Litigation. Reply, at 1.

II. ANY ARGUMENT CLARIFICATION SHOULD BE REJECTED

The Reply dedicates one out of three pages to clarify its Petition’s arguments, rather than respond to the POPR or discuss the alleged inconsistency between the POPR and expert report. Reply, at 2. The Board should reject Petitioners’ attempt to rewrite the Petition as outside the scope of the Board’s Nov. 5, 2024 email authorization for a reply as to “Petitioner’s allegation that ‘Patent Owner filed an expert report in the related litigation that contradicts Patent Owner’s substantive positions in the POPR’” and as a clear misuse of the Board’s time and resources.

See, e.g., Beckman Coulter, Inc., v. Sirigen II Ltd., IPR2022-01208, Paper 14, 9 (P.T.A.B. May 11, 2023) (rejecting Petitioner’s arguments in a Preliminary Reply as “beyond the scope of reply authorized by the Board” for “seeking to address not only the proper construction of [a] term” but also “why Petitioner should prevail even under Patent Owner’s proposed construction”).

Petitioners’ argument is still unavailing. The POPR described that mere disclosure of Wang or Yang’s generic DCI or DL data transmitted in a CSS or USS, described by the Reply again, is insufficient because Petitioner’s citations to do not describe whether the disclosed DCI or DL data transmitted in a CSS or USS necessarily has a relation to the claimed PDSCH (*e.g.*, that the DCI was transmitted through a PDCCH that scheduled the PDSCH in the disclosed CSS/USS). *See* Reply at 2 (citations omitted);¹ POPR, 10-11, 14, 17, 18-19. Because no relationship is established, the Petition fails to describe how Wang or Yang disclose the “CBG based HARQ-ACK *corresponding to the PDSCH.*” *Id.*

III. CONCLUSION

Because Petitioners mischaracterize the record and improperly attempt (and fail) to repair their flawed Petition, the Board should deny institution of the Petition.

¹ The references to PDCCH in the Reply are “Pet., §IV.F.3” and “Pet., §IV.F.4” (presumably a mistake and meant to be §V since §IV is “Reasons for the Requested Relief”) are related to the amorphous “State of the Art” rather than Wang or Yang. Reply, at 2. Petitioner’s attempt to tie its expert’s description of PDCCH in the “State of the Art” to the generic DCI or DL data of Wang or Yang is misleading.

Respectfully submitted,

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CERTIFICATE OF SERVICE

A copy of the foregoing Patent Owner's Preliminary Sur-Reply has been served on Petitioners' counsel of record as follows:

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