

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBIQUITI INC.,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Case IPR2024-01290
Patent 8,594,122

PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE

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CASE LAW

Inverness Med. Switz. GmbH v. Warner Lambert Co., 309 F.3d 1373 (Fed. Cir. 2002).

Omega Eng’g, Inc. v. Raytek Corp., 334 F.3d 1314 (Fed. Cir. 2003)

Abbott Labs. v. Sandoz, Inc., 566 F.3d 1282 (Fed. Cir. 2009)).

Grober v. Mako Prods., Inc., 686 F.3d 1335 (Fed. Cir. 2012)

Avid Tech., Inc. v. Harmonic, Inc., 812 F.3d 1040 (Fed. Cir. 2016).

I. THE BOARD SHOULD REJECT PO'S CONSTRUCTIONS

Claim 1 recites, “the second communication frame follows after a short inter frame space (SIFS) after the first communication frame.” The other independent claims recite a similar limitation. Patent Owner (PO) relies upon the prosecution history to contend that the limitation means that the second communication frame follows substantially immediately after the first communication frame (without any intervening response to the first communication frame). The Board should reject the PO's construction. At the outset, the plain and ordinary meaning is sufficiently broad to be inclusive of multiple embodiments. Specifically, a plain meaning read of “the second communication frame follows after a short inter frame space (SIFS) after the first communication frame” includes both “substantially immediately after the first communication frame” and situations where there is an intervening response to the first communication frame, such as a CTS or ACK.

A. The Plain Language Supports a Broad Construction

The claim language recites: “**follows after** a short inter frame space (SIFS) after the first communication frame.” The claim does not place a boundary on “after” such that it must occur “substantially immediately.” Thus, “after” encompasses a time period that extends beyond “substantially immediately after.” Moreover, this is a natural reading of “follows.” It no different than the classic movie trope where someone announces “we are being followed”—even though the

rear-view mirror shows intervening vehicles preceding the suspected follower.

Viewed in this light, the plain language of cancelled claim 2 (“after the first communication frame”) encompasses the scenario of cancelled claim 3 (“after a response to the first communication frame”) rather than reflects a mutually exclusive scenario.

B. The Specification Supports a Broad Construction

The ’122 patent specification introduces SIFS by stating unequivocally that the “indicated transmission may start after a [SIFS], **but there is no strict requirement on timing.**” ’122 patent, 4:67-5:2 (emphasis added). That said, half of the embodiments expressly described by the ’122 patent specification include an intervening transmission. *See, e.g., id.*, FIGS. 3-5, 8-9 and accompanying text. Indeed, the specification clarifies that even for the FIG. 5 embodiment relied on in the POPR, and like the FIGS. 3-4 embodiments, the indicated transmission “may follow SIFS **after a possible transmission** by the receiver of the [intervening] CTS.” *Id.*, 5:57-60 (emphasis added); *see also id.*, 6:23-24 (The ZLF **follows** ... SIFS **after** the ACK for immediate ACK (emphasis added)); Petition, 11-12 (describing that 802.11 uses SIFS for RTS/CTS and ACK).

The POPR’s assertion that the patentee has defined SIFS is backwards. The statement “follows substantially immediately (i.e., SIFS) after the frame” does not define “SIFS” to mean something. Rather, it defines “substantially immediately ...

after” to mean “SIFS ... after.” The claims do not include the phrase “substantially immediately.” But even assuming the POPR’s definition, the claim language would still read “**after** [substantially immediately] ... after.” Adopting the POPR’s construction would render the first “after” superfluous.

The specification only adds to the ambiguity of the cancellation of claims 2 and 3 rather than clarifying the applicant’s intent. For example, the specification describes a situation where the ZLF “follows **within** a SIFS.” ’122 patent, 6:22-23. This “within a SIFS” language clouds the POPR’s “i.e.” argument. It may be that the claims simply exclude this “**within** a SIFS” situation, favoring the other embodiments of “after SIFS,” with or without an intervening response frame.

Specifying SIFS in the claims has other important implications to aid in claim interpretation, and is not meaningless. The concept of SIFS is used to “separate transmissions belonging to a single dialog.” *Id.*, 5:2-6; Petition, 20-21. By specifying SIFS, the claims clarify that the ZLF is transmitted within a dialog, such as a QoS/ACK or RTS/CTS dialog, as opposed to later, outside the dialog, where another node’s transmission can “falsely [get] interpreted as the indicated transmission.” ’122 patent, 5:10-15, claims 3-8, FIGS. 3-4 & 8-9; Petition, 20-21.

The resulting structure from the claim amendment in question also serves the purpose of mirroring the illustrated embodiments. *See, e.g.*, Petition, 20-23. Dependent claims 3-5 (RTS/CTS) and claims 6-8 (QoS/ACK) reinforce that the

independent claims are to be read broadly. Claim 5 is the first claim that positively recites the first station transmitting the second communication frame. Claim 5 depends from claim 4 and uses the “further comprising” language. As a result, Claims 3-5 mirror the transmission sequence depicted in FIGS. 3 and 8. Likewise claims 6-8 mirror the transmission sequence in FIGS. 4 and 9.

C. No Clear and Unmistakable Disclaimer

The POPR’s reliance on the examiner’s amendment as evidence of prosecution disclaimer is misguided. The Federal Circuit has long held that there is a “heavy presumption” that claim terms carry their ordinary meaning unless the patentee “expressly relinquished claim scope during prosecution.” *Omega Eng’g*, 334 F.3d at 1323. For prosecution disclaimer to attach, the alleged disavowing actions made during prosecution must be both “clear and unmistakable.” *Id.*, 1326. The Federal Circuit has “declined to apply the doctrine of prosecution disclaimer where the alleged disavowal of claim scope is ambiguous.” *Id.*, 1324; *see also Grober*, 686 F.3d at 1341; *Abbott Labs.*, 566 F.3d at 1289. Here, the examiner twice rejected claims 2 and 3 using the identical disclosure from Larsson. UBIQUITI-1002, 562-63, 666. The examiner interpreted these claims to have sufficient overlap that a single disclosure from a single reference was sufficient to reject them both. The Applicant, however, made no arguments on the record specifically pertaining to claims 2 and 3 to remove any ambiguity in the

Applicant's intent, even after the allowance. *Id.*, 549, 654. Therefore, no prosecution disclaimer should attach.

Moreover, the Federal Circuit has declined to find disclaimer when the alleged disavowal was "amendable to multiple reasonable interpretations." *Avid Tech.*, 812 F.3d at 1045. "It is inappropriate to limit a broad definition of a claim term based on prosecution history that is itself ambiguous." *Inverness*, 309 F.3d at 1382. Here, the alleged disavowal stems from an examiner's amendment that resulted in a claim term having a plain meaning "amenable to multiple reasonable interpretations," as shown above. Thus, even if the examiner's amendment qualifies as an alleged disavowal (which it does not), the results are ambiguous.

II. THE PETITION DOES NOT RELY ON INHERENCY

Gu expressly teaches ZLF for sounding. *E.g.*, Petition, 29, 43-51; UBIQUITI-1003, 28-34, 80, 104-107. In addition, Gu expressly teaches sending an indication that zero length frames for sounding are forthcoming. *E.g.*, Petition, 29, 43-51; UBIQUITI-1003, 28-34, 80, 104-107. Because the format of the sounding frames is known by both the transmitter and receiver, the indication of the ZLF for sounding is an express teaching of alerting the receiver that the forthcoming packet will not include the address of the receiver. *Petition.*, 49; UBIQUITI-1003, 104-107. Contrary to POPR's attorney argument, the Petition provides factual support and expert testimony in support of its conclusions.

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on January 16, 2025, a complete and entire copy of this Petitioner's Reply to Patent Owner's Preliminary Response was provided by email, to the Patent Owner, by serving the correspondence address of record as follows:

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