

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBIQUITI INC.,

Petitioner,

v.

INTELLECTUAL VENTURES I, LLC,

Patent Owner.

Case No. IPR2024-01290

U.S. Patent No. 8,594,122

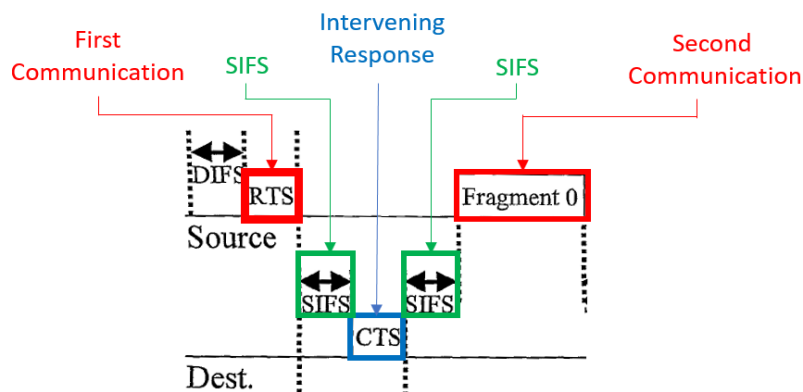
PATENT OWNER'S PRE-INSTITUTION SUR-REPLY

TABLE OF CONTENTS

I.	PETITIONER’S CLAIM CONSTRUCTION POSITION IS FLAWED	1
II.	GU DOES NOT EXPRESSLY DISCLOSE THE ABSENCE OF A RECEIVER ADDRESS.....	5

I. PETITIONER’S CLAIM CONSTRUCTION POSITION IS FLAWED

The Reply ignores the context in which the Examiner cancelled dependent claim 3. Just prior to the interview resulting in allowance, independent claim 1 broadly recited that a second communication frame “will follow the first communication frame” (Ex.1002, 510). Larsson (the primary reference raised by the Examiner) met that limitation. However, Larsson included an intervening response between the first and second communications, as shown by the portion of Figure 5 of Larsson reproduced below (colored annotations added):



To distinguish claim 1 from Larsson, claim 1 needed to be amended to exclude an intervening response. In that context, the Examiner initiated the interview to incorporate the SIFS limitation from dependent claim 2 (requiring the second frame to follow after a SIFS (i.e., substantially immediately) after the first communication frame) into claim 1. The Examiner simultaneously required the cancellation of dependent claim 3 because the intervening response recited in dependent claim 3 was inconsistent with the amended claim 1. There is no other plausible explanation for why, when faced with Larsson’s disclosure of an intervening response, the

Examiner initiated an interview to incorporate the SIFS limitation of dependent claim 2 into claim 1, and cancel dependent claim 3, which, like Larsson, included an intervening response. The “single dialog” theory conjured by Petitioner in the Reply (at 3) fails to distinguish Larsson’s sequence, which is a single-dialog.

In *Board of Regents v. BENQ Am. Corp.*, 533 F.3d 1362, 1369-1370 (Fed. Cir. 2008), the Federal Circuit rejected a proposed claim construction that conflicted with the prosecution history and would have rendered the amendments made to overcome prior art distinctions nonsensical—a principle directly relevant to the present case, where Petitioner’s overly broad construction similarly disregards the prosecution history and would encompass prior art expressly distinguished during prosecution. There, the original independent claim recited matching pre-programmed codes with “an alphabetic character string.” In order to distinguish Rabiner, which disclosed matching pre-programmed codes to words, the Applicant replaced “an alphabetic character string” in the independent claim with “one or more syllabic elements” and cancelled two dependent claims, both of which recited matching pre-programmed codes with words. In rejecting a proposed construction of “one or more syllabic elements” that included “words,” the Court stated:

If, as the Board of Regents proposes, “syllabic element” were broadly defined to include letter groups having any number of syllables, then all words would also be syllabic elements (because every word is a single- or multisyllabic letter group). This construction, however, does not square with the prosecution history. As noted above, claim 10 originally recited matching with an alphabetic character string, while one of its dependent

claims specified that this string comprised a word. After the examiner identified a reference that showed matching with a word, the Board of Regents limited claim 10 to require matching with syllabic element(s) and canceled the dependent claim that required matching with words. The cancellation of this dependent claim indicates that the set of “syllabic elements” does not include all words. Moreover, if “syllabic elements” included words, then Rabiner’s disclosure of matching with words would teach the portion of claim 10 that was amended to distinguish Rabiner. We decline to adopt a construction that would effect this nonsensical result. (emphasis added).

Like the “nonsensical result” rejected in *Board of Regents*, the construction proposed by the Petitioner here “does not square with the prosecution history.” On the contrary, Petitioner seeks to read claim 1 so broadly that it covers the exact reference (Larsson) that was expressly overcome during prosecution.

To bolster their position, the Reply describes a “movie trope” and then argues that, when “[v]iewed in this light, the plain language of cancelled claim 2 ... encompasses the scenario of cancelled claim 3” (Reply, 1-2, emphasis added). However, under *Phillips*, claims are not construed in the light of a “movie trope”; instead, claims are construed based on the prosecution history. If, as Petitioner argues, claim 3 was encompassed by claim 1 after claim 1 was amended to incorporate dependent claim 2, there would have been no reason for claim 3 to have been cancelled. Petitioner’s argument leads to the nonsensical finding that the Examiner required the cancelation of claim 3 despite there being no reason to do so.

The Reply refers to the statement in the specification that the “indicated transmission may start after a short interframe space (SIFS), but there is no strict

requirement on timing” (Reply, at 2, citing ’122 Patent, 4:67-5:2). Here, the juxtaposition of “after a short interframe space (SIFS)” against “but there is no strict requirement on timing” is telling. The juxtaposition makes clear that the first phrase -- “after a short interframe space (SIFS)” (as used in the claims) -- connotes a strict requirement on timing, while the second phrase -- “but there is no strict requirement on timing” -- indicates that other disclosed embodiments (not claimed) need not adhere to this requirement (see, e.g., POPR, at 25-26, citing authority that claims need not cover all disclosed embodiments).

The Reply (at 2-3) argues that “follows substantially immediately (i.e., SIFS)” does not define “SIFS” to mean “substantially immediately,” but rather defines “substantially immediately” to mean “SIFS.” This is a false distinction. The meaning of SIFS is the same regardless of whether “substantially immediately” means SIFS, or SIFS means “substantially immediately.” Accordingly, this semantic argument is without substantive impact.

The Reply fails to dispute that Petitioner’s proposed construction that the second frame follows the first frame by *at least* a SIFS renders the final wherein clause of claim 1 completely redundant (see, POPR, at 23-25). Instead, the Reply (at 3) argues that PO’s construction would render the first “after” superfluous. Not so. Claim 1 recites, “the second communication frame follows after a short inter frame space (SIFS) after the first communication frame.” The first “after” makes clear the

second frame comes after the SIFS, and the second “after” makes clear that the SIFS is after the first frame. Without the first “after,” it would be unclear whether “the second communication frame” follows before or follows after “a short inter frame space (SIFS) ...” The first “after” removes such ambiguity.

Petitioner argues that the specification’s statement that “[t]he ZLF follows within an SIFS for no ACK...” undermines Patent Owner’s argument (Reply, at 3). However, Petitioner’s argument hinges on the assumption that the phrase “within an SIFS” encompasses time spans shorter than a SIFS. Such an interpretation is illogical in the context of claim 1 because the ’122 Patent explicitly defines a SIFS as “the minimum inter-frame space” (’122 Patent, 5:4), precluding the possibility of a time span shorter than a SIFS between the first and second communication frames.

II. GU DOES NOT EXPRESSLY DISCLOSE THE ABSENCE OF A RECEIVER ADDRESS

Gu’s statement that its sounding packets “can be limited to a preamble and header without data” is not an express disclosure that such packets lack a receiver address. *In no way, shape, or form does Gu’s statement expressly say that such packets lack a receiver address.* None of the Petition’s citations for this so-called express disclosure remotely demonstrate that Gu expressly discloses packets lacking a receiver address (see Petition at 48). In fact, §7.3.3.6 of Ex.1010 does not exist, and the teachings of the ’122 Patent are not prior art (see POPR at 48-49). The Reply does not even attempt to resuscitate any of these flawed citations.

Respectfully submitted,

Dated: January 23, 2025

By: /Daniel H. Golub/

Daniel H. Golub

Registration No. 33,701

Counsel for Patent Owner

Intellectual Ventures I LLC

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **PATENT OWNER'S PRE-INSTITUTION SUR-REPLY** was served via email (as consented to by counsel) on January 23, 2025 to lead and backup counsel of record for Petitioners as follows:

David Conrad, Reg. No. 60,788
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402

Rishi Gupta, Reg. No. 64,768
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402

Email: IPR48642-0018IP1@fr.com
PTABInbound@fr.com

Dated: January 23, 2025

By: /Daniel H. Golub/
Daniel H. Golub
Registration No. 33,701
Counsel for Patent Owner
Intellectual Ventures I LLC