

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HP INC., DELL TECHNOLOGIES INC., DELL INC., AND
LENOVO (UNITED STATES) INC.,

Petitioners,

v.

UNIVERSAL CONNECTIVITY TECHNOLOGIES INC.,

Patent Owner.

Case IPR2024-01428
U.S. Patent No. 7,154,905

**PATENT OWNER'S SUR-REPLY TO
PETITIONERS' REPLY**

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I. Petitioners fail to meet their burden by failing to propose an explicit construction of “out-of-band” or refuting Patent Owner’s showing that neither Banes nor Calvignac disclose indicators including out-of-band symbols.

“In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”

Harmonic Inc. v. Avid Tech., Inc., 815 F.3d 12356, 1363 (Fed. Cir. 2016).

“The burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ 35 U.S.C. § 316(e), and that burden never shifts to the patentee.” *FanDuel, Inc. v. Interactive Games LLC*, 966 F.3d 1334, 1341 (Fed. Cir. 2020). Part of meeting that burden is identifying “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 422.104(b)(3).

That burden is not met by arguing how not to construe the claim, or by asserting how an element might, can be, or typically would, meet a claim limitation without ever identifying how the challenged claim is to be construed. Petitioners have assiduously avoided propounding a proposed construction for either “in-band” or “out-of-band” despite their apparent recognition that the proper construction of these terms is at issue. Paper 10, Reply, 1-3. By not doing so, Petitioners have failed to meet their burden and institution should be denied.

One consequence of Petitioners' efforts to avoid taking a definitive position on claim construction is their failure to meet their burden and refute Patent Owner's arguments.¹ Instead, Petitioners address a strawman argument, ignoring the POPR's assertions that "the process by which a symbol was placed in the packet" is not determinative of whether it is in-band or out-of-band (Paper 9, POPR, 21, 27) and Petitioners do not contend that an inserted symbol is necessarily "out-of-band." Petitioners do not meet their burden by arguing "can be," "typically," or "normally."² Reply, 2-3. Petitioners' arguments, *id.*, about what can be,

¹ Petitioners wrongly assert that Patent Owner does not dispute that Banes and Calvignac disclose the claimed "preempt" and "continue" indicators. Reply, 1. The POPR noted that Banes's interrupt code "allegedly" corresponded to the preempt indicator, POPR, 18, conditioned the argument "if the continue indicator corresponds to the resume code," *id.*, 22, and quoted Calvignac's description of using an HDLC in-band trailer to "indicate." *Id.*, 26. The POPR did not include a full discussion of every deficiency in the Petition. *Id.*, 29 n.4.

² "Do or do not. There is no try." Yoda, *The Empire Strikes Back* (1980).

or typically is, in a packet fall short of establishing what is an “out-of-band” symbol in the properly construed challenged claims. It is Petitioner’s burden to establish that the alleged “indicators” include “out-of-band” symbols. Petitioners’ unwillingness to proffer a construction for “out-of-band” symbols in the challenged claims precludes them from identifying how the challenged claims are construed or satisfying their unshifting burden of persuasion.³

II. The *Fintiv* Factors Weigh Against Institution

Factor 1: Petitioners’ argument that this factor disfavors denial because no stay has been requested in the LGL Case is flawed. There is no dispute that the LGL Case has not been stayed, nor is there any

³ Petitioners’ footnote argument about the number of transitions, Reply, 3 n.1, improperly seeks to import a limitation from the specification and is ambiguous as to whether out-of-band symbols should be construed as having 3 or less transitions. “[I]t is important not to import into a claim limitations that are not part of the claim.” *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

evidence that a stay would be granted if a proceeding is instituted. This factor favors denial.

Factor 2: Petitioners allege that the trial date of the LGL Case is “speculative” but provide no evidence to support this contention. Paper 10, Reply, 4. However, both the scheduled trial date and the date of trial based on median time-to-trial statistics occur many months before a final written decision would be expected in this forum. And, as discussed further for Factor 4, the *Sotera* stipulations do not remove concerns regarding the timing of trial with respect to a final written decision.

Factor 3: Petitioners do not dispute the substantial investment in resources already devoted to the LGL Case. Petitioners also cannot dispute that claim construction is ongoing. Opening, responsive, and reply briefs are due on March 28, April 11, and April 18. Petitioners’ *Sotera* stipulations do not eliminate the investments the parties have already made in district court.

Factor 4: Petitioners do not dispute the complete overlap in the arguments and evidence presented in the Petition and in district court. Petitioners’ contention that their *Sotera* stipulations remove all concerns regarding this overlap is unsupported here. In fact, as shown by the

Sotera stipulations (*see, e.g.*, EX1018 at 1 n.1) and the district court invalidity contentions (*see, e.g.*, EX2002 at 16-17), Petitioners have expressly reserved the right to challenge invalidity at the district court based on the same references relied upon here in combination with “any system, product, or public knowledge or use that embodies” any of the identified prior art patents or printed publications.” Thus, their *Sotera* stipulations notwithstanding, it appears that Petitioners will present the same arguments in district court that they have presented here under the guise of a “system art” combination whose only purpose is to avoid their commitment under the stipulations.

Factor 5: Petitioners’ argument ignores the Board’s express language in *Fintiv II*. In addition, Petitioners provide no support for their contention that this factor is neutralized when less than all parties to the IPR proceeding are also parties to a district court litigation involving the same patent.

Factor 6: As discussed in the POPR, the Petition fails to address a limitation of all of the challenged claim and relies upon duplicative prior art, the gist of which was substantively considered by the Patent Examiner. All six *Fintiv* factors strongly favor discretionary denial.

Date: March 17, 2025

Respectfully submitted,

/Brett Cooper/

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on March 17, 2025, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioners:

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