

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,

Petitioner,

v.

INTELLECTUAL VENTURES II, LLC,

Patent Owner

Case No. IPR2025-00219

U.S. Patent No. 9,706,500

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
STRIKE A PORTION OF PATENT OWNER'S SUR-REPLY**

Petitioner's Motion To Strike Section I of the Sur-Reply should be denied. Section I of the Sur-reply was a proper response to Petitioner's "bodily incorporation" position advanced in the Reply (at 1, 8-9).

The Patent Owner Response (POR) explained that Ground 1 was deficient because Anderson and Khan failed to disclose "receiving, on a single physical channel, an allocation of an uplink resource and a multi-level transmit power control (TPC) command" because they "use fundamentally incompatible channel multiplexing structures" and the combination would have "required a substantial re-design." POR, 30-32 (emphasis added). As the Patent Owner Response stated:

In Khan's time domain multiplexing embodiment, the forward link is organized into time-multiplexed slots, where different types of control information such as TPC bits and scheduling grants can be transmitted in distinct fields within the same downlink slot. This slot-by-slot time-multiplexing is fundamentally different from the control channel described in Andersson. Andersson discloses a DPCCH in which every 0.625 msec uplink slot carries a fixed structure of control fields, a TPC command ...and other bits, repeated in each slot ... Because these channels operate with different multiplexing structures, combining them would not have been a predictable or natural design choice. Andersson's DPCCH simply could not have predictably supported dynamic scheduling assignments. POR, 36 (citations omitted).

* * *

Under *KSR*, obviousness requires that the prior art be combined "in the same way" to achieve predictable results. Here, the combination fails on both counts. Andersson's WCDMA dedicated physical channels, uplink DPCCH, and downlink DPCH, were defined as continuous streams with fixed slot structures. ... Khan's HRPD disclosure arises from a different technology family, in which the forward link was explicitly organized into time-multiplexed slots that could carve out

separate fields for TPC commands and scheduling grants. A POSITA in 2004 ...would not have viewed these channels as operating “in the same way,” nor would they have expected predictable results from trying to merge them. TPC commands must be transmitted continuously and with extremely high reliability in every slot to maintain closed-loop power control, whereas scheduling information is larger, bursty, and tied to a different timing cycle. Attempting to combine these functions within the fixed structures of the DPCCH/DPCH would either disrupt the timing-critical TPC stream or constrain scheduling flexibility, undermining both. ...A POSITA therefore would have recognized that putting TPC and scheduling together on these channels was not a predictable or natural design choice ... POR, 36-38 (emphasis added).

Petitioner responded in the Reply (at 1, 8-9) by arguing that bodily incorporation is not required to establish obviousness, and Patent Owner properly countered in the Sur-Reply (at 3) that “Petitioner’s Reply does not cure the ‘allocation’ defect.” Even absent bodily incorporation, Petitioner still bears the burden of explaining why a person of ordinary skill in the art would combine the reference and how they would arrive at the claimed invention. In the Sur-Reply (at 1-4), Patent Owner properly explained that the Petitioner still failed to explain how a POSITA would have arrived at the claimed invention by failing to identify within the “fundamentally incompatible channel multiplexing structures” (POR, 32) of Andersson and Khan: “(1) what the “uplink resource” is in the asserted system, (2) what it means to “allocate” that resource, and (3) where, when, and how the UE receives the allocation such that the subsequent uplink transmission is ‘on the

allocated uplink resource.” Sur-Reply, 1-4. Pointing out that this gap still remained, even absent bodily incorporation, was entirely appropriate.

The POR similarly explained that Ground 4 was deficient because Zierra and Khan also “use[d] fundamentally incompatible multiplexing structures.” POR, 51. With respect to Ground 4 as well, Petitioner responded in the Reply (at 21-22) by arguing that bodily incorporation is not required to establish obviousness, and Patent Owner properly countered in the Sur-Reply (at 3) that “the same defect is even more stark in the Zierra grounds.” Again, even absent bodily incorporation, Petitioner still must explain why and how a POSITA would have arrived at the claimed invention. In the Sur-Reply (at 4-5), Patent Owner properly pointed out that the Petitioner still failed to explain how a POSITA would have arrived at the claimed invention because “Petitioner never identifies what that “uplink resource” is in ... Zeira, never identifies an allocation field that designates it, and never ties the alleged “grant” to the specific uplink resource “on” which the UE transmits.” Again, pointing out that this gap still remained even absent bodily incorporation was entirely appropriate.

For the foregoing reasons, Petitioner’s Motion To Strike Section I of the Sur-Reply should be denied.

Respectfully submitted,

Dated: March 17, 2026

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO STRIKE A PORTION OF PATENT OWNER'S SUR-REPLY** was served via email (as consented to by counsel) on March 17, 2026 to lead and backup counsel of record for Petitioners as follows:

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