

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. IPR2025-00220
U.S. Patent No. 11,206,670

PATENT OWNER'S SUR-REPLY

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PATENT OWNER'S EXHIBIT LIST

EX2001	Petitioner's Answer to Complaint and Counterclaim, dated June 20, 2024, in <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)
EX2002	Docket from District Court Litigation, <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)
EX2003	Scheduling Order from District Court Litigation, <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)
EX2004	Defendant's Second Supplemental Preliminary Invalidity Contentions, dated January 9, 2025, in District Court Litigation, <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)
EX2005	File History of U.S. Patent Appl. 14/372,363
EX2006	Declaration of Todor V. Cooklev, Ph.D.
EX2007	Curriculum Vitae of Todor V. Cooklev, Ph.D.
EX2008	<i>Modern Communications Systems: A First Course</i> Cooklev et al. (Michigan Publishing 2024)
EX2009	<i>LTE – The UMTS Long Term Evolution From Theory to Practice</i> (Second Edition) Sessia et al. (John Wiley & Sons Ltd. 2011)
EX2010	Declaration of Gary R. Lomp, Ph.D.
EX2011	Curriculum Vitae of Gary R. Lomp, Ph.D.

I. INTRODUCTION

The Reply fails to remedy the major substantive defects in the Petition. More specifically, the Reply fails to demonstrate that Wallen discloses or renders obvious Elements [1.4] and [1.6], or that Wallen is prior art against the ‘670 Patent. For these reasons which are explained in detail below, the Board should enter a Final Written Decision finding that the Petitioner has failed to prove the unpatentability of any of the challenged claims.

II. THE PETITION FAILS TO DEMONSTRATE HOW WALLEN DISCLOSED OR RENDERED OBVIOUS ELEMENTS [1.4] AND [1.6] AS ARRANGED IN THE CLAIM

The Petition failed to explain how Wallen satisfied Elements [1.4] and [1.6]. The Reply fails to cure this defect in the Petition.

A. Wallen Distinguishes Between An M-SIB Which Is A Special Information Block For Use Only By An MTC Device And A Legacy SIB Such As SIB1

The sole ground of the Petition relies on Wallen (EX1005) as the primary reference. Wallen identifies two types of devices. First, Wallen defines a “legacy terminal” as “[a]ny terminal UE designed in accordance with earlier versions of LTE.” EX1005, [0011]. Wallen also refers to a legacy UE both as “a standard-compatible” UE, and as “a first type of communication device capable of receiving a signal having a full bandwidth of the cellular communication system (‘first bandwidth’).” *Id.*, [0042], [0043] and [0047]. Second, Wallen defines an “MTC

device” as “a second type of communication device” that “is capable of receiving a signal no larger than a second bandwidth, wherein the second bandwidth is smaller than the first bandwidth.” *Id.*, [0042].

Wallen discloses that “the network node can allocate some of its resources, including special MTC-oriented control and data channels, to occupy no more than the second bandwidth.” *Id.*, [0043]. Wallen then defines “a new set of entities ... [s]uch as physical channels and system information, targeting communication with MTC devices” and denotes the new entities throughout the specification “by adding the prefix ‘M-’ to the more traditional term.” *Id.* Wallen draws a clear distinction between the aspects of a host cell that support MTC devices (which Wallen refers to as an “M-Cell”) and the “[r]emaining resources” that are “used to support the fully capable, legacy communication devices (i.e., the ‘first type of communication devices’).” *Id.*

As noted above, Wallen defined “a new set of entities” including new “system information, targeting communication with MTC devices” and denoted these entities throughout the specification “by adding the prefix ‘M-’ to the more traditional term.” *Id.* One new entity defined by Wallen was “a special system information block” or “M-SIB” that “includes information that is necessary for use by the second type of communication device.” *Id.*, [0020]-[0021]. In contrast to an M-SIB used by an MTC device, Wallen used the term “SIB” (without an ‘M-’ prefix) to refer to a system

information block received by a standard-compatible (or legacy) device. *Id.*, [0008] (“a standard-compliant communication device needs to be able to ... adapt its receiver bandwidth to match that of the system bandwidth in order to be able to receive the SIB”) and [0068] (“the first system information block (SIB1)” is “transmitted in a system standardized location (e.g., in subframe 5 in an LTE system). The first SIB, which is a legacy SIB”).

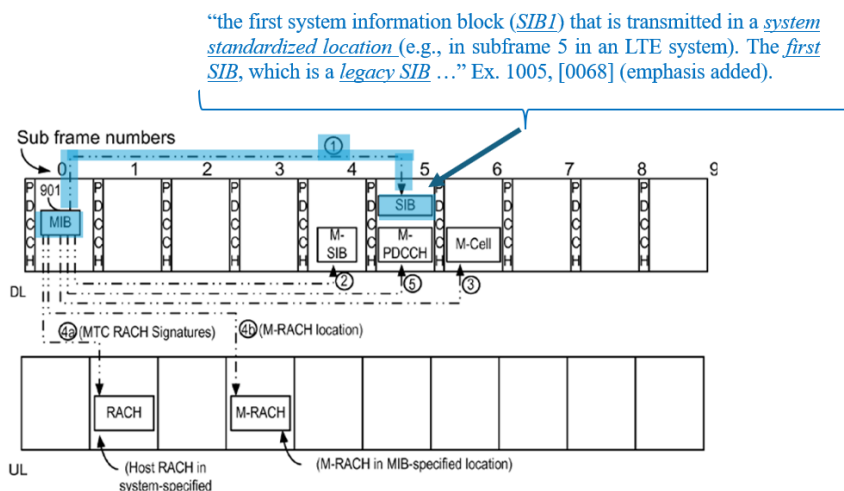
Thus, when Wallen refers to an M-SIB, Wallen is referring to a system information block that is to be used by an MTC device (Wallen’s “second type of communication device”). Conversely, when Wallen refers to a SIB (without an ‘M-’ prefix), Wallen is referring to a system information block for a standard-compliant or legacy device (Wallen’s “first type of communication device”). Wallen uses the phrase SIB1 only once, and is explicit that SIB1 is a legacy SIB, meaning that it is for use by a standard-compliant or legacy device.

B. Wallen’s Examples “1” And “5”

Wallen discloses several examples in connection with Figure 9. Aspects of Examples “1” and “5” are relied on in the Petition. These two examples are discussed next.

Example “1” is illustrated by the blue highlighting and blue text in the annotated version of Figure 9 below. In this embodiment, the “the MIB 901 ... informs the MTC device of a location of ... the first system information block (SIB1)”

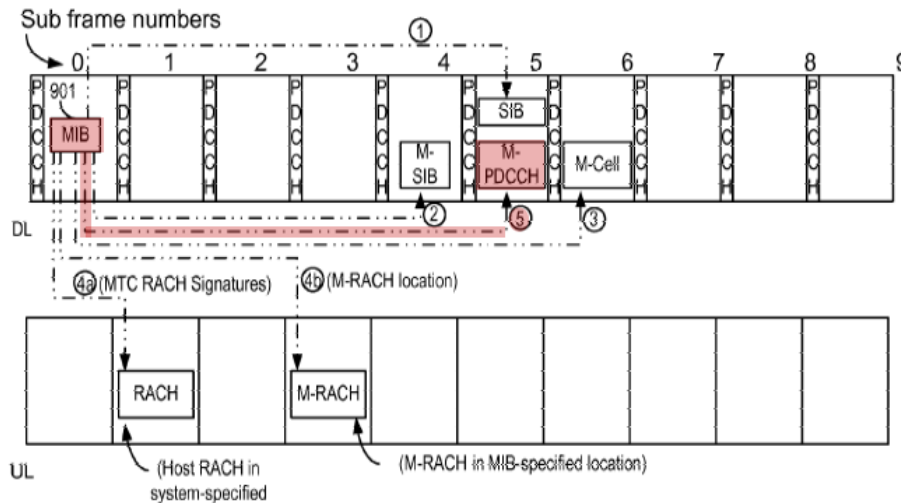
that is transmitted in a system standardized location (e.g., in subframe 5 in an LTE system))” where SIB1 “is a legacy SIB.” *Id.*, [0068] (emphasis added).



Thus, in example 1, the MIB 901 directly informs the MTC device of the location of a legacy SIB which Wallen refers to as SIB1.

The Petition purported to illustrate Example “5” with the red highlighting and red text in the annotated version of Figure 9 included in the Petition (at 51) and reproduced below. In this embodiment “(represented by the number “5” enclosed in a circle), the MIB 901 indicates the resource blocks, reference signal sequence, or search space allocated to a specific M-PDCCH.” *Id.*, [0072]. The M-PDCCH (which bears the ‘M-’ prefix) is “a special physical downlink control channel” that is “adapted for use by the second type of communication device” such as an MTC device. *Id.*, [0024]. “The M-PDCCH supplies control information to the MTC device, including MTC specific SIBs or downlink assignments pointing to the SIBs that are intended for this MTC device.” *Id.*, [0072] (emphasis added).

MIB indicates the time/frequency location of M-PDCCH, which in turn has “control information” such as downlink assignments pointing to SIBs (not shown)



Petition, 51. In example “5,” the MIB 901 “indicates the time/frequency location of M-PDCCH, which *in turn* has ‘control information’ such as downlink control information pointing to” the “*MTC specific SIBs*” or “*SIBs that are intended for this MTC device.*” Petition, 51 (red text above annotated version of Figure 9) and EX1005, [0072].

Thus, in contrast to example “1” where the MIB 901 *directly* informed the MTC device of the location of a *legacy SIB* (*SIB1*), example 5 involved a *multi-step* approach where the MIB first indicates the time/frequency location of M-PDCCH, which *in turn* has control information pointing to *M-SIBs* (referred to in [0072] as “*MTC specific SIBs*” or “*SIBs that are intended for this MTC device*”). It is clear (and would have been clear to POSITA) that, Wallen’s *special* physical downlink

control channel (M-PDCCH) is adapted for use by MTCs to acquire M-SIBs (as disclosed in example 5), and Wallen fails to teach or suggest using Wallen's special physical downlink control channel (M-PDCCH) to acquire a legacy SIB (SIB1). See, EX2010, ¶ 72.

C. The Mappings Of Elements [1.4] And [1.6] Wallen Set Forth In The Petition

Elements [1.4] and [1.6] collectively recite:

[1.4] wherein the MIB includes an indication of frequency resources and time resources for use in acquiring additional system information; and ...

[1.6] wherein the indicated frequency resources and the time resources include control information for use by the UE to acquire a system information block 1.

For strategic reasons relating to its non-infringement position in the district court, the Petitioner distanced itself from a reading of the claim language in which limitations [1.4] and [1.6] would have been satisfied by a MIB that pointed directly to a SIB1,¹ as is the case in Example “1” of Wallen. Instead, the Petition relied on a mapping of the claim language to the multi-step approach of Example “5” of Wallen where the MIB first indicates the time/frequency location of the M-PDCCH, which

¹ Rather than embracing such a reading of the claim language, the Petition disparaged such an interpretation referring to it as “Patent Owner’s apparent understanding” of limitations [1.4] and [1.6]. Petition notes 4 and 5.

*in turn*² has control information pointing to M-SIBs. However, since Example “5” discloses that the control information in the M-PDCCH points to M-SIBs as opposed to a “system information block 1” (or SIB1) as recited in Element [1.6], the Petition needed to find a way to bridge this gap between Example “5” of Wallen and the claim language. The Petition sought to bridge this gap by arguing that it would have been obvious that one of the M-SIBs pointed to by the control information on the M-PDCCH in Example “5” would have included the legacy SIB1 from Example “1.”

From the Petition:

² See, Petition, 51-52 (“ Wallen discloses or renders obvious *the indicated frequency resources and the time resources* (Wallen’s MIB indicates the time/frequency location of *resource blocks allocated to M-PDCCH*) include *control information for use by the UE* (“M-PDCCH supplies control information... intended for this MTC device”) to acquire a *system information block 1* (the “control information” includes ... Wallen’s “*first system information block (SIB1)*”),² thereby disclosing or rendering obvious limitation [1.6]”).

An example of one of Wallen’s “SIBs” is SIB1, as disclosed in Wallen. In fact, SIB1 is the only specific LTE SIB disclosed in Wallen. Moreover, *it would have been obvious that one of Wallen’s “SIBs” that are received includes the disclosed system information block 1 (SIB1)* because SIB1 was known in LTE to carry information essential to connecting to a cell.³ Therefore, *the indication of SIB1 represents simply specifying an implementation detail of which of the known “SIBs” to indicate by Wallen’s M-PDCCH*, and it was obvious, predictable, and beneficial that one of the “SIBs” is a known and essential SIB in LTE, namely, *SIB1*, the only specific SIB disclosed in Wallen. Petition, 51-52 (citations omitted) (emphasis added).

Given the Petition’s obviousness argument, the Petitioner bore the burden of demonstrating that it would have been obvious to implement Example “5” of Wallen such that the control information on the M-PDCCH in Example “5” pointed to an *M-SIB that “includes” the SIB1 (which Wallen disclosed as being a legacy SIB*. As explained next, the Petition failed to meet that burden.

³ In support of the argument that SIB1 was known in LTE to carry “information essential to connecting to the cell,” the Petition (at 52) relied on Sagfors (EX1009). Like Wallen, Sagfors referenced “SIB1” only in the context of existing (*legacy*) LTE systems. EX1009, 3. While there may be evidence that it was essential for *legacy* devices to access the legacy SIB1 in order to access the network, the Petition included no evidence that it would have been essential for Wallen’s *MTC* devices to access a legacy SIB1 to access the network. On the contrary, the fact that Wallen disclosed new entities like M-SIBs is evidence demonstrating that an MTC would have accessed the network using one of Wallen’s new M-SIBs as opposed to a legacy SIB like SIB1.

D. The Petition Failed To Meet Its Burden To Explain Why A POSITA Would Have Been Motivated To Include Wallen's Legacy SIB1 In Wallen's M-SIB

It is undisputable that Wallen discloses M-SIBs that are accessed via the M-PDCCH in Example "5," and separately discloses a "legacy SIB" (referred to by Wallen as SIB1) that is accessed directly by a pointer from the MIB in Example "1." As explained in the POR (at 42-43), the Petition failed to provide any explanation why a POSITA would have used Wallen's M-PDCCH (where the 'M-' prefix indicates that the channel was specifically designed to support Wallen's new MTC devices) as an intermediary through which an MTC device would access a legacy SIB such as SIB1. Given that Wallen (in Example "1") already disclosed that an MTC device could access the legacy SIB (SIB1) directly by a pointer from the MIB, the Petition fails to explain why a POSITA would have been motivated to replace or supplement that solution for directly accessing the legacy SIB (SIB1) with an indirect pathway that used an MTC specific channel (i.e., the M-PDCCH) as an intermediary to access the same legacy SIB1. For example, the Petition did not point to a problem with the direct methodology in Example "1" for directly accessing the legacy SIB (SIB1) that would have been solved by replacing that solution for directly accessing the legacy SIB (SIB1) with an indirect pathway that used an MTC specific channel (i.e., the M-PDCCH) as an intermediary to access the same legacy SIB1. The Reply simply ignores this basic deficiency in the Petition.

E. The New Theory Advanced In The Reply Fails Because Wallen Does Not Expressly Or Inherently Disclose That The M-SIBs Disclosed In Connection With Example “5” Include The Legacy SIB1 From Example “1”

In an effort to pivot to a new theory, the Reply (at 11) argues that “[t]he Petition’s mapping for the disputed limitations did not combine aspects of Wallen’s examples—nor did it need to” because “Petitioner consistently point[ed] to Wallen’s example 5 within elements [1.4] and [1.6].” That assertion defies credulity. The Petition’s analysis of the Element [1.6] expressly relied on the disclosure in Example “1” of Wallen at [0068] stating “[T]he MIB 901 ... includes time/frequency information ... that informs the MTC device of a location of the resource blocks ... allocated to the first system information block (SIB 1)” as well as the allegation that that “[i]n fact SIB1 [which is only disclosed in connection with Example “1” of Wallen], is the only specific LTE SIB disclosed in Wallen.” Petition, 51-52.

The Reply pivots to a new theory that “[t]he Petition cites Wallen’s mention of SIB1 in the content of example 1 only as additional evidence that SIBs include SIB1.” Reply, 11. Before turning to this new narrative in the Reply, it is important to begin with what Example 5 of Wallen actually said. Significantly, Example 5 did not refer to SIBs in general – but was instead expressly limited to only M-SIBs (i.e., SIBs that are specific to an MTC). From Wallen:

... The M-PDCCH supplies control information to the MTC device, including MTC specific SIBs or downlink assignments pointing to the SIBs that are intended for this MTC device. EX1005, [0072] (emphasis added).

The Reply (at 11) argues that Wallen’s mention of SIB1 in the content of example 1 is “evidence that SIBs include SIB1.” However, the Reply glosses over the fact that Example “5” does not describe “SIBs” in general – rather, that embodiment refers only to M-SIBs, i.e., “MTC specific SIBs” or “SIBs that are intended for this MTC device.” The Reply provides no evidence that the “MTC specific SIBs” or “SIBs that are intended for this MTC device” in Example “5” include the legacy SIB referred to in Wallen as SIB1. That is because Wallen says nothing of the sort. Nor does the Reply even argue, much less provide any evidence, that it is somehow inherent in Wallen that the “MTC specific SIBs” or “SIBs that are intended for this MTC device” in Example “5” necessarily must include the legacy SIB referred to in Wallen as SIB1. Thus, the new argument in the Reply that “Wallen’s mention of SIB1 in the content of example 1” is “evidence that SIBs include SIB1” fails to demonstrate that the M-SIBs in Example “5” include the legacy SIB referred to in Wallen as SIB1.

F. Wallen Fails To Suggest The M-SIBs In Example 5 Are Directed To Legacy Information

The Reply (at 12) goes on to make a further new argument that Wallen suggests that its “MTC specific SIBs” or “SIBs that are intended for this MTC device”

in Example “5” are “directed to ‘legacy’ information.” This new argument not only lacks support in Wallen, but is contradicted by the reference.

As explained above, Wallen defines “a new set of entities ... [s]uch as physical channels and system information, targeting communication with MTC devices” and denotes the new entities throughout the specification “by adding the prefix ‘M-’ to the more traditional term.” EX1005, [0043]. One such new entity defined by Wallen was “a special system information block” or “M-SIB” that “includes information that is necessary for use by the second type of communication device.” *Id.*, [0020]-[0021]. In contrast to an M-SIB used by an MTC device, Wallen used the term “SIB” (without an ‘M-’ prefix) to refer to a system information block received by a standard-compatible (or legacy) device. *Id.*, [0008] (“a standard-compliant communication device needs to be able to ... adapt its receiver bandwidth to match that of the system bandwidth in order to be able to receive the SIB”) and [0068] (“the first system information block (SIB1)” is “transmitted in a system standardized location (e.g., in subframe 5 in an LTE system). The first SIB, which is a legacy SIB”).

There would have been no need to for Wallen to have defined new entities including M-SIBs if the M-SIBs contained the same legacy information as legacy SIBs like SIB1 referred to in Wallen. Nor would Wallen have bothered to distinguish between M-SIBs and a legacy SIB if all such entities contained the same “legacy

information.” The argument in the Reply that Wallen suggests that a legacy SIB is used in Example “5” is meritless.

III. PETITIONER’S “ANALYSIS CAN END THERE” PRIORITY SHORTCUT MISREADS DYNAMIC DRINKWARE AND EVADES RIGGS’S PORTIONS-RELIED-ON REQUIREMENT

The Reply tries to short-circuit the priority inquiry by asserting that Petitioner “satisfied its initial burden of production” with a footnote that claimed that the ‘670 patent is not entitled to the filing date of its January 20, 2012 GB priority application (GB 1201000). The Reply posits that the “analysis can end there” because any burden allegedly shifted to Patent Owner to prove priority in the abstract—failing which, Petitioner declares the ‘670 patent’s effective filing date “January 21, 2013,” making Wallen prior art at least as of its February 16, 2012 non-provisional filing date. Reply, 2 and 13–15; Petition, 15 and 17 n.3. That framing is legally and procedurally wrong.

A. Petitioner’s burden-shifting argument misreads *Dynamic Drinkware* and ignores Riggs’s “portions-relied-on” requirement

Petitioner argues that it “satisfied its initial burden of production” merely by asserting—via a footnote—that Wallen is prior art as of its February 16, 2012 non-provisional filing date because the ‘670 patent allegedly is not entitled to the benefit of the filing date of its January 20, 2012 foreign priority application. The Reply contends the “analysis can end there” because the burden supposedly shifted to Patent Owner and Patent Owner purportedly failed to prove entitlement, so the ‘670

patent’s effective filing date is instead “January 21, 2013,” rendering Wallen prior art at least as of February 16, 2012. Reply, 2, 13–15; Petition, 15 and 17 n.3.

That framing is legally and procedurally incorrect under *Dynamic Drinkware* and *In re Riggs Dynamic Drinkware v. Nat’l Graphics*, 800 F.3d 1375 (Fed. Cir. 2015) and *In re Riggs*, 131 F.4th 1377 (Fed. Cir. 2025) for at least the following independent reasons.

1. ***Dynamic Drinkware* confirms Petitioner retains the ultimate burden—and cannot “end the analysis” by demanding Patent Owner prove priority in the abstract**

Dynamic Drinkware draws the critical distinction between (i) the burden of persuasion, which “never shifts” from the petitioner in an IPR, and (ii) a potential burden of production, which may shift only in response to an opposing party’s evidence. *Dynamic Drinkware*, 800 F.3d at 1378–79.

Petitioner’s “analysis can end there” approach improperly converts a limited, conclusory assertion into dispositive proof. Even if some production burden may shift in appropriate circumstances, *Dynamic Drinkware* does not permit Petitioner to short-circuit its statutory burden of persuasion—particularly where Petitioner’s own Petition did not meaningfully develop a full priority challenge and did not identify any specific lack of §112 support beyond a single “such as” example. *See Dynamic Drinkware*, 800 F.3d at 1378–79; Petition, 17 n.3.

2. The Petition raised only a narrow, example-based priority attack—and Patent Owner directly rebutted that asserted deficiency

The Petition’s entire foreign-priority attack appears in a footnote and is expressly framed as an example (“such as”), not a developed claim-by-claim priority challenge. (Petition, 17 n.3.) In response, Patent Owner did exactly what the rules and basic fairness require: it addressed the only articulated alleged deficiency (the Petition’s “SIB1” example) by citing the foreign priority document’s disclosure of SIB1. POR, 57–58.

The Reply (at 15) now tries to recharacterize that narrow Petition footnote into a broad new contention that Patent Owner had to affirmatively prove written-description support for “the challenged claims” in their entirety (and to do so with POSITA testimony), and that failing to do so resets the patent’s effective filing date to “January 21, 2013.” That is classic goalpost moving. The Petition did not present a developed theory that GB 1201000 lacks §112 support for the challenged claims as a whole; it offered only a conclusory footnote alleging only a single unsupported limitation. Petition, 17 n.3.

At minimum, where (as here) the Petitioner’s priority challenge was limited to an asserted “missing” feature, Patent Owner’s rebuttal evidence on that feature satisfies any responsive production obligation and returns the controversy to Petitioner—who must then prove, with record evidence, that the cited disclosure still

fails §112 for the challenged claims. *Dynamic Drinkware* does not allow a Petitioner to prevail simply by asserting that Patent Owner should have done more than respond to the Petition's only identified alleged deficiency.

3. Petitioner cannot use “threshold priority” rhetoric to avoid *Riggs*: *Riggs* requires support for the specific portions relied upon to treat a reference as earlier-filed prior art

Petitioner's “threshold” gambit is also an attempt to avoid Patent Owner's *Riggs* point that Petitioner must prove entitlement to an earlier date for the specific disclosures it relies upon, not merely point to the existence of a provisional and broadly claim entitlement.

Riggs squarely rejects the notion that “if a single claim is supported by the provisional application, then everything gets the benefit.” *In re Riggs*, 131 F.4th at 1384–85. Instead, even where some claim support exists, the provisional must support “the specific portions of the [non-provisional] specification identified and relied on” for the relevant prior-art theory. *Id.* at 1384.

That principle defeats Petitioner's attempt to “end the analysis” before reaching whether Wallen is entitled to Wallen-Prov's June 27, 2011 filing date for the *particular* disclosures Petitioner uses in its obviousness mapping. Petitioner cannot simultaneously (i) rely on Wallen's provisional date for prior-art purposes and (ii) insist the Board need not examine entitlement to that date because Patent Owner supposedly failed to prove something else. *Riggs* requires the entitlement

analysis when (as here) the effective date of the relied-upon Wallen disclosures is outcome-determinative. *See In re Riggs*, 131 F.4th at 1384.

4. Petitioner’s Reliance on *Marvell* and *G&H* Does Not Salvage Its “Wallen-as-of-February-16-2012” Theory

Petitioner attempts to avoid proving that Wallen is supported by the Wallen provisional application by asserting its narrative that Patent Owner allegedly failed to prove that the ‘670 Patent was entitled to the benefit of its foreign priority date (January 20, 2012). Reply, 18–21. In support, the Reply cites (i) *Marvell Semiconductor, Inc. v. Uniloc 2017 LLC*, IPR2019-01350, Paper 24 at 12–13 (P.T.A.B. Feb. 1, 2021), and (ii) *G&H Diversified Manufacturing, LP v. Dynaenergetics Europe GmbH*, PGR2021-00078, Paper 46 at 12 (P.T.A.B. Oct. 31, 2022). (Reply, 18–20). Neither decision is on point or designated precedential or informative. Moreover, both decisions predate the Federal Circuit’s ruling in *Riggs*.

a) Neither *Marvell* nor *G&H* eliminates Petitioner’s ultimate burden of persuasion—or authorizes Petitioner’s “conclusory footnote” priority attack

As Petitioner itself acknowledges, the burden of persuasion “never shifts” from the petitioner in an IPR. (Reply, 19–20). That is exactly what the Federal Circuit held in *Dynamic Drinkware*: the petitioner bears the burden to prove unpatentability by a preponderance of the evidence, and that burden does not shift. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

The two non-precedential, non-informative PTAB decisions Petitioner cites do not change that. At most, they recognize a narrow and uncontroversial point: in some circumstances, a patent owner may have a burden of production to come forward with evidence supporting an earlier effective filing date if the patent owner seeks to antedate asserted prior art. (Reply, 18–20.) But that procedural point does not excuse Petitioner from having to (1) properly raise and (2) prove its foreign-priority challenge with record evidence.

Here, the Petition presented a minimal foreign-priority challenge in a footnote. That footnote asserted that the ‘670 Patent is “not entitled” to the benefit of its foreign priority date, but was short on specifics. In fact, in terms of specifics, the footnote identified only a single limitation in claim 1 of the ‘670 Patent (i.e., the reference to “a system information block 1”) that the Petitioner contended lacked written description support in the foreign priority document. Petition, 17 n.3. In response, the Patent Owner demonstrated that this single limitation was indeed supported by the foreign-priority document. POR, 57-58. Petitioner cannot transform its cursory footnote into anything beyond what it was, i.e., the singular allegation (that Patent Owner has since rebutted) that “a system information block 1” in claim 1 lacked written description support in the foreign priority document. Petitioner cannot remake its cursory footnote into more than that by invoking

nonprecedential Board decisions about burden-of-production mechanics. Reply, 18–20.

b) Marvell is factually and procedurally inapposite—and does not support Petitioner’s attempt to expand beyond what it actually challenged in the Petition.

Marvell does not stand for the proposition Petitioner implies, which is that a patent owner must preemptively prove the entire priority chain whenever a petitioner vaguely gestures at priority. In *Marvell*, the panel addressed a circumstance where (as the decision explains) the examiner had denied a foreign priority claim during prosecution, and the patent owner in the IPR sought to effectively relitigate/correct that issue. Reply, 19–20. That is not this case.

More importantly, even taking Petitioner’s framing, *Marvell* only reinforces that the inquiry must be tethered to what is actually disputed and supported by evidence. Here, the Petition identified only one supposed written-description deficiency—its allegation regarding the limitation “wherein the indicated frequency resources and the time resources include control information for use by the UE to acquire a system information block 1.” Petition, 17 n.3. Patent Owner addressed that exact contention in its Response, and Petitioner’s effort to require Patent Owner to prove something broader (or different) in response is improper. Reply, 20.

c) ***G&H* is likewise inapposite and does not authorize Petitioner to avoid the merits of whether Wallen is entitled to Wallen-Prov.’s priority date**

Petitioner cites *G&H* for the general observation that the burden of production “may shift” to a patent owner on effective-filing-date issues. Reply, 18–19. But *G&H* does not hold that a petitioner can (i) lodge a conclusory priority accusation in a footnote and then (ii) insist the Board “need not reach” the petitioner’s own disputed prior-art entitlement issues. (Reply, 21).

Nor would that make sense as a matter of trial structure. Petitioner affirmatively sought institution on the theory that Wallen is prior art as of Wallen-Prov and relied on that earlier date extensively. Petition, 17–29. Petitioner cannot now ask the Board to bypass the Wallen-Prov dispute by reframing the case around a foreign-priority attack limited to a single allegedly missing limitation that Patent Owner demonstrated was present in the priority document.

5. ***Riggs* confirms why Petitioner’s approach is legally backwards: entitlement questions must be proven for the specific relied-upon subject matter—not asserted by shortcut.**

Even if the Board were to entertain Petitioner’s attempt to pivot away from Wallen-Prov, the Federal Circuit has made clear that priority/entitlement determinations in the prior-art context require a substantive, disclosure-specific showing, not a categorical shortcut. In *In re Riggs*, the Federal Circuit held that it is not enough to show that “at least one claim” of a reference finds support in the

provisional; the provisional must also provide written-description support for the specific disclosure relied upon as prior art. *In re Riggs*, 131 F.4th 1377, 1383–86 (Fed. Cir. 2025). Petitioner’s reliance on non-precedential PTAB decisions that pre-date *Riggs* does not, and cannot, supplant that controlling standard. (Reply, 18–21).

6. Petitioner’s “no POSITA testimony” criticism is misplaced—and, in any event, Patent Owner provided POSITA perspective

Petitioner faults Patent Owner for not citing testimony on what a POSITA would have understood from the foreign priority application. Reply, 15. But nothing in *Dynamic Drinkware* makes expert testimony a prerequisite for addressing an express disclosure in a priority document—particularly where the allegedly missing feature (SIB1) is explicitly recited in the priority disclosure and involves standard LTE terminology.

B. Petitioner’s “written-description” patch fails—Wallen-Prov still does not support the Wallen disclosures Petitioner relies on

The Reply attempts to cure two discrete written-description failures: (i) its reliance on Figure 13 of Wallen (a *new* “limited bandwidth communication device ... such as the MTC device” block diagram) by pointing to Figure 6 of Wallen-Prov, and (ii) its reliance on ¶[0072] of Wallen by arguing that the non-provisional’s added phrase “intended for this MTC device” is “supported by context” even though it is not present in Wallen-Prov. Neither attempt satisfies *Dynamic*

Drinkware/Riggs (i.e., Petitioner must show Wallen-Prov provides §112 written-description support for the specific Wallen portions Petitioner invokes as prior art).

1. Figure 6 of Wallen-Prov does not provide written-description support for Wallen’s *new* Figure 13 “limited bandwidth communication device ... such as the MTC device”

Petitioner reframes Patent Owner’s point as if Patent Owner had argued Wallen-Prov must “label” the UE as a “cellular telephone.” But Patent Owner’s argument is more fundamental: Wallen-Prov never discloses (or depicts) the later-added Figure 13 embodiment—a “limited bandwidth communication device ... such as the MTC device used in the examples described above,” with optional “sensor circuitry” and other application-specific functionality. That Figure 13 disclosure is new matter relative to the provisional, and Petitioner’s invalidity case relies on it throughout its element-by-element mapping (transceiver/processor/memory and MTC-device functionality tied to that architecture). (See, e.g., Petition’s reliance on Fig. 13; EX1005 ¶¶[0083]-[0084]; EX2010 ¶¶87-91).

The Reply asserts that Wallen-Prov’s Figure 6 “implements ‘some or all of the functionality described above’” and that this “refers to” MTC embodiments earlier in Wallen-Prov, therefore Figure 6 “at least represents an MTC device.” (Reply, 18-19 (quoting EX1006 p.12; citing EX1037 ¶50)). That conclusion does not follow from the cited passage.

The cited Wallen-Prov statement is a generic “example UE” implementation disclosure, namely that a UE processor can implement “some or all” of the functionality described in the surrounding discussion. It does not disclose, nor even suggest possession of the later-added, expressly limited reduced-bandwidth MTC-device architecture shown in Wallen’s Figure 13, and it does not link Figure 6 to the defining MTC characteristic Wallen itself emphasizes: reduced-bandwidth, low-complexity operation. (EX2010 ¶¶88-91).

Petitioner’s argument thus attempts to convert a generic “UE” block diagram into written-description support for a newly added, expressly limited “limited bandwidth communication device ... such as the MTC device” embodiment. That is precisely the kind of bootstrapping *Riggs* forbids, where a party points to generalized support for “something” in a provisional and then uses that generality to supply written description for later-added, more specific subject matter the provisional never actually describes.

Petitioner’s rebuttal also improperly tries to fill gaps in the Wallen-Prov with extrinsic evidence, asserting that “it was known that an MTC device could have a keypad and display,” and relying on EX1039 and EX1040 through EX1037. Reply, 18. That is legally irrelevant to written description. The question is what Wallen-Prov itself discloses as filed, not what other references might make “obvious” or

“possible.” See, *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (en banc).

Nor does Petitioner gain anything from cross-examining Patent Owner’s expert about the *appearance* of the UEs in Figure 5. Dr. Lomp testified the Figure 5 devices look like cellular telephones (shape, display, keypad) and “there’s no indication that they’re anything other than that.” EX1036, 20:3-11. Petitioner never identifies any affirmative disclosure in Wallen-Prov that those Figure 5/6 UEs are the later-added limited-bandwidth MTC device of Figure 13, nor could it because there is no such disclosure. Instead, Petitioner asks the Board to infer that result from a generic “some or all” implementation sentence. This is precisely the kind of hindsight inference that cannot substitute for §112 written description support.

In short, the Reply fails to show that a POSITA reading the Wallen-Prov would “immediately discern” Wallen’s later-added Figure 13 MTC-device architecture from Wallen-Prov’s Figures 5/6 and generic UE boilerplate. POR, 51 (quoting *Purdue*’s “immediately discern” standard); EX2010 ¶¶87-91). Because Petitioner’s claim mapping repeatedly relies on the Figure 13 “limited bandwidth communication device ... such as the MTC device” disclosure, Petitioner has not established Wallen is entitled to Wallen-Prov’s filing date for those relied-upon disclosures.

2. Wallen’s added language remains unsupported by Wallen-Prov—and Petitioner’s “context” theory is both legally insufficient and internally inconsistent

Petitioner concedes the precise language it relies on in Wallen does not appear in Wallen-Prov—it even underlines the missing phrase and characterizes the difference as “small.” Reply 19. But under §112 written description (and *Riggs*), Petitioner’s burden is not to show the difference is “small”; it is to show Wallen-Prov conveys possession such that a POSITA would “immediately discern” the later-added subject matter. POR, 51.

Petitioner does not do so. Petitioner’s entire “support” reduces to an inference that, because Wallen-Prov states an MTC can “receive and detect control information, including the MTC specific SIBs or downlink assignments pointing to the SIBs,” it is therefore “clear” that the SIBs are “intended” for the referenced MTC device—even though Wallen-Prov never says that. Reply, 20-21 (quoting EX1006 p.9; citing EX1037 ¶52). That is not written description; it is unsupported attorney argument.

Accordingly, Petitioner has not met its burden to show Wallen-Prov provides §112 written-description support for the specific Wallen excerpts on which Petitioner relies (Figure 13 disclosure and ¶[0072]’s added “intended for this MTC device” language).

IV. CONCLUSION

For the foregoing reasons, the Board should enter a Final Written Decision finding that none of the challenged claims are unpatentable.

Respectfully submitted,

Dated: March 4, 2026

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CERTIFICATE OF COMPLIANCE WITH WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), I certify that this **PATENT OWNER'S SUR-REPLY** complies with the type-volume limits set forth in the Memorandum and 37 C.F.R. § 42.24 because it contains 5,596 words, excluding the parts of the Brief that are exempted by 37 C.F.R. § 42.24(a), according to the word processing system used to prepare this document.

Respectfully submitted,

Dated: March 4, 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 SUR-REPLY** was served via email (as consented to by counsel) on March 4, 2026 to lead and backup counsel of record for Petitioner as follows:

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