

Paper No. ____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BROADCOM CORPORATION

Petitioner

v.

WI-FI ONE, LLC

Patent Owner

Case IPR2013-00602
U.S. Patent No. 6,466,568

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
AMEND**

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Cases

In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)2

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Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1575, 227 USPQ 177, 179
(Fed. Cir. 1985)2

Vas Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563 (Fed. Cir. 1991),2

Statutes

35 U.S.C. § 102 7, 11

37 C.F.R. § 42.1211

I. STATEMENT OF RELIEF REQUESTED AND FACTS IN DISPUTE

Owner's Motion to Amend should be denied because Owner¹ has failed to meet its burden of proving that it is entitled to have the substitute claims entered into the '568 patent for at least two reasons: (1) Owner's proposed amendments are not supported by the '568 patent, and (2) even if supported, the proposed amendments are not patentably distinct from the prior art.

II. OWNER HAS FAILED TO MEET ITS BURDEN OF PROOF

Owner has not met its burden of showing that there is support for the subject matter of the substitute claims. (37 C.F.R. § 42.121(b)). Claims 8-13 impermissibly include subject matter that is not supported in the '568 patent. In particular, there is no support for a service type identifier which identifies "transmission characteristics of a service" and a type of payload information. In addition, Owner must demonstrate that claims 8-13 include a patentable distinction over the prior art. As described below, Owner has not met its burden because the facts demonstrate that claims 8-13 are not patentably distinct from the prior art.

A. There is No Written Description Support for the Amendments

¹ After institution, Ericsson transferred the '568 patent to Wi-Fi One, LLC. This Reply refers to the current and prior owners as "Owner".

Claims 8-13 are not patentable under 35 U.S.C. §112, first paragraph, due to a lack of written description support for the claimed service type identifier. “[T]he test for sufficiency of support in a [patent] application is whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’” *Vas Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991), quoting *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). “A description which renders obvious the invention for which an earlier filing date is sought is not sufficient.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

Claim 8 includes the following unsupported limitation: “service type identifier which identifies [a] transmission characteristics of a service and [b] a type of payload information.” Owner interprets “transmission characteristics of a service” to require identifying different transmission characteristics for different services. (Paper No. 38 at 12 (“Menand does not disclose a ‘service type identifier’ because the transmission of only one service does not teach or suggest a service type identifier to a person of ordinary skill in the art.”)). However, the ‘568 patent does not provide written support for such an amendment.

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