

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BROADCOM CORPORATION

Petitioner

v.

WI-FI ONE, LLC

Patent Owner

Case IPR2013-00636
U.S. Patent No. 6,424,625

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

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I. Statement of Relief Requested and Facts in Dispute

Owner's¹ Motion to Amend attempts to substitute Claim 1 with a new substitute Claim 20. The Motion to Amend should be denied because Owner has failed to meet its burden of proving that it is entitled to have the substitute claim entered into the '625 patent. Owner cannot meet its burden because: (1) Owner's proposed amendments are not supported by the '625 patent; and (2) the proposed amendments are not patentably distinct from the prior art.

Claim 1 recites, *inter alia*, "a transmitter in the data network commanding a receiver in the data network to a) receive at least one packet having a sequence number that is not consecutive with a sequence number of a previously received packet and b) release any expectation of receiving outstanding packets having sequence numbers prior to the at least one packet." Claim 1 further recites "the transmitter discarding all packets for which acknowledgment has not been received, and which have sequence numbers prior to the at least one packet." The proposed amendments add a receiver window and limit the transmitter to commanding the receiver to receive, in step (a), at least one packet having a sequence number that is outside the receiver window.

¹ After institution, Ericsson transferred the '625 patent to Wi-Fi One, LLC.

This Reply refers to the current and prior owners as "Owner".

II. Owner Has Failed to Meet Its Burden of Proof

A. There is No Written Description Support for the Amendment

Claim 20 is not patentable under 35 U.S.C. §112, first paragraph, due to a lack of written description support for the claimed subject matter. In particular, the '625 patent fails to provide support for a transmitter commanding a receiver to receive a packet "outside of the receiver window."

"[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).

Generally, the '625 patent is directed to a wireless ARQ transmission scheme in which a transmitter and a receiver are exchanging packets. ('625 at 5:15-17; Ex. 1001). The transmitter maintains a transmit window to keep track of packets it has sent, and the receiver maintains a separate receiver window to keep track of packets it has received.

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