UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUGHES NETWORK SYSTEMS, LLC and
HUGHES COMMUNICATIONS, INC.,

Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,

Patent Owner.

IPR2015-00059 (Patent 7,916,781)

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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I. PRELIMINARY STATEMENT

Patent Owner effectively concedes that claims 1 and 2 as written are anticipated by Divsalar. Its opposition therefore hinges on selective importation of specification embodiments into the claims in an attempt to distinguish over Divsalar. In particular, Patent Owner first contends that the language "linear transform operation" in claim 1 does not mean what it says, and instead "must involve irregular repetition and scrambling of bits." Paper 24 (PO Resp.) at 31.

Next, Patent Owner contends that the claim language "accumulation operation" cannot be read literally, but instead "requires a specific type of accumulation operation," that entails "addition of a previously generated parity bit and more than one input bit in order to generate a second parity bit." *Id.* at 40-41, 45. Patent Owner says that its constructions are required because the "specification 'repeatedly and consistently describes'" the claimed invention in these ways. *See e.g.*, *id.* at 34, 45.

As explained below, the specification does not support Patent Owner's arguments. However, even if the specification were as clear as Patent Owner suggests, it would still be legally improper to use the specification to effectively re-write the claims in an attempt to save them. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*) (quoting *McCarty v. Lehigh Valley R.R. Co.*, 160 U.S. 110, 116 (1895)) ("if we once begin to include elements not mentioned in

the claim, in order to limit such claim . . . , we should never know where to stop."). Notably, Patent Owner has elected not to propose an amendment to the challenged claims to restrict them in the manner it now proposes. *See Microstrategy, Inc. v. Zillow, Inc.*, IPR2013-00034, Paper No. 42 at *11–15 (PTAB Mar. 27, 2014) ("If Patent Owner chooses not to avail itself of the opportunity to amend, it is reasonable to accord the claims their scope under the broadest reasonable construction . . . ."). Under the ordinary and plain meaning of the claims as drafted, Divsalar anticipates.

Patent Owner's procedural and evidentiary arguments are also without merit. Patent Owner failed to present any evidence rebutting Petitioner's evidence that Divsalar was published before the effective filing date of the '781 Patent. Moreover, the file history and the inventor's own public admissions establish Divsalar as prior art. Patent Owner also never demonstrated that the petition failed to name the proper real parties-in-interest. EchoStar was identified in the petition in the manner required by published PTO guidance. As to DISH, there is no evidence that DISH had any control, input, or even an interest in this proceeding.

II. ARGUMENT

A. PATENT OWNER'S CLAIM CONSTRUCTION ARGUMENTS LACK MERIT

1. The First Encoding Operation Does Not Require Irregularity

Patent Owner argues that the claim language "first encoding operation being

a linear transform operation that generates L transformed bits" is "not so broad as to encompass ***any*** linear transformation." Paper 24 at 31 (emphasis in original). Instead, Patent Owner argues, this operation "must involve irregular repetition and scrambling of bits." *Id.* This is purportedly "an essential aspect of the invention" described in the patent specification. *Id.* at 31-40.

Patent Owner's argument relies on the following two-step syllogism: (1) the claimed first encoding operation corresponds to the "outer coder discussed throughout the specification" (*id.* at 32 (citing Ex. 2024 ¶ 21); and (2) the "outer coder must include irregular repetition of bits" (Paper 24 at 32 (citing Ex. 2024 ¶ 22)). This is an improper attempt to redraft the claims by importing limitations from the specification. As the Federal Circuit sitting *en banc* has cautioned, "although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments." *Phillips v. AWH Corp.*, 415 F.3d at 1323. *See also Kara Technology Inc. v. Stamps. com Inc.,* 582 F.3d 1341, 1347-48 (Fed. Cir. 2009) ("The claims, not specification embodiments, define the scope of patent protection. The patentee is entitled to the full scope of his claims, and we will not limit him to his preferred embodiment ***or import a limitation from the specification***.") (emphasis supplied). Similarly, the Federal Circuit "repeatedly and consistently has recognized that courts may not redraft claims" in the guise of performing claim

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