

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HUAWEI DEVICE USA, INC. and  
ZTE (USA), INC.  
Petitioners

v.

ELECTRONICS AND TELECOMMUNICATIONS  
RESEARCH INSTITUTE  
Patent Owner

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Case IPR2015-00221  
Patent 8,565,346

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**EXCLUSIVE LICENSEE SPH AMERICA, LLC'S  
PRELIMINARY RESPONSE**

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## TABLE OF AUTHORITIES

### Cases

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<i>Gonzalez v. Banco Cent. Corp.</i> , 27 F.3d 751 (1st Cir. 1994)	27
<i>Heart Failure Technologies, LLC v. Cardiokinetix, Inc.</i> , IPR2013-00183 (PTAB 7/31/2013)	33
<i>In re Bigio</i> , 381 F.3d 1320 (Fed Cir. 2004)	9
<i>In re Kahn</i> , 441 F.3d 977 (Fed. Cir. 2006)	34, 43
<i>In re Paulsen</i> , 30 F.3d 1475 (Fed. Cir. 1994)	10
<i>In re Translogic Tech., Inc.</i> , 504 F.3d 1249 (Fed. Cir. 2007)	9
<i>In re Van Geuns</i> , 988 F.2d 1181 (Fed. Cir. 1993)	10
<i>KSR Int’l Co. v. Teleflex, Inc.</i> , 550 U.S. 398 (2007)	passim
<i>LG Display Co., Ltd. v. Innovative Display Technologies LLC</i> , IPR2014-01092 (PTAB 01/13/2015)	34, 43
<i>Taylor v. Sturgell</i> , 553 U.S. 880 (2008)	27
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### Statutes

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## Other Authorities

Office Patent Trial Practice Guide, 77 Fed. Reg. 48756 (Aug. 14, 2012) .....	9, 26, 27
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## LIST OF EXHIBITS

<u>Exhibit</u>	<u>Description</u>
2001	U.S. Patent Application Publication No. 2005/0163081 filed by Aoki <i>et al.</i> (“Aoki ‘081”)
2002	<i>Cisco Systems, Inc. v. C-Cation Techs., LLC</i> , IPR2014-00454 paper 12 (PTAB 8/29/2014)
2003	U.S. Patent No. 7,408,976, issued to Narasimhan <i>et al.</i>
2004	U.S. Patent No. 7,796,681 issued to Narasimhan <i>et al.</i>
2005	Joint Motion for Dismissal Without Prejudice of ZTE Corporation in <i>SPH America, LLC v. ZTE (USA), Inc.</i> , Case No. 3:13-cv-02326-CAB (Dkt. 15)
2006	HUAWEI DEFENDANTS’ ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIMS TO PLAINTIFF SPH AMERICA’S SUPPLEMENTAL FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT in <i>SPH America, LLC v. Huawei Technologies, Co., Ltd.</i> , Case No. 3:13-cv-02323-CAB (Dkt. 43, pp. 1-2)
2007	File History of U.S. Patent No. 7,577,085 issued to Narasimhan (pp. 302-347)

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