

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUAWEI TECHNOLOGIES CO., LTD.,
Petitioner

v.

BELL NORTHERN RESEARCH, LLC,
Patent Owner

Case No. IPR2019-01186
U.S. Patent No. 7,039,435

PETITIONER'S PRELIMINARY REPLY

LIST OF EXHIBITS

- EX1001 U.S. Pat. No. 7,039,435 to McDowell et al. (“the ’435 patent”)
- EX1002 File History of the ’435 Patent
- EX1003 Declaration of Jonathan Wells, Ph.D.
- EX1004 Certified English Translation of European Patent Publication EP 1091498 (“Baiker”)
- EX1005 U.S. Pat. No. 6,456,856 (“Werling”)
- EX1006 PCT Patent Publication WO 2002/05443 (“Irvin”)
- EX1007 U.S. Pat. No. 6,018,646 (“Myllymäki”)
- EX1008 U.S. Pat. No. 5,390,338 (“Bodin”)
- EX1009 Joint Claim Construction Chart, Worksheet, and Hearing Statement in *Bell Northern Research, LLC, v. Huawei Device (Dongguan) Co., Ltd., Huawei Device (Shenzhen) Co., Ltd., and Huawei Device USA, Inc.* (Case No. 3:18-cv-1784) (S.D.Cal., filed 4/19/19)
- EX1010 U.S. Provisional Patent Application No. 09/612,034 (“Irvin Provisional”)
- EX1011 Michael Barr, *Programming Embedded Systems in C and C++* (O’Reilly & Associates, 1999)
- EX1012 Rudolf F. Graf, *Modern Dictionary of Electronics* (Butterworth-Heinemann, 1999)
- EX1013 Harry Newton, *Newton’s Telecom Dictionary* (Miller Freeman, Inc., 1999)
- EX1014 Webster’s II New College Dictionary (Houghton Mifflin Co, 1999)
- EX1015 Martin H. Weik, *Fiber Optics Standard Dictionary* (Chapman & Hall, 1997)
- EX1016 European Patent Publication EP 1091498 (“Baiker”)

- EX1017 Webster's New World College Dictionary (Simon & Schuster, 1997)
- EX1018 U.S. Pat. No. 6,029,074 ("Irvin '074")
- EX1019 Defendants' Joint Opening Claim Construction Brief in *Bell Northern Research, LLC, v. Huawei Device (Dongguan) Co., Ltd., Huawei Device (Shenzhen) Co., Ltd., and Huawei Device USA, Inc.* (Case No. 3:18-cv-1784) (S.D. Cal.)
- EX1020 Plaintiff's Opening Claim Construction Brief in *Bell Northern Research, LLC, v. Huawei Device (Dongguan) Co., Ltd., Huawei Device (Shenzhen) Co., Ltd., and Huawei Device USA, Inc.* (Case No. 3:18-cv-1784) (S.D. Cal.)
- EX1021 Claim Construction Order and Order on Motions for Summary Judgment
- EX1022 Transcript of June 20, 2019 Hearing in *Bell Northern Research, LLC, v. Bell Northern Research, LLC, v. Huawei Technologies Co., Ltd. et al.* (Case No. 3:18-cv-1784) (S.D. Cal.)
- EX1023 Order on Request for Pre-Institution Stay of the Litigation (August 12, 2019) in *Bell Northern Research, LLC, v. Bell Northern Research, LLC, v. Huawei Technologies Co., Ltd. et al.* (Case No. 3:18-cv-1784) (S.D. Cal.)
- EX1024 Order on Confirming Settlement and Setting Deadline to File Joint Motion for Dismissal (October 24, 2019) in *Bell Northern Research, LLC, v. Bell Northern Research, LLC, v. Huawei Technologies Co., Ltd. et al.* (Case No. 3:18-cv-1784) (S.D. Cal.)

The Board's exercise of discretion under §314(a) or §325(d) is not warranted here. First, Patent Owner's statement that "it is a near certainty" the jury trial will conclude before any Final Written Decision here is not accurate. POPR, 25. The parties in the three separate litigations filed by Patent Owner were tentatively scheduled for a "final pretrial conference" in March 2020, but no trial date is actually scheduled and it is not clear what the sequence of these trials will be. The court plainly explained why during a recent hearing:

THE COURT: Keep me informed if any [IPRs] get instituted. Even though we have done claim construction, *I'm rather loathe to go on parallel tracks with the Patent Office*. Because things happen in IPR, even if the patents come back, sometimes there's clarifications about scope and meaning that might require I reconsider my claim construction. And I think we're, both the Patent Office and the district courts, playing on the same standards these days, and *so it's much more persuasive to me to hear what people, who actually know what this stuff means, think about it. So if they get instituted, let me know and we'll keep that in mind*. Otherwise, we will just keep going.

EX1022, 120-21 (emphasis added). Then, shortly before the POPR was filed, the court again clarified the trial date has "not been set." EX1023, 4. The court's reasoning for this reminder was clear:

PTAB decisions to institute on all the submitted patents *will greatly impact the scope of this case*. Even decisions to institute on less than all the patents have *significant potential to streamline this litigation*.

Id. at 4-5 (emphasis added). All of this important context, which distinguishes the present case from *NHK*, was omitted from the POPR. The district court’s position was plain. Contrary to the POPR’s statement, it is *not* a “near certainty” that the jury trial will conclude before the Board’s Final Written Decision here.¹

Second, equitable circumstances support instituting trial here. Patent Owner never alleged infringement of the ’435 patent until months after its initial complaint (Pet., 3), so the Petition here was filed efficiently and promptly—less than seven month after the amended complaint. Importantly, Petitioner here did not delay—filing less than 8 weeks after the end of Patent Owner’s ability to change the asserted claims in the litigation (with its April 19, 2019 amended disclosure). Petitioner had no assurance from Patent Owner that the asserted claims would remain fixed until April 19, 2019, and such timing should not serve to prejudice Petitioner here.

Next, regarding the POPR’s arguments about “antedating” the prior art

¹ Also, the litigation schedule was recently modified in an October 24, 2019 order confirming an agreement in principle on settlement of the litigation. EX1024, 1. According to that order “all other pending dates before Magistrate Judge Barbara L. Major are hereby vacated. Any matters currently before the District Judge shall remain in effect pending notice from that court.” *Id.* The parties have until November 20, 2019 to submit a joint motion for dismissal of the litigation.

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