

Filed: November 12, 2019

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

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY

I. THE DISTRICT COURT CASE SCHEDULE

Contrary to the Petitioner’s assertion, there is nothing “tentative” about the district court’s schedule for the related actions. There is a date certain set for every pre-trial deadline, including the pre-trial conference, which is confirmed—not “tentatively scheduled” (*see* Rep., 1)—for March 20, 2020 at 2:30 p.m. (Ex. 2001, ¶29.) It strains credibility that the Court, having had the parties submit final exhibit lists, witness lists, and all other submissions for the case to be trial-ready, would then wait ten months or more to actually conduct the trial. Lest there be any doubt, the default scheduling rules in the Southern District of California for patent cases call for “[a] trial date...within twenty-four (24) months for complex cases.” (Ex. 2002 (SDCA Patent Local Rules) at Patent L.R. 2.1(a).) Twenty-four months from Patent Owner’s complaint filing is August 1, 2020. (*See* Pet., 2.)

Moreover, the remaining presently scheduled litigation deadlines are unlikely to change. Petitioner already tried—and failed—to modify the schedule. Despite the court’s warning in the scheduling order that “[t]he dates and times set forth herein will not be modified except for good cause shown” (Ex. 2001, ¶30), Petitioner filed a request to extend the case deadlines due to anticipated discovery delays resulting from Petitioner’s status on the “Entity List” for the U.S. government’s export ban. (Ex. 2003, at 9.) The court granted relief that the parties agreed upon—permission to conduct limited discovery after the fact discovery

deadline—but denied Petitioner’s request to generally extend deadlines, stating, “[a]ll of the current dates and deadlines will remain as set.” (Ex. 2004, at 2.)

Petitioner misconstrues the district court’s comments on PTAB proceedings. First, as Petitioner’s first block quote shows, in June of 2019, the court shared the Board’s concern regarding parallel proceedings. (*See Rep.*, 1 (quoting district court’s statement asking first whether any IPRs had been instituted and then stating “I’m rather loathe to go on parallel tracks with the Patent Office.”) The Board’s analogous statements in *NHK* in very similar circumstances are precisely why Patent Owner seeks denial of the Petition under § 314(a). (*See* POPR at 25-28.) While the court stated that it would “consider the efficiencies of proceeding” (*Rep.*, 2) if an IPR is instituted, it is highly probable that the court would consider it efficient to continue to trial when some of the most significant costs of litigating—fact and expert discovery—will already have been incurred, and the case will be nearly trial ready. This situation is the opposite of “an inexpensive substitute for district court litigation.” Instead, it would derail a process that is near completion and has already expended substantial party and district court resources. The overlap and redundancy of this proceeding with the related litigation is confirmed through Petitioner’s expert technical reports served in the related litigation on October 11, 2019. Petitioner confirmed it intended to rely in the litigation on the same expert (Dr. Wells) to include the same prior art anticipation

and obviousness opinions and arguments as those identified as Grounds 1-6 in this proceeding. (Compare Petition at 5 with Ex. 2005 at 487-545). Accordingly, rather than an “inexpensive alternative” to district court litigation, this proceeding, if instituted, would duplicate the related district court litigation.

Second, nowhere does *NHK* state that the Board should consider the district court’s views on IPRs in exercising its discretion under § 314(a). Such a holding would lead to wild inconsistencies, depending on the views of which judge happened to preside over a related litigation, rather than objective facts such as the case schedule and overlap between the two tracks—which is what *NHK* focuses on. See *NHK Spring Co., Ltd. v. Intri-Plex Technologies, Inc.*, IPR2018-00752, Paper No. 8 at 19-20 (PTAB Sept. 12, 2018).

Third, Petitioner attempts to cast doubt on the “near certainty” that any jury trial in the related litigation would conclude long before any Final Written Decision in these proceedings, if instituted, by pointing out that the parties reached an agreement in principle with respect to the litigation. (Rep. at 2, n.1). More importantly, Huawei agreed to move to terminate its pending *inter partes* reviews against Patent Owner as part of the settlement. Accordingly, in any event, institution should be denied because either (i) without a final settlement, these proceedings will duplicate the related litigation, or (ii) with a final settlement, Huawei agreed to move to terminate its pending IPRs against Patent Owner.

II. THE EXAMINER’S REVIEW OF *IRVIN* AND THE DATE OF THE REFERENCE

Petitioner asserts that the Board should disregard that *Irvin* was considered by the Examiner. But *Irvin* was not “merely” cited in an IDS. (Rep. 5). As discussed in the POPR at 36-39, *Irvin* was individually identified in its own separate IDS, and in conjunction with the Examiner’s review and consideration of *Irvin*, the examiner specifically emphasized that that none of the prior art (including *Irvin*, which he had just reviewed) disclosed the “transmit power...based on [the] network adjusted power...and proximity transmit power level” limitation—precisely what Petitioner now argues *Irvin* discloses.

Petitioner does not dispute the authority cited at pp. 41-43 of the POPR that written support for solely a single claim is insufficient to prove an earlier effective prior art date for a specific reference. Yet that is all Petitioner has attempted to show—that claim 1 is supported by the provisional. The only other evidence Petitioner has submitted is a conclusory expert declaration that the respective disclosures within *Irvin* and its provisional are “substantially similar.” Petitioner cites no authority to support their position that specifications in the *Irvin* provisional that are merely substantially similar—whatever that may mean—are sufficient to provide the necessary written support for everything in *Irvin* relied upon in the Petition. Petitioner’s unfounded claims about what Patent Owner knows or should know are irrelevant to Petitioner’s failure to meet its burden here.

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