

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTEL CORPORATION  
*Petitioner,*

v.

PACT XPP SCHWEIZ AG  
*Patent Owner*

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Case IPR2020-00537  
U.S. Patent No. 7,928,763

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**PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY  
PURSUANT TO BOARD ORDER**

**PATENT OWNER'S EXHIBIT LIST**

<b>Exhibit No.</b>	<b>Description</b>
2015	Petition for <i>Inter Partes</i> Review of U.S. Patent No. 6,240,376 in <i>Synopsys, Inc. v. Mentor Graphics Corp.</i> , Case IPR2012-00042, Paper 1 (Sep. 26, 2012)
2016	Patent Owner's Request for Rehearing on Decision to Institute <i>Inter Partes</i> Review in <i>Synopsys, Inc. v. Mentor Graphics Corp.</i> , Case IPR2012-00042, Paper 18 (March 08, 2013)
2017	Banner & Witcoff, Ltd.'s "Messenger Log" from Exhibit 2005 in <i>Synopsys, Inc. v. Mentor Graphics Corp.</i> , Case IPR2012-00042
2018	Notice Regarding Case Management, Dkt. No. 19, filed May 23, 2019
2019	Patent Owner's Sur-Reply in <i>Intel Corp. v. Tela Innovations, Inc.</i> , Case IPR2019-01228, Paper 18 (Nov. 27, 2019)
2020	Declaration of Ziyong Li in Support of Patent Owner's Sur-reply
2021	Stipulation to Dismiss, Dkt. No. 24, filed May 30, 2019
2022	Stipulation and Order to Extend Time, Dkt. No. 98, filed June 1, 2020
2023	Excerpt of Intel's Initial Invalidity Contentions in the District Court case, filed October 31, 2019
2024	Intel's Motion to Transfer, No. 6:19-cv-00273-ADA, Dkt. 13

In its Response, Patent Owner (“PACT”) raised multiple procedural grounds, each of which provides an independent and fully sufficient reason the Board should deny the Petition. None of the arguments in Petitioner’s (“Intel”) reply changes this.

**I. PACT Was Not Properly Served Under 37 C.F.R. § 42.105(a)**

37 C.F.R. § 42.105(a) sets forth a simple and straightforward requirement, which Intel failed to meet. To properly effect service, Petitioner must serve Patent Owner “at the correspondence address of record for the subject patent.” 37 C.F.R. § 42.105(a). Intel did not do this and their reply consists of excuses and insufficient justifications why Intel need follow this rule. Furthermore, Petitioner mischaracterizes the rule, excluding with an ellipsis the important word “**additionally**,” which makes clear service at the correspondence address of record is required at a minimum, and that service on the patent owner at another address is not a substitute. 37 C.F.R. § 42.105(a) (“The petitioner may **additionally** serve the petition and supporting evidence on the patent owner at any other address”) (emphasis added). The rule is unambiguous: the petition must at least be served at the correspondence address of record, which shows Customer Number 73481 associated with Alliacense. Ex. 2006.

Petitioner instead refers to Edward Heller III listed on the power of attorney and argues that because Edward Heller is deceased, the next best option was to serve Mr. Aaron Grunberger, the original patent practitioner for the patent-in-suit.

However, Petitioner was fully aware of the correspondence address of record when it relied on the California address in its motion to transfer filed in May 2019. Petitioner made no attempt at service at that address, where other practitioners may be available. *See* Ex. 2024. *See* MPEP § 403.

Intel’s cited case, *Synopsys, Inc. v. Mentor Graphics Corp.*, did not hold that service on counsel before a power of attorney was filed was proper under § 42.105(a). Case IPR2012-00042, Paper 23 (Apr. 11, 2013). In *Synopsys*, the parties did not dispute that Banner & Witcoff had the power of attorney, and the issue was whether service on an old address was proper. Ex. 2015; Ex. 2016 at 22-23; Ex. 2017. It is undisputed that Mr. Grunberger had not yet filed a power of attorney when the Petition was sent to him.

Petitioner argues that delivery to litigation counsel constitutes proper service, citing *Micron Tech., Inc. v. e.Digital Corp.*, Case IPR2015-00519, Paper 14 (Mar. 24, 2015). However, the portion Petitioner relies on addressed the service of litigation counsel pursuant to 35 U.S.C. § 312(a), which requires “the petitioner provide[] copies of [] the documents [] to the patent owner.” This is different from the service requirement in 37 C.F.R. § 42.105(a). For that, the Board stated:

The correspondence address of record for a patent can be discovered simply by entering the number of the patent into the USPTO’s web-based Patent Application Information Retrieval (PAIR) portal (<http://portal.uspto.gov/pair/PublicPair>).

Case IPR2015-00519, Paper 14 at 5. This is what Petitioner failed to do here. Petitioner does not have excusable reasons comparable to the petitioner in *Micron*. The petitioner in *Micron* had served litigation counsel **more than two weeks before the § 315 statutory deadline**, and there was no evidence that the patent owner in *Micron* warned the petitioner that such service was improper. *Id.* at 3. Here, Intel chose not to contact Patent Owner’s litigation counsel regarding the service of the Petition. Rather, it contacted Mr. Grunberger three days before the deadline without even copying Patent Owner’s litigation counsel. Intel was warned by Mr. Grunberger that service was not proper, Ex. 1040, and upon such notice, Intel had until the end of the day on February 10 to research the proper way to conduct service, to find the correspondence address, and to effect proper service on the correspondence address, which Intel failed to do. Moreover, contrary to Intel’s assertions, the purported recipient identified in Intel’s proof of service does not work at Quinn Emanuel. Ex. 2020, ¶ 5. Therefore, Intel does not have any justification for its improper service.

## **II. Petitioner’s Declaratory Judgement Action Bars Institution**

Intel has failed to explain why its Declaratory Judgement Action does not in fact raise a challenge to invalidity when it alleges it does not infringe any “valid” patent. Clearly, Intel was asking the Judge to rule on validity and the Judge understood that. *See* Ex. 2018 (“It shall not be an excuse to deny or delay discovery

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