

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED,

Petitioner,

v.

UNM RAINFOREST INNOVATIONS,

Patent Owner.

Case IPR2021-00375

Patent No. 8,265,096 B2

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO AMEND**

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EXHIBIT LIST

Exhibit	Description
Ex. 1001	U.S. Patent No. 8,265,096 (“the ’096 patent”)
Ex. 1002	Declaration of Dr. Sumit Roy (“Roy”)
Ex. 1003	<i>Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC</i> , Paper 24, IPR2019-01393 (PTAB June 16, 2020)
Ex. 1004	Eleventh Supplemental Order Regarding Court Operations Under Exigent Circumstances Created by the Covid 19 Pandemic (W.D. Tex. Dec. 10, 2020)
Ex. 1005	Excerpts from JEFFREY G. ANDREWS ET AL., FUNDAMENTALS OF WIMAX (2007)
Ex. 1006	Five Criteria Statement for P802.16m PAR Proposal, IEEE 802.16-06/055r3 (Nov. 15, 2006)
Ex. 1007	IEEE 802.16m System Requirements, IEEE 802.16m-07/002r4 (Oct. 19, 2007)
Ex. 1008	Listing of Challenged ’096 Patent Claims
Ex. 1009	U.S. Provisional App. No. 60/929,798
Ex. 1010	Excerpts from ’096 Patent File History
Ex. 1011	Claim Construction Order in <i>STC.UNM v. Apple Inc.</i> , No. 1-20-cv-00351 (W.D. Tex. Apr. 9, 2020), ECF No. 69 (“Markman Order”)
Ex. 1012	U.S. Pub. No. 2009/0067377 A1 (“Talukdar”)
Ex. 1013	U.S. Provisional Application No. 60/956,031 (“Talukdar Provisional”)
Ex. 1014	Canadian Patent Application No. 2 581 166 A1 (“Wang”)
Ex. 1015	WIPO Handbook on Industrial Property Information and Documentation, “Examples and Kinds of Patent Documents” (May 2016)
Ex. 1016	U.S. Pub. No. 2007/0155387 A1 (“Li”)
Ex. 1017	U.S. Pub. No. 2007/0104174 A1 (“Nystrom”)
Ex. 1018	U.S. Pub. No. 2008/0095195 (“Ahmadi”)
Ex. 1019	Excerpts from William Stallings, WIRELESS COMMUNICATIONS AND NETWORKS (2D ED. 2005)

Ex. 1020	U.S. Patent No. 7,460,466 B2 (“Lee”)
Ex. 1021	U.S. Patent No. 8,462,611 B2 (“Ma”)
Ex. 1022	Fixed, nomadic, portable and mobile applications for 802.16-2004 and 802.16e WiMAX networks (November 2005)
Ex. 1023	Mohammad Azizul Hasan, Performance Evaluation of WiMAX/IEEE 802.16 OFDM Physical Layer (June 2007)
Ex. 1024	U.S. Patent No. 7,710,910 B2 (“Ode”)
Ex. 1025	IEEE 802.16m System Requirements, IEEE 802.16m-07/002r4 (Jan. 12, 2007)
Ex. 1026	U.S. Pub. No. 2004/0037215 A1 (“Hwang”)
Ex. 1027	Yasamin Mostofi, <i>ICI Mitigation for Pilot-Aided OFDM Mobile Systems</i> (IEEE, Vol. 4, No. 2, Mar. 2005)
Ex. 1028	Declaration of Dr. Robert Akl
Ex. 1029	Scott McKeown, <i>District Court Trial Dates Tend to Slip After PTAB Discretionary Denials</i> , Patents Post Grant (available at: https://www.patentspostgrant.com/district-court-trial-dates-tend-to-slip-after-ptab-discretionary-denials/)
Ex. 1030	Declaration of Jonah D. Mitchell in Support of Petitioners’ Motion for <i>Pro Hac Vice</i> Admission
Ex. 1031	Declaration of Christine M. Morgan in Support of Petitioners’ Motion for <i>Pro Hac Vice</i> Admission
Ex. 1032	ITRI’s Recorded Assignment, Reel/Frame No. 045200/0980
Ex. 1033	Sino Matrix’s Recorded Assignment, Reel/Frame No. 021275/0468
Ex. 1034	UNM’s Recorded Assignment, Reel/Frame No. 046854/0173
Ex. 1035	June 22, 2021 hearing transcript before Judge Albright in UNM’s litigations against Dell and ASUSTek.
Ex. 1036	Printout from Public PAIR showing the correspondence address of record for the ’096 patent
Ex. 1037	Excerpt of ’096 file history showing ITRI’s prosecution counsel
Ex. 1038	February 9, 2022 Deposition Transcript of Dr. Branimir Vojcic for IPR2021-00375
Ex. 1039	Supplemental Declaration of Dr. Sumit Roy (“Supp. Dec.”)

I. INTRODUCTION

P.O.’s Motion to Amend (Paper 27, hereafter “Motion”) should be denied for at least two reasons. First, the Motion should be denied because it does not comply with the requirement of 37 C.F.R. § 42.121(b) to show support for the entirety of the Proposed Amended Claims. Second, Patent Owner and its expert have confirmed that the only allegedly “new” limitation added in the Proposed Amended Claims is “naturally present” in the original claims. Accordingly, the Proposed Amended Claims are invalid over the combination of Talukdar and Li, as described in Ground 1 of the Petition. Notably, the Board granted institution on Ground 1. See Paper 14 at 44. Petitioner respectfully asks that the Board deny the Motion.

II. ARGUMENT

A. P.O. fails to establish that its proposed substitute claims meet the requirements under 37 C.F.R. § 42.121 and 35 U.S.C. §316(d)

While the Petitioner ultimately bears the burden of proving unpatentability of the substitute claims, before considering the patentability of any substitute claim, “the Board first must determine whether the motion to amend meets the statutory and regulatory requirements set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121.” *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 4 (P.T.A.B. Feb. 25, 2019) (precedential). These statutory and regulatory requirements include 37 C.F.R. § 42.121(b), which requires that a motion to amend show support for each proposed substitute claim in both the original specification and the priority disclosure: “(b)

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