

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED and
ZYXEL COMMUNICATIONS CORPORATION,

Petitioner,

v.

UNM RAINFOREST INNOVATIONS,

Patent Owner.

IPR2021-00375

Patent 8,265,096 B2

**PETITIONER'S REPLY TO
PATENT OWNER'S RESPONSE TO PETITION**

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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”)

Exhibit	Description
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

I. INTRODUCTION

Petitioner submits this Reply to Patent Owner’s Corrected Response,¹ Paper 38 (“Response” or “Resp.”) in the *inter partes* review of U.S. Patent No. 8,265,096 (“the ’096 Patent”). The Response consists almost entirely of *verbatim* repetition of the arguments in Patent Owner’s Preliminary Response (“Preliminary Response” or “Prelim. Resp.”), which the Board already considered and largely rejected in issuing its Decision Granting Institution of *Inter Partes* Review. See Paper 14 (“Institution Decision” or “I.D.”). The only passages containing substantive new content in the Response over the Preliminary Response are: 1) additional paragraphs relying on a supplemental declaration from Dr. Vojcic to argue that Talukdar is not prior art (Resp. at 28–33); and 2) a paragraph arguing that Dr. Roy’s declaration should be accorded no weight (Resp. at 34). Patent Owner’s additional argument regarding the prior art status of Talukdar fails because it does not apply the correct standard for written description required to support an earlier priority date, and does not even attempt to show possession within the disclosure of the provisional application. See *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (*en banc*) (“the specification must describe an invention understandable to that skilled

¹ Patent Owner filed a Corrected Response on Feb. 17, 2022 to replace the Response it filed on Dec. 7, 2021 as Paper 28.

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