UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED and
ZYXEL COMMUNICATIONS CORPORATION[1],

Petitioners,

v.

UNM RAINFOREST INNOVATIONS,

Patent Owner.

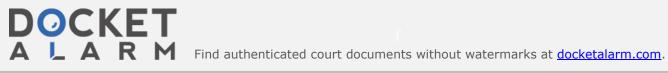PTAB Case No. IPR2021-00375

Patent No. 8,265,096 B2

PATENT OWNER'S SUR-REPLY TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,265,096 B2 CLAIMS 1-4 AND 6-8

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[1] ZyXEL Communications Corporation was joined as a petitioner in this proceeding based on a petition and motion for joinder filed in IPR2021-00734, which were granted.

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I. INTRODUCTION

Patent Owner UNM Rainforest Innovations (hereinafter "UNM" or "Patent Owner") respectfully submits this Sur-Reply to Petitioner's Reply To Patent Owner's Response To Petition for *Inter Partes* Review dated Dec. 28, 2020 ("Petition") of U.S. Patent No. 8,265,096 (EX1001, "'096 Patent") filed by Qualcomm Incorporated ("Qualcomm" or "Petitioner").

II. ARGUMENT

A. *Talukdar* Is Not Prior Art

Neither *Talukdar*, filed on Aug. 13, 2008, nor its provisional application No. 60/956,031, filed on Aug. 15, 2007, predate provisional application No. 60/929,798, filed on Jul. 12, 2007 ("'798 application"), from which the challenged '096 Patent derives priority. Since the '798 application properly supports the priority date of the '096 Patent, *Talukdar* is not prior art to the challenged claims of the '096 Patent.

Petitioner challenges this priority date and argues that Patent Owner "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." Paper 40 at 1-2 (*citing Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (*en banc*). Petitioner argues that Patent Owner improperly attempts to "fill gaps with the knowledge of a POSITA."

Paper 40 at 2. Petitioner mischaracterizes Patent Owner's position, the relevant case law, and the relevant legal standard.

1. Patent Owner Applies The Proper Standard, Which Requires An Objective Inquiry Into The Four Corners Of The Specification <u>From The Perspective Of A Person Of Ordinary Skill In The Art</u>.

Petitioner argues that Patent Owner applied the wrong standard in its analysis. Paper 40 at 3-4 and 5-6. This is incorrect. As noted by the Board (Paper 14 at 25-26), the "test for sufficiency [of the written description] is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). The Federal Circuit explicitly clarified that this analysis takes place in the context of the knowledge of a POSITA. *Id.* ("The test requires an objective inquiry into the four corners of the specification <u>from the perspective of a person of ordinary skill in the art</u>," *i.e.*, a POSITA). This inquiry is a question of fact and is, thus, highly dependent on the facts and arguments presented in each case. *Id.* Further, the Federal Circuit has made clear that "the written description requirement does not demand either examples or an actual reduction to practice." *Id.* Instead, a constructive reduction to practice can satisfy the written description requirement. *Falko–Gunter Falkner v. Inglis*, 448 F.3d 1357, 1366–67 (Fed.Cir.2006). And while "a description that merely renders the invention obvious does not satisfy the requirement," "the

description requirement does not demand any particular form of disclosure, or that the specification recite the claimed invention in *haec verba*." *Ariad Pharms.*, 598 F.3d at 1352 (citations omitted). Patent Owner and its expert, Dr. Vojcic, have shown in detail not only that each element of the challenged claims was disclosed in the '798 application, but also <u>the knowledge of a POSITA at the relevant time</u>, to frame the context of this inquiry. This is an explicit requirement of the enablement analysis set forth by the Federal Circuit. *Id.* at 1351.

> **2. Dr. Vojcic's Supplemental Declaration Properly Sets Forth The Actual Disclosure Of The Provisional Application <u>In Light Of The Knowledge Of A POSITA</u>, As Required By The Federal Circuit.**

Petitioner argues that Dr. Vojcic's identification of the skill level of a POSITA improperly imports required written description into the '798 application's disclosure. Paper 40 at 4-5 and 6-11. This is incorrect. Patent Owner demonstrated, element by element, that the '798 application reasonably conveys the invention to those skilled in the art as of its filing date. Paper 8 at 24-37. Specifically, regarding claim element 1(c) Patent Owner showed that the claim element "<u>wherein each symbol in the second communication system has a shorter symbol period than that in the first communication system</u>" is supported by the '798 application. First, Patent Owner identified the relevant disclosure in the provisional application, which is that the second format is designed to support higher mobility, *i.e.*, the speed at which the mobile unit is moving:

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