

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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QUALCOMM INCORPORATED and  
ZYXEL COMMUNICATIONS CORPORATION<sup>1</sup>,

Petitioners,

v.

UNM RAINFOREST INNOVATIONS,

Patent Owner.

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PTAB Case No. IPR2021-00375  
Patent 8,265,096 B2

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**REPLY IN SUPPORT OF  
PATENT OWNER'S REVISED MOTION TO AMEND**

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<sup>1</sup> 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 Reply in Support of its Revised Motion to Amend to request amendment of certain claims of U.S. Patent 8,265,096 B2 (EX1001, “’096 Patent”), responding to Petitioners’ *Opposition To Patent Owner’s Revised Motion To Amend* (Paper 49) (“Opposition”).

First, Petitioners argue that Patent Owner’s Revised Motion should be expunged because it does not suggest new amendments in addition to those already submitted in the original Motion to Amend. Second, Petitioners argue that when treated as a reply, Patent Owner’s Revised Motion should not be allowed to address the written description support because it is too late to do so. However, the Board already recognized in the Preliminary Guidance that the claims as a whole find proper support in the written description. Further, Petitioners have already unilaterally administered the appropriate self-help by submitting its “sur-reply” in a full 25 pages—which is the allotment for an opposition to a revised motion, and the approach taken by Patent Owner is expressly contemplated by the Office’s rules. Third, Petitioners’ complaint that Patent Owner relies on string citations without further explanation is unfounded because Patent Owner supplied short precise citations along with descriptive parentheticals explaining the disclosure individually

for each and every claim element. Fourth, for the reasons explained below, the proposed substitute claims are not rendered obvious over the prior art.

## **II. PATENT OWNER’S REVISED MOTION SHOULD BE TREATED AS A REPLY**

In its Opposition, Petitioners asked for extraordinary remedies that would be unjust and highly prejudicial to Patent Owner and the integrity of these proceedings. Petitioners concede that Patent Owner’s Motion is a reply and that the Opposition is a sur-reply. Paper 49 at 5. In a parallel filing, Petitioners recognized that there is uncertainty surrounding the interpretation and application of the rules governing the revised motion to amend practice. IPR2021-00377, Paper 47 at 12, fn. 1. Yet, Petitioners ask that Patent Owner’s Motion be disregarded and expunged. Paper 49 at 3-4. Not surprisingly, no decisions, including the ones on which Petitioners rely, support such a draconian result. Petitioners then ask that the written description support that Patent Owner provided in direct response to the Board’s Preliminary Guidance be completely disregarded. *Id.* at 5-8. Again, such drastic relief has not been granted, even in the decisions Petitioners cite. What Petitioners actually seek is to strip Patent Owner of its due process rights by depriving Patent Owner the meaningful opportunity to preserve its claims as required by the AIA and the Office’s implementing rules. Petitioners’ extreme positions must therefore be rejected.

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