

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.

Case IPR2021-00375

Patent No. 8,265,096 B2

**PETITIONER'S SUR-REPLY IN OPPOSITION TO
PATENT OWNER'S REVISED MOTION TO AMEND**

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I. INTRODUCTION

P.O.’s Reply in support of its Revised Motion to Amend (Paper 54, “RMTA Reply”)¹ confirms that, regardless of whether the Board considers P.O.’s Original Motion to Amend (Paper 37, “OMTA”) or Revised Motion to Amend (Paper 44, “RMTA”), both should be denied.

II. P.O.’S UNAUTHORIZED RMTA SHOULD BE EXPUNGED

P.O. does not dispute that its RMTA does not comply with requirement in the Pilot Program Notice to “include[] one or more new proposed substitute claims in place of previously presented substitute claims.” RMTA Reply at 3-4; 84 Fed. Reg. 9497, 9498–99, 9501. Although P.O. cites a portion of the Notice indicating that a revised MTA may also include previously presented claims (RMTA Reply at 4), the Notice makes clear that a revised MTA may only maintain “**some** proposed substitute claims from the original MTA,” which is consistent with the requirement to “include[] one or more new proposed substitute claims.” 84 Fed. Reg. at 9501 (emphasis added). P.O. attempts to circumvent the new-claim rule in the Pilot Program Notice by arguing it “serv[es] no meaningful purpose.” RMTA Reply at 4. In particular, P.O. hypothesizes that it could have complied with the new-claim rule “by simply adding a superficial and inconsequential amendment to create the illusion

¹ The RMTA Reply, Paper 54, is incorrectly labeled as Paper 52 on its first page.

of proper form.” *Id.* P.O. is wrong, as the Notice prohibits amendments unrelated to the preliminary guidance or the opposition to the MTA. *See* 84 Fed. Reg. 9497, 9498 (“A revised MTA **may not** include amendments . . . that are unrelated to issues raised in the preliminary guidance and/or petitioner’s opposition to the MTA.”) (emphasis added). An “inconsequential amendment” as contemplated by P.O. would have failed this requirement. Thus, the failure to include new claims is fatal to P.O.’s RMTA.

Moreover, P.O. does not dispute that its RMTA was unauthorized. RMTA Reply at 3-4; *Orthofix Medical Inc. v. Spine Holdings, LLC*, IPR2020-01411, Paper 33 at 3 (PTAB Oct. 27, 2021) (“We . . . did not authorize Patent Owner to file [a revised MTA] without new proposed substitute claims.”). Nor does P.O. dispute that the Board may expunge its unauthorized paper. RMTA Reply at 3-4. Because P.O.’s RMTA failed to comply with the Pilot Program Notice instructions to which the Board had directed the parties (Paper 23 at 2), and P.O. failed to obtain permission to deviate from those instructions, the RMTA should be expunged. 37 C.F.R. § 42.20(b); 37 C.F.R. § 42.7(a); *Valeo, North America, Inc. v. Magna Elecs., Inc.*, IPR2014-00227, Paper 44 at 2 (PTAB Jan. 14, 2015) (expunging unauthorized motion for “fail[ure] to comply with . . . instruction[s]” in a prior order, given that “Patent Owner did not initiate a conference call” to obtain authorization to deviate from those prior instructions).

Indeed, expungement is particularly warranted here because of the prejudice to Petitioner as a result of not knowing whether P.O.’s RMTA would be treated as a motion or a reply. In its RMTA Reply, P.O. now proclaims that—despite how it titled and styled the RMTA, despite giving itself 25 pages without seeking prior authorization to exceed the 12-page limit for a reply,² and despite otherwise giving no indication to Petitioner (or the Board) it intended to proceed in reply-fashion—its RMTA was actually a reply all along, and P.O. had only styled it as an RMTA “out of an abundance of caution.” RMTA Reply at 3. Based on this retroactive proclamation, P.O. contends that Petitioner has “already taken advantage” of the same remedies provided in *Orthofix Medical*, IPR2020-01411, Paper 33—i.e., clarity that a revised MTA was actually a reply, with an enlarged 25 pages to respond. RMTA Reply at 3.

Even accepting *arguendo* P.O.’s attempt at revisionist history, Petitioner here received neither of the remedies that the Board applied in *Orthofix Medical*. First, due to the compressed schedule, Petitioner was unable to receive advance clarity that P.O.’s RMTA was actually a reply—a point P.O. does not dispute. Opp’n at 3-4 (explaining that the schedule in this proceeding, which was three-times more compressed than the schedule in *Orthofix Medical*, prevented Petitioner from obtaining guidance from the Board in time to adjust its responsive paper); RMTA

² If deemed a reply, the Board should strike at least the unauthorized excess pages.

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