

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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QUALCOMM INCORPORATED,  
Petitioner,

v.

UNM RAINFOREST INNOVATIONS,  
Patent Owner.

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IPR2021-00375 (Patent 8,265,096 B2)  
IPR2021-00377 (Patent 8,249,204 B2)<sup>1</sup>

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Before KRISTEN L. DROESCH, BARBARA A. PARVIS, and  
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

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<sup>1</sup> This Order addresses overlapping issues in the cases listed above. Therefore, we issue one Order to be filed in each case. The parties, however, are not authorized to use this style of filing

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Judges Droesch, Parvis, and Boudreau held a conference call on May 18, 2021, with counsel for the parties. Counsel for Petitioner requested the call seeking authorization to file a reply to the Preliminary Response filed in each of IPR2021-00375 and IPR2021-00377.

Counsel for Petitioner requests authorization to file a reply to the Preliminary Response in each of IPR2021-00375 and IPR2021-00377 to address certain arguments by Patent Owner that the Board should exercise its discretion to deny institution under 35 U.S.C. § 314(a) based on the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB March 20, 2020) (precedential, designated May, 5, 2020) (“*Fintiv*”). More specifically, counsel for Petitioner asserts there is good cause for authorizing a reply to address the issue of real party-in-interest raised by Patent Owner as part of its analysis of the sixth *Fintiv* factor. Counsel for Petitioner also contends there is good cause for authorizing a reply to address the currently scheduled trial date in the related district court litigation in the context of the second *Fintiv* factor because there are multiple trials scheduled for the same date. Counsel for Patent Owner opposes Petitioner’s request, arguing there is not good cause for granting the request because Petitioner could have foreseen the real party-in-interest and trial date issues. Counsel for Patent Owner asserts that additional briefing will not resolve the real party-in-interest issue. Counsel for Patent Owner further contends that the scheduled trial date in the related district court litigation has not changed since the Petition was filed, and that it is common practice to schedule multiple trials for the same date with the expectation that some cases will settle.

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Specific to IPR2021-00375, Petitioner also requests authorization to address Patent Owner's arguments that the challenged claims are entitled to the benefit of the earlier filing date of Provisional Application 60/929,798. Patent Owner opposes Petitioner's request, arguing that this issue was foreseeable and that Petitioner already addressed this issue in its Petition. Patent Owner contends that Petitioner seeks a second bite at the apple.

Specific to IPR2021-00377, Petitioner requests authorization to address Patent Owner's claim construction arguments that the meaning of "compress" excludes quantization. Petitioner contends that this claim construction issue was not foreseeable because it is not addressed in the related district court litigation. Patent Owner opposes Petitioner's request, asserting this claim construction issue was foreseeable because the Patent Specification in numerous instances makes a distinction between the terms compress and quantization.

After considering the parties' contentions made during the conference call, we conclude that good cause exists for authorizing Petitioner's request to file a reply to address the real party-in-interest issue in the context of the sixth *Fintiv* factor and the scheduled trial date of the related district court litigation in the context of the second *Fintiv* factor. We, however, do not conclude that good cause exists for authorizing Petitioner to file a reply to address the entitlement of the challenged claims to the benefit of an earlier filing date and to address the claim construction issue. *See* 37 C.F.R. § 42.108. We note that a reply is not an opportunity to supplement the Petition on the merits.

Accordingly, we authorize Petitioner to file a four (4) page reply to the Preliminary Response to address the real party-in-interest issue in the

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context of the sixth *Fintiv* factor and the scheduled trial date of the related district court litigation in the context of the second *Fintiv* factor. We further authorize Patent Owner to file a four (4) page sur-reply.

#### ORDER

Accordingly, it is:

ORDERED that Petitioner's request for authorization to file a reply to the Preliminary Response is *granted*;

FURTHER ORDERED that Petitioner's reply is limited to four (4) pages and shall be filed no later than May 25, 2021; and

FURTHER ORDERED that Patent Owner is authorized to file a sur-reply, limited to four (4) pages, no later than June 1, 2021.

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