

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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QUALCOM INCORPORATED and ZYXEL COMMUNICATIONS  
CORPORATION<sup>1</sup>

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)  
IPR2021-00582 (Patent 8,565,326 B2)<sup>2</sup>

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

DROESCH, *Administrative Patent Judge*.

ORDER

Expunging Unauthorized Papers, Authorizing Patent Owner to File a Reply  
to the Opposition to Motion to Amend and Preliminary Guidance, and  
Authorizing Petitioner to File a Sur-reply to Patent Owner's Reply  
*37 C.F.R. § 42.5*

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<sup>1</sup> ZyXEL Communications Corporation was joined as a petitioner in these proceedings based on petitions and motions for joinder filed in IPR2021-00734, IPR2021-00739, and IPR2021-00741, respectively.

<sup>2</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.

IPR2021-00375 (Patent 8,265,096 B2)

IPR2021-00377 (Patent 8,249,204 B2)

IPR2021-00582 (Patent 8,565,326 B2)

On April 11, 2022, Patent Owner filed a paper styled “Patent Owner’s Revised Motion to Amend” in IPR2021-00375, IPR2021-00377, and IPR2021-00582. Paper 44.<sup>3</sup> Patent Owner’s Revised Motion to Amend addressed the statutory requirements indicated as deficient in the corresponding Preliminary Guidance (*see, e.g.*, Paper 42), but did not provide new proposed substitute claims, contrary to the requirements set forth for a revised motion to amend in the Office’s Motion to Amend Pilot Program Notice.<sup>4</sup> Paper 44. Patent Owner’s Revised Motion to Amend was 25 pages in length. *See id.* In response, Petitioner filed a paper styled “Petitioner’s Opposition to Patent Owner’s Revised Motion to Amend,” also 25 pages in length. Paper 49. Thereafter, the parties respectively filed a “Reply in Support of Patent Owner’s Revised Motion to Amend” and a “Petitioner’s Sur-reply in Opposition to Patent Owner’s Revised Motion to Amend.” Papers 52, 54.

During oral argument on May 12, 2022, counsel for Patent Owner indicated that prior to filing, it was not clear whether Patent Owner should file a revised motion to amend or a reply to Petitioner’s Opposition to the Motion to Amend and Preliminary Guidance. Likewise, counsel for Petitioner indicated that prior to filing, it was not clear whether Patent

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<sup>3</sup> All references are to the papers filed in IPR2021-00375. Similar papers were filed in IPR2021-00377 and IPR2021-00582.

<sup>4</sup> *See* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 84 Fed. Reg. 9497, 9499 (Mar. 15, 2019) (“A revised MTA includes one or more new proposed substitute claims in place of previously presented substitute claims to address issues identified in the preliminary guidance and/or the petitioner’s opposition.”).

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Owner's Revised Motion to Amend was, in effect, a reply and whether Petitioner should file an Opposition to Patent Owner's Revised Motion to Amend or a sur-reply. Counsel for Patent Owner did not seek guidance or clarification from the Board before filing its Revised Motion to Amend. Similarly, counsel for Petitioner did not seek guidance or clarification from the Board before filing its Opposition to Patent Owner's Revised Motion to Amend.

Patent Owner's Revised Motion to Amend does not comply with the requirement that it include one or more new proposed substitute claims. *See* Motion to Amend Pilot Program Notice, 84 Fed. Reg. at 9499. Because it does not include one or more new proposed substitute claims, Patent Owner's Revised Motion to Amend is, in effect, a reply that fails to comply with the 12 pages limit for a reply to an opposition to a motion to amend. *See* Consolidated Trial Practice Guide<sup>5</sup> at 38; *see also* 84 Fed. Reg. 64,280 (Nov. 21, 2019). Similarly, because Patent Owner's Revised Motion to Amend does not include one or more new proposed substitute claims, Petitioner's Opposition to Patent Owner's Revised Motion to Amend is, in effect, a sur-reply that fails to comply with the 12 pages limit for a sur-reply. *See id.* In the absence of presenting one or more new proposed substitute claims in a revised motion to amend, the parties are not authorized to file briefing beyond a reply to an opposition to a motion to amend and a corresponding sur-reply. *See generally* Motion to Amend Pilot Program Notice.

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<sup>5</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

IPR2021-00375 (Patent 8,265,096 B2)

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In view of the unauthorized papers filed in IPR2021-00375, IPR2021-00377, and IPR2021-00582, we determine it is necessary to expunge these papers from the record of each of these proceedings. *See* 37 C.F.R. § 42.7. Accordingly, we expunge: IPR2021-00375, Paper 44 (Patent Owner’s Revised Motion to Amend), Paper 49 (Petitioner’s Opposition to Patent Owner’s Revised Motion to Amend), Paper 54 (Reply in Support of Patent Owner’s Motion to Amend), and Paper 56 (Petitioner’s Sur-reply in Opposition to Patent Owner’s Motion to Amend); IPR2021-00377, Paper 42 (Patent Owner’s Revised Motion to Amend), Paper 47 (Petitioner’s Opposition to Patent Owner’s Revised Motion to Amend), Paper 52 (Reply in Support of Patent Owner’s Motion to Amend), and Paper 54 (Petitioner’s Sur-reply in Opposition to Patent Owner’s Motion to Amend); and IPR2021-00582, Paper 40 (Patent Owner’s Revised Motion to Amend), Paper 45 (Petitioner’s Opposition to Patent Owner’s Revised Motion to Amend), Paper 50 (Reply in Support of Patent Owner’s Motion to Amend), and Paper 52 (Petitioner’s Sur-reply in Opposition to Patent Owner’s Motion to Amend).

To proceed in a manner consistent with the Board’s policy of securing the just resolution of every proceeding, we authorize Patent Owner to refile its response to the Petitioner’s Opposition and the Preliminary Guidance in IPR2021-00375, IPR2021-00377, and IPR2021-00582 as a paper styled as a “Reply to Petitioner’s Opposition to Patent Owner’s Motion to Amend,” and further authorize Petitioner to file in in IPR2021-00375, IPR2021-00377, and IPR2021-00582 a sur-reply responsive to the “Reply to Petitioner’s Opposition to Patent Owner’s Motion to Amend.”

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More specifically, Patent Owner is authorized to file in IPR2021-00375, IPR2021-00377, and IPR2021-00582, no later than May 23, 2022, a paper styled as a “Reply to Petitioner’s Opposition to Patent Owner’s Motion to Amend.” The Reply to Petitioner’s Opposition to Patent Owner’s Motion to Amend must be substantively identical to the corresponding previously filed Patent Owner’s Revised Motion to Amend. Patent Owner is not authorized to present new or augmented arguments compared to the arguments presented in its corresponding previously filed Patent Owner’s Revised Motion to Amend. Patent Owner, however, may omit the claim appendix. Accompanying the Reply to Petitioner’s Opposition to Patent Owner’s Motion to Amend, Patent Owner must file as an exhibit a redline copy of its Reply to Petitioner’s Opposition to Patent Owner’s Motion to Amend highlighting the differences between it and the corresponding previously filed Patent Owner’s Revised Motion to Amend. Because the previously filed Patent Owner’s Revised Motion to Amend was 25 pages in length, we waive the page limit for Patent Owner’s Reply to Petitioner’s Opposition to Patent Owner’s Motion to Amend. Accordingly, Patent Owner is authorized 25 pages for its Reply to Petitioner’s Opposition to Patent Owner’s Motion to Amend.

Petitioner is authorized to file IPR2021-00375, IPR2021-00377, and IPR2021-00582, no later than June 2, 2022, a sur-reply that is responsive to the Reply to Petitioner’s Opposition to Patent Owner’s Motion to Amend.

[P]etitioner’s sur-reply in this context may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. The sur-reply may respond only to the preliminary guidance . . . and arguments made in the patent owner’s reply brief, comment on reply declaration testimony, and/or point to cross examination testimony.

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