

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED,

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 MOTION TO AMEND**

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I. INTRODUCTION

Patent Owner's Motion to Amend (Paper 27, hereafter "MTA" or "Motion") seeks to replace original claims 1-4 and 6-7 with substitute claims 44-47 and 49-50. P.O.'s Reply (Paper 64, hereafter "Reply") does not change any of the reasons why the MTA should be denied. Accordingly, P.O.'s MTA should be denied for at least the following reasons.

First, the MTA's failure to show written description support is fatal, because it is too late to do so in the first instance on reply. Second, even if it were not too late in reply, P.O. still did not comply with the precedential *Lectronsonics* decision, because even its Reply failed to meet its burden of production to show that **all** elements of the proposed amended claim were supported by the '798 Provisional Application. Third, the proposed substitute claims are rendered obvious over the prior art; the Board has already found that the combination of *Talukdar* and *Li* discloses a hybrid frame structure wherein the second communication system has symbols with a shorter symbol period than the symbols of the first communication system, and the parties **agree** that the newly added limitation is inherently disclosed when the second communication system has such symbols.

II. THE BOARD SHOULD DENY THE MTA BECAUSE IT FAILS TO COMPLY WITH THE APPLICABLE RULES

A. The Board Should Deny the MTA Because Attempted Showing of Written Description Support in Reply is Too Late

In its Reply, P.O. does not dispute that, under 37 C.F.R. § 42.121(b), it was required to show written description support for each limitation of the proposed substitute claims, including the retained original claim limitations, in its MTA. Nor does P.O. dispute that the MTA failed this requirement. *See Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 8 (P.T.A.B. Feb. 25, 2019) (precedential) (“[T]o meet [the] requirement” of 37 C.F.R. § 42.121(b), “the motion must set forth written description support for each proposed substitute claim as a whole, and not just the features added by the amendment.”); Paper 27 at 3–12 (failing to address, in any fashion, the original claim limitations of the proposed substitute claims). Instead, on reply, P.O. purports to provide a showing of written description support for the original limitations of the proposed substitute claims. Reply, Paper 64, at 5–20.

This attempt on reply comes too late. As the moving party, P.O. was obligated to present in its original MTA all of its arguments and evidence showing written description support for each limitation of the proposed substitute claims. *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 8 (P.T.A.B. Feb. 25, 2019) (precedential) (“**All arguments and evidence** in support of the motion to amend **shall be in the motion itself.**”) (emphasis added); 37 C.F.R. § 42.23(b) (“All arguments for the relief requested in a motion must be made in the motion,” and “[a] reply may only respond to arguments raised in the corresponding opposition”); Trial

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