

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 BRIEF ON THE ISSUES OF PATENT OWNERSHIP
AND STANDING

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Petitioner's Updated Exhibit List

Pursuant to 37 C.F.R. § 42.63(e), Petitioner submits its updated exhibit list:

Exhibit	Description
Ex. 1001	U.S. Patent No. 8,265,096 ("the '096 patent")
Ex. 1002	Declaration of Dr. Sumit Roy ("Roy")
Ex. 1003	<i>Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC</i> , Paper 24, IPR2019-01393 (PTAB June 16, 2020)
Ex. 1004	Eleventh Supplemental Order Regarding Court Operations Under Exigent Circumstances Created by the Covid 19 Pandemic (W.D. Tex. Dec. 10, 2020)
Ex. 1005	Excerpts from JEFFREY G. ANDREWS ET AL., FUNDAMENTALS OF WIMAX (2007)
Ex. 1006	Five Criteria Statement for P802.16m PAR Proposal, IEEE 802.16-06/055r3 (Nov. 15, 2006)
Ex. 1007	IEEE 802.16m System Requirements, IEEE 802.16m-07/002r4 (Oct. 19, 2007)
Ex. 1008	Listing of Challenged '096 Patent Claims
Ex. 1009	U.S. Provisional App. No. 60/929,798
Ex. 1010	Excerpts from '096 Patent File History
Ex. 1011	Claim Construction Order in <i>STC.UNM v. Apple Inc.</i> , No. 1-20-cv-00351 (W.D. Tex. Apr. 9, 2020), ECF No. 69 ("Markman Order")
Ex. 1012	U.S. Pub. No. 2009/0067377 A1 ("Talukdar")
Ex. 1013	U.S. Provisional Application No. 60/956,031 ("Talukdar Provisional")
Ex. 1014	Canadian Patent Application No. 2 581 166 A1 ("Wang")
Ex. 1015	WIPO Handbook on Industrial Property Information and Documentation, "Examples and Kinds of Patent Documents" (May 2016)
Ex. 1016	U.S. Pub. No. 2007/0155387 A1 ("Li")
Ex. 1017	U.S. Pub. No. 2007/0104174 A1 ("Nystrom")
Ex. 1018	U.S. Pub. No. 2008/0095195 ("Ahmadi")

Exhibit	Description
Ex. 1019	Excerpts from William Stallings, WIRELESS COMMUNICATIONS AND NETWORKS (2D ED. 2005)
Ex. 1020	U.S. Patent No. 7,460,466 B2 (“Lee”)
Ex. 1021	U.S. Patent No. 8,462,611 B2 (“Ma”)
Ex. 1022	Fixed, nomadic, portable and mobile applications for 802.16-2004 and 802.16e WiMAX networks (November 2005)
Ex. 1023	Mohammad Azizul Hasan, Performance Evaluation of WiMAX/IEEE 802.16 OFDM Physical Layer (June 2007)
Ex. 1024	U.S. Patent No. 7,710,910 B2 (“Ode”)
Ex. 1025	IEEE 802.16m System Requirements, IEEE 802.16m-07/002r4 (Jan. 12, 2007)
Ex. 1026	U.S. Pub. No. 2004/0037215 A1 (“Hwang”)
Ex. 1027	Yasamin Mostofi, <i>ICI Mitigation for Pilot-Aided OFDM Mobile Systems</i> (IEEE, Vol. 4, No. 2, Mar. 2005)
Ex. 1028	Declaration of Dr. Robert Akl
Ex. 1029	Scott McKeown, <i>District Court Trial Dates Tend to Slip After PTAB Discretionary Denials</i> , Patents Post Grant (available at: https://www.patentspostgrant.com/district-court-trial-dates-tend-to-slip-after-ptab-discretionary-denials/)
Ex. 1030	Declaration of Jonah D. Mitchell in Support of Petitioners’ Motion for <i>Pro Hac Vice</i> Admission
Ex. 1031	Declaration of Christine M. Morgan in Support of Petitioners’ Motion for <i>Pro Hac Vice</i> Admission
Ex. 1032	ITRI’s Recorded Assignment, Reel/Frame No. 045200/0980
Ex. 1033	Sino Matrix’s Recorded Assignment, Reel/Frame No. 021275/0468
Ex. 1034	UNM’s Recorded Assignment, Reel/Frame No. 046854/0173
Ex. 1035	June 22, 2021 hearing transcript before Judge Albright in UNM’s litigations against Dell and ASUSTek.
Ex. 1036	Printout from Public PAIR showing the correspondence address of record for the ’096 patent
Ex. 1037	Excerpt of ’096 file history showing ITRI’s prosecution counsel

I. INTRODUCTION

At the Board's request (Paper 19 at 4), Qualcomm submits this brief to address patent ownership and standing. UNM has consistently identified itself as the patent owner here, in the parallel litigation, and in other proceedings. Indeed, it only introduced the specter of an ownership dispute here – *after* the Board instituted review – as a gambit to halt review, but its position on its status as the patent owner elsewhere has never wavered. UNM is the assignee of record based on the face of the publicly-recorded assignments, which are presumed valid in this proceeding. When the Board has considered attempts by record patent owners, like UNM, to leverage ownership disputes in other forums to interrupt PTAB proceedings, it has rejected them. The same should follow here. Proffering no evidence to rebut the presumption flowing from the recorded assignments, UNM has standing to participate as the patent owner.

Moreover, no other considerations warrant deviating from the orderly completion of this IPR. Indeed, by serving the correspondent address of record for the '096 patent, Qualcomm met all service obligations necessary to proceed. Moreover, to the extent there are any concerns regarding Industrial Technology Research Institute ("ITRI"), here, the correspondent address of record for the '096 patent is actually ITRI's prosecution counsel. And, ITRI also is on notice of the IPR through the parallel litigation. That it has chosen not to participate is of no

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