

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED and
ZYXEL COMMUNICATIONS CORPORATION¹,

Petitioner,

v.

UNM RAINFOREST INNOVATIONS,

Patent Owner.

PTAB Case No. IPR2021-00375

Patent No. 8,265,096 B2

PATENT OWNER RESPONSE TO PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 8,265,096 B2
CLAIMS 1-4 AND 6-8

¹ ZyXEL Communications Corporation was joined as a petitioner in this proceeding based on a petition and motion for joinder filed in IPR2021-00734, which were granted.

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I. INTRODUCTION

Patent Owner UNM Rainforest Innovations (hereinafter “UNM” or “Patent Owner”) respectfully submits this Patent Owner Response to the Petition for *Inter Partes* Review dated Dec. 28, 2020 (“Petition”) of U.S. Patent No. 8,265,096 (EX1001, “’096 Patent”) filed by Qualcomm Incorporated (“Qualcomm” or “Petitioner”). Qualcomm submitted an effectively verbatim copy of Intel’s IPR2020-01576 (which has already been dismissed), albeit with the signature of a different expert witness. *Intel Corporation v. UNM Rainforest Innovations f/k/a STC.UNM*, Case IPR2020-01576 (Paper 8) (PTAB Feb. 02, 2021) (Termination Decision). Petitioner asserts that claims 1-4 and 6-8 of the ’096 Patent are unpatentable on two grounds based solely on 35 U.S.C. § 103:

Ground 1 – Claims 1-4, 6, and 7 are unpatentable as obvious over *Talukdar* and *Li*.

Ground 2 – Claim 8 is unpatentable as obvious over *Talukdar* and *Nystrom*.

The Preliminary Response was timely filed based on the Board’s Notice Of Filing Date Accorded To Petition And Time For Filing Patent Owner Preliminary Response. Paper 5. The Board instituted the proceeding on July 19, 2021. Paper 13. This Patent Owner’s Response is timely pursuant to the Board’s Scheduling Order and Revised Scheduling Order. Papers 15, 20.

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