UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON.,
Patent Owner.

Case IPR2022-00648
Patent No. 9,860,044

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBIT LIST

Exhibit No.	Description
2001	Declaration of Kayvan B. Noroozi in Support of Motion for Admission *Pro Hac Vice*

I. Introduction

Although the Petition obfuscates its allegations through a complex series of details regarding certain aspects of the technical standards, the Petition ultimately fails to make a *prima facie* showing of obviousness, and presents no reasonable likelihood of success as to the unpatentability of any challenged claim.

All challenged claims require a "reserved" first set of radio resources for the sending of uplink control information from a user terminal receiving downlink transmissions on only a single downlink carrier (a UE not utilizing carrier aggregation), *see, e.g.,* claim 1 limitation [1.2], and a "reserved" second set of radio resources for sending uplink control information from a user terminal receiving downlink transmissions on multiple downlink carriers (a UE utilizing carrier aggregation). *See, e.g.,* claim 1 limitation [1.3].[1]

The Petition does not allege that ***any*** prior art it relies upon actually taught or suggested the use of a set of radio resources reserved for a user terminal based on whether that user terminal has been scheduled for single carrier or multi-carrier downlink transmissions, as recited by the challenged claims. Instead, the Petition presents a convoluted series of allegations as to certain general capabilities contained within portions of the technical specifications, and then alleges that it

[1] Limitation 1.3 also covers an alternative implementation not relevant to this proceeding.

would have been "obvious" to manipulate numerous base station parameters, and to even add entirely new, previously unspecified parameters and formulas, to arrive at the invention of the challenged claims.

The Petition, however, provides no plausible reason ***why*** an ordinary artisan would have undertaken the complex series of steps and novel creations the Petition proposes in order to reconfigure a base station in the precise manner necessary to achieve the invention of the challenged claims. Indeed, with respect to multiple aspects of its obviousness theory, the Petition provides no motivation at all, and thus fails for that reason alone. And while the Petition does allege motivations for certain other aspects, those motivations are conclusory and generic, and bear no relationship to the specific modifications the Petition's theory requires. The Petition's obviousness allegations thus fail for lack of evidence of a motivation to combine. *PersonalWeb Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 991 (Fed. Cir. 2017); *In re NuVasive, Inc.*, 842 F.3d 1376, 1381-82 (Fed. Cir. 2016); *In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333-34 (Fed. Cir. 2016); *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1364-67 (Fed. Cir. 2015); *ActiveVideo Networks v. Verizon*, 694 F.3d 1312, 1328 (Fed. Cir. 2012).

Nor does the Petition provide sufficient evidence to support the conclusion that an ordinary artisan would have had a reasonable expectation of success in

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