

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

GENERAL ACCESS SOLUTIONS, LTD.,	§	
	§	
Plaintiff,	§	CIVIL ACTION NO. 2:20-CV-00007-RWS
	§	
v.	§	
	§	
SPRINT SPECTRUM LLC, SPRINTCOM, INC, ASSURANCE WIRELESS USA, L.P.,	§	
	§	
Defendants.	§	

ORDER

Before the Court is Plaintiff General Access’s Motion for Partial Summary Judgment of Validity on Grounds of IPR Estoppel. Docket No. 159. The Court heard argument on the motions at the dispositive motions hearing on June 17, 2021.¹ Having considered the briefing and oral argument, the Court believes that General Access’s motion should be **DENIED**.

BACKGROUND

In July 2017, Sprint initiated an IPR challenging the validity of the ’931 Patent. Relevant to the current matter, Sprint challenged independent claims 1 and 19 and dependent claims 28 and 29. Sprint raised three grounds for challenge. Docket No. 159-2 at 4–5. The principal prior art reference was Ulrich Vornefeld *et al.*, “SDMA Techniques for Wireless ATM,” IEEE Communications Magazine (November 1999) (“Vornefeld”). Docket No. 159-4. At the time the

¹ The Court also heard argument on several additional motions—of those, still pending are Plaintiff’s Motion for Partial Summary Judgment of Validity on the Ground That the Asserted Navini System is Not Prior Art to the ’931 Patent (Docket No. 166); Sprint’s *Daubert* Motion to Exclude the Damages Opinions of Mr. David Kennedy (Docket No. 163); Sprint’s Motion For Summary Judgment of No Pre-Suit Willful Infringement (Docket No. 164); Sprint’s Motion to Strike Doctrine of Equivalents Theory from the Expert Report of Dr. Vijay K. Madiseti (Docket No. 156); Sprint’s Motion for Summary Judgment of No Earlier Conception Date for the Asserted Claims (Docket No. 160); and Sprint’s Motion to Strike Mr. Kennedy’s Supplemental Opinions Related to Sprint’s License Agreements (Docket No. 158).

Vornefeld paper was written, the authors all held positions at RWTH Aachen University of Technology: (i) Ulrich Vornefeld was “working towards his Ph.D. at the research group of the Chair of Communication Networks at RWTH Aachen University,” *id.* at 57; (ii) Christopher Walke was a member of “the Smart Antenna Group at the Institute of High Frequency Technology at Aachen University as a research assistant,” *id.*; and (iii) Bernhard Walke was a “full professor for communication networks” at RWTH Aachen University. *Id.*

The PTAB issued a final written decision dated March 7, 2019. *Sprint Spectrum L.P. v. Gen. Access Sols., Ltd.*, No. IPR2017-01889, 2019 WL 1096544 (P.T.A.B. Mar. 7, 2019). In its decision, the PTAB invalidated independent claims 1 and 19. As the PTAB noted, General Access conceded the unpatentability of independent claims 1 and 19. *Id.* at *3. Specifically, General Access acknowledged that “[Vornefeld] knocks out our independent claims. We concede that.” *Id.* (quoting Docket No. 159-5 at 56:19–57:9).

On appeal, the Federal Circuit affirmed the validity of dependent claims 28 and 29 and, in so doing, rejected Sprint’s argument that Vornefeld rendered them unpatentable. *Sprint Spectrum L.P. v. Gen. Access Sols., Ltd.*, 812 F. App’x 999, 1007 (Fed. Cir. 2020).

After the Federal Circuit affirmed the validity of claims 28 and 29, Sprint served its supplemental invalidity contentions in this matter. Docket No. 159-6. In its supplemental contentions, Sprint identified the “Navini System” as alleged prior art. The Navini System was a broadband wireless access system developed and marketed under the name Ripwave by Navini Networks, Inc. in the early 2000s. Docket No. 187-2 ¶ 116. On December 18, 2020, Sprint served its opening expert report containing opinions that claims 28 and 29 are obvious in view of the Navini System combined with the knowledge of a person of ordinary skill in the art and/or in combination with Toshimitsu. Docket No. 187-3 ¶ 127.

Vornefeld does not reference Navini Networks, Inc. or the Navini System. *See generally* Docket No. 159-4. The biographies of the authors do not indicate that they had a connection to Navini Networks, Inc. *See id.* at 57.

LEGAL STANDARD

I. Summary Judgment

Federal Rule of Civil Procedure 56 requires that summary judgment be granted “if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” FED. R. CIV. P. 56(a). In determining whether a genuine issue for trial exists, a court views all inferences drawn from the factual record in the light most favorable to the nonmoving party. *Matsushita Elec. Indus. v. Zenith Radio*, 471 U.S. 574, 587 (1986). The moving party bears “the initial responsibility of informing the district court of the basis for its motion, and identifying those portions of the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, which it believes demonstrate the absence of a genuine issue of material fact.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986) (internal quotations omitted); *Ragas v. Tenn. Gas Pipeline Co.*, 136 F.3d 455, 458 (5th Cir. 1998). Once a party has made that showing, the nonmoving party bears the burden of establishing otherwise by supporting its contentions with some evidence. *Geiserman v. MacDonald*, 893 F.2d 787, 793 (5th Cir. 1990) (citing *Celotex*, 477 U.S. at 324).

II. IPR Estoppel

When a party seeks *inter partes* review of a claim in a patent and the IPR results in a final written decision, the party “may not assert [] in a civil action arising in whole or in part under section 1338 of title 28 . . . that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that” IPR. 35 U.S.C. § 315(e)(2). A petitioner may only seek

IPR of a patent on the “basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). Accordingly, prior art “systems” cannot be raised during IPR proceedings. *Biscotti Inc. v. Microsoft Corp.*, No. 2:13-CV-1015, 2017 WL 2526231, at *8 (E.D. Tex. May 11, 2017).

ANALYSIS

General Access contends that the combination of Toshimitsu and Navini is an estopped “ground.” Docket No. 159 at 9. General Access posits that IPR estoppel applies to “grounds” that were or could have been raised in IPR and, in the context of the broader statutory scheme, “grounds” captures a category of arguments that is distinct from and broader than specific items of evidence like patents or printed publications. *Id.* Thus, to General Access, the question is whether Sprint could have raised the same substantive arguments in IPR that it now makes about Toshimitsu rendering claims 28 and 29 obvious. *Id.* General Access rests its argument on *Wasica Fin. GmbH v. Schrader Int’l, Inc.*, 432 F. Supp. 3d 448 (D. Del. 2020), *appeal dismissed*, No. 2020-2124, 2020 WL 8374870 (Fed. Cir. Sept. 24, 2020). *Id.* at 10–11.

General Access further contends that Sprint could have raised Toshimitsu in combination with Vornefeld to make the same obviousness arguments in IPR that it advances here. *Id.* at 11. Instead, General Access argues, Sprint relies on the Navini System as a primary reference to allegedly disclose all elements of independent claims 1 and 19 and on a combination of the Navini System and Toshimitsu in arguing that dependent claims 28 and 29 would have been obvious. *Id.* But, General Access argues, Toshimitsu could have been raised in IPR to challenge the validity of claims 28 and 29 in precisely the same way by using it with Vornefeld as the base reference. *Id.* at 12. And since General Access conceded that Vornefeld disclosed all of the elements of independent claims 1 and 19, the Navini System is, at best, duplicative of Vornefeld. *Id.*

General Access further argues that the Navini System provides nothing new over the Vornefeld base reference asserted in IPR. *Id.* General Access contends that the mere fact that a specific combination was not presented does not suffice, as Sprint must show that the new combination is meaningfully different from what it did present or reasonably could have presented in IPR. *Id.*

Lastly, General Access argues that permitting Sprint to rely on Toshimitsu would effectively nullify statutory IPR estoppel. General Access contends that a “reference-by-reference reading of the estoppel provision ‘could gut [it] entirely’ ” because “defendants will simply swap out publications that were available through a diligent search with the same prior art, only in a slightly different format or in a version that could not have been found in a search[.]” *Id.* at 14 (citing *Wasica*, at 455 n.7). General Access asserts that Sprint attempts this “swap” here and, if Sprint is allowed to proceed with its Toshimitsu arguments, the estoppel provision would amount to nothing more than an invitation to hold some arguments in reserve during IPR and later spring them on patentees under the guise of “system-related combinations.” *Id.*

Sprint responds that IPR estoppel does not apply. Sprint argues that the IPR estoppel provision only applies to invalidity “grounds” that a petitioner raised or reasonably could have raised during its IPR. Docket No. 187 at 8 (citing 35 U.S.C. § 315(e)(2)). Sprint posits that the key question in determining the scope of IPR estoppel is what constitutes a “ground” that was “raised or reasonably could have been raised” during an IPR. *Id.* Sprints argues that as the only bases for challenging a claim in an IPR are anticipation and obviousness under §§ 102 and 103 based on prior art patents or printed publications, invalidity “grounds” in an IPR may only be based on prior art “patents or printed publications.” *Id.* Indeed, it is axiomatic that prior art “systems” cannot be asserted as an invalidity “ground” in an IPR. *Id.* Further, it is undisputed that the Navini

System is a “system,” and that such “system” was not expressly raised as a “ground” in IPR. *Id.* Thus, Sprint argues, the Navini System—either alone or in combination with Toshimitsu—was not raised and could not have been raised as an invalidity “ground” in IPR. *Id.*

Sprint responds that General Access’s arguments otherwise are contrary to law. Sprint argues that General Access’s argument that “[t]he statutory framework establishing IPR distinguishes ‘grounds’ from ‘evidence,’ including individual ‘patents and printed publications,’ ” Docket No. 159 at 8, and that “IPR estoppel attaches not just to individual items of evidence, but more broadly to arguments,” *id.* at 11, is flawed. Docket No. 187 at 9. Under this interpretation of the statute, if a prior art system is duplicative in scope of any patent or printed publication that was asserted or could have been asserted in an IPR, regardless of whether the system art is specifically described in such patent or printed publication, the invalidity ground based on such patent or printed publication is broad enough to cover the system art and, therefore, estoppel applies. *Id.* Sprint contends that courts do not follow this position. *Id.*

Moreover, Sprint contends that General Access’s reliance on *Wasica* is misplaced. Sprint argues that the distinction between “grounds” and “evidence” discussed in *Wasica* is designed to prevent an accused infringer in litigation from relying on a prior art system that is specifically described in a patent or printed publication that was or could have been submitted in an IPR. *Id.* The rationale for that distinction is that “moving from a printed publication (such as a manual describing a device) in an IPR proceeding to a physical product (such as the device described in the manual) in litigation merely swaps evidentiary proofs supporting the same ‘ground’ for invalidity that was raised or reasonably could have been raised during the IPR.” *Id.* (citing *Wasica*, 432 F. Supp. 3d at 453–54). In that situation, according to *Wasica*, the invalidity arguments are essentially the same (*i.e.*, the prior art system discloses the elements of the challenged claims),

only the evidence supporting the invalidity arguments is different (*i.e.*, the prior art system itself versus a printed publication specifically describing that system). *Id.*

But here, Sprint argues, Sprint is not trying to “swap” a physical product—the Navini System—for a printed publication specifically describing that system—Vornefeld. *Id.* at 12. Rather, Sprint argues that it is relying on a prior art system that is completely separate and distinct from Vornefeld. *Id.* Sprint asserts that it is undisputed that there is no relationship between the Navini System and Vornefeld. *Id.* Thus, unlike in *Wasica*, Sprint argues that it is not relying on a prior art system that is described in a printed publication that was or could have been raised in its IPR. *Id.* at 13.

Sprint further responds that General Access misrepresents Sprint’s obviousness case. *Id.* While General Access argues that Sprint is relying on the Navini System as a substitute for Vornefeld as the primary reference disclosing the elements of independent claims 1 and 19, Docket No. 159 at 2, 3, 11, Sprint is actually relying on the Navini System to disclose independent claims 1 and 19 and portions of the additional elements of dependent claims 28 and 29. *Id.* (citing Docket No. 187-2 ¶¶ 216–222). Sprint then relies on Toshimitsu as disclosing other elements of claims 28 and 29 such that the Navini System and Toshimitsu together disclose all the elements of dependent claims 28 and 29. *Id.* Therefore, Sprint argues, General Access’s motion is based on a faulty premise.

IPR estoppel does not apply here. Systems art cannot be raised in IPR. Thus, the Navini System—either alone or in combination with Toshimitsu—was not raised and could not have been raised as an invalidity “ground” in Sprint’s IPR. Courts may be split on whether there is some application of estoppel when a reference raised at IPR describes the systems art raised in the district court. *See e.g., Wasica*, 432 F. Supp. 3d 448; *but cf. Intell. Ventures II LLC v. Kemper Corp.*, No.

6:16-CV-0081, 2016 WL 7634422, at *3 (E.D. Tex. Nov. 7, 2016) (“[D]efendants have considerable latitude in using prior art systems (for example, software) embodying the same patents or printed publications placed before the PTO in IPR proceedings. This ability to raise such prior art systems in a subsequent district court litigation is always present.” (quotation omitted)). General Access’s argument, however, goes even further. General Access asks this Court to apply estoppel to a systems combination that could not be raised and was not described or discussed in IPR. Indeed, the logical conclusion of General Access’s argument would be that Sprint could not raise any systems art in this matter.² The Court will not endorse this expansion of estoppel law.

Following this reasoning, General Access’s reliance on *Wasica* is unavailing. In *Wasica*, the defendant sought to present three obviousness challenges at trial: “(1) Oselin in view of the ZR-1 Sensors, (2) Oselin in view of the ZR-1 Sensors and in further view of [certain] patents or printed publications, and (3) the ZR-1 Sensors in view of Oselin.” *Wasica*, 432 F. Supp. 3d at 452. The Oselin reference had been asserted in defendant’s IPR and the ZR-1 Sensors were a physical product “associated with the Chevrolet Corvette.” *Id.* After acknowledging that “[p]hysical products cannot be raised during IPR proceedings,” the *Wasica* court stated that “patents or printed publications that relate to and describe a physical product can, like other patents and printed publications, be raised in an IPR.” *Id.* at 453. The *Wasica* court then recognized that it was *undisputed* that “a 1990 article the parties refer to as ‘Siuru’ . . . is a printed publication that discloses all of the relevant features of the ZR-1 Sensors and that Siuru reasonably could have been raised during IPR.” *Id.* The facts in this matter are easily distinguishable from those pertinent

² General Access argues that the systems art alleged here is necessarily subsumed by Vornefeld because “[g]iven that General Access *conceded* that Vornefeld disclosed all of the elements of independent claims 1 and 19, the Navini system is at best duplicative of Vornefeld.” Docket No. 159 at 12 (emphasis in original). General Access’s reasoning leads to the conclusion that, because it conceded the disclosure in Vornefeld, any prior art system that also discloses claims 1 and 19 are subsumed by Vornefeld and should be estopped. This is not the law. Further, Sprint is in fact alleging that the Navini System discloses claims 1 and 19 *and* elements of 28 and 29, not just that the Navini System discloses claims 1 and 19. Docket No. 187 at 13.

in *Wasica*. The primary reference system in the combination that General Access seeks to estop Sprint from asserting is not described by the printed publication General Access equates it to from the IPR. General Access's motion for summary judgment is thus **DENIED**.

So ORDERED and SIGNED this 21st day of July, 2021.


ROBERT W. SCHROEDER III
UNITED STATES DISTRICT JUDGE