

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,

Petitioner,

v.

TOGAIL TECHNOLOGIES LTD.,

Patent Owner.

Case IPR2023-00338

Patent 10,791,502

PATENT OWNER’S PRELIMINARY RESPONSE TO PETITION

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Complaint, <i>Togail Technologies Ltd. v. Apple Inc.</i> , Case No. 6:22-cv-00326-ADA, Dkt. No. 1 (W.D. Tex. Mar. 28, 2022)
2002	Proof of Service, <i>Togail Technologies Ltd. v. Apple Inc.</i> , Case No. 6:22-cv-00326-ADA, Dkt. No. 6 (W.D. Tex. Apr. 4, 2022)

I. INTRODUCTION

Patent Owner Togail Technologies Ltd. (“Patent Owner”) submits this preliminary response to Petitioner Unified Patents, LLC’s (“Petitioner”) Petition for *inter partes* review of U.S. Patent No. 10,791,502 (“the ’502 Patent”).

First, the Board should exercise its discretion to deny the Petition under § 314(a) because this is the type of proceeding that the Board’s precedential decisions—*Valve I*, *Valve II*, and *General Plastic*—were developed to prevent. Here, the vast majority of *General Plastic* factors weigh against institution in light of copending IPR2023-00720 challenging the same claims of the ’502 patent with closely-related art.

Second, the Board should deny institution because Petitioner fails to establish a reasonable likelihood of unpatentability for the independent claims under any Ground, let alone present compelling evidence of unpatentability. For Ground 1, the Petition fails to establish that *Lee* teaches “transmitting a first SI request message to a base station (BS) after determining that the UE is in a connected state” as required by all challenged claims of the ’502 Patent. For Grounds 2-3, the Petition fails to establish that *Oppo* teaches “transmitting a second SI request message to the BS only when the at least one requested SIB is not received and the prohibit timer expires” as required by all challenged claims of the ’502 patent.

Even if the Board concludes that a discretionary denial is not appropriate, Petitioner has not established a reasonable likelihood of unpatentability under any ground or challenged claim. Accordingly, the Board should deny institution.

A. INSTITUTION SHOULD BE DENIED UNDER § 314(a)

35 U.S.C. § 314(a) gives the Board discretion to deny instituting “follow on” petitions. *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (Sept. 6, 2017) (precedential)

. The Board has often exercised this discretion to deny institution of a subsequent petition against a previously challenged patent where the subsequent petition is filed by a new petitioner. *See, e.g., NetApp v. Realtime Data*, IPR2017-01195, Paper 9 (Oct. 12, 2017) (“*NetApp*”) at 10; *NetApp v. Realtime Data*, IPR2017-01196, Paper 10 (Oct. 12, 2017); *NetApp v. Realtime Data*, IPR2017-01354, Paper 16 (Nov. 14, 2017); *EchoStar v. Realtime Data*, IPR2018-00614, Paper 10 (Sept. 5, 2018); *Shenzhen Silver Star Intelligent Tech. v. iRobot*, IPR2018-00761, Paper 15 (Sept. 5, 2018); *United Fire Protection v. Engineered Corrosion Solutions*, IPR2018-00991, Paper 10 (Nov. 15, 2015).

The Board has set forth seven factors for determining whether discretionary denial is appropriate (the “*General Plastic* factors”):

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;

2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic Indus. Co. v. Canon Kabushiki Kaisha, IPR2016-01357, Paper 19 at 16 (Sept. 6, 2017) (precedential).

Indeed, the Board has emphasized that the seven *General Plastic* factors “provide a useful framework for analyzing the facts and circumstances present in this case in which a *different petitioner* filed a petition challenging a patent that had been challenged already by previous petitions.” *NetApp* at 10 (emphasis added). Here, the vast majority of the *General Plastic* factors weigh against institution.

1. Factors 1–3 do not compel institution.

Factors 1 and 2 relate to successive petitions filed by the same petitioner, which even if not precisely at issue here are highly implicated because both Petitioner and Apple Inc. (“Apple”), one of Petitioner’s members, have filed overlapping Petitions with respect to the ’502 Patent. In the instant Petition, petitioner challenges claims 1, 4-7, 11, and 14-17 of the ’502 Patent based on the *Lee* (Ground 1) and *Oppo* (Grounds 2-3) references. Paper 2 at 2. In IPR2023-00720, Apple challenges all claims of the ’502 patent.

When different petitioners challenge the same patent, the Board considers the relationship between those petitioners when weighing the *General Pacific* factors. Factors 1 and 2 weigh against institution, and Factor 3 is neutral. *See NetApp* at 10. Indeed, in the latest Trial Practice Guide, the Office reiterated that a petition may be denied under § 314(a) and *General Plastic* where, as here, the subsequent petition is filed by a different petitioner. Trial Practice Guide Update (November 2019) at 57 n.1 (“Since *General Plastic*, the Board has held that the application of the first *General Plastic* factor is not limited to instances where multiple petitions are filed by the same petitioner. *See Valve Corp. v. Elec. Scripting Prods., Inc.*, Case IPR2019-00062, -00063, -00084 (PTAB Apr. 2, 2019) (Paper 11) (precedential) (denying institution when a party filed follow-on-petitions for *inter partes* review after the denial of an *inter partes* review request of the same

claims filed by the party's co-defendant). When different petitioners challenge the same patent, the Board considers the relationship, if any, between those petitioners when weighing the General Plastic factors. *Id.*").

The relationship between the petitioners here is particularly on point. As admitted by Petitioner in a Supreme Court pleading, Apple is a member of Unified Patents. *See, e.g.,* Brief of Unified Patents, LLC as Amicus Curiae in Support of Petitioner at 2, *Apple Inc. v. Qualcomm Inc.*, No. 21-746 (U.S. Dec. 20, 2021) (identifying Apple as a Unified member). Unified Patents is a for-profit company that facilitates challenges to patent validity on behalf of its members, including Apple. In a recent decision by the Board, Unified Patents was found to be a real party-in-interest with Apple. *See Unified Patents, LLC v. Memoryweb, LLC*, IPR2021-01413, Paper 56 (March 8, 2023) ("*Memoryweb*").

In *Applications in Internet Time, LLC v. RPX Corp.*, the Federal Circuit concluded that RPX acted as a proxy for its members. *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1349 (Fed. Cir. 2018). As part of the analysis, the Federal Circuit highlighted, inter alia, the following facts: (1) "RPX, unlike a traditional trade association, is a for-profit company whose clients pay for its portfolio of 'patent risk solutions'"; (2) one of RPX's strategies "for transforming the patent market is 'the facilitation of challenges to patent validity'"; and (3) the fact that RPX opts not to discuss specific IPRs with clients

may be for the purpose of circumventing the RPI requirement. *Id.* at 1351-52 and n.4. The court emphasized that RPX had advertised that its “interests are 100% aligned with those of [its] clients.” *Id.* at 1340, 43, 57; see also *id.* at 62, 64 (Reyna, J., concurring). The Federal Circuit concluded that these facts collectively “imply that RPX can and does file IPRs to serve its clients’ financial interests, and that a key reason clients pay RPX is to benefit from this practice in the event they are sued by an NPE.” *Id.* at 1352. The same is true for Petitioner in the present action.

Unified Patents’ business model is substantially similar to that of RPX, and Unified Patents is a for-profit company that collects fees from its for-profit members in order to provide this protection. Unified Patent’s individual members subscribe with the anticipation that their own organization will be protected within their defined “Zones.” *See Memoryweb* at 9, 13 (Unified’s strategic operating “structure provides complete alignment between Unified Patents and its member companies” and “suggests that a reason for such an arrangement is to enable Unified to file IPRs that directly benefit its members without having to name those members as RPIs.”) (citations and quotations omitted). Unified Patents’ members therefore have an established relationship with Unified Patents and receive a benefit in exchange for the subscription fees they pay. *See Applications in Internet Time*, 897 F.3d at 1351. Put simply, Unified Patents acts as a proxy for its

members, protecting those members from statutory bars and allowing the possibility of multiple “bites at the apple.” *See id.* at 1351-52.

Factor 2 weighs against institution because, as discussed below with respect to factor 6, a primary reference relied upon in Unified Patents’ Petition (*Oppo*) is also one of the primary references relied upon by Apple. *See* IPR2023-00720, *Apple Inc., v. Togail Technologies Ltd.*, Paper 2 at 19.

Factor 3 relates to whether the petitioner already received the Board’s decision on whether to institute review in the first petition. Since this is not at issue here, Factor 3 is neutral. But as the Board has made clear, Factor 1 is not dispositive, and the Board has often denied institution under § 314(a) and *General Plastic* under these circumstances. *See id.* at 10 and decisions cited above.

2. Factor 4 weighs against institution, as Petitioner delayed filing.

Factor 4 addresses Petitioner’s delay between learning of the art and filing the Petition. *See Valve I* at 13; *Valve II* at 13; *General Plastic* at 16. This factor weighs against institution. Petitioner’s member Apple was served with a complaint on the ’502 patent on April 1, 2022. *See* Ex. 2001 (Complaint), Ex. 2002 (Proof of Service). Petitioner presumably conducted prior art searches shortly thereafter, so there is no reason why they could not have identified the *Lee* and *Oppo* references, a publicly available patent application and a publicly available submission to the 3rd Generation Partnership Project, respectively, or brought the

Petition earlier. In similar circumstances, the Board has found that Factor 4 weighs against institution. *See NetApp v. Realtime*, IPR2017-01354, Paper 16 at 12 (noting that the “record contains no evidence that NetApp could not have located the fourth reference, Chu (a U.S. patent)” earlier); *see also NetApp*, Paper 9 at 12 (Oct. 12, 2017) (“The record also contains no evidence that NetApp could not have located Kitagawa (a U.S. patent) at an earlier date.”).

Yet Petitioner did not file this Petition until February 2, 2023—more than ten months after its member, Apple, was served with the complaint. This substantial delay weighs in favor of denying institution. *See NetApp* at 11–12.

3. Factor 5 also weighs against institution, as Petitioner has no valid excuse for its delay.

Factor 5, which relates to Petitioner’s explanation for any delay, also weighs against institution. *See Valve I* at 15; *Valve II* at 13–14; *General Plastic* at 16. Petitioner has not provided a valid explanation for waiting more than ten months after its member, Apple, was served with the complaint to file the Petition. Indeed, Petitioner had many opportunities to file an IPR since Apple was sued in March of 2022. *See NetApp* at 12 (finding this factor weighed against institution where petitioner “provided no explanation regarding why it waited” to file its petition).

4. Factors 6 weighs against institution.

Factor 6 relates to efficiency and the finite resources of the Board. *See Valve I* at 15; *Valve II* at 15; *General Plastic* at 16. This factor weighs against institution. “In general, having multiple petitions challenging the same patent, especially when not filed at or around the same time as in this case, is inefficient and tends to waste resources.” *Valve I* at 15; *Valve II* at 16. This Petition challenges all of the same claims that been challenged in the IPR filed by Apple. *See* IPR2023-00720. Addressing yet another Petition on the same claims of the same patent would waste the Board’s resources. *See NetApp v. Realtime*, IPR2017-01354, Paper 16 at 13 (Nov. 14, 2017); *Shanghai Lunion Information Tech. v. Ericsson*, IPR2018-00995, Paper 12 at 20 (Nov. 13, 2018) (finding Factor 6 weighs against institution where “the claims overlap substantially with the claims challenged in two of the prior petitions”). The Board’s finite resources are further implicated because both the present petition and the copending Apple petition rely on the *Oppo* reference. Because the same reference is presented in these petitions, Petitioner and Apple truly get two bites at the proverbial apple. For these reasons, Factor 6 weighs against institution.

5. Factor 7 also weighs against institution.

Factor 7 considers the Board’s ability to resolve the proceeding within a year. *See Valve I* at 15; *Valve II* at 15; *General Plastic* at 16. This factor also

weighs against institution. The Board has consistently found that Factor 7 weighs against institution where (1) the filer of a follow-on petition fails to seek coordination or consolidation with a co-pending petition; and (2) coordination or consolidation would be impractical.

For example, in *NetApp v. Realtime Data*, IPR2017-01354, the Board found that petitioner's failure to seek coordination or consolidation with pending IPRs which "are not so advanced that coordination would be impractical" prevented the Board from disposing of the petitions efficiently. Paper 16 at 13. It concluded that conducting "an entirely separate proceeding" would be "a significant waste of the Board's resources." *Id*; see also *NetApp* at 12–13 (finding Factors 6 and 7 weigh against institution because "the Board is unable to join, consolidate, or coordinate this proceeding with the three earlier-filed proceedings" resulting in a "significant waste of the Board's resources"); *NetApp v. Realtime Data*, IPR2017-01196, Paper 10 at 12 (same); *EchoStar v. Realtime Data*, IPR2018-00614, Paper 10 at 17 (finding Factors 6 and 7 weigh against institution "due to Petitioner's delay in filing its Petition and the time limit of 35 U.S.C. § 316(a)(11), the Board is unable to join, consolidate, or coordinate this proceeding with the earlier filed proceedings. The result would be a significant waste of the Board's resources.").

Here, Petitioner filed the instant Petition on February 2, 2023. Petitioner's member, Apple, had already been sued on the '502 Patent more than ten months

earlier. Apple waited until March 16, 2023, close to the one-year statutory bar, to file its petition, including on the same *Oppo* prior art reference. With the staggered petitions, Patent Owner would have to simultaneously defend the same claims of the same patent in two staggered and separate proceedings.

6. Summary of Factors

<i>Factor 1</i>	Weighs against institution
<i>Factor 2</i>	Weighs against institution
<i>Factor 3</i>	Neutral
<i>Factor 4</i>	Weighs against institution
<i>Factor 5</i>	Weighs against institution
<i>Factor 6</i>	Weighs against institution
<i>Factor 7</i>	Weighs against institution

In summary, six of the *General Plastic* factors weigh against institution; and one factor is neutral. Under § 314(a) and the totality of *General Plastic* factors, institution should be denied.

II. THE PETITION FAILS WITH RESPECT TO GROUND 1.

The claims of the '502 Patent require “transmitting a first SI request message to a base station (BS) after determining that the UE is in a connected state.” Ex. 1001, 17:27-29, 18:22-24. For the *Lee* reference, the Petition addresses this limitation at pages 21-29. More specifically, from pages 21-27, the Petition addresses the capability of User Equipment (UE) in *Lee* to send System Information

(SI) requests to a Base Station (BS) while in the CONNECTED Radio Resource Control (RRC) mode or in the IDLE RRC mode. But this portion of the Petition merely addresses that *Lee* discloses UE that can send SI requests in the CONNECTED RRC mode. The Petition does not address the express language of the claims, “transmitting ... ***after determining that the UE is in a connected state,***” until page 27. For the actual limitation, Petitioner presents three ways in which *Lee* purportedly teaches or renders obvious this express recitation of the ’502 Patent claims. Each of these “ways” fails.

The Petition’s first approach to the limitation is to conclude, based on the fact that the UE of *Lee* “had two RRC states which controlled the UE’s operation,” that the “UE like *Lee*’s constantly knew (*determin[ed]*) which state it was in at all times pursuant to the 3GPP radio resource control (RRC) layer specifications.” Petition at 27. In other words, because the “UE first determined that it was in the CONNECTED state when it entered the state,” *id.*, the limitation at issue would be satisfied regardless of any other steps *Lee*’s UE took beyond sending the SI request. This argument is divorced from the express requirement of the claimed limitation that require the active step of “determining” whether the UE is in the CONNECTED state before sending the *first* message, as opposed to UE “determining” whether it is in the IDLE or INACTIVE states before sending a different message. *Compare* Ex. 1001, Cl. 1 (“transmitting a first SI request message to a base station (BS) after

determining that the UE is in a connected state”) *with* Cl. 6 (“transmitting a fourth SI request message to the BS after determining that the UE is not in the connected state, the fourth SI request message including at least one requested SI message”).

Indeed, the Petition never shows that *Lee* discloses the step of “determining that the UE is in a connected state” before transmitting the first SI request message, and instead argues that “the ’502 Patent specification does not disclose a distinct step for a UE ‘determining’ that it is in one state or another.” Petition at 27. The Petition is incorrect — in addition to the claim requiring a distinct “determining” step, the specification of the ’502 Patent clearly describes different messaging approaches for the SI request based on whether the UE is in the CONNECTED state or in the IDLE or INACTIVE states. *See* Ex. 1001, 5:8-21 (“***The on-demand SI request procedure may be implemented differently for the UEs that are in different Radio Resource Control (RRC) states.*** For example, in one implementation, for a UE that is in a connected state, the NW may deliver on-demand SI messages or SIB(s) via dedicated signaling to the UE after receiving an SI request from the UE. In some implementations, for a UE that is in an idle state or an inactive state, the NW may deliver on-demand SI messages or SIB(s) via broadcasting.”) (emphasis added). The ’502 Patent teaches that a distinct determination of the CONNECTED state is required for the sending of the first SI request message. *Lee* does not disclose the required distinct determination.

Second, the Petition asserts that, because different “essential” SI is required depending on the RRC state (CONNECTED or IDLE), and because the SI request from *Lee*’s UE would be “precipitated” by a determination that “essential ... SIB is missing,” Petition at 27-28. As discussed above, *Lee* does not disclose either an active determining step as to whether the UE is in the CONNECTED state before sending the first SI request message, or an active determining step as to whether the UE is in the IDLE or INACTIVE states before sending a different message. Petitioner’s leap to conclude that *Lee* teaches, or at least renders obvious, “that the UE first determined its RRC state before sending any SI request,” *id.* at 28, is therefore unjustified. *Lee* does not make any distinction between the messaging for SI requests dependent upon the UE’s RRC state, even though *Lee* may determine that different essential SI may be required by different RRC states.

Third, the Petition asserts that, because *Lee* will use different signaling mechanisms for SI requests in the CONNECTED and IDLE states, the UE had to first determine “based on its state, how to format and send that message, i.e., the SI request was sent after determining that the UE is in a connected state.” Petition at 28-29. The Petition takes the same unjustified leap as it did with respect to the second assertion. In this instance, Petitioner’s allegation that the UE had to determine the RRC state in order to format the SI request message is premised on the fact that a different physical layer signaling mechanism is used in the different

RRC states, *e.g.*, the Dedicated Control Channel (DCCH) in the CONNECTED state and the Common Control Channel (CCCH) in the IDLE state. However, this premise lacks any support in *Lee* and is purely conclusory.¹ *Lee* does not disclose separately formatted SI request messages for the separate RRC states. In other words, *Lee* does not make any distinction between the messaging for SI requests dependent upon the UE's RRC state, even though *Lee* may use different physical layer signaling mechanisms dependent upon the RRC state.

For the foregoing reasons, the Petitioner has not demonstrated that there is a reasonable likelihood that it would prevail with respect to at least one of the claims challenged based on the *Lee* reference.

III. THE PETITION FAILS WITH RESPECT TO GROUNDS 2 AND 3.

The claims of the '502 Patent require “activating a prohibit timer” and “transmitting a second SI request message to the BS only when the at least one requested SIB is not received and the prohibit timer expires.” Ex. 1001, 17:31-34, 18:26-29. While *Oppo* teaches the use of a prohibit timer to determine when sending

¹ The Petition cites to ¶ 89 of the Declaration of Dr. Haas, Ex. 1003, to support its assertion. But ¶ 89 of the declaration repeats nearly verbatim the paragraph in the Petition beginning at page 28 and continuing to the top of page 29. “Thus, the cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.” *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper No. 9 at 15 (PTAB Aug. 24, 2022) (precedential). The same is true for ¶¶ 87-88 of the Haas Declaration and the Petition's first two arguments with respect to the “transmitting ... after determining that the UE is in a connected state” limitation.

of the second SI request should be allowed, that prohibit timer mechanism works in a fundamentally different fashion. The claims of the '502 Patent require that sending of the second SI request is done “*only when* the at least one requested SIB is not received and the prohibit timer expires.” *Oppo* does teach the required determination of this limitation. Because *Oppo* discloses that the prohibit timer stops upon the UE’s receipt of the SI request acknowledgment from the network, *Oppo* will allow the sending of a second SI request even though it has not determined whether the UE has received the SI of the first request. Ex. 1005, at 2 (Timer stops on “[r]eception of SI request acknowledgement”). In other words, *Oppo* describes that the second request may be transmitted when an SI request acknowledgment has not been received and the timer has expired. Because the second request may be transmitted under circumstances where the UE has not determined that the requested SI has not been received, *Oppo* fails to disclose the claimed requirement that the second request be transmitted “*only when* the at least one requested SIB is not received and the prohibit timer expires.” Ex. 1001, 17:31-34, 18:26-29 (emphasis added).

For the foregoing reasons, the Petitioner has not demonstrated that there is a reasonable likelihood that it would prevail with respect to at least one of the claims challenged based on the *Oppo* reference.

IV. CONCLUSION

The Board should exercise its discretion to deny the Petition under § 314(a) because all but one of the *General Plastic* factors weigh against institution and this is the type of proceeding that the Board’s precedential decisions—*Valve I*, *Valve II*, and *General Plastic*—were developed to prevent. In addition, the Board should deny institution because Petitioner fails to establish a reasonable likelihood of unpatentability for the independent claims under any Ground, let alone present compelling evidence of unpatentability. For Ground 1, the Petition fails to establish that *Lee* teaches “transmitting a first SI request message to a base station (BS) after determining that the UE is in a connected state” as required by all challenged claims of the ’502 Patent. For Grounds 2-3, the Petition fails to establish that *Oppo* teaches “transmitting a second SI request message to the BS only when the at least one requested SIB is not received and the prohibit timer expires” as required by all challenged claims of the ’502 Patent.

V. MANDATORY NOTICES – Related Matters – 37 C.F.R. §42.8(b)(2)

The ’502 Patent is the subject of a second IPR Petition filed by Apple Inc. in IPR 2023-00720.

The ’502 Patent is the subject of a civil action captioned: *Togail Technologies Ltd. v. Apple Inc.*, Case No. 3:23-cv-00610-JO-DEB (S.D. Cal.) which was transferred from Case No. 6:22-cv-00326-ADA (W.D. Tex.).

Respectfully submitted,

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Lead counsel for Patent Owner

Date: June 16, 2023

CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))

The undersigned hereby certifies that the word count in this Patent Owner Preliminary Response is 4,108 words, as counted by the word-processing program Microsoft Word that was used to generate this Patent Owner Preliminary Response, where such word count excludes the table of contents, table of authorities, mandatory notices, certificate of service, appendix of exhibits, claim listing, and this certificate of word count. This Patent Owner Preliminary Response is in compliance with the 14,000-word limit set forth in 37 C.F.R. § 42.24(b)(1).

Date: June 16, 2023

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that the above document was served on June 16, 2023, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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