

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

ZILKR CLOUD TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2023-00663
Patent 9,998,607

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBIT LIST**Currently Filed – Patent Owner**

Ex. No.	Description
2001	Declaration of Robert Akl, D.Sc.
2002	Ex. D-1 Invalidity Chart (de Castro for '607) (Cisco's Invalidity Contentions in <i>Zilkr v Cisco Systems, Inc.</i> , No. 2:22-cv-00166-JRG-RSP (E.D. Tex.))
2003	Ex. D-3 Invalidity Chart (Robb for '607) (Cisco's Invalidity Contentions in <i>Zilkr v Cisco Systems, Inc.</i> , No. 2:22-cv-00166-JRG-RSP (E.D. Tex.))

CLAIM LISTING

Independent Claim 1	
1.0	A method of provisioning a plurality of applications from different application developer systems to a network provider system through a unified services platform, the method comprising:
1.1	establishing a plurality of service accounts for a corresponding plurality of application service provider systems,
1.2	wherein the plurality of application service provider systems provide services for use in association with a telephone number of a subscriber of telecommunication services;
1.3	receiving, by a processor system, a plurality of API interfaces from the plurality of application service provider systems, wherein at least two of the API interfaces are different,
1.4	integrating, by the processor system, each of the plurality of API interfaces with a unified services platform API interface;
1.5	receiving a provider API interface for a network provider system;
1.6	integrating the provider API interface with the unified services platform API interface, wherein at least one of the plurality of API interfaces from the plurality of application service provider systems is not compatible with the provider API interface;
1.7	receiving a definition of a service and a plan for each of the plurality of application service provider systems;

1.8	receiving one or more definitions of actions for the service, wherein the actions comprise responses to triggering events occurring with a telephone number; and
1.9	publishing, after integrating each of the plurality of API interfaces with the unified services platform, the definition of the service, the definition of the plan, and the one or more definitions of actions for each application service provider in a provisioning catalog.

Dependent Claim 2	
2.0	The method of claim 1, further comprising: receiving, from the network provider system, a selection of one or more services from the plurality of the application services provider systems; and
2.1	publishing the selection of the one or more services in a services catalog,
2.2	wherein the services catalog is accessible by one or more subscribers of the network provider system.

Dependent Claim 3	
3.0	The method of claim 1, further comprising: receiving a request for associating at least one service from the plurality of application service provider systems with a telephone number of a subscriber;

3.1	associating the telephone number with the at least one service; and
3.2	invoking the at least one service in response to a communication event with the telephone number.

Dependent Claim 5	
5.0	The method of claim 3, wherein invoking the at least one service in response to the communication event with the telephone number comprises: invoking the at least one service associated with the telephone number in response to a first triggering event, wherein the first service is provided by a first service provided by a first application service provider system of the plurality of application service provider systems.

Dependent Claim 6	
6.0	The method of claim 5, wherein the triggering event comprises a representational state transfer (REST) upon sending a message, a REST upon receiving a message, a REST before making a call, a REST after making a call, a REST before receiving a call, a REST after receiving a call, a Session Initiation Protocols (SIP) on receiving a call, a SIP on making a call, or any combination thereof.

I. INTRODUCTION

Zilkr Cloud Technologies, LLC, the owner of U.S. Patent No. 9,998,607 (“the ’607 Patent”), submits this Preliminary Response to the Petition of Cisco Systems, Inc. (“Cisco” or “Petitioner”) challenging the validity of Claims 1-3, 5, and 6 of the ’607 Patent (“Challenged Claims”). The Board should deny the Petition for discretionary reasons and/or based upon the merits.

The Petition fails on the merits for multiple reasons. As one example, independent claim 1 requires a plurality of application service provider systems that provide “services for use in association with a telephone number of a subscriber of telecommunication services” (claim element (1.2)). To associate the telephone number with a service, the ’607 Patent’s description requires more than merely handling calls from a telephone number. Throughout the specification, “association” of a service with a telephone number is described as an affirmative action taken to establish such an association or link, not mere use of the telephone number in internal messaging.

As a second example, the Petition entirely ignores limitations in claim element [1.3] requiring that a plurality of API interfaces are received by a processor system *from the plurality of application service provider systems*. The Petition instead asserts that the alleged plurality of application service provider systems receive the alleged API interfaces, but it would be inconsistent with the claim to have these

systems receive the API interfaces from themselves. The Petition thus fails in ignoring claim limitations and in mapping de Castro in a manner inconsistent with the claim.

As a third example, de Castro's communication application server 200 merely "exposes the unified communication framework API 400 as a finite set of commands," and it is the application program's job to send a message to the communication application server with commands consistent with the finite set. Merely exposing a finite set of commands that may be used to send messages, as in de Castro, is not receiving a plurality of API interfaces from application service provider systems and integrating them with a unified services platform API interface, as claim 1 requires.

As a fourth example, de Castro does not teach "SIP networks" or a network provider system, and Petitioner is relying only on de Castro's mention of an SIP protocol as alleged "SIP networks" that are mapped to claim 1's "network provider system" in claim element [1.5]. There is no mention in de Castro of an "SIP network," let alone a particular "network provider system" as recited in claim 1.

As a fifth example, Petitioner incorrectly contends that a name alone is sufficient to define a service, but this is not consistent with the description in the '607 Patent or the understanding of a POSITA. And Petitioner's conclusory assertion that "it would have been obvious" to include these items in de Castro's

registry, which serves only to aid in mediating between a server and clients, fails to remedy the deficiency.

For these and additional reasons described below, the Petition fails to show a reasonable likelihood of prevailing on at least one challenged claim.

The *Fintiv* factors also favor denying institution of Cisco's Petition. For example, Petitioner asserted 2012/0016932 A1 ("de Castro") in co-pending litigation, and based on the median time-to-trial statistics, a Texas jury will consider invalidity of the '607 Patent more than four months before the Board is expected to render a final written decision here, if trial were to be instituted. Trial in the district court would precede a potential final written decision by more than eight months under the district court's schedule setting trial. Moreover, the co-pending litigation presents overlapping issues, and the parties and the district court have already expended (and will continue to expend) significant time and resources by the time the Board is expected to issue a decision on institution, including having conducted a claim construction hearing on July 14, 2023. Proceeding here is thus a poor use of the Board's resources—especially given that Petitioner failed to provide an adequate *Sotera* stipulation.

II. RELATED PROCEEDINGS IN THE DISTRICT COURT

The '607 Patent is involved in *Zilkr Cloud Technologies, LLC v. Cisco Systems, Inc.*, 2:22-cv-00166-JRG-RSP (E.D. Tex.) ("Texas Litigation"). The '607

Patent was also involved in *Zilkr Cloud Technologies, LLC v. RingCentral, Inc.*, 3:21-cv-02807-S (N.D. Tex.), which was terminated on April 12, 2022.

III. THE '607 PATENT

The '607 Patent, entitled “Unified Services Platform Using a Telephone Number as a Common Subscriber Identifier,” was filed on April 8, 2016, and issued on June 12, 2018. Ex. 1001 at 1. The '607 Patent claims priority to continuation applications dating back to the filing of the application for Pat. No. 9,210,254, filed November 22, 2013, and to provisional application No. 61/888,856, filed on October 9, 2013. The '607 Patent relates to new techniques for integrating advanced services and applications with legacy telephone service. *Id.*

The '607 patent provides technical solutions that can be used for digital services onboarding in telecommunications systems. The Zilkr technology increases revenue and customer retention for telecommunications providers by allowing their users to integrate multiple third-party services with the user’s phone number all from a unified platform. *See, e.g., id.*, 7:41-44 (“The ability to integrate into the unified platform once and become available everywhere thus greatly increases the value to the service, the network provider, and/or the user.”).

The '607 patent describes and claims a particular way of integrating two separate technological systems—a telephony network, such a PSTN network, and a network of third-party applications connected via the internet. The patent

describes a seamless integration of the two through a unified services platform, which is pictured below. *See id.*, Fig. 7.

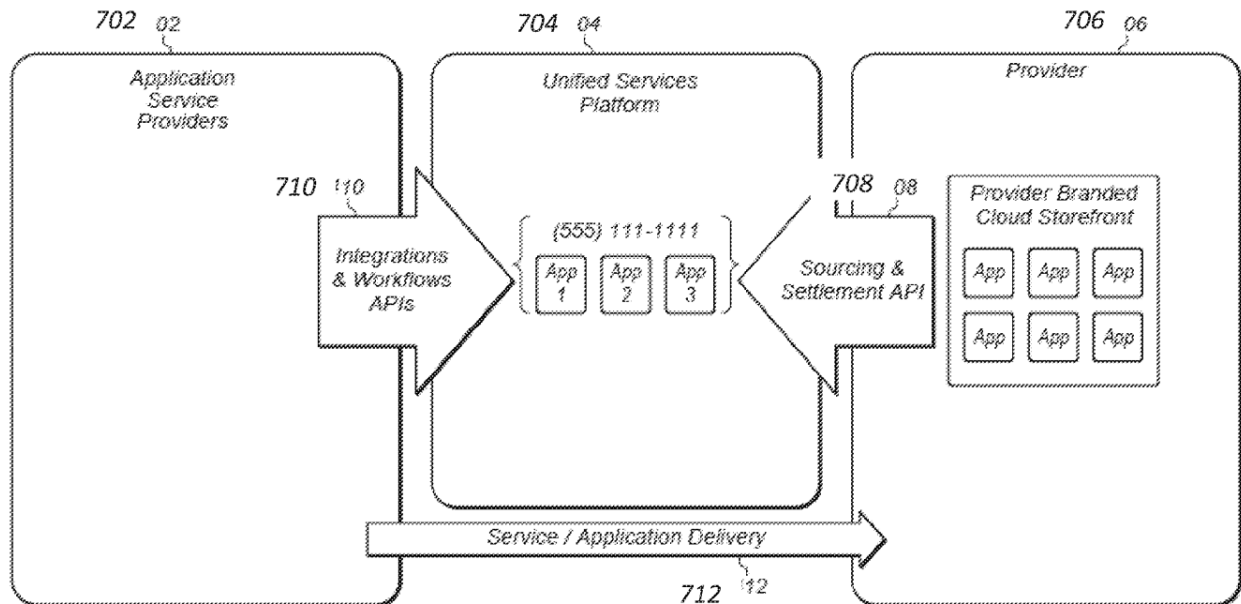
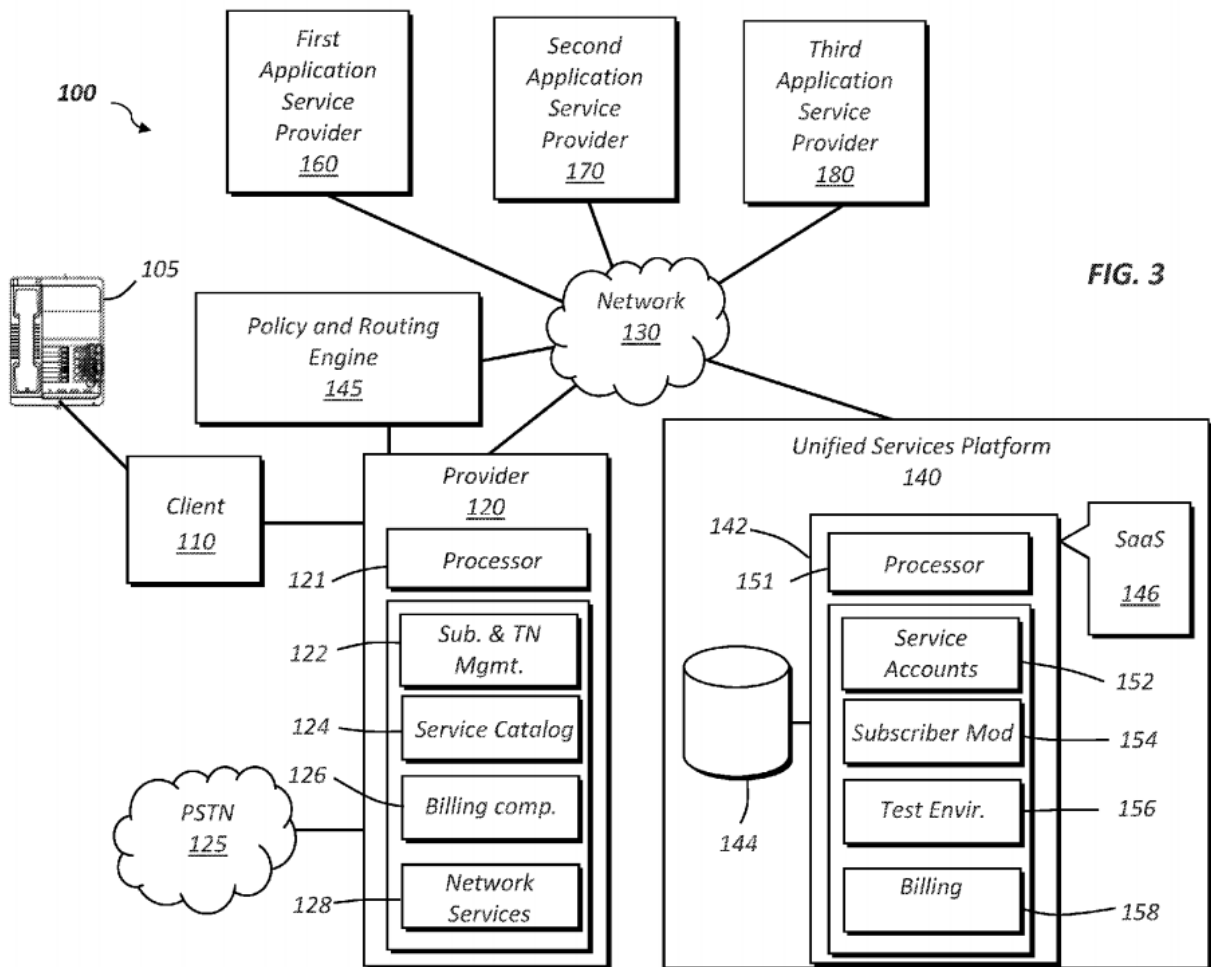


FIG. 7

According to the '607 Patent, “telecommunications service providers still have large numbers of customers with traditional analog telephone service,” whose “telephone number remains the universal identifier (ID) for communicating with the outside world.” *Id.*, 1:24-28. “For the remaining customers, the telephone number remains a valuable identifier for providing telephone services.” *Id.*, 1:28-30. With the availability of new technologies and services, “increasing numbers of customers wish to add services and applications to their existing telephone service,” but “many services and applications are supplied by third-party providers in

different ecosystems,” which oftentimes “use different types of IDs and have different rules and policies for managing and activating their services and applications.” *Id.*, 1:31-38.

Figure 3 (shown below) illustrates an embodiment of a system for providing a unified services platform:



Id., Fig. 3. “The unified services platform provides a common interface for each third party service as well as a common interface for the telecommunication provider.” *Id.*, 8:52-54. “The unified services platform 140 may be configured to

provide a common interface between the application service providers 160, 170, 180, when each may have different APIs.” *Id.*, 13:35-38. “The unified services platform 140 may unify all of the available services and applications in a single platform and associate the services and applications with a single ID to identify the device 110.” *Id.*, 13:38-42.

The ’607 Patent describes that the network provider provides a subscriber with a telephone number and the network provider seeks to provide its subscribers with additional services. *See* Ex. 1001, 3:16-19 (“The telephone number is provided by a network provider system, and a plurality of service provided by a plurality of third party service systems are associated with the telephone number.”), 6:66-67 (“The telephone number is thus one of most valuable assets a network provider has.”); 8:13-16 (“The integration of these applications and services into network providers thus allows the telephone number to elevate from the telephone.”); 8:26-30 (“The plurality of these actions, driven by a multitude of network providers and application developers on either side of a global ecosystem bridges both together, with the telephone number being the common, worldwide identifier anchoring it together.”). The ’607 Patent explains that “[a] global, hosted platform transforms a network provider by enabling a single point of integration between its various systems and the global ecosystem of onboarded services.” *Id.*, 7:33-35. As an example, the ’607 Patent describes that “[a] service joining the platform in Canada

can become available to a South East Asian provider's subscribers." *Id.*, 7:35-37.

The '607 Patent teaches associating the telephone number provided by a network provider system with various third-party services. For example, the '607 Patent describes that "[t]he telephone number is provided by a network provider system, and a plurality of service[s] provided by a plurality of third party services systems are associated with the telephone number." *Id.*, 3:16-19. The Patent goes on to describe that "[o]ne or more of the plurality of services are invoked by at least one triggering event associated with the telephone number." *Id.*, 3:20-22. Similarly, the specification describes "invoking, by the policy and rules engine, a first service associated with the telephone number in response to the first triggering event." *Id.*, 2:4-6. The '607 Patent also describes provisioning a service for use with a group plan that has a plurality of telephone numbers, and "associating the service with each telephone number of the plurality of telephone numbers." *Id.*, 3:55-56.

By associating a service with the telephone number, "the telephone number of a subscriber can be used to link any number of services," and the telephone number is used "as the common subscriber ID across a plurality of services." *Id.*, 9:27-31. "The telephone number 102 may be the central ID which is associated with all of the features 104, services 106, and apps 108 which are provided to the subscriber." *Id.*, 9:31-34. This association or link is further described as follows:

The unified services platform 140 may unify all of the available services and applications in a single platform and ***associate the services***

and applications with a single ID to identify the device 110. Rather than using an identifier such as an email address or a completely separate identifier, ***the unified services platform 140 may associate the various services and applications provided to the device 110 with the telephone number 105.***

Id., 13:38-46 (emphasis added).

The '607 Patent describes creation of workflow events to provide integration with the unified services platform:

“At step 408, the application service provider 160 may create workflow events to provide the integration with the unified services platform 140. The workflow events define the API interfaces to allow the service offered by the application service provider 160 to integrate with the unified services platform 140. Any number of API workflow events can be defined to allow for the full integration of the service with the unified services platform 140.”

Id., 17:16-21.

The '607 Patent describes a method of provisioning a plurality of applications from different application developer systems to a network provider system through a unified services platform as comprising:

establishing a plurality of service accounts for a corresponding plurality of application service provider systems, receiving, by a processor system, a plurality of API interfaces from the plurality of application service provider systems, integrating, by the processor system, each of the plurality of API interfaces with a unified services platform API interface, receiving a provider API interfaces for a network provider system, and integrating the provider API interface with the unified services platform API interface. The plurality of application service provider systems provide services for use in association with a telephone number of a subscriber of telecommunication services. At

least two of the API interfaces are different, and at least one of the plurality of API interfaces from the plurality of application service provider systems is not compatible with the provider API interface.

Id., 1:45-63. The method may further include:

receiving a definition of a service and a plan for each of the plurality of application service provider systems. . . .

receiving one or more definitions of actions for the service, wherein the actions comprise responses to triggering events occurring with a telephone number. . . .

publishing, after integrating each of the plurality of API interfaces with the unified services platform, the definition of the service, the definition of the plan, and the one or more definitions of actions for each application service provider in a provisioning catalog.

Id., 46:2-16.

The '607 Patent also describes how services and plans may be defined:

At step 404, the application service provider 160 may define the plans and services offered through the unified service provider. The services may define the availability and types of activities that the application service provider can provide with their products. The services can be defined through the use of catalog data such as a service name, associated website, description, category, availability, and the like. The service may also be defined using technical information including a configuration description, support information, and event notification information. The information may be provided as a link to URL, a message, or a messaging format for use with the service. The plans comprise information regarding pricing, features, and/or service limits associated with the service offered by the application service provider 160. The definitions and information for the services and plans can be stored in the unified services platform 140.

Id., 15:65-16:10.

“Actions” for services and plans may also be defined. Actions relate to the work performed by the service based on an input or trigger associated with the

device 110. The actions can be defined in terms of the trigger and the resulting activity with the trigger is performed. For example, an action can include posting an incoming message to a social media set for the subscriber or posting the message to a messaging storage log. Actions can include obtaining information such as contact information for a caller, customer information for a calling customer, and other examples. *See id.*, 16:11-27.

The '607 Patent describes triggers as follows:

A trigger can include any type of action performed on the device 110, such as an event associated with the telephone number 105 of the device 110. In an embodiment, a trigger can include a request by a subscriber to use the service. In some embodiments, the triggers can be tied to activities including messaging service activities (e.g., short message service (SMS) text messaging, etc.), call events, call control events, location events, time based events, and the like. The triggers can be associated with Representational State Transfers (REST) actions associated with various services. Applicable messaging service triggers can include, but are not limited to, REST upon sending a message and /or REST upon receiving a message. Similarly, call event triggers can include, but are not limited to, REST before making a call, REST after making a call, REST before receiving a call, and /or REST after receiving a call.

Id., 16:40-55.

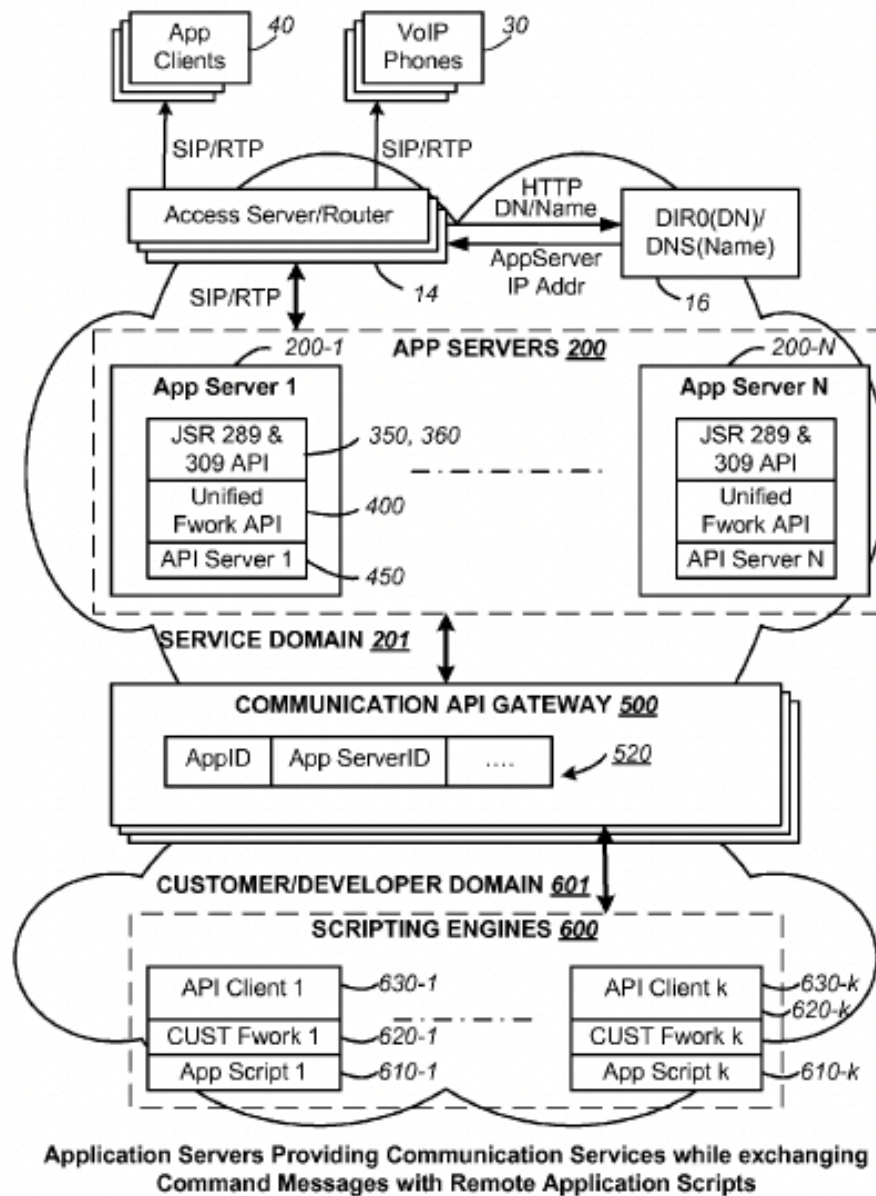
IV. OVERVIEW OF THE RELEVANT ALLEGED PRIOR ART

A. de Castro (Ex. 1005)

de Castro, entitled “System and Method for Telephony and Communication Services with Message-Base API,” was filed on July 20, 2011, and published on January 19, 2012. Ex. 1005 at 1. de Castro is directed to a communication

application server with a unified framework for call control and media control, which “supports a unified API having class objects and functions conforming to a telephony object model.” *Id.*, ¶ 38. In particular, the method and system of de Castro enables an application script to pass commands to the communication application server to operate it, which “allows application scripts to be processed remotely by appropriate scripting engines.” *Id.*

Figure 14 below illustrates de Castro’s network architecture, comprising a service domain 201 and a customer/developer domain 601:

**FIG. 14**

Id., Fig. 14. The service domain includes a plurality of communication application servers 200 (App Server 1 to App Server N), which “provide telephony and communication services to applications and allows application clients 40 such as, for example, VoIP phones to access the applications hosted in the communication application servers.” *Id.*, ¶ 115.

Application clients, such as VoIP phones 30, are “able to access a specific communication application by calling a dialed number or an URL.” *Id.*, ¶ 116. “The call is routed by an access server/router 14 into the IP network 10 to one of the communication application servers 200, such as App server 1,” “by looking up a directory service DIR016 with the IP address/dialed number in order to return the address of the communication application server executing the specific communication application.” *Id.*

“Each communication application server 200 comprises a virtual machine for executing codes with access to the unified communication API of the unified communication framework 400,” which is a “further abstraction of a basic call control API and media control API.” *Id.*, ¶ 117. In the customer/developer domain 601 is a plurality of scripting engines 600 “for the customers to host and process the customers application scripts 610.” *Id.*, ¶ 119. “For example, a customer 1 has the scripting engines 600 host and process[es] an application script such as App Script 1 610-1.” *Id.* An API client 630, such as API client 1 630-1, interprets the App Script and “renders it in terms of the commands of the finite set defined at the API server 450 of the communication application server 200.” *Id.* The API client 630 then packages the commands as messages in accordance with the messaging API protocol to be sent to a connected communication application server 200, such as App server 1 200-1. *Id.* One or more communication API gateway 500 “is

deployed on the network to serve as a messaging broker between the plurality of customers with application scripts in the customer/developer domain 601 and the group of communication application servers 200 in the service domain 201.” *Id.*, ¶ 120.

B. Robb (Ex. 1006)

U.S. Pat. No. 8,126,722 (“Robb,” Ex. 1006) to Robb et al. is entitled “Application Infrastructure Platform.” Ex. 1006, 1. Robb purports to describe an application infrastructure platform (AIP) having an application service provider (ASP) environment including multiple ASP systems providing application services to customers, and a common services environment including hardware and software and management systems providing to the ASP systems applications and integrated application, back-office, and management services used by the ASP systems in delivering their application services to their customers. In another aspect, the AIP is associated with a development and test bed environment which conducts product and service development and testing. *Id.* (abstract).

Robb describes an application infrastructure platform (AIP) that “provides a collection of applications and services to the hosted ASPs 102; the ASPs 102 in turn may repackage and resell to their customers as corporate portals.” Ex.1006, 7:29-32. “The AIP 114 may also aggregate its own applications and services with those of both external ASPs/Internet Service Vendors (ISVs) and its own ASPs into

a ‘Product Catalog.’” *Id.*, 7:53-55. “The aggregate AIP Product Catalog may then be subscribed to by its ASPs 124.” *Id.*, 7:56-57.

V. STANDARDS

A. Institution of an IPR

Under 35 U.S.C. § 314(a), Petitioner carries the burden of showing a reasonable likelihood that it would prevail with respect to at least one of the claims challenged in the Petition. Petitioner must prove unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375-77 (Fed. Cir. 2016).

B. Petitions Based on Obviousness

A petition based on obviousness, which all grounds raised by Petitioner are, must “meaningfully” address the first two *Graham* factors: (i) the scope and content of the prior art, and (ii) any differences between the claimed subject matter and the prior art. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966). It is not the Board’s (or Patent Owner’s) role to “sift through the information” provided with a petition to identify the differences between a challenged claim and the prior art. *Google Inc. & Twitter, Inc., Petitioners, v. Everymd.com LLC, Pat. Owner.*, No. IPR2014-00347, 2014 WL 2175007, at *11 (P.T.A.B. May 22, 2014).

To assert obviousness by combining prior art references, Petitioner must prove that: (1) a motivation to combine the references exists; and (2) a POSITA

would have had a reasonable expectation of success in combining the references. *Apotex Inc. v. Wyeth LLC*, IPR2014-00115, Paper 94 at 11 (P.T.A.B. Apr. 20, 2015) (“A party that petitions the Board for a determination of obviousness must show that ‘a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had reasonable expectation of success in doing so.’”).

The requirement for proving reasonable expectation of success refers to achieving what is claimed in the patent-at-issue. *Intelligent Bio-Sys. V. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016) (“[O]ne must have a motivation to combine accompanied by a reasonable expectation of achieving what is claimed in the patent-at-issue.”). An articulated reason with a rational underpinning to combine specific teachings in the references in a particular manner to arrive at the claimed invention is required for a showing of obviousness. *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007).

Objective indicia of non-obviousness cannot be ignored. *Fox Factory, Inc. v. SRAM, LLC*, IPR2016-01876, Paper 59, at * 9 (P.T.A.B. Apr. 2, 2018) (“Objective evidence of non-obviousness may often be the most probative and cogent evidence in the record and may often establish that an invention appearing to have been obvious in light of the prior art was not.”); *NuVasive, Inc. v. Iancu*, 752 F. App’x 985, 996 (Fed. Cir. 2018) (“On remand, the Board should reevaluate *NuVasive’s*

objective evidence of non-obviousness such as long-felt need . . .”). A necessary safeguard and, like here, a required aspect of a petition based exclusively on obviousness, is a forthright discussion of the objective indicia of non-obviousness. *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1354-55 (Fed. Cir. 2013) (“Failure to give proper consideration to such evidence, as in this case, can be fatal . . .”). Tellingly, Petitioner makes no attempt to address any indicia of non-obviousness.

Moreover, when an expert declaration is relied on to support obviousness, the “[l]ack of factual support for expert opinion going to factual determinations . . . may render the testimony of little probative value in a validity determination.” *Ashland Oil v. Delta Resins & Refractories*, 776 F.2d 281, 294 (Fed. Cir. 1985); *see also Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15 (PTAB Aug. 24, 2022) (precedential) (holding declaration is entitled to little weight when it contains an exact restatement of the petition’s arguments without any additional supporting evidence or reasoning).

C. Claim Construction

In an *inter partes* review filed on or after November 13, 2018, claim terms are construed based on their ordinary and customary meaning. 37 C.F.R. § 42.100(b). Patent Owner submits that the Board need not expressly construe any claim term in a particular manner to arrive at the conclusion that the Petition is substantively deficient.

Although Patent Owner provides arguments below on the scope of certain claim terms, Patent Owner does not propose a comprehensive construction, as it would not be necessary to resolve the controversy and deny the Petition. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’”) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)); *see also* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,353 (Oct. 11, 2018) (Final Rule) (“Moreover, it also may not be necessary to determine the exact outer boundary of claim scope because only those terms that are in controversy need be construed, and only to the extent necessary to resolve the controversy (e.g., whether the claim reads on a prior art reference).” (citing *Nidec*)).

If trial is instituted, however, and to the extent deemed necessary to resolve any dispute, Patent Owner reserves the right to propose more specific constructions of one or more claim terms.

VI. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner defines a POSITA as having “a bachelor’s degree in electrical engineering, computer science, computer engineering, or equivalent, and two years of relevant experience in telecommunications and networking,” but that “[l]ack of

professional experience can be remedied by additional education, and vice versa.”

Pet. 11-12. Because the proposed level of ordinary skill does not affect the ultimate analysis, Patent Owner takes no position at this time with respect to Petitioner’s proposed level of ordinary skill in the art.

VII. PETITIONER’S PROPOSED OBVIOUSNESS CHALLENGES

Ground	’607 Patent Claims	Type	Reference(s)
1	1-3, 5, and 6	§ 103	de Castro and Robb

VIII. PETITIONER HAS FAILED TO SHOW THAT DE CASTRO AND ROBB RENDER OBVIOUS CLAIMS 1-3, 5, AND 6

Petitioner argues de Castro and Robb render obvious the Challenged Claims of the ’607 Patent. For the reasons discussed below, Petitioner has not established a reasonable likelihood of success that de Castro and Robb render obvious any of the Challenged Claims. The petition thus fails.

Patent Owner’s analysis is supported by the Declaration of Dr. Robert Akl. Ex. 2001 (“Akl Dec.”). Dr. Akl is well-qualified to offer the opinions provided in this art. *See* Ex. 2001, Akl. Dec., ¶¶ 3-17.

A. Claim 1

- 1. de Castro does not teach “wherein the plurality of application service provider systems provide services for use in association with a telephone number of a subscriber of telecommunication services” [1.2]**

Petitioner argues de Castro’s “scripting engines” are application service provider systems that “provide services for use in association with a telephone number of a subscriber of telecommunication services.” Pet. 31-32. The Petition asserts that controlling incoming calls and outbound calls are services provided in “association with a telephone number of a subscriber.” Pet. 31 (citing Ex. 1005 ¶¶ 138-142). The Petition points to messages in de Castro that identify the telephone number of a caller, and concludes without explanation that de Castro therefore teaches the scripting engines “provide services for use in association with a telephone number of a subscriber of telecommunication services,” as required by claim element [1.2]. The Petition fails to show that de Castro teaches this claim element.

Providing “services for use in association with a telephone number of a subscriber of telecommunication services” as recited in claim 1 requires more than merely handling calls from a telephone number. Ex. 2001, Akl. Dec., ¶ 52. Dr. Akl opines that, when viewing the claim language in light of the description in the ’607 Patent, a POSITA would understand that there must be an established “association” or link between the service and the telephone number, not merely ad hoc use of a

telephone number in handling calls. *Id.*

The '607 Patent emphasizes the importance of the telephone number and teaches associating the telephone number provided by a network provider system with various third-party services. The patent is titled “Unified Services Platform Using a Telephone Number as a Common Subscriber Identifier.” Ex. 1001 at 1. The '607 Patent explains that the telephone number is “a valuable identifier for providing telephone services.” *Id.*, 1:29-30. The Patent discloses techniques for customers to add services and applications to their existing telephone service by provisioning applications from different application developer systems to the network provider system through a unified services platform. *See, e.g., id.*, 1:31-48. Throughout the specification, “association” of a service with a telephone number is described as an affirmative action taken to establish such an association or link, not mere use of the telephone number in internal messaging. *See* Ex. 2001, Akl. Dec., ¶ 53.

For example, the '607 Patent describes that “[t]he telephone number is provided by a network provider system, and a plurality of service[s] provided by a plurality of third party services systems are associated with the telephone number.” Ex. 1001, 3:16-19. The '607 Patent’s language here indicates affirmatively establishing an ongoing association, not merely use of a caller’s number in messages relating to the call. The Patent goes on to describe that “[o]ne or more of

the plurality of services are invoked by at least one triggering event associated with the telephone number.” *Id.*, 3:20-22. Similarly, the specification describes “invoking, by the policy and rules engine, a first service associated with the telephone number in response to the first triggering event.” Ex. 1001, 2:4-6. Using the policy and rules engine to identify and invoke a first service “associated” with the telephone number indicates a prior “association” that has already been established. *See* Ex. 2001, Akl. Dec., ¶ 54.

The ’607 Patent also describes provisioning a service for use with a group plan that has a plurality of telephone numbers, and “associating” is described as an affirmative step in this process: “associating the service with each telephone number of the plurality of telephone numbers.” Ex. 1001, 3:55-56. This affirmative association step is consistent with the above-mentioned language in the specification indicating an association is established between the telephone number and a service, not merely ad hoc use of telephone numbers in messages related to every call. *See* Ex. 2001, Akl. Dec., ¶ 55.

In the detailed description, the ’607 Patent continues to emphasize the importance of the phone number, and describes that “the telephone number of a subscriber *can be used to link any number of services.*” Ex. 1001, 9:27-28 (emphasis added). “For example, a diagram of an embodiment of utilizing a telephone number as the common subscriber ID across a plurality of services is

shown in FIG. 1.” *Id.*, 9:28-31. “The telephone number 102 may be the central ID ***which is associated with all of the features 104, services 106, and apps 108*** which are provided to the subscriber.” *Id.*, 9:31-34 (emphasis added). Consistent with this description, “providing services for use in association with a telephone number of a subscriber of telecommunication services,” as recited in claim 1, requires an established link between the telephone number and the service, and is not met merely by using a caller’s telephone number as relied on in the Petition. Dr. Akl’s testimony supports this analysis. *See* Ex. 2001, Akl. Dec., ¶ 56.

In another passage demonstrating consistent use of “associate” to require an established link, the ’607 Patent provides:

The unified services platform 140 may unify all of the available services and applications in a single platform and ***associate the services and applications with a single ID*** to identify the device 110. Rather than using an identifier such as an email address or a completely separate identifier, ***the unified services platform 140 may associate the various services and applications provided to the device 110 with the telephone number 105.***

Ex. 1001, 13:38-46 (emphasis added); Ex. 2001, Akl. Dec., ¶ 57.

As noted above, the portions of de Castro alleged in the Petition to teach claim element [1.2] at most indicate that a developer may use phone numbers in messages relating to incoming or outgoing calls. *See* Ex. 2001, Akl. Dec., ¶ 58. There is no description of a particular association or established link between the developer and a subscriber of telecommunication services. *Id.* In the opinion of Dr.

Akl, any caller could have their telephone number show up in the internal messages relating to the call, demonstrating there is no association between the telephone number of the subscriber and the service provided. *Id.* This understanding is further bolstered by de Castro’s statement that its application server can “provide telephony and communication services to a plurality of *customers*,” Ex. 1005 ¶ 39 (cited at Pet. 31), which, as the Petition elsewhere acknowledges, means a developer and not an end user, *see* Pet. 15-16. Ex. 2001, Akl. Dec., ¶ 58. A developer “customer” hosting a service that can be called by anyone, and incidentally using the calling number in messages used to control the call, fails to establish any association between the telephone number of a subscriber of telecommunication services and the developer customer’s service, as properly understood in the context of the ’607 Patent. Ex. 2001, Akl. Dec., ¶ 58.

For at least these reasons, Petitioner has not shown that de Castro teaches the limitations of claim element [1.2].

2. de Castro does not teach “receiving, by a processor system, a plurality of API interfaces from the plurality of application service provider systems, wherein at least two of the API interfaces are different” [1.3]

Claim 1 of the ’607 Patent recites “*receiving, by a processor system, a plurality of API interfaces from the plurality of application service provider systems.*” Claim limitation [1.3] (emphasis added). Under the plain language of the claim, the processor system that receives a plurality of API interfaces is separate

from the application service provider systems, as the API interfaces are received *from* the application service provider systems. Ex. 2001, Akl. Dec., ¶ 61. The Petition entirely ignores the claim language requiring receipt “from the plurality of application service provider systems,” as required by claim element [1.3].

Petitioner argues that de Castro’s custom frameworks are API interfaces, and that a POSITA would have understood that these frameworks were “received” by the scripting engines because they are illustrated as being located within and hosted by the scripting engines. Pet. 33, 35. There is no discussion of *from* where the custom frameworks were received, which would be necessary under the claim language. Ex. 2001, Akl. Dec., ¶ 62. It would not be possible for the custom frameworks to have been received *from* the plurality of application service provider systems, as required by the claim, because the Petition alleges that de Castro’s scripting engines are the plurality of application service provider systems, and the scripting engines are alleged to have *received* the custom frameworks. See Pet. 29 (arguing in connection with claim element [1.1] that “de Castro teaches a plurality of ‘**scripting engines**’ (‘*plurality of application service provider systems*’) . . .”); Pet. 33 (“de Castro teaches that each scripting engine (‘*application service provider system*’) includes . . .”); see Ex. 2001, Akl. Dec., ¶ 62. Thus, perhaps to avoid showing its improper reliance on de Castro’s scripting engines (alleged application provider systems) as receiving the custom frameworks (alleged API interfaces)

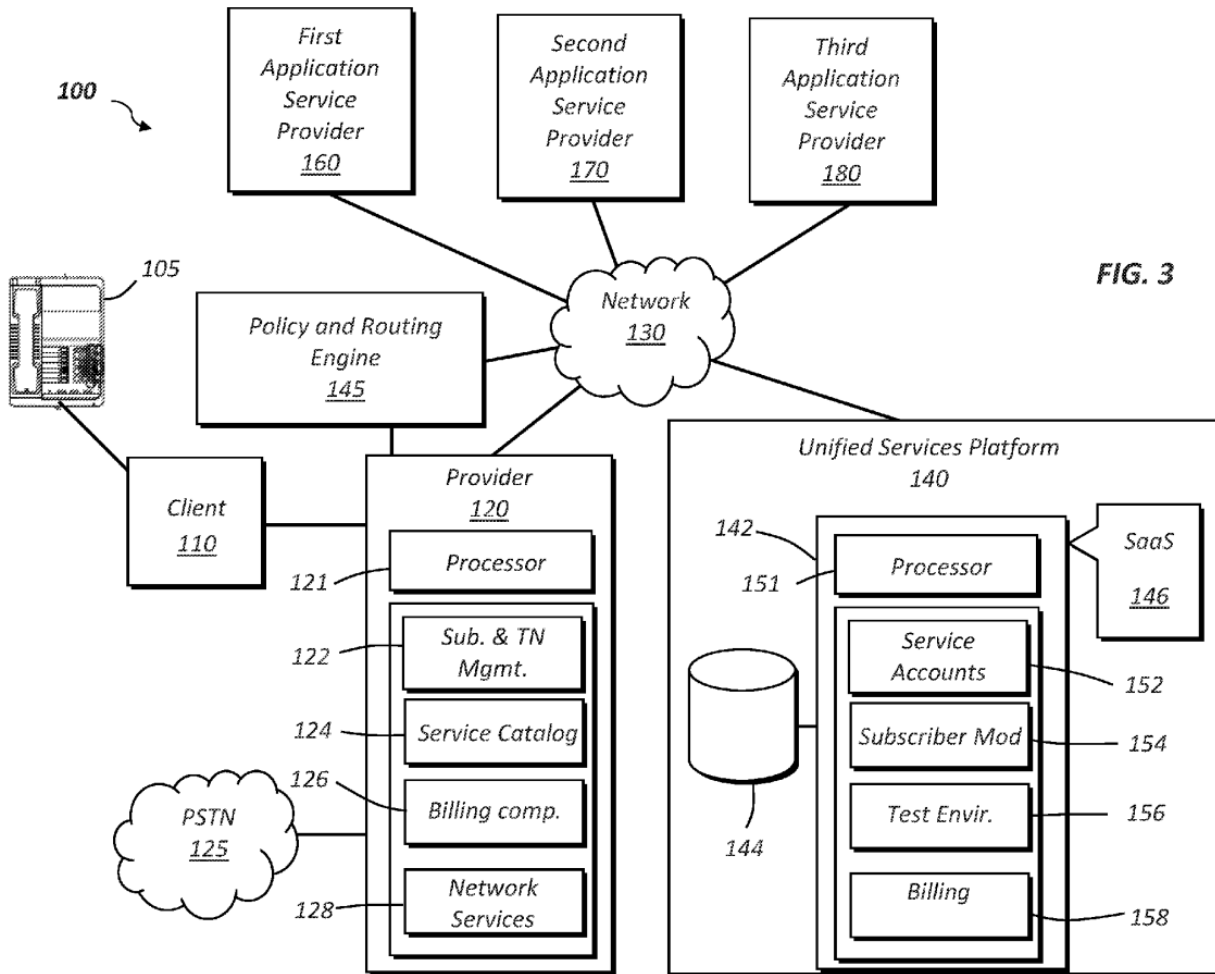
from de Castro’s scripting engines, the Petition simply ignores these limitations. Institution should be denied on this basis. In addition, Petitioner’s mapping would not make sense and is not possible, since de Castro’s scripting engines would have to send the alleged API interfaces to themselves. Ex. 2001, Akl. Dec., ¶ 62.

For at least these reasons, Petitioner has not shown that de Castro teaches the limitations of claim element [1.3].

3. de Castro does not teach “integrating, by the processor system, each of the plurality of API interfaces with a unified services platform API interface” [1.4]

The Petition’s failure with respect to claim limitations [1.3] are further illustrated, and the error compounded, by the Petition’s failure on limitations [1.4]. Claim element [1.4] requires integrating, by the same processor system referred to in claim element [1.3], each of the plurality of API interfaces with a unified services platform API interface. Ex. 2001, Akl. Dec., ¶ 65.

In the ’607 Patent, there is a Unified Services Platform 140, which has a processor 151, as illustrated in Figure 3:



Ex. 1001, Fig. 3. “The unified services platform provides a common interface for each third party service as well as a common interface for the telecommunication provider.” *Id.*, 8:52-54. “The unified services platform 140 may be configured to provide a common interface between the application service providers 160, 170, 180, when each may have different APIs.” *Id.*, 13:35-38. “The unified services platform 140 may unify all of the available services and applications in a single platform and associate the services and applications with a single ID to identify the device 110.” *Id.*, 13:38-42. The ’607 Patent describes creation of workflow events

to provide integration with the unified services platform:

“At step 408, the application service provider 160 may create workflow events to provide the integration with the unified services platform 140. The workflow events define the API interfaces to allow the service offered by the application service provider 160 to integrate with the unified services platform 140. Any number of API workflow events can be defined to allow for the full integration of the service with the unified services platform 140.”

Id., 17:16-21.

In this way, the '607 Patent shows an example of how the unified services platform receives a plurality of API interfaces from the plurality of application service provider systems (claim element [1.3]), and the same processor system then integrates “each of the plurality of API interfaces with a unified services platform API interface” (claim element [1.4]). Ex. 2001, Akl. Dec., ¶¶ 66-67.

Petitioner argues de Castro teaches a unified framework that provides a unified API that gives access to a set of unified class objects for call control and media control. Pet. 37. As Petitioner acknowledges, *see id.*, de Castro’s communication application server 200 “exposes the unified communication framework API 400 as a finite set of commands.” Ex. 1005, ¶ 38; Ex. 2001, Akl. Dec., ¶ 68. In de Castro, “[t]he class objects are invoked and manipulated by a finite set of commands and an application program essentially issues a series of such commands to operate the communication application server.” Ex. 1005, ¶ 38. Thus, the Petition fails to show that de Castro’s communication application server

receives a plurality of API interfaces from the plurality of application service provider systems and then *integrates each of the plurality of API interfaces with a unified services platform API interface*. Ex. 2001, Akl. Dec., ¶ 68. Instead, de Castro’s application program merely sends a message to the communication application server with commands consistent with the finite set of commands. *See* Ex. 1005, ¶ 38 (“The API server at the communication application server parses out the commands from the messages to have the communication application server executes the commands as they are available for execution.”); Ex. 2001, Akl. Dec., ¶ 68. Thus, the Petition fails to show a processor system *receiving a plurality of API interfaces from the plurality of application service provider systems* (which the Petition maps to de Castro’s scripting engines), and that *the same processor system then integrates each of the plurality of API interfaces with a unified services platform API interface*. *See* Ex. 2001, Akl. Dec., ¶ 68. In addition, merely “expos[ing]” a finite set of commands that may be used to send messages, as in de Castro, is not receiving a plurality of API interfaces from application service provider systems and integrating them with a unified services platform API interface, as claim 1 requires. *Id.*

For at least these reasons, Petitioner has not shown that de Castro teaches the limitations of claim element [1.4].

4. de Castro does not teach “receiving a provider API interface for a network provider system” [1.5]

Petitioner argues that in de Castro, “clients access the call-related application services ‘**via SIP**’ networks (*‘network provider system’*) connected to the application communication servers.” Pet. 40. But de Castro does not teach SIP “networks” or a network provider system. Ex. 2001, Akl. Dec., ¶ 72. The cited portion of de Castro states that “[i]nbound calls originate . . . via SIP and are offered to Rayo clients via XMPP using a Jabber identifier (JID).” Ex. 1005, ¶ 139. There is no mention of an SIP “network,” let alone a particular “network provider system” as recited in claim 1. Ex. 2001, Akl. Dec., ¶ 72.

In the ’607 Patent, the network provider is a specific entity. *Id.*, ¶ 73. The network provider provides a subscriber with the telephone number and the network provider seeks to provide its subscribers with additional services. *See* Ex. 1001, 3:16-19 (“The telephone number is provided by a network provider system, and a plurality of service provided by a plurality of third party service systems are associated with the telephone number.”), 6:66-67 (“The telephone number is thus one of most valuable assets a network provider has.”); 8:13-16 (“The integration of these applications and services into network providers thus allows the telephone number to elevate from the telephone.”); 8:26-30 (“The plurality of these actions, driven by a multitude of network providers and application developers on either side of a global ecosystem bridges both together, with the telephone number being

the common, worldwide identifier anchoring it together.”). The ’607 Patent explains that “[a] global, hosted platform transforms a network provider by enabling a single point of integration between its various systems and the global ecosystem of onboarded services.” Ex. 1001, 7:33-35. As an example, the ’607 Patent describes that “[a] service joining the platform in Canada can become available to a South East Asian provider’s subscribers.” *Id.*, 7:35-37. The Petition fails to identify in de Castro a network provider or its system, and instead merely identifies a protocol through which inbound calls may be received. Ex. 2001, Akl. Dec., ¶ 74. The Petition thus also fails to identify “a provider API interface” for the recited network provider system. *Id.*

For at least these reasons, Petitioner has not shown that de Castro teaches the limitations of claim element [1.5].

5. de Castro does not teach “integrating the provider API interface with the unified services platform API interface, wherein at least one of the plurality of API interfaces from the plurality of application service provider systems is not compatible with the provider API interface” [1.6]

Petitioner argues that de Castro teaches JSR 289 (SIP API 350) interfaces with unified framework API 400, and that a POSITA would have understood this to be the claimed “integrating the provider API interface with the unified services platform API interface,” as recited in claim element [1.6]. Pet. 42-43.

As noted above for claim element [1.5], the Petition fails to identify a

network provider or its system in claim element [1.5]. For at least this same reason, the Petition also cannot show de Castro teaches the related integrating in claim element [1.6], which requires integrating with the provider API interface recited in claim element [1.5]. Ex. 2001, Akl. Dec., ¶ 78.

Thus, for at least the same reasons that the Petition fails to identify a network provider or its system in claim element [1.5], the Petition also necessarily fails to show de Castro teaches the related integrating in claim element [1.6].

6. de Castro does not teach “receiving a definition of a service and a plan for each of the plurality of application service provider systems” [1.7]

Petitioner argues that “the ’607 patent describes a service name, description, and availability as examples of ‘*a definition of a service.*’” Pet. 12 (citing Ex. 1001, 15:65-16:1; Ex. 1003, ¶ 44). Petitioner misinterprets the cited portion of the ’607 patent. Ex. 2001, Akl. Dec., ¶ 81. The relevant portion of the ’607 patent provides:

The services can be defined through the use of catalog data such as a service name, associated website, description, category, availability, and the like. The service may also be defined using technical information including a configuration description, support information, and event notification information.

Ex. 1001, 15:65-16:3. The description in the ’607 Patent does not state that a name alone is sufficient to define the service, as incorrectly argued by Petitioner. *See* Ex. 2001, Akl. Dec., ¶ 81. Rather, those are examples of catalog data that *may be used* in defining the services. *Id.* A person of ordinary skill in the art would understand

that it requires more than a name to define the services. *Id.*

For claim element [1.7], Petitioner argues that de Castro’s registry 520 registers customers’ (developers’) applications and logs the properties and status with each API clients 630. Pet. 45-46. Petitioner argues that “a POSITA would have found it obvious for one of the ‘properties’ to be a short description or name of the application (each an example ‘*definition of a service*’).” Pet. 46. For support, the Petition cites only to conclusory statements of its declarant, which are entitled to little or no weight. The Petition and declarant state that “[s]toring a service’s name, description, or both, would facilitate an administrator in determining to which service the other, related properties pertain.” Pet. 46. But Petitioner does not show that de Castro contemplates an administrator or anyone viewing the registry. Ex. 2001, Akl. Dec., ¶ 82. Rather, the purpose of the registry is for reference by XMPP server 540, which conducts federation or mediates between the plurality of communication application servers 200 and the plurality of API clients 630. Ex. 1005, ¶ 130; Ex. 2001, Akl. Dec., ¶ 82. Thus, Petitioner’s argument is misplaced.

For at least the reason that de Castro’s registry is used only as a reference by XMPP server 540, and not intended to be viewed by an administrator as alleged in the Petition, Dr. Akl disagrees with Petitioner and its declarant’s conclusory assertion that “a POSITA would have found it obvious” for one of the properties to be a short description or name of the application. Ex. 2001, Akl. Dec., ¶ 82. There

is no indication in de Castro that a name in the registry would have aided XMPP server 540 in conducting federation between the plurality of communication application servers 200 and the plurality of API clients 630, and a description would be useless in aiding the XMPP server in that function. *Id.* Thus, the Petition’s conclusory statement that “it would have been obvious” to include these items in the registry fails to prove that is so. And even if a name were present in the registry, a name is not sufficient to define a service, as established above. *See* Ex. 2001, Akl Dec., ¶ 81.

The Petition’s contention that de Castro’s registry includes information sufficient to define the service as required by claim 1 depends on Petitioner’s incorrect interpretation of the ’607 Patent as providing that a name alone can define the service, and the conclusory assertion that “it would have been obvious” to include a name and description in the registry whose purpose is to aid a server in mediating between servers and clients. The Petition fails to show that any data included in de Castro’s registry would define the service as to satisfy claim element [1.7]’s step of receiving a definition of a service. Ex. 2001, Akl. Dec., ¶ 83.

For at least these reasons, Petitioner has not shown that de Castro teaches the limitations of claim element [1.7].

B. Petitioner Has Not Shown That de Castro Renders Obvious Dependent Claims 2, 3, 5, and 6

For at least the reasons discussed in Section VIII.A (incorporated by

reference herein), Petitioner has not shown that de Castro teaches or renders obvious claims 2, 3, 5, and 6, which depend from claim 1.

IX. THE BOARD SHOULD DENY INSTITUTION OF THIS PETITION UNDER 35 U.S.C. § 314(a)

Under § 314(a), the Director has discretion to deny institution. *NHK Spring Co. v. Intri-Plex Technologies, Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential). *Fintiv* sets forth six non-exclusive factors for determining “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential). These factors include:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and

6. other circumstances that impact the Board's exercise of discretion, including the merits grounds raised in the Petition.

Id.

According to the Memorandum from Director Vidal dated June 21, 2022, “compelling, meritorious challenges will be allowed to proceed at the PTAB even where district court litigation is proceeding in parallel. Compelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” Ex. 1021 at 4. Moreover, “[w]hen a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition, it mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB.” *Id.* at 7 (citation omitted).

Here, the *Fintiv* factors favor denial of institution of this Petition, and Petitioner has not presented compelling evidence of unpatentability. Nor has Petitioner provided a sufficient stipulation that it will not pursue in the Texas litigation “any grounds that could have reasonably been raised in the petition.” *Id.* (emphasis added).

As such, the Board should deny institution of this Petition under § 314(a).

A. Factor 1 is Neutral as No Court Has Granted a Stay and No Evidence Exists That a Stay May Be Granted

Regarding Factor 1, the parallel district court proceeding has not been stayed and no evidence exists that a stay may be granted if trial is instituted. The parallel district court proceeding includes three other U.S. patents besides the '607 Patent. Petitioner has never moved for a stay. The issues raised in the Petition are already presented, and are already being litigated, in the United States District Court for the Eastern District of Texas in *Zilkr Cloud Technologies, LLC v. Cisco Systems, Inc.*, 2:22-cv-00166-JRG-RSP (“Texas litigation”). Factor 1 is thus neutral at best. *See, e.g., Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, No. IPR2020-00123, 2020 WL 2511247, at *3 (P.T.A.B. May 15, 2020) (finding factor 1 to be neutral where “there is little evidence to suggest that the district court will grant a stay, should another one be requested”).

B. Factors 2 and 5 Weigh in Favor of Denying Institution

As to factors 2 and 5, Petitioner is the defendant in the Texas litigation (Pet. at 73), the *Markman* hearing is set to take place on July 14, 2023,¹ and jury selection is scheduled to begin January 22, 2024 (Ex. 1028). The final written decision in this case would be expected around October 12, 2024, if trial were instituted. Thus, the

¹ The district court reset the claim construction hearing from July 13, 2023, to July 14, 2023, on May 16, 2023.

district court's trial is scheduled to precede the Board's potential final written decision on the same asserted art by more than eight months.

This timing is similar to that in *NHK* where the Board noted a six-month difference between a scheduled trial date and the deadline for the Board's written decision. *NHK*, IPR2018-00752, Paper 8 at 20; *see also GlobalFoundries Inc. v. UNM Rainforest Innovations*, IPR2020-00984, Paper 11, at *11-16 (PTAB Dec. 9, 2020) (finding that a scheduled trial date four months before the statutory deadline for a final written decision was a factor weighing in favor of discretionary denial); *NanoCollect Biomedical, Inc. v. Cytonome/ST, LLC*, IPR2020-00551, Paper 19, at *16 (PTAB Aug. 27, 2020) (same); *Intel Corp. v. LLC*, No. IPR2020-00583, 2021 WL 531706, at *2 (P.T.A.B. Feb. 11, 2021) ("Thus, at this time, it appears likely that trial will occur many months before any final written decision would likely issue in this proceeding. Therefore, we maintain our finding that *Fintiv* Factor 2 (proximity of the court's trial date to the Board's projected statutory deadline for a final written decision) weighs in favor of exercising our discretion to deny institution pursuant to 35 U.S.C. § 314(a).").

Just like in *NHK*, instituting trial under the facts and circumstances here would be an inefficient use of Board resources. *See NHK*, IPR2018-00752, Paper 8 at 20 (finding under similar circumstances that institution "would not be consistent with 'an objective of the AIA . . . to provide an effective and efficient alternative to

district court litigation”).

Petitioner’s contention that Factor 2 “weighs slightly against discretionary denial, or at the very least is neutral” based on the median time-to-trial statistics for the Eastern District of Texas lacks merit. Pet. at 77-78. The Memorandum from Director Vidal dated June 21, 2022, instructs only that “the proximity to trial should not alone outweigh” other factors. Ex. 1021 at 8. As shown herein, other factors besides Factor 2 weigh in favor of denial, such as Factors 3, 4, 5, and 6, and no factors favor declining to exercise the Board’s discretion to deny institution. Moreover, based on the median time-to-trial in the Eastern District of Texas (24.5 months), trial would take place around June 4, 2024 (May 20, 2022 + 24.5 months). Trial would thus still occur more than four months prior to the expected October 12, 2024, final written decision (if trial were to be instituted).

Factors 2 and 5 thus weigh in favor of denying institution.

C. Factor 3 Weighs in Favor of Denying Institution, as the Parties and the District Court in the Eastern District of Texas Litigation Have Already Invested Significant Time and Resources

By the time the Board’s institution decision is likely to issue in October 2023, the Parties and the district court will have already expended considerable time and resources. For example, the district court will have already conducted the July 14, 2023, claim construction hearing, and fact discovery will have been completed on September 5, 2023. Ex. 1018 at 3; *see also Google LLC v. Personalized Media*

Commc'ns, LLC, No. IPR2020-00720, 2020 WL 6530766, at *2 (P.T.A.B. Nov. 5, 2020) (recognizing that “*Fintiv* holds that a district court's investment in issuing a claim construction order weighs toward, not against, exercising discretion to deny institution”). Expert discovery is expected to be completed on October 10, 2023, around the same time as the expected institution decision, and the deadline to file dispositive motions follows shortly thereafter on October 16, 2023. Ex. 1018 at 3.

Based on the significant time and resources the parties have already expended and will likely have expended by the time of the expected decision on institution, Factor 3 weighs in favor of denying institution.

D. Factor 4 Weighs in Favor of Denying Institution Given the Overlap in Arguments Presented in the Petition and in the Texas Litigation and Because Petitioner has not Adequately Mitigated Concerns of Potentially Conflicting Decisions and Duplication of Efforts

As to factor 4, Petitioner presents overlapping arguments in the Texas litigation and in the Petition. Petitioner's invalidity contentions in the Texas litigation contain similar proposed grounds for invalidity as are presented in the Petition for the Challenged Claims. *Compare* Pet. at 13 (asserting claims 1-3 and 5-6 are unpatentable as obvious over de Castro in view of Robb) with Ex. 2002 (asserting claims 1-3 and 5-6 are unpatentable as anticipated and/or obvious based on de Castro “alone and/or in combination with other references”); *see also* Ex. 2003 (asserting claims 1-3 and 5-6 are unpatentable as anticipated and/or obvious over Robb).

Despite this overlap, Petitioner claims “[t]here will be no overlap of prior art issues” and purports to stipulate that “if the Board institutes trial, Petitioner will cease asserting in the co-pending litigation the combination of references on which trial is instituted for the claims, to the extent Petitioner even asserts the same combination in the district court.” Pet. at 70. Petitioner’s “stipulation” is insufficient to alleviate any concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB because Petitioner fails to stipulate that it will not pursue “any grounds that could have reasonably been raised in the petition.”² Ex. 1021 at 7 (emphasis added); *see also Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020- 01019, Paper 12 at 19 (stating that a “Sotera” stipulation “ensures that an *inter partes* review is a ‘true alternative’ to the district court proceeding”); *Roku, Inc. v. IOENGINE, LLC*, IPR2022-01551 (P.T.A.B. May 5, 2023), Paper 10 at 17-18 (exercising discretion to deny institution based on, *inter alia*, “the late state of the parallel district court proceeding” and petitioner’s failure to submit a *Sotera*-type stipulation “that would make discretionary denial inappropriate”).

Factor 4 thus weighs in favor of denying institution.

² Even if it did, Factors 2, 3, 5, and 6 would still favor denial.

E. Factor 6 Weighs Against Institution as Petitioner Has Not Shown a Reasonable Likelihood That It Would Prevail on Ground 1 and/or Ground 2

Factor 6 considers other circumstances that impact the Board's exercise of discretion. According to Petitioner, Factor 6 weighs against denial "[i]n view of the striking similarities between the '607 patent claims and both de Castro and Robb." Pet. at 71. But, as shown above, Petitioner has failed to show a reasonable likelihood that it would prevail on its challenge.

Thus, to the extent Factor 6 takes into account the merits of Petitioner's claims, Factor 6 weighs in favor of denial.

X. CONCLUSION

For the reasons stated above, Patent Owner respectfully asks the Board to deny institution of IPR2023-00663.

Dated: July 12, 2023

Respectfully submitted,

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CERTIFICATE OF WORD COUNT UNDER 37 C.F.R. § 42.24(b)(1)

I, the undersigned, do hereby certify that the foregoing Patent Owner Preliminary Response, including footnotes, contains no more than 14,000 words, as measured by the Word Count function of Microsoft Word as specified by 37 C.F.R. § 42.24(b)(1).

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CERTIFICATE OF SERVICE

I hereby certify that on this 12th day of July, 2023, a true and correct copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE, and any accompanying exhibits, was served by electronic mail upon the following counsel of record for Petitioners:

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