

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

COBBLESTONE WIRELESS, LLC,
Patent Owner.

IPR2024-00318
Patent 8,554,196

PATENT OWNER'S PRELIMINARY RESPONSE

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Ex. 2003	Federal Court Management Statistics for the Eastern District of Texas through December 2023, <i>available at</i> https://www.uscourts.gov/statistics-reports/federal-court-management-statistics-december-2023
Ex. 2004	<i>Cobblestone Wireless, LLC v. AT&T Servs. Inc. et al.</i> , No. 2:22-cv-00474, Dkt. No. 1 (Complaint for Patent Infringement) (E.D. Tex. Dec. 15, 2022)
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Ex. 2016	<i>Samsung Elecs. Am., Inc. et al. v. Cobblestone Wireless, LLC</i> , IPR2024-00317, Paper 3 (IPR Petition) (PTAB Dec. 18, 2023)
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I. INTRODUCTION

The Board should deny institution of *inter partes* review (“IPR”) of U.S. Patent No. 8,554,196 (“the ’196 patent”) for three independent reasons.

First, the Petition should be denied on the merits. For Grounds 1 and 2, based on the Chitrapu reference, the Petition fails to identify a “first network” and “second network” as claimed, instead pointing to two beams of the same network, thus failing to satisfy a key limitation of the ’196 patent. For Ground 3, the Petition’s two theories each requires specific and unexpected arrangements of the Dinan and Wong references, in which the key component of Dinan’s algorithm under the Petition’s reading--that interval use devices should be assigned to 3G networks, not 4G networks--is sometimes applied but is sometimes skipped or reversed to assign interval use devices to 4G networks, not 3G networks. Because the Petition fails to show any motivation for a POSITA to choose the specific arrangement of choices when to follow Dinan and when to ignore Dinan--except by using the ’196 patent claims themselves as a roadmap, using impermissible hindsight--each of the Petition’s Ground 3 theories is legally flawed, as the Federal Circuit recently reaffirmed.

The Petition therefore fails to demonstrate a reasonable likelihood of prevailing for any of the challenged claims.

Second, the Board should exercise its discretion and deny institution because this Petition is an improper and unjustified parallel petition. Specifically, Petitioners' co-real party-in-interests ("RPIs") filed a parallel petition approximately a month before the instant Petition. Yet Petitioners have not provided any "ranking" as compared with that petition. Petitioners likewise offer no persuasive explanation as to why the invalidity grounds of the instant Petition could not have been included in the RPI petition or in Petitioners' "copycat" of the RPI petition, both of which used just over half of the type-volume limitation permitted. Instituting this Petition is contrary to the Board's guidance and is a strain on both party and Board resources.

Third, the Board should exercise its discretion to deny the Petition in light of the parallel district court litigation involving the same patent, the same parties, and the same prior art combinations. The Petition also fails to offer any stipulation to mitigate concerns of overlap here. In addition, because Petitioners waited until *one day* before the statutory deadline to file the Petition, there will be much investment in the district court case involving Petitioners at the time the Board renders its institution decision. And the district court trial is also set to take place months before the deadline for any final written decision in this proceeding. All six *Fintiv* factors favor a discretionary denial.

For each these independent reasons, institution should be denied.

II. BACKGROUND

A. Overview of the '196 patent

The '196 patent is generally directed to methods and systems for providing efficient wireless communication coverage to a group of devices, some of which require relatively high continuous bandwidth and some of which require only intermittent updating. Ex. 1001 at 3:35-4:22. To address this need, the patent teaches to cycle between two different coverage configurations involving two separate networks. In some embodiments, a first network cycles between (1) providing low-power coverage to the entire group of devices using a wide beam and (2) providing high-power coverage to the continuous use devices using a narrow beam. During the second configuration when the first network is using a narrow beam, a second network provides coverage to the interval-use devices, for example to address the possibility that an interval use device might become a continuous use device, for example by “receiving or making a call or initiating a download or the like.” *Id.* at 4:5-9. This aspect of the invention is reflected in each of the challenged claims. Claim 1 recites in relevant part:

1[pre] A method for providing network coverage for a group of devices
in an area comprising:

1[a] cycling over time through a coverage sequence that includes providing a first coverage configuration and providing a second coverage configuration, wherein:

1[b] providing the first coverage configuration includes transmitting a first beam of a first network that is configured to provide coverage for the group of devices; and

1[c] providing the second coverage configuration includes transmitting a second beam of the first network that is narrower than the first beam and configured to provide coverage to at least one continuous use device of the group of devices, the at least one continuous use device being actively involved in a substantially continuous service with the network, and

1[d] providing coverage by *a second network* to a plurality of interval use devices of the group of devices.

Id. at claim 1 (numbering added).¹ Challenged independent claim 17 recites substantially the same set of two coverage configurations. *Id.* at claim 17. Challenged independent claim 14 recites a different permutation of coverage

¹ All emphases added unless otherwise noted.

configurations, but the third coverage configuration of limitations 14[d] and 14[e] is identical in relevant part to the second coverage configuration of limitations 1[c] and 1[d], and all three coverage configurations of claim 14 require providing coverage by first and second networks.

III. LEVEL OF ORDINARY SKILL IN THE ART

The Petition proposes that a person of ordinary skill in the art (“POSITA”) in the field of the ’196 patent “would have had at least a bachelor’s degree in electrical engineering, computer engineering, computer science, physics, or the equivalent, and at least two years of experience working in the field. Less work experience may be compensated by a higher level of education or vice versa. Relevant working experience would include experience with cellular telecommunications and networking, radio-access networking architectures, protocols and signal propagation in wireless networks.” Pet. at 3 (internal citations omitted, citing Ex. 1003 ¶¶ 50-51). For purposes of this preliminary response, Patent Owner does not challenge that definition.

IV. CLAIM CONSTRUCTION

The Petition states that “Petitioners do not believe any term needs to be expressly construed beyond its plain and ordinary meaning.” *Id.* at 10. For purposes of this response only, Patent Owner agrees that no explicit claim construction is necessary for the purposes of deciding institution.

V. THE PETITION FAILS TO SHOW A REASONABLE LIKELIHOOD OF PREVAILING FOR ANY CHALLENGED CLAIM.

A. The Petition’s Ground 1 theory fails.

All independent claims of the ’196 patent require, in their final limitations, that a beam of the first network (the claimed “second beam” for claims 1, 17 and 20 and the claimed “third beam” for claim 14) provides coverage to at least one continuous use device and that a second network provides coverage to a plurality of interval use devices. *See* ’196 patent limitations 1[c], 1[d], 14[d], 14[e], 17[c], 17[d], 20[c], 20[d]. In the Petition’s Ground 1 theory for claim 1, the Petition alleges that Chitrapu’s “center beam” is the claimed “second beam of the first network” and provides coverage to one or more continuous use device. Pet. at 16 (“The center beam is a second beam of the first network.”); *id.* at 17 (“Chitrapu also discloses that a center beam is configured to provide coverage to a continuous use device.”). The Petition also maps that Chitrapu’s “omni-directional beam” to a beam from the claims “second network” and that it provides coverage to interval use devices. *Id.* at 18 (“[T]he second coverage configuration also includes transmitting an omni-directional beam 224 which provides coverage to interval use devices.”). The Petition contains analogous allegations in regard to the only other independent claims, claims 14, 17, and 20. Pet. at 31-35.

The Petition must thus establish that Chitrapu's center beam is a beam "of the first network" as claimed, and that the omni-directional beam provides coverage "by a second network" as claimed. Indeed, the Petition itself asserts that the omni-directional beam is "on a different, second network than the cover and center beams of the first network." *See, e.g.*, Pet. at 20. The Petition does not and cannot support this latter allegation because Chitrapu's "omni-directional beam" is on the same network as Chitrapu's "center beam." For that reason, the Petition does not and cannot show that Chitrapu renders obvious any of the challenged claims.

In the Petition's theory, both the center and cover beams are "of the first network." Pet. at 14 (identifying "a 'cover beam' (*i.e.*, a first beam of a first network)"; *id.* at 16 ("The center beam is a second beam of the first network Center beam 228 and cover beam 202 are of the same first network"). As Chitrapu explains, it is preferable to use the center and cover beams for distinct functions: the center beam "is preferably used for transmission/reception of user data," and the cover beam "may be used for paging purposes for WTRUs operating within the coverage area of the cover beam" and for locating a WTRU whose location is not known. Ex. 1005, ¶¶[0015]-[0017].

Chitrapu also teaches that the omni-directional beam should be used for exactly the same purposes as the cover beam, such as paging and locating WTRUs. *Id.* ¶¶[0017], [0019]. Specifically, Chitrapu teaches that a paging message may be

delivered using *either* the cover beam *or* the omni-directional beam, depending on the location of the WTRU that is to receive the paging message:

For example, a paging message that is to be delivered to WTRUs 210 and 216 may be delivered using the omni-directional beam 206. Where WTRUs 216, 218 are the recipients of a paging message, the messages may be delivered using the ***cover beam 204 or the omni-directional beam 206***. The omni-directional beam 206 may also be used to locate WTRUs 220, 222, 226 operating outside the range of cover beams 202, 204, as explained in more detail below.

Id. ¶[0019]. This discussion confirms that the omni-directional beam and cover beams serve similar or identical roles within the ***same*** network. This express teaching of Chitrapu contradicts the Petition’s allegation that the omni-directional beam is on a “different, second network” from the center and cover beams.

The Petition provide three reasons that the omni-directional beam is on “a different, second network”: (1) “because it is not part of the nested beam that comprises the cover and center beams”; (2) because it covers a different set of network devices; and (3) because it is “less capable” than the cover and center beams. Pet. at 20. These arguments all fail.

First, the Petition provides no support for the notion that not being “part of the nested beam” means that the omni-directional beam is “on a different, second network.” The only citation is to the declaration of Dr. Almeroth, who merely repeats

the Petition’s one-sentence statement nearly verbatim,² with no analysis, explanation, or citation to evidence in support. As described above, Chitrapu expressly discloses that the cover and omni-directional beams provide overlapping functionalities to the network, including the same paging and locating functions that support the operation of the center beam. And in fact Chitrapu’s only use of the word “network” is in connection with the paging functionality: “During a paging process, when a *network* is trying to locate a WTRU whose location is not known to *the network*, a cover beam 154 is preferably used due to its wider coverage area.” Ex. 1005, ¶[0016]. That is exactly the same process that “may also be performed using an omni-directional beam where an omni-directional beam is deployed along with a nested beam 152.” *Id.* ¶[0018]. Logically, the mere fact that the omni-directional beam is deployed “along with a nested beam” instead of being “part of the nested beam” makes no difference to which network is trying to locate the WTRU: it is the same network.

Second, none of the Petition, Chitrapu, or the ’196 patent gives any support for the notion that a beam covering a different set of devices is *ipso facto* a different,

² The Petition refers to “*The* omni-directional beam,” but Dr. Almeroth calls it “*Chitrapu’s* omni-directional beam.” The rest of the text of this paragraph appears to be literally identical.

second network as the Petition insists. Indeed, the Petition itself contradicts that interpretation. In the Petition’s Ground 1 theory, the *first network* “provides coverage for the group of devices 226 and 210, as well as other devices in the area” during the first coverage configuration using Chitrapu’s *cover beam*. Pet. at 14. But for the second coverage configuration, the Petition maps the “second beam of the *first network*” to Chitrapu’s *center beam* 228, which covers device 226 but does not cover device 120. Pet. at 16 (including annotated reproduction of Ex. 1005 Fig. 3B showing “center beam 228 (second coverage)” encompassing device 226 but not device 210). The Petition thus alleges, as it must, that Chitrapu’s cover beam and center beam are on the same “first network.” If covering a different group of devices meant that a beam was, by definition, on a different network, the Petition’s theory would fail because the center beam could not be a beam of the same “first network” as the cover beam.

Third, the Petition’s “less capable” argument likewise has no plausible support. The Petition avers that Chitrapu’s omni-directional beam is on a different network because it provides “initial handshaking” for the network provided by the center and/or cover beams. Nothing in Chitrapu states or implies that the omni-directional beam provides *only* handshaking functionality, but even accepting the Petition’s theory *arguendo*, it makes little sense to say that providing handshaking

for the first network is actually providing a “different, second network.” And the Petition likewise does not explain why that could possibly be the case.

In addition, the Petition cites disclosures in the '196 patent stating that a second network might be “less capable,” but nothing in the cited discussion supports the Petition’s handshaking theory. The patent provides numerous specific examples of pairs of more and less capable networks, such as 3G vs. EDGE; 4G vs. EDGE, 4G vs. 3G, etc. Ex. 1001 at 9:9-42. In each case, the “less capable network” is a fully functional network (not merely a “less capable beam”) capable of allowing a device to engage in substantive network communications. And unlike in the Petition’s Ground 1 theory, in the '196 patent the “less capable network” as incapable of providing data connectivity for a device, nor is the “less capable” network merely a component (e.g., a beam) of the “more capable” network that simply provides preliminary functionality required for using the “more capable” network.

The Petition’s theory that performing handshaking functionalities makes a beam a “different, second network” also contradicts Chitrapu’s own disclosure. Chitrapu expressly teaches that the cover beam can also perform handshaking. Ex. 1007 ¶[0025] (“[I]f no omni-directional beam 206 is provided, the cover beams 202, 204 may be swept through the coverage area 224 to pick up new users so that existing cover beams may be adjusted or additional cover beams may be deployed, where necessary. . . . [W]here an omni-directional beam is not provided, the initial

handshaking functions will need to be performed *at the cover beams*.”). The Petition alleges and requires that Chitrapu’s cover beams are part of the same “first network” as its center beam Pet. at 14 (“a ‘cover beam’ (*i.e.*, a first beam of a first network)”; *id.* at 16 (“The center beam is a second beam of the first network.”).

Because the Petition fails to show any “second network” as claimed, it does not show that Chitrapu renders obvious limitation 1[d]. This fatal defect likewise applies to limitations 14[e], 17[d], and 20[d], which rely on the same analysis. Pet. at 29, 31, 34. Thus, Ground 1 fails to show invalidity of any of the challenged claims of the ’196 patent.

B. The Petition’s Ground 2 theory fails.

The Petition’s Ground 2 relies on a combination of Chitrapu and Wong, with Wong being imported in an attempt to satisfy the “cycling over time through a coverage sequence” limitation of the independent claims, as well as certain dependent claims. Pet. at 40. This Ground includes no analysis of limitations 1[d], 14[b], 14[c], 17[d], or 20[d], instead implicitly relying on the Ground 1 analysis for those limitations. Ground 2 thus fails to show invalidity of any challenged independent claim for the same reason as Ground 1.

C. The Petition’s Ground 3 theory fails.

The Petition sets forth two different Ground 3 theories, each of which involves a combination of the Dinan and Wong references. Specifically, the Petition presents

somewhat different theories for (1) independent claims 1, 17, and 20; and (2) independent claim 14, which are addressed separately below. However, both theories fundamentally rely on the same concepts from Dinan and Wong. The Petition relies on Wong for its alleged teaching of providing a 4G network (mapped to the '196 patent's "first network" in both theories) with different antenna patterns that alternate using a scheduler. Pet. at 44, 46-47. From Dinan, the Petition takes the alleged teaching of providing simultaneous 4G and 3G networks to different devices within the network coverage areas. Pet. at 53-54. But within the Petition's obviousness theory one concept allegedly taught by Dinan takes a central role: "Dinan discloses that 3G coverage is used to provide service to devices using email, *i.e.*, interval use devices." Pet. at 54; *see also id.* at 9-10 (summarizing Dinan's "algorithm for determining whether a device is assigned 3G or 4G service"); *id.* at 43 (same). This supposed teaching is the only support in the Petition for the final limitation of each independent claim, the requirement of a second network providing coverage to "interval use devices," and thus is an essential component of the Petition's theories. *Id.* at 54.

1. Independent Claims 1, 17, and 20

For independent claims 1, 17, and 20, the Petition's Ground 3 maps the limitations of the '196 patent to the supposed teachings of Wong and Dinan as follows (including only limitations relevant to Patent Owner's argument):

<u>Limitation</u>	<u>Alleged disclosure of Wong/Dinan</u>
“interval use device”	Wong’s device 102. Pet. at 54, 64.
“continuous use device”	Wong’s device 104. <i>Id.</i> at 50, 52, 64.
“first network”	4G network as taught by Wong. <i>Id.</i> at 49, 53-54, 64.
“second network”	3G network as taught by Dinan. <i>Id.</i> at 53-54, 64.
“first coverage configuration” that provides “coverage [by a first network] for the group of devices”	Providing “4G coverage using a wide beam” to a group of devices including devices 102 and 104. <i>Id.</i> at 46, 49, 64.
the “coverage [by a first network] to at least one continuous use device of the group of devices” of the “second coverage configuration”	4G coverage using Wong’s narrow beam antenna pattern 514, which “provides coverage for device 104” <i>Id.</i> at 50-51, 64; <i>see also id.</i> at 46.
the “coverage by a second network to a plurality of interval use devices” of “the second coverage configuration”	Dinan’s 3G coverage of device 102. <i>Id.</i> at 54, 64.

Thinking about this mapping from the perspective of Wong’s device 102 illustrates a key aspect of the Petition’s theory. As noted above, in this ground, device 102 is what the Petition maps to the interval use device. And each of claims 1, 17, and 20 require “cycling over time through a coverage sequence that includes” first and second coverage configurations. In the first coverage configuration, device 102 receives 4G network coverage from Wong’s wide beam antenna pattern 413.

Pet. at 49. In the second coverage configuration, device 102 receives 3G coverage as disclosed by Dinan. *Id.* at 54. Because the claim requires “cycling over time through [this] coverage sequence,” when the Petition’s proposed Wong-Dinan combination cycles back to the first coverage configuration, device 102 will receive Wong’s wide beam 4G network coverage again.

But this jumping back and forth between 3G and 4G networks by an interval use device is not taught by *either* Wong or Dinan. Nor does the Petition allege any purported benefit or motivation to doing so; in fact, assigning an interval use device to a 4G network specifically ***contradicts*** the Petition’s core understanding from Dinan, which the Petition alleges teaches that “3G coverage is used to provide service to devices using email, i.e., interval use devices,” and specifically that device 102 itself is “provided 3G service” and is “not covered by” the 4G network because it is using “interval services such as email.” Pet. at 54. The Petition does not expressly recognize or address this contradiction. The Petition’s proposed configuration for limitation 1[b] contradicts the Petition’s own allegations regarding a POSITA’s understanding of Dinan’s teachings, under which interval devices would be assigned to 3G, because the Petition’s theory inexplicably involves continuously and systematically cycling through a configuration where interval use devices such as 102 are assigned to 4G.

Therefore, as explained in more detail below, the Petition’s implicit theory is actually that a POSITA combining Dinan and Wong would follow Dinan’s teaching about assigning interval use devices to 3G with respect to the second coverage configuration, but would ignore and in fact *reverse* the same teaching with respect to the first coverage configuration. Because the Petition fails to even *allege* (much less show, as it must) any motivation for a configuration that reverses Dinan’s teachings, the Petition fails to motivate the combination underlying its obviousness theory for claims 1, 17, and 20.

a. The Petition requires disregarding Dinan’s alleged teachings during the “first coverage configuration.”

The Petition’s theory for claims 1, 17, and 20 relies upon on a proposed modification to Dinan wherein Dinan’s algorithm for assigning interval use devices to the 3G network under normal operating conditions does *not* apply during the portion of Wong’s scheduling operation that the Petition maps to the “first coverage configuration.”

The Petition’s core allegation regarding Dinan, key to its theory for limitation 1[d], is that Dinan assigns devices with low quality of service requirements to the 3G network, not the 4G network. Pet. at 54 (“Dinan discloses that the 3G coverage provides coverage to interval use devices. . . . Thus, *Dinan discloses that 3G*

coverage is used to provide service to devices using email, i.e., interval use devices.”); see also id. at 9-10, 43.

The Petition’s theory turns on the specific network assignments for “device 102” during the first and second coverage configurations. In the theory, device 102 is the sole exemplar of an “interval use device” as claimed in the ’196 patent, and therefore plays a key role in the claim mapping theory. *See* Pet. at 54. Although the Petition only explains how its mapping would work with exactly two devices (and in fact the Petition does not even identify a “plurality of interval use devices”), the only way the Petition’s theory could possibly work is if multiple interval use devices were included within the “group of devices” to arrive at limitation 1[d]. *See* Pet. 53-55 (only citing device 102 as an interval use device in a limitation requiring “a plurality of interval use devices” within the “group of devices”). Notably, the Petition does not allege any different treatment for any other unspecified “interval use devices.” During the second coverage configuration (limitation 1[d]), the Petition alleges that device 102 is provided with 3G service (coverage by the “second network” as claimed), based on Dinan’s teaching that “3G coverage is used to provide service to devices using email, *i.e.*, interval use devices.” *Id.* at 54. This assignment is based on the Petition’s that device 102 does not require a high quality of service (QoS), for example because it is only using email. *Id.* In particular, the Petition alleges that device 102 under Dinan’s algorithm, “3G coverage is used to

provide services to devices using email, *i.e.*, interval use devices,” and therefore alleges that interval use devices such as device 102 receive 3G coverage under Dinan’s alleged teachings. *Id.* The assumptions that devices such as device 102 are interval use devices, and that Dinan teaches that they should be thus covered by the 3G network (“second network”), are the linchpins of the Petition’s obviousness theory.

But during the first coverage condition (limitation 1[b]), interval use devices such as device 102 are allegedly provided with 4G coverage via Wong’s beam 413, not 3G coverage as in the second coverage condition. Pet. at 49-50 (“Wong discloses providing a ***first coverage configuration*** that includes transmitting a beam antenna pattern (*i.e.* ***first beam of a first network***) For example. . . antenna pattern 413. . . provides coverage for devices 102 and 104.” (emphasis in original)); *id.* at 51 (“[I]n the Dinan-Wong combination, Wong’s antenna patterns are used to provide 4G (*e.g.*, WiMAX) coverage, and therefore both beams are of the same, first network.”). Of course, this is directly contrary to Dinan’s principle of operation relied upon by the Petition, explained directly above, wherein “3G coverage is used to provide services to . . . interval use devices.” Pet. 54; *id.* (“Dinan discloses that the 3G coverage provides coverage to ***interval use devices***.”) (emphasis in original). The Petition provides no explanation why interval use devices such as device 102 are assigned to the 4G network in the first coverage condition, contrary to this teaching

of Dinan; in particular, there is no suggestion of any technical benefit to such a coverage configuration which is admittedly contrary to Dinan's own teachings.

These two coverage conditions, wherein interval use devices such as device 102 are covered by a 4G network during the first coverage condition, but are covered by a 3G network during the second coverage condition, form the basis for the entirety of the Petition's Ground 3 analysis of Claim 1. Pet. at 49, 54.

On its face, the Petition's treatment of interval use devices between the first and second coverage condition poses a clear contradiction. Why are interval use devices such as device 102 provided with 4G coverage when the principle of operation that the Petition allegedly applies from Dinan to its proposed combination is that interval use devices receive 3G coverage and *not* 4G coverage? The Petition (and the expert declaration that parrots it) never answers this question. Based on the Petition's own reliance on Dinan's teachings, a POSITA would clearly be motivated to assign interval use devices such as device 102 to the 3G network during the first coverage configuration for exactly the same reason that the Petition relies on under the second coverage condition.

The Petition does not acknowledge or expressly address this apparent tension. Instead, it appears that the Petition tacitly structures its combination of Dinan and Wong to avoid the problem by requiring that Dinan's teaching that interval use devices are assigned to the 3G network is disregarded entirely during the first

coverage condition (limitation 1[b]). In other words, under the Petition's theory, the proposed modification of Dinan in view of Wong would continuously cycle through a configuration where Dinan's selection algorithm that is central to the Petition's interpretation of Dinan is disregarded in its entirety, with no alleged benefit for this aspect of the modification.

Comparing the Petition's Ground 3 theories for claims 1 and 14 further confirms the Petition's allegation that Dinan's algorithms for selecting between 3G and 4G network coverage are completely disregarded during the first coverage condition. For the "cycling" limitation of claim 14, the Petition describes the 4G functionality allegedly provided in each of the three claimed coverage configurations, and then expressly states that "All three coverage configurations also provide 3G coverage as taught by Dinan." Pet. at 59. But for the "cycling" limitation of claim 1, the Petition states that the coverage sequence "includes a first coverage configuration that provides 4G coverage... and a second coverage configuration that provides 4G coverage to a continuous use device... as well as 3G coverage to interval use devices." Pet. at 46. If the Petition's theory included Dinan's 3G coverage during the first coverage configuration of claim 1, the Petition would have so stated, as it did for claim 14. It did not, instead confirming that *only* the third coverage configuration includes both 4G and 3G networks.

Thus, the Petition's theory for claims 1, 17, and 20 does not merely require combining Dinan and Wong wholesale, but rather combining them in a specific arrangement, where during the first coverage configuration both continuous use and interval use devices via a 4G network (regardless of network load, contrary to Dinan's teachings), and then only during the second coverage configuration are Dinan's teachings regarding assigning interval use devices to the 3G network followed. To show obviousness, the Petition therefore must show that a POSITA would be motivated to combine Dinan and Wong in this specific arrangement and counterintuitive arrangement.

2. Independent Claim 14

Claim 14 requires a somewhat different set of coverage conditions than claims 1, 17, and 20. In particular, the claim requires:

14[b] providing the first coverage configuration includes transmitting a first beam of a first network that is configured to provide coverage for a first set of the group of devices, and providing coverage by a second network to at least a second set of the group of devices;

14[c] providing the second coverage configuration includes transmitting a second beam of the first network that is configured to provide coverage for the second set of the group of devices, and providing coverage by the second network to at least the first set of the group of devices; and

14[d] providing the third coverage configuration includes transmitting a third beam of the first network that is narrower than the first beam and is configured to provide coverage to at least one continuous use device of the group of devices, the at least one continuous use device being actively involved in a substantially continuous service with the network, and providing coverage by the second network to at least a plurality of interval use devices of the group.

Ex. 1001, claim 14 (numbering added). In the first coverage configuration, the first network covers a first group of devices and the second network covers a second group of devices. In the second coverage configuration, those assignments swap: the first network covers the second set of devices and the second network covers the first set of devices. The final limitation, the third coverage configuration, is identical to the final limitation of the other independent claims (where is it called the second coverage configuration).

Under the Petition's theory, each coverage configuration provides "4G coverage using a [wide/narrow/different narrow] beam antenna pattern as taught by Wong," and "[a]ll three coverage configurations... provide 3G coverage as taught by Dinan." Pet. at 58-59.

The Petition's theory posits that devices 101 and 102 are both interval use devices, *i.e.* devices "using 'applications of lesser relative importance or with less stringent data latency requirements,'" Pet. at 60 (device 102) (quoting Ex. 1007,

11:52-53); *id.* at 61 (assuming “device 101” is “using lower priority applications.”); *id.* at 63 (“[D]evice 101. . . [is an] ***interval use device***[] which [is] provided 3G coverage (*i.e.* ***coverage by a second network***) for interval services like email.”).

Based on the assumptions that devices 101 and 102 are interval use devices, and applying the Petition’s central takeaway from Dinan—that interval use devices are assigned to 3G, not 4G networks—the Petition alleges that both device 101 and device 102 receive 3G coverage instead of 4G coverage. Pet. at 61 (“3G coverage. . . is provided to device 101. . . if [it is] using lower priority applications.”); 63 (“[D]evice 101. . . [is an] ***interval use device***[] which [is] provided 3G coverage (*i.e.* ***coverage by a second network***) for interval services like email.”);

But, similar to the Petition’s theory for claims 1, 17, and 20, the Petition inexplicably changes the assignment for both interval use device 101 and interval use device 102 in other coverage configurations, concluding that (in those other coverage configurations) ***each*** device (including interval use devices) is instead provided with 4G coverage through Wong’s antenna patterns. *Id.* at 59 (device 101 receives 4G coverage from Wong’s antenna pattern 412); *id.* at 61 (device 102 receives 4G coverage from Wong’s antenna pattern 513). Here, unlike in its claim 1 analysis, the Petition expressly acknowledges the flip-flop between 3G assignment (following Dinan’s teachings) and 4G assignment (contradicting Dinan’s teachings):

Wong discloses providing a second coverage configuration that includes transmitting a narrow beam “antenna pattern” (i.e., *second beam of a first network*) For example in Figure 5, antenna pattern 513 provides coverage for 102 and any other devices within that antenna pattern, which is the second set of *devices that had 3G coverage in the first coverage configuration*.

Pet. at 61. Again, in the Petition’s theory, Wong’s beams provide 4G coverage, not 3G coverage. *Id.* at 58-59.

This claim mapping presents exactly the same conceptual problem as the Petition’s mapping for claim 1: sometimes the alleged Dinan-Wong combination follows Dinan’s key alleged teaching—under certain configurations, interval use devices are assigned 3G coverage, not 4G coverage—and under other configurations, sometimes contradicting that same teaching, without explanation.

3. The Petition fails to show any motivation to make the specific arrangements of Dinan and Wong required by either of its theories.

The Petition gives no explanation why a POSITA would have been motivated to combine Dinan and Wong in either of the specific, artificial configuration that it requires to meet all the limitations of any of the patent claims. Even if it were possible to combine Dinan and Wong in general, there are numerous possible arrangements of the two systems, but each of the Petition’s two theories—for claims

1, 17, and 20 and for claim 14 respectively—relies on a specific arrangement in allegedly satisfying the challenged claims. And even assuming *arguendo* that a POSITA would recognize the possible arrangements of Dinan and Wong, the Petition’s failure to motivate the particular arrangements that allegedly match the ’196 patent claims requires denial of institution. As the Federal Circuit recently confirmed: “It does not suffice to meet the motivation to combine requirement to recognize that two alternative arrangements... were both known in the art.” *Virtek Vision Int’l v. Assembly Guidance Systems, Inc.*, No. 2022-1998, slip op. at 5 (Fed. Cir. Mar. 27, 2024). Rather, “there must exist a motivation to combine various prior art references in order for a skilled artisan to make the claimed invention.” *Id.*, slip op. at 7. Here, not only is there no motivation to arrive at the Petition’s proposed modifications, wherein Dinan’s algorithm for 3G/4G assignment would be ignored under various time-cycled configurations, but such a configuration is not even disclosed by any reference relied upon by the Petition.

The requirement for a clear motivation is all the more demanding when, as here, the proposed combination would involve a fundamental change to one of the references. *See Adidas AG v. Nike, Inc.*, 963 F.3d 1355, 1359 (Fed. Cir. 2020) (affirming PTAB’s decision not finding obviousness where a proposed modification would “change the principles under which [the prior art] operates”). Because the Petition’s theory requires, in part, ignoring or contradicting Dinan’s express teaching

that interval use devices should be assigned to 3G networks, not 4G networks, the Petition's proposed modification necessarily changes the principles under which Dinan operates.

The Petition provides only minimal discussion of motivation to combine at all, and no argument whatsoever why a POSITA would select the specific arrangement required for either of the Petition's invalidity theories. The Petition assumes that Wong's scheduler "provide[s] better quality of service." Pet. at 44. The Petition then alleges, with no evidence or meaningful analysis, that a POSITA would be motivated to provide this advantage to Dinan because "Dinan's algorithm is more likely to assign devices that require high QoS to 4G service." *Id.* Even assuming the Petition's proposed motivation might provide some motivation to use Wong's scheduler with Dinan in *some* manner, the Petition does not provide motivation for the *specific* arrangements of Dinan and Wong as required by the Petition's two theories of invalidity wherein Dinan's 3G/4G selection algorithm is ignored entirely under various time-cycled configurations.

For example, in connection with the claim 1 theory, there is no plausible explanation why a POSITA would desire to assign low-QoS devices to 3G service, consistent with the Petition's interpretation of Dinan, while using Wong's narrow beam patterns, but then turn around and assign low-QoS interval use devices to 4G service and remove them from 3G service, contradicting Dinan's alleged teaching,

when Wong’s 4G network is using wide beams. As the Petition elsewhere acknowledges, Wong modulates the quality of service provided to devices by more frequently scheduling the antenna pattern corresponding to a device with high QoS requirement and less frequently scheduling the antenna pattern for a device with low QoS requirement. Pet. at 41 (quoting Ex. 1006, 9:48-51). In the specific situation posited by the Petition, involving devices 102 and 104, this functionality is obviously inapplicable when using wide beam 413, because that antenna pattern covers *both* devices. The scheduler cannot choose to give more time to device 104 than 102 and thus cannot achieve Wong’s benefit of providing appropriate QoS to each device. *See* Pet. at 50 (reproducing Ex. 1003 Fig. 4 with annotation). During the wide beam coverage configuration, Wong’s benefit is at its lowest. Assuming *arguendo* a POSITA would ever combine Dinan and Wong, it would be during the wide beam coverage configuration, when it is at least plausible that Dinan would provide a benefit by putting devices 102 and 104 on different networks when Wong is unable to differentiate them.

If anything, Dinan teaches that it is even more likely for an interval use device to be assigned to 3G during the first coverage configuration, because—as the Petition acknowledges—Dinan teaches that interval-use devices should be assigned to 3G service “if 4G service is loaded.” Pet. at 54. In particular, the Petition relies on Dinan’s step 424 (*see* Pet. at 54 (citing Ex. 1007, 11:49-54, 15:28-38)), which

has as a precondition that 4G base station is “‘heavily’ loaded.” Ex. 1007 at 15:21-37. If the 4G network is “heavily” loaded in the second coverage configuration, when it is using Wong’s narrow beam configuration, then it will certainly also be “heavily” loaded in the first coverage configuration alleged by the Petition, which the Petition acknowledges involves a wide beam coverage configuration that includes *all* devices within the “group of devices.” *See* Pet. at 49 (alleging that “devices 102 and 104 and other devices which may be in that area,” *i.e.* every device in the relevant beam region, would be placed in Dinan’s 4G network in the first coverage configuration). The teachings of Dinan thus do not support placing interval use devices onto the 4G network during any configuration.

Thus, even accepting the Petition’s unsupported allegation that a POSITA would be motivated to combine Dinan and Wong, the Petition does not even attempt to, and cannot, provide motivation to choose the one specific arrangement of Dinan and Wong that meets the limitations of claims 1, 17, and 20, with Dinan’s teachings ignored during the first coverage configuration and enabled during the second coverage configuration. And likewise for claim 14, the Petition provides no motivation for the specific choices required by that theory for when Dinan’s teachings should be followed and when they should be ignored. Finding obviousness in the face of this failure would be legal error, as the Federal Circuit has recently reaffirmed.

Because the Petition fails to show any motivation to combine Dinan and Wong in the particular ways required to satisfy all limitations of any claim of the '196 Patent, Ground 3 fails to show invalidity of any challenged claim.

VI. PETITIONERS AND THEIR CO-REAL PARTIES-IN-INTEREST DO NOT JUSTIFY THREE PARALLEL PETITIONS DIRECTED TOWARDS THE '196 PATENT.

Even if the merits of the Petition were strong (they are not), the Samsung Petitioners and their co-RPIs have not justified three parallel petitions directed towards the '196 patent. In addition to themselves, in the instant Petition, the Samsung Petitioners identify “T-Mobile USA, Inc., AT&T Services Inc., AT&T Corp., AT&T Mobility LLC, and Cellco Partnership d/b/a Verizon Wireless” (“the Carriers”) as RPIs “because Petitioners’ products are accused of infringement in their respective patent infringement actions.” Pet. at 71.

To date, the Samsung Petitioners and their co-RPIs have filed three IPR petitions challenging the '196 patent—IPR2024-000135 (“First Petition,” Ex. 2002), the instant Petition (“Second Petition”), and IPR2024-00317 (“Third Petition,” Ex. 2016). The First Petition was filed on Nov. 22, 2023 by the Carriers, and in addition to themselves, the Carriers “likewise identif[ied] Samsung Electronics Co., Ltd. [as an RPI] because its products are accused of infringement in the AT&T, T-Mobile, and Verizon actions, and Samsung Electronics Co., Ltd. has been named as a defendant” in the district court case against it. Ex. 2002 at 2-3; Pet. at 69. The Second

Petition (the instant petition) was filed less than a month later by the Samsung Petitioners, and identifies the Carriers as co-RPIs. Pet. at 71, 73-76. The Samsung Petitioners also filed the Third Petition the same day, again identifying the Carriers as co-RPIs. Ex. 2016 at 43, 45-48. Thus, three petitions challenging the '196 patent were filed within a month by nominally different petitioners (at least comparing the First Petition on one hand, and the Second and Third Petitions on the other), but each petition identifies at least one petitioner from the other as an RPI.

Although the Samsung Petitioners attempt to explain why their own two petitions (the Second and Third Petitions) should be instituted in view of one another, neither the petitioners of the First Petition (the Carriers) nor the Samsung Petitioners attempt to explain why all three petitions should be instituted in view of the Office's presumptive prohibition on parallel petitions. The Consolidated Trial Practice Guide ("CTPG," Nov. 2019 Update) indicates that at most one petition per patent is sufficient "in most situations," that "multiple petitions by a petitioner are not necessary in the vast majority of cases," and that multiple petitions challenging a particular patent should be "rare." CTPG at 59.

This presumptive prohibition applies to petitions filed by the same petitioner *or their RPIs*. As the Office confirmed, petitions filed by petitioners and their RPIs qualify as "parallel petitions" when the petitions are filed before the preliminary response in the first-filed proceeding:

To take into account the 35 U.S.C. 316(b) and 326(b) considerations of the economy, the integrity of the patent system, and the ability of the USPTO to provide timely and cost-effective PGRs, as outlined in the AIA, the USPTO has developed factors to consider when determining whether to institute an AIA review under several different circumstances, including when ... (3) ***more than one petition is filed by the same petitioner (or privy or real party in interest with a petitioner) at the same time as the first filed petition or up until the filing of the preliminary response in the first filed proceeding*** (“*parallel petitions*”) ...

Changes Under Consideration to Discretionary Institution Practices, Petition Word-Count Limits, and Settlement Practices for America Invents Act Trial Proceedings Before the Patent Trial and Appeal Board, 88 Fed. Reg. 24503, 24506 (Apr. 21, 2023). Here, because the First Petition and the instant Second Petition were filed less than a month apart, no preliminary response was filed in response to the First Petition at the time the Second Petition was filed. The First Petition and the Second Petition (as well as the Third Petition) are therefore parallel, rather than serial, petitions.

The Office’s policy in this regard conforms to the purposes of the AIA, which was crafted to “prevent not only petitioners, but *also* real parties in interest, from requesting or maintaining alternative administrative attacks ... ‘on any ground that the petitioner raised or reasonably could have raised during that inter partes review.’” *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1349

(Fed. Cir. 2018) (“*AIT*”) (quoting 35 U.S.C. §§ 315(e)(1)-(2)); *see also SharkNinja Operating LLC v. IRobot Corp.*, IPR2020-00734, Paper 11 at 20 (PTAB Oct. 6, 2020) (precedential) (“We understand that ‘[patent owners] should not be forced to defend later ... administrative attacks on the same or related grounds by a party that is so closely related to the original petitioner as to qualify as a real party in interest.’”) (quoting *AIT*, 897 F.3d at 1350); *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 at 5 (PTAB Oct. 2, 2020) (precedential) (“[T]he purpose of the RPI provision in IPRs was to protect patent holders from multiple petitions.”) (citing *AIT*, 897 F.3d at 1349-50); *cf.* 35 U.S.C. § 315(b) (The clock for the IPR time-bar begins when “***the petitioner, real party in interest***, or privy of the petitioner ***is served with a complaint*** alleging infringement of the patent.”).

Relatedly, in assessing ***serial*** petitions, the Board has confirmed the importance of determining the significance of “any relationship” between different petitioners in applying the *General Plastic* factors.³ *Valve Corp. v. Elec. Scripting*

³ The Petition contains an analysis of the *General Plastic* factors. Pet. at 67-68. The *General Plastic* analysis does not apply here because the petitions at issue are parallel, rather than serial, petitions. Nevertheless, Patent Owner addresses the Petition’s arguments from this section of the Petition, as many of the same overarching principles apply to both the parallel and serial petitions analyses.

Prods., Inc., IPR2019-00062, Paper 11 at 2 (PTAB Apr. 2, 2019) (precedential) (“*Valve*”) (“[W]hen different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the General Plastic factors.”) (finding “significant relationship” between co-defendants accused of infringing patent based upon devices sold by one defendant incorporating technology licensed from the other). Here, by mutual self-admission, the sets of petitioners are RPIs of one another. Moreover, just as in *Valve*, the sets of petitioners here are both accused of infringement with respect to the very same products. *See* Pet. at 71; Ex. 2002 at 2-3; Ex. 2016 at 43, 45-48. Thus, the petitioners are both self-admitted mutual RPIs **and** they also have the very same “substantial relationship” identified in *Valve*. Just as the Board considers “**any** relationship” between petitioners in the context of **serial** petitions it too must consider an RPI relationship between petitioners in the context of **parallel** petitions.

This, the Samsung Petitioners should have identified *for all three petitions*:

(1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).

CTPG at 59-60. But no ranking of the First Petition on one hand, as compared with the Second and Third Petitions on the other, is provided. Rather, Petitioners only explicitly address ranking between the Second and Third Petitions. Pet. at 69-71.

Viewed generously, the Samsung Petitioners' ranking of the Second Petition (the instant petition) over the Third Petition (IPR2024-00317) could be viewed, in effect, as ranking the Second Petition over the First Petition (the Carriers' petition) since the Third Petition is a "copycat" of the First Petition. *See id.* Even if so, the Samsung Petitioners have not justified why the First and Third Petitions on one hand, as well as the Second Petition on the other, are both necessary.

The First and Third Petitions do indeed challenge different claim sets and use different prior art than the Second Petition. *Compare* Ex. 2002 at 6; Ex. 2016 at 3 (challenging claims 23-27 as obvious over Chang) *with* Pet. at 1, 3 (challenging claims 1-5, 7, 8, 10, 12, 14, 17, 18, 20, and 21 as obvious over Chitrapu, Wang, and/or Dinan). But even so, and even if Petitioners are correct that "[t]he Challenged Claims [in the Second Petition] are materially different than the Challenged claims in the [First and Third] Petition[s]," Petitioners still have not justified multiple petitions here and particularly not why the instant Second Petition is necessary. *See* Pet. at 70-71; *see also id.* at 67-68.

Both the First and Third Petitions use only about half of the 14,000 word type-volume limitation. Ex. 2002 (First Petition) at 48 (indicating a 7,491 word count);

Ex. 2016 (Third Petition) at 47 (indicating a 7,523 word count); 37 C.F.R. § 42.24(a). Although the Second Petition indicates a 12,492 word count (Pet. at 75), only 10,193 of those words are dedicated to addressing the prior art and grounds at issue (*id.* at 5-66). Thus, even if Petitioners would have inserted their materials concerning the Second Petitions' grounds into the Third Petition (which has a slightly lower word count than the First Petition), the combined petition would have had 17,716 words, just a few thousand words over the word count limit. Moreover, Petitioners chose to include their "Ranking of Parallel Petitions" in Third Petition itself, rather than in a separate ranking paper as permitted by the Board. *See* Ex. 2016 at 40-43; CTPG at 60 n.3. And in any event, Petitioners would not have needed this section if they and their co-RPIs would have simply filed one petition to begin with. If this section is removed, the word-count for the combined petition would only be 17,211.

Neither Petitioners nor their co-RPIs offer any explanation for why they could not have reduced the type-volume by just over three thousand words, such as by removing or streamlining background information or adjusting the formatting of Mandatory Notices, to comply with the Boards regulations and guidance that situations requiring multiple petitions "should be rare." CTPG at 59. Indeed, Petitioners do not allege that "the patent owner has asserted a large number of claims in litigation or [that] there is a dispute about priority date requiring arguments under multiple prior art references." *Id.* Petitions also admit that "Petitioners knew of the

prior art references when the Carrier Petitioners filed their Petition” (Pet. at 68), further supporting that Petitioners and their co-RPIs could have included these additional grounds in the First Petition, but chose not to in favor of burdening the Board and Patent Owner with unnecessary parallel proceedings.

Petitioners claim that “there are few overlapping issues that would warrant conservation of Board resources.” *Id.* Setting aside that this appears to be by Petitioners’ and their co-RPI’s design, this argument flies in the face of the guidance in the CTPG that such parallel petitions are rarely needed and “may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” CTPG at 59. Indeed, that parallel petitions may not have overlapping claims or art does not negate the fact that, for example, the parties will need to draft, and the Board will need to review and hear argument on, two sets of briefing rather than one, and that Patent Owner’s expert will need to draft two expert declarations and be deposed twice.

In sum, the Board should exercise its discretion to deny institution of the instant Second Petition. If Petitioners and their co-RPIs wanted to include the claims and grounds in this petition, they could have and should have done so in the First Petition. And Petitioners provide no persuasive explanation for why they did not do so.

VII. DISCRETIONARY DENIAL OF INSTITUTION IS WARRANTED.

Beyond the reasons for non-institution set forth in Sections V and VI, institution should additionally be denied under *Fintiv*. 35 U.S.C. § 314(a) gives the Board discretion to deny institution of IPR due to the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring Co. v. Intrix-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19-21 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”). The Board has set forth six factors for determining whether discretionary denial in light of such parallel litigation is appropriate, and in analyzing them, “takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv I*”); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7-17 (PTAB May 13, 2020) (informative) (“*Fintiv II*”); *see also* Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (dated June 21, 2022) (“Interim Discretionary Denial Memo,” Ex. 2001).

Each of these six *Fintiv* factors weigh in favor of the Board exercising its discretion to deny institution here. For Factor 1, no stay of the parallel district court litigation has been granted, and a stay is unlikely. For Factor 2, trial in the parallel litigation will occur months before the deadline for a final written decision in this proceeding. For Factor 3, largely due to Petitioners’ delay in filing the Petition, there

will be much investment by the parties at the time of institution. For Factor 4, there is nearly perfect overlap in the claims and perfect overlap in the art at issue in this proceeding and in the district court, and Petitioners do not offer any stipulation in an effort to reduce this overlap. For Factor 5, Petitioners are the defendants in the parallel litigation. And for Factor 6, not only did Petitioners unduly delay in filing their Petition, filing just a day before the statutory deadline, but the Petition also fails to present a compelling challenge on the merits and is an improper and unjustified parallel petition. Each of these factors is addressed in more detail below.

A. *Fintiv* Factor 1: The district court has not granted a stay, nor is there any evidence that a stay will be granted.

In the parallel district court proceeding involving the '196 patent and Petitioners, the district court has not granted a stay pending IPR. Further, Petitioners have not requested such a stay, there is no indication they will request a stay, and there is no evidence that a stay will be granted.

And stay of the litigation is, at best, speculative and unlikely. The '196 patent is only one of five patents asserted in that litigation. Even if this IPR were instituted, it is unlikely that Judge Gilstrap would, for example, sever and stay the allegations concerning the '196 patent, as "it is often most efficient to resolve the diverse allegations together in the same action instead of creating numerous distinct cases for every different accused technology, patent, or party." *Polaris PowerLED Techs.*,

LLC v. Samsung Elecs. Am., Inc., No. 2:22-cv-00469-JRG, 2024 WL 1149223, at *2-3, 6 (E.D. Tex. Mar. 15, 2024) (Gilstrap, J.) (denying motion to sever allegations concerning a patent on which IPR had been instituted and stay that portion of the case, even though the case was at an “early stage”). This is particularly true here, where the infringement allegations as to all five patents involve cellular base stations and/or user equipment that supports 3GPP 5G NR communications. Ex. 2018 at 2. “If the Court severed the claims related to the ’[196] Patent, the parties would have to engage in duplicative damages and technical discovery for the overlapping accused products. Moreover, the Court and the parties would be burdened with the inefficiencies that result from doubling the necessary claim construction, pre-trial, and trial proceedings.” *Polaris*, 2024 WL 1149223, at *6.

Where the district court litigation has not been stayed and any stay is speculative and unlikely, allowing this IPR to proceed in parallel would be wasteful and inefficient. Factor 1 weighs against institution.

B. *Fintiv* Factor 2: Two district court trials will occur months before the deadline for a final written decision in this proceeding.

“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Fintiv I* at 9.

Here, the deadline for a final written decision in this IPR is June 28, 2025,

which may be extended to February 11, 2026, for good cause or in the case of joinder. 37 C.F.R. § 42.100(c). Meanwhile, the litigation is set for trial on May 5, 2025. *See* Ex. 2029 at 1; Pet. at 66. The timeframe set by the district court is consistent with the Federal Court Management Statistics for the Eastern District of Texas. *See* Interim Discretionary Denial Memo (Ex. 2001) at 3 & n.4 (encouraging use of these statistics in evaluating this factor). Those statistics indicate that, over the past six years, a civil case in the district was brought to trial 19.6 months after filing. Ex. 2003 (indicating median times to trial for civil cases for the twelve-month period ending in December for 2018-2023 as 19.0, 17.8, 17.5, 23.0, 19.0, and 21.4). Here, the trial involving Petitioners is set approximately over 22 months after the case was filed. *See* Ex. 2010 at 1 (trial set for June 5, 2025); Ex. 2012 (parallel case filed June 16, 2023).

Thus, the trial in the parallel litigation is set to occur approximately two months before the deadline for a final written decision, and possibly over a year before the deadline if extended in this proceeding. The Board has denied institution, including recently, on account of similar gaps between the final written decision and trial. *See, e.g., EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (“*EClinicalWorks*”) (finding this factor weighed in favor of discretionary denial and denying institution where “the beginning of the jury trial in the WDTX Cases is roughly *one or two months* before any final decision would

have been due had *inter partes* review been instituted”); *Fintiv II* at 13 (finding this factor weighed in favor of discretionary denial and denying institution where the district court trial was scheduled to occur ***two months*** before the deadline for the Board to reach a final written decision); *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 17 at 9 (PTAB May 2, 2022) (“*NXP*”) (same), *reh’g denied*, Paper 20 (PTAB Aug. 25, 2022).

The Petition presents no evidence that the trial will not proceed on the set date, which, as noted above, is consistent with the most current time-to-trial statistics for the Eastern District of Texas. Thus, “based on the evidence of record, there is no evidence to suggest that trial will be delayed.” *Nine Energy Serv. Inc. v. NCS Multistage Inc.*, IPR2020-01615, Paper 18 at 9 (Mar. 24, 2011); *see also NXP* at 9 (“We generally take courts’ trial schedules at face value absent some strong evidence to the contrary.”) (quoting *Fintiv II* at 13).

Because the trial in the parallel litigation is currently set to occur approximately two months before the deadline for a final written decision in this IPR, this date is consistent with current time-to-trial statistics, and there is no evidence that this date may change, this factor weighs against institution. *Fintiv II* at 13.

C. *Fintiv* Factor 3: By the time an institution decision is reached, there will have been extensive investment in the parallel district court litigations.

Factor 3 relates to the “amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision.*” *Fintiv I* at 9. For example, “if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition,” this factor favors denial. *Id.* at 9-10. “Likewise, district court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Id.* at 10.

The parties have already served both infringement and invalidity contentions, and at the time of the institution decision, fact discovery will be well underway. Ex. 2010 at 4; Ex. 2011. Indeed, fact discovery is already well underway at the time of this response, as the Petitioners and Patent Owner have already responded to 24 and 18 interrogatories, respectively. In addition, Petitioners have already produced over 13,000 documents, totaling over 675,000 pages, and Patent Owner has already produced over 1,000 documents, totaling 12,000 pages. Petitioners have also already served seven third-party subpoenas. And of course, there will be further investment in this case before the institution decision issues.

The parties’ investment, particularly when viewed in light Petitioners’ delay in filing their Petition, weigh against institution. Petitioners allege that they were

“diligent in filing this Petition less than six months after [they] w[ere] served with the complaint.” Pet. at 66-67. While the timing aspect of that statement may be technically true (*compare id.* at 73-76 (dated December 18, 2023) *with* Ex. 2013 (Samsung defendants served June 21, 2023)), that is not the relevant inquiry here. In addition to themselves, Petitioners identify “T-Mobile USA, Inc., AT&T Services Inc., AT&T Corp., AT&T Mobility LLC, and Cellco Partnership d/b/a Verizon Wireless” (collectively, “the Carriers”) as RPIs “because Petitioners’ products are accused of infringement in their respective patent infringement actions.” Pet. at 71.

The clock for a petitioner to file an IPR petition begins when petitioner or any other RPI is served. 35 U.S.C. § 315(b) (“An inter partes review may not be instituted if the petition requesting the proceeding is filed *more than 1 year after the date on which the* petitioner, *real party in interest*, or privy of the petitioner *is served with a complaint* alleging infringement of the patent.”). Here, the first of these RPIs was served on December 19, 2022 (Ex. 2005 (proof of service of AT&T Services Inc. dated December 19, 2022); Ex. 2004 (corresponding complaint alleging AT&T Services Inc. infringes the ’196 patent)), making the deadline for Petitioners to file the instant Petition December 19, 2023. And the instant Petition was filed on December 18, 2023 (Pet. at 73-76), just *one day* before the statutory deadline. Petitioners therefore waited until nearly the last possible minute to file their Petition. The same is true for petitions that Petitioners filed on other patents asserted in the

parallel litigation. Ex. 2014 at 75-78; Ex. 2015 at 60-62; Ex. 2016 at 45-48; Ex. 2017 at 75-78; (four petitions from Petitioners, each also naming the Carriers as RPIs, all filed December 18, 2023, one day before the statutory deadline).

In addition, in the litigation against the Carriers, Patent Owner served its preliminary infringement contentions involving the '196 patent on all five of the co-RPIs to this proceeding *over seven months before* the Petition was filed (Exs. 2006-2008), and the Carriers served their preliminary invalidity contentions *over five months before* the Petition was filed (Ex. 2009). The Board has found lack of diligence in similar circumstances. For example, in *Ericsson Inc. v. Collision Communications, Inc.*, the Board “d[id] not agree with Petitioner’s view that filing the Petition less than *nine months* after receiving infringement contentions constitutes filing the Petition promptly.” IPR2022-01233, Paper 12 at 15 (PTAB Jan. 19, 2023) (quotation marks omitted). The Board denied institution, and also noted that, like here, “Petitioner waited almost a year from inception of the [parallel] district court proceeding” to file the Petition. *Id.* Here, although Petitioners are not parties to the litigation against the Carriers, Petitioners’ co-RPIs had both infringement and invalidity contentions many months before the Petition was filed, and it is undisputed that Samsung products are at issue in that litigation. Petitioners offer no explanation for their delay in challenging the '196 patent in this forum once

they knew their products were accused of infringement in litigation involving their co-RPIs.

Because there has been substantial investment in the parallel proceeding, and Petitioners unduly delayed in filing the Petition, filing only one day before the statutory deadline, Factor 3 weighs heavily against institution.

D. *Fintiv* Factor 4: There is substantial overlap between this IPR and both district court proceedings.

This factor looks at “whether all or some of the claims challenged in the petition are also at issue in district court” and whether the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as the parallel district court case. *Fintiv I* at 12-13. Here, there is complete overlap between both the challenged and asserted claims, and the same combination of prior art applied in the Petition is also relied upon at the district court.

First, the Petition challenges all of the claims that are currently asserted in the litigation. *Compare* Pet. at 1 (challenging claims 1-5, 7, 8, 10, 12, 14, 17, 18, 20, and 21) *with* Ex. 2018 at 2; Ex. 2019 at 2 (identifying asserted claims 1-5, 7, 10, 12, 14, 17, 18, 20, and 21). Although there is one additional claim challenged in the Petition (claim 8), this is a dependent claim that depends from challenged independent claim 1, and the Petition applies the same prior art references against claim 8 as it does against claim 1 and other claims that are asserted in the parallel litigation. *See* Pet.

at 3 (applying the combination of Chitrapu and Wong against claim 8 as well as all claims asserted in litigation; applying combination of Dinan and Wong against claim 8 as well as numerous asserted claims).

“[A]lthough the challenged claims asserted in this proceeding may not be identical to those the parties elect to pursue at trial in the underlying litigation, the differences do not appear to be meaningful in this case.” *Google LLC v. Agis Software Dev., LLC*, IPR2020-00871, Paper 16 at 14-16 (PTAB Nov. 25, 2020), *reh’g denied*, Paper 27 (PTAB Jan. 26, 2022); *see also Global Tel*Link Corp. v. HLFIP Holding, Inc.*, IPR2021-00444, Paper 14 at 26 (PTAB July 22, 2021) (denying institution of IPR, noting that “[t]he mere fact ... that three dependent claims challenged here are not asserted in the district court litigation without any explanation of why the lack of challenge of these three claims in the district court is significant is not enough to favor institution, in light of the near complete overlap of issues with respect to [the challenged] claims”), *reh’g denied*, Paper 24 (PTAB Jan. 14, 2022).

Second, there is perfect overlap with the grounds asserted in the Petition and the invalidity grounds presented in the district court. The Petition has three obviousness grounds: (1) a single-reference obviousness ground based on Chitrapu, (2) an obviousness ground based on Chitrapu and Wong, and (3) an obviousness ground based on Dinan and Wong. *See* Pet. at 3; *id.* at 5 (indicating “Chitrapu” is

“U.S. Patent Pub. No. 2005/0261028”); *id.* at 7 (indicating “Wong” is “U.S. Patent No. 8,548,525”); *id.* at 9 (indicating “Dinan” is “U.S. Patent No. 8,285,291”). Petitioners rely on these same three combinations as alleged obviousness combinations in the parallel litigation. Ex. 2019 at 40 (listing “Chitrapu-028 alone,” “Chitrapu-028 and Wong together,” and “Wong and Dinan together” as exemplary obviousness combinations). And in the district court, Petitioners also rely in Chitrapu, Wong, and Dinan in other purported invalidity grounds. *Id.* at 33-35 (listing Chitrapu, Wong, and Dinan as purported anticipatory references); *id.* at 40 (listing other exemplary obviousness combinations involving one or more of Chitrapu, Wong, and Dinan).

Further, Petitioners fail to offer any stipulation concerning what prior art they will rely upon in the district court litigation, let alone a *Sotera* stipulation. It is hard to imagine how this proceeding could be an efficient option to the district court litigation when Petitioners intend to assert the ***exact same combinations*** in the district court, as well as the same art in other purported invalidity grounds, even if this Petition is instituted. *See, e.g., Code200, UAB v. Luminati Networks Ltd.*, IPR2020-01506, Paper 10 at 11-12 (PTAB Feb. 16, 2021) (denying institution, and finding that Factor 4 weighs in favor of doing so where “the overlap in issues between the two proceedings is substantial” and there were not “any stipulations filed or actions taken by Petitioner to reduce overlap between the proceedings”);

Apcon, Inc. v. Gigamon Inc., IPR2020-01579, Paper 9 at 26 (PTAB Mar. 16, 2021) (denying institution where “the art appears substantially the same, and no stipulation has been filed by Petitioner agreeing not to assert the same art”).

In short, the Petition challenges the same claims asserted in the parallel litigation, and uses the same art as relied upon in the district court. Petitioners also fail to offer any stipulation limiting the prior art or invalidity grounds on which they will rely in district court litigation. This raises substantial “concerns of inefficiency and the possibility of conflicting decisions,” weighing against institution. *See Fintiv I* at 12.

E. *Fintiv* Factor 5: Petitioners are the defendants in the district court litigation.

Petitioners are the defendants in the parallel litigation. “Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Fintiv II* at 15.

F. *Fintiv* Factor 6: Other circumstances weigh strongly against institution, including the weakness of the Petition, the fact this is an unjustified parallel petition, and Petitioners’ delay.

This factor looks at “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv I* at 9. This factor weighs heavily against institution for three reasons.

First, contrary to Petitioners’ assertion, the merits of the Petition suffer from significant weaknesses and gaps in proof, as discussed above. The Petition fails to

show that any of its proposed obviousness combinations discloses or renders obvious any of the challenged claims. *See supra* § V. Thus, the Petition fails to present a “compelling unpatentability challenge” (*see* Interim Discretionary Denial Memo (Ex. 2001) at 2-5) and fails to establish a reasonable likelihood of success.

Second, “[o]ther facts and circumstances may also impact the Board’s discretion to deny institution,” including “parallel petitions challenging the same patent.” *Fintiv I* at 16. Here, Petitioners and their co-RPIs did not just bring one IPR challenging the ’196 patent; rather, Petitioners brought two petitions and their co-RPIs also brought one of their own. Petitioners and their co-RPIs seek not just two bites at the apple but, rather, **five**, one at the district court trial involving Petitioners, a second in Petitioners’ proceeding here, a third in the other IPR proceeding Petitioners filed, a fourth in Petitioners’ RPIs’ district court trial, and a fifth in the RPI’s IPR proceeding.

This is precisely the sort of harassment of patent owners the AIA was meant to avoid. Congress intended IPRs to provide “quick and cost-effective alternatives to litigation” and to “establish a more efficient and streamlined patent system that will improve patent quality.” *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1317 (Fed. Cir. 2018) (quoting H. Rep. No. 112-98, 40, 48 (2011)). “Congress recognized the importance of protecting patent owners from patent challengers who could use the new administrative review procedures as ‘tools for harassment’” via

“repeated litigation and administrative attacks on the validity of a patent.” *Id.* (quoting H. Rep. No. 112-98, 40). Protecting patent owners from “repeated” and “harassing” attacks is the impetus behind not just *Fintiv*, but numerous other Board precedents. *See, e.g., Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017) (precedential) (recognizing “the potential for abuse of the review process by repeated attacks on patents”); *Valve* at 15 (similar).

Third, there is evidence that Petitioners unduly delayed in filing the Petition, filing just ***one day*** before the statutory deadline, as discussed above for Factor 3, and Petitioners offer no explanation for their delay. *See supra* § VI.C.

* * *

Each of the six *Fintiv* factors weigh in favor of the Board exercising its discretion to deny institution.

VIII. CONCLUSION

Patent Owner respectfully requests that the Board deny institution for any or all of three independent reasons. First, each of the Petition’s grounds fails on the merits. Second, the Board should exercise its discretion to deny institution of the Petition as an unjustified parallel petition. Third, the Board should exercise its discretion under Section 314(a) to deny institution in view of the co-pending lawsuit in light of Petitioners’ delay in filing the Petition.

Date: March 28, 2024

Respectfully submitted,

/Reza Mirzaie/

Reza Mirzaie, Reg. No. 69,138
Amy E. Hayden, Reg. No. 64,817
Neil A. Rubin, Reg. No. 67,030
Peter Tong, Reg. No. 74,292
RUSS, AUGUST & KABAT
12424 Wilshire Blvd., 12th Floor
Los Angeles, CA 90025
Tel.: 310-826-7474
Fax: 310-826-6991
rmirzaie@raklaw.com
ahayden@raklaw.com
nrubin@raklaw.com
ptong@raklaw.com
rak_cobblestone@raklaw.com

Counsel for Patent Owner

CERTIFICATION REGARDING WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), Patent Owner certifies that there are 11,242 words in the paper excluding the portions exempted under 37 C.F.R. §42.24(a)(1).

Date: March 28, 2024

/Reza Mirzaie/
Reza Mirzaie, Reg. No. 69,138
Amy E. Hayden, Reg. No. 64,817
Neil A. Rubin, Reg. No. 67,030
Peter Tong, Reg. No. 74,292
RUSS, AUGUST & KABAT
12424 Wilshire Blvd., 12th Floor
Los Angeles, CA 90025
Tel.: 310-826-7474
Fax: 310-826-6991
ahayden@raklaw.com
nrubin@raklaw.com
ptong@raklaw.com
rak_cobblestone@raklaw.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on March 28, 2024, 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 Petitioners:

James M. Glass (Reg. No. 46,729)
jimglass@quinnemanuel.com
Jason Williams (*pro hac vice* forthcoming)
jasonwiliams@quinnemanuel.com
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
51 Madison Avenue, 22nd Floor
New York, NY 10010
Tel: (212) 849-7000
Fax: (212) 849-7100

Quincy Lu (Reg. No. 76,954)
quincylu@quinnemanuel.com
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
1109 First Avenue, Suite 210
Seattle, WA 98101
Tel: (206) 905-7000
Fax: (206) 905-7100

Date: March 28, 2024

/Reza Mirzaie/
Reza Mirzaie, Reg. No. 69,138
Amy E. Hayden, Reg. No. 64,817
Neil A. Rubin, Reg. No. 67,030
Peter Tong, Reg. No. 74,292
RUSS, AUGUST & KABAT
12424 Wilshire Blvd., 12th Floor
Los Angeles, CA 90025
Tel.: 310-826-7474
Fax: 310-826-6991

ahayden@raklaw.com
nrubin@raklaw.com
ptong@raklaw.com
rak_cobblestone@raklaw.com

Counsel for Patent Owner