

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-Mobile USA, Inc., AT&T Services, Inc., Cellco Partnership d/b/a Verizon
Wireless, Nokia of America Corporation, Ericsson Inc.
Petitioners

v.

Wireless Alliance LLC
Patent Owner

IPR2024-00607
Patent No. 9,144,106

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

I. Introduction.....	1
II. Summary of the Technology.....	1
III. Claim Construction	3
IV. The Board Should Deny Institution Under <i>Fintiv</i>	4
A. Factor 1: denials of stays in similar cases weighs against institution.....	4
B. Factor 2: the Final Written Decision deadline 11 months after trial weighs heavily against institution.....	7
C. Factor 3: the parties will have heavily invested in trial, with trial only a few weeks after the anticipated date of the institution decision, weighing heavily against institution	8
D. Factor 4: overlap of issues is neutral at best.....	9
E. Factor 5: overlap of parties is neutral	10
F. Factor 6: the merits favor denial of institution	10
G. <i>Fintiv</i> Conclusion: The Board Should Deny Institution.....	13
V. 35 U.S.C. § 314(a) Precludes Institution Because Petitioners’ Event-Driven Theory Has No Reasonable Likelihood of Success When the District Court’s Claim Construction Excludes Events	13
VI. Conclusion	14

TABLE OF AUTHORITIES

Cases

<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).....	4, 8, 10
<i>Dish Network v. Broadband iTV</i> , IPR2020-01280, Paper 17 (PTAB Feb. 4, 2021)	8
<i>Ericsson Inc. v. Godo Kaisha IP Bridge 1</i> , IPR2022-00726, Paper 11 (PTAB. Nov. 2, 2022)	10
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020).....	10
<i>VMWare, Inc. v. Intellectual Ventures I LLC</i> , IPR2020-00470, Paper 13 (P.T.A.B. Aug. 18, 2020)	6

Statutes

35 U.S.C. § 314(a)	13, 14
--------------------------	--------

Patent Owner's Exhibit List

Exhibit	Description
2001	First Amended Docket Control Order from <i>Wireless Alliance, LLC v. AT&T Mobility LLC</i> , No. 2:2[3]-cv-00095-RWS-RSP, Dkt. 86 (E.D. Tex. May 2, 2024)
2002	Defendants' And Intervenor's Preliminary Invalidity Contentions Regarding U.S. Patent Nos. 9,144,106; 9,565,662; 10,045,383
2003	Scheduling Order from <i>Intellectual Ventures I LLC v. MVware, Inc.</i> , No. 1:19-cv-01075-ADA (W.D. Tex. Dec. 10, 2019).
2004	Memorandum Opinion and Order [Denying Stay] from <i>Force MOS Tech., Co., Ltd. v. ASUSTek Computer, Inc.</i> , No. 2:22-cv-00046-JRG (E.D. Tex. Apr. 10, 2024)
2005	Order [Denying Stay] from <i>General Access Solutions, Ltd. v. Cellco Partnership D/B/A Verizon Wireless</i> , No. 2:22-cv-00394-JRG (E.D. Tex. May 22, 2024)
2006	Docket Report from <i>Wireless Alliance, LLC v. AT&T Mobility LLC</i> , No. 2:23-cv-00095-RWS-RSP (E.D. Tex. June 9, 2024),
2007	Claim Construction Order from <i>Wireless Alliance, LLC v. AT&T Mobility LLC</i> , No. 2:23-cv-00095-RWS-RSP (E.D. Tex. Apr. 24, 2024).

I. Introduction

If the Board issues its institution decision on the September 26, 2024 deadline, the November 4, 2024 trial will begin about five weeks thereafter. Ex. 2001. At trial, Petitioners will have their day in court to make their same arguments to a jury. Ex. 2002 at 12 (listing Lee and Kim in Petitioners' invalidity contentions). A final written decision will likely not issue until about 11 months later. By then, any appeals from trial will likely be well underway. The Final Written Decision will likely have no effect. To conserve its limited resources, the Board should exercise its discretion to deny institution under *Fintiv*.

Additionally, for the same reason discussed in *Fintiv* factor 6 (the merits), the Petition is unlikely to succeed. Thus, the Board should also deny institution on the merits because Petitioners have not shown a reasonable likelihood of success in view of the District Court's claim construction order, Ex. 2007.

II. Summary of the Technology

The original assignee of the '106 Patent is the Electronics and Telecommunications Research Institute (ETRI) in Korea. Ex. 1001, cover. This is a nonprofit research institute that pioneered many important wireless communication technologies in the CMDA and 4G LTE spaces.

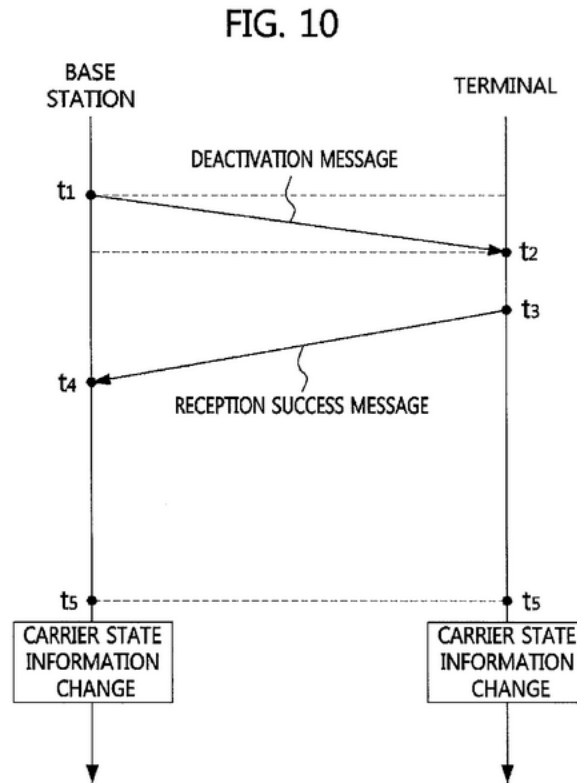
The '106 Patent provides a solution to "prevent inconsistency of secondary-carrier states that are managed by the base station" that may have otherwise arisen

in traditional 3GPP LTE systems. Ex. 1001 at abstract. In LTE systems, a base station engages in wireless data communication with a terminal (e.g., user equipment). Under favorable transmission conditions, the base station may use a “secondary” or “supplemental” component carrier (“CC”) to increase data transmissions to the terminal. *Id.* at 6:1–39. The ’106 Patent describes the scenario where a base station sends a stop transmission instruction to stop using a secondary carrier channel. *Id.* at 6:28–7:2.

But the ’106 Patent does not stop here. It further addresses the problem of potential desynchronization between the base station and the terminal. *Id.* at 13:4–11. The ’106 Patent discloses “the step (810) of transmitting a deactivation message for a secondary carrier to the terminal and the step (820) of changing the secondary carrier to the deactivation state after a predetermined time from the transmission of the deactivation message.” *Id.* at 12:63–13:2. Thus, “the predetermined time may be a value predefined to make state information that is managed by the terminal consistent with state information that is managed by the base station for the secondary carrier.” *Id.* at 13:40–44.

For example, it is possible for a terminal to never receive the instruction to stop transmission that is sent on a primary carrier channel. To avoid this desynchronization, the deactivation for a secondary carrier channel may be set for a predetermined time after the terminal receives a deactivation message. *Id.* at Fig. 10

(showing synchronized deactivation or “carrier state information change” at future time t_5 , after the successful confirmation that the deactivation message was received at t_4), 13:12–43.



Id. at Fig. 10. Notably, after the deactivation message is successfully transmitted, the base station can disconnect or change the state of the secondary carrier at future time t_5 .

III. Claim Construction

The District Court issued a claim construction order that clause containing “predetermined time” is not indefinite. Ex. 2007 at 6, 10. As part of this, the District Court rejected the “assertion that a ‘predetermined time’ can be the occurrence of an

event.” *Id.* at 7–8. The District Court reasoned that the claim language recites that the state change occurs after or based on a predetermined time *from an event*—the transmission of the deactivation message in claim 1. *Id.* at 8.

IV. The Board Should Deny Institution Under *Fintiv*

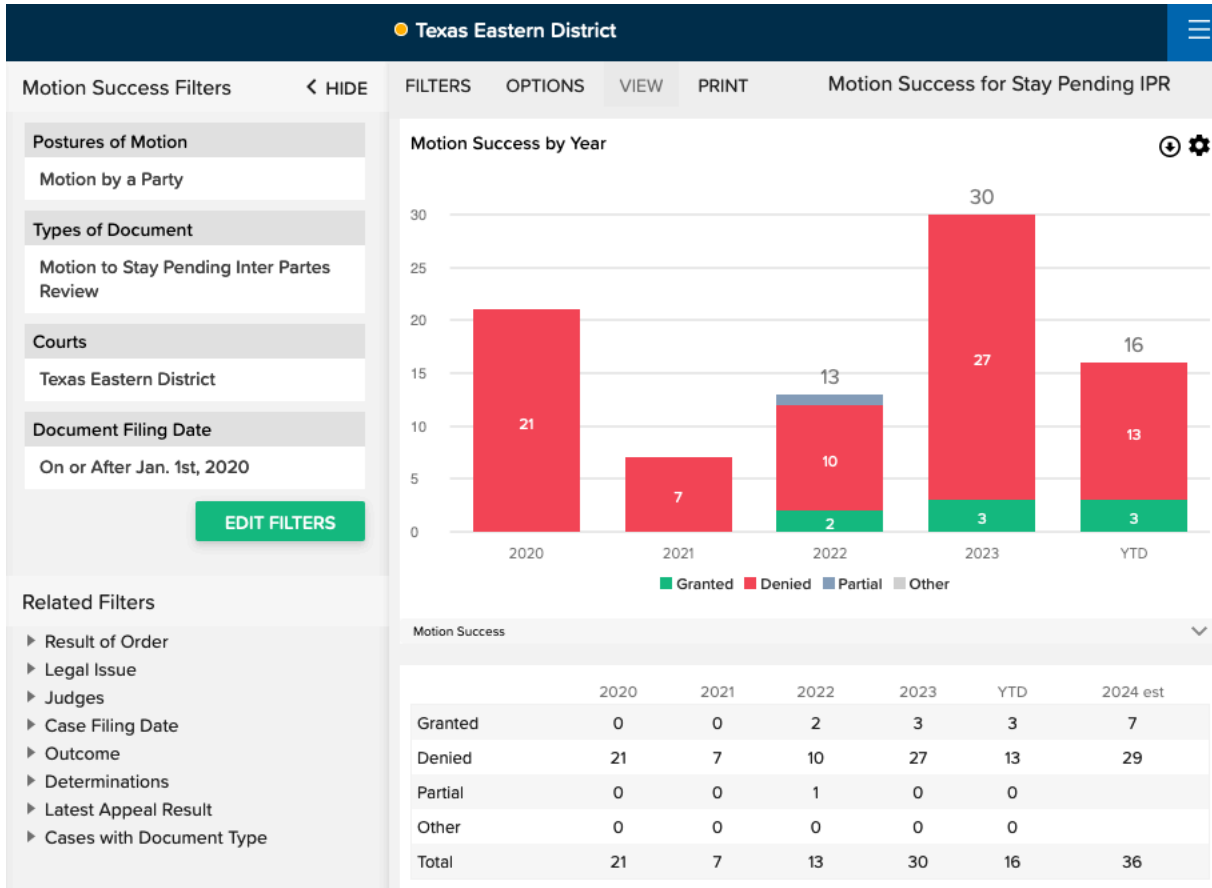
The Board should exercise its discretion to deny this exceptionally late IPR petition under *Fintiv* because the final written decision will not issue until around September 26, 2025—almost a year after the November 4, 2024 trial.

The *Fintiv* factors are: 1) whether the court granted a stay, or evidence exists that one may be granted if a proceeding is instituted; 2) a comparison of the district court trial date to the Board’s statutory deadline; 3) an investment in the district court proceedings; 4) overlap between issues raised in the petition and in the parallel proceeding; 5) overlapping parties; and 6) other considerations. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 13-14 (PTAB Mar. 20, 2020) (precedential).

A. Factor 1: denials of stays in similar cases weighs against institution

Factor 1 (a stay) weighs against institution. The Eastern District of Texas has rarely stayed a patent case pending *inter partes* review, only granting¹ 8 of 87 (9.2%) motions to stay pending an IPR according to a report from Docket Navigator:

¹ Granted when instituted much earlier in the case.



Docket Navigator Motion Outcomes Report (June 10, 2024)

Statistically, any motion to stay pending IPR has at least a 90.8% chance of denial. The District Court is likely to deny a motion for stay given the close proximity of the case to the November 4, 2024 trial. *Fintiv* at 7 (explaining how the “proximity of the court’s trial date and investment of time are relevant” to the likelihood of a stay). Indeed, the District Court effectively denied any possibility for a stay in the Petitioners’ cases when it recently denied motions for stays in similar cases. Ex. 2004 at 1–2 (denying stay in case with a similar trial date of October 7, 2024, just one month before the November 4, 2024 trial in this case, even with substantially

earlier institution decisions by May 27, 2024); Ex. 2005 at 1–2 (denying Petitioner Verizon’s motion to stay when final written decision will issue about half a year after trial). There is no reason to believe the District Court will act any differently in this case. This factor weighs against institution.

These facts distinguish Petitioners’ nonprecedential case *VMWare, Inc. v. Intellectual Ventures I LLC* where the IPR petition was filed in February 2020, just over half a year after the filing of the lawsuit on July 31, 2019. PR2020-00470, Paper 13 at 15 (P.T.A.B. Aug. 18, 2020). The nonprecedential *VMWare* case does not overrule the precedential *Fintiv* ruling that “this fact has sometimes weighed in favor of exercising authority to deny institution under *NHK*.” *Fintiv* at 7–8.

Trial in *VMWare* would not have taken place until April 2021—about a year after the filing of Intellectual Ventures’ POPR on May 20, 2020. Ex. 2003 at 8 (scheduling order for *VMWare*). Thus, the District Court may very well have granted a stay given the much earlier stage of the litigation. In *VMWare*, the patent owner Intellectual Ventures provided no affirmative evidence, such as statistics from Docket Navigator, to show that a motion to stay would be denied if it were filed. *VMWare*, IPR2020-00470, Paper 7 at 14–15. Nor did Intellectual Ventures provide recent decisions from the same district court denying a stay under similar facts, much less a decision denying a stay sought by an overlapping petitioner. The Board was thus correct not to speculate.

Here, the record overwhelmingly suggests that no stay will be granted. The exceptionally late stage of the case (with trial about 5 weeks after the institution decision), the historical data showing an overall 90.8% chance of denial of a motion to stay, and two recent denials of a stays by the same District Court (including one by overlapping Petitioner Verizon) under similar facts make it clear that any motion to stay will very likely be denied. Petitioners likely knew that if they filed a motion to stay, it would have been denied, so Petitioners chose not to file it. The lack of a frivolous motion should not be held against Patent Owner, and it does not change the fact that the trial remains set for November 4, 2024 with no likelihood of a stay.

The two-part inquiry under the first *Fintiv* factor (“whether a stay exists or is likely to be granted if a proceeding is instituted”) should be resolved as follows: no stay exists, and the evidence and recent opinions make clear that a stay will not be granted even if this IPR is instituted. *Fintiv* at 6. Thus, this is a case where “this fact has sometimes weighed in favor of exercising authority to deny institution under *NHK*.” *Fintiv* at 7–8.

B. Factor 2: the Final Written Decision deadline 11 months after trial weighs heavily against institution

Factor 2 (the trial and written decision deadlines) also weighs heavily against institution. Trial is set for November 4, 2024 (Ex. 2001), which is consistent with Petitioners’ estimate. Petition at 62 (estimating October 21, 2024). The final written decision is not expected until September 26, **2025**, about 11 months after trial.

Nothing suggests that litigation will deviate from the schedule or mean statistics by 11 months, especially because Petitioners have not moved to stay the case. The COVID-delay concerns from *Dish Network v. Broadband iTV*, IPR2020-01280, Paper 17 at 16 (PTAB Feb. 4, 2021) no longer apply. If the Board issues its institution decision on the September 26, 2024 deadline, the November 4, 2024 trial will begin in about five weeks thereafter, and nothing is likely to happen within that five week span to delay trial by 11 months. Ex. 2001. Precedent weighs these facts in favor of denying institution. *Fintiv* at 9.

C. Factor 3: the parties will have heavily invested in trial, with trial only a few weeks after the anticipated date of the institution decision, weighing heavily against institution

Factor 3 (investment in court proceedings) favors denial of institution. Patent Owner filed the litigations against the Petitioners on March 7, 2023. Ex. 2006, Dkt. 1. At the time of the filing of this POPR, the parties have already invested heavily in the litigations, including serving infringement and invalidity contentions, filing discovery motions, completing fact discovery, and serving opening expert reports on infringement, damages, and invalidity. Ex. 2001 at 2–3; Ex. 2006, *passim*. The *Markman* briefing and ruling were already completed by April 2024. Ex. 2006 at Dkts. 74, 79; Ex. 2007. By the deadline for an institution decision on September 26, 2024, the parties will have further served rebuttal expert reports, completed expert discovery, fully briefed dispositive motions, fully briefed *Daubert* motions, filed

motions *in limine*, filed a joint pretrial order, filed proposed jury instructions, filed proposed verdict forms, filed exhibit lists, filed witness lists, and filed deposition designations. *Id.* at 2. In short, the parties will be ready for their September 30, 2024 pretrial conference to take place 4 days after this IPR institution decision, and essentially only final preparations will need to be completed for the November 4, 2024 trial. *Id.* at 1–2. This factor weighs heavily in favor of denying institution.

Petitioners could have filed the Petition earlier. They served invalidity contentions in the litigation on September 8, 2023—almost five whole months before filing their February 29, 2024 IPR Petition. Ex. 2002 at 93. These invalidity contentions include the same Lee and Kim references asserted in this IPR. *Id.* at 12. The Petition offered no explanation for its 5-month lack of diligence.

D. Factor 4: overlap of issues is neutral at best

Factor 4 (overlap of the issues) is, at best, neutral. Petitioners’ invalidity contentions assert the same two references (Lee and Kim) among 26 patents/publications, 92 works of non-patent literature, and three systems. Numerically, this is less than a 2% overlap of invalidity arguments. Petitioners attempt to minimize this issue by arguing to the Board that it would not pursue the identical “specific combination of prior art references set forth in the grounds presented in this Petition.” Petition at 63. Petitioners’ representation to the Board is a far cry from a *Sotera*-type stipulation in which a petitioner stipulates to a district

court (not the Board) that it will not pursue in district court the same grounds in the petition as well as “any other ground . . . that was raised or could have been reasonably raised in an IPR.” *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13–14, 18–19 (PTAB Dec. 1, 2020) (precedential). Thus, a stipulation not to assert one specific combination² involving less than 2% of the 121 different prior art reserved for trial is essentially a meaningless, empty promise. In cases such as this, where Petitioners’ stipulation amounts to an “empty promise,” PTAB decisions find this factor neutral. *E.g., Ericsson Inc. v. Godo Kaisha IP Bridge 1*, IPR2022-00726, Paper 11 at 12–13 (PTAB. Nov. 2, 2022) (addressing differences in *Sotera* and *Sand Revolution* stipulations).

E. Factor 5: overlap of parties is neutral

Patent Owner agrees with Petitioners that this factor is neutral.

F. Factor 6: the merits favor denial of institution

The final *Fintiv* factor considers the merits and other circumstances. The Petition lacks compelling merit because they are unlikely to succeed on the merits of at least element [1.b], “*changing the secondary carrier to a deactivation state after a predetermined time from the transmission of the deactivation message*,” in view of the District Court’s claim construction. In particular, Petitioners have not demonstrated that Lee’s “disconnection time” is the claimed predetermined time

² The total number of combinations reserved for trial is astronomically large.

from the *transmission* of the deactivation message.

Petitioners argue that Lee discloses a predetermined time “defined *in relation* to the AAI_CMI-CMD message.” Petition at 47 (citing Ex. 1005, ¶[0153]; emphasis in Petition). Their expert provides the same conclusory statement without explaining why the “relation” is specifically “from the transmission,” as claimed. Ex. 1009 at ¶149. Petitioners and their expert take Lee’s statement out of context. Immediately after the cited statement from Lee’s paragraph 153, Lee provides four specific examples of how the predetermined time is defined. Ex. 1005 at ¶¶[0153]–[157]. None of these four examples state that the “disconnection time” is “from the transmission of the deactivation message.” *Id.* The first 3 examples describe the value of attributes in the AAI_CMI-CMD message other than disconnection time, and then simply state that “a disconnection time is defined.” *Id.* at ¶¶[154]–[156]. The last example implicitly defines the “disconnection time” as an event (the *reception* of the purported deactivation message). Other than repeating the conclusion of its expert that these paragraphs of Lee purportedly disclose a “predetermined time *from* the transmission of the deactivation message,” Petitioners provide no explanation for their conclusion.

Petitioners also argue that Lee’s Tables 5–12 define a “Disconnection time” as the “LSB bits of Superframe number at the time to disconnect the connection with the target carriers.” Petition at 45. Petitioners argue that these tables show

predetermined disconnection times. Petition at 46 (“the disconnection time is a predetermined time.”). However, Petitioners do not further argue that the disconnection time in Tables 5–12 are predetermined times *from* the *transmission* of the deactivation message. Petition at 44–46. As discussed above, Lee makes no such disclosure and Petitioners’ expert also provides no such explanation.

Petitioners also point to a marked-up version of Fig. 8, arguing that it demonstrates that Lee’s “disconnection time” is “connected to the time the AAI_CMI-CMD message is *sent/received*.” Petition at 47 (citing the exact same statement in their expert’s declaration at Ex. 1009 at ¶149; emphasis added). Petitioners’ argument is again nothing more than an unsupported conclusion. Petitioners use the ambiguous phrasing “sent/received” because Petitioners cannot definitively establish which of the two is taught by Lee. Indeed, a “disconnection time” cannot be defined as starting from two different starting times (the sending or the reception) because wireless messages are not sent and received at the same time, an understanding demonstrated in the more detailed ’106 Patent. *E.g.*, Ex. 1001 at Fig. 11 (showing the effect of propagation delay with, for example, a message being sent at t_1 and received later at t_2). The “Time elapsed due to defined disconnection time” annotated by Petitioners (Petition at 47) indicates a time elapsed from the *receipt* of the AAI_CMI-CMD message at the terminal (called an AMS in Lee). Petitioners do not explain why a figure demonstrating a time lapse from the *receipt*

of the AAI_CMI-CMD message is relevant to “predetermined time *from* the *transmission* of the deactivation message.”

Petitioners and their expert have therefore not shown a likelihood of success because, aside from their conclusions, the cited evidence is taken out of context and inconsistent with how a POSITA would understand Lee’s disclosure.

G. *Fintiv* Conclusion: The Board Should Deny Institution

Fintiv factors 1, 2, 3, and 6 all weigh in favor of denying institution. Factors 4 and 5 are neutral. The Board should not waste its limited resources instituting an IPR petition on a patent that will go to trial just 5 weeks after institution, especially when Petitioners offer a meaningless stipulation not to assert only two of their 121 prior art references. This is true especially true in the case of a weak Petition, where the Petitioners cannot show a “predetermined time” consistent with the District Court’s claim construction order. The Petition relies on conclusory expert testimony that is not supported by the prior art, and is inconsistent with the District Court’s claim construction. Institution should therefore be denied.

V. 35 U.S.C. § 314(a) Precludes Institution Because Petitioners’ Event-Driven Theory Has No Reasonable Likelihood of Success When the District Court’s Claim Construction Excludes Events

35 U.S.C. § 314(a) states that the Director may not authorize institution when there is no “reasonable likelihood that the petitioner will prevail with respect to at least 1 of the claims.” For the reasons discussed for *Fintiv* factor 6 (merits), the

Petition lacks a reasonable likelihood of success because it relies on a rejected claim construction.

Petitioners offer different ways that Lee allegedly discloses the claimed “predetermined time.” But as explained above, Petitioners do not explain how Lee discloses a “predetermined time from the transmission of the deactivation message,” which the District Court construed as not being based on “the occurrence of an event.” Ex. 2007 at 7–8. The Petition is completely silent and gives no reasons about how its invalidity theory meets the District Court’s claim construction.

Thus, none of Petitioners’ theories for independent claim 1 have a likelihood of success. For at least the same reasons, Petitioners’ theories for dependent claims 2 and 3 also fail. With no likelihood of success, institution is not authorized under 35 U.S.C. § 314(a).

VI. Conclusion

Under both *Fintiv* and 35 U.S.C. § 314(a), this case lacks merit and has no likelihood of success. The Board should not institute a petition that relies on a claim construction rejected by the District Court. Petitioners offer no explanation of how their interpretation of “predetermined time” does not conflict with the District Court’s claim construction, and Petitioners do not argue for a different construction. Institution will merely waste the parties’ resources that should instead be used for a trial that will take place 5 weeks later, all for a final written decision that will not

issue until 11 months after trial.

Respectfully submitted,

Dated: June 26, 2024

/ Qi Tong /

Qi Tong (Reg. No. 74,292)
RUSS AUGUST & KABAT
4925 Greenville Avenue, Suite 200
Dallas, TX 75206
(310) 826-7474

Attorney for Patent Owner

CERTIFICATION REGARDING WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), Patent Owner certifies that the word processing program used to prepare this paper reports that there are 3,171 words in the paper excluding the portions exempted under 37 C.F.R. §42.24(a)(1).

Dated: June 26, 2024

/ Qi Tong /

Qi Tong (Reg. No. 74,292)

RUSS AUGUST & KABAT

4925 Greenville Avenue, Suite 200

Dallas, TX 75206

(310) 826-7474

Attorney 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 June 26, 2024, by filing this document through P-TACTS as well as delivering a copy via electronic mail upon the following attorneys of record for Petitioners:

John D. Haynes

John.haynes@alston.com

David Frist

David.frist@alston.com

Michael C. Deane

Michael.deane@alston.com

Ross Barton

Ross.barton@alston.com

WA-Alston@alston.com

Date: June 26, 2024

/ Qi Tong /

Qi Tong (Reg. No. 74,292)
RUSS AUGUST & KABAT
4925 Greenville Avenue, Suite 200
Dallas, TX 75206
(310) 826-7474

Attorney for Patent Owner