

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T CORP., AT&T SERVICES, INC., and AT&T MOBILITY LLC,
Petitioners,

v.

ALEXANDER SOTO and WALTER SOTO,
Patent Owners.

Case IPR2024-00712
U.S. Patent No. 8,238,754

PATENT OWNERS' PRELIMINARY RESPONSE¹

¹ Due date extended in Ex. 3001.

To the Honorable Board,

The Board should exercise its discretion to deny institution because, as jointly reported, “[t]he Parties have reached an agreement in principle to resolve the underlying dispute and are in the process of finalizing a formal agreement. . . . The parties expect to be in a position to file a joint motion to dismiss the referenced IPR Petition” Ex. 3001. The parties’ effort to finalize their formal agreement is ongoing and nearing completion. As part of this agreement in principle, Petitioner will be obligated to dismiss its IPR Petition.

35 U.S.C. § 314(a) states that the “Director may not authorize an inter partes review to be instituted unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Because the parties have effectively settled the case aside from final formalities and because the Petitioner will be obligated to dismiss its petition, this IPR is unlikely to proceed to a final written decision, and the Petitioner is unlikely to prevail on any claim.

Because the threshold showing of a likelihood of prevailing is not met, the Board should exercise its discretion to deny institution under 35 U.S.C. § 314(a).

Respectfully submitted,

Dated: August 26, 2024

/ Qi Tong /

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

The undersigned hereby certifies that the above document was served on August 26, 2024, by filing this document through the P-TACTS system as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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