

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.
NOKIA OF AMERICA CORPORATION,

Petitioners,

v.

ACTIVE WIRELESS TECHNOLOGIES LLC,

Patent Owner.

Patent No. 11,019,557
Filing Date: May 10, 2019
Issue Date: May 25, 2021

Inventor: Atsushi Ishii
Title: APPARATUS AND METHOD FOR ACQUISITION OF
PERIODICALLY BROADCASTED SYSTEM INFORMATION IN
WIRELESS COMMUNICATION

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2024-00886

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2001	First Amended Docket Control Order, Dkt. 93, <i>Advanced Coding Techs. LLC v. LG Elecs. Inc.</i> , Case No. 2:22-cv-00501-JRG (E.D. Tex. March 11, 2024)
2002	Defendants' Joint Patent L.R. 3-3 Invalidity Contentions and Subject Matter Ineligibility Contentions, <i>Advanced Coding Techs. LLC v. LG Elecs. Inc.</i> , Case No. 2:22-cv-00501-JRG (E.D. Tex.), served Feb. 21, 2024

I. INTRODUCTION

On May 1, 2024, Ericsson Inc. and Nokia of America Corporation (“Petitioner”) submitted a Petition (Paper 3, “Petition” or “Pet.”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 11,019,557 (Ex. 1001, the “’557 Patent”), challenging Claims 9-16 (the “Challenged Claims”). The Petition asserts that Claims 9-16 are rendered obvious over International Patent Application Publication No. WO 2018/016922 in the name of Ingale et al. (“Ingale” or “Ex. 1004”), alone, or in combination with U.S. Patent Application Publication No. 2015/0223258 in the name of Jung et al. (“Jung” or “Ex. 1005”). Pet. at 17. The Board should deny the Petition for at least the reasons described briefly below.

Petitioner fails to show Ingale, alone, or in combination with Jung discloses at least “a parameter associated with a condition for determination of a failure of an SI message acquisition process,” and “wherein: the first type SIB is re-acquired by the user equipment upon the user equipment failing on the SI message acquisition process in at least one of the SI windows to receive the SI message,” as required by the Challenged Claims.

First, the Petition is deficient because Ingale fails to show “a condition for determination of a failure of an SI message acquisition process.” The Petition merely points to Ingale’s “timer or a counter” indicating “how long the network will broadcast OSI,” which is inapposite to determining failure of an SI message

acquisition process. Since the cited portion of Ingale is irrelevant to failure of an SI message acquisition process, Petitioner cites an entirely different reference, Ex. 1006 (“Zhang”), to rectify the deficiency of Ingale without articulating any motivation to combine Ingale with Zhang (which also fails to disclose *the first type SIB comprises the parameter* associated with a condition of an SI message acquisition failure). Jung also only discloses an additional attempt to acquire compulsory system information when “the acquisition of the system information fails from the cell 1 within the specific time interval” but (i) Jung is silent on whether *the first type SIB comprises a parameter* associated with a condition for determination of a failure of an SI message acquisition process and (ii) Jung’s “compulsory system information” does not correspond to the claimed SI message that fails to be acquired.

Second, Ingale and Jung only disclose re-acquisitions of OSI or SI messages instead of MSI or scheduling information for SI messages. Contrary to Dr. Mahon’s assertions, the fact that SI messages are re-acquired does not automatically mean that “the UE would need to confirm that it has the current scheduling information” so as to re-acquire the scheduling information. The Petition includes no attempt to establish inherency of re-acquiring scheduling information when merely SI messages are re-acquired and Dr. Mahon’s conclusory testimony amounts to only a possibility not disclosed by either Ingale or Jung. Additionally, the Petition is silent regarding whether Ingale or Jung disclose the claimed “user equipment failing on

the SI message acquisition process in at least one of the SI windows to receive the SI message.”

The Board should exercise its discretion to deny the Petition under 35 U.S.C. § 314(a) for at least the following reasons: (i) a parallel District Court Litigation (defined below) exists between the same parties or real-parties-in-interest; (ii) the District Court Litigation involves the same subject patent (the ’557 Patent) with substantially the same claims; (iii) the District Court’s trial will be *over six months before* the projected statutory deadline; (iv) the parties have heavily invested in the District Court Litigation and a trial date is set for March 17, 2025; and (v) there is no stay of the parallel District Court Litigation.

II. THE ’557 PATENT

The ’557 Patent “relates to wireless communications, and particularly to methods, apparatus, and techniques for requesting, transmitting, updating, and using system information (SI) in wireless communications. ’557 Patent, 1:18-21.

The ’557 Patent describes that all-broadcast-based periodic delivery methods could be efficient but only under conditions “where many UEs are almost always flowing into the coverage area. . . . However, this approach may result in wasting valuable radio resources in case of small cell deployment. Therefore, more efficient methods of SIB transmission are desired.” *Id.*, 1:57-64. The ’557 Patent therefore suggests a solution for “methods, apparatus, and techniques for obtaining and/or

updating SIBs in/of Other SI (Other SI SIBs), and also for making a determination of SI message acquisition process failure and remedial processes therefor.” *Id.*, 1:65-2:3.

Claim 9 of the ’557 Patent distinguishes between “the first type SIB comprising: scheduling information of a system information (SI) message” and the SI message itself. *Id.*, Claim 9. The first type SIB has parameters associated with a condition for determining whether the subsequently transmitted SI message failed to be acquired. *Id.* If the SI message fails to be acquired in at least one of the configured SI windows (configured through the scheduling information), the first type SIB or scheduling information is retransmitted and re-acquired by the user equipment. *Id.*

III. THE ALLEGED PRIOR ART

A. Ingale

Ingale “generally relates to a wireless communication system, and more specifically relates to a method and system from System Information (SI) acquisition in the wireless communication system.” Ex. 1004, [1].

Ingale discloses a “timer or a counter” indicating “how long the network will broadcast OSI” without any mention or reference to a determination of failure of SI message acquisition:

There can also be a timer or a counter (specified in terms of seconds or radio frame) associated with the broadcast indicator/FLAG when the FLAG is set to TRUE to indicate how long the network will broadcast the other

system information with reference to the beginning of system modification interval.

Id., ¶ [136].

Ingale discloses that its UE may re-acquire one or more Other SI (OSI) blocks (which correspond to an SI message instead of scheduling information for the SI message):

Another object of the embodiments herein is to monitor respective SI windows indicated by scheduling information included in the MSI to acquire one or more SI blocks of the OSI available in the camped cell.

Id., ¶ [19].

UE re-acquires or requests for a SI block only when it does not have the configuration of SI block corresponding to SCI of that SI block or the stored configuration (SIT) is invalid.

Id., ¶ [204]. Ingale does not describe a re-acquisition process of MSI (or scheduling information) based on the failure of the UE to receive OSI (or SI messages) in configured time windows.

B. Jung

Jung “relates to wireless communication and, more particularly, to an operating method for acquiring system information in a wireless communication system and an apparatus for supporting the same.” Ex. 1005, ¶ [0002].

Jung discloses an additional attempt to acquire compulsory system information, which is a first type SIB, when “the acquisition of the system information fails from the cell 1 within the specific time interval”:

If the acquisition of the [compulsory] system information fails from the cell 1 within the specific time interval, the terminal may additionally attempt to acquire the compulsory system information. Accordingly, the terminal may start the second timer or the second counter to transmit a system information acquisition failure report message to the network (S1231).

Id., ¶ [0240]. The compulsory system information of Jung “may comprise a master information block (MIB), a system information block 1 (SIB1), and a system information block 2 (SIB2) among the system information of the serving cell,” and therefore would correspond to a first type SIB (or scheduling information for a system information message instead of the system information message itself). *Id.*, ¶ [0019]. Therefore, to the extent Jung discloses acquisition failure, it discloses failure of the SIB comprising scheduling information of the SI message instead of failure of the SI message itself.

IV. CLAIM CONSTRUCTION

For the purposes of this Preliminary Response, Patent Owner agrees with Petitioner that “each claim term be given its plain and ordinary meaning.” Pet. at 9.

V. LEVEL OF ORDINARY SKILL IN THE ART

For the purposes of this Preliminary Response only, Patent Owner utilizes

Petitioner’s proposed level of skill in the art: “at least a Bachelor’s degree in Electrical Engineering or related field, and at least two years of work experience in design, development, and/or testing wireless telecommunication systems” and that “[t]o the extent a POSITA would have had a more advanced degree, such as a Master’s degree in Electrical Engineering or related field, then a POSITA may have had less work experience.” Pet. at 9-10 (citations omitted).

**VI. PETITIONER HAS NOT DEMONSTRATED A REASONABLE
LIKELIHOOD OF SUCCESS FOR THE GROUNDS
ADVANCED IN THE PETITION, AND THE PETITION
SHOULD BE DENIED**

The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) so-called secondary considerations where in evidence. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983).

The Board has held that a failure to identify the differences between the claimed subject matter and the prior art is fatal to an obviousness challenge. *See*,

Apple, Inc. v. Contentguard Holdings, Inc., IPR2015-00355, Decision Denying Institution of *Inter Partes* Review, Paper 9 at 9-10 (P.T.A.B. June 26, 2015) (denying institution for failure to identify the differences between the claimed subject matter and the prior art).

In arriving at an obviousness determination, the Board must sufficiently explain and support the conclusions that the prior art references disclose all the elements recited in the Challenged Claims and a relevant, skilled artisan not only could have made, but would have been motivated to combine all the prior art references in the way the patent claims and reasonably expected success. *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017). That is, even if all the claim elements are found across a number of references, an obviousness determination must consider whether a person of ordinary skill in the art would have the motivation to combine those references. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *Los Angeles Biomedical Rsch. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.*, 849 F.3d 1049, 1067 (Fed. Cir. 2017) (vacating and remanding an obviousness determination, in part, because the Board did not make factual finding as to whether there was an apparent reason to combine all three prior art references to achieve the claimed invention and whether a person of skill in the art would have had a reasonable expectation of success from such a combination). This combinability determination, as supported by an

articulated motivation to combine, requires a plausible rationale as to why those prior art references would have worked together. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013). Absent some articulated rationale, a “common sense” finding is no different than the conclusory statement “would have been obvious.” *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017). Of additional importance, “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references. . . .” *Innogenetics, N.V. v. Abbott Lab’ys.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008).

To demonstrate inherent obviousness, an inherent limitation must necessarily be present in the combination of references. *See Pers. Web Techs., LLC v. Apple, Inc.*, 917 F.3d 1376 (Fed. Cir. 2019); *LBT IP I LLC v. Apple Inc.*, No. 2022-1613, 2023 WL 3914920, at *3 (Fed. Cir. June 9, 2023). It is not enough to merely show that it is likely to be present. *Id.*

A. Claim 9 Is Not Obvious Over Ingale, Alone, or in Combination with Jung

- 1. The Petition Does Not Show that Ingale Alone or in Combination with Jung, Discloses “[the first type SIB comprising:] a parameter associated with a condition for determination of a failure of an SI message acquisition process,” as Required by Claim Element [9.3]**

Claim 9 of the ’557 Patent requires “a parameter associated with a condition for determination of a failure of an SI message acquisition process.”

First, the Petition is deficient because Ingale fails to show “a condition for determination of a failure of an SI message acquisition process.” The Petition merely points to Ingale’s “timer or a counter,” indicating “how long the network will broadcast OSI.” Pet. at 34, 36 (citing Ex. 1004, ¶ [136]). However, the length of time of an OSI broadcast is inapposite to determining failure of an SI message acquisition process. Petitioner takes for granted, without any proof from Ingale, that “[i]f a UE is not able to obtain the SI message within the period specified by the timer or number of SI windows identified by the counter included in the first type SIB (*MSI*) broadcast by the BS disclosed by Ingale, then the UE will fail to acquire the SI message.” See Pet. at 36. This logical leap is neither warranted nor supported by the Petition.

Since the cited portion of Ingale is irrelevant to failure of an SI message acquisition process, Petitioner cites an entirely different reference, Ex. 1006 (“Zhang”), 6:1-21, to rectify the deficiency of Ingale. See Pet. at 36. However, Zhang is not part of Petitioner’s ground for obviousness (Ingale and Jung) and Petitioner fails to articulate any motivation to combine Ingale with Zhang. For this reason alone, the Petition is deficient and institution should be denied. See *Broadcom Corp.*, 732 F.3d at 1335; *In re Van Os*, 844 F.3d at 1361.

The Petition’s remaining rationale for how Ingale alone allegedly discloses this claim limitation actually relies exclusively on cites to Petitioner’s expert

declaration of Dr. Mahon instead. *See* Pet. at 36 (citing Ex. 1003, ¶ 107). However, the cited portion of Dr. Mahon’s declaration solely relies on the disclosure of Zhang. *Id.* As noted above, the Petition does not set forth any motivation to combine Zhang with Ingale and/or Jung, which are the sole references in its propounded ground for obviousness. The Petition also includes no attempt to establish inherency of the disclosures of Zhang in either Ingale or Jung. *See LBT IP I LLC*, 2023 WL 3914920, at *3.

Even considering Dr. Mahon’s citation to Zhang, Zhang’s disclosure of multiple scheduling times, where “the UE can judge that the current link is abnormal” “[i]f the timer times out and the SIB is not yet correctly received” is not relevant to the cited embodiment disclosed in Ingale, where a timer is only used to indicate the broadcast length. Ex. 1006, 6:1-21. The Petition is also silent regarding whether Zhang discloses that ***the first type SIB comprises the parameter*** associated with a condition of an SI message acquisition failure.

Second, the Petition’s reliance on Jung is misplaced and does not rectify the deficiencies of Ingale. Petitioner’s expert declaration (Ex. 1003, ¶ 108) contains a plethora of quotations from Jung, which only disclose an additional attempt to acquire compulsory system information when “the ***acquisition of the [compulsory] system information fails*** from the cell 1 within the specific time interval.” Ex. 1005, ¶ [0240] (emphasis added). Claim 9 of the ’557 Patent describes that a first type SIB

has parameters associated with a condition for determining whether the subsequently transmitted SI message failed to be acquired. Jung's description of an additional attempt to acquire compulsory system information when the initial acquisition of the compulsory system information fails, does not disclose this claimed limitation for two reasons: (i) Jung is silent on whether a *first type SIB* (*i.e.*, not the SI message) comprises a parameter associated with a condition for determination of a failure of an SI message acquisition process; and (ii) Jung's "compulsory system information" does not correspond to the claimed SI message that fails to be acquired. Specifically, Jung recites "[t]he compulsory system information may comprise a master information block (MIB), a system information block 1 (SIB1), and a system information block 2 (SIB2) among the system information of the serving cell." Ex. 1005, ¶ [0019]. By Petitioner's own admission, "Minimum System SI may consist of MIB and a limited number of SIBs" correspond to the claimed "first type system information block," which comprises the "scheduling information of a system information (SI) message." Pet. at 31 (citing '557 Patent, 5:49-64); '557 Patent, Claim 9. This claim is clearly directed to the "failure of [the] SI message" itself, not the separate first type SIB comprising the scheduling information of the SI message. Therefore, the Petition is deficient because, to the extent Jung even discloses acquisition failure, it is disclosing failure of the SIB comprising scheduling information of the SI message instead of failure of the SI message itself.

Because of these deficiencies, institution should be denied.

2. The Petition Does Not Show that Ingale Alone or in Combination with Jung Discloses “*wherein: the first type SIB is re-acquired by the user equipment upon the user equipment failing on the SI message acquisition process in at least one of the SI windows to receive the SI message,*” as Required by Claim Element [9.6]

Claim 9 of the ’557 Patent requires “wherein: the first type SIB is re-acquired by the user equipment upon the user equipment failing on the SI message acquisition process in at least one of the SI windows to receive the SI message.”

First, because Ingale, alone, or in combination with Jung, does not disclose “a parameter associated with a condition for determination of a failure of an SI message acquisition process,” Ingale, alone, or in combination with Jung, cannot disclose “wherein: the first type SIB is re-acquired by the user equipment upon the user equipment *failing on the SI message acquisition process* in at least one of the SI windows to receive the SI message.”

Second, Petitioner admits that “Jung expressly discloses that . . . the UE would initiate another attempt to acquire the SI.” Pet. at 44 (citing Ex. 1005, ¶¶ [0221], [0240]). However, this claim limitation recites that “the first type SIB is re-acquired,” not the SI itself, rendering Petitioner’s characterization of Jung inapposite. *See* ’557 Patent, Claim 9 (distinguishing between “the first type SIB comprising: scheduling information of a system information (SI) message” and the

SI message). Similarly, Petitioner admits that “Ingale discloses that . . . the UE re-acquires the one or more Other SI blocks (*SI message*).” Pet. at 44-45 (citing Ex. 1004, ¶¶ [019], [087], [182], [204]).

From Ingale’s and Jung’s disclosures of re-acquisitions of OSI or SI messages, Petitioner relies on its expert for the proposition that “[a] POSITA would have also understood from the foregoing teachings of Ingale and Jung that the UE would re-acquire the MSI.” Pet. at 46 (citing Ex. 1003, ¶ 131). However, Petitioner’s expert, Dr. Mahon, merely parrots the same statements as in the Petition without any support. *See* Ex. 1003, ¶ 131. Contrary to Dr. Mahon’s assertion, the fact that SI messages are re-acquired does not automatically mean that “the UE would need to confirm that it has the current scheduling information” so as to re-acquire the scheduling information. *Id.* The Petition includes no attempt to establish inherency of show that re-acquiring scheduling information is “necessarily present” when merely SI messages are re-acquired. *See LBT IP I LLC*, 2023 WL 3914920, at *3. Dr. Mahon’s conclusory testimony amounts to only a possibility not disclosed by either Ingale or Jung, thus rendering the Petition deficient as to this claim limitation.

Third, the Petition is completely silent on whether Ingale or Jung disclose the claimed “user equipment failing on the SI message acquisition process in at least one of the SI windows to receive the SI message.” *See* Pet. at 44-47. Petitioner’s only citation referring to windows shows that the system of Ingale “monitor[s]

respectively SI windows indicated by scheduling information included in the MSI to acquire one or more SI blocks of the OSI.” Pet. at 45 (citing Ex. 1004, ¶ [019]). Ingale does not describe a re-acquisition process of MSI based on the failure of the UE to receive OSI in configured time windows, nor does Petitioner point to any such disclosure.

Because of these deficiencies, institution should be denied.

B. Claims 10-16 Are Not Obvious Over Ingale Alone or in Combination with Jung

Claims 10-12 depend upon Claim 9. For at least the same reasons as Claim 9, Ingale alone or in combination with Jung fails to render obvious Claims 10-12.

Claims 13-16 recite “a method for a base station apparatus,” which are the method claim analogues of Claims 9-12. For at least the same reasons as Claims 9-12, Ingale alone or in combination with Jung fails to render obvious Claims 13-16.

VII. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(a)

Based on Petitioner’s reasons regarding § 314(a), the Board should exercise its discretion to deny this Petition.

The circumstances of the parallel District Court Litigation, *Active Wireless Techs. LLC v. T-Mobile USA, Inc.*, No. 2:23-cv-00261-JRG-RSP (E.D. Tex.) necessitate denial of the Petition under the Board’s precedent, as every factor considered in relation to efficiency, fairness, and the merits supports denial. *See*

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (considering (a) “whether the petitioner and the defendant in the parallel proceeding are the same party”; (b) “overlap between issues raised in the petition and in the parallel proceeding” (c) “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision”; (d) “investment in the parallel proceeding by the court and the parties”; (e) “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted”; and (f) “other circumstances that impact the Board’s exercise of discretion, including the merits.”).

As set forth below, these factors collectively demonstrate that efficiency and integrity of the AIA are best served by denying review. First, the Petitioner is the Defendant in the parallel proceeding. *See infra* Section VII.A. Second, the asserted claims in the District Court Litigation are all at issue in the Petition. *See infra* Section VII.B. Third, trial in the District Court Litigation is set for March 17, 2025, about six months prior to the projected statutory deadline for a Final Written Decision of this Petition in November 14, 2025. *See infra* Section VII.C. Fourth, the parties (and Patent Owner in particular) have invested significant resources on developing legal and factual issues of validity and infringement in the District Court Litigation and will have invested substantially more resources before any decision on this Petition. *See infra* Section VII.D. Fifth, the Court has already denied a stay pending this

Petition. *See infra* Section VII.E. Finally, no other factors favor institution. *See infra* Section VII.F.

Accordingly, the Board should exercise its discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

**A. The Parallel District Court Litigation and the Petition
Involve the Same Parties**

As Petitioner notes, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the '557 Patent). Pet. at 64-65. Petitioner is a party to the District Court Litigation captioned as *Active Wireless Techs. LLC v. T-Mobile USA, Inc.*, No. 2:23-cv-00261-JRG-RSP (E.D. Tex.). Accordingly, this factor weighs in favor of discretionary denial.

B. The District Court Litigation Involves Substantially the Same Claims

All of the asserted claims of the '557 Patent in the District Court Litigation are at issue in this Petition. “In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020). Accordingly, this fact weighs in favor of discretionary denial.

C. Proximity of the District Court’s Trial Date

The proximity of the District Court Litigation’s trial date to the Board’s projected statutory deadline for a Final Written Decision strongly weighs in favor of discretionary denial.

The parties’ trial is scheduled for March 17, 2025. Ex. 2001 (First Amended Docket Control Order, Dkt. 63, *Active Wireless Techs. LLC v. T-Mobile USA, Inc.*, No. 2:23-cv-00261-JRG-RSP (E.D. Tex. June 14, 2024)). Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final Written Decision of this Petition is November 14, 2025.¹ As the District Court’s trial will be

¹ The statutory deadline for institution is November 14, 2024, “three months after receiving a preliminary response to the petition under section 313.” *See* 35 U.S.C. § 314(b)(1). If instituted, the statutory deadline for Final Written Decision is November 14, 2025, “not later than 1 year after the date on which the Director notices the institution of a review.”

about six months before the projected statutory deadline, this factor weighs strongly in favor of denying institution. See *Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 10-12 (P.T.A.B. June 24, 2020) (denying institution where the jury trial was scheduled to conclude approximately ten months before the statutory deadline); *Edward LifeSciences Corp. v. Evalve, Inc.*, IPR2019-01479, Paper 7, at 6-13 (P.T.A.B. Feb. 26, 2020) (denying institution where jury trial would conclude more than nine months before a final decision would be due); *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude “several months,” before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 (“Because the trial date is substantially earlier than the projected statutory deadline for the Board’s final decision, this factor weighs in favor of discretionary denial.”).

Petitioner does not contest that the proximity of the trial favors denial of institution. Thus, this factor also weighs in favor of discretionary denial.

D. Significant Investment and Petitioner's Delay in Filing the Petition

The parties' investment in the parallel proceeding weighs in favor of discretionary denial. In the District Court Litigation, the Court has already entered two Docket Control Orders (Dkts. 33, 63), Discovery Order (Dkt. 35), Protective Order (Dkt. 49), and E-Discovery Order (Dkt. 56). Discovery is also well under way. The parties have already exchanged infringement contentions pursuant to P.R. 3-1 and invalidity contentions pursuant to P.R. 3-3, and claim construction briefing is underway. Ex. 2001. A trial date is also set for March 17, 2025, which is less than seven months away. *Id.* Thus, the parties' and Court's substantial investment in this proceeding weighs in favor of denial of institution under this factor.

E. No Stay of the Parallel District Court Litigation

There is no stay of the parallel District Court Litigation and, in fact, a motion for a stay by Petitioner has already been denied. *See* Dkt. 68, *Active Wireless Techs. LLC v. T-Mobile USA, Inc.*, No. 2:23-cv-00261-JRG-RSP (E.D. Tex. July 24, 2024). Even if the Petition were instituted and Petitioner filed another motion to stay the District Court Litigation, prejudice, tactical disadvantage to Patent Owner, the late stage of the litigation, and the lack of potential simplification would weigh strongly against such a motion. *See Lennon Image Techs., LLC v. Macy's Retail Holdings, Inc.*, 2:13-CV-00235-JRG, 2014 WL 4652117, at *1 (E.D. Tex. Sept. 18, 2014). The statutory deadline for institution (on November 14, 2024) is not until after the related

District Court Litigation claim construction hearing is completed (on October 1, 2024). Ex. 2001; *see Intell. Ventures II v. FedEx Corp.*, No. 2:16-cv-00980-JRG, Dkt. 141 at 5 (E.D. Tex. Oct. 24, 2017) (“The Court agrees that the Parties have already invested substantial effort and resources during discovery and in preparing claim construction briefing. . . . These circumstances weigh against staying this case”).

Moreover, a stay would not decrease the burden on the Court and the parties since any instituted IPR would only cover 2 out of at least 9 combinations of obviousness that Petitioner has raised in the District Court Litigation, and do not include Petitioner’s challenges under § 101, § 102, or § 112. *See generally* Ex. 2002, at 13, 15, 20-21, 26, 28-29, 40-52, 89-90, 92. *Intell. Ventures II*, No. 2:16-cv-00980-JRG, Dkt. 141 at 3-4 (“[T]he instituted IPRs only cover a narrow slice of the invalidity arguments Defendants have raised in this case. For example, Defendants have argued that the ’715 Patent is invalid under § 102 with respect to at least eight references . . . under § 103 with respect to at least twenty-six combinations . . . under § 112 [], and under § 101.”).

Accordingly, it would be unlikely for the Court to hold that a stay would streamline the litigation and this factor supports denial of institution.

F. Other Factors Favor Discretionary Denial

Petitioner does not present a strong case on the merits, further supporting denial of institution. *See supra* Section VI. Petitioner also does not identify any other factors which weigh against discretionary denial. Pet. at 60-64.

Thus, when viewing the factors together, the Petition should be denied in the Director's discretion under 35 U.S.C. § 314(a).

VIII. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition in its entirety.

Respectfully submitted,

Dated: August 14, 2024

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE specified in 37 C.F.R. § 42.24 has 4,933 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

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CERTIFICATE OF SERVICE

A copy of the foregoing Patent Owner's Preliminary Response and Exhibits
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