

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. 10,531,443
Filing Date: June 14, 2018
Issue Date: January 7, 2020

Inventors: Zhanping Yin and Toshizo Nogami
Title: PHYSICAL UPLINK CONTROL CHANNEL (PUCCH) FORMAT
ADAPTATION FOR 5TH GENERATION (5G) NEW RADIO (NR)

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2024-00951

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2001	First Amended Docket Control Order, Dkt. 63, <i>Active Wireless Techs. LLC v. T-Mobile USA, Inc.</i> , No. 2:23-cv-00261-JRG-RSP (E.D. Tex. June 14, 2024)
2002	Defendants' Joint Patent L.R. 3-3 Invalidity Contentions and Subject Matter Ineligibility Contentions, <i>Active Wireless Techs. LLC v. T-Mobile USA, Inc.</i> , No. 2:23-cv-00261-JRG-RSP (E.D. Tex.), served June 28, 2024

I. INTRODUCTION

On May 31, 2024, Ericsson Inc. and Nokia of America Corporation (“Petitioner”) submitted a Petition (Paper 1, “Petition” or “Pet.”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 10,531,443 (Ex. 1001, the “’443 Patent”), challenging Claims 1-5 (the “Challenged Claims”). The Petition asserts that Claims 1-5 are rendered obvious over (i) U.S. Patent No. 11,206,108 (“Wang” or Ex. 1004); and (ii) over U.S. Patent No. 11,012,221 (“Yang” or “Ex. 1005”). Pet. at 19-20. The Board should deny the Petition for at least the reasons described briefly below.

Petitioner fails to show either Wang or Yang discloses at least “for the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a common search space (CSS), the receiving circuitry is configured to receive one HARQ-ACK bit for the transport block,” and “for the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a UE-specific search space (USS), the receiving circuitry is configured to receive HARQ-ACK bits of all CBGs,” as required by the Challenged Claims.

First, the Petition is deficient because each of the Petition’s citations to Wang, the Wang Foreign Priority Application, or the alleged understanding of the state of the art disclosing whether or not there is a possibility of transmitting one HARQ-ACK bit or multiple HARQ-ACK bits per CBG is inapposite as to whether the singular bit is transmitted only in the instance where a PDSCH is scheduled in a

CSS, as the claim recites. Similarly, the Petition fails to cite to any portion of Wang or the Wang Foreign Priority Application that discloses that “the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a UE-specific search space (USS). Moreover, the Petition also assumes, with no evidence, that Wang discloses the claimed “receiv[ing] HARQ-ACK *bits* of *all CBGs*” for the specific CBG based HARQ-ACK corresponding to the PDSCH scheduled in a USS.

Second, the Petition is deficient because none of its citations to Yang, the '048 Application (the provisional application to Yang), or the alleged understanding of the state of the art disclose either (i) the scheduling of a PDSCH in a common search space; or (ii) any configuration of the number of bits of HARQ-ACK received for the transport block. Similarly, the Petition fails to cite to any portion of Yang or the '048 Application that discloses that “the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a UE-specific search space (USS)” or “receiv[ing] HARQ-ACK bits of all CBGs.”

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 '443 Patent) with substantially the same claims; (iii) the District Court’s trial will be about *seven 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 '443 PATENT

The '443 Patent “relates generally to communication systems” and “[m]ore specifically, the present disclosure relates to physical uplink control channel (PUCCH) format adaptation for 5th generation (5G) new radio (NR).” '443 Patent, 1:16-20.

As the '443 Patent explains, advances in communication capacity, speed, flexibility and/or efficiency presents certain problems, particularly with respect to the communication structure that wireless communication devices use:

As wireless communication devices have advanced, improvements in communication capacity, speed, flexibility and/or efficiency have been sought. However, improving communication capacity, speed, flexibility and/or efficiency may present certain problems.

For example, wireless communication devices may communicate with one or more devices using a communication structure. However, the communication structure used may only offer limited flexibility and/or efficiency. As illustrated by this discussion, systems and methods that improve communication flexibility and/or efficiency may be beneficial.

Id. at 1:34-45.

To address this communication structure issues, for example, the '443 Patent proposes a particular control channel format and resource for HARQ-ACK

feedback, as described below:

The control channel format and resource for HARQ-ACK feedback may be implicitly determined by the scheduling space for CBG-based HARQ-ACK. If a PDSCH is scheduled in common search space (CSS) or UE-group search space, the UE 102 may report only one bit per TB or per PDSCH on a PUCCH format with up to two bits of UCI payload. If the PDSCH is scheduled in UE-specific search space (USS), the UE 102 may report HARQ-ACK bits for at least all transmitted CBGs on a PUCCH format with up to two bits of UCI payload.

Id. at 21:18-27.

III. THE ALLEGED PRIOR ART

A. Wang

Wang “relates to wireless communication technology, in particular to a method and a device for enhancing a performance of data transmission while supporting services with requirements of multiple TTI lengths at the same time.” Ex. 1004, 1:5-10.

Wang describes that “single bit HARQ-ACK information or the multi-bit HARQ-ACK information [is] according to one or more of the following parameters: business type; DCI format; system parameters; downlink control channel resource set; and downlink control channel search space” but Wang’s HARQ-ACK information according to the downlink control channel search space does not describe whether the HARQ-ACK corresponds to a PDSCH or if the PDSCH is scheduled in a common search space (CSS). *Id.*, 3:57-65. Similarly, Wang discloses

a single bit HARQ-ACK feedback method adopted by the DCI in the common search space fixedly but is silent regarding whether the HARQ-ACK corresponds to a PDSCH or if the PDSCH is scheduled in a common search space (CSS). *Id.*, 12:50-57.

Wang's Foreign Priority Application also discloses that HARQ-ACK information is generated according to the received PDSCH and that "DCI in a common search space (CSS) feeds back one-bit HARQ-ACK information to one TB," but such disclosures are silent regarding whether the PDSCH is scheduled in a common search space (CSS). Ex. 1007, 13, 18.

Wang and the Wang Foreign Priority Application disclose a "multi-bit HARQ-ACK feedback method [] adopted by the DCI in a user-specific search space (USS) fixedly" but do not disclose whether the PDSCH is scheduled in a user-specific search space (USS). Ex. 1004, 12:55-57; Ex. 1007, 26).

Wang and the Wang Foreign Priority Application disclose "HARQ-ACK *information* [of]/[to] *each* CBG" but do not disclose receiving HARQ-ACK *bits* of *all CBGs* for the specific CBG based HARQ-ACK corresponding to the PDSCH scheduled in a USS. Ex. 1004, 12:13-19 (emphasis added); Ex. 1007, 25.

B. Yang

Yang "relates to a wireless communication system, and more specifically, to methods and devices for transmitting/receiving signals. The wireless communication

system can support carrier aggregation (CA).” Ex. 1005, 1:8-12.

Yang discloses a CBG-based HARQ-ACK method of transmission but does not disclose either (i) the scheduling of a PDSCH in a common search space; or (ii) any configuration of the number of bits of HARQ-ACK received for the transport block. *Id.*, 16:55-64, 21:21-32, 38:1-6, Fig. 16.

The ’048 Application (the provisional application to Yang) similarly discloses that “the UE operates such that HARQ-ACK feedback corresponding to the PDSCH is reported to eNB using NACK” and “A/N feedback operation on a TB basis may be applied/set for DL/UL data (and/or Msg3/4) transmissions scheduled via CSS-based DCI transmissions,” but does not disclose any number of bits, let alone a requirement of only one HARQ-ACK bit for the HARQ-ACK corresponding to the PDSCH which is scheduled in a common search space. Ex. 1009, 66, 84.

Yang and the ’048 Patent also disclose a “DCI (or TMdedicated DCI format set/used for specific TM only) transmission based not on CSS but on USS,” but do not disclose whether the PDSCH is scheduled in a user-specific search space (USS) or receiving HARQ-ACK bits of all CBGs. Ex. 1005, 37:63-38:1; Ex. 1009, 83-84 (“retransmission scheduling on a CBG basis and A/N feedback configuration operation on a CBG basis may be applied/set only for DL/UL data transmissions scheduled via USS-based DCI transmissions rather than CSS.”).

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 an equivalent 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. Ground 1: Claim 3 Is Not Obvious Over Wang

- 1. The Petition Does Not Show that Wang Discloses “*for the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a common search space (CSS), the receiving circuitry is configured to receive one HARQ-ACK bit for the transport block,*” as Required by Claim Element [3.3]**

Claim 3 of the '443 Patent requires “for the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a common search space (CSS), the receiving circuitry is configured to receive one HARQ-ACK bit for the transport block.”

The Petition is deficient because it fails to disclose a receiving circuitry configured to receive one HARQ-ACK bit for the transport block, specifically for the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a common search space (CSS). The cited portions of Wang in the Petition only disclose single bit HARQ-ACK for a transport block divorced from whether the HARQ-ACK corresponds to a PDSCH scheduled in a CSS. Each of the Petition’s citations is taken in turn below:

First, the Petition highlights that “single bit HARQ-ACK information or the multi-bit HARQ-ACK information [is] according to one or more of the following parameters: business type; DCI format; system parameters; downlink control channel resource set; and downlink control channel search space.” Pet. at 32 (citing Ex. 1004, 3:57-65). However, this citation is inapposite because Wang’s HARQ-

ACK information according to the downlink control channel search space does not describe whether the HARQ-ACK corresponds to a PDSCH or if the PDSCH is scheduled in a common search space (CSS), as the claim requires. Similarly, Wang's disclosure of a single bit HARQ-ACK feedback method adopted by the DCI in the common search space fixedly is also silent regarding whether the HARQ-ACK corresponds to a PDSCH or if the PDSCH is scheduled in a common search space (CSS), as the claim requires. *See* Pet. at 32 (citing Ex. 1004, 12:50-57).

Second, the Petition's citations to the Wang Foreign Priority Application fare no better than Wang itself. For example, the Wang Foreign Priority Application discloses merely that HARQ-ACK information is generated according to the received PDSCH and that "DCI in a common search space (CSS) feeds back one-bit HARQ-ACK information to one TB." Pet. at 33 (citing Ex. 1007, 13, 18). However, such disclosures are silent regarding whether the PDSCH is scheduled in a common search space (CSS), as the claim requires. The Petition merely assumes with no evidence that the disclosed DCI somehow corresponds to the PDSCH scheduled in a CSS. Absent any evidence to make this connection, the Petition is deficient.

Third, the Petition tacitly admits that "Wang does not explicitly disclose element 3.3." Pet. at 33. Instead, the Petition relies upon an undisclosed combination of Wang with the amorphous "State of the Art." *Id.* at 33-34. Such a combination

requires a motivation to combine, which simply does not exist in the Petition or in the Petition's unsupported copy-cat expert declaration:

Petition

To the extent that Wang does not explicitly disclose element 3.3, it would have been obvious to a POSITA in view of Wang as well as the State of the Art as discussed above. Section, V.F, *supra*; EX-1003, ¶281. As disclosed in Wang and in the prior art discussed in Section V.F, it was well known prior to the Priority Date that TBs could be further subdivided in CBs or CBGs and that UEs could transmit HARQ-ACK bits on either a TB or CBG basis to improve the efficiency of the system and potentially prevent the need for retransmission of an entire TB whenever a NACK signal is received. Section V.F, *supra*; EX-1003, ¶281.

Moreover, it was known that it may not always be desirable to transmit one HARQ-ACK bit per CBG in all instances, so that it may be desirable to set up a wireless system where one HARQ-ACK bit is transmitted per TB in some instances, and one HARQ-ACK bit is transmitted per CBG in other instances. Section V.F, *supra*; EX-1003, ¶281. To set up such a system, a POSITA would be faced with a limited number of characteristics to use to distinguish between one HARQ-ACK transmission method and another. Accordingly, a POSITA would immediately recognize that one such distinguishing characteristic to devise such a system around is search space configuration, such that one HARQ-ACK bit is transmitted per TB in one search space configuration (*e.g.*, CSS), while one HARQ-ACK bit is transmitted per CBG in another search space configuration (*e.g.*, USS). EX-1003, ¶281;

Dr. Mahon Declaration

281. To the extent element 3.3 may not be explicitly disclosed in Wang, it would have been obvious to a POSITA in view of Wang as well as the state of the art as discussed above. Section, VI.H, *supra*. As disclosed in Wang and discussed throughout, it was well known prior to the priority date of the '443 Patent that TBs could be further subdivided in CBs or CBGs and that UEs could transmit HARQ-ACK bits on either a TB or CBG basis to improve the efficiency of the system and potentially prevent the need for retransmission of an entire TB whenever a NACK signal is received. Moreover, it was known that it may not always be desirable to transmit one HARQ-ACK bit per CBG in all instances, so that it may be desirable to set up a wireless system where one HARQ-ACK bit is transmitted per TB in some instances, and one HARQ-ACK bit is transmitted per CBG in other instances. To set up such a system, a POSITA would be faced with a limited number of characteristics to use to distinguish between one HARQ-ACK transmission method and another. Accordingly, a POSITA would immediately recognize that one such distinguishing characteristic to devise such a system around is search space configuration, such that one HARQ-ACK bit is transmitted per TB in one search space configuration (*e.g.*, CSS), while one HARQ-ACK bit is transmitted per CBG in another search space configuration (*e.g.*, USS).

Id.; Ex. 1003, ¶ 281. And even if such a motivation to combine existed, the Petition only argues that the combination would yield a system where “one HARQ-ACK bit is transmitted per TB in one search space configuration (*e.g.*, CSS).” Pet. at 34. Once again, the Petition ignores that the claim also recites “the CBG based HARQ-ACK corresponding to *the PDSCH which is scheduled in a common search space (CSS).*” In fact, the relevant portion of the Petition discussing this claim limitation

in the context of the “State of the Art” does not even mention the term “PDSCH.”
See Pet. at 33-34.

In other words, each of the Petition’s citations to Wang, the Wang Foreign Priority Application, or the alleged understanding of the state of the art disclosing whether or not there is a possibility of transmitting one HARQ-ACK bit or multiple HARQ-ACK bits per CBG is inapposite as to whether the singular bit is transmitted only in the instance where a PDSCH is scheduled in a CSS, as the claim recites.

Because of these deficiencies, institution should be denied.

2. The Petition Does Not Show that Wang Discloses “*for the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a UE-specific search space (USS), the receiving circuitry is configured to receive HARQ-ACK bits of all CBGs,*” as Required by Claim Element [3.4]

Claim 3 of the ’443 Patent requires “for the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a UE-specific search space (USS), the receiving circuitry is configured to receive HARQ-ACK bits of all CBGs.”

As with the previous claim limitation 3.3, the Petition fails to cite to any portion of Wang or the Wang Foreign Priority Application that discloses that “the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a UE-specific search space (USS).” *See* Pet. at 34-36.

While the Petition cites to Wang’s disclosure of a “multi-bit HARQ-ACK

feedback method [] adopted by the DCI in a user-specific search space (USS) fixedly,” the Petition is silent regarding Wang’s disclosure of whether the PDSCH is scheduled in a user-specific search space (USS), as the claim requires. Pet. at 35-36 (citing Ex. 1004, 12:55-57, Ex. 1007, 26). The Petition merely assumes with no evidence that the disclosed DCI somehow corresponds to the PDSCH scheduled in a USS. Absent any evidence to make this connection, the Petition is deficient.

The Petition also assumes, with no evidence, that Wang discloses the claimed “receiv[ing] HARQ-ACK *bits* of *all CBGs*” for the specific CBG based HARQ-ACK corresponding to the PDSCH scheduled in a USS. The Petition only cites to portions of Wang that disclose “HARQ-ACK *information* [of]/[to] *each* CBG.” Pet. at 35 (citing Ex. 1004, 12:13-19 and Ex. 1007, 25). The Petition completely manufactures its statement that the Wang Foreign Priority Application discloses a multi-bit HARQ-ACK method of “one bit for each CBG.” *See* Pet. at 36. It does not. Rather the only cite for this unquoted statement is from Petitioner’s expert, who also cites to no support for this verbatim statement. *See* Ex. 1003, ¶ 286. The Board should therefore reject this unsupported statement as mere attorney argument.

The Petition tacitly admits that “Wang does not explicitly disclose element 3.4.” Pet. at 36. As with the previous claim limitation 3.3, the Petition relies upon an undisclosed combination of Wang with the amorphous “state of the art.” *Id.* at 36.

Such a combination requires a motivation to combine, which simply does not exist in the Petition or the Petition's unsupported copy-cat expert declaration:

Petition

To the extent that Wang does not explicitly disclose element 3.4, it would have been obvious to a POSITA in view of Wang as well as the state of the art as discussed above. Section, V.F, *supra*; EX-1003, ¶287. As discussed above with respect to element 3.3, it was well known prior to the Priority Date that it may be desirable to devise a system that in some instances transmitted one HARQ-ACK bit per TB, but in other instances transmitted one HARQ-ACK bit per CBG. EX-1003, ¶287.

A POSITA looking to device such a system would be faced with a limited number of characteristics to distinguish between the two HARQ-ACK transmission methods, with one obvious distinguishing characteristics to use being search space configuration, such that one HARQ-ACK bit is transmitted per TB in one search space configuration (e.g., CSS), while one HARQ-ACK bit is transmitted per CBG in another search space configuration (e.g., USS). EX-1003, ¶287.

Dr. Mahon Declaration

287. To the extent element 3.3 may not be explicitly disclosed in Wang, it would have been obvious to a POSITA in view of Wang as well as the state of the art as discussed above. Section, VI.H, *supra*. As disclosed in Wang and discussed throughout, it was well known prior to the priority date of the '443 Patent that TBs could be further subdivided in CBs or CBGs and that UEs could transmit HARQ-ACK bits on either a TB or CBG basis to improve the efficiency of the system and potentially prevent the need for retransmission of an entire TB whenever a NACK signal is received. Moreover, it was known that it may not always be desirable to transmit one HARQ-ACK bit per CBG in all instances, so that it may be desirable to set up a wireless system where one HARQ-ACK bit is transmitted per TB in some instances, and one HARQ-ACK bit is transmitted per CBG in other instances. To set up such a system, a POSITA would be faced with a limited number of characteristics to use to distinguish between one HARQ-ACK transmission method and another. Accordingly, a POSITA would immediately recognize that one such distinguishing characteristic to devise such a system around is search space configuration, such that one HARQ-ACK bit is transmitted per TB in one search space configuration (e.g., CSS), while one HARQ-ACK bit is transmitted per CBG in another search space configuration (e.g., USS).

Id.; Ex. 1003, ¶ 287. And even if such a motivation to combine existed, the Petition ignores that the claim recites “the CBG based HARQ-ACK corresponding to *the PDSCH which is scheduled in a UE-specific search space (USS)*.” In fact, the relevant portion of the Petition discussing this claim limitation in the context of the “State of the Art” does not even mention the term “PDSCH.” *See* Pet. at 36. Again, the Petition provides unsupported attorney argument (and unsupported expert testimony) for the proposition that the state of the art discloses “one HARQ-ACK bit [is transmitted] per CBG,” which should be afforded no weight:

Petition

A POSITA looking to device such a system would be faced with a limited number of characteristics to distinguish between the two HARQ-ACK transmission methods, with one obvious distinguishing characteristics to use being search space configuration, such that one HARQ-ACK bit is transmitted per TB in one search space configuration (e.g., CSS), while one HARQ-ACK bit is transmitted per CBG in another search space configuration (e.g., USS). EX-1003, ¶287.

Dr. Mahon Declaration

HARQ-ACK bit is transmitted per CBG in other instances. To set up such a system, a POSITA would be faced with a limited number of characteristics to use to distinguish between one HARQ-ACK transmission method and another. Accordingly, a POSITA would immediately recognize that one such distinguishing characteristic to devise such a system around is search space configuration, such that one HARQ-ACK bit is transmitted per TB in one search space configuration (e.g., CSS), while one HARQ-ACK bit is transmitted per CBG in another search space configuration (e.g., USS).

Id. (annotated); Ex. 1003, ¶ 287 (annotated).

Because of these deficiencies, institution should be denied.

B. Ground 2: Claim 3 Is Not Obvious Over Yang

1. The Petition Does Not Show that Yang Discloses “*for the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a common search space (CSS), the receiving circuitry is configured to receive one HARQ-ACK bit for the transport block,*” as Required by Claim Element [3.3]

Claim 3 of the '443 Patent requires “for the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a common search space (CSS), the receiving circuitry is configured to receive one HARQ-ACK bit for the transport block.”

The Petition is deficient because none of its citations to Yang disclose either (i) the scheduling of a PDSCH in a common search space; or (ii) any configuration of the number of bits of HARQ-ACK received for the transport block. Pet. at 55-60 (citing Ex. 1005, 16:55-64, 21:21-32, 38:1-6, FIG. 16). For example, the Petition makes a conclusory statement that “Yang discloses utilizing one HARQ-ACK bit

for the transport block when the PDSCH is scheduled in a CSS” but the statement in the Petition or Petitioner’s expert declaration (just a singular sentence) is not supported by any evidence:

Petition

Thus, Yang discloses utilizing one HARQ-ACK bit for the transport block when the PDSCH is scheduled in a CSS. EX-1003, ¶358.

Dr. Mahon Declaration

358. Thus, Yang discloses utilizing one HARQ-ACK bit for the transport block when the PDSCH is scheduled in a CSS.

Id. at 58; Ex. 1003, ¶ 358. None of the citations to Yang in the Petition even mention the number of HARQ-ACK bits. Pet. at 55-60.

The Petition’s citations to the ’048 Application (the provisional application to Yang) fares no better than Yang itself. The Petition cites to a disclosure in the ’048 Application that “the UE operates such that HARQ-ACK feedback corresponding to the PDSCH is reported to eNB using NACK” and “A/N feedback operation on a TB basis may be applied/set for DL/UL data (and/or Msg3/4) transmissions scheduled via CSS-based DCI transmissions.” Pet. at 58 (citing Ex. 1009, 66, 84). However, such disclosures are inapposite. Aside from the failure to disclose any number of bits, let alone the one HARQ-ACK bit required by this claim limitation, the Petition also assumes with no evidence that the disclosed downlink data (DL data) somehow corresponds to the PDSCH scheduled in a CSS. Absent any evidence to make this connection, the Petition is deficient.

The Petition tacitly admits that “Yang does not explicitly disclose element 3.3.” Pet. at 59. Instead, the Petition relies upon an undisclosed combination of Yang

with the amorphous “state of the art,” which is a copy-cat of its arguments with respect to Wang. *Compare* Pet. at 59 with *id.* at 33-34. For the same reasons as with Wang, the Petition therefore fails to disclose this claim limitation utilizing the combination of Yang with the alleged state of the art. *See supra* § VI.A.1.

Because of these deficiencies, institution should be denied.

2. The Petition Does Not Show that Yang Discloses “*for the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a UE-specific search space (USS), the receiving circuitry is configured to receive HARQ-ACK bits of all CBGs,*” as Required by Claim Element [3.4]

Claim 3 of the ’443 Patent requires “for the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a UE-specific search space (USS), the receiving circuitry is configured to receive HARQ-ACK bits of all CBGs.”

As with the previous claim limitation 3.3, the Petition fails to cite to any portion of Yang or the ’048 Application that discloses that “the CBG based HARQ-ACK corresponding to the PDSCH which is scheduled in a UE-specific search space (USS)” or “receiv[ing] HARQ-ACT bits of all CBGs.” *See* Pet. at 34-36.

While the Petition cites to Yang’s disclosure of a “DCI (or TMdedicated DCI format set/used for specific TM only) transmission *based not on CSS but on USS,*” the Petition is silent regarding Yang’s disclosure of whether the PDSCH is scheduled in a user-specific search space (USS), as the claim requires. Pet. at 62 (citing Ex.

1005, 37:63-38:1; *see also* Pet. at 62-63 (citing Ex. 1009, 83-84) (“retransmission scheduling on a CBG basis and A/N feedback configuration operation on a CBG basis may be applied/set only for DL/UL data transmissions scheduled via USS-based DCI transmissions rather than CSS.”). The Petition merely assumes with no evidence that the disclosed DCI in Yang and the ’048 Application somehow corresponds to the PDSCH scheduled in a USS. Absent any evidence to make this connection, the Petition is deficient.

The Petition also assumes, with no evidence, that Yang discloses the claimed “receiv[ing] HARQ-ACK *bits* of *all CBGs*” for the specific CBG based HARQ-ACK corresponding to the PDSCH scheduled in a USS. The Petition completely manufactures its statement that “Yang discloses utilizing HARQ-ACK bits for all CBGs when the PDSCH is scheduled in a USS.” *See* Pet. at 62. It does not. Rather the only cite for this unquoted statement is from Petitioner’s expert, who also cites to no support for this verbatim statement:

Petition

Thus, Yang discloses utilizing HARQ-ACK bits for all CBGs when the PDSCH is scheduled in a USS. EX-1003, ¶368.

Dr. Mahon Declaration

368. Thus, Yang discloses utilizing HARQ-ACK bits for all CBGs when the PDSCH is scheduled in a USS.

Id.; Ex. 1003, ¶ 368. The Board should therefore reject this unsupported statement as mere attorney argument.

The Petition tacitly admits that “Yang does not explicitly disclose element 3.4.” Pet. at 63. As with the previous claim limitation 3.3, the Petition relies upon an undisclosed combination of Yang with the amorphous “state of the art.” *Id.* Such a combination requires a motivation to combine, which simply does not exist in the Petition. And even if such a motivation to combine existed, the Petition ignores that the claim recites “the CBG based HARQ-ACK corresponding to *the PDSCH which is scheduled in a UE-specific search space (USS)*.” In fact, the relevant portion of the Petition discussing this claim limitation in the context of the “state of the art” does not even mention the term “PDSCH.” *See id.* Again, the Petition provides unsupported attorney argument (and unsupported expert testimony) for the proposition that the state of the art discloses “one HARQ-ACK bit [is transmitted] per CBG,” which should be afforded no weight. *Id.*; Ex. 1003, ¶ 370. Neither Yang nor the ’048 Patent even disclose a number of bits associated with the HARQ-ACK.

Because of these deficiencies, institution should be denied.

C. Claims 1-2 and 4-5 Are Not Obvious Over Either Wang or Yang

Claim 1 recites “[a] user equipment” analogue to the “base station” of Claim 3. For at least the same reasons as Claim 3, Wang or Yang fail to render obvious Claim 1.

Claim 2 depends upon Claim 1. For at least the same reasons as Claim 1, Wang or Yang fails to render obvious Claim 2.

Claim 4 recites “a communication method of a user equipment,” which is the method claim analogues of Claim 1. For at least the same reasons as Claim 1, Wang or Yang fails to render obvious Claim 4.

Claim 5 recites “a communication method of a base station,” which is the method claim analogues of Claim 3. For at least the same reasons as Claim 3, Wang or Yang fails to render obvious Claim 5.

**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 December 15, 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 '443 Patent). Pet. at 74. 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 '443 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 December 15, 2025.¹ As the District Court's trial will be ***about seven 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.*

¹ The statutory deadline for institution is December 13, 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 December 15, 2025 (December 13, 2025 is a Saturday), "not later than 1 year after the date on which the Director notices the institution of a review."

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 complete. Ex. 2001. A trial date is also set for March 17, 2025, which almost six 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 December 13, 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 7 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 12-13, 15, 17-20, 25-26, 27-28, 35-40, 89, 91-92. *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 70-73.

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

VIII. THE BOARD SHOULD REJECT ANY LATE SOTERA STIPULATION

Petitioner has not made a *Sotera*-style stipulation that “if IPR is instituted, [Petitioner] will not pursue in the District Court Litigation any ground raised or that could have been reasonably raised in an IPR” in its Petition, which weighs further in favor of discretionarily denying institution. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 13-14 (P.T.A.B. Dec. 1, 2020) (designated Dec. 17, 2020).

The Board should not accept any late *Sotera* stipulation after this Patent Owner Preliminary Response. Petitioner has known about the related District Court

Litigation since Patent Owner filed a Complaint asserting infringement of the '443 Patent against T-Mobile USA, Inc. and T-Mobile US, Inc. (May 31, 2023) a year before this Petition (May 31, 2024) and has had two docket control orders for the District Court Litigation, each anticipating a trial date 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). Any withholding of the *Sotera* stipulation in its Petition is gamesmanship and prejudicial to Patent Owner in this proceeding and is inconsistent with 37 C.F.R. § 42.1(b)'s mandate to "secure the just, speedy, and inexpensive resolution of every proceeding."

Both the Board and the Director are abundantly clear that Petitioner cannot wait until after the Board renders its Institution Decision to address the issue of *Fintiv*, the Board's discretionary authority, and to submit a *Sotera* stipulation. *NXP USA, Inc. v Impinj, Inc.*, IPR2021-01556, Paper 12, 5-6 (P.T.A.B. Aug. 25, 2022); *see also id.*, IPR2021-01556, Paper 13, 3-4 (P.T.A.B. Sept. 7, 2022) (the Director finding "that the Board correctly determined that a stipulation, offered by a petitioner for the first time after a decision denying institution, is not a proper basis for granting rehearing of the decision on institution;" "[p]ermitting a petitioner to wait and see if the Board denies institution under *Fintiv*, and then offer such a stipulation for the first time on rehearing, frustrates these goals [of avoiding conflicting decisions] and

would open the door to gamesmanship,” “*the only appropriate time for a petitioner to offer a stipulation related to the Fintiv factor 4 analysis is prior to the Board’s decision of whether to institute review.*”) (emphasis added).

IX. CONCLUSION

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

Respectfully submitted,

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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 6,268 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.

Respectfully submitted,

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