

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC. and
NOKIA OF AMERICA CORPORATION,

Petitioners,

v.

ACTIVE WIRELESS TECHNOLOGIES LLC,

Patent Owner.

Patent No. 10,601,566
Filing Date: August 9, 2018
Issue Date: March 24, 2020

Inventors: Zhanping Yin and Toshizo Nogami
Title: MULTIPLE SLOT LONG PHYSICAL UPLINK
CONTROL CHANNEL (PUCCH) DESIGN FOR 5TH
GENERATION (5G) NEW RADIO (NR)

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2024-00985

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LIST OF EXHIBITS

Exhibit No.	Description of Document
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.), dated June 14, 2024)
2002	Defendants' Supplemental P.R. 3-3 and 3-4 Disclosures, <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
2003	Defendants' / Intervenors' List of Patent Claim Terms for Construction, <i>Active Wireless Techs. LLC v. T-Mobile USA, Inc.</i> , No. 2:23-cv-00261-JRG-RSP (E.D. Tex.), served May 23, 2024
2004	Defendants' / Intervenor's Preliminary Claim Constructions Pursuant to Local Patent Rule 4-2, <i>Active Wireless Techs. LLC v. T-Mobile USA, Inc.</i> , No. 2:23-cv-00261-JRG-RSP (E.D. Tex.), served June 27, 2024
2005	Joint Claim Construction and Prehearing Statement, Dkt. 66, <i>Active Wireless Techs. LLC v. T-Mobile USA, Inc.</i> , No. 2:23-cv-00261-JRG-RSP (E.D. Tex.), dated July 11, 2024

I. INTRODUCTION

On June 4, 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. 10,601,566 (Ex. 1001, the “’566 Patent”), challenging Claims 8-14 and 16 (the “Challenged Claims”). The Petition asserts that Claims 8-11, 13-14, and 16 are rendered obvious over U.S. Patent Application Publication No. 2019/0159191 A1 to Kim et al. (“Kim” or Ex. 1004), alone or in combination with U.S. Patent No. 10,951,350 to Gao (“Gao” or Ex. 1005) and Claim 12 is rendered obvious over (i) Kim, alone or in combination with Gao in view of 3GPP submission, “Long PUCCH Over Multiple Slots” (“R1-1710555” or “Ex. 1011”); or (ii) Kim, alone or in combination with Gao in view of U.S. Patent No. 10,873,435 (“Huang” or “Ex. 1016”). Pet. at 17-18. The Board should deny the Petition for at least the reasons described briefly below.

Petitioner fails to show that Kim discloses at least “receive uplink control information (UCI) with the frequency hopping for the configured multiple slots PUCCH,” as required by the Challenged Claims.

The Petition is deficient because it fails to apply the proper claim construction to “configured multiple slots PUCCH” that it had agreed to in the related District Court Litigation. As a result, the Petition lacks consistency and is obscure regarding which of Kim’s signaling(s) are responsible for determining the “uplink control

channel (PUCCH) span[ning] over multiple slots,” as recited by Claim Element [8.2] (*i.e.*, the same “configured multiple slots PUCCH” of Claim Element [8.3]), and contravenes the stated goal of efficiency in the ’566 Patent.

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 ’566 Patent) with substantially the same claims; (iii) the District Court’s trial will be *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 ’566 PATENT

The ’566 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).” ’566 Patent, 1:16-20.

As the ’566 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.

As further disclosed by the '566 Patent, communication flexibility, and efficiency is provided by this claim limitation in ensuring that the configured multiple slot PUCCH is determined (both in terms of its slot structure and frequency hopping) by certain signaling:

The PUCCH resource configuration has a tradeoff between semi-static RRC signaling and dynamic DCI indication. In general, the PUCCH format/structure should be configured by RRC signaling, and the actual PUCCH resource to be used for UCI reporting should be determined by explicit DCI indication.

Id., 26:32-37.

III. THE ALLEGED PRIOR ART

A. Kim

Kim “relates to a wireless communication system, and more particularly, to

methods of transmitting and receiving uplink signals between a terminal and a base station in a wireless communication system and devices for supporting the same. Specifically, the following disclosure relates to methods of transmitting and receiving signals between a terminal and a base station for coexistence of terminals to which different Transmission Time Intervals (TTIs) are applied when the terminals to which the different TTIs are applied transmit uplink signals on the same resource.” Ex. 1004, [0001]-[0002].

Kim discloses RRC signaling and/or first layer signaling for determining the number of slots for a long PUCCH:

The number of slots where a long PUCCH (PUSCH or PDSCH) is transmitted and indices thereof can be determined by RRC signaling, first layer (*e.g.*, PHY, L1) signaling, or a combination thereof.

Id., [0244].

Kim discloses separate, and possibly uncorrelated, signaling(s) for determining the frequency hopping aspect of a long PUCCH, namely “DCI or higher layer signaling”:

Additionally, information about a time when frequency hopping is applied to such a long PUCCH and/or information about a frequency hopping interval may be configured/indicated via DCI or higher layer signaling. In this case, the frequency hopping may be hopping in a single TTI (or slot), inter-TTI (or inter-slot) hopping as shown in FIG. 14, or hopping every several slots (for example, hopping may be performed every two slots).

Id., [0235].

In addition, time/frequency resource candidate where UCI will be actually transmitted may be defined per format by higher layer signaling, and the locations of the resources that will be actually used among the UCI resources may be dynamically indicated by the DCI that schedule multiple TTIs.

Id., [0287].

IV. PETITIONER IMPROPERLY FAILS TO IDENTIFY HOW THE CHALLENGED CLAIMS ARE TO BE CONSTRUED

Petitioner’s assertion that “each claim term be given its plain and ordinary meaning” in this proceeding (Pet. at 11) contradicts its positions in *Active Wireless Techs. LLC v. T-Mobile USA, Inc.*, No. 2:23-cv-00261-JRG-RSP (E.D. Tex.) (the “District Court Litigation”). In the District Court Litigation, Petitioner proposed the following terms (on May 23, 2024, two weeks *prior* to filing its Petition) for claim construction beyond the plain and ordinary meaning, proposed constructions based on antecedent basis (about three weeks after filing its Petition), resulting in agreed constructions between the parties:

Claim Term	Claims	Petitioner’s Proposed District Court Construction	Agreed District Court Construction
“the configured multiple slots PUCCH”	Claims 8, 16	Indefinite under § 112(b) for lacking antecedent basis	The “PUCCH span[ning] over multiple slots [] determined based on the signaling”

Claim Term	Claims	Petitioner’s Proposed District Court Construction	Agreed District Court Construction
“the long PUCCH”	Claim 11	Refers back to “PUCCH spans over multiple slots” of Claim 8	“the ‘uplink control channel (PUCCH) [that] spans over multiple slots’”
“loaded to all to PUCCH UCI carrying symbols of each slot”	Claim 11	Fix typo: “loaded to all ~~to~~ PUCCH UCI carrying symbols of each slot”	“loaded to all PUCCH UCI carrying symbols of each slot”

Ex. 2003, at 2; Ex. 2004, at 5-6; Ex. 2005, at 2.

Outside of the obvious typographical error of “loaded to all to PUCCH UCI carrying symbols of each slot,” each of the other terms’ constructions are expressly limiting because they are each directed to antecedent basis, namely, limiting the term to its previous mention in another claim limitation. The Petition does not assume that the plain and ordinary meaning of these terms is so limited, and the Petition’s analysis of the claim limitations containing these terms against the cited references does not indicate that those references disclose these limitations under Petitioner’s proposed constructions in the District Court Litigation.

If Petitioner believed that any claim terms required construction, it had a duty to identify “how the challenged claim is to be construed” in its Petition. 37 CFR. § 42.104(3); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide, at 48 (“The Board, in its claim construction determinations, will consider

statements regarding claim construction made by patent owners and by a petitioner filed in other proceedings, if the statements are timely made of record.”) (citations omitted). Instead, Petitioner chose to apply the plain and ordinary meaning in this case, while simultaneously proposing narrower constructions in the District Court Litigation. Petitioner’s proposed constructions in the District Court Litigation should be applied in this proceeding.

For the purposes of this Preliminary Response, Patent Owner does not dispute that the agreed upon constructions in the District Court Litigation should be applied in this proceeding. As such, the District Court will almost certainly enter these agreed constructions. Patent Trial and Appeal Board Consolidated Trial Practice Guide, at 47 (citations omitted) (“Parties should submit a prior claim construction determination by a federal court or the ITC in an AIA proceeding as soon as that determination becomes available. Preferably, the prior claim construction determination should be submitted with the petition, preliminary response, or response, along with explanations. Submission of a prior claim construction determination is mandatory under 37 C.F.R. § 42.51(b), if it is ‘relevant information that is inconsistent with a position advanced by the party during the proceeding.’”).

The rationale for each of the claim terms with agreed upon constructions in the District Court Litigation is described below (except for “loaded to all to PUCCH UCI carrying symbols of each slot,” which has an evident typographical error):

A. “the configured multiple slots PUCCH”: “the ‘PUCCH span[ning] over multiple slots [] determined based on the signaling’”

The claim language of the ’566 Patent is clear that “the configured multiple slots PUCCH” refers to the reference of “multiple slots PUCCH” from the previous claim limitation. Each of these references in the claims is bolded below, which indicate that the only reasonable interpretation of “the configured multiple slots PUCCH” is “the ‘PUCCH span[ning] over multiple slots [] determined based on the signaling,” as used in Claims 8 and 16:

[T]ransmit, to a user equipment (UE), a signaling, ***an uplink control channel (PUCCH) spans over multiple slots being determined based on the signaling***; and

receiv[e]/[ing] uplink control information (UCI) with the frequency hopping for ***the configured multiple slots PUCCH***

’566 Patent, Claims 8 and 16 (emphasis added).

The specification also discloses that “[i]n NR, the long PUCCH format may span over multiple slots, and the PUCCH format of a UE may be ***configured*** by a base station,” supporting the understanding that the configured PUCCH refers to the same PUCCH that spans over multiple slots. *Id.*, 5:48-50 (emphasis added).

As noted above, in the District Court Litigation, Petitioner and Patent Owner agree with the aforementioned construction. Ex. 2005, at 2.

B. “the long PUCCH”: “the ‘uplink control channel (PUCCH) [that] spans over multiple slots’”

The claim language of the ’566 Patent is clear that “the long PUCCH” in Claim 11 refers to the reference of the “‘uplink control channel (PUCCH) [that] spans over multiple slots’” from Claim 8 because, outside of Claim 11, that is the first reference of the PUCCH in question.

Claim 8:

transmit, to a user equipment (UE), a signaling, *an uplink control channel (PUCCH) spans over multiple slots* being determined based on the signaling; and

Claim 11:

The gNB of claim 8, wherein UCI encoded bits are rate matched and loaded to all to PUCCH UCI carrying symbols of each slot of *the long PUCCH* separately.

’566 Patent, Claims 8, 11 (emphasis added).

The specification also supports the understanding that the long PUCCH is the PUCCH that spans multiple slots from Claim 8:

“In 5G NR, at least two different types of uplink control channel (PUCCH) formats may be specified: at least one short PUCCH format and one long PUCCH format. The PUCCH channel is designed to carry uplink control information (UCI). In NR, *the long PUCCH format may span over multiple slots.*”

Id., 5:44-49 (emphasis added).

“A short PUCCH format may consist of one or two symbols. *A long PUCCH format may span multiple symbols and slots.*”

Id., 9:65-67 (emphasis added).

As noted above, in the District Court Litigation, Petitioner and Patent Owner agree with the aforementioned construction. Ex. 2005, at 2.

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 four 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 11-12 (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 Resch. 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 8 Is Not Obvious Over Kim, Alone or in Combination with Gao

1. The Petition Does Not Show that Kim Discloses “receive uplink control information (UCI) with the frequency hopping for the configured multiple slots PUCCH,” as Required by Claim Element [8.3]

Claim 8 of the ’566 Patent requires “receive uplink control information (UCI) with the frequency hopping for the configured multiple slots PUCCH.” As a preliminary matter, the Petition only relies on Kim to disclose this claim limitation. *See* Pet. at 31-33.

The Petition is deficient because it fails to show how Kim or Gao disclose the required base station receiving UCI with frequency hopping “*for the configured multiple slots PUCCH*.” Specifically, the Petition is deficient because the Petitioner inconsistently maps different disclosures in Kim to claim elements [8.2] and [8.3]. For claim element [8.2], the Petition relies on Kim’s RRC and/or first layer signaling for the claimed “signaling,” while for claim element [8.3], the Petition relies on Kim’s disclosure of DCI or higher layer signaling for the claimed “signaling,” which is not necessarily the same as RRC and/or first layer signaling. The Petition fails to explain how the different teachings meet the same “signaling” claim limitation.

As noted above, Petitioner failed to propose a construction for “configured multiple slots PUCCH” in this claim limitation, despite agreeing to construe this

term as “the ‘PUCCH span[ning] over multiple slots [] determined based on the signaling’” in the District Court Litigation. *See supra* Section IV. To disclose that particular claim term in the previous claim limitation, “transmit, to a user equipment (UE), a signaling, an uplink control channel (PUCCH) spans over multiple slots being determined based on the signaling,” the Petition relies on Kim’s disclosure of RRC signaling and/or first layer signaling for determining the number of slots for a long PUCCH:

The number of slots where a long PUCCH (PUSCH or PDSCH) is transmitted and indices thereof can be determined by RRC signaling, first layer (e.g., PHY, L1) signaling, or a combination thereof.

Pet. at 31 (citing Ex. 1004, [0242], [0244], [0245]).

With respect to Claim Element [8.3], the Petition is deficient because it makes no reference to the PUCCH spanning multiple slots determined based on the signaling relied upon in Claim Element [8.2], namely, the RRC and/or first layer signaling. Rather, the Petition points to a separate, and possibly uncorrelated, signaling(s) for determining the frequency hopping aspect of the multiple slot PUCCH, namely “DCI or higher layer signaling”:

Additionally, information about a time when frequency hopping is applied to such a long PUCCH and/or information about a frequency hopping interval may be configured/indicated via DCI or higher layer signaling.
In this case, the frequency hopping may be hopping in a single TTI (or slot), inter-TTI (or inter-slot) hopping as

shown in FIG. 14, or hopping every several slots (for example, hopping may be performed every two slots).

Pet. at 32 (citing Ex. 1004, [0235]).

[i]n addition, *time/frequency resource candidate where UCI will be actually transmitted may be defined per format by higher layer signaling*, and the locations of the resources that will be actually used among the UCI resources may be dynamically indicated by the DCI that schedule multiple TTIs.

Id. at 32-33 (citing Ex. 1004, [0287]).

As the '566 Patent explains, its objective is the invention of “systems and methods that improve communication flexibility and/or efficiency [that] may be beneficial.” '566 Patent, 1:43-45. As further disclosed by the '566 Patent, communication flexibility and efficiency is provided by this claim limitation in ensuring that the configured multiple slot PUCCH is determined (both in terms of its slot structure and frequency hopping) by certain signaling. *Id.*, 26:32-37 (“The PUCCH resource configuration has a tradeoff between semi-static RRC signaling and dynamic DCI indication. In general, the PUCCH format/structure should be configured by RRC signaling, and the actual PUCCH resource to be used for UCI reporting should be determined by explicit DCI indication.”).

Therefore, the Petition inconsistently maps which of Kim’s signaling(s) are responsible for determining the “uplink control channel (PUCCH) span[ning] over multiple slots,” as recited by Claim Element [8.2] (*i.e.*, the same “configured

multiple slots PUCCH” of Claim Element [8.3]), contravenes the stated goal of the ’566 Patent (and this claim limitation) and thus renders the Petition deficient.

Because of this deficiency, institution should be denied.

B. Claims 9-14 and 16 Are Not Obvious Over Petitioner’s Ground 1, Ground 2, or Ground 3 Combinations

Claims 9-11 and 13-14 depend upon Claim 8. For at least the same reasons as Claim 8, Kim, alone or in combination with Gao, fails to render obvious Claims 9-11 and 13-14.

Claim 12 depends upon Claim 8. For at least the same reasons as Claim 8, both the Ground 2 combination of Kim, alone or in combination with Gao in view of R1-1710555, and the Ground 3 combination of Kim, alone or in combination with Gao in view of Huang, fail to render obvious Claim 12.

Claim 16 recites “a method by a base station,” which is the method claim analogue of Claim 8. For at least the same reasons as Claim 8, Kim, alone or in combination with Gao, fails to render obvious Claim 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 December 17, 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 '566 Patent). Pet. at 70. 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 '566 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 17, 2025.¹ As the District Court’s trial will be

¹ The statutory deadline for institution is December 17, 2024, “three months after receiving a preliminary response to the petition under section 313.” *See* 35 U.S.C.

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. 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.”).

§ 314(b)(1). If instituted, the statutory deadline for Final Written Decision is December 17, 2025, “not later than 1 year after the date on which the Director notices the institution of a review.”

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 is 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 5 out of at least 11 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 14-16, 23, 26, 31-34, 60-83, 90, 92-93. *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 66-69.

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 '566 Patent against T-Mobile USA, Inc. and T-Mobile US, Inc. (May 31, 2023) over a

year before this Petition (June 4, 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 5,300 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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CERTIFICATE OF SERVICE

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