

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. 10,785,764
Filing Date: August 10, 2017
Issue Date: September 22, 2020

Inventors: Chongming Zhang, Renmao Liu,
and Shohei Yamada

Title: INFORMATION CHANGE TRANSMISSION METHOD AND DEVICE
FOR SINGLE-CELL MULTICAST SERVICE

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2024-00986

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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.), 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

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. 10,785,764 (Ex. 1001, the “’764 Patent”), challenging Claims 3, 4, and 6 (the “Challenged Claims”). The Petition asserts that Claims 3, 4, and 6 are rendered obvious over (i) United States Patent No. 11,160,094 to Shin et al. (“Shin” or Ex. 1005) or (ii) United States Patent No. 10,785,752 to Xu et al. (“Xu” or Ex. 1006) in view of 3GPP TS-36.212 v.13.2.0 (“Ex. 1007”), TS-36.213 v.13.2.0 (“Ex. 1008”), and TS-36.331 v.13.2.0 (“Ex. 1009”) (collectively “RAN72”), and U.S. Patent Publication No. 2019/0182632 to Fujishiro et al. (“Fujishiro” or “Ex. 1011”). Pet. at 13-16. The Board should deny the Petition for at least the reasons described briefly below.

The Petition fails to show how Ground 1 (Shin alone) discloses at least “the transmitting circuitry is configured to transmit, in more than one second subframe, the second DCI format carried on a second narrowband physical downlink control channel (NPDCCH),” “the transmitting circuitry is configured to transmit, in more than one first subframe, the first DCI format carried on a first NPDDCH,” “a period of the more than one first subframe is different from a period of the more than one second subframe,” and “the transmitting circuitry is configured to transmit the another SC-MCCH information with use of the resource indicated by the first DCI

format and in accordance with the second DCI format,” as required by the Challenged Claims. First, the Petition fails to show that its cited disclosures from Shin are related specifically to the transmission of the SC-MCCH information change notification. Second, the Petition fails to show that its cited disclosures from Shin are related specifically to the transmission of a “resource for a transmission of another SC-MCCH information.” Third, as with the previous claim limitation, the Petition relies on the conclusory assumption that, because Shin discloses limited bandwidth to a single PRB, it would be necessary to (i) have multiple subframes for the first DCI; and (ii) send the period of the more than one first subframe and more than one second subframe in different subframes. Fourth, the Petition’s only other citation to Shin teaches away from the claimed invention because it only describes a singular subframe corresponding to each of the MCCH changing notification and MCCH control rather than the claimed more than one first subframe and more than one second subframe. Fifth, the embodiment of Shin cited by the Petition (where “the data region, which contains SC-MCCH information carried on a PDSCH, immediately follows (and is thus indicated by) a control region which contains the first DCI format carried on a PDCCH”) contradicts the explicit language of Claim 3. Sixth, there is no teaching, suggestion, or motivation that Shin’s change notification is related to the separate embodiment in Shin that the Petition incorrectly alleges corresponds to the resource indicated by the first DCI format described

above.

The Petition also fails to show how Ground 2 (Xu, alone or in view of RAN72 and Fujishiro) discloses at least “generating circuitry configured to generate a second downlink control information (DCI) format indicating an SC-MCCH information change notification, wherein,” “the transmitting circuitry is configured to transmit, in more than one second subframe, the second DCI format carried on a second narrowband physical downlink control channel (NPDCCH),” “the generating circuitry configured to generate a first DCI format indicating a resource for a transmission of another SC-MCCH information,” “the transmitting circuitry is configured to transmit, in more than one first subframe, the first DCI format carried on a first NPDDCH,” “a period of the more than one first subframe is different from a period of the more than one second subframe,” and “the transmitting circuitry is configured to transmit the another SC-MCCH information with use of the resource indicated by the first DCI format and in accordance with the second DCI format,” as required by the Challenged Claims. First, the Petition is deficient because there is no sufficient motivation to combine conflicting embodiments between Xu and either RAN72 or Fujishiro. Specifically, the Petition does not articulate a motivation to combine an NB-IoT reference (Fujishiro) with a non-NB-IoT reference (Xu) and the cited embodiments of Xu and Fujishiro, which each allegedly describe different DCI formats, cannot collectively disclose the singular second DCI format. Second, as the

Petition admits, RAN72 is directed to non-NB-IoT and discloses “transmitting the SC-MCCH change notification in the same subframe as the updated SC-MCCH information,” contradicting the claim limitation. The ’764 Patent cannot be improperly used to fill in the deficiency of RAN72. Third, the Petition fails to disclose either of its alleged DCI formats (N1 or N2) in the combination of Xu, RAN72, and Fujishiro as applied together to the claimed SC-MCCH information.

The Board should deny institution on Ground 2 because Fujishiro and the ’764 Patent have the same effective filing date. Therefore, Fujishiro cannot be used as prior art to the ’764 Patent under 35 U.S.C. §102(a)(2), and Ground 2 should be denied.

The Board should exercise its discretion to deny the Petition under 35 U.S.C. § 325(d) because the Examiner’s consideration of Fujishiro and the corresponding arguments during prosecution precludes the Petition from being granted institution on Ground 2. Fujishiro is the same art relied on for the same arguments with respect to the recited “second DCI format” transmitted over the “more than one second subframe.”

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 ’764 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 ’764 PATENT

The ’764 Patent “relates to the field of wireless communications technology. More specifically, the present invention relates to an information change transmission method and device for a single-cell multicast service.” ’764 Patent, 1:6-10.

The ’764 Patent describes that its disclosed NB-IoT system “does not support transmitting a change indication and scheduling a new SC-MCCH information transmission in the same subframe” and does not mention physical resource blocks (PRBs):

However, in the NB-IoT system, in order to reduce costs, the system based on a narrowband design does not support transmitting a change indication and scheduling a new SC-MCCH information transmission in the same subframe. Therefore, when the SC-PTM feature is introduced for the NB-IoT system, a new change notification mechanism is needed for the NB-IoT system.

Id., 2:34-40.

The ’764 Patent states that “multicast transmission in the NB-IoT system is to be implemented on the basis of the features of the existing version 13 LTE SC-

PTM.” *Id.*, 1:47-50. In other words, the ’764 Patent describes that it uses existing version 13 LTE SC-PTM as a baseline, not that there was a motivation to combine LTE SC-PTM systems with NB-IoT systems beyond the methodology implemented by the ’764 Patent.

III. THE ALLEGED PRIOR ART

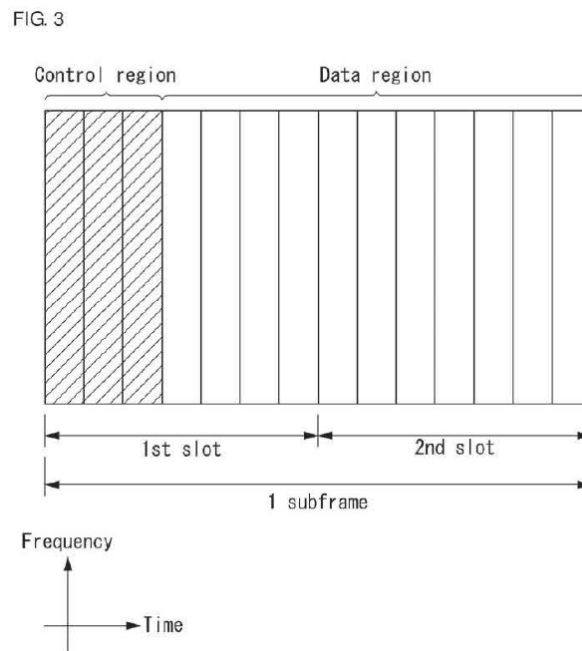
A. Shin

Shin “relates to a wireless communication system supporting NarrowBand-Internet of Things (NB-IoT) and more specifically, a method for transmitting/receiving data with respect to multicast and/or broadcast transmission and a device supporting the method.” Ex. 1005, 1:35-31.

Shin generally discloses, without much detail: (i) detecting NPDCCH with DCI Format N1 or N2 (*Id.*, 20:49-59, 26:24-25, 18:58-64); (ii) “DCI corresponding to a NPDCCH order [] carried by NPDCCH” (*Id.*, 25:41-43); (iii) “the same SC-MCCH information may be transmitted a number of times” (*Id.*, 25:40-50); and (iv) “MCCH control information is transmitted with multiple PRBs” (*Id.*, 45:18-27).

Shin teaches only a singular subframe corresponding to each of the MCCH changing notification and MCCH control. *Id.*, 42:37-46 (“the MCCH change notification is transmitted once over a very long time period and is transmitted from a subframe different from a subframe to which control information of the MCCH (i.e., DCI of the MCCH) is transmitted.”).

Shin also discloses an embodiment where the data region contains SC-MCCH information carried on a PDSCH and follows a control region. *Id.*, 32:59-63, 9:45-64, FIG. 3. For example, FIG. 3 of Shin shows that the control region, which spans only 3 symbols of the 1st slot, which is less than one subframe:



Id., FIG. 3.

Shin simply discloses that “[u]pon receiving the change notification, a UE attempting to receive an MBMS service transmitted using SC-PtM may acquire new SC-MCCH information.” *Id.*, 15:58-61.

B. Xu

Xu “relates to the field of communications. And particularly to a resource configuration method, system and device for an SC-MCCH.” Ex. 1006, 1:8-10.

Xu's only disclosure of a DCI format relating to an SC-MCCH information change notification describes that "DCI format-1c may be adopted" for a SC-MCCH change notification information:

Specifically, when an SC-MCCH change notification information is borne on the DCI in the PDCCH of the time-domain subframe, DCI format-1c may be adopted.

Id., 16:51-53.

Specifically, the SC-MCCH change notification information may be borne on the DCI in the PDCCH of the time-domain subframe. The DCI format-1c may be adopted.

Id., 18:45-47.

Xu is silent on this issue of NB-IoT communications and does not expressly disclose SC-MCCH in NB-IoT.

C. RAN72

RAN72 is a combination of 3rd Generation Partnership Project (3GPP) technical specifications ("TS"): 36.212, 36.213, and 36.331. 3GPP TS 36.212 v.13.2.0 ("TS-36.212") "specifies the coding, multiplexing and mapping to physical channels for E-UTRA." Ex. 1007, Scope. 3GPP TS 36.213 v.13.2.0 ("TS-36.213") "specifies and establishes the characteristics of the physicals layer procedures in the FDD and TDD modes of E-UTRA." Ex. 1008, Scope. 3GPP TS 36.331 v.13.2.0 ("TS-36.331") "specifies the Radio Resource Control protocol for the radio interface

between UE and E-UTRAN as well as for the radio interface between RN and E-UTRAN.” Ex. 1009, Scope.

RAN72 discloses that “DCI format N1 is used for the scheduling of one NPDSCH codeword in one cell...” but is otherwise silent regarding disclosing whether or not a DCI format used for scheduling an NPDSCH codeword necessarily implies that the same DCI format corresponds to using SC-RNTI for transmitting SC-MCCH. Ex. 1007, Section 6.4.3.2.

Portions of RAN72 are directed to non-NB-IoT and discloses “transmitting the SC-MCCH change notification in the same subframe as the updated SC-MCCH information.” Ex. 1009, Section 5.8.a.1.3.

D. Fujishiro

Fujishiro “relates to a user equipment and a base station for a mobile communication system.” Ex. 1011, [0001]-[0002].

Fujishiro discloses that “[t]he update notification information (Direct Indication) may use an existing format or may define a new format” but does not disclose any specific DCI format for that functionality. *Id.*, ¶ 102. Fujishiro also discloses using SC-RNTI for transmitting SC-MCCH. *Id.*, ¶ 94. As described below, Fujishiro is not technical prior art to the ’764 Patent under 35 U.S.C. §102(a)(2) and was otherwise considered for substantially the same reasons as the Petition during the prosecution of the ’764 Patent. *See infra* Sections VII-VIII.

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

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 7.

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 7-8 (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 Shin

1. The Petition Does Not Show that Shin Discloses “*the transmitting circuitry is configured to transmit, in more than one second subframe, the second DCI format carried on a second narrowband physical downlink control channel (NPDCCH)*,” as Required by Claim Element [3.3]

Claim 3 of the '764 Patent requires “the transmitting circuitry is configured to transmit, in more than one second subframe, the second DCI format carried on a second narrowband physical downlink control channel (NPDCCH).”

The Petition is deficient because it fails to show that Shin discloses “transmit, in more than one second subframe, *the second DCI format* carried on a second narrowband physical downlink control channel.” The claimed “second DCI format” has its antecedent basis from the previous claim limitation, which recites “a second downlink control information (DCI) format indicating an SC-MCCH information change notification.” *See* '764 Patent, Claim 3. However, the Petition fails to show that its cited disclosures from Shin are related specifically to the transmission of the SC-MCCH information change notification. Instead, the cited disclosures of Shin only generally disclose detected NPDCCH with DCI Format N1 or N2. *See* Pet. at 26-27 (citing Ex. 1005, 20:49-54,¹ 26:24-25, 18:58-64). Merely disclosing available

¹ The Petition erroneously cites this portion of Shin for disclosing DCI Format N1 or N2, while it actually discloses DCI Format N0.

formats (*e.g.*, N1 or N2) for the purposes of showing “the second DCI format carried on a second narrowband physical downlink control channel” does not meet the antecedent basis requirement that such a format was *also* used for the “second downlink control information (DCI) format indicating an SC-MCCH information change notification” of Claim Element [3.2].

Because of this deficiency, institution should be denied.

2. The Petition Does Not Show that Shin Discloses “*the transmitting circuitry is configured to transmit, in more than one first subframe, the first DCI format carried on a first NPDDCH,*”² as Required by Claim Element [3.5]

Claim 3 of the ’764 Patent requires “the transmitting circuitry is configured to transmit, in more than one second subframe, the second DCI format carried on a second narrowband physical downlink control channel (NPDCCH).”

The Petition is deficient because it fails to show that Shin discloses “transmit, in more than one first subframe, *the first DCI format* carried on a first NPDCCH.” The claimed “second DCI format” has its antecedent basis from the previous claim limitation, which recites “a first DCI format indicating a resource for a transmission of another SC-MCCH information.” *See* ’764 Patent, Claim 3. However, the Petition

² Patent Owner agrees with Petitioner that the recited “NPDDCH” is a typographical error and meant to be “NPDCCH.”

fails to show that its cited disclosures from Shin are related specifically to the transmission of a “resource for a transmission of another SC-MCCH information.” The recitation of “another SC-MCCH information” evidently refers to information other than the previously recited “SC-MCCH information change notification.”

Instead, the cited disclosures of Shin are generically related to the “DCI corresponding to a NPDCCH order [] carried by NPDCCH” (Pet. at 30 (citing Ex. 1005, 25:41-43)), that “the same SC-MCCH information may be transmitted a number of times” (Pet. at 30 (citing Ex. 1005, 25:40-50)), or that “MCCH control information is transmitted with multiple PRBs” (Pet. at 31 (citing Ex. 1005, 45:18-27)).

Additionally, the Petition provides no support for its conclusory statement that “[a] POSITA therefore understood that multiple PRBs *would necessarily correspond* to multiple subframes,” outside its expert declaration, which is equally conclusory:

Petition

The entire system bandwidth for an NB-IoT system is limited to one PRB. EX-1004, 31; EX-1003 ¶138. A POSITA therefore understood that multiple PRBs would necessarily correspond to multiple subframes. EX-1003 ¶138.

Dr. Mahon Declaration

138. As Shin explains, in an NB-IoT system, the entire system bandwidth is limited to one PRB. EX-1004 (Shin 393), pg. 31 (“Narrowband (NB)-LTE is a system for supporting low complexity, low power consumption with a system BW equivalent to 1 PRB of LTE system.”); EX-1005 (Shin 0940), 26:26-29. Given this disclosure, a POSITA would have understood that multiple PRBs would necessarily correspond to multiple subframes.

Pet. at 31 (citing Ex 1003, ¶ 138) (emphasis added). Petitioner’s conclusory argument amounts to an inherency argument without an explanation of why the element is necessarily present. Without further explanation, the Petition and the accompanying expert report conjure up a mere possibility of an undisclosed outcome from a given set of circumstances. *LBT IP I LLC v. Apple Inc.*, No. 2022-1613, 2023 WL 3914920, at *3 (Fed. Cir. June 9, 2023) (finding that an obviousness argument based on a skilled artisan’s understanding of necessary presence of an element not explicitly disclosed in the references must meet the standard for inherency, and rejecting expert testimony that fails to explain why the claim limitation is necessarily present). Petitioner’s failure to explain why this limitation is necessarily present, as required by the Federal Circuit, must prevent the Board from determining a reasonable likelihood of success on the merits, and therefore must be fatal to the Petition.

Because of these deficiencies, institution should be denied.

3. The Petition Does Not Show that Shin Discloses “a period of the more than one first subframe is different from a period of the more than one second subframe,” as Required by Claim Element [3.6]

Claim 3 of the ’764 Patent requires “a period of the more than one first subframe is different from a period of the more than one second subframe.”

First, as with the previous claim limitation, the Petition relies on the conclusory assumption that, because Shin discloses limited bandwidth to a single PRB, it would be necessary to (i) have multiple subframes for the first DCI; and (ii) send the period of the more than one first subframe and more than one second subframe in different subframes. *See* Pet. at 31. In view of the Petition's and Petitioner's expert's lack of any evidence, the Petition is deficient. Similarly, the Petition's reliance on the '764 Patent's statement of the problem it aims to address (*i.e.*, a narrowband design does not support transmitting a change indication and scheduling a new SC-MCCH information transmission in the same subframe) is misplaced because, as with the entirety of the '764 Patent specification, it does not mention PRBs at all. Pet. at 31-32 (citing '764 Patent , 2:34-40); *see generally* '764 Patent. Moreover, it is improper for the Petition to rely on the '764 Patent itself for the claim limitation it seeks to obviate, namely that the period of the more than one first subframe and the period of the more than one second subframe are mutually exclusive.

Second, the Petition's only other citation to Shin teaches away from the claimed invention because it only describes a singular subframe corresponding to each of the MCCH changing notification and MCCH control rather than the claimed more than one first subframe and more than one second subframe. *See* Pet. at 32 (citing Ex. 1005, 42:37-46) ("the MCCH change notification is transmitted once

over a very long time period and is transmitted from a subframe different from a subframe to which control information of the MCCH (i.e. DCI of the MCCH) is transmitted).”).

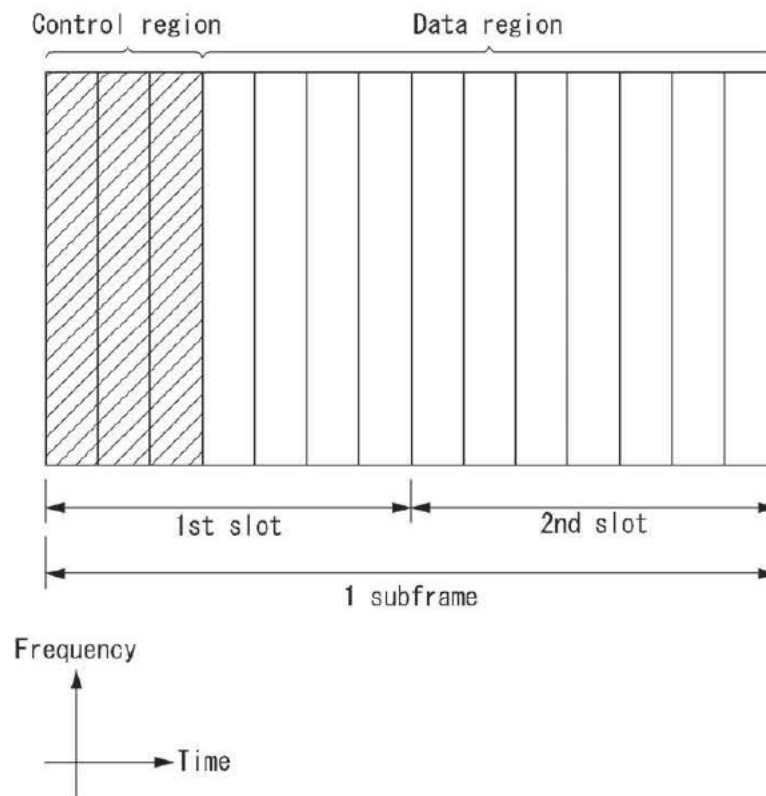
Because of this deficiency, institution should be denied.

4. The Petition Does Not Show that Shin Discloses “the transmitting circuitry is configured to transmit the another SC-MCCH information with use of the resource indicated by the first DCI format and in accordance with the second DCI format,” as Required by Claim Element [3.7]

Claim 3 of the ’764 Patent requires “the transmitting circuitry is configured to transmit the another SC-MCCH information with use of the resource indicated by the first DCI format and in accordance with the second DCI format.”

First, the embodiment of Shin cited by the Petition (where “the data region, which contains SC-MCCH information carried on a PDSCH, immediately follows (and is thus indicated by) a control region which contains the first DCI format carried on a PDCCH”) contradicts the explicit language of Claim 3. Pet. at 33-34 (citing Ex. 1005, 32:59-63, 9:45-64, FIG. 3). For example, the cited disclosure of Shin in FIG. 3 shows that the control region, which the Petition alleges is the claimed first DCI format, spans only 3 symbols of the 1st slot, which is less than one subframe:

FIG. 3



Ex. 1005, FIG. 3. Claim 3 recites that “the transmitting circuitry is configured to transmit, in *more than one* second subframe, the second DCI format.” ’764 Patent, Claim 3 (emphasis added).

Second, the Petition fails to disclose “SC-MCCH information with use of the resource indicated by the first DCI format *and* in accordance with the second DCI format.” The Petition merely makes a conclusory statement that “Shin further discloses that upon receiving a SC-MCCH change notification, updated SC-MCCH information is acquired” that allegedly shows the claimed “second DCI format” without tethering such an embodiment in Shin to the claimed “resource indicated by

the first DCI format.” For example, the portion of Shin cited by the Petition simply describes that “[u]pon receiving the change notification, a UE attempting to receive an MBMS service transmitted using SC-PtM may acquire new SC-MCCH information.” Pet. at 34 (citing Ex. 1005, 15:58-61). There is no teaching, suggestion, or motivation that such a change notification is related to the separate embodiment in Shin that the Petition incorrectly alleges corresponds to the resource indicated by the first DCI format described above.

Because of these deficiencies, institution should be denied.

B. Ground 2: Claim 3 Is Not Obvious Over Xu, Alone or in View of RAN72 and Fujishiro

- 1. There Is No Motivation to Combine Xu with either RAN72 or Fujishiro and the Combination Otherwise Does Not Disclose “*generating circuitry configured to generate a second downlink control information (DCI) format indicating an SC-MCCH information change notification, wherein,*” as Required by Claim Element [3.2], or “*the transmitting circuitry is configured to transmit, in more than one second subframe, the second DCI format carried on a second narrowband physical downlink control channel (NPDCCH),*” as Required by Claim Element [3.3]**

Claim 3 of the ’764 Patent requires “generating circuitry configured to generate a second downlink control information (DCI) format indicating an SC-MCCH information change notification, wherein” and “the transmitting circuitry is configured to transmit, in more than one second subframe, the second DCI format

carried on a second narrowband physical downlink control channel (NPDCCH).”

The Petition is deficient because there is no sufficient motivation to combine conflicting embodiments between Xu and either RAN72 or Fujishiro. For example, Xu’s only disclosure of a DCI format relating to an SC-MCCH information change notification describes that “DCI format-1c may be adopted” for a SC-MCCH change notification information:

Specifically, when an SC-MCCH change notification information is borne on the DCI in the PDCCH of the time-domain subframe, DCI format-1c may be adopted.

Ex. 1006, 16:51-53.

Specifically, the SC-MCCH change notification information may be borne on the DCI in the PDCCH of the time-domain subframe. The DCI format-1c may be adopted.

Id., 18:45-47. As the Petition admits, Xu “does not expressly state the DCI that is used to transmit the SC-MCCH,” and therefore it is unclear whether Xu discloses the recited “**second** DCI format,” as distinguished from the recited “first DCI format.” Pet. at 50. On the other hand, Fujishiro does not disclose **any** specific “second DCI format,” but only that “[t]he update notification information (Direct Indication) may use an existing format or may define a new format.” Pet. at 52 (citing Ex. 1011, ¶ 102). The Petition compensates for Fujishiro’s deficiency by citing to RAN 72, which itself is a combination of 3 different references, with no articulated

motivation combine in the Petition. *See* Pet. at 45-47. RAN 72 discloses that “DCI format N2 is used for for [sic] paging and direct indication.” DCI format N2 is a completely different DCI format than what Xu discloses (*i.e.*, DCI format-1c) and there is no articulated motivation to combine references that disclose systems that allegedly utilize two different DCI formats for the recited “second DCI format.” *See* Pet. at 45-47, 49-55.

Moreover, the Petition admits that “Xu is silent on this issue [of NB-IoT communications]” and “Xu does not expressly disclose SC-MCCH in NB-IoT” but “Fujishiro does.” Pet. at 47, 51. The Petition fails to articulate an appropriate motivation to combine disclosures directed to SC-MCCH in NB-IoT applications versus SC-MCCH in non-NB-IoT applications. *See* Pet. at 45-47. The Petition improperly supplies its motivation to combine Fujishiro and Xu with nothing other than the ’764 Patent specification:

As Xu does not disclose transmitting the services in an NB-IoT system, it would have been obvious to a POSITA to turn to look to Fujishiro for this purpose given the express mandate from the RAN#69 and #72 meetings.

Pet. at 46-47 (citing Ex. 1001, 1:25-50). However, there is no express mandate in the cited portion of the ’764 Patent. The ’764 Patent merely states that “multicast transmission in the NB-IoT system is to be implemented on the basis of the features of the existing version 13 LTE SC-PTM.” ’764 Patent, 1:47-50. In other words, the

'764 Patent describes that it uses existing version 13 LTE SC-PTM as a baseline, not that there was a motivation to combine LTE SC-PTM systems with NB-IoT systems beyond the methodology implemented by the '764 Patent. Therefore, the Petition fails to articulate a motivation to combine an existing NB-IoT (*e.g.*, Fujishiro) system with the existing version 13 LTE SC-PTM (*e.g.*, allegedly Xu) where the NB-IoT system has already considered (*i.e.*, combined) the necessary elements of 13 LTE SC-PTM as a part of the NB-IoT system.

Because of these deficiencies, institution should be denied.

2. **There Is No Motivation to Combine Xu with either RAN72 or Fujishiro and the Combination Otherwise Does Not Disclose “*the generating circuitry configured to generate a first DCI format indicating a resource for a transmission of another SC-MCCH information,*” as Required by Claim Element [3.4], or “*the transmitting circuitry is configured to transmit, in more than one first subframe, the first DCI format carried on a first NPDDCH,*” as Required by Claim Element [3.5]**

Claim 3 of the '764 Patent requires “the generating circuitry configured to generate a first DCI format indicating a resource for a transmission of another SC-MCCH information” and “the transmitting circuitry is configured to transmit, in more than one second subframe, the second DCI format carried on a second narrowband physical downlink control channel (NPDCCH).”

As described above, the Petition does not articulate a sufficient motivation to combine Xu, RAN72, and Fujishiro. *See supra* VI.B.2. Specifically, the Petition

does not articulate a motivation to combine an NB-IoT reference (Fujishiro) with a non-NB-IoT reference (Xu) and the cited embodiments of Xu and Fujishiro, which each allegedly describe different DCI formats, cannot collectively disclose the singular second DCI format. For the same reasons that the combination of Xu, RAN72, and Fujishiro do not disclose the second DCI format, the combination does not disclose the different claimed “first DCI format” in these claim limitations.

Even assuming the combination of Xu, RAN72, and Fujishiro, the Petition still fails to disclose claim limitations [3.4] and [3.5]. First, the Petition incorrectly alleges that Xu in view of RAN72 discloses the generation of the claimed “first DCI format.” However, the Petition’s only evidence is a listing of multiple DCI formats in TS-36.212. The mere disclosure of possible DCI formats is inapposite to generating a DCI format distinct from the DCI format disclosed in the previous claim limitations [3.2] and [3.3].

Second, the Petition relies on the addition of Fujishiro to the combination of Xu and RAN72 to allegedly disclose that the first DCI format must be N1, which is different than N2 (“the second DCI format”). However, the only basis for such a comment is Fujishiro’s disclosure of using SC-RNTI for transmitting SC-MCCH (Ex. 1011, ¶ 94) and the unrelated disclosure of RAN72 disclosing that “DCI format N1 is used for the scheduling of one NPDSCH codeword in one cell...” (Ex. 1007, Section 6.4.3.2). However, merely disclosing that a DCI format is used for

scheduling an NPDSCH codeword does not necessarily imply that the same DCI format corresponds to using SC-RNTI for transmitting SC-MCCH.

Third, the Petition does not describe any disclosure that indicates that the first DCI format is transmitted in more than one first *subframe*. Pet. at 58-59. Specifically, the Petition is silent about multiple subframes of particularly the first DCI format, which the Petition alleges is DCI format N1. *Id.*

Because of these deficiencies, institution should be denied.

3. The Petition Does Not Show that Xu, Alone or in View of RAN72 and Fujishiro, Discloses “a period of the more than one first subframe is different from a period of the more than one second subframe,” as Required by Claim Element [3.6]

Claim 3 of the '764 Patent requires “a period of the more than one first subframe is different from a period of the more than one second subframe.”

Because Xu, alone or in view of RAN72 and Fujishiro, fails to disclose “a more than one first subframe” of Claim Elements [3.4] and [3.5] and “a more than one second subframe” of Claim Elements [3.2] and [3.3], Xu, alone or in view of RAN72 and Fujishiro, cannot disclose the claimed “a period of *the more than one first subframe* is different from a period of *the more than one second subframe*.”

Further, as the Petition admits, RAN72 is directed to non-NB-IoT and discloses “transmitting the SC-MCCH change notification in the same subframe as the updated SC-MCCH information” (Pet. at 60-61 (citing Ex. 1009, Section

5.8.a.1.3)), contradicting the claim limitation. Absent any other reference to rectify this deficiency, the Petition improperly relies on the '764 Patent itself for its disclosure on why RAN72's same-subframe system would not work in an NB-IoT system. Pet. at 61 (citing '764 Patent, 2:34-40). However, the disclosure of the '764 Patent itself describing its rationale for developing the claimed invention cannot be supplied as the missing puzzle piece for the Petition's lacking combination, namely the disclosure that "DCI indicating an SC-MCCH change notification *must* be transmitted in a different subframe from the DCI indicating a resource for the updated SC-MCCH information." Pet. at 61. Aside from improper reliance on the subject patent, the Petition's entire rationale for why the '764 Patent supplies the necessary claim limitation is unsupported and its corresponding copy-cat expert declaration is similarly unsupported:

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Thus, in an NB-IoT system, DCI indicating an SC-MCCH change notification *must* be transmitted in a different subframe from the DCI indicating a resource for the updated SC-MCCH information. A POSITA would thus have understood that the subframes carrying the change notification and the subframes carrying the scheduling of a new SC-MCCH resource would need to be different. EX-1003 ¶206. It would thus have been obvious to a POSITA to turn to the solution disclosed by RAN72 for a MCCH change notification. EX-1003 ¶206. It would have been obvious for a POSITA to transmit the change notification (i.e. through DCI format N1) in a first set of subframes (i.e., a first modification period) and then transmit information indicating a resource for the SC-MCCH information (i.e. through DCI format N2) in a subsequent and distinct set of subframes (i.e., a second modification period). EX-1003 ¶206.

Dr. Mahon Declaration

206. Thus, in an NB-IoT system, DCI indicating an SC-MCCH change notification *must* be transmitted in a different subframe from the DCI indicating a resource for the updated SC-MCCH information. A POSITA would thus have understood that the subframes carrying the change notification and the subframes carrying the scheduling of a new SC-MCCH resource would need to be different. It would thus have been obvious to a POSITA to turn to the solution disclosed by RAN72 for a MCCH change notification. Based on this solution, it would have been obvious for a POSITA to transmit the change notification (i.e. through DCI format N1) in a first set of subframes (i.e., a first modification period) and then transmit information indicating a resource for the SC-MCCH information (i.e. through DCI format N2) in a subsequent and distinct set of subframes (i.e., a second modification period).

Id., at 61-62; Ex. 1003, ¶ 206.

Because of these deficiencies, institution should be denied.

4. The Petition Does Not Show that Shin Discloses “*the transmitting circuitry is configured to transmit the another SC-MCCH information with use of the resource indicated by the first DCI format and in accordance with the second DCI format,*” as Required by Claim Element [3.7]

Claim 3 of the '764 Patent requires “the transmitting circuitry is configured to transmit the another SC-MCCH information with use of the resource indicated by the first DCI format and in accordance with the second DCI format.”

Because Xu, alone or in view of RAN72 and Fujishiro, fails to disclose “the first DCI format” or “the second DCI format” of Claim Elements [3.2]-[3.5], Xu, alone or in view of RAN72 and Fujishiro, cannot disclose the claimed “the transmitting circuitry is configured to transmit the another SC-MCCH information with use of the resource indicated by the first DCI format and in accordance with the second DCI format.” As an example, the Petition fails to disclose either of its alleged DCI formats (N1 or N2) as applied together to the claimed SC-MCCH information. Pet. at 62-64. The Petition does not even mention the DCI formats it relies on. *Id.*

Because of these deficiencies, institution should be denied.

C. Claims 4 and 6 Are Not Obvious Over Petitioner's Ground 1 or Ground 2 Combinations

Claims 4 depends upon Claim 3. For at least the same reasons as Claim 3, the Petitioner's Ground 1 and Ground 2 combinations do not render obvious Claim 4.

Claim 6 recites "a method performed by a base station," which is the method claim analogue of Claim 3. For at least the same reasons as Claim 3, the Petitioner's Ground 1 and Ground 2 combinations do not render obvious Claim 16.

VII. GROUND 2 SHOULD BE DENIED BECAUSE FUJISHIRO IS NOT PRIOR ART UNDER 35 U.S.C. §102(A)(2)

The Petition incorrectly asserts that Fujishiro is prior art under 35 U.S.C. §102(a)(2), which requires that "the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention." However, Fujishiro does not have an effective filing date before the effective filing date of the claimed invention. The effective filing date of the claimed invention is August 11, 2016 China Standard Time (CST) based on Chinese Foreign Priority Application 2016 1 0658544. However, the effective filing date of Fujishiro is the same date by China Standard Time (CST). The Petition claims that Fujishiro "claims the benefit of U.S. Provisional Application No. 62/372,919

(Ex. 1010), filed on Aug. 10, 2016 (“Fujishiro 919”).” However, upon further scrutiny, the time stamp on Fujishiro 919 is “13:19:57”:

Electronic Acknowledgement Receipt	
EFS ID:	26601013
Application Number:	62372919
International Application Number:	
Confirmation Number:	9363
Title of Invention:	RADIO TERMINAL AND BASE STATION
First Named Inventor/Applicant Name:	Masato FUJISHIRO
Customer Number:	32968
Filer:	Kathleen Lynn Connell/tokiko kinoshita
Filer Authorized By:	Kathleen Lynn Connell
Attorney Docket Number:	16PD1405US00
Receipt Date:	10-AUG-2016
Filing Date:	
Time Stamp:	13:19:57
Application Type:	Provisional

Ex. 1010, 52. Therefore, Fujishiro 919 was filed at 1:19:57am CST on August 11, 2016 because CST is 12 hours ahead of Eastern Daylight Time (during the period from March to November, and otherwise 13 hours ahead). Therefore, both Fujishiro and the '764 Patent have the same effective filing date and Fujishiro cannot be used as prior art to the '764 Patent under 35 U.S.C. §102(a)(2), and Ground 2 should be denied.

VIII. THE PETITION SHOULD BE DENIED IN THE BOARD'S DISCRETION IN VIEW OF THE SAME PRIOR ART AND THE SAME ARGUMENTS PREVIOUSLY PRESENTED TO THE OFFICE DURING PROSECUTION

“In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, *the same or substantially the same prior art or arguments previously were presented to the Office.*” 35 U.S.C. § 325(d) (emphasis added); *Unified Pats. Inc. v. John L. Berman*, IPR2016-01571, Paper 10 (P.T.A.B. Dec. 14, 2016) (denying institution where the prior art cited in the petition was used in combination by the PTO in attempting to reject the underlying application); *Funai Elec. Co. v. Gold Charm Ltd.*, IPR2015-01491, Paper 18 (P.T.A.B. Feb. 18, 2016) (denying institution because the same prior art asserted in the petition was considered by the Examiner during prosecution against those claims); *Neil Ziegman, N.P.Z., Inc. v. Carlis G. Stephens*, IPR2015-01860, Paper 11 (P.T.A.B. Feb. 24, 2016) (exercising its discretion under § 325(d) to deny institution on the basis that the petition presented substantially the same or similar art or arguments as those previously presented during prosecution of the patent).

Petitioner's Ground 2 is based on a combination involving Fujishiro. During prosecution, the Examiner relied on Fujishiro because “Fujishiro discloses a method of SC-MCCH channel management in narrowband IoT.” Ex. 1002, 174. This is

precisely what the Petition uses Fujishiro for: “Although Xu does not expressly *disclose SC-MCCH in NB-IoT, Fujishiro does.*” Pet. at 51 (emphasis added).

The Petition’s reliance on Fujishiro is primarily in the context of Claim Element [3.2], disclosing the “second downlink control information (DCI) format,” which Claim Element [3.3] further recites is “transmit[ted] in more than one second subframe.” Specifically, the Petition relies on Fujishiro for its disclosure of “SC-MCCH [] transmitted in an SC-RNTI.” Pet. at 52, 57. This disclosure was discussed and distinguished from the claimed invention at length in patentee’s response to office action just prior to the Notice of Allowance, as displayed below:

Turning to Fujishiro, Fujishiro describes: The second update notification is an update notification of SC-MCCH (that is, SCPTM Configuration). The eNB 200 may transmit the second update notification to the UE 100 by the MPDCCH or the NPDCCH which is scrambled with an SC-N-RNTI. In response to the update notification information (Direct Indication) in the MPDCCH or NPDCCH including the
second update notification, the UE 100 can recognize the update of SC-MCCH. See paragraph [0104] of Fujishiro (emphases added by Applicant). Fujishiro further describes: When the second and third update notifications are not provided, the UE 100 receives the SC-MCCH every SC-MCCH modification boundary or every time the UE 100 receives the PDCCH scrambled with the SC-N-RNTI, and the UE 100 may then check whether or not the setting (SC-MTCH-Info) related to a TMGI of interest has been updated. See <i>id.</i>, at paragraph [0106] (emphases added by Applicant). According to the above paragraphs, Fig. 15A of Fujishiro depicts repetition of NPDCCH for SC-MCCH, and based on a common technical knowledge of 3GPP specification release 13, the NPDCCH scrambled with an SC-N-RNTI is considered as indicating both an update notification of SC-MCCH and a resource for the SC-MCCH in Fujishiro. That is, a timing of the update notification is same as a timing of the notification about the resource for the SCCH, and the timing corresponds to a timing of each of NPDCCH repeat transmissions. Thus, Fujishiro does not remedy the deficiencies of Shin as discussed above.

Ex. 1002, 213-214. Therefore, in this response to Office Action, the distinction made was between Fujishiro and “the more than one second subframe” of the second DCI

format, such that “the suggested combination of Shin and Fujishiro fails to disclose ‘a period of the more than one first subframe is different from a period of **the more than one second subframe** (emphasis added by Applicant).” *Id.* at 214.

The Board should find that the Examiner’s consideration of Fujishiro and the corresponding arguments in the aforementioned response to Office Action precludes the Petition from being granted institution on Ground 2 since Fujishiro is the same art relied on for the same arguments with respect to the recited “second DCI format” transmitted over the “more than one second subframe.”

IX. 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 '764 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 '764 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, 2025.³ As the District Court’s trial will be *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

³ 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. § 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.”

(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

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 2 out of at least 8 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, 22-23, 26, 29-30, 52-60, 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 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).

X. 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 ’764 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).

XI. CONCLUSION

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

Respectfully submitted,

Dated: September 17, 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 8,341 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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