

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,

Petitioner,

v.

S.M.R INNOVATIONS LTD and Y.M.R TECH LTD,

Patent Owners.

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IPR2024-01047

U.S. Patent 9,699,223

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PATENT OWNERS' PRELIMINARY RESPONSE

37 C.F.R. § 42.107(a)

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## PATENT OWNERS' EXHIBIT LIST

| Exhibit Number | Description                                                                                         |
|----------------|-----------------------------------------------------------------------------------------------------|
| 2001           | Second Amended Complaint, Civil Action No. 6:23-cv-479-ADA (W.D. Tex.)                              |
| 2002           | Notices of Deposition of Petitioner's Witnesses in Civil Action No. 6:23-cv-479-ADA (W.D. Tex.)     |
| 2003           | Notices of Deposition of Patent Owners' Witnesses in Civil Action No. 6:23-cv-479-ADA (W.D. Tex.)   |
| 2004           | Docket Sheet for Civil Action No. 6:23-cv-479-ADA (W.D. Tex.)                                       |
| 2005           | Patent Owners' Preliminary Infringement Contentions in Civil Action No. 6:23-cv-479-ADA (W.D. Tex.) |
| 2006           | Petitioner's Invalidity Contentions in Civil Action No. 6:23-cv-479-ADA (W.D. Tex.)                 |

|      |                                                                                    |
|------|------------------------------------------------------------------------------------|
| 2007 | Scheduling Order in Civil Action No. 6:23-cv-479-ADA (W.D. Tex.)                   |
| 2008 | Joint Claim Construction Statement in Civil Action No. 6:23-cv-479-ADA (W.D. Tex.) |

Plaintiffs S.M.R Innovations LTD and Y.M.R Tech LTD respectfully submit this Preliminary Response pursuant to 37 C.F.R. § 42.107(a).

## **I. Introduction**

S.M.R Innovations and Y.M.R Tech are wholly owned by Oded Shmueli and Benny Yehezkel, respectively, the inventors of the patents-in-suit. EX2001 [Second Amended Complaint], ¶¶2-3. Professor Shmueli received a Ph.D. in Applied Mathematics from Harvard University and is an Emeritus Professor of Computer Science at the Technion University in Israel. *Id.*, ¶8. He is an inventor of more than 55 U.S. patents and has held positions at leading research laboratories such as IBM Research, AT&T Bell Labs, and MCC. He has co-founded several start-up companies, including an artificial-intelligence company where he serves as Chief Scientist. *Id.*, ¶¶9-10. Mr. Yehezkel holds a degree in Computer Science from the Technion University and an MBA from the Tel Aviv University. He has held executive positions with various technology companies, including now serving as CEO of a company in the customer engagement and CX domain. *Id.*, ¶¶12-13.

The patents-in-suit trace back to a conversation between Professor Shmueli and Mr. Yehezkel in October 2000 born out of the widespread use of cellular phones juxtaposed with their limited capabilities. *Id.*, ¶14. The state of affairs regarding handheld devices was then notably primitive. Mobile communication

devices were emerging, but the idea of streaming media was still years away. Cellular phones could not accept streaming data or route a received stream to another electronic device. *Id.*, ¶15. As described in the patents-in-suit, Professor Shmueli and Mr. Yehezkel recognized that “it would be highly advantageous to provide the user with the ability to select a target device, based on the type of multimedia content, and furthermore to choose a device for play or storage of the content independently of the initially targeted or originating device.” *Id.*, ¶18. Using the solutions of the patents-in-suit, for example, someone can route a call directed to his or her smartphone to a nearby computer or watch that is wirelessly linked with the smartphone. As another illustration, someone can be prompted by, for example, a watch that there is an incoming call via an associated smartphone. *Id.*, ¶21.

The inventors attempted to discuss their inventions with Apple in 2006. After reaching out to Steve Jobs, the inventors spoke with the assistant to Apple’s then-Senior Vice President with responsibility for the iPod (Jon Rubinstein), who instructed them to send Mr. Rubinstein a presentation regarding their technology and pending patent application. *Id.*, ¶205. The inventors suggested to Mr. Rubinstein that they hold a discussion regarding the benefits their technology would provide to Apple. While they received an email from an Apple employee indicating that Apple had received the presentation, Apple did not respond with

any interest in licensing the inventors' technology. *Id.*

## **II. Definition of a Person of Ordinary Skill in the Art**

Patent Owners propose that a POSITA would have had a Bachelor's degree in Computer Science, Computer Engineering, Electrical Engineering, or a related field in computing technology, and at least two years' experience in wireless communication and mobile devices including multimedia streaming, or equivalent education, research, experience, and knowledge.

## **III. The Proposed Combinations Do Not Render the Challenged Claims Obvious**

### **A. Ground 1**

#### **1. Claim 1**

Petitioner's proposed combination fails at least because it does not teach or suggest the recitations of claim 1(b). Claim 1(b) recites "scanning said local wireless communication network using said mobile device to identify a plurality of devices, identified as compatible to handle said media content, said plurality of devices are wirelessly connected to said local wireless communication network and wirelessly announce an availability for accepting a routed media via said local wireless communication network."

This claim language was the subject of discussion during prosecution of the '223 patent. The Examiner at one point rejected the independent claims under 35 U.S.C. § 112, ¶2, providing the following explanation:

Claim 22 recites “scanning said local wireless communication network using said mobile device to identify a plurality of compatible devices which wirelessly announce an availability for accepting ***said media*** via said local wireless communication network”. According to the claim limitation, the compatible devices announce their availability to accept the said media (the media received by the mobile device). The compatible devices do not know the type of media the mobile device received and without knowing the type of media, how can a compatible device announced its availability to accept the said media. For example, if the mobile device received a video stream, a compatible device such as a fax machine can not announce that it is available to accept a video stream (said media). Specification discloses that the compatible devices announce their availability and the type of media they support. From the availability and media type information, the mobile device selects one or more compatible devices to reroute the received/said media (g. 10, Line 13-34, Pg. 11, Line 1-20). Therefore, the specification does not disclose that the compatible devices announce their availability to accept the ***said media*** (the media received by the mobile device). The claim contains subject matter that fails to comply with the written description requirement.

EX1002 at 187-88 [’223 Prosecution History, 2016-03-09 OA at 14-15].

In addressing the Examiner’s rejection, the inventors noted that the “Examiner stated that the specification discloses that the compatible devices announce their availability and the type of media they support and *that from the availability and media type information, the mobile device selects one or more*

*compatible devices to reroute the received/said media.*” EX1002 at 231 [’223 Prosecution History, 2016-06-09 Amendment at 9] (emphasis added). To address the rejection, the inventors amended the independent claims to recite that the plurality of devices connected to the local wireless communication network “announce an availability for accepting *a* routed media.” *Id.* at 231-32. In explaining the effect of the amendment, the inventors stated that, according to the amended claims, “[t]he identified devices announce that they are available to accept a routed media, not necessarily the media content received at the mobile device.” *Id.* at 232. This exchange between the Examiner and the inventors shows that they agreed that the mobile device selects one or more compatible devices based on the information announced over the local wireless communication network by the recited plurality of devices.

In the June 9, 2016, Office Action, the Examiner also rejected the independent claims as being anticipated by U.S. Patent Publication No. 2001/0005864 (“Mousseau”). EX1002, 190 [’223 Prosecution History, 2016-03-09 OA at 17]. In response, the inventors argued, *inter alia*, that Mousseau did not disclose claim 1(b). EX1002, 235 (“Furthermore, *Mousseau* teaches that the mobile device may search for a displayer device by interrogating, or querying devices, but not by scanning the WLAN to identify devices that announce their availability.”); *see also id.*, 237-38 (“Amended Claim 22 now clearly claims . . .

the distinct feature of scanning a wireless communication network by the mobile device receiving the streaming data for re-routing, to identify devices connected to the wireless network, are identified as capable to handle the routed media content, and that announce over the wireless local network that they are available to accept routed media.”).

In distinguishing Mousseau, the inventors stated that “*Mousseau* teaches that the mobile device may search for a displayer device by interrogating, or querying devices, but not by scanning the WLAN to identify devices that announce their availability.” EX1002, 235. The inventors went on to further explain how the independent claims were distinguishable from *Mousseau*: “In Mousseau the mobile device initiates a query and communicates with possible displayers to identify potential displayers to receive the forwarded attachment, in contrast to the method of the claimed invention, according to which ***devices announce their availability, and the mobile device scans the WLAN*** to identify those announcers.” EX1002, 236 (emphasis added).

For the same reasons discussed during prosecution regarding Mousseau, Petitioner’s proposed combination fails to account for claim 1(b): “said plurality of devices are wirelessly connected to said local wireless communication network and wirelessly announce an availability for accepting a routed media via said local wireless communication network.” Petitioner’s proposed combination relies solely

on the teaching of Zhang regarding claim 1(b). *See* Petition, 23-25.<sup>1</sup> The Petition states that “*Zhang*’s mobile device performs the following key steps:

- (1) Device discovery: The handheld device identifies the nearby helper servers.
- (2) Service query: The handheld device queries the identified helper servers to determine if they are capable of providing the helper service.
- (3) Request transfer: The handheld device selects a helper server and delegates the task to it.
- (4) Remote control: The helper server returns a remote control interface description to the handheld device.

Petition, 22 (citing *Zhang*, 3:44-56, 6:40-44). Petitioner relies on Zhang’s third step described above—“request transfer”—as teaching claim 1(b). Petition, 23.

In Zhang’s third step, as noted above, “[t]he handheld device selects a helper server and delegates the task to it.” Petition, 22 (quoting Zhang, 3:53-54). Zhang’s column 7, cited in the Petition, further describes the “request transfer” step. Zhang states that this involves the handheld device establishing a PPP connection with the

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<sup>1</sup> While Petitioner relies on Rofheart for the concept of locating multiple helper devices, it does not rely on Rofheart (or any other reference) for the claim language “said plurality of devices ... wirelessly announce an availability for accepting a routed media via said local wireless communication network.”

selected helper device 608 and “send[ing] its service request:

Once devices with requested helper services are located, *the handheld device can initiate the LAN Access Profile and establish a PPP connection with the helper device S608*. With the PPP connection in place, *the helper client can then connect to the helper server through TCP and send its service request*. The request may contain the following information for the server admission control: the MIME type of the user data, the requested service on the data (e.g. displaying, printing or storing), a flag indicating whether the actual data or a URL will follow, the length of the data in bytes, the expected duration of the service, and optionally, authentication information.

Zhang, 7:1-12 (emphasis added).

As the Petition describes, once the handheld device submits a service request to the selected helper device, the helper device responds to the service request:

“Specifically, in response to the service query [*sic*, “service request”], the helper ‘server makes the admission decision S648 and informs the client whether its service request can be granted right away, has to be queued[,], or is denied (e.g. not enough total resource on the server or authentication failure) S646.’” Petition, 23 (quoting Zhang, 7:22-25).

The Petition asserts that the helper device’s response to a service request satisfies the “announcing” claim language: “A POSITA would have understood and found obvious that the helper server responding with its availability to service the request meets the claimed, ‘wirelessly announce an availability for accepting a

routed media ...[.]” Petition, 24. As detailed below, this argument fails to teach claim 1(b) for the reasons discussed regarding Mousseau during prosecution.

First, as discussed above, the Examiner and the inventors agreed, claim 1(b) involves the mobile device scanning the local wireless communication network and selecting one or more compatible devices based on the announcing performed by the plurality of devices over the local area network. EX1002, 186, 236-38. In the teachings of Zhang relied on by Petitioner, however, the reverse occurs. Zhang’s handheld device *first* selects a helper device, and only afterward submits a service request to it, and only then does the helper device respond to the service request with information that Petitioner deems to constitute the recited “announcing.” This does not fit the claim language—Zhang’s device has selected the helper device *prior* to the helper device’s purported “announcing.” Thus, in Petitioner’s construct, selection precedes “announcing.” As discussed above, that is the opposite of how ’223 claim 1 operates, namely, “announcing” precedes selection.

This is confirmed by the inventors’ statements distinguishing Mousseau during prosecution. The inventors explained that Mousseau did not teach this claim language because “[i]n *Mousseau*, the mobile device initiates a query and communicates with possible displayers to identify potential displayers to receive the forwarded attachment.” EX1002, 236. This aspect of Mousseau is similar to

Zhang, where a mobile device selects a particular helper device, then submits a service request, and finally receives a response from the helper device. The inventors distinguished this scenario from their claims, stating that Mousseau’s operation was “in contrast to the method of the claimed invention, according to which devices announce their availability, and the mobile device scans the WLAN to identify those announcers [i.e., the plurality of devices connected to the local wireless network that announce their availability for accepting a routed media via said local wireless communication network].” *Id.* Similarly, the inventors reiterated that Mousseau does not “teach or imply that the mobile device receiving the streaming data for re-routing *scans the WLAN* to identify devices *which announce their availability and media type handling capabilities.*” *Id.*, 237 (emphasis added).

In summary, Zhang, like Mousseau, does not teach a mobile device that scans the local area network to identify an available device based on information announced by that device to the local area network. Rather, in Zhang, the mobile device selects a device, sends a service request to the selected device, and then learns its availability. Therefore, Petitioner’s proposed combination fails.

## **2. Claim 5**

Claim 5 depends from claim 1. Petitioner’s proposed combination fails for the reasons discussed regarding claim 1.

## **3. Claim 8**

Claim 8 depends from claim 1. Petitioner's proposed combination fails for the reasons discussed regarding claim 1.

**4. Claim 10**

Claim 10 depends from claim 1. Petitioner's proposed combination fails for the reasons discussed regarding claim 1.

**5. Claim 11**

Claim 11 depends from claim 1. Petitioner's proposed combination fails for the reasons discussed regarding claim 1.

**6. Claim 14**

Claim 14(b) recites "a scouting detector adapted to scan said local wireless communication network to identify a plurality of devices, identified as compatible to handle said media content, said plurality of devices are wirelessly connected to said local wireless communication network and wirelessly announce an availability for accepting a routed media via said local wireless communication network."

Petitioner refers to its arguments on claim 1(b) for claim 14(b). Therefore, its proposed combination fails regarding claim 14(b) for the same reasons discussed regarding claim 1(b).

**7. Claim 15**

Claim 15 depends from claim 14. Petitioner's proposed combination fails for the reasons discussed regarding claim 14.

**8. Claim 16**

Claim 16 depends from claim 14. Petitioner's proposed combination fails for the reasons discussed regarding claim 14.

**9. Claim 18**

Claim 18 depends from claim 14. Petitioner's proposed combination fails for the reasons discussed regarding claim 14.

**10. Claim 19**

Claim 19 depends from claim 14. Petitioner's proposed combination fails for the reasons discussed regarding claim 14.

**11. Claim 20**

Claim 20 depends from claim 14. Petitioner's proposed combination fails for the reasons discussed regarding claim 14.

**12. Claim 22**

Claim 22(c) recites "second program instructions executable by the processor to scan said local wireless communication network using said mobile device to identify a plurality of devices, identified as compatible to handle said media content, said plurality of devices are wirelessly connected to said local wireless communication network and wirelessly announce an availability for accepting a routed media via said local wireless communication network."

Petitioner refers to its arguments on claim 1(b) for claim 22(c). Therefore, its proposed combination fails regarding claim 22(c) for the same reasons discussed regarding claim 1(b).

**B. Ground 2**

**1. Claim 7**

Claim 7 depends from claim 1. Petitioner’s proposed combination fails for the reasons discussed regarding claim 1.

**2. Claim 13**

Claim 13 depends from claim 1. Petitioner’s proposed combination fails for the reasons discussed regarding claim 1.

**C. Ground 3**

**1. Claim 9**

Claim 9 depends from claim 1. Petitioner’s proposed combination fails for the reasons discussed regarding claim 1.

**D. Ground 4**

**1. Claim 10**

Claim 10 depends from claim 1. Petitioner’s proposed combination fails for the reasons discussed regarding claim 1.

**IV. Discretionary Denial Under 35 U.S.C. § 314(a) is Appropriate Under *Fintiv***

The Board has recognized that “the advanced state of [a parallel] district court proceeding” can provide grounds for the Board to deny institution of postgrant proceedings under § 314(a). *NHK Spring Co., Ltd. v. Intri-Plex Tech., Inc.*, IPR2018-00752, Paper 8 at 20; *Apple Inc. v. Fintiv, Inc.*, IPR2020-0019, Paper 15 at 7 (precedential). In *Fintiv*, the Board articulated several factors that

“balance considerations of system efficiency, fairness, and patent quality when a patent owner raises an argument for discretionary denial due to the advanced state of a parallel proceeding.” *Fintiv*, Paper 15 at 7. Under circumstances similar to this matter, the Board has denied institution when the analysis of these factors reveals that deciding otherwise would be an inefficient use of Board resources.

The *Fintiv* factors include (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (2) proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision; (3) investment in the parallel proceeding by the court and the parties; (4) overlap between issues raised in the petition and in the parallel proceeding; (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and (6) other circumstances that impact the Board’s exercise of discretion, including the merits. *See id.* at 7-8. Application of the *Fintiv* factors to the present circumstances suggests that discretionary denial is appropriate and will serve the interests of administrative efficiency and conserve the Board’s resources.

**A. Apple has Not Sought a Motion to Stay the Case in the Western District of Texas**

Apple has neither filed a motion to stay the district court litigation nor indicated to the district court that it intends to request a stay of the proceedings pending the Board’s decision whether to institute review. This factor strongly favors denial of institution.

**B. The Court's Trial Date is Set for More Than Two Months Before the Board's Projected Statutory Deadline**

The Board considers the proximity of the court's trial date in the parallel proceeding to the Board's projected statutory deadline for a final written decision. *Fintiv*, Paper 11 at 6. "If the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under NHK." *Id.* at 9. In *Fintiv*, the jury trial was set to begin "approximately two months before a final written decision would be due in [that] proceeding," and the Board found that this proximity weighed in favor of discretionary denial. *Fintiv*, Paper 15 at 13.

In the parallel court proceeding here, the current Scheduling Order sets the trial date for November 17, 2025. EX2007, 4. In this proceeding, the Final Written Decision would be expected by January 30, 2026. Thus, trial is expected to begin and conclude more than two months before the statutory deadline. While Petitioner suggests that schedule changes are likely, this is based only on its speculation.

**C. The Court and Parties have Invested Significantly in the Parallel Proceeding**

The Board considers investment in the parallel proceeding by the court and the parties in determining whether to exercise discretionary denial under § 314(a). *See Fintiv*, Paper 11 at 6. "Specifically, if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the

petition, this fact favors denial.” *Id.* at 9-10. Notably, “district court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Id.* at 10. In *Fintiv*, the Board noted that even though claim construction was complete, “fact discovery [was] in its early stages, with document production ongoing and depositions just getting underway, expert reports [were] not yet due, and substantive motion practice [was] yet to come.” *Fintiv*, Paper 15 at 14. Even so, the Board in *Fintiv* determined that this “factor weigh[ed] somewhat in favor of discretionary denial.” *Id.*

The parties here have invested significant resources in the district-court litigation. Patent Owners have deposed six of Petitioner’s employees and one of its expert witnesses. EX2002 [Deposition Notices of Petitioner’s Employees and Expert]. Petitioner has deposed both of Patent Owners’ principals. EX2003 [Deposition Notices of Plaintiffs]. The parties have extensively briefed issues relating to venue, as well as a motion to compel discovery. EX2004, Dkt. Nos. 18, 26, 28, 31, 32, 35, 37, 39, 53, 56, 58, 60 [Docket Sheet]. Additionally, Patent Owners have served infringement contentions (EX2005), and Petitioner has served invalidity contentions (EX2006). The parties have also each submitted opening and reply claim-construction briefs, including expert declarations submitted on behalf of each party. EX2004, Dkt. Nos. 70, 72, 75, 76 [Docket Sheet]. The district court is set to conduct a claim construction hearing on November 8, 2024. EX2007, 2

[Scheduling Order].

In sum, the district court and the parties have invested significant resources in the parallel proceeding, so this factor weighs in favor of discretionary denial.

**D. There is Complete Overlap Between Issues Raised in the Petition and in the Parallel Proceeding**

The Board considers overlap between issues raised in the petition and in the parallel proceeding in deciding whether to exercise its discretion to deny institution. *See Fintiv*, Paper 11 at 6. “Accordingly, if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Id.* at 12. As in *Fintiv*, the same claims are challenged here as in the district court. *See Fintiv*, Paper 15 at 14-15. Petitioner’s invalidity contentions in the district court include the same references that form the bases for this petition. *See* EX2006, 3 [Apple’s Invalidity Contentions]; Petition, 3-4, 79. While Petitioner indicates that if review is instituted, it “stipulates not to assert in the litigation (1) the Proposed Grounds of invalidity presented here nor (2) any grounds utilizing *Zhang* and *Moore* for the Challenged Claims,” this falls well short of a *Sotera* stipulation. *See NXP USA, Inc. v. Impinj, Inc.*, Paper 13 at 4, IPR2021-01556. Thus, the complete overlap in asserted references weighs in favor of denying institution.

**E. Petitioner and Defendant in the Parallel Proceeding are the Same Party**

The Board considers whether the petitioner is a defendant in the parallel proceeding, and, if it is, this fact weighs in favor of denying institution. See *Fintiv*, Paper 11 at 13-14. Apple is the defendant in the parallel district court litigation and the Petitioner in this proceeding, so this factor weighs in favor of discretionary denial. *See id.* at 15.

**F. Other Circumstances, Including the Lack of Merit in Petitioner’s Arguments, Favor Denial of Institution**

The Board also considers the merits of both petitioners’ and patent owners’ arguments. *See id.* As discussed above, Petitioner fails to offer any prior art reference that teaches, for example, at least the following limitations of the independent claims: claim 1(b), claim 14(b), and claim 22(c). This renders all of Petitioner’s grounds unpersuasive, or, at the very least, does not show that Petitioner’s “case [is] a close call.” *Id.* at 16. The Petition certainly does not constitute a “compelling unpatentability challenge,” which is a higher standard than the institution standard. *Commscope Technologies LLC v. Dali Wireless, Inc.*, Paper 23 at 3, IPR2022-01242.

With this glaring hole in every ground of Petitioner’s argument, the merits of this case “tip the balance” in favor of Patent Owners, and institution should be denied. *See Fintiv*, Paper 15 at 15.

**V. Conclusion**

For the foregoing reasons, the Board should deny institution.

Dated: October 30, 2024

Respectfully submitted,

/Cortney S. Alexander/

Reg. No. 54,778

Cortney S. Alexander

Kent & Risley LLC

5755 N Point Pkwy, Ste 57

Alpharetta, GA 30022

(404) 855-3867

(770) 462-3299 (fax)

[cortneyalexander@kentrisley.com](mailto:cortneyalexander@kentrisley.com)

## **CERTIFICATE OF WORD COUNT**

Pursuant to 37 C.F.R. § 42.24(d), Patent Owners certify that the foregoing Patent Owners' Preliminary Response contains 3,935 words, excluding the portions exempted by 37 C.F.R. § 42.24(a)(1), as measured by the word-processing software used to prepare the document.

/Cortney S. Alexander/  
Reg. No. 54,778  
Cortney S. Alexander  
Kent & Risley LLC  
5755 N Point Pkwy, Ste 57  
Alpharetta, GA 30022  
(404) 855-3867  
(770) 462-3299 (fax)  
[cortneyalexander@kentrisley.com](mailto:cortneyalexander@kentrisley.com)

## CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a) and (b), I certify that on the date indicated below, a true and accurate copy of the foregoing document was served on the following counsel for Petitioner via e-mail, pursuant to Petitioner's consent to e-mail service:

Paul R. Hart (Reg. No. 59,646)

[paul.hart@eriseip.com](mailto:paul.hart@eriseip.com)

[PTAB@eriseip.com](mailto:PTAB@eriseip.com)

Adam P. Seitz (Reg. No. 52,206)

[adam.seitz@eriseip.com](mailto:adam.seitz@eriseip.com)

[PTAB@eriseip.com](mailto:PTAB@eriseip.com)

Kevin Rongish (Reg. No. 78,716)

[kevin.rongish@eriseip.com](mailto:kevin.rongish@eriseip.com)

[PTAB@eriseip.com](mailto:PTAB@eriseip.com)

Dated: October 30, 2024

/Cortney S. Alexander/

Cortney S. Alexander

Reg. No. 54,778

Cortney S. Alexander

Kent & Risley LLC

5755 N Point Pkwy, Ste 57

Alpharetta, GA 30022

(404) 855-3867

(770) 462-3299 (fax)

[cortneyalexander@kentrisley.com](mailto:cortneyalexander@kentrisley.com)