

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T SERVICES INC., T-MOBILE USA, INC., CELLCO PARTNERSHIP
D/B/A VERIZON WIRELESS, ERICSSON, INC., AND NOKIA OF AMERICA
CORPORATION,

Petitioners

v.

INNOVATIVE SONIC LIMITED,

Patent Owner.

Case No. IPR2024-01144

U.S. Patent No. 9,237,489

PATENT OWNER PRELIMINARY RESPONSE

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I. INTRODUCTION

The Board should deny institution because [1] the Petition has not established that any prior art reference qualifies as a printed publication as required by 35 U.S.C. §311(b); [2] the Petition has not shown that the prior art suggests “configuring at least one SCell by a source eNB to a User Equipment (UE)” as required by independent claims 1 and 12; and [3] all six Fintiv factors favor discretionary denial under 35 U.S.C. §314.

II. BACKGROUND

A. The '489 Patent

U.S. Patent 9,237,489 is titled “Method and apparatus for secondary cell release during handover in a wireless communication system” and describes methods for releasing Secondary Cells (SCells) during User Equipment (UE) handover. EX1001, abstract. In mobile communications, a UE is connected to both a Primary Cell and a Secondary Cell. The “Primary Cell includes the cell operating in the primary frequency in which the UE either performs the initial connection establishment procedure or initiates the connection re-establishment procedure.” EX1001, 5:51-55. “A Secondary Cell (SCell) includes the cell operating on a secondary frequency which may be configured once an RRC connection is established and which may be used to provide additional radio resources.” *Id.*, 5:57-62.

When the UE changes locations, “UE mobility is realized with a handover procedure, which is triggered by the network. The network may initiate handover by first configuring the UE to perform measurement reporting or initiate handover without having received measurement reports from the UE.” EX1001, 6:1-7.

During this procedure, “the source eNB firstly selects the target eNB. The source eNB may also provide the target eNB with a list of cells. The target eNB decides which serving cells are to be configured for use after handover, which may include cells other than the ones indicated by the source eNB.” *Id.*, 6:21-32.

“However, currently there is no information included in RRCConnectionReconfiguration message for a UE to distinguish whether the handover is an intra-eNB or inter-eNB handover.” EX1001, 6:45-53. The invention therefore describes exemplary improvements to the handover process, including where “information indicates the SCell indexes of all the SCells configured to the concerned UE, thereby allowing the target eNB to include the sCellToReleaseList with the SCells configured to the UE in the RRCConnectionReconfiguration message so that the UE can release the SCell(s) according to the sCellToReleaseList.” EX1001, 6:65-7:4.

B. The Alleged Prior Art

The Petition asserts the following two grounds of invalidity:

- Obviousness of claims 1-22 in view of R2-105472 (“Nokia”) and 3GPP-36331-940, 3GPP-36300 950, and 3GPP-36331-Update (“3GPP Standard”)
- Obviousness of claims 1-22 in view of R2-105685 (“Ericsson”) and 3GPP Standard.

1. Nokia

R2-105472 (“Nokia”) is a proposal titled “ASN.1 Structure for SCell Configuration” prepared for the 3GPP TSG-RAN WG2 Meeting #71bis. The proposal suggests various ways of grouping SCell configuration parameters. EX1004, 1. Among the proposals are that “SCell configuration parameters should be grouped per DL and per UL” and moving “the SCell configuration parameters to extension of radioResourceConfigDedicated instead of having it in the extension of RRC Connection Reconfiguration message.” EX1004, 3.

2. Ericsson

R2-105685 (“Ericsson”) is a proposal titled “Physical layer parameters to be configured by RRC” also prepared for 3GPP TSG-RAN WG2 #71bis. The proposal suggests the changes needed in RRC where the higher layer configuration is required, e.g. the placement of different parameters in RRC. EX1005, 1. The proposal suggests a new format for PUSCH-config. EX1005, 6.

3. 3GPP Standard

3GPP-36331-940, 3GPP-36300 950, and 3GPP-36331-Update (“3GPP Standard”) are standards documents for 3GPP, a project for developing mobile standards for telecommunications. The specific standards at issue specify Radio Resource control protocols for the UE-E-UTRAN radio interface (EX1006), the E-UTRAN radio interface protocol architecture (EX1007), and a change request for Radio Resource control protocols (EX1008).

III. CLAIM CONSTRUCTION

The Petition submits that “the Board does not need to expressly construe any terms.” Pet., 14. For purposes of this preliminary response, Patent Owner agrees with Petitioner that no term needs to be construed, because the Petition fails to show the prior art suggests every limitation of the independent claims under any construction. Patent Owner reserves the right to expressly construe terms of the ’489 Patent should the Board institute review.

IV. THE PETITION FAILS TO SHOW THAT NOKIA, ERICSSON, AND THE 3GPP STANDARD ARE PRINTED PUBLICATIONS UNDER 35 U.S.C. § 311(b)

The Petition is facially defective because it fails to present legally sufficient reasoning to establish that any of the alleged prior art (including Nokia, Ericsson, and the 3GPP Standard) qualify as printed publications under 35 U.S.C. §311(b).

Having failed to carry Petitioners' burden, the Petition should be denied institution. *See Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018) ("Petitioner bears the burden of establishing that a particular document is a printed publication."). Every ground relies on some combination of EX1004 ("Nokia"), EX1005 ("Ericsson") and EX1006-EX1008 (the "3GPP Standard"). Once EX1004-1008 are disqualified, no viable ground of unpatentability exists.

The only arguments stated in the Petition in support of EX1004-EX1008 qualifying printed publications publicly accessible before the '489 Patent's priority date are [1] they were uploaded to a file server and [2] a non-precedential decision PTAB decision, *Samsung v. Huawei*, supposedly held all 3GPP documents are necessarily publicly accessible. Both are without merit. Further, any additional arguments that may be found in Petitioners' expert declaration but not stated in the Petition are not entitled to consideration.

A. Uploading to a File Server is Legally Insufficient to Establish Public Accessibility

The Petition's only argument for public accessibility of EX1004-EX1008 is that "they were uploaded to the 3GPP FTP server" before the '489 priority date:

- "Ericsson was uploaded to ETSI's file server on October 5, 2010. Ex-1003, ¶¶61-62, 87. As a result, Ericsson became a 'printed publication' under pre-AIA 35 U.S.C. § 102(a) on October 5, 2010." Pet., 16.

- “Nokia was uploaded to ETSI’s file server on October 5, 2010. Ex-1003, ¶¶56-57, 86. As a result, Nokia became a ‘printed publication’ under pre-AIA 35 U.S.C. § 102(a) on October 5, 2010.” Pet., 17.
- “3GPP technical specifications (TS) and contributions, including 3GPP TS 36.311 v9.4.0 (Ex-1006), 3GPP-36300-950 (Ex-1007), and 3GPP-36331-Update (Ex-1008) are publically [*sic*] accessible as of the date they were uploaded to the 3GPP FTP server.” Pet., 20.
- “3GPP TS 36.311 v9.4.0 (Ex-1006) was uploaded to ETSI’s file server on September 28, 2010. Ex-1003, ¶¶68-73, 89. As a result, 3GPP TS 36.311 v9.4.0 became a ‘printed publication’ under pre-AIA 35 U.S.C. § 102(a) on September 28, 2010.” Pet., 20.
- “3GPP-36300-950 (Ex-1007) was uploaded to ETSI’s file server on September 20-30, 2010. Ex-1003, ¶¶74-79. As a result, 3GPP-36300-950 became a ‘printed publication’ under pre-AIA 35 U.S.C. § 102(a) on September 30, 2010.” Pet., 20-21.
- “3GPP-36331-Update (Ex-1008) was uploaded to ETSI’s file server on October 28, 2010. Ex-1003, ¶¶63-67, 88. As a result, 3GPP-36331-Update became a ‘printed publication’ under pre-AIA 35 U.S.C. § 102(a) on October 28, 2010.” Pet., 21.

This argument is unavailing. Uploading a document to a file server does not by itself show public accessibility sufficient to establish a document as a printed publication. *SRI Int'l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1195 (Fed. Cir. 2008) (“this court does not find enough evidence in the record to show that [a file posted on a file server] was publicly accessible and thus a printed publication.”). This is true even if the document was technically accessible. *Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908 F.3d 765, 772 (Fed. Cir. 2018) (“The Board then correctly noted that ‘public accessibility’ requires more than technical accessibility.”). But besides the fact that they were uploaded to a file server, the Petition presents no other arguments for EX1004-EX1008 supposedly being printed publications.

To establish a reference as a printed publication, a petition must show the reference was publicly accessible, i.e., “searchable or indexed [or otherwise organized] in a meaningful way so that a person of ordinary skill in the art would have located [the reference].” *Acceleration Bay*, 908 F.3d at 772. The present Petition does not allege EX1004-EX1008 were ever indexed for search or actually disseminated to the interested public. Further, the Petition does not state that EX1004-EX1008 were meaningfully organized in any other way, such as finding

the name of specific subject matter for these exhibits in a catalog or the like. Pet., 15-21.

Having failed to state a sufficient reason to consider EX1004-EX1008 as publicly accessible before the priority date, the Petition should be denied.

B. *Samsung v. Huawei* Did Not Render All Alleged 3GPP Documents Publicly Accessible

In support of its argument that documents uploaded to a FTP server constitutes printed publications, the Petition cites a non-precedential Board decision in an unrelated case, *Samsung v. Huawei*, that supposedly established a rule that “technical reports and specifications uploaded to a standards organization’s file server before a challenged patent’s priority date qualify as prior art under 35 U.S.C. § 102.”¹

There is no such rule. Public accessibility is determined on a case-by-case basis, not by some general statement in an unrelated, non-precedential PTAB

¹ The Petition only provides a partial citation to this decision as *Samsung Elecs. Co.*, 2018 WL 6519544, *3, but the partial citation indicates this decision refers to *Samsung Elecs. Co., Ltd. v. Huawei Techs. Co., Ltd.*, IPR2017-01487, Paper 45 (PTAB Dec. 10, 2018).

decision. *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009) (public accessibility “is determined on a case-by-case basis”).

Moreover, the Petitioner in *Samsung* provided and the Board considered evidence of public accessibility Petitioners here fail to provide, including that:

- The 3GPP documents relied upon in *Samsung* were “fully searchable” and “available ‘to users via conventional search engines, such as the Google search engine’”. *Samsung* FWD at 10; *Samsung* Petition at 16.
- “3GPP members typically received an email whenever documents contributed for a Working Group meeting were uploaded to the FTP server.” *Samsung* FWD at 11, fn.3; *Samsung* Petition at 16.

Here, Petitioners present no evidence that EX1004-EX1008 were fully searchable or were indexed by a search engine, or that anyone was sent an email informing them that EX1004-EX1008 had been uploaded to a FTP server.

Therefore, *Samsung* cannot save Petitioner from the failure of its Petition to show that EX1004-EX1008 were publicly accessible before the priority date of the ’489 Patent.

C. Additional Arguments in Petitioners’ Expert Declaration That Are Not Stated in the Petition Should Not Be Considered

Rather than setting forth with particularity the evidence allegedly establishing EX1004-EX1008 as printed publications as required, the Petition

purports to incorporate EX 1003 (a six-hundred-ninety-six (696) page declaration by Craig Bishop) to support the conclusion that “[the alleged prior art] was uploaded to ETSI’s file server on [relevant date]. As a result, [the alleged prior art] became a ‘printed publication’ under pre-AIA 35 U.S.C. § 102(a) on [relevant date].” Pet. at 16 (allegation for Nokia), 17-18 (same allegation for Ericsson), 20-21 (same allegation for the 3GPP Standard). This is improper and should not be countenanced.

The Petition itself must “identif[y], in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. §312(a)(3). It is impermissible to incorporate by reference from another document. 37 C.F.R. § 42.6(a)(3) (“[a]rguments must not be incorporated by reference from one document into another document.”).

Federal Circuit caselaw supports this Rule. For example, in *3M Co. v. Evergreen Adhesives, Inc.*, the Federal Circuit rejected 3M’s arguments not made in the petition because its reference to expert testimony was “an attempt to introduce argument by citation.” 860 Fed.Appx. 724, 725-727 (Fed. Cir. 2021) (The Board is not to be forced to “play archeologist with the record” for arguments made outside the parties’ briefing); *see also, e.g., Medtronic, Inc. v. Teleflex Life*

Sciences Ltd., 2023 WL 7800137 (Fed. Cir. Nov. 16, 2023) at *4 (rejecting incorporation by reference); *Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 910 (Fed. Cir. 2014) (rejecting incorporation by reference as “fundamentally unfair”).

As the Board explained in *Vivint, Inc. v. SB IP Holdings LLC*: “What a petitioner may not do is to simply state conclusions in the petition, and rely on the expert declaration to provide all of the reasoning, explanation, and analysis.” IPR2022-00814, Paper 15, 2023 WL 6878619 at *5 (emph. added) (PTAB Oct. 16, 2023). That is precisely what the present Petition attempts to do: simply assert the conclusion that EX1004-EX1008 were publicly accessible before the priority date and rely on an expert declaration to provide all the reasoning, explanation, and analysis. Pet., 16-17, 20-21.

The requirement that the Petition itself must state the evidence supporting the grounds—and not just incorporate an expert declaration by reference—applies to the requirement to establish a reference as a printed publication. *Microsoft Corp. v. Throughputer, Inc.*, IPR2023-00852, Decision Denying Institution (Paper 18) at 17-18 (PTAB Nov. 9, 2023).

The Petition, as quoted above, references large portions of the Bishop Declaration to explain why EX1004-EX1008 were supposedly publicly accessible as of the date they were “uploaded to ETSI’s file server.” In other words, the

Petition presents only a single sentence repeated for each exhibit to allege public accessibility, and relies on the 696-page Bishop declaration to supply all the reasoning, explanation, and analysis. This single sentence also cites, without explanation, large portions of the Bishop Declaration, including paragraphs 25, 41, 52, 64, 86-96, 61-62, 87, 25, 73, 79-85, 68-73, 89, and 74-79. Pet., 16-17, 20-21. Worse, these paragraphs then attempt to sub-incorporate numerous pages from the declaration's integrated appendix: Appendix 6 at 6, 9; Appendix 9 at 10; Appendix 10 at 9; Appendix 24 at 87; Appendix 25 at 88, Appendix 26 at 1; Appendix 27 at 115-116.

Neither Patent Owner nor the Board should be forced to “play archeologist” with the record and comb through the pages of EX1003 in an attempt to discern what reasoning, explanation, and analysis might support the Petition's one-sentence conclusion that EX1004-EX1008 were publicly accessible as of the date they were “uploaded to ETSI's file server .” The citations to the Bishop Declaration do not substitute for the reasoning, explanation, and analysis that was required to appear in the Petition itself to establish EX1004-EX1008 as publicly accessible printed publications.

D. Further Preliminary Briefing is Not Warranted

To the extent Petitioners realize from this Preliminary Response that the Petition is deficient and seeks further preliminary briefing, it should be denied.

Further briefing may only be authorized upon a showing of good cause. *See* 37 C.F.R. § 42.108(c). “It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that **the initial petition** identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’ ” *Intel. Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (emphasis added).

It should come as no surprise to Petitioners that this Petition is deficient. Demonstrating that a reference qualifies as a printed publication is a “fundamental element of Petitioner’s contentions” in its Petition. *Microsoft Corp. v. Corel Software, LLC*, IPR2016-01083, Decision Denying Institution (Paper 14) at 13, fn.5 (PTAB Dec. 1, 2016). A Petitioner reading a Patent Owner Preliminary Response and realizing the Petition failed to state a threshold showing that a reference is a printed publication “does not support a finding of good cause” for additional briefing. *Id.* The same applies here.

V. CLAIMS 1-22 ARE NOT OBVIOUS IN VIEW OF NOKIA, ERICSSON, AND THE 3GPP STANDARD

The first step of independent claim 1 requires “configuring at least one SCell by a source eNB to a User Equipment (UE).” Independent claim 12 contains an identical recital. The ’489 Patent teaches that configuring the SCell is performed prior to release handover. For example:

A Secondary Cell (SCell) includes the cell operating on a secondary frequency *which may be configured once an RRC connection is established* and which may be used to provide additional radio resources. System information relevant for operation in the concerned SCell is typically provided using dedicated signaling when the SCell is added to the UE's configuration. Basically a PCell contains an uplink PCC and a downlink PCC, while an SCell configured to a UE may contain a downlink SCC or an uplink SCC along with a downlink SCC.

EX1001, 5:58-67.

The Petition fails to adduce any teaching in Nokia or Ericsson that shows “*configuring at least one SCell* by a source eNB to a User Equipment (UE)” as required by the first step of the independent claims. Rather than presenting evidence that a source eNB configures *an SCell* as required by the claims, the Petition instead presents evidence that the source eNB configures *an UE*:

- “3GPP-36331-Update discloses that the E-UTRAN (i.e. *the source eNB*) ‘*may configure a UE*’...” Pet., 26, 48-49.
- “3GPP-36331-Update further discloses *that the source eNB configures the UE* by means of the RRC protocol.” *Id.*, 26, 49.
- “The EUTRAN *configuring the UE* with one or more SCells discloses this limitation.” *Id.*, 49.

The only argument made by the Petition relevant to this element that even mentions SCells is that “E-UTRAN (i.e. the source eNB) ‘can independently add, remove or modify SCells by means of the RRC connection reconfiguration procedure using the RRCConnectionReconfiguration message.’” Pet., 26, 49. But this sentence refers to configuring the UE to add, remove, or modify SCells that serve the UE—not configuring the SCell. This is made clear by the fact that the Petition alleges that the RRCConnectionReconfiguration message that purportedly adds, removes, or modifies SCells is sent from the source eNB to the UE to do exactly that, and not provided to a SCell as would be to configure a SCell. *See* Pet., 3 (alleging “RRCConnectionReconfiguration message including the mobilityControlInformation, to be sent by the source eNB towards the UE.”).

To be perfectly clear that their theory is configuring the UE and not the SCell, Petitioners conclude their argument by ignoring configuration of the SCell entirely:

“A POSITA would understand that the E-UTRAN configuring the UE with one or more SCells discloses this limitation.” Pet., 27, 49. Configuring an UE however is not configuring a SCell as claimed. The Petition presents no evidence that any *SCell* is ever configured. The only evidence presented is that an UE is configured. But that is not what is claimed. Because Petitioners address the wrong claim limitation, the Petition fails to establish that configuring a SCell would have been obvious in view of the alleged prior art.

VI. THE BOARD SHOULD EXERCISE DISCRETION UNDER SECTION 314 AND DENY INSTITUTION

The Board should deny institution under 35 U.S.C. §314 because all six *Fintiv* factors favor discretionary denial. There is no requirement that the Board institute IPR. *See, e.g., Harmonic Inc. v. Avid Tech.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016). “[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.” *Id.* Rather, the decision to institute is delegated to the Board and is purely discretionary.

35 U.S.C. §314(a) gives the Board discretion to deny institution because of efficiency considerations stemming from parallel proceedings on the same patent. *See NHK Spring Co. v. Intri-Plex, Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (“*NHK Spring*”). The PTAB has set

forth six factors for determining whether discretionary denial due to efficiency considerations relating to parallel proceedings is appropriate (the “*Fintiv* factors”):

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(s) 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.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv I*”), 6; *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (PTAB May 13, 2020) (order denying institution) (informative, designated July 13, 2020) (“*Fintiv II*”), 7-8.

When she was the Director, Katherine Vidal issued interim guidance on the application of *Fintiv*. See Katherine K. Vidal, *Interim Procedure for Discretionary*

Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)² (“*Fintiv Memo*”); *see also OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021- 01064, Paper 102, 49–50 (PTAB Oct. 4, 2022) (precedential) (“*OpenSky*”) and *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022- 01242, Paper 23 (PTAB Feb. 27, 2023) (precedential) (“*CommScope*”). Under the interim *Fintiv Memo*, if the Board “determines that the information presented at the institution stage presents a compelling unpatentability challenge, that determination alone demonstrates that the PTAB should not discretionarily deny institution under *Fintiv*.” Interim *Fintiv Memo*, 4–5. However, *OpenSky* and *CommScope* make clear that the compelling merits standard is a significantly higher standard than the institution standard, requiring that it be “highly likely that the petitioner would prevail with respect to at least one challenged claim.” *OpenSky*, 49; *CommScope*, 3–4. Further, “compelling merits” should be considered only after a determination that the first five *Fintiv* factors favor discretionary denial. *CommScope*, 4–5. Regardless, Director Vidal’s Interim Procedure has no

² Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

force now that she has resigned without codifying her interim procedure with rulemaking.

Here, all six *Fintiv* factors weigh in favor of discretionary denial and there are no “compelling merits” or a *Sotera*-type stipulation. Accordingly, the Board should exercise its discretion and deny institution.

A. Factor 1

The first *Fintiv* factor—regarding whether a stay exists or is likely to be granted if a proceeding is instituted—weighs in favor of denial. No motion to stay pending the institution decision has been filed in the litigations. The district court has an established practice not to stay litigations pending resolution of inter partes review prior to institution. *Viavi Sols. Inc. v. Zhejiang Crystal-Optech Co.*, No. 2:21-CV-00378-JRG, 2022 WL 16856099, at *5 (E.D. Tex. Nov. 10, 2022) (“It is the Court’s established practice to consider that motions to stay pending IPR proceedings which have not been instituted are inherently premature and should be denied as such.”).

Even post-institution, the district court judge is unlikely to stay the case absent agreement from the parties. EX2005, 3 (showing 15% win rate on contested motions to stay pending IPRs in the ED Tex). Thus, this factor weighs in favor of denial.

B. Factor 2

The second *Fintiv* factor—the proximity of the court’s trial date to the Board’s projected statutory deadline for a Final Written Decision—weighs in favor of denial. The Notice of Filing Date Accorded to Petition was mailed on August 15, 2024. Paper 9, 1. A Final Written Decision will therefore be due by February 15, 2026. *See* 35 U.S.C. §314(b); 35 U.S.C. §316(a)(11). Jury selection in the district court litigation is scheduled to begin on July 21, 2025. EX1017, 1. Thus, a final written decision will likely issue seven months or more after the trial.

Further, under the interim *Fintiv Memo*, the PTAB will consider the median time from filing to disposition of the civil trial for the district in which the parallel litigation resides. *Id.*, 4-5. The current median time to trial in the Eastern District of Texas is 21.6 months. EX2006, 35. The district court litigations were filed on October 19, 2023. Paper 7, 2-3. Under these statistics, trial would be expected July or August 2025. Thus, using either the actual scheduled trial date in this matter or the median time-to-trial statistics for the Eastern District of Texas, trial is expected to conclude six months or more before a final written decision is due in this matter.

Under *Fintiv* factor 2, this weighs heavily in favor of discretionary denial. *See Fintiv I*, 9 (“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this factor in favor of exercising

authority to deny institution under NHK.”); *Ericsson Inc. et al v. Collison Communications, Inc.*, IPR2022-01233, Paper 12 at 12-13 (PTAB Jan. 19, 2023) (holding Factor 2 “weighs in favor of denying institution, given that we would not expect to issue a final written until at least four months” after trial). Further, granting institution here would frustrate one of the primary objectives of the AIA, which is “to provide an effective and efficient alternative” to parallel litigation. *NHK Spring*, 19-20 (quoting *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, 15-19 (PTAB Sept. 6, 2017) (precedential, designated Oct. 18, 2017)). If IPR were instituted, any potential FWD would issue well after trial concludes. Thus, instituting IPR here cannot be viewed as an “alternative” to litigation. Rather, it would simply be more litigation.

Petitioners cite *Hulu, LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00298, Paper 11 at 11-18 (PTAB May 19, 2021) and *NetNut Ltd. v. Bright Data Ltd.*, IPR2021-01492, Paper 12 at 9-16 (PTAB Mar. 21, 2022) to argue that “[t]he Board has granted institution in cases where the final written decision issued a few months after the scheduled trial date when other factors favor institution.” Pet., 71. In both cases, several factors weighed in favor of institution. Here, no factors weigh in favor of institution.

Petitioners also cite *CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00556, Paper 9 at 8 (PTAB Sept. 12, 2023) to argue that the Board treats factor 2 as neutral where Petitioners will have multiple trials (Pet., 72), but in *CrowdStrike*, the trials started “a few weeks earlier than the projected statutory deadline.” *Id.* Here, the projected statutory deadline will be six months after the scheduled trials. Thus, *CrowdStrike* does not support Petitioners’ position. Factor 2 therefore weighs in favor of denying institution.

C. Factor 3

The third *Fintiv* factor—which relates to “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision” (*Fintiv I* at 9)—also favors denial. Significant amounts of work have been completed in the district court. The parties have completed their P.R. 3-1 and 3-2 disclosures (Infringement Contentions), their P.R. 3-3 and 3-4 disclosures (Invalidity Contentions), and have exchanged claim constructions. EX1017, 5-6. The institution decision is expected no later than January 31, 2025. See 35 U.S.C. §314(b). By that date, the parties will have submitted their opening claim construction briefs, completed claim construction discovery, and submitted technical tutorials. EX1017, 4-5. The Markman hearings in the district court

litigations are scheduled for January 22, 2025 and February 5, 2025, respectively.³

EX1017, 3. The ordinary practice of this district court is to provide preliminary constructions at or shortly before the *Markman* hearing. Thus, significant substantive work will have already been completed in the district court litigation by the expected time of the institution decision. *See Fintiv II*, 14 (“based on the level of investment and effort already expended on claim construction and invalidity contentions in the District Court, this factor weighs somewhat in favor of discretionary denial in this case.”).

Petitioners argue that their “diligence in filing and the district court’s minimal investment tips this factor in favor of institution.” Pet., 72. But the Petition measures investment at the time the IPRs were filed, not (as required by *Fintiv*) at the time of the institution decision. As discussed above, by the time of

³ The district court split the deadlines for the district court cases into two tracks—the “ATL cases” (including cases 2:23-cv-486, 2:23-cv- 487, and 2:23-cv-488) and the “ISL cases” (including cases 2:23-cv-489, 2:23- cv-490, and 2:23-cv-491).

EX1017, 2 n.2. The ATL schedule is roughly two weeks ahead of the ISL schedule.

the institution decision, claim construction will be nearly complete and significant discovery will have taken place.

Further, the Petition was filed on July 25, 2024. Paper 1, 75. Infringement contentions were filed January 4, 2024. EX1017, 6. Thus, Petitioners waited approximately five months from receiving infringement contentions to file the Petition. Indeed, Petitioners filed their own invalidity contentions on April 12, 2024 and then waited another seven weeks before filing this Petition. EX1017, 5. These timelines show more delay than any case Petitioner cites. Accordingly, factor 3 weighs in favor of non-institution.

D. Factor 4

The fourth *Fintiv* factor—which relates to overlap between issues raised in the petition and in the parallel proceeding—also weighs in favor of denying institution. “[I]f 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.” *Fintiv* at 12. Claims 1-22 challenged in this IPR are also asserted in the District Court litigation. EX2007, 2. Petitioners identify the 3GPP Standard and proposals submitted for discussion in 3GPP TSG-RAN WG2 Meeting as prior art in the District Court litigation. EX2007, 9, 18-19. Thus,

Petitioners rely on the same body of prior art for the same claims in both proceedings.

The Petition stipulates that “if trial is instituted, Petitioners will not pursue this IPR’s Grounds in the district court litigation.” Pet., 73. The PTAB has classified such stipulations as “*Sand Revolution*”-style stipulations after the stipulation filed in *Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 (PTAB June 16, 2020), where Petitioner filed a stipulation that it “will not pursue the same grounds in district court litigation.” *Id.* at 11-12. The PTAB has routinely found similar stipulations weigh only “marginally in favor of not exercising discretion to deny institution.” *Id.*, 12; *LG Elecs., Inc. v. Ancora Techs., Inc.*, IPR2021-00581, Paper 16, 9-10 (PTAB June 10, 2021) (same); *Google LLC v. EcoFactor Inc.*, IPR2021-00454, Paper 9 (PTAB July 22, 2021) (same); *Samsung Electronics Co. Ltd. v. California Institute of Tech.*, IPR2023-00130, Paper 10, 19-20 (PTAB May 4, 2023) (same); *Roku, Inc. v. IOENGINE, LLC*, IPR2022-01554, Paper 11, 13-14 (PTAB May 5, 2023) (same).

The Board historically assigns almost no weight to *Sands Revolution* style stipulations such as the one Petitioner filed here. This is because *Sands Revolution*-style stipulations do little to eliminate overlap with the district court litigations.

Petitioners' stipulation does nothing to prevent the alleged prior art references asserted in the Petition from being re-used in substantially the same form in the litigation by combining them with different secondary references. Indeed, Petitioners' invalidity contentions reserve the right to do so. See, e.g., EX2007, 12 ("Any prior art reference cited herein may be combined with any other reference to demonstrate the invalidity of any of the Asserted Claims."). Thus, the stipulation here is almost meaningless.

Further, the Board has often denied institution in situations like the present where the other factors clearly favored non-institution, even where Petitioners offered stronger stipulations than the one offered here. For example, in *LG Elecs., Inc. v. Ancora Techs., Inc.*, IPR2021-00581, Paper 16, 9-10 (PTAB June 10, 2021), the Board denied institution despite the petitioner's stipulation "it will not subsequently assert invalidity in the district court on the same grounds asserted in the IPR or on the basis of the Hellman reference, either alone or in combination with any other reference." *Id.* Unlike Petitioners' stipulation here, the petitioner in *Ancora* agreed to a blanket stipulation not to assert the primary referenced Hellman under any circumstance. The Board there agreed with the patent owner that, even with the petitioner's stipulation, "there is significant overlap between the issues raised in the Petition and in the parallel district court proceeding." *Id.* Similarly, in

Samsung Electronics Co., Ltd.. v. California Institute of Technology, IPR2023-00130, Paper 10 (PTAB May 4, 2023), the Board denied institution notwithstanding a stipulation it characterized as “broader to some degree than the stipulation discussed in *Sand Revolution*” because “the trial in the Underlying Litigation would commence several months before the expected date of our final written decision” and there had been significant investment in the litigation. *Id.*, 16-20.

The facts here are stronger than *Ankora* and *Samsung*. Petitioners offer a near-meaningless stipulation that does not outweigh the other factors.

E. Factor 5

The fifth *Fintiv* factor—whether the petitioners and the defendant in the parallel proceedings are the same parties—weighs in favor of discretionary denial. The parties here are the same as the parties in the litigations. *Fintiv II*, 15 (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”).

F. Factor 6

The sixth *Fintiv* factor—relating to other circumstances that impact the Board’s exercise of discretion, including the merits—weighs in favor of discretionary denial. As demonstrated in Sections IV and V above, the Petition

fails to establish that any of the alleged prior art qualify as printed publications and further fails to show that they suggest “configuring at least one SCell by a source eNB to a User Equipment (UE).” There is no reasonable likelihood of success, much less the high likelihood of success required to show “compelling merits.” *See Fintiv I*, 15 (“if the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present”); *Commscope Technologies LLC, v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23, 5 (precedential) (“Merely pointing to [] analysis under the lower institution standard is insufficient to demonstrate that the Petition presents a compelling unpatentability challenge.”).

Petitioners’ allegations that the Petition shows “compelling merits” (Pet., 74) have nothing to do with the arguments in the present IPR and should be rejected. Centonza and Han are not alleged to be prior art in this IPR, and their supposed teaching of “the claimed message functionality using eNBs” is irrelevant to the claims at issue here. Pet., 74. Given that the Petition has not even established that Nokia, Ericsson, and the 3GPP Standard are even printed publications available as prior art in IPR, this factor strongly favors discretionary denial.

Accordingly, all six *Fintiv* factors weigh in favor of discretionary denial. The Board should use its discretion to deny institution of this IPR.

VII. CONCLUSION

For the foregoing reasons, the Board should deny institution.

Dated: November 15, 2024

Respectfully submitted,

/ Minghui Yang /
Minghui Yang (Reg. No. 71,989)
CARMICHAEL IP, PLLC
8607 Westwood Center Drive
Suite 270
Tysons, VA 22182
Tel: (703) 646-9248
mitch@carmichaelip.com

Counsel for Patent Owner

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner Preliminary Response consists of 5,662 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The Response complies with the type-volume limitation of 14,000 words as set forth in 37 C.F.R. § 42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

Dated: November 15, 2024

Respectfully submitted,

/ Minghui Yang /
Minghui Yang (Reg. No. 71,989)
CARMICHAEL IP, PLLC
8607 Westwood Center Drive
Suite 270
Tysons, VA 22182
Tel: (703) 646-9248
mitch@carmichaelip.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on November 15, 2024, a copy of the foregoing documents **PATENT OWNER PRELIMINARY RESPONSE AND EXHIBITS** were served by electronic mail, as consented to by Petitioner, upon the following:

McKool Smith, P.C.

Scott W. Hejny (Reg. No. 45,882)
shejny@McKoolSmith.com

Nicholas Mathews (Reg. No. 66,067)
nmathews@mckoolsmith.com

Christian J. Hurt (Reg. No. 63,659)
churt@mckoolsmith.com

Saif M. Askar (pro hac vice forthcoming)
saskar@mckoolsmith.com

Celerity_IPRs@mckoolsmith.com

By: /s/ Minghui Yang