

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. IPR2024-01145

U.S. Patent No. 9,560,559

PATENT OWNER PRELIMINARY RESPONSE

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I. INTRODUCTION

Challenged independent claims 1 and 7 of U.S. Patent No. 9,560,559 are directed to a method for supporting dual connectivity using two evolved Node Bs (eNBs). Each eNB separately controls a respective cell, and both cells serve a User Equipment (UE) together. To do so, the claims require the first eNB to allocate a measurement gap configuration to the UE, and then send the measurement gap configuration to the second eNB so that the second eNB could take the received measurement gaps into consideration when scheduling resources to the UE.

The Petition fails to show any of the alleged prior art discloses or suggests the second eNB taking “measurement gaps into consideration when scheduling resources to the UE” as claimed. As explained below, none of Centonza, Siomina, or TS 36.331 teach the second eNB using measurement gaps received from the first eNB to schedule resources to the UE. Because the Petition fails to show how this element is rendered obvious by the prior art, the Board should deny institution.

II. BACKGROUND

A. The '559 Patent

U.S. Patent 9,560,559 is titled “Method and apparatus for implementing small cell enhancements in a wireless communication system.” EX1001, abstract. At the time of invention, the 3GPP standards organization was undertaking standardization activities with respect to the Evolved Universal Terrestrial Radio Access Network, or “E-UTRAN” air interface. EX1001, 1:31-40, 2:18-30. Thus, the wireless

communications systems of the '559 Patent were developed in the context of E-UTRAN and may be “designed to support one or more standards such as the standard offered by” 3GPP. EX1001, 2:18-30. Accordingly, the '559 Patent incorporates by reference several E-UTRAN standards documents. *Id.*

In one aspect, the '559 Patent describes a study to “[i]dentify and evaluate the benefits of UEs having dual connectivity to macro and small cell layers served by different or same carrier and for which scenarios such dual connectivity is feasible and beneficial.” EX1001, 5:6-9. To implement the dual connectivity between the macro and small cell layers, the '559 Patent proposes that “a small cell could generally be configured to a UE by the macro eNB. Thus, it could be expected that the macro eNB and the small cell eNB need to exchange some information for the small cell configuration and operation (such as security configuration, physical configuration, MAC configuration, RLC configuration, and/or PDCP configuration).” EX1001, 6:30-40. Furthermore, “it would be beneficial for the macro eNB to send a measurement gap configuration (as discussed in 3GPP TS 36.331 V11.2.0) allocated for the UE to the small cell eNB so that the small cell eNB could take measurement gaps into consideration when scheduling resources to the UE. For example, the small cell eNB could avoid scheduling the UE during measurement gaps because the UE cannot transmit or receive any signal to/from the small cell during the measurement gaps.” EX1001, 6:41-49.

FIG. 5 shows a flow chart of one exemplary embodiment:

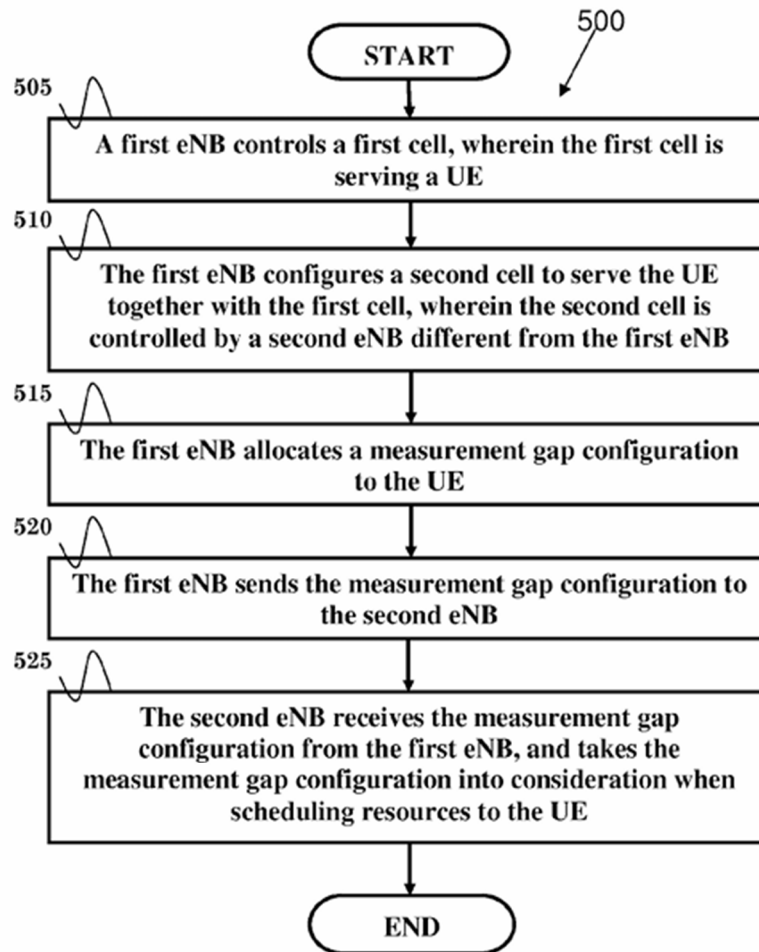


FIG. 5

EX1001, Fig. 5.

“In step 505, a first eNB controls a first cell that serves a UE. In step 510, the first eNB configures a second cell to serve the UE together with the first cell. The second cell is controlled by a second eNB that is different from the first eNB.”

EX1001, 6:50-57. “In step 515 of FIG. 5, the first eNB allocates a measurement gap

configuration to the UE.” *Id.*, 6:59-64. “In step 520, the first eNB sends the measurement gap configuration to the second eNB.” *Id.* “[T]he second eNB receives the measurement gap from the first eNB, and takes the measurement gap configuration into consideration when scheduling resources to the UE.” *Id.*, 6:65-7:3.

B. The Alleged Prior Art

The Petition asserts the following four grounds of invalidity:

- Anticipation of claims 1-3 and 7-11 in view of U.S. Patent No. 9,479,973 (“Centonza”);
- Obviousness of claims 1-13 and 7-11 in view of Centonza and TS 36.331;
- Obviousness of claims 1-13 and 7-11 in view of Centonza and WIPO Pub. App. No. WO2012064265A1 (“Siomina”); and
- Obviousness of claims 1-13 and 7-11 in view of Centonza, Siomina, and TS 36.331.

Each ground relies upon Centonza as the primary reference and introduces Siomina and/or TS 36.331 for various additional teachings.

1. Centonza

U.S. Pat. No. 9,479,973 (“Centonza”) is directed to a “node and method for handing over a sub-set of bearers to enable multiple connectivity of a terminal towards several base stations.” EX1005, Title. Centonza identifies that “[w]hen

using a single flow for mapping bearers in a heterogeneous network, several problems exist. An example of such a problem is the need for frequent handovers.” *Id.*, 1:66-2:2. According to Centonza, its invention “make[s] it possible to perform handovers selectively between a source and a target eNB, thereby creating more system flexibility than the legacy way of performing handover where a user equipment is completely handed over to the target.” *Id.*, 2:37-41.

Centonza suggests that “the handover can be triggered and/or executed at a bearer level rather than the current user equipment level approach that is used in LTE is proposed.” *Id.*, 2:29-32. “Different handover triggering conditions can be set, and based on these conditions as well as other factors such as load and user equipment/network buffer conditions; a selective handover of only a subset of the user equipment bearers is performed.” *Id.*, 2:32-36. Consistent with 3GPP LTE Release 11, Centonza teaches these handovers can occur between macro and pico cells. *Id.*, 1:35-52.

Specifically, Centonza is directed to updating 4GLTE release 11 to support complementing macro base stations with low powered (i.e., pico) base stations. Centonza explains:

Yet another approach that is gaining high attention is to use Heterogeneous Networks where the traditional pre-planned macro base stations (known as the macro layer) are complemented with several low-powered base stations that may be deployed in a relatively

unplanned manner. The 3rd Generation Partnership Project (3GPP) has incorporated the concept of Heterogeneous Networks as one of the core items of study in the latest enhancements of LTE, such as LTE release 11 and several low-powered base stations for realizing heterogeneous networks such as pico base stations, femto base stations (also known as home base stations or HeNBs), relays, and RRHs (remote radio heads) have been defined. The initial discussion for LTE release 12 has already started and one of the proposed items for study is the possibility of serving a user equipment (UE) from more than one eNB simultaneously. The current legacy handover mechanisms of LTE have to be updated in order to support this.

EX1005, 1:35-52.

An example of Centonza's architecture is shown below in Centonza Fig. 12, where the macro (or "anchor") base station 401A "are able to provide coverage and the picos 401B are there only for capacity enhancements." EX1005, 10:28-30.

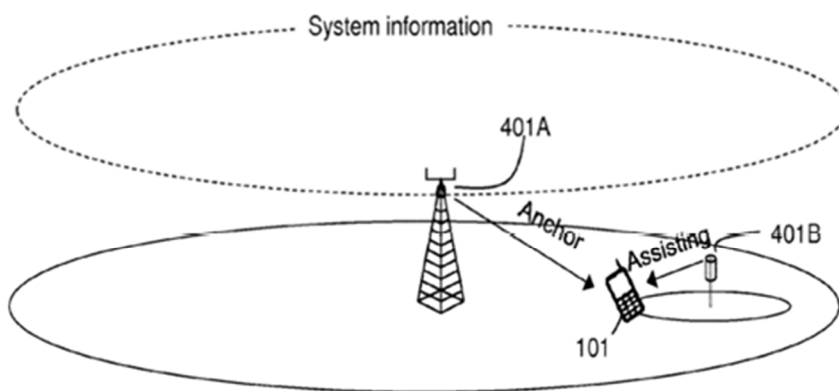
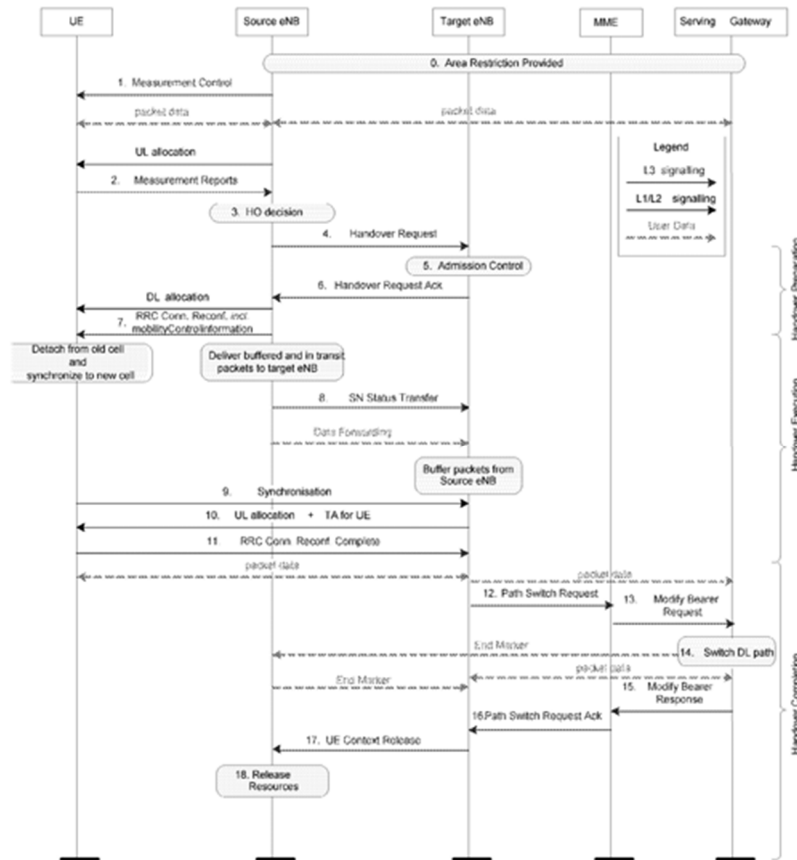


FIGURE 12

In these embodiments, “the user equipment maintains the macro connectivity all the time (called the ‘anchor’ flow), and adds the pico connectivity when it is in the coverage area of the pico (called the ‘assisting’ flow).” EX1005, 10:31-38. Centonza refers to this arrangement as “multiple connectivity” or “dual connectivity.” *Id.*, 10:37-39. In “multiple connectivity” or “dual connectivity” arrangements such as those relied on by Petitioner, the anchor flow is used for control signaling but either the anchor or assisting (‘pico’) flow may transmit data. *Id.*, 10:34-38 (“When both connections are active, the anchor flow may be used either for control signaling while the assisting flow is used for data. However, it will still be possible to send data also via the anchor flow.”). Thus, the anchor, or macro cell, ultimately controls pico connectivity.

Centonza’s “handover process is shown in Fig. 14” of the Centonza Provisional:



EX1006, 46 (Fig. 14), 21; *see also* EX1005, Fig. 15, 13:26-27. “The handover procedure can be subdivided into three stages of preparation (initiation), execution and completion.” *Id.*, 13:26-27.

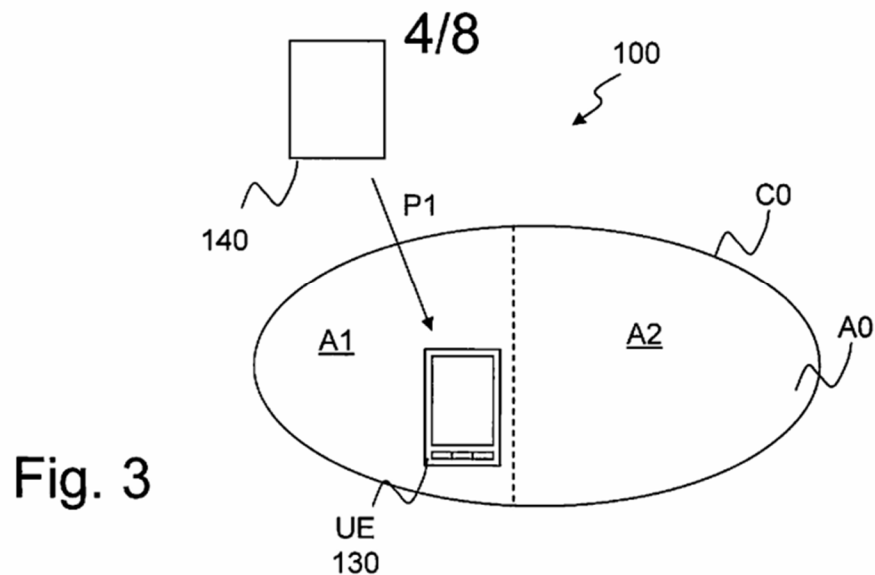
2. Siomina

WIPO Pub. App. No. WO2012064265A1 (“Siomina”) is titled “Methods and network nodes for configuring almost blank subframe transmission patterns and corresponding measurement patterns for reducing intercell interference in an heterogeneous cellular radio communication system” and describes methods for

configuring patterns for network nodes. EX1007, Title, Abstract. “The patterns are transmission patterns or measurement patterns.” *Id.*, Abstract.

Siomina teaches that its “measurement patterns” are patterns for user equipment located in a specific geographical area: “Each measurement pattern is associated with a respective restricted area such that each measurement pattern is used when the user equipment is located in the respective restricted area. Each respective restricted area is smaller than an entire area of the cell...” EX1007, 7:4-9.

This is illustrated by Fig. 3:



EX1007, Fig. 3. Figure 3 shows that the entire cell area C0 is divided into two geographic areas A1 and A2. Each area A1 and A2 is assigned a respective measurement pattern, and the measurement patterns correspond to conditions in each geographic area A1 or A2. EX1007, 10:21-29 (“[T]he cell C0 comprises a first area A1 and a second area A2. In this manner, different patterns may be configured

for, or associated with, different respective areas as described in more detail below. For each area A1 , A2, there will be assigned a respective pattern. The cell C0 has an entire cell area A0. Each of the first and second areas A1 , A2 is smaller than the entire cell area A0. The radio conditions in the first and second areas A1 , A2 may differ for different reasons, such as buildings, background noise etc.”).

3. TS 36.331

TS 36.331 is a technical specification titled “E-UTRA RRC protocol specification” incorporated by reference in the ’559 Patent. The specification 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.

III. CLAIM CONSTRUCTION

The Petition submits that “the Board does not need to expressly construe any terms.” Pet., 13. For purposes of this preliminary response, Patent Owner’s position is that all terms are entitled to their plain and ordinary meaning as understood by a POSITA under the proper construction. *Supra*, §II.A.3. Patent Owner reserves the right to expressly construe terms of the ’559 Patent should the Board institute review.

IV. CLAIMS 1-3 AND 7-11 ARE NOT ANTICIPATED BY CENTONZA OR OBVIOUS IN VIEW OF CENTONZA, SIOMINA, AND TS 36.331

Claims 1 and 7 are directed to a method for supporting dual connectivity using two evolved Node Bs (eNBs). Each eNB separately controls a respective cell,

and both cells serve a User Equipment (UE) together. The claims further require the first eNB to allocate a measurement gap configuration to the UE, and then send the measurement gap configuration to the second eNB so that the second eNB can take the received measurement gaps into consideration when scheduling resources to the UE. None of the alleged prior art suggests this last element—that the second eNB takes “measurement gaps into consideration when scheduling resources to the UE.”

In Ground 1, Petitioners argue that Centonza discloses this element. First, Petitioners appear to suggest that this element is an expression of an intended result rather than a method step and thus non-limiting. Pet., 35-36 (*citing Minton v. Nat’l Ass’n of Sec. Dealers, Inc.*, 336 F.3d 1373, 1381 (Fed. Cir. 2003)). Petitioners are incorrect. This clause affirmatively recites the capability of the second eNB to use the measurement gap to schedule resources to the UE. As the ’559 Patent explains, the benefit of the second eNB receiving the measurement gap configuration is so that the second eNB uses the measurement gap to schedule resources to the UE—i.e., avoid scheduling the UE during measurements. EX1001, 6:41-49 (“the small cell eNB could avoid scheduling the UE during measurement gaps because the UE cannot transmit or receive any signal to/from the small cell during the measurement gaps.”). This capability is more than the intended result of a process step; it is part of the process itself and must be given patentable weight. *Hoffer v. Microsoft Corp.*, 405 F. 3d 1326, 1330 (Fed. Cir. 2005).

Petitioners then argue that Centonza discloses this limitation because, during the Handover Request, the first eNB sends MeasGapConfig—an alleged measurement gap configuration—to the second eNB. The Petition, however, provides no evidence that Centonza’s Target eNB uses the received MeasGapConfig to schedule UE resources. Pet., 35-37. Instead, the Petition argues that the second eNB necessarily uses MeasGapConfig because its purpose is to “define time periods when no uplink or downlink transmissions will be scheduled, so that the user equipment may perform the measurements.” Pet., 36. In other words, Petitioners argue that evidence of sending MeasGapConfig to the Target eNB is sufficient to show using MeasGapConfig by the Target eNB.

Petitioners are again incorrect because TS 36.331 teaches that the purpose of MeasGapConfig is to **configure the UE** (not an eNB) to perform measurements during periods when there are no UL/DL transmissions scheduled. EX1009, 79 (describing how the UE sets up a received measurement gap configuration), 74 (defining “measurement gap” as “[p]eriods that the UE may use to perform measurements, i.e. no (UL, DL) transmissions are scheduled.”). Indeed, Petitioners’ description of the measurement gap in Centonza as “defin[ing] time periods when no uplink or downlink transmissions will be scheduled, **so that the user equipment may perform the measurements**” explicitly concedes this. Because the purpose of MeasGapConfig is to **configure the UE**, it does not follow that sending

MeasGapConfig to the Target eNB necessarily requires the Target eNB to use MeasGapConfig to schedule resources as required by the claims. Rather, page 79 of TS 36.331 teaches that the Target eNB passes MeasGapConfig to the UE so that the UE can be configured to perform measurements. There is no teaching anywhere in Centonza or TS 36.331 that the Target eNB (rather than the UE) uses MeasGapConfig to schedule resources. Thus, sending MeasGapConfig to a Target eNB alone cannot anticipate “taking measurement gaps into consideration when scheduling resources to the UE.” The alleged prior art simply lacks the required express teaching of the Target eNB taking measurement gaps into consideration when scheduling resources to the UE (rather than passing it to the UE to schedule measurements).

Petitioners’ Ground 2 argument repeats its Ground 1 argument that transmitting MeasGapConfig to the Target eNB necessarily requires the Target eNB to use MeasGapConfig to schedule resources to the UE and fails for the same reason. As explained above, TS 36.331—like Centonza—discloses that the purpose of MeasGapConfig is to configure the UE. TS 36.331 does not teach that the Target eNB (rather than the UE) uses MeasGapConfig to schedule resources. Thus, TS 36.331 cannot suggest that the Target eNB takes measurement gaps into consideration when scheduling resources to the UE as claimed.

Finally, Petitioners' Ground 3 argument that Siomina discloses this element suffers from the same defect. Like for Centonza and for TS 36.331, the Petition does not allege that Siomina discloses that a pico eNB uses patterns to schedule resources to a UE. Pet., 56-58. Instead, the Petition argues that this element may be inferred because "Siomina discloses that the macro eNB sends the patterns to the pico eNB." But like for Centonza and for TS 36.331, evidence that a pattern is sent to a pico eNB is not evidence that the pattern is used by the pico eNB to schedule resources. Rather, Siomina similarly discloses that the pattern is *applied to a UE*: "a network node, which may be a pico eNB, 'determines *which of the at least two patterns shall be applied when the user equipment 130* is located in the respective restricted area.'" Pet., 57 (*citing* EX1007, 13:20–30). Because the pattern is applied to a UE, Siomina at most suggests configuring a UE with a pattern and cannot suggest the pico eNB using the pattern to schedule resources.

Accordingly, the Petition fails to show that any prior art combination suggests "the second eNB could take measurement gaps into consideration when scheduling resources to the UE" and institution must be denied.

V. 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.

The Director has issued additional 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)¹ (“*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

¹ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

merits” should be considered only after a determination that the first five *Fintiv* factors favor discretionary denial. *CommScope*, 4–5.

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 July 31, 2024. Paper 9, 1. A Final Written Decision will therefore be due by January 31, 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 half a year 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 10, 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 at least five months 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., 67. 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., 67), but in *CrowdStrike*, the trials

started “a few weeks earlier than the projected statutory deadline.” *Id.* Here, the projected statutory deadline will be five 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.²

² 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

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

Further, the Petition was filed on July 17, 2024. Paper 1, 71. 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

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.

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 1-3 and 7-11 challenged in this IPR are also asserted in the District Court litigation. EX2007, 2. Petitioners identify as prior art U.S. PG Pub 2014/0206361 to Centonza (“Centonza Application”) in the District Court litigation. EX2007, 10. The Centonza Application subsequently issued as U.S. Patent 9,479,973 (“Centonza”), which Petitioners rely on as the primary alleged prior art in this IPR. Furthermore, both Petitioners’ infringement contentions and this IPR rely on WO2014056130A1 (“Siomina”) and TS 36.331. EX2007, 10, 20.

The Petition stipulates that “if trial is instituted, Petitioners will not pursue this IPR’s Grounds in the district court litigation.” Pet., 68-69. 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.*, No. 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 Section IV above, the Petition fails to show that Centonza or Siomina suggest “the second eNB could take measurement gaps into consideration when scheduling resources to the 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., 70) are based solely on their attorney argument repeating their §314 analysis and should be rejected as in *Commscope*. Petitioner's allegations essentially "point[] to its analysis under the lower §314 standard." *Commscope*, IPR2022-01242, Paper 23. *See* Pet., 70. Petitioner does not elaborate on why the merits here are "compelling." Such generic allegations do not rise to the level of compelling merits. *See, e.g., OpenSky* at 49 ("a compelling-merits challenge is a higher standard than the reasonable likelihood required for the institution of an IPR under 35 U.S.C. §314(a)."). Thus, this factor 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.

VI. CONCLUSION

For the foregoing reasons, the Board should deny institution.

Dated: October 31, 2024

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner Preliminary Response consists of 5,236 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).

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on October 31, 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:

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