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Paper 16
Date: April 17, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHARTER COMMUNICATIONS, INC.,
Petitioner,

v.

ADAPTIVE SPECTRUM AND SIGNAL ALIGNMENT, INC.,
Patent Owner.

IPR2024-01379
Patent 7,809,996 B2

Before KEVIN F. TURNER, KEVIN C. TROCK, and SCOTT RAEVSKY, *Administrative Patent Judges.*

TROCK, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Charter Communications, Inc. ("Petitioner") filed a Petition, Paper 1 ("Pet." or "Petition"), to institute an *inter partes* review of claim 20 (the "challenged claim") of U.S. Patent No. 7,809,996 B2 (Ex. 1001, "the '996 patent"). Adaptive Spectrum and Signal Alignment, Inc. ("Patent Owner") timely filed a Preliminary Response, Paper 6 ("Prelim. Resp."). On February 28, 2025, the USPTO rescinded the June 21, 2022, "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" ("*Fintiv* Memorandum").[1] On March 17, 2025, we issued an Order (Paper 11) authorizing each of the parties to file a supplemental brief limited to addressing what effect, if any, the recission of the *Fintiv* Memorandum may have on the parties' briefing in the Petition and the Preliminary Response. In response to the Order, each party filed a supplemental brief. *See* Papers 12, 13.

An *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). Institution of *inter partes* review, however, is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("[T]he PTO is permitted, but never compelled, to institute an IPR proceeding."). For the reasons discussed below,

[1] https://www.uspto.gov/about-us/news-updates/uspto-rescindsmemorandum-addressing-discretionary-denial-procedures.

we exercise discretion under 35 U.S.C. § 314(a) not to institute *inter partes* review.

B. Real Party in Interest

Petitioner identifies itself as the only real party in interest. Pet. 1. Patent Owner identifies itself as the only real party in interest. Paper 4, 1.

C. Related Proceedings

According to the parties, the '996 patent is the subject of the following action: *Adaptive Spectrum and Signal Alignment, Inc. v. Charter Communications, Inc., et al.*, Case No. 2:24-cv-00124 (E.D. Tex.), filed February 22, 2024. Pet. 1; Paper 4, 1.

D. The '996 Patent (Ex. 1001)

The '996 patent it titled "Adaptive FEC Codeword Management," and relates to dynamically controlling system parameters that affect performance in communication systems such as DSL systems. Ex. 1001, code (54), 1:18–22.

Figure 6 of the '996 patent, below, shows a block schematic diagram of a communication system. Ex. 1001, 5:21–23.

Figure 6

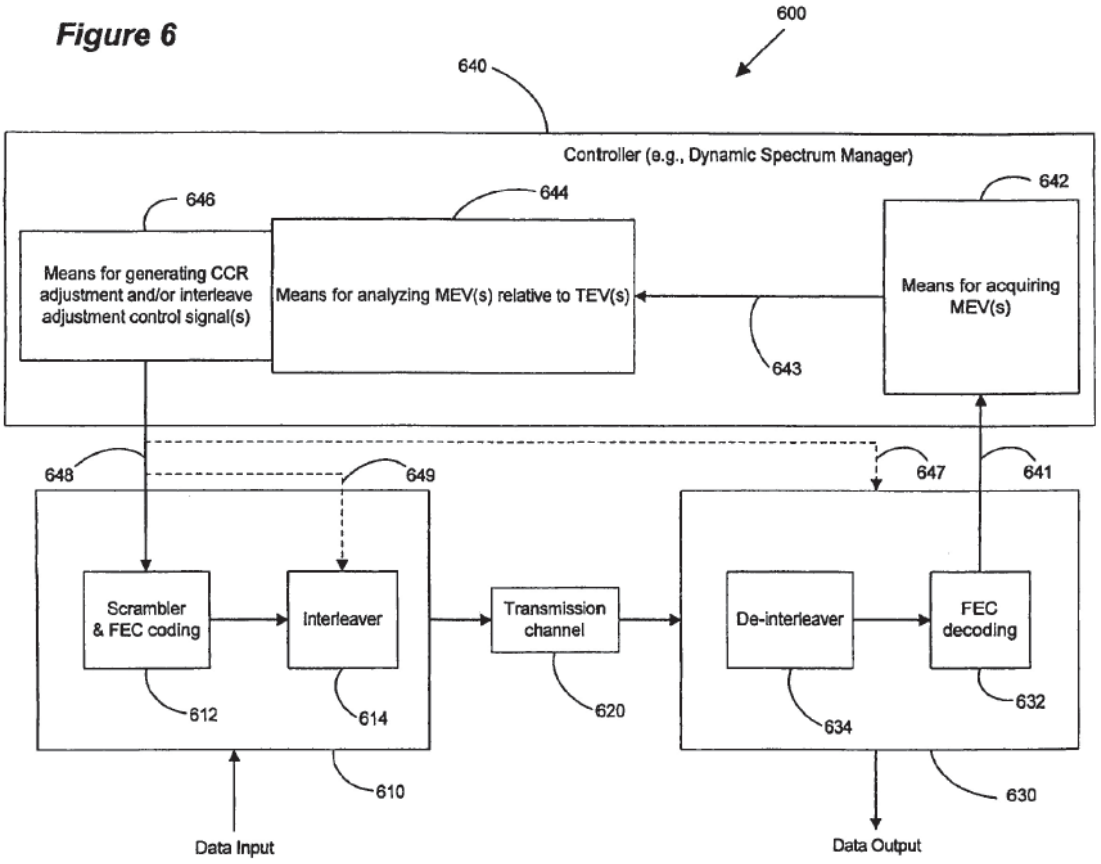


Figure 6, above, shows transmission system 600 comprising transmitter 610, transmission channel 620, receiver 630, and controller 640. *Id.* at 14:11–13. Transmitter 610 includes forward error correct (FEC) coder 612 coupled to interleaver 614. *Id.* at 14:13–15. FEC coder 612 generates codewords, and interleaver 614 interleaves data to be transmitted by transmitter 600 over transmission channel 620. *Id.* at 14:16–21.

Receiver 630 receives data, and de-interleaves and decodes the data. *Id.* at 14:25–28. When de-interleaving and decoding the data, receiver 630 generates input signal 641 relating to the bit error rate of the transmission system 600 and other information pertaining to errors generated in the transmission of data through transmission channel 620. *Id.* at 14:28–32.

Controller 640 measures error rate performance of system 600 at receiver 630 to determine whether adjustment of the codeword composition ratio (CCR) is beneficial and how best to implement such an adjustment. *Id.* at 14:44–47. The CCR is a quantity or value that represents the relation between the payload and parity bytes in the applicable FEC coding scheme. *Id.* at 4:13–17. Controller 640 includes means, such as a transmission error value monitor, coupled to the communication system for acquiring a measured transmission error value (MEV). *Id.* at 4:21–24. Coupled to this monitor is means for analyzing the MEV relative to a target transmission error value (TEV). *Id.* at 4:24–25. Controller 640 generates CCR adjustment control signal 648 in response to the MEV(s) and the controller's analysis of the MEV(s) relative to the TEV(s). *Id.* at 14:47–50.

E. The Challenged Claim

Petitioner challenges independent claim 20 of the '996 patent set out below. Pet. 1.

20[pre] A transmission system comprising:

20[a] a transmission channel to carry data between a transmitter and a receiver/decoder, each communicatively interfaced with the transmission channel;

20[b] a transmission error value monitor communicatively interfaced with the receiver/decoder to periodically monitor for transmission error values indicative of impulse noise events on the transmission channel,

20[c] wherein the transmission error values are periodically monitored after training and initialization on the receiver/decoder,

20[d] the transmission error values being selected from a group comprising: a bit error rate, errored seconds, errored minutes, code violations over a fixed period of time, Signal-to-Noise Ratio (SNR) measured at the receiver/decoder, and Transmission Control Protocol and Internet Protocol (TCP/IP) throughput,

20[e] and wherein the transmission error value monitor to further generate an input signal based on the transmission error values monitored; and

20[f] a controller coupled with the transmitter to receive the input signal from the transmission error value monitor and to further generate a retransmission overhead control signal for the transmitter in response to the input signal.

Ex. 1001, 22:42–64 (numbering and formatting designated by Petitioner; *see* Ex. 1011).

F. Evidence

Petitioner relies upon the following evidence:

(1) U.S. Patent No. US 5,699,365, issued December 16, 1997 ("Klayman") (Ex. 1003);

(2) U.S. Patent No. 6,477,669, issued November 5, 2002 ("Agarwal") (Ex. 1004);

(3) U.S. Patent No. 6,546,509, issued April 8, 2003 ("Starr") (Ex. 1005); and

(4) Declaration of Dr. James Martin (Ex. 1002).

G. Asserted Grounds of Unpatentability

Claim Challenged	35 U.S.C. §	References
20	103(a)	Klayman/Starr
20	103(a)	Agarwal/Starr

II. ANALYSIS

A. Discretionary Review under 35 U.S.C. § 314(a)

The Board's decision in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*"), identifies a non-exclusive list of factors the Board considers when addressing whether a related, parallel district court action provides a basis for discretionary denial under 35 U.S.C. § 314(a). *Fintiv*, 5–16. These 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.

Id. at 5–6. We take "a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review" when evaluating these factors. *Id.* at 6.

Petitioner asserts that when "[t]aken as a whole, [the *Fintiv*] factors weigh against exercising discretion to deny institution." Pet. 4.

Patent Owner asserts that "the Board should exercise its discretion to deny the Petition because (1) *Fintiv* factors two through five support discretionary denial; and (2) the Petition does not provide a compelling, meritorious challenge (*Fintiv* factor six)." Prelim. Resp. 26.

1. *Fintiv Factor 1: Whether the Court Granted a Stay or Evidence Exists that One May Be Granted if a Proceeding is Instituted*

Petitioner points out that it "has not yet moved for a stay in the co-pending litigation; therefore, *Fintiv* Factor 1 is neutral." Pet. 5.

Patent Owner agrees that Factor 1 is neutral, noting that "no stay has been requested in the parallel litigation, and there is no indication that the court would grant a stay in the event this proceeding were instituted." Prelim. Resp. 27.

We agree with the parties that Factor 1 is neutral as no stay has been requested in the parallel proceeding.

2. *Fintiv Factor 2: Proximity of the Court's Trial Date to the Board's Projected Statutory Deadline for a Final Written Decision*

Petitioner argues that "given the ongoing venue discovery which may affect case deadlines and based on the Courts' median time-to-trial," *Fintiv* Factor 2 is neutral. Pet. 6. Petitioner asserts that

> [t]he co-pending litigation is in its early stages. At the time of filing this Petition, Plaintiff has only served infringement contentions and the parties are engaging in venue discovery in connection with a motion to transfer the co-pending litigation to the District of Colorado. The parties have not yet engaged in any other written discovery, depositions, nor begun claim construction. According to the Court's Docket Control Order, a *Markman* hearing is set for March 19, 2025 and trial is currently set for September 22, 2025.

> (EX1008). However, the Eastern District of Texas' median time-to-trial for patent cases is 727 days, which would result in a trial date of February 17, 2026. (EX1009). And, if the district court litigation were to be transferred to the District of Colorado, the median time-to-trial for patent cases in that Court is 1,125 days (resulting in an expected trial date of March 22, 2027). (*Id.*). The projected statutory deadline for a final written decision is in mid-March 2026.

Pet. 5–6.

Patent Owner argues that *Fintiv* Factor 2 "strongly favors denial because trial will begin nearly seven months before the FWD deadline." Prelim. Resp. 27. Patent Owner asserts that

> [t]he projected statutory deadline for issuing a Final Written Decision (FWD) in this IPR is April 29, 2026. Jury selection in the parallel litigation is scheduled to begin September 22, 2025, which is more than seven months before the projected FWD deadline. EX2008, 1. The *Fintiv* Memo also authorizes panels to "consider the median time from filing to disposition of the civil trial for the district in which the parallel litigation resides" as reported on the uscourts.gov website. *Fintiv* Memo, 3 n.4. According to the latest report (September 2024) on the uscourts.gov website, the median time-to-trial for civil actions in the Eastern District of Texas is 21.9 months. The complaint in the parallel litigation was filed February 21, 2024. Applying the median time-to-trial, the estimated trial date would be in mid-December 2025 (about December 18, 2025), which is more than four months before the projected FWD deadline.
>
> Additionally, citing a Lex Machina report, Petitioner alleges that "the Eastern District of Texas' median time-to-trial for patent cases is 727 days, which would result in a trial date of February 17, 2026." Pet., 5 (citing EX1009). Even applying this date, which is most favorable to Petitioner, the trial in the parallel litigation would begin more than two months before the projected FWD deadline.
>
> Prelim. Resp. 27–28.

Patent Owner provides the table shown below summarizing its projected trial dates. *Id.* at 28.

Eastern District of Texas	Projected Trial Date	Months Before FWD
Current Case Schedule	September 22, 2025	More than seven
US Courts (Civil)	Mid-December 2025	More than four
Lex Machina (Patents)	February 17, 2026	More than two

The table above summarizes Patent Owner's projections for a trial date in the parallel proceeding pending in the Eastern District of Texas. Jury selection for the trial in the parallel proceeding is currently scheduled for September 22, 2025,[2] which would be slightly more than seven months before the statutory deadline for a final written decision in this proceeding should i*nter partes* review be instituted.[3]

According to Patent Owner, the September 2024 report on the www.uscourts.gov website indicates that the median time-to-trial for civil actions in the Eastern District of Texas is 21.9 months. Prelim. Resp. 28. Applying this median time-to-trial provides an estimated trial date in Texas of mid-December 2025, which is slightly more than four months before a projected statutory deadline of April 29, 2026, for a final written decision in this proceeding should institution be granted. Even relying on a Lex Machina report

[2] Ex. 2008, 1.

[3] A decision on institution in this case is due April 29, 2025, which, if instituted, would have a statutory deadline of April 29, 2026, for a final written decision.

(Ex. 1009), which indicates that the median time-to-trial for patent cases in the Eastern District of Texas is 727 days, would result in a trial date in February 2026, at least two months before the projected statutory deadline for a final written decision in this proceeding. So regardless of which trial date estimate is considered, they all provide for a trial date months before a projected statutory deadline for a final written decision in this proceeding.

With respect to Petitioner's argument concerning a possible transfer to the District of Colorado, on March 30, 2025, the Magistrate Judge in the parallel proceeding recently issued a Report and Recommendation denying the motion to transfer. *See* Ex. 2012, 5–20.

Accordingly, based on the current record we disagree with Petitioner that *Fintiv* Factor 2 is neutral. Instead, we agree with Patent Owner that Factor 2 favors discretionary denial.

3. Fintiv Factor 3: Investment in the Parallel Proceeding by the Court and the Parties

Petitioner argues that *Fintiv* Factor 3 "weighs in favor of not exercising discretion to deny institution." Pet. 6. Petitioner asserts that "[t]he district court case is in its early stages as the parties have only begun venue discovery and the claim construction hearing will not occur until March 2025." Pet. 6 (citing Ex. 1008). "Indeed," Petitioner points out, "the most fact-intensive work (fact and expert discovery), substantive issues (e.g., claim construction), and dispositive decisions (summary judgment and trial) have not yet begun in the co-pending litigation." *Id.* Petitioner argues that "[t]he district court has expended minimal resources to this case." *Id.*

Petitioner also asserts that it "was served with infringement contentions—identifying the asserted claims—on June 28, 2024 and has filed this Petition approximately 11 weeks after that date. Thus, Petitioner was 'reasonably diligen[t]' in filing this Petition under Factor 3 which weighs against exercising discretion." *Id.* at 6–7.

Patent Owner, however, argues that "Factor three weighs in favor of denying institution." Prelim. Resp. 29. Patent Owner points out that "the Board 'consider[s] 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*.'" *Id.* (citing *Fintiv*, 9 (emphasis added)). Patent Owner explains that as of the time of the filing of the Preliminary Response, "[t]he parties have already exchanged invalidity and infringement contentions and are engaged in fact discovery. By the April 29, 2025 DI deadline, the court will have conducted a Claim Construction Hearing (on March 19, 2025), and the parties will have completed fact discovery (by April 15, 2025) and be engaged in expert discovery." Prelim. Resp. 29 (citing Ex. 2008, 4–7). Patent Owner argues that "Petitioner's arguments that factor three favors institution are not persuasive because they consider the state of the parallel litigation at the time the Petition was filed, not at the time of the [decision on institution]." Prelim. Resp. 30.

Patent Owner also argues that "Petitioner [was not] diligent in filing the Petition, as it alleges." *Id.* (citing Pet. 6–7). Patent Owner points out that "the Petition was filed seven months after the Complaint identified the asserted claim that is challenged here." Prelim. Resp. 30 (citing Ex. 1006 ¶¶ 35–36). Patent Owner points out that "[t]he Petition challenges only one claim: independent claim 20," and that "[t]aking almost three months to challenge a single claim is

not diligent, and Petitioner does not provide any explanation for its delay in filing the Petition." Prelim. Resp. 30.

We disagree with Petitioner and agree with Patent Owner that *Fintiv* Factor 3 favors the exercise of discretionary denial. The current record shows that the parties have already exchanged infringement and invalidity contentions, engaged in fact discovery, exchanged proposed claim terms and preliminary claim constructions, filed a joint claim construction statement, attended a claim construction hearing, and the Court issued its claim construction order on March 31, 2025. *See* Ex. 2008; Doc. 105 (Case 2:24-cv-00124-JRG-RSP). Moreover, the deadline to complete fact discovery is April 15, 2025, before the statutory deadline for issuing a decision on institution in this case. *See* Ex. 2008, 4. Thus, contrary to Petitioner's arguments, the parties and the District Court will have expended substantial resources by the time the decision on institution is issued in this proceeding. Accordingly, we find that *Fintiv* Factor 3 favors the exercise of discretionary denial.

4. Fiintiv Factor 4: Overlap between Issues Raised in the Petition and in the Parallel Proceeding

In the Petition, Petitioner argues that "[t]his factor weighs in favor of not exercising discretion to deny institution," because "[i]f this Petition is instituted, Petitioner will not pursue any of the invalidity references relied on in the Petition in the district court litigation." Pet. 7.

In its Preliminary Response, Patent Owner argues that "Factor 4 strongly favors denial because there is complete overlap between the issues that will be tried in the different tribunals." Prelim. Resp. 31. Patent Owner contends that "there is complete overlap between the invalidity issues" because "the Petition challenges the validity of claim 20 of the '996 patent based on (i) Klayman and

Starr and (ii) Agrawal and Starr," and "in the parallel litigation, Petitioner challenges the validity of claim 20 using the same three references." *Id.* (citing Ex. 2009, 50–54). Patent Owner argues that "Petitioner's stipulation—to 'not pursue any of the invalidity references relied on in the Petition in the district court litigation'—is not a *Sotera* stipulation and does not allay the concerns undergirding factor four." Prelim. Resp. 31. Patent Owner argues that "Petitioner's stipulation is essentially meaningless," because "[i]t includes only three patents, each of which has at least one counterpart or related patent/publication that is not included in the stipulation." *Id.*

In its Supplement Brief, Petitioner states that "Petitioner's original analysis of the *Fintiv* factors did not focus on the [*Fintiv* Memorandum] guidance and remains unchanged." Paper 13, 2. However, with respect to Factor 4, Petitioner now asserts that "it will not pursue in the district court litigation any ground that Petitioner raised or reasonably could have raised in this proceeding." *Id.* at 3–4. Petitioner's new proposal is materially different than the stipulation first offered in the Petition, in which Petitioner only agreed that it would "not pursue any of the invalidity references relied on in the Petition in the district court litigation." Pet. 7.

In *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A), the Board considered a stipulation similar to the one Petitioner now offers in its supplemental brief.[4] In

[4] In *Sotera*, Petitioner "filed in the District Court 'a stipulation that, if IPR is instituted, they will not pursue in the District Court Litigation any ground raised or that could have been reasonably raised in an IPR.'" *Sotera v. Masimo*, IPR2020-01019, Paper 12, 18.

Sotera, the Board found that Petitioner's stipulation "mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions," and determined that "Petitioner's broad stipulation ensures that an *inter partes* review is a 'true alternative' to the district court proceeding." *Id.* at 19. Following the analysis in *Sotera*, we find that Petitioner's new stipulation weighs strongly in favor of not exercising discretion to deny institution.

5. Fintiv Factor 5: Whether the Petitioner and the Defendant in the Parallel Proceeding are the Same Party

There is no dispute that the parties are the same in both proceedings. Petitioner admits that it "is a defendant in the parallel proceeding," but argues that "this factor alone should not be dispositive." Pet. 7. Patent Owner argues that "Factor 5 strongly favors denial because the parties involved in this IPR are the same as in the district court proceeding." Prelim. Resp. 32.

Because the parties are the same in both proceedings, we find that this factor weighs in favor of discretionary denial. *See Sotera* at 19.

6. Fintiv Factor 6: Other Circumstances that Impact the Board's Exercise of Discretion, Including the Merits

With respect to Factor 6, Petitioner contends that the "Petition presents a strong case for invalidity of the '996 patent." Pet. 7. Petitioner argues that "[t]he claim at issue is broad and rendered obvious by the asserted grounds. Where, as here, a strong case for obviousness is presented, this factor weighs in favor of not exercising discretion to deny institution." *Id.* at 7–8.

In contrast, Patent Owner contends that Factor 6 "favors denying institution" because "the Petition fails to establish that its art teaches or suggests the 'periodically' limitation." Prelim. Resp. 32–33. Patent Owner argues that

both grounds asserted by Petitioner fail because the asserted references do not disclose monitoring channel characteristics "*periodically*" as recited in independent claim 20. *See* Prelim. Resp. 13–22. [5] Patent Owner argues that "periodically" means "monitor at fixed intervals" of time. *Id.* at 8–11.

Petitioner, however, argues that "*periodically*" means "repeated . . . over time." *See* Pet. 25 (citing Ex. 1002 ¶¶ 121, 128; Ex. 1003, 10:20–26) ("A POSITA would have understood Klayman's disclosure that this process is 'repeated . . . over time' to mean that this monitoring is done periodically.").

Thus, our analysis of the merits of this case at this preliminary stage (which we address in more detail below) turns on the determination of the meaning of the claim term "*periodically*." We note that the District Court has construed the term "*periodically monitor*" to mean "*monitor at regular intervals of time*." *See* Sec. II.C below. Given this construction, which we preliminarily agree with at this stage, we cannot agree with Petitioner that the Petition presents "a strong case for obviousness." Thus, we find that Factor 6 weighs in favor of exercising discretionary denial.

7. Conclusion on Discretionary Denial

When considering the *Fintiv* factors, we take "a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review." *Fintiv*, 6. Based on our review, we find that the factors weigh in favor of exercising discretion to deny institution of the Petition. The factors weighing

[5] The Preliminary Response also contends that "Petitioner has not demonstrated that Agarwal discloses the element of "indicative of impulse noise," but for the reasons discussed in our Decision in Sec. II.C we do not reach this contention. *See* Prelim. Resp. 22–26.

in favor of exercising discretionary denial include the scheduling of the parallel proceeding's trial date months prior to the Board's projected statutory deadline for a final written decision, the substantial investment by the parties and the District Court in the parallel proceeding, the recommended denial of the motion to transfer by the District Court, the District Court's ruling on claim construction which we preliminarily agree with, and the impact that this claim construction has on our assessment of the merits, as well as the identity of the parties in the two proceedings. In our view, these factors outweigh Petitioner's offer of a stipulation to limit the overlap between the issues raised in the Petition and the parallel proceeding. We, therefore, are persuaded that the interests of the efficiency and integrity of the system would be best served by invoking the authority under 35 U.S.C. § 314(a) to deny institution of the Petition.

B. Level of Ordinary Skill

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991).

Petitioner describes a person of ordinary skill in the art as a person having "at least a bachelor's degree in electrical engineering, or a related field, with at least two years of experience in the field of DSL, cable, or wireless communication systems." Pet. 9–10 (citing Ex. 1002 ¶¶ 55–56). Petitioner further states that "[a]dditional education could compensate for less practical experience and vice versa." *Id.* Patent Owner does not provide its own

description of a person of ordinary skill in the art, nor Patent Owner contest Petitioner's description. *See* Prelim. Resp.

Petitioner's description of a person of ordinary skill appears consistent with the subject matter of the '996 patent. This is supported by the testimony of Petitioner's declarant, Dr. Martin. *See* Ex. 1002 ¶¶ 55–56. We adopt Petitioner's assessment of a person of ordinary skill for purposes of this Decision, with the exception of the qualifier "at least," to keep the description from being vague and extending to a level reflecting that of an expert. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995).

C. Claim Construction

For petitions filed on or after November 13, 2018, a claim shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100 (2019). The Petition was accorded a filing date of September 17, 2024. Paper 5. Thus, we apply the claim construction standard as set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

Under *Phillips,* claim terms are generally given their ordinary and customary meaning as would be understood by one with ordinary skill in the art in the context of the specification, the prosecution history, other claims, and even extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises, although extrinsic evidence is less significant than the

intrinsic record. *Phillips*, 415 F.3d at 1312–17. Usually, the specification is dispositive, and it is the single best guide to the meaning of a disputed term. *Id.* at 1315.

Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co*. *Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (in the context of an *inter partes* review, applying *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Here, Petitioner takes the position that, "[f]or purposes of the prior art cited herein, no claim term requires an express construction because the prior art relied upon meet the claim terms under any reasonable interpretation." Pet. 13.

Patent Owner, however, asserts that with respect to contested claim 20, the term "*periodically monitor*" means "monitor at fixed intervals" and that this is "the only possible interpretation according to the plain and ordinary meaning of the word 'periodically.'" Prelim. Resp. 8; *see id.* at 8–11. Patent Owner argues that both grounds asserted by Petitioner fail because the asserted references do not disclose monitoring channel characteristics "*periodically*" as recited in claim 20. *See* Prelim. Resp. 13–22.

In contrast, Petitioner asserts that a person of ordinary skill in the art "would have understood Klayman's disclosure that this process is 'repeated . . . over time' to mean that this monitoring is done periodically." Pet. 25 (citing Ex. 1002 ¶¶ 121, 128; Ex. 1003, 10:20–26). Thus, according to Petitioner, the term "*periodically*" as used in claim 20 means "repeated . . . over time."

Thus, the parties dispute the ordinary and customary meaning of the term "*periodically*" as it is used in claim 20, with Petitioner arguing that "*periodically'* means "repeated . . . over time" and Patent Owner arguing that "*periodically*" means "at fixed intervals." *See* Pet. 25; Prelim. Resp. 8. Our preliminary determination of the ordinary and customary meaning of the term "*periodically*" as it is used in claim 20 substantially impacts our view of the merits in this case as this issue is the principal one raised by Patent Owner in its Preliminary Response. *See* Prelim. Resp. 5–22.

In discussing Klayman's primary station 101, Petitioner asserts that "[p]rocessors 130 within the primary station 'monitor a channel parameter of the second communications channel to form a monitored parameter.'" Pet. 24 (citing Ex. 1003, 11:2–12). Petitioner argues that a person of ordinary skill in the art "would have recognized that the monitor within processor 130 is a transmission error value monitor" because "Klayman specifically teaches that one such parameter which is monitored by processor 130 is 'bit error rates' (i.e., transmission error values)." Pet. 24 (citing Ex. 1003, 7:37–45; Ex. 1002 ¶ 120).

Petitioner goes on to assert that

> Klayman further teaches that "this process may be repeated for each secondary device and over time" and "different revised forward error correction parameters will be received by the different secondary stations and, over time, by the same secondary station." (EX1003, 10:20-26). A POSITA would have therefore understood that processors 130 would repeatedly monitor channel parameters (i.e., transmission error values) to repeatedly transmit revised forward error correction parameters (at step 370 of Figure 4) which are received by the secondary station. (EX1002 ¶121). **A POSITA would have understood Klayman's disclosure that this process is "repeated . . . over time" to mean that this monitoring is done *periodically***.

Pet. 25 (citing Ex. 1002 ¶¶ 121, 128) (emphases added).

Petitioner's declarant, Dr. Martin, testifies that a person of ordinary skill in the art reading Klayman

> would have understood that, in order for "different revised forward error correction parameters" to be received by the secondary station (including the transmitter), the process of monitoring channel parameters at the primary station would necessarily be repeated. **In my opinion, this repeated process, done "over time", indicates that each processor 130 is *periodically monitoring* the parameters.** Thus, Klayman teaches that the processor (i.e., transmission error value monitor) periodically monitors the channel parameters, including bit error rates (i.e., transmission error values).

Ex. 1002 ¶ 121 (emphases added).

Patent Owner disagrees with Petitioner's asserted meaning of the claim term "*periodically*." Petitioner instead argues that "[p]eriodically monitor means *monitor at fixed intervals*." Prelim. Resp. 8 (emphasis added). In support of this meaning, Patent Owner relies on three lines of evidence and argument: 1) the '996 Specification; 2) dictionaries; and 3) claim differentiation. *Id.* at 8–11. Also supporting Patent Owner's proposed meaning is the District Court's recent Claim Construction Order issued in the parallel proceeding, where the Court determines that the term "periodically monitor" means to "monitor at regular intervals of time." *See* Ex. 2013, 14–18.

First, Patent Owner asserts that "[t]he word 'periodically' is used only once in the '996 patent specification and refers to a fixed interval." Prelim. Resp. 8 (citing Ex. 1001, 13:21–22) (discussing systems that "periodically" acquire the number of CRC values at "15 minute intervals."). Patent Owner also asserts that "[o]ther relevant uses of the word 'period' are used to describe a 'fixed period of time.'" Prelim. Resp. 8 (citing Ex. 1001, 4:56–64; *accord* 5:61,

9:38, 13:32, cl. 2, cl. 16; *see also id.* at 11:18 (discussing "given period of time"); 12:51 (discussing a "given time period").

Second, Patent Owner argues that technical dictionary meanings of the term "periodically" also support its proposed meaning. In particular, Patent Owner points to the definition of the term "periodic" in the *Oxford Dictionary of Electronics & Electrical Engineering* (5th ed. 2018). There, the term "periodic" is defined as "[d]enoting any variable quantity that has regularly recurring values with respect to equal increments of some independent variable, such as time. The interval between two successive repetitions is the period." Prelim. Resp. 9 (citing Ex. 2004).

Patent Owner concedes that there is more than one meaning for the term "periodically" provided in other dictionaries. Prelim. Resp. 11. For example, Merriam-Webster's Collegiate Dictionary (11th ed. 2014) defines "periodically" as "1: at regular intervals of time; 2) from time to time: FREQUENTLY." Prelim. Resp. 11 (quoting Ex. 2006). Patent Owner argues, however, "there is a difference between the colloquial, or lay, use of the word periodic and the understanding of those skilled in the art here. It is true that a non-technical speaker or writer might conflate the words "periodically" and "repeatedly" . . . "[b]ut the language of the specification and claims, and the only technical dictionary in evidence, make clear that the *technical* distinction is well known and that 'periodically' here means 'at fixed intervals.'" Prelim. Resp. 10.

Third, Patent Owner argues that the doctrine of claim differentiation supports its proposed meaning of the term "periodically." Patent Owner points out that "[t]he '996 patent uses the word 'repeatedly' in its claims when referring to acquiring error information." Prelim. Resp. 9 (citing Ex. 1001, cl. 1 ("a

means, coupled with the DSL modem, for repeatedly acquiring"); *accord* cl. 10, 11, 12, 13, 17, 18). Patent Owner argues that "[u]nder the doctrine of claim differentiation, 'when . . . applicant[s] use[] different terms in a claim it is permissible to infer that [they] intended [their] choice of different terms to reflect a differentiation in the meaning of those terms.'" Prelim. Resp. 9–10 (citing *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1119 (Fed. Cir. 2004)). Patent Owner points out that "[t]he '996 Patent uses 'periodically' in claim 20," and that "[t]his is different from the other claims, which use 'repeatedly.'" Patent Owner argues that "[t]he '996 patent manifestly intends to express different meanings with each of these two terms." Prelim. Resp. 11.

As noted earlier, the District Court recently issued its Claim Construction Order in the parallel proceeding. There, the District Court determined that the term "periodically monitor" from claim 20 means to "monitor at regular intervals of time." Ex. 2013, 14–18. The District Court explained that "referring to 'regular' intervals rather than 'fixed' intervals is further appropriate in light of Plaintiff's acknowledgement at the March 19, 2025 hearing that the intervals need not be permanently unchanging." *Id.* at 18.

Based on this preliminary record, the weight of the evidence favors Patent Owner's proposed meaning of the term "periodically" as modified by the District Court, that the term "periodically" as used in claim 20 means to "monitor at regular intervals of time." Accordingly, we agree with Patent Owner's identified weaknesses in the Petition's merits, which supports the decision to discretionarily deny institution under *Fintiv*.

III. CONCLUSION

For the foregoing reasons, the evidence of record favors exercising discretion to deny institution of *inter partes* review under 35 U.S.C. § 314(a).

IV. ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314(a) the Petition is *denied* and no trial is instituted.

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