

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

ERICSSON INC. and CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,
Petitioners,

v.

PROCOMM INTERNATIONAL PTE. LTD.,
Patent Owner.

Case No. IPR2024-01452

U.S. Patent No. 8,583,100

PATENT OWNER'S REQUEST FOR DISCRETIONARY
DENIAL OF INSTITUTION

TABLE OF CONTENTS

	<u>Page</u>
I. THE DIRECTOR SHOULD EXERCISE DISCRETION UNDER SECTION 314 AND DENY INSTITUTION	1
A. Factor 1.....	3
B. Factor 2.....	4
C. Factor 3.....	6
D. Factor 4.....	8
E. Factor 5.....	11
F. Factor 6.....	12
II. CONCLUSION	19

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Harmonic Inc. v. Avid Tech.</i> , 815 F.3d 1356 (Fed. Cir. 2016)	1
--	---

Statutes

35 U.S.C. §314.....	1, 4, 7
35 U.S.C. §316.....	4

Agency Decisions

<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).....	2, 12
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 15 (PTAB May 13, 2020)	2
<i>Ericsson Inc. et al v. Collison Communications, Inc.</i> , IPR2022-01233, Paper 12 (PTAB Jan. 19, 2023)	5
<i>General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential, designated Oct. 18, 2017)	6
<i>Google LLC v. EcoFactor Inc.</i> , IPR2021-00454, Paper 9 (PTAB July 22, 2021).....	10
<i>International Business Machines Corporation v DigitalDoors, Inc.</i> , IPR2023-00967, Paper 7 (PTAB Dec. 1, 2023)	5
<i>LG Elecs., Inc. v. Ancora Techs., Inc.</i> , IPR2021-00581, Paper 16 (PTAB June 10, 2021)	10
<i>NHK Spring Co. v. Intri-Plex, Inc.</i> , IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019).....	1, 6

<i>Roku, Inc. v. IOENGINE, LLC,</i> IPR2022-01554, Paper 11 (PTAB May 5, 2023)	10
<i>Samsung Electronics Co. Ltd. v. California Institute of Tech.,</i> IPR2023-00130, Paper 10 (PTAB May 4, 2023)	10, 11
<i>Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC,</i> IPR2019-01393, Paper 24 (PTAB June 16, 2020)	9, 10

EXHIBIT LIST	
2001	Docket Control Order in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.)
2002	Opening Claim Construction Brief in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.)
2003	Plaintiff's Opposition to Defendants' Motion to Stay in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24cv-009-RWS-RSP (E.D. Tex.)
2004	United States District Courts—National Judicial Caseload Profile for 12-month period ending June 30, 2024; available at https://www.uscourts.gov/statistics-reports/analysis-reports/federalcourtmanagement-statistics
2005	LegalMetric District Report for Texas Eastern District Court in Patent Cases (January 2019-April 2024)
2006	April 6, 2025 Order denying Defendants' Motion To Stay in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24cv-009-RWS-RSP, Dkt. No. 62 (E.D. Tex.)
2007	Plaintiff's infringement contentions dated March 20, 2024 in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.)
2008	Defendant's invalidity contentions dated June 12, 2024 in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.)
2009	Comparison of Petition to Ex. 1003 (Houh Declaration)
2010	Transcript of January 30, 2025 Deposition of Dr. Henry Houh in IPR2024-00710
2011	Transcript of January 31, 2025 Deposition of Dr. Henry Houh in IPR2024-00723

Pursuant to Acting Director Stewart’s March 26, 2025 Memorandum titled “Interim Processes for PTAB Workload Management” (“March 26, 2025 Memorandum”), Patent Owner Procomm International Pte. Ltd (“Procomm”) respectfully requests that the Director exercise her discretion and deny institution of Petitioners Ericsson Inc. and Cellco Partnership’s Petition for *inter partes* review of U.S. Patent No. 8,583,100.

I. THE DIRECTOR SHOULD EXERCISE DISCRETION UNDER SECTION 314 AND DENY INSTITUTION

The Director should deny institution under 35 U.S.C. §314 because all six *Fintiv* factors favor discretionary denial. The district court trial is scheduled nine months in advance of the deadline for a Final Written Decision in this IPR.

The *inter partes* review statute leaves institution entirely at the discretion of the Director. *See* 35 U.S.C. §314(a); *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.*

The Director has historically applied that discretion where efficiency considerations stemming from parallel proceedings on the same patent warrant denial of institution. *See NHK Spring Co. v. Intri-Plex, Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (“*NHK Spring*”).

The Director has considered 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.

Here, all six *Fintiv* factors weigh in favor of discretionary denial, the Petition is particularly weak on the merits, and Petitioners have not even bothered to submit a *Sotera*-type stipulation. Moreover, additional considerations including the petition’s reliance on expert testimony and settled expectations of the parties both weigh in favor of discretionary denial. Procomm thus respectfully requests that the Director 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. Petitioners’ motion to stay was denied as premature by the district court on April 6, 2025. EX2006 [Decision Denying Motion To Stay]. The order explained that “[t]he ‘universal practice’ in this District, as well as the practice of most district courts, is to deny a motion for stay when the Patent Trial and Appeal Board has not yet acted on a petition for inter partes review.” *Id.* “The reasoning behind this is that unless the Board indicates there is a serious chance it will invalidate all the asserted claims, the Court will not needlessly wait to rule on the remaining asserted claims.” *Id.*

Even post-institution, the district court judge is unlikely to stay the case pending an IPR absent agreement from the parties. EX2005 [Legal Metric], 3 (showing 15% win rate on contested motions to stay pending IPRs in the ED Tex).

The advanced nature of the district court case makes it even more unlikely that the judge would issue a stay pending resolution of this IPR. 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 strongly in favor of denial because the jury trial will take place nine months before any Final Written Decision. Patent Owner’s Complaint was served on January 10, 2024. Petitioners filed this IPR on December 31, 2024. Thus, Petitioners waited nearly a year to file this IPR.

The Notice of Filing Date Accorded to the Petition was mailed on January 29, 2025. Paper 4. A Final Written Decision could therefore issue as late as July 29, 2026. *See* 35 U.S.C. §314(b); 35 U.S.C. §316(a)(11).

Because Petitioners waited until the last minute to file their IPR, the parallel district court litigation has already proceeded to an advanced stage and the district court has already scheduled jury selection for October 20, 2025. EX2001 (Docket Control Order). Thus, the Final Written Decision in this IPR is not expected until *nine months* after the trial.

The result is similar even when considering the median time from filing to disposition of the civil trial for the parallel litigation in the Eastern District of Texas rather than the scheduled trial date. The current median time to trial in the Eastern District of Texas is 23 months. EX2004, 35. The district court litigations were filed on January 8, 2024. Paper 6, 2. These statistics suggest that the trial would occur around December 2025. Thus, even using the median time to trial statistics, trial is expected seven months before the expected Final Written Decision.

“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.” *Fintiv I*, 9. *See also International Business Machines Corporation v Digital Doors, Inc.*, IPR2023-00967, Paper 7 at 9-10 (PTAB Dec. 1, 2023) (Factor 2 “favors exercising our discretion to deny institution” where trial was scheduled “about three and a half months before the statutory deadline for our final written decision.”); *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). The 9-month gap between the district court trial and the final written decision here is longer than in cases where the Board previously

denied institution. Thus, this factor weighs heavily in favor of denying institution.

Id.

Finally, granting institution here would frustrate one of the primary objectives of the AIA “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 would not be an “alternative” to parallel litigation. Rather, it would simply relitigate issues that had already been decided in the parallel litigation.

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 strongly 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 completed claim construction briefing. EX2001, 4-5; EX2007 [Infringement Contentions]; EX2008 [Invalidity Contentions]. The claim construction hearing was held on April 22,

2025. *Id.*, 3. Expert discovery closes on July 7, 2025, and dispositive and Daubert motions are due on July 14, 2025. *Id.* Responses will be due on July 28, 2025. *Id.*

By the expected July 29, 2025 decision on institution date (*see* 35 U.S.C. §314(b)), the District Court will have held a *Markman* hearing and the parties would have completed fact and expert discovery and filed dispositive and *Daubert* motions. *Id.* Thus, by the expected time of the decision on institution, most of the substantive work will have already been completed in the district court litigation and the parallel litigation will be preparing for trial. *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.”). Under these circumstances, it would be an extremely inefficient use of the parties’ and the Board’s time and resources to relitigate issues that will almost certainly be decided before the expected deadline to file a Patent Owner Response in this IPR.

Finally, Petitioners are solely responsible for this course of events. Petitioners waited until ten days before the one-year statutory deadline before filing this IPR and, in doing so, allowed the parallel district court litigation to advance substantially ahead of the expected schedule of this IPR. Petitioners received Patent Owner’s infringement contentions on March 20, 2024—nearly

nine months before this IPR was filed. EX2007 [Infringement Contentions], 8. Petitioners' invalidity contentions were served on June 12, 2024. EX2008 [Invalidity Contentions], 106. There is no reason for Petitioners to delay until December 31, 2024—over 6 months after they had served their invalidity contentions—to file an IPR. It would be unfair to require Procomm to duplicate work that has already been done in the parallel litigation because of Petitioners' delays. *See Fintiv II*, 14. 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. Independent claims 15 and 19 of the '100 Patent are asserted in the parallel litigation. Ex2007 [Infringement Contentions], 2. The Petition also challenges claims 15 and 19, in addition to independent claims 1 and 8 and several dependent claims using a single ground. Pet., 19. Each of the independent claims is substantially similar and is directed to generating and transmitting duplicate RF signals between a host and remote antenna units. Claims 1 and 19 are directed to a distributed base station (or remote wireless

communication station) that generates and transmits the claimed duplicate RF signal. Claims 8 and 15 are similarly directed to methods for generating and transmitting a duplicate RF signal.

Thus, the claims and prior art presented in this IPR will largely overlap with claims and prior art at issue in the parallel litigation, where validity will be determined approximately nine months before the FWD in this IPR.

Furthermore, Petitioners have not submitted a *Sotera*-type stipulation to remove the grounds that it could reasonably have raised in this IPR from the parallel litigation. Thus, it is anticipated that issues implicated by Petitioners' references in this IPR would rearise in the parallel litigation. Both these facts favor denying institution.

Petitioners argue that factor 4 weighs against discretionary denial because they "stipulate that if the IPR is instituted, it will not pursue the same grounds in the district court litigation." Pet., 86 (*citing Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 (PTAB June 16, 2020)). This "*Sand Revolution*"-style stipulation should be entitled to no weight because it only precludes Petitioners from pursuing the exact grounds in the Petition and does not preclude Petitioners from reusing the same prior art in different grounds with minor modifications. The Board has historically assigned

almost no weight to *Sand Revolution* style stipulations such as the one Petitioners filed here. *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). A *Sand Revolution*-style stipulation does little to eliminate overlap with the district court litigations, and Petitioners' stipulation here 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 or tertiary references. Thus, Petitioners' stipulation is almost meaningless.

To the extent the Director is inclined to consider Petitioners' *Sand Revolution*-style stipulation, 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 petitioners' 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 stronger blanket stipulation not to assert the primary referenced Hellman under any circumstance. The Board there agreed with the patent owner that, even with the petitioners’ 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*. Procomm submits that Petitioners’ meaningless stipulation should be assigned no weight. Accordingly, factor 4 favors discretionary denial.

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 strongly in favor of discretionary denial. Petitioner has unduly delayed in filing this IPR, the merits of the Petition are weak, Petitioners’ expert is not a POSA and has submitted a declaration parroting the unsupported arguments in the Petition, and the advanced age of these patents and length of time the claims have been in force (12 years) has resulted in settled expectations of the parties that the enforceability of the patents.

Delay: First, the *Fintiv* decision places a heavy emphasis in Factor 6 on whether the petition was filed expeditiously, specifically, whether the petition was filed “promptly after becoming aware of the claims being asserted.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), 11-12.

Petitioners have only themselves to blame for these IPRs being so far behind the district court. Petitioners filed this IPR on December 31, 2024—only ten days before the statutory deadline of January 10, 2025. There was no reason to delay a

year in filing IPRs. The Petition challenges every claim in the '100 Patent, so Petitioners were not waiting for infringement contentions to determine which claims were being asserted in the district court. But even if they had been, infringement contentions in the district court litigation were served on March 20, 2024—nearly nine months before this IPR was filed. EX2007 [Infringement Contentions], 8. Petitioners' delay weighs in favor of discretionary denial under Factor 6.

Merits: Second, the merits of the Petition are particularly weak. The primary reference used in the Petition's single ground—Aarflot—discloses exactly the sort of “centralized base station” that the '100 Patent distinguishes over and improves on. The '100 Patent explains that “[t]raditional wireless communication systems may have distributed antennas to expand the range of a centralized base station.” EX1001, ['100 Patent]. Aarflot's “distributed radio base station” is precisely this sort of “centralized base station.” EX1004 [Aarflot], 1:24-27 (“The present invention is directed to distributed radio base stations where a base station includes a main baseband processing unit coupled to one or more remote radio units where RF processing occurs.”). The '100 Patent explains that centralized base stations like Aarflot have a number of problems because “[a]ny signals received by the distributed antennas must be sent back to the centralized base station for

processing regardless of where the ultimate destination of the signal is located.”

EX1001 [’100 Patent], 1:18-21. These problems include “unneeded transmission of signals,” “increased latencies for users of the system,” and capacity issues that “cause unacceptable disruption of services for some users of the system.” EX1001 [’100 Patent], 1:16-26.

To fix the problems caused by centralized base stations like the one disclosed in Aarflot, the ’100 Patent discloses several solutions, including that each remote antenna can be co-located with its own router (*id.*, 1:43-45), and that one or more remote antenna units can be co-located with its own base station. *Id.*, 2:56-62, 9:5-15.

These solutions clearly distinguish the claims of the ’100 Patent over Aarflot. As a result, many claim limitations are completely missing from Aarflot and the Petition.

One clear example is that claim 1 requires (1) a host and (2) a remote base station that is co-located with a remote antenna unit. EX1001 [’100 Patent], cl. 1. Every other independent claim similarly requires (1) a host and (2) a base station (or baseband unit) that is co-located with a remote unit. *Id.*, cls. 8, 15, 19. The Petition alleges that Aarflot’s Radio Equipment Controller (REC) is the claimed

host, and that Aarflot's Radio Equipment (REs) are the claimed remote antenna units. Pet., 30-32.

Aarflot does not disclose anything that could be considered the claimed remote base station. Because Aarflot does not disclose anything that could be considered a remote base station co-located with Aarflot's REs, Petitioners allege that Aarflot's REC (or, alternatively the REC combined with a remote RE) is not only the host, but also simultaneously the "remote base station" that is by definition *remote* from the host. Pet., 34-35. But Petitioners' reasoning is circular. Aarflot's REC cannot simultaneously exist in two separate places at once as two distinct claim elements. The claims require an entire remote base station co-located at a remote antenna unit that is remote from the host, not (as is taught in Aarflot) a distributed base station with the control and baseband functionality (REC) at one location and the RE (which converts the baseband to radio frequencies) at a second location. Thus, Petitioners allege the impossible. Patent Owner's forthcoming POPR will address this completely missing limitation in more detail.

Because the '100 Patent is directed at least in part to resolving the issues presented by centralized base stations like those in Aarflot, Aarflot simply does not map to many of the claim limitations, including the "remote base station"

limitation. The secondary references relied on by Petitioners do little to rectify this issue. Thus, the merits here are particularly weak.

Third, the March 26, 2025 Memorandum provides additional discretionary considerations. These include the extent of the petition's reliance on expert testimony and settled expectations of the parties, such as the length of time the claims have been in force. These considerations further favor discretionary denial under *Fintiv* Factor 6.

Petitioners' Reliance On Expert Testimony: The Petition relies extensively on the declaration of Dr. Houh, citing approximately 200 times to Dr. Houh's Declaration is nearly a word-for-word copy of many sections of the Petition. EX2009 [Comparison] (showing that, other than for the Introduction, Qualifications, and Relevant Legal Standards sections, Dr. Houh's Declaration mostly copies sections from the Petition.) The comparison shows that pages 21-91 of the Petition and paragraphs 72-161 of Dr. Houh's Declaration present nearly identical arguments regarding the merits. EX2009 [Comparison]. The limited additional content in Dr. Houh's declaration is primarily block quotes from the alleged prior art that were likely deleted from the Petition to save word count. *See, e.g.,* EX2009 [Comparison], ¶73 (Dr. Houh quotes a sentence from Aarflot (EX1004) at 2:37-40 that the Petition cites without quoting). The Petition's failure

to provide focused expert testimony weighs against institution. *See, e.g.*, FAQs for Interim Processes for PTAB Workload Management, *available at* <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>.

Moreover, Dr. Houh does not qualify as a POSA under his own definition. Petitioners' expert Dr. Houh testifies that a person of ordinary skill would have been familiar with "radio network communications, including radio interfaces, base stations, remote antennas, baseband units and communication links." EX1003 [Houh Decl.], ¶48. Dr. Houh testifies that "A POSA would have gained knowledge of these concepts through a mixture of training and work experience," with, at a minimum "one to two years of [work] experience" for an individual with a "Master's degree in electrical engineering or related field." EX1003 [Houh Decl.], ¶49. But while Dr. Houh testifies that his qualifications are in "network communications," the experience he lists appears to be wired networks, not radio or wireless communications. It does not appear that the qualifications provided by Dr. Houh are sufficient to meet his own definition of a POSA. EX1003 [Houh Decl.], ¶¶11-22 (listing his expertise as "Web Site Development, Data Networking, Optical Networking, Telecommunications, and Media Streaming"—not radio network communications—and providing experience in computer networks,

telephone lines, Voice-over-IP, and speech recognition—again, not radio network communications).

The only mention of radios in Dr. Houh’s background is that a former classmate founded “a software radio company” sometime in the late 1990s and that Dr. Houh would sometimes speak with him. EX1003 [Houh Decl.], ¶14. But the fact that Dr. Houh knew somebody 30 years ago that might qualify as a POSA and that they spoke about software radios occasionally does not mean Dr. Houh himself qualifies as a POSA. Indeed, Dr. Houh’s POSA definition requires at least “one to two years” of work experience in radio communication networks (EX1003 [Houh Decl.], ¶49), but Dr. Houh identifies no actual work experience in that field.

Dr. Houh’s lack of specific expertise and parroting of the Petition is not surprising. Dr. Houh’s testimony in other IPRs establishes that Dr. Houh works on a large number of IPRs and issues declarations at an unsustainable rate. Each year, Dr. Houh works on an astonishing number of IPRs, so many that he submits up to 60 sworn declarations in a year. EX2011 (Dep. Trans. Houh IPR2024-00723), 14:10-19. Nearly 100% of Dr. Houh’s employment income is from expert witness fees for IPRs. EX2010 (Dep. Trans. Houh IPR2024-00710), 9:6-18; EX2011, 9:16-10:10, 11:6-9. Dr. Houh is affixing his signature to declarations—most well over 100 pages long—after he (with the assistance of counsel) (1) researches, (2) drafts,

and (3) finalizes them at the pace of about one declaration per week. EX2010, 44:2-7 (declarations are typically 120-150 pages). And approximately 90% of his work is for IPR petitioners. *Id.*, 8:14-21; EX2011, 6:12-14.

These facts demonstrate that Dr. Houh is writing declarations at a breakneck pace, delivering an average of one declaration each week. These factors could be expected to affect the reliability of any expert's opinions, and, as demonstrated by Dr. Houh's lack of experience with radio communication networks and copycat declaration, they appear to have done so here. Accordingly, Petitioner's reliance on expert testimony favors noninstitution.

Settled Expectations: Finally, settled expectations further weigh in favor of non-institution. The '100 Patent issued on November 12, 2013, almost 12 years ago. Since the '100 Patent was filed on January 25, 2007, most of the life of the patent has already passed. 35 U.S. Code §154(a)(2). Patent Owner respectfully submits that it has a settled expectation to its property rights based on the length of time the claims have been in force, and this expectation weighs against institution.

Accordingly, all six *Fintiv* factors weigh in favor of discretionary denial.

II. CONCLUSION

For the foregoing reasons, the Director should deny institution.

Dated: April 28, 2025

Respectfully submitted,

/ Stephen McBride /

Stephen McBride (Reg. No. 78,396)

CARMICHAEL IP, PLLC

8607 Westwood Center Drive, Suite 270

Tysons, VA 22182

Tel: (703) 646-9247

stevemcbride@carmichaelip.com

Counsel for Patent Owner

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner's Request For Discretionary Denial of Institution consists of 3,995 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The Request complies with the type-volume limitation of 14,000 words set out at 37 C.F.R. §42.24 and Acting Director Stewart's March 26, 2025 Memorandum titled "Interim Processes for PTAB Workload Management." In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

Dated: April 28, 2025

/Stephen McBride/

Stephen McBride (Reg. No. 78,396)

CARMICHAEL IP, PLLC

8607 Westwood Center Drive

Suite 270

Tysons, VA 22182

Tel: (703) 646-9247

stevemcbride@carmichaelip.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that, pursuant to 37 CFR § 42.6(e), a true and correct copy of the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** has been served electronically via email on counsel of record for Petitioners:

Ericsson and Verizon counsel:

Patrick D. McPherson
Patrick Craig Muldoon
D. Joseph English
Duane Morris LLP
901 New York Avenue N.W., Suite 700 East
Washington, D.C. 20001
Email: PDMcPherson@duanemorris.com
Email: PCMuldoon@duanemorris.com
Email: DJEnglish@duanemorris.com
Email: DC-IPdocketing@duanemorris.com

Verizon counsel:

Kevin P. Anderson
Duane Morris LLP
901 New York Avenue N.W., Suite 700 East
Washington, D.C. 20001
Email: KPAnderson@duanemorris.com

Dated: April 28, 2025

Respectfully submitted,

By: /Stephen McBride/
Stephen McBride