

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 REPLY IN SUPPORT OF REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION

PATENT OWNER'S EXHIBIT LIST

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 in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.) dtd March 20, 2024
2008	Defendant's P.R. 3-3 and 3-4 Disclosures (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	Relevant Excerpts From Transcript of January 30, 2025 Deposition of Dr. Henry Houh in IPR2024-00710.
2011	Relevant Excerpts From Transcript of January 31, 2025 Deposition of Dr. Henry Houh in IPR2024-00723.
2012	Amended 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.) dtd June 4, 2025 (Dkt. 80) – NEW

Pursuant to Acting Director Stewart’s June 10 and 11, 2025 authorizations (Exs. 3101, 3102), Patent Owner Procomm International Pte. Ltd (“Procomm”) files this Reply in support of Patent Owner’s Request for Discretionary Denial.

I. The Amended Docket Control Order Strongly Supports Non-Institution

On June 4, 2025, the district court issued an Amended Docket Control Order moving trial to February 17, 2026. Ex. 2012, 1. Thus, trial here will occur approximately five months before the July 2006 expected final written decision date. PO Br. at 4. Further, the current median time to trial in the Eastern District of Texas suggest that trial would occur around December 2025. EX2004, 35.

In *Arm Ltd. and Mediatek Inc. v. Daedalus Prime LLC*, IPR2025-00207, Paper 10 (PTAB May 16, 2025), the Director denied institution where trial was scheduled five months before the projected final written decision due date and a month or two after the median time-to-trial statistics indicated. The Director in *Arm* held that under those facts, “it is unlikely that a final written decision in this proceeding will issue before district court trial occurs.” *Id.*, 2.

The facts here weigh even more strongly in favor of discretionary denial. Similar to *Arm*, trial is scheduled approximately five months before the final written decision is expected. Further, the median time to trial statistics indicate trials in the Eastern District of Texas would typically take place eight months

before the final written decision in this IPR is due to issue. Ex. 2004 [Judicial Caseload Statistics], 35. Thus, the trial date is unlikely to move.

Petitioners waited nearly a year after being served with a complaint to file this IPR, placing the trial date well ahead of the expected final written decision date in this IPR. Accordingly, *Fintiv* Factor 2 strongly favors denial of institution.

II. *Sotera* Stipulations Have Limited, If Any, Estoppel Effect

Petitioners' Opposition presents a *Sotera* stipulation and argues that under *Fintiv* Factor 4, "[i]n view of Petitioners' *Sotera* stipulation, there will be no overlap between the issues raised in the Petition and issues to be adjudicated in the Related Litigation." Pet. Br. at 2, 6. Petitioner is wrong for several reasons.

First, Petitioners ignore the USPTO's clear guidance to the contrary. The USPTO's FAQs for Interim Process for PTAB Workload Management ("FAQs") explain that "[w]here the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited." *Id.*, FAQ 14. Similarly, the Director held in *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (PTAB March 28, 2025) that a *Sotera* stipulation does not ensure that the "IPR proceedings would be a 'true alternative' to the district court proceeding." *Id.* at 3-4. This is especially true

where Petitioners invalidity arguments rely on “unpublished system art, which [a *Sotera* stipulation] is not likely to moot. *Id.*, 4.

Petitioners are relying on system art in their invalidity contentions. *See* Ex. 2008 [Defendants’ Invalidity Contentions], 17 (identifying “Vanu, Inc.’s Anywave Base Station System, which was publicly available and/or in public use as of 2006” as alleged prior art to the ’100 Patent). Thus, the *Sotera* stipulation is not a “true alternative” to the district court invalidity proceedings.

Second, Petitioners’ statements ignore the Federal Circuit’s recent decision in *Ingenico Inc. v. IOENGINE, LLC*, 2025 WL 1318188 (Fed. Cir. 2025), which gutted IPR estoppel. *Ingenico* held that “IPR estoppel does not preclude a petitioner from asserting the same prior art raised in an IPR in district court.” *Id.* at *7. Under *Ingenico*, the same prior art that was raised in an IPR petition is not estopped from use in different grounds in the district court litigation. That is, “IPR estoppel does not preclude a petitioner from asserting that a claimed invention was known or used by others, on sale, or in public use in district court” based on the same prior art used in the IPR. *Id.* at *7.

Sotera stipulations parrot the IPR estoppel statute (35 U.S.C. § 315(e)(2)), but apply at the decision on institution rather than the final written decision. Thus, *Sotera* stipulations are bound by *Ingenico*.

The prior art in this IPR demonstrates the futility of *Sotera* stipulations under *Ingenico*. The '100 Patent has an earliest effective filing date of January 25, 2007. Ex. 1001 ['100 Patent], (22). The Aarflot reference that is the primary reference for every challenged claim in this IPR was filed as a PCT application that first published on April 20, 2006 as WO2006/040653. Ex. 1004 [Aarflot], (87). As a publicly-available document, WO2006/040653 was “known ... by others in this country” under 35 U.S.C. §102(a) (pre-AIA) and would be available for use in the district court even with a *Sotera* stipulation. Similarly, the secondary reference Wiedeman is a U.S. patent that issued on January 10, 2006. Ex. 1009 [Wiedeman], (45). Under *Ingenico*, Wiedeman can be used in this IPR as a patent and reused in the district court in the exact same manner as prior art that was “known by others” prior to the '100 Patent's earliest effective filing date. *Sotera* stipulations under *Ingenico* should be given little if any weight.

Because Petitioners' *Sotera* stipulation has no meaningful effect on the invalidity proceedings in the district court, *Fintiv* Factor 4 strongly favors denial.

III. *IRhythm* Supports Non-Institution

Settled expectations weigh in favor of denial due to Ericsson's knowledge of related Procomm applications and failure to seek early review of the '100 Patent. In *IRhythm Technologies, Inc. v Welch Allyn, Inc.*, IPR2025-00363 Paper 10 at 3

(PTAB June 6, 2025) (“Petitioner’s awareness of Patent Owner’s applications and failure to seek early review of the patents favors denial and outweighs” other factors favoring institution.)

Here, U.S. Pat. No. 10,341,229, assigned to Telefonaktiebolaget LM Ericsson, cites to WO 2008/092069. WO 2008/092069 is the WIPO Publication of PCT/US08/52026, a continuation of U.S. Appl. No. 11/627,255. The ’255 Application issued as the ’100 Patent. Ex. 1001 [’100 Patent], (21). Telefonaktiebolaget LM Ericsson, the parent company of Petitioner Ericsson Inc., is a real-party-in-interest in this IPR. Paper 3 [Pet.], 93.

As a continuation, the disclosure in the ’069 Publication is substantially the same as the ’100 Patent. Ericsson has been aware of WO 2008/092069 since at least April 4, 2016, when Ericsson identified the application in an IDS to the USPTO.). Despite that knowledge, Ericsson never sought earlier review of the ’100 Patent via reexamination or IPR. Thus, Patent Owner’s settled expectations favor denial of institution.

IV. Conclusion

For the foregoing reasons, the Director should deny institution.

Dated: June 12, 2025

Respectfully submitted,

/ Stephen McBride /

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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 REPLY IN SUPPORT OF REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** has been served electronically via email on counsel of record for Petitioners:

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