

IN THE 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.

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

Issue Date: Nov. 12, 2013

Title: DISTRIBUTED REMOTE BASE STATION SYSTEM

Inter Partes Review No.: IPR2024-01452

**PETITIONERS' SUR-REPLY IN OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PETITIONERS' EXHIBIT LIST

<i>Exhibit</i>	<i>Description</i>
1001	U.S. Patent No. 8,583,100 (the "'100 Patent")
1002	Select portions of prosecution history of the '100 Patent ("File History")
1003	Declaration of Petitioners' Expert Henry Houh ("Houh")
1004	U.S. Patent No. 8,908,650 to Aarflot et. al. ("Aarflot")
1005	U.S. Patent Application Publication No. 2008/0045254 to Gupta et. al. ("Gupta")
1006	U.S. Patent No. 6,785,558 to Stratford et al. ("Stratford")
1007	U.S. Patent No. 6,963,552 to Sabat et al. ("Sabat")
1008	U.S. Patent Publication 20090129314 A1 to Weniger et. Al. ("Weniger")
1009	U.S. Patent No. 6,985,454 to Wiedeman et al. ("Wiedeman")
1010	U.S. Patent No. 7,899,495 B2 to Laroia et al. ("Laroia")
1011	J. Kerpez, "A radio access system with distributed antennas," in <i>IEEE Transactions on Vehicular Technology</i> , vol. 45, no. 2, pp. 265-275, May 1996, ("Kerpez")
1012	J. H. Winters, J. Salz and R. D. Gitlin, "The impact of antenna diversity on the capacity of wireless communication systems," in <i>IEEE Transactions on Communications</i> , vol. 42, no. 234, pp. 1740-1751, FEBRUARY/MARCH/APRIL 1994 ("Winters").
1013	Related Patents
1014	UTRAN Iub Interface Data Transport and Transport Signalling for Common Transport Channel Data Streams (Release 4) 3GPPTS 25.434 V.4.4.0 (2002-2006)
1015	Common Public Radio Interface (CPRI); Interface Specification, CPRI Specification V2.0 (2004-10-01)
1016	U.S. Patent No. 8,380,198 to Etemad et al. ("Etemad")
1017	International Publication No. WO 2006/040653 to Aarflot.

<i>Exhibit</i>	<i>Description</i>
1018	ORDER denying Defendants' Opposed Motion to Stay Pending <i>Inter Partes</i> Review as premature in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D.Tex.)
1019	Defendants' Opposition to Plaintiff Procomm International Pte. LTS.'s Motion for Leave to Amend Infringement Contentions (Dkt. 52) in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D.Tex.)
1020	ORDER granting in part Procomm's Motion for Leave to Amend Infringement Contentions (Dkt. 76) in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D.Tex.)
1021	Joint Request to Amend the Docket Control Order (Dkt. 77) in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D.Tex.)
1022	Second Amended Docket Control Order (Dkt. 100) in <i>Aspen Networks, Inc. v. AT&T Mobility, LLC</i> , No. 2:23-cv-00476-RWS-RSP (E.D.Tex.)
1023	Excerpt from Zenious et al., BIODESIGN; THE PROCESS OF INNOVATING MEDICAL TECHNOLOGIES (EX-2010 in <i>iRhythm, Inc. v. Welch Allyn, Inc.</i> , IPR2025-00363)

*Petitioners' Sur-Reply in Opposition to Patent Owner's
Request for Discretionary Denial of Institution*

Pursuant to Acting Director Stewart's authorization (EX-3101), Petitioners hereby submit this Sur-Reply in opposition to Procomm's Request for Discretionary Denial ("Request").

I. The Amended Docket Control Order

Since Procomm filed its Request, the district court has delayed the scheduled trial by four months, with the trial presently scheduled to begin February 17, 2026. EX-2018 1. However, there are presently at least seven (7) cases before this district court judge that are scheduled to begin trial on that same date – necessitating the delay of several of those cases. Thus, there is a strong likelihood that the trial may be delayed even further, such that, to the extent the presently scheduled trial date favors denial of institution, it should be given little weight. Nonetheless, the *Sotera* stipulation and the strength of the merits far outweigh this factor in support of institution.

II. The *Sotera* Stipulation

Petitioners have made a *Sotera* stipulation and have represented that they are not relying on any corresponding system art in the Related Litigation to challenge the '100 Patent. Pet. Opp. 3, 9.

Procomm alleges that "Petitioners ignore the USPTO's clear guidance to the contrary" that *Sotera* stipulations do not eliminate overlapping issues while providing quote from FAQ 14. Reply 3. However, Procomm ignores the

important distinction made by FAQ 14 that the system art must be **corresponding** system art: “Where 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.” FAQ 14. Here, Petitioners do not rely on corresponding system art in the Related Litigation and Procomm has made no attempt to show that the system art identified in Ericsson’s invalidity contentions corresponds to any prior art relied upon in the Petition. Thus, there is no factual support for Procomm’s arguments regarding *Sotera*.

Procomm’s reliance on the Director’s decision in *Motorola Solutions* is also misplaced and ignores the factual basis of the decision that “Petitioners invalidity arguments in the district court are more expansive and **include combinations of the prior art asserted in these proceedings with unpublished system prior art**, which Petitioner’s stipulation is not likely to moot.” *Motorola Solutions*, Paper 19 at 4 (emphasis added). Here, Procomm provides no evidence that Petitioners invalidity arguments include combinations of the prior art asserted in the Petition with unpublished system art.

Finally, Procomm’s argument that under *Ingenico*, “Petitioners could argue that **Sterner** was ‘known ... by others in this country’” is nonsensical. Reply 4 (emphasis added). *Ingenico* merely clarified that “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. These are different grounds that could not be raised during an IPR.” *Ingenico Inc. v. IOENGINE, LLC*, No. 2023-1367 (Fed. Cir. May 7, 2025) at 16 (emphasis added).

Sotera remains precedential, and the stipulation under *Sotera* “weighs strongly in favor of not exercising discretion to deny institution under 35 U.S.C. § 314(a).” *Sotera*, Paper 12 at 19.

III. The *iRhythm* Decision

Procomm argues that the recent decision in *iRhythm* supports discretionary denial but fails to identify the underlying factual basis supporting the conclusion of the Director in *iRhythm*, and how that underlying factual basis relates to the facts of the present case.

Procomm relies solely on the listing of a WIPO publication of a PCT application that is a continuation of an application that issued as the '100 Patent on an IDS in a U.S. patent application pending in 2016 owned by the parent company of Ericsson. Procomm provides no evidence that the listed publication was relied upon or discussed by the examiner during prosecution, or that Ericsson had any knowledge that the publication was a continuation of an application that issued as the '100 Patent. The law is well settled that the mere knowledge of a patent does not confer knowledge of infringement of the patent under the patent statute.

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Amsted Industries Inc. v. Buckeye Steel Casting Co., 24 F.3d 178, 187 (Fed. Cir. 1994). Similarly, here, the mere listing of a WIPO publication of an application that is a continuation of an application that issued as the '100 Patent does not confer sufficient knowledge of the '100 Patent upon Ericsson to seek early review of the patent absent a claim of infringement.

The decision by the Director in *iRhythm* does not support the contention by Procomm that Ericsson had knowledge of the '100 Patent prior to the Related Litigation such that there was a settled expectation between the parties as to the patentability of the '100 Patent.

In *iRhythm*, the Patent Owner established an expectation between the parties with evidence showing that a former engineer and founder of the petitioner was particularly focused on the IP landscape related to petitioner iRhythm's heartrate monitor technology, specifically identifying petitioner iRhythm's IP searches focused on patents and pending applications, detailed review of the prior art including analysis of specific claims, and identifying challenged patents on IDSs filed in its own pending applications. *iRhythm* Paper 7 29-31; *citing* EX-1023.

Here, Procomm has provided no evidence to establish a settled expectation among the parties that the '100 Patent was patentable. To the contrary, the settled expectation among the parties was that Petitioners were not infringing the '100

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Patent by selling the accused products free from any claims of infringement for over six years.

IV. Conclusion

The Director should deny Procomm's request for discretionary denial of institution.

Respectfully submitted,

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Dated: June 16, 2025

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CERTIFICATION OF SERVICE

I hereby certify that on June 16, 2025, a copy of Petitioner's Sur-Reply in Opposition to Patent Owner's Request for Discretionary Denial was filed by filing this document through the PTACT's System as well as delivering a copy via electronic mail upon the following:

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