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. 7,103,377
Issue Date: September 5, 2006
Title: SMALL SIGNAL THRESHOLD AND PROPORTIONAL GAIN DISTRIBUTED DIGITAL COMMUNICATIONS

Inter Partes Review No.: IPR2024-01453

PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

***Mail Stop* "*PATENT BOARD*"**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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Alexandria, VA 22313-1450

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PETITIONERS' EXHIBIT LIST

Exhibit	***Description***
1001	U.S. Patent No. 7,103,377 ("the '377 Patent")
1002	Prosecution history of the '377 Patent ("File History")
1003	Declaration of Petitioners' Expert Henry Houh
1004	U.S. Patent Application Publication No. US2003/0162516 to Solum ("Solum")
1005	International Patent Application Publication No. WO1998000996A1 to Naidu et al. ("Naidu").
1006	International Patent Application Publication No. WO01/95427 to Owen ("Owen")
1007	U.S. Patent No. 5,867,763 to Dean et al. ("Dean")
1008	Intentionally left blank
1009	Intentionally left blank
1010	Related Patents
1011	ORDER dismissing with prejudice each of (i) Procomm's claims of infringement of the '377 Patent; Ericsson's counterclaim for declaratory judgment of non-infringement of the '377 Patent; and (iii) Ericsson's counterclaim for declaratory judgment of invalidity of the'377 Patent in *Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.*, No. 2:24-cv-009-RWS-RSP (E.D.Tex.)

I. INTRODUCTION

Patent Owner ("Procomm") has requested discretionary denial of institution of the Petition for *inter partes* review of the '377 Patent (i) under Section 314(a) pursuant to *Fintiv* in view of the district court litigation, *Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.*, No. 2:24-cv-009-RWS-RSP (E.D.Tex.) ("Related Litigation"); and (ii) due to other considerations including the settled expectation of the parties and the reliability of Petitioners' expert.

However, this Opposition demonstrates Procomm's Request should be denied in the interest of efficiency, fairness, and patent quality.

First, the entirety of Procomm's request for discretionary denial pursuant to *Fintiv* is based on the erroneous premise that there is an ongoing parallel litigation. In fact, all claims related to the '377 Patent, including Petitioner Ericsson's counterclaim for a declaratory judgment of invalidity, were dismissed with prejudice on March 2, 2025. *See* EX-1011.

Second, notwithstanding the 2006 issuance of the '377 Patent, Procomm has accused products of infringing the '377 patent in the Related Litigation that have been on sale for at least six years free from any claim of infringement. Thus, Petitioners' settled expectation has been that it was not infringing the '377 Patent.

Finally, the Petition is properly supported by expert testimony that cites the underlying factual support.

II. THERE IS NO BASIS TO DENY INSTITUTION UNDER SECTION 314(A) PURSUANT TO *FINTIV*

The entirety of Procomm's request for discretionary denial pursuant to *Fintiv* is based on the erroneous premise that there is an ongoing parallel litigation. In fact, all claims related to the '377 Patent, including Petitioner Ericsson's counterclaim for a declaratory judgment of invalidity, were dismissed with prejudice on March 2, 2025. *See* EX-1011.

III. THE SETTLED EXPECTATION OF THE PARTIES FAVOR INSTITUTION

Procomm argues that the '377 Patent has been in force since 2006, and that Petitioners could have challenged the patent long ago but did not. However, Procomm ignores the fact that the products it accused of infringing the '377 Patent in the Related Litigation and has since withdrawn its claims with prejudice, had been on sale for at least six years free from any claim of infringement of the '377 Patent, or any other patent. Thus, Petitioners had no reason to challenge the '377 Patent prior to the Related Litigation. The Board should institute review to allow Petitioners to challenge a patent that was asserted six years after Petitioners began selling the accused products because Petitioners' settled expectation has been that it was not infringing the '377 Patent.

IV. THE PETITION IS PROPERLY SUPPORTED BY EXPERT TESTIMONY THAT CITES THE UNDERLYING FACTUAL SUPPORT

The Request asserts that "Dr. Houh testifies that his qualifications are in *network* communications, not wireless communications, and it does not appear that the qualifications provided by Dr. Houh are sufficient to meet his own definition of a POSA." Req. 16 (emphasis in original). However, Dr. Houh's testimony expressly states that he served as an "expert witness in over 150 patent-related cases where I wrote expert reports and testified in over 100 depositions on topics such as …… mobile wireless technologies." Because mobile wireless technologies encompass wireless communications, Procomm's assertion is without factual support.

The Request also asserts that "Dr. Houh's Declaration shows that the Declaration is merely a word-for-word copy of the Petition's arguments." Req. 17. However, Dr. Houh's declaration contains factual support for all of his opinions, and it is necessary that such opinions and factual citations be included in the Petition pursuant to 37 § 42.6(a)(3) which states that "arguments must not be incorporated by reference from one document into another document."

Thus, the Petition is properly supported by expert testimony that cites the underlying factual support.

V. CONCLUSION

For the foregoing reasons, the Director should deny Procomm's request for discretionary denial of institution.

Respectfully submitted,

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Dated: May 28, 2025

CERTIFICATION OF SERVICE

I hereby certify that on May 28, 2025, a copy of Petitioners' Opposition to Patent Owner's Request for Discretionary Denial of Institution 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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