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. IPR2024-01453

U.S. Patent No. 7,103,377

PATENT OWNER REPLY IN SUPPORT OF REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

Pursuant to Acting Director Stewart's June 11, 2025 authorization (Ex. 3101), Patent Owner Procomm International Pte. Ltd ("Procomm") files this Reply in support of Patent Owner's Request for Discretionary Denial.

I. It is inefficient for the Board to adjudicate the validity of a patent for which no case or controversy exists between the parties

Procomm's causes of action alleging infringement of the '377 Patent and Ericsson's counterclaim of invalidity were both dismissed ***with prejudice*** on March 2, 2025. Opp. (Paper 12) at 4 (citing Ex.1011). Thus, no case or controversy exists between the parties, and neither Procomm nor Ericsson may bring the same claim or cause of action based on the '377 Patent against the other ever again. Under these circumstances, it is inefficient for the Board to review the validity of the '377 Patent when the outcome of the proceeding would have no practical effect on the parties, now or in the future.

Indeed, if Procomm were to prevail, as is likely based on the unrebutted validity arguments presented in Procomm's Discretionary Denial Brief, the Federal Circuit would likely dismiss any attempted appeal by Ericsson because it cannot show the necessary injury in fact to establish Article III standing. *Phigenix, Inc. v. Immunogen, Inc.*, 845 F.3d 1168, 1171 (Fed. Cir. 2017) (dismissing appeal of IPR because petitioner has not alleged a harm that "actually exist[s]"); *AVX Corp. v. Presidio Components, Inc.*, 923 F.3d 1357, 1363 (Fed. Cir. 2019); *Apple, Inc. v. Qualcomm Inc.*, 992 F.3d 1378, 1383 (Fed. Cir. 2021); *Incyte Corp. v. Sun Pharm.*

Indus., Inc., 136 F.4th 1096, 1099 (Fed. Cir. 2025). Under *Phigenix* and its progeny affirmed just a month ago, Ericsson has no potential infringement liability based on the dismissal with prejudice and thus has not suffered an injury in fact sufficient to confer Article III standing for an appeal of this IPR. *Incyte*, 136 F.4th at 1100.

Article III standing serves to manage the federal court system's workload, promote judicial efficiency, and weed out speculative or hypothetical claims. Respectfully, these are the same aims espoused by Director Stewart in the March 26, 2025 Interim Processes for PTAB Workload Management Memorandum. *Id*. at 3 ("These processes aim to improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, reduce pendency in *ex parte* appeals, and promote consistent application of discretionary considerations in the institution of AIA proceedings."). If the validity of the '377 Patent is too remote from a case or controversy to be an effective use of a federal court's resources, then, respectfully, it is also an ineffective use of the Board's resources.

II. The Director's *iRhythm* Decision Supports Discretionary Denial

Ericsson has been aware of the '377 patent since at least 2013. During prosecution of Ericsson's US Patent No. 8,670,722, a PTO examiner identified the '377 Patent in a Notice of Reference Cited as relevant prior art to Ericsson's own

distributed antenna system. Ex.2015, 214. Ericsson thus knew of the ’377 Patent’s relevance to its own products – before any product accused of infringing the ’377 Patent was ever on sale. Opp. (Paper 12) at 8 (representing that “the products[] accused of infringing the ’377 Patent in the Related Litigation[] had been on sale for at least six years,” e.g. since 2019).

Yet despite its long-standing knowledge, Ericsson never sought early review of the ’377 Patent. In *IRhythm Technologies, Inc. v Welch Allyn, Inc*., IPR2025-00363 Paper 10 (PTAB June 6, 2025), the Director addressed a similar situation and held that “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. *Id.* at 3. Respectfully, the same should apply here. Ericsson never challenged the ’377 Patent over a decade when it knew that the ’377 Patent implicated its own products. Even after being accused of infringement, Ericsson waited almost to the year before challenging the ’377 Patent’s validity at the PTO. Respectfully, Ericsson’s pattern of inaction creates a reasonable expectation that the ’377 Patent is valid.

III. Conclusion

For the foregoing reasons, the Director should deny institution.

Dated: June 12, 2025

Respectfully submitted,

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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 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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