

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

Mail Stop "PATENT BOARD"

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. 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 <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D.Tex.)
1012	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").

Procomm filed its Request urging the Director to deny institution based on the assertion that there was ongoing parallel litigation. As demonstrated in Petitioners' Opposition, there is not, the '377 Patent was dismissed with prejudice several months ago. Now, in its Reply that it sought authorization to file, instead of a *mea culpa* for wasting the resources of the Board and Petitioners and withdrawing its baseless Request, Procomm reverses course and argues that the fact that there is no longer an ongoing parallel litigation supports its position too. However, the facts have not changed and Procomm should be prohibited from now arguing a new basis for denial.

In addition, Procomm urges the Director to deny Petitioners' right to challenge the '377 Patent by *inter partes* review because one of the Petitioners "never sought early review of the '377 Patent" based on an examiner's citation in an Ericsson patent application in 2013 – despite there being no case or controversy involving the '377 Patent until the Related Litigation was filed in 2024, at least six years after the accused products had been on sale.

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On the one hand, Procomm seeks denial because there is no longer an infringement claim – and on the other hand seeks denial because Petitioners did not challenge the patent until Procomm made an infringement claim. Procomm cannot have it both ways.

I. Procomm's Erroneous Request

Procomm filed its Patent Owner's Request for Discretionary Denial of Institution arguing that "[t]he Director should deny institution under 35 U.S.C. §314 because all six *Fintiv* factors favor discretionary denial." Req. 2. As set forth in Petitioners' Opposition, the entirety of Procomm's request pursuant to *Fintiv* was based on the erroneous premise that there was an ongoing parallel litigation when, in fact, the '377 Patent had been dismissed from the Related Litigation months earlier on March 2, 2025. Pet. Opp. 2, *citing* EX-1011.

In response, Procomm sought and was granted authorization to address the issue in a reply. However, in its Reply, Procomm fails to acknowledge that its Request was based on a misrepresentation, or to correct the misrepresentation by withdrawal of the baseless Request. To the contrary, Procomm improperly seeks to flip the basis of its Request by now urging the Director to deny institution because there is no longer a "case or controversy" involving the '377 Patent. Reply 1-2.

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However, a “case or controversy” involving a challenged patent is not a condition necessary for institution of an *inter partes* review, nor is the lack of a case or controversy sufficient basis for the Director to deny institution. In fact, Procomm argues in the remainder of its Reply that the Director should deny institution because “Ericsson never sought early review of the ’377 Patent” despite the fact that there was no case or controversy involving the ’377 Patent until Procomm filed an infringement claim in the Related Litigation in 2024 – over six years after Petitioners began selling the accused products. Procomm’s assertion that “the outcome of the proceeding would have no practical effect on the parties, now or in the future” ignores the fact that the dismissal with prejudice of Procomm’s infringement claims applies only to the products accused of infringement in the Related Litigation and may have no effect on future claims.

Because Petitioners were served with a complaint for infringement of the ’377 Patent more than one year ago, pursuant to 35 U.S.C. §315(b), Petitioners may not file another petition challenging the ’377 Patent even if Procomm asserts infringement of different products in the future.

Procomm also erroneously argues that validity arguments presented in the Request are un rebutted. To the contrary, Procomm failed to file a POPR such that the merits of the Petition are un rebutted. The “validity arguments” made in the

Request were made in the context of a *Fintiv* analysis under the erroneous premise of an ongoing parallel litigation and are thus irrelevant to the merits of the Petition.

II. 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 the '377 Patent among eleven references in a Notice of References Cited by an examiner in an application filed by Ericsson pending in 2013. The '377 Patent was not relied upon or otherwise even mentioned by the examiner during prosecution. 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. *Amsted Industries Inc. v. Buckeye Steel Casting Co.*, 24 F.3d 178, 187 (Fed. Cir. 1994). Similarly, here, the mere listing of the '377 Patent by the examiner in a pending application filed by Ericsson, does not confer sufficient knowledge of the 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 the mere listing of the '377 Patent by an examiner in an application

pending in 2013 conferred “long-standing knowledge” of the patent upon Ericsson such that there was a settled expectation between the parties as to the patentability of the '377 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-1012.

Here, Procomm has provided no evidence to establish a settled expectation among the parties that the '377 Patent was patentable. To the contrary, the settled expectation among the parties was that Petitioners were not infringing the '377 Patent by selling the accused products free from any claims of infringement for over six years.

III. Conclusion

The Director should not discretionarily deny institution where there is no parallel litigation.

Respectfully submitted,

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DUANE MORRIS LLP

BY: /Patrick D. McPherson/

Patrick D. McPherson

USPTO Reg. No. 46,255

Duane Morris LLP

901 New York Avenue N.W., Suite 700 East

Washington, D.C. 20001

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:

James Carmichael
jim@carmichaelip.com

Amanda Sewanan
amanda.sewanan@srz.com

Stephen McBride
stevemcbride@carmichaelip.com

Minghui Yang
mitch@carmichaelip.com

Stephen Schreiner
schreiner@carmichaelip.com

Respectfully submitted,

/Patrick D. McPherson/
Patrick D. McPherson
USPTO Reg. No. 46,255
Duane Morris LLP
901 New York Avenue N.W., Suite 700 East
Washington, D.C. 20001

Dated: June 16, 2025