

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. IPR2025-01454

U.S. Patent No. 7,724,521

PATENT OWNER DISCRETIONARY DENIAL BRIEF REQUESTING
DENIAL OF INSTITUTION

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. THE DIRECTOR SHOULD EXERCISE DISCRETION UNDER SECTION 314(a) TO DENY INSTITUTION PURSUANT TO <i>FINTIV</i>.....	2
A. <i>Fintiv</i> Factor 1.....	4
B. <i>Fintiv</i> Factor 2.....	5
C. <i>Fintiv</i> Factor 3.....	7
D. <i>Fintiv</i> Factor 4.....	9
E. <i>Fintiv</i> Factor 5.....	12
F. <i>Fintiv</i> Factor 6.....	12
1. Promptness of Filing of the Petition.....	13
2. The Petition Challenges the '521 Patent Based on Grounds Duplicative of Prior Art Already Considered During Prosecution	13
3. Merits of the Petition	14
a. Claim 1 for Ground 1 (Stern): Limitation 1.2(b).....	15
b. Claim 1 for Ground 1 (Stern): Limitations 1.0-1.2	16
c. Claim 14 for Ground 1 (Stern): Limitations 14.0-14.1	20

d.	Claim 14 for Ground 1 (Stern): Limitations 14.0-14.3	22
e.	Claim 1 for Ground 2 (Aakalu): Limitation 1.2	22
f.	Claim 1 for Ground 2 (Aakalu): Limitation 1.2(c)	24
g.	Claim 14 for Ground 2 (Aakalu): Limitation 14.3	25
h.	Claim 19 for Ground 3 (Aakalu/Jones): Limitation 19.2	26
III.	THE DIRECTOR SHOULD DENY INSTITUTION UNDER SECTION 325(D) BECAUSE THE SAME PRIOR ART WAS PREVIOUSLY PRESENTED AND CONSIDERED DURING PROSECUTION OF THE '521 PATENT	27
A.	The Rigorous Prosecution of the '521 Patent	27
B.	Ground 2 Based on Aakalu Is Duplicative of the Prior Art and Arguments Considered and Applied by the Examiner	31
C.	Ground 3 Based on Aakalu and Jones Is Cumulative of the Prior Art and Arguments Considered and Applied by the Examiner	36
D.	Ground 1 Based on Stern '753 is Cumulative of Stern '834 Presented to and Considered by the Examiner	37
IV.	THE DIRECTOR SHOULD DENY INSTITUTION BASED ON OTHER RELEVANT CONSIDERATIONS	39
A.	Settled Expectations of the Parties	39
B.	Petitioners' Extensive Reliance on Parroted Expert Testimony	40
V.	CONCLUSION	45

VI. CLAIMS APPENDIX.....	46
---------------------------------	-----------

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Bell Semiconductor LLC v. NXP B.V.</i> , 2024 WL 4984053 (Fed. Cir. 2024)	41
<i>Garmin International, Inc. v. LoganTree, LP</i> , 825 Fed.Appx. 894 (Fed. Cir. 2020).....	41
<i>Harmonic Inc. v. Avid Tech.</i> , 815 F.3d 1356 (Fed. Cir. 2016)	3
<i>Microsoft Corp. v. i4i Ltd. Partnership</i> , 564 U.S. 91 (2011).....	39
<i>TQ Delta, LLC v. CISCO Systems, Inc.</i> , 942 F.3d 1352 (Fed. Cir. 2019)	24, 43

Statutes

35 U.S.C. §282.....	39
35 U.S.C. §314.....	2, 5, 8
35 U.S.C. §316.....	5
35 U.S.C. §325.....	1, 31

Agency Decisions

<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i> , IPR2019-01469, Paper 6, (PTAB Feb. 13, 2020) (precedential) .	32, 36, 37, 39
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).....	4, 13
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 15 (PTAB May 13, 2020)	4

<i>Becton Dickinson v. B. Braun Melsungen</i> , IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential).....	passim
<i>Ericsson Inc. et al v. Collison Communications, Inc.</i> , IPR2022-01233, Paper 12 (PTAB Jan. 19, 2023)	6
<i>Ericsson Inc. v. Active Wireless Tech. LLC</i> , IPR2024-00886, Paper 8 (PTAB Nov. 12, 2024).....	6
<i>Free-Flow Packaging Int’l, Inc. v. Automated Packaging Sys., Inc.</i> , IPR2016-00447, Paper 7 (PTAB June 22, 2016)	42
<i>General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential, designated Oct. 18, 2017)	7
<i>Google LLC v. EcoFactor Inc.</i> , IPR2021-00454, Paper 9 (PTAB July 22, 2021).....	10
<i>Halliburton Energy Services, Inc. v. Schlumberger Tech. Corp.</i> IPR2017–02072, Paper 11, 2018 WL 1891086 (PTAB Apr. 12, 2018)	41
<i>LG Elecs., Inc. v. Ancora Techs., Inc.</i> , IPR2021-00581, Paper 16 (PTAB June 10, 2021)	10, 11
<i>NHK Spring Co. v. Intri-Plex., Inc.</i> , IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019).....	1, 3, 7
<i>Roku, Inc. v. IOENGINE, LLC</i> , IPR2022-01554, Paper 11 (PTAB May 5, 2023)	10
<i>Samsung Electronics Co. Ltd. v. California Institute of Tech.</i> , IPR2023-00130, Paper 10 (PTAB May 4, 2023)	10, 11
<i>Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC</i> , IPR2019-01393, Paper 24 (PTAB June 16, 2020)	10
<i>Verizon Business Network Services LLC v. Huawei Tech. Co. Ltd.</i> , IPR2020-01278, Paper 12 (PTAB Jan. 26, 2021)	6

Xerox Corp. v. Bytemark, Inc.,
IPR2022-00624, Paper 12 (Director Review: Feb. 10, 2023) (prec.) 41, 42, 44

Regulations

37 C.F.R. § 42.104 40

Constitutional Amendments

U.S. Const. amend. VII.....39

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.) dtd April 26, 2024 (Dkt. 23)
2002	Reserved
2003	Plaintiff's Opposition to Defendants' Motion to Stay 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 26, 2025 (Dkt. 56)
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	Challenged Claims in IPR2025-01454
2007	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	Docket Report for <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.)
2009	Invalidity 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 June 12, 2024
2010	U.S. Pat. No. 9,943,006 to Ericsson
2011	Joint Claim Construction Statement 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 2, 2025 (Dkt. 43)
2012	Procomm 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.) dtd March 2, 2025 (Dkt. 48)
2013	Ericsson Responsive 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.) dtd March 2, 2025 (Dkt. 54)

2014	Procomm Reply on Claim Construction in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.) dtd April 1, 2025 (Dkt. 59)
2015	U.S. Pat. No. 6,253,834 (Sternier)
2016	Comparison of Petition to Ex. 1003 (Tanbour Declaration)
2017	Declaration of Stephen Schreiner in support of Ex. 2016 compare document

I. INTRODUCTION

Pursuant to Acting Director Stewart's March 26, 2025 Memorandum entitled "*Interim Processes for PTAB Workload Management*" ("March 26, 2025 Memorandum"), Patent Owner Procomm International Pte. Ltd ("Procomm") respectfully requests that the Director exercise her discretion and deny institution of Petitioners Ericsson Inc. and Cellco Partnership's Petition for *inter partes* review of U.S. Patent No. 7,724,521.

First, the Petition should be denied pursuant to *Fintiv*. The district court in *Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.*, No. 2:24-cv-009-RWS-RSP (E.D. Tex.) has already scheduled a jury trial on the '521 Patent ***nine months before*** the expected date of the Final Written Decision in this IPR. Conducting an IPR trial when the validity of the '521 Patent will have already been decided by the district court (1) is an inefficient use of the PTO's and parties' time and resources; (2) could lead to conflicting results; and (3) would undermine the objective of an IPR to be an ***alternative*** to district court adjudication of validity. *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018), 19.

Second, the Petition should be denied under § 325(d) because the same or substantially the same prior art was presented to the Office during the original prosecution of the '521 Patent. 35 U.S.C. §325(d). First, the Aakalu reference (Ex.

1005) that is the basis of IPR Grounds 2-3 was presented to the Examiner, applied by the Examiner, and overcome by the applicant. As for remaining Ground 1, it is based on the Sterner '753 reference (Ex. 1004) that has the same disclosure as the Sterner '834 reference (Ex. 2015) that was presented to and considered by the Examiner during prosecution. Under these circumstances, the Director should exercise her discretion to deny institution.

Third, the Director has indicated that other considerations relevant to discretionary denial include (1) the settled expectations of the parties, including how long the claims have been in force, and (2) the extent to which the petition relies on expert declarations to make its case for unpatentability. See March 26, 2025 Memorandum, 2-3. These considerations weigh in favor of discretionary denial because (1) the claims of the '521 Patent have been in force for nearly 15 years, and (2) the Petitioners rely on an extensive 134-page expert declaration that is unreliable and unhelpful because it repeats the Petition word-for-word.

II. THE DIRECTOR SHOULD EXERCISE DISCRETION UNDER SECTION 314(a) TO DENY INSTITUTION PURSUANT TO *FINTIV*

The Director should deny institution under 35 U.S.C. §314 because all six *Fintiv* factors favor discretionary denial. The *inter partes* review statute leaves institution entirely at the discretion of the Director. *See* 35 U.S.C. §314(a);

Harmonic Inc. v. Avid Tech., 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

The Director has historically applied that discretion where efficiency considerations stemming from parallel proceedings on the same patent warrant denial of institution. *See NHK Spring Co. v. Intri-Plex, Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (“*NHK Spring*”). The Director has considered six factors for determining whether efficiency and fairness support the exercise of authority to deny institution based on a parallel proceeding (the “*Fintiv* factors”):

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties as of the time of the institution decision;
4. Overlap between issues raised in the petition and in the parallel proceeding;
5. Whether the petitioner(s) and the defendant in the parallel proceeding are the same party; and

6. Other circumstances that impact the Board’s exercise of discretion, including whether the petition was filed “promptly after becoming aware of the claims being asserted” and the merits of the petition.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv I*”), 5-16; *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (PTAB May 13, 2020) (order denying institution) (informative, designated July 13, 2020) (“*Fintiv II*”), 7-8.

Here, all six *Fintiv* factors weigh in favor of discretionary denial, the Petition is weak on the merits, and Petitioners have not even bothered to submit a *Sotera*-type stipulation.

Procomm respectfully requests that the Director deny institution under *Fintiv*.

A. *Fintiv* Factor 1

The first *Fintiv* factor—regarding whether a stay exists or is likely to be granted if a proceeding is instituted—weighs heavily in favor of denial. The Petitioners’ motion to stay pending IPR filed on March 12, 2025, was denied on April 6, 2025 as premature. Ex. 2008 (Docket Report, Dkt. 62), 8.

Even if an IPR was instituted, the district court judge is unlikely to stay the case absent agreement from the parties. Ex. 2005, 3 (showing only a 20% win rate

on contested motions to stay pending IPRs decided by Judge Schroeder in the Eastern District of Texas). Thus, this factor strongly weighs in favor of denial.

B. *Fintiv* Factor 2

The second *Fintiv* factor—the proximity of the court’s trial date to the Board’s projected statutory deadline for a Final Written Decision—strongly weighs in favor of denial. Petitioners only recently filed this IPR on December 31, 2024—nearly one year after the January 10, 2024, service of Patent Owner’s Complaint. Ex. 2008, 4 (Docket Report, Dkt. Nos. 5-6, return of summons). The Notice of Filing Date Accorded to Petition was mailed on January 29, 2025. Paper 4. A Final Written Decision will thus be due by July 29, 2026. *See* 35 U.S.C. §314(b); 35 U.S.C. §316(a)(11).

Because Petitioners waited until the last minute to file their IPR, the parallel district court litigation has already proceeded to an advanced stage, and the district court has already scheduled jury selection for October 20, 2025. Ex. 2001 (Docket Control Order), 1. Thus, the Final Written Decision is expected ***nine months after*** the trial. Furthermore, the result is the same even when considering the median time from filing to disposition of the civil trial for the parallel litigation in the Eastern District of Texas rather than the scheduled trial date. The current median time-to-trial in the Eastern District of Texas is 21.6 months. Ex. 1004, 35. The

district court litigation was filed on January 8, 2024. Ex. 2008 (Docket Report), 3. These statistics indicate that the trial would occur around the same October 2025 date as scheduled. Thus, both the actual scheduled trial date in the parallel litigation and the median time-to-trial statistics for the Eastern District of Texas consistently place the trial in October 2025—nine months before the expected Final Written Decision.

Under *Fintiv* Factor 2, this weighs heavily in favor of discretionary denial. *See Fintiv I*, 9 (“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this factor in favor of exercising authority to deny institution under NHK.”); *Ericsson Inc. et al v. Collison Communications, Inc.*, IPR2022-01233, Paper 12, (PTAB Jan. 19, 2023), 12-13 (holding that Factor 2 “weighs in favor of denying institution, given that we would not expect to issue a final written decision until at least four months” after trial). *See also Ericsson Inc. v. Active Wireless Tech. LLC*, IPR2024-00886, Paper 8 (PTAB Nov. 12, 2024), 8-9 (Factor 2 weighs in favor of denying institution where trial date is eight months before expected date of final written decision); *Verizon Business Network Services LLC v. Huawei Tech. Co. Ltd.*, IPR2020-01278, Paper 12 (PTAB Jan. 26, 2021), 9-10 (Factor 2 weighs in favor of denial where “the district court has set its trial date ... approximately eight months before our

deadline to reach a final decision”). Here, the 9-month gap between the district court trial and the Final Written Decision is even longer than in these other cases where the Board denied institution. *Id.*

Finally, granting institution here would frustrate one of the primary objectives of the AIA “to provide an effective and efficient **alternative**” to parallel litigation. *NHK Spring*, 19-20 (quoting *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, (PTAB Sept. 6, 2017) (precedential, designated Oct. 18, 2017), 15-19 (emph. added). If an IPR is instituted, any potential FWD would issue well after trial concludes. Thus, instituting an IPR here would not be an alternative to parallel litigation. Rather, it would simply relitigate issues that would have been already decided in the parallel litigation.

C. *Fintiv* Factor 3

The third *Fintiv* factor—which relates to “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision” (*Fintiv I* at 9)—also favors denial. Significant amounts of work have been completed in the district court. The parties have completed their P.R. 3-1 and 3-2 disclosures (Infringement Contentions), their P.R. 3-3 and 3-4 disclosures (Invalidity Contentions), and have substantially completed claim construction briefing. Ex. 2001, 4-5. By the expected July 29, 2025, institution

decision date (*see* 35 U.S.C. §314(b)), the District Court will have held a *Markman* hearing, and the parties will have completed fact discovery and expert discovery. The parties will have also completed their briefing of dispositive motions. *Id.*

Thus, by the expected time of the institution decision, most of the substantive work will have been completed in the district court litigation, and essentially all that is left is trial. *See Fintiv II*, 14 (“based on the level of investment and effort already expended on claim construction and invalidity contentions in the District Court, this factor weighs somewhat in favor of discretionary denial in this case.”). The facts here “support the arguments that the parallel proceeding is more advanced ... and instituting would lead to duplicative costs.” *Fintiv I*, 10. Under these circumstances, it would be an extremely inefficient use of the parties’ and the Board’s time and resources to relitigate issues that would be almost certainly be decided before the expected deadline to file a Patent Owner Response in this IPR.

Finally, Petitioners are solely responsible for this course of events. Petitioners waited within two weeks of the one-year statutory deadline before filing this IPR and, in doing so, allowed the parallel district court litigation to advance substantially ahead of the expected schedule of this IPR. Petitioners’ invalidity contentions were filed on June 12, 2024. Ex. 2001, 1; Ex. 2009 (invalidity contentions). There is no justification for Petitioners waiting until December 31,

2024—more than 6 months after their invalidity contentions—to file this IPR. It would be unfair to require Procomm to duplicate work that has already been done in the parallel litigation because of Petitioners’ delays. *See Fintiv II*, 14.

Accordingly, Factor 3 weighs heavily in favor of non-institution.

D. *Fintiv* Factor 4

The fourth *Fintiv* factor—which relates to overlap between issues raised in the petition and in the parallel proceeding—also weighs in favor of denying institution. “[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Fintiv* at 12. The Petition challenges independent Claims 1 and 14 (Pet., 27), which are also asserted in the litigation. Ex. 2007, 46-58.

Further, the grounds of this Petition (Pet., 27) for IPR are identically found in the invalidity contentions in the parallel litigation. See Ex. 2009 (invalidity contentions), 43-44 (Sterner, Aakalu, Jones), 46 (same), 173-209 (E-04: Sterner), 210-229 (E-05: Aakalu), 230-247 (E-06: Jones). The invalidity contentions in the litigation also include obviousness combinations using the references from the IPR grounds combined with “prior art systems related to prior art references” (*id.*, 49)—overlapping combinations that would not be precluded by Petitioners’ weak

Sands Revolution stipulation. The overlap between the IPR grounds and the combinations in the parallel litigation strongly weighs in favor of non-institution.

Petitioners argue that factor 4 weighs against discretionary denial because they “stipulate that if the IPR is instituted, it will not pursue the same grounds in the district court litigation.” Pet., 90 (*citing Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 (PTAB June 16, 2020)). Patent Owner submits that this is a weak “*Sand Revolution*”-style stipulation that should be entitled to no weight because it only precludes Petitioners from pursuing the exact same grounds in the Petition and does not preclude Petitioners from reusing the same prior art in different grounds with minor modifications. Even in previous administrations, the Board has historically assigned almost no weight to *Sands Revolution* style stipulations such as the one Petitioners filed here. *LG Elecs., Inc. v. Ancora Techs., Inc.*, IPR2021-00581, Paper 16, (PTAB June 10, 2021), 9-10 (same); *Google LLC v. EcoFactor Inc.*, IPR2021-00454, Paper 9 (PTAB July 22, 2021) (same); *Samsung Electronics Co. Ltd. v. California Institute of Tech.*, IPR2023-00130, Paper 10, (PTAB May 4, 2023), 19-20 (same); *Roku, Inc. v. IOENGINE, LLC*, IPR2022-01554, Paper 11 (PTAB May 5, 2023), 13-14 (same). A *Sands Revolution*-style stipulation does little to eliminate overlap with the district court litigations, and Petitioners’

stipulation here does nothing to prevent the alleged prior art references asserted in the Petition from being re-used in substantially the same form in the litigation by combining them with different secondary references. The stipulation here is almost meaningless.

To the extent the Director is inclined to consider Petitioners' *Sands Revolution* style stipulation, the Board has often denied institution in situations like the present where the other factors clearly favored non-institution, even where Petitioners offered stronger stipulations than the one offered here. For example, in *LG Elecs., Inc. v. Ancora Techs., Inc.*, No. IPR2021-00581, Paper 16, (PTAB June 10, 2021), 9-10, the Board denied institution despite the petitioners' stipulation "it will not subsequently assert invalidity in the district court on the same grounds asserted in the IPR or on the basis of the Hellman reference, either alone or in combination with any other reference." *Id.* Unlike Petitioners' stipulation here, the petitioner in *Ancora* agreed to a blanket stipulation not to assert the primary reference Hellman under any circumstance. The Board there agreed with the patent owner that, even with the petitioners' stipulation, "there is significant overlap between the issues raised in the Petition and in the parallel district court proceeding." *Id.* Similarly, in *Samsung Electronics Co., Ltd. v. California Institute of Technology*, IPR2023-00130, Paper 10 (PTAB May 4, 2023), the Board denied

institution notwithstanding a stipulation it characterized as “broader to some degree than the stipulation discussed in *Sand Revolution*” because “the trial in the Underlying Litigation would commence several months before the expected date of our final written decision” and there had been significant investment in the litigation. *Id.*, 16-20.

The facts here are stronger than *Ankora* and *Samsung*. Procomm submits that Petitioners’ stipulation should be assigned minimal weight. Accordingly, Factor 4 strongly favors discretionary denial.

E. *Fintiv* Factor 5

The fifth *Fintiv* factor—whether the petitioners and the defendant in the parallel proceedings are the same parties—weighs in favor of discretionary denial. The parties here are the same as the parties in the litigations. *Fintiv II*, 15 (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”).

F. *Fintiv* Factor 6

The sixth *Fintiv* factor—relating to other circumstances that impact the Board’s exercise of discretion, including the merits—weighs in favor of discretionary denial.

1. Promptness of Filing of the Petition

The *Fintiv* decision places a heavy emphasis in Factor 6 on whether the petition was filed expeditiously, specifically, whether the petition was filed “promptly after becoming aware of the claims being asserted.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), 11-12. In this case, the Petitioners waited *more than 9 months* after receiving Procomm’s March 2024 infringement contentions before filing this Petition. See Ex. 2007 (infringement contentions). That is the opposite of expeditious and weighs in favor of discretionary denial.

2. The Petition Challenges the ’521 Patent Based on Grounds Duplicative of Prior Art Already Considered During Prosecution

As explained in detail in Section III below (Section 325(d)), this Petition challenges the ’521 Patent based on prior art already considered by the Examiner during prosecution.

The Aakalu reference was applied by the Examiner during examination of the application leading to the ’521 Patent. See Section III.A, *infra*. Yet, the Petition presents two grounds (Grounds 2-3) based on Aakula reference.

Ground 1 is based solely on the Sterner ’753 reference. A reference disclosing the same subject matter, U.S. Pat. No. 6,253,834 (the “Sterner ’834

reference”) was disclosed to and considered by the Examiner during examination.

See Section III.A, *infra*.

The Petitioners’ presentation of duplicative prior art in the Petition weighs in favor of discretionary denial.

3. Merits of the Petition

The merits of the Petition are weak and thus weigh in favor of discretionary denial. When describing the “compelling merits” of the Petition, Petitioners only generally suggest that the references “disclose a cooling unit utilizing the venturi effect to draw ambient air through the heatsink to cool electronic components as claimed in the ’521 Patent.” Pet., 91. There is no showing that there are compelling merits that the references teach or suggest the recited limitations of the claims of the ’521 Patent.

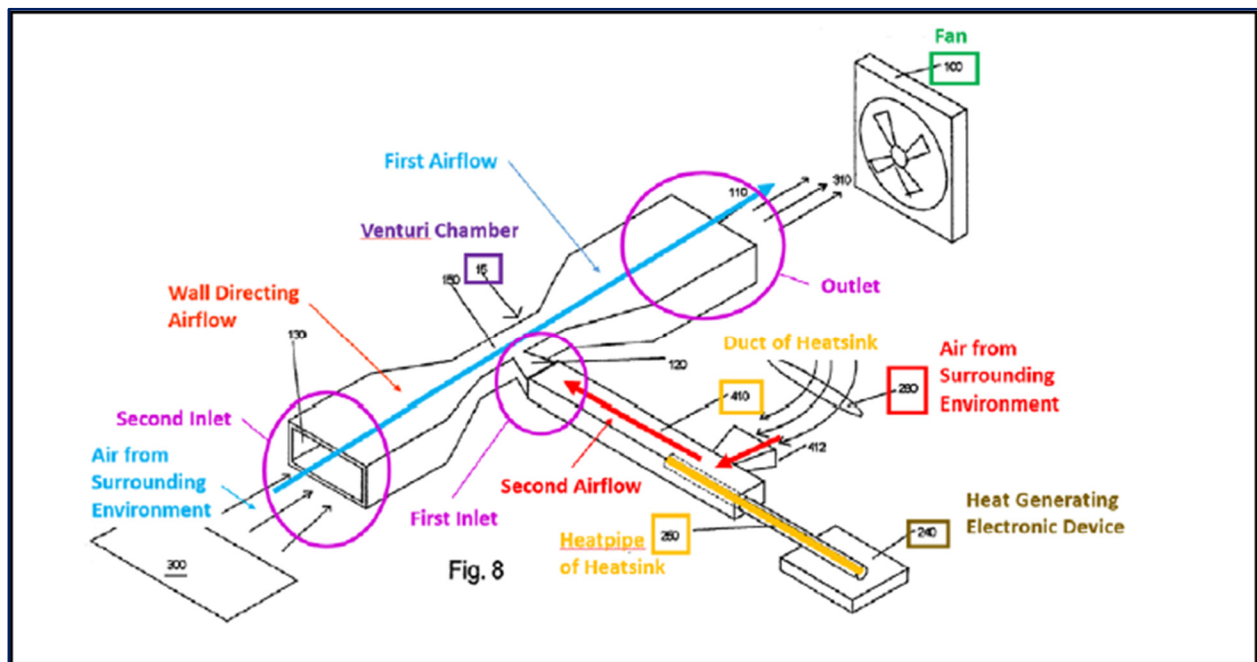
Although Procomm will further address the deficiencies of Petitioners’ references in much greater detail in its forthcoming Preliminary Response (merits brief), Procomm identifies examples of multiple dispositive merits issues that should preclude institution on the merits and that weigh in favor of discretionary denial pursuant to the *Fintiv* analysis.

Specifically, Patent Owner demonstrates below that the applied references fail to teach or suggest multiple limitations of independent Claims 1, 14, and 19.

a. Claim 1 for Ground 1 (Stern): Limitation 1.2(b)

First, with respect to Ground 1, the Stern reference does not teach or suggest limitation 1.2(b) of Claim 1 for *a Venturi chamber having ... a second inlet for receiving an airflow from a surrounding environment*.

Petitioners rely on a marked-up version of Figure 8 of Stern for this limitation:



Pet., 36 (Petitioners' annotated Fig. 8 for limitation 1.2). See Pet., 36-38 (analysis of limitation 1.2).

Petitioners argue that the claimed *second inlet for receiving air from a surrounding environment* of limitation 1.2(b) is met by the intake manifold 130 of Stern's Figure 8 that receives an airflow. Pet., 37.

However, a POSITA would readily recognize that the airflow received by intake manifold 130 is **heated air** that absorbs heat from the other electronic components 300 before it enters intake manifold 130 (the alleged *second inlet*), as illustrated in Figure 8. Indeed, Sterner explains that “FIG. 8 illustrates a fifth alternative embodiment in which the [electronic] system components 300 *are cooled* by creating an air flow into intake manifold 130 by air-moving device 100.” Ex. 1004 (Sterner), 5:14-16. A POSITA would thus understand that the air entering manifold 130 is not “air from a surrounding environment,” as Petitioners assert in their annotated Figure 8. See Pet., 36. Instead, the air entering manifold is heated air.

Accordingly, Sterner does not teach or suggest limitation 1.2(b).

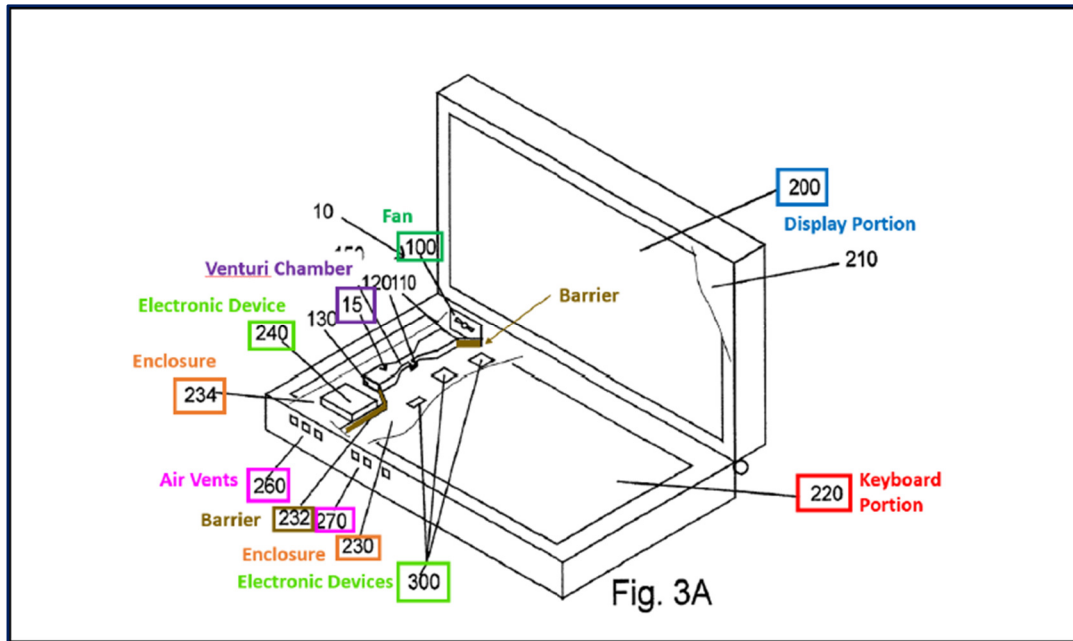
Petitioners’ cited evidence from the Tanbour Declaration at paragraphs 80-82 is entitled to no weight as it parrots the Petition verbatim. *Compare* Tanbour Decl., ¶¶ 80-82, *with* Pet., 37. See Section IV.B, *infra*.

Accordingly, Sterner does not teach or suggest limitation 1.2(b).

b. Claim 1 for Ground 1 (Sterner): Limitations 1.0-1.2

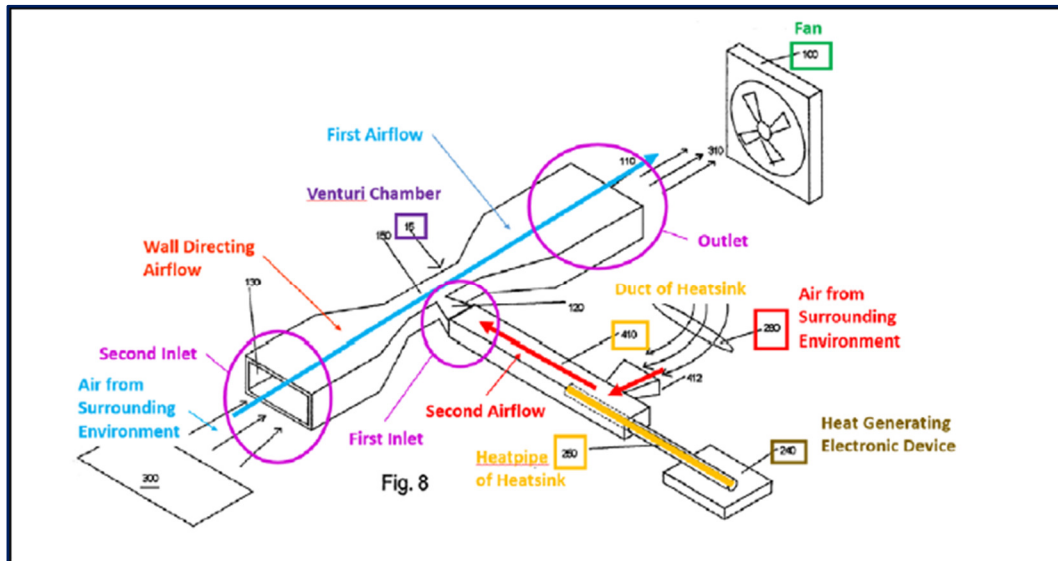
In their analysis of Claim 1, Petitioners rely on multiple distinct embodiments from Sterner ’753 without even attempting to establish that a POSITA would have an apparent reason to combine those embodiments.

For limitations 1.0 and 1.1, Petitioners rely on the Sterner embodiment of Figure 3A:



Pet., 31-32 (relying on Sterner, Fig. 3A, annotated by Petitioners, for limitation 1.0), 34 (relying on excerpted Fig. 3A, for limitation 1.1).

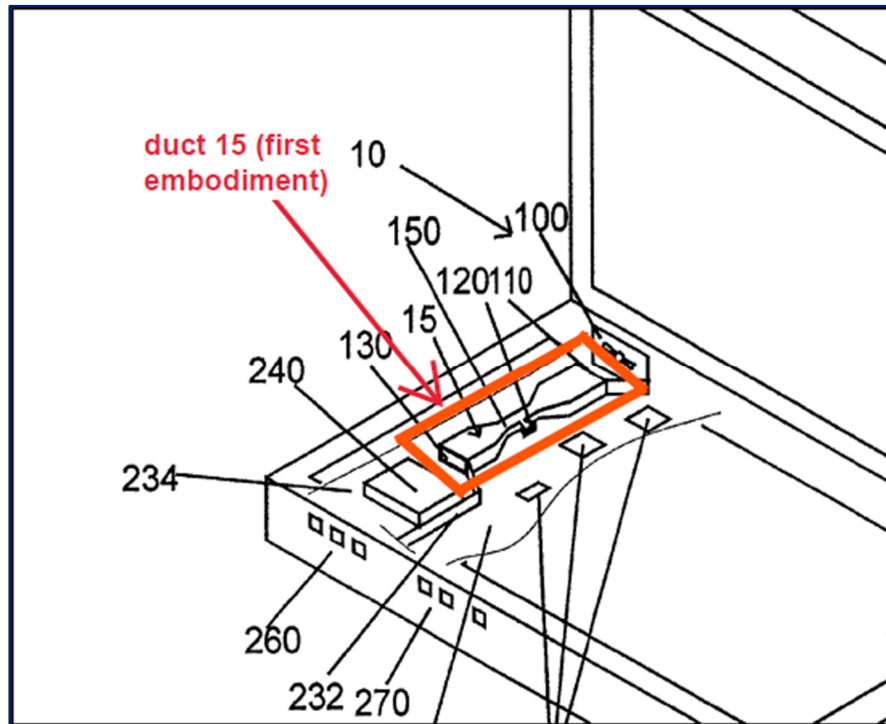
On the other hand, Petitioners rely on the embodiment of Figure 8 of Sterner for limitation 1.2:



Pet., 36 (relying on Fig. 8 for limitation 1.2). See Pet., 36-38 (analysis of limitation 1.2).

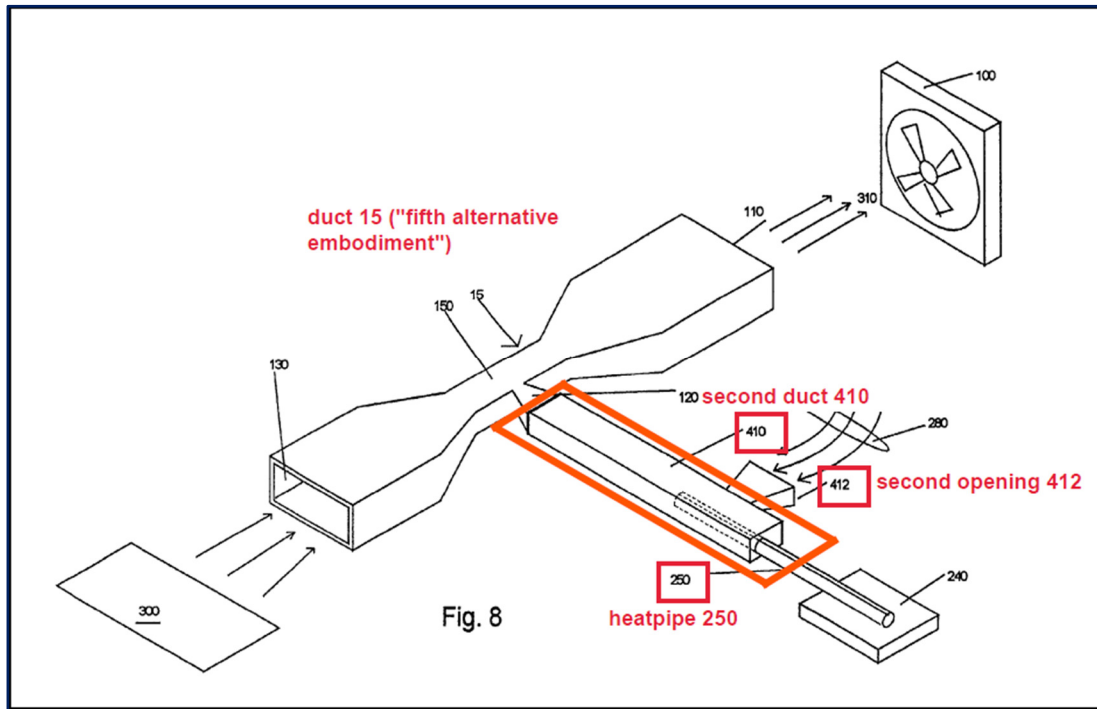
Figure 3A and Figure 8 are distinct embodiments of the invention. Sterner identifies them as distinct embodiments: Sterner identifies Figure 3A as the “*preferred embodiment* of the invention,” whereas it identifies Figure 8 as “a *fifth alternative embodiment* of the invention.” Sterner, 2:31-33, 2:46-48, 3:45-46, 8:14-15 (emph. added).

Also, a POSITA can readily see that Figures 3A and 8 are distinct embodiments of the invention. Figure 3A uses a standard air duct 15 (see Figure 2):



Sterner, Fig. 3A (excerpted and annotated by PO).

On the other hand, the “fifth alternative embodiment” of Figure 8 uses a modified air duct 15 that adds a second air duct 410, a heatpipe 250, and a second opening 412, as depicted below:



Sterner, Fig. 8 (annotated by PO in red).

Petitioners never even attempt to establish an apparent reason for a POSITA to combine the Figure 3A “preferred embodiment” with the Figure 8 “fifth alternative embodiment” of Sterner. See Pet., 31-38.

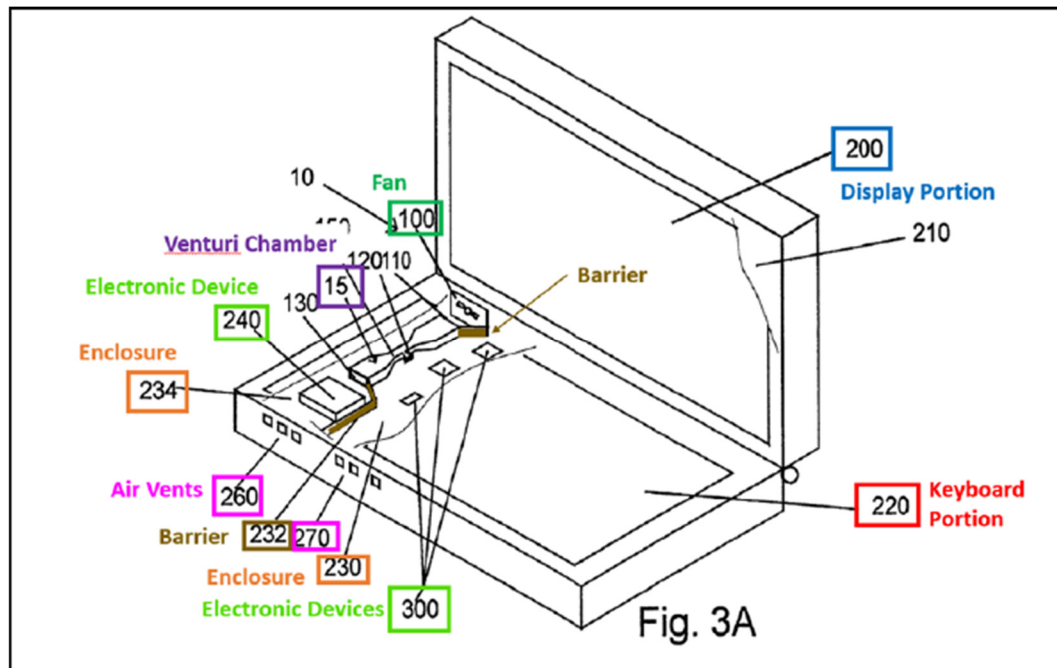
Accordingly, limitations 1.0-1.2 are not satisfied because a POSITA would not have reason to make the proposed combination.

c. Claim 14 for Ground 1 (Sterner): Limitations 14.0-14.1

Limitation 14.0 recites *cooling a sealed environment*, and limitation 14.1 recites directing heat generated by *electronic devices house within a sealed environment*.

The Petition argues that the cavities 230 and 234 in Figure 8 of Sterner are *sealed environments* housing electronic devices 240 and 300. Pet., 44.

Petitioners provide this mark-up of Figure 3A in support of this assertion:



Pet., 45 (Petitioners' annotated Fig. 3A of Sterner).

However, as illustrated in Figure 3A and elsewhere expressly disclosed by Sterner, the cavities 230/234 are ***connected to air vents*** 260/270. Sterner, 3:60-66.

Accordingly, a POSITA would understand that the cavities of Sterner are not *sealed environments* as claimed.

The expert testimony from the Tanbour Declaration is entitled to no weight because it parrots the Petition verbatim. *Compare* Tanbour Declaration, ¶¶ 100-105, *with* Petition, 43-46. See Section IV.B, *infra*.

Accordingly, limitations 14.0-14.1 are not satisfied by Sterner.

d. Claim 14 for Ground 1 (Sterner): Limitations 14.0-14.3

Just like their argument for Claim 1 (see Section II.F.2.b above), the Petitioners' obviousness theory for Claim 14 relies on combining multiple distinct embodiments from Sterner without ever establishing that a POSITA would have a reason to combine them.

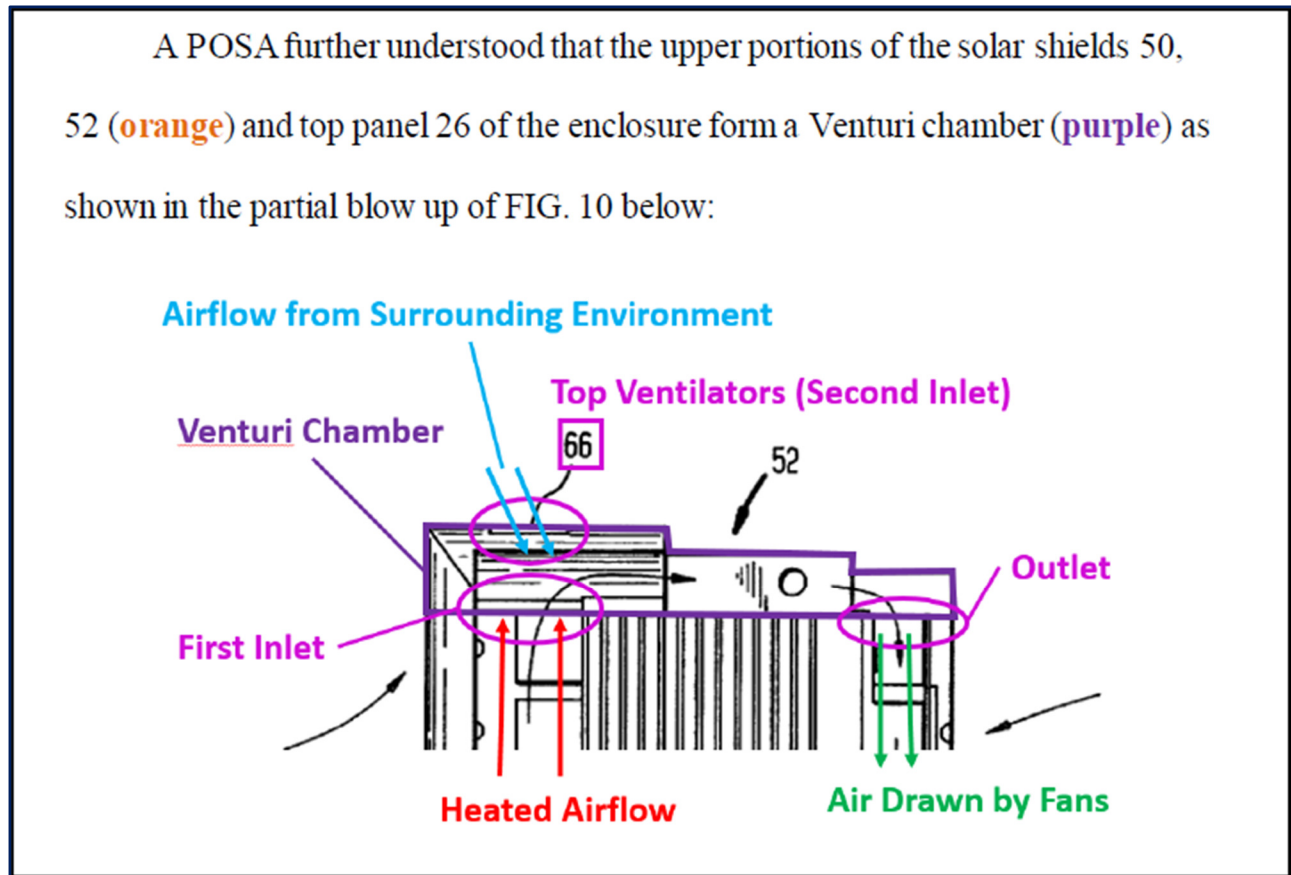
For example, the Petition relies on the "preferred embodiment" of Figure 3A and the "fifth alternative embodiment" of Figure 8 for limitations 14.0 and 14.1. See Pet., 43-46. Sterner, 2:31-33 (Figure 3A is the "*preferred embodiment* of the invention), 2:46-48 (Figure 8 is "a *fifth alternative embodiment* of the invention."). See Sterner, 3:45-46 (same), 8:14-15 (same). The Petition relies on the Figure 8 embodiment for limitation 14.2 and also for limitation 14.3. See Pet., 46-47.

For the same reasons explained above in Section II.F.2.b, the Petition does not establish an apparent reason to combine the disparate embodiments of Figure 3A and Figure 8 of Sterner, and thus limitations 14.0-14.3 are not satisfied.

e. Claim 1 for Ground 2 (Aakalu): Limitation 1.2

Limitation 1.2 of Claim 1 recites *a Venturi chamber having a first inlet, a second inlet, and an outlet.*

The Petition alleges that some vaguely referenced “upper portions” of the solar shield 14 and housing 12 in Aakalu is a Venturi chamber. Petitioners make the following assertion:



Pet., 61 (Petitioners’ annotated excerpt of Aakalu, Fig. 10).

But there is no teaching or suggestion by Aakalu that the marked areas are a Venturi chamber. Indeed, Aakalu does *not even mention* the term “Venturi chamber” or “Venturi effect” anywhere. Nor does Aakalu indicate that the velocity of the air increases, which is a characteristic of the Venturi effect.

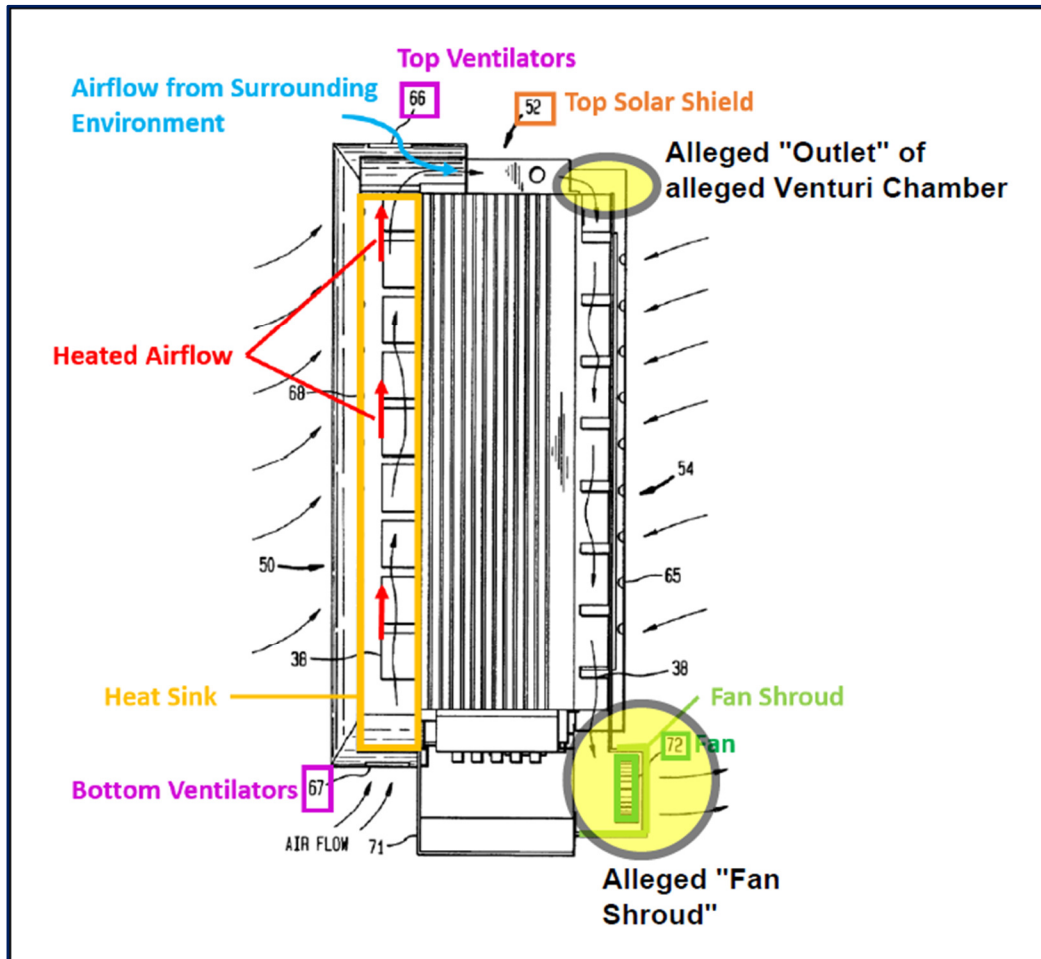
The Petition only sets forth unsupported attorney argument—which is facially insufficient to establish the limitation—because cited paragraphs 135 and 140 of the expert declaration parrot the Petition word-for-word. *Compare* Petition 61-62 (citing ¶ 135), 63-64 (citing ¶ 140), *with* Tanbour Declaration, ¶¶ 135, 140. Further, paragraphs 135 and 140 of the Tanbour Declaration are pure *ipse dixit* unsupported by any evidence showing that there is a Venturi effect within Aakalu. *TQ Delta, LLC v. CISCO Systems, Inc.*, 942 F.3d 1352, 1360 (Fed. Cir. 2019) (disregarding *ipse dixit* assertion “untethered to any supporting evidence”).

Accordingly, the Petitioners have not established that Aakalu teaches or suggests a *Venturi chamber* to meet limitation 1.2.

f. Claim 1 for Ground 2 (Aakalu): Limitation 1.2(c)

Petitioners’ application of Claim 1 to Aakalu fails to meet limitation 1.2(c) providing that the Venturi chamber has *an outlet coupled to the fan shroud*.

In the Petitioners’ own mark-up of Aakalu, the alleged *outlet* of the alleged Venturi chamber is not coupled to the alleged *fan shroud* pursuant to limitation 1.2(c):



Pet., 60 (Petitioners annotated Fig. 10 of Aakalu, further annotated in black/yellow highlight by PO).

Accordingly, Aakalu does not teach or suggest limitation 1.2(c) for *an outlet coupled to the fan shroud*.

g. Claim 14 for Ground 2 (Aakalu): Limitation 14.3

Limitation 14.3 recites *drawing a second airflow of heated air ... using a Venturi effect created by drawing the first airflow*.

For the *Venturi effect* of limitation 14.3, Petitioners rely entirely on their argument for limitation 1.3 regarding the *Venturi chamber*. Pet., 76.

Patent Owner responds that Aakalu does not teach or suggest the *Venturi effect* of limitation 14.3 for at least the same reasons explained for the *Venturi chamber* above in Section II.F.2.e.

Accordingly, Aakula does not teach or suggest limitation 14.3.

h. Claim 19 for Ground 3 (Aakalu/Jones): Limitation 19.2

The Petition relies entirely on its analysis of Claim 14 for the element in limitation 19.2 for *draw[ing] ... a second airflow of heated air from the one or more convective openings ... using a Venturi effect*. See Pet., 85 (emph. added).

But Aakalu does not teach or suggest the claimed application of the *Venturi effect* of limitation 19.2 for at least the same reasons explained in Section II.F.2.g above for limitation 14.3, and for the same reasons set forth for the *Venturi chamber* in Section II.F.2.e.

III. THE DIRECTOR SHOULD DENY INSTITUTION UNDER SECTION 325(D) BECAUSE THE SAME PRIOR ART WAS PREVIOUSLY PRESENTED AND CONSIDERED DURING PROSECUTION OF THE '521 PATENT

The Director should deny institution because the references forming the bases for the grounds were already presented to and considered by the Examiner during the prosecution of the '521 Patent.

A. The Rigorous Prosecution of the '521 Patent

The application leading to the '521 Patent was filed on June 11, 2008, with Claims 1-20. Ex. 1002, 0102-0140 ('521 Patent, Cover, 22). The independent claims were Claims 1, 14, and 19.

An IDS filed on June 11, 2008, presented U.S. Pat. No. 6,253,834 to Sterner ("Sterner '834 Patent") to the Examiner. Ex. 1002, 0099. The Examiner initialed the IDS on September 23, 2009. Ex. 1002, 0069-0070. The Sterner '834 Patent is listed as a reference considered by the Examiner on the face of the '521 Patent. '521 Patent, 001 (Cover).

The Examiner indicated that he considered the Sterner '834 reference. NFOA, 0054, 0069-0070 (signed IDS including Sterner '834); '521 Patent, 001 (Cover). The Examiner stated that he considered Sterner '834 before allowing the claims: "The prior art made of record and not relied upon is considered pertinent to applicant's disclosure." NFOA, 0054.

The Examiner issued a non-final Office Action (“NFOA”) dated September 29, 2009, rejecting Claims 1, 3, 6-8, and 14-20. Ex. 1002, 0049-0050. The Examiner rejected Claims 14-20, including independent Claims 14 and 20, as obvious based on Aakalu (U.S. Pat. No. 5,894,407) (Ex. 1005) in view of Dellapi (U.S. Pat. No. 6,142,595). NFOA, 0052.

The Examiner asserted that Aakalu met the limitations of then-pending independent Claims 14 and 19, except for the *electronic devices [being] housed within a sealed environment*. The Examiner applied Dellapi as disclosing a sealed enclosure for housing electronic devices. Ex. 1002 (NFOA), 0053.

The Examiner indicated that independent Claim 1 was patentable over Aakalu, Sterner ’834, and the other references of record, as follows:

The cited art [regarding Claim 1] does not each nor suggest a cooling unit composed of a fan shroud having at least one electrical fan. A Venturi chamber having a first inlet for receiving a heated airflow from a heatsink and a second inlet for receiving an airflow from a surrounding environment[.] The chamber having a wall for directing the airflow air from the surrounding environment in from the second inlet and across the heated airflow from the heatsink in a manner to as to draw the heated airflow through the heatsink using a Venturi effect. Ex. 1002 (NFOA), 0053.

In the response filed December 15, 2009 (“Response”), the applicant corrected the informalities related to the indefiniteness rejection. Response, 0025, 0027-0028.

The applicant addressed the art rejections by amending independent Claims 14 and 19 to add the limitation of “*wherein the first airflow does not flow into the one or more convective openings of the heatsink,*” as follows:

14. (Currently Amended) A method for cooling a sealed environment of an enclosure for housing electronics, the method comprising:

directing heat generated by one or more electronic devices housed within a sealed environment of an enclosure to a heatsink thermally coupled to an external environment;

drawing a first airflow across one or more convective openings of the heatsink, wherein the first airflow does not flow into the one or more convective openings of the heatsink;

drawing a second airflow of heated air from the one or more convective openings using a Venturi effect created by drawing the first airflow.

19. (Currently Amended) A method for cooling a sealed environment of an enclosure for housing electronics, the method comprising:

directing heat generated by one or more electronic devices housed within a sealed environment of an enclosure to a heatsink thermally coupled to an external environment;

when a temperature exceeds a first predetermined threshold, operating a fan to draw a first airflow across one or more convective openings of the heatsink and a second airflow of heated air from the one or more convective openings of the heatsink using a Venturi effect created by drawing the first airflow, wherein the first airflow does not flow into the one or more convective openings of heatsink;

when the temperature does not exceed a second predetermined threshold, allowing a natural circulation airflow to flow from the one or more convective openings of the heatsink by not operating the fan.

Ex. 1002 (Response), 0028-0029.

The applicant distinguished Claims 14 and 20 because Aakalu teaches the air entering the cross channels 42 (allegedly, the claimed *first airflow*) flows into the openings of longitudinal channels 40 (allegedly, the claimed *second airflow*) in the plate 32/rear panel 20 (allegedly, the claimed *heatsink*). See Akalu, Figs. 2, 3, and 5, 3:36-45. The applicant explained:

Thus claims 14 and 19 both clarify that the first airflow that creates the Venturi effect does not enter the [convective] openings of the heatsink. In contrast in the Aakalu reference “the cross channels 42 are normal to the longitudinal channels 40, and **allow for the passage of cross winds through the heat sink while permitting fresh air to be drawn into the longitudinal channels 40 (through the cross**

channels 42) during the convection process.” See, Aakalu, col. 3, lines 39-44. The Applicant respectfully asserts that Aakalu reference is deficient in teaching the limitations of claim 14 and 19 “wherein the first airflow does not flow into the one or more convective openings of heatsink.”

Ex. 1002 (Response), 0034 (emph. added).

The Response provided a summary of an interview conducted on December 15, 2009, describing how the Examiner agreed that the amendment to Claims 14 and 19 overcame the rejection based on Aakalu: “During the above referenced interview, the 103 rejection was discussed with respect to claims 14 and 19. The Examiner agreed that the Applicant’s proposed amendments would appear to overcome the cited references.” Ex. 1002 (Response), 0031.

Following the Response, the application was issued a Notice of Allowance on February 23, 2010, and it issued as U.S. Pat. No. 5,894,407 on April 13, 1999. Ex. 1002, 0007-0011; Ex. 1001, 001 (Cover).

B. Ground 2 Based on Aakalu Is Duplicative of the Prior Art and Arguments Considered and Applied by the Examiner

Under Section 325(d), the Director may deny to institute an IPR if “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. §325(d).

Ground 2 asserts that independent Claims 1 and 14 are obvious based on Aakalu. Pet., 27. However, during prosecution the Examiner located the Aakalu reference and applied it to the claims in the first Office Action (“NFOA”). Specifically, the Examiner applied Aakalu to initially reject independent Claim 14 and later withdrew that rejection based on the applicant’s amendment and argument. See Section III.A above. As for Claim 1, the Examiner found that it was patentable over Aakalu in the NFOA. Ex. 1002, 0053.

Under [§ 325\(d\)](#), the Board uses the following two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, (PTAB Feb. 13, 2020) (precedential), 8.

Thus, if the Patent Owner establishes that the same or substantially the same prior art or arguments were presented to the Office under *Beckton Dickinson* factors (a), (b), and (d), then the burden is on the Petitioners to establish that the Examiner committed a material error under (c), (e), and (f). *Id.*, 10 (“If, after

review of factors (a), (b), and (d), it is determined that the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relate to whether the petitioners have demonstrated a material error by the Office.”). *See Becton Dickinson v. B. Braun Melsungen*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential), 17-18.

A review of factors (a), (b), and (d) confirms that the same or substantially the same art was previously presented to the Office. Although not required, the record also establishes that the same or substantially the same arguments were previously presented to the Office.

Factor (a) refers to the similarities and material differences between the asserted art and the prior art involved during examination. *Id.* at 17. As discussed in Section III.A immediately above, the Aakalu reference in Ground 2 is identical to the Aakalu reference extensively considered by the Examiner during prosecution. Ex. 1002 (File History), 0049-0053. Factor (a) thus weighs in favor of non-institution.

Factor (b) is the cumulative nature of the asserted art and the prior art evaluated during examination. *Becton* at 17. The Aakula reference applied by the Examiner during examination is identical to the Aakula reference of Ground 2. Factor (b) thus weighs in favor of non-institution.

Factor (d) is the extent of the overlap between the arguments made during examination and the manner in which Petitioners rely on the prior art. The Petitioners are applying the same art, Aakalu, as allegedly disclosing a method for cooling electronic devices housed in an enclosure 10 using a Venturi effect, including the use of a heat sink with first longitudinal channels 40 drawing in an airflow from the bottom of the heatsink through the channels 40. Pet., 74 (enclosure 10), 75 (air drawn into longitudinal channels 40 via ventilators 67), 76 (Venturi effect). This is substantially the same argument made by the Examiner and overcome by the applicant. See NFOA, 0052-0053. Factor (d) thus weighs in favor of non-institution.

With factors (a), (b), and (d) establishing that the same or substantially the same art or argument was previously presented to the Office, the burden is on the Petitioners to establish material error through factors (c), (e), and (f).

Factor (c) is the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection. *Becton* at 17. Aakalu was thoroughly evaluated by the Examiner in (1) the September 29, 2009, Office Action rejection based on Aakalu, (2) the December 15, 2009, interview with the applicant discussing Aakalu, and (3) the December 15, 2009,

Response filed by the applicant distinguishing Aakalu. Factor (c) thus weighs in favor of non-institution.

Factor (e) is whether the Petitioners has pointed out sufficiently how the Examiner erred in the evaluation of the asserted prior art. *Becton* at 18. Petitioners' bare assertion that they disagree with the Examiner's finding does not establish material error. Pet., 87-88. The Petition vaguely asserts that "[i]t was error for the Examiner not to consider the full teachings of Aakalu" without specifying what material teaching of Aakalu was not considered. Pet., 88-89. The Petitioners' back-up argument is that "[i]t was further error for the Examiner to conclude that Aakalu does not teach a sealed enclosure." Pet., 89. However, the Examiner relied on the secondary Dellapi reference (U.S. Pat. No. 6,142,595) as teaching a sealed enclosure. See NFOA, 0053. Thus, even if, *arguendo*, the Examiner's interpretation of Aakalu as not teaching a sealed enclosure was incorrect (it is not), it is not a material error. Thus, factor (e) weighs in favor of non-institution.

Factor (f) is the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments. *Beckton* at 18. Other than simply asserting that Ground 2 is meritorious (Pet., 88), the Petition presents no additional evidence or facts warranting reconsideration of the Examiner's allowance of the claims over Aakalu. On the other hand, the Patent

Owner has demonstrated that Ground 2 fails to teach multiple limitations. See Section II.F.3.e-g.

Accordingly, the *Beckton* factors as a whole weigh in favor of non-institution. Further, under the framework of *Advanced Bionics*, the Board should not institute because the Petitioner has failed to demonstrate a material error.

C. Ground 3 Based on Aakalu and Jones Is Cumulative of the Prior Art and Arguments Considered and Applied by the Examiner

Ground 3 asserts that independent Claim 19 is obvious based on Aakalu in view of Jones. Pet., 27. As discussed in Sections III.A-B above, the Examiner applied Aakalu in view of the secondary Dellapi reference (U.S. Pat. No. 6,142,595). The Examiner applied Dellapi as teaching a sealed enclosure for electronics. See NFOA, 0053.

Thus, the same primary reference relied on in Ground 3, Aakalu, was applied by the Examiner for Claim 19. The secondary reference in Ground 3, Jones, discloses an enclosure housing electronics. Jones, Abstract, Summary, Figs. 1-2. Accordingly, Jones is cumulative of the Dellapi reference.

Accordingly, the Aakalu/Jones combination in Ground 3 of the Petition is cumulative of the Akalu/ Dellapi combination applied by the Examiner.

The Petition does not establish any material error with respect to Claim 19 for the same reasons set above in Section III.B. See Pet., 87-89.

Accordingly, the Board should not institute pursuant to *Advanced Bionics*.

D. Ground 1 Based on Sterner '753 is Cumulative of Sterner '834 Presented to and Considered by the Examiner

Ground 1 alleges obviousness of independent Claims 1 and 14 based on Sterner '753. Pet., 27. The Sterner '753 reference (Ex. 1004) is materially identical to the Sterner '834 reference presented to and considered by the Examiner.¹

As to *Beckton* factors (a), (b), and (d), it is undisputed that the Sterner '753 reference of Ground 1 is materially identical to the Sterner '834 reference presented to and considered by the Examiner. See Section III.A, *supra*. The Examiner indicated that he considered Sterner '834 before allowing the claims. NFOA, 0054.

¹ Petitioners concede that the Sterner '753 reference of Ground 1 discloses the same subject matter as the Sterner '834 reference presented and considered by the Examiner during prosecution. Pet., 89 (“The subject matter of Sterner was disclosed” to the Examiner).

With factors (a), (b), and (d) establishing that the same or substantially the same art or argument was previously presented to the Office, the burden is on the Petitioners to establish material error via factors (c), (e), and (f).

As for factor (c), the Sterner reference was evaluated by the Examiner during prosecution. The IDS filed on June 11, 2008, presented the Sterner '834 reference to the Examiner. Ex. 1002, 0099. The Examiner initialed the IDS on September 23, 2009. Ex. 1002, 0069-0070. The Examiner stated that he considered Sterner '834 before allowing the claims. NFOA, 0054 ("The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.")).

As for factors (e) and (f), the Petitioners have not established that the Examiner made a material error. *Becton* at 18. Petitioners assert that "Sterner was not materially considered by the Office." Pet., 89. That is incorrect and contrary to the Examiner's statement that he considered the art of record including Sterner. The Petition also asserts that Sterner teaches the limitations of independent Claims 1 and 14. Pet., 89. That *pro forma* assertion is insufficient to establish material error. Additionally, Patent Owner has pointed out how Sterner fails to teach or suggest multiple limitations of Claims 1 and 14. See Section II.F.3.a-d, *supra* (analysis of merits for Factor 6 of *Fintiv*).

Accordingly, the *Beckton* factors and *Advanced Bionics* framework establish that institution should be denied.

IV. THE DIRECTOR SHOULD DENY INSTITUTION BASED ON OTHER RELEVANT CONSIDERATIONS

Acting Director Stewart’s March 26, 2025 Memorandum identifies other considerations that favor discretionary denial here.

A. Settled Expectations of the Parties

Acting Director Stewart’s March 26, 2025 Memorandum identified “the [s]ettled expectations of the parties, such as the length of time the claims have been in force,” as a relevant consideration. March 26, 2025 Memorandum, 2.

The ’521 Patent has been in force for over 15 years since issuing in May 2010. Ex. 1001 (cover page). These Petitioners or others could have challenged the ’521 Patent via petition for IPR or a request for reexamination (*ex partes* or *inter partes*) long ago—but did not. Based on the length of the time the ’521 Patent has been in force, Procomm has settled expectations as to the validity of its patent, and, particularly, to its right to have that validity adjudicated in a district court pursuant to the Seventh Amendment subject to the clear and convincing presumption of validity accorded by statute. U.S. Const. amend. VII; 35 U.S.C. §282(a); *Microsoft Corp. v. i4i Ltd. Partnership*, 564 U.S. 91, 97 (2011).

Further, Petitioners were aware of the '521 Patent at least as early as 2017 because Ericsson cited the published patent application (U.S. Pat. Pub. 2009/0310301) that resulted in the '521 Patent while obtaining U.S. Pat. No. 9,943,006 assigned to Ericsson. See Ex. 2010, 2. Petitioners offer no excuse for waiting from 2017 to 2024 before challenging the '521 Patent, all the while allowing Patent Owner's expectation of exclusivity to become settled.

B. Petitioners' Extensive Reliance on Parroted Expert Testimony

Acting Director Stewart's March 26, 2025 Memorandum identified "the extent of the petition's reliance on expert testimony" as a relevant consideration. March 26, 2025 Memorandum, 2.

Here, the Petition extensively relies on expert testimony in the form of an extensive 127-page declaration that merely repeats the Petition verbatim. See Ex. 1003 by Emad Tanbour ("Tanbour Decl." or "Tanbour Declaration"); Pet., 27 (grounds).

First, the Tanbour Declaration is extensive and burdensome at 127 pages. Petitioners seek to use this expert testimony to fill gaps in their invalidity theories that are supposed to be based on the asserted references stated in the grounds. See 37 C.F.R. § 42.104(b)(4).

Second, the Tanbour Declaration completely parrots the Petition and thus should be accorded little weight. The Federal Circuit has held that expert declarations that parrot the petition should be disregarded. *Bell Semiconductor LLC v. NXP B.V.*, 2024 WL 4984053 at *3 (Fed. Cir. 2024) (unpub.) (“Board accurately characterized NXP’s expert testimony as conclusory and correctly pointed out that the only evidence in NXP’s petition was a citation of their expert’s declaration that parrots the language of the petition.”); *Garmin International, Inc. v. LoganTree, LP*, 825 Fed.Appx. 894, 898 n.5 (Fed. Cir. 2020) (unpub.) (“The Board, however, correctly found that Garmin’s expert merely parroted attorney argument without any supporting evidence or reasoning.”).

The Board, too, has repeatedly held that expert declarations like the Tanbour Declaration—which parrots the Petition *word-for-word*—should be disregarded. *See, e.g., Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 (Director Review: Feb. 10, 2023) (precedential), 5 (“the declaration copies, word-for-word, Petitioner’s conclusory assertions ... as though they are facts, rather than setting forth facts and evidence in support of Petitioner’s assertions”); *Halliburton Energy Services, Inc. v. Schlumberger Tech. Corp.* IPR2017–02072, Paper 11, 2018 WL 1891086 (PTAB Apr. 12, 2018) (decision denying institution) at *7 (“Mr. Todd’s testimony, which, again, merely parrots the conclusory statement ... is entitled to

little, if any, weight”); *Free-Flow Packaging Int’l, Inc. v. Automated Packaging Sys., Inc.*, IPR2016-00447, Paper 7 (PTAB June 22, 2016), 10 (“Dr. Kimmel’s declaration...does nothing more than parrot the language of the Petition word for word”).

The Tanbour Declaration parrots the Petition verbatim. Ex. 2016 is a comparison of the Tanbour Declaration (Ex. 1003) to the Petition. As can be seen from Exhibit 2016, all of the opinions in paragraphs 65-190 of the Tanbour Declaration addressing Grounds 1-3 are a *verbatim cut-and-paste* from pages 28-86 of the Petition. See Ex. 2016 (comparing Ex. 1003, Tanbour Decl., to Petition), 73-204. See Ex. 2017 (Schreiner Decl. in support of Ex. 2016). Accordingly, the Tanbour Declaration should be given no weight. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 (Director Review: Feb. 10, 2023) (precedential), 5.

For example, the Petition describes the Sterner Reference of Ground 1 as follows:

Sterner explains that electronic device 10, such as a notebook computer, includes a keyboard portion 220 (**red**) and a display portion 200 (**blue**). The keyboard portion 220 includes barriers 232 (**brown**) forming isolated enclosures or cavities 234, 230 (**orange**) that house heat producing electronic devices 240, 300 (**green**) respectively. A

cooling device comprising air-moving device 100 (**dark green**), such as a fan or blower, and air duct (venturi chamber) 15 (**purple**) is positioned in enclosure 234. Air is drawn into the enclosures 234, 230 (**orange**) through vents 260, 270 (**pink**) respectively to remove heat produced by components 240, 300 housed within the enclosures.

Pet., 29. The Tanbour Declaration parrots that passage verbatim, right down to the color coding. See Tanbour Dec., ¶ 67.

The Petition describes the Aakalu '407 reference as follows:

Aakalu explains that enclosure 10 (referred to as a microcell) comprises housing 12 (**blue**) and solar shield 14 (**orange**). A plurality of electronic components 16 (**green**) are mounted to the interior of housing 12. Housing 12 comprises front panel 18 (**gold**), rear panel 20 (**gold**), and two side panels 22, 24 (**gold**), each of which form heat sinks for absorbing and dissipating heat generated by electronic components 16 (**green**).

Pet., 52. Once again, the Tanbour Declaration parrots that passage verbatim down to the color coding. See Tanbour Dec., ¶ 118.

Additionally, this expert declaration repeatedly makes *ipse dixit* assertions that are not linked to evidentiary support. *TQ Delta, LLC v. CISCO Systems, Inc.*, 942 F.3d 1352, 1360 (Fed. Cir. 2019) (disregarding *ipse dixit* assertion “untethered to any supporting evidence”). See, e.g., Tanbour Decl., ¶¶ 140 (unsupported

assertion reference has a “restriction chamber”), 163 (unsupported assertion reference has a “Venturi effect”).

In sum, the Petition is based on excessive, duplicative, and unreliable expert testimony. In an IPR, expert testimony is supposed to explain the reasoning and evidence in a manner that helps the Board understand the arguments in the Petition. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 (Director Review: Feb. 10, 2023) (precedential), 5. An expert declaration like this one, which merely parrots the Petition word-for-word throughout, does not help the Board at all.

In light of all of this, Petitioners’ expert declaration unduly multiplies the effort required to evaluate its Petition.

The use of expert testimony in connection with this Petition thus weighs in favor of non-institution.

V. CONCLUSION

For the foregoing reasons, the Director should deny institution.

Dated: April 28, 2025

Respectfully submitted,

/ Stephen Schreiner /
Stephen T. Schreiner
(Reg. No. 43,097)
CARMICHAEL IP, PLLC
8607 Westwood Center Drive
Suite 270
Tysons, VA 22182
Tel: (703) 646-9248
schreiner@carmichaelip.com

Counsel for Patent Owner

VI. CLAIMS APPENDIX²

Claim 1

[1.0] 1. A cooling unit for an enclosure housing electronics, the cooling unit comprising:

[1.1] a fan shroud having at least one electrical fan; and

[1.2] a Venturi chamber having [a] a first inlet for receiving a heated airflow from a heatsink, [b] a second inlet for receiving an airflow from a surrounding environment, and [c] an outlet coupled to the fan shroud, the fan drawing air from the Venturi chamber via the outlet when the fan is on;

[1.3] wherein the Venturi chamber comprises a wall for directing the airflow air from the surrounding environment in from the second inlet and across the heated airflow from the heatsink in a manner to as to draw the heated airflow through the heatsink using a Venturi effect, when the fan is on.

² The claim limitations are numbered as they are in the petition filed in IPR2024-01454, except brackets [a]-[c] have been added to limitation 1.2.

Claim 2

2. The cooling unit of claim 1, wherein the fan shroud is offset from the Venturi chamber such that when the fan is not on, the fan shroud does not obstruct a natural circulation airflow entering the first inlet and exiting the second inlet of the Venturi chamber.

Claim 3

3. The cooling unit of claim 1, wherein the at least one electrical fan includes a primary fan and a backup fan that becomes operational upon a failure of the primary fan.

Claim 4

4. The cooling unit of claim 1, wherein the Venturi chamber first inlet encircles one or more convective openings of the heatsink.

Claim 5

5. The cooling unit of claim 1, wherein the airflow from the surrounding environment is cooler than the heated airflow.

Claim 14

[14.0] 14. A method for cooling a sealed environment of an enclosure for housing electronics, the method comprising:

[14.1] directing heat generated by one or more electronic devices housed within a sealed environment of an enclosure to a heatsink thermally coupled to an external environment;

[14.2] drawing a first airflow across one or more convective openings of the heatsink, wherein the first airflow does not flow into the one or more convective openings of the heatsink;

[14.3] drawing a second airflow of heated air from the one or more convective openings using a Venturi effect created by drawing the first airflow.

Claim 15

[15.0] The method of claim 14

[15.1] wherein drawing the first airflow further comprises drawing the first airflow into a Venturi chamber;

[15.2] wherein drawing the second airflow further comprises drawing the second airflow into the Venturi chamber;

[15.3] the method further comprising operating a fan to pull the first airflow and the second airflow out of the Venturi chamber.

Claim 16

16. The method of claim 14, further comprising operating a fan to draw the first airflow and the second airflow.

Claim 17

17. The method of claim 15, wherein the fan is located offset with respect to the Venturi chamber to not impede a natural circulation of airflow through the Venturi chamber when the fan is not in operation.

Claim 18

18. The method of claim 15, further comprising operating the fan when a temperature exceeds a predetermined threshold.

Claim 19

[19.0] A method for cooling a sealed environment of an enclosure for housing electronics, the method comprising:

[19.1] directing heat generated by one or more electronic devices housed within a sealed environment of an enclosure to a heatsink thermally coupled to an external environment;

[19.2] when a temperature exceeds a first predetermined threshold, operating a fan to draw a first airflow across one or more convective openings of the heatsink and a second airflow of heated air from the one or more convective openings of the heatsink using a Venturi effect created by drawing the first airflow, wherein the first airflow does not flow into the one or more convective openings of heatsink;

[19.3] when the temperature does not exceed a second predetermined threshold, allowing a natural circulation airflow to flow from the one or more convective openings of

the heatsink by not operating the fan.

Claim 20

20. The method of claim 19, wherein the fan is located such as to not impede the natural circulation airflow when the fan is not in operation.

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner Discretionary Denial Brief Requesting Denial of Institution consists of 7,788 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The Request complies with the type-volume limitation of 14,000 words set out at 37 C.F.R. §42.24 and Acting Director Stewart's March 26, 2025 Memorandum titled "Interim Processes for PTAB Workload Management." In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

Dated: April 28, 2025

/Stephen T. Schreiner/
Stephen T. Schreiner (Reg. No. 43,097)
CARMICHAEL IP, PLLC
8607 Westwood Center Drive
Suite 270
Tysons, VA 22182
Tel: (703) 646-9254
schreiner@carmichaelip.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on April 28, 2025, I caused a true and correct copy of the foregoing PATENT OWNER DISCRETIONARY DENIAL BRIEF REQUESTING DENIAL OF INSTITUTION to be served on the following counsel for Petitioner by electronic mail to the following email addresses:

Ericsson and Verizon counsel:

Patrick D. McPherson
Patrick Craig Muldoon
D. Joseph English
Duane Morris LLP
901 New York Avenue N.W., Suite 700 East
Washington, D.C. 20001
Email: PDMcPherson@duanemorris.com
Email: PCMuldoon@duanemorris.com
Email: DJEnglish@duanemorris.com
Email: DC-IPdocketing@duanemorris.com

Verizon counsel:

Kevin P. Anderson
Duane Morris LLP
901 New York Avenue N.W., Suite 700 East
Washington, D.C. 20001
Email: KPAnderson@duanemorris.com

By: /Stephen T. Schreiner/
Stephen T. Schreiner (Reg. No. 43,097)
CARMICHAEL IP, PLLC
8607 Westwood Center Drive, Suite 270
Tysons, VA 22182
Tel: (703) 646-9254
schreiner@carmichaelip.com

Counsel for Patent Owner