

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. IPR2024-01454

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

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

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 (Stern)
2016	Comparison of Petition to Ex. 1003 (Tanbour Declaration)
2017	Declaration of Stephen Schreiner in support of Ex. 2016 compare document
2018	Amended 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 June 4, 2025 (Dkt. 80) – NEW

Pursuant to Acting Director Stewart’s June 10, 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. The Amended Docket Control Order Strongly Supports Discretionary Denial

On June 4, 2025, the district court issued an Amended Docket Control Order moving trial to February 17, 2026. Ex. 2018, 1. Thus, trial here will occur more than five months before the July 29, 2026 due date for a final written decision. The current median time-to-trial statistics for the Eastern District of Texas suggest a trial date around October 2025. PO Br., 5-6; Ex. 2008, 35.

In *Arm Ltd. and Mediatek Inc. v. Daedalus Prime LLC*, IPR2025-00207, Paper 10 (PTAB May 16, 2025), the Director denied institution where trial was scheduled five months before the projected final written decision due date and a month or two after the median time-to-trial statistics indicated. The Director in *Arm* held that under those facts, “it is unlikely that a final written decision in this proceeding will issue before district court trial occurs.” *Id.*, 2.

The facts here weigh even more strongly in favor of discretionary denial. Similar to *Arm*, trial is scheduled five months before the final written decision is expected. Further, the median time-to-trial statistics indicate trials in the Eastern District of Texas would typically take place eight months before the final written

decision in this IPR is due to issue. Ex. 2004 [Judicial Caseload Statistics], 35.

Thus, the trial date is unlikely to move.

Because of Petitioners' delay in filing this petition—filed less than two weeks before the one-year statutory deadline—the district court litigation proceeded to an advanced stage where it will adjudicate validity well before a decision would be due in the IPR. Petitioners offer various excuses for their delay. Pet.'s Br., 7-8. But Petitioners were in control of the drafting of the Petition including when it was filed. Petitioners also possessed the knowledge about which of their products were potentially infringing the '521 Patent. Petitioners should have started preparing and filing a petition challenging all potentially infringed claims promptly after suit was filed on January 10, 2024, instead of waiting nearly twelve months until December 31, 2024.

Consequently, the trial date that is more than five months ahead of the date for a decision in the IPR strongly weighs in favor of discretionary denial.

II. The *Sotera* Stipulation has limited, if any, estoppel effect

Petitioners' Opposition presents a *Sotera* stipulation and argues that under *Fintiv* Factor 4, “[i]n view of Petitioners' *Sotera* stipulation, there will be no overlap between the issues raised in the Petition and issues to be adjudicated in the Related Litigation.” Pet. Br., 2, 9. Petitioner is wrong for several reasons.

First, the Petitioners’ assertion that they will not rely on system art is contradicted by their invalidity contentions for the ’521 Patent, which indicate they may rely on “operational systems” to prove invalidity. Ex. 2009 (invalidity contentions), 6. They indicate they may even “rely on any prior art system referenced, embodied, or described in any of the prior art references ... or which embodies any of the prior art references identified herein.” *Id.* Further, Petitioners could amend their invalidity contentions to assert system art not covered by their *Sotera* stipulation.

Second, Petitioners ignore the USPTO’s clear guidance that *Sotera* stipulations do not eliminate overlapping issues. The USPTO’s FAQs for Interim Process for PTAB Workload Management (“FAQs”) explain that “a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited.” *Id.*, FAQ 14. Similarly, the Director held in *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (PTAB March 28, 2025) that a *Sotera* stipulation does not ensure that the “IPR proceedings would be a ‘true alternative’ to the district court proceeding.” *Id.* at 3-4. *See, e.g., Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1367 (Fed. Cir. 2015) (“the statutory goal of providing a relatively quick and low cost alternative to litigation over validity”).

Third, Petitioners' statements ignore the Federal Circuit's recent decision in *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354 (Fed. Cir. May 7, 2025), which gutted IPR estoppel. *Ingenico* held that "IPR estoppel does not preclude a petitioner from asserting the same prior art raised in an IPR in district court." *Id.*, 1365-66. Under *Ingenico*, the same prior art that was raised in an IPR petition can be used under different grounds in the district court litigation. That is, "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 based on the same prior art used in the IPR. *Id.*, 1366.

Petitioners' *Sotera* stipulation parrots the IPR estoppel statute (35 U.S.C. § 315(e)(2)). Thus, Petitioners' *Sotera* stipulation would likely be subject to the interpretation of "grounds" in *Ingenico*.

The prior art in this IPR demonstrates the futility of *Sotera* stipulations under *Ingenico*. The '521 Patent has a filing date of June 11, 2008. Ex. 1001 ['521 Patent], (22). The Sterner reference that is used for Ground 1 in the Petition is a patent that issued on April 18, 2006. Ex. 1004 (Sterner). As a publicly-available document, Petitioners could argue that Sterner was "known ... by others in this country" under 35 U.S.C. §102(a) (pre-AIA) and would be available for use in the district court even with a *Sotera* stipulation. Indeed, Petitioners' invalidity

contentions assert the very same Sterner reference that is the basis for Ground 1 of the Petition. See Ex. 2004, 14, 173-209.

Because Petitioners' *Sotera* stipulation has no meaningful effect on the invalidity proceedings in the district court, *Fintiv* Factor 4 strongly favors denial.

III. The *iRhythm* Decision Supports Discretionary Denial

As the Patent Owner explained in its opening brief, the '521 Patent has been in force for over fifteen years, and the Petitioner was aware of the '521 Patent's application since at least 2017, PO Br., 39-40 (citing Ex. 2010, U.S. Pat. No. 9,943,006 assigned to Ericsson, citing U.S. Pub. No. 2009/0310301 corresponding to the '521 Patent). Despite that knowledge, Ericsson never sought earlier review of the '521 Patent via reexamination or IPR. PO Br., 39.

As explained in *iRhythm Technologies, Inc. v Welch Allyn, Inc.*, IPR2025-00363 Paper 10 (PTAB June 6, 2025) at *3, the "Petitioner's awareness of Patent Owner's application[] and failure to seek early review of the patents favors denial." Thus, Patent Owner's settled expectations favors denial of institution.

IV. Conclusion

For the foregoing reasons, the Director should deny institution.

Dated: June 12, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on June 12, 2025, I caused a true and correct copy of the foregoing **PATENT OWNER'S REPLY IN SUPPORT OF REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** to be served on the following counsel for Petitioner by electronic mail to the following email addresses:

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