

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. IPR2024-01455

U.S. Patent No. 8,497,813

PATENT OWNER'S REQUEST FOR DISCRETIONARY
DENIAL OF INSTITUTION

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.)
2002	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.)
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.)
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/federal-courtmanagement-statistics
2005	LegalMetric District Report for Texas Eastern District Court in Patent Cases (January 2019-April 2024)

Pursuant to Acting Director Stewart’s March 26, 2025 Memorandum titled “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 Celco Partnership’s Petition for *inter partes* review of U.S. Patent No. 8,497,813. 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 ’813 Patent *nine months before* the expected date of the Final Written Decision in this IPR, and maintaining this proceeding when the validity of the ’813 Patent will have already been decided by the district court is an inefficient use of the PTO’s and parties’ time and resources.

I. THE DIRECTOR SHOULD EXERCISE DISCRETION UNDER SECTION 314 AND DENY INSTITUTION

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.” *Id.*

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 discretionary denial due to efficiency considerations relating to parallel proceedings is appropriate (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;
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 the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv I*”), 6; *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 particularly weak on the merits, and Petitioners have not even bothered to submit a *Sotera*-type stipulation. Procomm thus respectfully requests that the Director deny institution.

A. Factor 1

The first *Fintiv* factor—regarding whether a stay exists or is likely to be granted if a proceeding is instituted—weighs in favor of denial. Although Petitioners filed a motion to stay pending IPR on March 12, 2025, Petitioners’ motion will almost certainly be denied because the district court has a “consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.” Ex.2003 (Plaintiff’s Opposition to Defendants’ Motion to Stay); *Luminati Networks Ltd. v. Teso LT, UAB*, No. 2:19-CV-00395-JRG, 2020 WL 6803255, at *1 (E.D. Tex. Oct. 30, 2020); *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13 CV-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (Bryson, J.) (“it is the universal practice of courts in this District to deny pre-institution motions to stay); *Viavi Sols. Inc. v. Zhejiang Crystal-Optech Co.*, No. 2:21-CV-00378-JRG, 2022 WL 16856099, at *5 (E.D. Tex. Nov. 10, 2022) (“It is the Court’s established practice to consider motions to stay pending IPR

proceedings which have not been instituted are inherently premature and should be denied as such.”).

Even post-institution, the district court judge is unlikely to stay the case absent agreement from the parties. Ex.2005, 85 (showing a 20% win rate on contested motions to stay pending IPRs before Judge Schroeder). Thus, this factor weighs in favor of denial.

B. 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—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. The Notice of Filing Date Accorded to Petition was mailed on January 29, 2025. Paper 4. A Final Written Decision will therefore 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). 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.2004, 35. The district court litigations were filed on January 8, 2024. Paper 6, 2. These statistics suggest 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 media 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 at 12-13 (PTAB Jan. 19, 2023) (holding Factor 2 “weighs in favor of denying institution, given that we would not expect to issue a final written until at least four months” after trial). Here, the 9-month gap between the district court trial and the final written decision is longer than in cases such as *Ericsson* where the Board has previously 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, 15-19 (PTAB Sept. 6, 2017) (precedential, designated Oct. 18, 2017). If IPR were instituted, any potential FWD would issue well after trial concludes. Indeed, the parties will still be briefing this IPR after the conclusion of the parallel district court trial. Thus, instituting IPR here would not be an “alternative” to parallel litigation. Rather, it would simply relitigate issues that will have been already decided in the parallel litigation.

C. 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; Ex.2002. By the expected July 29, 2025 institution decision date (*see* 35 U.S.C. §314(b)), the District Court would have held a *Markman* hearing and the parties would have completed expert discovery

and filed dispositive motions. Ex.2001, 4-5. Thus, by the expected time of the institution decision, most of the substantive work will have already been completed in the district court litigation and the parallel litigation would be almost at the eve of 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.”). 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 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. Moreso, Petitioners’ invalidity contentions were due on June 12, 2024. There is no reason for Petitioners to wait until December 31, 2024—6 months after their invalidity contentions—to file an 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 in favor of non-institution.

D. 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 only one independent claim (claim 1), which is also asserted in the parallel litigation. Thus, there is complete overlap of the principal patentability issues between this IPR and the parallel litigation. Furthermore, Petitioners have not submitted a *Sotera* type stipulation to remove the grounds that it could reasonably have raised in this IPR from the parallel litigation. Thus, it is anticipated that issues implicated by Petitioners’ references in this IPR would rearise in the parallel litigation. Both these facts favor denying institution.

By contrast, 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., 86 (*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 meaningless “*Sand Revolution*”-style stipulation that should be entitled to no weight because it only

precludes Petitioners from pursuing the exact grounds in the Petition and does not preclude Petitioners from reusing the same prior art in different grounds with minor modifications. Even in prior administrations, the Board has historically assigned almost no weight to *Sands Revolution* style stipulations such as the one Petitioner filed here. *LG Elecs., Inc. v. Ancora Techs., Inc.*, IPR2021-00581, Paper 16, 9-10 (PTAB June 10, 2021) (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, 19-20 (PTAB May 4, 2023) (same); *Roku, Inc. v. IOENGINE, LLC*, IPR2022-01554, Paper 11, 13-14 (PTAB May 5, 2023) (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 Petitioner's *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, 9-10 (PTAB

June 10, 2021), the Board denied institution despite the petitioner’s 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 referenced Hellman under any circumstance. The Board there agreed with the patent owner that, even with the petitioner’s 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’ meaningless stipulation should be assigned no weight. Accordingly, factor 4 favors discretionary denial.

E. Factor 5

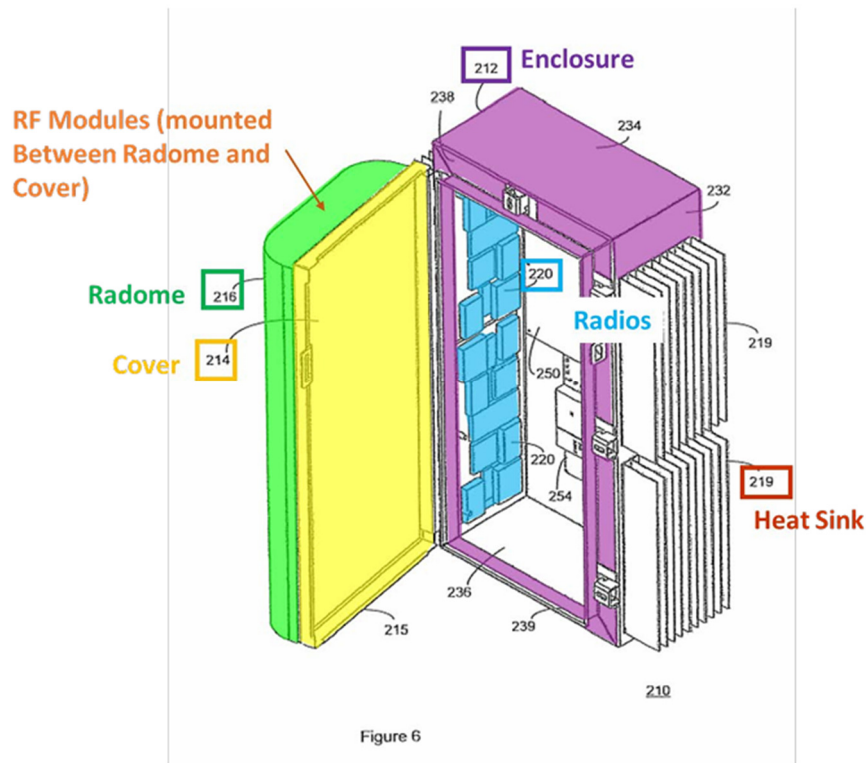
The fifth *Fintiv* factor—whether the petitioners and the defendant in the parallel proceedings are the same parties—weighs in favor of discretionary denial. The parties here are the same as the parties in the litigations. *Fintiv II*, 15 (“Because the petitioner and the defendant in the parallel proceeding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

F. 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.

First, the merits of the Petition are particularly weak. Indeed, when describing the “compelling merits” of the Petition, Petitioners only generically suggest that their references “disclose[] identical architecture and[] identical concepts” as the ’813 Patent, but do not address how those references suggest the precise language of the ’813 Patent’s claims. Pet., 87. Although Procomm will further address the deficiencies of Petitioners’ references in its forthcoming Preliminary Response, Procomm identifies two dispositive merits issues in this Request that should definitively preclude institution on the merits.

First, with respect to Ground 1 relying on the Bishop reference, Bishop does not suggest an enclosure including walls “defining an aperture through which the cavity of the enclosure may be accessed” where an internal cover and a mounted radome “overlap an area defined by the aperture.” Petitioners’ annotations of Fig. 6 of the ’813 Patent helpfully illustrate the claimed configuration:



Pet., 2. Here, the enclosure 212 has an aperture (in this example, defined by flange 238) through which the cavity of the enclosure is accessible. The aperture is closed by an internal cover 214 on which is mounted radome 216, consistent with the

claim language. Cover 214 opens and the interior of enclosure 212 is accessible through the aperture that cover 214 overlaps.

Bishop by contrast does not suggest “an aperture through which the cavity of the enclosure may be accessed” where an internal cover and a mounted radome “overlap an area defined by the aperture.” This is readily apparent from Petitioners’ annotations of Bishop:

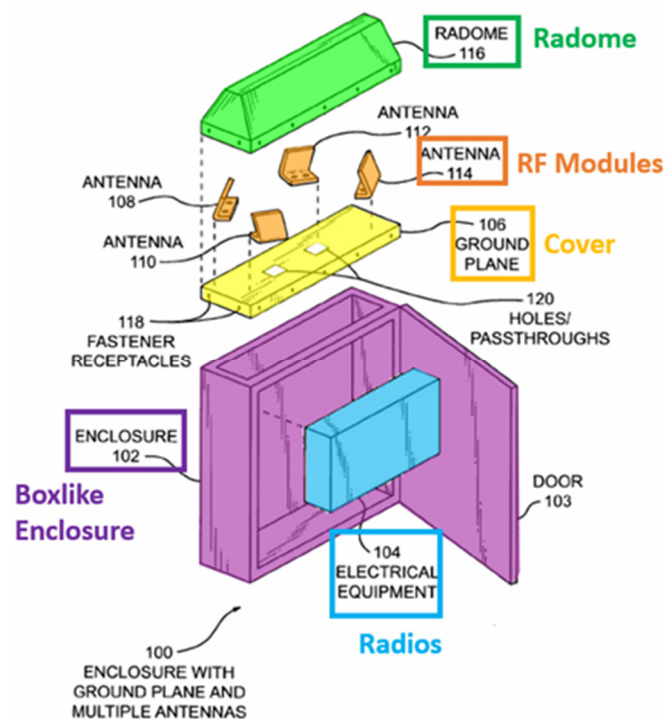


FIG. 1

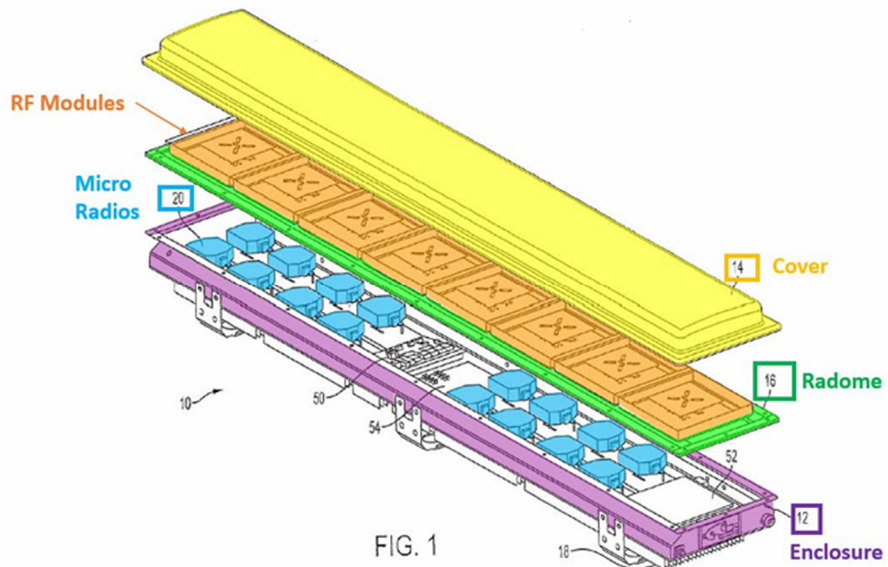
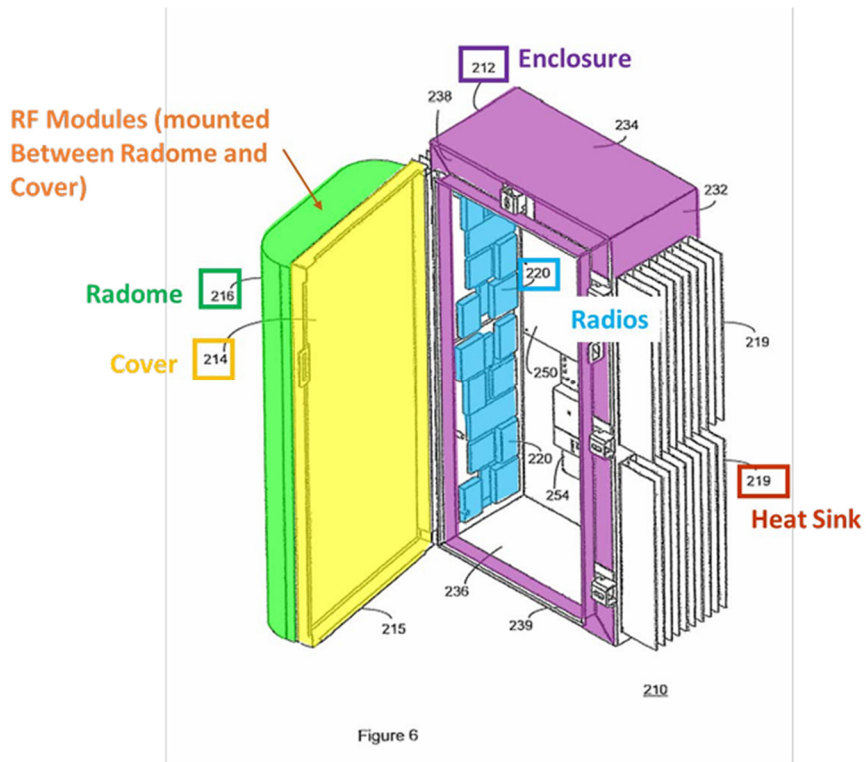
Pet., 27. In Bishop, the interior of enclosure 102 is accessed by an aperture defined by door 103 on the side of the enclosure. But because there is no radome mounted on door 103, Petitioners instead attempt to map ground plane 106, which has a

radome 116 mounted on it, to the claimed internal cover. This mapping however also fails because Bishop does not teach accessing the interior of enclosure 102 through the aperture covered by ground plane 106. Instead, Bishop teaches the interior of enclosure 102 is accessed through the separate door 103. Thus, ground plane 106 cannot be the claimed internal cover because the aperture covered by it is not the aperture through which the cavity of the enclosure in Bishop may be accessed. Rather, it is the aperture covered by door 103 that is through which the cavity of the enclosure in Bishop is accessed. But door 103 does not fit the rest of the mapping to claim 1 because it does not have a radome mounted to it.

Perhaps recognizing this distinction, the Petition further alleges that “[a]lthough the embodiment in Bishop is oriented such that the ground plane [internal cover] forms the top of the enclosure, consistent with the teaching of the ’813 Patent, a POSA understood that the enclosure of Bishop may be oriented such that the ground plane forms the front cover of the enclosure.” Pet., 44. But this reorientation does not address the fundamental difference between Bishop and the ’813 Patent: Bishop accesses the interior of enclosure 102 through a door 103 that is different than the ground plane 106 where radome 116 is mounted and, as a result, the aperture through which the cavity of the enclosure may be accessed is the aperture covered by door 103, not the aperture covered by ground plane 106.

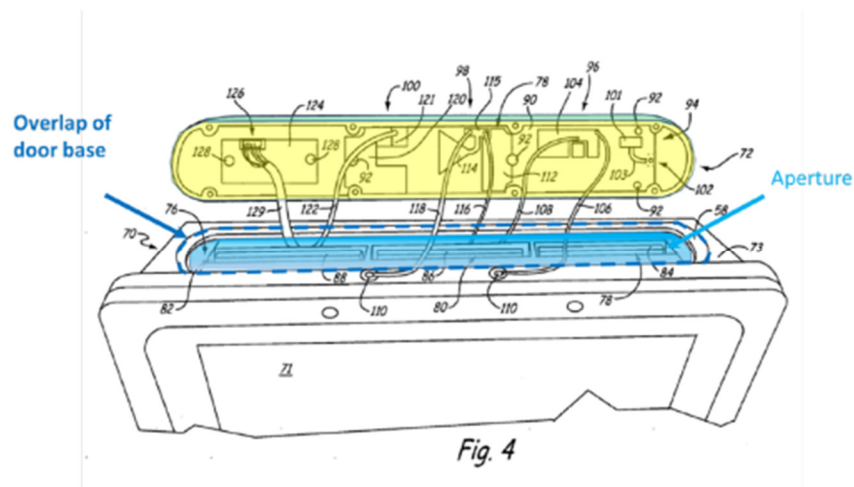
Even if Bishop is reoriented in the manner proposed by the Petition, the interior of enclosure 102 is still accessed through door 103. This modification does not resolve the fundamental problem that Bishop accesses the interior of enclosure 102 through door 103, not ground plane 106. None of the Ground 1's secondary references are cited for this issue; Petitioners' Ground 1 challenge thus fails to establish that the claims are an obvious modification of Bishop.

Second, with respect to Ground 2 relying on the Kelly reference, Kelly does not suggest an interior cover "having at least one RF radiating module fastened to an exterior surface thereof" and "dimensioned to overlap an area defined by the aperture" such that a lip extending from a flange is "engaged by the internal cover to provide the environmental seal." Annotated Figs. 1 and 6 of the '813 Patent illustrates an example of the claimed configuration:



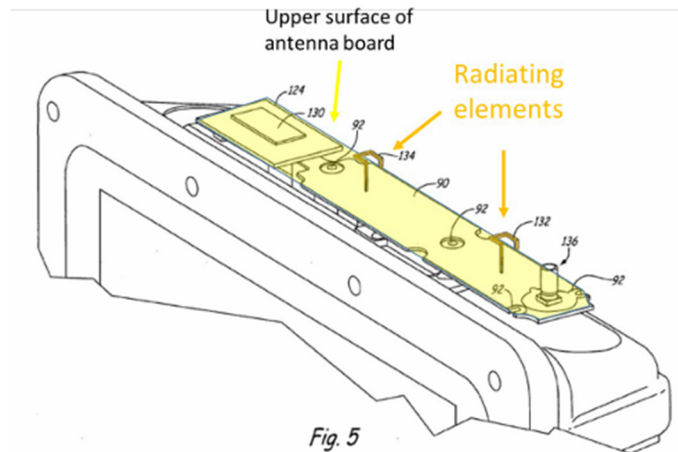
Pet., 2, 10. As claimed by the '813 Patent, this example shows that the RF radiating module is on the exterior of cover 214—beneath radome 216 and on the surface of cover 214 facing away from enclosure 212. Furthermore, the surface of cover 214 facing towards enclosure 212 (i.e., the *interior* surface that does not have the RF radiating module fastened to it) is the surface that is engaged by the lip extending from the flange to provide the environmental seal as claimed.

Kelly however does not suggest the claimed configuration where the RF radiating module is fastened to the exterior surface of an internal cover that is engaged by a lip extending from a flange to provide the environmental seal. This can be seen from Fig. 4 of Kelly:

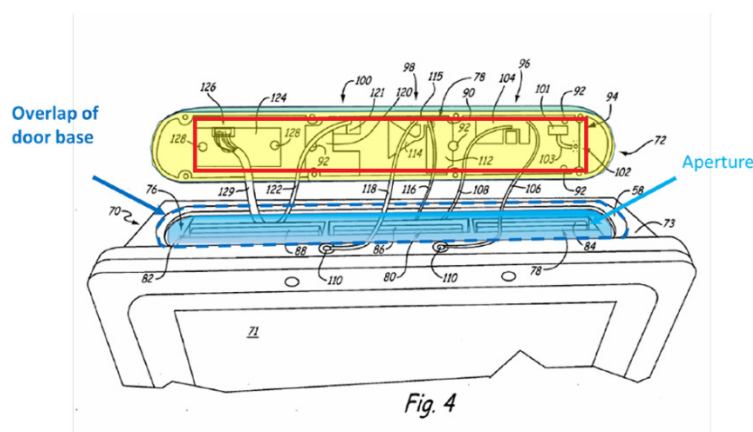


Pet., 81. First, it is important to note that Petitioners' annotations in yellow conflate two different elements: access door 72 and antenna board 90. Access door 72 is the entire area annotated in yellow in Fig. 4 above, whereas antenna board 90 as

shown in Fig. 4 is on the surface of access door 72 facing towards the housing and comprises only a portion of that surface, as shown by Fig. 5:



Annotated Fig. 4 below corrects this conflation and shows access door 72 in yellow and the portion of access door 72 with antenna board 90 outlined in red:



Because the Petition conflates access door 72 and antenna board 90, it fails to establish that one of access door 72 and antenna board 90 maps to the claimed internal cover. If antenna board 90 is mapped to the claimed internal cover, it does

not engage a lip extending from a flange to provide the environmental seal as claimed. Rather, Figs. 4 and 5 show that it is access door 72—not antenna board 90—that seals the aperture:

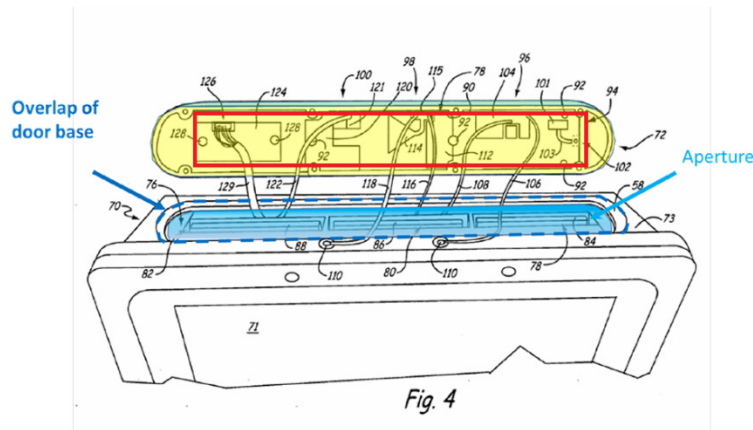
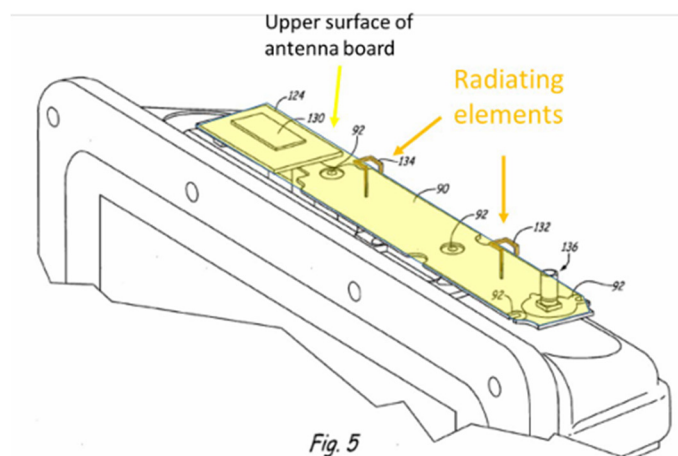


Fig. 5 shows that antenna board 90 does not match the shape of the surface of access door 72 and does not extend to the lip:



Kelly simply lacks any teaching of how antenna board 90, rather than access door 72, seals Kelly's device.

Alternatively, if access door 72 is mapped to the claimed internal cover, it does not have a RF radiating module fastened to an exterior surface thereof as claimed because the radiating elements are on the *interior* surface of the access door (i.e., the surface facing towards the housing). In either case, Kelly does not suggest the limitations of the internal cover specified by the claims. Furthermore, Ground 2's secondary reference (Avramis) is not cited for this issue; Petitioners' Ground 2 challenge thus fails to establish that the claims are an obvious modification of Kelly.

The March 26, 2025 Memorandum provides additional considerations for the factor 6 analysis including the extent of the petition's reliance on expert testimony and the settled expectations of the parties, such as the length of time the claims have been in force. Procomm submits that these considerations further favor discretionary denial.

Petitioners' expert Dr. Houh testifies that a person of ordinary skill would have been familiar with radio communications. Ex.1003, ¶47. But Dr. Houh testifies that his qualifications are in *network* communications, not radio communications, and it does not appear that the qualifications provided by Dr. Houh are sufficient to meet his own definition of a POSA. Ex.1003, ¶¶10-21 (listing his expertise as "Web Site Development, Data Networking, Optical

Networking, Telecommunications, and Media Streaming”—not radio communications—and providing experience in computer networks, telephone lines, Voice-over-IP, and speech recognition—again, not radio communications).

Dr. Houh’s declaration does not provide a single example of experience with radio communications. *Id.* Furthermore, a comparison of pages 38-54 of the Petition and paragraphs 78-117 of Dr. Houh’s Declaration shows that the Declaration is merely a word-for-word copy of the Petition’s arguments for claim 1 on Ground 1.

Likewise, a comparison of pages 67-82 of the Petition and paragraphs 150-170 of Dr. Houh’s Declaration again shows that the Declaration is merely a word-for-word copy of the Petition’s arguments for claim 1 on Ground 2. This is particularly problematic because the Petition periodically alleges in conclusory fashion that “a POSA understands” a particular assertion and then cites to Dr. Houh’s Declaration where the assertion is simply repeated verbatim without additional supporting evidence. Pet., 69 (alleging that “a POSA understands [antenna 114] to be a panel antenna”), 78-79 (alleging a POSA understands that Avramis’s heat sink improves Kelly’s computer). Respectfully, a declaration by an expert who lacks the requisite qualifications and whose testimony merely parrots the exact language of the Petition should weigh against institution under the expert testimony consideration of factor 6.

Finally, the '813 Patent issued on July 30, 2013, almost 12 years ago. Most of the 20-year life of the '813 Patent has already passed. 35 U.S. Code §154(a)(2). Patent Owner respectfully submits that it has an expectation to the validity of its property rights based on the length of time the claims have been in force, and this expectation should weigh against institution.

Accordingly, all six *Fintiv* factors weigh in favor of discretionary denial. The Board should use its discretion to deny institution of this IPR.

II. CONCLUSION

For the foregoing reasons, the Director should deny institution.

Dated: April 1, 2025

Respectfully submitted,

/ Minghui Yang /
Minghui Yang (Reg. No. 71,989)
CARMICHAEL IP, PLLC
8607 Westwood Center Drive
Suite 270
Tysons, VA 22182
Tel: (703) 646-9248
mitch@carmichaelip.com

Counsel for Patent Owner

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'S REQUEST FOR DISCRETIOARY DENIAL OF INSTITUTION** have been served electronically via email on counsel of record for Petitioners:

Patrick D. McPherson
Patrick C. Muldoon
D. Joseph English
Kevin P. Anderson
DUANE MORRIS LLP
901 New York Avenue NW
Suite 700 East
Washington, D.C. 20001
Email: PDMcPherson@duanemorris.com
Email: PCMuldoon@duanemorris.com
Email: DJEnglish@duanemorris.com
Email: KPAnderson@duanemorris.com
DC-IPdocketing@duanemorris.com

Date: April 1, 2025

Respectfully submitted,

By: /Minghui Yang/
Minghui Yang