

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 REPLY TO PETITIONERS' OPPOSITION TO
PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF
INSTITUTION

As authorized by the Director via email on May 7, 2025, Patent Owner Procomm International Pte. Ltd (“Procomm”) addresses the impact of Petitioners’ *Sotera* stipulation submitted with their Opposition to Patent Owner’s Request for Discretionary Denial of Institution. Paper 13 (“Opp.”), 3. Contrary to the Opposition’s representations at 1 and 7, Petitioners’ *Sotera* stipulation does not meaningfully eliminate the overlap between the issues raised in the Petition and the District Court litigation. *First*, Petitioners’ District Court invalidity contentions explicitly rely on system prior art that implicate the same issues as presented in the Petition. These references are outside the scope of Petitioners’ stipulation.

Ingenico, Inc. v. IOENGINE, LLC, No. 2023-1367, 2025 WL 1318188 at *7 (Fed. Cir. May 7, 2025). *Second*, Petitioners may, after an additional prior art search, assert further cumulative printed publications—unless Patent Owner can demonstrate that the additional prior art could not have been discovered sooner. Such references are also outside the scope of Petitioners’ stipulation. *Ironburg Inventions Ltd. v. Valve Corp.*, 64 F. 4th 1274, 1299 (Fed. Cir. 2023). Because Petitioners have not provided a stipulation that will eliminate the overlap between the invalidity theories presented in the Petition and asserted in the District Court, *Fintiv* factor 4, like the other factors, weighs in favor of denial. *Motorola Sol’ns, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at *3-4 (PTAB March 28, 2025) (“Petitioner’s [*Sotera*] stipulation does not ensure that these IPR proceedings would be a ‘true alternative’ to the district court proceeding ... Petitioner’s

invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner's stipulation is not likely to moot.").

A. *Fintiv* Factor 4: Petitioners' *Sotera* stipulation does not mitigate the overlap between the issues raised in the Petition and in the District Court

The Opposition promises that "Petitioners' *Sotera* stipulation proffered herein eliminates any overlap of issues presented in the Petition and issues to be tried in the Related Litigation." Opp., 1. Respectfully, Petitioners' *Sotera* stipulation is an empty promise that will not ensure that this IPR will be a true alternative to duplicative litigation of the '813 Patent's validity over the same issues in the District Court. There are simply too many loopholes, exceptions, and technicalities that will allow Petitioners to relitigate the issues raised here in the District Court despite their *Sotera* stipulation.

First, despite the Opposition's representation at 7 that "Petitioners are not relying on any corresponding system art in the Related Litigation," Petitioners *have* relied on corresponding system art in the Related Litigation. Ex.2009, 17 (relying on multiple system art against the '813 Patent, including "in combination" with the references asserted in this IPR). As the Director recognized in *Motorola*, a *Sotera* stipulation does not moot invalidity arguments in the District Court based

on combinations of references asserted in an IPR and system art. *Motorola*, IPR2024-01205 at *3-4. Indeed, the Federal Circuit recently affirmed that IPR estoppel using the same “reasonably could have raised” language as a *Sotera* stipulation does not preclude a petitioner from relying on the same patents and printed publications as evidence if used in a different ground, such as combined with system art. *Ingenico*, No. 2023-1367 at *7 (“IPR estoppel applies only to a petitioner’s assertions in district court that the claimed invention is invalid under 35 U.S.C. §§ 102 or 103 because it was patented or described in a printed publication (or would have been obvious only on the basis of prior art patents or printed publications).”). Under the Federal Circuit’s holding, Petitioners could even rely on the same prior art *alone* under a theory of sale or public use rather than publication. *Id.*

Even setting aside Petitioners’ ability—despite their *Sotera* stipulation—to relitigate the art asserted in this IPR alone or in combination with system art, Petitioners’ invalidity contentions also show that they intend to relitigate the same issues raised by the Petition in the District Court by substituting their system art for the patents asserted here. Petitioners’ invalidity contentions are replete with allegations that their system art provide the same teachings as their IPR references. Ex.2009, 40 (citing Avramis and system art E-Zy, MT-900007, and Flexwave for

the same teaching), 41 (citing Avramis, Bishop and Lakoduk, and system art E-Zy, MT-900007, and Flexwave for the same teaching), 42 (citing Bishop and Lakoduk, and system art MT-900007 and Two-Way Signal Booster System for the same teaching). The invalidity contentions confirm that the parties will be relitigating the same invalidity theories presented in the Petition in the District Court—through the same prior art, through cumulative system art, or a combination thereof—regardless of Petitioners’ *Sotera* stipulation.

Second, Petitioners may circumvent their *Sotera* stipulation by conducting further prior art searches and rely on any newly discovered printed publications to relitigate the same invalidity theories presented here in the District Court. The Federal Circuit places the burden on Patent Owner to show that any newly discovered printed publications could not have been discovered previously. *Ironburg*, 64 F. 4th at 1299. This has led to some District Courts permitting unsuccessful Petitioners to assert prior art *patents* against patents previously confirmed in IPRs. *EIS, Inc. v. Intihealth Ger GMBH*, No. 19-1227-GBW, 2023 WL 6797905 at *2-5 (D.Del. Aug. 30, 2023) (denying motion for IPR estoppel and permitting the defendant to argue invalidity based on a patent that was not discovered prior to defendant’s IPR); *Geigtech East Bay LLC v. Lutron Electronics Co., Inc.*, No. 16-CV-05290-CM, 2023 WL 8827572 at *8 (S.D.N.Y. December

21, 2023) (same). Petitioners' *Sotera* stipulation will not eliminate any overlap of issues presented in the Petition and to be litigated in the District Court. None of this is an alternative to litigation as promised by the AIA.

Finally, the Opposition argues that "PO asserted only Claim 1 and Claim 4 dependent from Claim 1" whereas "Petitioners have challenged Claims 1, 2, and 4-7, thus[,] only a subset of the challenged claims will be asserted in the Related Litigation." Opp., 7. But claim 1 is the only independent claim asserted in the District Court litigation and challenged in this IPR. Thus, every issue of validity decided by the District Court will also be before the Office. Even if there is not a complete overlap of claims challenged here and asserted in the District Court, the *Fintiv* factors address efficiency considerations. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020). Respectfully, there is minimal further efficiency to be gained from the Office deciding the validity of two additional dependent claims (2 and 7) beyond those that will be decided by the District Court.

For these reasons, Petitioners' *Sotera* stipulation does not meaningfully eliminate the overlap between the invalidity theories presented in the Petition and asserted in the District Court. Patent Owner respectfully requests that the Director exercise her discretion and deny institution.

Dated: May 9, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that, pursuant to 37 CFR § 42.6(e), a true and correct copy of the foregoing **PATENT OWNER'S REPLY TO PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** have been served electronically via email on counsel of record for Petitioners:

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