UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Charter Communications, Inc.,
Petitioner

v.

Adaptive Spectrum and Signal Alignment, Inc.,
Patent Owner

Case No. IPR2025-00012

U.S. Patent No. 10,848,398 B2

Filing Date: May 6, 2014
Issue Date: November 24, 2020

Title: METHOD, APPARATUS, AND SYSTEM FOR OPTIMIZING PERFORMANCE OF A COMMUNICATION UNIT BY A REMOTE SERVER

PETITIONER'S SUPPLEMENTAL BRIEF REGARDING RESCISSION OF THE *FINTIV* MEMO

I. INTRODUCTION

On March 26, 2025, the Patent Trial and Appeal Board ordered the parties to submit supplemental briefing regarding the effect of the recission of the *Fintiv* Memo on the parties' analysis under 35 U.S.C. § 314. IPR2025-00012, Paper 11 at 3 (Mar. 26, 2025). Petitioner Charter Communications, Inc. ("Petitioner") respectfully submits this supplemental brief.[1]

II. THE BOARD SHOULD NOT EXERCISE ITS DISCRETION UNDER 35 U.S.C. § 314(A) TO DENY INSTITUTION, DESPITE RECISSION OF THE *FINTIV* MEMO

On February 28, 2025, the USPTO announced it was rescinding the June 21, 2022 *Fintiv* Memo, which provided guidance regarding discretionary denials under 35 U.S.C. § 314(a) (the "Memo").[2] The rescission of the Memo, however, did not fundamentally change the Board's discretionary approach nor its application of the *Fintiv* factors. Rather, the USPTO merely refers parties to existing precedent and specifically *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020). *See* PTAB Guidance on USPTO's recission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation," March 24, 2025 ("Recission Guidance").

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[1] Pursuant to the Board's March 26, 2025 Order, Petitioner does not present any new evidence in this supplemental brief.
[2] https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures.

Denial of institution under § 314(a) remains within the Board's discretion. Institution decisions following recission reinforce the fact that the Board considers and applies the *Fintiv* factors to each case. Here, Petitioner's original analysis of the *Fintiv* factors did not focus on the Memo guidance and remains unchanged. For the reasons set forth in the Petition, the Board should not exercise discretion to deny institution. *See* Pet. at 5-9.

Factor 1 is neutral as the parties have not requested a stay. The analysis related to this factor is unchanged by rescission of the Memo, and the parties agree that *Fintiv* Factor 1 is neutral. *See* Pet. at 5-6; POPR at 37.

Factor 2 is neutral as the likely trial date is close in proximity to the projected statutory deadline for a final written decision. The Board still considers median time-to-trial and pending transfer under this factor. *See Toyota Motor Corp. v. Emerging Automotive LLC*, IPR2024-00785, Paper 13 at 11-12 (Mar. 11, 2025); *see also* Recission Guidance. As noted in the Petition, given median times-to-trial in EDTX and DCO, a trial is unlikely to occur before February or March 2026. EX1008; EX1009. The projected statutory deadline for a final written decision is May 2026. The Board has considered a pending transfer motion under this factor after the Memo's Recission. *See, e.g., Mobileye Global, Inc. v. Facet Tech. Corp.*, IPR2024-01110, Paper 16 at 12 (Mar. 5, 2020) (noting that the pending transfer motion "may delay the trial date in the Texas Litigation"). Thus, although the district

court litigation currently has a September 22, 2025 (EX1007) trial date, the Board should consider, in its discretion, the unlikelihood that trial proceeds on this date.

In fact, prior to the guidance of the Memo, the Board acknowledged uncertainty of scheduled trial dates under certain circumstances. *See, e.g., Sand Revolution II, LLC v. Continental Intermodal Grp. Trucking LLC*, IPR2019-01393, Paper 24 at 8-9 (Jun. 16, 2020). That uncertainty is even more prevalent in the Eastern District of Texas where Judge Gilstrap has a practice of stacking multiple cases on the same trial date. *See Samsung Elecs. Co., Ltd. v. Acorn Semi, LLC*, IPR2020-01207, Paper 21 at 31 (Feb. 10, 2021) (the Board explained, prior to the Memo, that "the number of other cases that are also scheduled to trial [in Judge Gilstrap's court] . . . introduce[d] some uncertainty" as to the scheduled trial). The facts before the Board as to this factor in no way support "strongly" favoring denial. *Compare* POPR at 37 *with Samsung*, Paper 21 at 31 (these circumstances "prevent this factor from weighing strongly against institution").

Factor 3 weighs against exercising discretion as the parties had not meaningfully invested in the litigation at time of filing. This factor is unchanged and weighs against exercising discretion to deny institution.

Factor 4 weighs against exercising discretion as Petitioner stipulated to not rely on any references identified in the Petition. Petitioner stipulates it will not pursue in the district court litigation any ground that Petitioner raised or

reasonably could have raised in this proceeding. *Sotera Wireless*, Paper 12 at 18-19. Accordingly, "following *Sotera Wireless*, this factor strongly favors institution." *Samsung*, Paper 21 at 34; *see also Mobileye*, Paper 16 at 15 (finding, post-Memo, a *Sotera* stipulation "weigh[s] strongly against exercising our discretion to deny institution"); *see also* Recission Guidance at 2-3 (explaining "a timely-filed *Sotera* stipulation . . . is highly relevant").

Factor 5 weighs in favor of discretion, but is not dispositive. The analysis of this is factor is unchanged by recission of the Memo as the parties are the same.

Factor 6 strongly weighs against exercising discretion given the merits of the Petition. This factor is no longer dispositive, but institution decisions predating the Memo and since its recission indicate that a petition presenting compelling evidence of patentability weighs heavily against exercising discretion for denial. *See, e.g., Mobileye*, Paper 16 at 16; *Fintiv, Inc.*, IPR2020-00019, Paper 11 at 14-16; *Sand*, Paper 24 at 12-14, 57; *cf. Toyota*, Paper 13 at 15-16; *see also* Recission Guidance at 3 (noting strength of merits should still be considered).

III. CONCLUSION

Fintiv factors 3-4 and 6 weigh in favor of not exercising discretion to deny institution, factors 1-2 are neutral, and only factor 5 favors denying institution Petitioner respectfully requests the Board not exercise its discretion to deny institution of its Petition regarding the '398 Patent.

Respectfully submitted,

/Erik B. Milch/ Dated: April 2, 2025

Erik B. Milch (Reg. No. 42,887)
Elizabeth Shrieves (*Pro hac vice*)
Edward Wang (*Pro hac vice)*
Proskauer Rose LLP
1001 Pennsylvania Ave., NW
Suite 600
Washington, DC 20004
Tel: (202) 416-6800
emilch@proskauer.com
eshrieves@proskauer.com
ewang@proskauer.com

Joseph Drayton (*Pro hac vice*)
Eleven Times Square
New York, NY 10036
Tel: (212) 969-3000
jdrayton@proskauer.com

Attorneys for Petitioner,
Charter Communications, Inc.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), I hereby certify that on April 2, 2025, I caused a complete copy of this Petitioner's Supplemental Brief Regarding Recission of the *Fintiv* Memo, to be served on the Patent Owner attorneys of record via electronic mail:

David L. Alberti (Lead Counsel)
dalberti@krameralberti.com

Jason A. Fitzsimmons (Back-up Counsel)
jfitzsimmons-PTAB@sternekessler.com

Richard M. Bemben (Back-up Counsel)
rbemben-PTAB@sternekessler.com

Michael D. Specht (Back-up Counsel)
mspecht-PTAB@sternekessler.com

Hong S. Lin (Back-up Counsel)
hlin@krameralberti.com

Sal Lim (Back-up Counsel)
slim@krameralberti.com

PTAB@sternekessler.com

/Erik B. Milch/
Erik B. Milch (Reg. No. 42,887)

CERTIFICATE OF COMPLIANCE

Petitioner certifies:

1. This Petition complies with the four-page limitation provided by the Board's March 26, 2025 Order Requesting Supplemental Briefing 37 C.F.R. § 42.5 and is limited to 4 pages; and

2. This Petition complies with the typeface and style requirements of 37 C.F.R. §§ 42.6(a)(2)(ii), 42.6(a)(2)(iii) and has been prepared in proportionally spaced, 14-point Times New Roman font using Microsoft Word Version 2308 (2024).

/Erik B. Milch/
Erik B. Milch (Reg. No. 42,887)