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 IPR2025-00013
U.S. Patent No. 11,770,313

PATENT OWNER'S SUPPLEMENTAL BRIEF ON RESCISSION OF *FINTIV* MEMORANDUM

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The Board requested supplemental briefing on what effect the February 28, 2025 rescission of the June 21, 2022 *Fintiv* Memo has on the parties' positions regarding the exercise of discretion to deny institution under 35 U.S.C. § 314(a). Paper 11. On March 24, 2025, Chief Judge Boalick issued additional Guidance on the USPTO's rescission of the *Fintiv* Memo ("March 24th Guidance"). The *Fintiv* analysis outcome remains unchanged: it strongly favors denying institution due to the advanced stage of the parallel district court proceeding, in which trial will begin in less than six months on September 22, 2025.

As explained in the POPR, *Fintiv* factors 2-6 either favor or strongly favor denying institution, and factor 1 is neutral. *See* POPR, 35-41. That analysis remains fully applicable. Notably, the scheduled trial date is more than seven months prior to the projected FWD deadline. POPR, 37. That has not changed. Indeed, the parallel district court litigation continues to move forward on schedule, as the Court conducted a Claim Construction Hearing on March 19, 2025, which the POPR noted was to occur on that date, and also issued a Claim Construction Order on March 31, 2025. *See* POPR, 38; *see also Adaptive Spectrum and Signal Alignment, Inc. v. Charter Communications, Inc. et al*, Case No. 2:24-cv-00124-JRG-RSP, Dkt. No. 105 (E.D. Tex.). Also on March 31, 2025, the Court **denied** Charter's motion to transfer the co-pending litigation to the District of Colorado, thereby rendering Petitioner's median time-to-trial calculation based on that venue

moot. *See* Pet., 6; *see also Adaptive Spectrum and Signal Alignment*, Dkt. No. 104.

Under the *Fintiv* Memo, a holistic weighing of the *Fintiv* factors strongly favored denial of institution. POPR, 35-41. As relevant here, the now rescinded *Fintiv* Memo included instructions related to the dispositive impact on the *Fintiv* analysis of a *Sotera* stipulation (factor 4) or of a determination of compelling merits (factor 6). As confirmed in the March 24th Guidance, under current Board precedent and Office policy, neither a *Sotera* stipulation nor a finding of compelling merits is dispositive in making the *Fintiv* assessment. March 24th Guidance, 2-3.

Here, however, these changes resulting from the rescission of the *Fintiv* Memo do not affect the result of the *Fintiv* analysis. Petitioner did not file a *Sotera* stipulation. POPR, 39-40. Even if Petitioner did file a *Sotera* stipulation, in view of the rescission of the June 21, 2022 *Fintiv* Memo, the *Fintiv* factors would still favor denial. In fact, any such "stipulation does not ensure that th[is] IPR proceeding[] would be a 'true alternative' to the district court proceeding." *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (P.T.A.B. Mar. 28, 2025) (on Director review; vacating panel's institution decision and denying under *Fintiv*). Here, as in *Motorola*, Petitioner's invalidity contentions include combinations of the asserted art with other system art, "which Petitioner's stipulation is not likely to moot." *Id.*, 4; EX2002, 32 (listing 8 different prior art

systems), 100-101 (identifying system art in combination with other references as allegedly rendering the ’313 patent obvious). Indeed, all of the references relied upon in the Petition’s Grounds are cited in Petitioner’s invalidity grounds in the parallel litigation. Petition, 3; EX2002, 31.

Nor has Petitioner made a showing of compelling merits. POPR, 16-34, 40-41. Indeed, under both the now rescinded *Fintiv* Memo and current Board precedent, a holistic weighing of the *Fintiv* factors strongly favors denying institution. As such, the Board should exercise its discretion to deny the Petition in view of the *Fintiv* factor analysis and most notably the significantly advanced parallel litigation.

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER'S SUPPLEMENTAL BRIEF ON RESCISSION OF *FINTIV* MEMORANDUM** was served in its entirety on April 2, 2025, upon the following party via electronic mail:

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