

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA OF AMERICA CORP., ERICSSON INC.,
AT&T SERVICES, INC.,
CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,
and T-MOBILE USA, INC.,
Petitioner,

v.

PEGASUS WIRELESS INNOVATION LLC
Patent Owner.

IPR2025-00036
Patent 11,627,631 B2

Before KRISTEN L. DROESCH, BARBARA A. PARVIS, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Nokia of America Corporation, Ericsson Inc., AT&T Services, Inc., Cellco Partnership d/b/a Verizon Wireless, and T-Mobile USA, Inc., (collectively “Petitioner”) filed a petition requesting *inter partes* review of claims 1–18 of U.S. Patent No. 11,627,631 B2 (Ex. 1001, “the ’631 Patent”). Paper 6 (“Petition” or “Pet.”). Petitioner filed a declaration of Dr. Michael Kotzin in support of the Petition. Ex. 1003. Exclusive Licensee Pegasus Wireless Innovation LLC (hereinafter “Patent Owner”) timely filed a preliminary response. Paper 10 (“Preliminary Response” or “Prelim. Resp.”). With our authorization, Petitioner filed a preliminary reply (Paper 12, “Preliminary Reply” or “Prelim. Reply”) and Patent Owner filed a preliminary sur-reply (Paper 13, “Preliminary Sur-reply” or “Prelim. Sur-reply”).

We have authority to determine whether to institute review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). An *inter partes* review may not be instituted unless it is determined that “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Institution of *inter partes* review, however, is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). For the reasons provided below, we exercise discretion to deny institution of *inter partes* review.

B. Real Parties-In-Interest

Petitioner states:

The real parties in interest are Cellco Partnership d/b/a Verizon Wireless, Verizon Business Network Services LLC, Verizon Corporate Services Group Inc., TracFone Wireless, Inc., AT&T Corp., AT&T Services, Inc., AT&T Mobility LLC, AT&T Mobility II LLC, New Cingular Wireless PCS, LLC, Cricket Wireless LLC, T-Mobile USA, Inc., Sprint Solutions LLC, Sprint Spectrum LLC, Ericsson Inc., Telefonaktiebolaget LM Ericsson, and Nokia of America Corporation.

Pet. 88. Patent Owner states that “[t]he real parties-in-interest for this proceeding include: Patent Owner^[1], Pegasus Wireless Innovation LLC.”
Paper 8.

C. Related Matters

The parties indicate that the ’631 Patent is the subject of:
Pegasus Wireless Innovation LLC. v. Verizon Communications Inc., No. 2:23-cv-00640 (E.D. Tex.) (“parallel district court proceeding”);
Pegasus Wireless Innovation LLC. v. AT&T Inc. et al., No. 2:23-cv-00638 (E.D. Tex.) (“AT&T Case”); and
Pegasus Wireless Innovation LLC. v. T-Mobile US, Inc. et al., No. 2:23-cv-00639 (E.D. Tex.) (“T-Mobile Case”).

See Pet. 89 (citing Ex. 1026); Paper 8, 1. Petitioner indicates the AT&T case and T-Mobile case have been consolidated into the parallel district court proceeding for all pre-trial issues. See Pet. 89 (citing Ex. 1026).

¹ Pegasus Wireless Innovation LLC is an exclusive licensee. Prelim. Resp. 1; see also Reel 065219, Frames 0144–180 (recorded exclusive license).

Patent Owner identifies the following petitions for *inter partes* review involving the patents that are at issue in the above-listed district court proceedings: IPR2025-00037, IPR2025-00083, IPR2025-00084, IPR2025-00137, IPR2025-00138, IPR2025-00290, IPR2025-00291, IPR2025-00292, IPR2025-00293, and IPR2025-00317. Paper 11, 1.

D. The '631 Patent (Ex. 1001)

The '631 Patent is directed to “technology for providing services using network slicing to mov[e] user equipment[] without interruption.” Ex. 1001, 1:20–24. The '631 Patent discloses t a base station includes “receiving network slice request information from a user equipment [(UE)] configured with the network slice[;] controlling the network slice request information to be transferred to a core network entity[;] and receiving specific network slice information that is configured based on the network slice request information from the core network entity.” *Id.* at 2:13–20.

E. Illustrative Claim

Claims 1, 7, and 13 are independent, and claims 2–6, 8–12, and 14–18 depend directly or indirectly therefrom. *See* Ex. 1001, 23:16–24:62.

Claim 1 is illustrative and reproduced, below:

A method for transmitting and receiving data, the method comprising:

deciding, by a source base station (BS), whether to perform a handover;

transmitting, from the source BS to a target BS, a handover request message when it is decided to perform the handover,

wherein the handover request message includes network slice information; and

receiving, by the source BS from the target BS, a handover request confirmation message in response to the handover request message,

wherein, if one or more protocol data unit (PDU) sessions are associated with one or more network slices that are not supported by the target BS, the handover request confirmation message includes information for indicating a rejection of the one or more PDU sessions by the target BS.

Ex. 1001, 23:16–33.

F. Asserted Challenges to Patentability and Asserted Prior Art

Petitioner challenges claims 1–18 based on the following grounds of unpatentability (Pet. 1–2):

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	1, 7, 13	103 ²	R3-173152 ³
2	2–6, 8–12, 14–18	103	R3-173152, TR 38.801 ⁴
3	1, 7, 13	103	Han, ⁵ TS 36.300 ⁶
4	2–6, 8–12, 14–18	103	Han, TS 36.300, TR 38.801

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103 effective March 16, 2013. Because the '631 Patent claims an effective filing date after the effective date of the applicable AIA amendment, we refer to the AIA version of § 103.

³ Xn Based Mobility Across RA (Ex. 1011, “R3-173152”).

⁴ 3GPP TR 38.801 V0.4.0 (2016-08) 3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Study on New Radio Access Technology; Radio Access Architecture and Interfaces (Release 14) (Ex. 1013, “TR 38.801”).

⁵ Certified English Translation of WIPO Pub. No 2018/059592 A1 (Exs. 1014, 1015, “Han”).

⁶ 3GPP TS 36.300 V.13.4.0 (2016-06) 3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Evolved Universal Terrestrial Radio Access (E-UTRA) and Evolved Universal Terrestrial Radio Access Network (E-UTRAN); Overall description; Stage 2 (Release 13) (Ex. 1024, “TS36.300”).

II. DISCRETION TO DENY INSTITUTION

Patent Owner contends the Board should exercise discretion to deny institution under 35 U.S.C. § 314, citing the six factors articulated in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). *See* Prelim. Resp. 34–35. Patent Owner asserts that the balance of the *Fintiv* factors warrant denial of institution. *See id.* at 35; Prelim. Sur-reply 5. Petitioner disagrees and presents a stipulation similar to the stipulation presented in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (“*Sotera*”). *See* Pet. 84–87; Prelim. Reply 5.

Under § 314(a), the Director has discretion to deny institution of an *inter partes* review. *See* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)).

The Board may, in the interest of fairness and the efficient use of Board resources, deny institution under § 314(a) where there are parallel district court proceedings involving the same or substantially the same parties and invalidity challenges. *Fintiv*, Paper 11 at 5–6, 12–13. In *NHK Spring Co. v. Intrix-Plex Technologies, Inc.*, the Board denied institution relying in part on § 314(a) because the parallel district court proceeding was scheduled to finish before the Board reached a final decision.

IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential). Following

NHK, the Board articulated the following factors for consideration when determining whether to exercise discretion to deny institution in view of a parallel proceeding:

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 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.

Fintiv at 5–6. “These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* at 6. In evaluating these factors, we take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* (citing Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019), 58)⁷.

On February 28, 2025, the USPTO rescinded the prior USPTO Director’s memorandum titled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (“Interim Procedure”). On March 24, 2025, the Chief Administrative Patent Judge issued a memorandum titled “Guidance on USPTO’s rescission of

⁷ Available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=Tri alPracticeGuideConsolidated>

‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’ (“Chief Judge Memo”).⁸ According to the Chief Judge Memo, the purpose of the recission was “to restore policy . . . to the guidance in place before the Interim Procedure, including the precedential decisions in [*Fintiv*] and [*Sotera*].” Chief Judge Memo 1. Subsequently, on March 26, 2025, the Acting Director of the USPTO issued a memorandum titled “Interim Processes for PTAB Workload Management” (“Acting Director Memo”).⁹ The new processes outlined in the Acting Director Memo do not apply to this proceeding because the deadline for the filing a preliminary response has already passed. *See* Acting Director Memo 3.

We address each of the *Fintiv* factors below.

A. First Factor: Whether the Court Granted a Stay

Patent Owner asserts that Petitioner has not moved for a stay of the parallel district court proceeding. *See* Prelim. Resp. 35–36. Petitioner speculates that the trial date could be extended based on requests for a protective order against non-jurisdictional discovery. *See* Pet. 84. Patent Owner asserts that since the Petition was filed the court has twice granted a protective order against non-jurisdictional discovery without suggesting that the trial date would be adjusted. *See* Prelim. Resp. 35 (citing Exs. 2001, 2002). Patent Owner further asserts that a stay is unlikely due to the

⁸ *Available at*

https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf

⁹ *Available at*

<https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>

significant case progress (discussed when addressing the third *Fintiv* factor), the scheduled jury trial preceding any final written decision (discussed when addressing the second *Fintiv* factor), and the timing of institution decisions on the ten other petitions filed against patents asserted in the same litigation (discussed when addressing the sixth *Fintiv* factor). *See id.* at 36. Patent Owner concludes that the considerations of the first *Fintiv* factor support denying institution or remain neutral. *See id.*

Because a stay has not be granted, and we have no basis to speculate that a stay may be granted in the future, we determine that the considerations of the first *Fintiv* factor are neutral.

B. Second Factor: Proximity of Trial Date

Patent Owner asserts that the second *Fintiv* factor weighs heavily in favor of discretionary denial because trial in the parallel district court proceeding is scheduled to begin September 8, 2025, nearly seven months before a final written decision would be expected on or about April 30, 2026. *See* Prelim. Resp. 46 (citing Ex. 1025, 2). Patent Owner further indicates that the September 2024 statistics for the median time-to-trial in the Eastern District of Texas show a period of 21.9 months which, according to Patent Owner are “consistent with the September 2025 trial date set out in Judge Gilstrap’s Docket Control Order.” *Id.* at 38 (citing Ex. 2003, 5); *see also* Chief Judge Memo at 3 (“[T]he Board may consider any evidence that the parties make of record that bears on the proximity of the district court’s trial date . . . including median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides.”). Patent Owner contends that the timeline of the trial date before the final written decision undisputedly favors denial of institution. *See* Prelim. Resp. 36–37 (citing *Fintiv*, Paper 11 at 9;

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Samsung Elecs. Co., Ltd. v. Mojo Mobility Inc., IPR2023-01092, Paper 11 at 11 (PTAB Jan 8, 2024); *Bentley Motors Ltd., Jaguar Land Rover Ltd.*, IPR2019-01539, Paper 9 at 14 (PTAB Mar. 10, 2020); *Immersion Sys. LLC v. Midas Green Techs., LLC*, PGR2021-00104, Paper 15 at 11 (PTAB Jan. 31, 2022); *see also NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18 at 8–9 (PTAB May 2, 2022); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 at 6–9 (PTAB May 15, 2019); *eClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022)).

Petitioner contends that the second *Fintiv* factor weighs against discretionary denial. *See* Pet. 85. Petitioner first asserts that the second *Fintiv* factor “should be considered at least neutral because jury selection is far in the future and is not set to begin until at least September 8, 2025,” and “would proceed with respect to only one of the three [district court proceedings].” Pet. 84; *see* Pet. Reply 5 (similar argument regarding three district court proceedings). Petitioner also asserts that “[e]ach of the defendant Petitioners are entitled to separate trials, which will necessarily proceed on separate dates. As such, there are explicit and inherent uncertainties with this case given the number of parties involved and the number of trials regarding this patent.” Pet. 84–85. Petitioner also asserts that the current trial date does not support denial because much can change in the time before trial. *See* Pet. 85 (citing *Dish Network v. Broadband iTV*, IPR2020-01280, Paper 17 at 16 (PTAB Feb. 4, 2021)). Petitioner further speculates that “it is likely that the district court proceedings will not be complete before the final written decision in this matter.” *Id.* Petitioner

further asserts that trial dates have not been set for two of the three district court cases. *See* Pet. Reply 5.

We are not swayed by Petitioner's speculation as to the trial date for the parallel district court proceeding as well as arguments regarding trial dates for the other two district court proceedings. Due to the actual trial date of the parallel district court proceeding having been set to occur more than seven months before an expected final written decision in this proceeding, as well as a projected trial date based on time-to-trial statistics of more than six months before an expected final written decision, we determine that the considerations of the second *Fintiv* factor weigh in favor of exercising discretion to deny institution of *inter partes* review.

C. Third Factor: Investment in the Parallel Proceeding

Patent Owner contends that the considerations of the third *Fintiv* factor favor denial of institution because the district court and the parties will have expended considerable resources in the parallel district court proceeding, including addressing the merits of Petitioner's invalidity contentions. *See* Prelim. Resp. 41. Patent Owner contends that by the time of the projected institution decision (April 30, 2025), fact discovery is to be completed on April 14, 2025, and Petitioner and Patent Owner will be required to serve their expert witness disclosures relating to the invalidity contentions by April 21, 2025. *See id.* at 43. Patent Owner asserts that by April 30, 2025, Petitioner and Patent Owner will have exchanged preliminary claim constructions, prepared a Joint Claim construction statement, completed claim construction discovery, and served claim construction briefing, and a claim construction hearing will have been held on March 11, 2025. *See id.* at 44. Patent Owner contends that the

investment in the parallel district court proceeding favors denial of institution. *See id.*

Patent Owner further asserts that Petitioner delayed filing this Petition until October 21, 2024, which was seven months after Petitioner was served infringement contentions on March 18, 2024, and five months after Petitioner served their invalidity contentions on May 17, 2024. *See* Prelim. Resp. 41. According to Patent Owner, “Petitioner[] provide[s] no justification for the delay in filing their Petition,” which the PTAB has found weighs in favor of denial of institution. *Id.* at 41–42 (citations omitted). More specifically, Patent Owner argues that Petitioner’s invalidity contentions include claim charts addressing the same references asserted in every ground of its Petition for every claim challenged, but provide no justification for delaying five months to file its Petition when it had already sufficiently developed invalidity theories in the district court pleadings. *See id.* at 42.

Petitioner contends that the district court will not invest significant resources related to the challenged patent prior to the issuance of the institution decision. *See* Pet. 86 (citing *Fintiv*, Paper 11 at 9–12; *Dish Network*, IPR2020-01280, Paper 17 at 18–21).

We agree with Patent Owner that significant investment in the parallel district court proceeding has already occurred. A claim construction hearing was held in the parallel district court proceeding on March 13, 2025. Also, the parties have exchanged invalidity contentions. We also agree with Patent Owner that Petitioner did not file the Petition expeditiously and did not explain the delay in filing the Petition.

Based on the substantial investment in the parallel district court proceeding by the parties and court, and the delayed timing of the Petition filing, we determine that the considerations of the third *Fintiv* factor weigh in favor of exercising discretion to deny institution of *inter partes* review.

D. Fourth Factor: Overlap Between the Issues Raised in the Petition and in the Parallel Proceeding

Patent Owner contends that the considerations of the fourth *Fintiv* factor weigh in favor of denying institution because there is substantial overlap between the claims, arguments, and evidence raised in the Petition and the invalidity contentions in the parallel district court proceeding. *See* Prelim. Resp. 45. According to Patent Owner, “Petitioner’s invalidity contentions challenge claims 1–18 of the ’631 patent based on R3-173152, Han 222^[10], TR 38.801, alone and in combination with other references.” *Id.* (citing Ex. 2004, 8–9, 26–27; Ex. 2005 (Appendix A); Ex. 2006 (Ex. A-1); Ex. 2007 (Ex. A-2); Ex. 2008 (Ex. A-3)). Patent Owner acknowledges that TS 36.300 is included in the invalidity contentions, but contends that TS 36.300 is merely relied upon in an alternative manner in the Petition including an assertion that Han discloses the same feature as TS 36.300. *See id.* (citing Pet. 52).

In the Preliminary Reply, Petitioner provides the following stipulation:

To mitigate any duplication concerns, if this IPR is instituted, Petitioners will not pursue in District Court litigation the specific grounds asserted in this proceeding, or any other

¹⁰ Han 222 refers to U.S. Patent 10,966,222 B2 (Ex. 2016), which is the U.S. counterpart to Han because it was filed as a continuation of PCT/CN2017/105046.

ground that was raised or could have been reasonably raised in an IPR (i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patents or printed publications).

Prelim. Reply 5 (citing *Sotera; BMW of No. Am., LLC. v. Northstar Sys. LLC*, IPR2023-01017, Paper 12 at 10 (PTAB Dec. 8, 2023)).

We note that Petitioner's patentability challenges based on R3-173152 are dependent upon Petitioner's argument that the '631 Patent is not entitled to an earlier November 3, 2016 filing date because there is insufficient written description support under 35 U.S.C. § 112(a) for independent claims 1, 7, and 13 in the earliest filed foreign application. *See* Pet. 5–11. Petitioner's invalidity contentions challenge written description support under 35 U.S.C. § 112(a) for independent claims 1, 7, and 13 in the '631 Patent. *See* Ex. 2004, 353. Accordingly, there is some overlap between the entitlement to the filing date of the earliest foreign application predicated on written description support for independent claims 1, 7, and 13 raised in the Petition and Petitioner's district court invalidity contentions challenging written description support for independent claims 1, 7, and 13.

As a result, we determine that Petitioner's stipulation mitigates to some degree the concerns of duplicative efforts and potentially conflicting decisions between the district court and the Board. *See Sotera*, Paper 12 at 18–19; *Sand Revolution II, LLC. v. Cont'l Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 12 (PTAB June 16, 2020) (informative)). Accordingly, we determine that the considerations of the fourth *Fintiv* factor weigh against exercising discretion to deny institution of *inter partes* review.

E. Fifth Factor: Whether the Petitioner and Defendant Are the Same Party

Patent Owner contends Petitioner is the defendant in the parallel district court proceeding and that this factor weighs in favor of discretionary denial. *See* Prelim. Resp. 48–49 (citing *Samsung Elec. Co. v. Clear Imaging Res., LLC*, IPR2020-01401, Paper 12 at 21–22 (PTAB Feb. 17, 2021)). Petitioner asserts that this factor is neutral. *See* Pet. 87 (citing *Sand Revolution*, Paper 24 at 12–13).

Given that Petitioner is the same as defendant in the parallel district court proceeding, we determine the considerations of the fifth *Fintiv* factor weigh in favor of exercising discretion to deny institution of *inter partes* review.

F. Sixth Factor: Other Circumstances, Including the Merits

Patent Owner asserts that the considerations of the sixth *Fintiv* factor weigh in favor of discretionary denial. More specifically, Patent Owner contends that the merits of this Petition are weak and the flaws in the Petition are numerous. *See* Prelim. Resp. 52 (citing Prelim. Resp. 9–33; *Fintiv*, Paper 11 at 13–14; *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 24 (PTAB Mar. 17, 2023)); *see also* Prelim. Sur-reply 5 (similar argument, citing Prelim. Resp.). Patent Owner contends that the Board has found that it does not need to decide whether the merits of the Petition are particularly strong because it would not impact the ultimate determination as to discretion to deny institution. *See id.* at 52–53 (citing *NXP*, PGR2022-00005, Paper 18 at 12–13; *Samsung v. Clear Imaging*, IPR2020-01404, Paper 12 at 23–25; *Apcon, Inc. v. Gigamon Inc.*, IPR2020-01579, Paper 9 at 26 (PTAB Mar. 16, 2021); *Fintiv*, Paper 11 at 15).

Petitioner asserts that this factor weighs strongly against discretionary denial because the merits of the Petition are strong and none of the grounds of unpatentability asserted in the Petitioner were previously considered. *See* Pet. 87 (citing *Comcast Cable Commn's, LLC v. Rovi Guides, Inc.*, IPR2019-00231, Paper 14 at 11 (PTAB May 20, 2019)).

We have reviewed the Petition, Preliminary Response, and Preliminary Reply and determine that the merits are strong for at least the patentability challenges based on R3-173152, assuming R3-173152 qualifies as prior art. However, as explained above in addressing the fourth *Fintiv* factor, we note that the strength of these R3-173152-based patentability challenges is dependent upon whether the '631 Patent is entitled to an earlier November 3, 2016 filing date, which overlaps with Petitioner's district court invalidity contentions under 35 U.S.C. § 112(a). *See* Pet. 5–11; Ex. 2004, 353; Prelim. Resp. 9–26; Prelim. Reply 1–4. The merits of the patentability challenges based on Han and TS 36.300 present a closer call on the merits because Patent Owner identifies potential weaknesses in Petitioner's asserted reasons a person of ordinary skill in the art would have modified the teachings of Han in view of TS 36.300 to include software that decides to perform handover prior to sending the handover request message.

Patent Owner further asserts that the dispute between the parties involves three complaints involving 11 patents filed in the district court on a single day, but Petitioner filed their IPR challenges “in a piecemeal fashion and on a slow-rolling basis” “over the period from October 18 to December 31, 2024.” Prelim. Resp. 49; *see id.* at 49–50. Patent Owner posits:

As the Board will approach the decisions serially, the strength of the *Fintiv* factors in favor of the Board exercising its discretion to deny institution will only become stronger. In particular, at least the first and third *Fintiv* factors will weigh more heavily in favor of denial as the estimated final written decision deadline for each IPR extends farther and farther beyond the anticipated trial date of September 8, 2025.

Id. at 50. Patent Owner further contends that “the complexity of this global dispute between Petitioner[] and Patent Owner encourages resolution in a single forum, without the risk of inconsistent results.” *Id.* Patent Owner asserts that the district court can resolve more disputed issues than the limited nature of IPR proceedings, for example, the indefiniteness issue Petitioner alluded to in the Petition and the 35 U.S.C. § 112(a) and (b) issues referenced in Petitioner’s invalidity contentions. *See id.* at 51 (citing Pet. 11; Ex. 2004, 353, 359–60).

Patent Owner further contends that “considering the earlier trial date, Petitioners’ attempt to peel off a small subset of the case’s invalidity issues for this IPR would be an inefficient use of resources.” Prelim. Sur-reply 5. According to Patent Owner, in this case “a broad, multi-patent suit can be fully resolved many months before the Board issues its final written decision” and “[t]he district court would consider the issues raised in this IPR, and also all other validity and infringement issues involving the challenged patent.” *Id.* Patent Owner asserts that Petition has not explained any efficiencies that would arise from instituting *inter partes* review.

We determine that the strength of the merits of Petitioner’s patentability challenges based on R3-173152, assuming R3-173152 qualifies as prior art, weighs against exercising discretion to deny institution of *inter partes* review. However, we determine that resolution of all of the disputes

based on all of the issues between the parties regarding the challenged patent before the district court, which likely would occur many months before a subset of the issues could be resolved before the Board, would be more efficient and, therefore, weighs in favor of exercising discretion to deny institution of *inter partes* review. In sum, we determine that the strength of the merits is obviated by the efficiency and timeliness of the parallel district court proceeding and, therefore, determine that considerations of the sixth *Fintiv* factor are neutral.

G. Conclusion

We have considered the evidence before us in view of the *Fintiv* factors. Because the analysis is fact-driven and we take a holistic view of the factors, no single factor is determinative of whether we exercise discretion to deny institution under § 314(a). The parallel district court trial date set more than six months before an expected final written decision and the significant investment by the court and parties in the parallel district court proceeding weigh in favor of exercising discretion to deny institution of *inter partes* review. Petitioner's stipulation, however, allays to some extent concerns regarding duplication of efforts and the possibility of conflicting decisions and weighs against exercising discretion to deny institution of *inter partes* review. Of the remaining factors, we find only that Petitioner and defendant being the same to weigh in favor exercising discretion to deny institution of *inter partes* review. After careful consideration and holistically balancing all of the considerations of the *Fintiv* factors, on this record, we determine that the evidence before us warrants exercising discretion to deny institution of *inter partes* review.

III. CONCLUSION

We exercise discretion under 35 U.S.C. § 314(a) to deny institution of *inter partes* review.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied*, and no trial is instituted.

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