

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.,
Petitioners,

v.

PEGASUS WIRELESS INNOVATION LLC,
Patent Owner.

Case IPR2025-00037
Patent 10,616,932

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Memorandum Opinion and Order in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex Dec. 11, 2024)
2002	Memorandum Opinion and Order in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex Dec. 23, 2024)
2003	Comparison of Districts Within the Fifth Circuit — 12-Month Period Ending September 30, 2024 (available at https://www.uscourts.gov/sites/default/files/2024-12/fcms_na_distcomparison0930.2024.pdf)
2004	Defendants' Preliminary Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex May 17, 2024)
2005	Reserved
2006	Reserved
2007	Reserved
2008	Reserved
2009	Appendix C to Defendants' Preliminary Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex May 17, 2024)
2010	Ex. C-1 of Appendix C to Defendants' Preliminary Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex May 17, 2024)
2011	Ex. C-3 of Appendix C to Defendants' Preliminary Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex May 17, 2024)
2012	Ex. C-2 of Appendix C to Defendants' Preliminary Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon</i>

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Exhibit No.	Description
	<i>Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex May 17, 2024)
2013	U.S. Patent 10,257,881 (Lin1 Counterpart)
2014	U.S. Patent 10,728,876 (Lin2 Counterpart)
2015	U.S. Patent 9,807,752 (Zhang Counterpart)
2016	Reserved
2017	Reserved

Pursuant to 37 C.F.R. § 42.107, Exclusive Licensee Pegasus Wireless Innovation LLC (“Pegasus” or “Patent Owner”) files this preliminary response, setting forth reasons why the Petition for *inter partes* review (“IPR”) of claims 1-2, 4, 8-9, and 11 of U.S. Patent No. 10,616,932 (the “’932 patent”), as requested by Nokia of America Corp., Ericsson Inc., AT&T Services, Inc., Cellco Partnership d/b/a Verizon Wireless, and T-Mobile USA, Inc. (“Petitioners”), should be denied.¹

I. INTRODUCTION

The ’932 patent discloses signaling protocols for radio resource control (RRC) in a mobile communications network. The protocols provide that after an access unit receives an uplink RRC message from a terminal, *e.g.* a cell phone, the access unit sends a first message with the uplink RRC message to a central unit. In response, the access unit receives a second message including a downlink RRC message.

Central to the invention claimed in the challenged independent claims of the ’932 patent, the disclosed protocols provide that “the access unit and the central unit distinguish signaling radio bearers based on radio bearer identification information included in the first message and the second message.” These features

¹ By submitting this Preliminary Response, no waiver of any argument is intended by Patent Owner. Patent Owner will have a right to file a complete response to the Petition, should the Board institute *inter partes* review. 37 C.F.R. § 42.120(a).

appear in independent claims 1 and 8, challenged in this Petition.

In each of the three Grounds presented in the Petition, Petitioners present a theory based on distinguishing “types” of signaling radio bearers, rather than showing that any of the references provide information to identify and distinguish the signaling radio bearers. In so doing, Petitioners try—but fail—to present a false equivalency between the references and the specification of ’932 patent. Contrary to Petitioners’ arguments, the ’932 patent does not distinguish signaling radio bearers based on “types” of signaling radio bearers, and instead discloses radio bearer identification information that can distinguish between signaling radio bearers, even between signaling radio bearers of the same type, such as a transport layer address, tunnel identification information, a Cell Radio Network Temporary Identifier (C-RNTI), a bearer ID (e.g. an E-UTRAN Radio Access Bearer Identifier (E-RAB ID)), or a logic channel identifier. Petitioners’ citations to the ’932 patent and discussion thereof fail to acknowledge or even address this technical aspect of the ’932 patent’s specification and challenged claims. Moreover, the asserted art fails to disclose or otherwise render obvious these claimed aspects of the challenged claims.

Accordingly, each of Petitioners’ Ground fails on the merits.

Notwithstanding the substantive defects of the Petition, the Board should exercise its discretion to deny the Petition based on discretionary grounds. A

proper balancing of the *Fintiv* factors weighs strongly in favor of denying institution. Patent Owner filed three parallel cases in the Eastern District of Texas involving the parties, in which it asserted not only the '932 patent but also ten other patents. Those cases were combined for pretrial proceedings and are rapidly moving towards trial, with a jury selection date approximately four months after the Board is expected to reach a decision on institution in this IPR, and eight months before a final written decision is expected to issue. As will be discussed, considerable effort will be undertaken in district court, both before the Board issues its institution decision in this IPR and before any final written decision would issue. Moreover, due to Petitioners' piecemeal filings of ten other IPRs against the ten other patents, many of the other IPRs do not even have expected dates for decisions on institution. Under a proper balancing of the *Fintiv* factors, the Board is requested to exercise its discretion and deny the Petition.

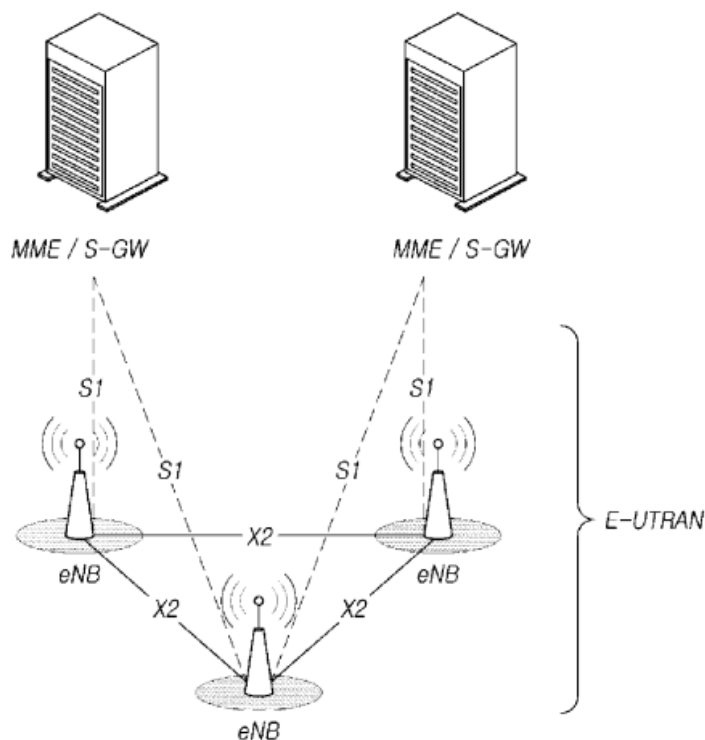
For each of these reasons, no IPR should be instituted.

II. THE '932 PATENT

The '932 patent is entitled, "Method for Configuring Wireless Connection of Terminal and Apparatus therefor," and discloses, more particularly, a signaling method and apparatus for radio resource control (RRC) in a mobile communications network. '932 Pat., 1:17-22.

A. Background of an Evolved UMTS Terrestrial Radio Access Network (E-UTRAN)

As depicted in Fig. 1 (reproduced below), in a 3GPP mobile communications network, “an evolved UMTS terrestrial radio access network (E-UTRAN) includes base stations (e.g., eNBs) providing an E-UTRA user plane (PDCP/RLC/MAC/PHY) and a control plane (RRC) protocol termination to user equipments (e.g., terminals).” ’932 Pat., 5:63-6:4. The eNBs can be “connected to each other via an X2 interface.” *Id.* The eNBs can be “connected to an evolved packet core (EPC) via an S1 interface.” *Id.* As illustrated, multiple eNBs can be connected to a common EPC (indicated as Mobility Management Entity / Serving Gateway (MME / S-GW)) via S1 interfaces.

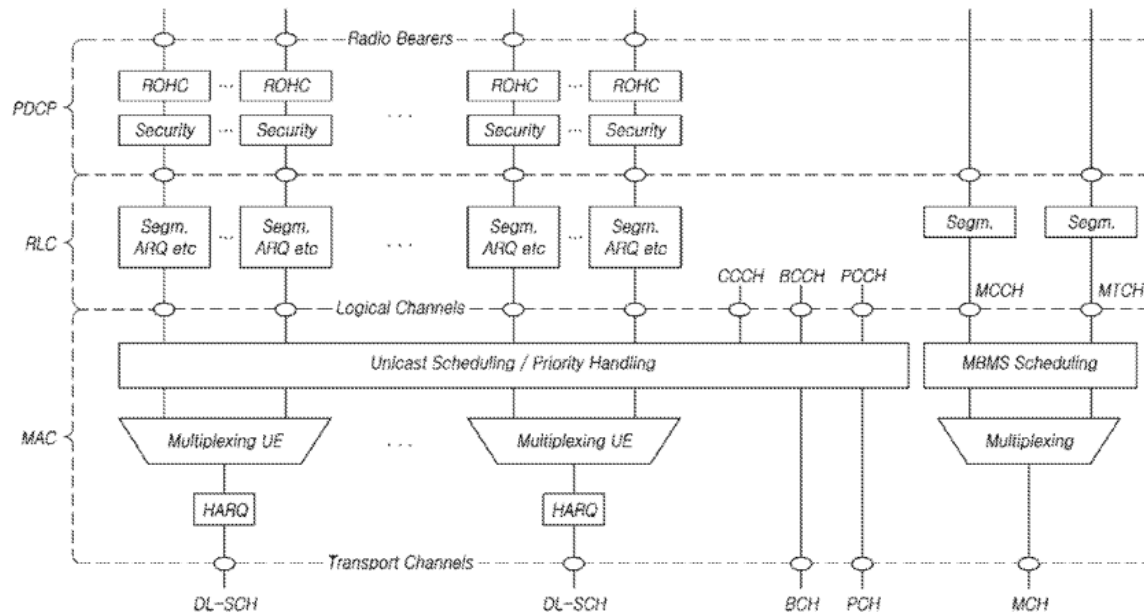


The '932 patent describes that a centralized cloud RAN network structure may reduce investment and operating costs of a radio network. *Id.*, 5:50-52. In a cloud RAN network structure, an eNB can be “divided into a digital unit (DU) performing data processing of the eNB and an RF unit (RU) transmitting and receiving wireless signals.” *Id.*, 5:52-55. With such separation, the DU may be disposed in a central location (a “concentrated section”) and the RU may be disposed in a service area located remotely from the central location (a “remotely-located service area”). '932 Pat., 5:55-63.

B. The '932 Patent Distinguishes Signaling Radio Bearers from Each Other to Provide a Dual Connectivity Network Structure

The '932 patent provides signaling protocols for a cloud RAN network structure. In the disclosed protocols, user equipment can have multiple radio bearers and can simultaneously connect with different radio access units (AU), which may or may not be connected to a common central unit (CU) according to various embodiments of the '932 patent, to provide the user equipment with dual connectivity.

Radio bearers are illustrated in Fig. 3 of the '932 patent (reproduced below).

FIG.3

In the Layer 2 structure for a downlink (DL) of E-UTRAN illustrated in Fig. 3, the layer is divided into a media access control (MAC) layer, a radio link control (RLC) layer, and a packet data convergence protocol (PDCP) sub-layer. '932 Pat., 6:14-17.

E-UTRAN supports multiple signal radio bearers for each UE, as shown at the top of Fig. 3. '932 Pat., 6:18-23. Respective radio bearers (e.g., wireless bearers) of the UE are associated with logic channels, such as a downlink control channel (DCCH) or a dedicated traffic channel (DTCH), of the MAC layer via a PDCP entity and an RLC entity associated thereto. *Id.* A transfer service is provided between the UE and the eNB via a logic channel associated with Layer 2 entities (e.g. the PDCP entity and the RLC entity), associated with specific traffic

flows having the same characteristics. '932 Pat., 6:18-28.

Separately illustrated in the '932 patent, E-UTRAN can classify a signaling radio bearer as a "type" of signaling radio bearer and provides RRC messages for each type of signaling radio bearer. *See* '932 Pat., Fig. 16 ("LTE SRB Type") (reproduced below); *id.*, 21:60-61 ("FIG. 16 illustrates SRB types and RRC messages of E-UTRAN"); *see also id.*, 12:44-45.

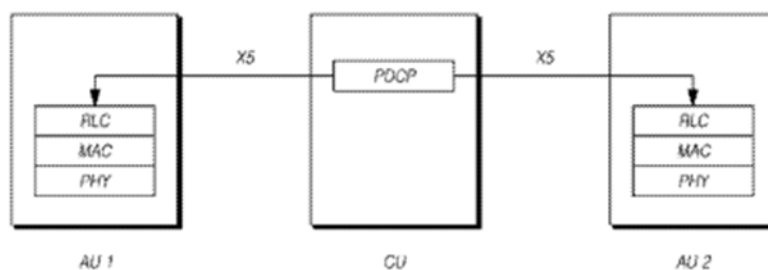
FIG. 16

LTE SRB Type	Direction	RRC message	RLC Mode
LTE SRB0 (DCCH)	Downlink	RRC Connection Setup RRC Connection Reject RRC Connection Re-establishment RRC Connection Re-establishment reject	Transparent
	Uplink	RRC Connection Request RRC Connection Re-establishment Request	
LTE SRB1 (DCCH)	Downlink	RRC Connection Reconfiguration RRC Connection Release Security Mode Command UE Capability Enquiry DL information transfer(if no SRB-2) Mobility from EUTRA Command Handover from EUTRA preparation request CS Fallback parameter response CDMA2000 Counter Check	AM
	Uplink	RRC Connection Setup Complete Security Mode Complete Security Mode Failure RRC Connection Reconfiguration Complete RRC Connection Re-establishment Complete Measurement report UE Capability information UL information Transfer(if no SRB2) UL handover preparation transfer CS fallback parameters request CDMA2000 Counter Check response	
LTE SRB2 (DCCH)	Downlink	DL Information Transfer	
	Uplink	DL Information Transfer	

User equipment can have dual connectivity, i.e., be connected to two base stations at the same time. In the '932 patent, various dual connectivity radio structures are described.

For example, Fig. 5 (reproduced below) illustrates a dual connectivity structure based on an assumption that a base station (eNB) is divided into a CU node and an AU node ('932 patent, 9:14-27):

FIG. 5



In Fig. 5, a specific instance of user equipment (UE) may be provided with a dual connectivity structure using radio resources provided via two radio access units (AUs). '932 patent, 9:20-23. For example, an access unit for providing an initial RRC connection may be defined as AU 1 and another access unit (AU 2) can provide additional radio resources to the same UE. '932 patent, 9:23-27. To add radio resources, signaling can occur on the CU-AU interfaces. A specific radio bearer may be provided to a specific UE via the CU and an access unit (AU). *See, e.g., '932 patent, 10:14-18.*

Relevant to the Petitioners' challenges, as a specific instance of user equipment can simultaneously connect to different access units (AUs), the '932 patent discloses an embodiment distinguishing signaling radio bearers in a connection procedure for a radio access network separation structure. *See generally* '932 Pat., 14:1-19:2; Fig. 12. In the procedure, signal radio bearers can be distinguished by using radio bearer identification information so that the same type of signal radio bearer (*e.g.*, SRB0) can be sent to different access units for the single instance of user equipment.

Fig. 12 (reproduced below) relates to a method of generating, by a CU 1202, a final RRC message and transmitting and receiving, by the CU 1202, an RRC message via an AU 1201. '932 Pat., 14:5-9.

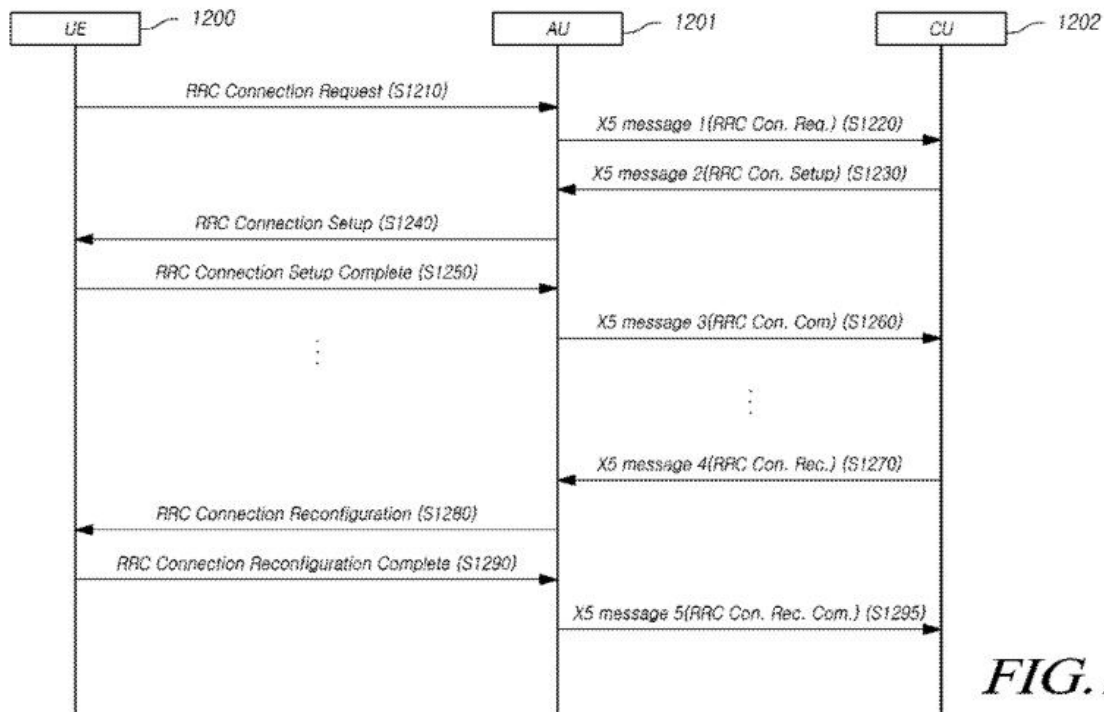


FIG. 12

Referring to FIG. 12, the UE 1200 starts an RRC connection setup procedure by transmitting an RRC connection request message to the AU 1201 in S1210. When the RRC connection request message is received by the AU 1201, the AU 1201 may transmit the received RRC connection request message to the CU 1202 in **S1220**. For example, when the RRC connection request message is received, the AU 1201 may transmit the RRC connection request message to the CU 1202 via a message on an interface between the AU 1201 and the CU 1202 (e.g. X5 message 1 in Fig. 12). '932 Pat., 14:17-22.

In **S1230** of Fig. 12, the CU 1202 transmits an RRC connection setup message including radio bearer configuration information (e.g. radioResourceConfigDedicated regarding SRB1 configured by the UE and/or entity configuration information regarding entities configured by the AU 1201 with regard to SRB1) to the AU 1201. '932 Pat., 14:36-14:52.

Identification information to distinguish signaling radio bearers can be included in message **S1220** from the AU to the CU (the RRC connection request message, e.g.) and in message **S1230** from the CU to AU (the RRC connection setup message, e.g.). '932 Pat., 14:53-15:3; 17:57-67.

This identification information to distinguish signaling radio bearers in the '932 patent does not merely distinguish between *types* of signaling radio bearers but rather it distinguishes between the signaling radio bearers. The '932 patent

explains that a message “may include a transport layer address or a GPRS tunneling protocol-tunnel endpoint identifier (GTP-TEID) in order to *distinguish* the above-described radio bearer configuration information (e.g. radioResourceConfigDedicated regarding **SRB1** configured by the UE and/or entity configuration information regarding entities configured by the AU 1201 with regard to **SRB1**).” ’932 Pat., 14:52-14:60 (emphasis added). Here, the signal bearers are of the same type—they are both SRB1. As a result, the identification information to distinguish signaling radio bearers, provided in messages consistent with ’932 patent, distinguishes between signaling radio bearers even when they are of the same type.

Other ways of providing information to distinguish signal bearers disclosed in the ’932 patent include a transport layer address, tunnel identification information, a C-RNTI, a bearer ID (e.g. an E-RAB ID), logic channel identifier, and tunnel identification information, “which allow transmission and reception to be separately performed according to the radio bearers.” ’932 Pat., 14:61-15:3.

Similarly, the ’932 patent states “the message including the RRC connection setup complete message ... may include at least one information among a transport layer address, tunnel identification information, a C-RNTI, a bearer ID (e.g. an E-RAB ID), and a logic channel identifier, which allow transmission and reception to be separately performed according to the radio bearers, *in order to distinguish the*

radio bearer ... of the corresponding UE.” ’932 Pat., 15:43-51 (emphasis added).

Also, the ’932 patent states, “the message, carrying the RRC connection reconfiguration message between the CU 1202 and AU 1201, may include at least one information among a radio bearer-specific transport layer address, a GTP-TEID (in an example, a transport layer address and a radio bearer-specific GTP-TEID, or in another example, a radio bearer-specific transport layer address and a radio bearer-specific GTP-TEID), a C-RNTI, a bearer ID (e.g. an E-RAB ID), and a logic channel identifier, *based on which the corresponding radio bearer is distinguished.*” ’932 Pat., 16:16-25 (emphasis added); *see also id.*, 16:32-55.

Consistent with the ’932 patent’s disclosure, independent claim 1 recites:

1. A method of configuring, by an access unit, a wireless connection of a terminal, the method comprising:
receiving an uplink radio resource control (RRC) message from a terminal, including the uplink RRC message into a first message, and transmitting the first message to a central unit;
receiving a second message from the central unit, where the second message includes a downlink RRC message in response to the uplink RRC message from the terminal; and
transmitting the downlink RRC message to the terminal,
wherein the access unit and the central unit distinguish signaling radio bearers based on radio bearer identification information included in the first message and the second message.

'932 patent, Claim 1 (emphasis added).

Claim 8 recites:

8. An access unit for configuring a wireless connection of a terminal, comprising:
a transmitter configured to transmit a first message to a central unit, where the first message includes an uplink RRC message received from a terminal; and
a receiver configured to receive a second message from the central unit, where the second message includes a downlink RRC message in response to the uplink RRC message from the terminal,
wherein the transmitter transmits the downlink RRC message to the terminal, and
wherein the access unit and the central unit distinguish signaling radio bearers based on radio bearer identification information included in the first message and the second message.

'932 patent, Claim 8 (emphasis added).

III. THE BOARD NEED NOT REACH ANY CLAIM CONSTRUCTION ISSUES TO DENY THE PETITION

Petitioners identify no terms as requiring construction and contends the “terms should receive their respective plain and ordinary meaning as understood by a person of ordinary skill in the art (POSITA) under *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005)”. Pet., 5. Without waiving its right to submit constructions in a Patent Owner Response, Patent Owner submits that the

Board need not engage in any pre-institution claim construction. For the substantive reasons presented in Section IV below, Petitioners' grounds include fundamental flaws and fail to establish the disclosure of every claimed element in each independent claim. These findings do not require the Board to conduct any construction of the above-identified terms.

IV. PETITIONERS' CHALLENGES FAIL ON THE MERITS

Petitioners assert three grounds in their Petition, and each Ground applies to all challenged claims (claims 1-2, 4, 8-9, and 11), including independent claims 1 and 8. Ground 1 contends the claims, are obvious over Lin1², Ground 2 contends the claims are obvious in view of Lin1 in view of Lin2³, and Ground 3 contends the claims are obvious over Lin1 in view of Zhang⁴.

Neither the primary reference, Lin1, nor the secondary references Lin2 and Zhang provide what the Examiner of the '932 patent found missing from the prior art studied during examination. The Statement of Reasons for Allowance of the '932 patent noted that "the access unit and the central unit distinguish signaling

² Ex. 1003, English Translation of Int'l Pat. Appl. No.: PCT/CN2014/089300 and Certificate of Translation ("Lin1").

³ Ex. 1005, English Translation of Int'l Pat. Appl. No.: PCT/CN2014/089310 and Certificate of Translation ("Lin2").

⁴ Ex. 10067, English Translation of Int'l Pat. Pub. No. WO 2014/127525 A1 and Certificate of Translation ("Zhang").

radio bearers based on radio bearer identification information included in the first message and the second message” (Ex. 1002 at 470):

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance: the claimed invention requires a combination of distinct features, which are not found in the prior art, either singularly or in combination. The independent claims identify the following uniquely distinct features:

Independent claim 1 requires “wherein the access unit and the central unit distinguish signaling radio bearers based on radio bearer identification information-included in the first message and the second message.”

Independent claim 9 requires “wherein the access unit and the central unit distinguish signaling radio bearers based on radio bearer identification information included in the first message and the second message.”

The closest prior art references found, either singularly or in combination, fail to anticipate or render the above limitations obvious.

These recitations of the independent claims are set forth in the elements Petitioners have labelled “1.C” and “8.B2.” *See* Pet., Claim Appendix (following page 93).

In each of Petitioners' three Grounds, Petitioners attempt to establish that the references disclose “wherein the access unit and the central unit distinguish signaling radio bearers based on radio bearer identification information included in the first message [from an access unit to a central unit] and the second message [from a central unit to an access unit],” as claimed. But Petitioners rely on

information that identifies a “type” of signal bearer rather than the signaling radio bearer itself. Thus, each of Petitioners' Grounds fails.

For the reasons discussed below, the Petition should be denied without institution because Petitioners have not .

A. Lin1 Does Not “Distinguish Signaling Radio Bearers Based on Radio Bearer Identification Information Included in the First Message [From an Access Unit to a Central Unit] and the Second Message [From a Central Unit to an Access Unit]”

As noted above, element [1.C] of claim 1 of the '932 patent recites, in relevant part, “wherein the access unit and the central unit distinguish signaling radio bearers based on radio bearer identification information included in the first message and the second message.” Claim 1 further recites that the “first message” is received by the access unit “from a terminal,” and the “second message” is received by the access unit “from the central unit.” The Petition attempts to address these aspects of claim 1 with respect to Lin1 at pp. 25-28 and 30-35.

In each of these sections, however, Petitioners do not point to “radio bearer identification information” in Lin1 that is used to “distinguish signaling radio bearers.” Instead, each portion seeks to rely on “indication information” in Lin1 that “identifies *a type* of signaling radio bearer (SRB)” (emphasis added), rather than the signaling radio bearer itself. For example, the Petition states at 26:

With respect to distinguishing the signaling radio bearers,
the POSITA would have understood that *distinguishing*

signaling radio bearers includes either (i) identifying a type of signaling radio bearer (SRB) or (ii) processing a message based on the identified SRB type.

Pet., 26 (underlining added, italics in original) (citing Kotzin, ¶142). Petitioners’ expert, Dr. Kotzin, similarly states “a person of ordinary skill in the art would have understood that identifying an SRB type of an **RRC message** (i.e., uplink or downlink RRC message) would distinguish the signaling radio bearer of the **RRC message** (i.e., uplink or downlink RRC message) *from other types of signaling radio bearers (SRBs).*” Kotzin, ¶142 (emphasis in original).

Petitioners fail to explain how identifying a type of signaling radio bearer “distinguishes” signaling radio bearers. Plainly, knowing that a signaling radio bearer is of a specific type does not distinguish signaling radio bearers *of the same type*. And that is what claim 1 requires. It does not call for distinguishing “types” of signaling radio bearers, but rather calls for distinguishing signaling radio bearers.

Petitioners appear to reach their erroneous conclusion concerning “types” of signaling radio bearers using the following logic: Petitioners posit that because the ’932 patent discusses types of signaling radio bearers, identifying the type of signaling radio bearer necessarily distinguishes signaling radio bearers. Pet., 26-28. But careful examination of Petitioners’ citations for their argument reveals their error. Petitioners contend that the ’932 patent “gives several examples

including: (i) ‘bearer identification information of the signaling radio bearer (i.e. *SRB1*)’, Ex. 1003, 15:58-61, (ii) ‘bearer identification information of the signaling radio bearer (DRB or *SRB2*)’, Ex. 1003, 17:46-50, and (iii) ‘bearer identification information (e.g. UP *SRB1* tunnel identification information (TEID))’, Ex. 1003, 17:57-67, that all refer to one of three SRB types (SRB0, SRB1, and SRB2).” Pet., 27. But ***only their third example*** provides information that can “distinguish” signaling radio bearers, and it is the only example that does more than just identify a “type” of signaling radio bearer.

For the first two “examples,” Petitioners try to make their quotations of 15:58-61 and 17:46-50 act as a definition of “bearer identification information,” but, in context, that is not what those portions of the ’932 patent say.

The first cited portion, at 15:58-61, discloses, “The CU 1202 may separately receive the RRC connection setup complete message based on the TEID, tunnel identification information, UE identification information, or bearer identification information of the signaling radio bearer (i.e. *SRB1*).” In this passage, the parenthetical “i.e. *SRB1*” does not define “bearer identification information” because the parenthetical is in the wrong spot—it is not placed after “bearer identification information.” Instead, it is placed after “signaling radio bearer” to identify a type of signaling radio bearer. And the ’932 patent’s actual example for

“bearer identification information” comes earlier in the same paragraph. There, the '932 patent states (15:43-51) (emphasis added):

For another example, the message including the RRC connection setup complete message, on the interface between the CU 1202 and the AU 1201, may include at least one information among a transport layer address, tunnel identification information, a C-RNTI, *a bearer ID (e.g. an E-RAB ID)*, and a logic channel identifier, which allow transmission and reception to be separately performed according to the radio bearers, *in order to distinguish the radio bearer* (e.g. above-described signaling [bearer]) of the corresponding UE.

Thus, the '932 patent does provide an explicit example of “bearer ID” to “distinguish” the radio bearer in the paragraph found at 15:38-62, but it is not where Petitioners try to find it. Rather, the '932 patent places the parenthetical example of bearer identification information (“an E-RAB ID”) after the phrase “bearer ID.” So, when the '932 patent later provides in the same paragraph “bearer identification information,” there is no need to provide another parenthetical example for “bearer identification information,” and that is clearly not what was intended to be achieved by the “SRB1” parenthetical.

Similarly, for Petitioner's citation of 17:46-50 (“bearer identification information of the radio bearer (DRB or SRB2)”), that parenthetical similarly follows “radio bearer,” not “bearer identification information.” Once again, earlier

in column 17, the '932 patent again provides an explicit example of "bearer ID."

There, the '932 patent states:

Alternatively, *to distinguish the radio bearer (e.g. DRB or SRB2, as described above)* of the corresponding UE, the message including the RRC connection reconfiguration complete message, on the interface between the CU 1202 and the AU 1201, may include at least one information among a transport layer address, tunnel identification information, a C-RNTI, *a bearer ID (e.g. an E-RAB ID)*, and a logic channel identifier, which allow transmission and reception to be separately performed according to the radio bearers."

'932 Pat., 17:26-38.

Petitioners' final "example" effectively confirms Petitioners' error. In the passage at 17:57-67, the '932 patent states, "Alternatively, the SRB0 RRC message may be transferred on an X5 message, by including a static or dynamic tunneling configuration. For example, in the process in which the AU 1201 transfers the RRC connection setup message to the CU 1202, on the X5 interface between the AU 1201 and the CU 1202, UE identification information or *bearer identification information* (e.g. UP SRB1 tunnel identification information (TEID)) may be transferred." '932 Pat., 17:57-67 (emphasis added). In that passage, the "bearer identification information" is a tunnel ID ("UP SRB1 tunnel identification information (TEID)"), not merely a type of signaling radio bearer. The use of a

tunnel identifier for a particular signaling radio bearer in this portion of the '932 patent is consistent with other portions of the '932 patent for distinguishing signaling radio bearers. *See, e.g.*, '932 Pat., 17:25-29 (“The message including the RRC connection reconfiguration complete message, on the interface between the CU 1202 and the AU 1201, may include a transport layer address or a GTP-TEID to distinguish the radio bearer (e.g. DRB or SRB2, as described above) of the corresponding UE.”).

Ultimately, despite Petitioners' best efforts to establish otherwise, nowhere in the '932 patent is there any indication that knowing whether a signaling radio bearer is of a particular type (SRB0, SRB1, or SRB2) distinguishes the signaling radio bearer. When the '932 patent discloses and claims distinguishing signaling radio bearers, it does not merely identify a “type” of signaling radio bearer.

Petitioners' Ground 1, and Grounds 2 and 3, each rely on Petitioners' erroneous theories concerning “types” of signaling radio bearers. Specifically, the Petition at pp. 30-35 for Ground 1 concerning claim 1, relies exclusively on information that identifies “a type of SRB.” Nowhere do Petitioners explain how identifying a type of signal radio bearer distinguishes signal radio bearer, especially given that signal radio bearers can be of the same type can be sent on the interfaces between access units and a central unit, such as in the dual connectivity embodiment of Fig. 5 of the '932 patent.

Petitioners' erroneous analysis of claim 8 incorporates its flawed analysis of claim 1 (*see* Pet., 40-41), and fails for similar reasons.

Accordingly, the Petition fails to establish a reasonable likelihood that the petitioner would prevail with respect to Ground 1.

B. Petitioners' "Types" Theory Fails for Grounds 2 and 3 As Well

With regard to Ground 2, Petitioners rely on Lin2 and argue for element [1.C], "To the extent it is argued that Lin1 does not disclose the access unit and the central unit 'distinguish' signaling radio bearers based on the radio bearer identification information-included in the first message and the second message, Lin2 suggests another way in which the access unit and the central unit distinguish signaling radio bearers based on the radio bearer identification information-included in the first message and the second message." Pet., 58-59. But rather than point to anything that distinguishes signal radio bearers, Petitioners again rely on their theory concerning "types" of signaling radio bearers. Pet., 59 ("a POSITA would have understood that Lin2's serving node (access unit) and anchor node (central unit) distinguish *the SRB type of the RRC message* based on the radio bearer identification information included in the first message and the second message.") (emphasis added, original emphasis omitted). Again, Petitioners' erroneous analysis of claim 8 incorporates its flawed analysis of claim 1 (*see* Pet., 62), and fails for similar reasons.

Accordingly, the Petition fails to establish a reasonable likelihood that the petitioner would prevail with respect to Ground 2.

Similarly with regard to Ground 3, Petitioners rely on Zhang and argue for element [1.C], “To the extent it is argued that Lin1 does not disclose radio bearer identification information included in the first message and a second message, Zhang discloses that the control information transmitted between network nodes ‘includes an identifier of a radio bearer (RB), and *values of the identifier of the radio bearer (RB) are ‘SRB 1’ and ‘DRB 2.’*” Pet., 77-78 (citing Kotzin, ¶336 & 345) (emphasis added). But as opined by Petitioners’ expert to support Petitioners’ theory, the “identifiers” in Zhang indicate a type of signaling radio bearer only. Kotzin, ¶336 (“As explained above, a person of ordinary skill in the art would have understood that an SRB1 is one of three types of signaling radio bearers.”), and Petitioners’ theory depends on the use of “types” of signaling radio bearers. Pet., 78. Thus, they cannot be used to distinguish signaling radio bearers as required by claim 1. For claim 8, Petitioners’ erroneous analysis incorporates its flawed analysis of claim 1 (*see* Pet., 82), and fails for similar reasons.

Accordingly, the Petition fails to establish a reasonable likelihood that the petitioner would prevail with respect to Ground 3.

V. THE BOARD SHOULD DENY INSTITUTION UNDER *FINTIV*

Notwithstanding the substantive defects of the Petition, the Board can and should deny the Petition by exercising its discretion under 35 U.S.C. § 314(a) because the correct balance of relative factors weighs in favor of denial.

When evaluating whether to deny a petition under Board discretion, the Board balances six 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 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 at 5-6 (PTAB Mar. 20, 2020).

“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.* In evaluating these factors, the Board takes “a holistic

view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

In addition, the USPTO Director issued an “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (“Interim *Fintiv* Procedure”) dated June 21, 2022, which is addressed below with respect to *Fintiv* factors 2 and 4.

A balance of the *Fintiv* factors warrants denial of institution.

A. Factor 1 Favors Denial (Likelihood of Stay)

Factor 1—which considers whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted—favors denial of institution.

Petitioners have not moved for a stay of the district court litigation. Petitioners cite to a then-pending discovery dispute to suggest Factor 1 weighs against discretionary denial. Pet., 86. But Petitioners did not establish that the outcome of the discovery dispute—whether non-jurisdictional discovery may proceed against a KT Corporation prior to resolving KT Corporation’s jurisdictional dispute—will affect the trial date of September 8, 2025 set by the district court. Ex. 1014, 2. In fact, since the Petition was filed, the district court has twice granted motions for a protective order against non-jurisdictional discovery without any suggestion that the trial date would be adjusted. Ex. 2001;

Ex. 2002. Moreover, in the months after its Petition was filed, Petitioners have not requested a stay or that the trial date be adjusted. Under these circumstances, Factor 1 favors denial of institution or remains neutral.

Any stay is also unlikely due to the significant case progression (discussed in factor 3), scheduled jury trial preceding any final written decision (discussed in factor 2), and the timing of institution decisions on the ten other IPRs against patents asserted in the same litigations (discussed in factor 6). The first *Fintiv* factor therefore supports denying institution or remains neutral.

B. Factor 2 Favors Denial (Timing of Trial)

Fintiv factor 2 weighs in favor of denying institution because the district court is set to commence trial on September 8, 2025, nearly seven months before the Board’s final decision would be expected to be due, on or about April 30, 2026. *See* Ex. 1014, 2. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Fintiv*, IPR2020-00019, Paper 11 at 9.

This timeline undisputedly favors denial. Indeed, the Board has previously held that a trial date which precedes a final written decision deadline by five, four and even one-to-two months favors discretionary denial. *See, e.g., Samsung Elecs. Co., Ltd. v. Mojo Mobility Inc.*, IPR2023-01092, Paper 11 at 11 (PTAB Jan 8, 2024) (denying institution, finding that a trial date “about five months before the

projected statutory deadline” favored discretion to deny); *Bentley Motors Ltd.*, *Jaguar Land Rover Ltd.*, IPR2019-01539, Paper 9 at 14 (PTAB Mar. 10, 2020) (denying institution where trial was set to occur five months before final written decision); *Immersion Sys. LLC v. Midas Green Techs., LLC*, PGR2021-00104, Paper 15 at 11 (PTAB Jan. 31, 2022) (jury trial starting four months ahead of final written decision favored discretionary denial); *see also NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18 at 8-9 (PTAB May 2, 2022) (two-month period between trial date and deadline for final decision weighed in favor of discretionary denial); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 at 6-9 (PTAB May 15, 2019) (one-month period between trial date and deadline for final written decision weighed in favor of discretionary denial); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12-13 (PTAB May 13, 2020) (second factor favors denial when “the currently scheduled District Court trial is scheduled to begin two months before our deadline to reach a final decision”); *eClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (favoring denial where beginning of jury trial was “roughly one to two months” before final decision was due).

Additionally, the USPTO’s Interim *Fintiv* Procedure provides that the “[p]arties may present evidence regarding the most recent statistics on median time-to-trial for civil actions in the district court in which the parallel litigation

resides for the PTAB’s consideration ... the PTAB will also consider additional supporting factors, such as the speed and availability of other case dispositions.”

See Interim Fintiv Procedure, 8-9. Here, the September 2024 statistics for the median time-to-trial in the Eastern District of Texas show a period of 21.9 months. Ex. 2003 at 5, (available at https://www.uscourts.gov/sites/default/files/2024-12/fcms_na_distcomparison0930.2024.pdf). The median time-to-trial statistics for the district are thus consistent with the September 2025 trial date set out in Judge Gilstrap’s Docket Control Order, as the median time-to-trial statistics for the district predict a trial date in October 2025 (Ex. 2003) based on the December 29, 2023 filing date in district court. This small difference between the scheduled trial date and the statistical prediction—only about one month—still places the district court’s jury trial well before the estimated date of completion of this proceeding. Accordingly, *Fintiv* Factor 2 weighs significantly in favor of denial. *Samsung Elecs.*, IPR2023-01092, Paper 11 at 11-12 (using statistics to “confirm[] that the schedule set by the district court is credible and should be given weight”).

Petitioners’ contention that the statistics on median time-to-trial for civil actions in the district court in which the parallel litigation resides “do not apply to this case given the number of cases and number of defendants” (Pet. 87, n.5) ignores the nature of the median time-to-trial statistics, and is wrong. The combined nature of these statistics means that they provide a prediction for any

case, whether it is a case with a single defendant, a case with multiple defendants, or cases that are combined for discovery (like the parallel litigations here). Just as a patent owner cannot diminish the usefulness of such statistics by contending that its case is only a single-patent case with one defendant, petitioners cannot diminish the usefulness of these statistics by contending that their case is complex.

Also, the suggestion in the Petition that there would be “post-trial motions” in order to suggest a later completion date for the district court litigation is inconsistent with *Fintiv* and provides an incorrect measurement. *Fintiv* does not account for activities occurring at the USPTO following a Final Written Decision, such as requests for rehearing or requests for Director Review, when considering whether there would be an undesirable overlap of activities. Instead, the time posts for measurement set out in *Fintiv* compare the date of the expected Final Written Decision to the expected trial date.

Judge Gilstrap has already set the date for the initial jury trial, and that jury trial will conclude well before the Board's projected statutory deadline. *See* Ex. 1014. Additionally, because of the stage of the underlying case and the speed with which the Eastern District of Texas reaches case dispositions, there are likely to be district court determinations relating to the validity of the '932 patent in advance of the Board's projected statutory deadline. Ex. 2003, 5. Indeed, the Court's Scheduling Order requires dispositive motions on issues such as (in)validity to be

filed by June 2, 2025, and requires defendants to identify its final invalidity theories by September 1, 2025. *See* Ex. 1014, 4 (setting the deadline for dispositive motions); *id.*, 2 (setting the deadline to disclose final invalidity theories).

Finally, Petitioners’ attempt to minimize the closeness of the scheduled trial date with the suggestion that “jury selection would proceed with respect to only one of the three cases” (Pet., 86) does not reduce the weight in favor of discretionary denial in this proceeding. When presented with a similar situation and argument, the PTAB has held “[e]ven if the proceedings are staggered, at least one of the proceedings would likely begin and conclude well before our decision, making it highly likely that there will be duplicate efforts in evaluating the challenged claims based on the prior art.” *AT&T Serv. Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-00992, Paper 14 at 10-11 (PTAB Dec. 16, 2024) (weighing Factor 2 “substantially in favor of discretionary denial”); *see also AT&T Serv. Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-01142, Paper 14 at 13 (PTAB Jan. 27, 2025); *AT&T Serv. Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-01121, Paper 14 at 11-12 (PTAB Jan. 27, 2025).

Thus, *Fintiv* factor 2 substantially weighs in favor of discretionary denial.

C. Factor 3 Favors Denial (Investment in Parallel Proceedings)

Factor 3 also weighs in favor of denial because the district court and both

Patent Owner and Petitioners will have expended considerable resources in the parallel litigation, including on the merits of Petitioners' invalidity positions, by the time the Board issues an institution decision. *See Sand Revolution II, LLC v. Cont'l Intermodal Grp.*, IPR2019-01393, Paper 24 at 10 (PTAB June 16, 2020) (noting that investment in invalidity contentions is relevant to this factor).

For factor 3, the Board considers "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*, IPR2020-00019, Paper 11 at 9. "This investment factor is related to the trial date factor, in that more work completed by the parties and the court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs." *Id.*, 10.

Here, Patent Owner served infringement contentions on Petitioners in district court on March 18, 2024, allowing Petitioners ample time to prepare and serve their district court invalidity contentions on May 17, 2024, approximately two months later. Pet., 87; *see also* Ex. 2004, 2009-2012. Yet, Petitioners delayed until October 18, 2024—seven months after receiving infringement contentions—to file its Petition challenging the '631 patent. Despite noting the date that the invalidity contentions were served in its Petition (Pet., 87), Petitioners provide no justification for the delay in filing their Petition. The PTAB has found when

examining *Fintiv* that where “Petitioner has not presented any factual evidence to justify” a delay after being served with infringement contentions, factor 3 weighs in favor of denial of institution. *See AT&T Serv.*, IPR2024-00992, Paper 14 at 12 (“the record shows that Petitioner waited five months to file the Petition after receiving Patent Owner’s infringement contentions, and Petitioner has not presented any factual evidence to justify this delay.”) (citing *Fintiv*, IPR2020-00019, Paper 11 at 11–12); *see also AT&T Serv.*, IPR2024-01142, Paper 14 at 13–15; *AT&T Serv.*, IPR2024-01121, Paper 14 at 12–13.

The facts here weigh even more in favor of denial than in the *AT&T Services* cases. Here, there was a delay of an additional two months from the date when the infringement contentions were served as compared to *AT&T Services*. Also, Petitioners served their own set of invalidity contentions in district court. As will be discussed with regard to factor 3 below, those infringement contentions overlap substantially with the Petition (and are even more comprehensive). Petitioners’ invalidity contentions include claim charts addressing the same references asserted by Petitioners in every ground of its Petition for every claim challenged in the co-pending litigation. *See, e.g.*, Exs. 2004, 2009–2012. Petitioners provide no justification for delaying five months to file its Petition when it had developed its invalidity theories sufficiently to include them in a district court pleading over five months earlier. Patent Owner and Petitioners will have expended substantial

resources in the parallel litigation, including on the merits of the invalidity positions, where—as detailed below—there is significant overlap of issues.

Indeed, given that the Board is projected to issue an institution decision by April 30, 2025, numerous labor-intensive activities such as these have taken place, or will take place, in the parallel litigations before that date. Fact discovery opened in early 2024 and is on-going relating to those issues, which is set to be completed on April 14, 2025, before the Board is expected to reach an institution decision in this IPR. Further, Petitioners will be required to prepare and serve their expert witness disclosures under Fed. R. Civ. P. 26(a)(2) relating to their invalidity contentions by April 21, 2025, and Patent Owner will be required to similar serve their infringement expert reports on that date.

As district court proceedings allow more invalidity defenses to be presented than in this proceeding, Petitioners' invalidity expert reports can be expected to present more comprehensive challenges to validity than presented in this proceeding. For example, in district court, Petitioners contend that the claims of the '932 patent are invalid under 35 U.S.C. § 112(a) and § 112(b). *See* Ex. 2004, 359, 360-61, 365, 366. Thus, the district court will be in the best position to resolve all of the validity issues relating to the '932 patent. Efficiency would favor the forum that can address all of the validity issues at the same time.

Additionally, Patent Owner and Petitioners will expend significant time and

resources relating to claim construction prior to April 30, 2025. The parties have exchanged preliminary claim constructions (November 26, 2024), prepared a Joint Claim Construction Statement (December 17, 2024), completed claim construction discovery (January 14, 2025), served claim construction briefing and optional technical tutorials (beginning January 28, 2025). All of those activities will culminate in a claim construction hearing on March 11, 2025, which will tax the resources of Petitioners and Patent Owner, as well as the district court.

Finally, as noted in factor 2, the Court's Scheduling Order requires dispositive motions on issues such as (in)validity to be filed by June 2, 2025, and requires defendants to identify its final invalidity theories by September 1, 2025. *See* Ex. 1014, 4 (setting the deadline for dispositive motions); *id.*, 2 (setting the deadline to disclose final invalidity theories). Should the Board institute, the Parties will effectively duplicate the efforts expended in the District Court to address the validity of the '932 patent.

These investments in the district court proceeding favor denial.

D. Factor 4 Favors Denial (Overlap of Issues)

Factor 4 also weighs in favor of discretionary denial because there is substantial overlap between the claims, arguments, and evidence raised in the Petition and in Petitioners' invalidity contentions in the parallel district court proceeding.

Petitioners challenge claims 1-2, 4, 8-9, and 11 of the '932 patent as obvious based on three references, Lin1, Lin2, and Zhang. Similarly, in district court, Petitioners' invalidity contentions challenge the same set of claims, claims 1-2, 4, 8-9, and 11 of the '932 patent based on Lin '881⁵, Lin '876⁶, and Zhang '752⁷ alone and in combination with other references. *See* Ex. 2004, 8-9, 12 (cover pleading); Ex. 2009, (Appx. C); Ex. 2010 (Ex. C-1) (Lin1/Lin '881); Ex. 2011 (Ex. C-3) (Lin2/Lin '752); Ex. 2012 (Ex. C-2) (Zhang/Zhang '752). Thus, there is substantial overlap between the Petition and the district court proceeding, as the claims challenged and primary references relied upon are identical. Therefore, Petitioners' common prior art challenges to the claims renders the "overlap in issues between the two proceedings [] substantial." *Code200, UAB v. Luminate Networks, Ltd.*, IPR2020-01506, Paper 10 at 11-12 (PTAB Feb. 16, 2021).

⁵ Lin '881 and Lin1 are substantially the same, as Lin '881 is a U.S. counterpart to Lin1. Specifically, Lin1 is a PCT publication based on PCT application PCT/CN2014/089300. *See* Lin1, 1 (item 21). Lin '881 is a continuation of PCT application PCT/CN2014/089300. Ex. 2013 (item 63).

⁶ Lin '876 and Lin2 are substantially the same, as Lin '876 is a U.S. counterpart to Lin2. Specifically, Lin2 is a PCT publication based on PCT application PCT/CN2014/089310. *See* Lin2, 1 (item 21). Lin '876 is a continuation of PCT application PCT/CN2014/089310. Ex. 2014 (item 63).

⁷ Zhang '752 and Zhang are substantially the same, as Zhang '752 is a U.S. counterpart to Zhang. Specifically, Zhang is a PCT publication based on PCT application PCT/CN2013/071776. *See* Ex. 1008, 1 (item 21) (note that Petitioner's English translation of Ex. 1008 found at Ex. 1007 lacks all pages from Ex. 1008, including its cover page). Zhang '752 is a continuation of PCT application PCT/CN2013/071776. Ex. 2015 (item 63).

Moreover, none of the Petitioners has offered a *Sotera* stipulation. *Inter Partes* Review is intended to be a “quick and cost effective alternative[] to litigation,” not an avenue for Petitioners to argue invalidity a second time in a second venue. *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1317 (Fed. Cir. 2018) (quoting H. Rep. No. 112-98, at 40, 48 (2011)). Indeed, Petitioners’ failure to offer a *Sotera* stipulation, despite the substantial overlap between the proceedings, only highlights the concerns of duplicative efforts and conflicting outcomes raised by *Fintiv* and the USPTO’s Interim *Fintiv* Procedure.

And Petitioners’ assertion in district court of *additional* prior art and *additional* combinations of art than those asserted here does nothing to alter the degree of overlap between the Petition and its invalidity contentions. *See, e.g., Fintiv*, IPR2020-00019, Paper 15 at 15 (finding Petitioner’s assertion of additional invalidity contentions “not relevant to the question of the degree of overlap for this factor”).

Petitioners argue that there is not perfect overlap between this IPR and the district court cases “because there are 6 claims asserted in this case and a total of 113 asserted in the related district court cases” (Pet., 88), but this argument misses the mark. The 113 litigated claims include claims in patents other than the ’932 patent, and the existence of other litigated claims does not diminish the perfect overlap between the claims in this IPR and the same six litigated claims. But even

when there is not a perfect alignment between the claims in IPR and litigation, the Board has repeatedly ruled that the assertion of additional claims does nothing to mitigate “substantial” overlap in issues between the two proceedings where common prior art is presented and common independent claims are challenged. *See, e.g., Code200, UAB*, IPR2020-01506, Paper 10 at 11-12 (“In light of the common prior art asserted here and in the [] district court case, as well as the common challenge to the sole independent claim and all but two of the dependent claims of the [’384] patent, we agree with the Patent Owner that the overlap in issues between the two proceedings is substantial.”); *see also Teso LT UAB v. Luminati Networks Ltd.*, IPR2021-00122, Paper 12 at 10 (PTAB Apr. 20, 2021) (denial of institution favored where Petition’s prior art references were all identified in the district court invalidity contentions, the same independent claims were challenged in both proceedings, and “the *additional* claims challenged in the Petition are all dependent claims”).

Therefore, with this substantial overlap between the Petition and the parallel proceedings, there are particularly strong “concerns of inefficiency and the possibility of conflicting decisions” if the IPR is instituted. *See, e.g., Fintiv*, IPR2020-00019, Paper 11 at 12 (finding “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong” where there is substantial overlap).

Accordingly, factor 4 weighs strongly in favor of denial of institution. *See Teso LT UAB*, IPR2021-00122, Paper 12 at 10 (finding “the overlap in issues between the two proceedings is substantial” where common art and common challenges to the independent claim were presented in both proceedings); *see also eClinicalWorks*, IPR2022-00229, Paper 10 at 12 (finding factor 4 weighed in favor of denial where Preliminary Invalidity Contentions showed overlap of asserted claims, art and arguments asserted in the Petition); *U.S. Venture, Inc. v. Sunoco Partners Mktg. & Terminals L.P.*, IPR2020-00728, Paper 10 at 12-14 (PTAB Oct. 1, 2020) (finding overlap between primary references asserted in Petition and litigation weighed in favor of denial).

For each of these reasons, factor 4 strongly favors discretionary denial.

E. Factor 5 Favors Denial (Overlapping Parties)

Patent Owner is the plaintiff and Petitioners are involved in the parallel litigation (Ex. 1014), and “because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Samsung Elecs. Co. v. Clear Imaging Research, LLC*, IPR2020-01401, Paper 12 at 21-22 (PTAB Feb. 17, 2021) (quoting *Fintiv*, IPR2020-00019, Paper 15 at 15).

F. Factor 6 Favors Denial (Other Factors)

Also weighing in favor of denial are at least two other factors: the substantive reasons as presented in Section IV above, and the manner in which Petitioners' various IPR challenges have been presented.

The litigation dispute between Patent Owner and Petitioners involves 11 patents, and the three federal litigations involving those 11 patents were filed in the district court on a single day, December 29, 2023. But rather than present its IPR challenges in a single group, Petitioners filed their IPRs in a piecemeal fashion and on a slow-rolling basis. In total, over the period from October 18 to December 31, 2024, Petitioners filed eleven IPRs. Further, as of the filing date of this POPR, at least four IPR petitions have not yet received notices according a filing date. Therefore, these four IPR petitions do not yet have preliminary response due dates. The following table summarizes the dates the eleven IPRs were filed, the IPR proceeding number, the date a notice according a filing date was issued, the anticipated institution deadline, and the anticipated final written decision deadline⁸:

⁸ Google joined the Petitioners as an additional petitioner in each of these IPR proceedings except for IPR2025-00036 and IPR2025-00037.

IPR2025-00037 Patent Owner's Preliminary Response

Filing Date	IPR	Notice of Filing Date	Date of Institution Decision (Est.)	Date of Final Written Decision (Est.)
10/21/24	IPR2025-00036	10/30/24	4/30/25	4/30/26
10/18/24	IPR2025-00037	10/30/24	4/30/25	4/30/26
11/15/24	IPR2025-00083	12/9/24	6/9/25	6/9/26
11/15/24	IPR2025-00084	12/9/24	6/9/25	6/9/26
12/24/24	IPR2025-00137	1/17/25	7/17/25	7/17/26
11/27/24	IPR2025-00138	1/29/25	4/29/25	7/29/25
12/26/24	IPR2025-00290	TBD	TBD	TBD
12/27/24	IPR2025-00291	TBD	TBD	TBD
12/31/24	IPR2025-00292	TBD	TBD	TBD
12/31/24	IPR2025-00293	TBD	TBD	TBD
12/24/24	IPR2025-00317	1/17/25	7/17/25	7/17/26

While this IPR may be one of the first to reach a decision on institution, it will be one of many decisions on institution the Board will need to make relating to the dispute between the Parties. 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.

Moreover, the complexity of this global dispute between Petitioners and Patent Owner encourages resolution in a single forum, without the risk of inconsistent results. While the Board generally evaluates each petition on its own,

district courts have additional tools available for resolving suits involving multiple patents, including established procedures for such disputes, deadlines for narrowing issues including the asserted claims and the invalidity contentions, and driving resolution of the dispute as a whole. *Cf.* Pet., 88 (“The district court will likely reduce the asserted claims”). For example, as noted above, the district court has already consolidated the district court proceedings for “all pretrial issues” (Pet., 91; *see also* Ex. 1015) and the consolidated action is progressing at pace towards a September 2025 trial date.

Also, the district court can resolve more disputed issues than the limited nature of IPR proceedings, which can only address a limited set of validity challenges. While IPR proceedings were once thought to be vehicles to settle validity questions concerning a patent, history has informed that IPR proceedings often only address some validity issues, leaving others for the district courts to deal with. When a patent survives an IPR, it adds complexity to the proceeding as the district court must then weigh questions of the scope of IPR estoppel. *See, e.g., EIS Inc. v. IntiHealth Ger GmbH*, 2023 WL 6797905, 19-1227-GBW (D. Del. Aug. 30, 2023) (addressing scope of IPR estoppel). And for other validity issues beyond the reach of IPRs (*see* Ex. 2004, 359, 360-61, 365, 366), those issues must be heard by the District Court.

Moreover, the merits of this Petition are weak as explained in Section IV. Far from presenting “a compelling unpatentability challenge,” *see Fintiv*, IPR2020-00019, Paper 11 at 13-14, the flaws in Petition are numerous. *See CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 24 (PTAB Mar. 17, 2023) (“to find compelling merits, the Board must provide reasoning to explain and support its determination as to compelling merits sufficient to allow the parties to challenge that finding and sufficient to allow for review of that decision.”)

In such circumstances, the Board has found that it “need not decide whether the merits of Petitioner’s asserted grounds are particularly strong because it would not impact [the] ultimate determination under Section 314(a)” and “the merits do not outweigh the other *Fintiv* factors.” *NXP USA*, PGR2022-00005, Paper 18 at 12-13 (finding that where factor 1 was neutral and factors 2-5 favored or slightly favored denial, factor 6 was neutral because it “would not impact [the] ultimate determination”); *Samsung Elecs.*, IPR2020-01401, Paper 12 at 23-25 (finding that where factors 1 and 4 slightly favored denial, factors 2 and 3 strongly favored denial, and factor 5 weighed in favor of denial, those factors outweighed any merits of the case considered in factor 6); *Apcon, Inc. v. Gigamon Inc.*, IPR2020-01579, Paper 9 at 26 (PTAB Mar. 16, 2021) (finding that the merits of the petitioner’s grounds do not outweigh the other factors in light of the strength of factors 2); *see also Fintiv*, IPR2020-00019, Paper 11 at 15 (“if the merits of the

grounds raised in the petition are a close[] call, then that fact has favored denying institution when other factors favoring denial are present”).

Accordingly, for the reasons stated above, Factor 6, and each of the remaining *Fintiv* factors counsel in favor of the Board exercising its discretion to deny institution.

VI. CONCLUSION

For the reasons presented above, the Petition should be denied, and no *inter partes* review should be instituted.

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CERTIFICATE OF WORD COUNT

The undersigned certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE complies with the type-volume limitation in 37 C.F.R. § 42.24(b)(1). According to the word-processing system's word count, the brief contains 8,997 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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CERTIFICATE OF SERVICE

Petitioner has consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on this date, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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