

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC., NOKIA OF AMERICA CORP., AT&T SERVICES, INC.,
CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS, GOOGLE LLC, AND
T-MOBILE USA, INC.,
Petitioners,

v.

PEGASUS WIRELESS INNOVATION LLC,
Patent Owner.

Case IPR2025-00083
U.S. Patent No. 10,638,463

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	Reserved
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	Reserved
2010	Reserved
2011	Reserved
2012	Reserved
2013	Reserved
2014	Reserved
2015	Reserved
2016	Reserved
2017	Reserved
2018	Comparison of Districts Within the Fifth Circuit — 12-Month Period Ending September 30, 2024 (available at https://www.uscourts.gov/sites/default/files/2025-02/fcms_na_distcomparison1231.2024.pdf)
2019	Appendix H 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)

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2020	Ex. H-8 of Appendix H 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)
2021	Ex. H-9 of Appendix H 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)
2022	Ex. H-3 of Appendix H 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)
2023	U.S. Patent Pub. No. 2020/0252180 (Takeda counterpart)
2024	U.S. Patent Pub. No. 2017/0265176 (Marinier counterpart)

Pursuant to 37 C.F.R. § 42.107, Pegasus Wireless Innovation LLC (“Pegasus” or “Patent Owner”) files this preliminary response to the Petition, setting forth reasons why the Petition for *inter partes* review (“IPR”) of claims 1-9 of U.S. Patent No. 10,638,463 (the “’463 patent”), as requested by Ericsson Inc., Nokia of America Corp., AT&T Services, Inc., Cellco Partnership d/b/a Verizon Wireless, Google LLC, and T-Mobile USA, Inc. (“Petitioners”), should be denied.¹

I. INTRODUCTION

Given the timing and advanced stage of co-pending litigation between the Petitioners and Patent Owner regarding the ’463 patent, the Board should exercise its discretion to deny the Petition under *Fintiv*. As enumerated below, each *Fintiv* factor weighs in favor of the Board exercising its discretion to deny institution. The co-pending litigation is scheduled to proceed to trial approximately nine months before the Board would be expected to issue a final written decision in this case, and seven other IPRs directed towards patents-at-issue in that litigation are on a timeline that is even later than this IPR. Further, there is substantial overlap between the validity challenges raised in the litigation and this IPR, and Petitioners have not submitted any stipulation regarding those challenges. Finally, a

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).

discretionary denial is strongly favored under the USPTO's current guidance regarding the *Fintiv* analysis, as of February 28, 2025.

Therefore, Patent Owner respectfully submits that the Board should exercise its discretion and deny this Petition against the '463 patent.

II. THE BOARD SHOULD DENY INSTITUTION UNDER *FINTIV*

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.*²

A proper 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., 66. 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

² On February 28, 2025, the USPTO rescinded the “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (“Interim *Fintiv* Procedure”) dated June 21, 2022. The Interim *Fintiv* Procedure no longer applies to the *Fintiv* analysis.

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 nine months before the Board's final decision would be expected to be due, on or about June 9, 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

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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).

The USPTO's Interim *Fintiv* Procedure, which was rescinded on February 28, 2025, provided 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. While that policy no longer carries weight in the *Fintiv* analysis, the statistics still weigh in favor of denial.

Here, the December 2024 statistics for the median time-to-trial in the Eastern District of Texas show a period of 23.0 months. Ex. 2018 at 5, (available at https://www.uscourts.gov/sites/default/files/2025-02/fcms_na_distcomparison1231.2024.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 November 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 two months—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”).

Although the median time-to-trial for civil actions statistics are generally consistent with a September 8, 2025 trial date, the Board should not look to the median time-to-trial for civil actions statistics, as the Director has rescinded the guidance to consider those statistics found in the June 21, 2022 memorandum containing the Interim *Fintiv* Procedure. In any event, even Petitioners argue the statistics “are not illuminating.” Pet. 70, n.2 (stating other reasons not to consider the statistics).

Also, the suggestion in the Petition that there would be “post-trial motions” (Pet., 67) 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 '463 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., 66) 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., 68; *see also* Ex. 2004, 2020-2022. Yet, Petitioners delayed until December 9, 2024—over eight months after receiving infringement contentions—to file its Petition challenging the '463 patent. Despite noting the date that the invalidity contentions were served in its Petition (Pet., 68), 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 three 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 4 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, 2020-2022. Petitioners provide no justification for delaying nearly seven months to file its Petition when it had developed its invalidity theories sufficiently to include them in a district court pleading nearly seven 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 June 9, 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, is on-going relating to those issues, and 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 '463 patent are invalid under 35 U.S.C. § 112(a) and § 112(b). *See* Ex. 2004, 357, 362-63. Thus, the district court will be in the best position to resolve all of the validity issues relating to the '463 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 June 9, 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 '463 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 assert two grounds in their Petition, and each Ground applies to all challenged claims (claims 1-9), including independent claims 1, 4, and 7. Ground 1 contends the claims are obvious over Takeda³ and Yan⁴ and Ground 2 contends the claims are obvious in view of Marinier,⁵ Yan, and R1-1711853⁶.

Similarly, in district court, Petitioners' invalidity contentions challenge the same set of claims, claims 1-9 of the '463 patent based on Takeda⁷, Yan, and

³ Ex. 1006, International Publication No. WO 2019/030929 A1 ("Takeda"); see *also* Ex. 1007, Certified Translation of International Publication No. WO 2019/030929 A1.

⁴ Ex. 1010, U.S. Patent No. 10,736,085 ("Yan" or "Yan- U.S. Patent").

⁵ Ex. 1011, U.S. Patent Application Publication No. US2014/0056278 A1 ("Marinier").

⁶ Ex. 1012, Activation/deactivation of bandwidth part ("R1-1711853").

⁷ Takeda and Takeda III are substantially the same, as Takeda is a U.S. counterpart to Takeda. Specifically, Takeda is a PCT publication based on PCT application PCT/JP2017/029223. *See* Takeda, 1 (item 21). Takeda III is national stage entry of PCT application PCT/JP2017/029223. Ex. 2023 (item 86).

Marinier⁸ alone and in combination with other references. *See* Ex. 2004, 2, 8, 17-18 (cover pleading); Ex. 2019, (Appx. H); Ex. 2020 (Ex. H-8) (Takeda/Takeda III); Ex. 2021 (Ex. H-9) (Yan); Ex. 2022 (Ex. H-3) (Marinier/Marinier counterpart). Thus, there is substantial overlap between the Petition and the district court proceeding, as the claims challenged and most of the primary references relied upon are identical. The only exception is R1-1711853, which is a two-page “Proposal” mentioned in the Petition as a redundancy. *See, e.g.*, Pet., 52 (“Nevertheless...”); Pet. 53 (“In the event that...”). 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).

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,

⁸ Marinier and its counterpart are substantially the same, as the Marinier counterpart is a publication of a continuation application from Marinier. Specifically, the Marinier counterpart is a publication of a continuation to application no. 13/974,911 (Ex. 2024 (item 63)) and Marinier is a publication based on application no. 13/974,911 (Ex. 1011 (item 21)).

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 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 9 claims asserted in this case and a total of 113 asserted in the related district court cases" (Pet., 68), but this argument misses the mark. The 113 litigated claims include claims in patents other than the '463 patent, and the existence of other litigated claims does not diminish the perfect overlap between the claims in this IPR and the same nine 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 denying 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 defects in the Petition, 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

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on a slow-rolling basis. In total, over the period from October 18 to December 31, 2024, Petitioners filed eleven IPRs. The following table summarizes the dates the eleven IPRs were filed, the IPR proceeding number, the date on which the USPTO's Notice according a filing date was issued, the anticipated institution deadline, and the anticipated final written decision deadline⁹:

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	7/29/25	7/29/26
12/26/24	IPR2025-00290	2/6/25	8/6/25	8/6/26
12/27/24	IPR2025-00291	2/6/25	8/6/25	8/6/26
12/31/24	IPR2025-00292	2/6/25	8/6/25	8/6/26
12/31/24	IPR2025-00293	2/6/25	8/6/25	8/6/26
12/24/24	IPR2025-00317	1/17/25	7/17/25	7/17/26

While this IPR may be among the earlier proceedings to reach a decision on institution, it will be one of at least eleven 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

⁹ Google joined the Petitioners as an additional petitioner in each of these IPR proceedings except for IPR2025-00036 and IPR2025-00037.

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 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., 68 (“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., 72; *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, 357, 362-63), those issues must be heard by the District Court.

Furthermore, the merits of this Petition are weak. Far from presenting “a compelling unpatentability challenge,” *see Fintiv*, IPR2020-00019, Paper 11 at 13-14, the flaws in Petition are numerous.

Where the bulk of the factors weigh in favor of denial, 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”).

Nevertheless, here the Petition contains defects sufficient to render the challenges deficient. In particular, each independent claim includes the following features: “wherein the UL control channel resource sets are configured for each UL bandwidth part (BWP) configured for the user equipment,” and “wherein the each UL BWP is activated through downlink (DL) control information.” During prosecution, the as-filed claims were originally rejected over a combination of asserted art. Ex. 1004, 159-167. In response, the application amended the independent claims to incorporate these features and to distinguish over the prior art relied upon by the examiner in the stated rejections. Ex. 1004, 68-74.

As the applicant convincingly argued to the examiner concerning a reference to Yiu applied by the examiner, Yiu “merely teaches about BWP but **fails** to teach i) **receiving any information** about **each UL** BWP” Ex. 1004, 73 (emphasis in original). The applicant also argued that Yiu “**does not** teach activating **each UL** BWP through **DL control information**.” Id. (emphasis in original). In these arguments, which were accepted by the examiner as sufficient to overcome the

rejections (Ex. 1004, 50-51), the applicant focused on and emphasized the “each” language in these amendments.

Here, the Petition fails to fully address each of the wherein clauses added during prosecution to each independent claim in each Ground, as demonstrated below:

Ground 1: Petitioners argue that claims 1-9 are unpatentable over Takeda in view of Yan. This challenge begins on page 10 of the Petition, and continues through page 43. However, the operative portions of the Petition for the purpose of this shortcoming occur at pages 32-34, addressing element 1[e], and page 35, addressing element 1[f].

In the section addressing the sixth *Fintiv* factor, Petitioners broadly assert that the Takeda reference “discloses each of the two wherein clauses that the Examiner argued were missing from the prior art.” Pet., 69 (citing Ex. 1002, ¶¶127-135; Ex. 1004, 44-53). But this is incorrect because Petitioners fail to fully address these wherein clauses in their merits challenges. While Petitioners’ analysis of both elements is deficient, this shortcoming is best introduced with regard to element 1[f].

In addressing element 1[f], “wherein the each UL BWP is activated through downlink (DL) control information,” Petitioners’ challenge is limited to quoting two sentences from Takeda *without analysis*. Pet., 35. Petitioners simply quote

Takeda’s sentences: “[t]he user terminal may control activation and/or deactivation of *one or more UL BWPs* configured for the user terminal based on the explicit or implicit indication information. The explicit indication information may be, for example, DCI [downlink control information] (UL grant).” Pet., 35 (emphasis modified from original). This brief quotation of Takeda fails to explain how Takeda allegedly discloses that “the *each* UL BWP is activated through downlink (DL) control information” in element 1[f]. (emphasis added).

Petitioners characterize the examiner’s amendment that added “the” to “the each UL BWP” in element 1[f] as a “non-substantive examiner’s amendment.” Pet., 4 (describing the examiner’s amendment in the notice of allowance at Ex. 1004, 44-53). But this characterization rings false, and fails to acknowledge that this amendment adds antecedent basis to the “each UL BWP.” Moreover, this antecedent basis points to element 1[e], which recites “wherein the UL control channel resource sets are configured for *each UL bandwidth part (BWP) configured for the user equipment.*” (emphasis added).

Thus, turning back to Petitioners’ analysis of element 1[e], Petitioners also fail to address the “each” aspect of this element. Initially, Petitioners contend that Takeda “teaches multiple UL control channels ... are scheduled for transmission within each particular bandwidth part.” Pet., 32. But the cited portions of Takeda

provide no disclosures supporting this contention as it relates to “each UL bandwidth part (BWP)” as claimed.

Petitioners quote Takeda’s [0117], which addresses contents of “UL BWP #1.” Continuing this limited focus on only one BWP, Petitioners state that “FIGS. 8-9 of Takeda show that multiple UL resources are configured for a *single UL BWP*.” Pet., 32 (emphasis added). Petitioners continue, concluding that “Takeda discloses that sets (encompassing multiple UL resources) are configured for a BWP.” Pet., 33.

Petitioners acknowledge that “BWPs are configured for the user terminal,” Pet., 34 (emphasis omitted), but plainly fail to identify which BWPs are configured for a user terminal. Rather, Petitioners simply rely on Takeda’s vague disclosure regarding “one or more BWPs configured for the user terminal” without addressing the claim requirements that must be satisfied for each UL BWP configured for a user terminal. Because the Petitioners are not specific about the number or identity of BWPs configured for a user terminal, Petitioners therefore also fail to establish that Takeda teaches the claimed features of element 1[e] for *each* UL BWP configured for a user terminal.

To the extent that Petitioners believe Takeda “discloses each of the two wherein clauses that the Examiner argued were missing from the prior art,” as alleged on page 69 of the Petition, they have failed to show how or where Takeda

allegedly discloses these complete wherein clauses. The Petition's shortcoming on this point is fatal to Petitioners' Ground 1 because Petitioners do not even realize Takeda's shortcoming in this regard, and therefore do not rely on Yan to remedy this shortcoming.

Thus, Ground 1 will likely fail against claim 1, and because the Petition relies entirely on its analysis for elements 1[e] and 1[f] to challenge the corresponding claimed features of independent claims 4 and 7, Ground 1 will also likely fail against these claims as well. *See* Pet., 40 (addressing elements 4[c] and 4[d]); 42-43 (addressing elements 7[d] and 7[e]).

Ground 2: Petitioners argue that claims 1-9 are unpatentable over Marinier in view of Yan, further in view of R1-1711853. This challenge begins on page 43 of the Petition, and continues through page 63. The operative portions of the Petition for the purpose of this shortcoming occur at pages 51-52, addressing element 1[e], and pages 52-54, addressing element 1[f].

Once again, Petitioners fail to establish how these references, considered alone or in combination, disclose or suggest every claimed features of elements 1[e] and 1[f].

Looking at element 1[e], Petitioners rely on Marinier to disclose the “use of BWPs for communicating between a WTRU and a serving site.” Pet., 52. Marinier discloses that “[e]ach serving site may be configured to utilize one or

more of the BW parts for communicating with the WTRU,” and “each BW part may include corresponding PUCCH and PUSCH resources.” Pet., 52 (quoting Marinier, [0130]). Petitioners then point to a different section of Marinier, which discloses that “BWPs may be specifically configured for each WTRU.” Pet., 52 (citing Marinier, [0147]). But these citations are not explained by Petitioners, and miss the point of establishing the claimed characteristics of “each UL bandwidth part (BWP) configured for the user equipment” in element 1[e]. In particular, while Marinier discloses that BWPs may be specifically configured for each WTRU, Marinier fails to disclose that “UL control channel resource sets are configured for each” such UL BWP configured for a user equipment.

Next, addressing element 1[f], Petitioners allege that Marinier “discusses UL grants within DCI” that direct a WTRU to transmit on an UL channel. Petitioners assert that “[a]s Marinier discloses that BW parts (containing PUCCH resources) are used for communication between serving sites and WTRUs (*Id.*, [0130], [0147]), a POSITA would further recognize that a bandwidth part ‘containing’ the PUCCH used for UL transmission would need to be activated to perform the UL transmission.” Pet., 53. But Petitioners have to do a lot of work to connect the dots in Marinier because Marinier fails to correlate DCI with activation of a UL BWP, much less “each UL BWP” as claimed. Specifically, Petitioners try to tie the DCI to a PUCCH “included in an inactive BW part,” and interpret Marinier’s

DCI as commanding the user equipment to activate “the inactive BW part through the DL control information that contains the UL grant, so that the UE can transmit UCI on the PUCCH that is included in the BW part.” Pet., 53. The result of this analysis is that Petitioners invent an inactive BW part in Marinier, and then invent a command to activate that inactive BW part based on the DCI. This is a violation of the statutory limits of IPRs, which permit challenges based on patents and printed publications only, not undisclosed scenarios created by Petitioners. And in any event, even if this theory had basis in Marinier's disclosures, which it does not, Petitioners still fail to address how this scenario applies to “the each UL BWP” defined in elements 1[e] and 1[f]. And while Petitioners look to R1-1711853 for use of DCI with DL or UL bandwidth parts, this additional reference still fails to address “the each UL BWP” defined in elements 1[e] and 1[f].

Ground 2 therefore will likely fail against claim 1, and because the Petition relies entirely on its analysis for elements 1[e] and 1[f] to challenge the corresponding claimed features of independent claims 4 and 7, Ground 2 will also likely fail against these claims as well. *See* Pet., 58-59 (addressing elements 4[c] and 4[d]); 61 (addressing elements 7[d] and 7[e]).

For these reasons, the merits of the challenges asserted in the Petitioner are not compelling, and do not support institution. Further, even if the Board chooses

not to evaluate the merits of the challenges, the remaining *Fintiv* factors overwhelmingly favor denial.

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.

III. 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 7,223 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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CERTIFICATE OF SERVICE

Petitioners have consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on March 10, 2025, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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