

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 IPR2025-00084
U.S. Patent No. 11,219,000

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	Reserved
2020	Reserved
2021	Reserved
2022	Reserved
2023	U.S. Patent Pub. No. 2020/0252180 (Takeda counterpart)

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2024	U.S. Patent Pub. No. 2017/0265176 (Marinier counterpart)
2025	Appendix G 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)
2026	Ex. G-9 of Appendix G 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)
2027	Ex. G-8 of Appendix G 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)
2028	Ex. G-3 of Appendix G 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)

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 1-12 of U.S. Patent No. 11,219,000 (the “’000 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 ’000 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 '000 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) to deny the Petition 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., 79. 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., 70) 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 '000 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., 69) 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., 71; *see also* Ex. 2004, 2025-2028. Yet, Petitioners delayed until December 9, 2024—over eight months after receiving infringement contentions—to file its Petition challenging the '000 patent. Despite noting the date that the invalidity contentions were served in its Petition (Pet., 71), 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, 2025-2028. 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 '000 patent are invalid under 35 U.S.C. § 112(a) and § 112(b). *See* Ex. 2004, 357, 362. Thus, the district court will be in the best position to resolve all of the validity issues relating to the '000 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 '000 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 four grounds in their Petition, but only three of those grounds, Grounds 1, 2, and 4, apply to the independent claims (claims 1, 5, and 9). Ground 1 contends that the independent claims, and certain dependent claims (claims 4, 8, and 12), are obvious over Yan³, Ground 2 contends that the independent claims, and all of the dependent claims, are obvious over Takeda⁴ in view of Yan, and Ground 4 contends that the independent claims, and all of the dependent claims, are obvious over Marinier⁵ in view of Yan and R1-1711853⁶. For completeness, Ground 3 is not used to shore up the deficiencies of the challenges against the independent claims in Grounds 1, 2, or 4. Instead, Ground 2

³ Ex. 1010, U.S. Patent No. 10,736,085 ("Yan" or "Yan- U.S. Patent").

⁴ Ex. 1006, International Publication No. WO 2019/030929 A1 ("Takeda"); *see also* Ex. 1007, Certified Translation of International Publication No. WO 2019/030929 A1.

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

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

contends dependent claims 2-3, 6-7, and 10-11 are obvious in view of Yan in view of R1-1711853.

Similarly, in district court, Petitioners’ invalidity contentions challenge the same set of claims, claims 1-12 of the ’000 patent based on Yan, Takeda⁷, and Marinier⁸ alone and in combination with other references. *See* Ex. 2004, 1, 8, 16-17 (cover pleading); Ex. 2025, (Appx. G); Ex. 2026 (Ex. G-9) (Yan); Ex. 2027 (Ex. G-8) (Takeda/Takeda III); Ex. 2028 (Ex. G-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” applied in the Petition against certain dependent claims and as a redundancy. *See, e.g.*, Pet., 46-47; Pet., 57-58 (“Nevertheless...”); Pet. 59 (“In the event that...”). Therefore, Petitioners’ common prior art challenges to the claims renders the “overlap in issues between the two proceedings []

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).

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)).

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, 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 12 claims asserted in this case and a total of 113 asserted in the related district court cases” (Pet., 71), but this argument misses the mark. The 113 litigated claims include claims in patents other than the ’000

patent, and the existence of other litigated claims does not diminish the perfect overlap between the claims in this IPR and the same 12 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 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 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 a 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

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

Filing Date	IPR	Notice of Filing Date	Date of Institution Decision (Est.)	Date of Final Written Decision (Est.)
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 one of the first four IPRs 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 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., 71 (“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., 75; *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), 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. As noted above in Factor 4, Petitioners assert four grounds in their Petition, but only three of those grounds, Grounds 1, 2, and 4, apply to the independent claims (claims 1, 5, and 9). Ground 1 contends that the independent claims are obvious over Yan, Ground 2 contends that the independent claims are

obvious over Takeda in view of Yan, and Ground 4 contends that the independent claims are obvious over Marinier in view of Yan and R1-1711853.

In each challenge of an independent claim, Petitioners concede that the asserted art does not disclose the claimed feature of “wherein the UL control channel resource set configuration information is received through UE specific radio resource control (RRC) signaling.” Petitioners then improperly use hindsight reasoning, rather than any patent or printed publication, to incorporate these claimed features into the asserted combinations. This claimed feature, which the examiner recognized as a clear distinction from the prior art, is neither disclosed nor suggested. For this reason, Petitioners’ challenges have substantial flaws and will likely fail on the merits.

In particular, Petitioners rely on improper hindsight as a basis to modify the asserted references in each Ground, as demonstrated below:

Ground 1: Petitioners argue that claims 1, 4-5, 8-9, and 12 are unpatentable over Yan. This challenge begins on page 10 of the Petition, and continues through page 23. The operative portion of the Petition for the purpose of this shortcoming occurs at pages 16-17, addressing element 1[f].

Per Yan, “[b]efore the receiving, by a terminal device, channel indication information from an access network device on a physical control channel, the method further includes: receiving, by the terminal device, configuration

information of the N channel resource sets from the access network device by using higher layer signaling, where configuration information of the N channel resource sets corresponding to the different terminal devices is different.” Yan, 19:5-12. Petitioners point to this disclosure to support that Yan allegedly discloses element 1[f] because they contend that a POSITA would understand that Yan’s “higher layer signaling” is RRC. Pet., 16.

In attempting to put the pieces of its challenge together, Petitioners assert that a “POSITA would recognize that configuration information which allocates UL resources is transmitted using either downlink control information (DCI) (for dynamic scheduling) or RRC (for configured grant scheduling) as a type of higher layer signaling.” Pet., 16. Without explanation, Petitioners contend that Yan’s “higher layer signaling” “is transmitted via RRC signaling.” Petitioners also contend that RRC signaling is “UE-specific” as claimed in element 1[f] “because it provides configuration information of channel resource sets which are “preconfigured ... *for the terminal device.*” Pet., 17 (emphasis in original) (citing the Roy Declaration, Ex. 1002, ¶133 and Yan, 11:51-52, 12:34-36).

But Petitioners’ logic does not hold up.

Initially, Dr. Roy’s Declaration provides an overview discussion of the relevant technology, beginning at ¶43. Per Dr. Roy, the “DCI contains control information used to schedule transmissions of uplink information.” Roy Decl.,

¶48. “DCI may allocate physical resources (e.g., time and/or frequency resources) for uplink data to be transmitted via the PUSCH.” *Id.* “The DCI format carries necessary information for scheduling of DL and UL transmissions, inclusive of frequency and time domain resource assignments (resource block locations), the modulation and coding schemes used, antenna ports, precoding matrix information and number of layers, transmit power control, and hybrid automatic repeat request (HARQ)-related aspects of the scheduled transmission.” *Id.*

Moreover, Dr. Roy states that “[f]or unpredictable UL signals (e.g., when a user is uploading large data files (e.g., images or videos) to a network-based storage environment), the BS may use dynamic scheduling to control UL signal transmissions.” *Id.*, ¶49. “In dynamic scheduling, the DCI received by the UE includes uplink channel parameters (e.g., an indication of a set of PUSCH or PUCCH resources available to the UE for transmitting UCI).” *Id.* Dr. Roy also notes that for “dynamic scheduling, the parameters and allocation within the DCI are only used for a single UL transmission after the UE receives and decodes the DCI; a second set of DCI must be received and decoded by the UE (with new parameters and allocation) before a second UL signal containing UCI is transmitted.” *Id.*

The picture Dr. Roy paints in this background discussion is that user equipment-specific signaling to identify parameters and resource allocation for a

UE uplink transmission would be sent via DCI. And as already noted above, Petitioners clearly distinguish between DCI and RRC. Indeed, given Dr. Roy's clear discussion in this technical tutorial, the conclusion to be drawn is that for establishing user equipment-specific signaling, a system would not use RRC but rather would use DCI to transmit UL control channel resource set configuration information.

Dr. Roy also explains that “[f]or more predictable UL signals (e.g., periodic uploads of data over a duration), the BS uses configured grant scheduling for UL signal transmissions.” Roy Decl., ¶50. “In configured grant scheduling, the parameters for UL transmissions are sent periodically but not necessary before every UL transmission (i.e., the parameters may apply to multiple subsequent UL transmissions).” *Id.* However, Dr. Roy fails to explain how and why this use of RRC signaling would be considered user equipment-specific RRC signaling, as required by element 1[f].

While Petitioners provide a back-up argument that it would have been obvious to use RRC signaling in Yan, this argument is not founded upon any patent or printed publication, and instead simply relies up on Dr. Roy's declaration to fill in this missing claim element. As the Board's Patent Trial Practice Guide explains, this is an improper use of expert testimony, and should be rejected.

Thus, Ground 1 will likely fail against claim 1, and because the Petition relies entirely on its analysis for element 1[f] to challenge the corresponding claimed features of independent claims 5 and 9, Ground 1 will likely fail against these claims as well. *See* Pet., 20 (addressing element 5[d]); 23 (addressing element 9[e]).

Ground 2: Petitioners argue that claims 1-12 are unpatentable over Takeda in view of Yan. This challenge begins on page 23 of the Petition, and continues through page 44. The operative portion of the Petition for the purpose of this shortcoming occurs at page 38.

In Ground 2, Petitioners again rely upon their analysis based on Yan in Ground 1 to address element 1[f]. This is incorrect for the reasons already discussed above.

Petitioners also assert that “Takeda discusses that RRC signaling is the higher level signaling used for providing configuration information to a UE (e.g., BWP configuration information, DL CORESET configuration information, including frequency resources, time resources, duration, Resource Element Group bundle size, transmission type, and/or a period of each CORESET).” Pet., 38. However, Petitioners and Dr. Roy both fail to reconcile this disclosure with Dr. Roy’s earlier reliance on DCI for conducting UE-specific signaling. Moreover, even assuming that Takeda discloses the use of RRC signaling as providing

configuration information, Petitioners fail to explain how this use discloses or suggests UE-specific signaling as claimed. Thus, this backup reliance on Takeda for element 1[f] suffers from a failure of proof.

Ground 2 therefore will likely fail against claim 1, and because the Petition relies entirely on its analysis for element 1[f] to challenge the corresponding claimed features of independent claims 5 and 9, Ground 2 will also likely fail against these claims as well. *See* Pet., 44 (addressing claims 5 and 9).

Ground 4: Petitioners argue that claims 1-12 are unpatentable over Marinier in view of Yan, further in view of R1-1711853. This challenge begins on page 47 of the Petition, and continues through page 65. The operative portion of the Petition for the purpose of this shortcoming occurs at pages 56-57.

According to Petitioners, Marinier discloses “the WTRU may be preconfigured and/or receive RRC signaling that configures one or more parameters that the WTRU should apply for transmission to a second serving site.” Pet., 57; Marinier, [0186]. However, Marinier does not disclose that the “transmission to a second serving site” in this sentence is referring to the transmission of UL control information, as required by the claim, because Marinier does not disclose the nature of the transmission, or the identity of the “second serving site.” Thus, Petitioners’ use of this selected sound bite does not address every claimed feature sufficient to render the challenged claim obvious.

As a backup to Marinier, Petitioners again rely upon their analysis based on Yan in Ground 1 to address element 1[f]. Pet., 57. This is incorrect for the reasons already discussed above.

Ground 4 therefore will likely fail against claim 1, and because the Petition relies entirely on its analysis for element 1[f] to challenge the corresponding claimed features of independent claims 5 and 9, Ground 4 also will likely fail against these claims as well. *See* Pet., 62 (addressing element 5[d] and claim 9 in full).

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.

IPR2025-00084 Patent Owner's Preliminary Response

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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 6,327 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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