

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.

KT Corporation (Patent Owner) and Pegasus Wireless Innovation LLC
(Exclusive Licensee)
Patent Owner

Case: IPR2025-00084

U.S. Patent No. 11,219,000

**PETITIONERS' BRIEF ADDRESSING THE DISMISSAL OF SIX CLAIMS
OF U.S. PATENT NO. 11,219,000 FROM THE PARALLEL DISTRICT
COURT LITIGATION**

On April 11, 2025, Petitioner filed a reply to the POPR. On April 24, 2025, Patent Owner (“PO”) notified Petitioners that it was withdrawing claims 2-3, 6-7, and 10-11 of the ’000 patent in the parallel litigation. On April 25, 2025, PO filed its Preliminary Sur-Reply. Petitioners submit this paper to address the effect of PO’s withdrawal of ’000 patent claims on discretionary denial.

Factor 3 (Investment): There will be None with Respect to Ground 3

There will be no investment in the district court with respect to at least Ground 3. This strongly favors institution. Petitioners promptly prepared and filed the petition once it became apparent that Google, a non-party to the parallel litigation, would be a named petitioner and RPI in this IPR.

Factor 4 (Overlap of Issues): The District Court will Never Consider Ground 3 or Numerous Challenged Claims

The district court will not consider all of the invalidity grounds presented in the Petition, including Ground 3, which only addresses the dismissed claims (Petitioners submitted a *Sotera* stipulation and noted the absence of system art contentions (*see* Paper 12)). The district court will not consider challenged claims 2-3, 6-7, and 10-11 at all, also favoring institution. *See Samsung Elec. Co., Ltd. v. Dynamics, Inc.*, IPR2020-00502, Paper 34 at 12 (PTAB Aug. 12, 2020).

Factor 5 (Overlap of Parties): Google is not a Party to the District Court

Google is not a party to the litigation, and therefore Google did not participate in the discussions regarding the withdrawal of the claims. This underscores the lack

of overlap among the parties and favors institution.

Factor 6 (Other Considerations): Judicial efficiency weighs in favor of institution

The Petition presents a compelling case that the dismissed claims are invalid under several grounds, including Ground 3 which challenges only the validity of dismissed claims. PO also opted to withdraw *all* the claims of the parent Patent No. 10,638,463 challenged in IPR2025-00083. The dismissed dependent claims of the '000 patent include all of the limitations of the independent claims of the '463 patent.

There is *no* basis for discretionary denial of the '463 IPR in light of PO's withdrawal of the '463 patent from the litigation. *ETN Capital, LLC d/b/a Beech Lane v. FBA Operating Co.*, IPR2024-01445, Paper 14 at 11 (P.T.A.B. Feb. 28, 2025). *See also* PTAB Consolidated Trial Practice Guide (Nov. 2019) at p. 58. The claims of the '000 patent overlap with those of the '463 patent, such that a judgment on the validity of the '463 patent claims would be directly applicable to the validity of the '000 patent claims. The grounds in this IPR and the '463 IPR are based on the same references. In the interest of judicial efficiency, the Board should institute the present IPR so that the parties may resolve validity of the '463 and '000 patents in parallel, particularly given the overlap in claimed subject matter and prior art noted above. Judicial efficiency tilts Factor 6 strongly in favor of institution.

Some claims of the '000 patent are still asserted in the litigation, and so the withdraw of '000 patent claims is shown by the attached email. Ex. 1043.

Case No. IPR2025-00084

Patent No. 11,219,000

Respectfully submitted,

Date: May 12, 2025

By: / S. Benjamin Pleune /

S. Benjamin Pleune, Reg. No. 52,421

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), the undersigned hereby certifies that a true and correct copy of the above-captioned **Petitioners' Brief Discussing Effects of District Court Dismissal on *Fintiv* Discretionary Denial Factors** was served in its entirety on May 12, 2025, via filing through the Patent Trial and Appeal Case Tracking System (P-TACTS), as well as by delivering copies via electronic mail to the following:

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Date: May 12, 2025

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