

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.,
Petitioner,

v.

PEGASUS WIRELESS INNOVATION LLC,
Patent Owner.

IPR2025-00084
Patent 11,219,000 B2

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

PARVIS, *Administrative Patent Judge*.

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

Ericsson Inc., Nokia of America Corporation, AT&T Services, Inc., Cellco Partnership d/b/a Verizon Wireless, Google LLC, and T-Mobile USA, Inc. (collectively “Petitioner”) filed a petition requesting *inter partes* review of claims 1–12 of U.S. Patent No. 11,219,000 B2 (Ex. 1001, “the ’000 patent”). Paper 7 (“Petition” or “Pet.”). Exclusive Licensee Pegasus Wireless Innovation LLC (hereinafter “Patent Owner”) timely filed a preliminary response. Paper 11 (“Preliminary Response” or “Prelim. Resp.”). With our authorization, Petitioner filed a preliminary reply (Paper 12, “Preliminary Reply” or “Prelim. Reply”) and Patent Owner filed a preliminary sur-reply (Paper 13, “Preliminary Sur-reply” or “Prelim. Sur-reply”).

On May 6, 2025, the parties sent an e-mail to update us that the parties agreed to dismiss certain patents from the related district court proceedings identified below in Section I.B. Ex. 1041. We authorized additional briefing and the filing of the dismissal and related e-mails as exhibits. Ex. 1041. Patent Owner and Petitioner each filed a Supplemental Brief addressing the impact of the dismissal on the parties’ arguments regarding discretionary denial in the instant proceeding. Paper 14 (PO Supp. Br.); Paper 16 (Pet. Supp. Br.). The ’000 patent is not identified among those patents in the Joint Motion to Dismiss filed in the related district court proceedings. Ex. 1042. Petitioner, however, submitted Exhibit 1043, which is an e-mail indicating that Patent Owner withdrew claims 2, 3, 6, 7, 10, and 11 of the ’000 patent from the related district court proceedings.

Institution of *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314.

Institution of *inter partes* review, however, is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). We have authority to determine whether to institute review under 37 C.F.R. § 42.4. For the reasons provided below, we exercise discretion to deny institution of *inter partes* review.

I. BACKGROUND

A. Real Parties in Interest

Petitioner states:

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

Pet. 74. Patent Owner states that “[t]he real parties-in-interest for this proceeding include: Patent Owner^[1], Pegasus Wireless Innovation LLC.”

Paper 8.

B. Related Matters

The parties indicate that the ’000 patent is the subject of:

Pegasus Wireless Innovation LLC. v. Verizon Communications Inc., No. 2:23-cv-00640 (E.D. Tex.) (“parallel district court proceeding”);

¹ Pegasus Wireless Innovation LLC is the exclusive licensee. *See* Reel 065219, Frame 0144 (recorded exclusive license). Under the license, Pegasus is granted, *inter alia*, “any and all other substantial right to and in the Patents necessary and sufficient under any applicable law or precedent to confer standing to Assignee and permit Assignee to initiate any actions on its own.” *Id.*

Pegasus Wireless Innovation LLC. v. AT&T Inc. et al., No. 2:23-cv-00638 (E.D. Tex.) (“AT&T Case”); and

Pegasus Wireless Innovation LLC. v. T-Mobile US, Inc. et al., No. 2:23-cv-00639 (E.D. Tex.) (“T-Mobile Case”).

See Pet. 75 (citing Ex. 1030); Paper 8, 1. Petitioner indicates the AT&T case and T-Mobile case have been consolidated into the parallel district court proceeding for all pre-trial issues. *See id.*

Patent Owner identifies the following petitions for *inter partes* review involving the patents that are at issue in the above-listed district court proceedings: IPR2025-00036, IPR2025-00037, IPR2025-00083, IPR2025-00137, IPR2025-00138, IPR2025-00290, IPR2025-00291, IPR2025-00292, IPR2025-00293, and IPR2025-00317. Prelim. Resp. 18–19.

C. The '000 Patent

The '000 patent is titled “Apparatus and Method of Uplink Control Channel Resource Allocation for New Radio.” Ex. 1001, code (54). The '000 patent relates to allocating “an uplink control channel resource in a next-generating/5G radio access network (hereinafter, referred to as a new radio (NR)).” *Id.* at 1:26–29. The '000 patent describes that “the 3rd generation partnership project (3GPP)” and, in particular, the “Radio Access Network Working Group 1 (RAN WG1)” studies “5G radio access technology” including “frame structures, channel coding and modulation, waveforms, multiple access methods, and the like for a new radio (NR).” *Id.* at 1:33–40. The '000 patent describes “a need to develop a method for enabling a user device to transmit an uplink channel, such as an uplink control channel and an uplink data channel, to a base station based on a bandwidth part (BWP) when the user device uses various BWPs in NR.” *Id.* at 1:52–56.

The '000 patent describes configuring “one or more bandwidth parts (BWPs) constituting bandwidths obtained by subdividing an NR CC [component carrier].” *Id.* at 7:13–14. Figure 3B of the '000 patent is a diagram illustrating configuring physical uplink (UL) control channel (PUCCH) resources. *Id.* at 3:1–3, 10:5–14.

FIG. 3B

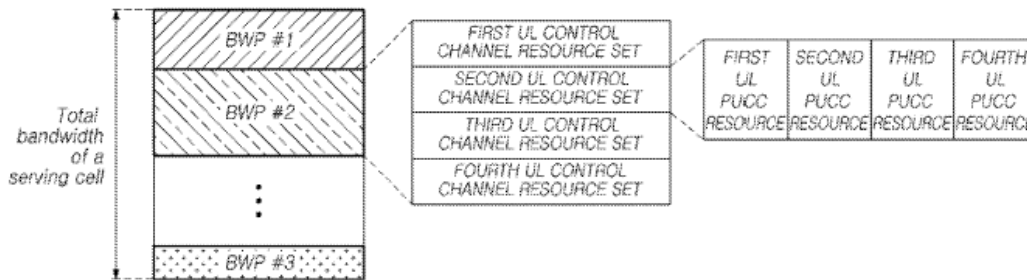


Figure 3B, above, is a diagram “illustrating i) PUCCH resource sets configuring each of N BWPs and ii) PUCCH resources configuring each PUCCH resource set.” *Id.* at 3:1–3. Figure 3B above shows non-overlapping UL BWP #1, BWP #2, and BWP #3 configured for user equipment (UE) from the “[t]otal bandwidth of a serving cell.” *Id.* at 10:5–11, Fig. 3B. As shown in Figure 3B, a base station (BS) configures first to fourth PUCCH resource sets for BWP #2. *Id.* at 10:12–14. The '000 patent describes that “each PUCCH resource may be defined as PUCCH format configuration information, time/frequency domain PUCCH resource configuration information (or additionally code domain resource configuration information) in the UL BWP.” *Id.* at 10:17–21. As shown in Figure 3B, the

“second PUCCH resource set” is “configured by a first to fourth PUCCH resources.” *Id.* at 10:22–24.

D. Illustrative Claim

Petitioner challenges claims 1–12 of the ’000 patent. Pet. 1. Of the challenged claims, claims 1, 5, and 9 are independent. Claims 2–4 depend, directly or indirectly, from claim 1; claims 6–8 depend, directly or indirectly, from claim 5; and claims 10–12 depend, directly or indirectly, from claim 9. Claim 1 is illustrative of the challenged claims and recites:

1. [1[pre]] A method of transmitting uplink (UL) control information by a user equipment, the method comprising:

[1[a]] receiving, from a base station, UL control channel resource set configuration information for UL control information transmission;

[1[b]] determining one of UL control channel resource sets contained in the received UL control channel resource set configuration information;

[1[c]] determining one of UL control channel resources contained in the determined UL control channel resource set; and

[1[d]] transmitting UL control information through the determined UL control channel resource;

[1[e]] wherein the determining of the one of the UL control channel resource sets is performed based on a size of the UL control information, and

[1[f]] wherein the UL control channel resource set configuration information is received through UE specific radio resource control (RRC) signaling.

Ex. 1001, 21:10–28.²

² Throughout our Decision we use Petitioner’s designations for the elements of the challenged claims. *See, e.g.*, Pet. 19–35 (designations for claim 1).

E. Evidence

Petitioner relies on the following patent evidence.

Name	Patent Document	Exhibit
Takeda	WO 2019/030929 A1	1007 ³
Yan	U.S. Patent No. 10,736,085 B2	1010
Marinier	US 2014/0056278 A1	1011

Petitioner also relies on 3GPP R1-1711853 (Exhibit 1012), which Petitioner argues is “a technical contribution submitted to the 3GPP TSG RAN WG1, NR AH 1706 meeting that was held between June 27–30, 2017. Pet. 9 (citing Exhibit 1017). Petitioner submits the Declaration of Mr. Craig Bishop (Ex. 1017) in support of its position that 3GPP R1-1711853 “became a ‘printed publication’ under 35 U.S.C. § 102 on June 29, 2017.” Pet. 9 (citing Ex. 1017).

Petitioner also relies on the testimony of Dr. Sumit Roy. Ex. 1002.

F. Asserted Grounds

Petitioner asserts that the challenged claims would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. § ⁴	Reference(s)/Basis
1, 4, 5, 8, 9, 12	103	Yan
1–12	103	Takeda, Yan
2, 3, 6, 7, 10, 11	103	Yan, 3GPP R1-1711853
1–12	103	Marinier, Yan, 3GPP R1-1711853

³ Exhibit 1007 is a certified translation of Exhibit 1006. Herein, we refer to Exhibit 1007.

⁴ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the challenged claims of the ’000 patent have an apparent effective filing date after March 16, 2013, the AIA version of § 103 applies. Our determinations and findings herein would not change if the pre-AIA provisions applied.

II. DISCRETION TO DENY INSTITUTION

Patent Owner contends the Board should exercise discretion to deny institution under 35 U.S.C. § 314, citing the six factors articulated in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). *See generally* Prelim. Resp.; Prelim. Sur-reply; PO Supp. Br. Petitioner disagrees and presents a stipulation similar to the stipulation presented in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (“*Sotera*”). *See* Pet. 68–72; Prelim. Reply 3; Pet. Supp. Br.

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

The Board may, in the interest of fairness and the efficient use of Board resources, deny institution under § 314(a) where there are parallel district court proceedings involving the same or substantially the same parties and invalidity challenges. *Fintiv*, Paper 11 at 5–6, 12–13. In *NHK Spring Co. v. Intri-Plex Technologies, Inc.*, the Board denied institution relying in part on § 314(a) because the parallel district court proceeding was scheduled to finish before the Board reached a final decision. IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential). Following *NHK*, the Board in *Fintiv* articulated the following factors for consideration

when determining whether to exercise discretion to deny institution in view of a parallel proceeding:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

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

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

⁵ Available at

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

with Parallel District Court Litigation” (“Chief Judge Memo”).⁶ According to the Chief Judge Memo, the purpose of the recission was “to restore policy . . . to the guidance in place before the Interim Procedure, including the precedential decisions in [*Fintiv*] and [*Sotera*].” Chief Judge Memo 1. Subsequently, on March 26, 2025, the Acting Director of the USPTO issued a memorandum titled “Interim Processes for PTAB Workload Management” (“Acting Director Memo”).⁷ The new processes outlined in the Acting Director Memo do not apply to this proceeding because the deadline for the filing a preliminary response has already passed. *See* Acting Director Memo 3.

We address each of the *Fintiv* factors below.

A. First Factor: Whether the Court Granted a Stay

The parties agree that no party has moved for a stay of the parallel district court proceeding. *See, e.g.*, Prelim. Resp. 3, Prelim. Reply 1; Prelim. Sur-reply. Patent Owner argues that a stay “would be unprecedented” because the “institution decision in this case is due about three months before the scheduled trial date (September 8, 2025).” Prelim. Sur-reply 1.

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

⁶ *Available at*

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

⁷ *Available at*

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

B. Second Factor: Proximity of Trial Date

Patent Owner asserts that the second *Fintiv* factor weighs heavily in favor of discretionary denial because trial in the parallel district court proceeding is scheduled to begin September 8, 2025, nearly nine months before a final written decision would be expected on or about June 9, 2026. *See* Prelim. Resp. 4 (citing Ex. 1039, 2).⁸ Patent Owner further indicates that the December 2024 statistics for the median time-to-trial in the Eastern District of Texas show a period of 23.0 months which, according to Patent Owner are “consistent with the September 2025 trial date set out in Judge Gilstrap’s Docket Control Order.” *Id.* at 6 (citing Ex. 2003); *see also* Chief Judge Memo 3 (“[T]he Board may consider any evidence that the parties make of record that bears on the proximity of the district court’s trial date . . . including median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides.”).

Petitioner contends that the second *Fintiv* factor “should be considered at least neutral because jury selection is far in the future and is not set to begin until at least September 8, 2025,” and “would proceed with respect to only one of the three [district court proceedings].” Pet. 69; *see* Prelim. Reply 1 (similar argument regarding three district court proceedings). Petitioner also asserts that “only one of three trials” in the district court is scheduled and disputes Patent Owner’s median-time-to-trial statistics, arguing “the district court has significantly delayed multiple scheduled trial dates, and has an average of 29 months to trial.” Prelim. Resp. 1–2 (citations omitted).

⁸ Patent Owner cites Exhibit 1014, but the correct citation appears to be Exhibit 1039. We treat Patent Owner’s error as a harmless typographical error.

Patent Owner responds that “*Fintiv* factor 2 weighs in favor of denying institution because the district court’s scheduled trial is set for September 8, 2025, roughly ten months before the June 9, 2026 date expected for a final written decision.” Prelim. Sur-reply 1. Patent Owner also argues that “Petitioners fail to explain why the earliest trial will not be able to fully resolve all pending validity issues surrounding the ’000 patent, including the challenges that cannot be raised in this IPR.” *Id.* Patent Owner also argues “all three cases are consolidated for all pre-trial purposes and therefore will be on equal procedural footing when the first trial begins on September 8, 2025.” *Id.* at 1–2. Patent Owner also argues Petitioner’s argument that the trial date may change “is founded entirely on speculation.” *Id.* at 3.

In the most recent briefing by the parties filed May 12, 2025, neither party indicates that the trial date of September 8, 2025 has changed. *See generally* PO Supp. Br.; Pet. Supp. Br. Indeed, Patent Owner argues “Patent Owner’s decision to narrow the asserted claims from the ’000 patent during expert discovery reveals just how far along the co-pending litigation is, with trial scheduled to proceed on September 8, 2025.” PO Supp. Br. 2. Petitioner does not argue that the narrowing of asserted claims of the ’000 patent impacts the trial date. *See generally* Pet. Supp. Br.

With respect to *Fintiv* factor 2, we consider “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written.” The trial is scheduled for September 8, 2025. Ex. 1039, 2; Ex. 2204, 1. Also, the three related district court proceedings are consolidated for pre-trial purposes. Ex. 1030; Prelim. Sur-reply 1–2.

We are not swayed by Petitioner’s speculation as to the trial date for the parallel district court proceeding, nor by Petitioner’s arguments

regarding trial dates for the other two district court proceedings. Due to the actual trial date of the parallel district court proceeding having been set to occur nine months before an expected final written decision in this proceeding, as well as a projected trial date based on time-to-trial statistics of more than five months before an expected final written decision, we determine that the considerations of the second *Fintiv* factor weigh in favor of exercising discretion to deny institution of *inter partes* review.

C. Third Factor: Investment in the Parallel Proceeding

Patent Owner contends that the considerations of the third *Fintiv* factor favor denial of institution because the district court and the parties will have expended considerable resources in the parallel district court proceeding, including on the merits of Petitioner's invalidity positions. *See* Prelim. Resp. 9. Patent Owner contends that by the time of the projected institution decision, fact discovery is to be completed on April 14, 2025, and Petitioner and Patent Owner will be required to serve their expert witness disclosures relating to the invalidity contentions by April 21, 2025. *See id.* at 11. Patent Owner asserts that by the date of the institution decision in this proceeding, Petitioner and Patent Owner will have exchanged preliminary claim constructions, prepared a joint claim construction statement, completed claim construction discovery, and served claim construction briefing, and a claim construction hearing will have been held on March 11, 2025. *See id.* at 12. Patent Owner contends that the investment in the parallel district court proceeding favors denial of institution. *See id.* at 11–12.

Patent Owner further asserts that Petitioner delayed filing this Petition until December 9, 2024, which was eight months after Petitioner was served infringement contentions on March 18, 2024, and five months after Petitioner served their invalidity contentions on May 17, 2024. *See* Prelim.

Resp. 9–10. According to Patent Owner, “Petitioner[] provide[s] no justification for the delay in filing their Petition,” which the Board has found weighs in favor of denial of institution. *Id.* at 10 (citations omitted).

“[N]otwithstanding that a defendant has one year to file a petition, it may impose unfair costs to a patent owner if the petitioner, faced with the prospect of a looming trial date, waits until the district court trial has progressed significantly before filing a petition.” *Fintiv*, IPR2020-00019, Paper 11, 11–12.

Petitioner contends that the district court will not invest significant resources related to the challenged patent prior to the issuance of the institution decision. *See* Pet. 70–71 (citing *Fintiv*, Paper 11 at 9–12; *Dish Network*, IPR2020-01280, Paper 17 at 18–21); Prelim. Reply 2–3 (similar argument that much work is still to be done in the district court case).

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

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

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

Patent Owner contends that the considerations of the fourth *Fintiv* factor weigh in favor of denying institution because there is substantial

overlap between the claims, arguments, and evidence raised in the Petition and the invalidity contentions in the parallel district court proceeding. *See* Prelim. Resp. 13. According to Patent Owner, similar to the unpatentability challenges here, Petitioner’s invalidity contentions present challenges based on Yan, Takeda, and Marinier alone and in combination with other references. *Id.* at 14 (citing Ex. 2004, 1, 8, 16–17; Ex. 2025, (Appx. G); Ex. Ex. 2026 (Ex. G-9) (Yan); Ex. 2027 (Ex. G-8) (Takeda/Takeda III); Ex. 2028 (Ex. G-3)).

In the Preliminary Reply, Petitioner provides the following stipulation:

To mitigate any duplication concerns, if this IPR is instituted, Defendants will not pursue in District Court litigation the specific grounds asserted in this proceeding, or any other ground that was raised or could have been reasonably raised in an IPR.

Prelim. Reply 3 (citing *Sotera; BMW of No. Am., LLC. v. Northstar Sys. LLC*, IPR2023-01017, Paper 12 at 10 (PTAB Dec. 8, 2023)). Petitioner also argues that “Defendants have *not* proffered any invalidity contentions based on unpublished system prior art.” Prelim. Reply 2. Petitioner also argues that due to Patent Owner’s narrowing the claims for trial, the District Court will not consider invalidity with respect to claims 2, 3, 6, 7, 10, and 11 or Ground 3 in the Petition, which addresses only those claims. Pet. Supp. Br. 1.

Patent Owner argues “[t]he limited narrowing of claims does not change the outcome of the *Fintiv* analysis.” PO Supp. Br. 1. Patent Owner argues that the Board need not decide “validity of patent claims that have been dropped from the co-pending litigation, particularly where a *Fintiv* denial is appropriate and warranted for the patents and claims that remain in

the litigation, including claims 1, 4, 5, 8, 9, and 12 of the '000 patent.” *Id.* at 1–2.

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

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

Patent Owner contends Petitioner is the defendant in the parallel district court proceeding and that this factor weighs in favor of discretionary denial. *See* Prelim. Resp. 17 (citing *Samsung Elec. Co. v. Clear Imaging Res., LLC*, IPR2020-01401, Paper 12 at 21–22 (PTAB Feb. 17, 2021)). Petitioner asserts that this factor is neutral. *See* Pet. 71 (citing *Sand Revolution*, Paper 24 at 12–13). Petitioner also contends that “Google, Inc. is not a party to any trial” and, therefore, “at least one Petitioner will *never* have a trial date in the parallel litigation.” Prelim. Reply 1 (citations omitted); Pet. Supp. Br. 1–2. Patent Owner responds that the addition of Google as a co-Petitioner does not change that this proceeding and the parallel district court proceeding involve the same parties.

Because of the involvement of a non-defendant, we determine the considerations of the fifth *Fintiv* factor are neutral.

F. Sixth Factor: Other Circumstances, Including the Merits

Patent Owner asserts that the considerations of the sixth *Fintiv* factor weigh in favor of discretionary denial for two reasons: (1) the Petition has

“substantive defects” and the merits are “weak”; and (2) the “global dispute” regarding the challenged patents was made more complex by Petitioner’s filing of petitions in “a piecemeal fashion” on “a slow-rolling basis.” Prelim. Resp. 18–28. Petitioner asserts that this factor weighs strongly against discretionary denial because the merits of the Petition are strong and none of the grounds of unpatentability asserted in the Petition were previously considered. *See* Pet. 72 (citing *Comcast Cable Comm’n’s, LLC v. Rovi Guides, Inc.*, IPR2019-00231, Paper 14 at 11 (PTAB May 20, 2019)).

Regarding the first reason, Patent Owner argues that Petitioner has not shown that the asserted prior art combinations teach “wherein the UL control channel resource set configuration information is received through UE specific radio resource control (RRC) signaling,” which is designated by Petitioner as element 1[f]. *Id.* at 21. Patent Owner relies on attorney argument regarding the testimony of Dr. Roy and the disclosures in the asserted prior art references. *Id.* at 21–28. Based on the current record, we find that Yan teaches “receiving, by the terminal device, configuration information of the N channel resource sets from the access network device by using higher layer signaling.” Ex. 1010, 19:8–11. Takeda teaches that the “user terminal may receive” configuration information “using higher layer signaling” including “for example, RRC signaling.” Ex. 1007 ¶ 100. Marinier teaches configuring “using higher layer signaling (e.g., RRC signaling).” Ex. 1011 ¶ 98. We find that Petitioner’s second ground of asserted obviousness of claims 1–12 over Takeda and Yan is strong in other respects. We also find that Petitioner provides sufficient rationale for making its proposed combination of Yan and Takeda for purposes of institution. Pet. 25–30.

Regarding the second reason, Patent Owner, more specifically, asserts that the dispute between the parties involves three complaints involving eleven patents filed in the district court on a single day, but Petitioner filed eleven IPR challenges “over the period from October 18 to December 31, 2024.” Prelim Resp. 18. According to Patent Owner, this proceeding “is one of at least eleven decisions on institution the Board will need to make” and “the Board will approach the decisions serially.” *Id.* at 19. In contrast, “the district court has already consolidated the district court proceedings for ‘all pretrial issues.’” *Id.* at 20.

Petitioner argues that “[t]here is *no* basis for discretionary denial” of IPR2025-00083 “in light of PO’s withdrawal of the ’463 patent from the litigation,” and the “claims of the ’000 patent overlap with those of the ’463 patent” and “the Board should institute the present IPR so that the parties may resolve validity of the ’463 and ’000 patents in parallel.” Pet. Supp. Br. 2.

On this record, we find persuasive Patent Owner’s arguments that Petitioner did not file its petitions expeditiously and did not explain the delay in filing its petitions. Also, Petitioner has not explained filing petitions over the time frame from October 18 to December 31, 2024.

We determine that the strength of the merits of Petitioner’s patentability challenges based on the combination of Takeda and Yan weighs against exercising discretion to deny institution of *inter partes* review. However, we determine that resolution of all of the disputes based on all of the issues between the parties regarding the challenged patent before the district court, which likely would occur many months before the unpatentability issues would be resolved before the Board, would be more efficient and, therefore, weighs in favor of exercising discretion to deny

institution of *inter partes* review. In sum, we determine that the strength of the merits is obviated by the efficiency and timeliness of the parallel district court proceeding and, therefore, determine that considerations of the sixth *Fintiv* factor are neutral.

G. Conclusion

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

III. CONCLUSION

For the foregoing reasons, we exercise discretion under 35 U.S.C. § 314(a) to deny institution of *inter partes* review.

IV. ORDER

In consideration of the foregoing, it is hereby:

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

IPR2025-00084
Patent 11,219,000 B2

FOR PETITIONER:

S. Benjamin Pleune
Ross R. Barton
J. Ravindra Fernando
Bennett M. Hardyman
Christopher TL Douglas
Matthew M. Turk
David S. Frist
Daniel J. O'Connor
ALSTON & BIRD LLP
ben.pleune@alston.com
ross.barton@alston.com
ravi.fernando@alston.com
bennett.hardyman@alston.com
christopher.douglas@alston.com
matthew.turk@alston.com
david.frist@alston.com
dan.oconnor@alston.com

Patrick C. Keane
Roger H. Lee
Andrew J. Koopman
Tanya S. Gaylord
BUCHANAN INGERSOLL & ROONEY PC
patrick.keane@bipc.com
roger.lee@bipc.com
andrew.koopman@bipc.com
tanya.gaylord@bipc.com

PATENT OWNER:

Wayne M. Helge
James T. Wilson
BUNSOW DE MORY LLP
whelge@bdiplaw.com
jwilson@bdiplaw.com