

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

REQUEST FOR DIRECTOR REVIEW

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Patent Trial and Appeal Board
US Patent and Trademark Office
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TABLE OF CONTENTS

I.	LEGAL STANDARDS	3
II.	ARGUMENT.....	4
	A. The Board erred in its evaluation of the <i>Fintiv</i> factors.	5
	B. Efficiency and fairness weigh in favor of institution.	8
	C. Compelling economic interests require institution.....	11

LIST OF EXHIBITS

Exhibit	Short Name	Description
Ex. 1001	'000 Patent	U.S. Patent No. 11,219,000
Ex. 1002	Declaration	Declaration of Dr. Sumit Roy
Ex. 1003	CV	<i>Curriculum Vitae</i> of Dr. Sumit Roy
Ex. 1004	'000 File History	File History of U.S. Patent No. 11,219,000
Ex. 1005		Reserved
Ex. 1006	Takeda	International Publication No. WO 2019/030929 A1
Ex. 1007	Certified Translation of Takeda	Certified Translation of International Publication No. WO 2019/030929 A1
Ex. 1008	Yan- PCT	International Publication No. WO 2017/024554 A1
Ex. 1009	Certified Translation of Yan- PCT	Certified Translation of International Publication No. WO 2017/024554 A1
Ex. 1010	Yan- U.S. Patent	U.S. Patent No. 10,736,085 B2
Ex. 1011	Marinier	U.S. Patent Application Publication No. US 2014/0056278 A1
Ex. 1012	R1-1711853	Activation/deactivation of bandwidth part
Ex. 1013		Reserved
Ex. 1014	Hooli	U.S. Patent Application Publication No. US 2018/0324786 A1
Ex. 1015	Yiu	U.S. Patent Application Publication No. US 2019/0044689 A1
Ex. 1016	Ahn	U.S. Patent Application Publication No. US 2019/0268123 A1
Ex. 1017	Bishop Declaration	Declaration of Craig Bishop

Exhibit	Short Name	Description
Ex. 1018	21.905 V12.0.0	3GPP Technical Specification 21.905 V12.0.0 (2013-06)
Ex. 1019	21.905 V14.1.1	3GPP Technical Specification 21.905 V.14.1.1 (2017-06)
Ex. 1020	Yang	U.S. Patent Application Publication No. US 2019/239214 A1
Ex. 1021	Takeda '856	U.S. Patent No. 11,265,856
Ex. 1022	Takeda '073	U.S. Patent No. 11,160,073
Ex. 1023	Zhang	International Publication NO. WO 2018/227538 A1
Ex. 1024	Li	U.S. Patent Application Publication NO. US 2016/0338041 A1
Ex. 1025	Ahn '664	U.S. Patent No. 10,305,664
Ex. 1026	Shaheen	U.S. Patent No. 10,805,941
Ex. 1027	'000 Claim Chart	U.S. Patent No. 11,219,000 Claim Chart
Ex. 1028	Order modifying deadlines	Order modifying case deadlines for D. Ct. Case Nos. 2:23-cv-00640-JRG, 2:23-cv-00638-JRG, and 2:23-cv-00639-JRG
Ex. 1029	First amended docket control order	First Amended Docket Control Order for D. Ct. Case Nos. 2:23-cv-00640-JRG, 2:23-cv-00638-JRG, and 2:23-cv-00639-JRG
Ex. 1030	Consolidation order	Order consolidating D. Ct. Case Nos. 2:23-cv-00640-JRG, 2:23-cv-00638-JRG, and 2:23-cv-00639-JRG for pretrial issues
Ex. 1031	Andrews	Jeffrey G. Andrews, <i>et al.</i> , "What Will 5G Be?" <i>IEEE Journal on Selected Areas in Communications</i> , Vol. 32, No. 6 (June 2014)
Ex. 1032	Oh	U.S. Patent No. 10,980,007
Ex. 1033	Wilson	U.S. Patent No. 10,588,143

Exhibit	Short Name	Description
Ex. 1034	Ratasuk	Repeepat Ratasuk, <i>et al.</i> , “Carrier Aggregation and Dual Connectivity,” Mobile Radio Research Lab, Nokia Bell Labs (2017)
Ex. 1035	Silva	Icaro Da Silva, <i>et al.</i> , “Tight integration of new 5G air interface and LTE to fulfill 5G requirements” <i>IEEE</i> (2015)
Ex. 1036	Marsch	Patrick Marsch, <i>et al.</i> , “5G Radio Access Network Architecture: Design Guidelines and Key Considerations” <i>IEEE Communications Magazine</i> (November 2016)
Ex. 1037	ATIS	ATIS.3GPP.37.863-01-01.V1540
Ex. 1038	Protective order	<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.) Protective Order from Non-Jurisdictional Discovery
Ex. 1039	Fourth amended docket control order	Fourth Amended Docket Control Order for D. Ct. Case Nos. 2:23-cv-00640-JRG, 2:23-cv-00638-JRG, and 2:23-cv-00639-JRG
Ex. 1040	Opposition to Order Focusing Claims	<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.) Pegasus Wireless Innovation LLC’s Surreply in Opposition to Defendants and Intervenor’s Motion for Entry of an Order Focusing Asserted Patent Claims and Prior Art
Ex. 1041	Email authorizing submission of District Court Dismissal	Email from Patent Trial and Appeal Board to Parties (May 7, 2025).
Ex. 1042	Dismissal of certain patents from District	<i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-

Exhibit	Short Name	Description
	Court	00639 (E.D. Tex.) Joint Motion to Dismiss Infringement Allegations and Non-Infringement and Invalidity Counterclaims with Respect to U.S. Patent Nos. 10,594,460; 10,638,463; 10,721,118; and 11,405,942
Ex. 1043	Email from Patent Owner withdrawing claims	Email from Jordan Rux (April 24, 2025).

AT&T Services, Inc., Cellco Partnership d/b/a Verizon Wireless, Google LLC and T-Mobile, USA, Inc., (collectively “Petitioners”) submit this Request for Director Review of the Institution Decision (Paper 17, “ID”). The Board improperly discretionarily denied the Petition even though factors of fairness, efficiency, and patent quality weigh in favor of institution.

The Acting Director’s decision to deny institution overlooks material facts that weigh strongly in favor of institution. In this case, Petitioners selected the PTAB as the proper and appropriate forum to review bad patent claims that the USPTO originally granted. Considering the relevant discretionary denial factors and legal principles of due process and proper APA notice, the present facts weighs in favor of institution.

In this case, PO dismissed claims from the parallel litigation without prejudice after expiration of the one year statutory bar period. Because the district court will not review many of the ’000 patent claims, the PTAB is the most appropriate venue to challenge validity based on written prior art. There is no recognition of PO’s dismissal without prejudice following expiration of the one year statutory bar in the Acting Director’s decision denying institution.

Moreover, the decision to deny institution was based in part on a retroactive reversal of prior Board guidelines that a petitioner could use a *Sotera* stipulation to eliminate overlapping prior art-based issues from parallel litigation. Here,

Petitioners did not receive proper notice of this change in PTAB policy, which was changed after Petitioners filed their IPR Petition but before the PTAB decided to discretionarily deny. Thus, the PTAB should not apply this policy change to the present proceeding, in accordance with due process and APA notice requirements.¹

¹ See, e.g., *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 275 (2016)

(USPTO action outside statutory limits “may be properly reviewable ... under the Administrative Procedure Act, which enables reviewing courts to ‘set aside agency action’ that is ‘contrary to constitutional right,’ ‘in excess of statutory jurisdiction,’ or ‘arbitrary [and] capricious.’”); see also *id.* (“due process problem” may justify judicial review); *Mexichem Fluor, Inc. v. EPA*, 866 F.3d 451, 462 (D.C. Cir. 2017) (“To satisfy the Due Process Clause, [an agency] must at a minimum ‘provide regulated parties fair warning of the conduct a regulation prohibits or requires.’”). Other parties have sought relief at the Federal Circuit. See Petition for Writ of Mandamus, *In re SAP America, Inc.*, No. 25-133 (Fed. Cir. June 13, 2025); Petition for Writ of Mandamus, *In re Motorola Solutions, Inc.*, No. 25-134 (Fed. Cir. June 23, 2025).

Petitioners relied on the *Sotera* stipulation in this case to invoke the authority of the PTAB to review patent claims dismissed from the District Court litigation without prejudice. Because the one year statutory bar applies to the named Petitioners, who remain interested in the review of *all* of the claims of the '000 patent in light of the district court dismissal without prejudice, the present IPR should be instituted so the USPTO can review the patent in question based on the written prior art presented by Petitioners.

Further, given that the parallel litigation is large and complex covering different technologies and multiple defendants scheduled for separate trials, it would be challenging for any district court to closely review patent validity and maintain consistency across the separate trials, making the PTAB the most appropriate forum for assessing validity.”

I. LEGAL STANDARDS

Director review of a Board decision may be warranted when the decision includes “(a) abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.” USPTO Website, Director Review Process. Requests for Director Review must be filed within thirty days of the entry of a decision not to institute a trial. 37 C.F.R. § 42.71(d).

II. ARGUMENT

On June 6, 2025, a Panel denied institution of IPR2025-00084 on purely discretionary grounds, despite the submission of a *Sotera* stipulation, despite PO dismissing several claims from the co-pending litigation, and despite the Board finding the merits of the Petition to be strong. ID, 14-15, 18. The Panel abused its discretion in denying institution, at least because efficiency and fairness considerations weigh strongly in favor of resolving the '000 Patent's validity at the PTAB in concert with the PTAB's review of the highly similar claims of the related U.S. Patent 10,638,463 ("the '463 Patent"), which is subject to an instituted IPR trial with overlapping grounds/references. *See* IPR2025-00083, Paper 18. Addressing validity of the '000 Patent in parallel with the instituted '463 IPR is a good use of PTAB resources, with agency review of the '000 Patent being the most efficient solution to resolving patent quality questions concerning the '000 Patent—again, particularly in light of the PTAB's institution of trial on very similar claims.

In addition to the Board's mishandling of the *Fintiv* factors, the Board erred because it did not consider the additional compelling economic interests at play in this case. In particular, by denying institution the PTAB elected to prioritize the patent rights of a foreign corporation without any domestic presence over America's telecommunications carriers.

A. The Board erred in its evaluation of the *Fintiv* factors.

The Board erred in its evaluation of the *Fintiv* factors for several reasons. *First*, with respect to *Fintiv* Factor 2, even if trial were to proceed on September 8, 2025, which it likely will not, the first trial would only proceed with respect to one of the three Petitioners. The trials involving the other Petitioners have not yet been scheduled. *See HP Inc., et al. v. Neodron Ltd.*, IPR2020-00459, Paper 17 at 36, 38 (P.T.A.B. Sept. 14, 2020) *see also Google LLC v. Uniloc 2017 LLC*, IPR2020-00441, Paper 13 at 35 (PTAB July 17, 2020) (Institution Decision) (“The fact that no trial date has been set weighs significantly against exercising our discretion to deny institution of the proceeding.”); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 13-14 (PTAB Mar. 20, 2020) (precedential) (“If a petitioner is unrelated to a defendant in an earlier court proceeding, the Board has weighed this fact against exercising discretion to deny institution under *NHK*.”). That the majority of Petitioners do not have a scheduled trial date demonstrates that the Board erred when evaluating *Fintiv* factor 2. As such, *Fintiv* factor 2 weighs in favor of institution.

Second, with respect to Factor 4, Petitioners submitted a *Sotera* stipulation in this case. *See* Paper 12. The *Sotera* stipulation mitigates any concerns regarding duplicative invalidity arguments relating to anticipation and/or obviousness based on patents and printed publications. Defendants have not

proffered any invalidity contentions based on unpublished system prior art.

Motorola Sols., Inc. v. Stellar, LLC, IPR2024-01205, Paper 19 at 4 (P.T.A.B. Mar. 28, 2025); *see also* Ex. 2004. As discussed in greater detail below, PO has further diminished the overlap between the issues raised in the petition and in the parallel proceeding by dismissing several claims of the '000 Patent from the district court litigation without prejudice. The consideration of Factor 4 should not encourage patent owners to assert a patent to trigger the 1-year statutory deadline for filing an IPR, and then withdraw some or all of the patent claims *without prejudice* so that patent owners can decide to reassert those same patent claims later, without risk of a later-filed IPR.

Third, with respect to Factor 6, other factors weigh strongly in favor of institution. The Board found that the merits of the petition are strong: “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.” Paper 17, 18. The strength of similar challenges to the related '463 Patent were sufficient to convince the Board to institute review there (IPR2025-00083, Paper 18), and the same result is appropriate here. The challenges presented in the '000 Patent involve the same art presented in the challenge of the '463 Patent, and the claims of the '463 Patent overlap with the claims of the '000 Patent.

The parallel litigation is large and complex, initially involving 11 patents, covering different technologies and multiple defendants scheduled for separate trials. *See e.g.*, Ex. 2004. Given these complexities, it would be challenging for any district court to closely review the validity of the asserted patents and maintain consistency across the separate trials. PO has already dropped 4 of the 11 asserted patents from the related litigation, and has dropped several patent claims from other patents involved in the litigation (including several claims of the '000 Patent).

PO contends the validity of the patents that are still at issue, such as this one, are the only ones relevant to the global dispute between the parties. *See* IPR2025-00083, Paper 14 at 1 (arguing that because “Patent Owner did not serve an expert infringement report regarding the '463 patent makes the validity of the '463 patent less important to the global dispute between the parties”). PO contends that the '000 patent is important to the global dispute, and yet the district court will never consider the validity of all of the claims of the '000 Patent, leaving Petitioners with uncertainty as to whether PO will separately assert the dropped claims in a later lawsuit (PO’s decision to drop certain patents and claims was *without prejudice*). Under these circumstances, the Board should institute IPR so that Petitioners have certainty as to the validity of *all* of the claims of the '000 Patent. The PTAB is the most appropriate resource to render a

thorough and consistent judgment on patent validity, as certain claims of the '000 Patent are no longer at issue in the parallel litigation.

Instituting an IPR promotes judicial efficiency, fairness, and patent quality. Given the possibility of future litigation involving the '000 Patent, and the fact that PO has not granted Petitioners a covenant not to sue, efficiency considerations counsel that the Board should address the validity of the '000 Patent now as part of the overarching dispute between the parties.

Altogether, the *Fintiv* factors favor institution given the strength of the grounds as confirmed by the instituted '463 Patent IPR on substantially similar claims, the multiple unscheduled trials, and the *Sotera* stipulation. As such, the Board erred when it denied institution of this IPR.

B. Efficiency and fairness weigh in favor of institution.

A proper denial of institution focuses on a *Fintiv* analysis, which examines factors relating 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.*” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (P.T.A.B. Mar. 20, 2020) (emphasis added). Here, several challenged claims of the '000 Patent have been dismissed from the district court litigation without prejudice. Ex. 1042. Therefore, without the present IPR to review the dismissed claims of the '000 Patent, Petitioners will be subject to heightened uncertainty as

to whether PO will decide to later assert the dismissed claims, no matter the outcome in the related district court trials. This fact alone demonstrates that considerations of fairness should weigh in favor of institution.

As discussed above, the Board has already decided to institute review of the related '463 Patent with claims that are highly similar to the claims of the '000 Patent. Since the proposed invalidity grounds for these two related patents are similar, reviewing the '000 in parallel with the '463 Patent will present substantial efficiencies for the Board, while simultaneously addressing the fairness concerns that would arise from forcing Petitioner to rely on a district court's decision as to the validity of only *some* of the claims of the '000 Patent. Even if PO's claimed importance concerning withdrawn claims were taken into account (and it should not be as PO asserted all of these patents in litigation), this fact would weigh in favor of institution so that the Board completes its responsibility to cancel weak, allegedly less important patent claims that PO nonetheless asserted and that Petitioners had been forced to defend against. Importantly, PO has not offered Petitioners a covenant not to sue.

PO has no "settled expectations" concerning this patent which was granted less than 3 years prior to its assertion in the parallel litigation. To the contrary, PO should reasonably expect a challenge of any patent related to an "unimportant" or "bad" patent, as that is the intended design of inter partes

review. *See, e.g., Thryv, Inc. v. Click-to-Call Tech., LP* 590 U.S. 45, 46 (2020)

(“Congress designed inter partes review to weed out bad patent claims

efficiently.”). *See also Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 272

(2016) (the IPR proceeding was initiated to screen out bad patents). As discussed

above, the ’000 Patent is related to the allegedly “unimportant” ’463 Patent, and

the ’463 claims are highly similar to those of the ’000 Patent. **Institution of**

the ’463 IPR—and the PTAB’s determination of a reasonable likelihood of

success challenging highly similar claims—further demonstrates that there

could not have been “settled expectations” concerning ’000 validity. PO—not

Petitioners—started this dispute by asserting its patent, but now only after

Petitioners have gone to the time and expense of filing an IPR challenge (and

demonstrating a reasonable likelihood of success with respect to similar claims),

PO wants a takeback. This cannot be the intent of Section 314(a).

As it stands, with some claims of the ’000 Patent dismissed from the Related Litigation without prejudice, the most expedient path Petitioners have to address the validity of *all* of the claims of the ’000 Patent is to seek the Board’s assistance. Moreover, this is the only opportunity that Petitioners will have to challenge the ’000 Patent in an IPR proceeding because the one-year statutory bar for challenging the ’000 Patent through an IPR has passed, yet PO may still assert the dismissed claims of the ’000 Patent against Petitioners in future

litigation given that the dismissal was without prejudice (PO has not offered Petitioners a covenant not to sue, as noted above). The lingering questions concerning patent quality of the '000 Patent while review of the related and highly similar '463 Patent moves forward at the PTAB cannot be the intended framework under Section 314(a).

Given the Board's expressed goals of efficiency, fairness and the desire to root out weak patents, the Board should deny PO's Request.

C. Compelling economic interests require institution.

While the co-pending litigation has been brought by Pegasus Wireless Innovation LLC, the patent at issue is owned by KT Corp. ("KT")—a Korean telecommunications carrier—that does not have employees or operations in the United States and is actively resisting the ability of the United States District Court for the Eastern District of Texas to exercise jurisdiction over it. *Pegasus Wireless Innovation LLC v. Cellco Partnership d/b/a Verizon Wireless et al.*, No. 2:23-cv-00640-JRG Dkt. 206 (E.D. Tex. Jan. 17, 2025). Rather than bringing suit itself, KT granted Pegasus Wireless Innovation LLC an exclusive license that would allow Pegasus to try and extract massive licensing fees from the Petitioners while KT remained out of reach of the United States legal system.

This is the wrong fact pattern for a discretionary denial: it is a clear-cut case of a foreign company targeting domestic companies using the US patent and

legal systems. If successful, the efforts of KT and Pegasus will impact jobs and salaries in the United States. The carrier Petitioners employ hundreds of thousands of Americans across the country and provide network and connectivity solutions to hundreds of millions of Americans as well as the Federal Government. The carrier Petitioners operate in all 50 states and pay billions of dollars in taxes every single year to the Federal Government.

In addition, the timing of the discretionary denial is not equitable. The Complaints in the cases against the Petitioners were served on January 3, 2024. After sifting through voluminous infringement contentions that were not received until March 18, 2024, and performing prior art searching, the Petitioners filed an IPR challenge on November 15, 2024. After receiving KT's POPR on March 10, 2025, Petitioners filed a *Sotera* stipulation on April 11, 2025. *See* Paper 12. Unfortunately for the Petitioners, the USPTO rescinded the prior guidance regarding *Fintiv* and the impact of a *Sotera* stipulation on February 28, 2025. ***This changed the rules in the midst of the Petitioners' IPR***, and allowed the PTAB to effectively ignore the *Sotera* stipulation and decline to institute.

* * *

Because the Board committed error, the Director should review and vacate the Institution Decision.

Respectfully submitted,

Case No. IPR2025-00084

Patent No. 11,219,000

Date: July 7, 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 **REQUEST FOR DIRECTOR REVIEW** was served in its entirety on July 7, 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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