

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

Charter Communications, Inc. and Plume Design, Inc.
Petitioner
v.

Adaptive Spectrum and Signal Alignment, Inc.
Patent Owner.

IPR2025-00088
Patent No. 11,050,654

**PETITIONER'S SUPPLEMENTAL BRIEF
REGARDING RECISSION OF THE *FINTIV* MEMO**

TABLE OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 11,050,654 (the “’654 patent”)
1002	Prosecution history of U.S. Patent No. 11,050,654 (“’654FH”)
1003	Declaration of Henry Houh, Ph.D. (“Houh Decl.”)
1004	U.S. Patent App. Pub. 2011/0149720 to Phuah et al. (“Phuah”)
1005	U.S. Patent App. Pub. 2011/0119370 to Huang et al. (“Huang”)
1006	Bruno P. Ramos, Vasco N. G. J. Soares and Alexandre J. P. D. Fonte, <i>Internet Access Quality Monitor</i> , PROCEEDINGS OF THE FOURTH INTERNATIONAL CONFERENCE ON WEB INFORMATION SYSTEMS AND TECHNOLOGIES, 197-201 (2008) (“Ramos”) DOI: 10.5220/0001532101970201
1007	U.S. Patent App. Pub. 2006/0164978 to Werner et al. (“Werner”)
1008	U.S. Patent App. Pub. 2002/0138443 to Schran et al. (“Schran”)
1009	TR-069 CPE WAN Management Protocol v.1.1, Issue 1, Amendment 2, (December 2007) (“TR-069”)
1010	U.S. Patent No. 7,934,212 (the “Lakhdhir”)
1011	U.S. Patent No. 7,530,020 (“Szabo”)
1012	U.S. Patent No. 6,915,271 (“Meyer”)
1013	U.S. Patent No. 8,290,920 (“Mahajan”)
1014	U.S. Patent No. 8,473,628 (“Kapoor”)
1015	U.S. Patent No. 9,250,833 (“DeAnna”)
1016	<i>Adaptive Spectrum and Signal Alignment, Inc. v. Charter Communications, Inc.</i> , No. 2:24-cv-00124 (E.D. Tex.), Complaint
1017	<i>Adaptive Spectrum and Signal Alignment, Inc. v. Charter Communications, Inc.</i> , No. 2:24-cv-00124 (E.D. Tex.), Docket Control Order

Exhibit	Description
1018	Lex Machina – Time to Trial for the Eastern District of Texas and District of Colorado
1019	<i>Curriculum Vitae</i> , Henry H. Houh, Ph.D.

Petitioner respectfully submits this brief in response to the Board's order.

IPR2025-00088, Paper 9 at 3 (Mar. 26, 2025).

I. The Board Should Not Exercise its Discretion Under 35 U.S.C. § 314(a) to Deny Institution Despite Recission of the *Fintiv* memo

The USPTO rescinded its June 21, 2022 *Fintiv* Memo regarding discretionary denials (the "Memo").¹ The rescission did not fundamentally change the Board's discretionary approach nor its application of the *Fintiv* factors. Rather, the USPTO merely refers parties to existing precedent and specifically *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020). *See* PTAB Guidance dated March 24, 2025 ("Recission Guidance").

Denial of institution under § 314(a) remains within the Board's discretion. Institution decisions following recission reinforce the fact that the Board considers and applies the *Fintiv* factors to each case. Here, Petitioner's original analysis of the *Fintiv* factors did not focus on the Memo guidance and remains unchanged. For the reasons set forth in the Petition, the Board should not exercise discretion to deny institution. *See* Petition at 5-9.

¹ <https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures>.

Factor 1 is neutral as the parties have not requested a stay. The analysis related to this factor is unchanged by rescission of the Memo, and the parties agree that *Fintiv* Factor 1 is neutral. *See* Pet. at 6; POPR at 4.

Factor 2 is neutral as the likely trial date is close in proximity to the projected statutory deadline for a final written decision. The Board still considers median time-to-trial and pending transfer² under this factor. *See Toyota Motor Corp. v. Emerging Automotive LLC*, IPR2024-00785, Paper 13 at 11-12 (Mar. 11, 2025); *see also* Recission Guidance. As noted in the Petition, given median times-to-trial in EDTX, a trial is unlikely to occur before February or March 2026. EX1018. The projected statutory deadline for a final written decision is in June 2026. The Board has considered a pending transfer motion under this factor after the Memo's Recission. *See, e.g., Mobileye Global, Inc. v. Facet Tech. Corp.*, IPR2024-01110, Paper 16 at 12 (Mar. 5, 2020) (noting that the pending transfer motion "may delay the trial date in the Texas Litigation"). Thus, although the district court litigation currently has a September 22, 2025 (EX1017) trial date, the Board should consider, in its discretion, the unlikelihood that a trial proceeds on this date.

² A Report and Recommendation denying the transfer motion in the underlying litigation issued on March 31, 2025.

In fact, prior to the Memo, the Board acknowledged uncertainty of scheduled trial dates under certain circumstances. *See, e.g., Sand Revolution II, LLC v. Continental Intermodal Grp. Trucking LLC*, IPR2019-01393, Paper 24 at 8-9 (Jun. 16, 2020). That uncertainty is even more prevalent in this jurisdiction (EDTX) where Judge Gilstrap stacks multiple cases on the same trial date. *See Samsung Elecs. Co., Ltd. v. Acorn Semi, LLC*, IPR2020-01207, Paper 21 at 31 (Feb. 10, 2021) (the Board explained, prior to the Memo, that “the number of other cases that are also scheduled to trial [in Judge Gilstrap’s court] . . . introduce[d] some uncertainty” as to the scheduled trial). The facts here in no way support “strongly” favoring denial. *Compare* POPR at 27 *with Samsung*, Paper 21 at 31 (these circumstances “prevent this factor from weighing strongly against institution”).

Factor 3 weighs against exercising discretion as the parties had not meaningfully invested in the litigation at time of filing. This factor is unchanged and weighs against discretionary denial.

Factor 4 weighs against discretionary denial based on Petitioner’s stipulation and challenge to unasserted claims. Petitioner stipulates it will not pursue in the district court litigation any ground that Petitioner raised or reasonably could have raised in this proceeding. *Sotera Wireless*, Paper 12 at 18-19. Accordingly, “following *Sotera Wireless*, this factor strongly favors institution.” *Samsung*, Paper 21 at 34; *see Mobileye*, Paper 16 at 15 (finding, post-Memo, a *Sotera*

stipulation “weigh[s] strongly against exercising our discretion to deny institution”); *see* Recission Guidance at 2-3 (explaining “a timely-filed *Sotera* stipulation . . . is highly relevant”). Further, the Petition challenges claims 2-3, 6, 8, 10-12, 20, and 33-34, which are not at issue in the litigation. This also weighs against discretionary denial. *Oticon Medical AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15 at 23-24 (Oct. 16, 2019) (precedential).

Factor 5 weighs against discretion. The analysis of this factor is unchanged by recission of the Memo because co-Petitioner Plume is not a party to the litigation.

Factor 6 strongly weighs against exercising discretion given the merits of the Petition. This factor is no longer dispositive, but compelling evidence of unpatentability weighs heavily against exercising discretion for denial. *See, e.g., Mobileye*, Paper 16 at 16; *Fintiv, Inc.*, IPR2020-00019, Paper 11 at 14-16; *Sand*, Paper 24 at 12-14, 57; *cf. Toyota*, Paper 13 at 15-16; *see* Recission Guidance at 3 (noting strength of merits should still be considered).

II. Conclusion

Fintiv factors 3-4 and 5-6 weigh in favor of not exercising discretion to deny institution, while factors 1-2 are neutral. Accordingly, Petitioner respectfully requests the Board not exercise its discretion to deny institution of its Petition regarding the '654 Patent.

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Petitioner's Supplemental *Fintiv* Briefing

Respectfully submitted,
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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of *PETITIONER'S SUPPLEMENTAL BRIEF REGARDING RECISSION OF THE FINTIV MEMO* has been served by emailing counsel of record for Patent Owner, identified below.

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