

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,
T-MOBILE USA, INC., AT&T SERVICES, INC.,
NOKIA OF AMERICA, CORP., ERICSSON INC., AND GOOGLE LLC,
Petitioners,

v.

PEGASUS WIRELESS INNOVATION LLC,
Patent Owner.

Case IPR2025-00137
U.S. Patent No. 11,540,272

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)
2005-2017	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)
2019-2039	Reserved
2040	Appendix I 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)
2041	Ex. I-2 of Appendix I 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)
2042-2049	Reserved
2050	Defendants' Amended 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 November 1, 2024)
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	Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex December 23, 2024)
2052	Defendants’ Motion for Leave to Amend 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. January 24, 2025)
2053	Appendices 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. November 1, 2024)
2054	Exhibits to Appendices of 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. November 1, 2024)
2055-2202	Reserved
2203	Consolidation 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 Feb. 13, 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 1-20 of U.S. Patent No. 11,540,272 (the “’272 patent”), as requested by Celco Partnership d/b/a Verizon Wireless, T-Mobile USA, Inc., AT&T Services, Inc., Nokia of America, Corp., Ericsson Inc., and Google LLC (“Petitioners”), should be denied.¹

I. INTRODUCTION

Petitioners’ primary references, You and Gao, fail to disclose an allocation table with information on a starting OFDM symbol, as claimed in each of the independent claims and as relied upon by the Examiner when allowing the claims. Petitioners try to minimize that the Examiner’s reasons for allowance (Ex. 1002, 75-77) included noting the presence of the information on a starting OFDM in the allocation table (Pet. 8, 17), but they cannot ignore the language of the claims or the express disclosures of their references, which fail to include any information on a starting OFDM symbol in the “patterns” that Petitioners rely on to disclose the claimed “tables.” Thus, Petitioners’ challenges fail.

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).

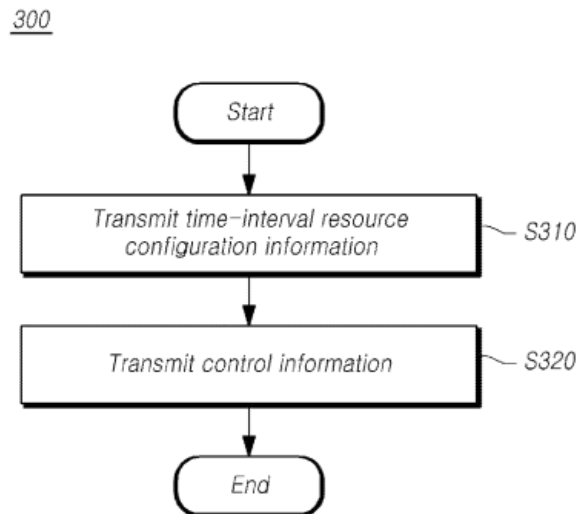
Additionally, Patent Owner intends to ask the Director to discretionarily deny the Petition within the time permitted to make such a request. Specifically, given the timing and advanced stage of co-pending litigation between the Petitioners and Patent Owner regarding the '272 patent, the Director should deny the Petition under *Fintiv*. As enumerated below and as will be addressed in Patent Owner's separate request for discretionary denial (to be filed), 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 on September 8, 2025, over ten months before the Board would be expected to issue a final written decision in this case (by July 17, 2026). Also, at least five of Petitioners' other IPRs are directed towards patents-at-issue in that litigation that 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. Therefore, Patent Owner respectfully submits that the Director should exercise its discretion and deny this Petition against the '272 patent.

II. THE '272 PATENT DISCLOSES AND CLAIMS AN ALLOCATION TABLE WITH INFORMATION ON A STARTING OFDM SYMBOL AND THE NUMBER OF THE OFDM SYMBOLS

The '272 patent is entitled, "Method and Device for Allocating Data Channel Resource for Next-Generation Wireless Access Network." Fig. 3 of the

'272 patent, reproduced below, illustrates a method of a base station for allocating a time-domain resource for DL data channel (PDSCH) transmission/reception or UL data channel (PUSCH) transmission/reception ('272 patent, 12:26-30):

FIG.3



The method 300 allocates the time-domain resource based on a slot or a mini-slot as a unit of a symbol (such as OFDM or SC-FDMA). In step S310, the method transmits time-domain resource configuration information to a UE including the allocation information. In step S320, the method transmits control information to the UE to select symbol allocation information included in the time-domain resource configuration information that was sent to the UE in step S310.

'272 patent, 12:31-45.

For example, in order to allocate the time-domain resource for the DL data channel (PDSCH) transmission/reception, the time-domain resource configuration information may include symbol allocation information and indexes indicating each symbol allocation information for each UE, such as provided in Table 2 of the '272 patent ('272 patent, 12:46-54; 10:60-11:17):

TABLE 2

<u>OFDM symbol (or SC-FDMA symbol) allocation information</u>		
Index	Starting OFDM symbol	Length
0	0	4
1	0	5
2	0	6

TABLE 2-continued

<u>OFDM symbol (or SC-FDMA symbol) allocation information</u>		
Index	Starting OFDM symbol	Length
3	1	3
4	1	4
5	1	5
6	2	2
7	2	3
8	2	4
9	3	1
10	3	2
11	3	3
12	4	1
13	4	2
14	5	1
15	reserved	reserved

In Table 2, the allocation information may include respective starting symbols and lengths (or number of symbols). '272 patent, 10:53-56. For example, the table could be transmitted as shown in the diagram of Fig. 4 ('272 patent, 13:6-18):

FIG. 4

**Time-interval resource configuration
information for a PDSCH (400)**

{
{index 0, SOS 0, Length 4}
{index 1, SOS 0, Length 5}
.
.
.
{index 15, SOS 5, Length 1}
}

After the table is transmitted, in step S320 of Fig. 3, the base station may transmit the control information including information indicating one of indexes corresponding to a row of the allocation table. '272 patent, 13:59-61. For example, a downlink assignment can be provided through the RRC signaling as a field of 3 or 4 bits indicating one of indexes. '272 patent, 13:64-14:19.

Consistent with the '272 patent's disclosure, independent claim 1 recites:

1. A base station, comprising:
 - a transceiver;
 - a receiver; and
 - a controller which controls the transceiver and receiver thereby performing operations including:

transmitting, to a wireless device, a radio resource control (RRC) signal including information on one or more allocations of a time-domain resource,

wherein the time-domain resource includes at least one or more orthogonal frequency-division multiplexing (OFDM) symbols,

wherein, based on the information, a number of OFDM symbols are determined for a physical downlink shared channel (PDSCH) or a physical uplink shared channel (PUSCH), and

wherein the determined number of OFDM symbols is smaller than or equal to a number of OFDM symbols included in a slot; and

transmitting, to the wireless device, downlink control information (DCI), including *a field including a bit string*,

wherein the bit string in the field relates to a row index of an allocation table, and

wherein the allocation table includes information on a starting OFDM symbol and the number of the OFDM symbols which is smaller than or equal to the number of OFDM symbols included in the slot.

'272 patent, claim 1 (emphasis added).

Claim 8 recites:

8. A wireless device, comprising:
 - a transceiver;
 - a receiver; and

a controller which controls the transceiver and receiver thereby performing operations including:

receiving, from a base station, a radio resource control (RRC) signal including information on one or more allocations of a time-domain resource,

wherein the time-domain resource includes at least one or more orthogonal frequency-division multiplexing (OFDM) symbols,

wherein, based on the information, a number of OFDM symbols are determined for a physical downlink shared channel (PDSCH) or a physical uplink shared channel (PUSCH), and

wherein the determined number of OFDM symbols is smaller than or equal to a number of OFDM symbols included in a slot; and

receiving, from the base station, downlink control information (DCI), including *a field including a bit string*,

wherein the bit string in the field relates to a row index of an allocation table, and

wherein the allocation table includes information on a starting OFDM symbol and the number of the OFDM symbols which is smaller than or equal to the number of OFDM symbols included in the slot.

'272 patent, claim 8 (emphasis added).

Claim 15 recites:

15. An operation method of wireless device, comprising:

receiving, from a base station, a radio resource control (RRC) signal including information on one or more allocations of a time-domain resource,

wherein the time-domain resource includes at least one or more orthogonal frequency-division multiplexing (OFDM) symbols,

wherein, based on the information, a number of OFDM symbols are determined for a physical downlink shared channel (PDSCH) or a physical uplink shared channel (PUSCH), and

wherein the determined number of OFDM symbols is smaller than or equal to a number of OFDM symbols included in a slot; and

receiving, from the base station, downlink control information (DCI), including *a field including a bit string*,

wherein the bit string in the field relates to a row index of an allocation table, and

wherein the allocation table includes information on a starting OFDM symbol and the number of the OFDM symbols which is smaller than or equal to the number of OFDM symbols included in the slot.

'272 patent, claim 15 (emphasis added).

When allowing the claims, the Examiner noted that the prior art failed to disclose or render obvious the claims with the recitation “wherein the determined number of OFDM symbols is smaller than or equal to a number of OFDM symbols included in a slot; and transmitting, to the wireless device, downlink control information (DCI), including a field including a bit string, wherein the bit string in the field relates to a row index of an allocation table, and wherein the allocation table includes information on a

starting OFDM symbol and the number of the OFDM symbols which is smaller than or equal to the number of OFDM symbols included in the slot.”

Ex. 1002, 75-76. Petitioners' asserted art also fails to disclose or suggest every claimed feature, including at least the emphasized portions of these challenged claims, indicated above.

III. THE BOARD NEED NOT REACH ANY CLAIM CONSTRUCTION ISSUES TO DENY THE PETITION

Petitioners state that “Petitioners propose that each claim term be given its plain and ordinary meaning in this proceeding, and that no specific construction of any claim term is required.” Pet., 12.

Without waiving its right to submit constructions in a Patent Owner Response, Patent Owner submits that the Board need not engage in any pre-institution claim construction. For the substantive reasons presented in Section IV below, Petitioner's grounds include fundamental flaws and fail to establish the disclosure of every claimed element in each independent claim. These findings do not require the Board to conduct any construction of the above-identified terms.

IV. PETITIONERS' CHALLENGES FAIL ON THE MERITS

Petitioners assert five grounds in their Petition, and four of those grounds, Grounds 1-4, apply to the independent claims (claims 1, 8, and 15). Ground 1 contends that the independent claims, and all of the dependent claims (claims 2-7,

9-14, and 16-20), are obvious over Gao², alone, or in view of You³; Ground 2 contends that the independent claims, and all of the dependent claims, are obvious over You, alone, or in view of Gao; Ground 3 contends that the independent claims, and all of the dependent claims, are obvious over Gao, alone, or in view of You, in further view of 3GPP36-213⁴ and 3GPP36-212⁵; and Ground 4 contends that the independent claims, and all of the dependent claims, are obvious over You, alone, or in view of Gao in further view of 3GPP36-213 and 3GPP36-212. For completeness, Ground 5 is not used to shore up the deficiencies of the challenges against the independent claims in Grounds 1-4. Instead, Ground 5 is a multiple-dependent ground and contends dependent claims 5, 12, and 19 are obvious in view of “Grounds 1-4” in further view of R1-1610129.⁶

Each Ground fails, however. Neither You nor Gao discloses or suggests an allocation table that “includes information on a starting OFDM symbol and the number of the OFDM symbols” or transmitting or receiving a bit string relating to a row index of the allocation table, as claimed. Petitioners attempt to equate You and Gao’s “patterns” to a table, but none of those “patterns” include a “starting OFDM symbol.” Instead, Petitioners try to fill the gaps in these references with

² Ex. 1007, U.S. Pat. Pub. No. 2020/0187169 (“Gao”).

³ Ex. 1004, U.S. Pat. Pub. No. 2018/0376497 (“You”).

⁴ Ex. 1010, 3GPP Specification 36.213, Release 13.1.0 (published March 2016).

⁵ Ex. 1011, 3GPP Specification 36.212, Release 13.1.0 (published March 2016).

⁶ Ex. 1020, R1-1610129.

conclusory expert testimony that ignores the teachings of the references themselves. Thus, Grounds 1 and 2 are facially deficient in establishing the unpatentability of any challenged independent claim. Grounds 3-5 similarly fail because secondary references 3GPP36-213, 3GPP36-212, and R1-1610129 are not relied on to remedy the above-described deficiencies of You or Gao. For the reasons discussed below, the Petition should be denied without institution.

A. The “Patterns” in You and Gao Do Not Include a Starting OFDM Symbol

Petitioners rely heavily on the “patterns” in You and Gao as disclosing the claimed allocation table. *See, e.g.*, Pet. 22-27. Specifically, Petitioners contend that You provides “resource patterns” that “indicate ... a resource region in which the sPDSCH is transmitted within an OFDM symbol region.” Pet. 47-48 (citing You, [0222]). Petitioners also assert that a “POSITA would understand You’s ‘regions’ within the ‘patterns’ to disclose, or suggest, ‘*information on a starting OFDM symbol and the number of the OFDM symbols*’ for each pattern.” Pet. 61 (citing its expert’s opinion at Ex. 1003, ¶¶378-386). Petitioners’ expert declaration mimics the Petition and does not add any meaningful technical analysis. Ex. 1003, ¶¶378-386. The logic in Petitioners’ analysis appears to be that because You’s patterns have regions and because regions must have a start and an end, You’s patterns must disclose a “starting OFDM symbol.” Pet. 61-63.

But this logic completely unravels when it is understood that You does not include a starting OFDM symbol in any “pattern” because, as Petitioners admit, “You devotes an entire section to ‘D. Starting OFDM Symbol location of sPDSCH Transmission.’” Pet. 63 (citing You [0226]-[0300]). You’s Section D does “describe methods of identifying the starting PDSCH OFDM symbol location,” Pet. 63, but none of those methods indicate that any “pattern” includes the starting PDSCH OFDM symbol. Here, Petitioners’ faulty logic appears to be that because (1) the “patterns” are transmitted by RRC signaling and (2) because You teaches that “[t]he sPDSCH transmission starting OFDM symbol location may be semi-statically configured by the eNB through ... an RRC signal,” Pet. 63 (citing You, [0243], [0248], [0262], [0268], [0279], [0285], [0292]), Petitioners conclude that the “patterns” must include the “starting OFDM symbol location.” Petitioners’ logic is faulty because the use of RRC signaling to directly send a starting OFDM symbol separately does not suggest including a starting OFDM symbol in You’s “patterns” regardless of how the “patterns” are transmitted. And the error in that faulty logic becomes plain because “Section D” in You occurs *after* You’s discussion of “patterns” in “Method 7” of You’s “Section C.” You, [0198], [0221]-[0224]. The correct understanding of You is that even after You provides patterns to the UE with RRC signaling, You must still identify the starting OFDM

symbol, which is achieved with ***additional*** RRC signaling, and not in any “pattern.”

Petitioners' logical errors concerning Gao are similar. Petitioners rely on Gao's disclosure of “notifying the UE of one of a plurality of predefined patterns, where each pattern includes an allocation of lengths and positions of the DL regions in the time unit.” Pet. 37 (citing Gao, [0191]). Petitioners then posit that Gao would disclose various downlink regions in Gao's time units, thereby disclosing a starting OFDM symbol. Pet. 39-41. But again, this is wrong. Gao expressly teaches that when a starting OFDM symbol is to be provided to a UE, it is done so “directly,” as non-exclusive alternative to Gao's patterns. Indeed, in full, paragraph [0191] of Gao reads (with emphasis added):

[0191] In an implementation, the notifying module is configured to notify the UE of the allocated DL regions via the configuration signaling by: notifying the UE of lengths and positions of the DL regions in the time unit; or notifying the UE of one of a plurality of predefined patterns, where each pattern includes an allocation of lengths and positions of the DL regions in the time unit; ***or notifying the UE of start or end positions of the DL regions in the time unit.***

Petitioners rely on the underlined portion in isolation, and ignore Gao's teaching that, when desirable to indicate a start position, Gao provides for direct notification

and not the use of any “pattern.” *See* Gao, [0111] (“the UE is notified directly of the start or end position(s) of the uplink region(s) in the time unit via the configuration signaling”). In this regard, Gao’s teaching is similar to You’s teaching regarding the RRC signaling of a starting OFDM symbol. Thus, neither You or Gao, when taken alone or in any combination, discloses or suggests a “pattern” with information on a starting OFDM symbol as claimed in each of the independent claims of the ’272 patent.

B. Due to the Deficiencies of You and Gao, Each Ground Fails

Grounds 1 and 2 rely on You and Gao and, thus, fail due to You and Gao’s failure to disclose an allocation table including a starting OFDM symbol.

Similarly, for Grounds 3 and 4, Petitioners merely rely on the standards (3GPP36-212 and 3GPP36-213) for disclosure of a “table” format and not to show an allocation table having information on a starting OFDM symbol. Pet. 71-73. Thus, Grounds 3 and 4 fail.

Finally, in Ground 5, Petitioners do not rely on R1-1610129 to show an allocation table having information on a starting OFDM symbol. Pet. 73-76. Thus, Ground 5 fails as well.

V. THE DIRECTOR SHOULD DENY INSTITUTION UNDER *FINTIV*

The Director can and should deny the Petition by exercising its discretion under 35 U.S.C. § 314(a) because the correct balance of relative factors weighs in favor of denial.

When evaluating whether to discretionarily deny a petition, the Director may look to at least 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 Director may take “a

holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*⁷

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 discovery dispute to suggest Factor 1 weighs against discretionary denial. Pet., 78. But in the months after its Petition was filed, Petitioners have not requested a stay or that the trial date be adjusted based on the discovery dispute. 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), a scheduled jury trial preceding any final written decision (discussed in factor 2), and the timing of institution decisions on the ten other IPRs against

⁷ 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. The most recent *Fintiv* guidance is included in the Chief Administrative Patent Judge’s Memorandum of March 24, 2025.

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, over ten months before the Board’s final decision would be expected to be due, on or about July 17, 2026. *See* Ex. 1022, 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 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; Memorandum from Chief Administrative Patent Judge at 3 (Mar. 24, 2025).

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-](https://www.uscourts.gov/sites/default/files/2025-02/fcms_na_distcomparison1231.2024.pdf)

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, on or around July 17, 2026. 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”).

Also, the suggestion in the Petition that there would be “post-trial motions” (Pet., 79) 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. 1022. 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 '272 patent in advance of the Board's projected statutory deadline. Ex. 2018, 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 final invalidity theories by September 1, 2025. *See* Ex. 1022, 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 case" (Pet., 78) 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 amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision" may be considered. *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., 79; *see also* Ex. 2004, 8, 14, 24-25, 36, 305 (cover pleading); Ex. 2040 (Appx. I); Ex. 2041 (Ex. I-2) (You). Yet, Petitioners delayed until December 24, 2024—over nine months after receiving infringement contentions—to file its Petition challenging the ’272 patent. Despite noting the date that the invalidity contentions were served in its Petition (Pet., 79), 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 four 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 and are seeking to amend their initial contentions. As will be discussed with regard to

factor 4 below, those invalidity contentions overlap substantially with the Petition (and are even more comprehensive).

Petitioners assert five grounds in their Petition, and four of those grounds, Grounds 1-4, apply to the independent claims (claims 1, 8, and 15). Ground 1 contends the independent claims, and all of the dependent claims (claims 2-7, 9-14, and 16-20) are obvious over Gao⁸, alone, or in view of You⁹; Ground 2 contends the independent claims, and all of the dependent claims, are obvious over You, alone, or in view of Gao; Ground 3 contends the independent claims, and all of the dependent claims, are obvious over Gao, alone, or in view of You, in further view of 3GPP36-213¹⁰ and 3GPP36-212¹¹; and Ground 4 contends the independent claims, and all of the dependent claims, are obvious over You, alone, or in view of Gao in further view of 3GPP36-213 and 3GPP36-212. For completeness, Ground 5 is not used to shore up the deficiencies of the challenges against the independent claims in Grounds 1-4. Instead, Ground 5 is a multiple-dependent ground and contends dependent claims 5, 12, and 19 are obvious in view of “Grounds 1-4” in further view of R1-1610129.¹²

⁸ Ex. 1007, U.S. Pat. Pub. No. 2020/0187169 (“Gao”).

⁹ Ex. 1004, U.S. Pat. Pub. No. 2018/0376497 (“You”).

¹⁰ Ex. 1010, 3GPP Specification 36.213, Release 13.1.0 (published March 2016).

¹¹ Ex. 1011, 3GPP Specification 36.212, Release 13.1.0 (published March 2016).

¹² Ex. 1020, R1-1610129.

Petitioners' initial invalidity contentions included a claim chart addressing the same You reference asserted by Petitioners in each of the Grounds and cited to the 3GPP 36.212¹³ reference relied upon for Grounds 3 and 4. Ex. 2004, 8, 14, 24-25, 36, 305 (cover pleading); Ex. 2040 (Appx. I); Ex. 2041 (Ex. I-2) (You). On November 1, 2024, and again on December 23, 2024, Petitioners sought to increase the overlap by providing Patent Owner amended invalidity cover pleadings and later moved for leave to amend its invalidity contentions. Exs. 2050-2052. In the amendment, Petitioners added a claim chart to the other primary reference to Gao in each of the Grounds. *See, e.g.*, Ex. 2051, 39; Ex. 2053, 122-183 (Appx. I); Ex. 2054, 625-730 (Ex. I-7) (Gao). Petitioners also clarified reliance on each of the secondary references to 3GPP 36.212, 3GPP 36.213, and R1-1610129. Ex. 2051, 19-21; Ex. 2053, 122-23. Should leave to amend be granted, there would be complete overlap between the Petition and the district court case. Petitioners also provide no justification for their delay in filing this Petition concerning the You reference when it had developed its invalidity theories sufficiently to include them in a district court pleading months *seven months* earlier. Patent Owner and Petitioners will have expended substantial resources in

¹³ The version of the 3GPP standard cited in the invalidity contentions is merely an earlier version (version 12.5.0) of the standard relied on in the Petition (version 13.1.0). Ex. 2004 at 25 (citing 3GPP TS 36.212 version 12.5.0 Release 12).

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 July 17, 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 and even before the Patent Owner's Preliminary Response is due. 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 '272 patent are invalid under 35 U.S.C. § 112(a) and § 112(b). *See* Ex. 2004, 364, 369. Thus, the district court will be in the best position to resolve all of the validity issues relating to the '272 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 July 17, 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), and participated in a claim construction hearing (March 11, 2025). These activities have taxed 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. 1022, 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 '272 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.

As noted above, Petitioners rely on Gao, alone, or in view of You; You, alone, or in view of Gao; and, alternatively, those references in in further view of 3GPP36-213 and 3GPP36-212 and R1-1610129.

Petitioners' original invalidity contentions include a claim chart addressing the same You reference asserted by Petitioners in its Petition, *see, e.g.*, Ex. 2004, 8, 14, 24-25, 36, 305 (cover pleading); Ex. 2040 (Appx. I); Ex. 2041 (Ex. I-2) (You), and its amended invalidity contentions included a claim chart to the Gao reference relied on the Petition and reliance on each of the secondary references. *See, e.g.*, Ex. 2051, 39; Ex. 2053, 122-183 (Appx. I); Ex. 2054, 625-730 (Ex. I-7) (Gao); *see also* Ex. 2051, 19-21; Ex. 2053, 122-23. Thus, in district court, Petitioners' invalidity contentions are challenging the same set of claims, claims 1-20 of the '272 patent based on the same references. Thus, there is substantial overlap between the Petition and the district court proceeding, as the claims challenged and the primary references relied upon are substantially identical. Therefore, Petitioners' common prior art challenges to the claims renders the "overlap in issues between the two proceedings [] 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*.

Indeed, Petitioners’ delay in filing their Petition and failure to file a *Sotera* stipulation with their Petition demonstrates their intent to conduct parallel proceedings. Given the lengthy time that passed between the filing of their invalidity contentions and their slow-rolled Petition, to the extent Petitioners attempt to file a belated *Sotera* stipulation in response to this brief, the Director should give it little weight as it would encourage gamesmanship and reward petitioners for multiplying parallel proceedings.

Further demonstrating the intent to present overlap contentions, Petitioners’ invalidity contentions explicitly signal that Petitioners intend to rely on systems embodying the You and Gao disclosures, and other disclosures, upon which it relies. *See* Ex. 2004, 38 (“Moreover, in certain instances, representative documents for certain prior art systems are cited, but, again, are merely exemplary; they do not

necessarily reflect or include every document relating to the prior art system that exists and that discloses or teaches a particular claim term or claim limitation.

Defendants reserve the right to rely on any and all documents that describe or relate to prior art systems, including relying on the system itself. Defendants also reserve the right to rely on the testimony of the authors, named inventors, or anyone else with knowledge of the prior art references and systems identified herein, as well as expert testimony regarding any such references or systems.”) (emphasis added); Ex. 2004, 14 n.5 (“Defendants also hereby ***identify any systems or products that embody the technology described in any patent or publication identified in these Preliminary Invalidity Contentions.*** Defendants reserve the right to rely on any documents or other evidence regarding such systems.”) (emphasis added); Ex. 2004, 29 (“All systems or products that embody the technology described in any patent or publication identified in these Preliminary Invalidity Contentions”); *see also* Ex. 2004, 8 n.2 (indicating Petitioners intend to “seek[] additional information related to the references and systems disclosed in these Preliminary Invalidity Contentions, and seek[] additional information related to available prior art systems”); Ex. 2050, 8 n.2, 9 n.5, 31, 34, 40; Ex. 2051, 9 n.2, 15 n.5, 31, 34-35, 41. Given that IPRs cannot reach the system prior art, even a *Sotera*-stipulation would not reduce the inefficiencies presented with these

multiple proceedings. *See Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB Mar. 28, 2025).

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 twenty '272 patent claims asserted in this case and a total of 113 asserted in the related district court cases" (Pet., 80), but this argument misses the mark. The 113 litigated claims include claims in patents other than the '272 patent, and the existence of other litigated claims does not diminish the perfect overlap between the claims in this IPR and the same twenty 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 denying 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. 1022),¹⁴ 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

¹⁴ To the extent Petitioners argue that the presence of Google as a Petitioner in this proceeding lessens the weight of Factor 5, that argument should be rejected. The inefficiencies caused by the presence of the numerous overlapping petitioners are not abated simply by including a petitioner who is not a named defendant in the underlying district court litigation.

IPR2025-00137 Patent Owner’s Preliminary Response

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 on which the USPTO’s Notice according a filing date was issued, the anticipated institution deadline, and the anticipated final written decision deadline¹⁵:

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
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

This IPR is one of eleven decisions on institution the Board will need to make relating to the dispute between the Parties. As the Director may face the

¹⁵ Google joined as an additional petitioner in each of these IPR proceedings except for IPR2025-00036 and IPR2025-00037.

decisions serially, the strength of the *Fintiv* factors in favor of exercising 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 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., 80 (“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” (Ex. 2203) and the consolidated action is progressing at pace towards a September 2025 trial date.

Moreover, in this IPR, Petitioners multiply these proceedings with litigation-based comments, without providing a relevant reason for these spurious allegations to be made in this IPR and, in many cases, without factual support. For example, Petitioners appear to have a complicated theory concerning the ’272

patent's "Priority Application" but note that "Petitioners' prior art predates" the October 31, 2016 date of the Priority Application. Thus, Petitioners' multiple asides concerning the "Priority Application" appear irrelevant to this IPR. *See* Pet. 1-2 (discussion of a priority application); Pet. 6-7 (same); Pet. 9 (raising whether "exemplary tables" found in the '272 patent are "not present in the Priority Application"); Pet. 18 (reference to "Priority Application").

Similarly injecting a litigation-based tactic in this IPR, Petitioners impugn what was allegedly provided to the Examiner during examination. *See* Pet. 15 (alleging the '272 patent "contains materials taken from the RAN1#86 meeting"); *id.* (alleging the "inventors removed" a statement); Pet. 17-18 (alleging the inventors "did not submit" materials "to the Examiner"). These comments are not proper in an IPR as an IPR is not suited to vet and decide such issues.

In fact, 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, 364, 369), 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. As explained in the preceding section, the merits of the challenges asserted in the Petition 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. 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").

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.

VI. CONCLUSION

For the reasons presented above, the Petition should be denied, and no *inter partes* review should be instituted.

Dated: April 17, 2025

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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 7,951 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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CERTIFICATE OF SERVICE

Petitioner has consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on April 17, 2025, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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