

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

PEGASUS WIRELESS INNOVATION LLC,
Patent Owner.

Case IPR2025-00138
U.S. Patent No. 10,181,931

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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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)
2019-2029	Reserved
2030	U.S. Patent Publication No. US 2014/0219202 A1 (Kim counterpart)
2031	U.S. Patent Publication No. US 2014/0092790 A1 (Zhang counterpart)
2032	Appendix B 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)
2033	Ex. B-1 of Appendix B 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)
2034	Ex. B-2 of Appendix B 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)
2035	Ex. B-4 of Appendix B to Defendants' Preliminary Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon</i>

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	<i>Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex May 17, 2024)
2036	Ex. B-6 of Appendix B 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)
2037-2203	Reserved
2204	Fifth Amended Docket Control Order, issued April 14, 2025

Pursuant to the Director’s Memorandum issued on March 26, 2025, Pegasus Wireless Innovation LLC (“Pegasus” or “Patent Owner”) files this request and brief on discretionary denial, setting forth reasons why the Petition for *inter partes* review (“IPR”) of claims 1-7 of U.S. Patent No. 10,181,931 (the “’931 patent”), as requested by Cellco Partnership d/b/a Verizon Wireless, AT&T Services, Inc., T-Mobile USA, Inc., Google LLC, Ericsson, Inc., and Nokia of America Corp. (“Petitioners”), should be denied.¹

I. INTRODUCTION

Given the timing and advanced stage of co-pending litigation between the Petitioners and Patent Owner regarding the ’931 patent, the Board should exercise its discretion to deny the Petition under *Fintiv*. As enumerated below, 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, nearly eleven months before the Board would be expected to issue a final written decision in this case (by July 29, 2026), and at least four other IPRs directed towards patents-at-issue in that litigation are on a timeline that is even later than this IPR. Also, there is substantial overlap between the validity challenges raised in

¹ By submitting this brief concerning discretionary denial, 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).

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the litigation and this IPR, and Petitioners have not submitted any stipulation regarding those challenges.

Importantly, two of Petitioners' other IPRs—IPR2025-00036 and IPR2025-00037—have already been denied institution by the Board under *Fintiv*, on April 25, 2025, due to the extensive activities that have already occurred in the co-pending litigation, the schedule of the upcoming trial, and the overlap in parties between those IPRs and the litigation. These same factors weigh even more in favor of discretionary denial in this case.

Finally, as demonstrated in Patent Owner's Preliminary Response, Petitioners' challenges are not strong. The '931 Patent discloses and claims methods for allocating control channel resources for transmitting acknowledge/non-acknowledge ("ACK/NACK") messages via a machine-type communication ("MTC") terminal. Relevant to the Petition's deficiencies discussed below, an MTC terminal may receive structural information including start offset information on the resource allocated to the uplink control channel. Further, the start offset information of the resource allocated to the uplink control channel for an MTC terminal may be configured differently from start offset information for a non-MTC or other terminal. As an additional step in the disclosed methods, when the response information of the downlink data of the

MTC terminal is repeatedly transmitted, the repeated transmission is performed using a same uplink control channel resource.

The Petition challenges the claims 1-7 based on two grounds. However, both grounds include multiple deficiencies. First, the Petition fails to address the claimed requirement of “structural information” and fails to address how the asserted art allegedly discloses the structural information that can include the start offset information. Second, the Petition mischaracterizes the disclosures of the asserted art in attempting establish each claimed feature, and fills in clear gaps in the prior art disclosures with unsupported expert testimony and conclusory assertions in violation of the IPR statutes and practices. Each Ground is deficient as presented below, and should be rejected. For these reasons, Petitioners' challenges fail on the merits.

Therefore, Patent Owner respectfully submits that the Board should exercise its discretion and deny this Petition against the '931 patent.

II. 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 deny a petition under Board discretion, the Board balances 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 Board takes “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*²

² 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

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. An institution decision in this case is due about *one month* before the scheduled trial, and institution decisions for at least four other involved patents are on a timeline even later than this case. A stay under these circumstances would be unprecedented, and Petitioners have not presented argument or evidence to the contrary.

Further, Petitioners have not moved for a stay of the district court litigation. Petitioners cite to a then-pending discovery dispute to suggest Factor 1 weighs against discretionary denial. Pet., 78. But Petitioners did not establish that the outcome of the discovery dispute—whether non-jurisdictional discovery may proceed against a KT Corporation prior to resolving KT Corporation's jurisdictional dispute—will affect the trial date of September 8, 2025 set by the district court. Ex. 1014, 2. In fact, since the Petition was filed, the district court has twice granted motions for a protective order against non-jurisdictional discovery without any suggestion that the trial date would be adjusted. Ex. 2001;

is included in the Chief Administrative Patent Judge's Memorandum of March 24, 2025 and the Director's Memorandum issued on March 26, 2025.

Ex. 2002. Moreover, in the months after its Petition was filed, Petitioners have not requested a stay or that the trial date be adjusted. 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 by roughly eleven months (discussed in factor 2), and the timing of institution decisions on the eight other pending IPRs against patents asserted in the same litigations (discussed in factor 6). Additionally, two of Petitioners’ other IPRs—IPR2025-00036 and IPR2025-00037—have already been denied by the Board under *Fintiv*, on April 25, 2025, due to the extensive activities that have already occurred in the co-pending litigation, the schedule of the upcoming trial, and the overlap in parties between those IPRs and the litigation. Between these *Fintiv* denials and the late stage of the co-pending litigation, a stay would be unprecedented.

The first *Fintiv* factor therefore supports denying institution or, at worst, 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, nearly eleven months before the Board’s final decision would be expected to be due, on or about July 29, 2026. *See* Ex. 1014, 2. “If the court’s trial date is earlier than the projected statutory

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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, as determined by the Board in two of Petitioners’ other IPRs—IPR2025-00036 and IPR2025-00037—against patents in suit. Those two IPRs were denied by the Board under *Fintiv*, on April 25, 2025, due to the extensive activities that have already occurred in the co-pending litigation, the schedule of the upcoming trial, and the overlap in parties between those IPRs and the litigation.

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

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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/2025-02/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 29, 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., 67) 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.

1014; Ex. 2204. 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 ’931 patent in advance of the Board’s projected statutory deadline. Ex. 2003, 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 its final invalidity theories by September 1, 2025. *See* Ex. 1014, 4 (setting the deadline for dispositive motions); *id.*, 2 (setting the deadline to disclose final invalidity theories); Ex. 2204 (same).

Petitioners’ attempt to minimize the closeness of the scheduled trial date with the suggestion that “jury selection would proceed with respect to only one of the three cases” (Pet., 66) 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). Further, all three cases are consolidated before Judge Gilstrap for all pre-trial purposes and therefore will be on equal procedural footing when the first trial begins on September 8, 2025.

Petitioners fail to explain why the earliest trial will not be able to fully resolve all pending validity issues surrounding the ’931 patent, including the challenges that cannot be raised in this IPR. *HP Inc., et al. v. Neodron Ltd.*, IPR2020-00459, Paper 17 at 36, 38 (PTAB Sept. 14, 2020) does not support Petitioners’ theory that different trial dates weigh against discretionary denial. Rather, in *HP*, factor 2 was treated as neutral where one litigation—involving two of the co-petitioners—was stayed pending IPR. *Id.*, at 34 (noting the “ND Cal. action ... has been stayed pending [IPR].”). No stay is in place in this case, and a stay is unlikely to be granted. Further, 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. Therefore, even the conclusion in *HP* that this factor was “neutral” cannot apply here.

Google’s status as a co-petitioner here does not alter the analysis. Google joined the named defendants as a co-Petitioner, knowing that Google could be subject to the same post-IPR estoppel statutes as the named defendants. This shows Google’s willingness to be treated on parity with the other Petitioners and does not

insulate all Petitioners from a *Fintiv* denial. *See Google LLC v. Cerence Operating Co.*, IPR2024-01465, Paper 15 at 13-14 (PTAB April 23, 2025) (“Petitioner Google’s presence in this proceeding does not raise the concerns that a *Fintiv* analysis is designed to address.”). *IQE PLC v. Cornell Rsch. Found. Inc.*, IPR2024-00609, Paper 9 at 12-13 (PTAB Sept. 13, 2024), cited by Petitioners in a separate IPR, is completely inapposite, as IPR2024-00609 was a *single-petitioner case*, and did not involve a mixing of defendant and non-defendant petitioners. *IQE* does not even remotely suggest that Google’s involvement here insulates the other Petitioners from the *Fintiv* analysis.

Finally, while Petitioners may speculate that the scheduled trial date might change, it would need to be delayed by eleven months—from September 2025 to August 2026—to put a final written decision ahead of trial. Speculation is not enough to modify this factor, which weighs heavily in favor of discretionary denial.

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 Board considers “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.” *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., 68; *see also* Ex. 2004, 2020-2022. Yet, Petitioners delayed until November 27, 2024—over eight months after receiving infringement contentions—to file its Petition challenging the '931 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,

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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 three 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. 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 two grounds in their Petition, and each Ground applies to all challenged claims (claims 1-7). Ground 1 contends the independent claims (claims 1, 3, 5, and 7), and all of the dependent claims (claims 2, 4, and 6) are obvious over You³ in view of Kim⁴. Ground 2 contends the independent claims, and all of the dependent claims, are obvious over Lee⁵ in view of Zhang⁶.

³ Ex. 1010, U.S. Publication No. 2016/0127952 (“You”).

⁴ Ex. 1012, Certified Translation of International Patent Publication WO 2013/027963 (“Kim”).

⁵ Ex. 1004, U.S. Patent No. 11,470,619 (“Lee”).

⁶ Ex. 1006, International Patent Publication WO 2014/048487 (“Zhang”).

Petitioners' invalidity contentions include claim charts addressing the same references asserted by Petitioners (You, Kim⁷, Lee, and Zhang⁸) in every ground of its Petition for every claim challenged in the co-pending litigation. *See, e.g.*, Exs. 2004, 7, 13, 16 (cover pleading); Ex. 2032 (Appx. B); Ex. 2033 (Ex. B-1) (You); Ex. 2034 (Ex. B-2) (Kim); Ex. 2035 (Ex. B-4) (Lee); Ex. 2036 (Ex. B-6) (Lee). Petitioners provide no justification for delaying over eight months to file its Petition when it had developed its invalidity theories sufficiently to include them in a district court pleading months earlier. Patent Owner and Petitioners will have expended substantial resources in 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 29, 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, and is complete as of April 14, 2025. Further, Petitioners served

⁷ Kim and its counterpart are substantially the same. Specifically, Kim is a PCT publication based on PCT application PCT/KR2012/006493. *See* Ex. 1019, 1 (item 21). Its counterpart is a national stage entry of PCT application PCT/KR2012/006493. Ex. 2030 (item 86).

⁸ Zhang and its counterpart are substantially the same. Specifically, Zhang is a PCT publication based on PCT application PCT/EP2012/069193. *See* Ex. 1019, 1 (item 21). Its counterpart claims priority to PCT application PCT/EP2012/069193. Ex. 2031 (item 30).

their expert witness disclosures under Fed. R. Civ. P. 26(a)(2) relating to their invalidity contentions on April 21, 2025, and Patent Owner was required to similarly serve its 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 '931 patent are invalid under 35 U.S.C. § 112(a) and § 112(b). *See* Ex. 2004, 357-360, 365-66. Thus, the district court will be in the best position to resolve all of the validity issues relating to the '931 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 29, 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. 1014, 4 (setting the deadline for dispositive motions); *id.*, 2 (setting the deadline to disclose final invalidity theories); Ex. 2204 (same). Should the Board institute, the Parties will effectively duplicate the efforts expended in the District Court to address the validity of the '931 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.

Petitioners assert two grounds in their Petition, and each Ground applies to all challenged claims (claims 1-7), including independent claims 1, 4, and 7. Ground 1 contends that the claims, are obvious over You and Kim, while Ground 2 contends that the claims are obvious over Lee in view of Zhang.

Similarly, in district court, Petitioners' invalidity contentions challenge the same set of claims, claims 1-7 of the '931 patent based on the same references. *See* Exs. 2004, 7, 13, 16 (cover pleading); Ex. 2032 (Appx. B); Ex. 2033 (Ex. B-1)

(You); Ex. 2034 (Ex. B-2) (Kim); Ex. 2035 (Ex. B-4) (Lee); Ex. 2036 (Ex. B-6) (Lee). Thus, there is substantial overlap between the Petition and the district court proceeding, as the claims challenged and most of the primary references relied upon are 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 at least the You, Kim, and Lee disclosures. *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”). 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).

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 7 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 ’931 patent, and the existence of other litigated claims does not diminish the perfect overlap between the claims in this IPR and the same seven 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. 1014, Ex. 2204),⁹ 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*,

⁹ 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.

IPR2020-00019, Paper 15 at 15). Factor 5 weighs strongly in favor of denial for the same reasons presented above for Factor 2.

F. Factor 6 Favors Denial (Other Factors)

Also weighing in favor of denial are at least two other factors: the manner in which Petitioners’ various IPR challenges have been presented, and the substantive defects in the Petition.

i. Petitioners’ Staggered Petitions Weigh in Favor of Denial

The litigation dispute between Patent Owner and Petitioners involves 11 patents, and the three federal litigations involving those 11 patents were filed in the 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 deadline¹⁰:

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 (denied)	N/A

¹⁰ Google joined the Petitioners as an additional petitioner in each of these IPR proceedings except for IPR2025-00036 and IPR2025-00037.

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Filing Date	IPR	Notice of Filing Date	Date of Institution Decision (Est.)	Date of Final Written Decision (Est.)
10/18/24	IPR2025-00037	10/30/24	4/25/25 (denied)	N/A
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

Two of Petitioners' other IPRs—IPR2025-00036 and IPR2025-00037—have already been denied institution by the Board under *Fintiv*, on April 25, 2025, due to the extensive activities that have already occurred in the co-pending litigation, the schedule of the upcoming trial, and the overlap in parties between those IPRs and the litigation. This IPR is one of nine remaining decisions on institution the Board or Director needs to make relating to the dispute between the Parties. As the Board or Director will approach the 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., 68 (“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” (Pet., 83; *see also* Ex. 1015) and the consolidated action is progressing at pace towards a September 2025 trial date.

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, 357-360, 365-66), those issues must be heard by the District Court.

ii. Petitioners' Weak Challenges Also Weigh in Favor of Denial

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.

1. Petitioners Fail to Address How the Asserted References Allegedly Disclose the Claimed “Structural Information”

Initially, the Petition fails to address how the asserted references allegedly disclose, suggest, or otherwise render obvious the claimed “structural information” in the challenged claims. Element 1.1 recites, in relevant part, “receiving structural information that contains at least one of i) information on a resource allocated to an uplink control channel for transmitting the response information and ii) start offset information on the resource allocated to the uplink control channel.”

As noted above, Petitioners present no claim construction theories and do not otherwise reveal to the Board what they believe the claimed “structural information” means or includes. Further, Petitioners present no explanation to the Board of how this feature is satisfied. Rather, Petitioners focus solely on the “information on a resource allocated to an uplink control channel” aspect of element 1.1, without addressing how or why such information satisfies the claimed

requirement of “structural information.” For example, in Ground 1, Petitioners assert that “You discloses a UE receiving structural information on a resource allocated to an uplink control channel ($\eta_{PUCCH}^{(1,p)}$)...” without addressing how or why this information satisfies the claimed requirement of “structural” information. Pet., 21-22. Looking to Kim, Petitioners rely on Kim’s $N_{PUCCH}^{(1)}$ as allegedly disclosing “start offset information,” and look also to Kim to allegedly disclose an “absolute start location.” Pet., 23. But again, in no instance do Petitioners explain to the Board what is meant by the claimed requirement to receive “structural” information, or how these references allegedly satisfy that claimed requirement. This failure constitutes a failure of proof in the Petition.

Ground 2 suffers from a similar failure of proof. There, Petitioners rely on Lee’s “configuration parameter” as the claimed “information on a resource allocated to an uplink control channel,” but fail to explain how or why Lee’s “configuration parameter” is viewed as allegedly disclosing the claimed “structural” information. Pet., 49. Petitioners’ reliance on Zhang is equally void of any such explanation. Pet., 49-50.

Finally, even Dr. Lanning fails to inform the Board what this claimed feature covers or how it is allegedly satisfied in each Ground. Rather, he simply parrots the conclusory assertions of the Petition on this point. *See* Ex. 1003, ¶122 (addressing element 1.1 for Ground 1), ¶214 (addressing element 1.1 for Ground

2); *see also id.*, ¶¶166, 182, 200, 201, 274, 291, 292 (quoting claim language without analysis).¹¹

As such, the Petition is facially deficient for failing to address how every claimed feature is met by the asserted references, and should be denied without institution. *See* 37 C.F.R. § 42.104(b)(3)-(4).

2. Petitioner’s Ground 1 Fails to Satisfy Element [1.6]

According to element 1.6, the claimed invention requires “wherein the start offset information of the resource allocated to the uplink control channel is configured separated from start offset information for a terminal different from the MTC terminal.” The Petition addresses this element from pp. 27-29, but fails to establish that this element is disclosed, suggested, or otherwise obvious in the asserted combination of Ground 1.

As a foundation for how this element 1.6 is missing from the asserted combination, it is helpful first to recount the Petition’s theory for how this combination allegedly discloses the claimed “start offset information.” The claimed “start offset information” is first presented in element 1.1, which recites: “receiving structural information that contains at least one of i) information on a

¹¹ A text search of Ex. 1003 reveals that the term “structural information” appears 29 times, with the first ten appearances occurring in the table of contents and another ten appearances occurring in headers quoting the claim language. Nowhere in his Declaration does Dr. Lanning explain “structural information.”

resource allocated to an uplink control channel for transmitting the response information and ii) start offset information on the resource allocated to the uplink control channel.” Addressing element 1.1, Petitioners rely on Kim’s $N_{PUCCH}^{(1)}$ as allegedly disclosing “start offset information.” Pet., 23 (“Kim further discloses that $N_{PUCCH}^{(1)}$ specifies the location after which a UE acquires its PUCCH resource, i.e., start offset information.”); *see also* Pet., 30 (addressing element 1.7, and relying on $N_{PUCCH}^{(1)}$ as allegedly disclosing “start offset information.”).

Turning back to element 1.6, which requires that the start offset information “is configured separated from start offset information for a terminal different from the MTC terminal,” Petitioners ***do not*** contend that Kim’s $N_{PUCCH}^{(1)}$ is configured differently based on whether it is for the MTC terminal or a terminal that is different from the MTC terminal. Instead, without evidentiary support to tie You’s disclosures to the claimed language, Petitioners allege that You discloses that a ***common search space (CSS)*** is configured differently for an MTC UE and a legacy UE. Pet., 28. Petitioners state, “You further discloses that the CSS of an MTC/UE terminal is configured differently for a terminal that is different from the MTC terminal.” *Id.*

Petitioners then conclude—without explanation—that a “POSITA understood that because the CSS region of the PDCCH of a non-MTC terminal is configured differently than the CSS region of the PDCCH of an MTC terminal, the

resource allocated to the uplink control channel of a non-MTC terminal would be configured differently from the resource allocated to the uplink control channel of an MTC terminal.” Pet., 28-29 (citing Ex. 1003, ¶148). From this conclusory assertion, Petitioners then turn to an unsupported inherency theory to contend—also without explanation—that a “POSITA thus understood that the start offset information of an MTC terminal would be necessarily different from the start offset information of a non-MTC terminal.” Pet., 29 (citing Ex. 1003, ¶148).

Nowhere in the Petition do Petitioners explain why a CSS region configuration would lead to an inherent disclosure of element 1.6. This is conclusory in violation of 37 C.F.R. § 42.104(b)(3)-(4), and relies upon expert testimony for claimed features in lieu of patents and printed publications as required by 35 U.S.C. § 311(b).

Moreover, ¶148 of Dr. Lanning’s Declaration offers no further insight into Petitioners’ theory on this element. As shown below, his testimony is similarly conclusory and fails to support the assertions founded upon inherency.

148. As mentioned in XI.A.2.a.vi, the resource allocated to the uplink control channel is configured based on, in part, the first CCE used for transmission of the corresponding PDCCH. Ex. 1011 (You '456), p. 28. Thus, a POSITA would have understood, that because the CSS region of the PDCCH for a non-MTC terminal is configured differently than the CSS region of the PDCCH for an MTC terminal, the resource allocated to the uplink control channel of a non-MTC terminal would likewise be configured differently from the resource allocated to the uplink control channel of an MTC terminal.

Ex. 1003, ¶148. This testimony fails to explain the basis for the opinions offered, and should be rejected as conclusory. *See* 37 C.F.R. § 42.65(a).

Petitioners also point to Kim for element 1.6, but the explanation there is no more insightful than the Petition's insufficient reliance on You. Specifically, Petitioners rely on Kim's ¶117, and discussion of "configuring a set of additional dynamic PUCCH resources separately from a set of cell-specifically configured conventional dynamic PUCCH resources." Pet., 29 (quoting You, ¶117). But once again, Petitioners offer no explanation of how this disclosure ties into Petitioners' earlier theory that You's $N_{PUCCH}^{(1)}$ satisfies the claimed "start offset information" or how the "start offset information" is configured differently from an MTC terminal versus a non-MTC terminal (or "other" terminal), as required by element 1.6.

Petitioners' theories of inherent disclosure therefore fail for element 1.6.

3. Petitioner's Ground 1 Also Fails to Satisfy Elements [3.5], [5.4], and [7.4]

Petitioners do not separately address elements 3.5, 5.4, and 7.4, and instead simply refer back to the arguments presented for element 1.6. Thus, for the same reasons that Petitioners' theory for element 1.6 fails, so do Petitioners' theories for elements 3.5, 5.4, and 7.4.

4. The Petition Fails to Establish that Lee is Prior Art for All it Discloses

Lee (Ex. 1004) was filed as a PCT application on August 7, 2014, and claims priority to two provisional applications, one filed on August 7, 2013 (Ex. 1005) and one filed on July 6, 2014.

The '931 patent was filed as a PCT application on September 22, 2014, and claims priority to two Korean applications, one filed on September 27, 2013, and one filed on May 14, 2014. Importantly, both Korean priority applications were filed *before* Lee's second provisional application. As Petitioners acknowledge, the '931 patent applicant submitted a certified translation of the priority document KR 10-2013-0115367. *See* Ex. 1002, 434-462; *see also* Pet., 8 n.1. Petitioners also do not dispute that the '931 patent is entitled to its September 27, 2013 priority date. Pet., 8-9 ("For this Petition, the [priority date] issue does not need to be resolved because each of the cited prior art references is prior art to the Challenged Claims

of the ’931 Patent regardless of whether the Challenged Claims are entitled to the filing date of the ’367 Provisional or the ’938 Provisional.”).

In the Petition, Petitioners treat Lee as prior art as of the earliest provisional filing date, August 7, 2013. This is contrary to Federal Circuit precedent. *See In re Riggs*, Case No. 2022-1945 (Fed. Cir. Mar. 24, 2025) (“It makes no sense to suggest that if a single claim is supported by the provisional application, then everything in the later filed application gets the benefit of the provisional date whether supported or not.”). While Petitioners contend that “citations to Lee include citations to EX-1004 and EX-1005” (Pet., 15), Lee (Ex. 1004) is only entitled to its earliest provisional date for what is actually disclosed in Ex. 1005. Citations in the Petition to Lee’s Ex. 1004 therefore should be disregarded.

5. Petitioner’s Ground 2 Fails to Satisfy At Least Element [1.9]

In addition to the Ground 2 deficiencies presented in Section IV.A and Section IV.D above, Ground 2 is also deficient in addressing element 1.9. Element 1.9 recites, “ wherein when the response information of the downlink data of the MTC terminal is repeatedly transmitted, ***the repeated transmission is performed using a same uplink control channel resource*** in each uplink subframe in which the uplink control channel is repeatedly transmitted.” (emphasis added). Petitioners fail to establish this feature in the cited references. Specifically, Petitioners cite to Lee for “utilizing different repetitions based on coverage levels”

because Lee discloses that “the number of repetition for PDSCH for coverage enhancement may be separately configured with the number of repetitions for *PUSCH* for coverage enhancement.” Pet., 61 (citing Lee, ¶46). But Petitioners fail to address that the claim requires an uplink control channel resource, such as PUCCH, while Lee only addresses a PUSCH, or physical uplink shared channel. *See* '931 patent, 5:40-42. Moreover, as the '931 patent explains, these are different channels designed to carry different types of information. Control channels like PUCCH transmit control information, while shared channels like PUSCH are data channels to transmit data. '931 patent, 5:31-42.

Moreover, Petitioners never even attempt to explain why Lee's disclosures regarding PUSCH would have been extended to PUCCH. Rather, without pointing to a disclosure in a patent or printed publication as required under 35 U.S.C. § 311(b), they instead contend that “repeated transmission of a PUCCH resource for HARQ ACK/NACK using a single, identical PUCCH resource in each subframe was well known in the art.” Pet., 61 (citing Dr. Lanning's Declaration, ¶253). Even Dr. Lanning relies on a POSITA's knowledge rather than a patent or printed publication for this feature. *See* Ex. 1003, ¶253.

While Petitioners contend that “Lee discloses limitation [1.9]” (Pet., 61), this is plainly incorrect, and Petitioners offer no reason why Lee's disclosures regarding PUSCH would have been obvious as a basis to modify a PUCCH

resource. As such, the Petition suffers from a clear failure of proof as to element 1.9.

6. Petitioner's Ground 2 Also Fails to Satisfy Elements [3.8], [5.7], and [7.7]

Petitioners do not separately address elements 3.8, 5.7, and 7.7, and instead simply refer back to the arguments presented for element 1.9. Thus, for the same reasons that Petitioners' theory for element 1.6 fails, so do Petitioners' theories for elements 3.8, 5.7, and 7.7.

7. Conclusion

Thus, the Petition fails with regard to Grounds 1-2 as to independent claims 1, 3, 5, and 7, along with corresponding dependent claims 2, 4, and 6.

iii. Overall, Factor 6 Weighs in Favor of Denial

Even if the Director or 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"). Regardless of whether the Board chooses to evaluate the merits of the challenges, the remaining *Fintiv* factors overwhelmingly favor denial.

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.

III. CONCLUSION

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

Dated: April 28, 2025

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CERTIFICATE OF WORD COUNT

The undersigned certifies that the foregoing PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL 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 8,055 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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CERTIFICATE OF SERVICE

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

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