UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

ENTROPIC COMMUNICATIONS, LLC,
Patent Owner.

IPR2025-00185
Patent 9,866,438

PETITIONER'S BRIEF AGAINST DISCRETIONARY DENIAL

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PETITIONER'S LIST OF EXHIBITS

Ex. 1036:	U.S. Patent No. 9,866,438 ("the '438 patent")
Ex. 1002:	Expert Declaration of Sayfe Kiaei
Ex. 1003:	Curriculum Vitae of Sayfe Kiaei
Ex. 1004:	Certified Prosecution History of the '438 patent
Ex. 1005:	U.S. Pub. No. 2007/0223512 ("Cooper")
Ex. 1006:	U.S. Provisional Patent App. No. 60/785,647 ("Cooper Provisional")
Ex. 1007:	Reserved
Ex. 1008:	Reserved
Ex. 1009:	Reserved
Ex. 1010:	Reserved
Ex. 1011:	Reserved
Ex. 1012:	U.S. Patent No. 10,084,538 ("Nielsen")
Ex. 1013:	U.S. Pub. No. 2013/0004179 ("Nielsen179")
Ex. 1014:	Reserved
Ex. 1015:	U.S. Patent No. 7,573,822 ("Monk")
Ex. 1016:	U.S. Patent No. 6,772,437 ("Cooper437")
Ex. 1017:	Claim Construction Memorandum Opinion and Order, *Entropic Comms., LLC v. Charter Comms., Inc.*, Case No. 2:22-CV-00125-JRG (E.D. Tex.)
Ex. 1018:	Rebuttal Expert Report of John Holobinko Regarding Validity of U.S. Patent Nos. 8,284,690 and 10,135,682, *Entropic Comms., LLC v. Charter Comms., Inc.*, Case No. 2:22-CV-00125-JRG (E.D. Tex.)

Ex. 1019:	Exhibit F, U.S. Patent No. 10,135,682 Exemplary Infringement Chart, *Entropic Comms., LLC v. Charter Comms., Inc.*, Case No. 2:22-CV-00125-JRG (E.D. Tex.)
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Ex. 1025:	U.S. Patent No. 8,503,546 ("Ashrafi")
Ex. 1026:	Tanenbaum, "Computer Networks," 4th ed. (2003)
Ex. 1027:	Driscoll, "Next Generation IPTV Services and Technologies" (2008)
Ex. 1028:	U.S. Pub. No. 2005/0097617 ("Currivan")
Ex. 1029:	U.S. Patent No. 10,135,682 ("the '682 patent")
Ex. 1030:	U.S. Pub. No. 2008/0291840 ("Cooper840")
Ex. 1031:	U.S. Pub. No. 2005/0122996 ("Azenkot")
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Ex. 1033:	ITU-T J.222.1, *Series J: Cable Networks and Transmission of Television, Sound Programme and Other Multimedia Signals* (Jul. 2007)

Ex. 1034	"[Tentative] Claim Construction Order," *Entropic Communications, LLC v. Comcast Corporation*, No. 2:23-cv-01050 (C.D. Cal. filed Feb. 10, 2023) and *Entropic Communications, LLC v. Cox Communications, Inc.*, No. 2-23-cv-01049 (C.D. Cal. filed Feb. 10, 2023) (collectively, "CA litigation")
Ex. 1035	U.S. Patent No. 6,816,463 ("Cooper463")

I. INTRODUCTION

The petitions for *inter partes* review ("IPR") of U.S. Pat. No. 9,866,438 (the "'438 Patent") filed by Petitioner Comcast Cable Communications, LLC ("Petitioner") are strong, timely, and merit institution. The petitions assert new prior art and arguments that prove the obviousness of the '438 Patent claims. The petitions were filed as a direct result of a request, by Patent Owner Entropic Communications, LLC ("Patent Owner"), to add the '438 Patent to its complaint against Petitioner in *Entropic Communications, LLC v. Cox Communications, Inc.*, 2:23-cv-01049 (C.D. Cal.) (the "Litigation"). A trial date has not been set in the Litigation, a conditional stay has already been granted for Petitioner, and the District Court has not yet granted leave for Patent Owner to amend its complaint to add the '438 Patent. *See Twitch Interactive, Inc. v. Razdog Holdings, LLC,* IPR2025-00307, IPR2025-00308, Paper 18 at 2 (P.T.A.B. May 16, 2025) (Director Stewart denying discretionary denial because there was "no currently scheduled trial date" and due to "persuasive evidence" that stay would be granted). The petitions also merit institution at least because (1) there is no sign that a trial date will be set in the Litigation any time soon, (2) Comcast's case is currently stayed and Patent Owner and Petitioner agree that it should remain stayed apart from potential motion practice related to the pleadings, (3) an IPR would address the validity of more of the claims than the

Litigation would, and (4) the Board can resolve the validity of the ’438 Patent and thereby expedite resolution the parties’ dispute.

Patent Owner’s Brief in Support of Discretionary Denial (the “Brief”) improperly blurs the distinction between two different patents, and misapplies the law regarding discretionary denial under 35 U.S.C. § 325, 35 U.S.C. § 314, and *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017) (precedential) (“*General Plastic*”). Patent Owner, having argued in the Litigation that the ’438 Patent is different from the U.S. Pat. No. 10,135,682 (the “’682 Patent”) (*see* Ex. 2009 at 2), now contends that the two are “similar” and “overlap” with respect to a previous petition for IPR of the ’682 Patent. *See* Brief at 2, 12. But, given there was never a previous IPR regarding the “same claims of the same patent” (*i.e.*, the ’438 Patent), *General Plastic* simply cannot apply. *General Plastic,* Paper 19 at 9. Similarly, discretionary denial is not appropriate under section 325(d): there is no other “proceeding or matter involving the [’438] patent [that] is before the Office,” and the art/arguments here are different than those previously presented to the Office with regard to the ’438 Patent (*or* the ’682 Patent). 35 U.S.C. § 325(d). Denial under section 314(a) is also not warranted because the factors from both *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (“*Fintiv*”) and the March 26, 2025, “Interim Processes

for PTAB Workload Management" (the "Interim Processes") favor institution or are, at worst, neutral.

Since both the facts and the law strongly favor institution, the Board should grant institution of at least one petition and not reward Patent Owner for delay in asserting a new allegation of infringement, contradictory arguments regarding the alleged similarity of different patents, and mischaracterizations of this Board's own precedent.

II. *GENERAL PLASTIC* IS INAPPLICABLE: THE '438 PATENT IS NOT THE '682 PATENT.

The '438 Patent is not the '682 Patent. Thus, *General Plastic* is inapplicable because there is no previous IPR filing against the "same claims <u>of the same patent</u>." *General Plastic,* Paper 19 at 9 (emphasis added).

Patent Owner improperly tries to wield the '682 Patent IPR institution denials against petitions directed to a different patent, relying on subjective terms like "closely related" to argue that the patents are similar and thus Petitioner is burdening the Patent Owner with "serial" petitions. *See, e.g.*, Brief at 3, 4, 5, 12, 17. This is incorrect: the patents are different, and *General Plastic* does not apply. Patent Owner's own actions in the Litigation demonstrate that the '438 and '682 Patents are different: when requesting permission to amend its complaint in the Litigation to add the '438 Patent to the Litigation, Patent Owner argued that it "only recently" discovered "facts establishing a good-faith basis to assert the '438 Patent" months

after filing the original complaint. Ex. 2009 at 2; Ex. 2010 at 1.[1] When seeking permission to add the '438 Patent, Patent Owner described the two patents as only "somewhat similar" (in contrast to describing several other patents as "substantially similar" to one another). Ex. 2009 at 10. Patent Owner, having argued in the Litigation that Patent Owner could not have asserted the '438 Patent in its original complaint due to material differences from the '682 Patent, cannot now complain that Petitioner failed to proactively file an IPR against the '438 Patent due to an alleged "overlap," especially when the '438 Patent was not originally asserted in the Litigation. If an "earlier challenge was well within" Petitioner's reach here (*See* Brief at 29), it was certainly "well within" Patent Owner's reach to assert the '438 Patent in its original complaint. Patent Owner's use of terms like "overlap," "similar," and "closely related" (*See, e.g.*, Brief at 3, 4, 5, 12, 17) do not change this fact.

Petitioners should not be required to challenge each and every potentially "overlap[ping]" family member when it petitions for IPR against any patent in the family. Requiring Petitioners to file IPRs against unasserted but "similar" patents, or risk a future denial if such a patent is later asserted, would burden petitioners and

[1] Ex. 2009 discusses a motion for leave to amend a complaint against co-defendant Cox; however, Ex. 2010 clarifies that this motion also applied against Petitioner.

the Board (and likely draw complaints from patent owners). This runs directly contrary to the goals of the Interim Processes.

III. THE PETITIONS ARE A TIMELY RESULT OF PATENT OWNER'S LITIGATION TACTICS

Patent Owner suggests that Petitioner "took the opportunity to wait" to file the '438 Patent petitions only after learning how the "Board would respond" to the '682 Patent petitions. Brief at 28. To the contrary, the '438 Patent *still* has not been formally added to the complaint in the Litigation, and Petitioner proceeded with these IPRs shortly after a Special Master in the Litigation provided a (not yet adopted) recommendation that Patent Owner be allowed to amend its complaint to add the '438 Patent. *See* Ex. 2016. The timing of the petitions is thus the consequence of Patent Owner's Litigation tactics, and any "unfair advantage" is a result of Patent Owner belatedly deciding to add the '438 Patent to the Litigation.

Petitioner cannot be faulted for assuming the '438 Patent would not be asserted in the Litigation. Patent Owner's original Feb. 10, 2023, complaint asserted eight patents (out of a total of twenty different patents asserted by Patent Owner against Petitioner in two different cases) but did not include the '438 Patent, (Ex. 2007 at 2), even though the '438 Patent issued years before the complaint was filed. (Ex. 1001 at 1 (patent issued Jan. 9, 2018)). Petitioner sought IPRs on certain of those originally asserted patents in February 2024. *See* IPR2024-00432 through IPR2024-00445.

The Board should not reward Patent Owner for delaying its ’438 Patent infringement allegations in the Litigation. It would be unfair and invite gamesmanship to allow patent owners to avoid IPR challenges against patents by delaying those patents’ assertion relative to other, allegedly similar patents.

IV. DENIAL UNDER § 325(D) WOULD BE IMPROPER

35 U.S.C. § 325(d) does not warrant discretionary denial. Denial based on section 325(d) would be improper because the art and arguments (whether made during prosecution of the ’438 Patent or made in the ’682 Patent IPR petitions) are not the “same or substantially the same” as those presented here. And, even if the Board finds that the same or substantially the same art and/or arguments were presented, the Office’s consideration of such art/arguments erred in a “manner material to the challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (“*Advanced Bionics*”).

A. The Art/Arguments Cited During Prosecution of the ’438 Patent are Different

Section 325(d) provides that “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). Many references cited in the present petitions (*e.g.*, Cooper840, Monk, Cooper437) were never previously presented to the Office and thus cannot be “the same or

substantially the same." And, the references that were previously presented (Currivan, Azenkot, Prodan) still do not warrant discretionary denial because the art combinations and arguments were not "the same or substantially the same." *Id.*

Currivan and Azenkot were indicated as "considered" in an IDS during prosecution of the '438 Patent (*See* Ex. 1004 at 159), but neither were "evaluated during examination" or used as "the basis for [a] rejection," and there were no "arguments made during examination." *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (P.T.A.B. Dec. 15, 2017) ("*Becton, Dickinson*"). Their mere listing in an IDS does not favor discretionary denial. *Thorne Research, Inc. v. Trustees of Dartmouth College,* IPR2021-00491, Paper 18 at 7-9 (P.T.A.B. Aug. 12, 2021) ("that one piece of art from the combination was previously presented and/or argued to the Office alone is insufficient to satisfy the first prong of *Advanced Bionics*"); *Grimco, Inc. v. Principal Lighting Group, LLC*, IPR2021-00968, Paper 13 at 19-21 (P.T.A.B. Nov. 22, 2021) (previously-cited art merely used "in a minor capacity"); *Micron Tech., Inc. v. Yangtze Memory Techs. Co., Ltd.*, IPR2024-00788, Paper 13 at 35 (P.T.A.B. Nov. 7, 2024) (citation in IDS does not "weigh[] . . . fully" in favor of denying institution); *Groupon Inc. v. Kroy IP Holdings, LLC*, IPR2019-00044, Paper 14 at 11 (P.T.A.B. Apr. 19, 2019) (mere citation in IDS not "sufficient to exercise our discretion to decline institution").

Prodan is only used in one petition (IPR2025-00184) of the three petitions filed by Petitioner against the ’438 Patent. Prodan was used in a rejection during prosecution of the ’438 Patent, but the art combinations and arguments presented in the petitions are not the “the same or substantially the same,” and thus discretionary denial is still unwarranted. During prosecution, the Office rejected claims using Prodan and Richardson but conceded that “Prodan does not explicitly teach that the composite SNR related metric is generated ‘based on a portion of the plurality of SNR related metrics corresponding to a group.’” Ex. 1004 at 75-77. The applicant then amended claim 1 to recite “a composite SNR-related metric based <u>at least in part</u> on a ~~portion~~ <u>worst-case SNR profile</u> of said plurality of SNR-related metrics . . ..” *Id.* at 105, 129-130. The application was subsequently allowed without further rejections. *Id.* at 147. Regarding that alleged deficiency regarding Prodan, Petitioner relies on newly-presented Cooper840, which has never been before the office, and Azenkot, which was never used in a rejection by the Office. Petitioner thus presents entirely new art (*e.g.*, Cooper840) and art combinations (*e.g.*, using Azenkot) and thereby presents new arguments using combinations of references that were never considered by the Office, are not cumulative, that were not evaluated during prosecution, have no overlap in arguments made during prosecution, and which merit reconsideration of the allowance of the ’438 Patent. *See Agrofresh Solutions Inc. v. Lytone Enterprise, Inc.*, IPR2021-00451, Paper 11 at 12-13

(P.T.A.B. July 27, 2021) (art/argument not substantially the same when previously-presented art used "in a different manner than the rejections made by the Examiner"). The Examiner materially erred in not considering these key secondary references, which would have merited further rejection(s), rather than an allowance without further inquiry. *See* Paper 2 at 15; *Advanced Bionics* at 8 n. 9 (an "example of a material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims"). And, even if the prior use of Prodan during prosecution somehow merited denial (it does not), it would only affect the second of three petitions filed against the '438 Patent.

The art and arguments here are also different because they show material error in allowance of the '438 Patent. The '438 Patent was allowed after the claims were amended in prosecution to recite "a composite SNR-related metric based <u>at least in part</u> on a <u>worst-case SNR profile</u> of said plurality of SNR-related metrics corresponding to said one of said plurality of service groups." Ex. 1004, 105, 107-108 (emphasis in original), 112, 152-154. But each secondary reference teaches this concept. For example, Cooper840 (never cited during prosecution) teaches that "[i]deally, we want to set the modulation profile as a function of the lowest [modulation error ratio] in the network element pool," later indicating that cable modems could be grouped by modulation error ratio and/or SNR. Ex. 1030, [0004],

[0031], [0006], [0028], [0032]; Ex. 1002, ¶¶ 101-103. As another example, Azenkot (only cited in an IDS during prosecution) uses a CMTS to group cable modems by SNR into logical channels, and sets a burst profile that all CMs within a group must use that (i) is tailored to the throughput abilities of the modems in a group, and (ii) is based on the "least capable cable modem" in the group (thereby allowing for communications with the least capable CM). Ex. 1031, [0001], [0007], [0013], [0016], [0040]-[0041], [0089], [0092]. In turn, the Office would never have allowed the '438 Patent had it properly considered the teachings of these references.

The material errors made during the Office during prosecution of the '438 Patent are similar to those in *Google LLC v. Dialect, LLC*, IPR2024-00752, Paper 11 (P.T.A.B. Oct 23, 2024) ("*Dialect*"). In *Dialect*, the Examiner cited two references, but overlooked specific teachings of those references when allowing a patent to issue. *Dialect,* Paper 11 at 38. Similarly, during prosecution of the '438 Patent, the Office cited Prodan but materially erred because it did not know about and thus overlooked, the teachings of Cooper840 and/or Azenkot. *See Advanced Bionics,* 8-9 & n. 9.

B. The '682 Patent IPRs Were Not "Another Proceeding or Matter Involving the Patent" and Did Not Present "the Same or Substantially the Same" Art/Arguments

Denial under section 325(d) based on activity relating to the '682 Patent is not merited because the '438 Patent is not the '682 Patent. *Advanced Bionics* is clear:

"[u]nder § 325(d), the art and arguments must have been previously presented to the Office during proceedings pertaining to the challenged patent." *Advanced Bionics* at 7 (emphasis added). The '682 Patent is not the "challenged patent" here. The fact that the two patents are members of the same family is irrelevant. *See, e.g.*, *Comcast Cable Communications, LLC v. Touchstream Technologies, Inc.,* IPR2024-00322, Paper 13 at 7-8 (P.T.A.B. July 18, 2024) (*Advanced Bionics* framework not met where reference cited in family member but not challenged patent).

Even if the IPR of the '682 Patent were somehow relevant (it is not), the art and arguments here rely on newly-asserted secondary references that comprise disclosure never considered by the Office in that IPR. The '682 Patent IPR found that Petitioner did not show that the secondary references cited in that case taught "selecting the worst-case or lowest SNR of the [cable modems (CMs)] in a group to generate the claimed 'composite SNR-related metric based at least in part on a worst-case SNR profile of said SNR related metrics.'" *See, e.g.,* IPR2024-00445, Paper 9 at 15-16, 20-21. Here, and as more fully detailed in the petitions, such concepts are clearly taught by the secondary references, and Patent Owner's POPR focuses on these secondary references and barely discusses the primary references. *See* Paper 9 at 22-37, 40-47. In turn, the secondary references teach features that were absent from the references in the '682 Patent IPR and thus present entirely new art and arguments which warrant Board review.

Patent Owner's reliance on *ZTE (USA) Inc. v. Fractus, S.A.*, IPR2018-01457, Paper 20 (P.T.A.B. Oct. 4, 2019) ("*ZTE*") is misleading. *See* Brief at 4. In *ZTE*, the petitioner conceded that references were "previously presented to the Office" but argued that cited references were "'buried in an extremely long [Information Disclosure Statement ("IDS")]' and 'were never called out for attention." *ZTE* at 4. But the IDSs in *ZTE* also included *inter partes* review and *ex parte* reexamination papers (albeit regarding different patents) that provided analysis of the references at issue. *Id.* at 5. The *ZTE* petitioner was thus trying to argue that the Board should discount that the references were "previously presented to the Office" despite the references, as well as papers analyzing those references, being before the examiner during prosecution. *Id.* Here, no such unique fact pattern applies.

The '682 Patent IPR art/arguments are also not "the same or substantially the same" as those presented here because the focus of the arguments–the secondary references–is completely different. As Patent Owner correctly notes (Brief at 9), Petitioner used Cooper, Prodan, and Thibeault as primary references in the '682 Patent IPR petitions, and now uses them again as primary references here. But the Board did not discuss the merits of the primary references in the '682 Patent institution denials, instead only addressing secondary references Saey/Gross/Cioffi. *See* IPR2024-00444, Paper 9 at 23; IPR2024-00445, Paper 9 at 24-25. The '438 Patent IPR petitions present entirely new and different secondary references

(Cooper840 and Azenkot). Patent Owner's POPR focuses on these secondary references, barely discussing the primary references. *See* Paper 9 at 22-37, 40-47. There was thus no "extent to which the asserted art was evaluated" in the Board's '682 Patent IPR institution denials, as the Board focused on entirely different references for an entirely different patent, and even Patent Owner's own arguments thus far suggest that arguments here will hinge on the new and entirely different secondary references in the present petitions. Patent Owner nonetheless argues that these new secondary references somehow "overlap" with Say/Gross/Cioffi and are used "in substantially the same way" (*See* Brief at 12), but never purports to explain why or how. Petitioner disagrees: there are critical differences between the asserted secondary references, there is no overlap between such secondary references, and such secondary references are not cumulative.[2] *See Becton, Dickinson,* 17-18; *see also* Ex. 1002 at 27-28 (expert's summary of Cooper840 and Azenkot). Here, "primary" just means first, not most important: the entirely new "secondary" references are, by far, more important to resolution of validity of the '438 Patent.

[2] In turn, while Petitioner is not seeking to relitigate the '682 IPR institution denials, such denials could be characterized as materially erring in not considering key secondary references that would have warranted institution. *See Advanced Bionics,* 8-9 & n. 9.

See In re Mouttet, 686 F.3d 1322, 1333 (Fed. Cir. 2012) (characterization of art as "primary" and "secondary" merely a "matter of presentation with no legal significance").

V. DENIAL UNDER § 314(A) WOULD BE IMPROPER

Discretionary denial under § 314(a) is improper as the factors in both *Fintiv* and the Interim Processes favor institution or are neutral.

A. The *Fintiv* Factors Favor Institution

All *Fintiv* factors favor institution or are neutral–and, in any event, a holistic view of the present circumstances encourages institution. *See Fintiv*, Paper 11 at 6 (encouraging a "holistic view of whether efficiency and integrity of the system are best served by denying or instituting review").

1. Factor 1: A Stay Has Already been Granted for Petitioner

Factor 1 favors institution because a Petitioner's district court case is stayed. A separate case in which Patent Owner asserts some of the same patents (but the '438 Patent) against another party (Cox) is also conditionally stayed pending a condition that Cox has rejected. Cox's case may thus be un-stayed but, should that occur, Petitioner expects the Cox case to proceed separately from Petitioner's case because (1) Patent Owner agrees that the stay should remain in place for Comcast subject only to potential briefing on certain pleading matters and (2) Cox has agreed that its case would proceed separately. Ex. 2016 at 3-4, 6; *see also Twitch*

Interactive, Inc. v. Razdog Holdings, LLC, IPR2025-00307, IPR2025-00308, Paper 18 at 2 (P.T.A.B. May 16, 2025) (Director Stewart denying discretionary denial because there was "no currently scheduled trial date" and due to "persuasive evidence" that stay would be granted).

In the Litigation, Judge Holcomb issued a stay as to both consolidated cases, subject to Cox's agreement to be bound "to the estoppel provisions applicable to [Petitioner under [§ 315(e)(2)]." Ex. 2014 at 11. Cox, which is not involved in any of the relevant petitions for IPR, did not agree to those conditions. Ex. 2015 at 3. However, the Court has not lifted the stay as to either case, and both Petitioner and Patent Owner expect Petitioner's case to remain stayed. Cox has stated that the Court "should deconsolidate" the cases against Cox and Comcast. Ex. 2016 at 6. Patent Owner has also indicated that not only (1) is it amenable to deconsolidation, but also (2) it is "amenable to a stay of discovery as to Petitioner, pending the Final Written Decisions in the IPRs, in order to prioritize the resolution of [other] issues, which include jurisdictional challenges." Ex. 2016 at 3-4. The existence of such a stay weighs "strongly" against exercising discretion to deny institution. *Snap v. SRK Technology,* IPR2020-00820, Paper 15 at 9 (P.T.A.B. Oct. 21, 2020) ("*Snap*"). Petitioner should not be penalized for a co-defendant's desire for deconsolidation, nor should it be forced to predict how Cox would react after such deconsolidation.

2. Factor 2: No Trial Date Has Been Set, and there is No Indication that a Trial Date will be Set Any Time Soon

Factor 2 favors institution: a trial date has not yet been set, nor has the Court suggested that it intends to set a trial date any time soon. *See Twitch Interactive, Inc. v. Razdog Holdings, LLC,* IPR2025-00307, IPR2025-00308, Paper 18 at 2 (P.T.A.B. May 16, 2025) (Director Stewart denying discretionary denial because there was "no currently scheduled trial date" and due to "persuasive evidence" that stay would be granted).

Much of the Litigation has been mired in disputes regarding consolidation (and, now, deconsolidation), motions to dismiss, and the like. *See* Ex. 2016. For example, as of May 2025, the '438 Patent is still not asserted in the co-pending litigation because Patent Owner is awaiting permission to amend its complaint to add the '438 Patent. *See id.* at 3.

There is no evidence that the Litigation (consolidated or deconsolidated) will be ready for trial any time soon, which counsels for institution. *See Sand Revolution II, LLC v. Continental Intermodal Grp.,* IPR2019-01393, Paper 24 at 9-10 (P.T.A.B. June 16, 2020) ("uncertainty" of trial schedule weighs in favor of not exercising discretion). Despite being filed in 2023, the Litigation is still in its early stages: Patent Owner is attempting to amend its complaint, the parties are still discussing deconsolidation, and Petitioner is planning to move again to dismiss. *See* Ex. 2016. As of the filing of this document, there is no case schedule and no *Markman* order.

And, even assuming that the Final Written Decision deadline could somehow occur around the same time as a trial date, this still weighs against discretionary denial. *See, e.g.*, *Ericsson Inc. v. XR Commc'ns LLC,* IPR2024-00868, Paper 8 at 29, 31 (P.T.A.B. Dec. 13, 2024) (*Fintiv* factor 2 against denial when "district court trial is likely to occur less than five months before" final written decision ("FWD")); *Ericsson Inc. v. XR Commc'ns LLC*, IPR2024-00613, Paper 9 at 34 (P.T.A.B. Oct. 9, 2024) (*Fintiv* factor 2 against denial even when trial date less than five months from possible FWD).

3. Factor 3: The Investment in the Litigation Regarding the '438 Patent is *De Minimis*

Factor 3 favors institution: the District Court has not even started to examine the validity of the '438 Patent. Patent Owner has not yet been granted leave to amend its complaint to add its '438 Patent infringement allegations. *See* Ex. 2016. The District Court has not performed claim construction regarding the '438 Patent or issued any orders relating to the '438 Patent. *See Fintiv,* Paper 11 at 10. The investment by the District Court with respect to the '438 Patent is thus minimal. *Snap*, Paper 15 at 10 (even where infringement/invalidity contentions exchanged and Markman positions exchanged, finding District Court "has not substantially invested in the case"); *see also Sotera v. Masimo Wireless,* IPR2020-01019, Paper 12 at 17 (P.T.A.B. Dec. 1, 2020). The fact that Petitioner filed this petition expeditiously (*e.g.*, not long after the Special Master recommended allowing Patent Owner to add

the ’438 Patent to its complaint) also favors institution. *Snap*, Paper 15 at 11 (diligence of petitioner weighs against denying institution under factor 3).

4. Factor 4: This IPR Would Handle All Claims, the Litigation Only a Fraction

Factor 4 favors institution. This proceeding is broader than the District Court litigation: these petitions challenge all claims in the ’438 Patent, whereas Patent Owner’s proposed (but not yet permitted) amendments to its complaint only assert claims 1-5 and 9. Ex. 2011 at 72. This IPR would thereby expeditiously resolve the validity of the entirety of the ’438 Patent, whereas the Litigation might only pertain to a handful of claims. *See Samsung Display Co., Ltd. v. Pictiva Displays Int’l Ltd.*, IPR2024-01222, Paper 12 at 8 (P.T.A.B. Mar. 6, 2025) (finding that the “additional challenged claims not at issue in the district court” weigh “against exercising discretion to deny institution”); *see also Snap,* Paper 15 at 15; *Samsung Bioepis Co. v. Regeneron Pharm., Inc.*, IPR2023-00739, Paper 9 at 58 (P.T.A.B. Oct. 20, 2023). Moreover, since the ’438 Patent is not yet formally added to the Litigation, an IPR should resolve validity issues faster than the Litigation, meaning that there is little risk of conflicting decisions. *See Fintiv,* Paper 11 at 12.

5. Factor 5: The Parties’ Relationships Do Not Favor Denial

Factor 5 is at worst neutral because it does not squarely address the present posture of the parties.

Petitioner is a party in the Litigation, which makes this factor neutral: *Fintiv* "says nothing about situations in which the petitioner is the same as, or is related to, the district court defendant." *See Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 11 (P.T.A.B. May 15, 2020) (APJ Crumbley, dissenting) (disfavoring a "defendant in the district court" is "contrary to the goal of providing district court litigants an alternative venue to resolve questions of patentability"); *Fintiv* at 13-14 (saying nothing about situations in which the petitioner also is the district court defendant). While some Board decisions find this factor favors denial in situations where a trial date is soon, that is not the case here. *See Sand Revolution II, LLC v. Continental Intermodal Grp.,* IPR2019-01393, Paper 24 at 12-13 (P.T.A.B. June 16, 2020); *Sotera v. Masimo Wireless,* IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020).

Cox's presence as a co-defendant in the consolidated Litigation should, if anything, tip this factor in favor of institution. Cox is not the Petitioner, and there is no indication that the issues litigated by Cox (consolidated or not) would be the "same as, or substantially similar to" those here. *See Fintiv,* Paper 11 at 13-14*; see also Comcast Cable Communications, LLC v. Touchstream Technologies, Inc.*, IPR2024-00322, Paper 13 at 13 (P.T.A.B. July 18, 2024) (co-defendant "not a real party in interest" to IPR and thus Petitioner "'cannot be held responsible for [invalidity contentions] of [the co-defendant]'").

6. Factor 6: Petitioner Deserves Efficient Resolution of Validity

Factor 6 favors institution because of the strong merits of Petitioner's petitions, filed as a direct result of Patent Owner's litigation tactics, and because of Petitioner's need for efficient and cost-effective resolution of the validity of the '438 Patent.

Petitioner's filing approach is Board-approved and proportional to Patent Owner's infringement contentions. Patent Owner complains about the "volume and excessiveness" of petitions filed by Petitioner, alleging that Petitioner is a "serial filer of parallel petitions." Brief at 3, 23. But the Board has previously found (in an IPR between the exact same parties) that the filing of three parallel petitions with multiple grounds "complied with [the Board's] guidance." *Comcast Cable Communications, LLC v. Entropic Communications, LLC,* IPR2024-00432, Paper 13 at 10 (P.T.A.B. Oct. 8, 2024). These parallel petitions often reflect the strength of Petitioner's invalidity assertions: when Petitioner has previously filed parallel petitions, the Board has typically granted *at least* one, and the decisions in those IPRs almost always rule all challenged claims unpatentable. *See, e.g.,* IPR2019-00237 to -00239 (2 petitions instituted against patent, all claims unpatentable), IPR2019-00290 to -00292 (same). Regardless, Petitioner's filings are proportional given Patent Owner's assertion of twenty different patents (and, if the District Court grants leave, two additional patents) against Petitioner across multiple cases.

Petitioner's allegedly "serial" petitions (*See* Brief at 17) are also the result of Patent Owner's own serial litigation tactics. It was Patent Owner that initially asserted the '682 Patent and only later requested permission to add the '438 Patent to its complaint. If Petitioner now has a "roadmap" of Patent Owner's past arguments (Brief at 13, 24-27), that roadmap is a predictable consequence of Patent Owner's decision to add the '438 Patent well after its original complaint.

Regardless, the petitions and grounds are neither voluminous nor excessive. Petitioner filed multiple petitions against the '438 Patent because it has numerous valid grounds that deserve consideration by the Board.

The Board's caution regarding excessive grounds in *Adaptics Ltd. v. Perfect Company*, IPR2018-01596, Paper 20, 17-18 (P.T.A.B. Mar. 6, 2019) (informative) ("*Adaptics*") is inapplicable here. *See* Brief at 21-24. In *Adaptics,* the Board critiqued a "catch-all" ground purporting to combine "up to ten references" with the conjunction "and/or" because it lacked "sufficient particularity" and yielded "hundreds of possible combinations." *Adaptics,* Paper 20 at 18. The Board's reference in that case to "seventeen possible combinations" was merely proffered as a hypothetical way of limiting such an overbroad "catch-all" ground. *Id.* at 19.

Adaptics does not require that a petitioner must proactively justify the quantity of grounds that it uses. And, in any event, Petitioner's grounds here are crystal clear.[3]

B. All March 26, 2025, Interim Processes Favor Institution

To the extent that Interim Processes factors are applicable here (the petitions were filed before the Interim Processes issued),[4] they favor institution. Thus, discretionary denial is not warranted under section 314(a).

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[3] For example, the "Cooper-Cooper840-Monk-Cooper437-Currivan" ground is explained in the Petition to be an alternate ground for claim 9 that provides an alternative approach to multiple "physical layer communication parameters." Paper 2 at 71-77.

[4] Respectfully, the Interim Processes also violate the Administrative Procedures Act ("APA"). Neither 35 U.S.C. § 314(a) nor the AIA as a whole permit the Director to, for example, refuse to deny institution based on the "length of time the claims have been in force." And, even if the Director could create such processes, they are procedurally invalid for failing to comply with notice-and-comment rulemaking requirements. See 5 U.S.C. § 553(b), (c); 35 U.S.C. §§ 2(b)(2), 316(a). The Interim Processes are also arbitrary and capricious, applying a series of subjective factors (in addition to *Fintiv*) that add further uncertainty to whether a petition will be granted.

1. The District Court has not Adjudicated the Validity/Patentability of the ’438 Patent

The ’438 Patent has not even been properly added to the complaint in the Litigation, and thus it has not been adjudicated whatsoever.

2. Petitioner’s Challenges are Strong

As already discussed above, Petitioner’s challenges are strong and a direct response to Patent Owner’s litigation tactics.

3. Petitioner Properly Relies on Expert Testimony

While the petitions’ arguments and references stand on their own, Petitioner uses expert testimony to more fully explain these positions. There is currently no evidence that the parties’ dispute will devolve into a battle of experts, as Patent Owner has yet to even identify an expert, much less allege disputes in view of a conflicting expert declaration.

To support its already-sufficient petitions, Petitioner attached expert declarations of a Person of Ordinary Skill in the Art (“POSITA”). *See, e.g.,* Ex. 1002. Patent Owner nonetheless asserts that the Petition is “expert-dependent” and “factually wrong.” *See* Brief at 29-31. But, should there be a dispute on the subject, there is no better evidence of what a POSITA would understand a reference to mean than a declaration of a POSITA–that is, Petitioner’s expert.

Moreover, to the extent that Patent Owner contends that the expert is “factually wrong” (Brief at 30), Patent Owner seeks to use an attorney’s

interpretation of the references to refute a POSITA's interpretation of those same references. Such attorney argument has little persuasive value compared to a POSITA's analysis. *Wasica Fin. GmbH v. Cont'l Auto. Sys.*, 853 F.3d 1272, 1284-85 (Fed. Cir. 2017) (reasonable for Board to accept expert testimony over "bare attorney argument"); *Enzo Biochem v. Gen-Probe, Inc.*, 424 F.3d 1276, 1284 (Fed. Circ. 2005) ("[a]ttorney argument is no substitute for evidence"). Regardless, such arguments are not relevant to the "extent of the petition's reliance on expert testimony," and should thus be addressed through proper IPR institution, briefing, and oral argument, not a handful of sentences in a request for discretionary denial.

4. There Are No Settled Expectations Between the Parties

The parties have no settled expectation regarding the '438 Patent. Patent Owner "only recently" discovered "facts establishing a good-faith basis to assert the '438 Patent" in the Litigation. Ex. 2009 at 2. Petitioner is actively contesting the Litigation (including objecting to Patent Owner's attempts to amend the complaint to add the '438 Patent). The "length of time the claims have been in force" is not material here at least because the '438 Patent only issued in 2018.

5. Compelling Economic and National Security Interests Favor Institution

The Board should institute because doing so will help efficiently resolve a dispute initiated by a non-practicing entity seeking to leverage the cost and delay of patent litigation for settlement pressure.

Petitioner is a U.S.-based company, based in Philadelphia, originating from a small cable operator in Tupelo, Mississippi. Petitioner is now the 33rd largest company in the United States, and it does everything from providing broadcasting and cable television services to providing telephone services, making movies and television shows, and even running theme parks. It is in the U.S. economy's best interest to provide cost-effective resolution of patent disputes by expert administrative patent judges so that Petitioner can focus on providing its services to millions of customers across the nation.

Patent Owner is a non-practicing entity that purely focuses on portfolio development and licensing. While such enforcement of intellectual property is an important right, the U.S. economy benefits from the proper evaluation of whether such intellectual property is valid so as to avoid disrupting legitimate activity in the U.S. economy.

Patent Owner's business model relies on patent assertion and licensing, meaning that, unlike Petitioner, lengthy protracted court battles do not distract from any other business venture. Rather, such protracted battles can be financially advantageous because they pressure defendants like Petitioner to settle.

The Board is well-positioned to expedite issues between the parties and to minimize harm to the U.S. economy. If the issue of validity is addressed expeditiously (and with respect to all claims, unlike what would be the case in the

Litigation), then the parties can focus their remaining efforts on infringement of any valid patents. In turn, if the ’438 Patent is valid as Patent Owner contends, then the Board can expedite the proper assertion of a valid patent. In contrast, if the ’438 Patent is invalid as Petitioner contends, then the Board can prevent Patent Owner from exerting an improperly-held monopoly to block innovation and legitimate economic activity.

VI. CONCLUSION

Review should be instituted and claims 1-18 canceled.

Dated: May 28, 2025

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CERTIFICATION UNDER 37 CFR §42.24(d)

Under the provisions of the Interim Processes for PTAB Workload Management and 37 CFR §42.24, the undersigned hereby certifies that the word count for the foregoing Petitioner's Brief Against Discretionary Denial totals 5,980, which is less than the 14,000 allowed under 37 CFR § 42.24.

Pursuant to 37 C.F.R. §42.24(a)(1), this count does not include the table of contents, the table of authorities, mandatory notices under §42.8, the certificate of service, this certification of word count, the claims listing appendix, or appendix of exhibits.

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that I caused a true and correct copy of this **PETITIONER'S BRIEF AGAINST DISCRETIONARY DENIAL** in connection with IPR2025-00185 to be served via e-mail on May 28, 2025, in its entirety on the following counsel of record for Patent Owner:

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