

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TESLA, INC.

Petitioner,

v.

INTELLECTUAL VENTURES II LLC,

Patent Owner.

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Case No. IPR2025-00221  
U.S. Patent No. 11,664,889

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**BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR  
DISCRETIONARY DENIAL**

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## PATENT OWNER'S EXHIBIT LIST

|          |                                                                                                                                                                                                                  |
|----------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Ex. 2001 | Petitioner's Answer to Complaint and Counterclaim, dated June 20, 2024, in <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)                                               |
| Ex. 2002 | Docket from District Court Litigation, <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)                                                                                   |
| Ex. 2003 | Scheduling Order from District Court Litigation, <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.)                                                                         |
| Ex. 2004 | Defendant's Second Supplemental Preliminary Invalidity Contentions, dated January 9, 2025, in District Court Litigation, <i>Intellectual Ventures II LLC v. Tesla, Inc.</i> , C.A. 1:24-cv-00884-ADA (W.D. Tex.) |
| Ex. 2005 | EP 1681 780 (Dateki)                                                                                                                                                                                             |
| Ex. 2006 | File History of U.S. Patent Appl. 11/646,692                                                                                                                                                                     |
| Ex. 2007 | File History of U.S. Patent Appl. 13/176,298                                                                                                                                                                     |
| Ex. 2008 | File History of U.S. Patent Appl. 14/458,693                                                                                                                                                                     |
| Ex. 2009 | File History of U.S. Patent Appl. 16/682,854                                                                                                                                                                     |
| Ex. 2010 | File History of U.S. Patent Appl. 17/339,550                                                                                                                                                                     |
| Ex. 2011 | File History of U.S. Patent Appl. 17/583,369                                                                                                                                                                     |
| Ex. 2012 | File History of U.S. Patent Appl. 17/870,425                                                                                                                                                                     |

## I. INTRODUCTION

Pursuant to the Memorandum by the Acting Director dated March 26, 2025, setting forth the “Interim Processes for PTAB Workload Management” (the Memorandum), Patent Owner hereby sets forth the applicable bases for discretionary denial of institution. This filing is being made within one month of the issuance of the Memorandum. As explained more fully below, all of the *Fintiv* factors, as well as several additional factors set forth in the Memorandum and the *Advanced Bionics* framework, favor the discretionary denial of institution in this case.

With respect to the *Fintiv* factors, Petitioner filed a Counterclaim on June 20, 2024 challenging the validity of U.S. Patent No. 11,664,889 (“889 Patent,” Ex. 1001) in *Intellectual Ventures II LLC v. Tesla, Inc.*, C.A. 1:24-cv-00884-ADA (W.D. Tex.) (the “Parallel Litigation.”) Ex. 2001, at 90-91 and Ex. 2002, at 6-7. As discussed in detail below, the Parallel Litigation has already progressed significantly, including completion of Preliminary Infringement and Invalidity Contentions, and the filing of all claim construction briefing. The Court is scheduled to hold the Markman Hearing in a few days (on April 10, 2025). By the anticipated date of the institution decision in this matter (July 9, 2025), the parties will be well into fact discovery, service of Final Infringement and Invalidity Contentions will be complete, and the Court will in all likelihood have issued its claim construction ruling. Ex. 2003, 2-3. The Trial is scheduled for May 14, 2026, about 2 months

before the statutory deadline for issuing a Final Written Decision in this matter on July 9, 2026. Ex. 2003, 4.<sup>1</sup>

With respect to other factors identified in the Memorandum, the Petition relies heavily on expert testimony that largely parrots *verbatim* the wording of the Petition. Moreover, as explained below, Petitioner is attempting to use its expert to rewrite the prior art to meet the claim limitations. Use of expert testimony for this type of gap-filling is particularly inappropriate where the expert declaration largely mirrors the Petition’s language. These aspects of the Petition also weighs in favor of a discretionary denial.

Finally, discretionary denial is appropriate under the *Advanced Bionics* and *Becton Dickinson* frameworks. The Examiner was specifically directed to the pertinence of Dateki (the sole reference used to challenge the independent claims of the ‘889 Patent) and considered the disclosure of Dateki over a dozen times. The Petition has not come close to demonstrating that the Examiner erred.

For all of these reasons, and as explained more fully below, the Director should exercise her discretion to deny institution.

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<sup>1</sup> The Petition (at 76, note 4) incorrectly asserts that “[t]he district court has not entered an order scheduling a trial date.” As shown on the last page of the Court’s Scheduling Order, a jury trial is scheduled for May 14, 2026. Ex. 2003, 4.

## II. THE FINTIV FACTORS FAVOR DISCRETIONARY DENIAL

The precedential order in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB March 20, 2020) (“*Fintiv*”) identifies six factors for the Board to consider in deciding whether to exercise discretion to deny institution based on parallel proceedings involving the same patent. Application of the present facts to these factors demonstrates that there are strong reasons for exercising discretion to deny institution here.

### A. Factor 1 Weighs Against Institution Because A Stay Has Not Been Granted In The Parallel Litigation And There Is No Evidence That A Stay Would Be Granted If This IPR Was Instituted

No stay has even been requested in the Parallel Litigation. Pet., 76. In addition, even if this IPR was instituted (which would not occur until on or around July 9, 2025) it is unlikely that the Court (Judge Albright) would grant a stay. *See, generally, Continental Intermodal Grp. v. Sand Revolution LLC*, No. 7:18-cv-00147 (W.D. Tex. July 22, 2020) (Judge Albright) *Multimedia Content Mgmt. LLC v. Dish Network*, No. 6:18-CV-00207-ADA, 2019 U.S. Dist. LEXIS (W.D. Tex. May 30, 2018) (Judge Albright) (denying stay).

Thus, the first factor weighs against institution.

**B. Factor 2 Weighs Against Institution Because The Parallel Litigation Has A Trial Date Scheduled Before The Projected Statutory Deadline For The Board's Final Written Decision**

The Trial in the Parallel Litigation is scheduled for May 14, 2026, about 2 months *before* the statutory deadline for issuing a Final Written Decision in this matter on July 9, 2026. Rather than looking at the actual date trial is scheduled, the Petition relies on the median time from filing to case disposition in the Western District of Texas. However, on February 28, 2025, the Office *rescinded* former Director Vidal's 2022 memorandum on discretionary denials which had directed that such statistics be considered. The announcement rescinding former Director Vidal's 2022 memorandum went on to state that decisions relying on the 2022 memo will be "*neither binding or persuasive on the PTAB.*" In view of the above, Petitioner's arguments based on the time to trial statistics cannot be considered persuasive and must be rejected.

Given that the actual trial date is *before* the due date for the Final Written Decision, the second factor favors discretionary denial.

**C. Factor 3 Weighs Against Institution Because The Parties Will Have Invested Significant Effort In The Parallel Litigation By The Time The Board's Institution Decision Is Due**

Factor 3 relates to investment in the Parallel Litigation by the District Court and the parties. *Fintiv*, Paper 11 at 9. This factor is judged from the date of the institution decision, which is expected to be no later than July 9, 2025. *Id.* By the

time the Board's institution decision is due, the following will have been completed in the Parallel Litigation:

- PO's Preliminary Infringement Contentions (served August 1, 2024);
- Petitioner's Preliminary Invalidity Contentions (served October 24, 2024);
- Parties exchanged claim terms for construction (November 14, 2024);
- Parties exchanged proposed claim constructions (December 5, 2024);
- Parties disclosed extrinsic evidence for claim construction (December 12, 2024);
- Petitioner's Opening Claim Construction Brief (January 9, 2025);
- PO's Responsive Claim Construction Brief (February 10, 2025);
- Petitioner's Reply Claim Construction Brief (March 3, 2025);
- PO's Sur-Reply Claim Construction Brief (March 24, 2025);
- Parties technical tutorials submitted to Court (March 31, 2025);
- Markman Hearing (scheduled for April 10, 2025);
- Fact discovery (opens April 11, 2025); and
- Final Infringement and Invalidity Contentions (due May 22, 2025).

Ex. 2003, 1-3. Clearly, the parties and the Court will have made a substantial investment in the Parallel Litigation by the expected date of the institution decision on July 9, 2025.

The Petition was filed on November 25, 2024. At that time, Petitioner asserted that “[t]he investment in the co-pending litigation has been minimal.” Pet., at 76. Patent Owner disagrees that the investment in the co-pending litigation was minimal as of November 25, 2024. However, even if Petitioner’s assertion about the state of affairs on November 25, 2024 was accurate, it is irrelevant. As explained in *Fintiv*, the investment in the Parallel Litigation by the District Court and the parties is judged from the date of the anticipated institution decision, which is expected to be about July 9, 2025 -- rather than November 25, 2024. *Fintiv*, Paper 11 at 9. There can be no argument that by July 9, 2025, the District Court and the parties will have made a substantial investment in the Parallel Litigation.

Thus, the third factor weighs against institution.

**D. Factor 4 Weighs Against Institution Because There Is Substantial Overlap Between The Parallel Litigation And This IPR**

As mentioned above Petitioner filed a Counterclaim in the Parallel Litigation challenging the validity of ‘889 Patent as a whole. Ex. 2001, at 90-91. The Counterclaim is not limited to an particular claim(s) of the ‘889 Patent, and therefore covers all claims of the ‘889 Patent -- including the claims challenged in this IPR.

On January 9, 2025, Petitioner filed its Second Supplemental Preliminary Invalidity Contentions in the District Court. As explained below, there is almost complete overlap between the prior art references advanced by the Petitioner in this

IPR and those advanced by the Petitioner in the Parallel Litigation. Set forth below is a summary of the grounds raised in the Petition, and the prior art asserted in each ground:

| <b>Grounds</b> | <b>Claims</b> | <b>Basis (pre-AIA)</b>                 |
|----------------|---------------|----------------------------------------|
| #1             | 1, 2, 5, 6    | § 103 under Dateki                     |
| #2             | 3, 7          | § 103 under Dateki in view of Mate     |
| #3             | 4, 8          | § 103 under Dateki in view of Chitrapu |

Pet., 20. Set forth below is an excerpt from Petitioner’s Second Supplemental Preliminary Invalidity Contentions in the Parallel Litigation showing the prior art relied on by Petitioner for the challenging the ‘889 Patent in the District Court:

**1. Prior Art Patents and Patent Publications**

| <b>Ex. No.</b> | <b>Patent/<br/>Publication</b>         | <b>Referenced<br/>As</b> | <b>Publication /<br/>Priority Date</b> |
|----------------|----------------------------------------|--------------------------|----------------------------------------|
| L1             | U.S. Pat. No. 8,072,916                | Dateki                   | January 14, 2005                       |
| L2             | U.S. Pat. App. Pub. No. 2004/0,087,325 | Cheng                    | November 4, 2002                       |
| L3             | U.S. Pat. App. Pub. No. 2005/0,208,959 | Chen                     | July 12, 2004                          |
| L4             | U.S. Pat. App. Pub. No. 2003/0,026,219 | Moon                     | March 23, 1999                         |
| L5             | U.S. Pat. No. 8,285,319                | Shin                     | October 27, 2006                       |

**2. Prior Art Publications**

| <b>Ex. No.</b> | <b>Patent/<br/>Publication</b>                | <b>Referenced<br/>As</b> | <b>Publication /<br/>Priority Date</b> |
|----------------|-----------------------------------------------|--------------------------|----------------------------------------|
| L6             | 3GPP TS 36.212 v8.0.0                         | 36.212 v8.0.0            | September 2007                         |
| L7             | 3GPP TS 36.213 v8.0.0                         | 36.213 v8.0.0            | September 2007                         |
| L8             | Wideband TDD: WCDMA for the Unpaired Spectrum | Chitrapu                 | 2004                                   |

Ex. 2004, 33; *see also*, 210-227. Thus, Dateki -- the primary reference in all three grounds in this IPR -- is also being asserted in the Parallel Litigation. In addition, Chitrapu (a secondary reference) is also being asserted in both this IPR and the Parallel Litigation. The only reference unique to the IPR is Mate, a secondary reference relied on for two dependent claims in Ground 2 for aspects of 3GPP -- a specification that the '889 Patent acknowledged as having existed. Pet., 48; Ex. 1001, at 4:4-13.

At the time the Petition was filed on November 25, 2024, Petitioner argued that “[t]he extent of overlap is ... speculative at this point in time.” Pet., at 77. However, on January 9, 2025, Petitioner filed its Second Supplemental Preliminary Invalidity Contentions in the Parallel Litigation setting forth in detail Petitioner’s invalidity contentions for the '889 Patent in the Parallel Litigation, which rely on essentially the same references asserted in this IPR. At this point in time, the high degree of overlap between the proceedings is far from being “speculative.”

Because there is a significant overlap between this IPR and the Parallel Litigation, there are particularly strong “concerns of inefficiency and the possibility of conflicting decision” if this IPR is instituted. *Fintiv*, Paper 11 at 12.

Thus, the fourth factor weighs against institution.

**E. Factor 5 weighs against institution because the patent owner is the same and the Petitioner are the same parties as in the Parallel Litigation**

Patent Owner and Petitioner are the same parties as in the Parallel Litigation.

Thus, the fifth factor weighs against institution.

**F. Factor 6 weighs against institution because the merits of Petitioner's challenge is weak**

The challenges set forth in the Petition are flawed. For example, the Petition extensively relies on an expert declaration that largely parrots *verbatim* the wording of the Petition. Ex. 1003. For example, the following paragraphs of the expert declaration essentially parrot the Petition word-for-word: Ex. 1003, ¶¶ 30-45, 49-50, 58-70, 72-89, 93-126, 129-135, 140-144 and 148-174.<sup>2</sup> The differences between the wording of these paragraphs from the declaration and that of the Petition are insubstantial. For example, in cases where the Petition provides a point citation to a given reference, the declaration includes a quotation from the reference corresponding to the point citation. For these reasons, the declaration is entitled to little if any weight. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15-17 (PTAB August 24, 2022) (designated precedential) (according “little weight” to

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<sup>2</sup> The portions of the expert declaration that do not parrot the Petition include information such as the expert's background, the materials he considered, and boilerplate describing application legal standards. (Ex. 1003, ¶¶ 1-24 and 26-29.)

declaration testimony that contains a verbatim restatement of a petition’s conclusory assertions without additional supporting evidence or reasoning). The Petition’s extensive reliance on expert testimony that is mostly a verbatim restatement of the Petition is a further factor that favors discretionary denial. *See also, Facebook v. Windy City Innovations, LLC*, 973 F.3d 1321, 1340-41 (Fed. Cir. 2020) (affirming the Board’s holding that claim was not unpatentable when “the Board considered Facebook’s expert’s testimony but determined that it did not add materially to Petitioner’s unpersuasive attorney argument,” “because it merely repeated Petitioner’s argument, nearly verbatim, without citation to the basis for his testimony.”)

Thus, the sixth factor weighs against institution.

In summary, all of the *Fintiv* factors weigh against institution. Under §314(a) and, based on the totality of the *Fintiv* factors, institution should be denied.

### **III. THE PETITION’S IMPROPER RELIANCE ON EXPERT TESTIMONY TO FILL GAPS IN THE PRIOR ART WARRANTS DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(A)**

In addition to the *Fintiv* factors that support a discretionary denial under 35 U.S.C. § 314(a), the Petition impermissibly and excessively relies on expert testimony to fill gaps in the prior art. As detailed below, the Petition exceeds the statutory scope of inter partes review by improperly supplementing the prior art

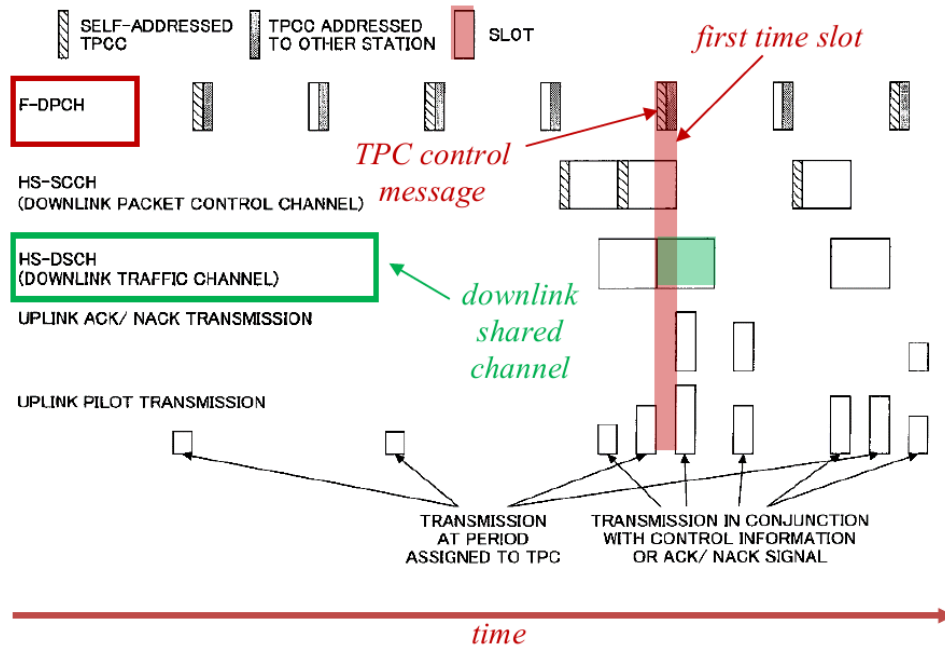
through a voluminous expert declaration. These circumstances provide a further basis for the Director to exercise discretion and deny institution.

One of the relevant considerations for discretionary denial under 35 U.S.C. § 314(a), as identified in the Memorandum, is “[t]he extent of the petition’s reliance on expert testimony.” Memorandum, at 1. In this case, the Petition relies heavily on an 81-page expert declaration (Ex 1003) comprising 175 paragraphs—well beyond what is appropriate under the statutory framework governing inter partes review.

Specifically, under 35 U.S.C. § 311(b), “[a] petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.” Here, the Petition impermissibly relies on the declaration of its expert to fill a gap in Dateki (the primary reference).

The only challenged independent claims (i.e., claims 1 and 5) of the ‘889 Patent recite a UE that transmits a signal based on information extracted from a “control message” having “power control bits for a plurality of UEs,” (ii) where “the control message” shares a time slot with a “downlink shared channel.” As shown in the annotated diagram from the Petition below, the Petition maps “the control message” with power control bits “for a plurality of UEs” to a “TPC control message” transmitted on the F-DPCH channel in Figure 6 of Dateki, and the

“downlink shared channel” to the downlink traffic channel in Figure 6 of Dateki.  
 Pet., 30, 35-36.



This mapping fails to meet the claimed combination because, in Figure 6 of Dateki, whenever the F-DPCH channel and the downlink data traffic channel share a time slot, the UE’s transmission power is not based on the power control information on the F-DPCH (mapped to “the control message”), as required by the claim language. Rather, in all cases where the F-DPCH channel and the downlink data traffic channel share a time slot, the power control information on the HS-SCCH (referred to as “second” transmission power control information in Dateki) - - as opposed to the F-DPCH (referred to as “first” transmission power control

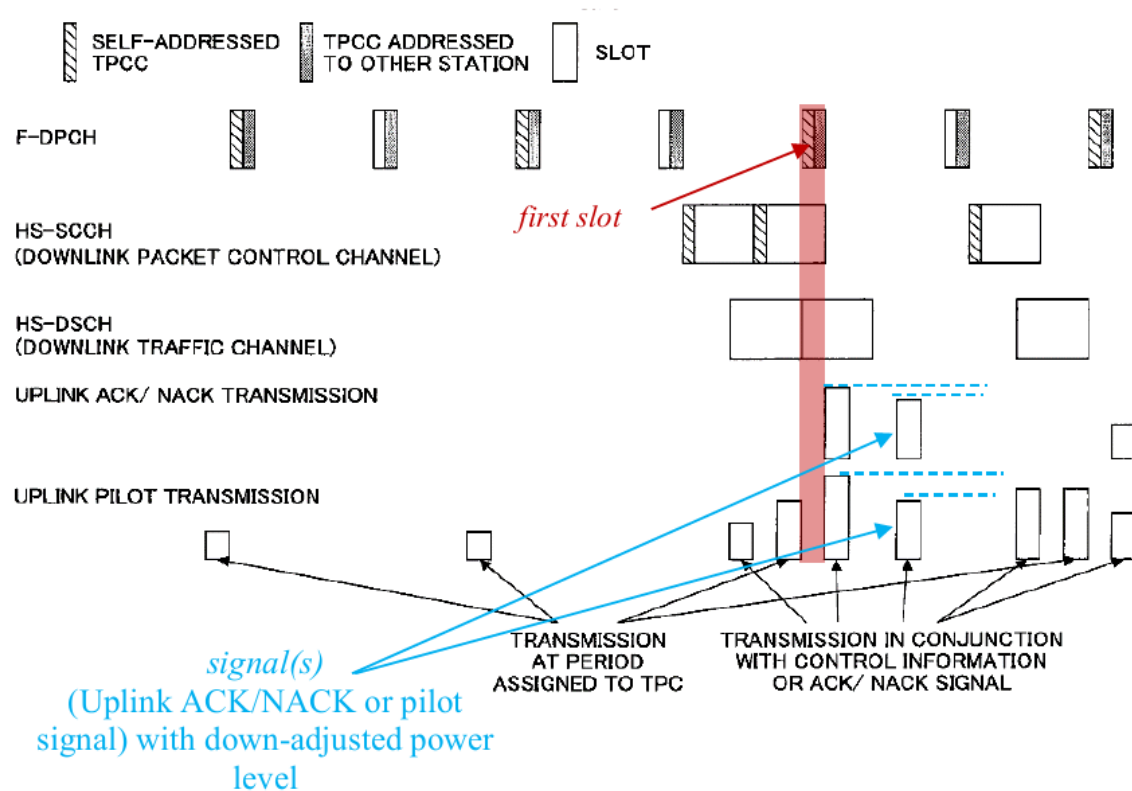
information in Dateki) -- is used to control the UE's transmission power.<sup>3</sup> The Petition does not contend (nor could it) that the power control information on the HS-SCCH maps to the claimed “the control message” because each frame on the HS-SCCH has power control information for only a single UE and thus lacks the requirement that “the control message” have power control bits for “a plurality of UEs,” as claimed.

In an attempt to fill this gap, the Petition relies on the declaration of Petitioner's expert to incorrectly assert that the “Uplink/ACK or pilot signal”

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<sup>3</sup> Ex. 1005, 3:8-11 (“where packet transmission is conducted, the transmission power control information is transmitted via the HS-SCCH as second transmission power control information”); 3:8-23 (“in a case where packet transmission is conducted, the transmission power control information is transmitted via the HS-SCCH as second transmission power control information ... in a case where data are transmitted via the HS-PDSCH, transmission power control may be conducted through transmission of an ACK/NACK signal ... based on the transmission power control information TPCC that is previously transmitted via the HS-SCCH. Thereby, transmission power may be suitably controlled to quickly respond to the transmission quality”); 13:57-62 (“According to the present embodiment, in transmitting the ACK/NACK signal, for example, the second transmission power control information TPCC2 that is previously received via the HS-SCCH may be used to swiftly control the transmission power to a desired level”); 12:61-65 (“It is noted that the reception of the HS-PDSCH and the transmission of the ACK/NACK signal are conducted in conjunction with the reception of the HS-SCCH”); 6:29-39 (“According to another aspect of the present invention, a wireless communication apparatus is provided ... that realizes data transmission via a shared channel, the apparatus including: a transmission unit that is configured to ... transmit control information for receiving the data including second transmission power control information when transmitting the data to the mobile station”); and 12:48 (equating “known signal” with “pilot signal”).

identified by the **blue arrows** below are adjusted based on “first” power control information sent on a “first slot” on the F-DPCH (shaded in **red** below) as opposed to “second” power control information sent on the HS-SCCH.



Pet., 41-42, *citing*, expert declaration Ex. 1003, ¶106. Lacking from this assertion in the expert declaration (Ex. 1003, ¶106) is any citation to Dateki that the “Uplink/ACK or pilot signal” identified by the **blue arrows** above are adjusted based on “first” power control information sent on the F-DPCH (shaded in **red**) as opposed to “second” power control information sent on the HS-SCCH. The Petition’s use of its expert declaration to assert that Dateki operates in a manner not specified by the reference represents classic gap filling.

Despite the absence of a supporting citation to Dateki, the Petition (through its expert) states that, since “the height of the second ACK/NACK signal and second pilot signal [identified by the blue arrows above] changes after the UE receives and extracts the TPCC information from the F-DPCH [red shading above],” the change in height is based on “first” power control information sent on the F-DPCH (shaded in red) as opposed to “second” power control information sent on the HS-SCCH. This reasoning makes little sense. For example, while the height of the second ACK/NACK signal (and its corresponding pilot signal) does change after the UE receives the identified TPCC information on the F-DPCH, the Petition fails to mention that the height of the first ACK/NACK signal (and its corresponding pilot signal) also changed after the UE receives the identified TPCC information on the F-DPCH. However, Dateki makes clear that even though the height of the first ACK/NACK signal (and its corresponding pilot signal) changes after the UE receives the specified TPCC information on the F-DPCH -- that height change is not based on the specified TPCC information sent on the F-DPCH but rather on second power control information transmitted over the HS-SCCH. Ex. 1005, 13:66-14:4 (“[w]hen a base station receives the third (from the left) pilot signal, the base station may generate the second (from the left) TPC bit in the HS-SCCH based on the third pilot signal, and thereby, accurate transmission power control may be conducted upon transmitting the first ACK signal.”) (emphasis added).

Petitioner's expert fails to explain why the second ACK/NACK signal (and its corresponding pilot signal) following the specified TPCC information on the F-DPCH would be based on information on the F-DPCH, when the first ACK/NACK signal (and its corresponding pilot signal) immediately following the specified TPCC information on the F-DPCH were not based on TPCC information from the F-DPCH. That is because the disclosure of Dateki compels a different conclusion. Specifically, Dateki's disclosure that second power control information sent over the HS-SCCH is used to control the transmission of ACK/NACK messages associated with data traffic sent on the downlink (Ex. 1005, 3:8-11, 3:8-23, 13:57-62, 12:61-65 and 6:29-39), and Dateki's teaching (at, e.g., 12:53-60) that the mobile station sends a pilot signal when transmitting an ACK/NACK, make clear that the height of the second ACK/NACK signal and its corresponding pilot signal (identified by the blue arrows above) are based on second power control information sent over the HS-SCCH (rather than first power control information sent on the F-DPCH as asserted in the Petition).

Through its expert, Petitioner is making an impermissible effort to rewrite the prior art to meet the claim limitations. Such expert testimony goes beyond interpreting the prior art and instead attempts to supply missing elements, in direct violation of 35 U.S.C. § 311(b). Gap-filling of this nature is particularly inappropriate where, as here, the expert declaration largely mirrors the Petition's

language without offering independent analysis. These aspects of the present challenge further support a discretionary denial under § 314(a).

Given the extensive and improper use of expert testimony, the Petition fails to comply with statutory requirements and undermines the integrity of the IPR process. Accordingly, this factor further supports discretionary denial under 35 U.S.C. § 314(a) and the guidance of the Memorandum. The Director should therefore exercise her discretion and deny institution.

#### **IV. DISCRETIONARY DENIAL IS ALSO APPROPRIATE UNDER THE *ADVANCED BIONICS* FRAMEWORK**

Section 325(d) provides that the Director may elect not to institute a proceeding if the challenge to the patent is based on matters previously presented to the Office. 35 U.S.C. § 325(d) states, in pertinent part,

In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, 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. (emphasis added).

Here, there is no dispute that the sole reference relied on in the Petition to challenge the independent claims -- Dateki (Ex. 1005) -- was previously presented to the Office, as Dateki appears on the face of the '889 Patent. During prosecution, the Examiner was specifically directed to the pertinence of Dateki and considered the disclosure of Dateki over a dozen times. The prosecution history demonstrates that,

having considered the disclosure of Dateki multiple times, the Examiner found the reference deficient. This result is consistent with the fact that Dateki fails to meet the claim language, as explained above. The Petition has not come even close to demonstrating that the Examiner erred. Rather, the fact that the Petitioner was required to resort to gap-filling by way of an expert declaration to fill holes left by Dateki demonstrates that the Examiner correctly analyzed the reference and found it lacking.

**A. The Prosecution History Demonstrates That The Examiner Was Specifically Directed To The Pertinence Of Dateki's Disclosure**

The European Counterpart (EP 1 681 780)(Ex. 2005) to Dateki (Ex. 1005) was the primary reference (D1) applied against the claims in the PCT counterpart (PCT/EP2007/064483) of the disclosure corresponding to the '889 Patent:

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING  
AUTHORITY (SEPARATE SHEET)**

International application No.

PCT/EP2007/064483

- 1 Reference is made to the following documents, which are cited in the International Search Report:

D1: EP-A-1 681 780 (FUJITSU LTD [JP]) 19 July 2006 (2006-07-19)

D2: US 2006/093026 A1 (MONTJOJO JUAN [US] ET AL) 4 May 2006 (2006-05-04)

D3: DE 102 01 270 A1 (SAMSUNG ELECTRONICS CO LTD [KR]) 8 August 2002 (2002-08-08)

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- 2.2 Accordingly all features of independent Claim 1 are known from D1 and its claimed subject-matter is thus not novel within the meaning of Article 33(2) PCT.

Ex. 2006, at 297-298. In response to the Written Opinion, the Applicant presented the Office with a copy of EP 1 681 780 (Dateki), and copies of the International Search Report and Written Opinion citing the same. Ex. 2006, at 269-285 (copy of Dateki), 288-293 (International Search report identifying EP 1 681 780 as category “X” prior art), 294-302 (Written Opinion), 305-306 (Electronic Acknowledgement Receipt evidencing submission of the above), 309-311 (Supplemental Information Disclosure Statement submitting same), and 148 (Form 1449 citing same). On November 17, 2009, Examiner Abselson (a Primary Examiner) signed the IDS indicating that he had considered these submissions. Ex. 2006, at 132.

While the Applicant originally submitted the European Counterpart (EP 1 681 780) (Ex. 2005) of Dateki during the prosecution of Application No. 11/646,292 (Ex. 2006) -- the first application in the priority chain of the ‘889 Patent -- the Applicant again disclosed all of the same information in Application No. 13/176,298, which was the next application in the priority chain. Ex. 2007, 86-89 (Information disclosure Statement, Foreign Patent Document Cite No. 4 identifying EP 1 681 780); NPL Cite No. 9 identifying International Preliminary Report on Patentability); 236-252 (submitting copy of EP 1 681 780), 403-405 (submitting International Search Report identifying EP 1 681 780 as category “X” prior art). On February 1, 2013, Examiner Abselson again signed the IDS indicating that he had considered these submissions. Ex. 2007, at 1851-1852 and 1857-1860.

Also, during prosecution of Application No. 13/176,298, the Applicant brought to the attention of Examiner Abelson that the Japanese Counterpart of Dateki (JP 2006-1973318) had been cited against Applicant's Japanese counterpart. Ex. 2007, at 1943-1959 (Japanese counterpart of Dateki) and 1911-1912 (Information disclosure statement citing same). At the same time, the Applicant indicated that the U.S. version of Dateki (USP 8072916, Ex. 1005) corresponded to the Japanese counterpart of Dateki raised by the Japanese Patent Office:

| U.S. PATENTS      |         |               |                        |            |                                                 | Remove                                                                   |
|-------------------|---------|---------------|------------------------|------------|-------------------------------------------------|--------------------------------------------------------------------------|
| Examiner Initial* | Cite No | Patent Number | Kind Code <sup>1</sup> | Issue Date | Name of Patentee or Applicant of cited Document | Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear |
|                   | 1       | 6611509       | BA                     | 2003-08-26 | Hayashi et al.                                  | * Corresponds to JP 11-261544                                            |
|                   | 2       | 8072916       | BB                     | 2011-12-06 | Dateki                                          | * Corresponds to JP 2006-197318                                          |

\* \* \*

| FOREIGN PATENT DOCUMENTS |         |                                      |                             |                        |                  |                                                 | Remove                                                                   |                          |
|--------------------------|---------|--------------------------------------|-----------------------------|------------------------|------------------|-------------------------------------------------|--------------------------------------------------------------------------|--------------------------|
| Examiner Initial*        | Cite No | Foreign Document Number <sup>3</sup> | Country Code <sup>2</sup> j | Kind Code <sup>4</sup> | Publication Date | Name of Patentee or Applicant of cited Document | Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear | T <sup>5</sup>           |
|                          | 1       | 11-261544                            | JP                          |                        | 1999-09-24       | Hayashi et al.                                  |                                                                          | <input type="checkbox"/> |
|                          | 2       | 2006-197318                          | JP                          |                        | 2011-12-06       | Dateki                                          |                                                                          | <input type="checkbox"/> |

\* \* \*

| NON-PATENT LITERATURE DOCUMENTS |         |                                                                                                                                                                                                                                                                 |  | Remove                   |
|---------------------------------|---------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--|--------------------------|
| Examiner Initials*              | Cite No | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published. |  | T <sup>5</sup>           |
|                                 | 1       | OFFICE ACTION, Japanese Patent Application No. 2009-543459, dated December 18, 2012.                                                                                                                                                                            |  | <input type="checkbox"/> |

Ex. 2007, at 1911-1912. On March 26, 2013, Examiner Abselson again signed the IDS indicating that he had considered these submissions. Ex. 2007, at 1851-1852.

The Applicant again disclosed multiple versions of Dateki in Application No. 14/458,693, which was the next application in the priority chain. Ex. 2008, 578-583 (Information Disclosure Statement, U.S. Patent Cite No. 11 (identifying USP 8,072,916 (US version of Dateki) as counterpart of JP 2006-197318 (Japanese version of Dateki); Foreign Patent Cite No. 4 (identifying EP 1 681 780 (EP counterpart of Dateki); and Non-Patent Literature Cite No. 12 (International Preliminary Examination Report identifying EP 1 681 780 as category “X” prior art)). On November 5, 2014 and again on October 23, 2015, Examiner Abselson signed the Information Disclosure Statements indicating that he had considered these submissions. Ex. 2008, at 526-532 and 552-558.

The Applicant again disclosed multiple versions of Dateki in Application No. 16/682,854, which was the next application in the priority chain. Ex. 2009, at 198-207 (Information Disclosure Statement, U.S. Patent Cite No. 11 (identifying USP 8,072,916 (US version of Dateki); Foreign Patent Cite No. 4 (identifying EP 1 681 780 (EP counterpart of Dateki); and Non-Patent Literature Cite No. 12 (International Preliminary Examination Report identifying EP 1 681 780 as category “X” prior art)). On February 4, 2020, Examiner Abselson again signed the IDS indicating that he had considered these submissions. Ex. 2009, at 186-195.

The Applicant again disclosed multiple versions of Dateki in Application No. 17/339,550, which was the next application in the priority chain. Ex. 2010, at 53-62 (Information Disclosure Statement, U.S. Patent Cite No. 11 (identifying USP 8,072,916 (US version of Dateki); Foreign Patent Cite No. 4 (identifying EP 1 681 780 (EP counterpart of Dateki); and Non-Patent Literature Cite No. 12 (International Preliminary Examination Report identifying EP 1 681 780 as category “X” prior art)). On September 17, 2021, Examiner Abselson again signed the IDS indicating that he had considered these submissions. Ex. 2010, at 24-33.

The Applicant again disclosed multiple versions of Dateki in Application No. 17/583,369, which was the next application in the priority chain. Ex. 2011, at 34-39 (Information Disclosure Statement, citing USP 8,072,916 (US version of Dateki), EP 1 681 780 (EP counterpart of Dateki); and International Preliminary Examination Report identifying EP 1 681 780 as category “X” prior art). On April 8, 2022, Examiner Abselson again initialed the pages of the IDS indicating that he had considered these submissions. Ex. 2011, at 27-32.

The Applicant again disclosed multiple versions of Dateki in Application No. 17/870,425 (the last application in the chain), which matured into the ‘889 Patent. Ex. 2012, 47-52 (Information Disclosure Statement, citing USP 8,072,916 (US version of Dateki), EP 1 681 780 (EP counterpart of Dateki); and International Preliminary Examination Report identifying EP 1 681 780 as category “X” prior art).

On December 6, 2022, Examiner Abselson again initialed the pages of the IDS indicating that he had considered these submissions. Ex. 2012, at 26-31.

Thus, Examiner Abselson was specifically directed to the pertinence of Dateki's disclosure in the Search Report and Written Opinion issued by the PCT Authority, and in an Office Action issued by the Japanese Patent Office. On at least seven separate occasions, Examiner Abselson indicated that he considered these materials. Moreover, over the course of 13 years (from 2009-2022), the Applicant directed Examiner Abselson to Dateki at least 14 times by citing either the U.S., European, or Japanese version of Dateki in Information Disclosure Statements. In every case, Examiner Abselson indicated that he considered the submissions.

The Petition argues that “[o]ther than initialing an Information Disclosure Statement listing Dateki (*see* Ex.1002, 150), there is no evidence that the Examiner substantively considered Dateki with respect to the Challenged Claims.” Pet., at 74. Of course, signing or initialing an Information Disclosure Statement is evidence that Examiner Abselson substantively considered Dateki. In essence, without any evidence of its own, Petitioner is making the scurrilous assertion that Examiner Abselson -- a Primary Examiner who has a 24-year tenure with the Office -- lied on at least seven separate times when he signed his name or applied his initials to government forms indicating that he considered both the Search Report and Written Opinion identifying the pertinence of Dateki and the disclosure of the reference

itself. Petitioner’s unsupported assertion that Examiner Abselson failed to do his job must be rejected.

**B. The *Advanced Bionics* Framework Favors Favor Discretionary Denial**

As explained in *Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GMBH*, IPR2019-01469, Paper #6, 7-8 (P.T.A.B. 2020) (Precedential):

... 35 U.S.C. § 325(d) identifies two separate issues for the Director to consider in exercising discretion to deny institution of review: whether the petition presents to the Office the same or substantially the same art previously presented to the Office, or whether the petition presents to the Office the same or substantially the same arguments previously presented to the Office. ...

Under § 325(d), the art and arguments must have been previously presented to the Office during proceedings pertaining to the challenged patent. Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent. ... If the “same or substantially the same prior art or arguments previously were presented to the Office,” then the Board’s decisions generally have required a showing that the Office erred in evaluating the art or arguments. See, e.g., *Becton, Dickinson*, Paper 8 at 24 (considering whether the petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art). If the petitioner fails to show that the Office erred, the Director may exercise his discretion not to institute inter partes review. *Id.* (exercising discretion where “Petitioner has not pointed to error by the Examiner”).

In the present case, there can be no dispute that Dateki’s disclosure was previously presented to the Office. It was, therefore Petitioner’s burden to demonstrate that Examiner Abelson erred. Petitioner utterly failed to meet this burden because, as explained above, Dateki fails to meet all of the limitations of independent claims 1

and 5 of the ‘889 Patent. Accordingly, discretionary denial of the Petition is warranted under the *Advanced Bionics* framework.

**C. The *Becton Dickinson* Factors Also Favor Discretionary Denial**

Institution of inter partes review is not warranted in this case because the Petition relies entirely on prior art that was previously presented to—and thoroughly considered by—the Patent Office during prosecution. As set forth in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential), the Board considers six non-exclusive factors in determining whether to exercise discretion under 35 U.S.C. § 325(d) based on the prior consideration of art and arguments. When applied to the record here, each of these factors, enumerated below, weighs in favor of discretionary denial.

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of prior art or arguments.

Specifically, the sole reference asserted in the Petition—Dateki—was repeatedly considered by the Examiner in both its U.S., Japanese and European forms, including during prosecution of the PCT counterpart application. The arguments now raised in the Petition mirror those previously rejected by the PCT Authority and by Examiner Abelson. Furthermore, the Petition fails to identify any error in the Examiner’s analysis and offers no material new evidence warranting reconsideration. As detailed below, under the totality of the circumstances, institution should be denied pursuant to § 325(d).

**1. The Similarities Between The Asserted Art And The Prior Art Considered During Examination And The Cumulative Nature Of The Asserted Art And The Prior Art Considered During Examination Support A Discretionary Denial Favor Discretionary Denial Under Factors (A) And (B)**

The only prior art asserted in the Petition against the challenged independent claims of the ‘889 Patent is Dateki (Ex. 1005). Both the U.S. Patent corresponding to Dateki and the European counterpart of Dateki (which is entirely cumulative of the U.S. version of the reference) were considered by Examiner Abelson numerous times. Thus, factors (a) and (b) from *Becton, Dickinson* support discretionary denial.

**2. The Extent To Which The Asserted Art Was Evaluated During Examination, Including Whether The Prior Art Was The Basis For Rejection; The Extent Of The Overlap Between The Arguments Made During Examination And The Manner In Which Petitioner Relies On The Prior Art Favor A Discretionary Denial Under Factors (C) And (D)**

The European counterpart of Dateki -- referred to as “D1” below -- was the primary basis for the rejection of the claims in the PCT counterpart of the disclosure corresponding to the ‘889 Patent. Just like the arguments made in the Petition, the PCT Authority based its rejection on Figure 6 of Dateki, including the transmission power control (TPC) information in a time slot on Dateki’s F-DPCH channel, as shown in Figure 6:

Document D1, *which is considered to represent the closest state of the art*, discloses a method for enabling active control feedback between a base station and mobile station in a wireless communications network (see D1, paragraphs 20, 23), the method comprising:

- allocating a first time slot within a frame for a mobile station to transmit a beacon signal to the base station, wherein the beacon signal is separate from data signals in the frame (see D1, paragraphs 10, 11, 50, 55, 56, *figure 6, the periodically sent uplink pilot transmission at the period assigned to TPC in the F-DPCH, in a slot preceding the slot assigned to the F-DPCH*, the pilot being sent without accompanying data, the frame length being 10 ms, a subframe comprising 3 slots);
- allocating a second time slot within the frame for the base station to transmit a control signal in response to the beacon signal, *the control signal for providing a basis upon which the mobile station adjusts a transmission parameter* (see D1, paragraphs 47, 52, 56, *figure 6, the slots in the F-DPCH carrying the TPC bits used for uplink power control*) ... Ex. 2006, at 297 (emphasis added).

Similar to the analysis of the PCT Authority, the Petition maps “a control message [transmitted] over a physical control channel in a first time slot,” as recited in claims 1 and 5 of the ‘889 Patent, to the transmission of TPC bits on Dateki’s F-DPCH channel in Figure 6 of the reference. From the Petition:

***[1.2] wherein: the receiver and the processor are configured to receive a control message over a physical control channel in a first time slot,***

Dateki discloses or at least renders obvious limitation [1.2]. Ex.1003, ¶¶79-85.

Dateki discloses the UE receiving control information over a “fractional dedicated **physical control channel (F-DPCH)**,” which is an example of the recited *physical control channel* in [1.2]. Ex.1005, 4:35-40 (describing F-DPCH carrying TPC bits for plural users), 12:13-15 (same); Ex.1003, ¶79.

Further, Dateki discloses transmitting a power *control message* over the F-DPCH: “[t]he F-DPCH corresponds to a channel that is capable of transmitting a slot including plural TPC [transmit power control] bits addressed to differing mobile stations.” Ex.1005, 12:13-15. ...

As explained above, the TPC commands carried in the F-DPCH (control channel) comprise a *control message*, because the TPC commands are communicated together in a F-DPCH, and the TPC commands are used to maintain the communication link. Ex.1003, ¶81. Referring to FIG. 6 below, Dateki illustrates a plurality of time slots and associated channels and transmissions. Pet., 30-32.

Moreover, similar to the analysis of the PCT Authority, the Petition maps the requirements that the UE “extract power control information ... from the first message” and “transmit a signal ... based on the extracted control information” as

recited in claims 1 and 5 of the ‘889 Patent to information extracted from the TPC commands sent on the F-DPCH channel in Figure 6 of Dateki. From the Petition:

***[1.5] the processor is further configured to extract power control information for the first UE from the control message, and***

Dateki discloses limitation [1.5]. Ex.1003, ¶¶98-101.

As discussed in association with [1.2] and shown in Fig. 6, Dateki’s UE receives a TPCC (transmit power control command). Ex.1005, 11:6-11, 12:13-16, FIG. 6. Dateki explains that the TPCC extracting unit 37 of the mobile station (part of *the processor*) extracts *power control information* from the TPCC ... Pet., 38.

\* \* \*

***[1.6] the transmitter and the processor are configured to transmit a signal over a physical control channel to a base station in a second time slot at a transmission power level based on the extracted power control information.***

Dateki discloses or renders obvious limitation [1.6]. Ex.1003, ¶¶102-111.

**First**, Dateki discloses that the UE transmits an “ACK/NACK signal” and uplink pilot signals (also referred to as pilot “symbols”) to the base station. See Ex.1005, 12:4-10, 10:60-62. Each of these signals, shown in FIG. 6 of Dateki, ...

FIG. 6, annotated below, illustrates adjusting the power level of ACK/NACK transmissions and pilot signals based on the TPCC information. Pet., 39-41.

The PCT Authority attempted to map Figure 6 of Dateki to the disclosure of the ‘889 Patent. Examiner Abelson was directed to this analysis and considered it on multiple occasions, correctly finding it lacking. Given these substantial overlaps between the

mapping of Dateki advanced by the PCT Authority and that set forth in the Petition, factors (c) and (d) from *Becton, Dickinson* support discretionary denial.

**3. Whether Petitioner Has Pointed Out Sufficiently How The Examiner Erred In Its Evaluation Of The Asserted Prior Art And The Extent To Which Additional Evidence And Facts Presented In The Petition Warrant Reconsideration Of Prior Art Or Arguments Favor A Discretionary Denial Under Factors (E) And (F)**

The Petitioner bears the burden of showing that the Examiner made an error in allowing the patent to be granted. In the present case, the Petition has not demonstrated that Examiner Abelson erred. With respect to satisfying its burden on this issue, the Petition makes only a conclusory statement that “it was material error for the Examiner to have allowed the Challenged Claims for the reasons presented in the Grounds above.” Pet., 74. This conclusory statement fails to satisfy Petitioner’s burden of demonstrating that Examiner Abselson erred. On the contrary, the fact that the Petitioner was required to resort to gap-filling by way of an expert declaration to fill holes left by Dateki demonstrates that the Examiner’s analysis of Dateki was correct. Simply put, the Petition presents no facts that warrant reconsideration of Examiner Abelson’s findings. Thus, factors (e) and (f) from *Becton, Dickinson* support discretionary denial.

In sum, all six Becton, Dickinson factors—(a) through (f)—support discretionary denial of institution under 35 U.S.C. § 325(d). The Petition relies

exclusively on Dateki, a reference that was repeatedly considered by the Examiner and by the PCT Authority in materially identical form. The arguments now advanced mirror those previously evaluated and rejected during prosecution, offering no meaningful distinction. Furthermore, the Petition fails to identify any substantive error in the Examiner's analysis and presents no new evidence that would warrant reconsideration.

This is precisely the type of case § 325(d) and *Becton, Dickinson* are intended to address: a Petition that merely repackages art and arguments already vetted by the Office, without identifying error or providing sufficient justification for a second look. Accordingly, the Board should decline to institute inter partes review in the exercise of its discretion under § 325(d).

## **V. CONCLUSION**

Institution of inter partes review should be denied under 35 U.S.C. § 314(a) based on the totality of the circumstances presented in this case. All six *Fintiv* factors weigh against institution, including the advanced stage of the Parallel Litigation, the scheduled trial date occurring before the projected Final Written Decision, the parties' substantial investment in the litigation, and the complete overlap of parties, issues, and prior art between the district court and this IPR. These factors raise serious concerns about duplicative proceedings, inefficiency, and the risk of conflicting outcomes.

In addition, the Petition's excessive and improper reliance on expert testimony also favors a discretionary denial. As explained above, Petitioner is attempting to use its expert to rewrite the prior art to meet the claim limitations. Use of expert testimony for this type of gap-filling is particularly inappropriate where, as here, the expert declaration largely mirrors the Petition's language without offering independent analysis.

Discretionary denial is also warranted under 35 U.S.C. § 325(d) and the *Advanced Bionics* framework. The Petition relies entirely on Dateki—a reference that was repeatedly and substantively considered by the Examiner over a 13-year prosecution history, including across multiple applications in the priority chain and in light of rejections by foreign patent offices. The Petitioner has not identified any error in the Examiner's evaluation, nor has it presented new evidence or materially different arguments. The Petition is precisely the type of duplicative challenge that § 325(d) was designed to prevent.

Further, every factor of the *Becton Dickinson* framework weighs in favor of discretionary denial under § 325(d). As such, this case exemplifies the circumstances where discretionary denial under § 325(d) is appropriate: a petition based on art and arguments previously and thoroughly evaluated by the Office, with no showing of error. As the *Becton Dickinson* decision makes clear, when the same or substantially

the same art and arguments were already presented, and the Petitioner fails to identify any error in the Office's evaluation, institution should be denied.

In view of the cumulative application of the *Fintiv*, *Advanced Bionics*, and *Becton Dickinson* frameworks—each of which independently supports discretionary denial—the Director should decline to institute inter partes review.

Respectfully submitted,

Dated: April 4, 2025

By: /Daniel H. Golub/  
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Registration No. 33,701

*Counsel for Patent Owner*  
*Intellectual Ventures II LLC*

## **CERTIFICATE OF COMPLIANCE WITH WORD COUNT**

Pursuant to 37 C.F.R. § 42.24(d), I certify that this **BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** complies with the type-volume limits set forth in the Memorandum and 37 C.F.R. § 42.24 because it contains 7,067 words, excluding the parts of the Brief that are exempted by 37 C.F.R. § 42.24(a), according to the word processing system used to prepare this Brief.

Respectfully submitted,

Dated: April 4, 2025

By: /Daniel H. Golub/  
Daniel H. Golub  
Registration No. 33,701

*Counsel for Patent Owner  
Intellectual Ventures II LLC*

## **CERTIFICATE OF SERVICE**

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** was served via email (as consented to by counsel) on April 4, 2025 to lead and backup counsel of record for Petitioner as follows:

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