

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

PEGASUS WIRELESS INNOVATION LLC,
Patent Owner.

Case IPR2025-00290
U.S. Patent No. 10,721,118

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Memorandum Opinion and Order in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex Dec. 11, 2024)
2002	Memorandum Opinion and Order in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex Dec. 23, 2024)
2003	Reserved
2004	Defendants' Preliminary Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex May 17, 2024)
2005-2017	Reserved
2018	Comparison of Districts Within the Fifth Circuit — 12-Month Period Ending September 30, 2024 (available at https://www.uscourts.gov/sites/default/files/2025-02/fcms_na_distcomparison1231.2024.pdf)
2019-2049	Reserved
2050	Defendants' Amended Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex November 1, 2024)
2051	Defendants' Amended Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex December 23, 2024)
2052	Defendants' Motion for Leave to Amend Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex. January 24, 2025)
2053	Appendices to Defendants' Amended Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex November 1, 2024)

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2054	Exhibits to Appendices of Defendants' Amended Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex November 1, 2024)
2055-2099	Reserved
2100	U.S. Pat. 10,952,099 (Futaki counterpart)
2101-2203	Reserved
2204	Fifth Amended Docket Control Order, issued April 14, 2025

Pursuant to 37 C.F.R. § 42.107, Pegasus Wireless Innovation LLC (“Pegasus” or “Patent Owner”) files this preliminary response to the Petition, setting forth reasons why the Petition for *inter partes* review (“IPR”) of claims 1-15 of U.S. Patent No. 10,721,118 (the “’118 Patent”), as requested by Google LLC, Cellco Partnership d/b/a Verizon Wireless, T-Mobile USA, Inc., AT&T Services, Inc., Nokia of America, Corp., and Ericsson Inc. (“Petitioners”), should be denied.¹

I. INTRODUCTION

Each independent claim of the ’118 patent (claims 1, 7, and 10) specifies that a secondary base station determines whether to add a secondary base station signaling radio bearer (SRB) to user equipment. *See, e.g.*, Ex. 1002, 70 (pointing out that the references relied on by the Examiner did not teach that a secondary base station determines whether to add a secondary base station SRB to user equipment); Ex. 1013, ¶125.

Repeatedly, Petitioners boldly claim that their primary reference, Futaki, discloses a secondary base station that determines whether to add a secondary base station SRB to user equipment. Pet., 26 (“the feature Applicant relied on for allowance”), 36 (“Futaki expressly discloses the limitation found to be missing

¹ By submitting this Preliminary Response, no waiver of any argument is intended by Patent Owner. Patent Owner will have a right to file a complete response to the Petition, should the Board institute *inter partes* review. 37 C.F.R. § 42.120(a).

from the art during prosecution”); *see also* 12, 73. But like the art relied upon by the examiner during examination, Futaki fails to disclose or suggest these claimed features. Rather, contrary to Petitioners' assertions, it is Futaki's ***master base station***, not its secondary base station, that determines whether to add a secondary base station SRB to user equipment. In the portion of Futaki relied on by Petitioners (Fig. 8 of Futaki) (Pet. 37-38), Futaki discloses a step 802 where master base station “initiates” a procedure to add (or modify) a secondary base station SRB by sending a signal to the secondary base station. Futaki, [0079]-[0082]. As will be explained below, the import of “initiating” step 802 was lost on Petitioners, and their expert witness. They completely ignored the “initiating” step in Futaki, including when and where it occurs (the master base station). Accordingly, Futaki performs “determining” in the same location as the references relied on by the Examiner and the “typical” technology distinguished in the '118 patent. *See* '188 patent, Fig. 1, 6:60-7:62; Ex. 1013, ¶126. Further, every asserted Ground incorrectly relies on Futaki to disclose this feature. As such, every Ground fails on the merits.

Additionally, notwithstanding the clear defects in Petitioners' merits arguments, Patent Owner is asking the Director to discretionarily deny the Petition within the time permitted to make such a request. Specifically, given the timing and advanced stage of co-pending litigation between the Petitioners and Patent

Owner, the Director should deny the Petition under *Fintiv*. As enumerated below and as will be addressed in Patent Owner's separate request for discretionary denial, each *Fintiv* factor weighs in favor of the Board exercising its discretion to deny institution or, at worst, remains neutral. The co-pending litigation is scheduled to proceed to trial on September 8, 2025, nearly eleven months before the Board would be expected to issue a final written decision in this case (by August 6, 2026).

The parties had been litigating infringement and validity since the initiation of the District Court litigations, with expert infringement reports due in late April 2025. Patent Owner narrowed the dispute with Petitioners, and elected not to submit an expert infringement report addressing infringement of the '118 patent. However, this does not change the *Fintiv* analysis here. When confronting an eleven-patent dispute before a district court, efficiency should allow and encourage patent owners to have the flexibility to narrow the dispute without being forced to expend resources to litigate validity issues before the Board that will have no bearing on the litigation, solely because a party (or large group of parties) wants to continue challenging the patent and burdening a patent owner with more limited resources.

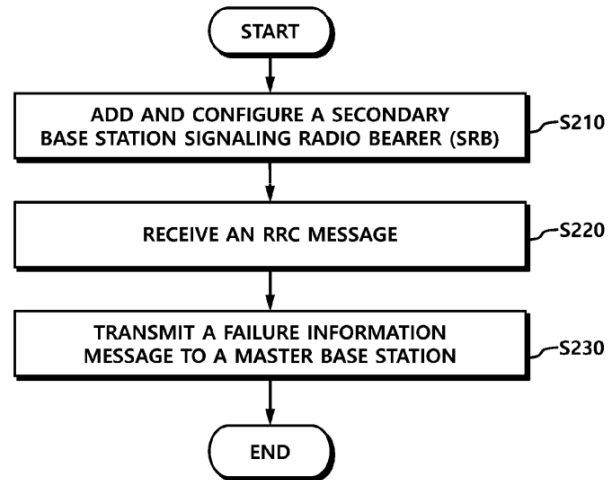
Patent Owner anticipates that Petitioners will argue that the Board should institute this proceeding because the District Court will not decide the validity of

the '118 patent. But the fact that Patent Owner did not serve an expert infringement report regarding the '118 patent makes the validity of the '118 patent less important to the global dispute between the parties, not more important. Conserving resources of the Board also favors denial. There no reason to expend Board resources to decide the validity of fifteen patent claims that have been dropped from the co-pending litigation, particularly where a *Fintiv* denial is appropriate and warranted for the patents that remain in the litigation.

Therefore, Patent Owner respectfully submits that the Director should exercise its discretion and deny this Petition against the '118 patent.

II. THE '118 PATENT

The '118 Patent is entitled, “Method for Configuring Dual-Connectivity by Terminal, and Apparatus Therefor.” As illustrated in Fig. 2, the '118 patent provides for the operation of user equipment (UE) ('118 patent, 9:48-49):

FIG. 2

In step S210, a UE configuring dual connectivity may add and configure a secondary BS signaling radio bearer (SRB). '118 patent, 9:50-52. The secondary BS may determine whether to add the secondary BS SRB to the UE. '118 patent, 9:57-60. In step S220, the UE may receive a radio resource control (RRC) message including radio resource configuration information on the secondary BS through the secondary BS SRB. '118 patent, 10:1-12. If the UE is unable to comply with radio resource configuration information included in an RRC message, the UE may transmit a failure information message to the master BS, as shown in step S230. '118 patent, 10:19-30.

Consistent with the '118 patent's disclosure, independent claim 1 recites:

1. A method of a user equipment for configuring dual connectivity, the method comprising:

adding and configuring a secondary base station signaling radio bearer (SRB);

receiving from a secondary base station, a radio resource control (RRC) message including radio resource configuration information on the secondary base station or a secondary cell group through the secondary base station SRB; and

transmitting a failure information message to a master base station in case the user equipment is unable to comply with the radio resource configuration information included in the RRC message,

wherein the addition of the secondary base station SRB is determined by the secondary base station.

'118 patent, Claim 1 (emphasis added).

Claim 7 recites:

7. A method of a secondary base station for controlling dual connectivity of a user equipment, the method comprising:

determining, by the secondary base station, to add a secondary base station signaling radio bearer (SRB) to the user equipment;

transmitting a radio resource control (RRC) message including radio resource configuration information on the secondary base station or a secondary cell group to the user equipment through the secondary base station SRB; and

receiving a response message for a radio resource configuration from the user equipment through the secondary BS SRB if the UE successfully complies with a radio resource on the secondary base station,

wherein the user equipment configures dual connectivity by using a master base station and the secondary base station.

'118 patent, Claim 7 (emphasis added).

Claim 10 recites:

10. A user equipment for configuring dual connectivity, the user equipment comprising:

a controller configured to add and configure a secondary base station signaling radio bearer (SRB);

a receiver configured to receive from a secondary base station, a radio resource control (RRC) message including radio resource configuration information on the secondary base station or a secondary cell group through the secondary base station SRB; and

a transmitter configured to transmit a failure information message to a master base station in case the user equipment is unable to comply with the radio resource configuration information included in the RRC message,

wherein the addition of the secondary base station SRB is determined by the secondary base station.

'118 patent, Claim 10 (emphasis added).

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

Petitioners state “[i]n Related Litigation, the parties proposed that certain claim terms should be given their plain and ordinary meaning. ... [Petitioners] proposed that the plain and ordinary meaning of ‘configured to’ in claim 10 means ‘actually configured to and not merely capable of performing the claimed function’

... [Petitioners] also proposed that the preambles are limiting. ... Petitioners apply the constructions proposed in the Related Litigation in” Petitioner’s Grounds. Pet., 16 (citations to Ex. 1016 omitted). Petitioners did not provide any indication of their proposed constructions for terms other than the “certain claim terms” found in Ex. 1016.

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

IV. PETITIONERS’ CHALLENGES FAIL ON THE MERITS

Petitioners assert two grounds in their Petition, and each Ground applies to all challenged claims (claims 1-15). Ground 1 contends the independent claims (claims 1, 7, and 10), and all of the challenged dependent claims (claims 2-6, 8, 9, and 11-15) are anticipated by, or obvious in view of Futaki². Ground 2 contends

² Ex. 1007, Certified English Translation of PCT International Publication No. WO 2017/119247 to Futaki *et al.*, published on July 13, 2017 (“Futaki”).

the independent claims, and all of the challenged dependent claims, are obvious over Futaki in view of 3GPP 36.300³ and 3GPP 36.331⁴.

Ground 1 fails to establish the unpatentability of any claim of the ’118 patent because Futaki fails to disclose a secondary base station that determines whether to add a secondary signaling radio bearer (SRB) to user equipment (UE). To the contrary, Futaki’s master base station determines whether to add a secondary signaling radio bearer (SRB) to user equipment (UE).

Thus, Ground 1 is facially deficient in establishing the unpatentability of any challenged independent claim. Ground 2 relies on Ground 1’s analysis for the “determining” recitations and, thus, fails for the same reasons as Ground 1. For the reasons discussed below, the Petition should be denied without institution.

A. Ground 1 Fails Because Futaki’s Master Base Station, Rather Than a Secondary Base Station, Initiates Adding Secondary Signaling Radio Bearers (SRB)

Each independent claim specifies that a secondary base station determines whether to add a secondary base station signaling radio bearer (SRB) to user

³ Ex. 1009, 3GPP TS 36.300 v12.8.0 (2015-12) 3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Evolved Universal Terrestrial Radio Access (E-UTRA); Overall description; Stage 2 (Release 12) (“3GPP 36.300”).

⁴ Ex. 1010, 3GPP TS 36.331 v12.8.0 (2015-12) 3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Evolved Universal Terrestrial Radio Access (E-UTRA); Radio Resource Control (RRC) Protocol specification (Release 12) (“3GPP 36.331”).

equipment (UE). For example, claims 1 and 10 recite “wherein the addition of the secondary base station SRB is determined by the secondary base station.” ’133 patent, claims 1 and 10 (final clauses). Petitioners refer to this element as element [1.4] in claim 1 and element [10.4] in claim 10. Claim 7 recites “determining, by the secondary base station, to add a secondary base station signaling radio bearer (SRB) to the user equipment.” Petitioners refer to this element of claim 1 as element [7.1]. Petitioners’ analysis of element [7.1] solely refers to their analysis of element [1.4]. Pet., 45.

Petitioners’ analysis of element [1.4] begins on page 35 of the Petition. Petitioner begins by alleging that Futaki includes a secondary base station that “adds the secondary base station SRB.” Pet.. 35 (citing Futaki, [0030]). Petitioners further argue that “Futaki discloses that the ‘New RRC layer 511’ of the ‘New 5G CG’ corresponding to the 5G specific eNB configures the addition of the New 5G SRB, and not only a modification of the New 5G SRB,” again citing to paragraph [0030] of Futaki. But paragraph [0030] of Futaki includes no detail concerning what entity “determines” to add a secondary base station SRB. In full paragraph [0030] states:

In some implementations, a 5G specific eNB6 used in a non-co-located deployment may have a New RRC layer 511 and a New PDCP layer 512. Moreover, the 5G specific eNB6 may have a control interface or connection

(e.g., S1-MME interface, S1-U interface) with a core network (e.g., Integrated EPC41 or 5G specific EPC42) for the 5G UE 1. In some implementations, the New RRC layer 511 may configure the lower layers 406-408 of the New 5G CG (e.g., New 5G cells 23 and 24) and transmit system information (i.e., Master Information Block (MIB) or System Information Blocks (SIBs) or both) via the New 5G CG. The New RRC layer 511 may set up a signaling radio bearer with the 5G UE 1, set up the lower layers 406 to 408 of the New 5G CG (e.g., New 5G cells 23 and 24) and the New PDCP layer 512, and transmit and receive RRC messages to and from the 5G UE 1 via the New 5G CG. The New RRC layer 511 may transfer NAS messages between the core network (e.g., Integrated EPC 41 or 5G specific EPC 42) and 5G UE 1. The New PDCP layer 512 provides the New RRC layer 511 with RRC message forwarding services via the New 5G lower layers 406-408.

Futaki, [0030]. As can be seen, there is no mention of “determining” or “initiating” or similar actions in paragraph [0030] of Futaki.

Nevertheless, Petitioners cite to their expert to conclude “Thus, Futaki discloses the secondary base station determining the addition of the secondary base station SRB by newly configuring the New 5G specific SRB.” Pet., 35. That opinion should be disregarded on its face, as it is merely a conclusion that does not follow from its premise in paragraph [0030] of Futaki. *See* 37 C.F.R. § 42.65(a).

Further, under the governing statutes, Petitioners cannot use expert testimony to supply an element missing from the prior art. *See* 35 U.S.C. § 311(b). Moreover, the expert's declaration at paragraphs 121 to 123 contains no meaningful analysis, as it just cites to paragraph [0030] of Futaki and mimics the Petition's conclusory analysis. As will be established below, the unsupported conclusion of Petitioners and their expert completely unravels when other disclosures of Futaki are considered.

Before addressing how Futaki's disclosures expressly contradict Petitioners' theory, it is helpful to first turn back to the Petition, and address Petitioners' views as to why the '118 patent was allowed in the first place. Petitioners allege that "Patent Owner argued that the prior art taught the master base station 'decid[ing] to request the SeNB to add or modify radio resources for a specific E-RAB.'" Pet., 36 (citing Ex. 1002, 70). Petitioner adds a comment that "[t]he '118 Patent also discloses that the master base station 'decides to request the SeNB 120 to allocate radio resources for a specific E-RAB.'" Pet. 36 (citing '118 patent, 6:63-64; 6:60-66). But Petitioners fail to realize that this quoted disclosure in the '118 patent is describing "typical technology" and *not the disclosed improvement in the '118 patent*. *See* '118 patent, 6:60-61.

Petitioners then discuss Futaki with a sentence⁵ (Pet., 36) (emphasis added):

Futaki discloses the secondary base station (the 5G specific eNB 6) ***deciding to add*** radio resources for a specific (e.g., 5G) radio access bearer by having “[t]he New RRC layer 511 [] configure a signalling radio bearer with the 5G UE 1” ***without a request or instruction from the master (e.g., LTE+) base station.***

The alleged support for Futaki disclosing “deciding to add ... without a request or instruction from the master (e.g., LTE+) base station” provided by Petitioners is again paragraph [0030], which does not discuss the entity that determines whether to add a secondary base station SRB at all, let alone “without a request or instruction from the master (e.g., LTE+) base station.” All of those words were added by Petitioners.

Petitioners then turn to Fig. 8 of Futaki, but here Petitioners’ analysis completely falls apart. Petitioners argue that “Futaki’s 5G specific eNB 6 is shown in Figure 8 deciding to request the primary base station (LTE+ eNB 5) to allocate radio resources by deciding to initiate the secondary base station addition by first transmitting a message (e.g., X2AP Message Transfer step 801A, SeNB Modification Required message step 801B) including control information for the

⁵ If the Board were hoping that Petitioners’ expert would provide a clearer explanation, that hope would be futile. Petitioners’ expert mimics this statement, word for word, without explanation. Ex. 1013, ¶127.

secondary base station to the master base station, without an initial request from the master base station.” Pet., 36. Petitioners then annotate Fig. 8 of Futaki to contend that the annotated portions of Futaki, steps 801A or 801B of Fig. 8, disclose an “Initial request transmitted by secondary base station to add its own SRB.” Pet., 37. The support for that annotation is not provided. Petitioners then argue that “Futaki’s secondary base station ‘deciding’ the addition of the secondary base station SRB satisfies the claimed ‘determining.’” Pet., 37. No citation of support is provided for this assertion, and Petitioners fail to explain where the allegedly-quoted word “deciding” appears in Futaki. To be sure, the term “deciding” is not in paragraph [0030] of Futaki or in paragraphs [0079]-[0082], where Fig. 8 is discussed. In fact, Patent Owner has not been able to find the word “deciding” in Futaki.

Moving beyond Petitioners’ misleading suggestion that Futaki discloses the unexplained “deciding” step, Futaki’s Fig. 8 and corresponding disclosure expressly discloses that a second base station does not determine whether to add a secondary base station SRB. First, regarding steps 801A and 801B relied on by Petitioners, Futaki discloses that these steps involve “the 5G specific eNB 6 [sending] an X2 message to the LTE+ eNB 5, the X2 message including at least control plane information (CP message) regarding the new 5G cell.” Futaki, [0079]; *see also* Ex. 1008, [0079] (“the 5G specific eNB 6 [sending] an X2

message containing at least control plane information (CP messages) for the New 5G cell to the LTE+eNB5”). Thus, the messages sent in steps 801A and 801B are not messages demonstrating an instruction to “add” a secondary base station SRB to user equipment but, instead, are inter-base station messages to notify the master base station regarding the new 5G cell.

Step 802 of Futaki confirms this. In step 802, “[i]n response to receiving the X2 message, the LTE+ eNB 5 may *initiate* a SeNB Modification procedure.” Futaki, ¶[0080] (emphasis added); Ex. 1008, ¶[0080] (“LTE+eNB5 may initiate a SeNB Modification procedure in response to receiving the X2 message.”). Only then does the secondary base station communicate with the UE to add and configure the secondary base station SRB. Accordingly, in Futaki, the master base station initiates, or in the language of the claims, “determines” to add a secondary base station SRB to a UE. While this particular disclosure provides an example of a modification procedure, Petitioners have argued no differences in Futaki’s addition and modification procedures. *See* Pet., 26; Ex. 1003, ¶79.

Petitioners do not address step 802 anywhere in their Petition. Neither does Petitioners’ expert. It appears that once Petitioners provided their conclusory and unsupported analysis of steps 801A and 801B in Figure 8 “deciding to request the primary base station (LTE+ eNB 5) to allocate radio resources by *deciding to initiate* the secondary base station addition,” Pet., 36 (emphasis added), Petitioners

overlooked step 802 of Futaki and its express teaching as to where the “deciding to initiate” occurs, that is at the master base station (the LTE+eNB5). Futaki, [0080] (“[i]n response to receiving the X2 message, the LTE+ eNB 5 may *initiate* a SeNB Modification procedure.”) (emphasis added); Ex. 1008, [0080] (“LTE+eNB5 *may initiate* a SeNB Modification procedure in response to receiving the X2 message.”).

Accordingly, Petitioners’ unsupported and conclusory analysis of Futaki is contradicted by Futaki’s express disclosures and fails.

For completeness, Petitioners end their analysis by suggesting that the ’118 patent’s “determining” is the same as its “configuring.” Pet., 37-38. But “adding” and “configuring” are different terms in the patent claims. Thus, Petitioners’ attempt to argue that Futaki discloses “determining” the configuration of a secondary base station SRB does not answer the question of which component of Futaki “determines” to add a secondary base station SRB.

For the foregoing reasons, Petitioner’s Ground 1 against independent claim 1 fails. Petitioners’ theory against independent claim 7 incorporates its erroneous analysis of element [1.4] for element [7.1] (*see* Pet., 45) and fails for the same reasons. Concerning element [10.4], Petitioners incorporate the erroneous analysis of element [1.4] in addition to arguing that element [10.4] is non-limiting. *See* Pet., 49-50.

Petitioners' non-limiting argument fails for a number of reasons. First, Petitioners ignore that the Examiner allowed claim 10 after element [10.4] was added. *See* Ex. 1002, 65-67, 70 (concerning renumbered application claim 11); *see also* Pet., 12. Thus, under 35 U.S.C. § 325(d), Petitioners' argument is foreclosed. 35 U.S.C. § 325(d) provides that "[i]n determining whether to institute . . . , the Director may take into account whether, and reject the petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office." Here, the Examiner issued a rejection of a claim without element [10.4], and Patent Owner overcame that rejection by adding element [10.4], clearly indicating that the Examiner gave patentable weight to the limitation. Petitioners essentially argue that the Examiner was wrong in doing so, which makes Petitioners' argument the same argument before the Examiner. As such, it is foreclosed under § 325(d).

Moreover, element [10.4] is a limitation directed to the user equipment of claim 10 as it provides a requirement when the user equipment adds a secondary base station SRB, that is, when it is determined to be added by the secondary base station. This is not a "product by process" limitation as implied by Petitioners' citation to MPEP § 2113.

Accordingly, Ground 1 fails as Futaki fails to disclose the limitations of each independent claim 1, 7, and 10. Ground 2 also fails as Petitioners rely on their

erroneous analysis in Ground 1 for elements [1.4], [7.1], and [10.4] in Ground 2. See Pet., 59 (element [1.4]), 63 (element [7.1]), 67 (element [10.4]).

B. Futaki is Not Established to be Prior Art

Additionally, Petitioners have failed to prove that Futaki is prior art to the '118 patent. Petitioners assume “the earliest effective filing date of the '118 Patent is the May 12, 2016 filing date of the earliest priority Korean Patent Application.” Pet., 7-8. Futaki, however, was filed December 14, 2016. Ex. 1007. Petitioners admit that to rely on Futaki as prior art, they need to use Futaki's Japanese priority document, Japanese Patent Application JP 2016-002879. Pet., 8-9. But Petitioners did not include Japanese Patent Application JP 2016-002879 as an exhibit to the Petition, and instead included a purported translation of it as Ex. 1008. As such, Petitioners have failed to carry their burden of production and have presented no version of Futaki prior to May 12, 2016. Thus, the Petition has failed to carry its burden of establishing that Futaki is prior art.

V. THE DIRECTOR SHOULD DENY INSTITUTION UNDER *FINTIV*

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

When evaluating whether to discretionarily deny a petition, the Director may look to at least six factors:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the Petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020).

“These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* In evaluating these factors, the Director may take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*⁶

⁶ On February 28, 2025, the USPTO rescinded the “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (“Interim *Fintiv* Procedure”) dated June 21, 2022. The Interim *Fintiv* Procedure no longer applies to the *Fintiv* analysis. The most recent *Fintiv* guidance

A proper balance of the *Fintiv* factors warrants denial of institution.

A. Factor 1 Favors Denial (Likelihood of Stay)

Factor 1—which considers whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted—favors denial of institution. An institution decision in this case is due about *one month* before the scheduled trial, and institution decisions for at least three other involved patents are on this same late timeline. A stay under these circumstances would be unprecedented, and Petitioners have not presented argument or evidence to the contrary.

Further, Petitioners have not moved for a stay of the district court litigation. Petitioners cite to a discovery dispute to suggest Factor 1 weighs against discretionary denial. Pet., 68. But Petitioners did not establish that the outcome of the discovery dispute—whether non-jurisdictional discovery may proceed against a KT Corporation prior to resolving KT Corporation’s jurisdictional dispute—will affect the trial date of September 8, 2025 set by the district court. In fact, since the Petition was filed, the district court has twice granted motions for a protective order against non-jurisdictional discovery without any suggestion that the trial date

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

would be adjusted. Ex. 2001; Ex. 2002. Moreover, in the months after its Petition was filed, Petitioners have not requested a stay or that the trial date be adjusted.

Any stay is also unlikely due to the significant case progression (discussed in factor 3), a scheduled jury trial preceding any final written decision by roughly eleven months (discussed in factor 2), and the timing of institution decisions on the eight other pending IPRs against patents asserted in the same litigations (discussed in factor 6). Additionally, two of Petitioners’ other IPRs—IPR2025-00036 and IPR2025-00037—have already been denied by the Board under *Fintiv*, on April 25, 2025, due to the extensive activities that have already occurred in the co-pending litigation, the schedule of the upcoming trial, and the overlap in parties between those IPRs and the litigation. Between these *Fintiv* denials and the late stage of the co-pending litigation, a stay would be unprecedented.

The first *Fintiv* factor therefore supports denying institution or at worst remains neutral.

B. Factor 2 Favors Denial (Timing of Trial)

Fintiv factor 2 weighs in favor of denying institution because the district court is set to commence trial on September 8, 2025, nearly eleven months before the Board’s final decision would be expected to be due, on or about August 6, 2026. *See* Ex. 1020, 2; Ex. 2204. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of

exercising authority to deny institution under *NHK*.” *Fintiv*, IPR2020-00019, Paper 11 at 9.

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

The Board has previously held that a trial date which precedes a final written decision deadline by five, four and even one-to-two months favors discretionary denial. *See, e.g., Samsung Elecs. Co., Ltd. v. Mojo Mobility Inc.*, IPR2023-01092, Paper 11 at 11 (PTAB Jan 8, 2024) (denying institution, finding that a trial date “about five months before the projected statutory deadline” favored discretion to deny); *Bentley Motors Ltd., Jaguar Land Rover Ltd.*, IPR2019-01539, Paper 9 at 14 (PTAB Mar. 10, 2020) (denying institution where trial was set to occur five months before final written decision); *Immersion Sys. LLC v. Midas Green Techs., LLC*, PGR2021-00104, Paper 15 at 11 (PTAB Jan. 31, 2022) (jury trial starting four months ahead of final written decision favored discretionary denial); *see also NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18 at 8-9 (PTAB May 2, 2022) (two-month period between trial date and deadline for final decision

weighed in favor of discretionary denial); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 at 6-9 (PTAB May 15, 2019) (one-month period between trial date and deadline for final written decision weighed in favor of discretionary denial); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12-13 (PTAB May 13, 2020) (second factor favors denial when “the currently scheduled District Court trial is scheduled to begin two months before our deadline to reach a final decision”); *eClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (favoring denial where beginning of jury trial was “roughly one to two months” before final decision was due).

The USPTO’s Interim *Fintiv* Procedure, which was rescinded on February 28, 2025, provided that the “[p]arties may present evidence regarding the most recent statistics on median time-to-trial for civil actions in the district court in which the parallel litigation resides for the PTAB’s consideration ... the PTAB will also consider additional supporting factors, such as the speed and availability of other case dispositions.” *See* Interim *Fintiv* Procedure, 8-9; Memorandum from Chief Administrative Patent Judge at 3 (Mar. 24, 2025).

Here, the December 2024 statistics for the median time-to-trial in the Eastern District of Texas show a period of 23.0 months. Ex. 2018 at 5, (available at https://www.uscourts.gov/sites/default/files/2025-02/fcms_na_distcomparison1231.2024.pdf). The median time-to-trial statistics for

the district are thus consistent with the September 2025 trial date set out in Judge Gilstrap’s Docket Control Order, as the median time-to-trial statistics for the district predict a trial date in November 2025 (Ex. 2018) based on the December 29, 2023 filing date in district court. This small difference between the scheduled trial date and the statistical prediction—only about two months—still places the district court’s jury trial well before the estimated date of completion of this proceeding, on or around August 6, 2026. Accordingly, *Fintiv* Factor 2 weighs significantly in favor of denial. *Samsung Elecs.*, IPR2023-01092, Paper 11 at 11-12 (using statistics to “confirm[] that the schedule set by the district court is credible and should be given weight”).

Also, the suggestion in the Petition that there would be “post-trial motions” (Pet., 69) in order to suggest a later completion date for the district court litigation is inconsistent with *Fintiv* and provides an incorrect measurement. *Fintiv* does not account for activities occurring at the USPTO following a Final Written Decision, such as requests for rehearing or requests for Director Review, when considering whether there would be an undesirable overlap of activities. Instead, the time posts for measurement set out in *Fintiv* compare the date of the expected Final Written Decision to the expected trial date.

Judge Gilstrap has already set the date for the initial jury trial, and that jury trial will conclude well before the Board’s projected statutory deadline. *See* Ex.

1020; Ex. 2204. Additionally, the Court's Scheduling Order requires dispositive motions on issues such as (in)validity to be filed by June 2, 2025, and requires defendants to identify final invalidity theories by September 1, 2025. *See* Ex. 1020, 4 (setting the deadline for dispositive motions); *id.*, 2 (setting the deadline to disclose final invalidity theories); Ex. 2204 (same).

Petitioners' attempt to minimize the closeness of the scheduled trial date with the suggestion that "jury selection would proceed with respect to only one of the three cases" (Pet., 68-69) does not reduce the weight in favor of discretionary denial in this proceeding. When presented with a similar situation and argument, the PTAB has held "[e]ven if the proceedings are staggered, at least one of the proceedings would likely begin and conclude well before our decision, making it highly likely that there will be duplicate efforts in evaluating the challenged claims based on the prior art." *AT&T Serv. Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-00992, Paper 14 at 10-11 (PTAB Dec. 16, 2024) (weighing Factor 2 "substantially in favor of discretionary denial"); *see also AT&T Serv. Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-01142, Paper 14 at 13 (PTAB Jan. 27, 2025); *AT&T Serv. Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-01121, Paper 14 at 11-12 (PTAB Jan. 27, 2025). Further, all three cases are consolidated before Judge Gilstrap for all pre-trial purposes and therefore will be on equal procedural footing when the first trial begins on September 8, 2025.

Also, *HP Inc., et al. v. Neodron Ltd.*, IPR2020-00459, Paper 17 at 36, 38 (PTAB Sept. 14, 2020) does not support Petitioners’ theory that different trial dates weigh against discretionary denial. Rather, in *HP*, factor 2 was treated as neutral where one litigation—involving two of the co-petitioners—was stayed pending IPR. *Id.*, at 34 (noting the “ND Cal. action ... has been stayed pending [IPR].”). No stay is in place in this case, and a stay is unlikely to be granted. Further, all three cases are consolidated for all pre-trial purposes and therefore will be on equal procedural footing when the first trial begins on September 8, 2025. Therefore, even the conclusion in *HP* that this factor was “neutral” cannot apply here.

Google’s status as a co-petitioner here does not alter the analysis. Google joined the named defendants as a co-Petitioner, knowing that Google could be subject to the same post-IPR estoppel statutes as the named defendants. This shows Google’s willingness to be treated on parity with the other Petitioners and does not insulate all Petitioners from a *Fintiv* denial. *See Google LLC v. Cerence Operating Co.*, IPR2024-01465, Paper 15 at 13-14 (PTAB April 23, 2025) (“Petitioner Google’s presence in this proceeding does not raise the concerns that a *Fintiv* analysis is designed to address.”). *IQE PLC v. Cornell Rsch. Found. Inc.*, IPR2024-00609, Paper 9 at 12-13 (PTAB Sept. 13, 2024), cited by Petitioners in a separate IPR, is completely inapposite, as IPR2024-00609 was a ***single-petitioner case***, and did not involve a mixing of defendant and non-defendant petitioners.

IQE does not even remotely suggest that Google’s involvement here insulates the other Petitioners from the *Fintiv* analysis.

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

Thus, *Fintiv* factor 2 substantially weighs in favor of discretionary denial.

C. Factor 3 Favors Denial (Investment in Parallel Proceedings)

Factor 3 also weighs in favor of denial because the district court and both Patent Owner and Petitioners will have expended considerable resources in the parallel litigation, including on the merits of Petitioners’ invalidity positions, by the time the Board issues an institution decision. *See Sand Revolution II, LLC v. Cont’l Intermodal Grp.*, IPR2019-01393, Paper 24 at 10 (PTAB June 16, 2020) (noting that investment in invalidity contentions is relevant to this factor).

For factor 3, “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision” may be considered. *Fintiv*, IPR2020-00019, Paper 11 at 9. “This investment factor is related to the trial date factor, in that more work completed by the parties and the court in the parallel proceeding tends to support the arguments that the parallel

proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Id.*, 10.

Here, Patent Owner served infringement contentions on Petitioners in district court on March 18, 2024, allowing Petitioners ample time to prepare and serve their district court invalidity contentions on May 17, 2024, approximately two months later. Pet., 70; *see also* Ex. 2004. Yet, Petitioners delayed until December 26, 2024—over nine months after receiving infringement contentions—to file its Petition challenging the ’118 patent. Despite noting the date that the invalidity contentions were served in its Petition (Pet., 70), Petitioners provide no justification for the delay in filing their Petition. The PTAB has found when examining *Fintiv* that where “Petitioner has not presented any factual evidence to justify” a delay after being served with infringement contentions, factor 3 weighs in favor of denial of institution. *See AT&T Serv.*, IPR2024-00992, Paper 14 at 12 (“the record shows that Petitioner waited five months to file the Petition after receiving Patent Owner’s infringement contentions, and Petitioner has not presented any factual evidence to justify this delay.”) (citing *Fintiv*, IPR2020-00019, Paper 11 at 11–12); *see also AT&T Serv.*, IPR2024-01142, Paper 14 at 13–15; *AT&T Serv.*, IPR2024-01121, Paper 14 at 12–13.

The facts here weigh even more in favor of denial than in the *AT&T Services* cases. Here, there was a delay of an additional four months from the date when the

infringement contentions were served as compared to *AT&T Services*. Also, Petitioners served their own set of invalidity contentions in district court and are seeking to amend their initial contentions.

Petitioners assert two grounds in their Petition, and each Ground applies to all challenged claims (claims 1-15). Ground 1 contends the independent claims (claims 1, 7, and 10), and all of the challenged dependent claims (claims 2-6, 8, 9, and 11-15) are anticipated by, or obvious in view of Futaki. Ground 2 contends the independent claims, and all of the challenged dependent claims, are obvious over Futaki in view of 3GPP 36.300 and 3GPP 36.331.

Petitioners' initial invalidity contentions included claim charts against the '118 patent, but did not cite to the primary Futaki reference. Ex. 2004. On November 1, 2024, and again on December 23, 2024, Petitioners sought to increase the overlap by providing Patent Owner amended invalidity cover pleadings and later moved for leave to amend its invalidity contentions. Exs. 2050-2052. In the amendment, Petitioners added a claim chart to the Futaki⁷ reference presented in each of the Grounds against claims 1-3, 6-12, and 15. *See, e.g.*, Ex. 2051, 8, 22-23, 31-32, 37; Ex. 2053, 45-83 (Appx. F); Ex. 2054, 295-348

⁷Futaki and its counterpart are substantially the same, as the Futaki counterpart is a U.S. counterpart to Futaki. Specifically, Futaki is a PCT publication based on PCT application PCT/JP2016/087143. *See* Futaki, 1 (item 21). The Futaki counterpart is national stage entry of PCT application PCT/JP2016/087143. Ex. 2100 (item 86).

(Ex. F-13) (Futaki/Futaki counterpart). Petitioners also clarified reliance on the secondary reference to 3GPP 36.300. Ex. 2051, 22-23; Ex. 2053, 45-83. Although Petitioners did not call out a version of the 3GPP 36.331 standard with respect to the '118 patent, Petitioners did rely on a version of the 3GPP 36.331 standard in their invalidity contentions. *See, e.g.*, Ex. 2051, 18 (citing 3GPP 36.331 version 11.5.0). Petitioners seek to amend their invalidity contentions, which would result in nearly complete overlap between the Petition and the district court case. Patent Owner and Petitioners will have expended substantial resources in the parallel litigation, including on the merits of the invalidity positions, where—as detailed below—there has been a significant overlap of issues.

Indeed, given that the Board is projected to issue an institution decision by August 6, 2025, numerous labor-intensive activities such as these have taken place, or will take place, in the parallel litigations before that date. Fact discovery opened in early 2024, and is complete as of April 14, 2025. Further, Petitioners served their expert witness disclosures under Fed. R. Civ. P. 26(a)(2) relating to their invalidity contentions on April 21, 2025, and Patent Owner was required to similarly serve its infringement expert reports on that date.

Additionally, Patent Owner and Petitioners will expend significant time and resources relating to claim construction prior to August 6, 2025. The parties have exchanged preliminary claim constructions (November 26, 2024), prepared a Joint

Claim Construction Statement (December 17, 2024), completed claim construction discovery (January 14, 2025), served claim construction briefing and optional technical tutorials (beginning January 28, 2025), and participated in a claim construction hearing (March 11, 2025). These activities have taxed the resources of Petitioners and Patent Owner, as well as the district court.

Finally, as noted in factor 2, the Court's Scheduling Order requires dispositive motions on issues such as (in)validity to be filed by June 2, 2025, and requires defendants to identify its final invalidity theories by September 1, 2025. *See* Ex. 1020, 4 (setting the deadline for dispositive motions); *id.*, 2 (setting the deadline to disclose final invalidity theories); Ex. 2204 (same).

These investments in the district court proceeding favor denial.

D. Factor 4 Favors Denial (Overlap of Issues)

Factor 4 also weighs in favor of discretionary denial because there was substantial overlap between the claims, arguments, and evidence raised in the Petition and in Petitioners' invalidity contentions in the parallel district court proceeding.

As noted above, Petitioners assert two grounds in their Petition, and each relies on Futaki or Futaki in combination with 3GPP standards to challenge claims 1-15. Petitioners' amended invalidity contentions include a claim chart addressing the same Futaki reference asserted by Petitioners in its Petition against all claims 1-

15, including all of the independent claims, expert for dependent claims 4, 5, 13, and 14, which are not being asserted in the district court litigation. *See, e.g.*, Ex. 2051, 8, 31-32, 37; Ex. 2053, 45-83 (Appx. F); Ex. 2054, 295-348 (Ex. F-13) (Futaki/Futaki counterpart). Petitioners also clarified reliance on the secondary reference to 3GPP 36.300 in the amended contentions, and cited to a version of the 3GPP 36.331 standard in their contentions. *See, e.g.*, Ex. 2051, 22-23; Ex. 2053, 45-83; Ex. 2051, 18 (citing 3GPP 36.331 version 11.5.0). Thus, in district court, Petitioners' invalidity contentions challenged nearly the same set of claims of the '118 patent based on the substantially the same references. Thus, there was substantial overlap between the Petition and the district court proceeding, as the claims challenged and the primary references relied upon are substantially identical. Therefore, Petitioners' common prior art challenges to the claims renders the "overlap in issues between the two proceedings [] substantial." *Code200, UAB v. Luminate Networks, Ltd.*, IPR2020-01506, Paper 10 at 11-12 (PTAB Feb. 16, 2021).

Moreover, none of the Petitioners has offered a *Sotera* stipulation. *Inter Partes* Review is intended to be a "quick and cost effective alternative[] to litigation," not an avenue for Petitioners to argue invalidity a second time in a second venue. *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1317 (Fed. Cir. 2018) (quoting H. Rep. No. 112-98, at 40, 48 (2011)). Indeed,

Petitioners' failure to offer a *Sotera* stipulation, despite the substantial overlap between the proceedings, only highlights the concerns of duplicative efforts and conflicting outcomes raised by *Fintiv*.

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

Further demonstrating the intent to present overlapping contentions, Petitioners' invalidity contentions explicitly signal that Petitioners intended to rely on systems embodying the Futaki disclosures upon which it relies here. *See* Ex. 2004, 38 ("Moreover, in certain instances, representative documents for certain prior art systems are cited, but, again, are merely exemplary; they do not necessarily reflect or include every document relating to the prior art system that exists and that discloses or teaches a particular claim term or claim limitation.

Defendants reserve the right to rely on any and all documents that describe or relate to prior art systems, including relying on the system itself. Defendants also reserve the right to rely on the testimony of the authors, named inventors, or

anyone else with knowledge of the prior art references and systems identified herein, as well as expert testimony regarding any such references or systems.”) (emphasis added); Ex. 2004, 14 n.5 (“Defendants also hereby ***identify any systems or products that embody the technology described in any patent or publication identified in these Preliminary Invalidity Contentions***. Defendants reserve the right to rely on any documents or other evidence regarding such systems.”) (emphasis added); Ex. 2004, 29 (“All systems or products that embody the technology described in any patent or publication identified in these Preliminary Invalidity Contentions”); *see also* Ex. 2004, 8 n.2 (indicating Petitioners intend to “seek[] additional information related to the references and systems disclosed in these Preliminary Invalidity Contentions, and seek[] additional information related to available prior art systems”); Ex. 2050, 8 n.2, 9 n.5, 31, 34, 40; Ex. 2051, 9 n.2, 15 n.5, 31, 34-35, 41. Given that IPRs cannot reach the system prior art, even a *Sotera*-stipulation would not reduce the inefficiencies presented with these multiple proceedings. *See Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB Mar. 28, 2025).

Petitioners’ assertion in district court of *additional* prior art and *additional* combinations of art than those asserted here does nothing to alter the degree of overlap between the Petition and its invalidity contentions. *See, e.g., Fintiv*, IPR2020-00019, Paper 15 at 15 (finding Petitioner’s assertion of additional

invalidity contentions “not relevant to the question of the degree of overlap for this factor”).

Petitioners argue that there is not perfect overlap between this IPR and the district court cases “because there are 15 claims asserted in this case and a total of 113 asserted in the related district court cases” (Pet., 70-71), but this argument misses the mark. The 113 litigated claims include claims in patents other than the ’118 patent, and the existence of other litigated claims does not diminish the overlap that existed between the claims in this IPR and the same fifteen litigated claims. But even when there is not a perfect alignment between the claims in IPR and litigation, the Board has repeatedly ruled that the assertion of additional claims does nothing to mitigate “substantial” overlap in issues between the two proceedings where common prior art is presented and common independent claims are challenged. *See, e.g., Code200, UAB*, IPR2020-01506, Paper 10 at 11-12 (“In light of the common prior art asserted here and in the [] district court case, as well as the common challenge to the sole independent claim and all but two of the dependent claims of the [’384] patent, we agree with the Patent Owner that the overlap in issues between the two proceedings is substantial.”); *see also Teso LT UAB v. Luminati Networks Ltd.*, IPR2021-00122, Paper 12 at 10 (PTAB Apr. 20, 2021) (denial of institution favored where Petition’s prior art references were all identified in the district court invalidity contentions, the same independent claims

were challenged in both proceedings, and “the *additional* claims challenged in the Petition are all dependent claims”).

Therefore, due to substantial overlap that existed between the Petition and the parallel proceedings, there are particularly strong “concerns of inefficiency” if the IPR is instituted. *See, e.g., Fintiv*, IPR2020-00019, Paper 11 at 12 (finding “concerns of inefficiency” where there is substantial overlap).

Accordingly, factor 4 weighs strongly in favor of denying institution. *See Teso LT UAB*, IPR2021-00122, Paper 12 at 10 (finding “the overlap in issues between the two proceedings is substantial” where common art and common challenges to the independent claim were presented in both proceedings); *see also eClinicalWorks*, IPR2022-00229, Paper 10 at 12 (finding factor 4 weighed in favor of denial where Preliminary Invalidity Contentions showed overlap of asserted claims, art and arguments asserted in the Petition); *U.S. Venture, Inc. v. Sunoco Partners Mktg. & Terminals L.P.*, IPR2020-00728, Paper 10 at 12-14 (PTAB Oct. 1, 2020) (finding overlap between primary references asserted in Petition and litigation weighed in favor of denial).

For each of these reasons, factor 4 strongly favors discretionary denial.

E. Factor 5 Favors Denial (Overlapping Parties)

Patent Owner is the plaintiff and Petitioners are involved in the parallel litigation (Ex. 1020; Ex. 2204),⁸ and “because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Samsung Elecs. Co. v. Clear Imaging Research, LLC*, IPR2020-01401, Paper 12 at 21-22 (PTAB Feb. 17, 2021) (quoting *Fintiv*, IPR2020-00019, Paper 15 at 15). Factor 5 weighs strongly in favor of denial for the same reasons presented above for Factor 2.

F. Factor 6 Favors Denial (Other Factors)

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

The litigation dispute between Patent Owner and Petitioners involves 11 patents, and the three federal litigations involving those 11 patents were filed in the district court on a single day, December 29, 2023. But rather than present its IPR challenges in a single group, Petitioners filed their IPRs in a piecemeal fashion and on a slow-rolling basis. In total, over the period from October 18 to December 31,

⁸ To the extent Petitioners argue that the presence of Google as a Petitioner in this proceeding lessens the weight of Factor 5, that argument should be rejected. The inefficiencies caused by the presence of the numerous overlapping petitioners are not abated simply by including a petitioner who is not a named defendant in the underlying district court litigation.

IPR2025-00290 Patent Owner’s Preliminary Response

2024, Petitioners filed eleven IPRs. The following table summarizes the dates the eleven IPRs were filed, the IPR proceeding number, the date on which the USPTO’s Notice according a filing date was issued, the anticipated institution deadline, and the anticipated final written decision deadline⁹:

Filing Date	IPR	Notice of Filing Date	Date of Institution Decision (Est.)	Date of Final Written Decision (Est.)
10/21/24	IPR2025-00036	10/30/24	4/25/25 (denied)	N/A
10/18/24	IPR2025-00037	10/30/24	4/25/25 (denied)	N/A
11/15/24	IPR2025-00083	12/9/24	6/9/25	6/9/26
11/15/24	IPR2025-00084	12/9/24	6/9/25	6/9/26
12/24/24	IPR2025-00137	1/17/25	7/17/25	7/17/26
11/27/24	IPR2025-00138	1/29/25	7/29/25	7/29/26
12/26/24	IPR2025-00290	2/6/25	8/6/25	8/6/26
12/27/24	IPR2025-00291	2/6/25	8/6/25	8/6/26
12/31/24	IPR2025-00292	2/6/25	8/6/25	8/6/26
12/31/24	IPR2025-00293	2/6/25	8/6/25	8/6/26
12/24/24	IPR2025-00317	1/17/25	7/17/25	7/17/26

Two of Petitioners’ other IPRs—IPR2025-00036 and IPR2025-00037—have already been denied institution by the Board under *Fintiv*, on April 25, 2025, due to the extensive activities that have already occurred in the co-pending litigation, the schedule of the upcoming trial, and the overlap in parties between those IPRs and the litigation. This IPR is one of nine remaining decisions on

⁹ Google joined the Petitioners as an additional petitioner in each of these IPR proceedings except for IPR2025-00036 and IPR2025-00037.

institution the Board or Director needs to make relating to the dispute between the Parties. As the Board or Director will approach the decisions serially, the strength of the *Fintiv* factors in favor of exercising discretion to deny institution will only become stronger. In particular, at least the first and third *Fintiv* factors will weigh more heavily in favor of denial as the estimated final written decision deadline for each IPR extends farther beyond the anticipated trial date of September 8, 2025.

Moreover, the complexity of this global dispute between Petitioners and Patent Owner encourages resolution in a single forum, without the risk of inconsistent results. While the Board generally evaluates each petition on its own, district courts have additional tools available for resolving suits involving multiple patents, including established procedures for such disputes, deadlines for narrowing issues including the asserted claims and the invalidity contentions, and driving resolution of the dispute as a whole. *Cf.* Pet., 71 (“The district court will likely reduce the asserted claims”). For example, as noted above, the district court has already consolidated the district court proceedings for “all pretrial issues” (Ex. 1021) and the consolidated action is progressing at pace towards a September 2025 trial date.

Further, Patent Owner has chosen to narrow the dispute by not serving an infringement expert report for the '118 patent involved in this proceeding, as well as for three other patents (Patent Owner did not serve expert reports for the patents

involved in IPR2025-00083, -00290, -00291, and -00317). As noted above, such narrowing of a dispute in district court is both encouraged and expected. Yet, narrowing can present unequal considerations before the Board. A petitioner with more resources than a patent owner may be motivated to continue marching forward with *inter partes* review despite their being no tangible effect on the overall dispute other than the gamesmanship of taxing the resources of its district court opponent. Here, the potential for gamesmanship is heightened, as some of the largest companies in the world have teamed up in this proceeding.

When confronting an eleven-patent dispute before a district court, efficiency should allow and encourage patent owners to have the flexibility to narrow the dispute without being forced to expend their resources to litigate issues before the Board that will have no bearing on the dispute, regardless of whether a petitioner (or large group of petitioners) has the resources to continue to asymmetrically burden the patent owner.

As noted in the introduction above, Patent Owner anticipates that Petitioners will argue that the Board should institute this proceeding because the District Court will not decide the validity of the '118 patent. But the fact that Patent Owner did not serve an expert infringement report regarding the '118 patent makes the validity of the '118 patent less important to the global dispute between the parties, not more important. And conserving resources of the Board also favors denial, as

there is also no reason to expend Board resources to decide the validity of fifteen patent claims that have been dropped from the co-pending litigation.

Furthermore, the merits of this Petition are weak. Far from presenting “a compelling unpatentability challenge,” *see Fintiv*, IPR2020-00019, Paper 11 at 13-14, the flaws in Petition are numerous. As explained in the preceding Section IV, the merits of the challenges asserted in the Petition are not compelling, and do not support institution.

Even if the Board chooses not to evaluate the merits of the challenges, the remaining *Fintiv* factors overwhelmingly favor denial. Where the bulk of the factors weigh in favor of denial, the Board has found that it “need not decide whether the merits of Petitioner’s asserted grounds are particularly strong because it would not impact [the] ultimate determination under Section 314(a)” and “the merits do not outweigh the other *Fintiv* factors.” *NXP USA*, PGR2022-00005, Paper 18 at 12-13 (finding that where factor 1 was neutral and factors 2-5 favored or slightly favored denial, factor 6 was neutral because it “would not impact [the] ultimate determination”); *Samsung Elecs.*, IPR2020-01401, Paper 12 at 23-25 (finding that where factors 1 and 4 slightly favored denial, factors 2 and 3 strongly favored denial, and factor 5 weighed in favor of denial, those factors outweighed any merits of the case considered in factor 6); *Apcon, Inc. v. Gigamon Inc.*, IPR2020-01579, Paper 9 at 26 (PTAB Mar. 16, 2021) (finding that the merits of

the petitioner's grounds do not outweigh the other factors in light of the strength of factors 2); *see also Fintiv*, IPR2020-00019, Paper 11 at 15 ("if the merits of the grounds raised in the petition are a close[] call, then that fact has favored denying institution when other factors favoring denial are present").

Accordingly, for the reasons stated above, Factor 6, and each of the remaining *Fintiv* factors counsel in favor of the Board exercising its discretion to deny institution.

VI. CONCLUSION

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

Dated: May 5, 2025

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CERTIFICATE OF WORD COUNT

The undersigned certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE complies with the type-volume limitation in 37 C.F.R. § 42.24(b)(1). According to the word-processing system's word count, the brief contains 9,406 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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CERTIFICATE OF SERVICE

Petitioner has consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on May 5, 2025, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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