

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.

KT CORPORATION (Patent Owner) and
PEGASUS WIRELESS INNOVATION LLC (Exclusive Licensee)

Case No. IPR2025-00290

Patent 10,721,118

**PETITIONERS' OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. ANALYSIS.....	2
A. <i>Fintiv</i> is Inapplicable and Efficiency and Fairness Weigh in Favor of Institution.....	2
B. The Strength of the Petition Weighs in Favor of Institution.....	6
1. Futaki Discloses “wherein the addition of the secondary base station SRB is determined by the secondary base station”	6
2. PO’s Argument that Discretionary Denial is Warranted Given that Element [10.4] is Limiting Fails	12
III. CONCLUSION.....	14
APPENDIX A - LIST OF EXHIBITS	
CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. §42.24	
CERTIFICATE OF SERVICE	

TABLE OF AUTHORITIES

Cases	Page(s)
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020).....	1, 2, 3, 4
<i>Epic Games, Inc. v. Ingenioshare, LLC</i> , IPR2022-00295, Paper 11 (P.T.A.B. Jun. 7, 2022).....	2
<i>ETN Capital, LLC d/b/a Beech Lane v. FBA Operating Co.</i> , IPR2024-01445, Paper 14 (P.T.A.B. Feb. 28, 2025).....	2
<i>The Data Company Technologies Inc. v. Bright Data Ltd.</i> , IPR2022-00135, Paper 12 (P.T.A.B. Jun. 1, 2022)	3
 Statutes	
35 U.S.C. §314(a)	5, 12
35 U.S.C. §325(d)	13

I. INTRODUCTION

Pursuant to the Director's Memorandum issued on March 26, 2025, Petitioners file this opposition to Patent Owner's Request For Discretionary Denial, Paper 12 ("Request"). Patent Owner ("PO") has requested discretionary denial of institution of the Petition for *inter partes* review of the '118 Patent on the basis that "each *Fintiv* factor weighs in favor of the Board exercising its discretion to deny institution" in view of the related district court litigation, *Pegasus Wireless Innovation LLC v. Cellco Partnership d/b/a Verizon Wireless et al.*, No. 2:23-cv-00640-JRG (E.D. Tex.) ("Related Litigation"). Request, 1. ***The '118 Patent has been dismissed from the Related Litigation.*** EX1025. *Fintiv* is not applicable given that there is no parallel litigation involving the same patent challenged in this IPR. PO's Request does not address this fact.

In addition to dropping the '118 Patent, PO has also dropped three additional patents at issue in the Related Litigation, along with numerous claims of the remaining patents. This fact, coupled with the absence of system prior art contentions and the planned submission of *Sotera* stipulations with respect to all remaining patents at issue in the Related Litigation, render the PTAB the most judicially efficient forum for adjudicating all prior art invalidity issues.

PO's Request also demonstrates the strength of Petitioners' unpatentability challenges because the Request resorts to mischaracterizing and/or ignoring

arguments in the Petition. As discussed in greater detail below, PO’s argument that the Petition fails to demonstrate that Futaki discloses “wherein the addition of the secondary base station SRB is determined by the secondary base station” is incorrect and is reached only because PO ignores many arguments in the Petition.

This Opposition demonstrates that the *Fintiv* factors do not apply here, and in view of considerations of fairness and efficiency, coupled with the strength of the grounds set forth in the Petition, discretionary denial is not warranted.

Accordingly, Petitioners hereby respectfully request that the Board deny PO’s Request and grant the Petition to institute *inter partes* review of the ’118 Patent.

II. ANALYSIS

A. *Fintiv* is Inapplicable and Efficiency and Fairness Weigh in Favor of Institution

PO’s Request focuses on a *Fintiv* analysis, which examines factors relating 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.*” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (P.T.A.B. Mar. 20, 2020) (emphasis added). Here, the ’118 Patent has been dismissed from the district court litigation without prejudice. EX1025. There is no parallel proceeding and therefore discretionary denial based on *Fintiv* no longer applies. *ETN Capital, LLC d/b/a Beech Lane v. FBA Operating Co.*, IPR2024-01445, Paper 14 at 11 (P.T.A.B. Feb. 28, 2025); *Epic Games, Inc. v. Ingenioshare, LLC*, IPR2022-00295, Paper 11 at 17

(P.T.A.B. Jun. 7, 2022); *The Data Company Technologies Inc. v. Bright Data Ltd.*, IPR2022-00135, Paper 12 at 10-11 (P.T.A.B. Jun. 1, 2022).

The PTAB’s precedential *Fintiv*, *NHK*, and *Sotera* decisions addressed judicial efficiency concerns arising from assessing validity of the same patent in both the PTAB and district court. *See, e.g., Apple Inc. v. Fintiv, Inc.*, IPR202000019, Paper 11 at 8-11 (P.T.A.B. Mar. 20, 2020) (analysis focused on “the challenged patent”, “the patent at issue in the petition”, overlap of the “same or substantially the same claims” of the patent). Indeed, the Consolidated Trial Practice Guide explains that *NHK-Fintiv* denials focus on “events in other proceedings related to the same patent”. PTAB Consolidated Trial Practice Guide (Nov. 2019) at p. 58 (emphasis added). Since the parties have agreed to dismiss the ’118 Patent from the related litigation, the “same patent” is not at issue in the related litigation and this IPR, and discretionary denial is unwarranted.

Nonetheless, despite the absence of any parallel proceeding, PO’s Request urges that discretionary denial is somehow appropriate.¹ To the extent PO suggests

¹ Petitioners reserve the right to challenge the March 26, 2025 Interim Processes for PTAB Workload Management at least because it is legally invalid as (1)

that its decision to dismiss the '118 Patent from the district court litigation indicates the '118 Patent to be of less importance such that resources should not be spent on it, Petitioners are unaware of any Patent Office guidance that the “importance” of a patent should be considered a factor relevant to whether the Board should exercise its discretionary denial authority. Moreover, if the '118 Patent indeed is of less importance, then that fact would weigh against the Board exercising its discretionary denial authority. By exercising its discretion in such a manner, the Board would be shirking its responsibility to Petitioners who are seeking its assistance in cancelling the weak, allegedly less important patent claims that PO nonetheless asserted and that Petitioners had been forced to defend against. Moreover, PO has not offered Petitioners a covenant not to sue.

Although *Fintiv* does not apply, efficiency and fairness concerns here nonetheless weigh in favor of the Board denying PO's Request. As it stands, with the '118 Patent dismissed from the Related Litigation without prejudice, the most expedient path Petitioners have to address the validity of the asserted claims is to seek the Board's assistance. Moreover, this is the only opportunity that Petitioners

exceeding the Director's authority, (2) arbitrary and capricious, and (3) adopted without notice-and-comment rulemaking.

will have to challenge the '118 Patent in an IPR proceeding because the one-year statutory bar for challenging the '118 Patent through an IPR has passed. As such, Petitioners will have no other opportunity to call upon the Board's assistance, yet PO may still assert the '118 Patent against Petitioners in future litigation given that the dismissal was without prejudice (PO has not offered Petitioners a covenant not to sue, as noted above). Discretionary denial would be unfair since PO may once again assert the '118 Patent against Petitioners in future litigation, yet Petitioners are barred from challenging the validity of the '118 Patent in this forum. Discretionary denial would allow patent owners to assert a patent to trigger the statutory bar and move for dismissal only to reassert the patent, leaving petitioners no recourse at the PTAB. This cannot be the intended framework under Section 314(a).

Indeed, instituting an IPR now promotes judicial efficiency, fairness, and patent quality. Given the possibility of future litigation involving the '118 Patent and the fact that PO has not granted Petitioners a covenant not to sue, efficiency considerations counsel that the Board should address the validity of the '118 Patent now as part of the overarching dispute between the parties.

Given the Board's expressed goals of efficiency, fairness and the desire to root out weak patents, the Board should deny PO's Request.

B. The Strength of the Petition Weighs in Favor of Institution

The Petition presents compelling evidence of invalidity for the reasons explained below.

1. Futaki Discloses “wherein the addition of the secondary base station SRB is determined by the secondary base station”

PO asserts that “Futaki fails to disclose a secondary base station that determines whether to add a secondary signaling radio bearer (SRB) to user equipment (UE).” Request, 25. According to PO, “Futaki’s master base station determines whether to add a secondary signaling radio bearer (SRB) to user equipment (UE).” Request, 25-26. PO is wrong. PO misapprehends Futaki’s disclosure and overlooks the meaning of “determine” when read in light of the ’118 specification and prosecution history, discussed below.

As explained in the Petition, Futaki discloses “wherein the addition of the secondary base station SRB is *determined* by the secondary base station.” Futaki expressly discloses a secondary base station “configur[ing] a signalling radio bearer with the 5G UE 1” EX1007, ¶[0030]; EX1008, ¶[0030]; Pet., 35. Futaki discloses that the “New RRC layer 511” of the “New 5G CG” corresponding to the 5G specific eNB (e.g., a secondary base station) configures the addition of the secondary SRB. *Id.* The Petition explains what is encompassed by “determined by the secondary base station” in view of the ’118 Patent specification and prosecution history. Pet., 36-38.

Futaki discloses “determining” the addition of the secondary base station SRB expressly involving the master base station (e.g., to perform a secondary base station addition procedure) to the same extent as described in the ’118 Patent.

PO argues that “paragraph [0030] of Futaki includes no detail concerning what entity ‘determines’ to add a secondary base station SRB” and “no mention of ‘determining’ or ‘initiating’ *or similar actions* in paragraph [0030] of Futaki.” Request, 26-27 (emphasis added). PO is wrong.

Addressing PO’s first point, Futaki is clear that the secondary base station “determines” to add a secondary base station SRB. Futaki states that “*the New RRC layer 511* may configure the lower layers 406-408 of the New 5G CG” and “[t]he *New RRC layer 511* may set up a signaling radio bearer with the 5G UE 1” where “*a 5G specific eNB 6* used in a non-co-located deployment may have *a New RRC layer 511*”. EX1007, ¶[0030]; EX1008, ¶[0030]; Pet., 35 (emphasis added). Futaki is thus clear that *the New RRC layer provided by the 5G specific eNB* (e.g., the secondary base station) “determines” the addition of the secondary base station SRB because Futaki states that the New RRC layer configures the lower layers and sets up the signaling radio bearer with the UE. *See* Pet, 35-38. EX1013, ¶¶124-130.

PO also asserts that Futaki makes no mention of “similar actions”, but PO does not explain what such “similar actions” would include. On the other hand, the Petition provides a detailed explanation of what “determining” encompasses. *See*

Pet., 36-38. Indeed, a review of the '118 specification and prosecution history reveals that the claimed “determining” encompasses the actions disclosed by Futaki.

For example, the Petition explains that “determining” encompasses similar actions including “deciding” (as used by Applicant in the prosecution history, *see* EX1002, p.70 and in the '118 Patent specification, *see* EX1001, 6:63-64) and “configuring” (used in the '118 Patent specification, *see* EX1001, 14:58-62; 14:54-15:3). The '118 Patent is clear that “configuring” is encompassed by “determining” because “configuring” ***denotes that the NR BS determines to add an SRB*** (e.g., SRB1) between the UE and the NR BS to a corresponding UE, and generates configuration information for this.” EX1001, 14:58-62; 14:54-15:3; Pet., 37 (emphasis added). Thus, Futaki’s express disclosure that “the New RRC layer 511 may ***configure*** the lower layers 406-408 of the New 5G CG” and “***set up a signaling radio bearer with the 5G UE***” satisfies “determining” in view of the specification of the '118 Patent. EX1007, ¶[0030]; EX1008, ¶[0030]; *See* Pet., 35-38. Futaki plainly discloses the secondary base station “configuring” the secondary base station SRB in paragraph [0030], as “[configuring] ***denotes that the NR BS determines to add an SRB*** (e.g., SRB1) between the UE and the NR BS”. Pet., 37. *See* Pet., 35-38. EX1013, ¶¶124-130.

PO misapprehends Petitioners’ reliance on the '118 specification. Specifically, PO asserts that Petitioners cite a portion of the '118 Patent that merely

describes the “typical technology,” i.e., wherein the master base station performs the “determining.” Request, 27-28. PO misapprehends the reason why Petitioners cite this ’118 disclosure. Petitioners cite this ’118 disclosure to explain what is meant by “determining” in the ’118 Patent. Specifically, the Petition states 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 EX1001, 6:63-64; 6:60-66). Petitioners cite this disclosure to show that, according to the ’118 specification, the claimed “determining” is closely related to “deciding”—not that the “determining” is performed by the master base station. In contrast to this “typical technology”, Futaki discloses that it is the secondary base station that decides/determines, just as disclosed and claimed in the ’118 Patent. Pet., 36.

In an attempt to refute Petitioners’ arguments regarding Fig. 8 of Futaki (*see* Pet., 36-38), PO asserts that “the master base station initiates, or in the language of the claims, ‘determines’ to add a secondary base station SRB to a UE.” Request, 30 (citing EX1007, ¶[0080]). However, PO’s selection of “initiating” arises from a section in Futaki that is separate from paragraph [0030], and is a portion which PO mischaracterizes in the Request. *Id.*

PO instead elects to suggest a term of “initiating” only because PO believes, incorrectly, that “initiating” in the context of Futaki supports their argument, while

“deciding” and “configuring” do not. *See* Request, 25-28. PO ignores “deciding” and “configuring”, evidenced by PO’s failure to recognize arguments in the Petition.

As quoted by PO, Futaki discloses “[i]n step 802, ‘[i]n response to receiving the X2 message, the LTE+ eNB 5 may **initiate** a SeNB Modification procedure.” Request, 30 (citing EX1007, ¶[0080] (emphasis in Request)). PO completely fails to address the portion of Futaki before “initiating”, which states that “initiating” by the master base station (e.g., the LTE+ eNB 5) occurs “***in response to*** receiving the X2 message” where the X2 message denotes ***the secondary base station “determining” to add the secondary base station SRB.*** *See* Pet., 36-38. In other words, the secondary base station first transmits an X2 message to “configure”, “determine”, or “decide” to add the secondary base station SRB, where the X2 message provides control information to the master base station. In Futaki, the master base station does not “decide to request the SeNB to add or modify radio resources” (EX1002, p.70), but only performs the initiation “in response to receiving the X2 message” from the secondary base station.

Thus, while the master base station may have some involvement in “initiating” the addition ***procedure***, the “determining” of the addition is performed by the secondary base station, as plainly shown by Figure 8 of Futaki. Pet., 36-38. Even further, Figure 8 of Futaki shows step 805 in which the secondary base station “configures” the secondary base station SRB with the UE. Pet., 37-38. *See*, EX1007,

Fig. 8; EX1008, Fig. 8. Futaki thus expressly discloses the 5G specific eNB “determining” the addition of the secondary base station SRB.

PO’s only argument against Figure 8 of Futaki is that nowhere does Figure 8 disclose the term “deciding” and thus Futaki “expressly discloses that a second base station does not determine whether to add a secondary base station SRB.” Request, 29-30. As explained here and in the Petition, steps 801A and 801B in Figure 8 of Futaki plainly support “deciding”, “configuring”, and/or “determining” to add the secondary base station SRB. PO even admits that steps 801A and 801B “are inter-base station messages *to notify the master base station regarding the new 5G cell.*” Thus, prior to notifying (or with notification to) the master base station, the secondary SRB “decides” and/or “determines” to add the secondary base station SRB, without any request or instruction from the master base station, in order to “notify the master base station.” Request, 30. *See* Pet., 36. The secondary base station of Futaki’s Fig. 8 clearly “determines” the addition of the secondary base station SRB.

PO’s argument fails because it relies on a mischaracterization of Futaki. While PO also asserts that Petitioner has not addressed differences in Futaki’s modification and addition procedure, there is no need to do so. Futaki discloses both addition and modification procedures, which were well known in the art. *See* Pet., 25-30. *See also* EX1007, ¶[0063]; EX1008, ¶[0063].

Finally, PO argues that “‘adding’ and ‘configuring’ are different terms in the patent claims.” Request, 31. However, the specification and the claims of the ’118 Patent consistently use these terms together (e.g., as “add and configure”) and interchangeably. EX1001, 9:50-51, 24:2-3, 24:11-12, cl.1, cl.10.

For the reasons explained in the Petition, the cited art discloses “wherein the addition of the secondary base station SRB is determined by the secondary base station.”

2. PO’s Argument that Discretionary Denial is Warranted Given that Element [10.4] is Limiting Fails

PO’s argument that discretionary denial is warranted given that Element [10.4] is limiting (*see* Request, 32-33) fails for at least three reasons.

First, Petitioners explained how the prior art satisfies Element [10.4] even if Element [10.4] is found to be limiting. Pet., 50 (“Even if found limiting, Element [10.4] is disclosed by Futaki...”). PO does not address this issue.

Second, PO’s argument concerning claim 10 is irrelevant to the issue of institution given the strength of the merits concerning all other Challenged Claims. *See* 35 U.S.C. §314(a) (authorizing institution where “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”). Petitioners’ argument that Element [10.4] is non-limiting is but one alternative basis for unpatentability relating to a single element of a single claim among 15 challenged claims.

Third, PO's reliance on Section 325(d) is without basis. The Examiner never expressly considered the issue of whether Element [10.4] is limiting or non-limiting. PO cites no statements made by the Examiner for support. Nowhere did the Examiner consider an argument that claim 10 was non-limiting due to being a process step performed by another system—which is the “argument” articulated in the Petition. The Examiner provided no specific reasons for allowance of claim 10 beyond referencing the Applicants remarks. EX1002, p.49. Contrary to PO's assertion, Applicant argued the merits of claim 1 without any express reliance on Element [10.4], much less any affirmative argument that Element [10.4] is limiting. EX1002, p.71.

Assuming (incorrectly) that the evidence supports a finding that the Examiner previously determined that Element [10.4] is limiting, this determination constitutes material error for the reasons explained in the Petition. Notably, PO does not even affirmatively argue that Element [10.4] is limiting, only that Petitioners' argument against Element [10.4] is foreclosed by § 325(d).

III. CONCLUSION

For the foregoing reasons, the Director should deny PO's Request for discretionary denial of institution.

Date: June 5, 2025

Respectfully submitted,

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APPENDIX A - LIST OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 10,721,118, issued on July 21, 2020 (“the ’118 Patent”)
1002	File History of U.S. Patent Application No. 16/300,557, filed on November 10, 2018 (“the ’557 Application”)
1007	Certified English Translation of PCT International Publication No. WO 2017/119247 to Futaki <i>et al.</i> , published on July 13, 2017 (“Futaki”)
1008	Certified English Translation of JP 2016-002879
1013	Declaration of Sumit Roy
1025	Order dated May 19, 2025 [Dkt. 334] in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc., et al.</i> , Civ. Action No. 2:23-cv-00640 (E.D. Tex.)

CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. §42.24

Pursuant to Acting Director Stewart's March 26, 2025 Memorandum on Interim Processes for PTAB Workload Management, the undersigned certifies that the foregoing Opposition to Patent Owner's Brief Requesting Discretionary Denial of Institution totals 2,947 words, excluding the parts which are exempted by 37 C.F.R. §42.24.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 5th day of June, 2025, a true and correct copy of the foregoing **PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** is being served via electronic mail upon counsel for Patent Owner as follows:

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