

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 IPR2025-00293
U.S. Patent No. 10,009,161

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)
2052-2202	Reserved
2203	Consolidation 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 Feb. 13, 2024)
2204	Fifth Amended Docket Control Order, issued April 14, 2025
2205-2249	Reserved
2250	Appendix K to Defendants' Preliminary Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex May 17, 2024)

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2251	Ex. K-3 of Appendix K to Defendants' Preliminary Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex May 17, 2024)
2252	Ex. K-8 of Appendix K to Defendants' Preliminary Invalidity Contentions in <i>Pegasus Wireless Innovation LLC v. Verizon Communications Inc. et al.</i> , Nos. 2:23-cv-00640, 2:23-cv-00638, 2:23-cv-00639 (E.D. Tex May 17, 2024)

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 1-6 of U.S. Patent No. 10,009,161 (the “’161 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

This Petition is a prototypical example of one that relies on expert testimony in place of “prior art consisting of patents or printed publications,” in violation of 35 U.S.C. § 311(b). For element [1.9], which recites that a code rate value “is calculated to be 797,” Petitioners note that their primary reference, Xia, “includes a ‘different another code rate value’ of 790” and not the claimed code rate value of 797. Pet., 39. Petitioners then rely on no less than 48 paragraphs of testimony spanning 14 pages to try to explain why it would be obvious to use a code rate value of 797 instead of 790. *See* Ex. 1008, 47-61, ¶¶140-188.

In the midst of that blizzard of testimony, Petitioners’ expert includes clear errors. For example, the expert alleges that “[t]he ’161 Patent does not explain how or why the 797 code rate was chosen for inclusion in its claimed CQI table.”

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).

Ex. 1008, ¶151. This is wrong. Describing Figure 18, which includes an “R” code rate value of 797, the ’161 patent explains that “‘R’ values are determined so that differences of the required SNRs between adjacent CQI indexes are almost the same using required SNRs of FIG. 17 and Equation 2.” ’161 patent, 14:7-11; *see also* ’161 patent, 13:53-14:11; Fig. 21; 14:43-53.

The expert also opines that R1-141366 (Ex. 1030) was “publicly available before the earliest priority date” of the ’161 patent (Ex. 1008, ¶154)—which is March 21, 2014—but the date given on the face of Ex. 1030 is “31th March– 4th April, 2014,” (Ex. 1030) and the expert does not provide any evidence of a date prior to March 21, 2014. In fact, the expert later opines that Ex. 1030 is “not prior art.” Ex. 1008, ¶162.

Additionally, the expert relies on another reference, R1-142638 (Ex. 1028), that is acknowledged not to be prior art (Ex. 1008, ¶166), as “evidence” that the code rate value of 797 “was a non-critical value.” The use of non-prior art exhibits like Ex. 1028 and Ex. 1030 shows that the Petition is not based on “prior art consisting of patents or printed publications.”

The expert further steps outside of the realm of an expert in engineering and into the realm of patent law by opining that “[t]he PTAB has consistently found claimed numerical limitations obvious where they involve no more than routine optimizations of predictable techniques” (¶180), “[t]his difference does not impart

patentability” (§140), “[s]election of the 797 code rate is not patentable” (§178).

Each of these opinions reflect the main position of the Petition that it would have been obvious to change the stated code rate value in the Xia reference from 790 to 797.

Notwithstanding the Petition's and expert's flawed theories, Petitioners also ignore that the claimed 797 code rate is part of a set of claimed code rates, including claimed code rates of 711 and 948. Petitioners and their expert do seem to recognize that, with whatever “routine optimization” a POSITA would use, that optimization could have an effect on the other values in the set of code rate values. But Petitioners fail to address what their proposed change of a code rate from 797 to 790 would be, and whether that change would have been obvious while satisfying the other claimed code rates of 711 and 948. Petitioners' challenge fails as it has offered no analysis of how any “routine optimization” would affect the other claimed code values and whether such a change would have any expectation of success, much less a reasonable expectation of success. As such, Petitioners have failed to treat the claims as a whole in their proposals to modify the Xia reference and failed to show a reasonable expectation of success of their proposed modification.

Additionally, while Petitioners' merits arguments possess clear defects that warrant Petition denial, 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 regarding the '161 patent, 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. 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). Further, there is substantial overlap between the validity challenges raised in the litigation and this IPR, and Petitioners have not submitted any stipulation regarding those challenges. Therefore, Patent Owner respectfully submits that the Director should exercise its discretion and deny this Petition against the '161 patent.

II. THE '161 PATENT

The '161 patent is entitled, "Method for Transmitting and Receiving the Channel State Information and Apparatus Thereof." Consistent with the '161 patent disclosures introduced in the preceding section, independent claim 1 recites:

1. . A method for transmitting channel state information by a User Equipment (UE), the method comprising:
receiving a reference signal for measuring channel quality from
a base station;

measuring the channel quality based on the reference signal, and selecting a channel quality indicator (CQI) index value from a predetermined CQI index table including CQI index values for 256 quadrature amplitude modulation (QAM) modulation, based on the measurement result of the channel quality; and

transmitting channel state information including the selected CQI index value to the base station,

wherein:

the CQI index table includes three CQI index values for QPSK modulation, three CQI index values for 16QAM modulation, five CQI index values for 64QAM modulation, and four CQI index values for 256QAM modulation;

one of the four CQI index values for 256QAM modulation is configured to have one code rate value that supports a same transmission efficiency as a maximum transmission efficiency of a CQI index table that excludes CQI index values for 256QAM modulation; and

another of the four CQI index values for 256QAM modulation is configured to have another code rate value same as the code rate value having a maximum transmission efficiency of a CQI index table that excludes CQI index values for 256QAM modulation; and

wherein:

the one code rate value of the one of the four CQI index values for 256QAM modulation *is calculated to be 711* using “code rate $\times$ 1024,”

the another code rate value of the another of the four CQI index values for 256QAM modulation *is calculated to be 948* using “code rate $\times$ 1024,” and

a different another code rate value of a different another of the four CQI index values for 256QAM modulation is calculated to be 797 using “code rate $\times$ 1024.”

'161 patent, Claim 1.

Claim 3 recites:

3. A method for receiving channel state information by a base station, the method comprising:

creating a reference signal for measuring channel quality;
transmitting the reference signal to a User Equipment (UE); and
receiving channel state information including a channel quality indicator (CQI) index selected from a predetermined CQI index table including CQI index values for 256 quadrature amplitude modulation (QAM) modulation, based on a measurement result of the channel quality, from the User Equipment,

wherein:

the CQI index table includes three CQI index values for QPSK modulation, three CQI index values for 16QAM modulation, five CQI index values for 64QAM modulation, and four CQI index values for 256QAM modulation;

one of the four CQI index values for 256QAM modulation is configured to have one code rate value that supports a same transmission efficiency as a maximum transmission efficiency of a

CQI index table that excludes CQI index values for 256QAM modulation; and

another of the four CQI index values for 256QAM modulation is configured to have another code rate value same as the code rate value having a maximum transmission efficiency of a CQI index table that excludes CQI index values for 256QAM modulation; and wherein:

the one code rate value of the one of the four CQI index values for 256QAM modulation *is calculated to be 711* using “code rate $\times$ 1024,”

the another code rate value of the another of the four CQI index values for 256QAM modulation *is calculated to be 948* using “code rate $\times$ 1024,” and

a different another code rate value of a different another of the four CQI index values for 256QAM modulation is calculated to be 797 using “code rate $\times$ 1024.”

'161 patent, Claim 3.

Claim 5 recites:

5. A User Equipment (UE) for transmitting channel state information, comprising:

a receiver configured to receive a reference signal for measuring channel quality from a base station;

a controller configured to measure the channel quality based on the reference signal, and select a channel quality indicator (CQI) index value from a predetermined CQI index table including CQI index values for 256 quadrature amplitude modulation (QAM)

modulation, based on the measurement result of the channel quality; and

a transmitter configured to transmit channel state information including the selected CQI index value to the base station,

wherein:

the CQI index table includes three CQI index values for QPSK modulation, three CQI index values for 16QAM modulation, five CQI index values for 64QAM modulation, and four CQI index values for 256QAM modulation;

one of the four CQI index values for 256QAM modulation is configured to have one code rate value that supports a same transmission efficiency as a maximum transmission efficiency of a CQI index table that excludes CQI index values for 256QAM modulation; and

another of the four CQI index values for 256QAM modulation is configured to have another code rate value same as the code rate value having a maximum transmission efficiency of a CQI index table that excludes CQI index values for 256QAM modulation; and wherein:

wherein:

the one code rate value of the one of the four CQI index values for 256QAM modulation *is calculated to be 711* using “code rate $\times$ 1024,”

the another code rate value of the another of the four CQI index values for 256QAM modulation *is calculated to be 948* using “code rate $\times$ 1024,” and

a different another code rate value of a different another of the four CQI index values for 256QAM modulation is calculated to be 797 using “code rate×1024.”

'161 patent, Claim 5.

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

Petitioners state that “[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'S CHALLENGES FAIL ON THE MERITS BECAUSE NO REFERENCE DISCLOSES OR SUGGESTS EVERY CLAIMED FEATURE, AND THE CHALLENGES RELY HEAVILY ON REFERENCES THAT ARE NOT PRIOR ART

Petitioners assert one ground in their Petition against all challenged claims (claims 1-6). Ground 1 contends claims 1-6 are obvious in view of Xia² in view of 3GPP TS 36.213 v.10.4 ("3GPP 36.213")³.

Independent claims 1, 3, and 5 of the '161 patent claim a set of specific code rate values, including a code rate value of 711, 948, and, in element [1.9], [3.9], and [5.9], a code rate value of 797. The '161 patent explains, for Fig. 18, which includes an "R" code rate value of 797, that "'R' values are determined so that differences of the required SNRs between adjacent CQI indexes are almost the same using required SNRs of FIG. 17 and Equation 2." '161 patent, 14:7-11; *see also* '161 patent, 13:53-14:11; Fig. 21; 14:43-53.

Petitioners' theory of obviousness asserts that Xia discloses a code rate value of 711, 948, and, with respect to element [1.9], 790. Pet., 39. Relying on the incorrect premise that "[t]he '161 Patent does not explain how or why the 797 code rate was chosen for inclusion in its claimed CQI table," (Pet. 41; *see also* Ex.

² Ex. 1027, Translation of PCT International Publication WO 2014/194681 ("Xia"); *see also* Ex. 1012.

³ Ex. 1013, 3GPP TS 36.213 v10.4.0 (2011-12) 3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Evolved Universal Terrestrial Radio Access (E-UTRA); Physical channels and modulation (Release 10).

1008, ¶151), Petitioners spend pages 39-52 of the Petition rehashing its expert's 14 pages of testimony, spread over 48 paragraphs, trying to explain the obviousness of using a code rate value of 797 instead of Xia's value 790. *See* Ex. 1008, 47-61, ¶¶140-188.

In their undertaking, although Ground 1 purports to rely only on Xia and 3GPP 36.213, their discussion of element [1.9] leans on other references throughout its analysis. But, in its section IV.B (Pet. 8-10) discussing the prior art status of certain documents, Petitioners do not address the prior art status of all documents relied upon in the discussion of element [1.9]. Specifically, Petitioners discuss references that do not predate the earliest priority date of the '161 patent—March 21, 2014—including Ex. 1028 and Ex. 1030. Pet., 42, 43, 44, 45, 46; *see also* Pet., 2.

Petitioners contend that Ex. 1030 is “dated March 21, 2014.” Pet. 44. It is not. The date given on the face of Ex. 1030 is “31th March– 4th April, 2014.” And, as Petitioners “assume the earliest effective filing date of the '161 Patent is March 21, 2014,” even a date of March 21, 2014 would not be prior art to the '161 patent. Even Petitioners' expert admits as such, stating that Ex. 1030 is “not prior art.” Ex. 1008, ¶162. Similarly, R1-142638, Ex. 1028, bears the date “19th - 23rd May 2014” and is also not prior art, as acknowledged by Petitioners. Pet., 45.

Because the Petition's discussion of element [1.9] is so heavily reliant on Ex. 1028 and 1030, Petitioners have failed to show a reasonable expectation of success of demonstrating the presence of the claimed set of code rate values in the "prior art consisting of patents and printed publications," in violation of § 311(b).

Additionally, Petitioners' theory is based on impermissible hindsight. Petitioners note that Xia has a code rates of 711 and 948, and assert it would have been obvious to select another code rate value in that range (apparently any other code rate value) including 797. Pet. 40 (alleging "all that would remain is the non-critical selection of any two intervening values between 711 and 948 that 'approximate' constant intervals"). Demonstrating the hindsight bias, Petitioners' analysis reaches this conclusion after discussing the '161 patent's teachings as part of its reasoning for the modification, *see* Pet., 39 ("the '161 Patent teaches...").

But just because Xia's table 6-3 has "minimum and maximum code rate values (711, 948)" does not mean that it would have been obvious for Xia to set a code rate value of 797 for an intermediate value. In fact, Xia did not set an intermediate value of 797 for any of its intermediate values. And Petitioners provide no reasoning to suggest that if a POSITA were to modify the values in Xia's table 6-3, that the POSITA would hold the minimum and maximum code rate values steady. In other words, if a POSITA were to modify the set of code rate values in Xia, Petitioners have not shown the desirability of holding the minimum

and maximum code rate values steady and set the intermediate values to other values.

Additionally, Petitioners have not shown the use of code rate value 797 in any prior art patent or printed publication. Instead, Petitioners reach out to a non-prior art reference, Ex. 1028, to allege “797 was a non-critical value for the CQI table.” Pet., 42. Again, relying on Ex. 1028, which is not prior art, Petitioners allege that “[t]he publicly available technical contributions and proposals demonstrate that no considered code rate was critical.” Pet., 42 (citing Ex. 1028). But not only is Ex. 1028 not prior art,⁴ Ex. 1028 is merely a list of “proposals” for an agenda item. Thus, it is not surprising that Ex. 1028 is devoid of the reasoning behind the proposals, and Ex. 1028 merely states what the proposals are, after the earliest effective filing date of the '161 patent. This reference and its teachings fail to establish obviousness of the '161 patent where these teachings can only be established to exist after the '161 patent's priority date.

For these reasons, Petitioners have not shown that the claims of the '161 patent are obvious over patent and printed publication prior art to the '161 patent.

⁴ The highlights on page 3 of Ex. 1028 appear to have been added by Petitioners and are not found in the copy of R1-142638 currently on the 3GPP website, which can be located by following the guidance in Bishop declaration. Ex. 1010, ¶72.

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.*⁵

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., 65. 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

⁵ 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 is included in the Chief Administrative Patent Judge’s Memorandum of March 24, 2025 and the Director’s Memorandum issued on March 26, 2025.

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 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. 1007, 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. 2003) based on the December 29, 2023 filing date in district court. This small difference between the scheduled trial date and the statistical prediction—only about two months—still places the district court’s jury trial well before the estimated date of completion of this proceeding, on or around 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., 66) 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. 1007; Ex. 2204. Additionally, because of the stage of the underlying case and the speed with which the Eastern District of Texas reaches case dispositions, there are likely to be district court determinations relating to the validity of the '161 patent in advance of the Board's projected statutory deadline. 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. 1007, 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., 65) does not reduce the weight in favor of discretionary denial in this proceeding. When presented with a similar situation and argument, the PTAB has held "[e]ven if the proceedings are staggered, at least one of the proceedings would likely begin and conclude well before our decision, making it highly likely that there will be duplicate efforts in evaluating the challenged claims based on the prior art." *AT&T Serv. Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-

00992, Paper 14 at 10-11 (PTAB Dec. 16, 2024) (weighing Factor 2 “substantially in favor of discretionary denial”); *see also AT&T Serv. Inc. v. ASUS Tech.*

Licensing Inc., IPR2024-01142, Paper 14 at 13 (PTAB Jan. 27, 2025); *AT&T Serv. Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-01121, Paper 14 at 11-12 (PTAB Jan. 27, 2025). Further, all three cases are consolidated before Judge Gilstrap for all pre-trial purposes and therefore will be on equal procedural footing when the first trial begins on September 8, 2025.

Petitioners fail to explain why the earliest trial will not be able to fully resolve all pending validity issues surrounding the ’161 patent, including the challenges that cannot be raised in this IPR. *HP Inc., et al. v. Neodron Ltd.*, IPR2020-00459, Paper 17 at 36, 38 (PTAB Sept. 14, 2020) does not support Petitioners’ theory that different trial dates weigh against discretionary denial. Rather, in *HP*, factor 2 was treated as neutral where one litigation—involving two of the co-petitioners—was stayed pending IPR. *Id.*, at 34 (noting the “ND Cal. action ... has been stayed pending [IPR].”). No stay is in place in this case, and a stay is unlikely to be granted. Further, all three cases are consolidated for all pre-trial purposes and therefore will be on equal procedural footing when the first trial begins on September 8, 2025. Therefore, even the conclusion in *HP* that this factor was “neutral” cannot apply here.

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

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

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

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

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

For factor 3, “the 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., 67; *see also* Ex. 2004, 2250-2252. Yet, Petitioners delayed until December 31, 2024—over nine months after receiving infringement contentions—to file its Petition challenging the ’161 patent. Despite noting the

date that the invalidity contentions were served in its Petition (Pet., 67), 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. As will be discussed with regard to factor 4 below, those invalidity contentions overlap substantially with the Petition (and are even more comprehensive).

Petitioners assert one ground in their Petition against all challenged claims (claims 1-6). Ground 1 contends claims 1-6 are obvious in view of Xia in view of 3GPP TS 36.213 v.10.4 (“3GPP 36.213”) (EX1013).

Petitioners’ invalidity contentions include claim charts addressing the same references asserted by Petitioners (Xia and 3GPP 36.213⁶) in the ground of its Petition for every claim challenged in the co-pending litigation. *See, e.g.*, Exs. 2004, 8, 21-22, 29, 37 (cover pleading); Ex. 2250 (Appx. K); Ex. 2251 (Ex. K-3) (Xia); Ex. 2252 (Ex. K-8) (3GPP 36.213). Petitioners provide no justification for the delay in filing its Petition when it had developed its invalidity theories sufficiently to include them in a district court pleading months *seven months* earlier. Additionally, 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 is 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

⁶ The version of the 3GPP standard cited in the invalidity contentions is merely a subsequent version (version 12.0.0) of the standard relied on in the Petition (version 10.4.0). Ex. 2250 at 1 (citing 3GPP TS 36.213 V12.0.0 (2013-12)).

invalidity contentions on April 21, 2025, and Patent Owner was required to similarly serve its infringement expert reports on that date.

As district court proceedings allow more invalidity defenses to be presented than in this proceeding, Petitioners' invalidity expert reports can be expected to present more comprehensive challenges to validity than presented in this proceeding. For example, in district court, Petitioners contend that the claims of the '161 patent are invalid under 35 U.S.C. § 112(a) and § 112(b). *See* Ex. 2004, 364, 370-72. Thus, the district court will be in the best position to resolve all of the validity issues relating to the '161 patent. Efficiency would favor the forum that can address all of the validity issues at the same time.

Additionally, Patent Owner and Petitioners will expend significant time and resources relating to claim construction prior to 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. 1007, 4 (setting the deadline for dispositive motions); *id.*, 2 (setting the deadline to disclose final invalidity theories); Ex. 2204 (same). Should the Board institute, the Parties will effectively duplicate the efforts expended in the District Court to address the validity of the '161 patent.

These investments in the district court proceeding favor denial.

D. Factor 4 Favors Denial (Overlap of Issues)

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

As noted above, Petitioners assert one ground in their Petition against all challenged claims (claims 1-6). Ground 1 contends claims 1-6 are obvious in view of Xia in view of 3GPP TS 36.213 v.10.4 ("3GPP 36.213") (EX1013). Petitioners' invalidity contentions include claim charts addressing the same references asserted by Petitioners (Xia and 3GPP 36.213) in the ground of its Petition for every claim challenged in the co-pending litigation and this IPR (claims 1-6). *See, e.g.*, Exs. 2004, 8, 21-22, 29, 37 (cover pleading); Ex. 2250 (Appx. K); Ex. 2251 (Ex. K-3) (Xia); Ex. 2252 (Ex. K-8) (3GPP 36.213). Thus, there is 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*.

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

Further demonstrating the intent to present overlap contentions, Petitioners' invalidity contentions explicitly signal that Petitioners intend to rely on systems embodying at least the Xia and the 3GPP 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 6 claims asserted in this case and a total of 113 asserted in the related district court cases” (Pet., 67), but this argument misses the mark. The 113 litigated claims include claims in patents other than the ’161 patent, and the existence of other litigated claims does not diminish the perfect overlap between the claims in this IPR and the same six litigated claims. But even when there is not a perfect alignment between the claims in IPR and litigation, the Board has repeatedly ruled that the assertion of additional claims does nothing to

mitigate “substantial” overlap in issues between the two proceedings where common prior art is presented and common independent claims are challenged. *See, e.g., Code200, UAB*, IPR2020-01506, Paper 10 at 11-12 (“In light of the common prior art asserted here and in the [] district court case, as well as the common challenge to the sole independent claim and all but two of the dependent claims of the [’384] patent, we agree with the Patent Owner that the overlap in issues between the two proceedings is substantial.”); *see also Teso LT UAB v. Luminati Networks Ltd.*, IPR2021-00122, Paper 12 at 10 (PTAB Apr. 20, 2021) (denial of institution favored where Petition’s prior art references were all identified in the district court invalidity contentions, the same independent claims were challenged in both proceedings, and “the *additional* claims challenged in the Petition are all dependent claims”).

Therefore, with this substantial overlap between the Petition and the parallel proceedings, there are particularly strong “concerns of inefficiency and the possibility of conflicting decisions” if the IPR is instituted. *See, e.g., Fintiv*, IPR2020-00019, Paper 11 at 12 (finding “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong” where there is substantial overlap).

Accordingly, factor 4 weighs strongly in favor of denying institution. *See Teso LT UAB*, IPR2021-00122, Paper 12 at 10 (finding “the overlap in issues

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

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

E. Factor 5 Favors Denial (Overlapping Parties)

Patent Owner is the plaintiff and Petitioners are involved in the parallel litigation (Ex. 1007; Ex. 2204),⁷ 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.

⁷ 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.

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, 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 deadline⁸:

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

⁸ Google joined the Petitioners as an additional petitioner in each of these IPR proceedings except for IPR2025-00036 and IPR2025-00037.

IPR2025-00293 Patent Owner's Preliminary Response

Filing Date	IPR	Notice of Filing Date	Date of Institution Decision (Est.)	Date of Final Written Decision (Est.)
12/27/24	IPR2025-00291	2/6/25	8/6/25	8/6/26
12/31/24	IPR2025-00292	2/6/25	8/6/25	8/6/26
12/31/24	IPR2025-00293	2/6/25	8/6/25	8/6/26
12/24/24	IPR2025-00317	1/17/25	7/17/25	7/17/26

Two of Petitioners' other IPRs—IPR2025-00036 and IPR2025-00037—have already been denied institution by the Board under *Fintiv*, on April 25, 2025, due to the extensive activities that have already occurred in the co-pending litigation, the schedule of the upcoming trial, and the overlap in parties between those IPRs and the litigation. This IPR is one of nine remaining decisions on institution the Board or Director needs to make relating to the dispute between the Parties. As the Board or Director will approach the decisions serially, the strength of the *Fintiv* factors in favor of exercising discretion to deny institution will only become stronger. In particular, at least the first and third *Fintiv* factors will weigh more heavily in favor of denial as the estimated final written decision deadline for each IPR extends farther beyond the anticipated trial date of September 8, 2025.

Moreover, the complexity of this global dispute between Petitioners and Patent Owner encourages resolution in a single forum, without the risk of inconsistent results. While the Board generally evaluates each petition on its own, district courts have additional tools available for resolving suits involving multiple

patents, including established procedures for such disputes, deadlines for narrowing issues including the asserted claims and the invalidity contentions, and driving resolution of the dispute as a whole. *Cf.* Pet., 67 (“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. 2203) and the consolidated action is progressing at pace towards a September 2025 trial date.

The district court can resolve more disputed issues than the limited nature of IPR proceedings, which can only address a limited set of validity challenges.

While IPR proceedings were once thought to be vehicles to settle validity questions concerning a patent, history has informed that IPR proceedings often only address some validity issues, leaving others for the district courts to deal with. When a patent survives an IPR, it adds complexity to the proceeding as the district court must then weigh questions of the scope of IPR estoppel. *See, e.g., EIS Inc. v. IntiHealth Ger GmbH*, 2023 WL 6797905, 19-1227-GBW (D. Del. Aug. 30, 2023) (addressing scope of IPR estoppel). And for other validity issues beyond the reach of IPRs (*see* Ex. 2004, 362-63, 368), those issues must be heard by the District Court.

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 2, 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 8,403 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 this date, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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