

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

PEGASUS WIRELESS INNOVATION LLC,
Patent Owner.

Case IPR2025-00317
U.S. Patent No. 11,405,942

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' 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. November 1, 2024)

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2054	Exhibits to Appendices of 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. November 1, 2024)
2055-2202	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)
2204-2299	Reserved
2300	Appendix D 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)
2301	Ex. D-1 of Appendix D 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, Exclusive Licensee 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 1-3, 5-7 and 9-11 of U.S. Patent No. 11,405,942 (the “’942 Patent”), as requested by Cellco Partnership d/b/a Verizon Wireless, T-Mobile USA, Inc., AT&T Services, Inc., Nokia of America, Corp., Ericsson Inc., and Google LLC (“Petitioners”), should be denied.¹

I. INTRODUCTION

The ’942 Patent discloses methods for notifying a user equipment (UE) that a resource element (RE) allocated for normal latency data transmission has been or will be pre-empted, or re-allocated, for a low latency data transmission. Central to these methods, user equipment (UE) receives a downlink (DL) signal having a specific radio network temporary identifier (RNTI) through UE-specific radio resource control (RRC) signaling. The specific RNTI received through the UE specific RRC signaling is a newly defined RNTI but is not at least a cell-RNTI (C-RNTI). The specific RNTI is used to monitor a DL control channel for DL preemption indication information, such as information indicating preempted

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).

resource information transmitted in a prior slot, before the DL preemption indication information is received.

In the Petition, Petitioners' challenges suffer from at least two fatal flaws. First, the Petition contends that an RTNI mentioned in its primary reference Kuchibhotla, the "marker-RTNI," satisfies the claimed "newly defined RNTI," but fails to identify for the Board what a "newly defined RNTI" is or why Petitioners' characterization is accurate. Petitioners' expert similarly renders a conclusory opinion on this claim element without providing any basis for support. Thus, the Petition suffers from a clear failure of proof on this element, which appears in each challenged independent claim.

Additionally, while the claimed specific RNTI (that is a newly defined RNTI) must be communicated to the UE via UE-specific radio resource control (RRC) signaling, there is nothing in Petitioners' references to support this teaching with regard to Kuchibhotla's "marker-RNTI." Petitioners therefore allege without support that a POSITA would have known that the relied-upon marker-RNTI would have been transmitted via UE-specific RRC signaling, or that Petitioners' reference could have been modified as such. These theories also fail for lack of support, and for failing to consider the express teachings of the reference that Petitioners propose to modify. In particular, Kuchibhotla discloses that each UE can decode a marker, which indicates that each UE also possesses the marker-

RNTI. Under these circumstances, Petitioners' assertion that each UE would receive the same marker-RNTI via UE-specific RRC signaling should be disregarded as a hindsight-based attempt to recreate the challenged claims.

For these reasons, Petitioners' challenges fail on the merits.

Further, notwithstanding the Petition's substantive failures, given the timing and advanced stage of co-pending litigation between the Petitioners and Patent Owner regarding the '942 patent, the Director should exercise its discretion to deny the Petition under *Fintiv*.² As enumerated below, 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, over ten months before the Board would be expected to issue a final written decision in this case (by July 17, 2026), and at least five other IPRs are directed towards patents-at-issue in that litigation are on a timeline that is even later than this IPR.

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. Finally, a discretionary denial is strongly favored under the USPTO's current guidance regarding the *Fintiv* analysis, as set forth in the Chief Administrative Law Judge's Memorandum of March 24, 2025.

² Patent Owner is submitting a request for discretionary denial for consideration by the Director in accordance with the deadline set by the Board.

Therefore, Patent Owner respectfully submits that the Director should exercise its discretion and deny this Petition against the '942 patent.

II. THE '942 PATENT

The '942 Patent is entitled, "Method and Apparatus for Transmitting and Receiving Downlink Signal in Next Generation Wireless Network." Consistent with the '942 Patent's disclosures introduced in Section I above, independent claim 1 recites:

1. A method of receiving a downlink (DL) signal by a first user equipment (UE), the method comprising:
receiving, by the first UE, a specific radio network temporary identifier (RNTI) for DL preemption indication information through a UE-specific radio resource control (RRC) signaling;
after receiving the specific RNTI, monitoring, by the first UE, a DL control channel for receiving the DL preemption indication information based on the received specific RNTI; and
receiving, by the first UE, the DL preemption indication information through a multicast signal,
wherein the specific RNTI received through the UE specific RRC signaling is a newly defined RNTI other than at least a cell-RNTI (C-RNTI),
wherein the DL preemption indication information indicates preempted resource information in a prior slot, which precedes a slot in which the DL preemption indication information is received,

wherein the specific RNTI is received with information related to time and frequency, and

wherein the information related to time and frequency is received for the reception of the DL preemption indication information through the UE-specific RRC signaling.

'942 Patent, Claim 1 (emphasis added).

Claim 5 recites:

5. A method of transmitting a downlink (DL) signal by a base station (BS), the method comprising:

configuring, by the BS, a specific radio network temporary identifier (RNTI) for DL preemption indication information;

transmitting, from the BS, the configured specific RNTI to a first user equipment (UE) through a UE-specific radio resource control (RRC) signaling; and

transmitting, from the BS, the DL preemption indication information based on the specific RNTI through a multicast signal, ***wherein the specific RNTI transmitted through the UE specific RRC signaling is a newly defined RNTI other than at least a cell-RNTI (C-RNTI),***

wherein the DL preemption indication information indicates preempted resource information in a prior slot, which precedes a slot in which the DL preemption indication information is transmitted,

wherein the specific RNTI is transmitted with information related to time and frequency, and

wherein the information related to time and frequency is transmitted for a reception of the DL preemption indication information by the first UE through the UE-specific RRC signaling.

'942 Patent, Claim 5 (emphasis added).

Claim 9 recites:

9. A user equipment (UE) for receiving a downlink (DL) signal, the UE comprising:

a receiver configured to receive a specific radio network temporary identifier (RNTI) for DL preemption indication information through a UE-specific radio resource control (RRC) signaling;

after reception of the specific RNTI, a controller configured to monitor a DL control channel for receiving the DL preemption indication information based on the received specific RNTI, wherein the receiver further configured to receive the DL preemption indication information through a multicast signal,

wherein the specific RNTI received through the UE specific RRC signaling is a newly defined RNTI other than at least a cell-RNTI (C-RNTI),

wherein the DL preemption indication information indicates preempted resource information in a prior slot, which precedes a slot in which the DL preemption indication information is received,

wherein the specific RNTI is received with information related to time and frequency, and

wherein the information related to time and frequency is received for the reception of the DL preemption indication information through the UE-specific RRC signaling.

'942 Patent, Claim 9 (emphasis added).

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

Petitioners state that “Petitioners apply the plain and ordinary meaning of each claim term herein.” Pet., 10 (also suggesting Petitioners may “allege indefiniteness in any parallel case involving the '942 Patent” without providing any reasons for alleged indefiniteness.).

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

Petitioners assert two grounds in their Petition, and each Ground applies to all challenged claims (claims 1-3, 5-7 and 9-11). Ground 1 contends that the independent claims (claims 1, 5, and 9), and all of the challenged dependent claims

(claims 2, 3, 6, 7, 10, and 11), are obvious over Kuchibhotla³ in view of “the knowledge of a POSITA.” Ground 2 contends that the independent claims, and all of the challenged dependent claims, are obvious over Kuchibhotla in view of Chen⁴ and further in view of “the knowledge of a POSITA.”

A. The Petition Fails to Address How Kuchibhotla Allegedly Discloses a “newly defined RNTI”

Element [1.4] of claim 1 recites, “wherein the specific RNTI received through the UE specific RRC signaling is a newly defined RNTI other than at least a cell-RNTI (C-RNTI).” As noted above, the Petition presents no claim constructions, and the Petition fails to explain how Kuchibhotla allegedly discloses the claimed requirement of a “newly defined RNTI.” The entirety of Petitioners’ analysis of this claimed element is contained on page 50 of the Petition, reproduced below.

³ Ex. 1004, U.S. Publication No. 2017/0223687 A1 (“Kuchibhotla”) (Patent Owner’s references to the Petition will remove the emphasis Petitioners added to the identification of the art relied upon in the Petition).

⁴ Ex. 1005, U.S. Publication No. 2016/0234857 A1 (“Chen”).

- v. ***[1.4] wherein the specific RNTI received through the UE specific RRC signaling is a newly defined RNTI other than at least a cell-RNTI (C-RNTI),***

For reasons discussed above for element [1.1], *Kuchibhotla* discloses that the **marker-RNTI** (*specific RNTI*) is received through *UE specific RRC signaling*. See §VII.A.2.ii, *supra*. The marker-RNTI is a “special CRC mask ... for the marker transmissions” (*newly defined RNTI other than at least a cell-RNTI (C-RNTI)*). EX-1004, ¶84 and ¶47 (describing assignment of special RNTIs to the UE at call admission in addition to the C-RNTI). *Kuchibhotla* therefore discloses element [1.4]. EX-1003, ¶163.

See Pet., 50. Similarly, the Lanning Declaration is equally conclusory, and fails to explain how the “marker-RNTI” of *Kuchibhotla* discloses a “newly defined RNTI.” Paragraph 163 of the Lanning Declaration is also reproduced below.

- v. ***[1.4] wherein the specific RNTI received through the UE specific RRC signaling is a newly defined RNTI other than at least a cell-RNTI (C-RNTI),***

163. For reasons discussed above for element [1.1], *Kuchibhotla* discloses that the marker-RNTI value (*specific RNTI*) is received by the UE through *UE specific RRC signaling*. See §VII.A.2.ii, *supra*. The marker-RNTI is a “special CRC mask ... for the marker transmissions” (*newly defined RNTI other than at least a cell-RNTI (C-RNTI)*). EX-1004, ¶84 and ¶47 (describing assignment of special RNTIs to the UE at call admission in addition to the C-RNTI). *Kuchibhotla* therefore discloses element [1.4].

See Ex. 1003, ¶163.

The Petition calls back to this undeveloped analysis for element [1.4] to address element [5.4] (Pet., 63) and element [9.4] (Pet., 67) without further explanation. Nowhere does the Petition or the Lanning Declaration explain how or why a marker-RNTI in Kuchibhotla satisfies the claimed “newly defined RNTI” of the challenged independent claims. Thus, the Petition suffers from a failure of proof. *See* 37 C.F.R. § 42.104(b)(3)-(4).

Accordingly, the Petition fails with regard to Ground 1 and independent claims 1, 5, and 9, along with corresponding dependent claims 2-3, 6-7, and 10-11. Ground 2 is not presented to remedy the deficiencies of Kuchibhotla with regard to this claimed feature, and therefore also fails.

B. The Petition Impermissibly Relies on Expert Testimony and Hindsight to Fill in Missing Disclosures in Kuchibhotla

As noted above, Petitioners rely on Kuchibhotla's “marker-RNTI” to disclose the claimed “specific RNTI,” which is the “newly defined RNTI.” In addition to the shortcomings explained above regarding this characterization, Petitioners also impermissibly rely on the Lanning Declaration, rather than patents and printed publications, to fill in missing disclosures from Kuchibhotla. Specifically, Kuchibhotla fails to disclose the methodology in which a “marker-RNTI” is conveyed to a user equipment (UE).

Kuchibhotla's sole disclosure of a “marker-RNTI” appears in paragraph 84. The entirety of that disclosure is included in a single sentence. Kuchibhotla

discloses, “[i]f PDCCH is used for marker transmission, the marker transmission can be differentiated from other control channel transmissions by using a special CRC mask (e.g. marker-RNTI) for the marker transmissions.” Kuchibhotla, ¶84.

The claims expressly include many requirements for the “specific RNTI” which is also the “newly defined RNTI.” Per claim 1, for example, the specific RNTI cannot be at least a cell-RNTI, it is received by the UE with “information related to time and frequency,” and it is received by the UE via “UE-specific radio resource control (RRC) signaling.” As can be seen from the limited disclosure in Kuchibhotla’s ¶84, Kuchibhotla fails to disclose each of these specific features regarding the marker-RNTI. Importantly for the purpose of this section of the POPR, Kuchibhotla fails to disclose how the marker-RNTI is communicated to the UE, and fails to disclose any use of UE-specific RRC signaling.

The Petition fills in this missing disclosure by relying upon a POSITA’s knowledge, but fails to explain the basis for this assertion. In particular, the Petition asserts that “[t]o enable monitoring of PDCCH candidates for a marker, a POSITA reviewing *Kuchibhotla* would have understood that the marker-RNTI (like the special LL-RNTI which also is used for PDCCH monitoring) would be assigned to the UE by the BS in the configuration message sent using **dedicated mode** (*UE-specific*) RRC signaling.” Pet., 41 (citing Ex. 1003, ¶136) (emphasis in original). Paragraph 136 of the Lanning declaration parrots this assertion from the

Petition, but fails to identify why a POSITA would have reached this particular understanding. Thus, the Lanning Declaration's assertion on this point should be disregarded as unsupported. *See* 37 C.F.R. § 42.65(a).

Petitioners then allege that a POSITA “would have been motivated to include the marker-RNTI in the UE-specific RRC configuration signaling at cell admission in addition to or instead of the LL-RNTI [low latency RNTI] for at least the reason that the marker-RNTI beneficially enhances the efficiency of monitoring PDCCH for control information.” Pet., 41-42. Petitioners allege that this is the case because “the marker-RNTI allows the UE to differentiate the marker from other control channel information, [and therefore] the UE can more efficiently identify resources that have been preempted for low latency transmissions.” Pet., 42 (citing Ex. 1003, ¶138). Once again, the Lanning Declaration parrots these assertions regarding efficiency of identifying resources that have been preempted for low latency transmissions. Ex. 1003, ¶138.

Further, this logic fails to consider the disclosures of Kuchibhotla. As noted above, Kuchibhotla expressly discloses when to use the marker-RNTI, namely when the “PDCCH is used for marker transmission.” Kuchibhotla, ¶84. Conversely, a user equipment decodes a low latency PDCCH [LL-PDCCH], which also may be used for “regular latency data packet assignment,” using the low latency RNTI [LL-RNTI]. Kuchibhotla, ¶47. But Kuchibhotla does not disclose a

scenario where the marker-RNTI and LL-RNTI can be substituted for one another, and does not disclose a scenario where both would be used. And neither the Petition nor the Lanning Declaration explain the relative efficiencies of these different RNTIs or even why Kuchibhotla discloses different techniques for monitoring a PDCCH or LL-PDCCH.

Moreover, Kuchibhotla's paragraph 76 strongly suggests that a marker-RNTI would be possessed by multiple UEs and therefore would be more efficiently communicated via UE-specific RRC signaling. Paragraph 76 discloses that the "marker transmission can be sent as a broadcast transmission common to multiple devices." Kuchibhotla, ¶76. Further, "[f]or a device not receiving low latency transmission in that subframe, but having an allocation for other data transmission, the marker transmission can tell which RE's in its allocation are used for low latency transmissions so that the device can ignore them, null them, or otherwise not use them." *Id.* By this disclosure, Kuchibhotla is indicating that multiple devices will receive the marker transmissions as a broadcast transmission, and will be able to apply the marker-RNTI to identify the resource elements (REs) with the low latency transmission and "ignore them, null them, or otherwise not use them." *Id.* As a result, per Kuchibhotla, the marker-RNTI is not UE-specific, and absent impermissible hindsight, there is no reason for a POSITA to conclude that a common marker-RNTI would be communicated to many UEs each using UE-

specific RRC signaling. Rather, Kuchibhotla would indicate that the common marker-RNTI would be more efficiently communicated to UEs using broadcast transmissions, i.e. non-UE-specific signaling.

In presenting their obviousness case, Petitioners fail to consider Kuchibhotla's teachings in this regard, and rely instead on impermissible hindsight to modify Kuchibhotla in order to suggest all claimed features.

For all the reasons set forth above, the Petition is deficient in its challenges and should be denied without institution.

V. THE DIRECTOR SHOULD DENY INSTITUTION UNDER *FINTIV*

For the following reasons and as set forth in Patent Owner's Request for Discretionary Denial to be filed, 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.

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 guidance is included in the Chief Administrative Law Judge’s March 24, 2025 Memorandum.

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., 70. But in the months after its Petition was filed, Petitioners have not requested a stay or that the trial date be adjusted based on the discovery dispute. Under these circumstances, Factor 1 favors denial of institution or remains neutral.

Any stay is also unlikely due to the significant case progression (discussed in factor 3), a scheduled jury trial preceding any final written decision (discussed in factor 2), and the timing of institution decisions on the ten other IPRs against patents asserted in the same litigations (discussed in factor 6). The first *Fintiv* factor therefore supports denying institution or 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, over ten months before the Board's final decision would be expected to be due, on or about July 17, 2026. *See* Ex. 1020, 2. "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. Indeed, the Board has previously held that a trial date which precedes a final written decision deadline by five, four

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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 Law 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 8, 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 July 17, 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., 71) 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. Additionally, because of the stage of the underlying case and the speed with which the Eastern District of Texas reaches case dispositions (*see, e.g.*, Ex. 2018, 5), there are likely to be district court determinations relating to the validity of the ’942 patent in advance of the Board’s projected statutory deadline. Indeed, 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).

Finally, 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., 70-71) 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).

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., 72; *see also* Ex. 2004. Yet, Petitioners delayed until December 24, 2024—over nine months after receiving infringement contentions—to file its Petition challenging the ’942 patent. Despite noting the date that the invalidity contentions were served in its Petition (Pet., 72), 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 currently 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).

As already introduced above, Petitioners assert two grounds in their Petition, and each Ground applies to all challenged claims (claims 1-3, 5-7 and 9-11). Ground 1 contends the independent claims (claims 1, 5, and 9), and all of the challenged dependent claims (claims 2, 3, 6, 7, 10, and 11) are obvious over Kuchibhotla in view of “the knowledge of a POSITA.” Ground 2 contends the independent claims, and all of the challenged dependent claims, are obvious over Kuchibhotla in view of Chen and further in view of “the knowledge of a POSITA.”

Petitioners' initial invalidity contentions in district court, dated May 17, 2024, included claim charts against the '942 patent, including for the primary reference used in both grounds, Kuchibhotla. *See, e.g.*, Ex. 2004, 34, 53-55; *see also* Ex. 2300 (Appx. D); Ex. 2301 (Ex. D-1); Ex. 2051, 8, 19-20, 180 (cover pleading) (addressing Chen). Petitioners provide no justification for delaying to file its Petition when it had developed its invalidity theories based on its primary reference in each Ground sufficiently to include it in a district court pleading months *seven months* earlier. 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 July 17, 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, is on-going relating to those issues, and is completed on April 14, 2025, before the Board is expected to reach an institution decision in this IPR and even before this Patent Owner's Preliminary Response is due. Further, Petitioners will be required to prepare and serve their expert witness disclosures under Fed. R. Civ. P. 26(a)(2) relating to their invalidity contentions by April 21, 2025, and

Patent Owner will be required to similar serve their 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 '942 patent are invalid under 35 U.S.C. § 112(a) and § 112(b). *See* Ex. 2004, 361, 366-67. Thus, the district court will be in the best position to resolve all of the validity issues relating to the '942 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 the institution decision deadline of July 17, 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). Should the Board institute, the Parties will effectively duplicate the efforts expended in the District Court to address the validity of the '942 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 two grounds in their Petition, and each of those Grounds relies on references found in the district court's invalidity contentions against the same claims in this IPR, including Kuchibhotla and Chen. *See, e.g.*, Ex. 2004, 34, 53-55; Ex. 2300 (Appx. D); Ex. 2301 (Ex. D-1); Ex. 2051, 8, 19-20, 180 (cover pleading). 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*.

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 the Kuchibhotla and Chen disclosures, and other disclosures, upon which it relies. *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”). 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) .

And 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 nine '942 patent claims asserted in this case and a total of 113 asserted in the related district court cases" (Pet., 72-73), but this argument misses the mark. The 113 litigated claims include claims in patents other than the '942 patent, and the existence of other litigated claims does not diminish the perfect overlap between the claims in this IPR and the same nine 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. 1020),⁶ 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).

F. Factor 6 Favors Denial (Other Factors)

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

⁶ 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.

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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 deadline⁷:

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	4/30/25	4/30/26
10/18/24	IPR2025-00037	10/30/24	4/30/25	4/30/26
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

⁷ Google joined as an additional petitioner in each of these IPR proceedings except for IPR2025-00036 and IPR2025-00037.

This IPR will be one of eleven decisions on institution the Board will need to make relating to the dispute between the Parties. As the Director may face 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., 73 (“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.

Also, 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, 361, 366-67), 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 Petition is flawed for the reasons already explained above in the prior section of this Preliminary Response.

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”). Even if the Board chooses not to evaluate the merits of the challenges, the remaining *Fintiv* factors overwhelmingly favor denial.

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.

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Dated: April 17, 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 7,314 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 April 17, 2025, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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