

Swift, Erica

From: Director_Discretionary_Decision
Sent: Thursday, May 15, 2025 10:49 AM
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Cc: Trials
Subject: RE: IPR2025-00317: Requests for filings from Petitioners and Patent Owner

Counsel – Petitioner should address the impact of the district court dismissal of the ‘942 patent from the district court litigation in its opposition to Patent Owner’s request for discretionary denial. If needed, Patent Owner may request additional briefing after Petitioner files its opposition. The Board will respond to Petitioner’s request related to the merits and non-discretionary considerations. Thank you.

From: Anderson, Kevin <KPAnderson@duanemorris.com>
Sent: Wednesday, May 14, 2025 3:40 PM
To: Trials <Trials@USPTO.GOV>
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Subject: IPR2025-00317: Requests for filings from Petitioners and Patent Owner

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Dear Board,

Petitioners and PO have the following requests.

1. On May 12, 2025, the parties to the parallel District Court litigation jointly moved to dismiss the ‘942 patent, at issue in this IPR, from that litigation. The motion is not yet granted, but once it is granted the Parties will update their mandatory notices as required per 37 C.F.R. § 42.8.

Additionally, Patent Owner and Petitioners each seek permission to file a 2-page paper addressing the impact of this dismissal on the *Fintiv* discretionary denial factors in this proceeding.

Petitioners request permission to file the following:

2. A 5-page reply to the IPR2025-00317 Patent Owner's Preliminary Response (POPR) to be filed within two weeks of receiving Board authorization. Petitioner seeks permission to respond to the POPR regarding the asserted prior art’s disclosure of “a newly defined RNTI other than at least a cell RNTI.” Petitioner also seeks permission to respond to the POPR regarding the asserted prior art’s disclosure that the marker-RTNI is sent via “UE-specific

RRC signaling.” For this limitation, the POPR cites to disclosures in the asserted prior art that the POPR suggests Petitioner did not consider. However, the disclosures cited by the POPR are directed to embodiments that are different than the embodiment on which Petitioner relies.

Patent Owner’s Position:

In order to respond to Petitioners’ preliminary reply, Patent Owner requests a 5-page preliminary sur-reply, to be filed within two weeks of the preliminary reply being filed.

Petitioners consent to Patent Owner filing a sur-reply of the same length to Petitioner’s reply.

Counsel for Patent Owner is copied herein and the parties have met/conferred.

Kevin Anderson
Lead Counsel for Petitioners

For more information about Duane Morris, please visit <http://www.DuaneMorris.com>

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