IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION.,
Petitioner

v.

PROXENSE, LLC,
Patent Owner

U.S. Patent No. 9,265,043
IPR Case No.: 2025-00327

PROXENSE LLC'S BRIEF FOR DISCRETIONARY DENIAL

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EXHIBIT LIST

No.	Exhibit Description
Ex. 2001	U.S. Patent No. 9,265,043
Ex. 2002	Docket Navigator Judge Profile for Judge Alan D. Albright
Ex. 2003	Scheduling Order for Proxense, LLC v. Intel Corp., 6:24-cv-00283, pending in the United States District Court for the Western District of Texas
Ex. 2004	Judge Albright's Frequently Asked Questions ("FAQ"), available at https://www.txwd.uscourts.gov/for-attorneys/judge-albright-courtroom-faq/
Ex. 2005	Intel's Preliminary Invalidity Contentions

I. Introduction

Under the *Interim Process for PTAB Workload Management Memorandum* (the "Memorandum") issued on March 26, 2025, the decision whether to institute an *inter partes* review is bifurcated between: (i) discretionary denial; and (2) merits and other non-discretionary statutory decisions. Pursuant to the Memorandum and the Board's Notice Extending Deadline for Discretion Briefing (Paper 4), Patent Owner requests that the Board discretionarily deny Intel's Petition for *Inter Partes* Review of U.S. Patent No. 9,265,043 (the "'043 Patent") for the reasons below.

II. The *Fintiv* Factors Strongly Favor Denial

As established in the precedential case of *Apple v. Fintiv*, the Board considers six factors when exercising its discretion to deny an *inter partes* review in view of a parallel proceeding. *Apple v. Fintiv*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). Those factors are: (1) whether the district 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 district 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

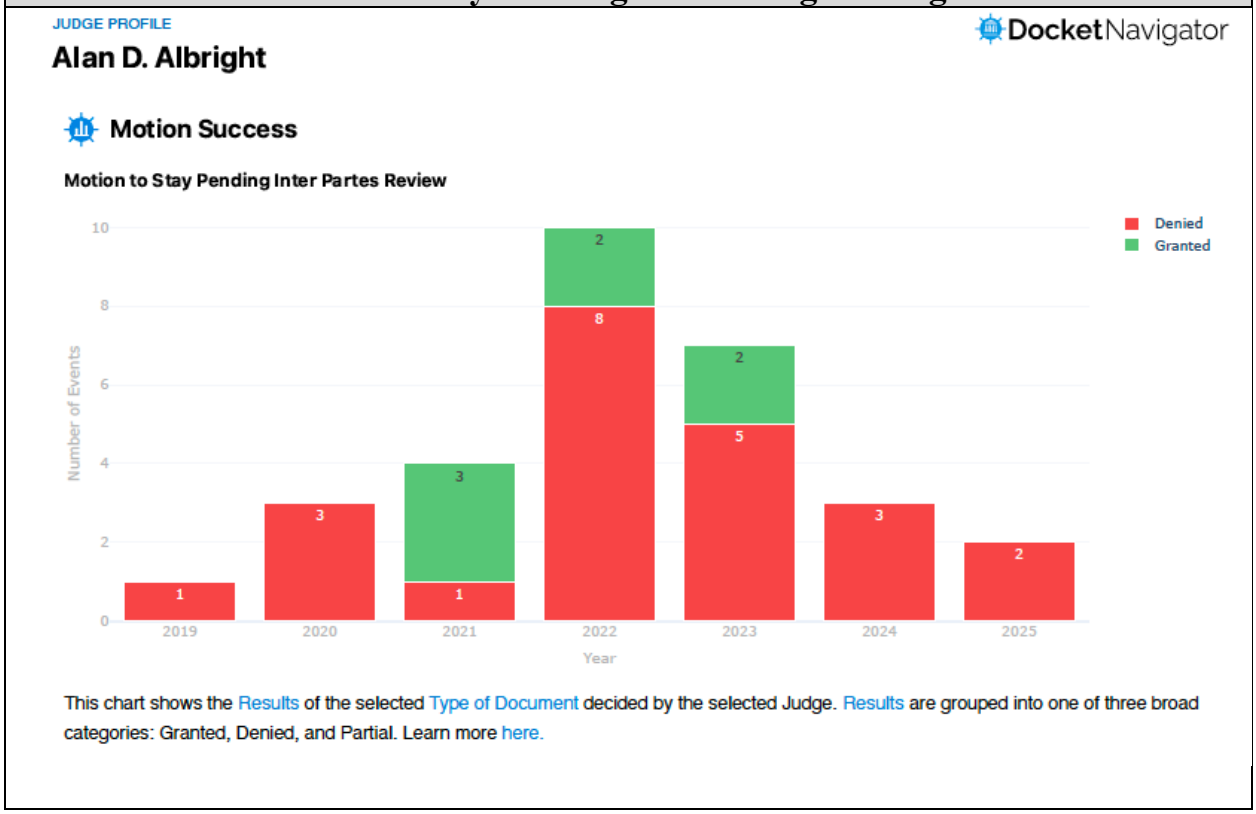
same party; and (6) other circumstances that impact the Board's exercise of discretion, including the merits. *Id.* Here, there is a parallel district court proceeding pending in the United States District Court for the Western District of Texas between Patent Owner Proxense and Petitioner Intel. The case is *Proxense, LLC v. Intel Corp*., 6:24-cv-00283 (the "District Court Proceeding"). As discussed below, each of the *Fintiv* factors weighs in favor of the Board denying institution in view of the District Court Proceeding.

A. The district court has not granted a stay and is unlikely to do so even if the Board institutes the Petition.

Petitioner has not sought a stay in the District Court Proceeding. Indeed, nowhere in its Petition or in the district court record has Petitioner even suggested that it will move the district court to stay the District Court Proceeding in the event the Board institutes the Petition. Moreover, Patent Owner represents that it will neither seek nor agree to a stay the District Court Proceeding.

Further, the evidence suggests that a stay is unlikely. Indeed, since 2019, Judge Albright has granted motion to stay pending *inter partes* review less than twenty-five percent of the time:

Motion to Stay Pending IPR – Judge Albright



Ex. 2002.

Because neither Petitioner nor Patent Owner seeks a stay, and because Judge Albright has denied the overwhelming majority of motions to stay pending *inter partes* review, the first *Fintiv* factor weighs in favor of discretionary denial.

B. The district court trial will conclude before the Board's statutory deadline to issue a final written Decision.

When the district court's trial date is earlier than the expected statutory deadline for Board's final written decision, "the Board generally has weighed this fact in favor of exercising authority to deny institution." *Fintiv*, IPR2020-

00019, Paper 11 at 9. Here, the district court trial date is set for May 18, 2026, *See* Ex. 2003, while the deadline for the statutory final written decision is July 30, 2026. Thus, the district court trial is scheduled to begin months before the Board would institute a final written decision.

For its part, Petitioner devotes a single sentence to this point and argues that "the median time to trial in the Western District of Texas for the twelve-month period ending September 30, 2024 is 33.1 months." Therefore, according to Petitioner, a district court trial may be expected in in early 2027. IPR2025-00327, Petition (Paper 2) at 79-80. But this overtly misleading statistic ignores the fact the district court has *already* set a trial date for May 18, 2026—not early 2027. And, according to Judge Albright's Frequently Asked Questions ("FAQ"), available at https://www.txwd.uscourts.gov/for-attorneys/judge-albright-courtroom-faq/, "[a]fter the trial date is set, the Court will not move the trial date except in extreme situations." *See* Exhibit 2004. Petitioner has not argued that it expects any "extreme situations" in connection with the case that would merit the district court moving the trial date. Further, the district court issued the scheduling order setting the trial date on October 28, 2024, nearly two months before Petitioner filed its Petition. Thus, Petitioner knew that a final written decision would issue after a district court trial, yet it still argued to the contrary.

Because the court-issued scheduling order—rather than Petitioner's conjecture—dictates that a final written decision would issue substantially later than a district court trial, this factor weighs in favor of discretionary denial.

C. The parties and the court have invested substantial resources in the district court case.

The District Court Proceeding was filed on May 23, 2024. Since that time, the parties and the court have invested substantial resources in the case. Patent Owner has completed and served its initial infringement contentions on Petitioner. Petitioner has completed and served its initial invalidity contentions on Patent Owner. Additionally, the parties have filed opening and responsive claim construction briefs. Indeed, as of this filing date, a *Markman* hearing has already been held before Judge Albright and a final claim construction order is imminent. Thus, the court has devoted a great deal of time to familiarizing itself with the patent and technology at issue. Further, by the July 30, 2025 institution deadline, fact discovery will have been open for nearly three months, and final infringement and invalidity contentions will have been served.

For its part, Petitioner appears to argue that this factor weighs in favor of institution because of the median time to trial in the Western District of Texas: "Because the median time to trial in the Western District of Texas for the twelve-month period ending September 30, 2024 is 33.1 months, trial may be expected to occur in early 2027…*Thus, Fintiv factors 2-3 favor institution*."

IPR2025-00327, Petition (Paper 2) at 79-80. But Petitioner's false assertion that trial will occur in 2027 does nothing to discount the fact that the court and the parties have invested substantial resources in the district court case.

Thus, this case is not at the very early stages of litigation, and it will be even further along by the Institution Deadline. Thus, this factor weighs in favor of discretionary denial.

D. There is substantial overlap between the issues raised in the Petition and the parallel District Court Proceeding.

Petitioner argues that the Gilb-802.15.3 combination renders claims 1-5, 8-11 invalid as obvious. IPR2025-00327, Petition (Paper 2) at 8. Petitioner argues that Gilb-802.15.3-Ward Combination renders claims 1-5, 8-11 invalid as obvious. *Id.* at 57. Petitioner argues that the Gilb-802.15.3-Ward-Brawn Combination renders claims 1-5, 8-11 invalid as obvious. *Id.* at 68. Petitioner's invalidity contentions advance the same arguments. *See e.g.* Exhibit 2005 at 9-17.

While it is true that the Petition challenges claims in addition to those challenged in the District Court Proceeding, "it may still be inefficient to proceed because the district court may resolve validity of enough overlapping claims to resolve key issues in the petition." *Fintiv,* IPR2020-00019, Paper 11 at 12-13. Here, the district court may resolve the validity of enough overlapping claims and Petitioner has not made any argument to the contrary.

Thus, this factor weights in favor of denying institution.

E. The Petitioner and the defendant in the parallel District Court Proceeding are the same party.

Where the Petitioner and the defendant in the parallel proceedings are the same party, this factor favors denial. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A); see also *Comcast Cable Communications, LLC v. Touchstream Technologies*, *Inc.,* IPR2024-00324, Paper 13 at 15 (PTAB July 24, 2024). Here, the parties in this proceeding and in the District Court Proceeding are the same. Indeed, Petitioner is the defendant in the District Court Proceeding. Thus, this factor weights in favor of discretionary denial.

F. There are no other circumstances that would disfavor denial

As discussed above, *Fintiv* factors one through 5 each weigh in favor of denial. Further, Petitioner has not identified any other reasons that would disfavor denial. Notably, Patent Owner will set forth arguments related to inconsistent claim construction positions taken by Intel in its forthcoming Preliminary Patent Owner Response that may be considered by the Board as additional circumstances favoring denial.

III. Conclusion

Each of the *Fintiv* factors weigh heavily in favor of the Board denying institution. *Inter partes* review of the ’043 Patent should therefore be denied.

Dated: April 28, 2025

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that the foregoing was served on April 28, 2025 by e-mailing copies to the e-mail addresses as provided in Petitioner's Petition.

Dated: April 28, 2025

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CERTIFICATE OF WORD COUNT

Under the provisions of 37 C.F.R. § 42.24, the undersigned hereby certifies that word count for the foregoing Brief (excluding the table of contents, certificate of service, word count, or listing of exhibits) is less than the 14,000 words allowed under 37 C.F.R. § 42.24.

Dated: April 28, 2025

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