

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONEPLUS TECHNOLOGY (SHENZHEN) CO., LTD.,

Petitioner

v.

PANTECH CORPORATION,

Patent Owner.

IPR2025-00762

U.S. Patent No. 10,863,573

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

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I.	INTRODUCTION	1
II.	DISCRETIONARY DENIAL IS INAPPROPRIATE UNDER 35 U.S.C. § 314(a)	4
A.	The PTAB Is Better Suited to Review a Large Number of Patents Involving Diverse and Complex Subject Matter	4
B.	There Are Compelling Economic Interests in Preventing a Non-Practicing Entity from Using Defective Patent Claims Against Manufacturers.....	8
C.	Patent Owner Has Not Established Settled Expectations	15
D.	Discretionary Denial Is Inappropriate Given the Strong Merits of the Unpatentability Challenge	20
E.	Patent Owner’s Other <i>Fintiv</i> Arguments Are Unavailing.....	24
1.	Factor 2: The FWD is likely to issue before the actual trial date in the district court litigation.....	24
2.	Factor 4: Petitioner’s stipulation to withdraw all §§ 102 and 103 challenges weighs strongly against discretionary denial	26
3.	Factor 6: The strong merits of the Petition weigh against discretionary denial.....	27
4.	Factor 1: Petitioner intends to request a stay, which is very likely to be granted.....	28
5.	Factor 5: The parties are not identical	29
6.	Factor 3: The Most Burdensome Work Remains in the Parallel Proceeding, and Petitioner diligently filed the instant Petition	29
III.	PATENT OWNER’S CONDUCT IN RELATED LITIGATION, NEGOTIATIONS, AND THIS PROCEEDING WEIGHS AGAINST DISCRETIONARY DENIAL	31
A.	Patent Owner’s Allegations of “Bad Faith” Are Baseless and Ignore Its Own Misconduct	31
B.	Patent Owner’s Litigation Misconduct Incited the Bias of the First Jury and Required a Second Trial	32
C.	The Jury Verdict Demonstrates Patent Owner’s Licensing Demands Constituted “Holdup”	34

D.	Patent Owner's Conduct in this Proceeding Should Not Be Rewarded	34
IV.	CONCLUSION.....	36

EXHIBIT LIST

Exhibit	Reference
1001	U.S. Patent No. 10,863,573 (“’573 Patent” or “’573Pat.”)
1002	File History of the ’573 Patent (“’573FH”)
1003	Declaration of Dr. Titus Lo in Support of Petition
1004	Dr. Titus Lo Curriculum Vitae
1005	U.S. Patent Application Publication No. 2014/0301362 (“Koskinen”)
1006	U.S. Patent Application Publication No. 2009/0149189 (“Sammour”)
1007	U.S. Patent Application Publication No. 2016/0021581 (“Deenoo”)
1008	U.S. Patent Application Publication No. 2014/0301281 (Koskinen281)
1009	<i>Pantech Corp.et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv-00038-RWS-JBB (E.D. Tex.), Dkt. No. 1, Complaint (“ <i>Pantech I</i> ”)
1010	<i>Pantech Corp.et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv-00038-RWS-JBB (E.D. Tex.), Dkt. No. 9, Waiver of Service
1011	3GPP TS 36.323 v.11.2.0 (2013-03) (Packet Data Convergence Protocol (PDCP) specification)
1012	3GPP TS 36.300 v.11.5.0 (2013-03) (E-UTRAN overall description)
1013	3GPP TS 36.322 v.11.0.0 (2012-09) (Radio Link Control (RLC) protocol specification)
1014	3GPP TS 36.331 v.11.3.0 (2013-03) (Radio Resource Control (RRC); Protocol specification)
1015	<i>Pantech Corp.et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv-00038-RWS-JBB (E.D. Tex.), Dkt. No. 47, First Amended Docket Control Order
1016	Docket Navigator stay statistics for Judge Schroeder in EDTX
1041	<i>Sotera-plus</i> Stipulation
1042	<i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 6, First Amended Complaint for Patent Infringement (“ <i>Pantech I</i> ”)

1043	<i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 223, Redacted Amended Joint Final Pretrial Order
1044	<i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 259, Verdict Form
1045	Cara Salvatore. <i>Albright Worried Multipatent Trials Ask Too Much of Jurors</i> . Law360 (Dec. 18, 2020)
1046	<i>Sonos Inc. v. D&M Holdings, Inc.</i> , 1:14-cv-01330-WCB (D. Del.), Dkt. No. 418, Discovery Dispute Letter Brief
1047	USPTO Recordation of Patent Assignment Document, Reel: 052662 Frames: 0609-0638
1048	<i>Pantech Corp. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:25-cv-00089 (E.D. Tex.), Dkt. No. 1, Complaint for Patent Infringement (“ <i>Pantech III</i> ”)
1049	Joshua Pond, et al. <i>Reexamining Three Preconceived Notions of SEPs as the 5G Patent Wars Ignite</i> . IPWatchDog (Oct. 25, 2021)
1050	Docket Navigator Statistics for Judge Schroeder in E.D. Tex.
1051	<i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv-00038-RWS-JBB (E.D. Tex.), Dkt. No. 12, Joint Motion to Stay Proceedings
1052	<i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 499, Final Judgment
1053	<i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 502-1, Redacted Version of Court’s Order (Dkt. No. 498)

I. INTRODUCTION

Discretionary denial (“DD”) of the instant Petition for *Inter Partes* Review (“IPR”) of U.S. Patent No. 10,863,573 (the “’573 Patent”) is wholly unwarranted. The Petition presents strong merits, comprising straightforward single-reference obviousness and simple two-reference combination grounds. These merits alone weigh heavily against discretionary denial.

Further, in a related IPR (IPR2025-00763, the “’763 IPR”) filed by Petitioner against one of the eight patents asserted in the parallel district court litigation—*Pantech II*,¹ the Director has already referred to a Board panel to consider the merits and non-discretionary considerations of the petition. *OnePlus Technology (Shenzhen) Co., Ltd. v. Pantech Corp.*, IPR2025-00763, Paper 4, at 1-2 (Director August 18, 2025). Accordingly, it is appropriate for the Board to use its resources also to consider the merits of the instant Petition involving another patent asserted in the same parallel litigation—rather than leaving the validity of the asserted patents to be adjudicated piecemeal in two separate forums under different standards—to avoid unnecessary inefficiency and a risk of inconsistent outcomes. *Advanced Micro Devices, Inc. et al. v. Concurrent Ventures, LLC et al.*, IPR2025-00478, Paper 10 at 2-3 (Director July 31, 2025) (finding it is an efficient use of Board resources to

¹ *Pantech Corp. et al. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, No. 5:24-cv-00038-RWS-JBB (E.D. Tex.) (“*Pantech II*”).

address the challenged patent when another patent involved in the same parallel district court proceeding has been referred to the Board)².

Additionally, institution is particularly appropriate because the PTAB is far better suited to resolve these complex patentability issues efficiently and consistently. Not only will the PTAB likely issue a FWD before trial, but the parallel district court litigation involves eight patents across distinct families, covering diverse and complex technologies, making it impractical for the district court to fully adjudicate validity within the limited trial framework.

Moreover, institution of this IPR serves important economic and public

² In a companion IPR (IPR2025-00637, the “’637 IPR”) involving a different patent, the Director granted Patent Owner’s Request for Discretionary Denial. *OnePlus Technology (Shenzhen) Co. Ltd. v. Pantech Corp.*, IPR2025-00637, Paper 17 (Director August 14, 2025). In that case, Petitioner, however, did not have an opportunity to present its arguments based on *AMD* and *Stratasys* as those decisions were not rendered until Petitioner had already filed its opposition. Also, the related ’763 IPR has not been referred to the Board at the time when the DD decision of the ’637 IPR was made. Thus, the change of circumstances in this IPR warrants a different outcome from the ’637 IPR DD decision. *ARM LTD. et al. v. Daedalus Prime LLC*, IPR2025-00207, Paper 14, at 2 (Director, August 6, 2025).

interests. Patent Owner's aggressive monetization campaign—asserting patents with questionable validity to demand unreasonable royalties—has imposed significant burdens on manufacturers. Preventing such misuse of defective patents serves the American public.

Finally, Patent Owner has not developed settled expectations regarding the '573 Patent. The '573 Patent issued December 8, 2020, less than 5 years ago. *See Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025) (analogizing settled expectations to 6-year bar on patent infringement damages). After acquiring the '573 Patent in 2020³, PO began asserting it in July 2021, and to date has only asserted it once, against Petitioner. Petitioner filed the instant IPR in April 2025, which is less than four and half years after the '573 Patent issued. Patent Owner's settled expectations thus have not been established given the age of the '573 Patent, the history of validity challenges to its portfolio, and Patent Owner's only recent efforts to assert the '573 Patent.

As will be explained in detail below in Sections II.A and II.C, the Director's *Tuozhu* decision is particularly applicable here and indeed controlling. *Shenzen Tuozhu Technology Co. Ltd. v. Stratasys, Inc.*, IPR2025-00531, Paper 10 (Director

³ PO did not invent any of the patents it asserts against Petitioner in district court or the ITC.

July 17, 2025) (“*Tuozhu*”). In that case, one of the patents has been in force for about ten years, but it has never been “commercialized, asserted, marked, licensed, or otherwise applied” in petitioner’s “particular technology space.” *Id.* at 3. Additionally, the parallel district court litigation involved nine patents from six different families with a “diverse range of subject matter.” *Id.* The petitioner there also filed a broad stipulation. The Director ruled that these factors tipped the balance against discretionary denial. *Id.*

II. DISCRETIONARY DENIAL IS INAPPROPRIATE UNDER 35 U.S.C. § 314(a)

A. The PTAB Is Better Suited to Review a Large Number of Patents Involving Diverse and Complex Subject Matter

The ’573 Patent is asserted in *Pantech II*, and discretionary denial is inappropriate here given the large number of asserted patents and the diverse, complex subject matter involved. In *Pantech II*, Patent Owner asserts eight patents from eight different families, each relating to a different aspect of sophisticated 4G/5G wireless communication technologies. *See* EX1009, 4-6, 13, 16, 19-20, 23, 26, 29, 32, 35. It is unreasonable to expect a jury to fully adjudicate eight patents, each hailing from a different patent family, in a single trial. Further, because the Court mandates a narrowing of asserted claims, EX2004, 4, it is impossible for the district court to address the validity of all the Challenged Claims in this petition.

In prior litigation between the same parties before the same judge stemming

from the same monetization campaign by Patent Owner—*Pantech Corp. et al. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, No. 5:22-cv-00069-RWS (E.D. Tex) (“*Pantech I*”), Patent Owner similarly asserted eight patents from eight different families, four of which also involved the 4G/5G communication technologies. *See* EX1042, 4-6, 12-13, 15-16, 24-26, 35-36. In *Pantech I*, despite requests from both sides for a longer trial, Judge Schroeder limited the trial to five days. *See* EX1043, 18-19. As a result, each side was allotted just 11 hours for all direct, cross, and rebuttal examinations. Indeed, due to these time constraints and the complexity of the issues, the invalidity of the asserted communications patents was not addressed during the trial. EX1044, 5 (seeking verdict regarding invalidity of only two non-communications patents).

Other experienced district court judges have similarly recognized the difficulty of presenting multiple patents to a jury in a limited trial setting. *See, e.g.*, EX1045, 1 (Judge Albright stating that he does not think “it’s fair to have a jury trying to handle more than two or three patents at a time”); EX1046, 2 (letter brief quoting Judge Andrews stating in a scheduling conference that a five-day trial should be appropriate for only a two-patent case). Accordingly, there will be significant practical difficulties in fully litigating the validity of the patents, including the ’573 Patent, in the *Pantech II* case.

In such cases as this one, the Director has refused to discretionarily deny the

petitions because “the Board is better suited to review a large number of patents involving diverse subject matter.” *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2-3 (Director June 13, 2025) (“*Tesla*”). For example, in *Tesla*, the Director denied the Patent Owner’s discretionary denial request even though the scheduled trial date preceded the projected Final Written Decision (FWD) date and despite meaningful investment in the parallel litigation. *Id.* at 2. The Director found that “Petitioner’s arguments regarding the complex and diverse litigation proceeding tip the balance against discretionary denial” because “[t]he large number and vast scope of the patents asserted in the district court litigation ... weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter.” *Id.* at 2-3; *see also Tesla, Inc. v. The United States of America as Represented by the Secretary of the Navy*, IPR2025-00341, Paper 12 at 2-3 (Director June 13, 2025); *Tuozhu*, IPR2025-00531, Paper 10 at 3 (Director July 17, 2025).

That same rationale applies here. In addition to this Petition, Petitioner has filed seven other IPR petitions against all eight patents asserted in *Pantech II*. *See also*, IPR2025-00720, -00756, -00762, -00763, -00783, -00887, -00888. It is impractical to expect a jury to, over the course of a trial of limited duration, fully adjudicate (i) the validity of eight patents from eight different families—each involving distinct aspects of complex 4G/5G wireless communication technologies,

(ii) infringement issues of those same, eight patents, (iii) damages, (iv) issues related to fair, reasonable, and non-discriminatory (“FRAND”) obligations, and (v) any counterclaims. It is far more practical and efficient for the PTAB, with its technical expertise and patent experience, to resolve the 35 U.S.C. §§ 102 and 103 issues through IPR proceedings.⁴

Moreover, *Pantech II* involves only claims 8-11 of the ’573 Patent, whereas the instant Petition challenges six additional claims (claims 1-5 and 12). Pet. 1. Thus, even if invalidity issues concerning the asserted claims 8-11 of the ’573 Patent could be addressed within the trial in *Pantech II*, the trial would not resolve the validity of the remaining six claims (claims 1-5, 12), which likewise raise strong unpatentability concerns, as discussed in Section II.D below.

Furthermore, there is no risk of duplicative work here. Petitioner has provided a broad, unequivocal stipulation that it will not pursue “*any* invalidity grounds under 35 U.S.C. §§ 102 and 103 against the ’573 Patent” if this IPR is instituted. EX1041. This stipulation is both broader and more straightforward than the *Sotera-plus* stipulation recently found by the Director to weigh against discretionary denial in

⁴ Indeed, institution would resolve all prior art based disputes between the Parties. Petitioner has stipulated that if this IPR is instituted, Petitioner will not pursue *any* invalidity grounds under 35 U.S.C. §§ 102, 103. EX1041.

Tesla. *Tesla*, IPR2025-00217, Paper 9 at 2; *see also id.*, EX1067 (*Sotera-plus* stipulation); *Tuozhu*, IPR2025-00531, Paper 10 at 3, EX1033 (*Sotera-plus* stipulation). Petitioner has firmly committed that, if the Board institutes review, it will not only withdraw any §§ 102 and 103 grounds it raised or could have raised in the IPR, but will also ***withdraw all §§ 102 and 103 challenges to the '573 patent entirely*** in *Pantech II*—ensuring this IPR serves as a true alternative to district court litigation. *See Motorola Solutions Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB March 28, 2025). This stipulation fully eliminates any concern of duplication between this proceeding and *Pantech II*.

Accordingly, institution is a practical, efficient, and non-duplicative alternative to the district court litigation—Patent Owner’s request should be refused on this basis alone. *See Tesla*, IPR2025-00217, Paper 9 at 2-3.

B. There Are Compelling Economic Interests in Preventing a Non-Practicing Entity from Using Defective Patent Claims Against Manufacturers

There are compelling economic and public policy interests favoring institution of this IPR. Patent Owner is a non-practicing entity (NPE) engaged in an ongoing campaign to monetize a portfolio of weak patents that it did not invent. Its strategy typically begins with demands for excessive royalties, followed by serial litigation when those demands are not met. This conduct has already contributed to the withdrawal of multiple cell phone manufacturers from the U.S. market. Despite

repeated and meritorious challenges to its portfolio, Patent Owner’s litigation campaign persists unchecked. Under these circumstances, institution of this IPR is not only appropriate—it is necessary to protect manufacturers, promote judicial efficiency, and preserve the integrity of the patent system.

Patent Owner is a known NPE.⁵ According to the USPTO Assignment Database, Patent Owner acquired the patent rights to the ’573 Patent, along with more than 200 other U.S. patents, through an “Intellectual Property Sale and Purchase Agreement” in 2020. *See* EX1047, 1, 8.

As explained below, during its ongoing monetization campaign against numerous manufacturers, including Petitioner, Patent Owner has demanded unreasonable royalty rates that violate its FRAND obligations for its patent portfolio. *See infra*, Section III. Since 2021, Patent Owner has filed a slew of patent infringement lawsuits against a range of manufacturers, including LG Electronics Inc., Asustek Computer Inc., BLU Products Inc., GNJ Manufacturing Inc., CoolPad Ground Limited, Lenovo Ground Ltd., HMD Global OY, TLC Industrie Holdings

⁵ *See, e.g.*, <https://portal.unifiedpatents.com/ptab/case/IPR2025-00637> (identifying Patent Owner as “NPE (Patent Assertion Entity)”); <https://ai-lab.exparte.com/case/ptab/IPR2025-00637/oneplus-technology-shenzhen-co-ltd-et-al-v-pantech-corporation> (identifying Patent Owner as “NPE”).

Co., Ltd., Shenzhen Tinno Mobile Technology Corp., and Petitioner. These lawsuits further illustrate Patent Owner's business model of asserting patents against manufacturers to extract royalties.

Patent Owner's aggressive monetization campaign has real and harmful economic consequences. Patent Owner's repeated demands for non-FRAND royalty rates have placed a significant burden on manufacturers, even contributing to the withdrawal of companies from the U.S. cellphone market, such as GNJ Manufacturing Inc. and CoolPad Group Limited. This underscores the strong economic interest in preventing Patent Owner from using defective patent claims to extract unjustified royalties from manufacturers.

The patents asserted in this campaign are not good patents. Although Patent Owner undoubtedly attempted to pick its best patents from a field of over 200 U.S. patents to assert in litigation, the Patent Office has consistently found serious patentability issues with those patents. For example, all seven patents asserted by Patent Owner from this same portfolio in its district court litigation against LG Electronics Inc. were found likely unpatentable in the institution decisions across seven IPR proceedings filed by LG Electronics Inc. *See Pantech Corp. et al. v. LG Elecs. Inc et al.*, 5:22-cv-00113-RWS, (E.D. Tex) (the "*LG case*"); IPR2023-01267, -01268, -01269, -01270, -01271, -01272, -01273. Petitioner has also filed five *Ex Parte* Reexamination ("EPR") requests against five other patents in Patent Owner's

patent portfolio, *all* of which were ordered based on findings of substantial new question of patentability. *See* 90/019,553, 90/019,559, 90/019,641, 90/019,704, 90/019,726. Four of those patents were asserted in *Pantech I* (with the fifth being a related family member), yet their invalidity was not adjudicated at trial due to the compressed schedule and complex and diverse subject matter.

The fact that nearly all of the carefully selected, first-tier patents asserted by Patent Owner in its initial wave of litigation against LG Electronics Inc. and Petitioner were found to have defective claims strongly suggests that the eight patents from the same portfolio asserted in its second wave of litigation (*Pantech II*)—including the '573 Patent—are even more vulnerable to unpatentability challenges in the eight pending IPRs filed by Petitioner.

Finally, Patent Owner's weaponization of these questionable patents against cell phone manufacturers appears unending. On July 3, 2025, Patent Owner initiated a third wave of district court litigation against five cell phone manufacturers, including Petitioner, in the same district court—*Pantech Corp. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, No. 5:25-cv-00089 (E.D. Tex.) (*Pantech III*)⁶—asserting four

⁶ The other four district court cases are *Pantech Corp. v. Shenzhen Inno Mobile Tech. Corp.*, No. 5:25-cv-00090 (E.D. Tex.); *Pantech Corp. v. TCL Indus. Holdings Co.*,

patents, two of which are continuations of a patent involved in *Pantech II*.⁷ On the same day, Patent Owner also filed a Section 337 investigation complaint with the U.S. International Trade Commission (“ITC”), asserting the same four patents from *Pantech III* against Petitioner and several other respondents, all of whom are cell phone manufacturers in the U.S. market. *See In the Matter of Certain Mobile Cellular Communications Devices*, Inv. No. 337-TA-3835 (ITC).

Patent Owner neither makes nor sells any products, and therefore does not compete in the market against Petitioner and these other manufacturers. Instead, Patent Owner evidently seeks to use the ITC proceedings and its remedy of an exclusion order as a club to bully Petitioner and other cell phone manufacturers into accepting a supra-FRAND license rate. The threat of an exclusion order tilts any negotiation concerning the patents-in-suit heavily in favor of Patent Owner and fosters an environment of patentee “hold up.” *See Apple, Inc. v. Motorola, Inc.*, 869

Ltd., No. 5:25-cv-00091 (E.D. Tex.); *Pantech Corp. v. HMD Global Oy*, No. 5:25-cv-00092 (E.D. Tex.); and *Pantech Corp. v. Lenovo Group Ltd.*, No. 5:25-cv-00093 (E.D. Tex.)

⁷ U.S. Patent Nos. 11,051,344 and 12,267,876 asserted in *Pantech III* are continuations of U.S. Patent No. 9,288,824, which is currently asserted in *Pantech II* and challenged in IPR2025-00783. EX1048, 4-5.

F.Supp.2d 901, 914 (N.D. Ill. 2012) (“[A] royalty negotiation that occurs under threat of an exclusion order may be weighted heavily in favor of the patentee in a way that is in tension with the RAND commitment.... [T]he threat of an exclusion order may allow the holder of a RAND-encumbered SEP to realize royalty rates that reflect patent hold-up, rather than the value of the patent relative to alternatives.”) (citation omitted).

The Federal Circuit has held that “a party that has made an ETSI FRAND commitment must have complied with the commitment’s obligation to negotiate in good faith over a license to its SEPs before it pursues injunctive relief based on those SEPs.” *Telefonaktiebolaget LM Ericsson v. Lenovo (United States), Inc.*, 120 F.4th 864, 876 (Fed. Cir. 2024). Patent Owner has never offered Petitioner a license specifically to the patents asserted in *Pantech II* or in *Pantech III* and the ITC on any terms, let alone FRAND terms. Patent Owner instead demanded that Petitioner license Patent Owner’s *entire patent portfolio*, which includes both SEPs and non-SEPs, at a supra-FRAND rate. Following the damages retrial in *Pantech I*, the jury rejected Pantech’s damages theory based on its supposed FRAND rate, awarding significantly lower damages. *See* EX1053. The trial record demonstrates that Patent Owner did not comply with its FRAND obligations by failing to offer a license to OnePlus on similar terms to those the prior patent owner had granted other competitors in the market.

Patent Owner’s aggressive monetization campaign has real and harmful economic consequences. Patent Owner’s repeated demands for non-FRAND royalty rates have placed a significant burden on manufacturers, even contributing to the withdrawal of companies from the U.S. cellphone market, such as GNJ Manufacturing Inc. and CoolPad Group Limited. This underscores the strong economic interest in preventing Patent Owner from using defective patent claims to extract unjustified royalties from manufacturers. *See also*, Federal Trade Commission, “The Evolving IP Marketplace: Aligning Patent Notice and Remedies with Competition,” March 2011, at 5 (“Patent hold-up can overcompensate patentees, raise prices to consumers who lose the benefits of competition among technologies, and deter innovation by manufacturers facing the risk of hold-up.”)

The PTAB plays a vital role in addressing such defective patents. In the *LG* case, the Board’s institution of IPRs on all seven asserted patents led to a prompt settlement between the parties, eliminating the need for a district court trial.⁸ This outcome further demonstrates that the PTAB is a more efficient forum for resolving

⁸ IPR was instituted in March and April 2024; the parties jointly moved to dismiss the case in view of settlement agreement shortly afterwards, on August 13, 2024. *See* IPR2023-01267 to -01273; *Pantech Corporation v. LG Electronics Inc.*, 5:22-cv-00113-RWS, (E.D. Tex), Dkt. No. 376 (Joint motion to dismiss).

such disputes. In contrast, Patent Owner's recent filing of *Pantech III* and ITC complaint is a strong indication that it does not expect to resolve its disputes with Petitioner in *Pantech II*. Therefore, reviewing the IPRs by the PTAB for the patents asserted in *Pantech II*—including the '573 Patent at issue here—is, as in the *LG* case, an efficient engine to drive the settlement of disputes between Patent Owner and Petitioner here, thereby making institution an appropriate and efficient use of the Office's resources.

Given Patent Owner's track record of asserting weak patents to demand excessive royalties, institution of this IPR is not only warranted but necessary to protect manufacturers, promote judicial efficiency, and uphold the integrity of the patent system.

C. Patent Owner Has Not Established Settled Expectations

Patent Owner has not established settled expectations regarding the '573 Patent. The '573 Patent issued less than five years ago and has not acquired settled expectations simply on its age. *See Dabico*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025) (analogizing settled expectations to 6-year bar on patent infringement damages); *Cambridge Industries USA Inc., v. Applied Optoelectronics, Inc.* IPR2025-00434 Paper 11 at 2-3 (Director June 26, 2025) (finding Patent Owner has not developed strong settled expectations that favor discretionary denial for patents issued in 2020 and 2019); *Berkshire Hathaway Energy Company et al. v.*

Birchtech Corp., IPR2025-00274, Paper 23 at 3 (Director July 2, 2025) (same).

Patent Owner only acquired the patent rights through an “Intellectual Property Sale and Purchase Agreement” in 2020 (*see* EX1047, 1, 8) and did not begin monetizing the patent until July 2021. DD Req. 12 (citing EX2003). Further, the ’573 Patent itself has only ever been asserted against Petitioner. As the Director has previously explained, even though “[a] patent may have been in force for years,” the fact that a patent has not been “commercialized, asserted, marked, licensed, or otherwise applied in a petitioner’s particular technology space, if at all” will “weigh against a patent owner’s claim of settled expectations and bear[] on the Director’s discretion.” *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2-3 (Director June 26, 2025); *see also* *Tuozhu*, IPR2025-00531, Paper 10 at 3 (finding the challenged patents have never been “commercialized, asserted, marked, licensed, or otherwise applied” in Petitioner’s “particular technology space”).

Such is the case here. Indeed, Patent Owner appears to measure its “settled expectation” regarding the ’573 Patent from its first monetization effort against Petitioner in July 2021, which is “almost three years” from the filing of this IPR. DD Req. 3. That limited timeframe is unsurprising. Prior to 2020, Patent Owner had no rights to commercialize, assert, mark, license, or otherwise apply the ’573 Patent. *See Intel*, IPR2025-00327, Paper 12 at 2–3. Moreover, there is no evidence that Patent Owner “commercialized, asserted, marked, licensed, or otherwise applied”

the '573 Patent in Petitioner's technology space between its 2020 acquisition and its first assertion in July 2021. *Id.* To Petitioner's knowledge, the '573 Patent has only been asserted once, against Petitioner in the *Pantech II* case. By PO's own accounting, "almost three years" since it began efforts to monetize the '573 Patent falls squarely within the Director's guidance in *Intel* regarding settled expectation. *Id.* (a lack of commercialization, assertion, or any other application of the patent in a petitioner's technology area weighs against finding strong settled expectations).

Unlike innovators who develop and own patents through their own research and development, Patent Owner—an NPE—acquired the patent portfolio solely for monetization. Any expectation that its patents would remain unchallenged could not reasonably begin before its enforcement campaign. This is especially true here, where (i) numerous Office proceedings have already raised serious patentability questions about its portfolio (*see* Section II.B), and (ii) Petitioner has consistently contested the validity of the patent portfolio since receiving Patent Owner's initial licensing demand, including asserting numerous invalidity defenses in district court and EPRs since the filing of *Pantech I*. Under these circumstances, Patent Owner cannot credibly claim that it had settled expectations that its patents were valid and enforceable.

Patent Owner's claim that there are strong settled expectations because the '573 Patent "is a standard essential patent ('SEP')," DD Req. 11, should be rejected.

As an initial matter, the “3GPP takes no position as to whether a patent declared essential to a standard is in fact essential...Experts estimate that only 10-47% of declared patents to the 2G/3G/4G standards are actually essential to practicing the standard and thus up to 90% of patents declared essential to these standards are not, in fact, essential.” EX1049. Further, the inclusion of any technology in the 3GPP standard is not predicated on it being new or nonobvious or otherwise an innovation over the prior art. Rather, “[w]hen a technology is incorporated into a standard, it is typically chosen from among different options. Once incorporated and widely adopted, that technology is not always used because it is the best or the only option; it is used because its use is necessary to comply with the standard.” *Ericsson, Inc. v. D-Link Systems, Inc.*, 773 F.3d 1201, 1233 (Fed. Cir. 2014). Furthermore, Patent Owner cannot rely on purported SEP status of the ’573 patent to establish “settled expectations” when it has violated its FRAND obligations in its monetization campaign.

Patent Owner’s suggestion that Petitioner should have filed IPRs earlier after receiving its 2021 licensing demand is misplaced. DD Req. 18. Given Patent Owner’s demand for a portfolio-wide license covering hundreds of patents, it would have been inefficient and impractical for Petitioner to preemptively challenge each of the over 200 U.S. patents in Patent Owner’s portfolio. *See generally* EX2003, 6-13 (providing an “Exemplary List of Pantech Wireless Patents” containing 224

patents). Moreover, Patent Owner deliberately chose not to assert the '573 Patent in *Pantech I* filed in 2022. Until Patent Owner filed *Pantech II* in 2024—including the '573 Patent—Petitioner had no reason to believe the '573 Patent would be asserted over the hundreds of other patents in Patent Owner's recently acquired portfolio. The timing of this IPR is thus directly attributable to Patent Owner's dilatory and piecemeal litigation strategy.

In sum, not only the instant Petition was filed less than four and half years after the '573 Patent issued, under the Director's guidance in *Intel* and based on Patent Owner's own admission, any settled expectations regarding the '573 Patent can only be measured from July 2021—when Patent Owner first began its monetization efforts. From that point, Patent Owner has not developed settled expectations that would support discretionary denial here. *See Dabico*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025); *Cambridge*, IPR2025-00434 Paper 11 at 2-3 (Director June 26, 2025); *Berkshire Hathaway*, IPR2025-00274, Paper 23 at 3 (Director July 2, 2025).

Discretionary denial is further unwarranted given the additional considerations including the district court's inability to address all the validity challenges here, compelling economic interests, and strong merits. *POSCO Co., Ltd. v. ArcelorMittal* PR2025-00370, Paper 10 at 2-3 (Director June 25, 2025) (finding "Petitioner's arguments regarding settled expectations—namely that Patent Owner's

claims were “highly vulnerable to invalidation based on prior art”—tip the balance against discretionary denial.”).

D. Discretionary Denial Is Inappropriate Given the Strong Merits of the Unpatentability Challenge

Discretionary denial is unwarranted considering the strong merits of the unpatentability grounds set forth in the Petition, consistent with the Acting Director’s *Interim Processes for PTAB Workload Management* (“Director Memo”).

The challenged claims of the ’573 Patent merely recite well-known techniques for enabling user equipment to communicate with multiple base stations by using a timer that enables packet data convergence protocol (“PDCP”) data received out of order from the multiple base stations to be sent in sequential order to upper processing layers. All elements of the challenged claims, including the purportedly patentable subject matter, are disclosed or suggested by U.S. Patent Application Publication No. 2014/0301362 to Koskinen (“Koskinen,” EX1005) alone, and independently rendered obvious by Koskinen and U.S. Patent Application Publication No. 2009/0149189 to Sammour (“Sammour,” EX1006). All elements of the challenged claims are also independently rendered obvious by U.S. Patent Application Publication No. 2016/0021581 to Deenoo (“Deenoo,” EX1007) and Sammour. Both Koskinen and Sammour disclose the key limitations that the Applicant argued were missing from the prior art during prosecution, namely “*wherein the RRC message include a PDCP-configuration information element (IE),*

and” “the PDCP-configuration IE includes a field indicating a value of the in-sequence timer.”

The Petition accordingly presents particularly strong unpatentability arguments on straightforward single-reference obviousness and two-reference combination grounds. Specifically, the Petition establishes that (i) claims 1-5 and 8-12 are rendered obvious by Koskinen, (ii) claims 1-5 and 8-12 are rendered obvious by Koskinen and Sammour, and (iii) claims 1-5 and 8-12 are rendered obvious by Deenoo and Sammour. *See* Pet. 1. These clear and well-supported challenges further demonstrate that discretionary denial is inappropriate, and that institution should be granted.

While the '573 Patent itself admits many of the claim elements (limitations 1[pre]-1[b] and the corresponding limitations of claim 8) were known in the prior art (*see* Petition, 11-17; '573Pat, 1:29-2:18), Koskinen and Deenoo unequivocally describe these basic and well-known limitations. Petition, 11-17, 48-53.

Receiving, from the macro base station, information related to an in-sequence timer for the PDCP SDU through a radio resource control (RRC) message wherein the PDCP SDUs are indicated by a predefined PDCP sequence number (SN) (limitations 1[c]-1[d] and the corresponding limitations of claim 8) was also well known, as exemplified by Koskinen, Petition, 18-21, and Deenoo, Petition, 53-57. For example, Koskinen teaches that the RLC layer of the UE includes a reordering

timer—t-Reordering—used as a time interval in which to determine whether reordering of received RLC data is out of order and must be reordered by waiting for in-sequence RLC data. Koskinen, ¶¶4, 16-17. The “timer’s expiry value can be configured by radio resource control (RRC).” *Id.*, ¶39, claims 2, 16. Koskinen further teaches that the PDCP SDUs are indicated by a PDCP SN, consistent with the ’573 patent’s treatment of PDCP SNs. *Id.*, ¶¶8, 56, 573Pat, Figs. 12-13; Petition 19-21. Deenoo likewise teaches that the UE receives an in-sequence timer for PDCP SDUs through a RRC message from the macro base station based on its “re-ordering algorithm” comprising a reordering timer. Deenoo, ¶¶205-212, Petition, 53-54. And Deenoo further teaches that the UE may determine missing PDCP PDU sequence numbers, meaning that said PDCP PDU SNs were “predefined.” Deenoo, ¶¶14, 206-211; Petition, 56-57.

Koskinen and Sammour further teach and render obvious the limitations that ultimately got the ’573 Patent allowed during prosecution—namely that the RRC message includes a PDCP-configuration information element (IE) that includes a field indicating a value of the in-sequence timer (limitations 1[e]-1[f] and the corresponding limitations of claim 8). Petition, 21-24, 41-43, 57-58. For example, Koskinen, which incorporates by reference and builds on 3GPP technical specifications, including TS 36.331, teaches that each UE including a PDCP layer is configured by RRC, and PDCP IEs in RRCs were well-known at the time, as

exemplified by the 3GPP technical specifications. Petition, 22-23, TS 36.331, 202. And it further would have been obvious to include the PDCP timer information in the PDCP-configuration IE because Koskinen discloses that the PDCP timer uses radio link control-unacknowledged mode variables, which describe an IE carrying reordering timer duration information for the RLC layer. TS 36.331, 219-220; Petition, 23-24. Further Sammour, combined with either Koskinen or Deenoo, renders obvious that the RRC message includes a PDCP-configuration IE that includes a field indicating the value of the in-sequence timer via Sammour's "Reordering Stop Mode IE." Sammour, ¶¶148-152; Petition, 41-43. Sammour's Reordering Stop Mode IE indicates to the UE that it should use a timer mechanism to stop reordering, and a flush timer IE indicates the value of the flush timer. *Id.*

In sum, whether Patent Owner's expectations regarding the '573 Patent are measured from 2021 or 2020, those expectations are not "settled" and do not justify discretionary denial. As detailed in Sections II.A-II.C above and Section III below, Petitioner has provided detailed, compelling reasons why institution of this IPR is an appropriate and efficient use of Board resources. *See Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025). This conclusion is fully aligned with the Director's reasoning in numerous recent, analogous decisions, such as *Tesla* and *Intel*. Accordingly, discretionary denial is not warranted.

E. Patent Owner’s Other *Fintiv* Arguments Are Unavailing

1. Factor 2: The FWD is likely to issue before the actual trial date in the district court litigation

The projected statutory deadline of FWD in this IPR falls on November 19, 2026, and the trial date of *Pantech II* is currently not set. EX2004. Judge Schroeder’s median time-to-trial of 30 months—which, accounting for the more than three-month stay, places the trial around December 2026. This shows that the FWD is likely to issue before the trial. EX1050, 2; *see also* EX1051, 3 (Patent Owner acknowledging that stay was desirable to promote judicial efficiency and that the stay would “not prejudice either Party”). The Director and Board have routinely considered median time-to-trial statistics of *the presiding judge* to more accurately predict actual trial timing. *See, e.g., Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-00250, Paper 14 at 2 (Director May 16, 2025) (using Judge Noreika’s time-to-trial statistics to predict actual trial timing instead of relying on the scheduled date); *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00321, Paper 10 at 10 (PTAB June 18, 2025) (finding *Fintiv* factor 2 neutral or slightly against discretionary denial based on Judge Gilstrap’s time-to-trial statistics, despite an earlier scheduled trial date).

Notably, in the ’637 IPR, which challenges another patent asserted in the *Pantech II* case and was filed just one month before this IPR, the Director has found that “it is likely that a final written decision in this proceeding will issue before the

district court trial occurs.” ’637 IPR, Paper 17, at 2. Extending the same reasoning here, the FWD will issue before the likely trial date in the *Pantech II* case.

In addition, the very real possibility of a stay being entered in *Pantech II* in view of the newly filed ITC complaint and *Pantech III* further undermines the certainty of the current trial date in *Pantech II*. Post-trial proceedings in *Pantech II* could also substantially delay the final judgment. For example, in *Pantech I*, the final judgment was issued almost 10 months after the first trial. *Compare* EX1044 (first jury verdict dated April 1, 2024) *with* EX1053 (final judgement dated January 23, 2025).

Even if the Director considers the currently scheduled pretrial conference date in Factor 2 analysis and determines that this date precedes the projected FWD date of this IPR, discretionary denial remains inappropriate. The PTAB is still better suited to review the Petition in this particular case not all claims challenged in this IPR are part of the district court proceeding, and this lack of overlap is expected to become larger as additional claims are dropped before the start of the trial, and the parallel district court litigation involves numerous patents covering diverse and complex technologies, making full adjudication impractical (*see* Section II.A)—consistent with the Director’s several recent decisions. *See Tesla*, IPR2025- 00217, Paper 9 at 2-3 (finding that “Petitioner’s arguments regarding the complex and diverse litigation proceeding tip the balance against discretionary denial” even with

an earlier trial date, no likelihood of stay, and meaningful investment in the district case).

This case particularly parallels *Tesla*. There, the Director identified two key factors weighing against discretionary denial: a broad stipulation and strong merits. *Tesla*, IPR2025-00217, Paper 9 at 2. As discussed above, Petitioner’s stipulation here is at least as broad and even more straightforward than in *Tesla* (see Sections II.A, II.E.2), and the Petition similarly presents strong merits (see Section II.A). Moreover, as in *Tesla*, Petitioner has explained that *Pantech II* involves complex and diverse subject matter across eight patents, making it highly impractical for the district court to fully adjudicate validity—including that of the ’573 Patent—within the limited trial framework. See Section II.A. Such considerations were so strong that the Director found these considerations outweighed the fact that, in *Tesla*, “the scheduled trial date precedes the projected final written decision due date” and that “there has been meaningful investment in the parallel proceeding by the parties.” IPR2025-00217, Paper 9 at 2.

2. Factor 4: Petitioner’s stipulation to withdraw all §§ 102 and 103 challenges weighs strongly against discretionary denial

Patent Owner mischaracterizes Petitioner’s second stipulation (EX1041) as merely “a *Sotera* stipulation.” DD Req. 8. As explained in Section II.A above, Petitioner’s stipulation is both broader and more straightforward than the *Sotera-plus* stipulation in *Tesla*. See *Tesla*, IPR2025-00217, Paper 9 at 2; see also *id.*,

EX1067 (*Sotera-plus* stipulation). Petitioner has unequivocally committed to ***withdraw all §§ 102 and 103 invalidity defenses entirely*** if this IPR is instituted.

EX1041. Given Petitioner’s broad, categorical stipulation covering all §§ 102 and 103 invalidity grounds, this factor strongly weighs against discretionary denial.

Patent Owner’s arguments regarding adding Guangdong OPPO Mobile Telecommunications Corp., Ltd. (“OPPO”) as a party in *Pantech II* are completely baseless and purely speculative. DD Req. 9. Petitioner does not seek to add OPPO as a party. Indeed, no pleading in *Pantech II* seeks to add OPPO, and Patent Owner provides no evidence to the contrary. Tellingly, Patent Owner also did not name OPPO as a party in its recently filed *Pantech III* and ITC complaint. EX1048.

3. Factor 6: The strong merits of the Petition weigh against discretionary denial

As explained above in Section II.D, the strong merits of the Petition weigh heavily against discretionary denial. In analyzing this factor, Patent Owner does not dispute the strength of the merits. DD Req. 10.

Instead, Patent Owner asserts that “[t]he district court is fully capable of resolving all issues, and there is no compelling public interest that would justify institution in this case.” *Id.* However, as discussed above, it is unrealistic, and indeed impossible due to the district court claim narrowing order, to fully litigate the invalidity issues in *Pantech II* given the complexity and number of asserted patents, and there is a compelling economic interest in reviewing defective patent claims

asserted by an NPE against manufacturers. *See* Sections II.B, II.C.

4. Factor 1: Petitioner intends to request a stay, which is very likely to be granted

Because no stay has been requested in view of the filing of this Petition or granted currently, this factor is neutral. The district court’s practice of denying any motion to stay *prior to* the petition for IPR being granted renders this factor neutral. DD Req. 4 (noting court’s practice of denying pre-institution requests for stay). However, Petitioner intends to seek a stay after institution is granted, and the district court has previously granted stays in similar circumstances. *See, e.g., Papst Licensing GMBH & Co. v. Apple, Inc.*, 2017 U.S. Dist. LEXIS 223280, *1-16 (E.D. Tex. June 16, 2017); *Resonant Sys., Inc. v. Samsung Elecs. Co., Ltd.*, 2024 U.S. Dist. LEXIS 41002 (E.D. Tex. March 8, 2024).

Moreover, Petitioner also intends to seek a stay of *Pantech II* based on Patent Owner’s recent filing of the ITC complaint and *Pantech III*. Given the overlap of issues and the presence of two patents from the same family as those asserted in *Pantech II* (*compare generally* EX1048 *with* EX1009), such a stay must be granted. *See, e.g.,* 28 U.S.C. § 1659(a) (“the district court *shall* stay, until the determination of the Commission becomes final, proceedings in the civil action with respect to any claim that involves the same issues involved in the proceeding before the Commission”); *Vicor Corp. v. FII USA Inc.*, 132 F.4th 1, 7 (1st Cir. 2025) (holding “the phrase ‘the same issues’ means what it says and applies whenever a district

court proceeding shares issues with an ITC proceeding”) (citation omitted).

Patent Owner’s accusation that Petitioner engaged in “dilatory tactics” lacks merit and is premised on purely attorney argument. DD Req. 4–5. The parties mutually agreed to stay *Pantech II* pending resolution of Patent Owner’s standing, which the court ultimately decided in Patent Owner’s favor in a “close” decision. *Pantech I*, 2024 LEXIS 242332, *9 (E.D. Tex. August 14, 2024). Petitioner’s disagreement about lifting the stay—given that the decision is pending on appeal—was reasonable and intended to conserve judicial resources. *See Pantech Corp. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, Appeal No. 2025-1628 (Fed. Cir. 2025). This also supports the likelihood of a stay in *Pantech II* after institution here.

5. Factor 5: The parties are not identical

Factor 5 is whether the petitioner and the defendant in the parallel proceeding are the same party. Here, the parties are not identical. OPPO is identified as a real party-in-interest (“RPI”) in this IPR, but is not a party to *Pantech II*.

6. Factor 3: The Most Burdensome Work Remains in the Parallel Proceeding, and Petitioner diligently filed the instant Petition

Because *Pantech II* was stayed for over three months soon after its inception, the investment has been minimal. By the anticipated date of an institution decision (by November 19, 2025), no dispositive or pretrial motions will have been filed. *See* EX2004. Although fact and expert discovery will have closed, that alone does not

reflect significant investment—particularly where (i) fact discovery does not involve substantive rulings on the patents-in-suit, (ii) Patent Owner’s discovery responses largely duplicate those from the earlier *Pantech I* case, and (iii) dispositive motions and pre-trial briefing will not have been filed. *See Cywee Grp. Ltd. v. Samsung Elecs. Co.*, 2019 WL 11023976, at *6 (E.D.Tex. Feb. 14, 2019) (“[T]he most burdensome parts of the case—filing and responding to pretrial motions, preparing for trial, going through the trial process, and engaging in post-trial motions practice—all lie in the future[.]”)

Further, Patent Owner’s claim that Petitioner “waited until the last minute” to file this IPR is meritless. DD Req. 6. Petitioner filed the instant Petition on April 24, 2025—about a month before the statutory deadline⁹ and before receiving any response from Patent Owner to Petitioner’s invalidity contentions in the district court. *See Snap Inc. v. SRK Tech.*, IPR2020-00820, Paper 15 at 12-13 (PTAB October 21, 2020) (precedential) (finding the petitioner’s conduct neutral because

⁹ Petitioner waived service and Patent Owner filed that waiver on May 20, 2024. Accordingly, the statutory bar date is May 20, 2025. *See Motorola Mobility LLC v. Patent of Michael Arnouse*, IPR2013-00010, Paper 20 at 6 (PTAB January 30, 2013) (informative) (“in the situation where the petitioner waives service of a summons, the one-year time period begins on the date on which such a waiver is filed”).

the petition “was not filed in close proximity to any response by Patent Owner to the invalidity contentions”). This timing was particularly reasonable given that *Pantech II* was stayed for months shortly after it began.

III. PATENT OWNER’S CONDUCT IN RELATED LITIGATION, NEGOTIATIONS, AND THIS PROCEEDING WEIGHS AGAINST DISCRETIONARY DENIAL

Patent Owner distorts and mischaracterizes the parties’ prior litigation in *Pantech I*, notably without citing the actual record. A full review of that case shows that both the district court and the jury found Patent Owner engaged in improper conduct, violating its FRAND obligations. Patent Owner’s pattern of litigation and licensing misconduct—along with its continued gamesmanship in this IPR—weighs against discretionary denial and supports institution.

A. Patent Owner’s Allegations of “Bad Faith” Are Baseless and Ignore Its Own Misconduct

Patent Owner’s allegations of Petitioner’s “bad faith” are unfounded and overlook its own conduct. DD Req. 18-19.¹⁰ Beginning in July 2021, Patent Owner demanded that Petitioner engage in negotiations for a license to a patent portfolio including over 1,400 patents. Patent Owner has never offered Petitioner a license to

¹⁰ Patent Owner’s entire argument about Petitioner’s supposed bad faith and Patent Owner’s alleged license offers based on FRAND terms is based solely on attorney argument without any supporting documentation. DD Req. 18-19.

the '573 Patent by itself. Petitioner neither needs nor wants a license for the entire portfolio.

Patent Owner's portfolio includes numerous patents it claims are standards-essential patents (SEPs), which must be licensed on FRAND terms. *TCL Commc'n Tech. Holdings Ltd. v. Telefonaktiebolaget LM Ericsson*, 943 F.3d 1360, 1364 (Fed. Cir. 2019). Petitioner, for its part, responded to Patent Owner's licensing demands by requesting details regarding Patent Owner's infringement allegations and raising concern that Patent Owner's offered rate was not FRAND. Rather than ignoring Patent Owner, Petitioner showed its commitment to complete the task of identifying the patents in Patent Owner's portfolio, which were truly SEPs¹¹ and would be licensed at a FRAND rate. But Patent Owner abandoned negotiations and chose to litigate on a small subset of patents.

In fact, the record in *Pantech I* confirms that Petitioner has consistently negotiated licenses in good faith. Petitioner has entered into licensing agreements with more than a dozen other companies—including NPEs like Patent Owner.

B. Patent Owner's Litigation Misconduct Incited the Bias of the First Jury and Required a Second Trial

Patent Owner's invocation of "the equities of the parties' conduct" (DD Req.

¹¹ As explained in §II.C, the vast majority of patents declared SEP by their owners are not in fact essential. EX1049.

13) and its self-serving contentions that it engaged in “good-faith efforts” (*id.*) ignore its misconduct during *Pantech I*. Following the trial in that case, the district court found that the Patent Owner’s conduct before the jury was so prejudicial that a retrial on damages was required. *Pantech I*, 2024 LEXIS 242332, *37–44 (E.D. Tex. August 14, 2024) (finding, *inter alia*, that “[m]ost prejudicial are Pantech’s excessive questions about litigation in the United Kingdom and Germany and Pantech’s closing arguments that suggested to the jury that they should increase the damages to punish OnePlus for its holdout behavior” and that “Pantech also inappropriately leveraged this prejudicial evidence during its closing arguments to seek punitive damages.”). This same misconduct infected the jury’s findings as to infringement, willfulness, and invalidity—findings that are currently the subject of an appeal. *See Pantech Corp. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, Appeal No. 2025-1629 (Fed. Cir. 2025).

Patent Owner relies upon a finding of willful infringement by the first jury to paint Petitioner in a bad light. However, that verdict was clouded by bias and prejudice, and the district court declined to enhance damages. EX1052 at 2; EX1053 at 15 (“the infringement period was not long, and the accused products used on the off-the-shelf components and publicly available code, and Defendant’s pre- and post-trial behavior as to the SEPs was tied closely to its reasonable belief that Plaintiffs’ offer was not FRAND”).

C. The Jury Verdict Demonstrates Patent Owner’s Licensing Demands Constituted “Holdup”

Indeed, the unreasonableness of Patent Owners’ licensing demands is evident in view of the recent jury verdict in *Pantech I*, awarding Patent Owner only a fraction of that amount, which is less than what Patent Owner requested the jury to award. *See* EX1053. The second jury’s findings in *Pantech I* illustrate Patent Owner’s failure to comply with its own FRAND obligations, i.e., its own holdup conduct, which weighs against its equity-focused argument for discretionary denial. *See Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 814 (1945) (“he who comes into equity must come with clean hands”) (internal citations and quotation marks omitted).

D. Patent Owner’s Conduct in this Proceeding Should Not Be Rewarded

Patent Owner has also repeatedly engaged in procedural gamesmanship throughout this IPR proceeding.

Patent Owner repeatedly delayed filing its Mandatory Notices in nearly all eight IPR proceedings against the patents asserted in *Pantech II*—ignoring the 21-day deadline set by 37 C.F.R. § 42.8(a)(2), despite multiple reminders from Petitioner. *See e.g.*, IPR2025-00637 (27 days), IPR2025-00783 (25 days), IPR2025-00887 (22 days), IPR2025-00888 (22 days), IPR2025-00720 (22 days), and IPR2025-00756 (22 days). In the ’763 IPR, Patent Owner has still failed to file its

Mandatory Notice yet—more than three months after service of the petition on May 14, 2025.

In addition, Patent Owner’s discretionary denial request contains clear misrepresentations. For example, Patent Owner contends that, in *Pantech I*, “the court denied Petitioner’s motions for judgment as a matter of law.” DD Req. 13. In reality, the district court in *Pantech I* **granted** judgment of a matter of law of non-infringement for one of the patents Patent Owner raised at trial, finding that Patent Owner failed to meet its burden. *Pantech I*, 2024 LEXIS 242332, *13-18 (E.D. Tex. August 14, 2024). In alleging Petitioner’s “refusal to negotiate in good faith and its holdout tactics,” Patent Owner claims that “Petitioner’s conduct has already been found to be unjust.” DD Req. 13-14. This is untrue. As noted above, the district court found that Petitioner actions were supported by its reasonable belief that Patent Owner was not making a FRAND offer.

Patent Owner also takes internally inconsistent positions in its discretionary denial request. For example, it argues that *Fintiv* Factor 5 supports discretionary denial because Petitioner is the same party as the defendant in the district court litigation, DD Req. 10, while also arguing (without any support), that Petitioner’s stipulation does not eliminate overlap of issues because it does not bind Guangdong OPPO Mobile Telecommunications Corp., Ltd., *id.*, 9.

Such repeated gamesmanship by Patent Owner in this proceeding should not

be rewarded with discretionary denial of institution.

IV. CONCLUSION

For the above reasons, Petitioner respectfully requests that the Director refrain from exercising discretion to deny this Petition, and instead pass it to a merits panel for consideration.

Dated: August 19, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT UNDER 37 CFR §42.24

Pursuant to 37 C.F.R. § 42.24 and the Interim Process for PTAB Workload Management, the undersigned hereby certifies that the word count for the foregoing Petitioner's Opposition to Patent Owner's Request for Discretionary Denial totals 8,050. Accordingly, this Opposition is under the limit of 14,000 words.

This word count was calculated by using the built-in word-count tool in the word-processing system used to prepare this document.

Dated: August 19, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing
**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL** and supporting materials (Exhibits 1042 - 1053)
have been served this 19th day of August, 2025, by electronic mail to the attorneys
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