UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ONEPLUS TECHNOLOGY (SHENZHEN) CO., LTD.,
Petitioners,

v.

PANTECH CORPORATION,
Patent Owner

_____

Case: IPR2025-00762

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

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PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION PURSUANT TO 37 C.F.R. § 42.123(a)

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Second Amended Docket Control Order, *Pantech Corporation and Pantech Wireless, LLC v. OnePlus Technology (Shenzhen) Co., Ltd.*, No. 5:24-CV-00038-RWS-JBB (E.D. Tex.) (Dkt. 58) (May 13, 2025)
2002	United States District Courts – National Judicial Caseload Profile
2003	Pantech Corporation's July 9, 2021 Notice Letter to OnePlus Technology Co., Ltd.
2004	Third Amended Docket Control Order, *Pantech Corporation and Pantech Wireless, LLC v. OnePlus Technology (Shenzhen) Co., Ltd.*, No. 5:24-CV-00038-RWS-JBB (E.D. Tex.) (Dkt. 86) (July 17, 2025)
2005	Order Modifying Dates in Docket Control Order, *Pantech Corporation and Pantech Wireless, LLC v. OnePlus Technology (Shenzhen) Co., Ltd.*, No. 5:24-CV-00038-RWS-JBB (E.D. Tex.) (Dkt. 85) (July 17, 2025)
2006	Jury Verdict, *Pantech Corp. v. OnePlus Technology (Shenzhen) Co., Ltd.*, No. 5:22-cv-00069-RWS (E.D. Tex.) (Dkt. 259) (April 1, 2024)
2007	Final Judgment, *Pantech Corp. v. OnePlus Technology (Shenzhen) Co., Ltd.*, No. 5:22-cv-00069-RWS (E.D. Tex.) (Dkt. 499) (Jan. 23, 2025)
2008	Kiri Gupta & Urska Petrovcic, *Evidence of Systematic "Patent Holdout"*, 38 Berkeley Tech. L. J. (2023)
2009	Richard A. Epstein & Kayvan B. Noroozi, *Why Incentives for "Patent Holdout" Threaten to Dismantle FRAND, and Why It Matters*, 32 Berkeley Tech. L.J. 1381 (2017)
2010	Kalyan Dasgupta & David J. Teece, *Protecting Innovation in the Mobile Wireless Ecosystem: Understanding & Addressing "Hold-Out"*, 38 Berkeley Tech. L.J. 313 (2023)
2011	Claim Construction Order from *Pantech Corp. et al. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, No. 5:24-cv-00038-RWS-JBB (E.D. Tex.)

I. INTRODUCTION

Patent Owner Pantech Corporation ("Pantech") respectfully requests that United States Patent and Trademark Office ("USPTO" or the "Office") Patent Trial and Appeal Board ("PTAB" or the "Board") deny Petitioner OnePlus Technology (Shenzhen) Co., Ltd.'s ("Petitioner" or "OnePlus") Motion to Submit Supplemental Information Pursuant to 37 C.F.R. § 42.123(a) (Paper 13). The supplemental evidence sought to be added to this proceeding by Petitioner would materially change the scope of Ground 3, and thus exceeds the permitted scope of supplemental evidence permitted under 37 C.F.R. § 42.123(a).

II. LEGAL STANDARD FOR SUPPLEMENTAL INFORMATION IN AN *INTER PARTES* REVIEW PROCEEDING

Section 42.123(a) of Title 7 of the Code of Federal Regulations sets forth two threshold requirements for the submission of supplemental information in an *inter partes* review proceeding: first, the "request for the authorization to file a motion to submit supplemental information [must be] made within one month of the date the trial is instituted," and second, "[t]he supplemental information must be relevant to a claim for which the trial has been instituted." 37 CFR § 42.123(a).

But these are not the only requirements for the submission of supplemental information. As the Federal Circuit has recognized, "[n]othing within subsection (a) [of 37 CFR § 42.123] excludes application of other PTAB regulations." *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 443-48 (Fed. Cir. 2015)

("This provision does not offer a routine avenue for bolstering deficiencies in a petition raised by a patent owner in a Preliminary Response"). The Board has further limited the admission of supplemental information by setting forth that "[t]he opportunity to submit additional evidence does not allow a petitioner to completely reopen the record, by, for example, changing theories after filing a petition." *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 15 (PTAB Dec. 20, 2019) (precedential).

III. THE PROVISIONAL APPLICATIONS SOUGHT TO BE ADDED WOULD MATERIALLY CHANGE THE SCOPE OF THE GROUNDS IN THE PETITION

A. The Petition Did Not Mention the Provisional Applications Now Sought to be Added to the Record

"In an IPR, the petitioner has the burden from the onset to show ***with particularity*** why the patent it challenges is unpatentable." *Harmonic Inc. v. Avid Tech.*, Inc., 815 F.3d 1356, 1363 (Fed. Cir. 2016) (emphasis added) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify "with particularity… the evidence that supports the grounds for the challenge to each claim")); *see also Intelligent Wellhead Systems Inc. v. Downing Wellhead Equipment, LLC*, IPR2024-00256, Paper 11 at 10-12 (PTAB June 5, 2024) (agreeing that a petition must show that a reference is entitled to a priority claim, and noting its prior denial of a request to "cure this deficiency"). This requirement includes a burden on the Petitioner "to show that the subject matter that [it] relies on in [a reference] is also found in the

[reference's provisional application]." *Forescout Tech., Inc., v. Fortinet, Inc.*, IPR2021-01328, Paper 12 at 9-10 (PTAB Jan. 27, 2022).

Here, the only ground identified "with particularity" by the Petition with regard to Deenoo is merely that Deenoo "is prior art under at least 35 U.S.C. §102(a)(2)." Paper 2 at 1. Any priority claim by Deenoo is not discussed further, and ***Deenoo's provisional applications are never mentioned***. And while the Petition also does not cite with particularity to its supporting declaration of Dr. Lo for any priority argument,[1] even Dr. Lo does not mention either provisional applications referenced by Deenoo—he only sets forth a conclusory (and incorrect) recitation of the "filing date" of the application itself. *See generally*, EX1003 at ¶ 203.

Thus, instituted Ground 3 (obviousness over Deenoo and Sammour) at most relies ***only*** on Deenoo's PCT filing date as its basis for prior art status—which is, as the Institution Decision notes, January 17, 2014. *See* Paper 10 at 20-23 (both noting and correcting a typographic error). The Institution Decision also correctly notes

[1] Without a detailed citation and allegation in the Petition, Dr. Lo's declaration is irrelevant. *See* 37 C.F.R. § 42.6(a)(3); *Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 at (PTAB Aug. 29, 2014) (precedential) (the "practice of citing the Declaration to support conclusory statements that are not otherwise supported in the Petition [] amounts to incorporation by reference").

that, regarding the provisional applications that Petitioner now seeks in its Motion to add, "Petitioner does not appear to be relying on those provisional applications." *Id.* at 22. Finally, the Institution Decision took care to note that it was not issuing a "preliminary determination of the prior art status of Deenoo." *Id.* at 23.

B. Petitioner Improperly Seeks to Modify Ground 3

Petitioner is now attempting to modify Ground 3 to present a new theory of an effective filing date of Deenoo earlier than previously set forth, and seeks to rely on new evidence and attorney argument not presented in the Petition in order to do so. This attempt is improper and should be rejected.

Arguing that Deenoo is entitled to an effective filing date earlier than its PCT application is found nowhere in the Petition, and Petitioner's new arguments impermissibly change the nature of Ground 3 by changing its contentions about Deenoo's effective filing date. *See Hulu*, Paper 29 at 15 (supplemental information may not "chang[e] theories after filing a petition").

Indeed, Petitioner's attempt is similar to the attempt rejected by the Board in *Microsoft Corporation v. ThroughPuter, Inc.*, IPR2023-00852, Paper 15 at 3-9 (PTAB Oct. 11, 2023). There, as here, the Petition's only allegation of prior art status was short, conclusory, and devoid of reference to the theory for which supplemental information would be relevant: "the Petition merely included a single footnote—with citations to testimony that does not address public accessibility—in support of

Petitioner's assertion that Tuan qualifies as prior art to the '948 patent." *Id.* at 4-5. The Board denied Petitioner's attempt to add evidence related to a specific theory of public accessibility that was absent in the petition. *Id.* at 4-9 (following *Hulu* and noting that "[w]e find this situation to be more aligned with a wholly new approach by Petitioner than with merely 'respond[ing]' to Patent Owner's arguments by elaborating on existing arguments and evidence").

The present circumstances are not an instance of a Petitioner seeking merely to add "further evidence" in support of an existing theory, as Petitioner has represented. *See generally*, Paper 13 at 1, 4-5, 13-15. It would be one thing if the Petition had set forth a theory based on the priority applications and was seeking to introduce those priority applications as evidence to bolster that theory, or had set forth a theory of public availability and was adding evidence in support of that theory. But this is not what Petitioner is seeking to do—the Petition did not even ***mention*** any provisional applications or allege any possible priority claim to them.

Seemingly in an attempt to downplay the effects upon the scope of Ground 3 by its proposed introduction of these provisional applications, Petitioner's Motion

sets forth conclusory attorney argument without expert support[2] that the Petition's cited portions of Deenoo that do not have direct counterparts in the provisional applications are nonetheless "supported" by the provisional applications. *See* Paper 13 at 13-15. But Petitioner's conclusory arguments are unavailing. For example, it is entirely unclear why Figure 8 and paragraph 211 of Deenoo find sufficient support in paragraph 128 of the provisional application, and Petitioner's conclusory statement (*see id.* at 15) does not make it so:

[2] This lack of expert support is especially notably in view of the Board's recommendation that any motion to submit supplemental information include testimonial evidence (Paper 10 at 23, n. 7)—which also indicates that the evidence sought to be introduced would ultimately be unavailing to meet Petitioner's burden of proof.

Paragraph 211 of Deenoo	Paragraph 128 of Provisional Applications
[0211] FIG. **8** illustrates an example representation of the aforementioned sequence that captures the triggers for status check and the actions related to reordering timer. One or more embodiments contemplate techniques for PDCP re-ordering that may include starting a reordering timer, for example perhaps when an out of sequence packet may be received from any one of RLC entities. Techniques may also include marking the missing sequence number. A status check procedure may be performed, for example perhaps when a new (e.g. fresh or updated) packet may be received from another RLC entity. The status check may include matching the marked sequence number with sequence number in the new packet, perhaps in some embodiments when the new packet sequence may be greater than the marked sequence number. A PDCP status report may be transmitted, for example to trigger retransmission, perhaps in some embodiments if the time to expiry for the reordering timer may be more than a configured report threshold. One or more, or all, queued PDUs and/or advancing the PDCP receive window and/or canceling the re-ordering timer may be done, for example perhaps if the time to expiry for the reordering timer may be less than a configured report threshold.	**[0128]** In some embodiments, perhaps in a case of a PDCP in macro (single DRB), the following sequence may be specified to support reconfiguration: UE PDCP RECEIVER OPERATION: Normal case: re-ordering algorithm: 0) Receive the PDCP data PDU from lower layers 1) Let the next in-sequence PDU SN be N. 2) If it is duplicate or PDU out of re-ordering window. Discard the packet and go to step 0. 3) If received PDCP Data PDU SN == N goto step 7. 4) If re-ordering timer is not running, start the PDCP re-ordering timer as soon as out of sequence PDCP Data PDU SN > N (from say RLC1/RLC2) is received. 5) When the re-ordering timer is running, if PDCP Data PDU (from say RLC2/RLC1 respectively) is received with SN > N, then a. If the remaining re-ordering time is greater than threshold, trigger a PDCP status report and wait for in-sequence PDCP PDU with SN=N. goto step 0. b. Stop re-ordering timer and perform same actions as re-ordering timer expiry. 6) If the re-ordering timer expires goto 7. 7) Deliver the queued packets to the higher layer, starting from closest received SN to N in order until the next SN gap and if there is any SN gap, start re-ordering timer similar to step 4. 8) Set N = 1+ SN of PDCP data PDU last delivered to higher layer in step 7. 9) Goto step 0.

This is particularly the case where "flush[ing] PDUs," as found in Figure 8, is not in paragraph 128. Likewise, Petitioner's barebones conclusion that Paragraph 251 of Deenoo somehow finds support in "at least Figure 10 of each provisional application and paragraph 148 of the '867 Provisional App and paragraph 163 of the '233 Provisional App." is unsupported. Paragraph 251 of Deenoo does not claim identity with Figure 12 (with corresponds to Figure 10 in both provisional applications), and the portion of Paragraph 251 of Deenoo that is actually relied upon by the Petition ("an RRC reconfiguration message 'may include a timing advance to be applied to the small cell, radio bearer configuration for the small cell, offset to the sub frame containing resource allocation, and/or a response window'" (*see* Paper 2 at 45)) is found nowhere in either Figure 10 the provisional applications or paragraph 148 of

the ’867 Provisional App or paragraph 163 of the ’233 Provisional App. In short, the introduction of these proposed exhibits ***would*** meaningfully change the scope of the issues to be assessed by the Board with respect to Ground 3, and this alone is reason to deny Petitioner’s Motion. *See Hulu*, Paper 29 at 15.

Ultimately, the prior art status of Deenoo should be contested for Ground 3 based on the only theory that is actually in the Petition. Deenoo has an effective filing date of January 17, 2014, and thus (1) may be prior art to the ’573 Patent if the ’573 Patent is not entitled to its own priority claim to Korean Patent Application No. KR-10-2013-0053408, filed on May 10, 2013, but (2) will not be prior art to the ’573 Patent if the ’573 Patent is entitled to this priority claim. Thus ***the priority claim of the ’573 Patent*** is the only relevant dispute for the prior art status of Deenoo for Ground 3 in this proceeding, not Petitioner’s newly introduced end-run around Patent Owner’s defense to show an earlier effective filing date of Deenoo. *See Redline*, 811 F.3d at 448 (the opportunity to submit supplemental information “does not offer a routine avenue for bolstering deficiencies in a petition raised by a patent owner in a Preliminary Response”).

C. The Board Has Not Indicated that Supplemental Information Will Be Admitted

Petitioner’s anticipated Reply may conceivably argue that the Board’s footnote 7 indicates that supplemental evidence will be admitted. Respectfully,

Patent Owner submits that this is not the case. Rather, the Board did not consider or decide one way or the other whether supplemental information would be admissible—the issue was not briefed, and the Board did not undertake a *sua sponte* analysis; rather, the Board invited the parties to brief the issue. *See* Paper 10 at 23, n. 7 ("Petitioner is encouraged to request authorization to file a motion to submit supplemental information…").

Now that the issue is briefed and the issue can be fully considered, the record before the Board should be clear: the introduction of such supplemental information is in fact an attempt to change the contours (and not just the supporting evidence) of Ground 3 and should thus be rejected. By law, a petition must identify, "in writing and with particularity… the evidence that supports the grounds for the challenge to each claim." 35 U.S.C. § 312(a)(3). Given that the provisional applications to which Deenoo claims priority were not even mentioned in the petition, it cannot be said that Ground 3 encompasses a claim that Deenoo is entitled to a priority date prior to the PCT filing date.

Because Ground 3 does not encompass a claim that Deenoo is entitled to a priority date prior to the PCT filing date, the supplemental evidence that Petitioner seeks to now add is either irrelevant (thus violating 37 C.F.R. § 42.123(a)(2)) or else modifies the underlying theory of Ground 3 (thus violating the requirement that supplemental information not "chang[e] theories after filing a petition" (*Hulu*, Paper

29 at 15)). In either case, Petitioner's Motion should be denied.

IV. CONCLUSION

For at least the foregoing reasons, the Board should deny Petitioner's Motion to Submit Supplemental Information.

Dated: December 8, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 8th day of December, 2025, a copy of the attached **PATENT OWNER'S PRELIMINARY RESPONSE** was served by electronic mail to the attorneys of record, at the following addresses:

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Respectfully submitted,

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