

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION and LENOVO (UNITED STATES) INC.,
Petitioners

v.

USTA TECHNOLOGY, LLC.,
Patent Owner

Case IPR2025-00838
Patent No. RE47,720

PATENT OWNER'S DISCRETIONARY DENIAL BRIEFING

Under 35 U.S.C. § 314(a)

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2002	First Amended Complaint for Patent Infringement, Dkt. 19 in <i>USTA Technology, LLC. v. Lenovo Group Limited, et al.</i> , No. 4:24-cv-00515 (E.D. Tex. June 7, 2024)
2003	Second Amended Complaint for Patent Infringement, Dkt. 34 in <i>USTA Technology, LLC. v. Lenovo Group Limited, et al.</i> , No. 4:24-cv-00515 (E.D. Tex. June 7, 2024)
2004	Lenovo (United States), Inc. and Lenovo Global Technology (United States) Inc.'s Motion to Dismiss for Improper Venue or, in the Alternative, To Transfer Venue, Dkt. 21 in <i>USTA Technology, LLC. v. Lenovo Group Limited, et al.</i> , No. 4:24-cv-00515 (E.D. Tex. June 7, 2024)
2005	Defendant Lenovo Group Limited's Motion to Dismiss and Strike Plaintiff USTA Technology, LLC's Second Amended Complaint, Dkt. 43 in <i>USTA Technology, LLC. v. Lenovo Group Limited, et al.</i> , No. 4:24-cv-00515 (E.D. Tex. June 7, 2024)
2006	USTA Technology, LLC's Unopposed Motion for Jurisdictional Discovery and to Extend the Time to Response to Lenovo Group Limited's Motion to Dismiss and Strike the Second Amended Complaint, Dkt. 57 in <i>USTA Technology, LLC. v. Lenovo Group Limited, et al.</i> , No. 4:24-cv-00515 (E.D. Tex. June 7, 2024)
2007	Order on Jurisdictional Discovery, Dkt. 58 in <i>USTA Technology, LLC. v. Lenovo Group Limited, et al.</i> , No. 4:24-cv-00515 (E.D. Tex. June 7, 2024)
2008	Joint Rule 26(f) Conference Report, Dkt. 49 in <i>USTA Technology, LLC. v. Lenovo Group Limited, et al.</i> , No. 4:24-cv-00515 (E.D. Tex. June 7, 2024)
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2013	Lenovo Group Limited's Notice of <i>Sotera</i> Stipulations for U.S. Patent No. RE47,720, Dkt. 60 in <i>USTA Technology, LLC. v. Lenovo Group Limited, et al.</i> , No. 4:24-cv-00515 (E.D. Tex. June 7, 2024)
2014	Appeal Statistics by Patent Trial and Appeal Board, dated April 30, 2025
2015	Order granting Ex Parte Reexamination of U.S. Patent RE47,720 in Reexam App. No. 90/019,702, dated December 5, 2024
2016	Burchfiel Oral History, recorded June 5, 2009
2017	Notice of References Cited, accompanying a Non-Final Rejection of U.S. Patent App. 12/059,682, dated January 27, 2011
2018	Office Action in <i>Ex Parte</i> Reexamination, Reexam App. No. 90/019,702, dated March 31, 2025
2019	Order setting briefing schedule for jurisdictional discovery, Dkt. 64 in <i>USTA Technology, LLC. v. Lenovo Group Limited, et al.</i> , No. 4:24-cv-00515 (E.D. Tex. June 7, 2024)
2020	Information Disclosure Statement, filed during prosecution of U.S. Patent App. 13/553,417, dated August 2, 2012
2021	Non-Final Rejection of U.S. Patent App. 13/553,417, dated February 22, 2013
2022	Final Rejection of U.S. Patent App. 13/553,417, dated August 26, 2013
2023	Non-Final Rejection of U.S. Patent App. 11/847,502, dated June 28, 2010
2024	Information Disclosure Statement, filed during prosecution of U.S. Patent App. 13/495,516, dated April 22, 2013
2025	Email from counsel for Intel to counsel for Patent Owner, dated January 23, 2023
2026	Response to Office Action in <i>Ex Parte</i> Reexamination of Reexam App. No. 90/019,702, and accompanying documents, dated June 2, 2025
2027	Notice of Intent to Issue a Reexam Certificate, and accompanying documents, dated July 15, 2025

2028	Time to Trial, <i>Median Time-to-Trial Statistics for the Eastern District of Texas, Jan. 1, 2020-July 28, 2025</i> , DOCKET NAVIGATOR, https://search.docketnavigator.com/patent/binder/0/0 (last visited July 28, 2025) (from homepage, click “Time to Trial” under “Timing Analysis”)
2029	<i>Intel Based Laptops</i> , LENOVO, https://www.lenovo.com/us/en/faqs/intel/best-intel-processor-laptops/?orgRef=https%253A%252F%252Fwww.google.com%252F (last visited July 29, 2025)

I. INTRODUCTION

Patent Owner USTA Technology, LLC (“USTA” or “Patent Owner”) respectfully requests that the Director exercise discretion under 35 U.S.C. § 314(a) to deny Petitioners Intel Corporation (“Intel”) and Lenovo (United States) Inc.’s (collectively, “Petitioners”) Petition for *inter partes* review of U.S. Patent No. RE47,720 (“the ’720 patent”).¹ As of December 20, 2024, only real party in interest Lenovo Group Limited (“LGL”) is a party to the parallel district court litigation. (See Exs. 2001, 2002.) For ease of reference, unless otherwise indicated, Patent Owner refers to Petitioner and the identified real parties in interest singularly and collectively as “Lenovo” for purposes of this Discretionary Denial brief only. Likewise, for purposes of this proceeding, the interests of Lenovo and LGL are also fully aligned with (former) joint defendants, so they are functionally the same party for the purposes of this Petition.

Pursuant to Acting Director Stewart’s March 26, 2025, Memorandum titled “Interim Processes for PTAB Workload Management” (the “PTAB Workload

¹ Motorola Mobility LLC and Lenovo Group Limited are named as real parties in interest.

Management Memo”)², this brief is limited in scope to Patent Owner’s bases for discretionary denial.³ As discussed below, a holistic assessment of factors bearing on the Director’s discretion strongly supports denying the Petition.

II. LEGAL STANDARDS

² <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>, accessed on July 16, 2025.

³ In accordance with the Patent Trial and Appeal Board’s (“PTAB”) FAQs for Interim Processes for PTAB Workload Management (“PTAB Interim Workload FAQs”), Patent Owner does “not repeat [its] merits arguments verbatim” in this brief and instead “briefly explain[s] why the merits are relevant [herein].” See <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>, FAQ 12, accessed on July 16, 2025. Patent Owner will separately file a Preliminary Response addressing the merits of the Petition pursuant to 37 C.F.R. § 42.107(a) on the schedule set forth by regulation and consistent with the PTAB Workload Management Memo. See 37 C.F.R. § 42.107(b). In accordance with the PTAB Interim Workload FAQs, Patent Owner requests that the Director “consider the merits in the [forthcoming] merits briefing” (i.e., Patent Owner’s Preliminary Response) as part of the discretionary denial analysis. See *PTAB Interim Workload FAQs*, FAQ 12.

The Director has discretion to deny institution under 35 U.S.C. § 314(a). *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 136 S. Ct. 2131, 2140 (2016). In determining whether to deny institution, the USPTO considers the presence and status of parallel proceedings involving the same patent, such as district court litigation. *See NHK Spring Co. Ltd. v. Intrix-Plex Techs. Inc.*, IPR2018-00752, Paper 8 at 20 (P.T.A.B. Sept. 12, 2018) (precedential); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 17 (P.T.A.B. May 13, 2020) (precedential) (hereinafter “*Fintiv*”); *see also Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (P.T.A.B. Sept. 6, 2017) (“[W]e recognize that an objective of the AIA is to provide an effective and efficient alternative to district court litigation”).

The PTAB Workload Management Memo enumerated a number of additional considerations for discretionary denial, including:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;

- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director’s discretion.

PTAB Workload Management Memo, 2-3.

Fintiv “sets forth factors that balance considerations of system efficiency, fairness, and patent quality when a patent owner raises an argument for discretionary denial due to the advanced state of a parallel proceeding.” *Fintiv*, Paper 15 at 7-8. The factors the Board considers in determining whether to exercise its discretion are: (1) whether the court granted a stay or evidence exists that a stay may be granted; (2) proximity of the court’s trial date to the Board’s projected deadline for a FWD; (3) investment in the parallel proceeding by the court and parties; (4) overlap between issues raised in the petition and the parallel proceeding; (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and (6) other considerations that impact the Board’s discretion, including the merits. *Fintiv*, IPR2020-00019, Paper 15 at 7-8.

III. BACKGROUND ON PARALLEL DISTRICT COURT LITIGATION

Patent Owner filed its Complaint (Ex. 2001) against Lenovo on June 7, 2024, in the Eastern District of Texas, a First Amended Complaint (“FAC”) (Ex. 2002) on October 7, 2024, and a Second Amended Complaint (“SAC”) on December 20, 2024

(Ex. 2003). The Complaint was originally directed at Petitioner Lenovo (United States) Inc., LGL, and Lenovo Global Technology (United States) Inc.⁴. The SAC is currently the live complaint with LGL as the only remaining defendant. The case is captioned *USTA Tech., LLC v. Lenovo Group Limited et al.*, No. 4:24-cv-00515-SDJ (E.D. Tex. June 7, 2024) [hereinafter “the Lenovo case” or “the parallel litigation”].

Patent Owner has also filed related lawsuits in the Eastern District of Texas against other defendants, which are currently active:

- *USTA Tech., LLC v. AT&T Mobility LLC et al.*, No. 4:24-cv-00513-SDJ (E.D. Tex. June 7, 2024) [hereinafter “the AT&T case”]; and
- *USTA Tech., LLC v. AsusTek Comp. Inc. et al.*, No. 4:24-cv-00512-SDJ (E.D. Tex. June 7, 2024) [hereinafter “the AsusTek case”].

In those lawsuits, the parties are set to have a Final Pretrial Conference on November 18, 2026, with trial to follow shortly thereafter, **before** the projected date of the FWD in this proceeding. (Exs. 2011 (the AT&T case schedule), 2012 (the AsusTek case schedule).)

Note that currently the Lenovo case is lagging behind the AT&T case and the

⁴ Though Lenovo Global Technology (United States) Inc. was a defendant in District Court, it is curiously not named as a real party in interest in the Petition. (See Pet. at 88.)

AsusTek case due to jurisdictional discovery issues⁵ that are scheduled to culminate in final briefing on August 13, 2025. (Ex. 2019.) There is otherwise no scheduling order currently in force. However, this alone is not dispositive with respect to discretionary denial. *See, e.g., Intel Corporation v. Proxense LLC*, IPR2025-00327, Paper 12 at 2 (P.T.A.B. June 26, 2025) (Petitions discretionarily denied due to settled expectations though no trial date scheduled). Indeed, as discussed below, not only is it likely that Lenovo will coordinate its schedule with the other proceedings, but the settled expectations here overwhelm the lack of a current scheduling order.

Though the schedule of the parallel litigation is behind that of the other two cases, the '720 patent is the only patent at issue, and the only two claims thus far asserted in the parallel litigation and at issue in this Petition, claims 53 and 95, are

⁵ On November 6, 2024, Petitioner Lenovo (United States) Inc., and Lenovo Global Technology (United States) Inc. filed a Motion to Dismiss for Improper Venue or, in the Alternative, to Transfer Venue. (Ex. 2004.) The filing of the SAC mooted this motion. On March 18, 2025, LGL filed a motion to dismiss and strike the SAC. (Ex. 2004.) In response to the motion to dismiss, Patent Owner and LGL agreed to conduct jurisdictional discovery, and the Court granted the jurisdictional discovery on April 21, 2025. (See Exs. 2005, 2006, 2007.) Patent Owner's opposition is due on July 30, 2025.

also at issue in the suits against the other defendants. In fact, the cases against the other defendants include the claims at issue in this Petition plus an ***additional 71 claims***, claims 19, 22-43, 45-58, 60-93, and 95-96 in total, which Patent Owner plans to assert against Lenovo after jurisdictional briefing is complete.

Moreover, prior to the jurisdictional delay, Lenovo requested that the Court align the schedule with that of the other defendants. (Ex. 2009.) So, there is no reason to think that Lenovo will not coordinate with the other defendants for invalidity assertions against the '720 patent in the District Court. Thus, this Petition serves as ***every defendant's*** additional bite at the apple for claims 53 and 95. Though the FWD might issue prior to trial in the parallel litigation due to the jurisdictional delay, the at-issue claims of the '720 patent for this IPR, plus the additional claims at issue in District Court, would already have their invalidity resolved in the trials for the other defendants prior to or concurrently with the FWD.

Therefore, for purposes of this Discretionary Denial briefing, Patent Owner contends that the trial date of the AT&T and AsusTek cases is, for all intents and purposes, the relevant trial date at issue for the '720 patent and this IPR proceeding—as soon as practicable after the Final Pretrial Conference on November 18, 2026, before the projected date of the FWD.

IV. CONSIDERATIONS FAVORING DENIAL

A. Settled Expectations

Under the interim process, the Director can consider “[s]ettled expectations of the parties, such as the length of time the claims have been in force” when deciding whether to exercise discretion to deny institution. Interim Processes for PTAB Workload Management at 2 (Mar. 26, 2025). Here, the ’720 patent was originally issued on January 27, 2009, as U.S. Patent 7,483,711 (“the ’711 patent”)—sixteen years ago—and later reissued as the ’720 patent on November 5, 2019—nearly six years ago. Had Petitioners objected to the issuance of the ’720 patent (or the ’711 patent), they could have raised challenges years ago. 35 U.S.C. §§ 302 (permitting any person at any time to file a request for reexamination), 311 (permitting *inter partes* review 9-months or more after issuance), and 321 (permitting post-grant review challenges up to 9-months after issuance). Instead, Petitioners waited nearly eleven months after the filing of the Complaint to file its Petition, all but ensuring that the validity of the ’720 patent claims would be decided in parallel district court litigation before a FWD in this proceeding.

The length of time the claims of the ’720 patent have been in force—almost six years—and the length of time the claims of its predecessor ’711 patent were in force—over sixteen years—favor discretionary denial.

Moreover, due to the early priority date of the ’720 patent, it served as prior art to many other patent applications in the industry, including Petitioners’ own filings. Petitioner Intel was aware of the ’720 patent’s application at least as early

as August 2, 2012, and its family at least as early as January 27, 2011, based on references cited during prosecution of Intel's own patents.

For example, Intel's own US8724541B2 ("the '541 patent") cites to US20040092281A1 ("the '281 publication"), which became the '711 patent and later reissued as the '720 patent, the patent at issue. Indeed, during prosecution of application 13/553,417 ("the '417 application") that would become the '541 patent, **Intel** disclosed the '281 publication in an Information Disclosure Statement ("IDS") filed on August 2, 2012. (Ex. 2020 at 1.) The examiner even used the '281 publication to reject the claims in the first Non-Final Rejection of the '417 application on February 22, 2013. (Ex. 2021 at Page 7.) The examiner did so again in the Final Rejection dated August 26, 2013. (Ex. 2022 at Page 9.) Therefore, Petitioner Intel has been aware of the '720 patent's application and subject matter, since at least August 2, 2012, after which Intel substantively analyzed it for applicability to, and rejection of, its own patent claims.

Similarly, real party in interest Motorola Mobility LLC ("Motorola"), a wholly-owned subsidiary of Lenovo and part of the Lenovo Group, was aware of the '711 patent at least as early as June 28, 2010. Motorola's own patent application 11/847,502 ("the '502 application") was issued a Non-Final Rejection on June 28, 2010, in which the examiner used the '711 patent to reject **more than half** of the pending claims. (Ex. 2023 at Page 2 to Page 19.)

In addition, Petitioner Intel’s own US8031605B2 (“the ’605 patent”) cites to US20090312028A1 (“the ’028 publication”), which became U.S. Patent 8,041,363 (“the ’363 patent”), which is a divisional of the ’711 patent. During prosecution of application 12/059,682 (“the ’682 application”) that would become the ’605 patent, the examiner cited the ’028 publication in a Notice of References Cited accompanying a Non-Final Rejection of the ’682 application on January 27, 2011. (Ex. 2017 at 1.)

Motorola also became aware of the ’028 publication at least as early as April 22, 2013, when **Motorola** cited it in an IDS associated with its patent application 13/495,516. (Ex. 2024 at 1.)

Despite knowing of the ’720 patent’s application and its related applications for over a decade, Petitioners did nothing, creating a settled expectation between the parties. See *iRhythm, Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (P.T.A.B. June 6, 2025). In *iRhythm*, the Director found that such an expectation outweighed factors such as (1) timing of the FWD “likely” issuing before trial in the parallel district court litigation, (2) “little investment by the parties” in the parallel litigation, (3) “high likelihood of a stay” in that parallel litigation if the IPR was instituted, and (4) proper use of expert evidence under the PTAB Workload Management Memo. *Id.* at 2-3. Just as in *iRhythm*, Petitioner Intel “cited the then-pending application that issued as the challenged patent in an Information Disclosure

Statement Petitioner filed in its own patent application,” and thus Petitioner’s “awareness of Patent Owner’s applications and failure to seek early review of the patents favors denial and outweighs the above-discussed considerations.” *Id.* at 3.

Moreover, counsel for Petitioner Intel received a letter from Patent Owner offering a license to the ’720 patent, among other patents. Reception of that letter was confirmed on November 18, **2022**. Likewise, Lenovo received a similar letter on or about November 15, **2022**, and confirmed receipt on November 23, **2023**. On January 23, **2023**, counsel for Intel indicated that, due to various superficial noninfringement and invalidity positions, Intel did not believe it “needs a license” to the indicated patents. (Ex. 2025 (email from Intel counsel).) But it was not until April **2025**, two and a half years after reception of the notice letter, that Intel filed this Petition. There was a settled expectation that neither Lenovo nor Intel would be challenging the ’720 patent in this manner. This favors discretionary denial.

Finally, the ’720 patent is set to expire in August 2026, leaving the ’720 patent with only **one** remaining year of term. Given the short amount of patent term left and the decades-long delay in addressing the validity of the ’720 patent claims, there was a settled expectation that the ’720 patent would not be challenged.

By delaying over thirteen years from the date it first became aware of the precursor application to the ’720 patent, and delaying two and a half years from receiving an explicit notice letter from Patent Owner, Petitioners created an implicit

expectation between the parties, as well as an acquiescence regarding the patentability of the claims of the '720 patent. The decade-long delay in addressing the validity of the '720 patent, to the point that it expires next year, further favors exercising discretion and denying this Petition.

To the extent there is dispute regarding Petitioners' knowledge of citations during prosecution, the Director has indicated that "actual notice of a patent or of possible infringement is not necessary to create settled expectations." *AXA Power ApS v. Dabico Airport Solutions Inc.*, IPR2025-00408, Paper 21 at 3 (P.T.A.B. June, 18, 2025). Therefore, the actual notice here, both during prosecution and via notice letter here, strongly indicates a settled expectation between the parties and favors discretionary denial.

For at least the foregoing reasons, the Petition should be discretionarily denied due to settled expectations of the parties.

B. Extensive Reliance on Expert Testimony

Petitioners' extensive reliance on an expert declaration supports discretionary denial. As discussed in the PTAB Interim Workload FAQs, "[w]hile the Board may consider expert testimony, as a matter of efficiency, extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court." (FAQ 21.) Here, as noted above, the Petition relies on a 137-page expert declaration (Ex. 1003)

that is cited 138 times over the course of the Petition. (*See generally* Petition.) Yet its declarant added little (if any) value to its analysis, frequently providing conclusory statements without evidentiary support and merely repeating/rewording the contents of the legal brief verbatim. Such conclusory analysis is not helpful to the trier of fact, and Petitioners' heavy reliance on it is another reason that the Petition should be discretionarily denied.

In addition to the conclusory nature of the expert testimony, Petitioners also use the expert testimony to “fill gaps in the prior art” for their invalidity assertions. (*See, e.g.*, Pet. at 13 (“Walton does not identify any specific frequencies for its system to use, leaving that implementation detail to a POSITA. However, it would have been obvious”); at 83 (“[A] POSITA knew how to implement the same network architecture as Walton using mobile terminals.”); at 84 (“[A] POSITA would have understood to update the CSI”).) The Director has implied that such testimony is the type contemplated by FAQ 21 and that supports discretionary denial. *See iRhythm*, IPR2025-00363, Paper 10 at 2 (Though “Patent Owner argues that discretionary denial is warranted because Petitioner is over-reliant on expert testimony, Patent Owner does not identify any portions of the expert testimony that suggest Petitioner is using its expert to fill gaps in the prior art.” (citations omitted)); *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 11 at 2 (P.T.A.B. June 27, 2025) (same).

Another reason for discretionary denial under this consideration is that Patent Owner will be presenting expert testimony with its POPR that disputes Petitioners' expert opinion on dispositive issues, creating a dispute the PTAB Interim Workload FAQs indicate "are better resolved in an Article III court."

C. The '720 Patent Is the Subject of Repeated Challenges

The Board should deny institution because, in addition to invalidity contentions in the parallel litigations, the '720 patent has been and is being subjected to multiple, overlapping invalidity proceedings. For example, the '720 patent was recently subjected to an *ex parte* reexamination ("reexam") proceeding, assigned to U.S. Patent App. No. 90/019,702. That reexam was filed on October 14, 2025, by Unified Patents. (Ex. 2015.) A non-final rejection issued on March 31, 2025 (Ex. 2018), and Patent Owner's response, without amendments, was timely filed on June 2, 2025 (Ex. 2026). As part of this response, Patent Owner filed an Information Disclosure Statement submitting this Petition and its prior art references to the Office to consider when evaluating patentability of the '720 patent's claims. (Ex. 2026 at 7.) The Office, after considering Patent Owner's arguments *and* this Petition (Ex. 2027 at 15-19), issued a Notice of Intent to Issue a Reexam Certificate on July 15, 2025. (Ex. 2027 at 1-8.) Thus, the Office has already considered Petitioners' arguments, and the Board should not spend its resources on this Petition.

There are also equitable considerations favoring discretionary denial. It was only after the non-final rejection issued did Petitioners file this Petition, subjecting Patent Owner to two invalidity fronts simultaneously. To spread Patent Owner even thinner, another defendant in the parallel District Court litigations, AT&T, filed an additional IPR Petition on June 16, 2025. *See AT&T Services, Inc. v. USTA Technology, LLC*, IPR2025-01166, Paper 1 (P.T.A.B. June 16, 2025). At every turn in the parallel litigations, the defendants have coordinated their schedules (*e.g.*, Ex. 2009); there is no reason to think they are not coordinated now, inundating Patent Owner with multiple simultaneous invalidity attacks to use the Office and the Board to get multiple bites of the apple. Petitioners should not get to coordinate their efforts and use the Board for multiple attacks when validity will be ruled upon by the District Court prior to any FWD, especially after patentability of 21 claims of the '720 patent have been upheld **this month** by the Office, including at-issue claim 53.

The Board has recently found that challenging a patent that has “already been the subject of multiple proceedings” favors discretionary denial because, in such circumstances and absent “persuasive reasoning,” an IPR is not “an appropriate use of Board resources.” *WebGroup Czech Republic, A.S. and NKL Assoc., S.R.O. v. Dish Tech. LLC*, IPR2025-00467, Paper 14 at 2-3 (P.T.A.B. July 16, 2025). Here, the '720 patent has just overcome *ex parte* reexam and is subject to multiple IPR petitions. The Office has already considered the Petition and upheld patentability.

Petitioners do not provide persuasive reasoning that this IPR is “an appropriate use of Board resources” given the multiple challenges the ’720 patent has overcome and continues to be subject to. The Petition should be discretionarily denied.

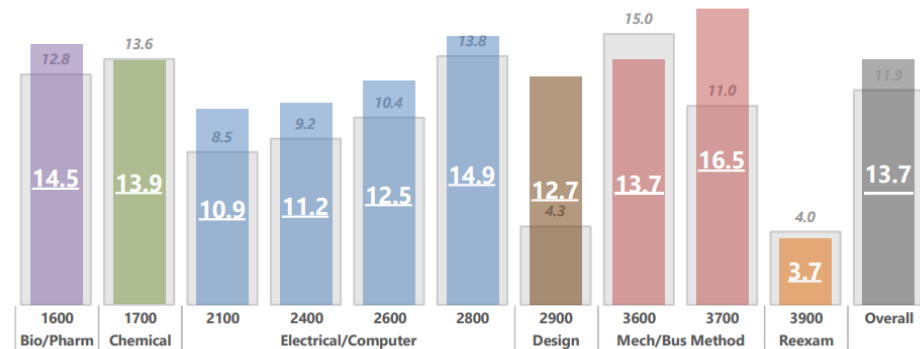
D. The Board’s Resources Are Better Spent Elsewhere

The Board should deny institution because its limited resources are better spent on the growing backlog of *ex parte* appeals. In 35 U.S.C. § 6(b)(1), the Board is tasked with “review[ing] adverse decisions of examiners upon applications for patent pursuant to section 134(a).” Congress also tasked the Board with reviewing appeals of reexaminations, derivation proceedings, IPRs, and PGRs. 35 U.S.C. § 6(b)(2)-(4). But current Office policy is to focus on *ex parte* appeals: “To ensure that the PTAB continues to meet its statutory obligations as to *ex parte* appeals, while continuing to maintain its capacity to conduct AIA proceedings, the Director will exercise her discretion on institution of AIA proceedings” Interim Processes for PTAB Workload Management at 1 (Mar. 26, 2025).

In 2025, the pendency for *ex parte* reexams has increased in almost every technical center. Shown below, the time (in months) to a final decision has increased in 2025 (shown with the color bars and white values) compared to the same data from 2024 (shown with the gray bars and gray values). For the technology center of the ’720 patent—2600—the pendency has increased from 10.4 months to 12.5 months, over a 20% increase.

Pendency of Decided Appeals

Feb. 2025 – Apr. 2025 (color bars & white values) vs. Feb. 2024 – Apr. 2024 (gray bars & values)



Pendency is calculated as average months from Board receipt date to final decision for a three month period and compared to the same period the previous year.

Central Reexamination Unit (CRU/TC 3900) decisions include *ex parte* reexams, *inter partes* reexam, supplemental examination review, regular cases and most reissues from all technologies except design patent applications.



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(Ex. 2014 at 7.)

These considerations weigh in favor of discretionary denial.

V. ANALYSIS OF THE *FINTIV* FACTORS

The above reasons favor discretionary denial regardless of the *Fintiv* factors.

Still, the *Fintiv* factors, analyzed holistically, also support discretionary denial.

A. Factor 1: A Stay at the District Court Is Unlikely

Here, a stay has not been requested in the parallel litigation, and the District Court is statistically unlikely to grant one should it be requested. For example, even if a Petitioner filed a motion to stay pending IPR in the District Court proceedings, judges in the Eastern District have consistently explained that it is the practice of the Eastern District to deny motions to stay where, as here, IPRs have not been instituted. *See, e.g., Luminati Networks v. Teso LT*, No. 2:19-CV-00395-JRG, 2020 U.S. Dist. LEXIS 219284, at *3 (E.D. Tex. Oct. 29, 2020) (Gilstrap, J.) (“this Court has a

consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.”); *see also Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV-1047-WCB, 2015 U.S. Dist. LEXIS 29572, at *17 (E.D. Tex. Mar. 11, 2015) (Bryson, J.) (“it is the universal practice” in this District to deny pre-institution motions to stay); *Viavi Sols. Inc. v. Zhejiang Crystal-Optech Co Ltd.*, No. 2:21-CV-00378-JRG, 2022 U.S. Dist. LEXIS 205106, at *15 (E.D. Tex. Nov. 10, 2022) (Gilstrap, J.) (“It is the Court’s established practice to consider that motions to stay pending IPR proceedings which have not been instituted are inherently premature and should be denied as such.”).

Judge Jordan is also likely to find that Patent Owner would suffer undue prejudice, because “a stay would delay its interest in the timely enforcement of its patent rights” and “since the final written decision for the IPR *could* issue after the scheduled trial, this factor weighs against a stay.” *Cobblestone Wireless, LLC v. Cisco Systems, Inc.*, No. 2:23-cv-00454-JRG-RSP, Dkt. 80 (Dec. 9, 2024) (emphasis added), *see also Cellspin Soft, Inc. v. ByteDance LTD., et al.*, No. 2:23-cv-00496-JRG-RSP, Dkt. 106 (Jan. 26, 2025). This sentiment is even truer here, where 71 additional claims are at issue in the parallel litigations, and the FWD will issue after, or at best concurrently with, the scheduled trials.

Thus, while Patent Owner recognizes that the Board ordinarily “will not attempt to predict” how a district court will proceed if a stay has not been granted

(see *Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (June 16, 2020) (informative)), the present facts indicate both that (1) even if a Petitioner were to request a stay, any stay request will be denied because it is the Eastern District of Texas's practice to not grant stays prior to institution, and (2) even if the Board institutes IPR proceedings, it is still unlikely that the presiding judge will grant a stay.

Fintiv Factor 1 thus weighs in favor of discretionary denial.

B. Factor 2: Proximity of the Court's Trial Date to the Board's Projected Statutory Deadline for a Final Written Decision

The precedential *Fintiv* decision, IPR2020-00019 at Paper 11, in discussing the earlier *NHK* decision, expressly noted that:

[U]nder § 314(a) the Board considered the fact that the parallel district court proceeding was scheduled to finish before the Board reached a final decision as a factor favoring denial. The Board found that the earlier district court trial date presented efficiency considerations that provided an additional basis, separate from the independent concerns under 35 U.S.C. § 325(d), for denying institution. Thus, *NHK* applies to the situation where the district court has set a trial date to occur earlier than the Board's deadline to issue a final written decision in an instituted proceeding.

Fintiv, IPR2020-00019, Paper 11 at 3. The rationale for discretionary denial in *NHK* also applies here, where the anticipated trial date is scheduled around the expected FWD date.

In the parallel proceedings, the Final Pretrial Conference is currently scheduled for November 18, 2026, with trial expected to begin as soon as practicable

thereafter. (Exs. 2011, 2012.) In other words, if the Board were to institute trial here, the district court trial is scheduled to conclude before, or contemporaneously with, the expected FWD in early December 2026. This earlier trial date presents efficiency considerations that are an independent basis for the Board to discretionarily deny institution.

The Board has consistently denied institution in cases involving similar gaps between the trial date and the statutory deadline for a FWD. *See, e.g., E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16, at 6–9 (P.T.A.B. May 15, 2019) (**one-month gap**); *ZTE USA Inc. v. Fractus SA*, IPR2018-01461, Paper 10, 16-17 (P.T.A.B. Feb. 28, 2019) (“substantially the same grounds” raised, court “likely to go to trial before a final decision is reached”); *Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (trial occurring two months before the expected FWD favored discretionary denial).

Additionally, the median time-to-trial for the Eastern District of Texas for jury trial is approximately 23 months. (See Ex. 2028 (Docket Navigator median time-to-trial statistics for the Eastern District of Texas, Jan. 1, 2020-July 28, 2025).) Because the parallel District Court actions were filed on June 7, 2024, trial would be expected to occur in early May 2026, roughly seven months prior to the statutory deadline for the FWD. Here, trial is set as soon as practicable after the Final Pretrial Conference on November 18, 2026, several months after the expected median time-to-trial date

and earlier than or concurrent with the statutory deadline of the FWD. The Board has found “[t]he fact that the time-to-trial statistic is earlier than the trial date set by [the Court] confirms that the schedule set by the District Court is credible and should be given weight.” *HP Inc. et al v. Universal Connectivity Technologies Inc.*, IPR2024-01429, Paper 11 at 9 (P.T.A.B. Apr. 16, 2025). The Board continued, “From this evidence, we are persuaded that we should rely on the trial date in the [District Court] litigation as the main indicator of a trial court reaching the merits of the invalidity of the patent-at-issue before we issue a final written decision.” *Id.* “Accordingly, this factor strongly favors exercising discretionary denial.” *Id.*

Additionally, it is important to note that Petitioners waited approximately eleven months after the District Court complaint was served to file the Petition. Had Petitioners been diligent in filing its Petition rather than delaying for eleven months, Petitioners could have avoided the trial date being scheduled before the FWD deadline. Now, because of Petitioners’ delay, the question of patentability will already be resolved by the District Court prior to, or concurrently with, the FWD in these proceedings. Moreover, while Patent Owner understands that a petitioner may wait to file an IPR petition until after the petitioner has seen what claims are being asserted in district court, here, Petitioner Lenovo has delayed the schedule using jurisdictional tactics, creating a lag time that avoided service of infringement contentions prior to the 12-month deadline to file the Petition.

Thus, Factor 2 weighs heavily in favor of discretionary denial.

C. Factor 3: Both Parties and the Court Have Invested Substantial Effort in the Parallel Litigation and Will Invest Even More Before an Institution Decision

The PTAB “consider[s] 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.” *Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9. By the expected institution decision date, December 1, 2025, the parties will have produced and analyzed thousands of pages of documents to complete venue and jurisdictional discovery and briefing, and it is expected that infringement and invalidity contentions will be served. The parties to the related parallel litigations will also be in the middle of *Markman* briefing, which is consolidated for those cases and may yet be consolidated with the parallel litigation. (*See, e.g.*, Exs. 2011 (the AT&T case schedule), 2012 (the AsusTek case schedule).) Thus, it cannot be said that the parallel litigation is or will be in its early stages as of the expected institution decision date.

By the expected institution decision date, the parties will have expended significant effort, including, among other things, preparing and serving thousands of pages of venue and jurisdictional discovery, reviewing and briefing that discovery to resolve the venue and jurisdictional issues, preparing and serving thousands of pages of infringement and invalidity contentions, propounding and responding to numerous interrogatories, requests for productions, and requests for admissions,

producing and reviewing thousands of pages of discovery, conducting depositions of fact witnesses and any third-party witnesses, and going through the *Markman* process.

By the expected institution decision date, the district court will also have invested substantial resources in the litigation, including ruling on LGL's motion to dismiss the SAC. Additionally, in the AT&T case and the AsusTek case, the parties will have already exchanged infringement and invalidity contentions, exchanged terms for claim construction, and the parties will be in the midst of extensive *Markman* briefing, including any necessary expert declarations and depositions thereof. (See Exs. 2011, 2012.) The *Markman* hearing is scheduled to occur within approximately two weeks of the institution deadline. (See *id.*) Again, given the timing, it is still possible for the parallel litigation's *Markman* process to be consolidated with that of the other cases.

Under similar circumstances, the PTAB has declined to institute IPR. See, e.g., *10X Genomics v. Pres. And Fellows of Harvard College*, IPR2023-01299, Paper 15 at 18 (P.T.A.B. Mar. 7, 2024) (denying institution of IPR when district court case had proceeded through *Markman* hearing and parties had exchanged contentions and completed substantial fact discovery); and *Samsung Elecs. Co. v. Mojo Mobility Inc.*, IPR2023-01098, Paper 11 at 8-9 (Feb. 9, 2024) (denying institution of IPR when district court case had proceeded through fact discovery and the *Markman* hearing).

Therefore, Factor 3 also weighs heavily in favor of discretionary denial.

D. Factor 4: Overlap of Issues Raised in the Petition and the Parallel District Court Litigation

Independent claims 53 and 95 of the '720 patent are challenged in the Petition. (Pet. at 6.) Currently, only those claims are at issue in the parallel litigation. (See Exs. 2001, 2002, 2003.) Thus, there is exact overlap with the references and arguments relied on in the Petition and the parallel litigation. Patent Owner plans to assert additional claims against Lenovo in the parallel litigation after completing jurisdictional briefing. However, even if only two claims continued to be at issue in the parallel litigation, at best, the IPR would be entirely duplicative of the parallel litigation; at worst, the IPR would have the potential to resolve validity of **only two** of the additional claims asserted against Lenovo. Either situation results in an inefficient use of the Board's and the Court's resources. *See, e.g., Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020) ("In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions.").

LGL's *Sotera* stipulation does not sufficiently mitigate any concerns of duplicative efforts between the District Court and the Board. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (P.T.A.B. Dec. 1, 2020) (precedential as to §II.A). LGL's stipulation in the Petition differs from the *Sotera*

stipulation and its stipulation in the parallel litigation. In the Petition, LGL stipulates:

LGL hereby stipulates that, if the PTAB institutes an IPR proceeding on the grounds presented for claims 53 and 95 of the '720 patent in [this IPR], LGL will not pursue an invalidity defense in the [related] district court litigation that the patent claims subject to the instituted IPR are invalid based on grounds that were raised or reasonably could have been raised during this IPR (i.e., any ground that could have been raised under 35 U.S.C. §§ 102 or 103 on the basis of prior art patents or printed publications).

(Pet. at 86.) In the corresponding stipulation filed in the parallel litigation, LGL added the following language: “LGL’s *Sotera* stipulation is not intended and should not be construed to limit LGL’s ability to assert invalidity of any claims of the asserted patents in this litigation ***based on any other ground.***” (Ex. 2013 at 1 (emphasis added).) The disclaimer that the stipulation is not meant to limit the ability to assert invalidity based on ***any*** other ground renders the stipulation meaningless because LGL can pick and choose different primary and secondary references with similar teachings to create new grounds. In addition, and importantly, LGL’s stipulation has no effect on the other parallel litigations. As described above, Lenovo and the other defendants have synced schedules at every

moment, so there is no reason to believe that the prior art references in the Petition will not be asserted in the parallel litigations by at least one other defendant, leaving the stipulation toothless.

In addition, the parallel litigations against AT&T and AsusTek involve 71 additional asserted claims than those at issue in the Petition, 73 in total: claims 19, 22-43, 45-58, 60-93, and 95-96. But due to the schedule lag, contentions have not been exchanged in the parallel litigation against Lenovo; however, Patent Owner anticipates a similar number in that case. Though the asserted claims may get narrowed throughout progress in the District Court, it is unlikely that all claims except claims 53 and 95, the only claims at issue in the Petition, will be dropped. The validity of the challenged claims, plus those additional claims, will be resolved sooner and more comprehensively in the parallel litigations than in this IPR should it be instituted.

Factor 4 thus weighs in favor of denying institution.

E. Factor 5: Petitioners Are Represented in the Parallel District Court Litigation

Petitioner Lenovo is a real party-in-interest to the parallel litigation. As noted by the Original Complaint and First Amended Complaint, Lenovo was one of the original defendants. (See Exs. 2001, 2002.) Though LGL is the only remaining defendant in the parallel litigation (see Ex. 2003), the interests of Lenovo, LGL, and LGL's other subsidiaries are fully aligned. Beyond the parent and subsidiary

interests they share, they operate as a unitary business, the Lenovo Group, controlled by LGL with its executive team⁶, and thus they are functionally the same party for the purposes of this Petition.

Petitioner Intel is not a party to the parallel litigation. However, Intel and Lenovo are intimately connected, as Intel supplies processors to Lenovo. (*See, e.g.*, Ex. 2029 (“Intel Based Laptops”).) Therefore, Intel’s validity concerns will be represented in the parallel litigation alongside Lenovo’s.

There is no unrelated third party involved in either the IPR or the parallel litigation, and adjudication in the district court proceeding will therefore resolve all claims between the parties.

⁶ 2023 Annual Report, <https://doc.irasia.com/listco/hk/lenovo/annual/2023/ar2023.pdf> at 65 (“We Are Lenovo” is Lenovo’s culture and the way Lenovo work together as one team.”), at 199 (“The chief operating decision-maker, who is responsible for allocating resources and assessing performance of the operating segments, has been identified as the Lenovo Executive Committee (the “LEC”) that makes strategic decisions.”); see also <https://tbri.com/special-reports/one-lenovo-creating-a-cohesive-global-technology-solutions-company-begins-with-unification/> (discussing “One Lenovo”).

Factor 5 therefore weighs in favor of discretionary denial. *See Fintiv II*, IPR2020-00019, Paper 15 at 15.

F. Factor 6: Petitioner’s Grounds Do Not Rise to the Level of “Compelling Evidence of Unpatentability”

Under the sixth *Fintiv* factor, the Board may consider other circumstances that impact the Board’s exercise of discretion, including the merits. *Fintiv*, IPR2020-00019, Paper 11 at 14-15; *see also PTAB Workload Management Memorandum* at 2 (stating that “consistent with the discretionary considerations enumerated in existing Board precedent . . . and the Consolidated Trial Practice Guide (Nov. 2019),” the parties may address all relevant considerations, including “[t]he strength of the unpatentability challenge” and “[t]he extent of the petition’s reliance on expert testimony.”). Here, the Petition was submitted in the reexamination and there is overlapping art to what has been considered; thus Patent Owner refers to the reexamination File History in support of this factor.

Therefore, the *Fintiv* factors collectively weigh in favor of discretionary denial, and the Board should deny institution under § 314(a).

VI. DENIAL OF THE PETITION UNDER § 314(d) IS APPROPRIATE

When there are parallel proceedings pending before the Patent Office — such as an IPR and a reexam — “the Director may determine the manner in which the *inter partes* review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, **or termination** of any such matter or proceeding.”

35 U.S.C § 315(d) (emphasis added). The Office ordered an *ex parte* reexam of the '720 patent on December 5, 2024, regarding claims 53-56, 64-66, 70, 76, 81-84, and 87-94 of the '720 patent. (Ex. 2015.) Though the Office issued a Notice of Intent to Issue a Reexam Certificate on July 15, 2025 (Ex. 2027 at 1-8) after considering and rejecting Petitioners' arguments provided in an IDS (Ex. 2027 at 15-19), the reexam has not yet been officially concluded and therefore remains open.

In view of the finite resources of the Board and the co-pending reexam, the Director should deny the Petition under 35 U.S.C § 315(d).

VII. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C., § 325(d)

In determining whether to institute an IPR petition, if another proceeding or matter involving the patent is before the Office, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

In evaluating arguments under § 325(d), the PTAB set forth a **two-part framework** in its precedential *Advanced Bionics* opinion:

- (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and

(2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics LLC v. MED-EL Elektromedizinische Gerate GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential); *see also Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph) (listing factors to consider in evaluating the applicability of § 325(d), referred to herein as the *Becton-Dickinson* factors).

Both prongs of *Advanced Bionics* and the related *Becton-Dickinson* factors favor exercising discretion to deny institution here.

A. The Same or Substantially the Same Prior Art and Arguments Were Previously Presented to the Office

Petitioner Lenovo is a real party-in-interest to the underlying litigation. As part of the analysis under the first prong of the *Advanced Bionics* framework, the PTAB evaluates *Becton-Dickinson* factors (a), (b), and (d):

Factor (a): “the similarities and material differences between the asserted art and the prior art” presented to the Office during a proceeding pertaining to the challenged patent,

Factor (b): “the cumulative nature of the asserted art and the prior art”
presented to the Office during a proceeding pertaining to the challenged
patent, and

Factor (d): “the extent of the overlap between the [prior] arguments”
and “the manner in which petitioner relies on the prior art.”

See Advanced Bionics, Paper 6 at 9-10, 9 n.10 (citing *Becton, Dickinson*, Paper 8 at 17-18).

The PTAB emphasized that these factors “should be read **broadly** . . . to apply to **any situation** in which a petition relies on the same or substantially the same art or arguments previously presented to the Office during a proceeding pertaining to the challenged patent.” *Advanced Bionics*, Paper 6 at 10; *see also id.* at 8 (noting that “[t]he proceedings in which the art was previously presented include, for example: examination of the underlying patent application, **reexamination of the challenged patent**, a reissue application for the challenged patent, and AIA post-grant proceedings involving the challenged patent” (emphasis added)).

Each of *Becton-Dickinson* factors (a), (b), and (d) favor exercise of discretion to deny institution. In particular, the ’720 patent *ex parte* reexam challenged the validity of 21 claims of the ’720 patent, including claim 53, one of the only two claims that are challenged in the Petition. Patent Owner submitted the Petition and associated references to the Office in an IDS for consideration during the

reexamination proceeding. (Ex. 2026 at 7; Ex. 2027 at 15-19.) This resulted in a one-to-one correlation between the art and arguments considered by the Office with respect to at least claim 53.

Accordingly, the first prong of *Advanced Bionics* is met because the art and arguments presented in the Petition are the same or substantially the same as those presented in the '720 patent *ex parte* reexam.

B. Petitioners Make No Claim that the Examiner Erred During Prosecution

As part of the analysis under the second prong of the *Advanced Bionics* framework, the PTAB evaluates Becton-Dickinson factors (c), (e), and (f):

Factor (c): “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;”

Factor (e): “whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art;” and

Factor (f): “the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.”

See Advanced Bionics, Paper 6 at 9-10, 9 n.10 (citing *Becton, Dickinson*, Paper 8 at 17-18). The PTAB emphasized Becton-Dickinson factors (c), (e), and (f) all “relate to whether the petitioner has demonstrated a material error by the Office.” *Id.*, Paper 6 at 10.

As discussed below, each of factors (c), (e), and (f) favor exercise of discretion to deny institution.

Becton Dickinson factors (c), (e), and (f) relate to whether the petitioner has demonstrated a material error by the Office. *Advanced Bionics*, IPR2019-01469, Paper 6 at 10; *see Becton*, IPR2017-01586, Paper 8, 17–18 (designated as informative). Here, Petitioners do not substantively address the '720 patent *ex parte* reexam, let alone assert that the examiner erred during examination. Nevertheless, the factors favor denial.

With respect to factor (c), the Office not only issued an order granting the '720 patent *ex parte* reexam (*see* Ex. 2015) prior to the Petition's filing, but also issued an Office Action rejecting the challenged claims. (*See* Ex. 2018.) Patent Owner submitted this Petition and associated references to the Office in an IDS for consideration during the reexam proceeding to ensure that the examiner had the same information present in the Petition. Thus, factor (c) is met because the same or substantially the same prior art is the basis for the rejections in the '720 patent *ex parte* reexam.

Regarding factor (e), Petitioners simply failed to address the '720 patent *ex parte* reexam despite the reexam having been filed and ordered prior to the filing of the Petition. (Ex. 2015 at 1 (confirming October 14, 2024 filing date of *ex parte* reexam); Paper 4 at 1 (confirming April 29, 2025, filing date of the Petition).)

Factor (f) is not present or satisfied by Petitioners because Petitioners offer no other evidence to justify reconsideration of the prior art or arguments that were at issue during the '720 patent *ex parte* reexam.

Finally, the Office issued a Notice of Intent to Issue a Reexam Certificate on July 15, 2025. (Ex. 2027 at 1-8.) The Office has already considered Petitioners' arguments, and rejected them. However, the reexam has not yet been officially concluded and therefore remains open.

In sum, all of the *Becton-Dickinson* factors, as reviewed from the lens of the two prongs of *Advanced Bionics*, weigh in favor of discretionary denial. Forcing Patent Owner to prosecute the '720 patent *ex parte* reexam and litigate the '720 patent IPR in parallel, where the same issues would be considered, would be highly prejudicial to Patent Owner. As such, Patent Owner respectfully requests the Director exercise her discretion and decline institution of the Petition.

VIII. PETITIONERS FAILED TO IDENTIFY ALL REAL PARTIES IN INTEREST, FAILING TO MEET THE REQUIREMENT OF 35 U.S.C. § 312(A)(2)

Petitioners Intel Corporation and Lenovo (United States) Inc., named Motorola Mobility LLC, and Lenovo Group Limited as real parties in interest. (Pet. at 88.) However, entity Lenovo Global Technology (United States) Inc. ("Lenovo Tech.") was a party to the parallel litigation until the SAC was filed. (See Exs. 2001-2003.) Patent Owner believes that LGL controls all Lenovo Group entities including

Lenovo Tech. (See Ex. 2003 at 2.) Therefore, Lenovo Tech. is a privy to Petitioners and should have been named as a real party in interest. This violates the requirement of 35 U.S.C. § 312(a)(2). Under 35 U.S.C. § 312(a), a Petition “may be considered **only if**” all of the requirements are met, including “identif[ying] all real parties in interest.” (emphasis added.) Because of this, the Director may deny the Petition for failing to meet the minimum statutory requirements for consideration.

Patent Owner also notes that Motorola was sold to LGL by Google on or around 2014 and that Google’s public disclosures indicate it retained a significant indemnification obligation (recorded as a \$130M liability) with respect to the Motorola business acquired by LGL.⁷ Google was also participating up until recently in IPR proceedings alongside Lenovo against Ericsson in *Google LLC et al v. Ericsson AB*, IPR2025-00004 & IPR2025-00003, while Ericsson was in a global IP dispute with the Lenovo Group. Google and Lenovo identified themselves as real parties in interest. Google and Motorola are also petitioners and real parties in interest in eight IPRs filed against Multifold International Incorporated Pte. Ltd. in October 2024, which identify Google and Motorola as real parties in interest. Patent Owner does not have additional information at this time, but notes that Google was

⁷ See <https://www.sec.gov/Archives/edgar/data/1288776/000128877615000046/goog10-qq32015.htm>.

involved in prior litigation with Patent Owner concerning RE47,720 in which Google was served on November 28, 2022.

IX. CONCLUSION

Holistically, the above considerations favor discretionary denial. The Board should therefore exercise its discretion to deny institution.

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner's Discretionary Denial Briefing consists of 8,022 words, excluding cover page, table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The brief complies with the type-volume limitation of 14,000 words as mandated in 37 C.F.R. §42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was served electronically via electronic mail on July 29, 2025 on the following counsel of record for Petitioners:

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