

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.

IPR2025-00838
U.S. Patent No. RE47,720

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

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I. INTRODUCTION

Petitioners oppose Patent Owner's request for discretionary denial of the IPR petition. This *inter partes* review is an appropriate use of Office resources and should not be denied for the reasons summarized below, as well as for the detailed reasons provided in the following section.

1. Examiner Made a Material Error In Reexamination

During the prior reexamination that resulted in a Reexamination Certificate issued on August 26, 2025, the Patent Owner submitted an IDS with a copy of the present IPR petition and a copy of Walton, the primary reference of the petition. Upon receipt of the IDS, the Examiner stated explicitly that he did not consider Walton during reexamination. Walton is not cumulative of the art the Examiner did consider, and it expressly teaches the claim features the Examiner found missing in the prior art to confirm patentability. This failure by the Office to consider and appreciate the teachings of Walton constitutes a material error that warrants review and correction.

2. Only One Claim Overlaps Between Reexamination and IPR

Of the 21 claims considered in reexamination and the 2 claims challenged in the present IPR, only claim 53 overlaps. The IPR challenges different claims and relies on different prior art than the reexamination, making the issues and evidence

in these proceedings distinct from each other. The numerous lawsuits initiated by Patent Owner asserting claims that were not reexamined refute any argument of an unfair attack against the patent.

3. The Patent Is Only 5 Years Old With No Settled Expectations

The '720 patent issued on November 5, 2019, so it is just five years old. The Director has repeatedly stated that patents less than six years old do not have settled expectations of validity. The Patent Owner's argument that there are "over sixteen years" of expectations based on its parent patent is incorrect. The '720 patent is a reissue patent, with its own unique patent number and claim set. The parent '711 patent was surrendered as defective (thus no expectation of validity), and the challenged claims were newly added during the '720 prosecution. Furthermore, prior communications between the parties ended with Intel providing prior art that showed the asserted claim was invalid, to which USTA never responded (until later filing the present lawsuit). This shows that any expectation of validity of the '720 patent was unsettled.

4. Litigation Trial Date Is Unscheduled and Will Occur Long After the Final Written Decision

There is no case schedule or trial date for the related litigation. There is a pending motion to dismiss and beyond the motion to dismiss briefing, there has

been no substantive work in the case—no preliminary infringement contentions, no discovery, and no claim construction proceedings. Even in the event the pending motion to dismiss were to be denied immediately, the trial would still occur many months after the statutory deadline for decision in this IPR.

5. Additional Considerations Favor a Merits Review

The analysis below addresses the *Fintiv* factors along with other considerations bearing on the Director's discretion that, based on the present facts, weigh against denial of this petition and support passing it to a merits panel for review.

II. DETAILED ANALYSIS

The evidence and arguments presented by the parties show that this IPR is an appropriate use of Office resources, and the Office should decline discretion to deny institution.

1. The Examiner Made a Material Error In Reexamination by Not Considering Walton

Denial under Section 325(d) is not warranted in this case because it is “an appropriate use of Office resources” for an IPR to correct an error made by the Office during a reexamination. *Anthony Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 9, 2; *see also, Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-

01280, Paper 13, 5 (precedential). Here the facts show a material error was made by the Office in the *ex parte* reexamination of the '720 patent.¹

Both the IPR petition and Walton (the primary reference of the petition)² were presented in an IDS to the Office during the pendency of reexamination, thus satisfying the first part of the *Advanced Bionics* framework.³ Walton was not previously submitted to or considered by the Office during the prior examination of the '720 patent or its patent family.⁴

Turning to the second part of the *Advanced Bionics* framework, *Becton Dickinson* factors (c), (e), and (f) are analyzed and show the Office made a material error.⁵ These factors are evaluated below and demonstrate that the Office erred in a

¹ Reexamination Control No. 90/019,702 concluded with a Reexamination Certificate issued on August 26, 2025. Ex.1039.

² Walton, U.S. Pub. No. 2003/00433732, Ex.1005.

³ *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential); *Ecto World*, 4.

⁴ EX.1002, Ex.1009, *see also*, Cited References listed in related U.S. Pat. Nos. 8,190,093, 8,494,534, and 8,041,363.

⁵ *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8

manner material to the patentability of the challenged claims by not considering Walton. Therefore, discretionary denial is not appropriate in this case.

a. **The Examiner Did Not Evaluate or Even Consider Walton
During Reexamination (*Becton Dickinson* Factor (c))**

Becton Dickinson factor (c) considers the extent to which the art was evaluated during examination including whether it was the basis for rejection. Here, both the IPR petition and Walton were cited in an IDS during the reexamination. However, Walton explicitly was not considered by the Examiner and thus was not evaluated or used to reject any claim during the reexamination. *See*, IDS reproduced and discussed immediately below.

Although the IDS was timely filed, the Examiner drew a line through the citation of Walton to indicate that it was not considered, shown below.

(Dec. 15, 2017) (precedential as to § III.C.5, first paragraph). *See also Advanced Bionics*, 9; and *Ecto World*, 3, 5.

Opposition to Patent Owner's Request for Discretionary Denial
IPR2025-00838 (U.S. Patent RE47,720)

Receipt date: 06/02/2025 90/019,702 - GAU: 3992

INFORMATION DISCLOSURE STATEMENT BY APPLICANT		Application Number		90019702	
		Filing Date		2024-10-14	
		First Named Inventor		RE47720	
		Art Unit		3992	
		Examiner Name		Matthew E. Heneghan	
		Attorney Docket Number		USTAP030D.RE	

	1								
If you wish to add additional Foreign Patent Document citation information, please click the Add button <input type="button" value="Add"/>									
NON-PATENT LITERATURE DOCUMENTS <input type="button" value="Remove"/>									
Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.							T ⁵
	1	Petition for Inter Partes Review of US Patent No. RE47,720 (IPR2025-00838), filed April 29, 2025 (91 pages)							☐
	2	Reference is a patent Exhibit 1001 - U.S. Patent No. RE47,720 to J. Burchfiel (42 pages)							☐
	3	Exhibit 1002 - Prosecution File History of U.S. Patent Application No. 15/898,404, issued as the '720 Patent (357 pages)							☐
	4	Exhibit 1003 - Declaration of James Lansford, Ph.D. under 37 C.F.R. § 1.68 (137 pages)							☐
	5	Exhibit 1004 - Curriculum Vitae of James Lansford, Ph.D. (9 pages)							☐
	6	Exhibit 1005 - U.S. Application Publication No. 2003/0043732 by J. Walton et al. (31 pages) References are patent application publications							☐
	7	Exhibit 1006 - U.S. Application Publication No. 2002/0066167 to W. McFarland (15 pages)							☐
	8	Exhibit 1007 - IEEE Std 802.11a-1999, Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) specifications, High-speed Physical Layer in the 5 GHz Band, Sept. 1999 (90 pages)							☐

Walton was not considered

PC.1.19.25

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /M.E.H/

Ex.1027, 10 (Annotated). Specifically, the Examiner wrote that “all references [were] considered except where lined through. /M.E.H/.” Because Walton is a

patent publication but was incorrectly listed in the IDS form with the Non-Patent Literature, the Examiner added the following remark below Walton: "References are patent application publications."

Thereafter, a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on July 15. Ex.1027. On August 22, over a month after the date of the NIRC, Patent Owner filed a second IDS that included Walton. Ex.1038. However, because the second IDS was not timely filed, the Examiner did not consider Walton. The Reexamination Certificate issued a few days later on August 26, 2025. Ex.1039.

Thus, the Examiner provided no analysis of either the IPR petition or Walton and did not use Walton as a basis for rejection. *See generally*, Exhibits 2015, 2018, 2026, and 1027. Based on all of the foregoing, at no time did the Examiner consider or evaluate the teachings of Walton despite it being before the Office.

b. The Office Erred Because the IPR Petition Sufficiently Points Out That Walton Teaches the Claim Features That Were the Reason for Patentability (*Becton Dickinson* Factor (e))

Becton Dickinson factor (e) considers whether the Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art. The IPR petition clearly and sufficiently shows that Walton teaches the very claim

element found to be missing from the art considered by the Examiner.

Specifically, pages 14-21 of the IPR petition provide a detailed analysis of how Walton teaches the foregoing limitation of claim 53 (numbered as limitation [53.1]). The Examiner thus erred by refusing to consider and appreciate the teachings of Walton, despite it being discussed extensively in the IPR petition.

Walton teaches the claim features found to be missing from the prior art during the reexamination. The reexamination relied on the combination of three patent publications, Agee, in view of McFarland, and further in view of Ton, for the obviousness rejection of claim 53.⁶ The Patent Owner argued, and the Examiner agreed, that that combination does not teach claim 53. Ex.1028, 9-17. Specifically, the Examiner found that the combination does not teach the claimed “*instruction*” which would be used to identify frequencies to “*avoid*.” See, the reexamination statement of reasons for patentability:

⁶ Ex.2018, 7-10. Only claim 53 overlaps the reexamination and IPR.

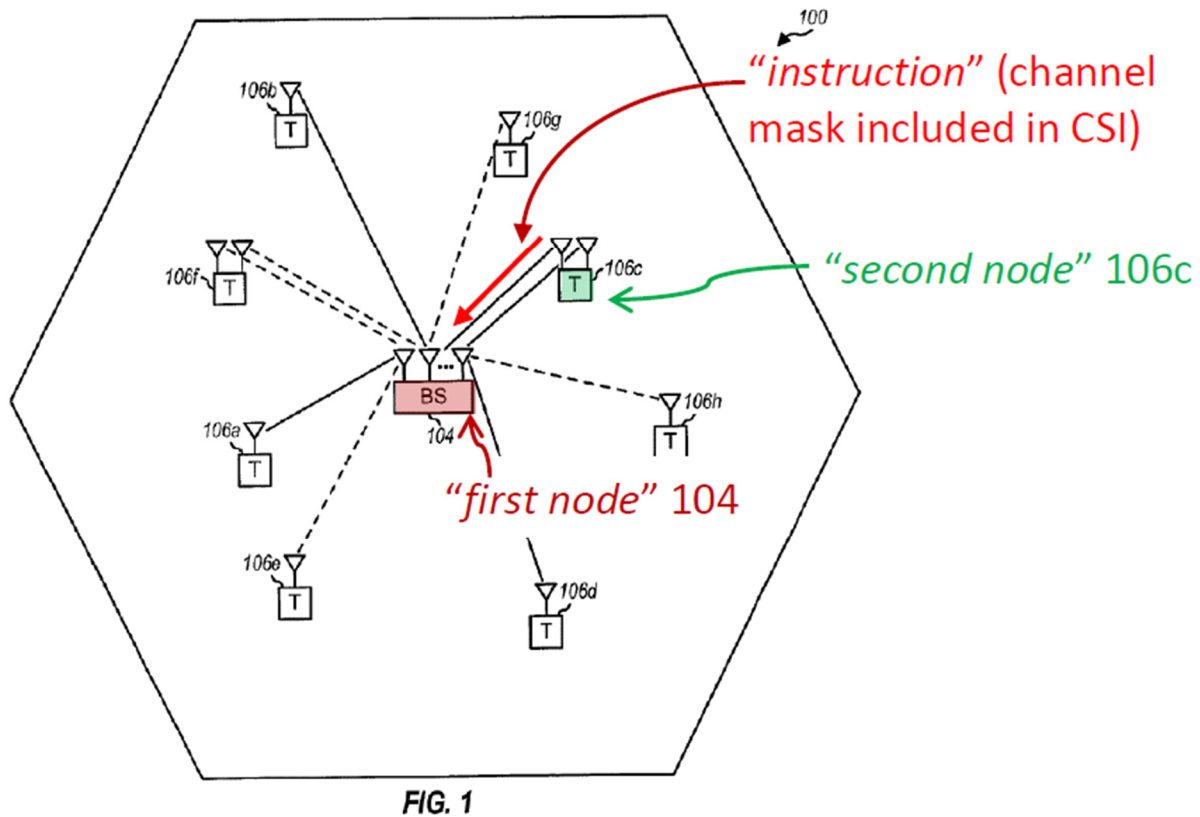
The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:

Regarding claim 53, Patent Owner has persuasively argued that the cited references would not result in "receiving at a first node in the radio communications network an instruction transmitted from a second node in the radio communications network to avoid using a plurality of frequencies to transmit to the second node."

Claims 54-56, 64-66, 70, 76, 81-84, and 87-94 are confirmed based upon their dependence on claim 53.

Reexamination NIRC, Ex.1027, 10 (Annotated).

In contrast to the art used in prior prosecution including the reexamination, Walton very clearly teaches the claim features the Examiner found missing in the prior art to establish patentability. Walton teaches that a base station 104 (the claimed "*first node*") in wireless network 100 receives channel state information with a "channel mask" (the claimed "*instruction*") from terminal 106c (the claimed "*second node*"), as shown in FIG. 1 from Walton, reproduced and annotated below.



Ex.1005, Fig. 1; *see also* [0024], [0203], [0205], [0225]. Walton further explains:

In one embodiment, the **CSI comprises an indication of all transmission channels that have been selected for use** ... In one specific implementation, **a channel mask may be defined to include a bit for each transmission channel that may be selected for use.** Prior to a data transmission, the available transmission channels may be evaluated and selected at the receiver system. The bit for each selected transmission channel may then be enabled (e.g., set to logic high) and **the bit for each unselected transmission channel may be disabled** (e.g., set to logic low).

Id., [0205].

By indicating which transmission channels to use or to disable, Walton teaches the claimed “*instruction*” which identifies frequencies (transmission channels) to “*avoid*.” *See also, id.*, [0009], [0026], [0066] where “channels” refer to OFDM frequencies. A more detailed analysis of how Walton teaches the foregoing limitation of claim 53 (numbered as limitation [53.1]) is provided in the IPR petition at pages 14-21.

Walton's teachings compel a finding of obviousness against claim 53 of the '720 patent that cannot reasonably be considered the same as or cumulative of the art or arguments previously considered. Further, Patent Owner does not present any arguments in its PO Brief as to why claim 53 is patentable over Walton.

c. **Additional Evidence Supports Reconsideration by the Office (*Becton Dickinson* factor (f))**

Becton Dickinson factor (f) considers the extent to which additional evidence and facts presented by the Petitioner warrant reconsideration.⁷ As

⁷ See *Ecto World*, 6 (“Finally, even if a petitioner fails to make a persuasive argument that the Examiner erred by overlooking particular teachings in the prior art provided on an IDS, a petitioner may be able to demonstrate that discretionary denial is inappropriate under *Becton Dickinson* factor (f).”)

discussed above, 1) Walton was not considered or appreciated by the Examiner during reexamination, and 2) Walton teaches the claim element found to be missing from the prior art considered during the reexamination. Thus, Walton is evidence presented by the Petitioner that warrants reconsideration.

Additionally, the Patent Owner failed on multiple occasions to ensure that Walton would be considered by the Office: (1) by incorrectly citing Walton in the wrong portion of the IDS with non-patent literature documents (*see* 37 CFR §1.98(a)(1)) and (2) by untimely and incorrectly filing a second, corrected IDS well after the Notice of Intent to Issue a Reexamination Certificate (NIRC), dated July 15. As discussed above at Section II.1.a, the Patent Owner incorrectly listed Walton on a first IDS paper such that the Examiner struck out the citation and explicitly did not consider Walton. Then on August 22, waiting over a month after the date of the NIRC, Patent Owner filed a second IDS that includes Walton along with a Petition to Accept the IDS After Issuance of NIRC and a Request to Expedite the Petition. *See* Exs.1036-1038. However, Patent Owner failed to meet any of the three conditions necessary for the second IDS to be considered after the NIRC, including “an unequivocal statement that one or more claims are unpatentable,” and “an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable.” *See* MPEP §

2256. The second IDS was never considered by the Examiner. The reexamination certificate issued on August 26, 2025, Ex.1039, shortly after the non-compliant second IDS was submitted.

This evidence of incorrect and untimely IDS submissions by the Patent Owner shows, under *Becton Dickinson* factor (f), that it is an appropriate use of Office resources to allow this IPR to proceed to a merits consideration to correct this material error.

2. Only One Claim Overlaps Between Reexamination and IPR

Of the 21 claims considered in reexamination and the 2 claims challenged in the present IPR, only claim 53 overlaps. *See generally*, IPR petition, Paper 3; Reexam Office Action, Ex. 2018. The IPR and reexamination address different claims and issues, supporting the appropriateness of instituting this IPR. None of the references in the reexamination comprise any ground of unpatentability for the IPR. Thus, the issues and evidence of the proceedings are entirely different. *Cf.*, *Apotex Inc., v. Alkermes Pharma Ireland Limited*, IPR2025-00514, Paper 10, 2; *see also*, *Geneoscopy, Inc. v. Exact Sci. Corp.*, IPR2024-00459, Paper 9, 30–32 (PTAB July 26, 2024) (declining to exercise discretion to deny institution of inter partes review in view of a completed *ex parte* reexamination).

The Patent Owner also alleges being “inundated ... with multiple

simultaneous invalidity attacks,” including referring to the later-filed IPR petition filed by AT&T. PO Brief, 15. This argument rings hollow when only one claim presented in the IPR—claim 53—overlaps with the reexamination; and it is the Patent Owner who has chosen to file multiple lawsuits against multiple defendants, each of whom are likely to seek review of the patent's validity.

3. The Patent Is Only 5 Years Old with No Settled Expectations

The '720 patent is just five years old. Its parent '711 patent was surrendered as defective. The challenged claims (claims 53 and 95) were newly added during the '720 prosecution, so there can be no settled expectation regarding their validity. Additionally, the Patent Owner's actions and communications with Petitioners demonstrate that any expectation of validity was unsettled.

a. The '720 Patent Is Only 5 Years Old

The '720 patent issued on November 5, 2019, less than 5 and a half years before the present IPR petition was filed (April 29, 2025). The Director has repeatedly stated that a patent that is less than 6 years old does not have a settled expectation of validity. *See Dabico Airport*, IPR2025-00408, Paper 21, 3 (comparing settled expectations of patent validity with the six-year bar for recovery of patent damages set forth in 35 U.S.C. § 286); *Cambridge Industries USA, Inc., v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 12, 2 (June 27,

2025).⁸

b. The Parent Patent's Issue Date Does Not Establish Settled Expectations

The '720 patent is a reissue of U.S. Pat. No. 7,483,711 (the "parent '711 patent"). Patent Owner's argument regarding purportedly settled expectations of validity of the '720 patent based on the parent '711 patent (PO Brief, 8-12) fails for multiple reasons.

First, the '720 patent is a stand-alone patent, with its own unique patent number and claim set. According to statute, a reissue patent is its own, separate patent, and in fact "the director may issue several reissued patents." 35 U.S.C. § 251(b).

Second, the parent '711 patent is a "defective patent" that has been officially "surrender[ed]," having "through error, [been] deemed wholly or partly inoperative or invalid." 35 U.S.C. § 251(a). Thus, there can be no settled expectation of validity of the defective '711 patent that Patent Owner willingly surrendered to the

⁸ It is noted that the '720 patent was 5 years and 5 months old at the filing of the present IPR petition, and the corresponding patent in *Cambridge* which was found to "not have developed strong settled expectations" was also 5 years and 5 months old at the filing of its petition. *Id.*, referring to U.S. Pat. No. 9,523,826.

Office. Ex.1002, 353-54.

Third, the challenged claims 53 and 95 of the present IPR petition were newly added during the '720 patent prosecution. Ex.1002, 68-69 (referencing prosecution claims 40 and 41, respectively). Since they did not exist as part of the parent '711 patent there can be no settled expectations as to these claims based on the parent patent. *Id.*, 68-70 (referring to prosecution claims 40 and 41, respectively).

c. Prior Communications Establish Lack Of Settled Expectations

The '720 patent issued on November 5, 2019, and three years later, the Patent Owner first asserted the '720 patent against Intel and Lenovo in a letter-writing campaign in late 2022. Ex. 2025; PO Brief at 11. In early 2023, Intel provided the Patent Owner with prior art that would render the patent invalid. Ex.2025, 2. Intel received no response from the Patent Owner, despite Intel's diligent attempts to resolve this issue—until the Patent Owner filed the presently pending lawsuit. Under these circumstances there could be no settled expectation that the validity of the patent would not be challenged.

4. Litigation Trial Date Is Unscheduled and Will Occur Long After the Final Written Decision

a. No Trial Date

There is no scheduled trial date. Lenovo moved to strike the complaint and dismiss the litigation under Fed. R. Civ. Pro. 12(b). Dkt. 43. The court has yet to rule on that motion, and it has yet to enter an operative schedule—a point of which Patent Owner is keenly aware. Ex.1029.

At present there are no deadlines for contentions, claim construction, or any substantive or discovery matter. There is minimal (if any) relevant investment in the pending litigation. There are no preliminary infringement contentions. In fact, the Patent Owner has not yet finalized which claims to assert in the litigation; to the contrary, it has expressly reserved its right to assert additional claims. PO Brief at 7.

b. Trial Will Occur After Final Written Decision

The earliest proposed schedule—which the Court has not yet entered and would need to be reset given that many proposed deadlines have passed—has a Final Pretrial Conference scheduled for November 18, 2026. Even under that schedule, the following week is Thanksgiving so the earliest conceivable starting date for trial would be the first week of December, **after** the statutory deadline for the final written decision (November 29, 2026).

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Critically, the pending motion to dismiss will likely push the trial date even later, well beyond 2026. Also, the Court's current schedule does not appear to have room for a trial in either December 2026 or January 2027.

CIVIL FINAL PRETRIAL CONFERENCE AND TRIAL DATES U.S. DISTRICT JUDGE SEAN D. JORDAN 2026		
United States Courthouse 7940 Preston Road Courtroom 105 Plano, TX 75024		
MONTH/YEAR	CIVIL PTC 9:00 a.m. (Trial held following month)	CIVIL TRIAL (Jury selection 9:00 a.m.) (Bench trial 9:00 a.m.)
JANUARY 2026	January 14, 2026	February 2-27, 2026
FEBRUARY 2026	February 11, 2026	March 2-31, 2026
MARCH 2026	March 18, 2026	April 1-30, 2026
APRIL 2026	April 15, 2026	May 4-29, 2026
MAY 2026	May 13, 2026	June 1-30, 2026
JUNE 2026	June 17, 2026	July 6-31, 2026
JULY 2026	July 15, 2026	August 3-28, 2026
AUGUST 2026	August 12, 2026	September 1-30, 2026
SEPTEMBER 2026	September 16, 2026	October 5-30, 2026
OCTOBER 2026	October 14, 2026	November 2-20, 2026, and December 1-10, 2026
NOVEMBER 2026	November 18, 2026	December 1-18, 2026, and January 4-29, 2027
DECEMBER 2026	December 16, 2026	January 4-29, 2027

Court's Trial Schedule through Jan. 2027, Ex.1030 (Annotated).

Thus, even if the complaint were to survive, the trial date would likely be scheduled for February 2027 or later, long after the deadline for a final written decision on this Petition.

c. The AT&T and AsusTek Cases Do Not Apply

At page 7 of its Brief, Patent Owner states that, “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 a preliminary matter, the AT&T and AsusTek cases are scheduled for trial in December 2026, after the due date of the final written decision. Ex.1030.

But more importantly, the issues between the cases are different, *i.e.*, the asserted claims and the accused devices in the present litigation are different from those in the AT&T and AsusTek cases. *See* PO Brief, 26; *see also*, EX.1023, EX.1031, EX. 1033. *Fintiv* is clear that a different, earlier court proceeding with different parties and different issues is not pertinent to a decision of discretionary denial. “If a petitioner is unrelated to a defendant in an earlier court proceeding, the Board has weighed this fact against exercising discretion to deny institution[.]” *Fintiv*, 13-14.

d. Patent Owner's Additional Arguments are Flawed

Patent Owner also discusses the average time-to-trial in the Eastern District of Texas. PO Brief, 20-21. However, as discussed above, the present litigation has no case schedule, and no scheduled trial date. Ex. 2004. Critically, there is currently a pending motion to dismiss. Any trial date will be delayed well beyond the average time-to-trial, and will instead most likely be set for February 2027 or later, long after the deadline for a final written decision on this Petition.

Also, Patent Owner's argument regarding Petitioners' alleged "delay" in the filing of the IPR petition is inaccurate. PO Brief, 21, Instead, the present petition was filed early, especially in light of the Patent Owner's repeated changes as to which of the '720 patent's 96 claims were being asserted and which entities were named as defendants. The Patent Owner has filed three different complaints. Exs. 2001-2003. The third and most recent complaint was filed on December 20, 2024, just three months before the filing of the present IPR petition. So, the present petition was filed early, shortly after the most recent complaint and well before having the benefit of any infringement contentions. *Fintiv*, 11 (Petitioner is diligent if "petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted"). Recent panels agreed that similar diligence is reasonable and weighs against denial. *See Samsung Elecs. Co., Ltd. v. Mullen Industries LLC*, IPR2024-01472, Paper 9 at 10 (Mar. 31, 2025) ("Petitioner's diligence in filing its Petition (a) less than five months after receiving Patent Owner's infringement contentions and (b) prior to the parties briefing claim construction issues weighs against exercising discretionary denial.").

5. Fintiv Does Not Apply, and Even If It Did, the *Fintiv* Factors Weigh Against Discretionary Denial

The *Fintiv* factors are to be considered when there is “an earlier trial date” between the parties. *Fintiv*, 5. As discussed above, **there is no trial date**. Instead, there is only a pending motion to dismiss, and if the motion is denied, the trial will still occur several months after the final written decision. Thus, *Fintiv* does not apply in the present case.

Nevertheless, Patent Owner incorrectly argues that “the anticipated trial date is scheduled around the expected FWD date.” PO Brief, 19. Even if this were true and the trial date was coincident with the AT&T and AsusTek trial dates set in December 2026, the *Fintiv* factors still do not support discretionary denial. As shown in the table below, every *Fintiv* factor is either neutral or weighs against denial.

Factor	Weight	Reason
1 (stay)	neutral	No evidence of a stay
2 (trial gap)	against denial	PO argues FWD will issue around trial date
3 (investment)	against denial	Early stages of litigation
4 (overlap)	against denial	<i>Sotera</i> stipulation
5 (parties)	against denial	PO argues FWD will issue around trial date
6 (merits)	against denial	Reliance solely on printed publications

a. Factor 1: Neutral (No Evidence Regarding a Stay)

No motion to stay has been filed, so the Board should not infer the outcome of such a motion. *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 7 (June 16, 2020) (informative). This factor is thus neutral.

Patent Owner's allegations for *Fintiv* factor 1 rely on irrelevant speculation as to whether the Eastern District typically denies motions to stay for "IPRs that have not been instituted." PO Brief at 17. *Fintiv* factor 1, by contrast, concerns only whether "evidence exists that [a stay] may be granted if a proceeding is instituted." *Fintiv* at 6. Thus, Patent Owner's speculation about whether the court would grant stay prior to institution is irrelevant.

This factor is therefore neutral.

b. Factor 2: Weighs Against Denial (Final Written Decision Before Trial Date)

As discussed above in Reason #4, the Patent Owner is wrong when it argues that "the anticipated trial date is scheduled around the expected FWD date." PO Brief, 19. There is no case schedule or trial date in the related litigation. There are no preliminary infringement contentions. Nothing has happened in the related litigation other than the motion to dismiss briefing. However, even if the Patent Owner was correct, this factor still weighs against discretionary denial where the

district court trial and IPR Final Written Decision are expected “around the same time.” *Fintiv*, 9.

Accordingly, factor 2 weighs against denial.

c. **Factor 3 Weighs Against Denial (Minimal Relevant Investment and Expeditious Filing)**

Factor 3 likewise weighs against denial. At present there are no deadlines for infringement or invalidity contentions, claim construction, or any substantive or discovery matter. In fact, the Patent Owner has not yet finalized which claims to assert in the litigation; to the contrary, it has expressly reserved its right to assert additional claims. PO Brief at 7.

Patent Owner's Request for Discretionary Denial projects that discovery will have begun by the expected institution date (PO Brief, 22), but this is pure speculation – again, the only activity in the case is in regard to a pending motion to dismiss that must be considered. Ex.2004. Under *Fintiv*, “[i]f, at the time of the institution decision, the district court has not issued orders ***related to the patent at issue in the petition***, this fact weighs against exercising discretion to deny institution.” *Fintiv* at 10.

The Patent Owner also refers to other lawsuits that do not name either Petitioner. PO Brief, 5, 7. But these lawsuits are irrelevant under *Fintiv* factor 3,

which relates only to “investment in the parallel proceeding by the court and parties” (*Fintiv* at 9), not to any other lawsuit not involving the Petitioner. The other lawsuits have different, unrelated defendants, and also have different claims being asserted and different products being accused (*i.e.*, different issues). *Fintiv*, 13-14; *see also*, Ex.1023; Ex.1031, Ex.1033.

Finally, this factor weighs against denial because “the petitioner filed the petition expeditiously.” *Fintiv* at 11. As discussed above at Reason #4(d), the Patent Owner filed the third and most recent complaint on December 20, 2024 (Ex. 2003), which is just three months before the filing of the present IPR petition. The present IPR petition was thus filed early, shortly after the most recent complaint and well before having the benefit of any infringement contentions. *Fintiv* at 11 (Petitioner is diligent if “petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted”). Recent panels agreed that similar diligence is reasonable and weighs against denial. *See Samsung Elecs. Co., Ltd. v. Mullen Industries LLC*, IPR2024-01472, Paper 9 at 10 (Mar. 31, 2025) (“Petitioner’s diligence in filing its Petition (a) less than five months after receiving Patent Owner’s infringement contentions and (b) prior to the parties briefing claim construction issues weighs against exercising discretionary denial.”).

Accordingly, factor 3 weighs against denial.

d. Factor 4: Weighs Against Denial (*Sotera* Stipulation)

Factor 4 weighs against denial because a *Sotera* stipulation has been filed in district court prior to filing the IPR. Ex. 1024. Specifically, the stipulation states:

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 LGL's Petition in [this IPR], LGL will not pursue an invalidity defense in the above-captioned 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 the 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).

Id.; *see also*, Petition, Paper 3, 86. Accordingly, factor 4 weighs heavily against denial.

Patent Owner advances several reasons to allege that factor 4 weighs against institution. PO Brief, 24-26. **First**, Patent Owner argues that the claims overlap between the trial and IPR. But this issue is resolved by the above-mentioned *Sotera* stipulation. *Id.*, 24. And Patent Owner's argument that it might assert additional claims demonstrates nothing more than the early stages of litigation.

Second, Patent Owner alleges (incorrectly) that the "*Sotera* stipulation does

not sufficiently mitigate any concerns of duplicative efforts between the District Court and the Board,” because LGL allegedly reserves the right to “pick and choose different primary and secondary references with similar teachings to create new grounds.” *Id.*, 25 (citing Ex.2013, 1). Patent Owner misunderstands LGL’s position. A *Sotera* stipulation allows a party to assert in district court any other ground that is not based solely on prior art patents or printed publications.

Such a stipulation “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions” and “ensures that an *inter partes* review is a ‘true alternative’ to the district court proceeding.” *Sotera* , 19. This holding by the Board was recently reaffirmed as a binding precedent. *See* Ex.1032 (USPTO Notice rescinding the June 21, 2022, memorandum entitled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation.”). The Federal Circuit has also confirmed that “Congress intentionally limited an IPR’s scope to invalidity challenges based on ‘prior art consisting of patents or printed publications.’” *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365 (Fed. Cir. 2025). As such, Patent Owner’s allegation that a *Sotera* stipulation will not prevent duplicative arguments is in direct conflict with operative Board and Federal Circuit precedents.

Third, Patent Owner also refers to the effect of the stipulation on “other parallel litigations.” *Id.*, 25-26. As discussed above, these other parallel litigations have different, unrelated defendants. Also, different claims are being asserted and different products are being accused (i.e., different issues). *Fintiv*, 13-14; *see also*, Ex.1023; Ex.1031, Ex.1033.

Patent Owner seeks to remove system prior art from being available in the parallel litigation under the guise of “mitigat[ing] any duplicative efforts between the district court and the Board.” *Sotera* at 8. System art-based invalidity grounds, however, would not and cannot have been considered by the Board.

Accordingly, Patent Owner's arguments regarding factor 4 are defective, and as discussed above, factor 4 weighs against denial.

e. **Factor 5 Weighs Against Denial: Whether Petitioner and Defendant are the Same Party**

Fintiv factor 5 is dependent on the trial date and the final written decision (FWD) of the IPR, and if they are “**around**” the same time, the factor weighs against denial even if the Petitioner is the Defendant. *NVIDIA Corp. v. Invensas Corp.*, IPR2020-00603, Paper 11 at 23 (Sept. 3, 2020)(Discussing *Fintiv* factor 5: “Because NVIDIA is the same party in both district court case and this proceeding, and we are likely to reach the merits **at or around** the same time as the district

court, this factor *weighs slightly against discretionary denial.*").

As discussed above, the Patent Owner is wrong when it argues that “the anticipated trial date is scheduled **around** the expected FWD date.” PO Brief, 19. There is no case schedule or trial date in the related litigation. There are no preliminary infringement contentions. Nothing has happened in the related litigation other than the motion to dismiss briefing. That said, even if the Patent Owner was correct about the anticipated trial date, this factor still weighs against discretionary denial.

f. **Factor 6 Weighs Against Denial: The Merits of the Petition Remain Strong**

Factor 6 weighs against denial because the Petition plainly shows that the '720 patent claims no more than well-known subject matter. As discussed in Reason #1 above, the Petition demonstrates that Walton teaches the purported invention prior to the priority date of the patent.

Patent Owner fails to address *any* alleged substantive weakness with Walton. Instead, the Patent Owner's sole argument is that the IPR petition includes “extensive reliance on expert testimony.” PO Brief, 12-14. The expert declaration is provided to present the position of a POSITA, and does not weaken the clear teachings of Walton. *See also*, discussion at Reason #7 below.

g. Conclusion Regarding *Fintiv*

Thus, *Fintiv* weighs against denial because the trial date (if scheduled) must occur after the final written decision, and because the *Fintiv* factors as a whole weigh against denial.

6. § 314(d) and §325(d) Do Not Support Denial

The Patent Owner makes arguments under 35 U.S.C. § 314(d) and § 325(d) referring to the co-pending reexamination. PO Brief, 28-34. As discussed in Reasons #1 and #2 above, the IPR petition addresses different claim sets than the reexamination and uses prior art that was expressly not considered in the reexamination. Further, the prior art in the IPR petition is different from (and stronger than) the art previously considered by the Office because it directly teaches the claim limitation that was identified by the Examiner in his reasons for patentability.

7. The Expert Report Is Proper

Beginning at page 12 of the PO Brief, the Patent Owner argues that the IPR petition has extensive reliance on expert testimony, but has not suggested that there are any disputes between experts. As for the alleged “gaps” filled by the expert, Patent Owner's selective quotes (PO Brief at 13) are misleading. In every instance, Dr. Lansford's testimony is supported by tertiary evidence in the form of prior art

patents or printed publications. *See generally*, Ex.1003. PO points to no claim limitation that is supplied only by expert testimony.

Also, the foundational decisions upon which patent law is based—*Phillips*, *KSR*, etc.—require the adjudicator to evaluate the patent and prior art from the perspective of a POSITA. That perspective is established with evidence, often in the form of expert declarations. Attorney argument is insufficient. Here, Petitioners' expert, Dr. Lansford, provides that perspective with testimony supported by background references in accordance with 37 CFR § 42.65 and *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (Aug. 24, 2022) (precedential).

Accordingly, the Petition's proper reliance on evidence-backed expert testimony to support the unpatentability grounds weighs against denial.

8. Subject Matter Is Well-Suited for the PTAB

The '720 patent is directed to filtering identified frequencies of a wireless transmission signal using an orthogonal frequency division multiplexing protocol. While this technology is likely a difficult subject for non-scientists and non-engineers, it is particularly well-suited for the judges at the PTAB because of their expertise. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015) (“[PTAB] members, because of expertise, may more often find it easier to understand and soundly explain the teachings and suggestions of prior art”); *see*

also, *United States v. Arthrex, Inc.*, 594 U.S. 1, 41, (2021) (“Given the technical nature of patents, the need for expertise, and the importance of avoiding political interference, Congress chose to grant the APJs a degree of independence”); *Daiichi Sankyo, Inc. v. Vidal*, 681 F. Supp. 3d 490, 495 (E.D. Va. 2023) (“Post-grant and *inter partes* review are advantageous over district court litigation because they are conducted by Board panels of APJs who have relevant subject matter expertise for adjudicating complex scientific disputes compared to federal judges or lay jurors”)(emphasis added).

9. Compelling Economic Interests Favor Institution

The United States has compelling national economic interests in affording Petitioners Intel and Lenovo the opportunity to challenge the '720 patent under the IPR framework. The '720 patent is being asserted against devices that utilize the IEEE 802.11ac Wi-Fi standard (Ex.1023) and that are critical to communications across the country, and it is in our country's national economic interest for such devices to be affordable.

Wi-Fi devices are widely used by schools, emergency service providers, and others that require a reliable communication infrastructure. For example, Lenovo offers FirstNet Ready devices for emergency environments, and mobile use of these devices is an important part of supporting frontline personnel. *See*,

www.firstnet.com/devices/tablets.html. In sum, the present proceeding supports the national interest for a review of the '720 Patent to avoid negatively impacting the availability and pricing of such important products.

10. Real Parties in Interest

Patent Owner speculates that the IPR does not properly identify all of the real parties in interest (RPIs). (PO Brief at 34). Petitioners submit in good faith that their listing of RPIs as presented in the Mandatory Notices section of the petition is correct. See Petition, Paper 3, 88. Further, the Patent Owner has not shown that this issue is ripe for consideration. See *SharkNinja Operations LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 at 18 (PTAB Oct. 6, 2020), citing *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, IPR2015-00739, Paper 38 at 6 (PTAB Mar. 4, 2016) (precedential).

11. The New Interim Process Should Not Govern the Decision

Petitioners also respectfully submit that the standards articulated in the June 2022 Procedures should apply to this Petition, until the Director issues new regulations in accordance with 35 U.S.C. § 316 and the Administrative Procedure Act ("APA").

As the Director knows, significant changes to applicable standards were announced in March 2025, beginning with the March 24, 2025 Memorandum of

Chief Administrative Patent Judge Scott Boalick (the “Boalick Memo”) and the March 26, 2025 Memorandum of Acting Director Stewart (the “Director Memo”). The Director Memo introduced an entirely new “interim process” that bifurcates institution between “(i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations.” Director Memo, 1 (Ex.1034). Under this new procedure, “the Director, in consultation with at least three PTAB judges” will determine whether discretionary denial is appropriate based on “all relevant considerations,” including several newly enumerated factors. *Id.* Three weeks after the Director Memo issued, the USPTO held an oral webcast setting forth additional substantive details of the new interim procedure not found in the Director Memo. Then, eight days after the webcast, the USPTO posted on its website “FAQs for Interim Processes for PTAB Workload Management” (Ex.1035) with even more substantive details, some potentially in conflict with details provided during the oral webcast.

Petitioners respectfully submit that these new procedures—as announced in the Boalick Memo, the Director Memo, the oral webcast, and the FAQs (collectively, the “Announcements”)—fall short of satisfying the requisite statutory and due process obligations of the USPTO.

By way of example, 35 U.S.C. § 316(a) mandates that “[t]he **Director shall**

prescribe **regulations**” including regulations “(2) setting forth the standards for the showing of sufficient grounds to institute a review under section 314(a).” The Announcements fall short of 35 U.S.C. § 316(a) by:

- (1) Making changes without going through notice-and-comment rulemaking, particularly given the agency's representation that it will make any further changes to the institution process through notice-and-comment rulemaking. *See* 88 Fed. Reg. 24503 (April 21, 2023). The Announcements violate the notice-and-comment requirements under the APA and are arbitrary and capricious.
- (2) Proposing considerations that lack clarity so that they fail to set “forth the standards for the showing of sufficient grounds to institute review.” 35 U.S.C. § 316(a). For example, many of the new considerations set forth in the Director Memo have no basis in the Patent Act, Federal Circuit law, or PTAB regulations such that petitioners cannot anticipate how the Director will apply them. *See* Ex.1034, 2-3 (“[s]ettled expectations,” “reliance on expert testimony,” “workload,” and “[c]ompelling economic, public health, or national security interests”). Also, these new considerations have recently been applied in an arbitrary and capricious manner.
- (3) Lacking a sufficiently reasoned explanation for the changes in the factors

relevant to institution, including changes that directly contradict the agency's prior guidance in the June 2022 Procedures—such as the controlling effect of a *Sotera* stipulation and the relevance of compelling merits. The passing reference to “efficiency” in the Announcements does not explain how the changes will aid that goal. *See Food & Drug Admin. v. Wages & White Lion Invs., L.L.C.*, 145 S. Ct. 898, 906 (2025) (explaining that when an agency changes position, it must “offer ‘good reasons for the new policy’”); *see also F.C.C. v. Fox Television Stations, Inc.*, 556 U.S. 502, 515 (2009) (agency changing position must show “that the new policy is permissible under the statute, that there are good reasons for it, and that the agency believes it to be better, which the conscious change of course adequately indicates”).

- (4) Applying the oral webcast and FAQs retroactively to petitions filed prior to issuance of the new policies, thereby undermining stakeholders' reliance interests and prejudicing petitioners with respect to strategies between district court and USPTO proceedings. This is particularly true where the retroactive application of a new rule was not first subjected to notice-and-comment rulemaking under the APA, despite the agency's stated intent to follow such procedures. *See NetworkIP, LLC v. F.C.C.*, 548 F.3d 116, 122–

23 (D.C. Cir. 2008).

(5) Creating at least a perception of a lack of transparency in the discretionary stage of the new bifurcated process. For example, a FAQs webpage that may be “frequently” updated “controls the interim processes.” Ex.1035, 1 (encouraging stakeholders to “check back frequently for updates”). *Id.* Further, there is no way for the parties to know who is designated to advise the Director and, thus, whether there are any conflicts of interest or other procedural concerns related to the process.

In the face of this non-exclusive list of deficiencies in the Announcements, Petitioners urge the Board and Director to consider whether to institute based on the standards articulated in the June 2022 Procedures until such time as the Director issues new regulations in accordance with 35 U.S.C. § 316 and the rulemaking procedures of the APA.

For the above reasons, Petitioners respectfully request that the Director refrain from exercising her discretion to deny this petition and instead pass it to a merits panel for consideration.

Opposition to Patent Owner's Request for Discretionary Denial
IPR2025-00838 (U.S. Patent RE47,720)

Respectfully submitted,

Date: August 29, 2025

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PETITIONERS' EXHIBIT LIST

Exhibit	Description
Ex.1001	U.S. Patent No. RE47,720 to J. Burchfiel ("’720 patent")
Ex.1002	Prosecution File History of U.S. Patent Application No. 15/898,404, issued as the ’720 Patent ("’720 File History")
Ex.1003	Declaration of James Lansford, Ph.D. under 37 C.F.R. § 1.68
Ex.1004	Curriculum Vitae of James Lansford, Ph.D.
Ex.1005	U.S. Application Publication No. 2003/0043732 by J. Walton et al. ("Walton")
Ex.1006	U.S. Application Publication No. 2002/0006167 to W. McFarland ("McFarland")
Ex.1007	IEEE Std 802.11a–1999, Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) specifications, High-speed Physical Layer in the 5 GHz Band, Sept. 1999 ("IEEE-802.11a")
Ex.1008	U.S. Application Publication No. 2002/0102940 to R. Bohnke et al. ("Bohnke")
Ex.1009	Prosecution File History of U.S. Patent Application No. 10/689,763, issued as U.S. Patent No. 7,483,711
Ex.1010	U.S. Patent No. 5,726,978 to C. Frodigh et al. ("Frodigh")
Ex.1011	S. Catreux et al., "Adaptive Modulation and MIMO Coding for Broadband Wireless Data Networks," <i>IEEE Communications Magazine</i> , pp. 108-115, June 2002
Ex.1012	App. No. 90/019702, <i>Ex Parte</i> Reexamination of the ’720 patent, Exhibit AA
Ex.1013	U.S. Patent Publication No. 2003/0235147 to J. Walton, et al. ("Walton-2")

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Exhibit	Description
Ex.1014	U.S. Patent No. 7,046,746 to R. Kearney et al.
Ex.1015	R. Van Nee and R. Prasad, <i>OFDM for Wireless Multimedia Communications</i> (2000), Chapters 1 and 2 ("Van-Nee")
Ex.1016	U.S. Patent No. 7,369,841 to C. Uhlik et al.
Ex.1017	A. Seyedi and G. Saulnier, "A Distributed Algorithm for Dynamic Sub-Channel Assignment in a Multi-User OFDM Communication System," <i>Proceedings of the 11th IEEE Signal Processing Workshop on Statistical Signal Processing</i> , Aug. 8, 2001.
Ex.1018	<i>Merriam Webster Collegiate Dictionary Tenth Edition</i> , Merriam-Webster Inc. (1993) (selected pages)
Ex.1019	H. Newton, <i>Newton's Telecom Dictionary</i> , CMP Books (2000) (selected pages)
Ex.1020	Declaration of Sylvia Hall-Ellis
Ex.1021	Declaration of David Ringle
Ex.1022	L. Peterson and B. Davie, <i>Computer Networks: A Systems Approach</i> , Morgan Kaufman Publishers, Inc. (1996) ("Peterson") (Chapter 7)
Ex.1023	Exhibit 2 to Complaint, <i>USTA Technology, LLC v. Lenovo Group Limited et al</i> , 4-24-cv-00515, June 7, 2024
Ex.1024	Lenovo Group Limited's Notice of Sotera Stipulations for U.S. Patent No. RE47,720, <i>USTA Technology, LLC v. Lenovo Group Limited et al</i> , 4-24-cv-00515, Dkt. 60, filed April 25, 2025
Ex.1025	U.S. Patent No. 6,556,553 to B. Palmer et al.
Ex.1026	Joint Rule 26(f) Conference Report, <i>USTA Technology, LLC v. Lenovo Group Limited et al</i> , 4-24-cv-00515, Dkt. 49, March 28, 2025
Ex.1027 NEW	Reexam 90/019,702 Notice of Intent to Issue Reexamination Certificate (NIRC) and Examiner-Signed IDS

Opposition to Patent Owner's Request for Discretionary Denial
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Exhibit	Description
Ex.1028 NEW	Reexam 90/019,702 Patent Owner Response to Office Action
Ex.1029 NEW	Email from Andrew Sherman to Clay Holloway, May 21, 2025
Ex.1030 NEW	Trial Calendar for Judge Jordan, Eastern District of Texas
Ex.1031 NEW	AT&T Infringement Contentions from IPR2025-01166, EX1010
Ex.1032 NEW	USPTO Notice
Ex.1033 NEW	<i>USTA v. AsusTek</i> Complaint, Civ. No. 4:24-cv-512 (EDTX)
Ex.1034 NEW	Director Memorandum
Ex.1035 NEW	FAQs for Interim Processes for PTAB Workload Management
Ex.1036 NEW	Reexam 90/019,702 Petition to Accept Information Disclosure Statement After Issuance of Notice of Intent to Issue <i>Ex Parte</i> Reexamination Certificate (NIRC), August 22, 2025
Ex.1037 NEW	Reexam 90/019,702 Request to Expedite Petition to Accept Information Disclosure Statement After Issuance of Notice of Intent to Issue <i>Ex Parte</i> Reexamination Certificate (NIRC), August 22, 2025
Ex.1038 NEW	Reexam 90/019,702 IDS Submitted on August 22, 2025
Ex.1039 NEW	Reexam 90/019,702 Certificate, August 26, 2025

CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. § 42.6, that service was made on the Patent Owner as detailed below.

Date of service August 29, 2025

Manner of service Electronic Email: asherman@devlinlawfirm.com; ddahlgren@devlinlawfirm.com; and dlflitparas@devlinlawfirm.com.

Documents served **Petitioners' Opposition to Patent Owner's Request for Discretionary Denial; Exhibits Ex.1027-1039.**

Persons served Andrew Sherman
Derek Dahlgren (*pro hac vice* forthcoming)
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