

Case IPR2025-00887
Patent No. 8,995,372
Patent Owner's Preliminary Response

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

PANTECH CORPORATION,
Patent Owner

Case: IPR2025-00887

U.S. Patent No. 8,995,372

PATENT OWNER'S PRELIMINARY RESPONSE

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Patent Trial and Appeal Board
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PATENT OWNER’S EXHIBIT LIST

Exhibit No.	Description
2001	Second Amended Docket Control Order, <i>Pantech Corporation and Pantech Wireless, LLC v. OnePlus Technology (Shenzhen) Co., Ltd.</i> , No. 5:24-CV-00038-RWS-JBB (E.D. Tex.) (Dkt. 58) (May 13, 2025)
2002	United States District Courts – National Judicial Caseload Profile
2003	Pantech Corporation’s July 9, 2021 Notice Letter to OnePlus Technology Co., Ltd.
2004	Third Amended Docket Control Order, <i>Pantech Corporation and Pantech Wireless, LLC v. OnePlus Technology (Shenzhen) Co., Ltd.</i> , No. 5:24-CV-00038-RWS-JBB (E.D. Tex.) (Dkt. 86) (July 17, 2025)
2005	Order Modifying Dates in Docket Control Order, <i>Pantech Corporation and Pantech Wireless, LLC v. OnePlus Technology (Shenzhen) Co., Ltd.</i> , No. 5:24-CV-00038-RWS-JBB (E.D. Tex.) (Dkt. 85) (July 17, 2025)
2006	Jury Verdict, <i>Pantech Corp. v. OnePlus Technology (Shenzhen) Co., Ltd.</i> , No. 5:22-cv-00069-RWS (E.D. Tex.) (Dkt. 259) (April 1, 2024)
2007	Final Judgment, <i>Pantech Corp. v. OnePlus Technology (Shenzhen) Co., Ltd.</i> , No. 5:22-cv-00069-RWS (E.D. Tex.) (Dkt. 499) (Jan. 23, 2025)
2008	Kiri Gupta & Urska Petrovcic, <i>Evidence of Systematic “Patent Holdout”</i> , 38 Berkeley Tech. L. J. (2023)

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2009	Richard A. Epstein & Kayvan B. Noroozi, <i>Why Incentives for “Patent Holdout” Threaten to Dismantle FRAND, and Why It Matters</i> , 32 Berkeley Tech. L.J. 1381 (2017)
2010	Kalyan Dasgupta & David J. Teece, <i>Protecting Innovation in the Mobile Wireless Ecosystem: Understanding & Addressing “Hold-Out”</i> , 38 Berkeley Tech. L.J. 313 (2023)
2011	<i>Markman Order, Pantech Corporation and Pantech Wireless, LLC v. OnePlus Technology (Shenzhen) Co., Ltd.</i> , No. 5:24-CV-00038-RWS-JBB (E.D. Tex.) (Dkt. 90) (July 30, 2025)
2012	<i>Pantech Corp. et al. v. OnePlus Tech. (Shenzhen) Co., Ltd.</i> , No. 5:24-cv-00038-RWS-JBB, Dkt. 95 (E.D. Tex. Aug. 14, 2025) (Defendant OnePlus Technology (Shenzhen) Co., Ltd.’s Abridged Objections to the Order on Claim Construction)
2013	3GPP TS 36.133 V10.0.0 (Requirements for support of radio resource management)

I. INTRODUCTION

Patent Owner Pantech Corporation (“Pantech”) respectfully requests that United States Patent and Trademark Office (“USPTO” or the “Office”) Patent Trial and Appeal Board (“PTAB” or the “Board”) deny institution of *inter partes* review of claims 1-4, 7-11, and 14 (the “challenged claims”) of U.S. Patent No. 8,995,372 (“the ’372 Patent”). Petitioner OnePlus Technology (Shenzhen) Co., Ltd.’s (“Petitioner” or “OnePlus”) has failed to demonstrate a reasonable likelihood of prevailing with respect to at least one challenged claim.

First, as a threshold issue, the Petition violates the requirements of both 37 C.F.R. § 42.104(b)(3) and (4), because the Petition fails to set forth or support clear constructions for terms that it sought to construe in the parallel District Court matter (a violation of 37 C.F.R. § 42.104(b)(3)), and also fails to apply the constructions that it does propose (a violation of 37 C.F.R. § 42.104(b)(4)). This is a critical issue that is explained in detail below.

Additionally, Petitioner’s primary reference for all Grounds—Tenny—is not prior art and lacks critical elements of the independent challenged claims, and these critical deficiencies are not overcome by the secondary reference relied upon for the independent claims under a theory of obviousness. Tenny in view of Huawei fails to render obvious each challenged claim of the ’372 Patent, which require “configuring

a uplink (UL) timing group including CCs having the same timing advance (TA) value.” *See* ’372 Patent at independent claims 1 and 8.

Accordingly, Petitioner has failed to meet its burden of showing a reasonable likelihood of prevailing with respect to the invalidity of any of the challenged claims. The Board should deny Petitioner’s request to institute *inter partes* review.

II. BACKGROUND

A. Background of the ’372 Patent

The ’372 Patent relates to the field of wireless communications. More particularly, the invention of the ’372 Patent relates to equipment and methods for performing random access in a communication system that supports a plurality of component carriers. ’372 Patent at 1:15-19. The invention of the ’372 Patent is directed to providing effective synchronization in a wireless communication including a plurality of component carriers. ’372 Patent at 1:32-35.

The ’372 Patent is entitled “Apparatus and method for performing random access in a wireless communication system,” issued on March 31, 2015, and claims priority to KR 10-2010-0027782, filed on March 29, 2010.

B. Summary of Petitioner’s Proposed Grounds for Unpatentability

Petitioner contends that claims 1-4, 7-11, and 14 of the ’372 Patent would have been obvious under pre-AIA 35 U.S.C. § 103. The Petition raises four grounds of alleged unpatentability based on the following references:

1. U.S. Patent Application Publication No. 2011/0158116 (“Tenny ’116”);
2. 3GPP Technical Document R2-100110 (“Huawei”);
3. U.S. Patent Application Publication No. 2010/0303039 (“Zhang”);
4. U.S. Patent No. 9,426,765 (“Wang ’765”);
5. 3GPP Technical Document R2-100372 (“Nokia”).

The specific grounds of alleged invalidity are summarized as follows:

Ground	Basis	Claims	References
1	§103 (pre-AIA)	1 and 8	Tenny in view of Huawei
2	§103 (pre-AIA)	2 and 9	Tenny in view of Huawei and Zhang
3	§103 (pre-AIA)	3, 4, 10, and 11	Tenny in view of Huawei and Wang
4	§103 (pre-AIA)	7 and 14	Tenny in view of Huawei and Nokia

C. Petitioner’s Relied-Upon References

The five references relied upon by Petitioner are summarized as follows:

1. *Overview of Tenny ’116 (Ex. 1004)*

U.S. Patent Application Publication No. 2011/0158116 (“Tenny ’116”) is a patent application entitled “Method and apparatus that facilitates a timing alignment in a multicarrier system.” Tenny ’116 was filed on June 17, 2010 and published on

June 30, 2011. Tenny '116 purports to disclose “methods and apparatuses that facilitate maintaining timing synchronization for user equipment in a multicarrier Long Term Evolution-Advanced (LTE-A) system.” EX1004 at ¶ [0003].

Tenny '116 claims priority to, *inter alia*, U.S. Provisional Application No. 61/218,769 (“Tenny-Prov”) (EX1005), filed June 19, 2009. Tenny-Prov is entitled “Timing Alignment in a Multicarrier System” and relates to “systems and methods for multicarrier timing alignment.” EX1005 at 1.

2. Overview of Huawei (Ex. 1006)

3GPP Technical Document R2-100110 (“Huawei”) is a submission to 3GPP’s servers on January 12, 2010 from Huawei. EX1006. Huawei is associated with 3GPP TSG RAN WG2 Meeting #68bis. *Id.* Huawei’s title is “Multiple Timing Advance Impact on RAN2.” *Id.*

3. Overview of Zhang (Ex. 1007)

U.S. Patent Application Publication No. 2010/0303039 (“Zhang”) is a patent application entitled “Method and apparatus for performing component carrier-specific reconfiguration.” Zhang was filed on March 12, 2010 and published on December 2, 2010. Zhang purports to disclose “component carrier-specific reconfiguration” schemes. EX1007 at ¶ [0022].

4. Overview of Wang '765 (Ex. 1008)

U.S. Patent No. 9,426,765 (“Wang '765”) is an issued patent entitled “Method

of handling uplink synchronization and related communication device.” Wang ’765 was filed on January 10, 2011 and was issued on August 23, 2016. Wang ’765 purports to disclose a “method of handling uplink synchronization in a wireless communication system and a related communication device.” EX1008 at 1:19-21.

Wang ’765 claims priority to U.S. Provisional Application No. 61/293,871 (“Wang-Prov”) (EX1009), filed January 11, 2010. Wang-Prov is entitled “Methods and System for Multiple Uplink Timing Synchronization.” EX1009.

5. *Overview of Nokia (Ex. 1010)*

3GPP Technical Document R2-100372 (“Nokia”) is a submission to 3GPP’s servers on January 12, 2010 from Nokia Corporation and Nokia Siemens Networks. EX1010. Nokia is associated with 3GPP TSG-RAN WG2 Meeting #68bis. *Id.* Nokia’s title is “RACH and carrier aggregation.” *Id.*

III. CLAIM CONSTRUCTION

The Petition contains two fatal defects under 37 C.F.R. § 42.104(b)(3)-(4). Together, these sections require that Petitioner provide a clear statement regarding: (1) both “[h]ow the challenged claim is to be construed” and “[w]here the claim to be construed contains a means-plus function or step-plus-function limitation..., the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function” (37 C.F.R. § 42.104(b)(3)) and (2) “[h]ow the construed claim is unpatentable” (37

C.F.R. § 42.104(b)(4)). Petitioner has failed to satisfy both of these requirements, and the Board should deny the Petition due to these fatal deficiencies.

First, Petitioner has differed from the parallel District Court Action (*Pantech Corp. et al. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, No. 5:24-cv-00038-RWS-JBB (E.D. Tex.)) to offer new and ill-defined constructions without justification. *See* Pet. 20-21.

In the parallel District Court Action, Petitioner proposed the function of “configure a uplink (UL) timing group including at least one of component carriers (CCs) having a difference in center frequencies within a threshold range, CCs having the same beamforming scheme, CCs having the same timing advance (TA) value, and CCs having the same reference downlink (DL) CC to be used for obtaining a TA value, from among a plurality of CCs” for the “a uplink timing group configuring unit...” term. *See* EX2011 (*Markman* order) at 30. Petitioner also proposed the function of “set a CC satisfying at least one of a CC having a lowest center frequency value, a CC having a center frequency value that is closest to a mean value, a CC having a highest center frequency, a CC having a broadest frequency band, a CC in which a radio link monitoring (RLM) is defined, in the configured UL timing group as a delegate CC” for the “a delegate CC setting unit...” term. *Id.* at 33. The Magistrate Judge rejected both of Petitioner’s proposed constructions (*id.* at 38), and

Petitioner has now objected to this ruling under Federal Rule of Civil Procedure 71(a), an objection which is currently pending. *See* EX2012.

But Petitioner here offers different, ill-defined functions for these terms, plagued by ellipses that make the proposed functions unclear:

Claim Term	Petitioner's Proposed Construction
#1	MPF claim limitation under 35 U.S.C § 112, paragraph 6 Function: configure an uplink (UL) timing group including ... from among a plurality of CCs Corresponding Structure: hardware of the UE that implements Function above. <i>See</i> EX1001, 8:23-26, 14:20-23, 16:15-18, 17:52-55, 18:54-57, 32:31-37, 33:51-56, FIGs. 15-16; EX1003, ¶69.
#2	MPF claim limitation under 35 U.S.C § 112, paragraph 6 Function: set a CC satisfying ... in the configured UL timing group as a delegate CC Corresponding Structure: hardware of the UE that implements the Function above. <i>See</i> EX1001, 8:23-26, 14:20-23, 16:15-18, 17:52-55, 18:54-57; EX1003, ¶70.

Pet. at 20-21. The unclarity of the functions being proposed is itself a violation of the requirements of 37 C.F.R. § 42.104(b)(3) to identify “[h]ow the challenged claim is to be construed.” *See CallMiner, Inc. v. Mattersight Corporation*, IPR2020-00272, Paper 8 at 9 (PTAB June 18, 2020) (“Construing a means-plus-function limitation under 35 U.S.C. § 112 ¶ 6 involves... identifying the claimed function”).

Petitioner offers no justification for departing from the constructions it is currently pursuing in the District Court matter, other than to say that there is no rule

prohibiting petitioner from taking inconsistent claim construction positions before the Board and a district court. *See* Pet. at 21 at 8 (citing *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 (PTAB Dec. 13, 2024)). But an absence of a blanket legal prohibition is not a justification—after all, *Cambridge Mobile Telematics* denied the petition for failing to satisfy 37 C.F.R. § 42.104(b)(3) even if it did not set forth a blanket prohibition against inconsistent positions—and Petitioner also provides no reasoning or support for the constructions that it now sets forth.

Furthermore, regardless of which functions are proffered here, Petitioner is also under an obligation to “identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function” (37 C.F.R. § 42.104(b)(3)). It fails to do so—no actual structure is identified. This is another violation of 37 C.F.R. § 42.104(b)(3), separate from Petitioner not clearly identifying the corresponding functions that it proposes. *See CallMiner, Inc. v. Mattersight Corporation*, IPR2020-00272, Paper 8 at 9 (PTAB June 18, 2020) (“Although Petitioner lists portions of the ’639 patent for the alleged structure of the

means-plus-function terms [] Petitioner fails to explain or identify what the structure is.”).¹

Accordingly, Petitioner is not clear in the constructions that it proposes, in violation of 37 C.F.R. § 42.104(b)(3), and the Petition should be denied on this basis.

Second, as explained below in more detail in Section V.A, Petitioner also does not apply its own proposed constructions in its proposed grounds. Petitioner was

¹ Petitioner cites to the Declaration of Dr. Akl (EX1003) for the supposedly supporting structure (*see* Pet. at 20-21), but Dr. Akl merely says “I offer a possible corresponding construction of claim term [#1 / #2], which is the hardware of the UE that implements the function” and goes on to provide the same string cite of ’372 Patent passages as exists in the Petition without explanation. *See* EX1003 at ¶¶ 69-70. This is insufficient as a basis for a claim construction. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 (PTAB Feb. 10, 2023) (precedential) (accorded “little weight” to declaration testimony that contains a verbatim restatement of a petition’s conclusory assertions); *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1340–41 (Fed. Cir. 2020) (affirming Board decision giving no weight to expert testimony that “merely repeated Petitioner’s argument, nearly verbatim, without citation to the basis for his testimony”).

required to explain “[h]ow the construed claim is unpatentable” (37 C.F.R. § 42.104(b)(4)), but it failed to apply its own proposed constructions to these claims.

For this additional reason, the Petition should be denied.

For purposes of this Preliminary Response, Patent Owner applies the Magistrate Judge’s construction of these terms, for the reasons set forth in the Magistrate Judge’s order. *See* EX2011 at 30-33. Therefore, Patent Owner applies the following constructions:

Term	Construction
“a uplink timing group configuring unit to configure a uplink (UL) timing group including at least one of component carriers (CCs) having a difference in center frequencies within a thresh-old range, CCs having the same beamforming scheme, CCs having the same timing advance (TA) value, and CCs having the same reference downlink (DL) CC to be used for obtaining a TA value, from among a plurality of CCs” (’372 Patent, Claim 8)	“a processor programmed to configure a uplink (UL) timing group including at least one of component carriers (CCs) having a difference in center frequencies within a threshold range, CCs having the same beamforming scheme, CCs having the same timing advance (TA) value, and CCs having the same reference downlink (DL) CC to be used for obtaining a TA value, from among a plurality of CCs”

“a delegate CC setting unit to set a CC satisfying at least one of a CC having a lowest center frequency value, a CC having a center frequency value that is closest to a mean value, a CC having a highest center frequency, a CC having a broadest frequency band, a CC in which a radio link monitoring (RLM) is defined, in the configured UL timing group as a delegate CC” (’372 Patent, Claim 8)	“a processor programmed to set a CC satisfying at least one of a CC having a lowest center frequency value, a CC having a center frequency value that is closest to a mean value, a CC having a highest center frequency, a CC having a broadest frequency band, a CC in which a radio link monitoring (RLM) is defined, in the configured UL timing group as a delegate CC”
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EX2011 at 38.

IV. LEGAL STANDARD FOR OBVIOUSNESS UNDER 35 U.S.C. § 103

A claim is not patentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious to a person of ordinary skill in the art at the time of the invention. 35 U.S.C. § 103(a). Obviousness requires assessing (1) the “level of ordinary skill in the pertinent art,” (2) the “scope and content of the prior art,” (3) the “differences between the prior art and the claims at issue,” and (4) “secondary considerations” of non-obviousness such as “commercial success, long felt but unsolved needs, failure of others, etc.” *KSR Int’l*

Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)).

It is a petitioner’s burden “to demonstrate both ‘that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.’” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016) (quotations and citations omitted). However, a petitioner must first show that all of the claimed elements are disclosed in the prior art. *See Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006) (considering motivation to combine and reasonable expectation of success only “if all the elements of an invention are found in a combination of prior art references”).

V. THE PETITION DOES NOT SHOW A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY CHALLENGED CLAIM

In addition to the grounds already presented in Patent Owner’s Request for Discretionary Denial, institution should be denied because Petitioner does not establish a reasonable likelihood of prevailing against any challenged claim.

A. Petitioner Fails to Support or Apply Its Own Claim Constructions

Petitioner has failed to apply its own proposed claim constructions for the “a uplink timing group configuring unit...” and “a delegate CC setting unit...” terms,

in violation of 37 C.F.R. § 42.104(b)(4). After setting forth means-plus-function structures for each of these terms (*see* Pet. at 20-21), albeit without reasoning or support, Petitioner proceeds to pay no more than lip service to these proposed constructions.

Regarding the “a uplink timing group configuring unit... ” limitation, Petitioner proposes a corresponding structure (to the extent this is a sufficient identification of structure) of “*hardware of the UE that implements Function above. See EX1001, 8:23-26, 14:20-23, 16:15-18, 17:52-55, 18:54-57, 32:31-37, 33:51-56, FIGs. 15-16.*” *See* Pet. at 20.

But when discussing this claim limitation in the context of the asserted Grounds, Petitioner ignores this structure. Petitioner first argues that “this limitation is disclosed by Tenny under the Patent Owner’s construction of plain and ordinary meaning” (Pet. at 38) (thereby not applying its own claim construction) before offering the following short and conclusory argument:

Tenny also discloses this limitation under Petitioner’s proposal to construe this limitation as a means-plus-function term. *See* Section VI (Claim Constructions); EX1003, ¶138. Wireless device 302 in Tenny is equivalent to the UE in the ’372 patent; and carrier grouping component 304 configures an UL timing group including CCs with the same or similar uplink timings, which is also the function of the “uplink timing group configuring unit” of this limitation. *See* Section VII.D.2 ([1.a]);

EX1003, ¶138. Further, the hardware of wireless device 302 that implements carrier grouping component 304 is also taught by Tenny, thereby disclosing the corresponding structure of this limitation as well.

EX1004, ¶¶120-121, 123; EX1005, ¶¶44-47; EX1003, ¶138.

Pet. at 39. None of this argument addresses the proposed structure.

To begin with, “configures an UL timing group including CCs with the same or similar uplink timings,” as discussed in Petitioner’s argument (Pet. at 39), is not the function proposed by Petitioner in either the parallel District Court action or for this Petition (*see* Pet. at 20). The actual function proposed by Petitioner, while the ellipses make the function unclear, is “configure an uplink (UL) timing group including ... from among a plurality of CCs.” *Id.* Petitioner’s proposed function is not applied by Petitioner or its expert. Pet. at 39; EX1003 at ¶ 138.

Additionally, Petitioner does not discuss **at all** the requisite structure from its own construction, which is “hardware of the UE that implements Function above. *See* EX1001, 8:23-26, 14:20-23, 16:15-18, 17:52-55, 18:54-57, 32:31-37, 33:51-56, FIGs. 15-16.” Pet. at 20. Petitioner, and its expert (*see* EX1003 at ¶¶ 143-44), do not discuss at all what this structure is, or how it matches **any** structure in Tenny. Pet. at 39.

The exact same deficiencies plague Petitioner’s argument for the “a delegate CC setting unit...” term, including failing to apply Petitioner’s own proposed

structure (*see* Pet. at 41; EX1003 at ¶ 144) and failing to discuss at all what the corresponding structure of the '372 Patent actually is or how it matches any structure in Tenny (*see* Pet. at 41; EX1003 at ¶ 144).

Thus, Petitioner has violated 37 C.F.R. § 42.104(b)(4), and on this basis institution should be denied.

B. Tenny '116 is Not Prior Art to the Challenged Claims

Each of Grounds 1-5 fails because the only primary reference that Petitioner relies upon—Tenny '116—is not prior art to the challenged claims.

1. Priority Date of the Challenged Claims

To begin with, Petitioner reads its own cited authority incorrectly, and it is wrong that it “is Patent Owner’s burden to establish that the claims are entitled to the priority dates of the earlier-filed application.” *See* Pet. at 18. It is Petitioner that bears the ultimate burden of proving invalidity, and this burden includes showing that the challenged claims are **not** entitled to a priority date antecedent to its proposed prior art: if a Patent Owner provides evidence and argument supporting a claim of priority, “the burden [] shifts to the proponent of the invalidity defense [] to convince the court that [the patent claim] is not entitled to the benefit of the earlier filing date.” *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1379–80 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)).

Petitioner alleges that Korean priority application KR 10-2010-0027782 does not “provide written description support to claims 1 and 8 because it does not disclose at least ‘*set[ting] a CC satisfying at least one of ... a CC in which a radio link monitoring (RLM) is defined.*’” See Pet. at 17. Petitioner is wrong.

As Petitioner acknowledges, the ’782 Application discloses that “when the UE configures a representative CC in a group including a primary CC (hereinafter referred to as 'PCC'), the UE may set the PCC as a representative CC in the group regardless of the eNB’s standard. See EX1014 at 7 (highlighted portion); Pet. at 17. The ’782 Application also discloses the following regarding its use of “component carriers” (CCs):

[T]he wireless communication system to which the present invention is applied is an example of a LTE-Advanced (LTE-A) system as a next-generation communication system recently discussed. The LTE-Advanced (LTE-A) system is a scheme for extending a bandwidth for satisfying system requirements, that is, a high data rate required by LTE-A, and includes a component carrier or component that is a plurality of unit carriers. The use of a carrier (Component Carrier, CC) is defined.

[...]

In addition, it is possible to define the use of a carrier aggregation (hereinafter referred to as “CA”) that combines up to five of one component carrier (Component Carriers) to use as one system band.

EX1014 at 4. Thus, the inventors of the '372 Patent clearly possessed a meaning of component carriers at the time of the '782 Application that was consistent with the LTE-A standard.

The first release of the LTE-A standard states under “Radio Link Monitoring” that “[t]he UE shall monitor the downlink link quality based on the cell-specific reference signal in order to detect the downlink radio link quality of the serving cell as specified in [3].” *See* EX2013 at § 7.6.1 (Introduction to Radio Link Monitoring).

Thus, a POSITA would understand that by disclosing the setting of a primary CC within a group of CCs as a representative CC within the context of LTE-A, the inventors of the '372 Patent were disclosing “setting a CC [] in which a radio link monitoring (RLM) is defined” (claims 8 and 12).

For purposes of written description support, “the test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (en banc). Furthermore, it is well established that there is no requirement that “the specification recite the claimed invention *in haec verba*.” *Id.*; *see also LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005) (“[T]he patent specification is written for a person of skill in the art, and such

a person comes to the patent with the knowledge of what has come before
Placed in that context, it is unnecessary to spell out every detail of the invention in the specification; only enough must be included to convince a person of skill in the art that the inventor possessed the invention and to enable such a person to make and use the invention without undue experimentation.”).

Accordingly, there is written description support for the claims of the ’372 Patent within the ’782 Application, and they are entitled to a priority date of at least August 13, 2010.

2. *Tenny ’116 is not Prior Art to the Challenged Claims Absent Disclosures in Tenny-Prov*

Petitioner appears to not dispute that, as a matter of law, “the provisional application must [] provide written description support for the specific portions of the patent specification identified and relied on in the prior art rejection.” *See In re Riggs*, 131 F.4th 1377, 1384 (Fed. Cir. 2025); Pet. at 4-5.

Accordingly, in view of the correct priority date of the ’372 Patent, all portions of Tenny ’116 relied upon by Petitioner must be supported by Tenny-Prov. This is not the case.

3. *Tenny-Prov Does Not Disclose “configuring a[n] uplink (UL) timing group including CCs having the same timing advance (TA) value” as required by claims 1 and 8*

Petitioner contends that claim elements [1.a] and [8.a] are satisfied by Tenny

alone because:

If “timing offsets” or “timing differences” of a set of CCs are within a threshold range, which means that the uplink timings of the CCs in each group are “close enough,” the set of CCs can be configured into the same “timing group” that shares “a single timing advance value.” EX1004, ¶¶65, 70; EX1005, Appx. A (5:3-5); EX1017, 34 (§6.1.3.5) and 38 (§6.2.3) (each timing advance command indicating a timing advance value); EX1003, ¶¶118-119.

Pet. at 33-34; *see also* Pet. at 38-9 (invoking discussion “in Section VII.D.2” concerning element [1.a] with regard to element [8.a], with no further discussion of support in Tenny-Prov for this portion of the limitation). No other basis of satisfying claim elements [1.a] or [8.a] is provided.

But at least Tenny-Prov does not satisfy the claim requirement. Tenny-Prov at Appx. A (5:3-5) provides the following:

In a “degenerate” form of this vector approach, the network could opt to send only a single timing advance command per MAC element, but indicate which timing group the value is associated with. This approach would minimise *[sic]* the specification impact to the concerned MAC control element, since the existing information only needs to be augmented by a group identifier.

EX1005 at Appx. A (5:3-6) (an additional line is quoted to complete a sentence). This is not a disclosure of configuring a uplink (UL) timing group including CCs

having the same timing advance (TA) value—no disclosure of configuring such a group at all is disclosed.

Dr. Akl’s declaration cannot cure this deficiency, as he provides just a nearly verbatim recitation of the petition without any additional explanation or support.

Accordingly, support for claim element [1.a] and [8.a] (each independent claim) is not found in Tenny-Prov, and Petitioner therefore cannot succeed with regard to any Ground, each of which relies on only Tenny for this claim element for all challenged claims.

4. *Tenny-Prov in View of Huawei Does Not Support Claim Element [1.b]*

Petitioner argues that “Tenny in view of Huawei” renders obvious claim element [1.b]. *See* Pet. at 35-36. This is incorrect.

Petitioner seems to implicitly admit that this disclosure is lacking in Tenny-Prov because it suggests it would have been obvious for a POSITA considering Tenny to look to Huawei to satisfy this claim element. *Id.* Petitioner even refers to Huawei’s disclosures as “Huawei’s delegate CC selection method.” *Id.* at 36. But Huawei does not disclose what Petitioner asserts that it does.

In Section 2.2.4 of Huawei, cited by Petitioner, Huawei discloses “to choose one [CC] with lowest frequency to perform RACH” (*see* EX1006 at § 2.2.4), but makes no disclosure or suggestion of setting such a CC as a delegate CC. *See*

EX1006 at § 2.2.4. Petitioner cites no way that it does, and aside from calling Huawei a “delegate CC selection method,” provides no reasons why it is one. Even Petitioner’s expert makes no allegation that Huawei’s disclosure concerns a selection of a delegate CC. *See* EX1003 at ¶¶ 123-28.

Accordingly, Tenny-Prov in view of Huawei does not render obvious claim element [1.b].

5. *Tenny-Prov Does Not Support the Proper Construction of Claim Elements [8.a] and [8.b]*

Entirely separate from Petitioner’s failure to address its own proposed claim construction for claim elements [8.a] and [8.b] in violation of 37 C.F.R. § 42.104(b)(4), as addressed in Section V.A, Tenny-Prov fails to meet the proper construction of these terms as set forth by the District Court.

With regard to claim element [8.a], Tenny-Prov does not teach “a processor programmed to configure a uplink (UL) timing group including at least one of component carriers (CCs) having a difference in center frequencies within a threshold range, CCs having the same beamforming scheme, CCs having the same timing advance (TA) value, and CCs having the same reference downlink (DL) CC to be used for obtaining a TA value, from among a plurality of CCs,” as required by the District Court’s construction. *See* EX2011 at 38.

In fact, Tenny-Prov does not disclose a processor of any particular

configuration. At most, Petitioner points to Figure 3, a paragraph that does not concern processors, and four boilerplate paragraphs in Tenny-Prov with regard to the hardware applicable to this structure (*see* Pet. at 38-39, citing EX1005 at Fig. 3, ¶¶ 34, 44-47). But Figure 3 and paragraph 34 do not concern any processors at all, and paragraphs 44-47 are boilerplate disclosures of generic computer hardware not tied to any particular configuration or functionality. Accordingly, Tenny-Prov does not teach element [8.a] according to the District Court’s construction, and Petitioner offers no support or even argument to remedy this deficiency.

Similar deficiencies are present with regard to claim element [8.b]. The District Court properly construed this term as “a processor programmed to set a CC satisfying at least one of a CC having a lowest center frequency value, a CC having a center frequency value that is closest to a mean value, a CC having a highest center frequency, a CC having a broadest frequency band, a CC in which a radio link monitoring (RLM) is defined, in the configured UL timing group as a delegate CC,” but Tenny-Prov does not disclose any such processor. Petitioner provides the same citations for claim element [8.b] as for [8.a], exchanging just paragraph 36 for 34. *See* Pet. at 40-41 (citing EX1005 at Fig. 3, ¶¶ 36, 44-47). But Figure 3 and paragraph 36 do not concern any processors at all, and paragraphs 44-47 are boilerplate disclosures of generic computer hardware not tied to any particular configuration or

functionality. Accordingly, Tenny-Prov does not teach element [8.b] according to the District Court's construction, and Petitioner offers no support or even argument to remedy this deficiency.

Accordingly, Tenny-Prov provides no basis for any Ground advanced by Petitioner meeting claim 8 (or claims 9-11 and 14, which depend on claim 8).

VI. CONCLUSION

For at least the foregoing reasons, the Board should deny institution.

Case IPR2025-00887
Patent No. 8,995,372
Patent Owner Preliminary Response

Dated: September 12, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 12th day of September, 2025, a copy of the attached **PATENT OWNER'S PRELIMINARY RESPONSE** was served by electronic mail to the attorneys of record, at the following addresses:

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CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Preliminary Response complies with the type-volume limitation of 37 CFR §42.24(a). The word count application of the word processing program used to prepare this Preliminary Response indicates that the Preliminary Response contains 4,848 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

Respectfully submitted,

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