

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T SERVICES, INC.

Petitioner,

v.

USTA TECHNOLOGY, LLC,

Patent Owner.

Case IPR2025-01166
Patent No. RE47,720

PETITIONER'S OPPOSITION TO DISCRETIONARY DENIAL

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	THE PTAB’S WORKLOAD MANAGEMENT FACTORS WEIGH IN FAVOR OF INSTITUTION	2
A.	Petitioner’s settled expectations weigh in favor of institution.....	2
1.	Development of the ’720 Patent’s “XG” technology	3
2.	The 802.11 Wi-Fi Standard.....	4
3.	None of the Original Claims Are Asserted Against Petitioner	5
4.	PO had no reasonable settled expectations in the reissue claims	6
B.	Neither the PTAB nor any court has adjudicated the validity of the challenged claims in view of the prior art relied upon in the Petition.....	6
C.	The Examiner erred by allowing claims 19-96 in the reissue and confirming claims 53-56, 64-66, 70, 76, 81-84, and 87-94 in the reexamination	9
D.	The proposed grounds are compelling, and the expert testimony on which they rely is entirely appropriate.....	10
E.	Equitable considerations weigh in favor of institution	11
III.	THE <i>FINTIV</i> FACTORS WEIGH IN FAVOR OF INSTITUTION	12
A.	<i>Fintiv</i> Factor 1: A stay has not yet been sought or ruled upon, but is likely if the Board institutes this IPR	12
B.	<i>Fintiv</i> Factor 2: Trial has not been scheduled	14
C.	<i>Fintiv</i> Factor 3: The parties have not invested sufficient resources in the litigation to weigh against institution.....	14
D.	<i>Fintiv</i> Factor 4: There is no meaningful risk of conflicting decisions	15
E.	<i>Fintiv</i> Factor 5: That Petitioner is a defendant, standing alone, does not outweigh the remaining factors	17
F.	<i>Fintiv</i> Factor 6: Other factors also weigh in favor of institution	17
IV.	CONCLUSION.....	20

TABLE OF EXHIBITS

Exhibit	Short Name	Description
EX1001	'720 Patent	U.S. Patent No. RE47,720
EX1002	Shoemake Declaration	Declaration of Dr. Matthew Shoemake
EX1003	Shoemake CV	<i>Curriculum Vitae</i> of Dr. Matthew Shoemake
EX1004	'711 Patent	U.S. Patent No. 7,483,711
EX1005	'720 Prosecution History	File History of U.S. Patent No. RE47,720
EX1006	'711 Prosecution History	File History of U.S. Patent No. 7,483,711
EX1007	Walton	U.S. Patent App. Pub. No. 2003/0125040
EX1008	Hamabe	U.S. Patent App. Pub. No. 2001/0016499
EX1009	802.11a	IEEE-SA Standards Board, <i>IEEE Standard for Telecommunications and Information Exchange Between Systems - LAN/MAN Specific Requirements - Part 11: Wireless Medium Access Control (MAC) and physical layer (PHY) specifications: High Speed Physical Layer in the 5 GHz band</i> , December 30, 1999.
EX1010	USTA's Infringement Contentions	USTA's Amended Infringement Contentions, <i>USTA Technology, LLC v. AT&T Inc. et al</i> , No. 4-24-cv-00513 (E.D. Tex. June 7, 2024).
EX1011	RESERVED	RESERVED
EX1012	Shoemake Paper	Shoemake et al., <i>High-Performance Wireless Ethernet</i> , IEEE Communications Magazine, pgs. 64-73, Vol. 39, Issue 11, November 2001.

Exhibit	Short Name	Description
EX1013	ERC/DEC/(99) 23	European Radiocommunications Committee, <i>ERC Decision of 29 November 1999 on the harmonized frequency bands to be designated for the introduction of High Performance Radio Local Area Networks (HIPERLANs)</i> , November 29, 1999.
EX1014	US Department of Commerce DFS Adoption	United States Department of Commerce News, <i>Agreement Reached Regarding U.S. Position on 5 GHz Wireless Access Devices</i> , January 31, 2003.
EX1015	US FCC Notice of Proposed Rulemaking for DFS	Federal Communications Commission, <i>Notice of Proposed Rulemaking</i> , June 4, 2003.
EX1016	802.11h PAR	Approval of Project Authorization Request for 802.11 Task Group h, December 13, 2000.
EX1017	TGh Philips Proposal	S. Choi et al., <i>Transmitter Power Control (TPC) and Dynamic Frequency Selection (DFS) Joint Proposal for 802.11h WLAN</i> , May 16, 2001.
EX1018	Kasslin TGh PPT	M. Kasslin, <i>Reasons for DFS Requirement in Europe</i> , July 2001, https://mentor.ieee.org/802.11/dcn/01/11-01-0442-00-000h-reasons-for-dfs-requirements.ppt (last accessed May 22, 2025).
EX1019	RESERVED	RESERVED
EX1020	Gubbi	U.S. Patent No. 6,934,752
EX1021	RESERVED	RESERVED
EX1022	Ylitalo	WO 2002/01732
EX1023	Smith	U.S. Patent No. 6,426,723
EX1024	Wi-Fi Alliance	<i>Securing Wi-Fi Wireless Networks with Today's Technologies</i> , Wi-Fi Alliance, February 6, 2003.

Exhibit	Short Name	Description
EX1025	802.11-1999	IEEE-SA Standards Board, <i>IEEE Standard for Telecommunications and Information Exchange Between Systems – Local and metropolitan area networks – Specific requirements Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) Specifications</i> , August 20, 1999.
EX1026	Walton 802.11n Proposal	Ketchum et al., <i>PHY Design for Spatial Multiplexing MIMO WLAN</i> , July 2004.
EX1027	RESERVED	RESERVED
EX1028	RESERVED	RESERVED
EX1029	Zamat	U.S. Patent No. 5,896,421
EX1030	Sorrells	U.S. Patent No. 8,571,135
EX1031	Thumpudi	U.S. Patent No. 7,801,735
EX1032	Hirsch	U.S. Patent App. Pub. No. 2003/0128659
EX1033	Larsson	U.S. Patent App. Pub. No. 2002/0172186
EX1034	Salz	J. Salz et al, <i>The Capacity of Wireless Communication Systems Can Be Substantially Increased by the Use of Antenna Diversity</i> , <i>IEEE Universal Personal Communications Conference</i> (September 1992)
EX1035	Foschini	Gerard J. Foschini, <i>Layered Space-Time Architecture for Wireless Communication in a Fading Environment When Using Multi-Element Antennas</i> , Bell Laboratories Technical Journal, 1996
EX1036	Raleigh2	G. G. Raleigh, <i>Spatio-Temporal Coding for Wireless Communication</i> , <i>IEEE Transactions on Communications</i> , Vol. 46, No. 3, March 1998.

Exhibit	Short Name	Description
EX1037	802.11e Draft D1.0	IEEE-SA Standards Board, <i>Draft Supplement to STANDARD FOR Telecommunications and Information Exchange Between Systems - LAN/MAN Specific Requirements - Part 11: Wireless Medium Access Control (MAC) and physical layer (PHY) specifications: Medium Access Control (MAC) Enhancements for Quality of Service (QoS)</i> , March 2001.
EX1038	Atheros Dual-Band	McFarland et al, <i>A 2.4 & 5 GHz Dual Band 802.11 WLAN Supporting Data Rates to 108 Mb/s</i> , 2002 IEEE GaAs Digest, 2002.
EX1039	Fallon	U.S. Patent No. 6,195,024
EX1040	Greenberger	U.S. Patent No. 6,675,187
EX1041	Onggosanusi	U.S. Patent No. 7,698,616
EX1042	Murtagh	E. M. Murtagh et al, <i>Outdoor Walking Speeds of Apparently Healthy Adults: A Systematic Review and Meta-analysis</i> , Sports Medicine, Vol. 51, pp. 125-141, published October 8, 2020.
EX1043	'930 App.	U.S. Provisional Patent Application No. 60/420,930
EX1044		Order [granting opposed motion to stay] in <i>Stellar, LLC v. Motorola Solutions, Inc.</i> , No. 4:23-CV-750-SDJ (E.D. Tex. Feb. 24, 2025)
EX1045		Order [staying case pending IPRs and pending motions] in <i>Stellar, LLC v. Motorola Solutions, Inc.</i> , No. 4:23-CV-750-SDJ (E.D. Tex. Jan. 21, 2025)
EX1046		Order [denying without prejudice opposed motion to stay] in <i>AR Design Innovations LLC v. Ashley Furniture Indus., Inc.</i> , No. 4:20-CV-392-SDJ (E.D. Tex. Jan. 11, 2021)
EX1047		Order Granting In Part Joint Motion to Stay Pending Inter Partes Review in <i>Spine Holdings, LLC v. Orthofix Medical, Inc.</i> , No. 4:20-CV-77-SDJ (E.D. Tex. Jun. 8, 2020)

Exhibit	Short Name	Description
EX1048		Order [granting unopposed motion to stay] in <i>Gatekeeper Solutions Inc. v. Darktrace, Inc.</i> , No. 4:24-CV-723-SDJ (E.D. Tex. Apr. 9, 2025)
EX1049		Scheduling Order in <i>Gatekeeper Solutions Inc. v. Darktrace, Inc.</i> , No. 4:24-CV-723-SDJ (E.D. Tex. Jan. 21, 2025)
EX1050		USTA Disclosure of Preliminary Constructions
EX1051		Excerpts of File History of Reexam No. 90/019,702
EX1052		August 2005 BBN Technologies DARPA final technical report on “XG”

I. INTRODUCTION

The Petition should be referred to the merits panel. For 10 years before reissue, Petitioner had a reasonable basis for well-settled expectations that the '720 Patent did not apply to 802.11 standard functionality of Wi-Fi equipment. The original claims said nothing of 802.11, and the specification unambiguously distinguishes its “present invention” which “*requires* a MAC protocol that is quite different from conventional ... protocols, such as 802.11.” Then, just five years ago, PO reissued the '720 Patent with over 70 new claims that mention 802.11. But the specification still distinguishes 802.11 from the “present invention” and so, when PO offered in 2022 to license the reissued '720 Patent, Petitioner replied that it did not understand the licensing offer to suggest infringement. But PO stood silent, waiting until June of 2024 to serve Petitioner with a complaint alleging infringement by the very 802.11 standard functionality the '720 Patent distinguishes. Critically, PO asserts *only* claims added or amended by the reissue just five years ago. Under these circumstances, it would be unjust to credit any of PO's expectations as settled. On the other hand, Petitioner had a reasonable basis since 2009 to expect that the '720 Patent did not apply to standard 802.11 functionality of Wi-Fi equipment.

Moreover, PO has asserted the '720 Patent against numerous defendants in multiple district courts, but has quickly settled cases and thereby evaded trial on validity. With now six pending cases against six different defendants, the PTAB

presents the single most efficient venue to adjudicate validity of these claims. There is no trial date scheduled in the Litigation and the presiding judge, Judge Jordan, has in similar circumstances been willing to stay cases while the PTAB addresses validity to simplify issues for subsequent district court trials. As such, there is no practical risk of inconsistent conclusions and the *Fintiv* factors weigh in favor of institution. The Petition's grounds—which rely on prior art and arguments that were not before the Examiner in any of original prosecution, reissue, or subsequent reexamination (of a small subset of claims)—are compelling and primed for the USPTO to right the examiners' mistake in allowing the reissue claims.

II. THE PTAB'S WORKLOAD MANAGEMENT FACTORS WEIGH IN FAVOR OF INSTITUTION

A. Petitioner's settled expectations weigh in favor of institution

Petitioner reasonably expected that the '720 Patent did not apply to and would not be asserted against the accused 802.11 standard functionality of its Wi-Fi equipment. The predecessor to the '720 Patent first issued in 2009. EX1004. None of its 21 original claims recited anything about the 802.11 standard. *See id.*, 27:19-28:64. To the contrary, the specification states that “the present invention” “**requires** [a] MAC *protocol* that is **quite different from** conventional carrier sense multiple access/collision detect (CSMA/CD) protocols, such as **IEEE 802.11**, which uses RTS/CTS exchanges.” EX1001, 20:12-23. That **not-802.11** disclosure was also consistent with the development of “XG” technology as an alternative to 802.11.

1. Development of the '720 Patent's "XG" technology

In 2002 (provisional) and 2003 (non-provisional) BBN Technologies, now a subsidiary of Raytheon, disclosed the "XG" system to "***overlay*** military networking on top of any narrowband-channelized spectrum." EX1043, 16/21; EX1001, 1:28-54; *see also* EX1052, 3/57 (August 2005 BBN Technologies DARPA final technical report on "XG"). To achieve this goal, BBN disclosed first generating a wideband OFDM signal and then employing "NB [narrowband] excision to eliminate interference with legacy systems," allowing the OFDM signals to coexist in the same spectrum as the legacy systems. EX1004, 19/21; EX1001, 10:56-11:10. The patent discloses a feedback scheme in which a receiver "produces an optimal waveform profile" that is then sent to "neighboring nodes" instructing them "to use zero power at frequencies" that the receiver "has determined are already populated." EX1001, 22:2-7. The predecessor '711 Patent reflected this concept. Claim 19 (Original Claim 21) recites "receiving at a first node" "an instruction transmitted from a second node" "to avoid using a plurality of frequencies to transmit to the second node," "filtering a transmission signal to remove power from the transmission signal at each frequency in the plurality of frequencies," and "transmitting" the filtered transmission signal. EX1006, 122/166, 34/166; EX1004, 34/34.

2. *The 802.11 Wi-Fi Standard*

The IEEE 802.11 Wi-Fi standards also evolved to address interference problems caused by concurrent operation in bands occupied by other users, but took a fundamentally different approach. With the 802.11 standard, if interference is detected on one or more channels, rather than perform narrowband excision, the devices simply stop using those channels for upcoming transmissions by not generating a signal in those channels in the first place. *See* EX1010, 49-50/426. Consistent with the 802.11 standard providing a fundamentally different approach to interference management, the specification of the '720 Patent *expressly distinguishes 802.11*: “the present invention” “requires [a] MAC protocol that is *quite different from* conventional carrier sense multiple access/collision detect (CSMA/CD) protocols, such as *IEEE 802.11*, which uses RTS/CTS exchanges.” EX1001, 20:12-23.

Thus, AT&T and all other users of 802.11 Wi-Fi standards reasonably expected—since at least its first application published in 2004—that the '711 Patent and its narrowband excision protocol were not relevant to Wi-Fi devices. From 2003 through 2017 when Raytheon assigned the '711 Patent to a non-practicing entity, Petitioner is not aware of BBN Technologies, Raytheon, or anyone else suggesting that the '711 Patent was relevant to 802.11-compliant devices.

3. *None of the Original Claims Are Asserted Against Petitioner*

Late in 2019, the '720 Patent reissued with amended (and 76 new) claims somehow reciting 802.11 protocols that were (1) not within the scope of the original claims and (2) expressly distinguished by the specification. EX1005, 154-180/357. PO added to independent claim 19 a “wherein” clause reciting that the “transmission signal” “is transmitted using” “an 802.11-based orthogonal frequency-division multiplexing (OFDM) *protocol*.” *Id.*, 157/357. This despite the specification explaining that the “802.11” “protocol” is “*quite different*” than the MAC *protocol* of “the present invention.” EX1001, 20:12-23. PO also added a dependent claim reciting that the “instruction includes a 802.11 clear to send (CTS) instruction.” EX1005, 168/357. This despite the specification explaining that 802.11 “RTS/*CTS* exchanges” are “*quite different*” than “the present invention.” EX1001, 20:12-23. And that’s not all. PO cleverly but improperly tried to expand the plain meaning of “filtering ... *to remove*” in the original claims, by adding a dependent claim nonsensically reciting that “the transmission signal is generated so as to not include power at each frequency in the plurality of frequencies to be avoided, *thereby resulting in the removal of power*.” EX1005, 172/357.

PO no doubt contends that the specification supported those amendments. But PO’s present-day choices belie that notion. Specifically, PO does not assert any of

original claims 1-18 in the Litigation, making clear that any “settled expectations” PO had in the original claims are not implicated by the current dispute.

4. *PO had no reasonable settled expectations in the reissue claims*

When PO obtained the predecessor to the ’720 Patent, it inarguably *did not include* the reissue claims challenged here and asserted against Petitioner in the Litigation. To hedge its unreasonable attempt to rely on the original 2009 issue date, PO also points to a letter “offering a license” as allegedly putting Petitioner on notice that—despite its “present invention” being “quite different” than 802.11—PO might someday assert the ’720 Patent against 802.11-standard functionality of Petitioner’s Wi-Fi devices. Paper 6, 10. But, in a prompt response to PO, Petitioner explained that it did “not interpret [PO]’s inquiry as an allegation of infringement.” EX2010. Did PO assert otherwise? No; PO hid behind the proverbial log, lodging no intimation of relevance, much less infringement, related to 802.11-standard WiFi functionality until serving its complaint in the Litigation on June 17, 2024.

B. Neither the PTAB nor any court has adjudicated the validity of the challenged claims in view of the prior art relied upon in the Petition

None of the proposed grounds were considered by the Examiner during prosecution or reexamination. Neither Walton nor Hamabe were cited during prosecution of either the original application or the reissue application. *See* EX1005; EX1006. And, neither Walton (EX1007) nor Hamabe (EX1008) were considered

during the prior reexamination of a small subset of the challenged claims.¹ In particular, nearly a month after being served with this Petition and after the CRU had issued its Notice of Intent to Issue a Reexam Certificate, Patent Owner (PO) petitioned the Office to accept a late Information Disclosure Statement including Walton and Hamabe. EX1051, 7/72.² Unsurprisingly, the Office declined to do so after conclusion of the reexamination. *Id.*, 3/72. Therefore, Walton and Hamabe have expressly ***not been considered*** by the USPTO. Thus, of the three prior art references common to both grounds in the Petition, only one (802.11a, EX1007) was cited in an information disclosure statement during the earlier reexamination, but 802.11a describes a known communication standard and was not a part of any rejection. As such, the Petition's prior art combination and arguments were not considered by the Office and the first prong of the *Advanced Bionics* framework is not met. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (designated Precedential Mar. 24, 2020) (establishing two-part framework to evaluate the exercise of discretion).

¹ The reexamination addressed only 20 claims out of the 70 claims challenged here. Claim 53 was the only independent claim addressed in the reexamination.

² Notably, the Intel petition relied on a different *Walton*, US2003/0043732, which the Examiner expressly declined to consider in reexamination. EX1051, 66/72.

This pending Petition is also materially different than the one discretionarily denied in *Intel Corp. v. USTA Tech., LLC*, IPR2025-00838, Paper 10 (PTAB Sep. 19, 2025). The Intel petition challenged only two claims, one of which was addressed in the reexamination. *Id.*, 2. In contrast, Petitioner here challenges 70 claims, all of which were added via reissue in 2019 (including all three of the reissue-added independents 19, 53, and 95). This Petition also relies on different prior art—Hamabe and a different Walton—than were in the Intel petition.

That this Petition challenges nearly all of the reissue claims is particularly relevant in that PO has and continues to file additional lawsuits in multiple districts. EX1054. While earlier cases outside the Eastern District of Texas have been dismissed, PO is free to file future cases in other districts. *Cf. Harbor Freight Tools USA Inc. v. Champion Power Equipment, Inc.*, IPR2025-00805, Paper 20 (PTAB Sep. 19, 2025) (referring petition to merits panel: “Because the litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient.”).

The decision in *Harbor Freight* noted that multiple patents were asserted in multiple districts, but the same principle applies here. PO asserted this challenged patent in three more lawsuits on July 29, 2025 alone. Even if PO were to only pursue the six lawsuits currently pending, the Eastern District of Texas will be required to

conduct *six different trials* addressing validity of the same patent. Paper 6, 4-5.

That is the opposite of efficiency for all parties, including PO, and the Court.

C. The Examiner erred by allowing claims 19-96 in the reissue and confirming claims 53-56, 64-66, 70, 76, 81-84, and 87-94 in the reexamination

The primary reference here compellingly discloses—in a similar system—the very feature the examiner concluded was missing from the prior art in the reexamination. In particular, the Examiner in the reexamination confirmed claims 53 and its dependents at issue because “Patent Owner ha[d] persuasively argued that the cited references [in the reexamination] 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.’” EX1051, 56/72. However, as explained in the Petition, the teachings of Walton and Hamabe, in view of the known 802.11a standard, compellingly disclose the purportedly missing feature:

Walton/802.11a/Hamabe renders obvious Limitation [19.1]. EX1002, ¶104. As discussed in Section IX.A.5, in Walton/802.11a/Hamabe if terminal 106a “determines that the carrier frequency must be changed,” it “transmits the control information to” access point 104 that “contain[s] the results of this determination.” EX1008, [0127], [0119], [0124]. Access point 104 in response “begins the process of changing the carrier frequency.” Id. That is, access point 104 (the “first node”) receives “control information” transmitted from

terminal 106a (the “second node”) indicating the current 802.11 channel “must be changed.” *Id.*, [0127]; EX1002, ¶104. An indication that the current 802.11 channel “must be changed” instructs access point 104 to select a different 802.11 channel than the current channel, having a different center frequency. EX1009, 34-35/90; EX1002, ¶104. As Hamabe explains, upon receipt of this “control information,” access point 104 “begins the process of changing” the 802.11 channel in use, confirming that the “control information is “an instruction” “to avoid using” the current channel “to transmit to the second node.” EX1008, [1024]; EX1002, ¶104.

Paper 1, 31-32. Notably, and as also explained in the Petition, the Petition’s mapping aligns with the 802.11 functionality accused in PO’s infringement contentions:

PO’s infringement allegations assert that an instruction to not use “at least one secondary channel” (a continuous 20, 40, or 80 MHz OFDM channel) constitutes an instruction “to avoid using a plurality of frequencies.” EX1010, 30-31/426. Walton/802.11a/Hamabe’s instruction that the current 802.11 channel (containing a plurality of frequencies) “must be changed” and, therefore, should be avoided, meets this element in the same way as PO’s infringement mapping. EX1002, ¶105.

Paper 1, 31-32 (footnotes omitted).

D. The proposed grounds are compelling, and the expert testimony on which they rely is entirely appropriate

PO criticizes Petitioner’s expert testimony as extensive and thoroughly cited, but fails to explain *why* any of that testimony is lacking. Paper 6, 12-13. PO instead

quotes selected snippets in a string cite and, ironically, brands it all “conclusory.” However, the quoted testimony plainly speaks to what a POSITA would have understood the prior art’s disclosure to mean, and what—in view of the prior art’s express disclosures—would have been obvious to a POSITA. These are precisely the types of issues for which expert testimony is helpful. That the Petition closely tracks the expert testimony reflects only that both are fully explained.

E. Equitable considerations weigh in favor of institution

Upon being sued for allegedly infringing 73 claims, Petitioner diligently searched the prior art and developed invalidity theories. Despite PO’s insinuations (Paper 6, 6-7), Petitioner did not coordinate with any other defendant or other third party the development of the invalidity theories in this Petition.³ The need to use most of the 12-month statutory period is a reflection of the complexity inherent in challenging 70 claims. And the fact that other defendants—also accused of infringing via the standard 802.11 functionality expressly distinguished in the ’720 Patent itself—may benefit from the invalidation of the Challenged Claims does not somehow make this IPR an “additional bite” for those defendants. Paper 6, 6. To

³ Invalidity contentions were not served in the Litigation until over two months after the filing of this Petition. EX2003, 1.

the contrary, a final written decision in this IPR would precede trial in the Litigation and would simplify or outright eliminate the need for subsequent district court trials.

III. THE *FINTIV* FACTORS WEIGH IN FAVOR OF INSTITUTION

Fintiv Factor 2 (timing) and 6 (other factors) weigh strongly in favor of institution. *Fintiv* Factors 1 (potential stay of litigation) and 3 (minimal investment in litigation) weigh slightly in favor of institution or, at worst, are neutral. *Fintiv* Factors 4 (risk of conflicting decisions) and 5 (Petitioner is a defendant) do not outweigh the other factors. Thus, the *Fintiv* Factors favor institution.

A. ***Fintiv* Factor 1: A stay has not yet been sought or ruled upon, but is likely if the Board institutes this IPR**

Petitioner has not yet requested a stay of the litigation. The Board should “decline to infer, based on actions taken in different cases with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (designated Informative Jul. 13, 2020). As such, “[t]his factor does not weigh for or against discretionary denial in this case.” *Id.*

Nevertheless, Petitioner intends to request a stay if the Board institutes this IPR, and Judge Jordan has been willing to grant stays in those circumstances. In a relatively short tenure on the bench, Judge Jordan has addressed stays pending *inter partes* review or *ex parte* reexamination in four cases. See EX1044, EX1045, EX1046, EX1047, EX1048. Of these, two were unopposed or joint and were granted

subject only to the requirement that the parties promptly advise the Court of any USPTO actions. *See* EX1047 (order granting joint motion to stay pending *not-yet-filed* IPRs); EX1048 (granting unopposed motion to stay pending ordered reexamination of asserted patent).

In the two cases in which plaintiffs opposed stays, Judge Jordan showed a clear willingness to stay cases pending IPRs. *See* EX1044, EX1046. In *Stellar, LLC v. Motorola Solutions, Inc.*, Judge Jordan granted an opposed motion to stay pending IPR, even when only half of the petitions had yet been instituted. EX1044; *see also* EX1045 (continuing stay even while defendants sought rehearing of the Director’s decision to vacate certain institution decisions. EX1044. In *AR Design Innovations LLC v. Ashley Furniture Indus., Inc.*, Judge Jordan denied *without prejudice* an opposed motion to stay but noted that “[o]nce the PTAB has decided whether to institute IPR proceedings, ‘the balance of factors bearing on the appropriateness of a stay may be very different, and the issuance of a stay may be appropriate.’” EX1046, 8/9 (quoting *Tessera Advanced Techs., Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:17-CV-00671, 2018 WL 3472700, at *2 (E.D. Tex. July 19, 2018)). On the other hand, PO’s arguments about the probability of a stay should thus be disregarded because they fail to address Judge Jordan’s own decisions.

This factor is therefore neutral or weighs slightly in favor of institution.

B. *Fintiv* Factor 2: Trial has not been scheduled

There is no scheduled trial date. PO contends that “trial [is] expected to begin as soon as practicable []after” the Final Pretrial Conference currently scheduled for November 18, 2026. Paper 6, 20. Judge Jordan’s own words undermine PO’s characterization. For example, when granting a stay pending *ex parte* reexamination in a case with an apparently identical form of scheduling order, Judge Jordan plainly stated that—despite a scheduled “final pretrial conference:” “*No trial date has been set.*” EX1048, 1-2 (citing EX1049, 3-5). The same is true here. Particularly in view of Judge Jordan’s demonstrated willingness to stay litigation pending resolution of USPTO proceedings, this factor therefore weighs strongly in favor of institution.

C. *Fintiv* Factor 3: The parties have not invested sufficient resources in the litigation to weigh against institution

PO overstates the parties’ and Court’s investment in the Litigation. While the parties have exchanged contentions and the *Markman* hearing is scheduled for December 16, 2025, PO has requested that the Court not construe any claims. *See* EX1050, 2 (“USTA is not presently seeking construction from the Court for any identified claim terms, phrases, or clauses.”).⁴ As of the January 8, 2026 deadline for

⁴ The Petition explains that “Petitioner applies, without conceding as correct, PO’s interpretation of the Challenged Claims as reflected in PO’s infringement mapping.” Pet., 15; *see also id.*, 2-3, 32, 34, 43, 51, 52, 58, 77.

the Board’s institution decision, months of fact discovery will remain and expert discovery will still be several months away. EX2003, 2-3. Moreover, Judge Jordan’s own orders addressing stay motions suggest that the Court itself would consider the PTAB to be the most efficient venue to address validity issues, when institution would come after a claim construction hearing. EX1048, 6. Specifically, evaluating “whether the action before the court has reached an advanced stage, including whether discovery has been completed and a trial date has been set,” Judge Jordan explained that—even where an institution decision would follow claim construction “a stay entered at that point has the potential to save the parties substantial expenses that would be incurred in the post-Markman pretrial period and in going to trial.” *Id.* Judge Jordan there “conclude[d] that this factor is also neutral” and expressly suggested that a stay post-claim construction could well be appropriate “[o]nce the PTAB has decided whether to institute” *Id.* Thus, while the parties will have invested some resources, that investment will be relatively limited and this factor should therefore be considered neutral.

D. *Fintiv* Factor 4: There is no meaningful risk of conflicting decisions

PO also overstates the potential for “inefficiency and the possibility of conflicting decisions.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 12 (PTAB Mar. 20, 2020) (precedential). At the outset, PO contends that there are actually more claims at issue in the district court than in the Petition. Paper 6, 24-

25. This is disingenuous at best, because there is no set of circumstances in which PO could actually go to trial with 73 claims. To the contrary, should the Litigation reach trial, PO will need to dramatically reduce its asserted claims—most likely by a factor of ten—which would leave the (in)validity of over 60 claims unresolved if IPR were not instituted. Indeed, even if trial proceeded with the three dependent claims that are not challenged in the Petition, PTAB validity findings for the other 70 claims (including their respective independent claims) would dramatically simplify the issues for a jury. *See, e.g.*, EX1048 (Judge Jordan finding simplification factor weighs in favor of stay because reexamination of all but four asserted claims “could substantially narrow the asserted claims”); EX1046, 7 (Judge Jordan denying pre-institution stay *without prejudice*, and expressly leaving open the possibility of a stay post-institution because the PTAB canceling or upholding “some or all claims” could simplify issues for trial).

Further, the Petition maps its grounds based on PO’s application of its own claims in the infringement contentions. Pet., 15 (“Petitioner applies, without conceding as correct, PO’s interpretation of the Challenged Claims as reflected in PO’s infringement mapping.”). Presumably, those interpretations are consistent with PO’s view of the “plain and ordinary meaning” it also seeks in the Litigation. EX1050. Nor would the constructions Petitioner seeks undermine the grounds in the Petition. *See* EX2022. Moreover, the parties would of course keep the Board

apprised of any constructions issued by the Court, and vice versa, which effectively eliminates the potential for inconsistent rulings.

Under these circumstances, particularly where Judge Jordan is open to stays given the potential for IPRs to simplify issues for trial, the realistic likelihood of inefficiency is minimal and there is effectively no risk of inconsistent decisions. This factor should therefore be considered neutral or, at most, weigh only slightly in favor of discretionary denial.

E. *Fintiv* Factor 5: That Petitioner is a defendant, standing alone, does not outweigh the remaining factors

Though outweighed by the rest of the factors, the Board has previously found that when, as here, Petitioner is the defendant in the litigation, “this factor weighs in favor of discretionary denial.” *Fintiv*, IPR2020-00019, Paper 15 at 12.

F. *Fintiv* Factor 6: Other factors also weigh in favor of institution

PO contends that the Petition “failed to identify a ‘first signal,’ a ‘second signal,’ a ‘filtered first transmission signal,’ and a ‘filtered second transmission signal,’ as recited in independent claims 19 and 53.” Paper 6, 27. But this is demonstratively false, which PO lays tacitly concedes in its next sentence: “To the extent Petitioner alleges to identify any signals in prior art corresponding to the claimed ‘signals,’ those alleged signals fail to satisfy all of the recited requirements of each claimed ‘signal,’ such as each’s specific claimed attributes and functionality.” *Id.* But this too is false.

First, what is required of the “first signal” is that it is “transmitted from the first node to the second node” and, by implication, has “a received power and one or more frequencies.” Paper 1, viii (Limitation [19.4]), xiii (Limitation [53.4]). And the Petition expressly addresses each of these features. Paper 1, 36 (“first/second signal transmitted from access point 104 to terminals 106a/106n”), 37 (“based on a received power of the first/second signal” and “also based on one or more frequencies of a first second signal”). So too for the “second signal.” *Compare* Paper 1, viii (Limitation [19.5]) and xiii (Limitation [53.5]) *with id.*, 36-37.

Second, what is required of the “filtered first transmission signal” is that it is “transmitted using a first frequency and an 802.11-based orthogonal frequency-division multiplexing (OFDM) protocol via at least one antenna of a plurality of antennas, using a first power that is based on at least one of the one or more data structures.” Paper 1, viii (Limitation [19.9]), xiii (Limitation [53.8]). And the Petition, again, addresses all of these features. Paper 1, 42-43 (“access point 104 may transmit to multiple terminals simultaneously on the same OFDM channel by employing multiple antennas and frequency subchannels” and “Each signal is ‘filtered’ for the reasons discussed in Limitations [19.2]-[19.3],” “transmitted using 802.11a’s ‘OFDM PHY’ layer,” “use a first/second frequency,” and “use a first/second power that is based on at least one of the one or more data structures”).

So too for the “filtered second transmission signal.” Paper 1, ix (Limitation [19.10]), xiii (Limitation [53.9]).

PO also contends that “for independent claim 95, Petitioner mistakes which node performs the claimed method step of ‘simultaneously transmitting to one or more other nodes.’” Paper 6, 27. This too is false. Claim 95 recites a method with various steps performed by various nodes. Limitation [95.7] recites “transmitting the compressed feedback *from the first node to the second node* ... while simultaneously transmitting to one or more other nodes” whereas Limitation [19.4] recites “receiving a compressed first feedback from the second node.” *Compare* Paper 1, xviii *with id.*, viii. For Limitation [95.7], the Petition refers back to Limitations [19.4], [19.9], and [19.10]. But PO overlooks that the Petition maps claim 95 to different first and second nodes than it does for claim 19. Specifically, the Petition identifies “terminal 106a” as the “first node” of claim 95 and identifies “the access point” as the “second node” of claim 95. Paper 1, 96. In contrast, the Petition identifies access point 104 as the “first node” of claim 19 and identifies “terminal 106a” as the second node of claim 19. Paper 1, 31. Thus, claim 19’s mapped first node (access point 104) that receives the compressed feedback *is the same as* claim 95’s mapped first node (access point 104) that transmits the compressed feedback. And it is that same access point 104 [that] “may transmit to

multiple terminals *simultaneously* on the same OFDM channel.” Paper 1, 42 (Limitation [19.9]), 44 (referencing Limitation [19.9] for Limitation [19.10]).

Thus, the Petition maps each of the identified “signals”—and their respective features—of independent claims 19 and 53, and consistently maps the “simultaneously transmitting” of Limitation [95.7]). These were the only bases for PO’s contention that the grounds are not compelling. As such, PO fails to undermine that proposed grounds compellingly rendered obvious the claims as mapped to the standard 802.11 functionality PO accuses of infringement. Paper 1, 31-32.

IV. CONCLUSION

For the foregoing reasons, discretionary denial would be the least-efficient outcome for Petitioner, Patent Owner, the five other defendants sued in co-pending litigation, and at least the United States District Court for the Eastern District of Texas (but likely other district courts as well). The Petition sets forth compelling challenges to the vast majority (70 of 73) claims asserted in the litigation and offers an opportunity for the PTAB to address validity challenges in a single IPR in a way that should—regardless of outcome—significantly simplify the issues for trial. Petitioner therefore respectfully requests referral to the merits panel.

Date: October 7, 2025

By: /Eagle H. Robinson/
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on October 7, 2025, complete copies of this Petitioner's Opposition to Discretionary Denial and EX1044-EX1052 were served on PO via email (by consent) to:

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/Eagle H. Robinson/
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