

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN AIRLINES, INC. AND SOUTHWEST AIRLINES CO.,

Petitioners,

v.

INTELLECTUAL VENTURES II LLC,

Patent Owner.

Case No. IPR2025-01509
U.S. Patent No. 11,032,000

**BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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PATENT OWNER'S EXHIBIT LIST

Ex. 2001	<i>American Airlines, Inc. and v. Intellectual Ventures II LLC</i> , IPR2025-00785 and IPR2025-00786, Paper 11 (PTAB August 29, 2025) (declining to exercise discretion to deny IPRs).
Ex. 2002	<i>American Airlines, Inc. and v. Intellectual Ventures II LLC</i> , IPR2025-00782 and IPR2025-00931, Paper 12 (PTAB September 19, 2025) (declining to exercise discretion to deny IPRs).
Ex. 2003	<i>American Airlines, Inc. and v. Intellectual Ventures II LLC</i> , IPR2025-00987 and IPR2025-01055, Paper 9 (declining to exercise discretion to deny IPRs).
Ex. 2004	Defendant Southwest Airline Co.'s Preliminary Invalidity Contentions

I. INTRODUCTION

The Petition challenges U.S. Patent No. 11,032,000 (the ‘000 Patent). The Director should exercise discretion and deny institution.

The ‘000 Patent is part of parallel district court litigation against Petitioner American Airlines (the American Litigation) involving ten patents (Case 4:24-cv-00890 (EDTX)), and also a part of separate parallel district court litigation against Petitioner Southwest (the Southwest Litigation) involving nine patents (Case 3:25-cv-2885 (NDTX)). In six earlier IPRs involving patents at issue in the American and Southwest Litigations, the Director issued decisions declining to exercise discretion to deny the Petitions. *See, American Airlines, Inc. and v. Intellectual Ventures II LLC*, IPR2025-00785 and IPR2025-00786, Paper 11 (PTAB August 29, 2025) (Ex. 2001), *American Airlines, Inc. and v. Intellectual Ventures II LLC*, IPR2025-00782 and IPR2025-00931, Paper 12 (PTAB September 19, 2025) (Ex. 2002), and *American Airlines, Inc. and v. Intellectual Ventures II LLC*, IPR2025-00987 and IPR2025-01055, Paper 9 (PTAB October 3, 2025) (Ex. 2003) (collectively, the “Six Earlier Decisions”). However, circumstances have changed since the Director issued those rulings.

In the Earlier Decisions, the Director found that “[t]he large number and wide scope of the patents asserted in the district court litigation weighs against discretionary denial, as the Board is better suited to review a large number of patents

involving diverse subject matter.” Ex. 2001, 3; Ex. 2002, 2 and Ex. 2003, 2. Since that time, the Board has denied institution on the merits in every Petition involved in the Earlier Decisions. The table below sets forth the status of each IPR challenging a patent in the parallel litigations. The institution has been denied in all cases highlighted in green, and the four remaining cases (highlighted in blue) do not have institution decisions due for several months.

<u>IPR/Patent</u>	<u>Status of Institution Decision</u>	<u>District Court Actions Where Patent Is Asserted American and/or Southwest</u>
IPR2025-00782/ USP 7324469	Denied	American (4:24-cv-00890) Southwest (3:25-cv-2885)
IPR2025-00785/ USP 7257582	Denied	American (4:24-cv-00890) Southwest (3:25-cv-2885)
IPR2025-00786/ USP 7949785	Denied	American (4:24-cv-00890) Southwest (3:25-cv-2885)
IPR2025-00931/ USP 8332844	Denied	American (4:24-cv-00890) Southwest (3:25-cv-2885)
IPR2025-00987/ USP 8407722	Denied	American (4:24-cv-00890) Southwest (3:25-cv-2885)
IPR2025-01055/ USP 8027326	Denied	American (4:24-cv-00890) Southwest (3:25-cv-2885)
IPR2025-01509/ USP 11032000	Due 3/23/26	American (4:24-cv-00890) Southwest (3:25-cv-2885)
IPR2025-01510/ USP 10103845	Due 4/14/26	American (4:24-cv-00890)
IPR2025-01511/ USP 7712080	Due 3/29/26	American (4:24-cv-00890) Southwest (3:25-cv-2885)
IPR2026-00043/ USP 7721282	Due 4/20/26	American (4:24-cv-00890) Southwest (3:25-cv-2885)

As discussed more fully below, as a result of the denial of institution in all of the cases highlighted in green, Patent Owner respectfully submits that, at this point, the District Courts -- as opposed to the Board -- are better suited to review the validity of the remaining patents (highlighted in blue above) that have yet to reach an institution decision.

In addition, the inconsistent claim construction positions of Petitioner Southwest separately support a discretionary denial in these proceedings. In the District Court, Petitioner Southwest contends that key claim terms of the '000 Patent are "indefinite." Ex. 2004, 302-303. By contrast, in this IPR, the Petitioner Southwest has abandoned those positions in favor of interpretations intended to support invalidity arguments — **without even acknowledging**, let alone justifying, the inconsistencies. The Director has made clear that such tactics warrant denial of institution. *See, e.g., Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 20 (Squires November 3, 2025) (precedential) (a petitioner must explain why it takes different claim construction positions in the petition and in district court) and *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (Squires November 5, 2025) (informative) (a petitioner's explanation that it could not argue indefiniteness in an IPR is insufficient to show why different claim construction positions are warranted).

For these reasons, and as explained more fully below, the Director should exercise discretion to deny institution.

II. AS A RESULT OF DENIAL OF INSTITUTION IN THE MAJORITY OF IPRS CHALLENGING THE PATENTS-IN-SUIT, THE DISTRICT COURTS ARE BETTER SUITED TO REVIEW THE VALIDITY OF THE REMAINING PATENTS-IN-SUIT INCLUDING THE ‘000 PATENT

In declining to exercise discretion in the Earlier Decisions addressing the six previous IPRs, the Director reasoned:

... Although Patent Owner argues that six of the asserted patents involve only two technology areas (DD Reply 1–2), the challenged patents appear to be directed to a diverse range of subject matter (e.g., Internet hotspots, distributed networking, transceiver operation, computer clusters) (DD Sur-reply 1–4). The large number and wide scope of the patents asserted in the district court litigation weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter. Ex. 2001, 3.

See, Ex. 2002, 2 (“This case presents essentially the same discretionary considerations as those presented in IPR2025-00785 and IPR2025-00786); and Ex. 2003 (“These cases present essentially the same discretionary considerations as those presented in IPR2025-00785 and IPR2025-00786”). However, now that the Board has denied institution in the six previous IPRs, it is clear that the Board will not be reviewing the patents that were at issue in those proceedings. Rather, the District Courts will now be charged with reviewing those six patents.

The Director found that the six patents at issue in the Earlier Decision spanned a “diverse range of subject matter (Internet hotspots, distributed networking, transceiver operation, computer clusters).” Ex. 2001, 3. Significantly, as illustrated below, the subject matter areas of the patents where institution was denied (**green**) *fully encompass* those of the remaining patents (highlighted in **blue**).

<u>IPR</u>	<u>Patent</u>	<u>Status of Institution Decision</u>	<u>Technology Area</u>
IPR2025-00782	7324469	Denied	Internet hot spots
IPR2025-00785	7257582	Denied	Distributed Networking
IPR2025-00786	7949785	Denied	Computer Clusters
IPR2025-00931	8332844	Denied	Distributed Networking
IPR2025-00987	8407722	Denied	Computer Clusters
IPR2025-01055	8027326	Denied	Transceiver Operation
IPR2025-01509	11032000	Due 3/23/26	Transceiver Operation
IPR2025-01510	10103845	Due 4/14/26	Transceiver Operation
IPR2025-01511	7712080	Due 3/29/26	Distributed Networking
IPR2026-00043	7721282	Due 4/20/26	Distributed Networking

The reasoning of the Earlier Decisions was premised on efficiency, and the possibility that the outcomes of the six earlier IPRs (had they been instituted) would lessen the burden on the District Courts to address the validity of patents spanning a “diverse range of subject matter.” For example, if the six IPRs had been instituted

and reached Final Written Decisions before the trials in the District Courts, the District Courts could have potentially avoided the need to address the validity of patents spanning diverse subject matter either because (i) the Patent Owner prevailed in the IPRs (resulting in Petitioners being estopped from challenging validity in the District Courts based on prior patents and publications) or (ii) Petitioners prevailed in the IPRs (resulting in the elimination of the subject patents from the District Court Litigations).

However, given the denials of institution in the six previous cases, no results by the Board in the four remaining IPRs will avoid the need for the District Courts to address the validity of patents spanning a “diverse range of subject matter,” including “Internet hotspots, distributed networking, transceiver operation, computer clusters.” More specifically, with respect to the ‘000 Patent at issue in this IPR which falls in the technology area of “transceiver operation,” the District Courts will need to address the validity of Patent No. 8027326 (also in the “transceiver operation” area) as a result of the denial of institution in IPR2025-01055, regardless of any result the Board might render in this IPR.

The most efficient path for avoiding duplication of efforts going forward is to have either the District Courts or the Board -- but not both -- address the validity of the patents in the remaining IPRs. However, since the District Courts are already required to address the validity of patents spanning a “diverse range of subject

matter” including that of the ‘000 Patent, it is more efficient for the District Courts (as opposed to the Board) to address the validity ‘000 Patent as well, as the District Courts will already be immersed in the technology area of the ‘000 Patent through their exclusive role assessing validity of the ‘326 Patent.

III. THE INCONSISTENT CLAIM CONSTRUCTIONS OF PETITIONER SOUTHWEST WARRANT DISCRETIONARY DENIAL

The Petition should also be denied under the Director’s discretionary authority because the Petition is predicated on claim construction positions that cannot be reconciled with those advanced by Petitioner Southwest in the District Court. There, Southwest has taken the position that key claim terms of the ‘000 Patent are “indefinite under 35 U.S.C. § 112” because, according to Southwest, such terms are “open to multiple interpretations, making the claim scope uncertain.” Ex. 2004, 302-303. Yet, in this IPR, Southwest has abandoned those positions in favor of interpretations intended to support invalidity arguments in this forum — **all without acknowledging**, let alone justifying, the inconsistency. While a Petitioner is not strictly prohibited from advancing inconsistent positions, a Petitioner doing so needs to explain why the inconsistent positions are warranted. *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper #12, 8 (PTAB December 13, 2024) (informative) (“At a minimum, the Petition should have explained “why the inconsistent positions are warranted”). Petitioners have provided no such

explanation because there is no legitimate justification for Petitioners' strategy of advancing inconsistent positions in multiple proceedings hoping one will prevail.

As detailed below, the indefiniteness allegations of Southwest in the district court cannot be reconciled with Petitioners' position here that the challenged claims should be construed "in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent." Petition, 7, *citing, AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). The indefiniteness positions of Petitioner Southwest in the district court are irreconcilable with those taken by Petitioners in this IPR because a claim term cannot be both "indefinite under 35 U.S.C. § 112, ¶ 2" because it is "open to multiple interpretations, making the claim scope uncertain" and, at the same time, have an "ordinary and customary meaning" as understood by "a person of ordinary skill in the art." Petitioner's failure to present a consistent and legally sound claim construction undermines the integrity of this proceeding and provides ample basis for discretionary denial.

A. "wherein a number of bits sent over the physical control channel is based on a number of fields of control information to be sent to the UE" (Claims 1 and 13)

By way of example, in the district court, Petitioner Southwest alleges that the phrase "wherein a number of bits sent over the physical control channel is based on a number of fields of control information to be sent to the UE" in independent claims

1 and 13 of the ‘000 Patent, is indefinite. In connection with this limitation, Petitioner Southwest alleges as follows in the District Court:

... What is meant by that the number of bits is based on a number of fields of control information? Does the number of bits increase based on a number of fields? The specification merely describes that a number of bits for the capacity of the PLCCH is matched to a number of bits required in a feedback field, but does not describe that a number of bits change based on *a number of* fields. Without a defined meaning, the phrase is open to multiple interpretations, making the claim scope uncertain. Ex. 2004, 303 (emphasis added).

By contrast, in this IPR, Petitioner Southwest has no problem ascribing an “ordinary and customary meaning” to the same claim term and then purporting to map this claim element to Liu. Petition, 49-52 (purporting to map “wherein a number of bits sent over the physical control channel is based on a number of fields of control information to be sent to the UE” to disclosures in Liu).

B. “assigned time intervals” and “in a time interval that it is not sending information over the physical uplink shared channel” (Claims 1 and 13)

Southwest’s inconsistent claim construction positions are further demonstrated by Southwest’s treatment of “assigned time intervals” and “in a time interval that it is not sending information over the physical uplink shared channel” in claims 1 and 13 of the ‘000 Patent. In connection with these limitations, Petitioner Southwest alleges as follows in the District Court:

How is a time interval for data transmitted defined? How is it assigned? When does a time interval in which information is not received over the

physical uplink shared channel occur? The specification does not use the term “time interval,” nor does the specification clearly describe situations in which transmissions are sent during a time interval that it is not sending information over the physical uplink shared channel. Without a defined meaning, the phrase is open to multiple interpretations, making the claim scope uncertain. Ex. 2004, 303 (emphasis added).

By contrast, in this IPR, Petitioner Southwest has no problem ascribing an “ordinary and customary meaning” to each of the same claim terms and then purporting to map these claim elements to prior art. Petition, 39 (purporting to map sending “over the physical uplink shared channel, data in assigned time intervals” to disclosures in Papasakellariou) and 40-41 (purporting to map sending/receiving “in a time interval that it is not sending/receiving information over the physical channel” to disclosures in Papasakellariou).

C. The Director’s Recent Decisions In *Reevo* And *Tesla* Demonstrate That The Failure Of Petitioner Southwest To Explain Its Inconsistent Claim Construction Positions Is Fatal

In *Reevo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 20 (Squires November 3, 2025) (precedential), the Director explained:

The Board’s claim construction rules are designed to ensure that the Board correctly construes claim terms to minimize inconsistency in claim construction between forums. See Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,349 (Oct. 11, 2018). To the end, the rules discourage petitioners from seeking broader constructions at the Board to support a patentability challenge while seeking narrower constructions in litigation to avoid infringement. As the Office explained when it changed the claim

construction stand used in *inter partes* reviews and post-grant reviews to match the standard used in litigation, “[petitioners] will have less flexibility to advance inconsistent arguments about claim scope, and will instead be required to choose a single claim construction that best captures the meaning the patent claim.” *Id.* That is not the case here, however, as petitioners continue to propose different claim constructions in the two forums.

Allowing petitioner to continue this practice does not further the Office’s goal of “providing greater predictability and certainty in the patent system.” 83 Fed. Reg. at 51,342-343. (emphasis added).

Similarly, in *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (Squires November 5, 2025) (informative), the Director vacated an institution decision where -- just like the present facts -- the Petitioner argued in District Court that certain claim terms were indefinite while maintaining in the IPR that the same terms be given “their plain and ordinary meaning.” *Id.*, at 2-3.

Simply put, the strategy adopted by Southwest of advancing inconsistent positions in multiple proceedings, hoping one will prevail, is a waste of the resources of the PTAB and favors discretionary denial.

IV. CONCLUSION

The facts have materially changed since the Director entered the Earlier Decisions declining to exercise discretion to deny institution in the six earlier IPRs challenging patents-in-suit in the American and Southwest District Court Litigations. As a result of the Board’s denial of institution in all of those cases on the merits, the District Courts -- as opposed to the Board -- are better suited to review

the validity of the remaining patents (including the ‘000 Patent) that have yet to reach an institution decision.

In addition, in the district court, Petitioner Southwest has taken the position that key claim terms of the ‘000 Patent are “indefinite,” while, in this IPR, Southwest has abandoned those positions in favor of interpretations intended to support invalidity arguments in this IPR—without acknowledging, let alone justifying, the inconsistency. This aspect of the Petition also favors discretionary denial.

For these reasons, the Director should deny institution.

Respectfully submitted,

Dated: November 24, 2025

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CERTIFICATE OF COMPLIANCE WITH WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), I certify that this **BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** complies with the type-volume limits set forth in the Memorandum and 37 C.F.R. § 42.24 because it contains 2,652 words, excluding the parts of the Brief that are exempted by 37 C.F.R. § 42.24(a), according to the word processing system used to prepare this Brief.

Respectfully submitted,

Dated: November 24, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** was served via email (as consented to by counsel) on November 24, 2025 to lead and backup counsel of record for Petitioner as follows:

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