

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

ERICSSON INC. and CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,
Petitioners,
v.
PROCOMM INTERNATIONAL PTE. LTD.,
Patent Owner.

Case No. IPR2024-01453

U.S. Patent No. 7,103,377

PATENT OWNER DISCRETIONARY DENIAL BRIEF REQUESTING
DENIAL OF INSTITUTION

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PATENT OWNER'S EXHIBIT LIST

EXHIBIT LIST	
2001	Docket Control Order in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.) dtd April 26, 2024 (Dkt. 23)
2002	Reserved
2003	Plaintiff's Opposition to Defendants' Motion to Stay in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.) dtd March 26, 2025 (Dkt. 56)
2004	United States District Courts—National Judicial Caseload Profile for 12-month period ending June 30, 2024; available at https://www.uscourts.gov/statistics-reports/analysis-reports/federalcourtmanagement-statistics
2005	LegalMetric District Report for Texas Eastern District Court in Patent Cases (January 2019-December 2024)
2006	Reserved
2007	Infringement contentions in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.) dtd March 20, 2024
2008	Docket Report for <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.)
2009	Invalidity Contentions in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.) dtd June 12, 2024
2010	Prosecution History of U.S. Pat. No. 8,670,722 to Ericsson
2011	Joint Claim Construction Statement in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.) dtd March 2, 2025 (Dkt. 43)
2012	Procomm Opening Claim Construction Brief in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.) dtd March 2, 2025 (Dkt. 48)
2013	Ericsson Responsive Claim Construction Brief in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.) dtd March 2, 2025 (Dkt. 54)

2014	Procomm Reply on Claim Construction in <i>Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.</i> , No. 2:24-cv-009-RWS-RSP (E.D. Tex.) dtd April 1, 2025 (Dkt. 59)
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I. INTRODUCTION

Pursuant to Acting Director Stewart's March 26, 2025 Memorandum entitled "*Interim Processes for PTAB Workload Management*" ("March 26, 2025 Memorandum"), Patent Owner Procomm International Pte. Ltd ("Procomm") respectfully requests that the Director exercise her discretion and deny institution of Petitioners Ericsson Inc. and Cellco Partnership's Petition for *inter partes* review of U.S. Patent No. 7,103,377.

The Petition should be denied because all factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) weigh in favor of discretionary denial. The district court in *Procomm International Ptd. Ltd. v. Verizon Communications, Inc. et al.*, No. 2:24-cv-009-RWS-RSP (E.D. Tex.) has already scheduled a jury trial on the '377 Patent ***nine months before*** the expected date of the Final Written Decision in this IPR. Conducting an IPR trial when the validity of the '377 Patent will have already been decided by the district court (1) is an inefficient use of the PTO's and parties' time and resources; (2) could lead to conflicting results; and (3) would undermine the objective of an IPR to be an ***alternative*** to district court adjudication of validity. *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, (PTAB Sept. 12, 2018), 19.

Furthermore, additional considerations set forth in the Director's March 26, 2025 Memorandum also favor discretionary denial. The additional considerations

relevant here include (1) the settled expectations of the parties, including how long the claims have been in force, and (2) the extent to which the petition relies on expert declarations to make its case for unpatentability (March 26, 2025 Memorandum, 2-3) – they weigh in favor of discretionary denial because (1) the '377 Patent has already expired, and (2) the Petitioners rely on duplicative expert declaration that is unreliable and unhelpful because it repeats the Petition word-for-word.

II. THE DIRECTOR SHOULD EXERCISE DISCRETION UNDER SECTION 314(a) TO DENY INSTITUTION PURSUANT TO *FINTIV*

The Director should deny institution under 35 U.S.C. §314 because all six *Fintiv* factors favor discretionary denial. The *inter partes* review statute leaves institution entirely at the discretion of the Director. *See* 35 U.S.C. §314(a); *Harmonic Inc. v. Avid Tech.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

The Director has historically applied that discretion where efficiency considerations stemming from parallel proceedings on the same patent warrant denial of institution. *See NHK Spring Co. v. Intri-Plex, Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (“*NHK Spring*”). The Director has considered six factors for determining whether

efficiency and fairness support the exercise of authority to deny institution based on a parallel proceeding (the “*Fintiv* factors”):

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties as of the time of the institution decision;
4. Overlap between issues raised in the petition and in the parallel proceeding;
5. Whether the petitioner(s) and the defendant in the parallel proceeding are the same party; and
6. Other circumstances that impact the Board’s exercise of discretion, including whether the petition was filed “promptly after becoming aware of the claims being asserted” and the merits of the petition.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv I*”), 5-16; *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (PTAB May 13, 2020) (order denying institution) (informative, designated July 13, 2020) (“*Fintiv II*”), 7-8.

Here, all six *Fintiv* factors weigh in favor of discretionary denial, the Petition is weak on the merits, and Petitioners have not even bothered to submit a *Sotera*-type stipulation.

Procomm respectfully requests that the Director deny institution under *Fintiv*.

A. *Fintiv* Factor 1

The first *Fintiv* factor—regarding whether a stay exists or is likely to be granted if a proceeding is instituted—weighs heavily in favor of denial. The Petitioners’ motion to stay pending IPR filed on March 12, 2025, was denied on April 6, 2025 as premature. Ex. 2008 (Docket Report, Dkt. 62), 8.

Even if an IPR was instituted, the district court judge is unlikely to stay the case absent agreement from the parties. Ex. 2005, 3 (showing only a 20% win rate on contested motions to stay pending IPRs decided by Judge Schroeder in the Eastern District of Texas). Thus, this factor strongly weighs in favor of denial.

B. *Fintiv* Factor 2

The second *Fintiv* factor—the proximity of the court’s trial date to the Board’s projected statutory deadline for a Final Written Decision—strongly weighs in favor of denial. Petitioners only recently filed this IPR on December 31, 2024—nearly one year after the January 10, 2024, service of Patent Owner’s Complaint.

Ex. 2008, 4 (Docket Report, Dkt. Nos. 5-6, return of summons). The Notice of Filing Date Accorded to Petition was mailed on January 29, 2025. Paper 4. A Final Written Decision will thus be due by July 29, 2026. *See* 35 U.S.C. §314(b); 35 U.S.C. §316(a)(11).

Because Petitioners waited until the last minute to file their IPR, the parallel district court litigation has already proceeded to an advanced stage, and the district court has already scheduled jury selection for October 20, 2025. Ex. 2001 (Docket Control Order), 1. Thus, the Final Written Decision is expected *nine months after* the trial. Furthermore, the result is similar even when considering the median time from filing to disposition of the civil trial for the parallel litigation in the Eastern District of Texas rather than the scheduled trial date. The current median time-to-trial in the Eastern District of Texas is 23 months. Ex. 2004, 35. The district court litigation was filed on January 8, 2024. Ex. 2008 (Docket Report), 3. These statistics indicate that the trial would occur around December 2025. Thus, both the actual scheduled trial date in the parallel litigation and the median time-to-trial statistics for the Eastern District of Texas place the trial between October and December 2025—seven to nine months before the expected Final Written Decision.

Under *Fintiv* Factor 2, this weighs heavily in favor of discretionary denial. *See Fintiv I*, 9 (“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this factor in favor of exercising authority to deny institution under NHK.”); *Ericsson Inc. et al v. Collison Communications, Inc.*, IPR2022-01233, Paper 12, (PTAB Jan. 19, 2023), 12-13 (holding that Factor 2 “weighs in favor of denying institution, given that we would not expect to issue a final written decision until at least four months” after trial). *See also Ericsson Inc. v. Active Wireless Tech. LLC*, IPR2024-00886, Paper 8 (PTAB Nov. 12, 2024), 8-9 (Factor 2 weighs in favor of denying institution where trial date is eight months before expected date of final written decision); *Verizon Business Network Services LLC v. Huawei Tech. Co. Ltd.*, IPR2020-01278, Paper 12 (PTAB Jan. 26, 2021), 9-10 (Factor 2 weighs in favor of denial where “the district court has set its trial date ... approximately eight months before our deadline to reach a final decision”). Here, the 9-month gap between the district court trial and the Final Written Decision is even longer than in these other cases where the Board denied institution. *Id.*

Finally, granting institution here would frustrate one of the primary objectives of the AIA “to provide an effective and efficient **alternative**” to parallel litigation. *NHK Spring*, 19-20 (quoting *General Plastic Indus. Co., Ltd. v. Canon*

Kabushiki Kaisha, IPR2016-01357, Paper 19, (PTAB Sept. 6, 2017) (precedential, designated Oct. 18, 2017), 15-19 (emph. added). If an IPR is instituted, any potential FWD would issue well after trial concludes. Thus, instituting an IPR here would not be an alternative to parallel litigation. Rather, it would simply relitigate issues that would have been already decided in the parallel litigation.

C. *Fintiv* Factor 3

The third *Fintiv* factor—which relates to “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision” (*Fintiv I* at 9)—also favors denial. Significant amounts of work have been completed in the district court. The parties have completed their P.R. 3-1 and 3-2 disclosures (Infringement Contentions), their P.R. 3-3 and 3-4 disclosures (Invalidity Contentions), and have substantially completed claim construction briefing. Ex. 2001, 4-5. By the expected July 29, 2025, institution decision date (*see* 35 U.S.C. §314(b)), the District Court will have held a *Markman* hearing, and the parties will have completed fact discovery and expert discovery. The parties will have also completed their briefing of dispositive motions. *Id.*

Thus, by the expected time of the institution decision, most of the substantive work will have been completed in the district court litigation, and essentially all that is left is trial. *See Fintiv II*, 14 (“based on the level of investment

and effort already expended on claim construction and invalidity contentions in the District Court, this factor weighs somewhat in favor of discretionary denial in this case.”). The facts here “support the arguments that the parallel proceeding is more advanced ... and instituting would lead to duplicative costs.” *Fintiv I*, 10. Under these circumstances, it would be an extremely inefficient use of the parties’ and the Board’s time and resources to relitigate issues that would be almost certainly be decided before the expected deadline to file a Patent Owner Response in this IPR.

Finally, Petitioners are solely responsible for this course of events. Petitioners waited within two weeks of the one-year statutory deadline before filing this IPR and, in doing so, allowed the parallel district court litigation to advance substantially ahead of the expected schedule of this IPR. Petitioners’ invalidity contentions were filed on June 12, 2024. Ex. 2001, 1; Ex. 2009 (invalidity contentions). There is no justification for Petitioners waiting until December 31, 2024—more than 6 months after their invalidity contentions—to file this IPR. It would be unfair to require Procomm to duplicate work that has already been done in the parallel litigation because of Petitioners’ delays. *See Fintiv II*, 14. Accordingly, Factor 3 weighs heavily in favor of non-institution.

D. *Fintiv* Factor 4

The fourth *Fintiv* factor—which relates to overlap between issues raised in the petition and in the parallel proceeding—also weighs in favor of denying institution. “[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Fintiv* at 12. The Petition challenges independent Claim 1 (Pet., 15), which is also asserted in the litigation. Ex. 2007.

Further, the single reference (Solum) applied by this Petition (Pet., 15) for IPR is identically found in the invalidity contentions in the parallel litigation. *See* Ex. 2009 (alleging invalidity in view of Solum). The invalidity contentions in the litigation also include obviousness combinations combining Solum with “prior art systems related to prior art references” (*id.*, 6, 55)—overlapping combinations that would not be precluded by Petitioners’ weak *Sands Revolution* stipulation. The overlap between the IPR grounds and the combinations in the parallel litigation strongly weighs in favor of non-institution.

Petitioners argue that factor 4 weighs against discretionary denial because they “stipulate that if the IPR is instituted, it will not pursue the same grounds in the district court litigation.” Pet., 36 (*citing Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 (PTAB June 16,

2020)). Patent Owner submits that this is a weak “*Sand Revolution*”-style stipulation that should be entitled to no weight because it only precludes Petitioners from pursuing the exact same grounds in the Petition and does not preclude Petitioners from reusing the same prior art in different grounds with minor modifications. Even in previous administrations, the Board has historically assigned almost no weight to *Sands Revolution* style stipulations such as the one Petitioners filed here. *LG Elecs., Inc. v. Ancora Techs., Inc.*, IPR2021-00581, Paper 16, (PTAB June 10, 2021), 9-10 (same); *Google LLC v. EcoFactor Inc.*, IPR2021-00454, Paper 9 (PTAB July 22, 2021) (same); *Samsung Electronics Co. Ltd. v. California Institute of Tech.*, IPR2023-00130, Paper 10, (PTAB May 4, 2023), 19-20 (same); *Roku, Inc. v. IOENGINE, LLC*, IPR2022-01554, Paper 11 (PTAB May 5, 2023), 13-14 (same). A *Sands Revolution*-style stipulation does little to eliminate overlap with the district court litigations, and Petitioners’ stipulation here does nothing to prevent the alleged prior art reference asserted in the Petition from being re-used in substantially the same form in the litigation by combining it with other secondary references, as Petitioners’ invalidity contentions already propose doing. The stipulation here is almost meaningless.

To the extent the Director is inclined to consider Petitioners’ *Sands Revolution* style stipulation, the Board has often denied institution in situations like

the present where the other factors clearly favored non-institution, even where Petitioners offered stronger stipulations than the one offered here. For example, in *LG Elecs., Inc. v. Ancora Techs., Inc.*, No. IPR2021-00581, Paper 16, (PTAB June 10, 2021), 9-10, the Board denied institution despite the petitioner’s stipulation “it will not subsequently assert invalidity in the district court on the same grounds asserted in the IPR or on the basis of the Hellman reference, either alone or in combination with any other reference.” *Id.* Unlike Petitioners’ stipulation here, the petitioner in *Ancora* agreed to a blanket stipulation not to assert the primary reference Hellman under any circumstance. The Board there agreed with the patent owner that, even with the petitioner’s stipulation, “there is significant overlap between the issues raised in the Petition and in the parallel district court proceeding.” *Id.* Similarly, in *Samsung Electronics Co., Ltd. v. California Institute of Technology*, IPR2023-00130, Paper 10 (PTAB May 4, 2023), the Board denied institution notwithstanding a stipulation it characterized as “broader to some degree than the stipulation discussed in *Sand Revolution*” because “the trial in the Underlying Litigation would commence several months before the expected date of our final written decision” and there had been significant investment in the litigation. *Id.*, 16-20.

The facts here are stronger than *Ankora* and *Samsung*. Procomm submits that Petitioners’ stipulation should be assigned minimal weight. Accordingly, Factor 4 strongly favors discretionary denial.

E. *Fintiv* Factor 5

The fifth *Fintiv* factor—whether the petitioners and the defendant in the parallel proceedings are the same parties—weighs in favor of discretionary denial. The parties here are the same as the parties in the litigations. *Fintiv II*, 15 (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”).

F. *Fintiv* Factor 6

The sixth *Fintiv* factor—relating to other circumstances that impact the Board’s exercise of discretion, including the merits—weighs in favor of discretionary denial.

1. Promptness of Filing of the Petition

The *Fintiv* decision places a heavy emphasis in Factor 6 on whether the petition was filed expeditiously, specifically, whether the petition was filed “promptly after becoming aware of the claims being asserted.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), 11-12. In this case, the Petitioner waited *more than 9 months* after receiving Procomm’s

March 2024 infringement contentions before filing this Petition. See Ex. 2007 (infringement contentions). That is the opposite of expeditious and weighs in favor of discretionary denial.

2. Merits of the Petition

The merits of the Petition are weak and thus weigh in favor of discretionary denial. The Petition relies upon a single ground of anticipation by Solum. Pet., 16. The Petition must thus demonstrate that Solum discloses every claim limitation exactly as arranged. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). “The [prior art] must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Here, Solum does not disclose “a gain factor that is determined in response to a remaining portion of the total system dynamic range after attenuation of other signal levels of the plurality of signal levels” as in independent claim 1. This explicit language requires that the gain factor “is determined” responsive to “a remaining portion of the total system dynamic range after attenuation of other signal levels of the plurality of signal levels.” In other words, the claim requires determining a specific gain factor value based on the remaining dynamic range. Column 7 line 26 to column 8 line 34 of the ’377 Patent confirms this by

disclosing a “gain calculator” for generating gain factors for each port based on the remaining dynamic range of the remaining signals.

By contrast, Solum does not determine a specific claimed gain factor value based on the remaining dynamic range. Instead, paragraph 15 of Solum describes increasing or decreasing the weighted coefficients applied to the input signals “until a satisfactory power level is achieved.” Ex. 1004, [0015]. At most, paragraph 15 discloses that the weighted coefficients are increased or decreased to achieve a satisfactory power level – there is no disclosure of determining a specific weighted coefficient that achieves the satisfactory power level. Rather than determining a gain factor, Solum merely discloses achieving the satisfactory power level through trial and error by increasing or decreasing the weighted coefficients. The Petition confirms this by arguing that Solum utilizes a feedback loop to adjust the weighted coefficients based on the output signal. Pet., 29-30. But this trial-and-error approach is different than determining a specific gain factor value as disclosed and claimed by the ’377 Patent – Solum does not disclose determining a specific gain factor value as required for anticipation.

III. THE DIRECTOR SHOULD DENY INSTITUTION BASED ON OTHER RELEVANT CONSIDERATIONS

Acting Director Stewart's March 26, 2025 Memorandum identifies other considerations that favor discretionary denial here.

A. Settled Expectations of the Parties

Acting Director Stewart's March 26, 2025 Memorandum identified "the [s]ettled expectations of the parties, such as the length of time the claims have been in force," as a relevant consideration. March 26, 2025 Memorandum, 2.

Having been granted almost 20 years ago, the '377 Patent is now expired. Ex. 1001. These Petitioners or others had almost twenty years to challenged the '377 Patent via petition for IPR or a request for reexamination (*ex partes* or *inter partes*) over the life of this patent—but did not. Based on the length of the time the '377 Patent has been in force and the fact that it is now expired, Procomm has settled expectations as to the validity of its patent, and, particularly, to its right to have that validity adjudicated in a district court pursuant to the Seventh Amendment subject to the clear and convincing presumption of validity accorded by statute. U.S. Const. amend. VII; 35 U.S.C. §282(a); *Microsoft Corp. v. i4i Ltd. Partnership*, 564 U.S. 91, 97 (2011).

Further, Petitioners were aware of the '377 Patent at least as early as 2013 when it was cited by an examiner during prosecution of Ericsson's U.S. Patent No.

8,670,722. Ex. 2010, 10 (showing assignment to Ericsson), 205 (citing the '377 Patent). Petitioners offer no excuse for waiting from 2013 to 2024 before challenging the '377 Patent, all the while allowing Patent Owner's expectation of exclusivity to become settled.

B. Petitioners' Extensive Reliance on Unreliable and Parroted Expert Testimony

Acting Director Stewart's March 26, 2025 Memorandum identified "the extent of the petition's reliance on expert testimony" as a relevant consideration. March 26, 2025 Memorandum, 2.

Here, the Petition extensively relies on the declaration of Petitioners' expert Dr. Henry Houh. Ex. 1003. Dr. Houh testifies that a person of ordinary skill would have been familiar with wireless communications. Ex. 1003, ¶49 ("With respect to the '377 Patent, a POSA would have been familiar with Distributed Antenna Systems and wireless communications in general."). But Dr. Houh testifies that his qualifications are in *network* communications, not wireless communications, and it does not appear that the qualifications provided by Dr. Houh are sufficient to meet his own definition of a POSA. Ex. 1003, ¶¶11-20 (listing his expertise as "Web Site Development, Data Networking, Optical Networking, Telecommunications, and Media Streaming"—not wireless communications—and providing experience

in computer networks, telephone Voice-over-IP, and speech recognition—again, not wireless communications). Dr. Houh’s declaration does not provide a single example of experience with wireless communications. *Id.*

The only mention of radios in Dr. Houh’s background is that a former classmate founded “a software radio company” sometime in the late 1990s and that Dr. Houh would sometimes speak with him. Ex. 1003, ¶13. But the fact that Dr. Houh knew somebody 30 years ago that might qualify as a POSA and that they spoke about software radios occasionally does not mean Dr. Houh himself qualifies as a POSA. Indeed, Dr. Houh’s POSA definition requires at least “one to two years” of work experience in radio communications (EX1003, ¶48), but Dr. Houh identifies no actual work experience in that field.

Furthermore, a comparison of pages 20-33 of the Petition and paragraphs 78-117 of Dr. Houh’s Declaration shows that the Declaration is merely a word-for-word copy of the Petition’s arguments. This is particularly problematic because the Petition periodically alleges in conclusory fashion that “a POSA understood” a particular assertion and then cites to Dr. Houh’s Declaration where the assertion is simply repeated verbatim without additional supporting evidence. *See, e.g.,* Pet., 23 (alleging that “A POSA understood the signal level at the antenna input port corresponds to or at a minimum is highly reflective of the signal level at the

antenna of the DRU because only de minimis losses would be expected between an antenna port and the output port of the DRU.”); Ex. 1003, ¶71 (same allegation). Respectfully, a declaration by an expert who lacks the requisite qualifications and whose testimony merely parrots the exact language of the Petition should be accorded little weight and merit denial of institution.

Indeed, The Federal Circuit has held that expert declarations that parrot the petition should be disregarded. *Bell Semiconductor LLC v. NXP B.V.*, 2024 WL 4984053 at *3 (Fed. Cir. 2024) (unpub.) (“Board accurately characterized NXP’s expert testimony as conclusory and correctly pointed out that the only evidence in NXP’s petition was a citation of their expert’s declaration that parrots the language of the petition.”); *Garmin International, Inc. v. LoganTree, LP*, 825 Fed.Appx. 894, 898 n.5 (Fed. Cir. 2020) (unpub.) (“The Board, however, correctly found that Garmin’s expert merely parroted attorney argument without any supporting evidence or reasoning.”).

The Board, too, has repeatedly held that expert declarations like Dr. Houh’s—which parrots the Petition ***word-for-word***—should be disregarded. *See, e.g., Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 (Director Review: Feb. 10, 2023) (precedential), 5 (“the declaration copies, word-for-word, Petitioner’s conclusory assertions ... as though they are facts, rather than setting

forth facts and evidence in support of Petitioner’s assertions”); *Halliburton Energy Services, Inc. v. Schlumberger Tech. Corp.* IPR2017–02072, Paper 11, 2018 WL 1891086 (PTAB Apr. 12, 2018) (decision denying institution) at *7 (“Mr. Todd’s testimony, which, again, merely parrots the conclusory statement ... is entitled to little, if any, weight”); *Free-Flow Packaging Int’l, Inc. v. Automated Packaging Sys., Inc.*, IPR2016-00447, Paper 7 (PTAB June 22, 2016), 10 (“Dr. Kimmel’s declaration...does nothing more than parrot the language of the Petition word for word”).

In sum, the Petition is based on duplicative and unreliable expert testimony. In an IPR, expert testimony is supposed to explain the reasoning and evidence in a manner that helps the Board understand the arguments in the Petition. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 (Director Review: Feb. 10, 2023) (precedential), 5. An expert declaration like this one, which merely parrots the Petition word-for-word throughout based on the say-so of an unqualified expert, does not help the Board at all.

In light of all of this, Petitioners’ expert declaration unduly multiplies the effort required to evaluate its Petition.

The use of expert testimony in connection with this Petition thus weighs in favor of non-institution.

IV. CONCLUSION

For the foregoing reasons, the Director should deny institution.

Dated: April 28, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner Discretionary Denial Brief Requesting Denial of Institution consists of 4,008 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The Request complies with the type-volume limitation of 14,000 words set out at 37 C.F.R. §42.24 and Acting Director Stewart's March 26, 2025 Memorandum titled "Interim Processes for PTAB Workload Management." In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

Dated: April 28, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that, pursuant to 37 CFR § 42.6(e), a true and correct copy of the foregoing **PATENT OWNER DISCRETIONARY DENIAL BRIEF REQUESTING DENIAL OF INSTITUTION** has been served electronically via email on counsel of record for Petitioners:

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