

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**AT&T SERVICES, INC. and STREAMWIDE, INC.
Petitioners,**

v.

**BK TECHNOLOGIES, INC.
Patent Owner.**

Case: IPR2026-00349

U.S. Patent No. 12,375,890

**PETITIONERS' OPPOSITION TO PATENT OWNER'S
DISCRETIONARY DENIAL BRIEF**

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EX. 1008	FirstNet Authority, <i>Introducing FirstNet Fusion: New Mission-Critical Platform will Revolutionize First Responder Communications</i> (October 16, 2025), https://about.att.com/story/2025/firstnet-fusion.html
EX. 1009	AT&T, <i>FirstNet Empowers the Era of the ‘Connected Responder’</i> (April 14, 2026), https://about.att.com/blogs/2026/firstnet-empowers-connected-responder-era.html
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EX. 1014	Motion to Stay filed in <i>BK Technologies, Inc. v. AT&T Mobility, LLC et al.</i> , No. 2-26-00090 (E.D. Tex. Aug. 6, 2026) (J. Schroeder III).

I. INTRODUCTION

AT&T Services, Inc. (“AT&T”) and StreamWide, Inc. (“SW”) (together, “Petitioners”) respond to Patent Owner BK Technologies, Inc.’s (“PO”) brief seeking discretionary denial of the Petition for Inter Partes Review (“IPR”) of U.S. Patent No. 12,375,890 (the “‘890 patent”). The Petition promotes two strong public interests. First, it clearly establishes the invalidity of a patent that was issued in error and seeks its efficient invalidation. Second, it addresses the assertion of that patent against AT&T and its FirstNet Fusion system, a first responder communication system supported by the Federal government for the public’s safety. Importantly, the facts underlying this Petition exemplify and conform to *all* principles, guidance, and tests the Director has deemed relevant in deciding whether to invoke discretionary denial, and *all* considerations weigh in favor of not invoking discretionary denial. The *Fintiv* factors weigh strongly in Petitioners’ favor due to: (a) the early posture of the parallel District Court proceeding, (b) a timely stay motion (brought before the case has even been set for a scheduling conference), (c) a *Sotera* stipulation establishing estoppel, and (d) compelling merits. Denial is also not appropriate because the Petition does not rely on substantially the same prior art or arguments previously presented to the Office and because there was material error by the Examiner during prosecution. Further, the PO has no settled expectations for this newly issued patent.

PO's discretionary denial brief, short on any real reasons to deny the Petition, glosses over, or entirely omits, any treatment of these critical considerations. Instead, PO complains about the lack of a *Sotera* stipulation—which Petitioners have now provided, and SW's potential contract and tortious interference claims against PO, which SW has promised *not* to assert if the subject Petitions are instituted. There is simply no reason to invoke discretionary denial in this case.

II. FACTUAL BACKGROUND

Petitioner AT&T is a telecommunications company that provides communications services and related technology to consumers, businesses, and government customers. Congress established the FirstNet Authority, an independent governmental agency tasked with creating a nationwide, dedicated mobile broadband network for first responders after 9/11. (EX. 1008). AT&T was awarded the contract to build, operate, and support the FirstNet network. (EX. 1007).

Petitioner SW is a global communication software technology developer and provider that offers real-time communications solutions for, *inter alia*, public safety organizations. One of SW's core platforms is Team On The Run ("TOTR"), a comprehensive communication platform that allows instant and secure connection between remote teams. (EX. 1013, Declaration of Pascal Béglin Dec. ("Béglin Dec."), ¶ 6). In 2019, SW began developing TOTR's "guest function," allowing users to securely invite guests to join conversations by sending the guest a URL to

download the application. (*Id.*, ¶¶ 7-8). TOTR is separate from, and unrelated to, the prior art included in the Petitions, including U.S. Patent No. 9,794,761 (“Mazzarella”). (*Id.*, ¶ 25).

TOTR was fully operable and commercially available when SW was approached by PO in April 2022. (*Id.*, ¶ 11). PO lacked the technical expertise to develop its own system and asked SW to develop and host a custom communications solution on top of SW’s TOTR solution. (*Id.*, ¶¶ 10-11). SW customized TOTR to meet PO’s request. (*Id.*, ¶¶ 12-14). By June 20, 2022, SW had fully designed the BKT overlay and it was released by July 8, 2022. (*Id.*, ¶ 14). SW and PO entered into a Reseller Agreement on or around July 22, 2022, providing that SW owned TOTR and PO owned SW’s “Reseller Improvements” (*Id.*, ¶¶ 17-18). On February 2, 2024, PO filed U.S. Patent Application 18/431,686, which matured into the ‘890 patent. The 18/431,686 application was a continuation of application No. 17/844,488, which is now Patent No. 11,997,568, the subject of IPR2026-00348. The ‘890 patent is subject to a terminal disclaimer in light of the ‘568 patent and its patentably indistinct subject matter. The ‘890 patent’s claims are broader than the mere improvements SW made to its TOTR platform and, instead, encompass the guest function of SW’s prior art TOTR system.¹

¹ TOTR is prior art to the ‘890 patent, however because the system has not been sufficiently described in a patent or printed publication it is not included in the Petition.

In a completely separate project, in June 2024, AT&T approached SW for assistance in implementing its Fusion platform. (*Id.*, ¶ 20). Fusion was AT&T’s push-to-talk platform designed to integrate smartphone-based public safety communications with traditional land mobile radio (LMR) systems used by first responders. (EX. 1008). Fusion requires all users to operate under a subscriber license. (EX. 1013, Béglin Dec., ¶ 23; EX. 1008).

On February 3, 2026, PO initiated a patent infringement proceeding against AT&T in the Eastern District of Texas, No. 2-26-00090. SW moved to intervene on May 6, 2026 and PO did not oppose. As of the date of the filing of this brief, SW’s motion is pending. SW and AT&T filed the Petition in the present proceeding on May 1, 2026.

III. SOTERA STIPULATION AND “NON-PATENT COUNTERCLAIMS”

Contemporaneous with the present brief, Petitioners have submitted a *Sotera* stipulation that, if the Patent Trial and Appeal Board (“PTAB”) institutes an IPR of the ‘890 patent, neither AT&T nor SW will pursue any ground of invalidity as to this patent that was raised or could have been raised in the instituted IPR in the co-pending District Court Case, No. 2-26-00090 (E.D. Tex) (J. Schroeder III). Therefore, to the extent that the Petition is instituted and any claim of the ‘890 patent is found valid, Petitioners will not assert any invalidity defense as to this patent in the District Court based upon any patent or printed publication as a primary

reference. Further, if both this Petition and the Petition in IPR2026-00348 are instituted, and SW's pending Motion to Intervene in the District Court is granted, SW will refrain from bringing the breach of contract and tortious interference counterclaims in the District Court Case that SW intended to bring.²

Contrary to PO's argument, there is no requirement that a Petitioner provide its *Sotera* at the time of its Petition. See *BMW of North America LLC v. Northstar Systems LLC*, IPR2023-01017, Paper 12, 10 (P.T.A.B. December 8, 2023); *Samsung Elecs. Co., Ltd. v. g+ Commc'ns, LLC*, IPR2023-00441, Paper 10, 18 (P.T.A.B. Aug. 3, 2023) (rejecting argument that "the offer of a *Sotera* stipulation is 'belated' and should have been provided before PO spent the time to brief the issue"). A Petitioner need only submit a *Sotera* stipulation in advance of the PTAB's deadline for entering its institution decision. *BMW of North America LLC v. Northstar Systems LLC*, IPR2023-01017, Paper 12, at 10 n. 11 (P.T.A.B. December 8, 2023). Because Petitioners' *Sotera* stipulation is consistent with existing estoppel principles already in effect under the applicable caselaw, PO already knew that, at a minimum, Petitioners would be estopped from asserting art in the parallel case that reasonably could have brought at the PTAB. See *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th

² To the extent that SW is permitted to intervene and has filed its Answer and Counterclaims before the PTAB considers the present brief, SW will voluntarily dismiss its breach of contract and tortious interference counterclaims (designated as the "non-patent counterclaims by PO) should the PTAB institute its IPR Petitions.

1354, 1366-67 (Fed. Cir. 2025). Thus, PO could have addressed the impact of the estoppel scenario in its discretionary denial brief but chose not to. PO has not been prejudiced by the timing of the filing of the *Sotera* stipulation.

IV. PUBLIC NATURE OF THE DISPUTE

The Petition raises a public dispute involving public safety, not a private dispute as PO contends. The ‘890 patent, a governmental right, issued in error. The material and anticipatory Mazzarella reference was never identified or considered by the Examiner. Mazzarella solves the same problem the ‘890 patent purports to solve, in the same way. (Pet. at 21). PO is now asserting infringement of the wrongly issued patent to obstruct AT&T’s Fusion platform, designed at the behest of the federal government for the public’s safety. This is the epitome of a public dispute.

PO’s allegations about this being a “private” dispute are wrong. First, the modifications SW made to its TOTR solution for PO are *completely* different than the system SW provides to AT&T for its FirstNet Fusion platform. (Br. at 7) (EX. 1013, Béglin Dec., ¶¶21-23). Second, Mazzarella, which issued on October 17, 2017, is not affiliated with, and has no relation to, either of the Petitioners. (*Id.*, ¶ 25). This Petition simply seeks to efficiently invalidate the ‘890 patent using prior art not owned by any of the parties to ensure that Fusion can continue to operate to protect the public in furtherance of AT&T’s obligations to the U.S. government, not decide a private dispute.

V. THE FINTIV FACTORS SUPPORT INSTITUTION

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) is the governing framework for discretionary denial where parallel litigation exists.

A. Factor 2: Proximity of the Court’s Trial Date to the PTAB’s Projected Statutory Deadline for a Final Written Decision

Petitioners filed the Petition within three months of the PO initiating the District Court case and that case is in its infancy (a scheduling order has not yet been entered by the Court and a trial date is not yet set). The average time to trial in Judge Schroeder’s patent cases is 3 years and 1 month. (EX. 1010). Even if the Court entered a scheduling order today, any trial will not likely be scheduled until March 2029. Comparatively, the PTAB will decide whether to institute the IPR by November 2026, and a final written decision would be expected by November 2027—long before a trial in front of J. Schroeder. This weighs strongly against discretionary denial, as PO concedes. (Br. at 16).

B. Factor 3: Investment in the Parallel Proceedings by the Court and Parties

Given the posture of the District Court case, the parties have not invested much resource. Outside of the pleadings, SW moved to intervene and PO did not oppose. The Court has not yet decided SW’s unopposed motion to intervene, scheduled an initial conference, or issued a case schedule. This factor weighs strongly against discretionary denial, which PO does not dispute. (Br. at 16).

C. Factor 4: Overlap Between Issues Raised in Petition and in Parallel Proceeding

Petitioners’ *Sotera* stipulation “mitigates certain concerns of duplicative efforts between the District Court and the Board, as well as concerns of potentially conflicting decisions” and “weighs strongly in favor of not exercising discretion to deny institution.” *Apple Inc. v. Haptic, Inc.*, IPR2024-01476, Paper 11, 12 (P.T.A.B. Apr. 4, 2025); *Lg Elecs., Inc. v. Ancora Techs., Inc.*, IPR2021-00581, Paper 15, 10 (P.T.A.B. June 10, 2021) (Even a narrow stipulation that does not encompass grounds that “reasonably could have been raised in the IPR” weighs “marginally against denying institution”). For example, if the Petition were to be instituted and if any claim of the ‘890 patent found valid, Petitioners will not assert any invalidity defense as to this patent in the District Court based upon any patent or printed publication as a primary reference. *Supra*, § III. This factor weighs against discretionary denial.

D. Factor 1: Whether a Stay Was Requested and Whether Evidence Exists that a Stay is Likely if an IPR is Instituted

A stay is appropriate, as addressed in detail in Petitioners’ Motion to Stay as submitted to the District Court, and due largely to the early posture of the case and the extent to which an IPR would simplify or entirely resolve the District Court case. (EX. 1014). Importantly, the Court has granted stays in cases at similar, or even later, postures than the stage of the District Court case against Petitioners. *See, e.g.*,

Resonant Systems, Inc. d/b/a RevelHMI v. Nintendo Co., Ltd., 2-25-cv-00090 (E.D. Tex. July 28, 2025) (stayed when “Defendant filed IPR petition just thirty-eight days after Plaintiff filed suit” and “the parties had not yet invested resources into the discovery process, nor had the Court yet invested resources into claim construction”); *Maxeon Solar Pte. Ltd. v. Canadian Solar, Inc.*, 2-24-cv-00210 (E.D. Tex. July 1, 2025) (stayed when parties had not taken a single deposition and discovery was at an early stage); *RavenWhite Licensing LLC v. The Home Depot, Inc. et al*, 2-24-cv-00688 (E.D. Tex. June 18, 2025) (stayed while case was still in its early stages); *Harbor Island Dynamic, LLC v. Samsung Electronics Co., Ltd. et al*, 2-24-cv-00140 (E.D. Tex. May 19, 2025) (stayed when significant discovery and many other important deadlines remained); *Cellspin Soft, Inc. v. ByteDance Ltd. et al*, 2-23-cv-00496 (E.D. Tex. Jan. 27, 2025). Indeed, because (a) Petitioners provide a *Sotera* stipulation, (b) SW agrees not to assert “non-patent counterclaims” (breach of contract and tortious interference claims) if the IPRs are instituted, and (c) the Petition addresses all asserted claims in parallel case, the IPR would either entirely resolve the District Court case or drastically simplify it.

AT&T has already filed a motion seeking a stay if the Board institutes the pending IPR petitions. (EX. 1014). That fact further pushes this factor against discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 12 (P.T.A.B. May 13, 2020) (informative); *Roku, Inc. v. Ioengine, LLC*, IPR2022-

01553, Paper 11, 10 (P.T.A.B. May 5, 2023). This factor therefore weighs against discretionary denial.

E. Factor 5: Whether the Petitioner and Defendant in the Parallel Proceeding are the Same

Here, the PO is the Plaintiff in the parallel case and Petitioner AT&T is one of the named Defendants. The other Petitioner, SW, not named as a Defendant in the parallel litigation, has moved to intervene. Here, because the parties were not identical at the inception of the case, and because SW's motion to intervene has not yet been granted, this factor weighs against denial, but at worst, is neutral.

F. Factor 6: Other Circumstances, Including the Merits of the Case

Factor 6 provides the petitioner with “the opportunity to draw attention to particular grounds that it believes are particularly persuasive of unpatentability.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15–16 (P.T.A.B. May 13, 2020). Here, the merits of the Petition are strong and largely §102 based. *See Dolby Lab'ys, Inc. v. Intertrust Techs. Corp.*, IPR2020-00662, Paper 13, 15 (P.T.A.B. Oct. 15, 2020) (noting that petitioner's “case appears reasonably persuasive on two independent prior art grounds including an anticipation ground, meaning that it has a strong case going forward”). Like its parent, the '890 patent ultimately issued because the concept of a non-subscriber was missing from the prior art. (EX. 1011,

PO Appeal Brief at 22-24, 26-36).³ This limitation is explicitly taught by Mazzarella.

PO's attack of the merits of the Petition is vague and unclear. It appears to argue that the claims of '890 patent require a single control device to both manage the claimed talkgroup and provide access to the talkgroups, while Mazzarella purportedly discloses only "disparate control components" and a "decentralized function." (Br. at 15). But the '890's claims do not require a single control device, nor does PO identify where in Mazzarella these allegedly "disparate control components" are mandated. PO also argues that Petitioners' "disregard key aspects of Mazzarella's express disclosures, including its characterization of talkgroups as push-to-talk based and its distinct process for user onboarding and participation." (Br. at 15). If PO is arguing that Mazzarella does not teach "push-to-talk," that is untrue as Mazzarella discusses its "system for ... managing dynamic PTT talk groups" throughout the reference, as identified in the Petition. (Pet. at 10-12). If PO is arguing that Mazarella teaches "push-to-talk" but just not push to talk *over cellular*, that argument also fails because Mazzarella discloses that the PTT talk groups may be accessed using cellular devices or over a cellular network, thus rendering the PTT talk groups described in Mazzarella as POC talk groups. (*Id.* at

³ PO filed an appeal in the application leading to the '568 patent highlighting this argument, which was accepted by the USPTO who went on to allow the '890 patent with a terminal disclaimer to obviate a double patenting rejection over the '568 patent.

11). PO never identifies what Mazzarella’s allegedly “distinct” “onboarding and participation” process is or how it is different from the claims of the ‘890 patent. (Br. at 15).

PO also criticizes the lack of a supporting expert declaration. (*Id.*). PO ignores that the Mazzarella reference, on its face, is so clearly anticipatory that it does not require an expert to recognize its teachings or explain how it reads on the ‘890 claims. “No rule requires a Petition to be accompanied by any declaration, let alone one from an expert guiding the Board as to how it should read prior art.” *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015). It is particularly appropriate to forego an expert’s opinion when the teaching “is easily understandable and does not require expert explanatory testimony.” *Dyson Tech. Ltd. v. Omachron Intell. Prop. Inc.*, IPR2024-01162, Paper 9, 4 (P.T.A.B. Jan. 13, 2025).

VI. THE SAME OR SUBSTANTIALY THE SAME ART WAS NOT BEFORE THE EXAMINER

Under 35 U.S.C. § 325(d), the PTAB may deny institution when the same or substantially the same prior art or arguments were previously presented to the Office. The PTAB should not exercise discretion under § 325(d) to deny petitions that present new, noncumulative art to the Office. *Oticon Medical AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15, 19-20 (P.T.A.B. Oct. 16, 2019) (precedential). Here, Mazzarella was neither cited nor discussed by the Examiner, nor was it identified in

an IDS by the PO. Mazzarella is new and noncumulative art because it teaches the “granting a first non-subscriber device access to the POC service and the first POC talkgroup” limitations that PO asserted were not in the prior art. (EX. 1011). Therefore, the Petition’s prior art teaches the precise limitations that were stated to be missing from the prior art considered during prosecution; for this reason alone, the Petition should not be denied. *See Jubilant Draximage Inc. v. Bracco Diagnostics Inc.*, IPR2018-01449, Paper 7, 19-20 (P.T.A.B. Feb. 8, 2019). Mazzarella is indisputably material. It discloses the same technical solution to the same problem the ‘890 patent attempts to solve—facilitating interagency communications during an emergency incident without requiring complicated administrative procedures so that different responding personnel with smart phones can communicate with each other, even if they are from different agencies and do not subscribe to the same POC service. (Pet. at 21).

VII. MATERIAL ERROR

The Petition should be instituted to correct material errors made during prosecution because the Examiner failed to conduct a proper search of the prior art. A material, anticipatory reference like Mazzarella should have been identified by the Examiner’s searches and analyzed—that it wasn’t constitutes error. *Quasar Sci. LLC v. Colt Int’l Clothing, Inc.*, IPR2023-00611, Paper 10, 14 (P.T.A.B. Oct. 10, 2023) (“petitioner may show material error by showing that the Office failed to reject the

claims over the asserted art. In other words, a petitioner’s showing that the challenged claims are unpatentable over the asserted prior art may itself be evidence of material error by the Office during prosecution”). *See also Ecto World, LLC v. Rai Strategic Holdings, Inc.*, IPR2024-01280, Paper 16, 15 (P.T.A.B. June 25, 2025) (Board declined to exercise discretion, stating that the “Office erred by not substantively considering” prior art references that were among over 1,000 other references listed on an IDS.); *Anthony Inc. v. ControlTec LLC*, IPR2025-00636, Paper 9, 2 (P.T.A.B. July 16, 2025) (material error by Examiner in overlooking Petitioner’s prior art); *Eunsung Global Corp. v. Hydrafacial LLC*, IPR2025-00445, Paper 14, 2-3 (examiner error in failing to consider particular piece of prior art); *Voltage v. Grp.*, PGR2024-00022, Paper 11, 69-70 (P.T.A.B. Sept. 30, 2024) (determining there was “no basis for discretionary denial” when “Petitioner ... asserts that it was error for the examiner not to assert [four prior art references] during prosecution”); *Chemtronics Usa, Inc. v. Flatfrog Lab ’ys Ab*, IPR2024-00015, Paper 11, 18-19 (P.T.A.B. Apr. 22, 2024) (finding error when Examiner did “not issue a rejection based on Han or even substantively discuss Han during examination” despite IPR petition relying on Han reference to teach a limitation that Examiner found lacking in the prior art); *Verizon Bus. Network Servs., Inc. v. Huawei Techs. Co., Ltd.*, IPR2020-01079, Paper 10, 30-31 (P.T.A.B. Jan. 14, 2021) (finding “material error” by an Examiner in overlooking a reference that was not art

of record in prosecution and also not cumulative); *Amazon.com, Inc. v. Vb Assets, LLC*, IPR2020-01346, Paper 7, 9 (P.T.A.B. Feb. 4, 2021) (finding “Petitioner has demonstrated material error by the Office” in failing to have “appreciated or considered the teachings” of the prior art reference).

The Examiner submitted two search strategy documents during prosecution, beginning with searches of inventor names before transitioning to keyword searches, the vast majority of which required the word “push” to be in very close proximity to the word “cellular.” (EX. 1012). For example, the search string “push adj2 talk adj2 cellular” was used extensively. (*Id.*) These unreasonably narrow searches automatically excluded Mazzarella from each and every search, because Mazzarella generally teaches “push to talk” technology, with cellular being one option, but the term “cellular” is not used within two words of “push to talk.” Such a search strategy indicates that the Examiner did not “obtain[] a thorough understanding of the invention disclosed and claimed” and was not “fully aware of the what the claims do not call for, as well as what they do require.” M.P.E.P., § 904.

VIII. FACTORS FROM THE MARCH 26, 2025 MEMORANDUM

The factors below were identified in the Director’s March 26, 2025 Memorandum as relevant to the question of discretionary denial. These factors weigh against discretionary denial.

A. Whether the PTAB or Another Forum has Already Adjudicated the Validity of the Challenged Claims

Neither the validity nor patentability of any claims of the ‘890 patent have ever been adjudicated by the PTAB or any other forum. This weighs against discretionary denial.

B. Strength of the Unpatentability Challenge

See supra, § V(F). This factor weighs against discretionary denial.

C. Extent of the Petition’s Reliance on Expert Testimony

The Petition does not rely on expert testimony. Most importantly, the use of expert testimony is not used to fill any gaps—all limitations are found in the prior art references themselves. *See Cambridge Indus. Usa, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 12, 2 (P.T.A.B. June 27, 2025). Indeed, eight of the challenged claims are anticipated by Mazzarella, thereby showing that expert testimony is not necessary. Overreliance on expert testimony weighs in favor of a discretionary denial. That is not the case here. This factor weighs against denial.

D. Settled Expectations of the Parties

Unlike older patents that are entitled to settled expectations, “[e]arly challenges favor robust, predictable patent rights and weigh against discretionary denial.” *Sun Pharms. Indus. Inc. v. Nivagen Pharms., Inc.*, IPR2025-00893, Paper 18, 2 (P.T.A.B. Sept. 19, 2025) (challenged patents issued a year prior were not “in force for a significant period of time”). Here, the ‘890 patent issued on July 29, 2025, just one year ago, weighing against discretionary denial. *See Tesla, Inc. v. Bulletproof Prop.*

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Mgmt., LLC, IPR2026-00204, Paper 14, 4 (P.T.A.B. June 15, 2026) (finding lack of settled expectations when the petition was brought “within two years of issuance”); *Padagis Us LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, 3 (P.T.A.B. July 16, 2025) (no settled expectations when patent issued four years prior; *Embodys, Inc. v. Lifenet Health*, IPR2025-00248, IPR2025-00249, Decision, Paper 13 at 2-3 (P.T.A.B. June 26, 2025) (no settled expectations for patent issued three years ago). Here, PO has not developed strong settled expectations that favor discretionary denial. This factor weighs against discretionary denial.

E. Compelling Economic, Public Health, or National Security Interests

AT&T’s Fusion platform was developed in furtherance of AT&T’s contract with the FirstNet Authority. (EXs. 1007, 1008, 1009). As such, AT&T has a contractual obligation to this government agency to provide services and create a broader communications infrastructure for public safety. (Ex. 1009). The Fusion platform was created specifically to protect public safety in times of crisis and disaster. (EXs. 1008, 1009). PO is using the ‘890 patent to obstruct the public safety and prevent Petitioner AT&T from carrying out its obligations to the federal government. *See e.g., Tesla, Inc. v. Bulletproof Property Management, LLC*, IPR2026-00204, Paper 14, 5 (Director June 15, 2026) (informative) (“Petitioner provides evidence of its manufacturing activities in the United States” which “further demonstrates that discretionary denial in these proceedings is not

appropriate”). There is a strong public interest in invalidating “bad patents” and, particularly, bad patents that are being used to the detriment of the public health and safety. *Thryv, Inc v. Click-To-Call Techs., LP*, 590 U.S. 45, 46, (2020).

IX. PO’S ARGUMENTS ARE UNSUPPORTED BY THE FACTS AND THE LAW

PO’s arguments boil down to only four baseless points and ignore the vast majority of considerations relevant to the discretionary denial decision. PO’s points are (1) Petitioners have not requested a Stay and that an Eastern District case is not likely to be stayed; (2) the IPR will not fully resolve the District Court case because of SW’s non-patent counterclaims; (3) there will be a duplication of issues with respect to invalidity among the IPR and the parallel District Court proceeding; and (4) the Petition serves only private interests, namely to gain litigation leverage in a purely private dispute. Each is incorrect.

First, explained above, a stay of the parallel proceeding has been requested by Petitioner AT&T and a stay is appropriate given the early posture of the case. (EX. 1014).

Second, the IPR can fully resolve the District Court case. At this time, the non-patent counterclaims that PO argues would prevent an IPR from fully resolving the parallel case have not even been asserted and Petitioner SW is not yet a party to the District Court case. However, if SW is permitted to intervene in the parallel action, SW has agreed *not* to assert its breach of contract and tortious interference

counterclaims if the IPRs are instituted. Therefore, an IPR can fully and totally resolve the parallel litigation, contrary to PO's arguments.

Third, Petitioners submitted *Sotera* stipulation that moots PO's argument that there will be any duplication between the IPR and the District Court case. PO needlessly points to three separate "invalidity theories" that Petitioners have purportedly advanced—1) the Mazzarella/Tillet theory as set forth in the Petition; 2) the Siegel reference that counsel for Petitioner provided to counsel for PO pursuant to negotiations under FRE 408, and 3) SW's own TOTR system art—claiming that Petitioners will use one at the PTAB and save the rest for the parallel litigation. (Br. at 9). This argument disregards that if the Petition is instituted, Petitioners are estopped from relying on other patents or printed publications in the District Court case due to the pertinent estoppel provisions and Petitioners' *Sotera* stipulation. *See Ingenico Inc.*, 136 F.4th at 1366-67. So, if the IPR is instituted, Petitioners will not be able to raise the Siegel reference against the patent in the District Court as PO contends. As for SW's own system art, because Petitioners could not introduce TOTR in the PTAB, this invalidity theory can only be advanced in the District Court. There will be no duplication whatsoever as TOTR could not be brought here. And, unlike the scenario that *Magnolia Medical Technologies, Inc. v. Kurin, Inc.*, warns against, this system art is not represented by patents or printed publications asserted in the IPR. IPR2026-00097, Paper 17, 3 (Director May 14, 2026) Further, no patents

or printed publications exist that cover the TOTR system art and thus could have been brought in an IPR. In any event, if the present Petition is instituted and the ‘890 patent invalidated, the parallel proceeding would be entirely resolved as to the 890 patent. If the Petition is instituted and the ‘890 not invalidated, then the parallel proceeding would be drastically narrowed.

Finally, the Petition is not an attempt to gain any litigation leverage in a “private dispute” like that identified by *Magnolia*. (Br. at 5-6). As explained, this case perfectly exemplifies the kind of public dispute that IPRs were intended to resolve. (*Supra*, § IV). The mere fact that there is a relationship between the parties and the existence of TOTR as system art not before the PTAB does not turn this into a private dispute, especially since Mazzarella is not TOTR but is entirely unaffiliated with SW. Further, the present case is very far from *Magnolia*, as there has been no progress in the District Court case and a *Sotera* stipulation in conjunction with general estoppel principles would prevent duplication of issues between the IPR and the District Court case. Here, there is no second bite at the apple.

X. CONCLUSION

For the reasons set forth herein as well as in the Petition, Petitioners respectfully request that the Director decline to deny institution.

Respectfully submitted,

Dated: August 7, 2026

By: /s/ Joseph V. Saphia

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CERTIFICATE OF COMPLIANCE

Pursuant to the Interim Director Discretionary Process, I certify that this paper complies with the 20-page limit requirement for discretionary denial briefs.

Dated: August 7, 2026

By: /s/ Jessica H. Zafonte

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R § 42.6(e), I hereby certify that a true and correct copy of the foregoing was served on Counsel for Patent Owner via filing through the P-TACTS System, as well as by delivering a copy via electronic mail to the following:

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