

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

ERICSSON INC. and CELLCO PARTNERSHIP D/B/A VERIZON
WIRELESS,
Petitioner,

v.

PROCOMM INTERNATIONAL PTE. LTD.,
Patent Owner.

IPR2024-01452 (Patent 8,583,100 B2)
IPR2024-01453 (Patent 7,103,377 B2)
IPR2024-01454 (Patent 7,724,521 B2)

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

DECISION
Granting Patent Owner's Request for Discretionary Denial
and Denying Institution of *Inter Partes* Review

IPR2024-01452 (Patent 8,583,100 B2)
IPR2024-01453 (Patent 7,103,377 B2)
IPR2024-01454 (Patent 7,724,521 B2)

Procomm International Pte. Ltd. (“Patent Owner”) filed a Request for Discretionary Denial (Paper 11, “DD Req.”) in the above-captioned cases, and Ericsson and Celco Partnership D/B/A Verizon Wireless (“Petitioner”) filed an opposition (Paper 13, “DD Opp.”).¹ With authorization, Patent Owner filed a Reply (Paper 14, “PO Reply”) and Petitioner filed a Sur-Reply (Paper 15, “Pet. Sur-Reply”).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in these proceedings. This determination is based on the totality of the evidence and arguments the parties have presented.

IPR2024-01452 and IPR2024-01454 present the same discretionary considerations as those discussed in *Ericsson Inc. et al. v. Procomm International PTE. LTD*, IPR2024-01455, Paper 15 (Acting Director Stewart May 16, 2025). Accordingly, that analysis is incorporated here. *See* IPR2024-1455, Paper 15 at 2–3. Although Petitioner asserts that the district court has delayed the scheduled trial date by four months (Pet. Sur-Reply 1), it is still unlikely that a final written decision in this proceeding (projected July 29, 2026) will issue before the district court trial occurs (scheduled Feb. 17, 2026). Therefore, the discretionary considerations favor discretionary denial for the same reasons set forth in IPR2024-01455. *See* IPR2024-1455, Paper 15 at 2–3.

IPR2024-01453 presents different circumstances. The challenged patent was dismissed with prejudice from the litigation on March 2, 2025. IPR2024-01453, DD Opp. 2 (citing Ex. 1011); IPR2024-01453, PO Reply 1.

¹ Citations are to papers in IPR2024-01452 unless otherwise noted. The parties filed similar papers in IPR2024-01453 and IPR2024-01454.

IPR2024-01452 (Patent 8,583,100 B2)

IPR2024-01453 (Patent 7,103,377 B2)

IPR2024-01454 (Patent 7,724,521 B2)

Additionally, the challenged patent has been in force since as early as 2006 and Petitioner was aware of it as early as 2013—having been brought to Petitioner’s attention in a Notice of References Cited during the prosecution of one of its own patents. IPR2024-01453, PO Reply 2 (citing Ex. 2015, 214); *see iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (Acting Director Stewart June 6, 2025). Also, as Patent Owner asserts, it is an inefficient use of Board resources to review a challenged patent that has been dismissed with prejudice from the litigation. IPR2024-01453, PO Reply 1–2. Patent Owner’s arguments of inefficiency and settled expectations tip the balance in favor of discretionary denial.

Although certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions are denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

ORDERED that Patent Owner’s Request for Discretionary Denial is *granted*; and

FURTHER ORDERED that the Petitions are *denied* and no trial is instituted.

IPR2024-01452 (Patent 8,583,100 B2)

IPR2024-01453 (Patent 7,103,377 B2)

IPR2024-01454 (Patent 7,724,521 B2)

FOR PETITIONER:

Patrick McPherson

Patrick Muldoon

Donald English

Kevin Anderson

DUANE MORRIS LLP

pdmcpherson@duanemorris.com

pcmuldoon@duanemorris.com

djenglish@duanemorris.com

kpanderson@duanemorris.com

FOR PATENT OWNER:

James Carmichael

Stephen McBride

Minghui Yang

Stephen Schreiner

CARMICHAEL IP, PLLC

jim@carmichaelip.com

stevemcbride@carmichaelip.com

mitch@carmichaelip.com

schreiner@carmichaelip.com

Amanda Sewanan

SCHULTE ROTH & ZABEL LLP

amanda.sewanan@srz.com