

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.

IPR2024-01455
Patent 8,497,813 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

Procomm International PTE. LTD (“Patent Owner”) filed a Request for Discretionary Denial (Paper 11, “DD Req.”) in the above-captioned case, and Ericsson and Cellco Partnership D/B/A Verizon Wireless (“Petitioner”) filed an opposition (Paper 13, “DD Opp.”). With authorization, Patent Owner filed a Reply (Paper 14) to address Petitioner’s stipulation.

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

In particular, the related district court trial is set to conclude substantially before a final written decision will issue in this proceeding. Patent Owner served Petitioner with a complaint on January 10, 2024. DD Req. 4. The current median time-to-trial in the Eastern District of Texas is 21.6 months. *Id.* at 5 (citing Ex. 2004, 35). Accordingly, trial is likely to occur around October 2025. *Id.* This is consistent with the trial schedule, which sets jury selection for October 20, 2025. *Id.* at 4 (citing Ex. 2001). The projected due date for the final written decision in this proceeding is July 29, 2026. Petitioner acknowledges that a trial date in the related district court litigation will precede the projected final written decision issuance date in this proceeding by nine months. DD Opp. 4. Petitioner points to Patent Owner’s service of proposed amended infringement contentions to explain why it waited nearly a year to file the Petition notwithstanding the early trial date. *Id.* at 5–6. Petitioner, however, does not explain sufficiently the nature of those proposed amendments and how they impacted the timing of the Petition. Additionally, there is insufficient evidence the district court is likely to stay its proceeding even if the Board were to institute trial.

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 Petition is 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 Petition is *denied* and no trial is instituted.

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