IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T SERVICES INC., CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS, AND NOKIA OF AMERICA CORPORATION

Petitioners,

v.

RIGHTQUESTION, LLC

Patent Owner.

U.S. Patent No. 11,856,132
Issue Date: December 26, 2023

Title: VALIDATING AUTOMATIC NUMBER IDENTIFICATION DATA

Inter Partes Review No.: IPR2025-00361

PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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PETITIONERS' EXHIBIT LIST

Exhibit #	***Description***
1001	U.S. Patent No. 11,856,132 ("'132 Patent")
1002	File History for U.S. Patent No. 11,856,132
1003	Expert Declaration of Patrick McDaniel, Ph.D.
1004	U.S. Patent Publication No. 2012/0144198 ("Har")
1005	Intentionally Omitted
1006	Intentionally Omitted
1007	AT&T Infringement Contentions Cover Pleading, *RightQuestion, LLC v. AT&T Corp., et al.*, No. 2:24-cv-00094-JRG (E.D. Tex.) Served: May 14, 2024.
1008	Second Amended Docket Control Order in *RightQuestion, LLC v. Cellco, Verizon Business Network Services LLC et al.*, No. 2:24-cv-00091 (E.D. Tex., October 20, 2024) (Lead Case)
1009	Dave Otway and Owen Rees. 1987. Efficient and timely mutual authentication. SIGOPS Oper. Syst. Rev. 21, 1 (Jan. 1987), 8–10. https://doi.org/10.1145/24592.24594
1010	Simpson, E., Schaumont, P. (2006). Offline Hardware/Software Authentication for Reconfigurable Platforms. In: Goubin, L., Matsui, M. (eds) Cryptographic Hardware and Embedded Systems - CHES 2006. CHES 2006. Lecture Notes in Computer Science, vol 4249. Springer, Berlin, Heidelberg. https://doi.org/10.1007/11894063_25 ("Simpson")
1011	Loh Chin Choong Desmond, Cho Chia Yuan, Tan Chung Pheng, and Ri Seng Lee. 2008. Identifying unique devices through wireless fingerprinting. In Proceedings of the first ACM conference on Wireless network security (WiSec '08). Association for Computing Machinery, New York, NY, USA, 46–55. https://doi.org/10.1145/1352533.1352542
1012	Ke Gao, C. Corbett and R. Beyah, "A passive approach to wireless device fingerprinting," *2010 IEEE/IFIP International Conference on Dependable Systems & Networks (DSN)*, Chicago, IL, 2010, pp. 383-392, doi: 10.1109/DSN.2010.5544294.

Exhibit #	***Description***
1013	Martins, Rui & Augusto, Alexandre & Correia, Manuel Eduardo. (2013). A Potpourri of Authentication mechanisms - The mobile device way.
1014	Abu-Hakima, Suhayya, Mansour Toloo and Tony White. “A Multi-Agent Systems Approach for Fraud Detection in Personal Communication Systems.” (2002).
1015	Hossain, A.K.M. Mahtab & Jin, Yunye & Soh, Wee-Seng & Van, Hien. (2013). SSD: A Robust RF Location Fingerprint Addressing Mobile Devices' Heterogeneity. Mobile Computing, IEEE Transactions on. 12. 65-77. 10.1109/TMC.2011.243.
1016	RFC 5280 Internet X.509 Public Key Infrastructure Certificate and Certificate Revocation List (CRL) Profile – Proposed Standard (May, 2008)
1017	Burnett, S. and Paine, S. (2001) RSA Security’s Official Guide to Cryptography. McGraw-Hill
1018	Boris Danev (2011) Physical-Layer Identification of Wireless Devices [Doctoral dissertation, ETH Zurich]. ETH Zurich Library Collection. https://www.research-collection.ethz.ch/handle/20.500.11850/72822
1019	Boris Danev, Davide Zanetti, and Srdjan Capkun. 2012. On physical-layer identification of wireless devices. ACM Comput. Surv. 45, 1, Article 6 (November 2012). https://doi.org/10.1145/2379776.2379782
1020	U.S. Pat. No. 9,129,130 (Filed: August 30, 2013; Priority: August 31, 2012)
1021	U.S. Patent Publication No. 2012/0131354 (“French”)
1022	U.S. Patent Publication No. 2012/0201381 (“Miller”)
1023	Joint Claim Construction Statement, *RightQuestion, LLC v. AT&T Corp., et al.*, No. 2:24-cv-00094-JRG (E.D. Tex.)
1024	REDACTED Plaintiff’s Opposed Motion for Leave to Amend Infringement Contentions as to the AT&T Defendants (Dkt 78), *RightQuestion, LLC v. AT&T Corp., et al.*, No. 2:24-cv-00094-JRG (E.D. Tex.)

Exhibit #	***Description***
1025	REDACTED Plaintiff's Opposed Motion for Leave to Amend Infringement Contentions as to the Verizon Defendants (Dkt 79), *RightQuestion, LLC v. AT&T Corp., et al.*, No. 2:24-cv-00094-JRG (E.D. Tex.) Dkt 79
1026	Defendants' Opposition to Plaintiff RightQuestion, LLC's Mpotion for Leave to Amend Infringement Contentions (Dkt 81), *RightQuestion, LLC v. AT&T Corp., et al.*, No. 2:24-cv-00094-JRG (E.D. Tex.)
1027	Federal Court Management Statistics, March 2025

I. INTRODUCTION

Petitioners AT&T Services Inc. ("AT&T"), Cellco Partnership d/b/a Verizon Wireless ("Verizon"), and Nokia of America Corporation ("Nokia")[1] (collectively, "Petitioners") hereby oppose Patent Owner RightQuestion, LLC's ("PO") request for discretionary denial ("Request" (Paper 8)) of Petitioners' Petition for *Inter Partes* Review of U.S. Patent No. 11,856,134 ("Petition" (Paper 4)). PO bases its request on the *Fintiv* factors and other considerations outlined in the Director's March 26, 2025 Memorandum titled "Interim Process for PTAB Workload Management" ("Workload Memo"), but PO mischaracterizes several material facts while ignoring others in seeking discretionary relief.

Petitioners acknowledge that trial in the parallel district court litigation is presently scheduled to occur before an expected final written decision in this proceeding. However, PTAB case law supports institution of the Petition notwithstanding the tentative trial schedule in the parallel litigation. A full analysis

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[1] Petitioner Nokia is not a party to the parallel litigation, but is a designer and supplier of some of the accused products. As such, Nokia has an interest in challenging the '989 Patent that extends beyond the parallel litigation. Thus, only the current IPR can provide the relief Nokia seeks regarding the patentability of all Challenged Claims, thus, weighing heavily against discretionary denial.

of the *Fintiv* factors and other considerations, particularly in view of Petitioners' stipulation, and the strength of the grounds set forth in the Petition, dictates that discretionary denial is not warranted and that PO's Request should be denied in the interest of efficiency, fairness and patent quality.

Accordingly, Petitioners hereby respectfully request that the Director deny PO's Request for discretionary denial and refer the Petition to the Board for a decision to institute *inter partes* review on the merits.

II. STIPULATION

In the Petition, Petitioners have stipulated that "[i]f the Board institutes IPR, Petitioners stipulate to not raising in the Related litigations any grounds that use the same combination of references herein." Pet. 77.

III. ANALYSIS

Discretionary denial under the *Fintiv* factors and other considerations is not warranted. *Fintiv* identifies six factors for the PTAB to balance in determining whether to exercise discretionary denial when there is a parallel district court proceeding: likelihood of a stay; the timing of trial; investment in the parallel proceeding; overlap of issues; overlap of parties; and other factors. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (Mar. 20, 2020) (precedential). Here, Factor 4 (overlap of issues), Factor 5 (overlap of parties), and Factor 6 (other factors) bear substantial weight in Petitioners' favor in view of Petitioners'

stipulation, the strong merits of the Petition, and Petitioner Nokia's insterest extending beyond the parallel litigation.

As of March 26, 2025, the Director includes other considerations in the holistic assessment alongside the *Fintiv* factors: whether the PTAB or another forum has already adjudicated the invalidity of the challenged claims; the strength of the unpatentability challenge; the extent of the petition's reliance on expert testimony; settled expectations of the parties; and any other considerations bearing on the Director's discretion. Workload Memo at 2-3. All of these other considerations too weigh in Petitioners' favor.

Accordingly, balancing all of the *Fintiv* factors and other considerations, the Director should deny PO's Request for discretionary denial.

A. Factor 1 – Likelihood of a Stay

No party has requested a stay, and the District Court has not indicated whether a stay would be granted in the parallel litigation. Therefore, this factor is neutral. *See, e.g., Hulu, LLC v. SITO Mobile, Ltd.*, IPR2021-00298, Paper 11 at 10-11 (PTAB May 19, 2021).

PO devotes nearly five full pages of the Request to speculate as to how a hypothetical motion to stay would be resolved. The Director should decline PO's invitation to do the same because the Board has repeatedly and consistently explained that it will not engage in such speculation before a motion to stay is

filed. *See Google, LLC v. Parus Holdings Inc.*, IPR2020-00847, Paper 9 at 12 (PTAB Oct. 21, 2020); *Fintiv*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (same); *SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 5 (PTAB April 7, 2025) (same).

B. Factor 2 – Timing of Trials

Petitioners acknowledge that trial is presently scheduled in the parallel litigation before a final written decision will issue in this proceeding. While this factor may favor discretionary denial, recent PTAB decisions also support institution of this Petition notwithstanding the present trial schedule. *See, e.g., Google LLC v. Mullen Industries LLC*, IPR2025-00019, Paper 14 at 13 (PTAB May 12, 2025) ("Although the earlier trial date weighs in favor of discretionary denial, the remaining factors are either neutral or weight against discretionary denial. Accordingly, we decline to exercise discretion to deny institution.").

Here, the gap between the present trial schedule and the statutory deadline for a final written decision may shrink. The District Court routinely finds good cause to reschedule trials, sometimes even more than once. *See*, *e.g.*, *Multimedia Techs. PTE Ltd. v. LG Elecs. Inc., et al.*, 2:22-cv-00494-JRG-RSP, Dkt. 273 (E.D. Tex. Mar. 18, 2025) (noting that "[t]his case has been set for trial five times: November 18, 2024, January 27, 2025, February 7, 2025, March 3, 2025, and March 17, 2025.").

Furthermore, in the parallel litigation, PO's actions have substantially increased the likelihood that the trial will be delayed, On May 6, 2025, PO filed belated motions to change its infringement cases and infringement contentions after the Court's Markman hearing and near the close of discovery. EX-1024, EX-1025. Those motions remain pending. However, if the motions are granted, it would likely require substantial delay in the trial schedule because, as noted by Defendants, it would require additional claim construction proceedings, additional prior art and invalidity contentions, and additional expert proceedings related to the changes. EX-1026 11-13.

In addition, the most recent Federal Court Management Statistics report from March 2025 indicates that the median time to trial in civil cases for the Eastern District of Texas is 25.9 months. (EX-1027 35) The data shows that trial schedules are being extended. *See Whirlpool Corp. et al. v. Shenzhen Sanlida Elec. Tech. Co.*, No. 2:22-CV-00027 (E.D. Tex. Mar. 25, 2025) (1092 days to trial); *Force Mos Tech., Co. v. ASUSTek Computer Inc.*, No. 2:22-CV-00460 (E.D. Tex. Jan. 22, 2025) (802 days to trial); *Touchstream Techs., Inc. v. Charter Communications Inc.*, No. 2:23-CV-00059 (E.D. Tex. Feb. 17, 2025) (746 days to trial). This too gives credence to the likelihood that the trial in the parallel litigation may be delayed.

C. Factor 3 – Investment in Parallel Proceedings

Despite the investment in the parallel litigation, as set forth below for Factor 4, in view of Petitioners' stipulation, there will be no overlap of patentability/validity to be tried between the parallel litigation and the IPR.

Although the District Court has issued a Claim Construction Order, the Order has no bearing on the grounds set forth in the Petition.

D. Factor 4 – Overlap of Issues

This factor strongly weighs against discretionary denial.

To mitigate any duplication concerns, Petitioners have stipulated that "[i]f the Board institutes IPR, Petitioners stipulate to not raising in the Related litigations any grounds that use the same combination of references herein." Pet. 77. In addition, Petitioners are not relying on any corresponding system art in the parallel litigation.

Furthermore, although Petitioners challenge here all claims asserted in the co-pending litigation, PO has asserted 70 claims from 3 patents in Related Litigations (EX-1016 3) – an amount that far exceeds the number of claims that the district court will allow at trial. Given that the PO will likely be limited to only five claims from the '132 Patent (at most), it is highly unlikely the district court addresses all Challenged Claims.

In addition, Petitioner Nokia is not a party to the parallel litigation. Thus,

the PTAB is the only forum in which the patentability/validity of the Challenged Claims in the ’132 Patent will be adjudicated for Petitioner Nokia.

E. Factor 5 – Overlap of Parties

This factor weighs against discretionary denial.

Petitioner Nokia is not a party to the parallel litigation, but is a designer and supplier of accused products. As such, Nokia has an interest in challenging the ’132 Patent that extends beyond the parallel litigation. Thus, only the current IPR can provide the relief Nokia seeks regarding the patentability of all Challenged Claims. Thus, this factor weighs against discretionary denial.

F. Factor 6 – Other Factors

The Petition presents compelling grounds of unpatentability supported by expert testimony, and it would be unjust for the Director to exercise her discretion to deny institution.

1. The Merits of the Petition are Strong and Unrebutted

The merits of the Petition are strong and unrebutted. PO is silent on the Petition’s merits, but rather argues generally that it “extensively relies upon unfocused and conclusory expert testimony.” Notably, PO’s entire argument cites only to the expert declaration, but identifies no deficiency in the Petition itself. For that reason alone, this factor should weigh against discretionary denial. *Samsung Electronics Co., Ltd. v. Clear Imaging Research, LLC*, IPR2020-01401, Paper 12 at 23 (PTAB Feb. 17, 2021) (encouraging parties to “point out, as part of the

factor-based analysis, particular 'strengths or weaknesses' to aid the Board in deciding whether the merits tip the balance one way or another."). But considering the Petition's merits, the Director will see that this factor strongly weighs against discretionary denial.

As described in the Petition, the Challenged Claims are directed to receiving device information and other data during a phone call to verify the caller identification information. This comparison is used to perform a security determination related to the communication. EX-1001, 2:46-62. The Challenged Claims' allowance was based solely on inclusion of a "cryptographic element associated with the caller device" limitation. *See* Pet., Section V.B, *infra*. Ex-1003, ¶25.

As detailed below, Har teaches a system for authenticating a "caller" which teaches, or renders obvious, the Challenged Claims – including the allegedly novel use of a "cryptographic element". A person of ordinary skill in the art ("POSA") also would be motivated to combine Har with Miller, which provides additional and complimentary disclose regarding the authentication of a calling device and device-specific authentication. As detailed below, Miller heavily overlaps the (later) '132 patent and provides extensive details about device-specific authentication. Pet. 1-2.

The Challenged Claims thus recite nothing more than a combination of prior

art elements, each used for its normal and intended purpose, that were well-known obvious modifications to a POSA. Pet. 2, EX-1003, ¶27.

2. Reliance on Expert testimony

Petitioners' reliance on expert evidence is entirely compliant with Federal Circuit precedent. Both *Phillips* and *KSR*, which form the foundation for claim construction and obviousness, require one to evaluate a patent and prior art from the perspective of a POSITA. Moreover, the Federal Circuit has made clear that attorney argument alone is insufficient. As such, PO's criticism of the Petition vis-à-vis Dr. McDaniel's expert declaration (EX-1003.) is misplaced. This consideration weighs against discretionary denial.

Obviousness grounds are evaluated from the perspective of a POSITA. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) ("If ***a person of ordinary skill*** can implement a predictable variation, §103 likely bars its patentability."), 418 ("[I]t can be important to identify a reason that would have prompted ***a person of ordinary skill*** in the relevant field to combine the elements in the way the claimed new invention does."). Here, again in accordance with Federal Circuit precedent, Dr. McDaniel provides his perspective on the obviousness of certain features claimed by the '009 Patent and the obviousness of the combination of certain references, with testimony supported by the required disclosure of references in accordance with 37 CFR § 42.65(a) and *Xerox Corp. v. Bytemark, Inc.*, IPR2022-

00624, Paper 9 (Aug. 24, 2022) (precedential). PO's assertion that the Petition somehow detrimentally "relies upon [Dr. McDaniel's] testimony, including attempting to plug gaps by arguing that certain features not disclosed in the relied-on references would have been obvious" does not comport.

Moreover, the Federal Circuit has made it clear that attorney argument is not evidence. *Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017) ("Attorney argument is not evidence.") (citing *Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371, 1380 (Fed. Cir. 2009) ("[U]nsworn attorney argument . . . is not evidence and cannot rebut . . . other admitted evidence . . ..")). *See also Elbit Sys. Of Am., LLC, v. Thales Visionix, Inc.*, 881 F.3d 1354, 1359 (Fed. Cir. 2018) ("Elbit fails to present any evidence supporting this contention beyond attorney argument … and '[a]ttorney argument is not evidence' and cannot rebut other admitted evidence."). The Board recently confirmed this: "It is well settled that mere attorney argument unsupported by factual evidence is entitled no probative value." *PLR Worldwide Sales LTD. v. Flip Phone Games, Inc.*, IPR2024-00209, Paper 28 at 32 (April 24, 2025). Because attorney argument is not evidence, expert testimony, such as Dr. McDaniel's declaration with citations to factual support underlying the opinions therein, is essential to properly support IPR obviousness positions.

III. APA CONSIDERATIONS

Notwithstanding the foregoing, the Workload Memo should not apply to the present Petition because that would violate the Administrative Procedure Act ("APA"). 5 U.S.C. §§ 551–559. First, the Director lacks authority to "promulgate retroactive rules." *Tafas v. Dudas*, 511 F. Supp. 2d 652, 666 (E.D. Va. 2007). Second, "general statements of policy" can only be applied prospectively. *Lincoln v. Vigil*, 508 U.S. 182, 197 (1993); 5 U.S.C. § 552(a)(2)(D)(ii). Third, the APA requires agencies to inform parties of the matters of "law asserted." 5 U.S.C. §554(b)(3). These violations are merely some examples that the Director should consider. Petitioners reserve the right to challenge the Workload Memo on other grounds including because it was adopted without notice-and-comment rulemaking.

IV. CONCLUSION

For the foregoing reasons, the Director should deny PO's request for discretionary denial of institution.

Dated: July 16, 2025

Respectfully submitted,

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CERTIFICATION OF SERVICE ON PATENT OWNER

Pursuant to 37 C.F.R. §§42.6(e), 42.8(b)(4) and 42.105, the undersigned certifies that on July 16, 2025, a complete and entire copy of this **Petitioners' Response to Patent Owner's Request for Discretionary Denial** was served in its entirety via filing through the Patent Trial and Appeal Case Tracking System (P-TACTS), as well as by delivering copies via electronic mail to the following:

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24 *et seq*., the undersigned certifies that this document complies with the type-volume limitations. This document contains 2,289 words as calculated by the "Word Count" feature of Microsoft 365, the word processing program used to create it.

Dated: July 16, 2025

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