

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONEPLUS TECHNOLOGY (SHENZHEN) CO., LTD.

Petitioner

v.

PANTECH CORPORATION

Patent Owner

IPR2025-00637

U.S. PATENT 9,763,283

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

TABLE OF CONTENTS

| | | |
|-----|---|----|
| I. | INTRODUCTION | 1 |
| II. | DISCRETIONARY DENIAL IS INAPPROPRIATE UNDER 35 U.S.C. § 314(a) | 2 |
| A. | Discretionary Denial Is Inappropriate Given the Strong Merits of the Unpatentability Challenge | 2 |
| 1. | The Petition presents strong merits on multiple grounds based on anticipation and single-reference obviousness | 2 |
| 2. | Discretionary denial is not warranted because a material error was committed by the Office during patent examination | 7 |
| B. | The PTAB Is Better Suited to Review a Large Number of Patents Involving Diverse and Complex Subject Matter | 14 |
| C. | There Are Compelling Economic Interests in Preventing a Non- Practicing Entity from Using Defective Patent Claims Against Manufacturers | 18 |
| D. | Patent Owner Has Not Established Settled Expectations | 22 |
| E. | Patent Owner’s Other <i>Fintiv</i> Arguments Are Unavailing | 27 |
| 1. | Factor 4: Petitioner’s stipulation to withdraw all §§ 102 and 103 challenges weighs strongly against discretionary denial | 27 |
| 2. | Factor 6: The strong merits of the Petition weigh against discretionary denial | 28 |
| 3. | Factor 1: Petitioner intends to request a stay, which is very likely to be granted | 28 |
| 4. | Factor 5: The parties are not identical | 30 |

| | | |
|------|--|----|
| 5. | Factor 3: Investment in the parallel litigation has been minimal, and Petitioner diligently filed the instant Petition | 30 |
| 6. | Factor 2: The FWD is likely to issue before or around the actual trial date in the district court litigation | 32 |
| III. | § 325(d) DISCRETION SHOULD NOT BE APPLIED..... | 35 |
| A. | Dudda, Lin, and Pelletier Are Not Cumulative to Art Previously Before the Patent Office..... | 35 |
| B. | The Examiner Materially Erred with Respect to the Patentability of the Challenged Claims | 37 |
| IV. | PATENT OWNER’S CONDUCT IN RELATED LITIGATION, NEGOTIATIONS, AND THIS PROCEEDING WEIGHS AGAINST DISCRETIONARY DENIAL | 37 |
| A. | Patent Owner’s Allegations of “Bad Faith” Are Baseless and Ignore Its Own Misconduct..... | 38 |
| B. | Patent Owner’s Litigation Misconduct Incited the Bias of the First Jury and Required a Second Trial..... | 39 |
| C. | The Jury Verdict Demonstrates Patent Owner’s Licensing Demands Constituted “Holdup” | 40 |
| D. | Patent Owner’s Conduct in this Proceeding Should Not Be Rewarded..... | 40 |
| V. | CONCLUSION..... | 43 |

LIST OF EXHIBITS

| Exhibit | Description |
|----------------|---|
| EX1001 | U.S. Patent No. 9,763,283 to Jung <i>et al.</i> |
| EX1002 | Prosecution History of U.S. Patent No. 9,763,283 |
| EX1003 | Declaration of Dr. Robert Akl |
| EX1004 | U.S. Patent No. 10,631,222 to Dudda <i>et al.</i> |
| EX1005 | U.S. Provisional Application No. 61/754,322 in the name of Dudda <i>et al.</i> |
| EX1006 | International Patent Application Publication No. 2014/110813 in the name of Lin <i>et al.</i> |
| EX1007 | U.S. Patent Application Publication No. 2011/0134774 in the name of Pelletier <i>et al.</i> |
| EX1008 | “LTE; Evolved Universal Terrestrial Radio Access (E-UTRA); Physical Layer Procedures (3GPP TS 36.213 version 11.0.0 Release 11),” ETSI TS 136 213 V11.0.0 (2012-10), available at https://www.etsi.org/deliver/etsi_ts/136200_136299/136213/11.00.00_60/ts_136213v110000p.pdf |
| EX1009 | “LTE; Evolved Universal Terrestrial Radio Access (E-UTRA) and Evolved Universal Terrestrial Radio Access Network (E-UTRAN); Overall Description; Stage 2 (3GPP TS 36.300 version 11.3.0 Release 11),” ETSI TS 136 300 V11.3.0 (2012-11), available at https://www.etsi.org/deliver/etsi_ts/136300_136399/136300/11.03.00_60/ts_136300v110300p.pdf |
| EX1010 | “LTE; Evolved Universal Terrestrial Radio Access (E-UTRA); Medium Access Control (MAC) Protocol Specification (3GPP TS 36.321 version 11.0.0 Release 11),” ETSI TS 136 321 V11.0.0 (2012-10), available at https://www.etsi.org/deliver/etsi_ts/136300_136399/136321/11.00.00_60/ts_136321v110000p.pdf |
| EX1011 | E. Dahlman <i>et al.</i> , “4G LTE/LTE Advanced for Mobile Broadband,” 1st ed. Elsevier, 2011 |
| EX1012 | U.S. Patent No. 9,814,075 to Kim <i>et al.</i> |
| EX1013 | U.S. Patent Application Publication No. 2012/0281548 in the name of Lin <i>et al.</i> |
| EX1014 | U.S. Patent Application Publication No. 2013/0028069 in the name of Pelletier <i>et al.</i> |

| Exhibit | Description |
|---------|--|
| EX1015 | U.S. Patent No. 9,118,452 to Park <i>et al.</i> |
| EX1016 | <i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv-00038-RWS-JBB (E.D. Tex.), Dkt. No. 47, First Amended Docket Control Order |
| EX1017 | A. Atayero, <i>et al.</i> , “3GPP Long Term Evolution: Architecture, Protocols and Interfaces,” International Journal of Information and Communication Technology Research, Volume 1, No. 7, November 2011 |
| EX1018 | Declaration of Zhe Wang |
| EX1019 | Declaration of Jia Hui Jiang |
| EX1020 | Correspondence with Patent Owner dated May 22, 2025 |
| EX1021 | <i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv-00038-RWS-JBB (E.D. Tex.), Dkt. No. 1, Complaint for Patent Infringement |
| EX1022 | <i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 6, First Amended Complaint for Patent Infringement |
| EX1023 | <i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 223, Redacted Amended Joint Final Pretrial Order |
| EX1024 | “Albright Worried Multipatent Trials Ask Too Much Of Jurors,” Law360 (Dec. 18, 2020), at https://www.law360.com/articles/1337976/albrightworriedmultipatent-trials-ask-too-much-of-jurors |
| EX1025 | <i>Sonos Inc. v. D&M Holdings, Inc.</i> , 1:14-cv-01330-WCB (D. Del.), Dkt. No. 418, Discovery Dispute Letter Brief |
| EX1026 | <i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv-00038-RWS-JBB (E.D. Tex.), Plaintiff’s Patent Infringement Contentions |
| EX1027 | USPTO Recordation of Patent Assignment Document, Reel: 052662 Frames: 0609-0638 |
| EX1028 | <i>Pantech Corp. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:25-cv-00089 (E.D. Tex.), Dkt. No. 1, Complaint for Patent Infringement |
| EX1029 | Docket Navigator Statistics for Judge Schroeder in E.D. Tex |
| EX1030 | <i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv-00038-RWS-JBB (E.D. Tex.), Dkt. No. 12, Joint Motion to Stay |

| Exhibit | Description |
|----------------|---|
| | Proceedings |
| EX1031 | <i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 259, Verdict Form |
| EX1032 | <i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 499, Final Judgment |
| EX1033 | <i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 502-1, Redacted Version of Court's Order (Dkt. No. 498) |

All citations to 35 U.S.C. §§ 102 and 103 in this paper refer to the AIA statutes.

All emphases in quotations are added unless otherwise noted.

Direct quotations of claim language are italicized.

This paper includes color illustrations and should be viewed in color.

I. INTRODUCTION

Discretionary denial (“DD”) of the instant Petition for *Inter Partes* Review (“IPR”) of U.S. Patent No. 9,763,283 (the “’283 Patent”) is wholly unwarranted. The Petition presents strong merits, including multiple straightforward anticipation and single-reference obviousness grounds and showing of a clear material error made by the Office during prosecution of the ’283 Patent. These merits alone weigh heavily against discretionary denial.

Additionally, institution is particularly appropriate because the PTAB is far better suited to resolve these complex patentability issues efficiently and consistently. The parallel district court litigation involves eight patents across distinct families, covering diverse and complex technologies, making it impractical for the district court to fully adjudicate validity within the limited trial framework.

Moreover, institution of this IPR serves important economic and public interests. Patent Owner’s aggressive monetization campaign—asserting patents with questionable validity to demand unreasonable royalties—has imposed significant burdens on manufacturers. Preventing such misuse of defective patents serves the American public.

Finally, Patent Owner has not developed settled expectations regarding the ’283 Patent. It only acquired the patent in 2020 and began asserting it in July 2021. Patent Owner’s settled expectations thus have not been established, particularly

given the history of validity challenges to its portfolio.

II. DISCRETIONARY DENIAL IS INAPPROPRIATE UNDER 35 U.S.C. § 314(a)

A. Discretionary Denial Is Inappropriate Given the Strong Merits of the Unpatentability Challenge

Discretionary denial is unwarranted considering the strong merits of the unpatentability grounds set forth in the Petition, consistent with the Acting Director’s *Interim Processes for PTAB Workload Management* (“Director Memo”). As detailed below, the Petition presents particularly strong merits because it: (i) presents multiple, straightforward anticipation and single-reference obviousness grounds, and (ii) identifies a material error made by the Office during prosecution of the ’283 Patent.

1. The Petition presents strong merits on multiple grounds based on anticipation and single-reference obviousness

The challenged claims of the ’283 Patent merely recite well-known radio link failure (RLF) handling techniques in wireless communication supporting dual connectivity—techniques that were extensively discussed, developed, and ultimately incorporated into the fourth-generation (4G) Long-Term Evolution (LTE) standard. All elements of the challenged claims, including the purportedly patentable subject matter, are expressly disclosed in U.S. Patent No. 10,631,222 to Dudda *et al.* (“Dudda,” EX1004), and independently rendered obvious by Dudda and International Patent Application Publication No. 2014/110813 in the name of

Lin *et al.* (“Lin,” EX1006). Both Dudda and Lin disclose the key limitation that Patent Owner argued was missing from the prior art and ultimately led to allowance of the ’283 Patent—namely, “*stop[ping] uplink transmission of the ... physical uplink control channel (PUCCH) ... to the secondary serving cell*” (hereinafter the “PUCCH Limitation”).

The Petition accordingly presents particularly strong unpatentability arguments on straightforward anticipation and single-reference obviousness grounds. Specifically, the Petition establishes that (i) all claims 1-13 are anticipated and rendered obvious by Dudda (Grounds 1 and 2), and (ii) all claims 1-13 are rendered obvious by Lin (Ground 4). *See* Pet. 4. These clear and well-supported challenges further demonstrate that discretionary denial is inappropriate, and that institution should be granted.

The similarities between the ’283 Patent and the prior art are striking. For example, FIG. A below presents a side-by-side comparison of FIG. 3 of the ’283 Patent—which illustrates the claimed “*wireless communication system supporting dual connectivity*”—with FIG. 3 of Dudda. Pet. 5, 9 (citing EX1003 – FIGs. F and H). Similarly, FIG. B below provides a side-by-side comparison between FIG. 3 of the ’283 Patent and FIG. 2 of Lin. Pet. 5, 48-49 (citing EX1003 – FIGs. F and I).

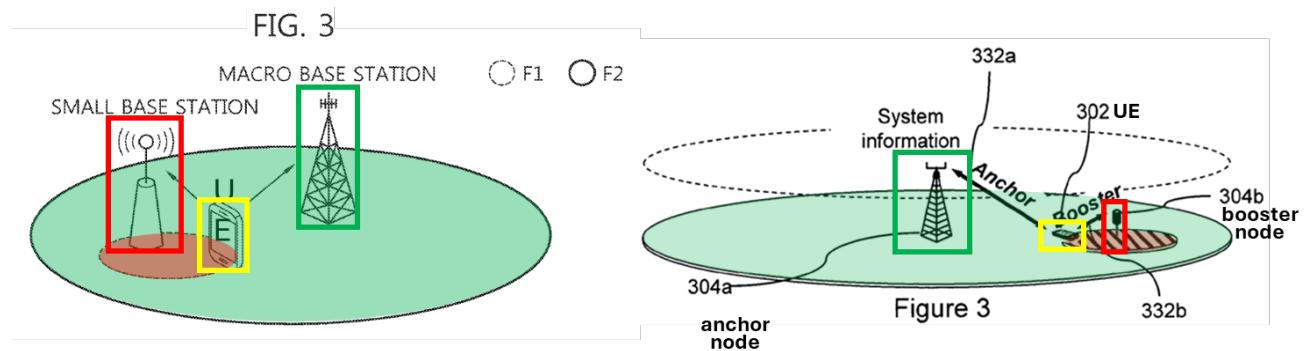


FIG. A: Side-by-side Comparison of Annotated FIG. 3 of the '283 Patent and Annotated FIG. 3 of Dudda

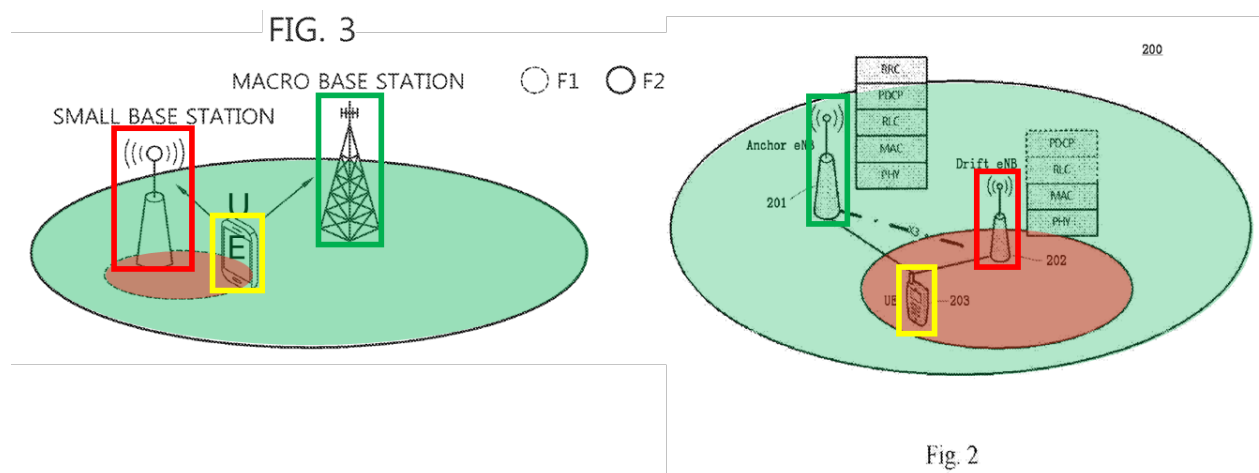


FIG. B: Side-by-side Comparison of Annotated FIG. 3 of the '283 Patent and Annotated FIG. 2 of Lin

As illustrated in FIGs. A and B above, both references clearly disclose a “wireless communication system supporting dual connectivity” that substantially mirrors the system recited in independent claims 1, 6, and 9.

Specifically, in FIG. A, Dudda discloses dual connectivity of a UE 302 (highlighted in yellow box, “user equipment”) to an anchor node 304a (in green box, “master base station”) and a booster node 304b (in red box, “secondary base station”); UE 302 is simultaneously connected to a macro cell/PCELL (in green,

“*primary serving cell*”) provided by anchor node 304a, and a small cell/SCELL (in red, “*secondary serving cell*”) provided by booster node 304b.¹ See Pet. 8-10.

Likewise, in FIG. B, Lin discloses a UE 203 (in yellow box, “*user equipment*”) with dual connectivity, connected to both an anchor eNB 201 (in green box, “*master base station*”) and a drift eNB 202 (in red box, “*secondary base station*”) in a wireless communication system 200; UE 203 is simultaneously connected to a PCELL (in green, “*primary serving cell*”) provided by anchor eNB 201, and an SCCELL (in red, “*secondary serving cell*”) provided by drift eNB 202. See Pet. 48-49.

Furthermore, independent claims 1, 6, and 9 effectively claim performing the following method:

- 1) Detecting a radio link failure (RLF) (limitation [1.a]);
- 2) Generating an RLF indicator, which contains a cell identifier ([1.a]);
- 3) Transmitting the RLF indicator to a master base station through radio resource control (RRC) ([1.b]-[1.c]); and
- 4) Stopping transmission of signals to the secondary serving cell ([1.d]).

As shown in FIG. C (annotated FIG. 8 of Dudda) below, Dudda expressly teaches the following:

¹ “PCELL” (or “PCell”) and “SCCELL” (or “SCell”) are abbreviations for “primary cell” and “secondary cell,” respectively, as commonly understood in the art. These terms are used consistently by Patent Owner in the DD Request and by Petitioner in both the Petition and this Opposition.

- 1) “RLF between the UE 802 and the assisting eNodeB 808 occurs in a step 8[9]4” (highlighted in green box, [1.a]);
- 2) Generating a “(7) RLF warning message” (in purple box, [1.a]);
- 3) The UE 802 and source eNodeB 804 are in an RRC diversity state (in blue box) and “trigger[s] the transmission of the (7) RLF warning message ... towards the source eNB 804” (in purple box, [1.b]-[1.c]); and
- 4) “RLF between the UE 802 and the assisting eNodeB 808 occurs, UE 802 stops transmitting to the assisting eNodeB 808” on the assisting cell (in red box, [1.d]).

See Pet. 11-21 (citing EX1003 — FIG. P with additional annotations).

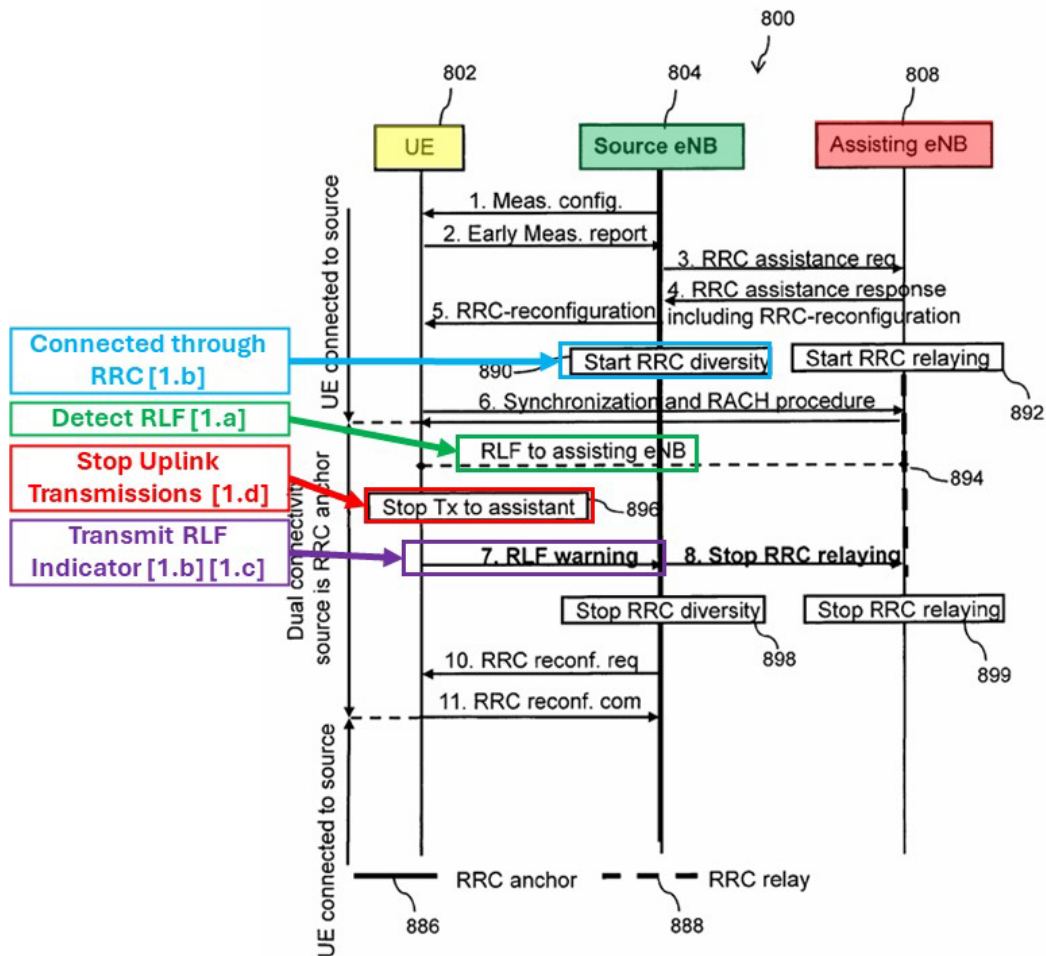


FIG. C: Annotated FIG. 8 of Dudda (EX1003 — FIG. P)

Similarly, as summarized in TABLE I below, Lin discloses an embodiment having sub-sections devoted to each step in the method (*see* Pet. 49):

| <u>Limitation</u> | <u>Lin Sub-Section</u> |
|--|---|
| Detecting a radio link failure (RLF) ([1.a]) | “UE RLM on multiple cells: Configurable RLM/RLF,” EX1006, [0032]-[0050]; “Report of RLF message,” EX1006, [0051]-[0056]. <i>See</i> Pet. 52-53. |
| Generating an RLF indicator which contains a cell identifier ([1.a]) | “Report of RLF message,” EX1006, [0051]-[0056]; “RLF content,” EX1006, [0057]-[0062]. <i>See</i> Pet. 52-53, 56. |
| Transmitting the RLF indicator to a master base station through radio resource control (RRC) ([1.b]-[1.c]) | “Report of RLF message,” EX1006, [0051]-[0056]. <i>See</i> Pet. 54-56. |
| Stopping transmission of signals to the secondary serving cell ([1.d]). | “Reaction to the RLF,” EX1006, [0063]-[0085]. <i>See</i> Pet. 56-61. |

TABLE I

2. Discretionary denial is not warranted because a material error was committed by the Office during patent examination

Discretionary denial is also inappropriate because the Petition establishes that the Office committed a material error during examination of the '283 Patent. As a result, it would be appropriate for the Office to use its resources to review that material error. *See Microsoft Corporation v. Partec Cluster Competence Center GMBH*, IPR2025-00318, Paper 9 at 3 (Director June 12, 2025) (“*Microsoft*”) (finding that “discretionary denial of institution is not warranted because of

Petitioner’s showing of material error during patent examination” and that “it is an appropriate use of Office resources to review the potential error”); *Eunsung Global Corp. v. HydraFacial LLC*, IPR2025-00445, Paper 14 at 3 (Director July 10, 2025) (finding that “discretionary denial is not appropriate” because “Petitioner persuasively demonstrates that the patent examiner overlooked certain teachings in Karasiuk that appear to disclose the allowable features of the claims”); *Anthony Inc. v. Controltec LLC*, IPR2025-00559, Paper 9 at 2 (Director July 16, 2025) (finding that “[a]lthough the challenged patents have been in force for approximately eighteen and seventeen years, Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error”).

As Patent Owner acknowledges, the allowability of the ’283 Patent hinged on the argument that the prior art reference fails to disclose or suggest any PUCCH to the SCELL, and thus cannot stop such non-existing uplink transmissions” and therefore does not disclose the PUCCH Limitation: “*stop[ping] uplink transmission of the ... physical uplink control channel (PUCCH) ... to the secondary serving cell.*” Patent Owner’s Request for Discretionary Denial (“DD Req.”), 11 (citing EX1002, 89). In other words, the allowed claims were premised solely on the supposed absence of the PUCCH Limitation in the prior art.

As demonstrated in the Petition and further discussed below in detail, both Dudda and Lin disclose the PUCCH Limitation. *See* Pet. 18-21, 56-61. Accordingly,

the examiner overlooked relevant prior art by not having considered Dudda and Lin’s teachings, demonstrating that the Office erred in a manner material to the patentability of the claims. *See Ecto World LLC v. Rai Strategic Holdings Inc.*, IPR2024-01280, Paper 13 at 5 (PTAB May 19, 2025) (precedential). The Director has previously denied requests for discretionary denial in similar circumstances, and should do so again here. *See, e.g., Microsoft*, IPR2025-00318, Paper 9 at 2-3 (denying request for discretionary denial where because the examiner overlooked pertinent prior art references that were not previously before the examiner); *Anthony Inc.*, IPR2025-00559, Paper 9 at 2 (same); *Tesla, Inc. v. Charge Fusion Technologies, LLC*, IPR2025-00152, Paper 11 at 2-3 (Director June 12, 2025) (finding Office erred by overlooking prior art teachings that disclosed the purportedly allowable feature); *Microsoft Corporation v. XI Discovery, Inc.*, IPR2025-00253, Paper 13 at 2 (Director June 25, 2025) (same).

a. Dudda discloses the PUCCH Limitation

Dudda discloses the PUCCH Limitation for two independent reasons, either of which alone satisfies the limitation.²

First, Dudda discloses that both the PCELL and the SCELL are used for “data

² Patent Owner argues that Petitioner “implicitly acknowledges that Dudda fails to disclose any PUCCH to the SCELL.” DD Req. 11. Petitioner has done no such thing and, as further explained herein, provided various reasons in its Petition for why Dudda discloses the PUCCH Limitation.

transmission,” which includes transmission of both signaling data and payload data in the uplink direction. Pet. 19-21 (citing EX1004, 9:54-58, 11:53-66, 28:35-51; EX1005, 25:28-26:10, 28:1-18). Patent Owner does *not* dispute that Dudda discloses uplink transmission of signaling data to the SCELL—instead, Patent Owner’s sole objection is an attorney’s assertion that Dudda’s disclosure of signaling data “is not a disclosure of any PUCCH to the SCELL.” DD Req. 12. However, it is well established in the art that the “signaling data” (*i.e.*, control data/information) is transmitted on PUCCH and PUSCH in uplink transmission. Pet. 20 (citing EX1007, [0040]; EX1009, 40; EX1011, 123-124; EX1003, ¶110).

As the Federal Circuit has explained, the test for anticipation “is not an *ipsissimis verbis* test,” and identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) (citations omitted). Here, corroborated extrinsic evidence—including other patents (EX1007, [0040]), industry standards (EX1009, 40), and technical textbooks (EX1011, 123-124)—along with the testimony of Petitioner’s expert, Dr. Robert Akl (who has over three decades of experience in wireless telecommunications), confirms that Dudda’s disclosure of uplink signaling data necessarily encompasses data transmitted via PUCCH. *See* EX1003, ¶110.

Patent Owner also attempts to improperly limit Dudda by mischaracterizing the LTE standard and reading those alleged restrictions into Dudda. Specifically, Patent Owner argues that because Dudda teaches applicability to LTE, and because

“in LTE, ‘the PCell is used for transmission of PUCCH,’” Dudda cannot disclose PUCCH transmission via the SCELL. DD Req. 12 (citing EX1009 at § 7.8, p. 58). But Dudda is *not* a mere recitation of then-existing LTE standards—its purpose as a patent document is to improve upon the prior art, including the LTE standard itself. *See, e.g.*, EX1004, 7:35-39 (“[i]t is an object of the present invention to provide” ways of handling RLF “in an *improved* way”). In fact, as a matter of logic, the LTE standard’s specification that PUCCH is transmitted via the PCELL does not preclude transmission of PUCCH via the SCELL—nothing in the standard prohibits it.

Second, Dudda discloses that the SCELL may function as a relay node for the PCELL by duplicating transmissions—specifically, “information sent between the first access node and the terminal may be duplicatedly sent between the first access node and the terminal via the second access node.” EX1004, 28:44-46; EX1005, 26:3-5; *see also* Pet. 19-20 (citing EX1004, 29:39-59; EX1005, 28:1-18). Accordingly, transmissions intended for the PCELL—including PUCCH—must also be duplicated and sent to the SCELL when acting as a relay.

Indeed, Patent Owner concedes that “Dudda teaches that the SCELL can be a relay node” and that “the ‘PCELL is used for transmission of PUCCH.’” DD Req. 12 (citing EX1009 at § 7.8, p. 58). Patent Owner’s only response is an attorney’s argument that Dudda does not expressly state that the duplicated signaling data includes PUCCH. *Id.* However, this argument is both technically incorrect, as

discussed above for the first reason, and fundamentally misses the point. Petitioner’s position is straightforward: if the PCELL transmits PUCCH and the SCELL operates as a relay node by duplicating PCELL transmissions, then, by necessity, PUCCH transmissions must also be duplicated and occur at the SCELL. Dudda’s express disclosure of duplication therefore also necessarily encompasses PUCCH transmission to the SCELL.

b. Lin discloses the PUCCH Limitation

Lin also discloses the PUCCH Limitation for the following two independent reasons.

First, Lin teaches that “CQI, PMI, RI, and so on ... may be directly **reported to the drift eNB.**” Pet. 56-57 (citing EX1006, [0025]). Patent Owner concedes that “CQI/PMI/RI are well-known uplink control information transmitted on PUCCH.” DD Req. 17; *see also*, Pet. 7, n. 2 (citing EX1007, [0040]; EX1009, 40; EX1003, ¶66). Lin therefore discloses the PUCCH Limitation. *See also*, Pet. 57 (citing EX1006, [0034], [0081]; EX1007, [0040]). Patent Owner does *not* address this cited paragraph [0025] of Lin in its DD Req.

Second, Patent Owner’s argument that PUCCH transmissions are confined to the PCELL is flawed. Patent Owner contends that “where PUCCH is specified in Lin, it is with regards to the PCELL.” DD Req. 15. As support, Patent Owner cites various paragraphs in Lin that reference “the serving cell” alongside PUCCH. *Id.*

(citing EX1006, [0010], [0034]).

However, the term “serving cell” in Lin refers to serving cells in general, including both the PCELL and SCELL. *See, e.g.*, EX1006, [0004] (“**SCELLs** can be configured to form together with the PCELL as a set of **serving cells**”). Lin also expressly identifies SCELLs provided by the drift eNB as “serving cells.” *Id.* [0007] (“UE **serving cell(s)** can be controlled by an eNB that is different to the eNB housing the UE anchor. This is a **drift eNB** of the UE”); [0026] (“RLM/RLF should be done in at least one of the **serving cells** in the **drift eNB**”); *see also*, Pet. 53 (explaining SCELL being provided by drift eNB).

Furthermore, the fact that Lin’s disclosures relating to PUCCH refer to the more general term “serving cell” instead of using the specific term “primary serving cell (PCELL)” indicates that these disclosures can apply to either the PCELL or the SCELL. *Compare* EX1006, [0004] (delineating differences between the phrases “primary serving cell (PCELL)” and “secondary serving cells (SCELLs)”) *with* [0010], [0034] (specifying PUCCH with respect to the generic term “serving cell”).

Accordingly, Lin’s references to PUCCH transmissions via a “serving cell” not only fail to exclude the SCELL, but, in fact, disclose that PUCCH transmissions occur on the SCELL. *See* Pet. 56-57 (citing EX1006, [0034]).

B. The PTAB Is Better Suited to Review a Large Number of Patents Involving Diverse and Complex Subject Matter

The '283 Patent is asserted in *Pantech Corp. et al. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, No. 5:24-cv-00038-RWS-JBB (E.D. Tex.) (“*Pantech II*”), and discretionary denial is inappropriate here given the large number of asserted patents and the diverse, complex subject matter involved. In *Pantech II*, Patent Owner asserts eight patents from eight different families, each relating to a different aspect of sophisticated 4G/5G wireless communication technologies. See EX1021, 4-6, 13, 16, 19-20, 23, 26, 29, 32, 35. It is unreasonable to expect a jury to fully adjudicate eight patents, each hailing from a different patent family, in a single trial.

In prior litigation between the same parties before the same judge stemming from the same monetization campaign by Patent Owner—*Pantech Corp. et al. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, No. 5:22-cv-00069-RWS (E.D. Tex.) (“*Pantech I*”), Patent Owner similarly asserted eight patents from eight different families, four of which also involved the 4G/5G communication technologies. See EX1022, 4-6, 12-13, 15-16, 24-26, 35-36. In *Pantech I*, despite requests from both sides for a longer trial, Judge Schroeder limited the trial to five days. See EX1023, 18-19. As a result, each side was allotted just 11 hours for all direct, cross, and rebuttal examinations. Indeed, due to these time constraints and the complexity of the issues, the invalidity of the asserted communications patents was not addressed during the

trial. EX1031, 5 (seeking verdict regarding invalidity of only two non-communications patents).

Other experienced district court judges have similarly recognized the difficulty of presenting multiple patents to a jury in a limited trial setting. *See, e.g.*, EX1024, 1 (Judge Albright stating that he does not think “it’s fair to have a jury trying to handle more than two or three patents at a time”); EX1025, 2 (letter brief quoting Judge Andrews stating in a scheduling conference that a five-day trial should be appropriate for only a two-patent case). Accordingly, there will be significant practical difficulties in fully litigating the validity of the patents, including the ’283 Patent, in the *Pantech II* case.

In such cases as this one, the Director has refused to discretionarily deny the petitions because “the Board is better suited to review a large number of patents involving diverse subject matter.” *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2-3 (Director June 13, 2025) (“*Tesla*”). For example, in *Tesla*, the Director denied the Patent Owner’s discretionary denial request even though the scheduled trial date preceded the projected Final Written Decision (FWD) date and despite meaningful investment in the parallel litigation. *Id.* at 2. The Director found that “Petitioner’s arguments regarding the complex and diverse litigation proceeding tip the balance against discretionary denial” because “[t]he large number and vast scope of the patents asserted in the district court litigation ...

weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter.” *Id.* at 2-3; *see also Tesla, Inc. v. The United States of America as Represented by the Secretary of the Navy*, IPR2025-00341, Paper 12 at 2-3 (Director June 13, 2025).

That same rationale applies here. In addition to this Petition, Petitioner has filed seven other IPR petitions against all eight patents asserted in *Pantech II*. *See also*, IPR2025-00720, -00756, -00762, -00763, -00783, -00887, -00888. It is impractical to expect a jury to, over the course of a trial of limited duration, fully adjudicate (i) the validity of eight patents from eight different families—each involving distinct aspects of complex 4G/5G wireless communication technologies, (ii) infringement issues of those same, eight patents, (iii) damages, (iv) issues related to fair, reasonable, and non-discriminatory (“FRAND”) obligations, and (v) any counterclaims. It is far more practical and efficient for the PTAB, with its technical expertise and patent experience, to resolve the 35 U.S.C. §§ 102 and 103 issues through IPR proceedings.³

Moreover, *Pantech II* involves only claims 1-4 of the ’283 Patent, whereas the instant Petition challenges all 13 claims. EX1026, 2-3, 12; Pet. 3. Thus, even if

³ Indeed, institution would resolve all prior art based disputes between the Parties. Petitioner has stipulated that if this IPR is instituted, Petitioner will *not* pursue *any* invalidity grounds under 35 U.S.C. §§ 102, 103. EX1020.

invalidity issues concerning the asserted claims 1-4 of the '283 Patent could be addressed within the trial in *Pantech II*, the trial would not resolve the validity of the remaining nine claims (claims 5–13), which likewise raise strong unpatentability concerns and material examination errors warranting review, as discussed in Section II.A above.

Furthermore, there is no risk of duplicative work here. Petitioner has provided a broad, unequivocal stipulation that it will not pursue “*any* invalidity grounds under 35 U.S.C. §§ 102 and 103 against the '283 Patent” if this IPR is instituted. EX1020. This stipulation is both broader and more straightforward than the *Sotera-plus* stipulation recently found by the Director to weigh against discretionary denial in *Tesla. Tesla*, IPR2025-00217, Paper 9 at 2; *see also id.*, EX1067 (*Sotera-plus* stipulation). Petitioner has firmly committed that, if the Board institutes review, it will not only withdraw any §§ 102 and 103 grounds it raised or could have raised in the IPR, but will also ***withdraw all §102 and §103 challenges entirely*** in *Pantech II*—ensuring this IPR serves as a true alternative to district court litigation. *See Motorola Solutions Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB March 28, 2025). This stipulation fully eliminates any concern of duplication between this proceeding and *Pantech II*.

Accordingly, institution is a practical, efficient, and non-duplicative alternative to the district court litigation—Patent Owner’s request should be refused

on this basis alone. *See Tesla*, IPR2025-00217, Paper 9 at 2-3.

C. There Are Compelling Economic Interests in Preventing a Non-Practicing Entity from Using Defective Patent Claims Against Manufacturers

There are compelling economic and public policy interests favoring institution of this IPR. Patent Owner is a non-practicing entity (NPE) engaged in an ongoing campaign to monetize a portfolio of weak patents that it did not invent. Its strategy typically begins with demands for excessive royalties, followed by serial litigation when those demands are not met. This conduct has already contributed to the withdrawal of multiple cell phone manufacturers from the U.S. market. Despite repeated and meritorious challenges to its portfolio, Patent Owner's litigation campaign persists unchecked. Under these circumstances, institution of this IPR is not only appropriate—it is necessary to protect manufacturers, promote judicial efficiency, and preserve the integrity of the patent system.

Patent Owner is a known NPE.⁴ According to the USPTO Assignment Database, Patent Owner acquired the patent rights to the '283 Patent, along with more than 200 other U.S. patents, through an “Intellectual Property Sale and Purchase Agreement” in 2020. *See* EX1027, 1, 8.

⁴ *See, e.g.*, <https://portal.unifiedpatents.com/ptab/case/IPR2025-00637> (identifying Patent Owner as “NPE (Patent Assertion Entity)”); <https://ai-lab.exparte.com/case/ptab/IPR2025-00637/oneplus-technology-shenzhen-co-ltd-et-al-v-pantech-corporation> (identifying Patent Owner as “NPE”).

As explained below, during its ongoing monetization campaign against numerous manufacturers, including Petitioner, Patent Owner has demanded unreasonable royalty rates that violate its FRAND obligations for its patent portfolio. *See infra*, Section IV. Since 2021, Patent Owner has filed a slew of patent infringement lawsuits against a range of manufacturers, including LG Electronics Inc., Asustek Computer Inc., BLU Products Inc., GNJ Manufacturing Inc., CoolPad Ground Limited, Lenovo Ground Ltd., HMD Global OY, TLC Industrie Holdings Co., Ltd., Shenzhen Tinno Mobile Technology Corp., and Petitioner. These lawsuits further illustrate Patent Owner's business model of asserting patents against manufacturers to extract royalties.

Patent Owner's aggressive monetization campaign has real and harmful economic consequences. Patent Owner's repeated demands for non-FRAND royalty rates have placed a significant burden on manufacturers, even contributing to the withdrawal of companies from the U.S. cellphone market, such as GNJ Manufacturing Inc. and CoolPad Group Limited. This underscores the strong economic interest in preventing Patent Owner from using defective patent claims to extract unjustified royalties from manufacturers.

Alarminglly, the patents asserted in this campaign are not good patents. Although Patent Owner undoubtedly attempted to pick its best patents from a field of over 200 U.S. patents to assert in litigation, the Patent Office has consistently

found serious patentability issues with those patents. For example, *all* seven patents asserted by Patent Owner from this same portfolio in its district court litigation against LG Electronics Inc. were found likely unpatentable in the institution decisions across seven IPR proceedings filed by LG Electronics Inc. *See Pantech Corp. et al. v. LG Elecs. Inc et al.*, 5:22-cv-00113-RWS, (E.D. Tex) (the “LG case”); IPR2023-01267, -01268, -01269, -01270, -01271, -01272, -01273. Petitioner has also filed five *Ex Parte* Reexamination (“EPR”) requests against five other patents in Patent Owner’s patent portfolio, *all* of which were ordered based on findings of substantial new question of patentability. *See* 90/019,553, 90/019,559, 90/019,641, 90/019,704, 90/019,726. Four of those patents were asserted in *Pantech I* (with the fifth being a related family member), yet their invalidity was not adjudicated at trial due to the compressed schedule and complex and diverse subject matter.

The fact that nearly all of the carefully selected, first-tier patents asserted by Patent Owner in its initial wave of litigation against LG Electronics Inc. and Petitioner were found to have defective claims strongly suggests that the eight patents from the same portfolio asserted in its second wave of litigation (*Pantech II*)—including the ’283 Patent—are even more vulnerable to unpatentability challenges in the eight pending IPRs filed by Petitioner.

Finally, Patent Owner’s weaponization of these questionable patents against cell phone manufacturers appears unending. On July 3, 2025, Patent Owner initiated

a third wave of district court litigation against five cell phone manufacturers, including Petitioner, in the same district court—*Pantech Corp. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, No. 5:25-cv-00089 (E.D. Tex.) (*Pantech III*)⁵—asserting four patents, two of which are continuations of a patent involved in *Pantech II*.⁶ On the same day, Patent Owner also filed a Section 337 investigation complaint with the U.S. International Trade Commission (“ITC”), asserting the same four patents from *Pantech III* against Petitioner and several other respondents, all of whom are cell phone manufacturers in the U.S. market. *See In the Matter of Certain Mobile Cellular Communications Devices*, Inv. No. 337-TA-3835 (ITC).

The PTAB plays a vital role in addressing such defective patents. In the *LG* case, the Board’s institution of IPRs on all seven asserted patents led to a prompt settlement between the parties, eliminating the need for a district court trial.⁷ This outcome further demonstrates that the PTAB is a more efficient forum for resolving

⁵ The other four district court cases are *Pantech Corp. v. Shenzhen Inno Mobile Tech. Corp.*, No. 5:25-cv-00090 (E.D. Tex.); *Pantech Corp. v. TCL Indus. Holdings Co., Ltd.*, No. 5:25-cv-00091 (E.D. Tex.); *Pantech Corp. v. HMD Global Oy*, No. 5:25-cv-00092 (E.D. Tex.); and *Pantech Corp. v. Lenovo Group Ltd.*, No. 5:25-cv-00093 (E.D. Tex.)

⁶ U.S. Patent Nos. 11,051,344 and 12,267,876 asserted in *Pantech III* are continuations of U.S. Patent No. 9,288,824, which is currently asserted in *Pantech II* and challenged in IPR2025-00783. EX1028, 4-5.

⁷ IPR was instituted in March and April 2024; the parties jointly moved to dismiss the case in view of settlement agreement shortly afterwards, on August 13, 2024. *See* IPR2023-01267 to -01273; *Pantech Corporation v. LG Electronics Inc.*, 5:22-cv-00113-RWS, (E.D. Tex), Dkt. No. 376 (Joint motion to dismiss).

such disputes. In contrast, Patent Owner’s recent filing of *Pantech III* and ITC complaint is a strong indication that it does *not* expect to resolve its disputes with Petitioner in *Pantech II*. Therefore, reviewing the IPRs by the PTAB for the patents asserted in *Pantech II*—including the ’283 Patent at issue here—is, as in the *LG* case, an efficient engine to drive the settlement of disputes between Patent Owner and Petitioner here, thereby making institution an appropriate and efficient use of the Office’s resources.

Given Patent Owner’s track record of asserting weak patents to demand excessive royalties, institution of this IPR is not only warranted but necessary to protect manufacturers, promote judicial efficiency, and uphold the integrity of the patent system.

D. Patent Owner Has Not Established Settled Expectations

Patent Owner has not established settled expectations regarding the ’283 Patent. Patent Owner only acquired the patent rights through an “Intellectual Property Sale and Purchase Agreement” in 2020 (*see* EX1027, 1, 8) and did not begin monetizing the patent until July 2021. DD Req. 18 (citing EX2003).

Although the ’283 Patent issued in 2017, Patent Owner had no basis for any settled expectation prior to its acquisition. As the Director has previously explained, even though “[a] patent may have been in force for years,” the fact that a patent has not been “commercialized, asserted, marked, licensed, or otherwise applied in a

petitioner’s particular technology space, if at all” will “weigh against a patent owner’s claim of settled expectations and bear[] on the Director’s discretion.” *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2-3 (Director June 26, 2025).

Such is the case here. Indeed, Patent Owner concedes that its asserted “settled expectation” regarding the ’283 Patent spans only “almost three years,” measured from its first monetization effort against Petitioner in July 2021. DD Req. 18. That limited timeframe is unsurprising. Prior to 2020, Patent Owner had no rights to commercialize, assert, mark, license, or otherwise apply the ’283 Patent. *See Intel*, IPR2025-00327, Paper 12 at 2–3. Moreover, there is no evidence that Patent Owner “commercialized, asserted, marked, licensed, or otherwise applied” the ’283 Patent in Petitioner’s technology space between its 2020 acquisition and its first assertion in July 2021. *Id.* Patent Owner’s own admission of having “*almost three years*” of settled expectation falls squarely within the Director’s guidance in *Intel*, which explains that a lack of commercialization, assertion, or any other application of the patent in a petitioner’s technology area weighs against finding strong settled expectations. *Id.*

Unlike innovators who develop and own patents through their own research and development, Patent Owner—an NPE—acquired the patent portfolio solely for monetization. Any expectation that its patents would remain unchallenged could not reasonably begin before its enforcement campaign. This is especially true here,

where (i) numerous Office proceedings have already raised serious patentability questions about its portfolio (*see* Section II.C), and (ii) Petitioner has consistently contested the validity of the patent portfolio since receiving Patent Owner’s initial licensing demand, including asserting numerous invalidity defenses in district court and EPRs since the filing of *Pantech I*. Under these circumstances, Patent Owner cannot credibly claim that it had settled expectations that its patents were valid and enforceable.

Patent Owner’s suggestion that Petitioner should have filed IPRs earlier after receiving its 2021 licensing demand is misplaced. DD Req. 18. Given Patent Owner’s demand for a portfolio-wide license covering hundreds of patents, it would have been inefficient and impractical for Petitioner to preemptively challenge each of the over 200 U.S. patents in Patent Owner’s portfolio. *See generally* EX2003, 6-13 (providing an “Exemplary List of Pantech Wireless Patents” containing 224 patents). Moreover, Patent Owner deliberately chose not to assert the ’283 Patent in *Pantech I* filed in 2022. Until Patent Owner filed *Pantech II* in 2024—including the ’283 Patent—Petitioner had no reason to believe the ’283 Patent would be asserted over the hundreds of other patents in Patent Owner’s recently acquired portfolio. The timing of this IPR is thus directly attributable to Patent Owner’s dilatory and piecemeal litigation strategy.

In sum, under the Director’s guidance in *Intel* and based on Patent Owner’s

own admission, any settled expectations regarding the '283 Patent can only be measured from July 2021—when Patent Owner first began its monetization efforts. From that point, Patent Owner has not developed settled expectations that would support discretionary denial here. *See Cambridge Industries USA Inc., v. Applied Optoelectronics, Inc.* IPR2025-00434 Paper 11 at 2-3 (Director June 26, 2025) (finding Patent Owner has not developed strong settled expectations that favor discretionary denial for patents issued in 2020 and 2019); *Berkshire Hathaway Energy Company et al. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 3 (Director July 2, 2025) (same).

Even if the Director were to measure Patent Owner's settled expectations from the issuance of the '283 Patent in 2017 (which Petitioner does not concede, for reasons discussed above), discretionary denial remains unwarranted given the strong merits of the IPR challenges here—specifically, (i) the material error made by the Office during examination (*see* Section II.A.2), and (ii) the high vulnerability of the challenged claims (*see* Section II.A.1)—in line with recent Director decisions. *See, e.g., Eunsung*, IPR2025-00445, Paper 14 at 2-3 (finding discretionary denial unwarranted despite the patent having issued in 2017 because the examiner overlooked prior art that appeared to disclose the allowable features of the claims); *Anthony Inc.*, IPR2025-00559, Paper 9 at 2 (finding discretionary denial unwarranted despite the patent having being in force for about 17 and 18 years

because the examiner overlooked prior art of a new reference); *POSCO Co., Ltd. v. ArcelorMittal*, IPR2025-00370, Paper 10 at 2-3 (Director June 25, 2025) (finding “Petitioner’s arguments regarding settled expectations—namely that Patent Owner’s claims were ‘highly vulnerable to invalidation based on prior art’—tip the balance against discretionary denial”).

Here, as in *Eunsung*, the allegedly distinguishing feature—the PUCCH Limitation—is disclosed in prior art, even in two separate references: Dudda and Lin. *See* Section II.A.2. The examiner’s failure to consider these references constitutes a material error that directly affects the patentability of the claims. Accordingly, even if Patent Owner’s settled expectations were deemed to begin in 2017—as in *Eunsung*—the rationale in *Eunsung* applies equally here, and discretionary denial remains inappropriate. IPR2025-00445, Paper 14 at 2-3.

Also, as in *Anthony Inc.*, the examiner erred by overlooking the teachings of newly cited references—Dudda, Lin, and Pelletier—which directly impact the patentability of the claims. *See* Sections II.A (discussing Dudda and Lin); *see also infra*, Section III.A (discussing Pelletier). Thus, even considering the ’283 Patent being in force for less than eight years, which is significantly shorter than the 17 and 18 years at issue in *Anthony Inc.*, the rationale in *Anthony Inc.* applies equally here, and discretionary denial remains inappropriate. IPR2025-00559, Paper 9 at 2.

In sum, whether Patent Owner’s expectations regarding the ’283 Patent are

measured from 2021 or as early as 2017, those expectations are not “settled” and do not justify discretionary denial. As detailed in Sections II.A, II.B, and II.C above and Section III below, Petitioner has provided detailed, compelling reasons why institution of this IPR is an appropriate and efficient use of Board resources. *See Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025). This conclusion is fully aligned with the Director’s reasoning in numerous recent, analogous decisions, such as *Microsoft*, *Eunsung*, *Anthony Inc.*, *Tesla*, and *Intel*. Accordingly, discretionary denial is not warranted.

E. Patent Owner’s Other *Fintiv* Arguments Are Unavailing

1. Factor 4: Petitioner’s stipulation to withdraw all §§ 102 and 103 challenges weighs strongly against discretionary denial

Patent Owner mischaracterizes Petitioner’s second stipulation (EX1020) as merely “a *Sotera* stipulation.” DD Req. 8. As explained in Section II.B above, Petitioner’s stipulation is both broader and more straightforward than the *Sotera-plus* stipulation. *See Tesla*, IPR2025-00217, Paper 9 at 2; *see also id.*, EX1067 (*Sotera-plus* stipulation). Contrary to Patent Owner’s misleading claim that the “district court will still address validity under 35 U.S.C. §§ 102 and 103” (DD Req. 9), Petitioner has unequivocally committed to ***withdraw all §102 and §103 invalidity defenses entirely*** if this IPR is instituted. EX1020. Given Petitioner’s broad, categorical stipulation covering all §§ 102 and 103 invalidity grounds, this factor

strongly weighs against discretionary denial.

Patent Owner's arguments regarding adding Guangdong OPPO Mobile Telecommunications Corp., Ltd. ("OPPO") as a party in *Pantech II* are completely baseless and purely speculative. DD Req. 9. Petitioner does not seek to add OPPO as a party. Indeed, no pleading in *Pantech II* seeks to add OPPO, and Patent Owner provides no evidence to the contrary. Tellingly, Patent Owner also did *not* name OPPO as a party in its recently filed *Pantech III* and ITC complaint.

2. Factor 6: The strong merits of the Petition weigh against discretionary denial

As explained above in Section II.A, the strong merits of the Petition weigh heavily against discretionary denial. In analyzing this factor, Patent Owner does not dispute the strength of the merits. DD Req. 10.

Instead, Patent Owner asserts that "[t]he district court is fully capable of resolving all issues, and there is no compelling public interest that would justify institution in this case." *Id.* However, as discussed above, it is unrealistic to fully litigate the invalidity issues in *Pantech II* given the complexity and number of asserted patents, and there is a compelling economic interest in reviewing defective patent claims asserted by an NPE against manufacturers. *See* Sections II.B, II.C.

3. Factor 1: Petitioner intends to request a stay, which is very likely to be granted

Because no stay has been requested in view of the filing of this Petition or

granted currently, this factor is neutral. The district court's practice of denying any motion to stay *prior to* the petition for IPR being granted renders this factor neutral. DD Req. 4 (noting court's practice of denying pre-institution requests for stay). However, Petitioner intends to seek a stay after institution is granted, and the district court has previously granted stays in similar circumstances. *See, e.g., Papst Licensing GMBH & Co. v. Apple, Inc.*, 2017 U.S. Dist. LEXIS 223280, *1-16 (E.D. Tex. June 16, 2017); *Resonant Sys., Inc. v. Samsung Elecs. Co., Ltd.*, 2024 U.S. Dist. LEXIS 41002 (E.D. Tex. March 8, 2024).

Moreover, Petitioner also intends to seek a stay of *Pantech II* based on Patent Owner's recent filing of the ITC complaint and *Pantech III*. Given the overlap of issues and the presence of two patents from the same family as those asserted in *Pantech II* (compare generally EX1028 with EX1021), such a stay must be granted. *See, e.g.,* 28 U.S.C. § 1659(a) ("the district court *shall* stay, until the determination of the Commission becomes final, proceedings in the civil action with respect to any claim that involves the same issues involved in the proceeding before the Commission"); *Vicor Corp. v. FII USA Inc.*, 132 F.4th 1, 7 (1st Cir. 2025) (holding "the phrase 'the same issues' means what it says and applies whenever a district court proceeding shares issues with an ITC proceeding") (citation omitted).

Patent Owner's accusation that Petitioner engaged in "dilatory tactics" lacks merit and is premised on purely attorney argument. DD Req. 4–5. The parties

mutually agreed to stay *Pantech II* pending resolution of Patent Owner’s standing, which the court ultimately decided in Patent Owner’s favor in a “close” decision. *Pantech I*, 2024 LEXIS 242332, *9 (E.D. Tex. August 14, 2024). Petitioner’s disagreement about lifting the stay—given that the decision is pending on appeal—was reasonable and intended to conserve judicial resources. *See Pantech Corp. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, Appeal No. 2025-1628 (Fed. Cir. 2025). This also supports the likelihood of a stay in *Pantech II* after institution here.

4. Factor 5: The parties are not identical

Factor 5 is whether the petitioner and the defendant in the parallel proceeding are the same party. Here, the parties are not identical. OPPO is identified as a real party-in-interest (“RPI”) in this IPR, but is *not* a party to *Pantech II*.

5. Factor 3: Investment in the parallel litigation has been minimal, and Petitioner diligently filed the instant Petition

Because *Pantech II* was stayed for over three months soon after its inception, the investment has been minimal. By the anticipated date of an institution decision (by October 17, 2025), expert discovery will still be ongoing, and no dispositive motions will have been filed. *See* EX2001. Although fact discovery will have closed, that alone does not reflect significant investment—particularly where (i) fact discovery does not involve substantive rulings on the patents-in-suit, and (ii) Patent Owner’s discovery responses largely duplicate those from the earlier *Pantech I* case.

No depositions have been taken, and any *Markman* ruling would not impact the IPR, as the Petition does not turn on claim construction. *See* Pet. 8.

The Board has found that this factor favors institution even in cases that have advanced beyond the completion of *Markman* briefing and fact discovery. *See Samsung Display Co. v. Pictiva Displays Int’l Ltd.*, IPR2024-01222, Paper 12 at 7 (PTAB March 6, 2025) (finding this factor weighs against denial, even though a *Markman* hearing has been held, in part because “much remains to be done, including expert discovery”); *see also SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01432, Paper 14 at 8-9 (PTAB April 7, 2025) (this factor favored institution even though the *Markman* briefing was completed and *Markman* hearing was scheduled within a month of the institution decision).⁸

Further, Patent Owner’s claim that Petitioner “waited until the last minute” to file this IPR is meritless. DD Req. 6. Petitioner filed the instant Petition on March 18, 2025—more than two months before the statutory deadline⁹ and before receiving

⁸ Contemporaneous with its institution decision in this case, the Board filed EX3001 which showed that *Markman* briefing was completed almost a month prior to the institution decision. *SAP*, IPR2024-01432, EX3001, 8 (sur-reply claim construction brief filed on March 17, 2025).

⁹ Petitioner waived service and Patent Owner filed that waiver on May 20, 2024. Accordingly, the statutory bar date is May 20, 2025. *See Motorola Mobility LLC v. Patent of Michael Arnouse*, IPR2013-00010, Paper 20 at 6 (PTAB January 30, 2013) (informative) (“in the situation where the petitioner waives service of a summons, the one-year time period begins on the date on which such a waiver is filed”).

Patent Owner’s validity contentions. *See Snap Inc. v. SRK Tech.*, IPR2020-00820, Paper 15 at 12-13 (PTAB October 21, 2020) (precedential) (finding the petitioner’s conduct neutral because the petition “was not filed in close proximity to any response by Patent Owner to the invalidity contentions”). This timing was particularly reasonable given that *Pantech II* was stayed for months shortly after it began.

6. Factor 2: The FWD is likely to issue before or around the actual trial date in the district court litigation

The projected statutory deadline of FWD in this IPR falls in October 2026, and the trial date of *Pantech II* is currently set for late April 2026. EX2001. However, Judge Schroeder’s median time-to-trial of 30 months—which, accounting for the more than three-month stay, places the trial around December 2026. This shows that the FWD is likely to issue before or around the same time as the trial. EX1029, 2; *see also* EX1030, 3 (Patent Owner acknowledging that stay was desirable to promote judicial efficiency and that the stay would “not prejudice either Party”). The Director and Board have routinely considered median time-to-trial statistics of *the presiding judge* to more accurately predict actual trial timing. *See, e.g., Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-00250, Paper 14 at 2 (Director May 16, 2025) (using Judge Noreika’s time-to-trial statistics to predict actual trial timing instead of relying on the scheduled date); *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00321, Paper 10 at 10 (PTAB June 18, 2025) (finding *Fintiv* factor 2 neutral or

slightly against discretionary denial based on Judge Gilstrap’s time-to-trial statistics, despite an earlier scheduled trial date).

In addition, the very real possibility of a stay being entered in *Pantech II* in view of the newly filed ITC complaint and *Pantech III* further undermines the certainty of the current trial date in *Pantech II*. Post-trial proceedings in *Pantech II* could also substantially delay the final judgment. For example, in *Pantech I*, the final judgment was issued almost 10 months after the first trial. *Compare* EX1031 (first jury verdict dated April 1, 2024) *with* EX1032 (final judgement dated January 23, 2025).

Even if the Director considers the currently scheduled court trial date in Factor 2 analysis and determines that this date precedes the projected FWD date of this IPR, discretionary denial remains inappropriate. The PTAB is still better suited to review the Petition in this particular case because (i) the prosecution record shows clear material error by the Office regarding the patentability of the claims (*see* Section II.A.2), and (ii) the parallel district court litigation involves numerous patents covering diverse and complex technologies, making full adjudication impractical (*see* Section II.B)—both consistent with the Director’s several recent decisions. *See Microsoft*, IPR2025-00318, Paper 9 at 3 (finding that “it is an appropriate use of Office resources to review the potential error” despite earlier trial date where the petitioner showed material Office error); *Padagis US LLC v. Neurelis, Inc.*,

IPR2025-00464, Paper 12 at 3 (Director July 16, 2025) (same); *Tesla*, IPR2025-00217, Paper 9 at 2-3 (finding that “Petitioner’s arguments regarding the complex and diverse litigation proceeding tip the balance against discretionary denial” even with an earlier trial date, no likelihood of stay, and meaningful investment in the district case).

This case particularly parallels *Tesla*. There, the Director identified two key factors weighing against discretionary denial: a broad stipulation and strong merits. *Tesla*, IPR2025-00217, Paper 9 at 2. As discussed above, Petitioner’s stipulation here is at least as broad and even more straightforward than in *Tesla* (*see* Sections II.B, II.E.1), and the Petition similarly presents strong merits, including multiple grounds of anticipation and single-reference obviousness, and clear examiner error (*see* Section II.A). Moreover, as in *Tesla*, Petitioner has explained that *Pantech II* involves complex and diverse subject matter across eight patents, making it highly impractical for the district court to fully adjudicate validity—including that of the ’283 Patent—within the limited trial framework. *See* Section II.B. Such considerations were so strong that the Director found these considerations outweighed the fact that, in *Tesla*, “the scheduled trial date precedes the projected final written decision due date” and that “there has been meaningful investment in the parallel proceeding by the parties.” IPR2025-00217, Paper 9 at 2.

III. § 325(d) DISCRETION SHOULD NOT BE APPLIED

Under the two-part *Advanced Bionics* framework, the Board should not exercise discretion to deny institution under 35 U.S.C. § 325(d). *See* Pet. 72-73. Dudda, Lin, and Pelletier have never been presented or otherwise considered by the Office during the original examination of the '283 Patent. *See generally* EX1002. None of the grounds raised in this Petition have ever been presented, much less discussed, during the original examination.

A. Dudda, Lin, and Pelletier Are Not Cumulative to Art Previously Before the Patent Office

As an initial matter, Patent Owner's argument that Dudda, Lin, and Pelletier are cumulative to previously presented art is facially deficient. Patent Owner merely argues that, like Lin-548¹⁰, none of Dudda, Lin, and Pelletier discloses the PUCCH Limitation, but provides no meaningful comparison. DD Req. 10-16. This does not amount to the required detailed analysis comparing the disclosures of Dudda, Lin, and Pelletier with prior art cited during prosecution (*e.g.*, Lin-548) as to other claim limitations, and thus fails to show these references are cumulative. Patent Owner's argument thus fails for not identifying the "similarities and material differences between the asserted art and the prior art involved during examination." *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18

¹⁰ U.S. Patent Application Publication No. 2012/0281548 to Lin *et. al.* (EX1013)

(PTAB December 15, 2017) (precedential as to § III.C.5, first paragraph).

Moreover, Dudda, Lin, and Pelletier each disclose what Patent Owner alleged as missing during prosecution, making them non-cumulative. *See Embody, Inc. et al. v. LifeNet Health*, IPR2025-00248, Paper 13 at 2 (Director June 26, 2025) (finding that references are not cumulative of previously presented art where new references disclose previously missing limitations). As explained above in Section II.A.2, both Dudda and Lin disclose the PUCCH Limitation, which was allegedly missing during prosecution.

Pelletier also expressly discloses the PUCCH Limitation by teaching that “a WTRU configured with at least one SCell, upon activation/deactivation of a given subset, (*i.e.*, one or more), of SCell(s), may determine whether or not it may start/stop/release configured dedicated UL resources, *e.g.*, PUCCH for CQI/PMI/RI.” EX1007, [0106].

Patent Owner argues that Pelletier fails to disclose the PUCCH Limitation because Pelletier refers to “PUCCH transmissions about the SCELL but sent to the PCELL.” DD Req. 13 (emphasis in original). This argument relies solely on comparing paragraph [0042], which mentions PUCCH in the context of the PCELL, with paragraph [0043], which discusses the SCELL but does not mention PUCCH. *Id.* However, the fact that PUCCH transmissions may be sent to the PCELL does not preclude PUCCH transmissions involving the SCELL; nothing in paragraph

[0043] suggests it exhaustively lists all transmissions to the SCELL.

Further, Patent Owner's reliance on the LTE standard to limit Pelletier is similarly misplaced as discussed above with respect to Dudda (*see* Section II.A.2.a). DD Req. 13-14. Like Dudda, Pelletier aims to improve upon the LTE standard, not merely replicating it. *See* EX1007, [0003].

B. The Examiner Materially Erred with Respect to the Patentability of the Challenged Claims

To the extent that any of Dudda, Lin, and Pelletier is found to be cumulative art (which Petitioner does not concede), the examiner erred in a manner material to the patentability of the challenged claims by not finding and appreciating that Dudda, Lin, and Pelletier each disclose the PUCCH Limitation for the reasons stated above. *See* Sections II.A.2, III.A.

Therefore, discretionary denial under 35 U.S.C. § 325(d) is unwarranted.

IV. PATENT OWNER'S CONDUCT IN RELATED LITIGATION, NEGOTIATIONS, AND THIS PROCEEDING WEIGHS AGAINST DISCRETIONARY DENIAL

Patent Owner distorts and mischaracterizes the parties' prior litigation in *Pantech I*, notably without citing the actual record. A full review of that case shows that both the district court and the jury found Patent Owner engaged in improper conduct, violating its FRAND obligations. Patent Owner's pattern of litigation and licensing misconduct—along with its continued gamesmanship in this IPR—weighs

against discretionary denial and supports institution.

A. Patent Owner’s Allegations of “Bad Faith” Are Baseless and Ignore Its Own Misconduct

Patent Owner’s allegations of Petitioner’s “bad faith” are unfounded and overlook its own conduct. DD Req. 18-19.¹¹ Beginning in July 2021, Patent Owner demanded that Petitioner engage in negotiations for a license to a patent portfolio including over 1,400 patents. Patent Owner has never offered Petitioner a license to the ’283 Patent by itself. Petitioner neither needs nor wants a license for the entire portfolio.

Patent Owner’s portfolio includes numerous patents it claims are standards-essential patents (SEPs), which must be licensed on FRAND terms. *TCL Commc’n Tech. Holdings Ltd. v. Telefonaktiebolaget LM Ericsson*, 943 F.3d 1360, 1364 (Fed. Cir. 2019). Petitioner, for its part, responded to Patent Owner’s licensing demands by requesting details regarding Patent Owner’s infringement allegations and raising concern that Patent Owner’s offered rate was not FRAND. Rather than ignoring Patent Owner, Petitioner showed its commitment to complete the task of identifying the patents in Patent Owner’s portfolio, which were truly SEPs and would be licensed at a FRAND rate. But Patent Owner abandoned negotiations and chose to

¹¹ Patent Owner’s entire argument about Petitioner’s supposed bad faith and Patent Owner’s alleged license offers based on FRAND terms is based solely on attorney argument without any supporting documentation. DD Req. 18-19.

litigate on a small subset of patents.

In fact, the record in *Pantech I* confirms that Petitioner has consistently negotiated licenses in good faith. Petitioner has entered into licensing agreements with more than a dozen other companies—including NPEs like Patent Owner.

B. Patent Owner’s Litigation Misconduct Incited the Bias of the First Jury and Required a Second Trial

Patent Owner’s invocation of “the equities for the parties’ conduct” (DD Req. 19) and its self-serving contentions that it engaged in “good-faith efforts” (DD Req. 18) ignore its misconduct during *Pantech I*. Following the trial in that case, the district court found that the Patent Owner’s conduct before the jury was so prejudicial that a retrial on damages was required. *Pantech I*, 2024 LEXIS 242332, *37–44 (E.D. Tex. August 14, 2024) (finding, *inter alia*, that “[m]ost prejudicial are Pantech’s excessive questions about litigation in the United Kingdom and Germany and Pantech’s closing arguments that suggested to the jury that they should increase the damages to punish OnePlus for its holdout behavior” and that “Pantech also inappropriately leveraged this prejudicial evidence during its closing arguments to seek punitive damages.”). This same misconduct infected the jury’s findings as to infringement, willfulness, and invalidity—findings that are currently the subject of an appeal. *See Pantech Corp. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, Appeal No. 2025-1629 (Fed. Cir. 2025).

Patent Owner relies upon a finding of willful infringement by the first jury to paint Petitioner in a bad light. However, that verdict was clouded by bias and prejudice, and the district court declined to enhance damages. EX1032 at 2; EX1033 at 15 (“the infringement period was not long, and the accused products used on the off-the-shelf components and publicly available code, and Defendant’s pre- and post-trial behavior as to the SEPs was tied closely to its reasonable belief that Plaintiffs’ offer was not FRAND”).

C. The Jury Verdict Demonstrates Patent Owner’s Licensing Demands Constituted “Holdup”

Indeed, the unreasonableness of Patent Owners’ licensing demands is evident in view of the recent jury verdict in *Pantech I*, awarding Patent Owner only a fraction of that amount, which is less than what Patent Owner requested the jury to award. The second jury’s findings in *Pantech I* illustrate Patent Owner’s failure to comply with its own FRAND obligations, *i.e.*, its own holdup conduct, which weighs against its equity-focused argument for discretionary denial. *See Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 814 (1945) (“he who comes into equity must come with clean hands”) (internal citations and quotation marks omitted).

D. Patent Owner’s Conduct in this Proceeding Should Not Be Rewarded

Patent Owner has also repeatedly engaged in procedural gamesmanship throughout this IPR proceeding.

First, Patent Owner repeatedly delayed filing its Mandatory Notices in nearly all eight IPR proceedings against the patents asserted in *Pantech II*—ignoring the 21-day deadline set by 37 C.F.R. § 42.8(a)(2), despite multiple reminders from Petitioner. For example, in this proceeding, Patent Owner filed its Mandatory Notice 27 days after service of the Petition. Similar delays occurred in IPR2025-00783 (25 days), IPR2025-00887 (22 days), IPR2025-00888 (22 days), IPR2025-00720 (22 days), and IPR2025-00756 (22 days). In IPR2025-00763, Patent Owner has still failed to file its Mandatory Notice yet—more than two months after service of the petition on May 14, 2025.

Second, Patent Owner intentionally waited until the last minute to file its DD Request, which caused all accompanying exhibits to be filed after the two-month deadline set by the Director Memo. *See generally* EX3101. Although Patent Owner attempted to excuse the delay as a “miscommunication” and claimed it was “purely procedural,” it offered no explanation for why it waited until the final moments of the two-month period to file its 20-page brief. *Id.* 1. As the PTAB has cautioned, “[w]aiting until the last minute—without explanation—is ill advised and had Petitioner not done so, any alleged delays caused by ‘technical issues’ would have been moot.” *Teva Pharmaceuticals USA, Inc. v. Monosol RX, LLC*, IPR2016-00281, Paper 21 at 10 (PTAB May 23, 2016).

Third, Patent Owner's DD Request contains clear misrepresentations. For example, Patent Owner contends that, in *Pantech I*, "the court denied Petitioner's motions for judgment as a matter of law." DD Req. 19. In reality, the district court in *Pantech I* **granted** judgment of a matter of law of non-infringement for one of the patents Patent Owner raised at trial, finding that Patent Owner failed to meet its burden. *Pantech I*, 2024 LEXIS 242332, *13-18 (E.D. Tex. August 14, 2024). In alleging Petitioner's "refusal to negotiate in good faith and its holdout tactics," Patent Owner claims that "Petitioner's conduct has already been found to be unjust." DD Req. 19. This is untrue. As noted above, the district court found that Petitioner actions were supported by its reasonable belief that Patent Owner was not making a FRAND offer.

Such repeated gamesmanship by Patent Owner in this proceeding should not be rewarded with discretionary denial of institution.

V. CONCLUSION

For the above reasons, Petitioner respectfully requests that the Director refrain from exercising discretion to deny this Petition, and instead pass it to a merits panel for consideration.

Respectfully submitted,

BAYES PLLC

/Zhiwei Zou/

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Date: July 17, 2025
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CERTIFICATION UNDER 37 C.F.R. § 42.24

This Petitioner's Opposition to Patent Owner's Request for Discretionary Denial complies with the requirements of 37 C.F.R. § 42.24. As calculated by the word count feature of Microsoft Word, it contains 9,406 words, excluding the parts exempted by § 42.24.

/Zhiwei Zou/
Zhiwei (Wayne) Zou
Registration No. 66,041
Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and Exhibits 1021-1033** were served on July 17, 2025, via email, as agreed to by counsel of record for the Patent Owner, at the following.

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Dated: July 17, 2025

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