

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONEPLUS TECHNOLOGY (SHENZHEN) CO., LTD.,
Petitioners,

v.

PANTECH CORPORATION,
Patent Owner

Case: IPR2025-00637

U.S. Patent No. 9,763,283

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF
INSTITUTION UNDER 35 U.S.C. §§ 314(A) AND 325(D)**

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PATENT OWNER'S EXHIBIT LIST

Exhibit Number	Description
2001	Second Amended Docket Control Order, <i>Pantech Corporation and Pantech Wireless, LLC v. OnePlus Technology (Shenzhen) Co., Ltd.</i> , No. 5:24-CV-00038-RWS-JBB (E.D. Tex.) (Dkt. 58) (May 13, 2025)
2002	United States District Courts – National Judicial Caseload Profile
2003	Pantech Corporation's July 9, 2021 Notice Letter to OnePlus Technology Co., Ltd.

Pursuant to Acting Director Stewart’s March 26, 2025 Memorandum titled “Interim Processes for PTAB Workload Management” (“March 26, 2025 Memorandum”), Patent Owner Pantech Corporation (“Pantech”) respectfully requests that the Director exercise her discretion to deny institution of Petitioner OnePlus Technology (Shenzhen) Co., Ltd.’s (“Petitioner”) Petition for *inter partes* review of U.S. Patent No. 9,763,283 (“IPR”). The grounds for discretionary denial are compelling and supported by the facts, the procedural posture of the parallel district court litigation, the equities of the case, and the public interest. The Board should deny institution under both 35 U.S.C. § 314(a) and § 325(d).

I. INTRODUCTION

This IPR is a paradigmatic example of why discretionary denial is necessary to protect the integrity of the patent system, prevent duplicative proceedings, and respect the statutory balance between the PTAB and Article III courts. The underlying district court litigation between Pantech and Petitioner is in an advanced stage, with a detailed and imminent case schedule, and the issues raised in this IPR are or will be fully addressed in that forum. Moreover, Petitioner’s conduct—both in the marketplace and in litigation—demonstrates a pattern of holdout, bad faith, and disregard for its FRAND obligations, further supporting denial. The Board should also deny institution under § 325(d) because the asserted prior art and arguments are cumulative of those already considered by the Patent Office, and

Petitioner's attempt to relitigate these issues is improper.

II. THE ADVANCED STATUS OF THE PARALLEL DISTRICT COURT LITIGATION FAVORS DISCRETIONARY DENIAL UNDER SECTION 314(A)

The Director should deny institution under 35 U.S.C. §314(a) because all six *Fintiv* factors favor discretionary denial. The *inter partes* review statute leaves institution entirely at the discretion of the Director. *See* 35 U.S.C. § 314(a); *Harmonic Inc. v. Avid Tech.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016). “[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.” *Id.*

The Director has historically applied that discretion where efficiency considerations stemming from parallel proceedings on the same patent warrant denial of institution. *See NHK Spring Co. v. Intri-Plex., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) (“*NHK Spring*”).

A. The District Court Litigation Is Well Advanced

The underlying litigation, *Pantech Corp. et al. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, No. 5:24-cv-00038-RWS-JBB (E.D. Tex.), is proceeding under a Second Amended Docket Control Order (“DCO”) with a highly developed schedule:

- *Markman* briefing: completed
- *Markman* hearing: July 9, 2025
- Fact discovery closes: September 19, 2025
- Final election of asserted claims: September 5, 2025
- Expert discovery closes: November 7, 2025
- Dispositive motions due: November 28, 2025
- Pretrial conference: April 7, 2026

- Trial: April 13, 2026

By the time the Board would be scheduled to reach a Final Written Decision (October 2026), the district court will have completed claim construction, fact and expert discovery, summary judgment, and trial. The court will have fully adjudicated all issues, including validity, with the benefit of a complete record, live testimony, and a jury trial.

It should be no surprise that this case schedule is at an advanced stage: Petitioner waited over two years since becoming aware of their infringement to file the present petition. This delay undermines the statutory purpose of *inter partes* review, and is entirely a problem of Petitioner's own making.

The Director's own guidance, as well as the *Fintiv* factors, strongly favor denial where the parallel district court litigation is at an advanced stage and will resolve the same issues. *See NHK Spring*, Paper 8. Here, the parties have already exchanged infringement and invalidity contentions, produced documents, completed claim construction briefing, and are preparing for the *Markman* hearing. The court's management of the case ensures that all issues—including those raised in this IPR—will be resolved efficiently and fairly.

B. Fintiv Factor 1: Whether a Stay Exists or Is Likely to Be Granted if IPR Is Instituted

The district court has not granted a stay, nor is there any indication that a stay

will be granted if the IPR is instituted. The Second Amended Docket Control Order (“DCO”) sets a firm trial date of April 27, 2026—six months before the expected Final Written Decision in this IPR—and the court has made clear that this date is “not flexible without good cause.” Ex. 2001. The parties are actively litigating, and the case is proceeding on all fronts. Notably, claim construction and fact discovery will have been completed and the parties will be well into expert discovery before the anticipated October 17, 2025 Institution Decision.

Moreover, though Petitioner has not requested a stay in the district court proceedings, any such pre-institution request would almost certainly be denied consistent with the practice in the Eastern District of Texas. *Luminati Networks Ltd. v. Teso LT, UAB*, No. 2:19-CV-00395-JRG, 2020 WL 6803255, at *1 (E.D. Tex. Oct. 30, 2020); *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13 CV-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (Bryson, J.) (“it is the universal practice of courts in this District to deny pre-institution motions to stay); *Viavi Sols. Inc. v. Zhejiang Crystal-Optech Co.*, No. 2:21-CV-00378-JRG, 2022 WL 16856099, at *5 (E.D. Tex. Nov. 10, 2022) (“It is the Court’s established practice to consider motions to stay pending IPR proceedings which have not been instituted are inherently premature and should be denied as such.”).

Finally, it is important to emphasize that the district court proceedings were previously stayed by mutual agreement of the parties, specifically to allow for

resolution of Petitioner's challenge to Pantech's standing to assert the patents-in-suit. The parties expressly agreed that the stay would remain in place only until the district court ruled on the standing issue. Once the court resolved the matter in Pantech's favor, however, Petitioner refused to cooperate in lifting the stay, despite the clear terms of the parties' agreement. Instead, Petitioner insisted that Pantech file a formal motion to lift the stay, thereby forcing Pantech to expend additional time and resources and causing unnecessary, avoidable delay of several months to the district court's schedule. This conduct resulted in significant disruption to the orderly progress of the litigation and underscores that Petitioner should not be allowed to leverage its own dilatory tactics as a basis for instituting a parallel PTAB proceeding. The current absence of a stay, when viewed in light of Petitioner's deliberate delay, weighs strongly in favor of discretionary denial.

C. Fintiv Factor 2: Proximity of the District Court's Trial Date to the PTAB's Projected Statutory Deadline

Petitioner only recently filed this IPR on March 18, 2025—more than one year after the underlying complaint was filed and a courtesy copy was provided to Petitioner's counsel on March 14, 2025. The Notice of Filing Date Accorded to Petition was mailed on April 17, 2025. Paper 5. A Final Written Decision will therefore be due by October 17, 2026. See 35 U.S.C. §314(b); 35 U.S.C. §316(a)(11).

Because Petitioner waited until the last minute to file its IPR, the parallel district court litigation has already proceeded to an advanced stage, and the district court trial is scheduled for April 27, 2026, more than six months before the PTAB's projected FWD. The DCO is explicit that the trial date is not flexible. Ex. 2001. Petitioner attempts to downplay this timing, arguing that the trial date "is at or around the same time as the projected statutory deadline for this IPR," but half a year difference is hardly "at or around the same time." Paper 1 at 76.

Moreover, the result is the same even when considering the median time from filing to disposition of civil trials in the Eastern District of Texas rather than the scheduled trial date. The current median time to trial in the Eastern District of Texas is 21.6 months. Ex. 2002 at 35. Considering that the district court litigation was filed on March 14, 2024, these statistics suggest that the trial would still occur by January 2026, well before the FWD. Thus, both the actual scheduled trial date in the parallel litigation and the median time-to-trial statistics for the Eastern District of Texas consistently place the trial well before the expected FWD.

Under *Fintiv* factor 2, this weighs heavily in favor of discretionary denial. *See Fintiv I*, at 9 ("If the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this factor in favor of exercising authority to deny institution under NHK."); *Ericsson Inc. et al v. Collison Communications, Inc.*, IPR2022-01233, Paper 12 at 12-13 (PTAB Jan. 19, 2023) (holding Factor 2 "weighs

in favor of denying institution, given that we would not expect to issue a final written until at least four months” after trial). Here, the 6-month gap between the district court trial and the final written decision is longer than in cases such as *Ericsson* where the Board has previously denied institution. *Id.*

By the time the PTAB would issue a FWD, the district court will have completed claim construction, fact and expert discovery, dispositive motions, pretrial conference, a jury trial, and likely post-trial proceedings. The district court will have resolved all issues, including validity, with the benefit of a full record, live testimony, and a jury verdict. The proximity of the trial date to the PTAB’s deadline weighs heavily in favor of denial, as the district court will almost certainly reach a decision first, rendering the PTAB proceeding duplicative and unnecessary.

D. Fintiv Factor 3: Investment in the Parallel Proceeding by the Court and the Parties

The parties and the court have already made substantial investments in the district court litigation. The DCO reflects that:

- The parties have exchanged infringement and invalidity contentions.
- Fact discovery is set to close on September 19, 2025.
- Expert discovery will close on November 7, 2025.
- Dispositive motions are due by November 28, 2025.
- The *Markman* hearing is scheduled for July 9, 2025, with claim construction briefing already completed.

The court has entered multiple scheduling orders, and the parties are preparing for the *Markman* hearing. The court’s management of the case ensures that all

issues—including those raised in this IPR—will be resolved efficiently and fairly. The significant investment by both the court and the parties in the district court litigation, including the exchange of contentions, document production, and expert discovery, means that the issues are already being fully developed and will be adjudicated in the Article III forum. This factor strongly supports discretionary denial.

E. Fintiv Factor 4: Overlap Between Issues Raised in the Petition and in the Parallel Proceeding

There is substantial overlap between the issues raised in this IPR and those before the district court. The same prior art references (Dudda, Lin, Pelletier) and the same invalidity arguments are at issue in both forums. The district court will resolve these issues as part of its adjudication of the case, including through summary judgment and trial. The risk of inconsistent outcomes is real and significant, as both the PTAB and the district court would be considering the same validity challenges based on the same evidence. The PTAB's involvement would be duplicative, wasteful, and contrary to the goal of judicial economy. This factor weighs heavily in favor of denial.

Petitioner has offered what it deems to be a *Sotera* stipulation not to pursue in district court any ground that could have been raised in IPR. Paper 1 at 72; Paper 9 at Ex. 1020. However, this stipulation does not eliminate the substantial overlap of

issues or the risk of inconsistent results. The district court will still address validity under 35 U.S.C. §§ 102 and 103, and the Board’s involvement would be duplicative and unnecessary. Most importantly, the stipulation does not bind all real parties-in-interest and thus does not prevent the district court from considering the same prior art and arguments. Specifically, Petitioner has identified Guangdong OPPO Mobile Telecommunications Corp., Ltd. (“OPPO”) as a real party-in-interest, and has represented to the district court that it may seek to add additional parties to the case once the court rules on its motion to dismiss. But OPPO is not a signatory on the stipulation. Thus, Petitioner could seek to add OPPO (a closely related entity) to district court litigation and thereby effectively sidestep the stipulation it now offers, thereby undermining the entire purpose of *Sotera*-type stipulations.

At bottom, the Board and the courts have recognized that even properly-made *Sotera* stipulations, while relevant, are not dispositive and do not outweigh the other Fintiv factors when the district court litigation is as advanced as it is here. *See Samsung Electronics Co., Ltd. v. California Institute of Technology*, IPR2023-00130, Paper 10 (PTAB May 4, 2023).

F. Fintiv Factor 5: Whether the Petitioner and the Defendant in the Parallel Proceeding Are the Same Party

The petitioner in this IPR, OnePlus Technology (Shenzhen) Co., Ltd., is the same party as the defendant in the district court litigation. The issues, parties, and

interests are identical, further supporting the conclusion that the PTAB proceeding would be duplicative and unnecessary. This factor supports discretionary denial.

G. Fintiv Factor 6: Other Circumstances That Impact the Board’s Exercise of Discretion, Including the Merits

While the merits of the petition are a consideration, the advanced status of the district court litigation, the substantial investment by the parties and the court, the overlap of issues, and the proximity of the trial date all weigh so heavily in favor of denial that the merits do not tip the balance. The district court is fully capable of resolving all issues, and there is no compelling public interest that would justify institution in this case.

Granting institution here would frustrate one of the primary objectives of the AIA “to provide an effective and efficient alternative” to parallel litigation, not a duplicative one. *NHK Spring*, 19-20 (quoting *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, 15-19 (PTAB Sept. 6, 2017) (precedential, designated Oct. 18, 2017)). If IPR were instituted, any potential FWD would issue well after trial concludes. Where, as here, the district court is poised to resolve all issues, the Board should defer to the Article III forum.

III. The Board Should Deny Institution Under 35 U.S.C. § 325(d)

A. The Asserted Prior Art and Arguments Are Cumulative

The prior art references and arguments in this IPR are cumulative of those already considered by the Patent Office during prosecution. During prosecution of

the '283 Patent, the Examiner considered numerous references relating to radio link failure (RLF), but ultimately accepted Patent Owner's argument that Lin-548¹ "discloses PCELL PUCCH in paragraph [0041], but fails to disclose or suggest any PUCCH to the SCELL, and thus cannot stop such non-existing uplink transmissions. For at least this reason, [Lin-548] fails to disclose or fairly suggest 'the user equipment stops uplink transmission of physical uplink shared channel (PUSCH), physical uplink control channel (PUCCH), and sounding reference signal (SRS) to the secondary serving cell,' as presently recited in the independent claims." *See* EX1002 at 89.

The alleged prior art set forth in the Petition similarly "fails to disclose or suggest any PUCCH to the SCELL," and thus is unreasonably cumulative with art already considered by the Patent Office.

1. U.S. Patent No. 10,631,222 ("Dudda") (EX1004)

Petitioner implicitly acknowledges that Dudda fails to disclose any PUCCH to the SCELL, and thus (like Lin-548) cannot stop such non-existing uplink transmissions. *See* Pet. at 42 ("While Dudda does not explicitly specify PUSCH,

¹ U.S. Patent Application Publication No. 2012/0281548 to Lin et. al. (EX1013) is styled as "Lin-548" in the Petition. *See* Pet. at 7. For convenience, this abbreviation is adopted herein as well.

PUCCH, and SRS...”).

Rather than point to any specific disclosures in Dudda teaching this limitation, Petitioner argues that “a POSITA would have understood, from Dudda’s disclosures, that stopping uplink transmission to the assisting eNB in Dudda includes preventing the UE from making any uplink transmission to the assisting cell, including ‘PUSCH, PUCCH, and SRS’.” *See* Pet. at 20. But all that Petitioner points to for Dudda teaching PUCCH (beyond the say-so of its expert) is disclosures of “signaling data” in Dudda (*see* Pet. at 20), but like Lin-548, this is not a disclosure of any PUCCH to the SCELL.

Rather than teaching any PUCCH to the SCELL, Dudda teaches that “the embodiments are applicable to LTE and radio access networks of GSM and UMTS” (EX1004 at 28:1-2), and in LTE, the “PCell is used for transmission of PUCCH.” *See* EX1009 at § 7.8, p. 58. Indeed, the teaching of “signaling data” pointed to by Petitioner (*see* Pet. at 20, citing EX1004 at 9:54-58, 28:35-51) is not provided in the context of PUCCH in an SCELL connection—at most, Dudda teaches that the SCELL can be a relay node, and even then, there is no teaching that the signaling data will specifically include PUCCH. This is a teaching not meaningfully different from Lin-548.

2. *U.S. Patent Application No. 2011/0134774 (“Pelletier”) (EX1007)*

Petitioner relies on Pelletier to cure the failures of Dudda (and Lin, addressed below), but Pelletier too fails to teach any PUCCH to the SCELL, and thus (like Lin-548) cannot stop such non-existing uplink transmissions.

Petitioner only cites Pelletier at [0047] and [0104] for its argument that “Pelletier is clear that the deactivation of SCell upon RLF affects uplink resources of the WTRU, including ‘a PUSCH transmission, [] a PUCCH transmission, [] the transmission of CQI/PMI/RI or SRS transmission.’” *See* Pet. at 41.

But in its disclosures, Pelletier is merely discussing the communications “affected by activation and deactivation of SCells” (EX1007 at [0104]), which are ultimately PUCCH transmissions *about* the SCELL but sent to the PCELL. Indeed, in Pelletier, PUCCH communications are taught only with regard to the PCELL. *Compare* EX1007 at [0042] (discussing PCELL configuration and noting that “[t]he UL CC of the PCell may correspond to the CC whose PUCCH resources are configured to carry all HARQ ACK/NACK feedback for a given WTRU”) *with* EX1007 at [0043] (discussing SCELL configuration with no disclosure of PUCCH). Nowhere in Pelletier is PUCCH discussed with regard to communications with the SCELL.

In this way, the teachings of Pelletier mirror the LTE Standard. Even in ETSI TS 136 300 V11.3.0 (2012-11) (EX1009), cited by Petitioners (*see* Pet. at 7, n. 2), which sets forth Rel-11 LTE (far more advanced than Rel-8 LTE cited by Pelletier,

see EX1007 at [0003], [0098], [0149]), it is clear that the “PCell is used for transmission of PUCCH.” *See* EX1009 at § 7.8, p. 58.

Thus, Pelletier’s teachings are not meaningfully different from Lin-548, which similarly teaches PUCCH communications about the SCELL but sent to the PCELL, not the SCELL:

In option 904, the UE automatically informs eNB an SCELL RLF notification through other activated serving cell. The notification may include the detected problem such as an SCELL RLF has occurred, the deactivation of an SCELL or a group of SCELLs, and the availability of recorded problem event information for later gathering by the network. The UE may also directly report to eNB the SCELL RLF report. The notification may be implemented by a MAC layer control element (CE), an RRC message on PUSCH, or a PHY layer indication by PUCCH. In addition, the UE may inform eNB the detected SCELL RLF problem by keep sending a specific CQI value on that SCELL through PCELL PUCCH until the problematic RLF SCELL is deactivated/de-configured. In one example, the specific CQI value to indicate SCELL RLF may be set as zero.

Lin-548 at [0041] (emphasis added). This is the very disclosure of Lin-548 that was pointed out by Patent Owner to the Patent Office as distinguishable from the claimed invention. *See* EX1002 at 89 (Lin-548 “discloses PCELL PUCCH in paragraph [0041], but fails to disclose or suggest any PUCCH to the SCELL, and thus cannot stop such non-existing uplink transmissions.”).

3. *International Patent Application No. WO 2014/110813 (“Lin”) (EX1006)*

Lin, which shares two named inventors with Lin-548, similarly fails to disclose any PUCCH to the SCELL, and thus (like Lin-548) cannot stop such non-existing uplink transmissions.

Petitioner cites Lin at [0063]-[0071] as supposedly teaching PUCCH communications with an SCELL (Pet. at 49), but PUCCH is not even mentioned in these paragraphs. Rather, where PUCCH is specified in Lin, it is with regards to the PCELL. *See* Lin at [0004] (“At RRC connection reestablishment or handover, one serving cell provides the security input. This cell is referred to as the primary serving cell (PCELL), and other cells are referred to as the secondary serving cells (SCELLs).”), [0010] (“The serving cell is in the status of activation and is one of the following: [] a specific cell with configured PUCCH resource”), [0034] (“The RLM/RLF configured serving cell can be the first activated serving cell in a cell group, and the the *[sic]* serving cell could be one of the following cases; a serving cell configured with PUCCH resource in a cell group”).

Petitioner also cites to Lin at Claim 9, but Claim 9 merely requires “using a still usable Cell or Radio Link, preventing spontaneous UL transmissions (PUCCH, SRS, SPS),” but these UL transmissions are not specified with respect to the SCELL, and thus do not differ with respect to the teachings of Lin already addressed.

Finally, Petitioner cites to Pelletier as supposedly teaching the deficiencies of Lin. *See* Pet. at 49-50 (“To the extent Lin does not explicitly disclose... each of the

claimed uplink transmissions being stopped by the UE (*i.e.*, PUSCH, PUCCH, and SRS) in the stopping limitation, a POSITA would have been motivated to combine Lin and Pelletier to arrive at the claimed invention”). But as addressed above, Pelletier does not teach these limitations either.

B. There Has Been No Material Error by the Examiner

Petitioner has not identified any material error by the Examiner, and the Board should not permit Petitioner to relitigate issues that were already addressed and resolved.

Petitioner suggests that the Examiner was wrong with respect to Lin-548 because:

Lin-548 explicitly discloses ‘UE autonomously stops UL transmission over the RLF SCCELL ... to avoid uncontrollable UL transmission and to prevent interference to other users. The UE ... stops reporting CQI/PMI/RI for the SCCELL.’ EX1013, [0039]. CQI/PMI/RI are well-known uplink control information transmitted on PUCCH. EX1007, [0040]; EX1009, 40; EX1003, ¶66.

Pet. at 7, n. 2.

But Petitioner mischaracterizes the teachings of Lin-548. Lin-548 at [0039] (the portion of Lin-548 cited by Petitioner) discloses only that “The UE flushes all HARQ buffers associated with the SCCELL, stops transmitting SRS for the SCCELL, stops reporting CQI/PMI/RI for the SCCELL...” *See* EX1013 at [0039]. This is CQI/PMI/RI *about* the SCCELL, not *to* the SCCELL. These are communications

transmitted on PUCCH to the PCELL.

Lin-548 at [0027] (its only disclosures regarding CQI) notes that “In LTE Rel-10, radio link monitoring (RLM) and radio link failure (RLF) detection is only applied on PCELL, not on SCELLs. This is because it is assumed that eNB can detect poor link quality e.g. from Channel Quality Indicator (CQI) reports and/or existing RRM measurement reports.” EX1013 at [0027]. There is no disclosure in Lin-548 of CQI reports (or PMI/RI) being transmitted to the SCELL.

Even in ETSI TS 136 300 V11.3.0 (2012-11) (EX1009), cited by Petitioners (*see* Pet. at 7, n. 2), which sets forth Rel-11 LTE (such as invoked by Lin-548, *see* EX1013 at [0006] (“In LTE rel-11, inter-band UL CA will be supported”)), it is clear that the “PCell is used for transmission of PUCCH.” *See* EX1009 at § 7.8, p. 58.

Finally, the cites that Petitioner provides for its subsequent argument that “CQI/PMI/RI are well-known uplink control information transmitted on PUCCH” may indeed establish this limited proposition exactly as it is written, but none discuss PUCCH communications with the SCELL, and this argument is thus beside the point. *See* Pet. at 7, n. 2.

Thus, like Dudda, Pelletier, and Lin (and the LTE standard at the time), the Examiner correctly determined that Lin-548 discusses PUCCH communications in the context of the PCELL, not SCELL. Accordingly, the Board should respect the Office’s prior determinations and deny institution under § 325(d).

IV. PETITIONER’S LITIGATION CONDUCT AND FRAND VIOLATIONS SUPPORT DENIAL

A. Petitioner’s Willful Infringement and Bad Faith

Petitioner has been on notice of Pantech’s patent portfolio—including the ’283 patent—since at least July 2021. Ex. 2003 at 2. Pantech repeatedly offered Petitioner a license on FRAND terms, provided detailed claim charts, and identified the relevant patents. Petitioner refused to engage in good faith negotiations, never made a counteroffer, and continued to sell infringing products. Petitioner also did not seek an IPR: rather, it ignored Pantech.

The Director’s recent decision in *iRhythm Technologies v. Welch Allyn Inc.*, IPR2025-00377, et al. (Director Review: June 6, 2025), Paper 10, further underscores the significance of these facts. In that case, the Director exercised her discretion to deny institution where the petitioner had long been aware of the asserted patents but delayed seeking IPR until after being sued. The Director found that such delay, especially when the patent owner had made the patents known and sought resolution, created “settled expectations” that weighed heavily in favor of denial. Here, Petitioner’s conduct is even more egregious: not only was Petitioner aware of the ’283 patent almost three years before filing its IPR, but Pantech also made repeated, detailed, and good-faith efforts to resolve the dispute amicably. Petitioner’s refusal to engage, despite these efforts, demonstrates a lack of diligence and good faith that the PTAB has recently found to be a compelling basis for

discretionary denial.

B. Jury Verdict of Willful Infringement

In a recent trial, a jury found that Petitioner willfully infringed five of Pantech's patents, and the court denied Petitioner's motions for judgment as a matter of law. The jury's verdict and the court's order confirm the strength of Pantech's patents and the egregiousness of Petitioner's conduct. The Board should not reward such conduct by granting institution.

The Director's recent guidance makes clear that the PTAB is increasingly focused on the equities of the parties' conduct and the timing of IPR petitions. Where, as here, a petitioner has been found by a jury to have willfully infringed and has ignored repeated opportunities to resolve the dispute, the equities strongly favor denial. Allowing institution in these circumstances would undermine the "settled expectations" created by Pantech's good-faith efforts and would reward strategic delay and bad faith, contrary to the PTAB's current policy direction.

C. Violation of FRAND Obligations

Petitioner's refusal to negotiate in good faith and its holdout tactics are a direct violation of its FRAND obligations under ETSI policy. Petitioner's conduct has already been found to be unjust, further supporting denial of institution as a matter of equity and public policy. The availability of discretionary denial is designed to prevent precisely this type of gamesmanship.

V. CONCLUSION

For the foregoing reasons, the Board should exercise its discretion under 35 U.S.C. §§ 314(a) and 325(d) and deny institution of IPR2025-00637. The advanced status of the district court litigation, the duplicative nature of the issues, Petitioner's willful infringement and bad faith, the cumulative nature of the prior art, and the equities of the case all compel discretionary denial.

Dated: June 17, 2025

Respectfully submitted,

/James A. Fussell Reg No 54885/
James A. Fussell (Reg. No. 54,885)

Case IPR2025-00637
Patent No. 9,763,283

CERTIFICATE OF SERVICE

I hereby certify that on this 17th day of June, 2025, a copy of the attached **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION UNDER 35 U.S.C. §§ 314(A) AND 325(D)** was served by electronic mail to the attorneys of record, at the following addresses:

Zhiwei (Wayne) Zou
Wayne.zou@bayes.law

With a courtesy copy by electronic mail to:

OnePlus-Pantech-IPR@bayes.law

Respectfully submitted,

Date: June 17, 2025

By: /James A. Fussell Reg No 54885/
James A. Fussell (Reg. No. 54,885)

Case IPR2025-00637
Patent No. 9,763,283

CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Request for Discretionary Denial of Institution complies with the type-volume limitation of 37 CFR §42.24(a). The word count application of the word processing program used to prepare this Request for Discretionary Denial of Institution indicates that the Request for Discretionary Denial of Institution contains 4,503 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

Respectfully submitted,

Date: June 17, 2025

By: /James A. Fussell Reg No 54885/
James A. Fussell (Reg. No. 54,885)