

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE USA, INC., AT&T MOBILITY LLC, CELCO PARTNERSHIP
D/B/A VERIZON WIRELESS, ERICSSON INC. AND NOKIA OF AMERICA
CORPORATION

Petitioners

v.

SMART RF INC.

Patent Owner

Case IPR2025-00727

U.S. Patent 7,035,345

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF
INSTITUTION**

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EXHIBIT LIST

Exhibit No.	Description
2001	Plaintiff's Complaint for Patent Infringement against AT&T, No. 2:24-cv-00195, Dkt. 1 (E.D. Tex. Mar. 19, 2024)
2002	Plaintiff's Complaint for Patent Infringement against Verizon, No. 2:24-cv-00196, Dkt. 1 (E.D. Tex. Mar. 19, 2024)
2003	Plaintiff's Complaint for Patent Infringement against T-Mobile, No. 2:24-cv-00197, Dkt. 1 (E.D. Tex. Mar. 19, 2024)
2004	Consolidation Order, No. 2:24-cv-00195, Dkt. 13 (E.D. Tex. Apr. 19, 2024)
2005	Order (Ericsson Intervention), No. 2:24-cv-00195, Dkt. 56 (E.D. Tex. Aug. 8, 2024)
2006	Order (Nokia Intervention), No. 2:24-cv-00195, Dkt. 56 (E.D. Tex. Aug. 8, 2024)
2007	<i>MyPort, Inc. v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:22-cv-00114-JRG, Order, Dkt. 73 (E.D. Tex. June 13, 2023)
2008	Minute Entry for Markman Hearing, No. 2:24-cv-00195, Dkt. 85 (E.D. Tex. Jun. 12, 2025)
2009	First Amended Docket Control Order, No. 2:24-cv-00195, Dkt. 81-1 (E.D. Tex. Jun. 10, 2025)
2010	Defendants' Supplemental Disclosure of Invalidity Contentions Under Patent Rules 3-3 and 3-4, No. 2:24-cv-00195 (E.D. Tex. Mar. 31, 2025)
2011	Docket Control Order, <i>Smart RF Inc. v. AT&T Mobility LLC et al.</i> , Case No. 2:24-cv-00195-JRG, Dkt. No. 41 (E.D. Tex. June 21, 2024)
2012	Intentionally Left Blank
2013	Intentionally Left Blank

Exhibit No.	Description
2014	Declaration of David DeZern
2015	Plaintiff's Five Service Emails for Supplemental Infringement Contentions, No. 2:24-cv-00195
2016	U.S. Patent No. 8,633,769 (Ericsson)
2017	Notice of Allowability for U.S. Patent No. 8,633,769 (Application No. 13/593,693) (Ericsson)
2018	U.S. Patent No. 9,660,673 (Ericsson)
2019	Office Action for U.S. Patent No. 9,660,673 (Application No. 14/898,838) (Ericsson)
2020	U.S. Patent No. 11,265,201 (Ericsson)
2021	Information Disclosure Statement for U.S. Patent No. 11,265,201 (Application No. 16/641,180) (Ericsson)
2022	U.S. Patent No. 7,268,619 (Nokia)
2023	Notice of Allowability for U.S. Patent No. 7,268,619 (Application No. 10/490,054) (Nokia)
2024	USPTO Assignment Table - U.S. Patent No. 7,268,619 (Application No. 10/490,054)
2025	<i>General Access Solutions, Ltd. v. Cellco Partnership</i> , Case No. 2:22-cv-00394-JRG, Order, Dkt. No. 225 (E.D. Tex. May 22, 2024)
2026	9,641,204 (“’204 Patent”)
2027	Letter to Smart RF re: Stipulation
2028	8,078,561 (“’561 Patent”)

I. INTRODUCTION

Pursuant to Director Stewart’s March 26, 2025, Memorandum titled “Interim Processes for PTAB Workload Management” (“Workload Memo”), Patent Owner Smart RF, Inc. (“Patent Owner”) respectfully requests that the Director exercise discretion and deny institution of *inter partes* review under 35 U.S.C. § 314(a).

The Workload Memo states that—in addition to the discretionary considerations set forth in existing Board precedent (e.g., *Fintiv*) and the Consolidated Trial Practice Guide (Nov. 2019)—the Director will take into account “all relevant considerations,” including but not limited to the strength of the unpatentability challenge, the extent of the petitioner’s reliance on expert testimony, settled expectations of the parties, and the ability of the PTAB to comply with its statutory deadlines. Workload Memo, 2-3. Given the circumstances presented here, discretionary denial is warranted based on these and other considerations.

In particular, denial is warranted in view of the district court trial between Patent Owner and the Petitioners T-Mobile USA, Inc. (“T-Mobile”), AT&T Mobility LLC (“AT&T”), and Cellco Partnership d/b/a Verizon Wireless (“Verizon”), Nokia of America Corporation (“Nokia”), and Ericsson Inc. (“Ericsson”) (collectively, “Petitioners”) with respect to the validity of the challenged patent that will commence on November 17, 2025—*eleven months before* the expected date of the Board’s final decision here. If instituted, the Board

would have to expend substantial resources to decide issues that will have already been addressed and decided by the district court.

II. BACKGROUND

Patent Owner filed complaints accusing Petitioners T-Mobile, AT&T, and Verizon of infringing U.S. Patent No. 7,035,345 (the “’345 patent”)¹ on March 19, 2024. Exs. 2001, 2002, and 2003. The district court consolidated those three cases (collectively referred to as the “district court case” or the “parallel proceeding”) for all pretrial issues on April 29, 2024. Ex. 2004. A schedule for the parallel proceeding was entered on June 21, 2024. Ex. 1017 at 1. Petitioners Nokia and Ericsson intervened in the parallel proceeding on August 8, 2024. Exs. 2005 and 2006.

Since then, the parties to the parallel proceeding have exchanged infringement

¹ Those complaints also alleged infringement of four other United States Patents: Nos. 10,958,296 (“’296 Patent”); 8,767,857 (“’857 Patent”); 9,641,204 (“’204 Patent”; Ex. 2026) and 8,078,561 (“’561 Patent”; Ex. 2028) (collectively, with the patent in this proceeding, the “Asserted Patents”). Petitioners have challenged three of those additional patents in co-pending *inter partes* review petitions: IPR2025-00612 (’561 Patent), IPR2025-00692 (’204 Patent), and IPR2025-00691 (’296 Patent) (collectively, the “Co-Pending IPRs”). Petitioners have not challenged the remaining patent asserted in the district court case: the ’857 Patent.

contentions, invalidity contentions, and preliminary claim constructions. The parties have conducted claim construction discovery, completed claim construction briefing, and the claim construction hearing occurred on June 12, 2025. Exs. 2008 and 2011. Further, the parties have conducted substantial discovery, including 18 depositions, over 900,000 pages of document production, 89 interrogatories, 5 subpoenas, and 6 sets of letters rogatory, and fact discovery closes on July 7, 2025. Ex. 2009 at 4; Ex. 2014 (DeZern Declaration). Still further, the parties will disclose expert witness reports for issues on which they bear the burden of proof on July 7, 2025, and rebuttal expert witness reports on July 28, 2025. Ex. 2009 at 4. The parties will file dispositive motions on August 11, 2025, and jury selection is set for November 17, 2025. *Id.* at 1, 4.

The Petitioners did not file this Petition until March 18, 2025, the day before the one-year anniversary of the filing of the parallel proceeding. In the interim, the parties and the District Court spent significant resources in the parallel proceeding as detailed herein. Furthermore, the Petitioners have not filed a motion to stay the parallel proceeding, nor have they indicated any intent to do so. In any event, it is the district court's "universal practice" "to deny a motion to stay when the Board has not yet acted on the IPR petition." *Arbor Global Strategies v. Samsung Elecs. Co.*, No. 2:19-cv-333-JRG-RSP, 2021 U.S. Dist. LEXIS 2434, at *7 (E.D. Tex. Jan. 7, 2021).

Should the Director not discretionarily deny the Petition, the trial would likely not be instituted until October 16, 2025 (six months from the notice according a filing date of April 16, 2025, Paper 9). This date is two days *after* the pretrial conference in the parallel proceeding. *Ex. 2009* at 2. Thus, it is even more unlikely that the district court would stay the parallel proceedings. By the pretrial conference, the parties will have completed all fact and expert discovery, fully briefed dispositive motions, completed all pretrial motions and disclosures, and filed a pretrial order. *Id.* at 2-3. Furthermore, a final written decision on the Petition would not be expected before October 2026, eleven months *after* the trial in the parallel proceeding.

III. DISCRETIONARY DENIAL IS WARRANTED

It is well-settled that institution of IPR is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“the PTO is permitted, but never compelled, to institute an IPR proceeding”); *see also* 35 U.S.C. § 314(a) (“[t]he Director may not authorize an inter partes to be instituted unless...”); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). In determining whether to exercise discretion to deny institution, the Director “consider[s] the effect of any such regulation [under this section] on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.”

35 U.S.C. § 316(b).

The Director may exercise discretion under § 314(a) to deny institution of an *inter partes* review when the parties have a parallel district court proceeding scheduled to finish before the Board’s deadline to issue a final written decision in an instituted proceeding. *See, e.g., Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 3 (PTAB Mar. 20, 2020) (“*Fintiv*”) (precedential, designated May 5, 2020); *NHK Spring Co. v. Intri-Plex Techs. Inc.*, IPR2018-00752, Paper 8 (“*NHK Spring*”) (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019); *Intel Corp. v. VLSI Tech. LLC*, IPR2019-01192, Paper 15 at 11 (PTAB Jan. 9, 2020) (“When considering the impact of parallel litigation in a decision to institute, the Board seeks, among other things, to minimize the duplication of work by two tribunals to resolve the same issue.”).

The Director frequently evaluates the following six factors in determining whether “to deny institution in view of an earlier trial date in the parallel proceeding”:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;

4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv, Paper 11 at 5-6.

Consistent with this authority, the Workload Memo makes clear that the Director will consider “all relevant considerations” in determining whether discretionary denial is warranted, including but not limited to the strength of the unpatentability challenge, the extent of the petitioner's reliance on expert testimony, settled expectations of the parties, compelling economic interests, and the ability of the PTAB to comply with its statutory deadlines. Workload Memo, 2-3. Discretionary denial is warranted here based on these and other relevant discretionary considerations.

A. *Fintiv* Factor 1 - Petitioners have not sought a stay, and a stay is unlikely to be granted.

This factor weighs against institution because the Petitioners waited nearly a year into the litigation to file the Petition, have not requested a stay, and a stay is unlikely. Indeed, the district court's established practice is to deny motions to stay

filed before institution of *inter partes* review. See *Arbor Global Strategies*, No. 2:19-cv-333-JRG-RSP, 2021 U.S. Dist. LEXIS 2434, at *7 (“The ‘universal practice’ in this District, as well as the practice of most district courts, is to deny a motion to stay when the Board has not yet acted on the IPR petition(s).”); *Polaris Power Techs. v. Samsung Elecs. Co.*, No. 2:22-CV-469-JRG, 2023 U.S. Dist. LEXIS 246491, at *4-5 (E.D. Tex. Aug. 18, 2023) (“[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.”); *Viavi Sols. Inc. v. Zhejiang Crystal-Optech Co Ltd.*, No. 2:21-CV-00378-JRG, 2022 U.S. Dist. LEXIS 205106, at *15 (E.D. Tex. Nov. 10, 2022) (denying stay pending *inter partes* review because “[i]t is the Court’s established practice to consider that motions to stay pending IPR proceedings which have not been instituted are inherently premature and should be denied as such.”); *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV-1047-WCB, 2015 U.S. Dist. LEXIS 29572, at *17 (E.D. Tex. Mar. 11, 2015) (“In this district, that is not just the majority rule; it is the universal practice. This Court’s survey of cases from the Eastern District of Texas shows that when the PTAB has not yet acted on a petition for *inter partes* review, the courts have uniformly denied motions for a stay.”).

Even if Petitioners were to move to stay post-institution, the district court is unlikely to stay the case. First, absent discretionary denial, an institution decision would not be expected until October 16, 2025, just one month before the trial is

scheduled in the parallel proceeding. Accordingly, a final decision from the Board would not be expected until October 2026 – eleven months after trial. Judge Gilstrap (the judge presiding over the parallel proceeding) routinely denies motions to stay district court litigation pending IPRs when the district court trial is scheduled before the Board’s final decision. *See, e.g., MyPort, Inc. v. Samsung Elecs. Co., Ltd.*, Case No. 2:22-cv-00114-JRG, Order, Dkt. 73 (E.D. Tex. June 13, 2023) (Ex. 2007 at 4-5 (denying a motion to stay when trial was scheduled and “the PTAB [final written] decision is not due until over two months after jury trial is set to begin”); *Solas OLED Ltd. v. Samsung Display Co., Ltd.*, Case No. 2:19-CV-00152-JRG, 2020 U.S. Dist. LEXIS 125973 (E.D. Tex. July 17, 2020) (denying a motion to stay partly because the Board’s final written decision would have been issued months after the scheduled trial); *General Access Solutions, Ltd. v. Cellco Partnership*, Case No. 2:22-cv-00394-JRG, Order, Dkt. No. 225 (E.D. Tex. May 22, 2024) (Ex. 2025 at 3) (denying a motion to stay where “the PTAB decision is not due until over six months after jury trial is set to begin”).

Judge Gilstrap considers three factors when determining whether to grant a stay pending IPR of asserted patents: (1) whether the stay will unduly prejudice the nonmoving party, (2) whether the proceedings before the court have reached an advanced stage, including whether discovery is complete and a trial date has been set, and (3) whether the stay will likely result in simplifying the case before the court.

Judge Gilstrap typically finds that the first factor weighs against a stay because any delay to trial prejudices the patent owner plaintiff. *See, e.g., Polaris Powered Techs., LLC v. Samsung Elecs. Am., Inc.*, Case No. 2:22-cv-00469-JRG, 2024 U.S. Dist. LEXIS 218301 at *6-7 (E.D. Tex. Dec. 3, 2024) (finding that the first factor weighed against a stay where plaintiff would be prejudiced by an indefinite stay while plaintiff appealed an adverse IPR final written decision to the Federal Circuit); *Croga Innovations Ltd. v. Cisco Sys.*, Case No. 2:24-CV-00065-JRG, 2025 U.S. Dist. LEXIS 71092 at *5-6 (E.D. Tex. Apr. 14, 2025) (finding that the first factor weighed against a stay where plaintiff, a non-practicing entity, would be prejudiced by a stay where the IPR final written decision was scheduled to issue four months after the scheduled trial). In the parallel proceeding here, Judge Gilstrap would likely find that this factor weighs against staying the case because Patent Owner would be prejudiced by a delay to trial, especially when the IPR final written decision is expected to occur more than 11 months after the scheduled trial date.

Judge Gilstrap typically finds that the second factor weighs against a stay if the district court litigation has reached an advanced stage of the case. Furthermore, Judge Gilstrap evaluates the stage of the case at the time the motion for stay was filed and also post motion to stay facts. *Croga Innovations Ltd. v. Cisco Sys.*, Case No. 2:24-CV-00065-JRG, 2025 U.S. Dist. LEXIS 71092 at *7 (E.D. Tex. Apr. 14, 2025). Judge Gilstrap generally finds that a district court case has reached an

advanced stage when “the deadline to substantially complete document production and exchange privilege logs has passed, the parties have exchanged and reviewed thousands of documents, including source code, and the Court has entered the Discovery Order.” *Id.* at *8. In the underlying district court case, each of these milestones occurred months ago. Ex. 2011. Furthermore, Judge Gilstrap will evaluate the stage of the case at the time the motion for stay was filed. As discussed previously, the earliest Judge Gilstrap will entertain a motion for stay is post-institution of the IPR. Should the IPR be instituted around October 16, 2025, the underlying district court litigation will have completed fact discovery, expert reports, and the pre-trial conference. *See* Ex. 2009. Indeed, the underlying district court case would be one month away from trial. *Id.* Thus, Judge Gilstrap will certainly find that the very advanced stage of the district court case weighs against a stay as to the second factor.

As to the third factor, Judge Gilstrap typically finds that this factor weighs against a stay unless the movant can show that every asserted claim has a reasonable likelihood of being invalidated. *Croga Innovations Ltd. v. Cisco Sys.*, Case No. 2:24-CV-00065-JRG, 2025 U.S. Dist. LEXIS 71092 at *8 (E.D. Tex. Apr. 14, 2025). Even if all challenged claims from each of the IPRs filed by Petitioners are instituted, Petitioners cannot show that every asserted claim has a reasonable likelihood of being invalidated because Petitioners did not challenge any asserted claims of U.S.

Patent No. 8,767,857 (and are time-barred from doing so). Judge Gilstrap denies motions to stay (and any accompanying request to sever a case and stay the severed case) if only a subset of the asserted patents have received adverse rulings in institution decisions or final written decisions. *See, e.g., Polaris Powered Techs., LLC v. Samsung Elecs. Am., Inc.*, Case No. 2:22-cv-00469-JRG, 2024 U.S. Dist. LEXIS 218301 (E.D. Tex. Dec. 3, 2024) (denying a motion to stay where only a subset of the asserted patents received an adverse final written decision); *RFCyber Corp. v. Google LLC*, Case No. 2:20-cv-00274-JRG, 2022 U.S. Dist. LEXIS 250095 (E.D. Tex. Jan. 4, 2022) (denying a motion to stay where two of the four asserted patents were instituted). For these reasons, a stay is unlikely.

B. *Fintiv* Factor 2 - The district court trial date is 11 months before the Board's projected statutory deadline.

This factor weighs heavily in favor of denying institution. "If the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*." *Fintiv*, Paper 11 at 9. Here the district court trial is scheduled to commence on November 17, 2025 (Ex. 2009 at 2.), *eleven months before* the projected deadline for the Board's final written decision on October 16, 2026.

Recently, following the Workload Memo, the Director has exercised discretion to deny institution in matters in which there were even shorter gaps

between the district court trial and the final written decision. *See Ericsson Inc. et al. v. Procomm International PTE. Ltd.*, IPR2024-01455, Paper 15 at 2 (PTAB May 16, 2025) (denying institution where “Petitioner acknowledges that a trial date in the related district court litigation will precede the projected final written decision issuance date in this proceeding by **nine months.**”) (emphasis added); *see also ARM Ltd. et al. v. Daedalus Prime LLC*, IPR2025-00207, Paper 10 at 2 (PTAB May 16, 2025) (denying institution where the projected due date for the final written decision was June 2026 and “[t]he district court’s scheduled trial date is January 26, 2026, and the ‘time-to-trial statistics suggest trial will begin . . . between March and May 2026,’” or potentially only **one month** before the final written decision).

Even before the Workload Memo, the Board found this factor favored denial in cases with less time between the trial date and the final written decision. *See AT&T Servs. Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-00997, Paper 15 at 9 (PTAB Dec. 16, 2024) (denying institution and holding that trial occurring “four to five months prior to the deadline for our final written decision, based on the scheduled trial date and median time-to trial statistics . . . weighs substantially in favor of discretionary denial”); *Ericsson Inc. v. Active Wireless Techs. LLC*, IPR2024-00886, Paper 8 at 8-9 (PTAB Nov. 12, 2024) (collecting cases); *see also EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (finding this factor weighed in favor of discretionary denial and denying institution where “the

beginning of the jury trial in the WDTX Cases is roughly one to two months before any final decision would have been due had inter partes review been instituted”); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (PTAB May 13, 2020) (finding this factor weighed in favor of discretionary denial and denying institution where the district court trial was scheduled to occur two months before the deadline for the Board to reach a final written decision).

The trial date set by the district court is a “deadline that cannot be changed without an acceptable showing of good cause,” which strongly indicates the Court intends to maintain the set trial date. Ex. 2011 at 2, 6; *see also HP Inc. v. Universal Connectivity Technologies, Inc.*, IPR2024-01428, Paper 12 at 6 (“HP Inc.”) (PTAB April 8, 2025) (“The District Court has stated that this trial date setting ‘cannot be changed without an acceptable showing of good cause.’ ... We are not persuaded by Petitioner’s unsupported argument that the trial date is speculative.”). The Court’s November 17, 2025, trial setting (just under 20 months from filing) is consistent with the Court’s median time-to-trial date of 21.6 months, which gives credibility to the Court’s entered schedule. *See id.* (showing the median time from filing to trial in civil cases in the Eastern District of Texas is 21.6 months); *HP Inc.*, Paper 12 at 6 (“The fact that the time-to-trial statistic is earlier than the trial date set by Judge Gilstrap confirms that the schedule set by the District Court is credible and should be given weight.”).

Petitioners generically dispute the firm trial date, relying on *Dish Network* to speculate that “because much can change in eight months, the current trial date does not support denial.” *See* Pet. at 90. But *Dish Network* still found that this factor only slightly avored a discretionary denial, doing so under circumstances less favorable for denial, including (i) the uncertainty of whether a scheduled trial date over nine months away would keep its date during the middle of the Covid-19 pandemic; (ii) the trial date being less than three months before the due date for the final written decision; and (iii) a pending motion to transfer. *See Dish Network v. Broadband iTV*, IPR2020-01280, Paper 17 at 15-18 (PTAB Feb. 4, 2021). None of these circumstances apply here. Indeed, *Dish Network* found that “[a] trial set to occur soon after the institution decision is fairly likely to happen prior to the Board’s final written decision, even if the trial date were postponed due to intervening circumstances.” *Id.* The trial date for the district court case has been set for November 17, 2025, which occurs soon after the institution decision date around October 16, 2025. The best that Petitioners can argue is that “[e]ach of the defendant Petitioners are entitled to separate trials, which will necessarily proceed on separate dates to be set by the court at a later time and likely spreading well into 2026.” Pet. at 89-90. But, at minimum, the first case will address issues relating to the validity of the challenged patents and involve at least three Petitioners (one defendant, and two intervenors). And, given the time-to-trial statistics in E.D. Tex., the likelihood

is that the other two defendants will follow only around a month later. Regardless, the best that Petitioners can speculate is the other trials “likely spreading well into 2026,” which remains months before the final decision here. Thus, the trial date here weighs heavily in favor of a discretionary denial.

Because trial in the parallel proceeding is scheduled to begin on November 17, 2025, eleven months before the projected deadline for the Board’s final written decision if *inter partes* review is instituted, this factor weighs in favor of denial. *See Google LLC v. Cerence Operating Co.*, IPR2024-01465, Paper 15 (“*Google-Cerence*”) (PTAB April 23, 2025) (“Because the District Court Litigation will address the issues relating to the validity of the [challenged] patent in a trial scheduled to occur several months before we would issue a final written decision, we weigh the second *Fintiv* factor as favoring discretionary denial.”).

C. *Fintiv* Factor 3 – The district court and the parties have heavily invested time and resources in the parallel proceeding.

This factor asks the Director to “consider [] the amount and type of work that the court and the parties will have completed in the parallel litigation by the time of [an] institution decision.” *See Google-Cerence*, Paper 15 at 9. It “is related to the trial date factor, in that more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more

advanced, a stay may be less likely, and instituting would lead to duplicative costs.”
Fintiv, Paper 11 at 10. This factor weighs heavily in favor of discretionary denial.

At time of this Petition, the parties had prepared and exchanged infringement contentions, invalidity contentions, initial and additional disclosures, substantial discovery and conducted 10 source code reviews. Ex. 2011 at 5-6; Ex. 2010; 2014. This weighs in favor of denial. *See Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3 (“*Motorola Solutions*”) (PTAB March 28, 2025) (holding this factor strongly favors denial because, among other things, “the parties had served extensive infringement and invalidity contentions”).

Since then, the parties to the parallel proceeding have exchanged supplemental infringement contentions five times (Ex. 2015) and supplemental invalidity contentions (Ex. 2010). The parties have also completed claim construction, having exchanged preliminary claim constructions, conducted claim construction discovery, completed claim construction briefing, and participated in the claim construction hearing on June 12, 2025. Ex. 2011 at 5-6; Ex. 2008. The parties have also invested substantial effort in discovery, including ongoing third-party discovery, which also favors denial. Ex. 2014; *see Samsung Electronics Co., Ltd. v. Evolved Wireless LLC*, IPR2021-00950, Paper 10 at 13 (“*Samsung-Evolved*”) (PTAB November 29, 2021) (denying institution and holding the investment factor weighed in favor of denial notwithstanding the fact that the district court had not

issued any substantive orders and finding “the Parties have exchanged and/or answered 138 Interrogatories, 171 Requests for Production, 79 Requests for Admission, served 30(b)(6) Deposition Notices comprising 64 topics, and exchanged over 1.3 million pages of documents (not counting source code).”). Here, discovery has been extensive in the parallel proceeding: 18 depositions, over 900,000 pages of document production, 89 interrogatories, 5 subpoenas, and 6 sets of letters rogatory. Ex. 2014; *see also Motorola Solutions*, Paper 19 at 3 (holding this factor strongly favors denial because, among other things, the parties had “conducted several depositions.”). Additionally, the parties have issued at least five third-party subpoenas for production and testimony. Ex. 2014. To date, nearly 389 pages of third-party material have been produced in responses to these subpoenas, with more expected. *Id.*

By the time of the institution decision, the parties’ and the Court’s ongoing investment in the parallel proceeding will be even more substantial. The parties will have completed fact discovery and served expert reports on July 7, 2025, served rebuttal expert reports on July 28, 2025, completed expert discovery on August 6, 2025, filed dispositive motions and *Daubert* motions by August 11, 2025, and served pretrial disclosures by September 3, 2025. Ex. 2009 at 3-4.

Given the substantial time and effort the parties and the district court have already invested in parallel litigation, and the additional investment they will make

before an institution decision is expected, this factor weighs heavily in favor of denial.

D. *Fintiv* Factor 4 – The IPR is not a “true alternative” to the parallel proceeding.

In the Memorandum regarding “Guidance on USPTO’s rescission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,’” issued by the Chief Administrative Patent Judge of the Patent Trial and Appeal Board on March 24, 2025 (hereinafter, “Guidance Memo”),² the Chief Judge stated,

[A] timely-filed *Sotera* stipulation[] (*i.e.*, a stipulation from a petitioner that, if an [*inter partes* review] or [post-grant review] is instituted, the petitioner will not pursue in district court . . . any ground raised or that could have been reasonably raised in the [*inter partes* review]/[post-grant review]) is highly relevant, but will not be dispositive by itself.

Guidance Memo, 2-3. In considering this factor, the Director should consider whether *inter partes* review would be a “true alternative” to parallel district court litigation. *See Motorola*, Paper 19 at 3-4 (Director vacating decision granting

²https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf

institution where the petitioner's "stipulation does not ensure that these [*inter partes* review] proceedings would be a 'true alternative' to the district court proceeding").

This factor weighs in favor of discretionary denial because this IPR proceeding is not a "true alternative" to the parallel proceeding. The primary references of Wright and Booth relied on in this Petition do not overlap with the references asserted in the district court case. *Compare*, Pet. at 3, with Ex. 2010 at 10-11, 24-25. Thus, the IPR proceeding cannot be a "true alternative" to the parallel proceeding because of the different primary references at issue.

Furthermore, Petitioners did not file a *Sotera* stipulation in this IPR proceeding, which further weighs in favor of discretionary denial. Petitioners allege that Exhibit 1032 is the purported *Sotera* stipulation, but Exhibit 1032 is directed to an Order regarding Ericsson's Motion for Leave to Intervene. *See* Pet. at 90. Patent Owner cannot find any *Sotera* stipulation filed in this IPR proceeding. Even if Petitioners had filed a *Sotera* stipulation, it does not ensure that these IPR proceeding would be a "true alternative" to the parallel proceeding. Indeed, as discussed below, "Petitioner's invalidity arguments in the district court are more expansive and include" system prior art and combinations of the secondary reference prior art asserted in these proceedings with unpublished system prior art, which Petitioner's stipulation is not likely to moot. *Motorola Solutions*, Paper 19 at 4. In short, this IPR

proceeding would not be a “true alternative” to the district proceeding. *See id.* at 3-4.

Even if Petitioners filed a *Sotera* stipulation, that stipulation does not ensure that this proceeding would be a “true alternative” to the district court proceeding. In an unfiled stipulation, Petitioners state that they “reserve their right to assert invalidity grounds in the Litigations **based on system art, either alone, or in combination with other prior art.** In addition, Defendants reserve the right to discuss at trial any and all prior art for purposes other than establishing invalidity of the patents-in-suit, including without limitation putting the patents-in-suit in technical or historical context in support of Defendants’ damages case.” Ex. 2027 at 2 (emphasis added).

In their Supplemental Invalidity Contentions, the Petitioners rely on at least seven different prior art systems. Ex. 2010 at 18-20. Because Petitioners reserve the right to rely upon that system art alone, and in combination with the same references in this IPR, it raises “concerns of inefficiency and the possibility of conflicting decisions,” which weighs in favor of discretionary denial. *Fintiv* at 12. Petitioner’s unfiled stipulation leaves open the possibility that the Board may reach decisions on the overlapping prior art that conflict with the district court’s decisions on combinations of system art with that overlapping prior art in the Petition. Accordingly, Petitioner’s unfiled stipulation does not ensure that this proceeding

would be a true alternative to the parallel proceedings. *Samsung Electronics Co., Ltd. v. Sionyx, LLC*, IPR2025-00064, Paper 15 (PTAB June 6, 2025) at 14-15. And further inefficiency will result because of the high likelihood that Petitioners raise system art during the district court proceeding. Accordingly, this factor weighs in favor of denial.

E. *Fintiv* Factor 5 – The Petitioners are also defendants or intervenors in the parallel proceeding.

Petitioners are indisputably either defendants or intervenors in the parallel proceeding. Accordingly, this factor weighs in favor of denying institution. *See SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 9 (PTAB April 7, 2025) (“The fact that Petitioner is also the defendant in the Litigation weighs in favor of discretionarily denying institution.”).

F. *Fintiv* Factor 6 – The weakness of the validity challenge favors exercising discretion.

The Workload Memo identifies “the strength of the unpatentability challenge” as a relevant consideration. Workload Memo, 2. This consideration favors discretionary denial because Petitioners’ patentability challenges are weak. Patent Owner’s preliminary response will identify numerous specific weaknesses in the Petition. Petitioners assert three grounds, none of which are anticipation grounds. Petitioners’ failure to identify any anticipatory art serves as an initial indication of the weaknesses of the Petition’s merits. At a minimum, the preliminary response will

demonstrate that the invalidity challenges in both Grounds 1, 2, and 3 (which address the independent claims) are particularly weak as to claim elements 1[b], 1[c], 3[b], 3[c], 5[c], 5[d], 7[c], 7[d], 9[c], 9[d], 11[c], 11[d]. Therefore, the merits of the Petitioner's patentability challenges are weak, further favoring denial of institution.

G. The Petition's heavy reliance on expert testimony favors exercising discretion.

"The extent of the petition's reliance on expert testimony" is an enumerated consideration set forth in the Workload Memo. Since the memo issued, the Office has further explained:

extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court.... As the judges have technical and legal expertise, it is not necessary for an expert to explain every aspect of the prior art. It is most helpful if an expert is providing focused testimony, for example to provide helpful context or to explain terms of art. The failure to provide focused expert testimony may weigh against institution.

FAQs for Interim Processes for PTAB Workload Management, at #21 (published Apr. 25, 2025), <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management> (last visited April 28, 2025) (hereafter, "FAQ #21").

This consideration favors discretionary denial because the Petition relies heavily on the unfocused declaration testimony of Petitioners' purported technical

expert, James Proctor, Jr. (Ex. 1026). Indeed, Mr. Proctor's declaration consists of 185 paragraphs of testimony spanning 109 pages. *See generally* Ex. 1026. The Petition extensively cites to and relies upon his testimony, including attempting to plug holes by arguing that certain features not disclosed on the relied-on references would have been obvious. *See e.g.*, Pet. at 23-24, 44-47, 52-54, 58-65, 67-73. Indeed, the word "POSITA" appears 49 times in the Petition.

Further, Mr. Proctor's declaration contains much of the same language as the Petition, even including the same annotations and color-coding used in the Petition. *Compare, e.g.*, Pet. 9-13 (Overview of the '345 Patent), *with* Ex. 1026 ¶¶ 62-68 (Overview of the '345 Patent); Pet. 14-18 (Overview of the Prior Art), *with* Ex. 1026 ¶¶ 71-76 (Overview of the Prior Art); Pet. 19-42 (Ground 1 analysis), *with* Ex. 1026 ¶¶ 77-111 (Ground 1 analysis); Pet. 42-56 (Ground 2 analysis), *with* Ex. 1026 ¶¶ 112-139 (Ground 2 analysis); Pet. 57-88 (Ground 3 analysis), *with* Ex. 1026 ¶¶ 140-182 (Ground 3 analysis). However, the Board has been skeptical of petition arguments repeated verbatim by a witness purporting to give expert testimony. *Kinetic Techs., Inc. v. Skyworks Solutions, Inc.*, IPR2014-00529, Paper 8, 14-15 (PTAB 2014) (denying institution). Such skepticism is warranted in reviewing the Petition, in light of Mr. Proctor's extensive repetition of the Petition in his declaration. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15, 19 (P.T.A.B. Aug. 24, 2022) (denying institution). The Board's resources would be

better allocated to other petitions more grounded in substance.

H. The settled expectations favor discretionary denial.

The Director may also consider the “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Memorandum at 2. Here, the ’345 Patent was filed on June 8, 2001, and issued on April 25, 2006. Petitioners Ericsson and Nokia were collectively aware of the Asserted Patents (either directly or through their families) well before the parallel district court case or this IPR was filed. Accordingly, Petitioners could have challenged the ’345 Patent when it issued. Instead, Petitioners waited until now, allowing Patent Owner’s expectations to settle. Furthermore, the ’345 Patent is near expiration, such that the PTAB should not expend its resources on a patent near its end of life.

Nokia has known of the ’345 Patent at least since U.S. Patent No. 7,268,619 (“Nokia’s ’619 Patent”; Ex. 2022) was assigned to Nokia affiliate Nokia Solutions and Networks GmbH on September 12, 2013 (or as early as 2008 when it was assigned to another Nokia affiliate). Ex. 2024. The ’345 Patent is listed as “cited by examiner” on the face of Nokia’s ’619 Patent, which issued on September 11, 2007. Ex. 2022. The examiner for Nokia’s ’619 Patent cited the ’345 Patent in the notice of allowance, mailed on June 12, 2007. Ex. 2023 at 4. While Nokia has known of the ’345 Patent at least 2013 (or perhaps 2008), Nokia did not seek to challenge the patentability of the ’345 Patent until over seventeen years later.

Ericsson has known of the '204 Patent, which is challenged in a Co-Pending IPR (IPR2025-00692), at least since the examination of Ericsson's U.S. Patent Nos. 9,660,673 ("Ericsson's '673 Patent"; Ex. 2018) and 11,265,201 ("Ericsson's '201 Patent"; Ex. 2020). The publication of the application that issued as the '204 Patent is listed as "cited by examiner" on the face of Ericsson's '673 Patent, which issued on May 23, 2017. Ex. 2018 (citing US 2015/0236731); Ex. 2026 ('204 patent showing US 2015/0236731). The examiner for Ericsson's '673 Patent cited US 2015/0236731 in the "Notice of References Cited" in the office action dated September 6, 2013. Ex. 2019 at 8. Accordingly, because of Ericsson's '673 Patent, it has known of the application that issued into the '204 Patent at least since September 6, 2016.

The '204 Patent is also listed as on the face of Ericsson's '201 Patent, which issued on March 1, 2022. Ex. 2020. The '204 Patent was submitted in an information disclosure statement and considered by the examiner on April 30, 2021. Ex. 2021. Thus, Ericsson had further knowledge of the '204 Patent via the IDS in Ericsson's '201 Patent.

Even though Ericsson knew about the '204 Patent since at least September 6, 2016 (because of the prosecution of Ericsson's '673 Patent), and even though Ericsson submitted the '204 Patent in an IDS in 2021 (during the prosecution of Ericsson's '201 Patent), Ericsson did not seek to challenge the patentability of the '204 Patent at any time prior to the Co-Pending IPRs, settling Patent Owner's expectations that Petitioner Ericsson does not dispute their patentability.

Ericsson has also known of the '561 Patent (Ex. 2028), which is another of the Asserted Patents and is challenged as Co-Pending IPR-2025-00612. Ericsson has known of the '561 Patent at least since the examination of Ericsson's patent, U.S. Patent No. 8,633,769 ("Ericsson's '769 Patent"; Ex. 2016). The '561 Patent is listed as "cited by examiner" on the face of Ericsson's '769 Patent, which issued on January 21, 2014. Ex. 2016. The examiner for Ericsson's '769 Patent cited the '561 Patent in the notice of allowance, mailed on September 12, 2013. Ex. 2017 at 4. Accordingly, Ericsson has known of the '561 Patent at least since September 12, 2013. Yet Ericsson did not seek to challenge the patentability of the '561 Patent until over eleven years later.

In these circumstances, the settled expectations of Patent Owner favors discretionary denial. *See IRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (PTAB June 6, 2025) ("Patent Owner argues that because **one of the** [five challenged] **patents** has been in force since as early as 2012 and Petitioner was aware of it as early as 2013—having cited the then-pending application that issued as the challenged patent in an Information Disclosure Statement Petitioner filed in its own patent application—settled expectations favor denial of institution. Patent Owner's argument is persuasive. Petitioner's awareness of Patent Owner's applications and failure to seek early review of the patents favors denial and outweighs the above-discussed considerations.").

IV. CONCLUSION

For the reasons above, Patent Owner respectfully requests that the Director

exercise discretion and deny institution of *inter partes* review. The district court trial is scheduled to begin one month after the date for institution decision and eleven months before a final written decision. Furthermore, Judge Gilstrap is highly unlikely to grant a stay in the underlying case. Additionally, one or more Petitioners were aware of some of the asserted patents challenged by Petitioners, but did not choose to challenge those patents until now. These facts warrant discretionary denial.

IPR2025-00727
U.S. Patent No. 7,035,345

Request for Discretionary Denial

Dated: June 16, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on June 16, 2025, a copy of Patent Owner's Brief in Support of Discretionary Denial has been served in its entirety via email on the following:

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that this document complies with the type-volume limitations set forth in 37 C.F.R. § 42.24 *et seq.* This document, excluding those portions excluded pursuant to § 42.24(a)(1), contains 6,275 words as calculated by the “Word Count” feature of Microsoft Word for Office 365, the program used in creating it.

/s/ Justin B. Kimble

Justin B. Kimble