

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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

v.

PANTECH WIRELESS, LLC,  
Patent Owner.

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U.S. Patent No. 10,764,803  
Filed: August 6, 2019  
Issued: September 1, 2020  
Inventors: Stephen G. Dick, et al.

TITLE: ENHANCED UPLINK OPERATION IN SOFT HANDOVER

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*Inter Partes* Review No. IPR2025-00756

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

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1010	3GPP Technical Specification 36.331, v10.6.0 (“TS36.331”)
1011	Shu Lin and Daniel Costello, Jr.; Error Control Coding: Fundamentals and Applications; (Excerpts) Prentice Hall, 1983 (“Lin”)
1012	Michel Mouly and Marie-Bernadette Pautet; The GSM System for Mobile Communications; 1992 (“Mouly”)
1013	Dimitri Bertsekas and Robert Gallager; Data Networks; Second Edition (Excerpts) Prentice Hall 1992 (“Bertsekas”)
1014	Regis J. “Bud” Bates; GPRS; General Packet Radio Service; (Excerpts); McGraw-Hill 2002 (“Bates”)
1015	Jhong Sam Lee and Leonard E. Miller; CDMA Systems Engineering Handbook; Artech House Publishers 1998 (“Lee”)

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1016	Harri Holma and Antti Toskala; WCDMA for UMTS; Radio Access For Third Generation Mobile Communications; John Wiley, 2000
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1026	“Albright Worried Multipatent Trials Ask Too Much Of Jurors,” Law360 (Dec. 18, 2020), at <a href="https://www.law360.com/articles/1337976/albrightworriedmultipatent-trials-ask-too-much-of-jurors">https://www.law360.com/articles/1337976/albrightworriedmultipatent-trials-ask-too-much-of-jurors</a>
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1031	Docket Navigator Statistics for Judge Schroeder in E.D. Tex.
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1036	<i>Pantech Corp. v. OnePlus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv-00038- RWS-JBB, (E.D. Tex., July 17, 2025), Dkt. No. 85, Order
1037	<i>Pantech Corp. v. OnePlus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv-00038- RWS-JBB, (E.D. Tex., July 17, 2025), Dkt. No. 86, Third Amended Docket Control Order
1038	<i>Pantech Corp. et al. v. OnePlus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv- 00038-RWS-JBB (E.D. Tex., August 20, 2025), Dkt. No. 96, OnePlus Opposed Motion to Stay Proceedings
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## I. INTRODUCTION

The instant Petition for *inter partes* review (“IPR”) of U.S. Patent No. 10,764,803 (the “’803 Patent”) should be referred to the Board because it is highly vulnerable to the presented invalidity challenges. The ’803 Patent claims were allowed after being amended to require a processor and transceiver of a wireless transmit/receive unit to perform steps, “while a primary cell is associated with a wireless network node and one or more non-primary cells are associated with the wireless network node.” EX1002, 25-32 and 49-62. The Petition explains it was a mistake to issue the ’803 Patent because this limitation of the claims is taught in Ericsson. Prior non-patent literature also demonstrates the claim features were well known and would have been obvious to one skilled in the art to implement. Correction of this material error is a salutary use of Office resources.

The ’803 Patent is one of eight patents from eight different patent families asserted in the parallel litigation. Each is directed to a diverse range of highly technical subject matter, which makes deciding their validity by jury extremely cumbersome and difficult.

There is no trial date scheduled in the parallel district court litigation, and motions to extend the current trial schedule by several months and to stay the case are pending before the district court. Petitioner has also filed a broad “*Sotera Plus*” stipulation in each case, agreeing not to raise *any* invalidity grounds under Sections

102 or 103 should the Board institute review of the '803 Patent, thereby preventing the possibility of conflicting decisions here and at the district court.

These factors have all been found persuasive—including in *AMD, American Airlines, Skullcandy, Eunsung, and Anthony Inc.*—to deny Patent Owner’s request for discretionary denial and refer the Petition to the Board, even where “settled expectations” may exist. The same result should be reached in this proceeding to “maintain consistency with discretionary decisions that the Director has already issued.” *See Interim Director Discretionary Process, Sec. I.A.*<sup>1</sup>

Here, Patent Owner has *not* developed settled expectations regarding the '803 Patent, which is particularly so in view of its 2020 issue date. Patent Owner did not itself invent the subject matter claimed in the '803 Patent but rather purchased it in 2021. As a non-practicing entity (NPE), Patent Owner has never commercialized the '803 Patent and has not shown that anyone has ever marked its products with the '803 Patent. Patent Owner chose not to assert the '803 patent in its first lawsuit against Petitioner but rather waited years to bring this suit. Moreover, no previous owner of the '803 Patent ever asserted it against any party. Particularly given the history of validity challenges to its portfolio of acquired

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<sup>1</sup> <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>

patents, any expectation Patent Owner may have had that the validity of the '803 Patent would not be challenged was shattered years ago.

Patent Owner's aggressive monetization campaign for unreasonable royalties has imposed significant burdens on manufacturers. Preventing such misuse of a patent with questionable validity serves the interests of the public.

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

### **A. Patent Owner's Request for Discretionary Denial Should Be Denied 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").

#### **1. Discretionary denial is not warranted because material errors were committed by the Office during examination**

Discretionary denial is inappropriate because the Petition establishes that the Office committed material errors during examination of the '803 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” despite the scheduled trial date preceding the expected final written decision due date by a month); *Eunsung*, 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.*, 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”).

In allowing the application that issued as the ’803 patent, the Examiner relied upon the mistaken belief that “the prior art fails to disclose wireless transmit/receive unit (WTRU), while a primary cell is associated with a wireless network node and one or more non-primary cells are associated with the wireless network node, receive a message on the primary cell, the received message including an indication of at least one of the one or more non-primary cells from which the WTRU is to receive a downlink shared channel transmission; and in response to the received message, receive and process the downlink shared channel transmission from the indicated at least one of the one or more non-primary cells.” EX1002 at 30–31. The Examiner materially erred by not applying the prior art

cited in the present petition. Had the Examiner done so, the application would not have been allowed because the references disclose not only the purportedly missing limitations but all limitations of the challenged claims, rendering them unpatentable.

For example, Ericsson discloses an “[i]ntra-Node B synchronized serving HS-DSCH cell change” procedure. EX1005, 1. In this procedure, “[t]he serving HS-DSCH cell is changed without change of the active set,” where “[t]he same Node B controls source and target HS-DSCH cells” of the “active set.” EX1005, 1. In this context, Ericsson’s “active set” refers to a set of cells controlled by and associated with the Node B. EX1003, ¶190. Accordingly, Ericsson teaches a UE undergoing a serving cell change where the source cell (i.e., primary cell) is changed to a target cell (i.e., one or more non-primary cells), both of which are included in a “active set” of cells controlled by the same Node B (i.e., wireless network node). EX1005, 1, 4-5; EX1003, ¶193.

Moreover, the Examiner relied on a mistaken priority date of the ’803 Patent in reviewing prior art during prosecution. *See* Pet. 9–12. As described in the present Petition, claim 1 of the ’803 patent recites “a primary cell is associated with a wireless network node and one or more non-primary cells are associated with the wireless network node,” and causing a WTRU to “receive configuration information for the primary cells and the one or more non-primary cells,” neither

of which were supported in the parent priority applications. *Id.* Because of the Examiner's erroneous assumption of an earlier priority date, numerous prior art documents, including the same documents Patent Owner uses to allege infringement in the related district court case (i.e., TS 36.300, TS 36.321 and TS 36.331), were not considered during prosecution.

Accordingly, because the Petition demonstrates the examiner both mistakenly assumed an earlier priority date for the '803 Patent and overlooked teachings in Ericsson and the other applied references that disclose the claimed features that the patent examiner indicated were not taught by the prior art of record, "it is an appropriate use of Office resources to review the ... error." *Taiwan Semiconductor Mfg. Co. Ltd. V. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 at 3-4 (Director September 3, 2025).

**2. The Petition presents strong merits on multiple grounds including anticipation and single-reference obviousness**

Indeed, Ericsson in view of TS 25.331 renders obvious all of the challenged claims. Pet.at 34–59. The pairing of Ericsson and TS 25.331 with Sebire (*id.* at 60–68) and of the pairing of the TS36 combination of TS36.300, TS36.321, and TS36.331 (*id.* at 21–33) further demonstrate the challenged claims would have been obvious to a POSA and should not have issued.

Under these circumstances, it is an efficient use of Board resources to address the patent challenged in this IPR even if the challenged patent has been in force for over seven years, consistent with the Director’s recent decisions in *Skullcandy, Eunsung, and Anthony Inc. Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9 at 2 (Director July 31, 2025) (“Skullcandy”) (denying DD of a nine year old patent because of material error by the examiner) *Eunsung Global Corp. v. HydraFacial LLC*, IPR2025-00445, Paper 14 at 2-3 (Director July 10, 2025) (“*Eunsung*”) (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. v. Controltec LLC*, IPR2025-00559, Paper 9 at 2 (Director July 16, 2025) (“*Anthony Inc.*”) (finding discretionary denial unwarranted of 17 and 18 year old patents because the examiner overlooked prior art); *see also 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”).

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

Discretionary denial is inappropriate here given the large number of asserted patents and the diverse, complex subject matter involved. In the parallel district court case (“*Pantech IP*”), Patent Owner asserts eight patents from eight different families concerning a different aspect of sophisticated 4G/5G wireless communication technologies. *See* EX1021, 4-6, 13, 16, 19–20, 23, 26, 29, 32, 35; EX1028, 2–4. In particular, the asserted patents are directed towards:

1. uplink operation during a “soft”/“softer” handover between Node-Bs (’803 Patent, Pet. at 6–7);
2. uplink synchronization in a multiple component carrier system (U.S. Patent No. 9,769,776; IPR2025-00720, Paper 1 at 6);
3. radio link control in wireless communication systems supporting dual connectivity (U.S. Patent No. 9,763,283; IPR2025-00637, Paper 1 at 4);
4. receipt of multi-flow data with respect to one evolved packet system bearer through a macro base station and a small base station in a wireless communication system supporting dual connectivity (U.S. Patent No. 10,863,573; IPR2025-00762, Paper 2 at 2);

5. transmission of uplink data using uplink resources based on a radio resource control message until being deactivated based upon MAC timer information (U.S. Patent No. 11,212,838; IPR2025-00763, Paper 2 at v–vii);
6. transmission and receipt of random access preamble requests and responses in a wideband radio access system (U.S. Patent No. 9,288,824; IPR2025-00783, Paper 1 at 7);
7. synchronization between a handset and an evolved NodeB when a plurality of component carriers are used (U.S. Patent. No. 8,995,372; IPR2025-00887, Paper 1 at 11); and
8. performance of muting certain radio resources during data transmission to avoid interference between neighboring cells (U.S. Patent No. 9,369,251; IPR2025-00887, Paper 1 at 10-11).

Indeed, IPR petitions were recently referred for merits consideration on sets of asserted patents with similarly diverse subject matter. *Apple Inc. v. Apex Beam Techs.*, IPR2025-00896, Paper 10, at 2-3 (Sept. 3, 2025) (“*Apex Beam*”) (denying DD of patents to “multi-antenna transmission, uplink transmission, down-link control information, uplink cancellation signaling, and failure recovery” due to diverse range of subject matter); *American Airlines, Inc. v. Intellectual Ventures I LLC*, IPR2025-00785, Paper 11 at 3 (Director Aug. 29, 2025) (“*American*

*Airlines*”) (denying DD of patents in force for about fourteen and eighteen years due to the “diverse range of subject matter” of the twelve patents spanning at least six families).

These decisions recognize it would be unreasonable to expect a jury to fully adjudicate eight patents, each hailing from a different patent family, in a single trial. Experienced district court judges have similarly recognized the difficulty of presenting multiple patents to a jury in a limited trial setting. *See, e.g.*, EX1026, 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”); EX1027, 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 ’803 Patent, in the *Pantech II* case.

**C. A Related IPR Petition Has Already Been Referred to the Board**

The petition for IPR of one of the eight patents asserted in the parallel *Pantech II* litigation has already been referred to a Board panel to consider the merits and non-discretionary considerations. IPR2025-00763 (the “’763 IPR”), Paper 4, at 1-2. The fact that a Board panel will consider the merits of a related IPR petition asserted in the same parallel litigation strongly tips the balance against discretionary denial here even if Patent Owner may have “settled expectations.”

*Advanced Micro Devices, Inc. et al. v. Concurrent Ventures, LLC et al.*, IPR2025-00478, Paper 10 at 2-3 (Director July 31, 2025) (“AMD”) (finding it is an efficient use of Board resources to address the challenged patent when another patent involved in the same parallel district court proceeding has been referred to the Board despite the challenged patent having been in force for over ten years).

In a companion IPR involving a different asserted patent, the Director granted Patent Owner’s Request for Discretionary Denial premised on “strong settled expectations.” *OnePlus Tech. (Shenzhen) Co. Ltd. v. Pantech Corp.*, IPR2025-00637 (the “’637 IPR”), Paper 17, at 2 (Director August 14, 2025). The related ’763 IPR had not been referred to the Board at the time when the DD decision of the ’637 IPR was made. Also, Petitioner did not have an opportunity to present its arguments based on *AMD*, *American Airlines*, and *Apex Beam* as those decisions were not rendered until Petitioner had already filed its opposition. Petitioner has requested Director Review to vacate the DD decision and to refer the petition in the ’637 IPR based on the materially changed circumstances. *See* ’637 IPR, Paper 18. These changed circumstances warrant denial of the request for DD in the ’637 IPR and the instant IPR. *See ARM LTD. et al. v. Daedalus Prime LLC*, IPR2025-00207, Paper 14, at 2 (Director, Aug. 6, 2025).

In addition, two other related IPRs (IPR2025-00762 and IPR2025-00720) challenging two other patents asserted in the parallel *Pantech II* litigation are also

likely to be referred to the Board. Similar to the present IPR challenge, related IPR2025-00762 challenges U.S. Patent No. 10,863,573, which has also been in force for less than five years such that there are not strong settled expectations regarding its validity.

Referral of the instant IPR to the Board will help maintain consistency with Discretionary Decisions that the Director has already issued. *See Interim Director Discretionary Process*, Sec. I.A. Further, the Board should devote resources to this IPR to ensure against inconsistent and inefficient outcomes—such as, by litigating the validity of patents asserted in the *Pantech II* litigation piecemeal in two separate tribunals under different standards.

**D. There Are Compelling Economic Interests in Preventing a Non-Practicing Entity from Using Defective Patent Claims to Holdup Implementation of Telecommunication Standards**

There are compelling economic and public policy interests favoring institution of this IPR. Patent Owner is an NPE<sup>2</sup> 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

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<sup>2</sup> *See, e.g.*, <https://portal.unifiedpatents.com/ptab/case/IPR2025-00637> (identifying Patent Owner as “NPE (Patent Assertion Entity)”); <https://ailab.exparte.com/case/ptab/IPR2025-00637/oneplus-technology-shenzhen-co-ltd-et-al-v-pantech-corporation> (similarly identifying Respondent (Patent Owner) as “NPE”).

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 acquired the patent rights to the '803 Patent, along with more than 80 other U.S. patents, through a "Patent Assignment Agreement" in 2021. *See* EX1029, 1, 3 (listed under its Application No. 16/533,320), 8–97 at 66. Patent Owner's portfolio includes numerous patents it claims are standard essential patents ("SEPs"), which must be licensed on fair, reasonable, and non-discriminatory ("FRAND") terms. *TCL Commc'n Tech. Holdings Ltd. v. Telefonaktiebolaget LM Ericsson*, 943 F.3d 1360, 1364 (Fed. Cir. 2019).

During its ongoing monetization campaign against Petitioner, Patent Owner has demanded unreasonable royalty rates that violate its FRAND obligations for its patent portfolio. *See infra*, Section III. Following its business model of asserting patents against manufacturers to extract royalties, Patent Owner has filed patent infringement actions since 2021 against a range of manufacturers, including LG Electronics Inc., ASUSTek Computer Inc., BLU Products Inc., GNJ Manufacturing Inc., CoolPad Ground Limited, Lenovo Group Ltd., Lenovo (United States) Inc.,

Motorola Mobility LLC, TCL Industries Holdings Co., Ltd., Tinno USA, Inc.,  
HMD America, Inc., and Petitioner.

The patents that Patent Owner are weaponizing in this campaign are not good patents. Although Patent Owner undoubtedly attempted to pick its best 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 Corporation et al v. LG Electronics 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 questions 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 “first-tier” patents Patent Owner asserted 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 '803 Patent—are even more vulnerable to unpatentability challenges as explained 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*)<sup>3</sup>—asserting four more patents. *See* EX1030. On the same day, Patent Owner also filed a Section 337 investigation complaint with the U.S. International Trade Commission (“ITC”), asserting the *Pantech III* patents against Petitioner and several other respondents, all of whom are cell phone manufacturers in the U.S. market. *See* EX1025, 6 (*In the Matter of Certain Mobile Cellular Communications Devices*, Inv. No. 337-TA-3835 (ITC July 2, 2025), Complaint).

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<sup>3</sup> The other four district court cases are *Pantech Corp. v. Shenzhen Tinno 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.).

Patent Owner neither makes nor sells any products and therefore does not compete in the market against Petitioner and these other manufacturers. Instead, Patent Owner evidently seeks to use the ITC proceedings and its remedy of an exclusion order as a club to bully Petitioner and other cell phone manufacturers into accepting a supra-FRAND license rate. The threat of an exclusion order tilts any negotiation concerning the patents-in-suit heavily in favor of Patent Owner and fosters an environment of patentee “holdup.” *See Apple, Inc. v. Motorola, Inc.*, 869 F.Supp.2d 901, 914 (N.D. Ill. 2012) (“[A] royalty negotiation that occurs under threat of an exclusion order may be weighted heavily in favor of the patentee in a way that is in tension with the RAND commitment . . . . [T]he threat of an exclusion order may allow the holder of a RAND-encumbered SEP to realize royalty rates that reflect patent hold-up, rather than the value of the patent relative to alternatives.”), *aff’d in relevant part*, 757 F.3d 1286 (Fed. Cir. 2014).

The Federal Circuit has held that “a party that has made an ETSI FRAND commitment must have complied with the commitment’s obligation to negotiate in good faith over a license to its SEPs before it pursues injunctive relief based on those SEPs.” *Telefonaktiebolaget LM Ericsson v. Lenovo (United States), Inc.*, 120 F.4th 864, 876 (Fed. Cir. 2024). Patent Owner has never offered Petitioner a license specifically to the patents asserted in *Pantech II* or in *Pantech III* and the ITC on any terms, let alone FRAND terms. Patent Owner instead demanded that

Petitioner license Patent Owner's *entire patent portfolio*, which includes both SEPs and non-SEPs, at a supra-FRAND rate. Following the damages retrial in *Pantech I*, the jury rejected Pantech's damages theory based on its supposed FRAND rate, awarding significantly lower damages. EX1034 at 2; EX1035 at 16. The trial record demonstrates that Patent Owner has complied with its FRAND obligations.

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. *See also* EX1024 (Federal Trade Commission, "The Evolving IP Marketplace: Aligning Patent Notice and Remedies with Competition," March 2011), at 5 ("Patent hold-up can overcompensate patentees, raise prices to consumers who lose the benefits of competition among technologies, and deter innovation by manufacturers facing the risk of hold-up.").

The PTAB plays a vital role in addressing such defective patents. The Board's institution of IPRs on all patents Patent Owner asserted against LG

Electronics Inc. precipitated a settlement, eliminating the need for a district court trial or further Board involvement.<sup>4</sup> In contrast, Patent Owner's recent *Pantech III* and ITC complaint filings are a strong indication that it does not expect to resolve its disputes with Petitioner in *Pantech II*. Therefore, the PTAB's review of the patents asserted in *Pantech II*—including the '803 Patent at issue here—would be, 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 in violation of its FRAND obligations, institution of this IPR is not only warranted but necessary to protect manufacturers, promote judicial efficiency, and uphold the integrity of the patent system.

**E. Patent Owner Has Not Established Settled Expectations Regarding the Validity of the '803 Patent**

Patent Owner has not established settled expectations regarding the '803 Patent. The '803 Patent issued on September 1, 2020, which is less than five years before Petitioner filed its Petition. Accordingly, the '803 Patent has not acquired

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<sup>4</sup> 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).

settled expectations simply based on its age. *See Cambridge Indus. 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 Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 3 (Director July 2, 2025) (same).

Moreover, Patent Owner acquired the patent rights only in 2021 (*see* EX1029, 1, 3 (listed under its Application No. 16/533,320), 66) and, according to Patent Owner, did not begin attempting to monetize the patent until July 2021. DD Req. 12. 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.D), 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 EPR 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. To the contrary, the settled expectations of the parties—Patent Owner and Petitioner—are the validity of Patent Owner's patent portfolio is deeply in question.

Additionally, Patent Owner’s assertion that Petitioner was on notice of the ’803 Patent before the filing of *Pantech II* is unsupported by any evidence. Patent Owner contends—citing its July 9, 2021 letter (EX2003)—that Petitioner has been on notice of the ’803 Patent since at least July 2021. DD Req. 12. This assertion is at best misleading. The July 9, 2021 letter merely lists the ’803 Patent as a line item in an “Exemplary List of Pantech Wireless Patents” added to the end of the letter and listing over 220 patent assets and provides no information or discussion of the ’803 Patent’s scope, coverage, or alleged standards essential nature. *See* EX2003, 10. Mere inclusion in an extensive list of patent assets does not constitute notice of infringement. *Amsted Indus. Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 187 (Fed. Cir. 1994) (“notice must be of ‘the infringement,’ not merely notice of the patent's existence or ownership”); *see Maxell, Ltd. v. Apple Inc.*, No. 5:19-CV-00036-RWS, at 9 (E.D. Tex. Mar. 20, 2021), Dkt. No. 697 (Order) (finding that a patent within a list that did not tie the patent to specific claims or specific products did not constitute actual notice).

The Director should reject Patent Owner’s claim that there are strong settled expectations because the ’803 Patent “is a standard essential patent (‘SEP’).” DD Req. 11. As an initial matter, the inclusion of any technology in the 3GPP standard is not predicated on it being new or nonobvious or otherwise an innovation over the prior art. Rather, “[w]hen a technology is incorporated into a standard, it is

typically chosen from among different options. Once incorporated and widely adopted, that technology is not always used because it is the best or the only option; it is used because its use is necessary to comply with the standard.”

*Ericsson, Inc. v. D-Link Systems, Inc.*, 773 F.3d 1201, 1233 (Fed. Cir. 2014).

Furthermore, Patent Owner cannot rely on whatever SEP status the '803 Patent may have to establish “settled expectations” when it has violated its FRAND obligations in its monetization campaign.

Patent Owner’s suggestion that Petitioner should have filed IPRs earlier after receiving its purported 2021 licensing demand is misplaced. DD Req. 12–13.

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 many 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 '803 Patent in *Pantech I* filed in 2022. Until Patent Owner filed *Pantech II* in March 2024—including the '803 Patent—Petitioner had no reason to believe the '803 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.

Therefore, Patent Owner has not established strong settled expectations that favor discretionary denial of the '803 Patent.

**F. Patent Owner's Other *Fintiv* Arguments Are Unavailing**

**1. Factor 1: Petitioner has requested a stay that is required to be granted by statute**

Petitioner has filed a motion for a stay of the parallel *Pantech II* litigation based on Patent Owner's recent ITC complaint. Given the overlap of issues and the presence of two patents from the same family in the ITC as those asserted in *Pantech II* (compare generally EX1025 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). Petitioner also intends to seek a stay after IPR 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). This also supports the likelihood of staying *Pantech II* after institution here.

Patent Owner’s accusation that Petitioner engaged in “dilatory tactics” lacks merit and is premised on purely attorney argument. DD Req. 5. The parties mutually agreed to stay *Pantech II* pending resolution of Patent Owner’s standing, which the district 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). Thus, this factor weighs against denial.

**2. Factor 2: The FWD is likely to issue before the actual trial date in the parallel district court litigation**

There is currently no trial date set in the parallel litigation. EX 1037, 1 (trial date is “TBD”). The district court, on July 17, 2025, *sua sponte*, extended the pretrial conference to April 28, 2026, (*id.*), and ordered that “jury selection and trial date will now be set following the pretrial conference.” EX1036.

The district court explained that the adjustments are intended to resolve issues before trial to ensure trial presentations are fully developed and efficiently delivered. *Id.* This is understandable, given that the litigation involves eight patents from eight different families, each relating to distinct aspects of sophisticated 4G/5G technologies. It is highly unlikely that the district court will be able to

adjudicate all the complex issues involving these eight patents in a single trial. Indeed, it is more likely that multiple trials will be needed to try all eight patents to avoid jury confusion and overload, and to ensure that due process is respected by allowing sufficient time for each patent to be adjudicated.

Patent Owner contends that the trial will take place “shortly after the pretrial conference.” DD Req. 4. This is pure speculation. To the contrary, Judge Schroeder’s median time-to-trial of 30 months—which, accounting for the more than three-month stay, places the trial no earlier than mid-December 2026, and more likely in early 2027 in view of year-end holidays. EX1031 at 2; *see also* EX1032, 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). Conversely, the Eastern District of Texas’s median-time-to-trial data (EX2002, 35)

cited by Patent Owner is inapplicable to the *Pantech II* litigation because it would result in a trial date (January 2026) that falls before the scheduled pretrial conference date (April 28, 2026). DD. Req. 6.

Given that the institution decision in this IPR is due by December 12, 2025, the FWD is likely to issue before the actual trial date when considering Judge Schroeder's median time-to-trial. EX1031, 2. In addition, the very real possibility of a stay being entered in *Pantech II* further undermines the certainty of the 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* EX1033 (first jury verdict dated April 1, 2024) *with* EX1034 (final judgement dated January 23, 2025).

Even if the Director considers the possibility that the trial may occur before the projected FWD date, 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.1), 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 an earlier trial date in view of material Office error); *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at 3 (Director July 16, 2025) (same); *Tesla, Inc. v. Intellectual Ventures II*, 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); *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00531, Paper 10 at 2–3 (finding that Petitioner’s arguments that these factors tip the balance against discretionary denial are persuasive even with an earlier trial date and the patent being in force for about 10 years).

Since no trial is scheduled and Petitioner has sought a stay that is required by statute, trial is unlikely to occur before a final written decision would issue in this IPR. Under *Fintiv* factor 2, these facts weigh heavily against discretionary denial. See *RØDE Microphones LLC v. Zaxcom, Inc.*, IPR2025-00557, Paper 11 at 2 (Director July 17, 2025).

**3. Factor 3: The Most Burdensome Work Remains in the Parallel Proceeding, and Petitioner diligently filed the instant Petition**

Because *Pantech II* was stayed for over three months soon after its inception, the investment has not been substantial. By the anticipated date of an institution decision (by December 2025), OnePlus expects that no dispositive or

pretrial motions will have been filed, given its pending motion to stay the litigation. *See* EX1038. It is not clear whether either fact or expert discovery will be closed by December 2025. The current stage of the case does not suggest significant investment—particularly where (i) fact discovery does not involve substantive rulings on the patents-in-suit, (ii) Patent Owner’s discovery responses largely duplicate those from the earlier *Pantech I* case, and (iii) dispositive motions and pre-trial briefing will not have been filed. *See Cywee Grp. Ltd. v. Samsung Elecs. Co.*, 2019 WL 11023976, at \*6 (E.D. Tex. Feb. 14, 2019) (“[T]he most burdensome parts of the case—filing and responding to pretrial motions, preparing for trial, going through the trial process, and engaging in post-trial motions practice—all lie in the future[.]”). Moreover, no depositions have been taken, and the *Markman* ruling does *not* impact the IPR, as the Petition does not turn on claim construction. *See* Pet. 13. Indeed, the *Pantech II* court itself recently recognized that the case is at an “early stage.” EX1039 (Aug. 27, 2025 Magistrate Judge Report and Recommendation), 22.

Further, Patent Owner’s claim that Petitioner “waited until the last minute” to file this IPR is meritless. DD Req. 6. *See Snap Inc. v. SRK Tech.*, IPR2020-00820, Paper 15 at 12-13 (P.T.A.B. Oct. 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 to resolve a close issue as to whether Patent Owner has a cognizable interest in a large swath of its patent portfolio.

Under *Fintiv* factor 3, the facts here weigh heavily against discretionary denial as the most burdensome parts of the case lie in the future.

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

There is no risk of duplicative work here. Patent Owner mischaracterizes Petitioner’s stipulation (EX1023) as merely “a *Sotera* stipulation.” DD Req. 9. 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 ’803 Patent” if this IPR is instituted. EX1023. This stipulation is both broader and more straightforward than the *Sotera-plus* stipulations found by the Director to weigh against discretionary denial in *Tesla* and *Stratasys*. *Tesla*, IPR2025-00217, Paper 9 at 2, EX1067 (*Sotera-plus* stipulation); *Stratasys*, IPR2025-00531, Paper 10 at 3, EX1033 (*Sotera-plus* stipulation). Petitioner’s stipulation that, if the Board institutes review, it will withdraw all §102 and §103 challenges regarding the ’803 patent entirely in *Pantech II* ensures that this IPR serves as a true alternative to district court litigation. *See Motorola Sols. Inc. v. Stellar, LLC*, IPR2024-01205,

Paper 19 at 3–4 (P.T.A.B. March 28, 2025). This stipulation fully eliminates any concern of duplication between this proceeding and *Pantech II*.

Patent Owner’s arguments regarding adding Guangdong OPPO Mobile Telecommunications Corp., Ltd. (“OPPO”) as a party in *Pantech II* are purely speculative. DD Req. 9. 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.

Accordingly, *Fintiv* factor 4 weighs strongly against discretionary denial. Institution is a practical, efficient, and non-duplicative alternative to the district court litigation, and Patent Owner’s request for DD should be refused on this basis alone. *See Tesla*, IPR2025-00217, Paper 9 at 2-3.

**5. 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*.

**6. 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. *See* DD Req. 10–12.

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.* at 10. 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.D. Further, because the IPR petition relating to another of the patents asserted in the parallel *Pantech II* litigation has already been referred for consideration on the merits, the Board should devote resources to this IPR to avoid inconsistent and inefficient outcomes that may occur by litigating validity of the asserted patents piecemeal in two separate tribunals under different standards. Accordingly, *Fintiv* factor 6 weighs strongly against discretionary denial.

### **III. 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. 12–16.<sup>5</sup> Beginning in July 2021, Patent Owner demanded that Petitioner engage in negotiations for a license to a patent portfolio including over 1,400 patents. Petitioner neither needs nor wants a license for the entire portfolio. Patent Owner has never offered Petitioner a license to the ’803 Patent by itself.

Petitioner, for its part, responded to Patent Owner’s licensing demands by requesting details regarding Patent Owner’s infringement allegations and voicing 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 litigate on a small subset of patents in serial litigation.

**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 of the parties’ conduct” and its self-serving contentions that it engaged in “good-faith efforts” (DD Req. 13) ignore

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<sup>5</sup> 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. 12–16.

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.

Patent Owner relies upon the 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. EX1034 at 2; EX1035 at 16 (the Court rejecting enhancement because “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”**

The unreasonableness of Patent Owners’ licensing demands is evident in view of the jury’s verdict in the re-trial 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”).

**D. Patent Owner’s Conduct Here Should Not Be Rewarded**

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. 13. In reality, the district court in *Pantech I* **granted** judgment as 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. 14-15. This is untrue. As noted above, the district court found that Petitioner’s 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.

#### IV. CONCLUSION

Petitioner respectfully requests that the Director deny Patent Owner's DD request and instead refer this Petition to a merits panel for consideration.

Respectfully submitted,

The logo for Leydig, featuring the word "Leydig" in a bold, sans-serif font. The letter "i" in "Leydig" has a small blue star above it.

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Date: September 12, 2025

**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 7,772 words, excluding the parts exempted by § 42.24.

/s/ Wesley O. Mueller

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## CERTIFICATE OF SERVICE

I hereby certify that on September 12, 2025, true and correct copies of Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and accompanying Exhibits were served in their entireties by email to Patent Owner's counsel of record at the following email addresses:

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