

Case No. IPR 2025-00875
U.S. Patent No. 9,940,972 B2

Request for Discretionary Denial

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC

Petitioner,

v.

CELLULAR SOUTH, INC.

Patent Owner.

Case No. IPR2025-00875

U.S. Patent No. 9,940,972

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

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EXHIBIT LIST

Exhibit No.	Description
2001	U.S. Patent No. 9,940,972
2002	U.S. Patent No. 10,218,954
2003	U.S. Patent No. 11,126,853
2004	Article, Vū Digital Wins Coveted TMC Communications Solutions 2015 Product of the Year Award
2005	Article, NAB Show Unveils Final 10 Participants Selected for SPROCKIT 2015
2006	Notice of References Cited in U.S. Patent Application No. 15/444,054 (Oct. 30, 2019)
2007	Information Disclosure Statement by Applicant in U.S. Patent Application No. 17/423,623 (July 20, 2021)
2008	CSI's Complaint for Patent Infringement against Google in <i>Cellular South, Inc. v. Google, LLC</i> , Case No. 6:24-cv-00245 (W.D. Tex. May 9, 2024)
2009	Proof of Service of Complaint
2010	Joint Case Management and Pretrial Order as Modified in <i>Cellular South, Inc. v. Google, LLC</i> , Case No. 4:25-cv-01487-YGR (N.D. Cal.) Dkt. No. 102, August 5, 2025
2011	Transcript of Conference held July 7, 2025 in <i>Cellular South, Inc. v. Google, LLC</i> , Case No. 4:25-cv-01487-YGR (N.D. Cal.) Dkt. No. 100 July 21, 2025

Exhibit No.	Description
2012	Preliminary Infringement Contentions in <i>Cellular South, Inc. v. Google, LLC</i> , Case No. 6:24-cv-00245 (W.D. Tex.) (served Dec. 13, 2024)
2013	Comparison of portions of Paper 2 with Ex. 1002

I. INTRODUCTION

Pursuant to the “Interim Processes for PTAB Workload Management” (“Workload Memo”) issued March 26, 2025,¹ Patent Owner Cellular South, Inc. (“CSI” or “Patent Owner”) respectfully requests that the Director exercise discretion and deny institution of Google LLC’s (“Google”) *inter partes* review petition. *See* 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 “[t]he strength of the unpatentability challenge,” “[t]he 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 at 2-3. Given the circumstances presented here, discretionary denial is warranted based on these and other considerations.

¹ <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>.

Here, Petitioner and Patent Owner are already involved in a litigation in the Northern District of California. That case, which involves the same patents and same claims as in this petition and others filed by Petitioner, has been pending for over fifteen months. *See* IPR2025-00875; IPR2025-00876; IPR2025-00877. Yet Petitioner waited until the very last day to file its petition. In particular, denial is warranted here because Petitioner has been aware of Patent Owner's patents and Patent's Owner's technology and products for nearly a decade. Moreover, the petition is weak on the merits. The petition relies solely on obviousness grounds, which each rely heavily on conclusory expert testimony that merely parrots the petition. Accordingly, the Petition is not a good use of the Board's time and resources, and discretionary denial is warranted.

II. BACKGROUND

A. The Technology and the Patents

Patent Owner is a diversified telecommunications and technology company that focuses on delivering connectivity and technology solutions to advance the field and its community. While Patent Owner is a relatively small company compared to its competitors in the telecommunications industry, it has always been an innovator. For example, Patent Owner has worked to diversify its product offerings to remain innovative and competitive in the telecommunications and technology marketplace.

Through one of these efforts, Patent Owner, through its subsidiary Vu Digital, created and offered “Video-to-Data” (or “V2D”), a cloud-based digital profiling and analytics system that could scan and turn video into searchable data faster than the real-time viewing of the video by using multiple servers that run simultaneously and in parallel.

V2D breaks down a video frame-by-frame and identifies the objects—for example, text, audio, images, faces, locations, logos—within each frame. V2D then creates a chronological record of all the objects identified within the video. V2D was a transformative product that made video content as easy to search as text, thereby providing users with unprecedented video classification and clustering capabilities, as well as significantly enhanced search engine indexing, content personalization, and targeted advertising capabilities.

The applications for V2D are far reaching. V2D could be an incredibly useful technology for video data processing and content personalization. For example, V2D could be used by law enforcement to process body camera footage which was becoming more widely adopted.

Patent Owner launched its V2D product in May 2015. Mere months later, Patent Owner’s V2D product was recognized by TCM—a global integrated media conglomerate and leading source of news and information for the communications

and technology industries worldwide—as the “best-of-the-best technology solutions available on the market today.” V2D received TCM’s coveted Communications Solutions 2015 Product of the Year Award that recognizes exceptional voice, data, and video communications products and services. (Ex. 2004).

Patent Owner was also selected in 2015 to be part of the National Association of Broadcasters’ year-long SPROCKIT accelerator program for innovative startups in media and entertainment. (Ex. 2005). SPROCKIT is a global innovation platform created to help large media, entertainment, and technology companies meet emerging tech start-ups to fast-track investment, acquisition, and partnerships between the two groups on new products and services. Petitioner is a corporate partner of SPROCKIT. *Id.*

SPROCKIT Sync is an invitation-only event put on three times a year by SPROCKIT that includes a series of private meetings between selected startups and corporate players in the media and entertainment industry. Following the launch of its V2D product, Patent Owner was invited to attend the SPROCKIT Sync conference that was held on June 18, 2015 at Google Tech Corners in Sunnyvale, California. There, Patent Owner presented its then “patent pending” V2D technology at the conference. Google was one of the corporate partners for this event.

Patent Owner protects its intellectual property. As is relevant here, Patent Owner is the assignee of three patents related to its V2D technology: U.S. Patent Nos. 9,940,972 (“the ’972 patent”) (Ex. 2001), 10,218,954 (“the ’954 patent”) (Ex. 2002), and 11,126,853 (“the ’853 patent”) (Ex. 2003), each entitled “Video to data.” The ’972 patent and ’954 patent are related patents, with the ’954 patent being a continuation of the ’972 patent. The ’853 patent, while not related, shares some inventors and similar technology with the ’972 patent and the ’954 patent. At a high level, these patents are directed to an improvement in the functionality of machine learned video recognition and classification systems, particularly with regard to specific techniques for improving the accuracy of predictions made using image, audio, text, and other video data.

Beyond being aware of Patent Owner’s technology at least from its involvement with SPROCKIT, Petitioner is also aware of Patent Owner’s patents, including these patents. On October 30, 2019, U.S. Patent No. 10,204,274 (parent of the ’853 patent) was one of six references cited by the examiner in Petitioner’s U.S. Patent Application No. 15/444,054. (Ex. 2006). And on July 20, 2021, the ’954 patent (child to the ’972 patent) was one of seven references cited in an Information Disclosure Statement filed by Petitioner in U.S. Patent Application No. 17/423,623. (Ex. 2007).

B. The Parallel District Court Litigation

On May 9, 2024, Patent Owner filed a complaint against Petitioner for infringement of the '972 patent, the '954 patent, and the '853 patent in the Western District of Texas. (Ex. 2008, Ex. 2009). Petitioner moved to transfer the case to the Northern District of California. On February 12, 2025, the court in the Western District of Texas granted Google's Motion to Transfer Venue to the Northern District of California.

Since the initial filing, Patent Owner has provided its infringement contentions, the parties have fully briefed motions to dismiss² and transfer venue. Since moving to the Northern District of California, case deadlines have been set, with trial scheduled for March 15, 2027. (Ex. 2010). Under that schedule, by the time the Institution Decision is due, the parties will be deep into fact discovery, having exchanged source code, amended infringement contentions, and invalidity contentions, as well as beginning the claim construction process. *Id.* Petitioner has not filed a motion to stay the district court litigation.

² Google's Motion to Dismiss was mooted by the later venue transfer and Google did not refile its motion in the Northern District of California.

On May 10, 2025—the last possible day allowed under § 315(b)—Petitioner filed this petition. Petitioner also filed IPRs challenging the '954 patent and the '853 patent. *See* IPR2025-00876; IPR2025-00877.

III. Discretionary Denial Is Warranted

“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016); 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.”). The Director may deny institution of an IPR when there is a parallel district court proceeding under § 314(a). *See, e.g., Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 3 (P.T.A.B. Mar. 20, 2020) (“*Fintiv*”) (precedential, designated May 5, 2020); *NHK Spring Co. v. Intri-Plex Techs. Inc.*, IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018) (precedential, designated May 7, 2019); *Intel Corp. v. VLSI Tech. LLC*, IPR2019-01192, Paper 15 at 11 (P.T.A.B. 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.”).

A. *Fintiv* Factors Favor Discretionary Denial

The Director frequently evaluates the following six *Fintiv* factors in determining whether to exercise their discretion to deny institution:

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. As discussed below, these factors favor discretionary denial when weighed together.

1. *Fintiv* Factor 1 – Neither party has sought a stay

No stay has been granted and neither party has asked for one. Further, Patent Owner does not intend to move for a stay. This factor is therefore neutral. *See Formycon Ag v. Regeneron Pharms., Inc.*, IPR2025-00233, 2025 WL 1558889, at *5 (P.T.A.B. June 2, 2025) (“No stay has been granted and neither party has asked for one. Accordingly, this factor is neutral.”).

Petitioner may argue that the district court is likely to grant a stay. However, as no such motion has even been filed, speculation is not warranted. *See, e.g., Phison Electronics Corporation v. Vervain, LLC*, IPR2025-00212, 2025 WL 1518096, at *4 (P.T.A.B. May 28, 2025) (“We decline to speculate on whether the district court would enter a stay if *inter partes* review were granted in this case.”); *Canadian Solar Inc. v. Maxeon Solar Pte. Ltd.*, IPR2024-01194, 2025 WL 290559, at *12 (P.T.A.B. Jan. 24, 2025) (“Each party offers data regarding the number of stays granted and denied by Judge Gilstrap in support of their speculation about how Judge Gilstrap would rule on a motion to stay should one be filed We, however, decline to speculate on how Judge Gilstrap may rule on a future motion for a stay should one be filed.”); *Nokia of Am. Corp. v. Wireless All. LLC*, IPR2024-00619, 2024 WL 4183018, at *4 (P.T.A.B. Sept. 13, 2024) (“Although Patent Owner is likely correct that no stay would be granted even if requested at this late date, we decline to speculate as to whether the district court would grant a stay if requested.”). This is particularly so here, where the district court has expressed that the situation could be “complicated” if not all of the IPRs are instituted. (Ex. 2011 at 4:17-20).

2. *Fintiv* Factor 2 – The district court trial date is only three months after the Board’s projected statutory deadline

Trial in the district court case is set for March 15, 2027. (Ex. 2010). The projected deadline for the Board to issue its final written decision is December 16,

2026, which is only three months before the trial date. The proximity of these dates renders this factor neutral. *Fintiv*, Paper 11 at 9 (“If the court’s trial date is at or around the same time as the projected statutory deadline or even significantly after the projected statutory deadline, the decision whether to institute will likely implicate other factors.”).

Moreover, this factor is not dispositive, and the Director regularly exercises discretion under 35 U.S.C. § 314(a) to deny petitions even where trial is set for or is likely after the final written decision. *See, e.g., IRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, 2025 WL 1605274, at *1 (P.T.A.B. June 6, 2025) (“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.”); *Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (P.T.A.B. July 31, 2025) (finding that “Patent Owner’s strong settled expectations tip the balance in favor of discretionary denial” even where the parallel district court proceeding involving Petitioner and Patent Owner has been stayed”); *Smartsky Networks LLC v. Gogo Business Aviation LLC*, IPR 2025-00672, Paper 10 at 2 (P.T.A.B. July 31, 2025) (exercising discretionary denial where the final written decision was due nearly five months before the district court’s schedule trial date because “the Office is disinclined to disturb the strong settled expectations of Patent

Owner”); *Samsung Bioepis Co., Ltd. v. Regeneron Pharms., Inc.*, IPR2025-00176, 2025 WL 1561086, at *10 (P.T.A.B. June 2, 2025).

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

This factor requires considering “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9. Although the Northern District of California litigation is just beginning, the parties were actively litigating in the Western District of Texas before Google’s Motion to Transfer Venue was granted. Specifically, the parties had fully briefed Google’s Motion to Dismiss, served initial disclosures, and CSI had served detailed infringement contentions. And by the time the Institution Decision is due, the parties will be deep into fact discovery, having exchanged source code, discovery, amended infringement contentions, and invalidity contentions, as well as beginning the claim construction process. (Ex. 2010).

Further, this factor takes into account whether the Petitioner “filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted.” *US Venture Inc v. Sunoco Partners Marketing & Terminals LP*, IPR2020-00728, Paper 10 at *10 (Oct. 1, 2020). “If, however, the evidence shows that the petitioner

did not file the petition expeditiously,” this has favored denial of institution. *Id.* Here, Petitioner did not file its petition expeditiously. Instead of filing the petition once it was aware of Patent Owner’s claims, Petitioner waited until the very last day to file its petition. *Compare* Ex. 2009 (complaint served May 10, 2024) *with* Paper 2 (petition filed May 10, 2025). And Petitioner cannot justify its delay, waiting until May 2025 to file the petition. Petitioner has known of or should have known of the ’972 patent since at least July 20, 2021, when it cited the child patent in an Information Disclosure Statement. (*See* Section III.A.6.a below). Further, Petitioner has known of the specific asserted claims since at least December 13, 2024, when Patent Owner served its infringement contentions in the district court case. (Ex. 2012). This factor therefore favors denial of institution. *See US Venture Inc v. Sunoco Partners Marketing & Terminals LP*, IPR2020-00728, Paper 10 at *10-11 (Oct. 1, 2020) (finding that “the evidence showing that Petitioner did not file the petition expeditiously” favors denial where Petitioner waited approximately a year to file petition); *Formycon Ag v. Regeneron Pharms., Inc.*, IPR2025-00233, 2025 WL 1558889, at *7 (P.T.A.B. June 2, 2025) (“Petitioner was aware of the particular claims being asserted against it as early as February 2024 and could have filed a Petition challenging them far earlier than it did. Petitioner’s delay in doing so is another fact in favor of denial.”).

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

“This factor evaluates ‘concerns of inefficiency and the possibility of conflicting decisions’ when substantially the same claims, challenges, arguments, and evidence are submitted in both the inter partes review proceeding and the parallel proceeding.” *Innoscence Am., Inc. v. Infineon Techs. Americas Corp.*, IPR2025-00010, 2025 WL 1421087, at *6 (P.T.A.B. May 16, 2025).

This factor weighs in favor of discretionary denial. Here, there is complete overlap of claims. Petitioner has challenged every claim of the ’972 patent, and Patent Owner has asserted every claim of the ’972 patent in its infringement contentions.³ (Compare Ex. 2012 with Paper 2). Moreover, the petitions related to

³ While Petitioner has not yet served invalidity contentions, it is expected that Petitioner will rely heavily on the same references from the IPR in the district court. To the extent that Petitioner chooses not to rely heavily on such references in the district court, it is clear that Petitioner would be engaging in gamesmanship and such act would render Petitioner’s stipulation toothless. Moreover, Petitioner’s assertion that it “reserves the right to pursue any grounds of invalidity, including but not limited to the grounds raised or that reasonably could have been

the district court litigation rely on overlapping references. For example, IPR 2025-00875 (this IPR) and IPR2025-00876, which deal with related patents, both rely heavily on the Fontana and Lau references. *Compare* IPR 2025-00875, Paper 2 (all Grounds) *with* IPR2025-00876, Paper 2 (Grounds 1 and 2). And IPR2025-00876 and IPR2025-00877 both rely heavily on the Kritt reference. *Compare* IPR2025-00876, Paper 2 (all Grounds) *with* IPR2025-00877 (all Grounds). Thus, if any of the IPRs are not instituted, it would likely result in a scenario where both the Board and the district court are deciding the same central issues based on the same evidence, duplicating efforts and resulting in the risk of inconsistent results. This too weighs in favor of discretionary denial.

Further, the petition is not a “true alternative” to the parallel district court litigation. Petitioner has not submitted a *Sotera* stipulation, but instead appears to limit its stipulation to only the prior art discussed in the IPR: “Petitioner hereby stipulates that if this IPR is instituted, then Petitioner will not pursue in the related pending litigation the specific grounds of invalidity that were raised or that

raised in this IPR, in the related pending litigation” (Paper 2 at 3) strongly suggests that Petitioner intends to rely on the same art in the district court litigation that it relied on in the petition.

reasonably could have been raised under 35 U.S.C. §§ 102 or 103 **on the basis of prior art patents or printed publications in this IPR.**” (Paper 2 at 3 (emphasis added)). This *Sand Revolution*-type stipulation leaves the door open for Petitioner to try to pursue different prior art at trial against the same claims as it challenges in the petition. *See Nokia of Am. Corp. v. Wireless All. LLC*, IPR2024-00619, 2024 WL 4183018, at *5 (P.T.A.B. Sept. 13, 2024) (“Petitioner’s stipulation not to pursue only the specific grounds in the Petition leaves open the possibility of duplication of efforts.”). “The breadth of the stipulation affects the weight given in the discretionary denial analysis. . . . [A] petitioner stipulating not to pursue the ‘same grounds’ presented in a petition only *marginally* favors not exercising [] discretion to deny institution.” *Hanwha Sols. Corp. v. Maxeon Solar Pte. Ltd.*, IPR2024-01199, 2025 WL 634837, at *7 (P.T.A.B. Feb. 26, 2025) (emphasis in original). As a result, Google’s petition is not a true alternative to the district court litigation.

On balance, this factor weighs in favor of discretionary denial, as there is complete overlap of claims and Petitioner’s narrow stipulation does not achieve the goals of avoiding duplication.

5. *Fintiv* Factor 5 – The Petitioner is also the defendant in the parallel proceeding

Petitioner does not and cannot dispute it is the defendant in the parallel proceeding. Paper 2 at 1 (“Petitioner was served on May 10, 2024.”). Accordingly,

this factor weighs in favor of denying institution. “The fact that Petitioner is also the defendant in the Litigation weighs in favor of discretionarily denying institution.” *SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 9 (P.T.A.B. April 7, 2025).

6. *Fintiv* Factor 6 – Other considerations favor denial

The Workload Memo states that the Director will consider “all relevant considerations” when determining whether discretionary denial is warranted. Workload Memo at 2-3. These considerations include without limitation:

- Settled expectations of the parties, such as the length of time the claims have been in force;
- The strength of the unpatentability challenge; and
- The extent of the petition’s reliance on expert testimony.

(Id.)

Discretionary denial is warranted here based on these considerations.

a. The parties’ settled expectations favor discretionary denial

The Director may consider the “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Workload Memo at 2. Here, the provisional application leading to the ’972 patent was filed on August 15, 2013, the application was published on February 7, 2014, and the patent issued on April 10,

2018 (over seven years ago). (Ex. 2001.) Accordingly, Petitioner could have challenged the '972 patent when it issued. Instead, despite knowing of the patent family, Petitioner waited until the filing deadline,⁴ allowing Patent Owner's expectations to settle. *See Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (P.T.A.B. July 31, 2025) ("the challenged patent has been in force for over six years, creating strong settled expectations").

Further, Petitioner has known of or should have known⁵ of the '972 patent since at least July 20, 2021. The '954 patent,⁶ which is a continuation of the '972 patent (Ex. 2002), was one of seven references cited in an Information Disclosure Statement filed by Petitioner in U.S. Patent Application No. 17/423,623. (Ex. 2007).

⁴ Patent Owner served the district court case on May 10, 2024. (Ex. 2009).

Petitioner filed this Petition on May 10, 2025. (*See* Paper 2).

⁵ Patent Owner's patent applications are available to the public. "As such, actual notice of a patent or of possible infringement is not necessary to create settled expectations." *Dabico Airport Sols. Inc. v. Axa Power Aps*, IPR2025-00408, 2025 WL 1710857, at *1 (P.T.A.B. June 18, 2025).

⁶ Google is also challenging the patentability of the '954 patent. *See* IPR2025-00876.

Moreover, Petitioner has been aware of Patent Owner’s technology since at least 2015. Patent Owner launched its “Video-to-Data” (or “V2D”) product in May 2015. This product was recognized by TCM—a global integrated media conglomerate and leading source of news and information for the communications and technology industries worldwide—as the “best-of-the-best technology solutions available on the market today.” (Ex. 2004). Patent Owner was also selected in 2015 to be part of the National Association of Broadcasters’ year-long SPROCKIT accelerator program for innovative startups in media and entertainment. (Ex. 2005). Petitioner was a corporate partner of SPROCKIT. *Id.* SPROCKIT is a global innovation platform created to help large media, entertainment, and technology companies meet with emerging tech start-ups to fast-track investment, acquisition, and partnerships between the two groups on new products and services. On June 18, 2015, Petitioner presented its then “patent pending” technology at the SPROCKIT Sync conference held at Google Tech Corners in Sunnyvale, California. (*See* Ex. 2008 at ¶ 24.) Accordingly, Petitioner was aware that Patent Owner was operating in this technology space, counseling towards discretionary denial. *See Murata Manufacturing Co. v. Georgia Tech Research Corp.*, IPR2025-00383, IPR2025-00384, Paper 13 at 2-3 (P.T.A.B. July 29, 2025) (exercising discretionary denial where “Petitioner was aware that Patent Owner was involved in the same technology

space for a significant amount of time before filing its Petition challenging Patent Owner's patent.”).

Yet Petitioner did not seek to challenge the patentability of the '972 patent at any time prior to filing this petition, settling Patent Owner's expectations.

In these circumstances, the settled expectations of Patent Owner favors discretionary denial. Indeed, the situation here is similar to the situation in *IRhythm Techs. IRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, 2025 WL 1605274 (P.T.A.B. June 6, 2025). There, the projected date for the final written decision was over six months **before** the district court's trial date. *Id.* at *1. Nevertheless, the petition was denied under 35 U.S.C. § 314(a) because the Petitioner was aware of the challenged patent and cited the then-pending application that issued as the challenged patent in an Information Disclosure Statement that Petitioner filed in its own patent application. *Id.* The Director found that “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,” including the fact that trial was set for over six months after the projected final written decision due date. *Id.* (emphasis added).

Here, Google has been aware of Patent Owner's patents since at least July 2021 and aware of Patent Owner's video-to-data technology since at least 2015, yet

did not seek early review of the patents. Rather, Google waited until the very last moment to file this petition. And the final written decision is due only three months—as opposed to the over six months in *IRhythm Techs.*—before the trial date. *See also Smartsky Networks LLC v. Gogo Business Aviation LLC*, IPR 2025-00672, Paper 10 at 2 (P.T.A.B. July 31, 2025) (exercising discretionary denial where the final written decision was due nearly five months before the district court’s schedule trial date because “the Office is disinclined to disturb the strong settled expectations of Patent Owner”). Therefore, this factor weighs heavily in favor of discretionary denial.

b. The weakness of Petitioner’s arguments and the Petition’s heavy reliance on expert testimony favors exercising discretion favors exercising discretion

The Workload Memo identifies “the strength of the unpatentability challenge” as a relevant consideration. Workload Memo at 2. “Although [the Director] may consider the merits for this factor, a full analysis of the merits is not necessary; rather, the parties may point out particular strengths or weaknesses to aid [] in deciding whether the merits tip the balance one way or another.” *Innoscence Am., Inc. v. Infineon Techs. Americas Corp.*, IPR2025-00010, 2025 WL 1421087, at *8 (P.T.A.B. May 16, 2025). This consideration favors discretionary denial because Petitioner’s patentability challenges are weak. In addition to the weaknesses

discussed below, Patent Owner's preliminary response will further identify numerous specific weaknesses in the Petition.

Every ground asserted by Petitioner is based on obviousness and relies on a combination of references. The petition is weak on the merits because it fails to provide a clear mapping to the prior art and omits even a basic obviousness analysis to support its conclusory assertions about what a person of ordinary skill would have understood or why a person of ordinary skill would have been motivated to combine such references.

Moreover, the petition attempts to rely heavily on expert testimony. Petitioner's obviousness grounds rely solely on expert testimony to fill in the gaps in the prior art and to establish what it contends would have been the relevant knowledge of a person of ordinary skill in the art. Yet, the expert declaration, which is over 120 pages long, merely parrots the petition and shares large sections of identical text with the petition. *See* Ex. 1002; *see also* Ex. 2013 (comparison of petition to Ex. 1002).

For example, Petitioner relies solely on expert testimony to argue that Fontana discloses "generating a topical meta-data that describes content of the video by deriving semantic information from the identification of the one or more objects and semantic information from the audio files." *See, e.g.*, Paper 2 at 23 ("A POSA would

understand ‘semantic information’ to refer to information conveying or associated with the meaning of content,” citing paragraph 98 of the expert declaration). Yet paragraph 98 of the expert declaration is merely the same content as the petition, without providing any additional supporting evidence or any technical reasoning, with the only change being that the quotations from the Fontana reference are not truncated. *See* Ex. 1002, ¶98; *see also* Ex. 2013, ¶98.

Likewise, Petitioner relies solely on expert testimony to argue that a person of ordinary skill in the art would have been motivated to combine Fontana with Lau. *See, e.g.*, Paper 2 at 26-32. Yet again the expert declaration is nearly identical to the petition, again with the only change being that the quotations are not truncated, without providing any additional supporting evidence or any technical reasoning. *See* Ex. 1002; *see also* Ex. 2013 at ¶¶107-120.

Indeed, as can be seen throughout the comparison of the petition and the expert declaration, the expert declaration is nearly identical to the petition, with the only changes being that the quotations are not truncated. *See* Ex. 2013. This makes the credibility of the expert a key issue in resolving Petitioner’s invalidity arguments, and the district court is better equipped to resolve a dispute that revolves around such factors. Moreover, the Board has been skeptical of petition arguments that are repeated verbatim by a witness purporting to give expert testimony. *Kinetic Techs.*,

Inc., Petitioner, v. Skyworks Sols., Inc., IPR2014-00529, 2014 WL 4787238, at *10 (P.T.A.B. Sept. 23, 2014) (“Merely repeating an argument from the Petition in the declaration of a proposed expert does not give that argument enhanced probative value.”); *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, 2022 WL 3648989, at *6 (P.T.A.B. Aug. 24, 2022) (“We have reviewed this excerpt from Dr. Jones’ declaration and note that it merely repeats, *verbatim*, the conclusory assertion for which it is offered to support. . . . Thus, the cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.”).

Accordingly, this factor weighs in favor of denying institution.

IV. CONCLUSION

For the reasons above, Patent Owner respectfully requests that the Director exercise discretion and deny institution of *inter partes* review.

Dated: August 11, 2025

Respectfully submitted,

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V. CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. 42.6(e), 42.8(b)(4) and 42.105, the undersigned certifies that on August 11, 2025, a complete and entire copy of this **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION and Exhibits 2001 through 2013** was served in their entirety via filing through the Patent Trial and Appeal Case Tracking System (P-TACTS), as well as electronic mail on the attorneys of record for Petitioners:

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VI. CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24

Pursuant to 37 C.F.R. § 42.24 et seq., the undersigned certifies that this document complies with the type-volume limitations excluding the cover page and the parts exempted by 37 C.F.R. § 42.24(a)(1). This document contains 4,865 words as calculated by the “Word Count” feature of Microsoft Word, the word processing program used to create it.

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