

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

ADVANCED CODING TECHNOLOGIES LLC,

Patent Owner.

Patent No. 7,804,891
Filing Date: March 30, 2005
Issue Date: September 28, 2010

Inventor: Taichi Majima

Title: DEVICE AND METHOD FOR JUDGING COMMUNICATION
QUALITY AND PROGRAM USED FOR THE JUDGMENT

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

Case No. IPR2025-01161

TABLE OF CONTENTS

	Page(s)
I. INTRODUCTION	1
II. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(a)	2
A. The Parallel District Court Litigation and the Petition Involve the Same Parties	4
B. The District Court Litigation Involves Substantially the Same Claims.....	5
C. Proximity of the District Court’s Trial Date	5
D. Significant Investment and Petitioner’s Delay in Filing the Petition.....	8
E. Settled Expectations of the Parties	8
III. CONCLUSION.....	9

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Advanced Coding Techs. LLC v. Google LLC</i> , Case No. 2:24-cv-00353-JRG (E.D. Tex.)	1, 2, 4
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020)	2
<i>Cisco Sys., Inc. v. Estech Sys., Inc.</i> , IPR2021-00329, Paper 13 (P.T.A.B. Jul. 6, 2021)	7
<i>Cisco Sys., Inc. v. Oyster Optics, LLC</i> , IPR2021-00238, Paper 10 (P.T.A.B. Jun. 1, 2021)	7
<i>Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.</i> , IPR2020-00122, Paper 15 (P.T.A.B. May 15, 2020)	5, 6
<i>Dabico Airport Sols. Inc. v. AXA Powers Aps</i> , IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025)	8, 9
<i>Edward LifeSciences Corp. v. Evalve, Inc.</i> , IPR2019-01479, Paper 7 (P.T.A.B. Feb. 26, 2020)	6
<i>F5 Networks, Inc. v. WSOU Invs., LLC</i> , IPR2022-00239, Paper 12 (P.T.A.B. May 18, 2022)	7
<i>Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017)	3
<i>Google LLC v. EcoFactor, Inc.</i> , IPR2021-00488, Paper 12 (P.T.A.B. Aug. 11, 2021)	7
<i>Next Caller Inc. v. TRUSTID, Inc.</i> , IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019)	6

NHK Spring Co. v. Intri-Plex Techs., Inc.,
IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018).....3

Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC,
IPR2019-01218, Paper 7 (P.T.A.B. Jan. 7, 2020)6

Samsung Elecs. Co. v. Truesight Commc'ns LLC,
IPR2025-00123, Paper 12, at 6-7 (Apr. 22, 2025)7

Supercell Oy v. Gree, Inc.,
IPR2020-00513, Paper 11 (P.T.A.B. June 24, 2020)6

Statutes

35 U.S.C. § 314(a)1, 3, 9

35 U.S.C. § 314(b)(1).....5

35 U.S.C. § 316(a)(11).....5

LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	Google LLC'S Second Amended Invalidity and Subject Matter Eligibility Contentions in <i>Advanced Coding Techs. LLC v. Google LLC</i> , Case No. 2:24-cv-00353-JRG (E.D. Tex.), dated April 11, 2025
2002	Advanced Coding Technologies LLC's Fourth Amended Disclosure of Asserted Claims and Infringement Contentions in <i>Advanced Coding Techs. LLC v. Google LLC</i> , Case No. 2:24-cv-00353-JRG (E.D. Tex.), dated December 20, 2024
2003	Advanced Coding Technologies LLC's Disclosure of Asserted Claims and Infringement Contentions in <i>Advanced Coding Techs. LLC v. Google LLC</i> , Case No. 2:24-cv-00353-JRG (E.D. Tex.), dated July 5, 2024

I. INTRODUCTION

Pursuant to the Director’s March 26, 2025, Memorandum Regarding Interim Processes for PTAB Workload Management, Advanced Coding Technologies LLC (“Patent Owner”) files this Request for Discretionary Denial of Institution.

On June 17, 2025, Google LLC. (“Petitioner”) submitted a Petition (Paper 2, “Petition” or “Pet.”) requesting *inter partes* review (“IPR”) of U.S. Patent No. 7,804,891 (Ex. 1001, the “’891 Patent”), challenging Claims 1-9 (the “Challenged Claims”).

The Petition identifies co-pending district court litigation *Advanced Coding Techs. LLC v. Google LLC*, Case No. 2:24-cv-00353-JRG (E.D. Tex.), with a trial date set for March 2, 2026. Pet. at 68; Ex. 1016. With Patent Owner’s Preliminary Response due October 8, 2025, institution of any grounds will result in the issuance of a Final Written Decision (“FWD”) by January 8, 2027.

The Director should exercise discretion to deny the Petition under 35 U.S.C. § 314(a) for at least the following reasons: (i) the parallel District Court Litigation exists between the same parties or real-parties-in-interest; (ii) the District Court Litigation involves the same subject patent (the ’891 Patent) with the same claims; (iii) the District Court’s trial will be *over ten months before* the projected statutory deadline for FWD; (iv) the parties have heavily invested in the District Court

Litigation with the deadline for the completion of fact discovery on October 7, 2025, and the completion of claim construction briefing due before the January 8, 2026 deadline for an institution decision; and (v) the '891 Patent has been in force for over 14 years, as such settled expectations have been created.

For the reasons set forth herein, the Director should exercise discretion to deny the Petition.

II. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(a)

The circumstances of the parallel District Court Litigation, *Advanced Coding Techs. LLC v. Google LLC*, Case No. 2:24-cv-00353-JRG (E.D. Tex.), necessitate denial of the Petition under the Board's precedent, as every factor considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (considering (a) "whether the petitioner and the defendant in the parallel proceeding are the same party"; (b) "overlap between issues raised in the petition and in the parallel proceeding"; (c) "proximity of the court's trial date to the Board's projected statutory deadline for a final written decision"; (d) "investment in the parallel proceeding by the court and the parties"; (e) "whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted"; and (f) "other

circumstances that impact the Board’s exercise of discretion, including the merits.”).

As set forth below, these factors collectively demonstrate that efficiency and integrity of the AIA are best served by denying review. First, the Petitioner is the Defendant in the parallel proceeding. *See infra* Section II.A. Second, the District Court Litigation involves the same claims at issue in the Petition. *See infra* Section II.B. Third, trial in the District Court Litigation is set for March 2, 2026, over eight months prior to the projected statutory deadline for a Final Written Decision of this Petition on January 8, 2027. *See infra* Section II.C. Fourth, the parties (and Patent Owner in particular) have invested significant resources in developing legal and factual issues of validity and infringement in the District Court Litigation and will have invested substantially more resources before any decision on this Petition. *See infra* Section II.D. Finally, there are settled expectations regarding the ’891 Patent, as it was granted over 14 years ago. *See infra* Section II.E.

Accordingly, the Director should exercise discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017))

(precedential)).

A. The Parallel District Court Litigation and the Petition Involve the Same Parties

As Petitioner notes, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the '891 Patent). Pet. at 68. Petitioner is a party to the District Court Litigation captioned as *Advanced Coding Techs. LLC v. Google LLC*, Case No. 2:24-cv-00353-JRG (E.D. Tex.), the District Court Litigation involves causes of action asserting the '891 Patent against Petitioner's products, which include Google's 5G and/or Wi-Fi 6 (IEEE 802.11.ax) compliant systems and devices including, but not limited to, Google Pixel Smartphone products compliant with 5G NR including, but not limited to, the Pixel 4a, Pixel 5a, Pixel 6, Pixel 6 Pro, Pixel 6a, Pixel 7, Pixel 7 Pro, Pixel 7a, Pixel Fold, Pixel 8, Pixel 8 Pro, Pixel 8a, Pixel 9, Pixel 9 Pro Fold, Pixel 9 Pro, Pixel 9 Pro XL, Pixel Tablet, Pixel Watch 3, and Google Nest Wifi Pro. Ex. 2002 at 2-3. Petitioner waited nearly eleven months after service of Patent Owner's infringement contentions on Petitioner before filing its Petition. Ex. 2003.

Accordingly, this factor weighs strongly in favor of discretionary denial.

B. The District Court Litigation Involves Substantially the Same Claims

There is overlap between the claims and grounds at issue in this Petition and the District Court Litigation because the Petition challenges the claims asserted in the District Court Litigation under the same grounds. *See* Ex. 2001 at 339-422; Pet. at 1. “In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020).

Accordingly, this factor weighs strongly in favor of discretionary denial.

C. Proximity of the District Court’s Trial Date

The proximity of the District Court Litigation’s trial date to the Board’s projected statutory deadline for a Final Written Decision weighs strongly in favor of discretionary denial.

The parties’ trial is scheduled for March 2, 2026. Ex. 1016. Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final

Written Decision of this Petition is January 8, 2027.¹ As the District Court’s trial will be *nearly ten months before* the projected statutory deadline, this factor weighs strongly in favor of denying institution. *See Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 10-12 (P.T.A.B. June 24, 2020) (denying institution where the jury trial was scheduled to conclude approximately ten months before the statutory deadline); *Edward LifeSciences Corp. v. Evalve, Inc.*, IPR2019-01479, Paper 7, at 6-13 (P.T.A.B. Feb. 26, 2020) (denying institution where jury trial would conclude more than nine months before a final decision would be due); *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019)

¹ Patent Owner will file a timely preliminary response on October 8, 2025. The statutory deadline for institution is January 8, 2026, “three months after receiving a preliminary response to the petition under section 313.” *See* 35 U.S.C. § 314(b)(1). If instituted, the statutory deadline for a Final Written Decision is January 8, 2027, “not later than 1 year after the date on which the Director notices the institution of a review.”

(denying institution where trial was scheduled to conclude “several months,” before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 (“Because the trial date is substantially earlier than the projected statutory deadline for the Board’s final decision, this factor weighs in favor of discretionary denial.”); *Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00329, Paper 13 at 7-15 (P.T.A.B. Jul. 6, 2021) (denied when two related trials predate FWD by eleven months and seven months, respectively); *F5 Networks, Inc. v. WSOU Invs., LLC*, IPR2022-00239, Paper 12 at 7-8 (P.T.A.B. May 18, 2022) (denied when trial predates FWD by six months); *Google LLC v. EcoFactor, Inc.*, IPR2021-00488, Paper 12 at 11-12 (P.T.A.B. Aug. 11, 2021) (denied when trial predates FWD by six months); *Cisco Sys., Inc. v. Oyster Optics, LLC*, IPR2021-00238, Paper 10 at 11-13 (P.T.A.B. Jun. 1, 2021) (denied when trial predates FWD by seven months); *Samsung Elecs. Co. v. Truesight Commc’ns LLC*, IPR2025-00123, Paper 12, at 6-7 (Apr. 22, 2025) (denied when trial predates FWD by six months). The over nine-month differential between the March 2026 trial date and the January 2027 FWD justifies discretionary denial.

Accordingly, this factor weighs strongly in favor of discretionary denial.

D. Significant Investment and Petitioner's Delay in Filing the Petition

The parties' investment in the parallel proceeding weighs strongly in favor of discretionary denial. In the District Court Litigation, the parties have already exchanged infringement and invalidity contentions and have exchanged initial claim terms. The deadline for substantial completion of document production will pass on August 5, 2025. Ex. 1016.

On the January 8, 2026 statutory deadline for an institution decision, the parties will have completed claim construction in the District Court Litigation. *See id.* Furthermore, the entirety of fact discovery will have passed, with fact discovery currently set to conclude on October 7, 2025. *Id.* A trial date is set for March 2, 2026, which is approximately ten months away. *Id.* Accordingly, the parties' and Court's substantial investment in this proceeding weighs strongly in favor of denial of institution.

E. Settled Expectations of the Parties

The '891 Patent was granted September 28, 2010, over 14 years before Petitioner filed its Petition, and claims priority to an application from 2004, which is over 20 years before Petitioner filed its Petition, as such, Patent Owner has settled expectations at this point. *See* '891 Patent. The Board has previously discretionarily denied institution because "the challenged patent has been in force almost eight

years, creating settled expectations.” *Dabico Airport Sols. Inc. v. AXA Powers Aps*, IPR2025-00408, Paper 21 at 2 (P.T.A.B. June 18, 2025). The Board also noted that “the longer the patent has been in force, the more settled expectations should be” and equated this approach to the six year damages period related to filing infringement lawsuits. *Id.* at 3. The situation is no different here, as “actual notice of a patent or of possible infringement is not necessary to create settled expectations.” *Id.*

When viewing the factors together, the Petition should be denied in the Director’s discretion under 35 U.S.C. § 314(a).

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion to deny institution of the Petition in its entirety.

Respectfully submitted,

Dated: July 17, 2025

By: /Peter Lambrianakos /
Peter Lambrianakos (Reg. No. 58,279)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796

CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION has 1,721 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

Respectfully submitted,

July 17, 2025

By: /Peter Lambrianakos _____/
Peter Lambrianakos (Reg. No. 58,279)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796

CERTIFICATE OF SERVICE

A copy of the foregoing PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION and Exhibits 2001 through 2003 have been served on Petitioner's counsel of record as follows:

Raghav Bajaj
Email: raghav.bajaj@lw.com
LATHAM & WATKINS LLP
300 Colorado Avenue, Suite 2400
Austin, Texas 78701

Doug Lumish
Email: doug.lumish@lw.com
Linfong Tzeng
Email: linfong.tzeng@lw.com
LATHAM & WATKINS LLP
140 Scott Drive
Menlo Park, California 94025

Patricia Young
Email: patricia.young@lw.com
LATHAM & WATKINS LLP
1271 Avenue of the Americas
New York, New York 10020

Joseph H. Lee
Email: joseph.lee@lw.com
LATHAM & WATKINS LLP
650 Town Center Drive, 20th Floor
Costa Mesa, California 92626

Attorneys for Google LLC.

July 17, 2025

By: /Peter Lambrianakos /
Peter Lambrianakos (Reg. No. 58,279)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796