

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

TELCOM VENTURES LLC,

Patent Owner

Case No. IPR2025-01235
U.S. Patent No. 10,674,432

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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2001	Interim Processes for PTAB Workload Management, Acting Director Memorandum (March 26, 2025) (https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf)
2002	Third Amended Docket Control Order
2003	Standing Order for Civil Cases Before Judge Rita F. Lin
2004	Telcom Ventures' Proposed Case Schedule for the Apple Litigation
2005	<i>Telcom Ventures LLC v. Apple, Inc.</i> , No. 3:25-cv-05041-RFL, Dkt. 1 (Oct. 4, 2024)

I. INTRODUCTION

Telcom Ventures LLC (“Telcom Ventures” or “Patent Owner”) respectfully submits this brief requesting that the Board deny institution of the Petition for *inter partes* review (Paper 1, “Petition”) filed by Apple Inc. (“Apple” or “Petitioner”) pursuant to § 314(a) and the March 26, 2025 Memorandum titled “Interim Processes for PTAB Workload Management” (“Interim Process Memo”). *See* Ex. 2001.

The Petition seeks *inter partes* review (“IPR”) of claims 1-17 (the “Challenged Claims”) of U.S. Patent No. 10,674,432 (the “Challenged Patent,” Ex. 1001). The Challenged Patent and seven other patents (collectively, the “Telcom Ventures Patents”) were originally the subjects of a co-pending patent infringement action that Telcom Ventures brought over one year ago against Apple in the Southern District of Florida, which was transferred to and is now pending in the Northern District of California as Civil Action No. 3:25-cv-05041-RFL (the “Apple Litigation”). Petitioner filed IPR petitions against all eight of these patents.¹ Apple’s IPR petitions are the second set of challenges before the Board on these same patents, as Samsung filed IPR petitions against the Telcom Ventures Patents three months

¹ IPR Nos. 2025-01232, 01233, and -01234 were accorded the same filing date as the present IPR, while IPR Nos. 2025-01236, -01237, -01238 and -01239 were accorded a filing date that is one day after the present IPR.

before Petitioner did so here.² *See* Paper 4. Subsequently, Google filed IPR petitions against seven of the eight Telcom Ventures Patents. *Id.* As explained in detail below, the Interim Process Memo and *Fintiv*³ factors weigh in favor of denying institution.

First, instituting this Petition would require a considerable and inefficient use of the Board’s resources as (1) the Samsung IPRs are scheduled to be considered by the Board in advance of an institution decision of this IPR and (2) at least one and possibly two district court trials on the Telcom Ventures Patents, including the Challenged Patent, is scheduled to conclude well before any final written decision would issue in the Apple IPRs.⁴ Indeed, the Samsung trial (set for June 1, 2026) will conclude *eight months* before February 8, 2027, the statutory deadline for the Board

² *See Samsung Electronics Co. v. Telcom Ventures LLC*, IPR2025-00957, -00972, -00973, -00974, -00975, -00976, -00977, -00978 (the “Samsung IPRs”).

³ *Apple v. Fintiv, Inc.*, No. IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”).

⁴ Patent Owner informed Samsung that it was withdrawing its infringement allegations for two patents in the Samsung Litigation (but not the Challenged Patent), but Samsung responded the same day by filing declaratory judgment claims of invalidity on all eight Telcom Ventures Patents. Accordingly, the validity of all eight Telcom Ventures Patents remains at issue in the Samsung Litigation.

to issue a final written decision in this IPR. Moreover, consistent with the California court's standing order, Telcom Ventures has proposed a trial date in the Apple Litigation that is before the Board's statutory deadline.⁵ *See* Exs. 2002, 2003.

Second, Patent Owner's Discretionary Denial briefs together and individually demonstrate Patent Owner has had strong settled expectations for the family of Telcom Ventures Patents going back nearly a decade—which stem from U.S. Patent No. 9,462,411, which was filed on November 4, 2008, and issued on October 4, 2016.⁶ The Challenged Patent and the other challenged Telcom Ventures Patents are

⁵ *See, e.g., Zhuhai CosMX Battery Co., Ltd. v. Ningde Ampere Tech. Ltd.*, IPR2025-00524, Paper 10 at 2 (Director Sept. 3, 2025) (“Repeat challenges weigh against institution.”); *Docker Inc. v. Intellectual Ventures II LLC*, IPR2025-00840, Paper 9 at 2 (Director Sept. 19, 2025) (denying institution where the challenged patent was at issue in other district court proceedings and IPRs and a district court trial would occur before any final written decision).

⁶ *See, e.g., Samsung Elecs. Co., Ltd. v. Icashe, Inc.*, IPR2025-00639, Paper 11 at 2 (P.T.A.B. Aug. 14, 2025) (granting discretionary denial where some of the challenged patents “have been in force for over nine, eight, twelve, nine, and nine

all continuations of the challenged '411 Patent, and the Office has, after a full and complete examination, issued each of these patents to Patent Owner year after year—in 2017, 2019, 2020, 2023, and 2024. Moreover, each of the applications has been directed to the same technology area as the products accused of infringement in the Apple Litigation. That the Office has continued to review and grant claims across the family underscores Patent Owner's settled expectations for these patents.

All told, there are many reasons to deny institution, and institution should be denied.

II. LEGAL STANDARDS

35 U.S.C. § 314(a) gives the Director discretion to deny institution of IPR due to the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19-21 (P.T.A.B. Sept. 12, 2018) (precedential). The Interim Process Memo outlines several discretionary factors committed to the Director's discretion under § 314(a), including a non-exhaustive set of factors that the Board may consider when evaluating how to apply its discretion under § 314(a) (“Interim Process Memo

years, respectively, creating strong settled expectations for Patent Owner” and instituting IPRs on other, more recent, patents would be “an inefficient use of Board resources and tips the balance to discretionary denial as to those patent[s] too”).

Factors”) and the *Fintiv* factors. The “[p]arties are encouraged to address *any* fact or circumstance they believe bears on the Director’s discretion to institute, including reasons not discussed in current Board precedent or in the Process Memorandum.” See Interim Director Discretionary Process Website, I.B (emphasis added).

III. THE DIRECTOR SHOULD DENY INSTITUTION OF INTER PARTES REVIEW UNDER § 314(a)

The Director should deny institution on all grounds because Apple’s IPR petitions present challenges to patents that will be subject to at least one and possibly two district court trials well before a final written decision. As shown below, many of the Interim Process Memo Factors weigh in favor of denying institution in the interest of efficiency and fairness, including Patent Owner’s settled expectations, the Petition’s extensive reliance on expert testimony, and other considerations. Moreover, the *Fintiv* factors weigh in favor of denying institution under 35 U.S.C. § 314(a). See *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18 at 7 (P.T.A.B. May 2, 2022) (weighing *Fintiv* factors and denying institution).

A. The Interim Process Memo Factors Weigh Against Institution

1. The Telcom Ventures Patents Will Be Subject to Validity Determinations Well Before Any Final Written Decision

Petitioner filed eight separate petitions challenging the eight Telcom Ventures Patents nearly *three months after* Samsung filed its own eight petitions challenging the same patents. These petitions are thus the second set of patentability challenges on the same set of patents before the Board. See, e.g., *uPI Semiconductor Corp. v.*

Force MOS Tech. Co. Ltd., IPR2025-00920, Paper 12 at 2 (Director Sep. 12, 2025) (“Repeated challenges weigh against institution, and it would not be an efficient use of Office resources to further consider the Petition under these circumstances.”); *Zhuhai CosMX Battery Co., Ltd. v. Ningde Amperex Tech. Ltd.*, IPR2025-00524, Paper 10 at 2 (Director Sept. 3, 2025) (“Repeat challenges weigh against institution.”). It would be an inefficient use of the Office’s resources to review serial challenges by different Petitioners to the same patents. This is especially true considering that the Telcom Ventures Patents will be subject to validity determinations in at least one and possibly two district court trials well before any final written decision issues in any of the pending IPRs. The Telcom Ventures Patents are asserted in *Telcom Ventures LLC v. Samsung Electronics Co., Ltd.*, No. 2:24-cv-00691-JRG (E.D. Tex.), where trial is scheduled for June 1, 2026 (the “Samsung Litigation”). *See* Ex. 2002. In other words, trial on the Telcom Ventures Patents will conclude in the Samsung Litigation *eight months* before February 8, 2027, the statutory deadline for the Board to issue a final written decision in this IPR (assuming the Board’s institution decision is dated February 6, 2026).⁷ Further,

⁷ In Samsung’s Opposition to Patent Owner’s Request for Discretionary

should the Board institute the Samsung IPRs, the Board's statutory deadline to issue any final written decision in the Samsung IPRs is well before the statutory deadline in these proceedings.

Moreover, the Parties are in the middle of negotiating a proposed schedule in the Apple Litigation, which is due to the Court on October 14, 2025. The assigned judge's standing order specifies that the proposed trial date should be within "12-16 months" of the filing date of the Complaint. Ex. 2003 ("The trial date will almost always be 12-16 months after the date the original complaint was filed."). Given that Telcom Ventures filed its Complaint over one year ago and a schedule is just now being set because of Apple's multiple attempts to delay the Apple Litigation—including Apple's Motion to Transfer, Motion to Dismiss, and Motion to Reconsider the Denial of the Motion to Dismiss—Telcom Ventures has proposed a trial date that is within 13 months of the case management conference scheduled to occur on

Denial, Samsung argued that the scheduled June 1, 2026 trial date is unlikely as the median time time-to-trial in the Eastern District of Texas is 25.1 months. *See Samsung Elec. Co. Ltd. v. Telcom Ventures LLC*, IPR2025-00974, Paper 10 at 14 (Sept. 18, 2025). Even though Samsung's median time-to-trial statistic was much longer than the 22 months proposed by Patent Owner, Samsung's median time would still put trial two months *before* any Final Written Decision. *Id.*

October 22, 2025. Ex. 2004. Should the Court agree with Telcom Ventures—or at the very least set a trial date, consistent with the Court’s order, that is within 15 months of the case management conference—trial in the Apple Litigation would conclude before the Board’s statutory deadline to issue any final written decision here. The judge is expected to set a schedule during the scheduling conference.

In sum, it is unlikely that any final written decision will issue before at least one and potentially two district court trials occur on the Challenged Patent. Under these circumstances, it would be an inefficient use of the Office’s resources to review the Challenged Patent. *See, e.g., Docker Inc. v. Intellectual Ventures II LLC*, IPR2025-00840, Paper 9 at 2 (Director Sept. 19, 2025) (denying institution where the challenged patent was at issue in other district court proceedings and IPRs and a district court trial would occur before any final written decision); *Koito Mfg. Co. Ltd. v. Longhorn Auto. Grp. LLC*, IPR2025-00955, Paper 9 at 2 (Director Sept. 19, 2025) (denying institution where the challenged patent was at issue in other district court proceedings where trial was set before any final written decision would issue). Accordingly, discretionary denial is appropriate based on at least the ordered Samsung Litigation trial date and the expected Apple Litigation trial date.

2. Patent Owner’s Settled Expectations Favor Denial

The Challenged Patent belongs to a family of patents with strong settled expectations. “Settled expectations” is generally directed to the length of time the

claims have been in force. This factor weighs in favor of denying institution.

At issue in these eight IPRs is a single set of eight continuation patents. This single family of patents, whose filing date is in 2008, embodies the inventions of two inventors, Peter D. Karabinis and Rajendra Singh. By the time of the institution decisions in these proceedings, the '411 Patent (the oldest family member) will have been in force for more than nine years—since October 4, 2016—and the Challenged Patent itself has been in force since June 2, 2020. This creates strong settled expectations for Telcom Ventures. *See, e.g., Samsung*, Paper 11 at 2 (granting discretionary denial where the challenged patents “have been in force for over nine, eight, twelve, nine, and nine years, respectively, creating strong settled expectations for Patent Owner”); *Yangtze Memory Techs. Co., Ltd. v. Micron Tech., Inc.*, IPR2025-00498, Paper 11 at 2 (P.T.A.B. Aug. 14, 2025) (granting discretionary denial where “the challenged patents have been in force for approximately ten, six, and six years, respectively, creating strong settled expectations for Patent Owner”).

Moreover, the Office has continually issued patents in this family over the last nine years. As such, starting with the original filing in 2008 (and issuance in 2016), Patent Owner has invested a significant amount of time and resources into this family of patents, none of which have ever been challenged before the present serial IPR petitions by Samsung, Apple, and Google, and the Office has continuously awarded Telcom Ventures patent after patent in the family after rigorous

examination by the Examiners. Petitioner does not—and cannot—provide any persuasive reasoning for why an *inter partes* review of eight patents in the same family is an appropriate use of Board resources. *Icashe*, Paper 11 at 3 (granting discretionary denial of seven IPRs even though some of the patents had not been in force as long as others); *Yangtze*, Paper 11 at 2 (declining to “disturb the strong settled expectations of Patent Owner” where Petitioner failed to provide persuasive reasoning for why IPR is an appropriate use of Board resources).

The fact that the first patent in the Telcom Ventures Patent family issued about nine years ago and the Challenged Patent has been in force since 2020, coupled with the substantial investments by Patent Owner (both then and in the many years since then) as the Office granted issuance of each family member, demonstrates settled expectations that warrant denial of institution. *See, e.g., iRhythm Techs., Inc. v. Welch Allyn*, IPR2025-00363, Paper 10 at 3 (Director June 6, 2025) (denying institution where “one of the patents has been in force since as early as 2012”); *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025) (“[T]he challenged patent has been in force almost eight years, creating settled expectations.”); *Samsung Elecs., Co., Ltd. v. Cerence Operating Co.*, IPR2025-00458, Paper 14 at 2 (Director June 25, 2025) (“[T]he challenged patents issued over 11 years ago Patent Owner’s settled expectations also weigh toward discretionary denial.”). The longstanding nature of the

Challenged Patent (and the family as a whole), and the Office's regular and consistent granting of each patent in the family over the last nine years, demonstrates settled expectations surrounding Messrs. Karabinis and Singh's inventions.

Moreover, each of the applications has been directed to the same technology area as the products accused of infringement in the Apple Litigation. For example, the Telcom Ventures Patents, including the Challenged Patent, are directed to financial transactions and wallet applications. Specifically, starting with the first application filed in November 2008, each of the Telcom Ventures Patents is directed to a wallet function on a mobile wireless device such as a smartphone. Ex. 1001 at 1:41-44 ("It would, for example, be desirable to have a mobile wireless device act as a 'wallet' (over and above other functions) only when it is time to pay for an item and not act as a wallet when there is no need to do so."). Indeed, each of the Telcom Ventures Patents relates to the use of a proximity criterion for completing financial transactions. *Id.* at 9:25-29 ("In one embodiment, the detection by mobile subscriber device 14 of a proximity criterion relative to Entity 1 can enable the mobile subscriber device 14 to authorize and complete a financial transaction such as the payment of a toll and/or of an item at a check out line.").

Thus, Patent Owner's settled expectations weigh against institution.

3. The Extent of the Petition's Reliance on Expert Testimony Favors Denial

In evaluating discretionary denial, the Director also considers the "extent of

the petition’s reliance on expert testimony.” Interim Process Memo at 2.

This factor favors denial because Petitioner relies heavily on expert testimony, assumptions, and inferences to fill in the gaps of the prior art in order to arrive at the claimed inventions. Also, Petitioner’s expert testimony is oftentimes superficial and at all times lengthy, covering every claim limitation and every asserted ground, rather than providing a focused expert declaration addressing only the limitations for which expert testimony is strictly warranted. *See generally* Ex. 1003.

Petitioner’s expert declaration lacks focus because, for example, it provides only a cursory analysis of the prior art using language that tracks the Petition and using the same headings and sub-headings throughout the claim analysis (*compare* Ex. 1003, ¶¶ 47-50 *with* Pet. at 4-6; *compare* Ex. 1003, ¶¶ 54-61 *with* Pet. at 1-4; *compare* Ex. 1003, ¶¶ 74-97 *with* Pet. at 7-22; *compare* Ex. 1003, ¶¶ 102-112 *with* Pet. at 25-33). Worse, Petitioner’s obviousness grounds—based on *Carlson* in a combination with *Holloway*, *ISO-14443*, *Lin*, *Sherman*, *Jazayeri*, and/or *Murakami*—rely on expert testimony to establish what Petitioner contends would have been the relevant knowledge of persons of ordinary skill in the art (“POSITA”), including how a POSITA allegedly would have understood or combined these seven references to fit the language of the Challenged Claims. *See, e.g.*, Pet. at 24-25 (in Ground 1 for claim 1, asserting that “a POSITA would have been motivated to implement *Carlson* pursuant to *Holloway*’s fingerprint sensor” and “pursuant to this

[ISO-14443] standardized protocol”); *id.* at 27-29 (in Ground 1 for limitation 1[a], asserting that “[a] POSITA would have been motivated to implement *Holloway*’s fingerprint scanner in *Carlson*’s device”); *id.* at 34, 40-41, 44-46, 47, 48-49, 50 (in Ground 1 for limitations 1[d], 1[d(1)], 1[d(2)], 1[d(iv)], 1[e], and 1[f], asserting what “[a] POSITA would have understood” based on the testimony of Petitioner’s expert); *id.* at 41-43 (in Ground 1 for limitation 1[d(1)], asserting that “[a] POSITA would have been motivated to implement *ISO-4443*’s teachings in this way for several reasons” provided by Petitioner’s expert); *id.* at 60, 62-63, 65-66 (in Ground 2 for limitations 7[a], 7[b], and 8[a] asserting what “[a] POSITA would have understood” based on the testimony of Petitioner’s expert); *id.* at 61-62 (in Ground 2 for claim 7, asserting that “[a] POSITA would have been motivated to implement *Lin*’s method of adding a credit card to *Carlson* for a number of reasons”); *id.* at 66-67 (in Ground 2 for limitation 8[a], asserting that “[a] POSITA would have been motivated to implement *Lin*’s group transaction teachings with *Carlson*”); *id.* at 69-70 (in Ground 3 for claim 9, asserting that “[a] POSITA would have been motivated to implement *Carlson*’s wireless device and communications network with *Sherman*’s WiMAX mobile communication module”).

Patent Owner will explain in its POPR (which Patent Owner incorporates by reference) why Petitioner’s and its expert’s arguments, assumptions, and inferences are incorrect and do not meet the claim limitations. Regardless, because of

Petitioner's extensive reliance on superficial but extensive expert testimony in an attempt to establish unpatentability of the Challenged Claims, the patentability of the Telcom Ventures patent family is better suited to resolution in an Article III district court, including both the Samsung Litigation that is already far advanced and the Apple Litigation. Thus, this factor favors denial of institution.

4. Other Circumstances Weigh Against Institution

Apple waited ten months to file these IPR petitions, placing the schedules for these petitions well behind the streamlined district court trial scheduled for June 2026 in the Samsung Litigation, not to mention the possibility of an additional trial in the Apple Litigation. The purpose of discretionary denial is to “allay[] concerns about inefficiency and duplication of efforts.” *Fintiv*, Paper 11 at 6. Instituting eight separate IPRs to address the patentability of the Telcom Ventures Patents that will already be decided by at least one jury (and by the Board, should the Board decide to institute the Samsung IPRs) would frustrate the intended efficiencies of the AIA and would be an unnecessary and unwarranted expenditure of the Board's resources.

In essence, Petitioner is requesting an additional eight separate IPR trials (which, when added to both the Google and Samsung IPRs, result in 23 IPRs challenging eight patents), where both the Samsung Litigation and Apple Litigation (as well as the Board's final written decisions in the Samsung IPRs, should they be instituted) will likely finish well in advance of any IPR final written decisions here.

The IPR Petitions on the family of Telcom Ventures Patents create duplicative workloads, inefficiencies, and potential for inconsistent results that the Interim Guidance Memo is designed to prevent. *See, e.g., Comcast Cable Commc'ns, LLC d/b/a Xfinity v. Entropic Commc'ns, LLC*, IPR2025-00183, Paper 11 at 3 (Director June 25, 2025) (“The presence of multiple parallel proceedings and avoidance of duplicative workloads and inconsistent outcomes favor discretionary denial.”). The Article III proceedings in both the Samsung Litigation and the Apple Litigation will be faster than these IPRs and will provide the most efficient resolution of the parties’ many extensive disputes over validity, all of which favors denial of institution.

Additionally, all seven grounds of the Petition rely on *Carlson*—filed approximately four months before the constructive reduction to practice of the Challenged Patent—as the primary prior art reference under 35 U.S.C. § 102(e). Pet. at 7, 23-24. Patent Owner reserves the right to challenge *Carlson*’s status as prior art. Litigation-related discovery related to conception and actual reduction to practice of the Challenged Patent and the other Telcom Ventures Patents may result in removing *Carlson* as prior art. It would be an inefficient use of the Board’s resources to duplicate discovery on these issues, including production of confidential documents, preparation of expert declarations, and depositions of fact and expert witnesses. As such, discretionary denial here would reduce the chances of duplicative workloads and inconsistent outcomes on prior art status and priority. *See*

Comcast Cable, IPR2025-00183, Paper 11 at 3 (Director June 25, 2025) (“Because there are multiple ongoing district court proceedings, discretionary denial of the Petitions reduces the chances of duplicative workloads and inconsistent outcomes.”).

In sum, many of the Interim Guidance Memo factors warrant discretionary denial of Apple’s IPR petitions, including the present Petition.

B. The *Fintiv* Factors Weigh Against Institution

1. *Fintiv* Factor 1: Apple Has Not Moved to Stay the Apple Litigation

Fintiv Factor 1 does not weigh for or against institution. Petitioner has not filed a motion to stay the Apple Litigation. Nor does the Petition indicate that Apple intends to request a stay of the Apple Litigation. Accordingly, this factor is neutral. See *VMWare, Inc. v. Intellectual Ventures I LLC*, IPR2020-00470, Paper 13 at 17 (P.T.A.B. Aug. 18, 2020) (finding in the absence of a stay motion that this factor “does not weigh for or against discretionary denial”).

2. *Fintiv* Factor 2: Any Final Written Decision Would Likely Occur After the Expected Jury Trial Date

Fintiv Factor 2 weighs against institution. As highlighted above in Section III.A.1, the parties are in the middle of negotiating a proposed schedule in the Apple Litigation, which is due to the Court on October 15, 2025. Judge Lin’s standing order specifies that the proposed trial date should be within 12-16 months of the filing date of the Complaint. See Ex. 2003. Given that Telcom Ventures filed its Complaint over one year ago and a schedule is just now being set because of Apple’s multiple

attempts to delay the Apple Litigation, Telcom Ventures has proposed a November 16, 2026 trial date.

Telcom Ventures' proposed trial date is consistent with the Court's standing order as it is within 13 months of the scheduled case management conference, which is for all intents and purposes akin to the filing date of the Complaint, as the case was transferred to the Northern District of California. Should the Court accept Telcom Ventures' proposal, trial in the Apple Litigation would conclude almost ***three months before*** the statutory deadline to issue any final written decision here. And even if the Court were to defer the trial date for another two to three months, trial would still likely conclude before the statutory deadline.

The Director has denied institution in view of similar gaps between trial and later final written decisions. *See, e.g., Samsung Elecs. Co., Ltd. v. Mobile Data Techs., LLC*, IPR2025-00535, Paper 16 at 2 (Director July 10, 2025) (finding this factor weighed in favor of discretionary denial and denying institution where the trial date (April 20, 2026) was over four months before the final written decision date (September 2026)); *Samsung Elecs. Co. Ltd. v. SinoTechnix LLC*, IPR2025-00331, Paper 13 at 2 (Director July 2, 2025) (finding this factor weighed in favor of discretionary denial and denying institution where the trial date (May 4, 2026) was about four months before the final written decision date (September 6, 2026)); *Cisco Sys., Inc. v. WSOU Investments LLC d/b/a Brazos Licensing & Dev.*, IPR2025-

00429, Paper 15 at 2 (Director June 25, 2025) (finding this factor weighed in favor of discretionary denial and denying institution where the trial date (March 2026 or April 20, 2026) was three-to-five months before the final written decision date (July 30, 2026)).

Finally, Petitioner created this situation by waiting *eight months* after Telcom Ventures initiated the Apple Litigation to file this IPR. Had Petitioner been diligent in its filing, perhaps it could have avoided one or even two trials occurring in advance of any final written decisions. Because of Petitioner's delay, patentability of the Challenged Patent will likely be resolved prior to these IPR proceedings.

Thus, because of the Samsung Litigation and the Apple Litigation, *Fintiv* Factor 2 weighs against institution.

3. *Fintiv* Factor 3: The Parties Will Have Invested Significant Effort and Resources in the Parallel District Court Case by the Time of Institution

Fintiv Factor 3 weighs against institution. *Fintiv* Factor 3 looks to 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 (emphasis added). There is no doubt that by Institution, the parties as well as two district courts will have made meaningful investments in parallel litigation.

In the Apple Litigation, by this IPR's institution deadline (February 6, 2026), the Parties will have already exchanged initial infringement contentions (November

5, 2025) and invalidity contentions (December 2, 2025) and conducted extensive fact discovery, since Telcom Ventures proposes a deadline for the close of fact discovery (May 27, 2026) that is three months after the institution deadline.⁸ Ex. 2004. Further, by the institution deadline, the Parties will be in the middle of claim construction and will have exchanged preliminary constructions.

Moreover, Telcom Ventures has already spent significant resources defending Apple's attempts to delay the Apple Litigation. Apple filed motions to transfer and dismiss the case, where Apple alleged that each of the Telcom Ventures Patents are invalid under 35 U.S.C. § 101, and even filed a motion asking the California court to reconsider the Florida court's decision denying Apple's motion to dismiss.

Given the significant resources the parties and two courts will have invested by the institution decision date, *Fintiv* Factor 3 weighs against institution.

4. *Fintiv* Factor 4: The Challenged Patent Is at Issue in the Parallel Litigation

***Fintiv* Factor 4** also weighs against institution. The Challenged Patent is currently asserted in the Apple Litigation (and the Samsung Litigation), that will likely conclude before any final written decision here. While Apple just filed a

⁸ The deadlines for the parties to exchange contentions and claim construction are set by the Local Patent Rules of the Northern District of California and are initiated by the Case Management Conference (scheduled for October 22, 2025).

Sotera stipulation on October 3, 2025, Apple has yet to serve its invalidity contentions in the Apple Litigation, and thus Patent Owner cannot analyze the full extent of the overlap of Petitioner's invalidity grounds in the parallel proceeding and the instant IPR. Accordingly, *Fintiv* Factor 4 is neutral.

5. *Fintiv* Factor 5: Overlap of Parties

***Fintiv* Factor 5** also weighs against institution because Petitioner (Apple Inc.) is the accused infringer and defendant in the Apple Litigation, and Patent Owner (Telcom Ventures LLC) is the plaintiff in that litigation. Ex. 2005. Therefore, there is complete identity of the parties.

6. *Fintiv* Factor 6: The Merits of the Petition Are Weak

***Fintiv* Factor 6** relates to the weakness of the Petition on the merits, which weighs against institution. The merits will be addressed in Patent Owner's Preliminary Response (which is incorporated herein by reference pursuant to the Interim Director Discretionary Process Website, II.C.i).

IV. CONCLUSION

For the reasons discussed, Patent Owner respectfully submits that the Board should deny institution of all Grounds of the Petition.

Dated: October 6, 2025

Respectfully submitted,

By: Christopher TL Douglas /
Christopher TL Douglas, Reg. No. 56,950

CERTIFICATION UNDER 37 C.F.R. §42.24

I hereby certify that this paper complies with the 20-page limit requirement for discretionary denial briefs filed after September 1, 2025.

Dated: October 6, 2025

By: / Christopher TL Douglas /
Christopher TL Douglas

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), the undersigned hereby certifies that true and correct copies of the above-captioned **PATENT OWNER'S DISCRETIONARY DENIAL BRIEF and Exhibits 2001 – 2005** were served in their entirety on October 6, 2025 via filing through the Patent Trial and Appeal Case Tracking System (P-TACTS) and electronic mail on the following counsel of record for Petitioner:

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