

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

APPLE INC.,

Petitioner

v.

TELCOM VENTURES LLC,

Patent Owner

---

Case No. IPR2025-01239  
U.S. Patent No. 12,028,793

---

**PATENT OWNER'S DISCRETIONARY DENIAL BRIEF**

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
US Patent and Trademark Office  
PO Box 1450  
Alexandria, Virginia 22313-1450

**TABLE OF CONTENTS**

I.	INTRODUCTION .....	1
II.	LEGAL STANDARDS .....	5
III.	THE DIRECTOR SHOULD DENY INSTITUTION OF INTER PARTES REVIEW UNDER § 314(a) .....	6
	A. The Telcom Ventures Patents Will Be Subject to Validity Determinations Well Before Any Final Written Decision .....	7
	B. Patent Owner’s Settled Expectations Favor Denial .....	10
	C. The Extent of the Petition’s Reliance on Expert Testimony Favors Denial.....	13
	D. Other Circumstances Weigh Against Institution.....	16
IV.	CONCLUSION.....	18

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>CASES</b>	
<i>Apple v. Fintiv, Inc.</i> , No. IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).....	5, 16
<i>Comcast Cable Commc'ns, LLC d/b/a Xfinity v. Entropic Commc'ns, LLC</i> , IPR2025-00183, Paper 11 (Director June 25, 2025) .....	17, 18
<i>Dabico Airport Sols. Inc. v. AXA Power ApS</i> , IPR2025-00408, Paper 21 (Director June 18, 2025) .....	12
<i>Docker Inc. v. Intellectual Ventures II LLC</i> , IPR2025-00840, Paper 9 (Director Sept. 19, 2025) .....	3, 9
<i>Ericsson Inc. v. Procomm International Pte. Ltd.</i> , IPR2024-01452, Paper 16 (Director June 25, 2025) .....	6
<i>iRhythm Techs., Inc. v. Welch Allyn</i> , IPR2025-00363, Paper 10 (Director June 6, 2025) .....	12
<i>Koito Mfg. Co. Ltd. v. Longhorn Auto. Grp. LLC</i> , IPR2025-00955, Paper 9 (Director Sept. 19, 2025) .....	10
<i>NHK Spring Co. v. Intri-Plex Techs., Inc.</i> , IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018).....	5
<i>Samsung Elecs., Co., Ltd. v. Cerence Operating Co.</i> , IPR2025-00458, Paper 14 (Director June 25, 2025) .....	12
<i>Samsung Elecs. Co., Ltd. v. Icashe, Inc.</i> , IPR2025-00639, Paper 11 (P.T.A.B. Aug. 14, 2025).....	4, 10, 11
<i>SAP America, Inc. v. Valtrus Innovations Ltd.</i> , IPR2025-00414, Paper 10 (Director July 10, 2025).....	2, 6
<i>uPI Semiconductor Corp. v. Force MOS Tech. Co. Ltd.</i> , IPR2025-00920, Paper 12 (Director Sept. 12, 2025) .....	7
<i>Yangtze Memory Techs. Co., Ltd. v. Micron Tech., Inc.</i> , IPR2025-00498, Paper 11 (P.T.A.B. Aug. 14, 2025).....	10, 11

*Zhuhai CosMX Battery Co., Ltd. v. Ningde Ampere Tech. Ltd.*,  
IPR2025-00524, Paper 10 (Director Sept. 3, 2025) .....3, 7

**STATUTES**

35 U.S.C. § 102(e) .....17

35 U.S.C. § 314(a) .....1, 5, 6

**OTHER AUTHORITIES**

“Interim Processes for PTAB Workload Management” .....1, 13

**TABLE OF EXHIBITS**

<b>Exhibit Number</b>	<b>Description</b>
2001	Interim Processes for PTAB Workload Management, Acting Director Memorandum (March 26, 2025) ( <a href="https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf">https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf</a> )
2002	Order Granting Joint Stipulation to Dismiss With Prejudice Counts I, II, V, and VIII of Telcom Ventures' Complaint
2003	Third Amended Docket Control Order
2004	Standing Order for Civil Cases Before Judge Rita F. Lin
2005	Telcom Ventures' Proposed Case Schedule for the Apple Litigation

## 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 1-11 (the “Challenged Claims”) of U.S. Patent No. 12,028,793 (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,<sup>1</sup> 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.<sup>2</sup> Apple’s

---

<sup>1</sup> U.S. Patent Nos. 9,462,411, 9,832,708, 11,770,756, and 12,028,793 have since been dismissed with prejudice from the Apple Litigation.

<sup>2</sup> IPR Nos. 2025-01232, -01233, -01234, and -01235 were accorded a filing date one day before the present IPR, while IPR Nos. 2025-01236, -01237, and -01238 were accorded the same filing date as the present IPR.

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 before Petitioner did so here. *See* Paper 4 (Mandatory Notice). Subsequently, Google filed IPR petitions against seven of the eight Telcom Ventures Patents. *Id.* As highlighted herein, and explained in further detail below, the Interim Process Memo factors weigh in favor of denying institution.

*First*, instituting this Petition would require an inefficient use of the Board’s resources as the Challenged Patent is no longer at issue in the Apple Litigation.<sup>3</sup> Indeed, the Court dismissed the Challenged Patent *with prejudice*, pursuant to the Parties’ joint stipulation, on September 24, 2025. Ex. 2002. Moreover, instituting the Petition would also require an inefficient and considerable 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) a district court trial on the Telcom Ventures Patents, including the Challenged Patent, is scheduled to conclude

---

<sup>3</sup> *See SAP America, Inc. v. Valtrus Innovations Ltd.*, IPR2025-00414, Paper 10 at 2-3 (Director July 10, 2025) (“[I]t is an inefficient use of Board resources to review these challenged patents that have been dismissed from the litigation.”).

well before any final written decision would issue in any of the Apple IPRs.<sup>4</sup> Indeed, the Samsung trial (set for June 1, 2026) will conclude *eight months* before February 8, 2027, the statutory deadline for the Board to issue a final written decision in this IPR.<sup>5</sup>

*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,

---

<sup>4</sup> 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.

<sup>5</sup> *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).

2016.<sup>6</sup> The other seven challenged Telcom Ventures Patents are continuations that the Office has, after a full and complete examination, issued 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.

Moreover, several other factors demonstrate that discretionary denial is appropriate here, including Petitioner’s reliance on expert testimony and the potential for duplicate discovery on issues related to conception and actual reduction to practice of the Challenged Patent. All told, there are many reasons to deny institution, and institution should be denied.

---

<sup>6</sup> 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 years, respectively, creating strong settled expectations for Patent Owner” and instituting IPRs on other patents that issued more recently would be “an inefficient use of Board resources and tips the balance to discretionary denial as to those patent[s] too”).

## 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 Factors”). The Interim Process Memo Factors include:

1. Whether the PTAB or another forum has **already adjudicated** the validity or patentability of the challenged patent claims;
2. Whether there have been **changes in the law** or new judicial precedent issued since issuance of the claims that may affect patentability;
3. The **strength** of the unpatentability challenge (related to *Fintiv* Factor 6);
4. The extent of the petition’s **reliance on expert testimony**;
5. **Settled expectations** of the parties, such as the length of time the claims have been in force;
6. **Compelling** economic, public health, or national security **interests**;  
and

7. Any **other considerations** bearing on the Director’s discretion.

Ex. 2001 at 2-3. In addition to the above, 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). The Board takes a “holistic view” of whether efficiency and integrity of the system are best served by denying or instituting review. *See id.* at I.A.

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

The Director should deny institution because the Challenged Patent was dismissed *with prejudice* from the Apple Litigation on September 24, 2025. *See* Ex. 2002. Consistent with the Director’s prior decisions, it would be “an inefficient use of Board resources to review [] challenged patents that have been dismissed from the litigation.” *See SAP America*, Paper 10 at 2-3 (denying institution where the challenged patents had been dismissed from the parallel proceeding with prejudice); *Ericsson Inc. v. Procomm International Pte. Ltd.*, IPR2024-01452, Paper 16 at 3 (Director June 25, 2025) (same).

Moreover, Apple’s IPR petitions present challenges to patents that will be subject to at least one district court trial 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.

**A. 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.<sup>7</sup> These petitions are thus the second set of patentability challenges on the same set of patents before the Board.<sup>8</sup> *See, e.g., uPI Semiconductor Corp. v. Force MOS Tech. Co. Ltd.*, IPR2025-00920, Paper 12 at 2 (Director Sept. 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

---

<sup>7</sup> *Samsung Electronics Co. v. Telcom Ventures LLC*, IPR2025-00957, -00972, -00973, -00974, -00975, -00976, -00977, -00978 (the “Samsung IPRs”).

<sup>8</sup> In addition, Google filed a third set of patentability challenges on seven of eight of the Telcom Ventures Patents. *See* Paper 4.

determinations in at least one district court trial 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. 2003. 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 9, 2026).<sup>9</sup> Further, 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

---

<sup>9</sup> In Samsung’s Opposition to Patent Owner’s Request for Discretionary 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*, IPR2025-00978, Paper 10 at 18 (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.*

judge’s standing order specifies that the proposed trial date should be within “12-16 months” of the filing date of the Complaint. Ex. 2004 at 3 (“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 October 22, 2025, 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. Ex. 2005. 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.

In sum, it is unlikely that any final written decision in this proceeding will issue before a district court trial occurs 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 of institution is appropriate in this proceeding based on at least the ordered Samsung Litigation trial date and the expected Apple Litigation trial date.

**B. 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. 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”).

While the Challenged Patent itself has been in force only since 2024, this does not undercut Patent Owner’s settled expectations here. *See id.* Indeed, 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, 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 these patents, 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 that support discretionary denial.

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 1:47-50 (“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.

**C. 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, ¶¶ 47-51 *with* Pet. at 4-6; *compare* Ex. 1003, ¶¶ 55-62 *with* Pet. at 1-3; *compare* Ex. 1003, ¶¶ 75-94 *with* Pet. at 7-18; *compare* Ex. 1003, ¶¶ 98-106 *with* Pet. at 21-24). Worse, Petitioner’s obviousness grounds—based on *Carlson* in combination with *ISO-14443*, *Jazayeri*, *Doyle*, *Birch*, *Sherman*, and/or *Murakami*—rely on expert testimony to establish what Petitioner’s contend 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 23-24 (in Ground 1 for limitation 1[a], asserting that “[a] POSITA would have been motivated to modify *Carlson*’s device to implement *Jazayeri*’s biometric authentication process”); *id.* at 26, 35, 45-47, 48, 52 (in Ground 1 for limitations 1[c], 1[g], 1[h], and 1[i], and claim 4, asserting what “[a] POSITA would have understood” based on the testimony of Petitioner’s expert); *id.* at 31 (in Ground 1 for limitation 1[g], asserting what “[a] POSITA reading Claim 1(g) . . . would understand . . . is required”); *id.* at 36-38 (in Ground 1 for limitation 1[g], 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 43-44 (in Ground 1 for limitation 1[g], asserting that “[a] POSITA would have been motivated to further modify *Carlson* . . . consistent with *Jazayeri*’s teachings”); *id.* at 51-52 (in Ground 1 for claim 3, asserting that “[a] POSITA would have been motivated to modify

*Carlson*'s device . . . pursuant to *Jazayeri*'s teachings"); *id.* at 66 (in Ground 2 for limitation 2[pre], asserting that "[a] POSITA would have been motivated to incorporate the repeatedly sensing functionality of *Doyle* into the wireless device of *Carlson-Jazayeri*"); *id.* at 69-70 (in Ground 3, asserting what "[a] POSITA would have understood" and that "[a] POSITA would have been motivated to incorporate *Birch*'s teachings"); *id.* at 71, 72-73 (in Ground 4 for limitations 8[a] and 8[b], asserting what "[a] POSITA would have understood" based on the testimony of Petitioner's expert); *id.* at 74-75 (in Ground 4 for limitation 8[d], asserting that "[a] POSITA would have been motivated to implement *Carlson*'s wireless device and communications network with *Sherman*'s WiMAX mobile communication module"); *id.* at 79-80 (in Grounds 5-8, asserting that a POSITA would have "modif[ied] *Carlson* pursuant to *Murakami*").

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 the Samsung Litigation that is already far advanced (and scheduled for trial well before this proceeding would conclude).

Thus, this factor favors denial of institution.

**D. Other Circumstances Weigh Against Institution**

Other circumstances also weigh against institution here. For example, Apple waited ten months (until August 5, 2025) 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 for a subset of the patents. The purpose of discretionary denial is to “allay[] concerns about inefficiency and duplication of efforts.” *Apple v. Fintiv, Inc.*, No. IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). 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, results 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 additionally will be able to 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, 18-19. 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.”).

Finally, the weakness of the merits of the Petition weigh in favor of discretionary denial. 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).

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

#### **IV. CONCLUSION**

As explained above, the Interim Process Memo factors weigh strongly in favor of discretionary denial. Thus, for the reasons discussed, Patent Owner respectfully submits that the Board should deny institution of all Grounds of the Petition.

Dated: October 7, 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 7, 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 7, 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:

Adam P. Seitz  
Adam.Seitz@eriseip.com

Paul R. Hart  
Paul.Hart@eriseip.com

Christina N. Canino  
Christina.Canino@eriseip.com

Sten Larson  
Sten.Larson@eriseip.com

Eric Brueckner  
Eric.Brueckner@eriseip.com

Khoa Vu  
Khoa.Vu@eriseip.com

Graeme Gillespie  
Graeme.Gillespie@eriseip.com

Service email  
PTAB@eriseip.com

Date: October 7, 2025

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