

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMSCOPE TECHNOLOGIES LLC,
CORNING OPTICAL COMMUNICATIONS LLC,
Petitioners,

v.

DALI WIRELESS, INC.,
Patent Owner.

IPR2022-01293
Patent 10,334,499

**PETITIONER’S PRELIMINARY REPLY TO
PATENT OWNER’S PRELIMINARY RESPONSE TO ADDRESS
NEW EVENTS IMPACTING THE *FINTIV* FACTORS**

This brief addresses new events impacting the *Fintiv* factors.

Factor 2: Proximity of parallel district court trial dates

Patent Owner (PO) has now filed three cases on the ‘499 patent against Petitioners and their customers (T-Mobile, Verizon, AT&T):

(1) *Dali Wireless, Inc. v. T-Mobile US, Inc. et al.*, No. 2:22-cv-414 (E.D. Tex. Oct. 21, 2022) (“**T-Mobile case,” EX-1046**)

(2) *Dali Wireless, Inc. v. Cellco Partnership D/B/A Verizon Wireless et al.*, No. 6:22-cv-00104 (W.D. Tex. Jan. 27, 2022) (“**Verizon case,” EX-1049**)

(3) *Dali Wireless, Inc. v. AT&T Corp.*, No. 2:22-cv-12 (E.D. Tex. Jan. 7, 2022) (“**AT&T case,” EX-1047**).

All three cases should be considered. *HP Inc. et al. v. Neodron Ltd.*, IPR2020-00459, Paper 17 at 36 (PTAB Sept. 14, 2020) (“we must consider ...all venues”).

No trial is scheduled in the T-Mobile case. EX-1048 (listing no scheduling order). When no trial is scheduled, that weighs “significantly against” discretionary denial. *Google LLC v. Uniloc 2017 LLC*, IPR2020-00441, Paper 13 at 35 (PTAB July 17, 2020). The estimated trial date also weighs against a discretionary denial. The estimated trial date is Nov. 2024 compared to the statutory deadline here of March 2024, i.e., the FWD would come 6 months before trial. EX-1050 at 35 (median time-to-trial 24.5 months from filing); EX-1046 (complaint filed Oct. 2022). Further, PO filed this case after the petition.

There is no longer any applicable trial date in the second Verizon case, which also weighs against discretionary denial. Since the PO’s response, the Court

severed and transferred Petitioner CommScope from the W.D. Texas to the E.D. Texas. EX-1051, EX-1052. PO tries to rely on the old case before the transfer. There is no trial date for the transferred case. PO agreed to stay all deadlines until “the Eastern District of Texas sets a new case schedule.” EX-1053 at 3.

The third case, involving AT&T, also does not merit a discretionary denial. After the petition, PO agreed to sever this case into multiple different cases. EX-1054 ¶1. The Court has not set the individual trial dates. PO *estimated* the trial date as January 2024. But since then, the Court ordered the parties to confer regarding consolidating this case with the transferred Verizon case, which would require a new schedule. EX-1055. Lastly, the *old* Verizon case (in W.D. Texas) does not merit a discretionary denial. Petitioners are no longer parties. Further, PO incorrectly says the Court set a trial of Dec. 8, 2023. That is merely a default entry. The Court explained: “Jury Selection/Trial. The Court expects to set this date at the conclusion of the Markman hearing,” which has not happened. EX-2011 at 5. The estimated trial date from the median time-to-trial is June 2024 compared to March 2024 for the FWD, i.e., 3 months before trial. EX-1050 at 37 (median time-to-trial is 28.3 months); EX-1049 (complaint filed Jan. 2022).

Factor 3: Investment in the parallel proceeding by the court and the parties

This factor weighs against discretionary denial. First, PO’s argument based on the old Verizon case in W.D. Texas no longer applies. PO argued the parties

will have completed claim construction and begun discovery by the institution date. Claim construction will not be complete because Petitioner has been transferred to the E.D. Texas, which has not set a claim construction hearing. Discovery has not begun because PO agreed to stay all deadlines. EX-1053 at 3. Second, for the AT&T case, per the schedule entered after the petition, the Court will not have issued any substantive orders before the institution decision—the claim construction hearing and dispositive motions come after March 2023. EX-2008 at 3. This weighs against a discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 10 (PTAB March 20, 2020) (Precedential). Third, PO identified no investment yet in the new T-Mobile case.

Factor 5: Whether petitioner and the defendants in parallel cases are the same

Petitioners are no longer a party to the W.D. Texas case that PO relied upon. Where PO relied on the W.D. Texas case, this factor now favors Petitioners.

Remaining Factors: Factor 1 remains neutral. Factor 4 remains the same, i.e., it weighs against denial because PO conceded “this Petition challenges claims not at issue in the district court litigation.” Paper 7 at 60. Factor 6 remains the same, i.e., it weighs against denial because of the compelling case shown by all claims of the parent patent already being cancelled in IPR based on the same reference (Wu) especially because the examiner found the ‘499 claims overlap with the now-canceled parent claims. Paper 1 at 8-12, 25.

Respectfully submitted,

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By: /Philip P. Caspers /
Philip P. Caspers, Reg. No. 33,227
Samuel A. Hamer, Reg. No. 46,754
Capella Tower, Suite 4200
225 South Sixth Street
Minneapolis, MN 55402
pcaspers@carlsoncaspers.com
shamer@carlsoncaspers.com
Phone: 612.436.9615
Fax: 612.436.9605

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on January 26, 2023, a complete and entire copy of this **Petitioner's Preliminary Reply to Patent Owner's Preliminary Response to Address New Events Impacting the *Fintiv* Factors** was provided via electronic service to the Patent Owner by serving the correspondence address of record as follows:

LEAD COUNSEL David D. Schumann (Reg. No. 53,569) Folio Law Group PLLC 1200 Westlake Ave. N., Ste. 809 Seattle, WA 98109 Email: david.schumann@foliolaw.com Tel: (206) 880-1802	First BACKUP COUNSEL Palani P. Rathinasamy (Reg. No. 63,541) Folio Law Group PLLC 1200 Westlake Ave. N., Ste. 809 Seattle, WA 98109 Email: palani@foliolaw.com Tel: (206) 880-1802
BACK UP COUNSEL Moses Xie (Reg. No. 74,491) Folio Law Group PLLC 1200 Westlake Ave. N., Ste. 809 Seattle, WA 98109 Email: Moses.xie@foliolaw.com Tel: (206) 880-1802	BACK UP COUNSEL Timothy Dewberry (Reg. No. 62,947) Folio Law Group PLLC 1200 Westlake Ave. N., Ste. 809 Seattle, WA 98109 Email: timothy.dewberry@foliolaw.com Tel: (206) 880-1802

/Philip P. Caspers/
Philip P. Caspers, Lead Counsel
Reg. No. 33,227