

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COMMSCOPE TECHNOLOGIES LLC  
CORNING OPTICAL COMMUNICATIONS LLC  
Petitioner,

v.

DALI WIRELESS, INC.,  
Patent Owner.

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Case IPR2022-01293  
Patent 10,334,499

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**PATENT OWNER'S SUR-REPLY  
TO PETITION FOR INTER PARTES REVIEW**

None of the purported “new” events Petitioner identifies in its Preliminary Reply will have a material effect on the *Fintiv* factors.

**I. Factor 2: Proximity of Parallel District Court Trial Dates**

First, Petitioner makes much about the filing of the new T-Mobile case involving the '499 patent. Paper 11 at 1. But the validity of the '499 patent will be adjudicated at least in the earlier E.D. Tex. AT&T cases in October 2023 and the remaining W.D. Tex. case in December 2023, well before the FWD date of March 2024 in this IPR proceeding.

Second, Petitioner claims that because Petitioner's Verizon case in W.D. Tex. was severed and transferred to E.D. Tex., there is no longer any applicable trial date for that case. Paper 11 at 1-2. Petitioner also makes the same argument for its AT&T case in E.D. Tex., alleging that the trial date is unknown because the parties agreed to sever that case into separate cases. *Id.* at 2. The latter is not correct. In the E.D. Tex. cases, the parties agreed to keep the two severed cases consolidated for pretrial purposes, thus preserving the pretrial schedules. Ex. 1054. The original trial date (e.g., October 23, 2023) will remain the same as to one of the two severed cases, with a subsequent trial for the other severed case to follow shortly thereafter. Thus, regardless of when the trial dates for Petitioner's Verizon or T-Mobile cases occur, the validity of the '499 patent will be adjudicated by the AT&T case in E.D. Tex. several months before a FWD issues in this proceeding.

Lastly, Petitioner adds that the actual trial date in the remaining W.D. Tex. case (to which Petitioner is not a party) hasn't been set yet. Paper 11 at 2. However, thus far, there is no reason for the putative trial date of December 2023 in that case to move later. Trial in the W.D. Tex. case is thus also expected to occur before the FWD issues in this proceeding.

## **II. Factor 3: Investment in the Parallel Proceeding by the Court and the Parties**

Petitioner also alleges the lack of investment in the parallel proceedings by narrowly focusing on Petitioner's Verizon case that was recently transferred to E.D. Tex. and how claim construction proceedings, discovery, and dispositive motions in that particular case have not yet begun. Paper 11 at 2-3. However, Petitioner overlooks the fact that substantial investments have already been made with respect to the '499 patent in Petitioner's AT&T case in E.D. Tex., as well as in Petitioner's Verizon case before it was transferred from W.D. Tex. to E.D. Tex. Petitioner and Patent Owner have already invested significant effort and resources in invalidity contentions, infringement source code review, document production, and written discovery in both the AT&T E.D. Tex. case as well as in the Verizon case when it was still in W.D. Tex. Also, the W.D. Tex. case (which includes the '499 patent) already held its *Markman* hearing on January 30. Therefore, despite the yet-to-be scheduled aspects of Petitioner's Verizon case in E.D. Tex., the parties have already made significant investments, including the earlier phases of Petitioner's Verizon

case in W.D. Tex. and Petitioner's AT&T case in E.D. Tex. for which trial will occur long before the FWD issues in this proceeding.<sup>1</sup>

**III. Factor 5: Whether Petitioner and Defendants in Parallel Cases Are the Same**

Petitioner claims that this factor favors against a denial because Petitioner is no longer a party to the W.D. Tex. case after its Verizon case was transferred to E.D. Tex. Paper 11 at 3. However, Petitioner is still a party to the AT&T case in E.D. Tex. which will have a trial well before the FWD in this proceeding issues.

**IV. Factor 6: Other Circumstances Including the Merits**

Petitioner argues that it has shown a compelling case on the merits because the '499 claims allegedly overlap with the claims of the '178 patents which were cancelled in another IPR asserting the same Wu reference. Paper 11 at 3. Patent Owner's Preliminary Response has demonstrated, however, that the '178 patent does not claim "radio resources" and was not directed to the management of "radio resources" which the Wu reference fails to disclose. *See, e.g.*, POPR, Paper 7 at 23-42.

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<sup>1</sup> Petitioner points out that no investments have been identified for the new T-Mobile case. But the fact remains that validity for the '499 patent will be adjudicated in the earlier W.D. Tex. and E.D. Tex. cases well before the FWD issues in this proceeding.

Dated: February 1, 2023

Respectfully Submitted,

/David D. Schumann/

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(Case No. IPR2022-01293)

*Attorneys for Patent Owner*

**CERTIFICATE OF SERVICE**

As authorized by Patent Owner's Mandatory Notice, I hereby certify that on February 1, 2023, a copy of this document has been served in its entirety by electronic mail on Petitioner's lead and backup counsel.

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