

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T SERVICES INC., T-MOBILE USA, INC., CELLCO
PARTNERSHIP D/B/A VERIZON WIRELESS, ERICSSON INC.,
AND NOKIA OF AMERICA CORPORATION,
Petitioners

v.

ASUSTEK COMPUTER INC.
Patent Owner

Case IPR2024-00992
U.S. Patent No. 10,951,359

PETITIONERS' PRELIMINARY REPLY

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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LIST OF EXHIBITS

Exhibit No.	Description	Previously Submitted
Ex-1001	U.S. Patent 10,951,359 (“the ’359 patent”)	X
Ex-1002	Declaration of Dr. Zygmunt Haas	X
Ex-1003	Curriculum Vitae of Dr. Zygmunt Haas	X
Ex-1004	U.S. Patent No. 10,945,251 (“Nogami”)	X
Ex-1005	U.S. Patent No. 11,025,456 (“Chatterjee”)	X
Ex-1006	3GPP TS 38.213 v15.2.0 (2018-06), “3rd Generation Partnership Project; Technical Specification Group Radio Access Network; NR; Physical layer procedures for control (Release 15) (“3GPP-Specification”)	X
Ex-1007	Declaration of Craig Bishop	X
Ex-1008	U.S. Patent Publication No. 2018/0324770 (“Nogami-770”)	X
Ex-1009	“CORESET Configuration and search space design,” Huawei, HiSilicon, 3GPP TSG RAN WG1 Meeting #90bis, Prague, Czech Republic, Oct. 9-13, 2017) (“Huawei-CORESET”)	X
Ex-1010	File history of U.S. Patent 10,951,359	X
Ex-1011	File history of U.S. Prov. App. No. 62/619,041 (“Huang-prov”)	X
Ex-1012	File history of U.S. Prov. App. No. 62/586,378 (“Nogami-provisional”)	X
Ex-1013	File history of U.S. Prov. App. No. 62,617,106 (“Chatterjee-provisional”)	X
Ex-1014	International Publication No. Wo2019/099388 (“Nogami-PCT”)	X
Ex-1015	June 21, 2022 Interim Procedure for Discretionary Denials in AIA Post-grant Proceedings with Parallel District Court Litigation	X
Ex-1016	Docket Control Order (Dkt. 52) in <i>ASUS Technology Licensing Inc. v. AT&T Inc.</i> ,	X

Exhibit No.	Description	Previously Submitted
	No. 2:23-CV-486 (E.D. Tex. Feb. 16, 2024)	
Ex-1017	Order (Dkt. 13) in <i>Innovative Sonic Limited et al v. AT&T Inc. et al</i> , No. 2:23-cv-00489 (E.D. Tex. Feb. 9, 2024)	X
Ex-1018	3GPP TS 38.213 v15.0.0 (2018-12), “3rd Generation Partnership Project; Technical Specification Group Radio Access Network; NR; Physical layer procedures for control (Release 15)	X
Ex-1019	NTT Docomo, Inc., “Summary of key aspects for search space,” 3GPP TSG RAN WG1 Meeting 90bis, Prague, CZ, Oct. 9-13, 2017, R1-1718834 (“NTT”)	X
Ex-1020	File history of U.S. Prov. App. No. 62/501,494 (“Nogami-770-prov”)	X
Ex-1021	October 1, 2024 Letter to Litigation Counsel re Prior Art Stipulation in IPR2024-00992	

Petitioners AT&T Services Inc., T-Mobile USA, Inc., Cellco Partnership d/b/a Verizon Wireless, Ericsson Inc., and Nokia of America Corporation (collectively, “Petitioners”) submit this Preliminary Reply as authorized by the Board in its email dated October 4, 2024. The Board should not deny institution under *Fintiv* because Petitioners have substantially reduced or eliminated any risk of duplicative litigation by stipulating that they will not pursue invalidity challenges in the underlying district court litigation on the grounds or the primary prior art references asserted in the Petition. Ex-1021.

Petitioners’ stipulation addresses the concerns raised in the Patent Owner Preliminary Response (POPR, Paper 10) analysis of *Fintiv* Factor 4 (POPR at 78-81) that “*Sands Revolution*-style stipulations do little to eliminate overlap with the district court litigations.” POPR at 79-80. Under Petitioners’ stipulation, there will be substantially less overlap between the evidence of unpatentability presented in this proceeding and any invalidity analysis presented in the related district court case.

The cases cited by Patent Owner in connection with its analysis of *Fintiv* Factor 4 are distinguishable on the facts. In *LG Elecs., Inc. v. Ancora Techs., Inc.*, No. IPR2021-00581, Paper 16 at 9-10 (PTAB June 10, 2021), the Board held that “Petitioner LG’s stipulation, however, somewhat mitigates the ‘concerns of inefficiency and the possibility of conflicting decisions.’” *Id.* Moreover, the Board’s

Fintiv analysis in that case turned on Factor 2 and the fact that trial in the underlying litigation was set to begin more than *eight months* before a Final Written Decision would be due in the proceeding which Petitioner seeks to join” as well as Factor 3 and the fact that “the parties have already finished claim construction and expert discovery, and dispositive motions including summary judgment are fully briefed.” *Id.* at 8 (emphasis in original), 9.

Similarly, in *Samsung Elecs. Co., LTD. v. California Institute of Technology*, IPR2023-00130, Paper 10 (PTAB May 4, 2023), the Board held that “Petitioner’s stipulation mitigates some concerns of duplicative efforts between the district court and the Board.” *Id.* at 19. The Board’s decision in that case turned, again, on other facts, including its Factor 3 analysis where “[b]oth parties acknowledge that the court in the Underlying Litigation has already issued a claim construction order” and that “the advanced stage of expert discovery is the most significant factor for our analysis” because “Petitioner should have already served its opening expert report on validity” and “the deadline for rebuttal expert reports is only days away.” *Id.* at 17. Further, the *Samsung* petition was “the sixth IPR against the ’710 patent, and none of the prior five found even a single claim unpatentable.” *Id.* at 21.

Thus, in both *LG* and *Samsung*, the Board recognized that the *Fintiv* stipulations mitigated concerns regarding duplicative results. The ultimate *Fintiv* analysis, however, was clouded by facts that do not exist in this proceeding.

In this proceeding, the investment in the district court case has been minimal because fact discovery is in its infancy, the parties have not engaged in expert discovery, there have been no substantive orders in the case, and proposed constructions of disputed claim terms were only exchanged late last week. Petition (Paper 1), 65; Ex-1016 at 5 (Docket Control Order).

Because the stipulation offered by Petitioners simplifies issues between the Board and the district court, and because it minimizes overlap between those proceedings, the Board should weigh the *Fintiv* factors in favor of Petitioners and not exercise its discretion to deny institution.

Date: October 18, 2024

Respectfully submitted,

/ Scott W. Hejny /

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the above-captioned **PETITIONERS'**
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