

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.

ASUS TECHNOLOGY LICENSING INC.,
Patent Owner

IPR2024-00992
Patent No. 10,951,359

**PATENT OWNER RESPONSE TO
PETITIONERS' PRELIMINARY REPLY**

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Patent Owner ASUS Technology Licensing Inc. (“PO”) submits this Response to Petitioners’ Preliminary Reply as authorized by the Board’s October 4, 2024 email.

The Petition stipulates that “if trial is instituted, Petitioners will not pursue this IPR’s Grounds in the district court litigation.” Pet., 66-67. Petitioners’ new stipulation adds “or the primary prior art references.” EX1021. This new stipulation adds little to the previous stipulation. The primary prior art reference in all three grounds in this IPR is Nogami. Pet., 2. Ground 1 is obviousness over Nogami. *Id.* Thus, the Petition already stipulated not to pursue Nogami in the district court litigation because it is a ground in the IPR.

Further, this is a field where Petitioners could easily replace Nogami with duplicative prior art. As discussed in the preliminary response, the ’359 Patent is directed to specific problems in the existing 3GPP 5G specification with respect to CORESET configuration. Paper 10, 8-12. The claim limitation that addresses this problem is “not allowing to transmit the signal such that an interval between any two bit positions with the value of one in the set of bit positions in the bit map is smaller than the first duration.” EX1001 [’359 Patent], cl. 1. *See id.*, cls. 12, 22.

The Petition reflects this, arguing that Nogami discloses each limitation but the “not allowing” limitation, but conceding that Nogami does not disclose this limitation. Pet., 22 (“Nogami in view of the knowledge of a POSITA discloses or

suggests this limitation.”). Indeed, Nogami simply replaces the Huawei-CORESET reference relied on by the examiner to argue it discloses the same known CORESET functionality in the same way without disclosing the missing “not allowing” limitation. Pet., 10 (“the Examiner allowed the claims, stating in the Notice of Allowance that Huawei-CORESET “does not disclose the limitation *not allowing to transmit...*”); EX1010 [’359 Patent FH], 158; EX1009 [Huawei-CORESET]. Under Petitioners’ stipulation, Petitioners can simply replace Nogami with another 3GPP reference discussing the same existing CORESET functionality that Petitioners rely on Nogami for in this IPR.

Petitioners attempt to distinguish the *LG* and *Samsung* decisions cited in the POPR, arguing that the stipulations there somewhat mitigate the concerns of inefficiency and conflicting decisions. Paper 12, 1-2. For the reasons discussed above, Petitioners’ stipulation does not mitigate these concerns. Petitioners rely on Nogami for its discussion of existing CORESET functionality that is duplicative of other documents discussing existing CORESET functionality.

In addition, the timing concerns here are similar to those in *LG* and *Samsung*, where the Board denied institution. Trial in the district court is scheduled at least four to five months before the deadline for a final written decision and significant investments have been made and continue to be made in the district court litigation. The Markman process is already underway and the district court Markman hearing

is scheduled shortly after the deadline for institution. Paper 10, 74-78; EX1016, 3-4. The parties are already well into fact discovery, with several depositions having occurred already and substantial completion of document production required by January 16, 2025. The parties have also already exchanged their contentions as to infringement and invalidity, including supplementation based on review of source code for the accused products. Fact discovery closes on March 3, 2025 and expert discovery closes on April 7, 2025. EX1016, 3.

Moreover, Petitioners do not attempt to distinguish *Google LLC v. EcoFactor Inc.*, IPR2021-00454, Paper 9 (PTAB July 22, 2021) or *Roku, Inc. v. IOENGINE, LLC*, IPR2022-01554, Paper 11, 13-14 (PTAB May 5, 2023) (cited at POPR, 79), which both also denied institution under *Fintiv* under similar facts to those present here. In *Google*, the Board held a trial scheduled roughly 5 months before a FWD weighed against institution. IPR2021-00454, Paper 9 at 10. Similarly, in *Roku*, trial scheduled roughly six months before a FWD was due “weigh[ed] heavily in favor of discretionary denial of institution.” IPR2022-01554, Paper 11 at 11.

Petitioners’ stipulation does not simplify the issues between the Board and the district court. Accordingly, it is not entitled to weight under the *Fintiv* analysis. The *Fintiv* factors favor denying institution.

Dated: November 1, 2024

Respectfully submitted,

/ Stephen McBride /

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on November 1, 2024, a copy of the foregoing document **PATENT OWNER RESPONSE TO PETITIONERS' PRELIMINARY REPLY** was served by electronic mail, as consented to by Petitioners, upon the following:

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