

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

IPR2024-00997
Patent No. 10,798,754

**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., 52. Petitioners’ new stipulation adds “or the primary prior art references asserted in that Petition.” EX1012. This new stipulation adds little to the previous stipulation because Petitioners rely on the primary references in this IPR for their disclosure of existing 3GPP 5G functionality, which is duplicative of related standards documents discussing 3GPP TS 38.300.

Specifically, the primary reference in Ground 2 (3GPP TS 38.300, EX1007) is a 3GPP 5G Technical Specification. Pet., 3; EX1007. The primary reference in Ground 1 (R2-1704250, EX1005) is a contemporaneous 3GPP 5G technical contribution. Pet., 3; EX1005. Petitioners rely on R2-1704250’s disclosure of substantially the same 3GPP 5G functionality disclosed in the 3GPP TS 38.300 specification. Paper 11 (POPR), 39-41. Moreover, the primary reference relied on and discussed by the Examiner during prosecution (R2-1707351, EX2011) is discussing the same functionality disclosed in 3GPP TS 38.300. Paper 11, 33-39.

Under Petitioners’ stipulation, Petitioners can simply identify another 3GPP technical contribution or patent document discussing the same relevant

functionality as 3GPP TS 38.300 and use that document to advance substantially the same arguments made not only in this IPR, but considered and rejected by the Examiner during prosecution. Petitioners' stipulation not to use 3GPP TS 38.300 and R2-1704250 therefore does nothing to reduce the risk of duplicative litigation because Petitioners would still be free to advance arguments that are duplicative and cumulative to the arguments made in this IPR and during prosecution.

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' new stipulation does not mitigate these concerns. Petitioners rely on 3GPP TS 38.300 and R2-1704250 for their discussion of existing 3GPP TS 38.300 functionality. Petitioners would be free to advance substantively the same prior art arguments in district court as have already been made in this IPR and during prosecution by using related 3GPP standards documents discussing substantially the same 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 11, 45-50; EX1010, 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. EX1010, 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, 50-51), which both also denied institution under *Fintiv* under similar facts to those present here. In *Google*, the Board held 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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