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

Case IPR2024-01121
U.S. Patent No. 10,148,402

PETITIONERS' PRELIMINARY REPLY

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

LIST OF EXHIBITS

Exhibit No.	Description	Previously Submitted
1001	U.S. Patent No. 10,148,402 to Lin et al. ("the '402 patent")	X
1002	File History of U.S. Patent No. 10,148,402	X
1003	Declaration of Alexander Haimovich, Ph.D.	X
1004	*Curriculum Vitae* of Alexander Haimovich, Ph.D.	X
1005	WIPO Publication No. WO2017/142573A1 ("Moon")	X
1006	R1-1609515, "On network beam switching and refinement (BM P-2)", 3GPP submission at 3GPP TSG-RAN WG1 Meeting #86bis by Intel	X
1007	Declaration of Craig Bishop	X
1008	Dahlman, E., Parkvall, S., & Sköld, J. (2016), *4G, LTE-Advanced Pro and the Road to 5G* ("Dahlman 2016")	X
1009	June 21, 2022 Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation	X
1010	Docket Control Order	X
1011	Consolidation Order	X
1012	R1-1613206, "WF on CDM Aggregation for 32 and 24 CSI-RS Ports," 3GPP submission at 3GPP TSG-RAN WG1 Meeting #87	X
1013	R1-162686, "Specification impact of aperiodic CSI-RS," 3GPP submission at 3GPP TSG-RAN WG1 Meeting #84bis	X
1014	R1-166056 - Final Report of 3GPP TSG RAN WG1 #85 v1.0.0 (Nanjing, China 23rd – 27th May 2016)	X
1015	R1-165642, "WF on Beamformed CSI-RS," 3GPP submission at 3GPP TSG-RAN WG1 Meeting #85	X

Exhibit No.	Description	Previously Submitted
1016	November 22, 2024 Letter to Litigation Counsel re Prior Art Stipulation in IPR2024-01121	
1017	Memorandum Order, Staying Case No. 2:23-cv-00486-JRG-RSP (Lead Case)	

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 December 10, 2024. The Board should not deny institution under *Fintiv* because Petitioners have 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 prior art references asserted in this Petition**. Ex-1016 (prior art stipulation). Moreover, in contrast with the cases cited by Patent Owner in its discussion of *Fintiv* Factor 4, **this case has been stayed**. Ex-1017 (Order staying the case).

Petitioners' stipulation addresses the concerns raised in the Patent Owner Preliminary Response (POPR, Paper 11) analysis of *Fintiv* Factor 4 (POPR at 26-29) that "*Sands Revolution*-style stipulations do little to eliminate overlap with the district court litigations." POPR at 27. Under Petitioners' stipulation, there will be no overlap between the evidence of unpatentability presented in this proceeding and any invalidity analysis presented in the related district court case because Petitioners have agreed not to pursue invalidity arguments in the district court litigation against the Challenged Claims on the grounds or prior art references asserted in this Petition.

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. Further, in this case Petitioners' stipulation eliminates overlap between prior art asserted in the Petition and in the district court.

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, as noted above, the case is currently stayed. Petition (Paper 1), 50-52; Ex-1010 at 5 (Docket Control Order); Ex-1017 (Order staying the case).

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

Date: December 17, 2024

Respectfully submitted,

/ Scott W. Hejny /
Scott W. Hejny
Reg. No. 45,882
shejny@mckoolsmith.com
Nicholas Mathews
Reg. No. 66,067
nmathews@mckoolsmith.com
Christian J. Hurt
Reg. No. 63,659
churt@McKoolSmith.com
McKool Smith, P.C.
300 Crescent Court, Suite 1500
Dallas, Texas 75201
Telephone: 214-978-4000
Facsimile: 214-978-4044

Attorneys for Petitioners AT&T Services Inc., T-Mobile USA, Inc., Cellco Partnership d/b/a Verizon Wireless, Ericsson Inc., and Nokia of America Corporation

CERTIFICATION OF SERVICE

The undersigned hereby certifies that the above-captioned **PETITIONERS' PRELIMINARY REPLY** is being served on counsel for Patent Owner via electronic mail to the following attorneys of record:

James T. Carmichael
jim@carmichaelip.com

Stephen McBride
stevemcbride@carmichaelip.com

Stephen Schreiner
schreiner@carmichaelip.com

Minghui Yang
mitch@carmichaelip.com

CelerityIPRs@carmichael.com

/ Scott W. Hejny /
Scott W. Hejny
Reg. No. 45,882
shejny@mckoolsmith.com