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 IPR2024-01142

U.S. Patent No. 10,887,868

PATENT OWNER'S AUTHORIZED PRELIMINARY SUR-REPLY

EXHIBIT LIST	
2001	Reserved
2002	Reserved
2003	Reserved
2004	Reserved
2005	LegalMetric District Report for Texas Eastern District Court in Patent Cases (January 2019-April 2024)
2006	United States District Courts—National Judicial Caseload Profile for 12-month period ending June 30, 2024; available at https://www.uscourts.gov/statistics-reports/analysis-reports/federal-court-management-statistics
2007	Defendants' P.R. 3-3 Invalidity Contentions from *ASUS Technology Licensing Inc. and Celerity IP, LLC v. AT&T Corp. et al.*, No. 2:23-cv 490 (lead), -489, -491, E.D. Tex., April 12, 2024
2008	Official Transcript of November 19, 2024 Case Management Conference before Judge Roy S. Payne from *Celerity IP LLC et al v. AT&T Corp. et al.*, No. 2:24-cv-00721-JRG-RSP, E.D. Tex., November 21, 2024
2009	Plaintiff's Motion for Leave to File Amended Pleading Dismissing with Prejudice Antitrust, Tortious Interference, and Unfair Competition Claims from *Celerity IP LLC et al v. AT&T Corp. et al.*, No. 2:24-cv-00721-JRG-RSP, E.D. Tex., December 6, 2024
2010	Exhibit A, Plaintiff's Second Amended Complaint from *Celerity IP LLC et al v. AT&T Corp. et al.*, No. 2:24-cv-00721-JRG-RSP, E.D. Tex., December 6, 2024
2011	Plaintiff's Notice of Mootness of Defendants' Motions to Dismiss from *Celerity IP LLC et al v. AT&T Corp. et al.*, No. 2:24-cv-00721-JRG-RSP, E.D. Tex., December 6, 2024
2012	Plaintiff's Motion to Lift Stay from *ASUS Technology Licensing Inc. and Celerity IP, LLC v. AT&T Corp. et al.*, No. 2:23-cv 486 (lead), E.D. Tex., December 7, 2024
2013	Notice of Hearing on Defendant's Motion to Dismiss from *Celerity IP LLC et al v. AT&T Corp. et al.*, No. 2:24-cv-00721-JRG-RSP, E.D. Tex., December 4, 2024
2014	Plaintiff's Motion for Expedited Briefing on the Motion to Lift Stay from *ASUS Technology Licensing Inc. and Celerity IP, LLC v. AT&T Corp. et al.*, No. 2:23-cv 486 (lead), E.D. Tex., December 7, 2024

2015	Defendants' Opposition to Motion to Expedite Briefing on Plaintiff's Motion to Lift Stay from *ASUS Technology Licensing Inc. and Celerity IP, LLC v. AT&T Corp. et al.,* No. 2:23-cv 486 (lead), E.D. Tex., December 9, 2024
2016	Plaintiff's Reply in Support of Motion to Expedite Briefing on Plaintiff's Motion to Lift Stay from *ASUS Technology Licensing Inc. and Celerity IP, LLC v. AT&T Corp. et al.,* No. 2:23-cv 486 (lead), E.D. Tex., December 9, 2024
2017	Patent Owner's Opening *Markman* Brief from *ASUS Technology Licensing Inc. and Celerity IP, LLC v. AT&T Corp. et al.,* No. 2:23-cv 486 (lead), E.D. Tex., December 9, 2024
2018	Reserved
2019	Defendants' Opposition in Part to Plaintiff's Motion for Leave to File Amended Pleadings from *Celerity IP LLC et al v. AT&T Corp. et al.*, No. 2:24-cv-00721-JRG-RSP, E.D. Tex., December 6, 2024
2020	Patent Owner's Revised Case Schedule from *ASUS Technology Licensing Inc. and Celerity IP, LLC v. AT&T Corp. et al.,* No. 2:23-cv 486 (lead), E.D. Tex., December 9, 2024
2021	Defendants' Response to Plaintiff's Motion to Lift Stay from *ASUS Technology Licensing Inc. and Celerity IP, LLC v. AT&T Corp. et al.,* No. 2:23-cv 486 (lead), E.D. Tex., December 9, 2024

As authorized by the Board in an email dated December 17, 2024, PO responds to Petitioner's Preliminary Reply (Paper 12). Institution should be denied under *Fintiv* because Petitioner's stipulation is not meaningfully broader than its original *Sand Revolution* stipulation. Further, the district court case is only momentarily stayed to address an antitrust issue unrelated to any PTAB proceeding, PO has since mooted that antitrust issue, and the stay is expected to be lifted on January 23, 2025. The current trial setting has not been continued and would still be expected well ahead of the projected deadline for a Final Written Decision even if impacted by the brief stay.

Fintiv factor one analyzes whether the district court case has been or will be stayed pending resolution of a PTAB trial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at *6 (PTAB March 20, 2020) ("A district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts."). That is not the case here. Rather, the district court temporarily stayed the parallel case only because PO asserted both infringement and antitrust claims against Petitioners and the court was concerned of a "chilling effect" if antitrust claims were pending while a joint defense of the infringement claims was ongoing. EX1020, 5; EX2008, 22:23-23:6. A brief stay to quickly resolve an antitrust issue should not implicate factor one. EX2008, 27:21-23 ("The Court: I don't need for there to be a

pause. I think this should be something that can be decided very quickly.”).

PO immediately moved to dismiss its antitrust claims with prejudice and to lift the stay. EX2009-2010. PO sought expedited resolution of its motion. The district court (at Petitioners’ request) calendared the motions to dismiss and lift the stay for a January 23, 2025 hearing in order to allow for complete briefing. EX2013, EX1021. Petitioners have since filed their brief indicating no substantive objection to the dismissal of PO’s antitrust claims with prejudice, eliminating the basis for the stay. *See* EX2019, 5-6, 11; EX2008, 27:21-23, 27:7-8 (The Court expressing that PO’s dismissal with prejudice “would be the end of that concern.”). Petitioners’ brief on the Motion to Lift Stay agrees resolution of PO’s amended pleadings will lift the stay and require only a “modest” amendment to the schedule. EX2021. Thus, there is no reason to believe the case will remain stayed past the January 23 hearing, which at this point appears to be no more than a formality.

A stay of less than 50 days minimally impacts the case schedule and does not meaningfully change the factor two analysis. The district court has not continued the trial date, and there is no reason to believe the court will do so. PO has already proposed a revised case schedule that accounts for the stay without impacting the trial date. EX2020. Even if the trial date were to shift by 1.5 months (the length of the stay)

to September 2025, the Final Written Decision would still issue more than four months after the trial. Under *Ericsson*, IPR2022-01233, Paper 12, that is sufficient for factor two to weigh in favor of denying institution.

For *Fintiv* factor four, Petitioners' new stipulation adds "or the primary prior art references" to their previous *Sand Revolution* stipulation not to "pursue this IPR's Grounds in the district court litigation." This new stipulation adds little to the prior one. Jung and Xiong are both a ground and the primary references of this IPR, so Petitioners' new stipulation merely repeats their original stipulation not to pursue Jung and Xiong. But Petitioners are free to pursue other combinations of patents and printed publications, such as Kim, Zhang, and Koskela, or any 3GPP specification. EX2007, 11. These other arts contain overlapping disclosures on beam pair selection and may supply similar teachings. Petitioners' new stipulation does not reduce the chance that the district court will address the same patentability issues as decided here.

Petitioners attempt to distinguish PO's cases by alleging differences in the factor 2 and 3 analysis. But as explained, the district court anticipates the stay to be brief and minimally impact the schedule. The parties are already well into fact discovery, depositions have occurred, and PO has already filed its opening *Markman* brief, with other deadlines imminent when the stay is lifted. EX2017.

Dated: January 1, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on January 1, 2025, a copy of the foregoing documents **PATENT OWNER PRELIMINARY SUR-REPLY AND EXHIBITS** were served by electronic mail, as consented to by Petitioner, upon the following:

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