

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T SERVICES, INC., AND NOKIA OF AMERICA CORP.;
Petitioner,

v.

ADAPTIVE SPECTRUM AND SIGNAL ALIGNMENT, INC.,

Patent Owner.

Case: IPR2025-00451

U.S. Patent No. 9,954,631

**JOINT MOTION TO TERMINATE PROCEEDING AND TO TREAT
THE AGREEMENT AS BUSINESS CONFIDENTIAL**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
US Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

LIST OF EXHIBITS

Exhibit	Short Name	Description
Ex-1001	'631 patent	U.S. Patent No. 9,954,631
Ex-1002	'631 File History	File History of U.S. Patent No. 9,954,631
Ex-1003	Gitlin Declaration	Declaration of Dr. Richard D. Gitlin
Ex-1004	Bingham	U.S. Patent No. 5,680,394 to Bingham
Ex-1005	Strobel	U.S. Patent No. 9,531,491 to Strobel
Ex-1006	Strobel '943 Provisional	U.S. Provisional Patent Application No.61/601,943
Ex-1007	Strobel '270 Provisional	U.S. Provisional Patent Application No. 61/598,270
Ex-1008	Kuipers	ITU Temporary Document 2012-06-4A-061 by ADTRAN, titled "G.fast: A flexible framing structure"
Ex-1009	Wei	ITU Temporary Document 2012-06-4A-040 by Wei
Ex-1010	Cioffi	U.S. Patent No. 5,887,032 patent to Cioffi
Ex-1011	Liu	U.S. Patent No. 6,754,261
Ex-1012	Joint Claim Construction Statement	Joint Claim Construction Statement, Exhibit A, <i>Adaptive Spectrum and Signal Alignment, Inc. v. AT&T Inc. et al.</i> , No. 24-cv-00029-JRG-RSP, Dkt. 105-1 (E.D. Tex. July 22, 2024)
Ex-1013	Lantiq Contribution	ITU Temporary Document 2012-02-4A-054 by Oksman
Ex-1014	CV	<i>Curriculum Vitae</i> of Richard Gitlin
Ex-1015	Grami	Grami, Introduction to Digital Communications, Academic Press, 2016. Chapter 11

Exhibit	Short Name	Description
Ex-1016	G.9701	Fast access to subscriber terminals (G.fast) – Physical layer specification
Ex-1017	Docket Control Order	Docket Control Order, <i>Adaptive Spectrum and Signal Alignment, Inc. v. AT&T Inc. et al.</i> , No. 24-cv-00029-JRG-RSP, Dkt. 84 (E.D. Tex. July 22, 2024)
Ex-1018	Order Focusing Claims	Order Focusing Patent Claims and Prior Art to Reduce Costs, <i>Adaptive Spectrum and Signal Alignment, Inc. v. AT&T Inc., et al.</i> , Case No. 2:24-cv-00029-JRG-RSP (E.D. Tex. Oct. 23, 2024), ECF No. 104.
Ex-1019	Motion to Transfer	Defendants’ Motion to Transfer Venue Based on the Parties’ Contractual Forum-Selection Clause, and Alternatively, Motion to Stay Case Pending Arbitration, <i>Adaptive Spectrum and Signal Alignment, Inc. v. AT&T Inc., et al.</i> , Case No. 2:24-cv-00029-JRG-RSP (E.D. Tex. Oct. 23, 2024), ECF No. 92 (<i>Redacted</i>).
Ex-1020	Gagnaire	Maurice Gagnaire, <i>Broadband Local Loops for High-Speed Internet Access</i> (Artech House, 2003).
Ex-1021	DSL Advances	Thomas Starr, et al., <i>DSL Advances</i> , (Prentice Hall, 2002).
Ex-1022	ISDN Architecture	Richard T. Roca, <i>ISDN architecture</i> (AT&T Technical Journal, 1986).
Ex-1023	Gitlin	U.S. Patent No. 4,924,492 to Gitlin
Ex-1024	Data Communication Principles	Richard D. Gitlin, Jeremiah F. Hayes and Stephen B. Weinstein, <i>Data Communication Principles</i> (Plenum Press, 1992).
Ex-1025	A Review of HDSL Progress	Joseph W. Lechleider, <i>High Bit Rate Digital Subscriber Lines: A Review of HDSL Progress</i> , Vol. 9, No. 6, IEEE Journal on Selected Areas in Comm. 769 (1991).

Exhibit	Short Name	Description
Ex-1026	Strobel Article	Strobel, <i>Channel Modeling and Physical Layer Optimization in Copper Line Networks</i> , (Springer, 2019).
Ex-1027	ITU Work Program	ITU Temporary Document 2012-06-4A-A20 titled “G.fast: Work programme for G.fast”
Ex-1028	Broadband Access Networks	Leif Aarthun Ims, <i>Broadband Access Networks</i> (Springer, 1998)
Ex-1029	Issues List	ITU Temporary Document 2012-06-4A-U20R1
Ex-1030	NF-085	ITU Temporary Document NF-085
Ex-1031	CI-075	ITU Temporary Document CI-075
Ex-1032	ITU Global Directory	ITU Global Directory from Wayback Machine, dated December 6, 2000
Ex-1033	ITU-T Guide	ITU-T Guide for Beginners, March 2005, International Telecommunication Union
Ex-1034	Agreement	Agreement between Nokia, AT&T, and ASSIA

Petitioners AT&T Services, Inc. (“AT&T”) and Nokia of America Corp. (“Nokia”) (collectively, “Petitioners”) and Patent Owner Adaptive Spectrum and Signal Alignment, Inc. (“Patent Owner” or “ASSIA”) have reached a settlement. Under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioners and ASSIA jointly move to terminate the present *inter partes* review proceeding and request that the Agreement be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Board authorized the parties to file this Joint Motion on June 10, 2025 via email.

I. STATEMENT OF FACTS

A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26, at *2 (July 28, 2014).

Patent Owner filed a patent infringement lawsuit alleging infringement of U.S. Patent No. 9,954,631 in the United States District Court for the Eastern District of Texas, captioned *Adaptive Spectrum and Signal Alignment, Inc. v. AT&T Inc., et al.*, 2:24-cv-00029. On April 14, 2025, the court dismissed with prejudice ASSIA’s

claims of infringement related to the '631 patent, as well as the remainder of ASSIA's claims in the case. The court dismissed without prejudice AT&T's remaining claims.

AT&T, Nokia, and ASSIA (collectively, the "Parties") subsequently reached an agreement (the "Agreement") to resolve their remaining disputes.

Under 37 C.F.R. § 42.74(b), the Agreement is in writing. A true and correct copy is being filed as Exhibit 1034. The Agreement is being filed electronically with access to "Board and Parties Only."

Pursuant to the Board's email dated June 10, 2025, as part of this Joint Motion the Parties separately request to treat the Agreement as business confidential information and keep it separate from the files of the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). This agreement contains confidential commercial and financial information of the Parties.

II. RELIEF REQUESTED

The Parties request termination of this *inter partes* review and respectfully submit that such termination is justified. The Parties also request that the Agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). "There are strong public policy reasons to favor settlement between the parties to a proceeding." Consolidated Trial Practice Guide 86 (Nov. 2019). "The Board expects that a proceeding will

terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” *Id.* (citing 35 U.S.C. §§ 317(a)).

The Board should terminate this proceeding, as the Parties jointly request, for the following reasons.

First, the Parties have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). In fact, the Board has not yet issued a decision on institution, conducted an oral hearing, or otherwise resolved the merits of the Petition. Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions recited in 35 U.S.C. § 317(a).

Second, the Parties have reached a settlement as to all the disputes in this proceeding and as to the ’631 patent. A true copy of the Agreement is being filed concurrently herewith. *See* Exhibit 1034. This agreement contains confidential commercial and financial information of the Parties. the Parties request that the Agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). The Parties hereby represent that the documents filed as Exhibits 1034 represent all agreements made in connection with, or in contemplation of, the termination of this proceeding.

This agreement, in the form of the Agreement (Ex. 1034), has been filed with the Board as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

Third, termination would save significant further expenditure of resources by the Parties. Termination upon settlement, as requested, would also further the purpose of *inter partes* review proceedings, which seeks to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

III. CONCLUSION

For the foregoing reasons, the Parties respectfully request termination of this *inter partes* review and request that the Agreement be treated as business confidential information pursuant.

Date: June 18, 2025

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CERTIFICATE OF SERVICE

Patent Owner has consented to email service in this proceeding. Pursuant to 37 C.F.R. §§42.6, the undersigned hereby certifies that a true and correct copy of the foregoing JOINT MOTION TO TERMINATE PROCEEDING AND TO TREAT THE AGREEMENT AS BUSINESS CONFIDENTIAL, and all associated exhibits were served in their entireties on June 18, 2025, upon the Patent Owner at the following email addresses of Patent Owner's litigation counsel:

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