

Case IPR2025-00756  
Patent No. 10,764,803  
Patent Owner's Preliminary Sur-Reply

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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ONEPLUS TECHNOLOGY (SHENZHEN) CO., LTD.,  
Petitioners,

v.

PANTECH CORPORATION,  
Patent Owner

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**Case: IPR2025-00756**

**U.S. Patent No. 10,764,803**

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**PATENT OWNER'S PRELIMINARY SUR-REPLY**

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U.S. Patent and Trademark Office  
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**PATENT OWNER’S EXHIBIT LIST**

| <b>Exhibit No.</b> | <b>Description</b>   |
|--------------------|--|
| 2001               | Second Amended Docket Control Order, <i>Pantech Corporation and Pantech Wireless, LLC v. OnePlus Technology (Shenzhen) Co., Ltd.</i> , No. 5:24-CV-00038-RWS-JBB (E.D. Tex.) (Dkt. 58) (May 13, 2025)            |
| 2002               | United States District Courts – National Judicial Caseload Profile   |
| 2003               | Pantech Corporation’s July 9, 2021 Notice Letter to OnePlus Technology Co., Ltd.   |
| 2004               | Third Amended Docket Control Order, <i>Pantech Corporation and Pantech Wireless, LLC v. OnePlus Technology (Shenzhen) Co., Ltd.</i> , No. 5:24-CV-00038-RWS-JBB (E.D. Tex.) (Dkt. 86) (July 17, 2025)            |
| 2005               | Order Modifying Dates in Docket Control Order, <i>Pantech Corporation and Pantech Wireless, LLC v. OnePlus Technology (Shenzhen) Co., Ltd.</i> , No. 5:24-CV-00038-RWS-JBB (E.D. Tex.) (Dkt. 85) (July 17, 2025) |
| 2006               | Jury Verdict, <i>Pantech Corp. v. OnePlus Technology (Shenzhen) Co., Ltd.</i> , No. 5:22-cv-00069-RWS (E.D. Tex.) (Dkt. 259) (April 1, 2024)   |
| 2007               | Final Judgment, <i>Pantech Corp. v. OnePlus Technology (Shenzhen) Co., Ltd.</i> , No. 5:22-cv-00069-RWS (E.D. Tex.) (Dkt. 499) (Jan. 23, 2025)   |
| 2008               | Kiri Gupta & Urska Petrovcic, <i>Evidence of Systematic “Patent Holdout”</i> , 38 Berkeley Tech. L. J. (2023)  |

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| 2009 | Richard A. Epstein & Kayvan B. Noroozi, <i>Why Incentives for “Patent Holdout” Threaten to Dismantle FRAND, and Why It Matters</i> , 32 Berkeley Tech. L.J. 1381 (2017)          |
| 2010 | Kalyan Dasgupta & David J. Teece, <i>Protecting Innovation in the Mobile Wireless Ecosystem: Understanding &amp; Addressing “Hold-Out”</i> , 38 Berkeley Tech. L.J. 313 (2023)   |
| 2011 | <i>Markman Order, Pantech Corporation and Pantech Wireless, LLC v. OnePlus Technology (Shenzhen) Co., Ltd.</i> , No. 5:24-CV-00038-RWS-JBB (E.D. Tex.) (Dkt. 90) (July 30, 2025) |
| 2012 | U.S. Patent Application Publication No. 2005/0111389   |

Patent Owner Pantech Corporation (“Pantech”) respectfully provides its sur-reply to Petitioner’s arguments made in its Preliminary Reply (Paper 12), subject to authorization provided by the Board on November 10, 2025.

To begin with, Petitioner has taken liberties with the leave granted to it, expanding from its narrow request “to address Patent Owner’s remarks that a POSITA would know that configuration information must be sent for connection to multiple cells and that it is inherent operation of a base station” (Petitioner’s Email to the Board, November 11, 2025) to arguing (1) claim scope requirements, and (2) which claims were challenged by its priority date argument.

Nevertheless, to the extent that these expanded arguments will be considered, Patent Owner responds to Petitioner’s Preliminary Reply as it has been made.

**I. WRITTEN DESCRIPTION SUPPORT EXISTS FOR THE CHALLENGED CLAIMS**

Petitioner’s Preliminary Reply makes several arguments regarding written description support, and each is incorrect.

*First*, Petitioner seems to implicitly, and improperly, present a claim construction argument that the claims must apply to carrier aggregation. *See* Preliminary Reply at 1. This is incorrect. That an after-arising technology (carrier aggregation) that incorporates the claimed technology has been accused of infringement is of no matter, and does not require that this after-arising technology

to have been described by the '803 Patent's priority documents so long as the claimed invention has been. "Method and apparatus claims not written in means-plus-function format are not necessarily limited to that disclosed in the specification but rather are defined by the language of the claims themselves" and do not exclude "after-arising technologies" from their literal scope. *SuperGuide Corp. v. DirecTV Enters.*, 358 F.3d 870, 878 (Fed. Cir. 2004); *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1371-72 (Fed. Cir. 2008) ("Our case law allows for after-arising technology to be captured within the literal scope of valid claims that are drafted broadly enough"). Written description support concerns the invention itself, as claimed, and at most Petitioner has raised a (flawed) non-infringement argument.

**Second**, Petitioner makes a new argument: "the challenged claims of the '803 patent require 'configuration information' in the context of 'softer handover' for a single primary node." Provisional Reply at 2. This is not a claim construction that has been advanced by Petitioner. The actual claim language is fully supported, as has been set forth in the POPR. *See* POPR at 10-15.

It is of course undisputed that claim 1 (and claim 7) sets forth that "a primary cell is associated with a wireless network node and one or more non-primary cells are associated with the wireless network node." And as the '803 Patent sets forth, the WTRU will "establish[] connections with more than one cell 808 which are

controlled by the same Node-B 804” (*see* ’803 Patent at 8:42-52), and that “[o]ne of the cells 808 may be designated as a primary cell 808a, while other cells are designated as non-primary cells 808b” (*id.* at 9:4-6) (both discussing figures 8A and 8B). Petitioner’s Preliminary Reply largely ignores this support.

Instead, Petitioner seems to pivot to another claim requirement, that the WTRU will “receive configuration information for the primary cells and the one or more non-primary cells.” *See* Preliminary Reply at 2-3. But here too, the ’803 Patent provides support. As shown in Figure 8B, and again unaddressed by the Preliminary Reply, the WTRU will “establish connections to at least two cells that belong to the same Node-B.” ’803 Patent at Fig. 8B. The same support exists in the priority documents. EX2012 at Fig. 8B.

In a 3GPP scheme, and in the schemes discussed by the ’803 Patent and its priority documents, connection is established by receiving configuration information. This will be true for every embodiment disclosed in the ’803 Patent, including those concerning primary and non-primary cells associated with a wireless network node. “Under the current 3GPP standards, *the RNC applies RRC radio bearer (RB) control procedures to coordinate active set cells with the WTRU.*” ’803 Patent at 2:42-45; EX2012 at [0010]. As Petitioner itself has set forth, this inherent aspect of establishing a connection would have been known to a POSITA and

unnecessary to spell out *in haec verba*. See Pet. at 42-43 (acknowledging that TS 25.331 sets forth this information). Indeed, as Patent Owner pointed out in its Preliminary Response, “it is implausible that connections could be established with any cells without configuration information being received by the WTRU [and] Petitioner has cited no way in which this could occur.” POPR at 14. Petitioner has still not rebutted this simple observation.

Furthermore, the ’803 Patent discloses the WTRU receives a “shared channel indicator for non-primary cells 808 b.” ’803 Patent at 9:10-14. Petitioner misleadingly attacks the “timing offset” aspect of this disclosure (*see* Preliminary Reply at 3) but ignores that the “non-primary cells 808 b send messages on the channel indicated by the shared channel indicator.” ’803 Patent at 9:9-10. This too is a disclosure of the transmission of configuration information in the context of a cell arrangement as set forth in Figures 8A, 8B, and related disclosures.

Finally, the ’803 Patent (and the ’426 App.) discloses that the WTRU receives configuration information for the relevant cells: “[o]nce the RNC 1006 selects cells for the active set, the RNC 1006 sends messages to the Node- Bs 1004a, 1004b and the WTRU 1002 to inform the selected cells for the active set.” *See* ’803 Patent at 9:66-10:2; EX2012 at ¶ [0057] (same). Petitioner attempts to distinguish this particular disclosure as being presented outside of the context of softer handover,

but the teaching is equally applicable and covers the claimed invention: the WTRU will receive configuration information for the cells of the active set, namely the primary cell and the one or more non-primary cells.

Ultimately, the priority documents establish firm written description support for the challenged claim language. The inventors were in possession of both the particular claimed configuration of primary and non-primary cells and the methods of current 3GPP standards whereby configuration information is used to configure the cells of the active set.

## **II. PETITIONER DID NOT CHALLENGE THE PRIORITY DATE OF CLAIMS 7, 8, 11, or 12**

Petitioner argues that its written description challenge applies to claims 7, 8, 11, and 12. Preliminary Reply at 4-5. But this is not what the Petition sets forth. Aside from a blanket statement about “[t]he challenged ’803 Patent claims,” Petitioner’s arguments regarding priority claims do not address the claim language of any claim except claim 1. *See* Pet. at 9-12 (addressing only claim 1).

Petitioner now points to the similarity of language between claim 1 and claims 7, 8, 11, and 12, but the claim language is not identical and Petitioner has not explained the difference. Petitioner also points to its argument about “the claim requirement of ‘receiving of configuration information’” but this precise language is also not in claims 7, 8, 11, and 12. Petitioner’s belated arguments fail.

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Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 24th day of November, 2025, a copy of the attached **PATENT OWNER'S PRELIMINARY SUR-REPLY** was served by electronic mail to the attorneys of record, at the following addresses:

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Respectfully submitted,

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