

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD, and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners,

v.

VASU HOLDINGS, LLC,
Patent Owner.

Case IPR2025-00447
U.S. Patent No. 10,206,154

**DECLARATION OF JAMES HANNAH IN SUPPORT OF
PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

I, James Hannah, declare as follows:

1. I am partner at the law firm of Kramer Levin Naftalis & Frankel LLP, attorneys for Patent Owner Vasu Holdings, LLC (“Vasu”), in the above-captioned *inter partes* review proceeding involving Petitioners Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (“Petitioners”). I provide this Declaration in support of Patent Owner’s Request for Discretionary Denial based upon my personal knowledge.

2. In the co-pending litigation, *Vasu Holdings, LLC v. Samsung Electronics Co.*, No. 2:24-cv-00034-JRG-RSP (E.D. Tex.), Vasu is currently asserting infringement of Claims 1, 3, 4, 8, and 9 of U.S. Patent No. 8,886,181, Claim 1 of U.S. Patent No. 10,206,154, Claims 1, 12, 23, 37, and 45 of U.S. Patent No. 10,368,281, and Claims 1, 12, 23, 35, and 41 of U.S. Patent No. 10,419,996.

3. The claims challenged in the ’154 Patent IPR (IPR2025-00447) (Claims 1, 2, 4, 43, and 45-47) encompass the claims originally asserted by Vasu for the ’154 Patent (Claims 1, 2, 4, 43, and 47).

4. Vasu filed its complaint on January 22, 2024. The complaint was served on January 24, 2024, in the Eastern District of Texas and assigned to Judge Gilstrap. Petitioners filed their IPR Petitions for the ’154 Patent (IPR2025-00447) on January 23, 2025, the day before the 12-month statutory deadline without explaining the cause for their delay in filing.

5. The scheduled trial date in the District Court litigation is November 3, 2025. The median time to trial in the Eastern District of Texas is 21.9 months (approximately November 21, 2025), as shown in Exhibit 2003. This lends credibility to the median time to trial date. As a result of Petitioners' delayed filing, the scheduled trial date in the District Court litigation will commence approximately nine months prior to the Board's projected August 27, 2026, final written decision deadline.

6. Vasu served its preliminary infringement contentions and asserted claims on May 15, 2024, and Petitioners served their preliminary invalidity contentions on July 31, 2024. Petitioners supplemented their invalidity contentions on September 30, 2024, and submitted their preliminary election of asserted prior art on March 25, 2025. Petitioners filed their IPRs for the '154 Patent on January 23, 2025, eight months after Vasu served its preliminary infringement contentions and nearly five months after they served their initial invalidity contentions.

7. Experts will rely on substantially the same prior art and grounds as in the Petition when forming their opinions. Pet. at 6. For example, within Petitioners' September 30, 2024 invalidity contentions, Petitioners asserted Iizuka and Sundar. Within the preliminary election of asserted prior art that Petitioners served on March 25, 2025, Petitioners asserted Iizuka, Sundar, and Inoue for the '154 Patent.

8. Petitioners asserted Enzmann '927 for Claims 1, 2, 4, 43, and 45 to 47, but only rely on Enzmann for claim limitations 1[c], 2, and 43[c]. Pet. at 6, 27-67 (charting claim limitations allegedly met by the references). Additionally, Petitioners already asserted 30 references claim 1[c], 14 references for claim 2, and 30 references for claim 43[c], of the '154 Patent in Supplemental Exhibit D of their September 30, 2024 supplemental invalidity chart. Petitioners do not explain how Enzmann '927 addresses any potential weaknesses posed by these other invalidity contention references.

9. Discovery in the co-pending litigation is well underway as both Vasu and Petitioners have served and responded to multiple sets of discovery requests. Specifically, the parties have served a combined total of 44 requests for admission (4 requests from Vasu and 40 requests from Petitioners), 162 requests for production (60 requests from Vasu and 102 requests from Petitioners), 75 interrogatories (40 requests from Vasu and 35 requests from Petitioners). The parties served initial disclosures beginning on June 19, 2024, that identified relevant witnesses and categories of documents. Petitioners amended their initial disclosures on March, 27, 2025.

10. The parties have collectively served 19 Rule 30(b)(1) and 30(b)(6) deposition notices and 7 subpoenas. In fact, Petitioners served three 30(b)(6) deposition notices seeking a corporate designee of Vasu to testify on 87 topics, as

recently as April 17, 2025, which is scheduled to take place on May 30, 2025, and June 2, 2025. Vasu has already conducted 7 depositions as of May 27, 2025, some of which spanned over two days.

11. In response to their respective requests for production, the parties have produced thousands of documents. Specifically, Petitioners have produced over 3.96 GB of source code and over 71,300 documents. The parties have also produced videos and other types of files. Vasu spent 10 days inspecting Petitioners' source code. Vasu's expert is expected to review the source code from May 28 to May 30. Fact discovery is set to close on June 2, 2025.

12. Petitioners filed a Motion to stay on April 18, 2025. Vasu filed its Opposition to the Motion on May 2, 2025. Magistrate Judge Payne denied Petitioners' Motion on May 9, 2025.

13. On April 22, 2025, Vasu filed a Motion to Compel Documents and Discovery Responses, and Magistrate Judge Payne granted the Motion on May 15, 2025.

14. The parties completed claim construction briefing in the co-pending litigation on April 15, 2025. A Joint Claim Construction Chart was submitted on April 22, 2025. Magistrate Judge Payne conducted the claim construction hearing on May 13, 2025 and issued a claim construction order on May 19, 2025.

15. On March 31, 2025, Judge Gilstrap appointed a technical advisor for the case. The parties, who are responsible for paying the technical advisor's fees and expenses, already provided him with all claim construction briefs, exhibits, and technology tutorials.

16. The deadline for submitting opening expert reports is June 16, 2025, and for rebuttal expert reports is July 7, 2025. Expert discovery will close on July 21, 2025. The filing deadline for filing dispositive motions and *Daubert* motions without seeking leave of court is July 28, 2025. Moreover, any outstanding dispositive and *Daubert* motions will be fully briefed by August 25, 2025.¹ Accordingly, the Court's technical advisor and the parties' experts will have considered these materials for their respective tasks involved in the litigation by the Board's August 27, 2025 institution decision deadline.

¹ Under the Local Rules for the E.D. Tex. Rule 7, replies and sur-replies to dispositive and non-dispositive motions must be filed within 7 days from the date the response is served. No further motions absent leave of court are allowed.

I declare that all statements made herein of my knowledge are true, and that all statements made on information and belief are believed to be true, and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Executed on May 27, 2025, in Redwood Shores, CA.

/James Hannah/
James Hannah