

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

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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35 U.S.C. § 315(b)5

35 U.S.C. § 325(d)*passim*

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Intentionally omitted
2002	Declaration of James Hannah in Support of Patent Owner's Request for Discretionary Denial
2003	Excerpt from U.S. District Court – National Judicial Caseload Profile Federal for the Eastern District of Texas, available at https://www.uscourts.gov/sites/default/files/2024-12/fcms_na_distprofile0930.2024.pdf
2004	Intentionally omitted
2005	Intentionally omitted
2006	Intentionally omitted
2007	Intentionally omitted
2008	Order, <i>California Institute of Technology v. Samsung Electronics Co., Samsung Electronics America, Inc.</i> , Case No. 2:21-cv-00446-JRG, Dkt. No. 108 (E.D. Tex. Jan. 20, 2023)
2009	Order, <i>Resonant Systems, Inc., d/b/a RevelHMI v. Sony Group Corporation and Sony Interactive Entertainment Inc.</i> , Case No. 2:22-cv-00424-JRG, Dkt. No. 84 (E.D. Tex. July 9, 2024)
2010	Order, <i>MyPort, Inc. v. Samsung Electronics Co., Samsung Electronics America, Inc.</i> , Case No. 2:22-cv-00114-JRG, Dkt. No. 73 (E.D. Tex. June 13, 2023)
2011	Order, <i>General Access Solutions, Ltd. v. Cellco Partnership d/b/a Verizon Wireless</i> , Case No. 2:22-cv-00394-JRG, Dkt. No. 225 (E.D. Tex. May 22, 2024)
2012	PCT/JP 2005/051029 A1 to Inoue
2013	U.S. Patent Application Publication No. 2005/0059400 (“Jagadeesan”)

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Exhibit	Description
2014	Claim Construction Order, <i>Vasu Holdings, LLC v. Samsung Elecs. Co.</i> , Case No. 24-cv-00034-JRG-RSP, Dkt. No. 78 (E.D. Tex. May 19, 2025)
2015	U.S. Patent No. 7,398,088 (“Belkin”)
2016	U.S. Patent No. 8,041,360 (“Ibe”)
2017	Excerpts of File History for U.S Patent 8,886,181

I. INTRODUCTION

Patent Owner, Vasu Holdings, LLC, (“Vasu”), respectfully requests that the Acting Director exercise her discretion to deny the Petition challenging U.S. Patent No. 10,206,154 (Ex. 1001, “the ’154 Patent”), based on:

(1) the advanced state of the corresponding district court action under *Apple Inc. v. Fintiv, Inc.*, because the District Court promises to be the faster and more efficient forum to address the same validity issues raised here given that Petitioners’ last-minute Petition allowed the District Court case to reach an advanced stage; and

(2) Petitioners’ reliance on the same or substantially the same art previously considered by the Office under 35 U.S.C. § 325(d).

First, the *Fintiv* factors strongly favor denial. Trial in the co-pending District Court litigation is scheduled to commence on November 3, 2025, which is nine months before the projected statutory final written decision deadline. Because Petitioners decided to wait to submit the Petition until the day before the statutory window closed, the District Court case is close to the fact discovery deadline. Petitioners’ delay also effectively nullifies the effectiveness of their promise not to raise validity challenges under 35 U.S.C. §§ 102 and 103 if the Board institutes trial in this case because the parties will be litigating the same issues in both forums until at least the eve of trial. Indeed, if institution is denied in this case and Petitioners

request rehearing, the District Court trial will likely be finished before any such request is decided.

With fact discovery closing on June 2, 2025, the parties narrowed the case several times, including on their own volition (and not simply based on Court deadlines). And with the upcoming June 16, 2025, deadline for opening expert reports, there can be no question that the parties have already expended extensive resources in the case. By the time an institution decision is due, the District Court will have already expended significant resources, given that the District Court conducted its *Markman* hearing on May 13, 2025 and issued a claim construction order on May 19, 2025. Under these circumstances, the District Court is highly unlikely to consider a renewed motion to stay so close to the scheduled trial date.

Second, the Director should also deny this Petition under 35 U.S.C. § 325(d) because the grounds raised in the Petition are substantially similar to those raised and traversed during prosecution of the '154 Patent and its related patent family. Specifically, Petitioners apply Iizuka¹ in every ground in essentially the same manner in which the Examiner considered the teachings of Belkin² during prosecution of the '154 Patent's parent (the '181 Patent). Both references disclose

¹ U.S. Patent Pub. No. 2005/0282541 to Iizuka (Ex. 1004).

² U.S. Patent No. 7,398,088 to Belkin (Ex. 2015).

disrupting the mobile device's existing connection when switching between cellular and WiFi networks rather than "establishing a second communication link... without disrupting the first communication link," as claimed. Petitioners' attempt to reassert the same arguments already addressed during prosecution under the guise of facially new references warrants denial under 35 U.S.C. § 325(d).

* * *

This request for discretionary denial of institution is authorized by the March 26, 2025, Memorandum regarding "Interim Processes for PTAB Workload Management" from the Acting Director of the United States Patent and Trademark Office. Vasu will discuss, in full, the reasons why the '154 Patent is patentable on the merits in its Patent Owner's Preliminary Response.

II. PETITIONERS' GROUNDS FOR CHALLENGE

The Petition presents the following references as its respective grounds for invalidating claims of the '154 Patent.

Ground	Claims	Basis	References Relied Upon
1	1, 2, 4, 43, and 45-47	§ 103	Iizuka, Enzmann
2	1, 2, 4, 43, and 45-47	§ 103	Iizuka, Enzmann, Inoue
3	45-47	§ 103	Iizuka, Enzmann, Sundar
4	45-47	§ 103	Iizuka, Enzmann, Sundar, and Inoue

Pet. at 6. Claims 1 and 43 are independent claims among the Challenged Claims.

III. THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 314(a)

The Board should deny institution under 35 U.S.C. § 314(a) because the *Fintiv* Factors overwhelmingly support denying institution. *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) (“*Fintiv*”). The projected statutory deadline for the final written decision in this case is nine months after trial is scheduled to commence in the District Court.

By way of background, the District Court litigation complaint was filed over 15 months ago and served on January 24, 2024, in the Eastern District of Texas and assigned to Judge Gilstrap. Declaration of James Hannah (Ex. 2002, “Hannah Decl.”), ¶4. The trial is scheduled for November 3, 2025, which is consistent with the median time to trial in the Eastern District of Texas being 21.9 months

(approximately November 21, 2025). *Id.*, ¶5; Ex. 2003. Thus, the scheduled trial date weighs in favor of denying institution.

Petitioners' unexplained delay in filing the IPR petition on January 23, 2025, the day before the 12-month statutory deadline under 35 U.S.C. § 315(b), further weighs in favor of denying the Petition. Hannah Decl., ¶4. Indeed, Petitioners' delay is largely why the District Court's trial will commence nine months prior to the Board's projected statutory final written decision deadline of August 27, 2026, for the Final Written Decision. *Id.*, ¶5.

Petitioners' actions in the District Court have been confounding. They filed a Motion to Stay Pending *Inter Partes* Review on April 18, 2025, even though the Eastern District of Texas has a "universal practice" of denying pre-institution motions to stay. Hannah Decl., ¶12; *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (referencing "the universal practice" of courts in this District to deny pre-institution motions to stay). In addition to this doomed request to stay the case, Petitioners proposed on April 18, 2025, that they would not pursue any § 102 or § 103 grounds in the litigation if the IPR is instituted. This proposal is neither efficient nor a true alternative to the District Court litigation because by the time the Board decides whether to institute trial in this case, the expert report briefing, dispositive briefings, and *Daubert* motions will have been completed. Hannah Decl., ¶16.

**A. *Fintiv* Factor 1: There is Little to No Likelihood that a Stay
Would be Granted in the Parallel District Court Proceeding**

Fintiv Factor 1 favors discretionary denial in this case because a stay in this case is highly unlikely. *Arm Ltd. v. Daedalus Prime LLC*, No. IPR2025-00207, Paper 10 at 2 (P.T.A.B. May 16, 2025) (finding Factor 1 favored discretionary denial because “there is insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial”); *Ericsson Inc. v. Procomm Int’l Pte. Ltd.*, No. IPR2024-01455, Paper 15 at 2 (P.T.A.B. May 16, 2025) (same).

Magistrate Judge Payne denied Petitioners’ Motion to Stay on May 9, 2025, as premature, and neither the Magistrate Judge nor Judge Gilstrap is likely to grant any renewed motion to stay the case that is only three months away from trial. Hannah Decl., ¶12. Magistrate Judge Payne’s denial of Petitioners’ motion to stay—filed roughly three months after Petitioners submitted this IPR petition—accords with the Eastern District of Texas’s “universal practice” of denying motions to stay that are filed before the Board’s institution decision. *Trover Grp.*, 2015 WL 1069179, at *6 (referencing “the universal practice” of courts in this District to deny pre-institution motions to stay). And to the extent that Petitioners file a renewed motion to stay the case in August, based on the Office instituting one or more of the five IPRs filed against Vasu’s patents, it is highly unlikely that such a motion would succeed.

Judge Gilstrap consistently denies requests to stay litigation when a last-minute IPR petition is submitted. To date, Judge Gilstrap has denied nearly every petitioner's motion to stay when the IPR petition was filed 10 months after receiving the complaint. For example, in *Cal. Inst. Of Tech. v. Samsung Elecs. Co.*, Judge Gilstrap found that Samsung's 10-month delay in filing its IPRs disfavored a stay. Ex. 2008, No. 2:21-cv-00446-JRG, Dkt. No. 108, slip op. at 5 (E.D. Tex. Jan. 20, 2023) (a stay "would [have] do[ne] nothing more than draw out the time to trial"); *see also Clear Imaging Rsch., LLC v. Samsung Elecs. Co.*, No. 2:19-cv-00326-JRG, 2020 WL 13886381, at *2 (E.D. Tex. Dec. 21, 2020) (denying stay where Samsung filed its IPRs 10 months after receiving complaint). This has been the case, even when petitioners file their motions to stay *after* the Board has decided its institution decision. *See* Ex. 2009, *Resonant Sys., Inc. v. Sony Grp. Corp.*, No. 2:22-cv-00424-JRG, Dkt. No. 84, slip op. at 4-5 (E.D. Tex. Jul. 9, 2024) (denying a motion to stay where petitioner waited 10 months after service of the lawsuit to file its IPRs, which "necessarily extended the potential resolution of the IPRs until well after the scheduled trial date").

Here, Petitioners' delay was even longer, as Petitioners waited to file the Petition until the day before the 12-month statutory deadline. Hannah Decl., ¶4. As a result, Petitioners' delayed IPR filings will cause jury selection to occur approximately nine months before the Board's statutory final written decision

deadline, significantly longer than the two months in *Cal. Inst. Of Tech.* and the eight months in *Resonant Sys., Inc.* Ex. 2008, slip op. at 5; Ex. 2009, slip op. at 4-5.

Judge Gilstrap also routinely denies motions to stay where, as here, the “parties [have] engaged in extensive discovery.” See § III.C, *infra* (Factor 3); Ex. 2008, *Cal. Inst. Of Tech.*, slip op. at 5 (stage of litigation disfavored stay because, in addition to the petitioner’s delayed IPR filings, “[t]he parties [have] engaged in extensive discovery, including the exchange of ‘tens of thousands of documents,’ interrogatories, depositions, source code inspection, third-party discovery, and infringement and invalidity contentions”); Ex. 2010, *MyPort, Inc. v. Samsung Elecs. Co.*, No. 2:22-cv-00114-JRG, Dkt. No. 73, slip op. at 4 (E.D. Tex. June 13, 2023) (the stage of litigation disfavored a stay where discovery was well underway, thousands of documents had been exchanged, depositions were taken, and source code inspections had occurred).

Here, Petitioners have produced over 71,300 documents and 3.96 GB of source code, which Vasu’s counsel reviewed for 10 days. The parties have also served infringement and invalidity contentions and exchanged multiple sets of discovery requests and responses, including 75 interrogatories, 7 third-party subpoenas, and 44 requests for admission. Vasu has already taken 7 depositions as of May 27, 2025, and Vasu’s 30(b)(6) depositions are scheduled to take place starting May 30. Hannah Decl., ¶¶9-11. Magistrate Judge Payne conducted the

Markman hearing and heard arguments regarding Vasu's Motion to Compel Documents and Discovery Responses on May 13. *Id.*, ¶¶13-14. Magistrate Judge Payne issued a claim construction order on May 19. *Id.*, ¶14; Ex. 2014 (Claim Construction Order).

In any event, Judge Gilstrap has found that a delayed IPR filing tips the "stage of litigation" factor against a stay, even if claim construction, fact discovery, and expert discovery had not been completed when the motion to stay was filed. *See* Ex. 2009, *Resonant Sys.*, slip op. at 4-5.

Judge Gilstrap has also denied a petitioner's motion to stay, even when, as here, the petitioner proposes a statement that it will not pursue invalidity before the District Court. In *General Access Solutions Ltd. v. Cellco Partnership*, Judge Gilstrap denied a motion to stay despite the defendant's stipulation, given that "a possibility that resolution of the IPRs could simplify the issues of th[e] case . . . [wa]s not a certainty." Ex. 2011, No. 2:22-cv-00394-JRG, Dkt. No. 225, slip op. at 4-5 (E.D. Tex. May 22, 2024).

Accordingly, *Fintiv* Factor 1 weighs in favor of denying institution because there is little to no likelihood that the District Court will stay the co-pending litigation. At the very least, Factor 1 is neutral, given that it is highly likely, though not necessarily a foregone conclusion, that the District Court will deny any renewed request for a stay.

B. *Fintiv* Factor 2: The District Court's Scheduled Trial Date is Approximately Nine Months Before the Expected Date of Any Final Written Decision

Fintiv Factor 2 strongly favors discretionary denial because the District Court trial is scheduled to commence on November 3, 2025, approximately nine months³ before the August 27, 2026, deadline to issue a final written decision in this case. Hannah Decl., ¶5; *see, e.g., Ericsson*, Paper 15 at 2 (finding a nine month gap between projected trial date and Board's final written decision deadline favored discretionary denial); *Arm Ltd.*, Paper 10 at 2 (finding Factor 2 favored denial because the Board's final written decision deadline was five months after the district court's scheduled trial date and one to three months after the projected trial date based on the court's median time-to-trial statistics); *Lenovo Inc. v. Universal Connectivity Techs., Inc.*, No. IPR2024-01481, Paper 19 at 10-11 (P.T.A.B. Apr. 17, 2025) (finding Factor 2 strongly favored discretionary denial where the Board's final written decision was expected six months after trial according to scheduling order

³ Petitioners improperly focus their *Factor 2* analysis on the projected institution decision date rather than the projected final written decision deadline. Pet. at 15; *see Fintiv*, Paper 11 at 6, 9 (defining factor 2 as “proximity of the court's trial date to the Board's projected statutory deadline for *a final written decision*”) (emphasis added).

or nine months after according to time-to-trial statistics for court); *Roku, Inc. v. IOENGINE, LLC*, No. IPR2022-01553, Paper 11 at 10-11 (P.T.A.B. May 5, 2023) (finding Factor 2 strongly favored discretionary denial where the Board's final written decision expected was seven months after trial according to the scheduled trial date or six months after according to the court's median time-to-trial statistics); *Toyota Motor Corp. v. Emerging Automotive LLC*, No. IPR2024-00785, Paper 13 at 12-13 (P.T.A.B. Mar. 11, 2025) (finding Factor 2 weighed "heavily in favor of discretionary denial" because trial was scheduled approximately eight months before the Board's expected final written decision).

The median time-to-trial in the Eastern District of Texas is 21.9 months (i.e., approximately November 21, 2025), which "lends credibility to" the November 3, 2025, trial date. Ex. 2003; *Samsung Elecs. Co. v. Secure Wi-Fi LLC*, No. IPR2024-01367, Paper 10 at 12-13 (P.T.A.B. Mar. 24, 2025) (finding that Factor 2 weighed heavily in favor of denial and recognizing Judge Gilstrap's time-to-trial statistics as lending credibility to scheduled trial date, which was set to occur five months before final written decision deadline); *see also* March 24, 2025 USPTO Guidance Memorandum at 3 ("[T]he Board may consider any evidence . . . that bears on the proximity of the district court's trial date . . . including median time-to-trial statistics . . . in the district court in which the parallel litigation resides.").

Therefore, *Fintiv* Factor 2 weighs strongly in favor of the Board exercising its discretion to deny institution.

C. *Fintiv* Factor 3: Significant Investment in the Parallel Litigation Will Have Occurred by the Time the Board's Institution Decision is Due

Fintiv Factor 3 favors discretionary denial because (1) significant investment has occurred and continues to occur in the co-pending District Court litigation, and (2) Petitioners filed the Petition *the day before* the statutory deadline.

The District Court has already devoted a significant amount of resources toward resolving the dispute. The parties have completed claim construction briefing, the *Markman* hearing occurred on May 13, 2025, and a claim construction order issued on May 19, 2025. Hannah Decl., ¶14; Ex. 2014. Judge Gilstrap also appointed a technical advisor for the case. Hannah Decl., ¶15. The parties, who are responsible for paying the technical advisor's fees and expenses, have already provided him with all of the claim construction briefs, exhibits, and technology tutorials. Opening and rebuttal expert reports will also have been served by July 7, 2025, with expert discovery closing on July 21, 2025. *Id.*, ¶16. Furthermore, dispositive motions and summary judgment will have been fully briefed by August 25, 2025, all involving these grounds and prior art, along with potential *Daubert* motions. *Id.* Notably, the Court's technical advisor and the parties' experts will

have considered these materials for their respective tasks involved in the litigation.

Id.

The Board has repeatedly weighed Factor 3 in favor of denying institution given this level of investment in the parallel proceeding. Specifically, substantial investment has been found where the District Court has already conducted a *Markman* hearing, issued a claim construction order, and fact discovery is set to close before the Board's institution decision deadline. *See Charter Commc'ns, Inc. v. Adaptive Spectrum & Signal Alignment, Inc.*, No. IPR2024-01379, Paper 16 at 13 (P.T.A.B. Apr. 17, 2025) (Factor 3 favored denial where parties had already engaged in fact discovery, *Markman* hearing occurred, claim construction order issued, and fact discovery set to close before Board's institution decision deadline); *Apple Inc. v. Haptic, Inc.*, No. IPR2024-01475, Paper 11 at 11-12 (P.T.A.B. Apr. 4, 2025) (same).

Before the Board's expected August 27, 2025, institution decision, the parties will have already expended significant investment conducting discovery in the District Court litigation. Hannah Decl., ¶¶9-11. The parties have already served and supplemented their respective infringement and invalidity contentions multiple times. *Id.*, ¶6. Fact discovery is set to close on June 2, 2025. *Id.*, ¶11. As of the filing of this brief, both parties have served several sets of discovery requests and responses, 44 requests for admission, 162 requests for production, and 75

interrogatory requests. *Id.*, ¶9. Initial disclosures were served, identifying relevant witnesses who are scheduled to be deposed. *Id.* Petitioners have produced over 71,300 documents and made over 3.96 GB of source code available for inspection, to which Vasu's outside counsel has already devoted 10 days to review. *Id.*, ¶11. Vasu's expert is expected to review the source code beginning on May 28, 2025. *Id.*

The parties have collectively served 19 Rule 30(b)(1) and 30(b)(6) deposition notices, and 7 subpoenas. *Id.*, ¶10. In fact, Petitioners served 87 topics for deposition on Vasu as recently as April 17, 2025, which is scheduled to take place on May 30, 2025, and June 2, 2025. *Id.* Vasu has already conducted seven depositions as of May 27, 2025, some of which spanned over two days. *Id.* Thus, Petitioners have demonstrated their efforts to complete discovery before the June 2, 2025, fact discovery cutoff. *Id.*, ¶¶9-11. On April 22, 2025, Vasu filed a Motion to Compel Documents and Discovery Responses, and the Court granted the Motion on May 15, 2025. *Id.*, ¶13.

Aside from the substantial investment by the parties and District Court, Factor 3 also weighs in favor of denying the Petition because Petitioners did not file the Petition expeditiously. *See Global Tel*Link Corp. v. HLFIP Holding, Inc.*, No. IPR2021-00444, Paper 14 at 22-23 (P.T.A.B. Jul. 22, 2021) (lack of diligence in filing the Petition where IPRs filed four days before statutory deadline weighs Factor 3 strongly in favor of denial). After all, “[i]f Petitioner[s] w[ere] diligent in filing

the Petition, that diligence could potentially mitigate some of the investments in parallel proceedings that are at issue.” *Id.* at 22. This Petition was filed even closer to the statutory deadline than in *Global Tel*Link*, and Petitioners’ delay has allowed the co-pending litigation to reach an advanced stage. Hannah Decl., ¶¶4, 9-11.

Further confirming Petitioners’ lack of diligence, the Petition was filed eight months after Vasu served its Asserted Claims and Preliminary Infringement Contentions (May 15, 2024) and nearly five months after Petitioners served their initial invalidity contentions (July 31, 2024). Hannah Decl., ¶6; *see Comcast Cable Commc’ns, LLC v. Touchstream Techs., Inc.*, No. IPR2024-00323, Paper 13 at 9-10 (P.T.A.B. Jul. 24, 2024) (finding Factor 3 favored denial where (1) fact and expert discovery and claim construction briefings and hearings completed before institution deadline; and (2) petitioner’s seven-month delay in filing petition after learning of asserted claims and nearly five-month delay after receiving initial invalidity contentions).

Petitioners’ unsupported statement that they have “diligently prepared and filed these IPRs,”⁴ cannot save Petitioners from their delays. Pet. at 15. Indeed, they

⁴ Petitioners likewise postponed filing IPR2025-00446, -00448, -00449, and -00450, which correspond to Patent Owners’ other asserted patents in this case. Petitioners

cite no prior decisions of the Board where such an unexplained delay was found to be diligent. *Cf. AT&T Servs. Inc. v. Asus Tech. Licensing Inc.*, No. IPR2024-01142, Paper 14 at 14-15 (P.T.A.B. Jan. 27, 2025) (finding Factor 3 favored denial because “Petitioner waited five months to file [its] Petition after receiving Vasu’s infringement contentions, and Petitioner ha[d] not presented any factual evidence to justify this delay”); *Fintiv*, Paper 11 at 11-12 (“[T]he parties should explain facts relevant to timing” and “if the petitioner cannot explain the delay in filing its petition, [this fact has] favored denial.”).

Therefore, Factor 3 weighs strongly in favor of denial.

D. *Fintiv* Factor 4: There is Substantial Overlap Between the IPR Proceeding and the Parallel Litigation

Fintiv Factor 4 favors discretionary denial because Petitioners challenge “the same or substantially the same claims, grounds, arguments, and evidence” as in the parallel District Court litigation. *Fintiv*, Paper 11 at 12-13. And while Petitioners’

filed IPR2025-00448, -00449, and -00450 on the final day of the statutory deadline, and IPR2025-00446, the day before the statutory deadline.

statement⁵ may lessen the chance of inconsistent decisions between the PTAB and District Court, Petitioners' delay in filing the Petition and the contingent nature of its proposed statement means that the parties will be litigating essentially the same issues in the IPR and District Court *at least* until the institution decision deadline, and potentially longer (in the event that institution is denied but Petitioner files a Request for Rehearing or Director Review Request).

While Vasu narrowed its asserted claims in the District Court litigation, the same claims challenged by Petitioners in this case (Claims 1, 2, 4, 43, and 45-47) are in Petitioners' invalidity contentions in the District Court litigation (Claims 1, 2, 4, 43, and 45-47). Hannah Decl., ¶¶2-3; *see Samsung Supercell Oy v. Gree*, IPR2020-01628, Paper 9 at 12-13 (P.T.A.B. Feb. 17, 2021) (finding Factor 4 favoring denial of institution where petition involved "exact same challenged claims" and substantially similar prior art as in district court litigation). Vasu's narrowing of asserted claims in the District Court litigation does not materially alter issues of substantial overlap, given that these proceedings and the District Court

⁵ Petitioners stated that they will forego their 35 U.S.C. §§ 102 and 103 challenges before the District Court in the event that if the Board institutes trial. Petitioners have not agreed to drop all invalidity challenges, however, including any challenges based on obviousness double-type patenting, and 35 U.S.C. §§ 101 and 112.

litigation will continue operating in parallel and that the Petition's claims will encompass all claims originally asserted in the District Court litigation. Hannah Decl., ¶¶2-3; *see also Hillman Grp., Inc. v. Hy-Ko Prods. Co.*, No. IPR2022-00169, Paper 8 at 13 (P.T.A.B. May 9, 2022) (Factor 4 favored denial because “[r]egardless of any narrowing of claims required by the Texas District Court for efficiency reasons at trial, the claims in the Petition will include all of the claims originally asserted in the Texas Litigation.”). Likewise, Petitioners’ challenged claims in their Petition (Claims 1, 2, 4, 43, and 45-47) in this case encompass those originally asserted in the District Court litigation (Claims 1, 2, 4, 43, and 47). Hannah Decl., ¶¶2-3. Additionally, substantial overlap will occur because the proceedings and the District Court litigation will continue operating in parallel.

Moreover, “[e]ven if the trial in the District Court action ultimately resolves fewer than all of the claims challenged in the Petition . . . , significant concerns about duplicative efforts persist because the same substantive issues related to the same prior art references are in contention in both forums.” *Samsung Display Co. v. Pictivia Displays Int’l Ltd.*, No. IPR2024-00855, Paper 12 at 10-11 (P.T.A.B. Nov. 19, 2024). Here there is a “substantial overlap of issues concerning the prior art,” given that Petitioners have selected to pursue before the District Court three of Petitioners’ four references asserted here, namely, Iizuka, Sundar, and Inoue. Hannah Decl., ¶7; *see Apple Inc. v. Optis Cellular Tech. LLC*, No. IPR2020-00465,

Paper 13 at 20-21 (P.T.A.B. Sept. 17, 2020) (recognizing “substantial overlap of issues concerning the prior art” and even though “the combinations of four references asserted by Petitioner at [District Court] and in the Petition are different, two of the references including the primary reference [], are the same in both combinations”).

Petitioners' addition of Enzmann '927 for Claims 1, 2, 4, 43, and 45-47 in their Petition does not “meaningfully differentiate the arguments presented in the Petition from the arguments made in the [D]istrict [C]ourt” either.⁶ Hannah Decl., ¶8; *Edwards Lifesciences, Corp. v. Evalve, Inc.*, No. IPR2019-01479, Paper 7 at 11 (P.T.A.B. Feb. 26, 2020); *see also Supercell Oy v. GREE, Inc.*, No. IPR2020-01633, Paper 9 at 11-13 (P.T.A.B. Feb. 19, 2021) (finding Factor 4 favored denial and finding substantial similarity between petition and district court litigation where same prior art asserted except for one additional dependent claim and reference in petition); *Samsung Elecs. Co. v. Secure Wi-Fi LLC*, No. IPR2024-01366, Paper 10 at 14-15, 17 (P.T.A.B. Mar. 24, 2025) (same). While Enzmann '927 has not been presented in the District Court litigation for the '154 Patent, Petitioners already point to 30 references for claim 1[c], 14 references for claim 2, and 30 references for claim

⁶ Petitioners only rely on Enzmann '927 for claim limitations 1[c], 2, and 43[c] of the '154 Patent.

43[c] and “do[] not explain how [their] arguments based on [Enzmann ’927] address any potential weaknesses in [these other six] invalidity [contention references].” Hannah Decl., ¶8; *Edwards Lifesciences*, Paper 7 at 10-11 (finding Factor 4 weighed in favor of denial because petitioner failed to indicate how petition reference filled in any gaps from those already listed in its invalidity contentions).

Petitioners’ sole argument in their Petition that the District Court litigation “will involve multiple grounds of invalidity not at issue here, enabling the court to focus its limited trial time on different invalidity defenses” is also unavailing, given the Board’s past rejection of such arguments. Pet. at 15; *see, e.g., Intel Corp. v. VLSI Tech. LLC*, No. IPR2020-00106, Paper 17 at 10-11 (P.T.A.B. May 5, 2020) (“Although Petitioner’s Final Invalidity Contentions include numerous other combinations of references challenging overlapping claims, . . . that difference alone does not negate that the same combinations of references asserted in the Petition are also asserted in Petitioner’s Final Invalidity Contentions”). On the contrary, it would be most efficient for the District Court to handle all of the parties’ disputes rather than bifurcate validity issues, especially because the District Court litigation will resolve all of those issues while any trial instituted on this Petition remains in its earliest stages.

While Petitioners submitted a statement offering to withdraw all §§ 102 and 103 challenges if the IPR is instituted, this is not a “‘true alternative’ to the

[D]istrict [C]ourt proceeding.” *Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020). Specifically, it will not “mitigate[] any concerns of duplicative efforts between the [D]istrict [C]ourt and the Board” or “of potentially conflicting decisions.” *Id.* Before the Board is scheduled to issue an institution decision, on August 27, 2025, expert reports and summary judgment motions in the District Court addressing the same prior art asserted here will have already been completed. Hannah Decl. ¶¶7, 16; *see* § III.C, *supra*. Because the parties will have already invested a substantial amount of time and effort addressing the § 103 issues in District Court involving the same art presented here, Petitioners’ statement will not have mitigated any duplicative concerns that a statement that is a true alternative to what the District Court would accomplish.

Nor does Petitioners’ statement outweigh the other *Fintiv* Factors. The Director’s recent decision in *Motorola Solutions, Inc. v. Stellar, LLC* emphasized the non-dispositive nature of a *Sotera*-stipulation. There, the Director vacated and denied institution because the “Board did not give enough weight to the investment in the parallel proceeding and gave too much weight to Petitioners’ *Sotera* stipulation.” No. IPR2024-01205, Paper 19 at 2, 4 (P.T.A.B. Mar. 28, 2025) (reversing Board’s grant of institution based on the *Fintiv* Factors “as a whole”). Here, too, the investment in the parallel proceeding greatly outweighs the effect of Petitioners’ statement.

Therefore, for at least the foregoing reasons, *Fintiv* Factor 4 weighs in favor of the Board exercising its discretion to deny institution.

E. *Fintiv* Factor 5: Petitioners are the Defendants in the Parallel Proceeding

Fintiv Factor 5 weighs in favor of exercising discretionary denial because the parties are the same in both proceedings. *Fintiv*, Paper 11 at 13-14.

F. *Fintiv* Factor 6: The Petition is Without Merit

Factor 6 weighs in favor of denying institution if the Board deems analysis of this Factor necessary. Here, because a bulk of the other *Fintiv* Factors favor discretionary denial, the Board “need not decide whether the merits of Petitioners’ asserted grounds are particularly strong because it would not impact [their] ultimate determination” since the facts weighing in favor of discretionary denial collectively outweigh the merits. *NXP USA, Inc. v. Impinj, Inc.*, No. PGR2022-00005, Paper 18 at 12-13 (P.T.A.B. May 2, 2022) (finding Factor 6 analysis unnecessary and denying institution based on Factors 1-5 where Factor 1 was neutral and Factors 2-5 slightly favored denial); *see also Samsung Elecs. Co. v. Clear Imaging Rsch., LLC*, No. IPR2020-01401, Paper 12 at 23-24 (P.T.A.B. Feb. 17, 2021) (finding Factor 6 did not outweigh the other *Fintiv* Factors favoring denial, where Factors 1 and 4 slightly favored denial, Factors 2 and 3 weighed strongly in favor of denial and Factor 5 weighed in favor of denial). Moreover, the Board need not consider the merits under Factor 6, given that the other *Fintiv* Factors favor denying institution.

Nonetheless, even if the merits of Petitioners' asserted grounds and prior art are considered, Factor 6 favors discretionary denial because Petitioners fail to show a reasonable likelihood of success on any challenged claim, as evidenced in the merits arguments presented in the concurrently-filed Patent Owner Preliminary Response. For example, Petitioners fail to show a reasonable likelihood that the asserted references teach or suggest limitations of the Challenged Claims, including limitation [1.c], "establishing a second communication link between the interface server and the end destination device without disrupting the first communication link." Furthermore, Petitioners failed to establish a reasonable likelihood—and certainly do not meet the higher "compelling" merits threshold that Petitioners asserted—that any claim of the '154 Patent is obvious over the art asserted in the Petition, including Iizuka, Enzmann, Inoue, and Sundar. Pet. at 14-15.

IV. OVERVIEW

A. The '154 Patent (Ex. 1001)

The '154 Patent is directed to a method for seamless switching communications among Voice over Internet (VoIP), public cellular, and public circuit-switched networks. '154 Patent at 1:35-39. The '154 Patent claims an "interface server" (depicted as "nomadic server 80" in Fig. 1 below), which facilitates the seamless roaming for a mobile communication device (e.g., device 90). *Id.* at 2:54-62.

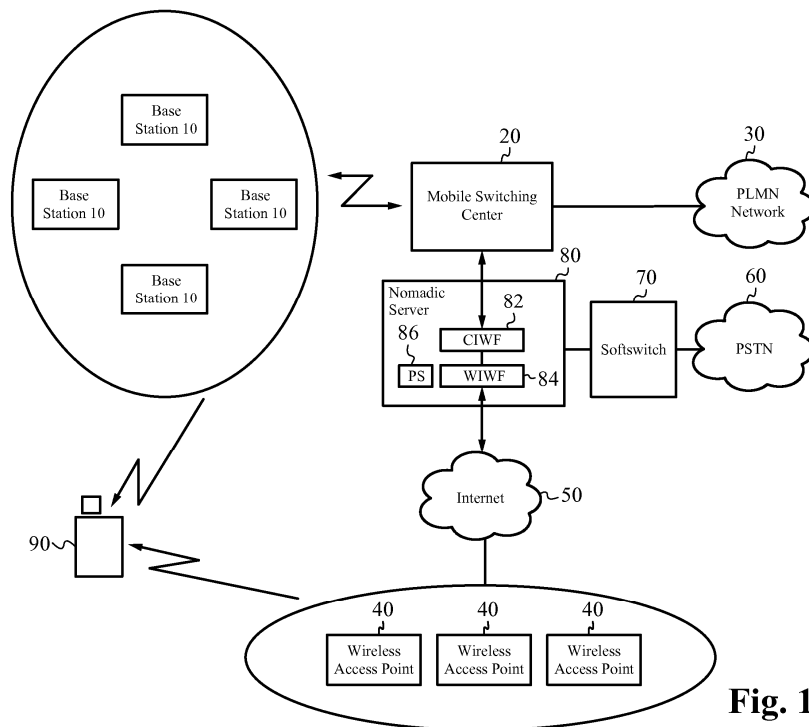


Fig. 1

Id., Fig. 1.

The nomadic server is a telephone communication processing and switching server that can hold in-progress telephone communications while the user roams between different types of wireless networks, without dropping or losing the in-progress communications. *Id.* at Abstract, 2:63-3:1. When a caller roams outside the range of a VoIP access point, the nomadic server will “hold” the current telephone communication while switching occurs from the VoIP access point to the cellular network. *Id.* at 5:63-6:9. Similarly, when a caller roams into the range of a VOIP access point while engaged in a telephone communication on the cellular network, the nomadic server will “hold” the current telephone communication while switching occurs from the cellular network to the VOIP access point. *Id.* The

nomadic server remains engaged, or active, in the telephone communication while switching from one network to another. *Id.*

B. '154 Patent Prosecution History

The '154 Patent issued from U.S. Patent Application No. 14/510,766, filed on October 9, 2014. Ex. 1002 at 65. It is a continuation of U.S. Patent Application No. 13/240,776, which was issued as U.S. Patent No. 8,886,181 (“the '181 Patent”) on November 11, 2014.⁷ The '181 Patent is a divisional application of U.S. Patent Application No. 11/330,675, filed on January 11, 2006, and claims priority to a U.S. Provisional Application No. 60/643,829 filed on January 14, 2005. Ex. 1002 at 65. The '181 Patent is also a continuation-in-part of U.S. Patent Application No. 11/031,498, filed on January 6, 2005, and which claims priority to U.S. Provisional Application No. 60/534,466, filed on January 6, 2004. *Id.*

After a compact examination, the Examiner stated, “there is no prior art reference, alone or in combination, that teaches or fairly suggests a method for at least ‘establishing a second communication link between the interface server and the end destination’ and ‘redirecting the second communication link from the interface server to the mobile communication device,’ in a combination with other recited

⁷ The '181 Patent is being challenged in a concurrent petition for *inter partes* review by Petitioners in Case No. IPR2025-00446.

claimed limitations.” *Id.* at 860 (10/1/2018 Notice of Allowance) (emphasis omitted). Examiner further stated that U.S. Pub. No. 2009/0191864 to Mousseau *et al.* was “considered the closest prior art that teaches the roaming of a device from a first network to a second network by establishing a second communication link from the call control equipment 112 (interface server) to the roaming mobile 100 and therefore no second link is being established from the equipment 112 to end destination.” *Id.* (citing Mousseau, ¶ [0023]).

C. '181 Patent Prosecution History

As the Petition acknowledges, the prosecution history of the '154 Patent's parent, the '181 Patent, is relevant to these proceedings because of the substantive examination undergone by the '181 Patent. Pet. at 11-12 (discussing the '181 Patent Prosecution).

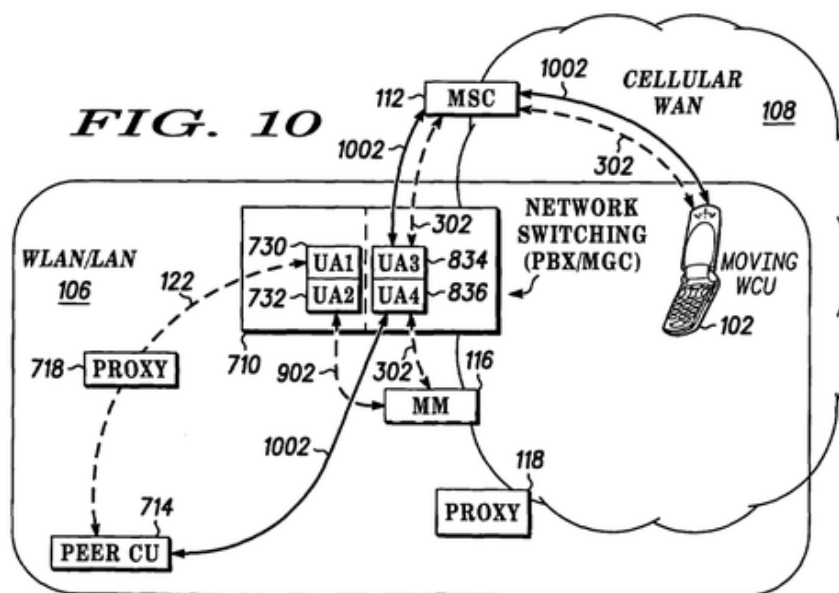
The '181 Patent was subject to a comprehensive and substantive examination by the Office. On November 5, 2012, the Office issued the application's second Non-final Office Action that rejected claims 1-9, *inter alia*, as allegedly being anticipated by U.S. Patent No. 8,041,360 to Ibe (“Ibe,” Ex. 2016). Ex. 2017 ('181 File History) at 6-9. The Applicant overcame this rejection by explaining that Ibe failed to teach establishing a second communication link “between the interface server and the end destination device.” *Id.* at 35-36 (Response to Non-Final Office dated 12/6/2012). Applicant persuasively argued—and without amendment—that

Ibe merely taught a new connection between a cellular proxy (the claimed interface server) and the mobile device, and not between the cellular proxy and the end destination. *Id.* at 35. The Office considered the Applicant's remarks "persuasive," and on February 7, 2013, the Office issued the application's third Non-final Office Action. *See id.* at 66 (finding Applicant's remarks filed 12/6/2012 were "fully considered and are persuasive").

In this third Non-final Office Action, the Examiner rejected claims 1-9 as allegedly being obvious over Ibe in combination with U.S. Patent No. 7,398,088 to Belkin (Ex. 2015, "Belkin"). The Examiner cited Belkin as disclosing notifying an interface server with the mobile communication device and establishing a second communication link between the interface server and the end destination device. Ex. 2017 at 52 (citing Ex. 2015 (Belkin) at Figs. 7-10, 13:32-44, 5:67-6:3, 13:45-14:2). Specifically, the Examiner argued that Belkin discloses a wireless communication unit that initiates a handover call ("notifying an interface server") that is routed via network switching function 112 to network switching function 110 ("interface server"). *Id.* (citing Ex. 2015 (Belkin) at Fig. 7-10, 13:32-44, 5:67-6:3).

The Examiner further cited Belkin's rerouting of the voice bearer RTP of the peer CU 714 (the "end destination device") to network switching function 710 (the interface server) and argued that link 1002 (the RTP stream seen in Fig. 10 of Belkin), is the claimed second communication link between end destination device

and interface server. Ex. 2017 ('181 Patent File History) at 52 (citing Ex. 2015 (Belkin) at Fig. 7-10, 13:45-14:2, 15:2-6); *see also id.* at 111-113 (Examiner clarifying the rejection in Final Office Action dated 6/27/2013).



Ex. 2015 (Belkin) at Fig. 10.

In response to this Office Action, the Applicant argued that Belkin only “teaches [] that the single connection between the peer CU 714 and the network switching function 710 is rerouted to the handover call port, not that a second connection is made between the peer CU 714 and the network switching function 710,” and that “[r]erouting a connection is not the same as establishing a second connection.” Ex. 2017 at 83 (emphasis original). The Examiner considered this argument and issued a Final Office Action, repeating its rejection of the claims in view of Ibe and Belkin. *Id.* at 111-113 (6/27/2013 Final Office Action).

The Applicant reiterated its argument that link 1002, between the peer CU 714 and the network switching function 740, is a rerouting of link 120 (alleged first communication link); it is not a separate or second link, as required by the claims. *Id.* at 135. To “emphasize this difference,” Applicant amended the claims to recite “establishing a second communication link between the interface server and the end destination device without disrupting the first communication link.” *Id.* (Response to Final Office Action 8/23/2013), 129 (emphasis modified).

The Examiner agreed with the Applicant's arguments and indicated the claims were non-obvious over Ibe and Belkin “in view of Applicant's amendments and arguments as filed on 8/23/2013.” *Id.* at 158, 172 (Notice of Allowance). There was further prosecution of other claims 14-18 and 38, which Applicant ultimately canceled. *Id.* at 165 (7/3/2014 Response to Final Office Action). A Notice of Allowance was issued on July 10, 2014, and the '181 Patent was issued on November 11, 2014. *Id.* at 167, 174.

V. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 325(d) BECAUSE PETITIONERS PRESENT SUBSTANTIALLY THE SAME ART AND ARGUMENTS

The Board “may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). The Board uses the following two-part framework:

- (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and
- (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims.

Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH, No. IPR2019-01469, Paper 6 at 8-9 (P.T.A.B. Feb. 13, 2020). If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review. “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

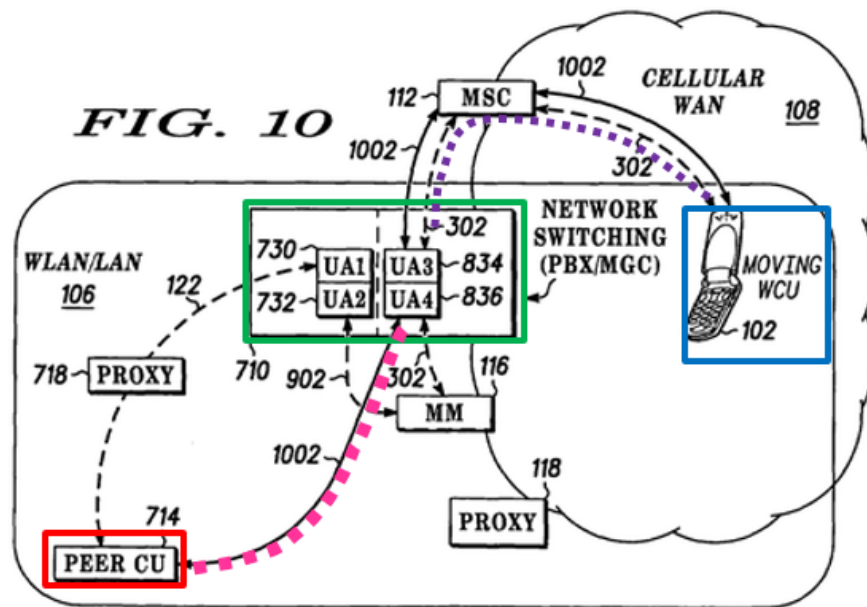
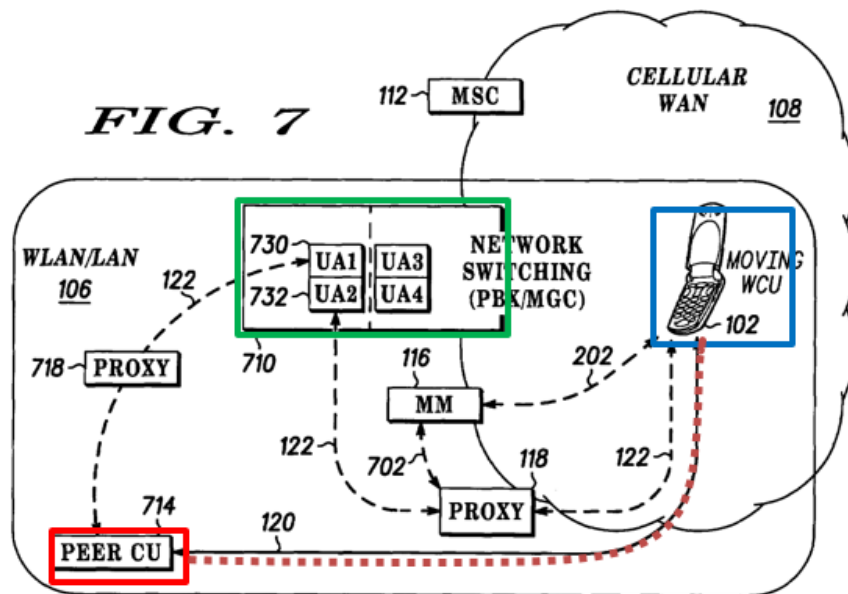
The Director should, therefore, deny institution because Petitioners' challenge relies on substantially the same arguments or substantially the same art previously considered by the Office during prosecution of the '154 Patent and its parent '182 Patent, and Petitioners have not demonstrated any material error. *Id.* at 10-11.

A. Substantially the Same Argument Was Previously Presented to the Office

Iizuka meets the first part of the *Advanced Bionics* framework because of the overlap between the arguments made during examination of the parent '181 Patent (in rejections based on Ibe and Belkin) and the manner in which Petitioners rely on Iizuka.

During examination of the parent '181 Patent, the Examiner rejected the '181 Patent claims as obvious over similar references used for identical purposes: Ibe and Belkin. *See* Ex. 2017 at 50-56 (2/7/2013 Office Action rejecting the then-pending Challenged Claims), 111-121 (6/27/2013 Final Office Action rejecting the same); Ex. 2016, Ex. 2015. Now, the Petition relies on Iizuka as disclosing and combining similar elements said during examination to be disclosed and combined by Ibe and Belkin. It is noted that Ibe and Belkin were cited during examination of the '154 Patent. Ex. 1002 at 72 (IDS filed 11/4/2014), 652 (making references considered).

During examination of the '181 Patent, the Examiner mapped Belkin's wireless communication unit (WCU) 102 to the claimed "**mobile communication device**," network switching function 710 to the claimed "**interface server**," peer communication unit (Peer CU) 714 to the claimed "**end destination device**," and link 1002 between Peer CU 714 and network switching function 710 to the "**second communication link**." Ex. 2017 at 52-53, 111-113.

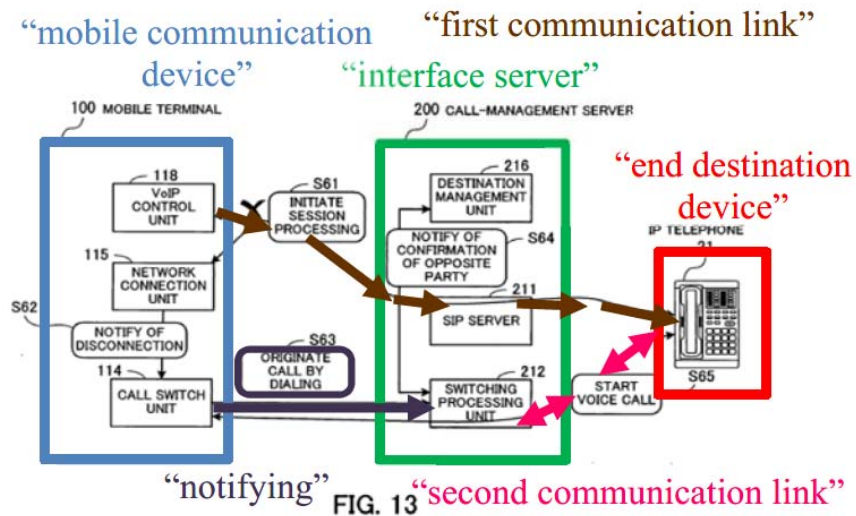


Ex. 2015 (Belkin) at Figs. 7 and 10 (annotated).

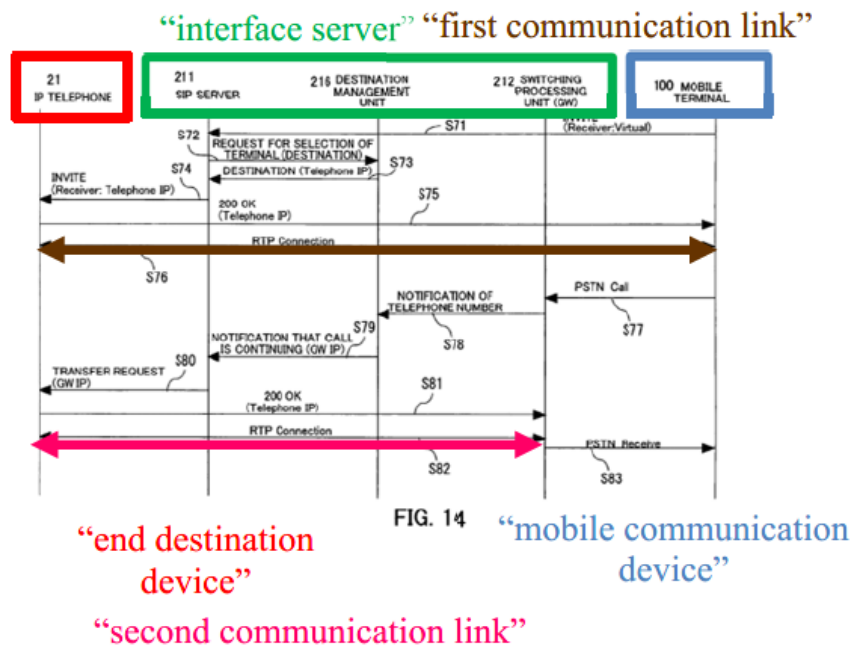
In overcoming the Examiner's rejections involving Belkin, Applicant argued that Belkin only "teaches [] that the single connection between the peer CU 714 and the network switching function 710 is rerouted to the handover call port, not that a

second connection is made between the peer CU 714 and the network switching function 710,” and that “[r]erouting a connection is not the same as establishing a second connection.” Ex. 2017 (’181 Patent File History) at 83 (emphasis original); see § IV.C, *supra*. The Examiner agreed with the Applicant’s reasoning and allowed the claims over the combination of Ibe and Belkin. Ex. 2017 at 158.

In the present Petition, Petitioners’ use of Iizuka is similar to the Examiner’s mapping of Belkin. Petitioners map Iizuka’s mobile terminal 100 to the claimed **“mobile communication device,”** the call management server 200 to the claimed **“interface server,”** the IP telephone 21 to the claimed **“end destination device,”** and the RTP or Real-time Transport Protocol connection (S82) between call-management server and the IP telephone to the **“second communication link.”** Pet. at 19-23, 39-45. Petitioners’ annotated Figures 13 and 14 of Iizuka are reproduced below.



Id. at 42 (annotating Fig. 13 of Iizuka).



Id. at 43 (annotating Fig. 14 of Iizuka). Under Petitioners’ theory, after a first communication link between a mobile device and an end destination device has been established at S76 (Pet. at 30-33), a second communication link (an RTP connection for real-time audio streams) is allegedly “established” at Step S82 between Iizuka’s call-management server 200 (alleged interface server) and its mobile terminal 100 (the alleged end destination device). Pet. at 41-42 (citing Iizuka, [0175]). But, Petitioners’ theory fails for the same reason as Examiner’s rejection using Ibe and Belkin.

Petitioners point to Iizuka’s “RTP Connection” at Step S82, which is the first RTP Connection (from Step S76) after it was rerouted from mobile terminal 100 to call-management server 200 (which—as prohibited by the claims—disrupts the first

communications link). Iizuka at [0173] (“[Step S80] The SIP server 211 transmits to the IP telephone 21 a transfer request in which the IP address of the switching processing unit 212 is designated.”) (emphasis added); *id.* at Fig. 14 (Step S80 depicting a “Transfer Request (GW IP)”). Accordingly, both the Figures and corresponding description show that the second RTP Connection (at Step S82) is the rerouted first RTP Connection (from S76) after the mobile terminal’s IP address was switched to the IP address for switching processing unit 212 of call-management server 200. *Id.* at [0173].

Petitioners’ short, one-paragraph discussion addressing discretionary denial under § 325(d) focuses on the fact that Iizuka and the other references “were not cited in an IDS or otherwise identified by the Examiner, or applied to reject claims during ’154’s prosecution.” Pet. at 14-15. Although Iizuka may be new in name, Petitioners made no effort to distinguish its *arguments* from those already considered and rejected by the Office.

Petitioners mention that the “Examiner also never considered the testimony of Petitioners’ expert Mark Lanning (Ex. 1003) regarding the scope and content of” the asserted references. *Id.* at 14 (citing over a range of 192 paragraphs of Mr. Lanning’s declaration). But Mr. Lanning’s testimony adds little to no benefit. Mr. Lanning’s declaration parrots the Petition’s argument, provides no analysis concerning whether and how Iizuka’s teachings cured the deficiencies identified

during prosecution of the '154 and '181 Patents, and fails to raise any argument that the Office has not already considered. *Compare* Ex. 1003 at ¶¶ 100-111 *with* Pet. at 39-48; *see Eyenovia, Inc. v. Sydnexis*, No. IPR2022-00963, Paper 7 at 17-21 (P.T.A.B. Nov. 8, 2022) (denying institution under § 325(d) when the expert's testimony was consistent with an argument the Examiner considered).

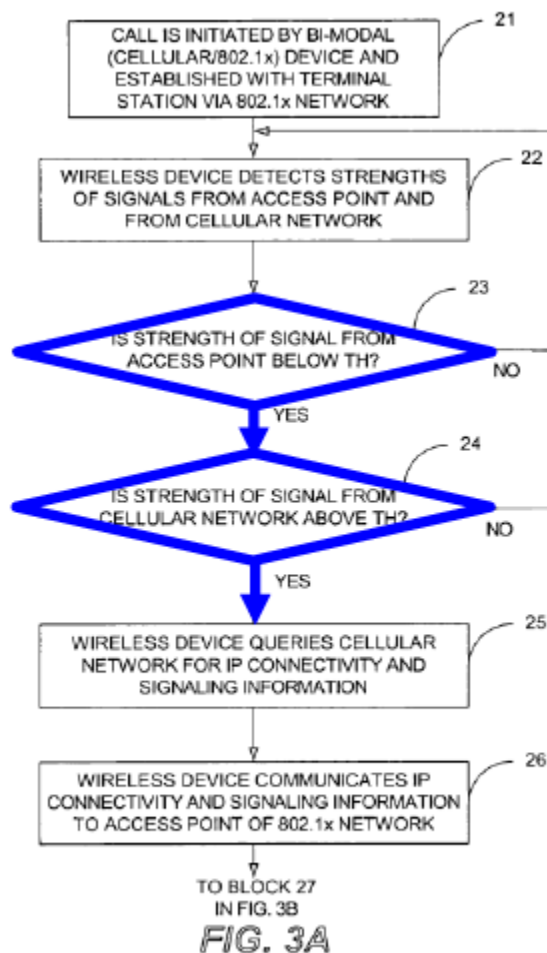
Accordingly, the Office already considered and rejected an argument that rerouting the original communication link between a mobile device and destination device to then be between an intermediary server and the communication device (as taught by Iizuka) satisfies the “establishing a second communication link between the interface server and the end destination device without disrupting the first communication link.” Thus, the first prong of the *Advanced Bionics* framework is satisfied. *Gator Bio, Inc. v. Sartorius Bioanalytical Instruments, Inc.*, No. IPR2023-00215, Paper 19 at 17-19, 22 (P.T.A.B. June 20, 2023) (denying institution where the challenges set forth in the Petition are based on the same or substantially the same prior art or arguments previously presented to the Office during patent examination for each of the asserted grounds).

B. Substantially the Same Prior Art Was Already Before the Office

Enzmann satisfies the first prong of the *Advanced Bionics* framework because it is cumulative to art considered during the '154 Patent examination. Enzmann is asserted in all grounds of the Petition and relied on for allegedly disclosing

determining “when a second context is preferred over the context of the first communication link.” Pet. at 45-48. Enzmann is cumulative to Jagadeesan (Ex. 2013), which was previously presented to the Office during examination. See Ex. 1002 at 76 (IDS filed 11/4/2014), at 656 (marking reference considered).

Petitioners cite Enzmann's Figure 3A (Pet. at 47), which is a flow chart “seamlessly handing off a wireless device call from an 802.1x network to a cellular network” (Enzmann, [0013]), as allegedly disclosing “when a second context is preferred over the context of the first communication link”:



“a second context preferred over the context of [a] communication link”

Pet. at 47 (citing Fig. 3A of Enzmann) (annotations original).

But this disclosure is remarkably similar to a corresponding figure in Jagadeesan, reproduced below with annotations.

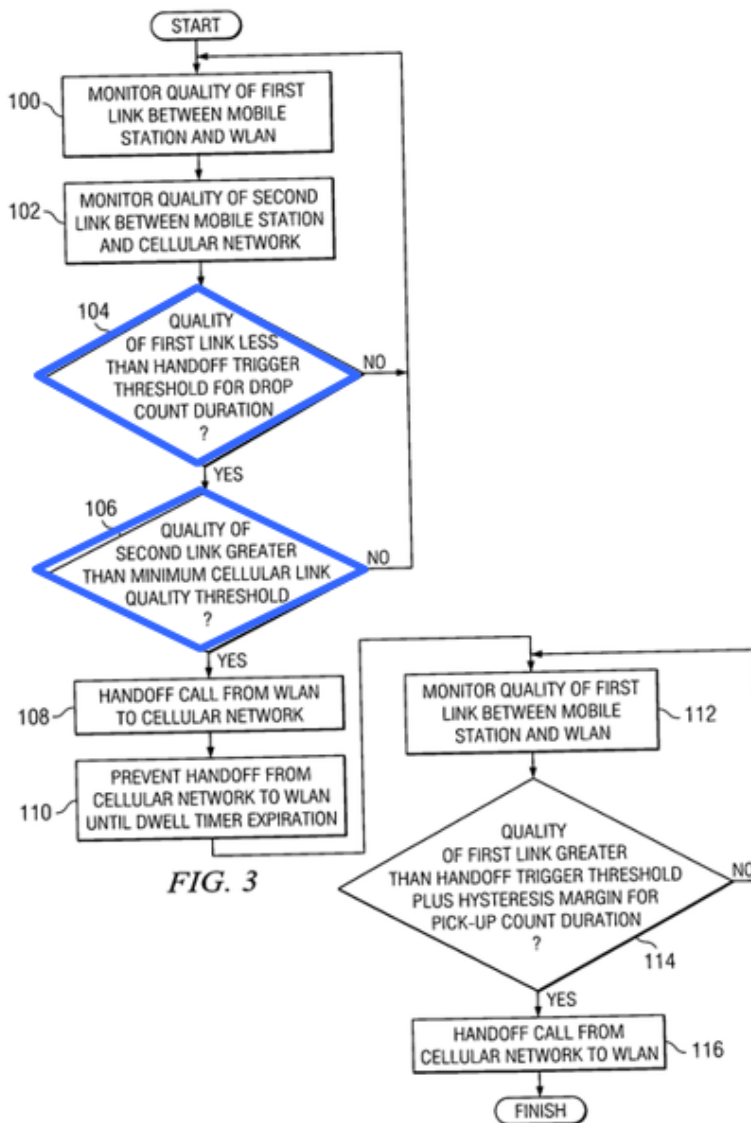


FIG. 3

Jagadeesan (Ex. 2013) at Fig. 3 (annotations added).

In fact, Petitioners cite Enzmann's description of these steps in [0025], which closely mirrors a corresponding disclosure in Jagadeesan:

Examiner-Cited Prior Art	IPR-Asserted Reference
<p>Jagadeesan:</p> <p>[0048]: “if the quality of the first link is <i>less than a handoff trigger threshold</i> for a drop count duration then the method proceeds to step 106 . . . if the <i>quality of the second link is greater than a minimum cellular link quality threshold</i> then the method proceeds . . .”</p> <p>Ex. 2013 (emphasis added).</p>	<p>Enzmann:</p> <p>[0025]: “A <i>determination is made as to whether the strength of the signal from the access point 7 has dropped below a certain threshold level, as indicated by decision block 23. If so, a determination is made as to whether the strength of the signal from the cellular network is at or above a certain threshold level, as indicated by decision block 24.</i>”</p> <p>Pet. at 47-48 (emphasis original).</p>

Therefore, Enzmann is cumulative to Jagadeesan, which was already before the Office during examination of the '154 Patent.

C. Petitioners Made No Showing of Material Error

The second prong of *Advanced Bionics* is satisfied because Petitioners do not show that the Examiner erred in a manner material to patentability. Petitioners allege no error by the Office, let alone material error. Pet. at 14-15. At best, Petitioners provide a vague, generic catch-all argument that “the references describe [] features the Examiner found missing from the prior art during prosecution of the parent '181,” but they fail to identify with any particularity what features they are referring to. *Id.* (citing the entirety of §IX, which spans 60 pages of analysis).

This “generalized statement[] as to the strength of its Petition fail[s] to identify sufficiently a material error.” *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, No. IPR2024-01280, Paper 13 at 6 (P.T.A.B. May 19, 2025) (precedential). Petitioners’ invitation for the Board to scour 60 pages of analysis to cobble together an argument under the second part of *Advanced Bionics* improperly shifts Petitioners’ burden to demonstrate material error onto the Board. *See Gross v. Town of Cicero, Ill.*, 619 F.3d 697, 702 (7th Cir. 2010) (“Judges are not like pigs, hunting for truffles buried in [the record].”) (citation omitted). The Board should, therefore, defer to the Examiner’s evaluation of the same evidence or arguments asserted here and exercise its discretion to deny institution. *Advanced Bionics*, Paper 6 at 8-9 (indicating that the Board should exercise discretion to deny institution if the petitioner fails to make a showing of material error because “this framework reflects a commitment to defer to previous Office evaluations of the evidence of record”).

Because the Petition presents only the same or substantially the same prior art and arguments previously presented during prosecution, and because Petitioners have failed to make any showing of error by the USPTO, the Board should exercise its discretion and deny institution under 35 U.S.C. § 325(d). *See Advanced Bionics*, Paper 6 at 7-9.

VI. CONCLUSION

For all of these reasons, Vasu accordingly requests that the Board deny institution of *inter partes* review of the Challenged Claims of the '154 Patent.

Respectfully submitted,

Dated: May 27, 2025

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CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24

The undersigned hereby certifies that the portions of the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** has 8,210 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24 and the Acting Director's "Interim Processes for PTAB Workload Management" Memorandum. This word count was prepared using the Microsoft Word word-processing system used to prepare this paper.

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CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the Patent Trial and Appeal Case Tracking System (P-TACTS) constitutes electronic service, service was made on Petitioner as detailed below.

<i>Date of service</i>	May 27, 2025
<i>Manner of service</i>	Electronic Filing with the Board (james.l.davis@ropesgray.com; alexander.middleton@ropesgray.com; christopher.bonny@ropesgray.com; Samsung-Vasu-IPR-Ropes@ropesgray.com)
<i>Documents served</i>	PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL
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