

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

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**SAMSUNG ELECTRONICS CO., LTD., AND  
SAMSUNG ELECTRONICS AMERICA, INC.,**

Petitioners,

v.

**VASU HOLDINGS, LLC,**

Patent Owner.

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

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**PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR  
DISCRETIONARY DENIAL**

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**EXHIBIT LIST**

<b>Exhibit No.</b>	<b>DESCRIPTION</b>
1001	U.S. Patent No. 10,206,154 (“154”)
1002	File History of U.S. Application No. 14/510,766 (“154FH”)
1003	Declaration of Mark Lanning (“Lanning”)
1004	U.S. Patent App. Pub. 2005/0282541 (“Iizuka”)
1005	U.S. Patent App. Pub. 2002/0126654 (“Preston”)
1006	<i>Reserved</i>
1007	<i>Reserved</i>
1008	U.S. Provisional App. No. 60/534,466 (“466-Prov”)
1009	U.S. Provisional App. No. 60/643,829 (“829-Prov”)
1010	U.S. Patent App. No. 11/031,498 (“498-CIP”)
1011	U.S. Patent Pub. 2005/0136927 (“Enzmann”)
1012	U.S. Patent Pub. 2007/0146475 (“Inoue”)
1013	U.S. Patent Pub. No. 2003/0134638 (“Sundar”)
1014	Docket Control Order (Dkt. No. 28), <i>Vasu Holdings, LLC v. Samsung Electronics Co., Ltd.</i> , No. 2:24-cv-00034-JRG-RSP (E.D. Tex.)
1015	U.S. Patent Pub. No. 2004/0009761 (“Money”)
1016	Jim Zyren, Intersil Corporation, “IEEE 802.11g Explained” (2001), available at <a href="https://www.3g4g.co.uk/Other/WiLan/802_11g/WP_IEEE802gExpla_12_06.pdf">https://www.3g4g.co.uk/Other/WiLan/802_11g/WP_IEEE802gExpla_12_06.pdf</a>
1017	Guide to IEEE 802.11 Wireless LAN Standards, EE Times (May 23, 2003), available at <a href="https://www.eetimes.com/guide-to-ieee-802-11-wireless-lan-standards/">https://www.eetimes.com/guide-to-ieee-802-11-wireless-lan-standards/</a>

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<b>Exhibit No.</b>	<b>DESCRIPTION</b>
1018	File History of U.S. Application No. 13/240,776 (“181FH”)
1019	Plaintiff Vasu Holdings, LLC’s Objections and Responses to Defendants Samsung Electronics Co., Ltd, and Samsung Electronics America, Inc.’s First Set of Interrogatories (Nos. 1-25)
1020	Plaintiff Vasu Holdings, LLC’s Supplemental Objections and Responses to Defendants Samsung Electronics Co., Ltd, and Samsung Electronics America, Inc.’s Interrogatories (Nos. 1-5, 8, 9, 13-15, 19-22, 25)
1021	Plaintiff Vasu Holdings, LLC’s Objections and Responses to Defendants Samsung Electronics Co., Ltd, and Samsung Electronics America, Inc.’s Second Set of Interrogatories (No. 26)
1022	U.S. Patent No. 7,664,501 (“Dutta”)
1023	Dictionary of Computer Science, Engineering, and Technology
1024	Microsoft Computer Dictionary, Fifth Edition
1025	WiFi Alliance, WiFi Overview
1026	U.S. Patent Pub. No. 2005/0190747 (“Sindhvani”)
1027	U.S. Patent No. 6,300,887 (“Le”)
1028	U.S. Patent No. 7,751,316 (“Yarlagadda”)
1029	U.S. Patent No. 7,359,979 (“Gentle”)
1030	Declaration of Jonathan Bradford
1031	Petitioners’ Offered Stipulation
1032	Order Denying Defendants’ Motion to Stay Pending Inter Partes Review (Dkt. No. 69), <i>Vasu Holdings, LLC v. Samsung Electronics Co., Ltd.</i> , No. 2:24-cv-00034-JRG-RSP (E.D. Tex.)
1033	C. Bonny Letter to P. Andre (June 25, 2024)

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1039	Plaintiff Vasu Holdings, LLC's Disclosure of Asserted Claims and Amended Infringement Contentions (June 18, 2025)
1040	A. Middleton Letter to C. Tirado (Sept. 18, 2024) <sup>1</sup>
1041	A. Middleton Letter to C. Tirado (Nov. 18, 2024)

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<sup>1</sup> Exhibits 1040 and 1041 have been redacted to remove references to source code file names and file paths.

**TABLE OF ABBREVIATIONS**

<b>Abbreviation</b>	<b>DESCRIPTION</b>
'154	U.S. Patent No. 10,206,154 (“’154”) (Ex. 1001)
'154FH	File History of U.S. Application No. 14/510,766 (Ex. 1002)
'181FH	File History of U.S. Application No. 13/240,776 (Ex. 1018)
IPR	<i>Inter Partes</i> Review
Petitioners, Samsung	Petitioners Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc.
PO, Vasu	Patent Owner Vasu Holdings, LLC
POSITA	Person of Ordinary Skill in the Art
PTAB	Patent Trial and Appeal Board
USPTO	United States Patent and Trademark Office
Pet.	Petition, Paper 2
Belkin	U.S. Patent No. 7,398,088 (“Belkin”) (Ex. 2015)
Ibe	U.S. Patent No. 8,041,360 (“Ibe”) (Ex. 2016)

## I. INTRODUCTION

This Petition for *Inter Partes* Review is part of a set of five petitions filed by Petitioners Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (“Samsung”) in January 2025 against four related patents assigned to Patent Owner Vasu Holdings, LLC (“PO”).<sup>2</sup>

Discretionary denial is not warranted under either under §314(a) or §325(d).

The *Fintiv* factors do not support denial, and are at worst neutral. Samsung's original motion to stay the district court case was denied without prejudice as “premature,” but Samsung intends to promptly renew its motion upon institution of this Petition. There is still much work to be done in the district court, with all of expert discovery and dispositive motions yet to be completed. Further, there is no guarantee that the trial date will hold given that there are *ten other trials set on the same date* as the trial involving PO and Samsung. Moreover, Samsung has agreed to *withdraw all §102 and §103 challenges entirely* in the district court case should the Board institute review, eliminating any possibility of overlap between the IPRs

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<sup>2</sup> The related proceedings are IPR2025-00446 (U.S. Patent No. 8,886,181), IPR2025-00448 and -00449 (U.S. Patent No. 10,368,281), and IPR2025-00450 (U.S. Patent No. 10,419,996).

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and the district court proceeding. And Samsung's petitions have compelling merits, which PO does not dispute aside from its argument that the prior art fails to teach limitation [1.c]. During prosecution of the parent '181 patent, the Examiner allowed the claims because the art allegedly did not teach establishing a second communication link "without disrupting the first communication link," which is also a requirement of limitation [1.c] and [43.c] of the '154 patent (Pet., at 11-12; Ex. 1018, at 577, 620). But as explained in the Petition (Pet., 39-48) and herein, Iizuka teaches that "[t]he switching processing unit 212 realizes a voice call through the mobile telephone network 10 *while the VoIP call which has already been established still continues*" (Iizuka, [0162]). Indeed, Iizuka in view of Enzmann discloses or renders obvious all limitations of independent claims 1 and 43, but these references were not considered by the Examiner. Finally, even though the patents-in-suit issued between 2014 and 2019, PO never previously asserted these patents until filing its complaint against Samsung in 2024. Moreover, *PO waited about a decade* after the first accused features were sold in 2013 and the patents-in-suit were issued in 2014 to 2019, before filing suit against Samsung in 2024. Thus, even if Samsung were aware of the patents-in-suit, there was a settled expectation that Samsung was not practicing the patents, and it would be unreasonable to expect Samsung to have filed IPR petitions before it did.

As to §325(d), none of Samsung's references were before the Examiner, and

PO fails to show that they are cumulative of any references that were.

## **II. DISCRETIONARY DENIAL IS NOT WARRANTED**

### **A. The Fintiv Factors Do Not Support Discretionary Denial**

Co-pending district court litigation in the United States District Court for the Eastern District of Texas does not warrant the exercise of discretion under §314(a). *See Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, Pap. 11 (designated precedential) (“*Fintiv*”). Nearly all of the *Fintiv* factors, enumerated below, do not support discretionary denial. *Id.* at 5-6.

#### **1. Factor 1 (Stay) Does Not Support Discretionary Denial**

The first *Fintiv* factor weighs against discretionary denial and is at worst neutral. This factor weighs against exercising discretion in cases where there is no stay but “the district court has denied a motion for stay without prejudice and indicated to the parties that it will consider a renewed motion . . . to stay if a PTAB trial is instituted.” *Fintiv* at 6-7. Here, the district court denied Samsung’s pre-institution motion without prejudice, stating that the motion was “premature.” Ex. 1032. Samsung is free—and intends—to renew its motion to stay if the Board institutes IPR. Indeed, in the past, this district court has weighed a pre-institution motion to stay followed by a prompt renewal of that motion after institution *in favor* of granting a stay. *e-Watch Inc. v. Apple, Inc.*, No. 2:13-cv-1061-JRG-RSP, 2015 WL 12915668, at \*3 (E.D. Tex. Mar. 25, 2015) (holding that the timing of the

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defendant's earlier motion to stay weighs in favor of granting the defendant's "promptly renewed" motion to stay after institution).

PO's argument that Judge Gilstrap has "denied nearly every petitioner's motion to stay when the IPR petition was filed 10 months after receiving the complaint" should be given no weight as it lacks any support and, further, ignores that Patent Owner's ("PO") conduct was the cause of any alleged delay in filing the Petition (which Samsung filed within the statutory deadline to do so). PO served infringement contentions on May 15, 2024 and subsequently served supplemental contentions on August 30, 2024 and again on October 24, 2024—both in response to deficiency letters served by Samsung that identified myriad issues with PO's contentions.

For example, as outlined in Samsung's June 25, 2024 deficiency letter, PO's preliminary infringement contentions improperly grouped disparate products under single claim charts without sufficient explanations of representativeness, failed to chart each accused produce and to provide element-by-element specificity for each asserted claim, inadequately identified how certain claim elements were met by the accused products, and used broad, unsupported assertions regarding product similarity and functionality—creating profound uncertainty for Samsung as to PO's infringement theories. Ex. 1033. As just one example, PO failed to identify an alleged second communication link between an interface server and the alleged end

destination device as required by limitation [1.c] (Ex. 1029, at 6), i.e., the same element that Vasu now focuses on for its §325(d) analysis and incorrectly contends is missing from the prior art. As another example, PO failed to identify what it contends is a notification to an interface server as required by limitation [1.c]. *Id.*, at 5.

PO's supplemental contentions suffered from these same, if not worse, defects. PO doubled down on its vague, inconsistent arguments—this time adding new accused products and hundreds of files of Samsung source code without identifying where each claim element was found. Ex. 1034. For example, in its August 30, 2024 contentions, PO still had not identified what it contends is a notification to an interface server. Ex. 1040, 9-10. PO also identified a new alleged “interface server,” but did not explain how the alleged interface server satisfied any of the limitations relating to the claimed interface server, including limitations [1.c] and [1.e]. Ex. 1040, 9. These deficiencies were prejudicial to Samsung because the '154 specification provides minimal guidance regarding certain claim terms, including the “re-directing” step of limitation [1.e]. The specification refers to a “call is then redirected” (Ex. 1001, 10:64, 11:56), but does not explain how this “re-direct[s] the second communication link”—i.e., the claimed link between the interface server and the end destination device—“*from the interface server to the mobile communication device*” as required by limitation [1.e]. And in its October

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24, 2024 contentions—the most recent set that PO had served at the time the petitions were filed—PO still had not explained, among other issues, how the alleged interface server satisfied this same limitation. Ex. 1041, at 5.

Despite Samsung's attempts to understand PO's assertions, PO's deficient contentions created uncertainty as to the asserted claims and infringement theories, such that Samsung could not seek IPR earlier. As such, Samsung was as diligent as it could be under these circumstances. Indeed, the uncertainty surrounding PO's infringement theories has continued even after the Petition was filed on January 24, 2025, as PO served proposed supplemental infringement contentions on February 28, 2025 and supplemental infringement contentions on March 24, 2025, and after the close of fact discovery served amended infringement contentions on June 18, 2025. But Samsung was not able to wait any longer for additional clarity due to the impending 1-year bar date, and filed its petitions for IPR of the patents-in-suit on January 24-25, 2025. The time of filing should therefore be given no weight because it was PO's own lack of diligence that forced Samsung to file when it did.

Moreover, contrary to PO's argument, it is not a "foregone conclusion" that a renewed motion to stay would be denied because of the stage of the district court case. While fact discovery has closed and a trial date is scheduled, no depositions have been scheduled for any of the eight experts in the case, and expert discovery does not close until July 21, 2025. Furthermore, besides the parties' joint motion to

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dismiss two of the asserted patents, no case dispositive motions have been filed. The deadline to file summary judgment and *Daubert* motions is weeks away on July 28, 2025. And the parties will still have pre-trial filings, motions in limine, and the pre-trial conference to follow after institution. It is unlikely Judge Gilstrap will have issued any decisions on summary judgment and *Daubert* motions, and will not have issued or yet considered any motions in limine, by the time of the Board's institution decision. Contrary to PO's arguments, the district court has granted stays in similar circumstances. *See SSL Servs., LLC v. Cisco Sys., Inc*, 5-cv-433, 2016 WL 3523871, at \*2 (E.D. Tex. June 28, 2016) (granting a stay even though the case was at "a relatively late stage" in which claim construction had taken place and trial was less than three months away, in part because "this case is not yet on the eve of trial..."); *Stingray Music USA, Inc. v. Music Choice*, No. 16-cv-00586, 2017 WL 9885167 (E.D. Tex. Dec. 12, 2017) (granting stay where fact discovery had closed and expert reports exchanged because "a stay might still obviate the need to prepare for trial [on] some or all ... claims, thus reducing the burden ... on the parties and the Court").

That said, in these circumstances, factor one is often found to be neutral because the district court's consideration of a renewed stay motion "is based on a variety of circumstances and facts beyond [the Board's] control and to which the Board is not privy." *Samsung Elecs. Co., Ltd. v. Truesight Commc'ns LLC*,

IPR2024-01477, Paper 12 at 10-11 (PTAB Apr. 21, 2025) (finding factor one neutral in IPR brought by petitioner against another patent asserted in the same district court litigation). As such, this factor weighs against discretionary denial and is at worst neutral.

**2. Factor 2 (Trial Date) Does Not Support Discretionary Denial**

Even if Factor 2 (“proximity of the court’s trial date to the Board’s projected statutory deadline”) weighs somewhat in favor of exercising discretion, it does not outweigh the other factors, which collectively weigh in favor of the Board not exercising discretion to deny institution. Samsung acknowledges that a trial date in the parallel litigation is presently scheduled ten months prior to an expected date of a Final Written Decision in this proceeding. However, trial dates in this district court are routinely delayed for various reasons. *See, e.g., Ex. 1035, Multimedia Techs. PTE Ltd. v. LG Elecs. Inc., et al., 2:22-cv-00494-JRG-RSP, Dkt. 273 (E.D. Tex. Mar. 18, 2025)* (stating that “[t]his case has been set for trial five times: November 18, 2024, January 27, 2025, February 7, 2025, March 3, 2025, and March 17, 2025. ... The parties have also been notified that other cases are preferentially set ahead of them for the April 7, 2025 and April 21, 2025 trial settings.”).

In this regard, although trial is currently set for November 3, 2025, Samsung expects the district court litigation to be delayed because ten other active cases are

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also scheduled for trial on that same date. Ex. 1036; *see Boe Tech. Grp. Co. v. Optronix Scis. LLC*, No. IPR2024-01130, 2025 WL 305477, at \*4 (P.T.A.B. Jan. 27, 2025) (*Fintiv* factor 2 “neutral or weigh[s] slightly in favor of not exercising discretion” where Judge Gilstrap “set 10 cases for jury selection on the same day”).

Moreover, this factor still “must be balanced” against other factors, including the existence of a petitioner stipulation (factor 4). *Samsung Display Co., Ltd., v. Pictiva Displays Int’l Ltd.*, IPR2024-01222, Paper 12 at 6, 9 (P.T.A.B. Mar. 6, 2025) (post-rescission) (deciding not to exercise discretionary denial even though trial date preceded the expected final written decision date by seven months, in view of other factors); *see also Posco Co., Ltd., v. Arcelormittal*, IPR2024-01376, Paper 11 at 13-14, 17 (P.T.A.B. Mar. 18, 2025) (post-rescission) (deciding not to exercise discretionary denial even though trial date preceded the expected final written decision date by five months, in view of other factors); *Palo Alto Networks, Inc. v. Croga Innovations Ltd.*, IPR2024-01421, Paper 8 at 11, 13-14 (P.T.A.B. Mar. 14, 2025) (post-rescission) (deciding not to exercise discretionary denial even though the trial date preceded the expected final written decision date by five months, in view of other factors). As such, factor 2 does not outweigh the considerations in the other factors, which on balance favor the Board not exercising its discretion.

**3. Factor 3 (Parallel Proceeding) Does Not Support Discretionary Denial**

Factor 3 either weighs against discretionary denial or is at worst neutral. This factor considers “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution.” *Fintiv*, Paper 11 at 9. “If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.” *Id.* at 10. Here, the district court has not made a single substantive ruling regarding the '154, and PO does not argue otherwise. Paper 8 at 12-16. This factor therefore weighs against discretionary denial for this reason alone.

Moreover, while fact discovery has closed and a trial date is scheduled in this case, this factor weighs against discretionary denial given the number and type of outstanding issues remaining. No depositions have been scheduled for any of the eight experts in the case. Expert discovery does not close until July 21, 2025. Furthermore, besides the parties' joint motion to dismiss two of the asserted patents, no case dispositive motions have been filed. The deadline to file summary judgment and Daubert motions is weeks away on July 28, 2025, with pre-trial filings, motions in limine, the pre-trial conference and trial to follow. Notably, the Board has found that this factor favors institution even in cases that have advanced beyond the

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completion of Markman briefing and fact discovery. *See Samsung*, IPR2024-01222, Paper 12 at 7 (finding this factor weighs against denial, even though a Markman hearing has been held, in part because “much remains to be done, including expert discovery”); *see also SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01432, Paper 14 at 8-9 (P.T.A.B. Apr. 7, 2025) (this factor favored institution even after Markman briefing was complete).

PO's claims that this factor weighs in favor of denial because Samsung was not diligent in filing the Petition but, as stated in Factor 1, PO, not Samsung, was responsible for any alleged filing delay. PO states that its preliminary infringement contentions were served on May 15, 2024, but conveniently omits that it twice served supplemental contentions in the months before the Petition was filed in response to the deficiencies raised by Samsung. Exs. 1033-1034. PO's repeated deficiencies, which continued even after the Petition was filed, created uncertainty regarding PO's infringement claims, hindering Samsung's ability to file. In other words, it was *PO's* lack of diligence—not Samsung's—that caused any purported delay in filing. Samsung was as diligent as it could be under the circumstances.

Therefore, because of the stage of the parallel litigation and Samsung's diligence, this factor weighs slightly against discretionary denial and is at worst neutral.

**4. Factor 4 (Issue Overlap) Does Not Support Discretionary Denial**

The *Fintiv* Board explained that “if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution under NHK.” *Fintiv*, IPR2020-00019, Paper 11, 12–13. Here, Samsung’s stipulation is ironclad—going even further than a *Sotera* stipulation. Samsung has unequivocally committed that, should the Board institute review, it will not only withdraw any §§ 102 and 103 grounds it raised or could have raised in the IPR, but it will ***withdraw all §102 and §103 challenges entirely***—leaving only §§ 101 and 112 issues for trial. Ex. 1031. Those remaining questions are beyond the Board’s statutory jurisdiction in this IPR, so they can proceed in district court without risk of duplicative effort or inconsistent rulings. Because of this stipulation, the district court and the Board will be adjudicating distinct questions, supported by distinct records, governed by distinct evidentiary standards, and tried to distinct decision-makers. The forums will not confront duplicative arguments or expert testimony, and institution would promote efficiency in the district court because the judge and jury will not have to consider hundreds of pages of evidence and hours of expert testimony on these matters.

The Board routinely finds that Factor 4 weighs strongly against discretionary

denial where a petitioner tenders a broad “*Sotera* stipulation” relinquishing any ability to pursue in the district court the same §§ 102 and 103 grounds it advances in the IPR because there is no meaningful overlap of issues. Here, in light of Samsung’s stipulation regarding all §§ 102 and 103 arguments, this factor even more strongly weighs against discretionary denial.

In addition, the Petition challenges claims 2, 4, 43, and 45-47, which are not asserted in the litigation. Ex. 1037. Thus, the validity of these claims will not be decided in the litigation, which further weighs against discretionary denial.

PO’s arguments regarding statements in the Petition are misplaced, as Samsung’s statements were mooted by its stipulation.

In sum, Factor 4 strongly weighs in favor of institution because Samsung’s stipulation streamlines the overall dispute by channeling all anticipation and obviousness inquiries to the Board and indisputably ensures that this IPR will be a true alternative to the district court litigation, and because the Petition challenges claims that are not asserted in the litigation.

**5. Factor 5 (Same Party) Does Not Support Discretionary Denial**

Factor 5 is neutral. Each of the Petitioners is a defendant in the parallel litigation. Nothing within *Fintiv* suggests that the same party between the proceedings weighs in favor of discretionary denial. *See HP Inc. v. Slingshot*

*Printing LLC*, IPR2020-01084, Paper 13 at 9 (P.T.A.B. Jan. 14, 2021) (having the “same parties as parallel proceeding” makes factor 5 “neutral”).

**6. Factor 6 (Other Considerations) Does Not Support Discretionary Denial**

This factor considers “other circumstances” that may impact the exercise of discretionary denial, such as the merits of the petition. *Fintiv*, at 14.

Factor 6 weighs against denial because the merits of the Petition are compelling. PO makes no real argument against the merits of Samsung's petition aside from asserting without explanation that Samsung fails to show a reasonable likelihood that the asserted references teach or suggest limitation [1.c]. Paper 8, at 23. And while this issue is discussed in PO's §325(d) analysis, the same or substantially the same art and arguments were not previously before the PTO. *See infra* §III. PO also argues in its Patent Owner's Preliminary Response that Iizuka fails to teach limitation [1.c], but Samsung has presented extensive analysis regarding how Iizuka teaches limitation [1.c]. *See infra* §III. During prosecution of the parent '181 patent, the Examiner allowed the claims because the art allegedly did not teach establishing a second communication link “without disrupting the first communication link,” which is also a requirement of limitations [1.c] and [43.c] of the '154 patent (Pet., at 11-12; Ex. 1018, at 577, 620). But as explained in the Petition (Pet., 39-48) and herein, Iizuka teaches that “[t]he switching processing unit

212 realizes a voice call through the mobile telephone network 10 ***while the VoIP call which has already been established still continues***" (Iizuka, [0162]). Indeed, Iizuka in view of Enzmann discloses or renders obvious all limitations of independent claims 1 and 43, but these references were not considered by the Examiner. PO does not argue that any other limitation other than [1.c]/[43.c] is missing from the prior art. Pap. 9, at 14-23.

In addition, the settled expectations of the parties weigh against discretionary denial. As the Acting Director recently noted, "a patent may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner's particular technology space, if at all. These non-exclusive examples provide considerations that weigh against a patent owner's claim of settled expectations and bears on the Director's discretion." *Intel Corp. v. Proxense, LLC*, IPR2025-00327, Pap. 12, at 2-3 (P.T.A.B. June 26, 2025). The four patents-in-suit issued between 2014 and 2019. The accused features across all four patents-in-suit were sold as early as 2013 (Ex. 1038, at 14 (table showing the year each accused feature was introduced by Samsung); Ex. 1039, at 2-4 (listing the accused features for the patents-in-suit)), and yet PO waited about a decade before filing suit against Samsung in 2024. PO had also never asserted the patents-in-suit before. Thus, even if Samsung were aware of the patents-in-suit, there was a settled expectation that Samsung was not practicing the patents-in-suit, and it would be

unreasonable to expect Samsung to have filed IPR petitions before it did. These circumstances further weigh against discretionary denial.

\* \* \*

As demonstrated above, nearly all *Fintiv* factors are either neutral or weigh against discretionary denial and the other relevant considerations in this case further disfavor denial. Discretionary denial is therefore not warranted.

### **III. §325(d) DISCRETION SHOULD NOT BE APPLIED**

Under the two-part *Advanced Bionics* framework, there is no basis for discretionary denial under 35 U.S.C. § 325(d), as the Grounds raised by this Petition are not the same or substantially the same as the art or arguments raised during '154's prosecution. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Pap. 6, \*8 (precedential) (establishing two-part framework for addressing 35 U.S.C. § 325(d)). Samsung relies on the following Grounds, none of which was considered by the Patent Office:

Ground 1: Iizuka in view of Enzmann (claims 1, 2, 4, 43, and 45-47);

Ground 2: Iizuka in view of Enzmann and Inoue (claims 1, 2, 4, 43, and 45-47);

Ground 3: Iizuka in view of Enzmann and Sundar (claims 45-47); and

Ground 4: Ground 3 in further view Inoue (claims 45-47). Pet., 6.

None of these references in Grounds 1-2 was raised during the prosecution of the '154, and while a version of Sundar (Sundar is only used in Grounds 3-4) was

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cited in an IDS during the examination of the '154, the Examiner never cited it in a rejection or considered it in combination with Iizuka, Enzmann, or Inoue. Pet., 14-15. PO does not dispute this. Instead, PO argues that these references are cumulative of art before the Patent Office. But PO fails to acknowledge key disclosures of the references relied on in Samsung's Petition that distinguish those references from the art relied upon during prosecution. Specifically, PO admits that the art considered during prosecution does not teach establishing a second communication link, for which Samsung relies on Iizuka's teaching of establishing two simultaneous communication links. PO instead glosses over Iizuka's extensive disclosures regarding establishing a second communication link to draw an untenable comparison to art that was merely cited in an IDS during the '154 prosecution.

And even if PO's assertion that the same or substantially the same art was before the Examiner were accurate (it is not), the Examiner erred by failing to apply the art to—and allowing—the '154's Challenged Claims. First, if Belkin is somehow cumulative to the disclosures in Iizuka (it is not), then the Examiner erred in overlooking the disclosures in Belkin. Second, PO argues that Enzmann (relied on by Samsung in all grounds for a portion of [1.c]) and Jagadeesan (cited in an IDS during prosecution) both disclose similar teachings, but the Examiner never cited Jagadeesan during prosecution. Indeed, PO does not dispute that Enzmann teaches “when a second context is preferred over the context of the first communication link”

in limitation [1.c]—the only limitation of claim 1 for which Enzmann is applied. Thus, to the extent that Jagadeesan's disclosures are substantially the same as Enzmann's, the Examiner erred in overlooking the disclosures of Jagadeesan.

For the reasons set forth in the Petition, the IPR should be instituted.

**A. Iizuka's Teaching of Establishing a Second Communication Link is Not the Same as Belkin's Teaching of Rerouting (All Grounds)**

PO incorrectly argues that Iizuka is cumulative of Belkin based on the incorrect assertion that they both teach rerouting of information instead of the "establishing a second communication link" as required by the claims.<sup>3</sup> Paper 8, at 31-36. But as explained below, PO ignores that instead of merely rerouting data, Iizuka teaches establishing a second communication link while a first communication "still continues," such that two communication links are established simultaneously, and not a mere re-routing of a single communication link that the Examiner found to be insufficient. Moreover, while Belkin is listed on the face of the '154 patent, the Examiner did not discuss the Belkin reference. Instead, Belkin was discussed during prosecution of the parent U.S. Patent 8,886,181 by a different

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<sup>3</sup> While PO also asserts that "the Petition relies on Iizuka as disclosing and combining similar elements said during examination to be disclosed and combined by Ibe and Belkin" (Paper 8, at 31), PO only addresses Belkin, and makes no attempt to show any overlap between Iizuka's disclosure and Ibe's.

Examiner.

Samsung relies on Iizuka, in part, as disclosing '154 [1.c] (“...establishing a second communication link between the interface server and the end destination device...”) and [1.e] (“re-directing the second communication link from the interface server to the mobile communication device, thereby establishing a second communication link between the mobile communication device and a second network”).<sup>4</sup> Pet. 39-48, 51-55.

The Petition provides a detailed discussion as to how Iizuka provides these limitations. For example, in showing Iizuka meets '154 [1.c], Samsung explains that “[t]he switching processing unit 212 in call-management server 200 establishes a voice call through the mobile telephone network 10 to IP telephone 21,” and that “[t]his voice call is established while the VoIP [] ‘still continues.’” Pet., 39-48 (citing Iizuka, [0160]-[0162], [0170]-[0175]). Samsung further explains that “[a]s part of this process of establishing a voice call, the method proceeds in stages. A second communication link (an RTP (Real-time Transport Protocol) connection for real-time audio streams) is established between the interface server and the end destination device as depicted in Iizuka’s Fig. 14.” Pet., 39-48 (citing Iizuka, [0175]). Regarding '154 [1.e], Samsung continues that after the steps explained in

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<sup>4</sup> Samsung also relies on Iizuka for similar limitations in claim 43. Pet., 60-62.

[1.c]:

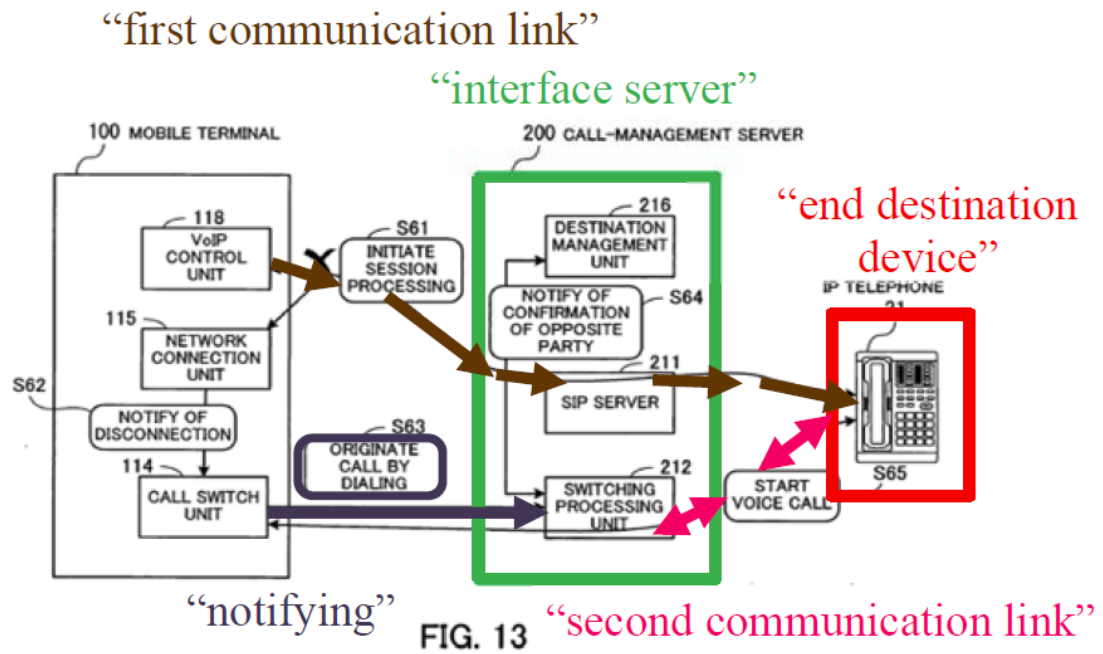
[A]fter the second communication link between call management server 200 and IP telephone 21 is established by making a voice call to IP telephone 21 over an RTP link (see [1.c]), switching processing unit 212 of the call-management server 200 returns a response to mobile terminal 100. Iizuka, [0176]; *see also* Iizuka, [0162]. This response “establishes a connection through the mobile telephone network 10” between call-management server 200 and mobile terminal 100. Iizuka, [0176]; *see also* Iizuka, [0162]. Thus, this response, labeled “PSTN Receive” in Fig. 14, establishes the second communication link between the call-management server 200 and mobile terminal 100. Iizuka, Fig. 14, [0176]; *see also* Iizuka, [0162]. As illustrated in Figure 2, the “PSTN receive” process passes through mobile telephone network 10, such that a wireless connection for this communication link is established between mobile terminal 100 and mobile telephone network 10. Thereafter, a voice call between IP telephone 21 and mobile terminal 100 through mobile telephone network 10[] becomes possible. Iizuka, [0176]; *see also* Iizuka, [0162].

Pet., 51-55.

PO ignores this extended discussion and claims that Iizuka's disclosure of establishing a second connection is substantially the same as the Belkin reference, which discloses rerouting. Paper 8, at 31-36. PO's only argument regarding Belkin is that 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.'" Paper 8, at 32-33 (emphasis in original) (citing Ex. 2017, at 83). According to PO, Iizuka's "second RTP Connection (at Step S82) is the rerouted first RTP Connection (from S76) after the mobile device's IP address was switched to the IP address for switching processing unit 212 of call-management server 200." *Id.* at 35.

But Iizuka is clear that it is not simply rerouting an initial RTP connection, rather it provides for two separate connections, specifically: "[t]he switching processing unit 212 realizes a voice call through the mobile telephone network 10 *while the VoIP call which has already been established still continues.*" Iizuka, [0162] (emphasis added). Because the second link is established while the first link "still continues," the second link is not merely obtained by rerouting the first link as in Belkin, but is instead a distinct second communication link. Indeed, Iizuka's Figure 13 reproduced below as annotated in the Petition shows two separate communication links:



Pet., 42.

This is distinct from Belkin's process relied on by the Examiner during the prosecution of U.S. Patent 8,886,181, which the Applicant argued relates only to “rerouting” a communication link instead of establishing a second communication link. In particular, Belkin provides that a “message requests that the peer unit 714 route it's voice bearer RTP to the RTP port associated with the handover call, e.g. WAN leg or UA4836, rather than the wireless communication unit 102.” Belkin, 13:45-14:2. The Examiner relied on this disclosure for “establishing a second communication link between the interface server and the end destination device.” Ex. 2017, 97-98. In response, the applicant argued that Belkin 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. Rerouting a connection is not the same as establishing a second connection.” *Id.* at 137 (emphasis original).

Thus, Iizuka's process of establishing a voice call over a communication link while a pre-established VoIP call *continues* such that a second link is established for communication is distinct from Belkin's process of rerouting a single RTP connection.

**B. Even If the Same or Substantially the Same Art or Arguments Were Before the Examiner, the Examiner Erred in Failing to Apply the Art and Arguments to the '154 Claims**

Finally, PO asserts there was no material error during prosecution, and erroneously equates the disclosures of Iizuka to Belkin (Paper 8, at 31-6, 39-40), but the Examiner of the '154 patent did not even address Belkin during prosecution. Thus, if Belkin is cumulative to the disclosures in Iizuka (it is not), then the Examiner erred in overlooking the disclosures in Belkin and allowing the Challenged Claims over them.

PO further argues that Enzmann (cited by Samsung for a portion of [1.c] in all grounds) is cumulative of Jagadeesan based on a comparison of a cited figure and corresponding description (Paper 8, at 36-39), but the Examiner never applied Jagadeesan in a rejection during prosecution, Applicant never argued that Jagadeesan failed to teach any portion of limitation [1.c], and likewise PO does not

dispute that Enzmann teaches the relevant portion of limitation [1.c]. Thus, PO concedes Examiner error.

Limitation [1.c] recites, in relevant part “when a second context is preferred over the context of the first communication link,” and the Petition provided analysis showing that Enzmann discloses monitoring a context of first communication link (“signal levels” associated with a “call session” that “is active”) and a second context for the second type of network (“cellular ... signal levels”). Pet., 46 (citing Enzmann, [0025]). The Petition further explained that Enzmann discloses monitoring “strength of the signal[s]” from both the 802.1x network and cellular network to decide if handover from the 802.1x network to the cellular network should occur because “the strength of the signal from the access point 7 [of the 802.1x network] has dropped below a certain threshold level” and “the strength of the signal from the cellular network is at or above a certain threshold level.” Pet., 46 (citing Enzmann, [0025], [0032]).

While PO asserts that Enzmann's teachings are cumulative of Jagadeesan (Pap. 8, at 36-39), the Examiner during the '154's prosecution never cited Jagadeesan, and Applicant never argued that Jagadeesan failed to teach any portion of limitation [1.c]. Indeed, PO does not dispute (Pap. 8, at 36-39; Pap. 9, at 14-23) that Enzmann teaches “when a second context is preferred over the context of the first communication link” in limitation [1.c]—the only limitation for which

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Enzmann is applied for claim 1 (Pet., 39-48). In its Patent Owner's Preliminary Response, PO argues only that Iizuka fails to teach a different portion of limitation [1.c]. Pap. 9, at 14-23. Thus, if Enzmann is cumulative to the disclosures in Jagadeesan, then the Examiner erred in overlooking the disclosures in the prior art and allowing the Challenged Claims.

\* \* \*

As demonstrated above, the Grounds raised by this Petition are not the same or substantially the same as the art or arguments raised during '154's prosecution. And even if they were, the Examiner erred by failing to apply them to and in allowing the '154's claims. Therefore, discretionary denial under §325(d) is not warranted.

#### **IV. CONCLUSION**

Samsung requests that the Director reject PO's request for discretionary denial.

Dated: June 27, 2025

Respectfully submitted,

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**ROPES & GRAY LLP**

*Lead Counsel for Petitioners*

**CERTIFICATE OF COMPLIANCE**

Pursuant to 37 C.F.R. § 42.24(a) and (d), the undersigned hereby certify that Petitioners' Opposition to Patent Owner's Request for Discretionary Denial complies with the type-volume limitation of 37 C.F.R. § 42.24(a)(i) because, exclusive of the exempted portions, it contains 5,554 words as counted by the word processing program used to prepare the paper.

Dated: June 27, 2025

Respectfully submitted,

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*Lead Counsel for Petitioners*

**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, that service was made on Patent Owner as detailed below and at [svdocketingus@hsfkramer.com](mailto:svdocketingus@hsfkramer.com):

*Date of service:* June 27, 2025

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*Documents served:* PETITIONERS' OPPOSITION TO PATENT  
OWNER'S REQUEST FOR DISCRETIONARY  
DENIAL  
EXHIBITS 1032-1041

*Persons served:* James Hannah  
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