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 IPR2025-00450
U.S. Patent No. 10,419,996

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

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## TABLE OF ABBREVIATIONS

| Abbreviation | DESCRIPTION |
|---|---|
| '996 | U.S. Patent No. 10,419,996 (Ex. 1001) |
| '996FH | File History of U.S. Application No. 15/921,275 (Ex. 1002) |
| IPR | *Inter Partes* 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 |
| Krantz | U.S. Patent Application Publication No. 2004/0153676 ("Krantz") (Ex. 2014) |
| Dorenbosch-498 | U.S. Patent Application Publication No. 2005/0239498 ("Dorenbosch-498") (Ex. 2001) |
| Belkin | U.S. Patent No. 7,398,088 ("Belkin") (Ex. 2015) |
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# I. INTRODUCTION

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 ***thirteen 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 IPR and the district court proceeding. And Samsung's petition has compelling merits, which PO does not dispute.

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. 1028. 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 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. 1029. 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. 1030. 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. 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, the parties do not exchange opening expert reports until June 16, 2025, 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 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. 1031, *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 thirteen other active cases are also scheduled for trial on that same date. Ex. 1032; *see Boe Tech. Grp. Co. v. Optronic 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.*, IPR2024-1222, Paper 12 at 6, 9 (P.T.A.B. Mar. 6, 2025) (postrescission) (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) (postrescission) (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 '996, and PO does not argue otherwise. Paper 7 at 11-16. 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. The parties do not exchange opening expert reports until June 16, 2025 and 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 completion of Markman briefing and fact discovery. *See Samsung*, IPR2024-1222, 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. 1029-1030. 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. 1027. 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.

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.

### 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 generically asserting that Samsung has not met its burden and incorporating PO's argument under §325(d). Paper 7, at 22. As described in detail below, however, the same or substantially the same art and arguments were not previously before the PTO. *See infra* §III.

* * *

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 '996'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: Dorenbosch in view of Donovan (claims 1, 12, 23, 25, and 34-35);

Ground 2: DeAnna in view of Ground 1 (claims 12, 23, and 34);

Ground 3: Iizuka in view of Donovan (claim 39);

Ground 4: Ground 3 in further view Preston (claim 39); and

Ground 5: Iizuka in view of Donovan and Pan (claim 41). Pet., 8.

None of these references were raised during the prosecution of the '996. Pet., 10-11. 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. First, PO argues that Donovan relied on by Samsung (for all Grounds) and Krantz both disclose a sleep to stand-by transition, but does not dispute (or even address) that Donovan discloses

this transition happens upon activation of a timer—the very claim limitation the Examiner determined is not disclosed by Krantz. Second, PO fails to draw a relevant comparison to Dorenbosch relied on by Samsung (Grounds 1 and 2) and Dorensbosch-498 initialed by Examiner in an IDS in the '996 prosecution and cited during prosecution of a separate patent. Finally, PO admits that the art considered during prosecution does not teach establishing a second communication link, for which Samsung relies on Iizuka's (Grounds 3-5) 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 '996 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 '996's Challenged Claims. Thus, for the reasons set forth in the Petition, the IPR should be instituted.

### A. Donovan Teaches a Sleep to Stand-by Transition Upon Activation of a Timer, Not After the Activation of a Timer Like Krantz (All Grounds)

PO incorrectly argues that Donovan is cumulative of Krantz because they both teach transition from a sleep mode to a stand-by mode. Paper 7 at 36-38. But as explained below, PO ignores (and does not dispute) Donovan's key disclosure of

transitioning from a sleep mode to a stand-by mode "upon activation of a timer," relied on in Samsung's Petition for all Grounds. Indeed, this is the very limitation the Examiner determined to be missing from the prior art during prosecution.

Samsung relies on Donovan across all Grounds for its disclosure of the claimed "upon activation of a timer [causing a] communication module to change state from a sleep mode to a stand-by mode" as required by all Challenged Claims. Pet., 28-32, 35, 38-39, 43-44, 77-78, 85. Specifically, Donovan discloses its communication device begins in "sleep mode" (or "low power mode") where "internal clocks are disabled and the PLLs, the XOSC and the voltage regulators are shut down," but "low power voltage regulator 98 provides power for the low power oscillator 84 and the counter." Donovan, [0052], [0056]-[0057], Fig. 4. Upon activating an oscillator XOSC (a timer), the communication module enters stand-by mode to "stabilize all circuitry." Donovan, [0044], [0053], [0057].

PO does not dispute that Donovan discloses transitioning from a sleep mode to a stand-by mode upon activation of a timer as required by the claims. Instead, PO ignores this key disclosure, and asserts that Donovan is cumulative to Krantz considered during prosecution simply because both teach a sleep mode to standby mode transition. Paper 7, at 36-38 (citing Krantz, [0009]-[0010], [0040]). PO fails, however, to acknowledge that the Examiner allowed the claims by noting that Krantz discloses "upon activat[ing] a timer from Doze mode (standby) to Off mode (sleep)"

(the opposite of what the claim requires), and "fails to teach 'upon activation of a timer, the switching system causes the second communication module to change state from a sleep mode to a stand-by mode.'" '996FH (Notice of Allowance) at 574.

Because the Challenged Claims require that the transition from sleep to standby mode happen ***upon*** activation of timer and not from standby mode to sleep mode, Donovan is not cumulative of Krantz.

### B. Dorenbosch and Dorenbosch-498's Disclosures are Critically Different for Purposes of the '996 Claims (Grounds 1-2)

PO incorrectly argues that Dorenbosch is cumulative of Dorenbosch-498 based on Dorenbosch-498's disclosure of checking a ***current*** network's characteristics when determining whether to switch to a new network. Paper 7, at 30-36. But as explained below, PO ignores key disclosures of Dorenbosch—not found in Dorenbosch-498—that involve checking the ***new*** network's characteristics when switching to the new network.

Samsung relies on Dorenbosch in Grounds 1 and 2 of the Petition for '996 claims 1, 12, 23, 25, 34-35. Pet., 8. Specifically, Samsung relies on Dorenbosch, in part, for claim limitation [1.b] ("wherein if a context changes for known networks or a new network is detected with a more favorable context, a previously established

communication automatically switches accordingly").[1] Pet., 24-26. To this end, Dorenbosch's handover procedure of Figure 8 discloses (i) detection of "WLAN signal degradation" (Dorenbosch, [0038], Fig. 8 (802)) and checking whether signal strength of the WAN signal is "good" (Dorenbosch [0038], Fig. 8 (806)) for the claimed "wherein if a context changes for known networks" and (ii) checking whether signal strength of the WAN signal is "still good" (Dorenbosch [0038], Fig. 8 (812)) for the claimed "a new network is detected with a more favorable context." Pet., 24-26.

PO incorrectly argues that the algorithms illustrated in Figure 8 of Dorenbosch relied on by Samsung, and Figure 9 of Dorenbosch-498 considered by the Examiner during the prosecution of a ***separate patent*** are "substantially similar," and that the disclosures of Dorenbosch-498 "lines up one-for-one" with the portions of Dorenbosch that Samsung relies on for '996 claim 1. Paper 7, at 30-36. While Dorenbosch and Dorenbosch-498 both disclose checking a ***current*** network's characteristics when determining when to switch to a new network, only Dorenbosch discloses checking the ***new*** network's characteristics as part of this process.

The handover procedure of Dorenbosch Figure 8 discloses that when a

[1] Samsung relies on Dorenbosch for similar limitations in claims 12, 23, 25, and 34-35. Pet., 32-34, 37, 41, 44-45.

subscriber unit is on a WLAN connection, the unit will check ***both*** if there is WLAN signal degradation (Dorenbosch, Fig. 8 (802)), and if WAN signal strength is "ok" (Dorenbosch, Fig. 8 (806)), and again whether signal strength of the WAN signal is "still good" (Dorenbosch, Fig. 8 (812)), and will switch to WAN only if these conditions are met. Dorenbosch, [0038], Fig. 8. Thus, this handover procedure evaluates both the claimed "context…for [a] known network[]" and whether "a new network [has] a more favorable context," and makes its handoff decision based on this determination, as claimed in the '996 patent. Pet., 24-26.

Dorenbosch-498, on the other hand, does not disclose using two contexts to make a handover decision. The embodiment of Dorenbosch-498 cited by PO describes a handoff method based on "expiration times," wherein for a multi-mode communication unit within a first network, an expiration time for the unit's contact with first network is shortened if marginal coverage or a border cell is detected in the first network. Dorenbosch-498, [0074]. This allows for quicker expiration of the unit's connection to the first network and therefore also allows for establishing quicker contact with a second network. Dorenbosch-498, [0074], Fig. 9. However, while this handover procedure allows for repeatedly checking the current network's coverage, it does not provide for checking the new network's coverage. Dorenbosch-498, [0074], Fig. 9. Thus, Dorenbosch-498 does not detect the new network's context or whether it is preferred, as Dorenbosch does and as is claimed

in the '996.

Samsung also relies on Dorenbosch's separate handover procedure of Figure 10 and related disclosures for '996 claim 34—a fact which PO completely ignores. Pet., 39-44.

These critical differences in processes show that Dorenbosch-498 is neither "substantially the same as" nor "cumulative" of Dorenbosch in the context of the '996 Challenged Claims.

### C. Iizuka's Teaching of Establishing a Second Communication Link is Not the Same as Belkin's Teaching of Rerouting (Ground 3-5)

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.[2] Paper 7, at 39-43. 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

[2] While PO also asserts that Iizuka is "cumulative to Belkin and Ibe" (Paper 7, at 39), PO only addresses Belkin, and makes no attempt to show any overlap between Iizuka's disclosure and Ibe's.

the '996 patent, the Examiner did not discuss the Belkin reference. Instead, Belkin was discussed during prosecution of the separate U.S. Patent 8,886,181 by a different Examiner.

Samsung relies on Iizuka, in part, as disclosing '996 [39.c] ("…establishing a second communication link between the interface server and the end destination device…") and [39.e] ("re-directing the second communication link from the interface server to another mobile communication device, thereby establishing a second wireless communication link between the mobile communication device and a second wireless network").[3] Pet. 66-70, 73-77.

The Petition provides a detailed discussion as to how Iizuka provides these limitations. For example, in showing Iizuka meets '996 [39.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., 66-70 (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

[3] Samsung also relies on Iizuka for similar limitations in claim 41. Pet., 83-88.

destination device as depicted in Iizuka's Fig. 14." Pet., 66-70 (citing Iizuka, [0175]). Regarding '996 [39.e], Samsung continues that after the steps explained in [39.c]:

> After 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 [39.c]), switching processing unit 212 of call-management server 200 returns a response to mobile terminal 100. [0176]; *see also* [0162]. This response "establishes a connection through the mobile telephone network 10" between call-management server 200 and mobile terminal 100. [0176]; *see also* [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. Fig. 14, [0176]; *see also* [0162]. As illustrated in Figure 2, the "PSTN receive" process passes through mobile telephone network 10, so a wireless connection for this communication link is established between mobile terminal 100 and mobile telephone network 10, enabling a voice call between IP telephone 21 and mobile terminal 100 through mobile telephone network 10[]. [0176]; *see also* [0162].

Pet., 73-77.

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 7, at 39-43. PO's only argument regarding Belkin

is that Applicant "argued persuasively to the Examiner during the '181 Patent examination, [that] '[r]erouting a connection is not the same as establishing a second connection,'" and therefore "Iizuka's rerouting of the initial RTP connection is not tantamount to establishing a second connection, as claimed." Paper 7, at 43 (citing Ex. 2017, at 36). 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:

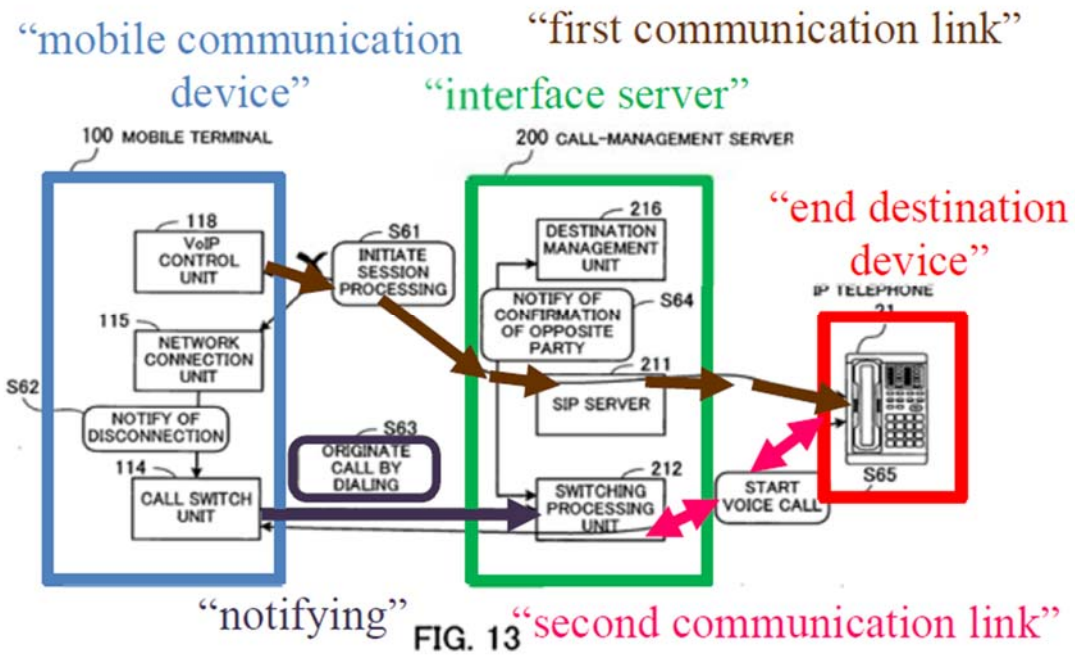

FIG. 13

Pet., 68.

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, 7. 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 36 (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.

### D. PO's Argument That Preston, Deanna and Pan Are Cumulative Is Irrelevant

As explained above, Donovan is included in all four Grounds of Samsung's petition, Dorenbosch is included in Grounds 1 and 2, and Iizuka is included in Grounds 3-5. Thus, for the reasons above, there are at least two independent reasons for each Ground as to why it is not cumulative of the art and arguments already considered during prosecution, and whether Preston, Deanna and Pan are cumulative of art already considered is irrelevant.

### E. 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 '996 Claims

Finally, PO asserts there was no material error during prosecution, and erroneously argues that Pan and Dorenbosch "have only slight differences with [Dorenbosch-498 and Pan-294] already expressly considered by the Office." Paper 7, at 45. Even if these references did have the same disclosures, Dorenbosch-

498 and Pan-294 were only ever initialed on an IDS in '996 prosecution, and were not the bases of rejections. An "examiner's initial on an IDS" does not equate "with meaningful evaluation and appreciation of the prior art." *Dr. Reddy's Laboratories S.A. v. Eye Therapies, LLC*, No. IPR2024-00467, Paper 14 at 19 (P.T.A.B. Aug. 13, 2024). Accordingly, the Examiner would have erred in overlooking the disclosures in Dorenbosch-498 and Pan-294 and allowing the Challenged Claims over them.

For example, PO identifies multiple disclosures from Dorenbosch-498 (Paper 7, at 30-36), but the Examiner did not rely on Dorenbosch-498 for any rejections during the prosecution of the '996—the Examiner only initialed it on an IDS. '996FH, 468 (Examiner initialing top reference and drawing arrow through remaining references including Dorenbosch-498). And while the Examiner relied on Dorenbosch-498 for its disclosure of "a transmission of broadband" during the prosecution ***of a separate patent***, it did not even rely on the disclosures cited by PO. *See* Ex. 2019, 8, 10, 13 (citing Dorenbosch-498, [0029]).

PO also argues that Pan relied on by Samsung is cumulative of Pan-294 that was "considered" by the Examiner during the '996 prosecution (Paper 7, at 38-39), but as PO notes, Pan-294 was merely included on an IDS and initialed by the Examiner. '996FH, 467 (Examiner initialing top reference and drawing arrow through remaining references including Pan-294). Pan-294 was not used as the basis for a rejection during the '996 prosecution. Thus, even if disclosures of Pan and

Pan-294 were cumulative, the Examiner erred in failing to meaningfully consider the disclosures of Pan-294 that PO cites. Paper 7, at 38-39 (citing [0028], [0030], [0038]-[0040], and [0053]).

PO further asserts that Donovan is cumulative of Krantz (Paper 7, at 36-38), but the Examiner failed to recognize any teaching of a communication module transitioning from a sleep mode to a stand-by mode upon activation of a timer within Krantz. To the extent Krantz is cumulative of the disclosures in Donovan (it is not), then the Examiner erred in overlooking the disclosures in Krantz and allowing the Challenged Claims over those disclosures.

And PO equates the disclosures of Iizuka to Belkin (Paper 7, at 39-43), but the Examiner of the '996 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.

* * *

As demonstrated above, the Grounds raised by this Petition are not the same or substantially the same as the art or arguments raised during '996's prosecution. And even if they were, the Examiner erred by failing to apply them to and in allowing the '996'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 10, 2025

Respectfully submitted,

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## 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 5,618 words as counted by the word processing program used to prepare the paper.

Dated: June 10, 2025

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## CERTIFICATE OF SERVICE

I hereby certify that on June 10, 2025, I caused a true and correct copy of Petitioners' Opposition to Patent Owner's Request for Discretionary Denial and supporting exhibits to be served via electronic mail to Patent Owner's counsel listed below and at svdocketingus@hsfkramer.com:

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