

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

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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35 U.S.C. § 325(d) *passim*

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PATENT OWNER’S EXHIBIT LIST

Exhibit	Description
2001	U.S. Patent Application Publication No. 2005/0239498 (“Dorenbosch-498”)
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	Spreadsheet regarding Magistrate Judge Payne’s average time to issue a <i>Markman</i> Order after a <i>Markman</i> hearing, from July 1, 2023, to present, exported from Docket Navigator, https://brochure.docketnavigator.com/
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)

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Exhibit	Description
2012	U.S. Patent Application Publication No. 2004/0030791 (“Dorenbosch-791”)
2013	U.S. Patent Application Publication No. 2005/0059400 (“Jagadeesan”)
2014	U.S. Patent Application Publication No. 2004/0153676 (“Krantz”)
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
2018	U.S. Patent 10,368,281
2019	Excerpts of File History for U.S. Patent 10,368,281
2020	U.S. Patent Application Publication No. 2004/0192294 (“Pan-294”)
2021	U.S. Patent Application Publication No. 2004/0203788 (“Fors”)

I. INTRODUCTION

Patent Owner, Vasu Holdings, LLC, (“Vasu”), respectfully requests that the Acting Director exercise her discretion to deny this Petition challenging claims 1, 12, 23, 25, 34, 35, 39, and 41 (“the Challenged Claims”) of U.S. Patent No. 10,419,996 (Ex. 1001, “the ’996 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 ten months before the projected statutory final written decision deadline. Because Petitioners decided to wait to submit the Petition on the last day of the statutory window, 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 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 in this case, the District Court—which has already dedicated resources to this case—will have conducted its *Markman* hearing (scheduled for tomorrow, May 13, 2025) and issued a claim construction order (expected by June 23, 2025). Under these circumstances, the District Court is highly unlikely to consider a renewed¹ 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. The main reference in every ground of the Petition, Dorenbosch (Ex. 1004), is substantially the same as a patent publication to

¹ Samsung's initial Motion to Stay was denied as premature on May 9, 2025.

Dorenbosch² that was also cited and traversed during examination of another Vasu patent related to the '996 Patent. Another reference, Pan, is virtually identical to another patent publication to Pan that was already disclosed to the Office in an IDS. The remainder of Petitioners' references are cumulative to, or substantially the same as, other references the Examiner previously considered and/or used in rejections during examination of the '996 Patent or other patents in its family. Despite citing essentially the same art and arguments, Petitioners identify no error in the Examiner's determination that the prior art did not teach or suggest, for example, "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."

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 '996 Patent is patentable on the merits in its Patent Owner Preliminary Response due June 10, 2025.

² U.S. Patent Publication No. 2005/0239498 to Dorenbosch ("Dorenbosch-498", Ex. 2001).

II. PETITIONERS' GROUNDS FOR CHALLENGE

The Petition presents the following prior art combinations as its respective grounds for invalidating claims of the '996 Patent:

Ground	Claims	Basis	References Relied Upon
1	1, 12, 23, 25, 34-35	§103	Dorenbosch and Donovan
2	12, 23, 34	§103	DeAnna, Dorenbosch, and Donovan
3	39	§103	Iizuka and Donovan
4	39	§103	Iizuka, Donovan, and Preston
5	41	§103	Iizuka, Donovan, and Pan

Pet. at 8.

III. THE BOARD SHOULD DENY INSTITUTION UNDER *FINTIV*

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 ten 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 24, 2025, the very last day of the 12-month statutory deadline under 35 U.S.C. § 315(b), further weighs in favor of denying the Petition. Hannah Decl., ¶4. Indeed, the Petitioners' delay is largely why the District Court's trial will commence ten months prior to the Board's projected statutory final written decision deadline of September 10, 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., ¶13; *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) ("it is 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 *Markman* Hearing and Order are expected, expert report briefing

will have been completed, and dispositive briefings and *Daubert* motions will have been completed. Hannah Decl., ¶17.

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, or is at the very least neutral, in this case, because 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 stay any renewed motion to stay the case with only two months away from trial. *Id.*, ¶13.

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., Inc.* 2015 WL 1069179, at *6 ("it is 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 September, 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.

Indeed, Judge Gilstrap consistently denies requests to stay the 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 is filed 10 months or later 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. Moreover, a stay "would [have] do[ne] nothing more than draw out the time to trial." Ex. 2008, No. 2:21-cv-00446-JRG, Dkt. No. 108, slip op. at *5 (E.D. Tex. Jan. 20, 2023); *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 Group 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 very last day of the 12-month statutory deadline. Hannah Decl., ¶4. As a result, Petitioners' delayed IPR filings will cause jury selection to occur approximately ten months before the Board's statutory final written decision deadline, significantly longer than the than two months in *Cal. Inst. of Tech.* and the eight months in *Resonant Systems, 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 case is in an advanced stage, as the “parties [have] engaged in extensive discovery.” *See infra* (Factor 3); Ex. 2008, *Cal. Inst. of Tech.*, slip op. at 5 (the stage of litigation disfavored a stay because, in addition to 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 the 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 65,600 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. Six depositions are scheduled to take place in South Korea beginning May 20, and Vasu’s 30(b)(6) depositions are scheduled to take place starting May 29. Hannah Decl. ¶¶10-12.

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.

Furthermore, 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 the request for a stay.

B. *Fintiv* Factor 2: The District Court's Scheduled Trial Date is Approximately Ten 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 10 months³ before the September 10, 2026, deadline to issue a final written decision in this case. Hannah Decl. ¶5; *see, e.g., 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 Board's final written decision expected six months after trial according to scheduling order 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 Board's final written decision expected six months after trial according to scheduling trial date or six months after according to time-to-trial statistics for court); *Toyota Motor Corp. v. Emerging Automotive LLC*, No.

³ Petitioners improperly focus their *Factor 2* analysis on the projected institution decision date rather than the projected final written decision deadline. Pet. at 12; *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).

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 scheduled approximately eight months before 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 *on the day of* the statutory deadline.

Before the Board's expected September 10, 2025, institution decision, the parties will have already expended significant investment conducting discovery in the District Court litigation. Hannah Decl., ¶¶10-12. The parties have already served and supplemented their respective infringement and invalidity contentions multiple times. *Id.*, ¶6. The fact discovery is nearly upon the parties, set to close on June 2, 2025. *Id.*, ¶12. 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.*, ¶10. Initial disclosures were served, identifying relevant witnesses who are scheduled to be deposed. *Id.* Petitioners have produced over 65,600 documents and made over 3.96 GB of source code available for inspection, in which Vasu's outside counsel have already devoted 10 days to review. *Id.*, ¶12. Vasu's expert is expected to review the source code beginning on May 28. *Id.* The parties have collectively served 19 Rule 30(b)(1) and 30(b)(6) deposition notices, and 7 subpoenas. *Id.*, ¶11. In fact, Petitioners served 87 topics for deposition on Vasu as recently as April 17, 2025, which is scheduled to take place on May 29, 2025 and June 2, 2025. *Id.* Thus, Petitioners have demonstrated their efforts to complete discovery before the June 2, 2025 fact discovery cutoff. *Id.*, ¶¶10-12. On April 22, 2025, Vasu filed a Motion to Compel Documents and Discovery Responses. *Id.*, ¶14.

To date, the District Court will also have devoted a significant amount of resources toward resolving the dispute. The parties have completed claim construction briefing, and the *Markman* hearing is scheduled to occur on May 13, 2025. *Id.*, ¶15. Magistrate Judge Payne—who will preside over the *Markman* Hearing—issues *Markman* Orders on average approximately 40 days after conducting the *Markman* Hearings. Ex. 2004; Hannah Decl., ¶15 (calculated based upon Magistrate Judge Payne's *Markman* Orders issued from July 1, 2023 to present). Accordingly, the parties can expect the Judge's *Markman* Order around June 23, 2025, roughly two months before the Board's institution decision deadline. Hannah Decl., ¶15.

Judge Gilstrap also appointed a technical advisor for the case. *Id.*, ¶16. 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.*, ¶17. 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 there has been substantial preparation for a *Markman* hearing (including completed briefing), and the hearing occurs prior to the Board's expected institution decision. *See Samsung Elecs. Co. v. Mojo Mobility Inc.*, No. IPR2023-01094, Paper 11 at 9 (P.T.A.B. Feb. 9, 2024); *see also 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 fact and expert discovery and claim construction briefings and hearings completed before institution deadline); *SharkNinja Operating LLC v. iRobot Corp.*, No. IPR2021-00544, Paper 7 at 9-10 (P.T.A.B. June. 25, 2021) (Factor 3 weighed in favor of denial where invalidity and infringement charts served, *Markman* hearing scheduled and *Markman* order expected before Board's institution deadline, and expert reports due before Board's institution deadline).

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, 10-12.

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*, Paper 13 at 9-10 (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 (Pet. at 12), cannot save Petitioners from their delays. Indeed, they cite to no prior decisions of the Board where such an unexplained delay was

⁴ Petitioners likewise postponed filing IPR2025-00446, -00447, -00448, and 00449, which correspond to Patent Owners’ other asserted patents in this case. Petitioners filed IPR2025-00448, and -00449 on the final day of the statutory deadline, and IPR2025-00446, and -00447 the day before the statutory deadline.

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 Patent Owner’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’ statement⁵ may lessen the chance of inconsistent decisions between the PTAB and

⁵ Petitioners have proposed a statement to 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.

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 Petitioners file a Request for Rehearing or Director Review).

The same claims challenged in the Petition (Claims 1, 12, 23, 25, 34-35, 39, and 41) are at issue in the District Court litigation (Claims 1, 12, 23, 25, 34-35, 39, and 41). Hannah Decl., ¶¶2, 3; *see 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).

There is also a “substantial overlap of issues concerning the prior art,” given that Petitioners have selected to pursue before the District Court three of the six references asserted here, namely, Iizuka, Pan, and Donovan. 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 DeAnna to address the "server/server device" limitations of Claims 12, 23, and 34 does not "meaningfully differentiate the arguments presented in the Petition from the arguments made in the [D]istrict [C]ourt" either. Hannah Decl., ¶8; *Edwards Lifesciences Corp. v. Evalve, Inc.*, No. IPR2019-01479, Paper 7 at 11 (P.T.A.B. Feb. 26, 2020); see *Supercell Oy*, Paper 9 at 11-13 (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). While DeAnna has not been presented in the District Court litigation for the '996 Patent, Petitioners already point to 25 references for claim 12[c], 23 references for claim 12[d], 25 references for claim 23[c], 23 references for claim 23[d], and at least 23 references for claim 34[preamble]—and "do[] not explain how [their] arguments based on [DeAnna] address any potential weaknesses in [these other] 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).

Likewise, Petitioners rely on Preston for a single claim limitation (39[d]), despite citing 23 other references in their invalidity contentions, and do not explain how Preston addresses any potential weaknesses in these other references. Hannah Decl., ¶8.

Petitioners also rely on Dorenbosch for Claims 1, 12, 23, 25, and 34 to 35 despite citing various other references in their invalidity contentions—at least 24 for 1[preamble], 24 for 1[a], 20 for 1[b], 23 for 1[c], at least 13 for 12[preamble], 13 for 12[a], 13 for 12[b], 25 for 12[c], 23 for 12[d], at least 13 for 25[[preamble]-b], 24 for 25[c], at least 24 for 34[preamble], 24 for 34[a], 24 for 34[b], 23 for 34[c], at least 24 for 35[preamble], 24 for 35[a], 24 for 35[b], and 23 for 35[c]—and do not explain how Dorenbosch addresses any potential weaknesses in these other references. Hannah Decl., ¶9.

Notably, the Dorenbosch reference cited in the Petition is cumulative of the Dorenbosch '498 reference from Petitioners' invalidity contentions. Hannah Decl., ¶¶7, 9; *infra* § V.A.1. As described in further detail below, both references share the same primary inventor, Jheroen P. Dorenbosch, and have substantially the same disclosures. *See infra* § V.A.1.

Petitioners' sole argument in their Petition that the District Court litigation “involves multiple grounds of invalidity not addressed here, enabling the court to focus its trial time on different invalidity defenses” is also unavailing, given the Board's past rejection of such arguments. Pet. at 11; *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 its institution decision on September 10, 2025, expert reports and summary judgment motions in District Court addressing the same prior art asserted here will have already been completed. Hannah Decl. ¶¶7, 17; *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 avoid the duplication of efforts or the risk of inconsistent decisions.

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: Petitioner is the Defendant 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 Lacks 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 Petitioner's 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, 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 incorporated Section 325(d) arguments section. *See* § V, *infra*.

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 '996 Patent is obvious over the art asserted in the Petition, including Dorenbosch, Donovan, DeAnna, Iizuka, Preston, and Pan. *See* § V.A-B, *infra*; Pet. at 11.

Based on a holistic weighing of the *Fintiv* Factors 1 through 6, Vasu respectfully requests that the Director deny institution:

<i>Fintiv</i> Factor	Discretionary Denial Weight
1	Weighs in favor of denial or is neutral.
2	Weighs strongly in favor of denial.
3	Weighs strongly in favor of denial.
4	Weighs in favor of denial.
5	Weighs in favor of denial.
6	Weighs in favor of denial (if consideration of this factor is necessary).

IV. BRIEF OVERVIEW OF THE '996 PATENT

A. The '996 Patent (Ex. 1001)

The '996 Patent is directed to a mobile communication device configured to automatically switch a communication that is already in progress using a cellular network to a wireless Voice over IP (VoIP) network, or vice versa. '996 Patent at 2:42-59. This invention addressed the cumbersome problem of having to “manually change the device’s setting by, e.g., pressing one [or] more keys” or the reliability issue stemming from “switching of the call from cellular to VoIP or vice versa [that] may result in the loss of the call.” *Id.* at 2:21-24, 2:35-38.

The '996 Patent discloses a mobile communication device having a timer. If the mobile device is conducting a call with its cellular communication module and its Wi-Fi antenna system detects a Wi-Fi system having a predefined threshold level

(strength), that timer is activated. *Id.* at 2:60-3:6. At the expiration of the timer, the mobile communication device's switching system causes the Wi-Fi system to change state from a sleep mode to a stand-by mode. *Id.* at 3:7-18. Subsequently, and before the cellular call is switched from the mobile device's cellular module to its Wi-Fi communication module, the switching system causes the Wi-Fi system to change state from the stand-by mode to an active mode. *Id.*; *see also id.* at 6:51-64.

B. Prosecution History of the '996 Patent

The '996 Patent issued from U.S. Patent Application No. 15/921,275, filed on March 14, 2018. Ex. 1002 at 374 (Filing Receipt). There are two related patents of note in this case: U.S. Patent No. 10,368,281 ("the '281 Patent," Ex. 2018) and U.S. Patent No. 8,886,181 ("the '181 Patent").

The '996 Patent is a continuation-in-part of U.S. Patent Application No. 15/480,293, which was filed on April 5, 2017, and issued as the '281 Patent. Ex. 1002 at 374; '281 Patent (Ex. 2018) at Cover. The '281 Patent is a continuation application in a chain of continuation applications starting from U.S. Patent Application No. 11/031,498 ("the '498 Application"), filed on January 6, 2005, which claims priority to U.S. Provisional Application No. 60/534,466 filed January 6, 2004. Ex. 1002 at 374. The '996 Patent is also related to U.S. Patent Application No. 13/240,776, which issued as the '181 Patent, and which is a divisional

application of U.S. Patent Application No. 11/330,675, filed on January 11, 2006, and is a continuation-in-part of the '498 Application.

The '996 Patent was subject to a substantive examination by the Office. In a November 6, 2018 Office Action and February 26, 2019, Final Office Action, the Examiner rejected the claims using combinations of U.S. Patent Publication No. 2005/0059400 to Jagadeesan ("Jagadeesan," Ex. 2013), U.S. Publication No. 2004/0153676 to Krantz ("Krantz," Ex. 2014), and U.S. Patent Publication No. 2004/0203788 to Fors ("Fors," Ex. 2021). Ex. 1002 at 426-40 (Non-Final Office Action dated 11/6/18); *see also id.* at 516-29 (Final Office Action dated 2/26/19).

In response, Applicant distinguished the '996 Claims over the Examiner's rejections by amending the claims to recite the "upon activation of a timer" limitation and argued the prior art did not teach or suggest such elements. *Id.* at 494-501 (amending claims 1 and 36 to recite "wherein 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, and the switching system causes the second communication module to change state from the stand-by mode to an active mode before a communication is switched to the second communication module" and amending claims 13, 24, 26, 35, 41, 43 with similar variants). In its April 25, 2019 Response to Final Office Action, Applicant argued persuasively that:

Within the Response to Argument section of the Office Action, it has been argued that Krantz teaches to process the network interface module from sleep mode to idle mode upon activate a timer listening to beacon intervals in paragraph 10 and the communication module changes from stand-by mode to active mode in paragraph 23

Although Krantz teaches “[i]t is desirable to reduce the amount of time the network interface module is in a high-power state when not sending traffic or scanning,” [Krantz, ¶ 23], Krantz does not specifically teach the interface causes the communication module to change state from the stand-by mode to an active mode before a communication is switched to the communication module. Additionally, although Krantz teaches a sleep time and a power state, Krantz does not teach wherein upon activation of a timer, the interface causes a communication module to change state from a sleep mode to a stand-by mode.

Ex. 1002 at 560; *see generally id.* at 559-68 (Response to Final Office Action dated 4/25/2019).

Examiner was persuaded by these arguments, allowed all claims, and provided that the claims were allowable because:

Regarding claim 1, 13, 24, 26, 35-37, 41 and 43, Krantz et al. discloses a network interface upon active a timer from Doze mode (standby) to Off mode (sleep), fig.6 elements 602, 620, 622. However, Krantz et al. 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”, in linking with other subject matters in the claims.

Ex. 1002 at 574 (Notice of Allowance dated 5/10/2019). The '996 Patent issued on September 17, 2019.

C. Prosecution History of the Related '281 Patent

Also pertinent to the issue of discretionary denial, the related '281 Patent was also subject to a comprehensive and substantive examination by the Office. Notably, the same Examiner (Tu X. Nguyen) that examined the '996 Patent also examined the '281 Patent, and was aware of at least all references used during the '281 Patent examination. *See* '996 Patent at 1 (listing "Primary Examiner – Tu X Nguyen"); Ex. 2018 ('281 Patent) at 1 (same).

The '281 Patent was subject to a comprehensive and substantive examination by the Office. In a January 16, 2018, Office Action (and in an April 4, 2018, Final Office Action), the Examiner rejected the claims using combinations of U.S. Patent Publication No. 2004/0030791 to Dorenbosch ("Dorenbosch-791", Ex. 2012), Jagadeesan (Ex. 2013) (the same Jagadeesan cited during the '996 Patent examination), U.S. Patent Publication No. 2005/0239498 to Dorenbosch ("Dorenbosch-498", Ex. 2001), and other references. Ex. 2019 ('281 Patent file history) at 5-14 (Non-Final Office Action dated 1/16/18); *see also id.* at 20-26 (Final Office Action dated 4/4/2018).

In response, Applicant distinguished the '281 Patent's claims over the Examiner's rejections by various claim amendments and arguments. *Id.* at 30-38.

Examiner agreed with Applicant's arguments and indicated the claim amendments overcame the combination of references including Dorenbosch-791, Dorenbosch-498, and Chaskar. In a September 12, 2018, Office Action (and a January 9, 2019, Final Office Action), the Examiner rejected the claims using a new combination of Jagadeesan and Krantz (Ex. 2014, the same Krantz reference cited during the '996 Patent's examination). Ex. 2019 ('281 Patent file history) at 49-56 (office action dated 9/12/2018); *id.* at 76-80 (final office action dated 1/9/2019). In response, Applicant amended the claims to incorporate allowable subject matter from then-pending claim 21. *Id.* at 69-72 (Second response to OA dated 12/12/2018); *id.* at 93-96 (Second response to final OA dated 3/8/2019). The Examiner allowed all pending claims in view of amended "timer" limitations found in each claim. *Id.* at 102 (Notice of Allowance dated 3/15/2019, reciting claim limitations in reasons for allowance).

V. THE BOARD SHOULD 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 is shown.” *Id.* at 9.

The Director should, therefore, deny institution because Petitioners' challenge relies on substantially the same or substantially the same art previously considered by the Office during prosecution of the '996 Patent, and Petitioners have not demonstrated any material error. *Id.* at 10-11.

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

1. Dorenbosch Is Cumulative to Another References By the Same Inventor That Was Previously Used by the Examiner During Examination of a Parent Patent Application

Dorenbosch is substantially the same as another Dorenbosch reference (Dorenbosch-498, Ex. 2001) used by the Examiner to reject the claims during examination of the related '281 Patent. Dorenbosch-498 shares the same lead inventor, Jheroen Dorenbosch, as the Petitioner-asserted Dorenbosch reference.⁶ Dorenbosch-498 was presented to the Office in an Invention Disclosure Statement filed during prosecution of the '996 Patent. Ex. 1002 at 55 (IDS filed 3/30/18), 468 (Examiner initials marking as "considered"). The Examiner also relied upon

⁶ In their Petition, Petitioners fail to mention Dorenbosch-498 or yet another Dorenbosch reference, U.S. Patent Publication No. 2004/0030791 to Dorenbosch ("Dorenbosch-791", Ex. 2012) that was previously presented to the Office. Both Dorenbosch-498 and Dorenbosch-791 were both disclosed to the Office in Invention Disclosure Statement during examination of the '996 Patent and used to reject claims during examination of the '281 Patent. *See* Ex. 1002 at 51, 55, 58 (IDS filed 3/30/18); *see also* Ex. 2019 at 5-14 (Office Action dated 1/16/18); *id.* at 20-26 (Final Office Action dated 4/4/2018).

Dorenbosch-498 to reject the claims of the '281 Patent during its examination. Ex. 2019 at 8, 10, 13 (Non-Final Office Action dated 1/16/18).

The portions of Dorenbosch relied upon by Petitioners are substantially the same as or cumulative to the disclosures found in Dorenbosch-498. For example, Petitioners cite Figure 8 of Dorenbosch for its detection of "Border Cell or Signal Degradation" (step 802) for meeting limitation [1.b] of the '996 Patent.

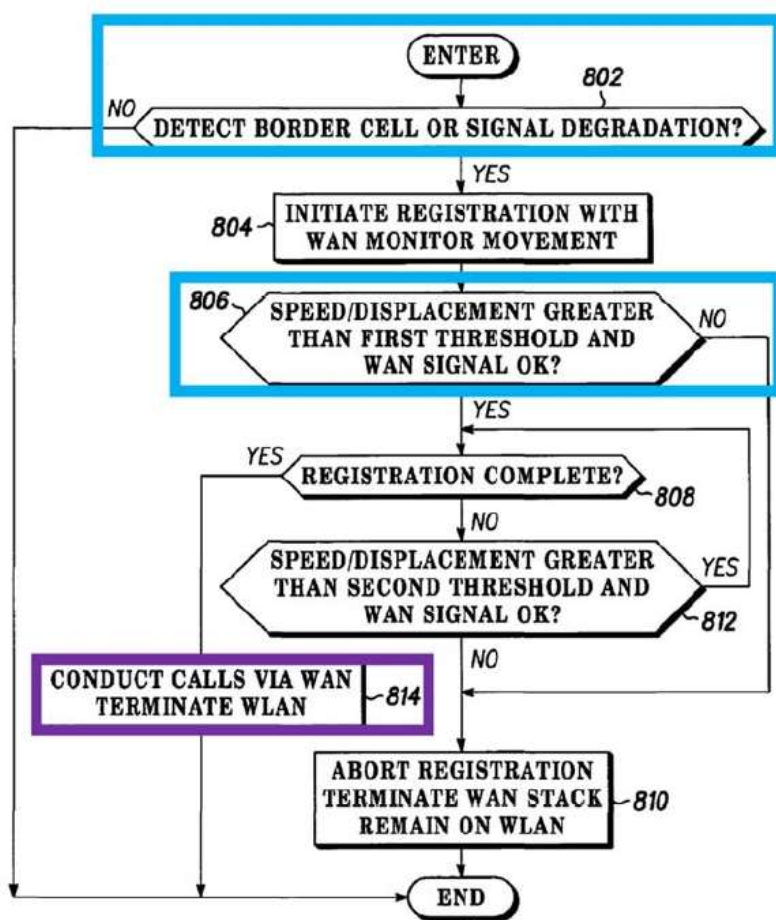


FIG. 8 800

Pet. at 15-16, 26 (citing Fig. 8 of Dorenbosch). A substantially similar disclosure is found in Dorenbosch-498:

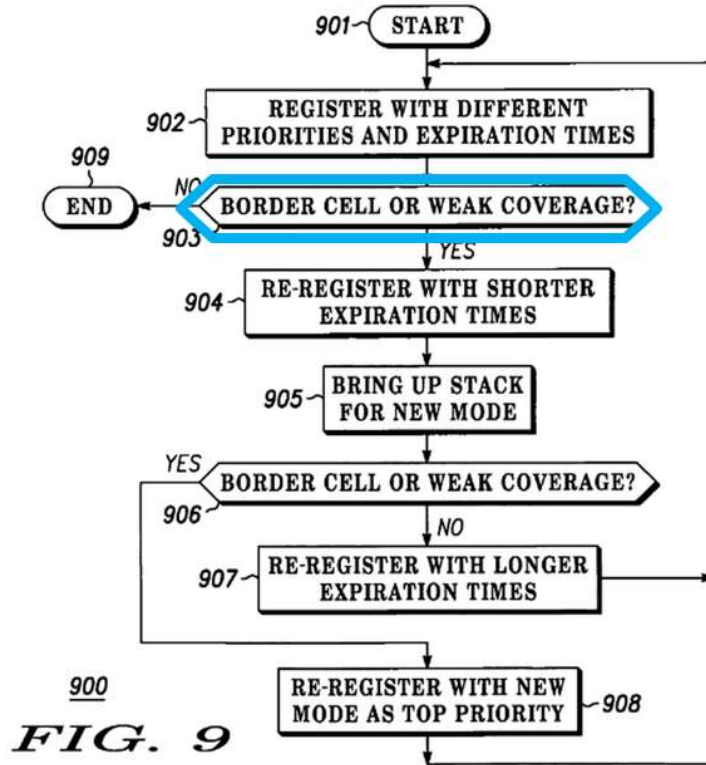


Fig. 9 of Dorenbosch-498 (Ex. 2001) (annotations added). In the chart below, the previously-considered disclosure of Dorenbosch-498 lines up one-for-one with the portions of Dorenbosch cited in the Petition.

Claim Limitation	Examiner-Cited Prior Art	IPR-Asserted Reference
[1.pre] A device comprising:	Dorenbosch-498 ⁷ (Ex. 2001) [0016]: “the term . . . multi-mode communication unit may be used interchangeably . . . with <i>subscriber unit</i> .”	Dorenbosch [0026]: “A block diagram of an exemplary <i>mobile subscriber device (SU) 306</i> is shown in FIG. 4” Pet. at 22 (emphasis as quoted in Petition).

⁷ Emphasis added to the quoted material in this column, unless otherwise noted.

	[0059]: “Referring to FIG. 5, a simplified block diagram of <i>multi-mode communication unit 102</i>”	
[1.a] a switching system to switch operation between a first communication module and a second communication module,	<p>Dorenbosch-498</p> <p>[0060]: “Transceiver 503 will . . . be configurable to support . . . multiple communication networks . . . further include one or more of a <i>WLAN transceiver 509 and WAN transceiver 511</i>”</p> <p>[0063]: “<i>Controller 505 also includes memory 515</i> . . . is used to store . . . software . . . for execution or use by the <i>processor 513</i>.”</p> <p>[0064]: “. . . <i>memory 515</i> further includes . . . a <i>signal quality assessment routine 519</i> for use in determining whether a handover or a mode switch may be required”</p>	<p>Dorenbosch,</p> <p>[0021]: “FIGS. 7, 8, 9, 10 and 11 . . . illustrating portions of a <i>handover process between a WLAN and a WAN</i>”</p> <p>[0026]: “. . . The SU 306 contains <i>two sets of transceivers—one for the WLAN system and one for the WAN system</i>”</p> <p>[0027]: “The mobile subscriber unit . . . includes <i>one or more processors 418</i> . . . <i>main memory 414</i>” . . . and . . . “<i>handover manager</i>”</p> <p>Pet. at 22-24.</p>
[1.b] wherein if a context changes for known networks or a new network is detected with a	Dorenbosch-498: Fig. 8; Fig. 9 (see Step 903 stating “Border Cell or Weak Coverage?”)	Dorenbosch Fig. 8; and [0038]: “If . . . <i>WLAN signal degradation is detected, then the unit 306 initiates</i>

<p>more favorable context, a previously established communication automatically switches accordingly</p>	<p>[0038]: “Referring to FIG. 3, multi-mode communication unit 102 is shown after a successful re-registration as described above, and after a mode switch to the second wireless communication network 108.”</p> <p>[0073]: Also, after the new stack is brought up at 805, registration, for example, at 802, can be made with the new network if a mode switch occurs</p> <p>[0074]: “If, for example, multi-mode communication unit 102 is operating in first network 106, and marginal coverage or a border cell is detected at 903”</p>	<p><i>the registration sequence with the WAN system and begins to monitor the movement of the device [I]f . . . the signal strength of the WAN signal is still good, . . . the unit will conduct any present . . . and subsequent calls via the WAN</i></p> <p>Pet. at 25-26.</p>
<p>[1.c] wherein 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, and</p>	<p>Dorenbosch-498</p> <p>[0003]: “. . . to bring up software and hardware necessary to operate within and register with the new system, Conversely, maintaining registration and communication with multiple systems at all times can seriously reduce battery life for the multi-</p>	<p>Dorenbosch</p> <p>[0038]: “[T]he process of initiating the registration sequence . . . includes the steps necessary to bring up the corresponding hardware and software for that system.”</p> <p>[0041]: “This presents further benefits to the phone battery life . . . in that <i>the unit 306 does not even start</i></p>

	<p><i>mode communication unit</i>”</p> <p>[0045]: “Multi-mode communication unit 102 quickly detects the disappearance of signal 105 associated with the WLAN, . . . , and <i>makes preparations such as bringing up its cellular stack, which may refer to the protocol stack associated with operation in second network 108 . . .</i>”</p> <p>[0074] “Also in preparation for losing contact with network 106, <i>the protocol stack for operation in second network 108 may be brought up</i> at 905 . . .”</p>	<p><i>the WAN stack 510 and hardware 410, 412, or burden the WAN system unnecessarily until sufficient movement has been detected.</i>”</p> <p>[0045]: “If all the conditions are met (i.e. sufficient signal strength, necessary movement conditions within border cell coverage) then <i>the unit 306 will terminate running the WAN stack 508 and hardware 410, 412</i>”</p> <p>Pet. at 27.</p>
<p>[1.d] the switching system causes the second communication module to change state from the stand-by mode to an active mode before a communication is switched to the second communication module.</p>	<p>Dorenbosch-498 Fig. 8-9</p> <p>[0073]: “Also, after the new stack is brought up at 805, <i>registration</i>, for example, at 802, <i>can be made with the new network if a mode switch occurs</i>,”</p>	<p>Dorenbosch Fig. 8; and</p> <p>[0038]: “When . . . registration . . . is completed, <i>the unit will conduct any present call . . . via the WAN system</i>”</p> <p>Pet. at 32.</p>

Based on this comparison, Dorenbosch satisfies the first prong of *Advanced Bionics* as being substantially the same as or cumulative to a reference (Dorenbosch-498) previously presented to the Office.

2. Donovan Is Cumulative to Krantz That Was Previously Used by the Examiner During Examination of the '996 Patent

Donovan (Ex. 1005) is substantially the same as Krantz, which was used by the Examiner to reject the claims during examination of the '996 Patent. Krantz was presented to the Office in an Invention Disclosure Statement filed during prosecution of the '996 Patent. Ex. 1002 at 481 (IDS filed 12/12/18), 534 (Examiner initials marking as “considered”). The Examiner also relied upon Krantz to reject the claims of the '996 Patent. *Id.* at 426-40 (Office Action dated 11/6/18), 516-29 (Final office Action dated 2/26/2019).

Petitioners cite Donovan for disclosing a “sleep-to-wakeup mode transition”, but the cited portions of Donovan are substantially the same as or cumulative to the disclosures found in Krantz. Pet. at 28-32. Donovan’s disclosures about the “sleep mode” and a “wakeup” period are cumulative to Krantz’s “sleep mode,” “scanning mode,” and “active mode,” which the Examiner cited in his Office Actions. Ex. 1002 at 520 (2/26/19 Final Office Action reasoning that “it would have been obvious . . . to modify the system of Jagadeesan et al. with the above teaching of Krantz in order to provide separate communication modules having different saving

power settings for different state of communication (etc, sleep mode, scanning mode and active mode).”). These similar disclosures are summarized in the below table comparing portions from Donovan cited and excerpted in the Petition with portions in Krantz.

Claim Limitation	Examiner-Cited Prior Art	IPR-Asserted Reference
<p>[1.c] wherein 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, and</p>	<p>Krantz (Ex. 2014)</p> <p>[0009]: “determining when <i>the network interface module can enter a doze state</i> includes determining that a <i>delayed sleep timer has expired</i>”</p> <p>[0010]: “In a maximum power save mode, the power management module puts the network interface module <i>into a doze state for multiple beacon intervals (i.e., a listening interval)</i>. . . . Prior to the listening interval ending, the network interface module <i>is set to an on state to receive a beacon</i>”</p> <p>[0040]: “The power management module 202 operates the network interface module 201 <i>in the constant awake mode</i> if the device 100 is scanning (step</p>	<p>Donovan</p> <p>[0052]: “<i>The low power voltage regulator 98 provides power for the low power oscillator 84 and the counter during the low power mode.</i> The low power voltage regulator 98 also <i>supplies power to registers and memories in the SOC circuit 50 so that the state of the SOC circuits 50 is retained, which is important for fast wake up time.</i>”</p> <p>[0056]: “[T]he processor 82 <i>optionally calibrates the low power oscillator 84 using signals generated by the XOSC 54.</i> In step 170, <i>the RF transceiver and the BBP are transitioned to the low power state or mode.</i> In step 172, <i>the internal clocks are disabled and the PLLs, the XOSC and the voltage regulators are shut down.</i>”</p>

	<p>410). <i>If the device 100 is not in the scanning mode,</i> the power management module 202 puts the network interface module 201 <i>in the doze mode (step 412).</i>”</p> <p>(all emphasis above added)</p>	<p>[0057]: “Upon entering <i>sleep mode, all mobile stations time the duration of the sleep interval in order to wakeup and stabilize all circuitry</i>”</p> <p>Pet. at 28-31.</p>
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Based on this comparison, Donovan satisfies the first prong of *Advanced Bionics* as being substantially the same as or cumulative to a reference (Krantz) previously presented to the Office.

3. Pan Is Nearly Identical to Another Reference by the Same Inventors That Was Previously Considered by the Examiner

Pan (Ex. 1009) is substantially the same as another Pan reference previously presented to the Office, namely U.S. Patent Publication No. 2004/0192294 to Pan (“Pan-294”, Ex. 2020). Pan-294 shares the same exact inventive entity (inventors ShaoWei Pan, Jinzhong Zhang, Angel Favila, Nicholas Labun) as the Pan reference Petitioners now rely on. Pan-294 was presented to the Office in an Invention Disclosure Statement filed during prosecution of the '996 Patent. Ex. 1002 at 54 (IDS filed 3/30/18), 467 (Examiner initials marking as “considered”). Pan is cumulative to Pan-294 because they share nearly identical disclosures, contain identical text in substantial portions (including identical Figures 1-7), and were even

filed concurrently, on June 26, 2002. *Compare* Pan at Fig. 1-7 with Pan-294 at Figs. 1-7.

Pan is cited by Petitioners for disclosing “an interface (*e.g.*, ‘media gateway’) causes a communication module to communicate (*e.g.*, ‘commands’ ‘mobile station’ to initiate handover to ‘second network’ using ‘transceiver’).” Pet. at 85-88 (citing Pan, [0030], [0032], [0040]-[0042], [0055]). Those cited paragraphs [0030], [0032], [0040]-[0042], [0055] appear verbatim in Pan-294 as paragraphs [0028], [0030], [0038]-[0040], and [0053], respectively. Pan satisfies the first prong of *Advanced Bionics* as being substantially the same as or cumulative to a reference (Pan-294, Ex. 2020) previously presented to the Office.

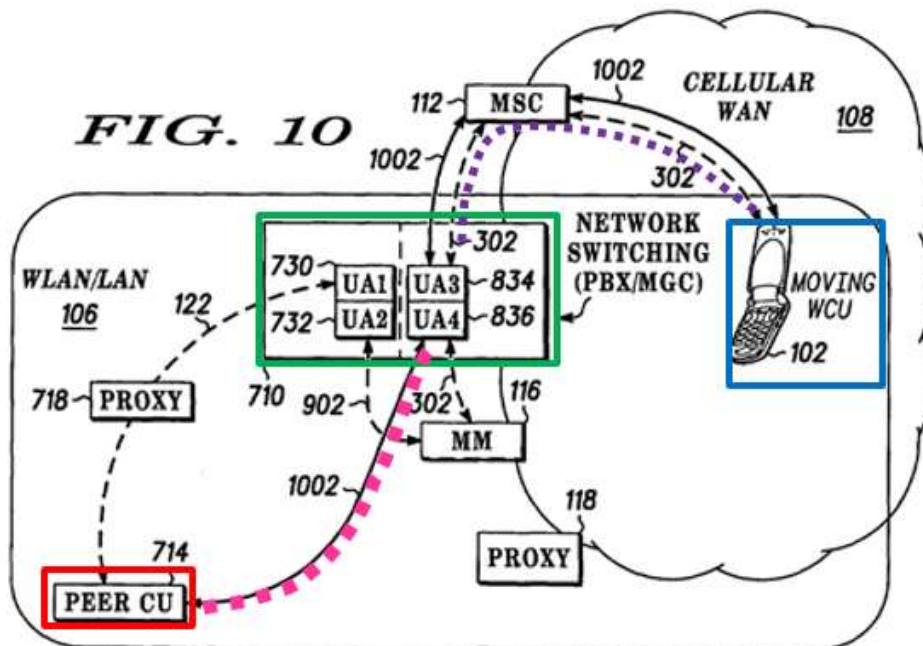
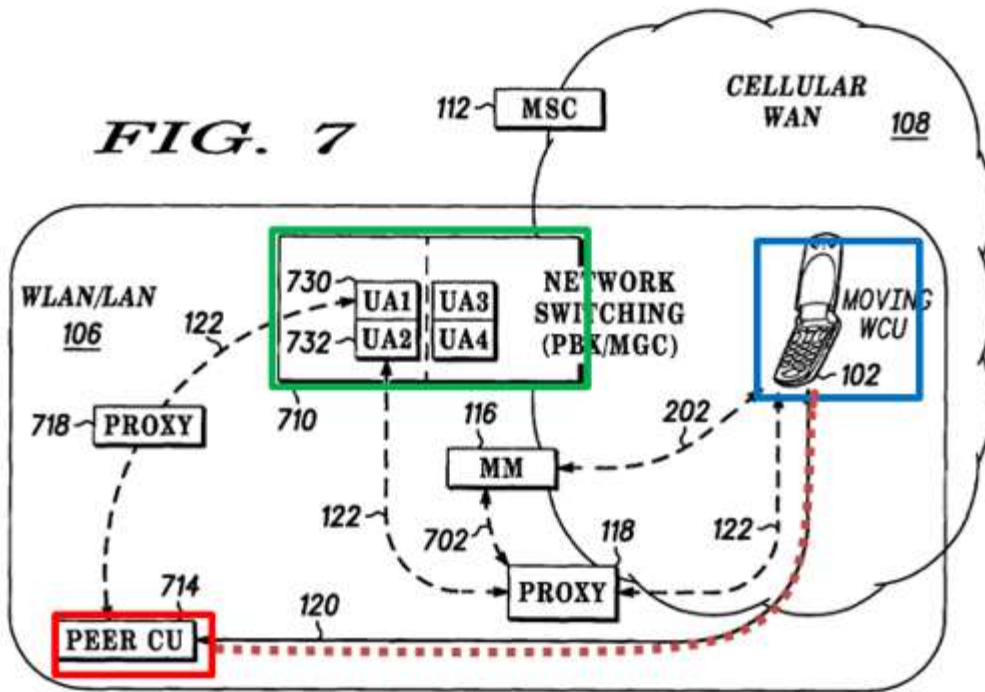
4. Iizuka Is Cumulative to Art Considered by the Examiner During Examination of the '996 Patent and Used During a Related '181 Patent Examination

Iizuka (Ex. 1007) is cumulative to art considered by the Examiner during the examination of the '996 Patent. Specifically, Iizuka is cumulative to U.S. Patent No. 7,398,088 to Belkin (“Belkin,” Ex. 2015) and U.S. Patent No. 8,041,360 to Ibe (“Ibe,” Ex. 2016), which were presented to the Office in an Invention Disclosure Statement filed during prosecution of the '996 Patent. Ex. 1002 at 48 (IDS filed 3/30/2018), 461 (Examiner initials marking as “considered”).

Iizuka is cumulative to Belkin and Ibe because of the overlap between the arguments made during the examination of the related '181 Patent distinguishing

Belkin and Ibe and the manner in which Petitioners rely on Iizuka in this case. To give some background, the Examiner rejected the then-pending claims of the '181 Patent as obvious over Ibe and Belkin and used for identical purposes. Ex. 2017 ('181 Patent file history) at 5-11. The present Petition relies on Iizuka for the same elements allegedly disclosed by the combination of Ibe and Belkin. *See id.* at 5-11 (2/7/2013 Office Action rejecting the then-pending Challenged Claims), 64-74 (6/27/2013 Final Office Action rejecting the same), 83-86 (8/23/2013 Response overcoming the Examiner's Rejection), 94 (7/10/2014 Notice of Allowance crediting the arguments and amendments filed on 8/23/2013).

During examination of the '181 Patent, the Examiner mapped Belkin's wireless communication unit (WCU) 102 to the claimed "**mobile communication device**", the network switching function 710 to the claimed "**interface server**", the peer communication unit (Peer CU) 714 to the claimed "**end destination device**," and the link 1002 between Peer CU 714 and network switching function 710 to the "**second communication link**." Ex. 2017 at 7-8, 64-66.



Ex. 2015 (Belkin) at Figs. 7 and 10 (annotated). This mapping is nearly identical to the Petitioners' use of Iizuka, with the Petitioners' annotations reproduced below in Figures 13 and 14 of Iizuka.

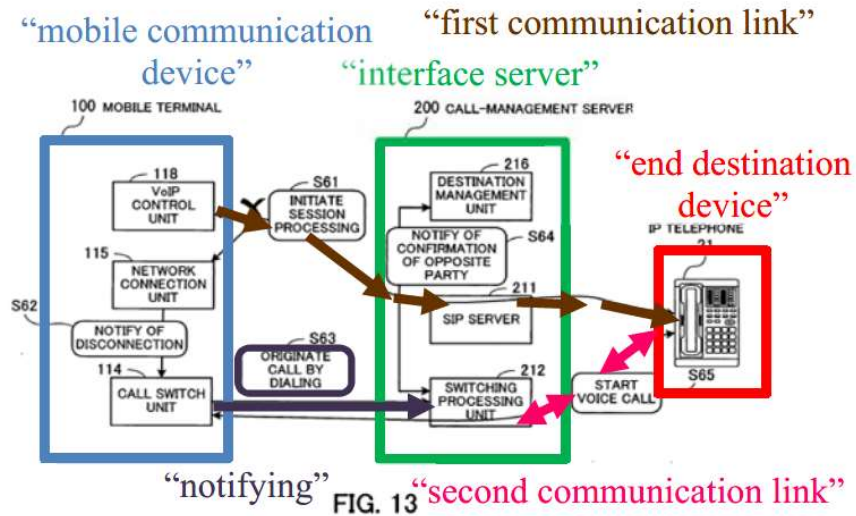


FIG. 13

Pet. at 68 (citing Fig. 13 of Iizuka, annotated).

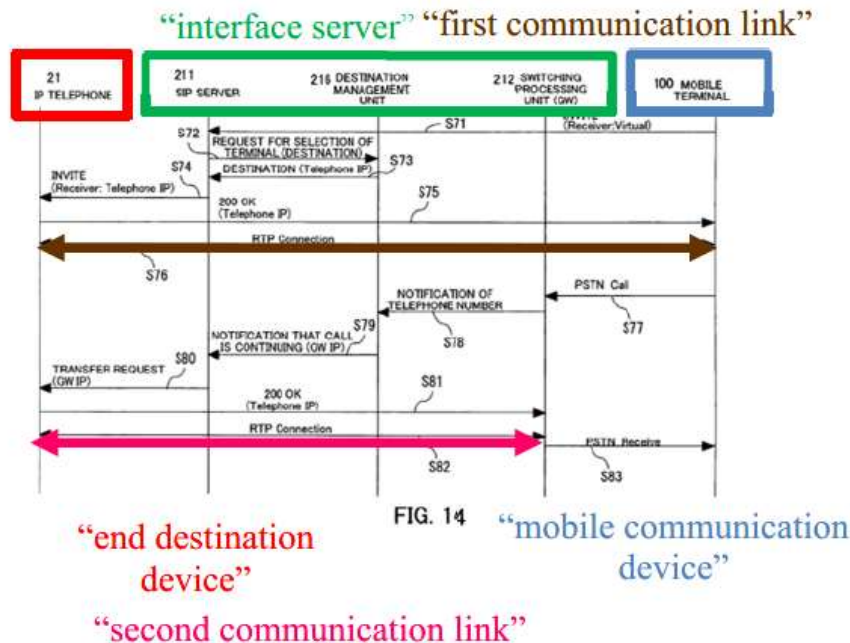


FIG. 14

Id. (citing Fig. 14 of Iizuka, annotated).

Under Petitioners' theory, after a first communication link between a mobile communication device and an end destination device has been established at S76 (Pet. at 66-67), a second communication link (an RTP connection for real-time audio streams) is established at Step S82 between Iizuka's call-management server 200 (alleged interface server) and its mobile terminal 100 (the alleged end destination device). *Id.* at 62, 68. As Vasu argued persuasively to the Examiner during the '181 Patent examination, "[r]erouting a connection is not the same as establishing a second connection." Ex. 2017 ('181 Patent File History) at 36. For at least that reason, Iizuka's rerouting of the initial RTP connection is not tantamount to establishing a second connection, as claimed.

Accordingly, the Office already considered and rejected an argument that transferring the original communication link between a mobile communication 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 an end destination device without disrupting the first communication link." Thus, Iizuka is cumulative to art already previously presented to the Office.

5. DeAnna and Preston Are Also Cumulative to Art Considered by the Examiner During the '996 Patent Examination

DeAnna (Ex. 1006) is cited for disclosing “a server.” Pet. at 45-46 (citing DeAnna [0022] “[t]o the extent it is argued [that] Dorenbosch does not render obvious a server based on the knowledge of a POSITA”). DeAnna is cumulative to Jagadeesan, which was already before the Examiner and used to reject the '996 Patent during examination. Ex. 1002 at 429-40. Examiner relied on Jagadeesan to reject the claims 13, 24, 26, and 35, citing [0023] of Jagadeesan for disclosing “IP data network 17 enables communication between endpoints coupled to cellular network 14, WLAN and IP data network 17.” *Id.* at 432. DeAnna and its alleged teaching of “a server” is therefore cumulative to Jagadeesan, which was already before the Office. DeAnna at [0022].

Preston (Ex. 1008) is relied upon by Petitioners “[i]f further disclosure of ‘notifying the mobile communication device to terminate transmission over the first communication link’ (limitation [39.d]) is required.” Pet. at 78-79 (citing Preston [0043]). Petitioners cite Preston for teaching transmitting a “SIP BYE message” to a SIP telephone. *Id.* (citing Preston at [0043]). But, this disclosure of a “SIP BYE message” is cumulative to a similar disclosure of “SIP BYE message” found in Belkin (Ex. 2015 at 14:33-44). Preston and its teachings of a “SIP BYE message” is therefore cumulative to Belkin, which was already before the Office.

B. 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.

In their Petition, Petitioners argue that “[t]he presented grounds are not cumulative of any art considered and are not the same/substantially the same as the art/arguments considered.” Pet. at 11. This claim is misleading, at best, particularly in the cases where the references (e.g., Pan and Dorenbosch) name the same inventors and have only slight differences with references already expressly considered by the Office. Petitioners also provide a vague, generic catch-all argument that “the references describe features Examiner found missing from the art during prosecution,” but they fail to identify with any particularity what features they are referring to. *Id.* (citing the entirety of Section IX, which spans over 70 pages of analysis, and citing a range of over 120 pages of its expert’s declaration).

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 show any 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

Accordingly, the Board should exercise its discretion and deny Petitioner's IPR Petition under § 314(a).

Respectfully submitted,

Dated: May 12, 2025

/James Hannah/

James Hannah (Reg. No. 56,369)
Kristopher Kastens (Reg. No. 57,517)
Kramer Levin Naftalis & Frankel LLP
333 Twin Dolphin Drive, Suite 700
Redwood Shores, CA 94065
Telephone: (650) 752-1700
Facsimile: (650) 752-1800
jhannah@kramerlevin.com
kkastens@kramerlevin.com

Jeffrey H. Price (Reg. No. 69,141)
Jeffrey Eng (Reg. No. 63,189)
Kramer Levin Naftalis & Frankel LLP
1177 Avenue of the Americas
New York, NY 10036
Telephone: (212) 715-7502
Facsimile: (212) 715-8302
jprice@kramerlevin.com
jeng@kramerlevin.com

Attorneys for Patent Owner
Vasu Holdings, LLC

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

The undersigned hereby certifies that the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** has 9,513 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24(b) and the March 26, 2025 Memorandum re: Interim Processes for PTAB Workload Management. This word count was prepared using the Microsoft Word word-processing system used to prepare this paper.

Dated: May 12, 2025

/James Hannah/
James Hannah (Reg. No. 56,369)

Attorneys for Patent Owner

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 Petitioners as detailed below.

<i>Date of service</i>	May 12, 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
<i>Persons Served</i>	ROPES & GRAY LLP James L. Davis, Jr., Alexander E. Middleton, Christopher M. Bonny

/James Hannah/
James Hannah
Registration No. 56,369
Lead Counsel for Patent Owner