

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

FOUR BATONS WIRELESS, LLC,

Patent Owner

Case IPR2025-00493

U.S. Patent No. 7,502,348

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

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PETITIONERS' EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent No. 7,502,348 (“’348Pat.”)
1002	Declaration of Michael Kotzin, Ph.D. (“Kotzin”)
1003	Curriculum Vitae of Michael Kotzin, Ph.D.
1004	File History of U.S. Patent No. 7,502,348 (“File History”)
1005	U.S. Patent Application Publication 2004/0165563 (“Hsu”)
1006	U.S. Patent Application Publication 2004/0198302 (“Hutchison”)
1007	U.S. Patent Application Publication 2003/0193910 (“Shoaib”)
1008	U.S. Patent No. 5,457,810 (“Ivanov”)
1009	U.S. Patent Application Publication 2004/0137902 (“Chaskar”)
1010	U.S. Patent Application Publication 2004/0264414 (“Dorenbosch”)
1011	Waharte <i>et al.</i> , “Selective Active Scanning for Fast Handoff in WLAN Using Sensor Networks” (Jan. 2004) (“Waharte”)
1012	Li <i>et al.</i> , “A Reliable Active Scanning Scheme for the IEEE 802.11 MAC Layer Handoff” (Aug. 2003) (“Li”)
1013	U.S. Patent Application Publication 2004/0005894 (“Trossen”)
1014	U.S. Patent Application Publication 2003/0104814 (“Gwon”)
1015	Mishra <i>et al.</i> , “An Empirical Analysis of the IEEE 802.11 MAC Layer Handoff Process” (Jan. 2003) (“Mishra”)
1016	U.S. Patent No. 6,487,596 (“Dougkis”)
1017	U.S. Patent Application Publication 2002/0160812 (“Moshiri-Tafreshi”)
1018	U.S. Patent Application Publication 2006/0178147 (“Jagadeesan”)
1019	B. Jabbari and W. Fuhrmann, “Teletraffic Modeling and Analysis of Flexible Hierarchical Cellular Networks with Speed-Sensitive

Exhibit No.	DESCRIPTION
	Handoff Strategy,” IEEE Journal on Selected Areas in Communications, 15(8), 1539-1548 (1997) (“Jabbari”)
1020	Complaint in <i>Four Batons Wireless, LLC, v. Samsung Electronics Co., Ltd. et al.</i> , 2:24-cv-00284 (E.D. Tex. April 26, 2024)
1021	Docket Control Order from <i>Four Batons Wireless, LLC v. Samsung Electronics Co., LTD, et al.</i> , No. 2:24-cv-0284-JRG (ECF 035) (E.D. Tex. Aug. 26, 2024)
1022	Cover Pleading of Plaintiff Four Batons Wireless, LLC’s Disclosures Pursuant to Local Patent Rules 3-1 and 3-2, Dated July 25, 2024
1023	Letter from Jin-Suk Park to Meng Xi dated April 18, 2025
1024	Order re Samsung’s Motion To Stay Proceedings Pending <i>Inter Partes</i> Review in <i>Four Batons Wireless, LLC v. Samsung Electronics Co., Ltd. et al.</i> , Case No. 2:24-cv-284, Dkt. No. 74 (E.D. Tex. Filed May 29, 2025)
1025	<i>Harbor Island Dynamic, LLC v. Samsung Elecs. Co.</i> , No. 2:24-CV-00140-JRG-RSP, Dkt. 81 (E.D. Tex. May 19, 2025)
1026	<i>Cellspin Soft, Inc. v. ByteDance Ltd.</i> , No. 2:23-CV-00496-JRG-RSP, Dkt. 106 (E.D. Tex. Jan. 26, 2025)
1027	Third Amended Docket Control Order in <i>Four Batons Wireless, LLC v. Samsung Electronics Co., Ltd. et al.</i> , Case No. 2:24-cv-284, Dkt. No. 76 (E.D. Tex. Filed May 29, 2025)
1028	Affidavit of Service in <i>Four Batons Wireless, LLC v. Samsung Electronics Co., Ltd. et al.</i> , Case No. 2:24-cv-284, Dkt. No. 10 (E.D. Tex. Filed May 1, 2024)
1029	PTAB Trial Statistics (FY 2024), USPTO
1030	Answer and Counterclaims in <i>Four Batons Wireless, LLC v. Samsung Electronics Co., Ltd. et al.</i> , Case No. 2:24-cv-284, Dkt. No. 24 (E.D. Tex. Filed Aug. 19, 2024)

I. INTRODUCTION

Petitioners Samsung Electronics, Co., Ltd. and Samsung Electronics America, Inc. (collectively “Samsung”) respectfully request that the Director deny Four Baton Wireless, LLC’s (“PO”) request to discretionarily deny this *inter partes* review (“Request”) of U.S. Patent No. 7,502,348 (“the ’348 patent”).¹ A holistic review of the factors governing discretionary denial show that the efficiency and integrity of the patent system would not be well served by denying institution here. Samsung has presented a straightforward combination of prior art that renders claims 1-8, 10, 11, and 13-21 of the ’348 patent obvious. Samsung timely filed the Petition, has submitted a stipulation broader than the stipulation submitted in *Sotera*, and if the Petition is instituted, it will be before most major milestones in the parallel district court case. Thus, *Fintiv* factors 3, 4, and 6 weigh against denying institution and outweigh *Fintiv* factors 1, 2 and 5.

PO also fails to identify any other considerations that warrant discretionary denial. The ’348 patent has not been the subject of any prior re-examination or validity challenges. PO’s challenge to the merits of the Petition (including that Petitioners allegedly take inconsistent claim construction positions) and criticism of

¹ The Notice of Filing Date Accorded issued on March 21, 2025 (Paper 6), meaning this opposition was due on June 21, 2025 (i.e., three months later). As June 21, 2025 was a Saturday, 35 U.S.C. § 21(b) extends the deadline to the next succeeding business day of June 23, 2025.

Dr. Kotzin's declaration are hollow and lack specificity. Moreover, to the extent there are any settled expectations here, it would be that Samsung believed it was licensed to the patent and, therefore, had no need to challenge its patentability.

II. DISCRETIONARY DENIAL IS NOT WARRANTED UNDER *FINTIV*

A. Factor 1 (Stay): The Board Does Not Speculate On A Stay

This factor is neutral. Although the district court denied Samsung's motion to stay pending IPR, it was *without prejudice* to Samsung's ability to renew the motion after the Board's institution decision. *See* Ex-1024 (“[T]he Court concludes that the Motion is premature, and a stay of these proceedings in advance of the PTAB's institution decision should be denied. Accordingly, the Motion is denied without prejudice to refileing ... following the PTAB's institution decision.”).

Moreover, a stay is still possible in the event of institution. Judge Gilstrap has previously granted contested stays in circumstances when all asserted claims of all asserted patents are challenged in the instituted IPRs, recognizing that the Board's review will likely result in simplification of issues before the court.² *See, e.g., Harbor Island Dynamic, LLC v. Samsung Elecs. Co.*, No. 2:24-CV-00140-JRG-RSP, Dkt. 81, at 5 (E.D. Tex. May 19, 2025) (granting contested stay: “Here, the

² By way of this Petition, as well as the petitions filed in IPR2025-00494, IPR2025-00495, and IPR2025-00496, Petitioners have challenged all claims of all four patents asserted by PO against Petitioners in the parallel district court litigation.

Board has instituted a trial covering all asserted claims. ... Accordingly, the simplification factor weighs in favor of a stay.”) (Ex-1025); *Cellspin Soft, Inc. v. ByteDance Ltd.*, No. 2:23-CV-00496-JRG-RSP, Dkt. 106, at 5 (E.D. Tex. Jan. 26, 2025) (same) (Ex-1026); *STA Grp. LLC v. Motorola Sols., Inc.*, No. 2:22-CV-00381-JRG-RSP, 2024 WL 2852961, at *2 (E.D. Tex. Jun. 5, 2024) (granting stay: “Further, the Court finds that Motorola has demonstrated that a stay would result in significant simplification of issues.”); *Resonant Sys., Inc. v. Samsung Elecs. Co.*, No. 2:22-CV-00423-JRG, 2024 WL 1021023, at *3 (E.D. Tex. Mar. 8, 2024) (granting stay: “Given that *inter partes* review had been instituted on all Asserted Claims of all Asserted Patents on multiple grounds, there is a material likelihood of simplification of the issues in this case. ... Further, the cancellation of some or all of the claims could result in simplification of issues in this case.”); *Commc’n Techs., Inc. v. Samsung Elecs. Am., Inc.*, No. 2:21-CV-00444-JRG, 2023 WL 1478447, at *3 (E.D. Tex. Feb. 2, 2023) (granting stay: “[T]he most important factor bearing on whether to grant a stay ... is the prospect that the [IPR] will result in simplification of issues.” (citation omitted)).

Thus, whether the parallel case will be stayed is still to be determined and the Board “will not attempt to predict how the district court ... will proceed” regarding potential stays “because the court may determine whether or not to say any individual case ... based on a variety of circumstances and facts.” *Sand Revolution*

II, LLC v. Cont'l Intermodal Grp.-Trucking LLC, IPR2019-01393, Paper 24, at 7 (PTAB Jun. 16, 2020); *Samsung Elec. Co. v. CardWare Inc.*, IPR2023-00211, Paper 13, at 7-8 (PTAB Jun. 13, 2023) (where district court had denied a motion to stay filed prior to institution without prejudice, declining to speculate as to how the court would rule on a renewed motion after institution and weighing this factor as neutral).

B. Factor 2 (Trial Date): The Expected Trial Date Is Approximately Six Months Before The Expected FWD And Trial May Move

While trial is currently scheduled in the parallel litigation on February 9, 2026, the median time to trial statistics for the Eastern District of Texas suggest a trial date in late-March or early April 2026.³ Ex-2006 at 35. The projected final written decision date is September 23, 2026. The PTAB has assigned varying weight to this factor under similar timelines. Compare, e.g., *Equipmentsshare.com Inc. v. Ahern Rentals, Inc.*, IPR2021-00834, Paper 19 at 13 (PTAB Nov. 16, 2021) (a period of seven months between trial and expected FWD “weighs somewhat in favor” of denial) with *Solus Adv. Matls. Co. Ltd. v. SK Nexilis Co., Ltd.*, IPR2024-01460, Paper 14 at 15-16 (“A trial date that is roughly six months earlier than the statutory deadline, on the facts of this case, strongly favors discretionary denial.”). This factor, however, should not be given the “strong” weight PO suggests.

³ The latest statistics state a median time from filing to trial of 23 months. Ex-2006 at 35. The complaint in the parallel litigation was filed on April 26, 2024.

Modifications to the trial date are likely. The trial date was scheduled in the nascency of the parallel litigation and less than three months after the filing of the complaint. Moreover, the district court has already scheduled *seven* trials for the same day, which cannot possibly all proceed at the same time. In fact, PO concedes that the “most recent median time to trial statistics for the Eastern District of Texas” suggest a later trial date than currently scheduled. Request at 7. Accordingly, any comparison of a projected FWD date against the scheduled trial date is speculative. *See Dish Network LLC v. Broadband iTV, Inc.*, IPR2020-01280, Paper 17 at 16 (PTAB Feb. 4, 2021) (“We cannot ignore the fact that the currently scheduled trial date is more than nine months away and much can change during this time”).

C. Factor 3 (Parallel Proceeding): There Will Be Significant Work Remaining In The District Court As Of The Institution Deadline

This factor weighs against exercising discretion to deny institution because significant work will remain in the parallel district court litigation as of the September 23, 2025 institution decision deadline. The table below summarizes the work that will remain as of the institution decision deadline (Ex-1027):

Event	Date
Claim Construction Hearing	Aug. 11, 2025
Close of Fact Discovery	Sep. 12, 2025
Opening Expert Reports	Sep. 24, 2025
Rebuttal Expert Reports	Oct. 21, 2025
Close of Expert Discovery	Oct. 29, 2025
Dispositive Motions	Nov. 3, 2025
Dispositive Motion Response Briefs	Nov. 17, 2025

Event	Date
File Pretrial Order	Dec. 23, 2025
Pretrial Conference	Jan. 5, 2026
Jury Selection	Feb. 9, 2026

As shown above, nearly every significant milestone in the case—including expert discovery, dispositive and *Daubert* motions, pretrial conference and trial—is scheduled to occur *after* the Board’s institution decision. Moreover, given that the claim construction hearing is currently scheduled for August 11, 2025, a claim construction order likewise may not issue before the institution decision deadline.

Under similar circumstances, the Board has found this factor to weigh against denying institution. For example, in *Samsung Elecs. Am., Inc. v. Snik LLC*, the Board found that this factor did not weigh in favor of denying institution even where the district court had already issued a claim construction order and fact discovery was set to close on the institution decision deadline. IPR2020-01427, Paper 10, at 11 (PTAB March 9, 2021). As the Board explained, “although there has been some investment in the parallel proceeding, the remaining investment and [Samsung’s] diligence in filing the petitions outweigh the investment such that this factor does not weigh in favor of denying institution.” *Id.*; see also *Bio-Rad Labs, Inc., v. Cal. Inst. of Tech.*, IPR2024-01451, Paper 11 at 10 (PTAB March 27, 2025) (finding this factor weighs against denying institution where “much more work remains, including, expert reports, expert discovery, expert depositions, and pretrial motions

and disclosures.”).

Samsung exercised the same diligence here. Like in *Snik*, this Petition was filed three months before the statutory bar date.⁴ *Id.* (“Petitioner was diligent in filing its petitions nearly three months before the statutory bar.”). Relatedly, the Petition was filed six months after receiving PO’s infringement contentions in the parallel litigation. *See, e.g., Fintiv*, IPR2020-00019, Paper 11 at 11 (“[I]t is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding.”).

The timing is particularly reasonable here because Samsung filed not only the instant Petition, but three additional petitions, directed to all four patents asserted by PO in the parallel litigation.⁵ Therefore, it is unsurprising that PO has not identified—because it cannot identify—any tactical advantage gained by Samsung from the timing of the filing. *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19 (Sep. 12, 2018) (precedential) (“The Petition, therefore, was timely, and Patent Owner does not apprise us of any tactical advantage, or opportunity for tactical advantage, that Petitioner gained by waiting to file the

⁴ While the Complaint was filed April 26, 2024, defendant Samsung Electronics America, Inc. was not served until April 29, 2024. Ex-1028.

⁵ This Petition was filed on January 30, 2025. Between January 24, 2025 and January 30, 2025, Samsung also filed IPR2025-00494, IPR2025-00495, and IPR2025-00496. Together, the four petitions challenge 69 claims.

Petition.”).

Moreover, Samsung respectfully notes that its Notice of Filing Date Accorded (“NFDA”) was not issued until March 21, 2025—50 days after the filing of its Petition on January 30, 2025—which based on Petitioners’ review appears to be more than twice as long as it has historically taken to issue NFDAs. Samsung is mindful of the important work performed by the Director and PTAB in ensuring the integrity of patents, including through its evaluation of 1,288 petitions for IPR and PGR last fiscal year alone (Ex-1029),⁶ and raises this only because the institution decision deadline would likely have occurred *prior* to the close of fact discovery if the NFDA had issued within a time more consistent with historic norms.

D. Factor 4 (Issue Overlap): There Is No Overlap Between Issues In the Parallel District Court Litigation And This Proceeding

This factor weighs strongly against exercising discretion to deny institution. PO argues that “all of Petitioner’s IPR references are also asserted in the District Court Proceeding” and that “the Petition and the Invalidity Contentions use the same combinations of references.” Request at 11. Contrary to PO’s argument, the fact that Samsung was obligated under EDTX P.R. 3-3 and 3-4 to identify all possible prior art relatively early in the case to preserve its defenses should not be held against

⁶ See PTAB Trial Statistics FY24, USPTO (available at https://www.uspto.gov/sites/default/files/documents/ptab_aia_fy2024__roundup.pdf).

Samsung now. The purpose of disclosing invalidity contentions early in the litigation is for the parties to provide notice of and preserve their right to make arguments, not to set out the exact arguments that will ultimately be presented at trial, which happens much later. *See, e.g., Correct Transmission, LLC v. Nokia of Am. Corp.*, No. 2:22-CV-00343-JRG-RSP, 2024 WL 1289821, at *3 (E.D. Tex. Mar. 26, 2024) (“This Court’s Patent Rules mandate invalidity contentions to provide fair notice of a party’s invalidity case and do not require a party to prove their invalidity case in the contentions.”); *GREE, Inc. v. Supercell Oy*, No. 2:19-CV-00070-JRG-RSP, 2020 WL 6731050, at *3 (E.D. Tex. Aug. 14, 2020) (“Indeed, one of the desired outcomes of discovery and a result of expert reports is the crystallization of invalidity and infringement theories preserved in a party’s contentions.”).

PO downplays Samsung’s stipulation that if this Petition is instituted, “then Samsung will not pursue in the above-captioned litigation ... any grounds that were raised or reasonably could have been raised in the IPR[.]” Ex-1023. According to the still precedential *Sotera* decision, this type of stipulation “weighs ***strongly in favor of not exercising discretion***” to deny institution. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 19 (PTAB Dec. 1, 2020) (precedential). Between December 17, 2020, when *Sotera* was designated precedential and the June 21, 2022 Vidal Memo, in the vast majority of petitions in which a *Sotera* stipulation was provided the Board did not exercise discretion to deny institution based on

Fintiv.⁷ Further, the Board’s recent decisions granting institution confirm that *Sotera* stipulations continue to be valid, enforced, and given weight in the *Fintiv* analysis.⁸ See, e.g., *Samsung Elecs. Co. v. Harbor Island Dynamic LLC*, IPR2024-01403, Paper 9, at 39 (PTAB Mar. 24, 2025); *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01433, Paper 13, at 12 (PTAB Apr. 7, 2025); *MediaTek Inc. v. ParkerVision, Inc.*, IPR2025-00030, Paper 9, at 21-22 (PTAB Mar. 31, 2025).

Moreover, Samsung has gone far beyond what *Sotera* requires by also stipulating that if the Petition is instituted, “then Samsung will [also] not pursue in the above-captioned litigation ... combinations of the prior art asserted in this IPR

⁷ Based on Petitioners’ review, of the 122 petitions that were filed with a *Sotera*-stipulation during that time period, 117 of the petitions were instituted. All 5 petitions in which institution was denied are distinguishable: 4 are the *Cisco v. Estech* petitions in which there was an 11-month gap between trial and the FWD (IPR2021-00329, -00321, -00332, and -00333), and in *Immersion Sys. LLC v. Midas Green Techs., LLC*, IPR2021-01176, Paper 16 at 16-17 (PTAB Jan. 6, 2022), the *Sotera*-stipulation was found insufficient because it was contingent upon completion of the IPR proceeding with a FWD and tied to an asserted likelihood of the court granting a stay in the litigation.

⁸ To be sure, newly promulgated FAQ 14 is inconsistent with long-standing precedent. See USPTO, “FAQs for the Interim Processes for PTAB Workload Management,” FAQ #14, available at <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management> (“The Director will take into account whether the stipulation materially reduces overlap between the proceedings. Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited”). But, assuming this is binding guidance, it cannot be reconciled with the letter or spirit of the still-precedential *Sotera* decision.

with unpublished system prior art” (Ex-1023), which is the additional provision that the Director suggested in *Motorola Solutions, Inc. v. Stellar, LLC*, would ensure that the IPR is a “true alternative” to the district court proceeding.⁹ IPR2024-01205, Paper 19 at 4 (PTAB Mar. 28, 2025). PO contends that even this stipulation is insufficient because “Samsung reserved the right to allege invalidity in the District Court Proceeding based on unpublished system prior art—either by itself or in combination with other prior art not asserted in the IPR.” Request at 12. But even *Motorola* didn’t go so far as to suggest—as PO would have it—that a Petitioner must forego all unpublished system prior art (e.g., unpublished system prior art that does not depend on any references relied on in the Petition) as a condition of institution.

Indeed, the Federal Circuit’s recent decision in *Ingenico Inc. v. IOENGINE, LLC*, suggests that Samsung’s stipulation here goes far beyond what is necessary to mitigate any overlap between the IPR and parallel district court litigation. *See* No. 2023-1367, 2025 WL 1318188 (Fed. Cir. May 7, 2025). As *Ingenico* notes, “Congress intentionally limited an IPR’s scope to invalidity challenges based on **‘prior art consisting of patents or printed publications.’** ... But IPR estoppel does

⁹ Samsung provided its stipulation, which goes beyond what *Sotera* required, before the Federal Circuit’s decision in *Ingenico Inc. v. IOENGINE, LLC*, No. 2023-1367, 2025 WL 1318188, at *6-7 (Fed. Cir. May 7, 2025) While Samsung does not withdraw its stipulation, it does not concede that the Director has the authority to require stipulations beyond the scope set out in the *Sotera* decision.

not preclude a petitioner from relying on the same patents and printed publications as evidence in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use.” *Ingenico*, 2025 WL 1318188, at *6-7 (citing 35 U.S.C. § 311(b)).

Thus, *Ingenico* confirms that Congress explicitly chose to limit IPRs to deciding invalidity under §§ 102 and 103, based on prior art consisting only of patents and printed publications. 35 U.S.C. § 311(b). This limit to the scope of issues that can be considered in an IPR was “intentional” by Congress. *Ingenico*, 2025 WL 1318188, at *6. The Post Grant Statute—which allows for challenging a patent on wide range of invalidity grounds not available in IPR (*see* 35 U.S.C. § 321(b))—further confirms that Congress deliberately chose to limit IPRs to a narrow subset of invalidity grounds and to leave all other bases for proving invalidity within the province of district courts. Nothing suggests that Congress intended to empower the Director to consider the defenses that Samsung’s stipulation permits it to continue to maintain in the parallel litigation as a basis for exercising discretion to deny institution.

Factor four also weighs against exercising discretion to deny institution because the Petition challenges claims 1-8, 10, 11, and 13-21 of the ’348 patent whereas PO has only asserted claims 1-6 and 13-17 in the parallel litigation. Ex-2007 at 2. PO argues that challenging additional claims “does nothing to simplify or

provide an alternative to the litigation or eliminate the duplication of effort.” Request at 11. This argument, however, ignores that a petitioner has one opportunity to challenge claims of an asserted patent before the PTAB while a plaintiff, such as PO, remains free to assert new claims at a later time.

This argument likewise ignores prior PTAB practice. The Board has repeatedly found that a difference in the number of claims asserted and challenged weighs against denial, even if a trial precedes a final written decision. *See, e.g., Precision Planting LLC v. Maschio Gaspardo S.p.A.*, IPR2024-00008, Paper 12, at 18 (PTAB Mar. 26, 2024) (holding that despite substantial issues between the IPR petition and parallel district court action, the inclusion of claims in the petition not contested in court argues against discretionary denial due to incomplete overlap); *Apple Inc. v. Neodron Ltd.*, IPR2020-00778, Paper 10, at 19 (PTAB Sept. 14, 2020) (weighing factor four against discretionary denial because “the ITC will not consider the validity of challenged claims 13 and 14”); *PUMA North Am., Inc. v. Nike Inc.*, IPR2019-01043, Paper 8, at 9-10 (PTAB Oct. 31, 2019) (“The Litigation only addresses challenged claims 1, 5, and 6” whereas “the Litigation *does not address* challenged claims 9, 10, 13, 14, or 17. ... Accordingly, even if trial in the Litigation were to conclude prior to the statutory due date for the Final Written Decision in this proceeding, questions regarding the patentability of the majority of challenged claims would remain unresolved.”) (emphasis in original). Notably, PO identifies no

support to the contrary. *See* Request at 11-12.

E. Factor 5 (Parties): That Samsung Is The Defendant In The Parallel Litigation Does Not Warrant Denial

This factor should be neutral. While Samsung is also a defendant in the parallel district court litigation, *Fintiv* only addresses the scenario in which the petitioner is unrelated to a defendant in a parallel proceeding, finding this should weigh against denying institution. But *Fintiv* “says nothing about situations in which the petitioner is the same as, or is related to, the district court defendant.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15, at 10-11 (PTAB May 15, 2020) (APJ Crumbley, dissenting) (noting that weighing this factor against a petitioner when the parties in IPR are the same in related litigation, could “tip the scales against a petitioner merely for being a defendant in the district court.” This “would seem to be contrary to the goal of providing district court litigants an alternative venue to resolve questions of patentability.”).

F. Factor 6 (Other Considerations): The Petition’s Merits Are Strong And No Other Factors Warrant Exercising Discretion To Deny Institution

This factor weighs against exercising discretion to deny institution because Samsung was diligent in filing the Petition and the Petition presents compelling grounds of unpatentability under § 103.

PO repeats its criticism that Samsung allegedly delayed filing its petition.

Request at 12-13. As discussed with respect to factor three, Samsung filed its petition well before the statutory deadline and within a reasonable time after receiving PO's infringement contentions. PO has not identified any tactical advantage gained by Samsung, or disadvantage suffered by PO, as a result of the timing of Samsung's petition. Additionally, as discussed with respect to factor four, Samsung stipulation means that all issues that are within the statutory purview of the Office will be decided by the Board if the IPR is instituted.

PO's reliance on correspondence from November 11, 2021 to support a purported lack of diligence is also meritless. In fact, the correspondence PO relies on, which notably identifies sixty-one patents, evidences Samsung's belief that it has a license to those patents, and confirms that PO waited over two years before filing an infringement suit against Samsung. *See* Ex-2011 at 7, 23.

In any event, PO identifies no authority for its expansive view that the Board should measure diligence from the time of pre-suit discussions. Moreover, its suggestion that such correspondence necessitates immediate filing of IPRs is inconsistent with Congress's intentional setting of the statutory bar for filing an IPR at one year from *service of a complaint*. 157 Cong. Rec. S5429 (daily ed. Sept. 8, 2011) ("The purpose of giving defendants a full year to seek IPR is to 'afford defendants a reasonable opportunity to identify and understand the patent claims that are relevant to the litigation.'"); *see also* 35 U.S.C. § 315(b) (petitioners have one

year to file an IPR petition after service of a complaint).

PO's assertions as to the merits of Samsung's Petition likewise do not support discretionary denial. PO argues that the merits are weak because the presented grounds are not anticipatory and rely on "hindsight-based modifications to its references." Request at 14. The Director should disregard these conclusory, non-substantive arguments. Anticipation has never been a requirement for concluding that the merits of a petition are strong. Rather, "[c]ompelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence." *BioNTech SE v. Moderna TX Inc.*, IPR2023-01358, Paper 19, at 18 (PTAB Mar. 19, 2024) (finding petitioner made a compelling merits showing based on obviousness grounds); *Samsung Bioepis Co. v. Regeneron Pharms., Inc.*, IPR2023-00884, Paper 13 at 71-72 (PTAB Nov. 17, 2023) (finding each of grounds presenting a two-reference, a three-reference, and a four-reference obviousness grounds demonstrated compelling merits). And PO provides no evidence or explanation to supports its assertion that the Petition is "hindsight-based."

Lastly, PO complains that Dr. Kotzin testifying regarding what a POSITA would have understood is somehow improper (Request at 14-15), but fails to provide any specific examples. A review of Dr. Kotzin's declaration reveals that, as a general rule, where he referred to what a POSITA would have understood, he was either

testifying regarding the background knowledge that a POSITA would have had when reviewing the prior art and/or explaining how the teachings of the prior art relate to the patentability of the challenged claims. This is exactly the type of expert testimony that the Board encourages in the Consolidated Trial Practice Guide. *See* CTPG (Nov. 2019) at 34-35 (“Expert testimony may have many uses. ... It may be used to establish the level of skill in the art and describe the person of ordinary skill in the art. Experts may testify about the teachings of the prior art and how they relate to the patentability of the challenged claims.”).

G. Summary of the *Fintiv* Factors: Factors 3, 4, and 6 Weigh Against Denying Institution and Outweigh Factors 1, 2 and 5

Weighing the *Fintiv* factors together, the Director should decline to exercise discretion to deny institution. By the time of institution, most of the significant milestones in the case—including expert discovery, summary judgment and *Daubert* motions, pretrial conference, and trial—will not have occurred. Indeed, it is likely that even the *Markman* order may not have issued by then. Additionally, Samsung’s stipulation—which actually goes beyond what is even required by *Sotera*—ensures that all issues within the statutory purview of the Office will be decided by the Board and *strongly* weighs against exercising discretion to deny institution. Moreover, the petition challenges more claims than are at issue in the parallel litigation. Institution is also merited because the Petition presents compelling grounds of unpatentability.

By contrast, none of factors 1 (neutral), 2 (against), and 5 (neutral)—whether considered alone or together—are sufficient to overcome the strong reasons against denying institution.

III. NO ADDITIONAL CONSIDERATIONS WEIGH IN FAVOR OF DISCRETIONARY DENIAL

PO also fails to identify any other considerations that warrant the Director exercising discretion to deny institution.

A. The Petition Presents Compelling Grounds And Dr. Kotzin’s Declaration Is Reliable

As discussed above, the Petition presents compelling grounds of unpatentability. Far from detracting from the merits, the Kotzin Declaration confirms that point. The Board has long recognized the useful role of expert testimony in explaining complex technologies and how a person of ordinary skill in the art (“POSITA”) would have understood them. *See Consolidated Trial Practice Guide*, 34-35 (Nov. 2019). This is particularly true under 35 U.S.C. § 103, which necessarily considers whether “the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.” As such, Dr. Kotzin’s Declaration contains his opinions regarding the level of skill in the art and describes the person of ordinary skill in the art (“POSITA”), how a POSITA would have read and interpreted the references that are cited in the grounds of

unpatentability, and the reasons why a POSITA would have been motivated to combine the references and would have had a reasonable expectation of success.

PO does not acknowledge any of this, and instead faults Petitioners' and Dr. Kotzin's purported "extensive reliance on an expert declaration" and "frequent[] rel[iance] on conclusory statements and repeating/rewording the contents of the legal brief[,]” respectively. Request at 15-16. But PO neither identifies any specific examples of reliance on “conclusory statements” or “repeating/rewording [of] the contents.”¹⁰ *See id.*

B. Samsung Had A Settled Expectation That It Had A License To The Patent

The Process Memorandum¹¹ refers to the “[s]ettled expectations of the *parties*,” not just the patent owner’s. Process Memorandum at 2. Here, to the extent

¹⁰ Dr. Kotzin provided his declaration prior to the Process Memorandum and prior to the Board’s April 25, 2025, “FAQs for Interim Processes for PTAB Workload Management.” Dr. Kotzin’s declaration was, therefore, in accordance with the rules and practices in effect at the time that Samsung filed its Petition. Nevertheless, regarding FAQ 21, Dr. Kotzin’s testimony is comprehensive (because he agrees with the unpatentability grounds in the Petition), but it is also focused because it provides helpful information beyond what is evident on the face of the prior art. *See, e.g.*, Ex-1002, ¶¶47-51 (discussing why the references used in the grounds are analogous to the challenged patent), 188-191, 227-232, 243-246 (discussing motivation to combine IPR references), 109, 110, 115, 125, 126, 146, 147, 174, 230, 231, 235, 244 (discussing what a POSITA would have known, including providing supporting evidence).

¹¹ Available at <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>

there are any settled expectations, it would be that Samsung believed the patent would not be enforced against it because it already had a license to it. Samsung, therefore, had no reason to challenge the patent through IPR prior to PO filing the parallel litigation. *See* Ex-2011 at 21 (“Samsung’s position is clear that its products are licensed under the patents Four Batons Wireless acquired from Toshiba and/or Ericsson.”). After Samsung made its position clear to PO in 2022, PO waited until 2024 to file suit. Thus, to the extent there are any settled expectations, they do not weigh in favor of discretionary denial.

Instead, PO notes that the ’348 patent has been in force for more than 16 years, without explaining how that age is allegedly relevant to this factor. Request at 16. For example, the ’348 patent was not PGR-eligible; thus, the fact that no PGR was filed against the ’348 patent is not relevant to its alleged strength. Notably, while Congress time-limited PGRs to within nine months of a patent’s grant (35 U.S.C. § 321(c)), it placed no limit on an IPR measured from the patent’s grant date. Instead, if a petitioner is served with a complaint alleging infringement, it must file an IPR within one year of having been served. 35 U.S.C. § 315(b). Petitioners are well within that deadline here. This difference in timing effectuates Congress’ intention to establish IPRs as a more streamlined and efficient mechanism to litigation. H.R. Rep. No. 112-98, at 39–40 (2011) (“The legislation is designed to establish a more efficient and streamlined patent system that will improve patent quality and *limit*

unnecessary and counterproductive litigation costs.”) (emphasis added).

As noted, Samsung had no reason to initiate IPR earlier than it did because it had a settled expectation that it was licensed to the patent. Now that PO has nevertheless initiated litigation, instituting this IPR effectuates Congress’ intent to have this IPR serve as a more efficient and streamlined mechanism for evaluating the patent’s validity and to “limit unnecessary and counterproductive litigation costs.” *Id.* This IPR will especially serve that purpose given the merits of the grounds presented, and the broad scope of Petitioners’ stipulation to not raise certain defenses in district court if this IPR is instituted and not later vacated (Ex-1023). That Samsung maintains its license defense in district court is also no reason to deny institution. Congress always intended IPRs to serve as focused challenges to patents, which is why they are limited “only [to] a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). A license defense lies in contract and is unrelated to patent validity. No post-grant proceeding established by Congress allows a petitioner to raise license as a defense to an allegation of infringement. In other words, there is no overlap between the issues such that there is any concern with two different fora considering the same issues or potentially reaching inconsistent outcomes. It would be manifestly unfair and an unreasonable exercise of the Director’s discretion to deny institution because a petitioner has raised a license

defense in a parallel litigation.

Although not cited by PO, the Director’s decision in *Dabico Airport Sol’ns, Inc. v. Axa Power APS*, 2025-00408, Paper 21 (PTAB Jun. 18, 2025), is also not a reason to deny institution. In *Dabico*, the Director exercised her discretion to deny institution because the challenged patent had been in force for eight years. *Id.* at 2. As noted above, however, Samsung believed that it was already licensed to the patents and, therefore, had no reason to expect that the patent would be enforced against it. Ex-2011 at 21; *see also* Ex-1030 at 21 (Samsung’s Answer in parallel litigation in which it asserts a license defense). Rather, the facts here are analogous to those in *Globus Medical, Inc. v. Spinelogik, Inc.*, IPR2025-00226, Paper 8 (PTAB Jun. 12, 2025), in which the Director found discretionary denial was not appropriate because petitioner “persuasively argue[d] that the challenged patent expired almost four years ago due to non-payment of maintenance fees, and, accordingly, it *expected nonenforcement of the challenged patent.*” *Id.* at 2 (emphasis added). Here, as in *Globus Medical*, Samsung had an expectation of non-enforcement because of previous licenses with Toshiba and Ericsson—the entities through which PO obtained this and the other patents asserted in the parallel litigation.

C. Samsung’s Claim Construction Positions are Consistent

While PO accuses Samsung of having taken inconsistent claim construction positions in the Petition and in the parallel litigation (Request at 16-17), it fails to

identify any example much less explain how. The Board has long held that it construes claims only to the extent necessary to resolve a controversy. *See e.g., Comcast Cable Comms., LLC v. Rovi Guides, Inc.*, Paper 8 at 17 (PTAB Nov. 7, 2017) (“[O]nly those terms which are in controversy need to be construed and only to the extent necessary to resolve the controversy”) (citing *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017)); *Abbott Labs v. Miracor Medical SA*, Paper 13 at 11-12 (PTAB Jun. 11, 2025) (same).

As Samsung explained in the Petition, “[g]iven the close correlation and substantial identity between the prior art references and the challenged claims, [Samsung] believes that no express constructions of the claims are necessary to assess whether the prior art reads on the challenged claims. Thus, the claims should be given their plain and ordinary meaning.” Petition at 7. Samsung also expressly reserved the right to raise claim construction positions in the parallel litigation because “comparing the claims to the accused products in the litigation may raise controversies that require construction of certain claim terms.” *Id.*, n.2. PO has not explained why any of this is improper.

PO’s reliance on *Cambridge Mobile* is also misplaced. Request at 17 (citing *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 at 6-9 (December 13, 2024) (informative)). *Cambridge Mobile* is directed to the specific situation where a petition takes contradictory positions with respect to terms

potentially written in means-plus-function format and violates the requirement to identify structure disclosed in the specification for performing function recited in means-plus-function format. *See* 37 C.F.R. § 42.104(b)(3); *Cambridge Mobile*, IPR2024-00952, Paper 12 at 6-9. There are no such terms in the '348 patent.

IV. THE PROCESS MEMORANDUM VIOLATES THE ADMINISTRATIVE PROCEDURES ACT

Samsung respectfully submits that the Process Memorandum violates the Administrative Procedures Act (“APA”). *First*, as binding agency policy that affects private interest, the Process Memorandum is a substantive rule that had to be promulgated through notice-and-comment rulemaking. *Mendoza v. Perez*, 754 F.3d 1002, 1020 (D.C. Cir. 2014). *Second*, the Process Memorandum exceeds the Director’s authority and violates the AIA. Nothing in the AIA authorizes the Director to deny IPR petitions based on the factors referenced in the Process Memorandum. *Third*, the factors and considerations identified in the Process Memorandum are arbitrary and capricious. Application of the *Fintiv* factors has led to unpredictable disparities among similarly situated IPR petitioners because of the uncertainty and malleability of the factors. The Process Memorandum worsens the problem by introducing several additional unpredictable and malleable factors, and improperly applies these new factors retroactively to already-filed petitions such as this one. *Fourth*, discretionary denial for any basis other than as authorized in 35

U.S.C. §314(a) is unauthorized. The Director does not have absolute discretion regarding whether to institute IPR; that discretion is limited to the bases authorized in 35 U.S.C. §314.¹²

V. CONCLUSION

For the foregoing reasons, Samsung respectfully request that the Director decline to exercise discretion to deny institution and let the panel decide whether to institute based on the merits of the Petition.

Date: June 23, 2025

Respectfully submitted,

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¹² The Office's discretionary denial practices are currently being challenged in *Apple Inc. v. Stewart*, No. 24-1864 (Fed. Cir. May 17, 2024). Petitioners respectfully request the benefit of any relief that may be granted in that appeal or other challenges to the Office's discretionary denial practices.

CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that the foregoing Petitioners' Opposition to Request for Discretionary Denial of Institution contains 6,085 words, excluding those portions identified in 37 C.F.R. §42.24(a), as measured by the word-processing system used to prepare this paper.

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Counsel for Petitioners

CERTIFICATE OF SERVICE

I certify that on June 23, 2025, I caused a true and correct copy of the foregoing Petitioners' Opposition to Patent Owner's Request for Discretionary Denial of Institution and supporting exhibits to be served via electronic mail in their entirety on the following:

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