

IPR2025-00639
Patent No. 9,122,965

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

ICASHE, INC.,

Patent Owner.

Case IPR2025-00639

Patent No. 9,122,965

**PATENT OWNER'S UNOPPOSED MOTION TO EXCUSE LATE FILING
AND SERVICE OF PATENT OWNER'S PRELIMINARY RESPONSE**

PATENT OWNER'S EXHIBIT LIST

Ex. 2001	Complaint for Patent Infringement, <i>iCashe, Inc. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.</i> , Civil Action No. 2:24-cv-00429, Dkt. 1 (June 6, 2024)
Ex. 2002	Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.'s Answer and Defenses to Plaintiff's Complaint for Patent Infringement, <i>iCashe, Inc. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.</i> , Civil Action No. 2:24-cv-00429, Dkt. 25 (October 1, 2024)
Ex. 2003	Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.'s Invalidity Contentions, <i>iCashe, Inc. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.</i> , Civil Action No. 2:24-cv-00429, (November 20, 2024)
Ex. 2004	Order, <i>iCashe, Inc. v. Samsung Electronics Co., Ltd. and Samsung Electronics America</i> , Civil Action No. 2:24-cv-00429, Dkt. 38 (May 1, 2025)
Ex. 2005	Affidavit of Service of Complaint, <i>iCashe, Inc. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.</i> , Civil Action No. 2:24-cv-00429, Dkt. 11 (June 17, 2024)
Ex. 2006	Plaintiff iCashe, Inc.'s Notice of P.R. 3-1 Disclosures and P.R. 3-2 Production, <i>iCashe, Inc. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.</i> , Civil Action No. 2:24-cv-00429, Dkt. 16 (September 5, 2024)
Ex. 2007	Notice of Compliance, <i>iCashe, Inc. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.</i> , Civil Action No. 2:24-cv-00429, Dkt. 36 (November 20, 2024)
Ex. 2008	Defendants' Ineligibility Contentions, <i>iCashe, Inc. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.</i> , Civil Action No. 2:24-cv-00429, (November 20, 2024)
Ex. 2009	United States Patent No. 8,451,122 (Narendra)

Ex. 2010	United States Design Patent No. D736,213 (Kang)
Ex. 2011	United States Design Patent No. D736, 212 (Kang)
Ex. 2012	United States Design Patent No. D736,216 (Kang)
Ex. 2013	United States Design Patent No. D739,856 (Kang)
Ex. 2014	United States Design Patent No. D772,232 (Cho)
Ex. 2015	United States Design Patent No. D773,467 (Cho)
Ex. 2016	Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.’s Invalidity Contentions, Exhibits A-A5, <i>iCashe, Inc. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.</i> , Civil Action No. 2:24-cv-00429, (November 20, 2024)
Exs. 2017 – 2022	<i>Reserved</i>
Ex. 2023	Defendants’ Invalidity Contentions, Exhibits H, <i>iCashe, Inc. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.</i> , Civil Action No. 2:24-cv-00429, (November 20, 2024)
Ex. 2024	Defendants’ Ineligibility Contentions, Appendix A, <i>iCashe, Inc. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.</i> , Civil Action No. 2:24-cv-00429, (November 20, 2024)
Exs. 2025 – 2030	<i>Reserved</i>
Ex. 2031	Declaration of Marc E. Levitt, Ph.D.
Ex. 2032	<i>P5CN072 Secure Dual Interface PKI Smart Card Controller – Short Form Specification</i> , Rev. 1.0 (Mar. 9, 2005)
Ex. 2033	<i>PN532/CI Near Field Communication (NFC) controller – Product short data sheet</i> , Rev. 3.2 (Sept. 20, 2012)
Ex. 2034	Declaration of Jessica L. Gutierrez

Patent Owner iCashe, Inc. respectfully submits this unopposed motion requesting that the Board (1) excuse the late filing and service of its Patent Owner Preliminary Response (Paper 9, “POPR”) and exhibits (Exs. 2031,¹ 2032, 2033), and (2) grant leave to file a corrected certificate of service.

I. Statement of Material Facts

1. Patent Owner’s deadline for submitting its POPR in this proceeding (“-639”) and POPRs in six related proceedings (“-640,” “-641,” “-642,” “-643,” “-644,” “-645”) was July 16, 2025. *See* Paper 5; Ex. 2034 (Gutierrez Decl.) at ¶ 3.

2. Patent Owner’s counsel worked throughout the day on July 16 preparing for the filing of POPRs, supporting expert declarations, and other exhibits, across all seven proceedings. Ex. 2034 at ¶ 4. Despite the volume of submissions, Patent Owner’s counsel believed throughout the day that they had allocated sufficient time to finalize and file all POPRs and exhibits. *Id.*

3. The POPRs and exhibits for three of the proceedings, -642, -643, and -644, were substantively completed by the afternoon of July 16. *Id.* at ¶ 5. The POPR and exhibits for the -640 proceeding were substantively completed shortly after. *Id.* When these POPRs and exhibits were near filing-ready, Patent Owner’s counsel shifted attention to finalizing the other three POPRs and exhibits. *Id.*

¹ Patent Owner acknowledges that Ex. 2031 is not labeled in accordance with 37 C.F.R. § 42.63 and will take the appropriate steps to file a replacement.

4. The finalization of the other three POPRs and exhibits took significantly more time than Patent Owner's counsel anticipated. *Id.* at ¶ 6. In finalizing the other three POPRs and accompanying exhibits, Patent Owner's counsel encountered unanticipated issues, in the form of corrections and modifications needing to be carried across multiple POPRs. *Id.* These issues also necessitated changes to expert declarations and citations thereto in the POPRs. *Id.*

5. Despite Patent Owner's counsel's best efforts, the finalization process left counsel with insufficient time to file all POPRs and supporting materials across six of the seven proceedings, including this proceeding, before midnight. *Id.* at ¶ 7.

6. Patent Owner filed its POPRs across all proceedings in series, starting with the on-time filing of the POPR in IPR2025-00643 on July 16, 2025 at 11:37 p.m. EDT. *Id.* at ¶¶ 8-9. Patent Owner filed the remaining six POPRs between 12:01 a.m. and 12:26 a.m. EDT. *Id.* at ¶ 9 (detailing filing times). The POPR and supporting materials in this proceeding were filed at **12:26 a.m. EDT** on July 17, 27 minutes after the 11:59 p.m. EDT deadline. *Id.* at ¶¶ 9-10. After filing, Patent Owner served all POPRs and exhibits on Petitioners at **1:19 a.m. EDT**. *Id.* at ¶ 11.

7. Although six of the POPRs were filed after midnight on July 17, all seven POPRs were substantively completed before the filing deadline. *Id.* at ¶ 12.

8. Petitioners do not oppose the relief requested. *Id.* at ¶ 13.

II. The Board Should Excuse Patent Owner’s Late Filing and Service of Its Patent Owner Preliminary Response in the Interests of Justice

“A late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.” 37 C.F.R. § 42.5(c)(3). Here, whether Patent Owner’s explanation constitutes good cause, the interests of justice support excusing Patent Owner’s late filing / service.

The Board considers three factors in deciding whether the interests of justice would be served by excusing a patent owner’s delayed filing: (1) prejudice to the petitioner, (2) prejudice to the patent owner, and (3) the Board and Director’s opportunity to consider the merits of the patent owner’s arguments before institution. *Formlabs Inc. v. Envisiontec, Inc.*, No. IPR2017-01258, 2017 WL 4315229, at *1-2 (PTAB Sept. 22, 2017) (accepting POPR filed one day late); *see also Aylo Freesites Ltd. v. Dish Tech. LLC*, No. IPR2024-00512, 2024 WL 3799924, at *1 n.1 (PTAB Aug. 13, 2024) (accepting three-day-late preliminary sur-reply); *Volkswagen Grp. of Am., Inc. v. Michigan Motor Techs. LLC*, No. IPR2020-00226, 2020 WL 3125342, at *2 (PTAB June 12, 2020) (accepting week-late sur-reply). Here, all factors support excusing Patent Owner’s late filing.

First, Petitioners have not suffered any prejudice as a result of Patent Owner’s delay. In the absence of a responsive pleading, the Board finds minimal prejudice to the petitioner. *Formlabs Inc.*, 2017 WL 4315229, at *2 n.1 (“It is not

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clear that there is any prejudice to Petitioner at all stemming from the one-day delay in filing the Preliminary Response, because Petitioner does not have a right to respond to the Preliminary Response.”); *Volkswagen Grp. of Am., Inc.*, 2020 WL 3125342, at *2. Here, Petitioners do not have a response by right to the POPR and therefore, are not prejudiced by the delayed filing. Additionally, Patent Owner’s delay of less than one hour does not cause significant prejudice. *See, e.g., Axis Communc’ns AB v. Aviglon Fortress Corp.*, No. IPR2019-00235, 2019 WL 1096605, at *1 (PTAB Mar. 7, 2019) (“Given that the delay in filing was less than 10 minutes, the prejudice to Petitioner, if any . . . would be slight.”). Petitioners assert no prejudice and do not oppose the relief requested. This factor supports excusing Patent Owner’s late filing.

Second, striking Patent Owner’s POPR and exhibits would significantly prejudice Patent Owner by eliminating Patent Owner’s opportunity to fully argue against institution. *Formlabs Inc.*, 2017 WL 4315229, at *2 n.1 (noting that striking late-filed POPR would significantly prejudice patent owner); *Axis Communc’ns AB v. Aviglon Fortress Corp.*, 2019 WL 1096605, at *1 (same); *Ely Holdings Ltd. v. O’Keeffe*, No. PGR2019-00025, 2019 WL 3227001, at *2 (PTAB July 17, 2019) (same). Even though Patent Owner has already presented arguments supporting discretionary denial of institution, (*see* Paper 7), the merits are also relevant to discretionary denial. *Apple v. Fintiv*, No. IPR2020-00019, 2020 WL

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2126495, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential); Stewart, *Memorandum on Interim Processes for PTAB Workload Management*, 2 (March 26, 2025) (establishing relevance of “strength of the unpatentability challenge”); FAQ 25, *FAQs for Interim Processes for PTAB Workload Management*, United States Patent Office (<https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>) (“[T]he Director will consider the merits arguments made in the petition and the POPR when relevant to the discretion determination.”). Patent Owner would be significantly prejudiced if unable to address the merits of the Petition prior to any discretionary denial or institution decision. This factor supports excusing Patent Owner’s late filing.

Third, the Director and the Board would benefit from a full record on which to decide institution. *Formlabs Inc.*, 2017 WL 4315229, at *2; *see also, e.g., Axis Communc’ns AB*, 2019 WL 1096605, at *1 (“Institution decisions that consider Patent Owner’s arguments will benefit both parties by providing clarity as to the Board’s view of the evidence and arguments.”). Striking the POPR and exhibits would also leave the Director with an incomplete record for deciding discretionary denial. This factor thus supports excusing the late filing.

CONCLUSION

For the above reasons, Patent Owner respectfully requests the Board excuse Patent Owner’s late filing and grant leave to file an amended certificate of service.

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Dated: July 25, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Patent Owner's Unopposed Motion to Excuse Late Filing and Service of Patent Owner's Preliminary Response was served on July 25, 2025, by electronic mail to Petitioners' counsel at the following addresses indicated in Petitioners' Mandatory Notices:

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