

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 IPR2025-00640
U.S. Patent No. 9,483,722

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

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EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001*	U.S. Patent No. 9,483,722 (“722”)
1002*	File History of U.S. Application No. 14/517,575 (“722FH”)
1003*	Declaration of Emmanouil Tentzeris in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent. No. 9,483,722 (“Tentzeris Decl.”)
1004	U.S. Patent App. Pub. No. 2010/0112941 (“Bangs”)
1005	U.S. Patent App. Pub. No. 2009/0040022 (“Finkenzeller”)
1006	U.S. Patent App. Pub. No. 2009/0215489 (“Kerdraon”)
1007	U.S. Patent App. Pub. No. 2008/0073426 (“Koh”)
1008	U.S. Patent App. Pub. No. 2007/0156436 (“Fisher”)
1009	File History for U.S. Patent Application No. 12/188,346 (“346 Application File History”)
1010 - 1013	<i>Reserved</i>
1014*	Plaintiff iCashe’s Infringement Contentions, Including Exhibit B
1015	Dachs, C., NFC — The Intuitive Contactless Technology Becomes Reality, 122 E&I Elektrotechnik und Informationstechnik 466 (Dec. 1, 2005) (“Dachs”)
1016	<i>Reserved</i>
1017	U.S. Patent App. Pub. No. 2005/0224589 (“Park”)
1018	U.S. Patent No. 8,260,199 (“Kowalski”)
1019 - 1022	<i>Reserved</i>
1023	U.S. Patent No. 5,943,624 (“Fox”)
1024 - 1025	<i>Reserved</i>

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Exhibit No.	DESCRIPTION
1026	U.S. Patent App. Pub. No. 2008/0235796 (“Buhr”)
1027	Finkenzeller, K., RFID Handbook, First Edition (“Finkenzeller-RFID”)
1028	Goldweber Declaration for Ex. 1027
1029 - 1030	<i>Reserved</i>
1031	U.S. Patent App. Pub. No. 2004/0133787 (“Doughty”)
1032 - 1035	<i>Reserved</i>
1036	Mayes, K. et al., Smart Cards, Tokens, Security and Applications (December 11, 2007)
1037-1049	<i>Reserved</i>
1050	Docket Control Order, <i>iCashe, Inc. v. Samsung Electronics Co.</i> , No. 2:24-cv-00429-JRG (E.D. Tex.)
1051	Docket Control Order, <i>Valtrus Innovations Ltd. v. NTT Data Services, LLC</i> , No. 2:24-cv-00361, (E.D. Tex.)
1052	Docket Control Order, <i>Fleet Connect Solutions LLC v. The Kroger Co.</i> , No. 2:24-cv-00430 (E.D. Tex.)
1053	Docket Control Order, <i>C47 Technologies LLC v. TCL Technology Group Corporation f/k/a TCL Corporation</i> , No. 2:24-cv-00417 (E.D. Tex.)
1054	Docket Control Order, <i>SiOnyx, LLC v. Samsung Electronics, Co., Ltd.</i> , No. 2:24-cv-00408 (E.D. Tex.)
1055	Docket Control Order, <i>Stingray IP Solutions LLC v. Allegion Public Limited Company</i> , No. 2:24-cv-00396 (E.D. Tex.)
1056	Docket Control Order, <i>ElectraLED, Inc. v. Astera LED Technology GmbH</i> , No. 2:24-cv-00512 (E.D. Tex.)
1057	Docket Control Order, <i>Alto Dynamics, LLC v. Fresha.com SV Ltd.</i> , 2:24-cv-00468 (E.D. Tex.)
1058	Docket Control Order, <i>Cloud Byte LLC v. Dell Inc.</i> , No. 2:24-cv-00637 (E.D. Tex.)
1059	September 20, 2024 Production Letter in <i>iCashe, Inc. v. Samsung Electronics Co.</i> , No. 2:24-cv-00429-JRG (E.D. Tex.)

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Exhibit No.	DESCRIPTION
1060	December 12, 2024 Production Letter in <i>iCashe, Inc. v. Samsung Electronics Co.</i> , No. 2:24-cv-00429-JRG (E.D. Tex.)
1061*	Declaration of Cheryl Sloane in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,483,722
1062*	Petitioners' Offered Stipulation
1063	Complaint, <i>iCashe, Inc. v. Samsung Electronics Co.</i> , No. 2:24-cv-00429-JRG, Dkt. 1 (E.D. Tex.)
1064	Samsung Mobile Payment Service – Samsung Pay, Available Starting Today in the U.S., Samsung Press Release (September 28, 2015) (https://news.samsung.com/global/samsung-mobile-payment-service-samsung-pay-available-starting-today-in-the-u-s)
1065	Samsung Announces Launch Dates for Groundbreaking Mobile Payment Service: Samsung Pay, Samsung Press Release (August 14, 2015) (https://news.samsung.com/global/samsung-announces-launch-dates-for-groundbreaking-mobile-payment-service-samsung-pay)
1066	<i>Multimedia Techs. PTE Ltd. v. LG Elecs. Inc.</i> , et al., 2:22-cv-00494-JRG-RSP, Dkt. 273 (E.D. Tex. Mar. 18, 2025)
1067	Judge Rodney Gilstrap (E.D. Tex.) Case Calendar for April 6, 2026 as of July 12, 2025
1068	Order Denying Without Prejudice to Refile Motion to Stay Pending IPRs, <i>iCashe, Inc. v. Samsung Electronics Co.</i> , No. 2:24-cv-00429-JRG, Dkt. 38 (E.D. Tex.)
1069	Petition, <i>Cisco Sys., Inc. v. Lionra Techs. Ltd.</i> , IPR2024-01281, Pap. 2
1070	File History of U.S. Patent No. 11,694,053
1071	Comparison of U.S. Patent Application No. 13/038,341 to U.S. Patent Application No. 12/188,346
Petitioners have used the same exhibit number to refer to the same document across IPR2025-00639, -00640, and -00641, except for those exhibits designated by an *, which indicates that the exhibit is unique to each IPR proceeding.	

TABLE OF ABBREVIATIONS

Abbreviation	DESCRIPTION
'722	U.S. Patent No. 9,483,722 (Ex. 1001)
IPR	<i>Inter Partes</i> Review
Petitioners, Samsung	Petitioners Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc.
PO	Patent Owner
POSITA	Person of Ordinary Skill in the Art
PTAB	Patent Trial and Appeal Board
USPTO	United States Patent and Trademark Office
Pet.	Petition, Paper No. 2
Br.	Patent Owner's Memorandum in Support of Discretionary Denial, Paper No. 7

I. INTRODUCTION

Discretionary denial is not warranted under § 314(a). This IPR is part of a group of challenges against seven patents that were asserted against Petitioners (“Samsung”) in district court: IPR2025-00639 (U.S. Patent No. 9,122,965); IPR2025-00640 (U.S. Patent No. 9,483,722); IPR2025-00641 (U.S. Patent No. 11,694,053); IPR2025-00642 (U.S. Patent No. 8,403,219); IPR2025-00643 (U.S. Patent No. 9,202,156); IPR2025-00644 (U.S. Patent No. 9,208,423); IPR2025-00645 (U.S. Patent No. 11,270,174). The *Fintiv* factors do not support denial and are at most neutral.

Five of the seven patents that Patent Owner (“PO”) asserted against Samsung (including the ’722) issued between 2013 and 2016, but PO waited until 2024 to assert the patents. As the Acting Director recently noted, “a patent may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner’s particular technology space, if at all. These non-exclusive examples provide considerations that weigh against a patent owner’s claim of settled expectations and bears on the Director’s discretion.” *Intel Corp. v. Proxense, LLC*, IPR2025-00327, Paper 12 at 2-3 (P.T.A.B. June 26, 2025). The remaining two patents recently issued in 2022 and 2023—further demonstrating that there cannot have been settled expectations as to any of the asserted patents.

Samsung instead had strong settled expectations of non-assertion given that

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PO and its predecessors waited the better part of a decade to assert this family of patents against Samsung—or anyone at all. For example, the '219 patent issued in 2013, and the '965 patent issued in 2015—the same year the accused functionalities in Samsung's patents were launched. But neither PO nor its predecessors asserted the patents until the present litigation was filed in 2024. Even if Samsung's products infringed (they do not), Samsung had settled expectations that it did not need to challenge these patents because PO and predecessor owners of the patents did not assert them against Samsung or any other entity until a decade later.

Tellingly, PO's brief does not even attempt to dispute—or discuss at all—the *merits* of Samsung's Petition. This is because Samsung's Petition has compelling merits, including anticipation grounds that were not considered during prosecution, that make discretionary denial inappropriate in this case. Furthermore, the primary reference in the Petition (Finkenzeller) teaches the limitation the Examiner believed was missing from the prior art during prosecution.

Moreover, the risk of duplicative efforts between these proceedings and the parallel district court litigation is low. Samsung agreed to a broad super-*Sotera* stipulation, eliminating any possibility of overlap between the art raised in the IPRs and the district court proceeding should the Board institute review. Samsung's original motion to stay the district court case was denied without prejudice as “premature,” but Samsung intends to promptly renew its motion upon institution,

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which is expected to occur before the court's *Markman* hearing. Consistent with the court's practice, it is expected that if the IPRs are instituted, the stay will be granted. In addition to that *Markman* hearing and nearly all claim construction briefing, there is substantial work to be done in the district court, including extensive fact discovery, contention interrogatory responses, third party discovery, fact depositions, all of expert discovery, and dispositive motions. Further, there is no guarantee that the trial date will hold given the likelihood the district court will grant a stay, postponing the trial, and that there are six other trials set on the same date as the trial involving PO and Samsung.

The filing of these petitions was further delayed as a result of PO's disclosures during discovery in the district court litigation and PO's misrepresentations concerning the alleged priority dates of at least one of the patents. During discovery PO contended that the named inventors of the challenged patents had conceived of the alleged inventions well before the effective filing date. These issues needed to be investigated before prior art could be selected for the challenges. In addition, for the '053 patent (one of the seven patents asserted), PO wrongly asserted that the application was a continuation instead of a continuation-in-part, shifting the effective filing date by three years. This caused the original Examiner to overlook intervening prior art, including art Samsung relies upon in IPR2025-00641. Discovery of this misrepresentation required Samsung to further investigate all

forty-nine priority claims across the seven asserted patents before selecting prior art and filing its IPRs.

Further, PO's argument that Samsung's petitions should be denied because they rely on extensive expert testimony is flawed—PO ignores the Petitions' extensive reliance on the prior art. PO does not identify any limitation of the asserted patents where Samsung has used expert testimony to fill gaps in the prior art disclosures. Rather, Samsung's expert provides detailed analysis to assist the Board with its analysis.

For these reasons, discretionary denial is not warranted under § 314(a).

II. DISCRETIONARY DENIAL IS NOT WARRANTED

Co-pending district court litigation in the United States District Court for the Eastern District of Texas does not warrant the exercise of discretion under § 314(a). *See Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (designated precedential) ("*Fintiv*"). Nearly all of the *Fintiv* factors, enumerated below, do not support discretionary denial. *Id.* at 5-6.

A. Patent Owner Delayed Asserting the Challenged Patents for Nearly a Decade

PO's settled expectations argument is unavailing. As a threshold matter, Samsung had no reason or need to challenge the asserted patents because it did not and does not use the claimed technology. Nevertheless, Samsung would have had settled expectations that PO had no interest in or intent to enforce the asserted

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patents.

Five of the seven patents that PO asserted against Samsung (including the patent challenged here) issued between 2013 and 2016: U.S. Patent Nos. 8,403,219; 9,122,965; 9,202,156; 9,208,423; and 9,483,722. The remaining two asserted patents (U.S. Patent Nos. 11,694,053 and 11,270,174) issued in 2022 and 2023, respectively. However, PO waited until 2024 to assert any of these patents. Thus, because five of the patents were not asserted for almost a decade and the remaining two only recently issued, there cannot have been settled expectations that the patents would be enforced. *Intel*, IPR2025-00327, Paper 12 at 2-3.

Instead, Samsung's accused products have been on the market since 2015. *See* Ex. 1063 at 8-11 (Complaint accusing Samsung's mobile payment functionality); Exs. 1064 and 1065 (Samsung launching mobile payment functionality in 2015). But neither PO nor its predecessors asserted the patents until the present litigation was filed in 2024. Accordingly, Samsung reasonably expected non-assertion of the challenged patent. *Intel*, IPR2025-00327, Paper 12 at 2-3. PO's inaction not only caused settled expectations of non-assertion, but also undermines PO's own arguments. PO's failure to assert its patents for over ten years cuts against PO's claims of settled expectations.

PO argues that Samsung could have theoretically challenged the asserted patents earlier, because one of the priority applications was cited as prior art to a set

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of Samsung design patent applications directed to the ornamental design of memory cards.¹ Br. 15-16. But the asserted patents were never cited, and PO makes no attempt to compare the scope of the claims of the identified application to the claims of the asserted patents. Even if it had, the fact that the asserted patents disclose a memory card has no relevance to the challenged claims, which are directed to a mobile device and do not recite a memory card. Further, PO's logic is untenable, as it would have obligated Samsung in 2015 to file IPRs not only on each of the 113 patents cited by the examiner in prosecution of a single design patent, but also on each of the patents related to those 113 patents—and the identified '122 patent alone had 15 related patents. PO's logic would have inundated the Board with a flood of unnecessary IPR petitions, running counter to the goals to “improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, [and] reduce pendency in *ex parte* appeals.” Acting Director Stewart's March 26, 2025 Memorandum titled “Interim Processes for PTAB Workload Management”

¹ PO's cited case *iRhythm* is inapposite—there, the asserted patent itself was disclosed by the applicant to the USPTO, but here, a different patent was one of 113 patents and applications cited by the examiner in a design patent application. *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (P.T.A.B. June 6, 2025).

(“Stewart Memorandum”) at 3. As such, discretionary denial is inappropriate.

B. The Merits of the Petition are Compelling

The merits of Samsung's petition—which PO, tellingly, ignores in its brief—are compelling and further weigh against discretionary denial. As explained in the Petition, Finkenzeller, the primary reference in the Petition, anticipates all claims and at minimum renders them obvious. Finkenzeller as well as the other references relied upon in the Grounds were not cited in an IDS or otherwise identified by the Examiner, or applied to reject claims during '722's prosecution. Indeed, Finkenzeller teaches the claimed concept that the Examiner believed was missing from the prior art, e.g.: “the mobile device including transmit circuitry separate from the load modulation circuitry in the smartcard controller.” *See, e.g.*, Pet. § V.B.1 ('722 Prosecution). For example, Finkenzeller discloses a mobile device (e.g., “mobile terminal”) that includes transmit circuitry (e.g., “transmit branch” circuits outside of “RFID chip CL”) that is separate from the “load modulation” circuitry used in a smartcard controller (“parallel resistor” for “load modulation” inside “RFID chip CL,” which is a “smart card chip”). *See, e.g.*, Pet. § IX ([1.pre], [1.a], [1.c3]); Finkenzeller, [0028]-[0031], [0042], [062], [0106]-[0108], [0110], [0112]-[0113], [0115], Fig. 9; '722, 8:56-9:6.

C. The District Court Trial Date Does Not Support Discretionary Denial

Even if the district court's trial date weighs somewhat in favor of exercising

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discretion, it does not outweigh the other factors, which collectively weigh in favor of the Board not exercising discretion to deny institution. Samsung acknowledges that a trial date in the parallel litigation is presently scheduled approximately five months prior to an expected date of a Final Written Decision in this proceeding. However, trial dates in this district court are routinely delayed for various reasons. *See, e.g.,* Ex. 1066, Joint Mot. for Preferential Trial Setting, *Multimedia Techs. PTE Ltd. v. LG Elecs. Inc., et al.*, 2:22-cv-00494-JRG-RSP (E.D. Tex. Mar. 18, 2025) Dkt. 273 (stating that “[t]his case has been set for trial five times: November 18, 2024, January 27, 2025, February 7, 2025, March 3, 2025, and March 17, 2025 ... The parties have also been notified that other cases are preferentially set ahead of them for the April 7, 2025 and April 21, 2025 trial settings.”).

In this regard, although trial is currently set for April 6, 2026, Samsung expects the district court litigation to be delayed because six other active cases are also scheduled for trial on that same date. Ex. 1067; *see BOE Tech. Grp. Co. v. Optronix Scis. LLC*, No. IPR2024-01130, 2025 WL 305477, at *4 (P.T.A.B. Jan. 27, 2025) (*Fintiv* factor 2 “neutral or weigh[s] slightly in favor of not exercising discretion” where Judge Gilstrap “set 10 cases for jury selection on the same day”). Furthermore, the trial date is likely to be delayed given the likelihood the district court will grant Samsung’s renewed motion to stay if the Board grants institution. *See* Section 2 *infra*. Indeed, Judge Gilstrap has a practice of staying cases with

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pending IPRs where, as here, the Board's deadline for institution is before the court's scheduled *Markman* hearing, making it even more likely that the April 6, 2026 trial date will be postponed. *See, e.g., Broadphone LLC v. Samsung Elecs. Co.*, No. 2:23-CV-00001-JRG-RSP, 2024 WL 3524022, at *2-3 (E.D. Tex. July 24, 2024) (granting stay prior to *Markman*); *Cywee Grp. Ltd. v. Samsung Elecs. Co.*, No. 17-CV-00140, 2019 WL 11023976, at *6-7 (E.D. Tex. Feb. 14, 2019) (granting stay three months prior to scheduled trial date).

Moreover, as PO itself explained (Br. 6 n.2), this factor still “must be balanced” against other factors, including the existence of a petitioner stipulation (*Fintiv* factor 4) and the merits of the petition (*Fintiv* factor 6). *Samsung Display Co. v. Pictiva Displays Int'l Ltd.*, IPR2024-01222, Paper 12 at 6, 9 (P.T.A.B. Mar. 6, 2025) (post-rescission) (deciding not to exercise discretionary denial even though trial date preceded the expected final written decision date by seven months, in view of other factors); *see also Posco Co. v. Arcelormittal*, IPR2024-01376, Paper 11 at 13-14, 17 (P.T.A.B. Mar. 18, 2025) (post-rescission) (deciding not to exercise discretionary denial even though trial date preceded the expected final written decision date by five months, in view of other factors); *Palo Alto Networks, Inc. v. Croga Innovations Ltd.*, IPR2024-01421, Paper 8 at 11, 13-14 (P.T.A.B. Mar. 14, 2025) (post-rescission) (deciding not to exercise discretionary denial even though the trial date preceded the expected final written decision date by five months, in

view of other factors). As such, even if the district court's trial date is not moved, the scheduled trial date does not outweigh the considerations in the other factors, which on balance favor the Board not exercising its discretion.

D. The District Court Is Likely to Grant a Renewed Motion to Stay

The likelihood the district court will grant a stay weighs against discretionary denial. *Fintiv* factor 1 (“whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted”) weighs against exercising discretion in cases where there is no stay but “the district court has denied a motion for stay without prejudice and indicated to the parties that it will consider a renewed motion ... to stay if a PTAB trial is instituted.” *Fintiv*, Paper 11 at 6-7. Here, the district court denied Samsung's pre-institution motion without prejudice, stating that the motion was “premature.” Ex. 1068. Samsung is free—and intends—to renew its motion to stay if the Board institutes IPR. Indeed, in the past, this district court has weighed a pre-institution motion to stay followed by a prompt renewal of that motion after institution *in favor* of granting a stay. *e-Watch Inc. v. Apple, Inc.*, No. 2:13-cv-1061-JRG-RSP, 2015 WL 12915668, at *3 (E.D. Tex. Mar. 25, 2015) (holding that the timing of the defendant's earlier motion to stay weighs in favor of granting the defendant's “promptly renewed” motion to stay after institution).

Moreover, a renewed motion to stay is likely to be granted in view of the amount and type of work already completed in the parallel litigation by the court and

the parties at the time of the institution. *Fintiv*, Paper 11 at 9. “If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.” *Fintiv*, Paper 11 at 10 (discussing *Fintiv* factor 3). Here, the district court has not made a single substantive ruling regarding the asserted patents. This factor therefore weighs against discretionary denial for this reason alone.

Furthermore, the parties have barely started claim construction—they just yesterday exchanged preliminary claim constructions, and have yet to complete claim construction discovery, or file any claim construction briefs. Critically, *Markman* is scheduled for October 28, 2025—nearly two weeks *after* the Board's institution deadline. This district court, and Judge Gilstrap in particular, frequently stays proceedings post-institution when the court has not yet conducted a *Markman* hearing. *See, e.g., Broadphone*, 2024 WL 3524022, at *2-3 (granting stay prior to *Markman*); *Cywee Grp.*, 2019 WL 11023976, at *6-7 (granting stay three months prior to scheduled trial date).

Likewise, the close of fact discovery is four months away and the close of expert discovery over five months away, no fact deposition nor expert deposition has been taken or scheduled, and no case-dispositive motions have been filed (the deadline to do so is not until January 5, 2026). There is still substantial work to be done in the district court case following the Board's institution decision, which

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weighs in favor of a stay.

Indeed, the district court has granted stays in cases that have advanced far beyond that of the instant case. *See SSL Servs., LLC v. Cisco Sys., Inc*, 5-cv-433, 2016 WL 3523871, at *2 (E.D. Tex. June 28, 2016) (granting a stay even though the case was at “a relatively late stage” in which claim construction had taken place and trial was less than three months away, in part because “this case is not yet on the eve of trial...”); *Stingray Music USA, Inc. v. Music Choice*, No. 16-cv-00586, 2017 WL 9885167, at *2 (E.D. Tex. Dec. 12, 2017) (granting stay where fact discovery had closed and expert reports exchanged because “a stay might still obviate the need to prepare for trial [on] some or all ... claims, thus reducing the burden ... on the parties and the Court”). Likewise, the Board has found the amount and type of work in the parallel litigation to favor institution on facts less favorable than those here. *See Samsung*, IPR2024-01222, Paper 12 at 7 (finding this factor weighs against denial, even though a *Markman* hearing has been held, in part because “much remains to be done, including expert discovery”); *see also SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01432, Paper 14 at 8-9 (P.T.A.B. Apr. 7, 2025) (this factor favored institution even after *Markman* briefing was complete).

PO's reliance on *Lionra* is misplaced. In fact, like the schedule in *Lionra*, “the bulk of this case is still in the future,” such that “this factor weighs in favor of a stay.” *Lionra Techs. Ltd. v. Cisco Sys., Inc.*, No. 2:24-cv-00097-JRG, 2025 WL

1239317, at *3 (E.D. Tex. Apr. 29, 2025). However, unlike the plaintiff in *Lionra*, Samsung has entered a broad super-*Sotera* stipulation in this case, which will simplify the issues in the parallel litigation to a far greater degree than the typical *Sotera* stipulation at issue in *Lionra*. Compare Ex. 1062 with Ex. 1069, Pet. for *Inter Partes* Review *Cisco Sys., Inc. v. Lionra Techs. Ltd.*, IPR2024-01281, Paper 2 at 70-71 (P.T.A.B. Aug. 26, 2024). Further, here, PO does not seek any injunctive relief. Ex. 1063 (Complaint) at 100. Accordingly, monetary damages and any interest will be sufficient to compensate PO for any alleged infringement. Moreover, five of the seven asserted patents-in-suit issued between 2013 and 2016, but PO waited until 2024 to assert them. As such, PO's concern with "vindicating its patent rights" falls flat when it waited between *nine and thirteen years* to assert the majority of the patents-in-suit. The lack of prejudice to PO increases the likelihood the court will grant a stay.

As such, the likelihood of a stay as well as the paucity and type of work completed in the parallel litigation weigh against discretionary denial.

E. *Inter Partes* Review Will Largely Moot the District Court Proceeding

Fintiv explains that "if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution under *NHK*."

Fintiv, Paper 11 at 12-13. Here, Samsung's stipulation extends further than typical *Sotera* stipulations. It is ironclad. Samsung has unequivocally committed that, should the Board institute review, it will not only withdraw any §§ 102 and 103 grounds it raised or could have raised in the IPR, but it will also not pursue any combinations of prior art asserted in this proceeding with any other type of prior art, including system art, thereby removing any potential overlap among the art raised in the IPR and the invalidity arguments presented to the district court. Ex. 1062. Sections 101 and 112 as well as system art are beyond the Board's statutory jurisdiction in this IPR, so they can proceed in district court without risk of duplicative effort or inconsistent rulings. Because of this stipulation, the district court and the Board will be adjudicating distinct questions, supported by distinct records, governed by distinct evidentiary standards, and tried to distinct decision-makers. The forums will not confront duplicative arguments or expert testimony, and institution would promote efficiency in the district court because the judge and jury will not have to consider hundreds of pages of evidence and hours of expert testimony on these matters.

The Board routinely finds that *Fintiv* Factor 4 weighs strongly against discretionary denial where a petitioner tenders a broad "*Sotera* stipulation" relinquishing any ability to pursue in the district court the same §§ 102 and 103 grounds it advances in the IPR because there is no meaningful overlap of issues.

Here, in light of Samsung's broad stipulation, this factor strongly weighs against discretionary denial.

F. Samsung Diligently Filed Its IPR Petitions

PO was the cause of any alleged delay in Samsung filing its Petition (which Samsung filed within the statutory deadline to do so).

First, the nature of PO's allegations necessarily forced Samsung to file when it did. PO asserted infringement of *close to 100 claims* across seven patents in the parallel litigation and accused approximately *275 products*—with accused components from at least six different chip suppliers. *See Tesla, Inc. v. Intell. Ventures, Inc.*, IPR2025-00217, Paper 9 at 2-3 (P.T.A.B. June 13, 2025) (declining to exercise discretion to deny the petition where the asserted patents were part of a “complex and diverse litigation proceeding,” as “the Board is better suited” to handle such matters). Although Samsung promptly began preparing its petitions, the sheer volume of asserted claims, patents, and accused products and components necessarily caused Samsung to file later than if PO had filed a less voluminous lawsuit. Samsung was as diligent as it could have been under the circumstances.

Second, PO's discovery responses in the corresponding district court litigation necessitated additional investigation into the correct priority date before Samsung could select art and prepare the IPRs. Prior to serving its invalidity contentions in November 2024, Samsung began requesting information from PO

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IPR2025-00640 (U.S. Patent No. 9,483,722)

related to any alleged earlier invention date. In December 2024, PO claimed an earlier conception date, which required additional investigation from Petitioner.

And third, for one of the seven patents (U.S. Patent No. 11,694,053, challenged in IPR2025-00641) asserted against Samsung, PO misrepresented its priority claim and attempted to conceal from the public that applicants had added new matter in U.S. Patent Application No. 13/038,341 (“’341 application”), to which the ’053, ’965, and ’722 patents claim priority. Specifically, the applicants of the ’053 patent misrepresented to the United States Patent and Trademark Office that the ’341 application, to which the asserted ’053 patent claims priority, is a continuation of U.S. Patent Application No. 12/188,346 (“’346 application”) rather than a continuation-in-part. Ex. 1070. Despite making this representation, the applicants of the ’341 application (filed in 2011) added new matter compared to the ’346 application (filed in 2008), causing the ’053’s effective filing date to be three years later than indicated. Ex. 1071.

This misrepresentation not only resulted in the incorrect allowance of the ’053 claims over the prior art, because the Examiner did not have the opportunity to consider intervening prior art, including the prior art identified by Samsung in its Petition for the ’053 patent, but it also delayed Samsung’s preparation and filing of the petitions for all seven asserted patents. Once Samsung discovered this misrepresentation by PO—the common assignee of all seven patents—it

investigated the forty-nine priority claims across the seven asserted patents and identified additional prior art, including certain prior art references relied upon in the '053 Petition (IPR2025-00641).

PO recently acknowledged that its prior statement with respect to the '341 application was incorrect when it requested a certificate of correction to correct this misrepresentation. Ex. 1070 at 484-500.

The time of filing should therefore not favor discretionary denial because it was PO's own conduct and lack of diligence that forced Samsung to file when it did.

G. Samsung Appropriately Relies on Expert Declarations

PO's argument that Samsung's petitions should be denied because they "[r]el[y] on [e]xtensive [e]xpert [t]estimony" is flawed and lacks any specific factual statements regarding the declaration of Samsung's expert Dr. Tentzeris. *See* Br. 13-14. Notably, PO does not identify any limitation of the asserted patents where Samsung has used expert testimony to fill gaps in the prior art disclosures. The Acting Director has found similar, lacking, arguments unpersuasive. *See iRhythm Techs.*, IPR2025-00363, Paper 10 at 2-3 (P.T.A.B. June 6, 2025) (finding that petitioner's reliance on expert to "explain the background knowledge of a person of ordinary skill in the art," with "citations to evidence in support of his statements in the required manner" weighs against discretionary denial); *Cambridge Indus. USA v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 11 at *2 (P.T.A.B. June 26,

2025) ("Patent Owner does not identify any portions of the expert testimony that suggest Petitioner is using its expert to fill gaps in the prior art.").

While PO takes issue with the conclusions of Petitioner's experts regarding the motivation to combine references, this is an issue that is fully appropriate for expert testimony, and, as PO admits, it and its experts will be free to respond to those motivation to combine arguments in its forthcoming Patent Owner Preliminary Response. Petitioner's reliance on expert testimony does nothing to tip the scales in favor of discretionary denial.

III. CONCLUSION

As demonstrated above, nearly all *Fintiv* factors are either neutral or weigh against discretionary denial and the other relevant considerations in this case further disfavor denial. Discretionary denial is therefore not warranted. Samsung requests that the Director reject PO's request for discretionary denial.

Dated: July 16, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(a) and (d), the undersigned hereby certify that Petitioners' Opposition to Patent Owner's Request for Discretionary Denial complies with the type-volume limitation of 37 C.F.R. § 42.24(a)(i) because, exclusive of the exempted portions, it contains 4,259 words as counted by the word processing program used to prepare the paper.

Dated: July 16, 2025

Respectfully submitted,

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Lead Counsel for Petitioners

CERTIFICATE OF SERVICE

I hereby certify that on July 16, 2025, I caused a true and correct copy of Petitioners' Opposition to Patent Owner's Request for Discretionary Denial and supporting exhibits to be served via electronic mail to Patent Owner's counsel listed below and at RK_iCashe@RobinsKaplan.com.

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