

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

GENGHISCOMM HOLDINGS LLC,  
Patent Owner.

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Case IPR2025-00788  
Patent No. 10,389,568

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

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**TABLE OF EXHIBITS**

<b>Exhibit No.</b>	<b>Description</b>
1001	U.S. Patent No. 10,389,568 (“’568 Patent”)
1002	Declaration of Harry Bims, Ph.D.
1003	Angela Doufexi, et al., <i>Design Considerations and Initial Physical Layer Performance Results for a Space Time Coded OFDM 4G Cellular Network</i> , In The 13th IEEE International Symposium on Personal, Indoor and Mobile Radio Communications (Vol. 1, pp. 192-196). IEEE (Sept. 18, 2002) (“Doufexi”).
1004	Dirk Galda & Hermann Rohling, <i>A Low Complexity Transmitter Structure for OFDM-FDMA Uplink Systems</i> , Vehicular Technology Conference. IEEE 55 <sup>th</sup> Vehicular Technology Conference, vol. 4, pp.1737-1741 (May 6, 2002) (“Galda”).
1005	Stefan Kaiser, <i>Multi-Carrier CDMA Mobile Radio Systems – Analysis and Optimization of Detection, Decoding, and Channel Estimation</i> , VDI-Verlag, Dusseldorf, Germany (Jan. 1998) (ISBN 3-18-353110-0) (“Kaiser”)
1006	Lucent Technologies, <i>Proposed Baseline OFDM Systems for Study</i> , 3GPP TSG-RAN1 #28 bis, R1-02-01246 (Oct. 8-9, 2002) (“Lucent”).
1007	Andres Bury & Jurgen Linder, <i>Comparison of Amplitude Distributions for Hadamard Spreading and Fourier Spreading in Multi-Carrier Code Division Multiplexing</i> , Globecom ’00-IEEE. Global Telecommunications Conference, Vol. 2, pp.857-860 (Nov. 27, 2000) (“Bury”)
1008	Kwang-Cheng Chen, et al., <i>A Programmable Architecture for OFDM-CDMA</i> , IEEE Communications Magazine, pp.76-82 (Nov. 1999) (“Chen”)
1009	RESERVED
1010	RESERVED
1011	U.S. Patent Application Publication No. 2003/0081538 to Walton et al.

<b>Exhibit No.</b>	<b>Description</b>
1012	Declaration of Sylvia Hall-Ellis, Ph.D.
1013	RESERVED
1014	RESERVED
1015	RESERVED
1016	Karsten Bruninghaus & Herman Rohling, <i>Multi-carrier spread spectrum and its relationship to single-carrier transmission</i> , Vehicular Technology Conference. IEEE 48 <sup>th</sup> Vehicular Technology Conference, vol. 3, pp.2329-2332 (May 18-21, 1998) (“Brüninghaus”).
1017	RESERVED
1018	RESERVED
1019	RESERVED
1020	RESERVED
1021	File History of U.S. Patent Application No. 11/187,107 as obtained from Patent Center (excerpts).
1022	File History of Provisional No. 60/589,187
1023	File History of U.S. Patent Application No. 10/145,854 as obtained from Patent Center (excerpts).
1024	RESERVED
1025	RESERVED
1026	RESERVED
1027	RESERVED
1028	File History of U.S. Patent Application No. 15/786,270 as obtained from Patent Center (excerpts)
1029	RESERVED
1030	File History of U.S. Patent Application No. 14/727,769 as obtained from Patent Center (excerpts)

Exhibit No.	Description
1031	File History of U.S. Patent Application No. 14/276,309 as obtained from Patent Center (excerpts)
1032	File History of U.S. Patent Application No. 12/545,572 as obtained from Patent Center (excerpts)
1033	RESERVED
1034	Declaration of Craig Bishop
1035	RESERVED
1036	File History of U.S. Patent Application No. 15/489,644 as obtained from Patent Center (excerpts)
1037	File History of U.S. Patent Application No. 15/149,382 as obtained from Patent Center (excerpts)
1038	3GPP TS 36.211 V8.8.0 (2009-09) 3 <sup>rd</sup> Generation Partnership Project; Technical Specification Group Radio Access Network; Evolved Universal Terrestrial Radio Access (E-UTRA); Physical Channels and Modulation (Release 8)
1039	Exhibit 1 to Plaintiff's P.R. 3-1(c) Infringement Contentions (U.S. Pat. No. 9,768,842)
1040	Marco Breiling, et al., <i>Peak-Power Reduction in OFDM without Explicit Side Information</i> , 5 <sup>th</sup> Int'l OFDM-Workshop 2000 (Hamburg/Germany), Sept. 2000, pp.28-1 to 28-4.
1041	RESERVED
1042	U.S. Patent No. 6,597,745 to Dowling
1043	Gerhard P. Fettweis, et al., <i>A Time Domain View to Multi-Carrier Spread Spectrum</i> , IEEE 6 <sup>th</sup> Int'l Symposium on Spread-Spectrum & Applications (ISSSTA 2000), (Sept. 6-8, 2000) (pre-print)
1044	Armin Dekorsy & Volker Kuehn, <i>Exploiting Time and Frequency Diversity by Iterative Decoding in OFDM-CDMA Systems</i> , Seamless Interconnection for Universal Services, Global Telecommunications Conference. GLOBECOM'99, Vol. 5, pp.2576-2580 (Dec. 5, 1999).

Exhibit No.	Description
1045	Volker Kuehn, et al., <i>Channel Coding Aspects in an OFDM-CDMA System</i> , ITG FACHBRICHT, pp.31-36 (Jan. 2000).
1046	Docket Control Order, <i>Genghiscomm Holdings, LLC v. Samsung Elecs., Am., Inc.</i> , No. 2:24-cv-0242-RWS-RSP, Dkt. 25 (Sept. 24, 2024).
1047	Complaint, <i>Genghiscomm Holdings, LLC v. Samsung Elecs., Am., Inc.</i> , No. 2:24-cv-0242-RWS-RSP, Dkt. 1 (Apr. 12, 2024).
1048	RESERVED
1049	Interview Agenda from U.S. Patent Application No. 16/194,290 (obtained from Patent Center)
1050	RESERVED
1051	U.S. Patent No. 6,785,258 to Garcia, Jr., et al. (“Garcia”)
1052	Jack Dongarra, et al., <i>Guest editors introduction to the top 10 algorithms</i> , <i>Computing in Science &amp; Engineering</i> 2(01) (2000), pp.22-23.
1053	U.S. Patent No. 6,263,017 to Miller
1054	U.S. Patent No. 6,175,551 to Awater et al.
1055	U.S. Patent No. 5,204,876 to Bruckert et al.
1056	3GPP TS 36.211 V8.7.0 (2009-05) 3 <sup>rd</sup> Generation Partnership Project; Technical Specification Group Radio Access Network; Evolved Universal Terrestrial Radio Access (E-UTRA); Physical Channels and Modulation (Release 8)
1057	David Astély, et al., <i>LTE: The Evolution of Mobile Broadband</i> , <i>IEEE Communications Magazine</i> , pp.44-51 (Apr. 2009).
1058	M. Rinne, et al., <i>LTE, the radio technology path towards 4G</i> , <i>Computer Communications</i> 33 (2010) pp.1984-1906 (2010)
1059	Declaration of Gary Swatzell including Exhibits A-D
1060	Guidance on USPTO’s recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with

Exhibit No.	Description
	Parallel District Court Litigation” (Mar. 24, 2025).
1061	Docket Control Order, <i>Slyde Analytics LLC v. Apple Inc.</i> , No. 2:24-cv-00331-RWS-RSP, Dkt. 46 (E.D. Tex. Sept. 23, 2024)
1062	Docket Control Order, <i>Innomemory, LLC v. Truis Financial Corp.</i> , No. 2:24-cv-00146-RWS-RSP, Dkt. 38 (E.D. Tex. Sept. 24, 2024)
1063	Docket Control Order, <i>Husky Injection Molding Systems Ltd. V. Ningbo Ao Sheng Mold Co., Ltd. D/B/A Aosimi</i> , No. 2:24-cv-00348-RWS-RSP, Dkt. 46 (E.D. Tex. Oct. 21, 2024)
1064	Docket Sheet for <i>Partec Ag, et al v. Microsoft Corporation</i> , No. 2:24-cv-00433 (downloaded Mar. 25, 2025).
1065	Combined asserted patents in <i>Genghiscomm Holdings, LLC v. Samsung Elecs., Am., Inc.</i> , No. 2:24-cv-0242-RWS-RSP, Dkt. 25 (Sept. 24, 2024).
1066	RESERVED
1067	RESERVED
1068	RESERVED
1069	RESERVED
1070	RESERVED
1071	The title page, page V, page 14, pages 32-24, pages 130-137, page 140, and page 150 of Kaiser, Stefan. <i>Multi-Carrier CDMA Mobile Radio Systems - Analysis and Optimization of Detection, Decoding, and Channel Estimation</i> . Doctoral Dissertation. Department of Computer Science and Engineering, Technische Universität München. Dusseldorf, Germany: Verein Deutscher Ingenieure (VDI) Verlag, ©1998. Obtained from the University of Mannheim Library in Mannheim Germany.
1072	RESERVED
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<b>Exhibit No.</b>	<b>Description</b>
1075	RESERVED
1076	RESERVED
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1079	Results of Docket Navigator Search for '568 Patent
1080	RESERVED
1081	RESERVED
1082	RESERVED
1083	RESERVED
1084	RESERVED
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1091	RESERVED
1092	File History of U.S. Patent Application No. 13/116,984 as obtained from Patent Center (excerpts)
1093	RESERVED
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<b>Exhibit No.</b>	<b>Description</b>
1099	RESERVED
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1104	RESERVED
1105	RESERVED
1106	RESERVED
1107	RESERVED
1108	RESERVED
1109	RESERVED
1110	RESERVED
1111	U.S. Provisional Application No. 60/422,670
1112	Articles of Incorporation for Idris Communications, Inc. (Jan. 18, 1999).
1113	Articles of Reinstatement, Idris Communications, Inc. Dissolved Sept. 23, 2004 (filed with the Colorado Secretary of State on February 24, 2023)
1114	The Way Back Machine – <a href="https://web.archive.org/web/20010517194943/http://idriscomm.com:80/">https://web.archive.org/web/20010517194943/http://idriscomm.com:80/</a> (last visited Jul. 4, 2025)
1115	Application for Authority for CIAN Systems, Inc. (Feb. 1, 2001)
1116	The Way Back Machine – <a href="https://web.archive.org/web/20011219231934/http://ciansystems.com:80/tech.html">https://web.archive.org/web/20011219231934/http://ciansystems.com:80/tech.html</a> (last visited Jul. 3, 2025)
1117	Patent Assignment between Steve Shattil and Arnold Alagar and Aquity dated Dec. 19, 2005 (Reel/Frame 018668/0704, et seq.) as

<b>Exhibit No.</b>	<b>Description</b>
	obtained from the United States Patent & Trademark Office
1118	Patent Assignment between Aquity LLC and Lot 41 Acquisition Foundation, LLC (Reel/Frame 019789/0509, et seq.)
1119	Patent Application Assignment between Steve Shattil and Arnold Alagar and Aquity dated Dec. 19, 2005 (Reel/Frame 018676/0626, et seq.) as obtained from the United States Patent & Trademark Office
1120	RESERVED
1121	RESERVED
1122	Notice of Abandonment mailed Feb. 13, 2013 in connection with U.S. Patent Application No. 11/424,176
1123	Articles of Organization for Genghiscomm Holdings, LLC (Jan. 14, 2014) as obtained from the Colorado Secretary of State
1124	Colorado Business Entities (OpenGovCo) search results for companies having an address at 1942 Broadway Street, Suite 314c, Boulder, CO 80302 (retrieved Jul. 11, 2025)
1125	“Find a patent practitioner” search results from <a href="https://oedci.uspto.gov/OEDCI/practitionerSearchEntry">https://oedci.uspto.gov/OEDCI/practitionerSearchEntry</a> for Steve Shattil.
1126	Zhiqiang Wu, et al., <i>High-Performance, High-Capacity MC-CDMA via Carrier Interferometry</i> , 12 <sup>th</sup> IEEE Int’l Symposium on Personal, Indoor and Mobile Radio Communications, PIMRC 2001, pp. G-G (Oct. 3, 2001).
1127	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 15/283,881 (Patent No. 9,768,842) (executed May 9, 2025)
1128	RESERVED
1129	RESERVED
1130	RESERVED
1131	RESERVED

<b>Exhibit No.</b>	<b>Description</b>
1132	RESERVED
1133	RESERVED
1134	RESERVED
1135	U.S. Patent Application No. 11/187,107, Certification of Micro Entity Status (Gross Income Basis), Information Disclosure Statement and ancillary papers (July 19, 2013).
1136	U.S. Patent Application No. 11/187,107, Issue Fee Transmittal (Jan. 14, 2014)
1137	Resume of Mr. Steve Shattil
1138	Excerpts from File History of U.S. Patent Application No. 10/145,854 as obtained from Patent Center
1139	RESERVED
1140	RESERVED
1141	Intellectual Property Owners Association, <i>Top 300 Organizations Granted U.S. Patents in 2024</i> (42 <sup>nd</sup> Annual Listing) available at <a href="https://ipo.org/wp-content/uploads/2025/01/2024-Top-300-Patent-Owners-List.pdf">https://ipo.org/wp-content/uploads/2025/01/2024-Top-300-Patent-Owners-List.pdf</a> (last visited Jul. 12, 2025).
1142	U.S. Patent Application No. 14/275,161, Filing Receipt dated May 21, 2014
1143	U.S. Patent Application No. 12/545,572, Certification of Micro Entity Status (Gross Income Basis)
1144	U.S. Patent Application No. 13/036,171, Certification of Micro Entity Status (Gross Income Basis)
1145	U.S. Patent Application No. 13/116,984, Certification of Micro Entity Status (Gross Income Basis)
1146	U.S. Patent Application No. 13/116,984, Petition to Revive (filed Aug. 12, 2013)
1147	U.S. Patent Application No. 14/275,161, Certification of Micro Entity Status (Gross Income Basis)

<b>Exhibit No.</b>	<b>Description</b>
1148	U.S. Patent Application No. 14/275,161, Patent Application Fee Transmittal
1149	U.S. Patent Application No. 11/187,107, Transaction History as obtained from USPTO Patent Center on Jul. 12, 2025.
1150	Genghiscomm Trademark Information as obtained from TESS Search ( <a href="https://tmsearch.uspto.gov">https://tmsearch.uspto.gov</a> ) (Jul. 12, 2025)
1151	Continuity data for U.S. Provisional No. 60/163,141 as obtained from Patent Center
1152	RESERVED
1153	RESERVED
1154	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 15/396,567 (Patent No. 10,200,227) (executed May 9, 2025)
1155	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 15/786,270 (Patent No. 10,389,568) (executed May 9, 2025)
1156	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 16/796,888 (Patent No. 11,075,786) (executed May 9, 2025)
1157	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 16/916,901 (Patent No. 11,223,508) (executed May 9, 2025)
1158	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 16/940,383 (Patent No. 11,252,005) (executed May 9, 2025)
1159	RESERVED
1160	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 17/105,574 (Patent No. 11,381,285) (executed May 9, 2025)
1161	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a)

<b>Exhibit No.</b>	<b>Description</b>
	related to Application Serial No. 17,183,114 (Patent No. 11,424,792) (executed May 9, 2025)
1162	Judge Schroeder Trial Sittings (Marshall, TX), as obtained from PACER
1163	U.S. Patent Application No. 10/131,163, Non-Publication Request (filed April 24, 2002) as obtained from USPTO Patent Center
1164	RESERVED
1165	RESERVED
1166	RESERVED
1167	RESERVED
1168	RESERVED
1169	RESERVED
1170	RESERVED
1171	RESERVED
1172	RESERVED
1173	Application Data Sheet from U.S. Patent Application No. 15/786,270 as obtained from Patent Center
1174	Declaration filed in connection with U.S. Patent Application No. 15/768,270 as obtained from Patent Center
1175	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 17/105,576 (Patent No. 11,431,386) (executed May 27, 2025)
1176	Information Disclosure Statement by Applicant, U.S. Patent Application No. 14/789,949 (dated Feb. 2, 2017)
1177	Information Disclosure Statement by Applicant, U.S. Patent Application No. 14/733,013 (dated June 6, 2017)
1178	U.S. Patent Application Publication No. 2004/0100897 to Shattil

## **I. INTRODUCTION**

Pursuant to the “Interim Processes for PTAB Workload Management Memorandum” issued by Director Stewart on March 26, 2025 (“Stewart Memo”), Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Samsung” or “Petitioner”) respectfully submit this brief requesting that the Director deny the request to exercise her discretion to deny institution of the Petition for Inter Partes Review (IPR) (Paper 1) of U.S. Patent No. 10,389,568 (“’568 Patent” or “Challenged Patent”) owned by Genghiscomm Holdings, LLC (“Genghiscomm”). Samsung’s challenge to the ’568 Patent is one of nine IPRs filed against patents asserted in litigation by Genghiscomm against Samsung Electronics America, Inc.

Although the scheduled district court trial date precedes the projected final written decision date for this proceeding, denial is not warranted because of the unique facts of these cases, including (1) of the nine patents challenged in this dispute, six issued in 2021 or later and none issued earlier than 2017, (2) Mr. Shattil, the inventor and prosecutor of these patents, repeatedly and knowingly misused micro entity status, and (3) Mr. Shattil misused the United States patent system and inappropriately prosecuted the nine Challenged Patents to the detriment of the public by withdrawing subject matter that had been dedicated to the public by his assignee and pursuing patents to subject matter in which he lacked an

ownership interest.

For these reasons, Petitioner respectfully requests that the petition be referred for a merits determination.<sup>1</sup>

## **II. BACKGROUND**

### **A. The Parties and Patent Agent Mr. Shattil**

Genghiscomm Holdings, LLC (“Genghiscomm”) is a Colorado limited liability corporation formed on January 14, 2014, with an address at 1942 Broadway Street, Suite 314c, Boulder, CO 80302. EX1047, ¶1; EX1123. Many dozens of LLCs share this same address. EX1124. Its Director, Mr. Steve Shattil, has been a registered patent agent since 1996. EX1125. Mr. Shattil is the named inventor on the Challenged Patent. EX1001, cover. His resume indicates that he is

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<sup>1</sup> Samsung will be filing briefs in connection with each of the nine IPR proceedings and anticipates raising similar issues in each proceeding. This brief is similar to the brief presented in IPR2025-00780 but also addresses the post-AIA status of the ’568 Patent that was triggered by Mr. Shattil’s efforts to copy equations from the 4G LTE standards years after they published when no such expressions were described by any of his patent applications. This discussion is presented in response to Genghiscomm’s argument that validity or patentability will be more efficiently adjudicated in the district court. *Infra* § III.F.2 – III.F.3.

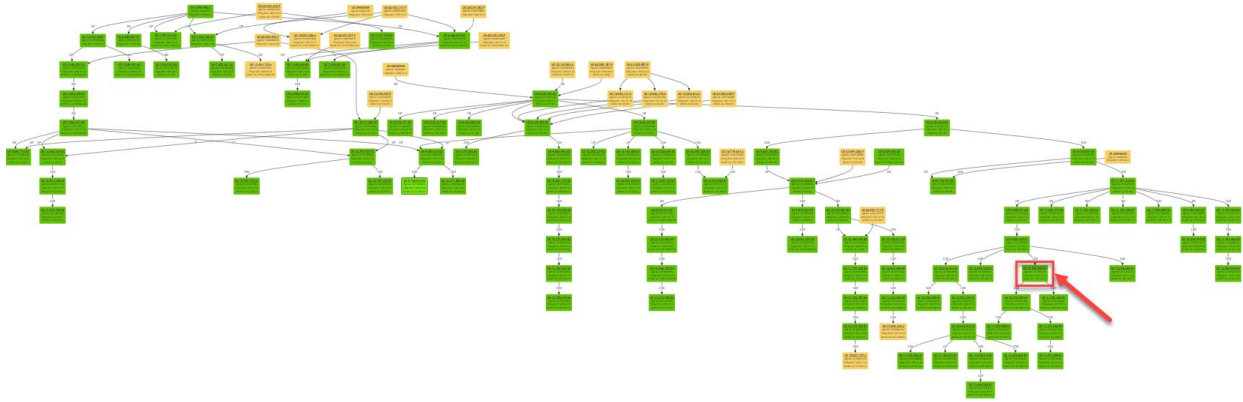
an inventor on over 150 patents and has filed or prosecuted over 1000 patents and patent applications. EX1137. “Genghiscomm®” was registered as a trademark in 2019 and is owned by Steve Shattil. EX1150. The goods and services associated with Genghiscomm are described as “Licensing of intellectual property rights.” EX1150, p.1. Since its formation in 2014, Genghiscomm has operated solely as a patent licensing company; it makes no products and has no discernable operations beyond its patent licensing efforts.

Petitioner party Samsung Electronics America, Inc. (“SEA”) is a United States corporation with offices in various states, including Texas, California, and New Jersey. SEA is a wholly owned subsidiary of Samsung Electronics Co., Ltd., a Korean company founded nearly a century ago. In 2024, Petitioner party Samsung Electronics Co., Ltd. obtained more patents from the USPTO than any other company, according to the Intellectual Property Owner’s Association. EX1141, p.2.

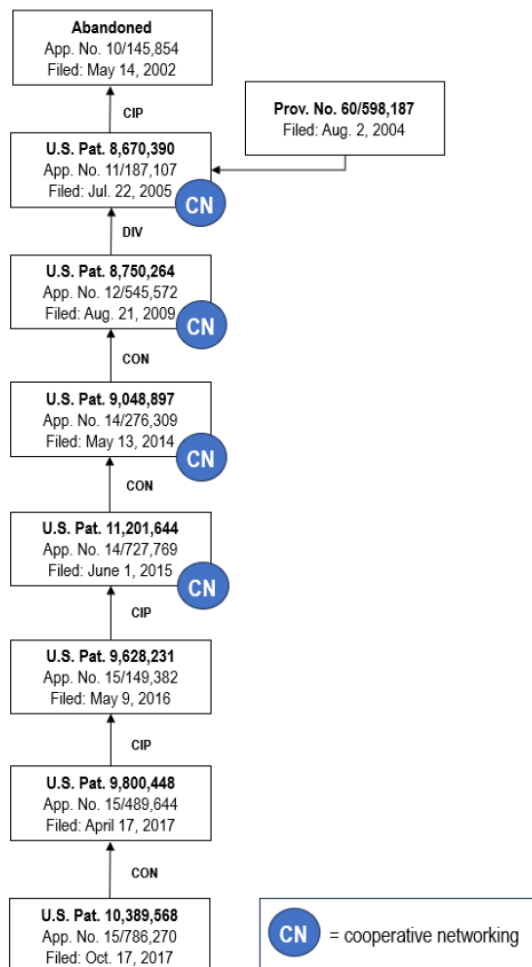
**B. Mr. Shattil Created A Patent Thicket Spanning More Than 100 Applications And Over 20 Years of Prosecution.**

While the domestic benefit claim for the ’568 Patent is relatively long and may appear relatively simple, the ’568 Patent is part of a much larger family of patent applications that have weaved their way through the Office for more than two decades. In all, there are more than 110 interrelated applications tied connected through a web of domestic benefit claims and incorporations by

reference. The following family tree, generated by an online tool called PatentBots® PatentPlex®, illustrates the extent of the family (the '568 Patent is identified by the red box and arrow):



The immediate patent family shown on the face of the '568 Patent (reflected in the illustration below) does not capture the full complexity of the prosecution history.



**'568 Pat. Related U.S. Application Data**

The domestic priority claims fail to reveal the complexity created by numerous incorporations by reference within the specifications. For example, the earliest-filed application in the '568 Patent's domestic benefit claim, U.S. Patent Application No. 10/145,854 ('854 Application), incorporated by reference more than 17 publications and another 20 patents and patent applications—many of which are themselves part of the larger family. EX1023, pp.233-236.

Mr. Shattil's approach to drafting and prosecuting these related applications has resulted in a patent thicket that comprises thousands of pages of complex descriptions and figures, leaving the public to navigate the web of disclosures without transparency.<sup>2</sup>

The complexity is evident even considering the nine patents Genghiscomm has asserted against Petitioner SEA across two litigations. Collectively, they span 715 pages and include 270 claims. EX1065 & IPR2025-00899, EX1001. The table below summarizes key information about these patents, including for each Challenged Patent: (1) the earliest claimed priority date, (2) date of alleged constructive reduction to practice,<sup>3</sup> (3) number of figures, (4) number of columns, and (5) an estimate of the number of documents incorporated by reference:

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<sup>2</sup> Take, for example, the '568 Patent filed in 2017. EX1001. Mr. Shattil has contended that he filed a provisional application describing all claims of the Challenged Patent in 1999. EX1155. ¶¶3-4. That Provisional is incorporated into the '854 Application, EX1023, p.236, but is not mentioned again in the applications in the domestic benefit chain for the '568 Patent until the '568 Patent was filed with a nearly identical specification to the original '854 Application.

<sup>3</sup> These dates are obtained from the declarations of Mr. Shattil and are in the record

<b>Pat.</b>	<b>Earliest Claimed Priority</b>	<b>Alleged Reduction to Practice</b>	<b>No. of Figs.</b>	<b>Spec. Cols.</b>	<b>No. of Docs Inc. by Reference.</b>
'842	5/14/02	11/2/99	48	79	~ 25
'227	5/14/02	11/2/99	48	79	~ 25
'568	5/14/02	11/2/99	47	43	~47
'786	8/4/04	4/24/02	236	157	~ 58
'508	8/4/04	4/24/02	19	54	~ 27
'005	8/4/04	4/16/03	19	54	~ 24
'285	8/4/04	2/7/03	70	76	~ 17
'792	1/8/07	4/24/02	37	66	~ 11
'386	8/4/04	4/16/03 <sup>4</sup>	70	75	~ 17

at EX1127 and EX1154 to EX1158, EX1160, EX1161. As these declarations show, Mr. Shattil believes he filed applications directed to the claimed subject matter in applications that predate the filing of the earliest applications in his domestic benefit claims.

<sup>4</sup> In earlier-filed discretionary denial briefs, Petitioner overlooked the fact Mr. Shattil had provided a declaration contending that the subject matter of the '386 Patent had been disclosed in a patent application filed on April 16, 2003. EX1175, ¶¶3-4.

There is substantial overlap in the specifications of some patents (e.g., the '508 and '005 Patents share similar specifications and domestic benefit claims). Yet, according to Mr. Shattil's declarations, the claimed subject matter in these otherwise similar applications has different dates of constructive reduction to practice, because the subject matter was first described in different patents and applications within the family.

Mr. Shattil has thus created a highly complex patent thicket that is difficult to decipher due to his prosecution strategy. The Office is far better equipped than a federal jury to address and resolve these complexities.

### **III. DISCRETIONARY DENIAL IS NOT WARRANTED UNDER §314(A)**

#### **A. Genghiscomm Lacks Settled Expectations In The Challenged Patent Because It Was Filed In October 2017—Eighteen Years After It Was Allegedly Conceived—And Issued In August 2019.**

Genghiscomm lacks settled expectations in the '568 Patent. The application for the Challenged Patent was filed in October 2017, about eighteen years after Mr. Shattil has declared that he first described the claimed subject matter in a provisional application filed in a different part of the extended patent family. EX1155, ¶¶3-4. The application for the challenged patent was even filed more than fifteen years after its earliest claimed priority date of May 14, 2002. EX1001, cover. Thus, Genghis has not developed strong settled expectations in the '568 Patent that warrant discretionary denial. *See, e.g., Shenzhen Tuozhu Tech. Co., Ltd. v. Statasys, Inc.,*

IPR2025-00438, Paper 10 (Jul. 17, 2025) (patents issuing in 2020, 2020, 2021, and 2024 not “in force for a significant period of time” and thus the Patent Owner lacked “strong settled expectations that favor discretionary denial”); *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11 (Jun. 26, 2025) (referring to merits panel when “most of the challenged patents have not been in force for a significant period of time (issued in 2020, 2019, and 2019), and accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial at least as to those patents”).

In addition to the group of patents challenged in this and related proceedings before the Board being relatively new, there are other unique facts in this and the other related proceedings warranting a finding of a lack of settled expectations and a finding that the public’s interest will be best served by a review of these patents in this proceeding.

**B. Compelling Public Interest: Considerations of Fairness, Patent System Efficiency, and Patent Quality Strongly Weigh Against Discretionary Denial On These Unique Facts.**

**1. Mr. Shattil and Genghiscomm had no right to the claimed subject matter when the Challenged Patent Application was filed in 2017 because of the 2005 Assignment to Aquity.**

Genghiscomm had no right to pursue the claims of the Challenged Patent when the application was filed and issued because based on Mr. Shattil’s own declaration testimony, he had assigned the claimed subject matter more than eleven

years before the Challenged Patent application was filed. Thus, despite assigning away all his rights to the patent applications in 2005, Mr. Shattil made new filings in 2017 as if he had the right and ability to claim priority to applications which he no longer owned.

Mr. Shattil executed a declaration stating that he constructively reduced the subject matter of all claims of the Challenged Patent to practice as reflected in a provisional application he filed in 1999. As Mr. Shattil declared:

I completed my invention as described and claimed in the subject patent ('568) as evidenced by the following:

The subject matter of each of the rejected claims is disclosed in U.S. Patent appl. no. 60/163,141 ('141), filed Nov. 2, 1999.

EX1155, ¶¶3-4 (emphasis removed).

U.S. Provisional No. 60/163,141 (“the '141 Provisional”) is mentioned in the specification for the Challenged Patent among a long list of 37 documents allegedly incorporated by reference. EX1001, 6:51. But, besides also being allegedly incorporated by reference into the earliest application in the domestic benefit claim—i.e., the '854 Application, EX1023, p.236—references to the '141 Provisional were removed from each of the intervening applications in the domestic benefit chain. *See, e.g.*, EX1021, EX1022.

More than two decades ago, Mr. Shattil pursued rights to the subject matter of the '141 Provisional by filing four applications claiming its benefit: U.S. Patent Application Nos. 09/703,202 (filed Oct. 31, 2000), 09/906,257 (filed Jul. 19, 2001), 10/034,386 (filed Dec. 27, 2001), and 10/360,346 (filed Feb. 7, 2003). EX1151 ('141 Provisional continuity data).<sup>5</sup> These applications were filed between October 31, 2000 and February 7, 2003, while Mr. Shattil still seems to have owned the rights.

On December 19, 2005, however, Mr. Shattil executed an assignment transferring all rights in these applications, and in subject matter disclosed therein, to Aquity LLC. EX1119. The assignment expressly conveyed:

all of Assignor's right, title and interest in and to the Patent Applications and any patents that may issue therefrom, including any foreign counterparts, divisions, continuations, or reissues of such patents, the same to be held by Assignee for Assignee's own use and enjoyment, and for the use and enjoyment of Assignee's successors, assigns, and other legal representatives, as fully and entirely as the same would have been held and enjoyed by Assignors if this Assignment and sale had not been made

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<sup>5</sup> These applications are not in the domestic benefit chain for the Challenged Patent.

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EX1119, p.3. This assignment covered the '141 Provisional and three of the four later non-provisional applications mentioned above. The relevant lines from the assignment are shown below.

Method and Apparatus for Using Multicarrier Interferometry to Enhance Optical Fiber Communications	02-Nov-99	60/163,141		US
Method and Apparatus for Using Multicarrier Interferometry to Enhance Optical Fiber Communications	31-Oct-00	09/703,202		US
Method and Apparatus for Using Frequency Diversity to Spatially Separate Wireless Communication Signals	27-Dec-01	10/034,386		US
Unified Multi-carrier Framework for Multiple-Access Technologies	7-Feb-03	10/360,346		US

EX1119, pp.6-7. The fourth was assigned via a separate, contemporaneous agreement (assigning patents as opposed to applications). The relevant line from that agreement is shown below.

Method and Apparatus for Transmitting and Receiving Signals having a Carrier Interferometry Architecture	16-Jul-01	09/906,257	6,686,879	US
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EX1117, pp.3, 5.

As a result of this assignment, Aquity stood in Mr. Shattil's shoes and acquired all rights to the subject matter in these patent applications—including the right to pursue claims or dedicate the subject matter to the public.<sup>6</sup> Mr. Shattil had

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<sup>6</sup> On May 10, 2007, Aquity LLC assigned each of the above-identified applications

thus conveyed all rights to the inventions disclosed in those applications to a third party and no longer had the right to claim the subject matter as his own.

Nevertheless, on October 17, 2017, Mr. Shattil filed the application for the Challenged Patent claiming subject matter Mr. Shattil believes was described in an application he assigned away and prosecuted it on behalf of Genghiscomm. EX1001, cover. Despite the 2005 assignment, Mr. Shattil identified Genghiscomm Holdings, LLC as the Applicant and assignee on the Application Data Sheet per 37 C.F.R. § 1.76. EX1173, p.5. Mr. Shattil's declaration submitted in the application for the Challenged Patent indicates that he believed he invented "a claimed invention in the application," thus showing that Mr. Shattil knew what he was claiming an exclusive right in. EX1174, 1. In other words, although Mr. Shattil had already been paid to assign away the claimed subject matter in 2005, he claimed that same subject matter for Genghiscomm in 2017 anyway.

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and patents to Lot 41 Acquisition Foundation, LLC. EX1118. There have been numerous assignments and transfers of rights in the patents and applications assigned to Aquity since 2005. However, there are no assignments showing that Mr. Shattil or Genghiscomm had a property interest in the subject matter of those patents when the Challenged Patent was filed or when it issued.

None of this was disclosed to the Office during prosecution. Under the Office's regulations, the assignee is entitled to prosecute an application "to the exclusion of the inventor or previous applicant or patent owner." 37 C.F.R. § 3.71(a). The original applicant is presumed to own an application "unless there is an assignment." *Id.* at § 3.73(a). For continuing and provisional applications, an assignment of a parent application is effective for child applications, and in the case of continuations-in-part, the assignee has rights to "subject matter common to" the assigned applications.<sup>7</sup> *See* M.P.E.P. §§ 306, 306.1.

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<sup>7</sup> In connection with a petition to accept an intentionally delayed priority claim in U.S. Patent Application No. 13/116,984, Mr. Shattil has stated that "Applicant Steve Shattil, who is the sole inventor of '917, had retained the right to file continuation-in-part applications that claim priority to '917." EX1092, p.32. The assignment he made included no such reservation. But even if Mr. Shattil did maintain the right to pursue claims directed to improvements in CIP applications, nothing gave him the right to claim exclusive rights in subject matter that he says is fully disclosed in patents and/or patent applications that he assigned away all of his right, title, and interest in. *See* M.P.E.P. 306 (in a CIP "the assignment recorded against the original application gives the assignee rights to ... the subject matter common to both applications").

Mr. Shattil’s own declaration reflects his understanding that all the claims of the Challenged Patent are described in the ’141 Provisional (and thus its progeny)—which he assigned away in 2005. Thus, neither Mr. Shattil nor Genghiscomm had any ownership interest in the claimed subject matter when it was applied for in 2017; that right belonged to Aquity or its successors under the 2005 assignment.

Accordingly, the application for the Challenged Patent should never have been filed. Genghiscomm cannot claim settled expectations in a patent it had no right to pursue, and the Office should not have issued a patent on subject matter owned by someone else to Genghiscomm.

**2. Mr. Shattil and Genghiscomm improperly claimed subject matter that was dedicated to the public by the assignee of that subject matter to the detriment of the public and Petitioner.**

Mr. Shattil’s and Genghiscomm’s actions in pursuing claims he alleges were described in the ’141 Provisional are detrimental to the public interest. The patent system must restrict the exclusive rights or the “public franchise” granted by a patent to ensure they remain within their legitimate scope. As the Supreme Court has explained:

*A patent by its very nature is affected with a public interest. As recognized by the Constitution, it is a special privilege designed to serve the public purpose of*

promoting the “Progress of Science and useful Arts.” At the same time, a patent is an exception to the general rule against monopolies and to the right to access to a free and open market. *The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest* in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that *such monopolies are kept within their legitimate scope.*

*Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 816-17 (1945) (emphasis added); see also 37 C.F.R. § 1.56(a) (“A patent by its nature is affected with a public interest.”)

Here, the public interest has been undermined by Mr. Shattil’s and Genghiscomm’s actions in obtaining claims to subject matter that, by the choice of their assignee or the assignee’s successors, had entered the public domain long before for the Challenged Patent was filed.

As explained above, Genghiscomm filed the application for the Challenged Patent to claim subject matter that Mr. Shattil had assigned away more than a decade earlier. *Supra* § III.B.1. Five non-provisional applications claimed the benefit of the ’141 Provisional, and all but one (U.S. Pat. Appl. No. 11/424,176)

are identified in the assignment agreements.<sup>8</sup> EX1117, EX1119. The rightful owner of the '141 Provisional and its progeny closed prosecution on this family, and the last application went abandoned on February 13, 2013. EX1122. The patents in this family issued in 2004, 2006, and 2008. No reissue—broadening or otherwise, was filed under 35 U.S.C. § 251. Any right to claim exclusive rights in the subject matter disclosed in the '141 Provisional lapsed well before the Challenged Patent was filed.

When the assignee closed prosecution and did not pursue further claims or a broadening reissue, any unclaimed subject matter entered the public domain. It is well-established that subject matter disclosed but not claimed in a patent is dedicated to the public—and the public is free to practice it. *See, e.g., Deering v. Winona Harvester Works*, 155 U.S. 286, 296 (1894) (“[I]f he described and claimed only a part of his invention, he is presumed to have abandoned the residue to the public.”); *Edward Miller & Co. v. Bridgeport Brass Co.*, 104 U.S. 350, 352 (1881) (The “omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed.”); *Unique Concepts v. Brown*, 939 F.2d 1558, 1562-63 (Fed. Cir. 1991) (“[S]ubject

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<sup>8</sup> The '176 Application was a divisional and is covered by the assignment too.

EX1117, p.3.

matter disclosed but not claimed in a patent application is dedicated to the public.”); *Envtl. Instruments v. Sutron Corp.*, 877 F.2d 1561, 1564 (Fed. Cir. 1989) (“The disclosure of a patent is in the public domain save as the claims forbid.”); *In re Terres*, 150 F.2d 711, 714 (C.C.P.A. 1945) (any unclaimed subject matter “has been dedicated under a presumption of law to the use and benefit of the public”); *cf. Technograph Printed Circuits, Ltd. v. United States*, 370 F.2d 571, 575 (Ct. Cl. 1966) (“If the applicant fails to file divisional applications claiming the inventions disclosed but not claimed . . . then the unclaimed inventions are dedicated to the public.”).

Despite this, in 2017 Genghiscomm sought exclusive rights in intellectual property it did not own. Mr. Shattil’s declaration (purported under 37 C.F.R. § 1.131) reflects his awareness that he was attempting to resurrect subject matter from a “closed” patent family that had been dedicated to the public. *See* EX1155. This approach undermines the public notice function of patents and frustrates the clarity that the patent system is designed to provide.

Not only was the filing of the Challenged Patent in disregard to Mr. Shattil’s 2005 assignment to Aquity, it also withdraws from the storehouse of public knowledge. The Challenged Claims recite subject matter that, by law, was dedicated to the public when the prior patent family closed. The public’s interest strongly favors restoring the public right to practice this subject matter free and

clear of the Challenged Patent or any claim for damages that may be brought thereunder.

Genghiscomm cannot claim settled expectations or entitlement to a patent right it never owned. In *Intel Corp. v. Proxense LLC*, the Director noted that “[t]here may be persuasive reasons why the Board should review challenged claims several years after their issuance date,” including that “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.” *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12, 2-3 (PTAB June 26, 2025). Along the line of *Intel* and under these particular facts, there can be no settled expectation by Genghiscomm in the Challenged Patent because Mr. Shattil resurrected matter from a “closed” patent family that had been dedicated to the public by his own assignee after he was compensated to part ways with those rights in the 2005 assignments.

**3. Mr. Shattil’s prosecution strategy has improperly extended the statutory patent term to the public detriment.**

Another consequence of Mr. Shattil’s approach to prosecuting the Challenged Patent is the improper extension of the patent term beyond what Congress intended. According to Mr. Shattil’s declaration, he conceived of and described the subject matter of the Challenged Patent in a provisional application

filed November 2, 1999. EX1155, ¶¶3-4. Under 35 U.S.C. § 119(e), he then had one year to file a nonprovisional application, which he did—U.S. Patent Application No. 09/703,202 (and related applications claiming the benefit of the '141 Provisional). EX1151. Under 35 U.S.C. § 154(a)(1), the patent term on the '141 Provisional ran for twenty years from the earliest non-provisional filing date. Thus, absent certain adjustments for USPTO delays, all rights in subject matter claimed from the '141 Provisional would have expired on November 2, 2020—twenty years after the 1-year anniversary of the '141 Provisional filing date.

But, by seeking claims in the Challenged Patent that he alleges were described in the '141 Provisional in 2017 (*eighteen years* after he allegedly conceived of the claims of the Challenged Patent), Mr. Shattil has improperly extended any exclusive rights in that subject matter by 558 days—extending exclusivity from the statutory expiration date of November 2, 2020 to May 14, 2022. He accomplished this by claiming subject matter from a different branch of the patent family in a different portion of the patent family with a later priority date.

The Supreme Court has recognized that the “cut-off date” for patent expiration is a critical public policy, as the public has a right to practice the invention freely after enduring the term of exclusivity. *Kimble v. Marvel Entm't, LLC*, 576 U.S. 446, 451 (2015) (“This Court has *carefully guarded* that cut-off date

[i.e., patent expiration], just as it has the patent laws' subject-matter limits: In case after case, the Court *has construed those laws to preclude measures that restrict free access to formerly patented, as well as unpatentable, inventions.*" (emphasis added)); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964). By prosecuting the Challenged Patent in this manner, Mr. Shattil has stretched the patent's term of exclusivity beyond the statutory 20 years, to the detriment of the public.

This improper extension further demonstrates that fairness and efficient operation of the patent system weighs against discretionary denial and supports a review of the Challenged Patent by the Board.

**4. Mr. Shattil and Genghiscomm have misused micro entity status to the detriment of the USPTO and its user community.**

Policy considerations strongly favor review of the Challenged Patent because Mr. Shattil and Genghiscomm repeatedly misused micro entity status, directly harming the Office and its user community through disproportionately increased financial obligations. This misuse should weigh heavily against discretionary denial of this Petition.

The Challenged Patent claims priority to U.S. Patent Application No. 11/187,107 ("the '107 Application"). On July 19, 2013, Mr. Shattil certified that the

applicant qualified for micro entity status on a gross income basis. EX1135, p.1. He specifically certified:

Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor *on more than four previously filed U.S. patent applications*, excluding provisional applications and international applications under the Patent Cooperation Treaty (PCT) for which the basic national fee under 37 CFR 1.492(a) was not paid, and also excluding patent applications for which the applicant has assigned all ownership rights or is obligated to assign all ownership rights as a result of the applicant's previous employment.

EX1135, p.1 (emphasis added).

After this certification, Mr. Shattil paid reduced micro entity fees for an information disclosure statement under 37 C.F.R. § 1.17(p), *id.*, p.3, the issue fee for the '107 Application, EX1136, and, as recently as 2021, the 8th year maintenance fee, EX1149.<sup>9</sup>

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<sup>9</sup> An exception to the five-application limit exists for inventions that must be assigned or which are in fact assigned to employers. *See* M.P.E.P. § 509.04. But Mr. Shattil assigned numerous patents and patent applications to Aquity which was not his employer. EX1117; EX1119; EX1137. The list of assigned patent

As the Office recently explained:

The USPTO is a fully fee-funded agency. When entities ineligible for the small or micro entity status fee reductions pay fees in an unentitled reduced amount, they take *improper advantage* of the fees paid by other entities. Fee payments made in an unentitled reduced amount **result in revenue loss for the USPTO**, which is required to set fees to recover aggregate costs. **Entities paying fees in unentitled reduced amounts result in the fees for all applicants being reset higher to offset this revenue loss.**

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applications includes more than five patent applications. EX1119, pp.6-8. “All such applications naming the inventor or joint inventor are counted toward the application filing limit, whether the applications were filed before, on, or after March 19, 2013. Further it does not matter whether the previously filed applications are pending, patented, or abandoned; they are all still included when counting to determine whether the application filing limit has been reached.”

M.P.E.P. § 509.04(a)I.B (Mar. 2014).

*See* Statutory Penalties for False Assertions or Certifications of Small or Micro Entity Status, 1536 O.G. 204 (Jul. 8, 2025) (emphasis added). Mr. Shattil and Genghiscomm’s actions thus deprive the USPTO and its users of fees.<sup>10</sup>

The submission of these micro entity certifications was not an oversight. For example, during prosecution of a parent to the Challenged Patent, Mr. Shattil’s micro entity certification was accompanied by an information disclosure statement referencing prosecution documents from two of Mr. Shattil’s other patent applications. EX1135, p.15. One of those applications—U.S. Patent Application No. 10/145,854 incorporated many more patent applications naming Mr. Shattil as

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<sup>10</sup> There are other examples of Mr. Shattil’s actions depriving the USPTO of fees. For example, in two information disclosure statements filed in two separate patent applications on February 2, 2017 Mr. Shattil certified that “no item of information contained in the information disclosure statement was known to” him “more than three months prior to the filing of the information disclosure statement” under 37 C.F.R. § 1.97(e)(2). EX1176, EX1177. At least one of the references on the IDS was known to Mr. Shattil—U.S. Patent Application Publication No. 2004/0100897. Mr. Shattil is the named inventor on it, and he filed the application in 2003—fourteen years before he certified he had not seen it more than three months before he filed the IDS in 2017. EX1178, cover.

inventor. *E.g.*, EX1023, pp.233-236. Mr. Shattil filed numerous micro entity certifications across a large patent family, as shown non-exhaustively in the table below.

	<b>Application (Patent)</b>	<b>Exhibit(s)</b>
1	11/187,107 (U.S. Pat. 8,670,390)	EX1135, EX1136, EX1149
2	12/545,572 (U.S. Pat. 8,750,264)	EX1143
3	13/036,171 (Abandoned)	EX1144
4	13/116,984 (U.S. Pat. 10,014,882)	EX1145; EX1146
5	14/275,161 (U.S. Pat. 9,042,333)	EX1142, EX1147, EX1148

It is hard to imagine that Mr. Shattil was unaware of his ineligibility for micro entity status given that he is a self-proclaimed inventor on over 150 patent applications and is a registered U.S. patent agent. EX1137. He has sophisticated knowledge and an obligation to practice completely before the Office.

In sum, Mr. Shattil and Genghiscomm sought reduced fees for their own financial gain, to the detriment of the USPTO and the integrity of the patent system. This pattern of misuse undermines fairness for all applicants and should weigh decisively against discretionary denial of this Petition.

**5. Mr. Shattil and Genghiscomm failed to disclose the public funding used in the conception of the claimed subject**

**matter, undermining any settled expectations in the Challenged Patent.**

Another compelling reason to grant review of the Challenged Patent is that Mr. Shattil and Genghiscomm failed to disclose the use of federal funding in the conception of the claimed inventions, as required by law. This undercuts any argument that Genghiscomm has “settled expectations” in its continued ownership of the patent.

The Bayh-Dole Act imposes a clear “obligation” on contractors: any patent application on an invention made with federal support<sup>11</sup> must include a statement in “the specification “specifying that the invention was made with Government support and that the Government has certain rights in the invention.” 35 U.S.C. § 202(c)(6); 37 C.F.R. § 401.14(f)(4). Failure to disclose such support can result in the government obtaining title to the invention. 35 U.S.C. § 202(c)(1); *see also* 37 C.F.R. § 401.14(d)(1)(i).

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<sup>11</sup> Under the standard patent rights clauses found in 37 C.F.R. § 401.14 these requirements pertain to “subject inventions” which include “any invention of the contractor *conceived or first actually reduced the practice in the performance of work under*” the contract.

The subject matter of the Challenged Claims was conceived with the benefit of public funding based on statements Mr. Shattil has made in other parts of the patent family, yet this fact was not disclosed in the Challenged Patents or its relatives (or any non-provisional application that Petitioner has identified). On October 31, 2002, Mr. Shattil filed U.S. Provisional Application No. 60/422,670. EX1111, p.11. This filing included a proposal explicitly stating that:<sup>12</sup>

*While Idris<sup>[13]</sup> performed work on an SBIR awarded by NASA Ames Research Center, it was discovered that CI provides performance improvements to all types of wireless communications and facilitates dynamic spectrum allocation.* In particular, performance improvements to wireless LAN offered Idris a unique business opportunity, resulting in the spin-off of a new company, CIAN Systems<sup>[14]</sup>, to commercialize CI technology for wireless LAN markets.

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<sup>12</sup> Id., pp.57-72 (The document is not complete. For instance, it appears to be missing a cover page and it cites to reference materials that are not included).

<sup>13</sup> Idris refers to another of Mr. Shattil's companies, Idris Communications, Inc. EX1112. Idris was dissolved September 23, 2004 and reinstated on February 24, 2023. EX1113.

<sup>14</sup> Mr. Shattil was a Director and Vice President of CIAN Systems. EX1115, p.1.

*Id.* at 69. The same document also describes Idris’s ongoing work for the Air Force and NASA Ames Research Center and confirms a focus on applying CI technology to defense and emergency service systems. *Id.* at 70, 72 (“Idris communications has been and is presently under contract with the Air Force to examine the deployment of CI in various environments.”). The SBIR award is also referenced on Idris’s website as of May 17, 2001. EX1114.<sup>15</sup>

A further website crawl from December 19, 2001, confirms that research on CI was “sponsored by NASA” and that the technology was developed under federally funded research.<sup>16</sup> Additional journal publications further reflect public

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<sup>15</sup> The ’670 Provisional admits that the application of CI to “all types of wireless communications” and its ability to allow “dynamic spectrum allocation” was discovered under a federal contract (an “SBIR awarded by NASA Ames Research Center”), thus making the application of CI to “all types of wireless communications” and its ability to perform “dynamic spectrum allocation” a “subject invention” under the standard patent provisions found in government contracts because it was conceived of using public funds. See 37 C.F.R. § 401.14(d)(1)(i).

<sup>16</sup> That website stated:

During the past three years, CI was presented in over 40

funding used in connection with research on carrier interferometry. For instance, an IEEE article co-authored by Mr. Shattil reports that the research it describes called was supported by “NSF grant ECS 9988665 “Ultra-Wideband Wireless Communication from Emerging Multiple Access Technology.” EX1126, p.G-11.

These materials establish that the subject matter claimed in the Challenged Patent—which is directed to using what Mr. Shattil called “Carrier Interferometry” in OFDM—is a “subject invention” under the Bayh-Dole Act and its implementing regulations because it was conceived of, or first actually reduced to practice, with the benefit of federal funding. Because Genghiscomm and Mr. Shattil failed to disclose the use of public funds, the government retains the right to claim title to the invention, diminishing any settled expectations that Genghiscomm may have in the Challenged Patent and tipping the scales against a discretionary denial.

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technical publications and 30 conferences. ***This research, sponsored by NASA, revealed that when CI is applied as a common platform for wireless networking,*** it simultaneously provides the following benefits: . . . Adapts to any communications protocol or standard (FHSS, DSSS, ***OFDM***) . . . Uses inexpensive mainstream manufacturing processes . . . Extends battery life or increases range via improved performance . . . .

EX1116, pp.1-2.

**6. Mr. Shattil’s prosecution tactics caused the Office to improperly issue a patent a decade after abandonment.**

Another factor favoring review of the Challenged Patent is that Mr. Shattil’s approach to patent prosecution in the patent family resulted in the USPTO improperly issuing a patent on the parent ’854 Application nearly a decade after it was abandoned. The ’854 Application—the ultimate parent to the Challenged Patent—went abandoned on May 27, 2009, when Mr. Shattil failed to timely pay the issue fee. EX1138, p.38. Soon thereafter, Mr. Shattil petitioned to withdraw the abandonment, *id.*, pp.33-35, but the Office denied the petition in June 2010. Although the Office provided clear guidance on alternative avenues for revival, Mr. Shattil did not pursue them. *Id.*, pp.31-32.

Nearly ten years later, Mr. Shattil filed a new petition to revive the ’854 Application. *Id.*, pp.22-27. In it, he checked the box stating that “[t]he entire delay in filing the required reply . . . was unintentional.” *Id.*, p.23. Yet Mr. Shattil offered no explanation for how the issue fee and petition filing could have been “unintentionally” overlooked *for nearly a decade*.

Although the petition was initially granted electronically, the unusual circumstances caught the Office’s attention and the decision was vacated. EX1138, pp.19-21. The Office then gave Mr. Shattil two months to explain the extensive delay and respond to specific concerns. *Id.*, p.21. No response was ever submitted.

Despite these red flags, on June 20, 2020, the Office issued U.S. Patent No. 10,673,758. *Id.*, p.17. Just three months later, Mr. Shattil requested a certificate of correction for the erroneously issued patent. *Id.*, pp.8-11. By this point, Mr. Shattil had been told expressly that the patent should not have been granted. The request for correction again alerted the Office, and the Office of Petitions determined that the patent was “erroneously issued.” The Office announced it would publish an errata in the Official Gazette clarifying that no patent had been granted. EX1138, p.3.

This sequence of events illustrates a pattern of gamesmanship and procedural manipulation of the U.S. patent system and the Office by Mr. Shattil, further complicating and obscuring the prosecution history of this patent family. These tactics not only undermine the integrity of the U.S. patent system but have imposed significant, unnecessary costs and complexity on those seeking to analyze or challenge these patents—including Petitioner.

The extraordinary actions that led to the issuance of a patent a decade after abandonment just underscores that the public interest is served by moving the present challenge forward before the Board. The integrity of the patent system should not be compromised by the cavalier approach to patent prosecution exhibited in this extensive patent family. The Office’s job is hard enough without such tactics and that is why it relies on the good faith and candor of the members

of its bar. In this particular patent family there has been a pattern of failures that warrant taking up the present challenges in the public interest.

**C. The Large Number and Complex Nature of the Patents at Issue Favor Review by the Board.**

Director Stewart has determined that disputes involving a large number of complex patents weigh heavily in favor of institution and review by the Board. In *Tesla, Inc. v. Intellectual Ventures II LLC*, Director Stewart expressly denied a request for discretionary denial, emphasizing the “large number and vast scope of the patents asserted,” even though the district court “trial date precedes the projected final written decision due date, and there is insufficient evidence the district court is likely to stay its proceeding even if the Board were to institute trial.” *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00221, Paper 10, 2-3 (June 13, 2025). Director Stewart noted that “Petitioner’s arguments regarding the complex and diverse litigation proceeding tip the balance against discretionary denial” and specifically observed that “the Board is better suited to review a large number of patents involving diverse subject matter.” *Id.*

This reasoning applies with even greater force here. Genghiscomm has accused SEA of infringing nine separate patents, spanning several technologies and two cellular standards. These patents are being asserted against 4G LTE and 5G standards—including mobile devices and 5G “gNodeB” network equipment. These

patents have diverse expiration dates and thus are being asserted at different products depending on the patent.

These nine asserted patents also present a complex and voluminous record, collectively spanning 715 pages and include 270 patent claims as explained above. They have different filing dates, priority dates, and reduction to practice dates, and are asserted against a diverse set of products and technology standards over a lengthy period.

<b>Pat.</b>	<b>Earliest Claimed Priority</b>	<b>Alleged Reduction to Practice</b>	<b># Figs.</b>	<b>Spec. Cols.</b>	<b># docs inc. by reference.</b>
'842	5/14/02	11/2/99	48	79	~ 25
'227	5/14/02	11/2/99	48	79	~ 25
'568	5/14/02	11/2/99	47	43	~47
'786	8/4/04	4/24/02	236	157	~ 58
'508	8/4/04	4/24/02	19	54	~ 27
'005	8/4/04	4/16/03	19	54	~ 24
'285	8/4/04	2/7/03	70	76	~ 17
'792	1/8/07	4/24/02	37	66	~ 11
'386	8/4/04	4/16/03	70	75	~ 17

The Board, as part of the agency that granted these patents, is best equipped to address the technical and procedural challenges posed by such a large and diverse patent family. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00221,

Paper 10, at 3 (“the Board is better suited to review a large number of patents”). As in *Tesla*, “the complex and diverse litigation proceeding tip the balance against discretionary denial.” *Id.* at 2-3.

**D. The Petition is Appropriately Supported by Expert Testimony.**

Genghiscomm argues that Samsung’s Petition relies too heavily on the Declaration of Harry V. Bims. Genghiscomm Br., 15-17. But there is nothing excessive or inappropriate about the Petition’s reliance on Dr. Bims’ expert testimony. On the contrary, Samsung’s approach is fully consistent with Director’s Stewart’s guidance regarding the use of expert evidence in Board proceedings.

**1. Samsung’s Petition does not inappropriately rely on expert testimony.**

The Petition’s primary unpatentability arguments are based on the explicit teachings of the prior art, which themselves clearly meet the challenged claims. Most of the Petition’s citations to Dr. Bims’ declaration simply demonstrate that Dr. Bims independently agrees with and confirms the Petition’s analysis of the prior art. That is fundamentally different from the Petition relying on expert testimony in lieu of clear documentary evidence.

Where expert testimony is provided, it serves to offer “provide helpful context or to explain terms of art” for the Board—exactly as contemplated by Board guidance. Every aspect of Dr. Bims’ testimony is meticulously corroborated

by citations to prior-art patents or printed publications. This approach aligns with the USPTO’s “FAQs for Interim Processes for PTAB Workload Management” (“Interim-Processes FAQs”), FAQ #21, which emphasizes the value of expert declarations supported by evidence. Similarly, Board decisions have “applauded” expert testimony that is corroborated by extensive citation to published references. *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00032, Paper 11 at 39 (May 19, 2025).

**2. The Petition’s reliance on expert testimony comports with the Director’s Guidance on proper use of expert testimony.**

The Petition’s use of expert testimony fully aligns with the standards articulated by the Director regarding proper reliance on expert declarations. In *iRhythm Technologies v. Welch Allyn Inc.*, the Director confirmed it is appropriate for a petitioner to rely on expert testimony “to explain the background knowledge of a person of ordinary skill in the art, and the expert provides citations to evidence in support of his statements in the required manner.” IPR2025-00363, at 2-3 (PTAB June 6, 2025).

Samsung’s Petition follows this guidance precisely. Dr. Bims explains what a person of ordinary skill in the art would have understood at the relevant time and substantiates his opinions with cites to supporting evidence. *See e.g.*, EX1002, ¶¶46-49, 52, 78, 114, 198, 261. For example, Dr. Bims references to the Dowling

patent (EX1042) to support his statement that transmitters could be implemented in hardware or software. EX1002, ¶198 (citing EX1042-Dowling, 3:46-50; 5:66-6:1 (disclosing that the transmitter, receiver, and precoder may be implemented in hardware or software”); 21:62-64 (disclosing that the “present invention” is applicable to FFT based multicarrier modulation and OFDM systems).

Accordingly, Petitioner properly relied upon expert testimony.

**E. Adjudication By the Board Would Be Efficient, as No Other Forum, Despite Many Lawsuits, Has Adjudicated the Merits of the Challenged Patent**

Despite numerous lawsuits, neither the PTAB nor any other forum has adjudicated the validity or patentability of the Challenged Patent. Since it issued, Genghiscomm has asserted the patent in at least eight lawsuits in four different district courts: the Eastern District of Texas, the Western District of Texas, the Southern District of California, and the Northern District of California. Although many of Genghiscomm’s lawsuits have settled, Genghiscomm’s repeated assertions and its claim that the patents cover cellular standards indicate a strong likelihood that it will sue additional defendants.

This situation is analogous to *Berkshire Hathaway Energy Company et al v. Birchtech Corp.*, where the Director denied a request for discretionary denial, finding that “[b]ecause the litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the

parties at the Office would be more efficient.” IPR2025-00274, Paper 23, at 2 (PTAB July 2, 2025). Here, adjudication of the validity of the Challenged Patents would be efficiently and effectively conducted before the Board.

**F. The Petition Provides a Compelling Challenge to Patentability.**

**1. The Petition includes clear anticipation grounds.**

Samsung’s Petition raises nine well-supported grounds challenging 16 claims of the ’568 Patent. Pet., 13. As detailed in the Petition, these grounds provide a strong and persuasive challenge to the patentability of the challenged claims. *Id.*

Grounds 1-6 rely upon Dirk Galda & Hermann Rohling, *A Low Complexity Transmitter Structure for OFDM-FDMA Uplink Systems*, *Vehicular Technology Conference*, IEEE 55th Vehicular Technology Conference, vol. 4, pp.1737-1741 (May 6, 2002) (“Galda”), which predates the earliest claimed effective filing date of the ’568 Patent. Galda was never presented to the Office during examination of the ’568 Patent and as such the Office has never had the opportunity to consider Galda.

As set forth in ground 1, Galda anticipates at least claims 1-2, 6, and 20. The similarities between the Challenged Patent and Galda are striking with Galda explaining that the use of DFT spreading codes can reduce peak-to-average power of an OFDM signal. As detailed in the Petition, the alleged unique and non-

obvious limitations of certain Challenged Claims were fully disclosed in Galda before the effective filing date of the '568 Patent. Pet. 21-30. In summary, the strength and clarity of Samsung's prior art grounds—including the anticipation challenge based on Galda—provide a compelling reason for the Board to institute review. The merits of these challenges weigh strongly against discretionary denial and support the need for a full adjudication on the patentability of the challenged claims.

**2. The Patent Office made a mistake by evaluating the '568 Patent under Pre-AIA law and that error should be corrected.**

The '568 Patent was incorrectly examined under pre-AIA law because Mr. Shattil copied equations from the LTE standards and claimed them as his own in connection with parent application U.S. Patent No. 9,800,448—after the AIA effective date. The claims of that application seek to secure as Genghiscomm's exclusive property equations that are found in the 4G LTE specification and nowhere in the disclosure of any of the patents in the immediate patent family to the Challenged Patent. This is illustrated by the example below:

**Claims Obtained By Mr. Shattil**

$$z(l \cdot M_{sc}^{PUSCH} + k) = \frac{1}{\sqrt{M_{sc}^{PUSCH}}} \sum_{i=0}^{M_{sc}^{PUSCH}-1} d(l \cdot M_{sc}^{PUSCH} + i) e^{-j \frac{2\pi i k}{M_{sc}^{PUSCH}}}$$

U.S. Pat. No. 9,800,448 (EX1179), claim 1.

$$s_l(t) = \sum_{k=-\lfloor N_{RB}^{UL} N_{sc}^{RB} / 2 \rfloor}^{\lfloor N_{RB}^{UL} N_{sc}^{RB} / 2 \rfloor - 1} a_{k(-),l} e^{j2\pi(k+1/2)\Delta f(t - N_{CP,l} T_s)}$$

U.S. Pat. No. 9,800,448 (EX1131), claim 2.

**3GPP TS 36.211 (V.8.5.0) (EX1030)**

$$z(l \cdot M_{sc}^{PUSCH} + k) = \frac{1}{\sqrt{M_{sc}^{PUSCH}}} \sum_{i=0}^{M_{sc}^{PUSCH}-1} d(l \cdot M_{sc}^{PUSCH} + i) e^{-j \frac{2\pi i k}{M_{sc}^{PUSCH}}}$$

EX1030, p.15.

$$s_l(t) = \sum_{k=-\lfloor N_{RB}^{UL} N_{sc}^{RB} / 2 \rfloor}^{\lfloor N_{RB}^{UL} N_{sc}^{RB} / 2 \rfloor - 1} a_{k(-),l} \cdot e^{j2\pi(k+1/2)\Delta f(t - N_{CP,l} T_s)}$$

EX1030, p.31.

Terms like “PUSCH,” “RB,” “ $N_{RB}^{UL}$ ,” and “ $N_{sc}^{RB}$ ” are defined in the 4G LTE standards but are not found anywhere in the earlier-filed disclosures. EX1036, p.33; EX1038, pp.8-9, 14-15, 31. Because the mathematical expressions introduced into the claims of the ’448 Patent are not described in applications filed before April 17, 2017—when they were claimed in the application for the ’448 Patent—the ’568 Patent is a post-AIA patent. Other issues with the treatment of the ’568 Patent as a pre-AIA patent are discussed in the Petition and would be the subject of adjudication by the Board should IPR be instituted. The Office erred when it concluded that the ’568 Patent was a pre-AIA patent and that error should be addressed in this proceeding.

**3. Genghiscomm cannot use Mr. Shattil’s declaration to swear behind Galda or Bury because the ’568 Patent is a post-AIA patent and Bury is a statutory bar even under pre-AIA law.**

Because the ’568 Patent is a post-AIA patent, Genghiscomm’s argument that it can merely swear behind Galda and Bury is incorrect. Genghiscomm Br., 15. Specifically, under the post-AIA statutes if Galda and Bury published before the

earliest effective filing date of the '568 Patent—which they both did—then they are prior art regardless of any alleged prior conception or reduction to practice absent certain exceptions not present here. *See* M.P.E.P. § 715 II (“Situations where 37 C.F.R. 1.131(a) Affidavits are Inappropriate” stating that “[a]n affidavit or declaration under 37 C.F.R. 1.131(a) is not appropriate in the following situations: (A) [w]here the application is subject to current 35 U.S.C. 102 and the affidavit or declaration is not directed to evidence used in a rejection based on pre-AIA 35 U.S.C. 102(g).”). Moreover, Bury, which published more than a year before the earliest claimed effective filing date is a § 102(b) bar even if the '568 Patent was subject to pre-AIA law. *See* M.P.E.P. § 715 II (“Situations where 37 C.F.R. 1.131(a) Affidavits are Inappropriate”: “(B) Where the reference publication date is more than 1 year prior to the effective filing date of applicant’s or patent owner’s claimed invention. Such a reference is a ‘statutory bar’ under pre-AIA 35 U.S.C. 102(b) as referenced in 37 CFR 1.131(a)(2).”).

These issues are regularly handled by the Office and pose questions of the relevant statutory scheme and fundamental tenets of patent law. The Board is thus a proper forum to adjudicate these issues.

**G. The *Fintiv* Factors Do Not Support Discretionary Denial.**

In addition to the Stewart Memo factors analyzed above, the *Fintiv* factors also weigh against discretionary denial of institution.

**1. Factor 1 (Stay): SEA will renew its motion for a stay if the Board institutes IPR.**

Under *Fintiv*, this factor weighs against discretionary denial 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.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6-7 (PTAB Mar. 20, 2020) (precedential).

SEA will seek a stay of co-pending litigation if the Board institutes IPR. The Eastern District of Texas has granted stays in similar circumstances where the case has “not reached such an advanced stage that it would weigh against a stay.” *Broadphone LLC v. Samsung Elecs. Co., Ltd.*, 2024 WL 3524022, at \*2-3 (E.D. Tex. July 24, 2024) (granting stay where a “significant amount of discovery remains, the claim construction hearing has not occurred, and trial is currently set for [over six months later]”). Here, the statutory deadline for the Board’s institution decision is November 7, 2025. EX1046, p.3. Assuming the decision is released shortly before the statutory deadline, the decision will be released around the same time as the Markman hearing, which is scheduled for October 21, 2025. EX1046, p.3. Moreover, because Genghiscomm has just added 22 new claims to the case this month, SEA has moved the Court to modify the *Markman* date to

mitigate the prejudice to SEA caused by the amendment of the contentions. Thus, the *Markman* hearing may be pushed back.

**2. Factor 2 (Trial Date): The District Court’s trial date is uncertain and seven trials are currently scheduled for the same date.**

*Fintiv* Factor 2 looks to “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Id.* Factor 2 is at worst neutral because of the uncertainty surrounding Judge Schroeder’s availability to oversee the trial involving the Challenged Patent as scheduled given the numerous trials scheduled on that same date and the fact that he borrows the courtroom in Marshall, Texas from Judge Gilstrap because Judge Schroder is typically in Texarkana, Texas. Thus, trial will likely occur during one of Judge Schroder’s infrequent sittings in Marshall, of which there are only four currently scheduled in 2026.

A jury trial is currently scheduled before Judge Schroeder on April 20, 2026. EX1046, p.1. When this Petition was filed, there were four trials scheduled in Marshall before Judge Schroeder for that date. *See* EX1061, p.1; EX1062, p.1; EX1063, p.1; EX1064, p.5 (resetting trial to 4/20/2026). Genghiscomm contends that the concern of having multiple trials on the same date is “no longer present.” Genghiscomm Br. at 6. That is not correct. As of the date of the filing of this brief, Judge Schroder has seven cases scheduled for trial on April 20, 2026:

1. *Video Solutions Pte. Ltd. v. Cisco Systems, Inc.*, No. 2:23-cv-00222-RWS-RSP;
2. *Aspen Networks, Inc. v. AT&T Inc., et al.*, No. 2:23-cv-00476-RWS-RSP;
3. *InnoMemory, LLC v. Truist Financial Corp.*, No. 2:24-cv-00146-RWS-RSP;
4. *Genghiscomm Holdings, LLC v. Samsung Electronics America, Inc.*, No. 2:24-cv-00242;
5. *WSOU Investments, LLC v. Cisco Systems, Inc.*, No. 2:24-cv-00332-RWS-RSP;
6. *Husky Injection Molding Systems Ltd. v. Ningbo AO Shen Mold Co., Ltd.*, No. 24-cv-00348-RWS-RSP;  
and
7. *Jensen v. Hunt Transportation, Inc.*, 25-cv-00424-RWS-RSP.

EX1162, pp.7-10. Two of these cases were filed in 2023—the year before the action in the parallel proceeding was filed. One of them—the *Aspen Networks* case—was just added to Judge Schroder’s trial calendar for April 2026 in May, thus showing that Judge Schroder’s trial schedule is in flux. And, because *Genghiscomm* was just allowed to assert 22 new claims in the litigation, SEA is moving the Court to push the litigation over the Challenged Patent to Judge Schroder’s October 2026 trial date.

Accordingly, at this time there are three cases that would be called before the first litigation between Genghiscomm and SEA is called. While Genghiscomm says that the *Innomemory* case has “been dismissed or closed and will not go to trial,” Genghiscomm Br., 6, Genghiscomm appears to overlook the consolidation order and Capital One’s continued litigation of the case. EX1163. That case has not resolved.

“[T]he Board may consider any evidence that the parties make of record that bears on the proximity of the district court’s trial date.” EX1060, p.2. Because Judge Schroeder cannot simultaneously try multiple patent cases and the case involving the Challenged Patent is currently fourth on the Court’s schedule, it is speculative to assume that the trial date will hold. And, if it does not, Judge Schroeder currently has only two remaining sittings in Marshall in 2026. Thus, at the very least, this factor is neutral or at least slightly weighs against exercising discretion to deny the Petition. *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 district court “set 10 cases for jury selection on the same day”).

Even assuming that the April 2026 date were to hold and the Final Written Decision (“FWD”) may come after the trial date, this is not an impediment to institution of IPR. The Board has instituted trial based on many of factors present

here, such as diligence in filing the petition, a stipulation not to pursue the asserted grounds in litigation, minimal investment in litigation, and the merits of the challenge were strong. *Lego Sys., Inc. v. Mq Gaming LLC*, No. IPR2020-01445, 2021 WL 606917, at \*8 (finding jury trial “five months before a final written decision” outweighed by “low” “investment by the court and parties in the [parallel case] on” common issues, Petitioner’s *Sotera* stipulation, and strong merits to the challenge); *Verizon Business Network Services, Inc. v. Huawei Techs. Co.*, IPR2020-01141, Paper 12 (Jan. 14, 2021).

When considering the complexity of the analysis that needed to be undertaken to evaluate the extensive patent thicket created by Mr. Shattil, Petitioner was diligent in preparing and filing the nine IPR petitions against the Genghiscomm patents. The way Patent Owner structured its patent families, shifted patent disclosures from one portion of the patent family to another, and, at times, incorporated dozens of patents and publications by reference, placed a significant burden on Petitioner to assess its positions. *Supra* §§ II.B, III.B.

The complexity presented by this, and the eight other IPR petitions Petitioner has filed, weigh strongly in favor of institution. *Apple, Inc. v. SEVEN Networks, LLC*, IPR2020-00156, Paper 10 at 21-22 (June 15, 2020) (“complexity of multiple patents and issues in the District Court Action” favored institution). Certainly the time required to analyze the patent family and prepare the petitions

should not be counted against Petitioner on these facts. Otherwise, Patent Owners will be incentivized to muddle the public record on patents to the detriment of the just to make it difficult to prepare petitions to challenge patents quickly. This will adversely impact the Office as well because it is likely to decrease the quality of examination of those complex patent families.

Considering the procedural and technical complexities involved in this case, the Board is uniquely situated to adjudicate patentability because of its expertise in patent law and technological questions.

**3. Factor 3 (Parallel Proceeding): The majority of the substantial deadlines will occur after the expected Institution Decision date.**

Factor 3 weighs against discretionary denial. The district court case is in relatively early stages even though it has been pending for nearly sixteen months. No depositions have occurred; expert discovery is many months away. Fact discovery is currently scheduled to close December 1, 2025. EX1046, p.3. Expert discovery currently starts that same day. *Id.* A *Markman* hearing is scheduled for Oct. 21, 2025, but as mentioned above, a motion to move the *Markman* hearing back is pending before the Court. *Id.* Where, as here, “the district court[s] ha[ve] not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.” *Fintiv* at 10.

**4. Factor 4 (Issue Overlap): *Sotera*-plus stipulation will minimize any potential overlap.**

Factor 4 weighs strongly against discretionary denial. In its Petition, Petitioner stipulated that, if the IPR is instituted, Petitioner will not assert that any of the claims challenged in this proceeding are invalid on any ground that Petitioner raised or reasonably could have raised during this inter partes review. Pet. 81 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-01019, at 19 (finding “stipulation here mitigates any concerns of duplicative efforts...as well as concerns of potentially conflicting decisions” and “ensures that an inter partes review is a ‘true alternative’ to the district court proceeding”); *Lego*, 2021 WL 606917, at \*6 (“[F]actor weighs strongly against discretionary denial” where Petitioner makes *Sotera* stipulation); *Verizon Business Network Servs, Inc. v. Huawei Techs. Co.*, IPR2020-01141, Paper 12 (Jan. 14, 2021) (“Instituting trial here serves overall system efficiency and integrity goals by not duplicating efforts and by resolving materially different patentability issues.”)).

On June 6, 2025 Petitioner filed “Petitioner’s Further Stipulation to Materially Reduce Overlap With District Court Proceedings” (Paper 7) in which Petitioner further stipulated that “if the PTAB institutes review in this proceeding, it will not rely in the litigation on any product or system that is ‘based on the same evidence presented’ in this IPR and will not advance a theory of obviousness based on the

combination of prior art that is asserted in any ground presented in the Petition with any other prior art, including product or system prior art, against the challenged claims.” Paper 7, 2 (citing *Cf. SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 9 (PTAB Apr. 7, 2025)).

Thus, the protections afforded by Petitioner’s stipulation here exceed the classic *Sotera* stipulation provisions found insufficient by the Board in *SAP*, and ensure that product or system art “based on the same evidence” to those used in the IPR will not be relied upon in the underlying litigation. Notably, Petitioner’s stipulation also forecloses what the Federal Circuit recently found permissible in *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1366 (Fed. Cir. 2025) (holding that Congress did 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”). Indeed, in that case the Federal Circuit authorized defendant/petitioner Ingenico to “rely[] on the DiskOnKey System with related printed publications at trial to prove the claimed invention was known or used by others, on sale, or in public use.” *Id.* at 1367. Here, however, Petitioner’s stipulation ensures that the IPR will serve as a true alternative to the parallel litigation if the Board institutes review. No product or system art will be introduced at trial that is “based on the same evidence” presented as grounds in this IPR or any evidence that

could have been raised as a grounds in this IPR. Accordingly, this factor strongly favors institution.

**5. Factor 5 (Same Party) does not support discretionary denial.**

When the Petitioner is the same as the named defendants in the litigation, the Board has found that this factor adds “little if anything to the discretionary denial analysis.” See *Aylo Freesites Ltd. f/k/a MG Freesites Ltd. v. WellcomeMat, LLC*, IPR2024-00710, Paper 13 at 17-18 (PTAB Sep. 05, 2024) (“We make the unremarkable observation that an IPR petitioner and patent owner are very often named parties in parallel district court litigation regarding the same patent. In our view, this factor adds little if anything to the discretionary denial analysis unless the petitioner is not named as a defendant (or declaratory judgment plaintiff) in parallel district court patent litigation.”). As in *Aylo*, the fact that there is overlap between the Petitioner parties and the defendant in litigation adds little to the discretionary denial analysis here.

**6. Factor 6 (Other Considerations): The compelling merits of the Petition strongly favor institution.**

As described above in Section III.F, the compelling challenge to the Challenged Patent presented in the Petition weighs against a discretionary denial. So too do public interest considerations as described in Section III.B.

#### **IV. DENIAL OF INSTITUTION UNDER 35 U.S.C. § 325(D) WOULD BE IMPROPER**

Guidance regarding the Director’s Interim Process states that “[i]f a patent owner chooses not to file a discretionary denial brief, the Director will not issue a decision on discretionary considerations.” *See* USPTO’s “FAQs for Interim Processes for PTAB Workload Management” (“Interim-Processes FAQs”), FAQ #9. Accordingly, a Patent Owner must raise a discretionary denial request for it to be heard by the Director. Here, Genghiscomm did not request discretionary denial under 35 U.S.C. §325(d); thus, no decision by the Director as to discretionary denial under 35 U.S.C. §325(d) is required.

Regardless, discretionary denial under 35 U.S.C. § 325(d) is not applicable here. First, the Challenged Patent was not rejected based on any prior art. Second, the prior art in Petitioner’s Grounds was never cited, much less discussed, during prosecution. Therefore, denial under § 325(d) is unwarranted.

#### **V. CONCLUSION**

For the above reasons, Petitioner respectfully requests that the Director decline to discretionarily deny this Petition and pass it to the merits panel for an institution decision on the merits of the Petition.

Case No. IPR2025-00788

Patent No. 10,389,568

Respectfully submitted,  
GREENBERG TRAURIG, LLP

Date: July 29, 2025

By: /Andrew R. Sommer/  
Andrew R. Sommer  
Reg. No. 53,932

**CERTIFICATION UNDER 37 C.F.R. § 42.24(d)**

This Request complies with the requirements of 37 C.F.R. § 42.24. As calculated by the word count feature of Microsoft Word, it contains 9,221 words, excluding the words contained in the Table of Contents, Table of Authorities, List of Exhibits, this Certification and the Certificate of Service.

GREENBERG TRAURIG, LLP

Date: July 29, 2025

By: /Andrew R. Sommer/  
Andrew R. Sommer  
Reg. No. 53,932

**CERTIFICATE OF SERVICE**

The undersigned certifies that the foregoing PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION and EXHIBIT NOS. 1022, 1092, 1111-1119, 1122-1127, 1135-1138, 1141-1151, 1154-1158, 1160-1163, 1173-1178 were served on the following counsel via electronic mail:

Ragnar Olson  
USPTO Reg. No. 58,684  
Global IP Law Group, LLC  
55 W. Monroe Street, Suite 3400  
Chicago, IL 60603  
Ph.: (312) 241-1503  
Email: rolson@giplg.com

With copies to:

dberten@giplg.com  
arichards@giplg.com  
kfrisby@giplg.com.

GREENBERG TRAURIG, LLP

Date: July 29, 2025

By: /Andrew R. Sommer/  
Andrew R. Sommer  
Reg. No. 53,932