

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

WILUS INSTITUTE OF STANDARDS AND TECHNOLOGY
INC.,
Patent Owner.

Case No. IPR2025-00935
U.S. Patent No. 11,129,163

**PATENT OWNER'S REQUEST FOR DISCRETIONARY
DENIAL OF INSTITUTION**

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
200 1	Order, <i>Wilus Institute of Standards and Technology Inc., v. HP Inc.</i> , Case No. 2:24-cv-00752-JRG-RSP, Dkt. No. 130 (June 11, 2025) (“Docket Control Order”)
200 2	Excerpt from Exhibit G-22 to Invalidity Contentions Served on February 13, 2025 in the consolidated case <i>Wilus Institute of Standards and Technology Inc., v. HP Inc.</i> , Case No. 2:24-cv-00752-JRG-RSP
200 3	Interim Processes For PTAB Workload Management, March 26, 2025, https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf
200 4	FAQs for Interim Processes for PTAB Workload Management), retrieved from https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management
200 5	Guidance on USPTO's rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation”, March 24, 2025, https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf
200 6	Excerpts from U.S. District Court – National Judicial Caseload Profile for the Eastern District of Texas, March 31, 2025, https://www.uscourts.gov/sites/default/files/document/fcms_na_dist_profile0331.2025.pdf
200 7	Screenshot regarding Judge Rodney Gilstrap's average time to trial from July 22, 2024 until July 22, 2025, retrieved from www.docketnavigator.com

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200 8	Excerpts from Invalidity Contentions Served on February 13, 2025 in the consolidated case <i>Wilus Institute of Standards and Technology Inc., v. HP Inc.</i> , Case No. 2:24-cv-00752-JRG-RSP
200 9	Dennis Crouch, Estoppel Guttled: A Pelican's Guide to Patent Litigation, https://patentlyo.com/patent/2025/05/estoppel-pelicans-litigation.html
201 0	Letter re "Notice of Wi-Fi 6 License offer" from Sisvel to Samsung Electronics Co., Ltd. with Attachments 1-2, April 8, 2022
201 1	Intentionally Omitted
201 2	Declaration of Jin Sam Kwak
201 3	List of Licensees to Wifi 6 from Sisvel, https://www.sisvel.com/licensing-programmes/Wi-Fi/wifi-6/#tab-list-of-licensees
201 4	U.S. Pat. No. 12,058,230
201 5	Excerpts of File History of U.S. Pat. No. 12,058,230

I. INTRODUCTION

The Board should exercise its discretion to deny this Petition because the patent at issue, U.S. Pat. No. 11,129,163 (the "'163 Patent"), is set to be tried in the U.S. District Court in the Eastern District of Texas ("EDTX") in less than a year, six months before the date of the Board's Final Written Decision. This trial will resolve Petitioner's validity challenges on the '163 Patent since Petitioner raised invalidity as a defense to infringement and validity issues may also be relevant to damages.

Granting institution of the Petition would not streamline issues or provide for a more efficient resolution of the parties' disputes. Two months prior to filing this Petition, the Petitioner had already elected to pursue its validity challenges in the district court by serving extensive invalidity contentions, including printed publications, system art, three out of the four references relied on in this Petition, along with many other references and obviousness combinations, as well as additional grounds of invalidity beyond novelty and obviousness. Given that the district court has an earlier trial date and can address all issues of validity concerning the '163 patent, even if a Final Written Decision is reached in this *inter partes* review ("IPR"), the Court would have already decided the issues months before. Therefore, the Director should exercise her discretion to deny the Petition to preserve efficiency and

to avoid inconsistent decisions.

Moreover, Samsung has delayed filing its validity challenges for years, which is another reason that the Petition should be denied. Samsung knew of the '163 Patent since at least April 2022, when it was approached with an offer for a license. Samsung did not file any invalidity challenges during this entire period. There was no *inter partes* review, post-grant review, reexamination request, or request for declaratory relief. And, of course, Samsung did not take a license to the '163 Patent. Even after this litigation was filed, Samsung waited for seven months to file this IPR. Given Samsung's delays, the IPR should not be instituted.

II. BACKGROUND

A. Background of the '163 Patent

The '163 Patent was filed on September 4, 2018, and is a continuation of PCT Application No. PCT/KR2017/002407 filed on March 6, 2017. SAMSUNG-1001 ('163 Patent) at Cover. It issued on September 21, 2021 and lists Geonjung Ko, Juhyung Son, Woojin Ahn, and Jinsam Kwak as inventors. Respondent Wilus Institute of Standards and Technology Inc. is the sole assignee of record.

The '163 Patent describes techniques for next-generation wireless communication technology that is capable of efficiently utilizing bandwidth

by simultaneously transmitting data between a plurality of terminals and base stations. *See* '163 Patent at 2:42-59. The '163 Patent is utilized by products that implement the Wi-Fi 6 (802.11ax) standard for wireless communications and is widely licensed by the industry.

Among other things, the '163 Patent addresses the issue of Basic Service Set (BSS) color collisions. The BSS color field is located in the high efficiency (HE PHY) physical layer header of a data unit. The BSS color is assigned a value from 0 to 63. The BSS color is a new feature that enables devices operating in the same frequency space to quickly distinguish between packets from their own BSS and those from an Overlapping BSS (OBSS), by simply referencing the BSS color value contained in the HE PHY header. In dense network environments, however, BSS color collisions occur when two or more BSSs operating on the same frequency channel use the same BSS color. *See* '163 Patent at 2:46-59, 10:41-62. The '163 Patent proposes solutions for handling BSS color-based operations in the presence of the BSS color collisions.

B. Related Proceedings

The '163 Patent is currently asserted in two co-pending litigations in the EDTX, both of which were filed on September 20, 2024. *Wilus Institute of Standards and Technology Inc., v. HP Inc.*, Case No. 2:24-cv-00764 (E.D.

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Tex.); *Wilus Institute of Standards and Technology Inc., v. Samsung Electronics Co. Ltd., Samsung Electronics America, Inc.*, Case No. 2:24-cv-00765 (E.D. Tex.). On October 23, 2024, the two cases were consolidated with four other cases into the lead case: *Wilus Institute of Standards and Technology Inc., v. HP Inc.*, Case No. 2:24-cv-00752-JRG-RSP (E.D. Tex.) (the “Co-Pending Litigation”). The Co-Pending Litigation is currently before Judge Rodney Gilstrap in the EDTX.

The Co-Pending Litigation is set for trial on June 1, 2026. Ex-2001 *Wilus Institute of Standards and Technology Inc., v. HP Inc.*, Case No. 2:24-cv-00752-JRG-RSP, Dkt. No. 130 (June 11, 2025) (“Docket Control Order”). This trial date is “a deadline that cannot be changed without an acceptable showing of good cause.” Ex-2001 (Docket Control Order) at pgs. 1, 5.

To date, the parties have exchanged infringement and invalidity contentions in the Co-Pending Litigation. Patent Owner served infringement contentions for the '163 Patent on November 18, 2024; and Petitioner served invalidity contentions on February 13, 2025.

The parties are scheduled to substantially complete document production on November 4, 2025 and complete fact discovery on December 22, 2025. Ex-2001 (Docket Control Order) at pg. 4.

The parties will exchange claim construction proposals in August and September 2025, and brief claim construction issues in November 2025, with the claim construction hearing currently set on December 16, 2025. *Id.* at pgs. 4-5.

C. This IPR Petition

Petitioner Samsung Electronics Co., Ltd., filed this Petition on April 30, 2025 on all claims of the '163 Patent (i.e., Claims 1-16). This Petition was filed seven months after Patent Owner's filing of the Complaint, five months after the infringement contentions, which identified the asserted claims (and thus placed Samsung on notice of the claims at issue), and two months after the Petitioner served invalidity contentions in the Co-Pending Litigation.

The Petition includes a 109-page expert declaration by Dr. Mark P. Mahon, and the Petition largely repeats the declaration. *See* SAMSUNG-1003. The Petition relies on four references: Lee (SAMSUNG-1005), Stacey (SAMSUNG-1006), Zhou (SAMSUNG-1007, SAMSUNG-1008), and Choudhury (SAMSUNG-1009). Notably, the Lee, Stacey, and Zhou references are already asserted in the invalidity contentions in the Co-Pending Litigation. Regarding Choudhury, the Petition cites its discussions on the 802.11 standard from 2016, and the invalidity contentions identify an earlier version of the 802.11 standard, i.e., the 2012 version, as prior art. *See, e.g.,*

Petition at pgs. 55-56; Ex-2002 (Invalidity Contentions G-22) at pg. 1.

III. LEGAL STANDARD

The Director has discretion to deny institution under 35 U.S.C. § 314(a). *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 136 S. Ct. 2131, 2140 (2016). In determining whether to deny institution, *Fintiv* balances considerations such as “system efficiency, fairness, and patent quality.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5 (P.T.A.B. May 13, 2020) (precedential) (hereinafter “*Fintiv*”). “When the patent owner raises an argument for discretionary denial under *NHK* due to an earlier trial date, the Board’s decisions have balanced the following factors:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Fintiv at pgs. 5-6.

The USPTO’s Process Memo¹ enumerated a number of additional

¹ Ex-2003 (Interim Processes For PTAB Workload Management Dated March 26, 2025, from Coke Morgan Stewart, the Acting Director of the USPTO),

considerations for discretionary denial, including:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

Process Memo at pgs. 2-3.

On April 25, 2025, the USPTO published frequently asked questions about the interim process (the “FAQs”)² and states that “[t]he information presented in the FAQs controls the interim process.” The FAQs include helpful guidance on the discretionary denial process.

For example, the answer to FAQ No. 20 states that “Parties are encouraged to address any fact or circumstance they believe bears on whether the Office should or should not institute trial, including reasons not discussed in current Board precedent or the Process Memorandum.”

retrieved from
<https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>.

² Ex-2004 (FAQs for Interim Processes for PTAB Workload Management), retrieved from <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>.

As another example, the answer to FAQ No. 14 suggests that a *Sotera* stipulation by the Petitioner may be of limited value if it does not materially reduce the overlaps with the co-pending litigation. FAQ No. 14 (“The Director will take into account whether the [*Sotera*] stipulation materially reduces overlap between the proceedings. Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited.”).

Yet another example, the answer to FAQ No. 21 states that failure to provide focused expert testimony may weigh against institution. FAQ No. 21 (“As the judges have technical and legal expertise, it is not necessary for an expert to explain every aspect of the prior art. It is most helpful if an expert is providing focused testimony, for example to provide helpful context or to explain terms of art. The failure to provide focused expert testimony may weigh against institution.”).

IV. THE BOARD SHOULD DENY INSTITUTION UNDER *FINTIV*

The Board should deny institution under 35 U.S.C. § 314(a) because the *Fintiv* Factors overwhelmingly support denying institution. *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) (“*Fintiv*”).

**A. *Fintiv* Factor 1: There is Little to No Likelihood that a Stay
Would be Granted in the Co-Pending Litigation**

Fintiv Factor 1 favors discretionary denial because no stay of the parallel district court litigation in EDTX has been granted, and there is no evidence that a stay will be granted.

In EDTX, “it is the universal practice” to deny pre-institution motions to stay. *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (“In this district, that is not just the majority rule; it is the universal practice. This Court's survey of cases from the Eastern District of Texas shows that when the PTAB has not yet acted on a petition for inter partes review, the courts have uniformly denied motions for a stay.”); *CyWee Grp. Ltd. v. Samsung Elecs. Co.*, 17-cv-140, 2019 WL 11023976, *5 (E.D. Tex. Feb. 14, 2019) (“It would have been virtually pointless for Samsung to have sought a stay before the IPR was instituted, as this Court would have almost certainly denied it; the decisions of courts in this district as well as other district courts make that abundantly clear.”). Here, a request to stay has not been filed by anyone in the Co-Pending Litigation, and this IPR has not been instituted. It is unlikely that a stay will be granted considering the Court's precedent.

The facts do not support a stay either. First, the deadline for the Final Written Decision (FWD) is well after the trial date. The trial date in the Co-

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Pending Litigation is set on June 1, 2026, and it cannot be changed absent an “acceptable showing of good cause.” Ex-2001 (Docket Control Order) at pgs. 1, 5. On the other hand, the date for FWD is on December 2, 2026, 6 months *after* the trial date. Since the trial will occur many months before the FWD, a stay is unlikely, and Judge Gilstrap has declined to stay the district court litigation in similar situations. *See, e.g., MyPort, Inc. v. Samsung Electronics Co., et al.*, No. 2:22-cv-00114-JRG, Dkt. No. 73, slip. op. at 4 (E.D. Tex. June 12, 2023) (denying a stay where the PTAB decision is not due until over two months after jury trial is set to begin); *Orckit Corporation v. Cisco Systems, inc.*, No. 2:22-cv-00276-JRG-RSP, Dkt. No. 56, slip. op. at 2 (E.D. Tex. March 29, 2023) (denying a stay where the FWD is 6 months after the scheduled trial date). Apparently recognizing the unlikelihood of a stay, Samsung has not even bothered to ask the Court for the same.

Second, a stay is unlikely given Petitioner's delay in filing the IPR. Petitioner filed this IPR *years* after it was first approached for a license to the '163 Patent, seven months after Patent Owner filed the district court case and five months after service of the infringement contentions. Judge Gilstrap has found Petitioner's delay in filing the Petition weighs against granting a motion to stay, even if the request to stay is filed today. *See, e.g., Tessera Advanced Technologies, Inc. v. Samsung Electronics Co.*, No. 2:17-cv-00671-

JRG, 2018 WL 3472700, *3 (E.D.Tex. July 19, 2018) (finding IPRs filed nine months after initiation of the lawsuit and five months after service of infringement contentions weighed against a motion to stay); *Resonant Sys., Inc. v. Sony Grp. Corp.*, No. 2:22-cv-00424-JRG, Dkt. No. 84, slip op. at 4-5 (E.D. Tex. Jul. 9, 2024) (Judge Gilstrap found that a delayed IPR filing tips the “stage of litigation” factor against a stay, even if claim construction, fact discovery, and expert discovery had not been completed when the motion to stay was filed.).

Where the district court litigation has not been stayed, and any stay is unlikely and at best speculative, allowing this IPR to proceed in parallel would be wasteful and inefficient. *Samsung Elecs. Co. v. Clear Imaging Research, LLC*, IPR2020-01552, Paper 12, 12-13 (P.T.A.B. Mar. 3, 2021) (denying institution because, in part, Judge Gilstrap deemed unlikely to stay a case in similar circumstances). Because there is little to no likelihood that the district court will stay the Co-Pending Litigation, *Fintiv* Factor 1 weighs in favor of denying institution.

B. *Fintiv* Factor 2: The District Court's Scheduled Trial Date is Approximately 6 Months Before the Expected Date of Any Final Written Decision

Fintiv Factor 2 strongly favors discretionary denial because the trial date is months before the date of the FWD. “If a district court’s trial date is

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earlier than the Board's projected statutory deadline for a final written decision, the Board generally has weighed this fact in favor of exercising discretion to deny institution." *T-Mobile USA, Inc., et al. v. Wireless Alliance*, IPR2024-00608, Paper 16 (P.T.A.B. Sept. 3, 2024) (denying institution of IPR).

The jury selection in the Co-Pending Litigation is scheduled to begin on June 1, 2026. Ex-2001 (Docket Control Order) at pg. 1. This trial date cannot be moved absent an acceptable showing of good cause. *Id.* at pg. 5 (trial date is "a deadline that cannot be changed without an acceptable showing of good cause."). The trial date is *six months* before the date of FWD (December 2, 2026). This timing strongly favors discretionary denial. *See, e.g., Lenovo Inc. v. Universal Connectivity Techs., Inc.*, No. IPR2024-01481, Paper 19 at 10-11 (P.T.A.B. Apr. 17, 2025) (finding Factor 2 strongly favored discretionary denial where Board's final written decision expected six months after trial according to scheduling order or nine months after according to time-to-trial statistics for court); *Roku, Inc. v. IOENGINE, LLC*, No. IPR2022-01553, Paper 11 at 10-11 (P.T.A.B. May 5, 2023) (finding Factor 2 strongly favored discretionary denial where Board's final written decision is expected six months after scheduled trial date).

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In addition to the already set trial date, the recent median time-to-trial statistics weigh against institution. Ex-2005, https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_int_eri_m_procedure_recission_20250324.pdf at pg. 3 (“in applying *Fintiv*, the Board may consider any evidence ... including median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides.”). According to the Federal Courts’ website, the median time from filing to trial in the EDTX is 25.9 months for the 12-month period ending on March 31, 2025. Ex-2006, https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0331.2025.pdf. This timeline is similar to Judge Gilstrap’s time-to-trial statistics. Judge Gilstrap has an average and median time of 24 months from filing to trial over the last 365 days, according to statistics on DocketNavigator. Ex-2007 (DocketNavigator Screenshot). Accordingly, even considering these statistics, the trial would still have already occurred several months (e.g., in September 2026) before the FWD in December 2026.

In situations where the underlying litigation is in the EDTX and the projected trial date is before the FWD date, the Board has consistently found this factor weighs in favor of denying institution. *See, e.g., EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022)

(finding this factor weighed in favor of discretionary denial and denying institution where “the beginning of the jury trial in the WDTX Cases is roughly *one or two months* before any final decision would have been due had *inter partes* review been instituted”); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (PTAB May 13, 2020) (informative) (finding this factor weighed in favor of discretionary denial and denying institution where the district court trial was scheduled to occur *two months* before the deadline for the Board to reach a final written decision); *Samsung Elecs. Co. v. Secure Wi-Fi LLC*, No. IPR2024-01367, Paper 10 at 12-13 (P.T.A.B. Mar. 24, 2025) (finding that Factor 2 weighed heavily in favor of denial and recognizing Judge Gilstrap’s time-to-trial statistics as lending credibility to scheduled trial date, which was set to occur five months before final written decision deadline). Therefore, the Board should exercise its discretion to deny institution under *Fintiv* Factor 2.

C. *Fintiv* Factor 3: Significant Investment in the Parallel Litigation Will Have Occurred by the Time the Board’s Institution Decision is Due

Factor 3 relates to the “amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv* at 9. This factor favors discretionary denial. The close of fact discovery and the institution decision for this IPR are both due in December

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2025. Parties will have expended substantial resources in the Co-Pending Litigation, e.g., for discovery and claim construction briefing, as well as to develop their respective litigation positions, leading up to the due dates.

The parties have been engaged in extensive discovery. The infringement contentions were served on November 18, 2024 and invalidity contentions were served on February 13, 2025. The parties have both issued and responded to interrogatory requests and are conducting third-party discovery. Both parties have also issued document requests and produced extensive documents. Petitioner has issued 122 document requests, and Patent Owner has issued 78 document requests. Patent Owner has also issued subpoenas for documents and depositions to four third-parties, including suppliers of Wi-Fi chips used in Samsung's accused products. It expects that discovery under these subpoenas will be complete in advance of the deadline for the institution decision.

Document production is set to be substantially complete one month prior to the institution decision being due. Ex-2001 (Docket Control Order) at pg. 4. The parties are expected to produce substantial volumes of documents prior to this deadline. The parties are also expected to invest in resources in motion practice for various disputes arising from the discovery.

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Furthermore, given that the close of fact discovery and the deadline for institution are both in December 2025, the parties will have spent substantial resources to develop their positions prior to institution. The parties will have spent significant time and resources to prepare and take depositions. The parties will likely have started preparing expert reports prior to the institution decision.

Moreover, the parties will have spent substantial time and resources to prepare claim construction briefs and exchanges. By the time institution decision is due, claim construction in the Co-Pending Litigation will be fully briefed, and the claim construction hearing will be 2 weeks away. Ex-2001 (Docket Control Order) at pg. 4. Although the Board has found that this factor is neutral when the *Markman* hearing occurs after institution, the other significant investment in this case weighs against institution. *See. Dell Inc. et al. v. Universal Connectivity Technologies Inc.*, IPR2024-01479, Paper 11, 6-7 (P.T.A.B. Apr. 7, 2025) (finding this factor neutral when claim construction briefing has been completed and claim construction hearing is scheduled soon after institution decision); *BOE Tech. Grp. Co. v. Element Capital Commercial Co.*, IPR2023-00808, Paper 9 at 23-24 (P.T.A.B. Nov. 15, 2023) (denying institution in part because “[s]ignificant discovery has been completed, including the exchange of infringement and invalidity contentions, document

requests and interrogatories, and proposed claim terms for construction, and ... close of fact discovery is near"). Therefore, Factor 3 is also in favor of denial.

D. *Fintiv* Factor 4: There is Substantial Overlap Between the IPR Proceeding and the Parallel Litigation

Factor 4 looks at “whether all or some of the claims challenged in the petition are also at issue in district court” and whether the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as the parallel district court case. *Fintiv* at 12-13. Here, the validity challenges in the Co-Pending Litigation encompass the challenges in this IPR, as well as additional grounds of invalidity. And the court will adjudicate the validity challenges earlier, prior to the FWD. Allowing this IPR to proceed would result in inefficiencies, waste, and delays; and may cause inconsistencies or tensions between the jury and the PTAB.

Claims 1-16 of the '163 Patent are currently asserted in the Co-Pending Litigation. The Petition challenges this same set of claims. Petitioner served extensive, voluminous (over 1000 pages) invalidity contentions on February 13, 2025, two months *before* the filing of this IPR. The invalidity contentions include 24 alleged primary prior art references and 9 alleged prior art systems or products, along with many other background art and numerous unspecified combinations, all asserted against the '163 Patent. Ex-2008 (Invalidity

Contentions, Cover Pleading) at pgs. 62-67, 340-393. The Petitioner also asserts patent ineligibility under 35 U.S.C. § 101 along with the invalidity contentions. The invalidity contentions are comprehensive challenges to the invalidity of the '163 Patent.

There are considerable overlaps between the validity challenges in the district court and here. Three out of the four total references in the Petition are recycled from the invalidity contentions. For example, Petitioner's primary reference Lee, and secondary references Zhou and Stacey in this IPR are all asserted as prior art and charted in the invalidity contentions in the Co-Pending Litigation. Regarding the fourth reference, Choudhury, the Petition refers to its discussions of the 2016 IEEE 802.11 standard (*see, e.g.*, Petition at p. 56). However, the invalidity contentions already identified and charted the earlier 2012 version of the IEEE 802.11 standard as prior art. Ex-2002 (Invalidity Contentions, G-22) at pg. 1.

The Petitioner's stipulation that it will not pursue invalidity grounds in district court that could have been raised under §§ 102 or 103 on the basis of prior art patents or printed publications is of limited value and does not outweigh the other *Fintiv* factors. This statement does not make the IPR proceeding a "true alternative" to the district court proceeding." *Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-01019, Paper 12 at 19 (P.T.A.B.

Dec. 1, 2020). Indeed, the Federal Circuit has recently held that “IPR estoppel does not preclude a petitioner from relying on the same patents and printed publications as evidence in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use.” *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1366 (Fed. Cir. 2025). This holding at the very least suggests the possibility that Samsung could present in district court precisely the same combinations of prior art references, not as patent or printed publication “grounds,” but rather as the evidence for “grounds” of what was “in public use, on sale, or otherwise available to the public” (35 U.S.C. § 102(a)(1)) and that neither IPR estoppel nor Samsung’s carefully worded stipulation would prevent such an invalidity argument that duplicated the prior art combinations presented in its IPR petition. *See* Ex-2009 (D. Crouch, *Estoppel Gutted: A Pelican’s Guide to Patent Litigation*, Patently-O, <https://patentlyo.com/patent/2025/05/estoppel-pelicans-litigation.html> (May 7, 2025)).

In addition, the Petitioner has asserted both system art and public knowledge art in the Co-Pending Litigation, including in combinations with patents and printed publications which are not covered by Petitioner’s stipulation. *See, e.g.*, Ex-2008 (Invalidity Contentions, Cover Pleading) at pgs. 366-393 (listing many dozens of purported combinations of patents and

printed publications with “Systems implementing IEEE 802.11ac” or “Knowledge of a person of ordinary skill”); SAMSUNG-1022 (Petitioner did not agree to drop all combinations of patents and printed publications with system or public knowledge art). The Petitioner also sets forth additional grounds of invalidity in the Co-Pending Litigation. The USPTO’s answer to FAQ No. 14 explicitly states that “[w]here the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful.” The Director’s recent decision in *Motorola Solutions, Inc. v. Stellar, LLC* also highlights the non-dispositive nature of this type of stipulation. *Motorola Solutions, Inc. v. Stellar, LLC*, No. IPR2024-01205, Paper 19 at 2, 4 (P.T.A.B. Mar. 28. 2025) (vacating and denying institution because the “Board did not give enough weight to the investment in the parallel proceeding and gave too much weight to Petitioners’ Sotera stipulation.”). There may be direct overlap between the disclosures of the Lee, Stracey, Zhou, and Choudhury references relied upon in this IPR and the “Systems implementing IEEE 802.11ac” or “Knowledge of a person of ordinary skill” that Samsung may seek to rely upon in the district court case. And Samsung’s many dozens of combinations of patents and printed publications with systems or public knowledge in its district court contentions encompass numerous prior art combinations that it

could have raised in substance in an IPR—for example by relying upon the IEEE 802.11ac standard itself rather than systems implementing it—but that Samsung chose not to.

Furthermore, Samsung's stipulation does not prevent duplicative grounds from being raised in the Co-Pending Litigation. Defendants Samsung and HP in the Co-Pending Litigation *jointly* served invalidity contentions, even though HP did not join this IPR. These invalidity contentions explicitly incorporate by reference the IPRs. Ex-2008 (Invalidity Contentions, Cover Pleading) at pg. 6. But Samsung's carefully crafted stipulation does not prevent the other Defendant, i.e., HP, from raising, in the district court, the same references used in this Petition.

For all of these reasons, Samsung's narrowly tailored stipulation does not meaningfully narrow the invalidity issues Samsung may present in district court or ensure that this IPR is a "true alternative." Particularly in view of the Federal Circuit's decision in *Ingenico*, for a stipulation to prevent overlap between the IPR and district court proceedings and to be given weight in avoiding discretionary denial, that stipulation should agree to forgo any use of patents or printed publications as evidence of prior art, whether alone or as a combination, and under any ground, including public use, public sale, and otherwise available to the public grounds. Because Samsung's stipulation falls

far short of doing so, it should not be permitted to outweigh the other *Fintiv* factors that strongly favor denial of institution.

Just as the PTAB's resources are not used efficiently when similar challenges based upon patents and printed publications are pursued by the petitioner in district court, they are also not used efficiently when a Petitioner that fails to invalidate claims in its IPR is free to file *ex parte* reexaminations challenging the same patent on grounds that they could have raised in their IPR. Samsung's failure to address potential subsequent *ex parte* reexaminations in its stipulation is another reason it should be given little weight.

In short, the Petition challenges the claims asserted in the parallel litigation, and the Samsung Petitioners rely on references that are the same or similar to its IPR references at the district court. And Samsung's carefully worded stipulation does not prevent the art used in this Petition or similar prior art arguments to be made again in the Co-Pending Litigation. This raises substantial "concerns of inefficiency and the possibility of conflicting decisions," weighing against institution. *See Fintiv* at 12. Therefore, Factor 4 weighs strongly in favor of denial.

E. *Fintiv* Factor 5: Petitioner is the Defendant in the Parallel Proceeding

Fintiv Factor 5 weighs in favor of discretionary denial because the parties are the same in both proceedings. *Fintiv*, Paper 11 at 13-14. The Petition has indicated that the real parties-in-interest are Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. These are the same defendants in *Wilus Institute of Standards and Technology Inc., v. Samsung Electronics Co., Ltd., Samsung Electronics America, Inc.*, No. 2:24-cv-00764 (E.D. Tex.), where the '163 Patent is asserted.

F. *Fintiv* Factor 6: The Petition Lacks Merit

Fintiv Factor 6 weighs in favor of denying institution if the Board deems analysis of this factor necessary.

Given the other *Fintiv* Factors favoring denial, the Board need not consider the merits under Factor 6. *NXP USA, Inc. v. Impinj, Inc.*, No. PGR2022-00005, Paper 18 at 12-13 (P.T.A.B. May 2, 2022) (the Board “need not decide whether the merits of Petitioners’ asserted grounds are particularly strong because it would not impact [their] ultimate determination” since the facts weighing in favor of discretionary denial based on the other factors collectively outweigh the merits.).

But even if the merits of the Petition were to be considered, Factor 6 favors discretionary denial because the Petitioner failed to show a reasonable

likelihood of success on any challenged claims, as the Petitioner expects to set forth in the Patent Owner Preliminary Response.

V. ADDITIONAL CONSIDERATIONS FAVORING DENIAL

1. Petitioner's Use of Expert Testimony Weighs in Favor of Discretionary Denial

Petitioner submitted a 109-page expert declaration along with its Petition. Rather than providing “helpful context or to explain terms of art,” (FAQ No. 21), the declaration is riddled with conclusory statements and is essentially a mirror image of the Petition. *See* SAMSUNG-1003.

As one example, Petition's arguments for Claim 1 in view of Lee are nearly identical copies from the expert declaration. *See, e.g., compare* Petition at pgs. 9-15, *with* SAMSUNG-1003 (Mahon Decl.) at ¶¶ 83-93. The remaining arguments in the Petition fare no better, as they are similarly lifted from the expert declaration. This “failure to provide focused expert testimony” weighs against institution. FAQ No. 21.

Indeed, USPTO has suggested, in its FAQs, “as a matter of efficiency, extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court.” FAQ No. 21. The situation here is no different, and the Board should deny institution for efficiency. The Petition is essentially a copycat of the expert declaration, which the Patent Owner plans to address in

its Preliminary Response. Moreover, the Petitioner already pursued the same art in the district court prior to filing this Petition, and the district court will likely adjudicate invalidity issues before the FWD. The district court is in the best and most efficient position to resolve the parties' disputes regarding the validity issues.

2. Petitioner's Delay in Filing the IPR and Wide Licensing Demonstrates Settled Expectation of the Patent's Validity

The USPTO encourages the parties to discuss "any fact or circumstance they believe bears on whether the Office should or should not institute trial, including reasons not discussed in current Board precedent or the Process Memorandum." FAQ No. 20.

The '163 Patent is practiced by products that implement the IEEE Wi-Fi 6 standard (802.11ax). This standard has been widely recognized and used by the communications industry. *See* Ex-2012, Kwak Decl. ¶ 3. The '163 Patent has been licensed by more than 30 companies in the communications industry, including many well-known names such as Cisco and Lenovo. Ex-2012, Kwak Decl. ¶ 4; Ex-2013, <https://www.sisvel.com/licensing-programmes/Wi-Fi/wifi-6/#tab-list-of-licensees>. This industry-wide licensing supports an expectation that the patent is valid. *See Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 55-56 (1923) ("the makers of two-thirds of the print paper of the country are licensees" of the plaintiff which

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constitutes “very weighty evidence to sustain the presumption from his patent that what he discovered and invented was new and useful.”).

In addition, Samsung delayed filing the IPR despite receiving actual notice. The '163 patent was issued on September 21, 2021. Samsung was notified of this Patent on April 8, 2022, when it was sent a letter on Wilus's behalf that identified the '163 Patent as essential to the Wi-Fi 6 Standard and offered Samsung a license to this patent. Ex-2010 (Notice Letter) at 1, 4; Ex-2012, Kwak Decl. ¶ 5. On April 13, 2023, Samsung received further notice of the '163 Patent, when the examiner provided Samsung the list of references cited by the examiner for Samsung's 12,058,230 patent as “considered pertinent to the applicant's disclosure.” Ex-2014 (U.S. Pat. No. 12,058,230) at Cover (listing the '163 Patent as a reference cited by the Examiner); Ex-2015 (Excerpt of File History of U.S. Pat. No. 12,058,230) at pgs. 23, 26 (listing the '163 Patent as prior art “considered pertinent” and in the Notice of References Cited). Samsung did not file an IPR for over three years after learning of the '163 patent through the offer to license, until after the Patent Owner had initiated litigation in the district court. Even then, Samsung waited for seven months to file the IPR. Although “actual notice of a patent or of possible infringement is not necessary to create settled expectations” (*Dabico Airport Sols. V. AXA Powers ApS*), Samsung's delay in challenging the validity

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of the '163 Patent after receiving actual notice supports that there is an expectation of the validity of the patent. *Dabico Airport Sols. v. AXA Power ApS*, IPR2025-00408, paper 21 at pg. 3 (P.T.A.B. June 18, 2025). And this expectation of validity is further magnified by the recognition of the of the industry through licensing agreements with the Patent Owner.

VI. CONCLUSION

Accordingly, the Board should exercise its discretion to deny institution of the Petition.

Dated: July 30, 2025

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

I certify that there are 5,675 words in this paper, excluding the portions exempted under 37 C.F.R. § 42.24(a)(1), according to the word count tool in Microsoft Word.

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Patent Owner's Request for Discretionary Denial
IPR2025-00935 (U.S. Patent No. 11,129,163)

CERTIFICATE OF SERVICE

I hereby certify that "Patent Owner's Request for Discretionary Denial"
was served on July 30, 2025 by email sent to:

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