

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

HANNIBAL IP LLC,
Patent Owner.

Case IPR2025-01187
Patent No. 11,057,896

**PATENT OWNER HANNIBAL IP LLC's REQUEST TO DIRECTOR FOR
DISCRETIONARY DENIAL OF PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT 11,057,896**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	FACTUAL BACKGROUND.....	2
	A. The '896 Patent	2
	B. Samsung's Prior Knowledge of the '896 Patent and Other Patents	3
	C. The Litigation Between Hannibal and Samsung.....	3
	D. Schedule in this IPR Proceeding	4
III.	INSTITUTION OF INTER PARTES REVIEW SHOULD BE DENIED	4
	A. Overview of the Petition	5
	B. The Unpatentability Challenge is Weak	5
	1. Petitioner Fails to Establish <i>Intel</i> and <i>ZTE</i> as Prior Art.....	5
	a. Mr. Rodermund has no personal knowledge regarding the <i>Intel</i> or <i>ZTE</i> references or when these references were available through the 3GPP website.....	6
	b. Petitioner fails to show a reasonable likelihood that <i>Intel</i> and <i>ZTE</i> were publicly accessible.	8
	2. Alleged Prior Art Cited by Petitioner is Substantially the Same Art Already Considered by the USPTO and Cited on the Face of the Patent	11
	C. Patent Owner had Established Expectations Based Samsung's Longstanding Knowledge of the '896 Patent.....	16

D. Other Factors18

 1. Trial Likely to Occur Before Projected FWD.....18

 2. A Stay of the District Court Proceedings is Unlikely19

IV. CONCLUSION.....20

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple, Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (March 20, 2020)	1
<i>AR Design Innovations LLC v. Ashley Furniture Indus., Inc.</i> , No. 4:20-cv-392-SDJ, 2021 WL 6496714 (E.D. Tex. Jan. 11, 2021)	19
<i>EClinicalWorks, LLC v. Decapolis LLC</i> , IPR2022-00229, Paper 10 (P.T.A.B. Apr. 13, 2022)	18
<i>Ericsson Inc. v. Active Wireless Techs. LLC</i> , IPR2024-00886, Paper 8 (P.T.A.B. Nov. 12, 2024).....	18
<i>iRhythm Techs., Inc. v. Allyn</i> , IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025)	17
<i>Luminati Networks Ltd. v. Teso LT, UAB</i> , No. 2:19-CV-00395-JRG, 2020 WL 6803255 (E.D. Tex. Oct. 30, 2020)	19
<i>MyPort, Inc. v. Samsung Elecs. Co., Ltd.</i> , No. 2:22-cv-00114-JRG, Dkt. 73 (E.D. Tex. June 13, 2023).....	20
<i>Nokia of America v. IPCOM, GmbH & Co. KG</i> , IPR2021-00533, Paper 10 (P.T.A.B. Aug. 12, 2021).....	10, 11
<i>Nvidia Corp. v. Neural AI, LLC</i> , IPR2025-00606, Paper 18 (P.T.A.B. July 31, 2025).....	17
<i>NXP USA, Inc. v. Redstone Logics LLC</i> , IPR2025-00485, Paper 11 (P.T.A.B. July 10, 2025).....	19
<i>Orion IP, LLC v. Hyundai Motor America</i> , 605 F.3d 967 (Fed. Cir. 2010)	2, 8, 11
<i>Samsung Elecs. Co., Ltd. v. Cerence Operating Co.</i> , IPR2025-00458, Paper 14 (P.T.A.B. June 25, 2025)	20

Samsung Elecs. Co., Ltd. v. Sinotechnix LLC,
IPR2025-00331, Paper 13 (P.T.A.B. July 2, 2025).....18

Samsung Electronics Co., Ltd. v. Genghiscomm Holdings LLC,
IPR2025-00793, Paper 11 (P.T.A.B. Aug. 22, 2025).....17, 19

Solas OLED Ltd. v. Samsung Display Co., Ltd.,
No. 2:19-CV-00152-JRG, 2020 WL 4040716 (E.D. Tex. July 17,
2020)20

SRI Int’l, Inc. v. Sec. Sys., Inc.,
511 F.3d 1186 (Fed. Cir. 2008)9

Stellar LLC v. Motorola Solutions, Inc.,
No. 4:23-cv-750-SDJ, Dkt. 50 (E.D. Tex. Aug. 9, 2024).....18

Trover Grp., Inc. v. Dedicated Micros USA,
No. 2:13-CV-1047-WCB, 2015 WL 1069179 (E.D. Tex. Mar. 11,
2015)19

Statutes

35 U.S.C. §§ 314(a) and 324(a)1

Other Authorities

37 C.F.R. § 42.2422

37 C.F.R. § 42.62(a).....2

FED. R. EVID. 901(a)(1)2, 6

<https://www.uspto.gov/patents/ptab/interim-director-discretionary>22

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2002	Letter from Hannibal's counsel to Samsung dated June 8, 2022
2003	<i>Order Governing Proceedings</i> in the U.S. District Court for the Eastern District of Texas, Case 4:25-cv-00200-SDJ dated July 24, 2025
2004	3GPP Terms of Use
2005	<i>Stellar LLC v. Motorola Solutions, Inc.</i> , No. 4:23-cv-750-SDJ, Dkt. 50 (E.D. Tex. Aug. 9, 2024)
2006	<i>MyPort, Inc. v. Samsung Elecs. Co., Ltd.</i> , No. 2:22-cv-00114-JRG, Dkt. 73 (E.D. Tex. June 13, 2023)

Patent Owner, Hannibal IP LLC (“Hannibal” or “Patent Owner”), requests that the Deputy Director of the U.S. Patent and Trademark Office (“USPTO”) exercise her discretion to deny institution in this *inter partes* review proceeding pursuant to the Director’s Memorandum “Interim Processes for PTAB Workload Management” dated March 26, 2025 (the “March 26th Memo,”) and 35 U.S.C. §§ 314(a) and 324(a).

I. INTRODUCTION

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (“Petitioners” or “Samsung”) filed their Petition for *inter partes* review (“IPR”) of U.S. Patent No. 11,057,896 (the “’896 Patent”) titled “Methods and Apparatuses of Determining Quasi Co-Location (QCL) Assumption for Beam Operations” (the “Petition”) on July 29, 2025. As discussed below, the relevant factors enumerated in the March 26th Memo weigh in favor of denial. *Id.*; *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (March 20, 2020) (precedential). For example, the unpatentability challenge is weak because the Petition relies on two 3GPP working group proposals (Exs. 1006 and 1011) that Petitioner failed to qualify as prior art. Indeed, Petitioner relies solely on the opinion of its expert—who has no personal knowledge—to attempt to establish the authenticity and accessibility of the references. But the expert’s testimony simply parrots inadmissible hearsay. With no personal knowledge or underlying facts, Petitioner cannot establish these

documents as prior art as a matter of law. 37 C.F.R. § 42.62(a) (“the Federal Rules of Evidence shall apply to a proceeding.”); FED. R. EVID. 901(a)(1) (requiring testimony of a witness *with knowledge*); *Orion IP, LLC v. Hyundai Motor America*, 605 F.3d 967, 974 (Fed. Cir. 2010) (“Whether a document constitutes a printed publication under § 102 is a question of law based upon the underlying facts of each particular case.”). Even assuming Petitioner adequately qualified these references as prior art—which Petitioner did not—the two references are substantially similar to art already considered during prosecution.

Further, Samsung has known of the ’896 Patent and its infringement since at least June 2022, more than three years before Samsung filed its Petition. Finally, trial in the underlying litigation will likely occur before a final written decision is due for the instant Petition, if this matter is instituted. For these reasons, the Petition should be denied.

II. FACTUAL BACKGROUND

A. The ’896 Patent

The ’896 Patent issued on July 6, 2021, and claims priority to U.S. Patent Application No. 62/754,165, filed on November 1, 2018. The ’896 Patent is directed at solving the problem of unfavorable beam switching in 5G wireless communication when User Equipment (UE) is configured with multiple CORESETs. The ’896 Patent provides a solution to this problem through the

strategic application of Quasi-Co-Location (QCL) assumptions, among other things.

B. Samsung's Prior Knowledge of the '896 Patent and Other Patents

Samsung received express notice of the '896 Patent and its infringement on June 8, 2022, when Hannibal sent a letter to Samsung. Ex. 2002. The letter listed the '896 Patent, as well as two other patents in Hannibal's portfolio, and stated that "[Samsung] infringe[s] at least the claims of the above-identified patents identified in the table below by making, using, selling, offering for sale, importing into the United States Samsung's 5G compliant devices." Ex. 2002 at 1. The referenced table included a list of nine claims from the '896 Patent that Samsung infringed. Ex. 2002 at 2. On July 21, 2022, Hannibal provided Samsung claim charts for the '896 Patent describing its infringement.¹

C. The Litigation Between Hannibal and Samsung

Following years of discussions, on February 27, 2025, Hannibal filed its Complaint seeking relief for Samsung's infringement of four patents, including the '896 Patent, in the U.S. District Court for the Eastern District of Texas, Case 4:25-

¹ Hannibal and Samsung entered into a Non-Disclosure Agreement on July 12, 2022.

cv-00200-SDJ (the “Litigation”).² The accused products are consumer devices such as smartphones and tablets. Samsung answered on June 16, 2025. On July 24, 2025, the Court issued its Order Governing Proceedings providing certain case deadlines (the “Order”). Ex. 2003. Based on that Order the Final Pre-Trial Conference is set for November 18, 2026. *Id.* No trial date was set, but in view of the Court’s practice, the trial is likely to be set in late November or early December 2026.

D. Schedule in this IPR Proceeding

Samsung filed its Petition on July 29, 2025, which was accorded that filing date by the Notice of Filing Date Accorded mailed August 6, 2025. Hannibal’s Preliminary Response is due November 6, 2025. The Board’s decision on institution must be made by February 6, 2026. The Board’s Final Written Decision (“FWD”) must be issued before February 6, 2027. Notably, the FWD will most likely issue *after* the jury trial in the Litigation.

III. INSTITUTION OF INTER PARTES REVIEW SHOULD BE DENIED

Of the seven factors listed in the March 26th Memo, four apply to the facts of this case and weigh in favor of denial: (1) the unpatentability challenge is weak;

² Samsung has filed three other Petitions for *inter partes* review against U.S. Patent Nos. 11,272,535, 11,368,911, and 11,641,661 (IPR2025-01188, IPR2025-01189, and IPR2025-01190, respectively) asserted by Hannibal in the Litigation.

(2) the petition relies heavily on expert testimony, (3) Samsung has known of the patent and its infringement for over three years creating settled expectations, and (4) trial in the underlying lawsuit will occur before a final written decision is due.

A. Overview of the Petition

Petitioner challenges all claims on four obviousness grounds. *See* Petition at 19. Specifically, in Ground 1, Petitioner challenges Claims 1-19 and 11-19 as obvious based on *Guo* (Ex. 1005) in view of *Intel* (Ex. 1006). In Ground 2, Petitioner challenges Claim 10 as obvious based *Guo* (Ex. 1005) in view of *ZTE* (Ex. 1011). In Ground 3, Petitioner challenges Claims 1-9 and 11-19 as obvious based on *5G-Standard* (Ex. 1012) in view of *Intel* (Ex. 1006). In Ground 4, Petitioner challenges Claims 1-9 and 11-19 as obvious based on *5G-Standard* (Ex. 1012) in view of *ZTE* (Ex. 1011).

B. The Unpatentability Challenge is Weak

1. Petitioner Fails to Establish *Intel* and *ZTE* as Prior Art.

The unpatentability challenge is weak at least because Petitioner fails to provide competent evidence to establish the publication date and public accessibility of 3GPP working group proposals, *Intel* (Ex. 1006) and *ZTE* (Ex. 1011), that form the basis of each Ground asserted in the Petition.

Samsung relies on the testimony of Mr. Friedhelm Rodermund in its attempt to prove up the authenticity and public accessibility of the *Intel* and *ZTE*

references. *See e.g.*, Petition at 16-17; Ex. 1029 at ¶ 2, 20, 25. But Mr. Rodermund's Declaration (Ex. 1029) does not reveal any personal knowledge of the documents, the date the purported prior art was available through the 3GPP website, or 3GPP's publication practices after he left ETSI in 2004—and especially not in the relevant time frame of 2018. Further, Mr. Rodermund's declaration fails to establish that the working group proposals were disseminated or otherwise made accessible to persons interested and ordinarily skilled in the subject matter before the priority date of the '896 Patent.

a. Mr. Rodermund has no personal knowledge regarding the *Intel* or *ZTE* references or when these references were available through the 3GPP website.

Mr. Rodermund purports to opine on the authenticity and availability of the *Intel* and *ZTE* references. Ex. 1029 at ¶¶ 20, 25. But Mr. Rodermund lacks personal knowledge of either reference. FED. R. EVID. 901(a)(1) (requiring testimony of a witness *with knowledge*). Mr. Rodermund is not an author or contributor to either reference. Nor does Mr. Rodermund testify that he received, reviewed, or even knew of either reference before November 1, 2018, the priority date of the '896 Patent.³ *See* Ex. 1029. Indeed, Mr. Rodermund makes no contention that he has personal knowledge of these documents. *See id.*

³ Petitioner does not challenge the priority date of the '896 Patent.

Further, Mr. Rodermund has no personal knowledge of the creation of date stamps, metadata, and other information associated with the *Intel* and *ZTE* references from 3GPP's FTP server. Mr. Rodermund does not testify that he uploaded the information to the 3GPP's FTP server, nor does he identify any individuals who did. Similarly, Mr. Rodermund does not testify that he, nor any other individual, downloaded or otherwise accessed the *Intel* and *ZTE* references via 3GPP's FTP server before November 1, 2018. At best, Mr. Rodermund merely parrots inadmissible hearsay from the 3GPP website. *See e.g., id.* at ¶ 63 (“Based on my personal knowledge *and my review of 3GPP's business records*”) (emphasis added);⁴ ¶ 64 (“*On its face*, R1-1808197 refers to the RAN WG1 meeting #94 held on August 20th-24th, 2018...*this information tells me* that R1-1808197 was available either prior to or during or shortly after that meeting to at least all attending 3GPP members”) (emphasis added); ¶ 65 (“public availability of the document is confirmed by the date stamp [on the 3GPP FTP server].”). Mr. Rodermund is not the custodian of these records and has not even been employed by 3GPP or ETSI for over twenty years. *See e.g., Ex. 1029* at ¶ 3 (confirming employment only between 1998 to 2004), ¶¶ 63-71 (basing entire opinion on information from 3GPP website); and ¶¶ 109-117 (same). Accordingly, Mr.

⁴ Mr. Rodermund's personal knowledge is limited to “3GPP's standard business and records keeping practices” from June 1998 through December 2004. *See Ex. 1029* at ¶ 3.

Rodermund is unable to confirm the accuracy or reliability of the date information currently provided by the 3GPP website, let alone as of the priority date for the '896 Patent.

Moreover, Mr. Rodermund's assertions are directly contradicted by 3GPP and ETSI's own official statements. Indeed, 3GPP and ETSI expressly disclaim the accuracy or reliability of any information contained on the 3GPP Website. *See* Ex. 2004 (3GPP Terms of Use) at 3 (Under section titled "Disclaimer," the Terms of Use for the 3GPP website states "ESTI makes no representations or warranties as to the accuracy, reliability or completeness of any information incorporated thereto and contained on the 3GPP Website.").

For the above reasons, Mr. Rodermund's testimony is speculative and insufficient to show a reasonable likelihood that *Intel* and *ZTE* qualify as prior art.

b. Petitioner fails to show a reasonable likelihood that *Intel* and *ZTE* were publicly accessible.

"Whether a document constitutes a printed publication under § 102 is a question of law based upon the underlying facts of each particular case." *Orion IP*, 605 F.3d at 974. To "qualify as a printed publication, the [reference] must have been disseminated or otherwise made accessible to persons interested and ordinarily skilled in the subject matter to which [the reference] relates prior to the critical date." *Id.* And "[a] given reference is 'publicly accessible' upon a satisfactory

showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *SRI Int’l, Inc. v. Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008) (quoting reference omitted). For electronic documents, whether such documents were indexed or catalogued, or if there were other tools for customary and meaningful research are factors relevant to the determination of public accessibility. *See id.* at 1196.

Mr. Rodermund opines that the *Intel* and *ZTE* references were publicly available based on their alleged inclusion on the 3GPP FTP server. Ex. 1029 at ¶¶ 81, 117. Even assuming such documents were uploaded to the FTP server before the priority date of the ’896 Patent, the 3GPP FTP server does not contain an index or catalogue or other tools for customary and meaningful research. Working group proposals are maintained on the 3GPP FTP server only by their temporary document (TDoc) number (*e.g.*, R1-1808197 and R1-1810751). *See e.g.*, Ex. 1029 at ¶¶ 65 and 102. There is no mechanism to meaningfully search the 3GPP FTP server for relevant documents, and a skilled artisan without prior knowledge of 3GPP’s practices and nomenclature would have to comb through thousands of unindexed and uncatalogued documents to locate relevant working group proposals such as *Intel* and *ZTE*. Accordingly, it would be unlikely that a person of skill in the art exercising reasonable diligence would locate these references. Mr.

Rodermund does not testify to the contrary. Indeed, while Mr. Rodermund testifies that for Technical Specifications “a person without prior knowledge of 3GPP and/or the technical specification (TS) number would have been able to easily find the TS for download via internet search,” he makes no such claim for the working group proposals such as *Intel* and *ZTE*. Compare Ex. 1029 at ¶¶ 169-173 (for Technical Specifications) with ¶¶ 63-71 (for *ZTE*) or ¶¶ 109-117 (for *Intel*). Accordingly, there is no evidence that a skilled artisan exercising reasonable diligence, could have located *Intel* or *ZTE* through the 3GPP FTP server before November 1, 2018.

The Board, in a nearly identical circumstance, found that a working group proposal “was not publicly accessible through the 3GPP ftp server.” *Nokia of America v. IPCOM, GmbH & Co. KG*, IPR2021-00533, Paper 10 at 30 (P.T.A.B. Aug. 12, 2021).⁵ Here, like the working group proposal at issue in *Nokia*, the *ZTE* and *Intel* references are identified on the 3GPP FTP servers only through their respective file names, R1-1808197 and R1-1810751. See *id.*; Ex. 1029 at ¶¶ 65 and 102. And like the witness’ declaration in *Nokia*, here, Mr. Rodermund presents no testimony that a person of ordinary skill in the art was aware of 3GPP’s

⁵ Compare *Nokia*, IPR2021-00533, Ex. 147-1011 (Declaration of Susanna Kallio) with Ex. 1029 (Declaration of Mr. Rodermund).

nomenclature or would have understood the contents of the working group proposals based on the filename. *Nokia*, IPR2021-00533, Paper 10 at 30. Based on similar information, the Board in *Nokia* determined that “[p]etitioner has not sufficiently shown [working group proposal] was indexed or catalogued on the ftp server or that the ftp server included tools for customary and meaningful search for this document” *Id.* at 31. And therefore, it held “[p]etitioner has not shown a reasonable likelihood that [working group proposal] was publicly accessible.” *Id.*

Here too, Petitioner fails to show that *Intel* and *ZTE* were “sufficiently accessible to the public interested in the art,” which is fatal to the Petition. *Orion IP*, 605 F.3d at 974. Without these references as prior art, Petitioner cannot show a reasonable likelihood that Petitioner would prevail on any claim challenged in the Petition. Accordingly, the Petition should be discretionarily denied.

2. Alleged Prior Art Cited by Petitioner is Substantially the Same Art Already Considered by the USPTO and Cited on the Face of the Patent.

The unpatentability challenge is also weak because it presents art that is substantially the same as art that was presented during prosecution. The Board may, in its discretion, deny institution of an IPR where the same or substantially the same prior art was previously presented during prosecution of the challenged patent. *Advanced Bionics LLC v. Med-El Elektromedizinische Geräte GmbH* sets forth a two-part framework for this analysis. IPR2019-01469, Paper 6 (P.T.A.B.

Feb. 13, 2020) (precedential). Specifically, under *Advanced Bionics*, the Board must first determine if one of the two following conditions are met:

1(a) whether the same or substantially the same art previously was presented to the Office; or

1(b) whether the same or substantially the same arguments previously were presented to the Office.

Id. at 8. If either condition is met, the first part of the framework is satisfied. Next, in that case, the Board must determine:

(2) whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Id. at 8. If the petitioner has not demonstrated that the office erred in a manner material to the patentability of the challenged claims, the Board may deny institution of the IPR.

For example, in *Google v. Valtrus Innovations Limited*, the Board denied institution where the petition was based solely on art that was a U.S. counterpart to a European patent application cited during prosecution of the challenged patent. IPR2022-01197, Paper 9 at 20-26 (P.T.A.B. Jan. 3, 2023). There, the Board first determined that the two pieces of art were substantially the same. *Id.* at 22. Having done so, the Board denied institution because petitioner had failed to present any argument on why the USPTO erred in its analysis of the European patent application during prosecution. *Id.* at 25. Of note, other than listing the IDS citing the European patent application as “considered,” the examiner did not say anything

about the European application during prosecution of the challenged patent.

Google, Paper 16 at 4 (P.T.A.B. Apr. 12, 2023).

Here, *Intel* (Ex. 1006) and *ZTE* (Ex. 1011), alleged prior art central to Petitioner's Grounds 1-4, are substantially the same as *Vivo366* (Ex. 1015) (cited on the face of the '896 Patent as Vivo Maintenance for beam management; RI-1810366 3GPP TSG, RAN WGI #94b, Oct. 12, 2018(Oct. 12, 2018), sections 2-3). *Vivo366* was already considered by the examiner and is cited on the face of the '896 Patent. Because *Intel* and *ZTE* are substantially the same as *Vivo366*, and because Petitioner has not offered any argument as to why it believes the examiner erred in analyzing *Vivo366*, Petitioner's challenge should be dismissed. *Advanced Bionics LLC*, IPR2019-01469, Paper 6; *Google*, IPR2022-01197, Paper 9 at 20-26.

Vivo366, *Intel*, and *ZTE* all focus on the perceived need for clarification with respect to the following passage from *TS 38.214*:

For both the cases when *tci-PresentInDCI* is set to 'enabled' and *tci-PresentInDCI* is not configured in RRC connected mode, if the offset between the reception of the DL DCI and the corresponding PDSCH is less than the threshold *Threshold-Sched-Offset*, the UE may assume that the DM-RS ports of PDSCH of a serving cell are quasi co-located with the RS(s) in the TCI state with respect to the QCL parameter(s) used for PDCCH quasi co-location indication of the lowest *CORESET-ID* in the latest slot in which one or more CORESETs within the active BWP of the serving cell are configured for the UE. If none of configured TCI states contains 'QCL-TypeD', the UE shall obtain the other QCL assumptions from the indicated TCI states for its scheduled PDSCH irrespective of the time offset between the reception of the DL DCI and the corresponding PDSCH.

TS 38.214 (Ex. 1012), pp. 26-27.

In view of perceived need for clarification, *Vivo366* proposed the following amendments to *TS 38.214*:

Similarly, with respect to Grounds 2 and 4, Petitioner relies on the following passage from *ZTE* to make its challenge to claim 10(f). Petition, pp, 48 (Ground 2), 65-66 (Ground 4) (citing *ZTE*, p. 12). There, *ZTE* proposed the following clarifications to *TS 38.214*:

In addition, when the time offset between the reception of the DL DCI and the corresponding PDSCH is smaller than a threshold *Threshold-Sched-Offset*, the QCL assumption of PDSCH of a serving cell is based on the lowest CORESET of the serving cell as shown in above description marked by blue.

-----38.214 section 5.1.5-----

For both the cases when *tci-PresentInDCI* is set to 'enabled' and *tci-PresentInDCI* is not configured, if the offset between the reception of the DL DCI and the corresponding PDSCH is less than the threshold *Threshold-Sched-Offset*, the UE may assume that the DM-RS ports of PDSCH of a serving cell are quasi co-located with the RS(s) in the TCI state with respect to the QCL parameter(s) used for PDCCH quasi co-location indication of the lowest *CORESET-ID* in the latest slot in which one or more CORESETs within the active BWP of the serving cell are configured for the UE. If none of configured TCI states contains 'QCL-TypeD', the UE shall obtain the other QCL assumptions from the indicated TCI states for its scheduled PDSCH irrespective of the time offset between the reception of the DL DCI and the corresponding PDSCH.

However, the time domain parameters like start symbol, period and time offset are included in the configuration of search space instead of CORESET. Consequently, the above lowest CORESET-ID should be clarified as a CORESET associated with one search space. In addition, based on the current specification, when the number of search space candidates in one slot is larger than that UE supports, the extra search space sets associated with one CORESET will not be monitored by the UE for keeping the low number of blind detection.

Therefore, the CORESET with the lowest CORESET-ID should be clarified as one CORESET associated with at least one search space set monitored by the UE.

ZTE (Ex. 1011), p. 12.

Again, *ZTE*'s proposal is substantially similar to the one made in *Vivo366* and *Intel*, and the majority of the language is identical.

The portions of *Intel* and *ZTE* cited by Petitioner discuss the same section of *TS 38.214* and offer substantially similar proposals for clarifying this section.

Therefore, *Intel* and *ZTE* are merely cumulative of *Vivo366* and do no offer

anything the examiner had not already considered when the examiner considered *Vivo366*. Of further note, in the Notice of Allowance, the examiner did not even list *Vivo366* as one of the top three closest pieces of art. *See* Ex. 1002, pp. 182-183.

Further, Petitioner describes the alleged disclosures of *Intel* and *ZTE* in nearly identical terms. According to Petitioner, *Intel* disclosed “using a CORESET’s QCL assumption to receive a PDSCH or CSI-RS.” Petition, p. 17 (citing *Intel*, pp. 1-4). According to Petitioner, *ZTE* disclosed “using a CORESET’s QCL assumption to receive subsequent data, such as PDSCH.” Petition, p. 18 (citing *ZTE*, pp. 11-14).

Because *Intel* and *ZTE* are substantially the same as of *Vivo366*, which was considered by the USPTO and appears on the face of the Patent, and because Petitioner has not offered any argument with respect to why it believes the examiner incorrectly analyzed *Vivo366*, Petitioner’s challenge is objectively weak and should be dismissed. *Advanced Bionics LLC*, IPR2019-01469, Paper 6; *Google*, IPR2022-01197, Paper 9 at 20-26.

**C. Patent Owner had Established Expectations Based
Samsung’s Longstanding Knowledge of the ’896 Patent**

Hannibal provided Samsung express notice of the ’896 Patent and its infringement on June 8, 2022. Ex. 2002 at 1-2. Hannibal then provided claims charts to Samsung for the ’896 Patent a month later, on July 21, 2022. As shown,

Samsung had knowledge the '896 Patent and its alleged infringement for more than three years filing this Petition.

Petitioner's longstanding knowledge of the '896 Patent without seeking any review of it weighs in favor of discretionary denial. *iRhythm Techs., Inc. v. Allyn*, IPR2025-00363, Paper 10 at 3 (P.T.A.B. June 6, 2025) ("Petitioner's awareness of Patent Owner's applications and failure to seek early review of the patents favors denial and outweighs the above-discussed considerations."); *Nvidia Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18 at 2-3 (P.T.A.B. July 31, 2025) (finding that even though patent was reissued in 2023, the fact that Petitioner had prior knowledge of the patent favored discretionary denial). This may be true even when the challenged patent has not been in force very long. *See Samsung Electronics Co., Ltd. v. Genghiscomm Holdings LLC*, IPR2025-00793, Paper 11 at 2 (P.T.A.B. Aug. 22, 2025) ("Although the patents challenged in these proceedings have not been in force for as long as those in IPR2025-00780 and IPR2025-00781, this fact alone does not tip the balance against discretionary denial."). By waiting years from when Hannibal first provided notice of the '896 Patent to file its Petition, Petitioner created an expectation that Samsung would not file a Petition for an IPR directed to the '896 Patent. Thus, this factor favors discretionary denial.

D. Other Factors

1. Trial Likely to Occur Before Projected FWD.

The Board's decision on institution must be made by February 6, 2026. The Final Written Decision ("FWD") must be issued on or before February 6, 2027.

In the Litigation, the Court set the final pretrial conference for November 18, 2026. Ex. 2003, Order. While the District Court did not set a trial date, the Court typically sets jury trials for shortly after the final pretrial conference. *See Stellar LLC v. Motorola Solutions, Inc.*, No. 4:23-cv-750-SDJ, Dkt. 50 (E.D. Tex. Aug. 9, 2024) (setting trial for 10 days after final pretrial conference), Ex. 2005, p. 4. Based on the District Court's usual practice, the jury trial will likely take place in late November or early December of 2026.

The Board has routinely denied institution when the jury trial predates the final written decision. *See, e.g., Samsung Elecs. Co., Ltd. v. Sinotechnix LLC*, IPR2025-00331, Paper 13 at 2 (P.T.A.B. July 2, 2025) (finding that jury trial predating the final written decision weighed in favor of discretionary denial); *Ericsson Inc. v. Active Wireless Techs. LLC*, IPR2024-00886, Paper 8 at 8-9 (P.T.A.B. Nov. 12, 2024) (collecting cases). Where, as here, there is a two-to-three month time difference between the trial and the FWD deadline, the Director has found this factor to favor the denial of institution. *See EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (P.T.A.B. Apr. 13, 2022)

(concerning one-to-two-month period); *NXP USA, Inc. v. Redstone Logics LLC*, IPR2025-00485, Paper 11 at 2 (P.T.A.B. July 10, 2025) (concerning a 2.5-month period).

Thus, the fact that trial will occur prior to the FWD favors discretionary denial. This is true even when the challenged patent has not been in force very long. *See Samsung Electronics Co., LTD. et al. v. Genghiscomm Holdings LLC*, IPR2025-00793, Paper 11 at 2 (P.T.A.B. Aug. 22, 2025) (“Although the patents challenged in these proceedings have not been in force for as long as those in IPR2025-00780 and IPR2025-00781, this fact alone does not tip the balance against discretionary denial.”).

2. A Stay of the District Court Proceedings is Unlikely.

In the parallel Litigation, the District Court has not granted a stay nor is it likely to do so. Indeed, judges in the Eastern District routinely deny any requests to stay litigation prior to the institution of an IPR. *See, e.g., Luminati Networks Ltd. v. Teso LT, UAB*, No. 2:19-CV-00395-JRG, 2020 WL 6803255, at *1 (E.D. Tex. Oct. 30, 2020); *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015); *AR Design Innovations LLC v. Ashley Furniture Indus., Inc.*, No. 4:20-cv-392-SDJ, 2021 WL 6496714, at *3-4 (E.D. Tex. Jan. 11, 2021) (citing *Trover*).

Even if this IPR is instituted, it is unlikely that the District Court would stay the Litigation. This is especially true where, as here, the FWD would likely issue after the trial in the parallel proceeding. *See, e.g., MyPort, Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:22-cv-00114-JRG, Dkt. 73 (E.D. Tex. June 13, 2023) (denying a motion to stay when “the PTAB [FWD] is not due until over two months after jury trial is set to begin”), Ex. 2006, p. 4; *Solas OLED Ltd. v. Samsung Display Co., Ltd.*, No. 2:19-CV-00152-JRG, 2020 WL 4040716, at *2 (E.D. Tex. July 17, 2020) (denying a motion to stay in part because the Board’s FWD would have issued after the scheduled trial). The fact that the District Court is unlikely to stay the case favors discretionary denial. *See, e.g., Samsung Elecs. Co., Ltd. v. Cerence Operating Co.*, IPR2025-00458, Paper 14 at 2 (P.T.A.B. June 25, 2025).

IV. CONCLUSION

For the reasons set forth above, Hannibal requests that the Deputy Director exercise her discretion and deny institution in this IPR proceeding on the '896 Patent.

Dated: October 6, 2025

/s/ Brian A. Carpenter
Brian A. Carpenter
USPTO Reg. No. 37,109
Vishal Patel
Admitted Pro Hac Vice
Cole Schotz P.C.
901 Main Street, Suite 4120
Dallas, TX 75202
469.557.9390
bcarpenter@coleschotz.com
vpatel@coleschotz.com

CERTIFICATE UNDER 37 C.F.R. SECTION 42.24

Hannibal certifies that the page count in this Request is 20 pages. This Request is in compliance with the 20 page limit. See <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>

CERTIFICATE OF SERVICE

I, Brian A. Carpenter, hereby certify that on the 6th day of October, 2025, the foregoing document was served on the following by email:

Joshua L. Goldberg
Timothy J. May
Nicholas A. Cerulli
Chen Zang
Kevin D. Rodkey
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
joshua.goldberg@finnegan.com
timothy.may@finnegan.com
nicholas.cerulli@finnegan.com
chen.zang@finnegan.com
kevin.rodkey@finnegan.com

/s/ Brian A. Carpenter
Brian A. Carpenter
USPTO Reg. No. 37,109
Vishal Patel
Admitted *Pro Hac Vice*
Cole Schotz P.C.
901 Main Street, Suite 4120
Dallas, TX 75202
469.557.9390
bcarpenter@coleschotz.com
vpatel@coleschotz.com

*Attorneys for Patent Owner
Hannibal IP LLC*