

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

Samsung Electronics Co., Ltd.,
Petitioner,

v.

One-E-Way, Inc.,
Patent Owner.

Case: IPR2025-01541
U.S. Patent No. 9,107,000

**PATENT OWNER ONE-E-WAY, INC.'S
DISCRETIONARY DENIAL BRIEF**

TABLE OF CONTENTS

I. INTRODUCTION.....	1
II. BACKGROUND.....	2
A. Background of the Invention.....	2
B. Embodiments of the Invention	3
C. Prior Enforcement and Litigation.....	4
D. Prior Validity Challenges	5
E. The Parallel District Court Litigation	5
F. Level of Ordinary Skill in the Art and Claim Construction.....	6
III. THE PTAB SHOULD EXERCISE ITS DISCRETION UNDER 35 U.S.C. § 314(A) TO DENY INSTITUTION.....	6
A. The Strength of OEW’s Settled Expectations is Sufficient to Exercise Discretion to Deny Institution	6
B. The recently granted stay does not preclude discretionary denial	10
C. The District Court and the Parties Have Invested a Significant Amount of Resources in the District Court Litigation.....	12
D. Petitioner’s Filing of a Belated <i>Sotera</i> Stipulation Will Not Resolve Issues Related to Duplication of Efforts	13
E. The Petitioner is Also a Defendant in the Parallel District Court Proceeding	16
F. Other Consideration Also Support Discretionary Denial	17
1. Petitioner relies on expert testimony extensively and for every ground asserted.....	17
2. The failure of past <i>inter partes</i> review challenges against other members of the ’000 patent’s family further supports discretionary denial here	18

3. The merits of the Petition are weak and do not outweigh
OEW's settled expectations or the other *Fintiv* factors 19

IV. CONCLUSION20

EXHIBIT LIST
Previously Filed (Petitioner)

Ex.	Description
1001	U.S. Patent No. 9,107,000 to Woolfork (“’000 patent”)
1002	File history of U.S. Application No. 13/356,949, filed January 24, 2012 (“the 2012 application”)
1003	File history of U.S. Application No. 10/027,391, filed December 21, 2001 (“the 2001 application”), as originally filed in <i>Sony Corp. v. One-E-Way, Inc.</i> , IPR2016-01638 as Exhibit 1003
1004	U.S. Publication No. 2003/0118196 (“the ’196-Publication”), as originally filed in <i>Sony Corp. v. One-E-Way, Inc.</i> , IPR2016-01638 as Exhibit 1004
1005	File history of U.S. Application No. 10/648,012, filed August 26, 2003 (“the 2003 application”), as originally filed in <i>Sony Corp. v. One-E-Way, Inc.</i> , IPR2016-01638 as Exhibit 1005
1006	U.S. Patent No. 7,412,294, as originally filed in <i>Sony Corp. v. One-E-Way, Inc.</i> , IPR2016-01638 as Exhibit 1006
1007	Excerpts from file history of U.S. Application No. 12/144,729, filed July 12, 2008 (“the 2008 application”), as originally filed in <i>Sony Corp. v. One-E-Way, Inc.</i> , IPR2016-01638 as Exhibit 1007
1008	Comparison of the 2003 application as-filed with the 2001 application as-filed, as originally filed in <i>Sony Corp. v. One-E-Way, Inc.</i> , IPR2016-01638 as Exhibit 1008
1009	Comparison of figures from the 2003 and 2001 applications as filed, as originally filed in <i>Sony Corp. v. One-E-Way, Inc.</i> , IPR2016-01638 as Exhibit 1009
1010	Comparison of the ’294 patent with the as-filed 2003 application, as originally filed in <i>Sony Corp. v. One-E-Way, Inc.</i> , IPR2016-01638 as Exhibit 1010
1011	Comparison of the 2008 application as-filed with the 2012 application as-filed
1012	Declaration of Michael Davies
1013	<i>One-E-Way, Inc. v. Apple Inc.</i> , No. 2:20-cv-06339, Dkt. 86 (C.D. Cal. Mar. 9, 2022) (“Apple Markman order”)
1014	<i>In the Matter of Certain Consumer Elecs. And Display Devices with Graphics Processing and Graphics Processing Units Therein</i> ,

Ex.	Description
	337-TA-943, Order 12 (ITC July 24, 2015) (“ITC <i>Markman</i> order”)
1015	U.S. Patent No. 6,744,808 (“Walley”)
1016	U.S. Patent No. 5,546,424 (“Miyake”)
1017	Reserved
1018	“Wireless Communications: Principles & Practice” by Theodore S. Rappaport (1996) (“Rappaport”)
1019	Reserved
1020	Reserved
1021	U.S. Patent No. 6,256,303 (“Drakoulis”)
1022	“The Communications Handbook” (1997) by Jerry D. Gibson (“Gibson”)
1023	One-E-Way’s Opening Claim Construction Brief <i>One-E-Way, Inc. v. Apple Inc.</i> , 2:20-cv-6339-JSK-PD (D.I. 65) (C.D. Cal. Dec. 6, 2021)
1024	Order Re Motion For Summary Judgment of Non-Infringement (“ <i>Apple</i> Summary Judgment Order”) <i>One-E-Way, Inc. v. Apple Inc.</i> , 2:20-cv-6339-JSK-PD (D.I. 102) (C.D. Cal. June 15, 2022)
1025	Library of Congress Record for “Wireless Communications: Principles & Practice” by Theodore S. Rappaport (1996)
1026	U.S. Patent No. 5,933,421
1027	Library of Congress Record for “The Communications Handbook” (1997)
1028	U.S. Patent No. 5,953,669
1029	Opinion Affirming <i>Apple</i> Summary Judgment Order <i>One-E-Way, Inc. v. Apple Inc.</i> , 2022-2020 (D.I. 32) (Aug. 14, 2023)
1030	<i>Curriculum Vitae</i> , Michael Allan Martin Davies

Ex.	Description
1031	Attachment A-12 to One-E-Way, Inc.'s Infringement Contentions in <i>One-E-Way, Inc. v. Samsung Electronics Co., Ltd.</i> , 1:24-cv-1561 (W.D. Tex.), served on June 26, 2025

Currently Filed (Patent Owner)

Ex.	Description
2001	One-E-Way, Inc.'s webpage available at http://one-e-way.com/
2002	One-E-Way, Inc.'s webpage available at http://one-e-way.com/about-us/
2003	Image of the packaging for One-E-Way, Inc.'s E-Clip Series products available at https://www.walmart.com/ip/E-Clip-Series-Headphone-Transmitter-Bundle/447919826
2004	Certified letter from One-E-Way, Inc. to Samsung Electronics dated April 10, 2020.
2005	Letter from Samsung Electronics Co., Ltd. to One-E-Way, Inc. dated April 22, 2020
2006	Excerpts from the file history of Samsung Electronics Co., Ltd.'s U.S. Application No. 12/565,909
2007	Order Granting Defendants' Motion to Stay Pending IPR in <i>One-E-Way, Inc. v. Dell Techs. Inc., et al.</i> , 1:24-cv-01558-RP (LEAD) (Dkt. 89)
2008	Scheduling Order in <i>One-E-Way, Inc. v. Dell Techs. Inc., et al.</i> , 1:24-cv-01558-RP (LEAD) (Dkt. 42)
2009	Preliminary Invalidity Contentions "Cover Document" of Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. and consolidated co-defendants Dell Technologies Inc. and Dell Inc. served in <i>One-E-Way, Inc. v. Dell Techs. Inc., et al.</i> , 1:24-cv-01558-RP (LEAD) on August 14, 2025

I. INTRODUCTION

Patent Owner One-E-Way, Inc. (“Patent Owner” or “OEW”) respectfully submits this Patent Owner Discretionary Denial Brief in response to Samsung Electronics Co., Ltd.’s (“Petitioner”) Petition for *Inter Partes* Review of Claims 1-5, 8-12 of U.S. Patent No. 9,107,000 (the “Petition”). It is being timely filed on or before November 30, 2025, in accordance with the “Director Institution of AIA Trial Proceedings” issued October 17, 2025;¹ the “Interim Processes for PTAB Workflow Management” (“Workload Memo”);² and the USPTO’s Discretionary Decisions webpage.³ Pursuant to 35 U.S.C. § 314(a), OEW respectfully requests that the Director exercise discretion to deny institution of a trial with respect to all of the claims of United States Patent No. 9,107,000 (the “’000 patent”).⁴

Here, the combination of the settled expectations of OEW and the balance of the *Fintiv* factors strongly favors denial of institution under 35 U.S.C. § 314(a).

¹https://www.uspto.gov/sites/default/files/documents/Director_Institution_of_AIA_Trial_Proceedings.pdf.

² <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>.

³ <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>.

⁴ Petitioner has also filed IPR petitions against OEW’s U.S. Patent No. 10,468,047 (the “’047 patent”) in *Samsung Electronics America Inc et al. v. One-E-Way Inc.*, IPR2025-01516, Paper 1 (P.T.A.B. Sept. 8, 2025) and against OEW’s U.S. Patent No. 10,129,627 (the “’627 patent”) in *Samsung Electronics America Inc et al. v. One-E-Way Inc.*, IPR2025-01540, Paper 1 (P.T.A.B. Sept. 16, 2025).

II. BACKGROUND

A. Background of the Invention

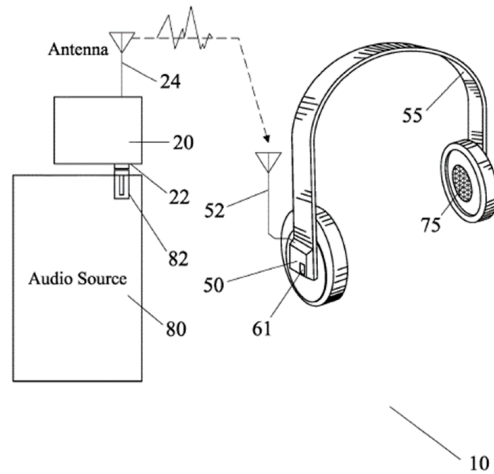
Earl Woolfork is the named inventor of the '000 patent. Mr. Woolfork first conceived of his wireless audio inventions in the late 1990's while exercising outdoors at the popular Santa Monica Steps in Los Angeles and noticing how many people were having trouble with the wires connecting their audio players to their headsets. Using his background in electrical engineering, Mr. Woolfork set out to create an invention that would allow people to enjoy high quality music without the complications of wires. Consequently, Mr. Woolfork conceived of a mobile audio transmitter and separate mobile receiver that communicated using radio signals to provide high quality audio data. Mr. Woolfork assigned the resulting patent rights to his company established in 2004, One-E-Way, Inc., where he still serves as the Founder and CEO to this day. *See* EX2001; EX2002.

OEW is a minority-owned, family-run business that worked to commercialize Mr. Woolfork's inventions for nearly two decades. OEW faced tremendous business adversity due to a lack of connections within the industry's distribution channels that catered to the larger electronics companies but was nonetheless able to release a USA-made wireless audio product that included patent marking and achieved some modest sales. *See, e.g., id.*; EX2003 (providing an example of OEW's product packaging including "Patented: one-e-way.com/about-us/") from a product listing on

www.walmart.com). In parallel with its commercialization efforts, OEW has been able to sustain itself through successful litigation and licensing efforts with major international electronics companies, as briefly discussed *infra*. See also EX2001 at 2 (listing OEW licensees).

B. Embodiments of the Invention

The challenged patent is generally directed to a wireless digital audio system. Ex. 1001 at 1:55-61. The patent’s focus on a wireless audio system, including a transmitter and a headphone, is represented in Figure 1, which is described as “a wireless digital audio system in accordance with the present invention:



Id. at Fig. 1 and 2:15-16. The patent discloses techniques to improve listening quality while reducing interference in order to provide private listening. The patent explains that, even when multiple such systems operate in a shared space, “[e]ach receiver headphone 50 user may be able to listen (privately) to high fidelity audio music, using any of the audio devices listed previously, without the use of wires,

and without interference from any other receiver headphone 50 user, even when operated within a shared space.” *Id.* at 3:34-28. This is achieved through a series of disclosed components within the system’s claimed transmitter and/or receiver.

C. Prior Enforcement and Litigation

OEW filed its first patent infringement action involving the ’000 patent’s family fourteen years ago in a complaint filed against one of Petitioner’s competitors. *See One-E-Way, Inc. v. Plantronics Inc. et al.*, 2:11-cv-06673 (C.D. Cal. Aug. 12, 2011). Since that time, OEW has filed ten other enforcement actions over the years involving the ’000 patent’s family against Petitioner’s competitors, including a complaint filed with the International Trade Commission in 2014 involving some of the most respected names in consumer audio, e.g. Sony, Sennheiser, and GN Netcom. *See Certain Wireless Headsets*, Inv. No. 337-TA-943, Complaint (U.S. Int’l Trade Comm’n Dec. 8, 2014).

Before filing its three most recent enforcement actions—which included the action against Petitioner—OEW last filed an infringement action against Apple Inc. in July 2020 and asserted in that case both of the other OEW patents Petitioner has challenged in the related IPRs here—the ’047 patent and the ’627 patent—and one other OEW patent. *See One-E-Way, Inc. v. Apple Inc.*, No. 2:20-CV-06339, Dkts. 1 and 22 (C.D. Cal. July 16, 2020). OEW’s action against Apple Inc. ultimately ended as the result of a noninfringement ruling on OEW’s infringement theory in that case;

specifically, the district court found that the implementation of certain parameters OEW had accused in Apple Inc.’s products did not satisfy the “unique user code” term in the asserted patents. *See One-E-Way, Inc. v. Apple Inc.*, 2022 WL 2564002, at *1 (C.D. Cal. June 15, 2022), *aff’d*, No. 2022-2020, 2023 WL 5199501 (Fed. Cir. Aug. 14, 2023).

D. Prior Validity Challenges

During the action against Apple Inc. described *supra*, Apple Inc. filed five IPR petitions against the three OEW patents that had been asserted against Apple, Inc., including two IPR petitions against the ’047 patent⁵ and two IPR petitions against the ’627 patent.⁶ In June 2021, institution was denied on the merits for all five of Apple Inc.’s IPR petitions. *See Apple Inc. v. One-E-Way, Inc.*, No. IPR2021-00283--00287, Paper 7 (P.T.A.B. June 11, 2021) (denying institution).

E. The Parallel District Court Litigation

On December 18, 2024, OEW filed a complaint against Petitioner in the Western District of Texas alleging infringement of the ’000 patent and two other related patents from the same family—the ’627 patent and the ’047 patent—which Petitioner has also filed IPR petitions against, as mentioned *supra*. On the same day,

⁵ *Apple Inc. v. One-E-Way, Inc.*, No. IPR2021-00284--00285 (P.T.A.B. Dec. 4, 2020)

⁶ *Apple Inc. v. One-E-Way, Inc.*, No. IPR2021-00286--00287 (P.T.A.B. Dec. 4, 2020).

OEW also filed complaints asserting the same three OEW patents against Dell Technologies Inc. and Dell Inc. (1:24-cv-01558-RP) and Anker Innovations, Ltd. (1:24-cv-01559-RP) in the Western District of Texas. The three cases were subsequently consolidated.

F. Level of Ordinary Skill in the Art and Claim Construction

In light of the USPTO's bifurcated process for decisions on institution, OEW focuses on discretionary considerations here and will address Petitioner's definition of a person of ordinary skill in the art and relevant claim constructions in connection with the merits-focused arguments OEW will present in its Patent Owner Preliminary Response due to be filed by December 30, 2025.

III. THE PTAB SHOULD EXERCISE ITS DISCRETION UNDER 35 U.S.C. § 314(A) TO DENY INSTITUTION

The Director regularly exercises their discretion to deny institution under 35 U.S.C. § 314(a), especially in the circumstances present here: the challenged patent issued over ten years prior to the filing of the Petition, the Petitioner received actual notice of the challenged patent after its issuance, and the Petitioner had notice of the challenged patent's family even prior to those events.

A. The Strength of OEW's Settled Expectations is Sufficient to Exercise Discretion to Deny Institution

Petitioner's longstanding and indisputable knowledge of the '000 patent and its failure to seek earlier review of the patent strongly favors discretionary denial and

outweighs the few *Fintiv* factors that *may* weigh marginally against discretionary denial.

The '000 patent issued more than ten years ago on August 11, 2015. EX1001. A little over four and a half years after the '000 patent's issuance, OEW sent a certified letter to Petitioner dated April 10, 2020 accusing Petitioner of infringing the '000 patent and several other OEW patents in the same family that had issued by that time. *See* EX2004 at 2 (identifying OEW's current family of patents, including the '000 patent, and Petitioner's infringing products). Petitioner confirmed receipt of OEW's April 10, 2020 notice letter in a follow-up letter dated April 22, 2020 and further stated that "Samsung has a policy of respecting the intellectual property rights of others [and] Samsung will carefully consider your proposal of discussing the patent issues mentioned in your letter." EX2005. Consequently, Petitioner cannot dispute that it received actual notice of the '000 patent, and its infringement of the same, approximately five and a half years (5.5 years) before filing the instant Petition.

In addition to the actual notice provided, Petitioner knew or should have known⁷ of the '000 patent upon its issuance as the result of its own prosecution

⁷ OEW's patent applications and issued patents are available to the public. "As such, actual notice of a patent or of possible infringement is not necessary to create settled expectations." *Dabico Airport Sols. Inc. v. Axa Power Aps*, IPR2025-00408, 2025 WL 1710857, at *1 (P.T.A.B. June 18, 2025).

activities. Specifically during prosecution of Petitioner’s U.S. Application No. 12/565,909 titled “Audio Device, AV System Having the Audio Device, and Method to Control the Audio Device,” one of OEW’s patents—U.S. Patent No. 7,684,885 (the “’885 patent”), to which the ’000 patent claims priority—was cited by the Examiner on two separate occasions as prior art in connection with rejections of Petitioner’s pending claims. *See* EX2006 at 69 and 135. Specifically, on December 13, 2011 and June 19, 2012, OEW’s ’885 patent was listed in the Examiner’s Notice of References Cited when issuing both a non-final and final rejection of Petitioner’s pending claims. *Id.* at 60, 69, 129 and 135.

While the ’000 patent itself had not yet issued at the time of those rejections, several other OEW patents in the same family as the ’000 patent had issued while other applications were still pending. In particular, OEW’s ’885 patent and the ’000 patent both ultimately claim priority to an application filed nearly twenty four years ago. *See* EX1001 (claiming priority to U.S. Application No. 10/027,391, which was filed on December 21, 2001). Moreover, the ’885 patent was again identified in OEW’s April 10, 2020 letter to Petitioner discussed *supra*. So, in addition to the opportunity to challenge the ’000 patent after Petitioner received notice via OEW’s letter, Petitioner also had the opportunity to challenge the ’000 patent upon its issuance after having received notice of the ’000 patent’s family four years prior during prosecution of Petitioner’s own patent application.

The Director’s recent decision in *iRhythm Technologies v. Welch Allyn Inc.*, IPR2025-00377, *et al.*, Paper 10 (Director Review: June 6, 2025), further underscores the significance of these facts. In that case, the Director exercised their discretion to deny institution where the petitioner had long been aware of the asserted patents but delayed seeking IPR until after being sued. The Director found that such delay, especially when the patent owner had made the patents known and sought resolution, created “settled expectations” that weighed heavily in favor of denial. *Id.* at 2. Here, Petitioner’s conduct is even more egregious: not only was Petitioner provided actual notice of the ’000 patent almost five and a half years (5.5) before filing its Petition, but OEW provided actual notice to Petitioner at that same time of both the ’000 patent itself and the ’885 patent that had previously been cited by an examiner during Petitioner’s prior prosecution activities.

While there is no bright line rule on the number of years of knowledge or the years a challenged patent had been in force to create settled expectations, the Director has previously found settled expectations to support discretionary denial in other challenges where the relevant IPR petition was filed at an even earlier relative time than here where the instant Petition was filed over ten years after issuance of the ’000 patent. *See, e.g., Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 9 at 5 (P.T.A.B. July 16, 2025) (explaining that the relevant petition was filed approximately five and a half years after issuance of the challenged patent); *id.*,

Paper 12 at 2 (Director July 31, 2025) (granting discretionary denial because “Patent Owner’s strong settled expectations tip the balance in favor of discretionary denial” and noting that the challenged patent had issued six years ago).

Petitioner did not file a challenge to the validity of the ’000 patent at any time prior to filing this Petition, thus allowing OEW’s expectations to settle over Petitioner’s many years of inaction. In these circumstances, the settled expectations of OEW strongly favor discretionary denial.⁸

B. The recently granted stay does not preclude discretionary denial

Although the district court recently stayed the parallel litigation on October 29, 2025, that fact does not tip the balance against discretionary denial here. In similar circumstances, the Director has found that “Patent Owner’s strong settled expectations tip[ped] the balance in favor of discretionary denial” in spite of the parallel district court proceeding having been stayed. *See Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (Director July 31, 2025) (granting discretionary denial where the challenged patent had been in force for over six years despite a stay having been entered in the parallel district court case).

⁸ Settled expectations are even stronger here because, as explained *supra*, three other OEW patents in the same family as the ’000 patent have defeated institution of five prior IPR challenges filed by Apple Inc., OEW has actively enforced its patent rights against Petitioner’s competitors for many years, and OEW has sold competing products marked with its patents in the relevant technology area for many years.

Moreover, if the Director denies institution, the stay in the district court case should be lifted shortly after the denial and result in a relatively minor delay of those proceedings. *See* EX2007 at 4 (granting a stay pending IPR and noting “should the PTAB decide not to initiate *inter partes* review—a short stay of the proceedings will not unduly prejudice OEW”). The district court litigation can then resume addressing invalidity and a variety of other germane issues. Specifically, the projected date for a decision on discretionary considerations for the instant Petition is January 20, 2026 and the parallel district court case was just recently stayed on October 29, 2025. *See id.* So, if the Director discretionarily denies institution, the stay in the parallel litigation would proceed with only an approximate three-month delay from the previous schedule such that the new trial date would be expected in July 2027, rather than the previously scheduled trial date of April 5, 2027. EX2008 at 6. The district court can hear not only Petitioner’s invalidity defenses, including IPR-ineligible challenges under 35 U.S.C. § 112 and those based on system prior art, but can also resolve infringement—an issue Petitioner and its co-defendants have caused a large amount of resources to be invested in before the stay was entered, as mentioned *infra*.

The recently granted stay is insufficient to overcome OEW’s strong settled expectations and the other *Fintiv* factors to avoid discretionary denial.

C. The District Court and the Parties Have Invested a Significant Amount of Resources in the District Court Litigation

“The Board also has considered 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.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020). “[M]ore work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced . . . and instituting would lead to duplicative costs.” *Id.* at 10.

OEW and Petitioner, as well as Petitioner’s co-defendants and the court in the consolidated case, have performed a large amount of work in the parallel district court litigation since December 18, 2024, when OEW filed its three original complaints against Petitioner and the consolidated defendants. *One-E-Way, Inc. v. Dell Techs. Inc., et al.*, No. 24-cv-1558 (Lead), Dkt. 1 (W.D. Tex. December 18, 2024). For example, three distinct motions to dismiss based on collateral estoppel and noninfringement have been fully briefed; OEW defeated a previous attempt to stay the cases; the parties served preliminary infringement and invalidity contentions totaling thousands of pages; defendants have produced thousands of technical documents; and opening and responsive claim construction briefs have been filed. *See* EX2008 at 2-4. Thus, although the parallel litigation is currently stayed, “the current investment in invalidity and construction contentions” weighs in favor of

discretionary denial. *See Cisco Sys., Inc. v. Ramot at Tel Aviv Univ.*, IPR2020-00122, Paper 15 at 8-9 (P.T.A.B. May 15, 2020). The parties' significant investment in the parallel proceeding since December 2024 favors a discretionary denial of institution.

D. Petitioner's Filing of a Belated *Sotera* Stipulation Will Not Resolve Issues Related to Duplication of Efforts

Petitioner's expected *Sotera* stipulation would not significantly reduce the issues before the district court and would not cause this proceeding to be a "true alternative" to the district court. In effect, Petitioner is seeking to have two independent bites at the invalidity apple, one here and one at the district court.

Based on Petitioner's recent actions in a related IPR challenge, OEW expects that Petitioner will file a *Sotera* stipulation here after OEW files this discretionary denial brief. Specifically, in Petitioner's related IPR petition challenging OEW's '047 patent, Petitioner *waited until after* OEW filed its discretionary denial brief to file a *Sotera* stipulation in an apparent attempt to game the system and prevent OEW from addressing Petitioner's stipulation. *Samsung Electronics America Inc et al. v. One-E-Way Inc.*, IPR2025-01516, Paper 7 (P.T.A.B. Nov. 17, 2025). Petitioner is expected to do the same here. Petitioner's conduct is prejudicial to OEW because OEW must guess what will be in Petitioner's stipulation in this IPR and any stipulation from Petitioner should have been included in the Petition itself. Nonetheless, when Petitioner files substantially the same *Sotera* stipulation in this IPR, it will ring just as hollow as it does in the related IPR.

In the parallel litigation, Petitioner has identified a large amount of prior art in its preliminary invalidity contentions, including multiple pieces of system art, allegedly relevant to the validity of the '000 patent. EX2009 at 36-37. Of the thirteen preliminary invalidity contention charts provided by Petitioner in the parallel litigation, two charts rely on references from the instant Petition as their primary references ('196 Publication and Walley), five others rely on system art as their primary reference, and the remaining six rely on other references not included in the Petition. *See* EX2009 at 36-37 (citing Exhibits A-1 – A-13).

At the outset, Petitioner's expected *Sotera* stipulation does not mitigate concerns of duplication of efforts because it is not binding on Petitioner's co-defendants in the related litigation and Petitioner's invalidity contentions are identical to the invalidity contentions of Petitioner's consolidated co-defendants Dell Technologies Inc. and Dell Inc. (collectively "Dell"), who OEW has accused of infringing the same three OEW patents as Petitioner. *See* EX2009 at 1. So, Petitioner has effectively sacrificed nothing if its expected *Sotera* stipulation is later given effect because Petitioner can simply rely on its co-defendant Dell to utilize any prior art that Petitioner cannot. Consequently, the expected *Sotera* stipulation would have done nothing to reduce duplication of efforts in the parallel litigation.

Moreover, Petitioner's expected *Sotera* stipulation will ring hollow because "Petitioner's stipulation does not ensure that these IPR proceedings would be a 'true

alternative’ to the district court proceeding.” *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (Director Mar. 28, 2025). First, as was the case in *Motorola Solutions*, where discretionary denial was granted and a rehearing denied despite petitioner filing progressively broader *Sotera* stipulations similar to Petitioner’s expected stipulation here, “[p]etitioner’s invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot.” *Id.*; *id.*, Paper 20 (P.T.A.B. April 28, 2025) (citing petitioner’s EX1045); *id.* Paper 23 (Director May 23, 2025). The same is true here where eleven of Petitioner’s thirteen invalidity charts directed to the ’000 patent rely on primary references that are not utilized in Petition, including five invalidity charts that use system art as the primary reference, and the stipulation is expected to do little with respect to system art combinations. EX2009 at 37-38. Specifically, Petitioner is expected to again carefully word its *Sotera* stipulation in the same way it did in the related IPR such that the only provision addressing system art merely prevents Petitioner from combining the prior art relied upon in its Petition with system art for *only one specific purpose*, i.e. “as evidence of the operation or structure of a system art device.” *Samsung Electronics America Inc et al. v. One-E-Way Inc.*, IPR2025-01516, Paper 7 at 2 (P.T.A.B. Nov. 17, 2025). This arguably leaves Petitioner free to combine prior art from its Petition with system art for many

other purposes and does nothing to prevent Petitioner from combining all of the other prior art that Petitioner “could have reasonably raised in the IPR” with Petitioner’s system art in the parallel litigation.

In light of the large amount of system art and other distinct prior art relied upon in Petitioner’s invalidity contentions, the lack of any restrictions on Petitioner’s co-defendants in the litigation, and the narrow and nebulous scope of Petitioner’s expected *Sotera* stipulation, it would be more efficient to allow these issues to proceed in front of the district court. “[A]lthough Petitioner’s enhanced stipulation may mitigate some concern of duplication between the parallel proceeding and this proceeding, the stipulation does not outweigh the other *Fintiv* factors,” including OEW’s settled expectations. *Green Revolution Cooling, Inc. v. Midas Green Techs., LLC*, IPR2025-00196, Paper 15 at 2-3 (Director July 25, 2025) (vacating Board’s decision to institute because it gave too much weight to petitioner’s “enhanced” *Sotera* stipulation).

This factor weighs in favor of discretionary denial in spite of the belated and prejudicial *Sotera* stipulation expected from Petitioner.

E. The Petitioner is Also a Defendant in the Parallel District Court Proceeding

OEW is the plaintiff and Petitioner, along with the other real party-in-interest Samsung Electronics America, Inc.—are defendants in the parallel litigation in the Western District of Texas, *One-E-Way, Inc. v. Samsung Electronics Co., Ltd., et al.*,

1:24-cv-01561. “The fact that Petitioner is also the defendant in the Litigation weighs in favor of discretionarily denying institution.” *SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 9 (P.T.A.B. April 7, 2025).

F. Other Consideration Also Support Discretionary Denial

The Director will consider “all relevant considerations” when determining whether discretionary denial is warranted, including:

- The extent of the petition’s reliance on expert testimony
- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims; and
- The strength of the unpatentability challenge.

Workload Memo at 2-3. Discretionary denial is further warranted here based on these considerations.

1. Petitioner relies on expert testimony extensively and for every ground asserted

Petitioner relies extensively on a lengthy 152-page expert declaration nearly twice as long as the Petition itself: the 92-page Petition cites the expert declaration approximately 100 separate times, and in support of seemingly every challenged claim and claim element. *See generally* Petition (citing EX1012 (Declaration of Michael Davies)). Petitioner’s excessive and heavy reliance on expert testimony—including to “gap fill” holes with the supposed understanding, motivations, and expectations of a POSITA—is further indication that its invalidity challenges are more suitable for district court litigation than for the expedited review provided by

an IPR. “[T]he Petition’s extensive reliance on conclusory expert testimony to gap-fill holes in the prior art demonstrates discretionary denial is appropriate.” *Google LLC v. Cerence Operating Co.*, No. IPR2024-01465, 2025 WL 1182608, at *6 (P.T.A.B. Apr. 23, 2025). The manner in which Petitioner invokes expert opinions here further supports discretionary denial.

2. The failure of past *inter partes* review challenges against other members of the ’000 patent’s family further supports discretionary denial here

As discussed *supra*, Apple Inc. previously filed five IPR petitions against three similar members of the ’000 patent’s family and all five petitions were denied institution on the merits. *See Apple Inc. v. One-E-Way, Inc.*, No. IPR2021-00283--00287, Paper 7 (P.T.A.B. June 11, 2021) (denying institution of challenges against OEW’s ’047 patent, the ’627 patent, and U.S. Patent No. 8,131,391). “Even absent road mapping, repeated prior challenges weigh against institution.” *Intel Corp. v. Advanced Cluster Sys., Inc.*, No. IPR2025-00794, Paper 13 at 2-3 (P.T.A.B. Aug. 14, 2025) (granting request for discretionary denial in part because the challenged patent had been in force for six years and involved in two prior Board proceedings where institution was denied on the merits).

Petitioner is expected to invoke Sony Corporation’s previously filed IPR petitions involving OEW patents, two of which were instituted, but *the Sony IPRs were not directed to the ’000 patent or either of the OEW patents challenged in*

Petitioner's related petitions here and none of Sony's petitions resulted in the invalidation of any of the claims. *See Sony Corporation v. One-E-Way, Inc.*, IPR2016-01638, Paper 12 (P.T.A.B. Feb. 22, 2017) (instituting IPR challenge against U.S. Patent No. 9,282,396); *Sony Corporation v. One-E-Way, Inc.*, IPR2016-01639, Paper 8 (P.T.A.B. Feb. 22, 2017) (same), (collectively, "Sony IPRs"). Moreover, in the Sony IPRs, OEW only opposed institution on procedural/administrative grounds concerning acceptable methods of incorporating materials by reference. *See id.* In contrast, here OEW is not relying only on procedural/administrative arguments when opposing institution and is instead focusing on the recent discretionary denial considerations and the substantively weak merits of the Petition, as will be detailed in OEW's forthcoming Patent Owner's Preliminary Response. Ultimately, the two Sony IPRs that were instituted challenging an earlier OEW patent with claims distinct from those of the '000 patent were dismissed by agreement of the parties before any final written decisions issued or claims were invalidated.

The prior failures of other IPR petitions utilizing analogous arguments and prior art to that in the instant Petition weighs in favor of discretionary denial.

3. The merits of the Petition are weak and do not outweigh OEW's settled expectations or the other *Fintiv* factors

As will be explained in detail in OEW's forthcoming Patent Owner's Preliminary Response, the Petition does not present a compelling case on the merits.

Every ground asserted by Petitioner is based on obviousness and evidences numerous weaknesses created by either (1) reliance on prior art involving base stations akin to the prior art that failed to support institution by the PTAB in Apple Inc.'s past IPR challenges to the related '047 and '627 patents; or (2) intentionally obtuse characterizations of what was disclosed or taught in OEW's U.S. Publication No. 2003/0118196—the ultimate parent application of the '000 patent that Petitioner attempts to weaponize as prior art.

Even without these flaws, the current record does not support a finding that the Petition's merits outweigh the great weight of the settled expectations factor and the other factors discussed *supra* favoring discretionary denial under § 314(a). Even if the merits of the Petition were able to present a “close call”—which they do not here—“that fact has favored denying institution when other factors favoring denial are present,” as is the case here. *Fintiv*, Paper 11 at 5-6.

The merits of the Petition do not tip the balance against discretionary denial.

IV. CONCLUSION

Patent Owner OEW has shown that the above-captioned IPR should not be instituted pursuant to the strong “settled expectations” of OEW and the balance of the *Fintiv* discretionary denial factors.

Date: November 21, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT UNDER 37 C.F.R. § 42.24(b)(1)

I, the undersigned, do hereby certify that the foregoing Patent Owner Discretionary Denial Brief, including footnotes, contains 20 pages, as measured by Microsoft Word. This is equal to the limit of 20 pages as specified by the USPTO's Discretionary Decisions webpage.⁹

/s/ Daniel L. Schmid

Daniel L. Schmid

⁹ <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (last visited November 14, 2025).

CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of November 2025, a true and correct copy of the foregoing PATENT OWNER ONE-E-WAY, INC.'S DISCRETIONARY DENIAL BRIEF and its supporting exhibits were served by electronic mail upon the following counsel of record for Samsung Electronics Co., Ltd.:

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