

IPR2025-01541  
Patent No. 9,107,000

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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SAMSUNG ELECTRONICS CO., LTD.,  
Petitioner,

v.

ONE-E-WAY, INC.,  
Patent Owner.

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

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

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**PETITIONER’S EXHIBIT LIST**

| <b>Exhibit No.</b> | <b>Description</b>   |
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| 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  |

| Exhibit No. | Description  |
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|             | 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 <i>Markman</i> order”)  |
| 1014        | <i>In the Matter of Certain Consumer Elecs. And Display Devices with Graphics Processing and Graphics Processing Units Therein</i> , 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<br><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”)<br><i>One-E-Way, Inc. v. Apple Inc.</i> , 2:20-cv-6339-JSK-PD (D.I. 102) (C.D. Cal. June 15, 2022)       |

| Exhibit No. | Description   |
|-------------|---|
| 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<br><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   |
| 1031        | Defendants Samsung Electronics Co., Ltd and Samsung Electronics America, Inc.’s Motion to Dismiss Plaintiff’s First Amended Complaint Pursuant to Fed. R. Civ. P. 12(b)(6), filed in <i>One-E-Way v. Samsung Electronics Co., Ltd., et al</i> , 1:24-cv-01558-RP, Dkt. 68 (W.D. Tex.) (July 1, 2025). |

## I. INTRODUCTION

The Director should deny Patent Owner’s (“PO”) Request for Discretionary Denial (Paper 6) (“Request”) for at least three reasons.

First, the *Fintiv* factors weigh in favor of institution and against discretionary denial. Judge Pitman granted Petitioner’s motion to stay the related district court litigation pending this IPR, and a Final Written Decision (“FWD”) would issue well before trial. EX2007. Judge Pitman rejected PO’s argument that the case is at an advanced stage and that the court and the parties have invested substantial resources. Indeed, claim construction briefing had only just begun, and fact discovery had not yet opened. *Id.* at 4-5. Further, Petitioner’s *Sotera+* stipulation minimizes concerns of overlapping issues between the district court and IPR proceedings.

Second, the Petition addresses material errors made by the Office during the prosecution of the U.S. Patent No. 9,107,000 (“’000 patent”). Paper 1 at 4-17. Petitioner raises the same priority date argument that Sony Corporation (“Sony”) raised in an IPR filed against a patent in the priority chain of the ’000 patent—U.S. Patent No. 9,282,396 (“’396 patent”)—that settled shortly before the deadline for a FWD. *Sony Corp. v. One-E-Way, Inc.*, IPR2016-01638 (“Sony IPR”), Paper 12 at 5-13 (P.T.A.B. Feb. 22, 2017). The Board’s institution decision for the Sony IPR indicates that the Office materially erred by failing to reject improper new matter and by applying an erroneous priority date; thus, the Office should not deny this

Petition as it allows for the resolution of issues previously deemed worthy of review. Even though Petitioner raised this material error in its Petition (Paper 1 at 4-17), PO provided no response.<sup>1</sup>

Third, the parties' settled expectations weigh against discretionary denial. PO has no settled expectation of validity since 2017 in view of the Board's institution of the Sony IPR, in which Sony alleged that the challenged claims of the related '396 patent were not entitled to a 2001 priority date because of a break in the chain of disclosure that rendered PO's own patent publication, U.S. Publication No. 2003/0118196 ("'196 publication"), prior art. *Sony IPR*, Paper 12 at 5-13. The Board instituted review based on this argument (*id.* at 17), and PO did not dispute that if the '196 publication was prior art, it anticipated and rendered obvious the challenged claims. *Sony IPR*, Paper 38 at 60:3-7. Rather than allow the Sony IPR to resolve the priority date issue, Sony and PO settled after oral argument but before the Board issued its FWD. *Sony IPR*, Paper 39.

Moreover, Samsung has a settled expectation of non-enforcement and non-infringement. As indicated in the Request, PO sent a letter to Samsung on April 10,

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<sup>1</sup> While PO took no position on the merits in its discretionary denial briefs, PO's Patent Owner Preliminary Response (Paper 7) raises largely the same legal arguments about priority that were previously addressed in the Sony IPR.. *See Sony IPR*, Paper 27.

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2020 indicating that Samsung’s “Bluetooth-Compatible products” infringe certain patents, including the ’000 patent. EX2004 at 2. But PO concedes that Petitioner responded on April 22, 2020 by requesting the “asserted claim numbers, asserted product model numbers and claim charts for each patent.” EX2005. The Request does not show any response to Petitioner’s request for the specific claims, products, and claim charts before the ’000 patent expired on December 21, 2021. Thus, Samsung had a settled expectation of non-enforcement based on the expiration of the ’000 patent and PO’s failure to show a response with the requested information.

Further, on June 15, 2022, in a proceeding involving two related patents which share a common specification with the ’000 patent—i.e., U.S. Patent Nos. 10,129,627 (“the ’627 patent”) and 10,468,047 (“the ’047 patent”)—the Central District of California found that Bluetooth-Compatible products do not infringe the ’627 and ’047 patents based on compliance with the Bluetooth Specification in view of the Court’s construction of the term “unique user code,” and granted Apple Inc.’s (“Apple”) motion for summary judgment of non-infringement. *One-E-Way, Inc. v. Apple Inc.*, 2022 WL 2564002, at \*9 (C.D. Cal. June 15, 2022). On August 14, 2023, the Federal Circuit affirmed the district court’s construction for “unique user code” and its finding that compliance with the Bluetooth Specification did not meet this limitation. *One-E-Way, Inc. v. Apple Inc.*, 2023 WL 5199501 (Fed. Cir. Aug. 14, 2023). Since “unique user code” is present in every claim of the ’000, ’627 and ’047

patents, Samsung had settled expectations that its Bluetooth-Compatible products did not infringe the '000 patent and that the '000 patent would not be asserted against Petitioner.

## **II. THE *FINTIV* FACTORS FAVOR INSTITUTION**

### **A. Factor 1: The District Court Stayed the Related Litigation**

The district court stayed the related litigation on October 29, 2025. EX2007. Thus, this factor heavily favors institution. *See Google LLC v. Sandpiper CDN, LLC*, IPR2025-00806, Paper 13 at 2 (Deshpande, C.J., Sep. 12, 2025); *Nintendo Co., Ltd. et al. v. Resonant Sys., Inc.*, IPR2025-00680, Paper 18 at 2 (Director Aug. 14, 2025).

While PO cites to *Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (Director July 31, 2025) to assert that a litigation stay is not dispositive on the issue of discretionary denial (Request at 10-11), that decision confirms that a stay counsels against discretionary denial. And, unlike in *Kahoot!*, Petitioner has explained why PO has no settled expectations in view of the Sony IPR and why Petitioner has strong settled expectations of non-enforcement. *See infra* Section IV.

### **B. Factor 2: An FWD Will Issue Before Trial**

With the district court's stay in place, there is no dispute that an FWD will issue before any trial. Indeed, even without the stay, the deadline for an FWD is March 30, 2027—one week before the previously scheduled trial date of April 5, 2027. EX2008, ¶19. Accordingly, this factor weighs heavily in favor of institution.

PO speculates that the length of the stay may only be three months based on an incorrect assertion that “the projected date for a decision on discretionary considerations for the instant Petition is January 20, 2026.” Request at 10-11. PO’s speculation on the timing of Director’s decision on institution is immaterial because there is no question that a trial will not occur before the FWD deadline.

**C. Factor 3: There Has Been Minimal Investment in the Related Litigation**

Investment in the parallel proceeding weighs against discretionary denial because the parties have invested little in the district court litigation thus far. Notably, the district court rejected PO’s argument that “the case is at an advanced stage in which both the parties and the Court have invested substantial resources” in granting Petitioner’s motion to stay. EX2007 at 4-5. Judge Pitman found that “[a]llowing the process before the PTAB to unfold will conserve judicial resources and avoid potential confusion of the issues before the Court holds a claim construction hearing and the parties begin to embark on fact discovery.” *Id.* at 5. The court explained that, since claim construction briefing had not completed and fact discovery had not begun, “this early stage of litigation favors a stay.” *Id.* The same factors already considered by the district court weigh against denial here.

PO asserts that there has been “a large amount of work in the parallel district court litigation” since “motions to dismiss based on collateral estoppel and

noninfringement have been fully briefed.” Request at 12. But Petitioner’s motion to dismiss based on collateral estoppel and non-infringement is based on the previous grant and affirmance of summary judgment of non-infringement for Bluetooth-Compatible products and highlights that *Petitioner* had settled expectations of non-infringement and non-enforcement based on the outcome of PO’s litigation against Apple’s Bluetooth-Compatible products. EX1031 at 1-9, 11-20. And the district court has neither held a hearing nor issued an order on the motion to dismiss, which weighs against exercising discretion to deny institution; indeed, as *Fintiv* explains, limited pretrial proceedings do not render a case advanced for discretionary denial purposes, especially where, as here, trial will not occur before a final written decision. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 10 (P.T.A.B. March 20, 2020). Thus, any work completed is not outcome-determinative.

The early stage of the case and the minimal investment by the parties—as the district court has found—thus weighs heavily in favor of institution.

**D. Factor 4: The *Sotera+* Stipulation Reduces Any Potential Overlap**

PO’s assertion that Petitioner’s *Sotera+* stipulation was untimely is without merit, as there is no set deadline for stipulations and PO cites no authority to the contrary. Petitioner’s broad stipulation outweighs every other *Fintiv* factor. *See* Petitioner’s Notification of District Court Stay and Stipulation to Materially Reduce Overlap with District Court Proceedings, Paper 8 (filed December 23, 2025).

Petitioner broadly stipulated that, if the Petition is instituted, Petitioner will not assert invalidity grounds in the underlying district court action including grounds that “could have reasonably been raised” in this IPR; any grounds that include any reference named in the Petition’s grounds; and any grounds including system art that include any patent or printed publication cited in the Petition. Paper 8 at 2.

This stipulation includes the standard *Sotera* stipulation and addresses duplication between product art and IPR art. *See id.* Thus, PO’s speculation concerning overlap of issues (Request at 12-14) lacks basis because this “broad stipulation . . . reduces the concern of inconsistent outcomes or significant duplication of efforts.” *Samsung Elecs. Co., Ltd. v. Wilus Inst. of Standards and Tech. Inc.*, IPR2025-00933, Paper 11 at 3 (Director Oct. 10, 2025); *see also Shenzhen Tuozhu Tech. Co. v. Stratasy, Inc.*, IPR2025-00438, Paper 10 at 3 (Director Jul. 17, 2025) (“a broad stipulation” helped “tip the balance against discretionary denial”). PO argues that the stipulation is deficient because it doesn’t bind “Petitioner’s co-defendants” in the district court case. Request at 14. But this factor favors institution *even if* other defendants are not bound. *Innolux Corp. v. Phenix Longhorn LLC*, IPR2025-00043, Paper 10 at 12 (P.T.A.B. May 15, 2025); *Luminex Int’l Co., Ltd. v. Signify Holdings B.V.*, IPR2024-00101, Paper 20 at 29-30 (Vidal Nov. 21, 2024).

**E. Factor 5: The Parties Are the Same**

Because PO and Petitioner are the parties in the district court litigation, and

because the Board will issue an FWD before any trial in the district court, this factor weighs against discretionary denial. *Samsung Elecs. Co. v. Staton Techiya, LLC*, IPR2022-00302, Paper 13 at 18-19 (P.T.A.B. July 11, 2022) (factor five weighs against discretionary denial when the statutory deadline for FWD is before the expected trial date in parallel litigation); *CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00289, Paper 7 at 16 (P.T.A.B. July 21, 2023) (same).

While PO cites to *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 (P.T.A.B. April 7, 2025) to argue this factor favors discretionary denial (Request at 16-17), unlike here, the *SAP* trial date was before the FWD deadline. *Id.* at 5-6.

#### **F. Factor 6: Other Circumstances Weigh in Favor of Institution**

Factor 6 weighs heavily against discretionary denial because the Petition provides strong arguments on the merits of the '000 patent's validity and addresses material errors made by the Patent Office during prosecution. *See infra* Section III.

##### *1. The Petition Provides Strong Arguments on the Merits*

The Request does not address the specific merits of the Petition. Request at 19-20. Instead, PO asserts that the Petition lacks merit, relying on vague generalities, and concludes that the other *Fintiv* factors and settled expectations outweigh any merit that might exist. *Id.* But all *Fintiv* factors point in favor of institution, and, as explained in Section IV below, Petitioner is the entity with settled expectations of *non-enforcement*. PO also ignores that the Petition relies on the same priority date

argument that the Board previously found to have merit in the Sony IPR, rendering PO's own publication prior art. *See infra* Section III. Petitioner's "strong showing on the merits"—as confirmed by institution of the Sony IPR—weighs against denial. *Apple v. Seven Networks*, IPR2020-00156, Paper 10 at 20 (P.T.A.B. June 15, 2020).

2. *The Petition Appropriately Uses Expert Testimony*

PO asserts that Petitioner relies extensively on Mr. Davies's opinion and faults Mr. Davies for explaining the technology and how it applies to the claims, as well as providing the knowledge of a person of ordinary skill in the art. Request at 17-18. PO also asserts that Mr. Davies is used to "'gap fill' holes" and cites *Google LLC v. Cerence Operating Co.*, No. 2024-01465, 2025 WL 1182608, at \*6 (P.T.A.B. Apr. 23, 2025) for the proposition that "the Petition's extensive reliance on conclusory expert testimony to gap-fill holes in the prior art demonstrates discretionary denial is appropriate." But PO misleadingly cites a *patent owner's* argument—not a finding of the Board. And PO fails to provide a single example supporting its argument.

Indeed, PO mischaracterizes the Petition and overstates its reliance on expert testimony, failing to identify any limitation that improperly relied on expert testimony. Mr. Davies's explanation of how a POSITA would have understood the prior art is the purpose of expert testimony. *Unification Techs. LLC v. Micron Tech. Inc.*, No. 2023-1348, 2024 WL 3738401, at \*7 (Fed. Cir. Aug. 9, 2024) (affirming Board's unpatentability finding where expert's opinion explained "how an ordinarily

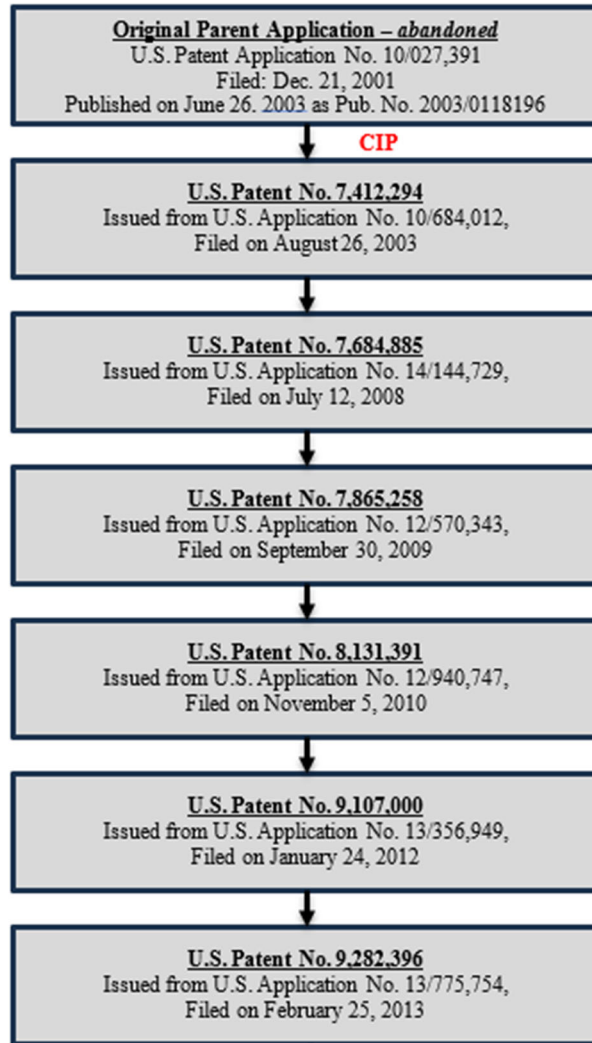
skilled artisan would have understood [the prior art's] description of” the claim term). The Petition relies on Mr. Davies to explain the background knowledge of a POSITA, and Mr. Davies’s testimony is supported by citations to evidence in the required manner. *See* 37 C.F.R. § 42.65(a); *iRhythm Techs. v. Welch Allyn Inc.*, IPR2025-00377, Paper 10 at 2-3 (Director June 6, 2025).

3. *The Board is Best Suited to Handle the Priority Date Issue*

PO argues that two IPR petitions filed by Apple Inc. on other patents, IPR2021-00286, -00287, weigh in favor of discretionary denial here. Request at 18. Not so. PO ignores that Apple’s petitions were denied institution because the Board found that the prior art references did not disclose either “independent code division multiple access communication” or the “unique user code” under the parties’ agreed constructions. *See Apple Inc. v. One-E-Way, Inc.*, IPR2021-00286, Paper 7 at 17-18, 22-23 (P.T.A.B. June 11, 2021). But Apple used PO’s own infringement allegations concerning Bluetooth to support invalidity arguments in those Petitions, and Apple later leveraged the Board’s findings that references concerning Bluetooth did not meet the claim limitations to demonstrate that Bluetooth-Compatible devices do not infringe the related ’627 patent. *Id.* at 21-22. This unique circumstance, as described further below in Section IV, demonstrates *Petitioner’s* settled expectations of non-infringement and non-enforcement.

While PO acknowledges the Sony IPRs (Request at 18-19), it ignores that the

instant Petition relies on the same priority date argument and PO's own prior art publication (i.e., the '196 publication) to assert invalidity here. Paper 1 at 3, 5-15. Sony's argument about the priority date of the '396 patent applies equally to the '000 patent because it is included in the same priority chain as illustrated below.



The Petition thus presents strong grounds for invalidity because there can be little dispute that PO's own publication teaches the limitations that the Office found missing in the Apple IPRs. Paper 1 at 17-21, 28-29. The Office already agreed in its

previous institution decision that it materially erred in relying on an improper and untimely incorporation by reference and by failing to reject improper new subject matter. *See infra* § III. As described further below, the Office’s error and the institution of the unresolved Sony IPR creates a strong basis to reject PO’s Request. *See Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00217, Paper 9, at 2-3 (Director June 13, 2025) (“Other considerations, however, counsel against discretionary denial. For example, Petitioner . . . asserts that the merits are strong because the Board previously determined there was a reasonable likelihood that similar claims of an ancestor patent were unpatentable in three separate proceedings with respect to some of the challenged patents in these proceedings.”). Moreover, the Board’s prior consideration of the priority date issue confirms that it is uniquely situated to handle this challenge as compared to the district court.

### **III. INSTITUTION IS APPROPRIATE BECAUSE THE PATENT OFFICE ERRED DURING PROSECUTION**

The Examiner made a material error in the prosecution of the ’000 patent with respect to the proper priority date, and correcting this error is an appropriate use of Office resources. *See, e.g., Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12 at 2-3 (Director July 17, 2025); *Anthony Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 12 at 2 (Director July 16, 2025) (even though the challenged patents have been long in force “it is an appropriate use of Office resources to review the potential

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error” made by the Office during prosecution); *Microsoft Corp. v. Partec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9 at 3 (P.T.A.B. June 12, 2025) (“it is an appropriate use of Office resources to review the potential error”). Even though this error was described in detail in the Petition (Paper 1 at 5-15, 14 n.4), PO provided no response to this issue in its brief.

Each application in the ’000 patent family claims priority to the prior applications in the chain. Merely claiming priority, however, is not sufficient for a claim to obtain the benefit of an earlier filing date. For the ’000 patent claims to be entitled to the priority date of the earliest application in the chain—the 2001 application—every application between the ’000 patent and that application must maintain disclosure that supports the claims. *See, e.g., Zenon Env’t, Inc. v. U.S. Filter Corp.*, 506 F.3d 1370, 1378–82 (Fed. Cir. 2007) (citations omitted) (reversing district court’s finding that the patent-in-suit was entitled to the priority date of an earlier filed patent because an intervening application did not meet the written description requirement, and holding the patent-in-suit anticipated by the earlier patent); *Anascape, Ltd. v. Nintendo of Am., Inc.*, 601 F.3d 1333, 1337 (Fed. Cir. 2010) (finding a parent application failed to provide written description support to entitle later claims to the benefit of the specification’s filing date because the later claims included text not present in the specification as originally filed).

Here, the PO broke the chain of disclosure in 2003 by filing a continuation-

in-part (“CIP”) application—U.S. Patent App. No. 10/648,012 (the “’012 application” or “2003 application”) (EX1005)—directed to a different invention than that of the ’000 claims. For example, the 2003 application as filed failed to support the following limitations of the challenged claims: “intersymbol interference,” “a direct conversion module,” and “differential phase shift keying (DPSK).” Paper 1 at 11-12. The 2003 application also did not include or incorporate by reference the disclosure of the earlier 2001 application, and PO’s subsequent amendments to the 2003 application’s specification (*see* Paper 1 at 12-14) cannot cure the break in the chain because the amendments were unsupported by the 2003 application’s disclosure as filed, and thus improperly introduced new matter. *See, e.g., Anascape, Ltd.*, 601 F.3d at 1337. The Examiner committed material error by allowing new matter amendments, including additions from the 2001 application’s specification. Paper 1 at 12-14, 14 n.4. By the time the 2003 application issued as U.S. Patent No. 7,412,294 (EX1006) on August 12, 2008, the specification and figures of the ’294 patent were completely different from the as-filed 2003 application. *See* EX1010.

In 2016, Sony filed an IPR petition with respect to the related ’396 patent, and argued that the challenged claims were invalid in view of the ’196 publication due to the break in the chain of disclosure in the 2003 application. *Sony IPR* at 5-13. The PTAB concluded on February 22, 2017 that Sony had “shown sufficiently that the

[2003] application failed to maintain continuity of disclosure with the [2001] application, and, as a result, the [later, related] patent is not entitled to the benefit of the filing date of the [2003] application or the [2001] application” and instituted review. *Id.* at 12-13, 17. The parties settled in February 2018 after the oral hearing but before a FWD issued. *Id.*, Papers 38, 39.

During prosecution of the '000 patent, PO argued “in the application’s review, it is tantamount to view the invention as of its date of priority (at least), December 21, **2001**.” EX1002, at 162 (emphasis in original). Moreover, after multiple rounds of Office Actions with PO asserting that limitations directed to independent CDMA, differential encoding, and reduced intersymbol interference distinguished the claimed invention from the prior art, the Office provided an Examiner’s Amendment in the Notice of Allowance, but no reason for allowance. EX1002 at 228-234, 293-302, 682-691. But as the Petition shows, the '196 publication teaches and/or renders obvious what was claimed to be novel throughout prosecution by PO as well as what was in the contents of the Examiner’s Amendment. Paper 1 at 17-39.

Because the Office materially erred by not rejecting improper new matter and in applying an erroneous priority date, as confirmed via the Sony IPR papers, the Office should not deny the present Petition, which raises the same issue the Board previously found demonstrated a reasonable likelihood that the petitioner would prevail with respect to at least one of the challenged claims based on the '196

publication. *C.f. Carbyne, Inc. v. TriTech Software Sys.*, IPR2025-00959, Paper 11 at 2 (Stewart Oct. 3, 2025) (referring in part based on examiner error where reference “cited on an IDS during prosecution” “appears to disclose the purportedly missing claim limitations” leading to allowance).

#### **IV. SETTLED EXPECTATIONS SUPPORT A MERITS CONSIDERATION**

The Board should also deny PO’s discretionary denial in view of the expectations of the parties. *See* USPTO “Interim Processes for PTAB Workload Management,” Mar. 26, 2025, 2 (“relevant considerations” for discretionary denial may include “[s]ettled expectations of *the parties*”) (emphasis added).

##### **A. PO Has No Settled Expectations Because it Knew of Serious Invalidity Issues Since 2017**

PO’s knowledge of the priority defect of the ’000 patent since 2017 renders PO’s assertions of settled expectations meritless.

As explained in Section III above, the Sony IPR was filed against a patent in the same priority chain of the ’000 patent—the ’396 patent—alleging that the challenged claims were not entitled to a 2001 priority date because there is a break in the chain of disclosure that rendered PO’s own patent publication, the ’196 publication, prior art that rendered obvious patents in the same chain. The Board, in its institution decision dated February 22, 2017, found (1) “the incorporation by reference statement added to the ’012 application after its filing date is improper new

matter and cannot be relied on to show continuity of disclosure with the '391 application;" and (2) Sony had "sufficiently shown that the '012 application failed to maintain continuity of disclosure with the '391 application, and, as a result, the '396 patent is not entitled to the benefit of the filing date of the '012 application or the '391 application." *Sony IPR* at 9-10, 12-13. Oral argument was heard on November 6, 2017, but before the Board could resolve the priority date dispute, the parties filed a joint request to terminate the proceedings on February 8, 2018—*two weeks* before the FWD deadline. *Id.*, Papers 38-39. Thus, contrary to PO's argument, PO has never had a settled expectation of validity since it has long been aware of the break in the priority chain and the Office's material errors stemming from its failure to reject improper new matter in the 2003 application and its application of an erroneous priority date during prosecution of the '000 patent. *Azurity Pharms., Inc. v. Helsinn Healthcare S.A.*, IPR2025-00945, Paper 11 at 2-3 (Stewart Sep. 19, 2025) (referring 11-year old patent based on examiner's erroneous assessment of unexpected results); *Taiwan Semiconductor Manufacturing Co. Ltd., et al v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 at 3-4 (Stewart Sep. 3, 2025) (referring 15-year old patent based on examiner's failure to apply reference cited during prosecution).

Furthermore, the mere passage of time cannot create a reasonable settled expectation of validity where, as here, PO was on notice of a substantial priority

defect since at least February 22, 2017—the date the Sony IPR was instituted. As the Federal Circuit recognized in *Zenon Env't, Inc. v. U.S. Filter Corp.*, 506 F.3d 1370 (Fed. Cir. 2007), and *Anascape, Ltd. v. Nintendo of Am., Inc.*, 601 F.3d 1333 (Fed. Cir. 2010), entitlement to priority depends on maintaining proper disclosure in the chain, and a known defect defeats any claim to settled expectations. Accordingly, discretionary denial on the basis of settled expectations is unwarranted.

**B. Petitioner Has a Settled Expectation of Non-Enforcement**

Contrary to PO's argument, Samsung has a settled expectation of non-enforcement and non-infringement. As indicated in the Request (at 7), PO sent a letter to Samsung indicating that Samsung's "Bluetooth-Compatible products" infringe certain patents, including the '000 patent, on April 10, 2020. EX2004 at 2. Petitioner promptly wrote back on April 22, 2020 requesting that PO provide "asserted claim numbers, asserted product model numbers and claim charts for each patent." EX2005. The Request does not show any response to Petitioner's request for the specific claims, product model numbers, or claim charts before the expiration of the '000 patent. Thus, contrary to PO's assertion—Petitioner had notice of the '000 patent but was not on notice of infringement of the '000 patent.<sup>2</sup> Moreover,

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<sup>2</sup> PO asserts that Petitioner had notice of the '000 patent based on references to related patents during the prosecution of Samsung's patent applications in 2011 and 2012. Request at 7-8. But PO admits that the '000 patent did not issue until 2015,

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when PO apparently failed to respond to Samsung’s letter and when the ’000 patent expired on December 21, 2021, Samsung had a settled expectation of non-enforcement. *Apple Inc. v. Allani*, IPR2025-00856, Paper 11 at 3 (P.T.A.B. Sept. 5, 2025) (finding a settled expectation of non-enforcement where patent owner did not file suit “until eleven years after the parties’ discussion about that patent” and where “Patent Owner did not assert the challenged patents against Petitioner until after they expired.”); *Globus Med., Inc. v. Spinelogik, Inc.*, IPR2025-00225, Paper 8 at 2 (P.T.A.B. June 12, 2025) (patent expiring “almost four years ago” supported expectation of “non-enforcement of the challenged patent”).

Additionally, PO asserted two patents related to the ’000 patent—the ’627 and ’047 patents—against Apple in a suit filed in the Central District of California on July 16, 2020, months after PO failed to respond to Samsung’s correspondence. *One-E-Way, Inc.*, 2022 WL 2564002, at \*1. On June 15, 2022, the Central District of California granted Apple’s motion for summary judgment of non-infringement of the Accused Products, finding that compliance with the Bluetooth Specification did not result in the infringement of the related ’627 and ’047 patents in view of the court’s construction of the term “unique user code,” which was present in all of the ’627 and ’047 patent claims. *Id.* at \*9. The Federal Circuit affirmed the district

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and thus Samsung could not have been on notice of the ’000 patent in 2011 or 2012.

court's construction and its finding that compliance with the Bluetooth Specification didn't infringe the related '627 and '047 patents on August 14, 2023. *One-E-Way*, 2023 WL 5199501. Since "unique user code" is also present in every claim of the '000 patent, Samsung had settled expectations that its Bluetooth-Compatible products did not infringe the '000 patent and that the '000 patent would not be asserted against Samsung given the Federal Circuit's binding decision. Indeed, the only basis for infringement alleged in PO's letter was use of the Bluetooth Specification. *See* EX2004.

Accordingly, Samsung had a settled expectation that it would not be sued since at least mid-2020, and those expectations were strengthened in June 2022 and August 2023 with the Central District of California's grant of summary judgment of non-infringement for products that implement the Bluetooth Specification and the Federal Circuit's affirmance of the same.

## **V. CONCLUSION**

For these reasons, Petitioner respectfully requests that the Director decline to exercise discretion to deny institution and institute the Petition on the merits.

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Dated: December 30, 2025

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

The undersigned certifies that on December 30, 2025, I caused a true and correct copy of PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION to be served on Patent Owner by filing this document and associated exhibit through the Patent Trial and Appeal Case Tracking System (P-TACTS) and transmitting these documents via electronic mail upon counsel of record for the Patent Owner as follows:

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