

**Opposition To Request For Discretionary Denial
U.S. Patent No. 11,573,939**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioner,

v.

KANNUU PTY LTD.,

Patent Owner.

Case No. IPR2026-00071

U.S. Patent No. 11,573,939

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

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TABLE OF EXHIBITS

No.	Short Name	Exhibit
1001	'939 Patent	U.S. Patent No. 11,573,939
1002	'939 File History	File History of U.S. Patent No. 11,573,939
1003	Madisetti Decl.	Declaration of Vijay Madisetti, Ph.D.
1004	Madisetti CV	Curriculum Vitae of Vijay Madisetti, Ph.D.
1005	<i>Perlman</i>	U.S. Pat. Pub. No. 2002/0113825 A1
1006	<i>Dostie</i>	U.S. Pat. Pub. No. 2004/0021691
1007	<i>Pu</i>	U.S. Patent No. 7,152,213
1008	<i>Josenhans</i>	U.S. Patent Publication No. 2002/0078013
1009	<i>Badarneh</i>	Int'l Patent Pub. No. WO2002/091160
1010	<i>Schroeder</i>	U.S. Patent No. 5,797,098
1011	<i>Strubbe</i>	U.S. Patent No. 5,223,924
1012	<i>Montgomery</i>	U.S. Patent No. 3,309,677
1013	'354 FWD	Final Written Decision, IPR2020-00737, Paper 105 (PTAB Sept. 21, 2021) (filed under seal)
1014	'393 FWD	Final Written Decision, IPR2020-00738, Paper 100 (PTAB Sept. 21, 2021) (filed under seal)
1015	'852 Final Rejection	Final Rejection, Reexamination No. 90/014,760 (July 28, 2022)
1016	'852 PTAB Decision	Decision on Appeal, Reexamination No. 90/014,760 (PTAB Sept. 19, 2023)
1017	'579 Final Rejection	Final Rejection, Reexamination No. 90/014,761 (July 28, 2022)
1018	'579 PTAB Decision	Decision on Appeal, Reexamination No. 90/014,761 (PTAB Sept. 19, 2023)
1019	'354/'393 IPR Appeal	Judgment, <i>Kannuu Pty Ltd. v. Samsung Elecs. Am., Inc.</i> , No. 22-1526 (Fed. Cir. Oct. 11, 2013)

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No.	Short Name	Exhibit
1020	'264 Final Rejection	Final Rejection, Reexamination No. 90/014,759 (Sept. 2, 2022)
1021	'264 PTAB Decision	Decision on Appeal, Reexamination No. 90/014,759 (PTAB Sept. 19, 2023)
1022	'252 Patent	U.S. Patent No. 11,200,252
1023		Samsung Document Production SAMSUNG_K_00035577-00035704 (filed under seal)
1024		[intentionally omitted]
1025		Samsung Document Production SAMSUNG_K_00035597 -603 -619 (Original) (filed under seal)
1026		30(b)(6) Deposition Transcript from IPR2020-00737 and IPR2020-00738 (filed under seal)
1027		Samsung's Supplemental Interrogatory Response to Kannuu's Interrogatory in IPR2020-00737 and IPR2020-00738 (filed under seal)
1028		[intentionally omitted]
1029		[intentionally omitted]
1030		[intentionally omitted]
1031		[intentionally omitted]
1032		[intentionally omitted]
1033		KAN-PTAB00001830, Kannuu--Revenue 2010-2018.pdf (filed under seal)
1034		KAN-PTAB00001655 (filed under seal)
1035		KAN-PTAB00001505 (filed under seal)
1036		KAN-PTAB00000236 (filed under seal)
1037		KAN-PTAB00000025 (filed under seal)

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No.	Short Name	Exhibit
1038		KAN-PTAB00000910 (filed under seal)
1039		KAN-PTAB00000919 (filed under seal)
1040		KAN-PTAB00000099 (filed under seal)
1041		KAN-PTAB00000118 (filed under seal)
1042		KAN-PTAB00000168 (filed under seal)
1043		KAN-PTAB00000973 (filed under seal)
1044		KAN-PTAB00001095 (filed under seal)
1045		KAN-PTAB00001237 (filed under seal)
1046		KAN-PTAB00000386 (filed under seal)
1047		KAN-PTAB00000989 (filed under seal)
1048		KAN-PTAB00001278 (filed under seal)
1049		KAN-PTAB00001327 (filed under seal)
1050		KAN-PTAB00001323 (filed under seal)
1051		KAN-PTAB00001803 (filed under seal)
1052		KAN-PTAB00001515 (filed under seal)
1053		KAN-PTAB00001796 (filed under seal)
1054		KAN-PTAB00001056 (filed under seal)
1055		KAN-PTAB00001618 (filed under seal)
1056		KAN-PTAB00001661 (filed under seal)
1057		[intentionally omitted]
1058		SAMSUNG-KANNUU-IPRS-00002 (filed under seal)
1059		SAMSUNG-KANNUU-IPRS-00002(Translation) (filed under seal)

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No.	Short Name	Exhibit
1060		Opinion and Order, <i>Kannuu Pty Ltd. v. Samsung Electronics Co., Ltd. et al.</i> , No. 1:19-cv-04297-ER, D.I. 93 (Jan. 19, 2021)
1061		U.S. District Court Time-to-Trial Statistics for SDNY (Sept. 2025)

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I. INTRODUCTION

The Director should deny Patent Owner’s request for discretionary denial in this proceeding (Paper 9) (“Request”) and in IPR2026-00072 involving U.S. Pat. No. 11,200,252, an unrelated patent that nevertheless claims very similar subject matter. Each of the relevant factors weigh against denial. Settled expectations do not apply here, the PTO committed material errors during prosecution, and all of the *Fintiv* factors weigh in favor of institution.

First, Patent Owner lacks settled expectations because the ’939 patent was issued in 2023 and the ’252 patent was issued in 2021. Moreover, five patents related to either the ’939 patent or ’252 patent have been invalidated via *inter partes* review or *ex parte* reexamination, removing any expectations of validity for the ’939 and ’252 patent, which are mere obvious variants of the other five. The petition here and against the ’252 patent also use nearly the same art presented against the five patents and therefore many of the issues have already been determined by the Board. Institution would be highly efficient.

Second, institution is appropriate to cure the material errors committed by the examiner during prosecution of the ’939 patent. Although the examiner had all four prior art references before him, the examiner did not discuss Badarneh, one of the main prior art references that Petitioner relies on. Moreover, the examiner

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overlooked important disclosures in Perlman that teach the “up, down, left, right, select functionality” and a “circular menu.”

Finally, the *Fintiv* factors heavily weigh against denial because there is currently no trial date and the Court has previously stayed the case following filing of IPR petitions against now-invalidated patents. Patent Owner’s complaint that the parallel litigation has been pending for six years is no reason to deny, as the delay is entirely due to Patent Owner asserting five invalid patents.

II. SETTLED EXPECTATIONS HEAVILY WEIGH AGAINST DENIAL

Patent Owner lacks settled expectations because the ’939 patent and the ’252 patent were only recently issued in 2023 and 2021, respectfully. Thus, PO “has not developed strong settled expectations that favor discretionary denial.” *See Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11 at 2-3 (June 26, 2025) (finding 2020 patent to lack settled expectations). Moreover, five patents that are related to the ’939 patent or ’252 patent have previously been invalidated. Specifically, U.S. Patent Nos. 9,436,354 and 8,370,393 were invalidated in IPR2020-00737 and -00738, respectfully. And U.S. Patent Nos. 9,697,264, 8,676,852 and 8,966,579 were invalidated following *ex parte* reexamination requests against them. The ’354, ’393, ’852, and ’579 patents are related to the ’939 patent via continuation applications, and the ’264 is a predecessor of the ’252 patent via continuation applications. The ’354, ’393, ’852, and ’579

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patents recite similar subject matter as the '939 and '252 patents—specifically, a remote control with a predictive keyboard. Indeed, during prosecution of the '939 patent, the applicant filed a terminal disclaimer to overcome obviousness-type double patenting over the related '354, '393, '852, and '579 patents. Accordingly, Patent Owner had no settled expectations to the validity of the '939 patent.

III. EFFICIENCY AND CONSISTENCY STRONGLY WEIGH AGAINST DISCRETIONARY DENIAL

Given that five patents related to either the '939 patent or '252 patent have all been invalidated using largely the same art, institution of these two IPRs would greatly promote efficiency and consistency. The vast majority of limitations found in the '939 and '252 patents are shared by the invalidated patents and therefore have already been found invalid. Those previous findings should greatly simplify the issues in these current proceedings, promoting efficiency and consistency. *See POSCO Co., Ltd. v. Arcelormittal*, IPR2025-00370, -00371, Paper 10 at 3 (Director Jun. 25, 2025) (“The fact that the Board previously determined related claims to be unpatentable—prior to the issuance of the challenged claims in this proceeding—tips the balance against discretionary denial.”).

Indeed, despite the length of the Challenged Claim in the '939 patent, Patent Owner describes the difference between the claim and the invalidated '579 patent as a narrowing “to the context of a television with a specific type of remote control

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keypad—one with ‘an up, down, left, right, select functionality’—that further ‘enables the selections’ of ‘item identifiers,’ such as letters or numbers in a movie title, ‘specifically positioned in a circular menu’ on the display of the television.” Request at 11. As discussed below, television and circular, directional remotes were anything but novel. Regardless, Patent Owner admits that the similarities between the ’939 and ’252 patents on the one hand and the earlier patents on the other are encompassed by a handful of limitations. Thus, efficiency and consistency weigh against discretionary denial.

IV. THE EXAMINER ERRED IN ALLOWING THE ’939 PATENT

Patent Owner contends that denial is warranted because the examiner considered all of the art presented in the Petition, and that Patent Owner specifically crafted the claim language to avoid that art. Request at 3-13.

However, Patent Owner does not dispute that the IPR art discloses the new language introduced in the ’393 patent, and the examiner therefore erred by overlooking these key disclosures.

A. The Examiner Overlooked Badarneh

The examiner entirely overlooked the Badarneh reference which anticipates and renders obvious the Challenged Claim. Pet. 47-72. Although Badarneh was before the examiner, the “Examiner did not issue any prior art rejections during examination” based on Badarneh or even discuss the reference. *Ecto World, LLC v.*

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Rai Strategic Holdings, Inc., IPR2024-01280, Paper 13 at 5-6 (May 19, 2025) (precedential). This constituted material error because the significance of Badarneh was plain—it was one of the primary references asserted in the IPRs and *ex parte* reexaminations brought by Petitioner against the five invalidated patents. As Patent Owner admits, the records from those proceedings were before the examiner. Accordingly, in failing to even acknowledge the Badarneh reference despite its obvious relevance, the examiner materially erred.

The examiner’s failure to address Badarneh was also material error because Badarneh discloses the very limitations that Patent Owner claims to be novel. As discussed above, Patent Owner claims it drafted the Challenged Claim to narrowly include “the context of a television with a specific type of remote control keypad—one with ‘an up, down, left, right, select functionality’—that further ‘enables the selections’ of ‘item identifiers,’ such as letters or numbers in a movie title, ‘specifically positioned in a circular menu’ on the display of the television.” Request at 11. These limitations, however, are clearly disclosed by Badarneh.

Badarneh’s teaches that “all screen-assisted and screen-based devices can be used,” including “larger display screens” with “remote control units.” Ex. 1009, 1:27-30, 4:6-11. This description clearly includes a television. Ex. 1003, ¶143. Badarneh also plainly teaches a remote control with up/down/left/right/select

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to review the[se] potential error[s].” *Taiwan Semiconductor Manufacturing Co. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 (Director Sept. 3, 2025); *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025 00153, Paper 11 at 3 (June 12, 2025) (“Petitioner relies on Letendre to teach a ‘slide,’ and Patent Owner does not dispute that Letendre teaches a ‘slider.’”).

Patent Owner instead alleges that Badarneh is “substantially similar to Pu.” Request at 4-5. But Patent Owner’s comparison of Badarneh and Pu merely states they are both directed to graphical user interfaces for performing predictive text entry, a shallow similarity that would describe any art within the same field of endeavor. Patent Owner does not show how Badarneh is substantially similar to Pu in “relevant part,” *i.e.* with respect to how they fail to disclose what Patent Owner claims are the novel features of the ’939 patent. *Advanced Bionics*, IPR2019-01469, Paper 6 at 15 (Feb. 13, 2020) (precedential). In fact, unlike Badarneh, Pu does not disclose up/down/left/right/select functionality in a circular menu. Pu instead teaches using a 1-9 number pad for input. *See, e.g.*, Ex. 1007, Fig. 13A.

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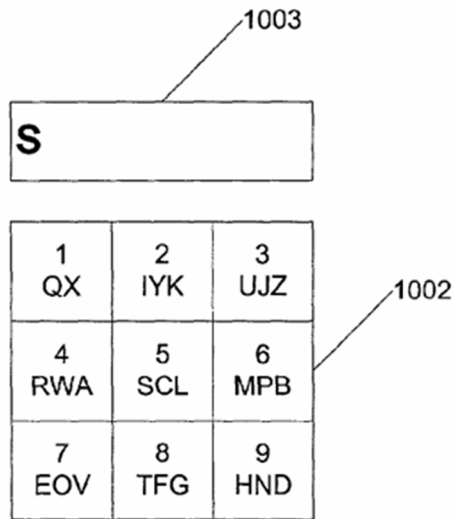


FIG. 13A

B. The Examiner Overlooked Perlman

The examiner also materially erred because he overlooked key teachings in Perlman. Although the examiner discussed Perlman in several rejections of the '939 patent, the examiner nevertheless failed to consider important teachings in Perlman that “teach[] the limitations of the challenged claims, and that no reasonable examiner could have found otherwise.” *Ecto World*, Paper 13 at 6.

Perlman discloses the limitations that Patent Owner claims were novel. Specifically, Perlman discloses “the context of a television with a specific type of remote control keypad—one with ‘an up, down, left, right, select functionality’—that further ‘enables the selections’ of ‘item identifiers,’ such as letters or numbers

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in a movie title, ‘specifically positioned in a circular menu’ on the display of the television.” Request at 11.

Perlman teaches user interaction “without looking away from the television/computer screen,” which plainly teaches a television. Ex. 1005, ¶14. Indeed, the Board has already concluded that Perlman discloses the limitation “wherein the computing device is a television.” Ex. 1014, 70.

Perlman also plainly teaches a remote control with up/down/left/right/select functionality positioned in a circular menu displayed on the screen. Specifically, Perlman’s remote control keypad has “directional and functional buttons 101” and “a ‘select’ button 108 for making various types of data selections.” Ex. 1005, ¶14; Fig. 2. As shown in Figure 2, the buttons are arranged in a circular menu on the screen. The Board has already concurred, finding that Perlman teaches “wherein the further one of more parts of item identifiers being arranged on the display relative to one another and corresponding to at least an up, down, left or right position.” Ex. 1013, 38-42.

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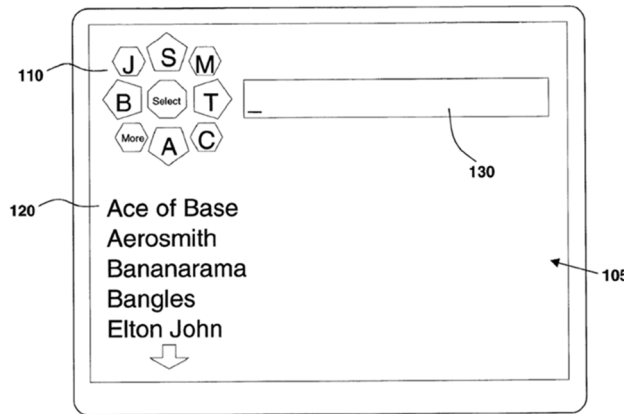


FIG. 2

Finally, Perlman plainly discloses that the remote control keys enable selection of “item identifiers.” Each of the remote control keys is a “character-mapped button[.]” that selects the mapped letter when pressed. Ex. 1005, ¶14, 17 (“As the user selects letters via the displayed character-mapped buttons 110, the user's letter selections will appear in a text box 130”).

Patent Owner does not dispute that Perlman discloses each of these limitations. Patent Owner merely asserts that because the examiner discussed Perlman and used it as the basis of its rejections, the examiner must have considered the full scope of its disclosures. Critically, however, *the Challenged Claim was not subject to any examiner rejection*—the examiner used Perlman to reject other claims that were later cancelled. Because it is not disputed that Perlman teaches what Patent Owner claims are the novel features of the '939 patent, the examiner materially erred by overlooking such teachings. *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025

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00153, Paper 11 at 3 (June 12, 2025) (“Petitioner relies on Letendre to teach a ‘slide,’ and Patent Owner does not dispute that Letendre teaches a ‘slider.’”).

V. THE *FINTIV* FACTORS WEIGH AGAINST DISCRETIONARY DENIAL

The *Fintiv* factors heavily weigh against denial, including the fact that no trial date is scheduled and the Court has already previously stayed the case in view of challenges to related patents.

A. Factor 1: The District Court is Inclined to a Stay

This factor heavily weighs against denial because the Court has already stayed the parallel litigation because of pending IPRs. The parallel litigation originally involved five patents that have all been found invalid. Petitioner had previously filed IPR challenges to all five patents. The Board instituted two of the petitions, but declined institution for the other three. Prior to Petitioner filing *ex parte* reexamination requests against the three patents that were denied IPR institution, the court granted Petitioner’s motion to stay, concluding that a stay would simplify the issues even with the three denied IPRs. Ex. 1060 at 18-19. Thus, if the Board were to institute one (or both) of the IPR petitions against the ’939 or ’252 patents, the Court is likely to stay the case once more. Indeed, Patent owner admits that “if the IPR petitions are instituted,” there will be “additional stays.” Request at 13-14.

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B. Factor 2: No Trial is Scheduled

Currently, no trial is scheduled, which significantly weighs against denial. *See Imperative Care, Inc. v. Inari Medical, Inc.*, IPR2025-00289, Paper 9 at 2 (Director June 12, 2025) (denying to exercise discretion where “there is no trial date scheduled in the district court”).

On July 29, 2025, the Court granted Patent Owner’s motion for leave to amend the complaint. On August 13, 2025, Patent Owner filed an amended complaint, adding the ’939 and ’252 patents to its claims of infringement. And on August 27, 2025, Petitioner filed an Answer. Since then, however, the parallel litigation has not progressed any further. No scheduling conference has occurred and no trial date has been set. In fact, prior to the stay of the case in 2021, the Court had not scheduled any trial date. While the parties had agreed to a schedule, it did not include a trial date. Instead, the parties were to file a Joint Pretrial Statement 30 days after the Court’s decision on any dispositive motions, and then Pretrial Filings 30 days following the statement.

It is therefore very likely that the Board will issue a Final Written Decision before any trial has occurred. The Board’s statutory deadline for a Final Written Decision is April 24, 2027. Even if the parallel litigation were to proceed, the Court is unlikely to schedule a trial until after case dispositive motions are decided.

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Moreover, the Southern District of New York’s official time-to-trial statistics show that the most recent median time-to-trial for the district court is 34.2 months from the date of filing. Because the amended complaint was filed on August 2025, that would place trial sometime in June 2028, over a year after the Board’s statutory deadline. Ex. 1061.

C. Factor 3: The Parties’ Limited Investment In The District Court Litigation Weighs Against Discretionary Denial

This factor significantly weighs against discretionary denial. As of the filing of this Opposition, the parallel litigation has not progressed beyond the filing of Patent Owner’s Amended Complaint and Petitioner’s Answer. No schedule has been put in place and discovery has not begun. Thus, the parties have not put in any investment into the parallel litigation.

Moreover, Petitioner exercised significant diligence in bringing the IPR petitions without delay. These petitions were filed a mere two months after Patent Owner amended its complaint to add the ’939 patent and ’252 patent.

D. Factor 4: Petitioner’s Broad Stipulation

Petitioner has filed a broad stipulation that closes the loophole that the Director identified in *Motorola. Motorola Sols.*, IPR2024-01205, Paper 19 at 4 (“Petitioner’s invalidity arguments in the district court are more expansive and

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include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner's stipulation is not likely to moot.").

Specifically, Petitioner stipulates that, if this petition is instituted (and not later denied institution or dismissed without a Final Written Decision), Petitioner will not assert in the parallel litigation:

(1) any grounds of invalidity arising under U.S.C. § 102 or § 103 involving only patent or printed publication prior art that could have reasonably been raised before the Board with respect to U.S. Pat. No. 11,573,939 (the '939 patent), including the same grounds in the Petition (Paper 3); or

(2) any grounds of invalidity arising under U.S.C. § 102 or § 103 with respect to the '939 patent that include U.S. Pat. Pub. No. 2002/0133825 ("Perlman"), U.S. Pat. Pub. No. 2004/0021691 ("Dostie"), U.S. Pat. Pub. No. 2002/0078103 ("Josenhans"), or WO 2002/01160 ("Badarneh").

This stipulation includes a *Sotera* stipulation as well as a stipulation not to use any of the IPR prior art, even in combination with system art that could not be raised in the IPR. This stipulation therefore removes any overlap between the parallel litigation and this proceeding and significantly weighs against denial. *Samsung Electronics Co., Ltd. v. Wilus Institute of Standards and Technology Inc.*, IPR2025-00933 *et al.*, Paper 11 (Director Oct. 10, 2025) ("Petitioner has filed a broad stipulation that reduces the concern of inconsistent outcomes or significant duplication of efforts.").

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E. Factor 5: Petitioners Being the District Court Defendants Does Not Outweigh the Factors Weighing Against Discretionary Denial

Petitioner is the defendant in the district court case. This factor does not outweigh the other factors discussed above.

F. Factor 6: The Merits of the Petition are Strong

Although Patent Owner asserts that the petition is “likely to fail on the merits,” Patent Owner does not provide any explanation as to how the grounds are deficient. As discussed above, both Perlman and Badarneh clearly teach the limitations that Patent Owner claims are the novel features, and Patent Owner’s Request does not argue otherwise. Thus, the merits of the petition are strong and weigh against denial.

VI. THE PENDENCY OF THE PARALLEL LITIGATION NOT INVOLVING THE CHALLENGED PATENTS DOES NOT WARRANT DISCRETIONARY DENIAL

Patent Owner argues that discretionary denial is warranted because the parallel litigation has been pending for over six years and may end up pending for over a decade if the Board institutes these IPR proceedings. Request at 13-14. Patent Owner cites to no authority to support its argument.

As noted above, however, this is misleading. The litigation *involving the ’939 and ’252 patents* has only been pending since August 2025, when Patent Owner filed their Amended Complaint. Moreover, the overall pendency of the parallel litigation is attributable solely to Patent Owner’s assertion of five patents that lacked novelty and have since been invalidated—the litigation was stayed while those

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invalidity proceedings ran their course. It was entirely Patent Owner's decision to continue defending patents that lacked novelty, leading to years of examination and appeals. If Patent Owner had wished to quickly resume the breach of contract claim in the parallel litigation, Patent Owner could have done so at any time by disclaiming the five patents or dismissing them from the complaint. Instead, Patent Owner chose not only to allow the challenges against the five original patents to proceed for years and allow the parallel litigation to remain stayed but also chose to assert new patents from the same family that suffer from the same defects. Patent Owner cannot claim any prejudice for any pendency of the case that stems entirely from Patent Owner's assertion of invalid patents.

VII. CONCLUSION

Patent Owner has identified no legitimate basis for the Director to deny institution based on any discretionary factors. Institution should be granted.

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Respectfully submitted,

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