

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.
Petitioner,

v.

KANNUU PTY LTD.
Patent Owner.

CASE IPR2026-00071
U.S. Patent No. 11,573,939

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
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TABLE OF ABBREVIATIONS

Abbreviation	Term
Kannuu	Patent Owner Kannuu Pty. Ltd.
Samsung	Petitioner Samsung Electronics America, Inc.
POSITA	Person of ordinary skill in the art
The '252 patent	U.S. Pat. No. 11,200,252
The '939 patent	U.S. Pat. No. 11,573,939
The '264 patent	U.S. Patent No. 9,697,264
The '354 patent	U.S. Patent No. 9,436,354
The '393 patent	U.S. Patent No. 8,370,393
The '579 patent	U.S. Patent No. 8,996,579
The '852 patent	U.S. Patent No. 8,676,852
The Initial Patents	The '264, '354, '393, '579, and '852 patents
The Instituted Patents	The '252 and '939 patents
The Instituted Claims	Claim 1 of the '939 patent
PTAB or the Board	Patent Trial and Appeal Board
IPR	<i>Inter Partes</i> Review
NDA	April 5, 2012 Mutual Non-Disclosure Agreement between Kannuu and Samsung Electronics America, Inc.

SDNY

Southern District of New York

I. INTRODUCTION

Samsung’s Petition challenging the patentability of the Instituted Patents should be discretionarily denied. *See* Memorandum from Director John A. Squires, Director Institution of AIA Trial Proceedings, Oct. 17, 2025 (“Director Institution Memo”); Memorandum from Acting Director Coke Morgan Stewart, Interim Processes for PTAB Workload Management, March 26, 2025 (“Interim Processes Memo”).

First, all of Samsung’s asserted prior art was presented to the Office during examination of the ‘939 patent.¹ *See* ‘939 Patent (citing all four references). Indeed, of the four references asserted in this IPR by Samsung, three were specifically considered and discussed in the Office Actions of the Instituted Patents. *See infra* Part II.

There is no indication that the Office materially erred in its examination. Samsung’s contention that the claims are not materially different from those in Kannuu’s Initial Patents—which were canceled in IPR and *ex parte* reexamination proceedings—is meritless. Indeed, based on the prior proceedings, Kannuu

¹ The references asserted in Samsung’s Petition are U.S. Pat. Pub. No. 2002/0113825 A1 (“Perlman”); U.S. Pat. Pub. No. 2004/0021691 (“Dostie”); U.S. Pat. Pub. No. 2002/0078013 (“Josenhans”); Int’l Pat. Pub. No. WO2002/091160 (“Badarneh”). Samsung also lists four additional references (U.S. Pat. No. 7,152,213 (“Pu”); U.S. Pat. No. 5,797,098 (“Schroeder”); U.S. Pat. No. 5,223,924 (“Strubbe”); U.S. Pat. No. 3,309,677 (“Montgomery”)), in its petition but does not assert them in its arguments. *See* Samsung ’939 Petition, at 15-16.

meticulously narrowed its claims to definitively overcome all prior art and arguments asserted by Samsung in those proceedings. Moreover, the Office was fully aware of the decisions in the prior IPR proceedings and Samsung's arguments in its ex parte reexamination requests when determining the patentability of the Instituted Patents.

Second, there is co-pending District Court litigation between the same parties as these proceedings, Kannuu and Samsung America (as well as its parent company). *Kannuu Pty Ltd. v. Samsung Electronics Co., Ltd. et al.*, 1:19-cv-04297-ER (S.D.N.Y.). Notably, Kannuu filed its complaint in the District Court litigation in May 2019. Institution of this petition will further delay proceedings likely by two or more additional years, especially given the contentiousness of the prior USPTO and appeal proceedings on the Initial Patents.

This would mean that *the earliest the District Court litigation would proceed to trial would be more than 10 years* from the time Kannuu filed its patent infringement complaint against Samsung. Congress designed IPRs “to provide an effective and efficient alternative to district court litigation,” *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16-17 (PTAB Sept. 6, 2017) (emphasis added), not proceedings that add more than a decade of delay to district court litigation.

**II. ALL OF THE PRIOR ART ASSERTED BY SAMSUNG HAS
ALREADY BEEN CONSIDERED BY THE OFFICE AND THERE
IS NO INDICATION OF MATERIAL ERROR IN ITS DECISION**

Over the course of more than four years of IPR and ex parte reexamination proceedings and appeals, the Initial Patents were ultimately canceled. Importantly, based on Samsung's arguments and prior art asserted in these proceedings, Kannuu's highly experienced counsel meticulously redrafted the claims of the Initial Patents to ensure the validity of the Instituted Patents.

In this regard, Kannuu diligently provided all of the prior art and documents in the prior IPR proceedings, as well as Samsung's reexamination requests and the Office's orders granting reexamination, plus submitted additional art, during the examination of the '939 patent. '939 Patent Petition, Ex. 1002, at 150. The validity of the Instituted Patents' claims was confirmed after the scrupulous examination of the Instituted Patents. As such, there is no indication that the Office materially erred in its decision.

In this instance, the Director should discretionarily deny the petition. See 35 U.S.C. § 325(d) (stating that the Board may reject a petition if "the same or substantially the same prior art or arguments previously were presented to the Office"); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential) (establishing the two-part § 325(d) framework of previous Office consideration plus lack of material

error); *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (informative) (identifying the non-exclusive factors (for evaluating whether the same art and arguments were previously considered)).

A. Samsung Relies on No New Prior Art

In its petition, Samsung relies on four references, Badarneh, Dostie, Perlman, and Josenhans. Samsung '939 Petition at 15-16. As Samsung notes in its petition, the same four references were asserted in its IPR petitions and/or ex parte reexamination requests of the Initial Patents. *Id.* at 6-7. The arguments it asserts here are the same or substantially similar to the arguments it made in the IPR proceedings and its ex parte reexamination requests of the Initial Patents. *Id.* (“For the same reasons as in those cases, the claims of the '393 patent are invalid as shown below.”).

B. The Examination of the '939 Patent Carefully Considered the Same or Substantially Similar Art to that Now Asserted by Samsung

Not only were all four references presented to the Office during prosecution of the '939 patent, the Examiner specifically referenced three of them (Perlman, Dostie, Josenhans) at length in multiple office actions. Samsung '939 Petition, Ex. 1002, at 508-23. Notably, the Examiner found in his first office action that now claim 1 (then claim 55) “was allowable” over these three references. *Id.* at 521.

As to the fourth reference, Badarneh, although the Examiner did not address it in his Office Actions, the reference is substantially similar to Pu, which the

Examiner did specifically evaluate. Samsung '939 Petition, Ex. 1002, at 522 (summarizing the reference and noting that it was “relevant” but not using it to reject any submitted claims). Specifically, Samsung described Pu in its '852 patent IPR petition as a “an improved user input interface that uses ‘dynamic key assignment’ and ‘a predefined list that is presented to a user in an arrangement that statistically reduces the number of keystrokes required for data.’” '852 EPR, Ex. 1011, at 15-16.

Samsung described Badarneh in its *ex parte* reexamination request as “graphical user interface” that dynamically “suggest[s] inputs based on the user’s prior inputs” from a list of “likely words and/or letters according to priority of use” that in essence reduces the number of keystrokes required to input data. *Id.* at 49-50, 62-64. Pu contains a center key surrounded by multiple up, down, left, right key options driven by a shuttle system. *Id.* at 15-17. Badarneh contains a center key surrounded by four key options driven by a rotary switch, which is similar to a shuttle system. *Id.* at 49-50, 62-64. Other features of Bardarneh are substantially the same as Pu, as well. *Id.* at 121-37; '852 IPR, Ex. 2013, at 46-61. And like Badarneh, Pu does not disclose the key limitations of the Instituted Patents, which require a specific form of searching in separate databases. Ex. 1007 at 1-33.

The Examiner summarizes Pu similarly: “Pu . . . teaches for data input without the use of a standard keyboard wherein input is accepted through a data entry means such as a shuttle control system The data that is entered is selected from a

predefined list that is presented to a user in an arrangement that statistically reduces the number of keystrokes required for data entry.” Samsung ’939 Petition, Ex. 1002, at 522. Additionally, Kannuu not only cited Badarneh in its IDS and provided the entirety of Badarneh along with its IDS, but also specifically referenced all of Samsung’s reexamination requests, in which Samsung made lengthy arguments regarding Badarneh. Samsung ’939 Petition, Ex. 1002, at 230-89.

In these circumstances, Bardaneh was at least “presented” to the Examiner and, because it is substantially similar to Pu, should be deemed to have been evaluated by the Examiner for purposes of Section 325(d). See *Advanced Bionics*, at 7-8 (“Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.”); *Becton, Dickinson*, at 17-18 (specifying factors for when the same or substantially similar prior art has been examined). Moreover, as explained below, explicit consideration of Badarneh would not have changed the Examiner’s decision.

In terms of the specific *Becton-Dickinson* factors, the redundancy is quite clear:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- All four references asserted by Samsung were involved during examination.

(b) the cumulative nature of the asserted art and the prior art evaluated during examination;

- Yes, the art is necessarily cumulative since it is the same four references.

(c) the extent to which the asserted art was evaluated during the examination, including whether the prior art was the basis for rejection;

- Three of the four references were specifically evaluated during examination. Although the fourth reference, Badarneh, was not, it is cumulative of Pu, which was specifically evaluated during examination. Notably, the Examiner did not reject Claim 1 of the '939 patent over these references.

(d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;

- As Samsung concedes (see supra), it presented the “same reasons” in the prior IPR and ex parte reexamination proceedings, which were presented to the Examiner during prosecution of the '939 patent.

(e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and

- As noted below, Samsung failed to identify important differences between Claim 1 of the '939 patent and the Initial Patents, which distinguish Claim 1 over the prior art cited by Samsung.

(f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

- No additional evidence or facts have been presented by Samsung that warrant reconsideration of the Examiner's decision. Samsung also notes secondary factors, but the entirety of the IPR documents regarding the Initial Patents, which present the same or

substantially similar arguments to those Samsung presents here, was made available to the Examiner.

As such, every one of the *Becton-Dickinson* factors favors denial of Samsung's petition.

C. There was no Material Error by the Office

According to *Advanced Bionics*, “[i]f the ‘same or substantially the same prior art or arguments previously were presented to the Office,’ then the Board’s decisions generally have required a showing that the Office erred in evaluating the art or arguments.” *Advanced Bionics*, at 8 (citing *Becton-Dickinson*). *Advanced Bionics* continues, “If the petitioner fails to show that the Office erred, the Director may exercise his discretion not to institute inter partes review.” *Id.* (citing *Becton-Dickinson*).

Contrary to Samsung's assertion, the claims at issue in the Instituted Patents contain key, material changes that ensure their validity relative to the Initial Patents. Kannuu's counsel meticulously reviewed Samsung's arguments and asserted prior art in so doing precisely to avoid Samsung's ability to make those assertions against the Instituted Patents.

As the claim comparison below illustrates, there were notable changes in the claim language from the canceled claims, both upon the initial submission of Claim

1 (single underline) or the '939 patent and by amendment during prosecution (bold).²

Samsung '939 Petition, Ex. 1002, at 601-602.

'939 Patent, Claim 1	'579 Patent, Claim 12
<p>1. A system for selecting items, the system comprising:</p> <p>an output display <u>of a television</u>; a remote control keypad <u>with an up, down, left, right, select functionality</u>; and</p> <p>a computer processor <u>contained within the television</u> configured to:</p> <p>associate the items with corresponding item identifiers;</p> <p>generate a first display on the output display, the first display comprises</p> <p>a part of an item identifier corresponding to a first set of items and a part of an item identifier corresponding to a second set of items in a database;</p> <p>enable selection, by the remote control keypad, of one of the two parts of the item identifiers associated with a selected set of items;</p>	<p>12. An apparatus for selecting items, the apparatus comprising:</p> <p>an output display;</p> <p>an input; and</p> <p>a computer processor configured to execute a method comprising:</p> <p>associating the items with a corresponding item identifiers;</p> <p>generating a first display on the output display, the first display comprises:</p> <p>a part of an item identifier corresponding to a first set of items and a part of an item identifier corresponding to a second set of items in a database;</p> <p>enabling selection of one of the two parts of the item identifiers by a user using the input;</p>

² Here, Claim 12 of the '579 patent is used for illustration. The changes with respect to other claims of the Initial Patents are the same or substantially similar.

<p>generate, in response to the selection of the one of the two parts of item identifiers, a further display on the output display, the further display comprises</p> <p>an additional part of an item identifier corresponding to a subset of the selected set of items and another additional part of an item identifier corresponding to another subset of the selected set of items;</p> <p>enable selection, by the remote control keypad, of one of the two additional parts of the item identifiers;</p> <p>combine the selected one of the two parts of the item identifiers with the selected one of the two additional parts of the item identifiers to create a larger part of the item identifiers;</p> <p>and display the larger part of the item identifiers on the output display, wherein</p> <p>the additional parts of the item identifiers are shorter than a complete item identifier,</p> <p>the first set of items and the second set of items are mutually exclusive of one another,</p> <p>and <u>the up, down, left, right, select functionality of the remote control</u></p>	<p>generating, in response to the selection of the one of the two parts of item identifiers, a further display on the output display, the further display comprises:</p> <p>an additional part of an item identifier corresponding to a subset of the selected set of items and another additional part of an item identifier corresponding to another subset of the selected set of items;</p> <p>enabling selection of one of the two additional parts of the item identifiers by the user using the input;</p> <p>combining the selected one of the two parts of the item identifiers with the selected one of the two additional parts of the item identifiers to create a larger part of the item identifiers;</p> <p>and displaying the larger part of the item identifiers on the output display; wherein</p> <p>the additional parts of the item identifiers are shorter than complete item identifiers;</p> <p>and the first set of items and the second set of items are mutually exclusive of one another.</p>
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<u>keypad enables the selections of parts of item identifiers specifically positioned in a circular menu on the output display.</u>	
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Specifically, Kannuu narrowed the previous claim 12 of the '579 patent to 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 a letters or numbers in a movie title, “specifically positioned in a circular menu” on the display of the television. *See* '939 patent, Claim 1.

The Examiner implicitly recognized these additional limitations as extremely meaningful, because he allowed Claim 1 of the '939 Patent on November 20, 2020, and, again, on September 22, 2022, despite the FWDs issuing in the IPRs on two of the Initial Patents in September 2021 (submitted to the Examiner) and despite Samsung's complete reexamination requests and the Office's order granting reexamination (submitted to the Examiner). Samsung '939 Petition, Ex. 1002, at 150.

In particular, the Examiner properly reviewed and discussed at length three of the four references asserted now by Samsung (Perlman, Dostie, and Josenhans), as well as multiple other references (including Pu), finding that with these additional limitations, these references did not anticipate or render obvious Claim 1. *See id.* at 15-16, 129-43, 327-340, 508-22. Samsung notably omits in its discussion of rejected

independent claims 36 and 48 that they did not contain specific limitations in Claim 1 (then Claim 55). Specifically, Samsung states, “Claims 36 and 48 had similar scope to claim 55, except then-claim 55 required a ‘directional input device with an up, down, left, right *functionality*’ and further required two different parts of item identifiers that correspond to ‘mutually exclusive’ sets of items.” Samsung ‘939 Petition at 15. However, Samsung fails to note other important differences between claim 55 and claims 36 and 48. Notably, claim 55 requires “*the up, down, left, right, select functionality* of the remote control keypad enables the selections of parts of item identifiers *specifically positioned in a circular menu on the output display.*” ’939 Pat., Claim 1.

As the Examiner’s descriptions of the prior art implicitly recognize, there is no indication in Perlman, Dostie, Josenhans, or Pu (which is duplicative of Badarneh), all of which the Examiner carefully evaluated, of the “up down, left, right, select functionality” enabling “the selections of parts of item identifiers specifically positioned in a circular menu on the output display.” Importantly, Samsung’s ex parte reexamination requests—which discussed Badarneh at length—were presented to the Examiner. Even if the Examiner had included this reference in his evaluation of ’939 patent, he still would have granted Claim 1.

As such, there is no indication of material error by the Office. Given that Samsung has cited no new prior art references, they all have either directly or

indirectly been considered by the Examiner, and Samsung's arguments regarding Examiner error are without merit, the petition should be discretionarily denied.

III. THE PARALLEL DISTRICT COURT PROCEEDINGS HAVE BEEN PENDING SIX YEARS AND WARRANT DISCRETIONARY DENIAL HERE

35 U.S.C. § 314(a) provides the Director with discretion to deny institution of any IPR proceeding in view of parallel proceedings regarding the same issues and patents. 35 U.S.C. § 314(a); *Harmonic Inc. v. Avid Tech.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). The Director has applied that discretion where efficiency considerations stemming from parallel proceedings on the same patent warrant denial of institution. *See NHK Spring Co. v. Intri-Plex., Inc.*, IPR2018-00752, Paper 8 at 11 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019).

Here, the parallel proceedings in the District Court have been pending since May 2019, including originally filed breach of contract claims stemming from Samsung's misuse of Kannuu's confidential information. When Samsung filed IPRs on the Initial Patents, the District Court stayed the entire cases given the close relationship between the breach of contract and patent causes of action.

After taking nearly a year to review the merits of and grant Kannuu's motion to add the Instituted Patents to the parallel District Court litigation, Samsung now seeks to add at least two more years of delay to those proceedings. In short, if the

IPR petitions are instituted, given the additional stays, the District Court action would not proceed to trial for *at least 10 years since filing*. Such lengthy delays would thwart the policy goal of “protect[ing] the integrity of both the USPTO and Federal Courts by assuring that all issues are promptly raised and vetted.” *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48759 (Aug. 14, 2012).

This is especially troubling given that Samsung is likely to fail on the merits of its petition. See Director Institution Memo at 1. Such inefficiencies and delays in the district court proceedings were not Congress’s intent in providing for IPRs in the America Invents Act. As the Director Institution Memo (at 1) underscores, institution decisions should “improve efficiency, consistency, and adherence to statutory requirements.” In other words, reaffirm that IPRs should be instituted only when they meaningfully advance the efficient and balanced administration of the Office. This approach aligns with 35 U.S.C. § 316(b), which directs consideration of “the efficient administration of the Office.”

IV. CONCLUSION

Samsung has asserted the same prior art that was made available to the Office during examination, and the Examiner did not commit error in granting the ’939 patent. Additionally, if this petition is granted, the earliest that the co-pending

District Court would go to trial would be *more than 10 years after the complaint was filed*. Accordingly, the petition should be discretionarily denied.

December 24, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Under 37 C.F.R. § 42.24, I certify that Sections I-IV of this Patent Owner's Request for Discretionary Denial have a total of X,XXX words according to the word count tool in Microsoft Word™ and a hand count of the words in the pictures.

By: /s/ Lewis E. Hudnell, III
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CERTIFICATE OF SERVICE

I certify that the foregoing **PATENT OWNER'S RESPONSE UNDER 37 C.F.R. § 42.120** was served on December 24, 2025, on the Petitioner by filing this document through the Patent Trial and Appeal Board P-TACTS System as well as e-mailing a copy to qe-samsung-kannuu@quinnemanuel.com.

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