

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NETWORK-1 TECHNOLOGIES, INC.,
Patent Owner.

Case No. IPR2026-00117
U.S. Patent No. 12,166,869

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

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LIST OF EXHIBITS

| Ex. No. | Description |
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| Ex-1001 | U.S. Patent No. 12,166,869 (“the ’869 Patent”) |
| Ex-1002 | Declaration of Dr. Sundeep Rangan |
| Ex-1003 | Curriculum Vitae of Dr. Sundeep Rangan |
| Ex-1004 | Prosecution History of U.S. Patent No. 12,166,869 |
| Ex-1005 | U.S. Patent No. 9,210,138 to Nakhjiri (“Nakhjiri”) |
| Ex-1006 | U.S. Patent Publication No. 2014/0024343 to Bradley (“Bradley”) |
| Ex-1007 | Certified Translation: Eun-Hee Jeong & Byung-kwan Lee, A Design of Safe AKA Module for Adapted Mobile Payment System on Openness Smartphone Environment, 13 Journal of Korea Multimedia Society 1687-97 (Nov. 2010) (“Jeong”) |
| Ex-1008 | U.S. Patent Publication No. 2013/0012168 to Rajadurai (“Rajadurai”) |
| Ex-1009 | U.S. Patent Publication No. 2009/0323967 to Pierce (“Pierce”) |
| Ex-1010 | GlobalPlatform Remote Application Management over HTTP Card Specification V2.2 – Amendment B ver 1.1.1 (Mar. 2012) (“GlobalPlatform”) |
| Ex-1011 | Certicom Research, Standards for Efficient Cryptography, SEC 1: Elliptic Curve Cryptography, v2 (May 21, 2009) (“SEC1”) |
| Ex-1012 | Eun-Hee Jeong & Byung-kwan Lee, A Design of Safe AKA Module for Adapted Mobile Payment System on Openness Smartphone Environment, 13 Journal of Korea Multimedia Society 1687-97 (Nov. 2010) (“Jeong”) (original Korean) |
| Ex-1013 | U.S. Patent Publication No. 2012/0300934 to Ala-Laurila (“Ala-Laurila”) |

| Ex. No. | Description |
|---------|--|
| Ex-1014 | ANSI X9.63 Overview, Key Agreement and Key Transport Using Elliptic Curve Cryptography, Simon Blake-Wilson, Certicom (2000) (“X9.63-Overview”) |
| Ex-1015 | Declaration of Simon Blake-Wilson, author of ANSI X9.63-Overview |
| Ex-1016 | National Library of Korea Catalog Printout |
| Ex-1017 | Korea Multimedia Society Webpage Printout |
| Ex-1018 | Declaration of Tono Aspinall of GlobalPlatform, Inc. |
| Ex-1019 | INTENTIONALLY LEFT BLANK |
| Ex-1020 | Claim Mapping Table |
| Ex-1021 | Prosecution History of U.S. Patent No. 10,700,856 |
| Ex-1022 | Prosecution History of U.S. Patent No. 10,187,206 |
| Ex-1023 | Prosecution History of U.S. Patent No. 9,742,562 |
| Ex-1024 | U.S. Patent Publication No. 2013/0301828 to Gouget (“Gouget”) |
| Ex-1025 | U.S. Patent Publication No. 2010/0174907 to Semple (“Semple”) |
| Ex-1026 | PCT Patent Publication No. WO2008/005162 to Wang (“Wang”) |
| Ex-1027 | U.S. Patent Publication No. 2010/0135491 to Bhuyan (“Bhuyan”) |
| Ex-1028 | CSMG, Reprogrammable SIMs: Technology, Evolution and Implications, Final Report (Sept. 25, 2012) (“CSMG”) |
| Ex-1029 | U.S. Patent Publication No. 2007/0083766 to Farnham (“Farnham”) |
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| Ex. No. | Description |
|---------|--|
| Ex-1032 | U.S. Patent Publication No. 2009/0068985 to Nguyen (“Nguyen”) |
| Ex-1033 | U.S. Patent Publication No. 2012/0008775 to Natarajan (“Natarajan”) |
| Ex-1034 | U.S. Patent No. 8,127,142 to Cuppett (“Cuppett”) |
| Ex-1035 | Jaemin Park et al., Secure Profile Provisioning Architecture for Embedded UICC, Int’l Conference on Availability, Reliability & Security 297 (2013) (“Park”) |
| Ex-1036 | Boyd, C. and Mathuria, A., Protocols for Authentication and Key Establishment, Springer-Verlag (2003) (“Boyd-Mathuria”) |
| Ex-1037 | Chart comparison of ’869 Patent claims and ’223 Patent claims |
| Ex-1038 | Chart comparison of ’869 Patent claims and ’206 Patent claims |
| Ex-1039 | U.S. District Court for the Eastern District of Texas, Judicial Caseload Profile (“Time-to-Trial Statistics”) |
| Ex-1040 | <i>Network-1 Techs., Inc. v. Samsung Elecs. Co.</i> , No. 2:25-cv-00667, Dkt. No. 1 (E.D. Tex. June 27, 2025) |

I. INTRODUCTION

Discretionary denial is not appropriate for at least three reasons. *First*, the parties' settled expectations weigh against discretionary denial. Patent Owner had no settled expectation of validity of the *specific '869 Patent* challenged in this IPR or any of the specific patents challenged in related IPRs. The most Patent Owner can allege is that Petitioner was aware of a *parent* patent to the '869 Patent by 2016. But it is the claims that define the scope of the alleged invention and Patent Owner does not allege infringement of the patent that forms the basis for its settled expectation argument. Instead, Patent Owner had to go back to the Patent Office to obtain a new set of child patents with materially different claims—including the '869 Patent, which issued in December 2024—to have something to assert against Petitioner nine years later. The only settled expectation here is one of non-enforcement.

Second, the *Fintiv* factors weigh in favor of institution and against discretionary denial in this proceeding. Here, the Final Written Decision deadline *leads* the trial date by six days and the time-to-trial statistics for the Eastern District of Texas demonstrate that the trial date is likely to be even later than scheduled, and possibly two months *after* a Final Written Decision is expected. The litigation is also in its earliest stages. An institution decision is expected well before the *Markman* hearing, fact depositions, and expert reports. Further, Petitioner's commitment to a broader-than-*Sotera* stipulation negates *any* concern that any issue before the Board

in this proceeding will be relitigated in the parallel proceeding.

Third, the Petition raises specific material errors made by the Patent Office during prosecution that should be addressed. Specifically, the Office committed material errors by issuing the challenged '869 Patent without a single prior art rejection, providing no substantive reasons for allowance, and by overlooking relevant prior art like Petitioner's primary reference, Nakhjiri (Ex-1005), which was cited in its publication form on a Notice of References Cited by the Examiner and used repeatedly in anticipation and obviousness rejections during prosecution of at least three parent applications to the '869 Patent but not for the '869 Patent. A proper search and examination would have revealed that the prior art, including references presented in the Petition, teaches every limitation of the challenged claims.

II. ARGUMENT

A. Settled Expectations Of The Parties Favor Petitioner Not Patent Owner

The Board should deny Patent Owner's request for discretionary denial in view of the expectations "of the parties." *See* USPTO "Interim Processes for PTAB Workload Management" (Mar. 26, 2025) at 2. When properly focusing on "[s]ettled expectations of the *parties*," as Office Guidance requires, it is clear that Petitioner—not the Patent Owner—had the settled expectations.

Patent Owner's central argument for denial rests on its specious claim of "settled expectations" of validity of the '869 Patent based on Petitioner's alleged

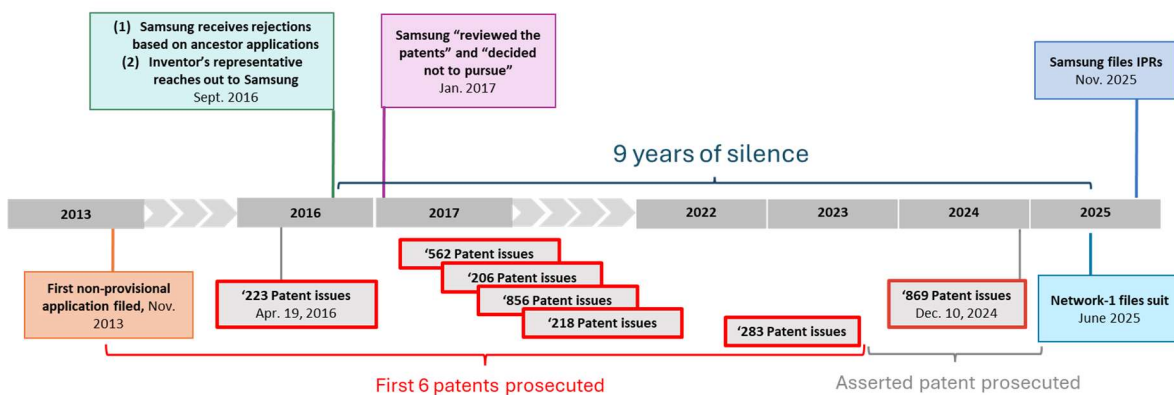
pre-suit knowledge by 2016 of the *great-great-grandparent* patent and the *great-great-great-great-grandparent* patent to the '869 Patent, the '206 Patent and the '223 Patent, respectively. Paper 8 at 4-6. Specifically, Patent Owner argues that the PTO “identified parent patents and patent publications of the '869 Patent” and Petitioner submitted IDSs identifying the '206 and '223 Patents during prosecution of Petitioner’s patent applications. Paper 8 at 5-6. But Petitioner’s alleged knowledge of the ancestor patents, which each include 19 pages of drawings and 148-150 columns of text, is irrelevant here; they were never asserted against Petitioner and their claims are materially different from those that are asserted. Significantly, Patent Owner does not allege that Samsung was ever actually aware of the challenged '869 Patent, which published November 23, 2023 and issued on December 10, 2024.

Patent Owner also argues that Petitioner learned about the “*inventions* as part of monetization discussions between Samsung and the inventor” in 2016-2017. Paper 8 at 4-5. But Patent Owner provides no actual communications to or from Samsung. Instead, it relies on (1) correspondence between the inventor and his representative, Andrew Bezaitis, where Mr. Bezaitis states “Nothing yet back from ... Samsung” and that he “just sent a note to Dr. Kim at Samsung – an old contact of mine that runs the Networking division” (Ex-2020); and (2) correspondence between Mr. Bezaitis and an individual named Kang Lee, who allegedly “has many

high level connections at Samsung.” Ex-2023. The correspondence from Mr. Lee’s g-mail address states that he “received an update from Samsung over the holiday and told me that their lawyers have reviewed the patents and decided not to pursue.” Ex-2023. This is all objectionable hearsay. But again, even if Patent Owner’s allegations are true, the “inventions” that Petitioner allegedly “learned about” were those claimed in the ancestor patents, not the ’869 Patent, which issued much later in 2024. Significantly, there is no record evidence of attempts to license, commercialize, or otherwise monetize any of the patents at issue.

Indeed, as shown below, Patent Owner asserts only a newly issued seventh-generation patent (i.e., the ’869 Patent) from this family, which has been in force for less than two years.

The 869 prosecution timeline



It is improper to attribute the age or alleged “settled expectations” of the non-asserted, ancestor patents to Petitioner, especially given their materially different claims. The ’869 Patent is a continuation of the ’206 and ’223 Patents, but as shown

in Exs-1037-1038, its claims include important differences. For example, Claim 1 of the '223 Patent recites deriving first and second shared keys using a key derivation function from an authenticated eUICC subscription manager and additional parameters including a token, shared secret algorithm, and secure hash algorithm. *See* Ex-1037 ('223 Patent, Cl. 1). Claim 1 of the '206 Patent recites recording and receiving by a subscription manager system, a digital signature algorithm, a certificate associated with a module, and a challenge from the module of a module provider system, and sending a digital signature and the challenge to the module. *See* Ex-1038 ('206 Patent, Cl. 1). These limitations are not recited in any '869 Patent claims. *See id.* When claims of ancestor patents are so different, the Board has referred these for consideration on the merits. *See, e.g., EvenFlo Co. v. Baby Jogger, LLC*, IPR2025-01140, Paper 9 at 6-7 (PTAB Oct. 8, 2025) (making similar arguments), Paper 12 (PTAB Nov. 20, 2025) (referred for institution).¹ *See also Dialect, LLC v. Bank of Am., N.A.*, No. 2:24-CV-00207-JRG, 2024 WL 4980794, at *3 (E.D. Tex. Dec. 4, 2024) (knowledge of a parent patent insufficient to show knowledge of asserted patent for purposes of willful infringement or inducement).

The “settled expectations” inquiry is an equitable consideration tied to the

¹ This is particularly true for the '780, '094, and '893 Patents, which are challenged in IPR2026-00114, -00118, and -00119, because Petitioner disputes whether the newly issued claims are even supported by the parent specification that Patent Owner allegedly made Petitioner aware of in 2016-2017. *See id.* at 7. This argument will be addressed in the discretionary denial papers for those IPRs.

existence of an enforceable patent right. The focus is how long an asserted patent “has been in force.” *Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (PTAB June 18, 2025) (informative). The Director has found that patents issued less than six years ago “have not been in force for a significant period of time . . . , and, accordingly, Patent Owner has not developed strong settled expectations,” which weighs against discretionary denial. *See, e.g., Samsung Elecs. Co. v. Wilus Inst. of Standards & Tech. Inc.*, IPR2025-00935, Paper 12 at 2 (PTAB Sep. 26, 2025); *Samsung Elecs. Co. v. Wilus Inst. of Standards & Tech. Inc.*, IPR2025-00933, Paper 11 at 3 (PTAB Oct. 10, 2025) (finding “Patent Owner has not developed strong settled expectations” when “challenged patents issued between 2020 and 2023”); *Cambridge Indus. USA, Inc. v. Applied Optoelecs., Inc.*, IPR2025-00434, Paper 11 at 2-3 (PTAB June 26, 2025) (patent that issued in 2019 had “not developed strong settled expectations”); *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 2-3 (PTAB July 2, 2025) (same for patents “issued in 2019 and 2020”); *Apple Inc. v. Apex Beam Techs., LLC*, IPR2025-00896, Paper 10 at 3 (PTAB Sept. 3, 2025) (same for patents “issued in 2021-2023”).

Patent Owner’s argument that “Samsung never moved to challenge any patents in the [Challenged Patent] famil[ies] prior to November 2025” (Paper 8 at 6) is a red herring. It is Patent Owner that delayed nine years after allegedly contacting Petitioner before asserting only newly-issued child patents against Petitioner. It

would have been reasonable for one in Petitioner’s position to assume this was because Patent Owner understood that the ancestor patents that Petitioner allegedly “decided not to pursue” were not applicable to Petitioner’s products or technologies. Indeed, it took nine years for the Patent Owner to obtain the challenged patents between 2022-2025 with markedly different claims before it could assert them against Petitioner.

Recent precedent makes clear that Patent Owner’s non-enforcement negates any settled expectations. For example, the Director referred a petition for consideration in circumstances similar to those here:

Petitioner acknowledges that it was aware of the challenged patent in IPR2025-00856 in 2012, when Patent Owner first contacted Petitioner about the challenged patent in a letter. Petitioner, however, contends that it “*did not expect enforcement*” of the patent challenged in IPR2025-00856 because it concluded that it did not require a license to the patent and advised Patent Owner of its position, and because Patent Owner did not assert the challenged patent against Petitioner until eleven years after the parties’ discussion about that patent.

Apple Inc. v. Allani, IPR2025-00856, Paper 11 at 3 (PTAB Sept. 5, 2025) (informative). Another IPR petition was referred for consideration on the merits in *Apple Inc. v. Vampire Labs, Inc.*, IPR2025-01215, Paper 9 (PTAB Nov. 20, 2025), after a similar argument in Petitioner’s discretionary denial opposition. *See* Paper 8 at 2 (PTAB Oct. 17, 2025) (“Because Patent Owner ... delayed fifteen years from first contacting Petitioner regarding the claimed technology before filing suit, Patent Owner’s assertion of settled expectations rings hollow.”).

If anything, in the present case, Petitioner had settled expectations that it would not be sued on these patent families. By remaining silent for nearly a decade after allegedly contacting Petitioner, Patent Owner fostered not an expectation of enforcement, but of acquiescence and non-enforcement. *See Allani*, IPR2025-00856, Paper 11 at 3 (informative).

B. The *Fintiv* Factors Favor Institution

1. Factor 1: Likelihood of a stay weighs against discretionary denial

Patent Owner’s argument that Petitioner’s “motion to stay the parallel District Court Proceeding ... will almost certainly be denied” (Paper 8, 10-11) is premised on its argument that Judge Gilstrap often denies stay motions (without prejudice) before IPRs are instituted. But the general practice before Judge Gilstrap is for the moving party to renew the stay motion after institution, and for an early-filed motion and institution before *Markman*, which would be the case here, Judge Gilstrap’s record on granting stays is far more favorable. *See, e.g., Commc’n Techs., Inc. v. Samsung Elecs. Am., Inc.*, No. 2:21-CV-00444-JRG, Dkt. No. 134 at 6 (E.D. Tex. Feb. 2, 2023) (“[W]ith the close of discovery, the claim construction hearing, and the trial setting all in the future, the Court concludes that this factor weighs in favor of a stay.”); *Maxeon Solar Pte. Ltd. v. Canadian Solar Inc.*, No. 2:24-CV-210-JRG, 2025 WL 1811321, at *2 (E.D. Tex. July 1, 2025) (“Given that *inter partes* review ha[s] been instituted on all Asserted Claims of all Asserted Patents on multiple

grounds, there is a material likelihood of simplification of the issues in this case. ... Also, the Court has not yet begun the claim construction process, and such hearing is not scheduled until later this summer.” (citation omitted)). Additionally, Judge Gilstrap has granted stays when, as here, the Final Written Decision is expected *before* the trial date. *Maxeon*, 2025 WL 1811321, at *2 (“Given that the PTAB is expected to issue its final written decisions [January 14] before this case goes to trial [January 26, 2026], it is possible if not likely that its decision will simplify the issues in this case ,... this factor weighs in favor of granting a stay.”). Considering this is a six patent case, referral and possible institution may simplify the case substantially. Thus, Factor 1 weighs against discretionary denial.

2. Factor 2: Trial date weighs against discretionary denial

The Final Written Decision for the '869 Patent is expected by June 1, 2027, which is at least six days before the current trial date, June 7, 2027. Additionally, the official time-to-trial statistics for Judge Gilstrap in the Eastern District of Texas demonstrate that the most recent median time-to-trial is 24.5 months, which would place the trial sometime in mid-July 2027—1.5 months after a Final Written Decision is expected. *See* Ex-1039 (Time-to-Trial Statistics); Ex-1040 (Complaint, filed June 27, 2025). As such, it is likely that a Final Written Decision will issue before the trial occurs, “reducing the concern of inconsistent outcomes or significant duplication of efforts.” *Apex Beam*, IPR2025-00896, Paper 10 at 2 (finding

discretionary denial “not appropriate” where “the projected final written decision due date ... is November 18, 2026,” “scheduled trial date is December 7, 2026,” and “time-to-trial statistics suggest trial could begin in January 2027”). Thus, Factor 2 weighs against discretionary denial.

3. Factor 3: Investment in parallel proceeding weighs against discretionary denial

There has been little investment in the parallel district court litigation. The Court has issued no substantive orders related to the patent. Institution will occur almost seven months before the *Markman* hearing (scheduled for December 14, 2026), and well before the close of fact and expert discovery. Such timing weighs against discretionary denial. *See, e.g., Tesla v. Autonomous Devices*, IPR2023-01172, Paper 21 at 8-9 (PTAB Jan. 8, 2024) (“the District Court has yet to issue a claim construction order addressing any terms of the [] patent,” “fact discovery is ongoing,” and “expert discovery has not begun”); *see also Western Digital Techs., Inc. v. Godo Kaisha IP Bridge 1*, IPR2025-00701, Paper 9 at 2 (PTAB Aug. 14, 2025) (“There has not been significant investment by the parties in the parallel proceeding.”); *Nintendo Co. v. Resonant Sys., Inc.*, IPR2025-00680, Paper 18 at 2 (PTAB Aug. 14, 2025) (same). Thus, Factor 3 weighs against discretionary denial.

4. Factor 4: Lack of overlap, given Petitioner’s broader-than-Sotera stipulation, weighs against discretionary denial

Petitioner’s broader-than-*Sotera* stipulation mitigates concerns about

duplicative efforts, committing not to pursue in the parallel district court litigation “any ground of invalidity raised or that reasonably could have been raised in this proceeding.” Paper 7. It further goes beyond *Sotera* to forgo “any ground arising from 35 U.S.C. §§ 102 or 103 that includes any reference that forms the basis of any ground raised in” the IPR. *Id.* Thus, if instituted, none of the prior art asserted in the Petition will be used in the litigation—even in combination with unpublished system art. As such, there will be no overlap between this proceeding and the parallel litigation, thereby negating any duplication of effort and inefficiency concerns. Thus, Factor 4 weighs against discretionary denial. *See, e.g., Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2 (PTAB June 13, 2025) (informative) (finding that Tesla’s broad *Sotera*+ stipulation “counsel[s] against discretionary denial”); *see also Shenzen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 at 3 (PTAB July 17, 2025) (“Petitioner has also filed a broad stipulation. ... Petitioner’s arguments that these factors tip the balance against discretionary denial are persuasive.”); *Wilus*, IPR2025-00933, Paper 11 at 3 (“Petitioner has filed a broad stipulation that reduces the concern of inconsistent outcomes or significant duplication of efforts.”).

Patent Owner incorrectly suggests that Petitioner’s stipulation was not timely filed (Paper 8, 14-15), when, in fact, it was filed less than a month after a filing date was accorded, providing Patent Owner ample time to address it in its discretionary

denial briefing. Petitioner’s timing follows PTAB guidance and falls in line with recently instituted petitions.²

5. Factor 6: Strong merits of the Petition weighs against discretionary denial

Patent Owner incorrectly argues for 5 pages that “the merits of the Petition are weak.” This lengthy preview of its POPR arguments contravenes Office guidance, which cautions a patent owner not to use its discretionary denial brief “as an additional opportunity for merits briefing.” Interim Director Discretionary Process § II.C.i (<https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>, last visited Feb. 25, 2026). Regardless, even if presented properly, consideration of the merits does not generally weigh into the *Fintiv* assessment except when the other *Fintiv* factors favor denial. See *ResMed Corp. v. Cleveland Medical Devices*, IPR2025-00158, Paper 11 at 13 (PTAB June 13, 2025) (explaining that the merits weigh “neutrally” when “none of the other *Fintiv* factors favor discretionary denial.” (citing *Fintiv*, Paper 11 at 14-15)). Because Patent Owner’s *Fintiv* and settled expectations are especially inapt under the circumstances, the Petition should be referred for proper consideration of the merits.

In any case, Patent Owner’s arguments, which attack the references in

² For example, in IPR2025-01215, a filing date was accorded on June 17, 2025, and petitioner filed its stipulation on August 14, 2025. See *Vampire*, IPR2025-01215, Papers 3, 6. The IPR was instituted on December 1, 2025. *Id.*, Paper 10.

isolation rather than in the presented combinations, are meritless. As an example, its assertion that Jeong’s MS-HN link need not use the security features described for its MS-SN link because the MS-HN link is “trusted” (Paper 8, 15-17) ignores the fact that even a “trusted” link can be compromised. The Petition explains why a POSITA would have applied Jeong’s MS-SN key generation process to MS-HN because it provides the improvement of perfect forward secrecy. *See, e.g.*, Paper 3, 18-22, 38-44. And Patent Owner’s other criticisms include the non-credible assertion that a POSITA would not have applied the industry standard “elliptic curve Diffie-Hellman” algorithm described in Nakhjiri and X9.63/SEC 1 since Ala-Laurila only discloses the original 1976 “Diffie Hellman” algorithm and not its elliptic curve variant. Paper 8, 17-18; Paper 3, 61-66 (explaining why this would have been obvious). Thus, because these and other arguments are fundamentally flawed, Factor 6 weighs strongly against discretionary denial.

C. Institution Of Petitioner’s IPR Petition Is Appropriate Because The Patent Office Erred During Prosecution

PTAB review of the ’869 Patent is further warranted, and discretionary denial is inappropriate, because the Office committed specific material errors during the patent’s prosecution. *See, e.g., Microsoft Corp. v. Partec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9 at 3 (PTAB June 12, 2025) (“it is an appropriate use of Office resources to review the potential error”). In particular, the Examiner erred by failing to perform a proper search and examination.

The '869 Patent issued *without a single prior art rejection*. Ex-1004. The insufficiency of examination is further demonstrated by the conclusory manner in which the pending claims were designated as allowable subject matter by the Examiner, with no discussion of the prior art, no comparison of the pending claims to the prior art, no substantive analysis of any claim limitations, or elaboration whatsoever as to why the pending claims were determined to be novel (and over which, if any, prior art). The Notice of Allowance simply referred back to the patentee's filing of terminal disclaimers to overcome the Examiner's double patenting rejections as the reasons for allowance. Ex-1004, 467 ("This communication warrants No Examiner's Reason for Allowance, applicant's reply makes evident the reasons for allowance Specifically, applicant's arguments filed on 7/8/2024 are persuasive, as such the reasons for allowance are in all probability evident from the record and no statement is deemed necessary."); *see also id.*, 426-35 (patentee's July 8, 2024 response, filing terminal disclaimers).

The Board also failed to conduct a proper examination by overlooking relevant prior art like Petitioner's primary reference, Nakhjiri (Ex-1005), which was cited in its publication form on a Notice of References Cited by the Examiner during prosecution of the '869 Patent (Ex-1004, 235, 335, 436), "considered pertinent to applicant's disclosure" (Ex-1004, 397, 467), and used repeatedly in anticipation and obviousness rejections during prosecution of at least three parent applications to the

'869 Patent but not for the '869 Patent. *See, e.g., id.*, 397 (“The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure. Nakhjiri (20140082359).”), 467 (same).

As demonstrated in the Petition, all limitations of independent Claim 1 are taught by the Nakhjiri-Bradley-Jeong combination and the Nakhjiri-Bradley-Ala-Laurila combination. Paper 3, 18-46, 61-68.

Because the Examiner failed to properly search for and examine the prior art, including the Nakhjiri reference that was before the Examiner during prosecution and the Bradley, Jeong, and Ala-Laurila references that could have been located by a thorough search, the Office erred in allowing the '869 Patent. Instituting the Petition would allow the Board to correct this defective examination process.

D. Patent Owner’s Remaining Arguments Do Not Justify Discretionary Denial

Patent Owner argues that Petitioner’s “extensive reliance on an expert declaration supports discretionary denial” because it “add[s] little (if any) value to the analysis.” Paper 8, 20. But the Petition properly relies on expert testimony to explain the knowledge of a POSITA, and to provide background regarding the technology, citing prior art in support, as required by 37 C.F.R. § 42.65(a). Indeed, the expert declaration provides over twenty-two pages of background on the technology, which is cited throughout the Petition to support specific arguments applying prior art to the claims. *See* Ex-1002 ¶¶29-52.

Detailed and evidence-supported declarations are encouraged by the Board. *See, e.g., Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00032, Paper 11 at 39 (PTAB May 19, 2025) (characterizing 278 page expert declaration’s support of “his extensive explanations ... with citations to dozens of pieces of objective evidence” as “a feature, not a bug of his testimony[]” and “applaud[ing]” the expert and Petitioner for “leav[ing] virtually none of the substance of his testimony unsupported by objective evidence”). Extensive, well-supported expert declarations, like Dr. Christina Pöpper’s declaration here, weigh against discretionary denial. *See, e.g., iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 2 (PTAB June 6, 2025) (Petitioner’s “rel[iance] on its expert to explain the background knowledge of a [POSITA]” and the expert’s “citations to evidence in support of his statements in the required manner” “weigh[] against discretionary denial”).

III. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Director decline to exercise discretion to deny institution and refer the Petition to a panel to decide whether to institute based on the merits.

Respectfully Submitted,

/s/ William M. Fink

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CERTIFICATE OF SERVICE (37 C.F.R. §42.6(e)(1))

The undersigned hereby certifies that the above document was served on March 2, 2026, by filing this document through the Patent Trial and Appeal Board P-TACTS System, as well as delivering a copy via express mail upon the following attorneys of record for the Patent Owner:

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