

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, SAMSUNG ELECTRONICS CO. LTD., AND SAMSUNG
ELECTRONICS AMERICA, INC.,

Petitioners,

v.

MULTIMODAL MEDIA LLC,

Patent Owner.

Patent No. 7,929,949
Filing Date: February 3, 2009
Issue Date: April 19, 2011

Inventor: Ewald Anderl
Title: INTERACTIVE MULTIMODAL MESSAGING

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2024-00056

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EXHIBIT LIST

Exhibit No.	Description of Document
Ex. 2001	Second Amended Docket Control Order, Dkt. 72, <i>Multimodal Media LLC v. Samsung Elecs. Co.</i> , No. 2:22-cv-00462-JRG-RSP (E.D. Tex. Jan. 12, 2024)
Ex. 2002	Defendants' Motion to Stay Pending Resolution of Motion to Transfer Venue, Dkt. 78, <i>Multimodal Media LLC v. Samsung Elecs. Co.</i> , No. 2:22-cv-00462-JRG-RSP (E.D. Tex. Feb. 7, 2024)
Ex. 2003	Defendants' Motion to Transfer Venue to The Northern District of California Under 28 U.S.C. § 1414(a), Dkt. 49, <i>Multimodal Media LLC v. Samsung Elecs. Co.</i> , No. 2:22-cv-00462-JRG-RSP (E.D. Tex. Oct. 20, 2023)

I. INTRODUCTION

On December 5, 2023, Google LLC, Samsung Electronics Co. Ltd., and Samsung Electronics America, Inc., filed a Petition for *Inter Partes* Review (Paper 1, “Petition” or “Pet.”) of claims 1-2, 4-5, and 9 of U.S. Patent No. 7,929,949 (Ex. 1001, the “’949 Patent”). On December 14, 2023, the Board issued a Notice of Filing Date for the Petition and set the time for filing Patent Owner’s Preliminary Response (Paper 5).

The Board should deny institution because none of the cited prior art discloses an “interactive multimodal message” as required by the claims. Although Petitioners purport to apply the “plain meaning” of interactive, the cited prior art for this claim element merely discloses known and routine messages such as SMS messages and voice messages. The Petition claims that these non-interactive prior art messages become “interactive” merely because users can reply to them or forward them. That is not the plain meaning of “interactive.” Petitioners’ attempt to broaden this claim term beyond its ordinary meaning is improper for several reasons. First, the Petition fails to seek a specific construction of “interactive.” Second, the Petition appears to base its flawed interpretation of “interactive” on a phrase in the specification describing recipient activity that is not lexicography and describes recipients replying to and forwarding messages that are already “interactive” multimodal messages. The Petition and the prior art cited therein does not meet its burden to

show that any “interactive” multimodal messages were present in the prior art, and therefore institution should be denied.

The Board should also exercise its discretion to deny institution under *Fintiv* and should reject any late *Sotera* stipulation.

II. THE '949 PATENT

The '949 Patent, titled Interactive Multimodal Messaging, describes and claims a method and system that enables a recipient to interact with an “interactive multimodal message triggered on a recipient’s mobile device.” Ex. 1001, Abstract. The '949 Patent states that, at the time of the invention “the content of text messages is limited to plain text without visual enhancements or interactivity” and that while existing multimedia messages “allow subscribers to send images, videos, and other kinds of multimedia content[,] . . . there is limited interactivity in the multimedia messages.” *Id.*, 1:33-40.

The '949 patent states:

Mobile communication service providers also provide services that allow a subscriber to send a text message with a request to purchase chosen ringtones, wallpapers, etc, or to activate a chosen new service, for example to activate or deactivate roaming, to the service provider. However, the choice is typically made by the subscriber offline, while the text message is used only for conveying the choice to the service provider. *The text message itself is non interactive.*

Ex. 1001 1:52-59 (emphasis added)

III. LEVEL OF ORDINARY SKILL IN THE ART

For the purposes of this Preliminary Response only, Patent Owner agrees with the level of ordinary skill in the art proposed by Petitioners, “a bachelor’s degree in electrical engineering, computer science, computer engineering, or a related field, and two-three years of experience with multimedia and Internet-related communications technologies.” Pet. at 7. Patent Owner does not believe that minor deviations from this level of skill in the art would materially change the analysis.

IV. CLAIM CONSTRUCTION

A. “multimodal message” and “interactive multimodal message”

The term “multimodal message” was previously construed to mean “seamless combination of graphics, text, and audio output or a combination of the above modalities with speech, text, and touch input or vice versa” and the term “interactive multimodal message” was construed to have its plain meaning, subject to the above construction of multimodal message. Pet. at 8-9. Petitioners state that they applied these constructions for the purposes of their Petition, and Patent Owner does the same for the purposes of its Preliminary Response. Under these constructions, the cited prior art does not render the challenged claims obvious.

B. “service information”

Construing “service information” at this stage is not necessary to resolve the current dispute, and therefore is unnecessary at this time. *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)))

C. “client application”

Construing “client application” at this stage is not necessary to resolve the current dispute, and therefore is unnecessary at this time. *See Realtime Data*, 912 F.3d at 1375.

D. “pointer”

Construing “pointer” at this stage is not necessary to resolve the current dispute, and therefore is unnecessary at this time. *See Realtime Data*, 912 F.3d at 1375.

E. Preamble

Although not explicitly stated, the Petition appears to treat claim 1’s preamble as limiting. Patent Owner agrees that the preamble is limiting as to “an interactive multimodal message” and “a recipient” because those phrases are used as antecedent basis for these terms later in the claim. Patent Owner disputes whether the remainder

of the preamble is limiting, as it merely states an intended purpose or use for the invention. *Arctic Cat Inc. v. GEP Power Prods., Inc.*, 919 F.3d 1320, 1328 (Fed. Cir. 2009); *TomTom, Inc. v. Adolph*, 790 F.3d 1315, 1323-24 (Fed. Cir. 2015) (holding that because one phrase provides necessary structure “does not necessarily convert the entire preamble into a limitation, particularly one that only states the intended use of the invention.”).

**V. THE PETITION HAS NOT DEMONSTRATED A
LIKELIHOOD OF SUCCESS**

All four proposed grounds of invalidity fail because the prior art does not suggest or disclose an “interactive” multimodal message as required by all challenged claims. Petitioners misread a statement in the specification and attempt to broaden the term “interactive” beyond its plain meaning without engaging in the proper claim construction analysis.

**A. Grounds 1-2 Fail Because the Petition Fails to
Demonstrate That Still Discloses an Interactive
Multimodal Message**

Grounds 1 and 2 rely on a combination of U.S. Patent Application Publication No. US 2008/0182603 to Still et al. (Ex. 1008, “Still”) and U.S. Patent Application Publication No. US 2007/0088852 to Levkovitz (Ex. 1009, “Levkovitz”). Although the Petition only relies on disclosures from Still to support disclosure of the claimed “interactive multimodal message,” the Petition fails to demonstrate that Still or

Levkovitz disclose multimodal messages that are *interactive* as required by the claims.

Still teaches sending a message and that “[a] multimedia content . . . may be associated with the message.” Ex. 1008 ¶ 45. This multimedia content may include “music, electronic books, and other forms of audio entertainment content, as well as video content, voice messages, animation content, or other forms of content for communication, advertising, entertainment, etc.” *Id.* The Petition states, with bare citation to the identical expert declaration, that “[a] POSITA would have understood that Still’s messages with multimedia content are interactive multimodal messages because they comprise a seamless combination of graphics, text, and audio output or a combination of the same with speech, text, and touch input.” Pet. at 23 (citing Ex. 1002 ¶ 74). Although this “analysis” parrots back the construction of “multimodal message,” it does not explain or disclose how these alleged multimodal messages are “interactive.”

The Petition then spends a total of two sentences¹ explaining how the multimodal message is “interactive,” explaining that “Still states that the recipient

¹ This analysis is repeated in the Petition on page 36, regarding the claim element “whereby the interactive multimodal message triggered on the mobile device enables said recipient interaction.” Regardless of which claim element it is applied to, the analysis remains deficient and the prior art does not disclose an “interactive” multimodal message.

‘may access the content . . . to listen and/or view’ it, ‘dedicate’ it to a recipient, or ‘forward’ it to a recipient.” Pet. at 23 (citing Ex. 1008 ¶ 22). But accessing content to view it, dedicating it to a recipient, or forwarding it to a recipient do not render multimodal messages “interactive” under the plain meaning of that term. If merely forwarding a message or viewing it rendered a message interactive, then every non-interactive message ever created is an “interactive” message. This is not what is contemplated by the claim.

In the very last citation in this section, the Petition includes a *see also* cite to a portion of the ’949 patent, which states:

The interaction with the interactive multimodal message by the recipient 205 may, for example, comprise ending the interactive multimodal message, replying to the interactive multimodal message, or forwarding the interactive multimodal message to one or more second recipients.

Pet. at 23 (citing Ex. 1001 5:34-39). This statement is not lexicography, and these three examples of recipient “interaction” are not what make the multimodal message interactive. What the recipient “interacts” with in this embodiment is *already* an “interactive multimodal message,” not because the recipient chooses or does not choose to end, reply to, or forward the message, but because the message itself allows interaction under the plain meaning of that term, e.g., two-way communication.

Other portions of the specification support that Petitioners are misreading and unreasonably broadening the phrase “interactive.” In the background section, the ’949 patent states:

Mobile communication service providers also provide services that allow a subscriber to send a text message with a request to purchase chosen ringtones, wallpapers, etc, [sic] or to activate a chosen new service, for example to activate or deactivate roaming, to the service provider. However, the choice is typically made by the subscriber offline, while the text message is used only for conveying the choice to the service provider. *The text message itself is non interactive.*

Ex. 1001 1:52-59 (emphasis added). The specification supports the plain meaning of the term “interactive,” and even states that typical text messages available at the time are non-interactive. *Id.* Still discloses a non-interactive text message that is associated with some other form of media data. This is not an “interactive” multimodal message, and Still does not disclose this claim element.

The Petition appears to use Still alone in Ground 1 and combines Still with Levkovitz for Ground 2. *See* Pet. at 25. The Petition relies on Levkovitz’s “client application” that is located on the mobile device in the event the claimed “client application” is construed to require the application be completely on the mobile device. *Id.* The Petition does not rely on any disclosures of Levkovitz for the claimed “interactive multimodal message,” and therefore the petition is deficient as this claim element is not met by Still.

Even if the Petition's citation to Levkovitz is applied to the "interactive multimodal message," it still does not disclose the required interactive message. The Petition cites to Levkovitz which states that the sender device includes a message client that is "'able to send and/or receive a message, a textual message, a graphical message, a SMS message, a MMS [sic] message, an IM item,' an Email message, 'or the like.'" Pet. at 25-26 (quoting Ex. 1009 ¶ 241). None of these is an example of an "interactive" multimodal message under the plain meaning of that term, rendering the Petition deficient.

Neither Still nor Levkovitz disclose or teach the following claim elements, and therefore the Petition is deficient and should be denied:

- "1. A method of enabling a recipient to interact with *an interactive multimodal message* triggered on a mobile device of said recipient . . ."
- Creating *said interactive multimodal message* by a sender using a client application to said sender, wherein said created *interactive multimodal message* is stored at a server"
- "sending a notification comprising a pointer to *said stored interactive multimodal message* to said mobile device of the recipient by said server;"
- "triggering the stored *interactive multimodal message* on the mobile

device of the recipient by accessing said pointer in said notification;”

- “transmitting service information to the mobile device of the recipient through said triggered *interactive multimodal message*”
- “whereby the *interactive multimodal message* triggered on the mobile device enables said recipient interaction.”

B. Grounds 3-4 Fail Because the Petition Fails to Demonstrate That Mumick’046 Discloses an Interactive Multimodal Message

Grounds 3 and 4 fail for the same reason as Grounds 1 and 2, namely that the disclosed messages in Mumick’046 are not “interactive” as required by the challenged claims. Again, the Petition relies on the example of “forwarding” the interactive multimodal message in the specification to expand the definition of “interactive” to include every message ever written. *See* Pet. at 50 and n.13 (“Specifically, Mumick’046 discloses that the recipient may ‘reply to a voice mail by SMS’” and noting that “[t]his is how the ’949 Patent presents the interaction.”).

As above, merely replying to a voice mail with an SMS does not make the voice mail itself interactive, and Petitioners’ interpretation of the claim is incorrect. Mumick’046 discloses “[m]ethods for combining speech with existing text wireless Short Message Service (SMS).” Ex. 1010, Abstract. The user of the system of Mumick’046 “creates a voice message by directly calling the multimodal platform 130” and, after the recording is completed, “a text SMS is sent to the receiving user.”

Id. ¶ 24.

According to the Petition, the system in Mumick’046 sends an interactive multimodal message that enables recipient interaction because the recipient may “reply by voice, thereby continuing an exchange of voice messages” and because a recipient may “reply to a voice mail by SMS.” Pet. at 62 (citing Ex. 1010 ¶¶ 37, 55.). Finally, the “interactivity” is allegedly supported by Mumick’046’s disclosure that “a menu may be presented to the recipient when they listen to a voicemail, which allows them ‘to record a message’ that is then sent to the original user that sent a voicemail ‘as a multimodal SMS message.’” *Id.* (citing Ex. 1010 ¶ 55).

Regarding the first two examples, replying to the voice message by using another voice message or an SMS message, neither of those examples render the original voice message “interactive.” Regarding the third example, the menu is presented to the user by the “standard voice mail system[]” on the recipient’s phone, which presents the user with several options to respond to the voice message. Ex. 1010 ¶ 55. The voice message itself, however, is not “interactive” under the plain meaning of that term. All cellular systems will necessarily use some sort of interface that allows a user to reply to a message, be it a voice message or an SMS message. That does not make the messages themselves interactive, as claimed by the ’949 patent.

As with Grounds 1 and 2, the Petition does not cite to Levokovitz for any

disclosures related to the “interactive multimodal message.” The Petition relies on Levkovitz’s “client application” that is located on the mobile device in the event the claimed “client application” is construed to require the application be completely on the mobile device. Pet. at 54-55. The Petition does not rely on any disclosures of Levkovitz for the claimed “interactive multimodal message,” and therefore the petition is deficient as this claim element is not met by Mumick’046.

Even if the Petition’s citation to Levkovitz is applied to the “interactive multimodal message,” it still does not disclose what is required by the claim. The Petition cites to Levkovitz’s disclosure that the sender device includes a message client that is “able to send and/or receive a message, a textual message, a graphical message, a SMS message, a MMS message, an IM item,” an Email message, “or the like.” Pet. at 54 (quoting Ex. 1009 ¶ 241). None of these disclosures are an “interactive” multimodal message under the plain meaning of that term, and the Petition is deficient.

Neither Mumick’046 nor Levkovitz disclose or teach the following claim elements, and therefore the Petition is deficient and should be denied:

- “1. A method of enabling a recipient to interact with *an interactive multimodal message* triggered on a mobile device of said recipient . . .”
- Creating *said interactive multimodal message* by a sender using a client

application to said sender, wherein said created *interactive multimodal message* is stored at a server”

- “sending a notification comprising a pointer to *said stored interactive multimodal message* to said mobile device of the recipient by said server;”
- “triggering the stored *interactive multimodal message* on the mobile device of the recipient by accessing said pointer in said notification;”
- “transmitting service information to the mobile device of the recipient through said triggered *interactive multimodal message*”
- “whereby the *interactive multimodal message* triggered on the mobile device enables said recipient interaction.”

VI. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(A)

Based on Petitioners’ reasons regarding § 314(a), the Board should exercise its discretion to deny this Petition.

The circumstances of the parallel district court litigation, *Multimodal Media LLC v. Samsung Elecs. Co.*, No. 2-22-cv-00462 (E.D. Tex.) (the “District Court Litigation”), necessitate denial of the Petition under the Board’s precedent, as every factor considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20,

2020) (precedential) (considering (a) “whether the petitioner and the defendant in the parallel proceeding are the same party”; (b) “overlap between issues raised in the petition and in the parallel proceeding” (c) “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision”; (d) “investment in the parallel proceeding by the court and the parties”; (e) “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted”; and (f) “other circumstances that impact the Board’s exercise of discretion, including the merits.”).

As set forth below, these factors collectively demonstrate that efficiency and integrity of the AIA are best served by denying review. First, two of the three parties are Defendants in the parallel proceeding. Second, the asserted claims in the District Court Litigation are all at issue in the Petition. Third, trial in the District Court Litigation is set for October 28, 2024, more than seven months prior to the projected statutory deadline for a Final Written Decision of this Petition on June 14, 2025. Fourth, the parties (and Patent Owner in particular) have invested significant resources on developing legal and factual issues of validity and infringement in the District Court Litigation and will have invested substantially more resources before any decision on this Petition. Fifth, the Court has neither granted nor denied a stay pending this Petition. Finally, no other factors favor institution.

Accordingly, the Board should exercise its discretion under § 314(a) and deny

the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

A. The Parallel District Court Litigation and the Petition Involve Substantially the Same Parties

As noted in Patent Owner’s Mandatory Notice, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the ’949 Patent). *Samsung Elecs. Co., v. Multimodal Media LLC*, IPR2024-00056, Paper 6 at 2 (P.T.A.B. December 26, 2023). Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. are parties to the District Court Litigation. Although Petitioner Google is not a defendant in that litigation, Samsung itself has moved to transfer that case to the Northern District of California based on activities of Google in that District. *See* District Court Litigation at Dkt. 49 (Ex. 2003). Petitioners cannot have it both ways: both using Google as a co-petitioner to attempt to avoid a *Fintiv* analysis and also attempting to include Google in the District Court Litigation in an attempt to manufacture facts for a transfer would be inequitable. Accordingly, this factor weighs in favor of discretionary denial.

B. The District Court Litigation Involves Substantially the Same Claims

All of the asserted claims of the '949 Patent in the District Court Litigation are at issue in this Petition. “In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020). Accordingly, this fact weighs in favor of discretionary denial.

C. Proximity of the District Court’s Trial Date

The proximity of the District Court Litigation’s trial date to the Board’s projected statutory deadline for a Final Written Decision strongly weighs in favor of discretionary denial.

The trial is scheduled for October 28, 2024. Exhibit 2001 (Second Amended Docket Control Order, Dkt. 72, *Multimodal Media LLC v. Samsung Elecs. Co.*, No. 2-22-cv-00462 (E.D. Tex. Jan. 12, 2024). Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final Written Decision of this Petition is June 14, 2025. As the District Court’s trial will be more than seven months before the projected statutory deadline, this factor weighs strongly in favor of denying institution. *See Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 10-

12 (P.T.A.B. June 24, 2020) (denying institution where the jury trial was scheduled to conclude approximately ten months before the statutory deadline); *Edward LifeSciences Corp. v. Evalve, Inc.*, IPR2019-01479, Paper 7, at 6-13 (P.T.A.B. Feb. 26, 2020) (denying institution where jury trial would conclude more than nine months before a final decision would be due); *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude “several months,” before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 (“Because the trial date is substantially earlier than the projected statutory deadline for the Board’s final decision, this factor weighs in favor of discretionary denial.”). Thus, this factor also weighs in favor of discretionary denial.

D. Significant Investment and Petitioners’ Delay in Filing the Petition

The parties’ investment in the parallel proceeding weighs in favor of discretionary denial. In the District Court Litigation, discovery is well under way. The parties have already exchanged infringement contentions pursuant to P.R. 3-1, and invalidity contentions pursuant to P.R. 3-3, begun the claim construction process

including briefing and expert depositions, and conducted at least one fact deposition. See Ex. 2001. Fact discovery will close before the statutory deadline to institute this proceeding. Thus, the parties' and Court's substantial investment in this District Court Litigation weighs in favor of denial of institution under this factor.

E. No Stay of the Parallel District Court Litigation

There is no stay of the parallel District Court Litigation.² Even if the Petition were instituted and Petitioners' motion to stay the District Court Litigation is granted, prejudice, tactical disadvantage to Multimodal, the late stage of the litigation, and the lack of potential simplification would weigh strongly against such a motion. *See Lennon Image Techs., LLC v. Macy's Retail Holdings, Inc.*, 2:13-CV-00235-JRG, 2014 WL 4652117, at *1 (E.D. Tex. Sept. 18, 2014). The statutory deadline for institution is not until after claim construction discovery begins. Ex. 2001; *see Intell. Ventures II v. FedEx Corp.*, No. 2:16-cv-00980-JRG, Dkt. 141 at 5 (E.D. Tex. Oct. 24, 2017) ("The Court agrees that the Parties have already invested substantial effort and resources during discovery and in preparing claim construction briefing. . . . These circumstances weigh against staying this case").

Moreover, a stay would not decrease the burden on the Court and the parties

² Although Petitioners state that they have not moved to stay the district court proceeding prior to filing their petitions for *Inter Partes* Review, the Samsung Petitioners did subsequently request a stay of the litigation. Ex. 2002, Dkt. 78.

since any instituted IPR would not cover any of the references that Petitioners raised in the District Court Litigation for both anticipation or any of the combinations of obviousness, and do not include Petitioners' challenges under § 112 or § 101. *Intell. Ventures II*, No. 2:16-cv-00980-JRG, Dkt. 141 at 3-4 (“[T]he instituted IPRs only cover a narrow slice of the invalidity arguments Defendants have raised in this case. For example, Defendants have argued that the ’715 Patent is invalid under § 102 with respect to at least eight references . . . under § 103 with respect to at least twenty-six combinations . . . under § 112 [], and under § 101.”).

Accordingly, it would be unlikely for the Court to hold that a stay would streamline the litigation and this factor supports denial of institution.

F. Other Factors Favor Discretionary Denial

Petitioners do not present a strong case on the merits, further supporting denial of institution. Petitioners also do not identify any other factors which weigh against discretionary denial. Pet. at 70-74.

Thus, when viewing the factors together, the Petition should be denied in the Director's discretion under 35 U.S.C. § 314(a).

VII. THE BOARD SHOULD REJECT ANY LATE SOTERA STIPULATION

Samsung has not made a *Sotera*-style stipulation that “if IPR is instituted, [Petitioner] will not pursue in the District Court Litigation any ground raised or that

could have been reasonably raised in an IPR” in its Petition, which weighs further in favor of discretionarily denying institution. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 13-14 (P.T.A.B. Dec. 1, 2020) (designated Dec. 17, 2020).

The Board should not accept any late *Sotera* stipulation after this Preliminary Response. Petitioners have known about the District Court Litigation since Patent Owner filed a Complaint asserting infringement of the ’949 Patent against Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (November 29, 2022) over one year before this Petition (December 2023). Three docket control orders have been entered in the District Court Litigation, each anticipating a trial date for October 2024. Ex. 2001. Any withholding of the *Sotera* stipulation in its Petition is gamesmanship and prejudicial to Patent Owner in this proceeding and is inconsistent with 37 C.F.R. § 42.1(b)’s mandate to “secure the just, speedy, and inexpensive resolution of every proceeding.”

Both the Board and the Director are abundantly clear that Petitioners cannot wait until after the Board renders its Institution Decision to address the issue of *Fintiv* and the Board’s discretionary authority, and to submit a *Sotera* stipulation. *NXP USA, Inc. v Impinj, Inc.*, IPR2021-01556, Paper 12, 5-6 (P.T.A.B. Aug. 25, 2022); *see also id.*, IPR2021-01556, Paper 13, 3-4 (P.T.A.B. Sept. 7, 2022) (the Director finding “that the Board correctly determined that a stipulation, offered by a

petitioner for the first time after a decision denying institution, is not a proper basis for granting rehearing of the decision on institution;” “[p]ermitting a petitioner to wait and see if the Board denies institution under *Fintiv*, and then offer such a stipulation for the first time on rehearing, frustrates these goals [of avoiding conflicting decisions] and would open the door to gamesmanship;” “*the only appropriate time for a petitioner to offer a stipulation related to the Fintiv factor 4 analysis is prior to the Board’s decision of whether to institute review.*”) (emphasis added).

VIII. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board deny Google LLC, Samsung Electronics Co. LTD., and Samsung Electronics America, Inc.’s Petition in its entirety.

Respectfully submitted,

Dated: March 14, 2024

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE specified in 37 C.F.R. § 42.24 has 4,483 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

Respectfully submitted,

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CERTIFICATE OF SERVICE

A copy of Patent Owner's Preliminary Response has been served on

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