

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. 9,185,227
Filing Date: December 12, 2013
Issue Date: November 10, 2015

Inventors: Inderpal Singh Mumick, Surinder Singh Anand,
and Raja N. Moorthy

Title: SENDER DRIVEN CALL COMPLETION SYSTEM

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2024-00063

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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 1-6, 8-15, and 17-19 of U.S. Patent No. 9,185,227 (Ex. 1001, the “’227 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 of the Petition because:

(1) The Prior Art cited in Ground 1, International Application Publication No.

WO 2010/139478 to Deutsche Telekom AG (“Prikowitsch,” Ex. 1011) does not disclose the claimed “call completion application” in the ’227 Patent, which explicitly requires that the detection of an incomplete call occurs on the calling party device. Rather, Prikowitsch discloses that the incomplete call is detected by a network server, and status information is relayed to the calling party device.

(2) The Prior Art cited in Ground 3, U.S. Patent Application No.

2004/0267884 to Yaron Sar-Shalom (“Sar-Shalom,” Ex. 1013) does not disclose the claimed “call completion application” which performs all the recited functions in the claims. The Petition instead modifies what it refers to as the “call completion application” in Sar-Shalom in the middle of its

analysis to argue that each of the claimed functions is being performed. But the '227 Patent requires a single “call completion application” to perform each element of the claim, and Sar-Shalom instead discloses a group of applications that trigger one another in order to operate.

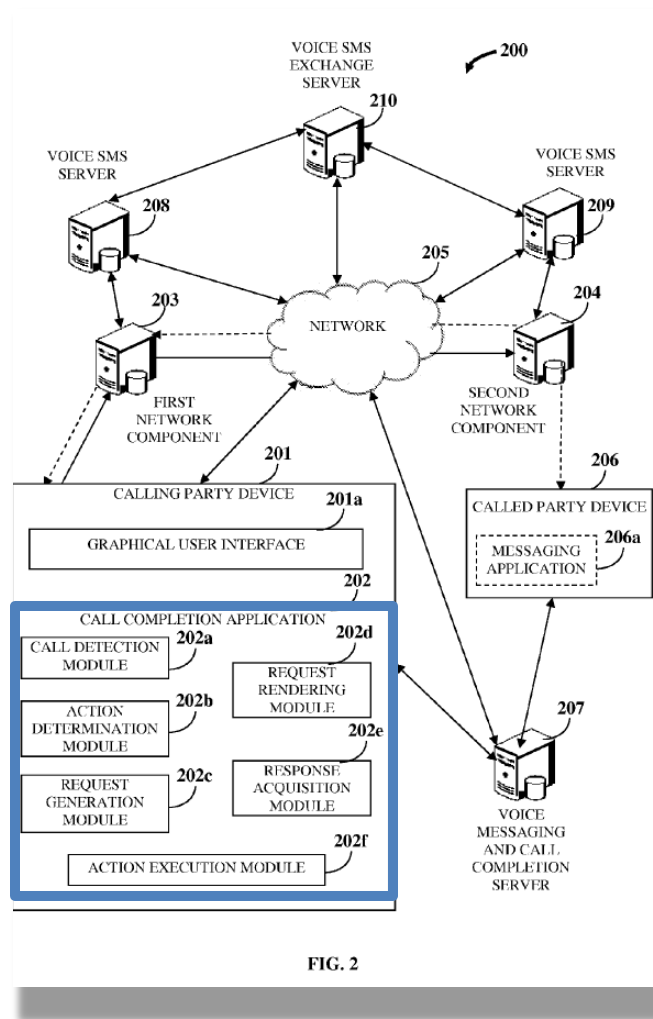
- (3) Ground 2 and 4 relate only to dependent claims and add an additional reference in an obvious combination. Because Grounds 1 and 3 fail and the underlying independent claims are not obvious over the cited prior art, Grounds 2 and 4 fail without analysis.

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

II. THE '227 PATENT

The '227 Patent describes and claims a “Sender Driven Call Completion System” by providing a “call completion application on a calling party device.” Ex. 1001, Title, Abstract. Upon detection of an incomplete call, the call completion application determines one or more “call completion actions,” which can be selected by a user or selected automatically. *Id.*

One of the innovations in the '227 Patent is that the call completion application resides on the calling party device, as shown in Figure 2:



Ex. 1001, FIG. 2 (annotated)

The functionality in the '227 patent, which did not exist at the time, allows the claimed method and system to operate agnostically as to whether a compatible system exists on the recipient's device. *Id.* 1:32-62. The inventions of the '227 Patent do not depend on the network that either of the devices are connected to, and resides entirely on the calling party device. *Id.* 2:39-51.

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, or the equivalent, with additional education substituting for experience and vice versa.” 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. “call completion application”

The parties currently dispute the construction of “call completion application” in the related district court action:

Petitioners Construction	Patent Owner Construction
“a software module that completes an incomplete call made by a calling party that is independent of a preconfigured call completion service, such as a voicemail, that is on the called device”	“a software module that completes an incomplete call made by a calling party without any dependence on the underlying network or called party device”

Patent Owner proposes that resolution of this dispute is not necessary to decide whether to institute a trial, because the Petition fails under either construction.

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)).

Should the Board see it necessary to conduct claim construction, the Petitioners’ construction should be rejected as overly broad and contrary to the claim language and specification.

Patent Owner’s construction is consistent with the specification, which notes that:

The method and the system disclosed herein enable a seamless execution of an action by the calling party, for example, an action that leads to a seamless transmission of a message from the calling party to the called party when the call is not completed, where the calling party is prompted automatically to perform an action, for example, transmit a message, when the call is not completed. *Furthermore, the method and the system disclosed herein implement a call completion service without any dependence on the underlying network to support call completion for the called party, with the calling party equipped with sufficient information and capability to trigger execution of the action.*

Ex. 1001, 2:26-38 (emphasis added). This is consistent with the benefits of the invention and the claims themselves, each of which require that the call completion application on the calling party device perform certain actions. In other words, the invention disclosed and claimed in the ’227 Patent is that the *calling party device*, rather than a service associated with the called party device or the network server,

“determines one or more of multiple call completion actions to be performed to complete the detected incomplete call.” Ex. 1001, 3:4-7.

In support of their incorrect proposed construction, Petitioners present three arguments. First, they claim that their proposed construction is supported by the specification. Pet. at 9. One portion of the specification notes that the call completion application is “independent of a preconfigured call completion service” like voicemail, but Petitioners do not explain why the claim should be limited to this exemplary embodiment and do not state that this is lexicography. *Id.* (citing Ex. 1001 1:24-43).

Petitioners next propose that dependent claims 2, 5, 12, and 15 “explicitly depend at some level ‘on the underlying network or called party’s device’” because they each claim the detection of an incomplete call based on certain events related to the called party device, such as the device being busy, out of a coverage area, unreachable, etc. Pet. at 10.

This argument is incorrect for several reasons. First, the events in claim 2 do not depend on the underlying network. A calling party’s wireless carrier can be T-Mobile and a called party’s wireless carrier can be Verizon, and the call completion application will still be able to detect an incomplete call based on these events, including “said call not being answered by said called party.” Ex. 1001, claim 2. Dependent Claim 2 does not change the basic language of claim 1, which requires

the detection of the incomplete call to occur by the call completion application on the calling party device. Second, the case law cited by Petitioners merely states that a dependent claim that contradicts the underlying independent claim is invalid for indefiniteness. *Multilayer Stretch Cling Film Holdings, Inc. v. Berry Plastics Corp.*, 831 F.3d 1350, 1362 (Fed. Cir. 2016). Notably, Petitioner Samsung has not advanced any such indefiniteness argument in the co-pending district court action, despite acknowledging that this claim construction dispute exists.

Petitioners' final argument in supporting their incorrect construction is that the prior construction is "inconsistent with intrinsic evidence." Pet. at 11. But this section does not cite or refer to any intrinsic evidence, merely incorporating expert testimony that copies the two prior claim construction arguments *verbatim*. In this section, the Petition argues that "applications for making calls must at least have some dependency on network and messaging protocols." *Id.* This argument intentionally misunderstands Patent Owner's construction and the claim language itself. As explained above, the claimed call completion application operates independently of the network that the calling party device is attached to. This does not mean that the call completion application *only* operates without a network at all, as Petitioners attempt to argue. Petitioners' claim construction is overly narrow and incorrect. Additionally, even if Petitioners' claim construction is adopted, as shown below, the Petition fails to meet its burden to show that the prior art discloses the

claimed “call completion application *on the calling party device*” performs the claimed functions, and therefore still should not be instituted. Patent Owner does not propose that any other claim construction issues are necessary to resolve the dispute.

**V. PETITIONER HAS NOT DEMONSTRATED A REASONABLE
LIKELIHOOD OF SUCCESS**

Each of the four grounds for obviousness fails because the basic structure of the prior art differs from the claim invention. Ground 1 fails because Prikowitsch discloses the detection of the incomplete call on a server, which directly contradicts the claims’ requirements that the incomplete call be detected on the calling party device. Ground 2 fails for the same reasons because it relates only to dependent claims which depend from the independent claims that are not rendered obvious by Ground 1. Ground 3 fails because the Petition shifts its theory as to what constitutes the “call completion application” in Sar-Shalom, and Sar-Shalom does not disclose a single “call completion application” that performs all of the functions required by the call completion application in the claims of the ’227 Patent. Ground 4 fails for the same reasons because it relates only to dependent claims which depend from the independent claims that are not rendered obvious by Ground 3.

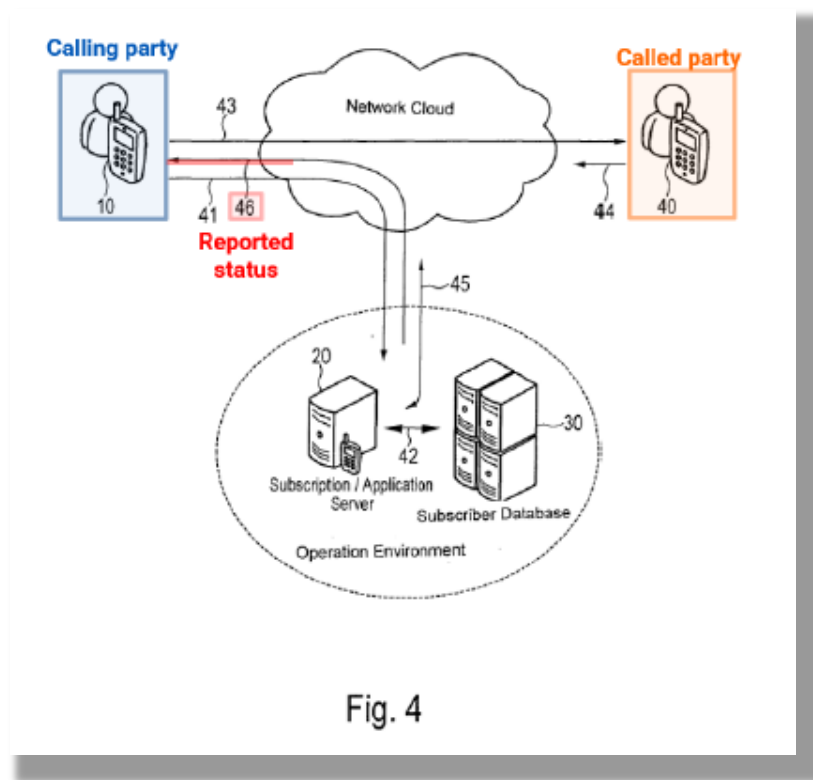
**A. Ground 1 Fails Because Prikowitsch Does Not Disclose
Detecting an Incomplete Call On the Calling Party Device**

Ground 1 contends that claims 1-2, 5, 8-12, 15, and 17-19 are obvious over PCT Publication No. WO 2010/139478 (“Prikowitsch”). The claims of the ’227

Patent require the “call completion application” to (1) detect the incomplete call; (2) receive the call completion actions; and (3) execute the call completion actions. Prikowitsch fails to meet all of the claims’ requirements because the call completion application on the calling party device does not detect an incomplete call, but rather relies on the server to notify it that a call has not been completed.

According to Petitioners, Prikowitsch discloses a call control method that Fallows a calling party to define customized actions to react to reported call statuses, and a call completion application on the calling party device that monitors the call and processes events based on detected and reported statuses. Pet. at 12. This is incorrect.

Prikowitsch discloses a system that is precisely what the invention in the ’227 patent is not—it relies upon “a server associated with the first communication network . . . to report back the current status to the calling terminal device from the network.” Ex. 1011, Abstract, 1:7-9. Prikowitsch admits that it discloses call control methods that were already known, such as sending a “signal to the calling terminal device that the called subscriber is unavailable or that the line is busy.” *Id.*, 1:11-12. The system disclosed in Prikowitsch is shown below:



Ex. 1011, Fig. 4 (annotated by Petitioner).

Each of the challenged dependent claims requires that the call completion application be located on the calling party device, and that the detection of the incomplete call *occurs on the calling party device*. Element 1[b] requires “detecting said incomplete call made by said calling party to said calling party, *by said call completion application on said calling party device*” while Elements 11[c] and [d] require “said call completion application *on said calling party device*, comprising: a call detection module configured to detect said incomplete call made by said calling party to said called party.” (emphases added.)

The Petition fails to show how each of these claim elements is met by Prikowitsch, and therefore institution should be denied. The Petition states that Prikowitsch “teaches a call completion application, which monitors a call from a calling party to a called party based on ‘reported status information.’” Pet. at 19-20 (citing Ex. 1011, 6:33-7:2). Nowhere does Prikowitsch use the term “monitor” or “detect” in relation to an incomplete call. Indeed, Prikowitsch *relies upon the server* to detect the incomplete call and “report” that status information to the calling party. Ex. 1011, 6:33-7:2. The status 46 is “reported by a server in the first communication network.” *Id.*, 3:5-6. The disclosed call completion application does not detect an incomplete call *on the calling party device* as claimed by the ’227 Patent.

Petitioners’ additional citations to Prikowitsch are also unavailing. Petitioners cites to 5:19-33¹ regarding the “detecting” step, but this only supports the disclosure that the server of the network is used to detect status information and “report” that information to the calling party (“[i]t is also possible to report back whether or not the terminal device of the called B subscriber is currently logged into the network.”). At 13:5-9, Prikowitsch discloses that the event 44 “is signalled” to the application on the terminal device for further evaluation.” Pet. at 20.

¹ Petitioner’s citation appears to be to page 3 of Prikowitsch, which is Bates stamped as page 5.

The Petition makes no attempt to explain how an admitted prior art system that reports status information across a network meets the claim limitation that requires detection of the incomplete call to occur on the calling party device. Therefore, the Petition is deficient and should be denied as to Ground 1.

B. Ground 2 Fails Because the Underlying Independent Claims Have Not Been Rendered Obvious by Prikowitsch

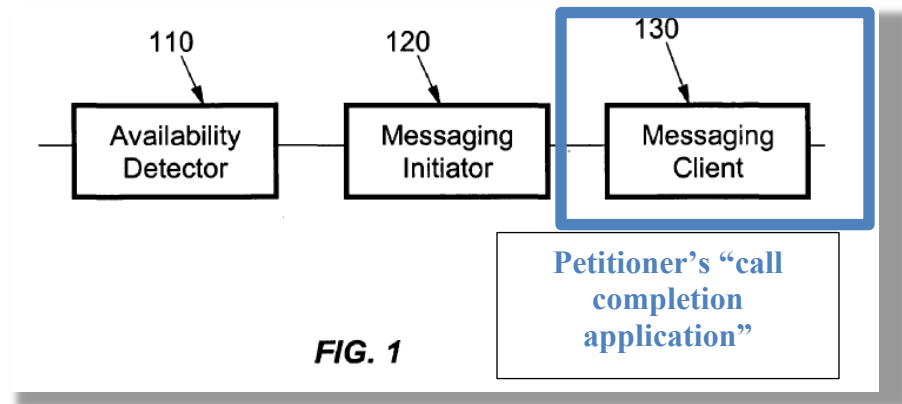
Ground 2 relates only to dependent claims. Because the underlying independent claims have not been shown to be likely unpatentable in Ground 1, Ground 2 fails without analysis.

C. Ground 3 Fails Because the Petition Does Not Consistently Define Sar-Shalom's Call Completion Application

The claims of the '227 Patent require the "call completion application" to (1) detect the incomplete call; (2) receive the call completion actions; and (3) execute the call completion actions. The Petition shifts positions in the middle of its analysis regarding what it contends is the "call completion application" in order to shoehorn this prior art into the claims. Because Sar-Shalom does not disclose a "call completion application" that performs all of the functions required by the independent claims of the '227 Patent, it does not render the challenged claims obvious.

The Petition first states that "Sar-Shalom's messaging client with the integrated messaging launcher (i.e., software) is a call completion application on the

calling party device.” Pet. at 44. Figure 1 of Sar-Shalom is shown below, including what the Petition contends is the claimed “call completion application:”



Ex. 1013, FIG. 1 (annotated).

“Sar-Shalom’s messaging client with the integrated messaging launcher (i.e., software) is a call completion application on the calling party device.” Pet. at 44.

When discussing the following claim element, the Petition refers to a *different* call completion application, namely the “automatic messaging client launcher’s availability detector,” (*Id.* at 45) which it contends “monitors the call.” (citing Ex. 1013 at [0036]). Although the availability detector does appear to monitor the call, *the availability detector is not part of the call completion application.* For the remainder of this ground, the Petition refers to the “automatic messaging client launcher” as the claimed “call completion application” that Petitioners contend perform the claimed function. But the Petition never defines the “automatic

messaging client launcher” in Sar-Shalom as the “call completion application.” For this reason, the Petition is deficient and institution should be denied.

Sar-Shalom does not disclose a single call completion application meets the claimed requirements. Rather, Sar-Shalom discloses a system that uses an application to detect an incomplete call, which then launches *another* application, the messaging client, which can be used to send SMS or MMS messages. *See, e.g.*, Ex. 1013 at [0053] (“a trigger signal is provided to the messaging client, at S320, causing the messaging client to launch.”).

The system claimed by the ’227 Patent requires no such triggering signal and does not launch a separate application to send or execute the call completion applications. Rather, the system described and claimed in the ’227 Patent is a single “call completion application” that detects an incomplete call, provides the user with call completion actions and receives selected call completion actions, and executes those call completion actions. Sar-Shalom therefore does not teach the following claim elements:

Element 1[b] “detecting said incomplete call made by said calling party to said called party, *by said call completion application on said calling party device;*”

Elements 11[c] and 11[d] “said *call completion application on said calling party device*, comprising: *a call detection module* configured to detect said incomplete call made by said calling party to said called party;”

Element 1[d(i)]: “receiving one or more of a plurality of call completion actions *to be performed by said call completion application* on said calling party device to complete said detected incomplete call;”

Element 11[e(i)]: “an action determination module configured to receive one or more of a plurality of call completion actions *to be performed to complete said detected incomplete call*;”

Element 1[e]: “triggering execution of said received one or more of said call completion actions *by said call completion application* on said calling party device based on one or more of action execution criteria for said completion of detected incomplete call;”

Element 11[f]: “*an action execution module configured to trigger execution of said received one or more of said call completion actions* based on one or more of action execution criteria one or more responses selected by said calling party for said completion of said detected incomplete call.” (emphases added.)

Because the Petition does not show that Sar-Shalom renders the dependent claims obvious, institution should be denied.

D. Ground 4 Fails Because the Underlying Independent Claims Have Not Been Rendered Obvious by Sar-Shalom

Ground 4 relates only to dependent claims. Because the underlying independent claims have not been shown to be likely unpatentable in Ground 3, Ground 4 fails without analysis.

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 ’227 Patent). *Samsung Elecs. Co., v. Multimodal Media LLC*, IPR2024-00063, 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 ’227 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 Petitioner’s 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 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

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

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 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 Petitioner's 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 88-91.

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 '227 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

/Peter Lambrianakos /
Peter Lambrianakos (Reg. No. 58,279)
Lead Counsel for Patent Owner
Fabricant LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Telephone: 212-257-5797
Facsimile: 212-257-5796
Email: plambrianakos@fabricantllp.com

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 4,796 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,

Dated: March 14, 2024

/Peter Lambrianakos /
Peter Lambrianakos (Reg. No. 58,279)
Lead Counsel for Patent Owner
Fabricant LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Telephone: 212-257-5797
Facsimile: 212-257-5796
Email: plambrianakos@fabricantllp.com

CERTIFICATE OF SERVICE

A copy of Patent Owner's Preliminary Response has been served on
Petitioner's counsel of record as follows:

William M. Fink
Email: tfink@omm.com
O'MELVENY & MYERS LLP
1625 Eye Street, NW
Washington, DC 20006

Benjamin Haber
Email: bhaber@omm.com
O'MELVENY & MYERS LLP
400 South Hope Street, 18th Floor
Los Angeles, CA 90071

Mark Liang
Email: mliang@omm.com
O'MELVENY & MYERS LLP
2 Embarcadero Center, 28th Floor
San Francisco, CA 94111

Caitlin P. Hogan
Email: chogan@omm.com
O'MELVENY & MYERS LLP
Times Square Tower, 7 Times Square
New York, NY 10036

Ali Sharifahmadian
Email: ali.sharifahmadian@arnoldporter.com
ARNOLD & PORTER KAYE SCHOLER LLP
601 Massachusetts Avenue, NW
Washington, DC 20001-3743

Patrick C. Reidy
Email: patrick.reidy@arnoldporter.com

ARNOLD & PORTER KAYE SCHOLER LLP

70 West Madison Street, Suite 4200
Chicago, IL 60602-4231

Attorneys for Petitioners

March 14, 2024

By: /Peter Lambrianakos /
Peter Lambrianakos (Reg. No. 58,279)
Lead Counsel for Patent Owner
Fabricant LLP
411 Theodore Fremd Avenue
Suite 206 South
Rye, New York 10580
Telephone: 212-257-5797
Facsimile: 212-257-5796
Email: plambrianakos@fabricantllp.com