

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. 10,552,030
Filing Date: October 11, 2013
Issue Date: February 4, 2020

Inventor: Kieraj Singh Mumick
Title: MULTI-GESTURE MEDIA RECORDING SYSTEM

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2024-00064

TABLE OF CONTENTS

	<u>Page(s)</u>
I. INTRODUCTION	1
II. THE '030 PATENT	2
III. LEVEL OF ORDINARY SKILL IN THE ART	3
IV. CLAIM CONSTRUCTION	4
A. “interface regions”	4
B. “gesture”	4
C. “interface definition module”	4
D. “detection module”	5
E. “action management module”	5
V. THE PETITION HAS NOT DEMONSTRATED A LIKELIHOOD OF SUCCESS	6
A. Ground 1 Fails to Demonstrate That the Prior Art Teaches Dynamically Changing Functions of the Interface Regions	6
B. Ground 2 Fails to Demonstrate That the Prior Art Teaches Dynamically Changing Functions of the Interface Regions	11
C. Ground 3 Relates Only to Dependent Claims	11
VI. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(A)	12
A. The Parallel District Court Litigation and the Petition Involve Substantially the Same Parties	13
B. The District Court Litigation Involves Substantially the Same Claims	14
C. Proximity of the District Court’s Trial Date	14

D.	Significant Investment and Petitioner’s Delay in Filing the Petition.....	16
E.	No Stay of the Parallel District Court Litigation	16
F.	Other Factors Favor Discretionary Denial	17
VII.	THE BOARD SHOULD REJECT ANY LATE SOTERA STIPULATION	18
VIII.	CONCLUSION.....	20

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020)	12, 14, 19
<i>Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.</i> , IPR2020-00122, Paper 15 (P.T.A.B. May 15, 2020)	14, 15
<i>Edward LifeSciences Corp. v. Evalve, Inc.</i> , IPR2019-01479, Paper 7 (P.T.A.B. Feb. 26, 2020)	15
<i>Intell. Ventures II v. FedEx Corp.</i> , No. 2:16-cv-00980-JRG, Dkt. 141 (E.D. Tex. Oct. 24, 2017)	17
<i>Lennon Image Techs., LLC v. Macy’s Retail Holdings, Inc.</i> , 2:13-CV-00235-JRG, 2014 WL 4652117 (E.D. Tex. Sept. 18, 2014)	16
<i>Multimodal Media LLC v. Samsung Elecs. Co.</i> , No. 2-22-cv-00462 (E.D. Tex.)	12, 15
<i>Next Caller Inc. v. TrustID, Inc.</i> , IPR2019-00961, -00962, Paper 10 (P.T.A.B. Oct. 16, 2019)	15
<i>NHK Spring Co. v. Intri-Plex Techs., Inc.</i> , IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018)	13
<i>NXP USA, Inc. v. Impinj, Inc.</i> , IPR2021-01556, Paper 12 (P.T.A.B. Aug. 25, 2022)	19
<i>Realtime Data, LLC v. Iancu</i> , 912 F.3d 1368 (Fed. Cir. 2019)	5, 6
<i>Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC</i> , IPR2019-01218, Paper 7 (P.T.A.B. Jan. 7, 2020)	15
<i>Samsung Elecs. Co., v. Multimodal Media LLC</i> , IPR2024-00064, Paper 6 (P.T.A.B. December 26, 2023)	13

<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12, 13-14 (P.T.A.B. Dec. 1, 2020) (designated Dec. 17, 2020)	18, 19
--	--------

<i>Supercell Oy v. Gree, Inc.</i> , IPR2020-00513, Paper 11 (P.T.A.B. June 24, 2020)	15
---	----

STATUTES

35 U.S.C. § 103	9, 17
35 U.S.C. § 314(a)	12, 13, 18
35 U.S.C. § 314(b)(1).....	15
35 U.S.C. § 316(a)(11).....	15

OTHER AUTHORITIES

37 C.F.R. § 42.1(b)	19
37 C.F.R. § 42.104(b)(3) and (4)	9
37 C.F.R. § 42.104(b) (4).....	9

EXHIBIT LIST

Exhibit No.	Description
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 1-14 of U.S. Patent No. 10,552,030 (Ex. 1001, the “’030 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 the Prior Art cited in Ground 1, U.S. Patent No. 8,812,041 to Lee (“Lee’041,” Ex. 1014) fails to disclose dynamically changing the functions of predefined interface regions. Petitioners define the claimed “predefined interface regions” as Lee’041’s “regions 16 and 18” (Pet. at 21), whose functions never change as required by the claims. Rather, region 16 is always associated with the function “Hold and Talk” and region 18 is always associated with the region “Slide-to-Lock” in Lee’041. Because these functions never change, Lee’041 fails to disclose dynamically changing the functions associated with one or more defined interface regions as required by both of the challenged independent claims.

Ground 2 combines Lee’041 with an additional reference, U.S. Patent Publication No. 2012/0229410 to Ohashi (“Ohashi,” Ex. 1017), but Ground 2 relies exclusively on Lee’041 in an identical argument to Ground 1 for defining interface

regions and the dynamic changing of their functions. Therefore, Ground 2 fails for the same reasons as Ground 1. Ground 3 relates only to dependent claims which depend from the underlying independent claims and, therefore, Ground 3 also fails for the same reasons as Ground 1.

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

II. THE '030 PATENT

The '030 Patent describes a method “for recording media data such as audio data in one or more communication modes based on gestures on a graphical user interface.” Ex. 1001, Abstract. The '030 Patent describes known communications modes, such as a “push to talk” mode, a “tap to start” mode, a “release to record” mode, a “tap to end” mode, and a “release to stop” mode. *Id.*, 1:16-2:19. Specifically regarding the push to talk mode, the '030 Patent notes that it “allows a user to record short media data quickly, with a single press of a button on the electronic device” but that “the user finds it difficult to record lengthy media data” and “[t]he user is forced to interact with the electronic device throughout the recording of the media data. . . .” *Id.* 2:20-28. The '030 Patent notes that known methods of recording “do not offer a method for the user to cancel the recording once begun, or perform any other action such as switching from one communication

mode to another communication mode, unless the graphical user interface provides an additional user interaction option. . . .” *Id.* 2:38-43.

The ’030 Patent summarizes the invention as providing a gesture-based media recording application that “defines multiple interface regions on the GUI of the electronic device” (*Id.* 3:50-52) and “associates a predefined function . . . with each of the defined interface regions on the GUI” (*Id.* 3:55:58). The media recording application then “dynamically changes the predefined function associated with one of the defined interface regions to another predefined function” based on a number of factors, including the communication mode, user preferences, or detection of certain gestures. *Id.* 4:1-4; 9:1-5.

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 touch interface 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. “interface regions”

For the purposes of this Preliminary Response, Patent Owner agrees that this term should be construed to mean “areas provided on the GUI of an electronic device that enable interfacing and interactions with a user of the electronic device” as proposed by Petitioners and agreed upon in the prior *Oppo* litigation. Pet. at 8-9.

B. “gesture”

For the purposes of this Preliminary Response, Patent Owner agrees that this term should be construed to mean “a user action or an actuation by a user performed manually, for example, by use of a finger, a thumb, a hand, etc., on the GUI, or by using an input device, for example, a physical button, a computer mouse, a pointing device, a light pen, a touch pad, a touch sensitive display device, a track ball, a pointing stick, any device capable of sensing a tactile input, etc.” as proposed by Petitioners. Pet. at 9.

C. “interface definition module”

Patent Owner disagrees that this term invokes § 112 ¶ 6. However, if the term is found to invoke § 112 ¶ 6, Patent Owner agrees with the structure and function proposed by Petitioners for the purposes of this Preliminary Response. For the purposes of the disputes raised herein, Patent Owner does not believe that resolution of this claim construction dispute is necessary because the Petition fails to

demonstrate that the prior art teaches certain claim limitations under any 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))).

D. “detection module”

Patent Owner disagrees that this term invokes § 112 ¶ 6. However, if the term is found to invoke § 112 ¶ 6, Patent Owner agrees with the structure and function proposed by Petitioners for the purposes of this Preliminary Response. For the purposes of the disputes raised herein, Patent Owner does not believe that resolution of this claim construction dispute is necessary because the Petition fails to demonstrate that the prior art teaches certain claim limitations under any construction. *Realtime Data*, 912 F.3d at 1375.

E. “action management module”

Patent Owner disagrees that this term invokes § 112 ¶ 6. However, if the term is found to invoke § 112 ¶ 6, Patent Owner agrees with the structure and function proposed by Petitioners for the purposes of this Preliminary Response. For the purposes of the disputes raised herein, Patent Owner does not believe that resolution of this claim construction dispute is necessary because the Petition fails to

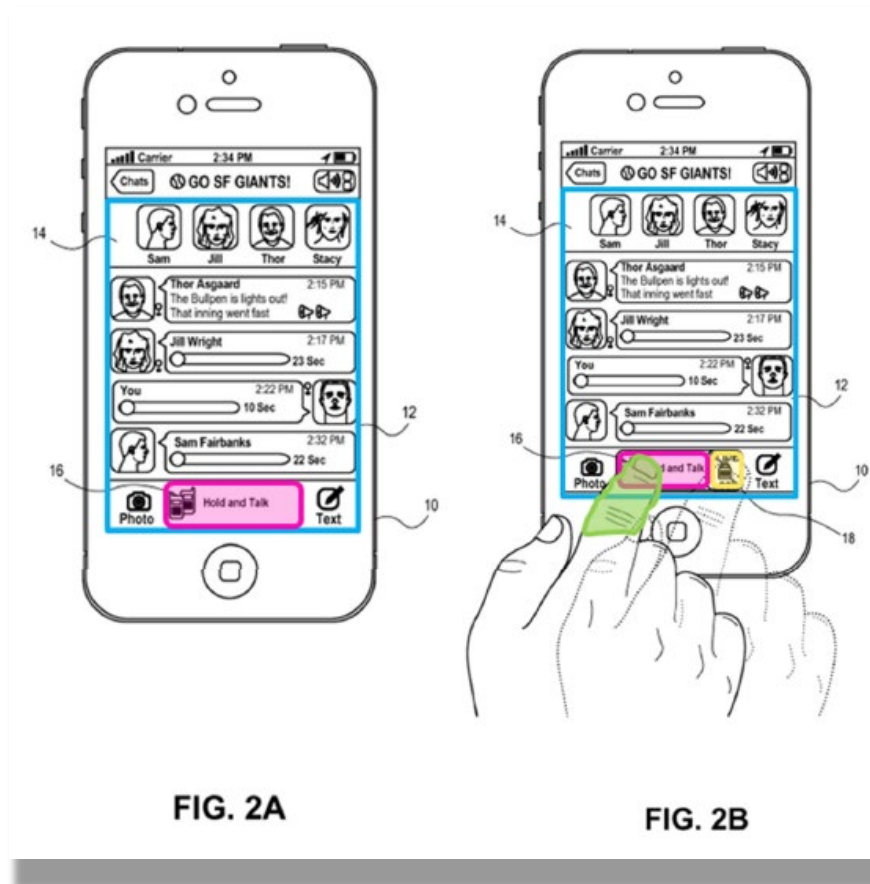
demonstrate that the prior art teaches certain claim limitations under any construction. *Realtime Data*, 912 F.3d at 1375.

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

**A. Ground 1 Fails to Demonstrate That the Prior Art Teaches
Dynamically Changing Functions of the Interface Regions**

The Petition should not be instituted because it fails to show that the functions of the interface regions are dynamically changed in response to a first gesture. Pet. at 27. The Petition apparently recognizes this shortcoming, and instead compares the prior art to the disclosure in the specification rather than the claim. *Id.* at 27-28. This is improper.

Ground 1 presents a single-reference obviousness ground based on Lee’041. According to the Petition, Lee’041 defines “one or more graphical user interface regions, such as regions 16 and 18, that enable interfacing and interacting with a user of the mobile device.” Pet. at 21. Petitioners’ annotations of Lee’041 are shown below, noting regions 16 and 18 as the defined “interface regions”:

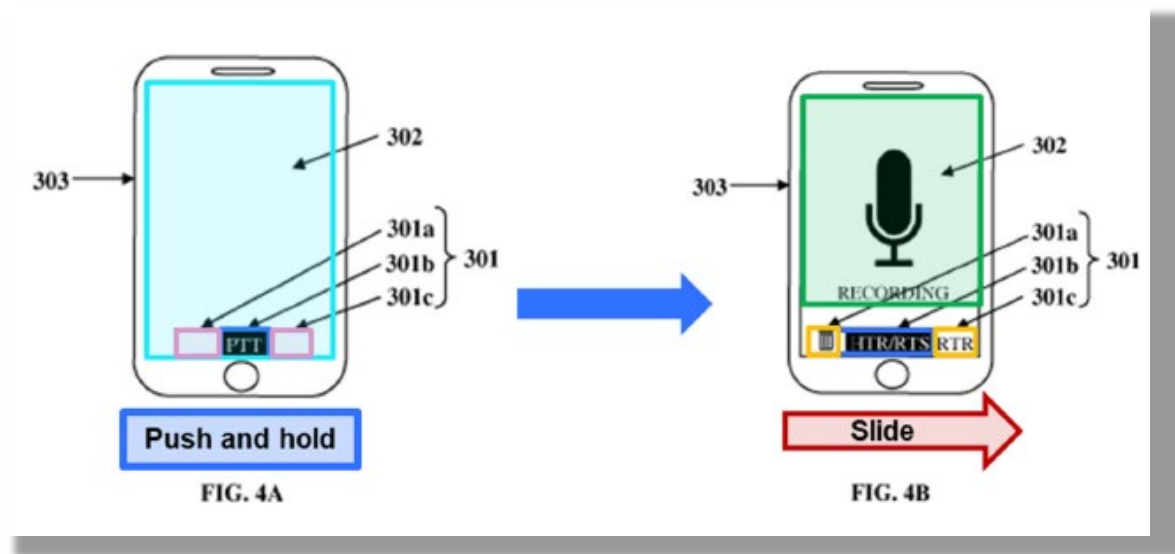


Ex. 1014, annotated by Petitioners (Pet. at 22)

The Petition presents two sentences supporting this claim element, the first parroting back the claim language and stating that Lee’041 “teaches that its gesture based media recording application dynamically changes functions associated with one or more defined interface regions.” Pet. at 27. The Petition goes on to explain that “when the Hold-and-Talk region 16 (Fig. 2A (pink)) is pressed and held by the user’s finger (Fig. 2B (green)) (first gesture), a ‘Slide-to-Lock’ feature dynamically appears to the display screen (yellow) where a part of region 16 was previously.”

Pet. at 27 (citing Ex. 1014, 3:33-36). But a defined interface region that “dynamically appears,” according to Petitioners, does not disclose *dynamically changing functions associated with said one or more defined interface regions* as required by the challenged claims, because the function associated with each of the defined interface regions remains static. The cited portion of Lee’041 states “as illustrated in FIG. 2B, a ‘Slide-to-Lock’ feature 18 appears when the Hold to Talk region 16 is contacted.” Ex. 1014, 3:33-35. But region 16 is always associated with the function “Hold to Talk” and region 18 is always associated with the function “Slide to Lock.” This is not “dynamically changing the functions associated with said one or more defined interface regions.”

The Petition, recognizing this shortcoming in the disclosure of Lee’041, goes on to compare Lee’041 to “a comparable disclosure of the ’030 Patent.” Pet. at 27. The Petition explains that, in an exemplary embodiment of the ’030 patent, the application “‘associates new predefined functions to’ interface regions 301a, 301b, and 301c, such as ‘interface region 301b’ for ‘hold to record (HTR)/release to stop (RTS). . . .’”. *Id.* at 27-28 (citing Ex. 1001 at 12:22-34, Figs. 4A-4B).



Ex. 1001, FIGS. 4A-4B, annotated by Petitioners (Pet. at 28)

This is improper for several reasons.

First, it is error to compare the prior art to the specification of the challenged patent, rather than the claims. *See* 35 U.S.C. § 103 (“A patent for a *claimed invention* may not be obtained . . . if the differences between the *claimed invention* and the prior art are such that the *claimed invention* as a whole would have been obvious. . . .”) (emphasis added).

Second, Petitioners appear to be attempting to use an embodiment in the specification of the '030 Patent to interpret the claim phrase “dynamically changing” without proffering a claim construction for that phrase. This is a failure of the Petition under 37 C.F.R. § 42.104(b)(3) and (4), which requires a Petition to state “[h]ow the challenged claim is to be construed” and “[h]ow the *construed* claim is

unpatenable under the statutory grounds identified. . . .” (emphasis added). Petitioners appear to be attempting to define the “dynamically changing” phrase to include a new interface region appearing based on reference to the ’030 Patent specification without specifically stating that construction. This is a failure of the Petition to comply with the statutory requirements and sufficient reason to deny institution.

What’s more, Petitioners misinterpret and misread the specification of the ’030 Patent. The cited portion of the specification describing Figures 4A and 4B discloses that the application “associates *new predefined functions* to the interface regions 301a, 301b, and 301c.” Ex. 1001 at 12:27-28 (emphasis added). The defined interface regions shown in Figure 4A were blank (or PTT for the middle region), and after detection of the first gesture, new functions are associated with each. This differs from the disclosure in Lee’041, wherein Petitioners have defined the interface regions as “regions 16 and 18” (Pet. at 21), and the functions of those two regions remain unchanged after a gesture is detected.

Based on Petitioners’ definition of the “one or more interface regions” whose functions do not change, Lee’041 does not disclose or teach “dynamically changing, by said gesture based media recording application, functions associated with said one or more defined interface regions based on said detected first gesture on said one of said defined interface regions” as required by claim 1 or “said interface

definition module configured to dynamically change functions associated with said one or more defined interface regions based on said detected first gesture on said one of said defined interface regions” as required by claim 8. Therefore, institution should be denied.

B. Ground 2 Fails to Demonstrate That the Prior Art Teaches Dynamically Changing Functions of the Interface Regions

Ground 2 relies only on Lee’041 for the “dynamically changing” claim elements, combining it with Ohashi for a different claim limitation. Pet. at 39. Because Lee’041 does not disclose or teach “dynamically changing, by said gesture based media recording application, functions associated with said one or more defined interface regions based on said detected first gesture on said one of said defined interface regions” as required by claim 1 or “said interface definition module configured to dynamically change functions associated with said one or more defined interface regions based on said detected first gesture on said one of said defined interface regions” as required by claim 8, Ground 2 fails for the same reason as Ground 1 and should not be instituted.

C. Ground 3 Relates Only to Dependent Claims

Ground 3 relates only to claims 2 and 9, which depend from independent claims 1 and 8. Because the cited prior art fails to show that claims 1 or 8 are obvious, Ground 3 fails for the same reasons and should not be instituted.

**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 ’030 Patent). *Samsung Elecs. Co., v. Multimodal Media LLC*, IPR2024-00064, 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 '030 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.¹ 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-

¹ 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.

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 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 52-56.

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 '030 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 issues 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 MULTIMODAL MEDIA LLC'S PRELIMINARY RESPONSE specified in 37 C.F.R. § 42.24 has 3,975 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 2010.

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 MULTIMODAL MEDIA LLC'S PRELIMINARY RESPONSE and EXHIBITS (Nos. 2001, 2002 and 2003) have been served on Petitioners' counsel of record as follows:

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

Ben 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