UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

COLLISION COMMUNICATIONS, INC.,
Patent Owner.

Case No. IPR2024-01250
U.S. Patent No. 8,089,946

PETITIONERS' BRIEF REGARDING *FINTIV*

On February 28, 2025, the USPTO rescinded the June 21, 2022 memorandum regarding *Fintiv* denials ("Memorandum"). In particular, the Memorandum had instructed the Board to not exercise its discretion to deny under *Fintiv* if a Petitioner filed a *Sotera* stipulation.

Petitioners have filed a *Sotera* stipulation. Ex. 1050. However, under the Board's precedent and practice prior to the Memorandum, the Board should not exercise its discretion to deny. These decisions hold that a *Sotera* stipulation "weighs ***strongly*** in favor of not exercising discretion to deny." *Sotera*, IPR2020-01019, Paper 12 at 18-19 (Dec. 1, 2020) (precedential). Thus, prior to the Memorandum, the Board had consistently held that a *Sotera* stipulation outweighs other factors, including early trial dates. *See, e.g.*, *Samsung Electronics Co., Ltd. et al v. RightQuestion, LLC*, IPR2022-00244, Paper 17 at 13-18 (June 10, 2022) (*Sotera* stipulation outweighs 9-month difference between trial date and FWD); *PNC Bank N.A. v. United Services Automobile Association*, IPR2022-00076, Paper 20 at 9-15 (May 11, 2022) (same); *Resi Media, LLC v. BoxCast Inc.*, IPR2022-00067, Paper 16 at 8-15 (April 26, 2022) (*Sotera* stipulation outweighs 8-month difference); *see also* https://www.sternekessler.com/news-insights/publications/fintiv-continues-take-center-stage-effect-parallel-litigation-ptab-2021/ (finding only 4.7% of cases denied institution under *Fintiv* when *Sotera* stipulation filed).

For the reasons explained below, the *Fintiv* factors weigh against denial.

Factor 1 – neutral. Neither party has requested a stay.

Factor 2 – neutral. Trial is currently scheduled for September 8, which is about six months before the Board's anticipated FWD date. Petitioners' stipulation renders this factor neutral as it removes any overlap between the proceedings. Should the Board find this factor to weigh in favor of denial, it should not be weighed heavily given the *Sotera* stipulation. *See, e.g.*, *Kia Corp. et al. v. Emerging Automotive, LLC*, IPR2024-01167, Paper 14 at 14-16 (January 27, 2025) (declining to deny despite six-month difference "weigh[ing] in favor" of denial).

Factor 3 – against denial. Fact discovery is still ongoing, expert discovery has not yet begun, and the Court has not yet construed any claims. Indeed, the Court only recently held a *Markman* hearing on March 10. *See IQE PLC v. Cornell Research Foundation Inc.*, IPR2024-00609, Paper 9 at 10-11 (Sept. 13, 2024) (factor 3 weighs against denial despite claim construction order when fact discovery still ongoing). Moreover, Petitioners were diligent in filing the Petition about four months after PO's infringement contentions, about two months after invalidity contentions, and over five months before the statutory deadline.

Factor 4 – strongly against denial. As discussed above, Petitioners' *Sotera* stipulation heavily weighs against denial.

Factor 5 – favors denial. The parties are the same.

Accordingly, the *Fintiv* factors weigh against denial.

Respectfully submitted,

Dated: March 12, 2025

By: *<u>/s/ James M. Glass</u>*
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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing document was served on March 12, 2025 via email directed to counsel of record for Patent Owner at the following:

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