UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC. and
SAMSUNG ELECTRONICS CO., LTD.,
Petitioners,

v.

COLLISION COMMUNICATIONS, INC.,
Patent Owner.

Case No. IPR2024-01250
U.S. Patent No. 8,089,946 B2

PATENT OWNER'S BRIEF ADDRESSING THE EFFECT OF THE USPTO'S RECISSION OF THE JUNE 21, 2022, DIRECTOR'S MEMORANDUM ENTITLED *INTERIM PROCEDURE FOR DISCRETIONARY DENIALS IN AIA POST-GRANT PROCEEDINGS WITH PARALLEL DISTRICT COURT LITIGATION*

In light of PTAB's withdrawal of the Director's Memorandum, there are at least two independent reasons that the Board should deny institution. The first is not impacted by the Withdrawal: as established in Patent Owner's Preliminary Response ("POPR"), the Petition fails to establish the required reasonable likelihood of success. But the second reason is directly affected by the Withdrawal: the Board now can and should discretionarily deny institution under *Fintiv*.

The *Fintiv* briefing in the Petition and POPR clearly established that the *Fintiv* factors strongly weigh in favor of a discretionary denial. Consequently, after that briefing, Petitioner filed a last-minute *Sotera* stipulation to avoid that denial. But in light of the Withdrawal, Petitioners' *Sotera* stipulation no longer ties the Board's hands, and the Board now can and should discretionarily deny institution because the *Fintiv* factors heavily weigh in favor of denying institution.

- **Factors 1, 3, and 5:** As already established in the POPR, each of these *Fintiv* factors weighs heavily in favor of denial. *See* POPR at 40-46. The Withdrawal does not impact these factors, and Petitioner has not sought or been granted permission to present any new arguments on them.

- **Factor 2:** Petitioners cannot dispute that any final written decision here would issue ***over six months after*** the district court's scheduled September 8, 2025, trial date. *See* POPR at 42-43. Thus, while this *Fintiv* factor already favored denial, it now weighs even more heavily for denial because—in light of the

Withdrawal—Petitioners can no longer rely on baseless speculation such as "much can change in one year." *E.g.*, Petition at 75.

- **Factor 6:** This factor already strongly favored denial because the Petitioners' allegations of the Petition's strong compelling merits are objectively baseless. POPR at 30-40. The Withdrawal of the Memorandum's emphasis on a compelling challenge thus does not affect the analysis, it merely makes Petitioners' unfounded allegations regarding the Petition's strength even more irrelevant.

- **Factor 4:** Petitioners' only real basis for avoiding a *Fintiv* denial was the Memorandum's position that a *Sotera* stipulation prevented the Board from exercising its *Fintiv* discretion. But the Withdrawal eliminates that lone basis: regardless of the stipulation, the Board can now exercise its discretion to deny institution. And institution here would not serve the purpose of an IPR—a faster alternative to a district court invalidity challenge—because Petitioners are also challenging the validity of these same claims in the earlier district court litigation, and those district court invalidity challenges will be decided over six months ***before*** any FWD. Institution will not thus preserve judicial resources, it will waste them by allowing Petitioners to challenge the same claims first in the district court and then again before the PTAB. The Board can save resources by discretionarily denying this petition and allowing the district court to adjudicate the validity of these claims under the same art over six months ***before*** the PTAB.

Respectfully submitted,

Dated: March 12, 2025

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CERTIFICATE OF SERVICE

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