

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

ANONYMOUS MEDIA RESEARCH HOLDINGS, LLC,
Patent Owner

Case IPR2024-01349
U.S. Patent 10,719,849

PATENT OWNER’S AUTHORIZED BRIEF¹ ADDRESSING *FINTIV*

¹ The filing of this five-page brief was authorized by the Board on March 4, 2025, in light of the rescission of Director Vidal’s June 21, 2022 Memorandum titled “Interim Procedure for Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation” (“Interim Procedure”). *See* Ex. 2041.

Patent Owner respectfully requests that the Board deny institution under § 314(a), as the district court trial is 6 months away and all validity issues will be addressed long before a Final Written Decision (“FWD”). *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 2 (Mar. 20, 2020) (precedential).

1. *The 1st Factor Heavily Favors Denial Because a Stay Will Not be Granted.*

On September 3, 2024, Petitioner sought a stay from the court based on its IPR petition. Ex. 2042, 8. Briefing closed on October 2. *Id.*, 9. Five months have passed; the motion is still pending. Since the filing, the court has permitted the parties to continue fully investing in the litigation. *Id.*, 9-12. The court also recently reaffirmed the upcoming March 18 *Markman* hearing date. *Id.*, 11 (#94). This strongly evidences that the court will not grant a stay, especially because trial is only six months away (*see* Factor 2) and significant time and resources have been invested (*see* Factor 3).

Additionally, the primary reasons for seeking the stay are now invalid. It can no longer be argued that the litigation is “in an early” or “not ... advanced stage” or that “limited discovery has occurred.” Ex. 2043, 2, 8. The court would not benefit from the Board’s claim constructions, as neither party has raised claim construction issues here and the Board has *already* addressed claim construction in its decisions denying institution of the six Roku petitions. *See* IPR2024-01053, -1054, -1055, -1056, -1057, -1058 (challenging ’791, ’768, ’622, ’896, ’848, and ’849 Patents, respectively). A stay would also not meaningfully simplify issues (Ex. 2043, 9), as there are now no pending

IPRs challenging the '768, '622 or '389 (8,677,389) Patents asserted against Petitioner.

Moreover, the district court has consistently denied motions to stay under circumstances *more* favorable to Petitioner than those here. *See, e.g., MyPort, Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:22-CV-00114-JRG, Dkt. 73, 4-5 (E.D. Tex. June 13, 2023) (denying stay where “the PTAB [final written] decision is not due until ***over two months*** after jury trial is set to begin”) (Ex. 2044); *Solas OLED Ltd. v. Samsung Display Co., Ltd.*, No. 2:19-CV-00152-JRG, Dkt. 133, 4 (E.D. Tex. July 17, 2020) (denying stay because “trial is only a few months away” and PTAB final written decisions would have been issued months after the scheduled trial) (Ex. 2045); *Oyster Optics, LLC, v. Infinera Corp.*, No. 2:19-CV-00257-JRG, Order, Dkt. 87, 4-5 (E.D. Tex. July 17, 2020) (denying stay because claim construction briefing closed and “[f]act discovery is closing in about a month and trial is only six months away.”) (Ex. 2046). This factor thus weighs heavily in favor of denial. *See Kiss Nail Products, Inc. v. Lashify, Inc.*, PGR2021-00046, Paper 12, 9 (Aug. 9, 2021) (Factor 1 favoring denial, finding that, even though the judge in the parallel ITC proceeding had not suggested it would not entertain a stay, a stay was unlikely given “the advanced state” of the case).

2. The 2nd Factor Heavily Favors Denial Because the Jury Trial is Looming.

Trial will occur on September 8, 2025—i.e., *nearly 7 months before* the FWD deadline of March 27, 2026. Ex. 2047, 1. As the Interim Procedure was rescinded, time-to-trial statistics are no longer relevant. *See Fintiv*, Paper 15, 13 (May 13, 2020)

(informative) (“We generally take courts’ trial schedules at face value absent some strong evidence to the contrary.”). Regardless, the court’s median time-to-trial is 19 months. Ex. 2048. This factor heavily favors discretionary denial. *See AT&T Servs. Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-00992, Paper 14, 10-11 (Dec. 16, 2024) (Factor 2 “weighs substantially in favor of ... denial” when trial is “four to five months prior” to FWD); *Ericsson Inc. v. Active Wireless Techs.*, IPR2024-00886, Paper 8, 8-9 (Nov. 12, 2024) (Factor 2 favors denial when trial is about 4 months prior to FWD).

3. The 3rd Factor Heavily Favors Denial Given the Significant Investment.

The Board considers “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11, 9. The parties have engaged in nearly a year and a half of fact discovery including: (1) responding to 35 interrogatories and 186 requests for production; (2) producing over 80,000 pages of documents; and (3) at least 18 days of expert source code review at a confidential facility. Infringement and invalidity contentions have been exchanged and claim construction briefing is complete. Ex. 2049, 4-5; Ex. 2042, 11 (#89). *Markman* occurs March 18. Ex. 2047, 3. Fact and expert discovery close in about one (April 14) and two months (May 16), respectively. *Id.* There has been extensive motion practice. Ex. 2042, 8-11 (#42, 45, 77, 92). By the institution deadline, the parties and court will have already invested significant resources toward the looming trial, including substantial preparation of expert reports

due about 2 weeks later. Ex. 2047, 3. By the FWD deadline, they will have *completely* invested in a trial that occurred *nearly 7 months earlier*. This factor heavily favors exercising discretion. *Cisco Sys., Inc. v. Ramot at Tel Aviv University Ltd.*, IPR2020-00122, Paper 15, 8-9 (May 15, 2020) (Factor 3 favored discretionary denial, where claim construction briefing and contentions were complete, *Markman* hearing was held mere days prior, expert discovery closed in 2 months, and trial was in 7 months).

This factor further favors denial when “the petitioner did not file the petition expeditiously, such as at or around the same time that the patent owner responds to the petitioner’s invalidity contentions, or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial.” *Fintiv*, Paper 11, 11-12. Although the lawsuit was served on September 27, 2023, Petitioner waited eleven months to file its Petition. Paper 1. This was seven months after infringement contentions were served (January 22, 2024), and nearly five months after invalidity contentions were served (April 1, 2024). Ex. 2049, 4-5. These facts tilt this factor even heavier toward denial.

4. *The 4th Factor Weighs Against Exercising Discretion.*

Although a *Sotera* stipulation has been submitted (Paper 1, 82), because the Interim Procedure has been rescinded, the Board is no longer required to decline the exercise of discretion. And while this factor does weigh against exercising discretion, the stipulation is not “sufficient when weighed against the other factors.” *See Cisco Sys., Inc. v. Esteche Sys., Inc.*, IPR2021-00333, Paper 12, 12 (July 7, 2021) (denying

institution despite *Sotera* stipulation, emphasizing advanced litigation stage).

5. The 5th Factor Favors Denial as Samsung is Petitioner and Defendant.

Samsung is petitioner and the litigation defendant. *Fintiv*, Paper 11, 13-14.

6. The 6th Factor Favors Denial.

“[I]f the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring the denial are present.” *Id.*, 14-15. There are no compelling merits for at least the reasons set forth in Sections III (pp. 11-60) and IV (pp. 62-71) of the Preliminary Response. Paper 11. But even the presence of compelling merits would not justify institution. First, because the Interim Procedure was rescinded, “compelling merits” no longer mandate that the Board decline to exercise its discretion; they are simply one factor to consider. Second, compelling merits would not outweigh the balance of factors here overwhelmingly favoring discretionary denial. The “compelling merits” consideration “*may* serve the interest of overall system efficiency and integrity because it allows the proceeding to continue in the event that the parallel proceeding settles or fails to resolve the patentability question presented in the PTAB proceeding.” *Fintiv*, Paper 11, 14-15. However, *all* invalidity issues will be resolved by a jury in 6 months, rendering institution a waste of the Board’s finite resources. The ’848 and ’849 Patents also expire before trial begins, so no efficiency or integrity purpose would be served by instituting, even if the parties later settle.

Dated: March 7, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4), the undersigned certifies that on March 7, 2025, the foregoing document was served via electronic mail on the following attorneys of record at the indicated e-mail address, which Petitioner has consented to electronic service for:

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