

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

TRUESIGHT COMMUNICATIONS LLC,

Patent Owner.

Patent No. 8,898,803

Filing Date: January 11, 2011

Issue Date: November 25, 2014

Inventors: David W. Hostetter and Joseph P. Zipperer

Title: CONTENT AND IDENTITY DELIVERY SYSTEM FOR
PORTABLE PLAYBACK OF CONTENT AND
STREAMING SERVICE INTEGRATION

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2024-01477

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2001	Second Amended Docket Control Order, Dkt. 59, <i>Truesight Commc'ns LLC v. Samsung Elecs. Co.</i> , Case No. 2:23-cv-00643-JRG (E.D. Tex. Jan. 8, 2025)
2002	Defendants' Amended Invalidity Contentions and P.R. 3-3 and 3-4 Disclosures, dated December 17, 2024 in <i>Truesight Commc'ns LLC v. Samsung Elecs. Co.</i> , Case No. 2:23-cv-00643-JRG (E.D. Tex.)

I. INTRODUCTION

On September 27, 2024, Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (“Petitioner”) submitted a Petition (Paper 3, “Petition” or “Pet.”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 8,898,803 (Ex. 1001, the “’803 Patent”), challenging Claims 1-20 (the “Challenged Claims”). The Petition asserts that Claims 1-14 are rendered obvious over various combinations of three or more references. The Board should deny the Petition for at least the reasons described briefly below.

Petitioner fails in each of the eight grounds to sufficiently show that any of the references or the combinations thereof disclose the limitations (i) “responsive to the flash memory media device being connected to the playback device,” (ii) “the transferred user service information from the connected flash memory media device is used to access at least one of the one or more account based digital streaming services,” and (iii) “stream a higher quality version of the content to the connected playback device for playback, wherein the higher quality version of the content is a high definition version of standard definition content transferred from the kiosk to the flash memory media device,” as required by one or more of the Challenged Claims.

First, the Petition is deficient because it entirely ignores the limitation “responsive to the flash memory media device being connected to the playback

device.” Petitioner’s combinations rely only on *Kirkland* for Grounds 1-4 and only on *Olaiya* for Grounds 5-8. Petitioner’s arguments for this limitation span less than a page. In that skeletal section, Petitioner does not identify any evidence to support the “responsive to” element of this limitation, instead the Petitioner argues that “responsive to” is not a claim element at all. Petitioner’s legal argument is at odds with Federal Circuit precedent and the Petition should be denied.

Second, the Petition is deficient because it does not set forth a sufficient teaching that “the transferred user service information from the connected flash memory media device is used to access at least one of the one or more account based digital streaming services.” Petitioner relies on *Kirkland*; however, *Kirkland* is not an account-based digital streaming service, it is a ***personal*** media server. Pet. at 36; Ex. 1005 [0075]. Petitioner also relies on *Olaiya*; however, *Olaiya* is not an account-based digital streaming service, it is a Peer-to-Peer (P2P) service, where, unlike account-based systems, data is downloaded from nodes under “loose autonomous control.” Ex. 1006 [0002]. Petitioner also relies on *Raja* in part for this limitation, however, Petitioner does not explain how *Raja* teaches or discloses that the transferred user information is used to access an “account-based digital streaming service”—the phrase “account-based digital streaming service” does not appear in the corresponding portion of the Petition. Pet. at 71-73.

Third, the Petition is deficient because it does not set forth a sufficient teaching of a device to “stream a higher quality version of the content to the connected playback device for playback, wherein the higher quality version of the content is a high definition version of standard definition content transferred from the kiosk to the flash memory media device.” None of the references teach or disclose this limitation. Petitioner’s alternative “motivation to engineer” the *Kirkland-Olaiya-Kang* combination is a single sentence with no support and is insufficient to support an obviousness finding.

The Board should exercise its discretion to deny the Petition under 35 U.S.C. § 314(a) for at least the following reasons: (i) a parallel District Court Litigation (defined below) exists between the same parties or real-parties-in-interest; (ii) the District Court Litigation involves the same subject patent (the ’803 Patent) with substantially the same claims; (iii) the District Court’s trial will be *over six months before* the projected statutory deadline; (iv) the parties have heavily invested in the District Court Litigation and a trial date is set for October 6, 2025; and (v) there is no stay of the parallel District Court Litigation.

II. CLAIM CONSTRUCTION

For the purposes of this Preliminary Response, Patent Owner does not adopt any meaning other than the plain and ordinary meaning.

III. LEVEL OF ORDINARY SKILL IN THE ART

For the purposes of this Preliminary Response only, Patent Owner utilizes Petitioner's proposed level of skill in the art: "a B.S. in electrical engineering, computer science, or a similar field and two years of experience in the design of digital content distribution systems, including reception appliances." Pet. at 21 (citations omitted).

IV. PETITIONER HAS NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF SUCCESS FOR THE GROUNDS ADVANCED IN THE PETITION, AND THE PETITION SHOULD BE DENIED

The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) so-called secondary considerations where in evidence. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983).

The Board has held that a failure to identify the differences between the claimed subject matter and the prior art is fatal to an obviousness challenge. *See*,

Apple, Inc. v. Contentguard Holdings, Inc., IPR2015-00355, Decision Denying Institution of *Inter Partes* Review, Paper 9 at 9-10 (P.T.A.B. June 26, 2015) (denying institution for failure to identify the differences between the claimed subject matter and the prior art).

In arriving at an obviousness determination, the Board must sufficiently explain and support the conclusions that the prior art references disclose all the elements recited in the Challenged Claims and a relevant, skilled artisan not only could have made, but would have been motivated to combine all the prior art references in the way the patent claims and reasonably expected success. *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017). That is, even if all the claim elements are found across a number of references, an obviousness determination must consider whether a person of ordinary skill in the art would have the motivation to combine those references. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *Los Angeles Biomedical Rsch. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.*, 849 F.3d 1049, 1067 (Fed. Cir. 2017) (vacating and remanding an obviousness determination, in part, because the Board did not make factual finding as to whether there was an apparent reason to combine all three prior art references to achieve the claimed invention and whether a person of skill in the art would have had a reasonable expectation of success from

such a combination). This combinability determination, as supported by an articulated motivation to combine, requires a plausible rationale as to why those prior art references would have worked together. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013). Absent some articulated rationale, a “common sense” finding is no different than the conclusory statement “would have been obvious.” *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017). Of additional importance, “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references. . . .” *Innogenetics, N.V. v. Abbott Lab’ys.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008).

To demonstrate inherent obviousness, an inherent limitation must necessarily be present in the combination of references. *See Pers. Web Techs., LLC v. Apple, Inc.*, 917 F.3d 1376 (Fed. Cir. 2019); *LBT IP I LLC v. Apple Inc.*, No. 2022-1613, 2023 WL 3914920, at *3 (Fed. Cir. June 9, 2023). It is not enough to merely show that it is likely to be present. *Id.*

A. Grounds 1-8: The Claims Are Not Rendered Obvious by Any Combination Because the Petition Fails to Disclose the “Responsive to” Limitations

1. The Petition Does Not Show that Kirkland-Olaiya-Kang Alone or in Combination, Discloses “responsive to the flash memory media device being connected to the playback device,” as Required by Claim Element [1d] or any of the “responsive to” Limitations of Claim 11

First, regarding Ground 1 (and Grounds 2-4, which rely on Ground 1), the Petition does not specify any teaching or disclosure from any of the prior art references regarding the “responsive to” limitations, and more specifically the “responsive to the flash memory device being connected to the playback device” limitation, as required by Claim element 1d.

The evidence set forth in the Petition for this limitation spans a single page. Petitioner states that “Kirkland discloses that in response to inserting its physical media (i.e., its flash memory media device) into client device, an authentication check is performed.” Pet. at 34. However, Petitioner does not explain how the “authentication check” maps to any of the claim limitations, let alone the claim limitations that follow the “responsive to” limitation. Merely stating that an “authentication process begins” is insufficient to support a teaching or disclosure of the “responsive to” limitation.

Petitioner seemingly acknowledges its shortcoming and relies on two cases for the proposition that “responsive to” limitations are generally not “read into” by the Board: *Magic Leap, Inc. v. Percept Techs. Inc.*, IPR2023-00494, Paper 21 at 16-19 (P.T.A.B. Jul. 23, 2024); *Google LLC v. Jenam Tech, LLC*, IPR2021-00630, Paper 38 at 6-11 (P.T.A.B. Sep. 16, 2022). However, neither of these cases stand for the proposition that the “responsive to” limitation should be disregarded. Regarding *Magic Leap*, the Board did not disregard the “responsive” limitation, rather the Board found that the examples in the specification were non-limiting. *Magic Leap, Inc. v. Percept Techs. Inc.*, IPR2023-00494, Paper 21 at 17-18 (P.T.A.B. July 23, 2024). In *Google LLC v. Jenam Tech, LLC*, the Patent Owner argued for inclusion of the term “directly,” however, the specification disclosed intervening events and the Board did not hold that “responsive to” meant directly. *Google LLC v. Jenam Tech., LLC*, IPR2021-00630, Paper 38 at 8 (P.T.A.B. Sept. 16, 2022). Petitioner fails to analyze Federal Circuit precedent, which generally holds that “in response to” connotes that a second event occurs in reaction to a first event. *American Calcar, Inc. v. Am. Honda Motor Co., Inc.*, 651 F.3d 1318, 1340 (Fed. Cir. 2011). In affirming the district court, the Federal Circuit stated that “in response to” and “when” to “require a cause-and-effect relationship.” As per the case

law and the claim language itself, “responsive to” cannot be disregarded, and Petitioner’s incorrect analysis should result in denial of the Petition.

Regarding Claim 11, there are six “responsive to” limitations, 11d-11i. Petitioner entirely ignores these limitations and does not set forth any basis for how these “responsive to” limitations are met. The word “response” does not even appear in the Petition in any section related to Claim 11.

Accordingly, because Petitioner provides no basis whatsoever for any relationship between what follows the “responsive to” limitation and its mappings to the prior art, Grounds 1-4 fail and the Petition should be denied.

2. The Petition Does Not Show that Olaiya-Raja-Hasegawa Alone or in Combination, Discloses “responsive to the flash memory media device being connected to the playback device,” as Required by Claim Element [1d] or any of the “responsive to” Limitations of Claim 11

Petitioner’s arguments regarding limitation 1d for the *Olaiya-Raja-Hasegawa* combination provide even less support than for other combinations. The support for limitation 1d includes a reference to section VIII.E.1.b and a statement that “POSITAs would have understood that to playback content either via streaming or via the removable memory, the removable memory must be connected to a playback device.” Pet. at 71. However, this section does not connect the “playback” to any condition and the Petition lacks any basis for the “responsive to” limitation.

Similarly, regarding Claim 11, there are six “responsive to” limitations, 11d-11i. Petitioner entirely ignores these limitations and does not set forth any basis for how these “responsive to” limitations are met. The word “response” does not even appear in the Petition in any section related to Claim 11.

Accordingly, because Petitioner provides no basis whatsoever for any relationship between what follows the “responsive to” limitation and its mappings to the prior art, Grounds 5-8 fail and the Petition should be denied.

B. Grounds 1-8: The Claims Are Not Rendered Obvious by Any Combination Because the Petition Fails to Disclose the “transferred user service information from the connected flash memory media device is used to access at least one of the one or more account based digital streaming services” Limitations

1. The Petition Does Not Show that Kirkland-Olaiya-Kang Alone or in Combination, Discloses “transferred user service information from the connected flash memory media device is used to access at least one of the one or more account based digital streaming services,” as Required by Claim Element [1d] or any of the Analogous Limitations of Claim 11

Regarding Ground 1 (and Grounds 2-4, which rely on Ground 1) the Petition does not set forth any “account-based digital streaming service.” Petitioner relies on *Kirkland*; however, *Kirkland* does not teach or disclose an account-based digital streaming service. Instead, *Kirkland* discloses a personal media server, which is different from the claim limitation in at least the following respects: (i) *Kirkland*’s

system is “personal” and therefore is not account-based, and (ii) *Kirkland*’s system is not a service. Petitioner’s arguments do not sufficiently explain how one of skill in the art would arrive at the claimed account-based digital streaming service from these teachings and therefore Ground 1 fails.

The Petition acknowledges that *Kirkland* discloses a method for streaming “from a user’s own media library to a user’s receiving device.” Pet. at 10. *Kirkland* describes a “personal media library” via a “personal on-demand media streaming server that they own.” Ex. 1005 [0020]. This “personal” model is contrary to the Challenged Claims, which require an “account-based” model. For example, the ’803 Patent describes “account information with streaming service providers 150” and further specifies that “users may have multiple accounts with multiple different streaming service providers 150.” ’803 Patent, 3:27-32. Petitioner also states that *Kirkland* discloses a “digital certificate or other authentication data.” Pet. at 33. Petitioner further states that “POSITAs would have further recognized that *Kirkland*’s streaming may limit access to ‘the owner, or select individuals that have been granted explicit permission by the owner.’” *Id.* at 36. However, a disclosure of digital certificates and login information does not make *Kirkland* “account-based.” Instead, *Kirkland*’s disclosure of a “personal” storage “server,” would lead one of skill in the art to understand that the storage solution is related to the owner’s

personal media library and not “account-based” or a “service” to be used by others.

Petitioner’s conclusory arguments amount to impermissible hindsight and cannot support a finding of obviousness. Petitioner does not rely on any modifications of *Kirkland* or other references to arrive at the claims, and instead relies only on these teachings alone. With no additional argument or evidence, the Petition must fail.

Next, regarding Ground 5 (and Grounds 6-8, which rely on Ground 5), Petitioner relies on *Olaiya*, and *Raja* for the “account based” limitation; however, neither of these references teach nor disclose an account-based digital streaming service as claimed. First, regarding *Olaiya*, *Olaiya* discloses a Peer-to-Peer (“P2P”) system. *Olaiya* does not disclose accounts, logins, usernames, credentials, or any kind of security whatsoever. Instead, *Olaiya* refers to “a P2P scheme similar to that used by BitTorrent,” which is not an “account-based” streaming service. Next, regarding *Raja*, Petitioner relies on a disclosure that “user credentials” must be verified by a server before access is provided. Pet. at 72. However, a disclosure of a security login does not equate to a disclosure of an “account-based” system, let alone an account-based streaming service. Furthermore, even if *Raja*’s disclosure was sufficient to teach an “account,” the Petition does not explain how *Raja*’s teachings could allow access to one or more *services*, as disclosed in the ’803 Patent.

Petitioner’s bare-bones assertions amount to nothing more than impermissible hindsight—the Petition itself does not even use the phrase “account-based digital streaming service” when discussing *Raja* and combinations based on *Raja*. Pet. at 71-73. Without any additional evidence, the Petition must fail.

Accordingly, because Petitioner has no evidence that the prior art alone or in combination teaches or discloses the limitation “account-based digital streaming service,” Grounds 1-8 fail and the Petition should be denied.

C. Grounds 1-8: The Claims Are Not Rendered Obvious by Any Combination Because the Petition Fails to Disclose the “stream a higher quality version of the content to the connected playback device for playback, wherein the higher quality version of the content is a high definition version of standard definition content transferred from the kiosk to the flash memory device” Limitations

The Petition fails to explain how the prior art, alone or in combination, teaches or discloses the “stream a higher quality version of the content to the connected playback device for playback, wherein the higher quality version of the content is a high definition version of standard definition content transferred from the kiosk to the flash memory device.”

Regarding Grounds 1-4, Petitioner relies on *Hasegawa* to teach “higher quality video would have included HD.” While this statement is conclusory, unsupported, and while the combination is based entirely on hindsight, the Petition fails for a more fundamental reason—Petitioner does not explain how the higher

definition version is *of the standard definition content* as required by the claims. Petitioner does not rely on *Hasegawa* for the disclosure of a standard definition, instead Petitioner relies on *Olaiya*. For example, *Olaiya* does not disclose standard definition content—*Olaiya* discloses a **slideshow with a voiceover**:

For example, if the illustration media content item is to be a slideshow with accompanying audio content, the producer or production company may select desired frames from the original media content to be used as still pictures for the slideshow and create a narrative or summary to accompany the slideshow.

Ex. 1006 [0036]. Thus, even if one of skill in the art were to make the combination as set forth in the Petition, one would not arrive at the claim limitations because the higher resolution video of *Hasegawa* would not be “of the standard definition content.”

In view of these shortcomings, Petitioner resorts to a new legal standard—the “*motivation to engineer*.” Pet. at 43 (emphasis added). Indeed, a POSITA would not have been able to make a combination without undue experimentation; rather, one of skill in the art would have had to *engineer* an entirely new system in order to arrive at the claims. Petitioner’s own rationale therefore necessitates denial for impermissible hindsight.

Regarding Grounds 5-8, Petitioner merely states “See Section VIII.A.1.g.” For the same reasons set forth above, Grounds 5-8 also fail, and the Petition should be denied in its entirety.

Petitioner’s alternative “motivation to engineer” the *Kirkland-Olaiya-Kang* combination in a single sentence with no support, is insufficient to support an obviousness finding.

V. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(a).

Based on Petitioner’s reasons regarding § 314(a), the Board should exercise its discretion to deny this Petition.

The circumstances of the parallel District Court Litigation, *Truesight Commc’ns, LLC v. Samsung Elecs. Co.*, No. 2:23-cv-00643-JRG-RSP (E.D. Tex.) 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, the Petitioner are the Defendants in the parallel proceeding. *See infra* Section VII.A. Second, the asserted claims in the District Court Litigation are all at issue in the Petition. *See infra* Section VII.B. Third, trial in the District Court Litigation is set for October 6, 2025, more than six months prior to the projected statutory deadline for a Final Written Decision of this Petition on April 23, 2026. *See infra* Section VII.C. 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. *See infra* Section VII.D. Fifth, while Defendants have moved for a stay of the District Court Litigation, it is likely that the Court will deny the request for a stay. *See infra* Section VII.E. Finally, no other factors favor institution. *See infra* Section VII.F.

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 the Same Parties

As Petitioner notes, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the '803 Patent). Pet. at 89. Petitioner is a party to the District Court Litigation captioned as *Truesight Commc'ns, LLC v. Samsung Elecs. Co.*, No. 2:23-cv-00643-JRG-RSP (E.D. Tex.). 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 '803 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).

Petitioner relies on its *Sotera* stipulation (Ex. 1016) in arguing that discretionary denial is not warranted. However, Petitioner's *Sotera* stipulation is insufficient, because it states that “if the PTAB either declines institution or later

vacates institution of this IPR, Samsung reserves the right to pursue in this litigation any ground that was raised or reasonably could have been raised in the IPR” but based on Petitioner’s positions in its stipulation, may only apply to “those grounds to be addressed at the PTAB.” Ex. 1016, *Sotera* Stipulation. Therefore, Petitioner’s stipulation is not necessarily as expansive as the stipulation discussed in *Sotera Wireless Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13 (P.T.A.B. Dec. 1, 2020), because Petitioner states that it relinquishes grounds only addressed by the PTAB. As such, Petitioner does not qualify for the treatment described in the Interim Procedure for *Sotera* stipulations. *See Samsung Elecs. Co. v. Cal. Inst. Of Tech.*, IPR2023-00130, Paper 10 (P.T.A.B. May 4, 2023).

Moreover, Petitioner’s *Sotera* stipulation is insufficient because there will still be issues related to conception and reduction to practice that will need to be addressed by the Board and the District Court. Specifically, one issue is whether the inventor had a prior conception and reduction to practice of the invention of the ’803 Patent, and there is at least one reference that is common to all grounds at issue in the Petition that is dated less than a year prior to the filing date of the ’803 Patent. The assignee on the face of ’803 Patent (i.e., Media IP, LLC) was working on this technology prior to the filing date of the ’803 Patent, and accordingly, both the Board and the District Court will have to address the conception and reduction to practice

issues regardless of whether the Petition is Instituted. Therefore, there are overlapping issues related to validity as the same issues of validity will be litigated in both forums.

Lastly, the Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation was issued under the prior administration, which is expected to be replaced “with rules after it has completed formal rulemaking.” *See*

https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

Accordingly, this factor 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 parties’ trial is scheduled for October 6, 2025. Ex. 2001 (Second Amended Docket Control Order, Dkt. 59, *Truesight Commc’ns, LLC v. Samsung Elecs. Co.*, No. 2:23-cv-00643-JRG-RSP (E.D. Tex. January 8, 2025)). 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 April 23, 2026.¹ As the District Court’s trial will be *more than six 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

¹ The statutory deadline for institution is April 23, 2025, “three months after receiving a preliminary response to the petition under section 313.” *See* 35 U.S.C. § 314(b)(1). If instituted, the statutory deadline for a Final Written Decision is April 23, 2026, “not later than 1 year after the date on which the Director notices the institution of a review.”

(“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.”).

Petitioner does not contest that the proximity of the trial favors denial of institution, only that because it submitted a *Sotera* stipulation, no discretionary denial is warranted. 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, the Court has already entered three Docket Control Orders (Dkts. 31, 34, 59), a Discovery Order (Dkt. 36), a Protective Order (Dkt. 38), and an E-Discovery Order (Dkt. 46). Discovery is also well under way. The parties have already exchanged infringement and supplemental infringement contentions pursuant to P.R. 3-1 and invalidity contentions pursuant to P.R. 3-3, and claim construction proceedings are underway. Ex. 2001. A trial date is also set for October 6, 2025, which is less than nine months away. *Id.* Thus, the parties’ and Court’s substantial investment in this proceeding 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 and Petitioners have only filed a motion to stay on January 8, 2025. *See* Dkt. 60, *Truesight Commc’ns*,

LLC v. Samsung Elecs. Co., No. 2:23-cv-00643-JRG-RSP (E.D. Tex. January 8, 2025). Even if the Petition were instituted, there are other petitions filed by Petitioner which have not yet been instituted, and prejudice, tactical disadvantage to Patent Owner, 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 (on April 23, 2025) is not until after the related District Court Litigation claim construction hearing will be completed (on April 2, 2025). 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 only cover 5 of the 20 references relied on by Petitioners in the District Court and only 1 out of at least **115** combinations of obviousness that Petitioner has raised in the District Court Litigation, and do not include Petitioner’s challenges under § 101, § 102, or § 112. *See generally* Ex. 2002, at 15-23, 228-355. *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

Petitioner does not present a strong case on the merits, further supporting denial of institution. *See supra* Section VI. Petitioner also does not identify any other factors which weigh against discretionary denial. Pet. at 89.

Thus, when viewing the factors together, the Petition should be denied in the Director's discretion under 35 U.S.C. § 314(a).

VI. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition in its entirety.

Respectfully submitted,

Dated: January 23, 2025

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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 5,014 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.

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CERTIFICATE OF SERVICE

A copy of the foregoing Patent Owner's Preliminary Response and Exhibits
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