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

Case IPR2024-01477

U.S. Patent No. 8,898,803

Petitioners' Supplemental Briefing

PETITIONERS' EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent 8,898,803 ("*'803Pat*")
1002	Declaration of Anthony Wechselberger
1003	Curriculum Vitae of Anthony Wechselberger
1004	File History of U.S. Patent 8,898,803 (Serial No. 13/004,806) ("*'803FH*")
1005	US Patent Publication No. 2008/0263634 ("*Kirkland*")
1006	US Patent Publication No. 2009/0083412 ("*Olaiya*")
1007	US Patent Publication No. 2009/0049464 ("*Kang*")
1008	Japanese Patent Publication No. 2009048715A ("*Hasegawa*") (original and certified translation)
1009	US Patent Publication No. 2009/0187654 ("*Raja*")
1010	US Patent Publication No. 2009/0117846 ("*Mavrakakis*")
1011	US Patent Publication No. 2010/0005492 ("*Takano*")
1012	US Patent Publication No. 2007/0044133 ("*Hodecker*")
1013	Selections from Patent Owner's Plaintiff's Disclosure of Asserted Claims and Infringement Contentions, served in *Truesight Communications LLC v. Samsung Electronics Ltd.*, Case No. 2:23-cv-00643-JRG (E.D. Tex.)
1014	US Patent Publication 2009/0288138 ("*Kalofonos*")
1015	Feldman, *Overcoming Free-Riding Behavior in Peer-to-Peer Systems*, ACM SIGecom Exchanges, Vol. 5, No. 4, July 2005, Pages 41–50.

Exhibit No.	DESCRIPTION
1016	September 27, 2024 letter from Ryan Nishimoto to Alfred Fabricant
1017	Plaintiff's Disclosure Of Asserted Claims And Infringement Contentions, *Truesight Communications LLC v. Samsung Electronics Co. et al.*, No. 2:23-cv-00643 (E.D. Tex. May 30, 2024)
1018	Defendants Samsung Electronics Co., Ltd.'s And Samsung Electronics America, Inc.'s Motion To Stay Proceedings Pending *Inter Partes* Review, *Truesight Communications LLC v. Samsung Electronics Co. et al.*, No. 2:23-cv-00643 (E.D. Tex. May 30, 2024)

As authorized by the Board, Petitioners submit this supplemental brief addressing what, if any, effect recission of the Interim Procedure For Discretionary Denials should have on the Board's exercise of discretion in this proceeding. Because Petitioners provide a *Sotera* stipulation, the factors set forth in *Apple, Inc. v. Fintiv, Inc.,* IPR2020-00019, Paper 11 (PTAB. Mar. 20, 2020) (precedential), strongly weigh against the Board exercising its discretion to deny institution.

I. The *Fintiv* Factors Collectively Weigh Against Exercising Discretion

A. Because Of Petitioners' *Sotera* Stipulation, Factor 4 Weighs Strongly Against Exercising Discretion

Petitioners have stipulated that if the Board "institutes this IPR petition on the grounds presented [], then [Petitioners] will not pursue in the [*Truesight v. Samsung* district court] litigation any grounds that were raised or reasonably could have been raised in this IPR." *See* EX1016. This is substantively identical to the stipulation the Board considered in *Sotera Wireless, Inc. v. Masimo Corp.,* which stated that petitioner "will not pursue in this case the specific grounds … [in] the instituted *inter parties* [sic] review petition, *or on any other ground … that was raised or could have been reasonably raised in an IPR (i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patents or printed publications).*" IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020) (precedential as to § II.A) (emphasis in original). Because Petitioners have made a *Sotera* stipulation (EX1016), Factor

4 weighs strongly against discretionary denial. *Sotera,* Paper 12 at 19. Indeed, even before the Interim Procedure was put in place, the Board regularly did not exercise its discretion to deny institution when a *Sotera* stipulation had been made. This was true even when the trial date was well-before the FWD deadline. *See* Section I.C.

The POPR asserts that 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.'" *See* POPR, 17-18. PO is wrong about the scope of Petitioners' stipulation, as it explicitly applies to any ground that was raised or reasonably could have been raised in the IPR, not just to those grounds addressed at the PTAB. Moreover, the only way Petitioners' stipulation would not apply is if trial is not instituted or if the Board vacates institution. PO does not explain how this negates Petitioners' stipulation. Nor could it. Even in *Sotera*, the plain language of the stipulation was conditioned on institution. *Sotera,* Paper 12 at 18-19. Moreover, the Board has held that conditioning a *Sotera* stipulation on institution is proper. *Microsoft Corp. v. D3D Technologies, Inc.*, IPR2021-00703, Paper 10 at 14 (PTAB Oct. 12, 2021).

The POPR also argues that there is potential duplication since conception and reduction to practice will purportedly need to be addressed by both the Board and

the district court. POPR at 18-19. Yet, PO provides no evidence to suggest this would be the case.

In *Sotera*, the Board found a stipulation like the one Petitioners provide here mitigated "any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions" and "ensures that an [IPR] is a 'true alternative' to the district court proceeding." *Sotera*, Paper 12 at 19. Thus, *Sotera* found that Factor 4 "weighs strongly in favor of not exercising discretion to deny institution under 35 U.S.C. § 314(a)." *Id*. The situation here is no different.

B. Investment in the Parallel Proceeding and Petitioners' Diligence (Factor 3)

Petitioners diligently filed this IPR four months after PO served infringement contentions asserting all claims. *See* EX1017. This weighs against denying institution. *Fintiv*, 11 (finding it "reasonable" to file petitions after "learn[ing] which claims are being asserted"); *CoolIT Sys., Inc. v. Asetek Danmark A/S*, IPR2021-01195, Paper 10 at 11-12 (P.T.A.B. Dec. 28, 2021) ("preparing a petition less than five months after asserted claims are identified was a diligent approach").

Regarding investment in the parallel proceeding, a *Markman* hearing is scheduled to take place prior to the institution date. However, much work would still remain as of the expected institution date, including most fact discovery, all

expert discovery, as well as dispositive motions. EX2002. No depositions have been taken, and no substantive orders have issued. Thus, Factor 3 weighs against discretionary denial. *Fintiv* at 9-10; *but see Sand Revolution II, LLC v. Cont'l Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 10-11 (PTAB Jun. 16, 2020) (informative) (finding factor 3 "weighs only marginally, if at all" in favor of discretionary denial when the district court had issued a *Markman* order prior to the institution decision deadline).

C. The Trial Date (Factor 2)

Trial is currently scheduled for October 6, 2025. EX2002. If instituted, the final written decision (FWD) will issue by April 23, 2026, six months after trial. Regardless, Petitioners' *Sotera* stipulation obviates concerns regarding duplicative proceedings. *See* §I.A above. Indeed, prior to issuance of the rescinded Interim Procedure, the Board regularly instituted proceedings with similar (and even larger) gaps in proceedings where Petitioners provided *Sotera* stipulations. *E.g.*, *Medtronic CoreValve LLC v. Colibri Heart Valve LLC*, IPR2020-01454, Paper 11 (PTAB Mar. 10, 2021) (FWD scheduled six-months after trial); *Resi Media LLC v. Boxcast Inc.*, IPR2022-00066, Paper 19 (PTAB Apr. 26, 2022) (FWD scheduled eight-months after trial); *Samsung Electronics Co., Ltd. v. RightQuestion, LLC*, IPR2022-00244, Paper 17 (PTAB Jun. 10, 2022) (FWD scheduled nine-months after trial); *Tianma Microelectronics Co. Ltd. v. Japan Display Inc.*, IPR2021-01028, Paper 14 at 9

(PTAB Dec. 14, 2021) (FWD scheduled ten-months after trial).

D. The Likelihood of a Stay (Factor 1), the Parties (Factor 5), and Other Circumstances (Factor 6)

On January 8, 2025, Petitioners moved to stay the District Court litigation, and the motion remains pending. EX1018. Thus, Factor 1 is neutral. The parties are the same in both the District Court and the IPR. Thus, Factor 5 weighs in favor of discretionary denial.

Factor 6 weighs against discretionary denial because the petition's grounds are strong and show more than a reasonable likelihood of unpatentability. Indeed, in arguing against institution, PO offers only unsupported attorney argument to rebut the substance of Petitioners' unpatentability arguments. For example, PO argues that Petitioners "[do] not specify any teaching or any disclosure" regarding the "responsive to the flash memory device being connected to the playback device" limitation. POPR at 7. But after saying this, PO's attorneys contradict themselves by disputing Petitioners' evidence. *Id*. Similarly, PO alleges the Petition ignored limitations [11d]-[11i] (POPR at 9), yet Petitioners' arguments regarding these elements span over five pages. PO's other criticisms are similarly baseless.

II. Conclusion

Petitioners respectfully submit that the Board should not exercise its discretion to deny institution of this petition.

Date: March 12, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that on March 12, 2025, I caused a true and correct copy of the foregoing Petitioners' Supplemental Briefing and supporting exhibits to be served via electronic mail to the counsel and email below:

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