

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

TRUESIGHT COMMUNICATIONS LLC,

Patent Owner.

IPR2025-00024
U.S. Patent No. 9,595,300

**PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

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LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	Third Amended Docket Control Order, Dkt. 67, <i>Truesight Commc'ns LLC v. Samsung Elecs. Co.</i> , Case No. 2:23-cv-00643-JRG (E.D. Tex. Jan. 24, 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.)
2003	Order Denying Motion to Stay Proceedings Pending <i>Inter Partes</i> Review, Dkt. 85, <i>Truesight Commc'ns LLC v. Samsung Elecs. Co.</i> , No. 2:23-cv-00643-JRG (E.D. Tex. Mar. 25, 2025)

I. INTRODUCTION

Pursuant to the Director’s March 26, 2025 Memorandum Regarding Interim Processes for PTAB Workload Management, Patent Owner files this Request for Discretionary Denial of Institution.

On December 17, 2024, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Google LLC (collectively, “Petitioner”) submitted a Petition (Paper 1, “Petition” or “Pet.”) requesting *inter partes* review (“IPR”) of U.S. Patent No. 9,595,300 (Ex. 1001, the “’300 Patent”), challenging Claims 1-20 (the “Challenged Claims”).

The Petition identifies co-pending district court litigation *Truesight Commc’ns, LLC v. Samsung Elecs. Co.*, No. 2:23-cv-00643-JRG-RSP (E.D. Tex.) (“District Court Litigation”) with a trial date set for October 6, 2025. With Patent Owner’s Preliminary Response due April 14, 2025, institution of any grounds will result in the issuance of a Final Written Decision (“FWD”) by July 14, 2026.

The Director should exercise discretion to deny the Petition under 35 U.S.C. § 314(a) for at least the following reasons: (i) the parallel District Court Litigation exists between the same parties or real-parties-in-interest; (ii) the District Court Litigation involves the same subject patent (the ’300 Patent) with substantially the same claims; (iii) the District Court’s trial will be *over nine months before* the projected statutory deadline for FWD; (iv) the parties have heavily invested in the

District Court Litigation with the deadline for substantial completion of discovery having passed on February 19, 2025, the completion of all claim construction proceedings with a *Markman* hearing scheduled for April 2, 2025, and the completion of fact and expert discovery and the filing of dispositive motions all due before the July 14, 2025 deadline for an institution decision; and (v) there is no stay of the parallel District Court Litigation with the issuance of a March 25, 2025 District Court Order denying Petitioners' motion for a stay.

For the reasons set forth herein, the Director should exercise discretion to deny the Petition.

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

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 II.A. Second, the District Court Litigation involves substantially the same claims at issue in the Petition. *See infra* Section II.B. Third, trial in the District Court Litigation is set for October 6, 2025, more than nine months prior to the projected statutory deadline for a Final Written Decision of this Petition on July 14, 2026. *See infra* Section II.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 II.D. Fifth, Defendants’ motion to stay the District Court Litigation has been denied. Even if Defendants’ renew their motion at a later date, Defendants did not petition for *inter partes* review of each and every claim asserted in the District Court Litigation, thus eliminating any likelihood of obtaining a stay in the district court. *See infra* Section II.E. Finally, no other factors favor

institution. *See infra* Section II.F.

Accordingly, the Director should exercise 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 '300 Patent). Pet. at 88-89. 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.). The District Court Litigation involves causes of action asserting the '300 Patent against Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.'s products which include Google LLC's applications, such as YouTube and Family Link, installed on Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.'s products. Exhibit 1009, Pet. at 90. Petitioner concedes that Google LLC is a real party-in-interest and that Petitioner filed the Petition over six months after

service of Patent Owner's infringement contentions on Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. Exhibit 1010.

Accordingly, this factor weighs strongly in favor of discretionary denial.

B. The District Court Litigation Involves Substantially the Same Claims

There is complete overlap between the claims and grounds at issue in this Petition and the District Court Litigation because the Petition challenges all claims asserted in the District Court Litigation under the same grounds. Ex. 2002. "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). The Petition does not attempt to propose any stipulation (under Sotera or otherwise) regarding the overlapping grounds. The Director should reject as untimely and prejudicial any belated request for authorization to propose a stipulation.

Accordingly, this factor weighs strongly 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 weighs strongly in favor of discretionary denial.

The parties' trial is scheduled for October 6, 2025. Ex. 2001 (Third Amended Docket Control Order, Dkt. 67, *Truesight Commc'ns, LLC v. Samsung Elecs. Co.*, No. 2:23-cv-00643-JRG-RSP (E.D. Tex. Jan. 24, 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 July 14, 2026.¹ As the District Court's trial will be ***more than nine 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

¹ Patent Owner will file a timely preliminary response on April 14, 2025. The statutory deadline for institution is July 14, 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 July 14, 2026, "not later than 1 year after the date on which the Director notices the institution of a review."

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 (“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.”). Even in cases where a petitioner attempts to proffer a stipulation under *Sotera* (which is not the case here and which the Director should not authorize on the basis of untimeliness), the Board has routinely denied institution under *Fintiv*. See, e.g., *Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00329, Paper 13 at 7-15 (P.T.A.B. Jul. 6, 2021) (denying institution while finding *Sotera* applied only when trial date was scheduled to begin around the same time as the deadline for FWD); *F5 Networks, Inc. v. WSOU Invs., LLC*, IPR2022-00239, Paper 12 at 7-8 (P.T.A.B. May 18, 2022) (denied when trial predates FWD by six months); *Google LLC v. EcoFactor, Inc.*, IPR2021-00488, Paper 12 at 11-12 (P.T.A.B. Aug. 11, 2021) (denied when trial predates FWD by six months); *Cisco Sys., Inc. v. Oyster Optics, LLC*, IPR2021-00238, Paper 10 at 11-13 (P.T.A.B. Jun. 1, 2021) (denied when trial predates FWD

by seven months). The nine-month differential between the October 2025 trial date and the July 2026 FWD by far justifies discretionary denial.

Accordingly, this factor weighs strongly in favor of discretionary denial.

D. Significant Investment and Petitioner's Delay in Filing the Petition

The parties' investment in the parallel proceeding weighs strongly in favor of discretionary denial. In the District Court Litigation, the parties have already exchanged preliminary and amended infringement and invalidity contentions. Ex. 2001. The deadline for substantial completion of document productions passed on February 19, 2025. *Id.* The parties have completed claim construction proceedings and will participate in a Markman hearing set for April 2, 2025. *Id.*

Before the July 14, 2025 statutory deadline for an institution decision, the parties will have completed fact and expert discovery and the parties will have filed their dispositive motions in the District Court Litigation. *Id.* A trial date is set for October 6, 2025, which is approximately nine months away. *Id.* Accordingly, the parties' and Court's substantial investment in this proceeding weighs strongly in favor of denial of institution.

E. No Stay of the Parallel District Court Litigation

There is no stay of the parallel District Court Litigation. On March 25, 2025, the District Court denied Petitioner's motion to stay the District Court Litigation.

Ex. 2003. Even if Petitioner renews their motion at a later date, the Eastern District of Texas routinely denies requests to stay pending IPRs before institution on all asserted claims of all asserted patents. *See Force Mos Tech., Co. v. ASUSTek Comput., Inc.*, No. 2:22-CV-00460-JRG, 2024 WL 1586266, at *4 (E.D. Tex. Apr. 11, 2024) (citation omitted).

The circumstances of the overall dispute between the parties are even more fatal to any future stay request, as Petitioner has not filed IPR grounds on every asserted claim across all asserted patents. *See Samsung Elecs. Co. v. Truesight Commc'ns LLC*, IPR2025-00123, Paper 7 at 25 (P.T.A.B. Feb 25, 2025) (“At least claim 11 of the ’749 Patent is currently asserted in the District Court Litigation and is not challenged in the Petition.”).

Accordingly, the lack of a stay and future unlikelihood of a stay weighs strongly in favor of denial of institution.

F. Other Factors Favor Discretionary Denial

Petitioner does not identify any other factors which weigh against discretionary denial. Pet. at 88-89. The merits of the Petition are weak and rely extensively on a 122-page expert declaration, which is about one and one-half the length of the grounds sections of the Petition itself, to fill in numerous gaps in the references. In one example, Petitioner and their expert break down Claim 1 into seven parts (1pre and 1a1, 1a2, 1b-1e) requiring extensive reliance on expert

testimony to combine multiple references in various ways for all parts except the preamble. *See, e.g.*, Ex. 1003 at pp. 42-87. Petitioner's extensive reliance on and over-use of expert testimony should weigh in favor of denial.

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

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion to deny institution of the Petition in its entirety.

Respectfully submitted,

Dated: March 28, 2025

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION has 2,009 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 REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION and Exhibits 2001 through 2003 have been served on Petitioner's counsel of record as follows:

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