

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

TRUESIGHT COMMUNICATIONS LLC,

Patent Owner.

Patent No. 9,595,300  
Filing Date: October 18, 2010  
Issue Date: March 14, 2017

Inventors: Todd E. Duffin, Todd R. Malsbary, and Mark E. Phillips  
Title: CONTEXTUAL CHAPTER NAVIGATION

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**PATENT OWNER'S PRELIMINARY RESPONSE**

Case No. IPR2025-00024

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**LIST OF EXHIBITS**

| <b>Exhibit No.</b> | <b>Description of Document</b>                                                                                                                                                                       |
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| 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

On December 17, 2024, Google LLC, Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (collectively, “Petitioner”) submitted a Petition (Paper 1, “Petition” or “Pet.”) to institute *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 asserts that Claims 1-20 are rendered obvious over various combinations of three or more references. The Board should deny the Petition for at least the reasons described below.

Petitioner fails in each of the two grounds to sufficiently show that any of the references or the combinations thereof disclose or render obvious (a) **“read[ing] from a metadata file . . . location on a secure digital card (SD card) of chapter preview images that correspond to the playable content. . .”** of Claim Limitations 1[a], 8[a], and 15[c]; (b) **“the timeline assembled from the chapter titles, the chapter start times, and the location on the secure digital card of chapter preview images that correspond to the playable content stored as part of the metadata. . .”** of Claim Limitations 1[b], 8[b], and 15[d]; and (c) **“wherein a focus identifier marks an image of a chapter corresponding to the current position within the continuous video playback”** of Claim Limitations 1[b], 8[b], and 15[d], as required by the Challenged Claims. In addition to the shortcomings of the prior

art, the Petition is deficient because Petitioner fails to contend any reasonable expectation of success for each of the proposed modifications.

The Board should exercise its 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 held on 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.

## **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 Bachelor's degree or equivalent in electrical engineering, computer science, or a related field, in addition to three years in research, design, or development in video playback systems, user interfaces, or other comparable experience." Pet. at 22 (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. The Petition Fails to Show How the References Teach or Render Obvious “read[ing] from a metadata file . . . location on a secure digital card (SD card) of chapter preview images that correspond to the playable content . . .” of Claim Limitations 1[a], 8[a], and 15[c]**

The Petition fails to show how the prior art references alone or in combination teach or render obvious the claimed features of reading from a metadata file stored with the video chapter titles, chapter start times, and location on a secure digital card (SD card) of chapter preview images that correspond to the playable content as initially configured and stored on the secure digital card, each chapter comprising a segment of content of the video. The Petition lacks sufficient

explanation or proper evidentiary basis to adequately support the allegation that Nishikawa's generic recitation of storing "information concerning images" renders obvious this claim limitation, which recites specific information, *i.e.*, **location** on a secure digital card of chapter preview images, is **read from a metadata file**.

Petitioner maps the claimed metadata file to Nishikawa's meta-data file and alleges that Nishikawa's chapter marks are stored in Nishikawa's meta-data file. Pet. at 24-25 *citing* Nishikawa at [0030]; Pet. at 40. Based on Petitioner's mapping, Nishikawa keeps only chapter marks in the meta-data file. While Petitioner's mapping of Nishikawa's chapter marks to a specific claim element is not explicit, Petitioner states without citation that Nishikawa's chapter mark "denotes the time at which it begins." *Id.* at 39. Thus, Patent Owner assumes Petitioner intends to map the claimed **chapter start times** to Nishikawa's chapter marks.

The Petition does not contend that Nishikawa's meta-data file comprises the **claimed chapter titles** or **location on a secure digital card of chapter preview images**. Petitioner concedes that Nishikawa "does not provide detailed disclosure regarding how or where the DVR system stores the program title information and thumbnail images . . . ." *Id.* at 25. Petitioner also concedes that Nishikawa "does not expressly state that 'a location . . . of' these thumbnail images is 'read[] from a metadata file.'" *Id.* at 40.

Petitioner attempts to cure this deficiency in two distinct ways. First, Petitioner proposes to combine Nishikawa with Angiolillo's purported teaching of storing/retrieving "information concerning the images." *Id.* at 27. But Angiolillo's "information concerning the images" is vague and lacks the specificity of the claimed requirements. Petitioner's combination does not even purport to render obvious the requirement that location on a secure digital card of chapter preview images, is read from a metadata file. Petitioner fails to contend any reasonable expectation of success to combine the references for the purposes of reading from a metadata file location on a secure digital card of chapter preview images. Second, Petitioner lists layers of what appear to be POSITA knowledge arguments without any additional evidentiary support. Petitioner alleges a POSITA would know that (a) thumbnails would be stored in "a location" of the Nishikawa's DVR system; (b) the DVR system could later identify that location for retrieval; and (c) the DVR system would necessarily read the POSITA-based storage location for retrieval from that location. Pet. at 41. These allegations consist of layers of unsupported assumptions and recite mere possibility, and Petitioner does not provide sufficient explanation to bridge the gap between Nishikawa's "instructions for generating [] images" (Pet. at 40) to the claimed requirement that location on a secure digital card of chapter preview images, is read from a metadata file. Petitioner fails to contend any reasonable expectation of success for any of the proposed layers of modification.

Accordingly, Petitioner has failed to show a reasonable likelihood of success as to Claims 1-20, and the Petition should be denied.

**B. The Petition Fails to Show How the References Teach or Render Obvious “. . .the timeline assembled from the chapter titles, the chapter start times, and the location on the secure digital card of chapter preview images that correspond to the playable content stored as part of the metadata. . .” of Claim Limitations 1[b], 8[b], and 15[d]**

The Petition fails to show how the prior art references alone or in combination teach or render obvious the claimed features of **the timeline assembled from the chapter titles, the chapter start times, and the location on the secure digital card of chapter preview images that correspond to the playable content stored as part of the metadata**. The Petition lacks sufficient explanation or proper evidentiary basis to adequately support the allegation that Nishikawa’s progress bar is **assembled from the chapter titles, the chapter start times, and the location on the secure digital card of chapter preview images that correspond to the playable content stored as part of the metadata**.

Petitioner maps the claimed “timeline” to Nishikawa’s progress bar. Pet. at 48 [“‘progress bar’ (615 or 715) (i.e., ‘timeline’)”]. Nishikawa’s progress bar is described in two paragraphs: [0036] concerning the progress bar 615 of FIG. 6 and [0042] concerning the progress bar 715 of FIG. 7.

[0036] Status bar includes a progress bar **615** which is a graphical representation of the cached video content. In one embodiment, the progress bar **615** may be divided into one or more segments **620<sub>1</sub>-620<sub>3</sub>**, where each segment denotes a individual cached program. It should further be appreciated that the program cache may be of a fixed size (e.g., 30 minutes) and/or may be user configurable. In the embodiment of **FIG. 6**, the live cache is a 90 minute cache and may contain any number of programs up to the limit of the cache size.

[0042] The status bar **710** includes a progress bar **715** which is a graphical representation of the stored video content (e.g., a broadcasted program). The status bar **710** is displayed near the bottom of the screen **705** further indicates the beginning of the stored video content as 0:00. The end of the stored video content is denoted by end time **720**.

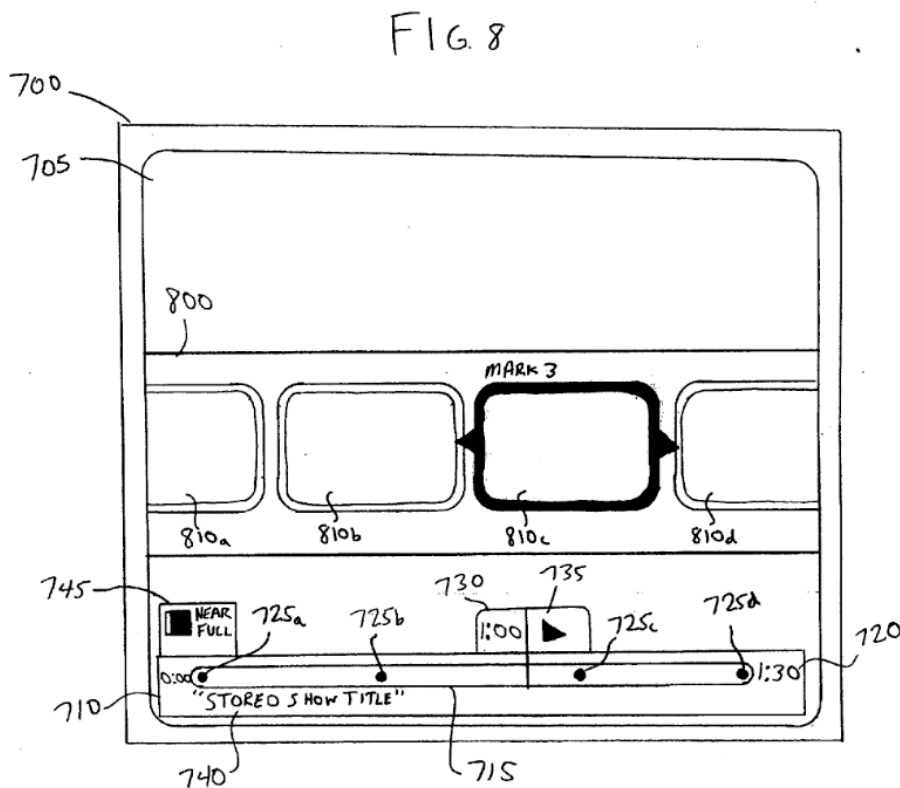
Neither of these paragraphs describe a progress bar that is **assembled** from any **metadata**, much less the **location on the secure digital card of the chapter preview images that correspond to the playable content stored as part of the metadata**. There is simply not enough disclosure to support an allegation that Nishikawa's progress bar is assembled from each of the three types of claimed metadata, including **location on the secure digital card of the chapter preview images that correspond to the playable content stored as part of the metadata**, as required by the claims. To the extent Petitioner attempts to rely on the same obviousness grounds presented for Claim Limitations 1[a], 8[a], and 15[c] above, Petitioner's proposed combination fails to address the "assembled" limitation and Petitioner again fails to contend any reasonable expectation of success for the proposed modification.

Accordingly, Petitioner has failed to show a reasonable likelihood of success as to Claims 1-20, and the Petition should be denied.

**C. The Petition Fails to Show How the References Teach or Render Obvious “wherein a focus identifier marks an image of a chapter corresponding to the current position within the continuous playback” of Claim Limitations 1[b], 8[b], and 15[d]**

The Petition fails to show how the prior art references alone or in combination teach or render obvious the claimed features of **wherein a focus identifier marks an image of a chapter corresponding to the current position within the continuous playback.**

Petitioner maps this limitation to Nishikawa’s focus border depicted in FIG. 8 and described in Nishikawa paragraphs [0046]-[0047].



[0046] As shown in FIG. 8, thumbnail view 800 is comprised of thumbnails 810<sub>a</sub>-810<sub>d</sub>, which correspond to the chapter marks 725<sub>a</sub>-725<sub>d</sub>. In this embodiment, focus has defaulted to thumbnail 810<sub>c</sub>, although it may similarly default to any other available thumbnail. In addition, a user may scroll through the available thumbnails 725<sub>a</sub>-725<sub>d</sub> using a left and right navigation. In addition, a chapter name may be included near the thumbnail currently in focus (e.g., “Mark 3”). Finally, users may request to exit the thumbnail view 800 (e.g., by pressing ‘down’ on a remote control device), or may simply wait for a predetermined delay period before the thumbnail view 800 is automatically exited.

[0047] It should be appreciated that, in the case of cached programming content, the beginning and ending thumbnails are always moving. As such, a predefined image instead may be displayed for the beginning and ending chapter marks for the cached content.

Ex. 1005, [0046]-[0047]. Nishikawa does not disclose **wherein a focus identifier marks an image of a chapter corresponding to the current position within the continuous playback**. Instead, Nishikawa teaches that a focus border surrounds a default thumbnail. Ex. 1005 at [0047]. FIG. 8 does not show any correspondence between the video playback and the thumbnail. To address this deficiency, Petitioner presents a fallback proposal to combine Nishikawa and Angiolillo to import Angiolillo’s disclosure of a selection tool. Pet. at 50 citing Angiolillo at [0038] and Figs. 3-6. However, Petitioner does not sufficiently explain how Angiolillo’s selection tool “marks an image of a chapter corresponding to the current position within the continuous playback.” Instead, Angiolillo shows the reverse: the content being displayed in Angiolillo is based on the change of focus of the selection tool. While this disclosure may be relevant to the subsequent

“moving. . .” limitations (*see, e.g.,* Pet. at 56-59), this teaching cannot satisfy both limitations. Petitioner does not identify any teaching in Angiolillo or provide any sufficient explanation to show how the focus identifier is based on “the current position within the continuous playback.” Without a teaching to show that the focus identifier mark is based on or corresponds to “the current position within the continuous playback,” the only relevant teaching is Nishikawa’s “default” focus identifier, which does not provide any support to disclose **wherein a focus identifier marks an image of a chapter corresponding to the current position within the continuous playback.**

Again, Petitioner fails to contend any reasonable expectation of success to modify Nishikawa and Angiolillo to arrive at the claimed focus identifier limitation.

Accordingly, Petitioner has failed to show a reasonable likelihood of success as to Claims 1-20, and the Petition should be denied.

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

The Board 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 held on 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 Board should exercise discretion to deny the 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 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 Board 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 90. 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 Board 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.<sup>1</sup> 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 institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TRUSTID, Inc.*,

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<sup>1</sup> 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.”

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 Board 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 the 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 19, 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 participated in a Markman hearing held on 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 [’300] 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.

In addition, Petitioner's over-use of expert's opinion of POSITA knowledge to fill missing limitations should weigh against institution. As described above, Petitioner fails to identify claimed elements in the prior art and uses conclusory expert testimony to inject such missing elements without any supporting evidence.

When viewing the factors together, the Petition should be denied in the Board'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: April 14, 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 4,374 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.

Respectfully submitted,

April 14, 2025

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**CERTIFICATE OF SERVICE**

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