

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.

Case No. IPR2025-00025

U.S. Patent No. 8,949,879

**PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	ANALYSIS OF THE <i>FINTIV</i> FACTORS	2
A.	<i>Fintiv</i> Factor Four: The Lack of Overlap Between the Issues Raised in the Petition and the District Court Litigation Weighs Heavily Against Exercising Discretion	2
B.	<i>Fintiv</i> Factor Five: This Factor Weighs Slightly Against Exercising Discretion Because Google Is Not a Party to the District Court Litigation	7
C.	<i>Fintiv</i> Factor Six: Other Circumstances, Including Patent Owner’s Ongoing Suits Against Users of Google’s Software and the Merits of the Petition, Weigh Against Discretionary Denial	8
D.	<i>Fintiv</i> Factor One: This Factor Is Neutral Because of the Possibility of a Future Stay	11
E.	<i>Fintiv</i> Factor Two: The Scheduled Trial Date Weighs Slightly in Favor of Exercising Discretion but Should be Given Little Weight Because Trial Is Unlikely to Proceed as Scheduled	12
F.	<i>Fintiv</i> Factor Three: While the Parties to the District Court Litigation and the Court Have Invested Some in the Litigation, Much Remains to Be Done	12
G.	Summary of the <i>Fintiv</i> Factors: Factors 4-6 Weigh Against Denying Institution and Outweigh Factors 2-3	14
III.	CONCLUSION.....	14

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (Precedential)	passim
<i>CoolIT Sys., Inc. v. Asetek Danmark A/S</i> , IPR2021-01195, Paper 10 (PTAB Dec. 28, 2021)	13
<i>e-Watch Inc. v. Apple, Inc.</i> , No. 2:13-cv-1061-JRG-RSP, 2015 WL 12915668 (E.D. Tex. Mar. 25, 2015)	11
<i>NXP USA, Inc. v. Impinj, Inc.</i> , IPR2021-01556, Paper 13 (PTAB Sept. 7, 2022) (Precedential)	6
<i>Posco Co., Ltd. v. ArcelorMittal</i> , IPR2024-01376, Paper 11 (PTAB Mar. 18, 2025)	7
<i>Samsung Bioepis Co. v. Regeneron Pharm., Inc.</i> , IPR2023-00739, Paper 9 (PTAB Oct. 20, 2023)	12, 13
<i>Samsung Display Co., Ltd. v. Pictiva Displays Int’l Ltd.</i> , IPR2024-01222, Paper 12 (PTAB Mar. 6, 2025)	3
<i>Samsung Elecs. Co., Ltd. v. Acorn Semi, LLC</i> , IPR2020-01183, Paper 17 (PTAB Feb. 10, 2021)	6
<i>Samsung Elecs. Co., Ltd. v. Truesight Commc’ns LLC</i> , IPR2024-01477, Paper 12 (PTAB Apr. 21, 2025)	11
<i>SAP Am., Inc. v. Cyandia, Inc.</i> , IPR2024-01496, Paper 13 (PTAB April 7, 2025)	5
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (Precedential as to § II.A)	5

I. INTRODUCTION

The Director should deny Patent Owner’s request to discretionarily deny institution based on parallel litigation. *See* Paper 9. Patent Owner relies on the parallel litigation in *Truesight Commc’ns, LLC v. Samsung Elecs. Co.*, No. 2:23-cv-00643-JRG (E.D. Tex.) (“the District Court Litigation”), which names only Petitioners Samsung Electronics America, Inc., and Samsung Electronics Co., Ltd. (collectively, “Samsung”) as defendants and involves only a small fraction of the claims challenged in the Petition. Petitioner Google LLC (“Google”) is not a party to the District Court Litigation, or any other litigation involving the ’879 patent.

Google has a strong interest in invalidating *all* claims of the ’879 patent because Patent Owner has accused several companies, including those not part of this proceeding, of infringing based on products that implement Google software. In the District Court Litigation, Patent Owner alleges that Samsung infringes the ’879 patent based on products that implement Google Family Link. Ex. 1008 ¶¶ 22-29; *see* Paper 9 at 4 (“The District Court Litigation involves causes of action asserting the ’879 Patent against [Samsung]’s products which include [Google]’s applications, such as YouTube and Family Link, installed on [Samsung]’s products.”). Patent Owner has also raised similar infringement allegations in separate cases against Lenovo Group Limited and TCL Technology Group Corp. Ex. 1020 ¶¶ 22-29; Ex. 1021 ¶¶ 22-29.

It would be inefficient to discretionarily deny institution here when the District Court Litigation will, at most, adjudicate only *five* of the '879 patent's nineteen claims. Denying institution would leave open the possibility for additional litigation on the unadjudicated claims against other users of Google's software and possibly Google itself. In contrast, if the Board institutes IPR and Petitioners prevail on all challenged claims (i.e., all claims of the patent), the IPR would resolve the currently pending litigations and foreclose any potential future litigations involving the '879 patent. For the five claims of the '879 patent that Patent Owner has not yet dropped from the District Court Litigation, Samsung has mitigated concerns of duplicative efforts and potentially conflicting decisions by entering a *Sotera* stipulation.

In view of each of the *Fintiv*¹ factors addressed below, the Director should decline to discretionarily deny institution here.

II. ANALYSIS OF THE *FINTIV* FACTORS

A. *Fintiv* Factor Four: The Lack of Overlap Between the Issues Raised in the Petition and the District Court Litigation Weighs Heavily Against Exercising Discretion

This factor weighs heavily against exercising discretion because the Petition challenges significantly more claims than those at issue in the District Court

¹ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (Precedential) ("*Fintiv*").

Litigation and all named defendants in the District Court Litigation have entered a *Sotera* stipulation. *See Fintiv* at 12-13 (“[I]f the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution under *NHK.*”).

The Petition challenged all nineteen claims of the ’879 patent based on a single prior-art combination. Paper 1 at 1. If the Board institutes IPR, it will address the patentability of *all* claims of the ’879 patent and will do so efficiently, as the proceeding involves only one ground. In contrast, the District Court Litigation involves only *five* claims of the ’879 patent. *See* Ex. 1022 (Patent Owner identifying claims 1, 4, 5, 10, and 12 as the asserted claims against Samsung). No matter what happens at trial, the District Court litigation will not address the validity of at least fourteen claims—nearly 75% of the claims challenged in the Petition. This significant lack of overlap between the claims at issue in this proceeding and in the District Court Litigation weighs against exercising discretion. *See Samsung Display Co., Ltd. v. Pictiva Displays Int’l Ltd.*, IPR2024-01222, Paper 12 at 8 (PTAB Mar. 6, 2025) (finding that the “additional challenged claims not at issue in the district court” weigh “against exercising discretion to deny institution”).

The additional challenged claims not at issue in the District Court Litigation involve materially different arguments and evidence. For example, although Patent

Owner initially asserted infringement of claims 7 and 14 of the '879 patent, those claims are no longer at issue in the District Court Litigation. *Compare* Ex. 2002 at 2 (identifying claims 1-19 as the asserted claims of the '879 patent), *with* Ex. 1022 (no longer asserting claims 7 and 14). These claims both require that “the authentication codes comprise biometric information.” Ex. 1001 at 14:11-12, 14:54-55. The Petition demonstrates why it would have been obvious “to implement Sullivan’s access codes/passwords using biometric information” in view of Craner disclosing authentication based on “voice, iris, or fingerprint verification.” Paper 1 at 55-56, 77; Ex. 1007 at 11:54-58. None of the asserted claims in the District Court Litigation require biometric information, so the District Court Litigation will fail to resolve the validity of these claims.

Patent Owner’s Request fails to even mention the lack of overlap. Instead, Patent Owner incorrectly asserts that “[t]here 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.” Paper 9 at 5 (emphasis added). At the time Patent Owner filed its Request, Patent Owner had already narrowed the District Court Litigation to only seven asserted claims of the '879 patent. Ex. 1023 (Patent Owner identifying claims 1, 2, 4, 5, 10, 12, and 17 as the asserted claims against Samsung). And on April 21, Patent Owner further narrowed to the five currently asserted claims. *See* Ex. 1022; Ex. 2001

at 4 (requiring Patent Owner to serve its “Final Election of Asserted Claims”). Far from “complete overlap” (Paper 9 at 5), the District Court Litigation involves only a small fraction of the challenged claims.

Moreover, the named defendants in the District Court Litigation have all entered a *Sotera* stipulation stating that, if the Board institutes IPR, they will not pursue in the District Court Litigation any ground that it raised or reasonably could have raised in the IPR. Ex. 1019 (Samsung’s *Sotera* Stipulation). This stipulation “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020) (Precedential as to § II.A). For example, Samsung’s invalidity contentions identify only one prior art system, the RCA DTA800B1, and rely on that system only as a primary reference. *See* Ex. 2002 at 12-15, 711-712. None of the “sources of evidence” describing this system were cited in the Petition. *Id.* at 711-712. Accordingly, this is not the situation where the same prior-art publications asserted in the petition are used to describe a system in district court. *See SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 8-9 (PTAB April 7, 2025).

Patent Owner cites no authority to support its argument that Samsung’s stipulation is untimely, and Petitioners are not aware of *any* decision treating as untimely a stipulation that was submitted after the petition but before institution.

Paper 9 at 5. Indeed, precedential authority only requires that a stipulation be offered “prior to the Board’s decision of whether to institute review.” *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 at 4 (PTAB Sept. 7, 2022) (Precedential). *Sotera* itself involved a stipulation submitted after the patent owner’s preliminary response. See Petitioner’s Reply to Preliminary Response, *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 10 (PTAB Oct. 16, 2020). And the Board has, in the past, considered and previously rejected this argument. *Samsung Elecs. Co., Ltd. v. Acorn Semi, LLC*, IPR2020-01183, Paper 17 at 43-44 (PTAB Feb. 10, 2021).

Patent Owner’s cries of prejudice ring hollow, as it filed its Request for Discretionary Denial of Institution just *two days* after the issuance of the March 26 Memorandum describing the new bifurcated processes for discretionary denial. Had Patent Owner not filed its Request four weeks early without warning, Samsung could have provided its stipulation before Patent Owner’s Request. In any event, there is no prejudice because the March 26 Memorandum allows Patent Owner to request leave to file a reply.

In view of the defendants in the District Court Litigation entering a *Sotera* stipulation and the very few overlapping claims between the District Court Litigation and this proceeding, the District Court Litigation will involve different grounds,

different arguments, and different evidence. This factor strongly weighs against exercising discretion.

B. *Fintiv* Factor Five: This Factor Weighs Slightly Against Exercising Discretion Because Google Is Not a Party to the District Court Litigation

The fifth *Fintiv* factor weighs slightly against exercising discretion because one of the Petitioners, Google, is not a party to the District Court Litigation. Under *Fintiv*, where “a petitioner is unrelated to a defendant in an earlier court proceeding, the Board has weighed this fact against exercising discretion to deny institution under *NHK*.” *Fintiv* at 13-14. Patent Owner does not assert that Google is related to Samsung. *See* Paper 9 at 4-5. Instead, Patent Owner argues that the District Court Litigation involves infringement allegations against Samsung’s “products which include Google LLC’s applications.” *Id.* at 4-5. Yet Google has interests that go beyond those of Samsung, including other pending litigations involving the ’879 patent and foreclosing future allegations of infringement based on products that include Google’s software. The Board has previously found that this factor is neutral when the petitioner and the defendants “have a supplier/customer relationship.” *Posco Co., Ltd. v. ArcelorMittal*, IPR2024-01376, Paper 11 at 16 (PTAB Mar. 18, 2025). But the balance tips slightly against denial here because, unlike *Posco*, where the petitioner sought to avoid future litigation, the risk of additional litigation is not hypothetical. *Id.* Patent Owner has already accused other parties of infringing based

on products that implement Google’s software, as discussed further for factor six, *infra*.

While *Fintiv* also states that “the Board may, nonetheless, exercise the authority to deny institution” “if the issues are the same as, or substantially similar to, those . . . about to be litigated,” that is not the case here. *Fintiv* at 14. As discussed for *Fintiv* factor four, the District Court Litigation involves only five of the nineteen challenged claims, and in view of Samsung’s *Sotera* stipulation, will involve different grounds, arguments, and evidence.

Patent Owner contorts the analysis for this factor by arguing 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].” Paper 9 at 4-5. Google, as one of the Petitioners, is a real party-in-interest *for the purposes of this IPR*. But Google is not a party to the District Court Litigation. Patent Owner fails to explain how Google’s filing of this Petition makes Google related to Samsung in the District Court Litigation. *See id.*; *Fintiv* at 13-14.

C. *Fintiv* Factor Six: Other Circumstances, Including Patent Owner’s Ongoing Suits Against Users of Google’s Software and the Merits of the Petition, Weigh Against Discretionary Denial

This factor weighs against discretionary denial because Google, who is not a party to the District Court Litigation, or any other litigation involving the ’879 patent, has a strong interest in invalidating all claims of the ’879 patent. Patent

Owner has filed patent infringement suits accusing Samsung, Lenovo Group Limited, and TCL Technology Group Corp. of infringing the '879 patent based on their products that implement Google Family Link. Ex. 1008 ¶¶ 22-29; Ex. 1020 ¶¶ 22-29; Ex. 1021 ¶¶ 22-29. Patent Owner has provided no stipulation or assurance that, if the five asserted claims of the '879 patent are invalidated in the District Court Litigation, it will not attempt to enforce the remaining fourteen claims against other parties, including Google. Denying institution would be an inefficient use of resources because Patent Owner could continue to assert its unadjudicated claims against other parties based on their use of Google's technology, leading to unnecessary litigation.

The strong merits of the Petition also favor institution because the single ground of unpatentability demonstrates the obviousness of all claims. Sullivan, which was not before the Examiner during prosecution, addresses the problems that the '879 patent purports to solve. For example, the '879 patent states that the problems with existing access controls for playback devices were that the "single override" provided by a conventional V-chip's PIN is purportedly "insufficient" in households with different-aged children and that the program rating "may not coincide with the parent's judgments." Ex. 1001 at 2:9-20, 2:33-60. Before the '879 patent, Sullivan also recognized that a user "may feel that a content rating for content the user has viewed may not be stringent enough, or conversely, too stringent, for

sensitive users such as children, for whom access to the content is controlled by the user.” Ex. 1005 at [0006]. To address that issue, Sullivan teaches a system that provides “a unique password” for each user so that children of different ages can access only content that aligns with the parent’s judgments. *Id.* at [0088], [0099]-[0100]. The Petition demonstrates how the prior art meets all limitations of the challenged claims, either alone or in combination.

Contrary to Patent Owner’s argument, the fact that the supporting expert declaration is longer than the Petition does not somehow demonstrate that the obviousness combinations are weak or that Petitioners over-used expert testimony. Paper 9 at 9. Instead, the expert declaration supports the strength of the Petition because it provides detailed explanations of where each limitation is found in the prior art and why a POSITA would have found the prior art obvious to combine, including through citations to multiple state-of-the-art references known to a POSITA. Similarly, the fact that the Petition combined references does not demonstrate that it used the expert declaration “to fill in numerous gaps in the references.” *Id.* Patent Owner does not identify any gaps in the prior art and instead only points generally to the expert declaration’s analysis for claim 1. *Id.* (citing Ex. 1003 at pp. 40-67). No such gaps exist.

D. *Fintiv* Factor One: This Factor Is Neutral Because of the Possibility of a Future Stay

The first *Fintiv* factor is neutral. According to *Fintiv*, this factor weighs against exercising discretion in cases where there is no stay but “the district court has denied a motion for stay without prejudice and indicated to the parties that it will consider a renewed motion . . . to stay if a PTAB trial is instituted.” *Fintiv* at 6-7. Here, the district court denied Samsung’s pre-institution motion without prejudice, stating that the motion was “premature.” Ex. 2003 at 2-3. Samsung is free to renew its motion if the Board institutes IPR. And in the past, the district court has weighed a pre-institution motion to stay followed by a prompt renewal of that motion after institution in favor of granting a stay. *e-Watch Inc. v. Apple, Inc.*, No. 2:13-cv-1061-JRG-RSP, 2015 WL 12915668, at *3 (E.D. Tex. Mar. 25, 2015) (holding that the timing of the defendant’s earlier motion to stay weighs in favor of granting the defendant’s “promptly renewed” motion to stay after institution). But in these circumstances, factor one is typically found to be neutral because the district court’s consideration of a renewed stay motion “is based on a variety of circumstances and facts beyond [the Board’s] control and to which the Board is not privy.” *Samsung Elecs. Co., Ltd. v. Truesight Commc’ns LLC*, IPR2024-01477, Paper 12 at 10-11 (PTAB Apr. 21, 2025) (finding factor one to be neutral in an IPR brought by Samsung against another patent asserted in the same District Court Litigation).

E. *Fintiv* Factor Two: The Scheduled Trial Date Weighs Slightly in Favor of Exercising Discretion but Should be Given Little Weight Because Trial Is Unlikely to Proceed as Scheduled

Trial in the District Court Litigation is scheduled to begin about three months after the deadline to decide whether to institute IPR. Ex. 2001. But it is highly unlikely that the trial will proceed as scheduled. The District Court Litigation is just one of *fourteen* cases currently scheduled to begin jury selection on the same day before Judge Gilstrap. Ex. 1024. Of those fourteen cases, six are other patent cases that were filed before the District Court Litigation. *Id.* at 1-12. In all likelihood, the trial will be delayed.

Even in the unlikely event that the District Court Litigation proceeds to trial as currently scheduled, the trial will only involve at most five of the nineteen challenged claims. *See* Ex. 1022. When “the district court action does not include all of the challenged claims within the scope of the litigation,” the Board has even found *Fintiv* factor two to weigh *against* exercising discretion. *Samsung Bioepis Co. v. Regeneron Pharm., Inc.*, IPR2023-00739, Paper 9 at 58 (PTAB Oct. 20, 2023).

F. *Fintiv* Factor Three: While the Parties to the District Court Litigation and the Court Have Invested Some in the Litigation, Much Remains to Be Done

Factor 3 weighs slightly in favor of exercising discretion. Although the District Court Litigation has progressed past the *Markman* hearing, Petitioners’ diligence in filing this Petition and the fact that the litigation involves only a small

subset of the challenged claims offsets the investment between the parties. Petitioners diligently filed this Petition (and one challenging another asserted patent) roughly six months after Truesight served its infringement contentions on Samsung. Ex. 1009; *see, e.g., Fintiv* at 11 (“[I]t is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding.”); *CoolIT Sys., Inc. v. Asetek Danmark A/S*, IPR2021-01195, Paper 10 at 11-12 (PTAB Dec. 28, 2021) (finding diligence where petition was filed five months after infringement contentions were served). Moreover, the *Markman* hearing occurred well after Patent Owner dropped twelve of the nineteen challenged claims from the District Court Litigation. *See* Ex. 1023 (narrowing the asserted claims on February 5, 2025); Ex. 2001 at 4 (*Markman* on April 2, 2025). Accordingly, while there has been some investment in the District Court Litigation generally, there has been *very little* investment for the bulk of the challenged claims, which are no longer a part of the litigation. *See Samsung Bioepis*, IPR2023-00739, Paper 9 at 56-57 (finding that “*Fintiv* factor 3 favors institution” where, although the litigation had advanced past trial, the validity of eight of twelve challenged claims was not at issue in the district court litigation).

Much also remains to be done in the litigation. Even if the Board waits until the last day to institute IPR and the case schedule has not changed by that time, the parties will still have not completed motions in limine, pretrial disclosures, other

pretrial tasks, the pretrial conference, and trial, and the district court will not yet have resolved dispositive motions or *Daubert* motions. Ex. 2001 at 1-3.

G. Summary of the *Fintiv* Factors: Factors 4-6 Weigh Against Denying Institution and Outweigh Factors 2-3

Weighing the *Fintiv* factors together, the Director should decline to discretionarily deny institution. While the District Court Litigation has progressed past the *Markman* hearing, the litigation involves only five of the nineteen challenged claims and does not name Google as a party. Even if Samsung invalidates those five claims at trial, that would not prevent Patent Owner from continuing to assert the unadjudicated claims against other users of Google's software in the future, including Google itself. For the five overlapping claims, any risk of duplicative efforts and potentially inconsistent outcomes is mitigated by the *Sotera* stipulations filed by Google and Samsung.

III. CONCLUSION

For the foregoing reasons, Petitioners respectfully request that the Director decline to exercise discretion to deny institution and let the panel decide whether to institute based on the merits of the Petition.

Date: April 28, 2025

Respectfully submitted,

/Erika H. Arner/

Erika H. Arner, Lead Counsel
Reg. No. 57,540

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24 and the Memorandum on Interim Processes for PTAB Workload Management, dated March 26, 2025, Petitioners certify that the word count of the foregoing **Petitioners' Opposition to Patent Owner's Request for Discretionary Denial of Institution** as measured by Microsoft Word is 3,290 words, excluding those portions identified in 37 C.F.R. § 42.24(a).

/Erika H. Arner/
Erika H. Arner, Lead Counsel
Reg. No. 57,540

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioners’
Opposition to Patent Owner’s Request for Discretionary Denial of Institution**
was served electronically via email on April 28, 2025, in its entirety on the
following:

Peter Lambrianakos
plambrianakos@fabricantllp.com

Vincent J. Rubino, III
vrubino@fabricantllp.com

Alfred R. Fabricant
ffabricant@fabricantllp.com

Enrique W. Iturralde
eiturralde@fabricantllp.com

John A. Rubino
jarubino@rubinoip.com

ptab@fabricantllp.com

Patent Owner has consented to service by email.

Date: April 28, 2025

By: /Daniel E. Doku/
Daniel E. Doku
Senior Litigation Legal Assistant

Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP