

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.

Patent No. 8,949,879

Filing Date: April 19, 2012

Issue Date: February 3, 2015

Inventors: Joseph Zipperer, Steven King, and Valient Seu

Title: ACCESS CONTROLS FOR KNOWN CONTENT

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2025-00025

TABLE OF CONTENTS

	Page(s)
I. INTRODUCTION	1
II. CLAIM CONSTRUCTION	3
III. LEVEL OF ORDINARY SKILL IN THE ART	4
IV. PETITIONER HAS NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF SUCCESS FOR THE GROUNDS ADVANCED IN THE PETITION, AND THE PETITION SHOULD BE DENIED	4
A. The Petition Fails to Show How the References Teach or Render Obvious the “override” and “V-chip” Claim Limitations 1a, 4d, 12c	6
B. The Petition Fails to Show How the References Teach or Render Obvious “determining that a content identifier of the [specific digital content/media content] matches a user identifier of the first [user/viewer] and the personal identification number [of the first viewer/of the first user] is successfully authenticated” of Claim Limitations 1f, 4j, and 12k	11
V. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(A)	13
A. The Parallel District Court Litigation and the Petition Involve the Same Parties	15
B. The District Court Litigation Involves Substantially the Same Claims.....	16
C. Proximity of the District Court’s Trial Date	17
D. Significant Investment and Petitioner’s Delay in Filing the Petition.....	19
E. No Stay of the Parallel District Court Litigation	19
F. Other Factors Favor Discretionary Denial	20

VI. CONCLUSION.....	21
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TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Adapt Pharma Operations Ltd. v. Teva Pharms. USA, Inc.</i> , 25 F.4th 1354 (Fed. Cir. 2022)	8
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020)	13, 18
<i>Apple, Inc. v. Contentguard Holdings, Inc.</i> , IPR2015-00355, Paper 9 (P.T.A.B. June 26, 2015)	4
<i>Broadcom Corp. v. Emulex Corp.</i> , 732 F.3d 1325 (Fed. Cir. 2013)	6
<i>Cisco Sys., Inc. v. Estech Sys., Inc.</i> , IPR2021-00329, Paper 13 (P.T.A.B. Jul. 6, 2021)	18
<i>Cisco Sys., Inc. v. Oyster Optics, LLC</i> , IPR2021-00238, Paper 10 (P.T.A.B. Jun. 1, 2021)	18
<i>Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.</i> , IPR2020-00122, Paper 15 (P.T.A.B. May 15, 2020)	16, 18
<i>Edward LifeSciences Corp. v. Evalve, Inc.</i> , IPR2019-01479, Paper 7 (P.T.A.B. Feb. 26, 2020)	17
<i>F5 Networks, Inc. v. WSOU Invs., LLC</i> , IPR2022-00239, Paper 12 (P.T.A.B. May 18, 2022)	18
<i>Force Mos Tech., Co. v. ASUSTek Comput., Inc.</i> , No. 2:22-CV-00460-JRG, 2024 WL 1586266 (E.D. Tex. Apr. 11, 2024)	19
<i>Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017)	14
<i>Google LLC v. EcoFactor, Inc.</i> , IPR2021-00488, Paper 12 (P.T.A.B. Aug. 11, 2021)	18

<i>Graham v. John Deere Co. of Kansas City</i> , 383 U.S. 1 (1966).....	4
<i>Innogenetics, N.V. v. Abbott Lab 'ys.</i> , 512 F.3d 1363 (Fed. Cir. 2008)	6
<i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	5
<i>KSR Int'l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	4, 8
<i>LBT IP I LLC v. Apple Inc.</i> , No. 2022-1613, 2023 WL 3914920 (Fed. Cir. June 9, 2023).....	6
<i>Los Angeles Biomedical Rsch. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.</i> , 849 F.3d 1049 (Fed. Cir. 2017)	5
<i>Next Caller Inc. v. TRUSTID, Inc.</i> , IPR2019-00961, -00962, Paper 10 (P.T.A.B. Oct. 16, 2019)	17
<i>NHK Spring Co. v. Intri-Plex Techs., Inc.</i> , IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018).....	14
<i>Pers. Web Techs., LLC v. Apple, Inc.</i> , 848 F.3d 987 (Fed. Cir. 2017)	5
<i>Pers. Web Techs., LLC v. Apple, Inc.</i> , 917 F.3d 1376 (Fed. Cir. 2019)	6
<i>Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC</i> , IPR2019-01218, Paper 7 (P.T.A.B. Jan. 7, 2020)	17
<i>Samsung Elecs. Co. et al., v. Truesight Commc'ns LLC</i> , IPR2024-01477, Paper 12 (P.T.A.B. Apr. 21, 2025)	3, 20
<i>Samsung Elecs. Co. et al., v. Truesight Commc'ns LLC</i> , IPR2025-00123, Paper 12 (P.T.A.B. Apr. 22, 2025)	3, 20
<i>Samsung Elecs. Co. v. Truesight Commc'ns LLC</i> , IPR2025-00123, Paper 7 (P.T.A.B. Feb 25, 2025).....	20

Stratoflex, Inc. v. Aeroquip Corp.,
713 F.2d 1530 (Fed. Cir. 1983) 4

Supercell Oy v. Gree, Inc.,
IPR2020-00513, Paper 11 (P.T.A.B. June 24, 2020) 17

In re Van Os,
844 F.3d 1359 (Fed. Cir. 2017) 6

Statutes

35 U.S.C. § 314(a) 2, 14, 21

35 U.S.C. § 314(b)(1).....17

35 U.S.C. § 316(a)(11).....17

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)
2004	Decision Denying Institution of <i>Inter Partes</i> Review 35 U.S.C. § 314, <i>Samsung Elecs. Co. et al., v. Truesight Commc'ns LLC</i> , IPR2024-01477, Paper 12 (P.T.A.B. Apr. 21, 2025)
2005	Decision Denying Institution of <i>Inter Partes</i> Review 35 U.S.C. § 314, <i>Samsung Elecs. Co. et al., v. Truesight Commc'ns LLC</i> , IPR2025-00123, Paper 12 (P.T.A.B. Apr. 22, 2025)

I. INTRODUCTION

On December 27, 2024, Google LLC, Samsung Electronics America, Inc., and Samsung Electronics Co., Ltd. (collectively, “Petitioner”) submitted a Petition (Paper 1, “Petition” or “Pet.”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 8,949,879 (Ex. 1001, the “’879 Patent”), challenging Claims 1-19 (the “Challenged Claims”). The Petition asserts that Claims 1-19 are rendered obvious over various proposed combinations of at least three references. The Board should deny the Petition for at least the reasons described below.

First, Petitioner’s single ground fails to sufficiently show that any of the references or the combinations thereof disclose or render obvious the “overriding” and “V-chip” limitations of the Challenged Claims. Petitioner fails to articulate a proper motivation or reason to modify Sullivan’s content recorder with Leung’s V-chip teachings. The proposed combination modifies Sullivan to introduce a problem that did not exist in Sullivan to be solved for the purpose of fitting the claimed invention. Sullivan’s content recorder has its own parental lock system and lacks any V-chip to override. Petitioner proposes to modify Sullivan’s disclosure to add a V-chip in order to introduce an override, i.e., to create the problem to be solved by the claimed invention. Because Sullivan already teaches a parental lock system without a V-chip, the proposed modification makes no sense and appears to be derived from impermissible hindsight. Additionally, Petitioner fails to articulate any supportable

reasonable expectation of success to combine the references. Petitioner's allegation of success is based on what Sullivan describes as an "undesirable" possibility and Petitioner's statement that "Sullivan discloses . . . V-chips are designed to use the VBI to identify the program's rating" lacks support because there is no reference or teaching in Sullivan for any V-chip. Pet. at 18.

Second, the Petition fails to show how Sullivan alone or in combination with Leung teaches or renders obvious the claimed features of *determining that a content identifier of the [specific digital content/media content] matches a user identifier of the first [user/viewer] and the personal identification number [of the first viewer/of the first user] is successfully authenticated*. Petitioner maps the "content identifier" to what Petitioner refers to as an "indication of the audio/visual content." But Sullivan does not recite the term "indication" at all, and Petitioner does not sufficiently explain the alleged "indication." While Petitioner references a list of users stored with content in Sullivan, Petitioner does not sufficiently explain the relevance of the list or explain why the list would need any alleged "indication of the audio/visual content" or any matching determination with such "indication" when Petitioner relies on a list with users already stored and associated with content.

Third, 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 '879 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. The Board has already denied institution on two earlier-filed petitions related to other asserted patents in the same District Court Litigation. *See Samsung Elecs. Co. et al., v. Truesight Commc'ns LLC*, IPR2024-01477, Paper 12 (P.T.A.B. Apr. 21, 2025) Ex. 2004; *Samsung Elecs. Co. et al., v. Truesight Commc'ns LLC*, IPR2025-00123, Paper 12 (P.T.A.B. Apr. 22, 2025) Ex. 2005. The Board should similarly exercise discretion to deny institution here.

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 two years in research, design, or development in television broadcast or video playback systems or other comparable experience." Pet. at 14 (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 the “override” and “V-chip” Recited in Claim Limitations 1a, 4d, 12c

Each ground of the Petition relies on a proposed combination of Sullivan and Leung to render obvious “override” and “V-chip” limitations. Specifically, Petitioner proposes modifying Sullivan with certain teachings of Leung. Pet. at 15-19.

This proposed combination is insufficient and lacks a motivation or reason to modify Sullivan with Leung because: (a) the proposed combination modifies

Sullivan to introduce a problem that did not exist in Sullivan to be solved for the purpose of fitting the claimed invention; and (b) Petitioner fails to articulate a proper motivation or reason to combine the references; and (c) Petitioner fails to articulate any supportable reasonable expectation of success to combine the references.

Claim 1 recites *an apparatus for setting rating based access controls for known digital content to be played **on a video playback device having a V-chip**, the apparatus comprising: a rating policy management module for selectively setting rating based access control on a per media and per user basis for digital content of a digital library **thereby overriding a policy set by the V-chip for access to the digital content from the video playback device***. Claim 12 recites *a method in a computing system for rating based media access policy enforcement, the method comprising: under control of **a video playback device having a V-chip that specifies default rating based access policy**, performing the acts of: displaying metadata; responsive to a first user selecting a media content from the displayed metadata, and responsive to determining that rating based access control **configured to override the V-chip default rating based access policy is enabled**: reading media information; reading a default rating based access policy action associated with the selected media content **configured to override the V-chip default rating based access policy***.

Petitioner relies on Sullivan's content recorders, such as personal video recorders. Sullivan does not disclose any V-chip technology. Instead, Sullivan already comprises what it refers to as "a user interface providing a single point of user control for parental locks." In other words, Sullivan's content recorder has its own parental lock system and lacks any V-chip to override.

Petitioner proposes to modify Sullivan's disclosure to add a V-chip to override, i.e., to create the problem to be solved by the claimed invention. Petitioner does not explain why a POSITA would add a V-chip when Sullivan already comprises a parental lock system. Because Sullivan already teaches a parental lock system, the proposed modification makes no sense and appears to be derived from impermissible hindsight.

A person of ordinary skill in the art would not be motivated to modify a reference to introduce a problem. A determination of obviousness "requires 'identify[ing] a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.'" *Adapt Pharma Operations Ltd. v. Teva Pharms. USA, Inc.*, 25 F.4th 1354, 1365 (Fed. Cir. 2022) (quoting *KSR*, 550 U.S. at 418). Introducing a new problem, i.e., modifying Sullivan to a V-chip in order to later add an override, is not a sufficient reason to modify a reference. Petitioner's explanation also fails to account for the already-existing parental lock user interface which already existed in Sullivan.

Additionally, Petitioner fails to identify a reasonable expectation of success. Petitioner's sole argument regarding success is based on what Sullivan describes as an "undesirable" possibility. Ex. 1005 at [0098]-[0099]. Petitioner alleges success by simply applying conventional techniques based on the allegation that "Sullivan discloses that the television content includes a rating in the VBI, and V-chips are designed to use the VBI program's rating." Pet. 18-19 citing Ex. 1005 at [0098]. However, Sullivan's sole reference to "vertical blanking interval" is described in the context of an embodiment for altering uncompressed signals that is not relied upon by Petitioner for any mapping in the Petition.

[0098] In another embodiment, a content recorder in accordance with the present invention such as a PVR, a VCR, or the like may store the television content in an uncompressed form, retaining rating information as part of the stored television signal. To alter the rating of the television content, an authorized user instructs the content recorder to change the rating information stored with the television content, e.g. replacing a TV-14 rating found in a vertical blanking interval of the stored television signal with a TV-MA rating.

The very next paragraph of Sullivan describes this alteration of the vertical blanking interval portion of an uncompressed signal as "undesirable" and proposes another embodiment. Ex. 1005 at [0099]. Sullivan teaches nothing further about any VBI or vertical blanking interval. The teaching in Sullivan is to avoid the vertical blanking interval. Petitioner's statement that "Sullivan discloses . . . V-chips are

designed to use the VBI to identify the program's rating" lacks support. Sullivan is completely silent on V-chip. Sullivan's content recorder does not include a V-chip as a component. Based on these incorrect, unsupportable statements by Petitioner and its expert, Petitioner has failed to advance any supportable reasonable expectation of success in modifying Sullivan's content recorder to include a Leung's "V-chip" and "override" disclosures.

The above arguments apply equally across Claims 1, 4, and 12 with respect to the override limitation. The above arguments apply equally across Claims 1 and 12 with respect to the V-chip limitation. While Claim 4 does not recite a V-chip, Petitioner still relies on modifying Sullivan with Leung's V-chip. *See* Pet. at 48; *see also* Pet. at 43 ("As discussed in Section VI.A.1.a, it would have been obvious to implement Sullivan's ratings-based parental locks using Leung's V-chip."). Petitioner's proposed combination of Sullivan with Leung's V-chip is irrelevant to this claim and is thus improper.

Accordingly, Petitioner has failed to show a reasonable likelihood of success as to Claims 1-19, and the Petition should be denied.

B. The Petition Fails to Show How the References Teach or Render Obvious “determining that a content identifier of the [specific digital content/media content] matches a user identifier of the first [user/viewer] and the personal identification number [of the first viewer/of the first user] is successfully authenticated” of Claim Limitations 1f, 4j, and 12k

The Petition fails to show how the prior art references alone or in combination teach or render obvious the claimed features of *determining that a content identifier of the [specific digital content/media content] matches a user identifier of the first [user/viewer] and the personal identification number [of the first viewer/of the first user] is successfully authenticated*. This claimed requirement is identified in the Petition as Claim Limitations 1f, 4j, and 12k.

Petitioner fails to sufficiently explain how either Sullivan or Leung disclose the “content identifier” element and to explain how said content identifier is used in the claimed matching determination. Petitioner appears to map the “content identifier” to what Petitioner refers to as an “indication of the audio/visual content.” Pet. 39. Petitioner does not sufficiently explain the alleged “indication.” The term “indication” does not appear in the disclosure of Sullivan or Leung. Petitioner does not identify any specific element in Sullivan which corresponds to the alleged “indication.” Petitioner does not allege that the “indication” is inherent. Accordingly, Petitioner leaves the Board guessing as to how to interpret the alleged “indication of the audio/visual content” or how to map Sullivan to the claimed

“content identifier.”

Citing to paragraphs 0099-0100 of Sullivan, Petitioner identifies a list of users stored with content. Pet. at 39. However, Sullivan teaches that this list is “generated, denoting at least one user who is allowed to access the content and who would otherwise be blocked by application of the content rating” and then “stored and associated with the stored content for controlling access to the content.” Ex. 1005 at [0100]. This disclosure makes no mention of Petitioner’s alleged “indication” much less how an “indication” is used in the required matching determination of this limitation. Petitioner does not explain why Sullivan would need Petitioner’s alleged “indication of the audio/visual content” when Sullivan discloses that a user is already stored with and associated with the content. Petitioner does not explain why Sullivan would need any matching determination using “indication of the audio/visual content” when Petitioner relies on a list that stores users with content.

While Petitioner asserts that Sullivan and Leung teach this limitation, Petitioner does not identify any teaching in Leung to cure this deficiency. To the extent Petitioner intends to rely on any teaching of Leung, Petitioner does not articulate any motivation or reason to modify Sullivan with any teaching of Leung for this limitation, and Petitioner fails to articulate whether modifying Sullivan with any teaching of Leung would have any reasonable expectation of success for this limitation.

Accordingly, Petitioner has failed to show a reasonable likelihood of success as to Claims 1-19, and the Petition should be denied.

V. 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 29, 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 '879 Patent). Pet. at 83-84. 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 '879 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 1008; Pet. at 83. 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; Pet. at 83, 85. To the extent Petitioner contends that Google's products are also involved in other litigations, such other litigations are irrelevant to the analysis for these Samsung-Truesight petitions because the District Court Litigation is the first proceeding which will determine the validity of the Challenged Claims. Any speculation about future events in other litigations is irrelevant to the analysis for these Samsung-Truesight petitions. 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. Despite being given the opportunity, Petitioner fails to provide a sufficient reason to withhold any stipulation until after Patent Owner filed its request for discretionary denial. Instead, Petitioner shifts blame on to Patent Owner for timely filing a request for discretionary denial. Petitioner’s attempt to construe the Board’s prior cases as establishing a precedent that petitioners need not disclose proposed stipulations until after a patent owner’s brief contradicts the Office’s and AIA’s stated goals and highly prejudices patent owners. The Board and the Director should not endorse petitioners withholding information until this late stage.

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 29, 2026. 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.*,

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 over 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 have participated in a Markman on April 2, 2025. *Id.*

Before the July 29, 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 six 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 in the District Court Litigation. *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.”).

In addition, the Board has recently denied institution of petitions for other asserted patents in the District Court Litigation, making the likelihood of obtaining a stay virtually zero. Ex. 1008 at 3-4 (referencing 803 and 749 Patents); *See Samsung Elecs. Co. et al., v. Truesight Commc'ns LLC*, IPR2024-01477, Paper 12 (P.T.A.B. Apr. 21, 2025) Ex. 2004; *Samsung Elecs. Co. et al., v. Truesight Commc'ns LLC*, IPR2025-00123, Paper 12 (P.T.A.B. Apr. 22, 2025) Ex. 2005.

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 83-84. The merits of the Petition are weak and rely extensively on a 113-page expert declaration, which is about one and one-half the

length of the Petition itself, to fill in numerous gaps in the references. In one example, Petitioner and their expert break down Claim 1 into eight parts (1pre and 1a-1g) requiring extensive reliance on expert testimony to combine multiple references for six of the eight parts. *See, e.g.*, Ex. 1003 at 40-67. Petitioner's extensive reliance on and over-use of expert testimony should weigh in favor of denial. As described above, Petitioner's proposed combination is insufficient and Petitioner fails to map the prior art to certain limitations.

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: April 29, 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 4,673 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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