

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

TRUESIGHT COMMUNICATIONS LLC,

Patent Owner

Case IPR2025-00123

U.S. Patent No. 8,745,749

Petitioners' Supplemental Briefing

PETITIONERS' EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent 8,745,749 (“’749 <i>Pat</i> ”)
1002	Declaration of Erez Zadok
1003	Curriculum Vitae of Erez Zadok
1004	File History of U.S. Patent 8,745,749 (Application No. 13/078,323) (“’749 <i>FH</i> ”)
1005	U.S. Provisional Patent Application 61/413,926
1006	U.S. Patent 6,611,907 (“ <i>Maeda</i> ”)
1007	US Patent Publication No. 2002/0080190A1 (“ <i>Hamann</i> ”)
1008	U.S. Patent 6,789,192 (“ <i>Hirota</i> ”)
1009	CN100468438C (“ <i>Lu</i> ”) (with certified translation)
1010	US Patent Publication No. 2012/0272065 (“ <i>Matsukawa</i> ”)
1011	Intellectual Property (IP) Information from the SD Card Association (SD-3C LLC) https://www.sd-3c.com/IPInformation.aspx
1012	A Dictionary of Computing, 6th ed., Oxford University Press (2008), pp. 34 (“backing store”), 194 (“file”) and 196 (“file system”).
1013	Screen Shot of http://www.4centity.com/about.aspx (4C Entity - About Us)
1014	Microsoft Computer Dictionary, 3rd ed., 1997, excerpts (“Microsoft Computer Dictionary”)
1015	DOD Standard, Department of Defense Trusted Computer System Evaluation Criteria, December 26, 1985 (“Orange Book”)

Exhibit No.	DESCRIPTION
1016	U.S. Publication No. 2005/0273858 (“Zadok Patent Publication”)
1017	Smart Card Handbook by Rankl and Effing, 1999-2000, John Wiley & Sons, Ltd., excerpts (“Smart Card Handbook”)
1018	C. P. Wright, M. Martino, and E. Zadok. NCryptfs: A secure and convenient cryptographic file system. In <i>Proceedings of the Annual USENIX Technical Conference</i> , pages 197–210, San Antonio, TX, June 2003. USENIX Association. (“NCryptfs”).
1019	SD Association – Fact Sheet (https://www.sdcard.org/about-sda/fact-sheet/)
1020	November 1, 2024, letter from Ryan Nishimoto to Alfred Fabricant
1021	Plaintiff’s Disclosure Of Asserted Claims And Infringement Contentions, <i>Truesight Communications LLC v. Samsung Electronics Co. et al.</i> , No. 2:23-cv-00643 (E.D. Tex. May 30, 2024)
1022	Defendants Samsung Electronics Co., Ltd.’s And Samsung Electronics America, Inc.’s Motion To Stay Proceedings Pending <i>Inter Partes</i> Review, <i>Truesight Communications LLC v. Samsung Electronics Co. et al.</i> , No. 2:23-cv-00643 (E.D. Tex. May 30, 2024)

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

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

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

Petitioners have stipulated that if the Board “institutes this IPR petition on the grounds presented [], then [Petitioners] will not pursue in the [*Truesight v. Samsung* district court] litigation any grounds that were raised or reasonably could have been raised in this IPR.” *See* 1020. This is substantively identical to the stipulation the Board considered in *Sotera Wireless, Inc. v. Masimo Corp.*, which stated that petitioner “will not pursue in this case the specific grounds ... [in] the instituted *inter parties* [sic] review petition, *or on any other ground ... that was raised or could have been reasonably raised in an IPR (i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patents or printed publications).*” IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020) (precedential as to § II.A) (emphasis in original). Because Petitioners have made a *Sotera* stipulation (EX1020), Factor

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

The POPR asserts that Petitioner’s *Sotera* stipulation is “insufficient” because “it states that ‘if the PTAB either declines institution or later vacates institution of this IPR, Samsung reserves the right to pursue in this litigation any ground that was raised or reasonably could have been raised in the IPR’ but based on Petitioner’s positions in its stipulation, may only apply to ‘those grounds to be addressed at the PTAB.’” *See* POPR, 21. PO is wrong about the scope of Petitioners’ stipulation, as it explicitly applies to any ground that was raised or reasonably could have been raised in the IPR, not just to those grounds addressed at the PTAB. Moreover, the only way Petitioners’ stipulation would not apply is if trial is not instituted or if the Board vacates institution. PO does not explain how this negates Petitioners’ stipulation. Nor could it. Even in *Sotera*, the plain language of the stipulation was conditioned on institution. *Sotera*, Paper 12 at 18-19. Moreover, the Board has held that conditioning a *Sotera* stipulation on institution is proper. *Microsoft Corp. v. D3D Technologies, Inc.*, IPR2021-00703, Paper 10 at 14 (PTAB Oct. 12, 2021).

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

21-22. Yet, PO provides no evidence to suggest this would be the case.

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

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

Petitioners diligently filed this IPR six months after PO served infringement contentions asserting all claims (*See* EX1021) and over a month before serving its invalidity contentions. *See* Ex. 2002. This weighs against denying institution. *Fintiv*, 11 (finding it “reasonable” to file petitions after “learn[ing] which claims are being asserted”); *Tianma Microelectronics Co. Ltd. v. Japan Display Inc.*, IPR2021-01057, Paper 15 at 9-10 (PTAB Jan. 6, 2022) (finding diligence when filing six-months after infringement contentions and four-months after invalidity contentions).

Regarding investment in the parallel proceeding, a *Markman* hearing is scheduled to take place prior to the institution date. However, much work would still remain as of the expected institution date, including most fact discovery, all expert discovery, as well as dispositive motions. EX2001. No depositions have

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

C. The Trial Date (Factor 2)

Trial is currently scheduled for October 6, 2025. EX2001. If instituted, the FWD will issue by May 25, 2026, seven months after trial. Regardless, Petitioners’ *Sotera* stipulation obviates concerns regarding duplicative proceedings. *See* §I.A. Indeed, prior to issuance of the rescinded Interim Procedure, the Board regularly instituted proceedings with similar (and even larger) gaps in proceedings where Petitioners provided *Sotera* stipulations. *E.g., Resi Media LLC v. Boxcast Inc.*, IPR2022-00066, Paper 19 (PTAB Apr. 26, 2022) (FWD scheduled eight-months after trial); *Samsung Electronics Co., Ltd. v. RightQuestion, LLC*, IPR2022-00244, Paper 17 (PTAB Jun. 10, 2022) (FWD scheduled nine-months after trial); *Tianma*, IPR2021-01057, Paper 15 at 7-9 (FWD scheduled eleven-months after trial).

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

On January 8, 2025, Petitioners moved to stay the District Court litigation,

and the motion remains pending. EX1021. Factor 1 is neutral. The parties are the same. Factor 5 weighs in favor of discretionary denial.

Factor 6 weighs against discretionary denial because the petition's grounds are strong and show more than a reasonable likelihood of unpatentability. When arguing against institution, PO offers only unsupported attorney argument to rebut the substance of Petitioners' unpatentability arguments. For example, PO argues that Petitioners rely on Hamann's manually entered label for the "media identification." POPR at 7-9. But Petitioners rely on Hamann's file structure which, like a real smart card, includes a unique identifier area. Pet., 30. Nor did Petitioners "gloss[] over Maeda's media key block" or fail "to identify any feature of Hamann [] analogous to Maeda's media key block." POPR at 8-9. Indeed, after saying this, PO's attorneys contradict themselves by disputing Petitioners' evidence. *Id.* And PO is wrong that Petitioners presented "no real expert testimony on expectation of success." POPR, 13; *but see*, Pet., 43 (citing EX1002, ¶270). PO's other criticisms are similarly baseless.

II. Conclusion

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

Date: March 17, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that on March 17, 2025, I caused a true and correct copy of the foregoing Petitioners' Supplemental Briefing and supporting exhibits to be served via electronic mail to the counsel and email below:

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