

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.

Patent No. 8,745,749
Filing Date: April 1, 2011
Issue Date: June 3, 2014

Inventors: Joseph P. Zipperer and John Calixto

Title: VIRTUAL SECURE DIGITAL CARD

PATENT OWNER'S SUPPLEMENTAL BRIEFING

Case No. IPR2025-00123

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Other Authorities

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LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	Third Amended Docket Control Order, Dkt. 67, <i>Truesight Commc'ns LLC v. Samsung Elecs. Co.</i> , Case No. 2:23-cv-00643-JRG (E.D. Tex. Jan. 24, 2025)
2002	Defendants' Amended Invalidity Contentions and P.R. 3-3 and 3-4 Disclosures dated December 17, 2024 in <i>Truesight Commc'ns LLC v. Samsung Elecs. Co.</i> , Case No. 2:23-cv-00643-JRG (E.D. Tex.)

The rescission of the Interim Procedure restores the Board’s pre-June 2022 breadth of discretion to deny petitions, *e.g.*, by removing the former Director’s requirements that the Board not issue any *Fintiv* denials where the petition: (1) presents “compelling merits” of invalidity, and (2) accompanies a *Sotera* stipulation. With elimination of the “compelling merits” analysis, the Board need only consider the merits as part of one *Fintiv* factor. *F5 Networks, Inc. v WSOU Invs., LLC*, IPR2022-00239, Paper 12 at 12-13 (P.T.A.B. May, 19, 2022) (finding Factor 6 neutral when grounds meet the “reasonable likelihood” standard). Denials issued between *Sotera* and June 2022 show stipulations are merely part of one factor to be considered with a trial date. Here the rescission has substantially increased the weight of the *Fintiv* factors in favor of denial.

I. FACTOR 2: PROXIMITY OF THE TRIAL DATE TO THE FWD

Trial is scheduled in the District Court Litigation for October 6, 2025. Ex. 2001. The FWD statutory deadline is May 25, 2026, over seven months after trial. This proximity raises real concerns of duplication and conflicting decisions, which strongly favors denial. *See Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at

10-12 (P.T.A.B. Jun. 24, 2020) (FWD approximately ten months after trial).¹

II. FACTOR 4: OVERLAP AND INSUFFICIENT *SOTERA* STIPULATION

No dispute exists regarding the overlap of grounds. However, rescission of the Interim Procedure negates the argument that “institution will not be denied when . . . Petitioners present a *Sotera* stipulation.” Pet. at 88. *Sotera* stipulations are no longer dispositive and must be considered only as part of Factor 4. Prior to June 2022, when the Board considered a proffered stipulation under Factor 4, the Board routinely exercised its discretion to deny petitions. This is particularly true where the parallel case is in an advanced stage and trial is set to predate the FWD. *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 and finding *Sotera* applied when trial date was scheduled to begin around the same time as the deadline for FWD and the trial date factor was found neutral). Because there is a seven-month differential between the instant trial date and FWD deadline (weighing strongly in favor of denial) and because the other factors in this proceeding weigh against the proffered stipulation,

¹ *See also Edwards Lifesciences Corp. v. Evalve, Inc.*, IPR2019-01479, Paper 7, at 6-13 (P.T.A.B. Feb. 26, 2020); *Samsung Elecs. Am. Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020); *Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019).

the Board would be justified in exercising discretion to deny institution. *See, e.g., F5 Networks, Inc.*, IPR2022-00239, Paper 12 (trial predates FWD by six months); *Google LLC v. EcoFactor, Inc.*, IPR2021-00488, Paper 12 (P.T.A.B. Aug. 11, 2021) (trial predates FWD by six months); *Cisco Sys., Inc. v. Oyster Optics, LLC*, IPR2021-00238, Paper 10 (P.T.A.B. Jun. 1, 2021) (trial predates FWD by seven months).² In each of the above-cited cases, the proximity of the trial date outweighed a proffered stipulation after *Sotera*.

That said, Petitioners' stipulation is not "substantively identical" to *Sotera*. Petitioners reserve the right to raise the challenges in this proceeding not only if the Board declines institution, but also if it "later vacates institution of this IPR[]." Ex. 1020 at 1. The stipulation in *Sotera* had no such language. Indeed, the Board has previously declined to accept stipulations with similar qualifications. *See, e.g.,*

² *See also* IPR2020-01184, Paper 11 (P.T.A.B. Jan. 5, 2021); IPR2020-01317, Paper 15 (P.T.A.B. Jan. 15, 2021); IPR2021-00659, Paper 14 (P.T.A.B. Sept. 30, 2021); IPR2020-01028, Paper 12 (P.T.A.B. Jan. 13, 2021); IPR2020-01291, Paper 13 (P.T.A.B. Jan. 25, 2021); IPR2020-01400, Paper 13 (P.T.A.B. Fed. 3, 2021); IPR2020-01322, Paper 9 (P.T.A.B. Mar. 1, 2021); IPR2020-01227, Paper 11 (P.T.A.B. Mar. 4, 2021); IPR2021-00581, Paper 16 (P.T.A.B. June 10, 2021); IPR2021-00444, Paper 14 (P.T.A.B. Jul. 22, 2021).

Immersion Sys. LLC v. Midas Green Techs., LLC, PGR2021-00104, Paper 15 at 14-15 (P.T.A.B. Jan. 31, 2022) (finding a stipulation limited to institution “***that results in a final written decision***” insufficient to “assuage concerns” under *Fintiv* Factor 4.). Petitioners’ stipulation here carves out the same exception the Board rejected in *Immersion*, requiring a FWD. Moreover, in *Microsoft Corp. v. D3D Techs., Inc.*, to which Petitioners cite, the Board’s decision regarding the *Sotera* stipulation at issue was limited to that proceeding – it did not generally affirm conditioning a stipulation on institution is *always* appropriate. *See* IPR2021-00703, Paper 10 at 14 (P.T.A.B. Oct. 12, 2021) (“We are not persuaded that conditioning the stipulation on institution ***in the instant proceeding*** is improper.”) (emphasis added). Petitioners’ stipulation is, therefore, insufficient.

III. FACTOR 3: INVESTMENTS AND PETITIONERS’ DELAY

The district court case is at an advanced stage and investments have been substantial. The deadline to substantially complete document production passed on February 19, 2025, and the parties continue to supplement productions. Ex. 2001. Briefing of Petitioners’ motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6) is complete and subsequently denied. The parties exchanged preliminary and amended infringement and invalidity contentions. *Id.* Claim construction briefing is complete, and the *Markman* hearing is set for April 2, 2025 (over seven weeks prior to the deadline for the institution decision). *Id.* The end of fact discovery and expert report

deadline will occur within weeks of the institution decision. *Id.* Petitioner has failed to proffer any credible reason for their delay in filing.³ This factor weighs strongly for denial.

IV. ADDITIONAL FACTORS AND CONSIDERATIONS

The remaining *Fintiv* factors weigh strongly in favor of denying institution. On Factor 1, there is no stay, and the Board routinely avoids speculating on pending motions. 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). Because Petitioners have not filed IPR grounds on every asserted claim in all asserted patents, there is no risk of a stay of the District Court Litigation. *See* Paper 7.

V. CONCLUSION

For the foregoing reasons and the reasons set forth in the POPR, Patent Owner respectfully requests the Board deny institution of the Petition in its entirety.

³ The sole case relied on by Petitioners is inapposite, where the Board found petitioner was diligent in filing six months after infringement contentions where 135 claims were asserted across 15 patents against over 2,400 products in the parallel case. *See* IPR2021-01057, Paper 15 at 9-10 (P.T.A.B. Jan. 6, 2022)

Respectfully submitted,

Dated: March 24, 2025

By: /Peter Lambrianakos /
Peter Lambrianakos (Reg. No. 58,279)
Email: plambrianakos@fabricantllp.com
Lead Counsel for Patent Owner
Vincent J. Rubino, III (Reg. No. 68,594)
Email: vrubino@fabricantllp.com
Enrique W. Iturralde (Reg. No. 72,883)
Email: eiturralde@fabricantllp.com
Back-Up Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue
Suite 206 South
Rye, New York 10580
Telephone: 212-257-5797
Facsimile: 212-257-5796

John A. Rubino (Reg. No. 71,543)
Email: jarubino@rubinoip.com
Back-Up Counsel for Patent Owner
RUBINO IP
51 J.F.K. Parkway
Short Hills, New Jersey 07078
Telephone: (201) 341-9445
Facsimile: (973) 535-0921

CERTIFICATE OF SERVICE

A copy of the foregoing Patent Owner's Supplemental Briefing has been served on Petitioners' counsel of record as follows:

Jeffrey A. Miller
Email: jeffrey.miller@apomks.com
ARNOLD & PORTER KAYE SCHOLER LLP
5 Palo Alto Square, Suite 500
3000 El Camino Real
Palo Alto, CA 94306

Ali R. Sharifahmadian
Email: ali.sharifahmadian@arnoldporter.com
ARNOLD & PORTER KAYE SCHOLER LLP
601 Massachusetts Avenue, NW
Washington, DC 20001-3743

*Attorneys for Samsung Electronics Co., Ltd. and
Samsung Electronics America, Inc.*

March 24, 2025

By: /Peter Lambrianakos /
Peter Lambrianakos (Reg. No. 58,279)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796