

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

TRUESIGHT COMMUNICATIONS LLC,
Patent Owner.

IPR2025-00123
Patent 8,745,749 B2

Before JOSIAH C. COCKS, ROBERT J. WEINSCHENK, and
BACH V. HOANG, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

Samsung Electronics Co., Ltd. and Samsung Electronics, America, Inc. (“Petitioner”) filed a Petition (Paper 3, “Pet.”) requesting an *inter partes* review of claims 1–8 and 13–25 (“the challenged claims”) of U.S. Patent No. 8,745,749 B2 (Ex. 1001, “the ’749 patent”). Truesight Communications LLC (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”) to the Petition. With our authorization, Petitioner filed a Reply (Paper 9, “Reply”) to the Preliminary Response, and Patent Owner filed a Sur-reply (Paper 10, “Sur-reply”) to the Reply. For the reasons discussed below, we exercise our discretion under 35 U.S.C. § 314(a) to deny institution of an *inter partes* review.

B. *Real Parties in Interest*

The parties identify themselves as the only real parties in interest. Pet. 88; Paper 5, 2.

C. *Related Matters*

The parties indicate that the ’749 patent is the subject of the following district court cases: 1) *Truesight Communications LLC v. Samsung Electronics Co., Ltd.*, No. 2:23-cv-00643 (E.D. Tex.) (“District Court Litigation”); 2) *Truesight Communications LLC v. TCL Technology Group Corp.*, No. 2:24-cv-00032 (E.D. Tex.); and 3) *Truesight Communications LLC v. Lenovo Group Ltd.*, No. 2:24-cv-00031 (E.D. Tex.). Pet. 88–89; Paper 5, 2. Petitioner also identifies IPR2024-01477 as a related matter. Pet. 89.

D. The '749 Patent

The '749 patent relates to the “generation of virtual memory devices.” Ex. 1001, 1:13–15. The '749 patent states that “Secure Digital (SD) cards are in wide use for many storage applications,” including “to store audio (MP3 players), pictures (digital cameras), and full motion video (camcorders and HD camcorders).” *Id.* at 1:17–20. According to the '749 patent, “[t]he content stored on SD cards can be transferred or archived to devices with larger storage capacities and additional processing capabilities.” *Id.* at 1:23–26. However, “[m]aintaining [digital rights management] protection through transfers from [an] SD card to other memories cannot be archived easily.” *Id.* at 1:32–40.

To address this identified deficiency, the '749 patent describes a system “that provisions a virtual secure digital (SD) card.” *Id.* at 3:2–4. Specifically, “the system detects an SD card and reads a media key block and media identification for the SD card.” *Id.* at 3:4–6. “The system stores the media key block and the media identification,” “creates a file system for secure data storage corresponding to the SD card’s secure data area,” and “creates a file system for . . . storage of user data corresponding to the SD card’s user data area.” *Id.* at 3:6–11.

E. Illustrative Claim

Of the challenged claims, claims 1, 14, 18, and 22 are independent. Claim 1 is reproduced below.

1. A method for generating a virtual secure digital (SD) card, the method comprising:
 - reading a media key block and media identification for an SD card;
 - storing the media key block and the media identification;

creating a file system for secure data on a storage device for storage of secure data corresponding to a secure data area of the SD card; and

creating a file system for user data on the storage device for storage of user data corresponding to a user data area of the SD card, wherein a size of the file system for secure data is determinant on a size of the file system for user data, the determination based on a lookup table providing a relationship between the sizes.

Ex. 1001, 10:56–11:2.

F. Evidence

Petitioner submits the following evidence:

Evidence	Exhibit No.
Declaration of Erez Zadok, Ph.D. (“Zadok Declaration”)	1002
Maeda, US 6,611,907 B1, issued Aug. 26, 2003 (“Maeda”)	1006
Hamann, US 2002/0080190 A1, published June 27, 2002 (“Hamann”)	1007
Hirota, US 6,789,192 B2, issued Sept. 7, 2004 (“Hirota”)	1008
Lu, CN 100468438C, published Mar. 11, 2009 (“Lu”)	1009
Matsukawa, US 2012/0272065 A1, published Oct. 25, 2012 (“Matsukawa”)	1010

G. Asserted Grounds

Petitioner asserts that the challenged claims are unpatentable on the following grounds (Pet. 1–2):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 14–16, 18, 22–24	103(a) ¹	Maeda, Hamann, Applicant Admitted Prior Art (“AAPA”)
2, 6–8, 19	103(a)	Maeda, Hamann, AAPA, Hirota

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. Based on the effective filing date of the ’749 patent, we apply the pre-AIA version of § 103.

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
3–5, 17, 20, 21, 25	103(a)	Maeda, Hamann, AAPA, Hirota, Lu
13	103(a)	Maeda, Hamann, AAPA, Matsukawa

II. ANALYSIS

Patent Owner argues that we should exercise our discretion under 35 U.S.C. § 314(a) to deny the Petition in light of the District Court Litigation. Prelim. Resp. 18–26; Sur-reply 1–5. Section 314(a) states that

[t]he Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Under § 314(a), we have discretion to deny institution of an *inter partes* review. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016). We consider several factors when determining whether to deny institution under § 314(a) based on a parallel district court proceeding, specifically

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”).

A. Factor 1 – Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

Under the first *Fintiv* factor, we consider “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Id.* at 6. Patent Owner argues that the first factor “supports denial of institution” because the District Court “is unlikely to grant” Petitioner’s motion to stay the District Court Litigation. Prelim. Resp. 25–26; *see* Sur-reply 5. Petitioner contends that this factor is neutral because Petitioner’s motion to stay “remains pending.” Reply 4–5.

The District Court recently denied Petitioner’s motion to stay without prejudice. Ex. 2003, 3. The District Court stated that Petitioner’s motion “is premature” because the Board has not decided “whether or not to institute *inter partes* review.” *Id.* We decline to speculate based on the record in this case whether the District Court would grant a renewed motion to stay the District Court Litigation. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative) (“*Fintiv IP*”). As a result, we determine that the first *Fintiv* factor is neutral.

B. Factor 2 – Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision

Under the second *Fintiv* factor, we consider the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Fintiv*, Paper 11 at 6. Patent Owner argues that the second factor “strongly weighs in favor of discretionary denial” because “the District Court’s trial will be **more than seven months before** the projected statutory deadline.” Prelim. Resp. 22–24; *see* Sur-reply 1–2. Petitioner

argues that although the projected statutory deadline for a final written decision is “seven months after trial,” “the Board regularly institute[s] proceedings with similar (and even larger) gaps . . . where Petitioners provided *Sotera* stipulations.” Reply 4.

The current trial date in the District Court Litigation is October 6, 2025. Ex. 2001, 1. The projected statutory deadline for a final written decision in this case is in April 2026. Thus, the trial in the District Court Litigation is likely to occur at least six months before the projected statutory deadline for a final written decision in this case. As a result, we determine that the second *Fintiv* factor weighs in favor of discretionary denial of institution.

C. Factor 3 – Investment in the parallel proceeding by the court and the parties

Under the third *Fintiv* factor, we consider the “investment in the parallel proceeding by the court and the parties.” *Fintiv*, Paper 11 at 6. Patent Owner argues that factor three “weighs strongly for denial” because 1) “[t]he deadline to substantially complete document production passed”; 2) “[c]laim construction briefing is complete, and the *Markman* hearing is set for April 2, 2025”; and 3) “[t]he end of fact discovery and expert report deadline will occur within weeks of the institution decision.” Sur-reply 4–5. Petitioner argues that this factor “weighs against discretionary denial” because Petitioner “diligently filed this [Petition] six months after [Patent Owner] served infringement contentions . . . and over a month before serving its invalidity contentions.” Reply 3–4. Petitioner also argues that “much work would still remain as of the expected institution date, including

most fact discovery, all expert discovery, as well as dispositive motions.”
Id. at 3–4.

The evidence of record indicates that the District Court and the parties have invested significant resources in the District Court Litigation. The parties have exchanged infringement and invalidity contentions and substantially completed document production, and the District Court has held a claim construction hearing. Ex. 2001, 4–5. Further, shortly after this Decision, the parties will complete fact discovery and serve opening expert reports. *Id.* at 4. Petitioner filed the Petition ten months after Patent Owner filed its complaint in the District Court Litigation and five months after Patent Owner served its infringement contentions.² Pet. 89–90; Ex. 1021, 9. We find that the timing of the Petition does not outweigh the investment in the District Court Litigation. Accordingly, we determine that the third *Fintiv* factor weighs in favor of discretionary denial of institution.

D. Factor 4 – Overlap between issues raised in the petition and in the parallel proceeding

Under the fourth *Fintiv* factor, we consider the “overlap between issues raised in the petition and in the parallel proceeding.” *Fintiv*, Paper 11 at 6. Petitioner stipulates that “if the Patent Trial and Appeal Board (‘PTAB’) institutes this IPR petition on the grounds presented (a table of which is included below), then [Petitioner] will not pursue in the [District Court Litigation] any grounds that were raised or reasonably could have been raised in the IPR.” Ex. 1020. Petitioner further states that “if the

² Petitioner points out that it filed the Petition over a month before serving its *amended* invalidity contentions, but does not indicate when it served its *initial* invalidity contentions. See Reply 3; Ex. 2002.

PTAB either declines institution or later vacates institution of this IPR, [Petitioner] reserves the right to pursue in [the District Court Litigation] any ground that was raised or reasonably could have been raised in the IPR.” *Id.* Patent Owner argues that Petitioner’s stipulation is not “substantively identical” to the one in *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential), because Petitioner conditions its stipulation on the Board not vacating institution. Sur-reply 3–4; *see* Prelim. Resp. 21. Patent Owner also argues that Petitioner’s stipulation “is insufficient because there will still be issues related to conception and reduction to practice that will need to be addressed by the Board and the District Court.” Prelim. Resp. 21–22.

The Petition challenges claims 1–8 and 13–25, and relies on Maeda, Hamann, Hirota, Lu, and Matsukawa. Pet. 1–2. Petitioner’s invalidity contentions in the District Court Litigation rely on the same references. Ex. 2002, 700, 703. Nonetheless, Petitioner’s stipulation that it will not rely on any grounds that were raised or reasonably could have been raised in this case in the District Court Litigation mitigates any concerns of duplicative efforts and potentially conflicting decisions. Ex. 1020; *see Sotera*, Paper 12 at 18–19. Patent Owner does not explain specifically why the condition on Petitioner’s stipulation (i.e., that the Board does not vacate institution) changes the impact of Petitioner’s stipulation in this case. *See* Prelim. Resp. 21; Sur-reply 3–4. Thus, we determine the fourth *Fintiv* factor weighs strongly against exercising our discretion to deny institution.

E. Factor 5 – Whether the petitioner and the defendant in the parallel proceeding are the same party

Under the fifth *Fintiv* factor, we consider “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, Paper 11 at 6. Here, Petitioner is the defendant in the District Court Litigation, and the parties agree that the fifth factor favors denial. Prelim. Resp. 20; Reply 5. Thus, we determine that the fifth *Fintiv* factor weighs in favor of exercising our discretion to deny institution.

F. Factor 6 – Other circumstances that impact the Board’s exercise of discretion, including the merits

Under the sixth *Fintiv* factor, we consider “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv*, Paper 11 at 6. Patent Owner argues that “Petitioner does not present a strong case on the merits.” Prelim. Resp. 26. According to Patent Owner, Petitioner does not show sufficiently that the asserted references teach all the limitations of the challenged claims or that it would have been obvious to combine the asserted references. *Id.* at 6–18. Petitioner argues that the asserted grounds “are strong” and that Patent Owner “offers only unsupported attorney argument to rebut the substance of [Petitioner’s] unpatentability arguments.” Reply 5.

Petitioner disputes the arguments presented by Patent Owner in the Preliminary Response. Reply 5. Petitioner, though, does not explain specifically why the merits in this case are particularly strong. *See id.* Thus, we determine that the sixth *Fintiv* factor is neutral.

G. Summary

On balance, we determine that *Fintiv* factors 1–6 favor discretionary denial of institution. Specifically, as discussed above, factors 2, 3, and 5

each weigh in favor of discretionary denial, factor 4 weighs strongly against discretionary denial, and factors 1 and 6 are neutral. We determine that the projected trial date (at least six months before the projected statutory deadline for a final written decision) and the parties' significant investment in the District Court Litigation outweigh Petitioner's stipulation. Thus, based on our holistic view of the *Fintiv* factors, we exercise our discretion under § 314(a) to deny the Petition.

III. CONCLUSION

For the reasons discussed above, we exercise our discretion under § 314(a) to deny the Petition.

IV. ORDER

It is hereby

ORDERED that the Petition is denied, and no trial is instituted.

IPR2025-00123
Patent 8,745,749 B2

For PETITIONER:

Jeffrey A. Miller
Ali R. Sharifahmadian
ARNOLD & PORTER KAYE SCHOLER LLP
jeffrey.miller@apks.com
ali.sharifahmadian@arnoldporter.com

For PATENT OWNER:

Peter Lambrianakos
Vincent J. Rubino, III
Enrique W. Iturralde
FABRICANT LLP
plambrianakos@fabricantllp.com
vrubino@fabricantllp.com
eiturralde@fabricantllp.com

John A. Rubino
RUBINO IP
jarubino@rubinoip.com