

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

VASU HOLDINGS, LLC,
Patent Owner.

Case IPR2025-00449
U.S. Patent No. 10,368,281

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	PETITIONERS’ GROUNDS FOR CHALLENGE	4
III.	THE BOARD SHOULD DENY INSTITUTION UNDER <i>FINTIV</i>	5
A.	<i>Fintiv</i> Factor 1: There is Little to No Likelihood that a Stay Would be Granted in the Parallel District Court Proceeding.....	7
B.	<i>Fintiv</i> Factor 2: The District Court’s Scheduled Trial Date is Approximately Ten Months Before the Expected Date of Any Final Written Decision	11
C.	<i>Fintiv</i> Factor 3: Significant Investment in the Parallel Litigation Will Have Occurred by the Time the Board’s Institution Decision is Due	12
D.	<i>Fintiv</i> Factor 4: There is Substantial Overlap Between the IPR Proceeding and the Parallel Litigation	17
E.	<i>Fintiv</i> Factor 5: Petitioner is the Defendant in the Parallel Proceeding	22
F.	<i>Fintiv</i> Factor 6:	22
1.	The Petition Lacks Merit	22
2.	Petitioners’ Parallel Petitions Favor Denial.....	23
IV.	BRIEF OVERVIEW OF THE ’281 PATENT	26
A.	The ’281 Patent (Ex. 1001)	26
B.	Prosecution History of the ’281 Patent	27
V.	THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 325(D) BECAUSE PETITIONERS PRESENT SUBSTANTIALLY THE SAME ART AND ARGUMENTS.....	30

Patent Owner’s Request for Discretionary Denial
IPR2025-00449 (U.S. Patent No. 10,368,281)

A.	Substantially the Same Argument Was Previously Presented to the Office.....	31
B.	Substantially the Same Prior Art Was Already Before the Office.....	33
1.	Chaskar Was Previously Used in Rejections by the Examiner During the '281 Patent Examination.....	33
2.	Dorenbosch Is Cumulative to Another Reference by the Same Inventor That the Examiner Cited During Examination	35
3.	Willhoff is Cumulative to Art Previously Presented to and Considered by the Office	40
4.	Enzmann, and Donovan Are Also Cumulative to Art Considered by the Examiner During the '281 Patent Examination	43
5.	Iizuka Is Cumulative to Art Considered by the Examiner During Examination of the '281 Patent and Used During a Related '181 Patent Examination.....	48
C.	Petitioners Made No Showing of Material Error	52
VI.	CONCLUSION.....	54

TABLE OF AUTHORITIES

Cases

<i>Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH,</i> No. IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020).....	<i>passim</i>
<i>Apple Inc. v. Fintiv, Inc.,</i> No. IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020).....	<i>passim</i>
<i>Apple Inc. v. Optis Cellular Tech. LLC,</i> No. IPR2020-00465, Paper 13 (P.T.A.B. Sept. 17, 2020).....	19
<i>AT&T Servs. Inc. v. Asus Tech. Licensing Inc.,</i> No. IPR2024-01142, Paper 14 (P.T.A.B. Jan. 27, 2025)	17
<i>Cal. Inst. of Tech. v. Samsung Elecs. Co.,</i> No. 2:21-cv-00446-JRG, Dkt. No. 108, slip op. (E.D. Tex. Jan. 20, 2023)	8, 9
<i>Clear Imaging Rsch., LLC v. Samsung Elecs. Co.,</i> No. 2:19-cv-00326-JRG, 2020 WL 13886381 (E.D. Tex. Dec. 21, 2020).....	8
<i>Comcast Cable Comms., LLC v. Touchstream Techs., Inc.,</i> No. IPR2024-00323, Paper 13 (P.T.A.B. Jul. 24, 2024).....	15, 16
<i>Edwards Lifesciences Corp. v. Evalve, Inc.,</i> No. IPR2019-01479, Paper 7 (P.T.A.B. Feb. 26, 2020).....	19
<i>General Access Solutions Ltd. v. Cellco Partnership,</i> No. 2:22-cv-00394-JRG, Dkt. No. 225, slip op. (E.D. Tex. May 22, 2024)	10
<i>Global Tel*Link Corp. v. HLFIP Holding, Inc.,</i> No. IPR2021-00444, Paper 14 (P.T.A.B. Jul. 22, 2021).....	15, 16
<i>Intel Corp. v. Ax Wireless,</i> No. IPR2023-01140, Paper 12 (P.T.A.B. Feb. 14, 2024).....	25
<i>Intel Corp. v. VLSI Tech. LLC,</i> No. IPR2020-00106, Paper 17 (P.T.A.B. May 5, 2020)	20

Patent Owner's Request for Discretionary Denial
IPR2025-00449 (U.S. Patent No. 10,368,281)

<i>Lenovo Inc. v. Universal Connectivity Techs., Inc.</i> , No. IPR2024-01481, Paper 19 (P.T.A.B. Apr. 17, 2025)	11
<i>MyPort, Inc. v. Samsung Elecs. Co.</i> , No. 2:22-cv-00114-JRG, Dkt. No. 73, slip op. (E.D. Tex. June 13, 2023).....	9
<i>Motorola Solutions, Inc. v. Stellar, LLC.</i> , No. IPR2024-01205, Paper 19 (P.T.A.B. Mar. 28, 2025)	21, 22
<i>NXP USA, Inc. v. Impinj Inc.</i> , No. PGR2022-00005, Paper 18 (P.T.A.B. May 2, 2022).....	22
<i>Regeneron Pharms., Inc. v. Merus N.V.</i> , 864 F.3d 1343 (Fed. Cir. 2017)	48
<i>Resonant Sys., Inc. v. Sony Group Corp.</i> , No. 2:22-cv-00424-JRG, Dkt. No. 84, slip op. (E.D. Tex. Jul. 9, 2024).....	8, 9, 10
<i>Roku, Inc. v. IOENGINE, LLC</i> , No. IPR2022-01553, Paper 11 (P.T.A.B. May 5, 2023)	11
<i>Samsung Elecs. Co. v. Clear Imaging Rsch., LLC</i> , No. IPR2020-01401, Paper 12 (P.T.A.B. Feb. 17, 2021).....	23
<i>Samsung Elecs. Co. v. Mojo Mobility Inc.</i> , No. IPR2023-01094, Paper 11 (P.T.A.B. Feb. 9, 2024).....	15
<i>Samsung Elecs. Co. v. Secure Wi-Fi LLC</i> , No. IPR2024-01367, Paper 10 (P.T.A.B. Mar. 24, 2025)	12
<i>SharkNinja Operating LLC v. iRobot Corp.</i> , No. IPR2021-00544, Paper 7 (P.T.A.B. June. 25, 2021)	15
<i>Shenzhen Root Tech. Co. v. Chiaro Tech. Ltd.</i> , No. IPR2024-00953, Paper 18 (P.T.A.B. Dec. 16, 2024)	25
<i>Sony Grp. Corp. v. MZ Audio Scis., LLC</i> , No. IPR2022-01544, Paper 11 (P.T.A.B. Jan. 25, 2023)	34
<i>Sony Grp. Corp. v. MZ Audio Scis., LLC</i> , No. IPR2022-01544, Paper 12 at 7 (P.T.A.B. Apr. 21, 2023)	34

Patent Owner’s Request for Discretionary Denial
IPR2025-00449 (U.S. Patent No. 10,368,281)

<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , No. IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020)	21
<i>Supercell Oy v. Gree, Inc.</i> , No. IPR2020-01628, Paper 9 (P.T.A.B. Feb. 17, 2021).....	18, 19
<i>Toyota Motor Corp. v. Emerging Automotive LLC</i> , No. IPR2024-00785, Paper 13 (P.T.A.B. Mar. 11, 2025)	11
<i>Trover Grp., Inc. v. Dedicated Micros USA</i> , No. 2:13-cv-1047-WCB, 2015 WL 1069179 (E.D. Tex. Mar. 11, 2015).....	6, 7

Statutes

35 U.S.C. § 101	18
35 U.S.C. § 102	2, 7, 17, 21
35 U.S.C. § 103	2, 7, 17, 21
35 U.S.C. § 112	18
35 U.S.C. § 314(a)	5, 54
35 U.S.C. § 315(b)	6
35 U.S.C. § 316(b)	24
35 U.S.C. § 325(d)	<i>passim</i>

Other Authorities

PTAB Consolidated Trial Practice Guide (Nov. 2019)	24
USPTO Guidance Memorandum (P.T.A.B. March 24, 2025)	12

PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	U.S. Patent Application Publication No. 2005/0239498 ("Dorenbosch-498")
2002	Declaration of James Hannah in Support of Patent Owner's Request for Discretionary Denial
2003	Excerpt from U.S. District Court – National Judicial Caseload Profile Federal for the Eastern District of Texas, available at https://www.uscourts.gov/sites/default/files/2024-12/fcms_na_distprofile0930.2024.pdf
2004	Spreadsheet regarding Magistrate Judge Payne's average time to issue a <i>Markman</i> Order after a <i>Markman</i> hearing, from July 1, 2023, to present, exported from Docket Navigator, https://brochure.docketnavigator.com/
2005	Intentionally Omitted
2006	Intentionally Omitted
2007	Intentionally Omitted
2008	Order, <i>California Institute of Technology v. Samsung Electronics Co., Samsung Electronics America, Inc.</i> , Case No. 2:21-cv-00446-JRG, Dkt. No. 108 (E.D. Tex. Jan. 20, 2023)
2009	Order, <i>Resonant Systems, Inc., d/b/a RevelHMI v. Sony Group Corporation and Sony Interactive Entertainment Inc.</i> , Case No. 2:22-cv-00424-JRG, Dkt. No. 84 (E.D. Tex. July 9, 2024)
2010	Order, <i>MyPort, Inc. v. Samsung Electronics Co., Samsung Electronics America, Inc.</i> , Case No. 2:22-cv-00114-JRG, Dkt. No. 73 (E.D. Tex. June 13, 2023)
2011	Order, <i>General Access Solutions, Ltd. v. Cellco Partnership d/b/a Verizon Wireless</i> , Case No. 2:22-cv-00394-JRG, Dkt. No. 225 (E.D. Tex. May 22, 2024)

Patent Owner's Request for Discretionary Denial
IPR2025-00449 (U.S. Patent No. 10,368,281)

Exhibit	Description
2012	U.S. Patent Application Publication No. 2004/0030791 ("Dorenbosch-791")
2013	U.S. Patent Application Publication No. 2005/0059400 ("Jagadeesan")
2014	U.S. Patent Application Publication No. 2004/0153676 ("Krantz")
2015	U.S. Patent No. 7,398,088 ("Belkin")
2016	U.S. Patent No. 8,041,360 ("Ibe")
2017	Excerpts of File History for U.S Patent 8,886,181

I. INTRODUCTION

Patent Owner, Vasu Holdings, LLC, (“Vasu”), respectfully requests that the Acting Director exercise her discretion to deny this Petition challenging claims 23 and 45 (“the Challenged Claims”) of U.S. Patent No. 10,368,281 (Ex. 1001, “the ’281 Patent”), based on:

- (1) the advanced state of the corresponding district court litigation under *Apple Inc. v. Fintiv, Inc.*, because the District Court promises to be the faster and more efficient forum to address the same validity issues raised here given that Petitioners’ last-minute Petition allowed the District Court case to reach an advanced stage,
- (2) Petitioners’ reliance on the same or substantially the same art previously considered by the Office under 35 U.S.C. § 325(d), and
- (3) the Petition’s extensive use of expert testimony to fill in the “timer” limitation that was among the reasons for the Examiner’s allowance during the ’281 Patent’s examination.

First, the *Fintiv* factors strongly favor denial. Trial in the co-pending District Court litigation is scheduled to commence on November 3, 2025, which is ten months before the projected statutory final written decision deadline. Because Petitioners decided to wait to submit the Petition on the last day of the statutory window, the District Court case is close to the fact discovery deadline. Petitioners’

delay also effectively nullifies the effectiveness of their promise not to raise validity challenges under 35 U.S.C. §§ 102 and 103 if the Board institutes trial in this case because the parties will be litigating the same issues in both forums until *at least* the eve of trial. Indeed, if institution is denied in this case and Petitioners request rehearing, the District Court trial will likely be finished before any such request is decided.

With fact discovery closing on June 2, 2025, the parties narrowed the case several times, including on their own volition (and not simply based on Court deadlines), and the upcoming June 16, 2025 deadline for opening expert reports, there can be no question that the parties have already expended extensive resources in the case. By the time an institution decision is due in this case, the District Court—which has already dedicated resources to this case—will have conducted its *Markman* hearing (scheduled for tomorrow, May 13, 2025) and issued a claim construction order (expected by June 23, 2025). Under these circumstances, the District Court is highly unlikely to consider a renewed¹ motion to stay so close to the scheduled trial date.

Second, the Director should also deny this Petition under 35 U.S.C. § 325(d) because the grounds raised in the Petition are substantially similar to those raised

¹ Samsung's initial Motion to Stay was denied as premature on May 9, 2025.

and traversed during prosecution. The primary reference in every ground of the Petition, Chaskar, was cited in an Office Action and successfully traversed during examination because it does not disclose a timer that establishes a time window. Another reference, Dorenbosch, is substantially the same as a patent publication to Dorenbosch² that was also cited and traversed during examination. The remainder of Petitioners' references are cumulative to, or substantially the same as, other references the Examiner previously considered. Despite citing essentially the same art and arguments, Petitioners identify no error in the Examiner's determination that the prior art did not teach or suggest, for example, "wherein if a Wi-Fi signal monitor detects that a Wi-Fi signal level is below a second predefined threshold value V_{th2} ; the timer is activated to establish a second time window of a second predefined size $T2$, wherein a third predefined threshold value V_{th3} is smaller than V_{th2} ."

Third, the Director should exercise her discretion to deny institution because the Petition relies heavily on Petitioners' expert's conclusory opinions to use the alleged knowledge of a POSITA to fill in a timer-activation claim limitation missing from the prior art. That timer-activation claim limitation distinguished the '281 Patent from the prior art during examination. Petitioners knew this and could not

² U.S. Patent Publication No. 2005/0239498 to Dorenbosch ("Dorenbosch-498", Ex. 2001).

find prior art that teaches this missing limitation. Instead, Petitioners have asserted references recycled from the prosecution history of the '281 Patent and rely on their expert's conclusory opinions to fill in the missing elements. The Board's limited resources are better used elsewhere, rather than in a battle of experts better suited for the impending parallel district court litigation that will commence nearly ten months before a final written decision would be due in this case.

This request for discretionary denial of institution is authorized by the March 26, 2025, Memorandum regarding "Interim Processes for PTAB Workload Management" from the Acting Director of the United States Patent and Trademark Office. Vasu will discuss, in full, the reasons why the '281 Patent is patentable on the merits in its Patent Owner Preliminary Response due, June 10, 2025.

II. PETITIONERS' GROUNDS FOR CHALLENGE

The Petition presents the following prior art combinations as its respective grounds for invalidating claims of the '281 Patent:

Ground ³	Claims	Basis	References Relied Upon
1	23	§103	Enzmann, Dorenbosch, Chaskar, and Willhoff
2	45	§103	Iizuka, Chaskar, and Willhoff
3	23	§103	Enzmann, Dorenbosch, Chaskar, Willhoff, and Donovan
4	45	§103	Iizuka, Chaskar, Willhoff, and Donovan

Pet. at 7.

III. THE BOARD SHOULD DENY INSTITUTION UNDER *FINTIV*

The Board should deny institution under 35 U.S.C. § 314(a) because the *Fintiv* Factors overwhelmingly support denying institution. *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) (“*Fintiv*”). The projected statutory deadline for the final written decision in this case is ten months

³ Petitioners’ chart sets forth that “Grounds 3-4” provide Claims “23, 45” as being obvious over “Grounds 1-2 in further view of Donovan.” Pet. at 7. It is unclear from Petitioners’ chart whether Petitioners are challenging claims 23 and 45 both in each ground or separately and over what precise combination of references. And the Petition’s analysis and Petitioners’ expert testimony are equally ambiguous. Pet. at 78-82; Ex. 1003 at ¶¶ 215-221.

after trial is scheduled to commence in the District Court. By way of background, the District Court litigation complaint was filed over 15 months ago and served on January 24, 2024, in the Eastern District of Texas and assigned to Judge Gilstrap. Declaration of James Hannah (Ex. 2002, “Hannah Decl.”), ¶4. The trial is scheduled for November 3, 2025, which is consistent with the median time to trial in the Eastern District of Texas being 21.9 months (approximately November 21, 2025). *Id.*, ¶5; Exhibit 2003. Thus, the scheduled trial date weighs in favor of denying institution.

Petitioners' unexplained delay in filing the IPR petition on January 24, 2025, the very last day of the 12-month statutory deadline under 35 U.S.C. § 315(b), further weighs in favor of denying the Petition. Hannah Decl., ¶4. Indeed, the Petitioners' delay is largely why the District Court's trial will commence ten months prior to the Board's projected statutory final written decision deadline of September 10, 2026, for the Final Written Decision. *Id.*, ¶5.

Petitioners' actions in the District Court have been confounding. They filed a Motion to Stay Pending *Inter Partes* Review on April 18, 2025, even though the Eastern District of Texas has a “universal practice” of denying pre-institution motions to stay. Hannah Decl., ¶13; *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (“it is the universal practice” of courts in this District to deny pre-institution motions to stay). In addition to this doomed request to stay the case, Petitioners proposed on

April 18, 2025, that they would not pursue any §102 or §103 grounds in the litigation if the IPR is instituted. This proposal is neither efficient nor a true alternative to the District Court litigation because by the time the Board decides whether to institute trial in this case, the *Markman* Hearing and Order are expected, expert report briefing will have been completed, and dispositive briefings and *Daubert* motions will have been completed. Hannah Decl., ¶17.

A. *Fintiv* Factor 1: There is Little to No Likelihood that a Stay Would be Granted in the Parallel District Court Proceeding

Fintiv Factor 1 favors discretionary denial, or is at the very least neutral, in this case, because Magistrate Judge Payne denied Petitioners' Motion to Stay on May 9, 2025, as premature, and neither the Magistrate Judge nor Judge Gilstrap is likely to stay any renewed motion to stay the case with only two months away from trial. *Id.*, ¶13.

Magistrate Judge Payne's denial of Petitioners' motion to stay—filed roughly three months after Petitioners' submitted this IPR petition—accords with the Eastern District of Texas's "universal practice" of denying motions to stay that are filed before the Board's institution decision. *Trover Grp., Inc.*, 2015 WL 1069179, at *6 ("it is the universal practice" of courts in this District to deny pre-institution motions to stay). And to the extent that Petitioners file a renewed motion to stay the case in September, based on the Office instituting one or more of the five IPRs filed against Vasu's patents, it is highly unlikely that such a motion would succeed.

Indeed, Judge Gilstrap consistently denies requests to stay the litigation when a last-minute IPR petition is submitted. To date, Judge Gilstrap has denied nearly every petitioner's motion to stay when the IPR petition was filed 10 months or later after receiving the complaint. For example, in *Cal. Inst. of Tech. v. Samsung Elecs. Co.*, Judge Gilstrap found that Samsung's 10-month delay in filing its IPRs disfavored a stay. Moreover, a stay "would [have] do[ne] nothing more than draw out the time to trial." Ex. 2008, No. 2:21-cv-00446-JRG, Dkt. No. 108, slip op. at 5 (E.D. Tex. Jan. 20, 2023); *Clear Imaging Rsch., LLC v. Samsung Elecs. Co.*, No. 2:19-cv-00326-JRG, 2020 WL 13886381, at *2 (E.D. Tex. Dec. 21, 2020) (denying stay where Samsung filed its IPRs 10 months after receiving complaint). This has been the case, even when petitioners file their motions to stay *after* the Board has decided its institution decision. See Ex. 2009, *Resonant Sys., Inc. v. Sony Group Corp.*, No. 2:22-cv-00424-JRG, Dkt. No. 84, slip op. at 4-5 (E.D. Tex. Jul. 9, 2024) (denying a motion to stay where petitioner waited 10 months after service of the lawsuit to file its IPRs, which "necessarily extended the potential resolution of the IPRs until well after the scheduled trial date").

Here, Petitioners' delay was even longer, as Petitioners waited to file the Petition until the very last day of the 12-month statutory deadline. Hannah Decl., ¶4. As a result, Petitioners' delayed IPR filings will cause jury selection to occur approximately ten months before the Board's statutory final written decision

deadline, significantly longer than the two months in *Cal. Inst. of Tech.* and eight months in *Resonant Systems, Inc.* Ex. 2008, slip op. at 5; Ex. 2009, slip op. at 4-5.

Judge Gilstrap also routinely denies motions to stay where, as here, the case is in an advanced stage, as the “parties [have] engaged in extensive discovery.” *See infra* (Factor 3); Ex. 2008, *Cal. Inst. of Tech.*, slip op. at 5 (stage of litigation disfavored stay because, in addition to petitioner’s delayed IPR filings, “[t]he parties [have] engaged in extensive discovery, including the exchange of ‘tens of thousands of documents,’ interrogatories, depositions, source code inspection, third-party discovery, and infringement and invalidity contentions); Ex. 2010, *MyPort, Inc. v. Samsung Elecs. Co.*, No. 2:22-cv-00114-JRG, Dkt. No. 73, slip op. at 4 (E.D. Tex. June 13, 2023) (the stage of litigation disfavored a stay where discovery was well underway, where thousands of documents had been exchanged, depositions were taken, and source code inspections had occurred). Here, Petitioners have produced over 65,600 documents and 3.96 GB of source code, which Vasu’s counsel reviewed for 10 days. The parties have also served infringement and invalidity contentions, and exchanged multiple sets of discovery requests and responses, including 75 interrogatories, 7 third-party subpoenas, and 44 requests for admission. Six depositions are scheduled to take place in South Korea beginning May 20, and Vasu’s 30(b)(6) depositions are scheduled to take place starting May 29. Hannah Decl., ¶¶10-12.

In any event, Judge Gilstrap has found that a delayed IPR filing tips the “stage of litigation” factor against a stay, even if claim construction, fact discovery, and expert discovery had not been completed when the motion to stay was filed. *See* Ex. 2009, *Resonant Sys.*, slip op. at 4-5.

Furthermore, Judge Gilstrap has also denied a petitioner's motion to stay, even when, as here, the petitioner proposes a statement that it will not pursue invalidity before the District Court. In *General Access Solutions Ltd. v. Cellco Partnership*, Judge Gilstrap denied a motion to stay despite the defendant's stipulation, given that “a possibility that resolution of the IPRs could simplify the issues of th[e] case . . . [wa]s not a certainty.” Ex. 2011, No. 2:22-cv-00394-JRG, Dkt. No. 225, slip op. at 4-5 (E.D. Tex. May 22, 2024).

Accordingly, *Fintiv* Factor 1 weighs in favor of denying institution because there is little to no likelihood that the District Court will stay the co-pending litigation. At the very least, Factor 1 is neutral, given that it is highly likely, though not necessarily a foregone conclusion, that the District Court will deny the request for a stay.

B. *Fintiv* Factor 2: The District Court's Scheduled Trial Date is Approximately Ten Months Before the Expected Date of Any Final Written Decision

Fintiv Factor 2 strongly favors discretionary denial because the District Court trial is scheduled to commence on November 3, 2025, approximately 10 months⁴ before the September 10, 2026, deadline to issue a final written decision in this case. Hannah Decl., ¶5; *see, e.g., Lenovo Inc. v. Universal Connectivity Techs., Inc.*, No. IPR2024-01481, Paper 19 at 10-11 (P.T.A.B. Apr. 17, 2025) (finding Factor 2 strongly favored discretionary denial where Board's final written decision expected six months after trial according to scheduling order or nine months after according to time-to-trial statistics for court); *Roku, Inc. v. IOENGINE, LLC*, No. IPR2022-01553, Paper 11 at 10-11 (P.T.A.B. May 5, 2023) (finding Factor 2 strongly favored discretionary denial where Board's final written decision expected six months after trial according to scheduling trial date or six months after according to time-to-trial statistics for court); *Toyota Motor Corp. v. Emerging Automotive LLC*, No.

⁴ Petitioners improperly focus their *Factor 2* analysis on the projected institution decision date rather than the projected final written decision deadline. Pet. at 12; *see Fintiv*, Paper 11 at 6, 9 (defining factor 2 as “proximity of the court’s trial date to the Board’s projected statutory deadline for *a final written decision*”) (emphasis added).

IPR2024-00785, Paper 13 at 12-13 (P.T.A.B. Mar. 11, 2025) (finding Factor 2 weighed “heavily in favor of discretionary denial” because trial scheduled approximately eight months before Board’s expected final written decision).

The median time-to-trial in the Eastern District of Texas is 21.9 months (i.e., approximately November 21, 2025), which “lends credibility to” the November 3, 2025, trial date. Exhibit 2003; *Samsung Elecs. Co. v. Secure Wi-Fi LLC*, No. IPR2024-01367, Paper 10 at 12-13 (P.T.A.B. Mar. 24, 2025) (finding that Factor 2 weighed heavily in favor of denial and recognizing Judge Gilstrap’s time-to-trial statistics as lending credibility to scheduled trial date, which was set to occur five months before final written decision deadline); *see also* March 24, 2025 USPTO Guidance Memorandum, at 3 (“[T]he Board may consider any evidence . . . that bears on the proximity of the district court’s trial date . . . including median time-to-trial statistics . . . in the district court in which the parallel litigation resides.”).

Therefore, *Fintiv* Factor 2 weighs strongly in favor of the Board exercising its discretion to deny institution.

C. *Fintiv* Factor 3: Significant Investment in the Parallel Litigation Will Have Occurred by the Time the Board’s Institution Decision is Due

Fintiv Factor 3 favors discretionary denial because (1) significant investment has occurred and continues to occur in the co-pending District Court litigation and (2) Petitioners filed the Petition *on the day of* the statutory deadline.

Before the Board's expected September 10, 2025, institution decision, the parties will have already expended significant investment conducting discovery in the District Court litigation. Hannah Decl., ¶¶10-12. The parties have already served and supplemented their respective infringement and invalidity contentions multiple times. *Id.*, ¶6. The fact discovery is nearly upon the parties, set to close on June 2, 2025. *Id.*, ¶12. As of the filing of this brief, both parties have served several sets of discovery requests and responses, 44 requests for admission, 162 requests for production, and 75 interrogatory requests. *Id.*, ¶10. Initial disclosures were served, identifying relevant witnesses who are scheduled to be deposed. *Id.*

Petitioners have produced over 65,600 documents and made over 3.96 GB of source code available for inspection, in which Vasu's outside counsel have already devoted 10 days to review. *Id.*, ¶12. Vasu's expert is expected to review the source code beginning on May 28, 2025. *Id.* The parties have collectively served 19 Rule 30(b)(1) and 30(b)(6) deposition notices, and 7 subpoenas. *Id.*, ¶11. In fact, Petitioners served 87 topics for deposition on Vasu as recently as April 17, 2025, which is scheduled to take place on May 29, 2025 and June 2, 2025. Thus, Petitioners have demonstrated their efforts to complete discovery before the June 2, 2025 fact discovery cutoff. *Id.*, ¶¶10-12. On April 22, 2025, Vasu filed a Motion to Compel Documents and Discovery Responses. Decl. *Id.*, ¶14.

To date, the District Court will also have devoted a significant amount of resources toward resolving the dispute. The parties have completed claim construction briefing, and the *Markman* hearing is scheduled to occur on May 13, 2025. Hannah Decl., ¶15. Magistrate Judge Payne—who will preside over the *Markman* Hearing—issues *Markman* Orders on average approximately 40 days after conducting the *Markman* Hearings. Exhibit 2004; Hannah Decl., ¶15 (calculated based upon Magistrate Judge Payne's *Markman* Orders issued from July 1, 2023 to present). Accordingly, the parties can expect the Judge's *Markman* Order around June 23, 2025, roughly two months before the Board's institution decision deadline. Hannah Decl., ¶15.

Judge Gilstrap also appointed a technical advisor for the case. *Id.*, ¶16. The parties, who are responsible for paying the technical advisor's fees and expenses, have already provided him with all of the claim construction briefs, exhibits, and technology tutorials. Opening and rebuttal expert reports will also have been served by July 7, 2025, with expert discovery closing on July 21, 2025. *Id.*, ¶17. Furthermore, dispositive motions and summary judgment will have been fully briefed by August 25, 2025, all involving these grounds and prior art, along with potential *Daubert* motions. *Id.* Notably, the Court's technical advisor and the parties' experts will have considered these materials for their respective tasks involved in the litigation. *Id.*

The Board has repeatedly weighed Factor 3 in favor of denying institution given this level of investment in the parallel proceeding. Specifically, substantial investment has been found where there has been substantial preparation for a *Markman* hearing (including completed briefing), and the hearing occurs prior to the Board's expected institution decision. *See Samsung Elecs. Co. v. Mojo Mobility Inc.*, No. IPR2023-01094, Paper 11 at 9 (P.T.A.B. Feb. 9, 2024); *see also Comcast Cable Comms., LLC v. Touchstream Techs., Inc.*, No. IPR2024-00323, Paper 13 at 9-10 (P.T.A.B. Jul. 24, 2024) (finding Factor 3 favored denial where fact and expert discovery and claim construction briefings and hearings completed before institution deadline); *SharkNinja Operating LLC v. iRobot Corp.*, No. IPR2021-00544, Paper 7 at 9-10 (P.T.A.B. June. 25, 2021) (Factor 3 weighed in favor of denial where invalidity and infringement charts served, *Markman* hearing scheduled and *Markman* order expected before Board's institution deadline, and expert reports due before Board's institution deadline).

Aside from the substantial investment by the parties and District Court, Factor 3 also weighs in favor of denying the Petition because Petitioners did not file the Petition expeditiously. *See Global Tel*Link Corp. v. HLFIP Holding, Inc.*, No. IPR2021-00444, Paper 14 at 22-23 (P.T.A.B. Jul. 22, 2021) (lack of diligence in filing the Petition where IPRs filed four days before statutory deadline weighs Factor 3 strongly in favor of denial). After all, "[i]f Petitioner[s] w[ere] diligent in filing

the Petition, that diligence could potentially mitigate some of the investments in parallel proceedings that are at issue.” *Id.* at 22. This Petition was filed even closer to the statutory deadline than in *Global Tel*Link*, and Petitioners’ delay has allowed the co-pending litigation to reach an advanced stage. Hannah Decl., ¶¶4, 10-12.

Further confirming Petitioners’ lack of diligence, the Petition was filed eight months after Vasu served its Asserted Claims and Preliminary Infringement Contentions (May 15, 2024) and nearly five months after Petitioners served their initial invalidity contentions (July 31, 2024). Hannah Decl., ¶6; *see Comcast Cable*, Paper 13 at 9-10 (finding Factor 3 favored denial where (1) fact and expert discovery and claim construction briefings and hearings completed before institution deadline; and (2) petitioner’s seven-month delay in filing petition after learning of asserted claims and nearly five-month delay after receiving initial invalidity contentions).

Petitioners’ unsupported statement that they have “diligently prepared and filed these IPRs,”⁵ (Pet. at 12-13), cannot save Petitioners from their delays. Indeed, they cite to no prior decisions of the Board where such an unexplained delay was

⁵ Petitioners likewise postponed filing IPR2025-00446, -00447, -00448, and 0050, which correspond to Vasu’ other asserted patents in this case. Petitioners filed IPR2025-00448, and -00450 on the final day of the statutory deadline, and IPR2025-00446, and -00447 the day before the statutory deadline.

found to be diligent. *Cf. AT&T Servs. Inc. v. Asus Tech. Licensing Inc.*, No. IPR2024-01142, Paper 14 at 14-15 (P.T.A.B. Jan. 27, 2025) (finding Factor 3 favored denial because “Petitioner waited five months to file [its] Petition after receiving Patent Owner’s infringement contentions, and Petitioner ha[d] not presented any factual evidence to justify this delay”); *Fintiv*, Paper 11 at 11-12 (“[T]he parties should explain facts relevant to timing” and “if the petitioner cannot explain the delay in filing its petition, [this fact has] favored denial.”).

Therefore, Factor 3 weighs strongly in favor of denial.

D. *Fintiv* Factor 4: There is Substantial Overlap Between the IPR Proceeding and the Parallel Litigation

Fintiv Factor 4 favors discretionary denial because Petitioners challenge “the same or substantially the same claims, grounds, arguments, and evidence” as in the parallel District Court litigation. *Fintiv*, Paper 11 at 12-13. And while Petitioners’ statement⁶ may lessen the chance of inconsistent decisions between the PTAB and

⁶ Petitioners have proposed a statement to forego their 35 U.S.C. §§ 102 and 103 challenges before the District Court in the event that if the Board institutes trial. Petitioners have not agreed to drop all invalidity challenges, however, including any

District Court, Petitioners' delay in filing the Petition and the contingent nature of its proposed statement means that the parties will be litigating essentially the same issues in the IPR and District Court *at least* until the institution decision deadline, and potentially longer (in the event that institution is denied but Petitioner files a Request for Rehearing or Director Review).

The same claims collectively challenged in the two IPR Petitions involving the '281 patent⁷ (Claims 1, 12, 23, 31, 37, and 45) are at issue in the District Court litigation (Claims 1, 12, 23, 31, 37, and 45). Hannah Decl., ¶¶2, 3; *see Supercell Oy v. Gree, Inc.*, No. IPR2020-01628, Paper 9 at 12-13 (P.T.A.B. Feb. 17, 2021) (finding Factor 4 favoring denial of institution where petition involved “exact same challenged claims” and substantially similar prior art as in district court litigation).

There is also a “substantial overlap of issues concerning the prior art,” given that Petitioners have selected to pursue before the District Court four of Petitioners' six asserted references asserted here, namely, Enzmann, Chaskar, Willhoff, and

challenges based on obviousness double-type patenting, and 35 U.S.C. §§ 101 and 112.

⁷ Petitioners filed two IPR Petitions for the '281 Patent (IPR2025-00448 and IPR2025-00449). Claims 1, 12, 31, and 37 are challenged in IPR2025-00448. Claims 23 and 45 are challenged in IPR2025-00449.

Iizuka. Hannah Decl., ¶7; *see Apple Inc. v. Optis Cellular Tech. LLC*, No. IPR2020-00465, Paper 13 at 20-21 (P.T.A.B. Sept. 17, 2020) (recognizing “substantial overlap of issues concerning the prior art” and even though “the combinations of four references asserted by Petitioner at [District Court] and in the Petition are different, two of the references including the primary reference [], are the same in both combinations”).

Petitioners' addition of Donovan as a secondary reference to address the “sleep mode” limitations of Claims 23 and 45 does not “meaningfully differentiate the arguments presented in the Petition from the arguments made in the [D]istrict [C]ourt” either. Hannah Decl., ¶8; *Edwards Lifesciences Corp. v. Evalve, Inc.*, No. IPR2019-01479, Paper 7 at 11 (P.T.A.B. Feb. 26, 2020); *see Supercell Oy*, Paper 9 at 11-13 (finding Factor 4 favored denial and finding substantial similarity between petition and district court litigation where same prior art asserted except for one additional dependent claim and reference in petition). While Donovan has not been presented in the District Court litigation for the '281 Patent, Petitioners already point to 16 other references for claim limitation 23[g] and 16 for claim limitation 45[d] and “do[] not explain how [their] arguments based on [Donovan] address any potential weaknesses in [these other] invalidity [contention references].” Hannah Decl., ¶8; *Edwards Lifesciences*, Paper 7 at 10-11 (finding Factor 4 weighed in favor

of denial because petitioner failed to indicate how petition reference filled in any gaps from those already listed in its invalidity contentions).

Likewise, Petitioners rely on Dorenbosch as a secondary reference for Claim 23 despite citing various other references in their invalidity contentions—21 for claim 23[a], 8 for 23[b], 24 for 23[c], 6 for 23[d], and 16 for 23[g]—and do not explain how Dorenbosch addresses any potential weaknesses in these other references. Hannah Decl., ¶9.

Notably, the Dorenbosch reference cited in the Petition is cumulative of the Dorenbosch '498 reference from Petitioners' invalidity contentions. Hannah Decl., ¶¶7, 9; *see* § V.B.2, *infra*. As described in further detail below, both references share the same primary inventor, Jheroen P. Dorenbosch, and have substantially the same disclosures.

Petitioners' sole argument in their Petition that the District Court litigation “will involve multiple grounds of invalidity not at issue here, enabling the court to focus its limited trial time on different invalidity defenses” is also unavailing, given the Board's past rejection of such arguments. Pet. at 12-13; *see, e.g., Intel Corp. v. VLSI Tech. LLC*, No. IPR2020-00106, Paper 17 at 10-11 (P.T.A.B. May 5, 2020) (“Although Petitioner's Final Invalidity Contentions include numerous other combinations of references challenging overlapping claims, . . . that difference alone does not negate that the same combinations of references asserted in the Petition are

also asserted in Petitioner's Final Invalidity Contentions"). On the contrary, it would be most efficient for the District Court to handle all of the parties' disputes rather than bifurcate validity issues, especially because the District Court litigation will resolve all of those issues while any trial instituted on this Petition remains in its earliest stages.

While Petitioners submitted a statement offering to withdraw all §102 and §103 challenges if the IPR is instituted, this is not a "true alternative' to the [D]istrict [C]ourt proceeding." *Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020). Specifically, it will not "mitigate[] any concerns of duplicative efforts between the [D]istrict [C]ourt and the Board" or "of potentially conflicting decisions." *Id.* Before the Board is scheduled to issue an institution decision, on September 10, 2025, expert reports and summary judgment motions in District Court addressing the same prior art asserted here will have already been completed. Hannah Decl., ¶¶7, 17; *see* § III.C, *supra*. Because the parties will have already invested a substantial amount of time and effort addressing the § 103 issues in District Court involving the same art presented here, Petitioners' statement will not have mitigated any duplicative concerns that a statement that is a true alternative to what the District Court would accomplish.

Nor does Petitioners' statement outweigh the other *Fintiv* Factors. The Director's recent decision in *Motorola Solutions, Inc. v. Stellar, LLC* emphasized

the non-dispositive nature of a *Sotera*-stipulation. There, the Director vacated and denied institution because the “Board did not give enough weight to the investment in the parallel proceeding and gave too much weight to Petitioners’ *Sotera* stipulation.” IPR2024-01205, Paper 19 at 2, 4 (P.T.A.B. Mar. 28, 2025) (reversing Board’s grant of institution based on the *Fintiv* Factors “as a whole”). Here, too, the investment in the parallel proceeding greatly outweighs the effect of Petitioners’ statement.

Therefore, for at least the foregoing reasons, *Fintiv* Factor 4 weighs in favor of the Board exercising its discretion to deny institution.

E. *Fintiv* Factor 5: Petitioner is the Defendant in the Parallel Proceeding

Fintiv Factor 5 weighs in favor of exercising discretionary denial because the parties are the same in both proceedings. *Fintiv*, Paper 11 at 13-14.

F. *Fintiv* Factor 6:

1. The Petition Lacks Merit

Factor 6 weighs in favor of denying institution if the Board deems analysis of this Factor necessary. Here, because a bulk of the other *Fintiv* Factors favor discretionary denial, the Board “need not decide whether the merits of Petitioners’ asserted grounds are particularly strong because it would not impact [their] ultimate determination” since the facts weighing in favor of discretionary denial collectively outweigh the merits. *NXP USA, Inc. v. Impinj Inc.*, No. PGR2022-00005, Paper 18

at 12-13 (P.T.A.B. May 2, 2022) (finding Factor 6 analysis unnecessary and denying institution based on Factors 1-5 where Factor 1 was neutral and Factors 2-5 slightly favored denial); *see also Samsung Elecs. Co. v. Clear Imaging Rsch., LLC*, No. IPR2020-01401, Paper 12 at 23-24 (P.T.A.B. Feb. 17, 2021) (finding Factor 6 did not outweigh the other *Fintiv* Factors favoring denial, where Factors 1 and 4 slightly favored denial, 2 and 3 weighed strongly in favor of denial and Factor 5 weighed in favor of denial). Moreover, the Board need not consider the merits under Factor 6, given that the other *Fintiv* Factors favor denying institution.

Nonetheless, even if the merits of Petitioners' asserted grounds and prior art are considered, Factor 6 favors discretionary denial because Petitioners fail to show a reasonable likelihood of success on any challenged claim, as evidenced in the incorporated § 325(d) arguments section. *See* § V.A, *infra*.

Furthermore, Petitioners failed to establish a reasonable likelihood—and certainly do not meet the higher “compelling” merits threshold that Petitioners asserted—that any claim of the '281 Patent is obvious over the art asserted in the Petition, including Chaskar, Dorenbosch, Willhoff, Donovan, Iizuka, and Enzmann. *See* § V.A-B, *infra*; Pet. at 13.

2. Petitioners' Parallel Petitions Favor Denial

Fintiv instructs that the weighing of factor 6 includes other considerations, such as “the filing of . . . parallel petitions challenging the same patent.” *Fintiv*,

Paper 11 at 16. Moreover, the Board's Consolidated Trial Practice Guide counsels against filing parallel petitions, indicating that "one petition should be sufficient to challenge the claims of a patent in most situations" and only grants such petitions in "rare" situations. PTAB Consolidated Trial Practice Guide at 59 (Nov. 2019). Here, Petitioners' parallel filings "against the same ['281] patent at . . . the same time (e.g., before the first preliminary response by the patent owner)" weighs against granting institution because it "may place a substantial and unnecessary burden on the Board . . . and could raise fairness, timing, and efficiency concerns." *Id.* (citing 35 U.S.C. § 316(b)).

Indeed, there is nothing remarkable about Petitioners' parallel '281 petitions that justifies circumventing the Petition's 14,000-word count limitation or being afforded multiple shots at the '281 Patent. Paper 3 ("Pet. Ranking") at 1 ("Petition 1 . . . is 13,990 words. Petition 2 . . . is 13,981 words."). This is not a case where "there is a dispute about priority date requiring arguments under multiple prior art references," given that Petitioner does not assert that two petitions were necessary to address priority date issues. PTAB Consolidated Trial Practice Guide at 59; *see* Pet. Ranking at 1-3.

Nor have Petitioners demonstrated "material differences" between the parallel petitions justifying their institution. As this Board has expressly noted, "[t]he mere fact that different references are asserted in this proceeding and the [other parallel]

IPR is not a justification for a parallel petition.” *Shenzhen Root Tech. Co. v. Chiaro Tech. Ltd.*, No. IPR2024-00953, Paper 18 at 10-11 (P.T.A.B. Dec. 16, 2024). Petitioners’ qualm with the “length of the [6] challenged claims” is also unpersuasive, given the Board’s rejection of these justifications in cases involving 14 claims. Pet. Ranking at 1-2; *Intel Corp. v. Ax Wireless*, No. IPR2023-01140, Paper 12 at 7-8 (P.T.A.B. Feb. 14, 2024) (“We disagree with Petitioner that fourteen claims is an inordinate number . . . [and] also find unavailing Petitioners’ argument that multiple petitions are justified because of ‘the length of the independent claims.’”).

Therefore, in view of the foregoing, *Fintiv* Factor 6, if considered, weighs in favor of the Board denying institution.

* * *

Based on a holistic weighing of the *Fintiv* Factors 1 through 6, Vasu respectfully requests that the Director deny institution:

<i>Fintiv</i> Factor	Discretionary Denial Weight
1	Weights in favor of denial or is neutral.
2	Weights strongly in favor of denial.
3	Weights strongly in favor of denial.
4	Weights in favor of denial.

5	Weights in favor of denial.
6	Weights in favor of denial (if consideration of this factor is necessary).

IV. BRIEF OVERVIEW OF THE '281 PATENT

A. The '281 Patent (Ex. 1001)

The '281 Patent is directed towards a mobile communication device configured to automatically switch a communication that is already in progress using a cellular network to a wireless Voice over IP (VoIP) network, or vice versa. '281 Patent at 2:36-41. This invention addressed the cumbersome problem of having to “manually change the device’s setting by, e.g., pressing one [or] more keys” or the reliability issue stemming from “switching of the call from cellular to VoIP or vice versa [that] may result in the loss of the call.” *Id.* at 2:15-32.

The '281 Patent discloses a mobile communication device having a timer. If the mobile device is conducting a call with its cellular communication module and its Wi-Fi antenna system detects a Wi-Fi signal having a predefined threshold level (strength), that timer is activated to establish a first time window having a predetermined length. *Id.* at 2:54-67. If the Wi-Fi signal level detected during this window at least meets the predefined threshold at the expiration of the timer, the mobile communication device’s switching system causes the in-progress

communication to be switched from its cellular module to its Wi-Fi communication module and through a VoIP network without losing the in-progress cellular call. *Id.*

The Wi-Fi communication module is also configured to change state from a sleep mode (during which the Wi-Fi communication module consumes relatively small amounts of power) to a standby mode (during which the Wi-Fi communication module consumes an intermediate amount of power). *Id.* at 3:1-6. Before the in-progress communication is switched to the Wi-Fi communication module, the mobile communication device causes the module to switch to a full active mode, during which the Wi-Fi communication module consumes an amount of power larger than an intermediate amount of power. *Id.* at 3:6:12.

B. Prosecution History of the '281 Patent

The '281 Patent issued from U.S. Patent Application No. 15/480,293, filed on April 5, 2017. Ex. 1002 at 56 (Filing Receipt). The '281 Patent is a continuation application in a chain of continuation applications starting from U.S. Patent Application No. 11/031,498 ("the '498 Application"), filed on January 6, 2005, which claims priority to U.S. Provisional Application No. 60/534,466 filed January 6, 2004. *Id.*

Additionally, the '281 Patent is related to U.S. Patent Application No. 13/240,776, which issued as U.S. Patent No. 8,886,181 ("the '181 Patent") on November 11, 2014. The '181 Patent is a divisional application of U.S. Patent

Application No. 11/330,675, filed on January 11, 2006, and is a continuation-in-part of the '498 Application.

The '281 Patent was subject to a comprehensive and substantive examination by the Office. In a January 16, 2018 Office Action and April 4, 2018 Final Office Action, the Examiner rejected the claims using combinations of U.S. Patent Publication No. 2004/0030791 to Dorenbosch ("Dorenbosch-791," Ex. 2012), U.S. Patent Publication No. 2005/0059400 to Jagadeesan ("Jagadeesan," Ex. 2013), U.S. Patent Publication No. 2005/0239498 to Dorenbosch ("Dorenbosch-498", Ex. 2001), and Chaskar (Ex. 1004). *See* Ex. 1002 at 435-444 (Non-Final Office Action dated 1/16/18); *see also id.* at 493-499 (Final Office Action dated 4/4/2018).

In response, Applicant distinguished the '281 Patent's claims over the Examiner's rejections by various claim amendments and arguments. Ex. 1002 at 567, 570, 573, 575 (amending pending claims 17, 45, 76, 85 [issued claims 1, 23, 37, and 45] to add "wherein upon activation of a timer, the switching system causes the second communication module to change state from a sleep mode to an active mode, wherein the timer is activated to establish a time window of a predefined size"); *id.* at 569 (amending 33 [issued claim 12] to recite third and fourth contexts, and second and third threshold values); *id.* at 571 (amending claim 56 [issued claim 31] to recite "wherein if a signal monitor detects that the alternative signal level is below a second predefined threshold value, a timer is activated to establish a second

time window of a second predefined size, wherein a third predefined threshold value is smaller than a second predefined threshold value”).

The Examiner agreed with Vasu's arguments and indicated the claim amendments overcame the combination of references including Dorenbosch-791, Dorenbosch-498, and Chaskar. In a September 12, 2018 Office Action (and in a January 9, 2019 Final Office Action), the Examiner rejected the claims using a new combination of Jagadeesan and U.S. Publication No. 2004/0153676 to Krantz (“Krantz,” Ex. 2014). Ex. 1002 at 598-605 (office action dated 9/12/2018); *id.* at 672-676 (final office action dated 1/9/2019). In response, Applicant amended the claims to incorporate allowable subject matter from then-pending claim 21. *Id.* at 634-637 (Second response to office action dated 12/12/2018); *id.* at 702-705 (Second response to final office action dated 3/8/2019).

The Examiner allowed all pending claims in view of the timer limitations found in each:

Regarding claims 17, 45, 76 and 85, the prior art fails to teach “wherein if a Wi-Fi signal monitor [detects] that a Wi-Fi signal level is below a second predefined threshold value V_{th2} ; the timer is activated to establish a second time window of the second predefined size T_2 , wherein a third predefined threshold value V_{th3} is smaller than V_{th2} .”, in linking with other subject matters in the claim.

Regarding claim 33, the prior art fails to teach “establishing a second time window of a second predefined size T , if the third detected context

falls below a second predefined threshold value V_{th2} ; detecting a fourth context during the second time window; and continuing a Wi-Fi communication without change if the fourth detected context is equal to or greater than a third predefined threshold value V_{th3} , wherein V_{th3} is smaller than V_{th2} .”, in linking with other subject matters in the claim.

Regarding claim 56, the prior art fails to teach “a timer is activated to establish a second time window of a second predefined size, wherein a third predefined threshold value is smaller than a second predefined threshold value”, in linking with other subject matters in the claim.

Id. at 732 (Notice of Allowance dated 3/15/2019). The '281 Patent issued on July 30, 2019. For clarity of reviewing the '281 Patent File History, it is noted that then-pending claims 17, 33, 45, 56, 76, and 85 issued as Challenged Claims 1, 12, 23, 31, 37, and 45, respectively. *Id.* at 767.

V. THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 325(D) BECAUSE PETITIONERS PRESENT SUBSTANTIALLY THE SAME ART AND ARGUMENTS

The Board “may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). The Board uses the following two-part framework:

- (1) whether the same or substantially the same art previously was presented to the Office or whether the

same or substantially the same arguments previously were presented to the Office; and

(2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims.

Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH, No. IPR2019-01469, Paper 6 at 8-9 (P.T.A.B. Feb. 13, 2020). If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review. “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

Here, denial of institution on all grounds is appropriate because Petitioners’ challenge relies on substantially the same or substantially the same art previously considered by the Office during prosecution of the ’281 Patent, and Petitioners have not demonstrated any material error. *Id.* at 10-11.

A. Substantially the Same Argument Was Previously Presented to the Office

The first prong of the *Advanced Bionics* framework is satisfied because the Office already determined that time averaging windows are not time windows. In overcoming a pending rejection involving Chaskar, Applicant argued that “Chaskar

does not teach determining a first context, activating a timer to establish a first time window of a first predefined size T1 based on the detected first context, determining a second context during the first time window and automatically switching a communication in progress via a wireless network to a communication via a Wi-Fi network based on the second detected context.” Ex. 1002 at 468. The Examiner agreed and withdrew the rejections based on Chaskar. *See id.* at 493-499; *id.* at 542-557 (Response to Office Action amending claims to add timer-activation limitation), 598-605 (Office Action rejection no longer using Chaskar).

In this case, Petitioners cite Chaskar in combination with Willhoff to satisfy the various timer and time window limitations of the '281 Patent, but Willhoff discloses the same time averaging windows as Chaskar. Accordingly, Willhoff does not meet the Challenged Claim limitations for the same reasons that Chaskar did not.⁸ Namely, Willhoff's “RSSI average” and Chaskar's “signal strength averaging windows” are techniques for improving measurement fidelity. Willhoff at 9:15-18; Chaskar at [0076].

These signal strength measurement techniques are categorically different from time windows during which measurement values are compared to a threshold

⁸ The merits of Petitioners' reliance on Willhoff will be addressed in greater detail in Patent Owner's Preliminary Response.

value. In Willhoff, for example, there are two types of signal strength measurements: a long term average and a short term value. The long term average is a moving average calculated over many samples over a relatively long period, and it “removes the effects of short term fades in the short term signal that otherwise may cause a premature trigger decision.” *See* Willhoff at Abstract. The short term value is a more instantaneous signal measurement designed to “offset[] historical bias that may be built into long term average.” *Id.* When both the long-term average and short-term current value exceed an appropriate threshold value, then the “trigger is . . . realized.” *Id.* at 3:24-37, 9:15-25. There are no timers set, and no time window during which the “trigger is . . . realized,” the trigger triggers any time the long term and short term measurements cross a threshold. *Id.*

Accordingly, *Advanced Bionics* prong one is satisfied because Petitioners repeat the same argument that Vasu already traversed during prosecution of the '281 Patent.

B. Substantially the Same Prior Art Was Already Before the Office

1. Chaskar Was Previously Used in Rejections by the Examiner During the '281 Patent Examination

Chaskar was previously considered and distinguished during examination of the '281 Patent. Chaskar was presented to the Office in an Information Disclosure Statement filed during prosecution of the '281 Patent. Ex. 1002 at 70 (IDS filed 11/02/17), 409 (Examiner initials marking as “considered”). Petitioners

acknowledge that Chaskar was previously presented to the Office. Pet. at 11 (“Examiner identified Chaskar”).

Petitioners do not acknowledge, however, that the Examiner cited Chaskar in a rejection of then-pending claims 35, 45, and 48-65⁹ of the '281 Patent. Ex. 1002 at 438-443 (Non-Final Office Action dated 1/16/18). Petitioners also do not acknowledge that Vasu successfully traversed these rejections by pointing out that Chaskar does not disclose the claimed activation of a timer or time window limitation. Thus, Chaskar satisfies the first prong of *Advanced Bionics* because the same art was previously presented to the Office.

Petitioners attempt to argue the first part of *Advanced Bionics* test is not met because the “Examiner did not consider [Chaskar] in combination with newly-identified references,” citing *Sony Group Corp. v. MZ Audio Scis., LLC*. Pet. at 11 (citing No. IPR2022-01544, Paper 12 at 7 (P.T.A.B. Apr. 21, 2023)). However, the Board's reasoning in that decision only applies to cases where the patent owner only argued the primary reference was the same as previously presented art but fails to address the secondary references relied on in challenging the independent claim. *Sony*, Paper 12 at 7; *see Sony Sony Grp. Corp. v. MZ Audio Scis., LLC*, No. IPR2022-01544, Paper 11 at 63-64 (P.T.A.B. Jan. 25, 2023) (Patent Owner's Preliminary

⁹ Pending claim 45 would eventually issue as the Challenged Claim 23. Ex. 1002 at 767.

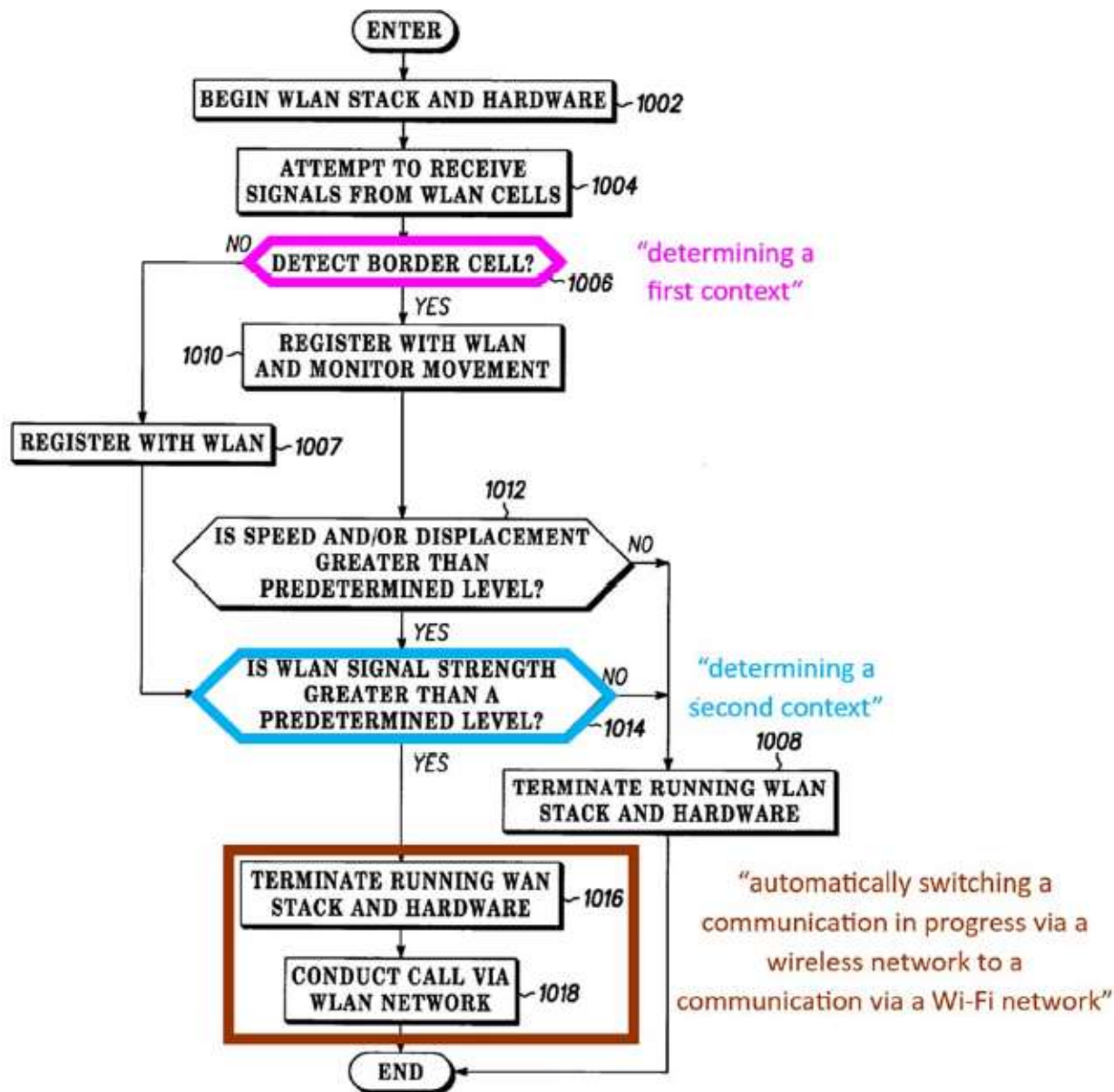
Response only addresses the primary reference and not three other secondary references). In contrast, in the present case, all of the references asserted by Petitioners are the same or substantially the same as art previously considered by the Examiner for the reasons below.

2. Dorenbosch Is Cumulative to Another Reference by the Same Inventor That the Examiner Cited During Examination

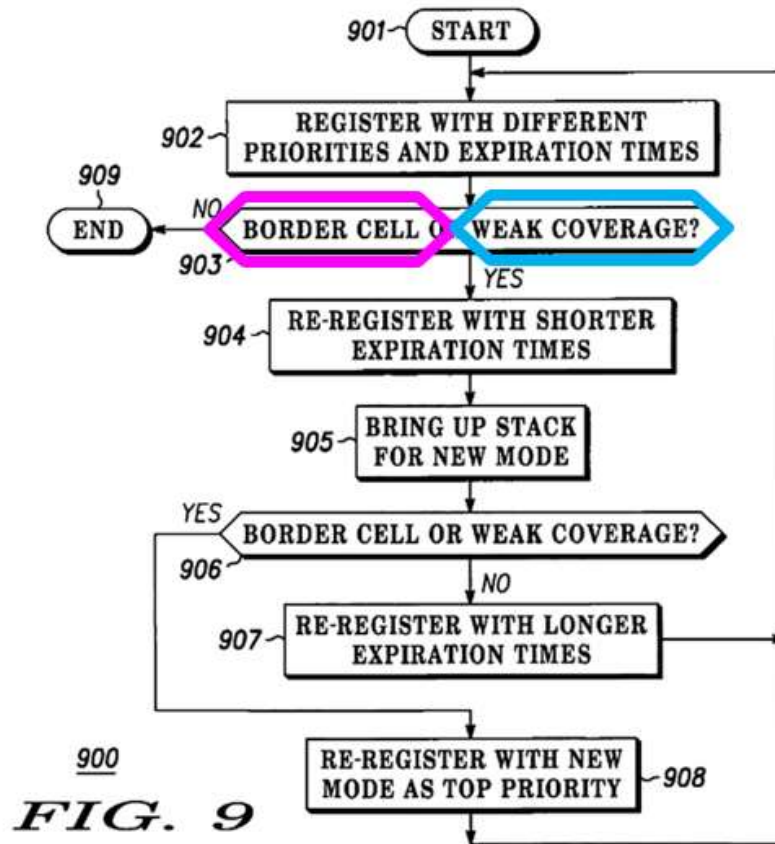
Dorenbosch is substantially the same as another Dorenbosch reference that was used by the Examiner to reject the claims during examination of the '281 Patent, namely, U.S. Patent Publication No. 2005/0239498 to Dorenbosch ("Dorenbosch-498", Ex. 2001), which shares the same lead inventor, Jheroen Dorenbosch, as the Dorenbosch reference (Ex. 1005) raised in the Petition.¹⁰ The Examiner used Dorenbosch-498 to reject the claims of the '281 Patent during its examination. Ex. 1002 at 438, 440, 442-443 (Non-Final Office Action dated 1/16/18); *id.* at 454 (PTO-892).

¹⁰ Petitioners fail to mention that Dorenbosch-498 (Ex. 2001), and yet another Dorenbosch reference, ("Dorenbosch-791", Ex. 2012), were both applied in rejections of the claims during examination. *See* Ex. 1002 at 435-444 (Office Action dated 1/16/18); *id.* at 493-499 (Final Office Action dated 4/4/2018).

The portions of Dorenbosch relied upon by Petitioners are substantially the same as or cumulative to the disclosures found in Dorenbosch-498. For example, Petitioners cite to Figure 10 of Dorenbosch for its detection of “Border Cell or Signal Degradation” for meeting limitation [1.b] of the '281 Patent.



Pet. at 21 (citing Fig. 10 of Dorenbosch). A similar disclosure is found in Dorenbosch-498:



Dorenbosch-498 at Fig. 9 (annotations added). In the chart below, the previously-considered disclosure of Dorenbosch-498 lines up one-for-one with the portions of Dorenbosch cited in the Petition.

Claim Limitation ¹¹	Examiner-Cited Prior Art	IPR-Asserted Reference
[23.a] a first communication module adapted to communicate with a first wireless network; [23.b] a second communication module adapted to communicate with an access point associated with a second network; and	Dorenbosch-498 (Ex. 2001)¹² [0060]: “Transceiver 503 will ... be configurable to support ... multiple communication networks ... further include one or more of a <i>WLAN transceiver 509 and WAN transceiver 511</i>”	Dorenbosch [0026]: “ . . . The SU 306 contains <i>two sets of transceivers</i>—one for the WLAN system and <i>one for the WAN system.</i>” See Pet. at 31-33 (emphasis original).
[23.c] a switching system to switch operation between the first communication module and the second communication module,	Dorenbosch-498 [0063]: “<i>Controller 505 also includes memory 515</i> ...is used to store among various other items or programs etc., an operating system or software, data, and variables 517 for execution or use by the <i>processor 513.</i>” [0064]: “... <i>memory 515</i> further includes ... a	Dorenbosch [0027]: “The mobile subscriber unit 306 also includes <i>one or more processors 418 which processes instructions, performs calculations, and manages the flow of information through the SU 306. The SU 306 also includes a main memory</i> 414 Included within the main memory 414, shown in more detail in FIG. 5, are a

¹¹ The Petition did not rely upon Dorenbosch for limitations [23.pre], [23.d], [23.e], [23.f], [23.h], [23.i]. Pet. at 31, 35-42, 46-49.

¹² Emphasis added to the quoted material in this column, unless otherwise noted.

	<i>signal quality assessment routine 519</i> for use in determining whether a handover or a mode switch may be required ...”	user interface 502, a handover manager 514 ...” Pet. at 33-35 (emphasis original).
[23.d] wherein if a context changes, the second communication module is activated and a second communication type is initiated,	Dorenbosch-498 [0003]: “... <i>to bring up software and hardware necessary to operate within and register with the new system, ...</i>” [0045]: “Multi-mode communication unit 102 quickly detects the disappearance of signal 105 associated with the WLAN..., and <i>makes preparations such as bringing up its cellular stack, which may refer to the protocol stack associated with operation in second network 108...</i>”	Dorenbosch [0038]: “<i>[T]he process of initiating the registration sequence with a communications system, be it a cellular (WAN) system or a local area (WLAN) system, includes the steps necessary to bring up the corresponding hardware and software for that system</i>” [0045]: “<i>The unit 306 enters the method, at step 1002 where it begins running the WLAN stack 510 and its associated hardware 404, 406. The unit then attempts to receive signals from WLAN cells at step 1004. If the unit detects a WLAN border cell, at step 1006, then the unit 306 registers with the WLAN and begins to monitor its movement, at step 1010.</i> Pet. at 35-39 (emphasis original).

[23.g] wherein upon activation of a timer, the switching system causes the second communication module to change state from a sleep mode to an active mode, wherein the timer is activated to establish a time window of a predefined size,	Dorenbosch-498 [0045]: “Multi-mode communication unit 102 quickly detects the disappearance of signal 105 associated with the WLAN, or first network 106, and <i>makes preparations such as bringing up its cellular stack, which may refer to the protocol stack associated with operation in second network 108...</i>” [0075]: “..., registers with and <i>brings up the stack for the WLAN...</i>”	Dorenbosch [0045]: “ . . . <i>The unit 306 enters the method, at step 1002 where it begins running the WLAN stack 510 and its associated hardware 404, 406. The unit then attempts to receive signals from WLAN cells at step 1004 [T]hen the unit will check the signal strength of the WLAN signal, at step 1014. Otherwise, the unit 306 again terminates running the WLAN stack 510 and hardware 404, 406, at step 1008, if either the movement information or the WLAN signal strength is insufficient to warrant a handover.</i>” Pet. at 42-46 (emphasis original).
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Based on this comparison, Dorenbosch satisfies the first prong of *Advanced Bionics* as being substantially the same as or cumulative to a reference (Dorenbosch-498) previously presented to the Office.

3. Willhoff is Cumulative to Art Previously Presented to and Considered by the Office

Willhoff is cumulative to Chaskar, which was previously presented to the Examiner during examination of the '281 Patent. Accordingly, Willhoff satisfies

the first prong of *Advanced Bionics* based on the cumulative nature between Willhoff and Chaskar, which was previously considered during examination of the '281 Patent.

Petitioners cite Willhoff for allegedly disclosing the “activating a timer . . . wherein the timer is activated to establish a time window of a predefined size” (*see* limitation [23.g], [45.d]) and “the timer is activated to establish a second time window of a second predefined size T2” (*see* limitation [23.h], [45.e]). Pet. at 42-48, 74-78. However, Willhoff's averaging windows are not the claimed timers or time windows of a predefined size for the same reason that Chaskar's averaging windows are not the claimed timers or time windows. *See* § V.A, *supra*.

The ideas that Petitioners point to in Willhoff are already found in, and thus cumulative to, Chaskar. For instance, Petitioners point to Willhoff's disclosure of a Received Signal Strength Indication (RSSI) average “to determine when a handoff condition is to be checked.” Pet. at 44-45, 47-48 (citing Willhoff at Abstract, 9:53-56). Petitioners then assert that Willhoff discloses windows of time having a longer “width” (e.g., “several seconds”) or shorter “width” (e.g., millisecond). *Id.* at 44 (citing Willhoff at 9:56-62, 10:46-47). But both of these notions, RSSI averages and allegedly different time windows, are already found in Chaskar, which was previously presented to the Office.

Indeed, Petitioners *admit* that both of these notions, RSSI averages and alleged different time windows, are already found in Chaskar, which was previously presented to the Office. Pet. at 30 (“Chaskar *already contemplates* using measurement windows of different widths and thus discloses using the two different size windows.”) (emphasis added) (citing Chaskar [0077]); *see Chaskar* at [0076] (disclosing “signal strength averaging windows, exponential averaging of samples of received signal strength, dwell timers, etc.” as example methods for robust measurement of received signal strength); *see also id.* at [0077] (disclosing that it is “possible to build in aggressiveness and conservativeness into handoff logic in a different manner,” which includes “having *different values for the widths of averaging windows* or dwell timers”) (emphasis added).

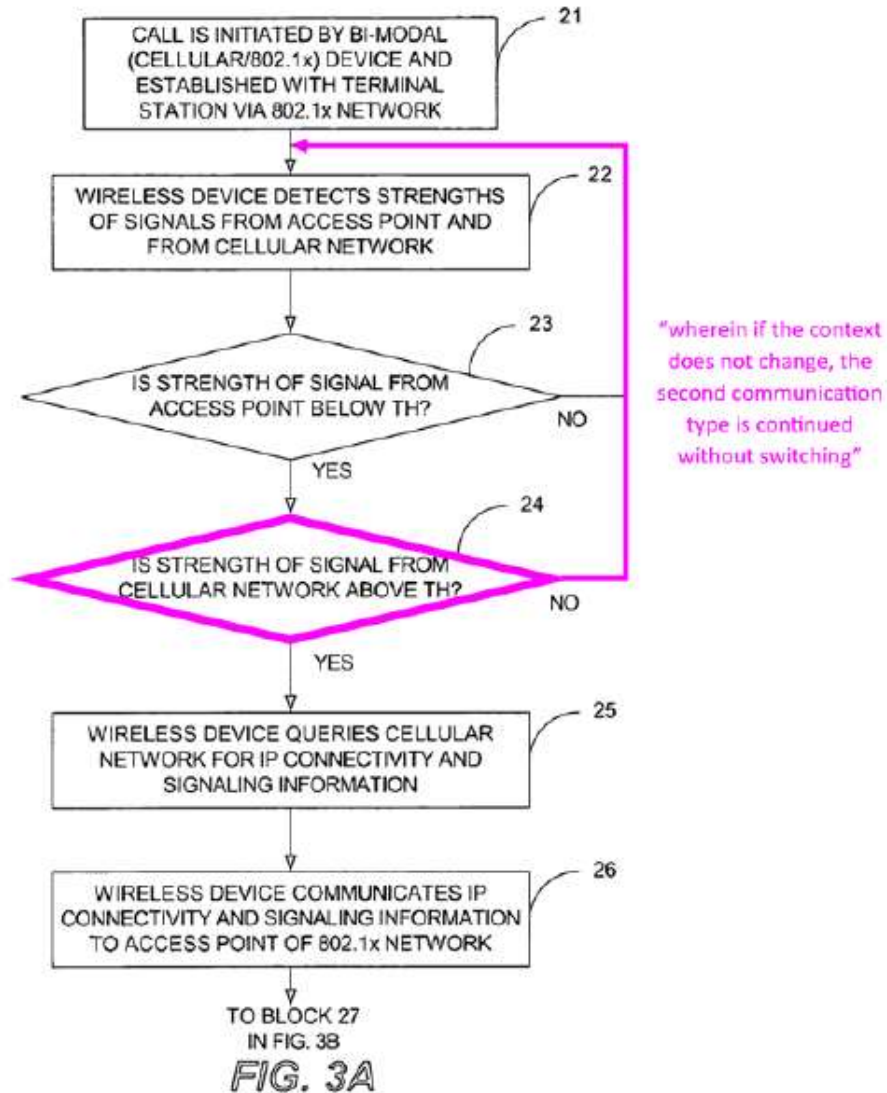
Chaskar's disclosure of “signal strength averaging windows” and “having different values for the widths of averaging windows” are cumulative to those portions of Willhoff that Petitioners rely upon. This cumulative relationship between Chaskar's and Willhoff's teachings are shown by Petitioners' own challenge. Petitioners allege that Chaskar discloses measuring signal strength using “signal strength averaging windows” “having different . . . widths,” but “does not provide implementation details.” Pet. at 29. But then Petitioners assert that “[a] POSITA would have looked to Willhoff for implementation details for Chaskar's signal strength averaging window.” *Id.*

For at least the foregoing reasons, Willhoff is cumulative to Chaskar.

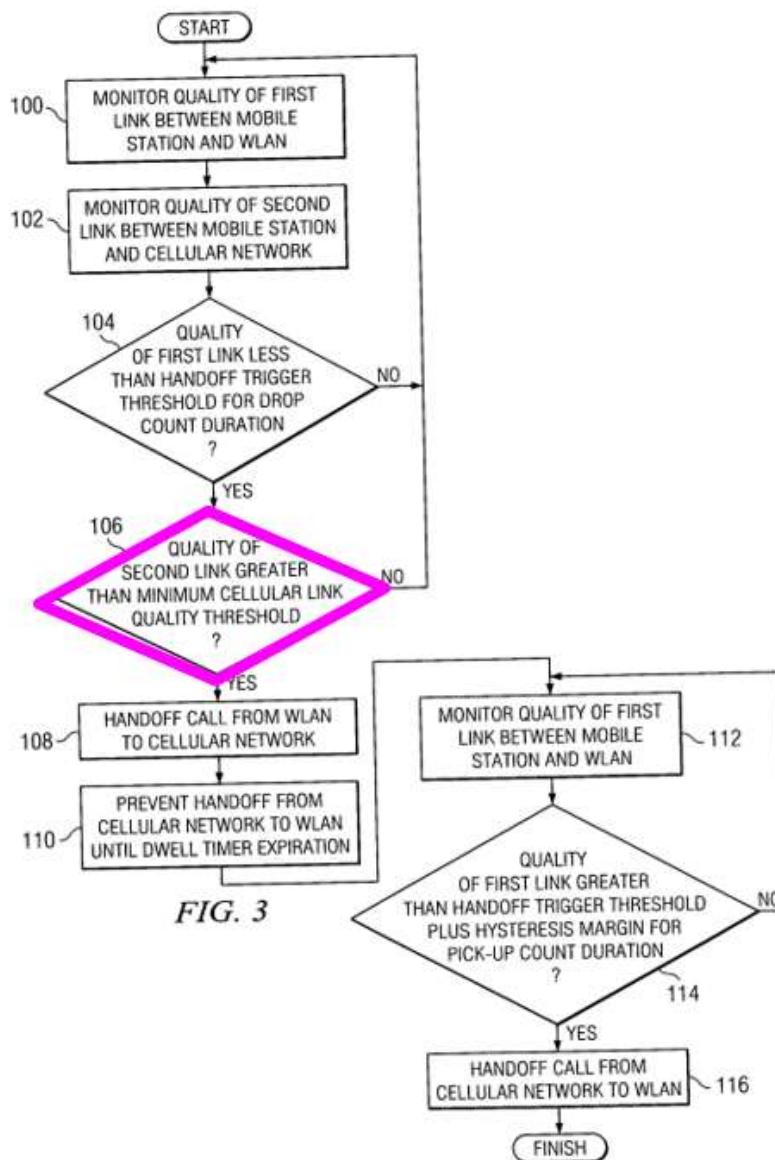
4. Enzmann, and Donovan Are Also Cumulative to Art Considered by the Examiner During the '281 Patent Examination

Enzmann is asserted against Claim 23 and relied upon for allegedly disclosing, *inter alia*, “wherein if a context changes . . . a second communication type is initiated.” Pet. at 35-42 (citing Enzmann, [0027], [0025]). Enzmann is cumulative to Jagadeesan (Ex. 2013), which was previously presented to the Office and used by the Examiner to reject Claim 23 (then-pending claim 45) during examination. *See* Ex. 1002 at 672-676 (citing Jagadeesan, [0025], [0041], Fig. 3); *see also id.* at 493-499, 598-605.

Petitioners cites Enzmann Figure 3A (Pet. at 39-40), which is a flow chart “seamlessly handing off a wireless device call from an 802.1x network to a cellular network” (Enzmann, [0013]), as allegedly disclosing “wherein if the context does not change, the second communication type is continued without switching” (i.e., limitation [23.e]).



Pet. at 40 (citing Fig. 3A of Enzmann) (annotations original). But this disclosure is remarkably similar to a corresponding figure in Jagadeesan, reproduced below with annotations.



Jagadeesan at Fig. 3 (annotations added). In fact, Petitioners cite to Enzmann's description of these steps in [0025], which mirrors closely a corresponding disclosure in Jagadeesan:

Examiner-Cited Prior Art	IPR-Asserted Reference
Jagadeesan: [0048]: “if the quality of the first link is <i>less than a handoff trigger threshold</i> for a drop count duration then the method proceeds to step 106... if the <i>quality of the second link is greater than a minimum cellular link quality threshold</i> then the method proceeds ...” (emphasis added).	Enzmann: [0025]: “ . . . A determination is made as to whether the strength of the signal from the access point 7 has dropped below a certain threshold level, as indicated by decision block 23. <i>If so, a determination is made as to whether the strength of the signal from the cellular network is at or above a certain threshold level, as indicated by decision block 24. If the answer to either of these questions is no, the process returns to block 22.</i>” Pet. at 40 (emphasis original).

Similarly, Petitioners cite to Enzmann's Figures 4A and 4B, which are flow charts for the opposite scenario, i.e., “seamlessly handing off a wireless device call from a cellular network to an 802.1x network.” Pet. at 35-37 (citing Enzmann [0027]-[0028]); *see* Enzmann at [0014]. This scenario and description mirrors another passage in Jagadeesan, reproduced below:

Examiner-Cited Prior Art	IPR-Asserted Reference
Jagadeesan: [0042]: “For example, mobile station 12 may be actively connected with cellular link 18a on a call, and a handoff may be triggered when the	Enzmann: [0027]: “FIGS. 4A and 4B illustrate a flow chart of the method of...performing a seamless <i>handoff</i> from the cellular network 6 <i>to the 802.1x network 2 While the call</i>

<i>quality of cellular link 18a is less than a handoff trigger threshold for a drop count duration and when the quality of WLAN link 18b is greater than a minimum WLAN link quality threshold.”</i> (emphasis added).	<i>is in progress, the strength of the signals from the access point 7 and from the cellular network 6 is measured by the wireless device, as indicated by block 42. A determination is made as to whether the strength of the signal from the cellular network 6 has dropped below a certain threshold level, as indicated by decision block 43. If so, a determination is made as to whether the strength of the signal from the 802.1x network 2 is at or above a certain threshold level, as indicated by decision block 44”</i> Pet. at 37 (emphasis original).
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Therefore, Enzmann is cumulative to Jagadeesan, which was already before the Office.

Donovan is relied upon by Petitioners for allegedly disclosing “a sleep mode.” Pet. at 78-79 (citing Donovan, [0042], [0057], [0045] “[t]o the extent further disclosure of a ‘sleep mode’ is required”). Donovan is cumulative to Krantz (Ex. 2014), which was already before the Examiner and used to reject the ’281 Patent during examination. Ex. 1002 at 598-605 (office action dated 9/12/2018); *id.* at 672-676 (final office action dated 1/9/2019). The Examiner rejected the then-pending claims of the ’281 Patent as being obvious in view of Krantz (and another reference), and cited Krantz’s disclosure that “controls the power to the network interface module 201 to three primary levels,” which included the modes of “on state, *doze*

state, and off state.” Ex. 1002 at 599 (citing Krantz [0036]) (emphasis added). Donovan and its teaching of “sleep mode” is, therefore, cumulative to Krantz, which was already before the Office. *Regeneron Pharms., Inc. v. Merus N.V.*, 864 F.3d 1343, 1350 (Fed. Cir. 2017) (“A reference is cumulative when it ‘teaches no more than what a reasonable examiner would consider to be taught by the prior art already before the PTO.’” (citation omitted)).

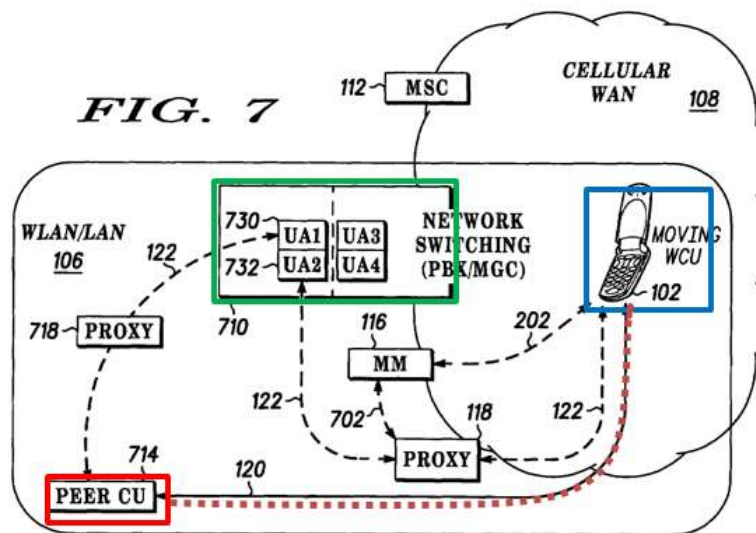
5. Iizuka Is Cumulative to Art Considered by the Examiner During Examination of the '281 Patent and Used During a Related '181 Patent Examination

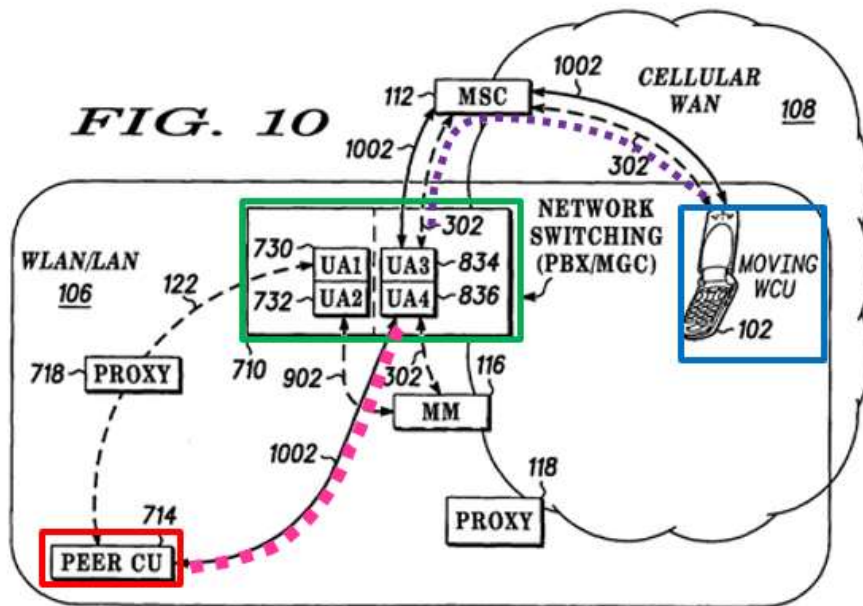
Iizuka is cumulative to art considered by the Examiner during the examination of the '281 Patent. Specifically, Iizuka is cumulative to U.S. Patent No. 7,398,088 to Belkin (“Belkin,” Ex. 2015) and U.S. Patent No. 8,041,360 to Ibe (“Ibe,” Ex. 2016), which were presented to the Office in an Information Disclosure Statement filed during prosecution of the '281 Patent. Ex. 1002 at 67 (IDS filed 11/02/17); *id.* at 406 (Examiner initials marking as “considered”).

Iizuka is cumulative to Belkin and Ibe because of the overlap between the arguments made during the examination of the related '181 Patent distinguishing Belkin and Ibe and the manner in which Petitioners rely on Iizuka in this case. To give some background, the Examiner rejected the then-pending claims of the '181 Patent as obvious over Ibe and Belkin. Ex. 2017 ('181 Patent file history) at 5-11. Now, the present Petition relies on Iizuka as disclosing and combining the same

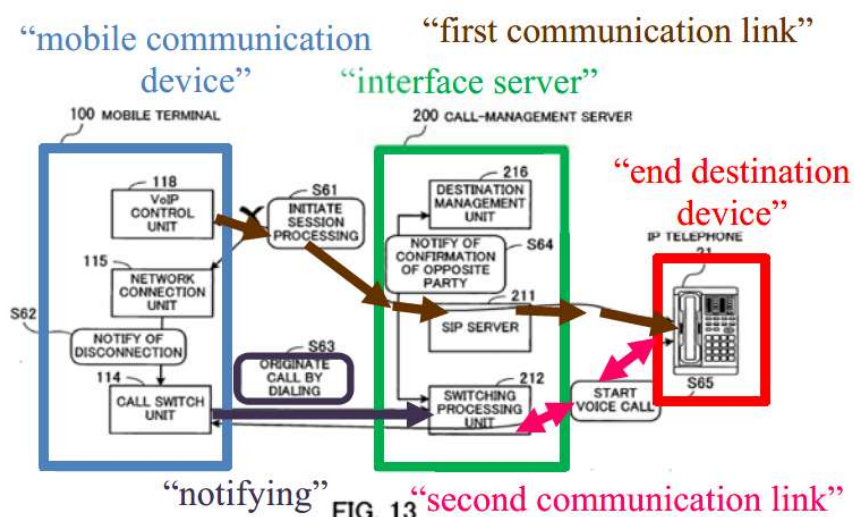
elements said during examination to be disclosed and combined by Ibe and Belkin. *See id.* at 5-11 (2/7/2013 Office Action rejecting the then-pending Challenged Claims), 64-74 (6/27/2013 Final Office Action rejecting the same), 83-86 (8/23/2013 Response overcoming the Examiner's Rejection), 94 (7/10/2014 Notice of Allowance crediting the arguments and amendments filed on 8/23/2013).

During examination of the '181 Patent, the Examiner mapped Belkin's wireless communication unit (WCU) 102 to the claimed “**mobile communication device**”, the network switching function 710 to the claimed “**interface server**”, the peer communication unit (Peer CU) 714 to the claimed “**end destination device**,” and the link 1002 between Peer CU 714 and network switching function 710 to the “**second communication link**.” Ex. 2017 at 7-8, 64-66.

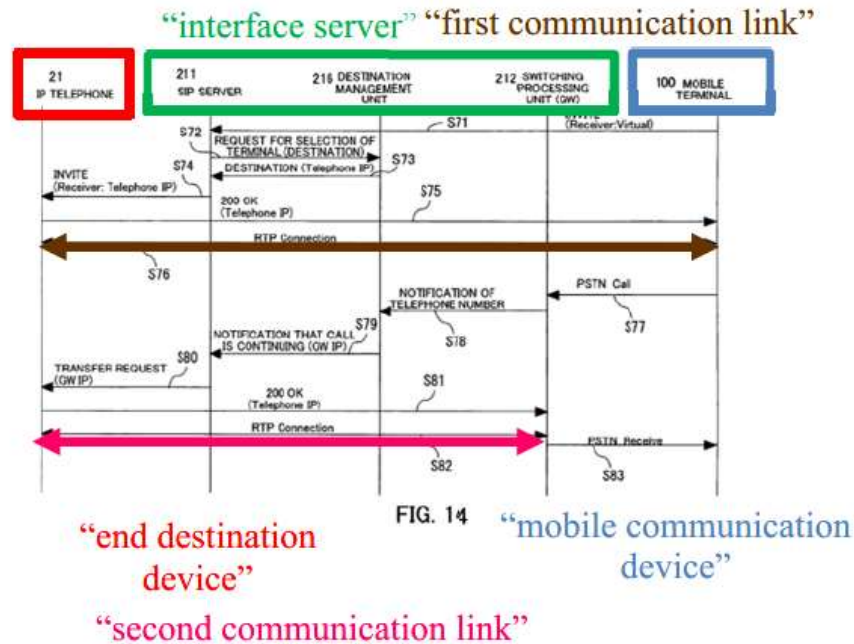




Belkin (Ex. 2015) at Figs. 7 and 10 (annotated). This mapping is nearly identical to the Petitioners' use of Iizuka, with the Petitioners' annotations reproduced below in Figures 13 and 14 of Iizuka.



Pet. at 68 (Fig. 13 of Iizuka, as annotated by Petitioner).



Id. (Fig. 14 of Iizuka, as annotated by Petitioner).

Under Petitioners' theory, after a first communication link between a mobile device and an end destination device have been established at S76 (*id.*), a second communication link (an RTP connection for real-time audio streams) is established at Step S82 between Iizuka's call-management server 200 (alleged interface server) and its mobile terminal 100 (the alleged end destination device). Pet. at 67-68. As Applicant argued persuasively to the Examiner during the '181 Patent examination, "[r]erouting a connection is not the same as establishing a second connection." Ex. 2017 ('181 Patent file history) at 36. For at least that reason, Iizuka's rerouting of the initial RTP connection is not tantamount to establishing a second connection, as claimed.

Accordingly, the Office already considered and rejected an argument that transferring the original communication link between a mobile device and destination device to then be between an intermediary server and the communication device (as taught by Iizuka) satisfies the “establishing a second communication link between the interface server and an end destination device without disrupting the first communication link.” Thus, Iizuka is cumulative to art already previously presented to the Office.

C. Petitioners Made No Showing of Material Error

The second prong of *Advanced Bionics* is satisfied because Petitioners do not show that the Examiner erred in a manner material to patentability.

In their Petition, Petitioners have failed to identify any error with the Examiner's consideration of the presented art. Nor could they, because, for example, the Examiner relied on nearly identical text from Chaskar that Petitioners now cite in their Petition (albeit in different paragraphs). *Compare* Ex. 1002 at 439, 441 (Examiner citing Chaskar [0071]) *with* Pet. at 46-47 (citing Chaskar [0072]). Even Petitioners' motivation to combine about avoiding “spurious handoffs” is found in a paragraph of Chaskar cited by the Examiner. *Compare* Ex. 1002 at 439, 441-442 (citing Chaskar [0057]) *with* Pet. at 56 (citing Chaskar, [0017]-[0021]). For ease of comparison, these similarities are reproduced in the below table:

Chaskar relied upon by Examiner	Chaskar relied upon by Petition
[0071]: “After initiation of phase 1, ... <i>while the detected WLAN signal strength is larger than a predetermined threshold Th2, the mobile node remains in a waiting state. After the signal strength has fallen below Th2, handoff phase 2 is initiated.</i>” See Ex. 1002 at 439, 441 (citing Chaskar, [0071]) (emphasis added).	[0072]: “ . . . [W]hile a detected WLAN signal strength is larger than Th2, the mobile node waits. <i>After the signal strength has fallen below Th2, in order to be proactive, handoff phase 1 is initiated.</i>” Pet. at 47 (emphasis original).
[0057]: “...the mobile terminal waits for T seconds before it initiates inter-technology handoff, <i>in order to try to filter out spurious handoff triggers...</i> if the detected WLAN signal strength is less than a predetermined threshold, an inter-technology handoff is initiated.” See Ex. 1002 at 439, 441 (citing Chaskar, [0057]) (emphasis added).	[0017]-[0021]: “The invention provides a method which: 1. can <i>reduce the number of spurious handoff triggers</i> without delaying the handoff trigger when it indeed needs to happen, 2. can reduce the number of false starts (of handoff preparation) in proactive handoff schemes” Pet. at 56-57 (emphasis added).
[0060]: “Note that Th2 typically should be bigger than Th1.” See Ex. 1002 at 439 (citing Chaskar, [0060]); <i>see also id.</i> at 441 (Examiner arguing that “Th2 is implied to Applicant third threshold value”).	[0069]: “ . . . According to an alternative embodiment of the proactive handoff procedure, <i>multiple thresholds can be used, for example Th1>Th2>Th3</i>” Pet. at 48-49 (emphasis original).

Accordingly, it cannot be said that Examiner erred materially in its consideration of Chaskar. And Petitioners cannot attempt to assert Examiner overlooked certain passages in Chaskar by simply pointing to passages that are

different from those passages that were previously cited by the Examiner, but that have nearly the same or substantially the same text or disclosures as those relied on by the Examiner.

In their Petition, Petitioners only provide a vague, generic catch-all argument “[t]o the extent art considered by the USPTO was substantially the same as references identified in the Grounds, the Examiner erred by not rejecting the Claims for the reasons discussed in §IX.” Pet. at 12. This argument fails to identify with particularity the specific error material to patentability the Examiner made. It is the Petitioners’ burden to affirmatively demonstrate that the Office committed material error in issuing the challenged patent. *See, e.g., Advanced Bionics*, Paper 6 at 9 (“At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.”).

Because the Petition presents only the same or substantially the same prior art and arguments previously presented during prosecution, and because Petitioners have failed to show any error by the USPTO, the Board should exercise its discretion and deny institution under 35 U.S.C. § 325(d). *See Advanced Bionics*, Paper 6 at 7-9.

VI. CONCLUSION

Accordingly, the Board should exercise its discretion and deny Petitioner’s IPR Petition under § 314(a).

Patent Owner's Request for Discretionary Denial
IPR2025-00449 (U.S. Patent No. 10,368,281)

Respectfully submitted,

Dated: May 12, 2025

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CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24

The undersigned hereby certifies that the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** has 11,065 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24(b) and the March 26, 2025 Memorandum re: Interim Processes for PTAB Workload Management. This word count was prepared using the Microsoft Word word-processing system used to prepare this paper.

Dated: May 12, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the Patent Trial and Appeal Case Tracking System (P-TACTS) constitutes electronic service, service was made on Petitioners as detailed below.

<i>Date of service</i>	May 12, 2025
<i>Manner of service</i>	Electronic Filing with the Board (james.l.davis@ropesgray.com; alexander.middleton@ropesgray.com; christopher.bonny@ropesgray.com; Samsung-Vasu-IPR-Ropes@ropesgray.com)
<i>Documents served</i>	PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL
<i>Persons Served</i>	ROPES & GRAY LLP James L. Davis, Jr., Alexander E. Middleton, Christopher M. Bonny

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