

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

**DECLARATION OF JAMES HANNAH IN SUPPORT OF
PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

I, James Hannah, declare as follows:

1. I am partner at the law firm of Kramer Levin Naftalis & Frankel LLP, attorneys for Patent Owner Vasu Holdings, LLC (“Patent Owner”), in the above-captioned *inter partes* review proceeding involving Petitioners Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (“Petitioners”). I provide this Declaration in support of Patent Owner’s Request for Discretionary Denial based upon my personal knowledge.

2. In the co-pending litigation, *Vasu Holdings, LLC v. Samsung Electronics Co.*, No. 2:24-cv-00034-JRG-RSP (E.D. Tex.), Patent Owner is currently asserting infringement of Claims 1, 3, 4, 8, and 9 of U.S. Patent No. 8,886,181, Claims 1, 2, 4, 43, and 47 of U.S. Patent No. 10,206,154, Claims 1, 12, 23, 31, 37, and 45 of U.S. Patent No. 10,368,281, and Claims 1, 12, 23, 25, 34, 35, 39, and 41 of U.S. Patent No. 10,419,996.

3. The claims collectively challenged in the ’281 Patent IPRs (IPR2025-00448 and IPR2025-00449) are the same as those challenged in Petitioners’ September 30, 2024, invalidity contentions: claims 1, 12, 23, 31, 37, and 45.

4. Patent Owner filed its complaint on January 22, 2024. The complaint was served on January 24, 2024, in the Eastern District of Texas and assigned to Judge Gilstrap. Petitioners filed their IPR Petitions for the ’281 Patent (IPR2025-

00448, IPR2025-00449) on January 24, 2025, the day of the 12-month statutory deadline without explaining the cause for their delay in filing.

5. The scheduled trial date in the District Court litigation is November 3, 2025. The median time to trial in the Eastern District of Texas is 21.9 months (approximately November 21, 2025), as shown in Exhibit 2003. This lends credibility to the median time to trial date. As a result of Petitioners' delayed filing, the scheduled trial date in the District Court litigation will commence 10 months prior to the Board's projected September 10, 2026 final written decision deadline.

6. Patent Owner served its preliminary infringement contentions and asserted claims on May 15, 2024, and Petitioners served their preliminary invalidity contentions on July 31, 2024. Petitioners supplemented their invalidity contentions on September 30, 2024, and submitted their preliminary election of asserted prior art on March 25, 2025. Petitioners filed their IPRs for the '281 Patent on January 24, 2025, eight months after Patent Owner served its preliminary infringement contentions and nearly five months after they served their initial invalidity contentions.

7. Experts will rely on substantially the same prior art and grounds as in the Petition when forming their opinions. Pet. at 7. For example, within the September 30, 2024 invalidity contentions, Petitioners asserted Chaskar and

Iizuka. Within the preliminary election of asserted prior art that Petitioners served on March 25, 2025, Petitioners asserted Iizuka, Chaskar, Enzmann, and Willhoff for the '281 Patent. Dorenbosch '498 was also asserted in Petitioners' September 30, 2024 invalidity contentions.

8. Petitioners asserted Donovan as a secondary reference for the “sleep mode” limitations of Claims 23 and 45 of the '281 Patent. Pet. at 7. However, Petitioners already asserted 16 other references for claim limitation 23[g] and 16 for claim limitation 45[d] of the '281 Patent involving “sleep modes” in Supplemental Exhibit E of their September 30, 2024 supplemental invalidity chart. Petitioners do not explain how Donovan addresses any potential weaknesses posed by these other invalidity contention references.

9. Petitioners also asserted Dorenbosch '977 as a reference in their Petition for Claim 23 of the '281 Patent. Pet. at 7. However, Petitioners already asserted 21 references for claim 23[a], 8 references for 23[b], 24 references for 23[c], 6 references for claim 23[d], and 16 references for 23[g] of the '281 Patent in Supplemental Exhibit E of their September 30, 2024 supplemental invalidity chart. Petitioners do not explain how Dorenbosch '977 addresses any potential weaknesses posed by these other invalidity contention references.

10. Discovery in the co-pending litigation is well underway as both Patent Owner and Petitioners have served and responded to multiple sets of discovery

requests. Specifically, the parties have served a combined total of 44 requests for admission (4 requests from Patent Owner and 40 requests from Petitioners), 162 requests for production (60 requests from Patent Owner and 102 requests from Petitioners), 75 interrogatories (40 requests from Patent Owner and 35 requests from Petitioners). The parties served initial disclosures beginning on June 19, 2024, that identified relevant witnesses and categories of documents. Petitioners amended their initial disclosures on March, 27, 2025.

11. The parties have collectively served 19 Rule 30(b)(1) and 30(b)(6) deposition notices and 7 subpoenas. In fact, Petitioners served three 30(b)(6) deposition notices seeking a corporate designee of Vasu to testify on 87 topics, as recently as April 17, 2025, which is scheduled to take place on May 29, 2025, and June 2, 2025. Six depositions are scheduled to take place in South Korea beginning May 20.

12. In response to their respective requests for production, the parties have produced thousands of documents. Specifically, Petitioners have produced over 3.96 GB of source code and over 65,600 documents. The parties have also produced videos and other types of files. Vasu spent 10 days inspecting Petitioners' source code. Patent Owner's expert is expected to review the source code from May 28 to May 30. Fact discovery is set to close on June 2, 2025.

13. Petitioners filed a Motion to stay on April 18, 2025. Patent Owner filed its Opposition to the Motion on May 2, 2025. Magistrate Judge Payne denied Petitioners' Motion on May 9, 2025.

14. On April 22, 2025, Patent Owner filed a Motion to Compel Documents and Discovery Responses, and the Court scheduled the hearing for May 13, 2025.

15. The parties completed claim construction briefing in the co-pending litigation on April 15, 2025. A Joint Claim Construction Chart was submitted on April 22, 2025. The Court scheduled the claim construction hearing for May 13, 2025, with Magistrate Judge Payne presiding. Magistrate Judge Payne's average time to issue a *Markman* Order after conducting a *Markman* hearing is 40 days. This average is based on Magistrate Judge Payne's issued *Markman* Orders from July 1, 2023 to present. This data was pulled from Docket Navigator, and it is in Exhibit 2004. Accordingly, a *Markman* Order in this case is expected by June 23, 2025, which is approximately two months before the Board's September 10, 2025, institution decision deadline.

16. On March 31, 2025, Judge Gilstrap appointed a technical advisor for the case. The parties, who are responsible for paying the technical advisor's fees and expenses, already provided him with all claim construction briefs, exhibits, and technology tutorials.

17. The deadline for submitting opening expert reports is June 16, 2025, and for rebuttal expert reports is July 7, 2025. Expert discovery will close on July 21, 2025. The filing deadline for filing dispositive motions without seeking leave of court and *Daubert* motions is July 28, 2025. Moreover, any outstanding dispositive and *Daubert* motions will be fully briefed by August 25, 2025.¹ Accordingly, the Court's technical advisor and the parties' experts will have considered these materials for their respective tasks involved in the litigation by the Board's September 10, 2025 institution decision deadline.

I declare that all statements made herein of my knowledge are true, and that all statements made on information and belief are believed to be true, and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code. Executed on May 12, 2025, in Redwood Shores, CA.

/James Hannah/
James Hannah

¹ Under the Local Rules for the E.D. Tex. Rule 7, replies and sur-replies to dispositive and non-dispositive motions must be filed within 7 days from the date the response is served. No further motions absent leave of court are allowed.