

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.

SAMSUNG ELECTRONICS CO., LTD.,

Petitioners

v.

KONINKLIJKE KPN N.V.

Patent Owner

Case IPR2025-00504

U.S. Patent 8,549,151

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF
INSTITUTION**

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EXHIBIT LIST

Exhibit No.	Description
2001 to 2100	RESERVED FOR PRELIMINARY RESPONSE
2101	KPN’s Original Petition and Request for Disclosure in <i>Koninklijke KPN N.V. v. Samsung Elecs. Co.</i> , No. 25-0237 (71st Dist. Ct. Harrison Cty. Tex., March 3, 2025).
2102	2016 Settlement, License and Non-Assertion Agreement between Koninklijke KPN N.V. and Samsung Electronics Co., Ltd. (“Financial Conditions” Redacted)
2103	Intentionally left blank
2104	Intentionally left blank
2105	Intentionally left blank
2106	KPN’s Original Petition and Request for Disclosure in <i>Koninklijke KPN N.V. v. Samsung Elecs. Co.</i> , No. 22-0762 (71st Dist. Ct. Harrison Cty. Tex., Sept. 28, 2022) (redacted)
2107	Signed Jury Verdict Form in <i>Koninklijke KPN N.V. v. Samsung Elecs. Co.</i> , No. 22-0762 (71st Dist. Ct. Harrison Cty. Tex., Feb. 23, 2024) (redacted)
2108	Final Judgment, <i>Koninklijke KPN N.V. v. Samsung Elecs. Co.</i> , No. 22-0762 (71st Dist. Ct. Harrison Cty. Tex., May 2, 2024) (redacted)
2109	Samsung’s Complaint for Declaratory Judgment of Non-Infringement (Dkt. 2) in <i>Samsung Electronics Co., Ltd. v. Koninklijke KPN N.V.</i> , No. 24-cv-01433-CFC (Dec. 31, 2024) (redacted)
2110	Samsung’s Complaint for Declaratory Judgment of Non-Infringement in <i>Samsung Electronics Co., Ltd. v. Koninklijke KPN N.V.</i> (Dkt. 2) (redacted), No. 25-cv-00001-CFC (January 1, 2025) (redacted)

Exhibit No.	Description
2111	Opening Brief in Support of Motion to Dismiss First Amended Complaint (Dkt. 30) in <i>Samsung Electronics Co., Ltd. v. Koninklijke KPN N.V.</i> , No. 24-cv-01433-CFC (Apr. 7, 2025) (redacted)
2112	Opening Brief in Support of Motion to Dismiss First Amended Complaint (Dkt. 31) in <i>Samsung Electronics Co., Ltd. v. Koninklijke KPN N.V.</i> , No. 25-cv-00001-CFC (Apr. 7, 2025) (redacted)
2113	Intentionally left blank
2114	Intentionally left blank
2115	Docket Navigator Search Results for All IPR or PGR Petitions Filed Between Jan. 1, 2025 and April 17, 2025
2116	Docket Navigator Search Results for IPR or PGR Petitions Filed by Samsung Between Jan. 1, 2025 and April 17, 2025
2117	Additional Excerpt of File History of U.S. Application No. 16/413,052 Since the Petition was filed
2118	Corrected Notice of Allowability for U.S. Application No. 16/413,052

I. SUMMARY OF ARGUMENT

Pursuant to Acting Director Stewart’s March 26, 2025 Memorandum titled “Interim Processes for PTAB Workload Management” (“Workload Memo”), Patent Owner Koninklijke KPN N.V. (“KPN”) respectfully requests that the Director exercise discretion and deny institution of *inter partes* review.

The Workload Memo states that—in addition to the discretionary considerations set forth in existing Board precedent (e.g., *Fintiv*) and the Consolidated Trial Practice Guide (Nov. 2019)—the Director will take into account “all relevant considerations,” including but not limited to the strength of the unpatentability challenge, the extent of the petitioner’s reliance on expert testimony, settled expectations of the parties, compelling economic interests, and the ability of the PTAB to comply with its statutory deadlines. Workload Memo, 2-3. Given the unique circumstances presented here, discretionary denial is warranted based on these and other considerations.

First, unlike virtually all other IPR and PGR proceedings, there are no pending infringement claims against Samsung Electronics America, Inc. or Samsung Electronics Co., Ltd (collectively, “Samsung”). To the contrary, KPN has moved to dismiss Samsung’s declaratory judgment lawsuit on the basis that no actual case or controversy exists because KPN has never threatened to sue Samsung for infringement of the ’151 Patent. Given “the current workload needs of the PTAB”

and consideration of “the ability of the PTAB to comply with ... its statutory deadlines for AJA proceedings” (*id.*), institution should be discretionarily denied so that the Board may prioritize proceedings involving patents that have either been asserted or clearly alleged to be infringed. Indeed, post grant proceedings can only serve as a “true alternative” to district court proceedings when a legitimate basis for litigation exists. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential).

Second, there are “legitimate questions about whether the petition is reasonably designed to advance the beneficial aims of the AIA or this Office.” *See OpenSky Industries, LLC v. VLSI Technology LLC*, IPR-2021-01064, Paper 102 at 36 (PTAB Oct. 4, 2022) (precedential). The evidence suggests that Samsung did not file its numerous IPR petitions because of a legitimate infringement concern. Instead, Samsung filed its petitions and declaratory judgment actions in pure retaliation because KPN was awarded **\$342M** (plus accruing interest) in breach of contract damages by a Texas state court for Samsung’s breach of a 2016 settlement agreement (“2016 Settlement Agreement”), which Samsung has repeatedly tried to pressure KPN to abandon. In fact, Samsung’s IPR petitions are the subject of a second Texas state court lawsuit by KPN alleging that Samsung’s filing of the petitions violates the 2016 Settlement Agreement. Ex. 2101 ¶¶ 28-68.

Third, discretion should be exercised because KPN will suffer irreparable

harm if Samsung is found to be in breach in the second Texas state court lawsuit after the Board issues a merits-based decision on institution. Although the merits of the Petition are weak, any decision by the Board addressing the merits would become part of the public domain and could be used by future petitioners to attempt to create new petitions, including by remedying the weaknesses in the Petition. Even a later-issued injunction could not undo the harm this would cause KPN.

Fourth, there are compelling economic interests favoring the exercise of discretion. There is a strong economic interest in holding technology companies to the terms of contractual agreements. There is also a robust economic interest in encouraging innovation by allowing technology companies, such as KPN, to license their novel technologies, which is used to fund further technological developments. Samsung's strategy of arbitrarily targeting valuable patents in KPN's portfolio as retaliation is an improper attempt to undermine that economic interest.

Fifth, the Office considered the Petition, references asserted in the Petition, and declaration of Samsung's proposed technical expert during prosecution of an allowed reissue application in the same family as the '151 Patent. Thus, the Office already considered the teachings of the asserted references and reached a different conclusion on patentability than now urged by Samsung. The Office's consideration of the Petition, asserted references, and supporting declaration in the reissue application weighs in favor of discretionary denial.

Sixth, Samsung's patentability challenges are weak. One of the primary references asserted in the Petition was not only considered by the Office but was applied by the Examiner. Moreover, there are specific merits-based weaknesses in each ground.

Seventh, the Petition relies extensively on expert testimony and there are, at minimum, reasonable disputes as to whether certain claim elements are satisfied by the alleged prior art. Pursuant to the Workload Memo, this consideration weighs in favor of discretionary denial.

Eighth, the expectations of the parties have long been settled. KPN has for decades relied on the licensing of patented technology that it internally develops to grow and support its telecommunications business. The '151 Patent issued over a decade ago, and Samsung has been aware of it for years. As such, the parties fully expected validity of the '151 Patent to remain unquestioned.

Ninth, given the current workload needs of the Board, another important consideration is the overall burden that the particular petitioner at issue places on the PTAB. At the current pace Samsung is filing IPR petitions this year, Samsung will account for **over 15%** of **all** IPRs or PGRs filed in 2025. Fundamental fairness dictates that the exercise of discretion should lean toward denial for petitioners that file an abnormally high number of petitions, which places a significant burden on the Board and increases the likelihood that the meritorious challenges of petitioners

that rarely file IPRs will be discretionarily denied.

Finally, the exercise of discretion here would preserve an unusually large amount of Board resources. Although there are six Samsung IPR petitions challenging unrelated and fundamentally different patents, the reasons for discretionary denial herein largely apply the same to each proceeding. Thus, exercising discretion would preserve an extraordinary amount of Board resources that could be dedicated to proceedings involving patents that have been asserted or actually threatened.

II. BACKGROUND

A. KONINKLIJKE KPN NV

KPN is a 150-year-old company that provides telecommunication services to millions of consumers in the Netherlands. Ex. 2101 ¶ 1. KPN has devoted billions of dollars to research and development activities designed to improve its telecommunication services. *Id.* To help fund these efforts, KPN relies on licensing revenue from its robust intellectual property portfolio that includes approximately 1,750 patents, many of which are declared essential to 3G, 4G, and 5G wireless standards. *Id.*

To support its research efforts, KPN licenses its patents directly, as well as through patent pools, and has provided licenses to many of the world's leading technology companies, including Microsoft, LG, Lenovo, BlackBerry, Nokia,

Ericsson, Dell, Oracle, Xiaomi, Acer, HTC, Huawei, Cisco, HP, ZTE, Fujitsu, ASUSTek, TCL, Motorola, Oracle, Panasonic, and Sony. *Id.* ¶ 2. Samsung also has licensed KPN's patents at various points, including in its 2016 Settlement Agreement with KPN, discussed further below.

B. THE 2016 SETTLEMENT AGREEMENT

Around 2015, KPN filed multiple lawsuits against Samsung in the United States, as well as in Germany and China, to attempt to resolve Samsung's willful infringement of several of KPN's patented inventions. *Id.* ¶ 4. Each United States lawsuit was filed before the United States District Court for the Eastern District of Texas, Marshall Division. *See Koninklijke KPN NV v. Samsung Electronics America, Inc.*, 2:14-cv-01165 (E.D. Tex.); *Koninklijke KPN NV v. Samsung Electronics America, Inc.*, 2:15-cv-00948 (E.D. Tex.). In response, Samsung filed IPRs challenging several of the asserted patents. *See Samsung Electronics Co., Ltd. v. Koninklijke KPN N.V.*, IPR2016-00392 (challenging U.S. Patent No. 6,212,662); *Samsung Electronics Co., Ltd. v. Koninklijke KPN N.V.*, IPR2016-00808 (challenging U.S. Patent No. 8,886,772); *Samsung Electronics Co., Ltd. v. Koninklijke KPN N.V.*, IPR2016-01087 (challenging U.S. Patent No. 9,014,667).

In 2016, just weeks before facing a federal jury trial, Samsung agreed to settle KPN's infringement claims for a combination of an upfront payment and a promise of future compensation in the form of patent pool licensing revenue. Ex. 2101 ¶ 5.

The parties' respective obligations were detailed in their 2016 Settlement Agreement. Ex. 2102. After the 2016 Settlement Agreement was executed, Samsung jointly moved to terminate the then-pending IPR proceedings against KPN, and the Board granted those requests. *See Samsung Electronics Co., Ltd. v. Koninklijke KPN N.V.*, IPR2016-00392, Paper 26; *Samsung Electronics Co., Ltd. v. Koninklijke KPN N.V.*, IPR2016-01087, Paper 9.¹

C. THE FIRST BREACH LAWSUIT

In 2021, Samsung breached the 2016 Settlement Agreement by taking a license to a contractually defined "Patent Pool" that triggered certain payment obligations under Article 2.3.1. Ex. 2101 ¶ 7; Ex. 2106 ¶¶ 9-41. Rather than pay KPN as required, Samsung hid the fact that it had entered into a Patent Pool agreement and did not pay KPN a single cent. Ex. 2101 ¶ 7.

In fact, when KPN subsequently learned that Samsung's payment obligation had been triggered, it reached out to Samsung to give it an opportunity to remedy its breach. *Id.* ¶ 8. Samsung refused. *Id.* Accordingly, KPN filed suit against Samsung in September of 2022. Ex. 2106. That lawsuit proceeded before the state court in Houston, Texas under Case No. 22-0762 ("First Breach Lawsuit"). *Id.*

¹ Institution was denied in *Samsung Electronics Co., Ltd. v. Koninklijke KPN N.V.*, IPR2016-00808 before the Settlement Agreement was executed.

On February 23, 2024, after a four-day trial, the jury found that Samsung had breached Article 2.3.1 of the 2016 Settlement Agreement by doing exactly what KPN had alleged: taking a license to a Patent Pool without paying KPN the agreed “KPN share.” Ex. 2107, 5. And the jury’s verdict demonstrated the magnitude of Samsung’s actions. The jury awarded KPN **\$287 million** in contractual damages, i.e., the “KPN share,” calculated by applying the minimum per unit contractual rate KPN was entitled to receive (per the terms of the relevant Patent Pool agreements) to the billions of Samsung products sold during the relevant timeframe. *Id.* at 6. The court ultimately entered judgment on the verdict, awarding KPN more than **\$342 million** plus accruing interest. Ex. 2108, 2-3.

D. SAMSUNG’S POST-VERDICT EFFORTS

Since the verdict, Samsung has embarked on a nationwide campaign to try to force KPN to abandon its judgment by making litigation as expensive and painful as possible.

1. Samsung’s “Removal” Attempt

One business day after the verdict was rendered, Samsung removed the state-court breach of contract case to federal court—arguing that it had realized for the first time *at trial* that KPN actually was asserting a claim for patent infringement that implicated federal jurisdiction. Ex. 2101 ¶ 12. The federal court swiftly rejected Samsung’s ploy, explaining that Samsung had “*no credible* argument that the breach

of contract claim necessarily raises a patent law issue.” *Koninklijke KPN N.V. v. Samsung Elecs. Co.*, No. 2:24-CV-0135-JRG-RSP, 2024 WL 2019739, at *3 (E.D. Tex. Apr. 4, 2024), report and recommendation adopted, 2024 WL 2019726 (Apr. 24, 2024) (emphasis added). Consequently, the federal court clearly ruled that KPN’s state-court claims did not assert or raise patent infringement.

Samsung similarly then tried to persuade the state court that the verdict should be overturned, including because—according to Samsung—“KPN is attempting to recover royalties *for infringement*.” Ex. 2101 ¶ 14 (quoting Mot. for JNOV, at 38, *Koninklijke KPN N.V. v. Samsung Elecs. Co.*, No. 22-0762 (71st Dist. Ct. Harrison Cty. Tex., June 3, 2024)) (emphasis added). The state court likewise rejected that argument. *Id.* Thus, both a federal and state court have rejected Samsung’s attempts to portray KPN as having asserted patent infringement claims against Samsung.

2. Samsung’s Declaratory Judgment Lawsuits

Samsung then pivoted to its latest tactic: “to make the litigation as painful as possible.” Samsung filed two lawsuits in the United States District Court for the District of Delaware—one on December 31, 2024, and one on January 1, 2025. The former sought a declaratory judgment of non-infringement of 9 different KPN patents, including the ’151 Patent. Ex. 2109, 1. The latter sought a declaratory judgment of non-infringement of 8 different KPN patents. Ex. 2110, 1. Samsung did not seek a declaratory judgment of invalidity in either lawsuit. *See generally* Exs.

2109, 2110.

KPN has moved to dismiss both declaratory actions because, *inter alia*, no actual case or controversy exists given that KPN has never threatened to sue Samsung for infringement of any of the identified patents, including the '151 Patent. *See* Ex. 2111, 18-27; Ex. 2112, 16-25. As explained in KPN's motion to dismiss the declaratory judgment lawsuit involving the '151 Patent, each and every one of Samsung's purported bases for the existence of a case or controversy is fundamentally flawed. *See* Ex. 2111, 19-20 (explaining that KPN did not accuse Samsung of patent infringement or seek patent infringement damages at the breach-of-contract trial); *id.* at 20-23 (explaining that KPN's emails from 2019—***more than five years ago***—and statements from the breach-of-contract trial could not plausibly give rise to a concrete threat of an infringement suit, that KPN never specifically identified any patent-in-suit in any of its communications, and that Samsung's own conduct confirms that it never felt threatened); *id.* at 23-24 (explaining that prior lawsuits filed by KPN against Samsung and unrelated companies involving entirely unrelated patents does not support the existence of a case or controversy); *id.* at 24-26 (explaining that KPN's breach-of-contract damages are irrelevant to whether a case or controversy exists for patent infringement); *id.* at 26 (explaining that the expiration the covenant not to sue in the 2016 Settlement Agreement does not give rise to an imminent threat of an infringement lawsuit).

3. Samsung's IPR Filings

Over the span of a few days beginning January 17, 2025, Samsung also filed six *inter partes* review petitions challenging patents that it has ***never*** been accused of infringing:

- IPR2025-00502 against U.S. Patent No. 9,667,669 (“the ’669 Patent”);
- IPR2025-00503 against U.S. Patent No. 8,660,560 (“the ’560 Patent”);
- IPR2025-00512 against U.S. Patent No. 8,881,235 (“the ’235 Patent”);
- IPR2025-00533 against U.S. Patent No. RE48089 (“the ’089 Patent”);
- IPR2025-00534 against U.S. Patent No. 9,462,544 (“the ’544 Patent”); and
- The present proceeding challenging the ’151 Patent

Notably, these IPR proceedings have zero bearing on the existing breach judgment against Samsung. However, Samsung is aware that the now-challenged KPN patents are currently licensed to dozens of companies and result in millions of dollars in annual licensing revenue that KPN uses to support its extensive research and development efforts to improve its business and advance telecommunications technology. Samsung is thus also clearly aware that invalidating the challenged patents would inflict significant economic harm to KPN’s telecommunications business.

E. THE SECOND BREACH LAWSUIT

On March 3, 2025, KPN filed a state court lawsuit against Samsung for breaching Article 4.1 of the 2016 Settlement Agreement based on its filing of the six

IPRs. Ex. 2101 ¶¶ 28-68.

F. SAMSUNG’S ART WAS CITED AND CONSIDERED IN FAMILY MEMBERS OF THE ’151 PATENT

1. ’151 Patent Family of Patents and Applications

KPN has a pending reissue application for U.S. Patent 9,654,330 (the “’330 Patent”). The Office assigned the reissue application the number U.S. Application No. 16/413,052 (the “Reissue Application”).

The Reissue Application claims priority to the application underlying the ’151 Patent, U.S. Application No. 12/808,665. Ex. 1013 (excerpts of file history of the pending reissue application); Ex. 1012 (excerpts of file history of the ’330 Patent).

During the prosecution of the application resulting in the ’330 Patent (U.S. Application No. 14/015,765), the Examiner rejected claims for obviousness-type double patenting over claims 1-7- and 9-23 of the ’151 Patent. Ex. 1012, at 251-252. The Examiner stated: “Although the claims at issue are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application [No. 14/015,765] is fully disclosed in the patent [’151 Patent] and is covered by the patent since the patent and the application are claiming common subject matter.” *Id.* at 252. In response, KPN filed a Terminal Disclaimer. *Id.* at 159-160, 235.

KPN also filed a Terminal Disclaimer in the Reissue Application. Ex. 1013,

2. The Office Considered the Petition, Asserted References, and Declaration During Prosecution of the Reissue Application

On March 3, 2025, as part of the prosecution of the Reissue Application, KPN cited the Petition, asserted references (Alston, Mela, Fajardo, and Gateva), the declaration of Samsung's proposed technical expert, Dr. Almeroth, and other exhibits in an Information Disclosure Statement. Ex. 2117, at 53-56. The Examiner signed the IDS with the statement "all references considered except where lined through." No reference name was lined through by the Examiner. *Id.* at 27-30.

On April 28, 2025, the Examiner issued a Notice of Allowance in the Reissue Application. *Id.* at 7. The Examiner provided Reasons for Allowance in which none of the Petition's asserted references was identified as the "closest art":

Regarding claims 1, 16, and 17, the closest art, Nguyenphu, discloses a multimedia session between the first and second terminals, with the gateway merely acting as a relay, but not a multimedia session that is simply between the first terminal and gateway. No other art could be found that disclosed the claim limitations such that the first, second, and third protocols are all different.

Id. at 14.² KPN paid the issue fee on May 2, 2025. *Id.* at 3-5.³

3. The Office Considered Mela During Prosecution of the '151 and '330 Patents

Ground 3 of the Petition relies on Mela as the primary reference. Pet., 2. As Samsung itself admits, Mela was not only before the Office during original prosecution, it was specifically applied in obviousness rejections issued by the Examiner, and the Examiner then concluded that those rejections had been overcome. Pet., 83-84; *see, e.g.*, Ex. 1002, at 68-75 (Office Action dated Oct. 16, 2012); *id.* at 11-21 (Notice of Allowance).

The same Examiner conducted the examination of both the '151 and '330 Patents. During prosecution of the '330 Patent, the Examiner applied Mela in multiple obviousness rejections, all of which were overcome. *See, e.g.*, Ex. 1012, at 481-483 (Office Action dated Dec. 11, 2014), 330-332 (Office Action dated July 13, 2015), 268-270 (Final Office Action dated Feb. 25, 2016); *id.* at 9-13 (Notice of Allowance). Samsung submitted a 690-page excerpt of the file history of the '330

² Nguyenphu is U.S. Patent Application Publication No. 2006/0230154. Ex. 1013, at 83.

³ After KPN paid the issue fee, the Examiner issued a Corrected Notice of Allowability to correct a typographical error in Form PTO-37. Ex. 2118, at 4.

Patent with the Petition (Ex. 1012), but the Petition does not address the Examiner's consideration of Mela during prosecution of the '330 Patent. *See* Pet., 83-84.

III. DISCRETIONARY DENIAL IS WARRANTED

It is well-settled that institution of IPR is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“the PTO is permitted, but never compelled, to institute an IPR proceeding”); *see also* 35 U.S.C. § 314(a) (“[t]he Director may not authorize an inter partes to be instituted unless...”); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). In determining whether to exercise discretion to deny institution, the Director “consider[s] the effect of any such regulation [under this section] on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.” 35 U.S.C. § 316(b).

Consistent with this authority, the Workload Memo makes clear that the Director will consider “all relevant considerations” in determining whether discretionary denial is warranted, including but not limited to the strength of the unpatentability challenge, the extent of the petitioner’s reliance on expert testimony, settled expectations of the parties, compelling economic interests, and the ability of the PTAB to comply with its statutory deadlines. Workload Memo, 2-3.

Discretionary denial is warranted here based on these and other relevant discretionary considerations, particularly given the unique facts presented.

A. The absence of a clear infringement dispute favors exercising discretion.

Inter partes review proceedings are designed to serve as a “true alternative” to district court proceedings. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential). In virtually all IPR and PGR petitions filed that is the case—there is a clear case or controversy based on an existing or threatened patent infringement lawsuit. Indeed, of the 431 IPRs and PGRs filed between January 1 and April 17 of this year, nearly **90%** involved a patent asserted by the petitioner in district court litigation. Ex. 2115.⁴ Moreover, of the 67 IPRs filed by Samsung during that period ***all*** involved patents that had been asserted against Samsung, *except* for the six IPRs filed against KPN in retaliation and two others. Ex. 2116.⁵

⁴ Counsel for KPN manually reviewed the 431 IPR or PGR filings using Docket Navigator (<https://www.docketnavigator.com/>) to determine the percentage involving patents that had been asserted against petitioner in litigation.

⁵ *Samsung Electronics Co., Ltd. v. Headwater Partners II LLC*, IPR2025-00426 (filed Jan. 8, 2025) and *Samsung Electronics Co., Ltd. v. Ouraring Inc.*, IPR2025-00147 (filed Jan. 23, 2025) do not appear to involve patents asserted against Samsung. However, it is unclear whether Samsung was expressly threatened with

This proceeding—including any instituted trial—cannot serve as a “true alternative” to district court proceedings, as there is no case or controversy involving the ’151 Patent. *Sotera Wireless, Inc.*, IPR2020-01019, Paper 12 at 19. Indeed, KPN has not asserted the ’151 Patent against Samsung. Nor has KPN even threatened Samsung with an infringement suit. Thus, unlike virtually all other IPRs and PGRs pending before the PTAB, there is a legitimate question as to whether Samsung’s proceedings serve as a true alternative to litigation given the lack of a clear infringement dispute between the parties.

Notably, there appears to be a pattern of Samsung filing a large number of IPRs against patents not even asserted or threatened against it. For example, Samsung very recently had its declaratory judgment action for non-infringement against Oura dismissed because Samsung failed to allege “an actual controversy existed.” *See Samsung Electronics Co., Ltd. v. Oura Health OY*, No. 24-cv-03245, 2025 U.S. Dist. LEXIS 57989, 2025 WL 929410 (N.D. Cal. Mar. 27, 2025). Despite this, Samsung chose to burden the PTAB with ten IPR or PGR petitions challenging Oura’s patents. *See* PGR2024-00030, -31, -38, -39; IPR2024-00928, -930, -1077, -1078, -1079; IPR2025-00147.

Given “the current workload needs of the PTAB” and consideration of “the

an infringement lawsuit based on those patents.

ability of the PTAB to comply with ... its statutory deadlines for AJA proceedings,” institution should be discretionarily denied so that the Board may prioritize IPRs and PGRs that unquestionably serve as a true alternative to district court proceedings—i.e., those proceedings involving patents that have been asserted in district court or have *clearly* been alleged to be infringed. As a general matter, whether a *clear* case or controversy exists should always be an important consideration in the discretionary denial calculus, but even more so now given the current workload needs of the PTAB. Indeed, assuming institution is discretionarily denied on this basis, Samsung can simply refile its IPR petition if a clear case or controversy actually comes to fruition, at which point the PTAB may have additional available resources.

B. Legitimate questions about the purpose of the Petition heavily favors exercising discretion.

Board precedent dictates that “legitimate questions about whether the petition is reasonably designed to advance the beneficial aims of the AIA or this Office” should be considered in determining whether discretionary denial is appropriate. *See OpenSky Industries, LLC*, IPR-2021-01064, Paper 102 at 36. The facts here suggest that the six Samsung petitions filed against KPN are not reasonably designed to advance these aims, but are instead part of an expansive nationwide campaign by Samsung to exert economic pain on KPN in retaliation for KPN’s \$342M+ breach of contract judgment. Indeed, it was only *after* Samsung was found liable for its

breach of the 2016 Settlement Agreement that it filed its barrage of IPRs targeting patents that Samsung knows have economic value to KPN's 150-year-old business.

Samsung's counsel in the declaratory judgment lawsuits has been chastised for engaging in this type of behavior before. For example, one court determined that counsel had filed wave after wave of patent challenges as part of a plan "to make the litigation as painful as possible" to try to force the other party to abandon its claims—an approach a court described as a "sharp practice that falls far short of model professional conduct[.]" *Vasudevan Software, Inc. v. MicroStrategy, Inc.*, No. C 11-06637 RS, 2013 U.S. Dist. LEXIS 197435, 2022 WL 2354916, *4-5, 10-11 (N.D. Cal. Mar. 8, 2013) (noting that counsel had even gone so far as to attack patents of unrelated clients of the patent holder's attorney).

Samsung's conduct here is similar. Samsung attempted to remove the breach-of-contract case to federal court, despite the court finding that Samsung had "no credible argument that the breach of contract claim necessarily raises a patent law issue." *Supra* II.E.1. Samsung then offered a similar argument to the state court, which was also rejected. *Id.* When both of those efforts failed, Samsung embarked on its nationwide campaign to exert as much pain as possible on KPN by first filing the two declaratory judgment actions involving 17 different patents—none of which have ever been asserted or even threatened against Samsung. Samsung followed up with its six IPR petitions targeting patents that also have never been asserted (or even

threatened to be asserted) against Samsung, but that Samsung knows have significant economic value to KPN.

The Director need not determine whether the purpose behind Samsung's petitions is legitimate—the mere existence of a *legitimate question* should weigh in favor of exercising discretion to deny institution. Indeed, in virtually all IPRs and PGRs before the Board, there is no question that the petition is designed to advance the aims of the AIA or the Office. That is not the case here, as there is ample evidence creating doubt about the impetus for Samsung's filings. *OpenSky Industries, LLC.*, IPR-2021-01064, Paper 102 at 36 (PTAB Oct. 4, 2022) (determining that petitioner “abused the IPR process by filing this IPR in an attempt to extract payment from” patent owner and explaining that, “[a]lthough it is not *per se* improper for a person not charged with infringement to file an IPR petition, the posture of a petitioner, in conjunction with other surrounding circumstances, could raise legitimate questions about whether the petition is reasonably designed to advance the beneficial aims of the AIA or this Office and whether, in addition, the filing amounts to an abuse of process”). Where there is a legitimate risk that an IPR or PGR has been filed for an improper purpose, the Director should err on the side of exercising discretion to ensure that the Office is not being used as a tool for abuse and that the Board's finite resources are being dedicated to proceedings that do not have an aura of impropriety.

C. KPN may suffer irreparable harm if the Board addresses the merits of the Petition.

Discretionary denial is also warranted because KPN would be irreparably harmed if the Board addresses the merits of the Petition and then the state court determines that Samsung has breached Article 4.1. While Samsung's Petition is weak, any determinations of the Board on the merits would be entered into the public domain and would be freely available for any future petitioner to rely upon to address weaknesses in Samsung's petitions. For example, even a decision denying institution on the merits would include a detailed, comprehensive Board analysis identifying weaknesses in the Petition and potentially providing the blueprint for future petitioners to prepare an improved petition. It would be unjust to allow Samsung's improperly filed petitions to be the catalyst for what would in essence be an advisory opinion of the Board providing a blueprint for future validity attacks.

Issuing a merits-based opinion based on such a petition would harm KPN in a way that could not be undone. In short, where there is a legitimate risk that a patent owner may be improperly and irreparably harmed by a merits-based decision of the Board, the PTAB should err on the side of exercising discretion.

D. Compelling economic interests favor exercising discretion.

The Workload Memo specifically identifies compelling economic interests as one of the relevant considerations for discretionary denial. Workload Memo, 2.

Here, there is a compelling economic interest in innovative technology

companies, such as KPN, developing new patented technology, which can then be licensed throughout the United States and rest of the world. Indeed, some of the largest telecommunications companies and smartphone manufacturers in the world are licensees of patented technologies that KPN spent decades developing. The licensing revenue from KPN's patented technologies not only funds its telecommunications service business, but also encourages KPN to continue developing new technologies, many of which become part of the wireless standards adopted throughout the world. Samsung's retaliatory targeting of KPN patents, which are not even asserted against Samsung, undermines this compelling economic interest by discouraging companies like KPN from further innovation.

E. The Office's consideration of the Petition, asserted references, and declaration in the Reissue Application favors exercising discretion.

During prosecution of the allowed Reissue Application, the Office considered the Petition, asserted references (Alston, Mela, Fajardo, and Gateva), and the declaration of Samsung's proposed technical expert, Dr. Almeroth. *Supra* II.F.2. Thus, the Office already considered the teachings of Alston, Mela, Fajardo, and Gateva and reached a different conclusion on patentability than now urged by Samsung and Dr. Almeroth. The Examiner found that a reference not asserted in the Petition, Nguyenphu, was the "closest art." Ex. 2117, at 14.

Allowed Claim 1 of the Reissue Application is similar in scope to, for

example, Claims 1 and 7 of the '151 Patent, as shown in the table below.

Reissue Application	'151 Patent
1. A method, wherein a gateway is capable of communicating with a first terminal and a second terminal, the method comprising: the gateway or the first terminal using a first protocol to exchange first multimedia session information between the first terminal and the gateway, wherein the exchange of the first multimedia session information establishes a first multimedia session between the first terminal and the gateway according to the first protocol and sets up a first media stream from the first terminal, and wherein the first multimedia session information includes a type of media; the second terminal using a second protocol to receive a trigger provided by the gateway or first terminal, wherein the trigger is to	1. %A method, wherein a gateway is capable of communicating with a first terminal and a second terminal, the method comprising: the gateway or the first terminal using a first protocol to exchange first media session information between the first terminal and the gateway, wherein the exchange of the first media session information sets up a first media stream from the first terminal; the second terminal using a second protocol to receive a trigger provided by the gateway, wherein the trigger is to initiate an exchange of second media session information between the gateway and the second terminal; in response to receiving the trigger, the second terminal using a third

initiate an exchange of second multimedia session information between the gateway and the second terminal, and wherein the trigger serves to inform the second terminal of availability of a new multimedia stream; in response to receiving the trigger, the second terminal using a third protocol to initiate the exchange of the second multimedia session information between the gateway and the second terminal, wherein the exchange of the second multimedia session information establishes a second multimedia session according to the third protocol and sets up a second media stream to the second terminal in which the second terminal participates; and the second terminal receiving the second media stream, wherein the second media stream is associated with the first media stream, wherein the first protocol, the	protocol to initiate the exchange of the second media session information between the gateway and the second terminal, wherein the exchange of the second media session information sets up a second media stream in which the second terminal participates; and the second terminal receiving the second media stream, wherein the second media stream is associated with the first media stream; wherein the first media stream is between the first terminal and a media server, wherein the second media stream is between said media server and the second terminal, and wherein said media server buffers at least part of the first media stream received from the first terminal before transmitting the second media stream to the second terminal.
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second protocol, and the third protocol are all different.	
	7. The method of claim 1, wherein the third protocol is different from the second protocol.

Compare Ex. 2117, at 37-43 (allowed Claims of the Reissue Application), *with* Ex. 1001, at 14:49-18:18 (issued claims of the '151 Patent).

The similarity of the scope of the allowed claims of the Reissue Application and the issued claims of the '151 Patent is supported by the Terminal Disclaimers in the '330 Patent and the Reissue Application. Ex. 1012, at 159-160, 235; Ex. 1013, 730-731; *supra* II.F.1.

The Examiner in the Reissue Application independently came to the conclusion that Alston, Mela, Fajardo, and Gateva do not render the claims of the Reissue Application unpatentable, contrary to Samsung's arguments in the Petition. To reach a different conclusion in this IPR would undermine the work already input by the Office and create inefficiencies and inconsistencies in the evaluation of patents. *Advanced Bionics, LLC v. Med-el Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8-9 (PTAB Feb. 13, 2020) (precedential) (“[T]his framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.”). The Petition, Alston, Mela,

Fajardo, Gateva, and Dr. Almeroth's declaration were cited in an IDS that was signed by the Examiner. Ex. 2117, at 27-30. Samsung may argue that more is needed for art to qualify for discretionary denial, but as the Board explained in *Advanced Bionics*, "[p]reviously presented art includes art made of record . . . such as on an Information Disclosure Statement (IDS)." *Advanced Bionics*, at 7-8.

The Office's earlier consideration of the Petition, Alston, Mela, Fajardo, Gateva, and Dr. Almeroth's declaration in the Reissue Application weighs in favor of discretionary denial. The end of examination is not the end of the analysis: the *Becton, Dickinson* factors "broadly provide guidance as to whether the art presented in the petition is that 'same or substantially the same' as the prior art previously presented to the Office during *any* proceeding, including prior AIA proceedings." *Id.* at 10 (emphasis added).

F. The weakness of the validity challenge favors exercising discretion.

The Workload Memo identifies "the strength of the unpatentability challenge" as a relevant consideration. Workload Memo, 2. This consideration favors discretionary denial because Samsung's patentability challenges are weak.

Grounds 1 and 2 of the Petition rely on Alston as the primary reference, and Ground 3 of the Petition relies on Mela as the primary reference. Pet., 2. As noted above, and as Samsung itself admits, Mela was not only before the Office during original prosecution, it was specifically applied in obviousness rejections by the

Examiner. *Supra* II.F.3; Pet., 83-84. Mela was also before the Office during prosecution of the '330 Patent and applied in obviousness rejections by the Examiner. *Supra* II.F.3. Mela was also before the Office during prosecution of the Reissue Application. Mela was thus already carefully considered by the Office (twice) and determined to not render any issued claims of the '151 Patent or the '330 Patent unpatentable—even before the Office considered the asserted references in the Reissue Application.

Samsung reasserting Mela hinges on the argument that the Examiner did not examine the same portions of Mela on which the Petition now relies. Pet., 7-9, 83-84. But the file history of '151 Patent shows otherwise: the Examiner considered the very portions of Mela that the Petition cites, yet reached a different conclusion.

The Petition asserts that “in prosecution, Examiner only relied on Fig. 9 for the ‘H2—SUBSCRIBE’ message (EX1002, 69-70),” “Petitioner relies on the messages ‘H4.NOTIFY,’ not considered by the Examiner,” and “[t]he Examiner further erred by not considering this portion of Mela’s disclosure.” Pet., 8. The Petition’s characterization of the file history of the '151 Patent is inaccurate.

During prosecution of the '151 Patent, however, the Examiner relied on Fig. 8 and concluded that the H2-SUBSCRIBE message in Mela allegedly corresponds to the “trigger” in claim 1. Ex. 1002, at 68-71. Samsung’s assertion that the “Petitioner relies on the messages starting with ‘H4.NOTIFY,’” Pet. 8, does not

establish what the Examiner supposedly overlooked. To the contrary, Samsung's assertion just reflects its own, different mapping. Nothing in the file history of the '151 Patent indicates that the Examiner retreated from her view that Mela's H2-SUBSCRIBE message was the alleged "trigger" in claim 1, and the Petition offers no evidence to the contrary.

The Examiner treated Mela's H2-SUBSCRIBE messages as the alleged "trigger" in claim 1 during prosecution of the '330 Patent—exactly as she did during prosecution of the '151 Patent. *Compare* Ex. 1012, at 481-483, *with* Ex. 1002, at 68-71. The Examiner's consistency across the '151 and '330 Patents further undermines Samsung's unsupported claim that the Examiner somehow missed relevant disclosure of Mela.

Further, the preliminary response will demonstrate that that the invalidity challenges based on Alston (Grounds 1 and 2) are particularly weak as to claim elements 1[b], 1[c], 1[d], 1[e], and Claim 7 (among others). Similarly, the preliminary response will show that that the ground based on Mela (Ground 3) is especially feeble as to claim elements 1[a], [1d], 1[e], and Claim 7 (among others); such weakness is unsurprising given that the Examiner already found independent claim 1 patentable over Mela.

G. The Petition’s heavy reliance on expert testimony favors exercising discretion.

“The extent of the petition’s reliance on expert testimony” is an enumerated consideration set forth in the Workload Memo. Since the memo issued, the Office has further explained:

extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court.... As the judges have technical and legal expertise, it is not necessary for an expert to explain every aspect of the prior art. It is most helpful if an expert is providing focused testimony, for example to provide helpful context or to explain terms of art. The failure to provide focused expert testimony may weigh against institution.

FAQs for Interim Processes for PTAB Workload Management, at #21 (published Apr. 25, 2025), <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management> (last visited April 28, 2025) (hereafter, “FAQ #21”).

This consideration favors discretionary denial because the Petition relies heavily on the unfocused declaration testimony of Samsung’s proposed technical expert, Kevin Almeroth, Ph.D. (Ex. 1003). Indeed, Dr. Almeroth’s declaration consists of 318 paragraphs of testimony spanning 155 pages. *See generally* Ex. 1003. The Petition extensively cites to and relies upon his testimony, including to try and plug holes by arguing that certain features not disclosed on the relied-on references would have been obvious. *See, e.g.*, Pet., 13, 25, 42, 46-47, 50, 52-53, 68.

Moreover, at minimum there are “reasonable disputes between experts on dispositive issues.” FAQ #21. Indeed, the preliminary response will identify several disputes between experts as to whether certain limitations of the independent claims are obvious based on, the prior art in each ground, including claim elements 1[a], 1[b], 1[c], 1[d], 1[e], and Claim 7, among others. While KPN submits that the prior art clearly fails to teach these limitations, at minimum there exist reasonable disputes between experts that are “better resolved in an Article III court.” *Id.*

Further, Dr. Almeroth’s declaration contains much of the same language as the Petition. *Compare* Pet. 13-39 (Ground 1), *with* Ex. 1003 ¶¶ 87-152 (discussing Ground 1); Pet. 39-52 (Ground 2), *with* Ex. 1003 ¶¶ 153-214; Pet. 53-82 (Ground 3), *with* Ex. 1003 ¶¶ 215-307 (discussing Ground 3). However, the Board has been skeptical of petition arguments repeated verbatim by a witness purporting to give expert testimony. *Kinetic Techs., Inc. v. Skyworks Solutions, Inc.*, IPR2014-00529, Paper 8, at 14-15, 23 (PTAB Sep. 23, 2014) (denying institution). Such skepticism is warranted in reviewing Samsung’s Petition, in light of Dr. Almeroth’s extensive repetition of the Petition in his declaration. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15, 18 (PTAB Aug. 24, 2022) (denying institution). The Board’s resources would be better allocated to other petitions more grounded in substance.

H. The long-settled expectations of the parties favor exercising discretion.

“Settled expectations of the parties, such as the length of time the claims have been in force,” favor discretionary denial. Workload Memo, 2. The claims of the ’151 Patent issued over a decade ago and Samsung has been aware of it for years. Thus, the expectation of KPN that the claims of the ’151 Patent are valid were not only reasonable based on the length of time the claims have been in force, but also based on the length of time that **Samsung** waited before challenging its validity⁶ and the fact that Ericsson found the claims to be so strong that it abandoned its invalidity defense entirely. As demonstrated by its conduct, Samsung had the same expectation—until it was found liable for \$342M+ for breaching the parties’ 2016 Settlement Agreement.

Moreover, since the issuance of the ’151 Patent, KPN has continued to build up its telecommunications business and invest resources into new telecommunications technologies, with the reasonable expectation that the ’151 Patent would remain a valuable source of licensing revenue. KPN has a portfolio of more than 325 patent families, and KPN’s patented inventions are the product of its extensive research and development efforts. KPN spends between \$300M and

⁶ Samsung was aware of the ’151 Patent at least as early as 2019 when it received a list of KPN patents and applications. Ex. 2109 ¶¶ 21, 57.

\$500M every year on research and development. Ex. 2106 ¶ 12.

I. Samsung’s status as a high-volume petitioner favors exercising discretion.

The Workload Memo states that the “Director will also consider the ability of the PTAB to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AJA proceedings, and other workload needs.” Workload Memo, 3.

At the current pace Samsung is filing IPR petitions this year, Samsung will account for **more than 15%** of all IPRs or PGRs filed in 2025. Specifically, of the 431 IPR or PGR petitions filed between January 1 and April 17 of this year, Samsung was a petitioner in 67 of those proceedings. Ex. 2115; Ex. 2116. The post grant process is not reserved for the largest companies in the world—it is a process that is supposed to be available to *all* individuals and businesses that have a legitimate need for a true alternative to district court proceedings, which are significantly more expensive and time consuming than post grant proceedings.

Fundamental fairness dictates that the exercise of discretion should lean toward denial for petitioners that file an abnormally high number of petitions, which places a significant burden on the Board and increases the likelihood that the meritorious challenges of petitioners that rarely file IPRs will be discretionarily denied. Indeed, Samsung’s status as a high-volume filer necessarily means that it is draining significant Board resources that would otherwise be available to petitioners

that seldom ever file post grant petitions. The adverse effects of this are even more pronounced given the current workload needs of the PTAB, resulting in an even greater fairness deficit.

In view of the above, KPN respectfully submits that a petitioner's status as a high-volume filer should weigh in favor of discretionary denial, at least and until the PTAB workload needs are fully addressed such that the temporary Workload Memo is no longer in place. This will help ensure that petitioners who infrequently file petitions are afforded fair consideration, but also motivate petitioners like Samsung to be more deliberate as to which patents they chose to challenge before the PTAB.

J. Discretionary denial would preserve an unusually large amount of Board resources.

Samsung has filed six IPR petitions challenging unrelated and fundamentally different patents. However, the reasons for discretionary denial herein largely apply with equal force to the five other pending petitions. In other words, discretionarily denying in this instance would not only free up Board resources associated with this proceeding, but also those five other proceedings.

Given the Director's focus "on the ability of the PTAB to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AJA proceedings, and other workload needs," KPN respectfully submits that discretionary denial should be favored here because it would result in significant Board resources

becoming available, including for appeals relating to ordinary patent prosecution and *ex partes* proceedings. Indeed, exercising discretion would also preserve substantial Board resources that could be dedicated to IPR or PGR involving patents that have been asserted or *actually* threatened, and which are not the subject of a breach of contract lawsuit.

IV. CONCLUSION

For the reasons above, Patent Owner respectfully requests that the Director exercise discretion and deny institution of *inter partes* review. The fact that there are no pending infringement claims against Samsung—as well as the many other considerations justifying discretionary denial discussed above—warrant discretionary denial.

Dated: May 9, 2025

Respectfully submitted,

/James L. Lovsin/
James L. Lovsin
Registration No. 69,550
Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4), the undersigned certifies that on May 9, 2025, a copy of the foregoing document (Patent Owner's Request for Discretionary Denial, including all Exhibits), was served via electronic mail on the attorneys of record at the indicated e-mail address(es).

/James L. Lovsin/
James L. Lovsin

CERTIFICATE OF COMPLIANCE

The undersigned certifies that this document complies with the type-volume limitations set forth in 37 C.F.R. § 42.24 *et seq.* This document, excluding those portions excluded pursuant to § 42.24(a)(1), contains 7,560 words as calculated by the “Word Count” feature of Microsoft Word for Office 365, the program used in creating it.

/James L. Lovsin/
James L. Lovsin