

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

ANONYMOUS MEDIA RESEARCH HOLDINGS, LLC,
Patent Owner

Case IPR2025-00558
U.S. Patent 10,963,911

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

EXHIBIT LIST

Exhibit No.	Description
2001 – 2100	RESERVED FOR PRELIMINARY RESPONSE
2101	U.S. Patent No. 8,296,791 (“the ’791 Patent”)
2102	U.S. Patent No. 8,510,768 (“the ’768 Patent”)
2103	U.S. Patent No. 8,756,622 (“the ’622 Patent”)
2104	U.S. Patent No. 10,572,896 (“the ’896 Patent”)
2105	U.S. Patent No. 10,719,848 (“the ’848 Patent”)
2106	U.S. Patent No. 10,719,849 (“the ’849 Patent”)
2107	Plaintiff’s First Amended Complaint (Dkt. 61) in <i>Anonymous Media Research Holdings, LLC v. Samsung Electronics America, Inc.</i> , Case No. 2:23- cv-00439-JRG-RSP (E.D. Tex.)
2108	Third Amended Docket Control Order (Dkt. 94) in <i>Anonymous Media Research Holdings, LLC v. Samsung Electronics America, Inc.</i> , Case No. 2:23-cv-00439-JRG-RSP (E.D. Tex.)
2109	Samsung’s Petition for <i>Inter Partes</i> Review of U.S. Patent No. 10,719,848, Paper 1, IPR2024-01350
2110	Samsung’s Petition for <i>Inter Partes</i> Review of U.S. Patent No. 10,719,849, Paper 1, IPR2024-01349
2111	Samsung’s Petition for <i>Inter Partes</i> Review of U.S. Patent No. 10,719,896, Paper 1, IPR2024-01348
2112	Mar. 21, 2025, Decision Denying Institution, Paper 19, IPR2024-01350, U.S. Patent No. 10,719,848

Exhibit No.	Description
2113	Mar. 24, 2025, Decision Denying Institution, Paper 16, IPR2024-01349, U.S. Patent No. 10,719,849
2114	Docket Sheet as of May 6, 2025 in <i>Anonymous Media Research Holdings, LLC v. Samsung Electronics America, Inc.</i> , Case No. 2:23-cv-00439-JRG- RSP (E.D. Tex.)
2115	Decision Granting Revival of U.S. Patent Application No. 13/914,870 (issued March 19, 2025)
2116	Samsung’s Motion to Stay (Dkt. 42) Pending <i>Inter Partes</i> Review in <i>Anonymous Media Research Holdings, LLC v. Samsung Electronics America, Inc.</i> , Case No. 2:23-cv-00439-JRG-RSP (E.D. Tex.)
2117	Claim Construction Order (Dkt. 106) in <i>Anonymous Media Research Holdings, LLC v. Samsung Electronics America, Inc.</i> , Case No. 2:23-cv-00439-JRG-RSP (E.D. Tex.)
2118	<i>MyPort, Inc. v. Samsung Elecs. Co., Ltd.</i> , No. 2:22-CV-00114-JRG, Dkt. 73 (E.D. Tex. June 13, 2023)
2119	<i>Solas OLED Ltd. v. Samsung Display Co., Ltd.</i> , No. 2:19-CV-00152-JRG, Dkt. 133 (E.D. Tex. July 17, 2020)
2120	<i>Oyster Optics, LLC, v. Infinera Corp.</i> , No. 2:19-CV-00257-JRG, Order, Dkt. 87 (E.D. Tex. July 17, 2020)
2121	Docket Navigator “Time to Trial” Statistics for Judge Rodney Gilstrap from May 6, 2015 to May 6, 2025
2122	Anonymous Media Research Holdings, LLC’s Unopposed Motion for Leave to Amend Infringement Contentions (Dkt. 74) in <i>Anonymous Media Research Holdings, LLC v. Samsung Electronics America, Inc.</i> , Case No. 2:23- cv-00439-JRG-RSP (E.D. Tex.)
2123	Samsung’s Third Supplemental Invalidity Contentions in in <i>Anonymous Media Research Holdings, LLC v. Samsung Electronics America, Inc.</i> , Case No. 2:23- cv-00439-JRG-RSP (E.D. Tex.)

Exhibit No.	Description
2124	Docket Navigator All PTAB Filing Search Results from Jan. 1, 2025 to May 5, 2025.
2125	Docket Navigator “Samsung Electronics” PTAB Filing Search Results from Jan. 1, 2025 to May 5, 2025.
2126	Docket Navigator “Apple” PTAB Filing Search Results from Jan. 1, 2025 to May 5, 2025.
2127	Docket Navigator “Amazon” PTAB Filing Search Results from Jan. 1, 2025 to May 5, 2025.
2128	Docket Navigator “Google” PTAB Filing Search Results from Jan. 1, 2025 to May 5, 2025.

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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 Anonymous Media Research Holdings, LLC (“Anonymous”) 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 under *Fintiv*¹ 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, whether validity was previously adjudicated, the extent of the petitioner’s reliance on expert testimony and the ability of the PTAB to comply with its statutory deadlines. Workload Memo at 2-3. Given the unique circumstances presented here, discretionary denial is warranted.

First, discretionary denial is warranted because the Board has already determined—in multiple related IPR proceedings—that the primary references relied on by Petitioner do not constitute prior art. Each ground in the Petition asserts as alleged prior art a published non-provisional application (i.e., “Steuer750”) or issued U.S. Patent No. 8,677,389 (“the ’389 Patent” or “Steuer389”), both of which

¹ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential) (hereinafter, “*Fintiv*”)

are ***from the same family as the challenged '911 Patent***. The Petition contends that the Steuer750 and the '389 Patent constitute prior art because the challenged claims are directed toward “video data” and that, at best, support for “video data” embodiments was not added until long after the Steuer750 and the '389 Patent published or issued. However, the Board explicitly rejected this same argument when it recently denied institution of two related patents with substantively identical specifications that claim priority through the same chain as the '911 Patent. The Board determined that the written description common to all non-provisional applications in the priority chain—including the chain of the '911 Patent—provide clear support for video-based embodiments and, thus, the earlier non-provisional applications and related issued patents do not constitute prior art. Because the Petition is premised on the same prior art theory and arguments that the Board has already twice rejected, discretionary denial is appropriate.

Second, discretionary denial is warranted under *Fintiv*. Jury trial is scheduled for September 8, 2025 in the Eastern District of Texas—about four months away. This is the same day as the projected institution decision, meaning that the parties and Court will have invested enormously in the litigation prior to the institution decision. Moreover, the projected final written decision deadline is a full year *after* the jury trial begins. In light of these facts and others, all six *Fintiv* factors heavily favor discretionary denial.

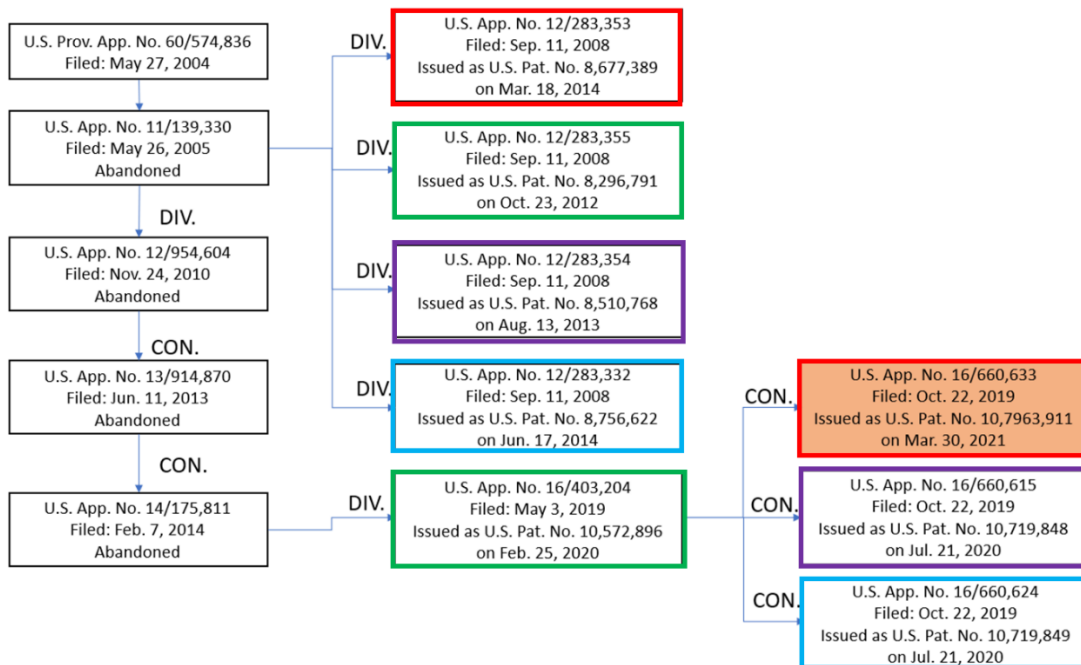
II. BRIEF BACKGROUND

In September 2023, Anonymous asserted U.S. Patent Nos. 8,296,791 (Ex. 2101, “the ’791 Patent”), 8,510,768 (Ex. 2102, “the ’768 Patent”), 8,756,622 (Ex. 2103, “the ’622 Patent”), 10,572,896 (Ex. 2104, “the ’896 Patent”), 10,719,848 (Ex. 2105, “the ’848 Patent”), and 10,719,849 (Ex. 2106, “the ’849 Patent”) against Samsung Electronics America, Inc. and Samsung Electronics America, Inc. (collectively, “Samsung”) in the Eastern District of Texas. *Anonymous Media Research Holdings LLC v. Samsung Electronics Co. Ltd.*, No. 2-23-cv-00439 (E.D. Tex.). The ’911 and ’389 Patents were later added to the lawsuit. Ex. 2107 at 1.

The eight patents are in the same family and can conceptually be broken down into four pairs—with one patent in each pair directed toward an “audio data” embodiment of an invention and the other patent in the pair directed toward a “video data” embodiment of essentially the same invention. As an illustrative example, the claims of the ’768 Patent are directed toward “scrubbing” based on **audio** data samples, whereas the claims of the ’848 patent are directed toward “scrubbing” based on **video** data samples. *Compare* Ex. 2102, claim 1 *with* Ex. 2105, claim 1. Aside from the “audio” versus “video” distinction, the claims are largely identical as between these two patents in the pair. A color-coded table for easily visualizing the four pairs is provided below.

Claimed Subject Matter	Patent	Data-Type
Deducing Play-Altering Actions	'791 (Ex. 2101)	Audio
	'896 (Ex. 2104)	Video
Scrubbing Play Streams	'768 (Ex. 2102)	Audio
	'848 (Ex. 2105)	Video
Channel Identification	'622 (Ex. 2103)	Audio
	'849 (Ex. 2106)	Video
Sample Time-Window Adjustment	'389 (Ex. 1006)	Audio
	'911 (Ex. 1001)	Video

A partial family tree from the Petition is reproduced with colored-boxes corresponding to the table to illustrate the relationship between the patents:



Pet. at 3. As shown, all four video-data patents claim priority back to U.S. Application No. 11/139,330 (“the ’330 Application”) through U.S. Application No. 14/175,811 (“the ’811 Application”). And the four audio-data patents claim priority to the ’330 Application as part of a separate priority chain.

In August 2024, Samsung filed IPR petitions challenging the '896, '848, and '849 patents, which are the video-data patents in each of their respective pairs. *Samsung Electronics Co., Ltd. v. Anonymous Research Holdings, LLC*, IPR2024-01348, Paper 1 (challenging '896 Patent); *Samsung Electronics Co., Ltd. v. Anonymous Research Holdings, LLC*, IPR2024-01349, Paper 1 (challenging '849 Patent); *Samsung Electronics Co., Ltd. v. Anonymous Research Holdings, LLC*, IPR2024-01350, Paper 1 (challenging '848 Patent).² Samsung filed the Petition in this proceeding challenging the '911 Patent about three months after the '911 Patent was added to the lawsuit. Paper 1. Consequently, Samsung's petitions only challenge the four video data patents.

Each petition sought to invalidate the challenged video data patents based on an earlier published non-provisional application and an issued patent, both in ***the same family*** as the challenged patents. Specifically, in all four petitions Samsung contends that the challenged claims are not entitled to the '330 Application priority

² Roku filed IPR petitions challenging the '791, '768, '622, '896, '848 and '849 patents. All six were denied on the merits in February 2025. *Roku, Inc. v. Anonymous Media Research Holdings, LLC*, IPR2024-01053, Paper 9 (denying institution on the '791 Patent); IPR2024-01054, Paper 9 (denying institution on the '768 Patent); IPR2024-01055, Paper 9 (denying institution on the '622 Patent); IPR2024-01056, Paper 10 (denying institution on the '896 Patent); IPR2024-01057, Paper 10 (denying institution on the '848 Patent); IPR2024-01058, Paper 10 (denying institution on the '849 Patent).

date because they claim “video” data embodiments, and the earliest possible support for those embodiments allegedly did not appear until the non-provisional application of the ’896 Patent filed on May 3, 2019. Pet. at 14-15; Ex. 2109 at 12-13; Ex. 2110 at 12-14; Ex. 2111 at 12-14. Thus, according to Samsung, the claims of the ’848, ’849, ’896 and ’911 patents are only entitled to priority date of May 3, 2019, but in no event earlier than November 24, 2010.

Based on the alleged earliest priority date of 2010, Ground 1 in each of the four IPR petitions relies on the publication of the ’330 Application, which published on December 1, 2005 as U.S. Publication No. 2005/0267750 to Steuer et al. (Ex. 1005, “Steuer750”). Pet. at 6-7; Ex. 2109 at 5-7; Ex. 2110 at 5-7; Ex. 2111 at 5-7.

Based on the alleged earliest priority date of 2019, Ground 2 in each of the four IPR petitions relies on the audio-data counterpart to each challenged patent as a primary reference. Specifically, Samsung alleges that the ’389 Patent (issued Mar. 2014) is prior art to the ’911 Patent, that the ’791 Patent (issued Oct. 2012) is prior art to the ’896 Patent, that the ’768 Patent (issued Aug. 2013) is prior art to the ’848 Patent, and that the ’622 Patent (issued June 2014) is prior art to the ’849 Patent. Pet. at 6-7; Ex. 2109 at 5-7; Ex. 2110 at 5-7; Ex. 2111 at 5-7.

A table is provided to show the primary reference relied in on each ground of the four petitions:

Challenged Patent	Ground 1 Primary Reference	Ground 2 Primary Reference
'896 Patent	Steuer750	'791 Patent
'911 Patent	Steuer750	'389 Patent
'848 Patent	Steuer750	'768 Patent
'849 Patent	Steuer750	'622 Patent

It appears that Samsung relied on the audio-data patent counterpart for Ground 2 in each petition, because the claims of those patents are largely identical to the claims of their video-data counterparts. *See e.g.*, Pet. at 46, 54, 55, 61 (relying on the “almost identical language” of the '389 Patent claims to map to the '911 Patent claim limitations).

In March 2025, the Board denied institution of the '848 and '849 petitions on the merits. Specifically, the Board determined that neither Steuer750 of Ground 1 nor the audio-patent counterparts (i.e., the '768 and '622 Patents) asserted in Ground 2 constituted prior art.³ Ex. 2112 at 12-22; Ex. 2113 at 12-22. The Board not only determined that “Petitioner has ***not shown*** that the ‘video data sample’ described in the '330 application ... would have been understood to relate only to the audio data

³ The '896 IPR proceeding was jointly terminated by the parties before the Board issued an institution decision. However, it would have been denied for the same reasons that the '848 and '849 IPRs were denied because the invalidity theory was exactly the same.

sample associated with a video stream,” but also ***affirmatively found*** that “the claims of the ’848 [and ’849] patent[s] are sufficiently supported by the written description in the ’330 application.” Ex. 2112 at 21; Ex. 2113 at 21. As such, the Board has already twice rejected Petitioner’s position that the common written description going back to the ’330 Application only discloses audio-data based embodiments, instead finding that the common written description sufficiently demonstrates that the inventors possessed both audio and video data embodiments.

Turning back to the lawsuit, all patents were jointly dismissed from the suit except for the ’848, ’849 and ’911 Patents. Jury trial on those patents is scheduled for September 8, 2025, about four months away. Ex. 2108 at 1. The parties and Court have invested heavily in the case to date—*e.g.*, fact discovery has closed, the Court issued its claim construction ruling, the parties recently exchanged opening and rebuttal expert reports, and a motion for summary judgment has already been filed. *Id.* at 3; Ex. 2114 at 14-15.

III. DISCRETIONARY DENIAL IS WARRANTED BECAUSE THE BOARD HAS ALREADY TWICE REJECTED THE INVALIDITY THEORIES IN THE PETITION

Ground 1 relies on Steuer750 as the asserted primary reference based on the earliest effective filing date of the challenged claims allegedly being “no earlier than November 24, 2010.” Pet. at 6. Ground 2 relies on Steuer389 (i.e., the ’389 Patent)—the audio-data counterpart to the ’911 Patent—as the asserted primary reference based

on the earliest effective filing date of the challenged claims allegedly being no earlier than May 3, 2019. *Id.* at 7. To support its priority date allegations, Samsung argued that “the ’330, ’604, ’870, and ’811 priority non-provisional applications do not provide adequate written description support for the challenged claims,” because they are directed toward “video data” embodiments, rather than “audio data” embodiments. Pet., 25-31. The entirety of Samsung’s arguments on this issue span roughly five pages. *Id.*

These are the same invalidity theories that Samsung offered in the ’848 and ’849 IPR petitions. Specifically, in Ground 1 of both petitions, Samsung likewise argued that Steuer750 is prior art. Ex. 2109 at 5; Ex. 2110 at 5. For Ground 2 in both petitions, Samsung also argued that the audio-data counterpart—i.e., the ’768 patent for the ’848 IPR and the ’622 Patent for the ’849 IPR—constituted prior art. Ex. 2109 at 6; Ex. 2110 at 6. Both petitions also relied on the same argument that “the ’330, ’604, ’870, and ’811 priority non-provisional applications do not provide adequate written description support for the challenged claims,” because they are directed toward “video data” embodiments, rather than “audio data” embodiments. *Compare* Pet., 25-31 *with* Ex. 2109 at 21-24 *and* Ex. 2110 at 25-29.

In denying institution of the ’848 and ’849 IPRs, the Board expressly rejected these theories. Ex. 2112 at 16-22; Ex. 2113 at 16-21. The Board found that the common written description provided sufficient written description support for video-data based

embodiments. Ex. 2112 at 19 (“This demonstrates that the applicants considered the term ‘media’ to include both audio **and video** and that the invention pertains to both audio **and video data** samples.”), 21 (“[W]e find that the claims of the ’848 patent are sufficiently supported by the written description in the ’330 application.”); Ex. 2113 at 19 (“This demonstrates that the inventor of the ’330 patent considered the term ‘media’ to include both audio **and video** and that the invention pertains to both audio **and video data** samples.”), 21 (“[W]e find that the claims of the ’849 patent are sufficiently supported by the written description in the ’330 application.”) (Emphases added).

Samsung cannot legitimately dispute that this determination applies equally to the present Petition, which relies on the same priority date arguments already rejected by the Board twice. Indeed, while the claims of the ’911 Patent are different than the claims of the ’848 and ’849 Patents, the sole basis for the alleged lack of written description support is the fact that the claims use the word “video” rather than “audio.” Samsung has never alleged that the claimed features lack written description support for any other reason. Consequently, the Board’s determination that the common written description demonstrates possession of the disclosed embodiments as applied to video-data necessarily dooms the present Petition. Because the Board has already determined that Samsung’s invalidity theory lacks merit in two other IPR proceedings,

discretionary denial is warranted.⁴

**IV. DISCRETIONARY DENIAL IS WARRANTED PURSUANT TO
*FINTIV***

A. First Factor: A stay will not be granted, weighing heavily toward denial.

The first *Fintiv* factor is “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Fintiv*, Paper 11 at 6. On September 3, 2024, Samsung sought a stay from the court based on the ’896, ’848 and ’849 IPR petitions filed by Samsung and the six IPRs filed by Roku. Ex. 2116 at 1-2. Briefing closed on October 2, 2024. Ex. 2114 at 10. Seven months have passed; the motion is still pending. *Id.* at 10-15. Since the motion was filed, the Court has permitted the parties to continue fully investing in the litigation, including completing fact discovery and exchanging opening and rebuttal expert reports. *Id.*, 10-15; Ex. 2108 at 3-4. The Court itself has continued investing heavily in the case, holding a *Markman* hearing in March and issuing its claim construction ruling shortly thereafter. Ex. 2108 at 14; Ex. 2117. The Court has also continued to allow the parties to progress toward trial, which is barely four months away. It is thus clear that a stay will not be granted, particularly

⁴ The Petition raises the new theory that the priority chain of the ’911 Patent is defective because the filing fee was not paid during the pendency of the ’870 application. Pet., 7-8. However, the ’870 application has since been revived and the filing fee paid, rendering this argument moot. Ex. 2115.

given that the '848 and '849 IPR petitions were denied.

Moreover, the primary reasons for seeking the stay are now invalid. It can no longer be argued that the litigation is “in an early” or “not ... advanced stage” or that “limited discovery has occurred.” Ex. 2116 at 2, 8. The court would not benefit from the Board’s claim constructions, as neither party has raised claim construction issues in this proceeding⁵ and the Board has *already* addressed claim construction in its decisions denying institution of the six Roku petitions. *See* IPR2024-01053, -1054, -1055, -1056, -1057, -1058 (challenging '791, '768, '622, '896, '848, and '849 Patents, respectively). A stay would also not meaningfully simplify issues (Ex. 2116 at 3), as there are now no pending IPRs challenges against the '848, and '849 Patents, which will be before the jury in about four months.

Moreover, the Court has consistently denied motions to stay under circumstances considerably ***more favorable*** to Petitioner than those here. *See, e.g., MyPort, Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:22-CV-00114-JRG, Dkt. 73, 4-5 (E.D. Tex. June 13, 2023) (denying stay where “the PTAB [final written] decision is not due until ***over two months*** after jury trial is set to begin”) (Ex. 2118); *Solas OLED Ltd. v. Samsung Display Co., Ltd.*, No. 2:19-CV-00152-JRG, Dkt. 133, 4 (E.D. Tex. July 17,

⁵ Anonymous will not raise claim construction issues in its preliminary response, just as it did not in its preliminary responses in the '848 and '849 IPR proceedings.

2020) (denying stay because “trial is only a few months away” and PTAB final written decisions would have been issued months after the scheduled trial) (Ex. 2119); *Oyster Optics, LLC, v. Infinera Corp.*, No. 2:19-CV-00257-JRG, Order, Dkt. 87, 4-5 (E.D. Tex. July 17, 2020) (denying stay because claim construction briefing closed and “[f]act discovery is closing in about a month and trial is only six months away.”) (Ex. 2120). This factor thus weighs heavily in favor of denial. *See Kiss Nail Products, Inc. v. Lashify, Inc.*, PGR2021-00046, Paper 12, 9 (Aug. 9, 2021) (Factor 1 favoring denial, finding that, even though the judge in the parallel ITC proceeding had not suggested it would not entertain a stay, a stay was unlikely given “the advanced state” of the case).

B. Second Factor: The jury trial is looming, weighing heavily toward discretionary denial.

Trial occurs on September 8, 2025—i.e., *a full year before* the projected FWD deadline of September 8, 2026. Ex. 2108 at 1. The Board “generally take courts’ trial schedules at face value absent some strong evidence to the contrary.” *Fintiv*, Paper 15, 13 (May 13, 2020) (informative). Regardless, the court’s median time-to-trial over the past decade is 19 months. Ex. 2021. This factor thus heavily favors discretionary denial. *See AT&T Servs. Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-00992, Paper 14, 10-11 (Dec. 16, 2024) (Factor 2 “weighs substantially in favor of ... denial” when trial is “four to five months prior” to FWD); *Ericsson Inc. v. Active Wireless Techs.*, IPR2024-00886, Paper 8, 8-9 (Nov. 12, 2024) (Factor 2 favors denial when trial is about 4 months prior to FWD).

C. Third Factor: The parties' and Court's significant investment in the litigation heavily weigh toward discretionary denial.

The Board considers “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9. The parties have engaged in nearly two years of fact discovery including: (1) responding to 35 interrogatories and 186 requests for production; (2) producing over 80,000 pages of documents; (3) at least 18 days of expert source code review at a confidential facility; and (4) 17 fact witness depositions. Infringement and invalidity contentions have been exchanged, claim construction briefing is complete, a *Markman* hearing was held, and a claim construction order has been issued. Ex. 2108; Ex. 2114. Fact discovery closed three weeks ago and opening and rebuttal expert reports have been served. Ex. 2108 at 3. There has been extensive motion practice, including a pending motion for summary judgment. Ex. 2114 at 9-13 (#42, 45, 77, 92, 114). The parties and Court will have almost fully invested in the litigation by the institution deadline, which is the same day the jury trial begins. Ex. 2108 at 1. Given the significant amount of litigation investment that will be completed by the projected institution deadline, this factor heavily favors exercising discretion to deny institution. *Cisco Sys., Inc. v. Ramot at Tel Aviv University Ltd.*, IPR2020-00122, Paper 15, 8-9 (May 15, 2020) (Factor 3 favored discretionary denial, where claim construction briefing and contentions were complete, *Markman* hearing was held mere days prior, expert discovery closed in 2 months, and trial was in 7 months).

This factor further favors denial when “the petitioner did not file the petition expeditiously, such as at or around the same time that the patent owner responds to the petitioner’s invalidity contentions, or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial.” *Fintiv*, Paper 11 at 11-12. Although the First Amended Complaint (Ex. 2107) was filed on November 7, 2024 to add the ’911 Patent to the suit, Anonymous served its amended infringement contentions identifying the asserted claims of the ’911 Patent on October 21, 2024. Ex. 2122 at 2. Samsung thus waited nearly ***three and a half months*** after receiving the amended contentions to file the present Petition. Pet. at 87. The delay here is unexplainable given that the Petition largely recycles the exact same invalidity theory and arguments from the ’896, ’848 and ’849 IPR petitions. These facts tilt this factor even heavier toward denial.

D. Fourth Factor: The considerable overlap between issues raised in the Petition and in the parallel proceeding favor discretionary denial.

The fourth *Fintiv* factor considers the “overlap between issues raised in the petition and in the parallel proceeding.” *Fintiv*, Paper 11 at 6. There is complete overlap between the invalidity issues raised in the Petition and in the parallel proceeding, as Samsung asserts the ’389 Patent as prior art against the ’911 Patent in the litigation. Ex. 2123 at 44-45. While Steuer750 is technically not asserted in the litigation, this is irrelevant as Petitioner admits that “Steuer750 and Steuer389 have substantively identical specifications.” Pet. at 42.

Although a *Sotera* stipulation has been submitted (Pet. at 87), the June 21, 2022 memorandum entitled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” was rescinded. Consequently, the stipulation does not independently dictate whether discretion is denied.

Moreover, the PTAB issued recent guidance clarifying that “[w]here the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, **a stipulation may not be particularly meaningful** because the efficiency gained by any AIA proceeding will be limited.” FAQs for Interim Processes for PTAB Workload Management, at #14 (published Apr. 25, 2025), <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management> (last visited April 28, 2025) (emphasis added). Samsung asserts **seven** different public uses, sales, and/or offers for sale as allegedly invalidating claims of the ’911 Patent, both alone and in combination with alleged published prior art, including the ’389 Patent. Ex. 2123 at 30-31, 44-45. Samsung also alleges that **over thirty** different claim terms of the ’911 Patent lack enablement and **over thirty** different claim terms of the ’911 Patent lack written description support. *Id.* at 70, 82-85, 97-100. Samsung further contends that the claims of the ’911 Patent are directed toward ineligible subject matter under 35 U.S.C. § 101. *Id.* at 109-110. Given the remarkably large number of additional invalidity theories asserted by Samsung in the litigation, including seven different alleged public uses, sales and/or offer for sales, the *Sotera* stipulation here

should be given no weight. *See Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB Mar. 28, 2025) (Director Review Decision) (determining that petitioner’s *Sotera* stipulation “does not ensure that these IPR proceedings would be a ‘true alternative to the district court proceeding,’ because the invalidity arguments in district court were “more expensive and include combinations of the prior art asserted in these proceeding with unpublished system prior art, which Petitioner’s stipulation is not likely to moot”). Indeed, the *Sotera* stipulation addresses only a fraction of the overall invalidity theories that Petitioner presents in the litigation.

Finally, even assuming the *Sotera* stipulation here was to be given some meaningful weight, the stipulation would still not be “sufficient when weighed against the other factors.” *See Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00333, Paper 12, 12 (July 7, 2021) (denying institution despite *Sotera* stipulation, emphasizing advanced litigation stage).

E. Fifth Factor: Samsung is Petitioner and Defendant, favoring discretionary denial.

The fifth *Fintiv* factor considers “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, Paper 11 at 6. Samsung is petitioner and the litigation defendant. Thus, this factor favors discretionary denial.

F. Sixth Factor: Other relevant considerations heavily favor discretionary denial.

1. The merits of the Petition are extraordinarily weak.

“[I]f the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring the denial are present.” *Id.* at 14-15. As explained in Section III, the Petition raises the exact same prior art theories that the Board has already rejected in the related ’848 and ’849 IPR proceedings. Moreover, Patent Owner’s preliminary response will largely mirror the preliminary responses and evidence filed in the ’848 and ’849 IPR proceedings, which the Board found compelling in determining that Steuer750 and the audio-data counterparts do not qualify as prior art. Consequently, the merits are not only weak—they are nonexistent.

Moreover, even the presence of compelling merits would not justify institution under these circumstances. Because the Interim Procedure was rescinded, “compelling merits” no longer mandate that the Board decline to exercise its discretion; they are simply one factor to consider. Moreover, compelling merits would not outweigh the balance of factors here, which overwhelmingly weigh toward discretionary denial. Indeed, while “compelling merits” consideration “*may* serve the interest of overall system efficiency and integrity because it allows the proceeding to continue in the event that the parallel proceeding settles or fails to resolve the patentability question presented in the PTAB proceeding,” that is simply

not the case here *Fintiv*, Paper 11 at 14-15 (emphasis added). **All** invalidity issues will be resolved by a jury in four months, rendering institution a waste of the Board's finite resources. Moreover, the '911 Patent expires before trial begins, so no efficiency or integrity purpose would be served by instituting, even if the parties later settle. Ex. 1001 (claiming priority to May 25, 2005 non-provisional and lacking any patent term adjustment).

2. 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. Workload Memo at 2-3. Since the memo issued, the Office has further explained that:

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,

Timothy Wahlers (Ex. 1002). Indeed, Mr. Wahler's declaration consists of 220 paragraphs of testimony spanning 170 pages. *See generally* Ex. 1002. The Petition extensively cites to and relies upon his testimony. *See generally* Pet. (citing up to paragraph 219 of the declaration). This includes trying to support the already-rejected theory that the common written description fails to demonstrate possession of video-data embodiments. *See* Pet. 25-31 (citing Ex. 1002, ¶¶73-83).

Additionally, the Board already found the same testimony offered by Mr. Wahler's to be flawed in the '848 and '849 proceedings on the central issue of whether the common written description provides adequate support for video-data-based embodiments. *Compare* Ex. 2112 at 19-21 and Ex. 2113 at 19-21 *with* Ex. 1002 ¶¶ 73-83 (offering same testimony that the Board identified as flawed in the denial decisions).

Finally, Mr. Wahler's declaration contains much of the same language as the Petition. *Compare e.g.*, Pet. 17-39 (addressing alleged priority issue) *with* Ex. 1002 ¶¶ 52-94 (largely repeating same statements from Petition, but including full block quotes rather than parentheticals or short cites). 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, 14-15 (PTAB 2014) (denying institution). Such skepticism is warranted in reviewing Samsung's Petition, in light of Mr. Wahler's extensive repetition of the Petition and the fact that the Board has already deemed his testimony flawed in the related '848

and '849 proceedings. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15, 19 (PTAB Aug. 24, 2022) (denying institution). The Board's resources would be better allocated to other petitions more grounded in substance.

3. 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 at 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 523 IPR or PGR petitions filed between January 1 and May 5 of this year (Ex. 2124), Samsung was a petitioner in 81 of those proceedings. Ex. 2125.⁶ 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.

While Samsung will undoubtedly point to its size to justify the excessive number of petitions it files, even a cursory comparison to other ultra-large technology

⁶ The search does not account for proceedings where Samsung may be a real party in interest.

companies reveals the fallacy of that position. Over the same period referenced above, Apple accounted for less than 8% of all IPR petitions filed (Ex. 2126), Amazon account for 3.6% (Ex. 2127) and Google accounted for about 2.3% (Ex. 2128). Consequently, Samsung is filing nearly **twice** as many IPR petitions as Apple, **five times** as many as Amazon, and **more than seven times** as many as Google over the same period of time.

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, Anonymous 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. Workload Memo at 3 (explaining that the interim workload processes "are temporary in nature due, in part, to the current workload needs of the PTAB"). This will help ensure that petitioners who infrequently file petitions are

afforded fair consideration, but also motivate petitioners such as Samsung to be more deliberate as to which patents they chose to challenge before the PTAB.

V. CONCLUSION

For the reasons set forth above, Anonymous respectfully requests that the Director exercise discretion and deny institution. The Board has already determined that Steuer750 and the '389 Patent cannot qualify as prior art against the '911 Patent. Moreover, the six *Fintiv* factors heavily favor discretionary denial, particularly given that the jury trial is set to begin in about four months.

Dated: May 6, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

Pursuant to 37 C.F.R. § 42.24 *et seq.*, the undersigned certifies that this document complies with the type-volume limitations. This document, excluding those portions identified under § 42.24 (a)(1) (table of contents, table of authorities, mandatory notices under § 42.8, certificates of service and compliance with word count, appendix of exhibits, and claim listing) contains 5,283 words as calculated by the word processing program used in creating it.

/Stephen D. Zinda/
Stephen D. Zinda

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4), the undersigned certifies that on May 6, 2025, a copy of the foregoing document (*Patent Owner's Request for Discretionary Denial*) and all corresponding exhibits, was served via electronic mail on all attorneys of record at the email addresses provided for electronic service listed in Petitioner's mandatory notices, as set forth below:

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