

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

OS-NEW HORIZON PERSONAL COMPUTING SOLUTIONS LTD.,
Patent Owner

IPR2025-00613
U.S. Patent No. 8,401,875

**PETITIONERS' RESPONSE TO PATENT OWNER'S
DISCRETIONARY DENIAL BRIEF**

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1002	Prosecution History of U.S. Patent 8,401,875 (“’875 PH”)
1003	Declaration of Dr. Andrew Wolfe in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent 8,401,875
1004	Curriculum Vitae of Dr. Andrew Wolfe
1005	Prosecution History of European Patent Office Patent Application No. 11/752,936.2 (“EPO PH”)
1006	Anil K. Jain et al., “ <i>An Introduction to Biometric Recognition</i> ” (2004) (“Jain”)
1007	U.S. Patent App. Pub. No. 2009/0083847 to Fadell et al. (“Fadell”)
1008	U.S. Patent No. 6,539,380 to Moran (“Moran”)
1009	U.S. Patent No. 6,788,928 to Kohinata et al. (“Kohinata”)
1010	U.S. Publication No. 2010/0082490 to Rosenblatt et al. (“Rosenblatt”)
1011	Japanese Patent App. Pub. No. P2001-109855A to Mizusawa et al.
1012	Certified Translation of Japanese Patent App. Pub. No. P2001-109855A to Mizusawa et al. (“Mizusawa”)
1013	U.S. Patent No. 8,495,020 to Nasserbakht et al. (“Nasserbakht”)
1014	U.S. Patent No. 7,313,825 to Redlich et al. (“Redlich”)
1015	U.S. Patent No. 7,587,595 to Scarlata et al. (“Scarlata”)
1016	PO’s Infringement Contentions for the ’875 patent in <i>OS-New Horizon Personal Computing Solutions v. Samsung Electronics Co. Ltd.</i> , No. 2:24-cv-00634-JRG-RSP (E.D. Tex.) (“OSNH v. Samsung – OSNH’s ’875 Patent Infringement Contentions”)

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1018	Excerpt from Bryan Pfaffenberger, “ <i>Webster’s New World Computer Dictionary</i> ” 10th ed. 2003 (“Webster’s Computer Dictionary”)
1019	Ross Anderson, “ <i>Security Engineering</i> ” 2nd ed. 2008 (“Anderson”)
1020	Excerpt from Richard E. Smith, “ <i>Authentication From Passwords to Public Keys</i> ” (2002) (“Smith”)
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1025	Excerpt from Microsoft Corporation, “ <i>Microsoft Computer Dictionary</i> ,” 5th ed. 2002 (“Microsoft Dictionary”)
1026	R. Ricci et al., “ <i>THE ‘SECUREPHONE’ A Mobile Phone with Biometric Authentication and e-Signature Support for Dealing Secure Transactions on the Fly</i> ” (2006) (“SecurePhone”)
1027	ISO/IEC 18092, First Edition Information technology—Telecommunications and information exchange between systems—Near Field Communication—Interface and Protocol (NFCIP-1) (April 1, 2004) (“ISO/IEC 18092”)
1028	ISO/IEC 21481, First Edition – Information technology—Telecommunications and information exchange between systems—Near Field Communication Interface and Protocol -2 (NFCIP-2) (January 15, 2005) (“ISO/IEC 21481”)
1029	U.S. Patent No. 8,199,719 to Taneja (“Taneja”)

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1030	Behzad Razavi, “ <i>RF Microelectronics</i> ,” (1998) (“Razavi”)
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1035	U.S. Patent No. 7,762,469 to Sueoka et al. (“Sueoka”)
1036	Docket Navigator, Gilstrap Uncontested Motions to Stay Pending IPR, 2014-present, pulled June 18, 2025
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1041	Katherine K. Vidal, Under Sec’y of Com. for Intell. Prop. & Dir. of the USPTO, Mem. Re Interim Proc. for Discretionary Denials in AIA Post-Grant Procs. with Parallel Dist. Ct. Litig. (June 21, 2022), <i>rescinded</i> Feb. 28, 2025
1042	Email from A. Shaw to Counsel for PO re OSNH v. Samsung – Case No. 2:24-cv-00634 – Service of Samsung Invalidity Contentions and Document Productions

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1043	<i>America Invents Act: Hearing on H.R. 1249 Before the Subcomm. on Intell. Prop., Competition, & the Internet of the H. Comm. on the Judiciary, 112th Cong. (March 30, 2011)</i>
1044	157 Cong. Rec. H5969 (daily ed. Sept. 8, 2011).

I. Introduction

Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (“Petitioners” or “Samsung”) respectfully request the Director decline to exercise discretionary denial and instead refer the Petition challenging claims of U.S. Patent 8,401,875 (“the ’875 patent”) for consideration on the merits.

The grounds presented in the Petition are undeniably strong. One of the two primary prior art references—Fadell (EX-1007)—was relied upon by the European Patent Office (“EPO”) to reject substantively identical claims in a foreign counterpart application to the ’875 patent. Patent Owner was never able to overcome the Fadell rejection and the European counterpart application never issued.

The U.S. Examiner erred in a manner material to patentability by failing to locate and rely on Fadell during prosecution of the application that led to the ’875 patent, which preceded the EPO examination. As the Director recently recognized, “it is an appropriate use of Office resources to review [a] potential error” by the Patent Office even when there is “a scheduled district court trial date that precedes the date projected for a Board final written decision.” *Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, 3 (PTAB June 12, 2025). That is the case here.

Moreover, the *Fintiv* factors do not support discretionary denial. For one, the challenged patent is the sole patent being asserted in a parallel district court litigation where only four claims are being asserted.¹ Institution will be decided before the parties make meaningful investment in the district court proceeding. In particular, institution is projected to occur three months before the claim construction hearing. In addition, Petitioners herein offers a “*Sotera* plus” stipulation to further limit any overlap with the district court proceeding. Finally, as to settled expectations, the public has an expectation that any owner of the ’875 patent would not assert claims it acquiesced were known in the art.

Because the merits are strong and cancellation of the challenged claims would completely dispose of the Texas Litigation, institution of IPR will achieve Congress’s purpose of “improving patent quality and providing a more efficient system for challenging patents that should not have issued.” (EX-1039, 39-40.)

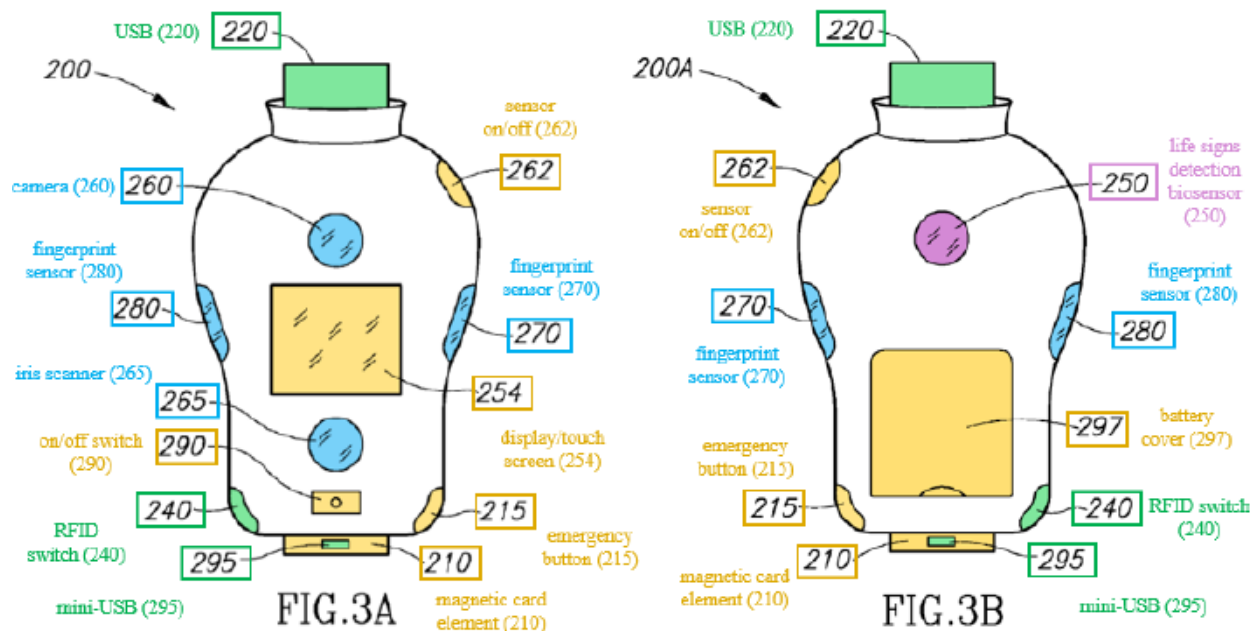
Accordingly, Petitioners respectfully submit that the Director should not exercise discretionary denial.

¹ *OS-New Horizon Pers. Computing Sols. Ltd. v. Samsung Elecs. Co. Ltd. et al.*, No. 2:24-cv-00634-JRG-RSP (E.D. Tex.) (“the Texas Litigation”).

II. The EPO Prosecution History Demonstrates the Strength of the Present Petition

A. '875 Patent Overview

As noted in the Petition, the challenged claims cover an apparatus “for managing highly secured personal data” using a plurality of standard biometric authentication systems (EX-1001, Abstract) and a “life signs detector” that prevents data access if a critical level of a life signs parameter is detected (EX-1001, 18:22-27). Annotated Figures 3A and 3B, below, show front and rear perspectives of a “preferred embodiment” (EX-1001, 24:21-24), that includes biometric sensors (blue), data/communication means (green), life sign detector (purple) and other components (brown). (EX-1001, 24:25-26:19; EX-1003, ¶¶37-60.)



As discussed below, prosecution of an EPO counterpart application to the '875 patent demonstrates that every element disclosed in the challenged claims was known in the prior art. Indeed, one of Petitioner's primary references (Fadell) was relied on by the EPO Examiner to reject substantively identical claims to those challenged here, and applicant was unable to overcome the rejection.

B. USPTO Examiner and Applicant Agreed That A Physically-Separated Authentication Unit Was Known

During prosecution before the Office, the Examiner rejected the pending claims over U.S. Publication 2009/0062887 to Mass in view of Moran. Specifically, the Examiner found that Moran (EX-1008) discloses an “authentication unit [that] is configured to compare the plurality of personal biological identification parameters ... with the pre-recorded set of personal biological identification parameters stored in” a second storage unit within the authentication unit. (EX-1002, 162-63.) Applicant never disputed that Moran discloses these features. Instead, Applicant amended claim 1 to add an integrated “life signs detector ... configured to measure and record at least one of said user's life sign parameters.” (EX-1002, 192-93.) The Examiner subsequently allowed the claims, stating that the prior art failed to disclose the “life signs detector” limitation (EX-1002, 221-23), and the '875 patent issued on March 19, 2013 (EX-1001).

However, as discussed below, use of “life signs detector[s]” was well-known in the prior art—including in the Fadell reference (EX-1007)—as recognized by

the EPO Examiner. Fadell was never of record, much less considered or discussed during U.S. prosecution of the '875 patent. (EX-1001, (56) References Cited.)

C. Substantively Identical Claims in European Counterpart Application Never Issued After Fadell Rejection

On March 10, 2011, PO filed International Patent Application No. PCT/IB2011/051002, which claimed priority to the same provisional application to which the '875 patent claims priority: U.S. Provisional Patent Application No. 61/313,145 (EX-1005, 1.) On July 12, 2012, PO entered this international application into the European phase before the EPO, assigned as European Application No. 11/752,936.2. (EX-1005, 87.)

On April 29, 2013, before examination of the European Application commenced, Applicant amended the pending claims to substantively match claims of the issued '875 patent. (EX-1005, 144-75.) Indeed, the only minor, non-material, difference in claim 1 is underlined in the chart below.

'875 patent, Claim 1	European Application, Claim 1
[1P] Apparatus for storing and managing personal and secured data and documentation files associated with a specific user, comprising:	[1P] Apparatus for storing and managing personal and secured data and documentation files associated with a specific user, comprising:
[1A] a plurality of biometric sensors for reading a plurality of personal biological biometric identification parameters of the user holding the apparatus, said plurality of biometric sensors being integrated within the apparatus;	[1A] a plurality of biometric sensors for reading a plurality of personal biological biometric identification parameters of the user holding the apparatus, said plurality of biometric sensors being integrated within the apparatus;

[1B] at least one life signs detector integrated within the apparatus, said life signs detector being configured to measure and record at least one of said user's life sign parameters;	[1B] at least one life signs detector integrated within the apparatus, said life signs detector being configured to measure and record at least one of said user's life sign parameters;
[1C] a first storage unit for the storage of said user's data and documentation files;	[1C] a first storage unit for the storage of said user's data and documentation files;
[1D] an authentication unit comprising a second storage unit, with said second storage unit configured to store a pre-recorded set of personal biological biometric identification parameters uniquely associated with the specific user, wherein said authentication unit is configured to compare the plurality of personal biological biometric identification parameters of the user holding the apparatus with the pre-recorded set of personal biological biometric identification parameters stored in said second storage unit;	[1D] an authentication unit comprising a second storage unit, with said second storage unit configured to store a pre-recorded set of personal biological biometric identification parameters uniquely associated with the specific user, wherein said authentication unit is configured to compare the plurality of personal biological biometric identification parameters of the user holding the apparatus <u>or any weighted combination thereof</u> with the pre-recorded set of personal biological biometric identification parameters <u>or any weighted combination thereof</u> stored in said second storage unit;
[1E] a processor in communication with said plurality of biometric sensors, said first storage unit and said authentication unit;	[1E] a processor in communication with said plurality of biometric sensors, said first storage unit and said authentication unit;
[1F] wherein access to the personal data and documentation files stored in said first storage unit is only enabled after said authentication unit positively matches each of the plurality of personal biological biometric identification parameters of the user holding the apparatus with the pre-recorded set of personal biological identification parameters stored in said second storage unit; and	[1F] wherein access to the personal data and documentation files stored in said first storage unit is only enabled after said authentication unit positively matches each of the plurality-of personal biometric biological identification parameters of the user holding the apparatus <u>or any weighted combination thereof</u> with the pre-recorded set of personal biological identification parameters stored in said second storage unit; and

[1G] wherein, whenever any of said at least one life signs detector detects a critical level of said user measured life sign parameters, the apparatus is configured to prevent access to said user's personal data and documentation files stored in said first storage unit.	[1G] wherein, whenever any of said at least one life signs detector detects a critical level of said user measured life sign parameters, the apparatus is configured to prevent access to said user's personal data and documentation files stored in said first storage unit.
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On May 2, 2014, the EPO Examiner issued a rejection of pending claims 1-15 based on Fadell. (EX-1005, 188-99.) In particular, the Examiner found that Fadell (identified as D1) discloses “all of the features of claim 1.” (EX-1005, 192-93.) For example, as to the “*life signs detector*” limitation found missing from the prior art during U.S. prosecution, the EPO Examiner cited Fadell’s teachings regarding a “countermeasure for preventing an unauthorized user from spoofing an authorized user’s skin patterns,” and listing examples such as “a sensor for detecting a user’s pulse, a heat sensor for determining the temperature of the object placed against the sensor (e.g., to determine if the temperature is within a range of expected human skin temperatures), or any other suitable countermeasure.” (EX-1005, 192-93; EX-1007, ¶57.)

Despite its arguments and amendments, Applicant was never able to overcome Fadell. Indeed, in one communication, Examiner noted that they “carefully re-considered the arguments” from previous communications and again concluded that claim 1 lacked an inventive concept in view of Fadell and

“matter[s] of general knowledge.” (EX-1005, 239-41.) Applicant eventually abandoned the claims. (EX-1005, 713.)

III. Discretionary Denial Is Not Warranted Under *Fintiv*

A. Factor One is Neutral or Favors Petitioners

Factor one considers “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 6 (PTAB Mar. 20, 2020) (precedential). This factor is at least neutral because no litigation stay has been requested and no objective evidence exists regarding whether a stay in the litigation will be granted. The Board’s practice is not to speculate regarding how a motion to stay may be decided. *Google LLC v. Mullen Indus. LLC*, IPR2025-00021, Paper 14, 8-9 (PTAB May 14, 2025). This factor may also favor Petitioners because many of his recent decisions suggest that Judge Gilstrap is likely to grant a stay if this proceeding is instituted, especially if uncontested.

Judge Gilstrap is likely to evaluate whether to grant a stay based on the factors set forth in *NFC Tech. LLC v. HTC Am., Inc.*, No. 2:13-cv-1058-WCB, 2015 WL 1069111 (E.D. Tex. Mar. 11, 2015), a decision authored by Federal Circuit Judge William Bryson, who was sitting by designation, that has been cited by courts in at least 100 decisions deciding motions to stay filed in the Eastern District of Texas. Such factors are “(1) whether the stay will unduly prejudice the

nonmoving party, (2) whether the proceedings before the court have reached an advanced stage, including whether discovery is complete and a trial date has been set, and (3) whether the stay will likely result in simplifying the case before the court.” *Id.* at *2.

Here, all factors would weigh in favor of a stay. As an initial matter, staying the litigation would not unduly prejudice patent owner given the nature of the parties and patent owner’s delay in bringing suit. *See, e.g., Comm’n Techs., Inc. v. Samsung Elecs. Am., Inc.*, No. 2:21-cv-00444 JRG-RSP, Dkt. No. 134, 1-2 (E.D. Tex. Feb. 2, 2023) (staying case where Plaintiff delayed in bringing suit, does not compete with Samsung. and “fail[ed] to establish that monetary damages are inadequate to remedy any harm”).

Moreover, a decision instituting IPR would take place on or around September 20, 2025. The claim construction hearing is scheduled to occur roughly three months later on December 11, 2025. (EX-2001, 4.) Judge Gilstrap has granted contested motions to stay filed on even closer timelines. *See, e.g., Commc’n Techs.*, No. 2:21-cv-00444-JRG-RSP, Dkt. No. 134, 1-2 (IPR instituted seven weeks before *Markman* hearing); *Resonant Sys., Inc. v. Samsung Elecs. Co. Ltd.*, No. 2:22-cv-00423, JRG, 2024 WL 1021023, at *3 (E.D. Tex. Mar. 8, 2024) (IPR instituted five weeks before *Markman* hearing).

Indeed, Judge Gilstrap routinely grants contested stays in circumstances when “inter partes review had been instituted on all Asserted Claims of all Asserted Patents on multiple grounds” because “there is a material likelihood of simplification of the issues in [the] case” and “the cancellation of some or all of the claims could result in simplification of issues in [the] case.” *See, e.g., Resonant Sys.*, 2024 WL 1021023, at *3 (granting stay based on material likelihood of simplification of the issues due to instituted IPR on all asserted claims). Institution of IPR here would create this scenario because the Petition challenges all four asserted claims of the ’875 patent – the sole patent asserted in the Texas Litigation – and their cancellation would result in complete disposition of the case.

PO wrongly argues that Petitioners’ decision not to file a motion to stay *prior to* a decision on institution means Judge Gilstrap is unlikely to stay the district court case. (PO Br., 6-7.) To the contrary, Judge Gilstrap routinely stays cases where the motion to stay is first filed *after* IPR is instituted. *See, e.g., Cellspin Soft, Inc. v. ByteDance Ltd.*, No. 2:23-cv-00496-JRG-RSP, Dkt. No. 106, 5 (E.D. Tex. Jan. 26, 2025); *Broadphone LLC v. Samsung Elecs. Co. Ltd.*, No. 2:23-cv-00001-JRG-RSP, Dkt. No. 134, 1-2 (E.D. Tex. July 24, 2024); *Comm’n Techs.*, No. 2:21-cv-00444, Dkt. No. 134, 1-2.

PO’s remaining arguments regarding a stay of the Texas Litigation are similarly unavailing. First, PO cites to case law regarding *pre*-institution requests

for stay (PO Br., 7-8), which are not relevant. Rather, this factor concerns likelihood of stay “if a proceeding *is instituted*.” *Fintiv*, IPR2020-00019, Paper 11, 7 (emphasis added). Next, PO cites to statistics regarding contested motions to stay pending IPR before Judge Gilstrap. (PO Br., 7-8 (citing *Ericsson Inc. v. Procomm Int’l Pre. Ltd.*, IPR2024-01455, Ex. 2005, 85 (PTAB).) But these statistics do not distinguish between pre- and post-institution motions, or between denials with and without prejudice, denials as moot, dismissals, and withdrawals.

PO also fails to acknowledge that Judge Gilstrap almost always grants uncontested motions to stay pending IPR. Since 2014, Judge Gilstrap has granted 88% (38/43) of such motions.² (EX-1036.) PO does not assert it would contest a stay of the Texas Litigation upon institution, nor could PO credibly do so if Petitioners’ IPR is instituted. Indeed, PO does not compete with Samsung and disposition of an instituted IPR would undoubtedly simplify the issues in the Texas litigation.

² Of the five denials, three were pre-institution. For the other two cases, Judge Gilstrap initially denied a stay without prejudice and later stayed the cases once defendants agreed to be subject to full statutory estoppel under 35 U.S.C. §315(e). *See Maxeon Solar Pte. Ltd. v. Hanwha Sols. Co.*, No. 2:24-cv-00262-JRG, Dkt. No. 58, 1-2 (E.D. Tex. May 5, 2025); *Molecular Rebar Design, LLC v. LG Energy Sol., Ltd.*, No. 2:24-cv-00107, Dkt. No. 86, 1-2 (E.D. Tex. Feb. 6, 2025).

Thus, at bottom, whether the Texas Litigation will be stayed is yet to be determined and the Board “will not attempt to predict how the district court ... will proceed” regarding potential stays “because the court may determine whether or not to say any individual case ... based on a variety of circumstances and facts.” *Sand Revolution II, LLC v. Cont’l Intermodal Grp.-Trucking LLC*, IPR2019-01393, Paper 24, at 7 (PTAB June 16, 2020); *see also Hulu, LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00298, Paper 11, at 11 (PTAB May 19, 2021) (because “neither party has produced evidence that a stay has been requested[,]” “[w]e decline to infer, based on actions taken in a different case with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here.”) (partially quoting *Fintiv*).

For these reasons, factor one at least neutral or favors Petitioners.

B. Factor Two: The District Court’s Trial Date Is Uncertain

Factor two considers the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Fintiv*, IPR2020-00019, Paper 11, 6. While the Texas Litigation is currently scheduled for trial on June 1, 2026 (EX-2001, 1), which is approximately four months before the Board would issue a final written decision if institution were granted, this date is hardly certain. As it currently stands, Judge Gilstrap has a total of 12 trials set for the week of

June 1, 2026 and 8 trials scheduled for May 18, 2026. (EX-1037.) So it is unlikely that Petitioners will proceed to trial on that date.

Statistics maintained by the “United States District Court – Judicial Caseload Profile” indicate that, as of March 31, 2025, the median time to trial in civil cases in the Eastern District of Texas is 25.9 months.³ (EX-1038, 35.) The Texas Litigation was filed on August 5, 2024. (EX-2002.) This projects a trial date around October 5, 2026, which is two weeks *after* the FWD statutory deadline of September 20, 2026. “[T]he fact that the district court trial is set for after the projected deadline for the Board to issue its Final Written Decision ... weighs *heavily* against discretionary denial.” *Intel Corp. v. PACT XPP Schweiz AG*, IPR2020-00535, Paper 11, 16 (PTAB Aug. 11, 2020) (emphasis added); *see also*, *e.g.*, *Intel Corp. v. ParkerVision, Inc.*, IPR2020-01302, Paper 9, 12 (PTAB Jan. 28, 2021) (granting institution where FWD projected 10 days before expected trial date); *Weatherford U.S., L.P. v. Enventure Glob. Tech., Inc.*, IPR2020-01684, Paper 16, 8-9 (PTAB Apr. 14, 2021) (granting institution where FWD projected one month before expected trial date).

³ PO relies on the December 31, 2024 statistics, which are now outdated. (See EX-2005.) The data presented by PO and the most recent data presented by Petitioner demonstrate that the median time to trial in the Eastern District of Texas is increasing.

Thus, when accounting for the strength of the merits and applying the current projections for the date of trial, factor two weighs against discretionary denial. Indeed, one study found that, when the Board exercised discretionary denial based on future trial dates, the Board incorrectly guessed the actual trial date 94% of the time (48 out of 51 discretionary denials). (EX-1040, 2.) Even the Board has previously noted that “scheduled trial dates are unreliable and often change.” (EX-1041, 8.)

C. Factor Three: Little Investment Relating to Invalidity Will Have Occurred in the Litigation by the Institution Deadline

The consideration of investment in parallel litigation in factor three focuses on pre-institution efforts relating to invalidity issues raised in the Petition—not on litigation efforts generally or anticipated post-institution efforts. *See, e.g., Apple, Inc. v. Koss Corp.*, IPR2021-00381, Paper 15, 16 (PTAB July 2, 2021) (“On the current record, the District Court Lawsuit is still in the early stages, with very little investment pertaining to the invalidity issues raised in the Petition.”); *Dell Techs. Inc. v. WSOU Investments, LLC*, IPR2021-00272, Paper 13, 10 (PTAB July 1, 2021) (“much of [the parties’] invested effort is unconnected to the patentability challenges presented here”); *Hulu, LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00158, Paper 9, 11 (PTAB April 20, 2021) (“Based on the present record, we are persuaded by Petitioner’s showing that the district court and the parties have not invested substantially in the merits of the invalidity positions.”). For this reason,

PO's arguments regarding general and post-institution investment in the Texas Litigation (PO Br., 12-13) are irrelevant and this factor weighs against discretionary denial.

Here, by the September 2025 institution deadline, the amount of work related to invalidity in the district court litigation will remain minimal. To date, as PO concedes, the only invalidity-specific work is service of invalidity contentions. (*See* PO Br., 12.) Most of fact discovery remains left to complete—no party or third-party depositions have been taken; PO has not performed a single inspection of the source code for the accused products, which has been made available for over four months; and as PO acknowledges, no claim construction briefing will be submitted by the institution deadline. (*See id.*, 13-14; EX-2001, 4; EX-1042.) Even by September 2025, “substantial work [will] remain[] to be done *as it relates to invalidity*: fact discovery is in its early stages, expert reports are not yet due, and substantive motion practice is yet to come.” *Dell*, IPR2021-00272, Paper 13, 10 (emphasis added); *see also* EX-2001, 3-4 (fact discovery, claim construction briefing, expert reports, and dispositive motion deadlines all occurring after September 2025). Moreover, the district court has not issued any substantive order with respect to the '875 patent and no such substantive orders are expected prior to institution. *Fintiv*, IPR2020-00019, Paper 11, 10 (“If, at the time of the institution

decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.”).

While PO notes that Petitioners’ invalidity contentions raise challenges outside of the scope of IPR (PO Br., 14; *see also* 35 U.S.C. §311(b)), as discussed below with respect to factor four, Petitioners’ have entered a *Sotera* stipulation. (Petition, 83.) The Board has recognized that factor three weighs against discretionary denial even when additional challenges are asserted in a parallel proceeding. *See, e.g., Mullen Indus. LLC*, IPR2025-00021, Paper 14, 10 (finding petitioner’s *Sotera* stipulation weighs against discretionary denial even though its district court invalidity contentions “include system prior art and other invalidity defenses rooted on lack of written description, indefiniteness, enablement, and obviousness-type double patenting that cannot be asserted in an IPR”).

PO also wrongly suggests that factor three favors denial where, as here, an institution decision will occur months before a *Markman* hearing. (*See* PO Br., 13-14.) Rather, under similar circumstances, the PTAB has found this factor to weigh against discretionary denial. *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15, 10-11 (PTAB Oct. 21, 2020) (precedential) (finding factor three weighs against institution because no claim construction has issued and no significant discovery had been completed); *Juniper Network, Inc. v. Packet Intel. LLC*, IPR2020-00336, Paper 21, 18 (PTAB Sep. 10, 2020) (“[T]he investment of time and effort that

remains to bring the co-pending litigations to trial appears to far outweigh that which has already been invested” when discovery is not yet complete and district court has not issued a decision on claim construction.); *Samsung Elecs. Co. Ltd. v. Headwater Rsch. LLC*, IPR2024-01396, Paper 13, 7 (PTAB Apr. 1, 2025) (finding the fact that “claim construction proceedings will not have completed and the district court will not have issued any substantive orders” by the time of the institution decision “weighs against denial” despite “the parties [] likely [having] done some work”); *Mobileye Glob., Inc. v. Facet Tech. Corp.*, IPR2024-01110, Paper 16, 12-13 (PTAB Mar. 5, 2025) (weighing against denial and instituting in absence of claim construction and other substantive orders from district court). Finally, PO’s argument regarding dispositive motion practice scheduled for February 2026 ignores the likelihood of a stay pending IPR. (*See* PO Br., 14-15.)

Accordingly, factor three weighs against discretionary denial.

D. Factor Four: Petitioners’ *Sotera* Stipulation Removes Any Overlap With the Texas Litigation

Petitioners have stipulated, consistent with *Sotera*, “that if IPR is instituted, they will not pursue in the related district court proceeding ‘any ground that [Petitioners] raised or reasonably could have raised’ during the instituted IPR.” (Petition, 83 (citing 35 U.S.C. §315(e)).) With this stipulation, *Fintiv* factor four weighs against discretionary denial.

PO raises meritless challenges to Petitioners' *Sotera* stipulation (PO Br., 15-20). First, PO contends that Petitioners' *Sotera* stipulation will not reduce overlap in proceedings because, in their invalidity contentions, Petitioners have asserted the same references. (PO Br., 15-16.) This argument is nonsensical because Petitioners' *Sotera* stipulation would restrict Petitioners' ability to rely on any overlapping references in the district court if this proceeding is instituted. The decisions cited by PO finding overlap between PTAB and district court invalidity theories favored denial (*id.*, 20) are inapplicable because none of the petitioners in those IPR proceedings provided a *Sotera* stipulation, as Petitioners have done here. *See, e.g., eClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10, 12 (PTAB Apr. 13, 2022) ("The record does not include any indication that [p]etitioner has stipulated to not assert the grounds in the [p]etition in the parallel litigation.").

PO next speculates that, if institution is granted, Petitioners will present "corresponding system prior art" in their expert reports and at trial. (PO Br., 17-18.) But this is unfounded speculation on PO's part, as none of the prior art systems cited in Petitioners' invalidity contentions correspond to the references asserted in the Petition. (EX-2003, 18-19.) PO also mischaracterizes Petitioner's invalidity contentions in arguing that "Petitioners' Invalidity Contentions assert at least 13 prior art systems in addition to over 100 patents and printed

publications ... resulting in an almost unthinkable number of invalidity grounds that Petitioners' stipulation does not moot." (PO Br., 18). In reality, Petitioner only presented one invalidity ground in its invalidity contentions based on system prior art. (EX-2003, 60-61 (discussing HIIDE 4.0 system prior art).) Moreover, Petitioners have not decided what prior art they will ultimately pursue in the district court case, particularly given that Petitioners' invalidity expert report is not due until January 12, 2026. (EX-2001, 3.) Thus, rather than having the Director speculate that Petitioners' will later identify corresponding system prior art that Petitioners might present at trial and whether there is overlap with the printed publications in this proceeding, the application of Petitioners' *Sotera* stipulation is a question to be resolved by the district court.

That being said, in view of the Director's Decision Granting Patent Owner's Request for Discretionary Denial and Denying Institution of *Inter Partes* Review in *Shenzen Tuozhu Tech. Co., Ltd. v. Stratasy, Inc.*, IPR2025-00354, Paper 11, 2 (PTAB June 12, 2025), Petitioners hereby stipulate that if this IPR is instituted, they will not pursue in the related district court proceeding any invalidity theories based on unpublished system prior art, either alone or in combination with other prior art.⁴

⁴ Petitioners would not oppose a request by PO for a limited brief reply to address this more restrictive *Sotera* stipulation.

Finally, as PO concedes, the Petition challenges the patentability of claims not asserted in (and that will not be addressed by) the Texas Litigation. (*See* PO Br., 16-17.) The challenges to these unaddressed claims weighs against discretionary denial. *Palo Alto Networks, Inc. v. Centripetal Networks, Inc.*, IPR2021-01157, Paper 10, 14 (PTAB Mar. 15, 2022) (declining to invoke §314(a) and finding factor four weighs against discretionary denial “[t]aking into account the [*Sotera*-type] stipulation and the number of claims challenged in this proceeding that will not be addressed by the district court proceeding”).

Accordingly, factor four weighs against discretionary denial.

E. Factor Five: Petitioners are Defendants in the Texas Litigation

Petitioners agree that they are defendants in the Texas Litigation.

F. Factor Six: Other Circumstances Weigh Against Discretionary Denial

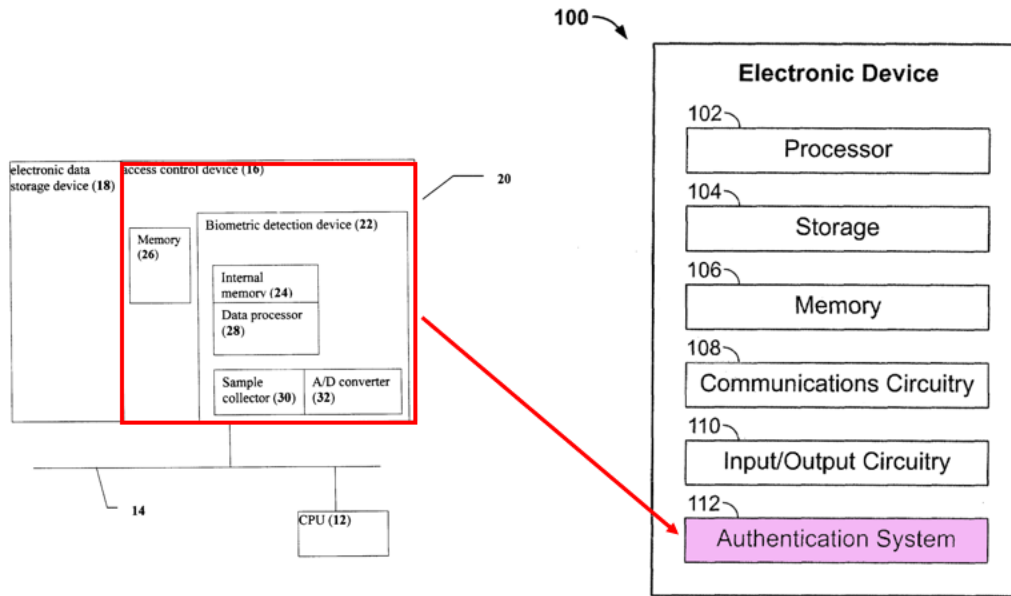
Factor six considers “other circumstances that impact the Board’s exercise of discretion, including the merits.” Petitioners address here the relevant considerations from the Director’s March 26, 2025 Memorandum.

1. The Petition Presents a Compelling Case of Unpatentability

As discussed above (§II), Petitioners’ prior art challenge is strong because there is clear evidence the Office erred in a manner material to patentability of the ’875 patent. The EPO rejected claims substantively identical to the challenged claims using Fadell alone. (*See* Pet., 5-6; EX-1005, 188-99.) In fact, the Petition is

an even stronger challenge than the rejection by the EPO because it combines Fadell with the teachings of Moran, which was found during prosecution to disclose the “*authentication unit comprising a second storage unit*” limitation—a finding PO did not dispute. (Pet., 3-5; EX-1002, 162-63, 207-08; *see also* PO Br., 22.) Separately, PO also does not dispute that both Fadell and Kohinata disclose the “*life signs detector*” limitation the Examiner identified as missing in prior art in the Notice of Allowance. (Pet., 5, 21-23, 59-60; EX-1002, 222-23.) Thus, the merits of the Petition are strong.

PO does not demonstrate otherwise. Rather, PO artificially severs the primary references from their respective obviousness combinations and argues against grounds not asserted in the Petition, contending (without explanation) that each fails to disclose the “*authentication unit comprising a second storage unit*” limitation. (*See* PO Br., 22.) But PO ignores that Moran discloses this limitation, which was not disputed during U.S. prosecution. (*Supra* §II.B.) Indeed, the Petition provides detailed analysis showing how this limitation is disclosed by two combinations. First, the Petition explains how a POSITA would have been motivated to combine Moran’s teachings regarding an access control unit having an integrated biometric detection device with Fadell’s electronic device having multiple authentication systems. (*See* Pet., 12-16, 24-31.)



**Moran (EX-1008), Figure 3 (left) (annotated);
Fadell (EX-1007), Figure 1 (right) (annotated)**

Second, the Petition also explains how a POSITA would have been motivated to combine Mizusawa's teachings regarding flexible, multi-biometric authentication techniques with Kohinata's cellular phone. (*See* Pet., 62-70.) PO makes no argument against either of these combinations, and again does not dispute the finding from prosecution that Moran discloses this limitation. (*See* PO Br., 22; EX-1002, 162-63.) PO cites various decisions attempting to downplay the importance of the strength of the merits to the discretionary denial analysis (*see* PO Br., 23), but those decisions have little relevance here given the flaws in PO's analysis of the other *Fintiv* factors described above.

Accordingly, the strength of the merits weighs against discretionary denial.

2. Petitioners’ Reliance on Expert Testimony Provides Helpful Context to the Board

Petitioners’ expert declaration provides helpful information regarding the unpatentability of the challenged claims. The Petition’s reliance on expert testimony does not mandate discretionary denial. Instead, the Board’s April 25, 2025 FAQ-21 states only that “extensive reliance on expert testimony ... *may* suggest that the questions are better resolved in an Article III court.” April 2025 FAQs, Q-21 (emphasis added). Under the specific facts of this case, Petitioners’ reliance on expert testimony is appropriate and helpful. The level of detail is also consistent with the PTAB’s November 2019 Consolidated Trial Practice Guide (“CTPG”), which states:

Expert testimony may have many uses. For example, it may be used to explain the relevant technology to the panel. It may also be used to establish the level of skill in the art and describe the person of ordinary skill in the art. Experts may testify about the teachings of the prior art and how they relate to the patentability of the challenged claims. Expert testimony may also be offered on the issue of whether there would have been a reason to combine the teachings of references in a certain way, or if there may have been a reasonable expectation of success in doing so.

(CTPG, 34-35.)

Petitioners’ expert declaration helpfully addresses many of these uses. For example, Dr. Wolfe identifies the qualifications and experience of a POSITA. (EX-

1003, ¶¶62.) He explains the teachings of the prior art (*see, e.g.*, EX-1003, ¶¶115-30 (Ground 1), ¶¶238-48 (Ground 3)) and how they invalidate the challenged claims (EX-1003, ¶¶139-215 (Ground 1), ¶¶257-323 (Ground 3)). He also details why a POSITA would have been motivated to combine the prior art and why there would be a reasonable expectation of success in doing so. (EX-1002, ¶¶131-38.) In short, Dr. Wolfe’s expert declaration provides “helpful context” regarding the prior art (April 2025 FAQs, Q-21) and addresses key issues relating to the unpatentability of the challenged claims of the ’875 patent. Though PO asserts the Petition relies on expert testimony to “backfill and plug holes in its arguments” (PO Br., 23), it fails to specifically identify any such “holes” supposedly backfilled.

3. No Forum Has Adjudicated the Validity of the Challenged Claims

That no forum has adjudicated the validity of the challenged claims of the ’875 patent weighs against discretionary denial. The EPO has already rejected claims substantively identical to the claims challenged in the Petition based on Fadell (EX-1007). (*See* Pet., 5-6; EX-1005, 188-99; *supra* §II.C.) Given this prior finding, allowing these questionable claims to stand unchallenged directly contradicts the purpose for which Congress created IPRs—“improving patent quality and providing a more efficient system for challenging patents that should not have issued.” (EX-1039, 39-40.)

4. The European Prosecution Contradicts Patent Owner's Settled Expectations

The EPO prosecution contradicts PO's settled expectations and instead confirm the public's settled expectation that the claims are not valid. PO states that the '875 patent issued in 2013 (PO Br., 24), but omits that just two years later, the EPO rejected substantively identical claims in a foreign counterpart to the '875 patent that PO eventually abandoned. (EX-1005, 188-99, 713; *supra* §II.C.) In other words, PO has been on notice of invalidating prior art for more than ten years, removing any possibility of settled expectations. PO has never, for example, asked the PTO to reexamine the '875 patent considering the Fadell reference despite being on notice that it invalidates claims in the '875 patent, either alone or in combination with other prior art. Further, because the '875 patent has effective filing date before March 16, 2013, it was never eligible for post-grant review. (35 U.S.C. §321; AIA §3(n)(1).) Accordingly, settled expectations weight against discretionary denial.

In sum, evidence of error by the Office demonstrates the strengths of the merits and, along with other considerations, weighs against discretionary denial.

IV. Discretionary Denial is Not Warranted Under *Advanced Bionics*

The Director should decline to exercise discretionary denial under *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020). It is undisputed that four of the five references

applied in the Petition—primary references Fadell (EX-1007) and Kohinata (EX-1009), as well as secondary references Rosenblatt (EX-1010) and Mizusawa (EX-1011; EX-1012)—were never considered or cited during U.S. prosecution. (*See* PO Br., 25-26.) Instead, PO’s arguments focus exclusively on Moran (EX-1008), which was only used as a secondary reference during prosecution and is again used as a secondary reference in only two of four grounds in the Petition. Specifically, Moran is used as a secondary reference in combination with Fadell in Grounds 1 and 2. (*See* Pet., 9-39, 41-50.) But the Petition also presents Grounds 3 and 4 based on Kohinata as a primary reference in combination with Misuzawa and Rosenblatt. (*See id.*, 76-82.) In other words, Grounds 3 and 4 do not include Moran. (*Id.*)

1. *Advanced Bionics* Part 1: The Petition Presents New Art and Arguments Not Previously Presented to the Office

Advanced Bionics Part 1 is not satisfied. This Petition presents new art and new arguments not previously presented to the Office. While Moran was of record during U.S. prosecution, Applicant never disputed the Examiner’s finding that Moran discloses the “*authentication unit comprising a second storage unit*” [1D] limitation. (EX-1002, 192-93.) More importantly, Moran was not considered in combination with Fadell or Rosenblatt. The Petition demonstrates how Fadell discloses the “*life signs detector*” limitation that PO argued (and Examiner agreed in the Notice of Allowance) was missing from the evaluated prior art. (EX-1002, 192-203, 222-23.) Thus, “the Office erred in a manner material to patentability of

the challenged claims by overlooking the teachings of’ Fadell, and the combined teachings of Fadell and Moran or Fadell, Moran, and Rosenblatt. (*See Microsoft Corp.*, IPR2025-00318, Paper 9, 2-3 (declining to invoke §325(d) where reference used by examiner in anticipation rejection during prosecution was used as secondary reference in IPR). The Office also erred by overlooking the teachings of Kohinata, and the combined teachings of Kohinata and Misuzawa, or Kohinata, Misuzawa, and Rosenblatt. Further, the same or substantially the same art or arguments have never been presented to the Office. *See Koito Mfg. Co. Ltd. v. Adaptive Headlamp Techs., Inc.*, IPR2016-00079, Paper 11, 38 (PTAB May 5, 2016) (declining to invoke §325(d) where previously considered prior art “is cited only as a secondary reference” and primary reference was not previously considered); *Caterpillar Inc. v. Wirtgen Am. Inc.*, IPR2022-01278, Paper 12, 43 (PTAB Feb. 7, 2023) (declining to invoke §325(d) where “none of the proposed combinations in the [p]etition were before the [e]xaminer” because “the other art relied on by [p]etitioner ... were not before the [e]xaminer”). As such, *Advanced Bionics* Part 1 is not satisfied.

2. *Advanced Bionics* Part 2: The Examiner Erred by Allowing the Claims

Because Part 1 of the *Advanced Bionics* framework is not satisfied, the Director need not consider Part 2. Nonetheless, if the Director were to consider Part 2, it is not satisfied because the Examiner erred by allowing the claims.

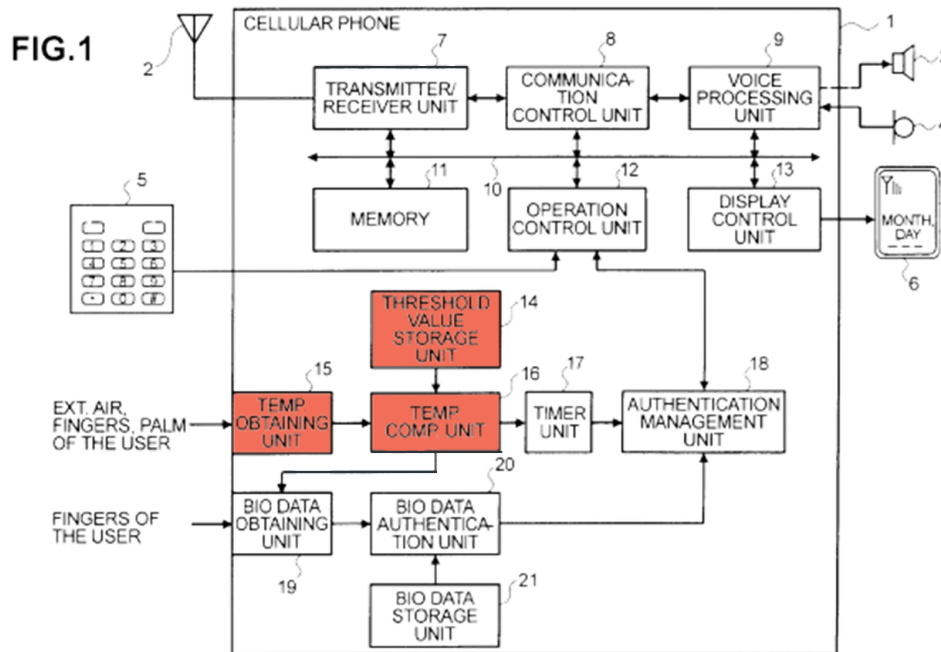
Becton, Dickinson factors (c), (e), and (f) are the relevant factors that should be considered at Part 2. *Advanced Bionics*, IPR2019-01469, Paper 6, 10.

As to factor (c), the Examiner's discussion of Moran was limited. (See EX-1002, 162-63 (citing EX-1008, Abstract, 4:15-37).) The Petition presents additional citations to Moran that were not included in the Examiner's Office Action, including extensive discussion of the motion to combine Fadell with Moran. (Pet. 11-16 (citing EX-1008 at Abstract, 1:10-14, 3:15-18, 4:38-53, 4:62-67, 7:9-11, 7:32-33, 7:52-55, Figure 3); *see also* Pet., 27 (citing EX-1008 at 7:49-55, 10:64-67, 12:17-24); Pet., 29-30 (citing EX-1008, claims 3-4, 5:32-35, 11:8-11, 11:31-34).)

As to factor (e), Petitioner has sufficiently demonstrated that the Examiner erred by failing to reject claims 1, 4, 7, 10, 14, and 19 over Fadell in combination with Moran (Pet., 9-39), and failing to reject claims 15 and 18 over Fadell in combination with Moran and Rosenblatt (Pet. 41-50). In particular, the Petition shows how Fadell discloses the “*life signs detector*” limitation the Examiner determined was missing from the prior art of record before the Office. (Pet., 83; EX-1002, 192-203, 222-23.) For example, the Petition provides detailed analysis showing how this limitation is disclosed by Fadell's teaching regarding a “countermeasure for preventing an unauthorized user from spoofing” to bypass biometric authentication, including “a sensor for detecting a user's pulse” and

“heat sensor for determining the temperature of the object placed against the sensor (e.g., to determine if the temperature is within a range of expected human skin temperatures).” (EX-1007, ¶57; Pet., 21-23; EX-1003, ¶¶155-60.) As discussed above, the EPO Examiner found that Fadell disclosed this limitation, and PO never overcame the rejection. (*Supra* §II.C.)

Petitioner has also sufficiently demonstrated that the Examiner erred by failing to reject claims 1 and 4 over Kohinata in combination with Misuzawa (Pet., 50-74), and failing to reject claims 15 and 18 over Kohinata in combination with Misuzawa and Rosenblatt (Pet., 76-82). The Petition also provides detailed analysis showing how the “*life signs detector*” is disclosed by Kohinata. In particular, Kohinata discloses a “use detection module” in a cellular phone 1, the use detection module judging “the state of contact to the user by measuring temperature” (EX-1009, 2:56-57) and comprising a threshold value storage unit 14, temperature obtaining unit 15, and temperature comparator unit 16. (EX-1009, Figure 1.) Temperature obtaining unit 15 alone or in combination with comparator unit 16 is a “*life signs detector*.” (EX-1003, ¶272.)



Kohinata, Figure 1 (red shading added)

(See also EX-1003, ¶¶271-75.) Accordingly, the Petition explains in detail how prior art that was not considered during prosecution invalidates the challenged claims—confirming that the Examiner committed a material error by allowing the claims. See *Hamilton Techs. LLC v. Fleur Tehrani*, IPR2020-01199, Paper 6, 21 (PTAB Jan. 6, 2021).

As to factor (f), for the reasons discussed above, the additional citation and discussion of Moran in the Petition, and the combination of Fadell with Moran, warrant reconsideration of Moran. Further, the Petition is accompanied by the expert declaration of Dr. Wolfe (EX-1003), which was not available to the Examiner during examination of the application leading to the '875 patent. See

Safran Cabin Inc. v. B/E Aerospace, Inc., IPR2022-00749, Paper 10, 12 (PTAB Oct. 21, 2022).

On this record, *Becton, Dickinson* factors (c), (e), and (f) all weigh against denying institution under §325(d).

V. Discretionary Denial Would Contradict the Purposes of the AIA

Nearly 15 years ago in 2011, Congress passed the Leahy-Smith America Invents Act (“AIA”) to address flaws in the patent system. Of particular concern was the proliferation of low-quality patents and the corresponding rise in abusive enforcement. *See, e.g., Thryv, Inc v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020) (“Congress, concerned about overpatenting and its diminishment of competition, sought to weed out bad patent claims efficiently.”); EX-1039, 39-40 (“[Q]uestionable patents [were] too easily obtained and too difficult to challenge.”). With these concerns in mind, Congress identified as one of the primary goals of the AIA “establish[ing] a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.” (EX-1039, 40.)

A critical part of the AIA’s new system was the creation of the PTAB and IPR process, which was designed to combat general flaws in the patent system like low patent quality and costly and inefficient district court litigation, as well as

problems directly associated with enforcement of low quality patents such as forum shopping and the economic impact of such litigation.

A. Weeding out Bad Patents and Providing an Alternative to Costly and Inefficient District Court Litigation

In passing the AIA, Congress recognized that the USPTO, constrained by limited time and resources, had increasingly allowed the issuance of patents that did not meet the statutory standard. IPR (along with the AIA’s new Post-Grant Review proceeding) would provide a system “for challenging [these] patents that should not have issued,” “improv[ing] patent quality and restor[ing] confidence in the presumption of validity that comes with issued patents in court.” (EX-1039, 39-40, 48.) As the Supreme Court acknowledged, “inter partes review protects ‘the public’s paramount interest in seeing that patent monopolies are kept within their legitimate scope.’” *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 584 U.S. 325, 336-37 (2018) (quoting *Cuozzo Speed Techs. v. Com. for Intell. Prop.*, 579 U.S. 261, 279-80 (2016)).

Congress also enacted IPR to alleviate the high costs associated with defending patent infringement claims in district court, costs that frequently exceed millions of dollars regardless of patent quality. (See EX-1039, 40 (AIA designed to “establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs”).) IPR was expressly intended to provide a “quick and cost effective alternative[] to

litigation,” allowing accused infringers to challenge patents early and at significantly reduced expense. (EX-1039, 48.) The AIA ensured that proceedings before the PTAB would be streamlined and time-limited, providing that final decisions must be issued within 12-18 months of institution. 35 U.S.C. §316(a)(11). This expedited framework allows accused infringers to avoid the burdens of lengthy district court litigation, instead resolving disputes at a fraction of the cost and time typically required in Article III courts.

B. Curbing Forum Shopping and Reducing Economic Impact of Litigating Bad Patents

Through creation of the PTAB and IPR, Congress aimed to curtail litigation tactics like forum shopping and reduce the economic impact of the litigation of low-quality patents on innovators and the judicial system.

Congress created in the PTAB a centralized administrative forum for post-grant validity challenges. By enabling accused infringers to challenge questionable patents through IPR, with its procedural efficiencies and a lower burden of proof than district court litigation (preponderance of the evidence rather than clear and convincing), the AIA was intended to substantially diminish the strategic advantage of filing in any particular district court.

When “patents that should not have issued” are litigated, they waste time and money that innovators could otherwise spend on R&D, as well as the judicial

resources required to maintain sometimes years-long infringement suits. (EX-1039, 39-40.)

Congress intended for the AIA to help alleviate the economic burden caused by litigation of low quality patents. (*See* EX-1039, 39 (citing Patent Reform in the 111th Congress: Legislation and Recent Court Decisions, Senate Judiciary Committee, 111th Cong. (2009) (statement of Prof. Mark A. Lemley, Stanford Law School) (“[A] number of the patent rules have given [litigants] unfair advantages in litigation, allowing them to enforce dubious patents in favorable jurisdictions, and to use the rules of patent remedies to obtain more money than their inventions were actually worth.”)).) The AIA’s creation of the PTAB and IPR and limitations on joinder served to improve patent quality, reduce the costs and inefficiencies of district court litigation, and curb forum shopping—benefits Congress recognized would disincentivize litigation of low quality patents and thus reduce its economic impact on innovators and the judicial system. (*See, e.g.*, EX-1039, 39-40 (“[Q]uestionable patents [were] too easily obtained and too difficult to challenge.”); EX-1043, 56 (*America Invent's Act: Hearing on H.R. 1249*) (noting the importance of the AIA to “address this problem of nonpracticing entities that we believe exploit flaws in the current patent system”).)

C. Congress Deliberately Set a One Year Statutory Bar to Give Petitioners a “Reasonable Opportunity” to Prepare Their Case

Congress held healthy debates over the length of time that a litigant defending patent infringement claims would have to file an IPR petition. In the bill passed in the Senate, litigants had 6 months to file an IPR petition. The final bill extended this provision to one year for reasons summarized in the Congressional Record:

High-technology companies, in particular, have noted that they are often sued by defendants asserting multiple patents with large numbers of vague claims, making it difficult to determine in the first few months of the litigation which claims will be relevant and how those claims are alleged to read on the defendant’s products. Current law imposes no deadline on seeking inter partes reexamination. And in light of the present bill’s enhanced estoppels, it is important that the section 315(b) deadline afford defendants a reasonable opportunity to identify and understand the patent claims that are relevant to the litigation.

(EX-1044, 78 (Cong. Rec. H5969 (2011) (Sen. Kyl).)

VI. Conclusion

For the reasons above, Petitioners respectfully submit that discretionary denial is inappropriate. The Director should refer the Petition to a three-member panel for consideration on the merits.

Date: June 20, 2025

Respectfully submitted,

/Lori A. Gordon/

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CERTIFICATE OF WORD COUNT UNDER 37 CFR §42.24(d)

Pursuant to 37 C.F.R. §42.24(a), Samsung hereby certifies that portions of the above-captioned Response to Patent Owner's Discretionary Denial Brief complies with the type-volume limits of the March 26 Stewart Memorandum because it contains 7,696 words according to the word-processing system used to prepare this Response. Pursuant to 37 C.F.R. §42.24(a), this word count is in compliance and excludes the table of contents, table of authorities, mandatory notices under §42.8, certificate of service, certificate of word count, appendix of exhibits, and any claim listing. This word count was prepared using Microsoft Word.

Date: June 20, 2025

Respectfully submitted,

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The undersigned certifies that a true copy of Petitioners' Response to Patent Owner's Discretionary Denial Brief and any new exhibits identified in the above Table of Exhibits have been served on the Patent Owner via e-mail to the following counsel of record:

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