

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**SAMSUNG ELECTRONICS CO., LTD. and SAMSUNG ELECTRONICS
AMERICA, INC.,
Petitioner,**

v.

**GENGHISCOMM HOLDINGS LLC,
Patent Owner.**

**Case IPR2025-00789
Patent No. 11,075,786**

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

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CERTIFICATION UNDER 37 C.F.R. § 42.24(d) 1

CERTIFICATE OF SERVICE 2

TABLE OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 11,075,786
1002	Declaration of Harry Bims, Ph.D.
1003	RESERVED
1004	Dirk Galda & Hermann Rohling, <i>A Low Complexity Transmitter Structure for OFDM-FDMA Uplink Systems</i> , Vehicular Technology Conference. IEEE 55 th Vehicular Technology Conference, vol. 4, pp.1737-1741 (May 6, 2002) (“Galda”).
1005	Stefan Kaiser, <i>Multi-Carrier CDMA Mobile Radio Systems – Analysis and Optimization of Detection, Decoding, and Channel Estimation</i> , VDI-Verlag, Dusseldorf, Germany (Jan. 1998) (ISBN 3-18-353110-0) (“Kaiser”)
1006	RESERVED
1007	Andres Bury & Jurgen Linder, <i>Comparison of Amplitude Distributions for Hadamard Spreading and Fourier Spreading in Multi-Carrier Code Division Multiplexing</i> , Globecom ’00-IEEE. Global Telecommunications Conference, Vol. 2, pp.857-860 (Nov. 27, 2000) (“Bury”)
1008	Kwang-Cheng Chen, et al., <i>A Programmable Architecture for OFDM-CDMA</i> , IEEE Communications Magazine, pp.76-82 (Nov. 1999) (“Chen”)
1009	RESERVED
1010	RESERVED
1011	U.S. Patent Application Publication No. 2003/0081538 to Walton et al.
1012	Declaration of Sylvia Hall-Ellis, Ph.D.

Exhibit No.	Description
1013	RESERVED
1014	Stephen B. Weinstein, <i>The History of Orthogonal Frequency-Division Multiplexing</i> , IEEE Communications Magazine, pp.26-35 (Nov. 2009).
1015	Richard van Nee & Ramjee Prasad, <i>OFDM for Wireless Multimedia Communications</i> (Artech House 2000).
1016	Karsten Bruninghaus & Herman Rohling, <i>Multi-carrier spread spectrum and its relationship to single-carrier transmission</i> , Vehicular Technology Conference. IEEE 48 th Vehicular Technology Conference, vol. 3, pp.2329-2332 (May 18-21, 1998) (“Brüninghaus”).
1017	RESERVED
1018	RESERVED
1019	File History of U.S. Patent Application No. 14/967,633 as obtained from Patent Center (excerpts).
1020	RESERVED
1021	File History of U.S. Patent Application No. 11/187,107 as obtained from Patent Center (excerpts).
1022	RESERVED
1023	File History of U.S. Patent Application No. 10/145,854 as obtained from Patent Center (excerpts).
1024	U.S. Patent No. 8,670,390
1025	U.S. Patent No. 8,750,264
1026	RESERVED
1027	RESERVED

Exhibit No.	Description
1028	RESERVED
1029	RESERVED
1030	File History of U.S. Patent Application No. 14/727,769 as obtained from Patent Center (excerpts)
1031	File History of U.S. Patent Application No. 14/276,309 as obtained from Patent Center (excerpts)
1032	File History of U.S. Patent Application No. 12/545,572 as obtained from Patent Center (excerpts)
1033	RESERVED
1034	RESERVED
1035	RESERVED
1036	File History of U.S. Patent Application No. 15/489,644 as obtained from Patent Center (excerpts)
1037	File History of U.S. Patent Application No. 15/149,382 as obtained from Patent Center (excerpts)
1038	3GPP TS 36.211 V8.8.0 (2009-09) 3 rd Generation Partnership Project; Technical Specification Group Radio Access Network; Evolved Universal Terrestrial Radio Access (E-UTRA); Physical Channels and Modulation (Release 8)
1039	Exhibit 1 to Plaintiff's P.R. 3-1(c) Infringement Contentions (U.S. Pat. No. 9,768,842)
1040	RESERVED
1041	RESERVED
1042	U.S. Patent No. 6,597,745 to Dowling

Exhibit No.	Description
1043	Gerhard P. Fettweis, et al., <i>A Time Domain View to Multi-Carrier Spread Spectrum</i> , IEEE 6 th Int'l Symposium on Spread-Spectrum & Applications (ISSSTA 2000), (Sept. 6-8, 2000) (pre-print)
1044	Armin Dekorsy & Volker Kuehn, <i>Exploiting Time and Frequency Diversity by Iterative Decoding in OFDM-CDMA Systems</i> , Seamless Interconnection for Universal Services, Global Telecommunications Conference. GLOBECOM'99, Vol. 5, pp.2576-2580 (Dec. 5, 1999).
1045	Volker Kuehn, et al., <i>Channel Coding Aspects in an OFDM-CDMA System</i> , ITG FACHBRICHT, pp.31-36 (Jan. 2000).
1046	Docket Control Order, <i>Genghiscomm Holdings, LLC v. Samsung Elecs., Am., Inc.</i> , No. 2:24-cv-0242-RWS-RSP, Dkt. 25 (Sept. 24, 2024).
1047	Complaint, <i>Genghiscomm Holdings, LLC v. Samsung Elecs., Am., Inc.</i> , No. 2:24-cv-0242-RWS-RSP, Dkt. 1 (Apr. 12, 2024).
1048	RESERVED
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1057	RESERVED

Exhibit No.	Description
1058	RESERVED
1059	Declaration of Gary Swatzell including Exhibits A-D
1060	Guidance on USPTO’s recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (Mar. 24, 2025).
1061	Docket Control Order, <i>Slyde Analytics LLC v. Apple Inc.</i> , No. 2:24-cv-00331-RWS-RSP, Dkt. 46 (E.D. Tex. Sept. 23, 2024)
1062	Docket Control Order, <i>Innomemory, LLC v. Truis Financial Corp.</i> , No. 2:24-cv-00146-RWS-RSP, Dkt. 38 (E.D. Tex. Sept. 24, 2024)
1063	Docket Control Order, <i>Husky Injection Molding Systems Ltd. V. Ningbo Ao Sheng Mold Co., Ltd. D/B/A Aosimi</i> , No. 2:24-cv-00348-RWS-RSP, Dkt. 46 (E.D. Tex. Oct. 21, 2024)
1064	Docket Sheet for <i>Partec Ag, et al v. Microsoft Corporation</i> , No. 2:24-cv-00433 (downloaded Mar. 25, 2025).
1065	Combined asserted patents in <i>Genghiscomm Holdings, LLC v. Samsung Elecs., Am., Inc.</i> , No. 2:24-cv-0242-RWS-RSP, Dkt. 25 (Sept. 24, 2024).
1066	File History of U.S. Patent Application No. 16/796,888 as obtained from Patent Center (excerpts).
1067	File History of U.S. Patent Application No. 16/199,221 as obtained from Patent Center (excerpts).
1068	File History of U.S. Patent Application No. 16/027,191 as obtained from Patent Center (excerpts).
1069	File History of U.S. Patent Application No. 15/642,850 as obtained from Patent Center (excerpts).
1070	RESERVED

Exhibit No.	Description
1071	RESERVED
1072	RESERVED
1073	A. Gusmão, et al., <i>Comparison of Two Modulation Choices for Broadband Wireless Communications</i> , VTC2000-Spring. 2000 IEEE 51 st Vehicular Technology Conference Proceedings, Vol. 2, pp.1300-1305 (May 15, 2000).
1074	Exhibit 4 to Plaintiff's P.R. 3-1(c) Infringement Contentions (U.S. Pat. No. 11,075,786)
1075	U.S. Patent No. 11,700,162 to Shattil
1076	RESERVED
1077	U.S. Patent No. 7,436,896
1078	Results of Docket Navigator Search for '786 Patent
1079	RESERVED
1080	RESERVED
1081	RESERVED
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1083	RESERVED
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1087	RESERVED
1088	RESERVED

Exhibit No.	Description
1089	RESERVED
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1094	RESERVED
1095	RESERVED
1096	RESERVED
1097	RESERVED
1098	RESERVED
1099	International Application Publication No. WO 02/054537 to Shattil (“Shattil-537”).
1100	Request for Certificate of Correction from U.S. Patent No. 10,673,758 (withdrawn after issuance)
1101	Request for Certificate of Correction from U.S. Patent No. 10,389,568
1102	Request for Certificate of Correction from U.S. Patent No. 10,778,492
1103	Request for Certificate of Correction for U.S. Patent No. 11,025,468
1104	RESERVED
1105	RESERVED
1106	RESERVED

Exhibit No.	Description
1107	RESERVED
1108	RESERVED
1109	RESERVED
1110	RESERVED
1111	U.S. Provisional Application No. 60/422,670
1112	Articles of Incorporation for Idris Communications, Inc. (Jan. 18, 1999).
1113	Articles of Reinstatement, Idris Communications, Inc. Dissolved Sept. 23, 2004 (filed with the Colorado Secretary of State on February 24, 2023)
1114	The Way Back Machine – https://web.archive.org/web/20010517194943/http://idriscomm.com:80/ (last visited Jul. 4, 2025)
1115	Application for Authority for CIAN Systems, Inc. (Feb. 1, 2001)
1116	The Way Back Machine – https://web.archive.org/web/20011219231934/http://ciansystems.com:80/tech.html (last visited Jul. 3, 2025)
1117	Patent Assignment between Steve Shattil and Arnold Alagar dated Dec. 19, 2005 (Reel/Frame 018668/0704, et seq.) as obtained from the United States Patent & Trademark Office
1118	Patent Assignment between Aquity LLC and Lot 41 Acquisition Foundation, LLC (Reel/Frame 019789/0509, et seq.)
1119	Patent Application Assignment between Steve Shattil and Arnold Alagar dated Dec. 19, 2005 (Reel/Frame 018676/0626, et seq.) as obtained from the United States Patent & Trademark Office
1120	RESERVED

Exhibit No.	Description
1121	RESERVED
1122	RESERVED
1123	RESERVED
1124	Colorado Business Entities (OpenGovCo) search results for companies having an address at 1942 Broadway Street, Suite 314c, Boulder, CO 80302 (retrieved Jul. 11, 2025)
1125	“Find a patent practitioner” search results from https://oedci.uspto.gov/OEDCI/practitionerSearchEntry for Steve Shattil.
1126	Zhiqiang Wu, et al., <i>High-Performance, High-Capacity MC-CDMA via Carrier Interferometry</i> , 12 th IEEE Int’l Symposium on Personal, Indoor and Mobile Radio Communications, PIMRC 2001, pp. G-G (Oct. 3, 2001).
1127	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 15/283,881 (Patent No. 9,768,842) (executed May 9, 2025)
1128	RESERVED
1129	RESERVED
1130	RESERVED
1131	RESERVED
1132	RESERVED
1133	RESERVED
1134	RESERVED
1135	U.S. Patent Application No. 11/187,107, Certification of Micro Entity Status (Gross Income Basis), Information Disclosure Statement and ancillary papers (July 19, 2013).

Exhibit No.	Description
1136	U.S. Patent Application No. 11/187,107, Issue Fee Transmittal (Jan. 14, 2014)
1137	Resume of Mr. Steve Shattil
1138	Excerpts from File History of U.S. Patent Application No. 10/145,854 as obtained from Patent Center
1139	RESERVED
1140	RESERVED
1141	Intellectual Property Owners Association, <i>Top 300 Organizations Granted U.S. Patents in 2024</i> (42 nd Annual Listing) available at https://ipo.org/wp-content/uploads/2025/01/2024-Top-300-Patent-Owners-List.pdf (last visited Jul. 12, 2025).
1142	U.S. Patent Application No. 14/275,161, Filing Receipt dated May 21, 2014
1143	U.S. Patent Application No. 12/545,572, Certification of Micro Entity Status (Gross Income Basis)
1144	U.S. Patent Application No. 13/036,171, Certification of Micro Entity Status (Gross Income Basis)
1145	U.S. Patent Application No. 13/116,984, Certification of Micro Entity Status (Gross Income Basis)
1146	U.S. Patent Application No. 13/116,984, Petition to Revive (filed Aug. 12, 2013)
1147	U.S. Patent Application No. 14/275,161, Certification of Micro Entity Status (Gross Income Basis)
1148	U.S. Patent Application No. 14/275,161, Patent Application Fee Transmittal

Exhibit No.	Description
1149	U.S. Patent Application No. 11/187,107, Transaction History as obtained from USPTO Patent Center on Jul. 12, 2025.
1150	Genghiscomm Trademark Information as obtained from TESS Search (https://tmsearch.uspto.gov) (Jul. 12, 2025)
1151	RESERVED
1152	RESERVED
1153	RESERVED
1154	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 15/396,567 (Patent No. 10,200,227) (executed May 9, 2025)
1155	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 15/786,270 (Patent No. 10,389,568) (executed May 9, 2025)
1156	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 16/796,888 (Patent No. 11,075,786) (executed May 9, 2025)
1157	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 16/916,901 (Patent No. 11,223,508) (executed May 9, 2025)
1158	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 16/940,383 (Patent No. 11,252,005) (executed May 9, 2025)
1159	RESERVED
1160	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 17/105,574 (Patent No. 11,381,285) (executed May 9, 2025)

Exhibit No.	Description
1161	Declaration of Steve Shattil, Declaration Under 37 CFR 1.131(a) related to Application Serial No. 17,183,114 (Patent No. 11,424,792) (executed May 9, 2025)
1162	Judge Schroeder Trial Sitzings (Marshall, TX), as obtained from PACER
1163	U.S. Patent Application No. 10/131,163, Non-Publication Request (filed April 24, 2002) as obtained from USPTO Patent Center
1164	U.S. Provisional Application No. 60/422,670 file history as obtained from USPTO Patent Center
1165	U.S. Patent No. 7,317,750
1166	U.S. Patent Application No. 10/131,163, Drawings filed Apr. 24, 2002 as obtained from USPTO Patent Center
1167	RESERVED
1168	Patent Center Data For U.S. Patent Application No. 10/414,663 (obtained Jul. 22, 2025).
1169	Patent Center Continuity Data for U.S. Patent Application No. 10/414,663 (obtained Jul. 22, 2025).
1170	Patent Center Data for U.S. Patent Application No. 10/360,346 (obtained Jul. 22, 2025)
1171	Patent Center Continuity Data for U.S. Patent Application No. 10/360,346 (obtained Jul. 22, 2025)
1172	RESERVED
1173	RESERVED
1174	RESERVED
1175	RESERVED

Exhibit No.	Description
1176	Information Disclosure Statement by Applicant, U.S. Patent Application No. 14/789,949 (dated Feb. 2, 2017)
1177	Information Disclosure Statement by Applicant, U.S. Patent Application No. 14/733,013 (dated June 6, 2017)
1178	U.S. Patent Application Publication No. 2004/0100897 to Shattil

I. INTRODUCTION

Pursuant to the “Interim Processes for PTAB Workload Management Memorandum” issued by Director Stewart on March 26, 2025 (“Stewart Memo”), Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Samsung” or “Petitioner”) respectfully submit this brief requesting that the Director decline to exercise her discretion to deny institution of the Petition for Inter Partes Review (IPR) (Paper 1) of U.S. Patent No. 11,075,786 (“’786 Patent” or “Challenged Patent”) owned by Genghiscomm Holdings, LLC (“Genghiscomm”). Samsung’s challenge to the ’786 Patent is one of nine IPRs filed against patents asserted in litigation by Genghiscomm against Samsung Electronics America, Inc.

Although the scheduled district court trial date precedes the projected final written decision date for this proceeding, denial is not warranted because of the unique facts of these cases, including (1) of the nine patents challenged in this dispute, six issued in 2021 or later and none issued earlier than 2017, (2) Mr. Shattil, the inventor and prosecutor of these patents, repeatedly and knowingly misused micro entity status, (3) Mr. Shattil made a wholesale change to the priority claim for the Challenged Patent during prosecution to extend its patent term to the detriment of the public, but would not have been able to do so if he had not filed a false certification with a nonpublication request and failed to disclose his earlier-

filed PCT application, and (4) Mr. Shattil misused the United States patent system and inappropriately prosecuted the nine Challenged Patents to the detriment of the public by withdrawing subject matter that had been dedicated to the public by his assignee and pursuing patents to subject matter in which he lacked an ownership interest.

For these reasons, Petitioner respectfully requests that the petition be referred for a merits determination.¹

¹ Samsung will be filing briefs in connection with each of the nine IPR proceedings and anticipates raising similar issues in each proceeding. There will be differences particularly as it pertains to the public interest factors discussed herein because those issues differ from one proceeding to another. The primary differences between this brief and the briefs Samsung has already filed in IPR2025-00780 and IPR2025-00781 are the following: (1) a discussion about how Genghiscomm has improperly benefited from a false certification made in connection with a nonpublication request filed in April 2002 that has improperly allowed the Challenged Patent's expiration date to be extended by years. *Infra* § III(B)(1); (2) a discussion about how claiming subject matter allegedly found in patent application publications that had been assigned away by Mr. Shattil not only prevented him from having an ownership

II. BACKGROUND

A. The Parties and Patent Agent Mr. Shattil

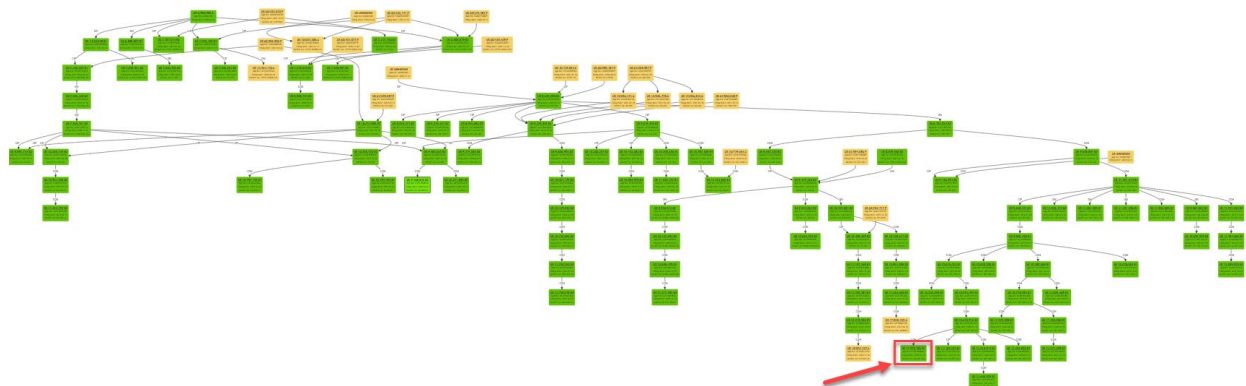
Genghiscomm Holdings, LLC (“Genghiscomm”) is a Colorado limited liability company formed on January 14, 2014, with an address at 1942 Broadway Street, Suite 314c, Boulder, CO 80302. EX1047, ¶1; EX1123. Dozens of LLCs share this same address. EX1124. Its Director, Mr. Steve Shattil, has been a registered patent agent since 1996. EX1125. Mr. Shattil is the named inventor on the Challenged Patent. EX1001, cover. His resume indicates that he is an inventor on over 150 patents and has filed or prosecuted over 1,000 patents and patent applications. EX1137. “Genghiscomm®” was registered as a trademark in 2019 and is owned by Steve Shattil. EX1150. The goods and services associated with Genghiscomm are described as “Licensing of intellectual property rights.” EX1150, p.1. Since its formation in 2014, Genghiscomm has operated solely as a patent licensing company; it makes no products and has no discernible operations beyond its patent licensing efforts.

interest in the claimed subject matter, but also worked to the detriment of the public, and (3) at the time of this filing, there is no reexamination pending before the Office (though SEA anticipates filing one to raise another public interest concern: double patenting).

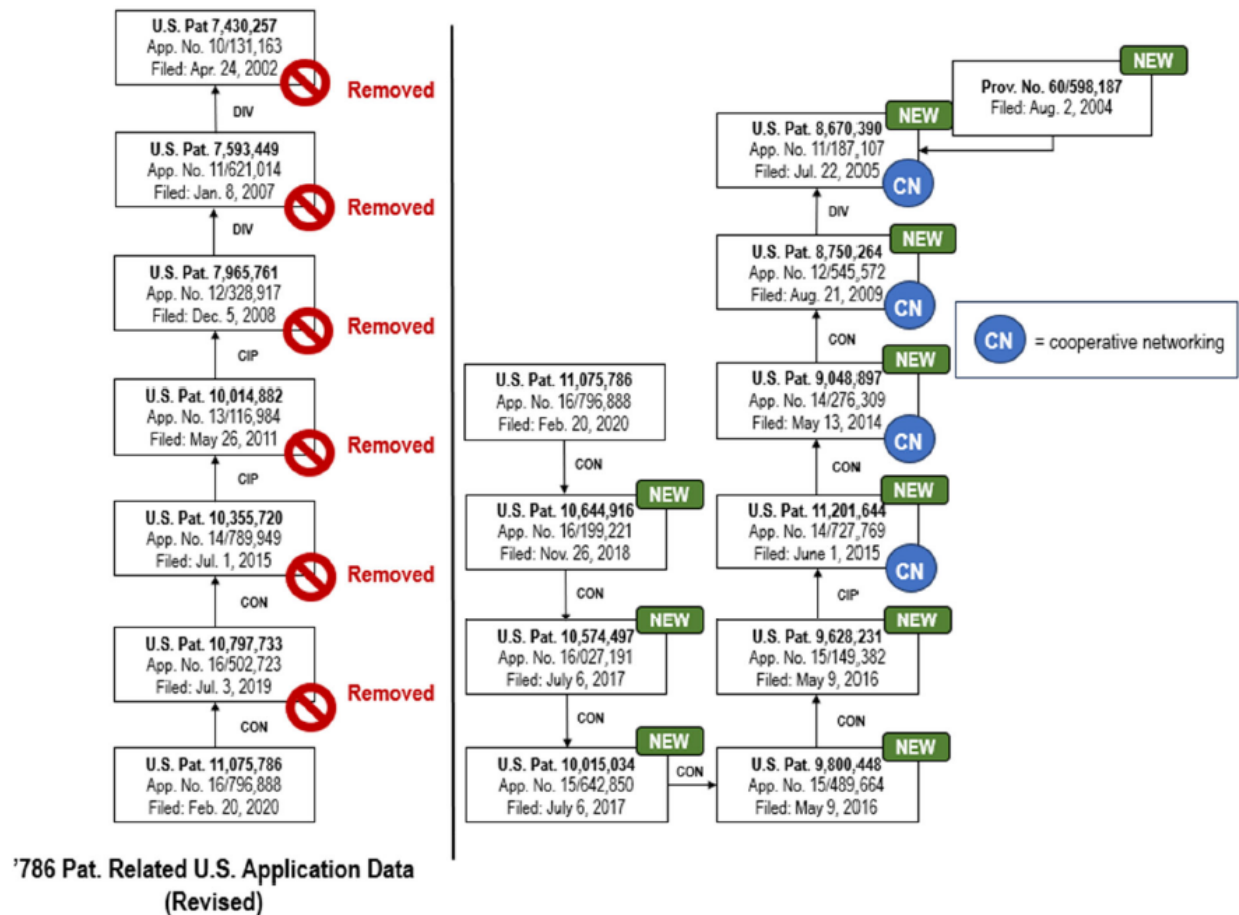
Petitioner Samsung Electronics America, Inc. (“SEA”) is a United States corporation with offices in various states, including Texas, California, and New Jersey. SEA is a wholly owned subsidiary of Samsung Electronics Co., Ltd., a Korean company founded nearly a century ago. In 2024, Petitioner party Samsung Electronics Co., Ltd. obtained more patents from the USPTO than any other company, according to the Intellectual Property Owners Association. EX1141, p.2.

B. Mr. Shattil Created A Patent Thicket Spanning More Than 100 Applications And Over 20 Years of Prosecution.

While the domestic benefit claim for the ’786 Patent may appear relatively simple, the ’786 Patent is part of a much larger family of patent applications that have weaved their way through the Office for more than two decades. In all, there are more than 110 interrelated applications connected through a web of domestic benefit claims and incorporations by reference. The following family tree, generated by an online tool called PatentBots® PatentPlex®, illustrates the extent of the family (the ’786 Patent is identified by the red box and arrow):



The immediate patent family shown on the face of the '786 Patent does not capture the full complexity of the prosecution history. In fact, as shown in the illustration below, during prosecution of the '786 Patent, a wholesale change to the domestic benefit claim was made.



EX1066, pp.37-39, 47-48. This change in domestic priority claim by Mr. Shattil significantly changed the exclusivity period associated with any patent that would issue on the application because, instead of calculating the expiration date based on an April 24, 2002 filing date, the expiration date would be calculated off the July

22, 2005 nonprovisional filing date of U.S. Patent Application No. 11/187,107 (“the ’107 Application”).

The domestic priority claims also fail to reveal the complexity created by numerous incorporations by reference within the specifications. Focusing on the domestic benefit claim made after the substantial revision to the domestic benefit claim was made, U.S. Provisional Application No. 60/598,187 (filed August 2, 2004) and the ’107 application (filed July 22, 2005), were directed to a different invention than the Challenged Patent. That different invention involves cooperative behavior between multiple mobile devices and each application in the chain that disclosed that subject matter has the abbreviation “CN” next to it. On May 9, 2016, Mr. Shattil rewrote the specification of the earlier applications and added discussions of orthogonal spreading, lowering peak-to-average power ratio, fast transforms, DFT spreading, and even incorporating by reference everything that appeared on a particular website (www.fftw.org) as allegedly relating to the disclosed DFT spreader. *E.g.*, EX1037, pp.97-129. Despite these new significant additions to the specification, Genghiscomm alleges that it is still entitled to an August 2, 2004 effective filing date.

As best Petitioner understands the basis for these significant changes to the specification, Genghiscomm is relying on disclosures from one of two U.S. Patent Application publications that were allegedly incorporated by reference into the

'187 Provisional and the '107 Application from a portion of the patent family that Mr. Shattil had assigned away and had no right to pursue claims in. *See infra* §III.B.2. In fact, Mr. Shattil has signed a declaration indicating that all claims of the Challenged Patent were first described in *yet another* patent application that is in a still different part of the extended patent family.

Mr. Shattil's approach to drafting and prosecuting these related applications has resulted in a patent thicket that comprises thousands of pages of complex descriptions and figures, leaving the public to navigate the web of disclosures without transparency.²

² Take, for example, the '786 Patent filed in 2020. EX1001. Mr. Shattil has contended that he first described the claimed subject matter **eighteen years earlier** in a patent application he filed in April 2002. EX1156, p.1, ¶¶3-4. While the '786 Patent was originally filed claiming the benefit of that application and shares a largely similar specification, Mr. Shattil's change to the domestic benefit claim means that the published U.S. patent specification makes no reference to that application at all. Indeed, the Office and the public are left to sift through Mr. Shattil's over 100 patent applications to figure out the origins of the allegedly claimed subject matter.

The complexity is evident even considering just the nine patents

Genghiscomm has asserted against Petitioner SEA across two litigations.

Collectively, they span 715 pages and include 270 claims. EX1065 & IPR2025-00899, EX1001. The table below summarizes key information about these patents, including for each Challenged Patent: (1) the earliest claimed priority date (2) date of alleged constructive reduction to practice,³ (3) number of figures, (4) number of columns, and (5) an estimate of the number of documents incorporated by reference:

Pat.	Earliest Claimed Priority	Alleged Reduction to Practice	No. of Figs	Spec. Cols.	No. of Docs Inc. by Reference.
'842	5/14/02	11/2/99	48	79	~ 25
'227	5/14/02	11/2/99	48	79	~ 25
'568	5/14/02	11/2/99	47	43	~47
'786	8/4/04	4/24/02	236	157	~ 58
'508	8/4/04	4/24/02	19	54	~ 27

³ These dates are obtained from the declarations of Mr. Shattil and are in the record at EX1127 and EX1154 to EX1158, EX1160, EX1161. As these declarations show, Mr. Shattil believes he filed applications directed to the claimed subject matter in applications that predate the filing of the earliest applications in his domestic benefit claims.

Pat.	Earliest Claimed Priority	Alleged Reduction to Practice	No. of Figs	Spec. Cols.	No. of Docs Inc. by Reference.
'005	8/4/04	4/16/03	19	54	~ 24
'285	8/4/04	2/7/03	70	76	~ 17
'792	1/8/07	4/24/02	37	66	~ 11
'386	8/4/04	Unknown	70	75	~ 17

There is substantial overlap in the specifications of some patents (e.g., the '508 and '005 Patents share similar specifications and domestic benefit claims). Yet, according to Mr. Shattil's declarations, the claimed subject matter in these otherwise similar applications has different dates of constructive reduction to practice, because the subject matter was first described in different patents and applications within the family.

Mr. Shattil has thus created a highly complex patent thicket that is difficult to decipher due to his prosecution strategy. The Office is far better equipped than a federal jury to address and resolve these complexities.

III. DISCRETIONARY DENIAL IS NOT WARRANTED UNDER §314(A)

A. Genghiscomm Lacks Settled Expectations In The Challenged Patent Because It Was Filed In February 2020—Eighteen Years After It Was Allegedly Conceived—And Issued In July 2021.

There are many reasons why Genghiscomm lacks any settled expectations with respect to the patents in dispute, including the fact that of the nine patents

challenged in this dispute, six issued in 2021 or later and none issued earlier than 2017. Specifically, Genghiscomm lacks settled expectations in the '786 Patent, which issued on July 27, 2021. EX1001, cover. The application for the Challenged Patent was filed in February 2020, about eighteen years after Mr. Shattil has declared that he first described the claimed subject matter in a provisional application filed in a different part of the extended patent family. EX1156, ¶¶3-4. The application for the challenged patent was even filed more than fifteen years after its earliest claimed priority date of August 2, 2004. EX1001, cover. Thus, Genghis has not developed strong settled expectations in the '786 Patent that warrant discretionary denial. *See, e.g., Shenzhen Tuozhu Tech. Co., Ltd. v. Statasys, Inc.*, IPR2025-00438, Paper 10 (Jul. 17, 2025) (patents issuing in 2020, 2020, 2021, and 2024 not “in force for a significant period of time” and thus the Patent Owner lacked “strong settled expectations that favor discretionary denial”); *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11 (Jun. 26, 2025) (referring to merits panel when “most of the challenged patents have not been in force for a significant period of time (issued in 2020, 2019, and 2019), and accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial at least as to those patents”).

In addition to the group of patents challenged in this and related proceedings before the Board being relatively new, there are other unique facts in this and the

other related proceedings warranting a finding of a lack of settled expectations and a finding that the public's interest will be best served by a review of these patents in this proceeding.

B. Compelling Public Interest: Considerations of Fairness, Patent System Efficiency, and Patent Quality Strongly Weigh Against Discretionary Denial On These Unique Facts.

1. Mr. Shattil improperly extended the term of the Challenged Patent in reliance on a false certification made with a non-publication request he signed in April 2002.

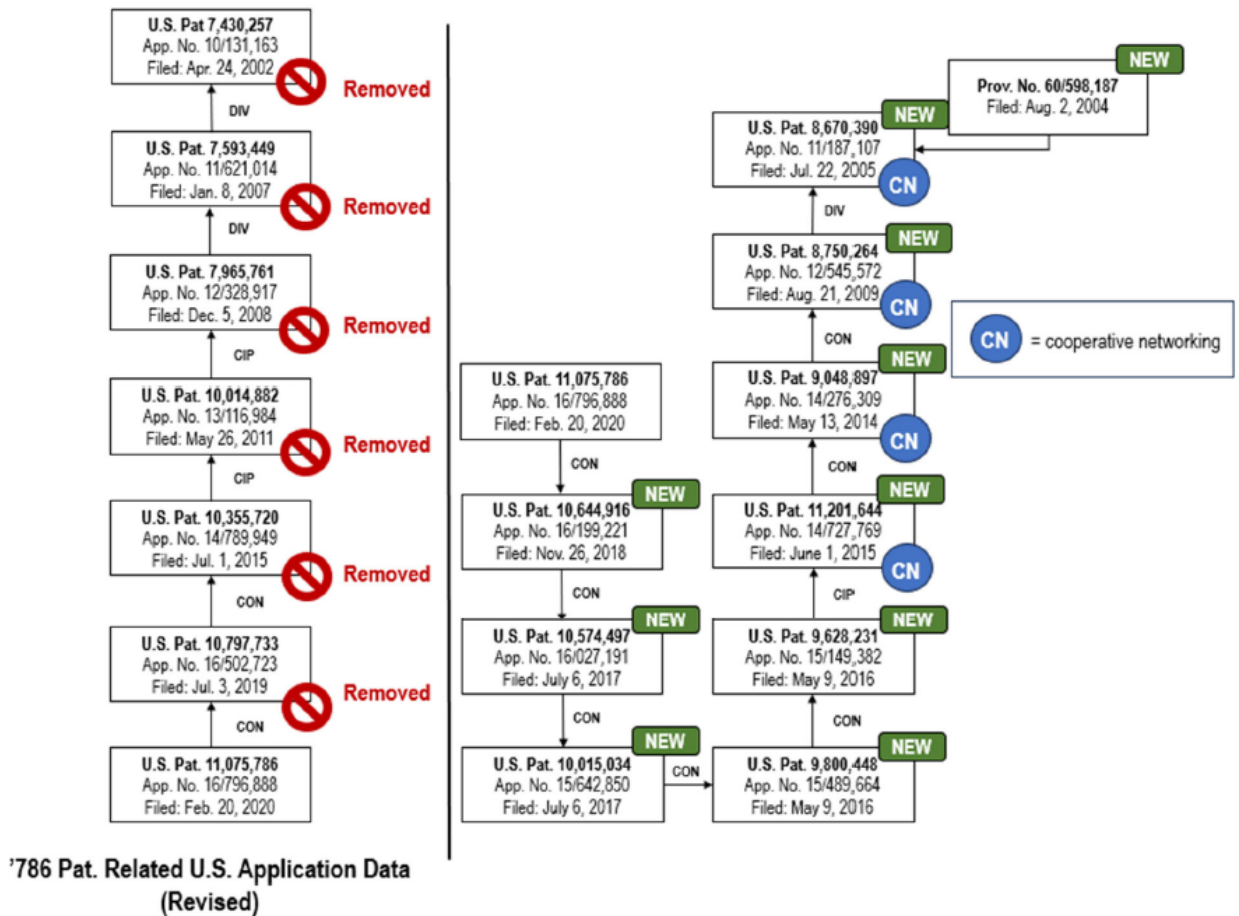
Mr. Shattil filed a false certification with a nonpublication request with the U.S. Patent Office for Application No. 10/131,163 (“the ’163 Application”), certifying that the invention *had not been* and would not be filed internationally, even though he had already filed a PCT application from which he copied many of the figures just months earlier. This false certification prevented the ’163 Application from publishing as required by law, which in turn, allowed Mr. Shattil to manipulate the priority claim of a related patent (the ’786 Patent) nearly two decades later, thereby improperly extending the ’786 Patent’s expiration by more than three years. This improper extension of the patent term is contrary to the public interest.

- a. Mr. Shattil contends that all Challenged Claims were first described in the '163 Application, filed April 24, 2002.**

Mr. Shattil has provided a declaration stating that the subject matter of each claim of the '786 Patent “is disclosed in U.S. Patent appl. no. **10/131,163 ('163), filed April 24, 2002.**” EX1156, ¶¶3-4. Mr. Shattil thus believes that all Challenged Claims are described in the '163 Application.

- b. The Challenged Patent was originally filed in the part of the patent family including the '163 Application.**

As already mentioned, during prosecution of the Challenged Patent, Mr. Shattil amended the priority claim to remove the Challenged Patent from the part of the patent family including the '163 Application and moved it into another part of the patent family that had a different domestic benefit claim and thus allowed the '786 Patent to expire later.



EX1066, pp.37-39, 47-48. Instead of expiring in 2022, any patent that would issue from the application leading to the '786 Patent would expire in July 2025 (absent patent term adjustments)—more than three years later.

c. Mr. Shattil filed a non-publication request in the '163 Application that prevented that application from publishing in 2002.

The change to the priority claim in the application for the '786 Patent would have been impossible if the '163 Application published before August 2, 2003, because that publication would have acted as a statutory bar to any application filed

more than a year after its publication. As a matter of statute, the '163 Application should have published “promptly” after it was filed because it claimed the benefit of the February 12, 1998 filing date of U.S. Patent Application No. 09/022,950. *See* 35 U.S.C. § 122(b)(1)(A) (“[E]ach application for a patent shall be published, in accordance with procedures determined by the Director, *promptly after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under this title.*” (emphasis added)). Thus, it would have published sometime in 2002, “promptly” after it was filed.

To prevent the '163 Application from publishing in 2002, Mr. Shattil submitted a non-publication request. In that request, he certified the invention disclosed in the '163 Application had not been filed under a treaty requiring 18-month publication. Mr. Shattil's certification stated:

I hereby certify that the invention disclosed in the attached application **has not and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

EX1163 (emphasis original). Applications under “a multilateral agreement” includes applications filed under the Patent Cooperation Treaty (“PCT”).

d. Mr. Shattil's certification in the April 2002 non-publication request was false.

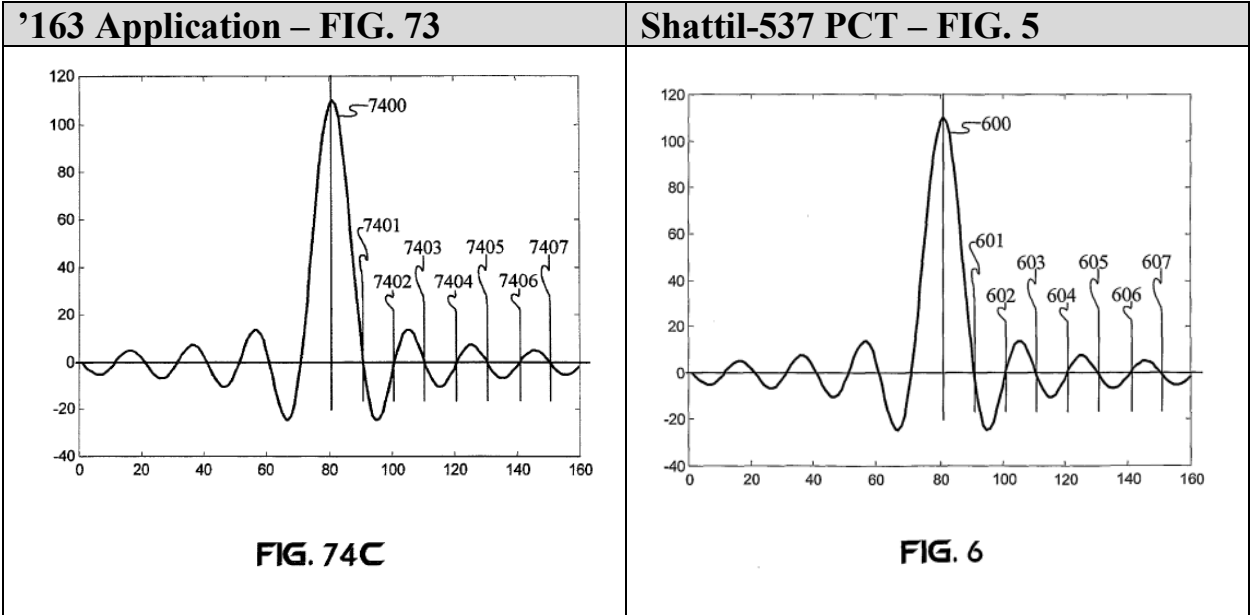
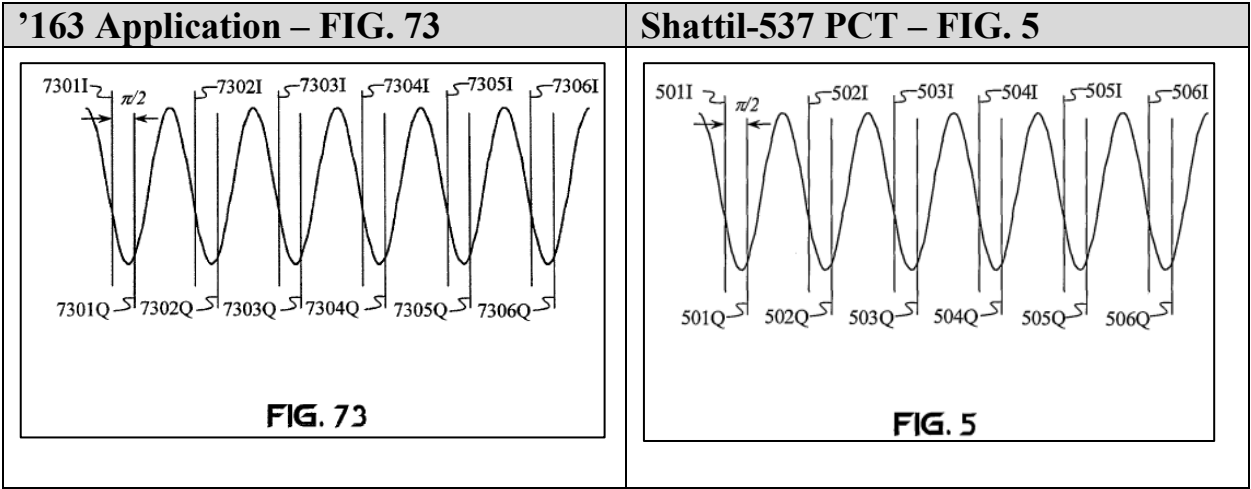
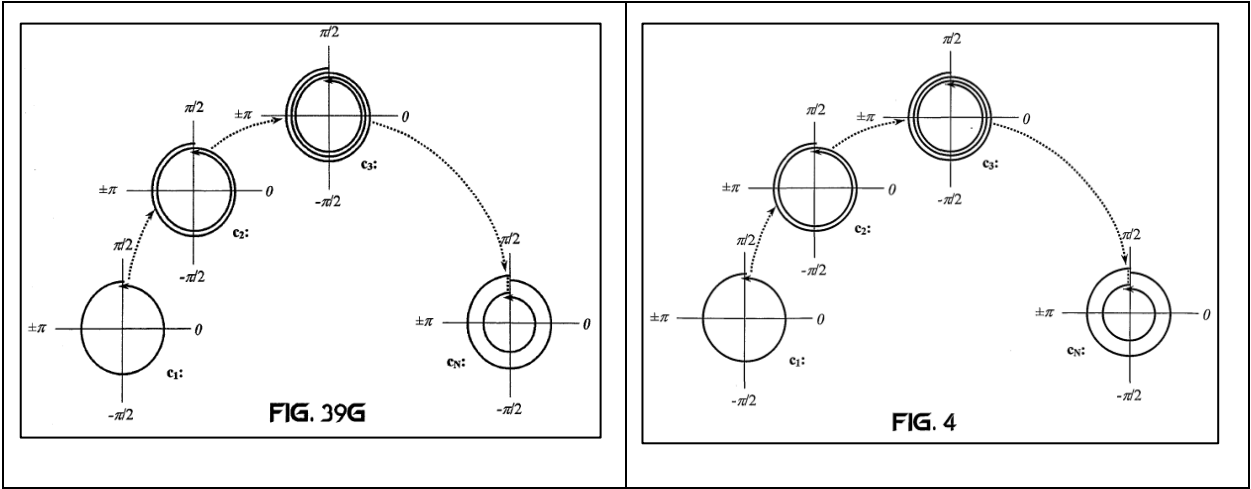
This certification was not true because on December 26, 2001—months before the '163 Application was filed, Mr. Shattil filed PCT/US0150856, which published on July 11, 2002 as WO 02/054537 (“Shattil-537 PCT”). EX1099.

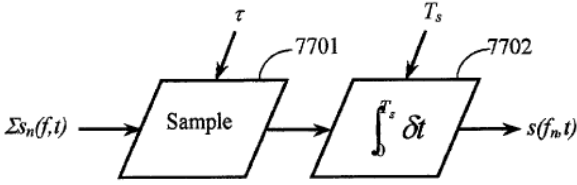
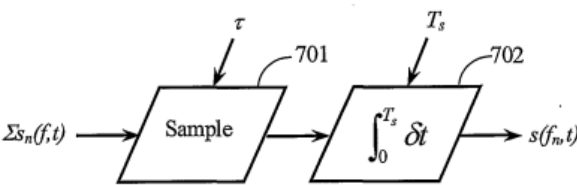
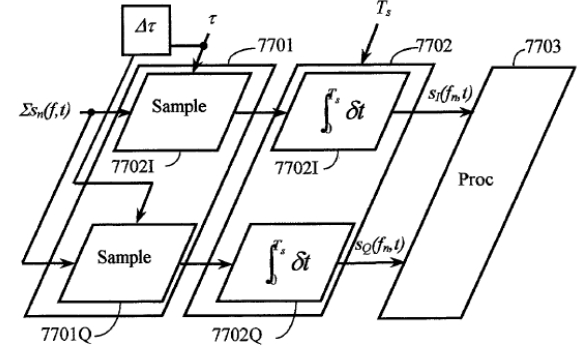
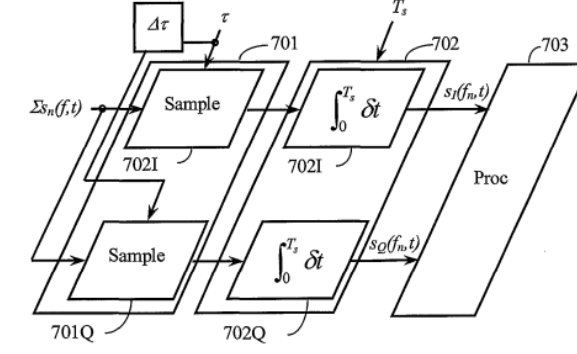
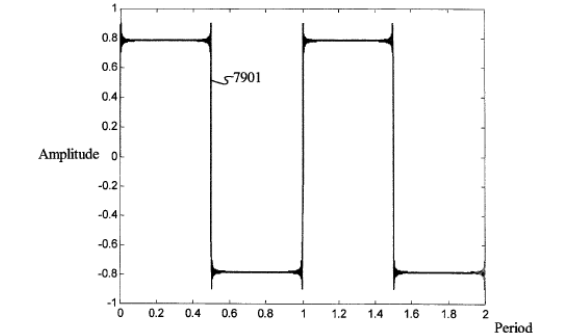
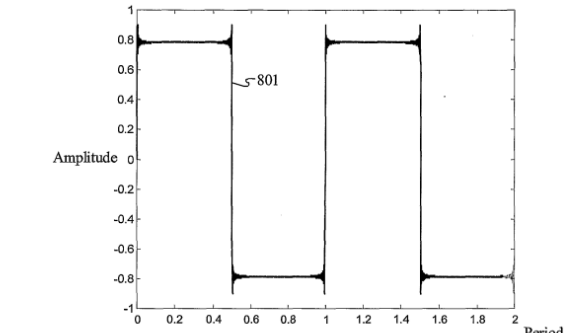
While not identical, the Shattil-537 PCT and the '163 Application share figures and description. Even some of the claims are similar between this PCT application and the '163 Application. Mr. Shattil's certification is contrary to his filing of the Shattil-537 PCT. In fact, Mr. Shattil included many of the same figures in the Shattil-537 PCT and the '163 Application—including readily-apparent typographical errors.

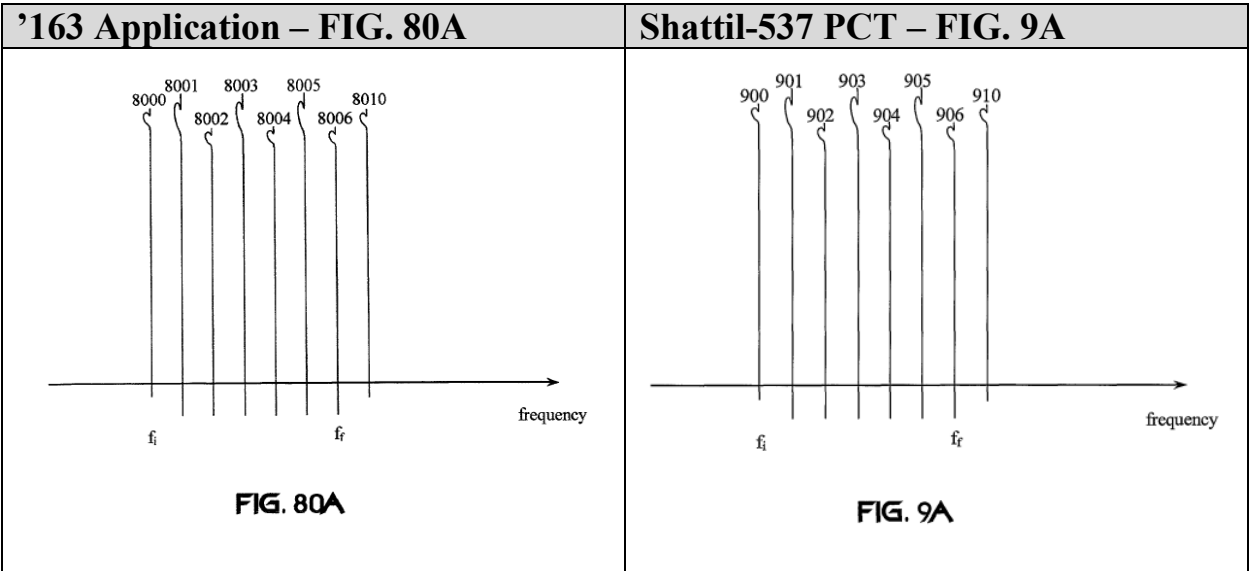
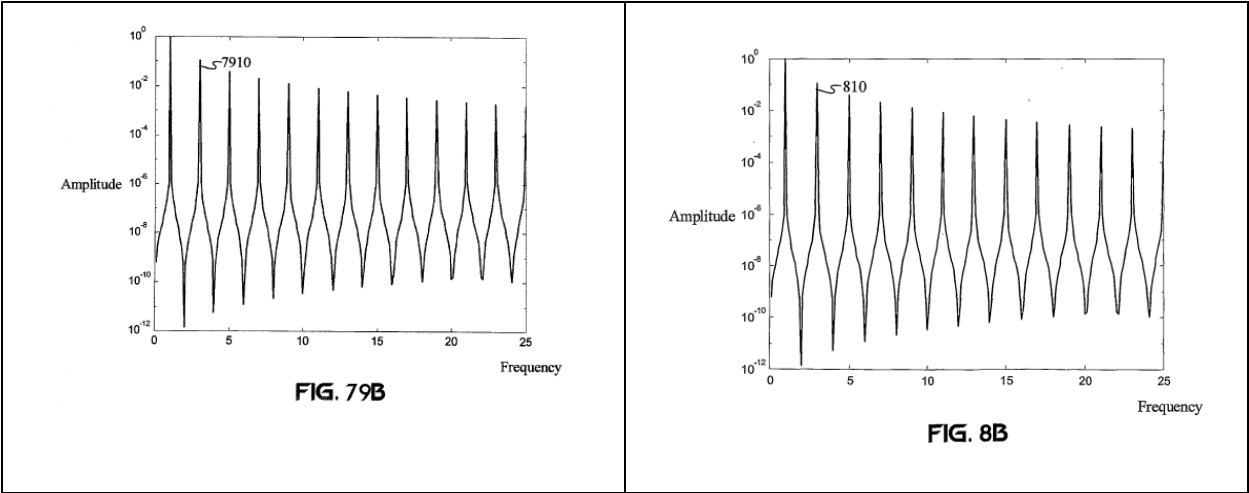
Thus, not only was Mr. Shattil aware of the Shattil-537 PCT, he copied parts of the '163 Application from it. The correspondence of figures from the '163 Application and the Shattil-537 PCT are illustrated in the tables below. All told, more than 35 figures were copied from the Shattil-537 PCT, renumbered, and placed in the '163 Application.⁴

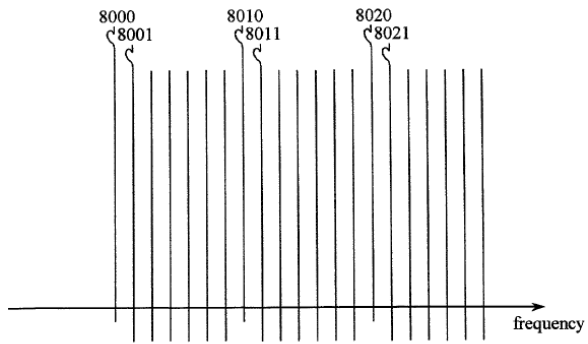
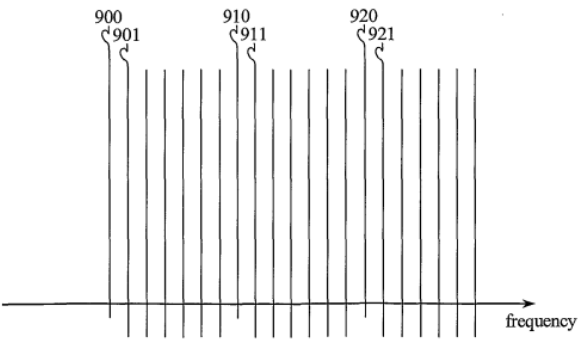
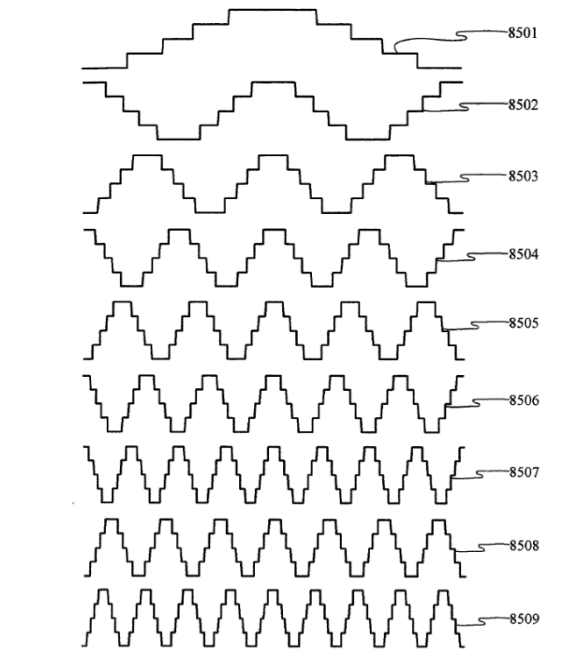
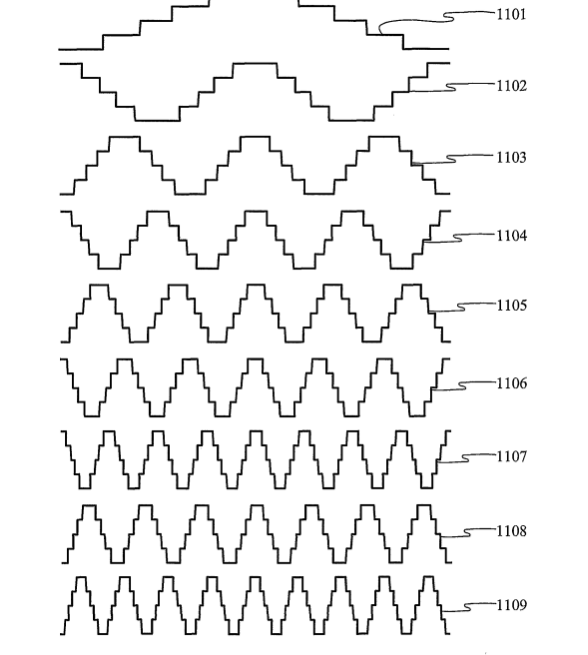
'163 Application – FIG. 39G	Shattil-537 PCT – FIG. 4
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⁴ Even if some subject matter found in the '163 Application was not found in Mr. Shattil's PCT filing, Mr. Shattil needed to redact the newly-added information if he did not wish for that subject matter to publish. *See* 35 U.S.C. § 122(b)(2)(B)(v).



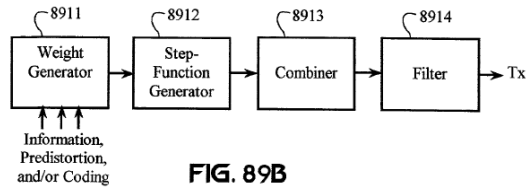
'163 Application – FIG. 77A  FIG. 77A	Shattil-537 PCT – FIG. 7A  FIG. 7A
'163 Application – FIG. 77B  FIG. 77B	Shattil-537 PCT – FIG. 7B  FIG. 7B
'163 Application – FIG. 79A  FIG. 79A	Shattil-537 PCT – FIG. 8A  FIG. 8A
'163 Application – FIG. 79B	Shattil-537 PCT – FIG. 8B



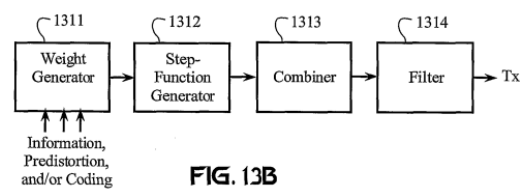
'163 Application – FIG. 80B  FIG. 80B	Shattil-537 PCT – FIG. 9B  FIG. 9B
'163 Application – FIG. 85  FIG. 85	Shattil-537 PCT – FIG. 9B  FIG. 11

'163 Application – FIG. 86A FIG. 86A	Shattil-537 PCT – FIG. 9B FIG. 12A
'163 Application – FIG. 86B FIG. 86B	Shattil-537 PCT – FIG. 12B FIG. 12B
'163 Application – FIG. 89A FIG. 89A	Shattil-537 PCT – FIG. 12B FIG. 13A

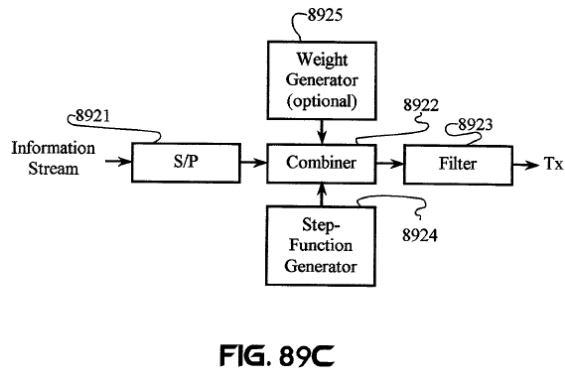
'163 Application – FIG. 89B



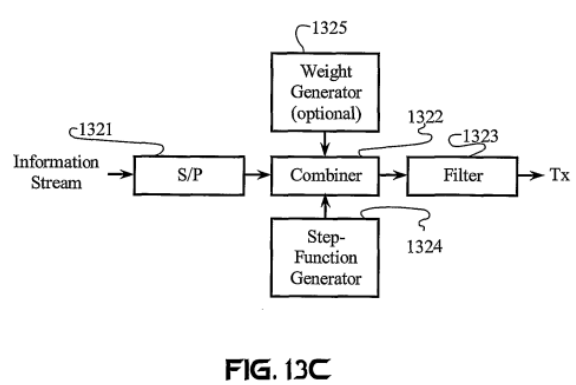
Shattil-537 PCT – FIG. 13B



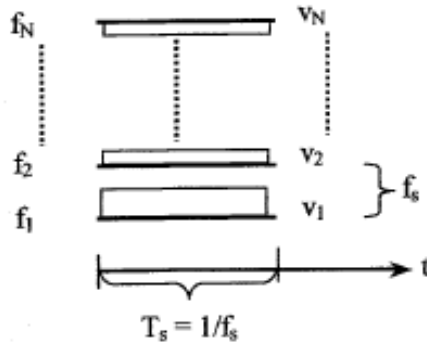
'163 Application – FIG. 89C



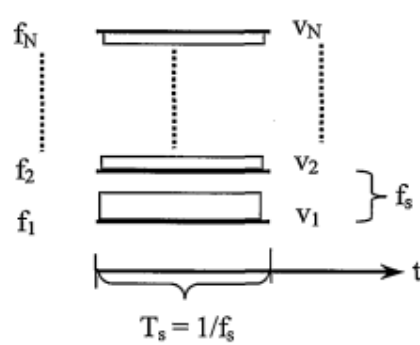
Shattil-537 PCT – FIG. 13C

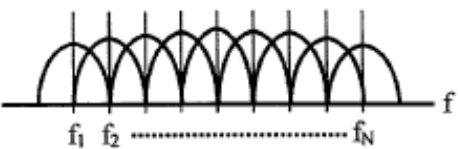
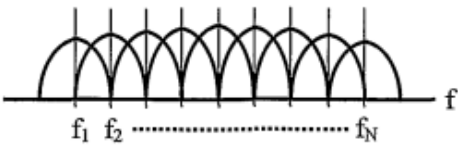
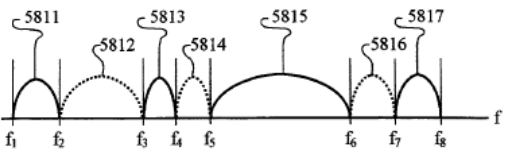
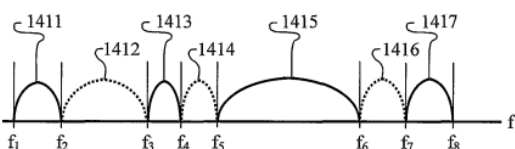
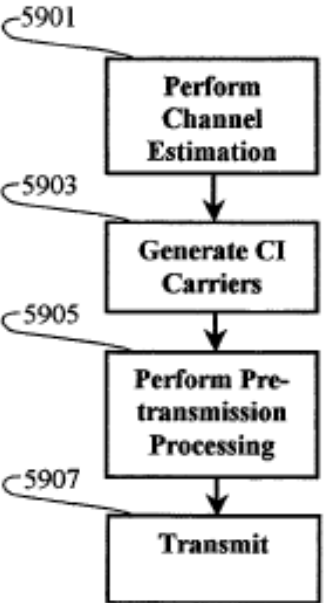
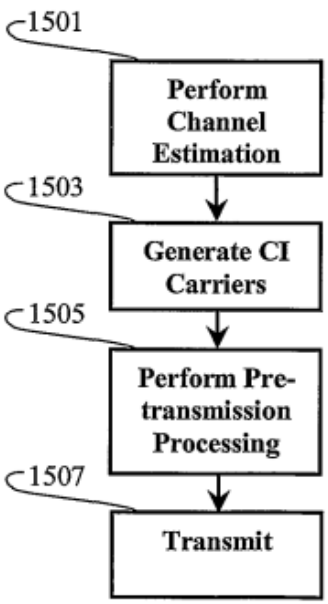


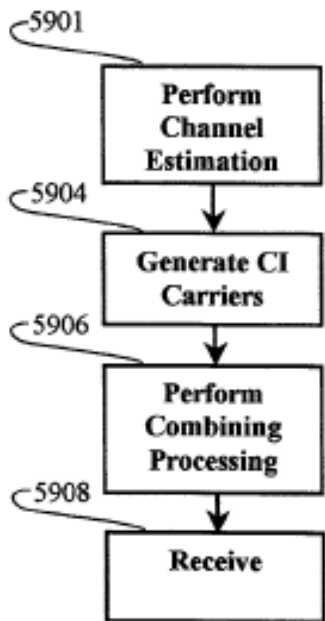
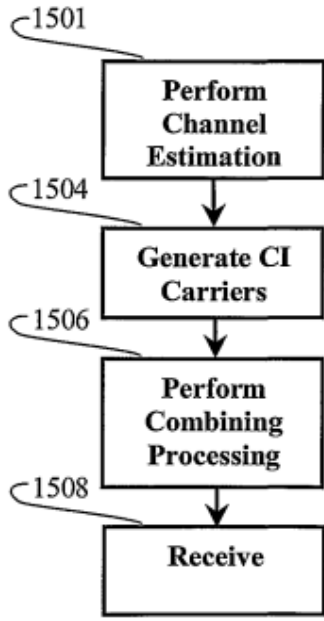
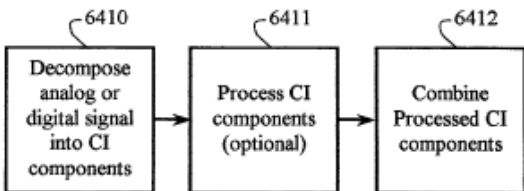
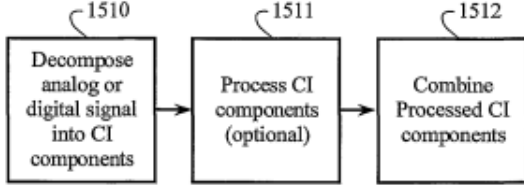
'163 Application – FIG. 58A

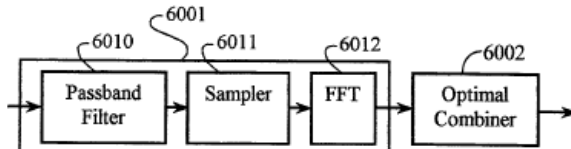
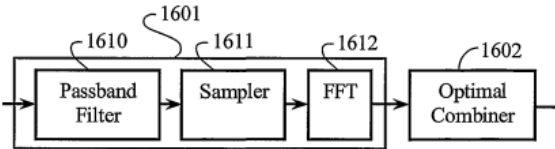
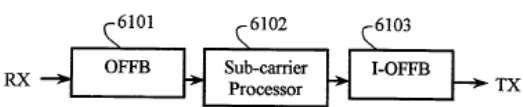
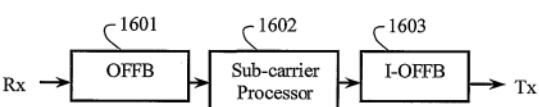
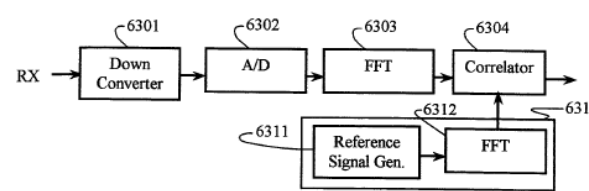
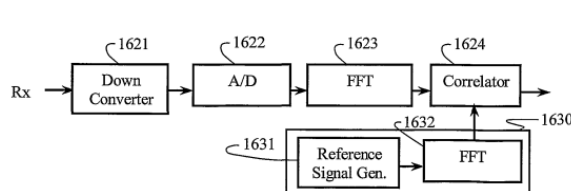


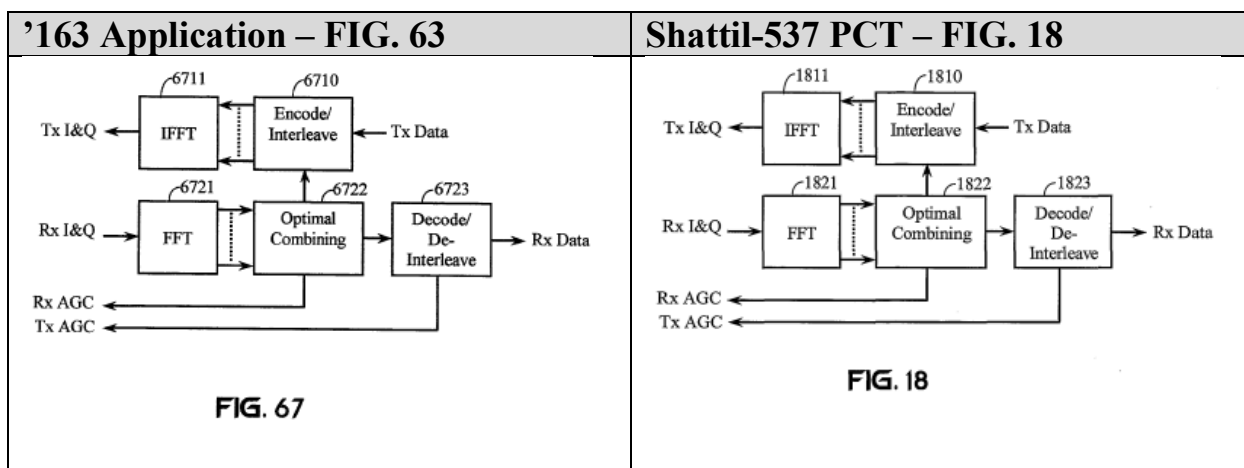
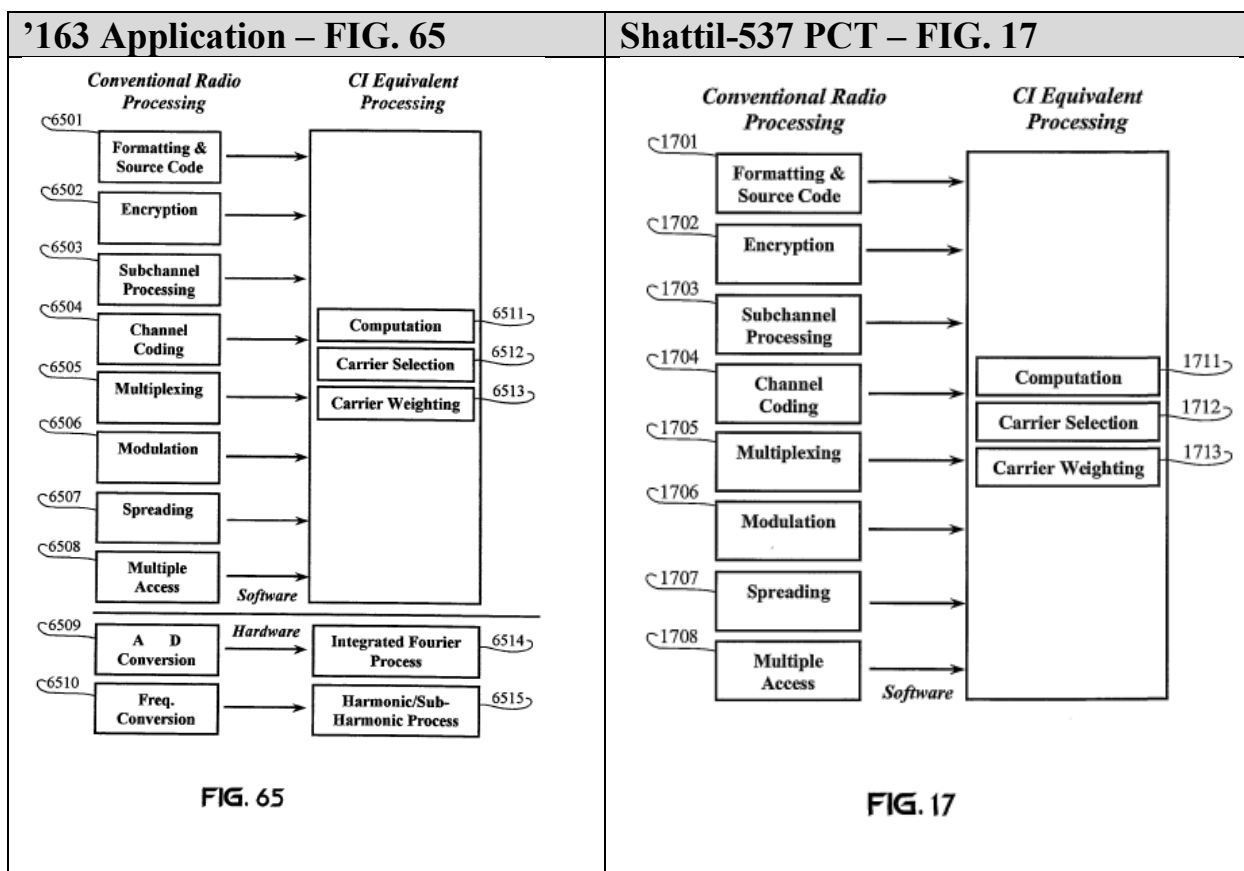
Shattil-537 PCT – FIG. 14A

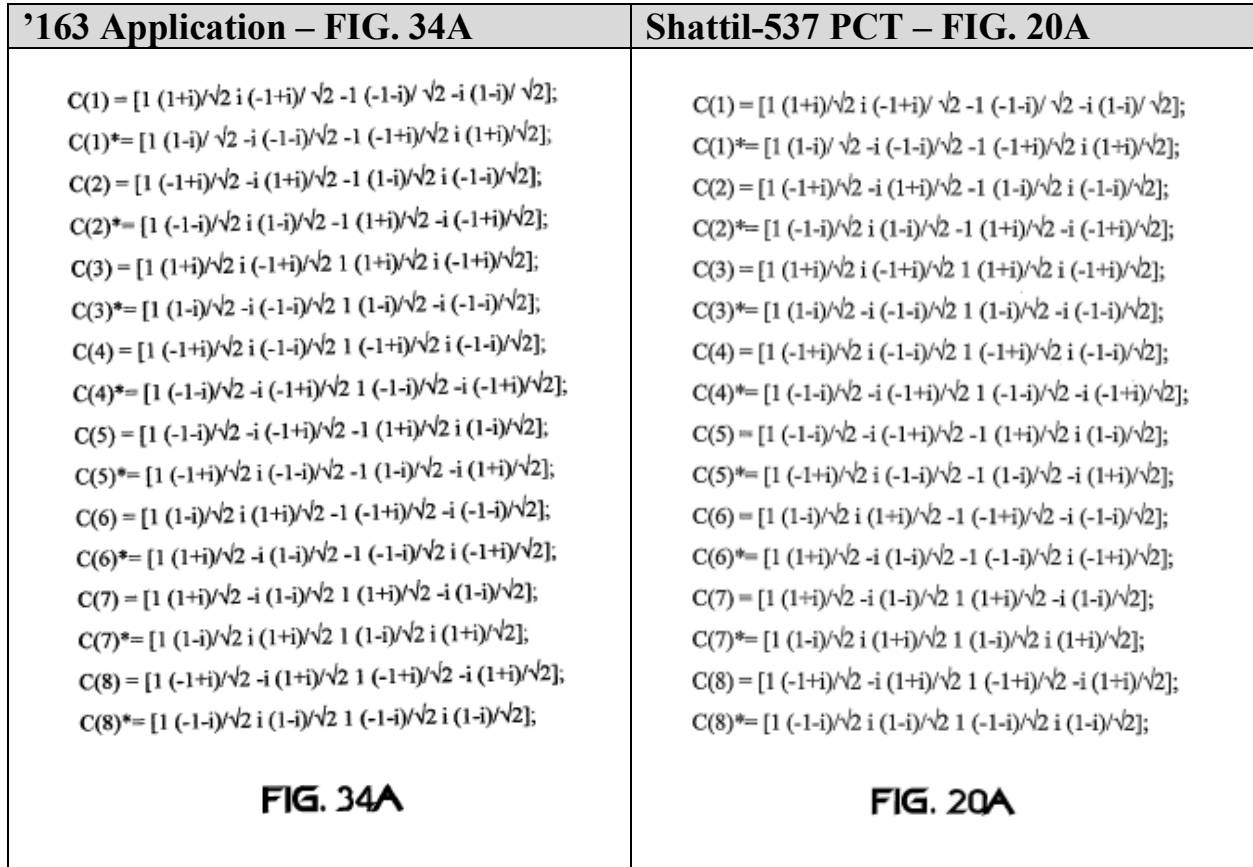
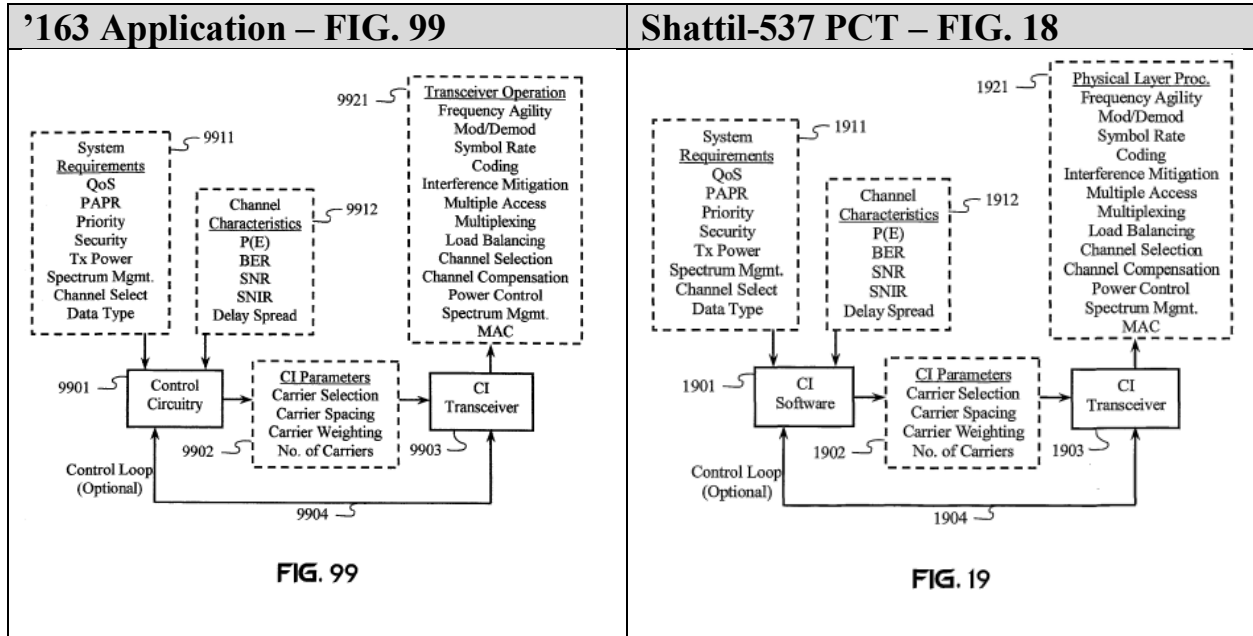


'163 Application – FIG. 58B  FIG. 58B	Shattil-537 PCT – FIG. 14B  FIG. 14B
'163 Application – FIG. 58E  FIG. 58E	Shattil-537 PCT – FIG. 14C  FIG. 14C
'163 Application – FIG. 59A  FIG. 59A	Shattil-537 PCT – FIG. 15A  FIG. 15A

'163 Application – FIG. 59B	Shattil-537 PCT – FIG. 15B
 <pre> graph TD 5901[Perform Channel Estimation] --> 5904[Generate CI Carriers] 5904 --> 5906[Perform Combining Processing] 5906 --> 5908[Receive] </pre> FIG. 59B	 <pre> graph TD 1501[Perform Channel Estimation] --> 1504[Generate CI Carriers] 1504 --> 1506[Perform Combining Processing] 1506 --> 1508[Receive] </pre> FIG. 15B
'163 Application – FIG. 64B	Shattil-537 PCT – FIG. 15C
 <pre> graph LR 6410[Decompose analog or digital signal into CI components] --> 6411[Process CI components (optional)] 6411 --> 6412[Combine Processed CI components] </pre> FIG. 64B	 <pre> graph LR 1510[Decompose analog or digital signal into CI components] --> 1511[Process CI components (optional)] 1511 --> 1512[Combine Processed CI components] </pre> FIG. 15C

'163 Application – FIG. 60A	Shattil-537 PCT – FIG. 16A
 FIG. 60A	 FIG. 16A
'163 Application – FIG. 61	Shattil-537 PCT – FIG. 16B
 FIG. 61	 FIG. 16B
'163 Application – FIG. 63	Shattil-537 PCT – FIG. 16C
 FIG. 63	 FIG. 16C





'163 Application – FIG. 34B

	C(1)* C(1)	C(2)* C(2)	C(3)* C(3)	C(4)* C(4)	C(5)* C(5)	C(6)* C(6)	C(7)* C(7)	C(8)* C(8)
CI(1)	0	8	0	0	0	0	0	0
CI(1)*	8	0	0	0	0	0	0	0
CI(2)	0	0	0	8	0	0	0	0
CI(2)*	0	0	8	0	0	0	0	0
CI(3)	0	0	0	0	8	0	0	0
CI(3)*	0	0	0	8	0	0	0	0
CI(4)	0	0	0	0	4-4i	0	8	0
CI(4)*	0	0	0	0	4-4i	0	8	0
CI(5)	4-4i	0	0	4+4i	0	0	0	0
CI(5)*	0	4+4i	4-4i	0	0	0	0	0
CI(6)	0	4-4i	4+4i	0	0	0	0	0
CI(6)*	4+4i	0	0	4-4i	0	0	0	0
CI(7)	0	0	0	0	4+4i	0	0	0
CI(7)*	0	0	0	0	4+4i	0	0	0
CI(8)	0	0	0	0	0	4-4i	0	8
CI(8)*	0	0	0	0	0	4-4i	0	8

FIG. 34B

Shattil-537 PCT – FIG. 20B

	C(1)* C(1)	C(2)* C(2)	C(3)* C(3)	C(4)* C(4)	C(5)* C(5)	C(6)* C(6)	C(7)* C(7)	C(8)* C(8)
CI(1)	0	8	0	0	0	0	0	0
CI(1)*	8	0	0	0	0	0	0	0
CI(2)	0	0	0	8	0	0	0	0
CI(2)*	0	0	8	0	0	0	0	0
CI(3)	0	0	0	0	8	0	0	0
CI(3)*	0	0	0	8	0	0	0	0
CI(4)	0	0	0	0	4+4i	0	8	0
CI(4)*	0	0	0	0	4+4i	0	8	0
CI(5)	4-4i	0	0	4+4i	0	0	0	0
CI(5)*	0	4+4i	4-4i	0	0	0	0	0
CI(6)	0	4-4i	4+4i	0	0	0	0	0
CI(6)*	4+4i	0	0	4-4i	0	0	0	0
CI(7)	0	0	0	0	4+4i	0	0	0
CI(7)*	0	0	0	0	4+4i	0	0	0
CI(8)	0	0	0	0	0	4-4i	0	8
CI(8)*	0	0	0	0	0	4-4i	0	8

FIG. 20B

'163 Application – FIG. 40B

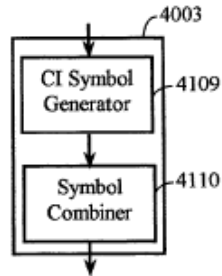


FIG. 40B

Shattil-537 PCT – FIG. 21A

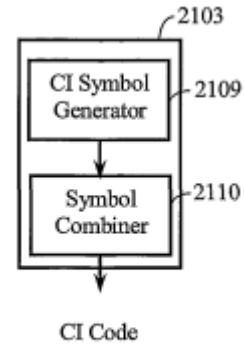


FIG. 21A

'163 Application – FIG. 40B

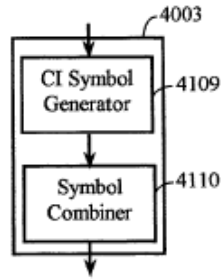


FIG. 40B

Shattil-537 PCT – FIG. 21A

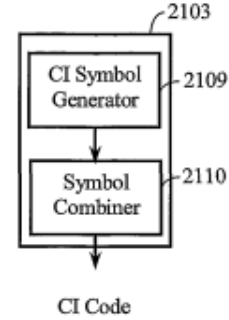


FIG. 21A

'163 Application – FIG. 49

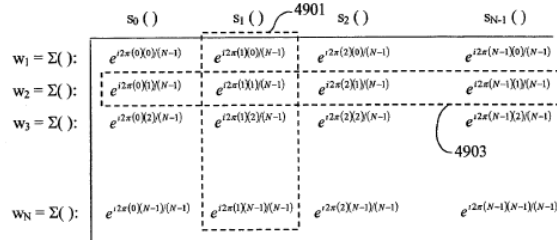


FIG. 49

Shattil-537 PCT – FIG. 22

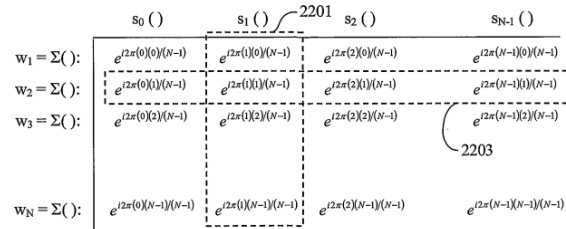


FIG. 22

'163 Application – FIG. 50

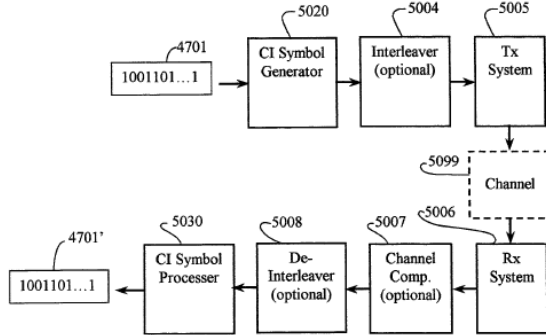


FIG. 50

Shattil-537 PCT – FIG. 23

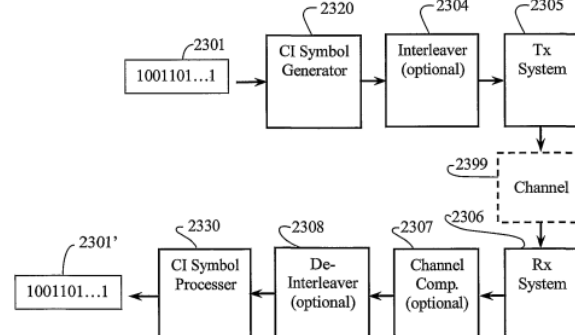


FIG. 23

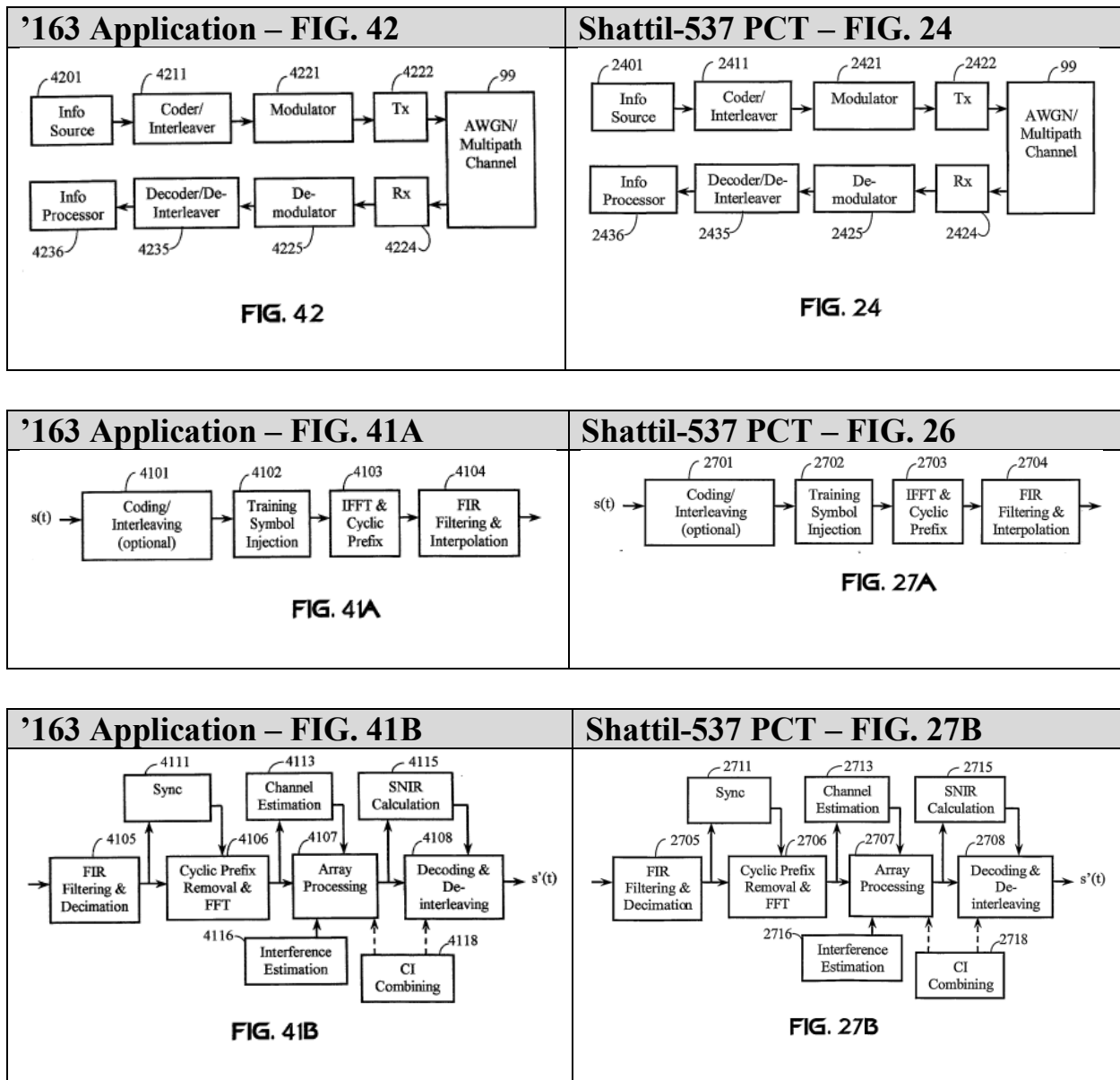
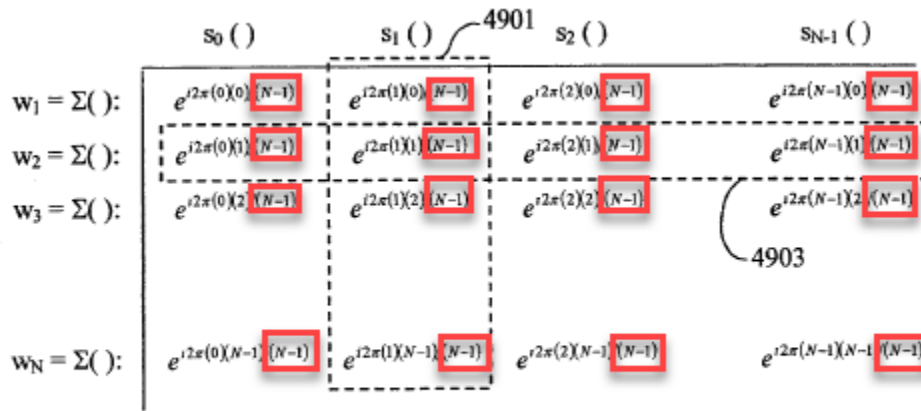


Figure 49 of the '163 Application even copied a typographical error in the denominator of the exponential term in which “N-1” should have been “N.” These typographical errors are identified below and are found in each of the Shattil-537 PCT (FIG. 22) and the '163 Application:

**FIG. 49**

Genghiscomm has sought certificates of correction in recent years to correct this error in some of the patents. EX 1102, p.14; *see also* EX1100, p.7; EX1101, p.12; EX1103, p.3.

Not only were figures and the substance of corresponding descriptions filed in a PCT application, but there are even similarities in what was being claimed between the '163 Application and the Shattil-537 PCT. For example, claim 11 of the '163 Application and claim 24 of the Shattil-537 PCT both claim a "CI code generator" including a "CI symbol generator." And claim 14 of the '163 Application and claim 32 of the Shattil-537 PCT both claim a "CI transmitter" that includes a "CI code generator" and a "CI encoder." Thus, not only did the '163 Application and the Shattil-537 PCT disclose the same invention, they claimed the same subject matter too.

- e. **Mr. Shattil recognized the relationship between the Shattil-537 PCT and the '163 Application in late 2002 but he did not rescind the non-publication request or his certification.**

Mr. Shattil again considered the relationship between the '163 Application and the Shattil-537 PCT in late October 2002. In U.S. Provisional Application No. 60/422,670 (“the '670 Provisional”), Mr. Shattil stated that “[m]ethods and systems used to generate CI codes,” were described in each of the '163 Application, the '854 Application, and PCT/US01/50856 (filed 12/26/2001),” and incorporated those disclosures by reference into the provisional application. EX1164, p.27. Thus, Mr. Shattil still knew about the relationship between the '163 Application and the Shattil-537 PCT in December 2002. Mr. Shattil did not rescind the non-publication request or the certification that he filed in April 2002.

Mr. Shattil would later file U.S. Patent Application No. 10/414,663 claiming the benefit of the '670 Provisional.⁵ Mr. Shattil removed the application number of the '163 Application—perhaps with the hope that it would remain confidential due

⁵ U.S. Patent Application No. 10/414,663 is in yet another branch of the patent family and does not claim the benefit of the same applications as the Challenged Patent or the '163 Application. Citations here are to the patent that issued from that application—U.S. Patent No. 7,317,750. EX1165.

to the nonpublication request and despite the filing of the Shattil-537 PCT.

EX1165, 2:49-51.

Mr. Shattil did not disclose the Shattil-537 PCT in any of the applications in either the original priority claim or in the amended priority claim despite having copied figures and text from it and even though it is at least §102(b) prior art.

f. But for the false non-publication certification, Mr. Shattil could not have changed the priority claim and extended the patent term of the '786 Patent.

If the '163 Application had published “promptly” after it was filed in April 2002—as was the statutory mandate for applications describing inventions that were also filed in PCT applications—and given Mr. Shattil’s declaration stating that everything claimed in the '786 Patent was disclosed in the '163 Application, the publication of the '163 Application would have erected a statutory bar to any application filed more than a year after its publication. Thus, Mr. Shattil would not have been able to amend the priority claim for the '786 Patent the way he did and still be able to claim subject matter that he says was disclosed in the '163 Application because the '163 Application would have been §102(b) anticipatory prior art. But, because he made the false certification that the invention disclosed in the '163 Application had not been filed in a PCT application—and then withheld the publication of the PCT application during prosecution—it did not publish until the '163 Application issued as U.S. Patent No. 7,430,257 on September 30, 2008.

g. The false nonpublication certification has a material impact on the public interest.

If the '786 Patent had issued with its original priority claim, it would have expired in April 2022—twenty years after the '163 Application was filed. But the '786 Patent was filed in 2020—so late in the statutory patent term as to render it of little, if any, value. Mr. Shattil thus benefited from his actions in preventing the '163 Application from publishing by changing the priority claim to claim the benefit of U.S. Patent Application 11/187,107 filed on July 22, 2005. This provided three more years of patent term. Again, if he had not filed a false certification to prevent the '163 Application from publishing, this would have been impossible and the '786 Patent would have expired in 2022.

These actions before the Office were contrary to the public interest because there is a strong public interest in ensuring that the temporal limits of the patent grant are carefully guarded. The Supreme Court has recognized that the “cut-off date” for patent expiration is a critical public policy, as the public has a right to practice the invention freely after enduring the term of exclusivity. *Kimble v. Marvel Entm't, LLC*, 576 U.S. 446, 451 (2015) (“This Court has *carefully guarded* that cut-off date [i.e. patent expiration], just as the patent law’s subject matter limits: In case after case, the Court has *construed those laws to preclude measures that restrict free access to formerly patented*, as well as unpatentable, inventions.”

(emphasis added)); *Sears, Roebuck & Co., v. Stiffel Co.*, 376 U.S. 225, 230 (1964).

By prosecuting the Challenged Patent in this manner, Mr. Shattil has stretched the exclusivity period for an invention he says he conceived of by April 2002, beyond the statutory 20 years, to the detriment of the public. This further demonstrates a compelling public interest in this proceeding and a review by the USPTO of the Challenged Patent.

2. Mr. Shattil and Genghiscomm had no right to the claimed subject matter when the Challenged Patent Application was filed in 2020 because of the 2005 Assignment to Aquity.

Mr. Shattil's approach to patent prosecution has harmed the public interest in another way. Specifically, Genghiscomm had no right to pursue the claims of the Challenged Patent when the application was filed. As explained above, Mr. Shattil's patent applications directed to cooperative networking "CN" describe a different invention related to cooperation between different mobile devices to transmit and receive signals. *Supra* §II.B. Because the subject matter that is claimed in the Challenged Patent is not disclosed in those applications, in May 2016, Mr. Shattil substantially supplemented the specification. The first occurrence of this is found in connection with U.S. Patent Application No. 15/149,382. *See supra* §II.B.

Genghiscomm alleges that the earliest effective filing date of the Challenged Claims is August 2, 2004, despite the substantial reworking of the specification in

2016. Supposedly, an incorporation by reference of U.S. Patent Application Publication Nos. 2004/0086027 (U.S. Patent Application No. 10/414,663) and 2003/0147655 (U.S. Patent Application No. 10/360,346) was relied upon for the substantial modification of the specification. EX1022 ('187 Provisional), pp.16, 42. Mr. Shattil assigned away all rights in the subject matter of these applications in a 2005 transaction with Aquity LLC.

Specifically, on December 19, 2005, Mr. Shattil executed an assignment transferring all rights in the applications resulting in the two incorporated patent applications and in subject matter disclosed therein to Aquity LLC. EX1119. The assignment expressly conveyed:

all of Assignor's right, title and interest in and to the Patent Applications and any patents that may issue therefrom, including any foreign counterparts, divisions, continuations, or reissues of such patents, the same to be held by Assignee for Assignee's own use and enjoyment, and for the use and enjoyment of Assignee's successors, assigns, and other legal representatives, as fully and entirely as the same would have been held and enjoyed by Assignors if this Assignment and sale had not been made

....

EX1119, p.3. This assignment covered the U.S. Patent Application Publications No. 2004/0086027 (U.S. Patent Application No. 10/414,663) and 2003/0147655

(U.S. Patent Application No. 10/360,346) that allegedly provide the description for what is now being claimed in the '786 Patent:

Unified Multi-carrier Framework for Multiple-Access Technologies	7-Feb-03	10/360,346		US
Orthogonal Superposition Coding for Direct-Sequence Communications	16-Apr-03	10/414,663		US

EX1119, p.7.

As a result of this assignment, Aquity stood in Mr. Shattil's shoes and acquired all rights to the subject matter in these patent applications—including the right to pursue claims or dedicate the subject matter to the public.⁶ Mr. Shattil had thus conveyed all rights to the inventions disclosed in those applications to a third party and no longer had the right to claim the subject matter as his own.

⁶ On May 10, 2007, Aquity LLC assigned each of the above-identified applications and patents to Lot 41 Acquisition Foundation, LLC. EX1118. There have been numerous assignments and transfers of rights in the patents and applications assigned to Aquity since 2005. However, there are no assignments of record showing that Mr. Shattil or Genghiscomm had a property interest in the subject matter of the patents resulting from these two patent application publications when the Challenged Patent was filed or when it issued.

Nevertheless, in May 2016, in apparent reliance on the incorporation by reference of these applications into U.S. Provisional Application 60/598,187 and nonprovisional 11/187,107, Mr. Shattil amended the specification to pull in subject matter from the two assigned applications in an apparent attempt to support patent claims including those of the Challenged Patent. In other words, Mr. Shattil filed the application for the Challenged Patent claiming subject matter Mr. Shattil believes was described in an application he assigned away and prosecuted it on behalf of Genghiscomm. EX1001, cover.

Despite the 2005 assignment, Mr. Shattil identified Genghiscomm Holdings, LLC as the Applicant and assignee on the Application Data Sheet per 37 C.F.R. § 1.76. EX1066, p.60. Mr. Shattil's declaration submitted in the application for the Challenged Patent indicates that he believed he invented "a claimed invention in the application," thus showing that Mr. Shattil knew what he was claiming an exclusive right in. EX1166, p.1. In other words, although Mr. Shattil had already been paid to assign away the applications on which he apparently relies on for written description support but he claimed that same subject matter for Genghiscomm in 2020.⁷

⁷ It appears based on USPTO records, however, that Genghiscomm had acquired rights in the patent resulting from the '163 Application in 2018.

None of this was disclosed to the Office during prosecution. *See* EX1001; EX1066. Under the Office’s regulations, the assignee is entitled to prosecute an application “to the exclusion of the inventor or previous applicant or patent owner.” 37 C.F.R. § 3.71(a). The original applicant is presumed to own an application “unless there is an assignment.” *Id.* at § 3.73(a). For continuing and provisional applications, an assignment of a parent application is effective for child applications, and in the case of continuations-in-part, the assignee has rights to “subject matter common to” the assigned applications.⁸ *See* M.P.E.P. §§ 306, 306.1.

⁸ In connection with a petition to accept an intentionally delayed priority claim in U.S. Patent Application No. 13/116,984, Mr. Shattil has stated that “Applicant Steve Shattil, who is the sole inventor of ‘917, had retained the right to file continuation-in-part applications that claim priority to ‘917.” EX1092, p.32. The assignment he made included no such reservation. But even if Mr. Shattil did maintain the right to pursue claims directed to improvements in CIP applications, nothing gave him the right to claim exclusive rights in subject matter that he says is fully disclosed in patents and/or patent applications that he assigned away all of his right, title, and interest in. *See* M.P.E.P. 306 (in a CIP “the assignment recorded

Neither Mr. Shattil nor Genghiscomm had an ownership interest in U.S. Patent Application Publications No. 2004/0086027 or 2003/0147655 when the Challenged Patent was applied for in 2020; those rights belonged to Aquity or its successors under the 2005 assignment. Accordingly, the application for the Challenged Patent should never have been filed and efforts to draft and obtain patent claims directed to subject matter that had been assigned away detracted from the assignment Mr. Shattil made in 2005. Genghiscomm cannot claim settled expectations in a patent it had no right to pursue.

3. Mr. Shattil and Genghiscomm improperly claimed subject matter that was dedicated to the public by the assignee of that subject matter to the detriment of the public and Petitioner.

As explained earlier, none of Mr. Shattil's cooperative networking ("CN") patent applications provided adequate written description for the claimed subject matter of the Challenged Patent. This led Mr. Shattil to substantially supplement the disclosure in parent patent application No. 15/149,382 apparently relying on the incorporation of U.S. Patent Application Publications No. 2004/0086027 (U.S.

against the original application gives the assignee rights to ... the subject matter common to both applications").

Patent Application No. 10/414,663) and/or 2003/0147655 (U.S. Patent Application No. 10/360,346).

Mr. Shattil's and Genghiscomm's actions in pursuing subject matter supposedly disclosed in U.S. Patent Application Publications No. 2004/0086027 and 2003/0147655 is detrimental to the public interest. One of the central goals of the patent system is to properly restrict the exclusive rights or "public franchise" granted by a patent to ensure they remain within their legitimate scope. As the Supreme Court has explained:

A patent by its very nature is affected with a public interest. As recognized by the Constitution, it is a special privilege designed to serve the public purpose of promoting the "Progress of Science and useful Arts." At the same time, a patent is an exception to the general rule against monopolies and to the right to access to a free and open market. The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope.

Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co., 324 U.S. 806, 816-17 (1945) (emphasis added); *see also* 37 C.F.R. § 1.56(a) ("A patent by its nature is affected with a public interest.")

Here, the public interest has been even further undermined by Mr. Shattil's and Genghiscomm's actions in obtaining claims to subject matter that, by the choice of their assignee or the assignee's successors, had entered the public domain long before for the Challenged Patent was filed. Specifically, as reflected in Patent Center data, the two patent application publications allegedly incorporated by reference into the '187 Provisional and '107 Application were the last applications filed in their respective parts of the extended patent family. EX1168, EX1169, EX1170, EX1171. No application was filed claiming the benefit of either application before they issued in 2008. EX1169, EX1171. No broadening reissue was filed either. *Id.*

By choosing not to file a continuation or reissue application based on these applications, the rightful owner of the subject matter disclosed therein allowed the disclosed subject matter to pass into the public domain. It is well-established that subject matter disclosed but not claimed in a patent is dedicated to the public—and the public is free to practice it. *See, e.g., Deering v. Winona Harvester Works*, 155 U.S. 286, 296 (1894) (“[I]f he described and claimed only a part of his invention, he is presumed to have abandoned the residue to the public.”); *Edward Miller & Co. v. Bridgeport Brass Co.*, 104 U.S. 350, 352 (1881) (The “omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed.”); *Unique Concepts v. Brown*,

939 F.2d 1558, 1562-63 (Fed. Cir. 1991) (“[S]ubject matter disclosed but not claimed in a patent application is dedicated to the public.”); *Envtl. Instruments v. Sutron Corp.*, 877 F.2d 1561, 1564 (Fed. Cir. 1989) (“The disclosure of a patent is in the public domain save as the claims forbid.”); *In re Terres*, 150 F.2d 711, 714 (C.C.P.A. 1945) (any unclaimed subject matter “has been dedicated under a presumption of law to the use and benefit of the public”); *cf. Technograph Printed Circuits, Ltd. v. United States*, 370 F.2d 571, 575 (Ct. Cl. 1966) (“If the applicant fails to file divisional applications claiming the inventions disclosed but not claimed . . . then the unclaimed inventions are dedicated to the public.”).

Despite this, in starting in 2016, Mr. Shattil amended the disclosure of the cooperative networking portion of the extended patent family to include subject matter that was allegedly described in the assigned patent applications, and then started claiming exclusive rights in intellectual property it did not own. This approach to patent prosecution undermines the public notice function of patents and frustrates the clarity that the patent system is designed to provide.

Not only was the filing of the Challenged Patent in disregard to Mr. Shattil’s 2005 assignment to Aquity, it also withdraws from the storehouse of public knowledge. The Challenged Claims recite subject matter that, by law, was dedicated to the public when the portion of the patent family that allegedly provides written description support for the claims was closed. The public’s

interest strongly favors restoring the public right to practice this subject matter free and clear of the Challenged Patent or any claim for damages that may be brought thereunder.

Genghiscomm cannot claim settled expectations or entitlement to a patent right it never owned. In *Intel Corp. v. Proxense LLC*, the Director noted that “[t]here may be persuasive reasons why the Board should review challenged claims several years after their issuance date,” including that “a patent may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner’s particular technology space, if at all.” *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12, 2-3 (PTAB June 26, 2025). Along the line of *Intel* and under these particular facts, there can be no settled expectation by Genghiscomm in the Challenged Patent because Mr. Shattil resurrected matter from a “closed” patent family that had been dedicated to the public by his own assignee (or that assignee’s successor) after he was compensated to part ways with those rights in the 2005 assignments.

This further shows that there is a compelling public interest in reviewing the grant of the Challenged Patent in this proceeding.

4. Mr. Shattil and Genghiscomm have misused micro entity status to the detriment of the USPTO and its user community.

Policy considerations strongly favor review of the Challenged Patent because Mr. Shattil and Genghiscomm repeatedly misused micro entity status, directly harming the Office and its user community through disproportionately increased financial obligations. This misuse should weigh heavily against discretionary denial of this Petition.

The Challenged Patent claims priority to U.S. Patent Application No. 11/187,107 (“the ’107 Application”). On July 19, 2013, Mr. Shattil certified that the applicant qualified for micro entity status on a gross income basis. EX1135, p.1. He specifically certified:

Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor ***on more than four previously filed U.S. patent applications***, excluding provisional applications and international applications under the Patent Cooperation Treaty (PCT) for which the basic national fee under 37 CFR 1.492(a) was not paid, and also excluding patent applications for which the applicant has assigned all ownership rights or is obligated to assign all ownership rights as a result of the applicant’s previous employment.

EX1135, p.1 (emphasis added).

After this certification, Mr. Shattil paid reduced micro entity fees for an information disclosure statement under 37 C.F.R. § 1.17(p), *id.*, p.3, the issue fee for the '107 Application, EX1136, and, as recently as 2021, the 8th year maintenance fee, EX1149.⁹

As the Office recently explained:

The USPTO is a fully fee-funded agency. When entities ineligible for the small or micro entity status fee reductions pay fees in an unentitled reduced amount, they take *improper advantage* of the fees paid by other entities. Fee

⁹ An exception to the five-application limit exists for inventions that must be assigned or which are in fact assigned to employers. *See* M.P.E.P. § 509.04. But Mr. Shattil assigned numerous patents and patent applications to Aquity which was not his employer. EX1117; EX1119; EX1137. The list of assigned patent applications includes more than five patent applications. EX1119, pp.6-8. “All such applications naming the inventor or joint inventor are counted toward the application filing limit, whether the applications were filed before, on, or after March 19, 2013. Further it does not matter whether the previously filed applications are pending, patented, or abandoned; they are all still included when counting to determine whether the application filing limit has been reached.” M.P.E.P. § 509.04(a)I.B (Mar. 2014).

payments made in an unentitled reduced amount ***result in revenue loss for the USPTO***, which is required to set fees to recover aggregate costs. ***Entities paying fees in unentitled reduced amounts result in the fees for all applicants being reset higher to offset this revenue loss.***

See Statutory Penalties for False Assertions or Certifications of Small or Micro Entity Status, 1536 O.G. 204 (Jul. 8, 2025) (emphasis added). Mr. Shattil and Genghiscomm’s actions thus deprive the USPTO and its users of fees.¹⁰

The submission of these micro entity certifications was not an oversight. For example, during prosecution of a parent to the Challenged Patent, Mr. Shattil’s

¹⁰ There are other examples of Mr. Shattil’s actions depriving the USPTO of fees. For example, in two information disclosure statements filed in two separate patent applications on February 2, 2017 Mr. Shattil certified that “no item of information contained in the information disclosure statement was known to” him “more than three months prior to the filing of the information disclosure statement” under 37 C.F.R. § 1.97(e)(2). EX1176, EX1177. At least one of the references on the IDS was known to Mr. Shattil—U.S. Patent Application Publication No. 2004/0100897. Mr. Shattil is the named inventor on it, and he filed the application in 2003—fourteen years before he certified he had not seen it more than three months before he filed the IDS in 2017. EX1178, cover.

micro entity certification was accompanied by an information disclosure statement referencing prosecution documents from two of Mr. Shattil's other patent applications. EX1135, p.15. One of those applications—U.S. Patent Application No. 10/145,854 incorporated many more patent applications naming Mr. Shattil as inventor. E.g., EX1023, pp.233-236. Mr. Shattil filed numerous micro entity certifications across a large patent family, as shown non-exhaustively in the table below.

	Application (Patent)	Exhibit(s)
1	11/187,107 (U.S. Pat. 8,670,390)	EX1135, EX1136, EX1149
2	12/545,572 (U.S. Pat. 8,750,264)	EX1143
3	13/036,171 (Abandoned)	EX1144
4	13/116,984 (U.S. Pat. 10,014,882)	EX1145; EX1146
5	14/275,161 (U.S. Pat. 9,042,333)	EX1142, EX1147, EX1148

It is hard to imagine that Mr. Shattil was unaware of his ineligibility for micro entity status given that he is a self-proclaimed inventor on over 150 patent applications and is a registered U.S. patent agent. EX1137. He has sophisticated knowledge and an obligation to practice completely before the Office.

In sum, Mr. Shattil and Genghiscomm sought reduced fees for their own financial gain, to the detriment of the USPTO and the integrity of the patent system. This pattern of misuse undermines fairness for all applicants and should weigh decisively against discretionary denial of this Petition.

5. Mr. Shattil and Genghiscomm failed to disclose the public funding used in the conception of the claimed subject matter, undermining any settled expectations in the Challenged Patent.

Another compelling reason to grant review of the Challenged Patent is that Mr. Shattil and Genghiscomm failed to disclose the use of federal funding in the conception of the claimed inventions, as required by law. This undercuts any argument that Genghiscomm has “settled expectations” in its continued ownership of the patent.

The Bayh-Dole Act imposes a clear “obligation” on contractors: any patent application on an invention made with federal support¹¹ must include a statement in “the specification “specifying that the invention was made with Government

¹¹ Under the standard patent rights clauses found in 37 C.F.R. § 401.14 these requirements pertain to “subject inventions” which include “any invention of the contractor *conceived or first actually reduced the practice in the performance of work under*” the contract.

support and that the Government has certain rights in the invention.” 35 U.S.C. § 202(c)(6); 37 C.F.R. § 401.14(f)(4). Failure to disclose such support can result in the government obtaining title to the invention. 35 U.S.C. § 202(c)(1); see also 37 C.F.R. § 401.14(d)(1)(i).

The subject matter of the Challenged Claims was conceived with the benefit of public funding based on statements Mr. Shattil made in other parts of his patent family, yet this fact was not disclosed in the Challenged Patents or relatives (or any non-provisional application that Petitioner has identified). On October 31, 2002, Mr. Shattil filed U.S. Provisional Application No. 60/422,670. EX1111, p.11. This filing included a proposal explicitly stating that:¹²

While Idris [¹³] performed work on an SBIR awarded by NASA Ames Research Center, it was discovered that CI provides performance improvements to all types of wireless communications and facilitates dynamic spectrum allocation. In particular, performance

¹² *Id.*, pp.57-72 (The document is not complete. For instance, it appears to be missing a cover page and it cites to reference materials that are not included).

¹³ Idris refers to another of Mr. Shattil’s companies, Idris Communications, Inc. EX1112. Idris was dissolved September 23, 2004 and reinstated on February 24, 2023. EX1113.

improvements to wireless LAN offered Idris a unique business opportunity, resulting in the spin-off of a new company, CIAN Systems [¹⁴], to commercialize CI technology for wireless LAN markets.

Id. at 69. The same document also describes Idris’s ongoing work for the Air Force and NASA Ames Research Center and confirms a focus on applying CI technology to defense and emergency service systems. *Id.* at 70, 72 (“Idris communications has been and is presently under contract with the Air Force to examine the deployment of CI in various environments.”). The SBIR award is also referenced on Idris’s website as of May 17, 2001.¹⁵ EX1114.

¹⁴ Mr. Shattil was a Director and Vice President of CIAN Systems. EX1115, p.1.

¹⁵ The ’670 Provisional admits that the application of CI to “all types of wireless communications” and its ability to allow “dynamic spectrum allocation” was discovered under a federal contract (an “SBIR awarded by NASA Ames Research Center”), thus making the application of CI to “all types of wireless communications” and its ability to perform “dynamic spectrum allocation” a “subject invention” under the standard patent provisions found in government contracts because it was conceived of using public funds. See 37 C.F.R. § 401.14(d)(1)(i).

A further website crawl from December 19, 2001, confirms that research on CI was “sponsored by NASA” and that the technology was developed under federally funded research.¹⁶ Additional journal publications further reflect public funding used in connection with research on carrier interferometry. For instance, an IEEE article co-authored by Mr. Shattil reports that the research it describes called was supported by “NSF grant ECS 9988665 “Ultra-Wideband Wireless Communication from Emerging Multiple Access Technology.” EX1126, p.G-11.

These materials establish that the subject matter claimed in the Challenged Patent—which is directed to using what Mr. Shattil called “Carrier Interferometry”

¹⁶ That website stated:

During the past three years, CI was presented in over 40 technical publications and 30 conferences. ***This research, sponsored by NASA, revealed that when CI is applied as a common platform for wireless networking***, it simultaneously provides the following benefits: . . . Adapts to any communications protocol or standard (FHSS, DSSS, ***OFDM***) . . . Uses inexpensive mainstream manufacturing processes . . . Extends battery life or increases range via improved performance

EX1116, pp.1-2.

in OFDM¹⁷—is a “subject invention” under the Bayh-Dole Act and its implementing regulations because it was conceived of, or first actually reduced to practice, with the benefit of federal funding. Because Genghiscomm and Mr. Shattil failed to disclose the use of public funds, the government retains the right to claim title to the invention, diminishing any settled expectations that Genghiscomm may have in the Challenged Patent and tipping the scales against a discretionary denial.

6. Mr. Shattil’s prosecution tactics caused the Office to improperly issue a patent a decade after abandonment.

Another factor favoring review of the Challenged Patent is that Mr. Shattil’s approach to patent prosecution in the patent family resulted in the USPTO improperly issuing a patent on the parent to the ’107 Application—the ’854 Application¹⁸—nearly a decade after it was abandoned. The ’854 Application went

¹⁷ According to an archived Wikipedia entry as modified in December 2015, Carrier Interferometry (“CI”) as allegedly “adopted in the uplink” for 4G LTE. EX1172, p.1. And, Genghiscomm is alleging that the claimed subject matter reads on the 4G uplink. EX1074, p.3.

¹⁸ The ’107 Application claimed the benefit of the ’854 application and U.S. Patent Application No. 09/718,851. EX1021, p.7.

abandoned on May 27, 2009, when Mr. Shattil failed to timely pay the issue fee.

EX1138, p.38. Soon thereafter, Mr. Shattil petitioned to withdraw the

abandonment, *id.*, pp.33-35, but the Office denied the petition in June 2010.

Although the Office provided clear guidance on alternative avenues for revival,

Mr. Shattil did not pursue them. *Id.*, pp.31-32.

Nearly ten years later, Mr. Shattil filed a new petition to revive the '854 Application. *Id.*, pp.22-27. In it, he checked the box stating that “[t]he entire delay in filing the required reply . . . was unintentional.” *Id.*, p.23. Yet Mr. Shattil offered no explanation for how the issue fee and petition filing could have been “unintentionally” overlooked for nearly a decade.

Although the petition to revive was initially granted electronically, the unusual circumstances caught the Office’s attention and the decision was vacated. EX1138, pp.19-21. The Office then gave Mr. Shattil two months to explain the extensive delay and respond to specific concerns. *Id.*, p.21. No response was ever submitted.

Despite these red flags, on June 20, 2020, the Office issued U.S. Patent No. 10,673,758. *Id.*, p.17. Just three months later, Mr. Shattil requested a certificate of correction for the erroneously issued patent. *Id.*, pp.8-11. By this point, Mr. Shattil had been told expressly that the patent should not have been granted. The request for correction again alerted the Office, and the Office of Petitions determined that

the patent was “erroneously issued.” The Office announced it would publish an errata in the Official Gazette clarifying that no patent had been granted. EX1138, p.3.

This sequence of events illustrates a pattern of gamesmanship and procedural manipulation of the U.S. patent system and the Office by Mr. Shattil, further complicating and obscuring the prosecution history of this patent family. These tactics not only undermine the integrity of the U.S. patent system but have imposed significant, unnecessary costs and complexity on those seeking to analyze or challenge these patents—including Petitioner.

The extraordinary actions that led to the issuance of a patent a decade after abandonment just underscores that the public interest is served by moving the present challenge forward before the USPTO. The integrity of the patent system should not be compromised by the cavalier approach to patent prosecution exhibited in this extensive patent family. The Office’s job is hard enough without such tactics and that is why it relies on the good faith and candor of the members of its bar. In this particular patent family there has been a pattern of failures that warrant taking up the present challenges in the public interest.

C. The Large Number and Complex Nature of the Patents at Issue Favor Review by the Board.

Director Stewart has determined that disputes involving a large number of complex patents weigh heavily in favor of institution and review by the Board. In *Tesla, Inc. v. Intellectual Ventures II LLC*, Director Stewart expressly denied a request for discretionary denial, emphasizing the “large number and vast scope of the patents asserted,” even though the district court “trial date precedes the projected final written decision due date, and there is insufficient evidence the district court is likely to stay its proceeding even if the Board were to institute trial.” *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00221, Paper 10, 2-3 (June 13, 2025). Director Stewart noted that “Petitioner’s arguments regarding the complex and diverse litigation proceeding tip the balance against discretionary denial” and specifically observed that “the Board is better suited to review a large number of patents involving diverse subject matter.” *Id.*

This reasoning applies with even greater force here. Genghiscomm has accused SEA of infringing nine separate patents, spanning several technologies and two cellular standards. These patents are being asserted against 4G LTE and 5G standards—including mobile devices and 5G “gNodeB” network equipment. These patents have diverse expiration dates and thus are being asserted at different products depending on the patent.

Pat.	Earliest Claimed Priority	Alleged Reduction to Practice	# Figs.	Spec. Cols.	# docs inc. by reference.
'842	5/14/02	11/2/99	48	79	~ 25
'227	5/14/02	11/2/99	48	79	~ 25
'568	5/14/02	11/2/99	47	43	~47
'786	8/4/04	4/24/02	236	157	~ 58
'508	8/4/04	4/24/02	19	54	~ 27
'005	8/4/04	4/16/03	19	54	~ 24
'285	8/4/04	2/7/03	70	76	~ 17
'792	1/8/07	4/24/02	37	66	~ 11
'386	8/4/04	Unknown	70	75	~ 17

The Board, as the agency that granted these patents, is best equipped to address the technical and procedural challenges posed by such a large and diverse patent family. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00221, Paper 10, at 3 (“the Board is better suited to review a large number of patents”). As in *Tesla*, “the complex and diverse litigation proceeding tip the balance against discretionary denial.” *Id.* at 2-3.

D. The Petition is Appropriately Supported by Expert Testimony.

Genghiscomm argues that Samsung’s Petition relies too heavily on the Declaration of Harry V. Bims. Request, 15-18. But there is nothing excessive or inappropriate about the Petition’s reliance on Dr. Bims’ expert testimony. On the

contrary, Samsung’s approach is fully consistent with Director’s Stewart’s guidance regarding the use of expert evidence in Board proceedings.

1. Samsung’s Petition Does Not Inappropriately Rely on Expert Testimony.

The Petition’s primary unpatentability arguments are based on the explicit teachings of the prior art, which themselves clearly meet the challenged claims. Most of the Petition’s citations to Dr. Bims’ declaration simply demonstrate that Dr. Bims independently agrees with and confirms the Petition’s analysis of the prior art. That is fundamentally different from the Petition relying on expert testimony in lieu of clear documentary evidence.

Where expert testimony is provided, it serves to offer “provide helpful context or to explain terms of art” for the Board—exactly as contemplated by Board guidance. Every aspect of Dr. Bims’ testimony is meticulously corroborated by citations to prior-art patents or printed publications. This approach aligns with the USPTO’s “FAQs for Interim Processes for PTAB Workload Management” (“Interim-Processes FAQs”), FAQ #21, which emphasizes the value of expert declarations supported by evidence. Similarly, Board decisions have “applauded” expert testimony that is corroborated by extensive citation to published references. *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00032, Paper 11 at 39 (May 19, 2025).

2. The Petition’s Reliance on Expert Testimony Comports With the Director’s Guidance on Proper Use of Expert Testimony.

The Petition’s use of expert testimony fully aligns with the standards articulated by the Director regarding proper reliance on expert declarations. In *iRhythm Technologies v. Welch Allyn Inc.*, the Director confirmed it is appropriate for a petitioner to rely on expert testimony “to explain the background knowledge of a person of ordinary skill in the art, and the expert provides citations to evidence in support of his statements in the required manner.” *iRhythm Technologies v. Welch Allyn Inc.*, IPR2025-00363, at 2-3 (PTAB June 6, 2025).

Samsung’s Petition follows this guidance precisely. Dr. Bims explains what a person of ordinary skill in the art would have understood at the relevant time and substantiates his opinions with cites to supporting evidence. *See e.g.*, EX1002, ¶¶57, 64, 67-69, 97, 105, 122-123. For example, Dr. Bims references to the Dowling patent (EX1042) to support his statement that transmitters could be implemented in hardware or software. EX1002, ¶122 (citing EX1042-Dowling, 3:46-50; 5:66-6:1 (disclosing that the transmitter, receiver, and precoder may be implemented in hardware or software”); 21:62-64 (disclosing that the “present invention” is applicable to FFT based multicarrier modulation and OFDM systems). Dr. Bims also explains the mathematical reality that a “Hermitian” as disclosed in the prior art is a complex conjugate with citations to evidence proving

as much. EX1002, ¶97 (citing EX1075, EX1077). Accordingly, Petitioner properly relied upon expert testimony.

E. Adjudication By the Board Would Be Efficient, as No Other Forum, Despite Many Lawsuits, Has Adjudicated the Merits of the Challenged Patent.

Despite numerous lawsuits, neither the PTAB nor any other forum has adjudicated the validity or patentability of the Challenged Patent. Since it issued, Genghiscomm has asserted the patent in at least eight lawsuits in four different district courts: the Eastern District of Texas, the Western District of Texas, the Southern District of California, and the Northern District of California. Although many of Genghiscomm's lawsuits have settled, Genghiscomm's repeated assertions and its claim that the patents cover cellular standards indicate a strong likelihood that it will sue additional defendants.

This situation is analogous to *Berkshire Hathaway Energy Company et al v. Birchtech Corp.*, where the Director denied a request for discretionary denial, finding that “[b]ecause the litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient.” IPR2025-00274, Paper 23, at 2 (PTAB July 2, 2025). Here, adjudication of the validity of the Challenged Patents would be efficiently and effectively conducted before the Board.

F. The Petition Provides a Compelling Challenge to Patentability.

Samsung's Petition raises four well-supported grounds challenging 18 claims of the '786 Patent. Pet., 8-9. As detailed in the Petition, these grounds provide a strong and persuasive challenge to the patentability of the challenged claims. *Id.*

Ground 1 relies upon Dirk Galda & Hermann Rohling, *A Low Complexity Transmitter Structure for OFDM-FDMA Uplink Systems*, Vehicular Technology Conference, IEEE 55th Vehicular Technology Conference, vol. 4, pp.1737-1741 (May 6, 2002) ("Galda") and Karsten Brüninghaus & Herman Rohling, *Multi-carrier spread spectrum and its relationship to single-carrier transmission*, Vehicular Technology Conference. IEEE 48th Vehicular Technology Conference, vol. 3, pp.2329-2332 (May 18-21, 1998) ("Brüninghaus"), both of which predate the earliest claimed effective filing date of the '786 Patent. Pet., 18-36. Neither Galda nor Brüninghaus were before the examiner when the decision to issue the '786 Patent was made. Indeed, Brüninghaus is added for the limited purpose of showing that it was common to use complex-conjugate codes to encode and decode DFT-spread data symbols. Pet. 30-32.

Ground 2 relies on an additional reference—Dowling—for the basic proposition that implementation in hardware or software was known to those skilled in the art and obvious variations. Pet., 36-46.

Genghiscomm’s argument that its position is strong and the Petition is weak underscores the complexity of the issues presented and the very reason that it would be more efficient to pursue this matter before the Board. Specifically, Genghiscomm argues that because Galda was published in May 2002, and Dowling was published in July 2003, it can swear behind both references. Genghiscomm Br., 15 (stating that the “challenge based on [these] references after that date must fail”). But both of these references are statutory bars that cannot be antedated because the earliest claimed effective filing date is August 2, 2004. *See* M.P.E.P. § 715 II (“Situations where 37 C.F.R. 1.131(a) Affidavits are Inappropriate”: “(B) Where the reference publication date is more than 1 year prior to the effective filing date of applicant’s or patent owner’s claimed invention. Such a reference is a ‘statutory bar’ under pre-AIA 35 U.S.C. 102(b) as referenced in 37 CFR 1.131(a)(2).”). This shows that the Board is better suited to resolve and quickly dispatch of these issues rather than adjudicating sundry unmeritorious positions across nine patents before the district court.

G. The *Fintiv* Factors Do Not Support Discretionary Denial.

In addition to the Stewart Memo factors analyzed above, the *Fintiv* factors also weigh against discretionary denial of institution.

1. Factor 1 (Stay): SEA Will Renew Its Motion For A Stay If the Board Institutes IPR.

Under *Fintiv*, this factor weighs against discretionary denial in cases where there is no stay but “the district court has denied a motion for stay without prejudice and indicated to the parties that it will consider a renewed motion . . . to stay if a PTAB trial is instituted.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6-7 (PTAB Mar. 20, 2020) (precedential).

SEA will seek a stay of co-pending litigation if the Board institutes IPR. The Eastern District of Texas has granted stays in similar circumstances where the case has “not reached such an advanced stage that it would weigh against a stay.” *Broadphone LLC v. Samsung Elecs. Co., Ltd.*, 2024 WL 3524022, at *2-3 (E.D. Tex. July 24, 2024) (granting stay where a “significant amount of discovery remains, the claim construction hearing has not occurred, and trial is currently set for [over six months later]”). Here, the statutory deadline for the Board’s institution decision is November 7, 2025. Assuming the decision is released shortly before the statutory deadline, the decision will be released around the same time as the Markman hearing, which is scheduled for October 21, 2025. EX1046, p.3. Moreover, because Genghiscomm has just added 22 new claims to the case this month, SEA has moved the Court to modify the *Markman* date to mitigate the

prejudice to SEA caused by the amendment of the contentions. Thus, there is no guarantee that the current schedule will remain in place.

2. Factor 2 (Trial Date): The District Court’s trial date is uncertain and seven trials are currently scheduled for the same date.

Fintiv Factor 2 looks to “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Id.* Factor 2 is at worst neutral because of the uncertainty surrounding Judge Schroeder’s availability to oversee the trial involving the Challenged Patent as scheduled given the numerous trials scheduled on that same date and the fact that he borrows the courtroom in Marshall, Texas from Judge Gilstrap because Judge Schroder is typically in Texarkana, Texas. Thus, trial will likely occur during one of Judge Schroder’s infrequent sittings in Marshall, of which there are only four currently scheduled in 2026.

A jury trial is currently scheduled before Judge Schroeder on April 20, 2026. EX1046, p.1. When this Petition was filed, there were four trials scheduled in Marshall before Judge Schroeder for that date. See EX1061, p.1; EX1062, p.1; EX1063, p.1; EX1064, p.5 (resetting trial to 4/20/2026). Genghiscomm contends that the concern of having multiple trials on the same date is “no longer present.” Genghiscomm Br. at 6. That is not correct. As of the date of the filing of this brief, Judge Schroder has seven cases scheduled for trial on April 20, 2026:

1. *Video Solutions Pte. Ltd. v. Cisco Systems, Inc.*, No. 2:23-cv-00222-RWS-RSP;
2. *Aspen Networks, Inc. v. AT&T Inc., et al.*, No. 2:23-cv-00476-RWS-RSP;
3. *InnoMemory, LLC v. Truist Financial Corp.*, No. 2:24-cv-00146-RWS-RSP;
4. *Genghiscomm Holdings, LLC v. Samsung Electronics America, Inc.*, No. 2:24-cv-00242;
5. *WSOU Investments, LLC v. Cisco Systems, Inc.*, No. 2:24-cv-00332-RWS-RSP;
6. *Husky Injection Molding Systems Ltd. v. Ningbo AO Shen Mold Co., Ltd.*, No. 24-cv-00348-RWS-RSP; and
7. *Jensen v. Hunt Transportation, Inc.*, 25-cv-00424-RWS-RSP.

EX1162, pp.7-10. Two of these cases were filed in 2023—the year before the action in the parallel proceeding was filed. One of them—the *Aspen Networks* case—was just added to Judge Schroder’s trial calendar for April 2026 in May, thus showing that Judge Schroder’s trial schedule is in flux. And, because Genghiscomm was just allowed to assert 22 new claims in the litigation, SEA is moving the Court to push the litigation over the Challenged Patent to Judge Schroder’s October 2026 trial date.

Accordingly, at this time there are three cases that would be called before the first litigation between Genghiscomm and SEA is called. While Genghiscomm says that the *Innomemory* case has “been dismissed or closed and will not go to trial,” Genghiscomm Br., p.6, Genghiscomm appears to overlook the consolidation order and Capital One’s continued litigation of the case. EX1163. That case has not resolved.

“[T]he Board may consider any evidence that the parties make of record that bears on the proximity of the district court’s trial date.” EX1060, p.2. Because Judge Schroeder cannot simultaneously try multiple patent cases and the case involving the Challenged Patent is currently fourth on the Court’s schedule, it is speculative to assume that the trial date will hold. And, if it does not, Judge Schroder currently has only two remaining sittings in Marshall in 2026. Thus, at the very least, this factor is neutral or at least slightly weighs against exercising discretion to deny the Petition. *Boe Tech. Grp. Co. v. Optronic Scis. LLC*, IPR2024-01130, 2025 WL 305477, at *4 (PTAB. Jan. 27, 2025) (*Fintiv* factor 2 “neutral or weigh[s] slightly in favor of not exercising discretion” where district court “set 10 cases for jury selection on the same day”).

Even assuming that the April 2026 date were to hold and the Final Written Decision (“FWD”) may come after the trial date this is not an impediment to institution of IPR. The Board has instituted trial based on many of factors present

here, such as diligence in filing the petition, a stipulation not to pursue the asserted grounds in litigation, minimal investment in litigation, and the merits of the challenge were strong. *Lego Sys., Inc. v. Mq Gaming LLC*, No. IPR2020-01445, 2021 WL 606917, at *8 (finding jury trial “five months before a final written decision” outweighed by “low” “investment by the court and parties in the [parallel case] on” common issues, Petitioner’s Sotera stipulation, and strong merits to the challenge); *Verizon Business Network Services, Inc. v. Huawei Techs. Co.*, IPR2020-01141, Paper 12 (PTAB Jan. 14, 2021).

When considering the complexity of the analysis that needed to be undertaken to evaluate the extensive patent thicket created by Mr. Shattil, Petitioner was diligent in preparing and filing the nine IPR petitions against the Genghiscomm patents. The way Patent Owner structured its patent families, shifted patent disclosures from one portion of the patent family to another, and, at times, incorporated dozens of patents and publications by reference, placed a significant burden on Petitioner to assess its positions. *Supra* § II(B); III.B.

The complexity presented by this, and the eight other IPR petitions Petitioner has filed, weigh strongly in favor of institution. *Apple, Inc. v. SEVEN Networks, LLC*, IPR2020-00156, Paper 10 at 21-22 (PTAB June 15, 2020) (“complexity of multiple patents and issues in the District Court Action” favored institution). Certainly the time required to analyze the patent family and prepare

the petitions should not be counted against Petitioner on these facts. Otherwise, Patent Owners will be incentivized to muddle the public record on patents to the detriment of the just to make it difficult to prepare petitions to challenge patents quickly. This will adversely impact the Office as well because it is likely to decrease the quality of examination of those complex patent families.

Considering the procedural and technical complexities involved in this case, the Board is uniquely situated to adjudicate patentability because of its expertise in patent law and technological questions.

3. Factor 3 (Parallel Proceeding): The majority of the substantial deadlines will occur after the expected institution decision date.

Factor 3 weighs against discretionary denial. The district court case is in relatively early stages even though it has been pending for fifteen months. No depositions have occurred; expert discovery is many months away. Fact discovery is currently scheduled to close December 1, 2025. EX1046, p.3. Expert discovery currently starts that same day. *Id.* A *Markman* hearing is scheduled for Oct. 21, 2025. *Id.* Where, as here, “the district court[s] ha[ve] not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.” *Fintiv*, at 10.

4. Factor 4 (Issue Overlap): *Sotera*-plus stipulation will minimize any potential overlap.

Factor 4 weighs strongly against discretionary denial. In its Petition, Petitioner stipulated that, if the IPR is instituted, Petitioner will not assert that any of the claims challenged in this proceeding are invalid on any ground that Petitioner raised or reasonably could have raised during this inter partes review. Pet. 84 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-01019, at 19 (finding “stipulation here mitigates any concerns of duplicative efforts...as well as concerns of potentially conflicting decisions” and “ensures that an inter partes review is a ‘true alternative’ to the district court proceeding”); *Lego*, 2021 WL 606917, at *6 (“[F]actor weighs strongly against discretionary denial” where Petitioner makes *Sotera* stipulation); *Verizon Business Network Servs, Inc. v. Huawei Techs. Co.*, IPR2020-01141, Paper 12 (Jan. 14, 2021) (“Instituting trial here serves overall system efficiency and integrity goals by not duplicating efforts and by resolving materially different patentability issues.”)).

On June 6, 2025 Petitioner filed “Petitioner’s Further Stipulation to Materially Reduce Overlap With District Court Proceedings” (Paper 7) in which Petitioner further stipulated that “if the PTAB institutes review in this proceeding, it will not rely in the litigation on any product or system that is ‘based on the same evidence presented’ in this IPR and will not advance a theory of obviousness based

on the combination of prior art that is asserted in any ground presented in the Petition with any other prior art, including product or system prior art, against the challenged claims.” Paper 7, 2 (citing *Cf. SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 9 (PTAB Apr. 7, 2025)).

Thus, the protections afforded by Petitioner’s stipulation here exceed the classic *Sotera* stipulation provisions found insufficient by the Board in *SAP*, and ensure that product or system art “based on the same evidence” to those used in the IPR will not be relied upon in the underlying litigation. Notably, Petitioner’s stipulation also forecloses what the Federal Circuit recently found permissible in *Ingenico Inc. v. IOENGINE, LLC.*, 136 F.4th 1354, 1366 (Fed. Cir. 2025) (holding that Congress did not “preclude a petitioner from relying on the same patents and printed publications as evidence in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use.”). Indeed, in that case the Federal Circuit authorized defendant/petitioner Ingenico to “rely[] on the DiskOnKey System with related printed publications at trial to prove the claimed invention was known or used by others, on sale, or in public use.” *Id.* at 1367. Here, however, Petitioner’s stipulation ensures that the IPR will serve as a true alternative to the parallel litigation if the Board institutes review. No product or system art will be

introduced at trial that is “based on the same evidence” presented in this IPR.

Accordingly, this factor strongly favors institution.

5. Factor 5 (Same Party) does not support discretionary denial.

When the Petitioner is the same as the named defendants in the litigation, the Board has found that this factor adds “little if anything to the discretionary denial analysis.” *See Aylo Freesites Ltd. f/k/a MG Freesites Ltd. v. WellcomeMat, LLC*, IPR2024-00710, Paper 13 at 17-18 (PTAB Sep. 05, 2024) (“We make the unremarkable observation that an IPR petitioner and patent owner are very often named parties in parallel district court litigation regarding the same patent. In our view, this factor adds little if anything to the discretionary denial analysis unless the petitioner is not named as a defendant (or declaratory judgment plaintiff) in parallel district court patent litigation.”). As in *Aylo*, the fact that there is overlap between the Petitioner parties and the defendants in litigation adds little to the discretionary denial analysis here.

6. Factor 6 (Other Considerations): The compelling merits of the petition strongly favor institution.

As described above in Section III(F), the compelling challenge to the Challenged Patent presented in the Petition weighs against a discretionary denial. So too do public interest considerations as described in Section III(F).

IV. DENIAL OF INSTITUTION UNDER 35 U.S.C. § 325(D) WOULD BE IMPROPER

Guidance regarding the Director's Interim Process states that "[i]f a patent owner chooses not to file a discretionary denial brief, the Director will not issue a decision on discretionary considerations." *See* USPTO's "FAQs for Interim Processes for PTAB Workload Management" ("Interim-Processes FAQs"), FAQ #9. Accordingly, a Patent Owner must raise a discretionary denial request for it to be heard by the Director. Here, Gengshiscomm did not request discretionary denial under 35 U.S.C. §325(d); thus, no decision by the Director as to discretionary denial under 35 U.S.C. §325(d) is required.

Regardless, discretionary denial under 35 U.S.C. § 325(d) is not applicable here. First, the Challenged Patent was not rejected based on any prior art. Second, the prior art in Petitioner's Grounds was never cited, much less discussed, during prosecution. Therefore, denial under § 325(d) is unwarranted.

V. CONCLUSION

For the above reasons, Petitioner respectfully requests that the Director decline to discretionarily deny this Petition and pass it to the merits panel for an institution decision on the merits of the Petition.

Case No. IPR2025-00789
Patent No. 11,075,786

Respectfully submitted,
GREENBERG TRAURIG, LLP

Date: July 29, 2025

By: /Andrew R. Sommer/
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CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

This Request complies with the requirements of 37 C.F.R. § 42.24. As calculated by the word count feature of Microsoft Word, it contains 10,718 words, excluding the words contained in the Table of Contents, Table of Authorities, List of Exhibits, this Certification and the Certificate of Service.

GREENBERG TRAURIG, LLP

Date: July 29, 2025

By: /Andrew R. Sommer/

Andrew R. Sommer

Reg. No. 53,932

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION and EXHIBIT NOS. 1022, 1099-1103, 1111-1119, 1124-1127, 1135-1138, 1141-1150, 1154-1158, 1160-1165, 1168-1171, 1176-1178 were served on the following counsel via electronic mail:

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