

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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

**v.**

**VB ASSETS, LLC,**  
*Patent Owner*

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**IPR2025-00867  
U.S. Patent No. 7,818,176**

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**PATENT OWNER'S DISCRETIONARY DENIAL BRIEF**

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## I. INTRODUCTION

VB Assets, LLC (“VB Assets” or “Patent Owner”) respectfully submits this brief requesting that the Board deny institution of the Petition for *inter partes* review (Paper 1 or “Pet.”) filed by Petitioners Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (“Petitioners” or “Samsung”) pursuant to §314(a) and the Acting Director’s March 26, 2025 Memorandum<sup>1</sup> titled “Interim Processes for PTAB Workload Management” (hereafter “Director Memo”).

The Petition seeks *inter partes* review (“IPR”) of claims 1-52 (the “Challenged Claims”) of U.S. Patent No. 7,818,176 (the “’176 Patent,” Ex. 1001). The ’176 Patent and five other patents<sup>2</sup> (collectively, the “VB Assets

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<sup>1</sup> See Ex. 2002 (Acting Director Memo)

(<https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>); Ex. 2003 (FAQs) (<https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>).

<sup>2</sup> Petitioners filed IPR petitions against all five of these other patents. See IPR Nos. 2025-00866, -00868, -00869, -00870, -00871. Three of the other IPRs were

Patents”) are the subject of the co-pending patent infringement action that VB Assets brought on October 9, 2024 against Samsung in the Eastern District of Texas as Civil Action No. 2:24-cv-00828 (the “EDTX Litigation”).

The Petition and the EDTX Litigation are not the first time that Samsung has encountered and evaluated the VB Assets Patents. Over a decade ago, around September 2012, Samsung expressed interest in licensing or purchasing VB Assets Patents. Ex. 2004 (Complaint), Paragraph 36-42. In December of that same year, Samsung offered to buy at least U.S. Patent Number 8,073,681—which it now challenges in IPR2025-00866—and license other VB Assets Patents, such as the ’176 Patent challenged in this proceeding. *Id.* Around 2013, instead of buying or licensing the patents, Samsung entered into a strategic partnership with Patent Owner’s predecessor to develop Samsung’s first voice assistant: S-Voice. *Id.*

Abruptly, Samsung announced a new, different product on October 18, 2017—its Bixby 2.0 voice assistant—which practices the inventions of the VB Assets Patents despite the fact that Samsung knew about but never secured any rights to use the VB Assets Patents in its new product (which it still sells to this day). After the announcement of this infringing product, Samsung rejected efforts to re-open

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accorded the same filing date as the present IPR, while the remaining two are on a schedule a few weeks behind.

discussions regarding the VB Assets Patents. *Id.* Despite this, Samsung never challenged their validity until now.

Now, almost 15 years after the '176 Patent issued in 2010 and after nearly a decade of silence from Samsung regarding the validity of the VB Assets Patents, Samsung furiously contests the validity of the VB Assets Patents (including the '176 Patent) in the Petition while also doing so in the EDTX Litigation. These challenges come in spite of the fact that the '176 Patent has already withstood multiple challenges before different tribunals, including the PTAB. Indeed, the Board denied institution of an IPR petition filed in 2020 by Amazon to challenge the '176 Patent. (*See* IPR No. 2020-01390, the “Prior IPR”). Beyond this, a District of Delaware jury rejected validity challenges to the '176 Patent when it found the patent to be valid and infringed by Amazon, alongside several other VB Assets patents that Petitioners now challenge (*see* Civil Action No. 1:19-cv-01410, the “Amazon Delaware Litigation”). In view of the settled expectations of the parties given the '176 Patent's nearly 15-year lifespan, Samsung's knowledge of the VB Assets Patents (including the '176 Patent) since at least 2012, the considerable resources already spent confirming the validity of the '176 Patent, Petitioners' robust validity challenges in the EDTX Litigation, and the factors discussed below, the Petition should be rejected and institution should be denied.

Denial is also warranted in the interests of efficiency and fairness. Samsung's invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, meaning that the EDTX Litigation is the most suitable venue to evaluate all of Samsung's challenges in view of all the evidence. Denial of this Petition—to allow the parties to focus on Samsung's full validity challenges in the EDTX Litigation—is the most efficient outcome and achieves the AIA's intended efficiency goals better than a half-dozen IPR proceedings that ask the Board to issue final written decisions months after a jury renders a verdict on the VB Assets Patents. Indeed, these combinations will be evaluated in the district court far in advance of any final written decision in these cases. Institution, in short, creates duplicative workloads, adds uncertainty, and risks inconsistent positions.

All told, there are many reasons to deny institution, as an evaluation of the discretionary denial factors confirms: all the Director Memo factors and *Fintiv*<sup>3</sup> factors weigh in favor of denying institution or are at the very least, neutral.

As highlighted above, the '176 Patent's survival after multiple validity challenges confirms Patent Owner's settled expectations that the '176 Patent is valid

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<sup>3</sup> *Apple v. Fintiv, Inc.*, No. IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

and enforceable since it has been in force since its issuance in 2010. Samsung's knowledge of the patents for a lion's share of that time (since 2011) drives the point home: both parties had settled expectations that weigh against institution. As to the remaining Director Memo factors: (1) the validity of the '176 Patent was already adjudicated both at the PTAB and by a District of Delaware judge and jury; (2) the Petition relies extensively on expert testimony to fill gaps in the cited references; and (3) the EDTX Litigation is more efficient because it encompasses all six patents, whereas this IPR would only resolve a subset of Samsung's patentability challenges to the '176 Patent and there would still need to be five other IPR proceedings to achieve just a portion of the validity side of the EDTX Litigation.

As to the *Fintiv* factors: (1) there is no request for a stay in the EDTX Litigation and even if there were, a stay is unlikely; (2) the EDTX Litigation is set to go to trial four months before the Board's deadline to issue a final written decision in this proceeding and more than five months before the IPRs of two other VB Assets Patents; (3) the parties have already invested significant resources in the EDTX Litigation; (4) all of Petitioners' invalidity theories are simultaneously raised in the EDTX Litigation and the filed stipulation does nothing to allay concerns of gamesmanship; (5) the parties in this proceeding are the same as the parties in the EDTX Litigation; and (6) the merits of Petitioners' case are weak.

Accordingly, institution should be denied.

## II. LEGAL STANDARDS

It is Petitioners' burden to demonstrate unpatentability by a preponderance of the evidence. The Petition must establish, with particularity, the grounds and evidence that support invalidating the patented claims. 35 U.S.C. §312(a)(3). Petitioners "must 'specify where each element of the claim is found in the [relied upon] prior art patents.'" *In-Depth Geophysical, Inc. v. ConocoPhillips Co.*, IPR2019-00850, Paper 56, \*27 (PTAB Sept. 3, 2020) (quoting 37 C.F.R. § 42.104(b)(4)). Petitioners must demonstrate that the prior art "discloses[] within the four corners of the document . . . all of the limitations claimed," and that disclosure must be "arranged or combined in the same way as recited in the claim." *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008).

In addition, the Board makes its determination regarding institution based on what the Petition *actually presents* and not what it could have reasonably contained had it been drafted differently. *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (holding that the Board is *not* "free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during [a post-grant proceeding]"). As will be explained further below, this dooms the Petition. The Board cannot "deviate from the grounds in the petition and raise its own" theories of invalidity. *Sirona Dental Sys. GmbH v. Institut Straumann AG*, 892 F.3d 1349, 1356 (Fed. Cir. 2018).

In addition to the underlying failures of the Petition, the Board should deny institution pursuant to discretionary factors committed to the Board's discretion under §314(b), including the Director Memo factors and *Fintiv*.

The Director Memo identified a non-exhaustive number of factors that may be considered by the Board when evaluating how to apply the Board's discretion under §314(b) (hereafter, the "Memo Factors") including (but not limited to):

1. Whether the PTAB or another forum has **already adjudicated** the validity or patentability of the challenged patent claims;
2. Whether there have been **changes in the law** or new judicial precedent issued since issuance of the claims that may affect patentability;
3. The **strength** of the unpatentability challenge (related to *Fintiv* Factor 6, above);
4. The extent of the petition's **reliance on expert testimony**;
5. **Settled expectations** of the parties, such as the length of time the claims have been in force;
6. **Compelling** economic, public health, or national security **interests**; and
7. Any **other considerations** bearing on the Director's discretion.

Ex. 2002 at 2-3. The Board's FAQs further indicate that "[t]he Process Memorandum includes a *non-exhaustive* list of issues that may be raised in discretionary briefing. Parties are encouraged to address *any* fact or circumstance

they believe bears on the Director’s discretion to institute, including reasons not discussed in current Board precedent or in the Process Memorandum.” Ex. 2003 (FAQs), at Q.11 (emphasis added).

Furthermore, the *Fintiv* factors include:

1. Whether the court has granted a **stay** or evidence exists that one may be granted if an IPR is instituted;
2. The **proximity of the court’s trial date** to the PTAB’s projected statutory deadline for a final written decision;
3. The **investment** in the parallel proceeding by the court and the parties;
4. The **overlap** between issues raised in the petition and those in the parallel proceeding;
5. Whether the petitioner and the defendant in the parallel proceeding are the **same party**; and
6. **Other circumstances** that impact the PTAB’s exercise of discretion, **including the merits** of the petition.

*Fintiv* at 6. The Board takes a “holistic view” of whether efficiency and integrity of the system are best served by denying or instituting review. *Id.*

### **III. THE BOARD SHOULD NOT INSTITUTE INTER PARTES REVIEW UNDER §314(A)**

#### **A. The Director Memo Factors Weigh Against Institution**

##### **1. Settled Expectations Favor Denial**

“Settled expectations” is generally directed to the length of time the claims have been in force. This factor weighs heavily in favor of denying institution.

By the time of the institution decision in this proceeding, the ’176 Patent will have been in force for more than fifteen years—since October 19, 2010. Since then, there have been at least two challenges to its validity and both have failed (the Prior IPR and the Amazon Delaware Litigation), confirming Patent Owner’s belief and reliance on the ’176 Patent being valid and enforceable. This creates settled expectations. *See, e.g., Dabico Airport Solutions Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025) (“The challenged patent has been in force almost eight years, creating settled expectations”); *Samsung Electronics, Co., Ltd. et al. v. Cerence Operating Co.*, IPR2025-00458, -00459, -00460, Paper 14 at 2 (Director June 25, 2025) (“[T]he challenged patents issued over 11 years ago . . . . Patent Owner’s settled expectations also weigh toward discretionary denial.”); *iRhythm Technologies, Inc. v. Welch Allyn*, IPR2025-00363, -00374, -00376, -00377, -00378, Paper 10 at 3 (Director June 6, 2025) (denying institution where “one of the patents has been in force since as early as 2012”).

Not only this, but Samsung has been aware of the '176 Patent specifically and the VB Assets Patents generally for well over a decade and only now challenges it in an IPR. Samsung knows of the '176 Patent at least through negotiations towards purchase or license of the VB Assets Patents in 2012. Ex. 2004 (Complaint), ¶ 36. But even before this, the '176 Patent was cited as prior art during prosecution of Samsung's Pub. No. 2008/0256574 on July 20, 2011. Ex. 2005 (Pub. No. 2008/0256574 Prosecution History). Samsung admits as much. Ex. 2006 (Samsung EDTX Litigation Answer), Paragraph 107 ("Samsung admits that the '176 patent was referenced during prosecution of U.S. patent application published as US 2008/0256574A1").

Further still, between Samsung's first knowledge of the VB Assets Patents—including specifically the '176 Patent—and now, Samsung developed and released an infringing product. Samsung admits that it announced a version of the accused product on October 18, 2017—nearly eight years ago but also six years after it knew of the '176 Patent and was aware of its relative importance in the voice assistant and natural language understanding industry. But Samsung never challenged its validity during all that time. This again demonstrates settled expectations. *See SIG Sauer, Inc. v Lone Star Future Weapons, Inc.*, IPR2025-00410, Paper 13 at 2 (Director June 26, 2025) (denying institution where the challenged patent "issued over 10 years

ago, and Petitioner subsequently developed a competing product without challenging this patent.”).

The settled expectations factor strongly favors denial of institution because the claims of the ’176 Patent have been in force since 2010, survived multiple validity challenges, and Samsung has been aware of the ’176 Patent as early as 2011 but decided not to challenge it until now. *iRhythm Techs.*, Paper 10 at 3 (“Petitioner’s awareness of Patent Owner’s applications and failure to seek early review of the patents favors denial and outweighs the above-discussed considerations.”); *Apotex Inc. v. Alkermes Pharma Ireland Limited*, IPR2025-00514, Paper 10 at 2 (Director July 2, 2025) (“[T]he challenged patent has been in force for more than 14 years, creating strong settled expectations.”).

## **2. Prior Adjudication of the ’176 Patent by the PTAB and other Forums Favors Denial**

This prior adjudication factor is directed to “whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims.” Here, both the PTAB and a district court have previously considered this patent.

Multiple unsuccessful validity challenges to the VB Assets Patents, including the ’176 Patent, reinforces denial under this factor. In March 2021, the PTAB denied institution of an IPR challenging claims 1-52 of the ’176 Patent, the exact same

claims challenged by Samsung here. *Amazon.com, Inc. v. VB Assets, LLC*, IPR2020-01390, Paper 7 (PTAB Mar. 11, 2021). Second, the validity of the '176 Patent was challenged in the Amazon Delaware Litigation, and a jury upheld the validity of the '176 Patent in November 2023. Ex. 2007 (Amazon Delaware Litigation Jury Verdict). Although only claim 40 was presented to the jury, each of the independent claims were asserted and challenged throughout expert discovery, but none were invalidated by the district court. Amazon is currently appealing its failed challenge to the '176 Patent to the Federal Circuit. Ex. 2008 (Amazon Notice of Appeal).

Thus, prior adjudication weighs strongly against institution. *See Celltrion, Inc. v. Regeneron Pharmaceuticals, Inc.*, IPR2025-00456, Paper 14 at 2 (Director June 25, 2025) (exercising discretion to deny institution when other forums have already adjudicated the validity of the challenged patent claims).

### **3. Heavy Reliance on Expert Testimony, Including to Fill Gaps in the Prior Art's Teachings, Favors Denial**

The Acting Director also considers the “extent of the petition’s reliance on expert testimony.” The FAQs further explain:

While the Board may consider expert testimony, as a matter of efficiency, extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court. The statute and our reviewing court require that petitions be based on prior art patents and printed publications. As the judges have technical and legal expertise, it is not necessary for an expert to explain every aspect of the prior art. It is most helpful if an expert is providing focused testimony, for

example to provide helpful context or to explain terms of art. The failure to provide focused expert testimony may weigh against institution.

Ex. 2003 (FAQs), at Q.21.

This factor favors denial because, as explained herein with respect to *Fintiv* Factor 6 and the Director Memo concerning the merits, Petitioners rely heavily on expert argument, assumptions, and inferences to fill in the gaps of the prior art and allegedly arrive at the claimed invention. Petitioners rely on cursory (but lengthy) expert testimony for every cited claim limitation and every ground, rather than providing a focused expert declaration addressing the limitations for which expert testimony is necessary. *See generally*, Ex. 1003.

The declaration lacks focus because, for example, it provides only a cursory analysis of the prior art using language that tracks the Petition (*compare* Ex. 1003, Paragraph 226 *with* Petition, 25; *compare* Petition 61 *with* Ex. 1003, Paragraph 412). Worse, however, is that Petitioners' expert fails to provide any meaningful testimony as to how the alleged disclosure of the prior art is to be applied in the proposed combination. In this same Paragraph 226, for instance, Petitioners' expert testifies only that "Hansen also discloses" the limitation but does not evaluate whether (or how) a POSITA would be motivated to combine this teaching with the primary reference, Taschereau. *Id.* Petitioners' expert simply alleges that Taschereau discloses the limitation, and Hansen discloses the limitation, but never evaluates

whether the POSITA would have arrived at the claimed invention as result of the combined teachings of the references, which is the argument presented in Ground 1 of the Petition. This is merely an example, but there is no shortage of similar failings where Petitioners' expert stops short of offering testimony that *would* aid the Board and instead lists separate and disparate disclosures of the prior art without explaining how they would be combined. *See, e.g.*, Ex. 1003, Paragraphs 216-226 (alleging both Taschereau and Hansen disclose the same limitation separately), Paragraphs 396-397 (alleging both Ramer and Cross disclose the same limitation separately).

Elsewhere, Petitioners' expert attempts to fill gaps. For example, in Ground 1, Petitioners assert that Taschereau discloses a “conversational language processor” because the “multi-pass latent recognition process recognizes words and phrases.” Petition, 22-23. To satisfy Claims [1E]/[27E], Petitioners cite to their expert's opinion that “a POSITA would have understood that Taschereau's multi pass process is a conversational language processor interpreting the recognized words and phrases using grammars” *Id.* (citing Ex. 1003, Paragraph 220).

Later, in Ground 4, Petitioners apply claim constructions for “acoustic grammar” that recite “a grammar of phototactic English language rules that maps phonemes to syllables” or “a collection of the phonemes linked together to form syllables.” Petition, 61. Petitioners do not allege that the Cross reference asserted in Ground 4 discloses mapping phonemes to syllables (or linking phonemes together

to form syllables) but do rely on Cross’s teachings as to “pronunciations.” *Id.* To tie them together, Petitioners allege that “[a] POSITA would understand the reference to ‘pronunciations’ in Cross to be synonymous with syllables,” citing their expert’s declaration. *Id.* (citing Ex. 1003, Paragraph 412). Petitioners’ expert supports this statement with references that are not asserted in Ground 4. Ex. 1003, Paragraphs 411-412 (citing Ex. 1016; Ex. 1017). *See* Section III.B.6.c, *infra*.

Patent Owner, in its POPR, will explain why Petitioners’ arguments, assumptions, and inferences are incorrect and do not meet the claim limitations. Regardless, and because of the extensiveness of the Petitioners’ reliance on the extensive testimony of its expert to establish the claimed invention, this dispute is better suited to resolution in an Article III district court, and this factor favors denial of institution. Ex. 2003 (FAQs), at Q.21.

#### **4. Other Factors Favor Denial**

The Acting Director has also indicated that she will consider any other factors when evaluating whether to apply discretionary denial. This last factor favors denial because institution would create the exact inefficiencies that Acting Director’s interim guidance is designed to protect against.

The EDTX Litigation involves six patents in a single unified district court proceeding brought on October 9, 2024. Ex. 2004 (Complaint). However, Samsung

waited until May 2025 to then file (to date) six IPR petitions<sup>4</sup> challenging all six patents in an attempt to avoid or delay a single streamlined district court trial, which would frustrate the intended efficiencies of the AIA. Taken together with Samsung's longstanding knowledge of the patent even as it developed a competing product (*see* Section III.A.1, *supra*), its IPR challenges should be denied.

In essence, Petitioners attempt to convert a single district court proceeding into *the same* district court proceeding, *plus* six separate IPR trials (involving invalidity determinations by potentially up to 18 factfinders, not including the district court).<sup>5</sup> Petitioners' IPRs create the duplicative workloads, inefficiency, and potential for inconsistent results that the Acting Director's interim guidance is

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<sup>4</sup> *See* IPR Nos. 2025-00866, -00867, -00868, -00869, -00870, -00871.

<sup>5</sup> Even further, the '176 Patent and a subset of the VB Assets patents are also part of another district court litigation involving Patent Owner and Apple (*VB Assets LLC v. Apple, Inc.*, No. 1:24-cv-01368-MN (D. Del.)). Because there are multiple ongoing district court proceedings, discretionary denial reduces the chances of duplicative workloads and inconsistent outcomes. *Comcast Cable Communications, LLC d/b/a Xfinity v. Entropic Communications, LLC*, IPR2025-00183, -00184, -00185, Paper 11 at 3 (Director June 25, 2025).

designed to prevent. *See, e.g., Comcast Cable Communications, LLC d/b/a Xfinity v. Entropic Communications, LLC*, IPR2025-00183, -00184, -00185, Paper 11 at 3 (Director June 25, 2025) (“The presence of multiple parallel proceedings and avoidance of duplicative workloads and inconsistent outcomes favor discretionary denial.”). A single Article III proceeding has the strong potential to be the fastest and most efficient resolution of the Parties’ many disputes, which favors denial of institution.

**B. The *Fintiv* Factors Weigh Against Institution**

**1. *Fintiv* Factor 1: The District Court Has Already Stated It Will Not Issue a Stay In Similar Circumstances, Which Favors Denial**

***Fintiv* Factor 1** favors denial of institution because of the co-pending EDTX Litigation.

First, Patent Owner has not requested a stay in the EDTX Litigation pending institution of this IPR (or the *five other* co-pending IPR petitions of the VB Assets Patents), and even if a stay were requested, the evidence shows that it is unlikely to be granted. Petitioners present no evidence in their Petition that they have requested a stay or that a stay is likely. When petitioners present no evidence that a stay is likely in parallel proceedings, the Board has found *Fintiv* Factor 1 to favor discretionary denial. *See Luxshare Precision Industry v. Amphenol Corp.*, IPR2022-00132, Paper 10 at 9 (PTAB May 3, 2022). The Court in the Eastern District of

Texas is on record that it “has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings” as to all patents at issue. *Force MOS Tech. Co., Ltd. v. ASUSTeK Computer, Inc.*, Case No. 2:22-cv-000460, ECF No. 74, (E.D. Tex. April 10, 2024) (citations omitted). The district court will, therefore, not stay the underlying action while institution decisions remain pending in any IPR proceeding.

As applied to the EDTX Litigation, a motion for a stay would not be ripe until institution is decided in the last of Samsung’s six IPR challenges. Furthermore, Samsung would need to prevail on institution of ***all six IPR petitions*** for there to be any chance of a stay in the district court proceeding—an unlikely outcome (particularly in view of the weak merits). The high likelihood of an eventual district court trial on at least one patent claim weighs against the likelihood of the EDTX Litigation being stayed and therefore strongly favors denial. *See, e.g., MyPort, Inc. v. Samsung Electronics Co., Ltd.*, Case No. 2:22-cv-00114, ECF No. 73 (June 13, 2023) (denying request for stay when final written decision in pending IPRs were scheduled to issue two months after trial, even though the Court had not yet held a Markman hearing, in view of the parties substantial investment in the case and the plaintiff’s interest in timely vindication of its patent rights).

Thus, *Fintiv* Factor 1 weighs heavily against institution because of the EDTX Litigation.

**2. *Fintiv* Factor 2: Any Final Written Decision Will Occur After the District Court's Scheduled Jury Trial Date, and Decisions in Other IPRs Would Occur Even Later**

***Fintiv* Factor 2** weighs heavily against institution.

In the EDTX Litigation, trial is scheduled for July 6, 2026. Ex. 2009 (EDTX Litigation Amended Docket Control Order). Trial on the VB Assets Patents will therefore be complete ***more than four months before*** the November 20, 2026, the statutory deadline for the Board to issue a final written decision in this IPR (assuming the Board's institution decision is dated November 20, 2025) and ***more than five months*** before the last final written decision is expected by December 10, 2026. Ex. 2009 (EDTX Litigation Amended Docket Control Order); Ex. 2010 (Notice According Filing Date in IPR2025-00870).

The currently scheduled district court trial date of July 6, 2026, is both conservative and achievable in view of median time to jury trial statistics. The median time to jury trial in patent cases filed before Judge Gilstrap after January 1, 2020 (which is a conservative estimate because it includes many cases delayed due to the Covid-19 epidemic) is just 20.6 months after the filing of the original district court complaint. Ex. 2011 (Docket Navigator Statistics). Applying that median time to trial to the date VB Assets filed its complaint, October 9, 2024, suggests an expected trial date in mid-to-late June of 2026. If anything, these statistics indicate that the trial date set in the EDTX Litigation is generous.

Thus, when considering either the scheduled jury trial date or the district court's median time-to-trial statistics, Samsung's six petitions challenging the VB Assets Patents will result in final written decisions (assuming they are all instituted), until the very end of 2026. This will be more than five months after the jury issues its verdict and almost six months after the median time-to-trial in cases filed after January 1, 2020.

The Director has denied institution in view of smaller gaps between the final written decisions and trial. *See, e.g., Samsung Electronics Co., Ltd. et al. v. Mobile Data Techs., LLC*, IPR2025-00535, -00536, Paper 16 at 2 (Director July 10, 2025) (finding this factor weighed in favor of discretionary denial and denying institution where the final written decision date (September 2026) was 4.2 months after trial date (April 20, 2026)); *Samsung Electronics Co. Ltd et al. v. SinoTechnix LLC*, IPR2025-00331, -00333, -00335, -00336, Paper 13 at 2 (Director July 2, 2025) (finding this factor weighed in favor of discretionary denial and denying institution where the final written decision date (September 6, 2026) was roughly 4 months after trial date (May 4, 2026)); *Cisco Systems, Inc. v. WSOU Investments LLC d/b/a Brazos Licensing and Development*, IPR2025-00429, Paper 15 at 2 (Director June 25, 2025) (finding this factor weighed in favor of discretionary denial and denying institution where the final written decision date (July 30, 2026) was roughly 3-5 months after trial date (March 2026 or April 20, 2026)); *Advanced Micro Devices*,

*Inc. et al. , v. Concurrent Ventures, LLC et al.*, IPR2025-00223, Paper 9 at 2 (Director June 12, 2025) (finding this factor weighed in favor of discretionary denial and denying institution where the final written decision date was only 16 days after trial); *see also EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (finding this factor weighed in favor of discretionary denial and denying institution where “the beginning of the jury trial in the WDTX Cases is roughly one or two months before any final decision would have been due had *inter partes* review been instituted”); *Resmed Corp. v. Cleveland Med. Devices Inc.*, IPR2023-00565, Paper 13 at 11 (PTAB September 25, 2023) (denying institution where trial was scheduled to occur “approximately one month” before the deadline to issue a final written decision).

Thus, *Fintiv* Factor 2 weighs heavily against institution because of the EDTX Litigation.

**3. *Fintiv* Factor 3: The Parties Have Already Invested Significant Effort and Resources in Parallel District Court Proceedings**

***Fintiv* Factor 3** weighs heavily against institution.

In the EDTX Litigation, by this IPR’s institution deadline (November 20, 2025), the parties will already have exchanged initial infringement and invalidity contentions and conducted extensive discovery in advance of the deadline for substantial completion of document production just five days later (November 25,

2025). Ex. 2009 (EDTX Litigation Amended Docket Control Order). VB Assets has already produced a substantial amount of documents—over sixty thousand—and will continue to make ongoing supplemental productions. Samsung, for its part, has made gigabytes of highly confidential source code available for inspection by VB Asset’s experts, who have spent approximately two hundred hours reviewing 8.5 GB of source code. Samsung has likewise committed to producing technical documents for the accused products implicated by VB Asset’s infringement contentions.

Further, as of this paper’s filing Samsung has already served seven third-party subpoenas seeking documents and deposition testimony pertaining to alleged prior art in an attempt to bolster its validity challenges before the district court. Exs. 2014–2020. Although the subpoenas ostensibly seek information about prior art systems, Samsung did not limit the scope of its subpoenas to exclude prior art printed publications about such systems, demonstrating its intent to maintain parallel and duplicative validity challenges between this tribunal and the district court. Indeed, several of these third-parties have already begun producing responsive documents, and the return dates on all third-party subpoenas served to-date are before the institution deadline in this IPR. In addition, Samsung’s counsel confirmed the deposition of a Samsung employee will take place on September 4, 2025, and VB Assets has already noticed an additional deposition. Ex. 2021; Ex. 2022. On top of this, Samsung recently produced thousands of documents from one or more

additional third-parties outside the above-mentioned subpoenas. These documents include marketing materials, technical diagrams, and various user and implementation guides for asserted prior art. All told, third parties in the district court action have already made more than eight thousand documents available in the litigation.

In addition, the *Markman* process will commence months before the institution deadline in this IPR, as the parties must exchange claim terms for construction by September 9, 2025. Ex. 2009 (EDTX Litigation Amended Docket Control Order). Soon after, on September 30, 2025, the parties will exchange preliminary constructions followed by a joint claim construction submitted to the court on October 21, 2025. *Id.* Indeed, the parties are to complete claim construction discovery by November 18, 2025, days before institution in this IPR, and opening claim construction briefs will be exchanged before the institution deadline in the last IPR of the VBA Assets Patents on December 10, 2025. *Id.*

Given the significant resources already invested by both VB Assets and Samsung in the EDTX Litigation, *Fintiv* factor 3 weighs heavily against institution.

**4. *Fintiv* Factor 4: The Overlap Between the Asserted Art and Petitioners' Invalidity Arguments in the District Court is Significant, and Petitioners' So-Called *Sotera* Stipulation Is Ineffective**

***Fintiv* Factor 4** also weighs against institution.

Samsung’s massive EDTX Litigation contentions assert all the same prior art in this IPR, and the same grounds. To be sure, Samsung’s validity challenges before the district court are expansive to say the least. For just six patents, Samsung asserts a staggering **200 individual claim charts** that add up to **over 25,000 pages**. As to the ’176 Patent, there is complete overlap between this IPR and Samsung’s validity challenges in the district court because Samsung “attaches and incorporates IPR No. IPR2025-00867, including the petition (Appendix E-33A) and expert declaration of Stuart Lipoff (Appendix E-33B), as if fully set forth [in its EDTX Litigation invalidity contentions].” Ex. 2012 at 67-68 (Samsung EDTX Litigation Invalidity Contentions). Samsung relies on this IPR to “show[] how the prior art references [Taschereau, Hansen, Franco, Jones, Ramer, and Cross] teach or suggest each and every element of the Asserted Claims of the ’176 Patent.” *Id.* In fact, the *only* obviousness combinations to challenge the ’176 Patent that Samsung specifically articulates across its 372-page cover document are the four grounds from this IPR:

| <b>Table 4E: Exemplary Obviousness Combinations for the Asserted Claims of the ’176 Patent</b> |                                |
|------------------------------------------------------------------------------------------------|--------------------------------|
| <b>Claims</b>                                                                                  | <b>Combinations</b>            |
| 1-2, 9-11, 27-28, 35-37                                                                        | Taschereau and Hansen          |
| 12-18, 25-26, 38-44, 51-52                                                                     | Taschereau, Hansen, and Franco |
| 3-8, 19-24, 29-34, 45-50                                                                       | Taschereau, Hansen, and Jones  |
| 1-52                                                                                           | Ramer and Cross                |

*Id.*, at 148-157.

Beyond this, Samsung asserts at least 16 system art references in its EDTX Litigation invalidity contentions, as shown in the chart excerpted below:

|       |                              |
|-------|------------------------------|
| E-23  | “MIT Galaxy” system          |
| E-23A | MIT Galaxy source code       |
| E-24B | MIT Voyager                  |
| E-23C | MIT Galaxy Video             |
| E-23D | Orion                        |
| E-23E | MIT Flight Browser           |
| E-23F | AMT Mobile Speech Task       |
| E-23G | Weather Query                |
| E-24  | Nuance Voice Platform System |
| E-25  | ScanSoft United System       |
| E-26  | SpeechWorks MINT System      |
| E-27  | HeyAnita                     |
| E-28  | Cybermind System             |
| E-29  | TellMe System                |
| E-30  | Microsoft MiPad System       |
| E-31  | GyrusLogic                   |

*Id.*, at 65-67 (alleging the above chart shows “the prior art references that anticipate or render obvious the Asserted Claims in the claim charts Appendices E-1–E-32”). Samsung’s invalidity contentions ensure that each system art reference asserted above can be combined with any other reference, including the references asserted in the Petition. Ex. 2012, 68 (“The prior art identified above, and in Appendices E-1–E-32 *and in IPR No. IPR2025-00867*, individually anticipate and/or can be

properly combined in multiple ways to demonstrate the obviousness of the Asserted Claims of the '176 patent.”) (emphasis added).

Accordingly, even with the limited *Sotera* stipulation proffered by Petitioners, Samsung would still claim to retain the ability to discuss at the jury trial the majority of the prior art references discussed in this Petition (including each of its primary references) in combination with system prior art that they have identified. Ex. 2012, 70 (“In addition to contending that the '176 patent Asserted Claims are invalid in view of the prior art references cited in the claim charts of Appendices E-1–E-32 *and IPR No. IPR2025-00867*, Samsung further contends that the '176 patent Asserted Claims are invalid as anticipated and/or obvious under U.S.C. §§ 102 and/or 103 *in view of public knowledge and uses and/or offers for sale of products and services related to the subject matter of the cited references.*”), at 70-71 (“Samsung’s reference to a particular device or product in the claim charts of Appendices E-1–E-32 *and IPR No. IPR2025-00867* should be interpreted *alternatively as both a reference to the product itself and to any corresponding patents, publications, or product literature cited in the claim charts that relate to the cited device or product.* In addition, Samsung may rely on other documents or things that have not yet been located to support its contentions regarding such prior art device(s) or product(s) that are referenced in the charts.”) (emphasis added).

As the Acting Director recognized in a recent Order Granting Director Review, such stipulations do not ensure that these IPR proceedings would be a “true alternative” to the district court proceeding where unpublished system prior art is asserted in combination with the art used in the IPR’s grounds. *Motorola Sol’ns, Inc. v Stellar LLC*, IPR2024-01205, Paper 19, 3-4 (Order Granting Director Review, Vacating the Decision Granting Institution, and Denying Institution of Inter Partes Review) (P.T.A.B. March 28, 2025) (Stewart, A.D.) (finding that a *Sotera* stipulation was unlikely to moot petitioner’s combination of IPR art with unpublished system prior art in district court proceedings, and therefore could not outweigh other factors favoring denial); *see also* Ex. 2003 at Q.14 (“... The Director will take into account whether the stipulation materially reduces overlap between the proceedings. Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited.”).

Aside from system art, Samsung also challenges the ’176 Patent as claiming ineligible subject matter under Section 101, not compliant with the written description and/or enablement requirements of Section 112, and indefinite under Section 112. Ex. 2012, 366 (citing Ex. 2013 (Exhibit G-5, Subject Matter Eligibility

Contentions for '176 Patent)); *see also id.*, at 360-362 (challenging claims under Section 112); at 363-365 (challenging claims as indefinite).

It is clear that this IPR, or even all of Samsung's IPRs challenging the VB Assets Patents, will not streamline Samsung's validity case. *See Shenzhen Tuozhu Tech. Co., LTD v. Stratasy, Inc.*, IPR2025-00354, Paper 11 at 2–3 (Director June 12, 2025) (“Petitioner’s invalidity arguments in the district court, however, are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot.”). Accordingly, Samsung’s limited *Sotera* stipulation should be afforded little, if any, weight when evaluating this *Fintiv* factor. Even if this IPR is instituted, and Samsung were to refrain from advancing any prior art or ground that was raised or reasonably could have been raised in this IPR, the district court will still have to try Samsung’s voluminous validity challenges alleging system prior art, patent ineligible subject matter, claims lacking written description, claims that are not enabled, and claims that are indefinite.

Samsung’s reliance on corresponding system art and several other invalidity theories in the EDTX Litigation at the same time as these IPRs defeats the AIA’s stated purpose of increased efficiency. The *Sotera* stipulation is simply not meaningful because the district court will still have to conduct a simultaneous, and robust, validity analysis regardless of the outcome of these IPRs. *See Ex. 2003*

(“FAQs”), at Q.14 (“ . . . The Director will take into account whether the stipulation materially reduces overlap between the proceedings. Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited.”).

Because there is complete overlap between the art raised in these proceedings and asserted in the underlying district court proceedings, and because inefficiencies created by multiple validity proceedings is not materially diminished by Petitioners’ *Sotera* stipulation in view of Petitioners’ use of unpublished system art in the district court proceeding, this factor favors denial.

**5. *Fintiv* Factor 5: The Identity of the Parties Weighs Against Institution**

**Fintiv Factor 5** also weighs against institution because Samsung is the accused infringer and defendant in the EDTX Litigation and Patent Owner is the plaintiff. Ex. 2004 (Complaint). Therefore, there is complete identity of the parties.

**6. *Fintiv* Factor 6: The Merits of the Petition Are Weak**

**Fintiv Factor 6** relates to the weakness of the Petition on the merits, which weighs against institution. While the merits will be more fully addressed in Patent Owner’s Preliminary Response (which is incorporated herein by reference pursuant

to FAQ Q.25), a few examples are provided below to illustrate the weakness of Petitioners' arguments.

Ground 1 and 2 assert the same underlying prior art combination—Taschereau modified by Hansen—while Ground 2 proposes further modification with the Franco reference. Ground 4 challenges all 52 claims of the patent with the combination of Ramer and Cross.<sup>6</sup>

**a. The Taschereau + Hansen combination**

Taschereau is directed to “matching an utterance” with “a listing in a directory” using a multi-pass process that “requires” the utterance to be “re-applied in a manner which the caller cannot hear.” Ex. 1005, Abstract, 13:8-19. Hansen, on the other hand, “immediately” passes words that its Linguistic Processor extracts from the incoming speech signal to the Command Processor. Ex. 1006, 27:34-38. These two approaches are inconsistent with one another. This matters for two reasons.

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<sup>6</sup> Ground 3 applies the combination of Ground 1, further modified by Jones, but does not challenge any independent claims. The Jones reference does not resolve any of the issues with Ground 1 that are identified herein. Thus, Ground 3 does not need to be considered for the purposes of evaluating the strength of the merits for discretionary denial.

**First**, the Petition is internally inconsistent. Petitioners sometimes rely on Hansen’s Command Processor and other times seem to suggest that the proposed combination uses only Hansen’s Linguistic Processor. *Compare* Petition, 11 (proposing POSITAs would expect success based on “integrat[ing] **one component**” of Hansen: the Linguistic Processor) *with id.*, 25 (relying on Hansen’s “‘Command Processor’ and associated host computer”). Both of Petitioners’ inconsistent positions present problems though. Hansen’s Command Processor takes words and outputs them as operating system commands, application commands, passes them to a word processor, or in some cases drops and ignores the word entirely. Ex. 1006, 10:12-19, Fig. 11. Putting aside whether such functionality (or commands) “interpret[s]” words as Petitioners allege (*see* Petition, 25), Petitioners fail to explain how ignored words and operating system command outputs from Hansen’s single pass would function in Taschereau’s multi-pass process. But Petitioners’ other read—where Hansen’s Command Processor is left behind—is no better because Petitioners provide no reason why a POSITA would be motivated to depart from Hansen’s single pass Linguistic Processor as part of the combination with Taschereau.

**Second**, Petitioners fail to establish a motivation to combine Taschereau and Hansen. As noted above, Taschereau “requires” that the recording of an utterance be reapplied for its multi-pass process (which Petitioners rely upon) to work. Ex. 1005, Abstract, 13:8-19; *see* Petition, 22-24. But Petitioners fail to explain how Hansen’s

single pass Linguistic and/or Command Processor would work with recorded utterances that are repeatedly passed through, or why a POSITA would supposedly want to try to do so. *See generally* Petition, 10-11. Petitioners' failure cannot be fixed at this stage in the proceeding. *In re Magnum Oil*, 829 F.3d at 1381.

Further still, when Hansen's Command Processor is involved, each "pass" would result in operating system or application commands to the computer, and Petitioners provide no explanation as to how that would be suitable with the multi-pass process of Taschereau. Petition, 10-11. These issues are compounded by the fact that Petitioners allege that **both** Taschereau and Hansen satisfy the "recognizing one or more words in the utterance at a speech recognition engine" limitation ([1B]/[27B])—but nowhere explain how the **combination** would recognize speech. Petition, 13-14 ("Taschereau thus discloses a 'speech recognition engine'" and later that "Hansen thus discloses a 'speech recognition engine.'"). Simply put, Petitioners fail to substantiate Ground 1's combination.

Petitioners are internally inconsistent elsewhere too. For example, for Claims [1A]/[27A] ("receiving a natural language utterance containing at least on request at an input device") Petitioners rely on their expert to allege that, in Taschereau, "the **microphone** in the handset is an 'input device' that receives the natural language utterance containing a request." Ex. 1003, Paragraph 176 (emphasis added); Petition, 12; *see also* Ex. 1003, Paragraph 177-178 (listing other "input devices" like

“landline phones, mobile phones, in-vehicle systems and other systems where voice recognition is used”). But to demonstrate Claims [1B]/[27B] (a “speech recognition engine coupled to [an] input device”) Petitioners’ expert switches to “the ‘input device’ being the ASR recognizer.” Ex. 1003, Paragraph 181 (“The ASR recognizer (the ‘input device’) is therefore coupled to a speech recognition engine that obtains the information from the ASR recognizer.”). The issue is that Taschereau never discloses that its ASR recognizer is the microphone itself. Petitioners also ignore that Taschereau’s ASR “recognizer” must handle multiple passes of recorded utterances “in data form” that “can be very quickly input into the recognizer.” Ex. 1005, 7:20-22. Petitioners fail to explain how Taschereau’s microphone would handle repeat utterances input in data form such that the microphone and the recognizer would be the same “input device.” *See generally* Petition, 11-14.

**b. The Taschereau + Hansen + Franco combination**

Petitioners’ further modification with tertiary reference Franco in Ground 2 does nothing to resolve these issues. In Ground 2, Petitioners map Franco to “determining an incorrect interpretation occurred and reinterpreting” but ignore that Franco works by “assuming” a second utterance will be a repeat of the first, so Franco then merges the audio of these repeats to yield a better recognition result. Ex. 1007, Paragraph [0020]. Petitioners do not identify anything in Franco that indicates

it determines that an interpretation was incorrect or that any reinterpretation is performed—instead Franco performs recognition by merging repetitive utterances.

**c. The Ramer + Cross combination**

Ground 4 fails as to two of the four challenged independent claims ([1C]/[27C]) because Petitioners advance claim constructions that require “a grammar of phototactic English language rules that maps phonemes to *syllables*” or “a collection of the phonemes linked together to form *syllables*.” Petition, 60-61 (emphasis added). Petitioners allege these constructions are satisfied by Cross’s<sup>7</sup> disclosure of a table with “phonemes representing, to the extent that it is practically feasible to do so, all pronunciations of all the words in a particular language.” *Id.*, 61 (citing Ex. 1010, 6:38-43). Petitioners, however, stop short of identifying syllables in Cross. Instead, Petitioners offer the conclusory statement “[a] POSITA would understand the reference to ‘pronunciations’ in Cross to be synonymous with syllables.” Petition, 61 (citing Ex. 1003, Paragraphs 411-412). Petitioners fail to substantiate this statement.

Petitioners’ expert offers nothing to back up the allegation that pronunciations are synonymous with syllables. Indeed, Paragraph 412 of his declaration is a word-for-word copy with the Petition. *Compare* Petition, 61 *with* Ex. 1003, Paragraph 412.

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<sup>7</sup> Petitioners do not rely on, or even cite to, Ramer for claim limitation [1C]/[27C].

Petitioners and their expert cite to unasserted references to allege that mapping phonemes to syllables was “well known in the art,” but do not explain how or why a POSITA would use those alleged teachings to modify the art asserted in Ground 4. The point is, Petitioners do not allege that Cross explicitly discloses mapping phonemes to syllables and their attempt to map Cross to the constructions is unsupported and improper.

The Petition’s challenge to the remaining two independent claims (14 / 40) fares no better because Petitioners exclusively rely on Ramer to meet the “adaptive misrecognition engine” limitation (Petition, 66-68)—alleging that Ramer discloses a scenario where “the user uttered a word that did not appear in its dataset”—but Petitioners ignore that the relied upon disclosure in Ramer concerns user inputted text “query entry 120.” Ex. 1009, 25:10-25, Fig. 4, 9; *see also* 5:48-67 (“Query entry 120 may be accomplished through the use of a numeric key pad entry, full mobile device keyboard entry . . . .”). Importantly, Ramer distinguishes “query entry 120” from “voice entry 122.” Ex. 1009, 5:48-67. This matters because Petitioners misrepresent Ramer: alleging that when “a user **utters** ‘Coltrain’ . . . [t]he system may misrecognize the word.” Petition, 68 (emphasis added). In Ramer’s example, however, the user doesn’t **utter** Coltrain, they type it. Accordingly, the system doesn’t “misrecognize” what the user typed, so Petitioners again mischaracterize Ramer by alleging the “[s]ystem may misrecognize the word as ‘Coal Train’ or ‘Soul

Train.” Petition, 68 (citing Ex. 1009, 25:10-15). Ramer uses those examples to explain what the system is *not* suggesting; it does not disclose that the system *misrecognized* the user’s typed query as “Coal Train” or “Soul Train.” Ex. 1009, 25:10-15. Petitioners and their expert fail to acknowledge these details of the Ramer reference, highlighting the fundamental weaknesses of Petitioners’ Ground 4 challenge.

These failures of the Petition are fatal and warrant denial on their own. Compounded with the additional discretionary denial factors, these failures strongly favor denial. Additional details as to the merits will be presented in Patent Owner’s Preliminary Response.

#### IV. CONCLUSION

Taken together, the Director Memo factors and the *Fintiv* factors weigh strongly in favor of discretionary denial—all factors either favor denial or are neutral.

For the reasons noted above, Patent Owner respectfully submits that the Board should deny institution of all Grounds of the Petition.

Dated: July 21, 2025

Respectfully submitted,

By: / Christopher TL Douglas /  
Christopher TL Douglas, Reg. No. 56,950

**CERTIFICATION UNDER 37 C.F.R. §42.24**

Pursuant to 37 C.F.R. §42.24(d), I certify that this brief complies with the type-volume limits of 37 C.F.R. §42.24 and the Director Memo because it contains 7,817 words, according to the word-processing system used to prepare this brief, excluding the parts that are exempted by 37 C.F.R. §42.24 (including the table of contents, a table of authorities, a listing of facts which are admitted, a certificate of service or this certificate word count, and appendix of exhibits).

Dated: July 21, 2025

By: / Christopher TL Douglas /  
Christopher TL Douglas

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. §42.6(e), the undersigned hereby certifies that true and correct copies of the foregoing **PATENT OWNER'S DISCRETIONARY DENIAL BRIEF and VB ASSETS EXHIBITS 2002-2022** were served in their entirety on July 21, 2025 by filing this document through Patent Trial and Appeal Case Tracking System (P-TACTS) as well as delivering true and correct copies by electronic mail on Petitioners' lead and backup counsel at the following email addresses (as agreed by counsel for Petitioners):

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