

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

GENGHISCOMM HOLDINGS LLC,
Patent Owner.

Case IPR2025-00899
U.S. Patent 11,431,386

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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I. INTRODUCTION AND SUMMARY OF REASONS FOR DISCRETIONARY DENIAL

Pursuant to the Interim Process for PTAB Workload Management memorandum dated March 26, 2025, Patent Owner GenghisComm requests discretionary denial of the Petition under 35 U.S.C. § 314(a). U.S. Patent 11,431,386 (“the ’386 Patent”) issued in August 2022. The ’386 patent will expire in December 2025.

A parallel District Court proceeding asserting the ’386 patent GenghisComm patents is set for trial 11 months from now on June 15, 2026. The district court trial is set to conclude substantially before a final written decision will issue in this proceeding on November 27, 2026 (i.e. more than **5 months before the FWD**).

Another parallel District Court proceeding asserting 8 other GenghisComm patents is set for trial in 9 months, on April 20, 2026. *GenghisComm v. Samsung*, Case 2:24-cv-0242 (E.D. Tex.). Samsung has filed nine different IPRs against the nine patents in the two district court cases, totaling 33,868 pages. If instituted, these IPRs would not reach a FWD until four-seven months **after** a district court trial. This weighs heavily in favor of discretionary denial.¹

¹ EDTX Case 2:24-cv-0242 involves eight GenghisComm patents; Samsung also delayed before filing IPRs against all eight patents (IPRs 2025-780, -781, -788, -

Further, the Petition also relies on a professional expert's declaration that is 94 pages long and 252 paragraphs to try to fill in gaps in the references, including by making statements with no fact citations. EX1002.²

A. Relevant Dates

The '386 patent will expire in December 2025. GenghisComm filed the District Court litigation involving the '386 patent in November 2024, where the parties have invested mountains of time and money progressing toward their June 2026 trial date and continue to do so. Samsung chose to wait to file its IPR Petition. As a result of Samsung's delay, any final written decision would be expected in late October 2026, *four months after* the district court's trial. Even the expected institution decision is *after* opening and responsive claim construction

789, -790, -791, -792, and -793). Patent Owner has requested discretionary denial in response to each of these petitions.

Additionally, for the '227, '005 and '792 patents, reexaminations are already pending: reexam control nos. 90/019,847 ('005), 90/019,848 ('792), and 90/019,411 ('227 patent).

² Bims' CV is omitted from Exhibit 1002 in this IPR. However, Bim's CV was provided with his declarations in the 8 other IPRs against the GenghisComm patents.

briefs are due in the district court, with the claim construction hearing just three weeks after institution. This does not include the additional months or years required for Director Review or appeal. Below is a summary of relevant dates:

Date	Patent or Litigation Event	IPR Event
Aug. 30, 2022	11,431,386 patent issued	
Nov. 5, 2024	EDTX: Complaint filed	
January 2025	EDTX: Fact discovery opened	
March 27, 2025	EDTX: Samsung served invalidity contentions, including 1,617 pages of claim charts and 1,958 pages of references	
May 27, 2025		IPR filing date accorded
Sep. 27, 2025		Discretionary Denial decision anticipated
Oct. 23, 2025	EDTX: Completion of Claim Construction Discovery	
Nov. 7, 2025	EDTX: Opening Claim Construction Brief and Technical Tutorials	
Nov. 7, 2025	EDTX: Deadline to Substantially Complete Document Production	
Nov. 21, 2025	EDTX: Responsive Claim Construction Brief	
Nov. 28, 2025	EDTX: Reply Claim Construction Brief	
Dec. 5, 2025	EDTX: Joint Claim Construction Chart	
Nov. 27, 2025		Institution decision anticipated
Dec. 19, 2025	EDTX: Claim Construction Hearing	
May 15, 2026	EDTX: Final Pre-trial conference	
June 15, 2026	EDTX: Jury selection	
Nov. . 27, 2026		FWD statutory deadline

II. THE FINTIV FACTORS FAVOR DISCRETIONARY DENIAL

A. The District Court Already Denied Samsung's Request for Pre-Institution Stay; A Post-Institution Stay Is Also Unlikely

The district court case is ongoing toward June 15, 2026 trial and will not be stayed.

Despite the clear and repeated guidance from the Courts in the Eastern District of Texas that no pre-institution stay will be granted, and Samsung's inability to identify any case in which the Courts in the E.D. of Texas stayed a case before the PTAB's institution decision, Samsung nonetheless filed a motion requesting a pre-institution stay on Friday, May 16, 2025 in both district court cases, case #1, Case 2:24-cv-00242-RWS-RSP, and this case #2, Case 2:24-cv-00901-RWS-RSP

On Monday May 19, 2025 the Court entered an Order *sua sponte* (before any response from plaintiff) denying the motion in case #1 and indicated that the case will not be stayed pre-institution. EX2001.

In case #2 relating to this '386 patent, in light of the Order in case #1 and the Court's stated "universal practice" to deny a motion for stay when the Patent Trial and Appeal Board has not yet instituted any petition for inter partes review, patent owner asked Samsung to withdraw its motion to stay in case #2, but Samsung declined. Patent Owner then continued to oppose the stay and asked for its costs and fees for being required to oppose the stay request. EX2002.

Even if the Director were to deny this request for discretionary denial and the PTAB institutes this IPR, it is still unlikely that a district court action would be stayed even post-institution. The district court is unlikely to stay even post-institution unless Samsung can show that IPRs have been instituted on *all* asserted claims and there has been a showing that the PTAB is the Board is *likely to invalidate every asserted claim* in the underlying case. *See, e.g. Scorpcast, LLC v. Boutique Media Pty Ltd*, 2020 WL 7631162, at *3 (E.D. Tex. Dec. 22, 2020), explaining:

Defendants may refile their Motion if the Board institutes on all the asserted claims in this case. to meet its burden, Defendants must address whether the Board is likely to invalidate every asserted claim—a showing that requires more than just pointing to a successful petition.

Samsung has made no attempt to demonstrate that this IPR (1) will be instituted; and (2) that the Board is likely to invalidate every asserted claim. There is insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute IPR trial.

B. The District Court Trial Date Is Four Months *Earlier* than the Statutory Deadline for Final Written Decisions.

District court trial. An FWD in this IPR is not expected until four months *after* the trial date. Director Review and/or appeal would add months or years.

This timing should be dispositive. This case is set for jury selection on June 15, 2026 with the final pretrial conference set for May 15, 2026. EX2004 & EX2005.

The current median time-to-trial in the Eastern District of Texas is 21.6 months, confirming that this trial date will go forward. EX2003.

C. Investment in Parallel Proceedings By Court and Parties

GenghisComm has invested substantially in the parallel proceedings. In addition to all the time, effort, and expense to secure the patents, GenghisComm and its counsel have been working on the matter for well over five years. The '386 patent issued in August 2022, about three years ago. Settled expectations favor denial of institution. *E.g. Irhythm Technologies, Inc. v. Welch Allyn, Inc.*, IPR2025-00363 (Paper 10).

Pre-suit investigation, drafting the complaint, and related work took extensive time. Since the case was filed, GenghisComm has prepared and served its initial infringement contentions, engaged in both offensive and defensive discovery, addressed Samsung's discovery shortcomings, and retained both technical, damages and software code experts. Depositions will soon be scheduled. Software code review will soon be underway, and third-party subpoenas have been issued and should soon produce discovery.

Samsung has also invested heavily in the district court litigation. It has answered 9 interrogatories, produced separate technical documents. A motion based on Samsung's non-infringement defense is now pending. It is defended there by the same law firm that filed this IPR, Greenberg Traurig, which is

reportedly one of the law firms with the highest billing rates in the country.

EX2006. According to one summary, Greenberg's rates range from \$395 per hour for paralegals to \$1,670 per hour for partners. EX2007.

As of now, as its Court appearances and emails reflect, Samsung has identified at least 10 Greenberg lawyers working on the E.D. of Texas case, plus untold additional lawyers unidentified by name but included in the reflector Gt-genghiscomm@gtlaw.com. Samsung's district court case team also includes at least two local counsel, plus paralegal(s), for a total of at least 13 individuals.³

All the expensive Greenberg lawyers and other professionals have produced extensive work product. Back in March 27, 2025, for example, Samsung provided its initial invalidity contentions. This work product included **1,617 pages** of claim charts, relying on 3,575 pages of references. As of today's date, Samsung has produced over 525,000 pages of documents, GenghisComm has produced over 58,000 pages of documents. GenghisComm has answered to 27 interrogatories (plus subparts) over both cases. Discovery and other issues require near daily attention, with deficiencies letters, response letters, additional follow-up, meet-

³ Lawyers from Greenberg working on the E.D. of Texas case include at least Tom Pease, Drew Sommer, Elana Araj, Jared Lee, Stephen Ullmer, Matthew Levinstein, Richard Edlin, Maya Shermann, Trenton Ward, Annie Rock.

and-confer conferences, motions, briefing, and argument. This is anticipated to continue throughout the summer. Any argument by Samsung that its investment in the district court proceedings is small cannot be true.

In addition to discovery, the expected institution decision is right before the district court's claim construction hearing, set for December 19, 2025. EX2004. By that time, claim construction exchanges, including terms, evidence, expert declarations, depositions, as well as briefing, will be well underway with exchanges starting shortly in August 2025. The parties will exchange claim construction expert declarations, which are typically expensive, by September 25, 2025. Expert depositions will be shortly thereafter. By time of the institution decision, claim construction proceedings will be substantially complete and an IPR risks inconsistent claim construction decisions.

The January 26, 2026 expert report deadline means that likely millions more will be spent on experts by that deadline. Most importantly, four months before the PTAB will issue any FWD, a jury trial will have been completed.

The average cost for patent litigation trials is between \$2.3 million and \$4 million, higher for cases seeking damages above \$25M, such as GenghisComm's royalty rate card requires here. EX2008. Samsung's actual investment in the case is likely far higher already and recent fee requests suggest Samsung will spend somewhere between \$6.5 million and \$26 million on the matter. For example, in

Demaray LLC v. Samsung Electronics Co. Ltd., Case 6:20-cv-00636-ADA, Dkt.

No 564, Samsung represented to the Texas Court that:

Samsung and its manufacturer-indemnitor Applied Materials have spent nearly four years, and over \$25 million in legal fees defending against Demaray's baseless litigation claims. Although Demaray's exceptional conduct manifested early in this case, Samsung only requests fees relating to the final phase of this case, in the final four months leading up to and through trial, in the amount of \$6,765,208.40. That is less than a third of the total fees paid and is necessary to deter the conduct exemplified by Demaray's improper litigation tactics.

EX2009.

Similarly, in *Staton Techiya v. Samsung*, case 2:21-cv-00413-JRG-RSP, Dkt. No. 968, p. 19, Samsung sought:

Based on the rates and hours above, Samsung seeks the following fees for Kirkland's work:

Category		Period
1	Attorneys' fees for patent infringement, validity, and damages	\$16,092,589
2	Attorneys' fees for litigating misconduct allegations	\$6,770,143
3	Additional fees for work overlapping categories 1 and 2	\$398,897
4	Fees for paralegals	\$875,513
Total		\$24,137,141

EX2010.

D. The Petition Overlaps with the District Court Proceedings

In district court, Petitioner's March 27, 2025 invalidity contentions included 9 charts specific to the '386 patent. They include the same references that Samsung included with its IPR Petition (Shattil-537, Galda, Brüninghaus,

Dowling) and also includes many, many additional references and combinations.

Samsung purported to include a *Sotera* stipulation within its Petition agreeing that Samsung “will not attempt to prove unpatentability or invalidity on any prior art that it could have reasonably presented in this proceeding in accordance with *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 at 13-14 (PTAB Dec. 1, 2020).” Petition p. 78. But in the district court litigation, Samsung purports to rely on purported “systems prior art” references. Samsung’s March 27, 2024 invalidity contentions include purported “prior art systems” and devices: EX2011, p. 19:

Table 3: Prior Art Systems

System Name	Use/Knowledge/Offer Date	Publisher	Short Name
Motorola SC 4812 (including SC 42812ET)	On or before 2001	Motorola	SC 4812

With respect to systems, Samsung’s invalidity contentions p. 4 also state:

Defendant further reserves the right to supplement its accompanying P.R. 3-4(b) document productions should it later discover additional prior art documents, information, testimony, prior art systems and related documentation, and/or software or hardware code, including information provided by third parties after the date of service of these Invalidity Contention.

With respect to systems, Samsung’s invalidity contentions p. 21 also state:

In addition to contending that the Asserted Claims are invalid in view of the prior art references cited in the claim charts of Exhibits, Defendant further contends that the 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. As discovery is ongoing, Defendant continues to investigate these items and to reserve the right to amend or supplement these contentions to include additional information or documents regarding such products and/or systems.

Importantly, none of Samsung's stipulations state that Samsung will not rely on its product or system references in the District Court action. Samsung's can also still advance a theory of obviousness based on the combination of prior art that is asserted in any ground presented in the Petition with any product or system references. The stipulation does not provide any meaningful limitation.

Therefore, Petitioner's post-petition *Sotera* stipulation will not meaningfully limit the invalidity arguments in district court and IPR will not resolve the validity disputes. Unlike this IPR, the parties' entire dispute, including any validity issues about the purported systems, will be resolved in the Texas litigation. This weighs heavily against institution.

III. ADDITIONAL FACTORS SET FORTH IN THE USPTO'S GUIDANCE MEMORANDUM SUPPORT DISCRETIONARY DENIAL

Following the March 25, 2025 Memorandum, the other factors also weigh

against institution. Although filed after the Memorandum issued, Samsung's

Petition did not address them.

A. Whether the PTAB or another forum has already adjudicated the validity of the patent claims

The validity of the '386 patent claims is an issue in the ongoing district court litigation.

B. Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability

No relevant changes were identified in the Petition and Patent Owner is not aware of anything relevant that would impact an institution decision.

C. The strength of the unpatentability challenge

As discussed below, the Petition relies heavily on a professional expert's declaration. In the District Court litigation, Patent Owner has also identified numerous substantive shortcomings with Petitioner's references, including, for example, Galda.

D. The extent of the petition's reliance on expert testimony

Samsung's Petition extensively relies on a Declaration of Harry V. Bims, EX1002. The Declaration is 94 pages long and 252 paragraphs. It appears that Bims is a professional expert.

The Petition cites Bims' declaration 137+ times and relies on the expert, not the references in the Grounds, to try to meet the patent claims. For example,

Petition p. 31 states:

At the very least, that the generation of Shattil-537's "CI symbols," which may be "derived from at least one invertible transform function, such as a Fourier transform," would obviously have produced *cyclic-shifted pulse waveforms that each has one of the plurality of data symbols modulated thereon* because that would have been understood to be the result of applying complex-valued polyphase codes derived from a Fourier transform to data symbols in the manner shown in Shattil-537. **EX1002, ¶118.**

The Petition cites only Bims' declaration, Exhibit 1002. At the cited paragraph 118, Bims provides only his opinion and cites to no reference or document from the time of the invention:

118. Based on these disclosures, a POSITA would have recognized that generating Shattil-537's "CI symbols" that are "derived from at least one invertible transform function, such as a Fourier transform" would produce "cyclic-shifted pulse waveforms that each has one of the plurality of data symbols modulated thereon." A POSITA would have appreciated that the claimed waveform would result from applying codes derived from a Fourier transform to data symbols discussed by Shattil-537.

As another example, Petition p. 41 argues:

Pulses are orthogonal when they are an integer multiple of $1/T_s$ as a POSITA would have understood. EX1002, ¶151; EX1015, p.22 ("[T]he carriers are linearly independent (i.e., orthogonal) if the carrier spacing is a multiple of $1/T$.").

Bims, exhibit 1002, repeats this same sentence and cites nothing to support it.

Exhibit 1015 is a document by Prasad that is not a reference in the Grounds.

Petitioner's extensive reliance on expert testimony confirms that Petitioner's cited references in the Grounds do not disclose the claim elements. It further suggests that there will be disputes between experts on dispositive issues and that any questions are better resolved in district court. Petitioner's expert declaration is not focused specific testimony limited to helpful context, background or explaining terms of art.

E. Settled expectations of the parties

The '386 patent claims have been in force since 2022. Samsung has been aware that it infringes them since at least November 2024. The claims will expire in 2025. It was solely Samsung's decision to before requesting this IPR.

F. Compelling interests

Patent Owner should not be subjected to proceedings before two different tribunals challenging the claims of one patent, especially after the investment required to try to complete issues before a jury.

IV. CONCLUSION

Patent Owner GenghisComm requests discretionary denial of the Petition under 35 U.S.C. § 314(a).

Case No. IPR2025-00899

U.S. Patent 11,431,386

Respectfully submitted,

Dated: July 24, 2025

/Ragnar Olson/

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CERTIFICATE UNDER 37 CFR § 42.24(d)

Under the provisions of 37 CFR § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner's Preliminary Response totals 2,905 which is less than the 14,000 words allowed under 37 CFR § 42.24(b)(1).

Dated: July 24, 2025

/Ragnar Olson/

Ragnar Olson

Reg. No. 58,684

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that on July 24, 2025, a complete and correct copy of the foregoing PATENT OWNER'S DISCRETIONARY DENIAL BRIEF was served via electronic mail on the following counsel of record for Petitioner:

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