

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

WILUS INSTITUTE OF STANDARDS AND TECHNOLOGY
INC.,
Patent Owner.

Case No. IPR2025-00988
U.S. Patent No. 10,687,281

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

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Order, <i>Wilus Institute of Standards and Technology Inc., v. HP Inc.</i> , Case No. 2:24-cv-00752-JRG-RSP, Dkt. No. 130 (E.D. Tex., June 11, 2025) (“Docket Control Order”)
2002	US 2016/0330300 A1 (Josiah ’300)
2003	Excerpts of Defendants’ P.R. 3-3 and 3-4 Invalidity Contentions and Subject Matter Eligibility Contentions in the consolidated case, <i>Wilus Institute of Standards and Technology Inc., v. HP Inc.</i> , Case No. 2:24-cv-00752-JRG-RSP (E.D. Tex.), dated February 13, 2025.
2004	Docket Navigator Stay Statistics
2005	Excerpt from U.S. District Court – National Judicial Caseload Profile for the Eastern District of Texas, March 31, 2025, https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0331.2025.pdf
2006	Judge Rodney Gilstrap’s median time to trial from July 22, 2024 until July 22, 2025, retrieved from www.docketnavigator.com
2007	D. Crouch, <i>Estoppel Gutted: A Pelican’s Guide to Patent Litigation</i> , Patently-O, https://patentlyo.com/patent/2025/05/estoppel-pelicans-litigation.html (May 7, 2025)
2008	Declaration of Jin Sam Kwak
2009	List of Licensees to Wifi 6 from Sisvel, https://www.sisvel.com/licensing-programmes/Wi-Fi/wifi-6/#tab-list-of-licensees
2010	Letter re “Notice of Wi-Fi 6 License offer” from Sisvel to Samsung Electronics Co., Ltd. with Attachments 1-2, April 8, 2022

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2011	Letter re “Notice of Wi-Fi 6 License offer” from Sisvel to Samsung Electronics Co., Ltd. with Attachments 1-2, January 18, 2023
2012	US 2016/0353322 A1 (Li '322)
2013	European Search Report for Samsung EP21173524.6
2014	Published U.S. Patent Application 2020/267654 A1

I. INTRODUCTION

The Board should exercise its discretion to deny this Petition because the patent at issue is set to be tried in the U.S. District Court in the Eastern District of Texas (“EDTX”) in less than a year, six and a half months *before* the date of the Board’s Final Written Decision. Given the earlier trial date in the District Court, it would not be an efficient use of the Board’s resources to institute this *inter partes* review (“IPR”).

The trial court is already set to resolve Samsung’s invalidity challenges to the patent, which are intertwined with Petitioner’s defenses to infringement and damages issues. Three months prior to filing this Petition, the Petitioner had elected to pursue its invalidity challenges in the district court by serving extensive invalidity contentions, including printed publications, system art, and the references relied on in this Petition, along with many other references and obviousness combinations, as well as additional grounds of invalidity beyond novelty and obviousness. Given that the district court has an earlier trial date and can address all issues of validity concerning the challenged patent, even if a Final Written Decision is reached in this *inter partes* review (“IPR”), the Court would have already decided the issues months before. Therefore, the Director should exercise her discretion to deny the Petition to preserve efficiency and to avoid inconsistent decisions.

Moreover, Samsung has delayed filing its invalidity challenges for years, which is another reason that the Petition should be denied. Samsung knew of the subject matter of the '281 Patent on October 13, 2021, if not earlier, as evidenced by the European search report issued in the prosecution of Samsung's European patent application 21173524.6, citing a Wilus published patent application that was a continuation of the '281 patent and listed the '281 patent on its face. Moreover, Samsung received actual notice of the '281 Patent on April 8, 2022, when it was approached with an offer for a license. Samsung did not file any invalidity challenges during this entire period. There was no *inter partes* review, post-grant review, reexamination request, or request for declaratory relief. And, of course, Samsung did not take a license. Even after the litigation asserting this patent was filed, Samsung waited for eight months to file this IPR. Given Samsung's delays, the IPR should not be instituted.

II. BACKGROUND

A. Background of the '281 Patent

The '281 Patent was filed on June 22, 2018, and issued on June 16, 2020. It is a continuation of PCT Application No. PCT/KR2016/015297, filed on December 26, 2016. SAMSUNG-1001 ('595 patent) at pgs. 1-2. The PCT Application further claims priority to multiple Korean applications filed in

2015 and 2016. '595 Patent at 1:9-28. The '595 Patent lists Juhung Son, Jinsam Kwak, Geonjung Ko, and Woojin Ahn as inventors. Wilus Institute of Standards and Technology Inc. ("Wilus") is the sole assignee of record.

The '281 Patent describes that there is a continued need "for providing a high-efficiency and high-performance wireless LAN communication technology in a high-density environment" and recognizes that "in a next generation wireless LAN environment, communication having high frequency efficiency needs to be provided indoors/outdoors under the presence of high-density stations and access points (AP)." '281 Patent at 2:50-59. The techniques provided in the '281 Patent can advantageously increase the total resource utilization rate, and improve the performance of the wireless LAN system. '281 Patent, 5:10-14. The '281 Patent is utilized by products that implement the Wi-Fi 6 (802.11ax) standard for wireless communications and is widely licensed by the industry.

B. Related Proceedings

The '281 Patent is currently asserted in two pending litigations in the EDTX, both which were filed in September 2024. *Wilus Institute of Standards and Technology Inc., v. HP Inc.*, Case No. 2:24-cv-00752 (E.D. Tex. Sept. 13, 2024); *Wilus Institute of Standards and Technology Inc., v. Samsung Electronics Co. Ltd., Samsung Electronics America, Inc.*, Case No. 2:24-cv-00746

(E.D. Tex. Sept. 11, 2024). On October 23, 2024, the two cases were consolidated with four other cases into the lead case: *Wilus Institute of Standards and Technology Inc., v. HP Inc.*, Case No. 2:24-cv-00752-JRG-RSP (E.D. Tex.) (the “Co-Pending Litigation”). The Co-Pending Litigation is currently before Judge Rodney Gilstrap in the EDTX.

The Co-Pending Litigation is set for trial on June 1, 2026. Ex-2001 *Wilus Institute of Standards and Technology Inc., v. HP Inc.*, Case No. 2:24-cv-00752-JRG-RSP, Dkt. No. 130 (June 11, 2025) (“Docket Control Order”). This trial date is “a deadline that cannot be changed without an acceptable showing of good cause.” Ex-2001 (Docket Control Order) at pgs. 1, 5.

To date, the parties have exchanged infringement and invalidity contentions in the Co-Pending Litigation. Patent Owner served infringement contentions on November 21, 2024; and Petitioner served invalidity contentions on February 13, 2025.

The parties are scheduled to substantially complete document production on November 4, 2025 and complete fact discovery on December 22, 2025. Ex-2001 (Docket Control Order) at pg. 4.

The parties will exchange claim construction proposals in August and September 2025, and brief claim construction issues in November 2025, with

the claim construction hearing currently set on December 16, 2025. *Id.* at pgs. 4-5.

C. This IPR Petition

Petitioner Samsung Electronics Co., Ltd., filed this Petition on May 1, 2025 on all claims of the patent. This Petition was filed eight months after Patent Owner's filing of the Complaint, six months after the infringement contentions, and three months after the Petitioner served invalidity contentions in the Co-Pending Litigation.

The Petition relies on two primary references, Josiam (SAMSUNG-1014) and Bharadwaj (SAMSUNG-1021), and a secondary references Kim (SAMSUNG-1018), Li (SAMSUNG-1023), Chen (SAMSUNG-1025) for certain invalidity grounds. In the Co-Pending Litigation, Defendants explicitly incorporate by reference "all prior art as described in any future inter partes review proceedings of the '281 patent." Ex-2003 (2025-02-13 IC) at pg. 80. The Bharadwaj and Chen references were also specifically charted in the Co-Pending Litigation. Ex-2003 (2025-02-13 IC) at pg. 31-32. Moreover, the Petition's Josiam and Li references were listed in the Co-Pending Litigation as "evidence of the state of the art" for the '281 patent. Ex-2003 (2025-02-13 IC) at pg. 33.

In addition, the sister reference to the Petition's Josiam '608 reference was also charted in the Co-Pending Litigation. *Compare* SAMSUNG-1023 (Josiam '608) *with* Ex. 2002 (Josiam '300); Ex-2003 (2025-02-13 IC) at pg. 31-32. The Josiam '300 in the Co-Pending Litigation shares an assignee, has the same inventors, and has overlapping figures with the Josiam '608 reference in this Petition.

The sister reference to the Petition's Li '171 reference was also charted in the Co-Pending Litigation. *Compare* SAMSUNG-1023 (Li '171) *with* Ex. 2002 (Li '322); Ex-2003 (2025-02-13 IC) at pg. 31-32. The Li '322 in the Co-Pending Litigation shares an assignee, has overlapping inventors, and has overlapping figures with the Li '171 reference in this Petition.

The Petition includes a 203-page expert declaration by Dr. R. Michael Buehrer, and the Petition largely repeats the declaration. *See* SAMSUNG-1003. In many places, the Petition is a verbatim copy of the expert declaration.

III. LEGAL STANDARD

The Director has discretion to deny institution under 35 U.S.C. § 314(a). *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 136 S. Ct. 2131, 2140 (2016). In determining whether to deny institution, *Fintiv* balances considerations such as “system efficiency, fairness, and patent quality.” *Apple Inc. v.*

Fintiv, Inc., No. IPR2020-00019, Paper 11 at 5 (P.T.A.B. May 13, 2020) (precedential) (hereinafter “*Fintiv*”). “When the patent owner raises an argument for discretionary denial under *NHK* due to an earlier trial date, the Board’s decisions have balanced the following factors:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and 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 Board’s exercise of discretion, including the merits.

Fintiv at pgs. 5-6.

The USPTO’s Process Memo¹ enumerated a number of additional considerations for discretionary denial, including:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and

¹ Interim Processes For PTAB Workload Management, Available at <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf> (March 26, 2025).

- Any other considerations bearing on the Director's discretion.

Process Memo at pgs. 2-3.

The USPTO has published guidance about the interim process (the “Interim Guidance”).² For example, Section I.B of the Interim Guidance states that “Parties are encouraged to address any fact or circumstance they believe bears on whether the Office should or should not institute trial, including reasons not discussed in current Board precedent or the Process Memorandum.”

As another example, Section I.D of the Interim Guidance suggests that a *Sotera* stipulation by the Petitioner may be of limited value if it does not materially reduce the overlaps with the co-pending litigation (“The Director will take into account whether the [*Sotera*] 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.”).

Yet another example, the answer to FAQ No. 22 of the former Interim Process FAQs³ states that failure to provide focused expert testimony may

² Interim Director Discretionary Process, Available at <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>.

³ <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>

weigh against institution. FAQ No. 22 (“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.”).

IV. THE BOARD SHOULD DENY INSTITUTION UNDER *FINTIV*

The Board should deny institution under 35 U.S.C. § 314(a) because the *Fintiv* Factors overwhelmingly support denying institution. *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) (“*Fintiv*”).

A. *Fintiv* Factor 1: There is Little to No Likelihood that a Stay Would be Granted in the Co-Pending Litigation

Fintiv Factor 1 favors discretionary denial because no stay of the parallel district court litigation in EDTX has been granted, and there is no evidence that a stay will be granted.

In EDTX, “it is the universal practice” to deny pre-institution motions to stay. *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (“In this district, that is not just the majority rule; it is the universal practice. This Court's survey of cases from the Eastern District of Texas shows that when the PTAB has not

yet acted on a petition for inter partes review, the courts have uniformly denied motions for a stay.”); *CyWee Grp. Ltd. v. Samsung Elecs. Co.*, 17-cv-140, 2019 WL 11023976, *5 (E.D.Tex. Feb. 14, 2019) (“It would have been virtually pointless for Samsung to have sought a stay before the IPR was instituted, as this Court would have almost certainly denied it; the decisions of courts in this district as well as other district courts make that abundantly clear.”). Here, a request to stay has not been filed in the Co-Pending Litigation, and this IPR has not been instituted. It is unlikely that a stay will be granted considering the Court’s precedent.

The facts do not support a stay either. First, the deadline for the Final Written Decision (FWD) is well after the trial date. The trial date in the Co-Pending Litigation is set on June 1, 2026, and it cannot be changed absent an “acceptable showing of good cause.” Ex-2001 (Docket Control Order) at pgs. 1, 5. On the other hand, the date for FWD is on December 16, 2026, more than 6 months *after* the trial date. Since the trial will occur many months before the FWD, a stay is unlikely, and Judge Gilstrap has declined to stay the district court litigation in similar situations. *See, e.g., MyPort, Inc. v. Samsung Elecs. Co., et al.*, No. 2:22-cv-00114-JRG, Dkt. No. 73, slip. op. at 4 (E.D.Tex. June 12, 2023) (denying a stay where the PTAB decision is not due until over two months after jury trial is set to begin); *Orckit Corp. v. Cisco Sys., inc.*, No.

2:22-cv-00276-JRG-RSP, Dkt. No. 56, slip. op. at 2 (E.D. Tex. March 29, 2023 (denying a stay where the FWD is 6 months after the scheduled trial date). Apparently recognizing the unlikelihood of a stay, Samsung has not even bothered to ask the Court for the same.

Second, a stay is unlikely given Petitioner's delay in filing the IPR. Petitioner filed this IPR *years* after it first learned the subject matter of the challenged patent and approached for a license, eight months after Patent Owner filed the district court case and six months after service of the infringement contentions. Judge Gilstrap has found Petitioner's delay in filing the Petition weighs against granting a motion to stay, even if the request to stay is filed today. *See, e.g., Tessera Advanced Techs., Inc. v. Samsung Elecs. Co.*, No. 2:17-cv-00671-JRG, 2018 WL 3472700, *3 (E.D. Tex. July 19, 2018) (finding IPRs filed nine months after initiation of the lawsuit and five months after service of infringement contentions weighed against a motion to stay); *Resonant Sys., Inc. v. Sony Grp. Corp.*, No. 2:22-cv-00424-JRG, Dkt. No. 84, slip op. at 4-5 (E.D. Tex. Jul. 9, 2024) (Judge Gilstrap found that a delayed IPR filing tips the "stage of litigation" factor against a stay, even if claim construction, fact discovery, and expert discovery had not been completed when the motion to stay was filed.).

Even if the IPR is instituted, a stay is statistically unlikely. For example, an analysis of the outcomes for motions to stay pending IPR before Judge Gilstrap demonstrates that the *vast majority* of these motions have been denied. Ex-2004 (Docket Navigator Stay Statistics). In the past five years, only five (5) such motions have been granted, while sixty-five (65) have been denied. In other words, there is no evidence that a stay will ever be granted in the Co-Pending Litigation in view of the Petition. Indeed, like here, where the district court litigation has not been stayed, and any stay is unlikely and at best speculative, allowing this IPR to proceed in parallel would be wasteful and inefficient. *Samsung Elecs. Co. v. Clear Imaging Rsch., LLC*, No. IPR2020-01552, Paper 12 at 12-13 (P.T.A.B. Mar. 3, 2021) (denying institution because, in part, Judge Gilstrap deemed unlikely to stay a case in similar circumstances). Because there is little to no likelihood that the district court will stay the Co-Pending Litigation, *Fintiv* Factor 1 weighs in favor of denying institution.

B. *Fintiv* Factor 2: The District Court's Scheduled Trial Date is More than 6 Months Before the Expected Date of Any Final Written Decision

Fintiv Factor 2 strongly favors discretionary denial because the trial date is months before the date of the FWD. "If a district court's trial date is

earlier than the Board's projected statutory deadline for a final written decision, the Board generally has weighed this fact in favor of exercising discretion to deny institution." *T-Mobile USA, Inc., et al. v. Wireless Alliance*, No. IPR2024-00608, Paper 16 (P.T.A.B. Sept. 3, 2024) (denying institution of IPR).

Jury selection in the Co-Pending Litigation is scheduled to begin on June 1, 2026. Ex-2001 (Docket Control Order) at pg. 1. This trial date cannot be moved absent an acceptable showing of good cause. *Id.* at pg. 5 (trial date is "a deadline that cannot be changed without an acceptable showing of good cause."). However, if the IPR were instituted by the deadline, the FWD would be due six months after the trial, on December 16, 2026. This timing strongly favors discretionary denial. *See, e.g., Lenovo, Inc. v. Universal Connectivity Techs., Inc.*, No. IPR2024-01481, Paper 19 at 10-11 (P.T.A.B. Apr. 17, 2025) (finding Factor 2 strongly favored discretionary denial where Board's final written decision expected six months after trial according to scheduling order or nine months after according to time-to-trial statistics for court); *Roku, Inc. v. IOENGINE, LLC*, No. IPR2022-01553, Paper 11 at 10-11 (P.T.A.B. May 5, 2023) (finding Factor 2 strongly favored discretionary denial where Board's final written decision is expected six months after scheduled trial date).

In addition to the already set trial date, the recent median time-to-trial statistics weigh against institution. Guidance on Interim Procedure⁴ at pg. 3 (“in applying *Fintiv*, the Board may consider any evidence ... including median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides.”). Judge Gilstrap has an average and median time of 24 months from filing to trial over the last 365 days, according to statistics on DocketNavigator. Ex-2006 (DocketNavigator Median Time to Trial Statistics). This timeframe is credible because it aligns with the median time from filing to trial in the EDTX which, according to the Federal Court’s website, is 25.9 months for the 12-month period ending on March 31, 2025. Ex-2005, https://www.uscourts.gov/sites/default/files/2025-02/fcms_na_distpro-file1231.2024.pdf, pg. 35. Accordingly, even considering Judge Gilstrap’s statistics, the trial would still have already occurred several months earlier, i.e., in September 2026, before the FWD in December 2026.

The Board has also consistently found that this factor weighs in favor of denying institution where the projected trial date is before the FWD date. *See, e.g., EClinicalWorks, LLC v. Decapolis LLC*, No. IPR2022-00229, Paper

⁴Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” Available at https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf (March 24, 2025)

10 at 9 (P.T.A.B. 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”); *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, Paper 15 at 13 (P.T.A.B. May 13, 2020) (informative) (finding this factor weighed in favor of discretionary denial and denying institution where the district court trial was scheduled to occur *two months* before the deadline for the Board to reach a final written decision); *Samsung Elecs. Co. v. Secure Wi-Fi LLC*, No. IPR2024-01367, Paper 10 at 12-13 (P.T.A.B. Mar. 24, 2025) (finding that Factor 2 weighed heavily in favor of denial and recognizing Judge Gilstrap’s time-to-trial statistics as lending credibility to scheduled trial date, which was set to occur five months before final written decision deadline). Therefore, the Board should exercise its discretion to deny institution under *Fintiv* Factor 2.

C. *Fintiv* Factor 3: Significant Investment in the Parallel Litigation Will Have Occurred by the Time the Board’s Institution Decision is Due

Factor 3 relates to the “amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv* at 9. This factor favors discretionary denial. The close of fact discovery and the institution decision for this IPR are both due in December

2025. Parties will have expended substantial resources in the Co-Pending Litigation, e.g., for discovery and claim construction briefing, as well as to develop their respective litigation positions, leading up to the due dates.

The parties have been engaged in extensive discovery. The infringement contentions were served on November 21, 2024 and invalidity contentions were served on February 13, 2025. The parties have spent substantial efforts in written discovery. The parties have both issued and responded to interrogatory requests and are conducting third-party discovery. Defendants have also issued requests for admissions to the Patent Owner. Both parties have issued document requests. Petitioner has issued 122 document requests to Patent Owner, and Patent Owner has issued 78 document requests. The parties have produced extensive documents and are disputing certain document requests. Patent Owner has also issued subpoenas for documents and depositions to four third parties, including suppliers of Wi-Fi chips used in Samsung's accused products. It expects that discovery under these subpoenas will be complete in advance of the deadline for the institution decision.

Document production is set to be substantially complete one month prior to the institution decision being due. Ex-2001 (Docket Control Order) at pg. 4. The parties are expected to produce substantial volumes of documents

prior to this deadline. The parties are also expected to invest in resources in motion practice for various disputes arising from the discovery.

Furthermore, given that the close of fact discovery is December 22, 2025 and the deadline for institution is less than a week earlier, the parties will have spent substantial resources to develop their positions prior to institution. Ex-2001 (Docket Control Order) at pg. 4. Defendants have already issued 30(b)(6) deposition notices. The parties are expected to invest significant time and resources in preparing, taking, and defending depositions. The parties will likely have started preparing expert reports prior to the institution decision.

Moreover, the parties will have spent substantial time and resources to prepare claim construction briefs and exchanges. By the time the institution decision is due, claim construction in the Co-Pending Litigation will be fully briefed, and the claim construction hearing will be December 16, 2025, the same day as the institution decision is due. Ex-2001 (Docket Control Order) at pg. 4. This is another factor in favor of discretionary denial. *BOE Tech. Grp. Co. v. Element Capital Com. Co.*, No. IPR2023-00808, Paper 9 at 23-24 (P.T.A.B. Nov. 15, 2023) (denying institution in part because “[s]ignificant discovery has been completed, including the exchange of infringement and invalidity contentions, document requests and interrogatories, and proposed

claim terms for construction, and ... close of fact discovery is near"). Therefore, Factor 3 is also in favor of denial.

D. *Fintiv* Factor 4: There is Substantial Overlap Between the IPR Proceeding and the Parallel Litigation

Factor 4 looks at "whether all or some of the claims challenged in the petition are also at issue in district court" and whether the "petition includes the same or substantially the same claims, grounds, arguments, and evidence" as the parallel district court case. *Fintiv* at 12-13. 12 of the 14 claims of the '281 Patent (i.e. Claims 1-6 and 8-13) are disputed in both the Co-Pending Litigation and this Petition, with only claims 7 and 14 unique to this Petition.

The Co-Pending Litigation and the Petition also overlap considerably on the grounds, arguments, and evidence of invalidity. The validity challenges in the Co-Pending Litigation encompass the challenges in this IPR, as well as additional grounds of invalidity. And the court will adjudicate the validity challenges earlier, prior to the FWD. Allowing this IPR to proceed would result in inefficiencies, waste, and delays; and may cause inconsistencies or tensions between the jury and the PTAB.

Samsung launched a comprehensive challenge to the validity of this patent three months *before* this IPR. Petitioner served extensive, voluminous (over 1000 pages) invalidity contentions which include 13 alleged primary prior art references and 9 alleged prior art systems or products, along with

many other background art and numerous unspecified combinations, all asserted against this patent. *See, e.g.*, Ex-2003 (2025-02-13 IC) at pg. 37-42, 82-84, 171-226. And Defendants' challenges are not limited to those, as they reserved the right to bring in additional grounds. *See, e.g.*, Ex-2003 (2025-02-13 IC) at pg. 2, fn. 1 ("Defendants reserve the right to rely on any contentions served separately" by other defendants in the consolidated district court litigation), pg. 33 ("Some or all of the corroborating references may also separately qualify as prior art publications under 35 U.S.C. § 102 and may be used as invalidating references as 35 U.S.C. §§ 102 and/or 103"). The Petitioner also asserts patent ineligibility under 35 U.S.C. § 101 along with the invalidity contentions.

There are direct overlaps between the references asserted in this IPR and those Samsung relied on in the Co-Pending Litigation. For example of the Petition's two primary references (Josiam and Bharadwaj) and three secondary references (Kim, Li, and Chen), Bharadwaj and Chen were specifically charted as primary references in the Co-Pending Litigation. Ex-2003 (2025-02-13 IC) at pg. 31-32. The Josiam and Li references were listed in the Co-Pending Litigation as "evidence of the state of the art" for the '281 patent. Ex-2003 (2025-02-13 IC) at pg. 33.

Moreover, Defendants explicitly incorporate by reference “all prior art as described in any future inter partes review proceedings of the '281 patent.” Ex-2003 (2025-02-13 IC) at pg. 80. This again confirms that all invalidity challenges in this Petition are also in the Co-Pending Litigation.

The Petitioner's *Sotera* stipulation (SAMSUNG-1051) does not make the IPR proceeding a “‘true alternative’ to the district court proceeding.” *Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020). Although Petitioner stipulates that it will not pursue invalidity grounds in district court that could have been raised under §§ 102 or 103 on the basis of prior art patents or printed publications, and that it will not pursue combinations of the prior art asserted in the IPR with system art, this stipulation is of limited value and does not outweigh the other *Fintiv* factors.

First, the stipulation does not prevent Samsung from raising the same references in the Co-Pending Litigation under the theory that the patent “was known or used by others”. Defendants contend, in the infringement contentions that “the '281 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.” Ex-2003 (2025-02-13 IC) at pg. 79-80. The Federal

Circuit has recently held that “IPR estoppel does 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.” *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1366 (Fed. Cir. 2025). This holding at the very least suggests the possibility that Samsung could present in district court precisely the same combinations of prior art references, not as patent or printed publication “grounds,” but rather as the evidence for “grounds” of what was “in public use, on sale, or otherwise available to the public” (35 U.S.C. § 102(a)(1)). Neither IPR estoppel nor Samsung’s carefully worded stipulation would prevent such an invalidity argument that duplicated the prior art combinations presented in its IPR petition. *See* Ex-2007 (D. Crouch, *Estoppel Gutted: A Pelican’s Guide to Patent Litigation*, Patently-O, <https://patentlyo.com/patent/2025/05/estoppel-pelicans-litigation.html> (May 7, 2025)).

Second, the stipulation does not prevent the same references from being raised in the Co-Pending Litigation by another Defendant. Defendants Samsung and HP in the Co-Pending Litigation *jointly* served invalidity contentions, even though HP did not join this IPR. The joint invalidity contentions also explicitly incorporate by reference the IPRs. Ex-2003 (2025-02-13 IC) at

pg. 80. In other words, the same references raised the Petition can still be litigated in the Co-Pending Litigation, even with Samsung's carefully crafted stipulation.

In addition, the Petitioner has asserted both system art and public knowledge art in the Co-Pending Litigation, including in combinations with patents and printed publications which are not covered by Petitioner's stipulation. *See, e.g.*, Ex-2003 (2025-02-13 IC) at pg. 133 ("Moreover, to the extent Plaintiff contends that an element is not disclosed in any one of the anticipatory references described in Appendix C, such reference may be combined with any other references listed in Appendix C for such element"), pg. 32 fn. 16 ("The attached invalidity chart over IEEE 802.11ac (RB-9) demonstrates how the systems implementing IEEE 802.11ac, listed in Table 2-C, disclose each element of each asserted claim."), pg. 169-170 (listing many dozens of purported combinations of patents and printed publications with systems implementing IEEE 802.11ac or "Knowledge of a person of ordinary skill"). The stipulation has limited value, since the stipulation does not agree to drop all combinations of patents and printed publications with system or public knowledge art. SAMSUNG-1051.

Moreover, the Petitioner also sets forth additional grounds of invalidity in the Co-Pending Litigation. Section I.D of the Interim Guidance explicitly

states that “[w]here the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful.” The Director’s recent decision in *Motorola Solutions, Inc. v. Stellar, LLC* also highlights the non-dispositive nature of this type of stipulation. *Motorola Solutions, Inc. v. Stellar, LLC*, No. IPR2024-01205, Paper 19 at 2, 4 (P.T.A.B. Mar. 28. 2025) (vacating and denying institution because the “Board did not give enough weight to the investment in the parallel proceeding and gave too much weight to Petitioners’ Sotera stipulation.”).

For all of these reasons, Samsung’s stipulation does not meaningfully narrow the invalidity issues in the Co-Pending Litigation or ensure that this IPR is a “true alternative.” Particularly in view of the Federal Circuit’s decision in *Ingenico*, for a stipulation to prevent overlap between the IPR and district court proceedings and to be given weight in avoiding discretionary denial, that stipulation should agree to forgo any use of patents or printed publications as evidence of prior art, whether alone or as a combination, and under any ground, including public use, public sale, and otherwise available to the public grounds. Because Samsung’s stipulation falls far short of doing so, it should not be permitted to outweigh the other *Fintiv* factors that strongly favor denial of institution.

Just as the PTAB's resources are not used efficiently when similar challenges based upon patents and printed publications are pursued by the petitioner in district court, they are also not used efficiently when a Petitioner that fails to invalidate claims in its IPR is free to file *ex parte* reexaminations challenging the same patent on grounds that they could have raised in their IPR. Samsung's failure to address potential subsequent *ex parte* reexaminations in its stipulation is another reason it should be given little weight.

In short, the Petition challenges the claims asserted in the parallel litigation, and the petitioners rely on references that are the same or similar to its IPR references at the district court. And Samsung's carefully worded stipulation does not prevent the art used in this Petition or similar prior art arguments to be made again in the Co-Pending Litigation. This raises substantial "concerns of inefficiency and the possibility of conflicting decisions," weighing against institution. *See Fintiv* at 12. Therefore, Factor 4 weighs strongly in favor of denial.

E. *Fintiv* Factor 5: Petitioner is the Defendant in the Parallel Proceeding

Fintiv Factor 5 weighs in favor of discretionary denial because the parties are the same in both proceedings. *Fintiv*, Paper 11 at 13-14. The Petition has indicated that the real parties-in-interest are Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. These are the same defendants in

Wilus Institute of Standards and Technology Inc., v. Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., No. 2:24-cv-00746 (E.D. Tex.), where the '281 Patent is asserted.

F. *Fintiv* Factor 6: The Petition Lacks Merit

Fintiv Factor 6 weighs in favor of denying institution if the Board deems analysis of this factor necessary.

Given the other *Fintiv* Factors favoring denial, the Board need not consider the merits under Factor 6. *NXP USA, Inc. v. Impinj, Inc.*, No. PGR2022-00005, Paper 18 at 12-13 (P.T.A.B. May 2, 2022) (the Board “need not decide whether the merits of Petitioners’ asserted grounds are particularly strong because it would not impact [their] ultimate determination” since the facts weighing in favor of discretionary denial based on the other factors collectively outweigh the merits.).

But even if the merits of the Petition were to be considered, Factor 6 favors discretionary denial because the Petitioner failed to show a reasonable likelihood of success on any challenged claims, as the Patent Owner expects to set forth in the Patent Owner Preliminary Response.

V. ADDITIONAL CONSIDERATIONS FAVORING DENIAL

1. Petitioner's Use of Expert Testimony Weighs in Favor of Discretionary Denial

Petitioner submitted a 203-page expert declaration along with its Petition. Rather than providing “helpful context or to explain terms of art,” (Interim Process FAQ No. 22), the declaration is riddled with conclusory statements and is essentially a mirror image of the Petition. *See* SAMSUNG-1003.

As one example, Petition's arguments for Ground 1A are nearly identical to the expert declaration. *See, e.g., compare* Petition at pgs. 9-37, *with* SAMSUNG-1003 (Buehrer Decl.) at ¶¶ 158-213. The remaining grounds in the Petition fare no better, as they are similarly lifted from the expert declaration. This “failure to provide focused expert testimony” weighs against institution. Interim Process FAQ No. 22.

Indeed, USPTO has suggested, in its FAQs, “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.” Interim Process FAQ No. 22. The situation here is no different, and the Board should deny institution for efficiency. The Petition is essentially a copycat of the expert declaration, which the Patent Owner plans

to address in its Preliminary Response. Moreover, the Petitioner already pursued the same art in the district court prior to filing this Petition, and the district court will likely adjudicate invalidity issues before the FWD. The district court is in the best and most efficient position to resolve the parties' disputes regarding the validity issues.

2. Petitioner's Delay in Filing the IPR and Wide Licensing Demonstrates Settled Expectation of the Patent's Validity

The USPTO encourages the parties to discuss "any fact or circumstance they believe bears on whether the Office should or should not institute trial, including reasons not discussed in current Board precedent or the Process Memorandum." Section I.B of the Interim Guidance.

The challenged patent is practiced by products that implement the IEEE Wi-Fi 6 standard (802.11ax). This standard has been widely recognized and used by the communications industry. *See* Ex-2008, Kwak Decl. ¶ 3. The patent has been licensed by more than 30 companies in the communications industry, including many well-known names such as Cisco and Lenovo. Ex-2008, Kwak Decl. ¶ 4; Ex-2009 (<https://www.sisvel.com/licensing-programmes/Wi-Fi/wifi-6/#tab-list-of-licensees>). This industry-wide licensing supports an expectation that the patent is valid. *See Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 55-56 (1923) ("the makers of two-thirds of the print paper of the country are licensees" of the plaintiff which

constitutes “very weighty evidence to sustain the presumption from his patent that what he discovered and invented was new and useful.”).

In addition, Samsung delayed filing the IPR despite being aware of patents in the '595 patent family and having received actual notice of the '595 patent itself. The '595 patent was issued on October 11, 2022. On October 13, 2021, the European Patent Office issued an extended European search report in the prosecution of Samsung's European patent application 21173524.6. Ex-2013. This search report cited Wilus's published application US 2020/267654 A1 as reference D1a, defeating the novelty of Samsung's patent application. Ex-2013 at 4-8. This published application is a continuation of the '281 patent and identified the '281 patent by number on its cover. Ex-2014 at 1. Accordingly, Samsung was aware of the '281 patent, and its relevance to technology that Samsung itself was developing, no later than October 13, 2021.

Moreover, Samsung was notified of this Patent on April 8, 2022, when it was sent a letter on Wilus's behalf that identified the '281 Patent as essential to the Wi-Fi 6 Standard and offered Samsung a license to this patent. Ex-2010 (Notice Letter) at 1, 5; Ex-2008, Kwak Decl. ¶ 5. Samsung did not challenge the validity of the '281 Patent for three and a half years after it became aware of its subject matter, and despite receiving the offer to license the '281 Patent three and half years ago. It did not file the IPR until after the Patent Owner

had initiated litigation in the district court. Even then, Samsung waited for nearly nine months to file the IPR.

Although “actual notice of a patent or of possible infringement is not necessary to create settled expectations” (*Dabico Airport Sols. V. AXA Powers ApS*), Samsung’s delay in challenging the validity of the patent after receiving actual notice supports that there is an expectation of the validity of the patent. *Dabico Airport Sols. v. AXA Power ApS*, No. IPR2025-00408, Paper 21 at 3 (P.T.A.B. June 18, 2025). This expectation of validity is further enhanced by the industry’s recognition through licensing agreements with the Patent Owner.

VI. CONCLUSION

Accordingly, the Board should exercise its discretion to deny institution of the Petition.

Dated: August 18, 2025

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CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24

I certify that there are 6,133 words in this paper, excluding the portions exempted under 37 C.F.R. § 42.24(a)(1), according to the word count tool in Microsoft Word.

Dated: August 18, 2025

/Neil A. Rubin/

CERTIFICATE OF SERVICE

I hereby certify that "Patent Owner's Request for Discretionary Denial"
was served on August 18 by email sent to:

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