

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

CM HK LIMITED,
Patent Owner.

IPR2025-01023
Patent 10,852,846

**PATENT OWNER'S
DISCRETIONARY DENIAL BRIEF**

EXHIBIT LIST

Ex. #	Description
2002	<i>Samsung Electronics Co., Ltd., et al., v. CM HK, Ltd. et al.</i> , Case No. 4:24-cv-06567 at Docket 1 (N.D. Cal Sep. 18, 2024), Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc.’s Complaint for Declaratory Judgment
2003	<i>CM HK, Limited, v. Samsung Electronics Co., Ltd., et al.</i> , Case No. 2:24-cv-00880 at Docket 46 (E.D. Tex. June 26, 2025), Defendants Samsung Electronics Co, Ltd. And Samsung Electronics America, Inc.’s Renewed Motion To Stay Pending Resolution Of Any Motion To Dismiss The NDCA Action
2004	<i>CM HK, Limited, v. Samsung Electronics Co., Ltd., et al.</i> , Case No. 2:24-cv-00880 at Docket 47 (E.D. Tex. July 9, 2025), Plaintiff CM HK Ltd.’s Opposition to Defendants’ Motion to Dismiss, Transfer or Stay
2005	<i>Samsung Electronics Co., Ltd., et al., v. CM HK, Ltd.</i> , Case No. 4:24-cv-06567 at Docket 73 (N.D. Cal May, 15, 2025), Order Granting Defendant CM HK, Ltd.'s Motion To Dismiss
2006	<i>Samsung Electronics Co., Ltd., et al., v. CM HK, Ltd.</i> , Case No. 4:24-cv-06567 at Docket 80 (N.D. Cal June 10, 2025), Joint Stipulation and Order to Stay All Deadlines in the Scheduling Order
2007	<i>Samsung Electronics Co., Ltd., et al., v. CM HK, Ltd.</i> , Case No. 4:24-cv-06567 at Docket 72 (N.D. Cal May, 13, 2025), Joint Claim Construction and Prehearing Statement
2008	<i>CM HK, Limited, v. Samsung Electronics Co., Ltd., et al.</i> , Case No. 2:24-cv-00880 at Docket 2 (E.D. Tex. November 1, 2024), Plaintiff’s Original Complaint for Patent Infringement
2009	<i>CM HK, Limited, v. Samsung Electronics Co., Ltd., et al.</i> , Case No. 2:24-cv-00880 at Docket 17 (E.D. Tex. Jan 28, 2025), Plaintiff’s Amended Complaint for Patent infringement

2010	<i>CM HK, Limited, v. Samsung Electronics Co., Ltd., et al.</i> , Case No. 2:24-cv-00880 at Docket 36 (E.D. Tex. Mar. 3, 2025), Docket Control Order
2011	<i>CM HK, Limited, v. Samsung Electronics Co., Ltd., et al.</i> , Case No. 2:24-cv-00880, (E.D. Tex. Jan. 7, 2025), Plaintiff’s P.R. 3-1 & 3-2 Disclosures
2012	<i>CM HK, Limited, v. Samsung Electronics Co., Ltd., et al.</i> , Case No. 2:24-cv-00880, (E.D. Tex. Mar. 4, 2025), Defendants Samsung Electronics Co., Ltd and Samsung Electronics America, Inc’s Local Patent Rule 3-3 Disclosures
2013	Docket Navigator, “Time to Trial for Judge Rodney Gilstrap” (August 7, 2025)
2014	Docket Navigator, “Time to Trial for Eastern District of Texas” (August 7, 2025)
2015	U.S. Patent Publication No. 2011/0199298, Bassompierre et al.
2016	Email from Bratton, Ariell, RE: <i>Samsung v. CM HK, Ltd.</i> , Case No. 4:24-cv-06567 (N.D. Cal.), IPR Threats to Evans, Christopher (May 2, 2025)
2017	March 24, 2025 Director’s Memo, <i>Guidance on USPTO’s rescission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation"</i> , Boalick, Scott R. (August 7, 2025)
2018	Patent Trial and Appeal Board, FAQs for Interim Processes for PTAB Workload Management (accessed August 15, 2025)
2019	U.S. Patent Publication No. 2009/0262074, Nasiri et al
2020	U.S. Patent Publication No. 2011/0163950, Ye et al
2021	U.S. Patent Publication No. 2011/0175806, Ye et al
2022	Declaration of Christopher L. Evans

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Patent Owner CM HK Limited (“CM HK” or “Patent Owner”) respectfully requests that the Board exercise its discretion and deny Samsung Electronics Co., Ltd’s (“Samsung” or “Petitioner”) Petition to institute *inter partes* review of U.S. Patent No. 10,852,846 (the “’846 Patent”). In support of discretionary denial, Patent Owner submits this bifurcated briefing—limited in scope to discretionary denial issues—pursuant to the Director’s March 26, 2025, Memorandum (“Director’s Memo”, Ex. 2017).

I. INTRODUCTION

The Director should deny institution of this IPR under 35 U.S.C. § 314(a) and § 325(d) to deny institution of this IPR. The projected final written decision due date in the Board proceedings is December 20, 2026. The jury selection for the Eastern District of Texas is scheduled for July 6, 2026. Ex. 2010 at 1-3. As such, it is unlikely that a final written decision in these proceedings will issue before district court trial occurs. Additionally, the public has been on notice for 14 years via patent application publications of priority patent applications, the challenged patent has been in force for nearly 5 years and the Petitioner has known about predecessor patents for more than 7 years, creating settled expectations.

Although Patent Owner believes that the facts highlighted above are sufficient evidence for discretionary denial, additional evidence in favor of denial is presented herein for consideration as part of a holistic assessment. Patent Owner submits that

Samsung's Petition is the product of procedural gamesmanship, lacking substantive merit. It seeks to repackage prior art that the Patent Office already considered and to multiply proceedings that are well underway in district court. All of Samsung's invalidity arguments rely on art which Samsung admits are counterparts of U.S. patent publications considered during prosecution of the '846 Patent. Paper 1 at 4. Samsung delayed over four years after the '846 Patent issued before launching this attack—waiting until after it filed declaratory judgment litigation and after CM HK filed suit in Texas. This late filed Petition does not serve the efficiency or integrity of the IPR process.

As detailed below, all six *Fintiv* factors, multiple Director's Memo factors, and § 325(d) support discretionary denial. The district court litigation is active, progressing toward trial in less than a year, and will resolve the parties' validity dispute months before any final written decision. Samsung has not sought a stay of that litigation nor has it provided a *Sotera* stipulation. The Petition relies on expert driven conjecture and prior art already reviewed and rejected by the Patent Office. Allowing this IPR to proceed would only reward procedural gamesmanship while undermining the purpose of the AIA. Discretionary denial is warranted.

II. RELATED LITIGATION

A. The Texas Litigation Filed by CM HK.

On November 1, 2024, CM HK filed a complaint for patent infringement in the Eastern District of Texas accusing Samsung of infringing the '846 Patent (the "Texas Litigation"). Ex. 2008. CM HK's complaint in the Texas litigation also accuses Samsung of infringing U.S. Patent No. 11,698,687 (the "'687 Patent"). *Id.* Specifically, CM HK asserted infringement of claims 1, 3, 7, and 9 of the '846 Patent and claims 1-7, 12, 14, and 25 of the '687 Patent. Ex. 2009 at ¶¶ 99, 106. The case was assigned to District Judge Rodney Gilstrap.

The Texas court issued a Docket Control Order setting the following deadlines:

Jury Selection	July 6, 2026
Pretrial Conference	June 1, 2026
End of Fact Discovery	Feb. 16, 2026
Opening Expert Reports	Feb. 16, 2026
Claim Construction Hearing	January 15, 2026

Ex. 2010 at 1-3.

CM HK served its infringement contentions on January 7, 2025. Ex. 2011 at 6.

Samsung served its invalidity contentions on March 4, 2025. Ex. 2012 at 85.

Samsung filed this IPR against the '846 Patent and IPR2025-01071 against the '687 Patent in June of 2025. IPR2025-01071 Paper 1.

B. The California Litigation Filed by Samsung.

On September 18, 2024, Samsung filed a complaint for declaratory judgment in the Northern District of California seeking only a declaration that it *does not infringe* claims 1 and 7 of the '846 Patent, claims 1, 14, and 27 of the '687 Patent, claims 1 and 13 of U.S. Patent 10,275, 038 (the "'038 Patent"), and claims 1 and 10 of U.S. Patent 10,817,072 (the "'072 Patent") (the "California Litigation"). Ex. 2002 at ¶¶ 1, 72, 78, 84, and 90.

On January 28, 2025, CM HK filed a motion to dismiss for lack of personal jurisdiction.

On March 28, 2025, the parties exchanged proposed terms for construction under Patent L.R. 4-1.

On May 13, 2025, the parties filed their Joint Claim Construction and Prehearing Statement. Ex. 2007.

On May 15, 2025, the Court granted CM HK's motion to dismiss finding Samsung failed to establish that CM HK is subject to the Court's specific jurisdiction. Ex. 2005 at 18. However, the Court allowed Samsung to seek jurisdictional discovery. *Id.* at 19-20.

At the parties' request, the court then vacated all deadlines from the Scheduling Order. Ex. 2006.

C. Prior CyWee Litigation and IPRs Concerning Related Patents.

CyWee Group Limited previously accused Samsung of infringing U.S. Patents 8,441,438 (the “’438 Patent”) and 8,552,978 (the “’978 Patent”) in a suit filed in February 2017 styled *CyWee Group Ltd. v. Samsung Electronics Co. Ltd., et al*, No. 2:17-cv-00140-WCB-RSP (E.D. Tex.) (the “CyWee Litigation”). The ’438 and ’972 Patents are related to U.S. Patent No. 10,852,846 (the “’846 Patent”) at issue here.

CyWee Group, Ltd.¹ also asserted the ’438 and ’978 Patents against Apple, LG, Huawei, HTC, Motorola, Google, and ZTE in the following cases:

CyWee Group Ltd. v. Apple Inc., No. 4:14-cv-01853 (N.D. Cal. 4/22/2014)

CyWee Group Ltd. v. Huawei Technologies Co., Inc. et al, No. 2:17-cv-00495 (E.D. Tex. 6/9/17)

CyWee Group Ltd. v. LG Electronics, Inc. et al, No. 3:17-cv-01102 (S.D. Cal. 5/31/17)

CyWee Group Ltd. v. HTC Corporation et al, No. 2:17-cv-00932 (W.D. Wa. 6/16/17)

CyWee Group Ltd. v. Motorola Mobility LLC, No. 1:17-cv-00780 (D. Del. 6/16/2017)

CyWee Group Ltd. v. ZTE Corp. et al, No. 3:17-cv-02130 (S.D. Cal. 10/17/17)

CyWee Group Ltd. v. Google, Inc., No. 1:18-cv-00571 (D. Del. 4/16/2018)

Petitions for *inter partes* review (“IPR”) were filed by nearly all these defendants and were consolidated into three IPRs: IPR2018-01257, IPR2018-01258 and

¹ CyWee Group, Ltd. is a prior assignee of the portfolio of patents related to the ’846 Patent.

IPR2019-00143. Samsung was granted permission to join IPR2018-01258 and IPR2018-01258. *See* IPR2019-00535, Paper 10 *and* IPR2019-00534, Paper 10.

In the IPRs, all asserted claims of the '438 Patent were found unpatentable:

IPR#	Patent	Unpatentable Claims	Reason
IPR2019-00143	8,441,438	1, 4, 5, 14-17, 19	§103: Yamashita & Bachmann
IPR2018-01258	8,441,438	1, 3-5	§103: Zhang & Bachmann
IPR 2018-01257	8,552,978	10, 12	§103: Zhang & Bachmann

The '846 Patent explicitly overcame multiple rejections based on Bachmann and Yamashita, that was asserted in those IPRs:

Date	Title of Action	Rejections	Cite
11/26/18	Non Final Rejection	35 USC § 102(b): Claims 1 and 9 are anticipated by Yamashita . 35 USC § 103: Claims 2-8 and 10-16 are unpatentable over Yamashita in view of Bachmann .	Ex. 1004 at 111-120.
5/24/19	Final Rejection	35 USC § 103: Claims 1-9 are unpatentable over Yamashita in view of Lu. 35 USC § 103: Claims 2-8 and 10-16 are unpatentable over Yamashita and Lu and Bachmann	Ex. 1004 at 145-155.
9/12/19	Final Rejection	35 USC § 102(b): Claims 1 and 9 are anticipated by Yamashita . 35 USC § 103: Claims 2-8 and 10-16 are unpatentable over Yamashita in view of Bachmann .	Ex. 1004 at 178-190.

1/30/20	Final Rejection	35 USC § 103: Claims 1-4, 7-12, and 15-16 are unpatentable over Yamashita in view of Bachmann .	Ex. 1004 at 225-236.
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III. LEGAL STANDARDS

The Board should deny institution pursuant to discretionary factors committed to the Board's discretion under §314(b), including the Director's Memo factors and *Apple, Inc. v. Fintiv, Inc.* IPR2020-00019, Paper 11 (PTAB March 20, 2020) ("*Fintiv*").

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, Paper 11 at 5-6. The Board takes a “holistic view” of whether efficiency and integrity of the system are best served by denying or instituting review. *Id.*

The Director’s 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.

Further, the Board’s FAQs state: “The 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. 2018 at Q. 12.

IV. DISCRETIONARY DENIAL IS WARRANTED

The Board should deny this Petition because all *Fintiv* factors and at least three of the Director's Memo Factors strongly favor discretionary denial. In particular, the projected final written decision due date in the Board proceedings is December 20, 2026. The jury selection for the Eastern District of Texas is scheduled for July 6, 2026. Ex. 2010 at 1-3. As such, it is unlikely that a final written decision in these proceedings will issue before district court trial occurs. Additionally, the public has been on notice for 14 years via patent application publications of priority patent applications, the challenged patent has been in force for nearly 5 years, and the Petitioner has known about predecessor patents for more than 7 years, creating settled expectations.

A. *Fintiv* Factor 1: The Petitioners Have not Sought a Stay and a Stay is Unlikely to be Granted.

This factor weighs against institution because the Texas Litigation is not stayed, Samsung has not requested a stay pending this IPR, and a stay is unlikely.

Samsung has ***not*** moved to stay the Texas Litigation pending the outcome of this IPR. However, Samsung has sought to stay the Texas Litigation in favor of the California Litigation arguing that litigation in California would be more efficient than in Texas. Ex. 2003. This motion is unlikely to be granted because the Texas Litigation is currently scheduled for trial in July 2026 while all claims were

dismissed and the schedule is vacated in the California Litigation. Ex. 2003 at 10-12; Ex. 2004 (Opposition brief) at 5-8; Ex. 2004 at 21; Ex. 2006 (order vacating schedule at parties' request).

Moreover, even if Samsung were to belatedly seek a stay of the Texas Litigation pending the institution decision for this IPR, that motion would certainly be denied. The Eastern District of Texas has a "consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings." *Luminati Networks Ltd. v. Teso LT, UAB*, No. 2:19-CV00395-JRG, 2020 U.S. Dist. LEXIS 219284, at *3 (E.D. Tex. Oct. 29, 2020); *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV-1047-WCB, 2015 U.S. Dist. LEXIS 29572, at *17 (E.D. Tex. Mar. 11, 2015) ("In this district, [denying pre-institution motions to stay] is not just the majority rule; it is the universal practice."); *Viavi Sols. Inc. v. Zhejiang CrystalOptech Co Ltd.*, No. 2:21-CV-00378-JRG, 2022 U.S. Dist. LEXIS 205106, at *15 (E.D. Tex. Nov. 10, 2022) ("It is the Court's established practice to consider that motions to stay pending IPR proceedings which have not been instituted are inherently premature and should be denied as such."). Even post-institution, Judge Gilstrap, who is presiding over the Texas Litigation, is unlikely to grant a stay absent an agreement from the parties. Exs. 2013 and 2014.

Thus, because the Texas Litigation is not stayed and is very unlikely to be stayed, *Fintiv* Factor 1 weighs heavily in favor of denial.

B. *Fintiv* Factor 2: The Texas Litigation Trial Date is 5.5 Months Before the Board's Projected Deadline.

This factor strongly favors discretionary denial. The Texas Litigation is set for trial on July 6, 2026, which is **five and a half months before** the projected deadline for the Board's final written decision on December 20, 2026.² Ex. 2010 at 1. Time to trial statistics of Judge Gilstrap and the Eastern District of Texas indicate that even under an average timeline the Texas Litigation is more likely than not to commence trial proceedings before the Board's final written decision. Ex. 2013; Ex. 2014.

The Board has repeatedly exercised its discretion to deny petitions for *inter partes* review when the district court trial was set three or more months before the projected final written decision due date. *Samsung Elecs. Co. Ltd. v. Os-New Horizon Pers. Computing Sols. Ltd.*, No. IPR2025-00613, Paper 10 at 2 (P.T.A.B. July 17, 2025) (strongly favoring denial when trial is scheduled 3.5 months before projected final written decision due date); *Samsung Elecs. Am. Inc. v. Collision Comm'n. Inc.*, IPR2025-00011, Paper 12 at 20-21 (P.T.A.B. April 28, 2025) (same when trial seven months before); *Samsung Elecs. Co. Ltd. v. Truesight Comms. LLC*, IPR2024-01477, Paper 12 at 11 (P.T.A.B. April 21, 2025) (same when trial is six months before); *Arm Ltd. et al. v. Daedalus Prime LLC*, IPR2025-00207, Paper 10 at 2 (P.T.A.B. May 16,

² The Notice of Filing Date Accorded to Petition was mailed on June 20, 2025. Paper 3 at 1. A Final Written Decision will therefore be due by December 20, 2026. See 35 U.S.C. § 314(b); 35 U.S.C. § 316(a)(11).

2025) (same when trial was 5 months before); *AT&T Services Inc. et al. v. ASUS Tech. Licensing Inc.*, IPR2024-00992, Paper 14 at 1011 (P.T.A.B. Dec. 16, 2024) (same with trial date 4-5 months before); *Ericsson Inc. et al. v. Active Wireless Techs. LLC*, IPR2024-00886, Paper 8 at 8-9 (P.T.A.B. Nov. 12, 2024) (same with trial date ~ 4 months before); *Linkplay Technology Inc., v. Sonos, Inc.*, IPR2025-00511, Paper 11 (P.T.A.B. July 31, 2025) (same with trial date 2 months before).

Therefore, this factor strongly supports discretionary denial.

C. *Fintiv* Factor 3: The District Courts and Parties Have Heavily Invested Time and Resources in the Parallel Proceedings.

This factor weighs in favor of discretionary denial. Patent Owner served infringement contentions on January 7, 2025. Ex. 2011. And Samsung served invalidity contentions on March 4, 2025. Ex. 2012.

Samsung has repeatedly shown that it is prioritizing its district court proceeding in the Northern District of California over IPR proceedings. The parties have exchanged substantial written discovery. CM HK has served 32 requests for production, 15 interrogatories, 5 requests for admissions, and 1 deposition notice combined in both the Texas and California Litigations. Ex. 2022 at ¶ 4. Samsung has served 96 requests for production, 29 interrogatories, 13 requests for admissions, and 4 depositions notices combined in the Texas and California Litigations. *Id.* at ¶ 5. CM HK has produced 1796 documents and conducted a deposition of a Samsung

fact witness. *Id.* at ¶ 4. Samsung has produced 1154 documents. *Id.* at ¶ 5. CM HK and Samsung have entered into an agreed Stipulated Protective Order with Qualcomm Incorporated, a third-party. *Id.* at ¶ 6. CM HK has undergone the process of retaining experts and scheduling source code review with both Samsung and Qualcomm Incorporated. *Id.*

The parties have already exchanged proposed claim constructions and filed a Joint Claim Construction and Prehearing Statement in the California Litigation. Ex. 2007. A Markman hearing will occur on January 15, 2026, in the Texas Litigation. Ex. 2010 at 3, which is approximately a month after the Board would potentially issue its institution decision in this IPR.

Samsung has known about the '846 Patent since July 29, 2024, when Patent Owner's counsel identified it in an email seeking a pre-suit licensing meeting. Ex. 2002 at ¶¶ 33-34. Moreover, Samsung has known about this patent portfolio since February 2017 when CyWee Group filed suit alleging Samsung infringed the '438 and '970 Patents, which "are in the same family as the ['846 Patent] and cover similar motion sensing technology." Ex. 2002 at ¶¶ 15, 21. The '846 Patent issued on December 1, 2020. Samsung waited 4.5 years from the '846 Patent's issuance and eight months since it filed suit to file this Petition. All the time and effort that the parties have invested in this case could have been saved had Samsung timely

filed its IPR petitions or post-grant review petitions after the patent issued or even if it had filed them before it filed the California Litigation.

The Board has found that this factor favors discretionary denial in similar circumstances. *Immersion Sys. LLC v. Midas Green Techs., LLC*, PGR2021-00104, Paper 15 at 10 (P.T.A.B. Jan. 31, 2022).

Because CM HK and Samsung have expended significant resources in the parallel litigations, this factor weighs in favor of discretionary denial.

D. *Fintiv* Factor 4: The Issues Raised in the Petition Substantially Overlap with Issues Raised in the Texas Litigation and the IPR is not a “true alternative” to the Parallel Litigation.

In considering this factor, the Director should consider whether *inter partes* review would be a “true alternative” to parallel district court litigation. See *Motorola Solutions, Inc. v. Steller, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB March 28, 2025) (Director vacating decision granting institution where the petitioner’s “stipulation does not ensure that these [inter partes review] proceedings would be a ‘true alternative’ to the district court proceeding”).

This factor weighs in favor of discretionary denial because there is substantial overlap in the invalidity theories presented in the Petition and in the Texas Litigation. Petitioner’s invalidity arguments in the Texas Litigation are more expansive, including the two references asserted in these proceedings (Bassompierre and Nasiri), in addition to many others, including unpublished system prior art. Ex. 2011 at 6-11.

Petitioner has not offered a *Sotera* stipulation; so this IPR proceeding would not be a “true alternative” to the Texas Litigation. *Motorola Solutions*, Paper 19 at 4 (holding not a true alternative when “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”).

Accordingly, this factor weighs in favor of discretionary denial.

E. *Fintiv* Factor 5: The Petitioner is a Defendant in the Texas Litigation.

Petitioner Samsung and Patent Owner CM HK are both parties to the District Court Proceeding. *See* Pet. at 1 (related matters). When the parties are the same—like in this case—this factor supports denying institution. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020) (precedential).

F. *Fintiv* Factor 6: The Weakness of the Validity Challenge Favors Discretionary Denial.

Samsung’s IPR petition rests on prior art that is cumulative of references already considered by the Patent Office during prosecution of the ’846 Patent. Samsung’s IPR petition includes only two grounds for invalidity. The first alleges that claims 1, 3, 7, and 9 are obvious under 35 U.S.C. § 103 over a new English language

translation of WO2009/156499 to Bassompierre³, and the second alleges that claims 1 and 3 are obvious under 35 U.S.C. § 103 over the new English language translation of WO2009/156499 to Bassompierre in combination with U.S. Patent No. 8,462,109 to Nasiri (“Nasiri”). Paper 1 at 3. Samsung’s IPR admits that respective U.S. equivalent or related patent application publications for both WO2009/156499 and Nasiri were considered by the Patent Office during prosecution of the ‘846 Patent. Paper 1 at 4.

WO2009/156499 is published in French for International Patent Cooperation Treaty Application No. PCT/EP2009/058024. Ex. 1005. US2011/0199298 is the U.S. Patent Application Publication No. of U.S. Application No. 13/001,307 which is a national stage entry application of International Patent Cooperation Treaty Application No. PCT/EP2009/058024. Ex. 2015 at 1. US2011/0199298 there has been accepted by the USPTO as an official translation of WO2009/156499. Samsung provides no explanation as to why its latest English translation should be relied upon instead of the official translation in US2011/0199298.

³ Note that the Petition refers to both WO2009/156499 (Ex. 1005) and the new English translation of WO2009/156499 (Ex. 1006) as “Bassompierre”. To avoid conflating these two documents, “Bassompierre” is not used as a shorthand herein.

U.S. Patent No. 8,462,109 (Nasiri) claims priority to U.S. Patent Application No. 12/398,156. Ex. 1008 at 1. This priority application was published as U.S. Patent Application Pub. No. 2009/0262074. Ex. 2019 at 1.

US2011/0199298 and US2009/0303204 were both on an Information Disclosure Statement submitted by the Applicant during prosecution of the '846 Patent on June 2, 2017 and marked as considered by the Examiner on November 26, 2018. Ex. 1004 at 103 and 123. Further, both of these references appeared in the Examiner's search results. *Id.* at 331.

All of Samsung's arguments therefore rest on art that is cumulative of references already considered by the Patent Office during prosecution of the '846 Patent. Samsung seeks to relitigate these same disclosures by reintroducing them through different publication numbers in an effort to evade 35 U.S.C. § 325(d). *NHK Spring Co. Ltd. v. Intri-Plex Techs. Inc.*, IPR2018-00752, Pap. 8 (Sept. 12, 2018) (precedential) (The Board denied institution on Section 325 grounds because the same art and grounds were considered during prosecution).

The Board has made clear that discretionary denial is appropriate where "the same or substantially the same prior art or arguments previously were presented to the Office." *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). Under the two-part *Advanced Bionics* framework, the key questions are: (1) whether the art or

arguments are the same or substantially the same as those previously presented to the Office and (2) if so, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Id.*

Samsung fails both prongs. First, it admits that the U.S. equivalents of the art were considered—meaning the substance of the references was before the Office. The fact that the examiner did not rely on those references in a rejection is irrelevant under *Advanced Bionics*, which focuses on whether the art or arguments were presented, not whether they were dispositive. *Id.* The Director has recently, unequivocally stated, “Challenging the claims using the same prior art that was previously presented on an IDS is sufficient to satisfy the first part of the *Advanced Bionics* framework.” *Ecto World, LLC v. Rai Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 4 (PTAB May 19, 2025) (precedential).

Second, Samsung offers no credible argument that the examiner materially erred in failing to reject claims over the U.S. versions of Bassompierre or Nasiri. Instead, Samsung repackages the same technical disclosures without identifying any substantive differences in teachings.

In summary, the references in Samsung’s Petition are not new, and the arguments are not meaningfully different. They were before the examiner and considered during prosecution. The Petition should be denied under § 325(d) because it presents

no materially new issues of patentability and offers no justification for reexamining what the Patent Office has already reviewed.

G. The Petition’s Heavy Reliance on Expert Testimony Favors Discretionary Denial.

This factor favors denial because Petitioner relies heavily on expert argument, assumptions and inferences to fill in the gaps of the prior art to allegedly arrive at the claimed invention. Petitioner has relied heavily on its expert declaration, citing to it at least 103 times over the course of the Petition. *See generally* Pet. (citing “1002”). Yet its declarant added little value to its analysis, frequently relying on conclusory statements and repeating/rewording the contents of the legal brief. *See* Ex. 1002. Such conclusory analysis is not helpful to the trier-of-fact and Petitioner’s heavy reliance on it is another reason that the Petition should be discretionarily denied.

Worse, Petitioner’s expert makes various assumptions and conjecture unsupported by the specifications to explain how Bassompierre “suggests” various limitations that it is missing. For example, Petitioner’s expert is relied upon to show that “a POSA would have been motivated to modify equation 21 [in Bassompierre] to include quaternions instead of Euler angles” because the claims of the ’846 Patent require quaternions. Paper 1 at 35; Ex. 1002 at ¶¶ 55-56.

This extensive reliance on expert testimony to fill gaps in the prior art strongly favors discretionary denial.

H. The Settled Expectations of the Parties Favor Discretionary Denial.

Instituting this IPR would unjustly deprive CM HK of its reasonable and settled expectation that it may rely on its property rights in the '846 Patent. The Board has found that challenged patents that have been in force for eight years have a strong settled expectation to not be disturbed. *Dabico Airport Sols. Inc. v. AXA Power Aps*, IPR2025-00408, Paper 21 at 2-3 (Director June 18, 2025). The '846 Patent issued from U.S. Patent Application No. 15/611,970 filed on June 2, 2017, which is a continuation of U.S. 13/072,794, filed on March 28, 2011, which is a continuation-in-part of U.S. 12/943,934 filed on November 11, 2010, which claims priority to Provisional U.S. Patent Application No. 61/292,558 filed on January 6, 2010. Ex. 1001 at 1-2. The first patent publication in this family is of U.S. 12/943,934 published as U.S. Patent Application Pub. No. 2011/0163950 A1 on July 7, 2011. Ex. 2020 at 1. The first patent publication following a continuation-in-part priority claim is of U.S. 13/072,794 published as U.S. Patent Application Pub. No. U.S. 2011/0175806 A1 on July 21, 2011. Ex. 2021 at 1. Thus, the public has been on notice of the subject matter claimed in the '846 Patent for 14 years. Petitioner has known about the '846 Patent's predecessor patents since February 2017 and has known about the '846 Patent since at least last July (2024). Ex. 2002 at ¶¶ 32-34.

Additionally, the Patent will expire in November 2030—about four years after a final written decision would issue in this IPR. The district court is a better forum to resolve invalidity issues in this circumstance.

CM HK can show it has expended extraordinary amounts of time, investments and resources dedicated to the research and development of the subject matter for the '846 Patent. *Amgen, Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, -00602, and -00603 (PTAB July 24, 2025). The inventors of the '846 Patent have spent the better part of two decades researching and developing the patent-at-issue.

CM HK is a small company. It would clearly impose undue inequities to force CM HK to litigate in three forums (Texas, California and PTAB) against Samsung Electronics, a large Korean corporation, and Samsung Electronics America, a large America corporation. Further, considering the early priority date of the '846 Patent and the limited amount of time remaining in its term, it would disrupt CM HK's settled expectations to have the Board reconsider the patentability of the challenged claims at this late date and would not be an efficient use of the Board's finite resources.

I. Samsung's Conduct Warrants Discretionary Denial.

Samsung's conduct in this case does not reflect a genuine desire to resolve a concrete dispute, but a calculated effort to delay adjudication, increase CM HK's litigation costs, and preserve procedural leverage at every turn. Congress created

inter partes review as a “quick and cost effective alternative to litigation”—not a tactical supplement to it. See H.R. Rep. No. 112-98, at 48 (2011); S. Rep. No. 110–259, at 20 (2008). But Samsung has treated the IPR process not as an alternative, but as a weapon—an auxiliary front in a campaign of procedural attrition.

In an attempt to preserve its ability to challenge CM HK’s patents in the PTAB, Samsung deliberately limited its declaratory judgment complaint in the California Litigation to claims for non-infringement, omitting any invalidity claims. Ex. 2002. That strategic omission was no accident. It was a maneuver designed to skirt the statutory bar of 35 U.S.C. § 315(a)(1), which prohibits a petitioner from pursuing IPR if it has already “filed a civil action challenging the validity of a claim of the patent.” Samsung’s approach undermines the congressional intent behind this provision: to prevent exactly this kind of forum manipulation.

Additionally, Samsung has threatened to file two more IPRs against patents CM HK is not asserting. See Ex. 2016 at 1–2. These are not the actions of a party seeking efficient resolution; they are the hallmarks of a party intent on procedural proliferation.

This tactic—maintaining a simultaneous district court action while initiating and threatening IPRs—runs directly counter to the AIA’s design. The PTAB has emphasized that AIA trials must be “just, speedy, and inexpensive.” 77 Fed. Reg. 48756, 48758 (Aug. 14, 2012). Samsung’s conduct flouts these principles.

In other words, Samsung’s approach *avoids* a speedy, just and efficient resolution and gives it a strategic advantage. It directly contravenes the purpose of IPRs. *See* Changes to Implement *Inter Partes* Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680 (Aug. 14, 2012) (codified at 37 C.F.R. §§ 42.100 et seq.) (establish a “streamlined” system that “limit[s] unnecessary and counterproductive litigation costs.”); 37 C.F.R. § 42.1(b) (the rules “shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.”). A number of factors demonstrate why denial is justified under such circumstances.

In doing so, Samsung also undermines the statutory estoppel framework Congress enacted to ensure that petitioners could not take a second bite at the apple across multiple forums. 35 U.S.C. § 315(e). Samsung’s coordinated litigation tactics seek not to comply with those estoppel provisions—but to dodge them.

Taken together, these facts show that Samsung’s procedural posture is not consistent with the purpose of the AIA, but instead reflects a conscious effort to circumvent its constraints. That conduct supports the inference that Samsung’s primary aim is not to resolve the dispute efficiently, but to create litigation leverage by exponentially increasing the costs. The Board should send a clear message that IPRs are not available to parties that seek to game the system and abuse patent holders in this way.

Therefore, Samsung's conduct also strongly supports discretionary denial.

V. CONCLUSION

Samsung's Petition is untimely, duplicative, and procedurally abusive. It relies on cumulative prior art already reviewed during prosecution, offers no meaningful justification for reexamination, and seeks to relitigate issues that will be resolved in district court before a final written decision would issue. The Petition is not a true alternative to litigation but an additional front in a campaign of procedural attrition.

All six *Fintiv* factors favor denial. The Director's Memo Factors independently support denial, especially the weakness of the merits, the reliance on expert speculation, and the settled expectations of the parties. Samsung's conduct—filing overlapping lawsuits and IPRs, while withholding invalidity arguments in district court—exemplify the kind of forum manipulation § 314(a) and § 325(d) were designed to prevent.

Based on the foregoing, the Board should deny institution.

Respectfully Submitted,

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CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))

This Patent Owner's Brief on Discretionary Denial complies with the type-volume limitation pursuant the Director's Memo and consistent with the 37 C.F.R. § 42.24, I certify that this Brief in Support of Discretionary Denial complies with the type-volume limits of the Director's Memo because it contains fewer than 14,000 words. The word processing system used to prepare this brief counts 5,341 words excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

Respectfully submitted,

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August 18, 2025
Date

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

The undersigned hereby certifies that the above document was served
August 18, 2025 by filing this document through the Patent Trial and Appeal Case
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