

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.
Petitioner

v.

CM HK LIMITED
Patent Owner

Case No.: IPR2025-01023
Patent No. 10,852,846

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
MOTION FOR ADDITIONAL DISCOVERY**

CM HK's Motion for Additional Discovery (Paper 44) rests on a false premise: that Samsung's Opposition to CM HK's Motion for Sanctions (Paper 38) argued that Samsung subjectively believed the May 13, 2025 Joint Claim Construction and Prehearing Statement ("JCCS") waived indefiniteness. Rather than speak about Samsung's subjective belief, Paper 38 addressed a legal question—what the JCCS objectively accomplished as a matter of record. Because the JCCS provided the "full list of all disputed terms," supplied concrete constructions for every term, and represented that no disputed term was case or claim dispositive, the JCCS made clear that Samsung was not arguing indefiniteness in the CM HK litigation. Paper 38 at 3-7; Ex. 2007 at 2-3.

CM HK contends that because the privilege "extends only to communications, and not to facts," Samsung's subjective beliefs are discoverable. Paper 44 at 2 (quoting *Upjohn Co. v. United States*, 449 U.S. 383, 395-96 (1981)). But CM HK itself recognizes that it is after privileged communications, asserting that Samsung has "waive[d] the attorney-client privilege" and explaining that it is entitled to "the communications that prove or disprove" Samsung's subjective belief. *Id.* CM HK's broad view as to the discoverability of privileged communications is fundamentally at odds with how courts treat privileged communications. *See Upjohn*, 449 U.S. at 393 ("An uncertain privilege, or one which purports to be certain but results in widely varying applications by the courts, is little better than no privilege at all.").

Waiver may occur where a privilege holder relies on advice of counsel as

a defense. *See In re EchoStar Commc'ns Corp.*, 448 F.3d 1294, 1301 (Fed. Cir. 2006). But Samsung has not done so here. Samsung's opposition to CM HK's motion for sanctions explained that: (1) the JCCS was dispositive (Paper 38 at 3-7); (2) Samsung's "never alleged" language was directed to the CyWee Case and in any event was mitigated by the JCCS (*id.* at 8); (3) CM HK took an inconsistent position in district court with respect to claim construction (*id.* at 8-9); (4) even accepting *arguendo* that there was a brief interval before the IPR petition was filed in which Samsung reserved indefiniteness in district court, any such reading is immaterial to the issues CM HK raised (*id.* at 10-12); (5) CM HK was not prejudiced (*id.* at 12-14), and (6) CM HK's motion violated the Board's rules (*id.* at 14-15). None of those arguments rest on Samsung's subjective beliefs. The duty of candor argument (Paper 44 at 1-2) does not bridge the gap: Rule 42.11 measures whether what a party told the Board was accurate, and Samsung's privileged communications regarding Samsung's subjective belief are not relevant to that.

Asked at the parties' meet-and-confer to identify where Paper 38 made a subjective-belief argument, CM HK could not. Ex. 3003 at 1-2. Its sanctions reply (Paper 40) never made that assertion either, and in fact did not dispute Paper 38's showing that CM HK mischaracterized the JCCS and took a position irreconcilable with its own district court filings, among other issues. Paper 38 at 4-5, 8-12. CM HK's motion for additional discovery itself only references Paper

38 once. Paper 44 at 1-2. But none of the statements CM HK references rely on Samsung's or counsel's state of mind.

Additional discovery must be “necessary in the interests of justice.” 37 C.F.R. § 42.51(b)(2); *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6-7 (PTAB Mar. 5, 2013) (precedential). The *Garmin* factors are not satisfied. *First*, CM HK must possess evidence tending to show beyond speculation that something useful will be uncovered; CM HK instead speculates that confirming documents “must exist” and that “[t]heir absence would be equally dispositive.” Paper 44 at 2. *Second*, *Garmin* protects a party's litigation positions and the basis for them—precisely what CM HK seeks. *Third*, the public papers are the information that Samsung relied on to respond to CM HK's sanctions motion, not advice of counsel or other privileged communications that may reflect Samsung's subjective beliefs. *Fourth*, the request is not easily understood because it defines responsiveness by what Samsung “believed.” Paper 44 at 1. *Fifth*, the request is burdensome because it spans eight months and reaches attorney-client communications and work product across two district court actions and these proceedings. *See also* Paper 33 at 6-8.

CM HK's alternative request—a stipulation that Samsung “never believed” the JCCS waived indefiniteness (Paper 44 at 1)—is also based on a false equivalence: Samsung's subjective beliefs are not part of Samsung's defense to CM HK's sanctions motion, so there is no basis to require Samsung to stipulate one way or the other about Samsung's subjective beliefs.

Respectfully submitted,

Dated: August 14, 2026

By: /Naveen Modi/
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CERTIFICATE OF SERVICE

I hereby certify that on August 14, 2026, I caused a true and correct copy of the foregoing Petitioner's Opposition to Patent Owner's Motion for Additional Discovery to be served by electronic means on the following practitioners of record for Patent Owner:

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