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. IPR2025-01110
U.S. Patent No. 11,716,171

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Order, *Wilus Institute of Standards and Technology Inc., v. HP Inc.*, Case No. 2:25-cv-00069-JRG-RSP, Dkt. No. 51 (E.D. Tex., June 13, 2025) ("Docket Control Order")
2002	Intentionally Omitted
2003	Excerpts of Defendants' P.R. 3-3 and 3-4 Invalidity Contentions and Subject Matter Eligibility Contentions in the consolidated case, *Wilus Institute of Standards and Technology Inc., v. HP Inc.*, Case No. 2:25-cv-00069-JRG-RSP (E.D. Tex.), dated July 9, 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 August 25, 2024 until August 25, 2025, retrieved from www.docketnavigator.com
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)
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

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, four 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. The Petitioner has elected to pursue its invalidity challenges in the district court by serving extensive invalidity contentions, including printed publications, system art, and each of 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 received actual notice of U.S. Patent No. 10,911,186, the parent by continuation of the '171 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 almost four and a half months to file this IPR. Given Samsung's delays, the IPR should not be instituted.

II. BACKGROUND

A. Background of the '171 Patent

The '171 Patent was filed on January 11, 2021, and issued on August 1, 2023. It is a continuation of U.S. Patent No. 10,911,186, filed on April 8, 2019, which is a continuation of U.S. Patent No. 10,305,638, the national stage of PCT Application No. PCT/KR2016/02199, filed on March 4, 2016. SAMSUNG-1001 ('171 patent) at pgs. 1-2. The PCT Application further claims priority to multiple Korean applications filed in 2015. '171 Patent at 1:9-19. The '171 Patent lists Woojin Ahn, Yongho Kim, Jinsam Kwak, and

Juhyung Son as inventors. Wilus Institute of Standards and Technology Inc. ("Wilus") is the sole assignee of record.

The '171 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 (APs)." '171 Patent at 2:37-46. The techniques provided in the '171 Patent can advantageously improve the efficiency and reliability of the wireless LAN system while reducing unnecessary channel occupancy and increasing spectral efficiency. '171 Patent, 3:61-4:11. The '171 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 '171 Patent is currently asserted in two pending litigations in the EDTX, both of which were filed in January 2025. *Wilus Institute of Standards and Technology Inc., v. HP Inc.*, Case No. 2:25-cv-00069 (E.D. Tex. Jan. 23, 2025); *Wilus Institute of Standards and Technology Inc.*, v. *Samsung Electronics Co. Ltd.*, *Samsung Electronics America, Inc.*, Case No. 2:25-cv-00070

(E.D. Tex. Jan. 23, 2025). On March 25, 2025, the two cases were consolidated into the lead case: *Wilus Institute of Standards and Technology Inc., v. HP Inc.*, Case No. 2:25-cv-00069-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 August 17, 2026. Ex-2001 *Wilus Institute of Standards and Technology Inc., v. HP Inc.*, Case No. 2:25-cv-00069-JRG-RSP, Dkt. No. 51 (June 13, 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, 6.

To date, the parties have exchanged infringement and invalidity contentions in the Co-Pending Litigation. Patent Owner served infringement contentions on May 14, 2025, and Petitioner served invalidity contentions on July 9, 2025.

The parties are scheduled to substantially complete document production on January 15, 2026, and complete fact discovery on March 30, 2026. Ex-2001 (Docket Control Order) at pgs. 4-5.

The parties will exchange claim construction proposals in October and November 2025, and brief claim construction issues in January 2026, with the claim construction hearing currently set on February 26, 2026. *Id*. at pgs. 5-6.

C. This IPR Petition

Petitioner Samsung Electronics Co., Ltd., filed this Petition on June 9, 2025 on all claims of the patent. The Petition relies on three references: Kim (SAMSUNG-1006), Chu (SAMSUNG-1019), and Choi (SAMSUNG-1010). Each of these three references was specifically charted as prior art in the Co-Pending Litigation. Ex-2003 (2025-07-09 IC) at pg. 26-28.

The Petition includes a 138-page expert declaration by Dr. Zhi Ding, 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 Memo[1] 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
- 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

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

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

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.").

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 August 17, 2026, and it cannot be changed absent an "acceptable showing of good cause." Ex-2001 (Docket Control Order) at pgs. 1, 6. On the other hand, the date for FWD is on December 24, 2026, more

than 4 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.

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 4 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 August 17, 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. 6

(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 more than four months after the trial, on December 24, 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 time-to-trial statistics weigh against institution. Guidance on Interim Procedure[3] 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 23 months

[3]Guidance on USPTO's recission 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_recission_20250324.pdf (March 24, 2025)

and 24 months respectively from filing to jury 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 is based on a total of 13 trials, and 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. Even assuming the jury trial occurred 23 months after the January 23, 2025 date the case against Samsung was filed, in accordance with Judge Gilstrap's average time to trial, the trial would still at approximately the same time the FWD would be expected in December 2026. The fact that a significant majority—8 out of 13—of the cases that reached a jury trial before Judge Gilstrap over the past 365 days did so in less than 24 months—together with the more than four months between the scheduled trial date and the expected FWD date—at the very least creates a very high likelihood of significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions.

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

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 institution decision for this IPR is 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 May 14, 2025, and invalidity contentions were served on July 9, 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. In the broader set of litigation between the parties, 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 less than one month after the institution decision is due. Ex-2001 (Docket Control Order) at pg. 5. 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.

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 exchanges in the Co-Pending Litigation will have occurred, and the claim construction hearing will be only two months away. Ex-2001 (Docket Control Order) at pgs. 5-6. 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. The same 16 claims of

the '171 Patent (i.e. Claims 1-16) are disputed in both the Co-Pending Litigation and 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 19 alleged primary prior art references and 21 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 (2025-07-09 IC) at pg. 26-32, 46-48, 89-122. And Defendants' challenges are not limited to those, as they reserved the right to bring in additional grounds. *See, e.g.*, Ex-2003 (2025-07-09 IC) at pg. 30 ("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 complete overlap between the references asserted in this IPR and references Samsung relied on in the Co-Pending Litigation. That is, each of the Kim, Chu, and Choi references was specifically charted as a primary prior art reference in the Co-Pending Litigation. Ex-2003 (2025-07-09 IC) at pg. 26-28.

Moreover, Defendants explicitly incorporate by reference "the petition for *inter partes* review of the '171 patent (PTAB-IPR2025-01110) filed on June 9, 2025, including the accompanying exhibits and expert declaration." Ex-2003 (2025-07-09 IC) at pg. 28. This again confirms that all invalidity challenges in this Petition are also in the Co-Pending Litigation.

The Petitioner's *Sotera* stipulation (SAMSUNG-1018) 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 invalidity contentions that "the '171 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 (2025-07-09 IC) at pg. 46. 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 (2025-07-09 IC) at pg. 47. 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 (2025-07-09 IC) at pg. 99-89 ("To the extent Plaintiff contends that an element is not disclosed in any one of the anticipatory references described in Appendix B, the limitation would have been obvious in light of the disclosures within the reference and the knowledge of one of skill in the art at the time of the '171 patent. Moreover, to the extent Plaintiff

contends that an element is not disclosed in any one of the anticipatory references described in Appendix B, such reference may be combined with any other references listed in Appendix B for such element"), pg. 29 fn. 15 ("The attached invalidity chart over IEEE 802.11ac (RB-17) demonstrates how the systems implementing IEEE 802.11ac, listed in Table 2-B, disclose each element of each asserted claim.").

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. 2:25-cv-00070 (E.D. Tex.), where the '171 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 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 its parent patent and having received actual notice. Samsung was notified of the parent by continuation of the '171 Patent on April 8, 2022, when it was sent a letter on Wilus's behalf that identified that parent U.S. Patent No. 10,911,186 as essential to the Wi-Fi 6 Standard and offered Samsung a license to the '186 Patent. Ex-2010 (Notice Letter) at 1, 4; Ex-2008, Kwak Decl. ¶ 5. Samsung did not challenge the validity of the '186 patent or the '171 patent despite receiving the offer to license the '186 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 four and a half 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 Director should exercise her discretion to deny institution of the Petition.

Dated: August 25, 2025 */Neil A. Rubin/*

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

I certify that there are 5,245 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 25, 2025 */Neil A. Rubin/*

CERTIFICATE OF SERVICE

I hereby certify that "Patent Owner's Request for Discretionary Denial" was served on August 25, 2025 by email sent to:

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