

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
AND SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

HANNIBAL IP LLC,
Patent Owner.

Case IPR2025-01188
Patent No. 11,272,535 B2

**PATENT OWNER HANNIBAL IP LLC's REQUEST TO DIRECTOR FOR
DISCRETIONARY DENIAL OF PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT 11,272,535**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	FACTUAL BACKGROUND.....	2
	A. The '535 Patent	2
	B. Samsung's Prior Knowledge of the '535 Patent and Other Patents	5
	C. The Litigation Between Hannibal and Samsung.....	6
	D. Schedule in this IPR Proceeding	7
III.	INSTITUTION OF INTER PARTES REVIEW SHOULD BE DENIED	7
	A. The Unpatentability Challenge is Weak	7
	1. Overview of Petition	8
	2. None of the References in Either Ground 1 or Ground 2 Render The Challenged Independent Claims Obvious.	9
	3. The Art Relied on in Grounds 1 and 2 is Substantially the Same as Art Presented During Prosecution.	12
	B. The Petitioner Relied Heavily on Expert Testimony	14
	C. Patent Owner had Established Expectations Based Samsung's Longstanding Knowledge of the '535 Patent.....	15
	D. Other Factors	17
	1. Trial Likely to Occur Before Projected FWD.....	17

2.	A Stay of the District Court Proceedings is Unlikely	18
IV.	CONCLUSION.....	19

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple, Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (March 20, 2020)	1
<i>AR Design Innovations LLC v. Ashley Furniture Indus., Inc.</i> , No. 4:20-cv-392-SDJ, 2021 WL 6496714 (E.D. Tex. Jan. 11, 2021)	18
<i>DSS Tech. Mngt., Inc. v. Apple Inc.</i> , 885 F.3d 1367 (Fed. Cir. 2018)	14, 15
<i>EClinicalWorks, LLC v. Decapolis LLC</i> , IPR2022-00229, Paper 10 (P.T.A.B. Apr. 13, 2022)	17
<i>Ericsson Inc. v. Active Wireless Techs. LLC</i> , IPR2024-00886, Paper 8 (P.T.A.B. Nov. 12, 2024).....	17
<i>Intel Corp., v. Interdigital, Inc.</i> , IPR2024-01441, Paper 13 (P.T.A.B. April 1, 2025)	13
<i>iRhythm Techs., Inc. v. Allyn</i> , IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025)	16
<i>Luminati Networks Ltd. v. Teso LT, UAB</i> , No. 2:19-CV-00395-JRG, 2020 WL 6803255 (E.D. Tex. Oct. 30, 2020)	18
<i>MyPort, Inc. v. Samsung Elecs. Co., Ltd.</i> , No. 2:22-cv-00114-JRG, Dkt. 73 (E.D. Tex. June 13, 2023).....	19
<i>Nvidia Corp. v. Neural AI, LLC</i> , IPR2025-00606, Paper 18 (P.T.A.B. July 31, 2025)	16
<i>NXP USA, Inc. v. Redstone Logics LLC</i> , IPR2025-00485, Paper 11 (P.T.A.B. July 10, 2025)	18
<i>Qualcomm Inc. v. Apple Inc.</i> , 24 F.4 th 1367 (Fed. Cir. 2022)	15

<i>Samsung Elecs. Co., Ltd. v. Cerence Operating Co.,</i> IPR2025-00458, Paper 14 (P.T.A.B. June 25, 2025)	19
<i>Samsung Elecs. Co., Ltd. v. Sinotechnix LLC,</i> IPR2025-00331, Paper 13 (P.T.A.B. July 2, 2025)	17
<i>Samsung Electronics Co., LTD. et al. v. Genghiscomm Holdings LLC,</i> IPR2025-00793, Paper 11 (P.T.A.B. Aug. 22, 2025)	18
<i>Solas OLED Ltd. v. Samsung Display Co., Ltd.,</i> No. 2:19-CV-00152-JRG, 2020 WL 4040716 (E.D. Tex. July 17, 2020)	19
<i>Stellar LLC v. Motorola Solutions, Inc.,</i> No. 4:23-cv-750-SDJ, Dkt. 50 (E.D. Tex. Aug. 9, 2024)	17
<i>Trover Grp., Inc. v. Dedicated Micros USA,</i> No. 2:13-CV-1047-WCB, 2015 WL 1069179 (E.D. Tex. Mar. 11, 2015)	18

Statutes

35 U.S.C. § 312(a)(3)	15
35 U.S.C. § 314(a)	1, 12
35 U.S.C. § 324(a)	1
35 U.S.C. § 325(d)	13

Other Authorities

37 C.F.R. § 42.24	21
37 C.F.R. § 42.104	14
37 C.F.R. § 42.104(b)(4)	15

PATENT OWNER’S EXHIBIT LIST

Exhibit No.	Description
2002	Notice of References Cited from U.S. Publ. Appl. 2020/0221495-A1
2003	U.S. Pat. Pub. No. 2018/0124831 (“ <i>Dinan</i> ”)
2004	Letter from Hannibal’s counsel to Samsung dated June 8, 2022
2005	Letter from Hannibal’s counsel to Samsung dated November 6, 2023
2006	<i>Order Governing Proceedings</i> in the U.S. District Court for the Eastern District of Texas, Case 4:25-cv-00200-SDJ dated July 24, 2025
2007	<i>Stellar LLC v. Motorola Solutions, Inc.</i> , No. 4:23-cv-750-SDJ, Dkt. 50 (E.D. Tex. Aug. 9, 2024)
2008	<i>MyPort, Inc. v. Samsung Elecs. Co., Ltd.</i> , No. 2:22-cv-00114-JRG, Dkt. 73 (E.D. Tex. June 13, 2023)

Patent Owner, Hannibal IP LLC (“Hannibal” or “Patent Owner”), hereby requests that the Director of the U.S. Patent and Trademark Office (“USPTO”) exercise her discretion to deny institution in this *inter partes* review proceeding pursuant to the Director’s Memorandum “Interim Processes for PTAB Workload Management” dated March 26, 2025 (the “March 26th Memo,”) and 35 U.S.C. §§ 314(a) and 324(a).

I. INTRODUCTION

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (“Petitioners” or “Samsung”) filed their Petition for *inter partes* review (“IPR”) of U.S. Patent No. 11,272,535 titled “Method and Apparatus for LBT failure Detection” (the “’535 Patent”) (the “Petition”) on July 11, 2025. As discussed below, the relevant factors enumerated in the March 26th Memo weigh in favor of denial. *Id.*; *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (March 20, 2020) (precedential). For example, the Petitioner’s challenge is weak because it fails to present any prior art that discloses the limitation “reset the LBT failure counter when a reset of the MAC entity is requested by an upper layer of the UE.” Ex. 1001, 13:45 – 46. To fill the gap in the prior art, Petitioner relies solely on expert testimony in support of an incorrect premise that the MAC reset procedure requires resetting all counters maintained by the MAC. As discussed herein, the art contradicts the expert’s opinion. Further, the art relied on in the Petition is

substantially the same as the art made of record during prosecution. Additionally, Samsung has had knowledge of the application leading to the challenged patent since 2021 and express notice of the patent and its infringement since early 2023. Finally, trial in the underlying litigation will likely occur before a final written decision is due for the instant Petition, if this matter is instituted. For these reasons, the Petition should be denied.

II. FACTUAL BACKGROUND

A. The '535 Patent

The '535 Patent issued on March 8, 2022, and contains two independent claims, Claims 1 and 10 (the “Challenged Independent Claims”). Claim 1 is an apparatus claim directed to a device, “a user equipment (UE).” Claim 10 is a method claim that closely corresponds to Claim 1. The application for the '535 Patent was filed on January 8, 2020, and claims priority to Provisional Application No. 62/790,099 filed on January 9, 2019. Ex. 1001. The priority date is not challenged by Petitioner. Petition, p. 1; Ex. 1002, ¶ 51.

As background, an improvement in the fifth generation (5G) New Radio (NR) wireless communications standard was making available to user devices (UE's) a portion of the RF spectrum known as the “unlicensed spectrum,” such as 5 GHz. Household Wi-Fi networks, for example, also utilize 5 GHz. Ex. 1001, 1:25-37. Much like the old CB radios or walkie-talkies, communication cannot

occur if two devices are trying to transmit on the same frequency. Given the prevalence of Wi-Fi devices, use of the unlicensed 5 GHz band could be especially problematic. To avoid interfering with other devices, the 5G standards specify a Listen-Before-Talk (“LBT”) scheme that requires a UE to listen to a particular frequency within the unlicensed spectrum before transmitting. LBT is analogous to what a human would do using a CB radio or walkie-talkie, that is, to listen before pushing the talk button, and if others are talking, either refrain or switch to another frequency. As explained in the Background section, “[i]n NR, LBT may be required prior to any transmission when operating on an unlicensed spectrum.” Ex. 1001, 1:37-45.

The claimed inventions are directed to “an improved and efficient mechanism for a UE to handle LBT failure that may take place in the physical layer.” Ex. 1001, 1:38-41. As noted by Petitioner, the 5G/NR specifications specify two protocol stacks, the user plane and the control plane. The inventions concern the control plane, which is as follows:

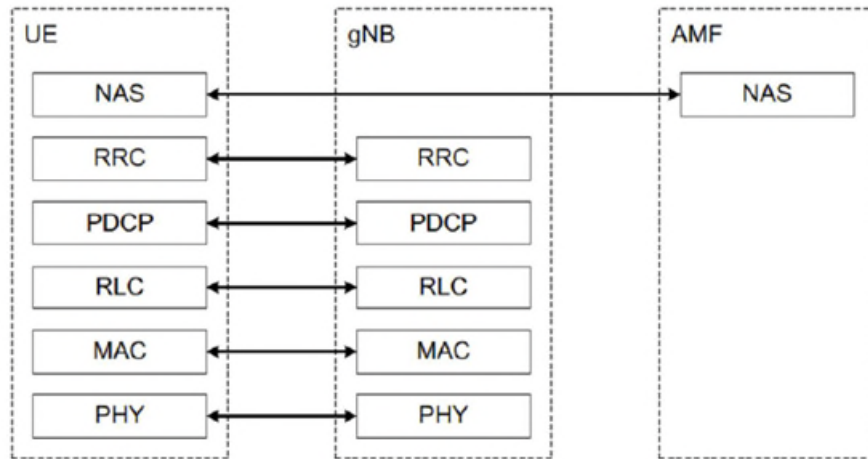


Figure 4.4.2-1: Control Plane Protocol Stack

Petition, p. 3. The “physical layer” (Ex. 1001, 1:38 – 41) is the “PHY” layer shown above.

The inventions of Challenged Independent Claims 1 and 10 provide a novel and non-obvious “improved and efficient mechanism” for handling LBT failures reported to the MAC layer by the PHY layer. LBT failures can be temporary, and it would be very inefficient to report every failure to the higher layers. The inventions enhance efficiency by requiring that the MAC layer keep track of the number of LBT failures reported to it by the PHY layer. Ex. 1001, ’535 Patent, Cl. 1, 13:36-39. The MAC layer uses a “failure counter” to count the number of LBT failures reported by the PHY layer. Cl. 1, 13:40-41. The MAC layer compares the count of LBT failures to a threshold value. Only when the count is equal to or greater than the threshold, which event is referred to as an “LBT failure event,”

does the MAC layer then report the failure event to “an upper layer.” Ex. 1001, 13:42-44.

Importantly, and a point completely ignored by Petitioner, the inventions require a particular mechanism for resetting the LBT counter. Where the prior art reset LBT counters based on an expiration of a timer, the claims here require “reset[ting] the LBT counter when a reset of the MAC entity is requested by an upper layer of the UE.” *Id.*, Cl. 1, 13:45-46. Indeed, the claims were amended to add this limitation during prosecution, which Petitioner failed to mention. Ex. 1003, Page 43, Request for Continued Examination. The Examiner agreed that this limitation [1e] distinguished the invention over the prior art. Ex. 1003, Page 21 of 356, Notice of Allowance (referring back to Applicant’s statement that “the cited art does not disclose resetting the LBT failure counter when a reset of a MAC entity is requested by an upper layer of the UE.” *see* Ex. 1003, Page 48 of 356, RCE).

B. Samsung’s Prior Knowledge of the ’535 Patent and Other Patents

Samsung had knowledge of the published application for the ’535 Patent at least four years before it filed the Petition. On July 8, 2021, during the prosecution of Samsung’s U.S. Patent No. 11,284,433, the examiner cited the application for

the '535 Patent, U.S. Publ. Appl. 2020/0221495-A1. Ex. 2002 (Notice of References Cited).

Samsung also received express notice of the '535 Patent and its infringement at least as early as February 14, 2023, when Hannibal provided Samsung with a claim chart directed to the '535 Patent.¹ Hannibal also followed up on November 6, 2023, with a letter expressly discussing the '535 Patent and referencing the previously provided claim chart. Ex. 2005, p. 2.

C. The Litigation Between Hannibal and Samsung

On February 27, 2025, Hannibal filed its Complaint seeking relief for Samsung's infringement of four patents, including the '535 Patent, in the U.S. District Court for the Eastern District of Texas, Case 4:25-cv-00200-SDJ (the "Litigation")². The accused products are consumer devices such as smartphones and tablets. *See* Complaint, ¶¶ 67 – 75. Samsung answered on June 16, 2025. On July 24, 2025, the Court issued its Order providing certain case deadlines (the "Order"). Ex. 2006. Based on the Court's schedule the Final Pre-Trial Conference

¹ Hannibal and Samsung entered into a Non-Disclosure Agreement on July 12, 2022.

² Samsung has filed three other Petitions for *inter partes* review against Hannibal of U.S. Patent Nos. 11,057,896, 11,368,911, and 11,641,661 (IPR2025-01187, IPR2025-01189, and IPR2025-01190, respectively).

is set for November 18, 2026. *Id.* No trial date was set, but in view of the Court’s practice, the trial is likely to be set in late November or early December 2026.

D. Schedule in this IPR Proceeding

Samsung filed its Petition on July 11, 2025, which was accorded that filing date by the Notice of Filing Date Accorded mailed July 21, 2025. Hannibal’s Preliminary Response is due October 21, 2025. The PTAB’s decision on institution must be made by January 21, 2026. The Board’s Final Written Decision (“FWD”) must be issued before January 21, 2027. Notably, the FWD will most likely issue *after* the jury trial in the Litigation.

III. INSTITUTION OF INTER PARTES REVIEW SHOULD BE DENIED

Of the seven factors listed in the March 26th Memo, four apply to the facts of this case: (1) the strength of the unpatentability challenge, (2) the extent of the petition’s reliance on expert testimony, (3) settled expectations of the parties, and (4) other considerations. Each factor strongly favors denial of institution under the Director’s discretionary authority.

A. The Unpatentability Challenge is Weak

The challenge to patentability is weak. None of the prior art references relied on in the Petition discloses or suggests the limitation “reset the LBT failure counter when a reset of the MAC entity is requested by an upper layer of the UE.” Ex. 1001, 13:45 – 46. Samsung purports to fill this substantial gap — wrongly —

with only the opinion of its expert, Dr. Kakaes. But, as discussed below, Dr. Kakaes' opinion is expressly contradicted by the very document, TS-38.321, that he purports to rely on.

Further, the patentability challenge relies on art that is substantially the same as prior art previously presented to the Patent Office as will be shown in Section 3 below.

1. Overview of Petition

The Petition attacks the validity of all twenty claims of the '535 Patent on four grounds. The Petitioner asserts in its first ground that Claims 1, 3-4, 7-8, 10, 12-13, 16-17, and 19-20 are obvious based on *Shi* (Ex. 1004) in view of TS-38.321 (Ex. 1007) ("Ground 1"). Petition, p. 22. The Petitioner asserts in the second ground that claims 1-8, 10-17, and 19-20 are obvious based on *Shi* in view of *Hong* (Ex. 1005) and TS-38.321 ("Ground 2"). Petition, p. 44. Only Grounds 1 and 2 concern the Challenged Independent Claims. At least because these Grounds fail, the other two Grounds (3 and 4) also lack merit.

In both Grounds 1 and 2, the Petitioner acknowledges that none of the art expressly discloses the limitation "reset the LBT failure counter when a reset of the MAC entity is requested by an upper layer of the UE." Ex. 1001, 13:45 – 46. Instead, Samsung relies solely on Dr. Kakaes' opinion, based on TS 38.321, to contend that this limitation would be obvious. Petitioner is wrong.

**2. None of the References in Either Ground 1 or Ground 2
Render The Challenged Independent Claims Obvious.**

In Ground 1, Samsung relies on *Shi* in view of TS 38.321. *Shi* discloses a “global counter” for maintaining a count of LBT failures, among other indications, and that “it is possible to reset the global counter when the global timer times out.” Ex. 1004. Page 6:28. *Shi* also discloses that when the global counter reaches a preset threshold value, the Radio Resource Control (RRC) layer can trigger one of the following processes: RRC connection reestablishment, Secondary Cell Group (SCG)—Radio Link Failure (RLF) processing, or RRC reconfiguration. *Id.*, 6:31-34. Finally, *Shi* discloses that the SCG-RLF process includes “reset[ing] the SCG Media Access Control (MAC) address entity, and report[ing] the number of LBT failures [maintained by the global counter] to the network via an MCG.” *Id.*, 6:37-40. Nowhere does *Shi* disclose or suggest that the SCG-MAC reset impacts the global counter. Nor does *Shi* disclose any other mechanism for resetting the global counter other than through a time out of the global timer.

Based on the statement that the SCG-RLF process includes a reset of the SCG-MAC address entity, Dr. Kakaes opines: “[i]t was well known to a POSITA that resetting a MAC entity includes, for example, resetting counters associated with the MAC entity.” Ex. 1002, ¶ 177. Dr. Kakaes relies on section 5.12 of TS 38.321, titled “MAC Reset” in support of his opinion. *Id.* Specifically, TS 38.321

states that “[i]f a reset of the MAC entity is requested by upper layers, the MAC entity shall: [among other things] reset BFI_COUNTER.” Ex. 1007, pp. 43-44. But a “BFI_COUNTER” has nothing to do with LBT. The BFI_COUNTER is a variable used by a UE to keep track of beam failures. LBT is not directed to beam failures. Despite these being completely different technologies, Dr. Kakaes relies solely on this disclosure to conclude that all counters maintained by the MAC entity are reset when the MAC is reset. As discussed below, Dr. Kakaes is wrong.

In Ground 2, Samsung similarly relies on *Shi* but in view of both TS 38.321 and *Hong*. As discussed above, *Shi* discloses that when the global counter reaches a preset threshold value, a RRC connection reestablishment procedure can be initiated. Samsung relies on the combination of *Shi* and *Hong* in support of its contention that the RRC connection reestablishment procedure includes “reset[ing] the MAC.” Petition, p. 45 (citing *Hong* [0195]). Like in Ground 1, Samsung’s patentability challenge relies on Dr. Kakaes’ opinion that “it was well known to a POSITA that resetting a MAC entity includes, for example, resetting the counters associated with the MAC entity.” Ex. 1002, ¶ 215. Dr. Kakaes’ analysis in support of this opinion for Ground 2 mirrors his analysis in Ground 1. He — and the Petitioner — relies on the MAC reset procedure described in TS 38.321.

TS-38.321, the Medium Access Control (MAC) protocol specification, itself, contradicts Dr. Kakaes’ opinion. Specifically, TS-38.321 defines two other

counters, PREAMBLE_TRANS-MISSION_COUNTER and PREAMBLE_POWER_RAMPING_COUNTER, that are maintained by the MAC entity. Ex. 1007, TS 38.321, p. 14 of 76. Neither counter is reset during the MAC entity reset provided in Section 5.11. Ex. 1007, TS 38.321, p. 43 of 76. The reset procedure is reproduced below as follows:

5.12 MAC Reset

If a reset of the MAC entity is requested by upper layers, the MAC entity shall:

- 1> initialize B_j for each logical channel to zero;
- 1> stop (if running) all timers;
- 1> consider all *timeAlignmentTimers* as expired and perform the corresponding actions in subclause 5.2;
- 1> set the NDIs for all uplink HARQ processes to the value 0;
- 1> stop, if any, ongoing RACH procedure;
- 1> discard explicitly signalled contention-free Random Access Resources, if any;
- 1> flush Msg3 buffer;
- 1> cancel, if any, triggered Scheduling Request procedure;
- 1> cancel, if any, triggered Buffer Status Reporting procedure;
- 1> cancel, if any, triggered Power Headroom Reporting procedure;
- 1> flush the soft buffers for all DL HARQ processes;
- 1> for each DL HARQ process, consider the next received transmission for a TB as the very first transmission;
- 1> release, if any, Temporary C-RNTI;
- 1> reset *BFI_COUNTER*.

Ex. 1007, pp. 43-44 of 76. As shown, neither the PREAMBLE_TRANSMISSION_COUNTER nor PREAMBLE_POWER_RAMPING_COUNTER is reset under the MAC entity reset protocol. Thus, TS-38.321 — the very document Dr. Kakaes purports to rely on — expressly demonstrates that Dr. Kakaes' premise that a MAC reset necessitates resetting *all* counters is wrong. This flaw is fatal to both Grounds 1 and 2 because both

grounds rely solely on Dr. Kakaes' incorrect opinion. Because neither combination of references can create a reasonable likelihood that the Petitioner would prevail with respect to the Challenged Independent Claims, Samsung's petition should be denied. 35 U.S.C. § 314(a).

3. The Art Relied on in Grounds 1 and 2 is Substantially the Same as Art Presented During Prosecution.

The prior art of record disclosed the same process Samsung relies on in Grounds 1 and 2. First, TS 38.321 is expressly discussed in the specification of the '535 Patent. Ex. 1001 at Col. 6:1-11. But additionally, U.S. Pat. Pub. No. 2018/0124831 ("*Dinan*"), cited by the examiner during prosecution and listed on the face of the '535 Patent, discloses an SCG-MAC reset when an LBT counter reached a threshold value. Ex. 2003, ¶¶184-187. Specifically, *Dinan* discloses,

[i]n response to unsuccessful termination of an SR process because of excessive LBT (e.g., SR_LBT counter reaches a first value), the UE may transmit an RRC message to the MeNB indicating that the LBT process is failed...The RRC message may be SCG Failure Information message transmitted by the UE to an MeNB.

Id., ¶187. *Dinan* further discloses that the "SCG failure notification procedure" includes informing the E-UTRAN about an "SCG failure that the UE has experienced e.g., SCG radio link failure" and transmitting "SCG failure information to the MeNB" when the UE experiences "excessive LBT." *Id.*, ¶184.

Finally, *Dinan* discloses that upon initiating this procedure, the UE may “reset SCG-MAC.” *Id.*

Dinan disclosed the same MAC reset that Samsung now contends — wrongly — creates a question of patentability. *See* Grounds 1 and 2. But the examiner cited *Dinan* during prosecution and correctly determined that the Challenged Independent Claims were patentable. And the Petition makes no contention that the Patent Office erred in a manner material to the patentability of the Challenged Claims. Because Samsung’s Petition presents art that is substantially the same as the art previously presented to the Patent Office, it should be denied. 35 U.S.C. § 325(d); *Intel Corp., v. Interdigital, Inc.*, IPR2024-01441, Paper 13 at 9 (P.T.A.B. April 1, 2025) (“In determining whether to institute an *inter partes* review, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”) (internal quotations and citing reference omitted).³

For the reasons discussed above, the Petition is weak and should be discretionarily denied.

³ Previously presented art includes art made of record by the Examiner. *Intel Corp., v. Interdigital, Inc.*, IPR2024-01441, Paper 13 at 11 (P.T.A.B. April 1, 2025).

B. The Petitioner Relied Heavily on Expert Testimony

As discussed above, none of the references in Grounds 1 or 2 disclose the limitation “reset the LBT failure counter when a reset of the MAC entity is requested by an upper layer of the UE.” Ex. 1001, 13:45 – 46. Instead, Petitioner relies solely on Dr. Kakaes’ opinion that all counters maintained by the MAC entity are reset during a MAC reset — which as discussed above is incorrect. *See* Petition, p. 31. Indeed, Petitioner and its expert rely on long narratives regarding what a “POSITA would have understood.” *See e.g.*, Ex. 1002, ¶¶ 176, 214. This phrase is used at least twenty-three (23) times in Dr. Kakaes Declaration. Ex. 1002. Samsung uses the phrase at least twenty (20) times in the Petition. By using this phrase, the Petitioner and its expert are attempting to rely on the mere assertion of “common sense” to gloss over the deficiencies of its combinations without providing any reasoned basis to meet the bar set for the use of “common sense.” *See DSS Tech. Mngt., Inc. v. Apple Inc.*, 885 F.3d 1367, 1375 (Fed. Cir. 2018).

Furthermore, as the Director recently stated in her Memorandum dated July 31, 2025, regarding Enforcement and Non-Waiver of 37 C.F.R. § 42.104, “expert testimony, common sense, and other evidence that is not ‘prior art consisting of patents or printed publications’ (collectively, ‘general knowledge’) may not supply a missing limitation.” The legal authorities cited by the Director pre-date the

Petition. *See* 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.104(b)(4); *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1373-77 (Fed. Cir. 2022); *see also* *DSS*, 885 F.3d at 1375.

Here, it is only expert testimony that purports to supply the limitation “reset the LBT failure counter when a reset of the MAC entity is requested by an upper layer of the UE.” Ex. 1001, 13:45 – 46. Accordingly, the Petitioner’s extensive use of expert testimony as a gap-filler, weighs in favor of denial.

C. Patent Owner had Established Expectations Based Samsung’s Longstanding Knowledge of the ’535 Patent

As discussed above, Samsung had knowledge of the application for the ’535 Patent at least as of July 2021, four years before it filed the Petition. Ex. 2002. Hannibal wrote to Samsung regarding its patents on June 8, 2022, and while the ’535 Patent was not specifically listed, the letter stated that Hannibal’s “patent portfolio relating to standard essential 5G wireless technologies,” which included the ’535 Patent. Ex. 2004. A list of the patents assigned to Hannibal was available on the Patent Office’s public website.

On February 14, 2023, Hannibal sent Samsung a chart for the ’535 Patent and others. And on November 6, 2023, Hannibal sent Samsung another letter that discussed the ’535 Patent, Samsung’s infringement, and referenced the previously provided claim charts. Ex. 2005. As shown, Samsung had knowledge of the

application for the '535 Patent since July 2021, and Hannibal provided express notice of the '535 Patent in early 2023.

Given these dates, Hannibal had settled expectations regarding the '535 Patent and that Samsung would not challenge the patent's validity at the Patent Office. Petitioner's longstanding knowledge of the '535 Patent without seeking any review of it provides a basis for Hannibal's settled expectations. *iRhythm Techs., Inc. v. Allyn*, IPR2025-00363, Paper 10 at 3 (P.T.A.B. June 6, 2025) ("Petitioner's awareness of Patent Owner's applications and failure to seek early review of the patents favors denial and outweighs the above-discussed considerations."); *Nvidia Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18 at 2-3 (P.T.A.B. July 31, 2025) (finding that even though patent was reissued in 2023, the fact that Petitioner had prior knowledge of the patent favored discretionary denial). This is especially true when, as here, Hannibal expressly provided Samsung with knowledge of the patent and infringement, yet Samsung did not seek review of the patent. By waiting over three years from when Hannibal first provided notice of its portfolio to file its Petition, Petitioner created an expectation that Samsung would not file a Petition for an IPR directed to the '535 Patent.

Thus, this factor favors discretionary denial.

D. Other Factors

1. Trial Likely to Occur Before Projected FWD

The Board's decision on institution must be made by January 21, 2026. The Final Written Decision ("FWD") must be issued on or before January 21, 2027.

In the Litigation, the Court set the final pretrial conference for November 18, 2026. Ex. 2006, Order. While the District Court did not set a trial date, the Court typically sets jury trials for shortly after the final pretrial conference. *See Stellar LLC v. Motorola Solutions, Inc.*, No. 4:23-cv-750-SDJ, Dkt. 50 (E.D. Tex. Aug. 9, 2024) (setting trial for 10 days after final pretrial conference), Ex. 2007, p. 4. Based on the District Court's usual practice, the jury trial will likely take place in late November or early December of 2026.

The Board has routinely denied institution when the jury trial predates the final written decision. *See, e.g., Samsung Elecs. Co., Ltd. v. Sinotechnix LLC*, IPR2025-00331, Paper 13 at 2 (P.T.A.B. July 2, 2025) (finding that jury trial predating the final written decision weighed in favor of discretionary denial); *Ericsson Inc. v. Active Wireless Techs. LLC*, IPR2024-00886, Paper 8 at 8-9 (P.T.A.B. Nov. 12, 2024) (collecting cases). Where, as here, there is a one-to-two-month time difference between the trial and the FWD deadline, the Director has found this factor to favor the denial of institution. *See EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (P.T.A.B. Apr. 13, 2022)

(concerning one-to-two-month period); *NXP USA, Inc. v. Redstone Logics LLC*, IPR2025-00485, Paper 11 at 2 (P.T.A.B. July 10, 2025) (concerning a 2.5-month period).

Thus, the fact that trial will occur prior to the FWD favors discretionary denial. This is true even when the challenged patent has not been in force very long. *See Samsung Electronics Co., LTD. et al. v. Genghiscomm Holdings LLC*, IPR2025-00793, Paper 11 at 2 (P.T.A.B. Aug. 22, 2025) (“Although the patents challenged in these proceedings have not been in force for as long as those in IPR2025-00780 and IPR2025-00781, this fact alone does not tip the balance against discretionary denial.”).

2. A Stay of the District Court Proceedings is Unlikely

In the parallel Litigation, the District Court has not granted a stay nor is it likely to do so. Indeed, judges in the Eastern District routinely deny any requests to stay litigation prior to the institution of an IPR. *See, e.g., Luminati Networks Ltd. v. Teso LT, UAB*, No. 2:19-CV-00395-JRG, 2020 WL 6803255, at *1 (E.D. Tex. Oct. 30, 2020); *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015); *AR Design Innovations LLC v. Ashley Furniture Indus., Inc.*, No. 4:20-cv-392-SDJ, 2021 WL 6496714, at *3-4 (E.D. Tex. Jan. 11, 2021) (citing *Trover*).

Even if this IPR is instituted, it is unlikely that the District Court would stay the Litigation. This is especially true where, as here, the FWD would likely issue after the trial in the parallel proceeding. *See, e.g., MyPort, Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:22-cv-00114-JRG, Dkt. 73 (E.D. Tex. June 13, 2023) (denying a motion to stay when “the PTAB [FWD] is not due until over two months after jury trial is set to begin”), Ex. 2008, p. 4; *Solas OLED Ltd. v. Samsung Display Co., Ltd.*, No. 2:19-CV-00152-JRG, 2020 WL 4040716, at *2 (E.D. Tex. July 17, 2020) (denying a motion to stay in part because the Board’s FWD would have issued after the scheduled trial). The fact that the District Court is unlikely to stay the case favors discretionary denial. *See, e.g., Samsung Elecs. Co., Ltd. v. Cerence Operating Co.*, IPR2025-00458, Paper 14 at 2 (P.T.A.B. June 25, 2025).

IV. CONCLUSION

For the reasons set forth above, Hannibal requests that the Director exercise her discretion and deny institution in this IPR proceeding on the ’535 Patent.

Dated: September 5, 2025

/s/ Brian A. Carpenter
Brian A. Carpenter
USPTO Reg. No. 37,109
Vishal Patel
Admitted Pro Hac Vice
Cole Schotz P.C.
901 Main Street, Suite 4120
Dallas, TX 75202
469.557.9390
bcarpenter@coleschotz.com
vpatel@coleschotz.com

CERTIFICATE UNDER 37 C.F.R. SECTION 42.24

Hannibal certifies that the word count in this Request, as determined by the Microsoft Word word-processing system is 4,034 words. This Request is in compliance with the 14,000-word limit pursuant to the Director's Memorandum of March 26, 2025 and 37 C.F.R. §42.24.

CERTIFICATE OF SERVICE

I, Brian A. Carpenter, hereby certify that on the 5th day of September, 2025,
the foregoing document was served on the following by email:

Joshua L. Goldberg
Timothy J. May
Nicholas A. Cerulli
Chen Zang
Kevin D. Rodkey
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
joshua.goldberg@finnegan.com
timothy.may@finnegan.com
nicholas.cerulli@finnegan.com
chen.zang@finnegan.com
kevin.rodkey@finnegan.com

/s/ Brian A. Carpenter
Brian A. Carpenter
USPTO Reg. No. 37,109
Vishal Patel
Admitted *Pro Hac Vice*
Cole Schotz P.C.
901 Main Street, Suite 4120
Dallas, TX 75202
469.557.9390
bcarpenter@coleschotz.com
vpatel@coleschotz.com

***Attorneys for Patent Owner
Hannibal IP LLC***