

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

HANNIBAL IP LLC,

Patent Owner.

Case No. IPR2025-01189
U.S. Patent No. 11,368,911

**PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

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I. INTRODUCTION

The Director should reject Patent Owner Hannibal IP LLC's request for discretionary denial (Paper 10, "DD Req."), consider the Petition on the merits, and institute this IPR. First, the Office erred when issuing the '911 Patent. During prosecution, the Office indicated that limitations of original claims 5 and 15 rendered allowable, but the search history shows those limitations were not specifically searched. Yet, the independent claims were allowed once the applicant amended them to include these limitations. Had the Office conducted a reasonable search for these limitations, it would have found prior art, such as *Nimbalker*, showing that they were known in the prior art and render the claims unpatentable.

Second, the '911 Patent issued just over three years ago and, since its issuance, the parties have been engaged in licensing discussions. Samsung had an expectation of nonenforcement based on those ongoing communications. The three other patents subject to copending IPR petitions issued between two and four years ago. The Director routinely declines to deny institution for such young patents, and here, there is the additional factor of ongoing licensing discussions.

Third, the *Fintiv* factors similarly weigh against denial. The district court canceled the status conference to consider Samsung's stay motion, there are no case deadlines, and the parties are not proceeding, if at all, until after the court rules on the motion and resets a scheduling conference. No trial date is set and the median

time-to-trial statistics place trial months after the last possible final written decision (“FWD”) date. The Director regularly declines to apply discretionary denial in such instances. Hannibal’s arguments on the merits misapply the law and are contradicted both by the ’911 Patent and Hannibal’s own infringement contentions. Such incorrect arguments favor moving to a merits consideration.

The ’911 Patent is young and subject to ongoing licensing discussions, and the Board is best suited to address the complex 5G standards technology as well as the earlier error by the Office. The instant petition should be considered on the merits and instituted.

II. INSTITUTION IS REQUIRED TO CORRECT MATERIAL ERRORS AND IS AN APPROPRIATE USE OF THE OFFICE’S RESOURCES

The Office materially erred when it allowed the ’911 Patent to issue. The Examiner effectively issued a first-action allowance when he indicated in the sole office action that pending original claims 5 and 15 “would be allowable if rewritten in independent form.” Ex. 1002, 111. The office action stated that the “Examiner ... was unable to find any prior art which solely or in combination” taught the limitation “starting a DRX on-duration timer of the DRX functionality in response to not receiving the power saving signal in the second search space.” *Id.* The Examiner then allowed the application after the applicant’s amendments to include this limitation, stating as the reasons for allowance that “Applicant rolled up limitations

from **objected dependent claims 5 and 15** to respective **independent claims 1 and 11** by cancelling **dependent claims 5 and 15.**” *Id.*, 148, 150, 162-164. But the Office erred.

Yet during prosecution, the Examiner’s searches did not target the specific limitations of original claims 5 and 15 that were indicated as the allowable subject matter. *Id.*, 120-133, 140, 173-189 (Examiner’s searches). For example, Search S60 (*id.*, 125) contains “not” near “active time” and variations on “wakeup signal,” but this search targets the limitation of the independent claims for not monitoring the wakeup signal (“WUS”) during active time, and is not directed towards the limitation indicated as allowable. Thus, the Examiner’s searches show that the Office did not search the limitation indicated as allowable. *See id.*, 120-133, 140, 173-189 (Examiner’s searches). This omission led to the material error in finding the limitations of original claims 5 and 15 allowable.

For example, searching for US patents, US publications, or PCT publications that published before October 15, 2021 (the date of the Examiner’s office action (*id.*, 98)) with the term “discontinuous reception” or “DRX” and each of the terms “WUS,” “not,” “ON,” “duration,” and any one of “receive,” “detect,” “decode,” “determine,” or “monitor” within 10 words of each other yields 28 results, including *Nimbalker* as the 12th result. Ex. 1045 (no. 12). The exact search text was:

("discontinuous reception" or DRX) AND (("not receive WUS
ON duration"~10) OR ("not detect WUS ON duration"~10) OR
("not decode WUS ON duration"~10) OR ("not determine WUS
ON duration"~10) OR ("not monitor WUS ON duration"~10))
and (PD/01/01/1789->10/15/2021)

Had the Examiner included “DRX” in the proximity strings above, the search would have yielded only 10 results, including *Nimbalker* as the sixth result. Ex. 1046 (no. 6).

Had the Office conducted a reasonable search, it would have found *Nimbalker* or another piece of prior art disclosing the limitation-at-issue. Thus, the Examiner’s note that they did not find prior art disclosing this limitation resulted from not performing an appropriate search. As shown above, that search would have led to a reasonable recognition that the prior art, including *Nimbalker*, teaches or renders obvious this limitation. Paper 1 (“Pet.”), 51. Samsung’s expert explains this. Ex. 1003, ¶¶148-149. Because the Examiner did not perform the proper search, they did not have these teachings and thus erred in their conclusion of patentability.

III. SETTLED EXPECTATIONS SUPPORT A MERITS CONSIDERATION

The “settled expectations” of the parties weigh strongly against denial because (1) all challenged patents are young, with the ’911 Patent issuing three years ago in 2022 and the other asserted patents issuing in 2021, 2022, and 2023; (2) Samsung

did not expect enforcement and had no reason to challenge validity because the parties were engaged in licensing discussions until the eve of the service of the Complaint; and (3) Samsung filed this Petition expeditiously less than four months after being served (and just over two years after learning of the '911 Patent).

A. The Ages of the '911 Patent and Other Challenged Patents Weigh Against Discretionary Denial

None of Hannibal's arguments related to the parties' expectations withstand scrutiny. To the contrary, all weigh against discretionary denial.

1. The '911 Patent and Other Challenged Patents Issued Only a Few Years Ago, Which Weighs Strongly Against Discretionary Denial

The '911 Patent issued June 21, 2022, less than three-and-a-half years before the expected discretionary denial decision date. The Director has found that patents issued less than six years ago “have not been in force for a significant period of time ..., and, accordingly, Patent Owner has not developed strong settled expectations,” which weighs against denial. *See, e.g., Samsung Elecs. Co. v. Wilus Inst. of Standards & Tech. Inc.*, IPR2025-00935, Paper 12 at 2 (Deshpande, C.J., Sep. 26, 2025) (declining discretionary denial when “the challenged patents have not been in force for a significant period of time (issued in 2021 and 2023), and, accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial as to these patents”); *Samsung Elecs. Co. v. Wilus Inst. of Standards & Tech.*

Inc., IPR2025-00933, Paper 11 at 3 (Deshpande, C.J., Oct. 10, 2025) (finding “Patent Owner has not developed strong settled expectations” where “most challenged patents issued between 2020 and 2023”); *Cambridge Indus. USA, Inc. v. Applied Optoelects., Inc.*, IPR2025-00434, Paper 11 at 2-3 (Director June 26, 2025) (patent that issued in 2019 “ha[d] not developed strong settled expectations”); *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 2-3 (Director July 2, 2025) (same for patents that “issued in 2019 and 2020”).

The other challenged patents issued about four or fewer years ago. The ’896 Patent issued July 6, 2021 (IPR2025-01187); the ’535 Patent issued March 8, 2022 (IPR2025-01188); and the ’661 Patent issued May 2, 2023 (IPR2025-01190). All therefore fall within the period where a “Patent Owner has not developed strong settled expectations,” which weighs against discretionary denial. *Samsung*, IPR2025-00935, Paper 12 at 2; *Samsung*, IPR2025-00933, Paper 11 at 3; *Cambridge*, IPR2025-00434, Paper 11 at 2-3; *Berkshire Hathaway*, IPR2025-00274, Paper 23 at 2-3.

2. Hannibal’s Alleged “Knowledge” in 2023 Does Not Support Discretionary Denial

Hannibal alleges that “Samsung had knowledge of the ’911 Patent at least as

of February 2023.”¹ DD Req. 15-18. Even taking Hannibal’s knowledge assertion as true, this admits that Samsung filed its IPR petition just over two years after learning of the ’911 Patent, which is reasonable given the parties’ ongoing licensing discussions.

Hannibal alleges that it “had settled expectations regarding the ’911 Patent and that Samsung would not challenge the patent’s validity at the Patent Office.” DD Req. 14-15. This misrepresents the facts and is a dubious *ex post* application of the Director’s decisions, not Hannibal’s actual belief. Hannibal had every reason to believe that, if the parties could not reach a licensing agreement and litigation ensued, Samsung **would** challenge validity, given Samsung’s history of challenging patents that are asserted **in litigation** against them. For that reason, Hannibal kept Samsung engaged in ongoing discussions until the eve of service of the Complaint in 2025.

¹ Hannibal’s statement regarding a 2022 letter that does not mention the ’911 Patent does not provide notice of the ’911 Patent. As one district court judge explained, “Saying you knew about [a patent] family is not too far a step from saying you knew there was this PTO in Virginia, and you should just go check everything there and see if anything there applies. It’s too nebulous.” *See Intell. Ventures I LLC v. T-Mobile USA, Inc.*, Hearing Tr. 61:2-9, No. 2:17-cv-00577-JRG, Dkt. 297 (E.D. Tex. Jan. 3, 2019).

Hannibal’s suggestion that Samsung should have challenged the ’911 Patent and other challenged patents in IPR earlier rings hollow. Again, by Hannibal’s own admission, Samsung and Hannibal were in continuing licensing discussions from 2022 until just before service of the Complaint. *Id.* And these were not typical licensing discussions; there was an expectation by Samsung that an amicable license would result since Hannibal represented that its patents are standards essential. *Id.*, 14; Ex. 2002, 1; Ex. 2005, 1. If true, Hannibal presumably understands that any entity that practices the relevant standards would owe it a FRAND license. Thus, it was Samsung’s expectation that the licensing discussions that continued for years would eventually lead to a license.

The cases Hannibal cites (*iRhythm* and *Nvidia*) do not show otherwise. DD Req. 15. In *iRhythm*, the “persuasive” argument was that “one of the patents has been *in force since as early as 2012 and Petitioner was aware of it as early as 2013*,” *and* petitioner “cited the then-pending application that issued as the challenged patent in an Information Disclosure Statement *Petitioner filed* in its own patent application.” *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (Director June 6, 2025) (emphases added). Thus, the *iRhythm* petitioner knew of and cited the challenged patent in its own IDS more than a decade before filing its petition. *Id.* That is not the case here. The ’911 Patent is just over three years old and there is no assertion that Samsung knew about the ’911 Patent before 2023 or any of

the patents or any of the challenged patents’ families before Hannibal contacted it in 2022. *See* DD Req. 14-15.

In *Nvidia*, one challenged patent “ha[d] been in force for over 11 years” and the other “originally issued in 2015,” but “reissued in 2023.” *Nvidia Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18 at 2-3 (Director July 31, 2025). The Director found that the parties “had a commercial relationship and, in 2017, [the patent owner] sent Petitioner a presentation” that included both patents at issue. *Id.* Thus, the petitioner in *Nvidia* waited seven years to file petitions after receiving the alleged notice, and both of the patents were many years older than the ’911 Patent and other challenged patents here.

Hannibal has no settled expectations to support discretionary denial.

B. Samsung’s Settled Expectations Outweigh Any Expectations of Hannibal

Even if Hannibal could prove it has settled expectations—it does not—Samsung had no reason to anticipate assertion of any challenged patent prior to the lawsuit because the parties were engaged in discussions for years until just before service of the Complaint. DD Req. 14-15; *see Apple, Inc. v. Allani*, IPR2025-00856, Paper 11 at 3 (Director Sep. 5, 2025); *cf. Globus Med., Inc. v. Spinelogik, Inc.*, IPR2025-00225, Paper 8 at 2 (Director June 12, 2025) (referring for merits consideration when petitioner showed it did not expect enforcement); *Intel Corp. v.*

Proxense LLC, IPR2025-00327, Paper 12 at 2-3 (Director June 26, 2025); *Home Depot U.S.A., Inc. v. H2 Intellect LLC*, IPR2025-00480, Paper 11 at 2-3 (Director Sep. 4, 2025). As such, Samsung’s expectations weigh against discretionary denial.

IV. THE *FINTIV* FACTORS WEIGH AGAINST DISCRETIONARY DENIAL

The Director should not deny the Petition under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential) (“*Fintiv*”), because Factors 1, 2, 3, 4, and 6 weigh strongly against discretionary denial, and Factor 5 only slightly favors denial or is neutral.

A. Factor 1: The Trial Court Canceled the Initial Case Management Conference to Consider Samsung’s Pre-Institution Motion to Stay and Is Likely to Grant Any Post-Institution Motion to Stay

Factor 1 weighs strongly against discretionary denial.

On September 19, the district court canceled the initial case management conference until it could “rule[] on [Samsung’s] pending Motion to Stay [22].” Ex. 1042. This indicates that not only is the district court considering granting a stay, but it is considering staying the case *pre*-institution. If the court is willing to consider a pre-institution stay, then the stay would almost certainly remain in effect post-institution. As of now, there is no case schedule in place. As a result, the parties agreed that prior proposed dates, such as those for serving infringement and invalidity contentions, are not in effect. Ex. 1043.

Even if the court denies a pre-institution stay, its canceling of the case management conference is a likely indicator that it would revisit the issue post-institution. Leaving the possibility open for a post-institution stay, even if a pre-institution motion is denied, weighs against discretionary denial. *See Fintiv*, IPR2020-00019, Paper 11 at 6-7 (denial of pre-institution stay without prejudice “has usually weighed against exercising authority to deny institution under *NHK*”). When all patents are instituted, the assigned district court judge has stayed the entire case. *Stellar, LLC v. Motorola Sols., Inc.*, No. 4:23-CV-750-SDJ, Dkt. 170 (E.D. Tex. Apr. 21, 2025) (staying case when all asserted patents instituted in IPR by Board). And even when the Board has instituted some petitions, but other institution decisions remain pending, that same district court judge has stayed cases. *See id.*, Dkt. 156 (E.D. Tex. Feb. 24, 2025) (granting stay when “the [Board] has instituted IPRs on four of those [eight] patents” and “will decide whether to institute IPRs on the remaining four patents” in later decisions). Thus, a stay is likely to be granted if the Board institutes petitions, even if just some.

B. Factor 2: No Trial Date Is Set and the Median Time-to-Trial Is More Than Two Months After the Latest Possible Final Written Decision Date

Factor 2 weighs strongly against discretionary denial. No trial date is set. When no trial date is set, the Director looks at the median time-to-trial statistics. *See Google LLC v. BrodTi Inc.*, IPR2025-00472, Paper 19 at 2 (Deshpande, C.J., June

25, 2025) (declining to discretionarily deny when no trial date scheduled and median time-to-trial suggested trial would occur after final written decision); *Google LLC v. Withrow Networks Inc.*, IPR2025-00775, Paper 10 at 2 (Deshpande, C.J., Aug. 14, 2025) (same); *RØDE Microphones, LLC v. Freedman Elecs. Pty Ltd.*, IPR2025-00557, Paper 11 at 2 (Director July 17, 2025) (same).

Hannibal filed its Complaint on February 27, 2025. Ex. 1040; DD Req. 6-7. The median time-to-trial statistics show 25.1 months between filing and trial. Ex. 1044, 35. This would result in a trial date in early April 2027, more than two months *after* the latest possible final written decision date of January 21, 2027. *See* Paper 4, Notice of Filing Date (July 21, 2025).

Moreover, the trial date may push back even further. As explained above, the court canceled the initial case management conference, which will be rescheduled, if at all, after ruling on the motion to stay. Ex. 1042; *see Omnitek Partners, LLC v. Raytheon Techs. Corp.*, No. 4:24-CV-143-SDJ, Dkt. 17 (E.D. Tex. July 3, 2024) (canceling case management conference, stating that separate schedule will be entered, if needed, after ruling on motion to dismiss); *Chien-Min Sung v. Samsung Elecs. Co.*, No. 4:23-CV-752-SDJ, Dkt. 82 (E.D. Tex. July 26, 2024) (stating that new pretrial and trial dates will be reset, if needed, after ruling on motion to transfer). Thus, the pretrial conference date that Hannibal relies upon (DD Req. 16-17) may likely be superseded and delayed by any new schedule. *Omnitek*, No. 4:24-CV-143-

SDJ, Dkt. 17; *Sung*, No. 4:23-CV-752-SDJ, Dkt. 82.

C. Factor 3: No Investment Has Occurred in the Parallel District Court Proceeding

Factor 3 weighs strongly against discretionary denial.

There has been little investment in the district court proceeding. The court canceled the initial case management conference, and it has not been rescheduled. There is currently no active case schedule, and the parties have agreed that prior proposed dates (such as for contentions) are not in effect and a case schedule should issue if the court does not stay the litigation. Hannibal has not served infringement contentions. Ex. 1043. Samsung has not served invalidity contentions. Discovery has not started. And the proceeding is effectively paused pending resolution of Samsung's pre-institution motion to stay. If a case schedule later issues, it would need to allow for additional time for initial proposed dates, such as contentions, that have already passed. *See id.* The early stage and lack of investment by either party or the court weighs strongly against discretionary denial.

D. Factor 4: There Is No Overlap Between Proceedings, and Samsung's Broad Stipulation Eliminates Any and All Potential Overlap

Hannibal does not argue any overlap between proceedings. Nor can it. Invalidity contentions have not been served. And, regardless, Samsung's stipulations (which are broader than *Sotera*) will, upon institution, eliminate even speculative

overlap between proceedings by excluding any ground that uses patents or printed publications as a primary reference in any invalidity combination, any ground that uses any reference named in a ground of the Petition, and any ground where a patent or printed publication cited in the Petition is used as evidence of the operation or structure of a system art device. *See* Paper 9; *Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00217, Paper 9 at 2 (Director June 13, 2025); *Samsung*, IPR2025-00933, Paper 11 at 3.

E. Factor 5: The Parties Are the Same

Recent decisions have indicated this is neutral or only slightly favors denial. *Innolux Corp. v. Phenix Longhorn*, IPR2025-00043, Paper 10 at 13 (May 15, 2025).

F. Factor 6: Strong Merits Show the Office Erred by Overlooking the Conventionality of the Alleged Point of Novelty

1. The Petition’s Strong Merits Weigh Against Denial, and Hannibal’s Merits Arguments Are Based on an Incorrect Understanding of the Law and Facts

Hannibal argues that *Nimbalker* (Ex. 1005) does not disclose “in response to not receiving the power saving signal while monitoring the second search space, [starting/start] a DRX on-duration timer of the DRX functionality.” DD Req. 8-13. Although Hannibal’s argument spans five pages, it merely repeats a single point: *Nimbalker* may include another criteria *in addition to* being in response to not receiving the power saving signal (WUS) when determining whether to start the DRX on-Duration timer. *Id.*

Setting aside that this argument is wrong as a matter of law and is contradicted by the '911 Patent and Hannibal's own infringement assertions, it does not change the fact that the Petition and the corresponding expert testimony explain that the claim element found allowable during prosecution already existed in the prior art. *See Anthony Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 12 at 2 (Director July 16, 2025); *id.*, Paper 9 at 16-17 (May 27, 2025); *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12 at 3-4 (Director July 17, 2025) (declining discretionary denials and finding material error where petitioner's prior-art references taught the specific claim limitation on which the examiner relied for allowance). *Nimbalker* is clear that not receiving the WUS signal is relied on when determining whether to start the on-Duration timer, which satisfies the claims. The Director should deny Hannibal's discretionary denial request on this basis. *See Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11 at 2-3 (Director June 12, 2025) (declining discretionary denial and referring for merits consideration where petitioner showed that prior art in petition established missing element of claims). At a minimum, Hannibal's singular argument is best left for a merits consideration, not discretionary denial. Samsung nonetheless addresses Hannibal's flawed position below.

In patent claims, the phrase "in response to" (or similar "responsive to" and "based on") may include additional unclaimed criteria or steps. In *Centripetal*

Networks, the Federal Circuit affirmed the Board’s unpatentability finding because the claimed “being ‘responsive to’” an action “includes deciding on an action to take based on [first] information *in combination with* other possible criteria” or additional unclaimed criteria, which rejected the patent owner’s argument that “*no other criteria*” was permitted in the determination. *Centripetal Networks, LLC v. Palo Alto Networks, Inc.*, No. 2023-1654, 2024 WL 4639207, at *4 (Fed. Cir. Oct. 31, 2024); *see also In re Affinity Labs of Tex., LLC*, 856 F.3d 902, 907 (Fed. Cir 2017) (holding that action “in response to” another event “does not prohibit additional, intervening steps” or actions); *Masimo Corp. v. Sotera Wireless, Inc.*, No. 2022-1415, 2023 WL 6307959, at *2 (Fed. Cir. Sep. 28, 2023) (“We agree with the Board that the plain meaning of ‘based on’ ... [is] broad, and this broad claim language does not exclude the use of ... other conditions to trigger an alarm,” and that “based on” is “a non-exclusive ‘condition precedent’” to the claimed action).

Here, Hannibal acknowledges (as it must) that *Nimbalker*’s RSRP or WUS decoder reliability are “**additional** condition[s]” when *Nimbalker* determines whether to start an on-Duration timer when not receiving the WUS. DD Req. 8-13; *Nimbalker*, 5, 8. *Nimbalker* is clear: “a conditional WUS operation is provided, wherein ... a **UE does not detect the WUS in a WUS monitoring occasion**, the UE **may determine whether or not to monitor a [PDCCH]**,” which may include other criteria. *Nimbalker*, 8; DD Req. 9 (quoting same). *Nimbalker* discloses that not

detecting the WUS is a requirement for the on-Duration timer determination and considering another criteria—“*if* the UE does not detect a WUS in a WUS monitoring occasion,” *then* it “*may*” consider other criteria to decide whether to start the on-Duration timer, but the ultimate determination is “in response to” not receiving the WUS. *Nimbalker*, 15 (emphases added). *Nimbalker* never gets to the RSRP or decoder consideration *unless* the WUS is not detected while monitoring the WUS monitoring occasion and both criteria are required to start the timer, as shown below. *Nimbalker*, 8-9, FIG. 3.

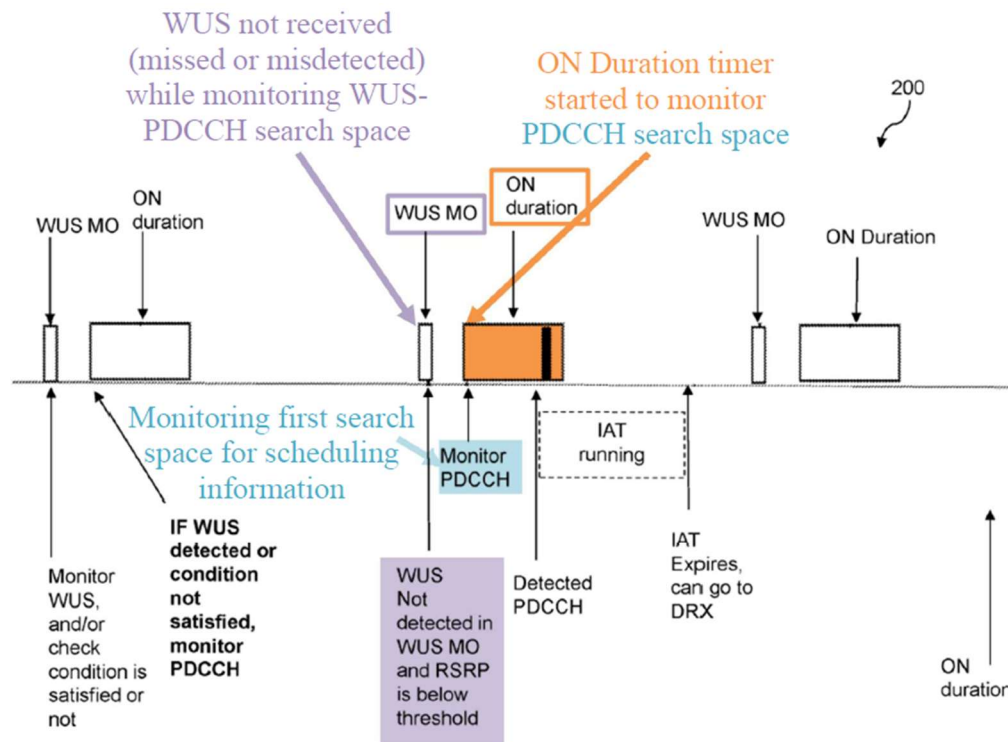


FIGURE 3

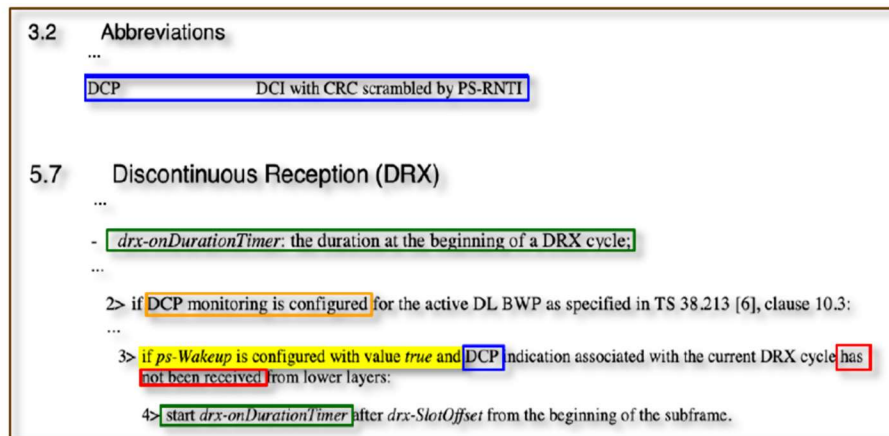
Pet., 22-33; Ex. 1003, ¶152; *Nimbalker*, FIG. 3.

Hannibal’s argument is also contrary the ’911 Patent’s disclosure, which

explains that, in general, when the WUS is not received, the UE does not wake up or start the on-Duration timer. *See, e.g.,* Ex. 1001, 3:19-22 (“[I]f the ***UE does not receive the WUS signal*** on the WUS occasion, the UE could switch to the sleep state, ***namely not wake up to monitor the PDDCH***” (emphases added)). The ’911 Patent also discloses other indications that are permitted, providing at least two examples where the determination for the UE to wake up and monitor PDCCH using the on-Duration timer is *also* “***based on the NW [network] indication***” when the WUS is not received. *Id.*, 10:55-57, 10:58-60 (emphases added).

Moreover, Hannibal’s own infringement positions contradict its argument. The infringement allegations for this claim element in the Complaint rely on operations that include additional criteria—specifically, “if *ps-Wakeup* is configured with value *true and*” the alleged WUS (“DCP”) is not received.

91. Each of the Accused Products further comprise the functionality that “***in response to not receiving the power saving signal while monitoring the second search space, starting a DRX on-duration timer of the DRX functionality***” based on their compatibility with and practice of the 3GPP 5G Standard. As shown below, this functionality is described in the 3GPP 5G Standard, including but not limited to TS 38.321 version 16.3.0:



3GPP TS 38.321 version 16.3.0.

Ex. 1040, ¶91 (yellow highlighting added, other annotations original).

Hannibal “cannot have it both ways” to allege an interpretation in district court that includes additional criteria while trying to exclude such criteria in this proceeding. *Bristol-Myers Squibb Co. v. Ben Venue Lab’ys, Inc.*, 246 F.3d 1368, 1375-76 (Fed. Cir. 2001); *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (patent is not “nose of wax” to “be twisted one way to avoid [invalidity] and another to find infringement”); *White v. Dunbar*, 119 U.S. 47, 51-52 (1886) (same).

Hannibal’s merits arguments should be rejected and the Petition instituted.

2. Samsung’s Expert Properly Explains the Technology and How *Nimbalker* Discloses or Renders Obvious the Claims

Hannibal asserts that “Petitioner relies heavily on Dr. Kakaes’ opinion” and faults Dr. Kakaes for explaining the technology and how it applies to the claims. DD Req. 13-14. But Hannibal’s argument does nothing more than reiterate its

disagreement about the “in response to” limitation, which is incorrect for the reasons discussed above. *Supra* Section IV.F.1. Dr. Kakaes’s explanation of how a POSITA would have understood the prior art is the purpose of expert testimony. *Unification Techs. LLC v. Micron Tech. Inc.*, No. 2023-1348, 2024 WL 3738401, at *7 (Fed. Cir. Aug. 9, 2024) (affirming Board’s unpatentability finding where expert’s opinion explained “how an ordinarily skilled artisan would have understood [the prior art’s] description of” the claim term).

3. The Board Is Best Suited to Handle the Complex Technology Here

The ’911 Patent and other challenged patents present uniquely complicated technology and facts that make the PTAB the best forum to decide their validity. The four challenged patents contain three distinct patent families and relate to complex 5G standards technology, which Hannibal has asserted are standards essential and have broad industry implications that the Board is better equipped to handle. *Tesla, Inc. v. United States*, IPR2025-00341, Paper 12 at 2-3 (“complex and diverse litigation proceeding[s]” favor institution because “the Board is better suited” to review patents); *Tesla v. Intell. Ventures II*, IPR2025-00217, Paper 9 at 2-3 (same).

V. CONCLUSION

Samsung respectfully requests that the Director decline to exercise discretion to deny institution and requests merits consideration and institution of this Petition.

Date: October 21, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioners’
Opposition to Patent Owner’s Request for Discretionary Denial of Institution**
was served on October 21, 2025, via email directed to counsel of record for the
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Patent Owner has consented to electronic service by email.

Dated: October 21, 2025

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