IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO., LTD., and

SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioners,

v.

MASSIVELY BROADBAND LLC.,

Patent Owner.

_____

Case No. IPR2025-01587

U.S. Patent No. 8,593,358

_____

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

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TABLE OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 8,593,358 ("'358 Patent")
1002	Prosecution History of U.S. Patent No. 8,593,358
1003	Expert Declaration of Dr. Mark Mahon
1004	U.S. Pat. Pub. No. 2008/0030411 ("Wen")
1005	Intentionally Left Blank
1006	U.S. Pat. Pub. No. 2004/0125027 ("Rubinshteyn")
1007	U.S. Pat. No. 5,926,751 ("Vlahos")
1008	U.S. Pat. No. 7,489,914 ("Govind")
1009	U.S. Pat. Pub. No. 2004/0095280 ("Poilasne")
1010	U.S. Patent No. 7,786,819 ("Ella")
1011	IEEE 100: The Authoritative Dictionary of IEEE Standards Terms, 7th ed. (2000)
1012	Prosecution History of U.S. Pat. No. 8,350,763.
1013	Int. Pub. No. WO 2005/029720 ("Leenaerts")
1014	U.S. Patent No. 8,583,065 ("Ben-Bassat")
1015	Infringement Contentions, *Massively Broadband LLC v. Samsung Electronics Co., Ltd., AND Samsung Electronics America, Inc.,* Case No. 2:25-cv-00608 (E.D. Tex.)
1050	"NYU Wireless' Rappaport envisions a 5G, millimeter-wave future," available at https://www.fierce-network.com/special-report/nyu-wireless-rappaport-envisions-a-5g-millimeter-wave-future
1051	U.S. District Court Time-to-Trial Statistics for EDTX (Sept. 2025)

I. INTRODUCTION

The Director should deny Patent Owner's request for discretionary denial in this proceeding (Paper 9) ("Request") as well as the eleven other IPR proceedings against patents asserted by Patent Owner (the "Challenged Patents"). Each of the relevant factors weigh against denial. *First*, the *Fintiv* factors heavily weigh against denial because trial is scheduled to occur after the projected dates of all twelve of the Final Written Decisions.

Second, Patent Owner lacks settled expectations because the '358 patent is part of a family that includes recently-issued patents—and given the significant overlap between the IPR petitions against this family, it would be an efficient use of Board resources to consider the merits of all of them. In addition, Patent Owner also lacks settled expectations because despite its contentions that the sole inventor on all twelve patents, Dr. Rappaport, had collaborated with Petitioners for multiple decades and had made significant contributions to the industry, Dr. Rappaport ***never*** indicated to Petitioners of any potential infringement of his patents and ***never*** told any industry standards groups that his patents were related to the accused Wi-Fi, LTE, and 5G standards.

Third, Patent Owner has asserted, and Petitioners have challenged, twelve patents belonging to three unrelated families that cover four different technologies. Given the wide scope of the subject matter of the Challenged Patents, the Board is

better positioned to adjudicate the validity of these patents.

Finally, institution is appropriate to cure the material errors committed by the examiner during prosecution of the ’358 patent. Specifically, the examiner allowed the claims without a single office action, finding that the prior art lacked disclosure of a multiband antenna used by a plurality of transceivers (or one multiband transceiver) in different frequency bands. Yet during prosecution of the parent ’763 patent, the examiner found many of the same limitations disclosed in the prior art. Further, the ’358 patent acknowledges that multiband antennas, active tuning, and multiband transceivers were known in the art and/or commercially available. The examiner therefore overlooked a broad swath of prior art that covers such well-known functionality—including the Petition’s Wen, Rubinshteyn, and Poilasne references that were not presented to the examiner.

II. THERE ARE NO SETTLED EXPECTATIONS IN THE VALIDITY OF THE ’358 PATENT

A. Patent Owner Lacks Settled Expectations

Patent Owner lacks settled expectations because the ’358 patent is related to other asserted patents that have only recently been issued, and which Petitioners have brought IPR challenges. Patent Owner has asserted the ’358 patent and the following related patents: U.S. Pat. Nos. 8,350,763 (“’763 patent”), 11,063,625 (“’625 patent”), and 11,876,548 (“’548 patent”). These patents belong to what

Patent Owner calls the "Smart Antenna patent family." Request at 6-7. The '625 patent issued on July 13, 2021 and the '548 patent issued on January 16, 2024. Since the '625 and '548 patents were only recently issued, Patent Owner lacks settled expectations as to their validity. *See Apple Inc. v. Apex Beam Techs. LLC*, IPR2025-00896, Paper 10 at 3 (Sept. 3, 2025).

Although the '763 and '358 patents were issued earlier, they claim subject matter that is similar to the '625 and '548 patents. As a result, there is significant overlap between the IPR petitions against this family of patents. It would therefore be an efficient use of Board resources to decide the merits of all four petitions, which further weighs against discretionary denial. *Embody, Inc. v. LifeNet Health*, IPR2025-00248, Paper 13 at 3 (Director June 26, 2025) ("Patent Owner has not developed strong settled expectations that favor discretionary denial as to the first patent, and it is an efficient use of Board resources to address the related patent.").

In particular, the earlier-issued '763 and '358 patents claim subject matter that overlaps in part with the claims of the recently-issued '625 and '548 patents, including the use of MIMO and beam-switchable antenna arrays, antenna tuning using active elements and/or elements selected or interconnected using electronic control, and multiband antennas that operate simultaneously in a plurality of different bands. Because of these overlapping limitations, analysis of one petition is highly informative of the others.

Patent Owner argues that Petitioners' prior awareness of a different patent family (the Intelligent Wireless Broadband Relay patent family, *see* Request at 6-7), gives rise to settled expectations in the validity of the '358 patent, but cites no authority in support of that argument.[1] In fact, the opposite is true. *See Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00437, Paper 10 at 2-3 (referring petitions for three patents despite finding settled expectations for two patents "not from the same patent family").

Patent Owner alternatively argues that settled expectations exist because two years before the '625 patent (a continuation-in-part of the '358 patent) issued, its corresponding published application was cited during prosecution of a Samsung patent. Request at 8-9. As an initial matter, Patent Owner's argument that Samsung's purported awareness of the continuation-in-part '625 patent—which issued in 2021 and lacks settled expectations[2]—somehow gives rise to settled

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[1] Petitioners have also disputed that there are settled expectations of validity for the Intelligent Wireless Broadband Relay patents. *See, e.g.*, *Samsung Elecs. Co., Ltd. v. Massively Broadband LLC*, IPR2026-00035, Paper 10 (Jan. 16, 2026).

[2] *See also Samsung Elecs. Co., Ltd. v. Massively Broadband LLC*, IPR2025-01564, Paper 12 (Jan. 6, 2026) (Petitioners' discretionary denial brief for the '625 patent).

expectations for the ’358 patent is emblematic of the overlapping disputes across all four Smart Antenna patents, and demonstrates why efficiency is best served if the Board decides the merits of all four petitions challenging the Smart Antenna patents.

Patent Owner also does not explain why the citation of its pending application during prosecution of an unrelated Samsung patent should have led Petitioners to seek review of the ’358 patent. *Nvidia Corp. v. Neural AI, LLC*, which Patent Owner relies on, is distinguishable. *See* Request at 8. In that case, the patent owner sent the petitioner a presentation discussing its patent portfolio, which included a discussion of specific patents that the petitioner did not challenge for years. *Nvidia*, IPR2025-00606, Paper 18 at 2-3 (July 31, 2025). Here, by contrast, and as discussed further below, although Petitioners collaborated with the sole named inventor on the twelve Challenged Patents for years, he never even suggested that Petitioners’ products infringed ***any*** of the Challenged Patents, much less the ’358 patent.

B. Patent Owner’s First-Time Assertion and Lack of Commercialization Undercut Any Claim of Settled Expectations

As far as Petitioners are aware, Patent Owner has never “commercialized, asserted, marked, licensed, or otherwise applied in … petitioner’s particular technology space” any of the twelve Challenged Patents, except through the lawsuit that it filed against Petitioners. *Shenzen Tuozhu Technology Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 (Director July 17, 2025). Nor does Patent Owner

contend it has ever sent a demand letter to anyone—certainly, Patent Owner did not tell Petitioner prior to the filing of this lawsuit in 2025 that it required a license to the Challenged Patents.

Yet as Patent Owner contends, the sole inventor on all twelve patents, Professor Theodore Rappaport, has "[f]or nearly three decades" "collaborated with [Petitioners] closely." Request at 2. During this multi-decade collaboration, Prof. Rappaport encouraged Samsung to invest in his research, granting Samsung full access to that research in return. Samsung (along with the industry writ large) made significant, well-publicized investments in the accused technology and prominently participated in the relevant standard-setting efforts. *See* Ex. 1050. But in all that time, despite the parties' close collaboration on development of the relevant standards, not once did Prof. Rappaport ever raise the possibility or suggestion that Petitioners' products infringed any of the Challenged Patents.

As Patent Owner acknowledges, Prof. Rappaport's work was widely published in technical papers and textbooks, including publications cited by Petitioners. Nor is it the case that an inventor's academic publication of his work means, as Patent Owner suggests, that the industry has acquiesced to his work and that Samsung should somehow be precluded from challenging Prof. Rappaport's patents now. Such an argument would chill industry-academic collaboration, forcing companies to shun participation in and contribution to academic research to

avoid future preclusion arguments. Thus, as a result of Prof. Rappaport sitting on his patent rights, Petitioners had settled expectations that Prof. Rappaport's published research was prior art that was available for use, that they did not infringe the Challenged Patents, and that Prof. Rappaport would not enforce the Challenged Patents. *Cf. Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11, 2-3 (Sept. 5, 2025) (finding discretionary denial "not appropriate" where, *inter alia*, "Patent Owner did not assert the challenged patent against Petitioner until eleven years after the parties' discussion about that patent"); *Apple Inc. v. Vampire Labs, LLC*, IPR2025-01215, Paper 9 (Nov. 20, 2025); *id.*, Paper 8, 13-14 (Aug. 27, 2025) (no discretionary denial where patent owner presented the patent to petitioner in 2009 but did not enforce it until 15 years later).

In addition, Patent Owner has asserted that the '358 patent and its related patents are infringed through Petitioners' use of the Wi-Fi, LTE and 5G wireless/cellular standards. Ex. 1015. As Patent Owner has made abundantly clear, Prof. Rappaport had significant involvement in the development of the 5G mmWave standard and claims significant contributions "in wireless communications [that] are widely recognized in the industry." Request at 3-4. Frankly, Prof. Rappaport is a known expert in the field. Yet despite Prof. Rappaport's long involvement in the industry and despite the fact that the earliest application in the Smart Antenna patent family was filed over fifteen years ago, he has never claimed that the '358 patent or

any patents in its family are essential or even related to any of the wireless standards he now accuses of infringement.

III. EFFICIENCY AND CONSISTENCY STRONGLY WEIGH AGAINST DISCRETIONARY DENIAL

Patent Owner has asserted, and Petitioners have challenged, twelve patents across three different families directed to vastly different subject matter and technologies. As a result, the Board is a much more suitable venue for reviewing the Challenged Patents. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 (Director June 13, 2025) ("The large number and vast scope of the patents asserted in the district court litigation (id. at 7) weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter.").

As discussed above, the '358 patent and three other asserted patents belong to what Patent Owner calls the "Smart Antenna patent family." Request at 6-7. Two of these patents (the '763 and '358 patents) are directed to wireless devices equipped with a single, tunable, multi-band antenna capable of transmission and reception on two or more frequency bands simultaneously, and Patent Owner has accused Samsung smartphones and tablets containing certain Qorvo and/or Qualcomm modules that allegedly support active tuning across multiple frequency bands, or ICs that work in substantially the same way. Ex. 1015. The other two (the '625 and '548

patents) are directed to sensor-based beamsteering in wireless devices equipped with a steerable antenna configured to transmit/receive mmWave signals in the frequency range of 10-500 GHz, and Patent Owner has accused Samsung 5G smartphones containing certain Qualcomm antenna modules allegedly capable of beam tracking and beamforming to avoid obstructions.

Patent Owner has also asserted five patents in what it calls the "Intelligent Wireless Broadband Relay patent family." Request at 6-7. These patents claim repeater functionality operating on ultrawideband bandwidth and data rates. For this patent family, Patent Owner has accused devices that support Wi-Fi hotspot functionality or provide 5G cellular data connectivity.

Finally, Patent Owner has asserted three patents in what it calls the "Network Monitoring patent family." Request at 6-7. These patents claim the collection and use of information, including location information, of wireless devices. For this patent family, Patent Owner has accused Samsung's Knox Suite, which is enterprise software running on a server that can track the locations of Samsung devices within an enterprise.

Thus, the twelve challenged patents are directed to three different families and four different technologies: (1) tunable antenna-equipped wireless devices configured for multi-band operation, (2) sensor-based beamsteering in wireless devices with steerable antennas operating at high-frequencies, (3) wireless repeater

functionality using ultrawideband bandwidth, and (4) the collection and use of location information of devices.

Patent Owner nevertheless argues that it would be inefficient for the Board to "evaluate all 340 challenged claims across the Asserted Patents," since Patent Owner claims it will "narrow the case to a small subset of those claims." Request at 2. To the contrary, evaluating all of the challenged claims at once is a far more efficient use of the Board's resources than resolving challenges to a small number of claims, which will inevitably lead to subsequent proceedings when Patent Owner asserts other claims in subsequent litigations, based on Patent Owner's vague assertion it will at some point narrow the case to a smaller number of claims. Further, denying institution based on the aggregate volume of petitions (which are entirely the result of Patent Owner's decision to assert a wide variety of patents in litigation) would merely incentivize patentees to flood the courts with complex litigation involving large numbers of patents. In addition, Patent Owner is currently asserting 131 claims in the parallel litigation, including nearly all independent claims of the twelve Challenged Patents. The claims that Patent Owner is not asserting are almost all short, dependent claims for which the Board will not need to expend much effort to adjudicate. In addition, the District Court involves significantly more prior art than those being raised in the IPR petitions, making it far more likely that the parties will expend less resources resolving the IPR petitions before the Board. Moreover, there

is significant overlap between IPR petitions within each family of patents. The IPR petitions challenging the '763 and '358 patents both assert Wen and Rubinshteyn as primary references, and the IPR petitions challenging all four patents in the Smart Antenna patent family address claim limitations relating to the use of MIMO and beam-switchable antenna arrays, antenna tuning using active elements and/or elements selected or interconnected using electronic control, and multiband antennas that operate simultaneously in a plurality of different bands. Thus, there are significant efficiencies in instituting the IPR petitions.

IV. THE EXAMINER ERRED IN ALLOWING THE '358 PATENT

The examiner erred in allowing the '358 patent by overlooking significant prior art. As discussed above, the '358 patent claims wireless devices equipped with an array of antennas, where at least one of the antennas is a single, tunable, multi-band antenna capable of transmission and reception on two or more frequency bands simultaneously. In addition, the antenna is actively tuned or tuned using passive elements under electronic control.

Yet the '358 patent admits that both multiband antennas and active antenna tuning were well-known. For example, the '358 patent discusses admitted prior art that discloses "an electronically tunable multiple hand antenna" that uses "a controller … [to] enable[] an antenna to be tuned," a "multiple band antenna" that "covers [four] frequency bands and standards," "tunable dielectric materials that

may be utilized in embodiments of the antenna tuners," "tunable capacitance" demonstrated "as able to adaptively tune antennas" available from Paratek Microwave, and "tunable wireless components for multi-band systems" available from Agile Materials. Ex. 1001, 2:11-3:57. The '358 patent further admits that it is "possible to purchase multi-band transceiver chips for popular wireless standards." *Id.*, 6:56-59. The '358 patent also acknowledges that it would be "evident" to implement the claimed antenna "with other antennas … to form an antenna array." *Id.*, 9:66-10:3.

Despite this applicant admitted prior art, the '358 patent merely purports to invent the combination of a multiband antenna, transceivers, and active tuning as part of a well-known antenna array. In particular, the '358 patent claims that its alleged invention uses an antenna "which can be used by multiple transmitters or receivers in different bands," and "exploits the idea of active antenna tuning … to the situation of where multiple band transmitters, receivers, or transceivers must be used simultaneously in a wireless portable device." Ex. 1001, 3:61-4:15.

Yet despite admitting that antenna arrays, multiband antennas, actively tuned antennas, and multiband transceivers were all well-known and/or commercially available, the examiner allowed the claims without a single rejection, determining that the considered prior art did not disclose at least one antenna in an antenna array that "is used by the plurality of transmitters, receivers or transceivers" or by a

"multiband transmitter, receiver or transceiver" "in a plurality of different bands," and is "an actively tuned antenna" or "tuned by one or more passive elements which are selected or interconnected using electronic control." Ex. 1002, 26-30.

Further, during prosecution of the parent '763 patent, the examiner found most of these limitations in the prior art, and ultimately only allowed the claims after applicant argued that the "main feature of the patent application" is "the elimination of a number of antennas and … the use of a single multiband antenna" instead of "having different antenna for each different type of receiver, transmitter, or transceiver." Ex. 1012, 34; *id.*, 35 (arguing that the prior art "[a]t no point … describe[s] having a single antenna receive or transmit at a plurality of different bands"), 45-46 (examiner finding the same limitations disclosed by Rofougaran).

The examiner overlooked the significant body of prior art that discloses multiband antennas that can be used by multiple transceivers (or a single multiband transceiver) in a plurality of different frequency bands—a significant error in view of the fact that both the '763 and 358 patents admit that multiband antennas, active tuning, and multiband transceivers were all known in the art. Such prior art includes Wen and Rubinshteyn, the primary references raised in all the petitions challenging the '763 and '358 patents, which indisputably describe a single multiband antenna used by a plurality of transceivers, or a multiband transceiver. Ex. 1004, [0027] (disclosing an "antenna 33" that "is 'common'" because "it is shared by a plurality

of wireless radio frequency (RF transceivers"), [0031] ("Each wireless RF transceiver preferably has a respective different operating frequency associated therewith."); Ex. 1006, [0016] (disclosing a multiband antenna "which permits simultaneous operation of the device at two different frequencies"), [0022] (disclosing that the multiband antenna has "a common RF input port … which is connected to a duplexer," and in turn, to "a transmitter and receiver."). Further, it would have been obvious to use such antennas in an antenna array in view of Poilasne. *See* Ex. 1009, [0007], [0042], [0060]-[0063], [0067] (disclosing antenna arrays). Wen, Rubinshteyn, and Poilasne all were not before the examiner. In overlooking this art, the examiner committed material error, and "it is an appropriate use of Office resources to review the[se] potential error[s]." *Taiwan Semiconductor Manufacturing Co. v. Marlin Semiconductor Ltd*., IPR2025-00847, Paper 11 (Director Sept. 3, 2025); *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025 00153, Paper 11 at 3 (June 12, 2025) ("Petitioner relies on Letendre to teach a 'slide,' and Patent Owner does not dispute that Letendre teaches a 'slider.'").

V. THE *FINTIV* FACTORS WEIGH AGAINST DISCRETIONARY DENIAL

The *Fintiv* factors heavily weigh against denial, including the fact that trial is scheduled to occur after the statutory deadline for the Board's Final Written Decision in ***all twelve*** IPR proceedings, as well as Petitioners' broad stipulation.

A. Factor 1: The District Court Has Not Indicated Its View on a Stay

Patent Owner attempts to predict how the District Court might rule on a potential post-institution stay motion. Request at 11-13. However, the Board declines to engage in such speculation when the district court has not expressed any position on the matter, instead treating this factor as neutral. *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (P.T.A.B. May 13, 2020) ("We decline to infer, based on actions taken in different cases with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here.").

Patent Owner concedes that the District Court would likely consider and potentially approve a stay if institution occurs across all twelve petitions. Request at 12, 17; *see also Cobblestone Wireless, LLC v. Cisco Systems, Inc.*, No. 2:23-cv-00454-JRG, 2024 WL 5047854 (E.D. Tex. Dec. 9, 2024) (granting stay following institution of IPR against asserted patent); *Emerging Automotive LLC v. Kia Corp. et al.*, No. 2:23-cv-00437-JRG, Dkt. 301 (E.D. Tex. Jun. 30, 2025) (granting stay following institution of IPRs and *ex parte* reexamination against all asserted patents). Indeed, the District Court has shown a recent willingness to grant stays even close to trial. *Stellar LLC v. Motorola Solutions, Inc. et al.*, No. 4:23-cv-750-SDJ, Dkt. 156 (E.D. Tex. Feb. 24, 2025) (imposing stay two weeks before trial, even while awaiting institution decisions on some asserted patents); *Emerging Automotive LLC v. Kia Corp. et al.*, No. 2:23-cv-00437-JRG, Dkt. 301 (E.D. Tex. Jun. 30, 2025)

(approving stay three weeks pre-trial).

B. Factor 2: Trial Is Scheduled After the Final Written Decisions

As Patent Owner concedes, trial is currently scheduled for May 17, 2027. That is well after the April 7, 2027 statutory deadline for the Board's Final Written Decision in this proceeding. It is also after the statutory deadline for the FWD in the last-filed IPR, May 8, 2027. This factor therefore substantially weighs against denial. *Google LLC v. Cellular South, Inc.*, IPR2025-00875, Paper 10, (Director Oct. 17, 2025) ("[I]t is likely that a final written decision in this proceeding will issue before the district court trial occurs, reducing the risk of duplication of efforts and inconsistent outcomes.").

Patent Owner cites to a cherry-picked "median 655 days to trial for cases pending being between Jan. 1, 2022 and Oct. 22, 2025 before Judge Gilstrap." Request at 18. But Patent Owner fails to heed Chief APJ Boalick's instruction to use "median time-to-trial statistics for civil actions ***in the district court.***" March 24, 2025 Guidance on USPTO's Rescission of Vidal Memo. The Eastern District of Texas's official time-to-trial statistics show that the most recent median time-to-trial for the district court is 24.5 months, which would place trial sometime in June 2027, after the current trial date. Ex. 1051. Patent Owner's statistic also fails to consider the significant rise in cases before Judge Gilstrap over the past year.

C. Factor 3: The Parties' Limited Investment In The District Court

Litigation Weighs Against Discretionary Denial

This factor significantly weighs against discretionary denial. At the time of the Board's institution decision, the parallel litigation will be in its early stages with limited investment by the court and parties—including a lack of a *Markman* hearing.

While Patent Owner emphasizes that the parties have exchanged contentions (Request at 18), that is not what the Board considers to be significant investment. More relevant is the fact that the District Court's *Markman* hearing is scheduled for November 10, 2026, many months after the Board's date for deciding institution. Ex. 2018 at 4. Indeed, by the institution decision date of April 7, 2026, the parties will not even have begun the process of claim construction by exchanging proposed terms. Fact discovery has only just begun and is not sched-+uled to be completed until December 28, 2026. Expert discovery will not be completed until February 1, 2027. These dates establish that there has been very little investment in the litigation. *Cf. Coretronic Corp. v. Maxell Ltd.*, IPR2025-00941, Paper 9 (Sept. 26, 2025) (finding meaningful investment where "the parties have participated in a *Markman* hearing, fact discovery was scheduled to close on August 21, 2025, and expert discovery will close soon.").

The primary reason there has been little progress in the litigation so far, despite Judge Gilstrap's propensity for aggressive scheduling, is because Petitioners were diligent in bringing these IPR petitions—all twelve petitions covering a wide

swath of subject matter were filed between 3 to 5 months after Patent Owner filed its complaint.

D. Factor 4: Petitioners' Broad Stipulation

Petitioners have filed a broad stipulation that closes the loophole that the Director identified in *Motorola*. *Motorola Sols.*, IPR2024-01205, Paper 19 at 4 ("Petitioner's invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner's stipulation is not likely to moot.").

Specifically, Petitioners stipulate that, if this petition is instituted (and not later denied institution or dismissed without a Final Written Decision), Petitioners will not assert in the parallel litigation:

> (1) any grounds of invalidity arising under U.S.C. § 102 or § 103 involving only patent or printed publication prior art that could have reasonably been raised before the Board with respect to U.S. Pat. No. 8,593,358 (the '358 patent), including the same grounds in the Petition (Paper 1); or
>
> (2) any grounds of invalidity arising under U.S.C. § 102 or § 103 with respect to the '358 patent that include European Pat. App. No. 1,914,835 ("Wen"), U.S. Pat. Pub. No. 2004/0125027 ("Rubinshteyn"), U.S. Pat. Pub. No. 2004/0095280 ("Poilasne"), U.S. Pat No. 7,489,914 ("Govind"), or U.S. Pat No. 5,962,751 ("Vlahos").

This stipulation includes a *Sotera* stipulation as well as a stipulation not to use any of the IPR prior art, even in combination with system art that could not be raised in the IPR. This stipulation therefore removes any overlap between the parallel litigation and this proceeding, and significantly weighs against denial. *Samsung*

Electronics Co., Ltd. v. Wilus Institute of Standards and Technology Inc., IPR2025-00933 *et al.*, Paper 11 (Director Oct. 10, 2025) ("Petitioner has filed a broad stipulation that reduces the concern of inconsistent outcomes or significant duplication of efforts.").

Patent Owner nevertheless argues that Petitioners' stipulation is "materially narrower" than the stipulation the Office has proposed in its Notice of Proposed Rulemaking. However, Petitioners have already stated they would update their stipulation to be consistent with such proposed rules if and when they are made final. Paper 5, 2 n.1.

E. Factor 5: Petitioners Being the District Court Defendants Does Not Outweigh the Factors Weighing Against Discretionary Denial

Petitioners are the defendants in the district court case. This factor does not outweigh the other factors discussed above.

F. Factor 6: The Merits of the Petition are Strong

Patent Owner does not dispute the substance of the petition. Instead, Patent Owner argues that Petitioner's expert testimony is "merely repeated verbatim in the Petition." Request at 19-20. Petitioner cites to no evidence that Dr. Mahon "repeat[ed]" the Petition—as opposed to the Petition significantly relying on Dr. Mahon's opinions. Indeed, Dr. Mahon makes clear that he "prepared this declaration" and "provid[ed] certain opinions relating to the patentability of the '358

patent." Ex. 1003, ¶2. Clearly, his declaration reflects his opinions, and the Petition is supported by his opinions.

Patent Owner argues that the "Board routinely discounts" "parroting of the Petition's text without technical reasoning." Request at 20. But the Board does not ignore expert testimony just because it is worded similarly with the petition—expert testimony is discounted only if it lacks reasoning or supporting evidence. *See PLR Worldwide Sales Ltd. v. Flip Phone* Games, IPR2024-00171, Paper 31 at 41 ("Xerox stands for the proposition that a declaration is entitled to little weight when it restates a petition's unsupported, conclusory assertions without any additional supporting evidence or reasoning. … [W]e find that the assertions in the Petition are … not conclusory, thus distinguishing this situation from the one described in *Xerox*.").

Patent Owner does not even provide an example of allegedly conclusory or otherwise unsupported opinions offered by Dr. Mahon. Patent Owner merely asserts that the "Petition's analysis for Ground I" is "nearly identical to Dr. Mahon's declaration," Request at 20, which is precisely the type of argument the Board has repeatedly rejected. Dr. Mahon's opinions are based on technical reasoning and evidence, including the disclosures in the prior art.

VI. CONCLUSION

Patent Owner has identified no legitimate basis for the Director to deny institution based on any discretionary factors. Institution should be granted.

DATED: January 26, 2026

Respectfully submitted,

By */s/ James Glass*

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on January 26, 2026, true and correct copies of the foregoing document and supporting materials were served in its entirety at the following email addresses:

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