

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

ZOPHONOS INC.,

Patent Owner

Case IPR2026-00085

U.S. Patent No. 11,900,016

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

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PETITIONERS' EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent 11,900,016 (“’016Pat.”)
1002	Declaration of Chris Kyriakakis, Ph.D. (“Kyriakakis”)
1003	Curriculum Vitae of Chris Kyriakakis, Ph.D.
1004	File History of U.S. Patent No. 11,900,016 (“File History”)
1005	U.S. Patent Application Publication 2008/0137873 (“Goldstein873”)
1006	U.S. Patent Application Publication 2013/0316642 (“Newham”)
1007	U.S. Patent Application Publication 2007/0127734 (“Brulle”)
1008	U.S. Patent Application Publication 2009/0061837 (“Chaudhri”)
1009	U.S. Patent Application Publication 2014/0254842 (“Smith”)
1010	U.S. Patent 8,194,864 (“Goldstein864”)
1011	U.S. Patent Application Publication 2014/0126748 (“Usher”)
1012	U.S. Patent Application Publication 2015/0012826 (“Tengstrand”)
1013	U.S. Patent Application Publication 2013/0064385 (“Jeong”)
1014	NOT USED
1015	NOT USED
1016	Excerpts from Microsoft Computer Dictionary (5th ed. 2002) (“Computer Dictionary”)
1017	Excerpts from Robert Oshana, “DSP Software Development Techniques Embedded and Real-Time Systems” (2006) (“Oshana”)
1018	Excerpts from Thomas D. Rossing, Richard F. Moore, and Paul A. Wheeler, “The Science of Sound” (3rd ed. 2002) (“Rossing”)
1019	Letter from Jin-Suk Park to Andres Healy regarding IPR2026-00085, dated December 17, 2025
1020	NOT USED
1021	NOT USED
1022	NOT USED
1023	NOT USED
1024	First Amended Docket Control Order from <i>Zophonos Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:25-cv-00752-JRG (E.D. Tex.) (Dkt. 39)
1025	<i>Harbor Island Dynamic, LLC v. Samsung Elecs. Co.</i> , No. 2:24-cv-00140-JRG-RSP, Dkt. 81 (E.D. Tex. May 19, 2025)
1026	United States District Courts — National Judicial Caseload Profile,

	as of December 31, 2025 (available at https://www.uscourts.gov/sites/default/files/document/fcms_na_distpr_ofile1231.2025.pdf)
1027	Returned Summons for Samsung Electronics America, Inc. from <i>Zophonos Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:25-cv-00752-JRG (E.D. Tex.) (Dkt. 11)
1028	NOT USED
1029	NOT USED
1030	Plaintiff Zophonos Inc.’s Disclosures of Asserted Claims and Infringement Contentions Cover Pleading from <i>Zophonos Inc. v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:25-cv-00752-JRG (E.D. Tex.)
1031	File History of U.S. Patent No. 11,204,736 (“ <i>File History</i> ’736”)
1032	File History of U.S. Patent No. 10,656,906 (“ <i>File History</i> ’906”)

I. INTRODUCTION

Patent Owner's arguments in support of discretionary denial do not come close to justifying denial of review when measured against the record and governing precedent. This Petition presents substantial unpatentability challenges, was filed promptly, and comes at a point when IPR can serve its intended role as an efficient and focused alternative to district court litigation.

The *Fintiv* factors weigh strongly against discretionary denial. The district court case remains at an early stage, with claim construction and all substantive merits proceedings scheduled to occur months after the institution decision. Trial is unlikely to occur until months after the FWD issues. Samsung has also submitted a *Sotera plus* stipulation to ensure that this IPR serves as a true alternative to the district court proceeding.

Patent Owner also fails to identify any settled expectations that could warrant discretionary denial. The '016 patent is relatively young, Samsung filed its Petition without delay, and there is no evidence of reliance or strategic gamesmanship. Patent Owner's effort to manufacture settled expectations from an examiner's citation of a different patent or from an unasserted and unchallenged portfolio patent finds no support in precedent.

Nor is there any procedural defect in the Petition. Patent Owner's § 42.104(b)(4) arguments merely repackage claim construction and merits disputes

as alleged pleading deficiencies. The Petition identifies where each claim element is found in the prior art and supports those mappings with evidence, fully satisfying the regulation.

Finally, Patent Owner's remaining discretionary arguments do not carry the day. Samsung has not taken, and has not reserved the right to take, inconsistent positions, and Patent Owner identifies no compelling public interest that would be harmed by institution. To the contrary, the public interest favors timely Board review where serious questions of patentability have been raised. Nor is there a reason to deny institution under § 325(d). The references and combination of references presented here were not previously before the Office. And if Patent Owner's representations regarding the similarity of *Golstein*⁸⁷³ and *Goldstein*⁷⁹⁷ are to be credited, then the Office additionally committed material error during prosecution of the '016 patent.

For these reasons, and as set forth below, Patent Owner's request for discretionary denial should be rejected and the Director should refer the Petition for consideration on the merits.

II. ARGUMENT

A. Discretionary Denial Is Not Warranted Under *Fintiv*

The *Fintiv* factors overwhelmingly favor institution: a stay of the parallel litigation is highly likely if review is instituted; the Final Written Decision ("FWD")

is expected before trial; the parallel litigation will remain at an early procedural stage and substantial district court work will remain at the time of institution; Samsung's *Sotera plus* stipulation eliminates any risk of duplicative adjudication; and the Petition diligently presents strong grounds of unpatentability.

1. Factor 1 (Stay): Likelihood Of A Stay Is High

This factor strongly weighs against discretionary denial. By the time of the institution decision—expected no later than May 19, 2026—the parallel litigation will remain in its earliest stages. The Markman hearing will still be more than six months away, and no substantive merits proceedings will have occurred. The claim construction process will not even begin until two months after the institution decision, when the parties exchange proposed terms for construction. EX1024, 4.

Samsung has also challenged every claim asserted in the parallel litigation, to ensure the IPR meaningfully simplifies the district court case.¹ Under these circumstances, courts in the Eastern District of Texas have a well-established track record of granting contested motions to stay following institution of IPRs. *See, e.g., Maxeon Solar Pte. Ltd. v. Canadian Solar Inc.*, No. 2:24-cv-210-JRG, 2025 WL

¹ By way of this Petition, as well as the petitions filed in IPR2026-00083 and IPR2026-00084, Samsung has challenged all claims of all three patents asserted by Zophonos against Samsung in the parallel litigation. *See* EX1030.

1811321 (E.D. Tex. July 1, 2025) (granting stay, IPRs instituted six months before Markman); *Harbor Island Dynamic, LLC v. Samsung Elecs. Co.*, No. 2:24-cv-00140-JRG-RSP, Dkt. 81 (E.D. Tex. May 19, 2025) (EX1025) (stay granted, IPRs instituted at least three months before Markman); *Resonant Sys., Inc. v. Samsung Elecs. Co.*, No. 2:22-cv-0043-JRG-RSP, 2024 WL 1021023 (E.D. Tex. Mar. 8, 2024) (stay granted, IPRs instituted one month before Markman); *Communications Techs., Inc. v. Samsung Elecs. Am., Inc.*, No. 2:21-cv-00444-JRG, 2023 WL 1478447 (E.D. Tex. Feb. 2, 2023) (stay granted, IPRs instituted 1.5 months before Markman).

2. Factor 2 (Trial Date): The FWD Is Expected Before Trial Concludes In District Court

This factor weighs against discretionary denial. Trial is currently scheduled for May 17, 2027; the latest possible date that the FWD can issue is May 19, 2027. EX1024, 1. But it is highly likely that the FWD will issue well in advance of trial.

Under the Director's new streamlined institution procedures, and based on Samsung's review, recent institution decisions show a median of approximately just over five months from the NOFDA to institution. Assuming similar timing here, the FWD would issue about one month before the currently scheduled trial date. Moreover, the current median time-to-trial statistics for the EDTX indicate that trial is likely to occur in August 2027, making it probable that the FWD will issue three

to four months before trial.² Under similar circumstances, the Board has found this factor weighs against discretionary denial. *See, e.g., Hanwha Sols. Corp. v. Maxeon Solar Pte. Ltd.*, IPR2024-01199, Paper 17, at 12-14 (PTAB Feb. 26, 2025) (FWD expected two months before trial “weighs against” denial); *Intel Corp. v. Advanced Cluster Sys., Inc.*, IPR2025-00794, Paper 13, at 2 (Acting Director Aug. 14, 2025) (FWD expected one month before trial “counsel[s] against discretionary denial”).

Zophonos’ reliance on *Samsung Elecs. Co. v. VB Assets, LLC* is misplaced. There, the actual trial date was six months *before* the expected FWD, and the petitioner relied on disputed district court median time to trial statistics to suggest possible contemporaneous timing. IPR2025-00870, Paper 11, at 2 (PTAB Oct. 10, 2025). Here, by contrast, the district court trial is guaranteed not to conclude before the FWD issues and is highly likely to occur months afterward. That likelihood is reinforced by the fact that the district court has scheduled 10 trials for the same date, making it virtually certain that not all can proceed as scheduled.

3. Factor 3 (Parallel Proceeding): Significant Work Remains In The District Court As Of The Institution Deadline

This factor weighs against discretionary denial because, as of the institution

² The latest statistics state a median time from filing to trial of 24 months. EX1026, 35. The complaint in the parallel litigation was filed on July 30, 2025.

decision deadline of May 19, 2026, the district court will not have invested resources in any substantive merits proceedings. The table below summarizes the work that will remain as of the institution decision deadline (EX1024):

Event	Date
Claim Construction Hearing	November 24, 2026
Close of Fact Discovery	December 28, 2026
Opening Expert Reports	December 28, 2026
Rebuttal Expert Reports	January 19, 2027
Close of Expert Discovery	February 1, 2027
Dispositive Motions	February 8, 2027
Dispositive Motion Response Briefs	February 22, 2027
File Pretrial Order	April 5, 2027
Pretrial Conference	April 12, 2027
Jury Selection	May 17, 2027

As shown above, every significant milestone—including claim construction, expert discovery, dispositive and Daubert motions, pretrial proceedings, and trial—will occur months *after* the Board’s institution decision. When virtually the entire substantive case lies ahead, the Board has consistently found factor three to weigh against discretionary denial. *See, e.g., Bio-Rad Labs, Inc., v. Cal. Inst. of Tech.*, IPR2024-01451, Paper 11, at 10 (PTAB Mar. 27, 2025) (factor weighs against discretionary denial where “much more work remains, including, expert reports, expert discovery, expert depositions, and pretrial motions and disclosures”); *see also Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 10 (PTAB Mar. 20, 2020) (precedential) (“If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against

exercising discretion to deny institution.”). Moreover, Samsung has been extremely diligent, bringing this challenge within three months of having been served, and before even having received Patent Owner’s infringement contentions in the district court.³ *Fintiv*, IPR2020-00019, Paper 11, at 11 (“If ... the petitioner filed the petition expeditiously ... this fact has weighed against” denying institution).

4. Factor 4 (Issue Overlap): Petitioners’ *Sotera Plus* Stipulation Ensures No Overlap

This factor weighs strongly against discretionary denial. Samsung has provided a stipulation that goes beyond *Sotera* to ensure that this IPR serves as a true alternative to district court proceeding. Specifically, Samsung has stipulated that if the Petition is instituted, it will not pursue in the district court any grounds that were raised or reasonably could have been raised in the IPR, **and** will not pursue combinations of the IPR prior art with unpublished system prior art. EX1019; *see Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 19 (PTAB Dec. 1, 2020) (precedential); *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19, at 4 (PTAB Mar. 28, 2025).

³ Samsung Electronics America, Inc. was served August 5, 2025 (EX1027), and this Petition was filed November 5, 2025. Patent Owner served its infringement contentions on November 10, 2025. EX1030.

Factor four also weighs against discretionary denial because not all challenged claims are at issue in the parallel litigation. The Petition challenges claims 32-44 of the '016 patent, whereas Patent Owner has asserted only claims 39, 40 and 43 in the district court. EX1030, 1. The Board has repeatedly found that such incomplete overlap weighs against denial. *See, e.g., Precision Planting LLC v. Maschio Gaspardo S.p.A.*, IPR2024-00008, Paper 12, at 18 (PTAB Mar. 26, 2024) (holding inclusion of claims in the petition not contested in court argues against discretionary denial); *Apple Inc. v. Neodron Ltd.*, IPR2020-00778, Paper 10, at 19 (PTAB Sep. 14, 2020) (factor four weighs against discretionary denial because “the ITC will not consider the validity of challenged claims 13 and 14”); *PUMA North Am., Inc. v. Nike Inc.*, IPR2019-01043, Paper 8, at 9-10 (PTAB Oct. 31, 2019) (the litigation does not address all challenged claims).

5. Factor 5 (Parties): This Factor Does Not Warrant Denial

This factor should be neutral. *Fintiv* only addresses the scenario in which the petitioner is unrelated to a defendant in a parallel proceeding, finding this should weigh against denying institution. But *Fintiv* “says nothing about situations in which the petitioner is the same as, or is related to, the district court defendant.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15, at 10-11 (PTAB May 15, 2020) (APJ Crumbley, dissenting). In any event, this factor cannot overcome the strong weight of the other factors.

6. Factor 6 (Other Considerations): The Petition's Merits Are Strong, And No Other Factors Warrant Exercising Discretion To Deny Institution

This factor weighs strongly against discretionary denial. Samsung acted diligently in filing the Petition, and the Petition presents compelling grounds of unpatentability. Patent Owner suggests it will reserve its substantive merits arguments for the POPR, thereby attempting to shield those arguments from response at this stage. But if Patent Owner's § 42.104(b)(4) arguments are any indication, those arguments will also rest on ignoring or mischaracterizing Samsung's evidence and reasoning. Nothing identified by Patent Owner justifies discretionary denial in light of the strength of the Petition and Samsung's diligence.

B. Patent Owner Has No Settled Expectations

Patent Owner has no settled expectations warranting discretionary denial. Patent Owner effectively concedes that the '016 patent's age does not create any settled expectations; it was in force for less than two years when this challenge was filed. Rather, Patent Owner argues there are settled expectations because (i) Samsung allegedly knew of the '016 patent, and (ii) a related patent that it has neither asserted against Samsung nor Samsung has challenged is more than six years old. DD Br., at 9. Neither is sufficient to create settled expectations for Patent Owner.

Patent Owner first contends that in March 18, 2025, the '016 patent was cited as a reference in a Samsung patent application. *Id.* But it was the Examiner—not

Samsung—who cited the '016 Patent in a list of thirteen prior art references on the same day that she allowed the pending claims. EX2001, 231-50. The Examiner never rejected the claims over the '016 Patent and Samsung itself never addressed or acknowledged the '016 Patent in any way. There is no reason to believe that Samsung even noticed, much less analyzed, the '016 patent, and Patent Owner provides not authority to support that such an inference is reasonable.

Even if Patent Owner's allegation was taken at face value, it would still be insufficient to establish settled expectations. Samsung filed this Petition within approximately eight months of the alleged knowledge. That timing is not indicative of delay or reliance. By analogy, Congress permits post-grant review to be filed within nine months of issuance. *See* 35 U.S.C. § 321(c). Filing an IPR within months of alleged awareness is inconsistent with any claim that Samsung sat on its rights or allowed reliance interests to accrue.

The decisions Patent Owner cites confirm this point. In each, the petitioner's knowledge was longstanding and accompanied by additional equities entirely absent here. In *Murata*, the challenged patent was more than sixteen years old, and the petitioner and patent owner had previously discussed the technology covered by the patent. *Murata Mfg. Co. v. Georgia Tech. Rsch. Corp.*, IPR2025-00383, Paper 14, at 2 (PTAB Jul. 29, 2025). In *Google*, the petitioner had been aware of the challenged patent for six years before filing its IPR. *Google LLC v. SoundClear Techs. LLC*,

IPR2025-00344, Paper 15, at 2-3 (PTAB Aug. 4, 2025). In *RegenX*, the petitioner had previously licensed the challenged patent and had the right to participate in its prosecution, creating reliance interests far beyond mere awareness. *RegenX Sci., Inc. v. NextGen Biologics, Inc.*, IPR2025-00620, Paper 13, at 2 (PTAB July 31, 2025). And in *Nvidia*, the petitioner had a longstanding commercial relationship with the patent owner and had been aware of the patents for at least eight years. *Nvidia Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18, at 2-3 (PTAB July 31, 2025).

Patent Owner next argues that settled expectations arise because the '016 patent is part of a broader portfolio containing an older patent. DD Br., at 10. That argument is equally unsupported. The cases Patent Owner cites do not stand for the proposition that the mere existence of older, unasserted patents in a portfolio creates settled expectations with respect to a newer patent. Rather, they reinforce that settled expectations depend on the age of the challenged patent itself and the petitioner's knowledge of that patent—not generalized awareness of a portfolio.⁴ See *NKT Photonics Inc. v. Omni Continuum LLC*, IPR2025-00839, Paper 10, at 2 (PTAB Sept. 4, 2025) (challenged patent had been in force for nearly seventeen years, and the petitioner had known about that specific patent for thirteen years); *Datadome*

⁴ Moreover, Patent Owner does not allege that Samsung knew of its “portfolio” prior to March 2025, only eight months before this challenge was filed.

S.A. v. Arkose Labs Holdings, Inc., IPR2025-00693, -694, Paper 13, at 2 (PTAB Aug. 14, 2025) (challenged patents had been in force for approximately seventeen and ten years, and petitioner had known about them—not merely the patent owner’s portfolio—for years before filing); *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, -602, -603, Paper 9, at 2-3 (PTAB July 24, 2025) (denying institution for patents in force for six and seven years, while expressly referring patent in force for only three years for consideration on the merits).

In short, this case lacks every hallmark of settled expectations. The ’016 patent is relatively young, Samsung filed its Petition promptly, and there is no evidence of reliance, delay, commercial entanglement, or strategic sandbagging.

C. The Petition Does Not Violate 37 C.F.R. § 42.104(b)(4)

Section 42.104(b)(4) merely requires that a petition identify where each claim element is disclosed in the asserted prior art; Samsung’s Petition satisfies the regulation. Patent Owner’s attempts to convert its disagreement with the Petition’s analysis into alleged threshold defects should be rejected.

Patent Owner first argues that the Petition fails to address limitation 32[e][ii], which recites “transmitting, to the at least one output device, an alert.” DD Br., at 11-12. That assertion is incorrect. The Petition includes a detailed, two-page discussion—supported by expert testimony—explaining why limitation 32[e][ii] would have been obvious in view of *Goldstein*⁸⁷³. See Pet., at 59-60. Patent

Owner's assertion that this limitation is "missing entirely" disregards that analysis.

Patent Owner next argues that the Petition purportedly maps the claimed "output device" to Newham's master device for limitations 32[c]/39[c], but then fails to rely on that disclosure for limitation 32[e][ii]. DD Br., at 12. That argument mischaracterizes the Petition when it states that the Petition maps the claimed output device to *Newham's* master earpiece. While the Petition speaks for itself, the conclusion of the discussion pertaining to 32[c]/39[c] summarizes the actual argument: "the *Goldstein873-Newham* combination teaches a pair of earpieces 100 including a second earpiece having a speaker configured to operate as a slave device to output audio stream received from the master device ('at least one output device')." *See* Pet., at 18-25, 53. Patent Owner also fails to explain why when read in context the Petition's discussion of 32[c]/39[c] and 32[e][ii] fail to clearly explain how the prior art meets each limitation.

Not satisfied with mischaracterizing the Petition, Patent Owner further asserts without explanation that the alleged failure to address limitation 32[e][ii] "cuts across all challenged claims and renders the Petition fundamentally deficient." DD Br., at 12. That assertion is facially incorrect. No other challenged claim includes a limitation analogous to 32[e][ii], and Patent Owner does not explain how an alleged deficiency with respect to a single limitation in a single claim could invalidate the

Petition as a whole.⁵

Patent Owner next contends that the Petition improperly fills gaps in *Goldstein873* through expert testimony that relies on a reference that is not part of the asserted grounds. DD Br., at 12. Patent Owner mischaracterizes the Petition as having acknowledged *Goldstein873* does not disclose monitoring sound pressure levels, but the Petition states the opposite—namely, that *Goldstein873* expressly discloses an earpiece that “can actively **monitor** a sound pressure level both inside and outside the ear canal.” Pet., at 15. The Petition relies on Dr. Kyriakakis’s expert testimony, supported by evidence exemplified by *Goldstein864*, to explain how a POSITA would have understood *Goldstein873*’s monitoring of sound pressure levels to encompass monitoring the amplitude of ambient and in-ear sounds. See Pet., at 16-17. The Petition uses that evidence to explain what a POSITA would have understood *Goldstein873* to disclose, not to substitute a missing disclosure or add an unasserted reference to the grounds. *Home Depot USA, Inc. v. Lynk Labs, Inc.*, IPR2021-01540, Paper 46, at 27-28 (PTAB Mar. 29, 2023). The same is true with respect to the “smart speaker” limitation of claim 43, where the Petition relies on expert testimony supported by evidence to explain why a POSITA would have

⁵ While challenged dependent claims 41 and 42 recite an “alert,” they do not specify where the alert is outputted.

understood *Goldstein*⁸⁷³ to teach such a device. *See* Pet., at 40-44.

Finally, Patent Owner asserts that the limitations of claim 38 are missing from the prior art. DD Br., at 12-13. But Patent Owner's objection reflects a disagreement over claim scope, not a failure of disclosure. The Petition is explicit about how a POSITA would have understood the claim and explains in detail how the prior art discloses the recited feature. *See* Pet., at 67-69. Patent Owner's disagreement with that interpretation does not mean the Petition failed to "specify where each element of the claim is found."

D. Samsung Has Not Taken, Nor Has It Reserved The Right To Take, Inconsistent Positions

Patent Owner's assertion that Samsung has "reserved the right" to take "alternative" or "inconsistent" claim construction positions is unfounded. DD Br., at 14. In its Petition, Samsung made the unremarkable and entirely proper statement that it reserves the right to raise claim construction arguments in the parallel litigation because, "[f]or example, comparing the claims to the accused products in the litigation may raise controversies that require construction of certain claim terms." Pet., at 10 n.3. Nothing in that statement suggests an intention to advance claim constructions inconsistent with any express or implicit position taken in this IPR, much less that Samsung has done so.

Notably, the district court case is not even at the stage where claim construction positions are being formulated. The parties are not scheduled to exchange proposed constructions for nearly three months after the institution decision. EX1024, 4. Any suggestion that Samsung has already committed itself to inconsistent constructions is meritless. Moreover, the Director has exercised vigilance in ensuring that parties do not take inconsistent claim construction positions in district court without an explanation. *See, e.g., Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 36 (Director Jan. 26, 2026). While Samsung may propose constructions for certain terms in the district court, it does not intend to propose constructions that contradict implicit or express positions it has taken in this IPR.⁶

Patent Owner also criticizes Samsung for asserting invalidity defenses under §§ 101 and 112 in the district court. DD Br., at 14. But Samsung is unaware of any Director decision holding that defenses based on lack of written description, lack of enablement, or patent-ineligible subject matter—which can only be raised in district

⁶ Moreover, Patent Owner is wrong that taking inconsistent position is always prohibited. DD Br., at 13-14. Rather, where a party does so, it needs to “explain sufficiently why the different positions are warranted.” *Revvo Techs.*, IPR2025-00632, Paper 20, at 5 (Director Nov. 3, 2025) (precedential).

court—implicate concerns about inconsistent claim construction positions. Patent Owner identifies no authority suggesting otherwise. The assertion of statutory defenses unavailable in IPR does not reflect gamesmanship or inconsistency; it recognizes the distinct scopes of the two proceedings.

To be sure, Samsung has also raised defenses under §112(b) in district court. But that is because EDTX P.R. 3-3 requires Samsung to raise all possible invalidity defenses in its invalidity contentions, which were due four months before the institution decision here. EX1024, 5. As the Director has recognized, where a party advances a construction in district court and the court ultimately adopts a different construction, the party has a legitimate basis for proceeding under the court-adopted construction before the Board. *Revvo Techs.*, IPR2025-00632, Paper 36, at 4. By the same reasoning, the Director should deem it proper for a petitioner to preserve the ability to raise a claim construction position in district court if IPR is not instituted.

In short, Samsung has neither reserved the right nor intends to take inconsistent positions.

E. No Compelling Public Interests Warrant Denial Of Institution

Rather than identifying any concrete public interest that would be harmed by institution, Patent Owner relies on generalized, unsupported assertions about the importance of its technology and its status as an individual inventor. Moreover, if Patent Owner's contention that the '016 patent implicates public health or safety

were accepted, that consideration favors institution, not denial. The public has a strong interest in ensuring that patents asserted in such contexts do not encompass unpatentable subject matter that could deter legitimate activity, especially early in the patent's life as is the case here. Institution in this case would therefore advance, rather than undermine, the public interest.

F. Discretionary Denial Under § 325(d) Is Not Warranted

Patent Owner argues for discretionary denial under § 325(d) because *Goldstein873*—only one of five references relied upon in the Petition—is allegedly substantively similar to *Goldstein797*, which was cited in an IDS during prosecution of the '016 patent. Even assuming *arguendo* (which Samsung does not concede) that *Goldstein873* and *Goldstein797* contain substantially similar disclosures, discretionary denial under § 325(d) is not warranted because neither prong of the *Advanced Bionics* analysis is satisfied. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, at 8 (PTAB Feb. 13, 2020) (precedential); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, at 17-18 (PTAB Dec. 15, 2017) (precedential).

The first *Advanced Bionics* factor is not met because the Petition is not based on the same or substantially the same art and arguments previously considered by the Office. The Petition challenges claims 32-44 based on combinations of *Goldstein873* with one or more of *Newham*, *Brulle*, *Chaudhri*, and *Smith*. *See Pet.*,

at 2. Patent Owner does not dispute that none of these additional references were previously considered by the Office, nor does it argue that their disclosures are duplicative of any prior art previously considered. Where, as here, “the Office did not previously consider all of the prior art references or combinations of references relied on in the Petition,” the first *Advanced Bionics* prong is not satisfied. *BMW of N. Am., LLC v. Foras Techs. Ltd.*, IPR2024-01347, Paper 7, at 22-23 (PTAB Mar. 7, 2025); *see also BMW of N. Am., LLC v. Michigan Motor Techs., LLC*, IPR2023-01032, Paper 14, at 16 (PTAB Jan. 29, 2024).

Because the first *Advanced Bionics* factor is not satisfied, discretionary denial under § 325(d) is unwarranted and the inquiry need go no further. But even if the Director were to consider the second factor, it too weighs against denial. The record demonstrates that the Office materially erred during examination of the ’016 patent. The prosecution history reflects an exceptionally cursory examination: the Examiner indicated that all 61 then-pending claims were directed to allowable subject matter in the very first Office Action. EX1004, 187-196. That pattern was not unique to the ’016 patent—the claims of its parent and grandparent patents were likewise never rejected based on the prior art. EX1031, 295-300, 355-62, 435-46 (file history of U.S. Patent No. 11,204,736); EX1032, 182-90 (file history of U.S. Patent No. 10,656,906).

Indeed, if Patent Owner’s assertion that *Goldstein797* is substantively similar to *Goldstein873* were accepted, it means *Goldstein797* was highly material to the examination of at least claims 32-44 of the ’016 patent for the same reasons that *Golstein873* is material as set out in the Petition. The Office’s failure to reject at least claims 32-44 of the ’016 patent during examination based on *Goldstein797*—indeed, its failure to issue any prior art-based rejections during prosecution—is itself evidence of examination error under *Advanced Bionics* factor two. *Ecto World, LLC v. Rai Strategic Holdings, Inc.*, IPR2024-01280, Paper 13, at 5-6 (Acting Director May 19, 2025) (precedential) (“A petitioner also may point to the fact that even though the asserted prior art is listed on an IDS, the Examiner did not issue any prior art rejections during examination, so the Examiner materially erred by overlooking certain teachings in the prior art on the IDS.”).

Accordingly, neither prong of the *Advanced Bionics* framework supports discretionary denial, and § 325(d) provides no basis to deny institution here.

III. CONCLUSION

For the foregoing reasons, Samsung respectfully request that the Director decline to exercise discretion to deny institution and refer this Petition for consideration on the merits.

Date: February 19, 2026

Respectfully submitted,

/Ali R. Sharifahmadian/

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CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that

(1) this Petitioners' Opposition to Patent Owner's Request for Discretionary Denial of Institution complies with the 20-page limitation, excluding the parts exempted by 37 C.F.R. § 42.24(a); and

(2) this brief complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft Word 365 in 14 point Times New Roman.

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CERTIFICATE OF SERVICE

I certify that on February 19, 2026, I caused a true and correct copy of the foregoing Petitioners' Opposition to Patent Owner's Request for Discretionary Denial of Institution and supporting exhibits to be served via electronic mail in their entirety on the following:

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