UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSARA INC.
Petitioner

v.

MOTIVE TECHNOLOGIES, INC.,
Patent Owner

Case IPR2026-00108
U.S. Patent No. 12,062,243

PATENT OWNER MOTIVE TECHNOLOGIES, INC.'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

Page

I. INTRODUCTION 1

II. BACKGROUND 4

A. The Motive California Case 4

B. Samsara's *Delaware Case*, the ITC Case and the Arbitration 6

C. Samsara's Petitions for IPRs on Motive's Patents Asserted in the *Motive California Case* and Samsara's Motion for a Stay of Motive's Patent Infringement Claims at the District Court 7

III. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(a) 7

A. Factor 1: Whether the Court Granted a Stay, or Evidence Exists that One May Be Granted if a Proceeding Is Instituted 8

B. Factor 2: Proximity of the Court's Trial Date to the Board's Projected Statutory Deadline 13

C. Factor 3: Investment in the Parallel Proceeding by the Court and the Parties 15

D. Factor 4: Overlap Between Issues Raised in the Petition and in the Parallel Proceeding 17

E. Factor 5: Whether the Petitioner and the Defendant in the Parallel Proceeding Are the Same Party 18

F. Factor 6: Other Circumstances that Impact the Board's Exercise of Discretion 18

IV. CONCLUSION 19

TABLE OF AUTHORITIES

Page(s)

Cases

Apple Inc. v. Fintiv, Inc.,
IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) 3, 8, 13, 14

Asetek Holdings, Inc v. Cooler Master Co.,
No. 13-cv-00457, 2014 WL 1350813 (N.D. Cal. Apr. 3, 2014) 13

Baker Hughes Inc. v. Liquidpower Specialty Prods. Inc.,
No. IPR2016-01896, 2017 WL 1215811 (P.T.A.B. Mar. 31, 2017).....19

Charter Commc'ns, Inc. v. Adaptive Spectrum & Signal Alignment, Inc.,
No. IPR2025-00088, 2025 WL 1474824 (P.T.A.B. May 22, 2025) 17

Deeper, UAB v. Vexilar, Inc.,
No. IPR2018-01310, Paper 7 7

Delphix Corp. v. Actifio, Inc.,
No. 5-13-cv-04613, Dkt. No. 118 (N.D. Cal. Nov. 13, 2014).....10

Delphix Corp. v. Actifio, Inc.,
No. 5-13-cv-04613, Dkt. No. 170.....10

Fulfillium, Inc. v. ReShape Med., LLC,
No. 17-cv-08419, 2018 WL 9848044 (C.D. Cal. June 4, 2018) 12

Harmonic Inc. v. Avid Tech., Inc.,
815 F.3d 1356 (Fed. Cir. 2016) 7

IMAX Corp. v. In-Three, Inc.,
385 F. Supp. 2d 1030 (C.D. Cal. 2005) 12

JBF Interlude 2009 Ltd. v. Quibi Holdings LLC,
No. 20-cv-02299, 2020 WL 6203555 (C.D. Cal. Oct. 19, 2020) 14

NHK Spring Co., Ltd. v. Intri-Plex Technologies, Inc.,
No. IPR2018-00752, Paper 8 .....2, 13

Otto Bock HealthCare LP v. Ossur HF,
No. 13-cv-00891, 2013 WL 12313020 (C.D. Cal. Dec. 16, 2013) 13

Samsung Elecs. Co., Ltd. v. Truesight Commc'ns LLC,
No. IPR2024-01477, 2025 WL 1167567 (P.T.A.B. Apr. 21, 2025) 18

Samsung Electronics Co. v. KP Innovations 2, LLC,
No. IPR2025-00101, 2025 WL 1369735 (P.T.A.B. 2025).....15

SmartSky Networks LLC v. Gogo Business Aviation LLC,
No. IPR2025-00672, 2025 WL 2178448 (P.T.A.B. 2025).....14, 15

Solus Advanced Materials Co, Ltd. v. Sk Nexilis Co., Ltd.,
No. IPR2024-01460, 2025 WL 1171851 (P.T.A.B. Apr. 22, 2025) 17

Space Data Corp. v. Alphabet Inc.,
No. 16-cv-03260, 2019 WL 1131420 (N.D. Cal. Mar. 12, 2019).....11

TPK Touch Sols., Inc v. Wintek Electro-Optics Corportation,
No. 13-cv-02218, 2013 WL 5289015 (N.D. Cal. Sept. 18, 2013) 13

Statutes

35 U.S.C. § 101.....5

35 U.S.C. § 314(a) 3, 7

35 U.S.C. § 316(a)(11).....14

TABLE OF EXHIBITS

Exhibit No.	Description of Document
2001	Memorandum Opinion issued by the U.S. District Court for the District of Delaware in *Samsara Inc. v. Motive Technologies, Inc.*, Case No. 1:24-cv-00084 (D. Del.), on August 14, 2024 (Dkt. 60)
2002	Scheduling Order issued by the U.S. District Court for the Northern District of California in *Motive Technologies, Inc. v. Samsara Inc.*, Case No. 3:24-cv-00902 (N.D. Cal.), on August 8, 2025 (Dkt. 115)
2003	Samsara Inc.'s Motion for Partial Stay Pending *Inter Partes* Review filed in *Motive Technologies, Inc. v. Samsara Inc.*, Case No. 3:24-cv-00902 (N.D. Cal.), on November 25, 2025 (Dkt. 147)
2004	Motive Technologies Inc.'s Opposition to Samsara Inc.'s Motion for Partial Stay Pending *Inter Partes* Review filed in *Motive Technologies, Inc. v. Samsara Inc.*, Case No. 3:24-cv-00902 (N.D. Cal.), on December 9, 2025 (Dkt. 148)
2005	Samsara Inc.'s Invalidity Contentions in *Motive Technologies, Inc. v. Samsara Inc.*, Case No. 3:24-cv-00902 (N.D. Cal.), dated November 18, 2025
2006	Motive Technologies Inc.'s Complaint filed in *Motive Technologies, Inc. v. Samsara Inc.*, Case No. 3:24-cv-00902 (N.D. Cal.), on February 15, 2024 (Dkt. 1)
2007	Motive Technologies Inc.'s Second Amended Complaint filed in *Motive Technologies, Inc. v. Samsara Inc.*, Case No. 3:24-cv-00902 (N.D. Cal.), on July 9, 2025 (Dkt. 107)

I. INTRODUCTION

Pursuant to the Director's March 26, 2025 Memorandum Regarding Interim Processes for PTAB Workload Management and the PTAB's Notice of Filing Date Accorded (Paper 3), Patent Owner Motive Technologies, Inc. ("Motive" or "Patent Owner") files this Request for Discretionary Denial of Institution of the Petition filed by Samsara, Inc. ("Samsara" or "Petitioner") on November 14, 2025 (Paper 1, "Petition") requesting *inter partes* review ("IPR") of U.S. Patent No. 12,062,243 (Ex. 1001, "the '243 Patent"), challenging Claims 1-33 ("the Challenged Claims").

Samsara and Motive are direct competitors and have been litigating against each other since January 2024. In the case most substantively relevant to this IPR, on February 15, 2024, Motive sued Samsara in the U.S. District Court for the Northern District of California for infringing U.S. Pat. No. 11,875,580 ("the '580 Patent"), and for several non-patent claims. Case No. 3:24-cv-00902 ("the *Motive California Case*"). In the *Motive California Case*, Samsara asserted counterclaims for infringement of U.S. Pat. Nos. 11,975,685; 10,033,706; and 12,069,041 on May 15, 2025. On July 9, 2025, Motive filed an amended complaint alleging infringement of all of the Challenged Claims of the '243 Patent, as well as for infringement of U.S. Pat. No. 12,136,276 ("the '276 Patent"). About three weeks before the *Motive California Case* was filed, Samsara sued Motive on January 24, 2024 in the District of Delaware ("the *Delaware Case*") alleging infringement of

U.S. Pat. Nos. 11,190,373 ("the '373 Patent"), 11,127,130 ("the '130 Patent") and 11,611,621 ("the '621 Patent") and also lodging several non-patent claims. Samsara also initiated an investigation at the International Trade Commission ("ITC") alleging infringement of the '373 Patent, the '130 Patent and the '621 Patent shortly thereafter.

Now, Samsara files this IPR attacking the '243 Patent with at least one improper aim: staying Motive's patent infringement causes of action (but not the other causes of action) in the *Motive California Case*, while Samsara's own causes of action against Motive move forward. In short, Samsara wants its patent claims against Motive to be litigated before Motive's patent claims against Samsara, not the other way around. Samsara believes institution of this IPR might help it obtain that partial stay in the *Motive California Case*.

Gamesmanship is not what IPRs are for. Motive asks the Director to reject Samsara's attempt to achieve an unfair and prejudicial advantage in the co-pending litigations between the parties through this IPR.

Allowing this IPR to proceed simultaneously with the *Motive California Case* would also be wasteful and inefficient. Indeed, granting institution here would frustrate one of the primary objectives of the America Invents Act, which is "to provide an effective and efficient alternative" to parallel litigation, not create additional litigation. *NHK Spring Co., Ltd. v. Intri-Plex Technologies, Inc.*, No.

IPR2018-00752, Paper 8, at 19-20 (quoting *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16-17 (P.T.A.B. Sept. 6, 2017) (precedential)). Instituting an IPR here would simply add another litigation to the already pending cases.

The factors for discretionary denial espoused in *Apple v. Fintiv* counsel in favor of denial here. The Director should exercise discretion to deny the IPR under 35 U.S.C. § 314(a) for at least the following reasons: (i) the *Motive California Case* will proceed whether or not this IPR is instituted because there are non-patent causes of action and Samsara's counterclaims for patent infringement in that case do not relate to the '243 Patent, and there is no evidence that a stay might be granted if the present proceeding is instituted; (ii) assuming institution, the trial in the *Motive California Case* may conclude before the PTAB issues a Final Written Decision ("FWD"), and that trial will almost definitely commence before any FWD is final and binding after any appeals; (iii) Motive has heavily invested in the *Motive California Case* already, and it will continue to do so. It has briefed dispositive motions, prepared infringement contentions, engaged in claim construction discovery, and will begin preparing soon for a *Markman* hearing scheduled for April 16, 2026 (which means the parties will be arguing claim construction prior to the statutory deadline for the PTAB to reach its institution decision here; by about one month); (iv) there is overlap in the issues here and in

the parallel *Motive California Case*; (v) the Petitioner here and the Defendant in the *Motive California Case* are the same; and finally; (vi) other circumstances counsel in favor of denial, including that instituting the IPR would be unfairly prejudicial to Motive in the other pending litigations between the parties.[1]

II. BACKGROUND

Motive and Samsara are direct competitors in "the market for driver safety and fleet management technology," (*i.e.*, "dashcam technology"). Ferraro Ex. 2001,[2] *Samsara Inc. v. Motive Technologies, Inc.*, Case No. 1:24-cv-00084, at Dkt. 60 at 1 (Aug. 14, 2024 D. Del.) ("*Delaware Case*"); Ferraro Ex. 2003, *Motive California Case*, Dkt. 147 at 9 (Samsara admits that "Motive and Samsara are competitors"). As noted above, in January and February 2024 Samsara and Motive commenced lawsuits against each other, alleging patent and non-patent causes of action in the U.S. District Courts for the District of Delaware and the Northern District of California, respectively.

A. The Motive California Case

On February 15, 2024, Motive commenced the *Motive California Case* in the Northern District of California, alleging infringement of the '580 Patent and

[1] Additionally, the Director should deny institution of the IPR on the merits for the reasons stated in the forthcoming Patent Owner's Preliminary Response, which will be filed by February 25, 2026.

[2] "Ferraro Ex." Refers to the Exhibits attached to the accompanying Declaration of Vincent M. Ferraro.

also alleging fraud, defamation, intentional interference with prospective economic relations, and violations of the Lanham Act, the California Uniform Trade Secrets Act, the Defend Trade Secrets Act and the California Unfair Competition Law. Ferraro Ex. 2006, *Motive California Case*, Dkt. 1. Motive later amended the Complaint to allege infringement of the '243 Patent at issue here and the '276 Patent. Ferraro Ex. 2007, *Motive California Case*, Dkt. 107.

The *Motive California Case* was stayed from June 4, 2024 to March 31, 2025 in light of the related proceedings in the *Delaware Case* and in private arbitration. *Motive California Case*, at Dkts. 52, 85.

On May 15, 2025, Samsara asserted counterclaims for patent infringement against Motive in the *Motive California Case*. *Id.*, at Dkt. 94.

On July 9, 2025, the District Court in California granted Motive's motion to amend its complaint in the *Motive California Case* to add patent infringement claims based on the '243 Patent at issue here and the '276 Patent, both of which issued during the stay. *Id.*, at Dkt. 106.

On July 23, 2025, Samsara moved to dismiss all of Motive's patent infringement claims in the *Motive California Case* pursuant to Fed. R. Civ. P. 12(b)(6) and 35 U.S.C. § 101, and some of the non-patent claims under Rule 12(b)(6) and as allegedly barred by the statute of limitations. *Id.*, at Dkt. 112. As of August 13, 2025, the motion has been fully briefed, and the Court is in the

process of deciding the motion on the papers. *Motive California Case*, at Dkts. 113, 116-117.

B. Samsara's *Delaware Case*, the ITC Case and the Arbitration

Samsara commenced the *Delaware Case* on January 24, 2024, alleging infringement of the '373 Patent, the '130 Patent, and the '621 Patent, and also alleging fraud and violations of the Lanham Act, Computer Fraud and Abuse Act, and the California Unfair Competition Law. *Delaware Case*, Dkt. 1.

On February 8, 2024, Samsara filed a Complaint with the ITC pertaining to the alleged infringement by Motive of the same patents asserted in the *Delaware Case*. Ferraro Ex. 2001, *Delaware Case*, Dkt. 60 at 2.

On February 28, 2024, Motive commenced an arbitration against Samsara pursuant to Samsara's commercial Terms of Service agreement. *Id*., at 2-3.

On August 14, 2024, the *Delaware Case* was transferred to the Northern District of California. *Id*. On March 31, 2025, the Northern District of California stayed Samsara's patent infringement claims in the former *Delaware Case* pending the ITC investigation and stayed Samsara's tort claims pending in the parties' arbitration. *Samsara Inc. v. Motive Technologies Inc.*, Case No. 3:24-cv-6049 (N.D. Cal.), Dkt. 23; Dkt. 108.

C. Samsara's Petitions for IPRs on Motive's Patents Asserted in the *Motive California Case* and Samsara's Motion for a Stay of Motive's Patent Infringement Claims at the District Court

On August 27, 2025, the PTAB instituted review of Samsara's petition for IPR of the '580 Patent, which was filed on February 14, 2025. *See* IPR2025-00574, Paper 12.

On October 17, 2025 and November 14, 2025, Samsara filed petitions for IPRs of the '276 Patent and '243 Patent, respectively. *See* IPR2026-00034; IPR2026-00108. The Director has not yet instituted review of either Petition.

Importantly for purposes of this brief, on November 25, 2025, Samsara moved to stay Motive's patent infringement claims in the *Motive California Case*. Ferraro Ex. 2003, Dkt. 147. Notably, Samsara did not move to stay its counterclaims, or any of Motive's non-patent claims. *Id*.

Motive filed its opposition to the motion to stay on December 9, 2025. Ferraro Ex. 2004, Dkt. 148.

III. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(a)

The Director has wide discretion to deny institution "even when a petitioner demonstrates a reasonable likelihood of prevailing with respect to one or more claims." *Deeper, UAB v. Vexilar, Inc.*, No. IPR2018-01310, Paper 7, at 42 (citing *SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 366 (2018)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1366-67 (Fed. Cir. 2016)). Consideration of the six factors set

forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 5-6 (P.T.A.B. Mar. 20, 2020) (precedential), necessitates denial of the Petition here.

A. Factor 1: Whether the Court Granted a Stay, or Evidence Exists that One May Be Granted if a Proceeding Is Instituted

A stay has not been granted as to Motive's patent infringement causes of action in the *Motive California Case*. There is no evidence that one will be granted. On the contrary, there is evidence that the California district court *will not* stay these claims.

The court in the *Motive California Case* is moving the case forward on its present schedule. On August 8, 2025, the court entered a Scheduling Order providing for the following deadlines (among others):

- **October 2, 2025**: Disclosure of Asserted Claims and Infringement Contentions with accompanying document production
- **November 18, 2025**: Invalidity Contentions with accompanying document production
- **December 3, 2025 – February 19, 2026**: Claim Construction Discovery
- **March 5-26, 2026**: Claim Construction Briefing
- **January 9, 2026 – April 3, 2026**: Damages Contentions
- **April 2-9, 2026**: Written Technology Synopsis; Case Tutorial
- **April 16, 2026**: Claim Construction Hearing
- **July 24, 2026**: Non-Expert Discovery Cutoff
- **November 14, 2026**: Expert Discovery Cut-off

- **April 15, 2027**: Hearing on Dispositive Motions and *Daubert* Motions
- **August 30, 2027**: Jury Trial

Ferraro Ex. 2002, *Motive California Case*, Dkt. 115.

The court expressly further ordered: "**All dates set by the Court should be regarded as firm.** Counsel may not modify these dates by stipulation without leave of court." *Id*. (emphasis added). The parties have been litigating under these deadlines for several months. The court warned that these deadlines are "firm" and has given no indication that it will issue a stay, due to this IPR or otherwise.

The court's clear directive that the case deadlines are "firm" aside, there are other logical reasons the court in the *Motive California Case* is not likely to grant a stay even if this proceeding is instituted.[3]

First, Samsara's partial stay request is itself evidence that a stay is not likely to be granted in the *Motive California Case* even if this proceeding is instituted, because the stay requested would not meaningfully streamline the *Motive California Case.* This fact removes from the analysis one reason courts usually grant stays. Staying only Motive's patent causes of action (again, the only thing

[3] Motive respectfully refers the Director to the parties' briefing on Samsara's motion to stay Motive's patent infringement claims attached as Exhibit 2003 (Samsara's Motion) and Exhibit 2004 (Motive's Opposition).

Samsara asked the court to do) but having Samsara's patent counterclaims as well as the non-patent claims go forward would not meaningfully reduce litigation. In opposition to Motive's similar motion requesting discretionary denial of institution of IPR2026-00034, Samsara relies on an order in a district court case in which the defendants requested, and the Court granted, a stay of the entire case. *See* IPR2026-00034 at EX1075. This Order is distinguishable to what Samsara requests here: a stay of Motive's patent infringement claims, but not of its own patent infringement claims. Claim construction disclosures and briefing, a *Markman* hearing, fact discovery, expert discovery, pretrial motions, and trial will all still happen on the present schedule in the *Motive California Case* for the other causes of action. Motive is not aware that there is any evidence showing that the Northern District of California will partially stay a case if an IPR is instituted when other causes of action and counterclaims will move forward anyway.

In IPR2026-00034, Samsara also relies on *Delphix Corp. v. Actifio, Inc.*, No. 5-13-cv-04613, Dkt. No. 118 (N.D. Cal. Nov. 13, 2014), for its argument that the District Court in the *Motive California Case* will grant its motion for a partial stay. However, the partial stay in *Delphix* was temporary, and ultimately, the court stayed the case in its entirety (including both parties' claims unrelated to the patents subject to IPRs for efficiency purposes). *Delphix Corp. v. Actifio, Inc.*, No. 5-13-cv-04613, Dkt. No. 170. This case is therefore distinguishable because the

court did not do what Samsara is asking for at the district court – i.e., staying just the patent claims subject to its IPR challenges.

Similarly, the California court is likely to consider that a stay as to Motive's patent claims will cause significant inefficiencies even if this proceeding is instituted. Samsara's counterclaims will be litigated now, yet many of the same witnesses will need to testify again on Motive's patent infringement claims unless Samsara prevails on all of its IPRs. Specifically, Motive expects to have at least nine (9) fact witnesses for its patent infringement claims that may overlap with Samsara's patent infringement counterclaims, including (1) a hardware engineer, (2) a front end engineer, (3) a firmware engineer, (4) a back end engineer, (5) a data scientist, (6) a product manager, (7) a finance employee, (8) a marketing employee, and (9) a sales employee. Ferraro Decl. ¶ 12.

To avoid such duplicative, piecemeal litigation, courts often decline to stay cases that involve additional patents or non-patent claims not at issue in the parallel USPTO proceedings. We expect the Northern District of California will do the same here. *See, e.g.*, *Space Data Corp. v. Alphabet Inc.*, No. 16-cv-03260, 2019 WL 1131420, at *3 (N.D. Cal. Mar. 12, 2019) ("Indeed, staying the '706 patent would have no effect on the '193 patent infringement claim, the DTSA and CUTSA trade secret claims, or the breach of contract claim. In other words, the parties are set to try this action in August 2019 and the principals and numerous

witness[es] are set to appear irrespective of whether the '706 patent is stayed. …Thus, staying the '706 patent also poses a risk of wasted resources as the Court would have to reconvene the parties and witnesses at a later date if the asserted claims of the '706 patent survive IPR."); *Fulfillium, Inc. v. ReShape Med., LLC*, No. 17-cv-08419, 2018 WL 9848044, at *2 (C.D. Cal. June 4, 2018) ("courts have found stays unwarranted in cases involving several claims unrelated to patent infringement") (vacated on other grounds); *IMAX Corp. v. In-Three, Inc.*, 385 F. Supp. 2d 1030, 1032-33 (C.D. Cal. 2005) (denying motion to stay because of the "myriad" of non-patent claims and counterclaims that would remain unresolved if the patent at issue was reexamined).

Second, evidence exists that Motive would be unfairly prejudiced and tactically disadvantaged by a partial stay of the *Motive California Case* if this proceeding is instituted, and Motive believes the California court would consider this as another reason not to grant a stay. Motive and Samsara compete head-to-head in the marketplace. Ferraro Ex. 2001 at 2; Ferraro Ex. 2003 at 15. Samsara continues to sell the accused products and profit from the conduct Motive challenges, while Samsara seeks to delay adjudication of Motive's claims. Meanwhile, Samsara's own patent claims would continue to move toward trial under the existing schedule. In considering stays, "[c]ourts have often found prejudice where, as here, the non-moving party is a direct competitor of the

movant." *TPK Touch Sols., Inc v. Wintek Electro-Optics Corportation*, No. 13-cv-02218, 2013 WL 5289015, at *3 (N.D. Cal. Sept. 18, 2013); *Asetek Holdings, Inc v. Cooler Master Co.*, No. 13-cv-00457, 2014 WL 1350813, at *5 (N.D. Cal. Apr. 3, 2014); *Otto Bock HealthCare LP v. Ossur HF*, No. 13-cv-00891, 2013 WL 12313020, at *3 (C.D. Cal. Dec. 16, 2013). That the parties are direct, head-to-head competitors is evidence that a stay is not likely to be granted.

Third, as explained below under Factor 2, the FWD and any appeals of that FWD will not be resolved before the trial in the *Motive California Case*. And as explained below under Factor 3, the parties and the Court have already invested significant resources in litigating Motive's patent infringement claims. This is evidence that the court may consider this case too advanced to partially stay it.

In sum, there is ample evidence that the district court will deny Samsara's request to stay Motive's patent infringement claims, yet there is no evidence that the court might partially stay the case if there is an institution here. Accordingly, this factor weighs in favor of discretionary denial.

B. Factor 2: Proximity of the Court's Trial Date to the Board's Projected Statutory Deadline

As the Board held in *Fintiv*: "If the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*. If the court's trial date is at or around the same time as the projected statutory deadline or even significantly after

the projected statutory deadline, the decision whether to institute will likely implicate other factors discussed herein, such as the resources that have been invested in the parallel proceeding." IPR2020-00019, Paper 11, at 9 (P.T.A.B. Mar. 20, 2020) (precedential decision).

Here, the statutory deadline for the issuance of a FWD is May 25, 2027, which may be extended by the Director for good cause to November 25, 2027. 35 U.S.C. § 316(a)(11). The trial in the *Motive California Case* is scheduled for August 30, 2027. *See* Ferraro Ex. 2002. And whether or not the trial in the *California Case* is before or after the FWD (if the IPR is even instituted), the FWD will not become binding until the time to appeal has passed, and then not until after any appeal of the FWD is resolved, which will certainly be after the scheduled trial in the *Motive California Case* in August 2027. *See JBF Interlude 2009 Ltd. v. Quibi Holdings LLC*, No. 20-cv-02299, 2020 WL 6203555, at *8 (C.D. Cal. Oct. 19, 2020) (citing *Evolutionary Intelligence, LLC v. Sprint Nextel Corp.*, 2014 WL 4802426, at *4 (N.D. Cal. Sept. 26, 2014)) ("determinations made by the PTAB during IPR review will not become binding on this Court until the parties have exhausted the appeals process before the Federal Circuit.").

Additionally, the Director has exercised discretion to deny institution even where the district court trial date was many months after the statutory date for the FWD where other factors favor discretionary denial. *See, e.g.*, *SmartSky Networks*

LLC v. Gogo Business Aviation LLC, No. IPR2025-00672, 2025 WL 2178448, at *1 (P.T.A.B. 2025) (granting request for discretionary denial where district court trial was scheduled 5 months after the FWD date); *Samsung Electronics Co. v. KP Innovations 2, LLC*, No. IPR2025-00101, 2025 WL 1369735, at *10-11 (P.T.A.B. 2025) (exercising discretion to deny institution where district court trial was scheduled 4 months after the FWD date). As explained herein, the other factors favor discretionary denial. In opposing Motive's motion requesting discretionary denial in IPR2026-00034, Samsara argues that the decision in *SmartSky* supports its argument because the Acting Director found that the fact that the trial date was projected to occur months after the FWD weighed in favor of denying the motion for discretionary denial. Samsara misses the point. Even if this factor weighs against discretionary denial, the Director may deny institution where other factors favor discretionary denial—as they do here. Similarly, the Director exercised discretion to deny institution in *Samsung* because "it would not be an efficient use of the Board's time and resources to institute review." *Samsung Electronics*, 2025 WL 1369735, at *10-11. The same is true here.

Accordingly, this factor either weighs in favor of denial of institution of the IPR, or is neutral.

C. Factor 3: Investment in the Parallel Proceeding by the Court and the Parties

The parties and the court have already invested significant resources in

litigating the *Motive California Case*, including the causes of action related to the Challenged Claims. As stated above, Samsara has already filed a fully-briefed motion to dismiss the patent infringement claims based on the '243 Patent and the other patents-in-suit. The court is in the process of deciding the motion on the papers. Motive served infringement contentions and a production of 17,277 pages of documents. Ferraro Decl. ¶ 9. Samsara served invalidity contentions and a production of 6,188 pages of documents. *Id*. The parties have exchanged claim terms, claim constructions and extrinsic evidence. *Id*. ¶ 10. Claim construction briefing and a *Markman* hearing will be completed before May 25, 2026, the statutory date for determination of institution of the IPR. *See* Ferraro Ex. 2002. Damages contentions and a technology tutorial provided to the Court will also be completed prior to May 25, 2026. *Id*. And, significantly, the parties will have substantially completed their respective document productions prior to May 25, 2026. *Id*. The parties have also expended resources on other fact discovery, including conducting numerous source code inspections (on both sides), serving 264 requests for production and 33 interrogatories, and issuing more than a dozen third-party subpoenas. Ferraro Decl. ¶ 11.

Additionally, almost all of the pretrial work will be completed in the *Motive California Case* by April 15, 2027 – one month before the statutory date for the FWD. *See* Ferraro Ex. 2002.

In opposing Motive's motion requesting discretionary denial in IPR2026-00034, Samsara argues that Motive argued that the case was in the early stages as of May 2025 when it moved to amend its complaint to add the '276 and '243 patents. Since May 2025, however, the parties engaged in significant discovery and other proceedings as detailed above.

Based on the foregoing, this factor weighs in favor of discretionary denial.

D. Factor 4: Overlap Between Issues Raised in the Petition and in the Parallel Proceeding

In both the *Motive California Case* and the Petition, Samsara seeks to invalidate all 33 claims of the '243 Patent based on obviousness. Samsara relies on two of the primary references in the Petition, Chun and Chao, in the *Motive California Case* too. *Compare* Pet. at 3-6 & Ex. 1005 (Chun), Ex. 1006 (Chao) *with* Ferraro Ex. 2005 (Samsara's Invalidity Contentions) at 14-15. Therefore, these issues overlap. Thus, this factor also weighs in favor of discretionary denial.

Samsara's Stipulation (Paper 6) states that, if this IPR is instituted, it "will not raise in the district court any grounds raised or that reasonably could have been raised in the Petition…" But this Stipulation is not dispositive of Motive's motion. Notwithstanding similar stipulations filed by other petitioners in other IPRs, the Director has exercised discretion to deny institution based on other factors. *See, e.g., Charter Commc'ns, Inc. v. Adaptive Spectrum & Signal Alignment, Inc.*, No. IPR2025-00088, 2025 WL 1474824, at *5 (P.T.A.B. May 22, 2025); *Solus*

Advanced Materials Co, Ltd. v. Sk Nexilis Co., Ltd., No. IPR2024-01460, 2025 WL 1171851, at *7 (P.T.A.B. Apr. 22, 2025); *Samsung Elecs. Co., Ltd. v. Truesight Commc'ns LLC*, No. IPR2024-01477, 2025 WL 1167567, at *5 (P.T.A.B. Apr. 21, 2025).

E. Factor 5: Whether the Petitioner and the Defendant in the Parallel Proceeding Are the Same Party

The parties in this Petition and the *Motive California Case* are identical. Samsara is the Petitioner and the defendant in the *Motive California Case*. Patent Owner/Motive is the plaintiff in the *Motive California Case*. Therefore, this factor weighs strongly in favor of discretionary denial of institution of the IPR.

F. Factor 6: Other Circumstances that Impact the Board's Exercise of Discretion

Samsara and Motive are direct competitors in the dashcam technology market and have been vigorously litigating competing patent infringement claims and non-patent claims against each other for the past two years. Samsara is using this IPR proceeding to bolster its motion to stay Motive's patent infringement claims in the *Motive California Case*. Such a stay would give Samsara the unfair advantage of litigating its patent infringement claims before Motive, thereby delaying Motive from obtaining injunctive and other relief pursuant to its patent claims. Samsara's attempt to use this IPR for this improper strategic purpose related to its larger litigation plan against Motive causes this factor to also weigh in

favor of discretionary denial. *See Baker Hughes Inc. v. Liquidpower Specialty Prods. Inc.*, No. IPR2016-01896, 2017 WL 1215811, at *4 (P.T.A.B. Mar. 31, 2017) ("We have exercised our discretion to deny institution when the facts of the case indicate that a petitioner has used an AIA proceeding to gain an unfair advantage.").

In addition to the foregoing, Motive respectfully refers the Director to its forthcoming Preliminary Response to the Petition, which provides additional reasons why Samsara's obviousness arguments are likely to fail on the merits. The lack of a meritorious IPR also favors discretionary denial.

IV. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion to deny institution of the Petition in its entirety.

Dated: January 26, 2026 Respectfully submitted,

KELLEY DRYE & WARREN LLP

/*VINCENT M. FERRARO*/
Vincent M. Ferraro
Registration No. 79,197
Attorney for Patent Owner
Motive Technologies, Inc.

7 Giralda Farms
Suite 340
Madison, NJ 07940
(973) 503-5927

CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION has 4,344 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

Dated: January 26, 2026

Respectfully submitted,

KELLEY DRYE & WARREN LLP

/*VINCENT M. FERRARO*/

Vincent M. Ferraro
Registration No. 79,197
Attorney for Patent Owner
Motive Technologies, Inc.

7 Giralda Farms
Suite 340
Madison, NJ 07940
(973) 503-5927

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that on January 26, 2026, a true and correct copy of the foregoing **PATENT OWNER MOTIVE TECHNOLOGIES, INC.'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** along with all the corresponding exhibits was served in its entirety electronically via e-mail (by consent) upon the following counsel for Petitioner:

Jason D. Eisenberg (Lead Counsel)
Lestin Kenton (Back-up Counsel)
Bryn Mendenhall (Back-up Counsel)
Sterne, Kessler, Goldstein & Fox PLLC
1101 K Street, NW, 10th Floor
Washington, DC 20005
Jasone-PTAB@sternekessler.com
Lkenton-PTAB@sternekessler.com
Bmendenhall-PTAB@sternekessler.com
6PTAB@sternekessler.com

Respectfully submitted,

KELLEY DRYE & WARREN LLP

/*VINCENT M. FERRARO*/

Vincent M. Ferraro
Registration No. 79,197
Attorney for Patent Owner
Motive Technologies, Inc.

Date: January 26, 2026

7 Giralda Farms
Suite 340
Madison, NJ 07940
(973) 503-5927