UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NETWORK-1 TECHNOLOGIES, INC.,
Patent Owner.

IPR2026-00114
Patent 11,233,780

PATENT OWNER'S BIFURCATED DISCRETIONARY DENIAL BRIEF PURSUANT TO THE DIRECTOR'S MARCH 26, 2025 MEMORANDUM

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37 C.F.R. § 42.107(b) 3, 11

EXHIBIT LIST

Exhibit	Description
EX2001	Complaint for Patent Infringement, *Network-1 Technologies, Inc. v. Samsung Electronics Co., Ltd., et al.*, EDTX-2-25-cv-00667, Dkt. 1 (June 27, 2025)
EX2002	Docket Control Order, *Network-1 Technologies, Inc. v. Samsung Electronics Co., Ltd., et al.*, EDTX-2-25-cv-00667, Dkt. 26 (Oct. 10, 2025)
EX2003	U.S. Patent No. 11,606,204
EX2004	U.S. Patent No. 11,973,864
EX2005	U.S. Patent No. 12,166,869
EX2006	*Reserved*
EX2007	U.S. Patent No. 12,207,094
EX2008	U.S. Patent No. 11,916,893
EX2009	Google Patents Page for U.S. Patent No. 11,606,204, https://patents.google.com/patent/US11606204B2/en?oq=11606204 (accessed Jan. 13, 2026)
EX2010	Google Patents Page for U.S. Patent No. 11,233,780, https://patents.google.com/patent/US11233780B2/en?oq=11%2c233%2c780 (accessed Jan. 13, 2026)
EX2011	September 2, 2016 Rejection of Samsung Patent Application No. 14/803,946
EX2012	U.S. Patent Publication No. 2015/0163056
EX2013	U.S. Patent Publication No. 2015/0121066
EX2014	September 6, 2018 Notice of Allowance and Notice of References Cited for Samsung Patent Application No. 15/350,963
EX2015	U.S. Patent Publication No. 2015/0143125
EX2016	Defendants' Patent Local Rule 3-3 Disclosure of Invalidity Contentions, *Network-1 Technologies, Inc. v. Samsung Electronics Co., Ltd., et al.*, EDTX-2-25-cv-00667 (December 9, 2025)
EX2017	*Reserved*
EX2018	Declaration of Eric J. Enger in Support of Patent Owner's Discretionary Denial Brief
EX2019	Declaration of John Nix in Support of Patent Owner's Discretionary Denial Brief
EX2020	Email chain dated September 27, 2016, produced with Bates Nos. NWO_SAM_00013288–90
EX2021	Email chain dated December 21, 2016, produced with Bates No. NWO_SAM_00013295

EX2022	"Patent Portfolio for 'Embedded SIMs' and the 'Internet of Things,'" produced with Bates Nos. NWO_SAM_00013436–37
EX2023	Email chain dated January 3, 2017, produced with Bates Nos. NWO_SAM_00013296–97
EX2024	U.S. Patent Application No. 14/099,329

I. Introduction

Patent Owner Network-1 Technologies, Inc. ("Network-1" or "PO") respectfully requests that the Director discretionarily deny Samsung Electronics Co., Ltd.'s and Samsung Electronics America, Inc.'s (collectively, "Samsung" or "Petitioner") Petition to institute *inter partes* review of U.S. Patent No. 11,233,780. In support of discretionary denial, Network-1 submits this briefing—limited in scope to discretionary denial issues—pursuant to the Director's March 26, 2025 Memorandum.

First, the parallel district court lawsuit will address the same invalidity grounds that are at issue in this proceeding, and the resolution of the lawsuit will coincide with the final written decision in this proceeding. By that time, the parties will have invested considerable resources in the district court litigation, which favors discretionary denial.

Second, Samsung has known of the challenged patent families since at least 2016, when Samsung learned about them during prosecution of its own patents and directly from the inventor. Thus, the settled expectations of the parties support discretionary denial.

Finally, the merits of the Petition are weak. The Petition relies on five references that were before the Patent Office during prosecution. But even when that art is combined, it fails to disclose key claim limitations of the '780 independent

claim. And because the '780 Patent is entitled to its priority date, Petitioner's last ground is moot.

Network-1 therefore respectfully requests that the Director exercise his discretion to deny institution.

II. Factual Background

A. Network-1's Lawsuit is Scheduled for Trial Within Days Of Any Final Written Decision Deadline

On June 27, 2025, Network-1 sued Samsung in District Court for infringing six patents: U.S. Patent Nos. 11,233,780 ("the '780 Patent"); 11,916,893 ("the '893 Patent"); 12,207,094 ("the '094 Patent"); 12,166,869 ("the '869 Patent"); 11,606,204 ("the '204 Patent"); and 11,973,864 ("the '864 Patent") (collectively, the "Asserted Patents" or the "Challenged Patents"). EX2001 at 2. Trial in the district court litigation is scheduled to start on June 7, 2027. EX2002 at 1.

About four months after the lawsuit began—between November 7 and November 26, 2025—Samsung filed IPR Petitions challenging each of the Asserted Patents. The following table shows the accorded filing date and projected final written decision deadline[1] for each IPR proceeding (with the information for this proceeding in bold and underlined):

[1] Projected final written decision deadlines were calculated based on Patent Owner's Preliminary Response being filed within three months of the notice of filing date

Patent No.	IPR No.	Accorded Filing Date	Projected Final Written Decision
11,606,204	IPR2026-00115	2025-11-20	2027-05-20
11,973,864	IPR2026-00116	2025-11-20	2027-05-20
12,166,869	IPR2026-00117	2025-12-01	2027-06-01
11,233,780	**IPR2026-00114**	**2025-12-03**	**2027-06-03**
12,207,094	IPR2026-00118	2025-12-03	2027-06-03
11,916,893	IPR2026-00119	2025-12-03	2027-06-03

In each IPR proceeding, the PTAB is projected to issue its final written decision within days of the scheduled June 7, 2027 District Court trial date.

B. The Challenged Patents Address Related Subject Matter

The Challenged Patents were all invented by John Nix (who also serves as a consultant for Network-1) in 2013 and were acquired by Network-1 in 2017. *See* EX2019 ¶ 2. They consist of three patent families, each of which addresses related subject matter (*e.g.*, secure device authentication in a wireless network). As shown below, the Challenged Patents are interrelated and cross-cite to one another.

The ’204 and ’864 Patents are both titled “SYSTEMS AND METHODS FOR ‘MACHINE-TO-MACHINE’ (M2M) COMMUNICATIONS BETWEEN MODULES, SERVERS, AND AN APPLICATION USING PUBLIC KEY

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accorded issue date, an institution decision issuing within three months from the Patent Owner’s Preliminary Response, and a final written decision issuing within one year of any institution decision. *See* 37 C.F.R. § 42.107(b); 35 U.S.C. §§ 314(b), 316(a)(11).

INFRASTRUCTURE (PKI)" and both issued from a common series of continuation applications. EX2003 at 1:1-20; EX2004 at 1:1-22.

The '869 Patent is titled "KEY DERIVATION FOR A MODULE USING AN EMBEDDED UNIVERSAL INTEGRATED CIRCUIT CARD." EX2005 at 1:1-3. The '869 Patent cites to the subject matter of U.S. Patent Application No. 14/055,606 (a parent application of both the '204 and '864 Patents, EX2003 at 1:10-20; EX2004 at 1:10-22) as related subject matter, incorporating the disclosure by reference. EX2005 at 1:35-41.

And the '780, '094, and '893 Patents are all titled "EMBEDDED UNIVERSAL INTEGRATED CIRCUIT CARD SUPPORTING TWO-FACTOR AUTHENTICATION" and issued from a common series of continuation applications. EX1001 at 1:1-24; EX2007 at 1:1:32; EX2008 at 1:1-27. All three patents refer to U.S. Pat. No. 9,319,223 (a parent application of the '869 Patent, EX2005 at 1:8-21) as related subject matter. EX1001 at 1:25-30; EX2007 at 1:33-38; EX2008 at 1:28-34. And as noted above, the '869 Patent family refers to the '204 and '864 Patents as related subject matter.

C. Samsung Has Known of the Challenged Patent Families Since 2016

Samsung has known about the inventions disclosed in the Challenged Patents and their relevance since well before the filing of the District Court Proceeding. More specifically, Samsung learned about these inventions in two ways: during

prosecution of its own patents, and from prior licensing discussions with the inventor.

First, Samsung repeatedly learned about Network-1's inventions while prosecuting its own patents. For example, Google Patents shows that the '204/'864 disclosure was cited to Samsung *11 times* and the '780/'094/'893 disclosure was cited to Samsung *4 times*. EX2009 at 50-62 (Google Patents "Cited By" Pages For '204 Patent); EX2010 at 51-56 (Google Patents "Cited By" Pages For '780 Patent).

Indeed, Samsung was made aware of the disclosures of each of the Challenged Patents during prosecution of Samsung's patent applications when it received a rejection citing those disclosures. For example, on September 2, 2016, the USPTO issued a rejection of Samsung's U.S. Patent Application No. 14/803,946 based on U.S. Patent Publication No. 2015/0163056, EX2011 at 5, and U.S. Patent Publication No. 2015/0121066, EX2011 at 3. Those references included the disclosures of the Challenged Patents, as explained below:

- '780/'094/'893 Patents: U.S. Patent Publication No. 2015/0163056 is the publication of Application No. 14/099,329, EX2012 at (21), which is a parent application to the Challenged '780, '094, and '893 Patents. EX1001 at 1:8-24; EX2007 at 1:8-32; EX2008 at 1:8-27.
- '869 Patent: U.S. Patent Publication No. 2015/0163056 incorporates by reference Application No. 14/084,141, EX2012 at [0001], which is a parent

application to the Challenged ’869 Patent. EX2005 at 1:8-22; *see also* EX2014 at 13 (an examiner citing the ’869 Patent disclosure[2] during prosecution of another Samsung application on Sept. 6, 2018).

- ’204/’864 Patents: U.S. Patent Publication No. 2015/0121066 is the publication of Application No. 14/064,618, EX2013 at [0021], which incorporates by reference Application No. 14/055,606, EX2013 at [0003], which is a parent application to the Challenged ’204 and ’864 Patents. EX2003 at 1:10-20; EX2004 at 1:10-22.

Second, Samsung learned about Network-1’s inventions as part of licensing and/or acquisition discussions between Samsung and the inventor. For example, in September 2016, the inventor’s representative first told the leader of Samsung’s Networking division about these inventions. *See* EX2020; EX2019 ¶ 3-4. Then in December 2016, the inventor’s representative “shared a summary of the patent portfolio with the head of IoT at Samsung Korea.” *See* EX2021; EX2019 ¶ 5. The summary specifically identified Patent No. 9,276,740 (parent to the ’204 and ’864 Patents); Patent No. 9,319,223 (parent to the ’869 Patent); and Patent No. 9,100,175

[2] The examiner cited U.S. Patent Publication No. 2015/0143125, EX2014 at 13, which is the publication of U.S. Patent Application No. 14/084,141, EX2015 at (21), which is a parent application to the ’869 Patent, EX2005 at 1:8-21.

(parent to the '780, '094, and '893 Patents). *See* EX2022; EX2019 ¶ 5. Samsung "reviewed the patents" by at least January 2017 and, despite strong patent reads, "decided not to pursue." *See* EX2023; EX2019 ¶ 6.

Despite all of this, Samsung never moved to challenge any patents in the Challenged Patent families prior to November 2025—more than 9 years after being made aware of the content and relevance of the disclosures.

III. Argument

As shown below, the *Fintiv* factors "support the exercise of authority to deny institution in view of an earlier trial date" in parallel district court litigation. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (PTAB March 20, 2020) (precedential) ("*Fintiv I*"). Additional considerations affecting the Director's discretion include the settled expectations of the parties and Samsung's excessive reliance on an expert declaration. Taken together, these considerations counsel in favor of discretionary denial.

A. The *Fintiv* Factors Support Discretionary Denial

The Director should deny the Petition under 35 U.S.C. §314(a) and *Fintiv* because of the significant investment in the parallel District Court Proceeding that will occur before the USPTO will issue a final written decision in this proceeding (or any other proceeding regarding the Challenged Patents). Network-1 sued Samsung for infringement of the Challenged Patents on June 27, 2025 in *Network-1*

Technologies, Inc. v. Samsung Electronics Co., Ltd., et al., Case No. 2:25-cv-00667 (E.D. Tex.) (the "District Court Proceeding"). EX2001 (Complaint). Trial in the District Court Proceeding is scheduled to start on June 7, 2027—within days of the projected final written decision deadlines in each of the IPR proceedings for the Challenged Patents. *See supra* Section II.A.

The Director has discretion to deny institution under 35 U.S.C. § 314(a). *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016). The USPTO should exercise such discretion here and deny the Petition because the same invalidity arguments will be addressed, and resolved, in the co-pending District Court Proceeding at essentially the same time that the Board would issue a final written decision in these IPR proceedings. Accordingly, institution of the IPR challenges here would not be an efficient use of the Board's resources.

The USPTO considers the presence and status of parallel district court litigation in determining whether to deny institution. *See NHK Spring Co. Ltd. v. Intri-Plex Techs. Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 17 (PTAB May 13, 2020) (informative) [hereinafter "*Fintiv*"]; *see also Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017) ("[W]e recognize that an objective of the AIA is to provide an effective and efficient alternative to district court litigation . . . ."). *Fintiv* "sets forth factors that

balance considerations of system efficiency, fairness, and patent quality when a patent owner raises an argument for discretionary denial due to the advanced state of a parallel proceeding." *Fintiv*, Paper 15 at 7–8.

The factors are:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Id. "[T]he Board examines these factors, which relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution. In evaluating the factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review." *Id.* (internal citations omitted). As detailed below, these factors favor discretionary denial.

1. Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

This factor favors discretionary denial because, although Samsung recently filed a motion to stay the parallel District Court Proceeding, that motion will almost certainly be denied based on the Court's well-known practice. Samsung is concurrently challenging claims of six different patents asserted in the District Court Proceeding in the Eastern District of Texas. And the "universal practice" in that district is to "den[y] stay requests when the PTAB has not yet acted on the petition for review." *Tessera Advanced Techs., Inc. v. Samsung Elecs. Co.*, 2018 U.S. Dist. LEXIS 120999, *10-11 (E.D. Tex. July 19, 2018). Thus, until the Director makes his institution decisions in each IPR proceeding, Samsung's stay motion will certainly be denied.

But even if the Director decides to institute IPR on some of the Challenged Patents, the Eastern District of Texas is unlikely to stay the litigation. That is because "[i]t has been [that district's] consistent and long established practice to deny motions to stay pending IPR . . . when the PTAB . . . [has] instituted review on less than all asserted claims of all asserted patents." *AGIS Software Development LLC v. Google LLC*, No. 2:19-cv-361-JRG, 2021 U.S. Dist. LEXIS 24195, at *9 (E.D. Tex. Feb. 9, 2021); *see Force Mos Tech., Co. Ltd. v. Asustek Computer, Inc.*, No. 2:22-cv-460-JRG, 2024 U.S. Dist. LEXIS 66423, at *10 (E.D. Tex. Apr. 11, 2024) (similar). Thus, pursuant to established precedent from that Court, to have any

chance of receiving a stay, each of Samsung's six Petitions would need to be instituted.

In sum, there is strong evidence that Samsung's stay motion will be denied, which favors discretionary denial. At minimum, "there is insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial." *Coretronic Corp. v. Maxell, Ltd.*, IPR2025-00474, Paper 11 at 2 (PTAB Jul. 10, 2025) (Acting Dir. Stewart, C.M.).

2. Factor 2: proximity of the court's trial date to the Board's projected statutory deadline for a final written decision

Factor 2 favors discretionary denial because the trial in the District Court Proceeding will occur within days of the projected final written decision deadline in this IPR proceeding (as well as the IPRs for each of the other Challenged Patents). *See supra* Section II.A. If the USPTO institutes in this case, the anticipated deadline for the Board's final written decision would be June 3, 2027. *See* Paper 5; *see also* 37 C.F.R. § 42.107(b); 35 U.S.C. §§ 314(b), 316(a)(11). Under the current schedule, the District Court trial will occur within a few days of that date—on June 7, 2027.

This factor favors denial given the proximity between the District Court Proceeding trial date and the projected final written decision deadline. *See, e.g., Advanced Micro Devices, Inc. et al. v. Concurrent Ventures, LLC et al.,* IPR2025-00223, Paper 9 at 2 (Acting Director Stewart June 12, 2025) (discretionarily denying based—in part—on the final written decision deadline and scheduled trial date being

within approximately two weeks of each other) (reversed on rehearing due to subsequent stay in district court proceeding). "Even though a district court trial date that occurs after a projected final written decision date reduces the possibility of conflicting decisions, that benefit does not outweigh the efficiencies gained by avoiding parallel proceedings in this instance because of the parties' meaningful investment in the district court proceeding…" *Id*. Given the near total investment in the District Court Proceeding that will occur before any final written decision might issue in this proceeding, this factor likewise favors discretionary denial here.

3. Factor 3: investment in the parallel proceeding by the court and the parties

This factor weighs in favor of discretionary denial because of the significant investment the district court and the parties have already made, as well as the work that will be done before the institution decision. In the District Court Proceeding, the parties have already exchanged their infringement and invalidity contentions. EX2002 at 4-5 (Docket Control Order); EX2018 ¶¶ 2-3. Further, the parties have responded to voluminous written discovery—answering dozens of interrogatories and several requests for admission. EX2018 ¶ 5. The parties have also produced and reviewed tens of thousands of pages of documents. *Id.* ¶¶ 2-3, 6. And the parties have served third-party subpoenas on five chipmakers including Qualcomm, NXP, and Infineon; and mobile network operators AT&T, T-Mobile, and Verizon. *Id.* ¶5. Thus, by the projected institution deadline of June 3, 2026, the district court and the

parties will have spent considerable resources on the parallel district court litigation.

4. Factor 4: overlap between issues raised in the petition and in the parallel proceeding

Factor 4 favors discretionary denial given the complete overlap between the invalidity allegations in the District Court Proceeding and the Petition.

Samsung asserts the following Grounds in this IPR:

#	Claims	Ground (All Grounds are Based on Obviousness)
1	1-15, and 17-20	"Secure Profile Provisioning Architecture for Embedded UICC" by Jaemin Park, et al. ("Park") (EX1005), GlobalPlatform Card Specification v2.1.1 ("GlobalPlatform") (EX1006), and "A Fast and Secure Elliptic Curve Based Authenticated Key Agreement Protocol For Low Power Mobile Communications" by Pierre Abi-Char et al. ("AbiChar") (EX1007)
2	1-15, and 17-20	Park, GlobalPlatform, and "ANSI X9.63 Overview" by Simon Blake-Wilson ("X9.63 Overview") (EX1008)
3	16	Park, GlobalPlatform, AbiChar, and U.S. Patent Publication No. 2015/0350881 to Weiss et al. ("Weiss") (EX1009)
4	16	Park, GlobalPlatform, X9.63 Overview, and Weiss
5	1-20	U.S. Patent No. 9,100,175 to Nix ("Nix 175") (EX1016), Park, and GlobalPlatform

Petition at 3.

Samsung is asserting the same grounds in the District Court Proceeding, as shown in its invalidity contentions and summarized in the table below.

Reference	Page of Invalidity Contentions (EX2016)	Name Used in Invalidity Contentions
Park	8	"Park (IEEE)"
GlobalPlatform	8	"GlobalPlatform"
AbiChar	8	"Abi-Char"
X9.63 Overview	8	"ANSI X9.63 Overview"
Weiss	7	"Weiss"
Nix 175	7	"Nix"

see also EX2016 (Invalidity Contentions) at 6 (incorporating by reference "all filings and exhibits from *Inter Partes* Review IPR2026-00114"). Thus, there is total overlap between the Petition grounds and District Court Proceeding.

Despite this overlap, the Petition itself offered no stipulation (*Sotera* or otherwise) to attempt to mitigate the duplication of effort that would occur if this IPR was instituted. Rather than offer such a stipulation "as soon as practicable,"[3] Samsung instead delayed nearly three weeks after its Petition before offering any stipulation at all. *See* Paper 7. Furthermore, the belated limited stipulation Samsung did offer reserved the right to assert combinations including system prior art in the District Court Proceeding, *id*., meaning Samsung intends to try validity based on purported prior art in both the District Court Proceeding and this IPR. Therefore, Samsung's stipulation is "not [] particularly meaningful because the efficiency gained in an AIA proceeding will be limited,"[4] and this factor favors discretionary denial. In fact, Samsung's stipulation even acknowledges that it falls short of a full stipulation that might eliminate duplication of issues across other venues (as

[3] *See* https://www.uspto.gov/patents/ptab/interim-director-discretionary-process at I.D (accessed on January 14, 2026) [hereinafter "Interim Director Discretionary Process"]

[4] *See* Interim Director Discretionary Process at I.D.

discussed in the Notice of Proposed Rulemaking issued October 17, 2025), and instead confirms that Samsung views this proceeding as an additional "bite at the apple" rather than any sort of true alternative to trying validity in the District Court Proceeding. *See* Paper 7 at footnote 1 (reserving the right to modify its stipulation at a later date despite already being well aware of what has been proposed as a proper stipulation under pending rulemaking).

5. Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same party

Petitioner Samsung and Patent Owner Network-1 are both parties to the parallel litigation. *See* EX2001. When the parties are the same—like in this case—this favors discretionary denial. *Sotera Wireless*, IPR2020-01019, Paper 12 at 19.

6. Factor 6: other circumstances that impact the Board's exercise of discretion, including the merits

Factor 6 weighs in favor of discretionary denial. In this case, the merits of the Petition are weak.

With respect to the sole independent claim 1, Samsung asserts combinations of five references—all of which were considered during prosecution of the '780 Patent. Pet. at 3 (grounds 1, 2, 5). More specifically, the patent examiner explicitly considered each of Park, GlobalPlatform, AbiChar, X9.63 Overview, and Nix 175. EX1004 at 3448 (Park), *id.* at 3468 (GlobalPlatform), *id.* at 3468 (AbiChar), *id.* at 3331 (X9.63 Overview), and *id.* at 36, 86 (Nix 175). And the examiner determined

that independent claim 1 was allowable because "it would not have been obvious [to] combine the teachings [of the] cited prior art to arrive at the claimed invention." EX1004 at 3416 (Reasons For Allowance); *see also id.* at 14, 3317 (incorporating prior Reasons For Allowance).

For example, claim 1(g) requires that the eUICC "receiv[e] the symmetric key." EX1001 at 80:53. With respect to grounds 1-2, Petitioner alleges that GlobalPlatform's Data Encryption Key ("DEK") is the claimed "symmetric key" and that it is "received" using GlobalPlatform's key transport option. Pet. at 41, 59-60. This allegation is wrong. GlobalPlatform explains that DEK is a "static key" that is never transported—so it is never "received." *See* EX1006 at 218 (bates). And although GlobalPlatform does provide a key transport option, GlobalPlatform does not explicitly teach that it is for the DEK. Instead, GlobalPlatform teaches that the key transport option is for a different key entirely—namely, the "session key." *Id.* at 271-272 (bates) ("If the key transport option is used, then the *session keys* are provided by the Off-Card Entity") (emphasis added). Thus, grounds 1-2 fail to teach or suggest "receiving the symmetric key," as claimed.

Claim 1(a)(2) also requires that the eUICC "generat[e] a first message comprising … a nonce." EX1001 at 80:27-30. Petitioner alleges a person of skill would modify Park Figure 4 to include GlobalPlatform's PKI authentication scheme, such that the eUICC would generate a message with two nonces. Pet. at 31-33. But

a person of skill would not combine Park and GlobalPlatform as per the Petition. Park's PKI authentication scheme is not nonce-based. EX1005 at 4-5. And in light of Park's pre-existing deterministic data authentication, a POSITA would not be motivated to include an additional layer of nonce-based authentication (like in GlobalPlatform) that compounds overhead without providing additional utility.

Finally, with respect to ground 5 only, Petitioner alleges the '780 Patent is not entitled to its priority date because none of the applications to which it claims priority provide written description for the claimed "receiving the symmetric key" from a subscription manager. Pet. at 9-10. According to the Petitioner, the applications only disclose receiving the symmetric key from the mobile network operator—not the subscription manager. *Id.* As an initial matter, claim 1 does not require receiving the symmetric key from a subscription manager—a point Petitioner appears to concede. *See id.* at 10 ("the claims of the '780 Patent place no limit on the source of the claimed 'symmetric key"). But even if the claims did require that the symmetric key come from a subscription manager, the earliest application (and all subsequent applications in the chain) clearly teach that the "mobile network operator 104 could operate the eUICC subscription manager 109." EX2024 at 25; *see also id.* at 65 ("the MNO 104 could also function as a eUICC subscription manager 109"). Thus, because the applications teach the mobile network operator and the subscription manager can be the same, there is ample written description in

the '780 priority applications for receiving a symmetric key from a subscription manager.

Other distinctions remain, and PO incorporates by reference its forthcoming Preliminary Response.

B. Additional Considerations Also Support Discretionary Denial

In addition to the *Fintiv* factor analysis discussed above, several other additional considerations support discretionary denial here.

First, the settled expectations of the parties support discretionary denial here. As discussed above in Section II.C (incorporated here by reference), Samsung has been aware of the patented inventions and their relevance to Samsung's own work since at least 2016, yet never challenged validity of any patents in the families (and further declined offers to purchase and/or license the patents) until after a lawsuit was filed.

Second, Samsung's extensive reliance on an expert declaration supports discretionary denial.[5] In the absence of compelling prior art, Samsung has relied

[5] *See* March 26, 2025 Interim Processes for PTAB Workload Management at 2, available at https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf (accessed on January 16, 2026); *Xerox Corp. et al. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022)

heavily on its expert declaration (EX1002), citing to it approximately 159 times over the course of the Petition, often generally citing large chunks of the declaration. *See* generally Pet. (citing "Ex-1002"). Yet its declarant added little (if any) value to its analysis, frequently relying on conclusory statements and repeating/rewording the contents of the legal brief. *See* EX1002. Samsung's heavy reliance on conclusory testimony that simply duplicates arguments made in the Petition is not helpful to the trier of fact and provides another reason the Petition should be discretionarily denied.

IV. Conclusion

For all of the reasons discussed above, Patent Owner respectfully requests that the Director decline to institute *inter partes* review of the '094 Patent.

Dated: February 3, 2026

Respectfully submitted,

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(granting little weight to an expert declaration which "merely repeats, *verbatim*, the conclusory assertion for which it is offered to support") (precedential).

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **Patent Owner's Discretionary Denial Brief,** were served via email to counsel of record for Petitioners as follows:

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