

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC. AND SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

GAEA, LLC,
Patent Owner.

Case IPR2026-00427
Patent 12,265,715

**BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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EXHIBIT LIST

Exhibit No.	Exhibit Description
2001	US 2017/0075909 (Goodson)
2002	US 2021/0182190 (Gao)
2003	Director Vidal's June 21, 2022 Memorandum
2004	March 24, 2025 memorandum by Chief APJ Boalick
2005	July 29, 2026 Gaea's Preliminary Infringement Contentions Against Meta
2006	September 11, 2026 Meta's Invalidity Contentions
2007	July 6, 2026 Gaea's Preliminary Infringement Contentions Against Samsung
2008	August 31, 2026 Samsung's Invalidity Contentions
2009	August 31, 2026 Samsung's Subject Matter Ineligibility Contentions
2010	Ex. C to 7-29-2026 Gaea's Preliminary Infringement Contentions Against Meta
2011	Ex. C to 7-6-2026 Gaea's Preliminary Infringement Contentions Against Samsung
2012	Mar. 26, 2025 Stewart Memorandum InterimProcesses-PTABWorkloadMgmt
2013	April 1, 2025 Director's CSIS Statement
2014	04-08-2024 Information Disclosure Statement, citing U.S. Pat. Pub. No. 2004/0174627
2015	8-21-2024 List of References Cited by Applicant and Considered by Examiner, citing U.S. Pat. Pub. No. 2004/0174627

I. INTRODUCTION

Patent Owner Gaea, LLC, (“Gaea” or “Patent Owner”) respectfully requests that the Board exercise its discretion and deny institution of this Petition for *inter partes* review of U.S. Patent No. 12,265,715 (Ex. 1001) under 35 U.S.C. § 314(a). Co-pending with the Petition are two district court actions for patent infringement of the ’715 patent, one in the Northern District of Texas and the other in the Eastern District of Texas (the “NDTX Case” and “EDTX Case” respectively). Pet. at 3. It would be inefficient and risk inconsistent rulings to allow the Petition to proceed.

First, Petitioner Meta Platforms, Inc. and Petitioner Samsung Electronics Co., Ltd., (“Meta” and “Samsung” or collectively “Petitioners”) fail to satisfy the requirements of *Advance Bionics* because Petitioners do not establish material error by the Patent and Trademark Office (“PTO” or “the Office”). This is detailed below, along with further explanation about why this is not a situation in which reconsideration of the Office’s actions is appropriate. For at least these reasons, the Petition should be denied.

Additionally, based on the application of the *Fintiv* factors as detailed below, due to Petitioner’s substantial delay in filing the Petition, and the significant risk of substantial overlapping issues between the instant Petition and the parallel district court actions, denial is warranted.

Lastly, the Board should also exercise its discretion and deny institution under the factors that Acting Director Stewart outlined in her March 26, 2025 memorandum. These additional factors further supports discretionary denial here: (1) the merits of the Petition are weak; (2) the Petitioners improperly rely on and largely parrot an expert declaration; and (3) the patent family has been in force for over six years and has never been subject to challenge until now.

II. THE BOARD SHOULD DENY INSTITUTION UNDER *ADVANCED BIONICS*

The Director should exercise discretion to deny institution under 35 U.S.C. § 325(d). Although Petitioners rely on Meir and Salessi rather than the references cited during prosecution, the technical teachings underlying their proposed combination were already presented to the Examiner. In particular, the Examiner considered references disclosing (1) programmable processors directing separate flash control logic to perform storage operations, (2) compression performed within solid-state storage devices, (3) storage policies governing compression and encryption, and (4) policy-directed redundancy and data placement. Petitioners have not established that their reliance on Meir and Salessi presents materially different teachings warranting reconsideration of the challenged claims.

A. The Petition Relies on Substantially the Same Art Previously Presented to the Office

Under the first part of the *Advanced Bionics* framework, the question is whether the same or substantially the same art or arguments were previously presented to the Office. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). The analysis does not require that the Petition identify the same references considered during prosecution; substantially similar teachings may also satisfy the framework.

Here, the Examiner considered Olster (EX1005), Hashimoto (EX1006), Goodson (EX2001), and Gao (EX2002), each identified in Applicant’s April 8, 2024 IDS and acknowledged as considered on August 1, 2024. EX1002, 309–312. Those references disclose the principal teachings Petitioners invoke in their Meir–Salessi combination.

1. The Considered Art Discloses the Same Technical Teachings and Relationships on Which Petitioners Rely

Olster is particularly significant because Petitioners themselves rely on the ancestor ’023 prosecution, where the Examiner repeatedly rejected claims over Olster. Pet., 11–12. Yet Petitioners do not address whether Meir presents substantially the same policy-directed storage teachings. Petitioners rely on Meir’s policy for redundancy operations including copying, striping, and parity; Olster likewise discloses policies governing replication and placement, including the number and distribution of copies. EX1005 ¶¶[0030]–[0031]; Pet., 28–29. Gao

additionally identifies RAID, compression, and encryption among storage-controller functions. EX2002 ¶[0038].

Petitioners also map Meir's processor 52 and memory 56 within high-level controller 36 to the claimed processor and memory, and low-level controller 44 to the device controller. Pet., 24–27. Gao discloses a substantially overlapping hierarchy: CPU 801 within flash controller 102 directs flash reads and writes, manages command queues, and supplies commands that lower-level state-machine and sequencing logic converts into flash microinstructions. EX2002 ¶¶[0232], [0265]–[0270]. Figures 8 and 9 place CPU 801 within flash controller 102, and Gao explains that CPU 801 directs reads and writes to appropriate channels. The flash controller maintains command queues populated by CPU 801; software on CPU 801 manages those queues; and lower-level logic maps the commands into microinstructions issued to a flash sequencer. *Id.* Thus, Gao discloses the same category of processor-to-lower-level-control division on which Petitioners rely.

Hashimoto provides a similar disclosure. Its SSD controller 14 includes CPU 61 and a distinct NAND interface 63, which Hashimoto expressly identifies as a NAND controller. EX1006 ¶¶[0150]–[0154]. CPU 61 executes command processing and controls the NAND controller, which interfaces with flash memory. *Id.* ¶¶[0151], [0154]. Thus, Hashimoto also discloses a programmable processor directing separate flash-control circuitry.

Petitioners rely on Salessi for SSD-side compression, decompression, encryption, and decryption and propose adding those algorithms to Meir’s software and policy. Pet., 16, 28–31. Hashimoto already discloses SSD-side compression: hardware engine 64 performs compression, and write data may be compressed before storage in flash, with the host designating whether compression applies. EX1006 ¶¶[0155], [0218], [0222]–[0227].

Fourth, Petitioners’ proposed combination relies on modifying Meir’s policy so that it determines which data receives Salessi’s compression and encryption processing. Pet. 30–31. Goodson expressly discloses this relationship between storage policies and content-processing operations. Goodson describes a policy-based content-management subsystem and identifies policies governing when and how data is encrypted. EX2001 ¶¶[0061]–[0062]. It further identifies compression, encryption, and replication among the operations performed in managing stored content. *Id.* ¶[0063]. Goodson also describes applying object-specific policies during ordinary I/O operations, including policies requiring compression. *Id.* ¶¶[0080]–[0081]. Thus, Goodson discloses more than the individual availability of compression and encryption. It teaches the use of storage policies to determine when those operations are performed—the same relationship Petitioners seek to establish by combining Salessi with Meir.

The overlap therefore extends beyond isolated components. The considered art discloses the same categories of functional relationships Petitioners invoke: processor-directed lower-level flash control (Gao), policies governing compression and encryption (Goodson), SSD-side compression (Hashimoto), and policy-directed replication and placement (Olster). EX2002 ¶¶[0232], [0265]–[0270]; EX2001 ¶¶[0061]–[0063], [0080]–[0081]; EX1006 ¶¶[0218]–[0227]; EX1005 ¶¶[0030]–[0031].

Accordingly, the Petition does not merely invoke storage technologies that were generally known in the art. Its proposed Meir–Salessi combination relies on processor/controller relationships, policy-directed storage operations, and selectively applied content processing that were already disclosed in the references considered by the Examiner. Although Petitioners implement those teachings through modifications to Meir’s software and storage policy, Pet., 19–22, 30–31, the Petition does not identify any material difference between the technical teachings underlying those modifications and those previously presented to the Office.

2. The Examiner Considered This Art During a Substantive Prior Art Search Directed to the Claims Challenged

The prosecution record also refutes Petitioners’ assertion that the claims received “little (if any) substantive consideration.” Pet., 13. Examiner Lane conducted PE2E searches on August 2 and November 25, 2024. EX1002, 466. The search history spans nearly one hundred pages and combines storage, memory, disk,

drive, and SSD concepts with requests, commands, write/read operations, policies, rules, algorithms, and content or data. *Id.* at 466–563. Those searches occurred while the challenged claims were pending and expressly recited policy-based processing, including compression, decompression, encryption, and decryption. *Id.* at 138–143, 465. Significantly, claims 37–56, which ultimately issued as claims 1–20, had been presented in March 2024 and already recited the policy-based content-processing functionality at issue. EX1002, 138–143, 465. Thus, the Examiner’s consideration of the cited references and searching occurred while the same policy-based processing subject matter Petitioners now rely on Salessi to supply was squarely presented in the pending claims. The first part of *Advanced Bionics* is therefore satisfied.

B. Petitioners Have Not Demonstrated Material Error

Because substantially the same art was previously presented to the Office, Petitioners bear the Part Two burden to demonstrate material Office error. *Advanced Bionics*, IPR2019-01469, Paper 6 at 8–9. The Petition does not address § 325(d) and identifies no such error.

That omission is dispositive under *Ecto World* once Patent Owner establishes that substantially the same art or arguments were previously presented. *Ecto World* confirms that IDS-submitted art qualifies as previously presented even if not substantively discussed during prosecution. *Ecto World, LLC v. RAI Strategic*

Holdings, Inc., IPR2024-01280, Paper 13, § A (Director May 19, 2025) (precedential). Petitioners then bear the burden to demonstrate material Office error. *Id.* Their silence as to § 325(d) leaves that burden unsatisfied.

That failure is particularly consequential because, as discussed above, the Examiner considered Gao, Hashimoto, Goodson, and Olster, which disclose the principal teachings Petitioners now invoke through Meir and Salessi: processor-directed lower-level flash control, selectable SSD-side compression, policy-governed compression and encryption, and policy-governed replication and placement. EX1002 309–312; EX2002 ¶¶[0232], [0265]–[0270]; EX1006 ¶¶[0150]–[0155], [0218], [0222]–[0227]; EX2001 ¶¶[0061]–[0063], [0080]–[0081]; EX1005 ¶¶[0030]–[0031]. The Examiner also conducted substantive prior-art searches while claims reciting policy-based processing, compression, decompression, encryption, and decryption were pending. EX1002, 138–143, 466–563.

Yet Petitioners do not explain how Meir and Salessi materially differ from the previously presented art, identify any relevant teaching the Examiner overlooked or misunderstood, or otherwise identify material error. Instead, they proceed directly to obviousness without explaining why substantially the same technical teachings warrant reconsideration, despite a record showing consideration of the cited

references and extensive prior-art searching while the challenged claims were pending.

Petitioners cannot cure that failure by relying on the merits of their obviousness grounds. *Ecto World* rejected the proposition that an allegedly strong unpatentability case itself establishes material Examiner error; otherwise, *Advanced Bionics* Part Two would collapse into the merits inquiry. *Ecto World* at 5–6. Nor must the Board search the prosecution record and construct a material-error theory Petitioners never advanced. *Id.* at 6 n.2. The Petition’s silence as to § 325(d) therefore leaves its Part Two burden unsatisfied.

C. The Same Deficiency Extends Across the All Grounds

All three grounds depend on Meir–Salessi. Ground 2 merely adds Chou for claim 9, and Ground 3 Lovinger for claim 19. Pet., 5. Neither replaces Meir–Salessi for the core SSD architecture and policy-based processing limitations. Thus, the substantially overlapping teachings underlying Meir–Salessi extend across every ground, and Petitioners’ failure to demonstrate material Examiner error warrants denial under § 325(d).

III. INSTITUTION SHOULD BE DENIED UNDER *FINTIV*

The Director should exercise his discretion to deny institution under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv I*”); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12

(PTAB Dec. 1, 2020) (precedential as to § II.A) (“*Sotera*”); and their progeny, in accordance with the USPTO’s February 28, 2025 guidance withdrawing former Director Vidal’s June 21, 2022 memorandum entitled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation.” See EX2003 (withdrawing former Director Vidal’s memorandum and citing *Fintiv I* and *Sotera*); see also EX2004 (March 24, 2025 memorandum by Chief APJ Boalick providing further guidance on the rescission).

Under those authorities, the Director may deny institution of petitions when related litigation is co-pending and an IPR would not be “an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017) (precedential)). The Director should balance six factors when evaluating whether to deny a petition under *Fintiv*. *Fintiv I* at 5-6. “These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* When analyzing and weighing these factors, the Director takes “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

As is addressed below, on balance, the *Fintiv* factors weigh in favor of denying the Petition.

A. *Fintiv* Factor 1: Petitioners Have Not Indicated that they Intend to File for Any Pre-Institution or Post-Institution Stays.

Petitioners have not requested pre-institution stays in either the NDTX Case or EDTX Case, nor have they given any indication that they plan to do so. Petitioners have also not given any indication that they intend to request a post-institution stay. Because there is no evidence indicating that pre- or post-institution stays will be sought or granted in the parallel NDTX and EDTX Cases, the first *Fintiv* factor weighs in favor of denying institution.

B. *Fintiv* Factor 2: Trial in the Parallel District Court Actions Is Estimated to Occur Contemporaneously with the Board’s Deadline for a Final Written Decision.

“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.” *Fintiv I* at 9.

Based on the Notice of Filing Date Accorded issued on August 5, 2026, the deadline for a final written decision in this IPR is approximately February 4, 2028, which may be extended to August 4, 2028 for good cause or in the case of joinder. 37 C.F.R. § 42.100(c). In the NDTX Case, trial has been scheduled for February 21, 2028. *See Gaea, LLC v. Meta Platforms, Inc.*, 4:26-cv-00348 (N.D. Tex) (“*Gaea v.*

Meta”) at Dkt. No. 34. In the EDTX Case, trial has been scheduled for April 3, 2028. *See Gaea, LLC v. Samsung Electronics Co., Ltd.*, 2:26-cv-00264 (E.D. Tex.) (“*Gaea v. Samsung*”) at Dkt. No. 24.

Trial in the NDTX Case will be contemporaneous with the deadline for final written decision for the instant prospective IPR. As the EDTX Case overlaps substantially with the NDTX case, it is very likely that the outcome of the NDTX Case will heavily inform the EDTX Case. Therefore, since many of the issues across the NDTX and EDTX Cases will be resolved contemporaneously with the deadline for final written decision for this IPR (or well before, should the deadline for final written decision be extended), this *Fintiv* factor weighs against institution.

C. *Fintiv* Factor 3: The Parties Expect to Invest Heavily in Several Parallel Proceedings, and Petitioner Unduly Delayed in Filing the Petition.

Factor 3 relates to the “amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv I* at 9. For example, “if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition,” this factor favors denial. *Id.* at 9-10.

Here, Petitioners and Patent Owner are engaged in the parallel NDTX and EDTX Cases, which are anticipated to require significant resources to resolve, including claim construction, substantial document productions, the examination of

source code, and the service of written discovery and responses thereto. In both cases, there are pending motions to transfer venue. *See Gaea v. Meta*, Dkt. No. 62; *Gaea v. Samsung*, Dkt. No. 43. Additionally, there is a pending motion to dismiss in *Gaea v. Samsung*. *See* Dkt. No. 41. The parties have already expended significant effort related to these motions. In *Gaea v. Meta*, venue discovery is set to close on October 12, 2026, with Gaea's response to Meta's motion due on November 2, 2026. *See* Dkt. No. 60. In *Gaea v. Samsung*, the Parties' deadline to submit a venue discovery order and briefing schedule is October 13, 2026. *See* Dkt. No. 50. It is clear that the parties have already expended significant effort related to these motions, and that this work will only continue to increase.

In addition to expending resources on the above motions practice, the parties in both cases have dedicated substantial time and energy to the creation of preliminary infringement, invalidity, and subject matter ineligibility contentions. *See* EX2005 (7-29-2026 Gaea's Preliminary Infringement Contentions Against Meta); EX2006 (9-11-2026 Meta's Invalidity Contentions); EX2007 (7-6-2026 Gaea's Preliminary Infringement Contentions Against Samsung); EX2008 (8-31-2026 Samsung's Invalidity Contentions); EX2009 (8-31-2026 Samsung's Subject Matter Ineligibility Contentions). With a filing date accorded of August 5, 2026, the institution decision for the Petition will be made on or before February 5, 2027. By this date, in the NDTX Case, the parties will have completed all claim construction

discovery and briefing and will be preparing for a *Markman* hearing. *See Gaea v. Meta*, Dkt. No. 24. Patent Owner also expects that discovery efforts will be in full swing by the time of the institution decision.

Moreover, the Director should consider Petitioners' delay in filing the Petition. The instant Petition was filed on August 5, 2026, nearly five months after the filing of the complaint in the parallel NDTX Case and just over four months after the filing of the complaint in the parallel EDTX Case. Petitioners offer no explanation for their delay.

Thus, because of the past and future duplicative resource expenditures by the parties in the parallel proceedings and petitioner's delay, this factor favors denial.

D. *Fintiv* Factor 4: The Petition and the Parallel District Court Cases Will Likely Raise Substantially Overlapping Issues.

This *Fintiv* factor looks at “whether all or some of the claims challenged in the petition are also at issue in district court” and whether the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as the parallel district court case. *Fintiv I* at 12-13. Here, at least some of the challenged claims are asserted in the parallel NDTX and EDTX Cases.

In the parallel district court cases, Patent owner has asserted claims 1 and 9 of the '715 patent against Petitioners. *See* EX2010 (Ex. C to 7-29-2026 Gaea's Preliminary Infringement Contentions Against Meta); EX2011 (Ex. C to 7-6-2026 Gaea's Preliminary Infringement Contentions Against Samsung). Meanwhile, the

Petition challenges claims 1, 2, 5-11, and 14-20 of the '715 patent. Pet., 10-11; *see also* EX2008 at 2. In their invalidity contentions, both parties raised prior art references Meir, Salessi, Chou, and Lovinger. *See* EX2006; EX2008. The prior art references raised by Petitioners in the Petition are the same: Meir, Salessi, Chou, and Lovinger. Pet., 13-18.

Every single claim of the '715 patent that Patent Owner alleges is infringed by both Petitioners in the NDTX and EDTX Cases is challenged in the Petition. And every piece of prior art that Petitioners use to support the Petition has been raised by invalidity contentions in the district court cases. Because of the guaranteed overlap of claims and the substantively overlapping prior art at issue, the fourth *Fintiv* factor weighs in favor of denying institution.

E. *Fintiv* Factor 5: Petitioners Are the Parallel Proceeding Defendants.

The Petition concedes that Petitioners are the defendants in the parallel NDTX and EDTX Cases, and thus “this factor weighs in favor of discretionary denial.” Pet. at 3; *Fintiv I* at 15.

F. *Fintiv* Factor 6: Petitioners Rely on Substantially the Same Art Previously Presented to the Office and Fail to Show Material Error.

As explained in Section II above, Petitioners’ assert substantially the same prior art references which were considered by Examiner, disclosing the same technical teachings and relationships. *See supra* § II. As such, Petitioners must

demonstrate material Office error, which they have failed to do. *Id.* This factor weighs in favor of discretionary denial.

IV. ADDITIONAL FACTORS SET FORTH IN THE DIRECTOR'S MEMORANDUM SUPPORT DISCRETIONARY DENIAL

A. The Strength of the Unpatentability Challenge

The Director's Memorandum lists "[t]he strength of the unpatentability challenge" as one factor upon which the Director may determine to deny institution. EX2012. As previously explained for *Fintiv* Factor 6, Petitioner's unpatentability challenge is extremely weak, resorting to rehashing art which is substantively the same as art already considered by the Examiner. *See supra* § III.F. The Petition therefore fails to show a reasonable likelihood of prevailing.

B. The Extent of the Petition's Reliance on Expert Testimony

The Petition's extraordinary reliance on its expert independently favors discretionary denial. The Director identifies "the extent of the petition's reliance on expert testimony" as relevant. Interim Processes for PTAB Workload Management at 2 (Mar. 26, 2025). In *iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, that factor weighed against denial only because no testimony filled prior-art gaps; the expert instead explained background knowledge with supporting citations. IPR2025-00363, Paper 10 at 2–3 (PTAB June 6, 2025)(Acting Director June 6, 2025). This record is the opposite.

The Petition cites Dr. Litz 211 times, often tracking his declaration nearly verbatim. Testimony that “merely repeats, verbatim,” a conclusory petition assertion without supporting evidence or technical reasoning merits little weight. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15–17 (PTAB Aug. 24, 2022) (precedential); see *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1340–41 (Fed. Cir. 2020) (affirming that testimony did not “add materially” where it repeated attorney argument nearly verbatim without an evidentiary basis). Here, the declaration supplies relationships absent from the cited references:

First, Meir says memory 56 stores the controller policy and software may reside on non-transitory media, but never says memory 56 stores that software. EX1010 ¶¶[0033]–[0034]. Dr. Litz supplies the missing piece: because the software *must* be available to processor 52, it *would* be available through memory 56. Ex. 1003 ¶97. The Petition adopts that inference as “confirming” storage in memory 56. Pet., 27.

Second, Meir says the policy may use RAID-like redundancy and specify parity rules, and that “the memory controller” calculates parity. EX1010 ¶¶[0025], [0038], [0048]. It never attributes striping, mirroring, parity calculation, or parity storage to processor 52 or its software. Dr. Litz fills the gap by opining that the software can direct processor 52 to perform those operations; the Petition repeats that attribution. Ex. 1003 ¶102; Pet., 29.

Third, claim 17 requires a storage policy comprising an encryption, decryption, compression, or decompression policy. The Petition concedes Meir may not disclose the limitation and turns to Salessi. Pet., 66–67. But Salessi merely lists those operations as SSD “processing capabilities” and describes a processing algorithm; it never calls them policies. EX1011 ¶¶[0006], [0023]. Dr. Litz nevertheless says “Salessi teaches the storage policy comprises” those policies, and the Petition likewise relies on Salessi without identifying that missing relationship. Ex. 1003 ¶¶249–250; Pet., 66–67.

These opinions do not explain an identified teaching; they supply missing claim-specific facts—the storage location, processor actor and operations, and policy relationship.

That defect independently requires denial. Rule 42.104(b)(4) 42.104(b)(4) requires the Petition to “specify where each element of the claim is found in the prior art patents or printed publications relied upon.” The Director’s July 31, 2025 memorandum confirms that expert testimony “may not be used to supply a missing claim limitation” and that, under § 312(a)(4), the Board “shall deny” a noncompliant petition. Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews at 1 (July 31, 2025). It applies because the Petition was filed after September 1, 2025. *Id.* at 3.

Because the declaration cannot cure those missing teachings—and its parroting testimony merits limited weight under *Xerox* and *Facebook*—denial is mandatory under § 312(a)(4) and Rule 42.104(b)(4), and independently warranted as a matter of discretion.

C. Settled Expectations of the Parties.

The Acting Director’s Memorandum also lists “[s]ettled expectations of the parties, such as the length of time the claims have been in force” as another factor based upon which the Director may determine to deny institution. EX2012.

The expectations of the parties for the ’715 patent claims are well-settled. Specifically, the ’715 patent claims were issued over a year ago on April 1, 2025. EX1001 at 1. The fact that the ’715 patent has already been in force for over a year with no challenges, such as a petition for Post Grant Review counsels against review.

In addition, the Acting Director noted the ability of companies such as Petitioners to “scour issued patents for commercial opportunities and to review issued patents to determine if and how they impact these companies’ freedom to operate” (though the Director has also regretted that “these early tools are rarely used because there are other portions of the AIA that encourage competitors to wait until they are actually sued for infringement to participate in this joint exercise to improve the IP system”). See EX2013 at 8. During prosecution of the ’715 patent, a Samsung reference was cited, first by Patent Owner in its 4-8-2024 Information Disclosure

Statement. *See* EX2014 (4-8-2024 Information Disclosure Statement, citing U.S. Pat. Pub. No. 2004/0174627). This same reference was then cited to in the 8-21-2024 List of References Cited by Applicant and Considered by Examiner. EX2015 (the 8-21-2024 List of References Cited by Applicant and Considered by Examiner, citing U.S. Pat. Pub. No. 2004/0174627). The '715 patent as issued cites to the above Samsung reference, which would have put Petitioner Samsung on notice of the '715 patent (in addition to being on notice of family member U.S. Patent No. 10,776,023, which has been in force for six years and is also asserted in the parallel proceeding) and of Patent Owner's patenting activity in a relevant technology area to Samsung. *See* EX1001 at 2. But, not until the filing of this Petition has Petitioner Samsung ever sought to challenge the '715 patent at the PTAB.

Because of the well settled expectations of the parties, including the length of time the claims have been in effect and Petitioner Samsung's prior decision not to challenge the '715 patent, despite notice and opportunity to do so, this factor weighs in favor of denying institution.

V. CONCLUSION

The Board should exercise its discretion and deny institution of the Petition.

Respectfully Submitted,

Dated: October 13, 2026

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(Case No. IPR2026-00427)

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**CERTIFICATION UNDER INTERIM DIRECTOR DISCRETIONARY
PROCESS (II)(C)(iii)**

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the page count for all portions of the foregoing Patent Owner's Brief in Support of Request for Discretionary Denial totals 20 pages per Microsoft Word, which complies with the requirement of 20 pages allowed under the Interim Director Discretionary Process. *See* Interim Director Discretionary Process (II)(C)(iii) (<https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>).

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CERTIFICATE OF SERVICE

As authorized by Patent Owner's Mandatory Notice, I hereby certify that on October 13, 2026, a copy of this document has been served in its entirety by electronic mail on Petitioner's lead and backup counsel.

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