

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

FENDGO, LLC,

Patent Owner

Case IPR2024-00114

U.S. Patent No. 11,265,404

Petition for *Inter Partes* Review of

U.S. Patent No. 11,265,404

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PETITIONERS' EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent 11,265,404 (“’404Pat.”)
1002	Declaration of William R. Michalson, Ph.D. (“ <i>Michalson</i> ”)
1003	Curriculum Vitae of William R. Michalson, Ph.D.
1004	File History of U.S. Patent 11,265,404
1005	U.S. Provisional Application 60/643,865
1006	U.S. Application 13/897,353
1007	INTENTIONALLY LEFT BLANK
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1011	INTENTIONALLY LEFT BLANK
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Exhibit No.	DESCRIPTION
1021	INTENTIONALLY LEFT BLANK
1022	INTENTIONALLY LEFT BLANK
1023	INTENTIONALLY LEFT BLANK
1024	INTENTIONALLY LEFT BLANK
1025	U.S. Publication 2004/0121756A1 (“ <i>Griffin</i> ”)
1026	U.S. Publication 2004/0137938A1 (“ <i>Deubler</i> ”)
1027	U.S. Patent 7515900B2 (“ <i>Van Camp</i> ”)
1028	U.S. Publication 2006/0201964 (“ <i>DiPerna964</i> ”)
1029	U.S. Patent 10,460,590 (“ <i>Strack</i> ”)
1030	U.S. Patent 10,089,842 (“ <i>Fadell</i> ”)
1031	U.S. Patent 8,032,108 (“ <i>Kuz</i> ”)
1032	Summary of all applications in the ’404 patent’s family
1033	Infringement Contentions served in <i>Fendgo LLC v. Samsung Electronics Co., Ltd.</i> , 2:23-cv-00221-JRG (E.D. Tex.) (July 13, 2023)
1034	Complaint in <i>Fendgo LLC v. Samsung Electronics Co., Ltd.</i> , 2:23-cv-00221-JRG (E.D. Tex.) (May 19, 2023)
1035	Order Granting Proposed Docket Control Order in <i>Fendgo LLC v. Samsung Electronics Co., Ltd.</i> , 2:23-cv-00221-JRG (E.D. Tex.) (August 8, 2023)
1036	Letter from Jin-Suk Park to Jay Nuttall dated November 1, 2023

LISTING OF CHALLENGED CLAIMS

Claim 1	
1[pre]	A mobile device, comprising:
1[a]	a camera unit, adapted to obtain at least one of image data and audio data;
1[b]	a location unit, adapted to obtain location data;
1[c]	a transmitting unit, adapted to transmit the image data, the audio data, and the location data as emergency information to a specified location, along with specific information including owner identification information; and
1[d]	a panic button, adapted to, when activated, ready itself to perform the following panic button functions: (1) dialing a public or private network for an emergency purpose and (2) activating the transmitting unit,
1[e]	wherein the panic button is activated by a depressing of the panic button together with another button at substantially the same initial time such that no panic button function is activated unless both buttons are depressed.
Claim 2	
2	A mobile device as set forth in claim 1, wherein the specific information includes a time and date stamp.
Claim 3	
3	A mobile device as set forth in claim 1, wherein the specific information includes a pre-recorded personal warning message if the panic button is activated during a predetermined time period.
Claim 4	
4	A mobile device as set forth in claim 1, wherein the panic button is silent.
Claim 5	
5	A mobile device as set forth in claim 1, wherein the panic button activates an audible warning message, wherein the audible warning message includes words.

Claim 6	
6	The mobile device as set forth in claim 1, wherein the panic button activates an audible alarm.
Claim 7	
7	The mobile device as set forth in claim 1, further comprising a safety switch that, upon being moved into position, readies the panic button to contact the public or private network for emergency purposes when the panic button is activated.
Claim 8	
8	A mobile device as set forth in claim 1, wherein the owner identification information includes a name and a description of the owner of the mobile device.

I. INTRODUCTION

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (“Samsung” or “Petitioners”) request *inter partes* review (“IPR”) of claims 1-8 (“Challenged Claims”) of U.S. Patent No. 11,265,404 (“the ’404 patent”). This Petition presents a compelling case of obviousness based on a broken priority chain.

The ’404 patent issued from U.S. Application 16/262,835 (the “’835 application”). The ’835 application was filed on January 30, 2019 and purports to claim priority through a chain of applications to a provisional application filed on January 14, 2005. Its specification generally describes a mobile device with a panic button that, when activated, triggers certain functions, such as image/audio data transmission. As originally-filed, application claim 7 (which issued as independent claim 1) generally required a mobile device comprising a “camera unit,” “location unit,” “transmitting unit,” and a “panic button, adapted to activate the camera, the location unit, and the transmitting unit.” During prosecution, application claim 7 was amended multiple times. Relevant here, the applicant amended the “panic button” limitation to require “a panic button, adapted to, when activated, **ready itself** to perform” certain “panic button functions.” The applicant did not explain the reason for the “ready itself” amendment, nor did the applicant identify any specification support for it. The specification does not support this claim amendment because the specification generally describes direct triggering; that is, once the panic

button is activated (e.g., pressed), various functions are performed. To be sure, the specification describes that the mobile device may have a separate “safety” switch that, upon being moved into position, readies the panic button to perform a function if it is pressed, but there is no description of activating or pressing the panic button to merely “ready itself” to perform functions.

As a result of the “ready itself” amendment, Petitioners submit that issued claim 1 (and claims 2-8, which depend from it) do not have §112 support in the ’835 application nor any application to which the ’835 application claims priority. Therefore, claims 1-8 are not entitled to priority before January 30, 2019.

The broken priority chain is fatal to the validity of the Challenged Claims under Section 103. An earlier application in the priority chain, Application No. 11/333,809, published as U.S. Patent App. Publication No. 2006/0201964 (“*DiPerna964*”) on September 14, 2006—more than one year before January 30, 2019, i.e., the earliest date to which claims 1-8 are possibly entitled to priority. Thus, *DiPerna964* qualifies as prior art under AIA 35 U.S.C. §102(a)(1). *DiPerna964* includes a substantively identical specification to the ’404 patent and renders obvious the challenged claims alone, or in combination with other prior art.

II. GROUNDS FOR STANDING

Petitioners certify that the '404 patent is available for IPR, and that Petitioners are not barred or estopped from requesting IPR to challenge the claims on the grounds herein.

III. STATEMENT OF PRECISE RELIEF REQUESTED FOR EACH CLAIM CHALLENGED

Petitioners respectfully request review and cancellation under 35 U.S.C. §311 of the Challenged Claims in view of *DiPerna964 and Strack*.¹ As shown below, each reference pre-dates the earliest possible priority date to which the challenged claims are entitled (January 30, 2019).

¹ Petitioners do not concede that any Challenged Claims satisfy other requirements for patentability that cannot be raised in IPR.

Reference	Date	Prior Art At Least Under
<i>DiPerna</i> 964	09/14/2006 (published)	§102(a)(1)
<i>Strack</i>	07/26/2016 (filed) 10/29/2019 (issued)	§102(a)(2)

IV. OVERVIEW OF THE '404 PATENT

A. Specification

The '404 patent relates to “a self-defense mechanism” integrated with “a mobile device.” ’404*pat.*, Abstract. “When the self-defense mechanism is activated,” an integrated camera unit “takes an image of the attacker,” and the mobile device “sends image data and audio data to the authorities along with specific information such as, for example, the name and description of the owner of the self-defense device, location information, a time and date stamp, etc.” *Id.*, 3:7-13. The self-defense mechanism may “simply [be] a separate panic button located on the device which activates the above-mentioned processes.” *Id.*, 3:16-19. “The panic button may be activated by ... a depressing of the panic button together with another button” *Id.*, 3:60-62.

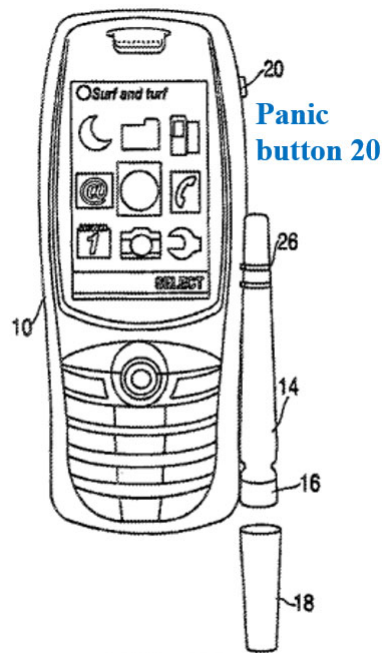


FIG. 2A

'404pat., FIG. 2A (annotated).

B. Prosecution History

In an Office Action dated June 10, 2021, the Office rejected application claim 7 (which issued as independent claim 1) as obvious. EX1004 at 147, 155. In a response dated September 10, 2021, the applicant amended application claim 7, as shown in the clip below.

7. (Currently Amended) A mobile device, comprising:

a camera unit, adapted to obtain at least one of image data and audio data;

a location unit, adapted to obtain location data;

a transmitting unit, adapted to transmit at least one of the image data, the audio data, and the location data as emergency information to a specified location, along with specific information including owner identification information; and

a panic button, adapted to, when activated, ready itself to perform at least one of the following panic button functions: (1) dialing a public or private network for emergency purposes or (2) activating the transmitting unit,

wherein the panic button is activated by a depressing of the panic button together with another button at substantially the same initial time such that no panic button function is activated unless both buttons are depressed.

EX1004 at 122.

As shown above, application claim 7 was amended to require that the panic button is adapted to, when activated, “ready itself to”² perform certain functions. In the remarks accompanying the amendments, the applicant did not explain or provide specification support for the “ready itself” amendment. *See* EX1004 at 128-132

V. LEVEL OF ORDINARY SKILL IN THE ART

A person of ordinary skill in the art (“POSITA”) at the time of the ’404 patent’s priority date—which, Petitioners contend for purposes of this Petition, is

² All emphases are added unless otherwise noted.

January 2019—would have had a Bachelor’s of Science Degree (or equivalent) in an academic area emphasizing electrical engineering, computer engineering, computer science, or a related technical field, and about 2-3 years of experience in the field of telematics systems (e.g., familiarity with control and diagnostic systems, navigation systems and wireless communication technology). A greater amount of education, i.e., a doctorate in an academic area emphasizing electrical engineering, computer engineering, computer science, or a related technical field, would compensate for fewer years of work experience. The POSITA could have also obtained similar knowledge and experience through other means. *Michalson* ¶15.

VI. CLAIM CONSTRUCTION

Petitioners are unaware of any “prior claim construction determination” related to the ’404 patent. *See* 37 C.F.R. §42.100(b). When determining validity, “claim terms need only be construed to the extent necessary to resolve the controversy.” *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011). Given the close correlation and substantial identity between the prior art references and the Challenged Claims, Petitioners believe that no express constructions of the claims are necessary to assess whether the prior art reads on the Challenged Claims. Thus, the claims should be given their plain and ordinary meaning. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Petitioners reserve the right to respond to constructions offered by Patent Owner

(“PO”) or adopted by the Board. Petitioners are not waiving arguments under 35 U.S.C. §112 or arguments regarding claim scope possibly raised in litigation.

VII. DETAILED EXPLANATION OF GROUNDS

A. The Challenged Claims Are Not Entitled to a Priority Date Earlier than January 30, 2019

The Board can consider the challenged claims’ priority date. *See Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1374 (Fed. Cir. 2023). A priority claim to an earlier application is valid only if the earlier application, inter alia, provides adequate written description for the claims pursuant to §112. 35 U.S.C. §120; *Anascape, Ltd. v. Nintendo of Am., Inc.*, 601 F.3d 1333, 1335 (Fed. Cir. 2010) (“To obtain the benefit of the filing date of a parent application, the claims of the later-filed application must be supported by the written description in the parent ‘in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.’”) (quotations omitted). “[T]he critical inquiry is whether the applicant has provided a description that in a definite way identifies the claimed invention in sufficient detail that a person of ordinary skill would understand that the inventor was in possession of it at the time of filing.” *Alcon Rsch. Ltd. v. Barr Labs., Inc.*, 745 F.3d 1180, 1190–91 (Fed. Cir. 2014) (quotations omitted).

Here, Petitioners demonstrate that the “ready itself” limitation in limitation 1[d] lacks written description support in the ’353 application (the ’404 patent’s

parent), but the analysis would be no different if any other application in the '404 patent's priority chain were considered. Limitation 1[d] is:

a panic button, adapted to, when activated, **ready itself to** perform the following panic button functions: (1) dialing a public or private network for an emergency purpose and (2) activating the transmitting unit,

At best, the '353 application describes an embodiment in which the mobile device includes a "separate 'safety' switch which, upon being moved into position, readies the panic button to contact 911 upon being pressed." EX1007 at 13. Otherwise, the '353 application generally describes that when the panic button is activated (e.g., pressed) the various functions or processes are triggered. *See, e.g., Id.*, 5-6, 10, 15. A POSITA would not have understood the '353 application to disclose expressly or inherently any feature by which the panic button, when pressed or activated, merely readies itself to perform certain functions (as opposed to, for example, just performing the functions). *Michalson* ¶53. Accordingly, a POSITA would not have understood the applicant to have been in possession of the invention

claimed in claim 1 as of the priority date of the '353 application. *Michalson* ¶54. Thus, claim 1 is not entitled to the priority date of the '353 application.³

B. *DiPerna964* In Combination with *Strack* Renders Obvious Claims 1–8

1. Claim 1

a. 1[pre]: “A mobile device, comprising:”

To the extent the preamble is limiting, *DiPerna964* discloses or suggests this feature. *Michalson* ¶¶55-57. For example, *DiPerna964* discloses “a mobile device.” *DiPerna964* at Abstract (“a mobile device”), ¶[0023] (“the present invention ... provides a mobile device”), ¶[0050] (disclosing types of mobile devices); *see also id.*, Claims 3, 7, 11, 16, 24, 29. Accordingly, *DiPerna964* discloses or suggests a mobile device (“[a] mobile device”).” *Michalson* ¶57.

³ For purposes of this proceeding, Petitioners contend that the lack of written description support for the “ready itself” limitation is sufficient to show that claims 1-8 of the '404 patent are not entitled to priority earlier than January 30, 2019. Samsung reserves the right to argue in the co-pending district court litigation that additional limitations lack written description support, for example, depending on PO’s arguments in support of validity and/or infringement.

b. 1[a]: “a camera unit, adapted to obtain at least one of image data and audio data;”

DiPerna964 discloses or suggests this feature. *Michalson* ¶¶58-60. For example, *DiPerna964* discloses a mobile device that includes “a camera unit” that “obtains at least one of image data and audio data.” *DiPerna964* at Abstract (“A mobile device includes a camera unit, a location unit, a transmitting unit, a self-defense mechanism, and a panic button. The camera unit ... obtains at least one of image data and audio data”), ¶[0023] (“a camera unit, adapted to obtain at least one of image data and audio data”); *see also id.*, Claims 3, 7, 11, 16, 24, 29. *DiPerna964* further discloses “a camera built into the mobile phone/device takes an image of the attacker, and the mobile phone/device sends image data and audio data to the authorities,” and that “the present invention utilizes a built-in camera to take still or moving images of the attacker and send the image and/or audio data to the authorities.” *DiPerna964* ¶[0017]; *see also id.*, ¶¶[0025], [0027], [0035].

Accordingly, *DiPerna964* discloses or suggests “a camera unit, adapted to obtain at least one of image and audio data.” *Michalson* ¶60.

c. 1[b]: “a location unit, adapted to obtain location data;”

DiPerna964 discloses or suggests this feature. *Michalson* ¶¶61-63. For example, *DiPerna964* discloses “a location unit” that “obtains location data.” *DiPerna964*, Abstract (“A mobile device includes ... a location unit ... the location unit obtains location data.”); ¶¶[0023] (“a location unit, adapted to obtain location

data”); *see also id.*, ¶¶[0017], [0024], [0025], [0027], [0026], [0035], Claims 3, 7, 11, 16, 24, 29; *Michalson* ¶62. Accordingly, *DiPerna964* discloses or suggests a “location unit, adapted to obtain location data”. *Michalson* ¶63.

- d. 1[c]: **“a transmitting unit, adapted to transmit the image data, the audio data, and the location data as emergency information to a specified location, along with specific information including owner identification information; and”**

DiPerna964 discloses or suggests this feature. *Michalson* ¶¶64-67. For example, *DiPerna964* discloses “a transmitting unit” that “transmits at least one of the image data, the audio data, the location data, and specific information including owner identification information.” *DiPerna964*, Abstract; *see also id.* ¶¶[0035] (“when the self-defense mechanism is activated, a camera built into the mobile phone/device takes still or moving images of the attacker, and the mobile phone/device sends the image data to the authorities along with specific information such as, for example, the name and description of the owner of the self-defense device.”), claim 16 (“a transmitting unit, adapted to transmit at least one of the image data, the audio data, the location data, and specific information including owner identification information to an emergency dispatch center”); *see also id.* ¶¶[0017], [0023], [0025], [0027], *Michalson* ¶65.

DiPerna964 further discloses transmitting data using MMS, which “is one method enabling the present invention to obtain video/audio information and send the data to a specified location.” *Id.* ¶[0039].

Accordingly, *DiPerna964* discloses or suggests “a transmitting unit, adapted to transmit the image data, the audio data, and the location data as emergency information to a specified location, along with specific information including owner identification information.” *Michalson* ¶67.

- e. **1[d]: “a panic button, adapted to, when activated, ready itself to perform the following panic button functions: (1) dialing a public or private network for an emergency purpose and (2) activating the transmitting unit,”**

DiPerna964 in combination with *Strack* discloses or suggests this feature. *Michalson* ¶¶68-91. For example, *DiPerna964* discloses a mobile phone with an integrated “self-defense mechanism” such as a “panic button.” *DiPerna964* ¶[0017]. The “panic button” is “adapted to activate ... the transmitting unit.” *Id.* ¶[0023]. When the panic button is activated, the mobile phone/device sends data and information to the authorities. *Id.* ¶[0035]; *see also id.* ¶[0017] *DiPerna964* also discloses that the panic button “can automatically contact 911 upon a press or series of presses of the button.” *Id.* ¶[0041]; *see also id.* ¶[0036] (“The system can be linked in with an emergency assistance number such as 911 or to a private emergency

network specifically set up for these purposes to work with the public authorities in assisting victims.”).

DiPerna964 discloses a desire for a device that allows a “victims or ***potential*** victims of violent crime” to flexibly respond to unpredictable emergency situations as they see fit. *DiPerna964* ¶¶[0005], [0037] (“Because a situation in which one is confronted by an attacker is inherently unpredictable, it would be advantageous for ***potential victims*** to have the flexibility to proceed as they feel the situation dictates.”); *see also id.*, ¶[0007] (“Many people often find themselves in a ***potentially dangerous situation*** in which they are confronted by an attacker. Defending oneself in this situation is of extreme importance.”). *DiPerna964* also recognizes the need to safeguard against falsely triggering the device. *Id.* ¶[0045] (“According to another embodiment, the panic button can be a big (e.g. red) button in the center of the phone (or elsewhere on the phone) that the user holds down for a predetermined time period. This can safeguard against falsely triggering the device. Other safeguards can include a button sequence, the number of times a button is depressed, etc.”)

Although *DiPerna964* describes a desire to give users flexible options for responding to potential threats and safeguard against false activations, a POSITA would have understood that the mobile device described in *DiPerna964* transmits information and dials 911 upon activation of the panic button, and, as discussed in §VII.A, it does not disclose a technique to allow the panic button to merely ready

itself to perform a function when the panic button is pressed or activated. Nevertheless, a POSITA would have been aware of such techniques by January 2019. *Michalson* ¶74.

For example, *Strack* discloses a system and method “for responding to potential security events.” *Strack*, 4:7-17. The system includes a mobile device executing a mobile application and a monitoring center connected via a network. *Id.*, 6:27-33. The mobile application may be programmed to respond to an “arming event” such as the user pressing one or more buttons on the device. *See id.*, 8:48-63, 9:24-28, claims 1, 2; *Michalson* ¶76. Once armed, the mobile application triggers a “duress timer” (*Strack*, 8:64-9:3), and begins recording audio and video data (*id.*, 12:45-50). The user may extend the duress timer or deactivate the timer, indicating that no potential security event exists, in which case any recording is stopped and deleted. *Id.*, 12:50-13:5; *Michalson* ¶¶77-78.

If the timer is allowed to expire, however, the mobile application enters an “alarm state.” *Strack*, 8:64-9:3, 13:16-21; *Michalson* ¶79. In the “alarm state,” the mobile application sends an alert to the monitoring center with event data including GPS data and streaming and/or recorded audio and video data. *Strack*, 13:11-29 (explaining that alarm state triggers notification to monitoring center, per steps 210-216 of figure 3); 11:34-47 (describing steps 210-216). The mobile application also initiates a telephone call from the mobile application to the emergency telephone

line of the monitoring center. *Id.*; *Michalson* ¶80. For example, an employee walking to their car late at night can press a button to arm the device and begin recording, and then deactivate the timer if there is no security event. *Strack*, 12:42-13:29. If the employee becomes incapacitated (for example, after being attacked), then the duress timer will expire and the mobile application will transmit data and dial an emergency number. *Id.*, 11:34-47; *Michalson* ¶¶81-82.

A POSITA would have understood *Strack*'s mobile device and *DiPerna964*'s mobile device were similar because *Strack* and *DiPerna964* describe implementing their disclosures on similar types of mobile devices. *Strack*, 6:29 (describing a “smart phone, tablet, etc.”); *DiPerna964* ¶[0050] (describing “cellular telephones” and “Blackberry-type devices”). And they both disclose that the mobile device(s) include button(s) that may be used to trigger collection of audio, video, and location data for transmission to a remote location in emergencies. *Michalson* ¶83. A POSITA would have understood that *Strack*'s arming and timer technique would have advanced *DiPerna964*'s objectives to (1) provide users with flexible options for responding to unpredictable and potential security threats, and (2) safeguard against false triggering of the system. For example, a POSITA would have understood that *Strack*'s technique of arming the device and implementing a timer would allow the user the ability to better assess whether the user was actually in a dangerous situation before triggering a call to 911 and transmission of the recorded

information. This would both give the user the flexibility to handle ambiguous potential threats as he/she sees fit and also reduce the likelihood of false triggering because the user would have some additional time to evaluate whether triggering the call/transmission is warranted. *Michalson* ¶¶84-86 (discussing, e.g., *Fadell*, 3:55-62, *Kuz*, 2:45-50).

Thus, a POSITA would have been motivated to incorporate *Strack*'s teachings related to the arming and timer technique into *DiPerna964*. *Michalson* ¶87. The *DiPerna964-Strack* combination discloses or suggests a mobile device with a panic button that, when activated, arms itself to start recording the image, audio, and location data, and that upon expiration of a timer, triggers the device to dial 911 and transmit the image, audio, and location data to a specified location, along with the specific information. *Id.* A POSITA would have understood that the arming and timer technique encompasses readying the panic button to perform the functions of dialing 911 and transmitting data because during the timer, the device is getting ready to perform those functions by recording the image, audio, and location data that is transmitted upon expiration of the timer. *Id.* ¶88.

A POSITA would have considered the combination to amount to the use of known technique (*Strack*'s arming and timer technique) to improve similar devices (*DiPerna964*'s mobile device) in the same way (to allow a user to start collecting information for sending to an emergency service should it become necessary while

giving the user a period of time to disarm the device to reduce false triggering of the system). *Michalson* ¶89. Applying *Strack*'s arming and timer technique to *DiPerna964* would have been well within the skill of an ordinary artisan by January 2019, as evidenced, for example, by the fact that *Strack* already implemented the same functionality in a mobile device similar to *DiPerna964*. *Id.* ¶90.

Accordingly, the *DiPerna964-Strack* combination discloses or suggests a panic button that, when activated (“a panic button, adapted to, when activated”) enters an armed state and initiates a duress timer, during which various data is recorded (“ready itself to perform the following panic button functions:”) and upon expiration of the timer, contacting 911 and transmits the recorded data to the authorities (“(1) dialing a public or private network for an emergency purpose and (2) activating the transmitting unit.”) *Id.* ¶91.

- f. **1[e]: “wherein the panic button is activated by a depressing of the panic button together with another button at substantially the same initial time such that no panic button function is activated unless both buttons are depressed.”**

DiPerna964 in combination with *Strack* discloses or suggests this feature. *Michalson* ¶¶92-94. *DiPerna964* discloses that “[t]he panic button may be activated by ... a depressing of the panic button together with another button.” *DiPerna964* ¶[0024]; *see also id.* ¶[0041] (“The panic button can be activated upon dialing 911 itself or upon pressing the panic button along with an emergency touchpad

‘picture.’”); *id.*, claim 9 (“wherein the panic actuator is activated by at least one of: ... a depressing of the panic actuator together with another actuator”).

Accordingly, the *DiPerna964-Strack* combination discloses or suggests activating the panic button by a depressing of the panic button together with another button (“panic button is activated by a depressing of the panic button together with another button at substantially the same initial time such that no panic button function is activated unless both buttons are depressed”). *Michalson* ¶94.

2. Claim 2: “A mobile device as set forth in claim 1, wherein the specific information includes a time and date stamp.”

DiPerna964 in combination with *Strack* discloses or suggests this feature. *Michalson* ¶¶95-96. *DiPerna964* discloses “wherein specific information includes a time and date stamp.” *Id.* ¶¶[0017], [0028]; *see also id.*, Claim 17. Accordingly, the *DiPerna964-Strack* combination discloses or suggests “wherein the specific information includes a time and date stamp.” *Michalson* ¶96.

3. Claim 3: “A mobile device as set forth in claim 1, wherein the specific information includes a pre-recorded personal warning message if the panic button is activated during a predetermined time period.”

DiPerna964 in combination with *Strack* discloses or suggests this feature. *Michalson* ¶¶97-99. *DiPerna964* discloses that the user may “pre-record a personal warning message which is transmitted to the emergency personnel in the event of an attack during a specific time period.” *Id.* ¶[0044]; *see also id.*, claim 18.

Accordingly, the *DiPerna964-Strack* combination discloses or suggests “wherein the specific information includes a pre-recorded personal warning message if the panic button is activated during a predetermined time period.” *Michalson* ¶99.

4. Claim 4: “A mobile device as set forth in claim 1, wherein the panic button is silent.”

DiPerna964 in combination with *Strack* discloses or suggests “[a] mobile device as set forth in claim 1, wherein the panic button is silent.” *Michalson* ¶¶100-102. *DiPerna964* discloses the panic button may be silent to alert authorities while keeping the alert secret from an attacker. *DiPerna964* ¶¶[0028], [0037], [0042]; *Michalson* ¶101. Accordingly, the *DiPerna964-Strack* combination discloses or suggests “wherein the panic button is silent.” *Michalson* ¶102.

5. Claim 5: “A mobile device as set forth in claim 1, wherein the panic button activates an audible warning message, wherein the audible warning message includes words.”

DiPerna964 in combination with *Strack* discloses or suggests this feature. *Michalson* ¶¶103-106. *DiPerna964* discloses the panic button “activat[ing] an audible warning message.” *DiPerna964* ¶[0028]. Specifically, *DiPerna964* discloses the mobile phone/device broadcasts a warning message via its speaker to announce “911 has been notified and your picture has been taken!” *Id.*, ¶[0042] (quotations omitted). Accordingly, the *DiPerna964-Strack* combination discloses or suggests “wherein the panic button activates an audible warning message, wherein the audible warning message includes words.” *Michalson* ¶106.

6. Claim 6: “The mobile device as set forth in claim 1, wherein the panic button activates an audible alarm.”

DiPerna964 in combination with *Strack* discloses or suggests this feature. *Michalson* ¶¶107-110. *DiPerna964* discloses that a victim can alert the authorities and “may advertise that fact to the attacker (e.g. through pressing a panic button which is also an alarm).” *Id.* ¶[0037]. *DiPerna964* further discloses that “one or more features of the present invention (e.g. picture/audio and location information transmitted, mace activated, *warning sounds*)” may “occur at once.” *Id.* ¶[0043]. Accordingly, the *DiPerna964-Strack* combination discloses or suggests “wherein the panic button activates an audible alarm.” *Michalson* ¶110.

7. Claim 7: “The mobile device as set forth in claim 1, further comprising a safety switch that, upon being moved into position, readies the panic button to contact the public or private network for emergency purposes when the panic button is activated.”

DiPerna964 in combination with *Strack* discloses or suggests this feature. *Michalson* ¶¶111-114. *DiPerna964* discloses the mobile phone/device contains a safety switch that “upon being moved into position, readies the panic button to contact 911 upon being pressed.” *DiPerna964* ¶[0041]. *DiPerna964* further discloses the mobile phone/device is linked to 911 as an “emergency assistance number” to “work with the public authorities in assisting victims.” *Id.* ¶[0036]. Accordingly, the *DiPerna964-Strack* combination discloses or suggests “further comprising a safety switch that, upon being moved into position, readies the panic

button to contact the public or private network for emergency purposes when the panic button is activated.” *Michalson* ¶114.

8. Claim 8: “A mobile device as set forth in claim 1, wherein the owner identification information includes a name and a description of the owner of the mobile device.”

DiPerna964 in combination with *Strack* discloses or suggests this feature. *Michalson* ¶¶115-119. As discussed in §VII.B.1.d, *DiPerna964* discloses transmitting specific information including owner identification information. *DiPerna964* discloses that the specific information includes “the name and description of the owner of the self-defense device.” *DiPerna964* ¶¶[0017], [0035]. A POSITA would have understood that the name and description of the owner of the self-defense device is the same as that of the mobile device because *DiPerna964* discloses that “the present invention provides a self-defense device which is integrated with a mobile phone/device.” *Id.* ¶[0016]. Accordingly, the *DiPerna964-Strack* combination discloses or suggests “wherein the owner identification information includes a name and a description of the owner of the mobile device.” *Michalson* ¶119.

VIII. THE DISCRETIONARY FACTORS FAVOR INSTITUTING TRIAL

A. 35 U.S.C. §314(a)

PO may ask the Board to exercise its discretion to deny institution despite the strong invalidity showing on the merits. The Board should decline to do so because

the weight of the factors articulated in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 6 (Mar. 20, 2020) (precedential) favors institution.⁴

1. Stay

Factor 1 is neutral. Petitioners have not requested a stay but intend to do so. The PTAB has explained that it will not speculate on how any such motion would be resolved, before one is filed. *Google LLC v. Parus Holdings, Inc.*, IPR2020-00847, Paper 9 at 12 (PTAB Oct. 21, 2020). Additionally, the PTAB has explained that this factor is neutral where no such stay motion has yet been filed. *See, e.g., Hulu LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00298, Paper 11 at 10-11 (PTAB May 19, 2021).

2. Trial Date

The docket control order in the parallel litigation currently sets jury selection for March 3, 2025, about 16 months away. EX1035. Any comparison of a projected Final Written Decision date against the scheduled trial date is speculative. *See Dish Network v. Broadband iTV*, IPR2020-01280, Paper 17 at 16 (PTAB Feb. 4, 2021) (“We cannot ignore the fact that the currently scheduled trial date is more than nine

⁴ The *Fintiv* framework should not be followed because it is legally invalid as (1) exceeding the Director’s authority, (2) arbitrary and capricious, and (3) adopted without notice-and-comment rulemaking.

months away and much can change during this time”) Setting that aside, as this Petition is filed in October 2023, a Final Written Decision would be expected by April or May 2025—one to two months after the currently scheduled trial date. Thus, this factor should be neutral or weigh at most minimally in favor of denial. *See Microsoft Corporation v. D3D Technologies, Inc.*, IPR2021- 00703, Paper 10 at 12 (PTAB Oct. 12, 2021) (concluding that although the final written decision is projected to issue about a month after the trial date, Fintiv Factor 2 is neutral); *Protect Animals with Satellites v. OnPoint Sys., LLC*, IPR2021-01483, Paper 11 at 11-13, 17 (Mar. 4, 2022). The Board has instituted with even more time between trial and FWD. *See NetNut Ltd. v. Bright Data Ltd.*, IPR2021-01492, Paper 12 at 9-16 (Mar. 21, 2022) (instituting IPR without stipulation and copending trial date six months before FWD).

3. Diligence/Investment

Factor 3 weighs strongly against discretionary denial. No substantive orders have been issued by the court in the underlying litigation, and investment in the parallel litigation will have remained low at the time of institution. EX1035. Assuming that a Decision on Institution is issued by May 2024, much work in district court will remain. *Id.* The opening claim construction brief is currently due July 25, 2024, the *Markman* hearing is scheduled for September 5, 2024, and opening expert reports are due October 15, 2024.

4. Overlap

Factor 4 weighs against discretionary denial. Petitioners challenge claims 1-8 this Petition and claims 9-15 in a co-pending petition filed on the same day, whereas PO has alleged infringement of only claims 9 and 12. EX1033.⁵ Accordingly, a material number of the challenged claims will not be addressed by the district court.

Petitioners have stipulated that, unless the Board denies or later vacates institution of this Petition, Petitioners will not seek resolution of invalidity in the copending litigation based on the specific grounds asserted in this Petition or any grounds including *DiPerna964* or *Strack*. EX1036.

5. Parties

Petitioners and PO are also parties to the parallel litigation. When the Board's deadline for FWD is estimated to be close in time to the district court trial date and the parties are the same in both proceedings, *Fintiv* factor 5 typically weighs as neutral. *See, e.g., Apple Inc. v. Koss Corp.*, IPR2021-00255, Paper 22 at 19 (weighing factor 5 as neutral “[g]iven the current information concerning the relative timing of the proceedings,” where district court trial was set to begin two months before the FWD deadline).

⁵ Petitioners have filed a Notice of Ranking, explaining why two petitions are necessary and why the Board should institute both petitions.

6. Other considerations

Even if the *Fintiv* factors favor discretionary denial (which they do not), the merits are compelling here. As demonstrated throughout, there is a wealth of prior art that the Office did not consider during prosecution that discloses and/or renders obvious the alleged invention.

Petitioners therefore respectfully submit that the *Fintiv* factors favor institution and that discretionary denial of this Petition would be neither appropriate nor equitable.

B. 35 U.S.C. §325(d)

The Board should likewise not exercise its discretion under §325(d) to deny institution of Petitioner's petition. *Strack* was not previously considered by the Office. *DiPerna964* was at least technically before the Office, but nothing in the record suggests that the Office considered the priority date to which the claims were entitled or that *DiPerna964* might be prior art. There is nothing in the record to suggest that the Office considered whether the "ready itself" limitation was supported by the specification. Indeed, the applicant never even identified any specification support for the feature for the examiner's consideration. Moreover, to the extent PO argues that the examiner implicitly considered these issues or was otherwise required to by the M.P.E.P., the examiner did not do so or clearly erred in his analysis because, as shown, the specification does not provide written description

support for the “ready itself” feature. Therefore, the Board should not exercise its discretion to deny institution under §325(d).

IX. MANDATORY NOTICES UNDER 37 C.F.R. §42.8

A. Real Parties-in-Interest

Petitioners identify themselves as the real parties-in-interest.

1. Related Matters

Samsung is concurrently filing a second IPR petition directed to claims 9-15 of the ’404 patent (IPR2024-00113).

To the best of Petitioners’ knowledge, the ’404 patent has only been involved in the following district court litigation: *Fendgo, LLC v. Samsung Electronics Co., Ltd. et al.*, 2:23-cv-00221-JRG (E.D. Tex.), filed May 19, 2023. EX1034.

Attached to this petition as EX1032 is a chart identifying all patents/application that are in the same family as the ’404 patent.

B. Lead and Backup Counsel

Lead Counsel	Back-Up Counsel
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C. Service Information

Please address all correspondence to lead and back-up counsel at the addresses shown above. Petitioners consent to electronic service by email at the following addresses:

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D. Power of Attorney

A power of attorney is filed herewith according to 37 C.F.R. §42.10(b).

X. FEES

Petitioners concurrently electronically submits the required fees for this Petition. The Board is authorized to charge Arnold & Porter Kaye Scholer LLP's deposit account, No. 50-2387, for any fee deficiency.

Date: November 1, 2023

Respectfully submitted,

/Ali R. Sharifahmadian/
Ali R. Sharifahmadian (Reg. No. 48,202)
Counsel for Petitioners

CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that the foregoing Petition for *Inter Partes* Review contains 5,314 words, excluding those portions identified in 37 C.F.R. §42.24(a), as measured by the word-processing system used to prepare this paper.

/Ali R. Sharifahmadian/
Ali R. Sharifahmadian (Reg. No. 48,202)
Counsel for Petitioners

CERTIFICATE OF SERVICE

I certify that on November 1, 2023, I caused a true and correct copy of the foregoing Petition for *Inter Partes* Review of U.S. Patent No. 11,265,404 and supporting exhibits to be served via overnight delivery on the Patent Owner at the following correspondence address of record as listed on Patent Center:

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A courtesy copy was also sent via electronic mail to Patent Owner's litigation counsel listed below:

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