

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
SAMSUNG ELECTRONICS CO., LTD.;
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners,

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

Case No. IPR2025-00018
U.S. Patent No. 11,122,418

PATENT OWNER'S PRELIMINARY RESPONSE

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2002	<i>Samsung SmartThings Find</i> , https://smarththingsfind.samsung.com/login (accessed January 24, 2024)
2003	Dictionary definition of “for” – Microsoft Encarta College Dictionary, 2001
2004	U.S. Pub. No. 2003/0119522 A1, to Barclay <i>et al.</i>
2005	Reserved
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2007	<i>Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation</i> , Vidal, June 21, 2022
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Mullen Industries LLC (“Patent Owner” or “Mullen”) submits this Preliminary Response to the Petition for *Inter Partes* Review (“Petition”) of U.S. Patent No. 11,122,418 (“the ’418 Patent”) filed by Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Google LLC (“Petitioners”).

I. INTRODUCTION

The Board should deny institution under 35 U.S.C. § 314(a) for each of the following reasons:

First, as a threshold procedural matter, the petition should be denied on *Fintiv* grounds in light of the underlying district court litigation. Petitioners have filed eleven IPR petitions challenging the validity of the eight patents at issue in the underlying district court case.¹ The eleven IPR petitions contain in total 64 grounds and 28 prior art references. *Id.* Petitioners have asserted all of these invalidity grounds (and more) in the district court case. By way of this and their ten other petitions, Petitioners are seeking to convert what is a single proceeding—the district court case—into eleven PTAB proceedings. Moreover, the district court case (which the district court has already declined to stay, and with virtual certainty will not be

¹ See (1) IPR2024-01472, (2) IPR2025-00018, (3) IPR2025-00019, (4) IPR2025-00021, (5) IPR2025-00124, (6) IPR2025-00197, (7) IPR2025-00365, (8) IPR2025-00366, (9) IPR2025-00367, (10) IPR2025-00368, (11) IPR2025-00369.

stayed) will hold trial six months before any Final Written Decision would issue on this Petition, and at least as long or even further in advance of any Final Written Decision(s) in regard to the other ten Petitions. Accordingly, institution of this Petition and the ten other Petitions would undermine the very principles and premise of the America Invents Act, as it would multiply and complicate the proceedings, rather than simplify matters.

Moreover, Petitioners' indication over email this week that it will file a purported "*Sotera*" stipulation does *not* change that the Board should deny institution. Both the former Director, and former Acting Director, recently confirmed in court filings that the Board *retains* discretion to deny institution under *Fintiv* even when Petitioner files such a stipulation (*e.g.*, Ex. 2017 at 17, "It is not true that this means the factors *per se* dictate the outcome. The only requirement is consideration, after which the Board may choose to—or not to—institute IPR."); *id.* at 15 ("The *Fintiv* factors ... merely guide the Board's decision-making process ... without dictating any particular outcome."). Otherwise, the factors would violate statute and be unconstitutional. *See id.*; *also infra* at §§ III.A.1-III.A.3. This, indeed, is unsurprising because many comments in response to the former Director's recent request for public comment noted that the Board must retain discretion to perform a "holistic" analysis that considers the specific facts on a case-by-case basis, and that a stipulation (even if a "true" *Sotera* stipulation) is merely one factor to consider.

Id. Here, any stipulation does not overcome the strong evidence that institution should be denied. Moreover, as the courts have recognized when considering the language contained in Petitioners' stipulation, it is insufficient and does not change that the Board should deny institution to avoid duplicative litigation as the facts here show that if the Board institutes it will put the parties in the wasteful, and prejudicial to Patent Owner, position of litigating common validity issues in both forums. *Id.*

Second, on the merits, the Petition fails to establish invalidity based on the multiple asserted references for any Ground. As described in detail below, the Petition fails to establish the presence of multiple claim limitations applicable to each of the Grounds of the Petition. For example, for all of Grounds 1-9, the Petition fails to establish anticipation or obviousness of a wireless device that is operable to have its location determined and that includes a permission operable of being provided by the wireless device for a second wireless device to access information about that location. As explained herein, these claimed features are indeed Patent Owner's innovative improvements that improve system security and are in no way taught or suggested by the cited art. In addition, for Grounds 1-4, the Petition fails to establish anticipation or obviousness of a wireless device that is operable of providing a first map provided with respect to the location of the wireless device.

For each of these independent reasons, the Petition should be denied.

II. BACKGROUND

A. Mr. Mullen, The '418 Patent, And The Underlying District Court Case

Jeffrey Mullen is an independent inventor who has invented prolifically across a wide array of technologies since the early 2000s, including, for example, with regard to wireless and cellular communications systems and devices, security improvements regarding the same, augmented reality and virtual reality devices, and autonomous defense systems. Mr. Mullen is the inventor of the '418 Patent and the sole member and founder of the Patent Owner Mullen Industries LLC. Patent Owner filed the underlying district court case more than a year ago in January 2024 to seek remedies for Petitioner Samsung's unlawful use of Mr. Mullen's patented technologies, including but not limited to with regard to the '418 Patent.

Mr. Mullen disclosed in U.S. application no. 11/485,161 and its corresponding U.S. provisional application no. 60/367,967 his innovation of a wireless device that includes security features for sharing information about the wireless device's location with another device and without requiring a telephone call to be established. The wireless device is operable to have its location determined and itself grants a permission for another wireless device to access location information about that location, and even displays a map provided with respect to the wireless device's location—all of this more than 18 years *before* Samsung released its Samsung SmartThings Find technology containing the same features. Ex. 2001; Ex. 2002.

Each of the Grounds of the Petition is directed to Claim 1, Claim 18, or Claim 19 of the '418 Patent, or a claim dependent on Claims 1, 18, or 19.

Claim 1 defines a system that includes a first wireless device. Ex. 1001, Claim 1. Among other things, as relevant to this Preliminary Response, Claim 1 specifies that a first wireless device operable of having its location determined includes a permission that is operable of being provided by said first wireless device for said second wireless device to access location information about said location. *Id.*

Claim 1 also specifies that the permission is operable of being stored in a remote system, wherein said remote system is located remotely from said first and second wireless devices. *Id.*

In addition, Claim 1 specifies that the first wireless device is operable of providing a first map provided with respect to the first wireless device's location. *Id.*

These summarized features of Claim 1 addressed in this Preliminary Response are seen in the below emphasized text of Claim 1. Claim 1 specifies several additional features, as seen below in the Claim, as do corresponding dependent claims 2-17, which would need to be addressed if there were institution.

Limitation	Claim Language
1(pre)	A system comprising:

Limitation	Claim Language
1(a)	a first wireless device, wherein a location of said first wireless device is operable of being determined and provided to a remote system,
1(b)	said location of said first wireless device is operable of being requested by a second wireless device outside of a call for communication between said first wireless device and said second wireless device,
1(c)	<i>a permission is operable of being provided by said first wireless device for said second wireless device to access location information about said location,</i>
1(d)	<i>said permission is operable of being stored in said remote system, wherein said remote system is located remotely from said first and second wireless devices,</i>
1(e)	said location information about said location is operable of being provided from said remote system to said second wireless device in accordance with said permission outside of said call,
1(f)	<i>wherein said first wireless device is operable of providing a first map provided with respect to said location.</i>

In addition, Claim 18 includes similar features, as addressed in greater detail below in this Preliminary Response. Again, Claim 18 specifies several additional features, as do corresponding dependent claims 20-25, which would need to be addressed if there were institution. Claim 19 likewise includes similar features, as addressed in greater detail below in this Preliminary Response. Claim 19 specifies several additional features, as do corresponding dependent claims 26-30, which would need to be addressed if there were institution.

B. Claim Construction

The Petition's section addressing claim construction identifies the standard for claim construction applicable to IPRs but does not identify any terms for construction. Pet. at 5. The Petition, however, ignores that claim construction was disputed in prior IPR proceedings involving the '418 Patent before such proceedings were terminated due to settlement, and at least the same disputed constructions are relevant here.

Accordingly, relevant to the issues here, Patent Owner submits that the Board should construe the following terms. Patent Owner reserves the right to identify additional terms necessitating construction should there be institution.

1. **Claim 1 – “a permission is operable of being provided by said first wireless device for said second wireless device to access location information about said location”**
2. **Claim 18 – “a [first / second] permission is operable of being provided by said [first / second] wireless device for said [second/first] wireless device to obtain said [first / second] location”**
3. **Claim 19 – “a [first / second] permission is operable of being provided by said [first / second] wireless device for said [second / first] wireless device to obtain said [first / second] location”**

Claim 1 of the '418 Patent recites that “*a permission* is operable of being *provided by said first wireless device for said second wireless device to access location information about said location*” of the first wireless device. Ex. 1001, 13:25-28 (emphases added).

Patent Owner submits the plain language of Claim 1 requires that the “permission” is provided both (i) by a specific device (*i.e.*, the same first wireless device recited in the claim that has its location determined) and (ii) for a specific device (*i.e.*, the “second wireless device” recited in the claim).

Claims 18 and 19 recite similar features, with the caveat that they specify that both a first permission and a second permission are operable of being provided by a first wireless device and a second wireless device, respectively, for another specified device as recited in the claims:

- “a first *permission* is operable of being provided *by* said first wireless device *for* said second wireless device to obtain said first location” (*id.*, Claim 18(f), 18:40-42) (emphases added);
- “a second *permission* is operable of being provided *by* said second wireless device *for* said first wireless device to obtain said second location” (*id.*, Claim 18(g), 18:43-45) (emphases added);
- “a first *permission* is operable of being provided *by* said first wireless device *for* said second wireless device to obtain said first location” (*id.*, Claim 19(f), 15:3-5) (emphases added);
- “a second *permission* is operable of being provided *by* said second wireless device *for* said first wireless device to obtain said second location” (*id.*, Claim 19(g), 15:6-8) (emphases added).

Patent Owner submits that construing these terms is necessary because, as addressed *infra* at Section III.B, the construction of these limitations is relevant to Petitioners’ failure to demonstrate invalidity of Grounds 1-9 of the Petition. Specifically, as addressed *infra* at Section III.B, Petitioner:

(i) improperly ignores (by ascribing no meaning to and failing to substantively address in the Petition) the portion of these terms that expressly requires the “permission” to be “provided *by*” a specific device recited in the claim

(e.g., in Claim 1, the same “first wireless device” recited in the claim that has its location determined); and

(ii) incorrectly argues that “a *permission* ... *for*” the specific device recited in the claim can be satisfied when no permission has been granted for that device but the device nonetheless may just so happen to be allowed access to location information as a result of a group policy that gives a group access to location information. Indeed, notwithstanding that these are very different concepts, the Petition conflates these two concepts and concedes, fatally to its invalidity allegations, that it uses them “interchangeably.” Pet., 13.

As a result of Petitioners’ two errors, Petitioners in effect seek to improperly rewrite this term in Claim 1 to read: “~~a permission is operable of being provided by said first wireless device for~~ a policy that may result in allowing said second wireless device to access location information about said location.” But this is not what is claimed. When a device provides a permission for a second device to access location information, advantageously there is certainty and transparency regarding what device can access the location—*i.e.*, the second device can. The claimed invention thus eliminates the risk of erroneously allowing access to location information to unwanted recipients, or conversely disallowing access to location information to recipients desired to have such access.

By contrast, when a policy is set that allows a group to access position or location information, which is how the references cited in Petitioner's Grounds purport to operate, it does not mean that any device has access to the location information. The group may be an empty set and the group's members may change over time such that the location access is not "for" any device but rather generic to a group, however such group is defined and however that definition may change over time. Accordingly, use of a group construct to govern access is very different than what Patent Owner claims and imposes risk of erroneously allowing or disallowing access to location information. Illustrating this, a group policy remains unchanged when a member is added to the group, which creates risk of erroneously allowing access to location information to the member when, for example, a user forgets that the group is allowed to access location information when adding the member to the group. Likewise, a group policy remains unchanged when a member is removed from the group, which creates risk of erroneously disallowing that member's access to location information when, for example, a user forgets when removing a member from the group that it was the member's inclusion in the group that permitted the member to access the location information. This difference relative to what the '418 Patent claims is significant, including in terms of system security. The '418 Patent indeed expressly recognizes this difference when it explicitly states that "[o]ne object of the present invention is to provide a security

feature which allows a user to limit and/or deny location access to a particular user.”

Ex. 1001, 1:44-46.

Accordingly, the Board should construe this term because the parties fundamentally dispute its meaning and, as discussed *infra* at Section III.B, Petitioner’s alleged art does not satisfy this term as properly construed.

As the Board is aware, claims in IPRs are construed according to the standard the Federal Circuit has specified in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

First, as to issue (i) referenced above, the plain language of the claims is itself clear that the “permission” must be “provided *by*” the specific device recited in the claim (e.g., in Claim 1, the permission must be provided by the same “first wireless device” recited in the claim that has its location determined). These words must be given meaning and cannot be ignored. *Phillips*, 415 F.3d at 1314 (“[T]he claims themselves provide substantial guidance as to the meaning of particular claim terms.”); *Exxon Chemical Patents v. Lubrizol Corp.*, 64 F.3d 1553, 1557 (Fed. Cir. 1995) (“We must give meaning to all the words in [the patent’s] claims.”). This should end the inquiry. It conclusively establishes that the device specified in each claim (e.g., in Claim 1, the “first wireless device”) must provide the “permission,” and the Board should reject Petitioners’ attempt to ignore this limitation or read it out of the claim. Indeed, this feature advantageously enhances system security by

requiring the same device that has its location determined to provide the permission to access the device's location information. Ex. 1001, 1:44-54 (“One object of the present invention is to provide *a security feature which* allows a user to limit and/or deny location access to a particular user. ... In this manner, *a cell phone user may give access, through his or her cell phone*, to a friend so that the friend can locate him or her”) (emphases added).

Second, as to issue (ii) referenced above, the meaning of “a ... permission ... *for*” another device in these claim terms is well understood in the English language. Laypersons and skilled artisans alike know that the word “for” means “*intended to be received or used by or aimed at somebody*.” Ex. 2003. This alone makes clear these terms require the claimed “permission ... *for*” the specified device to be a permission that is intended to be received or used by or aimed at that specific device; not merely a group policy that may result in allowing access to location information to indeterminate and fluctuating members of a group. The '418 Patent intrinsic record is consistent, and does not require a different interpretation.

Reviewing first the claim language, the plain wording of the claims supports Patent Owner's construction. These claim terms explicitly recite that “a permission,” “a first permission,” or “a second permission” is “provided ... *for*” a specified “wireless device.” The plain and customary meaning of these ordinary words is readily apparent—a consent (“permission”) is given (“provided”) that is

intended to be received or used by or aimed at somebody (“for”)—and the claim language expressly identifies that somebody, *i.e.*, the specified wireless device. *Phillips*, 415 F.3d at 1314 (“In some cases, the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words.”). These words of the claims cannot be ignored, including their requirement that the “permission” is “for” a specified wireless device. By contrast, to interpret these claims as merely setting a policy that applies to a group, however that group is defined and may change, would improperly strip the claims of their actual words and common meaning. *See VLSI Tech. LLC v. Intel Corp.*, 53 F.4th 646, 655-656 (Fed. Cir. 2022) (rejecting purported claim interpretation because “it does not explain the addition of the phrase ‘as a result of being used for electrical interconnection not directly to the bond pad.’ . . . that phrase was meant to serve some purpose ...”) (citing *Merck & Co. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005) (“A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so.”)); *Exxon Chemical Patents v. Lubrizol Corp.*, 64 F.3d at 1557 (“We must give meaning to all the words in [the patent’s] claims.”). This distinction is again important and specifically relates to Patent Owner’s innovation regarding improving system security. Ex. 1001, 1:44-46 (“One object of the present invention

is to provide *a security feature which allows* a user to limit and/or deny location *access to a particular user.*”) (emphases added).

The language of the dependent claims also supports Patent Owner’s construction. Dependent Claims 6, 24, and 30 recite that “said permission” is operable of being “removed ... for” the second wireless device:

6. The system of claim 1, wherein *said permission* is operable of being *removed*, by said first wireless device, *for said second wireless device* to obtain said location.

Ex. 1001, 13:46-48 (emphases added).

24. The system of claim 18, wherein *said first permission* is operable of being *removed*, by said first wireless device, *for said second wireless device* to obtain said first location.

Id., 16:8-10 (emphases added).

30. The system of claim 19, wherein *said first permission* is operable of being *removed*, by said first wireless device, *for said second wireless device* to obtain said first location.

Id., 16:24-26 (emphases added). These claims, too, expressly recite that “said permission” or “said first permission” is “*for said second wireless device.*” This can only be true when the permission is granted, by the first wireless device, to the second wireless device, instead of to a group that may possess an empty set or a membership that changes over time. To illustrate, revoking location access rights for a group will not affect whether a device can access location information if that

device is also a member of another group that can still access the location information. As another example, revoking location access rights for a group will not affect whether a device can access location information if that device is not (or is no longer) one of the group's members.

The specification also supports Patent Owner's construction. It repeatedly and consistently describes the invention as a user selecting, via a user's device (*i.e.*, the same device that is operable to have its location determined), another specific user for receiving permission:

[T]he present invention provides systems and methods for allowing a user of a cellular phone (e.g., a requesting user or a requestor) to locate the position of a different user's cellular phone (e.g., a requested user) based upon requestor-assigned access rights.

One object of the present invention is to provide a security feature which allows a user to limit and/or deny location access to a particular user.... only the users that have been granted access to the location of a user's cellular phone can actually locate that user's cellular phone. ... In this manner, a cell phone user may give access, through his or her cell phone, to a friend so that the friend can locate him or her

Ex. 1001, 1:39-49 (emphases added). This, too, is exactly what the '418 Patent discloses in connection with Figure 9 (*i.e.*, disclosing that "in accordance with the principles of the present invention" a wireless device user grants permission to access location information to another device by identifying or selecting that other device). *Id.*, Figure 9 and 9:10-15. *See also Sequoia Tech., LLC v. Dell, Inc.*, 66

F.4th 1317, 1326 (Fed. Cir. 2023) (citing *Kaken Pharm. Co. v. Iancu*, 952 F.3d 1346, 1352 (Fed. Cir. 2020) (“A patent’s statement of the described invention’s purpose informs the proper construction of claim terms....”)); *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007) (“When a patent ... describes the features of the ‘present invention’ as a whole, this description limits the scope of the invention.”).

The ’418 Patent also repeatedly and consistently refers to the specific benefits of assigning rights to a specific user, which further underscores that these words must be given specific meaning in the claims:

Phil *may grant Bill access* the exact location of his cell phone for a specific period of time

Ex. 1001 at 1:58-59 (emphases added); *see also* 8:22-28 (Bill and Jane).

[L]evels in the scope of access may be controlled by a user such that, for example; only a user’s exact location, approximate location, city, state, or country can be accessed *by a particular user*.

Id., 1:66-2:2 (emphases added).

Security is preferably taken into account in the present invention and, therefore, *location rights for a specific user may be given to a different user only* by that specific user. However, a user may request location access rights from a different user. For example, a user may be provided with a request location screen on his cell phone and that user (e.g., user “X”) may enter in the cell phone number of the cell phone whose location is desired. The user associated to the entered cell phone number may then receive an alert that says “user X has requested access to

your location.” Location access may then be given or denied on multiple levels and the requesting user notified of the decision.

Id., 3:9-21 (emphases added).

In this manner, *every user may assign rights (e.g. govern the security) to whom may or may not locate him/her*. In preferred embodiments, these rights will be stored in, or functionality executed from, a remote facility and accessed and utilized by a user’s cell phone or other requesting device (e.g., a watch or PDA).

If access has been given by a particular user that allows *for the requesting user* to locate that particular user, step 208 is initiated and the allowed location information is provided to the user in step 210.

Id., 4:60-5:2 (emphases added).

FIG. 10 shows display screen 1000 of *assigning location rights to a user* in accordance with the principles of the present invention. Display screen 1000 may be displayed, for example, *after a user has been selected to be given location rights*.

Id., 9:16-20 (emphases added)

If a location is requested, access rights to the requested location for the requesting device and/or user are obtained at step 1703. Step 1703 may be employed for example, as a call to a database storing a list of assigned access rights for the requested device/user and finding if any access rights were *assigned to the requestor’s identity*.

Id., 11:64-12:2 (emphases added).

The ’418 Patent’s prosecution history also supports Patent Owner’s construction. In the Office Action mailed October 27, 2020, the Examiner stated

that the claim requirement for “a permission ... operable of being provided ... for said second wireless device” to access location information was met by cited reference U.S. Pub. No. 2003/0119522 A1 to Barclay *et al.*, at paragraph [0018], which refers to “***permission options*** ... to selectively allow the customer ***to allow certain individuals*** the ability to see the customer’s location information.” Ex. 1002, at 667; Ex. 2004, at ¶ [0018] (emphases added). This coupling of each permission to a certain individual demonstrates that the Examiner, too, interpreted the claims to require each permission to be for a specified device as recited in the claim, and applicant did not dispute that aspect of the Examiner’s analysis. Ex. 1002, at 689-690. This likewise supports Patent Owner’s position that the claims should be construed to require that the ’418 Patent’s claimed permission must be provided for a specified device as recited in the claim, because Patent Owner’s construction is consistent with the manner in which these terms were construed during prosecution. *Phillips*, 415 F.3d at 1317 (“The prosecution history, which we have designated as part of the ‘intrinsic evidence,’ consists of the complete record of the proceedings before the PTO and includes the prior art cited during the examination of the patent. ... Like the specification, the prosecution history provides evidence of how the PTO and the inventor understood the patent.”).

Accordingly, the Board should hold that these claim terms require the claimed permission to be provided (i) by the specific wireless device recited in each claim

(*i.e.*, the same wireless device recited in the claim that has its location determined) and (ii) for the specific device as recited in the claim, and that these terms cannot be satisfied by a group policy that merely gives a group construct, however such group is defined and may change over time, access to the location information.

III. ARGUMENT

A. The Petition Should Be Denied Under *Fintiv* As The Issues Presented By The Petition And Petitioners' Ten Other Petitions Will Be Resolved First In The Underlying District Court Case And Institution Of This Petition And The Other Ten Petitions Would Greatly Multiply The Proceedings, Rather Than Simplify Matters

Petitioners take a single district court litigation and seek to turn it into eleven proceedings before the Board, which would issue final written decisions many months after the scheduled trial in the single district court case. The Board should use its discretion to deny institution of Petitioners' eleven IPR petitions, including this Petition.

As even former Director Vidal pointed out, "Congress designed the America Invents Act (AIA) post-grant proceedings 'to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.'" Ex. 2007 at 1 (citing H.R. Rep. No. 112-98, pt. 1, at 40 (2011), 2011 U.S.C.C.A.N. 67, 69; *see* S. Rep. No. 110-259, at 20 (2008)). Instituting Petitioners' eleven IPR petitions is directly contrary to this goal. This is because "[p]arallel district court and AIA proceedings involving the same

parties and invalidity challenges can increase, rather than limit, litigation costs.” Ex. 2007 at 1.

Here, instituting the eleven IPR petitions that would have the same outcome as the single pending district court case (upholding the validity or invalidating the patents) would drastically increase the litigation costs of the parties. This should not be taken lightly, especially here where Petitioners Samsung and Google, major technology companies, have sought to multiply the proceedings against an inventor-owned Patent Owner, whose sole member Mr. Mullen is the inventor of all involved patents. Moreover, notably, here the district court case is considering the exact same references (*even considering* Petitioners’ purported stipulation) and will also consider even more invalidity grounds. The single district court case will thus cover all of the invalidity grounds raised across the eleven IPR petitions as well as additional invalidity grounds. Petitioners’ IPR petitions thus do the opposite of streamlining the dispute between the parties, and instead multiply it drastically. The Board should therefore use its discretion to deny institution.

Under 35 U.S.C § 314(a), the Board has discretion to deny a petition based on the status of a related litigation. The Board considers six non-dispositive factors to determine whether efficiency, fairness, and the merits support denial:

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

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

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

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

Factor 5: whether the petitioners and the defendants in the parallel proceeding are the same parties;

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

Apple v. Fintiv, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential).

As discussed below, each of the six *Fintiv* factors supports the Board denying institution. The current advanced state of the parallel district court case, as well as the fact that the district court has already denied a request by Samsung for a district court stay, favors denial of the Petition. In addition, by the time the Board will issue an institution decision in this IPR Petition (expected mid-May 2025), claim construction will already be fully briefed in district court and opening expert reports will be exchanged the same month. *See* Ex. 1038 (EDTX Scheduling Order). Moreover, fact discovery has been underway for a year and the parties will have already substantially completed their document productions. *Id.* The parties have indeed already served many discovery requests in the district court case, conducted depositions and source code reviews (of both party source code and non-party source

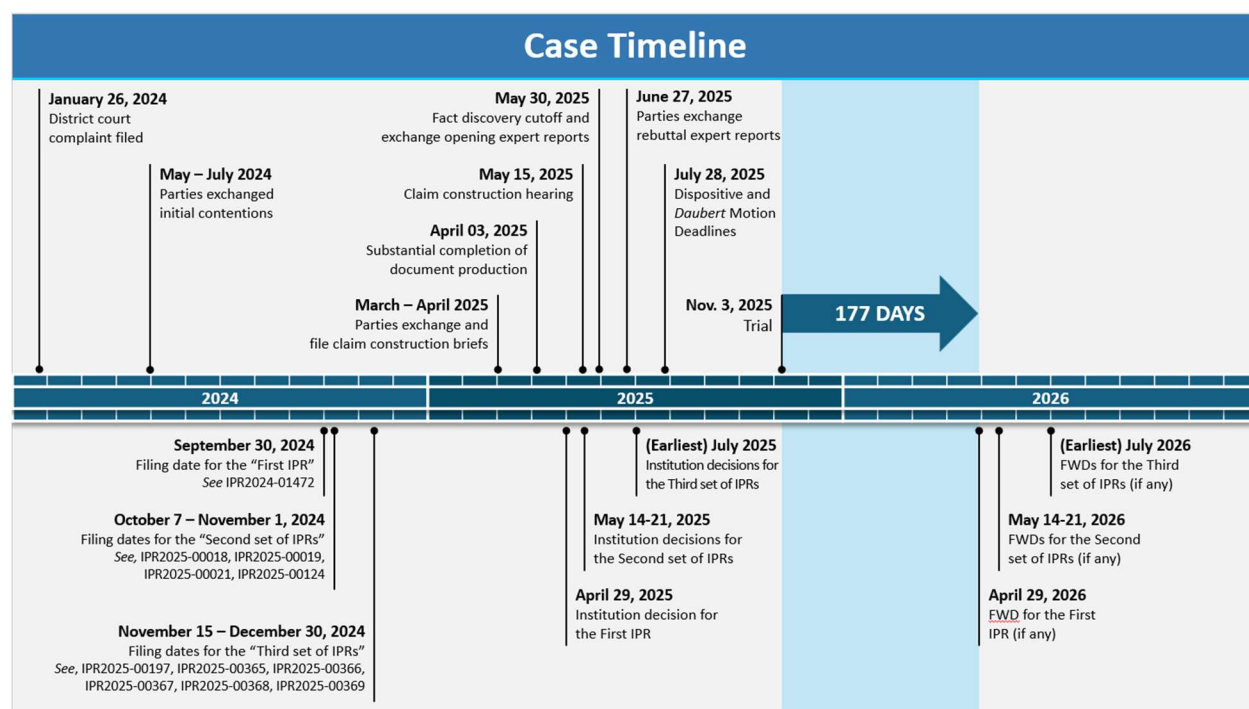
code), and produced over 340,000 pages of documents. The district court trial is also scheduled for November 3, 2025, which is approximately *six months before* any Final Written Decision would issue in this IPR. *Id.* Still further, Final Written Decisions in Petitioners' other ten IPRs would issue at about the same time or even later and in some instances not until at least *eight months* after the parallel district court trial. And, as explained below, the district court has already denied one request from the Samsung Petitioners for an IPR stay, and with virtual certainty will not grant any other request for a stay because the district court trial is already scheduled to complete well before the Board would issue a Final Written Decision on any petition.

Tellingly, Petitioners have not offered (nor can they) any real argument that supports instituting its eleven IPRs—which at best would result in rulings many months after the district court trial—rather than letting the parties resolve all of the issues in a single, faster district court case that is already scheduled to complete trial less than nine months from now in early November 2025. Accordingly, the Board should deny institution to serve and maintain the goals of efficiency and efficacy, as well as fairness to the Patent Owner. *See, e.g., General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017).

Factor 1: the district court denied Petitioners’ motion for a stay and is highly unlikely to issue a stay even were this Petition instituted. Petitioners state that this factor is neutral. Pet., 75. Petitioners, however, fail to consider the specific evidence of (i) the district court having already denied Petitioners’ request for a stay in light of IPRs (Ex. 2008) and (ii) the district court’s well-understood practice of denying requests for stays in circumstances directly analogous to the facts here, discussed below.

The Board holds that this factor considers “specific evidence” of whether the district court will grant a stay in the individual case at issue. *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative). Here, all evidence points to a stay not being entered in the district court pre- or post-institution. Indeed, Judge Gilstrap presides over the district court case in the United States District Court for the Eastern District of Texas (“E.D. Tex.”) and has already denied Petitioner Samsung’s request to stay the parallel district court case pre-institution of any IPRs. Ex. 2008. In addition, Judge Gilstrap has ordered that Samsung may not refile any request for a stay until ***after*** “the PTAB’s institution decision on the last of the pending IPRs.” *Id.* at 3. In light of this, and Judge Gilstrap’s well understood practices regarding stays, specific evidence in the form of Judge Gilstrap’s prior orders on requested stays pending IPRs in analogous circumstances—***denying*** a stay in each instance—

demonstrate that Judge Gilstrap will invariably also deny any potential future request for a stay here too. Indeed, as shown in the following timeline, the Board will not even issue its institution decisions in the last of the pending IPRs until at least July 2025 (“Institution decisions for the Third set of IPRs”), which will be less than four months before the district court trial will begin in early November 2025.



Here, Judge Gilstrap’s prior order denying a stay and the case timeline demonstrate that Judge Gilstrap will not enter a stay in the parallel district court case. The Board’s decision on institution in this IPR is not expected until May 14, 2025 (“Institution Decisions for the Second set of IPRs”). By that time, however, the parties in the district court case will have completed claim construction briefing, taken depositions, continued to review source code, produced even more than the

already-produced 340,000 pages of documents, and substantial completion of document production will have already taken place. Ex. 1038 at 4. In addition, fact discovery ends and opening expert reports are exchanged just weeks later on May 30, 2025. *Id.* at 3. Moreover, a Final Written Decision (if any) in this IPR would be received approximately *six months after the district court trial* on November 3, 2025 (“FWD for the Second Set of IPRs (if any)”), and approximately at least *eight months after the district court trial* in Petitioner’s third set of IPRs (“FWDs for the Third set of IPRs (if any)”). As Petitioner Samsung knows, Judge Gilstrap denies motions to stay district court litigation pending IPRs in such circumstances. *See, e.g., MyPort, Inc. v. Samsung Elecs. Co., Ltd.*, Case No. 2:22-CV-00114-JRG, Order, Dkt. 73 at 4-5 (E.D. Tex. June 13, 2023) (denying a motion to stay when trial was scheduled and “the PTAB [final written] decision is not due until over two months after jury trial is set to begin”) (Ex. 2009 at 4-5); *Solas OLED Ltd. v. Samsung Display Co., Ltd.*, Case No. 2:19-CV-00152-JRG, 2020 U.S. Dist. LEXIS 125973, at *6 (E.D. Tex. July 17, 2020) (denying a motion to stay because “trial is only a few months away” and PTAB final written decisions would have been issued months after the scheduled trial) (Ex. 2010 at *6); *Oyster Optics, LLC, v. Infinera Corp.*, Case No. 2:19-CV-00257-JRG, Order, Dkt. 87 at 4-5 (E.D. Tex. July 17, 2020) (denying a motion to stay because claim construction briefing was finished

and “[f]act discovery is closing in about a month and trial is only six months away.”) (Ex. 2011 at 4-5).

None of Petitioners’ IPRs are necessary, much less efficient, because the district court trial is a single proceeding that will address all issues in Petitioners’ eleven IPRs. Thus, Factor 1 heavily favors denial of institution.

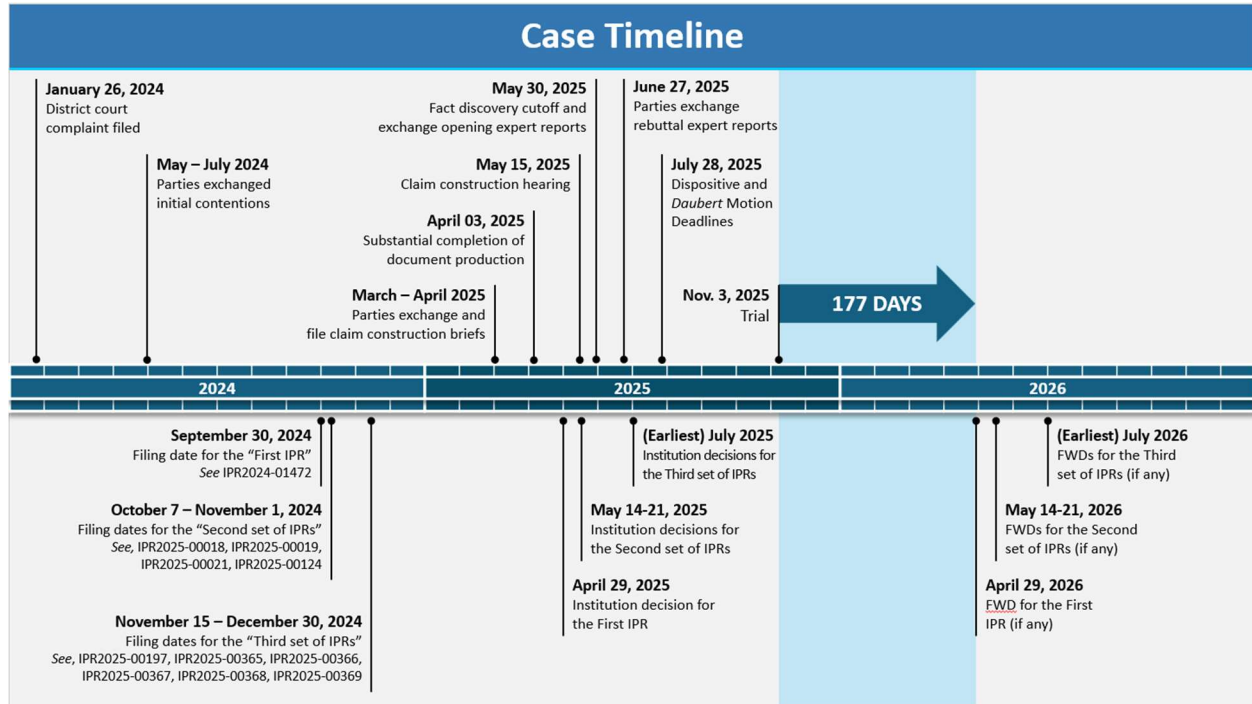
Factor 2: the single district court case will resolve all of the issues presented in the eleven petitions many months before any final written decision. The Board generally denies institution when the trial date is months before the projected statutory deadline of the PTAB’s final written decision (FWD). *Fintiv*, IPR2020-00019, Paper 11 at 9 (“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.”). The district court trial is set for November 3, 2025, which is more than six months before the earliest expected date of a FWD (mid-May 2026) in this Petition. Accordingly, this factor weighs heavily in favor of denying institution because the Board regularly finds that a period of six months or less between the district court trial and the expected FWD date supports denial of institution. *See, e.g., id.* (5-6 months based on the time-to-trial evidence); *Samsung Electronics Co., Ltd. v. Mojo Mobility Inc.*, IPR2023-01094, Paper 11 at 8 (Feb. 9, 2024) (“As the Texas Litigation is scheduled to go to trial ... approximately six months before a final written decision would be entered, we determine that Factor 2

weighs in favor [of] discretionary denial.”); *Satco Products, Inc. v. The Regents of the University of California*, IPR2021-00794, Paper 14 at 19 (PTAB Nov. 10, 2021) (five months); *Maxlite, Inc. v. Jiaxing Super Lighting Electric Appliance Co., Ltd.*, IPR2020-00208, Paper 32 at 5 (PTAB Oct. 12, 2021) (four months); *Stanley Black & Decker, Inc., et al. v. Zircon Corp.*, IPR2020-01572, Paper 10 at 12 (PTAB Apr. 19, 2021) (three months); *Next Caller, Inc. v. TrustID, Inc.*, IPR2019-00961, Paper 10 at 14-15 (PTAB Oct. 16, 2019) (three months); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 at 6 (PTAB May 15, 2019) (one month).

In addition, E.D. Tex. trial statistics before Judge Gilstrap where the parallel district court case is pending confirm that the November 3, 2025 district court trial date is firm and likely to hold. Ex. 2012 at 2. Indeed, the median time to jury trial in patent cases before Judge Gilstrap is 19.8 months after filing of the original complaint. *Id.* This would time the district court trial for September 2025 (*i.e.*, even before the currently scheduled trial date), which means that the present November 3, 2025 trial date is both credible and conservative. *Id.*; *see also Samsung Electronics Co., Ltd. v. Mojo Mobility Inc.*, IPR2023-01094, Paper 11 at 8 (Feb. 9, 2024) (exercising discretion to deny institution including because “[t]he fact that the time-to-trial statistics ... predict that a trial will be ... earlier than the trial date set in the court’s docket control order ... confirms that the schedule set by the district court is credible and should be given weight”).

Accordingly, Factor 2 also favors denying institution.

Factor 3: there has and continues to be significant investment by the parties in the district court litigation. The Board has used its discretion to deny institution when, as here, there has been significant investment in the parallel district court proceeding. As shown in the case timeline below, the district court proceeding has been pending for more than a year since January 26, 2024. The Parties have prepared and exchanged infringement and invalidity contentions, presented initial disclosures, served many discovery requests, taken depositions, conducted numerous expert reviews of produced source code (including source code produced by all Petitioners here), and are in the midst of claim construction discovery and additional substantial fact discovery that has already resulted in document production in the district court litigation of over 340,000 pages from both parties and non-parties. In addition, by the time the Board issues its institution decision, claim construction in the district court will already be fully briefed.



Petitioners also did not file their Petitions expeditiously, which favors denying institution. Petitioners waited many months after the district court complaint was filed to submit their Petitions. For example, as shown in the timeline above, Petitioners waited over eight months after the district court complaint was filed to submit their Petition in this IPR. Ex. 2013 (district court original complaint). For its other Petitions, Petitioners waited the same amount of time or even longer and in five of such Petitions Petitioners waited more than 11 months from the time the district court complaint was filed to submit the Petitions. This is far different from situations where a petitioner was deemed diligent. *Cf. Verizon Business Network Services, Inc. v. Huawei Techs. Co.*, IPR2020-01141, Paper 12 at 12 (PTAB Jan. 14, 2021).

Accordingly, because the parties have already expended, and continue to expend, significant time and resources in relation to the district court case, this factor weighs greatly in favor of denying institution of the Petition.

Factor 4: there is significant overlap between issues raised in the petition and in the parallel proceeding. “[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, th[at] fact has favored denial.” *Fintiv*, IPR2020-00019, Paper 11 at 12. Here, Petitioners challenge most of the ***same*** claims in their Petition—and across their ten other Petitions—that they do in their invalidity contentions at the district court. *See* Ex. 2014 at 2. In fact, Petitioners even rely on the same references in the Petition as they do in the district court. *See* Ex. 2014 at 114-115 (citing the same references at issue here, *i.e.*, *Sheha*, *Ryden*, *Tanaka*, *Randall*, *De-Vries*, and *Wollrab*). This is true ***even if*** Petitioners’ purported stipulation is entered. *See infra* at §§ III.A.1-III.A.3. Thus, the Petition includes substantial overlap with the claims, and substantial if not complete overlap with the evidence, asserted in the parallel district court litigation.

Accordingly, this factor, too, weighs heavily in favor of denying institution.

Factor 5: petitioners and the defendants in the parallel proceeding are the same party. Factor 5 also weighs in favor of denial because the parties to this proceeding are the same parties in the district court litigation—*i.e.*, Mullen Industries

LLC and the Samsung entities. *Fintiv*, IPR2020-00019, Paper 11 at 15 (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”). Petitioners do not contest these facts but, without explanation, argue incorrectly and nonsensically that “[t]his factor is neutral.” Pet., 77. This factor is not neutral; rather, it supports denying institution. *Fintiv*, IPR2020-00019, Paper 11 at 15.

Moreover, the fact that Google LLC is an additional co-Petitioner in these IPR proceedings is of no moment. *Id.* at 14 (“Even when a petitioner is unrelated to a defendant, however, if the issues are the same as, or substantially similar to, those already or about to be litigated, or other circumstances weigh against redoing the work of another tribunal, the Board may, nonetheless, exercise the authority to deny institution”); *Mylan Laboratories Ltd. v. Janssen Pharmaceuticals N.V.*, IPR2020-00440, Paper 17 at 12 (PTAB Jan. 14, 2021) (denying institution under *Fintiv* in light of an upcoming district court trial notwithstanding that the petitioner was *not* the defendant in that trial), *aff’d*, 989 F.3d 1375, 1378 (Fed. Cir. 2021).

Here, Google LLC is indeed related to, and collaborating with, the Samsung entities in both the district court case and these proceedings. The Samsung Petitioners are the defendants in the upcoming November 3, 2025 district court trial, and Petitioner Google LLC, while not a named party in the district court proceeding, is voluntarily participating on Samsung’s behalf in the district court. Specifically,

in the district court case Google LLC has (i) voluntarily submitted declarations on Samsung's behalf, (ii) produced documents and source code in response to subpoenas, and (iii) is represented by the same outside counsel that represents the Samsung entities. *See* Ex. 1036 at 2-3 (identifying counsel representing the Samsung entities, including, *e.g.*, Messrs. Trac, Snyder, and Liang, and Ms. Simmons, who also represent Google LLC in connection with the district court case); Ex. 2016 (same counsel representing Google LLC in the district court case). The Samsung Petitioners and co-Petitioner Google LLC are thus related, collectively involved in the district court case, and cooperating in the district court case on Samsung's behalf.

Accordingly, Factor 5 weighs in favor of denying institution.

Factor 6: the merits of the Petition are weak. The final factor also weighs in favor of denial because there is no “compelling challenge” of invalidity on the merits of the Petition. *See, e.g.*, Ex. 2007 at 4 (“compelling, meritorious challenges will be allowed to proceed at the PTAB even where district court litigation is proceeding in parallel”). As shown in the prior sections regarding claim construction, and in the following Sections III.B and III.C, Petitioners' arguments on the merits (including Petitioners' failure to address known claim construction disputes) do not meet the “reasonable likelihood” standard, much less the high standard required for an invalidity challenge when factors weigh in favor of the Board discretionarily

denying institution. *Id.* (“Compelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.”); *see also Vector Flow, Inc. v. HID Glob. Corp.*, IPR2023-00353, Paper 8 at 23-24 (PTAB July 27, 2023) (same).

Here, the Petition (i) strategically chose not to address known disputes over the claim terms’ meaning and (ii) misreads both the claims and the cited references, which demonstrates the weakness of the Petition and favors denying institution. *See e.g., supra* at Sections II.B.1, II.B.2, and II.B.3; *infra* at Sections III.B and III.C; *see also e.g., Samsung Electronics Co, Ltd. v. California Institute of Technology*, IPR2023-00130, Paper 10 at 26 (May 4, 2023) (exercising discretion to deny institution because “[f]or essentially the reasons posed by Patent Owner, we agree that Petitioner’s showing is less than compelling, as it rests tenuously upon apparent logical leaps”); *Samsung Display Co., Ltd. v. Pictiva Displays Int’l Ltd.*, IPR2024-00855, Paper 12 at 13 (November 19, 2024) (exercising discretion to deny institution because “Petitioner’s challenges do not meet the compelling merits standard because a genuinely-disputed issue surrounds the correct [claim] construction That genuine dispute, in turn, casts doubt upon whether Petitioner ‘is highly likely’ to prevail in showing that the [claim] limitation would have been obvious over the asserted prior art references”); Ex. 2007 at 4-5 (stating that the “compelling” merits

standard is a higher standard and “[w]here the information presented at the institution stage is merely sufficient to meet the statutory institution threshold, the PTAB has the authority ... to exercise discretion to deny institution in view of the other *Fintiv* factors”).

Accordingly, this factor, like all other factors, favors denial of institution.

1. The Director Recently Clarified In Court Filings That The Board Retains Discretion To Deny Institution Even When A Purported “Sotera” Stipulation Is Filed; Otherwise The Factors Would Violate Statute And Be Unconstitutional

Petitioners’ planned stipulation does not change that the Board should deny institution. The former Director recently clarified in district court and Federal Circuit filings that the Board *retains* discretion to deny institution even when petitioner files a so-called *Sotera* stipulation; otherwise, the Director’s factors would violate statute and be unconstitutional. Particularly, the Director’s district court brief stated that “[i]n June 2002, the Director issued a guidance memorandum revising the *Fintiv* analysis.... In this Memorandum, the Director ... directed that ... the Board *should not* discretionarily deny institution under *Fintiv* when a petitioner stipulates not to pursue, in a parallel district court proceeding, the same grounds as in the petition or any grounds that could reasonably have been raised in the petition.” Ex. 2017 at 6 (emphasis added). This clarified the June 2002 Memorandum issued more than a year prior, which stated that the PTAB “*will not* discretionarily deny

institution” when such a stipulation is entered. Ex. 2007 at 3 (emphasis added). The

Director further clarified that:

[T]he *Fintiv* factors are only a ‘general statement of agency policy’ that binds neither the Board nor actors beyond the agency ...

Ex. 2017 at 8.

[T]he *Fintiv* factors do not compel a specific outcome on institution *even within the agency*.

Id. at 12 (emphasis in original).

[T]he *Fintiv* factors do not establish a ‘binding norm’ because they do not replace the Board’s exercise of the Director’s delegated discretion. Rather, they merely guide the Board’s decision-making process in determining whether to institute and IPR on the Director’s behalf in any instance, without dictating any particular outcome.

Id. at 15.

[T]he *Fintiv* factors ... do not offer a plain, formulaic answer to the question of whether to institute IPR.... [T]he Board may consider any ‘[o]ther facts and circumstances’ it deems relevant ... with ‘a holistic view of whether [the] efficiency and integrity of the system are best served by denying or instituting review.... This flexibility, and the opportunity for the Board to make individual institution decisions, demonstrates that the *Fintiv* factors amount to only a general statement of policy guiding exercise of the Director’s delegated discretion, not a substantive rule.

Id. at 16.

A requirement that the Board ‘must consider’ the factors is not the same as a requirement that the Board ‘must obey’ the factors. It is true that the designation of the decisions as precedential means the Board ‘must consider’ the factors. It is not true that this means the factors *per se* dictate the outcome. The only requirement is consideration, after which the Board may choose to—or not to—institute IPR.

Id. at 17.

The Director also made the same clarifying statements to the Federal Circuit:

[The *Fintiv* factors] have no binding effect on the Director, and they do not require the Board to reach a particular result or otherwise foreclose the Board’s ability to exercise genuine discretion and make individualized determinations.

Ex. 2018 at 15.

Upon consideration of those factors, which leave the Board ample discretion to determine how the factors should be balanced in individual cases, the Board remains free to use that delegated discretion to either grant or deny a statutorily sufficient IPR petition after a ‘balanced assessment of all relevant circumstances of the case, including the merits.’

Id. at 22.

[T]he *Fintiv* factors do not dictate outcomes; they leave the Board with broad discretion to determine whether institution is warranted in a given case and leave the Director free to reverse any decision.

Id. at 29.

Moreover, relying on the Director’s statements, the district court held that because the Board always retains discretion to deny institution (even when, for example, petitioner files a *Sotera* stipulation) the Director’s *Fintiv* guidance does not violate the Administrative Procedure Act:

Plaintiffs ... alleg[e] three violations of the Administrative Procedure Act (“APA”), 5 U.S.C. § 701 *et seq.*

...

Based on the parties' written and oral arguments, the Court finds that the *NHK-Fintiv* standard was not a substantive rule requiring notice-and-comment rulemaking.

Ex. 2019 at Appx1-2.

[T]he express language of *Fintiv*, as well as the June 2022 Memo and other guidance from the Director, make clear that the Board undertakes a holistic analysis when determining whether to exercise its discretion in denying or instituting IPR.

Id. at Appx22.

This, too, is what the former Acting Director recently held when *sua sponte* clarifying via Director Review that the Board makes a “holistic determination ... with regard to discretionary denial” based on “the totality of the Board’s weighing of the *Fintiv* favors ... to exercise its discretion to deny institution under § 314(a).” *Samsung Display Co., Ltd. v. Pictiva Displays Int’l Ltd.*, IPR2024-00855, Paper 13 at 8 (Jan. 10, 2025) (Ex. 2020).

Accordingly, even when petitioner files a purported “*Sotera*” stipulation, it is **not** dispositive of whether the Board should deny institution under *Fintiv*. Rather, the Director and district court have clarified that the Board should consider any such stipulation as just one non-dispositive factor in connection with all other circumstances of the case, just like the Board has done previously. *See e.g., Cisco Systems, Inc. v. Estech Systems, Inc.*, IPR2021-00333, Paper No. 12, at 12-13 (PTAB July 7, 2021) (denying institution under *Fintiv* based on holistic analysis of all factors **even when** petitioner filed a *Sotera* stipulation because the Board was “not

persuaded ... the stipulations proffered here are sufficient when weighed against the other factors”).

2. The Director’s Request For Public Comment Likewise Elicited Strong Support For Treating A *Sotera* Stipulation As A Non-Dispositive Factor On A Case-By-Case Basis

That the Director clarified that a *Sotera* stipulation is but one non-dispositive factor is not surprising. After the former Director issued the 2002 Guidance Memorandum (Ex. 2007), the Director requested, and received, many public comments strongly urging the Director to clarify that the Board retains discretion to perform a “holistic” analysis considering the facts of each case on a case-by-case basis, including clarifying that even a *Sotera* stipulation is merely one non-dispositive factor to consider under *Fintiv*:

In our view, the existing *Fintiv* precedential decision already provides the basis for this clear and predictable rule that permits the discretionary denial of IPR or PGR petitions where the same patent is subject to co-pending district court or ITC litigation. The *Fintiv* framework has survived multiple legal challenges and is well understood by the PTAB and stakeholders. While we strongly support the inclusion of a mandatory *Sotera* stipulation in all IPR and PGR petitions, ***we do not see why it should provide a “safe harbor” for petitioners as a mechanism to avoid discretionary denial.*** The [Director’s Advanced Notice of Proposed Rulemaking] ANPRM seems to recognize this as well and proposes that a mandatory *Sotera stipulation could be “a necessary but not sufficient basis for institution.”* We agree with this approach.

...

One primary reason is that the USPTO has limited ability to enforce a Sotera stipulation in parallel proceedings, and many courts have already demonstrated that they will not enforce them consistently.

Ex. 2021 (Centripetal) at 6-7 (emphases added).

I support ‘making a Sotera stipulation a necessary but not sufficient basis for institution.’ [T]o survive a challenge under *Fintiv*, the Petitioner would necessarily need to file a *Sotera* stipulation. *The Petitioner would still need to meet the other criteria for institution in view of a parallel litigation.*

Ex. 2022 (Stanwood (“an inventor and US citizen with 161 issued US patents”)) at

¶16 (emphases added).

PhRMA supports in principle the potential proposal to make “***a Sotera stipulation a necessary but not sufficient basis for institution.***”

...

PhRMA recommends against the Office proposing the potential stipulation requirement as an exception to discretionary denials, which could permit institution in situations presenting concerns unrelated to multiple challenges, such as parallel proceedings or considerations under § 325(d). In other words, and consistent with the comments above regarding *Sotera* stipulations, *this potential stipulation should be a necessary but not sufficient basis to avoid discretionary denial.*

Ex. 2023 (Pharmaceutical Research and Manufacturers of America (PhRMA))

at 10, 12 (emphases added).

A Sotera type stipulation by itself is not a sufficient basis for allowing an IPR that duplicates district court proceedings to move forward. The patent owner has no ability to enforce such a stipulation in district court, and at least some courts are likely to allow an accused infringer to argue its way out of one.

...

In short, we think that a Sotera stipulation should not be used to replace a proper *Fintiv* analysis or even be treated as part of one.

Ex. 2024 (Alliance of U.S. Startups and Inventors for Jobs (“USIJ”)) at 16-17.

AIPLA generally agrees that stipulations by petitioners not to pursue in a parallel district court action grounds that were raised or reasonably could have been raised in a petition (a *Sotera* stipulation) mitigate concerns about pursuing overlapping issues in multiple fora. However, ***such stipulations as a safe harbor should not be absolute.***

Ex. 2025 (American Intellectual Property Law Association (“AIPLA”)) at 13.

Accordingly, this too confirms that the Board retains discretion to deny institution under *Fintiv* based on a holistic analysis of all factors on a case-by-case basis even when petitioner files a *Sotera* stipulation.

3. The Specific Facts Here Show That Petitioners’ Purported Stipulation (i) Is Insufficient In View Of The Other Factors That Weigh Heavily Against Institution And (ii) Would Still Leave The Parties Litigating The Same Validity Issues In Both Forums

Here, any stipulation does not overcome the strong evidence that institution should be denied under *Fintiv*, or the Director’s inherent discretion, as addressed above. *See supra* § III.A. That is, given the specific facts here, institution should be denied in favor of allowing the parties to resolve all validity disputes in the single district court proceeding that has advanced significantly and will be tried very soon in early November 2025. *Id.* Petitioners’ withholding of their stipulation instead of filing same with its Petition was also gamesmanship, prejudicial to Patent Owner, and inconsistent with the mandate of 37 C.F.R. § 42.1(b) to “secure the just, speedy, and inexpensive resolution of every proceeding.”

Moreover, as the courts have recognized when considering the language of Petitioners' stipulation, such language is insufficient to avoid duplicative litigation and given the facts here would still leave the parties in the wasteful, and prejudicial to Patent Owner, position of litigating common validity issues in both forums. Again, this should not be taken lightly, especially here where Petitioners Samsung and Google, major technology companies, have sought to multiply the proceedings against an inventor-owned Patent Owner, whose sole member Mr. Mullen is the inventor of all involved patents.

Specifically, as was expressly noted in the public comments discussed *supra* at § III.A.2, and to the prejudice of Patent Owner, courts have difficulty determining what grounds are within, or outside, the scope of any stipulation and inconsistently apply such language, which harms Patent Owner because it invariably leads to Patent Owner having to litigate the same or similar validity issues in both forums while petitioners obtain the benefit of two related, overlapping bites at the invalidity apple. *See e.g., Prolitec Inc. v. ScentAir Techs., LLC*, No. 20-984-WCB, 2023 WL 8697973, at *22 (D. Del. Dec. 13, 2023) (identifying “*a split among district courts*” as to “the meaning of ... ‘any ground that the petitioner raised or reasonably could have raised during that inter partes review.’”) (emphases added). This prejudice to Patent Owner is particularly acute where, here, the Petitioners are asserting “device art” in district court. *Id.*

First, in the parallel district court proceeding, Petitioners are relying on purported “device art” that is cumulative of and materially identical to patents or printed publications that could have been raised in this IPR. *See e.g.*, Ex. 2014 at 116-119 (identifying printed publications that describe each item of alleged “device art” or “prior art system”). Prejudicially, this will lead to the situation where Patent Owner must litigate the same validity issues in both forums because in district court “IPR estoppel does **not** apply to device art, **even when** that device art is cumulative of patents and printed publications that were or could have been asserted in a prior IPR.” *Prolitec Inc. v. ScentAir Techs., LLC*, 2023 WL 8697973, at *22 (emphases added).

Second, even worse, Petitioners’ invalidity contentions in the district court include many invalidity grounds **combining** the “device art” or “system prior art” with the **same** references in this IPR. *See e.g.*, Ex. 2014 at 121 (identifying “Primary References” including “Benefon Esc!” and “CellPoint Finder!”); *e.g.*, *id.* at 122 (combining such device art with the same Sheha and Randall references in this IPR). Samsung’s purported stipulation indeed expressly states that “[t]his stipulation is not intended, and should not be construed, to limit Samsung’s ability to assert invalidity ... on any other [102/103] ground.” The Board should deny institution to prevent this prejudicial and wasteful duplication in the parallel litigation. *E.g.*, *Prolitec Inc. v. ScentAir Techs., LLC*, 2023 WL 8697973, at *22.

Accordingly, even if Petitioners file their purported stipulation, the Board should deny institution under *Fintiv* or the Director's inherent authority.

B. Grounds 1-9 Of The Petition Fail To Establish Obviousness Of The Limitation “A Permission Is Operable Of Being Provided By Said First Wireless Device For Said Second Wireless Device To Access Location Information About Said Location” In Claim 1 And Similar Limitations In Claims 18 And 19

The Board should decline to institute Grounds 1-9 because the cited references fail to teach or suggest these claim limitations.

The Petition's arguments with regard to these claim limitations are based on Petitioners' fundamental misreading of the claim language, discussed *supra* at Sections II.B.1, II.B.2, and II.B.3. In particular, properly construed, these claim limitations require the claimed permission to be provided both (i) by the specific wireless device recited in each claim (*i.e.*, the same wireless device recited in the claim that has its location determined) and (ii) for the specific device recited in the claim. *Id.*

For its part, Petitioners in effect erroneously seek to rewrite this term in Claim 1 to read: “~~a permission is operable of being provided by said first wireless device for~~ a policy that may result in allowing said second wireless device to access location information about said location.” *Id.* Then, and only then on the basis of Petitioners' improper rewriting of the language of Claim 1, and similar

impermissible rewriting of the claim language of Claims 18 and 19, Petitioners incorrectly argue that Sheha or Randall teaches or suggests these claim limitations.

For the alleged Grounds, the Petition makes two critical errors.

First, the Petition repeatedly ignores (by ascribing no meaning to and failing to substantively address in the Petition) the portion of this term that expressly requires the “permission” to be “provided **by**” the specific device recited in the claim (e.g., in Claim 1, the *same* “first wireless device” recited in the claim that is operable to have its location determined). This is a significant omission, including because, as discussed *supra* at Sections II.B.1, II.B.2, and II.B.3, this feature indeed advantageously enhances system security by requiring the same device that has its location determined to provide the permission to access that device’s location information. Ex. 1001, 1:44-54 (“One object of the present invention is to provide a *security feature* which allows a user to limit and/or deny location access to a particular user. ... In this manner, *a cell phone user may give access, through his or her cell phone*, to a friend so that the friend can locate him or her”) (emphases added).

Second, the Petition repeatedly points to group policies that purportedly give access to location information to a group. However, as discussed *supra* at Sections II.B.1, II.B.2, and II.B.3, a group policy is not “a *permission ... for*” a specific device to access location information as recited in the claims, and this distinction is

important because it creates a security risk of erroneously allowing or disallowing access to location information. *Id.* Again, Petitioners' error is significant because the claimed requirement of providing "a permission ... for" a specified device eliminates this security risk and advantageously improves system security. Ex. 1001, 1:44-46 ("One object of the present invention is to provide a security feature which allows a user to limit and/or deny location access to a particular user.").

Turning to Petitioners' arguments, for Grounds 1-4 Petitioners rely on Sheha as allegedly teaching or suggesting these claim limitations. Pet., 10-15, 23, 25.

For Grounds 5-9, Petitioners rely on Randall as allegedly teaching or suggesting these claim limitations. Pet., 48-49, 58, 60.

First addressing Sheha (Grounds 1-4), the Petition vaguely and inadequately alleges that "*the Sheha system* can determine the target mobile device's privacy settings." Pet., 10 (citing Sheha, 5:3-20, 5:21-46, 4:59-66, 10:17-26) (emphases added). This does not disclose or suggest the claimed features that the same device that has its location determined is operable to provide a permission for another specific device to access that device's location information. Indeed, Sheha does not disclose or suggest these claim limitations nor the corresponding security advantages that the '418 Patent discloses these features provide. In addition, as described below, the portions of Sheha that the Petition relies on are irrelevant for additional reasons.

Sheha refers to a mobile device that stores privacy settings or filters that limit or restrict when the mobile device sends out position information, including “while receiving and/or sending calls,” “for an instance” or “for a given period of time”:

- In one embodiment, if a mobile device user specifies a telephone number of another position-enabled mobile device, the system would query the remote mobile device and verify its *privacy setting*. Ex. 1005, 4:62-66 (emphases added).
- In another embodiment, each device has *privacy settings* that allow the device to prevent or limit other calling devices from obtaining position information. *Id.*, 5:37-41 (emphases added).
- The mobile device location information can be provided only, due to *privacy settings*, if the user configured the mobile device 18a to allow position information to while calls are received. In another embodiment, the *privacy configuration* also includes settings such as the option to never send position information, or to send position information *while receiving and/or sending calls*, and whether the transfer of position information should be allowed only *for an instance or for a given period of time*. This provides the user the opt-in capability for position information transfer. *Id.*, 10:17-26 (emphases added).

Sending or receiving position information in Sheha is thus contingent *not* upon what access rights a mobile device has provided for another device but instead upon what privacy filters the mobile device has implemented for all incoming location requests. *Id.* The very nature of these filters in Sheha indeed make them indiscriminate as to the identity of any requesting mobile device. *Id.* The privacy

settings are *not* “a permission,” are *not* “provided by” the mobile device, and are *not* “for” another specified device as recited in Claims 1, 18, and 19. *Id.* Every disclosure in Sheha is consistent in this regard. *E.g.*, Ex. 1005, 4:35-42, 5:3-20, 5:21-46, 10:44-50, 11:3-9, 12:1-4. In addition, Sheha’s privacy settings reside on a mobile device itself, and thus are fundamentally different than the ’418 Patent’s claimed invention for the additional reason that they are not “stored” in a “remote system” or “server” as required by Claims 1, 18, and 19.

Here, Petitioners retained the *same* declarant that was retained by the prior petitioner in IPR proceedings involving the ’418 Patent before such prior proceedings were terminated due to settlement. And, notwithstanding Petitioners’ present arguments and transparent attempt to change their declarant’s prior testimony, Petitioners’ declarant *did* concede at his deposition in the prior proceedings that the privacy settings on Sheha’s mobile device are *not* for a specified device and instead are general settings that apply to any location request that is received:

Q. Oh, Okay. So let me see if I’m understanding what you just said. Are you saying that there’s a privacy setting with respect to a specific individual?

A. ***Sheha doesn’t discuss that level of privacy, I don’t believe. I think it’s more at the group level.***

Ex. 2015, 17:6-12 (emphases added).

Q. And this relates to assigning location access rights limitation of claim one. In that first sentence, you say: “Sheha allows user to establish which other users and devices may access their location information.” Correct?

A. Correct.

Q. This is not on an individual basis; correct?

....

A. *If I understand your question, I think that’s accurate. The privacy settings, as well as the group database settings, are not individual by individual*

Id., 114:12-25 (emphases added).

Separate and apart from Sheha’s privacy settings, Petitioners also rely on Sheha’s reference to a “group database” and that “users can define a group of specific users.” Pet., 10 (citing Sheha, 11:55-12:7). However, Sheha’s disclosures regarding “groups” is irrelevant for two reasons. *First*, Sheha only refers to the use of “groups” in the context of “landline-to-landline” requests (not mobile-to-mobile requests), whereas instead Claims 1, 18, and 19 of the ’418 Patent expressly refer to wireless devices:

A mobile or landline device can also request position information of another mobile or landline device by only specifying a telephone number, without having to initiate a telephone call. *For a landline-to-landline position request*, the specified telephone number is correlated to its position information using telephone information from a known database or sets of databases. In one embodiment, the online database that contains this information only includes users that do not have unlisted telephone numbers. In another embodiment, *users can define a*

group of specific users that have access to this information. This is also accomplished by utilizing a group database and authorization and authentication protocols to identify users that are permitted to access this information. When a mobile device's position information is requested, the system, based on privacy settings, responds with the appropriate position information to the requesting user's device. In another embodiment, using the authorization and authentication protocols a user can request the position of a mobile device, similarly to requesting the position of a landline device.

Sheha, 11:55-12:7 (emphasis added). *Second*, as discussed *supra* at Sections II.B1, II.B.2, and II.B.3, a group policy is not “a ***permission ... for***” a specific device to access location information as recited in the claims. This distinction is indeed immensely important. The '418 Patent's claimed invention of a mobile device providing “a permission ... for” another specific device eliminates security risk and advantageously improves system security. *Id.*

The Board should also reject Petitioners' hindsight attempt to reinterpret Sheha as teaching or suggesting something more. Pet. 12, 15 (alleging that any differences were “well-known as a beneficial option”). That the security advantages provided by the '418 Patent's claimed inventions are only disclosed by the '418 Patent, and not the cited references, should not be taken lightly. *In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965) (holding that there is an enduring admonition against impermissibly “pick[ing] and choos[ing]” from a reference “only so much ... as will support a given position, to the exclusion of other parts necessary to the full

appreciation of what such reference fairly suggests to” a POSITA); *In re Enhanced Security Research, LLC*, 739 F.3d 1347, 1355 (Fed. Cir. 2014) (holding it impermissible to “stitch together an obviousness finding ... without considering the references as a whole”); *see also e.g., InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014) (concluding that expert “succumbed to hindsight bias in her obviousness analysis” by focusing on what “one of ordinary skill in the art could” allegedly have done instead of what “they would have been motivated to do”).

Turning next to Randall (Grounds 5-9), the Petition likewise falls well short of demonstrating that Randall teaches or suggests these claim limitations. It alleges that “***Randall’s ‘server*** recognis[es] Bob’s device and determine[es] the database access rights which Alice has given him.” Pet., 48 (citing Randall, ¶ [0067]). However, Randall does not disclose or suggest the ’418 Patent’s claimed features that the same device that is operable to have its location determined is operable to provide a permission for another specific device to access the location information, nor does Randall disclose or suggest the corresponding the security advantages that the ’418 Patent teaches these features provide.

Randall refers to a remote database that can store information regarding multiple individuals and can also “define which entities can read different fields” in the database. Randall, ¶ [0047]. However, the Petition, and Randall, are completely

silent has to how those “defin[itions of] which entities can read different fields” are established. Randall does not teach or suggest that such definitions are “provided by” the same mobile device that is operable to have its location determined, which is a distinct security advantage disclosed and claimed by the ’418 Patent. *See supra* at Sections II.B.1, II.B.2, and II.B.3; Ex. 1001, 1:44-54 (“One object of the present invention is to provide a *security feature* which allows a user to limit and/or deny location access to a particular user. ... In this manner, *a cell phone user may give access, through his or her cell phone*, to a friend so that the friend can locate him or her”) (emphases added). This alone is fatal to all of Petitioners’ Grounds involving Randall.

Randall also does not teach or suggest providing a “permission ... for” another device to access location information as claimed in Claims 1, 18, and 19. The Petition acknowledges that Randall’s system assigns access rights to groups, called “i-Groups.” Pet., 48. This is so even when the group is intended, at least initially, to have only one individual member. *Id.*, 49 (citing Randall’s “i-Group” for “partner” and arguing that “*if* Alice assigns Bob to the ‘partner’ i-Group ... *and* Alice has only one partner, then Alice is assigning location access rights only to Bob (and his device).”) (emphases added). But as discussed *supra* at Sections II.B.1, II.B.2, and II.B.3, granting access rights to a group does not teach or suggest providing a “permission ... for” a wireless device as claimed in Claims 1, 18, and

19. A group may be an empty set, and even if at one point in time the group has only one individual member (like Petitioners argue), the group's members may change over time such that the policy is not "for" any device but rather generic to a group, however such group is defined and however that definition may change over time. Accordingly, reliance on a group policy for the grant of access rights does not disclose or suggest, and is very different than, what is claimed by the '418 Patent and imposes risk of erroneously allowing or disallowing access to location information. *Id.*; *Cf.* Ex. 1001, 1:44-46 ("One object of the present invention is to provide ***a security feature which allows a user to limit and/or deny location access to a particular user.***") (emphases added). This, too, is fatal to all of Petitioners' Grounds based on Randall.

Petitioners' fundamental misreading of these claim limitations, and corresponding erroneous mapping of these claim limitations to the cited references, demonstrates that the Petition fails to demonstrate invalidity of this claim limitation, let alone a "compelling case" of purported invalidity.

Accordingly, the Board should find that the Petition has failed to demonstrate invalidity of these claim limitations under the "reasonable likelihood" standard, much less a "compelling case" of purported invalidity, and thus should decline to institute Grounds 1-9. *See e.g., Samsung Electronics Co, Ltd. v. California Institute of Technology*, IPR2023-00130, Paper 10 at 26 (May 4, 2023) (exercising discretion

to deny institution because “we agree that Petitioner’s showing is less than compelling, as it rests tenuously upon apparent logical leaps”); *Samsung Display Co., Ltd. v. Pictiva Displays Int’l Ltd.*, IPR2024-00855, Paper 12 at 13 (Nov. 19, 2024) (exercising discretion to deny institution because “Petitioner’s challenges do not meet the compelling merits standard because a genuinely-disputed issue surrounds the correct [claim] construction That genuine dispute, in turn, casts doubt upon whether Petitioner ‘is highly likely’ to prevail in showing that the [claim] limitation would have been obvious over the asserted prior art references”); *AT&T Services, Inc. v. ASUS Technology Licensing Inc.*, IPR2024-01142, Paper 14 (Jan. 27, 2025) (exercising discretion to deny institution because “Patent Owner has identified a plausible understanding of the meaning of the claims ... and potential dispositive inadequacies in Petitioner’s approach to accounting for features of those claims Petitioner’s proposed grounds cannot be said to rise to the level of a ‘compelling’ meritorious challenge”).

C. Grounds 1-4 Of The Petition Fail To Establish Obviousness Of The Limitation “Providing A First Map Provided With Respect To Said Location” In Claim 1 And Similar Limitations In Claims 18 And 19

The Board should decline to institute Grounds 1-4 for the following additional independent reasons.

The Petition relies on Figure 5 of Sheha for the following claim limitations:

- “said first wireless device is operable of providing a first map provided with respect to said location” (Ex. 1001, Claim 1(f), 13:34-36) (emphases added);
 - “said first wireless device is operable of providing a first map from a perspective of said first wireless device” (*id.*, Claim 18(k), 14:53-55) (emphases added);
 - “said first wireless device is operable of providing a first map from a perspective of said first location” (*id.*, Claim 19(m), 15:23-25) (emphases added).
- See* Pet., 18, 23, 25.

Sheha, however, does not disclose or suggest a **wireless device** providing the map of Figure 5. Sheha instead explains that “FIG. 5 illustrates an example of a Map Caller-ID indicator and a display window” for a **landline-to-landline** embodiment that requires a peripheral display device capable of displaying, decoding, and processing position information:

[A]n advanced telephone 8 and 55 can establish a call with a standard telephone 5 and 54. Both telephones are typically connected to a telephone network 2 by means of a dedicated landline connection 9 a and 9 b. Since **a typical standard telephone device 5 and 54 is incapable of displaying position information or decoding and processing the data** from the telephone network 2, an accompany device can be used to facilitate such requirements, such as, for example, **a personal computer (PC) 23 a or Smart Television (TV) 23 b**

In this embodiment, the destination telephone 5 is not an advanced telephone 55 capable of decoding and displaying

the Map Caller-ID information sent by the telephone network 2 over the dedicated landline connection 9 a as previously described. Therefore, ***in order for the destination telephone 5 to have access to the Map Caller-ID information, it must be sent to an accompanying device 6, such as a PC 23 a or Smart TV 23 b, that is capable of displaying and processing the Map Caller-ID information.***

Ex. 1005, Sheha, 7:58-67, 8:6-15 (emphases added). This is the only Sheha embodiment referencing Figure 5.

The Petition's truncated and selective quotation of Sheha's disclosure as allegedly stating that "both the originating and destination mobile device receive the Map" is incorrect and misleading. Pet., 18 (purporting to cite Sheha, 11:42-44). That is not what Sheha says. Sheha, in fact, states that the mobile devices may receive so-called "Map Caller-ID information," which is not, and is different than, a graphical map. Sheha, 11:42-44 (emphasis added). Sheha does ***not*** teach or suggest that a mobile device receives or displays a graphical map of the Map Caller-ID information, much less provide a display like the one illustrated in Figure 5. Ex. 1005, 3:14-17 (describing providing "an alternative form of Caller-ID (Map Caller-ID) to a local computing telephone device for display"), 10:27-30 ("[T]he mobile device Map Caller-ID notification is sent to the mobile device as a conventional Caller-ID message [and] additional information is added to the original message."), 10:37-39 ("[T]he Map Caller-ID information sent to the mobile device contains the

originating position and user identification information”), 11:42-44 (mobile devices receiving “Map Caller-ID information”) (emphasis added). These statements are consistent with Sheha’s indication that displaying, decoding, and processing position information is performed, if at all, by an accompanying device, such as a personal computer, television, or navigational device—not a wireless telephone device.

Sheha in fact explains that the Map Caller-ID information in mobile device embodiments can be passed to a “navigational device . . . better suited for navigational displays and computations”:

Using a mobile device 18d, as illustrated in FIG. 6, it is possible to obtain the unit's local position and a destination 10 position for the purpose of navigation. However, a *typical mobile navigational device 18d*, such as a cellular phone or wireless PDA, *does not possess all of the capabilities or is not optimal for navigational purposes. An accompanying device 37*, such as an in-vehicle navigational device usually 15 installed in a motor vehicle 39a, *is better suited for navigational displays and computations.*

Id., 12:8-16 (emphases added). That the mobile device embodiments require separate navigational devices for displaying maps is not surprising, as mobile device manufacturers, including the Samsung Petitioners, did not offer map displays in the manner claimed on their mobile devices until years after Sheha.

Sheha also makes clear, and the Petition ignores, that as its name suggests Sheha’s Map *Caller-ID* technology requires a telephone call to obtain location or

position information. Indeed, all of Sheha's Map Caller-ID disclosures involve a phone call, and there is not a single disclosure involving the display of so-called Map Caller-ID information that does not require a telephone call. *E.g.*, Ex. 1005, Sheha, 7:27-8:24, 9:4-39, 10:27-65, 11:36-54. Accordingly, this renders Sheha's Map-Caller ID system irrelevant, and demonstrates that it does not teach or suggest the claim limitations, for an additional reason. Because Sheha's "location" or position information associated with Sheha's Map-Caller ID technology is always obtained in connection with a telephone call, Sheha does not teach or suggest "a first map provided with respect to said location" for the additional reason that Claims 1 and 19 specify that "said location" must be "requested ... *outside of* a call for communication." Ex. 1001, 13:21-24, 13:35-36, 14:64-67, 15:24-25.

Finally, the Petition relies on Sheha's reference to displaying "a map and address of the destination telephone number on the mobile telephone." Pet., 18 (citing Sheha, 4:52-58). However, this statement in Sheha does not mention, and is entirely unrelated to, Sheha's Figure 5. Nor does this statement in Sheha disclose or suggest a "map provided with respect to said location" of a wireless device (i.e., the same wireless device that is operable to have its location determined) as claimed in Claim 1 of the '418 Patent, a "map from a perspective of said first wireless device" as claimed in Claim 18, or a "map from a perspective of said first location" of said first wireless device as claimed in Claim 19. Rather, Sheha's statement at 4:52-58

instead merely refers to displaying “a map and address of the *destination* ...,” which at best is the display of information relating to a *different* device and *not* to the “first wireless device” recited in the claims. *Id.*

Accordingly, because the Petition fundamentally errs in its application of the purported prior art to, and its reading of, these additional claim limitations of Claims 1, 18, and 19 of the '418 Patent, the Board should find that the Petition has failed to demonstrate invalidity of these claim limitations, much less a “compelling case” of purported invalidity, and should decline to institute Grounds 1-4 for at least these additional independent reasons.

IV. CONCLUSION

For any or all of the above-described reasons, Patent Owner respectfully requests that the Board deny institution.

Dated: February 14, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

The undersigned certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE specified in 37 C.F.R. § 42.24 have 13,826 words, in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24(b)(1). This word count was prepared by the word-processing program used to prepare this paper (Microsoft Word).

Dated: February 14, 2025

/Peter F. Snell/

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CERTIFICATE OF SERVICE

I certify that a copy of this PATENT OWNER'S PRELIMINARY RESPONSE is being served by electronic mail on the following counsel of record:

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