

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

Case No. IPR2025-00021
Patent No. 11,096,039

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

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The Director should not take the extraordinary step of vacating the Panel’s well-reasoned institution decision. The *Fintiv* factors weigh against discretionary denial. All but one of the patent’s claims will never be addressed in litigation; plus Samsung’s *Sotera* stipulation further reduces overlap. Co-Petitioner Google is not a party to the litigation. And the merits are strong, having twice led to institution.

I. *FINTIV* FACTORS 4 AND 6 WEIGH IN FAVOR OF INSTITUTION

A. Factor 4: No Overlap

The Board was correct—Factor 4 weighs against discretionary denial. Samsung’s *Sotera* stipulation (EX1079) refutes PO’s overlap argument. A *Sotera*-type stipulation “weighs ***strongly in favor of not exercising discretion***...under 35 U.S.C. § 314(a).” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (Dec. 1, 2020) (precedential) (emphasis added). Samsung agreed that it will not raise in district court any art or arguments that it raised or reasonably could have raised in IPR. (And the ’039 patent was never eligible for PGR.) Contrary to PO’s argument, Samsung’s obligation under EDTX P.R. 3-3 and 3-4 to identify all possible prior art months before its Petition to preserve its defenses should not be held against this IPR now. *See Meta Platforms, Inc. v. Eight KHZ, LLC*, IPR2023-01003, Paper 9 at 11-12 (Jan. 9, 2024) (rejecting PO’s argument about the “right to assert overlapping system art in the district court,” because the argument “essentially attacks the reasoning of *Sotera* itself” despite *Sotera* remaining

binding precedent). The only device art still at issue in Samsung’s litigation—BenefonEsc!—*is* “materially different” from the patents/publications in this IPR, contrary to PO’s baseless assertion (Paper 16 at 10). Also, the Federal Circuit’s precedential *Ingenico, Inc. v. IOENGINE, LLC*, No. 23-1367, slip op. at 12 (Fed. Cir. May 7, 2025) made clear that “Congress intentionally limited an IPR’s scope” such that grounds using device art could not reasonably have been raised and are not subject to estoppel. IPRs were always intended to co-exist alongside district-court device-based invalidity grounds, not to supplant them.

Motorola Sols., Inc. v. Stellar, LLC, IPR2024-01205, Paper 19 at 3 (Mar. 28, 2025) is distinguishable. In *Motorola*, there was an 11-month gap between trial and FWD—here it is a 6-month gap. And, critically, this IPR covers all 19 claims of the ’039 patent but ***only one claim*** is currently set to be addressed by the district court. Thus, ***95% of the ’039 patent’s claims will only ever be addressed by the Board***, and there is no potential for overlap on these claims. *See, e.g., Palo Alto Networks, Inc. v. Centripetal Networks, Inc.*, IPR2021-01149, Paper 10 at 10-11 (Feb. 22, 2022) (“Taking into account the stipulation and the number of claims challenged in this proceeding that will not be addressed by the district court, ...this factor weighs against exercising our discretion to deny.”). PO’s stipulation to not assert those claims against Samsung does not resolve the issue because PO has not made the same assurances to Google or to any of Petitioners’ customers.

Thus, the many nonoverlapping claims coupled with Samsung's *Sotera* stipulation ensures this IPR is a "true alternative" forum to address issues that will not, and cannot, be addressed elsewhere. *Id.* Because of statutory estoppel, this is true whether PO or Petitioners ultimately prevail.

B. Factor 6: The Petition's Merits Are Strong

The Board's analysis was correct and entitled to deference—the Petition's "strong merits" weigh against discretionary denial. Paper 14 at 12. Indeed, the claims' unpatentability has already justified institution twice: here and in a prior IPR including "similar, if not identical" grounds. *Id.*, at 11. PO's allegations that Petitioners "strategically chose not to address known disputes over the claim terms' meaning" and "expert admissions from the prior proceedings" (Paper 16 at 14-15) are baseless, as the Board expressly found (Paper 14 at 11). Petitioners addressed all PO's issues raised in Apple's prior IPR (*see* Paper 4 at 22-25 (addressing claim interpretation), 5 (addressing PO's mischaracterization of prior expert testimony)), and the Board "disagree[d] with Patent Owner's proposed construction and with Patent Owner's corresponding arguments." Paper 14 at 11.

II. *FINTIV*FACTORS 1, 3 AND 5 ARE AT MOST NEUTRAL

A. Factor 1: The Board Will Not Speculate on a Stay

The Board's analysis was correct—Factor 1 is neutral. Samsung's motion to stay was denied "without prejudice to refiling...following the PTAB's institution decision on the last of the pending IPRs." EX2008, 3. The Board has consistently

refused to speculate on future-filed stays. And contrary to PO’s assertions, Judge Gilstrap *has* granted such re-filed stay motions post-institution (even when the EDTX trial date is fast approaching) where, as here, all asserted claims of all asserted patents are challenged in the IPRs. *See, e.g., Resonant Sys., Inc. v. Samsung Elecs. Co.*, No. 2:22-CV-00423-JRG, Dkt. 83 (E.D. Tex. Mar. 8, 2024).

B. Factor 3: There Is Significant Work Remaining

As the Board found, Factor 3 is at worst neutral, because “a significant portion of work remains to be done in the district court proceeding.” *Protect Animals With Satellites LLC v. OnPoint Sys., LLC*, IPR2021-01483, Paper 11 at 14-15 (Mar. 4, 2022). The parties have only just completed claim-construction briefing; *Markman* was recently postponed from May 15 to June 17; and expert discovery has only just begun (*after* this IPR was instituted). EX1038. PO’s assertion that “the *same* claim term [is] identified for construction” here and in EDTX (Paper 16 at 8-9) is false—only different terms from the ’039 patent are up for construction in EDTX. Also, if PO opposes a post-institution stay, the Board should weigh inefficiencies against PO, not Petitioners.

C. Factor 5: Google Is Not a Party to the Litigation

The Board was correct—“[b]ecause of the involvement of a non-defendant” (Google), Factor 5 does not weigh toward denial. Paper 14 at 11. Unlike in the cases PO cites (Paper 16 at 12-13), Google is not a party to *any* litigation involving PO’s patents. There is no other pending case where Google may raise its invalidity

challenges. It would be a denial of due process to deny Google access to IPR proceedings, where it is a co-petitioner and accepts the consequences of estoppel.

III. *FINTIV* FACTOR 2 DOES NOT OUTWEIGH THE OTHERS

The Board’s analysis was correct—the factors “as a whole...do not favor... deny[ing] institution,” even if Factor 2 individually weighs toward denial. Paper 14 at 12. PO’s assertion that Factor 2 “should have carried through” the other factors and “resulted in denial” (Paper 16 at 2) is wrong. Factor 2 “is not considered in isolation, but holistically along with other factors.” *Facebook, Inc. v. USC IP P’Ship*, IPR2021-00034, Paper 13 at 11 (Apr. 30, 2021). Indeed, the Board often institutes IPR on similar timing as here, assigning only minimal weight in favor of denial. *See, e.g., Google LLC v. Multimodal Media LLC*, IPR2024-00056, Paper 9 at 8 (Apr. 12, 2024) (FWD six months after trial).

Moreover, the trial date is uncertain. Judge Gilstrap has eight trials set for the same date, which cannot possibly all occur simultaneously. *See BOE Tech. Grp. Co. v. Optronix Scis. LLC*, IPR2024-01131, Paper 15 at 11 (Feb. 12, 2025) (“Because a number of cases are scheduled for jury selection on January 5, 2026..., there is some uncertainty ... we consider this factor to be *neutral or weigh slightly against*” (emphasis added)). Also, a mandamus petition is pending on Samsung’s transfer motion which, if granted, would likely vacate the trial date.

PO’s request should be denied.

/Elisabeth Hunt/ June 2, 2025
Elisabeth Hunt, Reg. No. 67,336

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)

I certify that on June 2, 2025, a copy of the foregoing document, including any exhibits or appendices filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

Peter F. Snell
Brad M. Scheller

PFSnell@mintz.com
BMScheller@mintz.com

Date: June 2, 2025

/Dara Del Rosario/
Dara Del Rosario
Paralegal
WOLF, GREENFIELD & SACKS, P.C.