

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. IPR2025-00197
U.S. Patent No. 11,109,218

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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2002	<i>Samsung SmartThings Find</i> , https://smarththingsfind.samsung.com/login (accessed January 24, 2024)
2003	Acting Director’s Stewart’s March 26, 2025 Memorandum titled “Interim Processes for PTAB Workload Management”
2004	USPTO Memorandum “Guidance on USPTO’s rescission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’” March 24, 2025.
2005	<i>Mullen Industries LLC v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:24-CV-00049-JRG, Order Denying Motion to Transfer, Dkt. 90 (E.D. Tex. Mar. 25, 2025)
2006	Reserved
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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Pursuant to Acting Director's Stewart's March 26, 2025 Memorandum titled "Interim Processes for PTAB Workload Management" (the "2025 Memorandum", EX2003), Patent Owner Mullen Industries LLC ("Patent Owner") respectfully requests that the Director exercise discretion and deny institution of Petitioners Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Google LLC's ("Petitioners") Petition for *inter partes* review IPR2025-00197 ("Petition") of U.S. Patent No. 11,109,218 (the "'218 Patent").

I. INTRODUCTION

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

First, the petition should be denied on *Fintiv* grounds in light of the ***imminent district court trial*** that will begin in the parallel district court litigation on November 3, 2025. The inventor, Mr. Jeffrey D. Mullen, is the sole member of the Plaintiff Mullen Industries LLC in the parallel district court litigation and, contrary to the very principles of the America Invents Act ("AIA"), would be highly prejudiced by Petitioners' request to drastically multiply the proceedings by adding more than 10 IPRs to what is presently a single district court case. Petitioners' attempt to drastically multiply the proceedings is indeed the epitome of waste and inefficiency and should be flatly rejected. 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 has already declined to stay the district court trial and thus will hold trial beginning on November 3, 2025, which is ***eight months before*** any Final Written Decision would issue on this Petition, and well 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 AIA, as it would drastically multiply and complicate the proceedings, rather than simplify matters.

Second, Petitioners’ filing of a purported “*Sotera*” stipulation does ***not*** change that the Board should deny institution. Indeed, the PTAB has clarified that a *Sotera* stipulation is a non-dispositive factor (EX2004, 2-3), and the Director recently and correctly ***declined*** to institute IPR notwithstanding the filing of a *Sotera* stipulation

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.

where, as here, the district court trial is imminent. IPR2024-01205, Paper 19, at 3 (Mar. 28, 2025), Order Granting Director Review, Vacating the Decision Granting Institution and Denying Institution of *Inter Partes* Review (finding that an imminent district court trial date that would precede a final written decision by eleven months “strongly favors discretionary denial”). In addition, as here, the district court would still consider “system” art in combination with patents and/or printed publications in the district court trial. *Id.* at 4 (explaining that a *Sotera* stipulation is “not likely to moot” “invalidity arguments in the district court [when they] are more expansive and include combinations of the prior art asserted in [parallel IPR petitions] with unpublished system prior art[.]”); *see also SAP Am. Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 8-9 (PTAB Apr. 7, 2025) (concluding that “we do not consider the presence of the *Sotera* stipulation in our case to ensure that *inter partes* review would be a ‘true alternative’ to the Litigation” because the petitioner relied on the IPR prior art in support of its district court system prior art invalidity theories). The imminency of the district court trial, and additional factors addressed *infra*, demonstrate in their totality that Petitioners’ submission of a *Sotera* stipulation here cannot overcome the compelling evidence that institution should be denied.

Further, 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.*, EX2017 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 statutes and the Board’s analysis would be unconstitutional. *See id.; also infra* at §III.B.1. 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, Petitioners’ stipulation does not overcome the strong evidence that institution should be denied. As the courts have recognized when considering the language contained in Petitioners’ stipulation, it is also 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. EX2017.

Third, the PTAB has ***already adjudicated*** the validity of the same patented claims of the ’218 Patent challenged in this Petition in IPR2023-000087. The PTAB correctly ***denied institution***, finding “Petitioner has failed to demonstrate[] a reasonable likelihood that it would prevail in establishing the unpatentability of any

of claims 1–19 of the '218 patent.” IPR2023-00087, Paper 10, at 2 (PTAB May 3, 2023). This, too, demonstrates that spending additional resources on a review of these patent claims is a waste of the PTAB’s, and the parties’, resources. Here, Petitioners reassert in their Petition *the same primary prior art reference* that the prior petitioners relied on in IPR2023-000087. And, as discussed *infra*, Petitioners’ incorporation of additional prior art references amounts to no more than a recycling of the same invalidity arguments the PTAB previously rejected.

Finally, there is strong additional evidence that the Petition fails to establish invalidity based on the multiple asserted references for any Ground and that instituting review would be wasteful of PTAB and party resources, including because the Petition resorts to relying excessively on expert testimony in an attempt to cure the plain deficiencies of each 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 1-7, the Petition fails to establish anticipation or obviousness of the “a request from said wireless telephonic device,” and mapping multiple user limitations of independent Claims 1, 6, and 11 (and all corresponding dependent claims), the “travel time” limitations of claims 6, 11, and 16 (and all corresponding dependent claims), and multiple additional limitations unique to claim 16 (and all corresponding dependent claims). '218 Patent, Claims 1, 6, 11, and 16. As explained herein, these claimed features are

indeed Patent Owner's innovative improvements that improve security and are in no way taught or suggested by the cited art.

For each of these independent reasons, institution should be denied.

II. BACKGROUND

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 '218 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 '218 Patent.

Mr. Mullen disclosed in U.S. Application No. 11/841,734, and its corresponding U.S. Provisional Application No. 60/367,967 his innovation of a wireless device that includes sharing information about the wireless device's location with other devices and without requiring a telephone call to do so. These devices provide that a wireless device is operable to have its location determined and itself grant a permission for other wireless devices to access location information about those locations, as well as map the location of multiple users, and provide

corresponding travel times—all of this more than 18 years *before* Samsung released its Samsung SmartThings Find technology containing the same features. EX2001; EX2002.

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 have taken a single district court litigation and sought 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.’” EX2007 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.” EX2007 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) but 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 of the involved patents. Moreover, notably, here the single district court case is considering the exact same references (*even considering* Petitioners’ purported stipulation) in Petitioners’ eleven IPRs, and will also consider 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 March 20, 2020) (precedential).

All six *Fintiv* factors support the 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 and denied transfer, favors denying institution. In addition, by the time the Board will issue an institution decision in this Petition (expected mid-July 2025), claim construction will be decided in the district court case, expert discovery will have closed, and dispositive motion deadlines will be due shortly thereafter. *See* EX1038 (EDTX Scheduling Order). Moreover, fact discovery has been underway for a year and will be closed before an Institution Decision. *Id.* Dispositive motions will be due only a week after the issuance of an Institution Decision. *Id.* (dispositive motions due July 28, 2025, projected Institution Decision issuance on approximately July 21, 2025). 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.

Of paramount significance, the district court trial is also scheduled for November 3, 2025, which is approximately *eight months before* any Final Written Decision would issue in this IPR (estimated by mid-July 2026). *Id.* Still further, Final Written Decisions in Petitioners' other ten IPRs would issue at about the same time. And, as explained below, the district court has already denied one request from the Samsung Petitioners for an IPR stay, 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. Furthermore, the district court recently *denied* Petitioners' motion to transfer, further cementing that the November trial date will stick. EX2005 (Order denying motion to transfer).

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 six 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.*

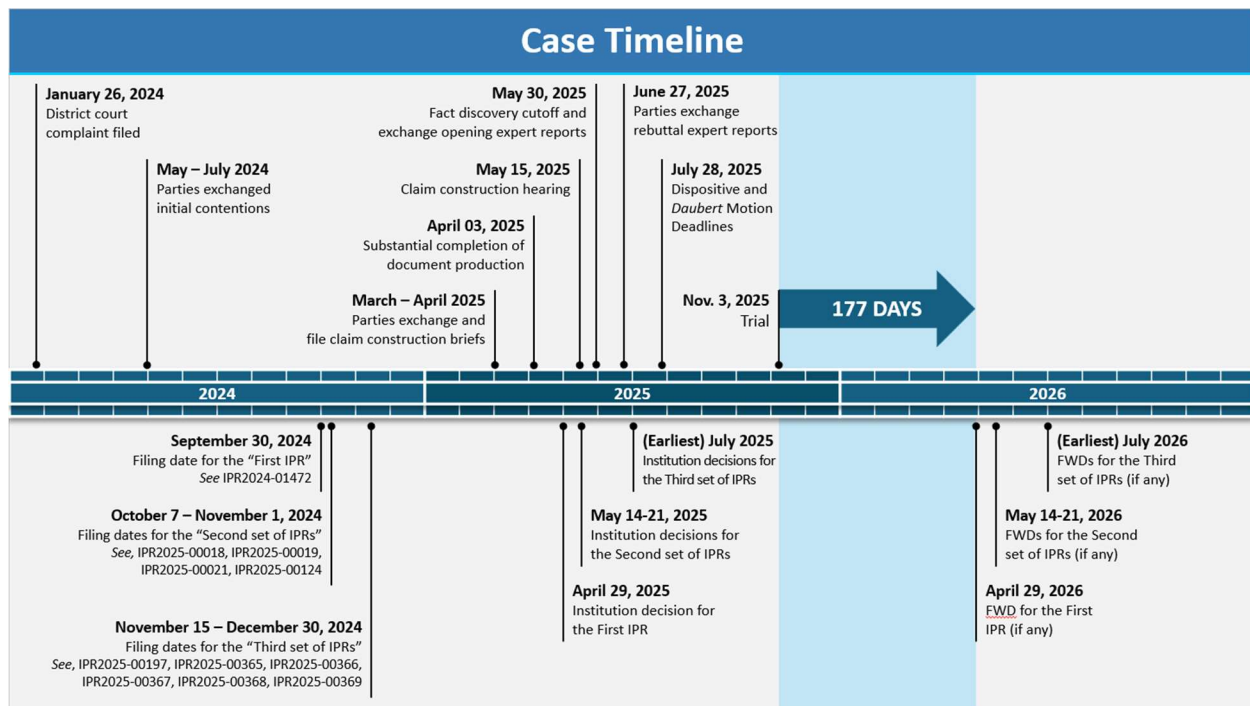
v. *Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017).

1. 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., 84. Petitioners fail to consider the specific evidence that (i) the district court *already denied* Petitioners’ request for a stay in light of IPRs (EX2008) and (ii) the district court’s well-understood practice of denying requests for stays in circumstances directly analogous to the facts presented here, discussed below.

The Board has held that this factor considers “specific evidence” of whether or not 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 of the evidence points to a stay not being entered in the district court litigation pre- or post-institution. Indeed, Judge Gilstrap presides over the underlying district court case in the United States District Court for the Eastern District of Texas (“E.D. Tex.”) and Judge Gilstrap has *already denied Petitioner Samsung’s request for a stay* of the parallel district court case pre-institution of any IPRs. EX2008. In addition, Judge Gilstrap has ordered that Samsung may not refile any request for a district court 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 with regard to 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 as well. Indeed, the Board will not even issue its institution decisions in the last of the pending IPRs until August 2025, *which will be less than three months before the district court trial* will begin in early November 2025. To date, Judge Gilstrap has invariably denied stays under these circumstances: where trial is imminent and final written decisions are not scheduled to issue for many months after the trial date.



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 July 21, 2025. By that time, however, the parties in the underlying district court case will have completed claim construction briefing, attended a claim construction hearing, taken depositions, continued to review source code, produced even more than the already-produced 340,000 pages of documents, and the date for substantial completion of document production will have already taken place. EX1038 at 4. In addition, fact and expert discovery will have closed, and dispositive motions will be due less than a week later on July 28, 2025. *Id.* at 3. Moreover, a Final Written Decision (if any) in this IPR would be received approximately ***eight months after the district court trial*** on November 3, 2025 (“FWD for the Third Set of IPRs (if any)”). As the Samsung Petitioners know, 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”) (EX2009 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) (EX2010 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.”) (EX2011 at 4-5).

Indeed, Judge Gilstrap has granted stays pending IPR under drastically different procedural postures. For example, in *Resonant Systems*, claim construction briefing had just begun, no *Markman* hearing had occurred, only two depositions had taken place, and the parties were still negotiating the scope of substantial email discovery. *Resonant Sys., Inc. v. Samsung Elecs. Co.*, No. 2:22-CV-00423-JRG, Dkt. 83 at *2, 4, 8 (E.D. Tex. Mar. 8, 2024). The stage of the district court case here is entirely different: by the time the final Institution Decision issues, claim construction will be fully briefed, a *Markman* hearing will have occurred, fact discovery and expert will have closed, dispositive motions will be due just one week later, and trial will be set to occur in three and a half months.

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

2. 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). *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9 (Mar. 20, 2020) (“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 eight months before the earliest expected date of a FWD (mid-July 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 date of the FWD supports denying 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 (PTAB 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).

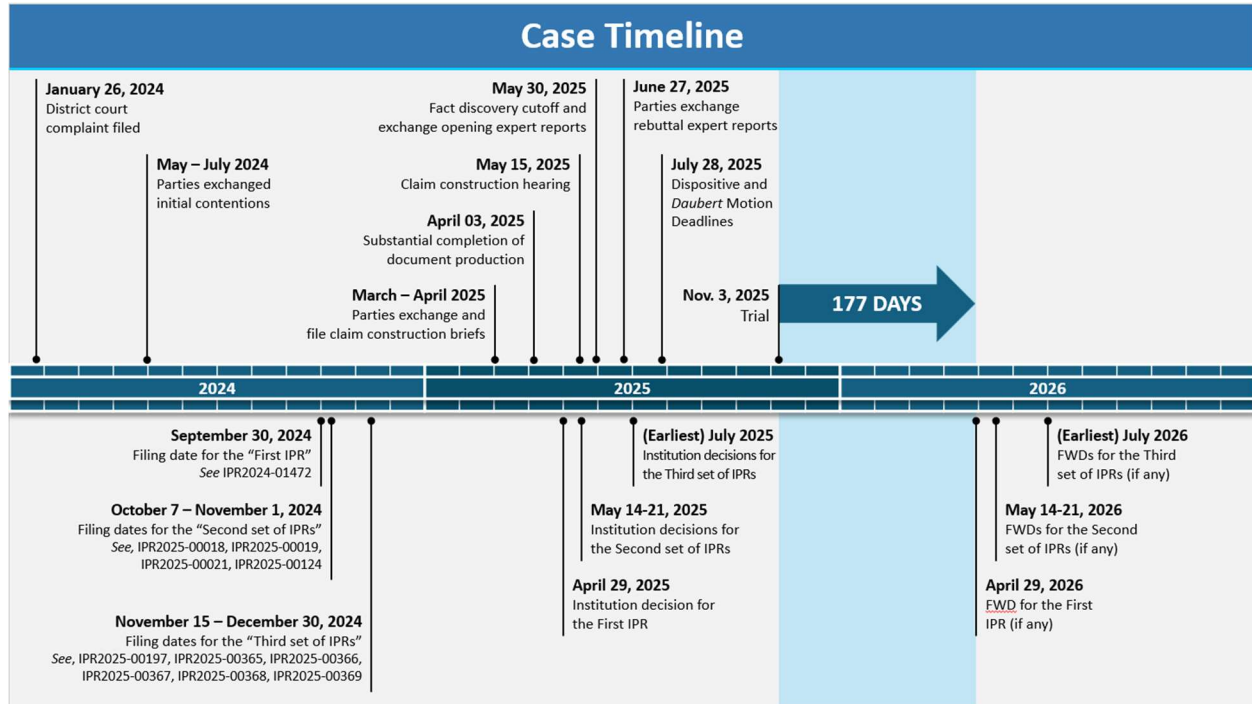
In addition, trial statistics in E.D. Tex. before Judge Gilstrap where the parallel district court case is pending confirm that the November 3, 2025 district court trial date is a firm date that is likely to hold. EX2012 at 2. Indeed, the median time to jury trial in patent cases before Judge Gilstrap is 19.8 months after filing of the original district court complaint. *Id.* This indicates the district court trial for September 2025 (*i.e.*, even before the 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 (PTAB 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”); *TESO LT et al. v. Luminati Networks Ltd.*, IPR2021-00249, Paper 12 at 8-9 (PTAB Jun. 2, 2021) (denying institution despite possibility of “some delay in the trial date due to crowded docket conditions” because “presuming that there would be extensive delay would be conjecture at this time.”).

The credibility of a November 3, 2025 trial date is even stronger in view of Judge Gilstrap recently denying the Samsung Petitioners' motion to transfer to the Northern District of California. EX2005; *see also SAP Am. Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 5-6 (PTAB Apr. 7, 2025) ("Because the trial date is set and the uncertainty in that date has diminished considerably due to the district court's denial of both motions to transfer the Litigation to a different venue, we find that Fintiv Factor 2 weighs in favor of discretionarily denying institution.").

Factor 2 also favors denying institution.

3. 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 will shortly complete claim construction and fact discovery, which has already resulted in document production in the district court litigation of over 340,000 pages from both parties and non-parties.



Petitioners also did not file their Petitions expeditiously, which favors the Board 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 nine months after the district court complaint was filed to submit their Petition in this IPR. EX2013 (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).

This factor weighs heavily in favor of denying institution because the parties have expended, and continue to expend, significant time and resources in relation to the district court case.

4. 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.” *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 12 (Mar. 20, 2020). Here, Petitioners challenge most of the *same* claims in their Petition—and also across their ten other Petitions—that they do in their invalidity contentions at the district court. *See* EX2014 at 2. In fact, Petitioners even rely on the same primary references in the Petition as they do in the parallel district court litigation. *See* EX2014 at 99-100 (citing the same references at issue here, *e.g.*, *Sheha* and *Randall*). This is true *even if* Petitioners’ purported stipulation is entered, as it has a “limited practical effect in reducing the overlapping efforts” in the IPR and the district court litigation. *SAP Am. Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 8 (PTAB Apr. 7, 2025); *see also infra* at §§III.B.1-III.B.3. The Acting Director recently and correctly explained that a *Sotera* stipulation is “not likely to moot” “invalidity arguments in the district court [when they] are more expansive and include combinations of the prior art asserted in [parallel IPR petitions] with unpublished

system prior art[.]” *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 4 (PTAB Mar. 28, 2025)., Order Granting Director Review, Vacating the Decision Granting Institution and Denying Institution of *Inter Partes* Review. Such is the case here, where not only are the same claims, grounds, arguments, and evidence presented in the Petitioner present in the parallel district court litigation, the district court litigation includes *additional* invalidity grounds that rely on the same prior art asserted in the Petition, in combination with system prior art that the Samsung Petitioners will assert in the district court regardless of whether the Board institutes.

Moreover, that the parties to the district court litigation are obligated to drop certain claims to comply with the court’s rules is of no moment here. Should the Board deny institution of this Petition, Patent Owner agrees to not assert again in the future against the Samsung petitioners any claim challenged in this Petition that Patent Owner has dropped in the district court litigation to comply with the court’s rules. In view of this stipulation, instituting review would be inefficient. *Samsung Electronics Co. vs. Mojo Mobility Inc.*, IPR2023-01094, Paper 11 at 12 (PTAB Feb. 9, 2024) (“Patent Owner has stipulated not to assert infringement of any claims challenged in the Petition that have been or will be dropped from the Texas Litigation. [...] This diminishes the significance of the non-overlapping claims. We determine that, as in *Fintiv*, it would be inefficient to proceed.”); *see also SK*

Innovation Co. v. LG Chem, Ltd., IPR2020-01036, Paper 13 at 17 (PTAB Nov. 30, 2020) (“Patent Owner’s stipulation that it will not present for the district court trial any claims challenged in the Petition but not addressed in the ITC’s final determination further minimizes ‘concerns of inefficiency and the possibility of conflicting decisions.’ *Apple, Inc. v. Fintiv, Inc.*, Paper 11 at 11.”).

This factor weighs heavily in favor of denying institution.

5. 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 parallel district court litigation—*i.e.*, Mullen Industries LLC and the Samsung entities. *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020) (“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., 85. This factor is not neutral; rather, it supports denying institution. *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020).

Moreover, the fact that Google LLC is an additional co-Petitioner in these IPR proceedings is of no moment. *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 14 (PTAB Sept. 16, 2021) (“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 Sept. 16, 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 case.*** 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* EX1036 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); EX2016 (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.

6. 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.*, EX2003 at 2 (relevant considerations may include “[t]he strength of the unpatentability challenge”); *SAP Am. Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 10-11 (PTAB Apr. 7, 2025) (“We decline to characterize the merits as sufficiently strong to overcome the other factors”). As shown in §§III.E and III.F, 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. *Vector Flow, Inc. v. HID Glob. Corp.*, IPR2023-00353, Paper 8 at 22-24 (PTAB July 17, 2023) (same).

Here, the Petition (i) recycles invalidity grounds that the PTAB already found did not evidence a reasonable likelihood of success, (ii) strategically chose not to address known disputes over the claim terms’ meaning and (iii) misreads both the claims and the cited references, which demonstrates the weakness of the Petition and favors denying institution. *See e.g., infra* at §§III.E and III.F; *see also e.g., Samsung*

Electronics Co, Ltd. v. California Institute of Technology, IPR2023-00130, Paper 10 at 26 (PTAB 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 (PTAB 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”); EX2007 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”).

Moreover, even if Petitioners’ case were seen as meeting the standard for institution—which it does not—it is not sufficiently strong on the merits to outweigh the evidence in factors 1-5. See *SAP Am. Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 10-11 (PTAB Apr. 7, 2025) (“[W]e determine that the other factors are more persuasive here. Although Petitioner’s challenge is straightforward and

definitely meets the standard for institution, even when balanced against Patent Owner’s counterarguments, we do not find the challenge to be sufficiently strong to outweigh the evidence discussed above in connection with *Fintiv* Factors 1–5.”).

This factor, like all other factors, favors denying institution.

B. The Presence or Absence of a “*Sotera*” Stipulation is of No Moment

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’ 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 2022, 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.” EX2017 at 5-6². This clarified the June 2022 Memorandum issued more than a year prior, which

² All emphases added throughout except where noted otherwise.

stated that the PTAB “*will not* discretionarily deny institution” when such a stipulation is entered. EX2007 at 3. 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 ...

EX2017 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 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.

EX2018 at 15.

[T]he 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 23.

[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.

EX2019 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 (PTAB Jan. 10, 2025) (EX2020).

Further, as explained in the memorandum titled “Guidance on USPTO’s rescission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’”, the Board *rescinded* the June 21, 2022 memorandum. EX2004. The Guidance Memorandum, issued March 24, 2025, makes clear that the presence of such a stipulation “will not be dispositive by itself.” *Id.*, 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. Exs. 2021-2025.

Accordingly, even when a petitioner files a purported “*Sotera*” stipulation, it is ***not*** dispositive of whether the Board should deny institution under *Fintiv*. Rather, the Acting 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.*, EX2004, *passim*; EX2003, *passim*; *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 2022 Guidance Memorandum (EX2007), 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*:

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.

EX2021 (Centripetal) at 6-7.

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.***

EX2022 (Stanwood (“an inventor and US citizen with 161 issued US patents”)) at

¶16.

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.

EX2023 (Pharmaceutical Research and Manufacturers of America (PhRMA))
at 10, 12.

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.

EX2024 (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.***

EX2025 (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, Petitioners’ 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’ initial 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 specifically noted in the public comments discussed *supra* at §III.B.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.”). This prejudice to Patent Owner is particularly acute where, here, the Petitioners assert “system 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.*, EX2014 at 101-103 (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.

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.*, EX2014 at 104-105 (identifying “Primary References” including “Randall” and “Sheha”); *e.g., id.* at 105 (combining such prior art with system or device prior art “SP(C)H-N300” or “Benefon Esc!”). 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; *SAP Am. Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 10-11 (PTAB Apr. 7, 2025) (factor 4 favors discretionary denial because Petitioner was asserting system art in district court and “a majority of the parties’ work that would be done here will also be required in the Litigation regardless of whether we institute review. Accordingly, we do not consider the presence of the *Sotera* stipulation in our case to ensure that inter partes review would be a ‘true alternative; to the Litigation.’”).

Third, the Acting Director, in her Order Vacating the Decision Granting Institution and Denying Institution in IPR2024-01205, correctly clarified that when “Petitioner’s invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in” the present IPR proceedings “with unpublished system prior art” a *Sotera* stipulation is “not likely to moot” those expansive district court invalidity arguments. IPR2024-01205, Paper 19, at 3-4. Such is the case here, where even if Petitioners abide by their proposed *Sotera* stipulation, Patent Owner would still be forced to address materially identical invalidity arguments to those in the Petition in the district court due to their combination with system prior art the Petitioners cannot raise before the Board.

Accordingly, even in light of Petitioners’ purported stipulation, the Board should deny institution under *Fintiv* or the Director’s inherent authority.

C. That the PTAB Already Adjudicated the Validity of the Challenged Claims by Denying Institution in a Prior IPR Also Supports Discretionary Denial

The 2025 Memorandum specifically states whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims is relevant to the discretionary denial considerations. Here, the PTAB already determined that the petitioner in a previous IPR did not demonstrate a reasonable likelihood of prevailing in establishing unpatentability of at least one claim of the '218 patent based on the *same prior art* Petitioner in the instant case propound for grounds 4-7. *See* IPR2023-00087, Paper 10 (PTAB May 3, 2023) (denying institution). In addition, as discussed *infra* §III.F, Petitioners' incorporation of additional prior art references is at its core a recycling of the same invalidity grounds the PTAB previously and correctly deemed unlikely to succeed on the merits.

D. Further Supporting Discretionary Denial, Each Invalidity Ground is Devoid of Merit and Ubiquitously Relies on Conclusory, Unsupported "Expert" Testimony

Another basis for discretionary denial is that each invalidity ground attempts to cure deficiencies in the cited references with excessive reliance on conclusory expert testimony. As discussed in greater detail *infra* §III.F, Petitioners' Grounds are either directly recycled from the petition the PTAB already denied, or they are foundationally predicated on the same arguments made in that petition, just with substitute but equivalent prior art references. Petitioners' patchwork strategy of

repurposing unsuccessful prior art and materially similar additive references warrants discretionary denial, as does Petitioners' pervasive attempt to buttress lacking obviousness combinations with unsupported expert testimony. The weakness of Petitioners' unpatentability challenges, and excessive reliance on expert testimony, weigh heavily in favor of discretionarily denying institution of the Petition.

E. The Petition Fails to Establish a Reasonable Likelihood of Success Because it Ignores Claim Construction Issues

1. Claims 1, 6, 11, and 16

Each of the Petition's Grounds are directed to Claim 1, Claim 6, Claim 11, or Claim 16 of the '218 Patent, or a claim dependent thereon.

The Petition describes discrete portions of the '218 Patent written description and summarizes the general subject matter of claims 1-19. Pet., 2-6.³ The invention of the '218 Patent as described in the specification is referenced and explained *infra* as appropriate.

Regarding the Claimed devices of the '218 Patent, **Claims 1, 6 and 11** concern a wireless device operable to display the locations of multiple other users from the perspective of the first user, as well as operable to display location-related

³ At this preliminary stage, and before submission of expert testimony, Patent Owner neither disputes nor consents to Petitioner's definition of a person of ordinary skill in the art. Pet., 4.

information. For example, Claim 1 specifically recites a “**first wireless telephonic device**” operable to request the location of a “**second wireless telephonic device**” and, after confirming permission to receive that location, operable to display a first location, as well as the location of a **third wireless telephonic device**. ’218 Patent, Claim 1. Claim 6 similarly recites a “**wireless telephonic device**” operable to request and display the locations of **first** and **second** wireless devices on a **map**. *Id.*, Claim 6. Like Claim 6, Claim 11 recites a “**wireless device**” operable to request and display the locations of **first** and **second** wireless devices on a **map**. *Id.*, Claim 11. Claims 1, 6 and 11 also recite operability to display other location-related information, including the distance and/or travel time between device locations, the address of a device location, a directional arrow to a device location and a compass.

Claim 16 is directed to devices operable to provide the locations of first and second devices both associated with the same user identification to a third device that is not associated with that user identification. *Id.*, Claim 16.

2. Claim Construction

Petitioners identify the standard for claim construction applicable to IPR proceedings but do not identify any terms for construction. Pet., 5. Contrary to Petitioner’s position, relevant to the issues here, Patent Owner submits that the Board should construe at least the term “request from said wireless telephonic device” present in Claims 1, 6, and 11.

Claims 1⁴, 6 and 11 of the '218 Patent each recite that prior to any location sharing, a “request from” a “wireless telephonic device” occur. '218 Patent, Claims 1, 6, 11. Patent Owner submits that the plain language of “request from said wireless telephonic device” means that the identified request is made *from* the device. As the Board is aware, claims in IPR proceedings 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, the plain language of the claims themselves are clear that the “request” is from the specific device recited in the claim (*e.g.*, in Claim 1, the “request to locate a second wireless” devices comes “*from* said first wireless telephonic device”), *see also* Claim 6 and 11 (“a request *from* said wireless telephonic device”). 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.”); *see also 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 telephonic device”, in Claims 6 and 11 the “wireless telephonic device operable to provide a display screen”) must

⁴ Claim 1 differs slightly from claims 6 and 11: “request to locate a second wireless telephonic device from said first wireless telephonic device”

provide the “request” and the Board should reject Petitioners’ attempt to ignore this limitation or read it out of the claim. Indeed, this feature advantageously enhances security by requiring the same device operable to make the request be the same device that is operable to display the resultant location information. ’218 Patent, 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”).

The plain and customary meaning of these ordinary words is readily apparent. “Request” means to ask. “From” implies the origin of. And the claim language expressly identifies where that ask originates—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 request come from the specified device. By contrast, to interpret these claims as allowing for a request to originate from an alternate source would improperly strip the claims of their actual words and their 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 important and specifically relates to Patent Owner’s innovation regarding improving security. ’218 Patent, 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.**”).

The specification also supports Patent Owner’s construction. It consistently describes the invention with the location access request from a specific device (*i.e.*, the same device that is operable to display location information):

FIG. 2 shows flow chart 200 of a simplified location feature constructed in accordance with the principles of the present invention. Step 202 initiates *when a user requests the location of another user’s cell phone.*

’218 Patent, 4:52-55. *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.”).

Accordingly, the Board should hold that these claim terms require the claimed “request” to originate with the specific wireless device recited in each claim.

Patent Owner reserves the right to identify additional claim terms necessitating construction should there be institution.

F. Grounds 1-7 Of The Petition Fail To Establish Obviousness Of Any Claim

Petitioners do not establish a reasonable likelihood that any of the independent claims of the ’218 Patent are unpatentable based on Randall, Sheha or the various combinations in grounds 1-7. The Board should deny institution because none of the Petition’s Grounds teach or make obvious at least the limitations addressed below.

1. The Petition Fails to Demonstrate that any Randall or Sheha Grounds Teach or Make Obvious “a request from said wireless telephonic device” as Recited in Claims 1, 6, and 11

Petitioners’ arguments with regard to these claim limitations are based on fundamental misreadings of the claim language. *Supra* at §III.E.2. Properly construed, these claim limitations require the claimed “request” to be made from the referenced device. *Id.*

Petitioners repeatedly ignore (ascribing no meaning to and failing to substantively address in the Petition) the portion of this term that requires the “request” for wireless access rights to initiate on the referenced wireless telephonic device that is operable to provide a map display. (e.g., Claim 1, “first wireless telephonic device operable to provide a display screen *after a request* to locate a second wireless telephonic device *from said first wireless telephonic device has occurred*”), *see also* Claim 6 and 11 (“a request from said wireless telephonic device”). This is a significant omission because this feature advantageously enhances security by providing only the *requesting* device with a map of the desired location. *supra* at §III.E; ’218 Patent, 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[.]”).

a. *Randall*

Nowhere does Randall teach or suggest a wireless telephonic device making a request as required by Claims 1, 6, and 11. Randall instead references the use of a remote database that can store information regarding a multitude of individuals, and also “define which entities can read different fields” in that database. Randall, [0047]. Randall references organizing data via definitions of which entities can read those different fields. *Id.* Both the Petition, and Randall are silent as to how those

definitions are established, as well as if those definitions are provided by the same mobile device that is operable to display location information. Location disclosure does not initiate by a request from a device as required by Claims 1, 6, and 11. Rather, Randall discloses a user, Alice, affirmatively choosing “to subscribe to the service which allows” another, Bob, to track her. *Id.*, [0021]. After doing so, Alice then has to provide an “ADS” number (described as “text strings”) to Bob. *Id.*, [0049]. Upon receipt of the ADS number from Alice (provided by unknown means), Bob “sends Alice’s ADS number to the server, then the server recognizes Bob’s device and allows that device to read Alice’s information held on the database which is specified as being accessible to Bob[.]” *Id.* This multi-step process, originating with user Alice first (1) opting into allowing her information to be shared, (2) making Bob eligible for subscribing to Alice’s location data, (3) providing an ADS number to Bob, and (4) Bob entering that ADS number on his device, is wholly divorced from the limitation “a request from said telephonic device for access to” location data, per Claims 1, 6, and 11.

The Board should also reject Petitioners’ hindsight attempt to reinterpret Randall as teaching or suggesting something more. Pet. 11-17 (e.g. mischaracterizing using the ADS number Alice generates as “requesting” location access, where Randall only describes Alice preemptively assigning location rights to Bob, then opting whether to even share her ADS number with Bob). That the

security advantages provided by the '218 Patent's claimed inventions are only disclosed by the '218 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”).

For at least these reasons, any Randall ground fails to teach or suggest Claims 1, 6, 11, and their respective dependent claims.

b. Sheha

Sheha does not teach or suggest a wireless telephonic device making a request as required by Claims 1, 6, and 11. Sheha instead references performing a reverse telephone number lookup to retrieve address information of the called telephone number, but only if the owner of the called telephone number preemptively

established “privacy settings” that blanketly permit address disclosure to *any* user of Sheha’s system. Sheha, 7:50-57; 10:17-26 (“mobile device location information can be provided only, due to privacy settings, if the user configured the mobile device 18a to allow position information while calls are received.”), 12:1-4. This is different than the secure function provided by the claimed invention.

Instead, Sheha refers to a checking mobile device privacy settings or filters stored in ODAS that blanketly dictate if the mobile device’s position information is available to a caller:

- [I]f 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***. If there ***are no privacy settings***, the system would request the position information[.] Sheha, 4:62-66.
- [E]ach device has ***privacy settings*** that allow the device to prevent or limit other calling devices from obtaining position information. *Id.*, 5:38-41.
- 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.

Sending or receiving position information in Sheha is thus contingent *not* upon a request sent by a device, but instead upon what privacy filters the secondary 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 calling mobile device. *Id.* The privacy settings are *not* “location access rights” or responsive to “a request” for the same, are *not* provided by the mobile device, and are *not* provided “to” another specified device as recited in Claims 1, 6, or 11. *Id.* Every disclosure in Sheha is consistent in this regard. *E.g.*, Sheha, 4:35-42, 5:3-20, 5:21-46, 10:44-50, 11:3-9, 12:1-4.

Petitioners retained the *same* declarant that was retained by the prior petitioner in IPR proceedings involving the Sheha reference before the Board denied institution. 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* specific to a device and instead are general settings that apply to any location request that is received:

Q. [...] 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.*

EX2015, 17:6-12.

The Board should reject Petitioners' hindsight attempt to reinterpret Sheha as teaching or suggesting something more. Pet. 51-53 (mischaracterizing Sheha's devices querying the ODAS database for privacy settings as the first device "requesting to locate" another device). That the security advantages provided by the '218 Patent's claimed inventions are only disclosed by the '218 Patent, and not the cited references, should not be taken lightly. *In re Wesslau*, 353 F.2d 241; *In re Enhanced Security Research, LLC*, 739 F.3d 1355; *see also e.g., InTouch Techs., Inc.*, 751 F.3d 1352 .

For at least these reasons, any Sheha ground fails to teach or suggest Claims 1, 6, 11, and their respective dependent claims.

2. The Petition Fails to Demonstrate that any Randall or Sheha Grounds Teach or Make Obvious Mapping Multiple Other Users as Recited in Claims 1, 6, and 11

Claim 1 requires a "first wireless telephonic device" to be operable to display on its screen "indicia ... representative of a first location" and "indicia representative of a second location." The "first location" and "second location" are not the location of the "first wireless telephonic device" – Claim 1 requires these locations to be the locations of other devices of other users. For example, Claim 1 recites that "said display screen includes a distance from said first wireless telephonic device *to said first location*" and that the "second location [is] obtained *from said third wireless telephonic device*." '218 Patent, Claim 1. Claim 6 also requires that the "wireless

telephonic device” be operable to display “indicia on said map representative of said first location” of a “first wireless device” and “indicia on said map representative of a second location obtained from a second wireless device.” *Id.*, Claim 6. Claim 11 also requires that the “wireless device” be operable to display “indicia on said map representative of said first location” of a “first wireless device” and “indicia on said map representative of a second user according to a second location obtained from a second wireless device.” *Id.*, Claim 11. Thus, each claim is directed to the display of multiple locations on a displayed map.

a. Randall

Randall does not disclose mapping multiple users. Petitioner makes a cursory effort to argue otherwise, pointing to Randall’s paragraph [0021], “Rendezvous” and “Beacon Button” disclosures, all of which do not teach or suggest mapping multiple users. Pet. 17-18. Paragraph [0021] merely recites that after going to through the process discussed in §III.F.1.a, a location service could “show their position [singular] on digital maps [plural]”—i.e., one user’s location, depicted on each other user’s map, not multiple users appearing on *one map*. Randall, [0021] (bracketed language added for clarity). The “Rendezvous” and “Beacon Button” disclosures are consistent in this respect in that both permit the user to make her location available to other devices, but without any mention of operability to depict *multiple* users on *one map*. Randall, p. 29.

b. Sheha

Sheha does not disclose mapping multiple users. Petitioners implicitly concede this point by incorporating Wollrab to satisfy the claim limitations in Claims 1, 6, and 11, which as discussed *infra*, fails.

c. Wollrab Combinations

The Petition's combinations of Randall and Sheha with Wollrab do not teach or suggest the multiple user mapping limitations of Claims 1, 6, and 11.

First, in both combinations, Petitioner fails to explain what combination is actually taking place. With respect to the Randall+Wollrab combination, Petitioner merely touts the improvements of the '218 invention ("POSAs would have recognized [the benefit] ... of showing the positions of the tracking and tracked users on a map, in an intuitive manner that would be easily comprehensible to the tracking user[.]"). Pet., 10. This does not explain what specific methodologies of Wollrab are being incorporated into Randall, if any.

With respect to the Sheha+Wollrab, Petitioners' combination amounts to a conclusory statement to "do software programming." Pet., 60 ("POSAs would have been motivated and reasonably expected success using only ordinary skill and software programming"). This is a critical failure of the Petition, at least because the technologies of Sheha and Wollrab are ***radically different***. Where Sheha employs a monolithic registry of telephone numbers and pre-set privacy settings, Wollrab

(predominantly concerned with synchronizing digital family event calendars) employs satellite transmissions of location data “every 5 minutes” to “specific member PDA devices or to all PDAs” within a defined group for “synchronizing/replication.” Wollrab, 4:1-10. Moreover, Wollrab functions using a “decentralized architecture” through “peer to peer” functionality” that does not “add[] another layer, for example a group store”—the exact opposite technology backbone employed in Sheha (i.e., a centralized repository of phone numbers and preordained blanket privacy settings). Sheha, 6:4-6.

Second, Petitioner and Williams provide *no* supporting evidence or technical reasoning as to why skilled artisans would have deemed these proposed combinations proposal technically feasible at the time of the invention, especially in light of the drastically different technological implementations, or why skilled artisans would have so modified the ODAS to provide this functionality with reasonable expectations of successfully doing so. *Xerox Corp. et al. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 14-16 (PTAB Aug. 24, 2022) (rejecting Petitioner’s assertions where declarant failed to provide supporting evidence or technical reasoning to support his statement). Instead, Petitioner merely proposes “software programming” to square the Sheha-Wollrab circle.

Moreover, in both Wollrab combinations, Petitioner impermissibly commingles the motivation to combine and reasonable expectation of success

analyses without distinction or specificity. This approach is improper. *Eli Lilly & Co. v. Teva Pharms. Int’l GmbH*, 8 F.4th 1331, 1344 (Fed. Cir. 2021) (“[W]e must first emphasize the clear distinction in our case law between a patent challenger’s burden to prove that a skilled artisan would have been motivated to combine prior art references and the additional requirement that the patent challenger also prove that the skilled artisan would have had a reasonable expectation of successfully achieving the claimed invention from the combination.”); *see also Samsung Elecs. Co. v. Elm 3DS Innovations LLC*, 925 F.3d 1373, 1380-1381 (Fed. Cir. 2019) (finding lack of adequate reasonable expectation of success).

For at least these reasons, any Randall-Wollrab and Sheha-Wollrab combinations fail to teach or suggest the limitations of at least Claims 1, 6, 11, and their respective dependent claims.

3. The Petition Fails to Demonstrate that any Randall or Sheha Combinations Teach or Make Obvious the “Travel Time” Limitations of Claims 6 and 11

Claims 6 and 11 both require providing “travel time” between locations. Petitioner in both its Randall Grounds and Sheha Grounds implicitly concedes that neither primary reference discloses “travel time.” Instead, Petitioner incorporates Obradovich, but fails to explain what the specific combination is, how any combination is technically feasible, or why a skilled artisan would be motivated to do so.

Obradovich refers to a highly complex and different system that involves and relies on separate remote components (“condition reporting device[s] (CRD)”) that interacts with and sends information to a unique device that Obradovich calls the “PCD,” or “Personal Communication Device.” The CRDs are “mounted on the sides of freeway overpasses or poles adjacent a vehicular arterial route to determine automotive vehicular speeds on the freeway or arterial route” and exchange information via a “central computer system” that transmits data to PCDs upon request. Obradovich, 17:28-18:5, 19:43-20:24. The multiple, remotely positioned CRDs each utilize “speed detector[s],” “radio transceiver[s],” “coaxial cable port[s]” and other “sensor[s]” “transmit data” to the PCD. Obradovich, 17:36-44; 21:21-22.

a. Randall

Petitioner’s combination, if understood correctly, is to purportedly take Obradovich’s “process [that] determines travel times” and display it on Randall’s display. Pet., 33; Obradovich, 22:62-65. As discussed *supra*, Obradovich’s “process” includes capturing information via a variety of sensors and/or speed detectors in the CRDs along a particular road, then transmitting that raw data to a PCD. *Supra* §III.F.3. Petitioner ignores this underpinning requirement for multiple remotely positioned auxiliary CRDs, and instead inexplicably combines this litany of additional hardware with Randall’s display. Pet., 33. These are inapposite technological pairings. Moreover, both Claim 6 and 11 include “travel time” display

“based on” “the first location and the location of said wireless telephonic device,” not—as recited in Obradovich—a time estimate based on an “ordered list of CRDs along the route[.]” Obradovich, 21:21-22. Petitioner, once again, fails to explain the specific motivation to combine, and even worse, inextricably commingles its conclusory motivation with the expectation of success analysis. Pet., 34 (“POSAs would have been motivated and reasonable [sic] expected success to implement” Randall and Obradovich). For these reasons, any combination of Randall and Obradovich fails to teach or render obvious Claims 6 and 11.

b. Sheha

Petitioner’s combination of Sheha and Obradovich is similarly lacking. Petitioner contends that “whole bodily” incorporation of Obradovich is not required to enable Sheha to utilize Obradovich’s system, and leaves the combination there, without *any* explanation of what short of whole bodily incorporation of Obradovich is required to enable “travel time” to be displayed. Pet., 70. The gating issue with this combination is that the only technology, between Sheha and Obradovich, capable of capturing the necessary information to establish a travel time are the CRDs of Obradovich. Petitioner does nothing to explain how a skilled artisan would or could account for the integration of these auxiliary, but vital components from Obradovich in Sheha. On this basis alone, any Sheha-Obradovich combination fails. *See Eli Lilly*, 8 F.4th at 1344; *see also SFC Co. Ltd. v. LG Chem. Ltd.*, IPR2020-

00178, Paper 16, at 37-39 (PTAB May 29, 2020) (“This general statement ... falls short of supporting Petitioner’s assertion that the proposed substitutions ... could be done with ease....”); *Rovalma, S.A. v. Bohler-Edelstahl GmbH & Co. KG*, 856 F.3d 1019, 1026 (Fed. Cir. 2017) (vacating decision for failure to adequately explain why skilled artisans would have reasonably expected success). Furthermore, again, Petitioner improperly commingles a conclusory motivation to combine with the expectation of success analysis. *Eli Lilly*, 8 F.4th at 1344.

4. The Petition Fails to Demonstrate that Randall or Sheha, Alone, or in View of Song Teaches or Suggests the Limitations of Claim 16

Claim 16 is directed to logging into two different devices using the same user identification and providing the locations of those devices to a third device that is not associated with the user identification. The systems described in Randall and Sheha are far different and, thus, fail to teach or suggest many of the limitations of Claim 16, with or without Song.

a. No Randall or Sheha Ground Discloses or Makes Obvious “a First Device Operable to Identify a User Identification on Said First Device by Receiving a Login and Password From Said First Device”

Claim 16 requires the “first device” to identify a “user identification” based on receiving a “login” and “password”. That is, the limitation requires (i) three discrete elements—“a login,” “password” and “a user identification”—and (ii) that

the *device* perform the identifying. Not Randall, Sheha, nor Song, disclose these elements.

Randall does not disclose these three elements. Rather, as underscored by Petitioner, Randall only discloses singular pieces of information given to the server for identifying Bob, without a secondary corroborating piece of information. Pet., 42. For example, “a unique, secret ID number [transmitted] to the server” or answering personal information questions. Randall, [0067]. It is not clear from the disclosure in Randall whether these informational pieces are logins, or passwords, but it is clear that the login/password corroboration required in the claim is not present. Moreover, Randall’s disclosure makes clear that the server, not the device, performs the identifying. *Id.* (“once authenticated, the server passes to Bob’s device the information it requests”). Randall’s disclosure of “both locally and on the server” fares no better as it does not refer to a user identification performed by the user device. *Id.*, [0380]. Rather, this disclosure is concerned with preventing access to information already accessible on a user’s account, not gaining access to newly granted information. *Id.* (“This authentication should prevent access to their information both locally and on the server”). Randall’s concern with preventing access to an account that has *already* been granted third-party information is irrelevant to Claim 16’s login, password and “a user identification” limitations. Further, such authentication occurs on Randall’s server, not the device in Claim 16

that performs the identifying. *Cf.* Randall, [0067] (“Authentication ... can be achieved through the server recognising Bob’s device”), ’218 Claim 16 (“a first device operable to identify a user identification on said first device by receiving a login and password from said first device”). Finally, Petitioner’s declarant’s assertion that Alice’s “user information” is identified locally is pure conjecture given the lack of citation to any disclosure in Randall. EX1003, [0226].

Petitioner relies on *two* elements in Sheha, “username” and “password” and suggests that the *ODAS* performs the identifying—not *three* elements and that the *user device* performs the identifying. Pet., 80, citing Sheha, 8:38-50. There is also no teaching or suggestion in lines 38-50 of column 8 of Sheha that a *user device* receives a login and password to identify a user identification. It is unclear from Sheha when and how the “username and password” are entered and whether they are used to identify a separate “user identification” or whether the “user identification information” referenced in Sheha *is* the “username and password,” let alone used by the *user device* to identify a user ID. Petitioner’s reliance on lines 26 to 29 of column six of Sheha are similarly unavailing because this embodiment first mandates the exchange of “unique identification token” which then requires further verification “by the networked server” (i.e., *ODAS*) prior to a position information disclosure. This is not the claimed “a login,” “password” and “user identification” nor a *device* that performs the identifying.

Song does not cure the deficiencies of Randall, nor Sheha. First, Song's *device* is not operable to identify a user identification, rather Song requires "owner data" to be entered into a "database" which *then* activates a personal device (e.g., phone). Song, 2:22-25 ("Owners of personal devices may register each of the devices with the registry server ... [which] includes a database of security information"). Second, when Song's server is "not available" login information is only accessible at the device level when it has *previously been inputted* on the server. *Id.*, 7:4-7 ("the registry server may be one or more server computers or other similar devices providing an authentication and authorization function *for the personal device(s)*"; 11:50 ("[when the server is unavailable] the personal device may use the locally stored information for authorization"). Finally, Petitioners nor Williams explain how the complex system in Song (employing public and private key generation and sharing) could be integrated with Randall, or Sheha's systems.

Nor does Petitioner address the challenges acknowledged by Song such as requiring "sufficient storage" capabilities, or what happens if the device has insufficient storage. Song, 11:33-35 ("personal device capability description 42 is reviewed for sufficient storage capability within the personal device 14 to store the corresponding device record"); *id.* 11:44-47 ("if the personal device capability description 42 indicates insufficient storage resources are present in the personal device 14, the registration process ends"). For these reasons alone, no Randall or

Sheha combination discloses or renders obvious Claim 16 or any of its dependent claims.

b. No Randall or Sheha Ground Discloses or Makes Obvious the “Recorded” Limitations of Claim 16

The claim further requires that the “user identification” have a location associated with it based on the locations of the first and second devices that identified the user identifications, and that such locations be recorded. Sheha does not disclose these limitations because it is silent on recording locations of a user identifications. Petitioner points to its discussion of Claim 1[a] to support its allegation Randall performs user identification recordation on a user device. Claim 1[a], and Petitioner’s discussion of the same is wholly irrelevant to the “recording” limitations of Claim 16. Further, neither Randall, nor Sheha disclose any user identification being identified by the *device*, so no recordation of a user identification performed by a device can occur. *See* §III.F.4.a.

c. No Randall or Sheha Ground Discloses or Makes Obvious “Said First Location is Operable to be Provided to a Third Device Not Associated With Said User Identification” or “Said Second Location is Operable to be Provided a Said Third Device Not Associated With Said User Identification”

The claim further requires that the location of the “user identification” be provided to “a third device not associated with said user identification,” that the same “user identification” identified on the first device also be identified on a second

device using the same “login” and “password” and that the second location of the “user identification” be provided to “a third device not associated with said user identification.” ’218 Patent, Claim 16. Again, neither any Randall ground or Sheha ground disclose recording the location of a user identification or identifying a user identification on the *user device*. *Supra* §III.F.4.b. Both primary references are therefore also silent on their ability to provide such information to *other* devices as these limitations require. Similarly, Song records user information (“device record”) on its “registry server”—not on any user device as required by the claim. Pet., 40 (“[Song’s] server stores data ‘for each owner,’ including ‘owner data 30 and at least one device record 32 for at least one personal device[.]’”).

For at least the reasons above regarding Randall, Sheha and/or Song’s failure to teach or suggest logging into multiple devices or associating the same user identification with different devices, the Petition fails to demonstrate that Randall or Sheha alone or in combination with Song discloses or makes obvious this claim.

Petitioners’ fundamental misreading of these claim limitations, corresponding erroneous mapping of these claim limitations to the cited references, and unexplained and unsupported combinations evidence the Petition’s failure to demonstrate invalidity of any of the ’218 Patent claims.

Accordingly, the Board should find that the Petition has failed to demonstrate invalidity of these claims by a “reasonable likelihood,” and thus should decline to

institute Grounds 1-7. *See e.g.*, IPR2023-00130, Paper 10 at 26 (denying 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 (PTAB November 19, 2024) (denying 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 at 27 (PTAB 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”).

IV. CONCLUSION

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

Dated: April 15, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

The undersigned certifies that the portions of the above-captioned PATENT OWNER'S DISCRETIONARY DENIAL BRIEF specified in 37 C.F.R. § 42.24 have 13,986 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: April 15, 2025

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CERTIFICATE OF SERVICE

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

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