Paper No. __

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

_____

Case No. IPR2025-00197
Patent No. 11,109,218

PETITIONERS' OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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1001	U.S. Patent No. 11,109,218 ("the '218 patent")
1002	Prosecution History of U.S. Patent No. 9,204,218
1003	Declaration of David H. Williams ("Williams-Decl.")
1004	Curriculum Vitae of David H. Williams
1005	U.S. Patent No. 7,333,820 ("Sheha")
1006	U.S. Provisional Patent Application No. 60/305,975 ("Sheha-Prov.")
1007	U.S. Patent Application Publication No. 2004/0024846 ("Randall")
1008	International Patent Application Publication No. WO 02/17075 ("Randall-WIPO")
1009	RESERVED
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1013	U.S. Patent No. 6,968,179 ("De-Vries")
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1029	U.S. Patent No. 6,456,854 ("Chern")
1030	U.S. Patent No. 6,754,665 ("Futagami")
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1036	Civil Docket Report in *Mullen Industries LLC v. Samsung Electronics Co., Ltd. et al.*, Case No. 2:24-cv-00049 (E.D. Tex.) (last checked November 14, 2024)
1037	Federal Court Management Statistics–Profiles, U.S. District Courts–Combined Civil and Criminal (June 30, 2024) (available at https://www.uscourts.gov/file/78871/download)
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1041	U.S. Patent Application Publication No. 2003/0074209 ("Tobin")
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1070	U.S. Patent No. 6,107,944 (“Behr”)
1071	U.S. Patent No. 7,203,752 (“Rice”)
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1073-1078	RESERVED
1079	Sotera Stipulation Letter dated February 11, 2025

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1081	Apr. 18, 2025 Letter from United States Senate to Secretary Howard Lutnick
1082	Congressional Research Service, *The Patent Trial and Appeal Board and Inter Partes Review*, R48016 (May 28, 2024)
1083	"About Google," available at: https://about.google/intl/ALL_us/around-the-globe/local-info/ (accessed May 25, 2025)
1084	"Samsung in America," available at: https://news.samsung.com/us/samsung-in-america (accessed May 25, 2025)
1085	*Mullen Industries LLC v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00049-JRG, Plaintiff's Final Pre-trial Election of Asserted Claims (E.D. Tex. May 2, 2025)
1086	*In re Samsung Elecs. Co., Ltd.*, No. 2025-129, Samsung Mandamus Petition, Dkt. 2 (Fed. Cir. May 8, 2025)
1087	Lex Machina Statistics for District Judge James Rodney Gilstrap (accessed May 14, 2025)
1088	*Mullen Industries LLC v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00049-JRG, Docket Order Resetting Markman Hearing (May 9, 2025)
1089	*Mullen Industries LLC v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00049-JRG, Fourth Amended Docket Control Order, Dkt. 85 (E.D. Tex. Mar. 12, 2025)
1090	Dana Nguyen, *IPR Estoppel's Evolving Landscape*, XV Nat'l L. Rev. 141 (Feb. 10, 2025), available at: https://natlawreview.com/article/ipr-estoppels-evolving-landscape
1091	June 18, 2024 Letter from Council for Innovation Promotion (C4IP) to The Honorable Katherine K. Vidal re: Docket No. PTO-P-2023-0048, Patent Trial and Appeal Board Rules of Practice for Briefing Discretionary Denial Issues, and Rules for 325(d) Considerations, Instituting Parallel and Serial Petitions, and Termination Due to

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	Settlement Agreement, available at: https://c4ip.org/wp-content/uploads/2024/06/C4IP-Comment-RE-PTO-P-2023-0048.pdf
1092	June 20, 2023 Comments of Innovation Alliance in Response to the USPTO's Advance Notice of Proposed Rulemaking Regarding Changes Under Consideration to Discretionary Institution Practices, Petition Word-Count Limits, and Settlement Practices for America Invents Act Trial Proceedings Before the Patent Trial and Appeal Board (Docket No. PTO-P-2020-0022)
1093	June 20, 2023 Letter from AbbVie to The Honorable Kathi Vidal re: Docket No. PTO-P-2020-0022: Advance Notice of Proposed Rulemaking on Changes Under Consideration to Discretionary Institution Practices, Petition Word-Count Limits, and Settlement Practices for America Invents Act Trial Proceedings Before the Patent Trial and Appeal Board
1094	June 20, 2023 Letter from Ericsson to Hon. Kathi Vidal re: Comments on Changes Under Consideration to Discretionary Institution Practices, Petition Word-Count Limits, and Settlement Practices for America Invents Act Trial Proceedings Before the Patent Trial and Appeal Board (Docket No. PTO-P-2022-0022)
1095	June 20, 2023 Letter from Nokia to Michael Tierney, Vice Chief Administrative Patent Judge re: Docket No. PTO-P-2020-0022
1096	Nathan Sportel, *Did Sotera Stipulations Solve the Fintiv Criticisms*, 21 Chicago-Kent J. Intell. Prop. (2022)
1097	Ryan Davis, "PTAB Ramps Up Fintiv Denials After Withdrawal Of Memo," Law360 (May 13, 2025, 10:46 PM EDT), available at: https://www.law360.com/articles/2339744/ptab-ramps-up-fintiv-denials-after-withdrawal-of-memo
1098	Brief of The National Retail Federation, The High Tech Inventors Alliance, et al., as Amici Curiae in Support of Apple and Reversal, *Apple Inc., v. Stewart*, No. 24-1864 at 22 (Fed. Cir. Aug. 12, 2024)

I. INTRODUCTION

This IPR should be instituted; discretionary denial is not warranted. As discussed below, compelling economic interests favor institution. The *Fintiv* factors favor institution. Contrary to Patent Owner's ("Mullen"'s) assertions, the challenged claims' patentability has never before been adjudicated, the Petition's use of expert testimony is entirely appropriate and supportive, and Mullen has raised no claim-construction issues that matter. The unpatentability grounds are strong; Mullen's arguments against them are exceedingly weak; and this is unsurprising given the Board's recent determinations, in instituting four of Petitioners' IPRs against Mullen's related patents, that the unpatentability case is strong.

The patent challenged here ("the '218 patent") is among a family of eight patents that share a specification and "recite well-known and obvious features of remotely locating a first wireless device from a second wireless device." *See Google LLC v. Mullen Industries LLC*, IPR2025-00018, Paper 14 at 13-14 (May 12, 2025) (granting institution); *accord* IPR2025-00019, Paper 14 at 13 (May 12, 2025) (granting institution); IPR2025-00021, Paper 14 at 11-12 (May 14, 2025) (granting institution); IPR2025-00124, Paper 14 at 12 (May 12, 2025) (granting institution). The lack of any true innovation actually deserving of patent protection is evident from the patents' protracted prosecution history. It took Mullen ***ten***

years from the filing of the patents' shared specification in 2003 to get a first claim set (patent 8,374,575) granted in 2013 after seven rejections. Another ***nine years*** were then spent collecting seven more patents via incremental variations on the same base concepts.

After collecting all those claim variations on the same well-known and obvious concepts, Mullen simultaneously asserted all of them against Apple the day after the last patent (11,246,024) issued in 2022. Just as Petitioners have here, Apple filed eleven IPRs to challenge these eight patents (which collectively total ***339 claims***); and the Board instituted eight of them. Rather than seeing those IPR trials through to judgment on the unpatentability of the instituted claims, Mullen settled with Apple and retained all 339 claims, which were used (together with another patent) to sue Samsung only a few months later. Now, faced with even stronger IPRs filed ***by statutory right*** by the subsequent defendant whom Mullen ***deliberately chose*** to sue sequentially, Mullen seeks to avoid the well-deserved cancellation of its unpatentable claims by using its own litigation conduct as both a sword and a shield, in order to retain the ability to continue to sue not only this defendant but unknown numbers of future targets on invalid patents that should never have issued in the first place.

The Board should not entertain Mullen's request to reward its gamesmanship with discretionary denial of this IPR. These IPRs, and the patents

they challenge, epitomize the very purpose of IPRs "to weed out bad patent claims" that are being levied against the industry and burdening American companies' technological and economic contributions via "overpatenting." *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020). "The PTAB was established as the signature accomplishment of the bipartisan Leahy-Smith America Invents Act, arguably the most important patent law enacted by Congress in the last 50 years." EX1081, 2. "Congress was also concerned that poor-quality patents fueled litigation by so-called 'patent trolls,' a pejorative term for patent plaintiffs that do not manufacture or sell the patented products." EX1082, pdf p. 2.

The challenged claims' unpatentability, as amply demonstrated in the Petition, should be tried on the merits—just as the Board's merits panel rightly determined is appropriate in five of the IPRs involved in the parties' dispute so far. IPR2024-01472, Paper 9 (Mar. 31, 2025); IPR2025-00018, IPR2025-00019, IPR2025-00124, Paper 14 (May 12, 2025); IPR2025-00021, Paper 14 (May 14, 2025).

II. COMPELLING ECONOMIC INTERESTS FAVOR INSTITUTION

Compelling economic interests strongly support instituting this and Petitioners' related pending IPRs. *See* Interim Processes for PTAB Workload Management (Mar. 26, 2025), 2-3 (inviting parties to address "[c]ompelling economic, public health, or national security interests" as "relevant considerations"

that "bear[] on the Director's discretion"). This is the case in light of the technological contributions made by Petitioners in the United States; no such contributions are made by Mullen generally or as to the patents at issue in these IPRs.

Patent Owner Mullen Industries LLC ("Mullen") makes no products, offers no services, and has no apparent business other than filing lawsuits.[1] Its website (mullenindustriesllc.com), as of this paper's filing, is an empty page with a looping video of a street corner, a "contact us" button, and a "subscribe" field.[2] The patents it asserts against the industry at large are not focused in any one subject-matter area. To date, Mullen has sued Apple and then Samsung on nine mobile-device patents, as well as Meta on twelve augmented-reality/virtual-reality gaming patents. In contrast, all of these defendants do offer innovative products and services that contribute to the nation's technological growth.

Unlike Mullen, Petitioners have invested and continue to invest heavily in the American economy. For example, in 2024, Google invested over $49 billion in research and development to power American technological leadership, and to

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[1] *Mullen Industries LLC v. Apple Inc.*, No. 6:22-cv-00145 (WDTX); *Mullen Industries LLC v. Samsung Elecs. Co.*, No. 2:24-cv-00049 (EDTX); *Mullen Industries LLC v. Meta Platforms, Inc.*, No. 1:24-cv-00354 (WDTX).

[2] *See also* archived capture at https://web.archive.org/web/20230331160924/https://mullenindustriesllc.com/

produce unprecedented leaps in artificial intelligence and quantum computing capabilities that advance national security. *See* EX1083. Google created $850 billion in economic activity for American businesses, nonprofits, publishers, creators, and developers in 2024; maintains offices or data centers in twenty-six states; and employs over 100,000 individuals throughout the United States. *See* EX1083. Similarly, Samsung has invested over $100 billion in the United States, generated over $31.2 billion with its U.S. facilities, and created over 175,000 jobs with its U.S. facilities. *See* EX1084.

III. THE *FINTIV* FACTORS FAVOR INSTITUTION

It would be a miscarriage of justice to deny this IPR under *Fintiv*. Mullen's assertions that instituting Petitioner's IPRs "would have the same outcome as the single pending district court case" which will allegedly "resolve all of the issues" are not remotely true. Patent Owner's Discretionary Denial Brief (Paper 11) ("DD-Brief"), 8-10.

This IPR challenges all 19 claims of the '218 patent—five of which were asserted against Samsung when the Petition was filed. Whereas now, Mullen has elected to proceed with ***only one*** claim (claim 11) in district court. EX1085. The district court will have no opportunity whatsoever to "invalidat[e] ***the patent[]***"

(DD-Brief, 8)[3]—it would only be able to assess claim 11, and only if that claim's validity remains at issue through trial and judgment. If Petitioners' IPR is never considered on its merits, at least 18 demonstrably unpatentable claims will remain at large for Mullen to use in harassing its next set of targets. Denying Petitioners their opportunity to demonstrate to the Board why these claims should be cancelled to prevent further vexatious litigation would be a public disservice and contrary to the very purposes and charge of the PTAB.

Any alleged prejudice to Mullen based on the number of IPR proceedings filed against Mullen's patents is self-imposed. It was not ***Petitioners'*** choice to "multiply the proceedings" needed to address Mullen's meritless patent assertions (DD-Brief, 1); it was ***Mullen*** that chose to file a complaint in district court asserting nine patents totaling 378 claims against Samsung.[4] It is not possible to challenge a set of patents via fewer than one IPR per patent (*see* 35 U.S.C. §311),

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[3] Bold italic emphases are added throughout unless otherwise noted.

[4] Mullen cites *General Plastic Indus. Co. v. Canon Kabushiki Kaisha* to argue that "the Board should deny institution to serve and maintain the goals of efficiency and efficacy, as well as fairness to" Mullen. DD-Brief, 10-11. But *General Plastic* addresses the potential for abuse when the same petitioner strategically files multiple, sequential IPR petitions "challenging the same patent and same claims…using [the Board's] decisions as a roadmap, until a ground is found that results in the grant of review." IPR2016-01357, Paper 19 at 11, 16-17 (Sept. 6, 2017). That is very different from this case where Petitioners diligently filed a set of twelve IPR petitions to address the vast amount of claims in the nine patents that were asserted by Mullen in the district-court case.

and two of Mullen's patents contain extraordinary numbers of claims (78 and 92 claims) that could not be addressed in one petition. Faced with Mullen's aggressive and overbroad assertion of patents, Samsung should not be penalized for availing itself of an alternative forum that is faster, cheaper, specialized, and more efficient than district court to defend itself against those nine patents. Indeed, that is the very purpose of *inter partes* review. "The framers of the AIA intended for IPR to serve as a faster, less costly alternative to district court litigation." EX1082, 13. "Congress's stated aim when creating IPR and PGR was to improve patent quality by providing a more efficient means to adjudicate patent validity issues." EX1082, pdf p. 2. "From the perspective of a person accused of patent infringement (or worried about being sued)," like Samsung, "PTAB procedures are often more advantageous than federal court litigation in that they are faster, cheaper, and use a lower standard of proof." *Id*.[5]

Proper consideration of the *Fintiv* factors weighs heavily in favor of instituting this IPR.

[5] "By statute, IPRs and PGRs are supposed to reach a final determination no later than one year after PTAB decides to institute the proceeding," which is "more streamlined than civil litigation, with average legal costs typically in the hundreds of thousands of dollars (as opposed to millions)." *Id.*; *see also* EX1081, 2.

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

Samsung's motion to stay the parallel EDTX litigation was denied "without prejudice to refiling of the same within fourteen (14) days following the PTAB's institution decision on the last of the pending IPRs." EX2008. In granting institution of five of Petitioners' IPRs in this dispute, the merits panel therefore "decline[d] to speculate whether the district court will grant a stay," and correctly "f[ou]nd that factor 1 is neutral." IPR2024-01472, Paper 9 at 8; IPR2025-00018, IPR2025-00019, Paper 14 at 10; IPR2025-00124, Paper 14 at 9; IPR2025-00021, Paper 14 at 8-9.

Indeed, the Board has consistently refused to speculate on future-filed stays.[6]

Mullen's argument that Judge Gilstrap's orders in other past cases show that he "will invariably also deny any potential future request for a stay here" (DD-Brief, 12-14) is not accurate. To the contrary, Judge Gilstrap has often granted

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[6] *See, e.g., Home Depot U.S.A., Inc. v. Sec. Tech., LLC*, IPR2024-01420, Paper 12 at 43-44 (Mar. 24, 2025) ("If Petitioner were to file a motion to stay in the EDTX Litigation, we decline to speculate how the district court would rule on such a motion."); *Ericsson Inc. v. XR Commc'ns LLC*, IPR2024-00868, Paper 8 at 28 (Dec. 13, 2024) (same); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (May 13, 2020) (same); *Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (June 16, 2020) (informative) ("[W]e will not attempt to predict how the district court…will proceed because the court may determine whether or not to stay any individual case…based on a variety of circumstances and facts beyond our control and to which the Board is not privy.").

contested stays in similar circumstances when all asserted claims of all asserted patents are challenged in the instituted IPRs, explaining that PTAB review will likely result in simplification of issues before the court.[7] Moreover, Judge Gilstrap and other EDTX judges have granted stay motions post-institution of IPR even when the district-court trial date is fast-approaching.[8]

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[7] *See, e.g., Resonant Sys., Inc. v. Samsung Elecs. Co.*, No. 2:22-CV-00423-JRG, Dkt. 83 at 6 (E.D. Tex. Mar. 8, 2024) (granting stay: "Given that *inter partes* review had been instituted on all Asserted Claims of all Asserted Patents on multiple grounds, there is a material likelihood of simplification of the issues in this case."); *Commc'n Techs., Inc. v. Samsung Elecs. Am., Inc.*, No. 2:21-CV-00444-JRG, 2023 WL 1478447, at *3 (E.D. Tex. Feb. 2, 2023) (granting stay: "'[T]he most important factor bearing on whether to grant a stay in this case is the prospect that the *inter partes* review proceeding will result in simplification of issues before the Court.' Here, *all claims* of the [patent] are currently under active PTAB review." (citation omitted) (emphasis original)).

[8] *See, e.g., Resonant*, Dkt. 83 at 6; *Commc'n Techs.*, 2023 WL 1478447 (case stayed 6 months before jury selection); *STA Grp. LLC v. Motorola Sols., Inc.*, No. 2:22-CV-00381-JRG-RSP, 2024 WL 2852961 (E.D. Tex. June 5, 2024) (case stayed 3.5 months before trial); *see OnPoint Sys., LLC v. Protect Animals With Satellites, LLC*, No. 4:20-CV-657, Dkt. 119 (E.D. Tex. Jan. 23, 2023) (case stayed 6.5 months before trial); *Broadphone LLC v. Samsung Elecs. Co.*, No. 2:23-CV-00001-JRG-RSP, 2024 WL 3524022 (E.D. Tex. July 24, 2024) (case stayed 6.5 months before trial); *Cobblestone Wireless, LLC v. Cisco Sys., Inc.*, No. 2:23-CV-00454-JRG-RSP, 2024 WL 5047854 (E.D. Tex. Dec. 9, 2024) (same); *Cellspin Soft, Inc. v. ByteDance Ltd.*, No. 2:23-CV-00496-JRG-RSP, Dkt. 106 (E.D. Tex. Jan. 26, 2025) (same).

Mullen cites a string of cases to support its argument, but in most of those cases, not all asserted claims were challenged or instituted,[9] or the institution decision makes plain that certain challenges are not likely to succeed.[10] Here, all of the asserted claims of all of the patents asserted in the underlying litigation are subject to petitions and will be addressed by the PTAB when instituted,[11] as most were when previously challenged by Apple who settled prior to final decisions. Moreover, as explained in Section V below, the instant Petition has particularly strong merits and is, at least, reasonably likely to succeed. At the very least, based on the broad claims and the strong prior-art references here, the PTAB should proceed to evaluate the Petition's challenges on the merits.

Therefore, this factor weighs against discretionary denial.

B. Factor 2: The Trial Date Is Uncertain

Mullen argues that the November 3, 2025 trial date is more certain because "of Judge Gilstrap recently denying the Samsung Petitioners' motion to transfer to

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[9] DD-Brief, 14 (citing *Oyster Optics* (EX2011) (one of the asserted claims not instituted (*id*. at 5-6)).

[10] DD-Brief, 13 (citing *MyPort* (EX2009) (likelihood of success on only two of five challenged grounds and only one of twelve challenged claims (*id*. at 5-6)).

[11] To date, the first five of the pending IPRs have been instituted, with the Board finding that the *Fintiv* factors as a whole do not favor exercising discretion to deny institution. IPR2024-01472, Paper 9; IPR2025-00018, IPR2025-00019, IPR2025-00021, IPR2025-00124, Paper 14.

the Northern District of California." DD-Brief, 17. But Judge Gilstrap's order denying Samsung's motion to transfer does not substantially change the calculus for factor 2 because Judge Gilstrap has eight trials set for the same date. While Mullen speculates that trial will occur as scheduled (DD-Brief, 16 (citing EX2012, 2)[12]), eight trials certainly cannot proceed before the same judge on the same date. Therefore, the number of cases that are scheduled on the same date, coupled with the certainty that the date ***will not*** stick for all but one of them, and the ***impossibility*** of knowing which, makes this factor weigh against discretionary denial.[13]

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[12] Mullen argues that in *TESO LT, UAB v. Luminati Networks Ltd.* the Board "den[ied] 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.'" DD-Brief, 16. But the posture of *TESO* makes it inapplicable here as it occurred immediately after the COVID-19 pandemic in 2021. The Board's reference to crowded docket conditions and petitioner's arguments regarding speculative further delays were COVID-related. IPR2021-00249, Paper 12 at 7-9 (Jun. 2, 2021). Moreover, the trial was much more imminent than is the case here.

[13] *See, e.g., BOE Tech. Grp. Co. v. Optronic Scis. LLC*, IPR2024-01131, Paper 15 at 11 (Feb. 12, 2025) ("Because a number of cases are scheduled for jury selection on January 5, 2026…, there is some uncertainty … we consider this factor to be neutral or ***weigh slightly against***" discretionary denial); *Samsung Elecs. Co. v. Acorn Semi, LLC*, IPR2020-01207, Paper 21 at 30-31 (Feb. 10, 2021) (granting institution; finding for factor 2 that "the number of other cases that are also scheduled [by Judge Gilstrap] to start trial on April 5, 2021 [nineteen] … introduce[s] some uncertainty and, thus, prevent this factor from weighing strongly against institution").

Additionally, Petitioner Samsung has filed a mandamus petition regarding Judge Gilstrap's denial of its transfer motion. EX1086. If that mandamus petition is granted, the trial date will likely be vacated.[14]

Even if the notional trial date (November 3, 2025) were credited, this would not compel denial. Although the Board's FWD is expected approximately eight months after the as-scheduled trial date, this factor is not determinative and "is not considered in isolation, but holistically along with other factors." *Facebook, Inc. v.*

[14] The Federal Circuit granted Petitioner Google's mandamus petition under similar circumstances in the *AGIS* case and the trial date was consequently delayed by 3.5 years before the case settled. *Compare AGIS Software Dev. LLC v. Google LLC*, No. 2:19-cv-00361, Dkt. 232 at 5 (E.D. Tex. Feb. 8, 2022) (setting trial for June 6, 2022), *with* No. 5:22-cv-04826, Dkt. 424 at 2 (N.D. Cal. Mar. 1, 2023) (setting jury trial for Aug. 18, 2025); *compare also, e.g., Largan Precision Co. v. Ability Opto-Electronics Tech. Co.*, No. 4:19-cv-00696, Dkt. 80 at 4 (E.D. Tex. Mar. 27, 2020) (setting Final Pretrial Conference for Apr. 30, 2021), *with* No. 3:20-cv-06607, Dkt. 177 at 12 (N.D. Cal. Jan. 22, 2021) (parties proposing May 16 or Aug. 9, 2022 for jury selection); *compare Raytheon Co. v. Cray, Inc.*, No. 2:15-cv-01554, Dkt. 30 at 1 (E.D. Tex. Dec. 29, 2015) (setting jury selection for Mar. 6, 2017), *with* No. 3:18-cv-00318, Dkt. 349 at 4 (W.D. Wis.) (setting jury selection for June 3, 2019); *compare CA, Inc. v. Netflix, Inc.*, No. 2:21-cv-00080, Dkt. 74 (E.D. Tex. Aug. 2, 2021) (DCO setting jury selection for Apr. 18, 2022), *with* No. 3:22-cv-00373, Dkt. 270 at 2 (N.D. Cal. Mar. 30, 2022) ("[T]here is a significant amount of litigation that still remains, including more discovery and claim construction…. This Court has yet to set a new trial date.").

USC IP P'Ship, IPR2021-00034, Paper 13 at 11 (Apr. 13, 2021). Specifically, the Board has previously instituted proceedings on comparable timing.[15]

Mullen cites a string of cases to support its argument that the gap between the trial and FWD "weighs heavily in favor of denying institution" but each is either pre-*Fintiv* and pre-*Sotera* (and much has changed in this area of law over the last six years)[16] or involved an imminent determination in an ITC proceeding where the same grounds and references from the IPRs were at issue before the

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[15] *See, e.g., T-Mobile USA, Inc. v. Cobblestone Wireless, LLC*, IPR2024-00137, Paper 15 (May 22, 2024) (other factors outweighing that there was eight months between trial and FWD; instituting); *Dolby Labs., Inc. v. Intertrust Techs. Corp.*, IPR2020-00665, Paper 11 (Feb. 16, 2021) (same); *Samsung Display Co. v. Pictiva Displays Int'l Ltd.*, IPR2024-01223, Paper 11 (Mar. 6, 2025) (seven months between trial and FWD); *Samsung Display Co. v. Pictiva Displays Int'l Ltd.*, IPR2024-01222, Paper 12 (Mar. 6, 2025) (same).

[16] DD-Brief, 16 (citing *Next Caller, Inc. v. TrustID, Inc.*, IPR2019-00961, Paper 10 (Oct. 16, 2019) (predates the designation of both *Fintiv* and *Sotera* as precedential); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 (May 15, 2019) (same)).

ITC,[17] or supports Petitioner because institution was ***granted***.[18] Here, there is a parallel district court litigation, not an ITC proceeding, and Petitioner's *Sotera* stipulation avoids the overlap issues that weighed against institution in the *Stanley* and *Satco* cases.

Moreover, due to timing of post-trial briefing and decisions, a final district-court judgment will generally come about four months after a jury verdict, so the proper comparison should compare when the district court's final judgment will issue to the timing of the Board's FWD, for an apples-to-apples comparison. For example, trial statistics in EDTX before Judge Gilstrap indicate that the median number of days between trial and termination of his cases is 117 days. EX1087 (Judge Gilstrap's median days to trial is 655 days and median days to termination

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[17] DD-Brief, 15-16 (citing *Satco Prods., Inc. v. The Regents of the Univ. of Cal.*, IPR2021-00794, Paper 14 at 18-25 (Nov. 10, 2021) (ITC proceeding was days away from initial determination, post-trial briefing was completed, and petitioner relied on the same prior-art references "in essentially the same way for its [IPR] challenges and its invalidity defenses in the [ITC] investigation" which weighed against institution); *Stanley Black & Decker, Inc. v. Zircon Corp.*, IPR2020-01572, Paper 10 at 12-18 (Apr. 19, 2021) ("ITC investigation will have been complete in its entirety…almost three months before the" FWD, "the [ITC] references and combinations alleged to invalidate" were identical in the IPR, and "[t]he [ITC] grounds of invalidity…include[d] those in the Petition, as it [was] incorporated by reference," which weighed against institution)).

[18] DD-Brief, 15 (citing *MaxLite, Inc. v. Jiaxing Super Lighting Elec. Appliance Co.*, IPR2020-00208, Paper 32 at 8 (Oct. 12, 2021) (denying patent owner's request for rehearing of the Board's decision reversing institution denial)).

is 772 days). The Board has considered this statistic in the *Fintiv* analysis, noting: "that a jury trial may occur in the district court before any Final Decision would be due here does not guarantee the entry of final judgment by the district court" in that same timeframe "as the district court litigation may still need to continue with a damages trial and post-trial motions." *See, e.g., Provisur Techs., Inc. v. Weber Food Tech. GmbH*, IPR2024-00269, 2024 WL 2978288, at *12 (PTAB June 13, 2024) (concurrence) (citation omitted).[19] Accordingly, the nearly four months that it will take for Judge Gilstrap to evaluate post-trial briefing and issue a final judgment must also be accounted for in evaluation of this factor.

Therefore, this factor weighs against discretionary denial.

C. Factor 3: There Is Significant Work Remaining

This factor weighs against discretionary denial because "a significant portion of work remains to be done in the district court proceeding." *Protect Animals With Satellites LLC v. OnPoint Sys., LLC*, IPR2021-01483, Paper 11 at 14-15 (Mar. 4, 2022). The parties have only just completed claim-construction briefing with a

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[19] *See also id.* at *6 ("post-trial briefing…could be extensive, given the number and variety of issues in that proceeding" and "delay final judgment"); *Microchip Tech. Inc. v. Bell Semiconductor, LLC*, IPR2021-00147, Paper 20 at 9 (May 14, 2021) (considering for factor 2 the proximity of a FWD issuing to "conclusion of the district court trial (including post-trial briefing that typically takes 1-2 months)"); *Microchip Tech. Incorp. v. Bell Semiconductor, LLC*, IPR2021-00148, Paper 19 at 11 (May 14, 2021) (same).

Markman hearing recently rescheduled from May 15 to June 17 (EX1088, 8); the parties have not yet begun expert discovery, which is currently scheduled to be completed on July 17; and dispositive motions are not scheduled to be filed until July 28. EX1089, 3. It is possible that the case and trial schedule may be further adjusted in light of Samsung's mandamus petition. The Board has found this factor to weigh against discretionary denial under similar circumstances.[20]

Mullen argues that "Petitioners waited more than 11 months from the time the district court complaint was filed to submit the Petitions" and therefore was not "diligent." DD Brief, 18 (citing *Verizon Business Network Servs., Inc. v. Huawei Techs. Co.*, IPR2020-01141, Paper 12 (Jan. 14, 2021)). But Mullen's district-court complaint asserted ***nine patents*** against Samsung, which collectively contain ***378 claims***. And Mullen's infringement contentions, served on Samsung nearly four

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[20] *See, e.g., Juniper Networks, Inc. v. Portsmouth Network Corp.*, IPR2024-00893, Paper 12 at 14 (Dec. 11, 2024) ("[T]he *Markman* hearing has not yet occurred and no claim construction order has been issued by the district court, fact discovery is still ongoing, and expert discovery has not yet begun."); *Toyota Motor Corp. v. Emerging Automotive LLC*, IPR2024-00786, Paper 11 at 47 (Oct. 22, 2024) ("Fact and expert discovery are ongoing…. Claim construction briefs have not been filed and the Markman Hearing is scheduled for January 16, 2025. This factor weights against discretionary denial.") (citation omitted); *AGIS Software Dev. LLC v. Google LLC*, No. 2:19-CV-00359-JRG, 2021 WL 465424, at *3 (E.D. Tex. Feb. 9, 2021) (Judge Gilstrap noting that even "with discovery complete, pretrial briefing submitted, and jury selection pending—***there remain significant resources yet to be expended by the parties***, including at the pretrial conference and preparations leading up to an actual trial of this case").

months after the complaint, ***asserted 272 claims involving over 650 pages of claim charts***. EX1067. Given that nearly 75% of the total claims across all of the patents were asserted in the infringement contentions, Petitioners were not able to meaningfully down-select what they challenged in the IPR. Thus, Petitioners expeditiously prepared and filed twelve IPR petitions challenging 343 claims across all nine patents[21] between September 30 and December 30, 2024, within 5-8 months of receiving Mullen's infringement contentions. It is this timing, between when Petitioner became "aware of the claims being asserted" vis-à-vis the infringement contentions and the filing the IPRs, that the Board considered for diligence in *Verizon*—not the timing between the filing of the complaint and the IPRs, as Mullen asserts. IPR2020-01141, Paper 12 at 12 ("We credit Petitioner's diligence in filing the Petition in this case within a short time (less than three months) ***after being served infringement contentions in the parallel case***.").

Indeed, the Board has expressly found that comparable time periods between infringement contentions and IPR filings were diligent. *See, e.g., Zynga Inc. v. IGT*, IPR2022-00199, Paper 11 at 15-16 (June 14, 2022) (determining petitioner acted reasonably diligently when it filed its petition approximately five months after receiving initial infringement contentions); *Zynga Inc. v. IGT*, IPR2022-

[21] Google is co-petitioner with Samsung on eleven of the IPRs against eight patents. Samsung is the sole petitioner on IPR2024-01472 against the '633 patent.

00223, Paper 10 at 13-14 (June 7, 2022) (same). Contrary to Mullen's mischaracterization, Petitioners did not "wait" to file these IPRs—the time it took Petitioners to diligently prepare challenges mapping ***343 claims*** was eminently reasonable, and entirely caused by Mullen's vexatious over-assertion of over 250 more claims than it would ever be permitted to actually present at trial in the district court.

This timing is even more reasonable here, where Google is not a party to the litigation, because it allowed Google and Samsung to prepare a single petition on each claim set to best conserve the Board's resources. *See IQE PLC v. Cornell Research Foundation Inc.*, IPR2024-00609, Paper 9 at 11 (Sept. 13, 2024) (disagreeing that "Petitioner was not diligent in filing its Petition" when Petitioner was not "sued in, and is not a party to," the parallel litigation). If Google had filed its own separate petition, *Fintiv* would not have applied to it. *Google LLC v. Multimodal Media LLC*, IPR2024-00053, Paper 10 at 8 (June 5, 2024) ("*Fintiv* does not apply to Google and, even if applied, the *Fintiv* factors weigh[] against denial."). Applying *Fintiv* to Google here would thus perversely penalize both Google and Samsung for filing one petition rather than two on each patent.

Finally, if Mullen seeks to avoid unnecessary work for itself and the district court in view of a parallel IPR, this is entirely within Mullen's control. Patent owners can and routinely do agree to stay the parallel district-court litigation post-

institution of IPR proceedings by the Board and these joint requests are invariably granted, including in EDTX.[22] If a litigation stay is still opposed by Mullen after institution, any inefficiencies should be weighed against Mullen for refusing to agree to stay the case, not Petitioners.

Therefore, this factor weighs against discretionary denial.

D. Factor 4: No Overlap

1. Only One Challenged Claim Overlaps

Mullen argues that "Petitioners challenge most of the same claims in their Petition…that they do in their invalidity contentions at the district court." DD-Brief, 19 (citing EX2014, 2)). This is a red herring and has the issue backwards. Petitioner Samsung's IPR petitions and invalidity contentions responded to the claims ***that were asserted by Mullen*** in the district court, where—under EDTX P.R. 3-3 and 3-4—Samsung had an obligation to disclose every single theory that it may possibly assert in the district-court litigation many months before it filed its IPR petitions, or otherwise those arguments would be deemed waived.

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[22] *See, e.g., Molecular Loop Biosciences, Inc. v. Illumina, Inc.*, No. 1:24-cv-00680, Dkt. 39 (D. Del. Feb. 6, 2025); *Orca Security Ltd. v. Wiz, Inc.*, No. 1:23-cv-00758, Dkt. 233 (D. Del. Jan. 16, 2025); *EyesMatch Ltd. v. Samsung Elecs. Co.*, No. 2:23-cv-00363-JRG, Dkt. 60 (E.D. Tex. Dec. 19, 2024); *Flip Phone Games Inc. v. PLR Worldwide Sales Ltd.*, No. 2:23-cv-00139-JRG, Dkt. 138 (E.D. Tex. Dec. 10, 2024); *Athalonz LLC v. Under Armour, Inc.*, No. 2:23-cv-00193-JRG, Dkt. 77 (E.D. Tex. Sept. 13, 2024); *Fendgo LLC v. Samsung Elecs. Co.*, No. 2:23-cv-00221-JRG, Dkt. 55 (E.D. Tex. June 14, 2024); *Datanet LLC v. Dropbox Inc*., No. 3:24-cv-01972, Dkt. 149 (N.D. Cal. May 15, 2024).

Moreover, the proper consideration is the number of claims that these IPRs challenge that will ***never*** be addressed by the district court. This Petition covers all claims of the '218 patent, whereas ***only one claim*** (claim 11) is currently set to be addressed by the district court. EX1085. Thus, ***95% of the '218 patent's claims will only ever be addressed by the Board***, and there is no potential for overlap on these claims.[23] Thus, the fact that 95% of the '218 patent's claims will only ever be addressed by the PTAB, coupled with Samsung's *Sotera* stipulation, ensures that IPR is a "true alternative" forum to address issues that will not, and cannot, be addressed elsewhere. *Palo Alto*, IPR2021-01149, Paper 8 at 12-14. And because

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[23] *See, e.g., Hewlett Packard Enter. Co. v. Cobblestone Wireless, LLC*, IPR2024-00707, Paper 17 at 49 (Sept. 24, 2024) ("Because…the Petition challenges additional claims not at issue in the district court case, we find that this factor weighs in favor of institution."); *Google LLC v. Proxense, LLC*, IPR2024-00232, IPR2024-00233, Paper 10 at 31-32 (July 24, 2024) ("Petitioner also argues that the Petition challenges significantly more claims than the claims at issue in the Texas case…. As Patent Owner's allegation of potential overlap is largely speculative and is somewhat mitigated by Petitioner's stipulation, this factor weighs against exercising our discretion to deny."); *Samsung Elecs. Co. v. MyPAQ Holdings Ltd.*, IPR2022-00307, Paper 10 at 12-13 (May 23, 2022) ("Petitioner states that it 'has challenged more claims than asserted…in district court'…. Thus, for all of the foregoing reasons, we determine that the fourth *Fintiv* factor weighs against discretionary denial of institution." (citation omitted)); *Palo Alto Networks, Inc. v. Centripetal Networks, Inc.*, IPR2021-01149, Paper 10 at 10-11 (Feb. 22, 2022) ("Taking into account the stipulation and the number of claims challenged in this proceeding that will not be addressed by the district court, …this factor weighs against exercising our discretion to deny."); *Vudu v. Ideahub*, IPR2020-01688, Paper 16 at 14-15 (Apr. 19, 2021) (same).

of statutory estoppel, this efficiency accrues whether Mullen or Petitioners ultimately prevail.

Mullen's stipulation not to assert dropped claims against Samsung (DD-Brief, 20) does not resolve the issue because Mullen has not made the same assurances against co-Petitioner Google, or any of Petitioners' customers. Nor has Mullen offered a license and covenant not to sue, which would finally exhaust the risk of claims against the Petitioners.

Mullen further argues that "Petitioners even rely on the same primary references in the Petition as they do in the parallel district court litigation." DD-Brief, 19 (citing EX2014, 99-100). Here, too, the fact that Samsung was obligated under EDTX P.R. 3-3 and 3-4 to identify all possible prior art to preserve its defenses months before its Petitions were filed should not be held against Petitioners' IPRs now. Indeed, the very purpose of disclosing invalidity contentions early in the litigation is for the parties to provide notice of and preserve their right to make arguments, not to set out the exact arguments that will ultimately be presented at trial, which happens much later.[24]

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[24] *See, e.g., Correct Transmission, LLC v. Nokia of Am. Corp.*, No. 2:22-CV-00343-JRG-RSP, 2024 WL 1289821, at *3 (E.D. Tex. Mar. 26, 2024) ("This Court's Patent Rules mandate invalidity contentions to provide fair notice of a party's invalidity case and do not require a party to prove their invalidity case in the contentions."); *Smart Path Connections, LLC v. Nokia of Am. Corp*., No. 2:22-

It is routine, expected, and in many cases required by Judge Gilstrap that the parties' initial arguments from their contentions be narrowed at various stages during the litigation leading up to trial.[25] For example, the DCO in the EDTX litigation requires Samsung to disclose its final prior-art references and combinations seven days before jury selection. EX1089. Samsung should not be penalized by the Board for following the Court's rules on invalidity contentions. Moreover, as discussed above, Mullen has already substantially narrowed the asserted claims in the litigation since the parties filed their initial contentions such that over 95% of the '218 patent's claims will only ever be addressed in the IPR.

CV-0296-JRG-RSP, 2024 WL 1096138, at *4 (E.D. Tex. Mar. 13, 2024) (same); *GREE, Inc. v. Supercell Oy*, No. 2:19-CV-00070-JRG-RSP, 2020 WL 6731050, at *3 (E.D. Tex. Aug. 14, 2020) ("Indeed, one of the desired outcomes of discovery and a result of expert reports is the crystallization of invalidity and infringement theories preserved in a party's contentions."); *Kroy IP Holdings, LLC v. AutoZone, Inc.*, No. 2:13-CV-888-WCB, 2014 WL 7463099, at *4 (E.D. Tex. Dec. 30, 2014) ("Invalidity contentions are procedural tools for providing notice of a party's specific theories of invalidity[.]"); *Crocs, Inc. v. Effervescent, Inc.*, No. 06-CV-00605-PAB-KMT, 2017 WL 5171332, at *2 (D. Colo. Nov. 8, 2017).

[25] *See, e.g., Personalized Media Commc'ns, LLC v. Google LLC*, No. 2:19-CV-00090-JRG, Dkt. 476 at 2 (E.D. Tex. Jan. 26, 2021) ("Almost every case is narrowed from both sides of the docket as it moves from pleadings to discovery to trial. The Court's rules contemplate just such a progression."); *Video Sols. Pte. Ltd. v. Cisco Sys., Inc.*, No. 2:23-CV-00222-JRG, Dkt. 223 at 1 (E.D. Tex. Jan. 17, 2025); *Content Guard Holdings, Inc. v. Amazon.com, Inc.*, No. 2:13-CV-1112-JRG, Dkt. 456 at 20 (E.D. Tex. Mar. 19, 2015).

That combined with Samsung's *Sotera* stipulation significantly reduces the overlap between proceedings.

Mullen cites a string of cases to support its argument that the Board should deny institution notwithstanding Samsung's *Sotera* stipulation, but those relate to instances where there was complete overlap between the asserted claims and the claims challenged in the IPR, or there was nearly a year-long gap between trial and the FWD, which weighed in favor of denial.[26] Here, the gap between trial and the FWD is eight months, substantial work remains in the parallel litigation, and Petitioners are challenging significantly more claims in the IPRs than are asserted in the district court litigation.

2. Samsung's *Sotera* Stipulation

Petitioner Samsung filed a *Sotera*-type stipulation in this matter. EX1079. Recent USPTO decisions and FAQs suggesting this is no longer sufficient likely violate due process, are arbitrary and capricious, involve improper substantive rulemaking, and do not respect Congress's legislative choices in passing the AIA.

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[26] DD-Brief, 19-20 (citing *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3 (Mar. 28, 2025) (11-month gap between trial and FWD); *SAP Am. Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 9 (Apr. 7, 2025) ("all claims being contested as invalid in the Litigation are also subject to a challenge in the Petition")), 28-29 (citing *Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00333, Paper No. 12 at 6, 10-11 (July 7, 2021) (11-month gap between trial and FWD)).

Mullen argues that "even when a petitioner files a purported '*Sotera*' stipulation, it is not dispositive of whether the Board should deny institution under *Fintiv*." DD-Brief, 29. As an initial matter, such stipulations ***were dispositive*** between Director Vidal's June 21, 2022 guidance memorandum ("the Vidal Memo")[27] until February 28, 2025, when the USPTO withdrew the Vidal Memo. Petitioners operated under the Vidal Memo's binding guidance when preparing and filing this and the other petitions in response to Mullen's assertion of several hundred patent claims. Respectfully, it would be a violation of Petitioners' due-process rights to apply this change ***retroactively*** to deny this Petition based on the EDTX trial date when Petitioner relied on the rules as they existed at the time Petitioner drafted and filed its Petition. *See* Petitioner's Request for Rehearing of Order Granting Director Review, *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 20 at 5-10 (Mar. 28, 2025) ("Motorola Rehearing Request").

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[27] USPTO, "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" (June 21, 2022), available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf, at 3 ("[T]he PTAB ***will not discretionarily deny institution*** in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.").

In any event, whether dispositive or not, consistent decision-making requires that *Sotera*-stipulations be considered sufficient here. *Sotera* is still precedential, and dictates that such a stipulation "weighs ***strongly in favor of not exercising discretion***…under 35 U.S.C. §314(a)." *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (Dec. 1, 2020) (precedential). Indeed, many recent decisions granting institution of IPR petitions confirm that *Sotera* stipulations continue to be valid, enforced, and given weight in the *Fintiv* analysis for factor 4.[28] And, between December 17, 2020, when *Sotera* was designated precedential by then-Director Iancu and the June 21, 2022 Vidal Memo, the vast majority of Board decisions did not exercise discretion to deny institution based on *Fintiv*.[29]

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[28] *See, e.g., Samsung Elecs. Co. v. Harbor Island Dynamic LLC*, IPR2024-01403, Paper 9 at 39 (Mar. 24, 2025); *Samsung Elecs. Co. v. Harbor Island Dynamic LLC*, IPR2024-01405, Paper 9 at 36 (Mar. 24, 2025); *Samsung Elecs. Co. v. Headwater Rsch. LLC*, IPR2024-01407, Paper 9 at 8 (Mar. 20, 2025); *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01433, Paper 13 at 12 (Apr. 7, 2025); *MediaTek Inc. v. ParkerVision, Inc.*, IPR2025-00030, Paper 9 at 21-22 (Mar. 31, 2025); *Home Depot*, IPR2024-01420, Paper 12 at 48; *Home Depot USA, Inc. v. RavenWhite Sec. Inc.*, IPR2024-01316, Paper 12 at 12 (Mar. 24, 2025); *Deltran USA, LLC v. The Noco Co.*, IPR2024-01219, Paper 8 at 18 (Mar. 19, 2025); *Palo Alto Networks, Inc. v. Croga Innovations Ltd.*, IPR2024-01421, Paper 8 at 12-13 (Mar. 14, 2025); *Canadian Solar Inc. v. Maxeon Solar PTE Ltd.*, IPR2024-01040, Paper 13 at 17 (Jan. 14, 2025).

[29] Of the 57 cases in which a *Sotera*-stipulation was filed during that time period, institution was granted in 52 cases. All five cases where institution was denied are distinguishable: four are the *Cisco v. Estech* cases, discussed *supra* at n.26, where there was an 11-month gap between trial and the FWD (IPR2021-00329, -00331, -

To be sure, newly promulgated FAQ 14[30] is inconsistent with long-standing precedent:

> The Director will take into account whether the stipulation ***materially reduces overlap*** between the proceedings. ***Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful*** because the efficiency gained by any AIA proceeding will be limited.

But, assuming this is binding guidance, it cannot be reconciled with the letter or spirit of the still-precedential *Sotera* decision.

Samsung's *Sotera* stipulation—indeed any correctly formulated *Sotera* stipulation—should be dispositive in most circumstances. Fundamentally, Samsung has already agreed that it will not raise in district court any grounds that it raised or reasonably could have raised in the IPR.[31] The scope of the stipulation is coextensive with that of the estoppel statute by design. *Compare* EX1079 ("[If

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00332, and -00333), and the last case is *Immersion Sys. LLC v. Midas Green Techs., LLC*, IPR2021-01176, Paper 16 at 16-17 (Jan. 6, 2022), where the *Sotera*-stipulation was found insufficient because it was contingent upon completion of the IPR proceeding with a FWD and tied to an asserted likelihood of the court granting a stay in the litigation. *See also* EX1096.

[30] USPTO, "FAQs forInterim Processes for PTAB Workload Management," FAQ #14, available at https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management.

[31] The '218 patent was never eligible for PGR.

instituted,] Samsung will not pursue in the above-captioned litigation any grounds that were raised or reasonably could have been raised in the IPR.") *with* 35 U.S.C. §315(e)(2) ("[Upon a final written decision, the petitioner may not assert invalidity] on any ground that the petitioner raised or reasonably could have raised during that inter partes review"). *Sotera* effectively brings IPR estoppel forward to the point of institution. *See* EX1090, 2 ("Sotera stipulations serve to assure [that], if the PTAB institutes the IPRs, the Patent Challenger will not pursue estopped invalidity theories in the district court as the parallel litigation proceeds.").

It is for this reason that the Board recognized that *Sotera* fully addresses the issue of overlap. *See Philip Morris Prods., S.A. v. RAI Strategic Holdings*, IPR2020-01094, Paper 9 at 22-23 (Jan. 25, 2021) (noting that "one way for a petitioner to ***avoid overlap***, inefficiency, and the possibility of conflicting decisions is to provide a [*Sotera*] stipulation. … Petitioner's decision ensures that an *inter partes* review is a '***true alternative***' to the ITC investigation."). That is because grounds that include device and system art based on an on-sale bar or public use can ***never*** be reasonably raised in an IPR. *See* 35 U.S.C. §311(b) ("A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent…***only on the basis of prior art consisting of patents or printed publications***.").

Therefore, by filing a *Sotera*-stipulation, Samsung has already agreed to be bound to the full scope of statutory estoppel under §315(e)(2) upon IPR institution and ensures that the IPR is a true alternative—as much as it can be under the statute. Contrary to Mullen's argument, there is simply no reasonable or sound basis for forcing Samsung and others to consent to estoppel greater than the AIA implementing statutes allow for. Forcing parties to do so by suggesting so in new FAQs undermines the Congressional intent limiting the scope of IPR challenges that the Federal Circuit explained in the recent precedential decision *IOENGINE, LLC v. Ingenico, Inc.*, --- F.4th ---, No. 23-1367, slip op. at 12 (Fed. Cir. May 7, 2025) ("Congress intentionally limited an IPR's scope to invalidity challenges based on 'prior art consisting of patents or printed publications.'").[32]

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[32] *See also, e.g., Microchip Tech. Inc. v. Aptiv Servs. US LL*C, No. 1:17-CV-01194-JDW, 2020 WL 4335519, at *4 (D. Del. July 28, 2020) ("As the plain language of [35 U.S.C. §311(b)] makes clear, petitioners for IPR can only raise invalidity grounds based on patents and printed publications. They cannot raise physical device prior art."); *Singular Computing LLC v. Google LLC*, 668 F. Supp. 3d 64, 70 (D. Mass. 2023) ("A petitioner in an IPR proceeding cannot challenge the validity of a patent based on prior-art products or systems."); *Altria Client Servs. LLC v. R.J. Reynolds Vapor Co.*, No. 1:20-CV-472, 2022 WL 2757481, at *10 (M.D.N.C. July 14, 2022) ("The PTAB also did not have prior art products before it as this Court does because the PTAB may only base invalidity decisions on prior art patents and printed publications."); *Clearlamp, LLC v. LKQ Corp.*, No. 12-CV-2533, 2016 WL 4734389, at *9 (N.D. Ill. Mar. 18, 2016), judgment entered, 2016 WL 7013478 (N.D. Ill. Nov. 30, 2016) ("[U]nlike in district court litigation, products cannot be offered as prior art during inter partes review."); *Wi-LAN Inc. v. LG Elecs., Inc.*, 421 F. Supp. 3d 911, 922 (S.D. Cal. 2019) ("In an IPR, a petitioner

Respectfully, suggesting Petitioner waive defenses beyond the statutory estoppel's requirement also does not make any sense. Recent USPTO FAQ 14 stating that *Sotera*-stipulations may not be particularly meaningful is based on the misguided notion that such stipulations serve efficiency only if they "ensure that [the] IPR proceeding[] would be a '***true alternative***' to the district court proceeding." *Motorola Sols.*, IPR2024-01205, Paper 19 at 3-4 (granting Director Review). But, what "ensures" the IPR is a "true alternative" is now a moving target. For example, *Sotera* itself said its stipulation ensures that an IPR is a "true alternative." *Sotera*, Paper 12 at 19 ("Accordingly, Petitioner's broad stipulation ensures that an inter partes review is a '***true alternative***' to the district court proceeding.").

There is nothing new about district-court litigation that justifies the reasoning of FAQ 14 and *Motorola Sols*. *Sotera*-stipulations are as much a true alternative now as they were then. The new FAQs undermine four years of *Sotera*-

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is limited to challenging patent claims as invalid only on grounds 'that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.' 35 U.S.C. § 311(b)."); *Netlist, Inc. v. Micron Tech., Inc.*, No. 2:22-CV-203-JRG-RSP, 2024 WL 402181, at *1 (E.D. Tex. Jan. 10, 2024), report and recommendation adopted, 2024 WL 387787 (E.D. Tex. Jan. 31, 2024) (same); *Gen. Access Sols., Ltd. v. Sprint Spectrum LLC*, No. 2:20-CV-00007-RWS, 2021 WL 5154085, at *3 (E.D. Tex. July 21, 2021) (same); *CliniComp Int'l, Inc. v. Athenahealth, Inc.*, No. A-18-CV-00425-LY, 2020 WL 7011768, at *2 (W.D. Tex. Oct. 28, 2020) (same).

based precedent and stand to thwart Congressional intent by ensuring certain district courts are IPR-proof;[33] and this new "true alternative" requirement to have one forum and one forum only lacks any limiting principle. A stipulation ensuring a "true alternative" to district court would force a would-be petitioner to not only stipulate away all prior-art defenses, as Motorola recently proposed (*see* Motorola Rehearing Request at 9-11 (offering to stipulate to no prior-art defense at trial)), but also to stipulate away all its statutory defenses, including §101 and §112, obviousness-type double patenting, and other non-statutory defenses, none of which can be raised in an IPR, leaving petitioners without any check on district-court plaintiffs.[34] To paraphrase the Supreme Court, Congress surely did not hide this elephant in the mousehole of §314(a)'s use of the word "may." *Cf. Whitman v. Am. Trucking Ass'ns, Inc.*, 531 U.S. 457, 468 (2001) (Scalia, J.).

The Federal Circuit has recently addressed the scope of estoppel and explained that it only applies to a petitioner's invalidity assertions in district court under §102 or §103 based on patents and printed publications, but does not

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[33] *See* EX1097, 1 ("[T]he Patent Trial and Appeal Board has denied dozens of petitions by citing upcoming trials, mostly in the Eastern District of Texas.").

[34] *See* EX1098, 22 ("A stipulation not to raise prior art in district court can badly skew damages awards—it allows a plaintiff to misrepresent an incremental invention as a pioneering one. It also tends to distort claim construction allowing a patent owner to advance broad constructions that it otherwise would avoid because they read on prior art.").

preclude on-sale or public use assertions. *See IOENGINE*, No. 23-1367, slip op. at 15-16. This refutes Mullen's argument that it will be prejudiced if institution is not denied, notwithstanding Petitioner Samsung's *Sotera* stipulation, because Samsung's "device art" "is cumulative of and materially identical to patents or printed publications that could have been raised in this IPR" and its invalidity contentions "include many invalidity grounds combining the 'device art' or 'system prior art' with the same references in this IPR." DD-Brief, 33. The Federal Circuit's precedential decision makes clear that IPRs were never intended to supplant district-court invalidity grounds based on such device art, by design. Mullen further argues that Samsung's ability to assert device art in the litigation diminishes the value of Samsung's *Sotera* stipulation and prejudices Mullen because the courts "inconsistently apply [the] language" of the stipulation in the estoppel context. DD-Brief, 32. But this speculative problem is one that district courts can and do address, and it reflects Congress's intent to limit §315(e)(2) prior art.

Moreover, Mullen's inconsistency argument has been consistently rejected by the Board. *See, e.g., Meta Platforms, Inc. v. Eight KHZ, LLC*, IPR2023-01003, Paper 9 at 11-12 (Jan. 9, 2024) (rejecting that the "right to assert overlapping system art in the district court" risks inconsistent outcomes because it "essentially attacks the reasoning of *Sotera* itself" despite *Sotera* remaining binding precedent);

Philip Morris, IPR2020-01094, Paper 9 at 22-23. To be sure, in theory, there may be gray areas where some system art may have been capable of forming viable IPR grounds based solely on art under §311(b); but, respectfully, this is an issue for the courts to address as they already do, not for the USPTO to police with ever more burdensome restrictions on petitioners to access IPRs. *See Dell, Inc. v. Universal Connectivity Techs.*, IPR2024-01479, Paper 11 at 7-8 (Apr. 7, 2025) (rejecting patent owner's argument regarding use of system art at trial; "[O]ur evaluation at this juncture is based on the facts before us, not on how Petitioner might challenge the validity of the patent at trial.").

The only device art still at issue in Samsung's litigation—BenefonEsc! and gpsOne—are not "cumulative of and materially identical to patents or printed publications that could have been raised in this IPR" under §311(b). DD-Brief, 33. None of the prior art in this IPR is alleged to be describing BenefonEsc! or gpsOne. In the district court, for BenefonEsc!, Samsung has obtained the physical devices and witness testimony from the CEO of the phone's U.S. distributor regarding how the device works. For gpsOne, Samsung has obtained non-public documents and source code to describe how the device works. These types of

evidence, which could not have been raised in the IPRs, are precisely the types of evidence that the ***courts*** consider in determining whether estoppel applies.[35]

Moreover, while Mullen argues that "many comments in response to the former Director's recent request for public comment noted that…a stipulation (even if a 'true' *Sotera* stipulation) is merely one factor to consider" (DD-Brief, 28-31 (citing EX2021-EX2025)), many other comments note that *Sotera* stipulations are the exact solution to the parallel-proceeding concerns animated by *Fintiv*. For example, C4IP "has discussed at length additional reasons for supporting the use of *Sotera* stipulations." EX1091, 3. Specifically, C4IP noted:

> On the merits, C4IP continues to believe that the Office should discretionarily deny petitions where there is parallel district court or ITC litigation unless the petitioner files a *Sotera* stipulation, for both PGR and IPR proceedings. ***As the Office noted in the ANPRM, "A***

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[35] *See, e.g., Medline Indus., Inc. v. C.R. Bard, Inc.*, No. 17-cv-7216, 2020 WL 5512132 at *5 (N.D. Ill. Sept. 14, 2020) (Bard not estopped because its claim charts were "replete with photographs of the [] products themselves … as opposed to documents describing the products" so these were not "patent- or printed publication-based invalidity theories in disguise"); *Clinicomp*, 2020 WL 7011768 at *2 (defendant not estopped where it "relie[d] extensively on non-public documents or information that Athenahealth necessarily could not have used in the IPR proceedings"); *Microchip Tech.*, 2020 WL 4335519, at *4 (Aptiv not estopped; "[Microchip] wants the Court to dig into the substance of Aptiv's references and determine that the physical devices do not add anything beyond the written references. Yet Aptiv's expert will testify that the combination is significant. The Court has no basis to disregard such testimony and disregard those references.").

> ***significant advantage of a* Sotera *stipulation is that it effectively minimizes concerns related to the overlapping issues and duplicative efforts that may result from parallel district court litigation."*** C4IP agrees and has discussed at length additional reasons for supporting the use of *Sotera* stipulations in C4IP's ANPRM comments, which are attached to this submission and incorporated by reference here.

Id. Similarly, Innovation Alliance noted that:

> *Sotera* stipulations…best effectuate the AIA's intent that IPRs would be "quick and cost effective alternatives to litigation" and not "tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent." … Indeed, ***the* Sotera *stipulation solution is the only one that makes the PTAB an alternative to district court*** litigation, rather than an additional tool for invalidating a patent.

EX1092, 5-6 (citing H.R. Rept. 112-98 (June 1, 2011), 48). Many other commenters echoed similar support because, if accepting the premise upon which *Fintiv* was decided, *Sotera* stipulations make sense.[36]

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[36] *See* EX1093, 2-3, AbbVie (

> [A] Sotera stipulation, which prevents a petitioner from using any reference or relying on any ground that reasonably could have been raised (even if was not actually raised) in an IPR, "effectively minimizes concerns related to the overlapping issues and duplicative efforts that may [otherwise] result." Thus, ***requiring all petitioners to file such stipulations is an elegant solution that prevents PTAB trial proceedings from becoming parallel proceedings***

Therefore, this factor weighs against discretionary denial.

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

Mullen argues that "the fact that Google LLC is an additional co-Petitioner in these IPR proceedings is of no moment" to factor 5 because Google is "voluntarily participating on Samsung's behalf in the district court case." DD-Brief, 21-23. This gets Factor 5 backwards. Google's decision to participate in the IPRs and accept the estoppel consequences based on its relationship to the accused instrumentalities is exactly the reason why Factor 5 weighs in favor of institution. The Board has found under similar circumstances that, at least as to the non-litigant (i.e., Google), this factor weighs against denying institution or is at worst neutral.[37]

Mullen cites *Mylan Labs. Ltd. v. Janssen Pharmaceutics N.V.*, IPR2020-00440, Paper 17 (Sept. 16, 2021), aff'd, 989 F.3d 1375 (Fed. Cir. 2021) for support

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rather than the "quick and cost-effective alternatives to litigation" envisioned by Congress.

); EX1094, 3, Ericsson (similar); EX1095, 5, Nokia (similar).

[37] *See, e.g., Charter Commc'ns, Inc. v. Adaptive Spectrum Signal Alignment, Inc.*, IPR2025-00087, Paper 14 at 14 (May 5, 2025) ("Because [co-]Petitioner Plume is not a party in both proceedings, we find that this factor weighs slightly against exercising discretionary denial."); *VMWare, Inc. v. Proven Networks, LLC*, IPR2021-00196, Paper 11 at 15 (May 21, 2021) ("the presence of [co-Petitioner] VMware, who is not a party to the underlying litigation, weighs against exercising our discretion to deny institution.").

(DD-Brief, 22), but this case is inapposite. In *Mylan*, there were two parallel district-court proceedings at issue—one involving Petitioner Mylan and the other involving an unrelated party, Teva. The trial date in the parallel Teva litigation was one year prior to the FWD deadline for Mylan's IPR. IPR2020-00440, Paper 17 at 14-15. The trial date in the parallel Mylan litigation was also before the FWD deadline. *Id*. at 15. The Board found that factor 5 favored denying institution because petitioner Mylan "is indisputably the defendant in the *Mylan* litigation, which…is reasonably likely to go to trial prior to what would be the mandatory date of the Final Written Decision if we instituted *inter partes* review on this Petition," "Mylan will have the opportunity to fully litigate the invalidity of the [] patent in that case, which is already well underway," and "although the defendant in the *Teva* litigation is unrelated to the Petitioner, … 'the issues [in both the *Mylan* and *Teva* litigations] are the same as, or substantially similar to, those already or about to be litigated'" imminently at the *Teva* trial. *Id*. at 23.

Unlike the *Mylan* case, Google is not a party to the Samsung litigation or any other litigation related to the '218 patent. Therefore, there is no other pending case in which Google may raise its invalidity challenges against the '218 patent.

It would be a denial of Google's due-process rights to deny it access to IPR proceedings, where it is a co-petitioner and accepts the consequences of estoppel. Therefore, this factor weighs against discretionary denial.

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

In already instituting four of Petitioners' IPRs on this family of patents (all sharing the same specification), the Board's merits panel found that "[d]ue to strong merits, this factor weighs against exercising discretionary denial." IPR2025-00018, Paper 14 at 14; IPR2025-00021, IPR2025-00124, Paper 14 at 12; *accord* IPR2025-00019, Paper 14 at 13. This IPR is no different, as discussed further below in Section V.

IV. MULLEN'S OTHER DISCRETIONARY-DENIAL ARGUMENTS ARE MERITLESS

A. The PTAB Has Never Adjudicated the Challenged Claims' Patentability

Mullen's assertion that the PTAB "already adjudicated the validity or patentability" of the challenged claims in Apple's prior IPR2023-00087 is false. DD-Brief, 35. Although Apple filed a petition, no *inter partes* review was instituted, so the challenged claims' patentability was never adjudicated. *See California Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 989 (Fed. Cir. 2022) (explaining that when the PTAB did not "institute[] review on…grounds raised in a petition," this leaves the non-instituted "grounds ***unadjudicated*** on the merits").

A decision denying institution is not an adjudication of ***patentability***—it is merely a "threshold determination under § 314(a) of the question whether ***the petitioner*** has a reasonable likelihood of prevailing" in that IPR. *Thryv, Inc. v. Click-to-Call Techs., LP*, 590 U.S. 45, 56 (2020); 35 U.S.C. §314(a) (institution

decision determines whether "the information presented in the petition…shows that there is a reasonable likelihood that the petitioner would prevail"). That ***Apple's petition*** was found unlikely to prevail does not in any way mean the challenged claims were determined to actually be ***patentable***. It is only "***[u]pon electing to institute inter partes review***" that "the Board conducts a proceeding to evaluate the challenged claims' validity," and only "[a]t the conclusion of the proceeding—if review 'is instituted and not dismissed'" that "the Board 'issue[s] a final written decision with respect to the ***patentability*** of' the challenged claims." *Thryv*, 590 U.S. at 49 (citing 35 U.S.C. §316 and quoting §318(a)); *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 361 (quoting §318(a)). That did not happen in Apple's IPR—because institution was denied, the *inter partes* review did not even commence, and the challenged claims' patentability was not adjudicated, as no "final written decision with respect to the patentability" was issued under §318(a). Moreover, institution denial is "nonappealable" under §314(d); this, too, indicates that no "complete adjudicative process" occurred, as there was not a "full and fair opportunity to litigate" patentability. *See Innovad Inc. v. Microsoft Corp.*, 260 F.3d 1326, 1334 (Fed. Cir. 2001).

This Petition is different from Apple's, and deserves its opportunity to demonstrate to the Board—in the ***first*** IPR to be instituted for adjudication of these claims—that the challenged claims are ***not*** patentable in the least. Mullen's

allegation that this Petition's grounds are "a recycling of the same invalidity grounds" as in Apple's petition (DD-Brief, 35) is facially untrue. Grounds 1-3 here are based on Randall—a reference that the Board has never before considered against the challenged claims—and combines it with Wollrab (which the Board did not consider and the Examiner did not apply in any rejection) or Song (which has not previously been of record). Only Grounds 4-7 rely on Sheha (one of Apple's primary references), and combine it with Wollrab or Song—again, references that were ***not*** presented in Apple's petition. As discussed in this Petition and in Section V below, these references teach what the Board found missing from Sheha in IPR2023-00087, and Mullen's only arguments to the contrary fail to account for the references' cited disclosures, the Petition's explanations, and the proper law of obviousness.

Denying this IPR because Apple's different petition was denied years earlier would be grossly unfair to Petitioners—who had no involvement in and no ability to influence the strength of Apple's showing—and would set a dangerous precedent incentivizing patentees to target seemingly weaker defendants with early lawsuits in order to exhaust the entire industry's one and only chance of attempting IPR before serially targeting other defendants who would have mounted stronger challenges. Encouraging bad patents to flourish in this manner is not what the PTAB should stand for.

B. The Petition's Strong Grounds Are Appropriately Supported by Expert Testimony and Already Addressed Mullen's Claim Constructions

Mullen's allegation that the Petition "attempts to cure deficiencies in the cited references with excessive reliance on conclusory expert testimony" (DD-Brief, 35) is doubly meritless.

First, there are no deficiencies in the cited references. As discussed in Section V below, Mullen only alleges there are deficiencies by ignoring the references' explicit teachings that the Petition cites, ignoring where the Petition provided reasoning explaining the combinations, their motivations and expectations of success, and mistaking the law on obviousness. Mullen cannot invent "deficiencies" by pretending that explicit statements in the references and in the Petition do not exist.

Second, Mullen's allegation that there is "excessive reliance on conclusory expert testimony" is itself utterly conclusory. Mullen's single paragraph making this allegation (DD-Brief, 35-36) provides no shred of reasoning nor any actual citation to demonstrate how the manner in which the Petition purportedly relies on any expert testimony for any specific issue is "excessive." Merely using the adjective "excessive" in a brief to characterize the Petition's reliance on expert testimony does not make it so.

Indeed, as discussed in Section V below, ***none*** of the issues raised by Mullen's merits arguments require the Board to assess the correctness of any expert testimony ***at all*** in order to reject Mullen's arguments as unfounded. The Board need only look at the statements in the prior-art references themselves that are cited and quoted in the Petition, the reasoning spelled out in the Petition that Mullen ignored and failed to address, and black-letter obviousness law, all of which compel the conclusion that there is ***nothing*** nonobvious about the challenged claims.

Mullen's further allegation that the Petition "ignores claim construction issues" (DD-Brief, 36) is baseless. The only claim construction that Mullen's brief proposes is that the "request" in claims 1, 6, and 11 is "from the specific device recited in the claim." DD-Brief, 38-41. Mullen did not raise this claim-construction position in Apple's IPR, and does not explain how Mullen believes the Petition "ignores" it. And, as shown in Sections V.A.2 and V.B.2 below, this claim-construction position does not even matter to this IPR, because the Petition demonstrates (and ***Mullen*** ignores) that even this construction is disclosed by the prior art.

V. THE PETITION'S MERITS ARE STRONG, AND MULLEN'S MERITS ARGUMENTS ARE EXTRAORDINARILY WEAK

This IPR challenges all claims 1-19 of the '218 patent, of which claims 1, 6, 11, and 16 are independent. Mullen's discretionary-denial brief and its POPR

(which merely repeats the same merits arguments as the discretionary-denial brief) only dispute the Petition's merits as to the independent claims.

At their core, the '218 patent's independent claims are similar to the claims of Mullen's other patents for which the Board has already found that the Randall-based and Sheha-based grounds of Petitioners' IPRs present "strong merits" that "weigh[] against exercising discretionary denial." *See* IPR2025-00018, Paper 14 at 14.[38] Mullen's claims all "recite well-known and obvious features of remotely locating a first wireless device from a second wireless device." *Id*. at 13-14.[39] As relevant to the '218 patent's claims, the Board has already found in instituting Petitioners' other IPRs that both Randall and Sheha independently disclose the second device requesting the first device's location from a server, the server providing the first device's location to the second device only if the first device has given permission to the second device, and displaying the first device's location on a map on the second device, along with information including directions to the location.

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[38] *See also* IPR2025-00019, Paper 14 at 13; IPR2025-00021, Paper 14 at 12; IPR2025-00124, Paper 14 at 12.

[39] *See also* IPR2025-00019, Paper 14 at 13; IPR2025-00021, Paper 14 at 11-12; IPR2025-00124, Paper 14 at 12.

The extra elements added in independent claims 1, 6, and 11 of the '218 patent are nothing more than a grab bag of noninventive features that were well-known and obvious for map displays. They include a distance to the mapped location (claims 1, 6, 11), an address (claims 1, 11), a compass and travel time (claims 6, 11), and a directional arrow (claim 6). For any of these features not explicitly discussed in Randall or Sheha, the Petition presents an obvious combination with other prior art. The only one Mullen attempts to dispute is for the "travel time" recited only in claims 6 and 11; and that dispute is meritless as discussed in Sections V.A.4 and V.B.4 below.

The element of claims 1, 6, and 11 that the Board found missing from Sheha in Apple's previous IPR is the showing of two locations representing two other devices on the displaying device's screen. The Board found that "Sheha teaches displaying the location of one target device" on the requesting device, but not two target devices. IPR2023-00087, Paper 10 at 17. This Petition demonstrates that displaying two or more target devices' locations is explicitly taught by Wollrab and would have been obvious in combination with Randall or Sheha. Petition (Paper 4), 7-10, 20-22, 50-51, 58-60. The Board has not previously considered Wollrab; and the Examiner in prosecution never applied Wollrab in any rejection, and did not have Randall or Sheha and thus never considered Wollrab in combination with either of them. Petition, 86-87. The combinations of Wollrab

with Randall or Sheha are strong, and Mullen does not dispute that Wollrab discloses the recited feature. Mullen only attempts to attack the combination by ignoring and failing to address pages of explanation in the Petition.

Independent claim 16 recites, instead of the miscellaneous map features of claims 1, 6, and 11, a feature where a user can use the same login and password on two ("first" and "second") devices. This Petition demonstrates that this feature is explicitly taught by Song—another reference that has not previously been before the Office—and would have been obvious in combination with Randall or Sheha. Petition, 40-47, 79-83. As discussed below in Sections V.A.5 and V.B.5, Mullen's scattershot arguments regarding claim 16 do not meaningfully contest that the combination meets this feature via Song's teachings.

The merits arguments in Mullen's brief (and repeated in its POPR) are extraordinarily weak. This is not a run-of-the-mill merits case where there may be reasonable disputes. Mullen's arguments uniformly ignore (and therefore fail to reasonably address) the prior-art disclosures cited, the reasoning presented in the Petition, and black-letter obviousness law. The only supportable conclusion is that the Petition's merits are compelling and strong.

A. The Randall-Based Grounds Are Strong

Grounds 1-3 are based on Randall, which was not in Apple's prior IPR and has not been considered by the Office as to the '218 patent. Randall's disclosure

has a running example where wireless device user Alice shares her information with wireless device user Bob, including her location information. In instituting four of Petitioners' IPRs so far, the Board has found strong merits as to the unpatentability of Mullen's claims relating to a wireless device (like Bob's) accessing and displaying the location of another wireless device (like Alice's). IPR2025-00018, Paper 14 at 14 ("strong merits"), 39; IPR2025-00019, Paper 14 at 13 ("the merits are strong"), 31; IPR2025-00021, Paper 14 at 12 ("strong merits"), 41; IPR2025-00124, Paper 14 at 12 ("strong merits"), 39.

This Petition's grounds on the '218 patent's claims are likewise strong.

1. Undisputed Elements for Claims 1, 6, 11

The Petition demonstrates that Randall itself discloses nearly all limitations of independent claims 1, 6, and 11, with the exception of: displaying a second other device's location in addition to a first other device's location ([1D]/[6D]/[11D]) which is met by the combination with Wollrab; and displaying a target address ([1F]/[11G]), a compass ([6F]/[11F]), a directional arrow ([6G]), and travel time ([6H]/[11H]), which are met by the combination with Obradovich (plus Mura-Smith for [6G]). Petition, 11-26, 30-34, 36-39.

All of this is largely undisputed. As to the combinations, Mullen disputes only the Wollrab combination for [1D]/[6D]/[11D] and the Obradovich combination only as to [6H]/[11H]. Mullen's arguments as to those combinations

are meritless as discussed below. And as to Randall, Mullen only presents arguments as to element [1A]/[6A]/[11A], which facially fail for ignoring Randall's disclosures that the Petition cites.

2. Element [1A]/[6A]/[11A]: Randall Explicitly Discloses Location "Request" from Device; Mullen's Claim Construction Is Irrelevant

Element [1A]/[6A]/[11A] recites a "request" from one device (e.g., Bob's device in Randall) for the location of another device (e.g., Alice's device).[40] Mullen fruitlessly spends four pages of its brief arguing that the claims should be construed to require that "the identified request is made *from* the device" that the Petition maps to Bob's device. DD-Brief, 37-41. This claim-construction argument is irrelevant, because the Petition does not rely on the request being made from a different device. The Petition demonstrates that "Bob's…*device* can *request* to access Alice's…GPS location." Petition, 14.

Mullen's assertion that Randall's "[l]ocation disclosure does not initiate by a request from a device" (DD-Brief, 43) is refuted by Randall's explicit disclosure cited in the Petition. Randall teaches that as Alice's "location" gets "up-dated" on the server, Bob's device accesses it by "polling the server" (EX1007, p. 24 "People

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[40] The requesting device (e.g., Bob's device) is the "first wireless telephonic device" in claim 1 and the "wireless [telephonic] device" in claims 6 and 11. The target device (e.g., Alice's device) is the "second wireless telephonic device" in claim 1 and the "first wireless device" in claims 6 and 11.

tracking")—i.e., "Bob can pull the new data into his device" (*id.*, [0053]), which is a "***request*** (i.e. pull)" of the information from the server (*id.*, [0015]). Bob's device makes this request by "sending various data tags defining its enquiry" to the server, and then "the server passes to Bob's device the information ***it requests***." *Id.*, [0067]. All of this explicit disclosure is cited and quoted in the Petition at 14-15, and Mullen entirely ignores and fails to address it. *See* DD-Brief, 42-44.

Mullen's assertion that "Randall only describes Alice preemptively assigning location rights to Bob" (DD-Brief, 43) is irrelevant. Element [1A]/[6A]/[11A] does not require location access rights to already be assigned or not assigned in order for a device to make a location "request," and neither does Randall. Bob's device can "send[] to the server" a request including Alice's "ADS number" together with "data tags defining" which of Alice's information fields Bob wishes to access (EX1007, [0049], [0067]) before or after Alice has given him access to her location, specifically. If Bob's request comes before Alice has given him location access, the server will not send him Alice's location yet. If Bob's request comes after Alice has given him location access permission, then "the server passes to Bob's device the information it ***requests***." EX1007, [0067].

3. Element [1D]/[6D]/[11D]: Display of Two Other Devices' Locations in Randall-Wollrab Combinations

Mullen argues that Randall does not disclose "depict[ing] *multiple* users on *one* map." DD-Brief, 48 (Mullen's emphasis). But the Petition does not rely on

Randall alone to disclose "on *one* map." The Petition quotes Randall's disclosures of displaying a "group" of users' locations at the same time, which suggests displaying plural devices' locations simultaneously. Petition, 20. Mullen does not dispute this. For displaying those locations on one map, the Petition combines Randall with Wollrab. Petition, 20-22.

Mullen does not dispute that Wollrab explicitly teaches this feature, and instead attempts to attack the combination by ignoring what the Petition says. Mullen's allegation that the Petition "does not explain what specific methodologies of Wollrab are being incorporated into Randall" (DD-Brief, 49) is untrue. The Petition's combination incorporates "Wollrab's techniques" cited at 4:40-58, 5:50-61 of EX1014 (Petition, 10), which had just been discussed on page 7 of the Petition. That those Wollrab techniques disclose displaying a group of devices' locations simultaneously on one map (Petition, 7-8) is undisputed.

Mullen makes a baseless conclusory allegation (without citing or discussing any Petition pages) that the Petition "provide[s] ***no*** supporting evidence or technical reasoning" and "impermissibly commingles the motivation to combine and reasonable expectation of success analyses without distinction or specificity." DD-Brief, 50-51 (Mullen's emphasis). Mullen ignores the Petition's detailed analysis that separately details why "POSAs would have been motivated" and then

why "POSAs would have reasonably expected success" in the combination with Wollrab. Petition, 9-10.

4. Element [6H]/[11H]: Travel Time in Randall-Obradovich Combinations

For element [6H]/[11H], Mullen does not dispute that Obradovich discloses the recited "travel time," and only attempts to attack the combination of Obradovich with Randall, by ignoring what the Petition says and mistaking the law of obviousness.

First, Mullen baselessly alleges that the Petition "fails to explain what the specific combination is" and "fails to explain the specific motivation to combine." DD-Brief, 51, 53. This is untrue; the Petition at 8-9 discusses the specific Obradovich teachings being applied (including to "display…travel times for the…route"), and then at 10-11 discusses both motivation and expectation of success (individually, contrary to Mullen's allegation that the analyses are "commingle[d]"—DD-Brief, 53 (citing only page 34 of the Petition and ignoring pages 10-11 (§VI.D) and its citation on page 33)).

Second, Mullen argues that the combination relies on using "Obradovich's 'process' [that] includes capturing information via a variety of sensors and/or speed detectors in the CRDs along a particular road" (DD-Brief, 52), which is also not true. The Petition need not rely on any specific sensor/speed-detector techniques from Obradovich's specific system implementation for calculating

travel time. The Petition's combination applies, just as a POSA would have, on Obradovich's more generic ***teaching*** to determine and display travel time for a route, based on travel times for the route's segments. Petition, 33-34. It does not matter how Obradovich's system implements the details of the calculations; the Petition demonstrates how Obradovich's teachings about displaying travel time apply generically to Randall's system, as POSAs knew how to calculate travel times as "well-known, conventional background knowledge." Petition, 33-34 (discussing background knowledge corroborated by EX1025 and EX1041).

It is black-letter law that "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (C.C.P.A. 1981); *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1294 (Fed. Cir. 2015); *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1343 (Fed. Cir. 2020). "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR Int'l Co. v. Teleflex, Inc*., 550 U.S. 398, 421 (2007).

Mullen's argument runs afoul of this well-settled law, as the Petition already explained, at pages 70-71 which Mullen's brief ignores.

5. Claim 16

a. Element [16A]

As to [16A], Mullen first incorrectly argues that Randall uses only one "piece[] of information…for identifying Bob," rather than both "a login and password." DD-Brief, 54-55. Mullen ignores and fails to rebut the Petition's explanation that Randall discloses that Bob inputs a "PIN" or question "answer[]" (either of which is a "password") that is used to identify Bob on any device, which teaches that Bob also inputs a login because matching to a login is how such a password identifies "Bob the person." Petition, 42 (discussing EX1007, [0067], [0380]).

Mullen next argues, again incorrectly, that Randall's "server, not the device, performs the identifying" of the user. DD-Brief, 55. As the Petition explained, Randall at [0380] discloses that user "authentication" can be used for access control "locally" at the device. Petition, 42-44. Mullen's argument that "this disclosure is concerned with preventing access to information already accessible on a user's account, not gaining access to newly granted information" (DD-Brief, 55) is both unsupported and irrelevant. Claim 16 does not require the user identification to be used for gaining access to newly granted information.

Additionally, the Petition showed that authenticating the user on the local device would have been obvious in view of background knowledge. Petition, 43,

citing corroborating EX1024, EX1019, EX1029, EX1054, EX1030. Mullen ignores and fails to rebut this showing.

The Petition's combination with Song (Petition, 44) is yet another alternative way [16A] is obvious. Mullen's argument that Song's login information is only accessible locally if previously inputted on the server (DD-Brief, 57) is irrelevant as nothing in claim 16 requires performing [16A] at a time when the login has never before been sent to the server. And Mullen's argument that bodily incorporation of Song's specific implementation details might be too "complex" or require too much "storage" (DD-Brief, 57) runs afoul of black-letter obviousness law as discussed in Section V.A.4 above.

b. Elements [16B]/[16F]

Mullen makes no attempt to explain its conclusory allegation that the Petition's discussion is "wholly irrelevant to the 'recording'" in [16B]/[16F]. DD-Brief, 58. The Petition establishes that Alice's location in Randall is stored (recorded) on the i-server. Petition, 13 (§VI.E.1.a ([1A]), cited at *id*., 44.

c. Elements [16D]/[16I]

[16D] and [16I] recite providing the first and second devices' locations "to a third device" that is "not associated with" the first and second devices' user identification. Mullen's confused arguments do not actually dispute that Randall discloses providing any device's location to another device not associated with the providing device's user. Mullen only argues that [16D]/[16I] are not met for "the

reasons above" that fail as discussed in Section V.A.5.a above, or possibly because Mullen misreads [16D]/[16I] as if they recited providing "user identification" information to other devices (which is not what [16D]/[16I] recite). DD-Brief, 59.

None of Mullen's arguments hold water. The Randall-based grounds are strong and merit institution.

B. The Sheha-Based Grounds Are Strong

Grounds 4-6 combine Sheha with Wollrab for claims 1, 6, and 11 (and with Obradovich for "travel time" in claims 6 and 11), like Grounds 1-2 do for Randall. Ground 7 combines Sheha with Song for claim 16 as Ground 3 does for Randall. The combinations with Wollrab meet the features of claims 1, 6, and 11, and the combination with Song meets the features of claim 16, that the Board found missing from Sheha in Apple's earlier IPR (IPR2023-00087, Paper 10 at 17, 21-25).

1. Undisputed Elements for Claims 1, 6, 11

The Petition demonstrates that Sheha itself discloses nearly all limitations of independent claims 1, 6, and 11, with the exception of displaying a second other device's location in addition to a first other device's location ([1D]/[6D]/[11D]) which is met by the combination with Wollrab. Petition, 51-62, 65-73. As to travel time ([6H]/[11H]), the Petition demonstrated obviousness over Sheha, or alternatively in combination with Obradovich. Petition, 69-71.

Mullen's arguments against the combinations fail in the same ways discussed above. Sheha's teachings are largely undisputed; Mullen only presents arguments as to element [1A]/[6A]/[11A], which facially fail for ignoring Sheha's disclosures that the Petition cites.

2. Element [1A]/[6A]/[11A]: Sheha Explicitly Discloses Location "Request" from Device; Mullen's Claim Construction Is Irrelevant

Just as discussed in Section V.A.2 above as to Randall, Mullen's construction of [1A]/[6A]/[11A] is irrelevant because, even if it were adopted, Sheha meets it. Petition, 51-52, citing EX1005, 4:62-66, 19:3-8 ("receiving, from the communication device of the first user, a request for position information of the second user").

Mullen's assertion that Sheha's "privacy filters" are "indiscriminate as to the identity of any calling mobile device" (DD-Brief, 46) is irrelevant to [6A]/[11A] because these elements recite only a "request" and recite no limitations as to how or why the request is successful. As to [1A] which recites "a permission," nothing in the claim language requires the permission to be specific to the calling device as opposed to a generic permission including the calling device and others. *See* IPR2025-00018, Paper 14 at 17 (Board finding that Mullen's related '418 patent "claim does not recite that the permission is limited to permission for only the second wireless device"). Mullen also only addresses cherry-picked portions of

Sheha (DD-Brief, 45-46), and fails to address Sheha's disclosure that "users can define a group of specific users that have access" (EX1005, 11:63-12:7, cited in Petition, 52).

3. Element [1D]/[6D]/[11D]: Display of Two Other Devices' Locations in Sheha-Wollrab Combinations

As discussed in Section V.A.3 above, Mullen does not dispute that Wollrab explicitly teaches the feature in [1D]/[6D]/[11D], and instead attempts to attack the combination by ignoring what the Petition says.

Mullen's allegation that the Petition's "combination amounts to a conclusory statement to 'do software programming'" (DD-Brief, 49) provides no justification for simply ignoring the rest of the Petition's sentence explaining the combination (Petition, 60), plus the preceding two pages of detailed explanation (*id.*, 58-59), plus the entire "Sheha-Wollrab Combination" section (*id.*, 50-51).

Mullen's argument that Sheha's and Wollrab's specific implementation details are "radically different" (DD-Brief, 49-50) again runs afoul of obviousness law, which does not require bodily incorporation as discussed in Section V.A.4 above.

Mullen's conclusory allegation that the Petition "provide[s] ***no*** supporting evidence or technical reasoning" and "impermissibly commingles the motivation to combine and reasonable expectation of success analyses" (DD-Brief, 50-51, Mullen's emphasis) is again baseless and ignores the Petition's detailed analysis

that separately details why "POSAs would have been motivated" and then why "POSAs would have reasonably expected success" in the combination with Wollrab. Petition, 50-51, 58-60.

4. Element [6H]/[11H]: Travel Time in Randall-Obradovich Combinations

Mullen's arguments regarding [6H]/[11H] and Obradovich are the same for both combinations with Randall and Sheha (DD-Brief, 51-52), and fail as discussed in Section V.A.4 above.

The Petition at 8-9 discusses the specific Obradovich teachings being applied, and then at 64-65 discusses both motivation and expectation of success (individually, contrary to Mullen's allegation that the analyses are "commingle[d]"—DD-Brief, 54).

Mullen's assertion that "the only technology…capable of capturing the necessary information to establish a travel time are the CRDs of Obradovich" (DD-Brief, 53) fails for ignoring and failing to rebut the Petition's showing that "[o]ther obvious implementation options for determining travel time were background knowledge for POSAs, including, e.g., estimating the travel time by simply dividing the route distance by the speed the mobile device is traveling." Petition, 71 (citing corroborating EX1041, EX1067).

5. Claim 16

a. Element [16A]

Mullen's allegation that the Petition does not map [16A]'s "user identification" as well as its "login and password" to Sheha (DD-Brief, 56) is false. *See* Petition, 80 (quoting EX1005, 8:38-50 as disclosing "users' identifications" and "username and password"). Additionally, [16A] does not require the "user identification" to be a separate input. [16A] is met by identifying who the user is ("identify a user identification") "by receiving a login and password."

Mullen's assertion that Sheha does not disclose the user device performing the identifying (DD-Brief, 56) is also untrue. As the Petition explained, Sheha at 5:26-29 discloses that the user "is logged on to [the] wireless…device" before the server. Petition, 80. Mullen's argument that "further verification" by the server is required "prior to a position information disclosure" (DD-Brief, 56) is irrelevant. Claim 16 does not exclude further verification by the server.

The Petition's combination with Song (Petition, 81) is another alternative way [16A] is obvious. Mullen's arguments against Song for [16A] fail as discussed in Section V.A.5.a above.

b. Elements [16B]/[16F]

Mullen makes no attempt to explain its conclusory assertion that Sheha "is silent on recording locations of a user identifications." DD-Brief, 58. The Petition

at 81 provides multiple citations and quotations from Sheha that Mullen does not attempt to address.

c. Elements [16D]/[16I]

Mullen's arguments as to [16D]/[16I] are the same for both Randall and Sheha (DD-Brief, 58-59), and fail as discussed in Section V.A.5.c above.

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All of Mullen's merits arguments are exceedingly weak. The Petition's grounds are strong, and merit institution.[41]

Respectfully submitted,

Date: 2025-05-27

/Elisabeth Hunt/
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WOLF, GREENFIELD & SACKS, P.C.

[41] Petitioners reserve the right to challenge the March 26, 2025 Interim Process for PTAB Workload Management at least because it is legally invalid as (1) exceeding the Director's authority, (2) arbitrary and capricious, and (3) adopted without notice-and-comment rulemaking.

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24, the undersigned certifies that the foregoing **PETITIONERS' OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** contains 13,975 words excluding; a table of contents, a table of authorities, Mandatory Notices under § 42.8, a certificate of service or word count, or appendix of exhibits or claim listing. Petitioners have relied on the word count feature of the word processing system used to create this paper in making this certification.

Date: May 27, 2025

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

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

I certify that on May 27, 2025, a copy of the foregoing document, including any exhibits or appendices filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

Peter F. Snell	PFSnell@mintz.com
Brad M. Scheller	BMScheller@mintz.com

Date: May 27, 2025

/Dara Del Rosario/
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