

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

Case No. IPR2025-00365
U.S. Patent No. 11,234,117 (Claims 1-14, 73-92)

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. BACKGROUND	5
III. ARGUMENT.....	6
A. The Petition Should Be Denied Under <i>Fintiv</i> Because the Underlying District Court Case Will Resolve the Issues Months Prior to Any Final Written Decisions, and Granting Institution Will Create Inefficiency and Greatly Multiply Proceedings	7
1. Factor 1: The District Court Denied Petitioners’ Motion for a Stay and is Highly Unlikely to Issue a Stay Even Were This Petition Instituted.	10
2. Factor 2: The Single District Court Case Will Resolve All of the Issues Presented in the Eleven Petitions Many Months Before Any Final Written Decision.....	14
3. Factor 3: There Has and Continues to be Significant Investment By the Parties in the District Court Litigation.	16
4. Factor 4: There is Significant Overlap Between Issues Raised in the Petition and in the Parallel Proceeding.	18
5. Factor 5: Petitioners and the Defendants in the Parallel Proceeding are the Same Party.	20
6. Factor 6: The Merits of the Petition are Weak.	22
B. The Presence or Absence of a “ <i>Sotera</i> ” Stipulation is of No Moment.....	24
1. The Director Recently Clarified In Court Filings That The Board Retains Discretion To Deny Institution Even When A Purported “ <i>Sotera</i> ” Stipulation Is Filed; Otherwise The Factors Would Violate Statute And Be Unconstitutional	24
2. The Director’s Request For Public Comment Likewise Elicited Strong Support For Treating A <i>Sotera</i> Stipulation As A Non-Dispositive Factor On A Case-By-Case Basis	28

3.	The Specific Facts Here Show That Petitioners’ Purported Stipulation (i) Is Insufficient In View Of The Other Factors That Weigh Heavily Against Institution And (ii) Would Still Leave The Parties Litigating The Same Validity Issues In Both Forums	30
C.	Grounds 1-6 Of The Petition Are Weak on the Merits and Fail To Establish Obviousness of Any Claim	34
1.	Grounds 1, 3, 4, and 6 of the Petition Fail to Establish Obviousness of the Limitation “Instructing Said Remote Server to Change a List of Users on Said Remote Server for a Profile Associated with Said Wireless Telephone that Are Allowed to Access Said Location by Way of Said Remote Server Providing Said Location from Said Remote Server to at Least One of Said Users of Said List of Users, Wherein Each User of Said List of Users Is Representative of One of a Plurality of Wireless Telephones” in Claim 1 and Its Dependent Claims.....	34
2.	Grounds 2, 3, 5, and 6 of the Petition Fail to Establish Obviousness of the Limitation “Providing a Permission for Said Second Wireless Device to Access Location Information About Said Location” in Claim 73 and Its Dependent Claims	48
3.	Grounds 2 and 3 of the Petition Fail to Establish Obviousness of the Limitation “Providing a First Map Provided with Respect to Said Location” in Claim 73 and Its Dependent Claims	55
IV.	CONCLUSION.....	59

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 15 (PTAB May 13, 2020)	20
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)	8, 14, 18, 20
<i>AT&T Servs., Inc. v. ASUS Tech. Licensing Inc.</i> , IPR2024-01142, Paper 14 (PTAB Jan. 27, 2025)	47, 54
<i>Cisco Sys., Inc. v. Estech Sys., Inc.</i> , IPR2021-00333, Paper No. 12 (PTAB July 7, 2021)	28
<i>E-One, Inc. v. Oshkosh Corp.</i> , IPR2019-00161, Paper 16 (PTAB May 15, 2019)	15
<i>Exxon Chem. Patents v. Lubrizol Corp.</i> , 64 F.3d 1553 (Fed. Cir. 1995)	35, 37
<i>Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017)	10
<i>In re Enhanced Sec. Research, LLC</i> , 739 F.3d 1347 (Fed. Cir. 2014)	45, 52
<i>In re Wesslau</i> , 353 F.2d 238 (CCPA 1965)	44, 52
<i>InTouch Techs., Inc. v. VGO Commc'ns, Inc.</i> , 751 F.3d 1327 (Fed. Cir. 2014)	45
<i>Kaken Pharm. Co. v. Iancu</i> , 952 F.3d 1346 (Fed. Cir. 2020)	38
<i>Maxlite, Inc. v. Jiaxing Super Lighting Electric Appliance Co., Ltd.</i> , IPR2020-00208, Paper 32 (PTAB Oct. 12, 2021)	15

<i>Motorola Sols., Inc. v. Stellar, LLC</i> , IPR2024-01205, Paper 19 (PTAB Mar. 28, 2025)	3, 19, 33
<i>Mylan Labs. Ltd. v. Janssen Pharms. N.V.</i> , IPR2020-00440, Paper 17 (PTAB Sept. 16, 2020)	21
<i>MyPort, Inc. v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:22-CV-00114-JRG, Order, Dkt. 73 (E.D. Tex. June 13, 2023)	13
<i>Next Caller, Inc. v. TrustID, Inc.</i> , IPR2019-00961, Paper 10 (PTAB Oct. 16, 2019)	15
<i>Oyster Optics, LLC, v. Infinera Corp.</i> , Case No. 2:19-CV-00257-JRG, Order, Dkt. 87 (E.D. Tex. July 17, 2020)	13
<i>Prolitec Inc. v. ScentAir Techs., LLC</i> , No. 20-984-WCB, 2023 WL 8697973 (D. Del. Dec. 13, 2023)	31, 32, 33
<i>Resonant Sys., Inc. v. Samsung Elecs. Co.</i> , No. 2:22-CV-00423-JRG, Dkt. 83 (E.D. Tex. Mar. 8, 2024), Dkt. 63 (E.D. Tex. Dec. 5, 2025)	13
<i>Samsung Display Co., Ltd. v. Pictiva Displays Int’l Ltd.</i> , IPR2024-00855, Paper 12 (PTAB Nov. 19, 2024)	23, 47, 54
<i>Samsung Display Co., Ltd. v. Pictiva Displays Int’l Ltd.</i> , IPR2024-00855, Paper 13 (PTAB Jan. 10, 2025)	27
<i>Samsung Elecs. Co, Ltd. v. California Institute of Technology</i> , IPR2023-00130, Paper 10 (PTAB May 4, 2023)	22, 47, 54
<i>Samsung Elecs. Co., Ltd. v. Mojo Mobility Inc.</i> , IPR2023-01094, Paper 11 (PTAB Feb. 9, 2024)	14, 15, 19
<i>Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC</i> , IPR2019-01393, Paper 24 (PTAB June 16, 2020)	10
<i>SAP Am. Inc. v. Cyandia, Inc.</i> , IPR2024-01496, Paper 13 (PTAB Apr. 7, 2025)	<i>passim</i>

<i>Satco Prods., Inc. v. The Regents of the University of California</i> , IPR2021-00794, Paper 14 (PTAB Nov. 10, 2021).....	14
<i>SK Innovation Co. v. LG Chem., Ltd.</i> , IPR2020-01036, Paper 13 (PTAB Nov. 30, 2020).....	20
<i>Solas OLED Ltd. v. Samsung Display Co., Ltd.</i> , Case No. 2:19-CV-00152-JRG, 2020 U.S. Dist. LEXIS 125973 (E.D. Tex. July 17, 2020).....	13
<i>Stanley Black & Decker, Inc. v. Zircon Corp.</i> , IPR2020-01572, Paper 10 (PTAB Apr. 19, 2021)	15
<i>TESO LT v. Luminati Networks Ltd.</i> , IPR2021-00249, Paper 12 (PTAB June 2, 2021)	15
<i>Vector Flow, Inc. v. HID Glob. Corp.</i> , IPR2023-00353, Paper 8 (PTAB July 17, 2023).....	22
<i>Verizon Bus. Network Servs., Inc. v. Huawei Techs. Co.</i> , IPR2020-01141, Paper 12 (PTAB Jan. 14, 2021)	18
<i>Verizon Servs. Corp. v. Vonage Holdings Corp.</i> , 503 F.3d 1295 (Fed. Cir. 2007)	39
<i>VLSI Tech. LLC v. Intel Corp.</i> , 53 F.4th 646 (Fed. Cir. 2022)	37
Federal Statutes	
35 U.S.C. § 314(a)	1, 7, 27

TABLE OF EXHIBITS

Exhibit	Description
2001	<i>Samsung Launches SmartThings Find, a New Way to Quickly and Easily Located Your Galaxy Devices</i> , https://news.samsung.com/global/samsung-launches-smarththings-find-a-new-way-to-quickly-and-easily-locate-your-galaxy-devices (October 30, 2020)
2002	<i>Samsung SmartThings Find</i> , https://smarththingsfind.samsung.com/login (accessed January 24, 2024)
2003	Acting Director’s Stewart’s March 26, 2025 Memorandum titled “Interim Processes for PTAB Workload Management”
2004	USPTO Memorandum “Guidance on USPTO’s rescission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’” March 24, 2025.
2005	<i>Mullen Industries LLC v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:24-CV-00049-JRG, Order Denying Motion to Transfer, Dkt. 90 (E.D. Tex. Mar. 25, 2025)
2006	Reserved
2007	<i>Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation</i> , Vidal, June 21, 2022
2008	<i>Mullen Industries LLC v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:24-CV-00049-JRG, Order Denying Motion to Stay, Dkt. 71 (E.D. Tex. Jan. 23, 2025)

2009	<i>MyPort, Inc. v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:22-CV-00114-JRG, Order, Dkt. 73 (E.D. Tex. June 13, 2023)
2010	<i>Solas OLED Ltd. v. Samsung Display Co., Ltd.</i> , Case No. 2:19-CV-00152-JRG, 2020 U.S. Dist. LEXIS 125973 (E.D. Tex. July 17, 2020)
2011	<i>Oyster Optics, LLC, v. Infinera Corp.</i> , Case No. 2:19-CV-00257-JRG, Order, Order, Dkt. 87 (E.D. Tex. July 17, 2020)
2012	Docket Navigator, Time to Milestones for Judge Gilstrap (E.D. Tex.) in Patent Cases for the Last 5 Years
2013	<i>Mullen Industries LLC v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:24-CV-00049-JRG, Complaint, Dkt. 1 (E.D. Tex. Jan. 26, 2024)
2014	<i>Mullen Industries LLC v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:24-CV-00049-JRG (E.D. Tex.), Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.’s Amended Invalidity Contentions
2015	Excerpted Transcript of the Deposition of David Williams, IPR2023-00096, July 26, 2023.
2016	Excerpt from <i>Mullen Industries LLC v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:24-CV-00049-JRG (E.D. Tex.), Non-Party Google LLC’s Objections and Responses to Mullen’s Document Subpoena
2017	USPTO Director’s Brief in <i>Apple Inc. v. Vidal</i> , No. 5:20-cv-06128-EJD (N.D. Cal. Sept. 21, 2023)

2018	USPTO Director’s Brief in <i>Apple Inc. v. Vidal</i> , No. 2024-1864 (Fed. Cir. Oct. 16, 2024)
2019	Plaintiff-Appellants Brief in <i>Apple Inc. v. Vidal</i> , No. 2024-1864 (Fed. Cir. Aug. 5, 2024) (with Appx. containing <i>Apple Inc. v. Vidal</i> , No. 5:20-cv-06128-EJD, Order Denying Plaintiffs’ Renewed Motion for Summary Judgment; Granting Defendant’s Motion for Summary Judgment (N.D. Cal. Mar. 31, 2024))
2020	<i>Samsung Display Co., Ltd. v. Pictiva Displays Int’l Ltd.</i> , IPR2024-00855, Paper 13, Director Review Decision (PTAB Jan. 10, 2025)
2021	Centripetal - Public Comment on Advanced Notice of Proposed Rulemaking (ANPRM) Regarding Discretionary Institution Practices
2022	Stanwood - Public Comment on Advanced Notice of Proposed Rulemaking (ANPRM) Regarding Discretionary Institution Practices
2023	Pharmaceutical Research and Manufacturers of America (PhRMA) - Public Comment on Advanced Notice of Proposed Rulemaking (ANPRM) Regarding Discretionary Institution Practices
2024	Alliance of U.S. Startups and Inventors for Jobs (USIJ) - Public Comment on Advanced Notice of Proposed Rulemaking (ANPRM) Regarding Discretionary Institution Practices
2025	American Intellectual Property Law Association (AIPLA) - Public Comment on Advanced Notice of Proposed Rulemaking (ANPRM) Regarding Discretionary Institution Practices

2026	U.S. Patent No. 8,374,575 Prosecution History Excerpt, September 2, 2010 Final Rejection
2027	U.S. Patent No. 6,360,102

Pursuant to Acting Director's Stewart's March 26, 2025 Memorandum titled "Interim Processes for PTAB Workload Management" (the "Memorandum", EX2003), Patent Owner Mullen Industries LLC ("Patent Owner") respectfully requests that the Director exercise discretion and deny institution of Petitioners Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Google LLC's ("Petitioners") Petition for *inter partes* review IPR2025-00365 ("Petition") of U.S. Patent No. 11,234,117 (the "117 Patent").

I. INTRODUCTION

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

First, the petition should be denied on *Fintiv* grounds in light of the ***imminent trial*** that will begin in the parallel district court litigation on November 3, 2025. The district court has declined to stay the litigation and thus will hold trial well in advance of any Final Written Decision(s) that would issue in this Petition or the ten other Petitions Petitioners have filed. Indeed, the district court trial will occur ***over nine months before*** any Final Written Decision would issue on this Petition.

Despite the imminent trial date, Petitioners have filed eleven IPR petitions challenging the validity of the eight patents at issue in the underlying district court

case.¹ The inventor, Mr. Jeffrey D. Mullen, is the sole member of the Plaintiff Mullen Industries LLC in the parallel district court litigation and, contrary to the very principles of efficiency and simplification enshrined in the America Invents Act (“AIA”), would be unduly prejudiced by Petitioners’ request to drastically multiply the proceedings by adding 11 IPRs to what is presently a single district court case. Not only have Petitioners filed numerous IPRs, but the IPRs themselves contain numerous grounds and prior art: the eleven IPR petitions contain in total 64 grounds and 28 prior art references. And Petitioners have asserted all these IPR invalidity grounds (and more) in the district court case. Thus, by way of this and their ten other petitions, Petitioners are seeking to convert what is a single proceeding—the district court case—into eleven PTAB proceedings. Multiplying the proceedings elevenfold is the epitome of waste and inefficiency and should be rejected.

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

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

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

Further, both the former Director, and former Acting Director, recently confirmed in court filings that the Board *retains* discretion to deny institution under *Fintiv* even when Petitioner files such a stipulation (*e.g.*, EX2017 at 17 (“It is not

true that this means the factors *per se* dictate the outcome. The only requirement is consideration, after which the Board may choose to—or not to—institute IPR.”)); *id.* at 15 (“The *Fintiv* factors ... merely guide the Board’s decision-making process ... without dictating any particular outcome.”). Otherwise, the factors would violate statutes and the Board’s analysis would be unconstitutional. *See id.*; *also infra* at Section III.B.1. This is unsurprising because many comments in response to the former Director’s recent request for public comment noted that the Board must retain discretion to perform a “holistic” analysis that considers the specific facts on a case-by-case basis, and that a stipulation (even if a “true” *Sotera* stipulation) is merely one factor to consider. *Id.* Here, Petitioners’ stipulation does not overcome the strong evidence that institution should be denied. As has been recognized, the Board should still deny institution to avoid duplicative litigation where, as here, if the Board institutes it will put the parties in the wasteful, and prejudicial to Patent Owner, position of litigating common validity issues in both forums. EX2017.

Third, there is strong additional evidence that the Petition fails to establish invalidity because the Petition fails to show that the prior art meets multiple claim limitations applicable to each of the Grounds of the Petition and thus instituting review would be wasteful of PTAB and party resources. In addition, the Petition resorts to relying excessively on conclusory expert testimony in an attempt to cure the plain deficiencies of each Ground.

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

II. BACKGROUND

Jeffrey Mullen is an independent inventor who has invented prolifically across a wide array of technologies since the early 2000s, including, for example, wireless and cellular communications systems and devices, security improvements regarding the same, augmented reality and virtual reality devices, and autonomous defense systems. Mr. Mullen is the inventor of the '117 Patent and the sole member and founder of the Patent Owner Mullen Industries LLC. Patent Owner filed the underlying district court case more than a year ago in January 2024 to seek remedies for the Samsung Petitioners' unlawful use of Mr. Mullen's patented technologies, including but not limited to the inventions claimed in the '117 Patent.

Mr. Mullen disclosed in U.S. Application No. 11/834,674 and its corresponding U.S. Provisional Application No. 60/367,967 his innovation of wireless telephones capable of having their location determined and security measures for the same. The claimed wireless telephones are capable of, *inter alia*, having their location determined, providing location information, permissions, and/or location access rights for other specific devices, changing permissions or location access rights for other specific devices, receiving and displaying directional information to other specific devices, and providing a map with respect to the wireless telephones' location—all of this more than 18 years *before* Samsung

released its Samsung SmartThings Find technology containing the same features. EX2001; EX2002.

III. ARGUMENT

As a matter of efficiency, the Board should use its discretion to deny institution of Petitioners' eleven IPR petitions, including this Petition. Given the advanced stage of the district court litigation and its impending trial date, the practical effect of instituting Petitioners' IPRs would be to multiply the proceedings elevenfold—particularly where the final written decisions would issue many months after the conclusion of the scheduled trial.

Petitioners' attempt to multiply these proceedings is the exact opposite of the purpose of *inter partes* reviews. As even former Director Vidal pointed out, "Congress designed the America Invents Act (AIA) post-grant proceedings 'to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.'" EX2007 at 1 (citing H.R. Rep. No. 112-98, pt. 1, at 40 (2011), 2011 U.S.C.C.A.N. 67, 69; *see* S. Rep. No. 110-259, at 20 (2008)). Instituting Petitioners' eleven IPR petitions is directly contrary to this goal because "[p]arallel district court and AIA proceedings involving the same parties and invalidity challenges can increase, rather than limit, litigation costs." EX2007 at 1.

This concern is particularly acute where, as here, Petitioners Samsung and Google, major technology companies, have sought to multiply the proceedings against a Patent Owner whose sole member and owner, Mr. Mullen, is the inventor of all challenged patents. If the IPRs are instituted, the only practical effect will be to greatly increase the costs to Patent Owner: the district court case involves the same references (*even considering* Petitioners' purported stipulation) and the outcome would be the same (upholding the validity or invalidating the patents). However, the IPR decisions would occur months *after* the district court case and drastically increase the litigation costs of the parties. Petitioners' IPR petitions thus do the opposite of streamlining the dispute between the parties—they multiply it drastically. In view of these inefficiencies, and the deficiencies of the Petition on the merits, the Board should therefore use its discretion to deny institution.

A. The Petition Should Be Denied Under *Fintiv* Because the Underlying District Court Case Will Resolve the Issues Months Prior to Any Final Written Decisions, and Granting Institution Will Create Inefficiency and Greatly Multiply Proceedings

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

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

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

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

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

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

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

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

All six *Fintiv* factors support denying institution. The current advanced state of the parallel district court case, as well as the fact that the district court has already denied a request by Samsung for a district court stay and denied transfer, favors denial of the Petition. In addition, by the time the Board will issue an institution decision in this IPR Petition (expected mid-August 2025), claim construction will be decided in the district court case, fact and expert discovery will have closed, and dispositive motion briefing will have been completed before the projected Institution Decision date of August 19, 2025. *See* EX1038 (EDTX Scheduling Order). The investment in the district court litigation has been substantial: the parties have already served and responded to discovery requests in the district court case,

conducted depositions and source code reviews (of both party source code and non-party source code), and produced over 400,000 pages of documents.

Of paramount significance, the district court trial is also scheduled for November 3, 2025, which is approximately *nine months before* any Final Written Decision would issue in this IPR (estimated by mid-August 2026). *Id.* Still further, Final Written Decisions in Petitioners' other ten IPRs would issue at about the same time. And, as explained below, the district court has already denied one request from the Samsung Petitioners for an IPR stay, and with virtual certainty will not grant any other request for a stay because the district court trial is already scheduled to complete well before the Board would issue a Final Written Decision on any petition. Furthermore, the district court recently *denied* Petitioners' motion to transfer, further cementing that the November trial date will stick. EX2005 (Order denying motion to transfer).

Tellingly, Petitioners have not offered (nor can they) any real argument that supports instituting its eleven IPRs—which at best would result in rulings many months after the district court trial—rather than letting the parties resolve all of the issues in a single, faster district court case that will go to trial less than six months from now in early November 2025. Accordingly, the Board should deny institution to serve and maintain the goals of efficiency and efficacy, as well as fairness to the

Patent Owner. *See, e.g., Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017).

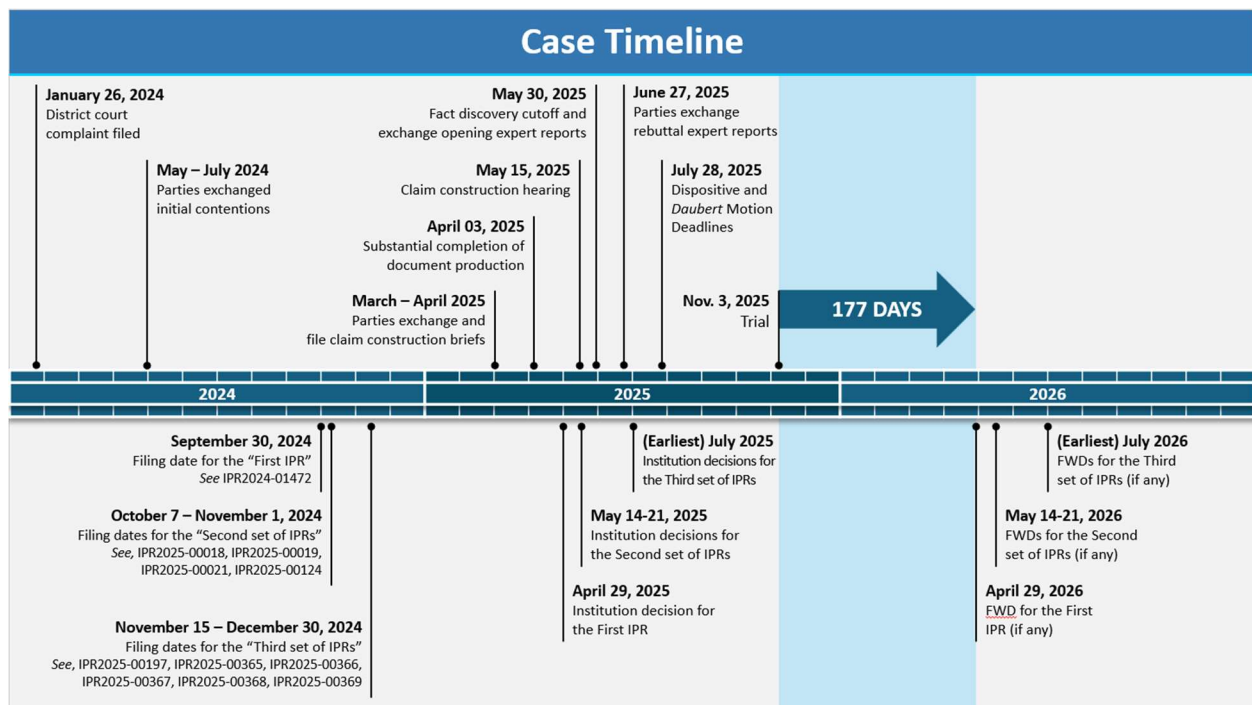
1. Factor 1: The District Court Denied Petitioners’ Motion for a Stay and is Highly Unlikely to Issue a Stay Even Were This Petition Instituted.

Petitioners state that this factor is neutral. Pet., 85. Petitioners fail to acknowledge the specific evidence (i) that the district court *already denied* Petitioners’ request for a stay in light of IPRs (EX2008) and (ii) the district court’s well-understood practice of denying requests for stays in circumstances directly analogous to the facts presented here. This factor is not neutral; it weighs strongly in favor of denying institution.

The Board has held that this factor considers “specific evidence” of whether the district court will grant a stay in the individual case at issue. *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative). Here, the specific evidence points to a stay not being entered in the district court litigation pre- or post-institution. Indeed, Judge Gilstrap presides over the underlying district court case in the United States District Court for the Eastern District of Texas and Judge Gilstrap has *already denied Petitioner Samsung’s request for a stay* of the parallel district court case pre-institution of any IPRs. EX2008. Importantly, in denying the stay, Judge Gilstrap ordered that Samsung may not refile any request for a district court stay

until *after* “the PTAB’s institution decision on the *last* of the pending IPRs.” *Id.* at 3 (emphasis added).

This timing is of particular importance in view of Judge Gilstrap’s well-established precedent for IPR stays. Indeed, the Board will not even issue its institution decisions in the last of the pending IPRs until August 2025, *which will be less than three months before the district court trial* will begin in early November 2025. To date, Judge Gilstrap has invariably denied stays under these circumstances: where trial is imminent and final written decisions are not scheduled to issue for many months after the trial date.



This IPR is among the “Third set of IPRs”, and the Board’s institution decision is not expected until August 19, 2025. As shown in the timeline, the expected

institution decision is just *two and a half months* before trial. Not only is that in close proximity to the trial itself, but by that time, the parties in the underlying district court case will have:

- completed claim construction briefing
- attended a claim construction hearing
- completed depositions
- reviewed source code
- produced more than 400,000 pages of documents,
- completed fact discovery
- completed expert discovery
- completed dispositive motion briefing

EX1038 at 4. Further, a Final Written Decision (if any) in this IPR would be received approximately *nine months after the November 3, 2025 district court trial*. *See id.* at 3.

Indeed, Judge Gilstrap has even granted stays pending IPR even under drastically different procedural postures. For example, in *Resonant Systems*, claim construction briefing had just begun, no *Markman* hearing had occurred, only two depositions had taken place, and the parties were still negotiating the scope of substantial email discovery. *Resonant Sys., Inc. v. Samsung Elecs. Co.*, No. 2:22-

CV-00423-JRG, Dkt. 83 at *2, 4, 8 (E.D. Tex. Mar. 8, 2024), Dkt. 63 at *1 (E.D. Tex. Dec. 5, 2025). The stage of the district court case here is entirely different: by the time the final Institution Decision issues, claim construction will be fully briefed, a *Markman* hearing will have occurred, fact discovery will have closed, expert discovery will be concluding, dispositive motions will be due just one week later, and trial will be set to occur in three and a half months.

Due to the imminent trial date and substantial investment by the Court and parties in the case, Judge Gilstrap routinely denies motions to stay district court litigation pending IPRs in such circumstances. *See, e.g., MyPort, Inc. v. Samsung Elecs. Co., Ltd.*, Case No. 2:22-CV-00114-JRG, Order, Dkt. 73 at 4-5 (E.D. Tex. June 13, 2023) (denying a motion to stay when trial was scheduled and “the PTAB [final written] decision is not due until over two months after jury trial is set to begin”) (EX2009 at 4-5); *Solas OLED Ltd. v. Samsung Display Co., Ltd.*, Case No. 2:19-CV-00152-JRG, 2020 U.S. Dist. LEXIS 125973, at *6 (E.D. Tex. July 17, 2020) (denying a motion to stay because “trial is only a few months away” and PTAB final written decisions would have been issued months after the scheduled trial) (EX2010 at *6); *Oyster Optics, LLC, v. Infinera Corp.*, Case No. 2:19-CV-00257-JRG, Order, Dkt. 87 at 4-5 (E.D. Tex. July 17, 2020) (denying a motion to stay because claim construction briefing was finished and “[f]act discovery is closing in about a month and trial is only six months away.”) (EX2011 at 4-5).

Under the specific facts of this case, it is not speculation to conclude that Judge Gilstrap will deny any refiled motion to stay; it is a near certainty. Thus, Factor 1 heavily favors denial of institution.

2. Factor 2: The Single District Court Case Will Resolve All of the Issues Presented in the Eleven Petitions Many Months Before Any Final Written Decision.

The Board generally denies institution when the trial date is months before the projected statutory deadline of the PTAB’s final written decision (FWD). *Fintiv*, IPR2020-00019, Paper 11 at 9 (“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution.”). The district court trial is set for November 3, 2025, which is *more than nine months before* the earliest expected date of a FWD (mid-August 2026) in this Petition. EX1038 at 4. This substantial length of time strongly favors discretionary denial—the Board routinely finds periods of six months, or even less, between a district court trial and expected FWD date supports denial of institution. *See, e.g., Fintiv*, IPR2020-00019, Paper 11 at 9 (5-6 months based on the time-to-trial evidence); *Samsung Elecs. Co., Ltd. v. Mojo Mobility Inc.*, IPR2023-01094, Paper 11 at 8 (PTAB Feb. 9, 2024) (“As the Texas Litigation is scheduled to go to trial ... approximately six months before a final written decision would be entered, we determine that Factor 2 weighs in favor [of] discretionary denial.”); *Satco Prods., Inc. v. The Regents of the University of California*, IPR2021-00794,

Paper 14 at 19 (PTAB Nov. 10, 2021) (five months); *Maxlite, Inc. v. Jiaxing Super Lighting Electric Appliance Co., Ltd.*, IPR2020-00208, Paper 32 at 5 (PTAB Oct. 12, 2021) (four months); *Stanley Black & Decker, Inc. v. Zircon Corp.*, IPR2020-01572, Paper 10 at 12 (PTAB Apr. 19, 2021) (three months); *Next Caller, Inc. v. TrustID, Inc.*, IPR2019-00961, Paper 10 at 14-15 (PTAB Oct. 16, 2019) (three months); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 at 6 (PTAB May 15, 2019) (one month).

In addition, trial statistics in E.D. Tex. before Judge Gilstrap, where the parallel district court case is pending, confirm that the November 3, 2025 district court trial date is a firm date that is likely to hold. EX2012 at 2. The median time to jury trial in patent cases before Judge Gilstrap is 19.8 months after filing of the original district court complaint. *Id.* Here, the median time to jury trial would result in a trial date in September 2025 (*i.e.*, even before the scheduled trial date), which means that the present November 3, 2025 trial date is both credible and conservative. *Id.*; *see also Samsung Elecs.*, IPR2023-01094, Paper 11 at 8 (exercising discretion to deny institution including because “[t]he fact that the time-to-trial statistics ... predict that a trial will be ... earlier than the trial date set in the court’s docket control order ... confirms that the schedule set by the district court is credible and should be given weight”); *TESO LT v. Luminati Networks Ltd.*, IPR2021-00249, Paper 12 at 8-9 (PTAB June 2, 2021) (denying institution despite possibility of “some delay in

the trial date due to crowded docket conditions” because “presuming that there would be extensive delay would be conjecture at this time.”).

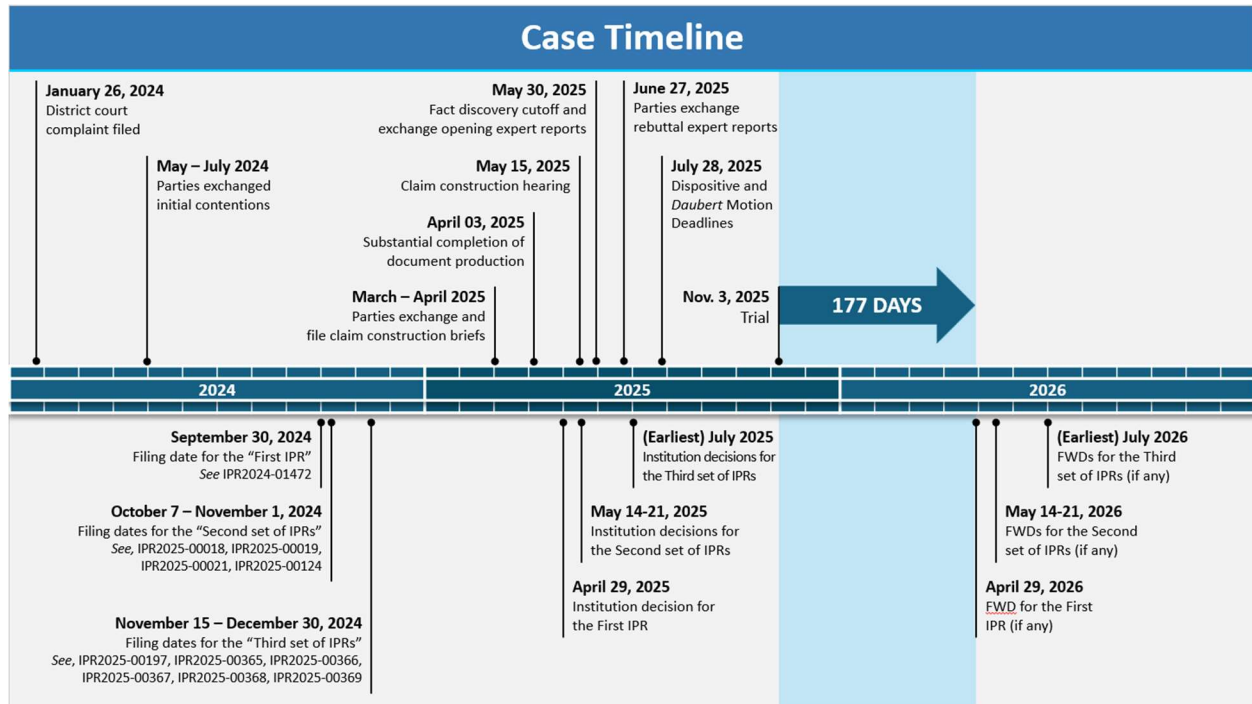
The credibility of a November 3, 2025 trial date is even stronger in view of Judge Gilstrap recently denying the Samsung Petitioners’ motion to transfer to the Northern District of California. Ex 2005; *see also SAP Am.*, IPR2024-01496, Paper 13 at 5-6 (“Because the trial date is set and the uncertainty in that date has diminished considerably due to the district court’s denial of both motions to transfer the Litigation to a different venue, we find that Fintiv Factor 2 weighs in favor of discretionarily denying institution.”).

Accordingly, Factor 2 also favors denial of institution.

3. Factor 3: There Has and Continues to be Significant Investment By the Parties in the District Court Litigation.

The Board has used its discretion to deny institution when, as here, there has been significant investment in the parallel district court proceeding. As shown in the case timeline below, the district court proceeding has been pending for well over a year since January 26, 2024. The Parties have prepared and exchanged infringement and invalidity contentions, presented initial disclosures, served many discovery requests, taken depositions, conducted numerous expert reviews of produced source code (including source code produced by all Petitioners here), and will shortly complete claim construction and fact discovery, which has already

resulted in document production in the district court litigation of over 400,000 pages from both parties and non-parties.



Petitioners also did not file their Petitions expeditiously, which favors the Board denying institution. Petitioners waited many months after the district court complaint was filed to submit their Petitions. For example, as shown in the timeline above, Petitioners waited over eleven months after the district court complaint was filed and seven and a half months after Patent Owner served its infringement contentions to submit their Petition in this IPR. EX2013 (district court original complaint). In fact, in five of such Petitions Petitioners waited more than 11 months from the time the district court complaint was filed to submit the Petitions. This is far different from situations where a petitioner was deemed diligent. *Cf. Verizon*

Bus. Network Servs., Inc. v. Huawei Techs. Co., IPR2020-01141, Paper 12 at 12 (PTAB Jan. 14, 2021) (petition filed less than three months after being served infringement contentions).

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

4. Factor 4: There is Significant Overlap Between Issues Raised in the Petition and in the Parallel Proceeding.

“[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, th[at] fact has favored denial.” *Fintiv*, IPR2020-00019, Paper 11 at 12. Here, Petitioners challenge almost the exact *same* claims in their Petition—and across their ten other Petitions—that they do in their invalidity contentions at the district court. *See* EX2014 at 2. In fact, Petitioners even rely on the same references in the Petition as they do in the parallel district court litigation. *See* EX2014 at 169 (citing the same references at issue here, *e.g.*, *Sheha* and *Randall*). This is true *even if* Petitioners’ purported stipulation is entered, as it has a “limited practical effect in reducing the overlapping efforts” in the IPR and the district court litigation. *SAP Am.*, IPR2024-01496, Paper 13 at 8; *see also infra* at Sections III.B.1-III.B.3.

The Acting Director recently and correctly explained that a *Sotera* stipulation is “not likely to moot” “invalidity arguments in the district court [when they] are more expansive and include combinations of the prior art asserted in [parallel IPR petitions] with unpublished system prior art[.]” *Motorola Sols.*, IPR2024-01205, Paper 19 at 4. Such is the case here, where not only are the same claims, grounds, arguments, and evidence presented in the Petitioner present in the parallel district court litigation, the district court litigation includes *additional* invalidity grounds that rely on the same prior art asserted in the Petition, in combination with system prior art that the Samsung Petitioners will assert in the district court regardless of whether the Board institutes.

Moreover, that the parties to the district court litigation are obligated to drop certain claims to comply with the court’s rules is of no moment here. Should the Board deny institution of this Petition, Patent Owner agrees to not assert again in the future against the Samsung petitioners any claim challenged in this Petition that Patent Owner has dropped in the district court litigation to comply with the court’s rules. In view of this stipulation, instituting review would be inefficient. *Samsung Elecs.*, IPR2023-01094, Paper 11 at 11 (“Patent Owner has stipulated not to assert infringement of any claims challenged in the Petition that have been or will be dropped from the Texas Litigation. . . . This diminishes the significance of the non-overlapping claims. We determine that, as in *Fintiv*, it would be inefficient to

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

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

5. Factor 5: Petitioners and the Defendants in the Parallel Proceeding are the Same Party.

Factor 5 also weighs in favor of denial because the parties to this proceeding are the same parties in the parallel district court litigation—*i.e.*, Mullen Industries LLC and the Samsung entities. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020) (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”). Petitioners do not contest these facts but, without explanation, argue incorrectly and nonsensically that “[t]his factor is neutral.” Pet., 86. This factor is not neutral; rather, it supports denial of institution. *Fintiv*, IPR2020-00019, Paper 15 at 15.

Moreover, the fact that Google LLC is an additional co-Petitioner in these IPR proceedings is of no moment. *Fintiv*, IPR2020-00019, Paper 11 at 14 (“Even when a petitioner is unrelated to a defendant, however, if the issues are the same as, or substantially similar to, those already or about to be litigated, or other circumstances

weigh against redoing the work of another tribunal, the Board may, nonetheless, exercise the authority to deny institution”); *Mylan Labs. Ltd. v. Janssen Pharms. N.V.*, IPR2020-00440, Paper 17 at 12 (PTAB Sept. 16, 2020) (denying institution under *Fintiv* in light of an upcoming district court trial notwithstanding that the petitioner was *not* the defendant in that trial), *aff’d*, 989 F.3d 1375, 1378 (Fed. Cir. 2021).

Here, Google LLC is indeed related to, and collaborating with, the Samsung entities in both the district court case and these proceedings. The Samsung Petitioners are the defendants in the upcoming November 3, 2025 district court trial, and Petitioner Google LLC, while not a named party in the district court proceeding, ***is voluntarily participating on Samsung’s behalf in the district court case.*** Specifically, in the district court case Google LLC has (i) voluntarily submitted declarations on Samsung’s behalf, (ii) produced documents and source code in response to subpoenas, and (iii) is represented by the same outside counsel that represents the Samsung entities. *See* EX1036 at 2-3 (identifying counsel representing the Samsung entities, including, *e.g.*, Messrs. Trac, Snyder, and Liang, and Ms. Simmons, who also represent Google LLC in connection with the district court case); EX2016 (same counsel representing Google LLC in the district court case). The Samsung Petitioners and co-Petitioner Google LLC are thus related,

collectively involved in the district court case, and cooperating in the district court case on Samsung's behalf.

Accordingly, Factor 5 weighs in favor of denying institution.

6. Factor 6: The Merits of the Petition are Weak.

The final factor also weighs in favor of denial because the merits of the petition are weak and are far from being sufficiently strong to overcome the factors favoring institution. *See, e.g.*, EX2003 at 2 (relevant considerations may include “[t]he strength of the unpatentability challenge”); *SAP Am.*, IPR2024-01496, Paper 13 at 10-11 (“We decline to characterize the merits as sufficiently strong to overcome the other factors”). As shown in Section III.C, Petitioners’ arguments on the merits do not meet the “reasonable likelihood” standard, much less the high standard required for an invalidity challenge when factors weigh in favor of the Board discretionarily denying institution. *Vector Flow, Inc. v. HID Glob. Corp.*, IPR2023-00353, Paper 8 at 23-24 (PTAB July 17, 2023).

Here, the Petition misreads both the claims and the cited references, which demonstrates the weakness of the Petition and favors denial of institution. *See, e.g., infra* at Section III.C; *see also, e.g., Samsung Elecs. Co, Ltd. v. California Institute of Technology*, IPR2023-00130, Paper 10 at 26 (PTAB May 4, 2023) (exercising discretion to deny institution because “[f]or essentially the reasons posed by Patent Owner, we agree that Petitioner’s showing is less than compelling, as it rests

tenuously upon apparent logical leaps”); *Samsung Display Co., Ltd. v. Pictiva Displays Int’l Ltd.*, IPR2024-00855, Paper 12 at 13 (PTAB Nov. 19, 2024) (exercising discretion to deny institution because “Petitioner’s challenges do not meet the compelling merits standard because a genuinely-disputed issue surrounds the correct [claim] construction That genuine dispute, in turn, casts doubt upon whether Petitioner ‘is highly likely’ to prevail in showing that the [claim] limitation would have been obvious over the asserted prior art references”); EX2007 at 4-5 (“[w]here the information presented at the institution stage is merely sufficient to meet the statutory institution threshold, the PTAB has the authority ... to exercise discretion to deny institution in view of the other *Fintiv* factors”).

Moreover, even if Petitioners’ case were seen as meeting the standard for institution—which it is not—it is not sufficiently strong on the merits to outweigh the evidence in factors 1-5. *See SAP Am.*, IPR2024-01496, Paper 13 at 10-11 (“[W]e determine that the other factors are more persuasive here. Although Petitioner’s challenge is straightforward and definitely meets the standard for institution, even when balanced against Patent Owner’s counterarguments, we do not find the challenge to be sufficiently strong to outweigh the evidence discussed above in connection with *Fintiv* Factors 1–5.”).

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

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

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

Petitioners’ stipulation does not change that the Board should deny institution. The former Director recently clarified in district court and Federal Circuit filings that the Board *retains* discretion to deny institution even when petitioner files a so-called *Sotera* stipulation; otherwise, the Director’s factors would violate statute and be unconstitutional. Particularly, the Director’s district court brief stated that “[i]n June 2022, the Director issued a guidance memorandum revising the *Fintiv* analysis.... In this Memorandum, the Director ... directed that ... the Board *should not* discretionarily deny institution under *Fintiv* when a petitioner stipulates not to pursue, in a parallel district court proceeding, the same grounds as in the petition or any grounds that could reasonably have been raised in the petition.” EX2017 at 5-6 (emphasis added). This clarified the June 2022 Memorandum issued more than a year prior, which stated that the PTAB “*will not* discretionarily deny institution” when such a stipulation is entered. EX2007 at 3 (emphasis added). The Director further clarified that:

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

EX2017 at 8.

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

Id. at 12 (emphasis in original).

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

Id. at 15.

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

Id. at 16.

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

Id. at 17.

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

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

EX2018 at 15.

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

Id. at 23.

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

Id. at 29.

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

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

...

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

EX2019 at Appx1-2.

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

Id. at Appx22.

This, too, is what the former Acting Director recently held when *sua sponte* clarifying via Director Review that the Board makes a “holistic determination ... with regard to discretionary denial” based on “the totality of the Board’s weighing of the *Fintiv* favors ... to exercise its discretion to deny institution under § 314(a).” *Samsung Display Co., Ltd. v. Pictiva Displays Int’l Ltd.*, IPR2024-00855, Paper 13 at 8 (PTAB Jan. 10, 2025) (EX2020).

Further, as explained in the memorandum titled “Guidance on USPTO’s rescission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’”, the Board *rescinded* the June 21, 2022 memorandum. EX2004. The Guidance Memorandum, issued March 24, 2025, makes clear that the presence of such a stipulation “will not be dispositive by itself.” *Id.*, 3. This, indeed, is unsurprising because many comments in response to the former Director’s recent request for public comment noted that the Board must retain discretion to perform a “holistic” analysis that considers the specific facts on a case-by-case basis, and that a stipulation (even if a “true” *Sotera* stipulation) is merely one factor to consider. Exs. 2021-2025.

Accordingly, even when a petitioner files a purported “*Sotera*” stipulation, it is *not* dispositive of whether the Board should deny institution under *Fintiv*. Rather, the Acting Director and district court have clarified that the Board should consider

any such stipulation as just one non-dispositive factor in connection with all other circumstances of the case, just like the Board has done previously. *See e.g.*, EX2004, *passim*; EX2003, *passim*; *Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00333, Paper No. 12, at 12-13 (PTAB July 7, 2021) (denying institution under *Fintiv* based on holistic analysis of all factors ***even when*** petitioner filed a *Sotera* stipulation because the Board was “not persuaded ... the stipulations proffered here are sufficient when weighed against the other factors”).

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

That the Director clarified that a *Sotera* stipulation is but one non-dispositive factor is not surprising. After the former Director issued the 2022 Guidance Memorandum (EX2007), the Director requested, and received, many public comments strongly urging the Director to clarify that the Board retains discretion to perform a “holistic” analysis considering the facts of each case on a case-by-case basis, including clarifying that even a *Sotera* stipulation is merely one non-dispositive factor to consider under *Fintiv*:

While we strongly support the inclusion of a mandatory *Sotera* stipulation in all IPR and PGR petitions, ***we do not see why it should provide a “safe harbor” for petitioners as a mechanism to avoid discretionary denial.*** The [Director’s Advanced Notice of Proposed Rulemaking] ANPRM seems to recognize this as well and proposes that a mandatory *Sotera stipulation could be “a necessary but not sufficient basis for institution.”* We agree with this approach.

...

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

EX2021 (Centripetal) at 6-7 (emphases added).

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

EX2022 (Stanwood (“an inventor and US citizen with 161 issued US patents”)) at ¶16 (emphases added).

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

...

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

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

The patent owner has no ability to enforce such a stipulation in district court, and at least some courts are likely to allow an accused infringer to argue its way out of one.

...

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

EX2024 (Alliance of U.S. Startups and Inventors for Jobs (“USIJ”)) at 16-17.

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

EX2025 (American Intellectual Property Law Association (“AIPLA”)) at 13.

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

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

Here, Petitioners’ *Sotera* stipulation does not overcome the strong evidence that institution should be denied under *Fintiv*, or the Director’s inherent discretion, as addressed above. *See supra* Section III.A. That is, given the specific facts here, institution should be denied in favor of allowing the parties to resolve all validity disputes in the single district court proceeding that has advanced significantly and will be tried very soon in early November 2025. *Id.* Petitioners’ initial withholding of their stipulation—waiting nearly two months—instead of filing same with its Petition was also gamesmanship, prejudicial to Patent Owner, and inconsistent with

the mandate of 37 C.F.R. § 42.1(b) to “secure the just, speedy, and inexpensive resolution of every proceeding.”

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

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

This prejudice to Patent Owner is particularly acute where, here, the Petitioners assert “systems art” in district court. *Id.*

First, in the parallel district court proceeding, Petitioners are relying on purported “device art” that is cumulative of and materially identical to patents or printed publications that could have been raised in this IPR. *See e.g.*, EX2014 at 172-175 (identifying printed publications that describe each item of alleged “device art” or “prior art system”). Prejudicially, this will lead to the situation where Patent Owner must litigate the same validity issues in both forums because in district court “IPR estoppel does **not** apply to device art, even when that device art is cumulative of patents and printed publications that were or could have been asserted in a prior IPR.” *Prolitec*, 2023 WL 8697973, at *22 (emphases added).

Second, even worse, Petitioners’ invalidity contentions in the district court include many invalidity grounds **combining** the “device art” or “system prior art” with the **same** references in this IPR. *See e.g.*, EX2014 at 138-39 (identifying “Primary References” including “Benefon Esc!” and “CellPoint Finder!”); *e.g.*, *id.* at 143-45 (combining such device art with the same Sheha, Randall, De-Vries, and Degnbol references in this IPR). Samsung’s purported stipulation indeed expressly states that “[t]his stipulation is not intended, and should not be construed, to limit Samsung’s ability to assert invalidity ... on any other [102/103] ground.” The Board should deny institution to prevent this prejudicial and wasteful duplication in the

parallel litigation. *E.g.*, *Prolitec*, 2023 WL 8697973, at *22; *SAP Am.*, IPR2024-01496, Paper 13 at 10-11 (factor 4 favors discretionary denial because Petitioner was asserting system art in district court and “a majority of the parties’ work that would be done here will also be required in the Litigation regardless of whether we institute review. Accordingly, we do not consider the presence of the *Sotera* stipulation in our case to ensure that inter partes review would be a ‘true alternative; to the Litigation.’”).

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

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

C. Grounds 1-6 Of The Petition Are Weak on the Merits and Fail To Establish Obviousness of Any Claim

1. Grounds 1, 3, 4, and 6 of the Petition Fail to Establish Obviousness of the Limitation “Instructing Said Remote Server to Change a List of Users on Said Remote Server for a Profile Associated with Said Wireless Telephone that Are Allowed to Access Said Location by Way of Said Remote Server Providing Said Location from Said Remote Server to at Least One of Said Users of Said List of Users, Wherein Each User of Said List of Users Is Representative of One of a Plurality of Wireless Telephones” in Claim 1 and Its Dependent Claims

The Board should decline to institute any Grounds of the Petition with respect to Claim 1 and its dependent claims because the references fail to teach or suggest this limitation.

The Petition’s arguments are based on a fundamental misreading of the claim language. Properly construed, the limitation requires the claimed “access [to] said location” to be provided both (i) by the specific wireless device recited in each claim (*i.e.*, the same “said wireless telephone” recited in the claims that has is capable of providing its location) and (ii) to a specific device recited in the claim (*i.e.*, “one of said plurality of wireless telephones” associated with a “user”).

Petitioners in effect erroneously seek to rewrite these terms in Claim 1 to read: “~~instructing said remote server to chang[ing] a policy that may result in allowing a list of users on said remote server for a profile associated with said wireless telephone~~ that are allowed to access said location by way of said remote server

providing said location from said remote server to at least one of said users of said list of users, wherein each user of said list of users is representative of one of a plurality of wireless telephones.” EX1001, 13:25-32. Then, and only then, based on Petitioners’ improper rewriting of the language of Claim 1, Petitioners incorrectly argue that Sheha or Randall teaches or suggests this claim limitation. This rewriting of the claim language includes two key errors of claim construction.

First, the Petition repeatedly ignores (by ascribing no meaning to and failing to substantively address in the Petition) the portion of this term that expressly requires the “access [to] said location” to be provided by the specific “said wireless telephone” recited in the claims that has its location determined. The plain language of the claim is itself clear that the “access [to] said location” must be provided by the specific device recited in the claim (*i.e.*, the same “said wireless telephone” recited in the claims that has its location determined). These words must be given meaning and cannot be ignored. *Phillips*, 415 F.3d at 1314); *Exxon Chem. Patents v. Lubrizol Corp.*, 64 F.3d 1553, 1557 (Fed. Cir. 1995). This should end the inquiry. It conclusively establishes that the device specified in each claim (*i.e.*, the “said wireless telephone”) must provide the “access [to] said location,” and the Board should reject Petitioners’ attempt to ignore this limitation or read it out of the claim.

Indeed, this is a significant omission, including because requiring the same device that has its location determined to provide the permission to access that

device's location information enhances system security. EX1001, 1:44-54 (“One object of the present invention is to provide a *security feature* which allows a user to limit and/or deny location access to a particular user. ... In this manner, *a cell phone user may give access, through his or her cell phone*, to a friend so that the friend can locate him or her”).

Second, the Petition repeatedly points to group policies that purportedly give access to location information to a group. But a group policy is not a grant of “access [to] said location” to a specific device as recited in the claims. The plain language of the claim again makes clear that the “access [to] said location” is provided to specific individual “users” where “each user ... is representative of one of a plurality of wireless telephones.” The plain and customary meaning of these ordinary words is readily apparent—rights to access the location is provided that is intended to be received or used by or aimed at a recipient—and the claim language expressly identifies that recipient, *i.e.*, the wireless telephone associated with the user. *Phillips*, 415 F.3d at 1314 (where ordinary meaning of the claim is readily apparent, claim construction “involves little more than the application of the widely accepted meaning of commonly understood words”).

By contrast, to interpret these claims as merely setting a policy that applies to a group, however that group is defined and may change, would improperly strip the claims of their actual words and their common meaning. *See VLSI Tech. LLC v.*

Intel Corp., 53 F.4th 646, 655-656 (Fed. Cir. 2022); *Exxon Chem. Patents*, 64 F.3d at 1557. Group policies create a security risk of erroneously allowing or disallowing access to location information, and Paper Owner's disclosed and claimed innovations improve system security and address that very issue. EX1001, 1:44-46. Notwithstanding that group policies and the claimed invention are very different concepts, the Petition conflates the two and, fatally to its invalidity allegations, uses them "interchangeably." Pet., 10 n.4.

More specifically, when a policy is set that allows a group to access position or location information, which is how the references cited in Petitioners' Grounds purport to operate, it does not mean that any device has access to the location information. The uncertainty that devices "may" or "can be" given access (as Petitioners effectively rewrite the claims to recite) is different than the certainty of devices that "are" provided access (as the '117 Patent actually claims). *See, e.g.*, Pet., 51-52. The group may also be an empty set and the group's members may change over time such that location access rights are not assigned "to" any device but rather are generic to a group, however such group is defined and however that definition may change over time.

Illustrating this, a group policy remains unchanged when a member is added to the group, which creates risk of erroneously allowing access to location information to the member when, for example, a user forgets that the group is

allowed to access location information when adding the member to the group. Likewise, a group policy remains unchanged when a member is removed from the group, which creates risk of erroneously disallowing that member's access to location information when, for example, a user forgets when removing a member from the group that it was the member's inclusion in the group that permitted the member to access the location information. Still another example, if a group permission is changed that results in allowing or disallowing access to location information to members of the group, it shows that the group is the construct that is, or is not, assigned location access rights and not the group members themselves whose potential access to location information depends on whether they remain members of the group.

The difference relative to Claim 1 is significant, including in terms of system security. The '117 Patent expressly recognizes this difference when it explicitly states that “[o]ne object of the present invention is to provide a security feature which allows a user to limit and/or deny location access to a particular user.” EX1001, 1:44-46. Indeed, the claimed invention eliminates the risk of erroneously allowing access to location information to unwanted recipients, or conversely disallowing access to location information to recipients that are desired to have access.

The specification supports Patent Owner's construction and understanding of Claim 1. *See Kaken Pharm. Co. v. Iancu*, 952 F.3d 1346, 1352 (Fed. Cir. 2020) (“A

patent's statement of the described invention's purpose informs the proper construction"); *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007) ("When a patent ... describes the features of the 'present invention' as a whole, this description limits the scope of the invention."). It repeatedly and consistently describes the invention as a user selecting, via a user's device (*i.e.*, the same device that is capable of having its location determined), another specific user for receiving permission. EX1001, 1:39-54. This, too, is exactly what the '117 Patent discloses in connection with Figure 9 (*i.e.*, disclosing that a wireless device user grants permission to access location information to another device by identifying or selecting that other device). *Id.*, Figure 9, 9:10-15. Further, the '117 Patent repeatedly refers to the benefits of assigning rights to a specific user, which underscores that these words must be given that specific meaning in the claims. EX1001 at 1:58-59 ("Phil may grant Bill access"), 1:66-2:2 (location "can be accessed by a particular user"), 3:9-11 ("location rights for a specific user may be given to a different user only by that specific user"); 4:56-65 ("for the requesting user"), 9:16-20 ("assigning location rights to a user"), 11:64-12:2 ("finding if any access rights were assigned to the requestor's identity").

The prosecution history of a related patent, U.S. Patent No. 8,374,575, is also instructive. Each of claims 1, 14, and 30 of the '575 patent include a nearly identical limitation to the one at issue. During prosecution of the '575 patent, the Examiner

stated that the portion of the claim requirement for “changing ... a list of users ... that are allowed to access the location ...” was met by U.S. Pat. No. 6,360,102, which refers to “*a list of preferred subscribers ... that have permission to position the mobile subscriber.*” EX2026, 3; EX2027, 4:9-10. This coupling of each grant of location access rights to a certain individual demonstrates that the Examiner, too, interpreted the claims to require each such grant to be for a specified device as recited in the claim, and the applicant did not dispute this aspect of the Examiner’s analysis. *Id.* This likewise supports Patent Owner’s position that the claims should be construed to require that the ’117 Patent’s claimed grant of “access [to] said location” must be provided for a specified device as recited in the claims, because Patent Owner’s construction is consistent with the manner in which these claim terms were construed during prosecution. *Phillips*, 415 F.3d at 1317.

Turning to the specific grounds, for Grounds 1 and 3 Petitioners rely on Sheha as allegedly teaching or suggesting this claim limitation. Pet., 8-14. For Grounds 4 and 6, Petitioners rely on Randall as allegedly teaching or suggesting these claim limitations. Pet., 51-54.

First addressing Sheha (Grounds 1 and 3), the Petition vaguely and inadequately alleges that “Sheha discloses that each device may have privacy settings ... changed at the instruction of the *wireless telephone*” Pet., 8 (citing Sheha, 5:38-46, 11:63-12:7) (emphasis in original). Sheha does not disclose or

suggest the claimed features that the same device that has its location determined is capable of providing “access [to] said location” for another specific device, nor the security advantages that the ’117 Patent discloses these features provide.

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

- In one embodiment, if a mobile device user specifies a telephone number of another position-enabled mobile device, the system would query the remote mobile device and verify its *privacy setting*. EX1005, 4:62-66 (emphasis added).
- In another embodiment, each device has *privacy settings* that allow the device to prevent or limit other calling devices from obtaining position information. *Id.*, 5:38-41 (emphasis added)
- The mobile device location information can be provided only, due to *privacy settings*, if the user configured the mobile device **18a** to allow position information to while calls are received. In another embodiment, the *privacy configuration* also includes settings such as the option to never send position information, or to send position information *while receiving and/or sending calls*, and whether the transfer of position information should be allowed only *for an instance or for a given period of time*. *Id.*, 10:17-26 (emphasis added).

Sending or receiving position information in Sheha is thus contingent *not* upon what access rights a mobile device has provided for another device but instead upon what privacy filters the mobile device has implemented for all incoming

location requests. *Id.* The very nature of Sheha’s filters make them indiscriminate as to the identity of any requesting mobile device. *Id.* The privacy settings are *not* location access rights, are *not* provided by the mobile device, and are *not* for another specified device as recited in Claim 1. *Id.* Every disclosure in Sheha is consistent in this regard. *E.g.*, EX1005, 4:35-42, 5:3-20, 5:21-46, 10:44-50, 11:3-9, 12:1-4. In addition, Sheha’s privacy settings reside on a mobile device itself, and thus are fundamentally different than the ’117 Patent’s claimed invention for the additional reason that they are not stored on a “remote system” as required by Claim 1.

Here, Petitioners retained the *same* declarant that was retained by the prior petitioner in IPR proceedings involving the ’117 Patent before such prior proceedings were terminated due to settlement. And, notwithstanding Petitioners’ present arguments and transparent attempt to change their declarant’s prior testimony, Petitioners’ declarant *did* concede at his deposition in the prior proceedings that the privacy settings on Sheha’s mobile device are *not* for a specified device and instead are general settings that apply to any location request that is received:

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

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

EX2015, 17:6-12 (emphasis added).

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

A. Correct.

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

....

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

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

Aside from Sheha’s privacy settings, Petitioners rely on Sheha’s reference to a “group database” and that “users can define a group of specific users.” Pet., 8 (citing Sheha, 11:55-12:7, 4:59-5:20). However, Sheha’s disclosures regarding “groups” are irrelevant for two reasons. *First*, Sheha only refers to the use of “groups” in the context of “landline-to-landline” requests (not mobile-to-mobile requests), whereas instead Claim 1 of the ’117 Patent expressly refers to wireless telephones:

A mobile or landline device can also request position information of another mobile or landline device by only specifying a telephone number, without having to initiate a telephone call. ***For a landline-to-landline position request***, the specified telephone number is correlated to its position information using telephone information from a known database or sets of databases. In one embodiment,

the online database that contains this information only includes users that do not have unlisted telephone numbers. In another embodiment, ***users can define a group of specific users that have access to this information. This is also accomplished by utilizing a group database*** and authorization and authentication protocols to identify users that are permitted to access this information. When a mobile device's position information is requested, the system, based on privacy settings, responds with the appropriate position information to the requesting user's device. In another embodiment, using the authorization and authentication protocols a user can request the position of a mobile device, similarly to requesting the position of a landline device.

Sheha, 11:55-12:7 (emphasis added). *Second*, a group policy is not a grant of “access [to] said location” to a specific device as recited in the claims. This distinction is indeed immensely important. The '117 Patent's claimed invention of a mobile device providing “access [to] said location” to a specific device eliminates security risk and advantageously improves system security.

The Board should also reject Petitioners' hindsight attempt to reinterpret Sheha as teaching or suggesting something more. Pet. 11, 13-14 (alleging that any differences were “well-known as a beneficial option”). That the security advantages provided by the '117 Patent's claimed inventions are only disclosed by the '117 Patent, and not the cited references, should not be taken lightly. *In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965) (there is an enduring admonition against impermissibly “pick[ing] and choos[ing]” from a reference “only so much ... as will support a given

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

Turning to Randall (Grounds 4 and 6), the Petition likewise falls well short of demonstrating that Randall teaches or suggests these limitations. It alleges that “***Randall’s ‘server*** recognis[es] Bob’s device and determine[es] the database access rights which Alice has given him.” Pet., 47-48, 51-54 (citing Randall, [0067]). However, Randall does not disclose or suggest the ’117 Patent’s claimed features that the same device that is capable of having its location determined is capable of providing permission for another specific device to access the location information, nor does Randall disclose or suggest the corresponding the security advantages that the ’117 Patent teaches these features provide.

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

silent has to how those “defin[itions of] which entities can read different fields” are established. Randall does not teach or suggest that such definitions are provided by the same wireless telephone that is capable of having its location determined, which is a distinct security advantage disclosed and claimed by the ’117 Patent. *See* EX1001, 1:44-54. This alone is fatal to Petitioners’ Ground based on Randall.

Randall also does not teach or suggest providing “access [to] said location” to another wireless telephone as claimed in Claim 1. The Petition acknowledges that Randall’s system assigns access rights to groups, called “i-Groups.” Pet., 51-54. This is so even when the group is intended, at least initially, to have only one individual member. *Id.*, 51 (citing Randall’s “i-Group” for “partner,” which the Petition acknowledges is accessible to “usersg whom [Alice] has assigned to the ‘i-Group’ called ‘partner’” even if Alice only initially assigns “Bob” to that group). But as discussed, granting access rights to a group does not teach or suggest providing “access [to] said location” to a wireless telephone as claimed in Claim 1. A group may be an empty set, and even if at one point in time the group has only one individual member (like Petitioners argue), the group’s members may change over time such that the policy is not for any device but rather generic to a group, however such group is defined and however that definition may change over time. Accordingly, reliance on a group policy for the grant of access rights does not disclose or suggest, and is very different than, what is claimed by the ’117 Patent

and imposes risk of erroneously allowing or disallowing access to location information. *Id.*; *Cf.* EX1001, 1:44-46. The Petition indeed concedes that Randall’s use of a group construct injects ambiguity and uncertainty, and risk of improper disclosure, by acknowledging that when a user is assigned to a group (“friends” or “family”) it merely means that “[t]he user’s friends or parents etc’ **can be** ‘allowed...to track his or her location’.” Pet., 51-52. It does not mean that any other users’ wireless telephones “**are allowed** access to said location” as claimed by Claim 1. This, too, is fatal to Petitioners’ Grounds 4 and 6 based on Randall.

Because Petitioners fundamentally misread these claim limitations and erroneously map them to the references, the Petition fails to demonstrate invalidity. Accordingly, the Board should find that the Petition has failed to show invalidity of these claim limitations, and thus should decline to institute any Grounds of the Petition with respect to Claim 1 or any of its dependent claims. *See, e.g., Samsung Elecs.*, IPR2023-00130, Paper 10 at 26 (“Petitioner’s showing is less than compelling, as it rests tenuously upon apparent logical leaps”); *Samsung Display*, IPR2024-00855, Paper 12 at 13 (denying institution “because a genuinely-disputed issue surrounds the correct [claim] construction That genuine dispute, in turn, casts doubt upon whether Petitioner ‘is highly likely’ to prevail in showing that the [claim] limitation would have been obvious”); *AT&T Servs., Inc. v. ASUS Tech. Licensing Inc.*, IPR2024-01142, Paper 14 at 27 (PTAB Jan. 27, 2025) (denying

institution because “Patent Owner has identified a plausible understanding of the meaning of the claims ... and potential dispositive inadequacies in Petitioner’s approach to accounting for features of those claims”).

2. Grounds 2, 3, 5, and 6 of the Petition Fail to Establish Obviousness of the Limitation “Providing a Permission for Said Second Wireless Device to Access Location Information About Said Location” in Claim 73 and Its Dependent Claims

The Board should decline to institute Grounds 2, 3, 5, and 6 because the cited references fail to teach or suggest this limitation.

The Petition’s arguments for these limitations are again based on Petitioners’ fundamental misreading of the claim language. As with Claim 1, *see supra* Section III.C.1, properly construed, these limitations of claim 73 require the claimed permission be provided both (i) by the specific wireless telephone recited in each claim (*i.e.*, the same wireless telephone recited in the claim that has its location determined) and (ii) to the specific device recited in the claim (*i.e.*, the “second wireless device”).

Petitioners in effect erroneously rewrite this term in Claim 73 to read: “~~providing a permission for~~ a policy that may result in allowing said second wireless device to access location information about said location.” Then, and only then based on Petitioners’ improper rewriting of the language of Claim 73, Petitioners incorrectly argue that Sheha or Randall teaches or suggests this claim limitation.

Like their analysis for Claim 1, Petitioners' rewriting of the claim language suffers from two key errors of claim construction.

First, the Petition repeatedly ignores (by ascribing no meaning to and failing to substantively address in the Petition) the portion of this term that expressly requires "a permission" be provided by the specific device recited in the claim (*e.g.*, the *same* "wireless telephone" that is capable of having its location determined). The plain language of the claim is clear that the "permission" must be provided by the specific device recited in the claim (*i.e.*, the same "first wireless telephone" that has its location determined). These words must be given meaning and cannot be ignored. *Phillips*, 415 F.3d at 1314. This conclusively establishes that the "wireless telephone" in Claim 73 must provide the "permission", and the Board should reject Petitioners' attempt to read this limitation out of the claim. Like Petitioners' error in their analysis of Claim 1, this is a significant error because requiring the same device that has its location determined to provide the permission to access that device's location information enhances system security. EX1001, 1:44-54.

Second, the Petition repeatedly points to group policies that purportedly give access to location information to indeterminate and fluctuating members of a group. However, as discussed *supra* at Section III.C.1, a group policy is not a grant of "access [to] location information about said location" or a grant of "permission" that is provided "for" a specific device as recited in the claims. Just as for Claim 1, the

meaning of the plain language of Claim 73 is readily apparent: rights to access the location is provided that is intended to be received or used by or aimed at a recipient—and the claim language expressly identifies that recipient, *i.e.*, the wireless device associated with the user. *Phillips*, 415 F.3d at 1314. As discussed above, *supra* Section III.C.1, to interpret these claims as merely setting a group, however that group is defined and may change, would improperly strip the claims of their actual words and common meaning. Group policies create a security risk of erroneously allowing or disallowing access to location information, and, as shown in the specification and figures, Patent Owner’s disclosed and claimed innovations improve system security and address that very issue. *See supra* Section III.C.1.

Turning to Petitioners’ arguments, for Grounds 2 and 3 Petitioners rely on Sheha as allegedly teaching or suggesting these claim limitations. Pet., 23-26. For Grounds 5 and 6, Petitioners rely on Randall as allegedly teaching or suggesting these claim limitations. Pet., 65.

First addressing Sheha (Grounds 2 and 3), the Petition vaguely alleges that the target device’s user “‘can define a group of specific users ... that are *permitted* to access’ the target device’s location information.” Pet., 24 (citing Sheha, 11:55-12:7(emphasis in underline added, emphasis in bold in original)). This does not disclose or suggest the claimed features that the same device that has its location determined is capable of providing a permission to another specific device to access

that device's location information. Indeed, Sheha does not disclose or suggest these claim limitations nor the corresponding security advantages that the '117 Patent discloses these features provide.

As discussed *supra* at Section III.C.1, Sheha refers to a mobile device that stores privacy settings or filters that limit or restrict when the mobile device sends out position information, including “while receiving and/or sending calls,” “for an instance” or “for a given period of time.” *See supra* at Section III.C.1 (quoting EX1005, 4:62-66, 5:37-41, 10:17-26). As confirmed by Petitioner's declarant in a previous proceeding, sending or receiving position information in Sheha is thus contingent **not** upon what permissions a mobile device has provided to another device but instead upon what privacy filters the mobile device has implemented for all incoming location requests. *Id.*; *see also supra* Section III.C.1.

Aside from Sheha's privacy settings, Petitioners also rely on Sheha's reference to a “group” database and “defin[ing] a group of specific users that are **permitted** access.” Pet., 24 (citing Sheha, 11:55-12:7) (emphasis in original). However, as discussed *supra* in Section III.C.1., Sheha's disclosures regarding “groups” are irrelevant because it only refers to the use of “groups” in the context of “landline-to-landline” requests (not the claimed wireless devices) and a group policy is not “a permission” provided “for” a specific device to access location information as recited in the claims. *See supra* Section III.C.1. These distinctions are important.

The '117 Patent's claimed invention of a wireless telephone providing "a permission" "for" another specific wireless device eliminates security risk and advantageously improves system security. *Id.*

The Board should also reject Petitioners' hindsight attempt to reinterpret Sheha as teaching or suggesting something more. Pet. 25 (citing Williams-Decl. [0171], [0172]-[0174]). That the security advantages provided by the '117 Patent's claimed inventions are only disclosed by the '117 Patent, and not the cited references, should not be taken lightly. *See supra* Section III.C.1; *In re Wesslau*, 353 F.2d at 241; *In re Enhanced Sec. Research*, 739 F.3d at 1355.

Turning next to Randall (Grounds 5 and 6), the Petition likewise falls well short of demonstrating that Randall teaches or suggests these claim limitations. It alleges that "Randall teaches that any 'user must be able to switch location information on for a person or group of people..., i.e. being able to select the person and allow access' to make the user's device's location '[v]isible to specific people (or groups) for a specific period of time'—e.g., 'for the half hour that the group of friends are trying to locate each other in town.'" *See* Pet., 65 (citing §§VIII.B.1.d-VIII.B.1.e ([1D]-[1E] of the Petition), 56 (citing Randall, [0144], [0136], [0143]), . However, Randall does not disclose or suggest the '117 Patent's claimed features that the same device that is capable of having its location determined is capable of providing a permission for another specific device to access the location information,

nor does Randall disclose or suggest the corresponding the security advantages that the '117 Patent teaches these features provide.

As discussed *supra* Section III.C.1, Randall refers to a remote database that can store information regarding multiple individuals and can also “define which entities can read different fields” in the database, but is completely silent as to how those “defin[itions of] which entities can read different fields” are established. Randall, [0047]. Randall does not teach or suggest that such definitions are provided by the same mobile device that is capable of having its location determined, which is a distinct security advantage disclosed and claimed by the '117 Patent. *See supra* at Section III.C.1; EX1001, 1:44-54. This alone is fatal to all of Petitioners’ Grounds involving Randall.

Randall also does not teach or suggest providing “a permission” “for” another device to access location information as claimed in Claim 73. As discussed *supra* at Section III.C.1, the Petition acknowledges that Randall’s system assigns access rights to groups, called “i-Groups.” But, as discussed with respect to Sheha, granting access rights to a group does not teach or suggest providing “location access rights” “for” a wireless device as claimed in Claim 73. *See supra* at Section III.C.1 (explaining that Randall’s use of i-Groups injects ambiguity and uncertainty, and risk of improper disclosure, all of which are inconsistent with the disclosed and

claimed inventions of the '117 Patent). This misreading is fatal to all of Petitioners' Grounds based on Randall.

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

Accordingly, the Board should find that the Petition has failed to demonstrate invalidity of these claim limitations by a "reasonable likelihood," much less a sufficiently strong case of purported invalidity to overcome the factors strongly supporting discretionary denial, and thus should decline to institute Grounds 1-6. *See, e.g., Samsung Elecs.*, IPR2023-00130, Paper 10 at 26 (exercising discretion to deny institution because "Petitioner's showing is less than compelling, as it rests tenuously upon apparent logical leaps"); *Samsung Display*, IPR2024-00855, Paper 12 at 13 (exercising discretion to deny institution because "a genuinely-disputed issue surrounds the correct [claim] construction That genuine dispute, in turn, casts doubt upon whether Petitioner 'is highly likely' to prevail in showing that the [claim] limitation would have been obvious"); *AT&T Servs.*, IPR2024-01142, Paper 14 at 27 (denying institution because "Patent Owner has identified a plausible understanding of the meaning of the claims ... and potential dispositive inadequacies in Petitioner's approach to accounting for features of those claims Petitioner's

proposed grounds cannot be said to rise to the level of a ‘compelling’ meritorious challenge”).

3. Grounds 2 and 3 of the Petition Fail to Establish Obviousness of the Limitation “Providing a First Map Provided with Respect to Said Location” in Claim 73 and Its Dependent Claims

The Board should decline to institute Grounds 2 and 3 because the cited references fail to teach or suggest these claim limitations.

The Petition relies on Sheha’s Figure 5 for the “said first wireless telephone is further operable of providing a first map provided with respect to said location” limitation of Claim 73. Sheha, however, does not disclose or suggest a *wireless telephone* providing Figure 5’s map. Sheha instead explains that “FIG. 5 illustrates an example of a Map Caller-ID indicator and a display window” for a *landline-to-landline* embodiment that requires a peripheral display device capable of displaying, decoding, and processing position information:

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

In this embodiment, the destination telephone 5 is not an advanced telephone 55 capable of decoding and displaying the Map Caller-ID information sent by the telephone

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

EX1005, Sheha, 7:58-67, 8:6-15 (emphases added). This is the only Sheha embodiment referencing Figure 5.

The Petition's selective quotation of Sheha's disclosure as allegedly stating that "both the originating and destination mobile device receive the Map" is incorrect and misleading. Pet., 28-29 (citing Sheha, 11:42-44). Instead, Sheha states that the mobile devices may receive "Map *Caller-ID information*," which is not, and is different than, a graphical map. Sheha, 11:42-44 (emphasis added). Sheha does *not* teach or suggest that a mobile device receives or displays a graphical map of the Map Caller-ID information, much less provide a display like the one illustrated in Figure 5. EX1005, 3:14-17 (describing providing "an alternative form of *Caller-ID (Map Caller-ID)* to a local computing telephone device for display"), 10:27-30 ("[T]he mobile device Map Caller-ID notification is sent to the mobile device as a *conventional Caller-ID message* [and] additional information is added to the original message."), 10:37-39 ("[T]he Map Caller-ID information sent to the mobile device contains the originating position and user identification information"), 11:42-44 (mobile devices receiving "Map Caller-ID information") (emphasis added).

These statements are consistent with Sheha's indication that displaying, decoding, and processing position information is performed, if at all, by an accompanying device, such as a personal computer, television, or navigational device—not a wireless telephone device.

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

However, a *typical mobile navigational device 18d*, such as a cellular phone or wireless PDA, *does not possess all of the capabilities or is not optimal for navigational purposes. An accompanying device 37*, such as an in-vehicle navigational device usually 15 installed in a motor vehicle 39a, *is better suited for navigational displays and computations.*

Id., 12:10-16 (emphases added). That the mobile device embodiments require separate navigational devices for displaying maps is not surprising, as mobile device manufacturers, including the Samsung Petitioners, did not offer map displays in the manner claimed on their mobile devices until years after Sheha.

Sheha also makes clear, and the Petition ignores, that as its name suggests Sheha's Map Caller-ID technology requires a telephone call to obtain location or position information. Indeed, all of Sheha's Map Caller-ID disclosures involve a call, and there is not a single disclosure involving the display of so-called Map Caller-ID information that does not require a call. *E.g.*, EX1005, 7:27-8:24, 9:4-39,

10:27-65, 11:36-54. Accordingly, this establishes that Sheha's Map-Caller ID system does not teach or suggest the claim limitations. Because Sheha's "location" or position information associated with Sheha's Map-Caller ID technology is *always* obtained in connection with a telephone call, Sheha does not teach or suggest "a first map provided with respect to said location" for the additional reason that Claim 73 specifies that "said location" must be "requested ... *outside of a call* for communication." EX1001, 19:6-7, 19:16-18.

Finally, the Petition characterizes Sheha as disclosing that "a map...can be displayed on the mobile telephone." Pet., 28 (citing Sheha, 4:43-58). But the Petition's ellipsis omits important context, and this statement in Sheha is entirely unrelated to Sheha's Figure 5. The statement further does not disclose or suggest a "map provided with respect to said location" of the wireless telephone that has its location determined as claimed in Claim 73 of the '117 Patent. Rather, Sheha's statement at 4:43-58 instead merely refers to displaying "a map and address of the *destination* ...," which at best is the display of information relating to a *different* (landline) device and *not* to the "first wireless device" recited in the claims. *Id.*

Accordingly, because the Petition fundamentally errs in its application of the purported prior art to, and its reading of, these additional claim limitations of Claim 73 of the '117 Patent, the Board should find that the Petition has failed to demonstrate invalidity of these claim limitations, much less a "compelling case" of

purported invalidity, and should decline to institute Grounds 2 and 3 for at least these additional independent reasons.

* * *

The Petition's excessive reliance on conclusory expert testimony further demonstrates the weakness of the merits of Petitioners' unpatentability challenges. *See generally* Pet. (citing "Williams-Decl." over 200 times); *see also, e.g.*, Pet., 14-19 (citing "Williams-Decl." after nearly every sentence). Petitioners' pervasive attempts to buttress weak obviousness combinations with unsupported expert testimony also provides another basis for discretionary denial. *See* EX2003, 2.

IV. CONCLUSION

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

Dated: April 21, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

The undersigned certifies that the portions of the above-captioned PATENT OWNER'S DISCRETIONARY DENIAL BRIEF specified in 37 C.F.R. § 42.24 have 13,793 words, in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24(b)(1). This word count was prepared by the word-processing program used to prepare this paper (Microsoft Word).

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CERTIFICATE OF SERVICE

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