Paper No. __

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

_____

Case No. IPR2025-00365
Patent No. 11,234,117

PETITIONERS' OPPOSITION TO
PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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LISTING OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 11,234,117 ("the '117 patent")
1002	Prosecution History of U.S. Patent No. 11,234,117
1003	Declaration of David H. Williams ("Williams-Decl.")
1004	Curriculum Vitae of David H. Williams
1005	U.S. Patent No. 7,333,820 ("Sheha")
1006	U.S. Provisional Patent Application No. 60/305,975 ("Sheha-Prov.")
1007	U.S. Patent Application Publication No. 2004/0024846 ("Randall")
1008	International Patent Application Publication No. WO 02/17075 ("Randall-WIPO")
1009	RESERVED
1010	RESERVED
1011	RESERVED
1012	RESERVED
1013	U.S. Patent No. 6,968,179 ("De-Vries")
1014	U.S. Patent No. 6,920,328 ("Wollrab")
1015	U.S. Patent No. 6,714,791 ("Friedman")
1016	RESERVED
1017	U.S. Patent No. 6,885,874 ("Grube")
1018	U.S. Patent No. 6,716,101 ("Meadows")
1019	U.S. Patent No. 7,366,522 ("Thomas")
1020	U.S. Patent No. 5,736,960 ("Murphy")
1021	U.S. Patent No. 5,923,286 ("Divakaruni")
1022	International Patent Application Publication No. WO 01/91486 ("Darling")
1023	U.S. Patent No. 6,084,951 ("Smith")
1024	RESERVED
1025	U.S. Patent No. 6,415,224 ("Wako")

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1034	RESERVED
1035	International Patent Application Publication No. WO 00/22860 ("Degnbol")
1036	Civil Docket Report in *Mullen Industries LLC v. Samsung Electronics Co., Ltd. et al.*, Case No. 2:24-cv-00049 (E.D. Tex.) (last checked December 26, 2024)
1037	Federal Court Management Statistics–Profiles, U.S. District Courts–Combined Civil and Criminal (September 30, 2024) (available at https://www.uscourts.gov/file/79291/download)
1038	Docket Control Order in *Mullen Industries LLC v. Samsung Electronics Co., Ltd. et al.*, Case No. 2:24-cv-00049 (E.D. Tex.) (June 14, 2024) (Dkt. 30)
1039	Plaintiff's Disclosure of Asserted Claims and Infringement Contentions in *Mullen Industries LLC v. Samsung Electronics Co., Ltd. et al.*, Case No. 2:24-cv-00049 (E.D. Tex.) (May 15, 2024)
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1041	U.S. Patent Application Publication No. 2003/0074209 ("Tobin")
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1044	U.S. Patent No. 6,269,369 ("Robertson")
1045	U.S. Patent Application Publication No. 2002/0169539 ("Menard")
1046	U.S. Patent No. 7,681,034 ("Lee")

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1051	U.S. Patent No. 6,674,849 (“Froeberg”)
1052	RESERVED
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1054	U.S. Patent No. 6,867,733 (“Sandhu”)
1055	U.S. Patent No. 6,532,418 (“Chun”)
1056	U.S. Patent No. 6,049,718 (“Stewart”)
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1075	U.S. Patent No. 6,208,934 ("Bechtolsheim")
1076	U.S. Patent Application Publication No. 2003/0040272 ("Lelievre")
1077	U.S. Patent No. 5,048,117 ("Aisaka")
1078	U.S. Patent No. 5,212,811 ("Kuge")
1079	Sotera Stipulation Letter dated February 11, 2025
1080	Plaintiff's Preliminary Pre-Trial Election of Asserted Claims in *Mullen Industries LLC v. Samsung Electronics Co., Ltd. et al.*, Case No. 2:24-cv-00049 (E.D. Tex.) served on March 20, 2025
1081	Apr. 18, 2025 Letter from United States Senate to Secretary Howard Lutnick
1082	Congressional Research Service, *The Patent Trial and Appeal Board and Inter Partes Review*, R48016 (May 28, 2024)
1083	"About Google," available at: https://about.google/intl/ALL_us/around-the-globe/local-info/ (accessed May 25, 2025)
1084	"Samsung in America," available at: https://news.samsung.com/us/samsung-in-america (accessed May 25, 2025)
1085	*Mullen Industries LLC v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00049-JRG, Plaintiff's Final Pre-trial Election of Asserted Claims (E.D. Tex. May 2, 2025)
1086	*In re Samsung Elecs. Co., Ltd.*, No. 2025-129, Samsung Mandamus Petition, Dkt. 2 (Fed. Cir. May 8, 2025)
1087	Lex Machina Statistics for District Judge James Rodney Gilstrap (accessed May 14, 2025)
1088	*Mullen Industries LLC v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00049-JRG, Docket Order Resetting Markman Hearing (May 9, 2025)
1089	*Mullen Industries LLC v. Samsung Elecs. Co., Ltd.*, No. 2:24-cv-00049-JRG, Fourth Amended Docket Control Order, Dkt. 85 (E.D. Tex. Mar. 12, 2025)

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1090	Dana Nguyen, *IPR Estoppel's Evolving Landscape*, XV Nat'l L. Rev. 141 (Feb. 10, 2025), available at: https://natlawreview.com/article/ipr-estoppels-evolving-landscape
1091	June 18, 2024 Letter from Council for Innovation Promotion (C4IP) to The Honorable Katherine K. Vidal re: Docket No. PTO-P-2023-0048, Patent Trial and Appeal Board Rules of Practice for Briefing Discretionary Denial Issues, and Rules for 325(d) Considerations, Instituting Parallel and Serial Petitions, and Termination Due to Settlement Agreement, available at: https://c4ip.org/wp-content/uploads/2024/06/C4IP-Comment-RE-PTO-P-2023-0048.pdf
1092	June 20, 2023 Comments of Innovation Alliance in Response to the USPTO's Advance Notice of Proposed Rulemaking Regarding Changes Under Consideration to Discretionary Institution Practices, Petition Word-Count Limits, and Settlement Practices for America Invents Act Trial Proceedings Before the Patent Trial and Appeal Board (Docket No. PTO-P-2020-0022)
1093	June 20, 2023 Letter from AbbVie to The Honorable Kathi Vidal re: Docket No. PTO-P-2020-0022: Advance Notice of Proposed Rulemaking on Changes Under Consideration to Discretionary Institution Practices, Petition Word-Count Limits, and Settlement Practices for America Invents Act Trial Proceedings Before the Patent Trial and Appeal Board
1094	June 20, 2023 Letter from Ericsson to Hon. Kathi Vidal re: Comments on Changes Under Consideration to Discretionary Institution Practices, Petition Word-Count Limits, and Settlement Practices for America Invents Act Trial Proceedings Before the Patent Trial and Appeal Board (Docket No. PTO-P-2022-0022)
1095	June 20, 2023 Letter from Nokia to Michael Tierney, Vice Chief Administrative Patent Judge re: Docket No. PTO-P-2020-0022
1096	Nathan Sportel, *Did Sotera Stipulations Solve the Fintiv Criticisms*, 21 Chicago-Kent J. Intell. Prop. (2022)
1097	Ryan Davis, "PTAB Ramps Up Fintiv Denials After Withdrawal Of Memo," Law360 (May 13, 2025, 10:46 PM EDT), available at: https://www.law360.com/articles/2339744/ptab-ramps-up-fintiv-denials-after-withdrawal-of-memo

Exhibit	Description
1098	Brief of The National Retail Federation, The High Tech Inventors Alliance, et al., as Amici Curiae in Support of Apple and Reversal, *Apple Inc., v. Stewart*, No. 24-1864 at 22 (Fed. Cir. Aug. 12, 2024)
1099	Federal Court Management Statistics–Profiles, U.S. District Courts–Combined Civil and Criminal (March 31, 2025) (available at https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0331.2025.pdf)
1100	*In re SAP Am., Inc.*, Petition for Writ of Mandamus, No. 25-____ (Fed. Cir. June 13, 2025)

I. INTRODUCTION

This IPR should be instituted; discretionary denial is not warranted. As discussed below, compelling economic interests favor institution. The *Fintiv* factors favor institution. Contrary to Patent Owner's ("Mullen"'s) assertions, the Petition's unpatentability grounds are strong, and its use of expert testimony is entirely appropriate and supportive. Mullen's exceedingly weak arguments against the Petition's grounds repeat from the same arguments the Board's merits panel soundly rejected in its recent decisions instituting four of Petitioners' IPRs against Mullen's related patents, where the panel (Judges Smith, Quinn, and Parvis) explicitly found that Petitioners' unpatentability case is strong. *See* Section IV below. A panel with two of the same judges (Judges Smith and Parvis) also previously instituted Apple's IPR2023-00115 on the same claims challenged here and based on one of the same primary prior-art references presented here; that IPR settled before a final written decision could be issued canceling the challenged claims. These "considerations…counsel against discretionary denial." *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, -00219, -00220, -00221, -00222, Paper 9 at 2 (June 13, 2025); IPR2025-00339, Paper 10 at 2 (June 13, 2025).

The patent challenged here ("the '117 patent") is among a family of eight patents that share a specification and "recite well-known and obvious features of remotely locating a first wireless device from a second wireless device." *See*

Google LLC v. Mullen Industries LLC, IPR2025-00018, Paper 14 at 13-14 (May 12, 2025) (granting institution); *accord* IPR2025-00019, Paper 14 at 13 (May 12, 2025) (granting institution); IPR2025-00021, Paper 14 at 11-12 (May 14, 2025) (granting institution); IPR2025-00124, Paper 14 at 12 (May 12, 2025) (granting institution). The lack of any true innovation actually deserving of patent protection is evident from the patents' protracted prosecution history. It took Mullen ***ten years*** from the filing of the patents' shared specification in 2003 to get a first claim set (patent 8,374,575) granted in 2013 after seven rejections. Another ***nine years*** were then spent collecting seven more patents via incremental variations on the same base concepts.

After collecting all those claim variations on the same well-known and obvious concepts, Mullen simultaneously asserted all of them against Apple the day after the last patent (11,246,024) issued in 2022. Just as Petitioners have here, Apple filed eleven IPRs to challenge these eight patents (which collectively total ***339 claims***); and the Board instituted eight of them. Rather than seeing those IPR trials through to judgment on the unpatentability of the instituted claims, Mullen settled with Apple and retained all 339 claims, which were used (together with another patent) to sue Samsung only a few months later. Now, faced with even stronger IPRs filed ***by statutory right*** by the subsequent defendant whom Mullen ***deliberately chose*** to sue sequentially, Mullen seeks to avoid the well-deserved

cancellation of its unpatentable claims by using its own litigation conduct as both a sword and a shield, in order to retain the ability to continue to sue not only this defendant but unknown numbers of future targets on invalid patents that should never have issued in the first place.

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

This case presents even more confirmation of strong unpatentability merits than the recent *Tesla* decisions denying Intellectual Ventures' requests for discretionary denial, in which the Director explained that "the merits are strong because the Board previously determined there was a reasonable likelihood that similar claims of an ancestor patent were unpatentable in three separate

proceedings with respect to some of the challenged patents in these [*Tesla*] proceedings." IPR2025-00217, -00219, -00220, -00221, -00222, Paper 9 at 2; IPR2025-00339, Paper 10 at 2. Here, the Board previously determined there was a reasonable likelihood of unpatentability of the ***same*** claims challenged in this IPR ('117 claims 1-14 and 73-92) when it granted institution of Apple's IPR2023-00115, which included a set of grounds based on the same Sheha reference used in one of Petitioners' sets of grounds here. ***And*** the Board has recently determined there is a reasonable likelihood that similar claims of Mullen's related patents are unpatentable in four separate proceedings: IPR2025-00018, -00019, -00124, and -00021. In fact, as discussed in Section IV below, the independent claims of the '117 patent challenged in this IPR are duplicates of claims in Mullen's '575 and '418 patents "with small word or small phrase changes" (*see* EX1002 at 1503), and the Board has now found a reasonable likelihood of unpatentability of those claims ***twice***: once in instituting Apple's IPR2023-00097 and -00090 (which settled post-institution), and once again in instituting Petitioners' IPR2025-00124 and -00018.

The Board is well familiar with these patents and has competently rejected Mullen's various attempted iterations of the same weak substantive arguments multiple times now. To discretionarily deny this IPR would be a waste of the considerable expertise the Board's merits panel has developed on this large set of Mullen patents and the relevant prior art, and would be the opposite of promoting

efficiency between the proceedings. *See also Tesla*, IPR2025-00217, -00219, -00220, -00221, -00222, Paper 9 at 3 ("the Board is better suited to review a large number of patents involving diverse subject matter" than a district court); IPR2025-00339, Paper 10 at 3 (same).

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

II. COMPELLING ECONOMIC INTERESTS FAVOR INSTITUTION

Compelling economic interests strongly support instituting this and Petitioners' related pending IPRs. *See* Interim Processes for PTAB Workload Management (Mar. 26, 2025), 2-3 (inviting parties to address "[c]ompelling economic, public health, or national security interests" as "relevant considerations" that "bear[] on the Director's discretion"). This is the case in light of the technological contributions made by Petitioners in the United States; no such contributions are made by Mullen generally or as to the patents at issue in these IPRs.

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

Unlike Mullen, Petitioners have invested and continue to invest heavily in the American economy. For example, in 2024, Google invested over $49 billion in research and development to power American technological leadership, and to produce unprecedented leaps in artificial intelligence and quantum computing capabilities that advance national security. *See* EX1083. Google created $850 billion in economic activity for American businesses, nonprofits, publishers, creators, and developers in 2024; maintains offices or data centers in twenty-six

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

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

states; and employs over 100,000 individuals throughout the United States. *See* EX1083. Similarly, Samsung has invested over $100 billion in the United States, generated over $31.2 billion with its U.S. facilities, and created over 175,000 jobs with its U.S. facilities. *See* EX1084.

III. THE *FINTIV* FACTORS FAVOR INSTITUTION

It would be a miscarriage of justice to deny this IPR under *Fintiv*. Mullen's assertion that the district-court case will "resolve all of the issues" presented in this IPR is not remotely true. Patent Owner's Discretionary Denial Brief (Paper 13) ("DD-Brief"), 9, 14, 30.

This IPR challenges 34 claims of the '117 patent (claims 1-14 and 73-92)—all of which were asserted against Samsung when the Petition was filed. Whereas now, Mullen has elected to proceed with ***only one*** of those claims (claim 1) in district court. EX1085. The district court will have no opportunity whatsoever to "invalidat[e] ***the patent[]***" (DD-Brief, 7)[3]—it would only be able to assess claim 1, and only if that claim's validity remains at issue through trial and judgment. If Petitioners' IPR is never considered on its merits, at least 33 demonstrably unpatentable claims will remain at large for Mullen to use in harassing its next set of targets. Denying Petitioners their opportunity to demonstrate to the Board why

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

these claims should be cancelled to prevent further vexatious litigation would be a public disservice and contrary to the very purposes and charge of the PTAB.

Any alleged prejudice to Mullen based on the number of IPR proceedings filed against Mullen's patents is self-imposed. The "large number" of "patents asserted in the district court litigation" in fact "weighs ***against*** discretionary denial, as the Board is better suited to review a large number of patents…." *Tesla*, IPR2025-00217, -00219, -00220, -00221, -00222, Paper 9 at 3; IPR2025-00339, Paper 10 at 3. It was not ***Petitioners'*** choice to "multiply the proceedings" needed to address Mullen's meritless patent assertions (DD-Brief, 2); it was ***Mullen*** that chose to file a complaint in district court asserting nine patents totaling 378 claims against Samsung.[4] It is not possible to challenge a set of patents via fewer than one IPR per patent (*see* 35 U.S.C. §311), and two of Mullen's patents contain extraordinary numbers of claims (78 and 92 claims) that could not be addressed in

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[4] Mullen cites *General Plastic Indus. Co. v. Canon Kabushiki Kaisha* to argue that "the Board should deny institution to serve and maintain the goals of efficiency and efficacy, as well as fairness to" Mullen. DD-Brief, 9-10. But *General Plastic* addresses the potential for abuse when the same petitioner strategically files multiple, sequential IPR petitions "challenging the same patent and same claims…using [the Board's] decisions as a roadmap, until a ground is found that results in the grant of review." IPR2016-01357, Paper 19 at 11, 16-17 (Sept. 6, 2017). That is very different from this case where Petitioners diligently filed a set of twelve IPR petitions to address the vast amount of claims in the nine patents that were asserted by Mullen in the district-court case.

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

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

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

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

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

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

Mullen's argument that Judge Gilstrap's orders in other past cases show that "it is a near certainty" that he "will deny any refiled motion to stay" here (DD-Brief, 11-14) is not accurate. To the contrary, Judge Gilstrap has often granted

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

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

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

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

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

Therefore, this factor weighs against discretionary denial.

B. Factor 2: The Trial Date Is Uncertain

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

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[9] DD-Brief, 13 (citing *Oyster Optics* (EX2011) (one of the asserted claims not instituted (*id*. at 5-6)).

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

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

the Northern District of California." DD-Brief, 16. But Judge Gilstrap's order denying Samsung's motion to transfer does not substantially change the calculus for factor 2 because Judge Gilstrap has seven trials set for the same date. While Mullen speculates that trial will occur as scheduled (DD-Brief, 15 (citing EX2012, 2)[12]), seven trials certainly cannot proceed before the same judge on the same date. Therefore, the number of cases that are scheduled on the same date, coupled with the certainty that the date ***will not*** stick for all but one of them, and the ***impossibility*** of knowing which, makes this factor weigh against discretionary denial.[13] Additionally, the Eastern District of Texas continues to grow more

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[12] Mullen argues that in *TESO LT, UAB v. Luminati Networks Ltd.* the Board "den[ied] institution despite possibility of 'some delay in the trial date due to crowded docket conditions' because 'presuming that there would be extensive delay would be conjecture at this time.'" DD-Brief, 15-16. But the posture of *TESO* makes it inapplicable here as it occurred immediately after the COVID-19 pandemic in 2021. The Board's reference to crowded docket conditions and petitioner's arguments regarding speculative further delays were COVID-related. IPR2021-00249, Paper 12 at 7-9 (Jun. 2, 2021). Moreover, the trial was much more imminent than is the case here.

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

congested, and its median time-to-trial is now 25.9 months (EX1099, 35), which would place trial in Mullen's litigation against Samsung in March 2026, nearly five months later than scheduled.

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

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

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

USC IP P'Ship, IPR2021-00034, Paper 13 at 11 (Apr. 30, 2021). The Board has previously instituted proceedings on comparable timing.[15]

Mullen cites a string of cases to support its argument that the gap between the trial and FWD "strongly favors discretionary denial" but each is either pre-*Fintiv* and pre-*Sotera* (and much has changed in this area of law over the last six years)[16] or involved an imminent determination in an ITC proceeding where the same grounds and references from the IPRs were at issue before the ITC,[17] or

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[15] *See, e.g., PNC Bank, N.A. v. United Services Automobile Ass'n*, IPR2022-00075, Paper 21 at 9-12 (June 13, 2022) (finding "the minimization of overlap" from petitioner's *Sotera* stipulation "and the strength of the merits presented in the Petition outweigh the upcoming trial date and investment" where district-court trial was scheduled nine months before FWD); *TCL Electronics Holdings Ltd. v. Maxell, Ltd.*, IPR2025-00120, Paper 9 at 6-10 (May 20, 2025) (similar, with trial eight months before FWD); *T-Mobile USA, Inc. v. Cobblestone Wireless, LLC*, IPR2024-00137, Paper 15 (May 22, 2024) (other factors outweighing that there was eight months between trial and FWD; instituting); *Dolby Labs., Inc. v. Intertrust Techs. Corp.*, IPR2020-00665, Paper 11 (Feb. 16, 2021) (same); *Samsung Display Co. v. Pictiva Displays Int'l Ltd.*, IPR2024-01223, Paper 11 (Mar. 6, 2025) (seven months between trial and FWD); *Samsung Display Co. v. Pictiva Displays Int'l Ltd.*, IPR2024-01222, Paper 12 (Mar. 6, 2025) (same).

[16] DD-Brief, 14-15 (citing *Next Caller, Inc. v. TrustID, Inc.*, IPR2019-00961, Paper 10 (Oct. 16, 2019) (predates the designation of both *Fintiv* and *Sotera* as precedential); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 (May 15, 2019) (same)).

[17] DD-Brief, 14-15 (citing *Satco Prods., Inc. v. The Regents of the Univ. of Cal.*, IPR2021-00794, Paper 14 at 18-25 (Nov. 10, 2021) (ITC proceeding was days away from initial determination, post-trial briefing was completed, and petitioner relied on the same prior-art references "in essentially the same way for its [IPR] challenges and its invalidity defenses in the [ITC] investigation" which weighed

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

Moreover, due to timing of post-trial briefing and decisions, a final district-court judgment will generally come about four months after a jury verdict, so the proper comparison should compare when the district court's final judgment will issue to the timing of the Board's FWD, for an apples-to-apples comparison. For example, trial statistics in EDTX before Judge Gilstrap indicate that the median number of days between trial and termination of his cases is 117 days. EX1087 (Judge Gilstrap's median days to trial is 655 days and median days to termination is 772 days). The Board has considered this statistic in the *Fintiv* analysis, noting: "that a jury trial may occur in the district court before any Final Decision would be due here does not guarantee the entry of final judgment by the district court" in that

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against institution); *Stanley Black & Decker, Inc. v. Zircon Corp.*, IPR2020-01572, Paper 10 at 12-18 (Apr. 19, 2021) ("ITC investigation will have been complete in its entirety…almost three months before the" FWD, "the [ITC] references and combinations alleged to invalidate" were identical in the IPR, and "[t]he [ITC] grounds of invalidity…include[d] those in the Petition, as it [was] incorporated by reference," which weighed against institution)).

[18] DD-Brief, 14-15 (citing *MaxLite, Inc. v. Jiaxing Super Lighting Elec. Appliance Co.*, IPR2020-00208, Paper 32 at 8 (Oct. 12, 2021) (denying patent owner's request for rehearing of the Board's decision reversing institution denial)).

same timeframe "as the district court litigation may still need to continue with a damages trial and post-trial motions." *See, e.g., Provisur Techs., Inc. v. Weber Food Tech. GmbH*, IPR2024-00269, 2024 WL 2978288, at *12 (PTAB June 13, 2024) (concurrence) (citation omitted).[19] Accordingly, the nearly four months that it will take for Judge Gilstrap to evaluate post-trial briefing and issue a final judgment must also be accounted for in evaluation of this factor.

Therefore, this factor weighs against discretionary denial.

C. Factor 3: There Is Significant Work Remaining

This factor weighs against discretionary denial because "a significant portion of work remains to be done in the district court proceeding." *Protect Animals With Satellites LLC v. OnPoint Sys., LLC*, IPR2021-01483, Paper 11 at 14-15 (Mar. 4, 2022). The parties have only just completed claim-construction briefing with a *Markman* hearing held only yesterday (June 17; *see* EX1088, 8); the parties have only just begun expert discovery, which is currently scheduled to be completed on July 17; and dispositive motions are not scheduled to be filed until July 28.

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

EX1089, 3. It is possible that the case and trial schedule may be further adjusted in light of Samsung's mandamus petition. The Board has declined to discretionarily deny IPRs under similar circumstances.[20]

Mullen argues that "Petitioners waited more than 11 months from the time the district court complaint was filed to submit the Petitions" and therefore were not "diligent." DD Brief, 17-18 (citing *Verizon Business Network Servs., Inc. v. Huawei Techs. Co.*, IPR2020-01141, Paper 12 (Jan. 14, 2021)). But Mullen's district-court complaint asserted ***nine patents*** against Samsung, which collectively contain ***378 claims***. And Mullen's infringement contentions, served on Samsung nearly four months after the complaint, ***asserted 272 claims involving over 650 pages of claim charts***. EX1067. Given that nearly 75% of the total claims across all of the patents were asserted in the infringement contentions, Petitioners were not able to meaningfully down-select what they challenged in the IPR. Thus,

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[20] *See, e.g., PNC*, IPR2022-00075, Paper 21 at 9-12 ("We conclude that the minimization of overlap and the strength of the merits presented in the Petition outweigh the upcoming trial date and investment" where "claim construction, expert discovery, and dispositive motions will be completed before a decision on institution is expected."); *AGIS Software Dev. LLC v. Google LLC*, No. 2:19-CV-00359-JRG, 2021 WL 465424, at *3 (E.D. Tex. Feb. 9, 2021) (Judge Gilstrap noting that even "with discovery complete, pretrial briefing submitted, and jury selection pending—***there remain significant resources yet to be expended by the parties***, including at the pretrial conference and preparations leading up to an actual trial of this case").

Petitioners expeditiously prepared and filed twelve IPR petitions challenging 343 claims across all nine patents[21] between September 30 and December 30, 2024, within 5-8 months of receiving Mullen's infringement contentions. It is this timing, between when Petitioner became "aware of the claims being asserted" vis-à-vis the infringement contentions and the filing of the IPRs, that the Board considered for diligence in *Verizon*—not the timing between the filing of the complaint and the IPRs, as Mullen asserts. IPR2020-01141, Paper 12 at 12 ("We credit Petitioner's diligence in filing the Petition in this case within a short time (less than three months) ***after being served infringement contentions in the parallel case***.").

Indeed, the Board has expressly found that comparable time periods between infringement contentions and IPR filings were diligent. *See, e.g., Zynga Inc. v. IGT*, IPR2022-00199, Paper 11 at 15-16 (June 14, 2022) (determining petitioner acted reasonably diligently when it filed its petition approximately five months after receiving initial infringement contentions); *Zynga Inc. v. IGT*, IPR2022-00223, Paper 10 at 13-14 (June 7, 2022) (same). Contrary to Mullen's mischaracterization, Petitioners did not "wait" to file these IPRs—the time it took

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

Petitioners to diligently prepare challenges mapping ***343 claims*** was eminently reasonable, and entirely caused by Mullen's vexatious over-assertion of over 250 more claims than it would ever be permitted to actually present at trial in the district court.

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

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

granted, including in EDTX.[22] If a litigation stay is still opposed by Mullen after institution, any inefficiencies should be weighed against Mullen for refusing to agree to stay the case, not Petitioners.

Therefore, this factor weighs against discretionary denial.

D. Factor 4: No Overlap

1. Only One Challenged Claim Overlaps

Mullen argues that "Petitioners challenge almost the exact same claims in their Petition…that they do in their invalidity contentions at the district court." DD-Brief, 18 (citing EX2014, 2)). This is a red herring and has the issue backwards. Petitioner Samsung's IPR petitions and invalidity contentions responded to the claims ***that were asserted by Mullen*** in the district court, where—under EDTX P.R. 3-3 and 3-4—Samsung had an obligation to disclose every single theory that it may possibly assert in the district-court litigation many months before it filed its IPR petitions, or otherwise those arguments would be deemed waived.

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

Moreover, the proper consideration is the number of claims that these IPRs challenge that will ***never*** be addressed by the district court. Petitioners' IPR Petitions addressing the '117 patent (IPR2025-00365, -00366, and -00367) cover all 92 claims of the '117 patent, whereas only five claims are currently set to be addressed by the district court (i.e., only one or two challenged claims in each IPR). EX1085. Thus, ***95% of the '117 patent's claims will only ever be addressed by the Board***, and there is no potential for overlap on these claims.[23] Thus, the fact that 95% of the '117 patent's claims will only ever be addressed by the PTAB, coupled with Samsung's *Sotera* stipulation, ensures that IPR is a "true alternative" forum to address issues that will not, and cannot, be addressed

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

elsewhere. *Palo Alto*, IPR2021-01149, Paper 10 at 10-11. And because of statutory estoppel, this efficiency accrues whether Mullen or Petitioners ultimately prevail.

Mullen's stipulation not to assert dropped claims against Samsung (DD-Brief, 19) does not resolve the issue because Mullen has not made the same assurances against co-Petitioner Google, or any of Petitioners' customers. Nor has Mullen offered a license and covenant not to sue, which would finally exhaust the risk of claims against the Petitioners.

Mullen further argues that "Petitioners even rely on the same references in the Petition as they do in the parallel district court litigation." DD-Brief, 18 (citing EX2014, 169). Here, too, the fact that Samsung was obligated under EDTX P.R. 3-3 and 3-4 to identify all possible prior art to preserve its defenses months before its Petitions were filed should not be held against Petitioners' IPRs now. Indeed, the very purpose of disclosing invalidity contentions early in the litigation is for the parties to provide notice of and preserve their right to make arguments, not to set out the exact arguments that will ultimately be presented at trial, which happens much later.[24]

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

It is routine, expected, and in many cases required by Judge Gilstrap that the parties' initial arguments from their contentions be narrowed at various stages during the litigation leading up to trial.[25] For example, the DCO in the EDTX litigation requires Samsung to disclose its final prior-art references and

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the contentions."); *Smart Path Connections, LLC v. Nokia of Am. Corp.*, No. 2:22-CV-0296-JRG-RSP, 2024 WL 1096138, at *4 (E.D. Tex. Mar. 13, 2024) (same); *GREE, Inc. v. Supercell Oy*, No. 2:19-CV-00070-JRG-RSP, 2020 WL 6731050, at *3 (E.D. Tex. Aug. 14, 2020) ("Indeed, one of the desired outcomes of discovery and a result of expert reports is the crystallization of invalidity and infringement theories preserved in a party's contentions."); *Kroy IP Holdings, LLC v. AutoZone, Inc.*, No. 2:13-CV-888-WCB, 2014 WL 7463099, at *4 (E.D. Tex. Dec. 30, 2014) ("Invalidity contentions are procedural tools for providing notice of a party's specific theories of invalidity[.]"); *Crocs, Inc. v. Effervescent, Inc.*, No. 06-CV-00605-PAB-KMT, 2017 WL 5171332, at *2 (D. Colo. Nov. 8, 2017) ("A requirement that parties to a patent case disclose infringement, non-infringement, and invalidity contentions is intended to require the parties to provide 'early notice of their infringement and invalidity contentions, and to proceed with diligence in amending those contentions when new information comes to light in the course of discovery.'" (citation omitted)).

[25] *See, e.g., Personalized Media Commc'ns, LLC v. Google LLC*, No. 2:19-CV-00090-JRG, Dkt. 476 at 2 (E.D. Tex. Jan. 26, 2021) ("Almost every case is narrowed from both sides of the docket as it moves from pleadings to discovery to trial. The Court's rules contemplate just such a progression."); *Video Sols. Pte. Ltd. v. Cisco Sys., Inc.*, No. 2:23-CV-00222-JRG, Dkt. 223 at 1 (E.D. Tex. Jan. 17, 2025) ("As consistent with this Court's practice encouraging parties to narrow the issues and streamline their case in preparation for trial, the Docket Control Order allows Plaintiff to narrow its case and disclose its final election of Asserted Claims up to and until 10 days before jury selection." (citation omitted)); *Content Guard Holdings, Inc. v. Amazon.com, Inc.*, No. 2:13-CV-1112-JRG, Dkt. 456 at 20 (E.D. Tex. Mar. 19, 2015) ("After much consideration, the Court has determined that the best time for this proceeding is likely after the close of expert discovery but before pretrial proceedings commence in full. At that point, the case should be substantially narrowed[.]").

combinations seven days before jury selection. EX1089. Samsung should not be penalized by the Board for following the Court's rules on invalidity contentions. Moreover, as discussed above, Mullen has already substantially narrowed the asserted claims in the litigation since the parties filed their initial contentions such that 95% of the '117 patent's claims will only ever be addressed in the IPRs. That combined with Samsung's *Sotera* stipulation significantly reduces the overlap between proceedings.

Mullen cites a string of cases to support its argument that the Board should deny institution notwithstanding Samsung's *Sotera* stipulation, but those relate to instances where there was complete overlap between the asserted claims and the claims challenged in the IPR, or there was nearly a year-long gap between trial and the FWD, which weighed in favor of denial.[26] Here, the gap between the scheduled trial date and the FWD is nine months (and reduces to less than five months when considering median time-to-trial statistics), substantial work remains

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[26] DD-Brief, 18-19 (citing *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3 (Mar. 28, 2025) (11-month gap between trial and FWD); *SAP Am. Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 9 (Apr. 7, 2025) ("all claims being contested as invalid in the Litigation are also subject to a challenge in the Petition")), 28 (citing *Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00333, Paper No. 12 at 6, 10-11 (July 7, 2021) (11-month gap between trial and FWD)).

in the parallel litigation, and Petitioners are challenging significantly more claims in the IPRs than are asserted in the district court litigation.

2. Samsung's *Sotera* Stipulation

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

Mullen argues that "even when a petitioner files a purported '*Sotera*' stipulation, it is not dispositive of whether the Board should deny institution under *Fintiv*." DD-Brief, 27. As an initial matter, such stipulations ***were dispositive*** between Director Vidal's June 21, 2022 guidance memorandum ("the Vidal Memo")[27] until February 28, 2025, when the USPTO withdrew the Vidal Memo. Petitioners operated under the Vidal Memo's binding guidance when preparing and filing this and the other petitions in response to Mullen's assertion of several

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

hundred patent claims. Respectfully, it would be a violation of Petitioners' due-process rights to apply this change ***retroactively*** to deny this Petition based on the EDTX trial date when Petitioner relied on the rules as they existed at the time Petitioner drafted and filed its Petition. *See In re SAP Am., Inc.*, Petition for Writ of Mandamus at 14-15, No. 25-____ (Fed. Cir. June 13, 2025) (EX1100); *see also* Petitioner's Request for Rehearing of Order Granting Director Review, *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 20 at 5-10 (Apr. 28, 2025) ("Motorola Rehearing Request").

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

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[28] *See, e.g., Samsung Elecs. Co. v. Harbor Island Dynamic LLC*, IPR2024-01403, Paper 9 at 39 (Mar. 24, 2025); *Samsung Elecs. Co. v. Harbor Island Dynamic LLC*, IPR2024-01405, Paper 9 at 36 (Mar. 24, 2025); *Samsung Elecs. Co. v. Headwater Rsch. LLC*, IPR2024-01407, Paper 9 at 8 (Mar. 20, 2025); *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01433, Paper 13 at 12 (Apr. 7, 2025); *MediaTek Inc. v. ParkerVision, Inc.*, IPR2025-00030, Paper 9 at 21-22 (Mar. 31, 2025); *Home*

by then-Director Iancu and the June 21, 2022 Vidal Memo, the vast majority of Board decisions did not exercise discretion to deny institution based on *Fintiv*.[29] To be sure, newly promulgated FAQ 14[30] is inconsistent with long-standing precedent:

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

Depot, IPR2024-01420, Paper 12 at 48; *Home Depot USA, Inc. v. RavenWhite Sec. Inc.*, IPR2024-01316, Paper 12 at 12 (Mar. 24, 2025); *Deltran USA, LLC v. The Noco Co.*, IPR2024-01219, Paper 8 at 18 (Mar. 19, 2025); *Palo Alto Networks, Inc. v. Croga Innovations Ltd.*, IPR2024-01421, Paper 8 at 12-13 (Mar. 14, 2025); *Canadian Solar Inc. v. Maxeon Solar PTE Ltd.*, IPR2024-01040, Paper 13 at 17 (Jan. 14, 2025).

[29] Of the 57 cases in which a *Sotera*-stipulation was filed during that time period, institution was granted in 52 cases. All five cases where institution was denied are distinguishable: four are the *Cisco v. Estech* cases, discussed *supra* at n.26, where there was an 11-month gap between trial and the FWD (IPR2021-00329, -00331, -00332, and -00333), and the last case is *Immersion Sys. LLC v. Midas Green Techs., LLC*, IPR2021-01176, Paper 16 at 16-17 (Jan. 6, 2022), where the *Sotera*-stipulation was found insufficient because it was contingent upon completion of the IPR proceeding with a FWD and tied to an asserted likelihood of the court granting a stay in the litigation. *See also* EX1096.

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

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

Samsung's *Sotera* stipulation—indeed any correctly formulated *Sotera* stipulation—should be dispositive in most circumstances. Fundamentally, Samsung has already agreed that it will not raise in district court any grounds that it raised or reasonably could have raised in the IPR.[31] The scope of the stipulation is coextensive with that of the estoppel statute by design. *Compare* EX1079 ("[If instituted,] Samsung will not pursue in the above-captioned litigation any grounds that were raised or reasonably could have been raised in the IPR.") *with* 35 U.S.C. §315(e)(2) ("[Upon a final written decision, the petitioner may not assert invalidity] on any ground that the petitioner raised or reasonably could have raised during that inter partes review"). *Sotera* effectively brings IPR estoppel forward to the point of institution. *See* EX1090, 2 ("Sotera stipulations serve to assure [that], if the PTAB institutes the IPRs, the Patent Challenger will not pursue estopped invalidity theories in the district court as the parallel litigation proceeds.").

It is for this reason that the Board recognized that *Sotera* fully addresses the issue of overlap. *See Philip Morris Prods., S.A. v. RAI Strategic Holdings*, IPR2020-01094, Paper 9 at 22-23 (Jan. 25, 2021) (noting that "one way for a

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[31] The '117 patent was never eligible for PGR.

petitioner to ***avoid overlap***, inefficiency, and the possibility of conflicting decisions is to provide a [*Sotera*] stipulation. … Petitioner's decision ensures that an *inter partes* review is a '***true alternative***' to the ITC investigation."). That is because grounds that include device and system art based on an on-sale bar or public use can ***never*** be reasonably raised in an IPR. *See* 35 U.S.C. §311(b) ("A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent…***only on the basis of prior art consisting of patents or printed publications***.").

Therefore, by filing a *Sotera*-stipulation, Samsung has already agreed to be bound to the full scope of statutory estoppel under §315(e)(2) upon IPR institution and ensures that the IPR is a true alternative—as much as it can be under the statute. Contrary to Mullen's argument, there is simply no reasonable or sound basis for forcing Samsung and others to consent to estoppel greater than the AIA implementing statutes allow for. Forcing parties to do so by suggesting so in new FAQs undermines the Congressional intent limiting the scope of IPR challenges that the Federal Circuit explained in the recent precedential decision *Ingenico, Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365 (Fed. Cir. May 7, 2025) ("Congress

intentionally limited an IPR's scope to invalidity challenges based on 'prior art consisting of patents or printed publications.'").[32]

Respectfully, suggesting Petitioner waive defenses beyond the statutory estoppel's requirement also does not make any sense. Recent USPTO FAQ 14 stating that *Sotera*-stipulations may not be particularly meaningful is based on the misguided notion that such stipulations serve efficiency only if they "ensure that [the] IPR proceeding[] would be a '***true alternative***' to the district court

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[32] *See also, e.g., Microchip Tech. Inc. v. Aptiv Servs. US LL*C, No. 1:17-CV-01194-JDW, 2020 WL 4335519, at *4 (D. Del. July 28, 2020) ("As the plain language of [35 U.S.C. §311(b)] makes clear, petitioners for IPR can only raise invalidity grounds based on patents and printed publications. They cannot raise physical device prior art."); *Singular Computing LLC v. Google LLC*, 668 F. Supp. 3d 64, 70 (D. Mass. 2023) ("A petitioner in an IPR proceeding cannot challenge the validity of a patent based on prior-art products or systems."); *Altria Client Servs. LLC v. R.J. Reynolds Vapor Co.*, No. 1:20-CV-472, 2022 WL 2757481, at *10 (M.D.N.C. July 14, 2022) ("The PTAB also did not have prior art products before it as this Court does because the PTAB may only base invalidity decisions on prior art patents and printed publications."); *Clearlamp, LLC v. LKQ Corp.*, No. 12-CV-2533, 2016 WL 4734389, at *9 (N.D. Ill. Mar. 18, 2016), judgment entered, 2016 WL 7013478 (N.D. Ill. Nov. 30, 2016) ("[U]nlike in district court litigation, products cannot be offered as prior art during inter partes review."); *Wi-LAN Inc. v. LG Elecs., Inc.*, 421 F. Supp. 3d 911, 922 (S.D. Cal. 2019) ("In an IPR, a petitioner is limited to challenging patent claims as invalid only on grounds 'that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.' 35 U.S.C. § 311(b)."); *Netlist, Inc. v. Micron Tech., Inc.*, No. 2:22-CV-203-JRG-RSP, 2024 WL 402181, at *1 (E.D. Tex. Jan. 10, 2024), report and recommendation adopted, 2024 WL 387787 (E.D. Tex. Jan. 31, 2024) (same); *Gen. Access Sols., Ltd. v. Sprint Spectrum LLC*, No. 2:20-CV-00007-RWS, 2021 WL 5154085, at *3 (E.D. Tex. July 21, 2021) (same); *CliniComp Int'l, Inc. v. Athenahealth, Inc.*, No. A-18-CV-00425-LY, 2020 WL 7011768, at *2 (W.D. Tex. Oct. 28, 2020) (same).

proceeding." *Motorola Sols.*, IPR2024-01205, Paper 19 at 3-4 (granting Director Review). But, what "ensures" the IPR is a "true alternative" is now a moving target. For example, *Sotera* itself said its stipulation ensures that an IPR is a "true alternative." *Sotera*, Paper 12 at 19 ("Accordingly, Petitioner's broad stipulation ensures that an inter partes review is a '***true alternative***' to the district court proceeding.").

There is nothing new about district-court litigation that justifies the reasoning of FAQ 14 and *Motorola Sols*. *Sotera*-stipulations are as much a true alternative now as they were then. The new FAQs undermine four years of *Sotera*-based precedent and stand to thwart Congressional intent by ensuring certain district courts are IPR-proof;[33] and this new "true alternative" requirement to have one forum and one forum only lacks any limiting principle. A stipulation ensuring a "true alternative" to district court would force a would-be petitioner to not only stipulate away all prior-art defenses, as Motorola recently proposed (*see* Motorola Rehearing Request at 9-11 (offering to stipulate to no prior-art defense at trial)), but also to stipulate away all its statutory defenses, including §101 and §112, obviousness-type double patenting, and other non-statutory defenses, none of

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

which can be raised in an IPR, leaving petitioners without any check on district-court plaintiffs.[34] To paraphrase the Supreme Court, Congress surely did not hide this elephant in the mousehole of §314(a)'s use of the word "may." *Cf. Whitman v. Am. Trucking Ass'ns, Inc.*, 531 U.S. 457, 468 (2001) (Scalia, J.).

The Federal Circuit has recently addressed the scope of estoppel and explained that it only applies to a petitioner's invalidity assertions in district court under §102 or §103 based on patents and printed publications, but does not preclude on-sale or public use assertions. *See Ingenico*, 136 F.4th at 1366–67. This refutes Mullen's argument that it will be prejudiced if institution is not denied, notwithstanding Petitioner Samsung's *Sotera* stipulation, because Samsung's "device art" "is cumulative of and materially identical to patents or printed publications that could have been raised in this IPR" and its invalidity contentions "include many invalidity grounds combining the 'device art' or 'system prior art' with the same references in this IPR." DD-Brief, 32-33. The Federal Circuit's precedential decision makes clear that IPRs were never intended to supplant district-court invalidity grounds based on such device art, by design.

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

Mullen further argues that Samsung's ability to assert device art in the litigation diminishes the value of Samsung's *Sotera* stipulation and prejudices Mullen because the courts "inconsistently apply [the] language" of the stipulation in the estoppel context. DD-Brief, 31-32. But this speculative problem is one that district courts can and do address, and it reflects Congress's intent to limit §315(e)(2) prior art.

Moreover, Mullen's inconsistency argument has been consistently rejected by the Board. *See, e.g., Meta Platforms, Inc. v. Eight KHZ, LLC*, IPR2023-01003, Paper 9 at 11-12 (Jan. 9, 2024) (rejecting that the "right to assert overlapping system art in the district court" risks inconsistent outcomes because it "essentially attacks the reasoning of *Sotera* itself" despite *Sotera* remaining binding precedent); *Philip Morris*, IPR2020-01094, Paper 9 at 22-23. To be sure, in theory, there may be gray areas where some system art may have been capable of forming viable IPR grounds based solely on art under §311(b); but, respectfully, this is an issue for the courts to address as they already do, not for the USPTO to police with ever more burdensome restrictions on petitioners to access IPRs. *See Dell, Inc. v. Universal Connectivity Techs.*, IPR2024-01479, Paper 11 at 7-8 (Apr. 7, 2025) (rejecting patent owner's argument regarding use of system art at trial; "[O]ur evaluation at this juncture is based on the facts before us, not on how Petitioner might challenge the validity of the patent at trial.").

The only device art still at issue in Samsung's litigation—BenefonEsc!—is not "cumulative of and materially identical to patents or printed publications that could have been raised in this IPR" under §311(b). DD-Brief, 32. None of the prior art in this IPR is alleged to be describing BenefonEsc!. In the district court, for BenefonEsc!, Samsung has obtained the physical devices and witness testimony from the CEO of the phone's U.S. distributor regarding how the device works. These types of evidence, which could not have been raised in the IPRs, are precisely the types of evidence that the ***courts*** consider in determining whether estoppel applies.[35]

Moreover, while Mullen argues that "many comments in response to the former Director's recent request for public comment noted that…a stipulation (even if a 'true' *Sotera* stipulation) is merely one factor to consider" (DD-Brief,

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

27-30 (citing EX2021-EX2025)), many other comments note that *Sotera* stipulations are the exact solution to the parallel-proceeding concerns animated by *Fintiv*. For example, C4IP "has discussed at length additional reasons for supporting the use of *Sotera* stipulations." EX1091, 3. Specifically, C4IP noted:

> On the merits, C4IP continues to believe that the Office should discretionarily deny petitions where there is parallel district court or ITC litigation unless the petitioner files a *Sotera* stipulation, for both PGR and IPR proceedings. ***As the Office noted in the ANPRM, "A significant advantage of a* Sotera *stipulation is that it effectively minimizes concerns related to the overlapping issues and duplicative efforts that may result from parallel district court litigation."*** C4IP agrees and has discussed at length additional reasons for supporting the use of *Sotera* stipulations in C4IP's ANPRM comments, which are attached to this submission and incorporated by reference here.

Id. Similarly, Innovation Alliance noted that:

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

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

Therefore, this factor weighs against discretionary denial.

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

Mullen argues that "the fact that Google LLC is an additional co-Petitioner in these IPR proceedings is of no moment" to factor 5 because Google is "voluntarily participating on Samsung's behalf in the district court case." DD-Brief, 20-21. This gets factor 5 backwards. Google's decision to participate in the IPRs and accept the estoppel consequences based on its relationship to the accused instrumentalities is exactly the reason why factor 5 weighs in favor of institution. The Board has found under similar circumstances that, at least as to the non-

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

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

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

litigant (i.e., Google), this factor weighs against denying institution or is at worst neutral.[37]

Mullen cites *Mylan Labs. Ltd. v. Janssen Pharmaceutics N.V.*, IPR2020-00440, Paper 17 (Sept. 16, 2021), aff'd, 989 F.3d 1375 (Fed. Cir. 2021) for support (DD-Brief, 20-21), but this case is inapposite. In *Mylan*, there were two parallel district-court proceedings at issue—one involving Petitioner Mylan and the other involving an unrelated party, Teva. The trial date in the parallel Teva litigation was one year prior to the FWD deadline for Mylan's IPR. IPR2020-00440, Paper 17 at 14-15. The trial date in the parallel Mylan litigation was also before the FWD deadline. *Id*. at 15. The Board found that factor 5 favored denying institution because petitioner Mylan "is indisputably the defendant in the *Mylan* litigation, which…is reasonably likely to go to trial prior to what would be the mandatory date of the Final Written Decision if we instituted *inter partes* review on this Petition," "Mylan will have the opportunity to fully litigate the invalidity of the [] patent in that case, which is already well underway," and "although the

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

defendant in the *Teva* litigation is unrelated to the Petitioner, … 'the issues [in both the *Mylan* and *Teva* litigations] are the same as, or substantially similar to, those already or about to be litigated'" imminently at the *Teva* trial. *Id*. at 23.

Unlike the *Mylan* case, Google is not a party to the Samsung litigation or any other litigation related to the '117 patent. Therefore, there is no other pending case in which Google may raise its invalidity challenges against the '117 patent.

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

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

In already instituting four of Petitioners' IPRs on this family of patents (all sharing the same specification), the Board's merits panel found that "[d]ue to strong merits, this factor weighs against exercising discretionary denial." IPR2025-00018, Paper 14 at 14; IPR2025-00021, IPR2025-00124, Paper 14 at 12; *accord* IPR2025-00019, Paper 14 at 13. This IPR is no different. Indeed, as discussed further below in Section IV, the merits arguments Mullen attempts in its brief in this IPR are the same arguments that the panel already rightly rejected as to corresponding claims in IPR2025-00124 ('575 patent) and IPR2025-00018 ('418 patent). These "considerations," plus the Board's previous institution of Apple's IPR2023-00115 on the same '117 patent claims challenged here, "counsel against

discretionary denial." *See Tesla*, IPR2025-00217, -00219, -00220, -00221, -00222, Paper 9 at 2 (finding "discretionary denial of institution is not appropriate" despite *Fintiv* factors 1-3 favoring denial, noting "the merits are strong because the Board previously determined there was a reasonable likelihood that similar claims of an ancestor patent were unpatentable in three separate proceedings with respect to some of the challenged patents in these proceedings."); IPR2025-00339, Paper 10 at 2 (same).

IV. THE PETITION'S GROUNDS ARE STRONG, AS THE BOARD'S MERITS PANEL HAS ALREADY FOUND IN THE IPRS ON PATENTS WHOSE CLAIMS THE '117 PATENT SUBSTANTIVELY REPLICATES

This IPR challenges claims 1-14 and 73-92 of the '117 patent, which include two independent claims (1 and 73). Mullen's discretionary-denial brief and its POPR (which merely repeats the same merits arguments as the discretionary-denial brief) only dispute the Petition's merits as to the independent claims.

As the Examiner noted in prosecution of the '117 patent, the independent claims are "similar to [Patent Owner's] claims in other patents with small word or small phrase changes." EX1002 at 1503. '117 claim 1 is modeled after claim 1 of patent 8,374,575 ("'575 patent"), which is challenged by Petitioners' IPR2025-00124. '117 claim 73 is modeled after claim 1 of patent 11,122,418 ("'418 patent"), which is challenged by Petitioners' IPR2025-00018. The Board's merits panel has already instituted those IPRs—whose grounds are based on the same

Sheha and Randall references as this Petition's grounds—and the Board found in its institution decisions that those grounds present "strong merits." IPR2025-00018, Paper 14 at 13-14; IPR2025-00124, Paper 14 at 11-12.

The same is true here. In the above two IPRs filed by Petitioners, Mullen presented to the Board substantively the same merits arguments that Mullen has presented here, regarding nearly identical claim limitations, and the merits panel soundly rejected them. ***Additionally***, the Board previously instituted Apple's IPR2023-00115 that presented a Sheha-based ground against the same '117 claims 1-14 and 73-92, which settled prior to final written decision. It is difficult to imagine a stronger merits case than this one.

A. The Board's Merits Panel Has Already Rightly Rejected All the Merits Arguments Made in Mullen's Brief

The merits arguments in Mullen's brief (and repeated in its POPR) concern only one element in each independent claim that Mullen alleges is unmet by both the Sheha-based and Randall-based grounds, plus one further element in independent claim 73 that Mullen alleges is unmet by Sheha (but does not dispute as to Randall). These elements are shown in the table below together with the corresponding elements that Mullen attempted to argue in the '575 and '418 patent IPRs:

’117 Patent Element:	’575 Patent Element (IPR2025-00124):	’418 Patent Element (IPR2025-00018):
[1E] 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;	[1C] changing, at the direction of said first wireless telephone, a list of users on said remote server for a profile associated with said first wireless telephone that are allowed to access said location, wherein each user of said list of users is representative of one of a plurality of wireless telephones;	
[73F] providing a permission for said second wireless device to access location information about said location;		[1C] a permission is operable of being provided by said first wireless device for said second wireless device to access location information about said location;
[73I][38] wherein said programming of said wireless telephone is further operable of providing a first map provided with respect to said location.		[1F] wherein said first wireless device is operable of providing a first map provided with respect to said location.

[38] Mullen only argues element [73I] as to Sheha, and does not dispute that Randall discloses it.

For each of elements [1E] and [73F], Mullen makes essentially the same set of two arguments: (1) that the claim language requires the access permission to be instructed/provided by the same "wireless telephone" whose location is to be accessed, and that neither Sheha nor Randall discloses this; and (2) that the claim language should be interpreted to require the access permission to be provided to a specific receiving device rather than a group, and that neither Sheha nor Randall meets this construction. DD-Brief, 35-36 (introducing "*First*" and "*Second*" arguments for claim 1), 49-50 (introducing "*First*" and "*Second*" arguments for claim 73).

For element [73I], Mullen argues that Sheha does not disclose a wireless telephone providing the recited map. DD-Brief, 55-58. But Mullen does not dispute that Randall discloses this element.

Mullen made the same arguments as to the corresponding claim elements in the '575 and '418 patents. IPR2025-00124, Paper 8 at 42-53; IPR2025-00018, Paper 8 at 44-59. The Board's merits panel correctly rejected these arguments in granting institution of both those IPRs. IPR2025-00124, Paper 14 at 23-26 (rejecting both arguments as to Sheha for '575 element [1C]), 36-39 (rejecting both arguments as to Randall for '575 element [1C]); IPR2025-00018, Paper 14 at 24-28 (rejecting both permission-related arguments as to Sheha for '418 element [1C]), 29-32 (rejecting map-related argument as to Sheha for '418 element [1F]),

36-38 (rejecting both permission-related arguments as to Randall for ’418 element [1C]).

That should end the inquiry. The merits panel is the body responsible for “addressing the merits” in the Interim Process for PTAB Workload Management (March 26, 2025), and there is no reason for any assessment of the merits here to be resolved any differently than they were in IPR2025-00124 and IPR2025-00018.

For completeness, the merits are discussed in further detail below.

B. The Sheha-Based Grounds Are Strong

Grounds 1-3 are based on Sheha (EX1005), the same primary reference that formed a base of Apple’s IPR2023-00115 on the challenged ’117 patent claims, which the Board instituted and the parties then settled. The Sheha-based grounds here are at least as strong as those in Apple’s previously instituted IPR, as can be seen from the Board’s rejection of Mullen’s merits arguments in Petitioners’ related IPR2025-00124 and IPR2025-00018, as discussed above.

1. Undisputed Elements

The Petition demonstrates that Sheha discloses all elements of independent claims 1 and 73. Petition (Paper 4), 6-18, 22-30. This is largely undisputed, as Mullen’s arguments as to Sheha address only [1E], [73F] and [73I].

As discussed below, Mullen’s arguments are the same as those the Board has already correctly rejected in IPR2025-00124 and IPR2025-00018, and fare no better here.

2. Elements [1E] and [73F]

a. "said wireless telephone" instructing/providing access permission

Mullen argues that [1E] "requires the 'access [to] said location' to be provided by the specific 'said wireless telephone'…that has its location determined," and similarly that [73F] "requires 'a permission' be provided by" that same device. DD-Brief, 35, 49. This claim-construction argument is irrelevant, because the Petition does not rely on access rights being provided from a different device than the device being located.

Mullen's brief acknowledges (DD-Brief, 40), but then fails to rebut the showing in the Petition at 8 that "Sheha discloses that ***each device*** may have ***privacy settings***, including privacy configuration specifications stored at the *remote server* and changed at the instruction *of the wireless telephone*." The Petition cites Sheha at 5:38-46, which says "each device has privacy settings that allow ***the device*** to prevent or limit other calling devices from obtaining position information," and at 11:63-12:7, which says "a mobile device's position information" is provided "***based on privacy settings***" including "a group database and authorization and authentication protocols." *See* IPR2025-00124, Paper 14 at 23 (Board quoting same); IPR2025-00019, Paper 14 at 22 (Board agreeing that Sheha's "mobile device provides permission for a requesting device to access its

location information"); IPR2023-00115, Paper 9 at 15-16 (Board finding for institution purposes that Sheha discloses [1E]).

Mullen argues that "Sheha's privacy settings reside on a mobile device itself" rather than "on a 'remote system,'" and that Sheha's "group database" on the remote server is "[a]side from Sheha's privacy settings" and only used for "'landline-to-landline' requests (not mobile-to-mobile requests)" (DD-Brief, 41-43), but these assertions are incorrect, as the Board has found. IPR2025-00124, Paper 14 at 24-25 ("Sheha discloses privacy-permission settings relating to defining a group of users with access to location information." … "Regarding [Mullen's] argument that Sheha's disclosures 'regarding 'groups'' are in the context only of 'landline-to-landline' requests'…, we disagree."); IPR2025-00018, Paper 14 at 27 ("We are not persuaded at this stage by Patent Owner's contention that the group database having permission to access location information is limited to landline-to-landline requests"); Petition, 9-11 (rebutting Mullen's arguments with discussions of Sheha disclosures and alternative obviousness arguments that Mullen's brief ignores and fails to address).

b. Access permission provided to a group

In Sheha, a mobile device's privacy/permissions settings information can include "defin[ing] a group of specific users that have access" via "a group database and authorization and authentication protocols." Petition, 8 (quoting

EX1005, 11:55-12:7), 24 (same). Mullen attempts to distinguish the challenged claims from this disclosure by arguing that [1E] and [73F] require providing access rights "to a specific device" as opposed to "a group policy." DD-Brief, 36, 49-50. But there is nothing in the claim language requiring the access rights to be unique/specific to the requesting device (*See* Petition, 24-25), as the Board has already found. IPR2025-00124, Paper 14 at 25 ("[W]e are not persuaded to adopt Patent Owner's construction of element [1C]"); IPR2025-00018, Paper 14 at 27-28 ("Patent Owner's contention that the claim requires a single permission for a single device is not commensurate with the scope of the claim….").

In discussing both '575 claim 1 (corresponding to '117 claim 1) and '418 claim 1 (corresponding to '117 claim 73), the Board correctly noted not only that the claim language recites no exclusion of group-based permissions, but also that "the written description" in the Mullen patents' common specification itself "includes an embodiment where a user assigns access rights to a group," which further demonstrates "that the scope of this claim term as read in light of the written description encompasses a group permission" like Sheha's. IPR2025-00018, Paper 14 at 18; IPR2025-00124, Paper 14 at 16-17; EX1001, 13:9-12, 3:23-25 (discussed in Petition, 25).

Mullen's claim-construction argument is particularly nonsensical for [1E], whose own language explicitly refers to a group: "a ***list of users***…that are allowed

to access said location," as the Board recognized in IPR2025-00124 (Paper 14 at 16-17). There is no material difference between the claim's recitation and Sheha's disclosure of "a group of specific users that have access" (EX1005, 11:55-12:7 (quoted in Petition, 8)), or Randall's "list of all the entities…to whom access to more private data is to be given" (EX1007, [0511] (quoted in Petition, 52)).

3. Element [73I]

Mullen does not dispute that Randall discloses element [73I]. For Sheha only, Mullen argues that Sheha does not disclose "providing a first map provided with respect to said location" in [73I] because allegedly Sheha "does not disclose or suggest a ***wireless telephone*** providing Figure 5's map" in Sheha. DD-Brief, 55 (Mullen's emphasis). The Board correctly rejected that argument when Mullen made it as to '418 claim 1's identical recitation ("providing a first map provided with respect to said location"). IPR2025-00018, Paper 14 at 29-32 ("[W]e agree with Petitioner" that "a person of ordinary skill in the art would have caused the mobile telephone to display the map of Figure 5.") (noting that "[t]he references cited by Mr. Williams explicitly show what is already implicitly taught by Sheha, namely, that displaying the map of Figure 5 on a mobile telephone was within the background knowledge of a person of ordinary skill") (citing EX1007, EX1016, EX1014, EX1017, EX1018); *see* Petition, 30 (likewise citing EX1007, EX1054,

EX1014, EX1017, EX1018, which Mullen's brief ignores). Mullen has provided no reason for the Board to reach a different conclusion here.

None of Mullen's arguments hold water. The Sheha-based grounds are strong and merit institution, in this IPR just as in IPR2025-00124, IPR2025-00018, and IPR2023-00115.

C. The Randall-Based Grounds Are Strong

Grounds 4-6 are based on Randall (EX1007), whose disclosure has a running example where wireless device user Alice shares her information with wireless device user Bob, including her location information. As with the Sheha-based grounds, the Randall-based grounds are strong, as can be seen from the Board's rejection of Mullen's merits arguments in Petitioners' related IPR2025-00124 and IPR2025-00018.

1. Undisputed Elements

The Petition demonstrates that Randall discloses all elements of both independent claims 1 and 73. Petition, 48-57, 63-66. Again, this is largely undisputed, as Mullen's arguments as to Randall address only [1E] and [73F]. Mullen attempts some of the same arguments against Randall as against Sheha, but fails even worse because Randall contains explicit statements meeting Mullen's claim constructions that the Petition cited and Mullen ignores.

As discussed above and further below, Mullen's arguments are the same as those the Board has already correctly rejected in IPR2025-00124 and IPR2025-00018, and fare no better here.

2. Elements [1E] and [73F]

a. Both of Mullen's Claim-Construction Positions Are Irrelevant Because They Are Met by Randall Disclosures That Mullen Ignores

As discussed above, Mullen argues that both elements [1E] and [73F] require: (1) the access permission to be instructed/provided by the same "wireless telephone" whose location is to be accessed; and (2) the access permission to be provided to a specific receiving device rather than a group. DD-Brief, 34-36, 49-50. As to Randall, neither of these claim-construction arguments matter. Even if Mullen's claim-construction positions were adopted, Randall explicitly teaches that its system meets them. The Petition highlighted these explicit disclosures, and Mullen's brief simply ignores them.

As to argument (1), Randall teaches that "whenever Alice wishes to, she can change the level of access of a current contact" and "***Alice's device*** will report this to the server, and then Bob will be given this new information." EX1007, [0509] (cited in Petition, 53). Randall also teaches that Alice can access her "i-data" via her "***mobile device*** to allow her to manage her data," which includes the list of users who are allowed to access her device's GPS location as shown in Randall's

Table 1. EX1007, [0505] (quoted in Petition, 51). As the Board recognized, "Randall discloses that the same wireless information device performs the disclosed functions of having its location determined and providing permission for another device to access location information." IPR2025-00018, Paper 14 at 37; *see also* IPR2025-00124, Paper 14 at 38 (quoting Randall EX1007, [0505]). Mullen fails to address any of these disclosures that meet Mullen's own constructions. *See* DD-Brief, 45-47, 52-53 (discussing Randall without mentioning [0505] or [0509], or the Petition's discussions thereof).

As to argument (2), the Petition quotes Randall's teachings that "[l]ocation information" can be made "[v]isible to ***specific people*** (or groups)" and that "[a]ccess rights can be associated with ***individual entities***, and can also be associated with groups of entities." Petition, 52 (quoting EX1007, [0136], [0070]) (further citing EX1007, [0052] ("a user can also specify the remote database access rights given to ***different people*** or groups" to establish "the access rights appropriate to ***that device***"), [0146] (users can give access rights to "***specific people*** or groups of people")). As the Board recognized, these disclosures meet the disputed limitations "even under Patent Owner's narrower construction." IPR2025-00018, Paper 14 at 37 (discussing EX1007, [0052], [0070], [0146]). Mullen fails to address any of these disclosures that meet Mullen's own constructions. *See* DD-Brief, 46-47, 53-54.

Mullen's arguments against the Randall-based grounds thus facially fail, for ignoring how the Petition demonstrated that Randall meets even Mullen's proposed claim constructions.

b. Mullen's Claim Constructions Are Also Wrong

Mullen's arguments against Randall also independently fail because Mullen's claim constructions for both claims 1 and 73 are wrong, for the reasons discussed in Section IV.B.2 above, and explained by the Board in its recent institution decisions. IPR2025-00124, Paper 14 at 14-17; IPR2025-00018, Paper 14 at 15-19.

V. THE PETITION'S STRONG GROUNDS ARE APPROPRIATELY SUPPORTED BY EXPERT TESTIMONY

Mullen's off-handed allegation that the Petition includes "excessive reliance on conclusory expert testimony…to buttress weak obviousness combinations" (DD-Brief, 59) is doubly meritless.

First, there are no weaknesses in the obviousness grounds or the cited references. As discussed in Section IV above, Mullen's arguments have already been rejected by the Board's merits panel, and Mullen only alleges there are weaknesses by ignoring the references' explicit teachings that the Petition cites.

Second, Mullen's allegation that there is "excessive reliance on conclusory expert testimony" is itself utterly conclusory. Mullen's single paragraph making this allegation (DD-Brief, 59) provides no shred of reasoning nor any actual

citation to demonstrate how the manner in which the Petition purportedly relies on any expert testimony for any specific issue is "excessive." Counting the number of citations to the declaration does nothing to show that any of those citations are excessively relying on testimony (as opposed to, e.g., citing testimonial evidence that corroborates the Petition's reliance on explicit disclosures in the prior art). And merely using the adjective "excessive" in a brief to characterize the Petition's reliance on expert testimony does not make it so.

Indeed, as discussed in Section IV above, ***none*** of the issues raised by Mullen's merits arguments require the Board to assess the correctness of any expert testimony ***at all*** in order to reject Mullen's arguments as unfounded. The Board need only look at the statements in the prior-art references themselves that are cited and quoted in the Petition, and the reasoning spelled out in the Petition that Mullen ignored and failed to address, as the Board's merits panel has already done in Petitioners' related IPRs to reject Mullen's same arguments and grant institution.

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The challenged claims are unpatentable; the Petition's grounds are strong, and merit institution.[39]

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[39] Petitioners reserve the right to challenge the March 26, 2025 Interim Process for PTAB Workload Management at least because it is legally invalid as (1) exceeding

Respectfully submitted,

Date: 2025-06-18

/Elisabeth Hunt/

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the Director's authority, (2) arbitrary and capricious, and (3) adopted without notice-and-comment rulemaking.

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. §42.24, the undersigned certifies that the foregoing **PETITIONERS' OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** contains 13,146 words excluding; a table of contents, a table of authorities, a certificate of service or word count, or appendix of exhibits or claim listing. Petitioners have relied on the word count feature of the word processing system used to create this paper in making this certification.

Date: June 18, 2025

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

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

I certify that on June 18, 2025, a copy of the foregoing document, including any exhibits or appendices filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

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