UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

Case No. IPR2025-00366
U.S. Patent No. 11,234,117 (Claims 15-41)

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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2002	*Samsung SmartThings Find,* https://smartthingsfind.samsung.com/login (accessed January 24, 2024)
2003	Acting Director's Stewart's March 26, 2025 Memorandum titled "Interim Processes for PTAB Workload Management"
2004	USPTO Memorandum "Guidance on USPTO's recission of 'Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation'" March 24, 2025.
2005	*Mullen Industries LLC v. Samsung Elecs. Co., Ltd.*, Case No. 2:24-CV-00049-JRG, Order Denying Motion to Transfer, Dkt. 90 (E.D. Tex. Mar. 25, 2025)
2006	Reserved
2007	*Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation*, Vidal, June 21, 2022
2008	*Mullen Industries LLC v. Samsung Elecs. Co., Ltd.*, Case No. 2:24-CV-00049-JRG, Order Denying Motion to Stay, Dkt. 71 (E.D. Tex. Jan. 23, 2025)

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2010	*Solas OLED Ltd. v. Samsung Display Co., Ltd.*, Case No. 2:19-CV-00152-JRG, 2020 U.S. Dist. LEXIS 125973 (E.D. Tex. July 17, 2020)
2011	*Oyster Optics, LLC, v. Infinera Corp.*, Case No. 2:19-CV-00257-JRG, Order, Order, Dkt. 87 (E.D. Tex. July 17, 2020)
2012	Docket Navigator, Time to Milestones for Judge Gilstrap (E.D. Tex.) in Patent Cases for the Last 5 Years
2013	*Mullen Industries LLC v. Samsung Elecs. Co., Ltd.*, Case No. 2:24-CV-00049-JRG, Complaint, Dkt. 1 (E.D. Tex. Jan. 26, 2024)
2014	*Mullen Industries LLC v. Samsung Elecs. Co., Ltd.*, Case No. 2:24-CV-00049-JRG (E.D. Tex.), Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.'s Amended Invalidity Contentions
2015	Excerpted Transcript of the Deposition of David Williams, IPR2023-00096, July 26, 2023.
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2019	Plaintiff-Appellants Brief in *Apple Inc. v. Vidal*, No. 2024-1864 (Fed. Cir. Aug. 5, 2024) (with Appx. containing *Apple Inc. v. Vidal*, No. 5:20-cv-06128-EJD, Order Denying Plaintiffs' Renewed Motion for Summary Judgment; Granting Defendant's Motion for Summary Judgment (N.D. Cal. Mar. 31, 2024))
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2022	Stanwood - Public Comment on Advanced Notice of Proposed Rulemaking (ANPRM) Regarding Discretionary Institution Practices
2023	Pharmaceutical Research and Manufacturers of America (PhRMA) - Public Comment on Advanced Notice of Proposed Rulemaking (ANPRM) Regarding Discretionary Institution Practices
2024	Alliance of U.S. Startups and Inventors for Jobs (USIJ) - Public Comment on Advanced Notice of Proposed Rulemaking (ANPRM) Regarding Discretionary Institution Practices
2025	American Intellectual Property Law Association (AIPLA) - Public Comment on Advanced Notice of Proposed Rulemaking (ANPRM) Regarding Discretionary Institution Practices

Exhibit	Description
2026	Reserved
2027	Reserved
2028	U.S. Patent No. 9,204,283 Prosecution History Excerpt, September 23, 2014 Notice of Allowance

Pursuant to Acting Director's Stewart's March 26, 2025 Memorandum titled "Interim Processes for PTAB Workload Management" (the "Memorandum", EX2003), Patent Owner Mullen Industries LLC ("Patent Owner") respectfully requests that the Director exercise discretion and deny institution of Petitioners Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Google LLC's ("Petitioners") Petition for *inter partes* review IPR2025-00366 ("Petition") of U.S. Patent No. 11,234,117 (the "'117 Patent").

I. INTRODUCTION

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

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

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

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

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

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

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

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

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

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

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

II. BACKGROUND

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

Mr. Mullen disclosed in U.S. Application No. 11/834,674 and its corresponding U.S. Provisional Application No. 60/367,967 his innovation of wireless telephones capable of having their location determined and security measures for the same. The claimed wireless telephones are capable of, *inter alia*, having their location determined, displaying options for changing access rights, receiving a login and password for use in determining whether to allow access of location information, providing location information and/or location access rights for other specific devices, changing permissions or location access rights for other specific devices, and receiving location-based event notifications—all of this more

than 18 years *before* Samsung released its Samsung SmartThings Find technology containing the same features. EX2001; EX2002.

III. ARGUMENT

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

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

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

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

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

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

> **Factor 2**: proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
>
> **Factor 3**: investment in the parallel proceeding by the court and the parties;
>
> **Factor 4**: overlap between issues raised in the petition and the parallel proceeding;
>
> **Factor 5**: whether the petitioners and the defendants in the parallel proceeding are the same parties;
>
> **Factor 6**: other circumstances that impact the Board's exercise of discretion, including the merits.

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

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

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

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

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

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

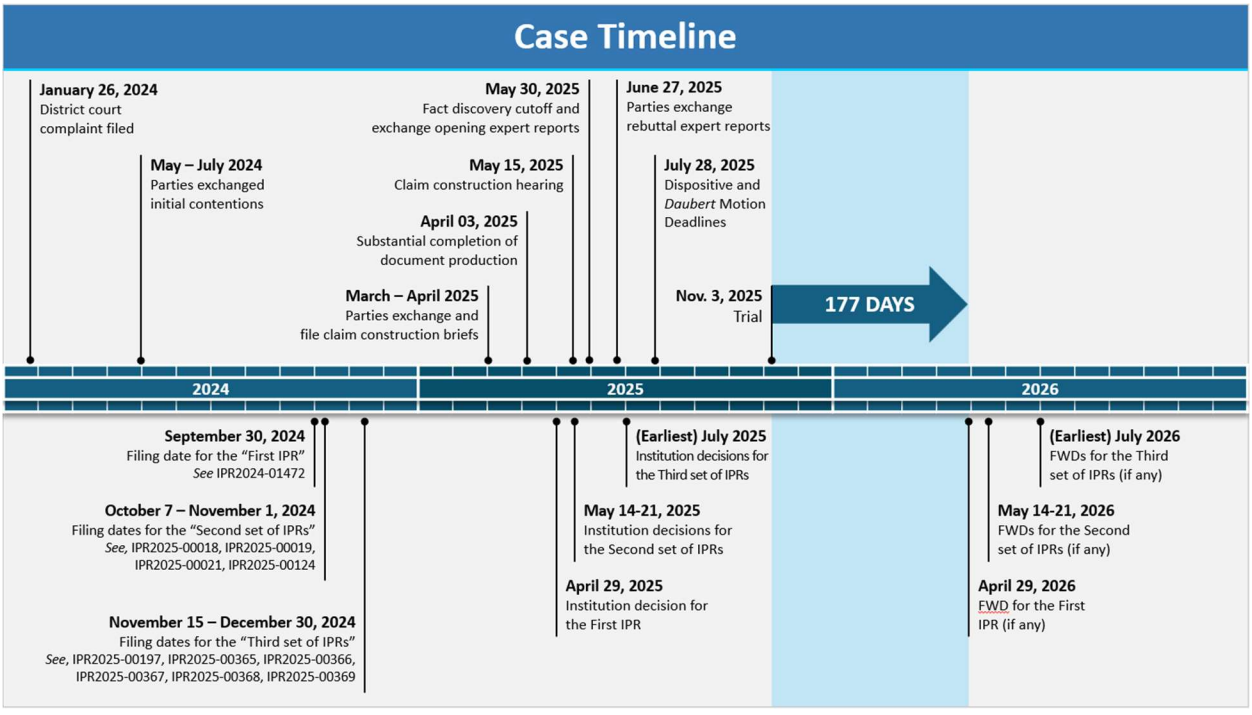
1. Factor 1: The District Court Denied Petitioners' Motion for a Stay and is Highly Unlikely to Issue a Stay Even Were This Petition Instituted.

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

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

"the PTAB's institution decision on the ***last*** of the pending IPRs." *Id*. at 3 (emphasis added).

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



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

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

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

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

Indeed, Judge Gilstrap has granted stays pending IPR even under drastically different procedural postures. For example, in *Resonant Systems,* claim construction briefing had just begun, no *Markman* hearing had occurred, only two depositions had taken place, and the parties were still negotiating the scope of substantial email discovery. *Resonant Sys., Inc. v. Samsung Elecs. Co.*, No. 2:22-CV-00423-JRG, Dkt.

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

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

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

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

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

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

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

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

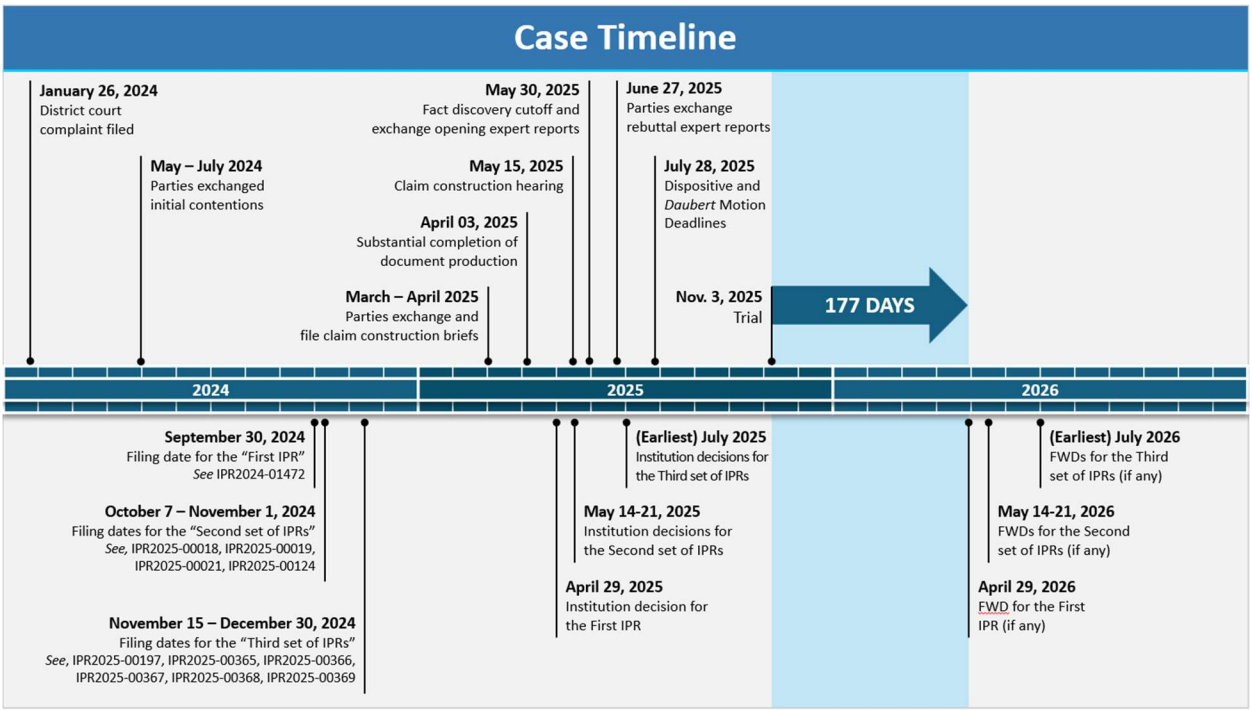
The credibility of a November 3, 2025 trial date is even stronger in view of Judge Gilstrap recently denying the Samsung Petitioners' motion to transfer to the Northern District of California. Ex 2005; *see also SAP Am.*, IPR2024-01496, Paper 13 at 5-6 ("Because the trial date is set and the uncertainty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

Accordingly, Factor 2 also favors denial of institution.

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

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

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



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

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

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

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

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

The Acting Director recently and correctly explained that a *Sotera* stipulation is "not likely to moot" "invalidity arguments in the district court [when they] are more expansive and include combinations of the prior art asserted in [parallel IPR petitions] with unpublished system prior art[.]" *Motorola Sols.*, IPR2024-01205, Paper 19, 4, Order Granting Director Review, Vacating the Decision Granting Institution and Denying Institution of *Inter Partes* Review (Mar. 28, 2025). Such is the case here, where not only are the same claims, grounds, arguments, and evidence presented in the Petitioner present in the parallel district court litigation, the district court litigation includes *additional* invalidity grounds that rely on the same prior art asserted in the Petition, in combination with system prior art that the Samsung Petitioners will assert in the district court regardless of whether the Board institutes.

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

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

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

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

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

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

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

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

Petitioners and co-Petitioner Google LLC are thus related, collectively involved in the district court case, and cooperating in the district court case on Samsung's behalf.

Accordingly, Factor 5 weighs in favor of denying institution.

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

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

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

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

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

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

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

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

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

> [T]he *Fintiv* factors are only a 'general statement of agency policy' that binds neither the Board nor actors beyond the agency …

EX2017 at 8.

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

Id. at 12 (emphasis in original).

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

Id. at 15.

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

Id. at 16.

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

Id. at 17.

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

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

EX2018 at 15.

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

Id. at 23.

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

Id. at 29.

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

> Plaintiffs … alleg[e] three violations of the Administrative Procedure Act ("APA"), 5 U.S.C. § 701 *et seq.*
> …
> Based on the parties' written and oral arguments, the Court finds that the *NHK-Fintiv* standard was not a substantive rule requiring notice-and-comment rulemaking.

EX2019 at Appx1-2.

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

Id. at Appx22.

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

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

Accordingly, even when a petitioner files a purported "*Sotera*" stipulation, it is ***not*** dispositive of whether the Board should deny institution under *Fintiv*. Rather, the Acting Director and district court have clarified that the Board should consider any such stipulation as just one non-dispositive factor in connection with all other circumstances of the case, just like the Board has done previously. *See e.g.*, EX2004, *passim*; EX2003, *passim*; *Cisco Systems, Inc. v. Estech Systems, Inc.*, IPR2021-00333, Paper No. 12 at 12-13 (PTAB July 7, 2021) (denying institution under *Fintiv* based on holistic analysis of all factors ***even when*** petitioner filed a *Sotera* stipulation because the Board was "not persuaded … the stipulations proffered here are sufficient when weighed against the other factors").

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

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

> While we strongly support the inclusion of a mandatory *Sotera* stipulation in all IPR and PGR petitions, ***we do not see why it should provide a "safe harbor" for petitioners as a mechanism to avoid discretionary denial***. The [Director's Advanced Notice of Proposed Rulemaking] ANPRM seems to recognize this as well and proposes that a mandatory ***Sotera stipulation could be*** "***a necessary but not sufficient basis for institution***." We agree with this approach.
> …
>
> ***One primary reason is that the USPTO has limited ability to enforce a Sotera stipulation in parallel proceedings, and many courts have already demonstrated that they will not enforce them consistently***.

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

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

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

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

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

> ***The patent owner has no ability to enforce such a stipulation in district court, and at least some courts are likely to allow an accused infringer to argue its way out of one***.
>
> …
>
> ***In short, we think that a Sotera stipulation should not be used to replace a proper Fintiv analysis or even be treated as part of one.***

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

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

EX2025 (American Intellectual Properly Law Association ("AIPLA")) at 13.

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

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

Here, Petitioners' *Sotera* stipulation does not overcome the strong evidence that institution should be denied under *Fintiv*, or the Director's inherent discretion, as addressed above. *See supra* Section III.A. That is, given the specific facts here,

institution should be denied in favor of allowing the parties to resolve all validity disputes in the single district court proceeding that has advanced significantly and will be tried very soon in early November 2025. *Id*. Petitioners' initial withholding of their stipulation—waiting nearly two months—instead of filing same with its Petition was also gamesmanship, prejudicial to Patent Owner, and inconsistent with the mandate of 37 C.F.R. § 42.1(b) to "secure the just, speedy, and inexpensive resolution of every proceeding."

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

Specifically, as was specifically noted in the public comments discussed *supra* at Section III.B.2, and to the prejudice of Patent Owner, courts have difficulty determining what grounds are within, or outside, the scope of any stipulation and inconsistently apply such language, which harms Patent Owner because it invariably leads to Patent Owner having to litigate the same or similar validity issues in both

forums while petitioners obtain the benefit of two related, overlapping bites at the invalidity apple. *See e.g., Prolitec Inc. v. ScentAir Techs., LLC*, No. 20-984-WCB, 2023 WL 8697973, at *22 (D. Del. Dec. 13, 2023) (identifying "***a split among district courts***" as to "the meaning of … 'any ground that the petitioner raised or reasonably could have raised during that inter partes review.'") (emphases added). This prejudice to Patent Owner is particularly acute where, here, the Petitioners assert "systems art" in district court. *Id*.

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

Second, even worse, Petitioners' invalidity contentions in the district court include many invalidity grounds ***combining*** the "device art" or "system prior art" with the ***same*** references in this IPR. *See e.g.*, EX2014 at 138-39 (identifying "Primary References" including "Benefon Esc!" and "CellPoint Finder!"); *e.g.*, *id.*,

139-53 (combining such device art with the same Randall, Sheha, Degnbol, De-Vries, and Wako references in this IPR). Samsung's purported stipulation expressly states that "[t]his stipulation is not intended, and should not be construed, to limit Samsung's ability to assert invalidity … on any other [102/103] ground." The Board should deny institution to prevent this prejudicial and wasteful duplication in the parallel litigation. *E.g.*, *Prolitec*, 2023 WL 8697973, at *22; *SAP Am.*, IPR2024-01496, Paper 13 at 10-11 (factor 4 favors discretionary denial because Petitioner was asserting system art in district court and "a majority of the parties' work that would be done here will also be required in the Litigation regardless of whether we institute review. Accordingly, we do not consider the presence of the *Sotera* stipulation in our case to ensure that inter partes review would be a 'true alternative; to the Litigation.").

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

identical invalidity arguments to those in the Petition in the district court due to their combination with system prior art the Petitioners cannot raise before the Board.

Accordingly, even considering Petitioners' purported stipulation, the Board should deny institution under *Fintiv* or the Director's inherent authority.

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

1. Grounds 1 and 3 of the Petition Fail to Establish Obviousness of the Limitation "Providing Said Login and Said Password to a Remote Server for Use in Determining Whether to Allow Access of Location Information for Said One of Said Plurality of Wireless Telephones Associated to Said Selected One of Said Plurality of Users, Said Determining Including Identifying a User of Said Wireless Telephone Using Said Login, Determining Said Password Is Associated with Said Login" in Claim 15 and Its Dependent Claims

The Board should decline to institute any Grounds of the Petition that rely on Sheha with respect to Claim 15 and its dependent claims because the references fail to teach or suggest this limitation.

This limitation requires that, before providing the user of the first wireless telephone with access to the location of the user selected from the plurality of users, the user of the first wireless telephone must be identified based on login and password information ("*identifying a user of said wireless telephone using said login [and] determining said password is associated with said login*"). EX1001, Claim 15. Sheha does not teach this limitation, nor does the Petition demonstrate otherwise.

The Petition alleges that Sheha "determine[s] whether the target device has authorized the requesting device to *access* its *location information*." Pet., 13-14 (emphasis in original). This is not what Sheha discloses. The authentication and authorization protocols of Sheha are used to verify user identity and that a user is signed into the ODAS:

- "Once the user has logged on to the personal computer via **authentication and authorization** procedures, any call that originates or is destined to their telephone number can identify the position of the other landline telephone number, based on predetermined privacy settings associated with the other landline telephone number." EX1005, 4:35-40 (emphasis added).

- "The remote user that is logged on to a wireless or landline position-enabled computing device is verified by the networked server's **authentication and authorization** protocol procedures." *Id*., 5:25-28 (emphasis added).

- "When the ODAS **3** is notified from the telephone network **2** that a telephone call is being established, the ODAS **3** correlates both the origin and destination telephone users' identifications to verify if the user is signed-on to the ODAS **3** using **authentication and authorization** protocols. These **authentication and authorization** protocols establish that a user is genuine and verify the level of authority each user is granted, such as for differentiating services provided by the ODAS **3**." *Id*., 8:42-50 (emphasis added).

- "Once the ODAS 3 has been notified of all the appropriate information, the system verifies, by using **authorization and authentication protocols**, if the user of both the originating and destination telephone numbers are signed-on to the system." *Id*., 9:61-66 (emphasis added).

- "In another embodiment, users can define a group of specific users that have access to this information. This is also accomplished by utilizing a group database and **authorization and authentication protocols** to identify users that are permitted to access this information." *Id*., 11:63-12:1 (emphasis added).

- "In another embodiment, using the **authorization and authentication protocols** a user can request the position of a mobile device, similarly to requesting the position of a landline device." *Id*., 12:4-7 (emphasis added).

Thus, Sheha does not teach that authentication and authorization procedures are used to "determine whether the target device has authorized the requesting device to obtain its location."

Device users in Sheha *never* provide access rights to another specific individual user as required by the claims. Sheha does not disclose allocating location access rights between individual users. Sheha instead describes a user being able to implement "privacy settings" on his device to control when and to what extent his device will convey position information to one or more other devices. EX1005, 4:35-40, 4:62-5:2, 5:3-11, 5:37-45, 10:17-20, 10:47-50, 11:3-8, 12:1-4. Sheha does not describe discerning between position requests based on user identity.

For at least these reasons, the Petition fails to establish that Petitioner is reasonably likely to demonstrate that Claim 15 is unpatentable based on Sheha.

2. Grounds 1 and 3-6 of the Petition Fail to Establish Obviousness of the Limitation "Assigning Location Access Rights to Said One of Said Plurality of Wireless Telephones Associated with Said Selected One of Said Plurality of Users for Obtaining Said Location of Said Wireless Telephone" in Claim 15 and Its Dependent Claims

The Board should decline to institute Grounds 1 and 3-6 because the cited references fail to teach or suggest this limitation of Claim 15.

The Petition's arguments are based on a fundamental misreading of the claim language. Properly construed, the limitation requires the claimed location access rights be provided both (i) by the specific wireless telephone recited in each claim and (ii) to the specific device recited in the claim (one of said plurality of wireless telephones associated with said selected one of said plurality of users).

Petitioners in effect erroneously seek to rewrite this term in Claim 15 to read: ~~assigning location access rights to~~ a policy that may result in allowing said one of said plurality of wireless telephones associated with said selected one of said plurality of users ~~for obtaining~~ to obtain said location of said wireless telephone." Then, and only then based on Petitioners' improper rewriting of the language of Claim 15, Petitioners incorrectly argue that Sheha or Randall teaches or suggests this claim limitation. This rewriting of the claim language includes two key errors of claim construction.

First, the Petition repeatedly ignores (by ascribing no meaning to and failing to substantively address in the Petition) the portion of this term that expressly requires the "location access rights" to be provided by the specific device recited in the claim (*e.g.*, in Claim 15, the *same* "wireless telephone" recited in the claim preamble and has a positioning system for determining its location). The plain language of the claim is clear that the "location access rights" must be provided by that specific device recited in the claim. These words must be given meaning and cannot be ignored. *Phillips*, 415 F.3d at 1314); *Exxon Chem. Patents v. Lubrizol Corp.*, 64 F.3d 1553, 1557 (Fed. Cir. 1995). This should end the inquiry. It conclusively establishes that the device specified in the claim ("said wireless telephone") must provide the "location access rights", and the Board should reject Petitioners' attempt to read this limitation out of the claim.

Indeed, this is a significant omission, including because requiring the same device that has its location determined to provide the permission to access that device's location information enhances system security. EX1001, 1:44-54 ("One object of the present invention is to provide a ***security feature*** which allows a user to limit and/or deny location access to a particular user. … In this manner, ***a cell phone user may give access, through his or her cell phone***, to a friend so that the friend can locate him or her ….") (emphasis added).

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

By contrast, to interpret these claims as merely setting a policy that applies to a group, however that group is defined and may change, would improperly strip the claims of their actual words and their common meaning. *See VLSI Tech. LLC v. Intel Corp.*, 53 F.4th 646, 655-656 (Fed. Cir. 2022); *Exxon Chem. Patents*, 64 F.3d at 1557. Group policies create a security risk of erroneously allowing or disallowing access to location information, and Paper Owner's disclosed and claimed innovations improve system security and address that very issue. EX1001, 1:44-46.

Notwithstanding that group policies and the claimed invention are very different concepts, the Petition conflates the two and, fatally to its invalidity allegations, uses them "interchangeably." Pet., 14.

More specifically, when a policy is set that allows a group to access position or location information, which is how the references cited in Petitioners' Grounds purport to operate, it does not mean that any device has access to the location information. The uncertainty that devices "may" be given access (as Petitioners effectively rewrite the claims to recite) is different than the certainty of devices that "are" provided access (as the '117 Patent actually claims). *See* Pet., 20. The group may also be an empty set and the group's members may change over time such that location access rights are not assigned "to" any device but rather are generic to a group, however such group is defined and however that definition may change over time.

Illustrating this, a group policy remains unchanged when a member is added to the group, which creates risk of erroneously allowing access to location information to the member when, for example, a user forgets that the group is allowed to access location information when adding the member to the group. Likewise, a group policy remains unchanged when a member is removed from the group, which creates risk of erroneously disallowing that member's access to location information when, for example, a user forgets when removing a member

from the group that it was the member's inclusion in the group that permitted the member to access the location information. Still another example, if a group permission is changed that results in allowing or disallowing access to location information to members of the group, it shows that the group is the construct that is, or is not, assigned location access rights and not the group members themselves whose potential access to location information depends on whether they remain members of the group.

The difference relative to Claim 15 is significant, including in terms of system security. The '117 Patent expressly recognizes this difference when it explicitly states that "[o]ne object of the present invention is to provide a security feature which allows a user to limit and/or deny location access to a particular user." EX1001, 1:44-46. Indeed, the claimed invention eliminates the risk of erroneously allowing access to location information to unwanted recipients, or conversely disallowing access to location information to recipients that are desired to have access.

The specification supports Patent Owner's construction and understanding of Claim 15. *See Kaken Pharm. Co. v. Iancu*, 952 F.3d 1346, 1352 (Fed. Cir. 2020) ("A patent's statement of the described invention's purpose informs the proper construction ….")); *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007) ("When a patent ... describes the features of the 'present invention' as a whole, this description limits the scope of the invention."). It

consistently describes the invention as a user selecting, via a user's device (*i.e.*, the same device that is capable of having its location determined), another specific user for receiving permission. EX1001, 1:39-54. This, too, is exactly what the '117 Patent discloses in connection with Figure 9. *Id.*, Figure 9, 9:10-15. Further, the '117 Patent repeatedly refers to the benefits of assigning rights to a specific user, which underscores that these words must be given that specific meaning in the claims. EX1001 at 1:58-59 ("Phil may grant Bill access"), 1:66-2:2 (location "can be accessed by a particular user"), 3:9-11 ("location rights for a specific user may be given to a different user only by that specific user"); 4:56-65 ("for the requesting user"), 9:16-20 ("assigning location rights to a user"), 11:64-12:2 ("finding if any access rights were assigned to the requestor's identity").

Further, the prosecution history of the related U.S. Patent No. 9,204,283 ("'283 patent") also supports Patent Owner's construction. Claim 1 of the '283 patent similarly contains an "assign[ing] location access rights" limitation. In a Notice of Allowability, the Examiner made an Examiner's Amendment for the specific purpose of adding the claim requirements for a wireless device to provide "location access rights" "to" another wireless device, and stated that these "amended independent claims … possess a unique combination of limitations that is not sufficiently taught or suggested by the prior art." EX2028, 6-9. Thus, this coupling of each grant of location access rights or a permission to a specific device

demonstrates that the Examiner, too, interpreted the claims to require each such grant of location access rights or permission to be for a specified device as recited in the claim, and the applicant agreed to the examiner's amendment. *Id*. This likewise supports Patent Owner's position that the claims should be construed to require that the '117 Patent's claimed location access rights or permission must be provided to a specified device as recited in the claim, because Patent Owner's construction is consistent with the manner in which these claim terms were construed during prosecution. *Phillips*, 415 F.3d at 1317.

Turning to Petitioners' arguments, for Grounds 1 and 3 Petitioners rely on Sheha as allegedly teaching or suggesting these claim limitations. Pet., 20. For Grounds 4-6, Petitioners rely on Randall as allegedly teaching or suggesting these claim limitations. Pet., 60.

First addressing Sheha (Grounds 2 and 3), the Petition vaguely alleges that "[c]onfiguring a device's ***privacy permissions*** can include 'defin[ing] ***a group*** of specific users that have access" to the device's location." Pet., 13 (citing Sheha, 11:55-12:7) (emphasis added). This does not disclose or suggest the claimed features that the same device that has its location determined is capable of providing location access rights to another specific device to access that device's location information. Indeed, Sheha does not disclose or suggest these claim limitations nor

the corresponding security advantages that the '117 Patent discloses these features provide.

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

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

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

location requests. *Id*. The very nature of these filters in Sheha make them indiscriminate as to the identity of any requesting mobile device. *Id*. The privacy settings are *not* location access rights, are *not* provided by the mobile device, and are *not* for another specified device as recited in Claim 15. *Id*. Every disclosure in Sheha is consistent in this regard. *E.g.*, EX1005, 4:35-42, 5:3-20, 5:21-46, 10:44-50, 11:3-9, 12:1-4. In addition, Sheha's privacy settings reside on a mobile device itself, and thus are fundamentally different than the '117 Patent's claimed invention for the additional reason that they are not stored on a "remote system" as required by Claim 15.

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

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

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

EX2015, 17:6-12.

> Q. And this relates to assigning location access rights limitation of claim one. In that first sentence, you say: "Sheha allows user to establish which other users and devices may access their location information." Correct?
>
> A. Correct.
>
> Q. This is not on an individual basis; correct?
>
> ….
>
> A. ***If I understand your question, I think that's accurate. The privacy settings, as well as the group database settings, are not individual by individual*** ….

Id., 114:12-25.

Aside from Sheha's privacy settings, Petitioners also rely on Sheha's reference to a "group" database and "defin[ing] a group of specific users that have access." Pet., 13-15 (§VI.D.1.g ([15G])), 20 (citing §VI.D.1.g ([15G])). However, Sheha's disclosures regarding "groups" are irrelevant for two reasons. *First*, Sheha only refers to the use of "groups" in the context of "landline-to-landline" requests (not mobile-to-mobile requests), whereas instead Claim 15 of the '117 Patent expressly refers to wireless telephones:

> A mobile or landline device can also request position information of another mobile or landline device by only specifying a telephone number, without having to initiate a telephone call. ***For a landline-to-landline position request***, the specified telephone number is correlated to its

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

EX1005, 11:55-12:7 (emphasis added). *Second*, a group policy is not an assignment of "location access rights" to a specific device as recited in the claims. This distinction is immensely important. The '117 Patent's claimed invention of a mobile device assigning "location access rights" to a specific device eliminates security risk and advantageously improves system security.

The Board should also reject Petitioners' hindsight attempt to reinterpret Sheha as teaching or suggesting something more. Pet., 15-16 (§VI.D.1.g ([15G])), 20 (citing §VI.D.1.g ([15G])). That the security advantages provided by the '117 Patent's claimed inventions are only disclosed by the '117 Patent, and not the cited references, should not be taken lightly. *In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965) (holding that there is an enduring admonition against impermissibly

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

Turning to Randall (Grounds 4-6), the Petition likewise falls well short of demonstrating that Randall teaches or suggests these claim limitations. It alleges that "Bob could promote Alice to an i-Group that Bob has specified as having access to Bob's GPS location, thus using Bob's device to assign location access rights to Alice's device whose number is in Bob's contacts." Pet., 61. However, Randall does not disclose or suggest the '117 Patent's claimed features that the same device that is capable of having its location determined is capable of providing location access rights for another ***specific device*** to access the location information, nor does Randall disclose or suggest the corresponding the security advantages that the '117 Patent teaches these features provide.

Randall refers to a remote database that can store information regarding multiple individuals and can also "define which entities can read different fields" in the database. Randall, [0047]. However, the Petition, and Randall, are completely silent has to how those "defin[itions of] which entities can read different fields" are established. Randall does not teach or suggest that such definitions are provided by the same wireless telephone that is capable of having its location determined, which is a distinct security advantage disclosed and claimed by the '117 Patent. *See* EX1001, 1:44-54 ("One object of the present invention is to provide a ***security feature*** which allows a user to limit and/or deny location access to a particular user. … In this manner, ***a cell phone user may give access, through his or her cell phone***, to a friend so that the friend can locate him or her …."). This alone is fatal to Petitioners' Ground based on Randall.

Randall also does not teach or suggest providing "assigning location access rights" to another wireless telephone as claimed in Claim 15. The Petition acknowledges that Randall's system assigns access rights to groups, called "i-Groups." Pet., 60-61. This is so even when the group is intended, at least initially, to have only one individual member. *Id*., 57 (§IX.B.1.g ([15G]) citing Randall's "i-Group" for "partner") which the Petition acknowledges is accessible to "user**s** whom [Alice] has assigned to the 'i-Group' called 'partner'" even if Alice only initially assigns "Bob" to that group), 60 (citing (§IX.B.1.g ([15G]) of the Petition). But as

discussed, granting access rights to a group does not teach or suggest "assigning location access rights" to a wireless telephone as claimed in Claim 15. A group may be an empty set, and even if at one point in time the group has only one individual member (like Petitioners argue), the group's members may change over time such that the policy is not for any device but rather generic to a group, however such group is defined and however that definition may change over time. Accordingly, reliance on a group policy for the grant of access rights does not disclose or suggest, and is very different than, what is claimed by the '117 Patent and imposes risk of erroneously allowing or disallowing access to location information. *Id*.; *Cf*. EX1001, 1:44-46 ("One object of the present invention is to provide ***a security feature which allows a user to limit and/or deny location access to a particular user***.") (emphasis added).

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

Accordingly, the Board should find that the Petition has failed to demonstrate invalidity of these claim limitations, and thus should decline to institute any Grounds of the Petition with respect to Claim 15 or any of its dependent claims. *See, e.g.*, *Samsung Elecs.*, IPR2023-00130, Paper 10 at 26 (exercising discretion to deny

institution because "we agree that Petitioner's showing is less than compelling, as it rests tenuously upon apparent logical leaps"); *Samsung Display*, IPR2024-00855, Paper 12 at 13 (denying institution "because a genuinely-disputed issue surrounds the correct [claim] construction …. That genuine dispute, in turn, casts doubt upon whether Petitioner 'is highly likely' to prevail in showing that the [claim] limitation would have been obvious"); *AT&T Services, Inc. v. ASUS Technology Licensing Inc.*, IPR2024-01142, Paper 14 at 27 (PTAB Jan. 27, 2025) (denying institution because "Patent Owner has identified a plausible understanding of the meaning of the claims … and potential dispositive inadequacies in Petitioner's approach to accounting for features of those claims").

3. Grounds 2, 3, 5, and 6 of the Petition Fail to Establish Obviousness of the Limitation "Location Access Rights of Said Wireless Telephone from Said Second Wireless Telephone" in Claim 29 and Its Dependent Claims

The Board should also decline to institute Grounds 2, 3, 5, and 6 because the cited references fail to teach or suggest these claim limitations.

The Petition's arguments for this limitation are again based on Petitioners' fundamental misreading of the claim language. Similar to Claim 15, *see supra* Section III.C.1, properly construed, this limitation of claim 29 requires the claimed location access rights be provided both (i) by the specific wireless telephone recited

in the claim ("said second wireless telephone") and (ii) to the specific device recited in the claim ("said wireless telephone").

For its part, Petitioners in effect erroneously seek to rewrite this term in Claim 29 to read: "~~location access rights of~~ a policy that may result in allowing said wireless telephone to access location information about ~~from~~ said second wireless telephone." *Id*. Then, and only then on the basis of Petitioners' improper rewriting of the language of Claim 29, Petitioners incorrectly argue that Sheha or Randall teaches or suggests these claim limitations. Like their analysis for Claim 15, Petitioners' rewriting of the claim language suffers from two key errors of claim construction.

First, the Petition repeatedly ignores (by ascribing no meaning to and failing to substantively address in the Petition) the portion of this term that expressly requires the "location access rights" to be provided "***from***" the specific device recited in the claim ("said second wireless telephone") to another specific device recited in the claim ("said wireless telephone"). The plain language of the claim is clear that the "location access rights" must be provided by the specific device recited in the claim, and that device has its location determined. EX1001, Claim 29 ("selecting a location-based event that is based, at least in part, ***on a location of a second wireless telephone*** … receiving a location-based event notification corresponding to said selected location-based event as a result of, at least in part,

location access rights … ***from said second wireless telephone***). These words must be given meaning and cannot be ignored. *Phillips*, 415 F.3d at 1314. This conclusively establishes that the second wireless telephone must provide the "location access rights", and the Board should reject Petitioners' attempt to read this limitation out of the claim. Like Petitioners' error in their analysis of Claim 15, this is a significant error because requiring the same device that has its location determined to provide the location access rights to access that device's location information enhances system security. EX1001, 1:44-54.

Second, the Petition repeatedly points to group policies that purportedly give access to location information to indeterminate and fluctuating members of a group. However, as discussed *supra* at Section III.C.1, a group policy is not a grant of "location access rights" that "from" a specific device as recited in the claims. Just as for Claim 15, the meaning of the plain language of Claim 29 is readily apparent: rights to access the location is provided that is intended to be received or used by or aimed at a recipient—and the claim language expressly identifies that recipient, *i.e.*, "said wireless telephone." *See Phillips*, 415 F.3d at 1314. As discussed above, *supra* Section III.C.1, to interpret these claims as merely setting a policy that applies to a group, however that group is defined and may change, would improperly strip the claims of their actual words and their common meaning. Group policies create a security risk of erroneously allowing or disallowing access to location information,

and, as shown in the specification and figures, Patent Owner's disclosed and claimed innovations improve system security and address that very issue. *See supra* Section III.C.1.

Turning to Petitioners' arguments, for Grounds 2 and 3 Petitioners rely on Sheha as allegedly teaching or suggesting this limitation and, in the alternative, a combination of Sheha and Degnbol. Pet., 2, 34. For Grounds 5 and 6, Petitioners rely on Randall as allegedly teaching or suggesting this limitation and, in the alternative, a combination of Randall and De-Vries. Pet., 2, 73-74.

First addressing Sheha (Grounds 2 and 3), the Petition first asserts that Sheha's "ODAS determines whether the target device has given the requesting device *location access rights*." Pet., 34. But Sheha does not disclose determining whether a specific target device has been granted location access rights by another specific device as claimed. The Petition tacitly concedes this point when it vaguely alleges that "any 'users can define ***a group*** of specific users that have access to this [location] information' as part of configuring ***privacy permissions***." Pet., 13-15 (§VI.D.1.g ([15G]) quoting Sheha 11:55-12:7) (emphasis added), 20 (citing §VI.D.1 and Sheha 11:55-12:7)). But this does not disclose or suggest the claimed features that the "location access rights" are provided "***from***" the specific device recited in the claim ("said second wireless telephone") to another specific device recited in the claim ("said wireless telephone"). Indeed, Sheha does not disclose or suggest these

claim limitations nor the corresponding security advantages that the '117 Patent discloses these features provide.

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

Aside from Sheha's privacy settings, Petitioners also rely on Sheha's reference to a "group" database and "defin[ing] a group of specific users that have access." Pet., 13-15 (§VI.D.1.g ([15G])), 34 (citing §VI.D.1 (Claim 15)). However, as discussed *supra* in Section III.C.1., Sheha's disclosures regarding "groups" are irrelevant because it only refers to the use of "groups" in the context of "landline-to-landline" requests (not the claimed wireless devices) and a group policy is not "location access rights" provided "to" a specific device to access location information as recited in the claims. *See supra* Section III.C.1. These distinctions are important. The '117 Patent's claimed invention of a mobile device providing

"location access rights" "to" another specific wireless device eliminates security risk and advantageously improves system security. *Id*.

The Board should also reject Petitioners' hindsight attempt to reinterpret Sheha as teaching or suggesting something more. Pet., 15 (§VI.D.1.g ([15G])), 34 (citing §VI.D.1 (Claim 15)). That the security advantages provided by the '117 Patent's claimed inventions are only disclosed by the '117 Patent, and not the cited references, should not be taken lightly. *See supra* Section III.C.1; *In re Wesslau*, 353 F.2d at 241; *In re Enhanced Sec. Research*, 739 F.3d at 1355.

In addition, the Board should reject Petitioners reliance, in the alternative, on a combination of Sheha with Degnbol. Pet., 34-35. First, like Sheha, Degnbol fails to teach or suggest that "location access rights" are provided "***from***" a "second wireless telephone" as claimed in Claim 29. Degnbol instead states that determining who is part of a user's "Buddy List" is "carried out via other channels, for example through a web-based interface or by calling a customer service representative at a call-center." EX1035 at 5:28-31. Second, Degnbol also does not teach or suggest "location access rights" are "***of***" a specific device. Rather, like Sheha, Degnbol instead states that any permissions are based on a user's "group[ing] Buddies into different categories, i.e., 'Friends', 'Relatives', and sub-categories such as 'Bowling Friends', 'Friends from work', 'Best Friends', etc." *Id*., 10:5-11. Again, a group policy is not "***location access rights***" "***of***" a specific device to access location

information as recited in the claim. Moreover, the Petition's reliance on "preferences" is incorrect and misleading. Pet., 34. Degnbol's preferences relate to notifications that the user wishes to receive about others—it does not disclose or suggest that location access rights to information about a user's own location are provided by the user's device to another specific device.

Turning next to Randall (Grounds 5 and 6), the Petition likewise falls well short of demonstrating that Randall teaches or suggests these claim limitations. It alleges that "Randall's system provides a *location-based event notification* on Bob's device ….'" Pet., 56-57 (citing Randall, [0264]). However, Randall does not disclose or suggest the '117 Patent's claimed features that the "location access rights" are provided by the specific device recited in the claim, and that device has its location determined. EX1001, Claim 29 ("selecting a location-based event that is based, at least in part, ***on a location of a second wireless telephone*** … receiving a location-based event notification corresponding to said selected location-based event as a result of, at least in part, location access rights … ***from said second wireless telephone***). Nor does Randall disclose or suggest the corresponding the security advantages that the '117 Patent teaches these features provide.

As discussed *supra* Section III.C.1, Randall refers to a remote database that can store information regarding multiple individuals and can also "define which entities can read different fields" in the database, but is completely silent has to how

those "defin[itions of] which entities can read different fields" are established. Randall, [0047]. Randall does not teach or suggest that such definitions are provided by the same mobile device that is capable of having its location determined, which is a distinct security advantage disclosed and claimed by the '117 Patent. *See supra* at Sections III.C.1; EX1001, 1:44-54. This alone is fatal to all of Petitioners' Grounds involving Randall.

Randall also does not teach or suggest providing "location access rights" "of" another device to access location information as claimed in Claim 29. As discussed *supra* at Section III.C.1, the Petition acknowledges that Randall's system assigns access rights to groups, called "i-Groups." But, as discussed with respect to Sheha, granting access rights to a group does not teach or suggest providing "location access rights" "of" a wireless device as claimed in Claim 29. *See also supra* at Section III.C.1 (explaining that Randall's use of i-Groups injects ambiguity and uncertainty, and risk of improper disclosure, all of which are inconsistent with the disclosed and claimed inventions of the '117 Patent). This misreading is fatal to all of Petitioners' Grounds based on Randall.

The Board should also reject Petitioners reliance, in the alternative, on a combination of Randall with De-Vries. Pet., 73-74. First, like Randall, De-Vries fails to teach or suggest that "location access rights" are provided "***from***" a "second wireless telephone" as claimed in Claim 29. Rather, De-Vries merely states that a

"user can set rules" but does not disclose or suggest how such rules may be set. EX1013 at 2:63. Second, De-Vries also does not teach or suggest "location access rights" are "***of***" a specific device. Rather, like Randall, De-Vries instead states that any permissions are based on a user's grouping of others into "buddy lists," which can be further segregated "into separate subsets, such as subsets of family, friends, business contacts, co-workers, etc." *Id*., 2:43, 3:5-8. And, De-Vries states that any permissions are provided on a group policy basis: "a social mode where … as to anyone on their buddy list … the user is visible," "a business mode in which … the user is visible to only their business contacts and co-workers," and "a private mode in which the user is visible only to a select subset …." *Id.*, 3:22-30. Again, a group policy is not "***location access rights***" "***of***" a specific device to access location information as recited in the claim.

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

Accordingly, the Board should find that the Petition has failed to demonstrate invalidity of these claim limitations by a "reasonable likelihood," much less a sufficiently strong case of purported invalidity to overcome the factors strongly

supporting discretionary denial, and thus should decline to institute Grounds 1-6. *See, e.g.*, *Samsung Elecs.*, IPR2023-00130, Paper 10 at 26 (exercising discretion to deny institution because "Petitioner's showing is less than compelling, as it rests tenuously upon apparent logical leaps"); *Samsung Display Co.*, IPR2024-00855, Paper 12 at 13 (exercising discretion to deny institution because "a genuinely-disputed issue surrounds the correct [claim] construction …. That genuine dispute, in turn, casts doubt upon whether Petitioner 'is highly likely' to prevail in showing that the [claim] limitation would have been obvious"); *AT&T Services*, IPR2024-01142, Paper 14 at 27 (exercising discretion to deny institution because "Patent Owner has identified a plausible understanding of the meaning of the claims … and potential dispositive inadequacies in Petitioner's approach to accounting for features of those claims ….. Petitioner's proposed grounds cannot be said to rise to the level of a 'compelling' meritorious challenge").

* * *

The Petition's excessive reliance on conclusory expert testimony further demonstrates the weakness of the merits of Petitioners' unpatentability challenges. *See generally* Pet. (citing "Williams-Decl." over 200 times); *see also, e.g.*, Pet., 7-22 (citing "Williams-Decl." after nearly every sentence in its Ground 1, Claim 15 analysis). Petitioners' pervasive attempts to buttress weak obviousness

combinations with unsupported expert testimony also provides another basis for discretionary denial. *See* EX2003, 2.

IV. CONCLUSION

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

Dated: April 21, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

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

Dated: April 21, 2025

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CERTIFICATE OF SERVICE

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