

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. IPR2025-00367
U.S. Patent No. 11,234,117 (Claims 42-72)

PATENT OWNER'S PRELIMINARY RESPONSE

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TABLE OF EXHIBITS

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

2009	<i>MyPort, Inc. v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:22-CV-00114-JRG, Order, Dkt. 73 (E.D. Tex. June 13, 2023)
2010	<i>Solas OLED Ltd. v. Samsung Display Co., Ltd.</i> , Case No. 2:19-CV-00152-JRG, 2020 U.S. Dist. LEXIS 125973 (E.D. Tex. July 17, 2020)
2011	<i>Oyster Optics, LLC, v. Infinera Corp.</i> , Case No. 2:19-CV-00257-JRG, Order, Order, Dkt. 87 (E.D. Tex. July 17, 2020)
2012	Docket Navigator, Time to Milestones for Judge Gilstrap (E.D. Tex.) in Patent Cases for the Last 5 Years
2013	<i>Mullen Industries LLC v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:24-CV-00049-JRG, Complaint, Dkt. 1 (E.D. Tex. Jan. 26, 2024)
2014	<i>Mullen Industries LLC v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:24-CV-00049-JRG (E.D. Tex.), Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.’s Amended Invalidity Contentions
2015	Reserved
2016	Excerpt from <i>Mullen Industries LLC v. Samsung Elecs. Co., Ltd.</i> , Case No. 2:24-CV-00049-JRG (E.D. Tex.), Non-Party Google LLC’s Objections and Responses to Mullen’s Document Subpoena
2017	USPTO Director’s Brief in <i>Apple Inc. v. Vidal</i> , No. 5:20-cv-06128-EJD (N.D. Cal. Sept. 21, 2023)
2018	USPTO Director’s Brief in <i>Apple Inc. v. Vidal</i> , No. 2024-1864 (Fed. Cir. Oct. 16, 2024)

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

Patent Owner Mullen Industries LLC (“Patent Owner” or “Mullen”) submits this Preliminary Response to the Petition for *inter partes* review IPR2025-00367 (“Petition”) of U.S. Patent No. 11,234,117 (the “’117 Patent”) filed by Petitioners Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Google LLC’s (“Petitioners”).

I. INTRODUCTION

The Board should deny institution of the Petition under 35 U.S.C. § 314(a) because the Petition fails establish invalidity of any challenged claim based on the multiple asserted references for any Ground. As described in detail below, the Petition fails to establish the presence of multiple claim limitations applicable to each of the Grounds of the Petition. For example, for all Grounds 1-4, the Petition fails to establish anticipation or obviousness of “requesting a location of a said second wireless device from a server located remotely from said wireless telephone and said second wireless device” and “displaying on said wireless telephone an option to request location access rights from said second wireless device after it is determined that said wireless telephone does not have location access rights for said second wireless device.” ’117 Patent, Claim 42. The Petition attempts to cure deficiencies in the cited references with excessive reliance on conclusory expert testimony. As explained herein, these claimed features are indeed Patent Owner’s

innovative improvements that improve system security and are in no way taught or suggested by the cited art.

As addressed in full in Patent Owner's Discretionary Denial Briefing, the imminent trial in the underlying district court litigation will resolve the invalidity disputes at issue in this Petition, and therefore institution of this Petition is a waste of valuable PTAB resources. Paper 12. These considerations, in addition to the weakness of Petitioners' unpatentability challenges, and excessive reliance on expert testimony, warrant denying institution of the Petition.

II. BACKGROUND

Jeffrey Mullen is an independent inventor who has invented prolifically across a wide array of technologies since the early 2000s, including, for example, with regard to wireless and cellular communications systems and devices, security improvements regarding the same, augmented reality and virtual reality devices, and autonomous defense systems. Mr. Mullen is the inventor of the '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 Petitioner Samsung's unlawful use of Mr. Mullen's patented technologies, including but not limited to with regard to 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

systems and methods for cellular phones and security measures for the same. These systems and methods provide that a wireless device is operable to have its location determined, request location and location access rights from other devices, display options for changing access rights, transmitting requests for location access rights assignments and itself grant a permission for another wireless device to access location information about that location—all of this more than 18 years *before* Samsung released its Samsung SmartThings Find technology containing the same features. Ex. 2001; Ex. 2002.

III. ARGUMENT

A. Grounds 1-4 Of The Petition Are Weak on the Merits and Fail To Establish Obviousness of Any Claim

Each of the Grounds¹ of the Petition is directed to Claim 42 of the '117 Patent, or a claim dependent on Claim 42.

Claim 42 specifies a wireless telephone having programming capable of requesting the location of another wireless device, displaying an option to request rights to access that location if access rights have not yet been given, transmitting a request for access rights to a server and receiving the location if access rights are provided. '117 Patent, Claim 42. These summarized features of Claim 42 addressed

¹ At this preliminary stage, and before submission of expert testimony, Patent Owner neither disputes nor consents to Petitioner's definition of a person of ordinary skill in the art. Pet., 3-4.

in this Preliminary Response are seen in the below emphasized text of Claim 42. Claim 42 specifies several additional features, as seen below in the Claim, as do corresponding dependent claims 43-72, which would need to be addressed if there were institution.

Limitation	Claim Language
42(pre)	A wireless telephone comprising:
42(a)	a processor;
42(b)	a positioning system for determining a location of said wireless telephone; and
42(c)	memory storing programming capable of:
42(d)	<i>requesting a location of a second wireless device</i> from a server located remotely <i>from said wireless telephone</i> and said second wireless device;
42(e)	<i>displaying on said wireless telephone an option to request location access rights</i> from said second wireless device after it is determined that said wireless telephone does not have location access rights for said second wireless device;
42(f)	transmitting a request to said server that said location access rights be assigned for said wireless telephone by said second wireless device; and
42(g)	receiving said location of said second wireless device from said server dependent upon said access rights.

The Board should decline to institute Grounds 1-4 at least because the cited references fail to teach or suggest at least the following claim limitations of independent Claim 42:

- “requesting a location of a said second wireless device from a server located remotely from said wireless telephone and said second wireless device”
- “displaying on said wireless telephone an option to request location access rights from said second wireless device after it is determined that said wireless

telephone does not have location access rights for said second wireless device”

The Petition fails to show that skilled artisans would have understood that Randall or Sheha in combination with Futagami and/or Darling teach or make obvious at least these limitations, and accordingly fails to show the cited references teach or suggest Claim 42 or corresponding dependent claims 43-72.

1. Randall Alone or in Combination with Darling or Futagami Fails to Teach or Render Obvious One Device Requesting the Location of Another

Independent Claim 42 recites, *inter alia*, a wireless telephone with memory storing programming capable of “requesting a location of a second wireless device[.]” ’117 Patent, Claim 42. Randall does not teach or render obvious this element alone or in combination with Darling.

Randall refers to employing a remote database that stores different “fields” of information for a multitude of individuals, with each individual pre-defining those who can access those fields. Randall, [0047]. Randall discloses a user, e.g. Alice, affirmatively choosing “to subscribe to the service which allows” another, Bob, to track her. *Id.*, [0021]. After doing so, Alice then must provide an “ADS” number to Bob. *Id.*, [0049]. Upon receipt of the ADS number, Bob “sends Alice’s ADS number to the server” which “recognizes Bob’s device and allows that device to read Alice’s information held on the database which is specified as being accessible to Bob[.]”

Id. Thus, only if Alice preemptively specified her location as accessible for Bob, and only if Bob has been given Alice's ADS number, can Bob view Alice's location. If she doesn't make this information available to Bob or others, he cannot.

This process does not describe a first device asking a second device for its location. Randall instead describes a second device incapable of requesting location, whereby access must be granted *first* and even then only accessible after receipt and entry of an ADS number on the first device. This multi-step process, originating with Randall's equivalent "second wireless device" is wholly divorced from Claim 42's requirement of a specific *request* for a location of a second wireless device originating from the original wireless device.

Petitioner implicitly concedes that Randall does not teach or suggest this limitation by incorporating Darling. Pet., 16. Darling does not cure this deficiency. Darling refers to location information for Darling's "second wireless device" being transmitted to the server prior to the claimed wireless telephone "requesting a location of [the] second wireless device from a server." Darling, 2:1-3. Thus, Darling's location disclosure occurs with or without a "request" for location.

Petitioners' reliance on the testimony of Williams for this claim element is unavailing. Williams does not explain how Randall's remote database of "fields" with pre-defined rules for third-party access, nor how the pre-requisite separate steps of (1) disclosure and (2) entry of an ADS number, refers to "requesting a location of

a second wireless device” as required by Claim 42. Ex. 1003, [0136]-[0139]. Williams instead makes the conclusory statement that “Randall discloses Element [42D].” *Id.*, [0137]. Williams completely ignores the Darling’s initial step of sending location information to the server prior to any request, which renders his conclusion that “Darling reinforces Randall’s teaching” conclusory, unsupported, and contradictory to the express language of Darling. *Id.*, [0138].

For these reasons alone, the Petition and Randall (alone or in combination with Darling) fails to teach or suggest claim 42, or any claim dependent thereon.

2. Randall Alone or in Combination with Darling or Futagami Fails to Teach or Render Obvious Displaying an Option to Request Location Access Rights After it Has Been Determined That Access Rights Have Not Been Granted

This limitation recites that, after a determination is made that the wireless telephone does not have location access rights for the second wireless telephone, the wireless telephone displays on its screen *an option to request* those rights. ’117 Patent, Claim 42. Randall does not teach or render obvious this element alone or in combination with Darling or Futagami. Petitioner does not and cannot alleged that Randall nor Darling teach or suggest displaying an option to request location access rights. Instead, Petitioner improperly combines Randall with the inapposite disclosures of Futagami.

Futagami, however, also does not teach or suggest displaying an option on the wireless telephone to request access rights from a second device after it has been determined that the wireless telephone does not have location access rights for the second device. Futagami contemplates using its system for “names, telephone numbers, addresses, dates of birth, and electronic mail address”—***not location information***. Futagami, 4:10-12. Futagami discloses an “information processing apparatus” that upon receipt of a “keyword” (i.e., a search term) from a “client terminal” (i.e., a device operated by a requesting party), retrieves information associated with that keyword, and transmits that information to the requesting client terminal. *Id.*, 2:1-21. When access to the requested information is “not permitted or is restricted,” Futagami refers to “inquiring of the owner of the personal information whether or not to give permission as to providing of the personal information[.]” *Id.*, 2:33-35. Thus, Futagami does not teach or suggest “displaying an option” to the unpermitted requestor of restricted information—it inversely immediately questions the owner of the personal information (as Petitioner would have it, the “second wireless device”) if the restriction should be removed. *Id.* The Petition disregards this critical difference between Claim 42 and Futagami.

The Petition, ignoring this difference, points to Futagami’s statement that should a non-permitted requester “still want[] to access the retrieved personal information, the ***user transmits a message (restriction removal request message)*** to

the management server 6.” Futagami, 15:56-60. Writing and sending a message to request access is not displaying an option to request access as Claim 42 requires. The juxtaposition between Futagami’s “message” and “displaying an option” is made even clearer by Futagami’s express disclosures of when something is “displayed” at a client terminal. *See, e.g.*, Futagami, 16:22-25 (“The restriction removal inquiry message transmitted from the management server 6 *is received by the client terminal of the owner of the personal information and displayed.*”); 15:54-56 (“When the client terminal receives the refusal message from the management server 6, the refusal message is **displayed.**”); 5:23-25 (“In step S2, the terminal unit 22 **displays** the personal information input screen”); 5:64-64 (“electronic mail from a certain user is displayed in a window on the **display** screen of the client terminal ... electronic mail [is] **displayed** in the window”).

Futagami never teaches or suggests displaying an option to request access because Futagami does not operate in that manner. Rather, upon issuing a refusal, the process stops, and the user, without an option displayed before them, independently sends a message to the server. *Id.*, 19:20-26 (“because the access requester does not transmit a restriction removal request ... the access requester cannot acquire the personal information”). Futagami further states that if a user receives a refusal message and decides to not write and “transmit a restriction removal request ... the management server 6 does not transmit a restriction removal

inquiry message to the personal information owner.” 19:15-23. This is a stark difference from the ’117 Patent’s device that “*asks* the requester if the requester would like to request access rights.” ’117 Patent, 12:34-35.

Aware of this deficiency, the Petition again attempts to cure the absence of “displaying on said wireless telephone an option to request location access rights” in Futagami with purported expert testimony of Williams. But the cited testimony—“POSAs would have understood, for example, that an obvious implementation to solicit the “yes” or “no” to be “input by the user” would include *displaying an option* in the refusal message”—provides no supporting evidence or technical reasoning, just a conclusory statement. *Xerox Corp. et al. v. Bytemark, Inc.*, IPR2022-00624, Paper 12, 5 (Feb. 10, 2023) (Precedential) (“The declaration does not provide any technical detail, explanation, or statements supporting *why* the expert determines that the feature in question was required or would have been obvious based on the prior art disclosure.”) (emphasis in original).

Randall and Futagami are also technically very different and incompatible. Randall refers to the preemptive assignment of third-party rights to a user’s information, obtainable only *after* assignment and provision of a unique “ADS” number. Futagami on the other hand employs a “personal information acquisition process” whereby a user requests third party information matching certain “keywords”. Futagami, 14:50-54. *Prior to* obtaining or checking permission rights,

the direct opposite of Randall, Futagami's server gathers the requested information. *Id.*, 14:59-65. Only after collecting the requested information does Futagami begin its access restriction process, whereas before any information is collected in Randall's system, Randall's users need to first (1) be granted access rights by the owner preemptively, (2) be given the owner's ADS number, and (3) authenticated. Randall, [0047]-[0049].

Further, Futagami does not disclose or even hint at using its system for sharing location information, making it even less likely a skilled artisan would have been motivated at the time of the invention to combine the disclosures of Randall and Futagami. Petitioner's declarant's conclusory testimony that "POSAs would have understood Futagami's technique to be desirable" cannot overcome the stark differences amongst the references. *Xerox Corp*, IPR2022-00624, Paper 12, 5.

Neither Petitioner, nor Williams, even contend Darling teaches or suggests displaying an option to request location access rights.

For these reasons too, the Petition and Randall (alone or in combination with Futagami) fails to teach or suggest claim 42, or any claim dependent thereon.

The Board should also reject Petitioners' hindsight attempt to reinterpret Futagami as teaching or suggesting something more. 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 Security Research, LLC*, 739 F.3d 1347, 1355 (Fed. Cir. 2014) (holding it impermissible to “stitch together an obviousness finding ... without considering the references as a whole”); *see also e.g., InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014) (concluding that expert “succumbed to hindsight bias in her obviousness analysis” by focusing on what “one of ordinary skill in the art could” allegedly have done instead of what “they would have been motivated to do”).

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

Accordingly, the Board should find that the Petition has failed to demonstrate invalidity of these claim limitations by a “reasonable likelihood,” much less a “compelling case” of purported invalidity, and thus should decline to institute Grounds 1-2. *See e.g., Samsung Electronics Co, Ltd. v. California Institute of Technology*, IPR2023-00130, Paper 10 at 26 (May 4, 2023) (exercising discretion to

deny institution because “we agree that Petitioner’s showing is less than compelling, as it rests tenuously upon apparent logical leaps”).

3. Sheha Alone or in Combination With Darling or Futagami Fails to Teach or Render Obvious One Device Requesting the Location of Another

Independent Claim 42 recites, *inter alia*, a wireless telephone with memory storing programming capable of “requesting a location of a second wireless device[.]” ’117 Patent, Claim 42. Sheha does not teach or render obvious this element.

Sheha implements communications between users in a fundamentally different manner than that which is recited in the instant limitation of Claim 42. Sheha describes that a phone number or a device may have “privacy settings” or “permission settings” that indicate whether a caller can obtain a location. Sheha, 4:35-40, 4:62-5:2, 5:3-11, 5:15-19, 5:37-45, 10:17-26, 10:47-50, 11:3-8, 12:1-4. The “privacy settings” or “permission settings” are not described as targeting other specific devices or users, but are rather described as follows:

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***. Sheha, 4:35-40 (emphasis added)

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***. If there

are no ***privacy settings***, the system would request the position information from the remote mobile device and forward it back to the local mobile device. *Id.*, 4:62-5:2 (emphasis added)

In another embodiment, the destination remote mobile device receiving the telephone call ***obtains the position information*** from the calling local mobile device, ***based on permission settings of the calling local mobile device***, for the performance of various operations, such as mapping and calculating driving directions. In this case, the calling local mobile device has ***privacy settings*** that determines the period of the position transfer to the destination remote mobile device. *Id.*, 5:3-11 (emphasis added)

Any time one of Sheha's callers makes a call, the ODAS system provides whatever information is available, as dictated by the call recipient's privacy settings. The absence or presence of privacy settings, and thus ODAS's ability to provide position information, is not the same as "requesting a location of a second wireless device from a server." Rather, it is an automatic, indiscriminate dissemination of information that is agnostic as to the identity of the caller.

The Petition's reliance on Sheha also fails to appreciate the plain language of this claim element by analogizing the actions of ODAS (Sheha's server) to the "memory storing programming" on the "wireless telephone" that is capable of "requesting a location of a second wireless device *from* a server." '117 Patent, Claim 42. Petitioner relies on the following disclosure in Sheha: "[w]hen a mobile device 18b dials a phone number" the "ODAS 3 requests position information from the destination mobile device 18c[.]" Pet., 68, quoting Sheha, 11:10-54. This disclosure is very clear – the mobile device makes a phone call, and *ODAS*, not the mobile

device, initiates the “request” for “position information.” This process is entirely inconsistent with Claim 42’s requirement of a specific *request* for a location of a second wireless device originating from the original wireless device.

For these reasons alone, the Petition and Sheha fail to teach or suggest claim 42, or any claim dependent thereon.

4. Sheha Alone or in Combination With Darling or Futagami Fails to Teach or Render Obvious Displaying an Option to Request Location Access Rights After it has Been Determined That Access Rights Have Not Been Granted

This limitation recites that, after a determination is made that the wireless telephone does not have location access rights for the second wireless telephone, the wireless telephone *displays* on its screen *an option to request* those rights. ’117 Patent, Claim 42. Sheha does not teach or render obvious this element alone or in combination with Darling or Futagami.

Sheha’s disclosures do not even describe a first device requesting that a second device change its privacy or permission settings, never mind the first device displaying an option to request location access rights. Instead, Sheha indicates that position information is only provided according to a sender’s designated permissions:

In another embodiment, the destination remote mobile device receiving the telephone call obtains the position information from the calling local mobile device, based on **permission settings** of the calling local mobile device, for the performance of various operations, such as

mapping and calculating driving directions.” Sheha, 5:3-9 (emphasis added)

The calling local mobile device can also choose not to reveal its local position to the destination remote mobile device for privacy purposes at anytime and can conversely enable position transfer **permissions** at anytime and for any period of time or as long as the call is active.” *Id.*, 15-19 (emphasis added)

The mobile device location information can be provided only, due to **privacy settings**, if the user configured the mobile device 18a to allow position information [] 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)

“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. The server queries the remote party of the position request for **permission** on whether the position request can be granted based on criteria such as duration of request. If granted, both parties have access to each other’s position information, which can be used for real-time driving directions or collaboration purposes.” *Id.*, 5:24-33 (emphasis added)

These disclosures do not involve requesting *access rights* – they disclose position information that will only be provided according to rules set up by the owner of position information. If the permission or privacy settings do not allow for disclosing position information, Sheha provides no methodology for the caller to request position information, never mind a change in location access rights.

“Access rights” and “location information” are two different things, which Claim 42 makes clear. Claim 42 (emphasis added) (“requesting a *location*” and “displaying ... an option to request location *access rights*”). Petitioner disregards the plain language of the Claim and conflates the two by relying on Sheha’s disclosure that a user can update their privacy settings thereby allowing a caller to access position information and calling that “requesting location access rights.” This is improper, and falls well short of showing that Sheha teaches or suggests requesting “location access rights.”

Because Sheha merely discloses providing advance access to a user’s position information, and is *silent* on requesting access rights in the absence of such position information, Sheha does not disclose or suggest “displaying on said wireless telephone an option to request location access rights from said second wireless device after it is determined that said wireless telephone does not have location access rights for said second wireless device” as recited in Claim 42. Petitioner implicitly acknowledges this shortcoming in Sheha (as well as in Darling), by making the combination with Futagami. Pet., 72. But as discussed §III.A.2, Futagami does not teach or suggest “displaying on said wireless telephone an option to request location access rights.” For these reasons alone, the Petition and Sheha (alone or in combination with Futagami) fails to teach or suggest claim 42, or any claim dependent thereon.

Petitioner's alleged motivation to combine Sheha and Futagami is insufficient. First, the sole purpose of Sheha is associating address information with phone numbers, whereas Futagami is silent on location information. On this point alone, skilled artisans would not have been motivated to combine these references on this discrepancy. Moreover, where Futagami employs keyword searching for relevant information with individualized "access restrictions information associated with the ... personal information itself," Sheha's "privacy settings" provide a blanket wall across all location data that either permits or does not permit disclosure to other callers. *See, e.g.*, Futagami 2:1-21, 15:4-7; Sheha, 4:35-40, 4:62-5:2, 5:3-11, 5:15-19, 5:37-45, 10:17-26, 10:47-50, 11:3-8, 12:1-4. Petitioner's reliance on the declaration of Williams does not cure this problem because Williams' opinions are generic and conclusory rationales, devoid of explanation as to what modifications to either system are required to effectively combine them. For example, Mr. Williams merely contends skilled artisans would have been motivated to supplement Sheha with Futagami's "access control techniques" because the "references discuss overlapping, complementary, and beneficial techniques for controlling access to personal information." Ex. 1003, [0292]. For these reasons alone, the Petition and Sheha (alone or in combination with Futagami) fails to teach or suggest claim 42, or any claim dependent thereon.

In conclusory fashion, Mr. Williams contends “POSAs would have been motivated and would have had a reasonable expectation of success in applying, to location requests in Sheha’s system, Futagami’s disclosures for how to proceed when the requesting user does not already have access to the requested information” and that it would have been “desirable” to do so “because it allows the requesting user to choose whether it makes sense to disturb the other user[.]” *Id.*, [0293]. Beyond improperly commingling the motivation to combine analysis with the reasonable expectations of success analysis, Mr. Williams’ conclusory opinions *completely* ignore the functionality of Sheha. Sheha only refers to sharing location information when one user *calls* (i.e., disturbs) another user. Regardless of whether Sheha could technically be combined with Futagami (Mr. Williams provides no explanation or evidence of how Sheha and Futagami could be modified from a technical standpoint), Sheha is not concerned with disturbing users because it is focused on the simultaneous exchange of location information when the parties are on a phone call with one another. Sheha, 7:12-16; 7:50-57; 7:58-67; 9:57-10:4; 11:10-23; 11:44-51. For these reasons alone, the Petition and Sheha (alone or in combination with Futagami) fails to teach or suggest claim 42, or any claim dependent thereon.

The Board should also reject Petitioners’ hindsight attempt to reinterpret Sheha as teaching or suggesting something more. 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 Security Research, LLC*, 739 F.3d 1347, 1355 (Fed. Cir. 2014) (holding it impermissible to “stitch together an obviousness finding ... without considering the references as a whole”); *see also e.g., InTouch Techs., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014) (concluding that expert “succumbed to hindsight bias in her obviousness analysis” by focusing on what “one of ordinary skill in the art could” allegedly have done instead of what “they would have been motivated to do”).

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

Accordingly, the Board should find that the Petition has failed to demonstrate invalidity of these claim limitations by a “reasonable likelihood,” much less a “compelling case” of purported invalidity, and thus should decline to institute

Grounds 1-4. *See e.g., Samsung Electronics Co, Ltd. v. California Institute of Technology*, IPR2023-00130, Paper 10 at 26 (May 4, 2023) (exercising discretion to deny institution because “we agree that Petitioner’s showing is less than compelling, as it rests tenuously upon apparent logical leaps”).

IV. CONCLUSION

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

Dated: May 14, 2025

Respectfully submitted,

/Peter F. Snell/

Peter F. Snell (Reg. No. 52,235)
Brad M. Scheller (Reg. No. 61,022)
MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY AND POPEO, P.C.
919 Third Avenue
New York, New York 10022
Telephone: 212-935-3000
Facsimile: 212-983-3115
E-mails: PFSnell@mintz.com;
BMScheller@mintz.com

CERTIFICATE OF WORD COUNT

The undersigned certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE specified in 37 C.F.R. § 42.24 have 4,736 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: May 14, 2025

/Peter F. Snell/

Peter F. Snell (Reg. No. 52,235)

CERTIFICATE OF SERVICE

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

Lead Counsel

Elisabeth H. Hunt
(Reg. No. 67,336)
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02210-2206
Telephone: (617) 646-8443
Facsimile: (617) 646-8646
elisabeth.hunt@wolfgreenfield.com

Backup Counsel

Gregory S. Nieberg
(Reg. No. 57,063)
WOLF, GREENFIELD & SACKS, P.C.
605 Third Avenue
25th Floor,
New York, NY 10158
Telephone: (212) 849-3338
Facsimile: (212) 697-7890
gregory.nieberg@wolfgreenfield.com
Michael S. Parsons
(Reg. No. 58,767)
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02210-2206
Telephone: (617) 646-8942
Facsimile: (617) 646-8646
michael.parsons@wolfgreenfield.com
Daniel D. Smith
(Reg. No. 71,278)
WOLF, GREENFIELD & SACKS, P.C.
Telephone: (617) 646-8038
dan.smith@wolfgreenfield.com
Andrew R. Varrenti
(Reg. No. 78,555)
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02210-2206
Telephone: (617) 646-8314
Facsimile: (617) 646-8646
andrew.varrenti@wolfgreenfield.com

Counsel for Google LLC

Benjamin Haber
(Reg. No. 67,129)
O'MELVENY & MYERS LLP
400 South Hope Street, 19th Floor
Los Angeles, CA 90071
Telephone: (213) 430-6000
Facsimile: (213) 430-6407
bhaber@omm.com

William M. Fink
(Reg. No. 72,332)
O'MELVENY & MYERS LLP
1625 Eye Street, NW
Washington, DC 20006
Telephone: (202) 383-5300
Facsimile: (202) 383-5414
tfink@omm.com

Patric M. Reinbold
(Reg. No. 79,178)
O'MELVENY & MYERS LLP
1625 Eye Street, NW
Washington, DC 20006
Telephone: (202) 383-5165
Facsimile: (202) 383-5414
preinbold@omm.com

Caitlin Hogan
(Reg. No. 61,515)
O'MELVENY & MYERS LLP
1301 Avenue of the Americas,
Suite 1700
New York, NY 10019
Telephone: (212) 326-4481
Facsimile: (212) 326-2061
chogan@omm.com

Counsel for Samsung Petitioners

Dated: May 14, 2025

/Peter F. Snell/

Peter F. Snell (Reg. No. 52,235)