

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOME DEPOT U.S.A., INC.,
Petitioner,

v.

H2 INTELLECT LLC,
Patent Owner

Case No. IPR2025-00480
Patent No. 8,433,296

**PETITIONER'S SURREPLY IN OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

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Exhibit No.	Description
1001	U.S. Patent No. 8,433,296 (the “ 296 patent ”).
1002	Declaration of David H. Williams.
1003	File History of U.S. Patent No. 8,433,296.
1004	U.S. Patent App. Pub. No. 2006/0149630 (“ Elliott ”).
1005	U.S. Patent App. Pub. No. 2002/0161633 (“ Jacob ”).
1006	File History of U.S. Pat. No. 11,948,171.
1007	U.S. Patent No. 6,108,650 (“ Musk ”).
1008	<i>H2 Intellect LLC v. The Home Depot, Inc., et al.</i> , Infringement Contentions, November 1, 2024.
1009	Macromedia Dreamweaver UltraDev Support Center - Defining Dynamic Content, https://web.archive.org/web/20060715033222/https://www.adobe.com/support/ultradev/content/url_parameters/url_parameters04.html (Jul. 15, 2006).
1010	U.S. Patent App. Pub. No. 2003/0142631 (“ Silvester ”).
1011	U.S. Patent App. Pub. No. 2007/0088852 (“ Levkovitz ”).
1012	U.S. Patent App. Pub. No. 2008/0032703 (“ Krumm ”).
1013	Apple launches official iPhone, iPod touch Web apps directory. https://appleinsider.com/articles/07/10/11/apple_launches_official_iphone_ipod_touch_web_apps_directory (Oct. 11, 2007).
1014	Five Killer Apps for Palm Centro (and Treo) Smartphones, https://www.cbsnews.com/news/five-killer-apps-for-palm-centro-and-treo-smartphones/ (Oct. 1, 2007).
1015	<i>H2 Intellect LLC v. The Home Depot, Inc., et al.</i> , Infringement Contentions, Exhibit A, November 1, 2024.
1016	Papers of H. Bentley Hahn: The Man Who Invented the 5-Digit ZIP Code, https://jfk.blogs.archives.gov/2021/07/01/papers-of-h-bentley-hahn-the-man-who-invented-the-5-digit-zip-code/ (July 1, 2021).
1017	Geofencing, Techopedia, https://www.techopedia.com/definition/14937/geofencing (last visited February 10, 2025).
1018	Jonathan P. Munson & Vineet K. Gupta, Location-Based Notification as a General-Purpose Service, Proceedings of the 2nd International Workshop on Mobile Commerce 40 (2002).

Exhibit No.	Description
1019	What We Do, Locating What's Important To You, Cell-Loc, http://web.archive.org/web/20030411221815/http://cellloc.com/what_locating.html (last visited February 10, 2025).
1020	Alan Cohen, "Location, Location, Location," PC Mag., available at https://books.google.com/books?id=eIvagv988JgC&pg=PA82#v=onepage&q&f=false (last visited February 10, 2025).
1021	U.S. Patent No. 7,133,685.
1022	U.S. Patent No. 7,164,986.
1023	U.S. Patent No. 8,536,999.
1024	U.S. Patent Publication No. US 2008/0094256.
1025	U.S. Patent No. 8,010,134.
1026	U.S. Patent Publication No. US 2006/0116817.
1027	U.S. Patent No. 10,380,636.
1028	Get parameters in url, https://www.drupal.org/forum/support/module-development-and-code-questions/2007-10-03/get-parameters-in-url (Oct. 3, 2007).
1029	Petitioner's Stipulation
1030	U.S. Patent App. Pub. No. 2010/0312646 (" Gupta ")

This sur-reply was authorized by the Director. EX3102. PO does not deny that there were multiple Examiner errors. PO does not deny that Gupta discloses the limitations added by Examiner amendment to place the application in condition for allowance. PO does not deny that those limitations added by Examiner amendment create two equally possible antecedent bases for “the request.” PO does not deny that the Director has found that Examiner error can trump *Fintiv* based on the Director’s holistic assessment of the evidence presented. PO does not deny that its owners were well-aware that the ’296 patent would be subject to IPR when it was recently acquired, and ignores the showing in Petitioner’s Opposition that PO’s “patent bargain presumption” argument has been rejected by Supreme Court and Federal Circuit precedent. Instead, PO makes legally flawed arguments and baseless attacks in furtherance of its desperate plea to avoid IPR. PO’s request should be denied for these and other reasons discussed below.

I. THE DIRECTOR HAS REJECTED PO’S MATERIAL ERROR ARGUMENT

Rather than demonstrate that the examiner did not make a material error, PO argues that the Director should ignore the Examiner’s material error in failing to recognize that Gupta discloses the very limitations added to overcome a rejection over Gupta. Paper 9 (“Reply”), 1-2. That argument has been rejected. Recently, the Director rejected a discretionary denial request due to an Examiner error based on a Kishi reference that was not the basis of the Petition’s grounds. *Compare*

Western Digital Tech., Inc. v. Godo Kaisha IP Bridge 1, IPR2025-00701, Paper 9 (Director Aug. 14, 2025), *with Western Digital Tech., Inc.*, Paper 8, 2 (arguing examiner error based on Kishi reference). The Director made this denial over PO’s objection that Kishi was not a basis for a challenge in the petition. *Id.*, Paper 6, 64 (“what Kishi allegedly shows is irrelevant to the grounds. The Petition only relies on Soukup....”).

PO’s allegation that petitioner “falsifies the file history” defies comprehension and common sense. Reply, 2. The file history (EX1003) plainly shows that there was no notice of allowance (“NOA”) before the Examiner’s Amendment. Moreover, as anyone who has ever prosecuted a patent application would understand, the NOA was conditioned on acceptance of the Examiner’s amendments. *Compare* EX1003 at 44 (PO “solicit[ing]” a NOA after September amendments), *with id.* at 24-25 (Examiner’s “reasons for allowance” predicated on *newly* added elements, e.g., “storing a record....”). In any event, PO’s allegation is irrelevant—the Examiner erred by failing to recognize that the limitations added by the Examiner were disclosed in Gupta, and that error should be fixed by the Office.

II. THAT THE PTAB’S IS BETTER EQUIPPED TO EVALUATE THESE CONFUSING CLAIMS FAVORS INSTITUTION

PO does not dispute that the Examiner’s amendment renders these claims potentially indefinite as well as confusing and convoluted. Paper 7, 6-10. Instead, PO argues that this is not a statutory ground for determining whether a Petitioner

may prevail under §314(a) and that “discretionary denial *for any basis other than as authorized in 35 U.S.C. § 314(a)* is unauthorized.” Reply, 2. This argument is meritless. While §314(a) may preclude the Director from declining to institute a meritorious petition, *see* Paper 7, 16, nothing in §314(a) precludes the Director from *declining* a request for discretionary denial for any reason.

The potential indefiniteness of the claims caused by the Examiner’s amendment is no bar to institution. The Federal Circuit has held that the PTAB is sanctioned to resolve patentability challenges despite (potential) indefiniteness of claims. *Intel Corp. v Qualcomm Inc.*, 21 F. 4th 801, 803 (Fed. Cir. 2021). Here, the Petition squarely addresses both possible interpretations of “the request” such that the PTAB is definitely able to resolve the patentability challenge despite the indefiniteness of claims.

Moreover, the Director has repeatedly declined to discretionarily deny petitions due to circumstances that implicate the PTAB’s superior capability to evaluate unpatentability challenges. For example, where a PO asserts a large number of claims at the district court, the Director has repeatedly declined to discretionarily deny a petition because the PTAB is “better suited to review a large number of patents involving diverse subject matter.” *Tesla, Inc. v. Intellectual Ventures II*, IPR2025-01076, Paper 9 at 2-3 (Director June 13, 2025); *Shenzhen Tuozhu Tech. Co. v. Stratasy, Inc.*, IPR2025-00438, Paper 10 at 3 (Director July

17, 2025). Here, the PTAB is better suited to review these confusing and convoluted claims asserted by the PO, and PO does not contend otherwise. This is another sound reason to deny PO's request for discretionary denial.

III. THE DIRECTOR HAS DETERMINED THAT MATERIAL ERROR TRUMPS FINTIV

PO does not dispute that the Director has rejected requests for discretionary denial when a material error by the examiner has occurred. *Microsoft Corp. v. Partec Cluster Competence Center GmbH*, IPR 2025-00318, Paper 9 (PTAB June 12, 2025); *Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9 (PTAB July 31, 2025). As discussed above, PO does not dispute that the examiner has made multiple material errors here, and those material errors are properly considered here. Contrary to PO's argument (Reply, 3), Petitioner's broad *Sotera-plus* stipulation is a further reason to deny PO's request for discretionary denial. *Shenzen*, Paper 10 at 3.

IV. PO'S SETTLED EXPECTATIONS ARGUMENTS FAIL

PO re-alleges that HD should have somehow known about the patent because of a recent prior suit against Samsung that resolved shortly after it was filed. Reply, 4-5. PO's allegation is out of touch with business reality—there is no practical way that a suit against Samsung regarding devices Home Depot does not sell would reasonably provide notice to Home Depot. Samsung is not considered a Home Depot competitor, and PO was unable to point to any evidence to the

contrary except attorney argument. Here, PO gave no actual or constructive notice of its allegations to Petitioner, and the Director has held that settled expectations are intimately tied to “Petitioner’s *awareness* of Patent Owner’s applications and failure to seek early review.” *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (Director June 6, 2025).

PO again raises its “patent bargain presumption against retroactive legislation” argument, alleging that the Opposition “evades” it. Reply, 5. But PO fails to acknowledge the contrary *Calder, Celgene* and *Genentech* Supreme Court and Federal Circuit authority cited by Petitioner. Paper 7, 15. Thus, far from evading this argument, the Opposition tackles it head-on by demonstrating that there is no reasonable basis for it because it is contrary to this precedent. *Landgraf v. Usi Film Prods.*, 511 U.S. 244, 268 (1994) (stating presumption against retroactive legislation is overcome “where Congress first make[s] its intention clear” that legislation applies retroactively) and Leahy-Smith America Invents Act §6(c)(2)(A), 125 Stat. at 304 (“The amendments made by subsection (a) ... *shall apply to any patent issued before, on, or after [AIA’s] effective date.*” (emphasis added)) are further evidence that there is no reasonable basis for this argument.

V. CONCLUSION

PO’s request for discretionary denial should be rejected for the reasons discussed above and in Petitioner’s Opposition.

Date: August 26, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) that on August 26, 2025 a true and correct copy of this brief and any new exhibits was served by emailing a copy of same to the following:

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