

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD. and SAMSUNG ELECTRONICS
AMERICA, INC.,

Petitioners

v.

MOBILE DATA TECHNOLOGIES LLC,

Patent Owner

IPR2025-00535
U.S. Patent No. 9,032,039

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	The Board Should Exercise Its Discretion to Deny Institution of the Parallel, Lower-Ranked ‘535 IPR Asserting Neibauer Grounds	4
III.	Discretionary Denial under <i>General Plastic</i> Framework.....	12
	A. Factor 1: Relationship Between Petitioner and Meta	13
	B. Factor 2: Whether Petitioners knew about Neibauer Grounds at the time of Meta filed the Meta-MDT-IPRs	15
	C. Factor 3: Availability of Information from Meta-MDT-IPRs	15
	D. Factors 4 and 5: Petitioners’ Delay in Filing the Follow-On Petitions.....	16
	E. Factors 6 and 7: Board Resources and Statutory Deadlines.....	18
IV.	Discretionary Denial under <i>Advanced Bionics</i> Framework	19
	A. Relevant Legal Principles	20
	B. <i>Advanced Bionics</i> Factors (a)-(c).....	22
	1. Neibauer, Cheng, and Squibbs	22
	2. Ausems	25
	3. Bandera.....	27
	4. Harvey	28
V.	The Board Should Exercise Discretionary Denial Under <i>Fintiv</i> Framework.....	29
	A. Factor 1: No stay has been entered in the EDTX-Litigation and there is no evidence that a stay will be granted.	32
	B. Factor 2: The EDTX-Litigation’s Trial Date is Five Months Before the Expected Date of Any Final Written Decision	35

C.	Factor 3: Significant Investment in the Parallel Litigation Will Have Occurred by the Time the Board’s Institution Decision is Due	38
D.	Factor 4: There is Substantial Overlap Between This IPR and the EDTX-Litigation, Rendering Petitioners’ <i>Sotera</i> -style Stipulation Ineffective	41
E.	Factor 5: Petitioners are the Defendants in the EDTX-Litigation	46
F.	Factor 6: Other Circumstances That Impact the Board’s Exercise of Discretion, Including the Merits	46
	1. Settled expectations of the parties, such as the length of time the claims have been in force.	46
	2. Petitioners’ abuse of the IPR process	46
	3. Petitioners’ inconsistent rankings of the Petitions	48
	4. Petitioners’ excessive reliance on expert testimony	48
	5. The ‘535 Petition lacks merit	54
G.	Holistic Assessment of <i>Fintiv</i> Factors and Considerations Weighs in Favor of Denying Institution	61
VI.	CONCLUSION	61

TABLE OF AUTHORITIES

<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,</i> IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020) (precedential)	<i>passim</i>
<i>Apple Inc. v. Fintiv, Inc.,</i> IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential).....	<i>passim</i>
<i>Apple Inc. v. Fintiv, Inc.,</i> IPR2020-00019, Paper 15 (P.T.A.B. May 13, 2020)	46
<i>Arista Networks, Inc. v. Corrigent Corporation,</i> IPR2023-00839, Paper 9 (P.T.A.B. Dec. 7, 2023)	15
<i>Ascend Elements, Inc. v. Duesenfeld GmbH,</i> IPR2024-00948, Paper 10 (P.T.A.B. Nov. 22, 2024).....	15
<i>AT&T Servs. v. ASUS Tech.,</i> IPR2024-00992, Paper 14 (P.T.A.B. Dec. 16, 2024)	40
<i>BabyBjorn, AB v. The Ergo Baby Carrier, Inc.,</i> IPR2025-00111, Paper 19 (P.T.A.B. Apr. 22, 2025)	6
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG,</i> IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017)	21, 25
<i>Chapman v. Casner,</i> 315 Fed.Appx. 294 (Fed. Cir. 2009).....	8
<i>Cisco Systems, Inc. v. C-Cation Techs.,</i> IPR2014-00454, Paper 12 (P.T.A.B. Aug. 29, 2014) (informative)	53
<i>Comcast Cable Communications LLC v. Entropic Communications LLC,</i> IPR2025-00181, Paper 8 (P.T.A.B. Apr. 29, 2025)	11
<i>CyWee Grp. Ltd. v. Samsung Elecs. Co.,</i> No. 17-cv-140, 2019 WL 11023976 (E.D. Tex. Feb. 14, 2019)	32
<i>Dell Inc. et al. v. Universal Connectivity Technologies Inc.,</i> IPR2024-01479, Paper 11 (P.T.A.B. Apr. 7, 2025)	39
<i>Ecto World, LLC and SV3, LLC v. RAI Strategic Holdings, Inc.,</i> IPR2024-01280, Paper 10 (P.T.A.B. Mar. 6, 2025)	9

<i>EndyMed Medical Ltd. v. Serendia, LLC</i> , IPR2024-00843, Paper 14 (PTAB Jan. 10, 2025)	10
<i>E-One, Inc. v. Oshkosh Corp.</i> , IPR2019-00161, Paper 16 (P.T.A.B. May 15, 2019)	30
<i>Ericsson Inc. v. Uniloc 2017, LLC</i> , IPR2019-01550, Paper 8 (P.T.A.B. Mar. 17, 2020)	14, 15
<i>General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017).....	<i>passim</i>
<i>In re Cavanagh</i> , 58 C.C.P.A. 856, 436 F.2d 491 (CCPA 1971)	8
<i>Intel Corp. v. Interdigital, Inc.</i> , IPR2024-01441, Paper 13 (P.T.A.B. Apr. 1, 2025)	26
<i>Lenovo Inc. et al. v. Universal Connectivity Technologies Inc.</i> , IPR2024-01479, Paper 17 (P.T.A.B. Apr. 17, 2025)	39
<i>Masimo Corp. v. Apple Inc.</i> , IPR2024-00071, Paper 7 (P.T.A.B. Apr. 25, 2024)	9
<i>Medacta USA, Inc. v. RSB Spine, LLC</i> , IPR2020-00275, Paper 22 (P.T.A.B. May 22, 2020)	6
<i>Meta Platforms, Inc. v. Mobile Data Techs., LLC</i> , IPR2024-00248 (P.T.A.B. 2023).....	2
<i>Microsoft Corp. v. D3D Techs.</i> , IPR2021-00877, Paper 14 (P.T.A.B. Dec. 2, 2021)	6
<i>Motorola Solutions, Inc. v. Stellar LLC</i> , IPR2024-01205, Paper 19 (P.T.A.B. Mar. 28, 2025).....	31
<i>MyPort, Inc. v. Samsung Electronics Co., Ltd., et al.</i> , No. 2:22-cv-00114-JRG, Dkt. No. 73 (E.D. Tex. June 12, 2023).....	35
<i>NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.</i> , IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018) (precedential)	30

<i>Nokia Of America Corp v. Pegasus Wireless Innovation LLC</i> , IPR2025-00036, Paper 14 (P.T.A.B. Apr. 25, 2025)	54
<i>Nokia of America Corp. v. Alexander Soto and Walter Soto</i> , IPR2023-00680, Paper 18 (P.T.A.B. Mar. 4, 2024) (Director Review).....	22
<i>Pfenex Inc. v. GlaxoSmithKline Biologicals SA</i> , IPR2019-01478, Paper 9 (P.T.A.B. Feb. 10, 2020)	17, 19
<i>Saint Lawrence Commc'ns LLC v. ZTE Corp.</i> , No. 2:15-CV-349-JRG, 2:15-CV-351-JRG, 2017 WL 3396399 (E.D. Tex. Jan. 17, 2017).....	34
<i>Samsung Elecs. Co. Ltd. v. Clear Imaging Research, LLC</i> , IPR2020-01552, Paper 12 (P.T.A.B. Mar. 3, 2021)	33
<i>Samsung Elecs. Co. Ltd. v. Evolved Wireless LLC</i> , IPR2021-00950, Paper 10 (P.T.A.B. Nov. 29, 2021).....	32
<i>SAP America v. Cyandia, Inc.</i> , IPR2024-01496, Paper 13 (P.T.A.B. Apr. 7, 2025)	38, 45
<i>SIBIA Neurosciences, Inc. v. Cadus Pharma. Corp.</i> , 225 F.3d 1349 (Fed. Cir. 2000)	8
<i>Solus Advanced Materials Co., Ltd. v. SK nexilis Co.</i> , IPR2024-01460, Paper 14 (P.T.A.B. Apr. 22, 2025)	40
<i>Tessera Advanced Technologies, Inc. v. Samsung Electronics Co., Ltd.</i> , No. 2:17-cv-00671-JRG, 2018 WL 3472700 (E.D. Tex. July 19, 2018).....	34
<i>TMobile USA, Inc., et al. v. Wireless Alliance</i> , IPR2024-00608, Paper 16 (P.T.A.B. Sept. 3, 2024).....	36, 38
<i>TomTom, Inc. v. Blackbird Tech, LLC</i> , IPR2017-02025, Paper 7 (P.T.A.B. Mar. 12, 2018).....	18
<i>Trover Group, Inc. v. Dedicated Micros USA</i> , No. 2:13-cv-1047WCB, 2015 WL 1069179 (E.D. Tex. Mar. 11, 2015)	32
<i>Valve Corp. v. Electronic Scripting Products, Inc.</i> , IPR2019-00062, Paper 11 (P.T.A.B. Apr. 2, 2019) (precedential)	12, 13

<i>Volkswagen Group of America, Inc. v. Neo Wireless LLC</i> , IPR2022-01567, Paper 8 (P.T.A.B. May 3, 2023)	15
---	----

<i>Xilinx, Inc. v. Arbor Glob. Strategies, LLC</i> , IPR2020-01568, Paper 12 (P.T.A.B. Mar. 5, 2021)	15
---	----

Statutes

35 U.S.C. § 102	44
35 U.S.C. § 282	46
35 U.S.C. § 314	4, 18, 30, 31
35 U.S.C. § 316	12, 18
35 U.S.C. § 325	20, 30, 61

Other Authorities

<i>Consolidated Trial Practice Guide</i> , U.S. Patent & Trademark Office (2019)	<i>passim</i>
Guidance on USPTO’s Recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” U.S. Patent & Trademark Office (Mar. 24, 2025)	31, 37, 54
Interim Processes for PTAB Workload Management, U.S. Patent & Trademark Office (Mar. 26, 2025)	11, 31, 46

Regulations

37 C.F.R. § 11.303	20
37 C.F.R. § 122	10, 47
37 C.F.R. § 42.100	36
37 C.F.R. § 42.122	17
37 C.F.R. § 42.6	53

EXHIBIT LIST

Ex.	Description
2001	E-mail serving amended infringement contentions in EDTX-Litigation
2002	Comparison between the specifications of the ‘039 and ‘801 Patents
2003	Petition for <i>Inter Partes</i> Review in IPR2025-00536 (Jan. 31, 2025)
2004	Federal Register / Vol. 89, No. 77 / Friday, April 19, 2024 / Proposed Rules (Pages 28693-28706)
2005	Return of Service filed in the EDTX-Litigation (June 21, 2024)
2006	E-mail from the Board regarding the 535 and 536 IPR panel assignments (May 2, 2025)
2007	Decision Granting Institution of <i>Inter Partes</i> Review in IPR2024-00248 (June 11, 2024)
2008	E-mail from Erick S. Robinson memorializing the phone conversation with Petitioners’ counsel (September 26, 2024)
2009	Comparison of independent claims of the ‘039 and ‘5801 Patents
2010	U.S. Patent No. 6,594,347 (“Calder”)
2011	Examples of verbatim copy-pasting from Meta-MDT-IPRs by Petitioners
2012	U.S. Patent Application No. 2005/0177645 A1 (“Dowling”)
2013	E-mail exchange between Erick S. Robinson and Petitioners’ counsel regarding a stay (October 17, 2024)
2014	E-mail exchange between Erick S. Robinson and Petitioners’ counsel regarding a stay (February 19, 2025)
2015	E-mail exchange between Erick S. Robinson and Petitioners’ counsel wherein Petitioners shared their motion to stay with Patent Owner (March 4, 2025)
2016	Second Amended Docket Control Order in the EDTX-Litigation (December 19, 2024)
2017	United States District Courts — National Judicial Caseload Profile (September 30, 2024)
2018	E-mail from Petitioners’ counsel serving their initial and additional disclosures (October 16, 2024)
2019	E-mail from Petitioners’ counsel serving their invalidity contentions (January 31, 2025)
2020	E-mail from Petitioners providing materials produced by third-party Microsoft Corporation and Sybase, Inc. in response to Petitioners’ subpoena in the EDTX-Litigation (April 25, 2025)

Ex.	Description
2021	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (March 7, 2025)
2022	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 24, 2025)
2023	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 21, 2025)
2024	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 11, 2025)
2025	E-mail from Petitioners providing materials produced by third-party AT&T Mobility LLC in response to Petitioners' subpoena in the EDTX-Litigation (February 5, 2025)
2026	Patent Owner's Infringement Contentions in the EDTX-Litigation (September 4, 2024)
2027	Petitioners' Invalidity Contentions in the EDTX-Litigation (January 31, 2025)
2028	E-mail exchange between Homayoon Rafatijo and Petitioners' counsel regarding Petitioners' contacting the Board for filing their proposed <i>Sotera</i> stipulation (April 21-23, 2025)
2029	E-mail from Petitioners' counsel with a draft of a proposed communication to the Board (April 30, 2025)
2030	E-mail from Petitioners' counsel with sharing with Patent Owner their proposed <i>Sotera</i> stipulation (April 18, 2025)
2031	Reserved
2032	Petitioners' proposed <i>Sotera</i> stipulation for '535 and '536 IPRs (April 18, 2025)
2033	Petitioners' claim chart against '039 Patent based on the Yahoo! System art (January 31, 2025)
2034	Petition for <i>Inter Partes</i> Review in IPR2024-00248 (Dec. 6, 2023)
2035	Summary of verbatim (or nearly verbatim, strikethrough added) matches between the '535 petition to the Houh Declaration (Ex.1002)

I. INTRODUCTION

On June 10, 2024, Mobile Data Technologies LLC (“Patent Owner”) filed a patent infringement complaint (the “Complaint”) against Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioners”) in the United States District Court for the Eastern District of Texas. *Mobile Data Technologies LLC v. Samsung Electronics Co. Ltd. et al.*, 2:24-cv-00435-JRG-RSP (E.D. Tex.) (“EDTX-Litigation”). In the Complaint, Patent Owner asserted four patents: U.S. Patent Nos. 8,825,801 (“the ‘801 Patent”), 9,032,039 (“the ‘039 Patent”), 9,619,578 (“the ‘578 Patent”), 9,922,348 (“the ‘348 Patent”). Patent Owner served its infringement contentions on September 4, 2024, for these patents. On October 6, 2024, Patent Owner filed an Amended Complaint, adding U.S. Patent No. 8,793,336 (“the ‘336 Patent”) to the EDTX-Litigation. On the same day, Patent Owner served its amended infringement contentions in which “[n]othing else was added other than a chart for the asserted claims of the ‘336 [Patent] and the file history for the ‘336 [Patent].” Ex.2001. In this proceeding, Patent Owner refers to the five patents asserted in the EDTX-Litigation as the “Asserted Patents.” As shown in Figure 1 below, the Asserted Patents arise from a common family and share nearly identical specifications. *See, e.g.*, Ex.2002 (comparing specifications of the ‘039 and ‘801 Patents).

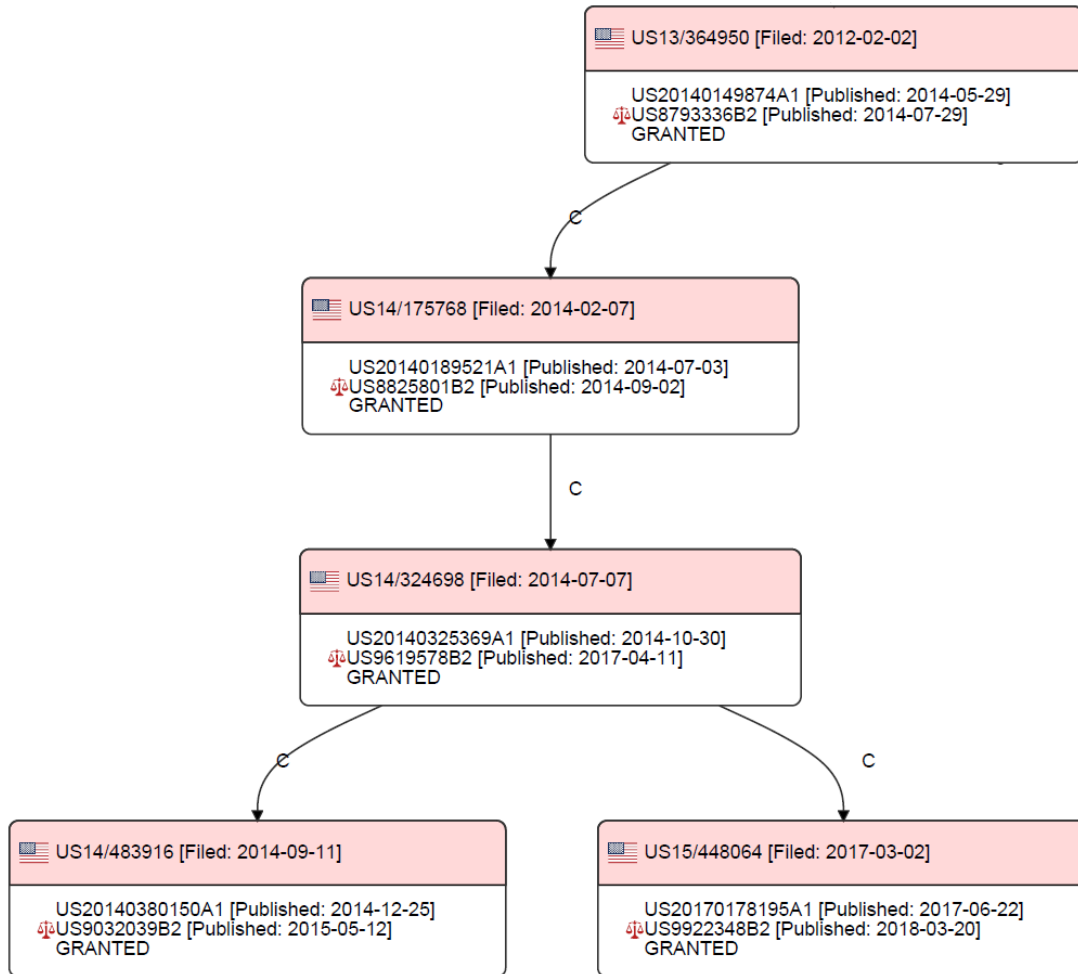


Figure 1. Family tree for the Asserted Patents.

Nearly eight months into the EDTX-Litigation, and after the service of both invalidity and infringement contentions, Petitioners filed *ten* IPR petitions—two against each Asserted Patent—on what they characterize as “mutually exclusive grounds.” The first set simply asserts the Neibauer-based combinations (“Neibauer Grounds”) that Meta Platforms, Inc. (“Meta”) advanced in *Meta Platforms, Inc. v. Mobile Data Techs., LLC*, IPR2024-00248 (P.T.A.B. 2023) (“Meta-MDT-IPRs”), a proceeding since settled. Petitioners concede that this first set rests on “common

references and arguments” recycled from the Meta-MDT-IPRs. Paper 3 at 4. However, characterizing them as merely “common references and arguments” is far too generous: Petitioners have copied the Meta-MDT-IPRs petition word-for-word and dropped it into the ‘535 Petition, substituting little more than the caption. *See* Ex.2011 (providing examples of verbatim copy-pasting from the Meta-MDT-IPR Petition). The second set asserts invalidity grounds based on Randall-Forsyth and Pelkey-Eck claim combinations (collectively, the “Original Grounds”). Yet Petitioners advance identical claim construction positions in both the Original Grounds and the Neibauer Grounds—Petitioners’ proposed constructions appear verbatim in each petition. *See infra* Table 1.

For four independent reasons, the Board should exercise its discretion to deny institution of the ‘535 IPR:

1. Petitioners have failed to provide any adequate justification for its parallel petitions and thus under the *Consolidated Trial Practice Guide* (“CTPG”), the ‘535 Petition, which is “lower-ranked,” should be discretionarily denied.

2. Under the *General Plastic* factors, Petitioners’ serial petitions on the same patents as in the Meta-MDT-IPRs should be denied.

3. Under *Advanced Bionics*, the art asserted in the ‘535 Petition was before the Examiner during examination of the ‘039 Patent, and Petitioners have made no demonstration that the Office erred in a manner material to the patentability of the

challenged claims.

4. The *Fintiv* factors weigh heavily in favor of denial. The EDTX-Litigation is proceeding on a schedule for an April 2026 jury trial—five months before any *inter partes* review (“IPR”) would conclude between Petitioners and Patent Owner, even if the Board were to institute. In addition, there is substantial overlap between the ‘535 IPR Petition and the EDTX-Litigation as Petitioner relies on system art in the EDTX-Litigation that corresponds to the references relied upon in the Petition. Furthermore, the Petition relies excessively on expert testimony and lacks merit, as demonstrated below.

Accordingly, the Board should exercise its discretion and deny institution of the Petition.

II. The Board Should Exercise Its Discretion to Deny Institution of the Parallel, Lower-Ranked ‘535 IPR Asserting Neibauer Grounds

The CTPG makes clear that multiple petitions against the same patent “should be rare,” as parallel filings “place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” CTPG at 59. Pursuant to 35 U.S.C. § 314(a), the Board exercises exclusive discretion to decide whether parallel petitions should proceed to institution. *Id.* at 61. The CTPG acknowledges only limited circumstances that may justify more than one petition—such as an unusually large number of asserted claims in litigation or a contested priority date requiring multiple prior art references. *Id.* at 59. None of those

circumstances is present here, and Petitioners do not contend otherwise.¹

Petitioners attempt to justify their parallel petitions (‘535 and ‘536 IPRs) by pointing to a single factor from the April 19, 2024 *Notice of Proposed Rulemaking on Instituting Parallel and Serial Petitions*: “alternative claim constructions that require different prior art references on mutually exclusive grounds.” Paper 3 at 2. Yet, they admit that Patent Owner’s construction for “mobile device”² in the Meta-MDT-IPRs is only a “narrow[er] construction” compared to that advanced in the district court litigation between MDT and Meta (“MDT-Meta-Litigation”)—not an “alternative construction.” *Id.* at 4. Accordingly, Petitioners themselves do not characterize the MDT-Meta-Litigation and Meta-MDT-IPRs constructions as “alternative claim constructions.” *See id.*

Petitioners contend that because “no final decision has been made regarding claim construction” in the Meta-MDT-IPRs, filing two petitions was necessary to

¹ In Petitioners’ Notice of Ranking, they cited only “alternative claim constructions” to support their filing parallel petitions. Paper 3 at 2-3. Petitioners cannot add any other justifications for filing parallel petitions now. *See* CTPG at 59-60.

² Petitioners do not list any other claim terms to justify filing parallel petitions. Paper 3 at 2-4. Petitioners are time-barred to rely on any other claim terms to justify filling parallel petitions now. *See* CTPG at 59-60.

address Patent Owner’s narrower construction in the Meta-MDT-IPRs. *Id.* But as Table 1 below shows, Petitioners adopt the MDT-Meta-Litigation constructions in *both* ‘535 and ‘536 IPRs, and thus Petitioners’ alleged justification fails. *See BabyBjorn, AB v. The Ergo Baby Carrier, Inc.*, IPR2025-00111, Paper 19, 11-13 n.11 (P.T.A.B. Apr. 22, 2025) (holding that a second-ranked petition is unnecessary when petitioner addresses the same construction in both petitions); *see also Medacta USA, Inc. v. RSB Spine, LLC*, IPR2020-00275, Paper 22, 10-11 (P.T.A.B. May 22, 2020). Furthermore, Petitioners could have sought claim constructions within one petition instead of filing two petitions. *Microsoft Corp. v. D3D Techs.*, IPR2021-00877, Paper 14, 9 (P.T.A.B. Dec. 2, 2021) (“[N]othing prevented Petitioners from seeking claim constructions” within a single petition).

Table 1: Petitioners’ proposed constructions for claim terms in ‘535 and ‘536 Petitions are identical.

Term	‘535 IPR Construction	‘536 IPR Construction
Mobile Device	“Petitioners apply the plain meaning which is consistent with Meta’s Meta-MDT-IPR and MDT-Meta-Litigation constructions.” Petition at 5.	“Petitioners apply the plain meaning which is consistent with Meta’s Meta-MDT-IPR and MDT-Meta-Litigation constructions.” Ex.2003 at 6.
Application-Based Information Channel	“Petitioners do not believe this term requires construction here.” Petition at 6.	“Petitioners do not believe this term requires construction here.” Ex.2003 at 7.
Wireless Network Limitations	“While Petitioners dispute PO’s construction, construction of the term is not needed because the prior art discloses this term under both constructions.” Petition at 6-7.	“While Petitioners dispute PO’s construction, construction of the term is not needed because the prior art discloses this term under both constructions.” Ex.2003 at 7.

It is remarkable that Petitioners invoke Patent Owner's allegedly different construction to justify parallel petitions while themselves relying on identical constructions throughout both petitions. Because Petitioners apply identical claim construction in both the Neibauer Grounds and the Original Grounds, their claim of "different" constructions merely masks an effort to dodge the 14,000-word limit and pack extra unpatentability grounds into multiple petitions. Two petitions are not necessary.

In addition, to the extent that Petitioners' citation to the Notice of Rulemaking factor may imply that the proposed claim constructions in the Meta-MDT-IPRs and MDT-Meta-Litigation are "alternative claim constructions," Petitioners' characterization is disingenuous. As Petitioners themselves admit, these constructions are not alternatives at all; they have a genus-species relationship. Patent Owner argued in the MDT-Meta-Litigation that "no construction [is] required" for "mobile device," but, "[i]f the Court requires a construction, 'a piece of handheld equipment.'" Ex.1025 at 3. In the Meta-MDT-IPRs, Patent Owner proposed "a portable device with limited display space and limited navigational capabilities that connects to a mobile site and/or mobile channel via a wireless

network.”³ Ex.1030 at 9. The Meta-MDT-IPRs construction is consistent with and merely narrows the formulation in the MDT-Meta-Litigation; any device that meets the narrower definition necessarily falls within the broader one. Petitioners themselves acknowledge that the Meta-MDT-IPRs construction is “narrow[er]” than, not inconsistent with, the MDT-Meta-Litigation constructions. Paper 3 at 4. Even assuming the Meta-MDT-IPRs and MDT-Meta-Litigation constructions are genuinely alternatives, which they are not, there is no need for “different prior art references.” *Id.* at 2-3. Any prior art combination that allegedly renders the claims unpatentable under the narrower construction (i.e., Meta-MDT-IPRs construction) also renders them unpatentable under the broader construction (i.e., MDT-Meta-Litigation construction). *See In re Cavanagh*, 58 C.C.P.A. 856, 436 F.2d 491, 496 (CCPA 1971) (“[I]f appellant’s narrow claims are obvious in view of the prior art, so are his broad claims.”); *Chapman v. Casner*, 315 Fed.Appx. 294, 297-298 (Fed.Cir.2009) (“[C]laims directed to the genus ... can be anticipated or rendered obvious by references disclosing the species.”); *SIBIA Neurosciences, Inc. v. Cadus Pharma. Corp.*, 225 F.3d 1349, 1355 (Fed.Cir.2000) (holding that when claims are

³ Patent Owner explained its bases for this construction thoroughly in its Meta-MDT-IPRs Response. Ex.1030 at 9-15. That said, the Board does not need to construe any term for Discretionary Denial purposes.

invalid under a narrow construction of a term, it is not necessary to determine whether they are invalid under a broader construction). Accordingly, the ‘535 IPR asserting Neibauer Grounds—predicated on the broader construction—is redundant.

Furthermore, Petitioners’ sole basis for filing two petitions is one factor from a list of nine factors enumerated in the April 19, 2024 Notice of Proposed Rulemaking on “Instituting Parallel and Serial Petitions.” Paper 3 at 2. But a Notice of Proposed Rulemaking is exactly that—a proposal. It has not been adopted by the Director and therefore is not binding. Even if it had been adopted, Petitioners ignore eight of the Notice’s nine enumerated factors, including whether “there is a dispute about the priority date,” whether Petitioners “lacked information ... at the time they filed the petitions,” or whether “[t]he complexity of the technology” demands separate petitions. Ex.2004 at 12, col. 3. Petitioners ask the Board to elevate a single, non-binding consideration over a “holistic view of the totality of the circumstances presented”—an approach embraced by the Board in decisions involving exercise of discretion. *See, e.g., Ecto World, LLC and SV3, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 10 (P.T.A.B. Mar. 6, 2025) (adopting the holistic view approach in *Advanced Bionics* context); *Masimo Corp. v. Apple Inc.*, IPR2024-00071, Paper 7 (P.T.A.B. Apr. 25, 2024) (adopting the same in *General Plastic* context).

Moreover, Petitioners do not explain why they bypassed the obvious route—

filing a joinder motion by July 11, 2024,⁴ under 37 C.F.R. § 122(b)—to join the Meta-MDT-IPRs, which rested on the same Neibauer Grounds that Petitioners now re-assert with “common references and arguments.” Paper 3 at 4. A prompt joinder would have cast Petitioners as understudy should MDT and Meta settle, conserved the Board’s finite resources, and satisfied the Board’s preference for joinder where, like in this case, no new issues arise. *See EndyMed Medical Ltd. v. Serendia, LLC*, IPR2024-00843, Paper 14, 12 (P.T.A.B. Jan. 10, 2025) (“[T]here is a policy preference for joining a later petitioner if their petition does not present new issues that might complicate or delay an existing proceeding.”).

Finally, Petitioners contend that the “burden on the Board and PO in instituting” the ‘535 IPR is “minimal” because it relies on “common references and argument.” Paper 3 at 4. Untenable. The burden may indeed be trivial for Petitioners—they have merely copy-pasted the Meta-MDT-IPR on the ‘039 Patent into the present Petition (*see* Ex.2011)—but it is anything but minimal for everyone else. Patent Owner must craft a full response and retain a new expert due to a conflict with Petitioners, while the Board must devote substantial resources to preside over

⁴ Petitioners were served with the Complaint in the EDTX on June 17, 2024, and thus Petitioners were aware of the Asserted Patents and the Meta-MDT-IPRs at least by June 17, 2024. *See* Ex.2005.

yet potentially two trials on the same ‘039 Patent.

As explained above, Petitioners do not point to any reasonable basis to file parallel petitions, and thus Petitioners should have put their best foot forward in a single petition. Here Petitioners rank the ‘535 IPR lower than the ‘536 IPR. Paper 3 at 2. Accordingly, the Board should exercise its absolute discretion and deny institution of the ‘535 IPR. Considering “the ability of the PTAB to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AIA proceedings, and other workload needs” (*see* the March 26, 2025 Memorandum titled, “Interim Processes for PTAB Workload Management” (the “March 26, 2025 Memo”) at 2-3), exercising absolute discretion to deny institution of lower-ranked petitions in cases like this where there is no reason to file parallel petitions is prudent. Notably, as of May 4, 2025—over three months after filing the ‘535 IPR—Petitioners’ IPR petitions “are not yet paneled.” Ex.2006. This indicates the Board’s demanding workload. Exercising absolute discretion to deny the lower-ranked ‘535 IPR will “maintain PTAB capacity to conduct AIA proceedings.” March 26, 2025 Memo at 2-3. Accordingly, the Board need not further consider *Fintiv*, *General Plastic*, and *Advanced Bionics* frameworks in the interest of preserving its administrative resources. *See, e.g., Comcast Cable Communications LLC v. Entropic Communications LLC*, IPR2025-00181, Paper 8 (P.T.A.B. Apr. 29, 2025).

III. Discretionary Denial under *General Plastic* Framework

The Board should deny the ‘535 IPR under *General Plastic*, which provided a seven-factor analysis addressing serial IPR petitions challenging the same patents. The seven *General Plastic* factors are: (1) whether the same petitioner previously filed a petition directed to the same claims of the same patent; (2) whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it; (3) whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition; (4) the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition; (5) whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent; (6) the finite resources of the Board; and (7) the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than one year after the date on which the Director notices institution of review. *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017).

Although *General Plastic* addressed serial petitions by a single petitioner, the Board’s precedential decision in *Valve Corp. v. Electronic Scripting Products, Inc.*

expressly expanded the scope of *General Plastic*'s applicability to situations involving multiple petitioners, such as here:

[O]ur application of the *General Plastic* factors is not limited solely to instances when multiple petitions are filed by the same petitioner. Rather, when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General Plastic* factors.

IPR2019-00062, Paper 11, 9 (P.T.A.B. Apr. 2, 2019) (precedential).⁵

A. Factor 1: Relationship Between Petitioner and Meta

The applicability of *Valve* is not limited to instances where petitioners have a specific type of relationship (e.g., business or co-defendants relationship): the Board should consider “any relationship” between them. *Id.* The CTPG confirms this understanding: “[w]hen different petitioners challenge the same patent, the Board considers the relationship, if any, between those petitioners when weighing the *General Plastic* factors.” CTPG at 57 n.1. A relationship between two petitioners can be “implicitly created” by virtue of the second petitioner’s relying on the first petitioner’s work product:

We agree that, absent this petition, no such relationship, on the record before us, existed. We determine, however, that Petitioner implicitly created such a relationship by using the prior petitioners’ work as a menu and picking and choosing from their work product. The instant Petitioner’s decision to use the prior petitions as a roadmap for its own petition ties the interests of all of the petitioners together.

⁵ All emphases are added unless otherwise stated.

Ericsson Inc. v. Uniloc 2017, LLC, IPR2019-01550, Paper 8 at 12 (P.T.A.B. Mar. 17, 2020).

Petitioners here have used the Meta-MDT-IPRs not merely as a roadmap but as a source document for their carbon-copy ‘535 Petition (*see* Ex.2011), and thus implicitly created a relationship between Petitioners and Meta under *Ericsson*. Petitioners concede that, in the ‘535 IPR, they advance the very same “common references and arguments” Meta deployed in the Meta-MDT-IPRs. Paper 3 at 4. And the Petition confirms the borrowing at every turn. The prior art references and combinations mirror Meta’s. *Id.* The claim construction positions replicate Meta’s. Petition at 5-7. Finally, with the benefit of hindsight, Petitioners add a remedial layer. “Petitioners have also provided separate Grounds 34 below, adding the Harvey reference (EX1010) to address Meta’s proposed construction of application-based information channel, *in the event it is adopted for purposes of this IPR and the prior art for Grounds 12 is somehow found insufficient on this point.*” Petition at 2223; *see also* Petition at 67.

Further underscoring their relationship, Petitioners rely on the declaration of Meta’s expert, Dr. Hall-Ellis, and Meta’s Reply from the Meta-MDT-IPRs, and indeed file them as Exhibits (*See* Exs.1026 and 1033), thus tying their interest so completely to Meta’s that the ‘535 IPR reads like an annotated reissue of the Meta-

MDT-IPRs.⁶

This factor weighs in favor of exercising discretion to deny institution.

B. Factor 2: Whether Petitioners knew about Neibauer Grounds at the time of Meta filed the Meta-MDT-IPRs

This factor is neutral, because Meta filed the Meta-MDT-IPRs before the Complaint was filed against Petitioners. However, as described above, Petitioners could have joined the Meta-MDT-IPRs after they were served with the Complaint in the EDTX-Litigation against Petitioners.

C. Factor 3: Availability of Information from Meta-MDT-IPRs

This factor addresses “whether at the time of filing of the second petition, the

⁶ In the Board’s prior refusals to invoke *Ericsson*, petitioner—unlike here—advanced its own grounds and arguments and did not recycle arguments from another petitioner. *See, e.g., Ascend Elements, Inc. v. Duesenfeld GmbH*, IPR2024-00948, Paper 10, 32-33 (P.T.A.B. Nov. 22, 2024) (emphasizing petitioner’s reliance “mostly on prior art not asserted in [the prior IPR]”); *Arista Networks, Inc. v. Corrigent Corporation*, IPR2023-00839, Paper 9, 10 (P.T.A.B. Dec. 7, 2023) (same); *Volkswagen Group of America, Inc. v. Neo Wireless LLC*, IPR2022-01567, Paper 8, 18 (P.T.A.B. May 3, 2023) (“Petitioner here does not rely on prior art ‘pick[ed] and cho[sen]’ from any earlier petitions.”); *Xilinx, Inc. v. Arbor Glob. Strategies, LLC*, IPR2020-01568, Paper 12, 10-11 (P.T.A.B. Mar. 5, 2021).

petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition.” *General Plastic* at 16. This factor is “directed to Petitioner’s potential benefit from receiving and having the opportunity to study Patent Owner’s Preliminary Response ... prior to its filing of follow-on petitions.” *Id.* at 17.

Here, it is undisputed that Petitioners received a benefit from having the opportunity to study Patent Owner’s Response and Preliminary Response in the Meta-MDT-IPRs prior to their filing of follow-on petitions. Petitioners waited eight months after the Meta-MDT-IPRs’ institution decision—a year after Patent Owner filed its Preliminary Response and four months after Patent Owner filed its Response in the Meta-MDT-IPRs—before filing the ’535 IPR. They then used that Response as an exhibit and attempted to rebut Patent Owner’s arguments presented in it. *See* Petition at 34-35 (citing Ex. 1030).

Accordingly, this factor weighs in favor of exercising discretion to deny institution.

D. Factors 4 and 5: Petitioners’ Delay in Filing the Follow-On Petitions

Petitioners were served with the Complaint in the EDTX-Litigation on June 17, 2024—less than one week after the Board instituted trial on the ’039 Patent in the Meta-MDT-IPRs. *See* Exs. 2005 and 2007. Any modicum of diligence would have revealed that the same ’039 Patent was already in an active IPR. Had Petitioners

truly wished to pursue the Neibauer Grounds advanced in the Meta-MDT-IPRs, they could—and should—have sought joinder no later than July 11, 2024, per 37 C.F.R. § 42.122(b). Petitioners offer no explanation for letting that window close. *See Pfenex Inc. v. GlaxoSmithKline Biologicals SA*, IPR2019-01478, Paper 9, 12 (P.T.A.B. Feb. 10, 2020) (“Moreover, if Petitioner was interested in pursuing the same challenge as that presented in the 230 IPR, it could have requested joinder under 37 C.F.R. § 42.122(b). ... That the 230 IPR settled after institution is not an adequate excuse for delay.”).

Even if Petitioners somehow missed the Meta-MDT-IPRs institution decision, the timeline condemns their conduct. Petitioners concede that the ‘535 IPR re-packages the very “common references and arguments” used in the Meta-MDT-IPRs (Paper 3 at 4), yet they waited nearly eight months to file—long after Patent Owner served its Response in the Meta-MDT-IPRs, Patent Owner’s expert sat for deposition, and Meta filed its Reply. Specifically, there is no dispute that Petitioners were aware of the Meta-MDT-IPRs at least as of September 2024 when they reached out to Patent Owner to solicit a stay in the EDTX-Litigation pending the Meta-MDT-IPRs. Ex.2008. Yet, Petitioners failed to file the ‘535 IPR petition until four months later. Such delay is inexcusable; it is simple opportunism masquerading as diligence.

These factors weigh strongly in favor of exercising discretion to deny institution.

E. Factors 6 and 7: Board Resources and Statutory Deadlines

These factors consider efficiency and the limited resources of the Board. *General Plastic* at 16-17, 21 (“multiple, staggered petition filings, ... are an inefficient use of the inter partes review process and the Board's resources”); *see also* CTPG at 55-56 (noting that the Director’s discretion under § 314(a) is informed by 35 U.S.C. § 316(b), which requires “the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter”).

Filing multiple IPR petitions against the same patent—when joinder was readily available—subverts procedural economy and needlessly expends Board resources. In addition, Petitioners have filed two petitions (‘535 and ‘536 IPRs) on the ‘039 Patent. Coordinating two trials on the ‘039 Patent for the two petitions filed against the ‘039 Patent so that all final written decisions issue within the statutory period would impose an unnecessary administrative burden on the Board. Given that Petitioners rank the ‘535 IPR lower, imposing such administrative burden on the Board is not warranted.

Moreover, Petitioners concede that the ‘535 IPR advances the same “common references and arguments” raised in the Meta-MDT-IPRs yet offer no reason they should benefit from the review of the Meta-MDT-IPRs. *See TomTom, Inc. v. Blackbird Tech, LLC*, IPR2017-02025, Paper 7, 15-17 (P.T.A.B. Mar. 12, 2018)

(noting that the Board is “mindful of the potential inequity of parties filing multiple petitions,” where a petitioner has “relie[d] on substantially similar references and analyses” and “[has] not shown sufficiently, how the [asserted] references are different enough to warrant institution”).

Finally, the Board’s decision to institute trial in the Meta-MDT-IPRs based on the same “common references and arguments” (Paper 3 at 4), raised in the ‘535 IPR does not warrant imposing the added burden of a second proceeding on the ‘039 Patent. That inefficiency is heightened here, where Petitioners indicated their preference that the Board “consider the merits of this Petition last.” *Pfenex Inc. v. GlaxoSmithKline Biologicals SA*, IPR2019-01478 Paper 9, 12-13 (P.T.A.B. Feb. 10, 2020).

Accordingly, these factors weigh in favor of discretionary denial.

IV. Discretionary Denial under *Advanced Bionics* Framework

Petitioners knew that Neibauer, Cheng, and Squibbs were already of record before the Examiner during examination of the ‘039 Patent. Indeed, Meta acknowledged this in the Meta-MDT-IPRs. Ex.2034, 3-6. Petitioners, however, disingenuously assure the Board that “no asserted reference is substantially the same

as any art previously presented.”⁷ Petition at 71. Petitioners have thus not met their required duty of candor. 37 C.F.R. § 11.303. As such, the Board should exercise its discretion and deny institution on that basis.

A. Relevant Legal Principles

In determining whether to institute an IPR, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). The Board uses a two-part framework for evaluating arguments under Section 325(d): (1) whether the same or substantially the same art was previously presented to the Office or whether the same or substantially the same arguments were previously presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469,

⁷ Indeed, this misrepresentation is the only material difference between Meta’s petition and the ‘535 IPR Petition. Petitioners clearly used Meta-MDT-IPRs as a roadmap, plucked out passages they like, scratched out bits they do not, all before filing the ‘535 IPR. *See* Ex.2011 (providing numerous examples of verbatim copy-pasting from Meta-MDT-IPRs by Petitioners)

Paper 6, 8 (P.T.A.B. Feb. 13, 2020) (precedential).

When applying this framework, the Board considers the *Becton, Dickinson* factors that address the Board's discretion to deny institution when a petition presents the same or substantially the same prior art or arguments previously presented to the Office during examination, including:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8, 17-18 (P.T.A.B. Dec. 15, 2017) (precedential as to § III.C.5, first paragraph). Factors (a), (b), and (d) relate to whether the same or substantially the same art or arguments were previously presented to the Office during examination, and factors (c), (e), and (f) relate to whether a petitioner demonstrates that the Office erred in a manner material to the patentability of the claims. *Advanced Bionics*, Paper 6 at 9-11. Only if the same or substantially the same art or arguments were previously presented to the Office during examination does the Board then consider whether the petitioner

has demonstrated a material error by the Office. *Id.*

As noted above, Petitioners failed to meet their duty of candor by misrepresenting to the Board that that “no asserted reference is substantially the same as any art previously presented” (Petition at 71), even though Neibauer, Cheng, and Squibbs were made of the record by the Examiner. Petitioners also failed to address the “material error” prong of the *Advanced Bionics* test. As such, the Board should not reward Petitioners by allowing them to address the “material error” in their response to this Discretionary Denial brief. If the Board entertains any such late-presented arguments, Patent Owner respectfully requests the Board allow Patent Owner an opportunity to reply.

B. *Advanced Bionics* Factors (a)-(c)

1. Neibauer, Cheng, and Squibbs

“[T]he first part of the *Advanced Bionics* framework is satisfied if either substantially the same prior art or substantially the same arguments were previously presented to the Office.” *Nokia of America Corp. v. Alexander Soto and Walter Soto*, IPR2023-00680, Paper 18, 4 (P.T.A.B. Mar. 4, 2024) (Director Review) (emphasis in original). “Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Advanced Bionics*, Paper 6 at 7-8.

The application that matured into the ‘039 Patent was filed on September 11, 2014. Ex.1001 at 1. The great-grandparent of the ‘039 Patent is U.S. Patent 8,135,801 (the “‘5801 Patent”). On May 14, 2012, the ‘5801 Patent—with materially different claims and limitations than those of the ‘039 Patent (*see* Ex.2009 (comparing independent claims of the ‘039 and ‘5801 Patents))—was found in an *inter partes* reexamination proceeding to be invalid based on a combination of Neibauer and Cheng. The PTAB affirmed in October 2014. *See* Ex.1024. The Examiner of the ‘039 Patent was the same Examiner of the great-grandparent ‘5801 Patent that was later reexamined, and also *considered that reexamination decision while examining the ‘039 Patent.* Ex.1022, 197 (Examiner IDS containing only three documents related to the reexamination proceeding, including Record of Oral Hearing Before the Patent Trial and Appeal Board in *Facebook, Inc., Requester v. Wireless Ink Corp., Patent Owner*, Appeal 2014-007363, Reexamination Control No. 95/001,989, and Decision of the Patent Trial and Appeal Board in *Facebook, Inc., Requester v. Wireless Ink Corp., Patent Owner*, Appeal No. 2014-007363, Reexamination Control No. 95/001,989). Accordingly, there is no doubt that the Examiner had knowledge of the reexamination proceeding and its use of Neibauer and Cheng.

Furthermore, the Examiner evaluated Neibauer, Cheng, and Squibbs during examination of the ‘039 Patent. Indeed, each of these references appear in IDS

forms, as well as on the face of the ‘039 Patent. Ex.1022 at 170, 186, 199, 312. Specifically, the IDS forms note that Examiner must “[i]nitial if reference considered ... or [d]raw line through a citation if ... not considered.” The Examiner initialed the IDS forms without lining through Neibauer, Cheng, and Squibbs. *See, e.g., id.* at 174, 314. The Board should thus decline to institute trial in the ‘535 IPR based on the same prior art references considered by the Examiner.

Aside from Petitioners’ failure to abide by their duty of candor, the Board should not bless Petitioners’ invitation to second-guess the Examiner’s judgment not to apply Neibauer, Cheng, and Squibbs (alone or in combination) to the ‘039 Claims. The Board defers to “previous Office evaluations of the evidence of record unless material error is shown.” *Advanced Bionics*, Paper 6 at 9. A showing of material error is a high threshold: “[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Id.*

Here the claims of the ‘039 Patent are materially different from those of the ‘5801 Patent invalidated during the reexamination proceeding. *See* Ex.2009. In addition, the reexamination decision was made part of the record of the ‘039 prosecution history by the Examiner, showing that the Examiner considered the potential relevance of the reexamination proceeding. Accordingly, Petitioners cannot rely on the reexamination outcome for the ‘5801 Patent to argue that the

Examiner of the '039 Patent committed “material error” by not rejecting the '039 Patent claims based on Neibauer and Cheng.

2. Ausems

Petitioners add Ausems to their Neibauer Grounds in an attempt to circumvent *Advanced Bionics*. But *Advanced Bionics* applies to “the same or substantially the same prior art” (*Advanced Bionics*, Paper 6 at 8), and *Becton, Dickinson* factors (a) and (b) explicitly contemplate whether the asserted art is cumulative of the prior art involved in the examination or whether there are material differences between the two.

Petitioners cite Ausems for three reasons, each of which is cumulative of references relied upon by the Examiner during prosecution of the '039 Patent. First, Petitioners rely on Ausems as teaching “a mobile device that incorporated a digital camera for recording, storing, and transmitting digital images.” Petition at 18-20. But Calder—a prior art reference specifically discussed by the Examiner—also teaches a mobile device with a video camera for image capture. Ex.1022 at 161; Ex.2010, 2:27-30 (“[A]lternatively the mobile device may have a video camera for image capture whereby an interpretation of the image is converted into tones and the tones are transmitted to a telephony server.”).

Second, Petitioners use Ausems for teaching a “mobile device [that] could have been ‘a GPS-based navigational device.’” Petition at 43. But as Petitioners’

expert testimony shows, the same is taught by the previously considered Squibbs: “Squibbs explains that the cell phone can determine location information in a number of ways, including from ‘a location server of the mobile radio infrastructure,’ or using ‘a GPS system built into the cell phone.’” Ex.1002, ¶89 (citing Squibbs, ¶0098; ¶0101). And as discussed above, Squibbs was presented to the Office during prosecution.

Third, Petitioners cite Ausems for teaching elements like CPU and memory. Petition at 44-45. But Cheng, cited during examination, also describes these elements. Cheng, *e.g.*, 23:16-20 (“Although computer system 1100 is illustrated having a single processor, a single hard disk drive and a single local memory, the system 1100 is optionally suitably equipped with any multitude or combination of processors or storage devices.”), 23:29-31 (“CPU 1204 is the central processing unit of the system, performing calculations and logic operations required to execute a program.”).

Accordingly, Ausems is cumulative of references considered during the prosecution history (i.e., Calder, Squibbs, and Cheng). Thus, its inclusion in the Neibauer Grounds was unnecessary, notably given that Petitioners included both Squibbs and Cheng in their grounds. *See Intel Corp. v. Interdigital, Inc.*, IPR2024-01441, Paper 13, 15-16 (P.T.A.B. Apr. 1, 2025).

3. Bandera

Petitioners' reliance on Bandera is limited to dependent claim 21, and their arguments are taken verbatim from Meta's Petition in the Meta-MDT-IPRs. *See* Ex.2011, 21-23, Row#26. Petitioners use Bandera for teaching "advertising based on the location of the mobile device" or "location-based advertisement." Petition at 64-65. Petitioners need not rely on Bandera to teach this, and to the extent they do, Bandera is substantially similar to US 2005/0177645 to Dowling et al., which was before the Examiner. Ex.1022, 208. For example, Dowling discloses "a geographical web browser" that provides "a new means for advertising locally available items such as products and services." Ex.2012, [0064]. Specifically, Dowling teaches an example of a location-based advertising:

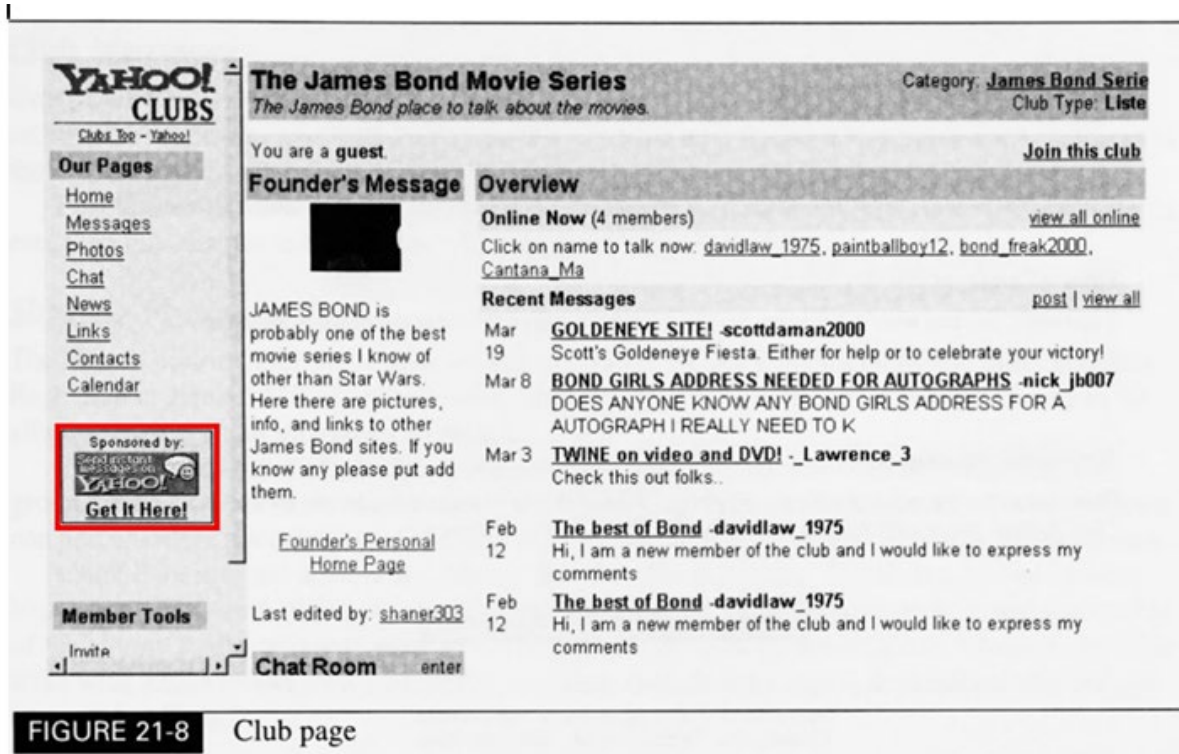
The user interested in a certain product or service logs into a geographically controlled web site and configures the packet filter to display information related to a user's needs. In one example the mobile unit 105 enters a new city and the user is interested in finding a mall with a particular clothing store within. As the user drives along, a web page comes up and provides directions to the shopping mall and also optionally provides an inside map of the mall to include directions to the desired store.

Id. Dowling's disclosure that was before the Examiner during the prosecution of the '039 Patent is substantially similar to the disclosure Petitioners rely on in Bandera.

To be clear, Petitioners do not cite Bandera to teach the delivery of advertising content on the same web page as other content (e.g., a photo) requested by a mobile user. And in fact, Petitioners need not cite Bandera for that. As Petitioners allege

Neibauer “shows an exemplary club page with an advertisement placed on it.”

Petition at 51.



(Neibauer, p.475, Fig. 21-8 (red box added).)

Petition at 52. Accordingly, Petitioners rely on Bandera in a limited fashion: “The web server, in response, generates a requested web page that includes an advertising object. The web server selects the advertising object ‘based on a user location and/or on the time of day.’” Petition at 49. As shown above, Dowling discloses the same.

4. Harvey

Petitioners’ use of Harvey in Grounds 3 and 4 of the ‘535 IPR only highlights their abuse of the IPR process. Petitioners openly admit that the only reason Grounds

3 and 4 based on Harvey are asserted in the ‘535 IPR is to “account for a construction of ‘application-based information channel’ proposed by Meta in the MDT-Meta-Litigation.” Petition at 67. Petitioners have not proposed the MDT-Meta-Litigation construction for “application-based information channel” in the district court, nor do they propose that construction in the ‘535 IPR. *See* Petition at 5-7. There is no reason for Petitioners to burden the Board with Grounds 3 and 4 based on Harvey in the ‘535 IPR when neither Petitioners nor Patent Owner have ever adopted the construction proposed by Meta in the MDT-Meta-Litigation for “application-based information channel.” Meta introduced Grounds 3 and 4 in the Meta-MDT-IPRs only because its own litigation claim construction required it. Petitioners’ assertion of these grounds completes their mimicry of the Meta-MDT-IPRs.⁸ Accordingly, the Board should not consider Grounds 3 and 4 based on Harvey.

V. The Board Should Exercise Discretionary Denial Under *Fintiv* Framework

The Board should deny institution under §314(a) in view of its precedential decisions in *NHK Spring* and *Fintiv*. In *NHK Spring*, the Board denied institution primarily because the related district court case would resolve all the issues before the Board. *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8,

⁸ In fact, by doing so Petitioners tie their interest to Meta’s under the *General Plastic* framework as discussed above.

20 (P.T.A.B. Sept. 12, 2018) (precedential), *see also id.*, 11-18 (applying discretion under 35 U.S.C. §325(d)). Other cases—relying on *NHK Spring*—have also denied institution where the district court trial would resolve the invalidity issue before a final written decision would be issued by the Board. For example, in *E-One, Inc. v. Oshkosh Corp.*, the Board applied *NHK Spring*’s analysis under 35 U.S.C. §314(a) to deny institution. IPR2019-00161, Paper 16 (P.T.A.B. May 15, 2019). In *E-One*, the Board reasoned:

In the § 314(a) portion of its analysis, [*NHK Spring*] noted that a district court proceeding involving the same patent was scheduled to go to trial before a final decision would have been due in the Board proceeding, and the Board proceeding would involve the same claim construction standard, the same prior art references, and the same arguments as in the district court.

Id., 6. In both *NHK Spring* and *E-One*, factors warranting a denial of institution included the district court investing considerable time and resources to handle the same issues presented in the IPR, and trials that were scheduled to be completed prior to a Board’s final written decision. The facts here warrant denial just as decided in *NHK Spring* and *E-One*.

In *Fintiv*, the Board emphasized six factors to consider under *NHK Spring* which are discussed below. *See Fintiv*, Paper 11 at 5-16. The Board stated that “[t]hese factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.*, 6. In evaluating the *Fintiv* factors, the Board must “take[] a **holistic**

view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

Importantly, no individual factor is dispositive by and of itself. *See* the March 24, 2025 Memorandum titled, “Guidance on USPTO’s Recission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’” (the “March 24, 2025 Memo”). For example, a timely-filed *Sotera* stipulation is not dispositive. *Id.* at 3. Similarly, “compelling merits alone is not dispositive in making the assessment.” *Id.*; *see also Motorola Solutions, Inc. v. Stellar LLC*, IPR2024-01205,-01206,-01207,-01208, Paper 19 (P.T.A.B. Mar. 28, 2025) (vacating the decision granting institution and denying institution because “the Board did not give enough weight to the investment in the parallel proceeding and gave too much weight to Petitioner’s *Sotera* stipulation”).

Additionally, consistent with *Fintiv*’s holistic analysis, the Board should also consider other relevant considerations, including but not limited to “[t]he extent of the petition’s reliance on expert testimony,” “[s]ettled expectations of the parties, such as the length of time the claims have been in force,” and compelling economic interests. *See* March 26, 2025 Memo at 2-3.

Here, the overall balance of *Fintiv* factors and other relevant considerations weigh strongly in favor of denying institution under 35 U.S.C. §314(a).

A. Factor 1: No stay has been entered in the EDTX-Litigation and there is no evidence that a stay will be granted.

Fintiv Factor 1 weighs in favor of discretionary denial because the EDTX-Litigation has not been stayed. Indeed, no motion to stay the case is pending, and Petitioners have presented no evidence that Judge Gilstrap would grant a stay if such a motion were filed. Even if Petitioners filed a motion to stay today, under the precedent in the Eastern District of Texas, it would be denied.

As a threshold matter, the ‘039 Patent is not subject to an instituted IPR proceeding, and the Eastern District of Texas does not grant a stay when the Board has not issued the decision on institution:

It would have been virtually pointless for Samsung to have sought a stay before the IPR was instituted, as this Court would have almost certainly denied it; the decisions of courts in this district as well as other district courts make that abundantly clear.

CyWee Grp. Ltd. v. Samsung Elecs. Co., No. 17-cv-140, 2019 WL 11023976, at *5 (E.D.Tex. Feb. 14, 2019); *see also Trover Group, Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047WCB, 2015 WL 1069179, at *6 (E.D.Tex. Mar. 11, 2015) (Bryson, J.) (“This Court’s survey of cases from the Eastern District of Texas shows that when the PTAB has not yet acted on a petition for inter partes review, the courts have uniformly denied motions for a stay.”); *see also Samsung Elecs. Co. Ltd. v. Evolved Wireless LLC*, IPR2021-00950, Paper 10 at 10-11 (P.T.A.B. Nov. 29, 2021) (finding this factor weighed in favor of denial and denying institution where patent owner

showed a stay was unlikely partly based on the court’s past decisions denying stays); *Samsung Elecs. Co. Ltd. v. Clear Imaging Research, LLC*, IPR2020-01552, Paper 12 at 12-13 (P.T.A.B. Mar. 3, 2021) (denying institution because, in part, Judge Gilstrap deemed unlikely to stay a case in similar circumstances).

Additionally, even if the Meta-MDT-IPRs were still active before the Board and Petitioners file their motion to stay today—before the Board decides institution in the ‘535 IPR—the Eastern District of Texas would deny Petitioners’ motion to stay based on Petitioners’ delay. Petitioners had every opportunity to file a motion to stay the EDTX-Litigation any time between institution and withdrawal of the Meta-MDT-IPRs, namely between June 2024 and March 2025. In fact, Petitioners have been contemplating a motion to stay for over seven months, since the early stages of the EDTX-Litigation (*See* Exs.2008, 2013, and 2014), but still have not filed such a motion with the district court.

On September 26, 2024, Petitioners inquired about Patent Owner’s position regarding a stay of the EDTX-Litigation pending the issuance of final written decisions in Meta-MDT-IPRs. *See* Ex.2008. Patent Owner informed Petitioners that it opposed a stay, and Petitioners did not proceed with filing. Ex.2013. On February 19, 2025, after filing their IPR Petitions, Petitioners once again inquired about Patent Owner’s “position on a stay pending IPR.” *See* Ex.2014. And on March 4, 2025, Petitioners shared a draft of their motion to stay for Patent Owner’s review. Ex.2015.

To date, Petitioners still have not filed a motion to stay. Eastern District of Texas precedent has denied a stay where there has been a much shorter delay than here. *See, e.g., Saint Lawrence Commc'ns LLC v. ZTE Corp.*, No. 2:15-CV-349-JRG, 2:15-CV-351-JRG, 2017 WL 3396399, at *2 (E.D.Tex. Jan. 17, 2017) (“[Defendant’s] decision to wait over a month to file its renewed motion to stay following the PTAB’s decision to institute IPR ... further undermines its efforts to obtain a stay.”).

Even if Petitioners’ delay in filing a motion to stay is overlooked, Petitioners’ delay in filing their IPR Petition is an independent basis in the Eastern District of Texas to deny a motion to stay. *See Tessera Advanced Technologies, Inc. v. Samsung Electronics Co., Ltd.*, No. 2:17-cv-00671-JRG, 2018 WL 3472700, at *3 (E.D.Tex. July 19, 2018) (finding IPRs filed nine months after initiation of the lawsuit and five months after service of infringement contentions weighed against a motion to stay). Here, Petitioners filed their IPR Petitions nearly eight months after the initiation of the EDTX-Litigation and five months after service of Patent Owner’s infringement contentions. Under the Eastern District of Texas’s precedent, Petitioners’ delay in filing their IPR Petitions would weigh against grant of a motion to stay even if they filed one today.

Finally, the Eastern District of Texas has yet another independent reason to deny a motion to stay—any final written decision would not be due until well after

the trial concludes. The EDTX-Litigation has been underway for almost a year now, and jury selection is less than a year away, on April 20, 2026. *See* Ex.2016. This is “a deadline that cannot be changed without an acceptable showing of good cause. Good cause is not shown merely by indicating that the parties agree that the deadline should be changed.” *Id.* at 5. An institution decision on the ‘535 IPR is not due until September 2025. By that date, the parties will have substantially completed the claim construction process, with the *Markman* hearing scheduled for October 30, 2025. *See id.* at 4-5. A final written decision would not be due until September 2026, five months after trial is scheduled to begin. For this independent reason, the Eastern District of Texas is likely to find that a stay in circumstances like this case would unduly prejudice Patent Owner, disfavoring a stay. *See, e.g., MyPort, Inc. v. Samsung Electronics Co., Ltd., et al.*, No. 2:22-cv-00114-JRG, Dkt. No. 73 (E.D.Tex. June 12, 2023) at 4 (noting that patent owner has an interest in the timely enforcement of its patent rights and that granting a stay could delay the case by nearly two years where the PTAB decision is not due until over two months after jury trial is set to begin).

Accordingly, under circumstances of this case, *Fintiv* Factor 1 weighs overwhelmingly in favor of discretionary denial.

B. Factor 2: The EDTX-Litigation’s Trial Date is Five Months Before the Expected Date of Any Final Written Decision

Fintiv Factor 2 strongly weighs in favor of discretionary denial because by the

time any final written decision in the ‘535 IPR would issue, the EDTX-Litigation would be concluded, and Petitioners’ invalidity challenges all addressed by the district court. “If a district court’s trial date is earlier than the Board’s projected statutory deadline for a final written decision, the Board generally has weighed this fact in favor of exercising discretion to deny institution.” *TMobile USA, Inc., et al. v. Wireless Alliance*, IPR2024-00608, Paper 16 (P.T.A.B. Sept. 3, 2024) (exercising discretion to deny institution of inter partes review).

The ‘535 IPR was filed nearly 8 months after initiation of the EDTX-Litigation, and a decision whether to institute the ‘535 IPR is expected approximately on September 13, 2025. If instituted, any final written decision is expected approximately on September 13, 2026. 37 C.F.R. § 42.100. Jury selection in the EDTX-Litigation is scheduled to begin on April 20, 2026, five months before any final written decision from the Board. *See* Ex.2016, at 1. The jury selection is “a deadline that cannot be changed without an acceptable showing of good cause. Good cause is not shown merely by indicating that the parties agree that the deadline should be changed.” *Id.* at 5. Furthermore, while the case schedule has been amended, the parties have never attempted to extend any of the critical interim deadlines, such as claim construction, fact discovery, expert discovery, pre-trial conference, and jury selection. Thus, it is unlikely that the parties agree to change the trial date now.

Even if the Board disregards the scheduled trial date, an analysis of the current median time-to-trial statistics still weighs against institution. *See* March 24, 2025 Memo at 3 (“[T]he Board may consider any evidence that the parties make of record that bears on the proximity of the district court’s trial date or the ITC’s final determination target date, including median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides.”). The most recent statistics on “United States District Courts – National Judicial Caseload Profile,” published by www.uscourts.gov,⁹ show that for a 12-month period ending September 30, 2024, a median time-to-trial in the Eastern District of Texas for civil cases is 21.9 months. Ex.2017 at 35. Accordingly, the projected trial date in the EDTX-Litigation for purposes of *Fintiv* in accordance with the March 24, 2025 Memo would be around March 29, 2026—even earlier than the scheduled trial date and nearly six months before the expected timing of a final written decision if this proceeding is instituted.

The Board has consistently found that this factor weighs in favor of exercising

⁹ This website is “maintained by the Administrative Office of the U.S. Courts on behalf of the Federal Judiciary.” <https://www.uscourts.gov/>. The URL for the published statistics is https://www.uscourts.gov/sites/default/files/2024-12/fcms_na_distprofile0930.2024.pdf.

discretionary denial where the underlying litigation is in the Eastern District of Texas and the projected trial date is prior to the date when the final written decision would be due. *See, e.g., SAP America v. Cyandia, Inc.*, IPR2024-01496, Paper 13, 5-6 (P.T.A.B. Apr. 7, 2025) (holding that this factor weighs against institution when the trial would begin “about four months before the deadline for entering a final written decision in this proceeding”); *T-Mobile*, IPR2024-00608, Paper 16 at 13 (“Because the district court would address issues relating to the validity of the ’662 patent in a trial that, by any measure, would occur many months before we would issue a final written decision, we weigh the second *Fintiv* factor as favoring discretionary denial.”).

Accordingly, this factor weighs in favor of exercising discretion to deny institution.

C. Factor 3: Significant Investment in the Parallel Litigation Will Have Occurred by the Time the Board’s Institution Decision is Due

Fintiv Factor 3 is a two-prong test. The first prong relates to the “amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv* at 9. The second prong is the petitioner’s diligence in filing the petition. “If the petitioner cannot explain the delay in filing its petition, [this fact has] favored denial.” *Fintiv* at 11-12 (recognizing that for Factor 3, “the parties should explain facts relevant to timing”). This factor weighs in favor of exercising discretion to deny institution, because the first prong is neutral,

and the second prong strongly weighs in favor of discretionary denial.

Starting with the first prong, fact discovery between the parties is ongoing in the EDTX-Litigation, and each party has made several produced volumes of documents. Exs.2018-2019. Petitioners have already served 10 third-party subpoenas requesting production of documents concerning invalidity. Several third parties have produced documents in response to Petitioners' subpoenas. Exs.2020-2025. In addition, the parties have completed and exchanged their infringement and invalidity contentions.¹⁰ By the projected institution date, the parties would have already expended significant time in discovery and will have also exchanged claim constructions, filed a joint claim construction statement, and completed claim construction discovery. *See* Ex.2016. The *Markman* hearing is also scheduled to occur about a month after the institution decision is due. *Id.* Under similar circumstances, the Board has consistently held that this prong is neutral. *See, e.g., Dell Inc. et al. v. Universal Connectivity Technologies Inc.*, IPR2024-01479, Paper 11, 6-7 (P.T.A.B. Apr. 7, 2025); *Lenovo Inc. et al. v. Universal Connectivity Technologies Inc.*, IPR2024-01479, Paper 17, 11-12 (P.T.A.B. Apr. 17, 2025); *Solus Advanced Materials Co., Ltd. v. SK nexilis Co.*, IPR2024-01460, Paper 14, 17-18

¹⁰ Patent Owner served its infringement contention on September 4, 2024. Ex.2026. Petitioners served their invalidity contention on January 31, 2025. Ex.2027.

(P.T.A.B. Apr. 22, 2025).

Turning to the second prong, Petitioners were not diligent in filing their Petition. Despite admitting that the ‘535 IPR rests on “common references and arguments” recycled from the Meta-MDT-IPRs (Paper 3 at 4), Petitioners waited for nearly eight months to file the ‘535 IPR Petition. Petitioners cannot justify this delay. In fact, Petitioners cannot even explain why they did not file a joinder motion to join the Meta-MDT-IPRs, which rested on the same arguments that Petitioners now re-assert.

Even if this is overlooked, Petitioners cannot explain why they failed to promptly file their Petition upon receiving Patent Owner’s infringement contentions in the EDTX-Litigation. Petitioners were served with Patent Owner’s infringement contentions on September 4, 2024—nearly five months prior to filing the ‘535 IPR. Ex.2026. The five-month gap between service of infringement contentions and the filing of the ‘535 IPR Petition constitutes “substantial delay” that favors discretionary denial under *Fintiv* Factor 3. *AT&T Servs. v. ASUS Tech.*, IPR2024-00992, Paper 14 at 12 (P.T.A.B. Dec. 16, 2024) (five months between infringement contentions and the petition is a “substantial delay”).

Accordingly, this factor weighs in favor of exercising discretion to deny institution.

D. Factor 4: There is Substantial Overlap Between This IPR and the EDTX-Litigation, Rendering Petitioners’ *Sotera*-style Stipulation Ineffective

Fintiv factor 4 weighs strongly in favor of discretionary denial because “some of the claims challenged in the petition are also at issue in district court,” and the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as included in the EDTX-Litigation. *Fintiv* at 12-13.

The Board’s April 25, 2025 FAQs about the discretionary denial process¹¹ expressly list two criteria for an effective *Sotera* stipulation: one procedural and one substantive. Procedurally, “[a] petitioner should file a *Sotera* or *Sand* stipulation as soon as practicable, so that a patent owner may address the impact of the stipulation in its discretionary denial brief.” April 25, 2025 FAQs, Q.14. As to the substance, “the stipulation [must] materially reduce[] overlap between the proceedings,” noting that “[w]here the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful.” *Id.* Petitioners’ *Sotera*-style stipulation fails to meet either criterion.

Procedurally, Petitioners’ *Sotera*-style stipulation is untimely. Petitioners had ample opportunity to file their *Sotera*-style stipulation sooner and even at the time

¹¹ www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management.

of filing the ‘535 IPR but waited for over 3 months to contact the Board to seek leave to file it.¹² Ex.2006. And despite Patent Owner promptly responding to Petitioners’ inquiry (Ex.2028), Petitioners wasted yet another full week to email Patent Owner the draft of their proposed communication to the Board (Ex.2029). These delays are

¹² On April 18, 2025—nearly three months after filing their Petition, Petitioners contacted Patent Owner, proposing a *Sotera*-style stipulation. Ex.2030. On April 21, 2025, Petitioners informed Patent Owner that they intend to seek leave to file their proposed stipulation, asking Patent Owner to indicate its position by April 23, 2025. Ex.2028. Patent Owner responded on April 23, 2025, that “Patent Owner does not oppose Petitioner contacting the Board to seek leave to file these stipulations.” *Id.* It took Petitioners one week to respond with the draft of its proposed communication to the Board on April 30, 2025. Ex.2029. Petitioners sent its request for leave to file its *Sotera*-style stipulation to the Board on May 2, 2025. Ex.2006. As of the date of the filing of this Discretionary Denial brief, Petitioners’ *Sotera*-style stipulation is not filed. Accordingly, Patent Owner cannot address the “impact” of a stipulation that is not yet filed. As such, Patent Owner presents its arguments on the sufficiency of Petitioners’ April 18, 2025 proposed stipulation, assuming that Petitioners will not modify their proposed drafts in this IPR or any of the other IPRs based on Patent Owner’s arguments in this brief.

not excusable—the untimeliness of Petitioners’ filing has substantially prejudiced Patent Owner. Patent Owner intended to file this Discretionary Denial brief on May 1, 2025—ten days before the two-month deadline—so that Petitioners’ response would arrive before the POPR was due, giving Patent Owner enough time to review and respond in the POPR. Petitioners have deprived Patent Owner of its strategic advantage.¹³

Turning to the substance of Petitioners’ *Sotera*-style stipulation, Petitioners’ proposed draft does not reduce overlap between the proceedings. Petitioners’ draft stipulation provides that if the Board “institutes an *inter partes* review (“IPR”) in either or both of IPR2025-00535 and IPR2025-00536 concerning U.S. Patent No. 9,032,039, then Samsung will not pursue in this litigation the grounds raised or any

¹³ Petitioners cannot hide behind their April 18, 2025 email to Patent Owner. First, the FAQs state that the stipulation must be “file[d] ... as soon as practicable”—sending a draft of a stipulation to Patent Owner does not relax the filing requirement. The reason is simple—until such time that such proposed stipulation is filed, it is just that: a proposed draft. A petitioner can change its proposed draft at anytime before filing. Thus, Patent Owner could not reasonably address the impact of a draft stipulation that is not yet filed. Second, April 18, 2025—over three months from filing the Petitions—is not “as soon as practicable” by any stretch.

other grounds that could have reasonably been raised before the PTAB in the instituted proceeding(s).” Ex.2032.¹⁴ However, in view of Petitioners’ invalidity contentions, this stipulation is insufficient.

In the EDTX-Litigation, Petitioners have asserted the “Yahoo! System” as a prior art system to challenge the validity of the ‘039 Patent. Ex.2027 at 35-36 Yet, in their Yahoo! System invalidity claim chart, Petitioners expressly state that the Yahoo! System is described in Neibauer, which Petitioners contend “independently qualif[ies] as 35 U.S.C. §§ 102(a) and 102(b) prior art.” Ex.2033 at 1.

¹⁴ Patent Owner files this Exhibit only to give the Board context for its arguments. Petitioners—not Patent Owner—must file any *Sotera* stipulation, and they have not done so. This Exhibit does not fulfill that duty, and no stipulation is considered filed because Patent Owner files this Exhibit. If the Board permits Petitioners to file a stipulation, it must be the very stipulation they delivered to Patent Owner on April 18, 2025—no revisions, no substitutions. *See* Ex.2006 at 2 (requesting “to document the *Sotera* stipulations served on Patent Owner Mobile Data Technologies LLC on April 18 and April 21, 2025”).

Mobile Data Technologies, LLC v. Samsung Electronics Co. Ltd., and Samsung Electronics America, Inc.
No. 2:24-cv-00435-JRG-RSP (E.D. Tex.)
Defendants' Invalidation Contentions – Exhibit C15

Claim Chart Against U.S. Patent No. 9,032,039 (“’039 patent”)

Charted Reference: The Yahoo! System (“Yahoo”)

The Yahoo system was available prior to June 18, 2001 and June 18, 2002, qualifies as prior art under at least 35 U.S. §§ 102 and/or 103 as to the asserted claims of U.S. Patent 9,032,039 (“the ’039 Patent”), as discussed in greater detail in the chart that follows.¹ Yahoo is described in the following publications which each independently qualify as 35 U.S.C. §§ 102(a) and 102(b) prior art to the ’039 patent:

- Neibauer, Alan, “How to do Everything with Yahoo!” (2000)
- Hill, Brad, “Yahoo! for Dummies,” (2001)

Id. In fact, Petitioners relied on disclosures from Neibauer for every claim limitation in their Yahoo! System invalidity claim chart. *See id.* As evidenced by Petitioners’ own invalidity contentions, Petitioners assert an invalidity defense based on the same evidence presented in this Petition, i.e., Neibauer disclosures. Thus, despite Petitioner’s statutory inability to raise the Yahoo! System in this IPR, a substantial overlap of issues would remain even with Petitioners’ *Sotera*-style or any other narrower stipulations. Where, as here, “the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful.” April 25, 2025 FAQs, Q.14.

Because Petitioners intend to swap labels in the EDTX-Litigation for what is otherwise the Neibauer Grounds asserted in the ‘535 IPR Petition to cloak the Neibauer Grounds as a prior art system ground, *Fintiv* Factor 4 weighs strongly in favor of denying institution. *See, e.g., SAP America v. Cyandia, Inc.*, IPR2024-01496, Paper 13, 8-9 (P.T.A.B. Apr. 7, 2025) (holding on similar facts that “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”).

E. Factor 5: Petitioners are the Defendants in the EDTX-Litigation

Fintiv factor 5 weighs in favor of exercising discretionary denial because the parties are the same in both proceedings. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 15 (P.T.A.B. 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.”).

F. Factor 6: Other Circumstances That Impact the Board’s Exercise of Discretion, Including the Merits

Fintiv factor 6 holistically weighs in favor of exercising discretionary denial.

1. Settled expectations of the parties, such as the length of time the claims have been in force.

The March 26, 2025 Memo lists “settled [as opposed to speculative] expectations of the parties” as a factor to be considered as part of the Board’s holistic review. Patent Owner has a settled expectation in the validity of the challenged claims. First, these claims are entitled to the statutory presumption of validity. 35 U.S.C. § 282. Second, the challenged claims were in force since 2015 until they expired in June 2023. Accordingly, this factor weighs in favor of a discretionary denial.

2. Petitioners’ abuse of the IPR process

As noted above, Petitioners failed to file a joinder motion by July 11, 2024,¹⁵ under 37 C.F.R. § 122(b)—to join the Meta-MDT-IPRs, which rested on the same Neibauer Grounds that Petitioners now re-assert. Although Petitioners had notice and opportunity to do so any time between June 17, 2024, when they were served with the Complaint in the EDTX-Litigation, and July 11, 2024, Petitioners waited nearly eight months to file the current Petition, re-raising the “common references and arguments” as those in the Meta-MDT-IPRs. Paper 3 at 4.

Additionally, Petitioners’ filing two sets of petitions is nothing but a transparent attempt to circumvent the 14,000-word limit. Petitioners contend filing multiple petitions was necessary because Patent Owner allegedly proposed two alternative constructions for some of the claim terms. Paper 3 at 2-4. Yet, instead of addressing one claim construction in their first-ranked Petition and the other in the second-ranked Petition, Petitioners take identical claim construction positions in ‘535 and ‘536 Petitions as shown in Table 1. This highlights two points. One, Patent Owner’s proposed construction are not truly alternatives as Petitioners characterize. Two, Petitioners’ first-ranked and second-ranked Petitions substantially overlap.

¹⁵ Petitioners were served with the Complaint in the EDTX on June 17, 2024, and thus as of June 17, 2024 Petitioners were aware of the Asserted Patents and the Meta-MDT-IPRs. *See* Ex.2005.

Additionally, as discussed above, Petitioners have no good-faith reason to burden the Board with Grounds 3 and 4 based on Harvey in the ‘535 IPR when neither Petitioners nor Patent Owner have ever adopted the construction proposed by Meta in the MDT-Meta-Litigation for “application-based information channel.” *See supra* §IV.B.4. Petitioners’ abuse of the IPR process should not be rewarded.

3. Petitioners’ inconsistent rankings of the Petitions

Petitioners rank their twin Petitions inconsistently. Petitioners rank the Petition asserting the Neibauer Grounds (i.e., the ‘535 IPR) lower than the Petition asserting the Original Grounds (i.e., the ‘536 IPR) only for their Petitions against the ‘039 and ‘801 Patents. Paper 3 at 2. For other Asserted Patents, Petitioners consistently rank the Petition asserting the Neibauer Grounds higher.

The Asserted Patents belong to the same family, as shown in Figure 1 above, and share nearly identical specifications. *See, e.g.,* Ex.2002. Petitioners do not explain why their ranking of the Petitions is inconsistent, and thus Patent Owner objects to Petitioners’ capricious ranking. That Petitioners rank the Petition asserting the Neibauer Grounds lower only for the ‘039 Patent and ‘801 Patent indicates Petitioners’ skepticism as to the merit and effectiveness of the Neibauer Grounds against the claims of the ‘039 Patent. The Board should consider this as a factor favoring exercising discretion to deny institution.

4. Petitioners’ excessive reliance on expert testimony

The Board's April 25, 2025 FAQs about the discretionary denial process expressly state "extensive reliance on expert testimony ... may suggest that the questions are better resolved in an Article III court." April 25, 2025 FAQs, Q.21. The Board emphasized the statutory requirement that "petitions [must] be based on prior art patents and printed publications." *Id.* The Board pronounced that to the extent a petitioner relies on expert testimony, the testimony must be "focused ... to provid[ing] helpful context or [] explain[ing] terms of art." Importantly, "failure to provide focused expert testimony may weigh against institution." *Id.*

a) Petitioners' expert testimony is not focused to providing helpful context

Petitioners' expert testimony is not "focused ... to provid[ing] helpful context." Petitioners' 155-page-long expert declaration for their 87-page Petition is not "focused expert testimony." Nor does it provide any helpful context. In fact, contrary to the Board's direction that "it is not necessary for an expert to explain every aspect of the prior art" (April 25, 2025 FAQs, Q.21), Petitioners' expert testimony engages in a limitation-by-limitation obviousness analysis of the claims, and fills shortcomings in the prior art using only conclusory statements. Patent Owner presents examples here.

In discussing limitation 1[B], the expert testimony begins with a quote from Neibauer: "[a] club is a group of Yahoo! members who share a common interest. Each club has its own message board, chat room, as well as places to share

photographs, news, addresses, and links.” Ex.1002, ¶139. From this quote, the expert testimony assumes without providing any explanation that the club is an application. *Id.* This unfounded assumption—which forms the basis of Petitioners’ Neibauer Grounds—is undermined by the very next paragraph in the expert testimony: “clubs are accessible from a webpage on the Yahoo! website (<http://clubs.yahoo.com>).” Ex.1002, ¶140. A “focused” expert testimony that provides “helpful context” should have explained why Neibauer’s clubs that are merely “a webpage on the Yahoo! website” would be understood to be an application. Petitioners’ expert testimony does not.

A few paragraphs below, Petitioners’ expert testimony states that “[t]he club photo sharing feature is an “application-based information channel.” Ex.1002, ¶144. The expert testimony specifically argues that the photo sharing feature is an information channel through which a “club member can upload and share photos with other club members.” Ex.1002, ¶145. And, according to Petitioners’ expert, the photo sharing feature is application-based, because it is a feature of the club (i.e., the application per ¶139). Again, whether the club photo-sharing feature would in fact be the claimed “application-based information channel” depends on whether the club is an application, but Petitioners’ expert testimony provides no helpful context to the Board on this pivotal point.

A paragraph below, Petitioners’ expert testimony offers a definition for the

term “application” citing Microsoft Computer Dictionary: “A program designed to assist in the performance of a specific task, such as word processing, accounting, or inventory management.” Ex.1002, ¶146. The paragraph ends with a conclusory statement with no citation to Neibauer, stating that “the club photo sharing feature is provided by one or more software programs or applications running on the web server, and the web browser application running on the club member’s mobile device, which allows club members to interact with and use the club photo sharing feature.” *Id.* But even if this were true (which it is not), at best it would show that Neibauer’s club photo sharing feature is a web-based information channel, as Petitioners’ expert expressly admits. Ex.1002, ¶93; ¶127. The expert testimony provides no helpful context sufficient to show that a web-based information channel is the same as an application-based information channel.

Furthermore, this conclusion is inconsistent with earlier statements in the expert testimony equating Neibauer’s club with an application. If the club is an application, as the expert testimony states, and the photo sharing is a feature of that application, then Petitioners’ expert testimony, read literally, argues that the photo sharing feature is an application inside another application. Under Petitioners’ expert testimony, the photo sharing feature would not be an application-based information channel, as required by the claims—it would be an information channel application. This would impermissibly rewrite the claims, and Petitioners’ expert testimony does

not explain why the two terms are the same.

b) Petitioners rely extensively on expert testimony

Petitioners' cite to Neibauer fewer than 50 times, whereas Petitioners cite their expert's testimony to support their limitation-by-limitation analysis more than 150 times. In fact, the overwhelming majority of the content of the Petition appears verbatim in Petitioners' expert testimony. Ex.2035 (providing numerous examples of copy-pasting from Ex.1002 into the Petition). Consider Petitioners' terse discussion of Grounds 3 and 4. Petition at 67-70. The entirety of pages 67 and 68 of the Petition are taken from Ex.1002, ¶¶243-244 of Petitioners' expert testimony. Ex.2035, 12-13. For example, the Petition, copying from the expert declaration, states “[a]s noted, Harvey explains that ‘[t]he community creating module permits the creator to create a community, and designate applications and content presented in the community by a user interface.’” Interestingly, the Petition never “noted” this previously. In their copy-paste process from the expert testimony (Ex.1002, ¶244), Petitioners failed to appreciate that their expert's use of “[a]s noted” was justified because the expert testimony actually noted the disclosure of Harvey earlier in his declaration. Ex.1002, ¶243. But the Petition did not.

Furthermore, Petitioners not only rely exclusively on expert testimony but also incorporate by reference the testimony in violation of well-entrenched rules. For limitation 1[B], a key limitation, Petitioners drop a conclusory statement that

“Neibauer’s club photo sharing feature is an ‘application-based information channel.’” Petition at 21. For support, Petitioners cite six paragraphs of expert testimony. *Id.* The Petition does not include any discussion supporting this conclusion, requiring Patent Owner and the Board to search for support in the expert testimony. Petitioners incorporate arguments by reference and therefore violate 37 C.F.R. § 42.6(a)(3). *Cisco Systems, Inc. v. C-Cation Techs.*, IPR2014-00454, Paper 12 at 9 (P.T.A.B. Aug. 29, 2014) (informative) (providing that “practice of citing the Declaration to support conclusory statements that are not otherwise supported in the Petition also amounts to incorporation by reference”). Interestingly, Petitioners’ expert also offers no citation, let alone analysis, for the assertion that “[t]he club photo sharing feature is an ‘application-based information channel.’”¹⁶ ¶144.

As for the “previously established” element in limitation 1[B], Petitioners again exclusively rely on expert testimony. Petitioners argue that “[t]he club photo sharing feature is also a ‘previously established’ application-based information

¹⁶ Petitioners’ expert repeatedly refers to the photo sharing feature as a web-based feature, without any explanation or providing helpful context to the claimed “application-based information channel.” Ex.1002, ¶93; ¶127. Neither Petitioners nor their expert explain how a PHOSITA would equate “application-based” with “web-based.”

channel because it was already established as a feature of the club before the club member chose to upload a new photo to a photo album.” Petition at 21. Instead of citing Neibauer for support and offering analysis in the Petition, Petitioners cite ¶145 of the expert testimony, which by itself constitutes incorporation by reference. *Id.* Worse yet, when reading ¶145 of the expert testimony, the Board and Patent Owner are referred to some unspecified portion of the expert testimony: “The club photo sharing feature is also ‘previously established’ because, as shown above, it was already established as a feature of the club before the club member chose to upload a new photo to a photo album.” Ex.1002, ¶145.

Thus, the Petition relies extensively on expert testimony, which also provides no helpful context in understanding key aspects of the Petition. The Board should weigh this factor in favor of discretionarily denying institution.

5. The ‘535 Petition lacks merit

“A full merits analysis is not necessary as part of deciding whether to exercise discretion not to institute, but rather the parties may point out, as part of the factor-based analysis, particular ‘strengths or weaknesses’ to aid the Board in deciding whether the merits tip the balance.” *Fintiv*, Paper 15 at 15. But even “compelling merits alone is not dispositive in making the [*Fintiv*] assessment.” March 24, 2025 Memo at 3; *see also Nokia Of America Corp v. Pegasus Wireless Innovation LLC*, IPR2025-00036, Paper 14, 17-18 (P.T.A.B. Apr. 25, 2025) (“We determine that the

strength of the merits of Petitioner’s patentability challenges based on R3-173152, ... weighs against exercising discretion to deny institution of inter partes review. However, we determine that resolution of all of the disputes based on all of the issues between the parties regarding the challenged patent before the district court, which likely would occur many months before a subset of the issues could be resolved before the Board, would be more efficient and, therefore, weighs in favor of exercising discretion to deny institution of inter partes review. In sum, *we determine that the strength of the merits is obviated by the efficiency and timeliness of the parallel district court proceeding and, therefore, determine that considerations of the sixth Fintiv factor are neutral.*”). Accordingly, the Board need not engage in assessment of merits, because given the strength of other factors and considerations suffice for *Fintiv* purposes. If, however, the Board considers assessment of merits in its holistic approach to *Fintiv*, the ‘535 Petition is weak.

a) Petitioners Rely on Prior Art that Lacks Material Claim Limitations

Regarding Grounds 1-4, the Petition asserts that the features of Yahoo! and the uses of its services and tools (referencing various excerpts from Neibauer, notably referencing the Yahoo! Clubs feature) renders the majority of the claim limitations obvious. However, Neibauer is completely devoid of any teaching or suggestion of at least the claim limitation “identifying a[n] ... application-based information channel” (into which content from a mobile device, including captured

content from a mobile device, is to be inserted), as generally recited in the independent claims (e.g., limitation 1[B]).

The Petition asserts that the claimed step of “identifying a[n] ... application-based information channel” “takes place when Neibauer’s server receives a photo uploaded by a club member to be shared with other club members”, and further asserts that “Neibauer’s club photo sharing feature is an ‘application-based information channel.’” Petition at 21.

However, Neibauer simply discloses use of the Yahoo! website for accessing the various features, including the clubs feature, in contrast to use of an “application-based” information channel, as generally recited in the claims. In fact, there is no disclosure of use of a “application” whatsoever for the Yahoo! Clubs feature. Rather, the Yahoo! Clubs feature is accessible from a webpage on the Yahoo! website, which allows users to search existing clubs relating to specific topics of interest, and a user clicks a hyperlink for a given club. Neibauer at 473. In particular, Neibauer explicitly states that a user can “Access Yahoo! clubs by clicking Clubs on the Yahoo! home page or by going directly to <http://clubs.yahoo.com/> to open the page....” *Id.* Petitioners’ expert also concedes this. Ex.1002, ¶93; ¶127. Accordingly, a user utilizes the Yahoo! website to further access and use the web-based Yahoo! Clubs feature for the sharing of content, in contrast to an “application-based information channel,” as generally claimed.

Accordingly, the Yahoo! Clubs feature is hosted and provided via a web-based means, in contrast to the claimed “application-based” information channel. In particular, the photo sharing provided by Yahoo! Clubs is merely a feature that is web-based, in contrast to being application-based. *See* Ex.1002, ¶¶93; ¶127.

Petitioners do not rely on any of the remaining references to cure the deficiencies of Neibauer for limitation 1[B]. *See* Petition at 20-23. Nor can they. Neither Cheng, nor Ausems, nor Squibbs, nor Bandera (asserted in Grounds 1-2) teaches or suggests at least the claim limitation “identifying a previously established application-based information channel” into which content from a mobile device, including captured content from a mobile device, is to be inserted.

Cheng merely discloses systems and methods of extracting content from a web page and reformatting the extracted content for viewing on a mobile device. Cheng, 1:11-16. Cheng is simply relied upon for the teaching of proxy servers and use of such servers in making web content viewable on mobile devices. In fact, The Petition acknowledges that:

Cheng provides “bolt-on” functionality, with the proxy server capable of converting and reformatting any existing HTML-based web page into a format suitable for display on a mobile device. (EX-1002, ¶¶69, 73-74, 92-93; Cheng, 2:30-32 (“The [reformatting] may be done for at least one of groups of devices, individual devices, web site-specific conversions, or for all web sites.

Petition at 16; *see also* Ex.1002, ¶95 (describing Cheng as “including the ability to make web-based information content available on mobile devices. Cheng would also

have been reasonably pertinent to problems facing the inventors, including how to implement a web-based system for making information content available to mobile device users”).

As such, Cheng is completely unrelated to the use, and devoid of any teaching, of an “application-based information channel.” Rather, Cheng is limited to use with web site-specific conversions. Ausems, Squibbs, and Bandera are also similarly deficient, and the Petition does not rely upon them for teaching or suggesting the limitation 1[B]. Thus, even if one were to combine the teachings of one or more of the remaining references with Neibauer, such a combination would still fail to teach or suggest this limitation.

b) Harvey does not cure the deficiencies in Grounds 1 and 2

As discussed above, the Board should not consider Grounds 3-4 due to Petitioners’ abuse of the IPR process. *See supra* §V.F.2 and §IV.B.4. However, if the Board is to consider these grounds, they too are weak and do not disclose limitation 1[B]: identifying an application-based information channel that is “previously established.” Petitioners assert that Harvey discloses a “previously established” information channel because “[t]he key feature of Harvey here is the ability of a community creator to author content for a community before the community is created and launched.” Petition at 68 (emphasis in original); *see also*

id. (“Harvey therefore discloses the ability to add content to a community using the community-creation tool, before the community is created.”).

However, Harvey fails to teach or suggests at least the claim limitation “identifying a previously established application-based information channel,” as generally recited in the independent claims (e.g., limitation 1[B]). Harvey describes the use of a community creating module, described as being capable of permitting a creator to create a community and designate applications and content to be presented in the community. Petitioners suggest that the community that Harvey describes is the information channel. The capabilities of this community (information channel), however, are permitted during the creation of the community, and do NOT occur before the creation of the community, as the Petition asserts. Thus, Harvey’s community is not a “previously established application-based information channel.” Interestingly, Petitioners cite Harvey’s discussion about creation of the community and designation of content for the community that clearly states the designation of content occurs during the creation of the community: “Harvey explains that ‘[t]he community creating module permits the creator to create a community, and designate applications and content presented in the community by a user interface.’” Petition at 68 (citing Harvey, 4:28-30). Yet, Petitioners distort this by saying that “Harvey therefore discloses the ability to add content to a community using the community-creation tool, before the community is created.” Petition at 68.

Furthermore, the Petitioners and their expert appear to be lumping the terms “created” and “launched” as if they are a single action. In particular, the Petition asserts “[t]he key feature of Harvey, for purposes of this ground, is its disclosures of a community creator being able to add content to a community before the community is created and launched.” Petition at 68 (emphasis in original). However, Petitioners’ statement is factually incorrect. The creation and subsequent launching of a given community are two separate actions. The addition of content to a given community occurs during the creation of the community, not before the creation of the community. Accordingly, while a community creator may add content to a community before it is launched, the community creator cannot add content to a community before the community itself is created. Petitioner’s expert statement is thus inaccurate and misleading.

In addition, Harvey is generally directed to web-based community creation (Harvey, 7:49-56, 8:49-50), in which a user can establish a connection with a community, among other ways, “through browser access to an appropriate website.” Harvey, 29:59-62. As such, Harvey suffers from the same deficiencies as Neibauer. Thus, even if one were to combine the teachings of Harvey with Neibauer (and any other remaining references), such a combination would still fail to teach or suggest at least limitation 1[B]..

G. Holistic Assessment of *Fintiv* Factors and Considerations Weighs in Favor of Denying Institution

On balance, the evidence of record favors exercising discretion to deny institution of the ‘535 IPR on *Fintiv* grounds.

VI. CONCLUSION

Appropriate analysis based on the evidence of record under the frameworks described in CTPG for parallel petitions, *General Plastic* for follow-on petitions, *Advanced Bionics* for § 325(d), and *Fintiv* independently favors exercising discretion to deny institution of the ‘535 IPR.

Date: May 7, 2025

Respectfully submitted,

/Erick Robinson/

Erick Robinson, Esq. (Reg. No. 51,354)

Jayne Partridge (Reg. No. 39,011)

Jayne C. Piana (Reg. No. 48,424)

Patrick M. Dunn (Reg. No. 70,474)

BROWN RUDNICK LLP

811 Main Street, Suite 1850

Houston, TX 77002

Tel: (281) 815-0511

Fax: (281) 605-5699

Homayoon Rafatijo (Reg. No. 80,870)

BROWN RUDNICK LLP

1900 N Street NW

Washington, D.C. 20036

Tel: (202) 536-1724

Fax: (202) 536-1701

Attorneys for Patent Owner

Mobile Data Technologies LLC

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), the undersigned hereby certifies that the foregoing Patent Owner's Discretionary Denial Brief contains 13,405 words using the word count feature of Microsoft Word.

Date: May 7, 2025

Respectfully submitted,

/Erick Robinson/

Erick Robinson, Esq. (Reg. No. 51,354)

Attorneys for Patent Owner

Mobile Data Technologies LLC

CERTIFICATE OF SERVICE

I hereby certify that on May 7, 2025, I caused a true and correct copy of the foregoing Patent Owner's Discretionary Denial Brief to be served via electronic mail upon the following attorneys of record for the Petitioners:

Lori Gordon (Reg. No. 50,633)
Goodwin Procter LLP
1900 N St. N.W.
Washington, D.C. 20036
Phone: (202) 346-4000
Fax: (202) 346-4444
Gordon-ptab@goodwinlaw.com

Doug Kline (Reg. No. 35,574)
GOODWIN PROCTER LLP
100 Northern Avenue
Boston, MA 02210
Phone: (617) 570-1000
Fax: (617) 523-1231
dkline@goodwinlaw.com

Naomi Birbach (Reg. No. 67,113)
Goodwin Procter LLP
620 Eighth Avenue
New York, NY 10018
Phone: (212) 813-8800
Fax: (212) 355-3333
NBirbach@goodwinlaw.com

Srikanth Reddy
(*pro hac vice* application to be filed)
GOODWIN PROCTER LLP
100 Northern Avenue
Boston, MA 02210
Phone: (617) 570-1000
Fax: (617) 523-1231
sreddy@goodwinlaw.com

Date: May 7, 2025

Respectfully submitted,

/Erick Robinson/

Erick Robinson, Esq. (Reg. No. 51,354)
BROWN RUDNICK LLP
811 Main Street, Suite 1850
Houston, TX 77002
Tel: (281) 815-0511
Fax: (281) 605-5699

*Attorneys for Patent Owner
Mobile Data Technologies LLC*