UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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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

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PATENT OWNER'S REPLY
IN SUPPORT OF DISCRETIONARY DENIAL

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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 *Inter Partes* 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 *Inter Partes* 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 *Sotera* 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 *Sotera* stipulation (April 18, 2025)
2031	Reserved
2032	Petitioners' proposed *Sotera* 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 *Inter Partes* 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)
2036	Petition for Inter Partes Review in IPR2025-00537 (Feb. 3, 2025)
2037	Declaration of Mahdi Eslamimehr for IPR2025-00535 of U.S. Patent No. 9,032,039
2038	Petitioners' expert declaration from the '541 IPR

Ex.	Description
2039	Petitioners' expert declaration from the '537 IPR
2040	Order of the EDTX court denying Samsung's Motion for Relief from Protective Order
2041	Redacted version of Samsung's Motion for Relief from Protective Order filed in the EDTX-Litigation (May 29, 2025)
2042	Patent Owner's and Meta's February 21, 2025 joint email to the Board regarding the settlement of the MDT-Meta-Litigation and Meta-MDT-IPRs
2043	Reserved
2044	Reserved
2045	File History of Ex Parte Reexamination of U.S. Patent 8,793,336
2046	Petitioner's Authorized Reply to Patent Owner's Preliminary Response (IPR2021-00917, Paper 7, Sept. 22, 2021)
2047	Declaration of Kevin Jakel in IPR2021-00917 (May 11, 2021)
2048	E-mail from Petitioners' counsel re Updated Sotera Stipulation

I. Petitioners' Challenge to the Director's Bifurcated Process

The AIA grants the Director authority to "interpret[] [] statutes related to the Patent Office's decision to initiate inter partes review." *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45 (2020). This authority includes the discretion to determine whether to institute an IPR trial. 35 U.S.C. §314(a). Petitioners' challenge to the Director's interim process therefore amounts to a challenge "regarding how to exercise" this very institution discretion. *Cf. Apple Inc. v. Vidal*, 63 F.4th 1, 13 (Fed.Cir.2023) (discussing appellate review of institution decision).

II. Petitioners' Inconsistent Ranking and *General Plastic* Arguments

Inconsistent Ranking: Petitioners' claim their inconsistent ranking is justified, R. 17, misses the point. Petitioners' arguments for all challenged claims, including claims not challenged by Meta, are a copy-and-paste of Meta's arguments. Ex.2011. For example, Petitioners recycle Meta's argument against claim 19 for claim 1, which Meta did not challenge. *Compare* Paper 4 ("P4"), 9-40*, with* Ex.2034, 12-43. Petitioners' "additional investment" argument (R.17) therefore fails.

***General Plastic*: Factor 1.** Petitioners' attempt to distance themselves from the Meta-MDT-IPRs is disingenuous. First, in the '535-IPR, Petitioners recycled Meta's arguments even for claims not challenged by Meta. *Compare* P4, 9-40*, with* Ex.2034, 12-43. Petitioners advance Meta's interests by asserting Grounds 3-4 solely to account for Meta's claim constructions in the MDT-Meta-Litigation.

Petition, 67. Petitioners have thus tied their interests to Meta's and their after-the-fact attempt to untie them, by suggesting the Board need not consider Grounds 3-4 (R.36), should not be rewarded. Finally, a significant relationship exists between Petitioners and Meta as both are members of Unified Patents LLC, a company that files *ex parte* reexam requests for its members. Ex.2046, 1 n.2; Ex.2047, ¶¶2-3. Like Meta and Petitioners, Unified attempted to invalidate the '336 Patent (the great-grandparent of the '039 Patent) but failed. Ex.2045, 341-42.

Factor 2, Petitioners claim they did not attempt joinder to the Meta-MDT-IPRs because they did not have "an adequate opportunity to analyze PO's patent infringement claims." R.23. Petitioners' IPR positions, however, are not guided by PO's infringement contentions because Petitioners challenge several claims from the '039 Patent not asserted by PO in the EDTX-Litigation.

Factor 3, Petitioners' claim that they are not using PO's filings in the Meta-MDT-IPRs to "shift … the prior art asserted and the related arguments in [their] follow-on petition" is untrue. R.23-24. For example, Petitioners expressly use PO's arguments in the Meta-MDT-IPRs to add Ausems to the Neibauer Grounds. R.33-34, DD, 16. Petitioners are, thus, improperly using PO's arguments as a roadmap.

Factors 4-5, Petitioners' claim that "they were concerned with the possibility that PO would propose different constructions in the MDT-Meta-Litigation and in the Meta-MDT-IPR" and thus delayed filing of the '535-IPR rings hollow. R. 25.

Petitioners' Ranking Notice claims that the '***536-IPR***, not the '535-IPR, addresses PO's Meta-MDT-IPR constructions.[1] Paper 3 ("P3"), 4. Accordingly, Petitioners need not have waited for PO's Meta-MDT-IPR constructions to file the '535-IPR, and thus their 8-month delay in filing the '535-IPR is unjustified. Even if it were, PO filed its Meta-MDT-IPR Response on October 1, 2024, and Petitioners still do not explain their additional 4-month delay to file the '535-IPR.

Factors 6-7, Petitioners' reliance on *Micron Tech.* is misplaced. R.27. The '535-IPR is not "the only IPR before the Board." Further, Petitioners' Ranking Notice cited PO's allegedly different constructions for "mobile device" to justify parallel petitions. P3, 4. Petitioners cannot change positions now by stating PO proposed different constructions for "application-based information channel." R.7.

III. Petitioners' *Advanced Bionics* Arguments

Neibauer/Cheng/Squibbs were cited during prosecution of the '039 patent, as Petitioners admit. R.28. Further, they were raised in a reexam of the great-grandparent of the '039 Patent, the '5,801 reexam. The Examiner of the '039 Patent considered the record of that proceeding while examining the '039 Patent. Ex.1022, 197. In the '336 Patent reexam, Unified cited the same Neibauer disclosures Petitioners use in the '535-IPR. Ex.2045, 65. The Examiner of the '336 reexam

[1] Petitioners do not rebut advancing identical claim constructions in both petitions.

considered these arguments and confirmed the '336 patent's patentability. Ex.2045, 341-42. The Board should not disturb the determinations of two Examiners.

Petitioners wrongly claim the Board's earlier institution of an IPR on the '039 Patent demonstrates material error. R. 30. While the standard for patentability is preponderance of evidence, the standard for institution is lower: "reasonable likelihood of success as to one claim." Under Petitioners' theory "the reasonable likelihood standard of §314(a) and the second part of the *Advanced Bionics* framework ('material error') would collapse into one." *Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper 7, 20 (P.T.A.B. July 11, 2023).

IV. Petitioners' Yahoo! System Invalidity Contention

Petitioners do not dispute the '535 Petition has been repackaged as system art in the district court invalidity contentions. They argue, however, they "have not decided what prior art they will ultimately pursue." R.48-49. This situation, however, exemplifies the problem Petitioners created in this case. Petitioners' admission that estoppel does not apply under *Ingenico*, even with their stipulation, only underscores the insufficiency of their stipulation to mitigate any concerns of duplicative efforts. Even more relevant, however, is that at 10:30 AM on the very day this Reply was filed, Petitioners served an eleventh-hour stipulation materially different from the one PO addressed in its DD brief. Ex.2048. Petitioners have done so despite representing to the Board "Petitioners will file an exact copy of the [April

18, 2025] *Sotera* stipulation" just 4 days ago. R.48 n.7. Petitioners had PO's *Sotera* arguments for 40 days and could have addressed them in their Response. Their delay should not be rewarded; the late stipulation must be rejected. Further, Petitioners should have filed their late stipulation "as soon as practicable" and before PO filed its DD brief. FAQ #14. To allow PO to address the late stipulation, Petitioners request additional briefings. If the Director decides this request is proper given the deadline for DD decision, PO will show this new stipulation is inadequate. If the Director decides otherwise, PO requests Petitioners' late stipulation be stricken.

V. Petitioners Invite the Board to Speculate About the PO-Meta Settlement

Petitioners' contention that PO and Meta terminated Meta's IPRs "on the eve of oral argument" (R.9, 53) is untrue. PO/Meta jointly informed the Board of the settlement on February 21, 2025, before the deadline for motions to exclude and well before the oral argument date. Ex.2042. PO did not even file a sur-reply. Settling is not gamesmanship. CTPG, 86. Petitioners' argument that "it is reasonable to infer that PO settled…because it knew that Meta's arguments were strong on the merits and that it settled to avoid an adverse [FWD]" is mere speculation. Petitioners made this same argument in the EDTX-Litigation to de-designate the MDT-Meta settlement agreement so they could use it in this IPR, and the court rejected it (Ex.2040). PO had a settled expectation of the Asserted Patents' strength, because the '336 Patent survived the reexam initiated by Petitioners' proxy, Unified.

Date: June 17, 2025

Respectfully submitted,

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I hereby certify that on June 17, 2025, I caused a true and correct copy of the foregoing Patent Owner's Reply in Support of Its Discretionary Denial Brief to be served via electronic mail upon the following attorneys of record for the Petitioners:

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