

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

IPR2025-00541
U.S. Patent No. 9,922,348

**PETITIONERS' RESPONSE TO PATENT OWNER'S
DISCRETIONARY DENIAL BRIEF**

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
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1003	Excerpts from Alan Neibauer, <i>How to Do Everything With Yahoo!</i> (2000) (“Neibauer”)
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1005	U.S. Patent No. 7,574,486 B1 to Yin Cheng et al. (filed November 8, 2000, issued August 11, 2009) (“Cheng”)
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I. Introduction

This is precisely the type of situation where *inter partes* review is an efficient use of Board resources for at least two reasons. First, the Board has already found that there is a reasonable likelihood that all of the claims challenged here are invalid. Specifically, the Board instituted IPR against all claims of U.S. Patent 9,922,348 (“’348 patent”) on June 11, 2024 based on a petition filed by Meta Platforms, Inc. *See* IPR2024-00250 (the “Meta-MDT-IPR”), Paper 11. Patent Owner (“PO”) is a Patent Assertion Entity (PAE) who continues to assert the challenged patent despite the Board’s prior finding. Second, the Examiner erred by failing to identify or apply the art set forth in the Petition, and as a result, none of this art was considered during prosecution.

PO cannot credibly claim that it had settled expectations as to the validity of the challenged patent. PO has owned the patent for less than three years and has been defending it against invalidity challenges for nearly as long as it has owned the patent. Nor is PO entitled to the benefit of any settled expectations of prior owners of the patent. Even if it was, there is no evidence that the prior owners had such settled expectations. For example, two patents in the same family as the challenged patent were invalidated by the Board years ago, with both decisions affirmed on appeal by the Federal Circuit. Accordingly, to the extent there were any settled expectations concerning the validity of the ’348 patent, such

expectations included that the patents were, at most, of questionable validity.

Moreover, the accused product in the litigation (Petitioners’ “Samsung Members” application) was launched in 2016 with no claim for patent infringement asserted by PO at any point until 2024. Unlike Petitioners, neither PO nor its predecessors ever commercialized or applied the claimed technology in any way. Therefore, all of the reasons set forth in the Director’s recent guidance in *Intel Corp. v. Proxense LLC*, IPR2025-00327, 328, 329, Paper 12, 2-3 (PTAB June 26, 2025), weigh against discretionary denial.

Indeed, the facts here against discretionary denial are at least as strong as those presented in *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, -219-222, -339, Paper 10, 3 (Stewart June 13, 2025). In *Tesla*, the Director did not exercise discretion to deny institution because IPR was instituted on three ancestor patents to the challenged patent. *Id.* Here, the Board *instituted* IPR on the challenged patent and the Board has *invalidated* two patents in the same family with both findings summarily affirmed on appeal. As in *Tesla* the FWD date here would be after the likely trial date. And as in *Tesla*, the complexity of the district court case – where 70 claims are asserted across 5 different patents – weighs in favor of institution despite the FWD date. Put simply, the Director’s decision in *Tesla* cannot be reconciled with any decision exercising discretion to deny this petition.

Finally, the Director should not exercise discretion to deny the petition because doing so would reward PO's gamesmanship. PO sued Petitioners in the Eastern District of Texas on June 10, 2024 – a date strategically timed to prevent Petitioners from realistically conducting the diligence necessary to evaluate whether to join the Meta-MDT-IPR. The Meta-MDT-IPR was scheduled for oral argument on March 11, 2025. But, just days before the hearing, PO settled its dispute with Meta, thus avoiding a FWD invalidating claims of the '348 patent (and other related patents challenged by Meta). Through its discretionary denial brief, PO essentially seeks the Director's assistance to yet again avoid an invalidity finding against the '348 patent. PO even goes so far as to accuse Petitioners of abusing the IPR process. Yet it is PO that has attempted to game the system—rather than proceed to a FWD in the Meta-MDT-IPR, PO settled with Meta right before the hearing, which completely belies any argument by PO about the supposed strength of its patent.

Exercising discretionary denial against a patent for which the Board already instituted IPR would directly contradict Congress's purpose in enacting the AIA, which sought to "improv[e] patent quality and provid[e] a more efficient system for challenging patents that should not have issued." (EX-1037, 39-40.) PO's gamesmanship should not be rewarded. Indeed, exercising discretion to deny the pending petition would perversely incentivize patent owners facing instituted *inter*

partes review to settle such proceedings (while still straining Board resources through the institution phase) and file serial litigation against another defendant in the same technical field in order to inoculate their patents from Board review.

Accordingly, the Director should decline to exercise discretionary denial and refer a three-member panel of the Board to consider the merits of the Petition.

II. Factual Background

A. Samsung Is an Innovator

Samsung is one of the most innovative companies in the world. In the United States alone, Samsung has been awarded over 145,000 patents—the most of any company. Samsung commercializes these innovations into hundreds of products and services across dozens of industries, including smartphones, cellular base stations, televisions, semiconductors, batteries for consumer products and electric vehicles, and household appliances like refrigerators, dishwashers, microwaves, and washing machines.

B. Patent Owner Mobile Data Technologies LLC

PO is a Delaware limited liability company founded July 15, 2019. (EX-1038; EX-1039, ¶1.) According to PO, it “specializes in mobile technologies and social media solutions.” (EX-1039, ¶1.) However, PO has no online presence (no website or social media) and provides no products or services relating to “mobile technologies and social media solutions” or otherwise. Indeed, PO admitted in

litigation that it has no product that practices the alleged invention of the '348 patent. (EX-2026, 11 (“MDT does not assert that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention.”).)

Since its creation, PO’s only publicly known activity appears to have been the April 1, 2022 purchase of six related patents, including the '348 patent (*see* EX-1040), and, as discussed further below, the subsequent assertion of those patents against Meta in November 2022 and against Petitioners in June 2024.

PO’s litigation efforts are funded, at least in part, by a litigation funder named LIT-US Chisum 22-B LLC (“Chisum”); PO assigned a security interest in the '348 patent to Chisum on September 29, 2022, just before PO filed suit against Meta. (EX-1041.) Chisum’s business is to fund patent litigations. (*See, e.g.*, EX-1042 (*Entangled Media* Dkt. No. 254), 1 (“[Plaintiff] has received and continues to receive litigation funding from non-party LIT-US Chisum 22-B LLC ... with respect to this litigation.”); EX-1043 (*Electrolysis* Dkt. No. 147), 3 (“[Plaintiff] entered into a financing transaction in September 2022, a portion of which included granting a security interest in the '494 Patent to LIT-US CHISUM 22-B LLC”).)

C. PO's Prior Proceedings Against Meta

1. MDT Sues Meta in the MDT-Meta-Litigation

On November 23, 2022, PO sued Meta Platforms, Inc. (“Meta”) and Meta Platforms Technologies, LLC alleging infringement of the ’348 patent, among other patents.¹ (EX-1044.) PO accused “Defendants’ social media mobile applications and related software, including without limitation those made available under the Facebook brand” of infringement. (*Id.*, ¶88.)

2. The Instituted IPR Proceeding Against the ’348 Patent

On December 6, 2023, Meta filed an IPR petition challenging all claims (1-20) of the ’348 patent. IPR2024-00250, Paper 2. Ground 1 challenged claims 1-3, 6-9, 12-14, and 17-18 based on Neibauer, Ausems, and Cheng; Ground 2 challenged claims 4-5 based on those references in further view of Squibbs; Ground 3 challenged claims 10-11, 15-16, and 19-20 based on the Ground 1 references in further view of McElfresh. *Id.*, 3. Meta also raised Grounds 4-6 in further view of Harvey to account for a potential construction of “*web-based*

¹ PO originally sued Meta in the Western District of Texas. Judge Albright granted Meta’s motion to transfer to the Northern District of California. Prior to settlement, the case was captioned *Mobile Data Techs. LLC v. Meta Platforms, Inc.*, No. 3:24-cv-00896-WHA (N.D. Cal.) (the “MDT-Meta-Litigation”).

shared information channel” Meta proposed in the MDT-Meta-Litigation. *Id.*, 3, 10.

On June 11, 2024, the Board instituted IPR of the ’348 patent. IPR2024-00250, Paper 11. In so doing, the Board declined PO’s request to exercise discretionary denial under §325(d), “disagree[ing] with Patent Owner that all of the references Petitioner is relying on are the same or substantially the same as references that were before the Office.” *Id.*, 14. The Board noted that “there is no dispute that Ausems and McElfresh were not considered by the Office.” *Id.* The Board also rejected PO’s argument that Ausems is substantially the same as US 7,277,927 to Rensin et al., and that McElfresh is substantially the same as US 2005/0171645 to Dowling et al., which were presented during prosecution. *Id.*, 14-16.

On the merits, the Board found that “Petitioner [Meta] demonstrates a reasonable likelihood of prevailing in its challenge to independent claim 1 under 35 U.S.C. § 103(a) as obvious over Neibauer, Ausems, and Cheng” *Id.*, 36. The Board stated that, “we are persuaded that Petitioner has demonstrated sufficiently for purposes of institution that the teachings of Neibauer, Ausems, and Cheng meet limitation 1[c],” which is the only limitation PO disputed pre-institution. *Id.*, 34.

The Board scheduled oral argument (for the ’348 and five other related patents asserted against Meta) for March 11, 2025. IPR2024-00250, Paper 12.

3. PO's and Meta's Conflicting and Changing Views on Claim Construction

In the MDT-Meta-Litigation and the Meta-MDT-IPR, the parties identified the following terms for construction. (EX-1025, 2-3; EX-1030, 8-16; EX-1033, 2-5.)

a. Mobile Device

MDT-Meta District Court	
PO	plain and ordinary meaning; alternatively, “a piece of handheld equipment”
Meta	“any type of portable information processing device capable of being configured for communication over a network, including but not limited to a mobile telephone, a personal digital assistant (PDA), a palmtop computer, a hand-held computer, a laptop computer, a tablet computer, a global positioning system (GPS) receiver or other GPS-based navigational device, an MP3 player or other type of audio player, a pager, a watch or other timepiece, a camera, or a portable game player”
Meta-MDT-IPR	
PO	“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”
Meta	construed based on express definition: “The term ‘mobile device’ as used herein is intended to include, without limitation, any type of portable information processing device capable of being configured for communication over a network”

b. “Web-Based Shared Information Channel”

In the Meta-MDT-IPR, Meta and PO agreed to the construction “a medium for transferring information accessible to more than one user via the web” which is consistent with the plain meaning of this term. (EX-1002, ¶38; EX-1030, 16; EX-1011, 25.)

4. PO and Meta Settle on the Eve of Oral Argument

On March 7, 2025, just four days before oral argument, PO and Meta filed a joint motion to terminate the IPR. IPR2024-00250, Paper 38. The parties concurrently filed a copy of the settlement agreement as EX-2024; the agreement has been sealed as business confidential information by the Board. IPR2024-00250, Paper 39.

D. The MDT-Samsung Texas Litigation

PO sued Petitioners for patent infringement on June 10, 2024 alleging infringement of the '348 patent, among other patents. *Mobile Data Technologies LLC v. Samsung Electronics America, Inc.*, No. 2:24-cv-435-JRG-RSP (E.D. Tex.). PO served infringement contentions on the '348 patent on September 4, 2024, asserting 11 claims.

III. Review of These Claims is an Efficient Use of Board Resources

Reviewing the challenged claims would be an efficient use of Board resources because the Board already determined in the Meta-MDT-IPR there is a

reasonable likelihood that the same claims challenged are invalid over the same prior art presented by Petitioners—Neibauer, Ausems, and Cheng. The Examiner thus erred in issuing these claims, and PO knows it. Facing an imminent adverse ruling against its litigation vehicle—the '348 patent—PO abruptly settled the Meta-MDT-IPR on the eve of trial and shifted tactics to once again avoid substantive review. The Board should not reward such maneuvering;.

A. The Board Previously Found a Reasonable Likelihood that the '348 Patent is Invalid

The Board already determined that “Petitioner [Meta] demonstrates a reasonable likelihood of prevailing in its challenge to independent claim 1 under 35 U.S.C. § 103(a) as obvious over Neibauer, Ausems, and Cheng.” IPR2024-00250, Paper 11, 29-37. This previous finding confirms that the '348 patent is, at the very least, of questionable validity. The Board’s resources would therefore be well-spent picking up where it left off in the Meta-MDT-IPR.

The Board’s prior conclusion in the Meta-MDT-IPR is compelling evidence of unpatentability warranting IPR institution. *See Tesla v. Intell. Ventures II*, IPR2025-00217, Paper 10, 2. In *Tesla*, the Director refused to discretionarily deny because three prior IPR institutions against an ancestor patent, which terminated prior to FWD due to settlement, weighed in favor of unpatentability and against discretionary denial. *Id.* The decision was made even though a stay was unlikely and trial was likely to proceed prior to an FWD. *Id.* Petitioners here present an

even stronger prior art challenge than *Tesla*, especially because Petitioners' challenge is based on the same prior art and arguments that the Board already found persuasive in the Meta-MDT-IPR.

Indeed, the Board has, on multiple occasions, called into question the patentability of the '348 patent. Where *Tesla* involved IPRs for an ancestor patent only, the '348 patent itself was subject to institution in the Meta-MDT-IPR. As discussed above (§II.C.2), the Board determined "Petitioner [Meta] demonstrates a reasonable likelihood of prevailing in its challenge to independent claim 1 under 35 U.S.C. § 103(a) as obvious over Neibauer, Ausems, and Cheng." IPR2024-00250, Paper 11, 29-37. Further, the *Tesla* challenge included just one overlapping reference, whereas this Petition is based on the same three references the Board relied upon in instituting the Meta-MDT-IPR. And, as in *Tesla*, the Meta-MDT-IPR was terminated before a FWD due to settlement.

The Meta-MDT-IPR alone confirms the strength of Petitioners' prior art challenge, but it is not the only instance where the Board cast doubt on the patentability of the '348 patent. In 2012, Facebook (predecessor to Meta) filed an *inter partes* reexamination request for US 8,135,801 ("the '5801 patent"), ancestor to the '348 patent. The Examiner found all 20 original claims and 11 claims added by amendment were either anticipated or rendered obvious in part by Neibauer. (EX-1024, 14.) This finding was affirmed by the Board and the Federal Circuit on

appeal. (*Id.*, 14, 18-19.) Where the ancestor IPRs in *Tesla* never reached a final decision on patentability, the unpatentability of the '5801 patent was determined by the Examiner, the Board, and the Federal Circuit. As a result, the history supporting unpatentability not only favors institution, it outweighs other factors in the same way it did in *Tesla*.

B. The Examiner Erred in Issuing the '348 Patent

Petitioners respectfully submit that the Examiner materially erred in allowing the claims of the '348 patent.

The Examiner's first error was in failing to identify Ausems as relevant prior art. Had the Examiner located and reviewed these references, the claims would not have issued. The Examiner's second error is in overlooking the teachings of Neibauer and Cheng, which were cited in IDSs initialed by the Examiner. Had the Examiner actually analyzed the claims in view of Neibauer and Cheng, he would have realized that the claims were invalid. But for the Examiner's failure to identify Ausems and apply the teachings of Neibauer and Cheng to the challenged claims, the '348 patent would not have issued. Petitioners' prior art renders obvious each of limitations [1D]-[1F] identified as missing from the prior art in the Notice of Allowance. (EX-1022, 256; Petition, 22-34.) In other words, the Examiner erred by overlooking the teachings of Neibauer, Cheng, and Ausems that "impact patentability of the challenged claims." *Advanced Bionics, LLC v. MED-*

EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6, 8 n.9 (PTAB Feb. 13, 2020).

The Examiner’s material error in missing the teachings of Neibauer and Cheng is confirmed by the fact that the Board already instituted IPR of the ’348 patent, concluding that “Petitioner [Meta] demonstrates a reasonable likelihood of prevailing in its challenge to independent claim 1 under 35 U.S.C. § 103(a) as obvious over Neibauer, Ausems, and Cheng.” IPR2024-00250, Paper 11, 29-37; *see also Therabody, Inc. v. Hyperice IP Subco, LLC*, PGR2024-00053, Paper 8, 10 (PTAB Apr. 21, 2025) (“We agree with Petitioner that the Examiner did not identify the pertinence of Mabuchi’s disclosure and did not issue a rejection based on such disclosure or combined teachings, and that this constitutes Examiner error.”).

Relying on the same disclosures identified by Petitioners here, the Board concluded, based on the record before it, that “the combination of Neibauer, Ausems, and Cheng” disclosed the contested and uncontested limitations of claim 1. *See* IPR2024-00250, Paper 11, 29-35. The Examiner therefore materially erred in allowing the claims to issue.

C. Patent Owner is a PAE that Continues to Assert the ’348 Patent Despite the Board’s Prior Finding

Mobile Data Technologies, LLC is a PAE whose business model relies on collecting revenue from innovative companies like Samsung. As discussed above,

PO has no online presence, provides no products or services relating to “mobile technologies and social media solutions” or otherwise, and has no product that practices the alleged invention of the ’348 patent. (EX-2026, 11 (“MDT does not assert that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention.”).)

PO purchased the ’348 patent, along with five other patents in the same family, on April 1, 2022 (*see* EX-1040) and immediately asserted the patents against Meta. When Meta came too close to invalidating the patents PO hoped would provide its only source of revenue, PO settled and shifted its focus to Petitioners. Despite knowing the ’348 patent is weak, PO continues to enforce it against innovative companies, wasting both innovator and Board resources. Indeed, PO asserts 70 claims across five patents in the parallel district court proceeding. The Board is best situated to handle PO’s overbroad enforcement of its weak patent. If this Petition is discretionarily denied, PO will no doubt continue its enforcement campaign against other innovators, risking the possibility that the Board will once again be asked to review the claims of the ’348 patent. Thus, it would be a prudent use of Board resources to nip PO’s practices in the bud by finally determining the patentability of the ’348 patent.

IV. The “Settled Expectations” of the Original Patent Owner do Not Inure to a PAE that Recently Acquired a Patent, Particularly in PO’s Case

PO cannot reasonably claim to have “settled expectations” in the validity of a patent which it had been actively litigating for more than 2.25 out of the 2.8 years it had owned the patent at the time this Petition was filed. (*Compare* EX-1040, with EX-1044.) PO’s purported “settled expectations” belong to the original patent owner and did not transfer to PO when it acquired the ’348 patent solely for the purpose of monetizing it through litigation in which validity was certain to be a contested issue. The parties’ settled expectations thus weigh against discretionary denial.

PO acquired the ’348 patent on April 1, 2022. It then quickly sued Meta less than eight months later on November 23, 2022. PO knew when it bought the ’348 patent that innovators like Samsung would not simply lie down in the face of an infringement allegation. Indeed, a PAE in particular would understand that challenges to validity are common occurrences in patent litigation, and would thus have no expectation, let alone a “settled” expectation, that the validity of its patent would go unquestioned in any enforcement action. *Cf. Anaheim Gardens, L.P. v. United States*, 953 F.3d 1344, 1350-51 (Fed. Cir. 2020) (“the timing of the purchase and knowledge of the purchaser”—especially “a sophisticated investor”—“are relevant considerations in determining whether a purchaser had reasonable investment-backed expectations” in the takings context); *Nordlinger v.*

Hahn, 505 U.S. 1, 12-13 (1992) (“[A]n existing owner rationally may be thought to have vested expectations in his property or home that are more deserving of protection than the anticipatory expectations of a new owner at the point of purchase.”).

By the time it acquired the ’348 patent in April 2022, the patentability of the ’348 patent had been called into question on multiple occasions. (*Supra* §III.A.) Twelve years prior, Facebook sought reexamination of the ’5801 patent, resulting in a finding that all twenty claims were unpatentable in part over Neibauer. (EX-1024, 14.) That finding was later affirmed by both the Board and the Federal Circuit. (EX-1024, 14, 18-19.)

The ’348 patent’s vulnerability was further confirmed by the Board’s 2020 decision finding all claims of another related patent, U.S. Patent No. 7,908,342 (ancestor to the ’348 patent) unpatentable. *See RPX Corp. v. Publishing Techs., LLC*, IPR2018-01131, Paper 44 (PTAB Jan. 7, 2020); *RPX Corp. v. Publishing Techs., LLC*, IPR2018-01132, Paper 43 (PTAB Dec. 2, 2019); *both aff’d Publishing Techs. LLC v. RPX Corp.*, No. 2020-1420, -1421 (Fed. Cir. Apr. 9, 2021). Had PO conducted any sort of due diligence prior to purchasing the ’348 patent, it would have discovered these proceedings. Thus, to the extent there were any settled expectations of the parties concerning the validity of the ’348 patent, such expectations included that the patents were, at most, of questionable validity.

PO's "settled expectations" post-acquisition are equally nonexistent. Besides the fact that PO has been litigating the '348 patent for almost the entirety of its ownership, PO should have been convinced beyond a doubt that the '348 patent was at risk when the Board instituted the Meta-MDT-IPR.

PO argues "institution of [the] Meta-MDT-IPRs does not undermine PO's settled expectation" because the standard for institution is "reasonable likelihood of success" as to one challenged claim versus the "preponderance of the evidence" standard required to invalidate all claims. (PO Br., 42 n.13.) PO clearly does not even believe its own argument, given that it settled the Meta-MDT-IPR on the eve of trial, most likely because it expected Meta to succeed on the merits and wanted to avoid an FWD finding the claims unpatentable.

Petitioners' settled expectations weigh heavily against discretionary denial in this case. The Director's recent guidance in *Intel Corp. v. Proxense LLC* is enlightening. IPR2025-00327, 328, 329, Paper 12, 2-3 (PTAB June 26, 2025). In *Intel*, the Director explained:

There may be persuasive reasons why the Board should review challenged claims several years after their issuance date. For example, ... a patent may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner's particular technology space, if at all. These non-exclusive examples provide considerations that weigh against a patent owner's claim of settled expectations and bears on the Director's discretion.

Id.

Here, PO admitted in litigation that it has no product that practices the alleged invention of the '348 patent. (EX-2026, 11.) And to Petitioners' knowledge, the '348 patent was never commercialized by PO's predecessor. Further, Petitioners first introduced the Samsung Members application that PO accuses of infringement in April 2016.² (EX-1039, ¶27; EX-1056.) Despite this, neither PO nor its predecessor ever asserted the '348 patent against Petitioners during the life of the patent, which issued on March 20, 2018 and expired in June 2023. (*See* EX-1001; PO Br., 44.) PO instead waited until June 2024 to sue (EX-1047)—a full year after the patent expired, and over eight years after Petitioners first introduced Samsung Members. Analogizing to real property law, the settled expectations of an alleged violator would exceed those of the property owner under such circumstances. *See, e.g.*, Restatement (First) of Prop. § 459 cmt. a (1993) (“Through lapse of time old rights become obscure. A long continued use raises reasonable expectations of its continuance.”). Petitioners' consistent and

² The core functionality PO accuses of infringement—users sharing content with each other on mobile phones—existed as of April 2016. (*Compare* EX-1039, ¶27 (“Connect and share with others in the community”), *with* EX-1056, 3 (“Community provides a forum for Galaxy users around the world to talk freely with each other about anything related to Samsung products.”)).

continuous use of the accused products, with no competing commercialization or enforcement for eight years should weigh heavily against discretionary denial. *See Intel*, IPR2025-00327, Paper 12, at 2-3. Petitioners had no reason to believe they would be sued for infringement and relied on these settled expectations for many years.

PO also argues that the age of the patent weighs in favor of discretionary denial. But PAEs like MDT should not benefit from strategically waiting to acquire and assert weak patents against innovative companies such as Samsung. The mere passage of time does not transform a low-quality patent into a stronger one. Granting weight to MDT's so-called "settled expectations"—especially when Petitioners' accused products were publicly available well before MDT's formation (*see* EX-1038)—would be contrary to the public interest. Such reasoning would encourage PAEs to delay enforcement and assert patents only late in their life cycle, instead of promptly addressing alleged infringement. Adopting MDT's argument would send the wrong message, effectively rewarding entities for acquiring questionable patents late in their term simply to shield them from *inter partes* review.

Under these circumstances, the age of the '348 patent weighs against discretionary denial. It certainly should not be treated as determinative in MDT's favor. *See, e.g., Tesla, Inc. v. Navy*, IPR2025-00341, Paper 12 (Stewart June 13,

2025(no discretionary denial for 18-year-old patent); *Tesla v. Intell. Ventures II*, IPR2025-00217, Paper 10 (same for 14-year-old patent).

V. Discretionary Denial Would Contradict the Purposes of the AIA

Nearly 15 years ago in 2011, Congress passed the Leahy-Smith America Invents Act (“AIA”) to address flaws in the patent system. Of particular concern was the proliferation of low-quality patents and the corresponding rise in abusive enforcement. *See, e.g., Thryv, Inc v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020) (“Congress, concerned about overpatenting and its diminishment of competition, sought to weed out bad patent claims efficiently.”); EX-1037, 39-40 (“[Q]uestionable patents [were] too easily obtained and too difficult to challenge.”). With these concerns in mind, Congress identified as one of the primary goals of the AIA “establish[ing] a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.” (EX-1037, 40.)

A critical part of the AIA’s new system was the creation of the PTAB and IPR process, which was designed to combat general flaws in the patent system like low patent quality and costly and inefficient district court litigation, as well as problems directly associated with enforcement of low quality patents such as forum shopping and the economic impact of such litigation. (*See* EX-1037, 40.)

A. Weeding out Bad Patents and Providing an Alternative to Costly and Inefficient District Court Litigation

In passing the AIA, Congress recognized that the USPTO, constrained by limited time and resources, had increasingly allowed the issuance of patents that did not meet the statutory standard. IPR (along with the AIA’s new Post-Grant Review proceeding) would provide a system “for challenging [these] patents that should not have issued,” “improv[ing] patent quality and restor[ing] confidence in the presumption of validity that comes with issued patents in court.”(EX-1037, 39-40, 48.) As the Supreme Court acknowledged, “inter partes review protects ‘the public’s paramount interest in seeing that patent monopolies are kept within their legitimate scope.’” *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 584 U.S. 325, 336-37 (2018) (quotation omitted).

Congress also enacted IPR to alleviate the high costs associated with defending patent infringement claims in district court, costs that frequently exceed millions of dollars regardless of patent quality. (*See* EX-1037, 40 (AIA designed to “establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs”).) IPR was expressly intended to provide a “quick and cost effective alternative[] to litigation,” (EX-1037, 48), allowing accused infringers to challenge patents early and at significantly reduced expense. The AIA ensured that proceedings before the PTAB would be streamlined and time-limited, providing that final decisions must

be issued within 12-18 months of institution. 35 U.S.C. § 316(a)(11). This expedited framework allows accused infringers to avoid the burdens of lengthy district court litigation, instead resolving disputes at a fraction of the cost and time typically required in Article III courts. (*See* EX-1037, 40.)

B. Curbing Forum Shopping and Reducing Economic Impact of Litigating Bad Patents

Through creation of the PTAB and IPR, Congress aimed to curtail litigation tactics like forum shopping and reduce the economic impact of the litigation of low-quality patents on innovators and the judicial system.

Congress created in the PTAB a centralized administrative forum for post-grant validity challenges. By enabling accused infringers to challenge questionable patents through IPR, with its procedural efficiencies and a lower burden of proof than district court litigation (preponderance of the evidence rather than clear and convincing), the AIA was intended to substantially diminish the strategic advantage of filing in any particular district court.

When “patents that should not have issued” (EX-1037, 39-40) are litigated, they waste time and money that innovators could otherwise spend on R&D, as well as the judicial resources required to maintain sometimes years-long infringement suits.

The AIA’s creation of the PTAB and IPR and limitations on joinder served to improve patent quality, reduce the costs and inefficiencies of district court

litigation, and curb forum shopping—benefits Congress recognized would disincentivize litigation of low quality patents and thus reduce its economic impact on innovators and the judicial system. (*See, e.g.*, EX-1037, 39-40 (“[Q]uestionable patents [were] too easily obtained and too difficult to challenge.”); EX-1045, 56 (noting the importance of the AIA to “address this problem of nonpracticing entities that we believe exploit flaws in the current patent system”).

C. Congress Deliberately Set a One Year Statutory Bar to Give Petitioners a “Reasonable Opportunity” to Prepare Their Case

Congress held healthy debates over the length of time that a litigant defending patent infringement claims would have to file an IPR petition. In the bill passed in the Senate, litigants had 6 months to file an IPR petition. The final bill extended this provision to one year for reasons summarized in the Congressional Record:

High-technology companies, in particular, have noted that they are often sued by defendants asserting multiple patents with large numbers of vague claims, making it difficult to determine in the first few months of the litigation which claims will be relevant and how those claims are alleged to read on the defendant's products. Current law imposes no deadline on seeking inter partes reexamination. And in light of the present bill's enhanced estoppels, it is important that the section 315(b) deadline afford defendants a reasonable opportunity to identify and understand the patent claims that are relevant to the litigation.

(EX-1046, 29 (Sen. Kyl).)

VI. Petitioners Filed Parallel Petitions to Address PO’s Alternative Constructions of “Mobile Device”

As noted above, PO proposed differing constructions for “*mobile device*” in the Meta-MDT-IPR and the MDT-Meta-Litigation, despite the fact that the same claim construction standard applies in both proceedings. (*See* Petition, 6-7; 37 CFR § 42.100(b).) Petitioners filed their petitions within four months of being made aware of PO’s revised claim construction positions in its Response, and within weeks after the deadline for the last brief due in the Meta-MDT-IPR. To address PO’s different constructions, Petitioners concurrently filed this Petition and the IPR2025-00542 Petition, in which Petitioners explained how fundamentally different prior art renders obvious the challenged claims under PO’s narrower construction. In particular, Petitioners explained how the Randall-Forsyth and Pelkey-Eck combinations disclose a “*mobile device*” even under PO’s overly narrow Meta-MDT-IPR construction. IPR2025-00542, Paper 3, 20; *see also id.*, EX-1003, ¶¶96-97; *id.*, Paper 3, 64-65; *see also id.*, EX-1003, ¶191.

Petitioners filed parallel petitions challenging the ’348 patent so that PO could not strategically select which claim construction position to pursue depending on what references Petitioners presented. Petitioners’ position is consistent with the approach endorsed by the Board in at least *Apple Inc. v. Resonant Sys. Inc.*, IPR2024-00698, Paper 9, 13-14 (PTAB Oct. 21, 2024) (instituting two petitions that relied on “fundamentally different” prior art where

patent owner advanced differing claim constructions, reasoning that “it would not serve the public’s interest to institute on only one petition and thus create a situation where Patent Owner could argue against one obviousness ground in one petition in a manner that would undermine Patent Owner’s position against Petitioner’s other obviousness ground in the other petition.”). For example, if PO’s narrower Meta-MDT-IPR construction of “*mobile device*” is adopted, the Board could potentially conclude that the Neibauer grounds raised in this Petition do not satisfy that limitation, whereas the prior art in the IPR2025-00542 petition directly covers a “*mobile device*” under PO’s narrower construction. In short, institution of both petitions will ensure fairness and deny PO the opportunity to engage in further gamesmanship.³

For the ’348 patent, Petitioners ranked the instant Petition higher than the IPR2025-00542 Petition to minimize the burden on the Board and PO if no FWD issued in the Meta-MDT-IPR. (*See* Paper 4, 2.) The grounds and challenged claims in the this Petition are the same as those in the Meta-MDT-IPR, so the Board will

³ Petitioners acknowledge the Director’s recent decision in *CrowdStrike, Inc. v. GoSecure, Inc.*, IPR2025-00068, -070, Paper 25 (Stewart June 25, 2025) that required a claim construction prior to institution, and a decision by the Board to institute on at most one petition. While Petitioners believe institution of both of its Petitions on the ’348 patent is warranted, Petitioners understand that the Board may institute on one Petition after making a claim construction determination.

not need to invest additional time and resources into analyzing new prior art. While Petitioners prefer to proceed with the grounds set forth in the IPR2025-00542 Petition, they are prepared to proceed on the grounds set forth in IPR2025-00541 if that is the Board's preference.⁴

VII. Discretionary Denial Is Not Warranted Under *General Plastic*

The Director should decline to exercise discretionary denial under *General Plastic* because Petitioners do not have a significant relationship with Meta, which necessarily outweighs the remaining factors. See *Videndum Prod. v. Rotolight*, IPR2023-01218, Paper 12, 5-6 (Vidal Apr. 19, 2024) (“[W]here, as here, the first and second petitioners are neither the same party, nor possess a significant relationship under *Valve*, *General Plastic* factor one necessarily outweighs the other *General Plastic* factors.”). Even considering the remaining factors, discretionary denial is still inappropriate.

A. Factor One: Petitioners Have No Significant Relationship With Meta

Factor one considers “whether the same petitioner previously filed a petition directed to the same claims of the same patent.” Petitioners clearly are not the same

⁴ PO complains that Petitioners “inconsistently” ranked their IPR petitions across five related patents, one of which is the '348 patent. (PO Br., 50.) Petitioners are not aware of any authority dictating how Petitioners should rank petitions across different patents, and PO cites no such authority.

party as Meta, and PO does not contend otherwise. Nor has PO put forth any evidence that Petitioners and Meta are parties to a joint defense group or have any relevant commercial relationship (and they are not).

Petitioners and Meta were never co-defendants in the same case, and PO's infringement allegations are based on completely different products. (*Compare* EX-1039, ¶27 (accusing “a social media application and software known as Samsung Members”), *with* EX-1044, ¶88 (accusing Meta's “social media mobile applications and related software, including without limitation those made available under the Facebook brand.”).)

PO instead argues that Petitioners have a “significant relationship” with Meta that was “implicitly created” because of the common grounds in Petitioners' and Meta's respective Petitions.⁵ (PO Br., 4-7.) But the Board has consistently recognized that this is not a basis for finding that discretionary denial is appropriate. *Pat. Quality Assurance, LLC v. VLSI Tech. LLC*, IPR2021-01229,

⁵ PO also claims Petitioners “implicitly tied their interest to that of Meta” by including Harvey in Ground 2 to account for Meta's claim construction for “*mobile information channel*” in the MDT-Meta-Litigation. (PO Br., 7.) As discussed below (§VIII.D), because Meta settled and is no longer pursuing its litigation construction of “*web-based shared information channel*,” Petitioners agree that Ground 2 need not be considered by the Director or the Board so long as Petitioners do not advance the Meta litigation construction.

Paper 10, 8 (PTAB Jan. 26, 2022) (finding that “factor 1 weighs somewhat against discretionary denial because Petitioner has not filed a prior petition, but did copy its substantive grounds from a prior petition.”); *Splunk, Inc. v. Sable Networks, Inc.*, IPR2021-01469, Paper 11, 8 (PTAB Mar. 10, 2022) (“we disagree that the framework from *General Plastic* favors denying institution.... because this is the first time this petitioner has challenged the ’790 patent, and Petitioner’s alleged copying of the earlier-filed petitions is not enough to fairly characterize Petitioner’s relationship with the [prior] petitioners as significant enough to warrant exercising our discretion to deny institution.”).

Moreover, in the two cases that PO cites to support its relationship argument (PO Br., 4-7), the Board found the existence of a relationship between petitioner and an earlier petitioner based on facts that do not exist here.

In *Valve*, Valve and HTC were co-defendants in district court litigation and “were accused of infringing the ’934 patent based on the same product.” *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11, 9-10 (PTAB, Apr. 2, 2019). HTC filed a petition challenging the ’934 patent; the Board denied institution “because HTC failed to show a reasonable likelihood of prevailing in establishing the unpatentability of at least one challenged claim.” *Id.*, 1. Valve subsequently filed its own petition challenging the same claims. *Id.* Under *General Plastic* factor one, the Board found “a significant relationship between Valve and

HTC with respect to Patent Owner’s assertion of the ’934 patent” because they were co-defendants in the same litigation and accused of infringing the same product. *Id.*, 10. The Board thus concluded that under factor one, “[t]he complete overlap in the challenged claims and the significant relationship between Valve and HTC favor denying institution.” *Id.*

Here, the second factual predicate to *Valve*’s factor-one analysis does not exist. Petitioners and Meta are not the same party and have no “significant relationship” relating to PO’s assertion of the ’348 patent. Unlike in *Valve*, Petitioners and Meta were never co-defendants in the same case and PO’s infringement allegations are based on completely different products. (*Compare* EX-1039, ¶27, *with* EX-1044, ¶88.)

PO’s reliance on *Ericsson*, a non-precedential opinion, fares no better. *Ericsson Inc. v. Uniloc 2017, LLC*, IPR2019-01550, Paper 8 (PTAB Mar. 17, 2020). There, Ericsson’s petition came after other defendants in separate litigation had filed multiple petitions against the same patent, and at the time the Board decided *Ericsson* in March 2020, those related IPRs were still pending. *See id.*, 3 (listing related proceedings.) This case is distinguishable from *Ericsson* for the same reason it is distinguishable from *Valve*: the Meta-MDT IPR was instituted but terminated prior to a FWD as a result of settlement.

Moreover, numerous panels have recognized *Ericsson* as an outlier decision limited to its specific facts. *See, e.g., Pat. Quality Assurance*, IPR2021-01229, Paper 10, 10 (PTAB Jan. 26, 2022) (“[*Ericsson*] has not been designated as precedential or informative by the Board, and other decisions have determined that factor 1 weights against discretionary denial for an independent petitioner.”). *Ericsson* is likewise inapplicable here; no relationship exists between Petitioners and Meta.

B. Factor Two: No Evidence Petitioners Were Aware of the Prior Art

Factor two considers “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.” This factor weighs against discretionary denial. As PO admits, “Meta filed the Meta-MDT-IPRs before the Complaint was filed against Petitioners.” (PO Br., 8.)

PO also argues that Petitioners could have joined the Meta-MDT-IPR. (PO Br., 8.) But PO’s strategic filing of its suit against Petitioners—just four weeks before the July 11, 2024 joinder deadline (*see* EX-1047)—deprived Petitioners an adequate opportunity to analyze PO’s patent infringement claims and determine how best to proceed before that joinder deadline passed.

Indeed, Petitioners’ answer in the district court was not even due until October 7, 2024 (because Samsung Electronics Co. Ltd. agreed to waive service).

(EX-1048.) And as noted above, Petitioners did not receive PO's infringement contentions on the '348 patent until September 4, 2024.

C. Factor Three: Petitioners Are Not Using PO's Submissions in the Meta-MDT-IPR to Strategically File Follow-On Petitions

Factor three, which considers “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,” also weighs against discretionary denial.

The Board’s main concern under factor three is “the shifts in the prior art asserted and the related arguments in follow-on petitions. Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.” *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, 17 (citation omitted). Specifically, in *General Plastic*, the Board sought to prevent petitioners from “strategically stag[ing] their prior art and arguments in multiple petitions, using our decisions as a roadmap, until a ground is found that results in the grant of review.” *Id.*

Not surprisingly, PO’s brief ignores this reasoning in *General Plastic*—because this articulated potential for abuse is not present here. Petitioners are not using follow-on petitions to search for “a ground ... that results in the grant of review”—the Board already found that such grounds exist when it instituted the Meta-MDT-IPR. Moreover, PO had a full and fair opportunity, including with

expert testimony, to address the prior art presented here and in the Meta-MDT-IPR. And, if IPR is instituted here, PO will be able to submit a further response. There is no prejudice to PO, so the fact that Petitioners previously saw PO's submissions in the Meta-MDT-IPR is irrelevant under factor three.

D. Factors Four and Five: The Lapse In Time Before Petitioners Filings Was Proper

Factor four considers “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,” and factor five considers “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.” Foremost, these factors are not relevant here because Petitioners did not file the earlier petition—Meta did—and Petitioners have no significant relationship with Meta, as discussed above. *See supra* §VII.A.

Regardless, Petitioners' delayed filing the Petition because they were concerned with the possibility that PO would propose different constructions in the MDT-Meta-Litigation and in the Meta-MDT-IPR. In the MDT-Meta-Litigation, PO proposed “*mobile device*” broadly to mean “a piece of handheld equipment.” (EX-1025, 3.) However, in the Meta-MDT-IPR, PO proposed a new, narrower construction, clearly intended to exclude Meta's cited prior art: “a portable device with limited display space and limited navigational capabilities that connects to a

mobile site and/or mobile information channel via a wireless network.” (EX-1030, 9.) Petitioners had to take PO’s new construction into account, ultimately resulting in the filing of concurrent IPR petitions with different prior art to account for PO’s different constructions. (See Paper 4 (identifying parallel petitions against ’348 patent).)

PO also repeats its argument that Petitioners should have joined the Meta-MDT-IPR. (PO Br., 9-10.) However, as discussed above, PO filed its original complaint against Petitioners—alleging infringement of four different patents—a mere three weeks before the Meta-MDT-IPR joinder deadline, leaving little opportunity for Petitioners to evaluate PO’s claims.

E. Factors Six and Seven: The Amount of Additional Work to Be Performed by the Board Is Minimal

Factor six considers “the finite resources of the Board.” Factor seven considers “the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.” There is little additional work for the Board to do with respect to this Petition. The Board instituted IPR against the ’348 patent (and other related patents) previously, and Meta and PO settled just four days before oral argument. The Board is therefore already familiar with the art raised in this Petition. See *Micron Tech., Inc. v. Sonrai Memory Ltd.*, No. IPR2023-00909, Paper 7, 9 (PTAB Nov. 28, 2023) (“*General Plastic* factors 6 and 7 also weigh against

denying institution. The previous IPR terminated after institution due to settlement.

... Because this Petition is now the only IPR before the Board challenging the '421 patent, we agree with Petitioner that this case provides an efficient means for resolving patentability ... without unnecessarily straining the Board's limited resources.").

VIII. Discretionary Denial Is Not Warranted Under *Advanced Bionics*

PO makes the same *Advanced Bionics*-type arguments that the Board already rejected in the Meta-MDT-IPR, concluding that “[w]e disagree with Patent Owner that all of the references Petitioner is relying on are the same or substantially the same as references that were before the Office.” IPR2024-00250, Paper 11, 14.

The Director should decline to exercise discretionary denial under *Advanced Bionics*, as the Board previously did when instituting IPR based on the same references. (*See supra* §III.A.) As discussed below, for each of the references cited in the Petition, the relevant *Beckton*, *Dickinson* factors weigh against discretionary denial.

A. Ausems

As in the Meta-MDT-IPR, PO concedes that Ausems was not considered during prosecution. IPR2024-00250, Paper 11, 14. Petitioners primarily cite Ausems to account for the situation where “PO contend[s] incorporation of digital

cameras into mobile devices was not well-known as of June 2002,” because “Ausems discloses a mobile device that incorporated a digital camera for recording, storing, and transmitting digital images.” (Petition, 24.) If PO concedes that incorporation of digital cameras into mobile devices was known before the ’348 patent, the Board need not consider Ausems for this purpose.

Petitioners also rely on Ausems to show that “each mobile device could have been ‘a *GPS-based navigational device*’” as recited in claim 6. (Petition, 36.) PO argues that Ausems’ disclosure is cumulative of Squibbs. (PO Br., 26.) But, as noted below, the Examiner provided no substantive analysis of Squibbs; he certainly did not rely on Squibbs’ teaching of “a GPS system built into the cell phone” to reject issued claim 15. (EX-1011, ¶¶98.) Because the Examiner materially erred by failing to consider the teachings of Squibbs during prosecution, PO cannot rely on Squibbs to argue that Ausems is cumulative of previously considered art.

B. Neibauer, Cheng, Squibbs

It is undisputed that the Examiner never applied Neibauer, Cheng, or Squibbs in any rejection during prosecution of the ’348 patent. Instead, the Examiner’s only acknowledgment of these references was an indication that they were “considered” along with hundreds of references submitted by Applicant in IDSs. (See EX-1022, 195 & 212 (Neibauer), 174 (Cheng), 177 (Squibbs).) The

number of references Applicant submitted is unusually large,⁶ yet Applicant never directed the Examiner to any specific disclosures in any of the IDS references, including, specifically, Neibauer, Cheng, and Squibbs.

Under these circumstances, *Becton, Dickinson* factors (c), (e), and (f) demonstrate that the Examiner materially erred in overlooking these references. *See Ecto World*, IPR2024-01280, Paper 13, 5 (“even when the asserted prior art is on an IDS, but the Examiner did not apply the reference,” “a petitioner must explain, with reference to *Becton Dickinson* factors (c), (e), and (f), how the Examiner erred in overlooking the prior art”).

Factor (c) considers “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection.” As noted above, none of Neibauer, Cheng, and Squibbs served as the basis for rejection during prosecution. *See, e.g., Ecto World*, IPR2024-01280, Paper 13, 5 (“a petitioner may argue that it satisfies the second part of *Advanced Bionics*

⁶ As the Director noted previously, “[m]ost IDS submissions contain fewer than 25 references. *See Setting and Adjusting Patent Fees During Fiscal Year 2025*, 89 FR 91898 at 91924 (Nov. 20, 2024) (‘Approximately 87% of applications contain 50 or fewer applicant-provided items of information, and approximately 77% contain fewer than 25 . . . [O]nly 4% of applications contain more than 200 applicant-provided items of information.’).” *See Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13, 7 n.3 (Stewart May 19, 2025).

because the asserted prior art was not a basis for rejection during examination ...”); *Therabody*, PGR2024-00053, Paper 8, 9 (“Despite Mabuchi being presented during prosecution, the fact that Mabuchi was not used as the basis of rejection weighs against exercising discretion to deny institution under § 325(d).”).

Factor (e) considers “whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art.” Petitioners respectfully submit that the Examiner materially erred in failing to reject the challenged claims because, as demonstrated in the Petition, Petitioners’ cited prior art—including Neibauer, Cheng, and Squibbs—renders obvious each and every limitation of the challenged claims. (*See* Petition, 9-66.) In particular, the Examiner erred because Petitioners’ prior art renders obvious each of the “*receiv[ing]*” [1D]/[1E] and “*integrat[ing]*” [1F] limitations identified as missing from the prior art in the Notice of Allowance. (EX-1022, 256.) In other words, the Examiner erred by ignoring the teachings of Neibauer, Cheng, and Squibbs that “impact patentability of the challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8 n.9 (PTAB Feb. 13, 2020).

The Examiner’s material error in overlooking the teachings of Neibauer and Cheng specifically is confirmed by the fact that the Board already instituted IPR of the ’348 patent, concluding that “Petitioner [Meta] demonstrates a reasonable likelihood of prevailing in its challenge to independent claim 1 under 35 U.S.C. §

103(a) as obvious over Neibauer, Ausems, and Cheng.” *See* IPR2024-00250, Paper 11, 29-36; *see also Therabody*, PGR2024-00053, Paper 8, 10 (“We agree with Petitioner that the Examiner did not identify the pertinence of Mabuchi’s disclosure and did not issue a rejection based on such disclosure or combined teachings, and that this constitutes Examiner error.”).

Relying on the same disclosures identified by Petitioners here, the Board concluded, based on the record before it, that “Neibauer, Ausems, and Cheng meet limitation [[1D]/[1E]]” and that “Petitioner has demonstrated sufficiently for purposes of institution that the combined teachings of Neibauer, Ausems, and Cheng meet the” remaining limitations. *See* IPR2024-00250, Paper 11, 29-35. The Examiner therefore materially erred in allowing the claims to issue.

Factor (f) considers “the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.” If the Director refers the Petition for consideration on the merits, the Board would not be reconsidering prior art arguments previously considered by the Examiner, as Neibauer, Cheng, and Squibbs are “not substantially the same as prior art the Examiner applied.” *Ecto World*, IPR2024-01280, Paper 13, 5. PO does not argue otherwise. Nor could it. The Examiner did not apply any prior art against the ’348 patent during prosecution, issuing only a non-statutory double patenting rejection

before allowing the claims. (EX-1022, 155-158.) Petitioners' prior art arguments cannot be the same as Examiner arguments that do not exist.

Accordingly, *Becton, Dickinson* factors (c), (e), and (f) weigh against exercising discretionary denial based on Neibauer, Cheng, and Squibbs. Because Petitioners' Ground 1 with these references covers all but one challenged claim, the Director need not consider PO's *Advanced Bionics* arguments for the remaining prior art references. For completeness, Petitioners will address PO's arguments.

C. McElfresh

PO also concedes, as in the Meta-MDT-IPR, that McElfresh was not considered during prosecution. IPR2024-00250, Paper 11, 14. Instead, PO argues that McElfresh is cumulative of WO 2001/082139 to Sahota. (PO Br., 21-23.) During the Meta-MDT-IPR, PO unsuccessfully argued that McElfresh was substantially the same as another reference included in an IDS for the '336 patent. IPR2024-00250, Paper 11, 11. PO's second attempt is similarly unconvincing.

Sahota was merely marked as "considered" by the Examiner among hundreds of references submitted by Applicant. (EX-1022, 189.) The Examiner did not apply Sahota in any rejection. In fact, the Examiner never discussed the "data feed" limitations to which PO contends Sahota is relevant. Thus, *Becton, Dickinson* factor (c) weighs against denial. *See Ecto World*, IPR2024-01280, Paper 13, 5; *Therabody*, PGR2024-00053, Paper 8, 9.

McElfresh is not cumulative of Sahota. First, the disclosures PO points to in Sahota do not disclose a “*data feed*” as disclosed by McElfresh. In McElfresh, the advertisement and content integration is dynamic and includes features relevant to the claims, such as advertisement prioritization based on behavior and economics—a true “*data feed*.” (See, e.g., EX-1014, 2:39-3:6.) Sahota is not dynamic and is template-based. (See, e.g., EX-2047, ¶8.) This is important because, for example, claim 10 requires “*periodically*” obtaining data from the feed and claim 11 further requires that the periodically obtained data is an advertisement.

Further, Sahota does not disclose McElfresh’s technique for integrating advertisements into a webpage. (Petition, 54-56; see, e.g., EX-1014, Figure 1.) The word “advertisement” never appears in Sahota. And Sahota’s Figure 8A that PO points to is a preexisting web page, “xyz.com,” for a company to sell its products. (EX-2047, 22.) The list of products on “xyz.com” (jean jacket, big oxford, etc.) is not a separate inserted advertisement as contemplated by the claims.

D. Harvey

Petitioners added Harvey to Grounds 4-6 to account for a potential construction of “*web-based shared information channel*” proposed by Meta in the MDT-Meta-Litigation. (Petition, 8.) While PO baselessly accuses Petitioners of abusing the IPR process by doing so (PO Br., 23.), PO ignores that the MDT-Meta-

Litigation was still pending when Petitioners filed their Petition. IPR2024-00250, Paper 38 (Joint Motion to Terminate). Petitioners included Harvey to address the possibility of the Board adopting Meta’s proposed litigation construction. Because Meta settled, Petitioners agree that Grounds 4-6 need not be considered by the Director or the Board.

IX. Discretionary Denial Is Not Warranted Under *Fintiv*

A. Factor One is Neutral or Favors Petitioners

Factor one considers “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 6 (PTAB Mar. 20, 2020) (precedential). This factor is neutral because no litigation stay has been requested and no objective evidence exists regarding whether a stay in the litigation will be granted. The Board’s practice is not to speculate regarding how a motion to stay may be decided. *Google LLC v. Mullen Indus. LLC*, IPR2025-00021, Paper 14, 8-9 (PTAB May 14, 2025).

If Petitioners’ IPR Petitions are instituted, PO cannot credibly oppose a stay. Indeed, PO requested a stay of the MDT-Meta-Litigation pending IPR while the petitions were still pending. (EX-1050.) Specifically, PO told the court that it “believes that the institution decisions and any [FWDs] will simpl[if]y the issues in the case whether the IPRs are instituted, not instituted, or partially instituted. In other words, any outcome from the PTAB will streamline the relevant issues in this

proceeding.” *Id.*, 5. PO fails to acknowledge that Judge Gilstrap almost always grants uncontested motions to stay pending IPR. Specifically, Judge Gilstrap has granted over 88% (38/43) uncontested motions to stay pending IPR presented since 2014. (EX-1049.)

Here, a decision instituting IPR would take place on or around October 13, 2025. The *Markman* hearing is scheduled for October 30, 2025. Judge Gilstrap has granted motions to stay filed on similar timelines. *See, e.g., Commc’n Techs., Inc. v. Samsung Elecs. Am., Inc.*, No. 2:21-cv-00444-JRG-RSP, Dkt. No. 134, 1-2 (E.D. Tex. Feb. 2, 2023) (granting motion to stay 13 days before *Markman* hearing where IPR instituted seven weeks before hearing). Indeed, Judge Gilstrap has stayed cases based on IPR institution even after a *Markman* hearing where going forward would otherwise “risk[] an inefficient consumption of limited judicial resources.” *Netlist, Inc. v. Micron Tech., Inc.*, No. 2:22-cv-00203-JRG-RSP, Dkt. No. 493, 1 (E.D. Tex. Feb. 10, 2024) (*sua sponte* staying case pending IPR after issuing *Markman* opinion); *see also STA Grp. LLC v. Motorola Sols., Inc.*, No. 2:22-cv -00381-JRG-RSP, 2024 WL 2852961, *2 (E.D. Tex. June 5, 2024) (granting motion to stay after issuing *Markman* order).

PO wrongly argues that Petitioners’ decision not to file a motion to stay prior to a decision on institution means Judge Gilstrap is unlikely to stay the district court case. (PO Br., 26-29.) Judge Gilstrap routinely stays cases where the

motion to stay is first filed after IPR is instituted. *See, e.g., Cellspin Soft, Inc. v. ByteDance Ltd.*, No. 2:23-cv-00496-JRG-RSP, Dkt. No. 106, 5 (E.D. Tex. Jan. 26, 2025); *Broadphone LLC v. Samsung Elecs. Co., Ltd.*, No. 2:23-cv-00001-JRG-RSP, Dkt. No. 134, 1-2 (E.D. Tex. July 24, 2024). PO's reliance on *Saint Lawrence Commc'ns LLC v. ZTE Corp.*, No. 2:15-cv-349-JRG, 2017 WL 3396399, *2 (E.D. Tex. Jan. 17, 2017) is inapposite. As PO's brief acknowledges, the court criticized the defendant for waiting a month after IPR institution to file its motion to stay. (PO Br., 27-28.) In contrast, Petitioners anticipate filing a motion to stay within days after institution of its pending IPR petitions.

PO's argument that Petitioners' filing eight months after the PO initiated suit would result in denial of a motion to stay (PO Br., 28) is likewise contrary to Judge Gilstrap's practice. *See, e.g., Harbor Island Dynamic, LLC v. Samsung Elecs. Co., Ltd.*, No. 2:24-CV-00140-JRG-RSP, Dkt. No. 81, 1-2 (E.D. Tex. May 19, 2025) (granting motion to stay where petitions filed roughly seven months after complaint); *Broadphone LLC*, No. 2:23-cv-00001-JRG-RSP, Dkt. No. 134, 1-2 (granting motion to stay where petition filed 10 months after the complaint). The *Tessera* case relied on by PO is distinguishable. There, the PTAB had yet to render a decision on the IPR petitions. *Tessera Advanced Techs., Inc. v. Samsung Elecs. Co., Ltd.*, No 2:17-cv-00671-JRG, 2018 WL 3472700, *3 (E.D. Tex. July 19, 2018).

PO's argument that Judge Gilstrap is unlikely to stay the case because the FWD is expected after the trial date (PO Br., 28-29) is further contradicted by numerous recent cases. *See, e.g., Harbor Island Dynamic, LLC*, No. 2:24-CV-00140-JRG-RSP, Dkt. No. 81, 5 (granting motion to stay where trial scheduled for January 5, 2026 and FWDs expected in March and April, 2026); *Cellspin Soft, Inc.*, No. 2:23-cv-00496-JRG-RSP, Dkt. No. 106, 5 (granting motion to stay where trial was scheduled for August 4, 2025 and FWDs expected in September and October 2025); *Broadphone LLC*, No. 2:23-cv-00001-JRG-RSP, Dkt. No. 54, 4-6 (granting motion to stay case where trial was scheduled for February 10, 2025 notwithstanding expected FWD in May 2025).

Thus, at bottom, whether the parallel case will be stayed is still to be determined and the Board "will not attempt to predict how the district court ... will proceed" regarding potential stays "because the court may determine whether or not to stay any individual case ... based on a variety of circumstances and facts." *Sand Revolution II, LLC v. Cont'l Intermodal Grp.-Trucking LLC*, IPR2019-01393, Paper 24, 7 (PTAB Jun. 16, 2020); *see also Hulu, LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00298, Paper 11,11 (PTAB May 19, 2021) (because "neither party has produced evidence that a stay has been requested[,] " "[w]e decline to infer, based on actions taken in a different case with different facts, how

the District Court would rule should a stay be requested by the parties in the parallel case here.”) (partially quoting *Fintiv*).

B. Factor Two: The District Court’s Trial Date Is Uncertain

Factor two considers the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Fintiv*, IPR2020-00019, Paper 11, 6. The district court litigation is currently scheduled for trial on April 20, 2026 (EX-2016), which is approximately six months before the Board would issue a FWD if institution is granted. This date, however, is hardly certain—as it currently stands, Judge Gilstrap has a total of 10 patent infringement trials set for the week of April 20, 2026 and 7 patent infringement trials scheduled for April 6, 2026. (EX-1051.) So it is unlikely that Petitioners will proceed to trial at that time.

Statistics maintained by the “United States District Court – Judicial Caseload Profile” indicate that, as of March 31, 2025, the median time to trial in civil cases in the Eastern District of Texas is 25.9 months.⁷ (EX-1052, 35.) This projects a trial date around August 10, 2026, roughly two months before the

⁷ PO wrongly contends that the September 30, 2024 statistics (which state the median time to trial is 21.9 months) represent “[t]he most recent statistics” available. (PO Br., 37.) In any event, the data presented by PO (which is based on statistics as of September 30) and the most recent data (which is based on statistics as of March 31) each demonstrate that the median time to trial in the Eastern District is increasing.

expected FWD date. Where the district court trial is expected to take place around two months before the FWD date, the Board generally considers this factor to be neutral or weigh only “slightly” in favor of discretionary denial. *See, e.g., Hulu LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00158, Paper 9, 9-10 (Apr. 20, 2021) (granting institution where FWD was over one month after anticipated trial date, reasoning that where trial date and FWD data are at or around same time, efficiency and fairness concerns are not particularly strong and other factors should be considered); *Apple Inc. v. Koss Corp.*, IPR2021-00255, Paper 22, 10-12 (PTAB June 3, 2021) (granting institution where FWD expected two months after anticipated trial date); *Quibi Holdings, LLC v. JBF Interlude 2009 Ltd*, IPR2021-00231, Paper 10, 8 (June 7, 2021) (granting institution where FWD expected seven weeks after anticipated trial date).

The new USDC statistics moot PO’s reliance on *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13, 5-6 (PTAB Apr. 7, 2025), which found that factor 2 weighs in favor of discretionary denial where trial was expected about *four* months before the FWD. (PO Br., 31.) Even taking PO’s outdated statistics as fact, PO’s *SAP* argument fails because it omits that Petitioner argued in its briefing that the trial date would change because it had sought transfer (which was denied before the Board’s decision) – not because of court congestion. *SAP Am.*, IPR2024-01496, Paper 13, 6. And, in any event, the Board has previously

instituted IPR even in cases where the FWD issues four months after the projected trial date. *See, e.g., Zynga, Inc. v. IGT*, IPR2022-00199, Paper 11, 14 (PTAB June 14, 2022) (citing *Fintiv*, IPR2020-00019, Paper 11, 9) (instituting trial while weighing this factor as “slightly in favor of discretionary denial” where trial was scheduled four months before FWD); *Samsung Elecs. Co., Ltd. v. CardWare Inc.*, IPR2023-00211, Paper 13, 10 (PTAB Jun. 13, 2023) (instituting trial while weighing this factor as “marginally in favor of discretionary denial” when trial scheduled four months before FWD); *Nokia of Am. Corp. v. IPCOM, GmbH & Co. KG*, IPR2021-00533, Paper 10, 9 (PTAB Aug. 12, 2021) (instituting trial while weighing this factor as “slightly in favor of exercising discretion to deny institution” when trial may occur four months before FWD).

Further weighing against discretionary denial, the USPTO took almost ten weeks to issue the Notice of Filing Date Accorded to Petition (Paper 7). This stands in contrast to the roughly 20 days the Board was typically taking to issue such Notices over a studied three month period in 2024 and the 19-day historical average timeframe. (EX-1053, 2.) This delay was entirely outside Petitioners’ control and should not weigh in favor of discretionary denial. Had the notice issued in the historical average timeframe, the expected FWD date would have fallen within two weeks of the projected August 10, 2026 trial date, well within the bounds of what the Board has previously considered “around the same time as

[the] deadline to reach a final decision.” *See NeuMoDx Molecular v. HandyLab, Inc.*, IPR2020-01132, Paper 20, 13 (PTAB Apr. 19, 2021) (granting institution where FWD was expected 11 days after anticipated trial date).

Thus, at most, Factor 2 is neutral. Indeed, one study found that, when the Board exercised discretionary denial based on future trial dates, the Board incorrectly guessed the actual trial date 94% of the time (48 out of 51 discretionary denials). (EX-1054, 2.) Indeed, the Board has previously noted that “scheduled trial dates are unreliable and often change.” (EX-1055, 8)

C. Factor Three: Little Investment Relating to Invalidity Will Have Occurred in the Litigation by the Institution Deadline

The consideration of investment in parallel litigation focuses on efforts relating to invalidity issues raised in the Petition—not on litigation efforts generally. *See, e.g., Apple, Inc. v. Koss Corp.*, IPR2021-00381, Paper 15, 16 (PTAB July 2, 2021) (“On the current record, the District Court Lawsuit is still in the early stages, with very little investment pertaining to the invalidity issues raised in the Petition.”); *Dell Techs. Inc. v. WSOU Investments, LLC*, IPR2021-00272, Paper 13, 10 (PTAB July 1, 2021) (“much of [the parties’] invested effort is unconnected to the patentability challenges presented here”).

Here, by the October 2025 institution deadline, the amount of work related to invalidity in the district court litigation will remain minimal. To date, as PO concedes, the only invalidity-specific work is service of infringement and

invalidity contentions and Petitioners' service of third-party subpoenas. (*See* PO Br., 32.) Even by October 2025, "substantial work [will] remain[] to be done **as it relates to invalidity**: fact discovery is in its early stages, expert reports are not yet due, and substantive motion practice is yet to come." *Dell*, IPR2021-00272, Paper 13, 10 (emphasis added); *see also* EX-2016, 3-4 (fact discovery, expert report, and dispositive motion deadlines all occurring after September 2025).

PO wrongly contends that factor 3 is neutral where, as here, an institution decision will occur before a Markman hearing. Rather, under similar circumstances, the PTAB has found this factor to weigh against denying institution. *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15, 10-11 (PTAB Oct. 21, 2020) (precedential) (finding factor weighs against institution when no claim construction has issued and no significant discovery had been completed); *Samsung Elecs. Co., Ltd. v. Headwater Rsch. LLC*, IPR2024-01396, Paper 13, 7 (PTAB Apr. 1, 2025) (finding the fact that "claim construction proceedings will not have completed and the district court will not have issued any substantive orders" by the time of the institution decision "weighs against denial" despite "the parties [] likely [having] done some work"); *Mobileye Glob., Inc. v. Facet Tech. Corp.*, IPR2024-01110, Paper 16, 12-13 (PTAB Mar. 5, 2025) (weighing against denial and instituting in absence of claim construction and other substantive orders from district court).

Under this factor, PO complains again that Petitioners should have joined the Meta-MDT-IPR or filed the Petition earlier. (PO Br., 33-34.) As explained in *supra* §VII.D, due to PO’s strategic filing of the complaint against Petitioners just weeks before the Meta-MDT-IPR joinder deadline, Petitioners were given inadequate time to evaluate PO’s claims before that deadline passed. Nor did Petitioners have the ability to assess whether to join with the benefit of infringement contentions, which set forth the asserted claims. *Fintiv*, IPR2020-00019, Paper 11, 11 (“[I]t is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding.”) And, as explained in *supra* §VII.D, Petitioners justifiably waited to file the Petition to see if PO would shift any of its claim construction positions; PO did precisely that in the Meta-MDT-IPR, proposing a new and narrower construction for “*mobile device*.”

Accordingly, factor three weighs against discretionary denial.

D. Factor Four: Petitioners’ *Sotera* Stipulation Removes Any Overlap With the Litigation

On April 21, 2025, Petitioners stipulated, consistent with *Sotera*, “that if the [PTAB] institutes an *inter partes* review (‘IPR’) in either or both of IPR2025-00541 and IPR2025-00542 concerning U.S. Patent No. 9,922,348, then Samsung will not pursue in this litigation the grounds raised or any other grounds that could

have reasonably been raised before the PTAB in the instituted proceeding(s).” EX-2032. With this stipulation, *Fintiv* factor four weighs against discretionary denial.

PO raises procedural and substantive challenges to Petitioners’ *Sotera* stipulation, both of which are meritless. Procedurally, PO argues that, because Petitioners have not yet filed their *Sotera* petition (Petitioners await permission from the Board to do so), Petitioners have “prejudiced PO.” (PO Br., 36.) According to FAQs for Interim Processes for PTAB Workload Management (“April 2025 FAQs”), the purpose of filing a *Sotera* stipulation “as soon as practicable” is “so that a patent owner may address the impact of the stipulation in its discretionary denial brief.” April 2025 FAQs, Q-14. PO indisputably had an opportunity to—and did—address Petitioners’ stipulation in its discretionary denial brief. Thus, there is no prejudice to PO, and its procedural argument should be rejected.⁸

Furthermore, PO presently asserts 70 claims in five asserted patents in the co-pending litigation. PO will doubtlessly narrow its case in the district court prior

⁸ PO claims that Petitioners’ *Sotera* stipulation is a “proposed draft.” (PO Br., 36 n.11.) Not so. The April 21, 2025 letter from Petitioners’ counsel is clear and unwavering; there is no indication that the stipulation is simply a draft for consideration that is subject to change. (EX-2032.) Once granted permission, Petitioners will file an exact copy of the *Sotera* stipulation already provided to PO.

to trial—meaning that there will be claims addressed in the IPR proceedings that will not be addressed by the district court. The challenges to these unaddressed claims weigh against discretionary denial. *Palo Alto Networks, Inc. v. Centripetal Networks, LLC*, IPR2021-01157, Paper 10, 14 (PTAB Mar. 15, 2022) (declining to invoke § 314(a) and finding factor four weighs against discretionary “[t]aking into account the [*Sotera*-type] stipulation and the number of claims challenged in this proceeding that will not be addressed by the district court”). *See also Tesla v. Intell. Ventures II*, IPR2025-00217, Paper 10, 3 (denying request for discretionary denial, because, in part of the “large number and vast scope of the patents asserted in the district court litigation”).

Substantively, PO contends that Petitioners’ *Sotera* stipulation will not reduce overlap in proceedings because, in their preliminary invalidity contentions, Petitioners have asserted Yahoo! as product prior art in the litigation. (PO Br., 37.) PO’s argument assumes that, if institution is granted, Petitioners will present Yahoo! as product prior art in their expert reports and at trial. But this is pure speculation on PO’s part. Aside from Yahoo!, Petitioners have identified eight other prior art systems in their invalidity contentions. (EX-2027, 20-21.) Petitioners have not decided what prior art they will ultimately pursue in the district court case, particularly given that Petitioners’ invalidity expert report is not due until December 1, 2025. (EX-2016, 4.)

Amended Sotera Stipulation

Notwithstanding the foregoing, in view of the Director’s Decision Granting Patent Owner’s Request for Discretionary Denial and Denying Institution of Inter Partes Review in *Shenzen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00354, Paper 11, 2-3 (PTAB June 12, 2025), Petitioners agree that if IPR is instituted, they will not pursue in the related district court proceeding the grounds raised or any other grounds that could have reasonably been raised before the PTAB in the instituted proceeding(s) or any “combinations of the prior art asserted in these proceedings with unpublished system prior art.” Moreover, Petitioners agree that if IPR is instituted, they will not pursue in the related district court litigation any commercial prior art theory that is coextensive with prior art presented to the Board, including Yahoo!⁹

E. Factor Five: Petitioners Are Defendants in the E.D. Texas Litigation

Petitioners agree that they are defendants in the E.D. Texas litigation.

F. Factor Six: Other Circumstances Weigh Against Discretionary Denial

Factor six considers “other circumstances that impact the Board’s exercise of discretion, including the merits.” Petitioners address here the relevant considerations from the Director’s March 26, 2025 Memorandum.

⁹ Petitioners have offered this amended *Sotera* stipulation in each of IPR Nos. IPR2025-00535 – IPR2025-00544. (EX-1057.)

1. The Petition Presents a Compelling Case of Unpatentability

PO wrongfully argues that the Petition “lacks material claim limitations.” (PO Br., 56.) Unfortunately for PO, the Board already concluded in the Meta-MDT-IPR that “Petitioner has demonstrated sufficiently for purposes of institution that the combined teachings of Neibauer, Ausems, and Cheng meet” claim limitation [1F]—the only limitation PO contests here. IPR2024-00250, Paper 11, 34-35.

Emphasizing the point, PO’s sole argument for patentability is based on the misguided proposition that the claims require a “*content application*” that is itself “*personalized*.” (PO Br., 56-59.) PO did not raise this argument in the Meta-MDT-IPR. The Petition and Dr. Houh’s declaration discuss how Neibauer discloses an application that provides access to “*personalized content*”: “[u]nder the proposed combination, each club member would have used the web browsers on their mobile device to post personalized content using the club photo album feature. (Petition, 30-31; EX-1002, ¶129; Neibauer, p.477-479.)

PO also argues that Petitioners’ separate theory based on Neibauer’s Yahoo! Companion fails to disclose “*personalized content application*” for lack of motivation to combine Yahoo! Mobile with Yahoo! Clubs and Yahoo! Companion. (PO Br., 59-63.) Petitioners do not argue that Mobile, Clubs, and Companion must be “combined” to disclose a “*personalized content application*.” Instead, Neibauer

describes various features of Yahoo! which together teach the elements of the claim, including a homepage that can be personalized, meeting the “*personalized content application*” limitation.

PO finally argues that the remaining references do not cure the alleged deficiencies of Neibauer with respect to limitation [1B]. (PO Br., 63-65.) As PO acknowledges, however, Petitioners do not rely on those references for limitation [1B]. (PO Br., 58; *see also* Petition, 20-21.) PO’s arguments are irrelevant.¹⁰

2. PO Should Not Be Permitted to Game the System

PO repeatedly accuses Petitioners of “abus[ing] the IPR process” in at least the following ways:

- By declining to attempt to join the instituted IPR proceeding against the ’348 patent despite not having MDT’s infringement contentions. (PO Br., 9-10, 33, 48.)
- By filing two petitions to PO’s differing claim constructions. (PO Br., 43-47.)
- By ranking its two petitions on the ’348 patent in a manner different from its ranking as to the other challenged patents. (PO Br., 50.)

¹⁰ PO also argues that “Grounds 4-6 based on Harvey does not cure the deficiencies in Grounds 1-3.” (PO Br., 63.) As discussed above, the Director and the Board need not consider Grounds 4-6.

In addition, PO argues that the timing of Petitioners' *Sotera* stipulation "has substantially prejudiced PO," including because "PO had to invest time and resources to argue regarding the insufficiency of a not-yet-filed stipulation." (PO Br., 36, 48; *see also id.*, 43 ("Petitioners' abuse of the IPR process")). PO also argues that the Petition lacks merit. (PO Br., 54-65.)

But it is PO who has "gamed" the system by terminating the Meta-MDT-IPR mere days before oral argument due to settlement. On May 16, 2025, Petitioners asked PO to consent to Petitioners' filing of the Settlement Agreement as a sealed exhibit with this response. PO refused via email. The parties met and conferred on May 23, 2025 and reached an impasse on the issue.

Because motions cannot be filed without authorization (*see* 37 C.F.R. §42.20), Petitioners emailed the Board on May 28, 2025 and asked for permission to file a motion to compel production of the Settlement Agreement through the routine discovery rules that obligate PO to produce information inconsistent with a position advanced by PO in its opening brief. *See* 37 C.F.R. §42.51(b)(1)(iii). Despite the fact that Petitioners were prohibited from including substantive argument in their email to the Board seeking authorization to file their motion to compel,¹¹ on May 29, 2025, the Board denied Petitioners' request, stating that,

¹¹ *See* U.S. Patent & Trademark Office, Patent Trial and Appeal Board Boardside Chat: AIA Motions Practice, 7 (March 18, 2021),

“Petitioner has not provided sufficient relevance of the requested discovery to the Director’s discretionary considerations.” (EX-3101.) The Board, however, acknowledged that “[m]indful of any protective orders, Petitioner may discuss any fact or circumstance they believe bears on the Director’s discretion to institute, including what it believes to be inconsistent positions in Patent Owner’s discretionary denial brief, in its opposition.” *Id.*

By settling on the eve of trial, it is reasonable to infer that PO settled the Meta-MDT-IPR proceedings because it knew that Meta’s arguments were strong on the merits and that it settled to avoid an adverse FWD finding the challenged claims unpatentable. *See, e.g., My Health, Inc. v. ALR Techs., Inc.*, No. 2:16-cv-00535-RWS-RSP, 2017 WL 6512221, *5 (E.D. Tex. Dec. 19, 2017), *report and recommendation adopted*, 2018 WL 11327219 (E.D. Tex. Nov. 30, 2018) (quoting *SFA Sys., LLC v. Newegg Inc.*, 793 F.3d 1344, 1350 (Fed. Cir. 2015)) (noting, in a ruling finding the case exceptional, that patent owner’s practice of settling cases “right on the cusp of a merits determination ... supports the conclusion that [patent owner] was filing lawsuits ‘for the sole purpose of forcing settlements, with no intention of testing the merits of [the] claims’”). Indeed, if it felt it had a strong

https://www.uspto.gov/sites/default/files/documents/ptab_boardside_chat_aia_motions_practice_20210318.pdf.

case on the merits, PO should have proceeded to a FWD, which would have all but necessitated denial of this petition on §325(d) grounds.

3. No Forum Has Adjudicated the Validity of the Challenged Claims

That no forum has adjudicated the validity of the challenged claims of the '348 patent weighs against discretionary denial. The Board has already found that there is a reasonable likelihood that at least claim 1 is invalid based on Neibauer, Ausems, and Cheng. *See* IPR2024-00250, Paper 11, 29-36. Given this prior finding, allowing these suspect claims to stand unchallenged directly contradicts the purpose for which Congress created IPRs—"improving patent quality and providing a more efficient system for challenging patents that should not have issued." (EX-1037, 39-40.)

4. Petitioners' Reliance on Expert Testimony Provides Helpful Context to the Board

Petitioners' expert declaration provides helpful information regarding the unpatentability of the challenged claims. Indeed, Petitioners' expert declaration provides the same level of detail as Meta's expert's declaration, which the Board found helpful when instituting IPR against the '348 patent. *See* IPR2024-00250, Paper 11, 31-36 (citing 6 times to Meta's expert declaration, EX-1002). PO complains that Petitioners supposedly failed to follow the guidance set forth in the Board's April 25, 2025 FAQ-21 regarding expert testimony. (*See* PO Br., 51.) PO's arguments should be rejected.

First, PO faults Petitioners for not considering the Board’s FAQs in the Petition, but of course Petitioners could not have done so—the Petition was filed on February 6, 2025, nearly three months before the FAQs were published.

Second, the Petition’s reliance on expert testimony does not mandate discretionary denial. Instead, the Board’s FAQ-21 states only that “extensive reliance on expert testimony ... *may* suggest that the questions are better resolved in an Article III court.” April 2025 FAQs, Q-21. Under the specific facts of this case, Petitioners’ reliance on expert testimony is appropriate and helpful; as noted above, the Board previously cited similar testimony from Meta’s expert as helpful in deciding to institute IPR.

That the Board found the level of detail in Meta’s expert declaration (and, by extension, in Petitioners’ declaration) helpful is also consistent with the

Consolidated Trial Practice Guide (“CTPG”), which states:

Expert testimony may have many uses. For example, it may be used to explain the relevant technology to the panel. It may also be used to establish the level of skill in the art and describe the person of ordinary skill in the art. Experts may testify about the teachings of the prior art and how they relate to the patentability of the challenged claims. Expert testimony may also be offered on the issue of whether there would have been a reason to combine the teachings of references in a certain way, or if there may have been a reasonable expectation of success in doing so.

CTPG, 34-35.

Petitioners' expert declaration, like Meta's in the Meta-MDT-IPR, helpfully addresses many of these uses. For example, Dr. Houh identifies the qualifications and experience of a POSITA. (EX-1002, ¶¶31-32.), explains the teachings of the prior art and how they invalidate the challenged claims (*see, e.g.*, EX-1002, ¶¶42-71, 96-155 (Ground 1)), and details why a POSITA would have been motivated to combine the prior art with a reasonable expectation of success in doing so. (EX-1002, ¶¶72-95.) In short, Dr. Houh's expert declaration provides "helpful context" regarding the prior art (April 2025 FAQs, Q-21) and addresses key issues relating to the unpatentability of the challenged claims.

Third, PO improperly conflates the application of distinct claim language with factual inconsistency in arguing that Dr. Houh takes inconsistent positions across IPRs with respect to Neibauer's disclosure of "*mobile*," "*application-based*," and "*web-based*" information channels. (PO Br., 51-52, 56.) PO's reliance on *Google LLC v. Makor Issues & Rights Ltd.* and *Meta Platforms, Inc. v. Eight kHz, LLC* here is misplaced. (PO Br., 56.) In *Google*, patent owner took inconsistent positions across two proceedings regarding whether the ***same claim limitation*** was subject to interpretation under 35 U.S.C. § 112 ¶6. IPR2017-00815, Paper 31, 24 (PTAB Aug. 10, 2018). In *Eight kHz*, petitioner first argued that its reference lacked a certain limitation, only to later assert in a separate proceeding

that the same reference disclosed a similar limitation. IPR2023-01004, Paper 9, 29-30 (PTAB Jan. 9, 2024). Dr. Houh has made no such inconsistent statements.

Fourth, as discussed above, Dr. Houh provides helpful, focused testimony of how the combination discloses that “web browser applications on the mobile devices would have been applications that allowed club members to access personalized content,” including through Neibauer’s “personal photo album,” “personalized messages using the private message board,” “online chat with other club members,” and the Yahoo! Companion toolbar. (EX-1002, ¶¶129, 132.)

PO lastly points to three sentences in the Petition (out of the approximately 57 pages of merits argument) as alleged violations of the rule against incorporation by reference. (PO Br., 54.) PO is wrong. “One purpose of the prohibition against incorporation by reference is to eliminate abuses that arise from incorporation.” *Cisco Sys., Inc. v. C-Cation Techs. LLC*, IPR2014-00454, Paper 12, 10 (PTAB Aug. 29, 2014). “One of the abuses that arise from incorporation by reference is a pointless imposition on the Board’s time.” *Avant Tech., Inc. v. Anza Tech., Inc.*, IPR2018-00828, Paper 7, 16 (PTAB Oct. 16, 2018). There is no such abuse here. The sentences identified by PO clearly cite to expert testimony and identify the issues to which that expert testimony is relevant (limitations [1A] and [1B])—the Board need not guess the purpose of such testimony. Indeed, the Board already relied on similar testimony from Meta’s expert to institute the Meta-MDT-IPR.

X. Conclusion

For the reasons above, Petitioners respectfully submit that discretionary denial is inappropriate.

Date: July 14, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT UNDER 37 CFR §42.24(d)

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Opposition to Patent Owner's Discretionary Denial Brief complies with the type-volume limits of the March 26 Stewart Memorandum because it contains 13,797 words according to the word-processing system used to prepare this Opposition, excluding the words in the Table of Contents, Table of Authorities, List of Exhibits, Certification Under §42.24(d), and Certificate of Service. This word count was prepared using Microsoft Word.

Date: July 14, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that a true copy of Petitioners' Response to Patent Owner's Discretionary Denial Brief and any new exhibits identified in the above Table of Exhibits have been served on the Patent Owner via e-mail to the following counsel of record:

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