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

IPR2025-00542
U.S. Patent No. 9,922,348

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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EXHIBIT LIST

Ex.	Description
2001	E-mail serving amended infringement contentions in EDTX-Litigation
2002	Comparison between the specifications of the '348 and '578 Patents
2003	Petition for *Inter Partes* Review in IPR2025-00541 (Feb. 6, 2025)
2004	Reserved
2005	Return of Service filed in the EDTX-Litigation (June 21, 2024)
2006	E-mail from the Board regarding the 541 and 542 IPR panel assignments (May 2, 2025)
2007	Decision Granting Institution of *Inter Partes* Review in IPR2024-00250 (June 11, 2024)
2008	E-mail from Erick S. Robinson memorializing the phone conversation with Petitioners' counsel (September 26, 2024)
2009	Reserved
2010	Reserved
2011	Reserved
2012	Reserved
2013	E-mail exchange between Erick S. Robinson and Petitioners' counsel regarding a stay (October 17, 2024)
2014	E-mail exchange between Erick S. Robinson and Petitioners' counsel regarding a stay (February 19, 2025)
2015	E-mail exchange between Erick S. Robinson and Petitioners' counsel wherein Petitioners shared their motion to stay with Patent Owner (March 4, 2025)
2016	Second Amended Docket Control Order in the EDTX-Litigation (December 19, 2024)
2017	United States District Courts — National Judicial Caseload Profile (March 31, 2025)
2018	E-mail from Petitioners' counsel serving their initial and additional disclosures (October 16, 2024)
2019	E-mail from Petitioners' counsel serving their invalidity contentions (January 31, 2025)
2020	E-mail from Petitioners providing materials produced by third-party Microsoft Corporation and Sybase, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (April 25, 2025)
2021	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (March 7, 2025)

Ex.	Description
2022	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 24, 2025)
2023	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 21, 2025)
2024	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 11, 2025)
2025	E-mail from Petitioners providing materials produced by third-party AT&T Mobility LLC in response to Petitioners' subpoena in the EDTX-Litigation (February 5, 2025)
2026	Patent Owner's Infringement Contentions in the EDTX-Litigation (September 4, 2024)
2027	Petitioners' Invalidity Contentions in the EDTX-Litigation (January 31, 2025)
2028	E-mail exchange between Homayoon Rafatijo and Petitioners' counsel regarding Petitioners' contacting the Board for filing their proposed *Sotera* stipulation (April 21-23, 2025)
2029	E-mail from Petitioners' counsel with a draft of a proposed communication to the Board (April 30, 2025)
2030	E-mail from Petitioners' counsel sharing with Patent Owner their proposed *Sotera* stipulation (April 21, 2025)
2031	Reserved
2032	Petitioners' proposed *Sotera* stipulation for '541 and '542 IPRs (April 21, 2025)
2033	Petitioners' claim chart against '348 Patent based on the Nokia 9210 System (January 31, 2025)
2034	Reserved
2035	Summary of verbatim (or nearly verbatim) matches between the '542 petition to the Houh Declaration (Ex.1003)
2036	E-Mail from Petitioners providing Casio America, Inc.'s declarations certifying business records in response to Petitioners' subpoena in the EDTX-Litigation (May 9, 2025)
2037	Joel West & David Wood, *EVOLVING AN OPEN ECOSYSTEM: THE RISE AND FALL OF THE SYMBIAN PLATFORM* (2013)
2038	Bradston Henry, *Multiplayer Server Basics | Creating a Multiplayer Game Server - Part 1* (Oct. 25, 2021),

Ex.	Description
	https://dev.to/ibmdeveloper/multiplayer-server-basics-ep-1-creating-a-multiplayer-game-server-5aed
2039	Declaration of George Edwards in Regard to the Petitions for *Inter Partes* Review of U.S. Patent No. 9,922,348
2040	Order of the EDTX court denying Samsung's Motion for Relief from Protective Order
2041	Redacted version of Samsung's Motion for Relief from Protective Order filed in the EDTX-Litigation (May 29, 2025)
2042	Patent Owner's and Meta's February 21, 2025 joint email to the Board regarding the settlement of the MDT-Meta-Litigation and Meta-MDT-IPRs
2043	U.S. Design Patent 753,156 Assigned to Samsung
2044	Prosecution History of the U.S. Design Patent 753,156 Assigned to Samsung
2045	File History of Ex Parte Reexamination of U.S. Patent 8,793,336
2046	Petitioner's Authorized Reply to Patent Owner's Preliminary Response (IPR2021-00917, Paper 7, Sept. 22, 2021)
2047	Declaration of Kevin Jakel in IPR2021-00917 (May 11, 2021)
2048	Petition for Inter Partes Review in IPR2024-00250 (Dec. 6, 2023)
2049	Petitioners' expert declaration from the '536 IPR
2050	Petitioners' expert declaration from the '538 IPR

I. INTRODUCTION

On June 10, 2024, Patent Owner ("PO") filed a patent infringement complaint ("Complaint") Petitioners in the Eastern District of Texas ("EDTX"). *Mobile Data Technologies LLC v. Samsung Electronics Co.*, 2:24-cv-00435-JRG-RSP (E.D.Tex.) ("EDTX-Litigation"). ***The EDTX-Litigation will be tried six months before a final written decision ("FWD") is issued in this proceeding***. In the Complaint, PO asserted four patents: U.S. Patents 8,825,801 ("'801 Patent"), 9,032,039 ("'039 Patent"), 9,619,578 ("'578 Patent"), 9,922,348 ("'348 Patent"). PO served its infringement contentions for these patents on September 4, 2024. On October 6, 2024, PO filed an Amended Complaint, adding U.S. Patent 8,793,336 ("'336 Patent") to the EDTX-Litigation. That day, PO served its amended infringement contentions in which "[n]othing else was added other than a chart for the asserted claims of the '336 [Patent] and the file history for the '336 [Patent]." Ex.2001. PO refers to the patents asserted in the EDTX-Litigation as the "Asserted Patents." As shown in Figure 1 below, the Asserted Patents arise from a common family and share nearly identical specifications. *See* Ex.2002.

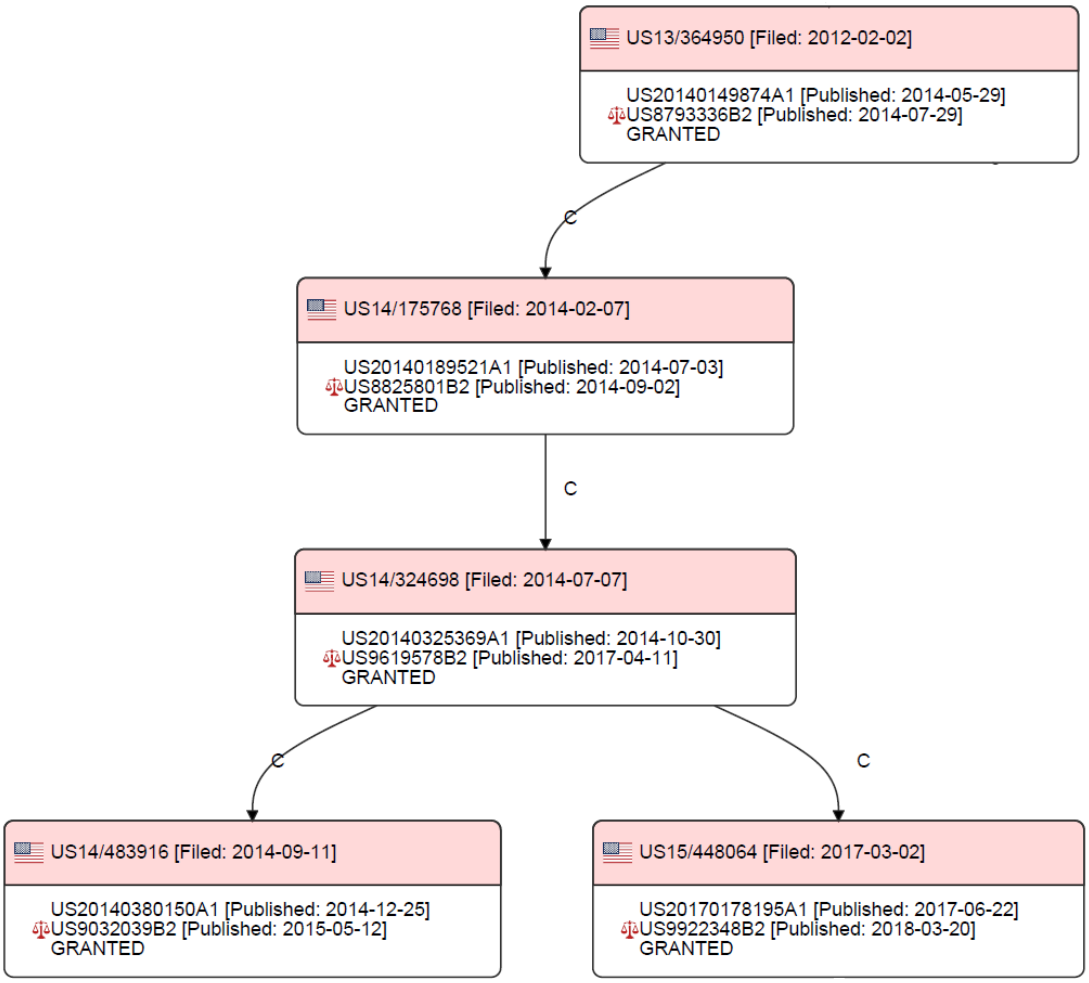

Figure 1. The Asserted Patents' family tree.

Petitioners have had notice of the family of the Asserted Patents before PO filed its Complaint in the EDTX-Litigation for at least two independent reasons. First, the great-great-grandparent of the '348 Patent, i.e., the U.S. Patent 8,135,801 ("'5801 Patent") was cited during the examination and appears on the face of the U.S. Design Patent 753,156 ("D156" Patent) to Petitioners. Ex.2043, 1. Second, Petitioners previously sought to invalidate the '336 Patent (the '348's great-grandparent) via an *ex parte* reexamination filed in June 2023 through Unified

Patents LLC ("Unified")—an entity in which Petitioners are members.

Despite the having notice of the Asserted Patents family for several years, Petitioners filed their IPR petitions against the Asserted Patents nearly eight months into the EDTX-Litigation, and after the service of invalidity and infringement contentions. Petitioners filed *ten* IPR petitions—two against each Asserted Patent—on what they characterize as "mutually exclusive grounds." Paper 3 ("Ranking"), 3. The first set asserts the Neibauer-based combinations ("Neibauer Grounds") that Meta Platforms, Inc. ("Meta") advanced in *Meta Platforms, Inc. v. Mobile Data Techs., LLC*, IPR2024-00250 (P.T.A.B. 2023) ("Meta-MDT-IPRs"), a proceeding since settled.[1] Petitioners concede this first set of petitions rests on "common references and arguments" recycled from the Meta-MDT-IPRs. Ranking, 5. Characterizing them as merely "common references and arguments" is too generous: Petitioners copied the Meta-MDT-IPRs petition almost word-for-word. The second set of petitions asserts invalidity grounds based on Randall-Forsyth and Pelkey-Eck combinations (collectively, the "Original Grounds"). Yet Petitioners

[1] PO and Meta jointly informed the Board of their settlement on February 21, 2025—before PO filing its sur-reply and before parties filing their motion to exclude. Ex.2042. The Board's guidelines on the discretionary denial process were announced over a month after the MDT-Meta-Litigation and Meta-MDT-IPRs were settled.

advance identical claim constructions in both the Original and Neibauer Grounds—Petitioners' proposed constructions appear verbatim in each petition. *Compare* Pet.5-7*, with* Ex.2003, 6-8.

For two independent reasons, the Board should exercise its discretion to deny institution of the '542-IPR:

1. Petitioners fail to adequately justify its parallel petitions and thus under the *Consolidated Trial Practice Guide* ("CTPG"), the "lower-ranked" '542 Petition should be discretionarily denied.

2. The *Fintiv* factors weigh heavily in favor of denial. The EDTX-Litigation is set for an April 2026 jury trial—six months before any *inter partes* review ("IPR") would conclude, even if the Board were to institute. There is substantial overlap between the '542-IPR and the EDTX-Litigation as Petitioners use system art in the EDTX-Litigation that corresponds to the references relied upon in the Petition. Furthermore, the Petition relies excessively on expert testimony and suffers from fatal weaknesses, as demonstrated below.

The Board should exercise its discretion and deny institution.

II. The Board Should Discretionarily Deny Institution of the Parallel, Lower-Ranked '542-IPR Asserting Original Grounds

The CTPG makes clear that multiple petitions against the same patent "should be rare," as parallel filings "place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns."

CTPG, 59. Pursuant to 35 U.S.C. §314(a), the Board exercises exclusive discretion to decide whether parallel petitions should proceed to institution. *Id.*, 61. The CTPG acknowledges only limited circumstances that may justify more than one petition. *Id.*, 59. None of those circumstances is present here, and Petitioners do not contend otherwise.[2]

Petitioners justify their parallel petitions ('541- and '542-IPRs) by pointing to a single factor from the April 19, 2024 *Notice of Proposed Rulemaking on Instituting Parallel and Serial Petitions*: "alternative claim constructions that require different prior art references on mutually exclusive grounds."[3] Ranking, 3. Yet, they admit

[2] In Petitioners' Notice of Ranking, they cited only "alternative claim constructions" to support their filing parallel petitions. Ranking, 2-3. Petitioners cannot add any other justifications for filing parallel petitions now. *See* CTPG, 59-60.

[3] Petitioners' claim that their twin petitions present mutually exclusive grounds is belied by their expert's use of Cheng (a prior art reference used for the Neibauer Grounds) in this IPR to establish "the general knowledge of a POSITA" as a gap-filler for the Original Grounds' shortcomings. Ex.1003, ¶¶81-83, 91-93.

that PO's construction for "mobile device"[4] in the Meta-MDT-IPRs is only "narrow[er]" compared to the construction advanced in the district court litigation between MDT and Meta ("MDT-Meta-Litigation")—not an "alternative construction." *Id.*, 5. Accordingly, Petitioners themselves do not characterize the MDT-Meta-Litigation and Meta-MDT-IPRs constructions as "alternative claim constructions." *See id.*

Petitioners contend that because "no final decision has been made regarding claim construction" in the Meta-MDT-IPRs, filing two petitions was necessary to address PO's narrower constructions in the Meta-MDT-IPRs. *Id.* Petitioners, however, adopt the MDT-Meta-Litigation constructions in ***both*** '541- and '542-IPRs. *Compare* Pet.5-7*, with* Ex.2003, 6-8. Accordingly, Petitioners' alleged justification fails. *See BabyBjorn, AB v. The Ergo Baby Carrier, Inc.*, IPR2025-00111, Paper 19, 11-13 n.11 (P.T.A.B. Apr. 22, 2025) (holding that a second-ranked petition is unnecessary when petitioner addresses the same construction in both petitions); *see also Medacta USA, Inc. v. RSB Spine, LLC*, IPR2020-00275, Paper 22, 10-11 (P.T.A.B. May 22, 2020). Furthermore, Petitioners could have sought

[4] Petitioners do not list any other claim terms to justify filing parallel petitions. Ranking, 2-4. Petitioners cannot rely on other claim terms to justify filling parallel petitions now. *See* CTPG, 59-60.

claim constructions within one petition instead of filing two petitions. *Microsoft Corp. v. D3D Techs.*, IPR2021-00877, Paper 14, 9 (P.T.A.B. Dec. 2, 2021) ("[N]othing prevented Petitioners from seeking claim constructions" within a single petition).

It is remarkable that Petitioners invoke PO's allegedly different constructions to justify parallel petitions while themselves relying on identical constructions throughout both petitions. ***Because Petitioners apply identical claim constructions in both the Neibauer and Original Grounds, their claim of "different" constructions merely masks an effort to dodge the 14,000-word limit and pack extra unpatentability grounds into multiple petitions***.

To the extent Petitioners' citation to the Notice of Rulemaking factor implies that PO's proposed claim constructions in the Meta-MDT-IPRs and MDT-Meta-Litigation are "alternative claim constructions," Petitioners' characterization is disingenuous. As Petitioners admit, these constructions are not alternatives at all; they have a genus-species relationship. For example, PO argued in the MDT-Meta-Litigation that "no construction [is] required" for "mobile device," but, "[i]f the Court requires a construction, 'a piece of handheld equipment.'" Ex.1009, 3. In the Meta-MDT-IPRs, PO proposed "a portable device with limited display space and limited navigational capabilities that connects to a mobile site and/or mobile channel

via a wireless network."[5] Ex.1010, 9. The Meta-MDT-IPRs construction is consistent with and merely narrows the formulation in the MDT-Meta-Litigation; any device that meets the narrower definition necessarily falls within the broader one. Petitioners themselves acknowledge that the Meta-MDT-IPRs construction is "narrow[er]" than, not inconsistent with, the MDT-Meta-Litigation constructions. Ranking, 5.

Even assuming the Meta-MDT-IPRs and MDT-Meta-Litigation constructions are genuinely alternatives (they are not), there is no need for "different prior art references." *Id.,* 2-4. Any prior art combination that allegedly renders the claims unpatentable under the narrower construction (i.e., Meta-MDT-IPRs construction) also renders them unpatentable under the broader construction (i.e., MDT-Meta-Litigation construction). *See In re Cavanagh*, 58 C.C.P.A. 856, 436 F.2d 491, 496 (CCPA 1971) ("[I]f appellant's narrow claims are obvious in view of the prior art, so are his broad claims."); *Chapman v. Casner*, 315 Fed.Appx. 294, 297-298 (Fed.Cir.2009) ("[C]laims directed to the genus … can be anticipated or rendered obvious by references disclosing the species."); *SIBIA Neurosciences, Inc. v. Cadus*

[5] PO explained its bases for this construction in its Meta-MDT-IPRs Response. Ex.1010, 9-15. However, the Board need not construe any term for discretionary denial purposes.

Pharma. Corp., 225 F.3d 1349, 1355 (Fed.Cir.2000) (holding that when claims are invalid under a narrow construction of a term, it is not necessary to determine whether they are invalid under a broader construction). Accordingly, the '541-IPR asserting Neibauer Grounds—predicated on the broader construction—is redundant.

Petitioners nonetheless chose to rank the '541-IPR higher—underscoring their own lack of confidence in the merits of the '542 Petition. Had they truly believed in the strength of the Original Grounds, they would have ranked the '542-IPR higher, as those Grounds supposedly rely on narrower constructions and should have sufficed to invalidate the claims under either narrow or broad construction. The Board should not institute an IPR that Petitioners themselves deemed the weaker of the two.

Furthermore, Petitioners' sole basis for filing two petitions is one factor from a list of nine factors enumerated in the April 19, 2024 Notice of Proposed Rulemaking on "Instituting Parallel and Serial Petitions." Ranking, 3. But a Notice of Proposed Rulemaking is exactly that—a proposal. Even if it had been adopted, Petitioners ignore eight of the Notice's nine enumerated factors. Ex.2004, 12, col. 3. Petitioners ask the Board to elevate a single, non-binding consideration over a "holistic view of the totality of the circumstances presented"—an approach embraced by the Board in decisions involving exercise of discretion. *See, e.g.*, *Ecto World, LLC and SV3, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper

10 (P.T.A.B. Mar. 6, 2025) (adopting the holistic view approach in *Advanced Bionics* context).

Petitioners also contend the "burden on the Board and PO in instituting" two IPRs against the '348 Patent is "minimal" because the higher-ranked '541-IPR relies on "common references and argument" as Meta asserted in the Meta-MDT-IPRs. Ranking, 4-5. Untenable. The burden may indeed be trivial for Petitioners—they have merely copy-pasted the Meta-MDT-IPR on the '348 Patent into the '541 Petition—but it is anything but minimal for everyone else. PO must craft a full response[6] and retain a new expert due to a conflict with Petitioners, while the Board must devote substantial resources to preside over potentially two trials on the same '348 Patent.

Finally, the Board's decision to institute trial in the Meta-MDT-IPRs based on the same "common references and arguments" (Ranking, 5) raised in the '541-IPR does not warrant abusing the IPR process and imposing the added burden of a second proceeding on the '348 Patent. Doing so undermines the efficiency the IPR

[6] As evidenced from PO's merits and *Advanced Bionics* in its '541 discretionary denial brief, unlike Petitioners, PO does not copy-paste its arguments from the Meta-MDT-IPRs. Instead, PO spent significant resources to refine its arguments, focusing on the Petition's fundamental deficiencies.

process is designed to protect. That inefficiency is especially true here: as of May 4, 2025—over three months after filing the '542-IPR—Petitioners' IPR petitions "are not yet paneled." Ex.2006. This indicates the Board's demanding workload, and despite that workload Petitioners abused the IPR process by filing parallel—yet completely unnecessary—Petitions. And as the Board has previously recognized, the inefficiency of parallel Petitions is even more heightened where, as here, Petitioners themselves ask the Board to "consider the merits of this Petition last." *Pfenex Inc. v. GlaxoSmithKline Biologicals SA*, IPR2019-01478, Paper 9, 12-13 (P.T.A.B. Feb. 10, 2020).

As explained above, Petitioners do not point to any reasonable basis to file parallel petitions, and thus Petitioners should have put their best foot forward in a single petition. Here Petitioners rank the '541-IPR higher than the '542-IPR. Ranking, 2. Accordingly, the Board should exercise its absolute discretion and deny institution of the '542-IPR. Considering "the ability of the PTAB to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AIA proceedings, and other workload needs" (*see* the March 26, 2025 Memorandum titled, "Interim Processes for PTAB Workload Management" (the "March 26, 2025 Memo"), 2-3), exercising absolute discretion to deny institution of the lower-ranked '542-IPR, especially when there was no reason to file parallel petitions, is prudent.

Denying institution for the lower-ranked '542-IPR will "maintain PTAB

capacity to conduct AIA proceedings." March 26, 2025 Memo, 2-3. Accordingly, the Board need not further consider the *Fintiv* framework. *See Comcast Cable Commc'ns LLC v. Entropic Commc'ns LLC*, IPR2025-00181, Paper 8 (P.T.A.B. Apr. 29, 2025).

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

If the Board considers *Fintiv*, the Board should deny institution under §314(a). In *NHK Spring*, the Board denied institution primarily because the related district court case would resolve all the issues before the Board. *NHK Spring, Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, 20 (P.T.A.B. Sept. 12, 2018) (precedential), *see also id.*, 11-18 (applying discretion under 35 U.S.C. §325(d)). Other cases—relying on *NHK Spring*—have also denied institution where the district court trial would resolve the invalidity issue before an FWD would be issued by the Board. *E.g.*, *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16, 6 (P.T.A.B. May 15, 2019).

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

In *Fintiv*, the Board emphasized six factors to consider under *NHK Spring*,

discussed below. *See Fintiv*, Paper 11, 5-16. The Board stated "[t]hese factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding." *Id.*, 6. In evaluating the *Fintiv* factors, the Board must "take[] a ***holistic view*** of whether efficiency and integrity of the system are best served by denying or instituting review." *Id.*

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

Additionally, consistent with *Fintiv*'s holistic analysis, the Board should also consider other relevant considerations, including but not limited to "[t]he extent of the petition's reliance on expert testimony," and "[s]ettled expectations of the parties, such as the length of time the claims have been in force.". March 26, 2025

Memo, 2-3.

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

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

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

As a threshold matter, the '348 Patent is not subject to an instituted IPR proceeding, and the EDTX denies stays when the Board has not issued the decision on institution:

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

CyWee Grp. Ltd. v. Samsung Elecs. Co., 17-cv-140, 2019 WL 11023976, *5 (E.D.Tex. Feb. 14, 2019); *see also Trover Group, Inc. v. Dedicated Micros USA*, 2:13-cv-1047WCB, 2015 WL 1069179, *6 (E.D.Tex. Mar. 11, 2015) (Bryson, J.) ("This Court's survey of cases from the [EDTX] shows that when the PTAB has not yet acted on a petition for inter partes review, the courts have uniformly denied

motions for a stay."); *Samsung Elecs. Co. v. Evolved Wireless LLC*, IPR2021-00950, Paper 10, 10-11 (P.T.A.B. Nov. 29, 2021) (finding a stay was unlikely partly based on the court's past decisions denying stays); *Samsung Elecs. Co. v. Clear Imaging Research, LLC*, IPR2020-01552, Paper 12, 12-13 (P.T.A.B. Mar. 3, 2021) (denying institution because, in part, Judge Gilstrap deemed unlikely to stay a case in similar circumstances).

Additionally, even if the Meta-MDT-IPRs were still active before the Board and Petitioners file their motion to stay today—before the Board decides institution in the '542-IPR—the EDTX would deny Petitioners' motion based on Petitioners' delay. Petitioners had every opportunity to file a motion to stay the EDTX-Litigation any time between institution and withdrawal of the Meta-MDT-IPRs, namely between June 2024 and March 2025. In fact, Petitioners have been contemplating a motion to stay for over seven months, since the early stages of the EDTX-Litigation (*See* Exs.2008, 2013, and 2014), but have not filed a motion with the district court.

On September 26, 2024, Petitioners inquired about PO's position regarding a stay of the EDTX-Litigation pending the issuance of FWDs in Meta-MDT-IPRs. *See* Ex.2008. PO informed Petitioners it opposed a stay, and Petitioners did not file a motion. Ex.2013. On February 19, 2025, after filing their Petitions, Petitioners again inquired about PO's "position on a stay pending IPR." *See* Ex.2014. And on March 4, 2025, Petitioners shared a draft of their motion to stay for PO's review. Ex.2015.

To date, Petitioners have not filed a motion to stay. EDTX precedent has denied a stay where there has been a much shorter delay than here. *See, e.g.*, *Saint Lawrence Commc'ns LLC v. ZTE Corp.*, 2:15-CV-349-JRG, 2:15-CV-351-JRG, 2017 WL 3396399, *2 (E.D.Tex. Jan. 17, 2017) ("[Defendant's] decision to ***wait over a month to file its renewed motion to stay*** following the PTAB's decision to institute IPR … further undermines its efforts to obtain a stay.").

Even if Petitioners' delay in filing a motion to stay is overlooked, Petitioners' delay in filing their Petition is an independent basis in the EDTX to deny a motion to stay. *See Tessera Advanced Technologies, Inc. v. Samsung Electronics Co.*, 2:17-cv-00671-JRG, 2018 WL 3472700, *3 (E.D.Tex. July 19, 2018) (finding IPRs filed ***nine months after initiation of the lawsuit*** and ***five months after service of infringement contentions*** weighed against a motion to stay). Here, Petitioners filed their Petitions nearly eight months after the initiation of the EDTX-Litigation and five months after service of PO's infringement contentions. Under the EDTX's precedent, Petitioners' delay in filing their Petitions weighs against granting a motion to stay even if filed today.

Finally, the EDTX has yet another independent reason to deny a motion to stay—any FWD would not be due until well after the trial concludes. The EDTX-Litigation has been underway for a year now, and jury selection is less than a year away, on April 20, 2026. *See* Ex.2016. This is "a deadline that cannot be changed

without an acceptable showing of good cause. Good cause is not shown merely by indicating that the parties agree that the deadline should be changed." *Id.*, 5. An institution decision on the '542-IPR is not due until October 2025. By that date, the parties will have substantially completed the claim construction process, with the *Markman* hearing scheduled for October 30, 2025. *See id.*, 4-5. An FWD would not be due until October 2026, six months after trial is scheduled to begin. For this independent reason, the EDTX is likely to find a stay in circumstances like this case would unduly prejudice PO. *See, e.g.*, *MyPort, Inc. v. Samsung Electronics Co.*, et al., 2:22-cv-00114-JRG, Dkt. 73 (E.D.Tex. June 12, 2023), 4 (denying a stay where the PTAB decision is not due until over two months after jury trial is set to begin).

Accordingly, *Fintiv* Factor 1 weighs overwhelmingly in favor of discretionary denial.

B. Factor 2: The EDTX-Litigation's Trial Date is Six Months Before the Expected Date of Any FWD

Fintiv Factor 2 strongly weighs in favor of discretionary denial because by the time any FWD in the '542-IPR would issue, the EDTX-Litigation would be concluded, and Petitioners' invalidity challenges all addressed by the district court. "If a district court's trial date is earlier than the Board's projected statutory deadline for a final written decision, the Board generally has weighed this fact in favor of exercising discretion to deny institution." *T-Mobile USA, Inc., et al. v. Wireless Alliance*, IPR2024-00608, Paper 16 (P.T.A.B. Sept. 3, 2024) (denying institution of

IPR).

The '542-IPR was filed nearly eight months after initiation of the EDTX-Litigation, and a decision whether to institute the '542-IPR is expected approximately on October 13, 2025. If instituted, any FWD is expected approximately on October 13, 2026. 37 C.F.R. §42.100. Jury selection in the EDTX-Litigation is scheduled to begin on April 20, 2026, six months before any FWD from the Board. *See* Ex.2016, 1, 5 (jury selection is "a deadline that cannot be changed without an acceptable showing of good cause" which must be more than the parties' agreement). The parties have never attempted to extend any of the critical interim deadlines, such as claim construction, fact discovery, expert discovery, pre-trial conference, and jury selection.

Even if the Board disregards the scheduled trial date, the current median time-to-trial statistics weigh against institution. *See* March 24, 2025 Memo, 3 ("[T]he Board may consider … ***median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides***."). The most recent statistics on "United States District Courts–National Judicial Caseload Profile," published by www.uscourts.gov,[7] show that for a 12-month period ending March 31, 2025, a

[7] This website is "maintained by the Administrative Office of the U.S. Courts on behalf of the Federal Judiciary." https://www.uscourts.gov/. The URL for the

median time-to-trial in the EDTX for civil cases is 25.9 months. Ex.2017, 35. Accordingly, the projected trial date in the EDTX-Litigation for purposes of *Fintiv* would be around July 29, 2026—nearly three months before the expected timing of any FWD.[8]

The Board has consistently found this factor weighs in favor of exercising discretionary denial where the underlying litigation is in the EDTX and the projected trial date is before the FWD date. *See, e.g.*, *SAP America v. Cyandia, Inc.*, IPR2024-01496, Paper 13, 5-6 (P.T.A.B. Apr. 7, 2025) (holding this factor weighs against institution when the trial would begin "***about four months*** before the deadline for

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published statistics is https://www.uscourts.gov/sites/default/files/2024-12/fcms_na_distprofile0930.2024.pdf.

[8] Petitioners cite the March 31, 2025 statistics in their response to discretionary denial briefing in the '535-IPR. Even under the March 31, 2025 statistics, this factor favors discretionary denial given the expected FWD date is 2-3 months after the projected trial date for all IPRs. *Shenzhen Tuozhu Technology Co. v. Stratasys, Inc.*, IPR2025-00354, Paper 11, 2 (P.T.A.B. June 12, 2025) (granting patent owner's request for discretionary denial when the "projected [FWD] due date … is July 14, 2026," the "scheduled trial date is June 1, 2026," and the "time-to-trial statistics suggest that trial will begin in July 2026").

entering a final written decision in this proceeding"); *T-Mobile*, IPR2024-00608, Paper 16, 13 (same).

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

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

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

Starting with the first prong, fact discovery between the parties is ongoing in the EDTX-Litigation, and each party has produced several volumes of documents. Exs.2018-2019. The parties have recently litigated a discovery dispute concerning the scope of the Protective Order in the EDTX-Litigation. Ex.2040. Petitioners have served 10 third-party subpoenas requesting production of documents. Several third parties have produced documents in response to Petitioners' subpoenas. Exs.2020-2025; Ex.2036. Additionally, the parties have exchanged their infringement and

invalidity contentions.[9] By the projected institution date, the parties will have already expended significant time in discovery, exchanged claim constructions, filed a joint claim construction statement, and completed claim construction discovery. *See* Ex.2016. The *Markman* hearing is also scheduled to occur about two weeks after the institution decision is due. *Id.* Under similar circumstances, the Board has consistently held this prong is neutral. *See, e.g.*, *Samsung Electronics Co. v. SiOnyx, LLC*, IPR2025-00065, Paper 16, 11-12 (P.T.A.B. June 6, 2025) (determining that the first prong is neutral even when "***the claim construction phase has not even begun yet***"); *Dell Inc. et al. v. Universal Connectivity Technologies Inc.*, IPR2024-01479, Paper 11, 6-7 (P.T.A.B. Apr. 7, 2025); *Lenovo Inc. et al. v. Universal Connectivity Technologies Inc.*, IPR2024-01479, Paper 17, 11-12 (P.T.A.B. Apr. 17, 2025); *Solus Advanced Materials Co. v. SK nexilis Co.*, IPR2024-01460, Paper 14, 17-18 (P.T.A.B. Apr. 22, 2025).

Turning to the second prong, Petitioners were not diligent in filing their Petition. Petitioners cannot explain why they failed to promptly file their Petition upon receiving PO's infringement contentions in the EDTX-Litigation. Petitioners were served with PO's infringement contentions on September 4, 2024—nearly five

[9] PO served its infringement contentions on September 4, 2024. Ex.2026. Petitioners served their invalidity contentions on January 31, 2025. Ex.2027.

months prior to filing the '542-IPR. Ex.2026. The five-month gap between service of infringement contentions and the filing of the '542 Petition constitutes "substantial delay" that favors discretionary denial under *Fintiv* Factor 3. *AT&T Servs. v. ASUS Tech.*, IPR2024-00992, Paper 14, 12 (P.T.A.B. Dec. 16, 2024) (five months between infringement contentions and the petition is a "substantial delay").

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

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

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

The Board's April 25, 2025 FAQs ("FAQs") about the discretionary denial process[10] list two criteria for an effective *Sotera* stipulation: one procedural and one substantive. Procedurally, "[a] petitioner ***should file*** a *Sotera* or *Sand* stipulation ***as soon as practicable***, so that a patent owner may address the impact of the stipulation in its discretionary denial brief." FAQs, Q.14. As to the substance, "the stipulation

[10] www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management.

[must] ***materially reduce***[] overlap between the proceedings," noting that "[w]here the petitioner is ***relying on corresponding system art*** in a co-pending proceeding and/or several other invalidity theories, ***a stipulation may not be particularly meaningful***." *Id.* Petitioners' *Sotera*-style stipulation fails to meet either criterion.

Procedurally, Petitioners' *Sotera*-style stipulation is untimely. Petitioners had ample opportunity to file their *Sotera*-style stipulation sooner and even at the time of filing the '542-IPR but waited for over three months to contact the Board to seek leave to file.[11] Ex.2006. And despite PO promptly responding to Petitioners' inquiry

[11] On April 21, 2025—nearly three months after filing their Petition, Petitioners contacted PO, proposing a *Sotera*-style stipulation. Ex.2030. On April 21, 2025, Petitioners informed PO they intend to seek leave to file their proposed stipulation, asking PO to indicate its position by April 23, 2025. Ex.2028. PO responded on April 23, 2025: "Patent Owner does not oppose Petitioner contacting the Board to seek leave to file these stipulations." *Id.* It took Petitioners one week to respond with the draft of their proposed communication to the Board. Ex.2029. Petitioners sent their request for leave to file their *Sotera*-style stipulation to the Board on May 2, 2025. Ex.2006. As of the date of the filing of this Discretionary Denial brief, Petitioners' *Sotera*-style stipulation is not filed. Accordingly, PO cannot address the "impact" of a stipulation that is not yet filed. As such, PO presents its arguments on the

(Ex.2028), Petitioners wasted yet another full week to email PO the draft of their proposed communication to the Board (Ex.2029). These delays are not excusable—the untimeliness of Petitioners' filing has substantially prejudiced PO. Notably, that PO had to invest time and resources to argue regarding the insufficiency of a not-yet-filed stipulation only serves Petitioners' interest. Petitioners' delay has thus prejudiced PO.[12]

1. There is Substantial Overlap Between the References in the Petition and the Corresponding System Art in the EDTX-Litigation

Turning to the substance of Petitioners' *Sotera*-style stipulation, Petitioners' proposed draft does not reduce overlap between the proceedings. Petitioners' draft

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sufficiency of Petitioners' April 21, 2025 proposed stipulation, assuming Petitioners will not modify their proposed drafts in this IPR or any of the other IPRs based on PO's arguments in this brief.

[12] Petitioners cannot hide behind their April 21, 2025 email to PO. First, the FAQs state that the stipulation must be "file[d] … as soon as practicable"—sending a draft of a stipulation to PO does not relax the filing requirement. A petitioner can change its proposed draft at anytime before filing. Thus, PO cannot not reasonably address the impact of a draft stipulation that is not yet filed. Second, April 21, 2025—over three months from filing the Petitions—is not "as soon as practicable."

stipulation provides that if the Board "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.[13] However, in view of Petitioners' invalidity contentions ("IVCs"), this stipulation is insufficient.

For Ground 1, Petitioners assert Randall-Forsyth combination. These references are directed at features of the Symbian operating system ("OS"). Randall ("The present invention will be described with reference to an implementation from Symbian Limited of London, United Kingdom. This implementation is called the ADS™ system."); Forsyth ("An implementation of the present invention, called Forums™, is a new approach to group communication from Symbian Limited of London, United Kingdom. … Forums runs on the object based operating system Symbian OS."). Petitioners specifically focus on "the Symbian Forums service"

[13] PO files this Exhibit only to give the Board context for its arguments. Petitioners—not PO—must file any *Sotera* stipulation, and they have not done so. PO's filing of this Exhibit does not fulfill that duty, and no stipulation is considered filed because Patent Owner files this Exhibit. If the Board permits Petitioners to file a stipulation, it must be the April 21, 2025 stipulation. *See* Ex.2006, 2.

described in Randall and Forsyth. Pet.6-10.

In the EDTX-Litigation, Petitioners have asserted the "Nokia 9210 System" as a prior art system to challenge the validity of the '348 Patent. Ex.2027, 35-36. As a threshold matter, the Nokia 9210 system relies on Symbian OS, which originates from a major joint venture between Psion and phone manufacturers Ericsson, Motorola, and Nokia to create Symbian Ltd. in June 1998. Ex.2037, 5. Ex.2039, ¶9. The collaboration aimed to develop a standardized operating system for mobile devices—Symbian OS. *Id.* The Nokia 9210 Communicator was the first device to run on the Symbian OS platform, with Nokia's Series 80 UI, the result of Symbian Ltd.'s 'Crystal' design. *Id.*, 5-6, 10 (showing crystal design features). Thus, the Nokia 9210 System is a device that runs on Symbian OS.[14] Indeed, Petitioners' evidence used in this IPR uses the Nokia 9210 Communicator as a "Symbian OS Phone." Ex.1019. Specifically, the Nokia 9210 features that Petitioners relied on in their IVCs are enabled by the Symbian OS and adequately described in Randall and Forsyth as explained below.[15]

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[14] In 2009 Forsyth was assigned to Nokia Corporation, Finland, and later in 2015 assigned Nokia Technologies Oy. *See* Ex.1006.

[15] The following discussion of Petitioners' invalidity claim chart and features of the Nokia 9210 System that Petitioners rely on is not an admission by PO that the Nokia

Indeed, Petitioners' expert, Dr. Houh, concedes the Randall-Forsyth teachings are embodied in the Nokia 9210 System asserted by Petitioners' IVCs. Houh states that "[n]umerous books and papers published prior to June 2002 (or in 2002) ***confirm the disclosures of Randall and Forsyth regarding wireless devices running the Symbian OS.***" Ex.1003, ¶102. The very next paragraph, Houh states that "[t]he Symbian OS, available prior to 2002, was intended for a range of devices." Ex.1003, ¶103. And in the next paragraph, Houh lists the Nokia 9210 System as an example. "Allin's Figure 3 below illustrates the ***Nokia 9210 Communicator*** based on the Crystal communicator reference design." Ex.1003, ¶104; *see also* ¶¶105-106.

9210 System teaches, discloses, or otherwise suggests any limitation of the '348 Patent. The discussion is limited to comparing disclosures of the Nokia 9210 system and Randall-Forsyth. PO maintains that the Nokia 9210 System does not render obvious any claims of the '348 Patent for the same reasons the Randall-Forsyth combination does not.

Figure 2. Top frame: the Nokia 9210 Communicator depicted in Houh's declaration. Ex.1003, ¶104. Bottom frame: the Nokia 9210 Communicator shown in Petitioners' IVCs. Ex.2033, 24.

For example, for IVCs limitation 1[A] (corresponding to Petition's limitation 1[A]-1[B]) the processor for the Nokia 9210 is listed as "'32-bit ARM9-based RISC CPU' http://www.***allaboutsymbian***.com/devices/nokia9210/9210ispecs.php." Ex.2033, 5. The URL selected by Petitioners demonstrates the connection between the Nokia 9210 and Symbian OS. The Nokia 9210 User Guide further discloses that the device has a memory such that a user can "view the amount of free memory for storing data and installing new software. You can scroll and view the memory consumption of the following details: Documents, Spreadsheets, Sounds, Faxes, Mails, Short messages, Calendar data, Contacts, Images, Installed applications, and Other file types." Ex.2033, 5. In Randall and Forsyth there is also disclosure of a mobile device with a processor: "current designs of communicators based on the Symbian platform include all of the applications found on a fully featured PDA, such as a contacts manager, messaging application, word processor . . ." Forsyth, 1:36-39; Randall, 1:22-24. A fully featured PDA (like the Nokia 9210) necessarily has a processor and a memory. Thus, this disclosure in the Invalidity Contentions is duplicative of the disclosure in Randall and Forsyth. Ex.2039, ¶12.

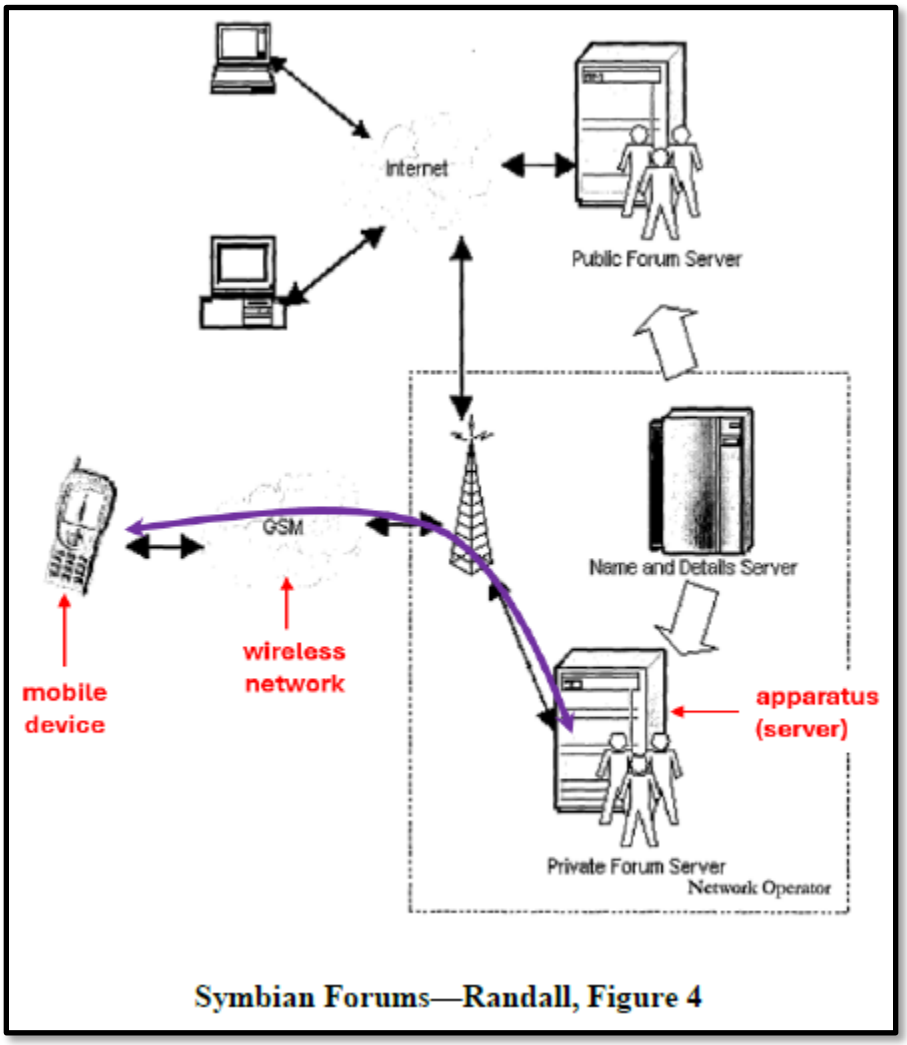
For IVCs limitation 1[B] (corresponding to Petition's limitation 1[C]), Petitioners point to "[t]he Short Message Service (SMS) enables you to send and receive short messages over the digital wireless network." Ex.2033, 7. But Forsyth also discloses this capability: "To start a Forum, a user sends a short message to his

chosen recipients. To do this, the user/Forum creator enters a SMS-style message and Forum title into the wireless communication device." Forsyth, 5:45-48. Thus, the user's ability to send a short message with the Forums application is a capability provided by the client-server architecture of the Symbian OS. Ex.2039, ¶13.

Petitioners' IVCs also rely on the disclosure of "Word Processor" for its ability to write and edit content in the Nokia 9210 User Guide. Ex.2033, 7. This feature is also described in Forsyth. Forsyth's claim 3 recites that group objects are capable of being used by any of the following applications: "(a) e-mailing application (b) text based messaging application (c) voice telephony (d) multi-media messaging (e) productivity applications (including word processing, spreadsheets, and presentation applications)." These applications function similarly to Forums, which "runs on the object based operating system Symbian OS," such that the applications run on the Symbian OS in devices like the Nokia Communicator. Forsyth, 2:40-53. Ex.2039, ¶14.

Petitioners also rely on the Nokia 9210 System User Guide's disclosure that "[s]ome servers have access restrictions that require a valid user name and password. In this case, you will be prompted for your user name and password before the Web page can be retrieved." Ex.2033, 8. But this feature is disclosed in Randall as implemented in the Symbian OS: "There is a need for authentication of the user when they access their data perhaps via their WID. This authentication should

prevent access to their information both locally and on the 10 server (for instance if their device is stolen). The authentication can use a number of different mechanisms: a basic WID and password/passphrase is likely to be first line of access. Once past this stage the WID may store private key(s) transparently to the user of the WID that will allow access to services. The private key effectively represents the ownership of the WID to the server side session." Randall, 48.



Symbian Forums—Randall, Figure 4

Ex.2039, ¶15.

For IVCs limitation 1[D]-1[E][16] (corresponding to Petition's limitation 1[E]), Petitioners point to the Nokia 9210 User Guide's discussion of contact groups: "You can create contact groups to save time by sending e-mails and short messages to all members of the contact group in one action." Ex.2033, 11. This capability of the Symbian OS is disclosed in the Randall-Forsyth combination: "Forums…facilitates open discussion amongst a group and allows multiple chat-style conversations to take place simultaneously." Pet.25 citing Forsyth. Petitioners also cite Randall, stating that "a forum allows several people to be part of a 'channel' or room." Pet.34. In both of these disclosures, however, the underlying capability for storing the contact records of the people in a group is provided by the Symbian OS. Thus, the disclosure in the Invalidity Contentions is the same as in the Randall and Forsyth combination. Ex.2039, ¶17.

Petitioners also include a citation to Nokia's internet browsing features allowing users to "interactively post and respond" to content. Ex. 2033, 14. But Randall and Forsyth also disclose the same internet browsing features of the Symbian OS. Randall describes a "data services framework" allowing integration with web-based services such as a BBC service for weather or a Yellow Pages

[16] For IVCs limitation 1[C] (corresponding Petition's limitation 1[D]), Petitioners refer to the exact same portions of the Nokia 9210 Manual as for limitation 1[B].

service, where a "two-way flow of information" enables the user interaction with web services. Randall, 20:16-28. This contributes to the dynamic content sharing and message delivery of Symbian. Forsyth similarly describes the integration with web services via a "central server [that] can act as a store for resources which group-members may wish to discuss and share" such as "web sites." Forsyth, 3:19-34. Forsyth goes on to describe "Social Browsing" where users can "see the internet sites other people have browsed to… on a per-person basis," allowing users to share images and maintain collaborative records through web interfaces. Forsyth, 13:5-20. Ex.2039, ¶18.

Further, Dr. Houh, asserts that internet browsing to post and respond to content is disclosed in Randall and Forsyth. Specifically, Houh states that "based on Randall's disclosure of GSM and WAP, a POSITA would have understood the client-side application is either (1) a standalone application supporting WAP or GSM-messaging protocol (discussed below) or (2) a web browser (such as a WAP microbrowser)." Ex.1003, ¶48. Randall discusses communication methods including GSM and WAP as being utilized as "good, functional transport solutions" for ServML, which is a "a means of storing, accessing, and interacting with data using a client-server architecture" that "takes advantage of the power of Symbian advanced clients" and therefore provided by Symbian OS. Randall, 45:5-15, 58:5-20. Providing a microbrowser for display of a webpage is utilized by the Forums

Application and provided by the Symbian OS. Ex.2039, ¶19.

Petitioners also assert that the Nokia 9210 System allowed determination of "information associated with wireless messaging such as username and date/time, such as in the following exemplary forums, newsgroups, websites, and messengers." Ex.2033, 17. Petitioners included the following snippet in the Invalidity Contentions as an exemplary forum:

JEEPN
7901 posts · Joined 1999

#5 · Nov 8, 2000

In order to post a pic to the page, so it comes up automatically, the pic has to first be on the web. I, and a few others (Jeepskate), have accounts at Photo Point, which is free. It allows us to upload pictures to the web and have them in one location. Check it out at http://www.photopoint.com/.

JEEPN
Winter Harbor, Maine
'81 CJ-8 Scrambled!
It's a Jeep, Chevy, IHC kinda thing!

JEEPN

Reply Like Save Share

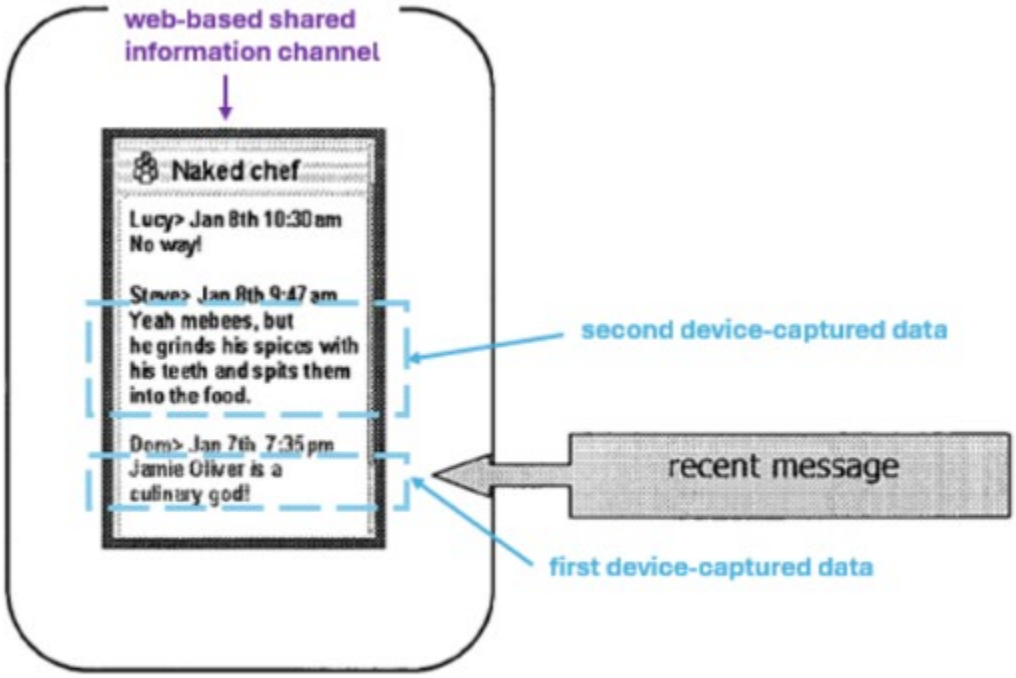
G Unknown member Discussion starter

#6 · Nov 8, 2000

did this work

Reply Save Share

Ex. 2033, 18. This, however, is depicted in Forsyth's Figure 7, which Petitioners cite in the Petition as evidence of "captured data from multiple users … presented on a single 'integrated' display." Pet.41-42. Ex.2039, ¶¶20-21.



Forums—Forsyth, Figure 7

Petitioners also point to screenshots of the Nokia 9210 device to support that it "allowed sharing content." Ex.2033, 20. As Petitioners admit, Forsyth also expressly discloses sharing content. Specifically, Forsyth describes a "group object" as a structure comprising information that either contains or references the minimum necessary contact information for two or more entities (typically individuals, though potentially also multiple facets of a single individual) for purposes of facilitating interactions or content sharing. Forsyth, 2:17–24. Forsyth further elaborates that in the Forums context, a new group object may be instantiated when a user selects message recipients or, more broadly, when the user identifies intended participants for group-based communication. Forsyth, 2:48–52. The overlap between Forsyth

and the Nokia 9210 System's Contacts functionality is not incidental—it is because both systems operate within the Symbian OS environment. Forsyth also states that the option to "[define] the recipients of a message, or… [define] the desired participants to be involved in group communication" is enabled by the use of group objects, which is a capability provided by Symbian OS where "group objects can be defined independently of any specific task or application." Forsyth, 2:40-53. Ex.2039, ¶22.

Finally, Petitioners also point to the Nokia 9210 User Guide: "A voice mailbox is a network service or a personal answering machine where people can leave you voice messages." Ex. 2033, 28. Forsyth also discloses this feature of the Symbian OS: "It is possible that Forums are given email addresses and telephone numbers in their own right, so that users may send text or voice messages to a Forum from any communications device." Forsyth, 12:64-67; *see also* 11:49-51.

As the above analysis shows, each of the Nokia 9210 features Petitioners use in the EDTX-Litigation is adequately described by the Randall-Forsyth combination. Ex.2039, ¶26. Despite Petitioners' statutory inability to raise the Symbian OS-based system (e.g., Nokia 9210 System) in this IPR, a substantial overlap of issues would remain even with Petitioners' *Sotera*-style or any other narrower stipulations. Where, as here, "the petitioner is ***relying on corresponding system art*** in a co-pending proceeding and/or several other invalidity theories, ***a***

stipulation may not be particularly meaningful." FAQs, Q.14.

Because Petitioners intend to swap labels in the EDTX-Litigation to cloak the Ground 1 as a prior art system when it is the same art asserted in the Petition, *Fintiv* Factor 4 weighs strongly in favor of denying institution. *See, e.g.*, *SAP America*, IPR2024-01496, Paper 13, 8-9 (holding on similar facts "we do not consider the presence of the *Sotera* stipulation in our case to ensure that inter partes review would be a 'true alternative' to the Litigation").[17]

2. The Ineffectiveness of Petitioners' *Sotera*-style Stipulation is Highlighted by the Federal Circuit's Decision in *Ingenico Inc. v. IOENGINE, LLC*

The Board's determination as to effectiveness of a *Sotera* stipulation hinges on "whether the stipulation ***materially reduces overlap*** between the proceedings." FAQs, Q.14. A stipulation is not effective unless it guarantees that "the same or substantially ***the same claims, grounds, arguments, and evidence***" will not be raised in the district court. *Fintiv*, 12-13. Under *Fintiv*, the analysis thus is not limited to

[17] Similarly, for Ground 2 Petitioners rely on Pelkey-Eck, which disclose "an enhanced version of the Nintendo GameBoy," an allegedly prior art system. Ex.1003, ¶174. Petitioners' *Sotera*-style stipulation does not preclude them from asserting an invalidity ground based on Nintendo GameBoy or combination of Nintendo GameBoy with Pelkey-Eck in the EDTX-Litigation.

whether the grounds of unpatentability are of the same nature (i.e., based on patents/publications) in different proceedings—the analysis must consider whether a petitioner raises substantially the same arguments and evidence in different proceedings. *Id.*

The recent Federal Circuit precedential decision in *Ingenico Inc. v. IOENGINE, LLC* highlights why Petitioners' *Sotera*-style stipulation is ineffective for *Fintiv* purposes. No. 23-1367, Document 58 (Fed.Cir. May 7, 2025). The Court held that the protection afforded by the IPR estoppel (35 U.S.C. §315(e)) is narrow: a petitioner is not precluded from "relying on ***the same patents and printed publications as evidence*** in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use." *Id.*, 14.

Ingenico thus permits Petitioners to use the same prior art references raised in the Petition in the EDTX-Litigation not only as evidence but also as a prior art reference in a ground that could not be raised in this IPR. For example, under *Ingenico*, Petitioners can present in EDTX-Litigation an invalidity ground based on the Nokia 9210 System and in view of Randall and Forsyth. Per *Ingenico*'s express holding, IPR estoppel does not apply to such a ground as it could not be raised in the IPR because the Nokia 9210 System is system art.

In fact, Petitioners have expressly reserved the right to do this in the EDTX-

Litigation. Petitioners expressly state in their Nokia 9210 System invalidity claim charts in the EDTX-Litigation that:

> ***[I]t would have been obvious to a person of ordinary skill in the art as of the priority date of the '348 patent to modify the Nokia 9210 System and/or combine the teachings of the Nokia 9210 System with other prior art references, including but not limited to the prior art references presently found in Samsung's Invalidity Contentions …***

Ex.2033, 1. The four references relied upon in this IPR—Randall, Forsyth, Pelkey, and Eck—are amongst the "the prior art references presently found in Samsung's Invalidity Contentions." *See* Ex.2027, 35-36. Thus, per *Ingenico*, Petitioners' *Sotera*-style stipulation does not prevent Petitioners from concocting a ground of unpatentability by combining the ***very same prior art references*** asserted in the '542-IPR with a prior art system. Indeed, given that Randall, Forsyth, and the Nokia 9210 System are all directed at the Symbian OS, Petitioners can "***combine the teachings of the Nokia 9210 System with other prior art references***," (i.e., Randall and/or Forsyth). Ex.2033, 1.

Worse yet, Petitioners' *Sotera*-style stipulation would not preclude them from recycling Randall, Forsyth, Pelkey, and Eck in the EDTX-Litigation for use ***as evidence***. In fact, Petitioners have expressly reserved the right to do so in their invalidity contentions:

> ***Defendants' reference to a particular device or product*** in the claim charts of Exhibits E1-E23 ***should be interpreted alternatively*** as both ***as a reference*** to the product itself and ***to any corresponding patents, publications, or product literature cited in Exhibits E1-E23 that***

relates to the cited device, or product.

Ex.2027, 39.

Accordingly, in view of *Ingenico* as well as Petitioners' express statements in their invalidity contentions, Petitioners' *Sotera*-style stipulation does not "materially reduce[] overlap" between this IPR and the EDTX-Litigation, as required by the Board. FAQs, Q.14. The Board should exercise its discretion to deny institution in this case.[18]

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

Fintiv factor 5 weighs in favor of exercising discretionary denial because the parties are the same in both proceedings. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 15 (P.T.A.B. May 13, 2020).

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[18] In the '535-IPR, Petitioners cite *Ingenico*, conceding that "IPR estoppel does not preclude" them from relying on the same prior art in the EDTX-litigation. But the relevant inquiry under *Sotera* is not whether estoppel applies—it is whether the stipulation adequately mitigates "***concerns*** of duplicative efforts and potentially conflicting decisions," thereby ensuring the IPR serves as a "true alternative" to litigation. Petitioners' admission that estoppel does not apply under *Ingenico*, even with their *Sotera* stipulation, only underscores the insufficiency of that stipulation to satisfy the very concerns *Sotera* was meant to address.

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

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

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

The March 26, 2025 Memo lists "***settled*** [as opposed to speculative] expectations of the parties" as a factor to be considered as part of the Board's holistic review. PO has a settled expectation in the validity of the challenged claims.[19] First, these claims are entitled to the statutory presumption of validity. 35 U.S.C. §282. Second, the challenged claims were in force since 2018 until they expired recently.

Moreover, ***the Asserted Patents enjoy an unqualified expectation of validity against Petitioners***. Petitioners have had knowledge of the Asserted Patents family since at least May 2015, yet never addressed the validity of the Asserted Patents

[19] The institution of Meta-MDT-IPRs does not undermine PO's settled expectation. The standard for institution is "reasonable likelihood of success" as to only one claim in the challenged patent. This is a far different standard than that required to invalidate all claims. *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed.Cir.2016) (discussing the "significant difference" and "qualitatively different standard" between the burden to establish a reasonable likelihood of success and the burden of proof by a preponderance of the evidence).

family. The '5801 Patent—the great-great-grandparent to the '348 Patent—appears on the face of the D156 Patent assigned to Petitioners, and was cited in an IDS on May 28, 2015 during the examination of the D156 Patent. Ex.2044, 72.

The Director has recently recognized that settled expectation favors discretionary denial in circumstances like this. *iRhythm, Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10, 3 (P.T.A.B. June 6, 2025) ("Petitioner's awareness of Patent Owner's applications and failure to seek early review of the patents favors denial and outweighs the above-discussed considerations."). In *iRhythm*, the pending patent application that issued as the great-grandparent of the patent challenged in the IPR2025-00363 proceeding was cited in an IDS during the examination of the petitioner's patent application. *Id*. The Director found "persuasive" the patent owner's argument that petitioner's awareness of the great-grandparent patent application creates an implicit expectation between the parties as to the entire family:

> By delaying over ten years from the date it first became aware of the '007 Patent (and then the subsequent to issue '422 Patent), ***Petitioner has created an implicit expectation between the parties, an acquiescence as to the patentability of the claims of the '422 Patent***. The decades-long delay of addressing the validity of ***this patent family*** further favors exercising discretion and denying this Petition.

iRhythm, IPR2025-00363, Paper 7, 31.

Like *iRhythm*, Petitioners have also created an "implicit expectation between the parties" because (1) the great-grandparent of the '348 Patent (i.e., '5801 Patent) appears on the face of the D156 Patent assigned to Petitioners and was cited in an

IDS during the examination of the D156 Patent,[20] and (2) Petitioners failed to seek earlier review of the Asserted Patents.

a) Petitioners attempted but failed to invalidate the great-grandparent of the '348 Patent via an *ex parte* reexamination filed by Unified in June 2023

Even assuming the May 2015 IDS did not give Petitioners notice of the Asserted Patents family (it did), Petitioners cannot justify their delay in filing these IPRs as explained above. On June 9, 2023, Unified filed a request for *ex parte* reexamination of the '336 Patent—the great-grandparent of the '348 Patent. *See* Ex.2045. Unified's reexamination request pointed to Neibauer's disclosures—the very same disclosures Petitioners rely on in the '541 Petition. *Id.*, 65. The Examiner considered Unified's arguments, including those based on Neibauer, but confirmed the patentability of the challenged claims of the '336 Patent.[21]

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[20] The D156 Patent was filed in May 2013 and issued in April 2016. The '5801 Patent was cited in an IDS dated May 28, 2015. Ex.2044, 72. The '578 Patent Application, the '348's Parent, was published in October 2014. Thus, on May 28, 2015, when the '5801 Patent was cited during examination of the D156 Patent, Petitioners had notice of the '5801 Patent family including the '348 Patent.

[21] For this reason alone, Petitioners' Neibauer Grounds in the '535, '537, '539, '541, and '541-IPRs against the Asserted Patents fail under the *Advanced Bionics*

Petitioners are members of Unified, as Unified admitted in its filings with the Board. *See* Ex.2046, 1 n.2 ("Apple, Inc. and Samsung Electronics Co., are members of Unified Patents."). Unified's CEO, Kevin Jakel, previously stated in a sworn declaration that Unified's "'Members subscribe to one or more of Unified's technology-specific NPE zones [and] pay a yearly subscription fee to a specific NPE technology zone." Ex.2047, ¶2. In return for those fees, Unified performs various services for its members, including filing requests for *ex parte* reexamination. *See id.*, ¶3. Given Petitioners' membership in Unified, and even assuming the May 2015 IDS did not give Petitioners notice of the Asserted Patents family (it did), Petitioners have had knowledge of the Asserted Patents family at least as of June 9, 2023, but "failed to seek early review of" the Asserted Patents. *iRhythm*, IPR2025-00363, Paper 10, 3.

Accordingly, this factor weighs in favor of a discretionary denial.

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framework. As explained in PO's discretionary denial briefs in those IPRs, Neibauer was considered by the Examiner during the examination of the Asserted Patents. Furthermore, Neibauer's disclosures relied upon by Petitioners in those IPRs were also considered by the Examiner of Unified's reexamination proceeding. Ex.2045, 65. The Board should not disturb the determinations of two Examiners.

2. Petitioners' abuse of the IPR process

As explained above, Petitioners' filing two sets of petitions is nothing but an attempt to circumvent the 14,000-word limit. Petitioners contend filing multiple petitions was necessary because PO proposed two alternative constructions for some of the claim terms. Ranking, 2-4. Yet, instead of addressing one claim construction in their first-ranked Petition and the other in the second-ranked Petition, Petitioners take identical claim construction positions in '541 and '542 Petitions. *Compare* Pet.5-7*, with* Ex.2003, 6-8. This highlights two points. One, PO's proposed construction are not truly alternatives as Petitioners characterize. Two, Petitioners' first-ranked and second-ranked Petitions substantially overlap.

Petitioners' abuse of the IPR process is further highlighted by them burdening the Board and PO with their copycat '541 Petition instead of joining the Meta-MDT-IPRs. Petitioners were served with the Complaint in the EDTX-Litigation on June 17, 2024—less than one week after the Board instituted trial on the '348 Patent in the Meta-MDT-IPRs. *See* Exs.2005 and 2007. Any modicum of diligence would have revealed that the same '348 Patent was already in an active IPR. Had Petitioners truly wished to pursue the Neibauer Grounds advanced in the Meta-MDT-IPRs, they could—and should—have sought joinder no later than July 11, 2024, per 37 C.F.R.

§42.122(b). Petitioners offer no explanation for letting that window close.[22] *See Pfenex Inc. v. GlaxoSmithKline Biologicals SA*, IPR2019-01478, Paper 9, 12 (P.T.A.B. Feb. 10, 2020) ("Moreover, if Petitioner was interested in pursuing the same challenge as that presented in the 230 IPR, it could have requested joinder under 37 C.F.R. §42.122(b). … That the 230 IPR settled after institution is not an adequate excuse for delay.").

Filing multiple IPR petitions against the same patent—when joinder was readily available—subverts procedural economy and needlessly expends Board

[22] In a motion filed in the EDTX-Litigation, Petitioners claim they did not attempt joinder because they did not have "MDT's infringement contentions (which assert claims not challenged in the Meta-MDT-IPR)." Ex.2041, 5. This is a red herring. First, Petitioners' invalidity challenges in the '541-IPR are directed only at claims that were challenged in the Meta-MDT-IPRs. *Compare* Ex.2003, 2-3*, with* Ex.2048, 2-3. Furthermore, Petitioners' conduct shows that PO's EDTX-Litigation infringement contentions are irrelevant to Petitioners' IPR positions. PO did not assert in the EDTX-Litigation any of the claims challenged by Petitioners' Grounds2-3 and 5-6. Ex.2026, 3. Indeed, Petitioners have no good reason to include Grounds 2-3 and 5-6 in the '541-IPR other than to unnecessarily burden the Board and PO, tying their interest to Meta's, and abusing the IPR process.

resources. Instead, Petitioners bypassed the obvious route—filing a joinder motion by July 11, 2024, under 37 C.F.R. §122(b)—recycling the same Neibauer Grounds with "common references and arguments," (Ranking, 5), from Meta-MDT-IPRs, and filing it as a new petition. This amounts to abuse of the IPR process and unduly burdens the Board and PO.

A prompt joinder would have cast Petitioners as understudy should MDT and Meta settle, conserved the Board's finite resources, and satisfied the Board's preference for joinder where, like in this case, no new issues arise. *See EndyMed Medical Ltd. v. Serendia, LLC*, IPR2024-00843, Paper 14, 12 (P.T.A.B. Jan. 10, 2025) ("[T]here is a policy preference for joining a later petitioner if their petition does not present new issues that might complicate or delay an existing proceeding."). Petitioners' excuse for not filing a joinder fails. *See supra* note 22.

a) Petitioners' failure to identify "all real parties in interest" is a discretionary consideration

As explained above, Petitioners attempted but failed to invalidate the claims of the '336 Patent through an *ex parte* reexamination request filed by Unified in June 2023. Given Petitioners' membership in Unified, Petitioners should have listed Unified as a real party in interest. Their failure to do so is abuse.

"[T]he focus of the real-party-in-interest inquiry is on the patentability of the claims challenged in the IPR petition, bearing in mind who will benefit from having those claims canceled or invalidated." *Applications in Internet Time, LLC v. RPX*

Corp., 897 F.3d 1336, 1348 (Fed.Cir.2018). "Determining whether a non-party is a 'real party in interest' ***demands a flexible approach*** that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that ***has a preexisting, established relationship with the petitioner***." *Id.*, 1351. This inquiry requires examining the IPR petitioner's relationship with the non-party to determine whether the IPR petitioner represents the non-party's interest in invalidating the challenged claims. *Id.*

It is undisputed that Petitioners and Unified have a pre-existing, established relationship, as Petitioners are paying members of Unified. Ex.2046, 1 n.2. And it is without question that Unified stands to benefit from the outcome of Petitioners' IPRs, should that outcome be favorable to Petitioners. Unified expended the resources necessary to prepare and file the reexamination request against the '336 Patent, which shows Unified's interest in invalidating the claims of the Asserted Patents. Unified publicly states that "Unified exists to break the cycle of patent assertion."[23] And as of 2024 Petitioners are "the most sued company in the U.S., with 69 patent infringement lawsuits involving 208 patents."[24] Thus, as evidenced by Petitioners' membership in Unified, Petitioners and Unified both benefit from

[23] https://www.unifiedpatents.com/success.

[24] https://www.greyb.com/blog/patent-litigation-trends/.

invalidating patents.

Despite knowing that Unified—which Petitioners are members of—benefit from the outcome of these IPRs, Petitioners failed to list Unified as a real party-in-interest. Petitioners' intentional concealment favors denial.

3. Petitioners' inconsistent rankings of the Petitions

Petitioners rank their twin Petitions inconsistently. For their Petitions against the '039 Patent, Petitioners rank the Petition asserting the Original Grounds (i.e., the '536-IPR) higher than the Petition asserting the Neibauer Grounds (i.e., the '535-IPR). Here, however, Petitioners rank the Petition asserting the Original Grounds (i.e., the '542-IPR) lower than the Petition asserting the Neibauer Grounds (i.e., the '541-IPR).

The Asserted Patents belong to the same family, as shown in Figure 1 above, and share nearly identical specifications. *See* Ex.2002. Petitioners do not explain why their ranking of the Petitions is inconsistent, and thus PO objects to Petitioners' capricious ranking.[25] If the Board were to institute Petitioners' higher-ranked

[25] In their response in the '535-IPR, Petitioners attempt to justify their inconsistent ranking by claiming that "Petitioners are challenging 16 claims in the ['039] patent not challenged by Meta," and that they ranked the IPR2025-00536 petition higher because "the Board would need to make some additional investment in analyzing

Petitions against the Asserted Patents, the Board would have to consider the Original Grounds for the '039 Patent and the Neibauer Grounds for the '348 Patent. Determining unpatentability based on "mutually exclusive" prior art references (Ranking, 3) for patents of the same family would unnecessarily impose additional burden on the Board, notably when the specifications of the '039 and '348 Patents are nearly identical, and the claims share common terms and limitations.

The Board should consider this as a factor favoring exercising discretion to deny institution in view of "the ability of the PTAB to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AIA proceedings, and other workload needs." March 26, 2025 Memo, 2-3.

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the prior art regardless of which set of grounds was selected." While Meta challenged independent claims 19 and 23, Petitioners' unpatentability arguments—including those for claims not addressed by Meta—are little more than a copy-and-paste of Meta's arguments for claims 19 and 23. For instance, Petitioners assert that independent claim 1—which Meta did not challenge—is invalidated by the exact same prior art disclosures that Meta cited against claim 19. Thus, because Petitioners themselves relied on the same disclosures for all challenged claims that Meta used for only a few, their claim of "additional investment" is nothing more than a red herring.

4. Petitioners' excessive reliance on expert testimony

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

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

Petitioners' 163-page-long expert declaration for their 97-page Petition is not "focused expert testimony." Nor does it provide any helpful context. In fact, contrary to the Board's direction that "it is not necessary for an expert to explain every aspect of the prior art" (FAQs, Q.21), Houh engages in a limitation-by-limitation obviousness analysis of the claims, and fills shortcomings in the prior art using only conclusory statements. PO presents examples here.

As a threshold matter, Houh takes inconsistent positions across Petitioners' multiple IPRs. In the '536-IPR, Houh's testimony stated that an individual Forum is an "'application-based information channel'" because Forums is an "application." Ex.2049, ¶¶125, 129. In the '542-IPR, the expert argued that the very same feature

is a "web-based shared information channel." Ex.1003, ¶¶130-31. Here, the expert based his conclusion on the notion that Forums is "like a fully personalized web portal." *Id.,* ¶132. In the '538-IPR, the expert used the individual Forum to map the claimed "mobile information channel." Ex.2050, ¶¶88, 95. The expert testimony provides no helpful context sufficient to resolve these inconsistencies. And to the extent the expert implies that that "web-based shared information channel," "application-based information channel," and "mobile information channel" are equivalent, Houh's testimony does not provide any explanation as to why.

In addressing the "web-based shared information channel" limitation, Houh cites Exhibits 1015 and 1014—references that are not included in any Asserted Ground—to discuss GSM and WAP functionality. Ex.1003, ¶¶58-60 (referencing disclosures in Exs.1015 and 1014). The expert does so to fill the gap he admits exists in Randall and Forsyth. But Forsyth is directed at neither WAP nor GSM and, as such, the expert's reference to GSM and WAP functionality does not constitute "providing helpful context" to understand any teaching of Forsyth. It is an attempt to gap-fill the prior art's teachings by expert testimony.

In fact, Forsyth does not mention even once "WAP" or "Wireless Application protocol," and teaches away from GSM-based platforms: "Wireless information devices based on the Symbian OS platform, are 'smarter' than current generation GSM phones in being able to offer multiple, advanced, robust client based

applications." Forsyth, 1:32-35. Forsyth specifically lists fundamental weaknesses associated with GSM phones making it unsuitable for Forsyth, e.g., "no single system fully and successfully accommodates the unique characteristics of communicating between groups of mobile users." Forsyth, 1:54-60.

As a further example, in his analysis of Ground 2, Houh admits that "Pelkey does not disclose details of the wireless network used to provide wireless messaging from the game system to the server." Ex.1003, ¶213. Nevertheless, he states his conclusory opinion that a "POSITA would have been motivated to use either GSM-SMS or WAP for the messaging service, rather than paging." *Id.* Other than his say-so, the expert offers no evidence supporting a conclusion that "where PagerWorld is implemented in a WAP environment, a POSITA would understand that selecting a specific portal from the main PagerWorld screen constitutes a web-based activity." *Id.*, ¶216.

Additionally, Houh relies on Eck's disclosure of "PagerWorld" for the "web-based shared information channel" limitation 1[E]/13[C]/17[C]. Ex.1003, ¶211. Despite admitting that Eck "uses the word 'PagerWorld' in the [Multiple User Dungeon] title to reflect the communication means is paging," the expert concludes that "a POSITA would have understood that such a MUD is equally applicable when the communication means is another messaging type such as SMS or messaging via a WAP protocol." *Id.* But the expert provides no citation to any reference that

supports, even remotely, his conclusion.

Houh also alleges that "each user is capable of sending and receiving messages, photos and sound clips and customizing their persona using, e.g., photos taken with the integrated digital camera," citing Eck, 11:32-35 and 12:16-19 (Ex.1003, ¶208), yet these portions of Eck merely disclose the message center of PagerWorld and the Address Book screen. Nowhere in these passages is there mention of a user sending a photo or sound clip or customizing their persona using photos taken with the integrated digital camera.

Such expert testimony "is particularly problematic in cases where, like here, expert testimony is offered not simply to provide a motivation to combine prior-art teachings, but rather to supply a limitation missing from the prior art." *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 5 (P.T.A.B. Aug. 24, 2022) (precedential) (citing *Arendi S.A.R.L. v. Apple, Inc.*, 832 F.3d 1355, 1361-62 (Fed.Cir.2016)).

b) Petitioners rely extensively on expert testimony

In addition to violating the requirement that expert testimony be focused to providing "helpful context," Petitioners also violate the requirement that their reliance on expert testimony not be "extensive." The overwhelming majority of the content of the Petition appears verbatim in Houh's testimony. Ex.2035 (providing numerous examples of copy-pasting from Ex.1003 into the Petition).

As further evidence of Petitioners' copy-paste of their expert declaration, typographical errors in the declaration are repeated in the Petition: "The Randall-Forsyth combination discloses '*reciev[ing]* [sic, receiving] *first device-captured data from a first one of the mobile devices via the network interface'* [1C] and '*reciev[ing]* [sic, receiving] *second device-captured data from a second one of the mobile devices via the network interface* [1D].'" Pet.23; Ex.1003, ¶108; *see also* Pet.74; Ex.1003, ¶208 ("The Pelkey-Eck combination also discloses '*reciev[ing] [sic, receiving] second device-captured data …*").

Additionally, substantive errors in the declaration are also repeated in the Petition. When discussing Ground 2, the Petition argues "As shown in this figure [on page 80], the message received at the user's device includes the captured content ***and the determined information***." Pet.80. The '348 Patent claims, however, do not contain a limitation regarding determined information. Houh repeats this error in his declaration. Ex.1003, ¶ 219.

Regarding the "personalized content application" limitation, Petitioners cite three paragraphs spanning two full pages in their expert declaration. Pet.33. The discussion from their expert declaration, however, appears nowhere in the Petition and thus this constitutes impermissible incorporation by reference. *Cisco Systems, Inc. v. C-Cation Techs.*, IPR2014-00454, Paper 12, 9 (P.T.A.B. Aug. 29, 2014) (informative) (providing that "practice of citing the Declaration to support

conclusory statements that are not otherwise supported in the Petition also amounts to incorporation by reference"). Furthermore, Houh's declaration does not qualify as a prior art in this proceeding. *Meta Platforms, Inc., et al. v. Eight kHz, LLC*, IPR2023-01023, Paper 10, 31 (P.T.A.B. Jan. 9, 2024) ("We further note that several of Petitioner's assertions are supported only by VR Book (Ex. 1063), which is not relied upon as the basis for this challenge, or Dr. Begault's deposition testimony, ***which does not qualify as prior art in this proceeding***.").

Additionally, Houh's declaration addresses references not relied upon as the basis for Petitioners' Ground 1. *See* Ex.1003, ¶¶58-60 (discussing Ex.1015), ¶133 (referring to arguments made in §IV.A.1.c.(2) of the declaration with regard Ex.1014). Petitioners cannot rely—directly or indirectly through expert testimony—on references not asserted in Ground 1 to gap-fill a missing limitation in Randall and Forsyth. *See Meta Platforms, Inc.*, IPR2023-01023, Paper 10, 31 ("We further note that several of Petitioner's assertions are supported only by VR Book (Ex. 1063), ***which is not relied upon as the basis for this challenge***, or Dr. Begault's deposition testimony, which does not qualify as prior art in this proceeding.").

For Ground 2, Petitioners again copy-paste, almost verbatim, conclusory statements from their expert declaration into the Petition to provide a motivation to combine and to support limitations missing from Pelkey and Eck. *See* Ex.2035, 24-49. A "petitioner cannot employ mere conclusory statements. The petitioner must

instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed.Cir.2016).

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

5. The '542 Petition lacks merit

"A full merits analysis is not necessary as part of deciding whether to exercise discretion not to institute, but rather the merits [may] tip the balance." *Fintiv*, Paper 15, 15. Even "compelling merits alone is not dispositive in making the [*Fintiv*] assessment." March 24, 2025 Memo, 3; *see also Nokia Of America Corp v. Pegasus Wireless Innovation LLC*, IPR2025-00036, Paper 14, 17-18 (P.T.A.B. Apr. 25, 2025) ("***[W]e determine that the strength of the merits is obviated by the efficiency and timeliness of the parallel district court proceeding and, therefore, determine that considerations of the sixth Fintiv factor are neutral***."). Accordingly, because of the strength of other factors and considerations suffice for *Fintiv* purposes, the Board need not engage in an assessment of merits. If, however, the Board considers an assessment of merits in its holistic approach to *Fintiv*, the Petition is weak.

Finally, while Patent Owner addresses both Grounds, a showing that Petitioners have failed to meet their burden as to one Ground suffices to

discretionarily deny institution as to both Grounds. *See Samsung Electronics Co. v. Kp Innovations 2 LLC*, IPR2025-00101, Paper 13, 27-28 (P.T.A.B May 12, 2025). In light of *SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 373 (2018), it would not be an efficient use of the Board's time and resources to institute review in such a case. *See Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9, 10-11 (P.T.A.B. Nov. 7, 2018) (informative); *see also Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7, 41-43 (P.T.A.B. Jan. 24, 2019) (informative).

a) The Petition Fails to Set Forth the Grounds with the Required Particularly

An IPR petition must identify "with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim." 35 U.S.C. §312(a)(3). "In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable." *Harmonic Inc. v Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed.Cir.2016) (citing 35 U.S.C. §312(a)(3)). The PTAB Trial Practice Guide advises that "parties should avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on ***concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence*** of record." CTPG, 39. Further, "[t]he petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon." 37 C.F.R. §42.104(b)(4).

"The statutory requirement of particularity in a petition for IPR takes on heightened importance when considered in conjunction with SAS's 'all-or-nothing' approach," and "the Board may consider whether a lack of particularity as to one or more of the asserted grounds justifies denial of an entire petition." *Adaptics LTD. v. Perfect Co.*, IPR2018-01596, Paper 20 (P.T.A.B. Mar. 6, 2019) (informative).

Here, instead of presenting a particularized argument and "specify[ing] where each element of the claim is found in the prior art patents or printed publications relied upon" as required by 37 C.F.R. §42.104(b)(4), the Petition parses claim elements, addresses terms out of context, and jumps between disparate discussions in the references. The Petition obfuscates the actual argument and basis for Petitioners' supposed reasonable grounds for invalidity. The Petition is anything but "concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence." CTPG, 39.

For example, Petitioners impermissibly blend the disclosure of Randall with that of Forsyth when discussing the "Forums server." Petitioners cannot argue that "the Forums server" provides features disclosed in Randall and features disclosed in Forsyth, without addressing the combination, which Petitioners failed to do. *See, e.g., Intel Corp. v. Tela Innovations*, IPR2019-01521, Paper 65, 25 (P.T.A.B. Mar. 9, 2021) ("***It is not sufficient to demonstrate that each of the components in a challenged claim is known in the prior art***; ***Petitioner must also explain why a***

POSITA would have combined the elements disclosed in the separate embodiments described in [a single reference].”).

In the context of independent claim 1, Petitioners argue “The Randall-Forsyth combination, as informed by general knowledge of a POSITA, teaches or at least suggests an ‘*apparatus*’ (server) includes ‘a processing element….’” Pet.17. The Petition refers repeatedly to the “Forums server,” as if it were a single, identified server. *Id.,* 18 (“***The Forums server*** performs…”). But here, again, despite discussing a singular “Forums server,” the Petition ambiguously refers to servers of each of Forsyth and Randall and cites to its expert’s equally ambiguous discussion of both. *Id.* citing Ex.1003, ¶88; *see also id.* (“***the server*** includes ‘a memory’…”; “***The Forums server*** acts as ‘a store for resources…’”). While Petitioners point to the “Private Forum Server” in Randall, Figure 4, they also quote from Forsyth in describing the “server.” *See* Pet.18 (“Specifically, the Forums server acts as ‘a store for resources which group-members may wish to discuss and share (e.g., personal information, personal photographs, music, web sites, etc.).’” citing 3:31-34). This portion of Forsyth describes a “central server,” also described as a “remote server … designed to handle all aspects of storing and forwarding messages to the intended recipients, maintaining massage [sic, message] threads and making then [sic, them] readable to recipients etc.” 3:21-24. This server is not illustrated in any of Forsyth’s figures and is not referred to as the “private Forum server” of Randall, so the Petition

fails to establish which disclosure of either reference allegedly corresponds to the apparatus required by limitations 1[A] and 1[B].

With regard to the processing limitations 1[C]-1[D]/13[A]-13[B]/17[A]-17[B], Petitioners argue Forums receives first and second device-captured data at the "server." Pet.27-28. The Petition then describes *that server* with references to Randall's inclusion in Figure 4 of the "private Forum Server" ***and*** in the very same sentence, continues describing *that server* by quoting from Forsyth. Pet.28.

Houh likewise impermissibly cites to Randall and Forsyth when describing the "Forums server" without even attempting to establish the servers are the same. Ex.1003, ¶117 ("As I discussed above, the server, illustrated in ***Randall's Figure 4*** below, 'handles contacting each group member, storing messages, allowing message to be read, sending, receiving and distributing messages.' ***Forsyth, 3:28-31***; Randall, 57:4 (describing 'server side software'), 38:24 (describing server side message handling applications')."; *see also* ¶88 ("***Both*** Randall and Forsyth describe that ***the server*** performs…"), ¶49 (describing the "Symbian Forums server" functionality with reference to Forsyth and its implementation ("ServML") with reference to Randall), ¶65 ("Forsyth enhances the functionality of ***the Symbian infrastructure***"). Petitioners fail to establish that the server in Randall is the same server as in Forsyth and thus impermissibly blend the disclosures in these references.

It is not the PO's or the Board's job to decipher the alleged teachings;

Petitioners have the burden, which they have not met. *See* 35 U.S.C. §312(a)(3); 37 C.F.R. §42.104(b)(4).

b) Petitioners Rely on Prior Art that Lacks Material Claim Limitation "web-based shared information channel"

As a threshold matter, parroting their expert's conclusory statements, Petitioners also take inconsistent positions: the individual Forum is the application-based information channel in the '536 Petition, the web-based shared information channel in this Petition, and the mobile information channel in the '538 Petition. ***The Board should resolve this double-speak against Petitioners on merits***. *See Google LLC v. Makor Issues & Rights Ltd.*, IPR2017-00815, Paper 31, 24 (P.T.A.B. Aug. 10, 2018) (noting a party's failure to "explain persuasively" why it has "taken inconsistent positions between IPRs with respect to this limitation."); *see also Meta Platforms, Inc. v. Eight kHz, LLC*, IPR2023-01004, Paper 9, 29-30 (P.T.A.B. Jan. 9, 2024) (pointing to inconsistencies in the petitioner's positions regarding the prior art teachings across two IPRs).

Further, the Petition fails to establish that an individual Forum is a "web-based" shared information channel, as required by each independent claim. *See* limitation 1[F]/13[C]/17[C]. Petitioners cite to two lines in Randall to support their argument that the Forums user interface pages are provided to users via the web. Pet.35 (citing Randall, 45:14-15). These two lines of Randall do not establish that the web is used: "ServML embraces existing standards and initiatives such as

SyncML and XML and uses standard data transports such as WAP or http for data access." Using standard data transports does not teach or suggest that the information is provided via the web. Tellingly, Petitioners turn to other references to fill this gap. Pet.35 (citing EX-1013 and EX-1027); *see also id.*, 78-79 (citing EX-1013, EX-1027, and EX-1020). These references, however, are not relied upon in either Ground, and thus should not be considered. *See Helmerich & Payne Int'l Drilling Co. v. Nabors Drilling Techs. USA, Inc.*, IPR2021-00671, 2021 WL 4864389, *8 (P.T.A.B. Oct. 1, 2021) (holding "Petitioner's and its expert's reliance on several references beyond those in the stated ground as purported evidence of knowledge in the art indicates the use of improper hindsight reasoning").

Petitioners also point to the "ADS naming convention" in Randall to support that Forums are designed to be mobile websites accessible "via the web." Pet.36. The ADS number, however, is not associated with the Forums interface. It is a "pointer to ***entity specific data*** held on the web server," as Petitioners admit. *Id.*; *see also* Randall, 9:13-15 ("wireless information device (as well as web browsers) can access ***an entity's database*** by sending to the server an unchanging pointer or key (an 'ADS number') which is unique to that entity"). Petitioners' hypothetical scenario of a user entering an "ADS number associated with the Forum, Naked Chef (e.g., www.forums.com/NakedChef)" (Pet.37) ***appears nowhere*** in Randall and is inconsistent with the express teachings of Randall that the ADS number points to an

entity's database, not a Forum. Indeed, the only support for this hypothetical scenario is conclusory statements in Houh's declaration. *Id.* (citing Ex.1003, ¶137). Thus, Petitioners' argument that the ADS number supports that Forums is a web-based shared information channel fails.

c) Ground 2 Fails Because Petitioners Do Not Identify a Basis to Combine Pelkey and Eck

Ground 2 of the Petition asserts that the combination of Pelkey (Ex.1007) and Eck (Ex.1008) discloses or renders obvious every element of the independent claims of the '348 Patent. This ground also fails. Petitioners' explanation to combine Pelkey and Eck is nothing more than impermissible hindsight.

Petitioners fail to identify any plausible motivation to combine the teachings of Pelkey and Eck. Petitioners merely state, without support, that a "POSITA would have been motivated to combine Eck's teachings regarding PagerWorld with the network and message server architecture taught in Pelkey." Pet.58.

As an initial matter, the holes in Petitioners' argument are particularly notable given their admissions as to the deficiencies of Pelkey and Eck. Admitted deficiencies include:

(i) Eck does not describe a client-server structure as taught in Pelkey (Ex.1003, ¶183; Pet.59-60);

(ii) Pelkey does not describe integration of messaging and sharing content like photos with multiple users (Ex.1003, ¶176; Pet.60); and

(iii) Pelkey does not describe any in-game messaging (Ex.1003, ¶176; Pet.60).

Petitioners argue that a "POSITA would be motivated to apply the network and message server architecture in Pelkey to Eck in order to avoid the charge-based system for exchanging messages and photos via pager cartridge in Eck. (EX-1003, ¶176.)" Pet.59. This is contrary to the teaching of Eck, which solves any issue regarding "cost" an entirely different way. Specifically, Eck teaches that a user can turn to "user-generated custom libraries of words, phrases and graphics" to reduce message length. This practice is called "coding," which Eck expressly acknowledges can be used "to reduce message length" and thus "reduce message charges." Eck, 16:59-60; *see also id*. 16:49-63 ("It can be seen that by using 'coding', the length of the messages may be reduced."). Petitioners and their expert point to no evidence to support a combination of Pelkey and Eck based on cost reduction, failing to address the additional costs of the proposed modification (e.g., communication and bandwidth costs of the proposed network and message server architecture) or the specific savings that would motivate the combination or prompt a user to switch to GSM-SMS or WAP. *In re Schmidt*, 892 F.2d 1051, *2 (Fed.Cir.1989) ("[W]hile we agree that cost saving may serve as a motive for making

a modification, ***it must be clear at least that the modification, in fact, effects a reduction in the cost.***").

Petitioners continue that "a POSITA would be motivated to modify the 'pager cartridge' in Eck as necessary to use PagerWorld in Pelkey given the disclosed benefits of PagerWorld including 'exploration and adventure,' 'chat and community interaction,' and 'character growth.'" Pet.59 (citing Ex.1003, ¶176; Eck 10:13-19). The statement is nonsensical: it admits that Eck, through its pager cartridge, already provides the benefits of 'exploration and adventure,' 'chat and community interaction,' and 'character growth,' so why would its structure and operation need to change? *See* Eck, 10:1-19 (explaining an application of "pager cartridge 100" is Multiple User Dungeon (MUD) games that provide these benefits). Petitioners do not answer this question. Instead, the statement highlights their use of impermissible hindsight.

Finally, Petitioners parrot their expert's conclusory opinions that Eck's PagerWorld game is a known technique, Pelkey's client-server based messaging server is a known method/product, and "[r]eplacing the pager system infrastructure system in Eck with the client-server architecture in Pelkey is the simple substitution of one known element for another to achieve a predictable result (internet-based functionality)." Pet.60 citing EX-1003, ¶176. But the expert never explains what those modifications would be given differences in operation and architecture.

Indeed, the expert provides no explanation of how a pager cartridge could be replaced with a hypothetical "GSM-SMS or WAP cartridge" in the system of Eck.

Petitioners have thus failed to provide a sufficient explanation of the combination of Pelkey and Eck or the motivation to combine them. This applies to all '348 Patent claims.

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

On balance, the evidence of record favors exercising discretion to deny institution of the '542-IPR on *Fintiv* grounds.

IV. CONCLUSION

Analyses under the CTPG framework for parallel petitions and *Fintiv* independently favor denying institution of the '542-IPR.

Date: June 16, 2025

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), the undersigned hereby certifies that the foregoing Patent Owner's Discretionary Denial Brief contains 13,987 words using the word count feature of Microsoft Word.

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