UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

MOBILE DATA TECHNOLOGIES LLC,

Patent Owner

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

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 IPR2025-00542 (Feb. 6, 2025)
2004	Federal Register / Vol. 89, No. 77 / Friday, April 19, 2024 / Proposed Rules (Pages 28693-28706)
2005	Return of Service filed in the EDTX-Litigation (June 21, 2024)
2006	E-mail from the Board regarding the 535 and 536 IPR panel assignments (May 2, 2025)
2007	Decision Granting Institution of *Inter Partes* Review in IPR2024-00250 (June 11, 2024)
2008	E-mail from Erick S. Robinson memorializing the phone conversation with Petitioners' counsel (September 26, 2024)
2009	Comparison of independent claims of the '348 and '5801 Patents
2010	U.S. Patent No. 6,594,347 ("Calder")
2011	Examples of verbatim copy-pasting from Meta-MDT-IPRs by Petitioners
2012	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 (September 30, 2024)
2018	E-mail from Petitioners' counsel serving their initial and additional disclosures (October 16, 2024)
2019	E-mail from Petitioners' counsel serving their invalidity contentions (January 31, 2025)
2020	E-mail from Petitioners providing materials produced by third-party Microsoft Corporation and Sybase, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (April 25, 2025)

Ex.	Description
2021	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (March 7, 2025)
2022	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 24, 2025)
2023	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 21, 2025)
2024	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 11, 2025)
2025	E-mail from Petitioners providing materials produced by third-party AT&T Mobility LLC in response to Petitioners' subpoena in the EDTX-Litigation (February 5, 2025)
2026	Patent Owner's Infringement Contentions in the EDTX-Litigation (September 4, 2024)
2027	Petitioners' Invalidity Contentions in the EDTX-Litigation (January 31, 2025)
2028	E-mail exchange between Homayoon Rafatijo and Petitioners' counsel regarding Petitioners' contacting the Board for filing their proposed *Sotera* stipulation (April 21-23, 2025)
2029	E-mail from Petitioners' counsel with a draft of a proposed communication to the Board (April 30, 2025)
2030	E-mail from Petitioners' counsel 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 Yahoo! System art (January 31, 2025)
2034	Petition for *Inter Partes* Review in IPR2024-00250 (Dec. 6, 2023)
2035	Summary of verbatim (or nearly verbatim) matches between the '541 Petition to the Houh Declaration (Ex.1002)
2036	U.S. Patent No. 6,760,046 ("I'Anson")
2037	Reserved
2038	Order of the EDTX court for expedited motion practice

Ex.	Description
2039	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)
2040	Petitioners' expert declaration from the '535 IPR.
2041	Reserved
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	Petitioners' expert declaration from the '537 IPR.
2044	Reserved
2045	Prosecution history of the 039 Patent
2046	Reserved
2047	Worldwide Application 2001/082139 ("Sahota")
2048	Redacted version of Samsung's Motion for Relief from Protective Order filed in the EDTX-Litigation (May 29, 2025)

I. INTRODUCTION

On June 10, 2024, Patent Owner ("PO") filed a patent infringement complaint ("Complaint") against Petitioners in the Eastern District of Texas. *Mobile Data Technologies LLC v. Samsung Electronics Co. et al.*, 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. On the same 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 five patents asserted in the EDTX-Litigation as the "Asserted Patents." As shown in Figure 1 below, the Asserted Patents arise from a common family and share nearly identical specifications. *See, e.g.*, Ex.2002 (comparing specifications of the '348 and '578 Patents).

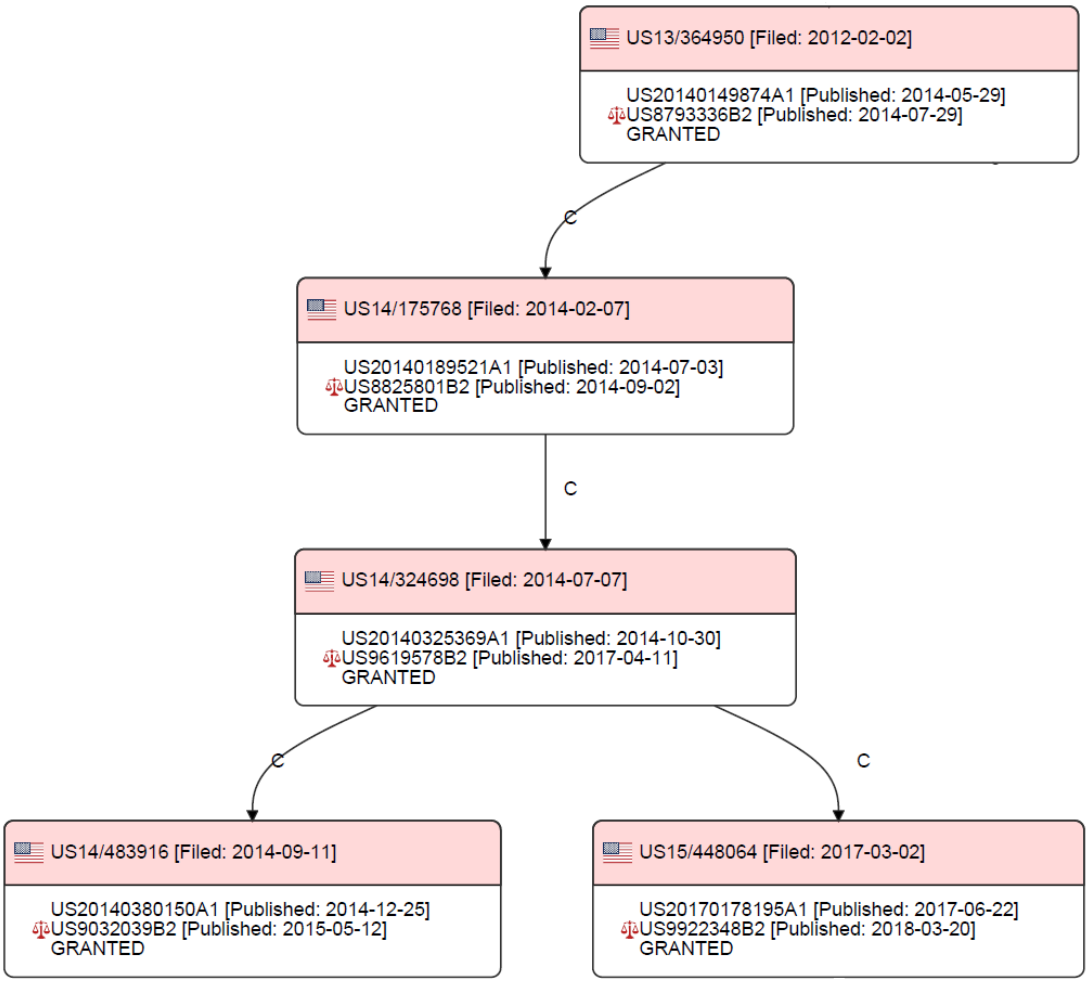

Figure 1. Family tree for the Asserted Patents.

Nearly eight months into the EDTX-Litigation, and after the service of both invalidity and infringement contentions, Petitioners filed *ten* IPR petitions—two against each Asserted Patent—on what they characterize as "mutually exclusive grounds." Paper 4 ("Ranking"), 3. The first set simply asserts the Neibauer-based combinations ("Neibauer Grounds") that Meta Platforms, Inc. ("Meta") advanced in *Meta Platforms, Inc. v. Mobile Data Techs., LLC*, IPR2024-00250 (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. However, characterizing them as merely "common references and arguments" is far too generous: Petitioners have copied the Meta-MDT-IPRs petition almost word-for-word and dropped it into the '541 Petition, substituting little more than the caption. *See* Ex.2011 (providing examples of verbatim copy-pasting from the Meta-MDT-IPR Petition). The second set of petitions asserts invalidity grounds based on Randall-Forsyth and Pelkey-Eck combinations (collectively, the "Original Grounds"). Yet Petitioners advance identical claim construction positions in both the Original and Neibauer Grounds—Petitioners' proposed constructions appear verbatim in each petition. *Compare* Petition, 6-8*, with* Ex.2003, 5-7.

For three independent reasons, the Board should exercise its discretion to deny institution of the '541-IPR:

1. Under the *General Plastic* factors, Petitioners' serial petitions on the same

[1] PO and Meta jointly informed the Board of their settlement on February 21, 2025—before PO filed its sur-reply and before the parties filed motions 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.

patents as the Meta-MDT-IPRs should be denied.

2. Under *Advanced Bionics*, the art asserted in the '541 Petition was before the Examiner during examination of the '348 Patent, and Petitioners have made no demonstration that the Office made an error material to patentability of the challenged claims.

3. The *Fintiv* factors weigh heavily in favor of denial. The EDTX-Litigation is scheduled for an April 2026 jury trial—six months before any IPR would conclude, even if the Board were to institute. In addition, there is substantial overlap between the '541-IPR and the EDTX-Litigation as Petitioner relies on system art in the EDTX-Litigation that corresponds to the references relied upon in the Petition. Furthermore, the Petition relies excessively on expert testimony and lacks merit, as demonstrated below.

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

II. Discretionary Denial under *General Plastic* Framework

The Board should deny the '541-IPR under *General Plastic*, which provided a seven-factor analysis addressing serial IPR petitions challenging the same patents. *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017).

Although *General Plastic* addressed serial petitions by a single petitioner, the

Board's precedential decision in *Valve Corp. v. Electronic Scripting Products, Inc.* expressly expanded the scope of *General Plastic*'s applicability to situations involving multiple petitioners, such as here:

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

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

A. Factor 1: Relationship Between Petitioner and Meta

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

> We determine, however, that Petitioner implicitly created such a relationship by ***using the prior petitioners' work as a menu and picking and choosing from their work product.*** The instant ***Petitioner's decision to use the prior petitions as a roadmap for its own petition ties the interests of all of the petitioners together***.

[2] All emphases added unless otherwise stated.

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

Petitioners have used the Meta-MDT-IPRs not merely as a roadmap but as a source document for their carbon-copy '541 Petition (*see* Ex.2011), and thus implicitly created a relationship between Petitioners and Meta under *Ericsson*. Indeed, the '541-IPR reads like an annotated reissue of the Meta-MDT-IPRs.[3] Petitioners concede that, in the '541-IPR, they advance the same "common references and arguments" Meta deployed in the Meta-MDT-IPRs. Ranking, 5. And the Petition confirms the borrowing at every turn. The prior art references and combinations mirror Meta's. *Id.* The claim construction positions replicate Meta's.

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

Petition, 5-8. Finally, Petitioners admit they burden the Board with Grounds 4-6 "solely to account for a potential construction of 'web-based shared information channel' proposed by Meta in the **MDT-Meta-Litigation**." Petition, 8. Unless Petitioners intend to create an implicit relationship between themselves and Meta, it is unclear why Petitioners should advocate a construction proposed by Meta in ***the MDT-Meta-Litigation***. Given that Petitioners filed the '541 Petition while the MDT-Meta-Litigation was pending, Petitioners implicitly tied their interest to Meta in the MDT-Meta-Litigation by addressing Meta's construction in the MDT-Meta-Litigation in this IPR.

Further, Petitioners rely on the declaration of Meta's expert, Dr. Hall-Ellis, and Meta's Reply from the Meta-MDT-IPRs, and file them as Exhibits (*See* Exs.1026 and 1033). Indeed, Petitioners cite the declaration of Dr. Hall-Ellis, ***whom Petitioners have not retained in this proceeding***, in support of Neibauer's prior art status. Petition, 1-2 (citing Ex.1026). Even though PO has the right to depose Dr. Hall-Ellis in this proceeding given Petitioners' reliance on Dr. Hall-Ellis (*see* 37 CFR §42.53), Petitioners cannot make Dr. Hall-Ellis available for cross-examination. Petitioners' reliance on the declaration of Meta's expert not retained in this proceeding prejudices PO.

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

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

This factor is neutral, because Meta filed the Meta-MDT-IPRs before the Complaint was filed against Petitioners. However, Petitioners had opportunity to join the Meta-MDT-IPRs any time between June 17, 2024, when they were served with the Complaint in the EDTX-Litigation, and July 11, 2024, per 37 C.F.R. §42.122(b). Petitioners failed to do so.

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

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

It is undisputed that Petitioners benefitted from having the opportunity to study PO's Response and Preliminary Response in the Meta-MDT-IPRs prior to filing their follow-on petitions. Petitioners waited eight months after the Meta-MDT-IPRs' institution decision—a year after PO filed its Preliminary Response and four months after PO filed its Response in the Meta-MDT-IPRs—before filing the '541-IPR. They then used that Response as an exhibit and attempted to rebut PO's arguments presented in it. Petition, 11-12, 16 (citing Ex. 1030).

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

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

Petitioners were served with the Complaint in the EDTX-Litigation on June 17, 2024—less than one week after the Board instituted trial on the '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 IPR. Had Petitioners 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).[4] Petitioners offer no explanation for letting that window close. *See*

[4] In a motion filed in the EDTX-Litigation, Petitioners claimed 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.2048, 5. This is a red herring. First, Petitioners' invalidity challenges in this IPR are directed only at those claims that were challenged in the Meta-MDT-IPRs. *Compare* Pet.2-3, *with* Ex.2034, 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' Grounds

Pfenex Inc. v. GlaxoSmithKline Biologicals SA, IPR2019-01478, Paper 9, 12 (P.T.A.B. Feb. 10, 2020) ("Moreover, if Petitioner was interested in pursuing the same challenge as that presented in the 230 IPR, it could have requested joinder under 37 C.F.R. §42.122(b). … That the 230 IPR settled after institution is not an adequate excuse for delay.").

Even if Petitioners somehow missed the Meta-MDT-IPRs institution decision, the timeline condemns their conduct. Petitioners concede that the '541-IPR re-packages the very "common references and arguments" used in the Meta-MDT-IPRs (Ranking, 5), yet they waited nearly eight months to file—long after PO served its Response in the Meta-MDT-IPRs, PO's expert sat for deposition, and Meta filed its Reply. There is no dispute Petitioners were aware of the Meta-MDT-IPRs at least by September 2024 when they asked PO about a stay in the EDTX-Litigation pending the Meta-MDT-IPRs. Ex.2008. Yet, Petitioners did not file the '541-IPR petition until over four months later. Such delay is inexcusable; it is simple opportunism masquerading as diligence.

These factors weigh strongly in favor of exercising discretion to deny

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2-3 and 5-6. Ex.2026, 3. Indeed, Petitioners have no good reason to include Grounds 2-3 and 5-6 other than to unnecessarily burden the Board and PO, tying their interest to Meta's, and abusing the IPR process.

institution.

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

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

Filing multiple IPR petitions against the same patent—when joinder was readily available—subverts procedural economy and needlessly expends Board resources. Additionally, Petitioners have filed two petitions ('541- and '542-IPRs) on the '348 Patent. Coordinating two trials on the '348 Patent for the two petitions filed against the '348 Patent so that all FWDs issue within the statutory period imposes an unnecessary burden on the Board.

Moreover, Petitioners concede that the '541-IPR advances the same "common references and arguments" raised in the Meta-MDT-IPRs yet offer no reason they should benefit from the review of the Meta-MDT-IPRs. *See TomTom, Inc. v. Blackbird Tech, LLC*, IPR2017-02025, Paper 7, 15-17 (P.T.A.B. Mar. 12, 2018) (noting that the Board is "mindful of the potential inequity of parties filing multiple petitions," where a petitioner has "relie[d] on substantially similar references and

analyses”).

Accordingly, these factors weigh in favor of discretionary denial.

III. Discretionary Denial under *Advanced Bionics* Framework

In determining whether to institute an IPR, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art ***or*** arguments previously were presented to the Office.” 35 U.S.C. §325(d). The Board uses a two-part framework for evaluating arguments under Section 325(d): (1) whether the same or substantially the same art was previously presented to the Office ***or*** whether the same or substantially the same arguments were previously presented to the Office; and (2) if either condition of part one is satisfied, whether the petitioner has demonstrated the Office erred in a manner material to the patentability of the challenged claims. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8 (P.T.A.B. Feb. 13, 2020) (precedential).

When applying this framework, the Board considers the *Becton, Dickinson* factors that address the Board’s discretion to deny institution when a petition presents the same or substantially the same prior art ***or*** arguments previously presented to the Office during examination. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17-18 (P.T.A.B. Dec. 15, 2017) (precedential as to §III.C.5, first paragraph).

Petitioners fail to substantively address the "material error" prong of the *Advanced Bionics* other than stating that "the Examiner materially erred in failing to rely on Neibauer, Cheng, and Squibbs to reject the challenged claims." Petition, 68. The Board should not reward Petitioners by allowing them to raise new arguments to address the "material error" in their response to this Discretionary Denial brief. If the Board entertains any such late-presented arguments, PO respectfully requests the Board allow PO an opportunity to reply.

Finally, PO addresses the *Advanced Bionics* framework for all prior art references asserted by Petitioners. However, the Board need not address grounds including McElfresh and Squibbs (Grounds 2-3 and 5-6) if the Board determines discretionary denial of Grounds 1 and 4 is warranted under *Advanced Bionics*. Petitioners use Squibbs only for two claims and McElfresh only for five claims. Even if the Board determines that only grounds based on McElfresh and Squibbs were to survive *Advanced Bionics* (they do not), upon institution the Board still must consider the other grounds challenging 12 claims. *See BioDelivery Sciences International, Inc. v. Aquesitive Therapeutics, Inc.*, 898 F.3d 1205, 1209 (Fed.Cir.2018) ("We agree that *SAS* requires institution on all challenged claims and all challenged grounds."). It would not be an efficient use of the Board's time and resources to institute review in such a case, where the overwhelming majority of Petitioners' challenges are precluded under *Advanced Bionics*. *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. *Advanced Bionics* Factors

1. Neibauer, Cheng, and Squibbs

Advanced Bionics*'s first prong is met* as Petitioners concede that Neibauer, Cheng, and Squibbs "were considered by the Examiner." Petition, 67. Petitioners argue, however, that because "these references were among hundreds of prior art references cited during prosecution" the Examiner's "consideration of Neibauer, Cheng, and Squibbs does not raise §325(d) issues in light of the uneventful prosecution history." *Id.* Petitioners' argument fails.

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

provide an analysis even when the asserted prior art is on an IDS, but the Examiner did not apply the reference." *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13, 5 (P.T.A.B. May 19, 2025) (precedential as to §A).

The Examiner evaluated Neibauer, Cheng, and Squibbs, as Petitioners concede, during examination of the '348 Patent. Each of these references appear in IDS, as well as on the face of the '348 Patent. Ex.1022, 195, 212, 174, 177. Specifically, the IDS note that Examiner must "[i]nitial if reference considered … or [d]raw line through a citation if … not considered." The Examiner initialed the IDS without lining through Neibauer, Cheng, and Squibbs. *See, e.g.*, *id.*, 191, 199. Indeed, the Examiner annotated each IDS page including Neibauer, Cheng, and Squibbs, adding the following statement:

> ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /J.J/
>
> **Page 177 of 310**

Id. The Board should thus decline to institute trial in the '541-IPR because the same prior art references were considered by the Examiner.

Turning to *Advanced Bionics*'s second prong, Petitioners argue that the Examiner "materially erred in failing to rely on Neibauer and Cheng to reject the challenged claims." Petition, 68. For support, Petitioners merely drop a conclusory statement devoid of any analysis: "These references confirm that all limitations of

the claims were obvious in view of the prior art – including the limitations that the Examiner found missing from McGerry." *Id.* The Director has made clear that such conclusory statements do not suffice:

> A petitioner also may point to the fact that even though the asserted prior art is listed on an IDS, the Examiner did not issue any prior art rejections during examination, so the Examiner materially erred by ***overlooking certain teachings in the prior art on the IDS***.

Ecto World, IPR2024-01280, Paper 13, 5. Petitioners do not point to teachings in the prior art that the Examiner overlooked.

Indeed, the record conclusively establishes that the Examiner was aware of the teachings of Neibauer and Cheng during the prosecution but did not find them relevant for determining patentability of the claims of the '348 Patent. The application that matured into the '348 Patent was filed on March 2, 2017. Ex.1001, 1. The great-grandparent of the '348 Patent is U.S. Patent 8,135,801 (the "'5801 Patent"). On May 14, 2012, the '5801 Patent—with materially different claims and limitations than those of the '578 Patent (*see* Ex.2009 (comparing independent claims of the '348 and '5801 Patents))—was found invalid in an *inter partes* reexamination proceeding based on a combination of Neibauer and Cheng. The PTAB affirmed in October 2014. *See* Ex.1024. The Examiner of the '348 Patent was the same Examiner of the great-grandparent '5801 Patent that was later reexamined and was also the Examiner for all other Patents in the family. The Examiner entered the record of that reexamination proceeding in the prosecution of the '348 Patent.

Ex.1022, 202. (IDS containing three documents related to the reexamination proceeding, including Record of Oral Hearing in *Facebook, Inc*. v. *Wireless Ink Corp.*, Appeal 2014-007363, Reexamination No. 95/001,989, and Decision in *Facebook, Inc.* v. *Wireless Ink Corp*., Appeal 2014-007363, Reexamination No. 95/001,989). Thus, the Examiner had knowledge of the reexamination proceeding—that was concluded prior to the '348 Patent Application filing—and its use of Neibauer and Cheng.

Furthermore, as explained above, the Examiner evaluated Neibauer and Cheng during examination of the '348 Patent because he initialed the IDS forms containing Neibauer and Cheng. Petitioners thus have not shown that the Examiner erred materially with respect to Neibauer and Cheng.

The Board should not bless Petitioners' invitation to second-guess the Examiner's judgment not to apply Neibauer and Cheng (alone or in combination) to the '348 Claims. The Board defers to "previous Office evaluations of the evidence of record unless material error is shown." *Advanced Bionics*, Paper 6, 9. A showing of material error is a high threshold: "[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability." *Id.* Petitioners have not cleared this high bar.

Finally, Petitioners' argument that the reexamination proceeding of the '5801 Patent led to the cancellation of all those claims is irrelevant. Petition, 67-68. Setting

aside Petitioners' exaggeration (***the PTAB affirmed the Examiner's rejection on grounds not involving Cheng*** (Ex.1024, 0014)), Petitioners' inference—that the reexamination result shows that not rejecting the '801 claims over Neibauer was material error—is belied by the vast differences between the claims of the '348 and '5801 Patents. *See* Ex.2009. The record shows the Examiner considered the potential relevance of the reexamination proceeding. Accordingly, Petitioners cannot rely on the reexamination outcome for the '5801 Patent to argue that the Examiner of the '348 Patent committed "material error" by not rejecting the '348 Patent claims based on Neibauer and Cheng.

2. Ausems

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

Petitioners cite Ausems for two reasons, each of which is cumulative of references relied upon by the Examiner during prosecution of the '348 Patent. First, Petitioners rely on Ausems as teaching "a mobile device that incorporated a digital camera for recording, storing, and transmitting digital images." Petition, 24. But Calder—a prior art reference specifically discussed by the Examiner in the family—

also teaches a mobile device with a video camera for image capture. Ex.1022, 178; Ex.2010, 2:27-30 ("[A]lternatively the mobile device may have a video camera for image capture whereby an interpretation of the image is converted into tones and the tones are transmitted to a telephony server.").[5] This teaching from Ausems is also disclosed in U.S. Patent 6,760,046 to I'Anson (Ex.2036)—a prior art reference considered by the Examiner. Ex.1022, 178, 159. I'Anson discloses

> Alternatively, mobile entity 20 could be a single unit such as ***a mobile phone with WAP functionality***. Of course, if only data transmission/reception is required … this is ***a PDA with built-in GSM data-capable functionality*** whilst another example is ***a digital camera (the data-handling subsystem) also with built-in GSM data-capable functionality enabling the upload [i.e., transmission] of digital images from the camera to a storage server***.

Ex.2036, 2:61-3:7. If not identical, this disclosure is substantially similar to Ausems's disclosure relied upon by Petitioners.

Second, Petitioners use Ausems for teaching a "mobile device [that] could

[5] The Examiner discussed Calder extensively in the prosecution of the '039 Patent. *See* Ex.2045, 160-162. The '039 Patent Application was filed nearly three years before the '348 Patent Application was filed. The '039 Patent was granted in 2015. Thus, the Examiner's discussion of Calder in the prosecution of the '039 Patent Application is evidence of the Examiner's knowledge of Calder's teaching during pendency of the '348 Patent Application.

have been 'a GPS-based navigational device.'" Petition, 36. But as Petitioners' expert testimony shows, the same is taught by the previously considered Squibbs: "Squibbs explains that the cell phone can determine location information in a number of ways, including from 'a location server of the mobile radio infrastructure,' or using 'a GPS system built into the cell phone.'" Ex.1002, ¶165 (citing Squibbs, ¶0098; ¶0101). And as discussed above, Squibbs was presented to the Office during prosecution.

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

3. McElfresh

Parroting Meta, Petitioners add McElfresh to their Neibauer Grounds to circumvent *Advanced Bionics*. Petitioners cite McElfresh for teaching "integrating advertisements into a webpage." Petition, 54. Petitioners cite McElfresh's Fig.3A and argue that the ad server or Rad Server 112 "gathers a set of ads … for placement on a website." Petition, 56. Petitioners argue that "the Rad Server 112 delivers a set of ads for display to the user." *Id.* Petitioners use McElfresh for the claimed "data feed" term, arguing that "the 'data feed' would have corresponded to a feed

containing a plurality of advertisements that would have been available for display … obtained by from Rad Server 112." Petition, 57.

These disclosures of McElfresh relied upon by Petitioners are "***substantially the same*** prior art" as Worldwide Application 2001/082139 to Sahota (Ex.2047), considered by the Examiner. Ex.1022, 189. Sahota discloses generating a "***data stream***" from "data [that] is extracted from the ***content from the disparate content sources***." Ex.2047, [0008]. This "***data stream is provided for display on one or more different type of platforms***." *Id.* Thus, Sahota's data stream is substantially similar to McElfresh's "a feed containing a plurality of advertisements that would have been available for display." Petition, 57.

Like McElfresh's Rad Server, Sahota discloses a server generating the data stream: "***[S]yndication server 110 can generate a standardized data stream*** from the XML file for display on multiple types of platforms or formats such as, for example, HTML." Ex.2047, [0033]. Sahota also discloses integration and target placement of content on a webpage by the syndication server: "***Syndication server 110 can incorporate enhanced Internet content*** with input signals 120 such that ***the enhanced content is targeted for set- top box 106***. In other embodiments, ***syndication server 110 can transform content on network 102 and target the content for other types of devices*** such as, for example, a personal computer." *Id.*; *see id.*, cl.45 ("[T]he delivering of the content and media assets includes integrating

the content and media assets within a broadcast for the receivers.”).

Finally, Sahota expressly discloses its content can be an advertisement designed for webpage placement: “The content can be from web page on web server 112. The web page can include HTML tags and attributes to display text and images for a personal computer display.” Ex.2047, [0039]; Fig.8A (showing that content can be placed in specific pre-determined positions on a webpage).

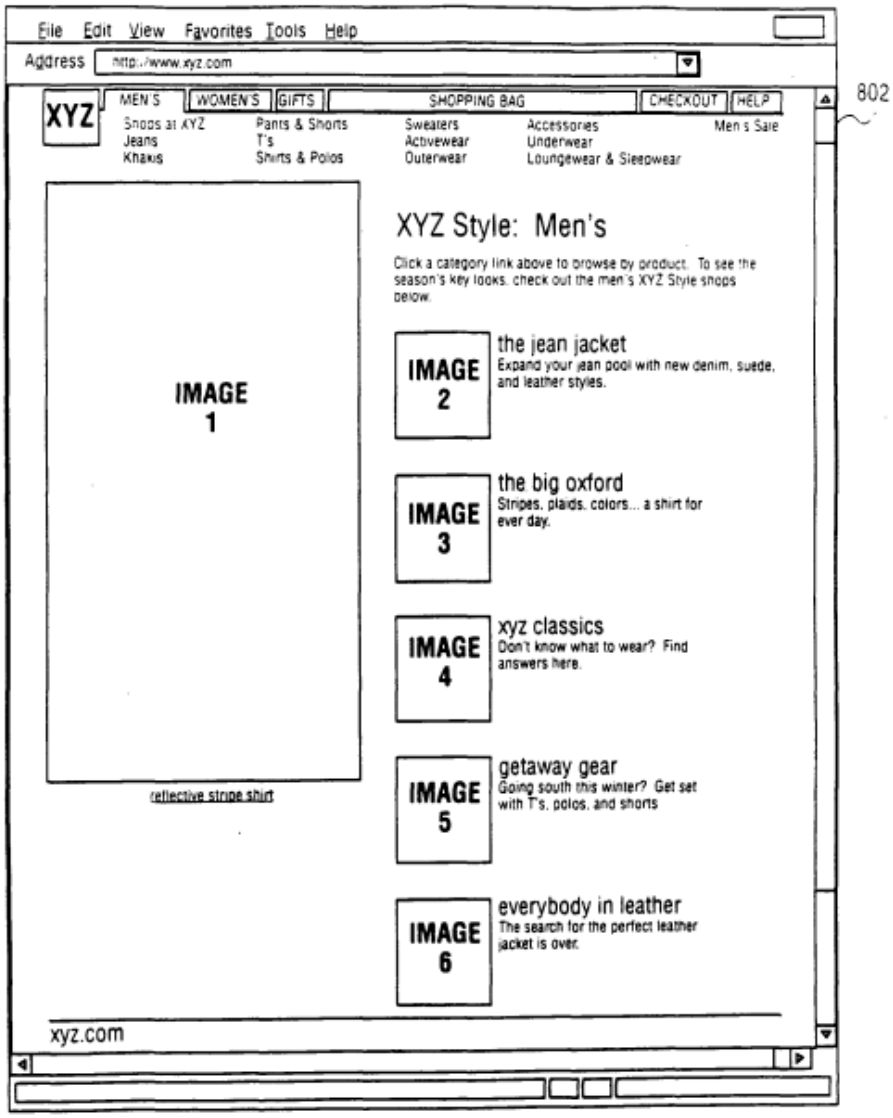

FIG. 8A

Accordingly, McElfresh is cumulative of Sahota considered during the prosecution history, and Petitioners have not argued that Examiner erred materially in not applying Sahota.

4. Harvey

Petitioners' use of Harvey in Grounds 4-6 of the '541-IPR only highlights their abuse of the IPR process. Petitioners admit that ***the only*** reason Grounds 4-6 based on Harvey are asserted in the '541-IPR is to "account for a potential construction of 'web-based shared information channel' proposed by Meta in the ***MDT-Meta-Litigation***." Petition, 8. There is no reason for Petitioners to burden the Board with Grounds 4-6 based on Harvey in the '541-IPR when neither Petitioners nor PO have ever adopted the construction proposed by Meta in the MDT-Meta-Litigation for "web-based shared information channel." Meta introduced Grounds 4-6 in the Meta-MDT-IPRs only because its own litigation claim construction required it. Petitioners' assertion of these grounds confirms their mimicry of the Meta-MDT-IPRs.[6] Accordingly, the Board should not consider Grounds 4-6 based on Harvey.

As established above, the Board should exercise its discretion to deny the '541

[6] And by doing so Petitioners tie their interest to Meta's under the *General Plastic* framework as established above.

Petition based on *Advanced Bionics*.

IV. The Board Should Exercise Discretionary Denial Under the *Fintiv* Framework

The Board should deny institution under §314(a) in view of its precedential decisions in *NHK Spring* and *Fintiv*. In *NHK Spring*, the Board denied institution primarily because the district court would resolve all issues before the Board. *NHK Spring Co., 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 a 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 that "[t]hese factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding." *Id.*, 6.

In evaluating the *Fintiv* factors, the Board must "take[] a ***holistic view*** of whether efficiency and integrity of the system are best served by denying or instituting review." *Id.*

Importantly, no individual factor is dispositive. *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) (vacating the decision granting institution and denying institution because "the Board did not give enough weight to the investment in the parallel proceeding and gave too much weight to Petitioner's *Sotera* stipulation").

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

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

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

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

As a threshold matter, the '348 Patent is not subject to an instituted IPR proceeding, and the Eastern District of Texas does not grant stay when the Board has not issued the decision on institution:

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

CyWee Grp. Ltd. v. Samsung Elecs. Co., 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 Eastern District of Texas shows that when the PTAB has not yet acted on a petition for inter partes review, the courts have uniformly denied motions for a stay."); *see also Samsung Elecs. Co. Ltd. v. Evolved Wireless LLC*, IPR2021-00950, Paper 10, 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. Ltd. 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 '541-IPR—the Eastern District of Texas would deny Petitioners' motion to stay based on Petitioners' delay. Petitioners had every opportunity to file a motion to stay the EDTX-Litigation between institution and withdrawal of the Meta-MDT-IPRs, namely between June 2024 and March 2025. In fact, Petitioners have been contemplating a motion to stay for over seven months, since the early stages of the EDTX-Litigation (*See* Exs.2008, 2013, and 2014), but still have not filed 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 IPR Petitions, Petitioners once again inquired about PO's "position on a stay pending IPR." *See* Ex.2014. And on March 4, 2025, Petitioners shared a draft motion to stay with PO. Ex.2015. To date, Petitioners have not filed a motion to stay. Eastern District of Texas precedent has denied 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 Eastern District of Texas 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). 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 Eastern District of Texas's precedent, Petitioners' delay in filing their Petitions weighs against granting a motion to stay even if filed today.

Finally, the Eastern District of Texas has another independent reason to deny a motion to stay—any FWD would not be due until after the trial concludes. The EDTX-Litigation has been underway for almost a year now, and jury selection is less than a year away, on April 20, 2026. *See* Ex.2016. This is "a deadline that cannot be changed without an acceptable showing of good cause. Good cause is not shown merely by indicating that the parties agree that the deadline should be changed." *Id.*,

5. An institution decision on the '541-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. A FWD would not be due until October 2026, six months after trial is scheduled to begin. For this independent reason, the Eastern District of Texas is likely to deny stay. *See, e.g.*, *MyPort, Inc. v. Samsung Electronics Co.*, 2:22-cv-00114-JRG, Dkt. 73 (E.D.Tex. June 12, 2023), 4 (denying stay where the PTAB decision is not due until over two months after jury trial is set to begin).

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

B. Factor 2: The EDTX-Litigation's Trial Date is 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 '541-IPR issues, the EDTX-Litigation will 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 FWD, the Board generally has weighed this fact in favor of exercising discretion to deny institution." *T-Mobile USA, Inc. v. Wireless Alliance*, IPR2024-00608, Paper 16 (P.T.A.B. Sept. 3, 2024) (exercising discretion to deny institution of inter partes review).

The '541-IPR was filed nearly eight months after initiation of the EDTX-

Litigation, and a decision whether to institute the '541-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. As established above, the jury selection is "a deadline that cannot be changed without an acceptable showing of good cause. Good cause is not shown merely by indicating that the parties agree that the deadline should be changed." *Id.*, 5. Furthermore, while the case schedule has been amended, the parties have never attempted to extend any of the critical interim deadlines, such as claim construction, fact discovery, expert discovery, pre-trial conference, and jury selection.

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 any evidence that the parties make of record that bears on the proximity of the district court's trial date or the ITC's final determination target date, ***including median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides***."). The most recent statistics on "United States District Courts – National Judicial Caseload Profile," published by

www.uscourts.gov,[7] show that for a 12-month period ending September 30, 2024, a median time-to-trial in the Eastern District of Texas for civil cases is 21.9 months. Ex.2017, 35. Accordingly, the projected trial date in the EDTX-Litigation for purposes of *Fintiv* in accordance with the March 24, 2025 Memo would be around March 29, 2026—even earlier than the scheduled trial date and nearly seven months before the expected timing of a FWD if this proceeding is instituted.

The Board has consistently found this factor favors discretionary denial where the underlying litigation is in the Eastern District of Texas 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 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.

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

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 an important discovery dispute concerning the scope of the Protective Order in the EDTX-Litigation. Ex.2038. 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.2039. Additionally, the parties have completed and exchanged infringement and invalidity contentions.[8] By the projected

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

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.*, *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. Despite admitting that the '541-IPR rests on "common references and arguments" from the Meta-MDT-IPRs (Ranking, 5), Petitioners waited for nearly eight months to file the '541 Petition. Petitioners cannot justify this delay. In fact, Petitioners cannot even explain why they did not file a joinder motion to join the Meta-MDT-IPRs, which rested on the same arguments Petitioners now re-assert. *See supra* note 4.

Even if this is overlooked, Petitioners cannot explain why they failed to promptly file their Petition upon receiving PO's infringement contentions in the EDTX-Litigation. PO served its infringement contentions on September 4, 2024—

nearly five months prior to filing the '541-IPR. Ex.2026. The five-month gap between service of infringement contentions and filing of the '541 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 about the discretionary denial process[9] 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

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

discretionary denial brief." April 25, 2025 FAQs, Q.14. As to the substance, "the stipulation [must] ***materially reduce***[] overlap between the proceedings," noting that "[w]here the petitioner is ***relying on corresponding system art*** in a co-pending proceeding and/or several other invalidity theories, ***a stipulation may not be particularly meaningful***." *Id.* Petitioners' *Sotera*-style stipulation fails to meet either criterion.

Procedurally, Petitioners' *Sotera*-style stipulation is untimely. Petitioners could have filed their *Sotera*-style stipulation sooner, even at the time of filing the '541-IPR, but waited for over 3 months to seek leave to file it.[10] Ex.2006. And

[10] 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 its proposed communication to the Board on April 30, 2025. Ex.2029. Petitioners sent its request for leave to file its *Sotera*-style stipulation to the Board on May 2, 2025. Ex.2006. As of the date of the filing of this Discretionary Denial brief, Petitioners have not filed their *Sotera*-style stipulation. Accordingly, PO

despite PO promptly responding to Petitioners' inquiry (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.[11]

Turning to the substance of Petitioners' *Sotera*-style stipulation, Petitioners' proposed draft does not reduce overlap between the proceedings. Petitioners' draft stipulation provides that if the Board "institutes an *inter partes* review ("IPR") in

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cannot address the "impact" of a stipulation that is not yet filed. As such, PO presents its arguments on the sufficiency of Petitioners' April 21, 2025 proposed stipulation, assuming that Petitioners will not modify their proposed drafts in this IPR or any of the other IPRs based on PO's arguments in this brief.

[11] 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 is prejudiced because it must address the impact of a stipulation not yet filed. Second, April 21, 2025—over three months from filing the Petitions—is not "as soon as practicable."

either or both of IPR2025-00541 and IPR2025-00542 concerning U.S. Patent 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.[12] However, in view of Petitioners' invalidity contentions, this stipulation is insufficient.

In the EDTX-Litigation, Petitioners asserted the "Yahoo! System" as a prior art system to the '348 Patent. Ex.2027, 20-21, 45-46. Yet, in their Yahoo! System invalidity claim chart, Petitioners expressly state the Yahoo! System is described in Neibauer, which Petitioners contend "independently qualif[ies] as 35 U.S.C. §§102(a) and 102(b) prior art." Ex.2033, 1.

[12] 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. This Exhibit does not fulfill that duty, and no stipulation is considered filed because PO files this Exhibit. If the Board permits Petitioners to file a stipulation, it must be the April 21, 2025 stipulation—no revisions, no substitutions. *See* Ex.2006, 2 (requesting "to document the *Sotera* stipulations served on Patent Owner Mobile Data Technologies LLC ***on April 18 and April 21, 2025***").

Mobile Data Technologies, LLC v. Samsung Electronics Co. Ltd., and Samsung Electronics America, Inc.
No. 2:24-cv-00435-JRG-RSP (E.D. Tex.)
Defendant's Invalidity Contentions – Exhibit E15

Claim Chart Against U.S. Patent No. 9,922,348 ("the '348 patent")

Charted Reference: The Yahoo! System ("Yahoo")

The Yahoo system was available prior to June 18, 2001 and June 18, 2002, and qualifies as prior art under at least 35 U.S. §§ 102 and/or 103 as to the asserted claims of U.S. Patent 9,922,348 ("the '348 Patent"), as discussed in greater detail in the chart that follows.[1] Yahoo is described in the following publications which each independently qualify as 35 U.S.C. §§ 102(a) and 102(b) prior art to the '348 patent:

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

Id. Thus, Petitioners assert an invalidity defense exclusively based on the same evidence presented in this Petition, i.e., Neibauer, for every claim limitation. *See id.* Thus, despite Petitioner's statutory inability to raise the Yahoo! System in this IPR, a substantial overlap of issues remains even with Petitioners' *Sotera*-style or any other narrower stipulations. Where, as here, "the petitioner is ***relying on corresponding system art*** in a co-pending proceeding and/or several other invalidity theories, ***a stipulation may not be particularly meaningful***." April 25, 2025 FAQs, Q.14.

Because Petitioners intend to swap labels in the EDTX-Litigation for what is otherwise the Neibauer Grounds asserted in the '541-IPR to cloak the Neibauer Grounds as a prior art system ground, *Fintiv* Factor 4 weighs strongly in favor of denying institution. *See, e.g.*, *SAP America*, IPR2024-01496, Paper 13, 8-9 (holding on similar facts that "we do not consider the presence of the *Sotera* stipulation in our case to ensure that inter partes review would be a 'true alternative' to the Litigation").

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

As noted, the Board's determination as to effectiveness of a *Sotera* stipulation hinges on "whether the stipulation ***materially reduces overlap*** between the proceedings." April 25, 2025 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 whether the grounds of unpatentability are of the same nature (i.e., based exclusively on patents and printed 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 '541 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 Yahoo! System and in view of Neibauer, Cheng, Squibbs, Ausems, McElfresh, or Harvey. Per *Ingenico*'s holding, IPR estoppel does not apply to such a ground as it could not be raised in the IPR because the Yahoo System is system art.

First, as shown above, Petitioners' invalidity contentions treat the Yahoo! System as being equivalent of Neibauer. In fact, in their Yahoo! System invalidity claim chart, Petitioners rely exclusively on Neibauer's disclosures for every limitation. Second, Petitioners have expressly reserved the right combine the Yahoo! System with any one of Neibauer, Cheng, Squibbs, Ausems, or Harvey in the EDTX-Litigation.

> ***[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 Yahoo and/or combine the teachings of Yahoo with other prior art references, including but not limited to the prior art references presently found in Samsung's Invalidity Contentions*** and any supplements thereto and the relevant section of charts for other prior art for the '348 Patent … ***It would have been obvious to modify the methods and/or systems disclosed in Yahoo, alone or in combination with the references identified in Sections III.A-B and IV.B-C of Samsung's Invalidity Contentions***.

Ex.2033, 1. The references relied upon in this IPR—Neibauer, Cheng, Squibbs, Ausems, and Harvey—are among the "the prior art references presently found in

Samsung's Invalidity Contentions." *See* Ex.2027, 8-20. Indeed, Petitioners' invalidity contentions have numerous references to Cheng and Squibbs. *See, e.g.*, *id*., 66-67; 80-82; 101. 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 '541-IPR with a prior art system.

Worse yet, Petitioners' *Sotera*-style stipulation would not preclude them from recycling Neibauer, Cheng, Squibbs, Miller, and Harvey 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.*** In addition, Defendants may rely on other documents or things that have not yet been located to support its contentions regarding such prior art device(s) or product(s) that are referenced in the charts.

Ex.2027, 48.

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. April 25, 2025 FAQs, Q.14. The Board should exercise its discretion to deny institution in this case.

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).

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

Fintiv factor 6 holistically weighs in favor of 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.[13] First, these claims are entitled to the statutory presumption of validity. 35 U.S.C. §282.

[13] 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).

Second, the challenged claims were in force since 2018 until they expired recently. Accordingly, this factor weighs in favor of a discretionary denial.

2. Petitioners' abuse of the IPR process

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—such as an unusually large number of asserted claims in litigation or a contested priority date requiring multiple prior art references. *Id.,* 59. None of those circumstances is present here, and Petitioners do not contend otherwise.[14]

Petitioners attempt to 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." Ranking, 3.

[14] In Petitioners' Notice of Ranking, they cited only "alternative claim constructions" to support filing parallel petitions. Ranking, 2-4. Petitioners cannot add any other justifications for filing parallel petitions now. *See* CTPG, 59-60.

Yet, they admit that PO's constructions for "mobile device"[15] in the Meta-MDT-IPRs are "narrow[er] constructions" compared to those advanced in the MDT-Meta-Litigation—not "alternative constructions." *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.* But Petitioners adopt the MDT-Meta-Litigation constructions in ***both*** '541 and '542 IPRs, and thus Petitioners' alleged justification fails. *See BabyBjorn, AB v. The Ergo Baby Carrier, Inc.*, IPR2025-00111, Paper 19, 11-13 n.11 (P.T.A.B. Apr. 22, 2025) (holding a second-ranked petition is unnecessary when petitioner addresses the same construction in both petitions); *see also Medacta USA, Inc. v. RSB Spine, LLC*, IPR2020-00275, Paper 22, 10-11 (P.T.A.B. May 22, 2020). Furthermore, Petitioners could have sought claim constructions within one petition instead of filing two petitions. *Microsoft Corp. v. D3D Techs.*, IPR2021-00877, Paper 14, 9 (P.T.A.B.

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

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 relying on identical constructions throughout both petitions. ***Because Petitioners apply identical claim constructions in both the Neibauer Grounds and the Original Grounds, their claim of "different" constructions merely masks an effort to dodge the 14,000-word limit and pack extra unpatentability grounds into multiple petitions***. Because PO's proposed construction are not truly alternatives as Petitioners characterize, and because Petitioners' first-ranked and second-ranked Petitions substantially overlap, Petitioners abused the IPR process by filing two petitions.

Additionally, to the extent that Petitioners' citation to the Notice of Rulemaking factor implies that the 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.1025, 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."[16] Ex.1030, 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 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 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 Pharma.*

[16] PO explained its bases for this construction thoroughly in its Meta-MDT-IPRs Response. Ex.1030, 9-15. That said, the Board need not construe any term for Discretionary Denial purposes.

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 and highlights Petitioners' abuse of the IPR process.

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. It has not been adopted by the Director and therefore is not binding. Even if it had been adopted, Petitioners ignore eight of the Notice's nine enumerated factors, including whether "there is a dispute about the priority date," whether Petitioners "lacked information … at the time they filed the petitions," or whether "[t]he complexity of the technology" demands separate petitions. Ex.2004, 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 holistic view approach in *Advanced Bionics* context); *Masimo Corp. v. Apple Inc.*, IPR2024-00071, Paper 7 (P.T.A.B. Apr. 25, 2024) (adopting same in *General Plastic* context).

Moreover, Petitioners do not explain why they bypassed the obvious route—filing a joinder motion by July 11, 2024, under 37 C.F.R. §122(b)—to join the Meta-MDT-IPRs, which rested on the same Neibauer Grounds Petitioners now re-assert with "common references and arguments." Ranking, 5. Petitioners had notice and opportunity to do so any time between June 17, 2024, when served with the Complaint in the EDTX-Litigation, and July 11, 2024, but Petitioners waited nearly eight months to file the current Petition, re-raising "common references and arguments" as those in the Meta-MDT-IPRs. Ranking, 5. 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' apparent excuse for not filing a joinder fails. *See supra* note 4.

Finally, Petitioners contend that the "burden on the Board and PO in instituting" the '541-IPR is "minimal" because it relies on "common references and argument." Ranking, 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 present Petition (*see* Ex.2011)—but it is anything but minimal for everyone

else. PO must craft a full response[17] 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. That inefficiency is heightened here, because as of May 4, 2025—over three months after filing the '541-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.

Additionally, as discussed above, Petitioners have no good-faith reason to burden the Board with Grounds 4-6 based on Harvey in the '541-IPR when neither Petitioners nor PO have adopted the construction proposed by Meta in the MDT-Meta-Litigation for "mobile information channel." *See supra* §III.A.4. Petitioners'

[17] As evidenced from PO's merits and *Advanced Bionics* in this 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.

abuse of the IPR process should not be rewarded.

3. Petitioners' inconsistent rankings of the Petitions

Petitioners rank their twin Petitions inconsistently. Petitioners rank the Petition asserting the Neibauer Grounds (i.e., the '541-IPR) higher than the Petition asserting the Original Grounds (i.e., the '542-IPR) for their Petitions against all Asserted Patents except the '039 Patent. Ranking, 2.

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

4. Petitioners' excessive reliance on expert testimony

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

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

Petitioners' expert testimony is not "focused … to provid[ing] helpful context." Petitioners' 134-page-long expert declaration for their 70-page Petition is not "focused expert testimony." Nor does it provide any helpful context. In fact, contrary to the Board's direction that "it is not necessary for an expert to explain every aspect of the prior art" (April 25, 2025 FAQs, Q.21), Petitioners' expert testimony engages in a limitation-by-limitation obviousness analysis of the claims, and fills shortcomings in the prior art using only conclusory statements. PO presents examples here.

As a threshold matter, the expert takes inconsistent positions across Petitioners' multiple IPRs. In the '535-IPR, Petitioners' expert stated that "[t]he club

photo sharing feature is an 'application-based information channel'" because the club is an application. Ex.2040, ¶¶144; 139. In this IPR, the expert argued that the very same feature is a "web-based shared information channel." Ex.1002, ¶¶75, 123. Here, the expert based his conclusion on the notion that the club is a webpage accessible from a website. *Id.,* ¶104. In the '537-IPR, the expert used the club photo-sharing feature to map the claimed "mobile information channel." Ex.2043, ¶¶109, 130, 134. 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, Petitioners' expert testimony does not provide any explanation as to why.

For limitation 1[F], Petitioners' expert testimony maps the claimed "personalized content application" to a web browser. Ex.1002, ¶128. For support, the expert resorts to extrinsic evidence, i.e., the definition of "application" in the Microsoft Computer Dictionary: "A program designed to assist in the performance of a specific task, such as word processing, accounting, or inventory management." Ex.1002, ¶128. Under the expert's reasoning, because web browsers can be used to "post personalized content using the club photo album," they are the claimed "personalized content application." Ex.1002, ¶129. But under that same logic, a web browser is also a tax-filing application because "each [] member would have used

the web browsers on their mobile device to [file taxes] using the [TurboTax] feature." *Id.*

More importantly, to equate web browsers with the claimed "personalized content applications," the expert simply ignores the specification, which teaches away from conventional methods, including web browsers. The specification provides that "conventional techniques" such as web browsers, which were known in 2002, have been "unable to meet" the needs of users who wish to make "***specific personalized information content available*** via mobile devices to their friends, colleagues, subscribers or other entities." Ex.1001, 1:50-54; *see also id.*, 1:54-58 ("By way of example, conventional techniques such as web site authoring tools and web logging ('blogging') are not optimized for use in the generation of information content for shared access via mobile devices."). The expert testimony provides no helpful context sufficient to show that web browsers are the claimed "personalized content applications."

b) Petitioner's reliance on expert testimony is "extensive"

In addition to violating the requirement that expert testimony be focused to providing "helpful context," Petitioners violate the requirement that their reliance on expert testimony not be "extensive." The overwhelming majority of the content of the Petition appears verbatim in Petitioners' expert testimony. Ex.2035 (providing numerous examples of copy-pasting from Ex.1002 into the Petition).

Furthermore, Petitioners impermissibly incorporate by reference the testimony. For example, for limitations 1[A] and 1[B], Petitioners argue that a "POSITA would also have been motivated to make the club features available to mobile devices to take advantage of growing popularity of such devices." Petition, 19. For support, Petitioners cite four paragraphs of expert testimony with no analysis. *Id.* Petitioners incorporate arguments by reference and therefore violate 37 C.F.R. §42.6(a)(3). *Cisco Systems, Inc. v. C-Cation Techs.*, IPR2014-00454, Paper 12 at 9 (P.T.A.B. Aug. 29, 2014) (informative) (providing that "practice of citing the Declaration to support conclusory statements that are not otherwise supported in the Petition also amounts to incorporation by reference").

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

5. The '541 Petition lacks merit

"A full merits analysis is not necessary as part of deciding whether to exercise discretion not to institute, but rather the parties may point out, as part of the factor-based analysis, particular 'strengths or weaknesses' to aid the Board in deciding whether the merits tip the balance." *Fintiv*, Paper 15, 15. But 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) ("In sum, ***we determine that the strength of the merits is obviated by the efficiency and timeliness of the parallel district court proceeding and, therefore, determine that considerations of the sixth Fintiv factor are neutral***."). Accordingly, the Board need not assess the merits, given that the strength of other factors and considerations suffice for *Fintiv* purposes. If, however, the Board assesses the merits in its holistic approach to *Fintiv*, the '541 Petition is weak.

Finally, while PO addresses the merits of all six Grounds asserted by Petitioners, a showing that Petitioners have failed to meet their burden as to one Ground suffices to discretionarily deny institution. *See Samsung Electronics Co Ltd et al. v. Kp Innovations 2 LLC*, IPR2025-00101, Paper 13, 27-28 (P.T.A.B May 12, 2025). If the Board institutes review based on a determination that Petitioners have shown a reasonable likelihood of prevailing ***on only one ground***, under *SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 373 (2018), the Board still must consider the other ground. *See BioDelivery*, 898 F.3d at 1209 ("We agree that *SAS* requires institution on all challenged claims and all challenged grounds."). But 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). As

established below, Petitioner has not met its burden on either of the Grounds. Even if the Board determines Petitioner has met its burden on one of the Grounds, however, the Board should still exercise discretion to deny institution of all Grounds under *SAS*. *See Samsung Electronics Co Ltd et al.*, IPR2025-00101, Paper 13, 27-28.

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

As a threshold matter, parroting their expert's conclusory statements, Petitioners also take inconsistent positions: the club photo-sharing feature is the application-based information channel in the '535 Petition, the web-based shared information channel in this Petition, and the mobile information channel in the '537 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*, IPR2023-1004, 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).

The Petition also fails to establish the claimed "personalized content applications." Petition, 20-30. Petitioners assert that the "web browsers on the mobile devices" of Neibauer comprise "personalized content applications." Petition,

29. Any disclosure in Neibauer of web browsers on the mobile devices, however, does not read on ***personalized content applications***, as defined in the '348 Patent.

The '348 Patent discloses that the "system provides a platform ***for the development of*** a wide variety of ***personalized content applications*** for users of mobile devices, thereby allowing wireless network service providers not only to increase their subscriber base, but also to reduce turnover in their subscriber base." Ex.1001, 18:59-63. Based on the express language in the specification, the personalized content applications must be "developed" and thus must be something more than a web browser, which already existed in 2002, the priority date of the '348 Patent. Furthermore, for the "personalized content application" to "increase subscriber base" and "reduce turnover in their subscriber base," as provided in the specification, the "personalized content application" must be something more than just a web browser. Finally, the specification provides that "conventional techniques" such as web browsers, which were known in 2002, have been "unable to meet" the needs of users who wish to make "***specific personalized information content available*** via mobile devices to their friends, colleagues, subscribers or other entities." *Id.*, 1:50-54; *see also id.*, 1:54-58 ("By way of example, conventional techniques such as web site authoring tools and web logging ('blogging') are not optimized for use in the generation of information content for shared access via mobile devices."). As a result, Petitioners' argument that the "web browsers on the

mobile devices also comprise 'personalized content applications'" is contrary to the specification of the '348 Patent and thus fails.

Petitioners rely on Neibauer's club photo sharing feature accessed through a web browser to be the "personalized content application" required in limitation 1[F]/13[C]/17[C]. *See* Petition, 27-30.[18] First, to support their conclusion that this club photo sharing feature accessed through a web browser is an "application," Petitioners point to their expert and an extrinsic source, the Microsoft Computer Dictionary. Petition, 29. Petitioners' expert, however, merely parrots the language from the Petition without providing any detailed analysis as demonstrated above. And the extrinsic evidence of the Microsoft Computer Dictionary should not be considered where, as here, it is clear from the specification that "personalized content application" is something different from "web browsers." *CR Bard, Inc. v. US Surgical Corp.*, 388 F. 3d 858, 862 (Fed. Cir. 2004) ("[E]xtrinsic evidence cannot alter any claim meaning discernible from intrinsic evidence"). Expert testimony that is "conclusory, unsupported and unspecific" cannot substitute for proof in the prior art. *Icon Health & Fitness v. Strava*, 849 F.3d 1034, 1043 (Fed. Cir. 2017); *TQ*

[18] Petitioners' analysis of claim 17 is inadequate; it does contain any showing regarding claim 17 except the preamble. Petition, 44. There is no analysis of limitations 17[A]-17[C]. *Id.*

Delta v. Cisco, 942 F.3d 1352, 1364 (Fed. Cir. 2019). Petitioners must map each claim element "with particularity" under 37 C.F.R. §42.104(b)(4); generic references to device capability do not satisfy that rule.

Second, Petitioners fail to establish that Neibauer's club photo sharing feature is a "personalized content application." Petitioners assert that each "club member would have used the web browsers on their mobile device to post personalized content using the club photo album feature." Petition, 30. Even assuming that a web browser could be properly interpreted as a personalized content application despite the language in the '348 Patent specification (it cannot), that users can post content on the club photo album feature does not make the club photo album feature "personalized." Instead, the "personalized content application" requires that the ***actual application*** be personalized, not the content within the application. *See, e.g.*, Ex.1001, 18:59-63 ("[T]he system provides a platform ***for the development of*** a wide variety of ***personalized content applications*** for users of mobile devices, thereby allowing wireless network service providers not only to increase their subscriber base, but also to reduce turnover in their subscriber base.").

Recognizing this deficiency, Petitioners point to a "separate theory": "Neibauer discloses the ability of a user to customize their own Yahoo! Home page using Yahoo! Companion, a toolbar added to the web browser window." Petition, 32. Petitioners' argument, however, fails because as discussed in more detail below,

there is no motivation to combine Yahoo! Companion in chapter 3 with Yahoo! Clubs in chapter 21 with Yahoo! Mobile in chapter 7. Thus, Petitioners fail to demonstrate that Neibauer discloses "personalized content applications," as required by limitations 1[F] /13[C]/17[C], and does not rely on any reference other than Neibauer for this limitation.

(1) Petitioners offer no evidence of Motivation to Combine Neibauer's different chapters

Petitioners' Ground 1 combines three different chapters of Neibauer—Yahoo! Clubs (chapter 21), Yahoo! Companion (chapter 3), and Yahoo! Mobile (chapter 7)—with Cheng and Ausems. *Cf.* Pet. 19 (referencing Yahoo! To Go, Yahoo Clubs, and Cheng); Pet. 32 (referencing Yahoo! Companion). This is a 5-reference combination, as Petitioners must show a motivation to combine the three chapters of Neibauer even though they are in the same reference. "When an obviousness argument relies on 'combining multiple embodiments ***from a single reference***, … ***there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful***, otherwise a skilled artisan would not arrive at the claimed combination.'" *Reactive Surfaces Ltd. v. Toyota Motor Corp.*, IPR2019-00867, Paper 6, 8 (P.T.A.B. Sep.18, 2019) (quoting *In re Stepan Co.*, 868 F.3d 1342, 1345-46 n.1 (Fed. Cir. 2017)); *see also Intel Corporation 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]."); *Apple Inc. v. Arigna Technology*, IPR2022-01037, Paper 9, 20 (P.T.A.B. Dec. 2, 2022); *Samsung SDI Co. v. Ube Industries, Inc.*, IPR2017-02116, Paper 8, 21 (P.T.A.B. Mar. 12, 2018); *Abiomed, Inc. v. Maquet Cardiovascular, LLC*, IPR2017-01204, -01205, Paper 8, 8-12 (P.T.A.B. Oct. 23, 2017). Petitioners have not even attempted to make this showing.

Neibauer is completely silent as to the availability of the Yahoo! Clubs feature on a user's mobile device or how one would implement the Yahoo! Clubs feature for mobile device usage in Yahoo! Mobile. Rather, Neibauer specifically describes that Yahoo! Mobile services are limited to basic Yahoo! services, such as checking e-mail and calendar and receiving preferred mobile alerts (i.e., stock quotes, weather alerts, horoscope alerts, etc.). Neibauer, 166. The functionality of Yahoo! Mobile depends on the mobile device used. For example, to check email and calendar, a user needs a PDA that uses Palm OS Windows CE, a modem, and a Web browser; to receive alerts about events, a user needs a pager or mobile phone with text-messaging capability, an e-mail address, and a Yahoo! ID. *Id.* There is no discussion in Yahoo! Mobile about Yahoo! Clubs. Even on a PDA, the information available through Yahoo! Mobile is limited to basic information, including address book,

calendar, lodging, mail, movie showtimes, people search, ski reports, sports, stock quotes, and weather. Neibauer, 174. Indeed, Petitioners acknowledge that Neibauer does not "expressly disclose that the Yahoo! clubs feature was available on handhelds" (Pet. 13), but they assert, without support, that "it would have been obvious over Neibauer alone to allow user-created clubs to be accessed by handheld devices disclosed elsewhere in Neibauer." *Id.* Their expert parrots this conclusory statement (Ex.1002, ¶79), which ignores the express disclosure in Neibauer acknowledging that Yahoo! Mobile is restricted to basic features such as alerts. Indeed, that Neibauer does not mention Yahoo! Clubs as functionality available via Yahoo! Mobile undermines Petitioners' argument that it "would have been viewed as a logical (and obvious) extension of the existing mobile features and capabilities described in Neibauer." Petition, 13; Ex.1002, ¶79.

Petitioners have thus failed to establish there is a motivation to combine Yahoo! Mobile in chapter 7 with Yahoo! Clubs in chapter 21.

Additionally, there is no motivation to combine Yahoo! Companion from chapter 3 with Yahoo! Mobile. While Yahoo! Companion allows the user to customize their own Yahoo! Home page using a toolbar added to the web browser window, there is no suggestion to combine Yahoo! Companion with Yahoo! Mobile. Indeed, Neibauer states that "you have to download the Companion on each computer on which you want to use it." Neibauer, 56. Neibauer describes the steps

the user must take to download Yahoo! Companion on the user's computer, all of which are directed to a computer. Neibauer, 56-59. While Yahoo! Mobile includes a discussion of software that may be downloaded to a user's PDA (Neibauer, 175-76), these downloads do not include Yahoo! Companion but are instead third-party stand-alone modules such as an "auto lease calculator." Neibauer, 176. Indeed, the only two pieces of Yahoo! software available for download are Messenger for Palm OS and Messenger for WinCE. *Id.*, 177.

Thus, there is no motivation to combine Yahoo! Mobile with Yahoo! Companion and Petitioners have failed to provide any argument or evidence to the contrary.

b) Grounds 4-6 based on Harvey does not cure the deficiencies in Grounds 1-3

As discussed above, the Board should not consider Grounds 4-6 due to Petitioners' abuse of the IPR process. *See supra* §IV.F.2 and §III.A.4. However, if the Board considers this ground, it too is weak. As a threshold matter, however, ***PO highlights yet another aspect of Petitioners' abuse of the IPR process***. Petitioners' Grounds 4-6 address limitations that are not in the claims of the '348 Patent, the "content management site" and "user-authored content." Petition, 64.

Even overlooking this, Petitioners burden the Board with their verbatim copy-pasting from Meta's IPR positions regarding Harvey only for its disclosure of "the

ability to add content to a community before the community is created." Petition, 64-65.

Harvey does not teach that content can be added to a community before it is "created" as Petitioners claim. Harvey describes the use of a community creating module, capable of permitting a creator to create a community and designate applications and content to be presented in the community. Petitioners suggest that the community that Harvey describes is the web-based shared information channel. Petition, 64-65. The capabilities of this community, however, are permitted ***during*** the creation of the community, and ***do NOT occur before*** the creation of the community, as the Petition asserts. Thus, Harvey does not teach "the ability to add content to a community ***before*** the community is created." Petition, 68. Petitioners cite Harvey's discussion about creation of the community and designation of content for the community that clearly states the designation of content occurs ***during*** the creation of the community: "Harvey explains that '[t]he community creating module permits the creator ***to create a community, and designate*** applications and content presented in the community by a user interface.'" Petition, 64-65 (citing Harvey, 4:28-30). Yet, Petitioners distort this by saying that "Harvey therefore discloses the ability to add content to a community ***before*** the community is created." Petition, 64-65.

Furthermore, Petitioners and their expert appear to be lumping the terms "created" and "launched" as if they are a single action. In particular, the Petition asserts Harvey provides Neibauer's club with the ability "to allow the club founder to add content to one or more mobile information channels, before the club is created and launched." Petition, 65. However, Petitioners' conclusion blurs the line between "launch" and "create." The addition of content to a given community occurs ***during*** the creation of the community, ***not before*** the creation of the community. Accordingly, while a community creator may add content to a community before it is launched, the community creator cannot add content to a community before the community itself is created.

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 '541-IPR on *Fintiv* grounds.

V. CONCLUSION

Appropriate analysis based on the evidence of record favors exercising discretion to deny institution of the '541-IPR.

Date: June 6, 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.

Date: June 6, 2025

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CERTIFICATE OF SERVICE

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