

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

IPR2025-00543
U.S. Patent No. 9,619,578

**PETITIONERS' SUR-REPLY REGARDING
DISCRETIONARY DENIAL**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF AUTHORITIES

<i>Intel Corp. v. Proxense LLC</i> , IPR2025-00327, -328, -329	2
<i>Tesla, Inc. v. Intell. Ventures II LLC</i> , IPR2025-00217, -219-222, -339	1

EXHIBIT LIST

Exhibit	Reference
1001	U.S. Patent 9,619,578 to Harper (“the ’578 patent”)
1002	Declaration of Henry Houh, Ph.D. in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent 9,619,578
1003	Excerpts from Alan Neibauer, <i>How to Do Everything With Yahoo!</i> (2000) (“Neibauer”)
1004	<i>RESERVED</i>
1005	U.S. Patent No. 7,574,486 B1 to Yin Cheng et al. (“Cheng”)
1006	U.S. Patent No. 6,434,403 B1 to Michiel R. Ausems et al. (“Ausems”)
1007-1009	<i>RESERVED</i>
1010	U.S. Patent No. 6,487,583 B1 to Jamey Harvey et al. (“Harvey”)
1011	U.S. Patent Application Publication No. 2001/0015759 A1 to Robert Francis Squibbs (“Squibbs”)
1012	Excerpts from Uwe Hansmann et al., <i>Pervasive Computing Handbook</i> (2001) (“Hansmann”)
1013-1020	<i>RESERVED</i>
1021	Excerpts from <i>Microsoft Computer Dictionary</i> (5th ed 2002)
1022	File history of U.S. Patent No. 9,619,578 B2
1023	<i>RESERVED</i>
1024	Excerpts of file history of Inter Partes Reexamination of U.S. Patent No. 8,135,801 B2
1025	Joint Claim Construction Statement, Dkt. 51, Mobile Data Technologies LLC v. Meta Platforms, Inc., Case No. 7:22-cv-00244- ADA-DTG (W.D. Tex. filed September 13, 2023)

Exhibit	Reference
1026	Declaration of Sylvia D. Hall-Ellis, Ph.D. (“Hall-Ellis”) from IPR-2024-00249
1027	RESERVED
1028	U.S. Patent 8,135,801 to Harper et al.
1029	Order Granting <i>Inter Partes</i> Reexamination of U.S. Patent 8,135,801
1030	<i>Meta Platforms, Inc. v Mobile Data Techs. LLC</i> , IPR2024-00249, Paper 26 (PTAB Oct. 2, 2024)
1031	Declaration of June Munford
1032	Excerpt from Webster’s Dictionary of Computer Terms (page 98)
1033	<i>Meta Platforms, Inc. v Mobile Data Techs. LLC</i> , IPR2024-00249, Paper 33 (PTAB Jan. 10, 2025).
1034-1035	RESERVED
1036	<i>Meta Platforms, Inc. v. Mobile Data Techs. LLC</i> , IPR2024-00248, Paper 26 (PTAB Oct. 2, 2024)
1037	RESERVED
1038	H.R. Rep. No. 112-98 (2011)
1039	Delaware Department of State, Division of Corporations, Entity Page for Mobile Data Technologies LLC, https://icis.corp.delaware.gov/ecorp/entitysearch/NameSearch.aspx
1040	First Am. Compl., <i>Mobile Data Techs. LLC v. Samsung Elecs. Am., Inc.</i> , No. 2:24-cv-00435-JRG-RSP, Dkt. No. 25 (E.D. Tex. Oct. 6, 2024)
1041	Patent Assignment Record for US 9,619,578 to Mobile Data Technologies LLC

Exhibit	Reference
1042	Patent Assignment Record for US 9,619,578 conveying Security Interest to Chisum
1043	Order Re Def.'s Mot. to Compel Litig. Funding Docs., <i>Entangled Media, LLC v. Dropbox Inc.</i> , No. 23-cv-03264-PCP (VKD), Dkt. No. 254 (N.D. Cal. Apr. 8, 2025)
1044	Order, <i>Electrolysis Prevention Sols. LLC v. Daimler Truck North Am. LLC</i> , No. 3:21-cv-00171-TEJ-WCM, Dkt. No. 147 (W.D.N.C. July 24, 2023)
1045	Complaint, <i>Mobile Data Technologies LLC v. Meta Platforms, Inc.</i> , Case No.7:22-cv-00244-ADA-DTG, Dkt. No. 1 (W.D. Tex. Nov. 23, 2022)
1046	<i>America Invents Act: Hearing on H.R. 1249 Before the Subcomm. on Intell. Prop., Competition, & the Internet of the H. Comm. on the Judiciary</i> , 112th Cong. (March 30, 2011)
1047	157 Cong. Rec. 13,159 (2011)
1048	Complaint, <i>Mobile Data Techs. LLC v. Samsung Elecs. Am., Inc.</i> , No. 2:24-cv-00435-JRG-RSP, Dkt. No. 1 (E.D. Tex. June 10, 2024)
1049	Unopposed Mot. for Extension of Time to Move, Answer or Otherwise Respond to Pl.'s Compl. & Waiver of Foreign Service Requirement, <i>Mobile Data Techs. LLC v. Samsung Elecs. Am., Inc.</i> , No. 2:24-cv-00435-JRG-RSP, Dkt. No. 5 (E.D. Tex. June 26, 2024)
1050	Docket Navigator, Gilstrap Uncontested Motions to Stay Pending IPR, 2014-present, pulled May 26, 2025
1051	Pl.'s Unopposed Mot. to Stay Proceedings Pending IPR, <i>Mobile Data Technologies LLC v. Meta Platforms, Inc.</i> , Case No.3:24-cv-00896-WHA, Dkt. No. 111 (N.D. Cal. Apr. 18, 2024)

Exhibit	Reference
1052	Pacer, List of Calendar Events Set for Judge Gilstrap for 4/1/2026-4/30/2026, pulled June 4, 2025
1053	United States District Court – Judicial Caseload Profile 2020-March 2025
1054	Jennifer Nall, DLA Piper, <i>How Delayed Notice of Date Accorded Mailings May Affect Inter Partes Review</i> (June 3, 2025), https://www.dlapiper.com/en/insights/publications/intellectual-property-news/2025/how-delayed-notice-of-date-accorded-mailings-may-affect-inter-partes-review
1055	Andrew T. Dufresne et al., Perkins Coie, <i>How Reliable are Trial Dates Relied on by the PTAB in the Fintiv Analysis?</i> , 1600 PTAB & Beyond (Oct. 29, 2021)
1056	Katherine K. Vidal, Under Sec’y of Com. for Intell. Prop. & Dir. of the USPTO, Mem. Re Interim Proc. for Discretionary Denials in AIA Post-Grant Procs. with Parallel Dist. Ct. Litig. (June 21, 2022), <i>rescinded</i> Feb. 28, 2025
1057	Samsung Newsroom, Samsung Members App Puts Galaxy Experts at Your Fingertips (Apr. 8, 2016), https://news.samsung.com/global/samsung-members-app-puts-galaxy-experts-at-your-fingertips
1058	Email from N. Birbach to Counsel for PO re IPR Nos. IPR2025-00535 – IP2025-00544 – Updated Sotera Stipulation
1059	U.S. Patent Application Publication 2001/0027422A1 to Brandrud

TABLE OF ABBREVIATIONS

Abbreviation	Description
PO	Patent Owner Mobile Data Technologies LLC
Op.	Petitioners' Response to Patent Owner's Discretionary Denial Brief, Paper 11
Meta-MDT-IPR	<i>Meta Platforms, Inc. v. Mobile Data Technologies LLC</i> , IPR2024-00249
POR	Patent Owner's Reply in Support of Discretionary Denial, Paper 13

There are no settled expectations counseling in favor of discretionary denial.

First, PO's patents and their ancestors have already been subject to instituted post-grant challenge on no fewer than ten occasions. Nine out of those ten challenges ended in unfavorable outcomes for PO. For example, in three proceedings, two ancestors to the '578 patent were found unpatentable, one based in part on the same art presented here, with all three decisions summarily affirmed on appeal. (Op., 17.) The Board then instituted the Meta-MDT-IPR against the '801 patent based on the same art presented here. (Op., 11.) Finally, the Board instituted Meta's IPRs against five related patents, *including the '336 patent*, based in part on Neibauer and Cheng. IPR2024-00246-248, -250-251.

There is no reasoned basis for PO to conclude that the '578 patent's validity is, or ever has been, "settled." *See Tesla v. Intell. Ventures II*, IPR2025-00217, Paper 9, 2 (Stewart June 13, 2025). For example, the '5801 patent was found invalid and, like the challenged patent, covered method and/or systems for sharing content amongst multiple users. (EX-1024, 3-4.) Thus, PO's expectations are inherently unsettled. PO's assertion that the '336 reexam was "based on Neibauer" is false. (POR, 2.) The reexam relied on four unrelated references, and the requestor made two passing citations to Neibauer to support motivation to combine. (EX-2049, 65.) Regardless, the Examiner erred by not considering Neibauer on the merits, and one instance of an ancestor surviving reexam cannot

evidence settled expectations in view of nine other instances where the Board found at least a reasonable likelihood that the claims were invalid.

Second, PO argues that Petitioners should have been aware of the '578 patent since May 2015 because a patent related to the '578 patent was cited during prosecution of Petitioners' design patent. (POR, 1 (incorrectly relying on *Ericsson* where the challenged patent was cited, not an ancestor).) But by May 2015, the subject patent *had already been found unpatentable* in reexam. (EX-1024, 1.) At that time, the only reasonable conclusion was that the patent posed no risk. Moreover, imposing a duty to investigate here would hold Petitioners to an impossible standard. Likely at least hundreds of thousands of patents and applications are cited on the face of Petitioners' over 145,000 issued patents. Requiring Petitioners to assess and challenge every cited patent and their family members would exact an undue burden on innovators like Samsung.

Third, even accepting PO's incorrect assertion that it inherited the expectations of its predecessor and that those expectations were "settled" (Op. 16-21), any such expectations do not outweigh Petitioners' settled expectations of non-infringement as articulated in *Intel*. IPR2025-00327, Paper 12, 2-3 (Stewart June 26, 2025). PO fails to address Petitioners' eight years of undisturbed commercialization of the accused technology before PO finally sued Petitioners. Thus, settled expectations weigh against discretionary denial.

Date: July 23, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a true copy of Petitioners' Sur-Reply
Regarding Discretionary Denial has been served on the Patent Owner via e-mail to
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