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

IPR2025-00544
U.S. Patent No. 9,619,578

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 '578 and '801 Patents
2003	Petition for *Inter Partes* Review in IPR2025-00543 (Feb. 5, 2025)
2004	Reserved
2005	Return of Service filed in the EDTX-Litigation (June 21, 2024)
2006	E-mail from the Board regarding the 543 and 544 IPR panel assignments (May 2, 2025)
2007	Decision Granting Institution of Inter Partes Review in IPR2024-00249 (June 11, 2024)
2008	E-mail from Erick S. Robinson memorializing the phone conversation with Petitioners' counsel (September 26, 2024)
2009	Reserved
2010	Reserved
2011	Reserved
2012	Reserved
2013	E-mail exchange between Erick S. Robinson and Petitioners' counsel regarding a stay (October 17, 2024)
2014	E-mail exchange between Erick S. Robinson and Petitioners' counsel regarding a stay (February 19, 2025)
2015	E-mail exchange between Erick S. Robinson and Petitioners' counsel wherein Petitioners shared their motion to stay with Patent Owner (March 4, 2025)
2016	Second Amended Docket Control Order in the EDTX-Litigation (December 19, 2024)
2017	United States District Courts — National Judicial Caseload Profile (March 31, 2025)
2018	E-mail from Petitioners' counsel serving their initial and additional disclosures (October 16, 2024)
2019	E-mail from Petitioners' counsel serving their invalidity contentions (January 31, 2025)
2020	E-mail from Petitioners providing materials produced by third-party Microsoft Corporation and Sybase, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (April 25, 2025)
2021	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (March 7, 2025)

Ex.	Description
2022	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 24, 2025)
2023	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 21, 2025)
2024	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 11, 2025)
2025	E-mail from Petitioners providing materials produced by third-party AT&T Mobility LLC in response to Petitioners' subpoena in the EDTX-Litigation (February 5, 2025)
2026	Patent Owner's Infringement Contentions in the EDTX-Litigation (September 4, 2024)
2027	Petitioners' Invalidity Contentions in the EDTX-Litigation (January 31, 2025)
2028	E-mail exchange between Homayoon Rafatijo and Petitioners' counsel regarding Petitioners' contacting the Board for filing their proposed *Sotera* stipulation (April 21-23, 2025)
2029	E-mail from Petitioners' counsel with a draft of a proposed communication to the Board (April 30, 2025)
2030	E-mail from Petitioners' counsel sharing with Patent Owner their proposed *Sotera* stipulation (April 21, 2025)
2031	Reserved
2032	Petitioners' proposed *Sotera* stipulation for '543 and '544 IPRs (April 21, 2025)
2033	Petitioners' claim chart against '578 Patent based on the Nokia 9210 System (January 31, 2025)
2034	Reserved
2035	Summary of verbatim (or nearly verbatim) matches between the '544 petition to the Houh Declaration (Ex.1003)
2036	E-Mail from Petitioners providing Casio America, Inc.'s declarations certifying business records in response to Petitioners' subpoena in the EDTX-Litigation (May 9, 2025)
2037	Joel West & David Wood, *EVOLVING AN OPEN ECOSYSTEM: THE RISE AND FALL OF THE SYMBIAN PLATFORM* (2013)

Ex.	Description
2038	Bradston Henry, *Multiplayer Server Basics | Creating a Multiplayer Game Server - Part 1* (Oct. 25, 2021), https://dev.to/ibmdeveloper/multiplayer-server-basics-ep-1-creating-a-multiplayer-game-server-5aed
2039	Declaration of George Edwards in Regard to the Petitions for *Inter Partes* Review of U.S. Patent No. 9,619,578
2040	Order of the EDTX court denying Samsung's Motion for Relief from Protective Order
2041	Redacted version of Samsung's Motion for Relief from Protective Order filed in the EDTX-Litigation (May 29, 2025)
2042	Patent Owner's and Meta's February 21, 2025 joint email to the Board regarding the settlement of the MDT-Meta-Litigation and Meta-MDT-IPRs
2043	U.S. Design Patent 753,156 Assigned to Samsung
2044	Prosecution History of the U.S. Design Patent 753,156 Assigned to Samsung
2045	File History of Ex Parte Reexamination of U.S. Patent 8,793,336
2046	Petitioner's Authorized Reply to Patent Owner's Preliminary Response (IPR2021-00917, Paper 7, Sept. 22, 2021)
2047	Declaration of Kevin Jakel in IPR2021-00917 (May 11, 2021)
2048	Petition for Inter Partes Review in IPR2024-00249 (Dec. 6, 2023)
2049	Declaration of Petitioners' expert from '538 IPR

I. INTRODUCTION

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

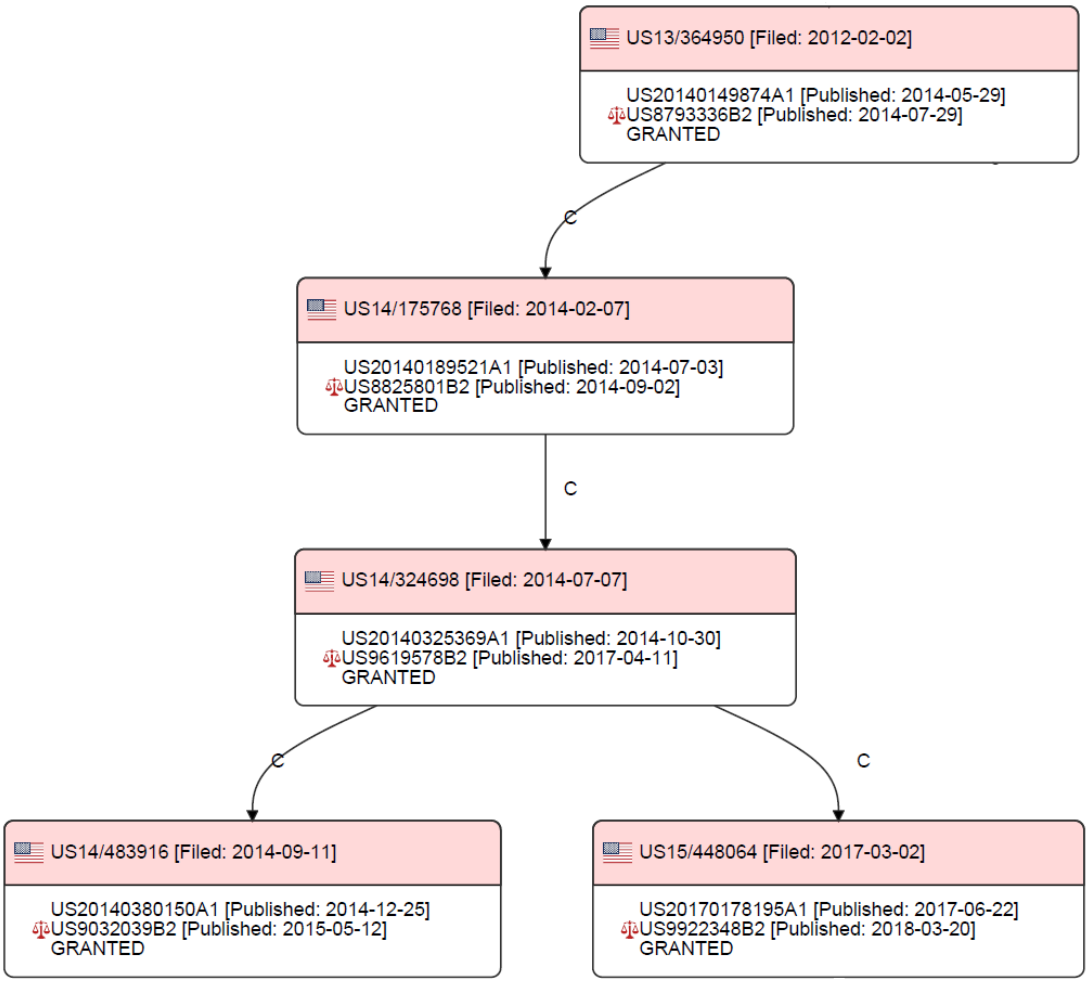

Figure 1. The Asserted Patents' family tree.

Petitioners have had notice of the family of the Asserted Patents before PO filed its Complaint in the EDTX-Litigation for at least two independent reasons. First, the great-grandparent of the '578 Patent, i.e., the U.S. Patent 8,135,801 ("'5801 Patent") was cited during the examination and appears on the face of the U.S. Design Patent 753,156 ("D156" Patent) to Petitioners. Ex.2043, 1. Second, Petitioners previously sought to invalidate the '336 Patent (the '578's grandparent) via an *ex parte* reexamination filed in June 2023 through Unified Patents LLC ("Unified")—

an entity in which Petitioners are members.

Despite the having notice of the Asserted Patents family for several years, Petitioners filed their IPR petitions against the Asserted Patents nearly eight months into the EDTX-Litigation, and after the service of invalidity and infringement contentions. Petitioners filed *ten* IPR petitions—two against each Asserted Patent—on what they characterize as "mutually exclusive grounds." Paper 3 ("Ranking"), 3. The first set asserts the Neibauer-based combinations ("Neibauer Grounds") that Meta Platforms, Inc. ("Meta") advanced in *Meta Platforms, Inc. v. Mobile Data Techs., LLC*, IPR2024-00249 (P.T.A.B. 2023) ("Meta-MDT-IPRs"), a proceeding since settled.[1] Petitioners concede this first set of petitions rests on "common references and arguments" recycled from the Meta-MDT-IPRs. Ranking, 5. Characterizing them as merely "common references and arguments" is too generous: Petitioners copied the Meta-MDT-IPRs petition almost word-for-word. The second set of petitions asserts invalidity grounds based on Randall-Forsyth and Pelkey-Eck combinations (collectively, the "Original Grounds"). Yet Petitioners

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

advance identical claim constructions in both the Original and Neibauer Grounds—Petitioners' proposed constructions appear verbatim in each petition. *Compare* Petition, 5-7*, with* Ex.2003, 6-9.

For two independent reasons, the Board should exercise its discretion to deny institution of the '544-IPR:

1. Petitioners fail to adequately justify its parallel petitions and thus under the *Consolidated Trial Practice Guide* ("CTPG"), the "lower-ranked" '544 Petition should be discretionarily denied.

2. The *Fintiv* factors weigh heavily in favor of denial. The EDTX-Litigation is set for an April 2026 jury trial—six months before any *inter partes* review ("IPR") would conclude, even if the Board were to institute. There is substantial overlap between the '544-IPR and the EDTX-Litigation as Petitioners use system art in the EDTX-Litigation that corresponds to the references relied upon in the Petition. Furthermore, the Petition relies excessively on expert testimony and suffers from fatal weaknesses, as demonstrated below.

The Board should exercise its discretion and deny institution.

II. The Board Should Discretionarily Deny Institution of the Parallel, Lower-Ranked '544 IPR Asserting Original Grounds

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

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

Petitioners justify their parallel petitions ('543- and '544-IPRs) by pointing to a single factor from the April 19, 2024 *Notice of Proposed Rulemaking on Instituting Parallel and Serial Petitions*: "alternative claim constructions that require different prior art references on mutually exclusive grounds."[3] Ranking, 3. Yet, they admit that PO's constructions for both "mobile device" and "application-based information

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

[3] Petitioners' claim that their twin petitions present mutually exclusive grounds is belied by their expert's use of Cheng (a prior art reference used for the Neibauer Grounds) in this IPR to establish "the general knowledge of a POSITA" as a gap-filler for the Original Grounds' shortcomings. Ex.1003, ¶¶89-91, 180-182, 224.

channel"[4] in the Meta-MDT-IPRs are only "narrow[er] constructions" compared to those advanced in the district court litigation between MDT and Meta ("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.* Petitioners, however, adopt the MDT-Meta-Litigation constructions in ***both*** '543- and '544-IPRs. *Compare* Petition, 5-7*, with* Ex.2003, 6-9. Accordingly, Petitioners' alleged justification fails. *See BabyBjorn, AB v. The Ergo Baby Carrier, Inc.*, IPR2025-00111, Paper 19, 11-13 n.11 (P.T.A.B. Apr. 22, 2025) (holding that a second-ranked petition is unnecessary when petitioner addresses the same construction in both petitions); *see also Medacta USA, Inc. v. RSB Spine, LLC*, IPR2020-00275, Paper 22, 10-11 (P.T.A.B. May 22, 2020). Furthermore, Petitioners could have sought claim constructions within one petition instead of filing two petitions.

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

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

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

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

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

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

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

Pharma. Corp., 225 F.3d 1349, 1355 (Fed.Cir.2000) (holding that when claims are invalid under a narrow construction of a term, it is not necessary to determine whether they are invalid under a broader construction). Accordingly, the '543-IPR asserting Neibauer Grounds—predicated on the broader construction—is redundant.

Petitioners nonetheless chose to rank the '543-IPR higher—underscoring their own lack of confidence in the merits of the '544 Petition. Had they truly believed in the strength of the Original Grounds, they would have ranked the '544-IPR higher, as those Grounds supposedly rely on narrower constructions and should have sufficed to invalidate the claims under either narrow or broad construction. The Board should not institute an IPR that Petitioners themselves deemed the weaker of the two.

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

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

Petitioners also contend the "burden on the Board and PO in instituting" two IPRs against the '578 Patent is "minimal" because the higher-ranked '543-IPR relies on "common references and argument" as Meta asserted in the Meta-MDT-IPRs. Ranking, 4-5. Untenable. The burden may indeed be trivial for Petitioners—they have merely copy-pasted the Meta-MDT-IPR on the '578 Patent into the '543 Petition—but it is anything but minimal for everyone else. PO must craft a full response[6] and retain a new expert due to a conflict with Petitioners, while the Board must devote substantial resources to preside over potentially two trials on the same '578 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 '543-IPR does not warrant abusing the IPR process and imposing the added burden of a second proceeding on the '578 Patent. Doing so undermines the efficiency the IPR

[6] As evidenced from PO's merits and *Advanced Bionics* in its '543 discretionary denial brief, unlike Petitioners, PO does not copy-paste its arguments from the Meta-MDT-IPRs. Instead, PO spent significant resources to refine its arguments, focusing on the Petition's fundamental deficiencies.

process is designed to protect. That inefficiency is especially true here: as of May 4, 2025—over three months after filing the '544-IPR—Petitioners' IPR petitions "are not yet paneled." Ex.2006. This indicates the Board's demanding workload, and despite that workload Petitioners abused the IPR process by filing parallel—yet completely unnecessary—Petitions. And as the Board has previously recognized, the inefficiency of parallel Petitions is even more heightened where, as here, Petitioners themselves ask the Board to "consider the merits of this Petition last." *Pfenex Inc. v. GlaxoSmithKline Biologicals SA*, IPR2019-01478, Paper 9, 12-13 (P.T.A.B. Feb. 10, 2020).

As explained above, Petitioners do not point to any reasonable basis to file parallel petitions, and thus Petitioners should have put their best foot forward in a single petition. Here Petitioners rank the '543-IPR higher than the '544-IPR. Ranking, 2. Accordingly, the Board should exercise its absolute discretion and deny institution of the '544-IPR. Considering "the ability of the PTAB to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AIA proceedings, and other workload needs" (*see* the March 26, 2025 Memorandum titled, "Interim Processes for PTAB Workload Management" (the "March 26, 2025 Memo"), 2-3), exercising absolute discretion to deny institution of the lower-ranked '544-IPR, especially when there was no reason to file parallel petitions, is prudent.

Denying institution for the lower-ranked '544-IPR will "maintain PTAB

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

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

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

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

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

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

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

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

Memo, 2-3.

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

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

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

As a threshold matter, the '578 Patent is not subject to an instituted IPR proceeding, and the EDTX denies stays when the Board has not issued the decision on institution:

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

CyWee Grp. Ltd. v. Samsung Elecs. Co., 17-cv-140, 2019 WL 11023976, *5 (E.D.Tex. Feb. 14, 2019); *see also Trover Group, Inc. v. Dedicated Micros USA*, 2:13-cv-1047WCB, 2015 WL 1069179, *6 (E.D.Tex. Mar. 11, 2015) (Bryson, J.) ("This Court's survey of cases from the 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."); *Samsung Elecs. Co. v. Evolved Wireless LLC*, IPR2021-00950, Paper 10, 10-11 (P.T.A.B. Nov. 29, 2021) (finding a stay was unlikely partly based on the court's past decisions denying stays); *Samsung Elecs. Co. v. Clear Imaging Research, LLC*, IPR2020-01552, Paper 12, 12-13 (P.T.A.B. Mar. 3, 2021) (denying institution because, in part, Judge Gilstrap deemed unlikely to stay a case in similar circumstances).

Additionally, even if the Meta-MDT-IPRs were still active before the Board and Petitioners file their motion to stay today—before the Board decides institution in the '544-IPR—the EDTX would deny Petitioners' motion based on Petitioners' delay. Petitioners had every opportunity to file a motion to stay the EDTX-Litigation any time between institution and withdrawal of the Meta-MDT-IPRs, namely between June 2024 and March 2025. In fact, Petitioners have been contemplating a motion to stay for over seven months, since the early stages of the EDTX-Litigation (*See* Exs.2008, 2013, and 2014), but have not filed a motion with the district court.

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

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

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

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

without an acceptable showing of good cause. Good cause is not shown merely by indicating that the parties agree that the deadline should be changed." *Id.*, 5. An institution decision on the '544-IPR is not due until October 2025. By that date, the parties will have substantially completed the claim construction process, with the *Markman* hearing scheduled for October 30, 2025. *See id.*, 4-5. An FWD would not be due until October 2026, six months after trial is scheduled to begin. For this independent reason, the EDTX is likely to find a stay in circumstances like this case would unduly prejudice PO. *See, e.g.*, *MyPort, Inc. v. Samsung Electronics Co.*, et al., 2:22-cv-00114-JRG, Dkt. 73 (E.D.Tex. June 12, 2023), 4 (denying a stay where the PTAB decision is not due until over two months after jury trial is set to begin).

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

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

Fintiv Factor 2 strongly weighs in favor of discretionary denial because by the time any FWD in the '544-IPR would issue, the EDTX-Litigation would be concluded, and Petitioners' invalidity challenges all addressed by the district court. "If a district court's trial date is earlier than the Board's projected statutory deadline for a final written decision, the Board generally has weighed this fact in favor of exercising discretion to deny institution." *T-Mobile USA, Inc., et al. v. Wireless Alliance*, IPR2024-00608, Paper 16 (P.T.A.B. Sept. 3, 2024) (denying institution of

IPR).

The '544-IPR was filed nearly eight months after initiation of the EDTX-Litigation, and a decision whether to institute the '544-IPR is expected approximately on October 13, 2025. If instituted, any FWD is expected approximately on October 13, 2026. 37 C.F.R. §42.100. Jury selection in the EDTX-Litigation is scheduled to begin on April 20, 2026, six months before any FWD from the Board. *See* Ex.2016, 1, 5 (jury selection is "a deadline that cannot be changed without an acceptable showing of good cause" which must be more than the parties' agreement). The parties have never attempted to extend any of the critical interim deadlines, such as claim construction, fact discovery, expert discovery, pre-trial conference, and jury selection.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

months prior to filing the '544-IPR. Ex.2026. The five-month gap between service of infringement contentions and the filing of the '544 Petition constitutes "substantial delay" that favors discretionary denial under *Fintiv* Factor 3. *AT&T Servs. v. ASUS Tech.*, IPR2024-00992, Paper 14, 12 (P.T.A.B. Dec. 16, 2024) (five months between infringement contentions and the petition is a "substantial delay").

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

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

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

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

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

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

Procedurally, Petitioners' *Sotera*-style stipulation is untimely. Petitioners had ample opportunity to file their *Sotera*-style stipulation sooner and even at the time of filing the '544-IPR but waited for over three months to contact the Board to seek leave to file.[11] Ex.2006. And despite PO promptly responding to Petitioners' inquiry

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

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

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

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

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

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

stipulation provides that if the Board "institutes an *inter partes* review ("IPR") in either or both of IPR2025-00543 and IPR2025-00544 concerning U.S. Patent No. 9,619,578, then Samsung will not pursue in this litigation the grounds raised or any other grounds that could have reasonably been raised before the PTAB in the instituted proceeding(s)." Ex.2032.[13] However, in view of Petitioners' invalidity contentions ("IVCs"), this stipulation is insufficient.

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

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

described in Randall and Forsyth. Petition, 8-12.

In the EDTX-Litigation, Petitioners have asserted the "Nokia 9210 System" as a prior art system to challenge the validity of the '578 Patent. Ex.2027, 41. As a threshold matter, the Nokia 9210 system relies on Symbian OS, which originates from a major joint venture between Psion and phone manufacturers Ericsson, Motorola, and Nokia to create Symbian Ltd. in June 1998. Ex.2037, 5. Ex.2039, ¶9. The collaboration aimed to develop a standardized operating system for mobile devices—Symbian OS. *Id.* The Nokia 9210 Communicator was the first device to run on the Symbian OS platform, with Nokia's Series 80 UI, the result of Symbian Ltd.'s 'Crystal' design. *Id.*, 5-6, 10 (showing crystal design features). Thus, the Nokia 9210 System is a device that runs on Symbian OS.[14] Indeed, Petitioners' evidence used in this IPR uses the Nokia 9210 Communicator as a "Symbian OS Phone." Ex.1019. Specifically, the Nokia 9210 features that Petitioners relied on in their IVCs are enabled by the Symbian OS and adequately described in Randall and Forsyth as explained below.[15]

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

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

Indeed, Petitioners' expert, Dr. Houh, concedes the Randall-Forsyth teachings are embodied in the Nokia 9210 System asserted by Petitioners' IVCs. Houh states that "[n]umerous books and papers published prior to June 2002 (or in 2002) ***confirm the disclosures of Randall and Forsyth regarding wireless devices running the Symbian OS.***" Ex.1003, ¶107. The very next paragraph, Houh states that "[t]he Symbian OS, available prior to 2002, was intended for a range of devices." Ex.1003, ¶108. And in the next paragraph, Houh lists the Nokia 9210 System as an example. "Allin's Figure 3 below illustrates the ***Nokia 9210 Communicator*** based on the Crystal communicator reference design." Ex.1003, ¶109; *see also* ¶¶110-111.

9210 System teaches, discloses, or otherwise suggests any limitation of the '578 Patent. The discussion is limited to comparing disclosures of the Nokia 9210 system and Randall-Forsyth. PO maintains that the Nokia 9210 System does not render obvious any claims of the '578 Patent for the same reasons the Randall-Forsyth combination does not.

Figure 2. Top frame: the Nokia 9210 Communicator depicted in Houh's declaration. Ex.1003, ¶109. Bottom frame: the Nokia 9210 Communicator shown in Petitioners' IVCs. Ex.2033, 22-27.

For limitation 1[A], Petitioners' IVCs use the Nokia 9210 User Guide disclosure that "Short Message Service (SMS) enables you to send and receive short messages over the digital wireless network." Ex.2033, 6. But Forsyth also discloses this capability: "To start a Forum, a user sends a short message to his chosen recipients. To do this, the user/Forum creator enters a SMS-style message and Forum title into the wireless communication device." Forsyth, 5:45-48. The ability for a user to send a short message with the Forums application is a capability provided by the client-server architecture of the Symbian OS. Ex.2039, ¶11.

Petitioners' IVCs also use the disclosure of "Word Processor" for its ability to write and edit content in the Nokia 9210 User Guide. Ex.2033, 6. But Forsyth's claim 3 expressly recites that group objects are capable of being used by any of the following applications: "(a) e-mailing application (b) text based messaging application (c) voice telephony (d) multi-media messaging (e) productivity applications (including word processing, spreadsheets, and presentation applications)." These applications would function similarly to Forums, which "runs on the object based operating system Symbian OS," such that the applications run on the Symbian OS in devices like the Nokia Communicator. Forsyth, 2:40-53; Ex.2039. ¶12.

Petitioners' IVCs also use "the Contacts application to create, edit, and manage all contact information, such as phone numbers and addresses." Ex.2033, 6-

7. This feature of the Symbian OS is disclosed in Forsyth-Randall combination. As conceded by Houh: "Forsyth is directed to a 'group communication method' using a 'group object' to specify identities of group members. Forsyth's 'group object' is application independent and as such can be created in one application and then immediately used in other applications to specify a group for group communication." Ex.1003, ¶48. Forsyth discloses a specific Forums application, but the application "runs on the object based operating system Symbian OS" where "group objects can be defined independently of any specific task or application." Forsyth, 2:40-53. Forsyth's disclosure of utilizing group objects for creating, editing, and managing contact information is a capability provided by Symbian OS. Ex.2039, ¶13.

Forsyth's "group object" can be actual contact information, which would be stored by the Symbian OS: "A 'group object' is therefore a collection of information that describes or references at least the minimum amount of information about 2 or more entities (usually individual, but possibly also different aspects of the same individual) required for activities to be engaged in between them, or content to be shared or exchanged. It can be actual contact information for each member of a group." Forsyth, 2:17-24. The option to "[define] the recipients of a message, or… [define] the desired participants to be involved in group communication" is enabled by the use of group objects, which is a capability provided by Symbian OS where "group objects can be defined independently of any specific task or application."

Forsyth, 2:40-53; Ex.2039, ¶14. Randall also discloses a function that "lets you create circles of contacts of people with similar interests who you may never have met before, but have picked up their text details on a website where you share interests in common." Randall, 82.

Petitioners' IVCs also refer to the Nokia 9210 User Guide: "You can create contact groups to save time by sending e-mails and short messages to all members of the contact group in one action." Ex.2033, 7. This capability of the Symbian OS is disclosed in the Randall-Forsyth combination: "Forums…facilitates open discussion amongst a group and allows multiple chat-style conversations to take place simultaneously." Petition, 18 (citing Forsyth). Petitioners also cite Randall, stating that "a forum allows several people to be part of a 'channel' or room, which is usually themed." Petition, 18. In both disclosures, the underlying capability for storing the contact records of the people in a group is provided by the Symbian OS. Ex.2039, ¶16.

Petitioners' IVCs also include citation to Nokia's internet browsing features allowing users to "interactively post and respond" to content. Ex.2033, 9-10. But Randall-Forsyth combination also discloses the same internet browsing features of the Symbian OS. Randall describes a "data services framework" allowing integration with web-based services such as a BBC service for weather or a Yellow Pages service, where a "two-way flow of information" enables the user interaction

with web services. Randall, 20:16-28. This contributes to the dynamic content sharing and message delivery of Symbian. Ex.2039, ¶17. Forsyth similarly describes the integration with web services via a "central server [that] can act as a store for resources which group-members may wish to discuss and share" such as "web sites." Forsyth, 3:19-34. Forsyth describes "Social Browsing" where users can "see the internet sites other people have browsed to… on a per-person basis," allowing users to share images and maintain collaborative records through web interfaces. Forsyth, 13:5-20.

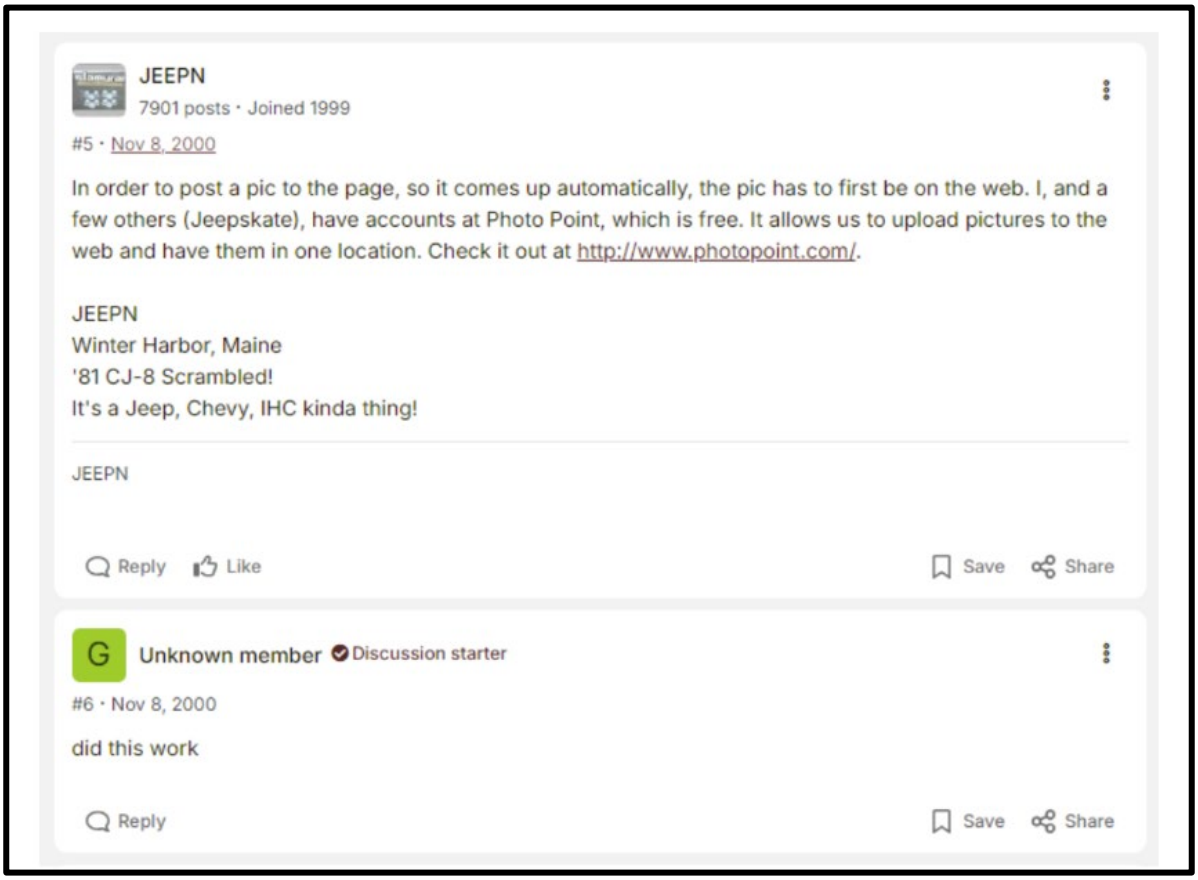
Furthermore, Houh admits the Randall-Forsyth combination discloses internet browsing to post and respond to content: "Forums uses a client/server model with a program component running on a wireless information device (e.g., a local application or microbrowser) which communicates over the wireless network to a program component on the server." Ex.1003, ¶158. Specifically, "based on Randall's disclosure of GSM and WAP, a POSITA would have understood the client-side application is either (1) a standalone application supporting WAP or GSM-messaging protocol or (2) a web browser (such as a WAP microbrowser)." Ex.1003, ¶54. Randall discusses communication methods including GSM and WAP as being utilized as "good, functional transport solutions" for ServML, which is a "a means of storing, accessing, and interacting with data using a client-server architecture" that "takes advantage of the power of Symbian advanced clients" and

therefore provided by Symbian OS. Randall, 45:5-15, 58:5-20. Similarly, Houh states Forsyth's "'new forum' interface screen is a webpage provided by the server and displayed via a microbrowser or a client-side Forums application supporting WAP." Ex.2049, ¶89. The capability to provide a microbrowser for display of a webpage utilized by the Forums Application is provided by the Symbian OS. Ex.2039, ¶18. Thus, disclosure in the IVCs for limitation 1[A] is the same as in the Randall-Forsyth combination.

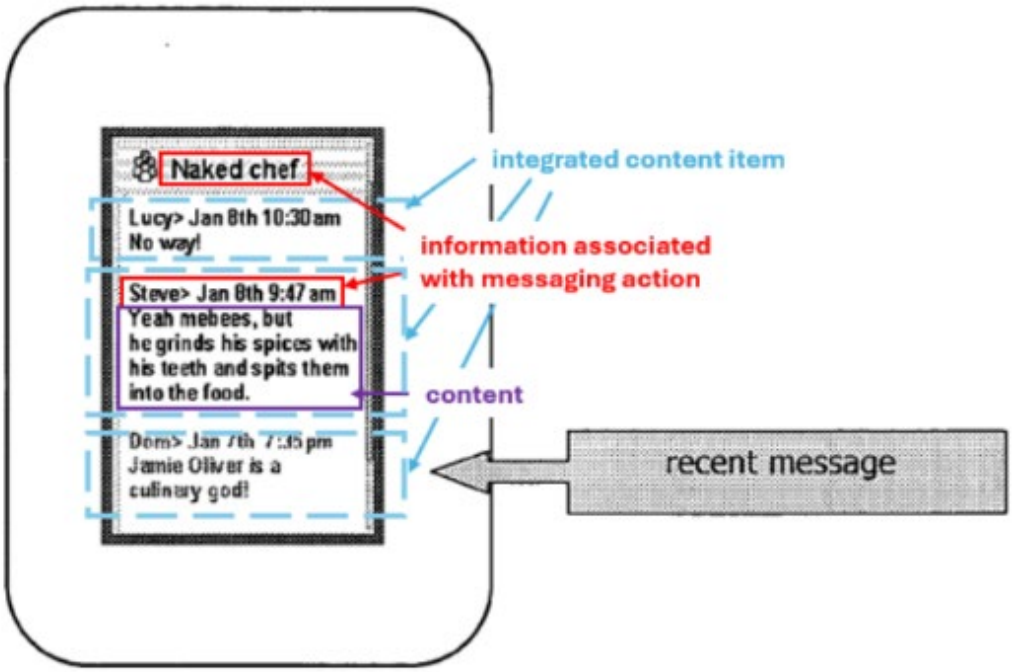
For limitation 1[B], Petitioners' IVCs use the Nokia 9210 User Guide "Your Inbox shows the date of received short messages and the time of the short messages received on the current day." Ex.2033, 15. Randall discloses this feature: "ADS adds further to its inherent reliability by introducing the concept of indicating the freshness of data. This can be implemented through a date stamp indicating when particular data was obtained from the server, or a graphical icon representative of freshness." Randall, 12. Forsyth similarly discloses this feature in a Symbian OS application: "[n]ew messages are easily identifiable. Messages appear in date order, i.e. newest messages appear at the bottom. The view automatically focuses on the most recent message to minimize scrolling." Forsyth, 6:40-45; Ex.2039, ¶19 (citing Forsyth's Fig.7).

For limitation 1[B], Petitioners' IVCs state the Nokia 9210 System allowed determination of "information associated with wireless messaging such as username

and date/time, such as in the following exemplary forums, newsgroups, websites, and messengers." Ex.2033, 15. Petitioners included the following snippet in the Nokia 9210 System claim chart as an exemplary forum:



Ex.2033, 16. This corresponds to Forsyth's Figure 7 which Petitioners use to show the "sender/poster identity, Forum name, date/time" are integrated with the message. Petition, 41-42.



Forums—Forsyth, Figure 7

Petition, 42; Ex.2039, ¶¶20-21.

For limitation 1[C], Petitioners' IVCs use the Nokia 9210 System User Guide statement that "[s]ome servers have access restrictions that require a valid user name and password. In this case, you will be prompted for your user name and password before the Web page can be retrieved." Ex.2033, 19. But Randall discloses this feature as implemented in the Symbian OS: "There is a need for authentication of the user when they access their data perhaps via their WID. This authentication should prevent access to their information both locally and on the 10 server (for instance if their device is stolen). The authentication can use a number of different mechanisms: a basic WID and password/passphrase is likely to be first line of access.

Once past this stage the WID may store private key(s) transparently to the user of the WID that will allow access to services. The private key effectively represents the ownership of the WID to the server side session." Randall, 48; Ex.2039, ¶22.

Petitioners' IVCs also cite the Nokia 9210 User Guide disclosure of "When you receive a short message or picture message, a text indicating the number of messages that have been received and the indicator will appear on the display and a tone will sound, unless the communicator is set to a silent profile." Ex.2033, 19. This feature of the Symbian OS, however, is disclosed by Forsyth. Ex.2039, ¶23. "After a user receives notification of a Forum message, he can check the status of his Forums, as shown in FIG.6. This view distinguishes Forums with unread (new) messages from those with read (old) ones. The new Forum (subject: Naked Chef is therefore shown highlighted, although colour may not be enough to act as the only distinguishing attribute. There may also be some graphical indication of the number of unread (new) messages." Forsyth, 6:28-36. Forsyth also discloses that the notification feature provided by the Symbian OS can be turned off. "In either case, the users' devices simple send a notification to the Forum of each site visited (when notification is allowed by the user—it may be turned off)." Forsyth, 13:12-14.

As the above analysis shows, each of the Nokia 9210 features Petitioners use in the EDTX-Litigation is adequately described by the Randall-Forsyth combination. Ex.2039, ¶26. Despite Petitioners' statutory inability to raise the

Symbian OS-based system (e.g., Nokia 9210 System) in this IPR, a substantial overlap of issues would remain even with Petitioners' *Sotera*-style or any other narrower stipulations. Where, as here, "the petitioner is ***relying on corresponding system art*** in a co-pending proceeding and/or several other invalidity theories, ***a stipulation may not be particularly meaningful***." FAQs, Q.14.

Because Petitioners intend to swap labels in the EDTX-Litigation to cloak the Ground 1 as a prior art system when it is the same art asserted in the Petition, *Fintiv* Factor 4 weighs strongly in favor of denying institution. *See, e.g.*, *SAP America*, IPR2024-01496, Paper 13, 8-9 (holding on similar facts "we do not consider the presence of the *Sotera* stipulation in our case to ensure that inter partes review would be a 'true alternative' to the Litigation").[16]

[16] Similarly, for Ground 2 Petitioners rely on Pelkey-Eck, which disclose "an enhanced version of the Nintendo GameBoy," an allegedly prior art system. Ex.1003, ¶245. Petitioners' *Sotera*-style stipulation does not preclude them from asserting an invalidity ground based on Nintendo GameBoy or combination of Nintendo GameBoy with Pelkey-Eck in the EDTX-Litigation.

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

The Board's determination as to effectiveness of a *Sotera* stipulation hinges on "whether the stipulation ***materially reduces overlap*** between the proceedings." FAQs, Q.14. A stipulation is not effective unless it guarantees that "the same or substantially ***the same claims, grounds, arguments, and evidence***" will not be raised in the district court. *Fintiv*, 12-13. Under *Fintiv*, the analysis thus is not limited to whether the grounds of unpatentability are of the same nature (i.e., based on patents/publications) in different proceedings—the analysis must consider whether a petitioner raises substantially the same arguments and evidence in different proceedings. *Id.*

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

Ingenico thus permits Petitioners to use the same prior art references raised in

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

In fact, Petitioners have expressly reserved the right to do this in the EDTX-Litigation. Petitioners expressly state in their Nokia 9210 System invalidity claim charts in the EDTX-Litigation that:

> ***[I]t would have been obvious to a person of ordinary skill in the art as of the priority date of the '578 patent to modify the Nokia 9210 System and/or combine the teachings of the Nokia 9210 System with other prior art references, including but not limited to the prior art references presently found in Samsung's Invalidity Contentions …***

Ex.2033, 1. The four references relied upon in this IPR—Randall, Forsyth, Pelkey, and Eck—are amongst the "the prior art references presently found in Samsung's Invalidity Contentions." *See* Ex.2027, 41. 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 '544-IPR with a prior art system. Indeed, given that Randall, Forsyth, and the Nokia 9210 System are all directed at the Symbian OS, Petitioners can "***combine the teachings of the Nokia 9210 System with other prior art references***," (i.e., Randall

and/or Forsyth). Ex.2033, 1.

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

> ***Defendants' reference to a particular device or product*** in the claim charts of Exhibits D1-D23 ***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 D1-D23 that relates to the cited device, or product.***

Ex.2027, 43-44.

Accordingly, in view of *Ingenico* as well as Petitioners' express statements in their invalidity contentions, Petitioners' *Sotera*-style stipulation does not "materially reduce[] overlap" between this IPR and the EDTX-Litigation, as required by the Board. FAQs, Q.14. The Board should exercise its discretion to deny institution in this case.[17]

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

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 exercising discretionary denial.

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

The March 26, 2025 Memo lists "***settled*** [as opposed to speculative] expectations of the parties" as a factor to be considered as part of the Board's holistic review. PO has a settled expectation in the validity of the challenged claims.[18] First,

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litigation. Petitioners' admission that estoppel does not apply under *Ingenico*, even with their *Sotera* stipulation, only underscores the insufficiency of that stipulation to satisfy the very concerns *Sotera* was meant to address.

[18] 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

these claims are entitled to the statutory presumption of validity. 35 U.S.C. §282. Second, the challenged claims were in force since 2017 until they expired recently.

In addition, ***the Asserted Patents enjoy an unqualified expectation of validity against Petitioners***. Petitioners have had knowledge of the Asserted Patents family since at least May 2015, yet never addressed the validity of the Asserted Patents family. The '5801 Patent—the great-grandparent to the '578 Patent—appears on the face of the D156 Patent assigned to Petitioners, and was cited in an IDS on May 28, 2015 during the examination of the D156 Patent. Ex.2044, 72.

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

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standard" between the burden to establish a reasonable likelihood of success and the burden of proof by a preponderance of the evidence).

application creates an implicit expectation between the parties as to the entire family:

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

iRhythm, IPR2025-00363, Paper 7, 31.

Like *iRhythm*, Petitioners have also created an "implicit expectation between the parties" because (1) the great-grandparent of the '578 Patent (i.e., '5801 Patent) appears on the face of the D156 Patent assigned to Petitioners and was cited in an IDS during the examination of the D156 Patent,[19] and (2) Petitioners failed to seek earlier review of the Asserted Patents.

a) Petitioners attempted but failed to invalidate the grandparent of the '578 Patent via an *ex parte* reexamination filed by Unified in June 2023

Even assuming the May 2015 IDS did not give Petitioners notice of the Asserted Patents family (it did), Petitioners cannot justify their delay in filing these

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

IPRs as explained above. On June 9, 2023, Unified filed a request for *ex parte* reexamination of the '336 Patent—the grandparent of the '578 Patent. *See* Ex.2045. Unified's reexamination request pointed to Neibauer's disclosures—the very same disclosures Petitioners rely on in the '543 Petition. *Id.*, 65. The Examiner considered Unified's arguments, including those based on Neibauer, but confirmed the patentability of the challenged claims of the '336 Patent.[20]

Petitioners are members of Unified, as Unified admitted in its filings with the Board. *See* Ex.2046, 1 n.2 ("Apple, Inc. and Samsung Electronics Co., Ltd. are members of Unified Patents."). Unified's CEO, Kevin Jakel, previously stated in a sworn declaration that Unified's "'Members subscribe to one or more of Unified's technology-specific NPE zones [and] pay a yearly subscription fee to a specific NPE technology zone." Ex.2047, ¶2. In return for those fees, Unified performs various

[20] For this reason alone, Petitioners' Neibauer Grounds in the '535, '537, '539, '541, and '543-IPRs against the Asserted Patents fail under the *Advanced Bionics* framework. As explained in PO's discretionary denial briefs in those IPRs, Neibauer was considered by the Examiner during the examination of the Asserted Patents. Furthermore, Neibauer's disclosures relied upon by Petitioners in those IPRs were also considered by the Examiner of Unified's reexamination proceeding. Ex.2045, 65. The Board should not disturb the determinations of two Examiners.

services for its members, including filing requests for *ex parte* reexamination. *See id.*, ¶3. Given Petitioners' membership in Unified, and even assuming the May 2015 IDS did not give Petitioners notice of the Asserted Patents family (it did), Petitioners have had knowledge of the Asserted Patents family at least as of June 9, 2023, but "failed to seek early review of" the Asserted Patents. *iRhythm*, IPR2025-00363, Paper 10, 3.

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

2. Petitioners' abuse of the IPR process

As explained above, Petitioners' filing two sets of petitions is nothing but an attempt to circumvent the 14,000-word limit. Petitioners contend filing multiple petitions was necessary because PO proposed two alternative constructions for some of the claim terms. Ranking, 2-4. Yet, instead of addressing one claim construction in their first-ranked Petition and the other in the second-ranked Petition, Petitioners take identical claim construction positions in '543 and '544 Petitions. *Compare* Petition, 5-7*, with* Ex.2003, 6-9. This highlights two points. One, PO's proposed construction are not truly alternatives as Petitioners characterize. Two, Petitioners' first-ranked and second-ranked Petitions substantially overlap.

Petitioners' abuse of the IPR process is further highlighted by them burdening the Board and PO with their copycat '543 Petition instead of joining the Meta-MDT-IPRs. Petitioners were served with the Complaint in the EDTX-Litigation on

June 17, 2024—less than one week after the Board instituted trial on the '578 Patent in the Meta-MDT-IPRs. *See* Exs.2005 and 2007. Any modicum of diligence would have revealed that the same '578 Patent was already in an active IPR. Had Petitioners truly wished to pursue the Neibauer Grounds advanced in the Meta-MDT-IPRs, they could—and should—have sought joinder no later than July 11, 2024, per 37 C.F.R. §42.122(b). Petitioners offer no explanation for letting that window close.[21] *See Pfenex Inc. v. GlaxoSmithKline Biologicals SA*, IPR2019-01478, Paper 9, 12 (P.T.A.B. Feb. 10, 2020) ("Moreover, if Petitioner was interested in pursuing the

[21] In a motion filed in the EDTX-Litigation, Petitioners claim they did not attempt joinder because they did not have "MDT's infringement contentions (which assert claims not challenged in the Meta-MDT-IPR)." Ex.2041, 5. This is a red herring. First, Petitioners' invalidity challenges in the '543 IPR are directed only at claims that were challenged in the Meta-MDT-IPRs. *Compare* Ex.2003, 2-3*, with* Ex.2048, 2-3. Furthermore, Petitioners' conduct shows that PO's EDTX-Litigation infringement contentions are irrelevant to Petitioners' IPR positions. PO did not assert in the EDTX-Litigation claims 2-6, 13-14, 17-19, and 22 challenged by Petitioners. Ex.2026, 3. Petitioners have no good reason to include these claims in the '543-IPR other than to unnecessarily burden the Board and PO, tying their interest to Meta's, and abusing the IPR process.

same challenge as that presented in the 230 IPR, it could have requested joinder under 37 C.F.R. §42.122(b). … That the 230 IPR settled after institution is not an adequate excuse for delay.”).

Filing multiple IPR petitions against the same patent—when joinder was readily available—subverts procedural economy and needlessly expends Board resources. Instead, Petitioners bypassed the obvious route—filing a joinder motion by July 11, 2024, under 37 C.F.R. §122(b)—recycling the same Neibauer Grounds with “common references and arguments,” (Ranking, 5), from Meta-MDT-IPRs, and filing it as a new petition. This amounts to abuse of the IPR process and unduly burdens the Board and PO.

A prompt joinder would have cast Petitioners as understudy should MDT and Meta settle, conserved the Board’s finite resources, and satisfied the Board’s preference for joinder where, like in this case, no new issues arise. *See EndyMed Medical Ltd. v. Serendia, LLC*, IPR2024-00843, Paper 14, 12 (P.T.A.B. Jan. 10, 2025) (“[T]here is a policy preference for joining a later petitioner if their petition does not present new issues that might complicate or delay an existing proceeding.”). Petitioners’ excuse for not filing a joinder fails. *See supra* note 21.

a) Petitioners’ failure to identify “all real parties in interest” is a discretionary consideration

As explained above, Petitioners attempted but failed to invalidate the claims of the ‘336 Patent through an *ex parte* reexamination request filed by Unified in June

2023. Given Petitioners' membership in Unified, Petitioners should have listed Unified as a real party in interest. Their failure to do so is abuse.

"[T]he focus of the real-party-in-interest inquiry is on the patentability of the claims challenged in the IPR petition, bearing in mind who will benefit from having those claims canceled or invalidated." *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1348 (Fed.Cir.2018). "Determining whether a non-party is a 'real party in interest' ***demands a flexible approach*** that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that ***has a preexisting, established relationship with the petitioner***." *Id.*, 1351. This inquiry requires examining the IPR petitioner's relationship with the non-party to determine whether the IPR petitioner represents the non-party's interest in invalidating the challenged claims. *Id.*

It is undisputed that Petitioners and Unified have a pre-existing, established relationship, as Petitioners are paying members of Unified. Ex.2046, 1 n.2. And it is without question that Unified stands to benefit from the outcome of Petitioners' IPRs, should that outcome be favorable to Petitioners. Unified expended the resources necessary to prepare and file the reexamination request against the '336 Patent, which shows Unified's interest in invalidating the claims of the Asserted Patents. Unified publicly states that "Unified exists to break the cycle of patent

assertion."[22] And as of 2024 Petitioners are "the most sued company in the U.S., with 69 patent infringement lawsuits involving 208 patents."[23] Thus, as evidenced by Petitioners' membership in Unified, Petitioners and Unified both benefit from invalidating patents.

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

3. Petitioners' inconsistent rankings of the Petitions

Petitioners rank their twin Petitions inconsistently. For their Petitions against the '039 Patent, Petitioners rank the Petition asserting the Original Grounds (i.e., the '536-IPR) higher than the Petition asserting the Neibauer Grounds (i.e., the '535-IPR). Here, however, Petitioners rank the Petition asserting the Original Grounds (i.e., the '544-IPR) lower than the Petition asserting the Neibauer Grounds (i.e., the '543-IPR).

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

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

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

capricious ranking.[24] 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 '578 Patent. Determining unpatentability based on "mutually exclusive" prior art references (Ranking, 3) for patents of the same family would unnecessarily impose additional burden on the Board, notably when the specifications of the '039 and '578 Patents

[24] In their response in the '535-IPR, Petitioners attempt to justify their inconsistent ranking by claiming that "Petitioners are challenging 16 claims in the ['039] patent not challenged by Meta," and that they ranked the IPR2025-00536 petition higher because "the Board would need to make some additional investment in analyzing the prior art regardless of which set of grounds was selected." While Meta challenged independent claims 19 and 23, Petitioners' unpatentability arguments—including those for claims not addressed by Meta—are little more than a copy-and-paste of Meta's arguments for claims 19 and 23. For instance, Petitioners assert that independent claim 1—which Meta did not challenge—is invalidated by the exact same prior art disclosures that Meta cited against claim 19. Thus, because Petitioners themselves relied on the same disclosures for all challenged claims that Meta used for only a few, their claim of "additional investment" is nothing more than a red herring.

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

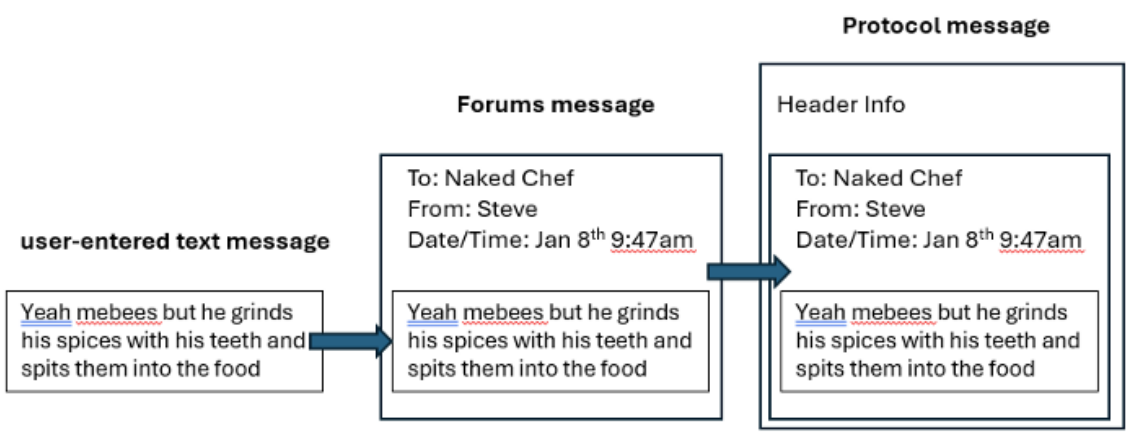
The Board's FAQs about the discretionary denial process expressly state "***extensive reliance on expert testimony*** … ***may suggest that the questions are better resolved in an Article III court***." FAQs, Q.21. The Board emphasized the statutory requirement that "petitions [must] be based on prior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

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

Petitioners' 197-page-long expert declaration for their 99-page Petition is not "focused expert testimony." Nor does it provide any helpful context. In fact, contrary to the Board's direction that "it is not necessary for an expert to explain every aspect of the prior art" (FAQs, Q.21), Houh engages in a limitation-by-limitation obviousness analysis of the claims, and fills shortcomings in the prior art using only

conclusory statements. PO presents examples here.

In discussing "wireless networking functionality" of 1[B]/9[C] for both Grounds, Houh's testimony goes beyond the references and offers unsupported opinions. With Ground 1, Houh makes two fundamental definitive but conclusory statements: "when a device captures a user's content, the mobile device creates a Forums message by bundling the sender... and the Forum name…with the user supplied content" and "[t]he mobile device must also encapsulate the generated Forums message into a protocol message to be transmitted by over wireless network, as I illustrate in my Figure B below." Ex.1003, ¶¶162-163. Other than his say-so, Houh offers no evidence supporting either conclusion. On encapsulation of a Forum message, Houh concedes that "neither Randall nor Forsyth provides the details of the ***wireless messaging functionality*** of ***GSM-SMS or WAP***." *Id.*, 163. Houh assumes without providing any explanation that ***the Forums message in Forsyth*** is somehow converted into a protocol message with such information. For support, Houh cites his own made-up drawings, resulting in merely a circular argument. *Id.* Furthermore, Houh's drawings are not proper prior art. *Meta Platforms, Inc., et al. v. Eight kHz, LLC*, IPR2023-01023, Paper 10, 31 (P.T.A.B. Jan. 9, 2024) ("We further note … Dr. Begault's deposition testimony, ***which does not qualify as prior art in this proceeding***.").



Houh, Figure B

In the next few paragraphs, Houh cites Exhibits 1015 and 1014—references that are not included in any Asserted Ground—to discuss GSM and WAP functionality. Ex.1003, ¶¶164-166 (discussing Ex.1015 and cross-referencing Ex.1014). Houh does so to fill the gap he admits exists in Randall-Forsyth. But Forsyth admittedly provides no details of how WAP or GSM message protocols relate to a Forum message (and indeed, no description of what information may be included in message packets) and, as such, Houh's explanation of "the ***wireless messaging functionality*** of ***GSM-SMS or WAP***" does not constitute "providing helpful context" to understand any teaching of Forsyth.

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

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

In Ground 2, Houh relies on Eck's disclosure of "PagerWorld" for limitation 1[B]/9[C] and throughout. *See* Ex.1003, ¶266. Despite admitting that Eck "uses the word 'PagerWorld' in the [Multiple User Dungeon (MUD)] title to reflect the communication means is paging," Houh concludes that "a POSITA would have understood that such a MUD is equally applicable when the communication means is another messaging type such as SMS or messaging via a WAP protocol." *Id.* But Houh provides no citation to any reference that supports, even remotely, his conclusion. The only support is his say-so.

Next, in the same paragraph, Houh concocts yet another conclusory argument—that PagerWorld is "persistent" and thus satisfies the construction of "application-based information channel." Houh states that PagerWorld includes a client software and a server software. *Id.* From this he concludes that "[a]s such, PagerWorld is persistent," and thus previously established, because "it remains in existence after individual users exit the world." *Id.* But beyond pointing to Eck's client-server architecture, Houh does not explain why or cite any evidence to support his position that Eck's PagerWorld is persistent.

Indeed, Houh's conclusion is patently false. Having client and server components does not mean an always-on or "persistent" service. Many portable-device applications (on game consoles or mobile devices) use a client/server model only ephemerally—the server runs only during an active session, then shuts down when the session ends. *See* Ex.2038.

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

b) Petitioners rely extensively on expert testimony

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

Importantly, as for the "wireless networking functionality" element in limitation 1[B], Petitioners rely exclusively on expert testimony to support an alternative argument. Petitioners argue "[t]he mobile device must further

encapsulate the generated Forums message into a protocol message (e.g., GSM-SMS or WAP) to be transmitted over wireless network." Petition, 38-39. Instead of citing Randall or Forsyth and offering analysis in the Petition, Petitioners cite ¶¶162-166 of Houh's testimony, which constitutes impermissible incorporation by reference. *Cisco Systems, Inc. v. C-Cation Techs.*, IPR2014-00454, Paper 12, 9 (P.T.A.B. Aug. 29, 2014) (informative) (providing that "practice of citing the Declaration to support conclusory statements that are not otherwise supported in the Petition also amounts to incorporation by reference"). Furthermore, Houh's declaration does not qualify as a prior art. *Meta Platforms*, IPR2023-01023, Paper 10, 31 (recognizing expert testimony as "***not qualif[ing] as prior art***").

Additionally, these paragraphs of Houh's declaration address references that are not in Petitioners' Ground 1. Ex.1003, ¶¶164-165 (discussing Ex.1015), ¶166 (referring to arguments made in §IV.A.1.c.(2) of the declaration with regard Ex.1014). Petitioners cannot rely—directly or indirectly through expert testimony—on references not asserted in Ground 1 to gap-fill a missing limitation in Randall and Forsyth. *See Meta Platforms, Inc.*, IPR2023-01023, Paper 10, 31 (disregarding exhibit not included in ground as "***not relied upon as the basis for this challenge***").

The reason Petitioners rely exclusively on Houh's say-so for this limitation is that, as acknowledged by Houh, "neither Randall nor Forsyth provides the details of the ***wireless messaging functionality*** of ***GSM-SMS or WAP***." Ex.1003, ¶163.

Similarly, Petitioners use Houh's statement of "what 'a POSITA would have understood'" and reference to the "Nokia 7650 wireless device" to fill gaps regarding the "media data captured by the mobile device." Petition, 24-25 citing Ex.1003, ¶¶115-120.

As to Ground 2, Petitioners again copy-paste, almost *verbatim*, conclusory statements from their expert declaration into the Petition to provide a motivation to combine and to support limitations missing from Pelkey and Eck. *See* Ex.2035, 18-36. Petitioners' sole basis for motivation to combine Pelkey and Eck is Houh's *ipse dixit* testimony which Petitioners copy verbatim from into the Petition. The only part of Houh's testimony that Petitioners omit is the portion that proves conclusively Houh's opinion is ***not*** based on the Ground 2 prior art references: "***But it [i.e., Pelkey] does not specifically disclose the integration of messaging and sharing content like photos and sound clips with other users within its client-server environment.***" Ex.1003, ¶247. Nevertheless, Petitioners gap-fill a missing limitation via conclusory expert testimony that motivation to combine exists. A "petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed.Cir.2016).

The Petition thus relies extensively on expert testimony that provides no

helpful context in understanding key aspects of the Petition. This factor weighs in favor of discretionarily denying institution.

5. The '544 Petition lacks merit

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

Finally, while Patent Owner addresses both Grounds, a showing that Petitioners have failed to meet their burden as to one Ground suffices to discretionarily deny institution as to both Grounds. *See Samsung Electronics Co. v. Kp Innovations 2 LLC*, IPR2025-00101, Paper 13, 27-28 (P.T.A.B May 12, 2025). In light of *SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 373 (2018), it would not be an efficient use of the Board's time and resources to institute review in such a case. *See*

Chevron Oronite Co. LLC v. Infineum USA L.P., IPR2018-00923, Paper 9, 10-11 (P.T.A.B. Nov. 7, 2018) (informative); *see also Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7, 41-43 (P.T.A.B. Jan. 24, 2019) (informative).

a) The Petition Fails to Show How Each of the Four Different Potential "First Interfaces" Meet the Remainder of the Claim Limitations

For Ground 1, the Petition identifies ***four*** potential "first interfaces" (1[A]/9[B]) but does not clearly explain how each of the four purported first interfaces permits designation of a "content item comprising media data from a mobile device" (1[A]/9[B]), how *that same content item* is integrated with information associated with a wireless networking functionality (1[B]/9[C]), how the *same integrated content item* is inserted into *the same channel* associated with each purported "first interface" (1[C]/9[D]), and how that same channel provides multiple users access to the same integrated content item (1[C]/9[D]). The Petition bounces between discussions of text messages (which Petitioners concede are *not* media data (Petition, 24)), photos, sounds, and image data, as explained below.

(1) The Petition Bounces Between Text, Photos, and Music Without Addressing How They Could Be Combined

For Ground 1, the Petition impermissibly mixes and matches disclosures from various Forsyth's embodiments: Scenario 1-Group based text messaging, Scenario 2-Discussion of Photos, and Scenario 4-A Digital Memento from a User's Birthday.

But Petitioners fail to explain how aspects of these embodiments may be properly combined. For example, when discussing the "content item comprising media data" term, Petitioners point to Scenario 1-Group based text messaging.[25] Petition, 24. Petitioners also point to Scenario 2-Discussion of Photos where a user "takes a few photographs" and sends them to the group. Petition, 24. Petitioners also point to Scenario 4-A Digital Memento from a User's Birthday where "[p]eople post MP3s of the kind of music played at each club." [26]

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[25] Petitioners' reliance on Scenario 1-Group based text messaging is incorrect because text messaging is not "media data," as Petitioners' themselves acknowledge. Petition, 24 ("describing media as encompassing 'a document, a video, a photo, a graphic, a music file, etc.").

[26] Petitioners' reliance on scenarios where content is not captured by the mobile device is fundamentally flawed. For example, in Scenario 2-Discussion of Photos the photos are not taken by the mobile device ("a user is on holiday, and he takes a few photographs of the beach ***with his digital camera***") and thus are not "captured by the mobile device." Likewise, in Scenario 4-A Digital Memento from a User's Birthday the pictures are taken with "digital cameras," not "captured by the mobile device. Petition, 25 (citing Forsyth, 9:5-35). And similarly, the music files from Scenario 4 are not "captured by the mobile device."

When discussing the "first interface" limitation of the claims, however, Petitioners point to Scenario 1-Group based text messaging. Petition, 28. The first interface, however, allows designation of the content item comprising media data, and as Petitioners' themselves acknowledge, Scenario 1-Group based text messaging does not contain media data. Petitioners acknowledge this deficiency but do nothing to fill the gap other than by citing to their expert's conclusory statement. Petition, 29.

Regarding the "insertion of captured content" requirement, Petitioners again point to Scenario 2-Discussion of Photos and Scenario 4-Digital Memento from a User's Birthday (Petition, 37), again even though neither of those scenarios involves media data "captured by a mobile device."

Regarding the "information associated with a wireless networking functionality," Petitioners point to Scenario 1-Group based text messaging and Scenario 3-Social Scheduling. Petition, 38-39. Regarding the "integrating the at least one content item and information … to generate at least one integrated content item," Petitioners again point to Scenario 1-Group based text messaging, even though this scenario does not include the required media data. Petition, 40.

"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 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).

b) 1[B]/9[C]: integrating one content item—that comprises media data—and information associated with at least one wireless networking functionality of the mobile device

The claims require integration of the media data captured by the mobile device (as the content item) with information associated with the wireless networking functionality. As described in the '578 Patent specification, one embodiment includes a "services integration server 39 [that] controls the integration of information associated with [the] wireless networking functionalities with the content…." Ex.1001, 10:1-4.

As an initial matter, when addressing the "integrating" limitations, Petitioners never identify any media data being integrated. *See* Petition, 24 (citing Ex.1001, 17:35-35) (identifying media as other than text message). Instead, Petitioners point to the generic text messaging of Forsyth Scenario 1 and Figure 7, without any reference to ***media data content***. Petition, 41 (citing Ex.1003, ¶172).

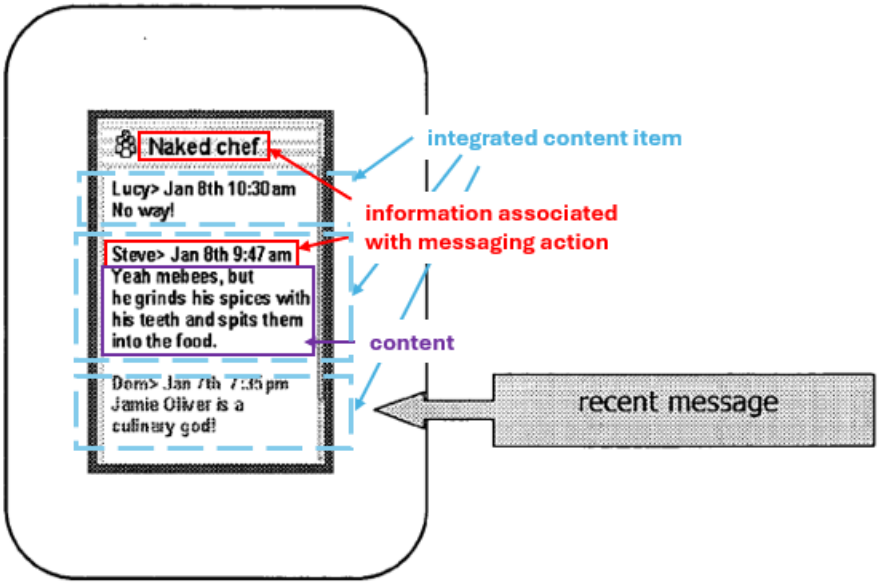
(1) Petitioners' Reliance on Sender/ Poster Name, Date/time, and Forum Name Fails

As discussed in §III.F.(4).a, Petitioners improperly rely on Houh's say-so for encapsulation of sender name, date/time, and Forum name as the "information associated with at least one wireless networking functionality," arguing the information is integrated with content as a single object in Forums. *See* Petition, 38-42. The argument is flawed for multiple additional reasons.

First, this information about the Forums message is, at best, information about the claimed content—not "information associated with … wireless networking functionality of ***the mobile device***." Petitioners contend an individual Forum created in Forums is the claimed "information channel." Petition, 20. Thus, information about the Forum's name or its participants is, at best, information about the claimed information channel—not "information associated with … wireless networking functionality of ***the mobile device***."

Second, contrary to Petitioners' argument, the ***display*** of such information with content does not teach an "integrated content item." Petitioners repeatedly point to Forsyth's Figure 7, the Scenario 1-group based text messaging interface. They argue because it shows sender "Steve" and Forum name "Naked Chef" along with a text message, the mobile device "must" have created a single message with it all. Petition, 38-39 (citing Ex.1003, ¶162). And Petitioners reproduce Houh's annotated Forsyth Figure 7 (reproduced below) supposedly showing a single, integrated object

with all such information. Petition, 41 (citing Ex.1003, ¶172). This does not teach the claimed integrated content item.



Forums—Forsyth, Figure 7 [Petitioners' annotated]

It clearly shows ***only text messages*** and not a "***content item comprising media data*** captured by the mobile device."

Notably, Petitioners focus on Figure 7 depicting content (text only) along with sender/poster name and date being "*presented* as a single 'integrated content item'" Petition, 41. But even assuming, *arguendo*, sender name, date/time, and Forum name are information associated with a wireless networking functionality of the mobile device, Petitioners provide no citations supporting such presentation of information necessarily requiring the claimed integration. Indeed, Forsyth makes the point—in Scenario 2, on which Petitioners rely—that there is "a separation between ***actual***

storage of data on the remote server, and ***presentation/access*** of that data (of which there could be many instances, for a given stored piece of information)." Forsyth, 7:44-48.

Looking at the claim as a whole, there is an order: Limitation 1[B]/9[C] recites creating an "integrated content item" from the content item and information associated with a wireless networking functionality, and limitation 1[C]/9[D] recites "inserting the …integrated content item" into the channel. That the information is displayed together says nothing of whether it was an integrated content item and inserted as such (e.g., as opposed to separate pieces of information).

c) Petitioners Fail to Identify a Basis to Combine Pelkey and Eck

Petitioners fail to identify any plausible motivation to combine the teachings of Pelkey and Eck. Petitioners merely state, without support, that a "POSITA would have been motivated to combine Eck's teachings regarding PagerWorld with the network and message server architecture taught in Pelkey." Petition, 59.

The holes in Petitioners' argument are particularly notable given their admissions as to the deficiencies of Pelkey and Eck, including:

(i) Eck does not describe a client-server structure as taught in Pelkey (Ex.1003, ¶246; Petition, 60);

(ii) Pelkey does not describe integration of messaging and sharing content like photos with multiple users (Ex.1003, ¶247; Petition, 58);

(iii) Pelkey does not describe any in-game messaging (Ex.1003, ¶247; Petition, 61); and

(iv) Pelkey does not disclose details of the wireless network used to provide wireless messaging from the game system to the server (Petition, 76; Ex.1003, ¶276).

Petitioners argue that a "POSITA would be motivated to apply the network and message server architecture in Pelkey to Eck in order to avoid the charge-based system for exchanging messages and photos via pager cartridge in Eck. (Ex.1003, ¶247.)" Petition, 60. This is contrary to the teaching of Eck, which solves any issue regarding "cost" with "user-generated custom libraries of words, phrases and graphics" to reduce message length. This practice is called "coding," which Eck expressly acknowledges can be used "to reduce message length" and thus "reduce message charges." Eck, 16:59-60; *see also* 16:49-63 ("It can be seen that by using 'coding', the length of the messages may be reduced."). Also, Petitioners and their expert fail to address the additional costs of the proposed modification (e.g., communication and bandwidth costs of the proposed network and message server architecture) or the specific savings that would motivate the combination or prompt a switch to GSM-SMS or WAP. *See In re Schmidt*, 892 F.2d 1051, *2 (Fed.Cir.1989) ("[W]hile we agree that cost saving may serve as a motive for making

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

Petitioners continue that "a POSITA would be motivated to modify the 'pager cartridge' in Eck as necessary to use PagerWorld in Pelkey given the disclosed benefits of PagerWorld including 'exploration and adventure,' 'chat and community interaction,' and 'character growth.'" Petition, 60-61 (citing Ex.1003, ¶247; Eck, 10:13-19). The statement is nonsensical: it admits that Eck, through its pager cartridge, already provides the benefits of 'exploration and adventure,' 'chat and community interaction,' and 'character growth,' so why would its structure and operation need to change? *See* Eck, 10:1-19. Petitioners do not answer this question. Instead, the statement highlights their use of impermissible hindsight.

Finally, Petitioners parrot their expert's conclusory opinions regarding "[r]eplacing the pager system infrastructure system in Eck with the client-server architecture in Pelkey is the simple substitution of one known element for another to achieve a predictable result (internet-based functionality)." Petition, 61 citing Ex.1003, ¶247. But Houh never explains what those modifications would be given differences in operation and architecture and provides no explanation of how a pager cartridge could be replaced with a hypothetical "GSM-SMS or WAP cartridge."

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 '544 IPR on *Fintiv* grounds.

IV. CONCLUSION

Analyses under the CTPG framework for parallel petitions and *Fintiv* independently favor denying institution of the '544 IPR.

Date: June 16, 2025

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), the undersigned hereby certifies that the foregoing Patent Owner's Discretionary Denial Brief contains 13,992 words using the word count feature of Microsoft Word.

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