

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.

Petitioner,

v.

TJTM TECHNOLOGIES, LLC,

Patent Owner.

Case IPR2025-00586

Patent No. 8,958,853

PATENT OWNER'S PRELIMINARY RESPONSE

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I. Introduction

In parallel with a pending Request for Discretionary Dismissal filed May 2, 2025, TJTM Technologies LLC, a small entity, hereby submits Patent Owner's Preliminary Response. We request that the PTAB deny institution of the IPR. We Director also will review this POPR when she decides whether to conserve PTAB resources by dismissing this Petition, both because the District Court invalidated every claim subject to the Petition and because of settled expectations more than 10 years after the '853 Patent issued. *See, Hulu LLC v. Piranha Media Distribution, LLC*, IPR2024-01253, Paper 22 (Director Apr. 17, 2025) (informative); *Samsung Electronics Co., Ltd., et al. v. Sinotechnix LLC*, IPR2025-00331, paper 15 (Director's delegee July 2, 2025) (routine). We are confident that the PTAB will deny institution, should the Director not dismiss. The most efficient path is for the Director to dismiss based on *Hulu* or *iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, IPR2025-00353 *et al.*, paper 10 (Director June 6, 2025) (routine decision granting discretionary denial), thereby saving the PTAB from going over these materials a second time.

In the Request for Discretionary Dismissal, we emphasized that the district court to found every claim to be invalid under 35 U.S.C. § 101. After May 2, a PTAB panel applied *Hulu* via an order to show cause, as the time had passed in

which to request discretionary dismissal. *See, Shopify Inc. v. DKR Consulting LLC*, IPR 2025-00132, paper 10, at 2-3 (PTAB May 29, 2024) (OSC; routine decision).

The Director has repeatedly applied the reasoning in *Hulu* to dismiss petitions.

Since May 2, multiple decisions have formulated the settled expectations consideration, including *Samsung Electronics Co., Ltd., supra*, paper 15 on July 2, 2025, in which expectations were considered settled and dismissal was entered because the challenged patents had “been in force for more than 10 years, creating strong settled expectations”. The ‘853 Patent issued February 17, 2015 and was in force more than 10 years before filing of this IPR Petition. Since the settled expectations consideration emerged after filing of the Request for Discretionary Dismissal, we discuss it in this submission.

This POPR addresses *Fintiv* factors, especially factor six: the merits of the IPR. On the merits, the primary reference Cazan was selectively quoted and not fairly described in the Petition and accompanying Declaration of Houh, Ex. 1002. In fact, Cazan does not include an enabling disclosure or even a written description of some of the elements for which it is cited. Addressing the secondary reference, Frye never teaches suppression of incoming phone calls, which are passed to a telematics unit for legal, hands free communications. The technical connection between Cazan and Frye, involving OnStar® telematics, is not mentioned in the Petition, the Declaration, or even the Opposition to Dismissal,

which was filed after the Patent Owner raised the issue in the Request of Discretionary Dismissal. The OnStar® telematics connection relates to the extent of hindsight on which the Petition must rely to select a feature buried in Frye [0134] for combination with Cazanans, in an effort to produce the opposite result that Frye discloses at length. Patent Owner's position is that the Petition uses hindsight to select an obscure feature and, then, to extend suppression of text messages to suppression of incoming calls, instead of selecting combination the telematic features taught and emphasized by Frye to enable legal, hands-free calls when the cell phone is in a restricted position, within close proximity to a cheap RFID tag. Viewing the reference as a whole, legal, hands-free calling dominates Frye's teaching. Even the apparent hindsight cannot overcome the lack of support for certain features for which the Petition relies on Cazanans and Frye.

On the merits and on weighing of the *Fintiv* factors, the IPR should not be instituted.

II. Background and Timeline

The '853 Patent issued in on February 17, 2015 from a continuation of application no. 14/176,107 filed February 9, 2014, which claimed priority to U.S. Provisional Application No. 61/835,234 filed June 14, 2013.

Patent Owner filed an enforcement action on March 7, 2024 against Petitioner. Petitioner filed this IPR petition on March 5, 2025, on the eve of the one-year anniversary of the enforcement action, and months after the District Court ruled that all claims were invalid under § 101.

In the District Court, Petitioner moved to dismiss under Rule 12(b)(6), asserting that the claims challenged in this proceeding are invalid as reciting ineligible subject matter under § 101. The District Court agreed with Petitioner and dismissed Patent Owner's infringement claim with prejudice on October 22, 2024. *Ex. 1018, Docket Order*. Patent Owner appealed and briefing concluded on May 16, 2025.

Patent Owner filed a Request for Discretionary Dismissal on May 2. Based on *Hulu*, we urged that because the patent claims were invalidated by the District Court, it is unnecessary to institute another proceeding to review the same claims for patentability on other grounds. Petitioner submitted a request to file a motion for stay the IPR briefing in an email dated May 19, which Patent Owner opposed

in an email dated May 20. The Director denied leave to file a motion in an email dated May 22.

Petitioner filed its Opposition to Discretionary Dismissal five weeks ahead of its deadline, on June 6. Undaunted by denial of leave to file a motion, Petitioner repeated its request for a stay in an email dated June 13, without seeking leave to file a motion. The Director requested a response from Patent Owner, which we submitted by the next day on June 18. The Director has not yet responded to the June emails. The thread of emails from May and June is submitted as Ex. 2001.

III. The Director Should Again Rule that a District Court Final Judgment of Invalidity of all Claims Favors Dismissal Under Hulu. The Board should Deny Institution of an IPR on the Merits.

“The Director is permitted, but never compelled, to institute an IPR.” *Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1382 (Fed. Cir. 2021).

A. *The Merits May be Secondary to the District Court’s Dismissal of all Claims under Section 101.*

The Director’s informative *Hulu* decision, the Board’s precedential *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) and the *Fintiv* decision all favor dismissal under circumstances when all of the claims challenged by the IPR petition have

been invalidated by the District Court. The *Hulu* decision became informative after the Request for Discretionary Dismissal was filed and has been followed. In *Hulu*, the Director ruled:

*[T]he Fintiv framework does not fit neatly with the circumstances of this case, where the district court already had determined that the challenged claims are invalid under § 101 before the Board's Decision. Nevertheless, the Fintiv framework emphasizes efficiency concerns, and Fintiv encourages the parties to explain the impact of other facts and circumstances that exist in their proceeding on efficiency and integrity of the patent system. Fintiv, Paper 11 at 16. Here, as explained above, **where a district court already has found the challenged claims invalid, the efficiency and integrity of the patent system is best served by denying institution.***

Hulu, Paper 22, at 3. Under this ruling, the District Court's invalidation of the claims should lead to dismissal of the IPR petition.

B. *The Fintiv Factors Support Denial, following the Board's Initial Reasoning in AviaGames.*

The reasoning on the *Fintiv* factors from paper 12 in *AviaGames, Inc., v. Skillz Platform Inc.*, IPR2022-00530, Paper 12 (PTAB Aug. 9, 2022) (routine decision denying institution where district court had found claims invalid under § 101), *remanded*, Paper 14 (Dir. Mar. 2, 2023), *denial reinstated*, Paper 15 (PTAB Mar. 22, 2023) (routine decision), reaches the same outcome as the Director's *Hulu*

decision. The PTAB panel’s routine decision discussed all six factors in light of the District Court’s dismissal, not just the overriding impact of the District Court’s dismissal of all claims. The *Fintiv* analysis in *AviaGames* provides a counterpoint to Petitioner’s briefing, which did not mention *AviaGames* even after it was raised in the Request of Discretionary Dismissal.

Factor 1: “the district court case cannot be stayed because it has concluded.”
E.g., AviaGames, Paper 12, at 23.

Factor 2: “the District Court has completed its consideration of the [’853] patent,” so “this factor weighs heavily in favor of denying institution.”
AviaGames, Paper 12, at 12-13.

Factor 3: favors denial “if, at the time of the institution decision, the District Court has issued substantive orders related to the patent.” *Fintiv*, 9-10. The § 101 “invalidity determination is a substantive order related to the [’853] patent,” so “this factor weighs in favor of denying institution.” *AviaGames*, Paper 12, at 13.

Factor 4: Here, “all... of the claims challenged in the petition are also at issue in district court,” *Fintiv*, 12-13. Here, even more than in *AviaGames*, where only *some* challenged claims were invalidated, “this factor favors discretionarily denying institution,” because all of the challenged claims were invalidated.
AviaGames, Paper 12, at 14.

Factor 5: The petitioner and the defendant in the parallel proceeding are the same party. So this factor, too, weighs in favor of discretionary denial. *Ibid.*

Factor 6: Petitioner did not address the strength of seven out of eight grounds asserted in the IPR petition. *AviaGames*, Paper 12, at 15. (The section below addresses the merits.)

Again, *Hulu* did not find it necessary to address factor 6 or even any of factors 1-6 in reaching the conclusion that efficiency favored dismissal of the IPR petition, because the claims stood invalid under section 101. We have provided the *AviaGames* reasoning as a counterpoint to Petitioner's Opposition briefing, which did not mention *AviaGames* even after it was raised in the Request of Discretionary Dismissal.

The Petitioner seeks to distinguish *Hulu* by filing a *Sotera* stipulation. Given Google's capability of finding additional prior art, other than *Cazanas* and *Frye*, the *Sotera* stipulation is unlikely to mean that Google would not assert invalidity under section 103 in District Court, if it lost an IPR challenge based on just two references. After all, the Google provides the primary tools available for searching for prior art, including Google Patents, Google Scholar, and Google Search with AI. Petitioner's team would just try harder to find new art that it didn't have on March 5 when it filed the IPR petition, in order to avoid the *Sotera* stipulation.

C. *The Merits Further Support Denial of Institution.*

The Board's April 17, 2025 fireside chat regarding the new procedure indicated that the merits should be addressed in the context of Factor 6. Our discussion of the merits follows. What follows should be considered to **supplant the discussion of the merits in our Request for Discretionary Dismissal filed on May 2**. This filing corrects some minor errors in the prior filing.

The Petition relies most heavily on Cazan U.S. Pat. No. 8,275,351 (Ex. 1004) and secondarily on Frye U.S. Pub. 2012/0282906 (Ex. 1005). The evidence cited from these references does not give rise to a reasonable likelihood that the independent claims of U.S. Patent No. 8,958,853 (Ex. 1001) would be invalidated, so no IPR should be instituted.

The interface and suppression elements of claim 1 that are missing from the cited references include:

[1d] a memory controlled by the processor, the memory including instructions that when executed by the processor cause the processor to perform the steps of:

[1e] providing a graphical user interface through which a user customizes one or more functions of the mobile device when placed in an inactive mode; [e.g., FIGs. 4-6]

[1f] receiving a user selection to automatically initiate the inactive mode in response to the pairing of the mobile device with a vehicle; [see, e.g., Col. 7, lines 58-60, referring to FIG. 4d GUI]

[1g] receiving a user selection of an away message to use when the mobile device is in inactive mode; [see, e.g., FIGs. 5a-5d, GUIs for message selection]

[1h] in response to the pairing of the mobile device and the vehicle, automatically initiating a process to place the mobile device in inactive mode; ... and

[1j] suppressing one or more sound, visual, or vibration communication cues that would have accompanied the communication had the mobile device not been in inactive mode.

(The element numbering is adopted from the Petition for ease of reference.

Numbering is not part of the issued '853 Patent claims. References to illustrative GUI figures are added.)

The evidence cited in the Petition must be viewed from the perspective of one of ordinary skill in the art, who would recognize that both cited references disclose interaction between a cell phone and a built in “telematics unit.” The secondary Frye reference further requires an RFID tag at a predetermined location in a vehicle. Both references use the built-in cellular capabilities of GM’s OnStar® as the example of a “telematics unit.” Cazanias is assigned to a parent of Verizon. It gives OnStar® as its only example of a telematics unit, at col. 5:17. It refers to the telematics unit 13 times and notes that a telematics unit traditionally provides road side assistance. *Id.*, at col. 5: 7. Secondary reference Frye is assigned to General Motors, which builds OnStar® into its vehicles. Frye refers to the telematics unit

254 times. In the absence of hindsight, combining GM's improvement on OnStar®, with Cazanias teaches a person of skill in the art to rely on a built-in telematics unit. Adding Frye to Cazanias would reinforce the role of OnStar® or a similar telematics unit, which dominates Frye. The Petitioner's Opposition to Dismissal did not respond to this analysis and does not even acknowledge reference to OnStar® in both cited references. *See, e.g.,* Opposition, at 22-24. Neither the Petition nor Declaration of Houh mentioned OnStar® or that the secondary reference is assigned to General Motors.

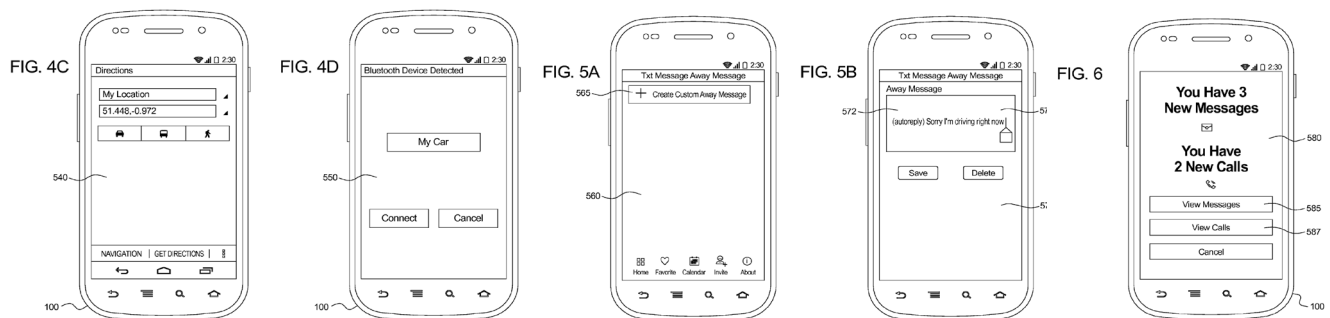
Interface Missing from Cazanias

The primary Cazanias reference only mentions the possibility of a configuration interface in passing and never mentions suppressing distracting rings and beeps. No interface is claimed and no interface is given a written description or enabling disclosure, beyond dialing digits to select among listed options. Cazanias col. 11:43-45. Suppression of communication cues is not mentioned as a technical problem or as a feature of Cazanias. *See, Decl. Houh, Ex. 1002, ¶ 86* (acknowledging that Cazanias does not disclose suppressing rings and beeps).

The interface elements [1d]-[1g] of the challenged claims, which are illustrated in figures and explained in text, include providing a graphical user interface to customize an inactive mode and receiving a user selection to initiate the inactive mode upon pairing with a vehicle. In contrast, Cazanias' claims make

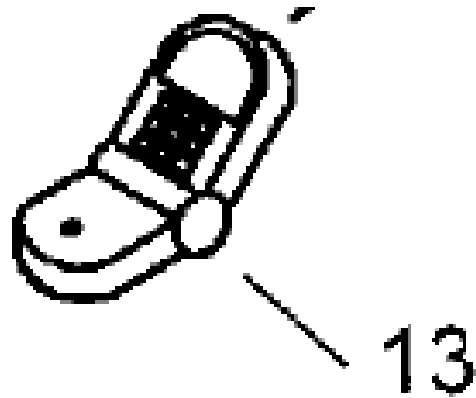
no mention of an interface, so there is no presumption that Cazanias provides an enabling disclosure. At most, buried in Cazanias' dependent claims 7, 15 and 24 there is reference to "receiving an input of the response messaging service message from an end-user of the mobile station". Claim 7, col. 16:20. There is no illustration or detailed description of Cazanias' dialing digits to select from a displayed menu, just those few words in three lines of Cazanias col. 11:43-45. A "stylus and touch sensitive screen" are mentioned at 11:55-56, without any details of an interface, other than the displayed menu in 11:43-45.

The challenged Patent illustrates a graphical user interface in figures 4A, 4B, 4C, 4D, 5A, 5B, 5C, 5D and 6 and describes the GUI operation at column 8. In these figures and accompanying narrative, the '853 Patent provides a written



description and enabling disclosure of a graphical user interface.

In contrast, Cazanias FIG. 1 illustrates a flip phone 13 with a 12-key keypad (only showing 9 keys, but understood to include 12 keys), as reproduced here. The label for 13 is “mobile station”, which also is applied to the telematics unit 16. Col. 5:3-5. Cazanias’ block diagram FIG. 2 is consistent with flip phone 13.



One cannot see the numbered choices menu in Cazanias’ FIG. 1, but those who used flip phones in 2010, when Cazanias was filed, will recall menus with numbered choices selected by dialing digits. A menu structure responsive to dialing digits is mentioned in Cazanias col. 11:43-45. Cazanias’ most detailed disclosure of the mobile station 13 interface is in column 11:33-55, which is partially quoted, beginning after the bold-faced sentence below, in the Petition, at 34-35, the Declaration, ¶ 87, and the Opposition, at 22. The whole paragraph, 11:33-56, including the sentence that Petitioner omitted, reads:

As shown, the digital telephone handset 13 includes a display 56 for displaying messages, menus or the like, call related information dialed by the user, calling party numbers, incoming messaging service messages, and other information. Also, the display is used to input information such as a response message or to configure the DNDA 15. If the mobile station executes location-based service Patents, the display 56 may provide other information regarding the determined location and/or surrounding areas, e.g. LAT/LON

data, a rate of travel of the mobile station 13, and other information. A keypad 58 enables dialing digits for voice and/or data calls and generating selection inputs keyed by the user based on any displayed menu. The display 56 and keypad 58 are the physical elements providing a textual or graphical user interface. In addition to normal telephone related input/output, these elements are also used for display of menus and other information to the user and user input of selections. For example, these elements can be used to input information related to the response message or to configure other parameters of the DNDA 15. Of course, other user interface elements may be used, such as a stylus and touch sensitive display screen, as in a PDA or mobile smartphone.

Cazanas, Ex-1004, col. 11:33-55. Despite our criticism of the Petition and Decl. Houh Ex. 1002 for omitting the bold-faced sentence above, the Opposition to Dismissal, at 22-24, cites the whole paragraph but begins quoting the paragraph after the bold-faced sentence. In response to the Opposition, we acknowledge that Cazanas refers to dialing digits instead of a numeric interface, teaching that “**A keypad 58 enables dialing digits for ... generating selection inputs keyed by the user based on any displayed menu.**”

No further disclosure of an interface is provided by Cazanas. Reference in lines 43-45 to dialing digits, using what is shown in FIG. 1 as 9 keys on a flip phone, to “generate selection inputs” or “configure other parameters” is not a written description or enabling disclosure of what we claim. Arguing that using

digits to select inputs from a displayed menu should be considered “graphical” is no substitute for a written description or enabling disclosure of what we illustrate and positively claim. Passing mention of an alternative interface with “a stylus and touch sensitive display screen, such as a PDA or mobile smartphone” at the end of the paragraph is not enough to teach what is, illustrated, described, and claimed in the challenged ‘853 Patent.

Four words (col. 11:54-55) and a picture of a flip phone 13 with 9 keys (FIG. 1) is not enough teaching, enablement or written description to render obvious our well-illustrated graphical user interfaces, with positively claimed functions. Even though the iPhone had reached version 4 by 2010, Cazanias made no effort to show that he, as an inventor, was possessed of the claimed graphical user interface. If the inventor had had our invention in mind, he would have disclosed it, but he didn’t. He just mentioned a stylus and touch sensitive screen. An expert’s opinion cannot overcome the deficiency of the reference.

The Houh declaration, Ex. 1002 expertly glosses over the graphical user interface deficiency of Cazanias with phrases such as “use a graphical user interface of the mobile device ... in this manner as well.” Houh Decl., ¶ 88. The expert’s diversionary argument is that the user could invoke a web browser running on the flip phone to access My-Verizon and configure the cell phone app using the web site from the flip phone. Houh, ¶ 88. This is not taught by Cazanias and is

implausible for the flip phone illustrated. The Petition, at 36, cites this conclusory expert argument without citing any passage from Cazanias for running a browser on the flip phone 13. The Opposition gives no excuse for the expert selectively quoting from col. 11:33-55.

There is no argument in the IPR that Frye teaches the claimed GUI. The Opposition, at 34, confirms that Petitioner does not rely on Frye for a graphical user interface, referring to claim element 1[e]. Neither the Overview of Frye (Petition, at 13-14), nor the discussion of element [1e] (Petition, at 24-26) describe a GUI on Frye's cell phone. Instead, Frye's OnStar® interface is built into the dashboard. *See*, Frye ¶ 0084; *also*, ¶ 0061.

Suppression Missing from Cazanias

There is no mention in Cazanias of either the problem of distracting phone rings or buzzes or the claimed solution of “suppressing one or more sound, visual, or vibration communication cues”. Houh's declaration, *infra*, ¶ 86, concedes as much. Instead, Cazanias' background focuses on compliance with new laws that prohibit hand-held use of mobile phone for calls or text messages while driving. Suppression of cues was not among requirements described in either Cazanias or Frye to satisfy those laws. Providing Cazanias' automated responses does not inherently require the positively claimed suppression of communication cues.

The challenged Patent describes an inactive mode suppressing notifications as follows:

A user may enable an inactive mode of the device to suppress notification of incoming phone calls, text, emails, etc. and automatically notify the sender with an away message. By suppressing the communications distracted driving may be reduced. One drawback, however, is that senders may feel upset that they are not being answered when the sender is expecting the user to reply. Thus, in order to reassure senders that they will receive a response at the earliest convenient opportunity, the mobile device permits the user to send an away message upon receipt of a communication.

‘853 Patent, Summary, Ex. 1001. In contrast, there is no written or enabling description in Cazanias of a graphical user interface on the mobile device that controls “suppressing one or more sound, visual, or vibration communication cues”. Cazanias does not use the word “suppress*” or any synonym in its disclosure.

The Opposition to Dismissal, at 25, finds it “hard to imagine” how a DNDA could notify a user of incoming calls, without allowing the user to answer the calls, and still increase safety. This is a faint effort to invoke inherency, to substitute something argued to be inevitable for what actually is disclosed. Inherency fails, as a matter of law, because hearing a phone ring, continuing our drive, and knowing

to pick up the phone to see who called after we stop is a common experience.

Registering that someone called, without picking up or looking at the phone, is not hard to image or unusual. It is safer than picking up the phone and holding it to your ear.

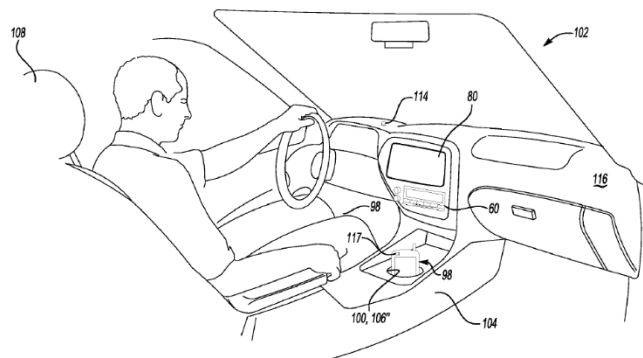
Thus, suppression of phone call notifications is missing from Cazanaz.

Suppression Missing from Any Combination Without Hindsight

Frye, Ex. 1005, does not teach suppressing notification of incoming calls, as the cited passage [0134] is part of Frye's disclosure of text-to-speech reading to a driver of incoming text messages [0135] and enabling audible responses to text messages. Phone call handling is described at [0044], as "voice communications [phone calls] received at the mobile device 98 are transmitted to the user hands-free via the telematics unit 14." Frye's primary teaching is legal and safe hands-free calling. Suppression of text message notifications in [0134] ("restrict the message notification ... of an incoming text message") and in [0136] ("text messaging features are completely deactivated") is an alternative to the disclosed, "Utilizing a text-to-speech program that is executable by the processor 36 of the telematic unit 14, the text context of the message is converted into an audible format. In response to a prompt, the user may elect to listen to the audible form of the message." [0135]. None of the Petition, Declaration, or Opposition acknowledge that Frye does not teach suppression of incoming phone calls.

Reading the Petitioner's submissions without closely studying Frye would lead to the mistaken impression that Frye teaches suppression of incoming calls.

The arrangement in Frye enables legal hands-free calls [0044] and hands-free listening and responding to text messages. [0135]. Pairing of the cell phone 98 with the telematic unit does not trigger adjusting of the mobile



device's operational mode. (Frye does not use the term inactive mode.) Instead, proximity of the cell phone to an RFID device 100, detected by detector 106, is the trigger. Frye ¶¶ 0123, 0134. This RFID trigger is confirmed by Petitioner's expert. Houh, ¶¶ 0144, 0149. RFID tags are dumb devices that cannot "pair" with receivers in the manner that Bluetooth devices do. Frye expressly distinguishes between the phone 98 detecting the RFID tag in the cup holder and the phone pairing with OnStar®.

Preferably, Frye's RFID connection is combined with speed sensing 706 by the telematic unit 14 which "ultimately activates" adjusted functionality. Frye ¶¶ 0060, 0124. (Interaction with RFID tags also was discussed in U.S. Pub. 2011/0039581 Cai assigned to Nokia, which the Examiner applied during prosecution.) Frye teaches a complex interaction among the mobile device 98, the

telematics unit 14 and the RFID tag 117, mediated by the RFID reader/detector 106. Frye uses variations on “detect” 70 times, and uses “RFID connection” 72 times. Frye teaches features triggered by interaction between the cell phone and RFID tag, not pairing with the vehicle’s telematics unit. Frye teaches obnoxious alerts triggered by pairing with the vehicle’s telematics unit, forcing the user to place the cell phone next to the RFID tag, as further explained below.

Hindsight is a major problem in the Petition’s proposed combination of references. The law requires Petitioner to explain why a secondary feature for suppressing notification of incoming text messages (not telephone calls), in Frye paragraph [0134] would be selected from all of the features in Frye by a person skilled in the art who has Cazanias and Frye in hand but no knowledge of our claim language, and why this feature modified from suppressing text messages to suppressing phone calls. The Petition and Opposition to Dismissal both fail to acknowledge the legal principle from *Application of Shuman*, 361 F.2d 1008, 1011 (CCPA 1966), *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1141, 227 U.S.P.Q. (BNA) 543, 550 (Fed. Cir. 1985), and other cases that bars selecting an obscure feature from a secondary reference and bars ignoring the secondary reference as a whole, including teaching away from the proposed combination..

None of the four “motivations” in the Petition, at 50-53, referred to in the Opposition, at 26, address why a person skilled in the art would zero in on [0134]

or even notice the option to silence text messaging after placing a cell phone near an RFID tag that enabled legal, hands free calling while driving. Frye, [0044].

None of the motivations explain why a person skilled in the art would ignore how Frye handles incoming calls and modify an option for handling of text messages, because Petitioner's submissions all fail to acknowledge that [0134] only applies to text messages, not to phone calls.

The first motivation, from Cazanas, col. 4:5-7, is increased safety. Using the hands-free talking illustrated in FIG. 5, reproduced above, increases safety over illegal, hand-held cell phone usage while driving. The first motivation would lead a skilled person to use Frye's overall teaching and would not drive a search for the option in [0149]. Nor would the first motivation lead a skilled person to ignore Frye's overall teaching and handling of incoming calls [0044], to extend suppression in [0134] from text messages to phone calls. The Petitioner never even argues that the first motivation would lead a skilled person to modify the option of suppressing text messages mentioned in [0134].

The second motivation, from Frye [0018], needs to be understood in view of the topic sentence of paragraph [0134] and Frye's disclosure, as a whole. The topic sentence concludes, "distractions that may be associated with use of the mobile device in a **non-hands-free manner** are reduced or even eliminated." (Emphasis added). Frye teaches interacting with both phone calls [0044] and text messages

[0135] in a hands-free manner that Frye considers to increase driving safety. The Petitioner never even argues that the second motivation would lead a skilled person to modify Frye's option for suppression of text messages so that it would apply to phone calls.

The third motivation is for incorporating "Frye's suppression functionality", without acknowledging that his functionality in [0134] is limited to suppressing text messages. The third motivation mentions the manually set or timed "Do Not Disturb" mode, which we typically set when we sleep at night and manually set when we cannot be disturbed. The DND ring suppression is a separate feature that is not automatically invoked in any art of record when a driver starts a journey. The DND set for sleep hours or manually to prevent an interruption does not motivate a skilled person to select Frye' suppression of text message notifications [0134] for combination with Cazanias or to modify suppression of text message notifications to suppression of phone calls when a driver starts a journey. The DND feature is orthogonal to our claims and unlikely to have been overlooked by the examiner.

The fourth motivation does not extend to suppression of calls, only to running a program on a mobile device using instructions stored in memory. Thus, none of the four motivations explain either selection or modification of text

message announcement suppression to override the thrust of Frye, which is enabling safe, hands-free driver interaction with calls and messages.

A person of ordinary skill in the art, unaided by our claim language, would be motivated to combine Frye, the secondary reference, with Cazanias, to satisfy new mobile phone laws by implementing hands free calling and interaction with calls and text messages. The combination that implements Frye's teachings, taken as a whole, allows a driver to talk on the phone and to receive and reply to SMS messages legally, hands free, while driving. This is contrary to the challenged claims, which prevent the driver from being interrupted by notifications of incoming phone calls.

A person of ordinary skill in the art, in the absence of our claims, also would combine the RFID tag in GM's secondary reference with Verizon's primary reference. In addition to emphasizing reliance on the telematics unit, Frye forces positioning of a phone near an RFID chip at a predefined location in a car. In Frye, pairing of the telematics unit with the phone positioned away from the RFID chip triggers flashing lights, beeping the driver, scrambling the currently playing audio (e.g. music, news radio, ...) and other means to get the driver's attention. Frye, ¶¶ 0057, 0061-62, 0092-93, 0159. Frye's app is intended to irritate and distract users, if necessary, to force a user to position the phone next to the RFID chip. This is contrary to the claimed result of pairing. Once the phone is near the RFID chip,

Frye's app encourages hands-free communication while driving, as the mode preferred to suppressing hands-free calls or messaging.

Therefore, the argued combination of Cazanas with Frye mistakenly depends on hindsight. The skilled person's combination of Cazanas and Frye, *sans* hindsight, without knowledge of our claims, would rely on a telematics unit and an RFID tag and to enable ringing and hands-free operation of cell phones in compliance with laws that were new and emerging at the time, laws which were discussed in both references.

On the merits, *Fintiv* Factor 6 strongly weighs against institution.

IV. Passage of More than 10 Years from Issuance of the Patent to Filing of the IPR Petition Favors Dismissal of the Petition, Following *iRhythm*, *Dabico*, *Samsung* and Numerous Decisions by the Director After Filing of our Request of Discretionary Dismissal.

Since May 2, there have been multiple decisions applying a settled expectations consideration, including *Samsung Electronics Co., Ltd., et al. v. Sinotechnix LLC*, IPR2025-00331, paper 15 (Director's delegatee July 2, 2025) (routine decision granting discretionary denial), in which expectations were considered settled and dismissal was entered because the challenged patents had "been in force for more than 10 years, creating strong settled expectations". *See*,

also, Dabico Airport Sols. v. AXA Power ApS, IPR2025-00408, paper 21 (Director June 18, 2025) (routine decision granting discretionary denial); *iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, IPR2025-00353 *et al.*, paper 10 (Director June 6, 2025) (routine decision granting discretionary denial). The challenged patent, Ex. 1001 issued February 17, 2015 and was in force more than 10 years before filing of the IPR Petition. Since this consideration emerged after we filed our Request for Discretionary Dismissal, it is appropriate to discuss in this paper, following up on the email of June 18 that the Director's team requested. Ex. 2001.

This Director's decisions regarding settled expectations counsel a different perspective on repeated patent assertion over a course of years than argued by Petitioner. In *iRhythm, supra*, at 3, the Director highlighted years of awareness of the patent before assertion against the petitioner. The Director found that awareness without filing a request for IPR for years settled expectations of the patent owner and favored discretionary dismissal. The Director granted the request for discretionary denial. In *Dabico, supra*, the time period that gave rise to settled expectations was 10 years, similar to the time since Bovis' '853 Patent issued on February 17, 2015. Here, Google has actually been aware of Bovis' patent since at least 2018, when United Patents filed the first request for IPR, which was not instituted. Google was a founding member of United Patents. Decker (Oct. 14, 2013) *Google, NetApp Sidestep Courts to Combat Patent Claims*, at

<https://www.bloomberg.com/news/articles/2013-10-14/google-to-netapp-sidestep-courts-to-combat-patent-claims>. Google undoubtedly subscribes to newsletters and press releases by United Patents. *See, e.g.,* <https://www.unifiedpatents.com/insights/2018/12/18/smtm-technology-patent-challenged-as-likely-invalid>. Even if Google wasn't aware of the inventor's assertion of this patent against Microsoft or Apple cell phones, Google was aware by 2018 of the likelihood that Google phone infringed Bovis' patent. Not only did Petitioner postpone filing the follow-on IPR for many years, it waited 363 days after assertion, to nearly the last possible day, to request an IPR. Moreover, in *Dabico, supra*, the Director indicated that actual awareness need not be shown. Following the Director's rationale in *iRhythm*, *Dabico*, and *Samsung*, provides an additional, new basis for discretionary dismissal.

V. Conclusion

To sum up, the Director should adopt the same approach as in the Director's recent *Hulu* decision that when parallel court proceedings have already reached an appealable final judgment that the claims are invalid, efficiency requires non-institution and dismissal of the IPR petition. The Director also should follow the settled expectations analysis in *iRhythm* and *Dabico*, to conclude that dismissal would be efficient and fair.

The Board should deny institution because the cited references do not give rise to a reasonable likelihood that the independent claims of U.S. Patent No. 8,958,853 (Ex. 1001) would be invalidated. The Board should determine that no IPR should be instituted.

Respectfully submitted,

Date: July 15, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents, together with all exhibits filed therewith, were served by electronic service, by consent between the parties (Pet. at 7), on the date signed below:

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** contains 5,885 words, excluding the caption, table of contents, and table of authorities, according to the word processing program used to prepare it.

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