

From: [Director Discretionary Decision](#)
To: [Mark J. DeBoy](#); [Wichman, Adam R.](#); [Director Discretionary Decision](#); [Trials](#)
Cc: [Patrick Finnan](#); [Larry Shatzer](#); [PTAB Adam Wichman](#); [PTAB Rich Giunta](#); [PTAB Greg Nieberg](#); [PTAB Mike Rader](#); [PTAB Michele Moresco](#); [PTAB Michael Parsons](#)
Subject: RE: Inter Partes Reviews IPR2025-00928 and IPR2025-00929
Date: Monday, October 20, 2025 11:46:33 AM
Attachments: [image002.png](#)
[image003.png](#)

Patent Owner is authorized to file a 5-page reply in IPR2025-00928 and IPR2025-00929 due no later than Friday, October 24, 2025, limited to addressing the arguments raised below in Petitioner's request for rehearing.

From: Mark J. DeBoy <mdeboy@esfip.com>
Sent: Friday, October 17, 2025 12:19 PM
To: Wichman, Adam R. <Adam.Wichman@WolfGreenfield.com>; [Director_Discretionary_Decision](#) <[Director_Discretionary_Decision@uspto.gov](#)>; [Trials](#) <[Trials@USPTO.GOV](#)>
Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>; PTAB Adam Wichman <AWichman-PTAB@WolfGreenfield.com>; PTAB Rich Giunta <RGiunta-PTAB@WolfGreenfield.com>; PTAB Greg Nieberg <GNieberg-PTAB@WolfGreenfield.com>; PTAB Mike Rader <MRader-PTAB@WolfGreenfield.com>; PTAB Michele Moresco <mmoresco-ptab@WolfGreenfield.com>; PTAB Michael Parsons <MParsons-PTAB@WolfGreenfield.com>
Subject: Inter Partes Reviews IPR2025-00928 and IPR2025-00929

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Your Honors,

Patent Owner, Fractus S.A. requests a conference call to discuss good cause to submit responses to the Requests for Rehearing submitted by the Petitioner in inter partes reviews IPR2025-00928 and IPR2025-00929. Specifically, Patent Owner believes good cause exists for a short five page reply to address:

- Petitioner's interpretation of the Director's Discretionary Denial Decision as discussed in Section II of the Requests for Rehearing, and
- Compliance of Sections III-V of the Requests for Rehearing with 37 C.F.R. § 42.71(d).

Patent Owner has conferred with Petitioner and provided a detailed explanation of the issues it intends to address in a reply, as indicated in the email chain forwarded below. Patent Owner also indicated its intent to contact the Board at midday today. Petitioner, however, has not yet indicated whether or not it will oppose the request, nor has Petitioner provided its availability for a call with the Board. Petitioner also did not request additional time to consider Patent Owner's request.

Patent Owner is available for a conference call as follows:

- Monday, October 20, 1pm-3:00pm;
- Wednesday, October 22, 1:00pm-3:00pm; and
- Thursday, October 23, 9:30am-3:00pm.

Respectfully submitted,
 Mark DeBoy
 Counsel for Patent Owner

Mark J. DeBoy
Partner



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From: Mark J. DeBoy

Sent: Thursday, October 16, 2025 1:31 PM

To: Wichman, Adam R. <Adam.Wichman@WolfGreenfield.com>

Cc: Patrick Finnann <pfinnan@esfip.com>; Larry Shatzer <shatzer@esfip.com>; PTAB Adam Wichman <AWichman-PTAB@WolfGreenfield.com>; PTAB Rich Giunta <RGiunta-PTAB@WolfGreenfield.com>; PTAB Greg Nieberg <GNieberg-PTAB@WolfGreenfield.com>; PTAB Mike Rader <MRader-PTAB@WolfGreenfield.com>; PTAB Michele Moresco <mmoresco-ptab@WolfGreenfield.com>; PTAB Michael Parsons <MParsons-PTAB@WolfGreenfield.com>

Subject: RE: Inter Partes Reviews IPR2025-00928 and IPR2025-00929

Adam,

It is Fractus' position that Fractus did not wait three years to assert the challenged patents, as Geotab indicates in its rehearing request, and instead, asserted at least the '365 Patent shortly after it was in communication with Geotab. Fractus asserted the '365 patent in 2022 against ADT. You can find this argument on page 17 of Patent Owner's discretionary denial request. Of course, Fractus is requesting a response to Geotab's misunderstanding of the Board's decision, and therefore, is under no obligation to have previously presented this argument.

-Mark

From: Wichman, Adam R. <Adam.Wichman@WolfGreenfield.com>
Sent: Thursday, October 16, 2025 1:23 PM
To: Mark J. DeBoy <mdeboy@esfip.com>
Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <shatzer@esfip.com>; PTAB Adam Wichman <AWichman-PTAB@WolfGreenfield.com>; PTAB Rich Giunta <RGiunta-PTAB@WolfGreenfield.com>; PTAB Greg Nieberg <GNieberg-PTAB@WolfGreenfield.com>; PTAB Mike Rader <MRader-PTAB@WolfGreenfield.com>; PTAB Michele Moresco <mmoresco-ptab@WolfGreenfield.com>; PTAB Michael Parsons <MParsons-PTAB@WolfGreenfield.com>
Subject: RE: Inter Partes Reviews IPR2025-00928 and IPR2025-00929

Mark,

I want to make sure that I understand this correctly. Fractus intends to argue that it was engaged in discussions with Geotab until “shortly before” it filed suit on December 6, 2024 because of claim construction briefing that was filed in E.D. Tex. in litigation involving third parties ADT and Vivint?

And where did Fractus make this argument in its request for discretionary denial?

Thanks.



Adam R. Wichman, Ph.D.

Shareholder

Admitted to Practice: Massachusetts, California

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From: Mark J. DeBoy <mdeboy@esfip.com>
Sent: Thursday, October 16, 2025 1:15 PM
To: Wichman, Adam R. <Adam.Wichman@WolfGreenfield.com>
Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <shatzer@esfip.com>; PTAB Adam Wichman <AWichman-PTAB@WolfGreenfield.com>; PTAB Rich Giunta <RGiunta-PTAB@WolfGreenfield.com>; PTAB Greg Nieberg <GNieberg-PTAB@WolfGreenfield.com>; PTAB Mike Rader <MRader-PTAB@WolfGreenfield.com>; PTAB Michele Moresco <mmoresco-ptab@WolfGreenfield.com>; PTAB Michael Parsons <MParsons-PTAB@WolfGreenfield.com>

Subject: RE: Inter Partes Reviews IPR2025-00928 and IPR2025-00929

Adam,

It is Fractus position that Geotab and Fractus were engaged in discussions until shortly before Patent Owner asserted the challenged patent. Patent Owner's evidentiary basis is based in part on Petitioner's exhibits 1008-1010 in IPR2025-00928.

-Mark

Mark J. DeBoy

Partner



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From: Wichman, Adam R. <Adam.Wichman@WolfGreenfield.com>

Sent: Thursday, October 16, 2025 12:50 PM

To: Mark J. DeBoy <mdeboy@esfip.com>

Cc: Patrick Finnann <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>; PTAB Adam Wichman <AWichman-PTAB@WolfGreenfield.com>; PTAB Rich Giunta <RGiunta-PTAB@WolfGreenfield.com>; PTAB Greg Nieberg <GNieberg-PTAB@WolfGreenfield.com>; PTAB Mike Rader <MRader-PTAB@WolfGreenfield.com>; PTAB Michele Moresco <mmoresco-ptab@WolfGreenfield.com>; PTAB Michael Parsons <MParsons-PTAB@WolfGreenfield.com>

Subject: RE: Inter Partes Reviews IPR2025-00928 and IPR2025-00929

Mark,

You write,

As you are aware, Section II of Geotab's Requests for Rehearing states "Contrary to the Director's finding, Geotab and Fractus were not 'engaged in discussions... until shortly before' Fractus filed suit." Fractus disagrees with this position.

What is the disagreement? What is the evidentiary basis for this disagreement?

Regards,



Adam R. Wichman, Ph.D.

Shareholder

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From: Mark J. DeBoy <mdeboy@esfip.com>

Sent: Thursday, October 16, 2025 12:42 PM

To: Wichman, Adam R. <Adam.Wichman@WolfGreenfield.com>

Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>; PTAB Adam Wichman <AWichman-PTAB@WolfGreenfield.com>; PTAB Rich Giunta <RGiunta-PTAB@WolfGreenfield.com>; PTAB Greg Nieberg <GNieberg-PTAB@WolfGreenfield.com>; PTAB Mike Rader <MRader-PTAB@WolfGreenfield.com>; PTAB Michele Moresco <mmoresco-ptab@WolfGreenfield.com>; PTAB Michael Parsons <MParsons-PTAB@WolfGreenfield.com>

Subject: RE: Inter Partes Reviews IPR2025-00928 and IPR2025-00929

Adam,

As you are aware, Section II of Geotab's Requests for Rehearing states "Contrary to the Director's finding, Geotab and Fractus were not 'engaged in discussions... until shortly before' Fractus filed suit." Fractus disagrees with this position.

As you are also aware, 37 C.F.R. § 42.71(d) requires that a request for rehearing "must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply," which is not done in sections III-V.

Fractus will seek a 5 page reply.

Fractus plans to email the Board no later than mid-day tomorrow. We look forward to receiving an indication of your position in advance of our email.

-Mark

Mark J. DeBoy

Partner



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From: Wichman, Adam R. <Adam.Wichman@WolfGreenfield.com>

Sent: Thursday, October 16, 2025 12:32 PM

To: Mark J. DeBoy <mdeboy@esfip.com>

Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>; PTAB Adam Wichman <AWichman-PTAB@WolfGreenfield.com>; PTAB Rich Giunta <RGiunta-PTAB@WolfGreenfield.com>; PTAB Greg Nieberg <GNieberg-PTAB@WolfGreenfield.com>; PTAB Mike Rader <MRader-PTAB@WolfGreenfield.com>; PTAB Michele Moresco <mmoresco-ptab@WolfGreenfield.com>; PTAB Michael Parsons <MParsons-PTAB@WolfGreenfield.com>

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Mark,

Thanks for your email. Geotab requires more information to evaluate Fractus's request.

- What about "Petitioner's interpretation of the Director's Discretionary Denial Decision as discussed in Section II" in each request does Fractus think requires a reply?
- Why does Fractus take the position that "Sections III-V do not comply with 37 C.F.R. § 42.71(d)"? Which request does this concern?
- You say Fractus will request a "short reply." How many pages is a "short reply"?

Regards,

Adam R. Wichman, Ph.D.



Shareholder

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From: Mark J. DeBoy <mdeboy@esfip.com>
Sent: Wednesday, October 15, 2025 5:06 PM
To: PTAB Adam Wichman <AWichman-PTAB@WolfGreenfield.com>; PTAB Rich Giunta <RGiunta-PTAB@WolfGreenfield.com>; PTAB Greg Nieberg <GNieberg-PTAB@WolfGreenfield.com>; PTAB Mike Rader <MRader-PTAB@WolfGreenfield.com>; PTAB Michele Moresco <mmoresco-ptab@WolfGreenfield.com>; PTAB Michael Parsons <MParsons-PTAB@WolfGreenfield.com>
Cc: Patrick Finnan <pfinnan@esfip.com>; Larry Shatzer <lshatzer@esfip.com>
Subject: Inter Partes Reviews IPR2025-00928 and IPR2025-00929

Adam,

Patent Owner will be emailing the Board to request replies to Geotab's Requests for Rehearing in inter partes reviews IPR2025-00928 and IPR2025-00929. Specifically, Patent Owner will request a short reply to address:

- Petitioner's interpretation of the Director's Discretionary Denial Decision as discussed in Section II, and
- How Sections III-V do not comply with 37 C.F.R. § 42.71(d).

Please let us know if Petitioner opposes this request and your availability for a call with the Board.

Provided below is a draft email to the Board for your consideration.

Sincerely,
Mark

Your Honors,

Patent Owner, Fractus S.A. requests a conference call to discuss good cause to submit responses to the Requests for Rehearing submitted by the Petitioner in inter partes reviews IPR2025-00928 and IPR2025-00929. Specifically, Patent Owner believes good cause exists for a short reply to address:

- Petitioner's interpretation of the Director's Discretionary Denial Decision as discussed in Section II of the Requests for Rehearing, and
- Compliance of Sections III-V of the Requests for Rehearing with 37 C.F.R. § 42.71(d).

Petitioner **does/does not** oppose this request.

The parties are available as follows:

- Thursday October 16, 9:30am-12:00pm;
- Monday, October 20, 9:30am-3:00pm;
- Wednesday, October 22, 1:00pm-3:00pm; and
- Thursday, October 23, 9:30am-3:00pm.

Respectfully submitted,
Mark DeBoy
Counsel for Patent Owner

Mark J. DeBoy
Partner



EDALL • SHAPIRO • FINNAN

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