

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEOTAB INC. AND GEOTAB USA, INC.,
Petitioners,

v.

FRACTUS, S.A.
Patent Owner.

Case No. IPR2025-00929
Patent No. 8,810,458

**PETITIONERS' OPPOSITION TO
PATENT OWNER'S DISCRETIONARY DENIAL BRIEF**

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EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 8,810,458 (“the ’458 patent”)
1002	Prosecution History of U.S. Patent No. 8,810,458
1003	Declaration of David M. Pozar, Ph.D. (“Pozar”)
1004	Curriculum Vitae of David M. Pozar
1005	K-L Wong, J-H Chou, S-W Su, and C-M Su. “Isolation between GSM/DCS and WLAN Antennas in a PDA Phone,” <i>Microwave and Optical Technology Letters</i> , volume 45, no. 4, 2005, pp. 347-352 (“Wong”)
1006	Declaration of James L. Mullins, Ph.D.
1007	Curriculum Vitae of James L. Mullins
1008	U.S. Patent App. Pub. No. 2009/0002248 to Zhao et al. (“Zhao”)
1009	ETSI TS 145 005 V4.3.0 Technical Specification: Digital cellular telecommunications system (Phase 2+); Radio transmission and reception (3GPP TS 45.005 version 4.3.0 Release 4), 2001
1010	Plaintiff’s Disclosure of Asserted Claims and Infringement Contentions Against Geotab Pursuant to Local Patent Rules 3-1 and 3-2, <i>Fractus, S.A. v. Geotab Inc.</i> , No. 2-24-cv-01008 (E.D. Tex.), served Mar. 12, 2025.
1011	G-Y Lee and K-L Wong. “Quad-Band Internal Monopole Mobile-Phone Antenna,” <i>Microwave and Optical Technology Letters</i> , volume 40, no. 5, 2004, pp. 359-361 (“Lee”)
1012	U.S. Patent App. Pub. No. 2006/0082503 to Gaucher et al. (“Gaucher”)
1013	U.S. Patent App. Pub. No. 2004/0113848 to Gaucher et al. (“Gaucher848”)
1014	WIPO Publication No. WO 2006/040609 to Zhao et al.
1015	Overall Revision of the Rules Regarding Industrial Scientific and Medical (ISM) Equipment, 50 Fed. Reg. 36061, 36069 (Sep. 5, 1985) (codified at 47 C.F.R. §18.301)
1016	’458 patent Claim Limitation Comparison Chart

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1017	IEEE Std. 802.11a-1999, Supplement to the IEEE Standard for Information Technology—Telecommunications and information exchange between systems—Local and metropolitan area networks—Specific requirements— Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) specifications: High-speed Physical Layer in the 5 GHz Band (Dec. 30, 1999)
1018	IEEE Std. 802.11b-1999, Supplement to the IEEE Standard for Information Technology—Telecommunications and information exchange between systems—Local and metropolitan area networks—Specific requirements— Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) specifications: Higher-Speed Physical Layer Extension in the 2.4 GHz Band (Jan. 20, 2000)
1019	IBM Hardware Announcement: New IBM ThinkPad T42 notebooks feature new fingerprint and Intel PRO/Wireless technologies (Jan. 11, 2005)
1020	IEEE Std. 802.11g-2003, 802.11g IEEE Standard for Information technology—Telecommunications and information exchange between systems—Local and metropolitan area networks—Specific requirements Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) specifications, Amendment 4: Further Higher Data Rate Extension in the 2.4 GHz Band (June 27, 2003)
1021	ZigBee Specification (Jun. 27, 2005)
1022	Specification of the Bluetooth System version 2.0, volume 2 (issued Nov. 4, 2004)
1023	Wi-Fi Alliance Press Release, “Wi-Fi Celebrates Its Third Birthday” (Apr. 7, 2003) (Wayback Machine copy dated Sep. 28, 2003)
1024	U.S. Patent App. Pub. No. 2002/0021250 to Asano et al. (“Asano”)
1025	Y.J. Wang et al., “Novel Microstrip-Monopole-Integrated Ultra-Wideband Antenna for Mobile UWB Devices,” in <i>Radio and Wireless Conference, 2003. RAWCON’03. Proceedings</i> , IEEE, 2003, pp. 87-90.
1026	Excerpts from James et al., <i>Mathematics Dictionary</i> (Chapman & Hall, 5th ed. 1992)
1027	Excerpts from Pozar, <i>Microwave Engineering</i> (John Wiley & Sons, Inc., 3rd ed. 2005)

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1028	Dialogue Flybook User’s Manual rev. 1.02 (2003)
1029	U.S. Patent No. 5,596,401 to Kusuzawa
1030	U.S. Patent No. 6,624,789 to Kangasvieri et al.
1031	Unlicensed NII Devices in the 5 GHz Frequency Range, 63 Fed. Reg. 40831, 40836-40837 (July 31, 1998) (codified at 47 C.F.R. §15.407)
1032	U.S. Patent App. Pub. No. 2004/0121828 to Wang et el. (“Wang”)
1033	U.S. Patent No. 6,728,555 to Pirilä et al.
1034	U.K. Patent App. Pub. No. GB 2336019 to Berg et al. (“Berg”)
1035	Smith, “Dialogue demos ‘total wireless’ sub-notebook” (The Register, Jun. 2, 2004)
1036	K-L Wong, J-H Chou, S-W Su, and C-M Su. “Isolation between GSM/DCS and WLAN Antennas in a PDA Phone,” <i>Microwave and Optical Technology Letters</i> , volume 45, no. 4, 2005, pp. 347-352 (color version)
1037-1042	<i>Reserved</i>
1043	October 2021 Letter from Fractus to Geotab
1044	Email communications of Geotab and Fractus between November 2021 and January 2022
1045	November 2021 Letter from Geotab to Fractus
1046	Copy of Fractus’s Standard Non-Disclosure Agreement
1047	D.I. 17, Consolidation Order, <i>Fractus, S.A. v. Verizon</i> , No. 2:24-cv-01009 (E.D. Tex. Feb. 18, 2025)
1048	Federal Court Statistics March 31, 2025
1049	D.I. 34, Docket Control Order, <i>Fractus, S.A. v. Verizon</i> , No. 2:24-cv-01009 (E.D. Tex. Mar. 26, 2025)
1050	Eastern District of Texas Model Patent Order
1051	D.I. 14-1, Proof of Service of Complaint, <i>Fractus, S.A. v. Geotab</i> , No. 2:24-cv-01008 (E.D. Tex. Jan. 3, 2025)

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1052	D.I. 18, Consolidation Order, <i>Cornell v. AT&T</i> , No. 2:25-cv-00054 (E.D. Tex. Feb. 18, 2025)
1053	D.I. 25, Docket Control Order Setting Trial, <i>Cornell v. AT&T</i> , No. 2:25-cv-00054 (E.D. Tex. Mar. 26, 2025)
1054	D.I. 11, Consolidation Order, <i>H2 Intellect v. The Home Depot</i> , No. 2:25-cv-00123 (E.D. Tex. Apr. 8, 2025)
1055	D.I. 46, Docket Control Order Setting Trial, <i>H2 Intellect v. The Home Depot</i> , No. 2:25-cv-00123 (E.D. Tex. Jun. 2, 2025)
1056	D.I. 9, Consolidation Order, <i>HyperQuery v. Nemetschek</i> , No. 2:25-cv-00043 (E.D. Tex. Apr. 7, 2025)
1057	D.I. 17, Docket Control Order Setting Trial, <i>HyperQuery v. Nemetschek</i> , No. 2:25-cv-00043 (E.D. Tex. Jun. 2, 2025)
1058	D.I. 7, Consolidation Order, <i>Infogation v. TomTom</i> , No. 2:24-cv-01022 (E.D. Tex. Feb. 18, 2025)
1059	D.I. 23, Docket Control Order Setting Trial, <i>Infogation v. TomTom</i> , No. 2:24-cv-01022 (E.D. Tex. Mar. 27, 2025)
1060	D.I. 13, Consolidation Order, <i>Intercurrency v. Airwallex</i> , No. 2:24-cv-01011 (E.D. Tex. Apr. 8, 2025)
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1062	D.I. 16, Docket Control Order Setting Trial, <i>IOT Innovations v. Snap One</i> , No. 2:25-cv-00022 (E.D. Tex. Mar. 26, 2025)
1063	D.I. 12, Consolidation Order, <i>QR Switch v. Walmart</i> , No. 2:25-cv-00064 (E.D. Tex. Feb. 18, 2025)
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Patent Owner's request for discretionary denial (Paper 7, "Request") disregards multiple factors that decisively weigh against discretionary denial and justify using the Board's resources to decide the Petition on the merits. The Request should be denied and the Petition should be referred to the merits panel.

I. INTRODUCTION

Petitioners Geotab Inc. and Geotab USA, Inc. ("Geotab") are a leading provider of telematic (vehicle-tracking) solutions in the United States. Geotab is trusted by the Federal Government (with services to the Army, the Marine Corp, the Air Force, the Coast Guard, the Department of Homeland Security, and the U.S. Postal Service) and industry-leading companies like Amazon and UPS.

Geotab USA is an American company headquartered in Atlanta, Georgia. Geotab's 400 U.S. employees serve more than more than 31,000 American customers. Geotab's advanced telematics platform, ecosystem and network of 3.3M+ connected vehicles across the United States provides the critical insights that the Federal Government and thousands of U.S. companies rely on to optimize operations, boost productivity, reduce cost, and drive efficiency.

Patent Owner Fractus, S.A. ("Fractus") is a Spanish non-practicing entity. Fractus regularly sues American companies for patent infringement in United States District Courts. Fractus has filed 17 such litigations since 2009, 16 of them in the Eastern District of Texas.

Fractus returned to the Eastern District of Texas to file a lawsuit accusing Geotab’s telematics devices of infringing five different patents concerning mobile devices with antennas—including the ’458 Patent challenged in this IPR. Fractus simultaneously filed a second lawsuit accusing Verizon of infringing the ’458 Patent. The ’458 Patent never should have issued. As explained below, the claims are demonstrably unpatentable and only issued due to the Examiner’s material errors.

The Final Written Decision (“FWD”) is highly likely to issue before any trial occurs in the litigation in the Eastern District of Texas. The *Fintiv* factors overwhelmingly favor institution. Fractus contends that the district court trial will beat the FWD (with a statutory deadline of November 28, 2026) because jury selection is currently scheduled for September 14, 2026. But Fractus ignores that Judge Gilstrap’s docket currently lists *fifteen* cases that—under Fractus’s analysis—are set for jury selection on the same date (September 14, 2026). *Infra* §IV.A; EX1066. The court can only hold one trial at a time. Given that Geotab is just one of fifteen cases with jury selection currently scheduled on that date, there is a 93% chance (i.e., 14 in 15) that Geotab’s case will *not* go to trial on September 14, 2026. The date Fractus identifies is simply not a reliable indicator of when Fractus’s litigation against Geotab can be expected to go to trial.

The median-time-to-trial statistics in the Eastern District of Texas (“EDTX”) are a far more reliable indicator of when Fractus’s litigation against Geotab can realistically be expected to go to trial. *Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-00250, Paper 14 at 2 (Dir. May 16, 2025) (where a scheduled trial date preceded the FWD date but “the time-to-trial statistics suggest trial would not begin until” after the FWD date the Director correctly found that “it is likely that a final written decision in this proceeding will issue before the district court trial occurs” and referred the petition to the merits panel). Under the 25.9 month median-time-to-trial in EDTX (*infra* §IV.A.1), a trial is unlikely to be held until February 2, 2027, more than two months (65 days) after the statutory November 28, 2026 deadline for the FWD to issue. The earlier FWD weighs against discretionary denial.

Seeking to avoid the consequences of applying the district-wide one year statistics, as the Director’s decisions have done, Fractus alleges that Judge Gilstrap’s “average” time-to-trial “[o]ver the past two years” is 22 months which would result in a trial that slightly beats the FWD. Request, 15. Fractus includes stale, two-year old data to obscure the fact that the caseload in EDTX and for Judge Gilstrap has increased. The district’s median-time-to-trial (over a one-year interval) jumped from 21.3 months on March 31, 2024 to 25.9 months on March 31, 2025. EX1048, 35. In the twelve-month period ending August 28, 2025 (the

date of this Opposition), Judge Gilstrap held 13 patent trials, with a median and average time-to-trial of 25 months (EX1067), which would result in the Geotab trial occurring after FWD.

By any reliable measure, it is likely that the FWD will beat the trial in EDTX, which weighs against discretionary denial. But even if the Director were to rely on the (unrealistic) trial date that Fractus identifies, “discretionary denial of institution is [still] not warranted because of Petitioner[s]’ showing of material error during patent examination.” *Microsoft Corp. v. ParTec Cluster Competence Center GmbH*, IPR2025-00318, Paper 9 at 2-3 (Dir. June 12, 2025) (referring petition to merits panel; material error outweighs earlier trial date); *see also Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at 2-3 (Dir. July 16, 2025) (same).

* * *

Fractus has weaponized its facially-unpatentable ’458 Patent claims against a wide range of industries, thereby imposing a burden on commerce, the courts, and the American consumer. For the reasons explained below, Fractus’s request for discretionary denial should be denied and the Petition referred to the merits panel to correct the Examiner’s material errors in allowing the ’458 Patent to issue.

II. CORRECTING THE OFFICE’S MATERIAL ERRORS IS AN EFFECTIVE USE OF THE BOARD’S RESOURCES AND WEIGHS AGAINST DISCRETIONARY DENIAL

The Examiner materially erred in allowing the ’458 Patent. The ’458 Patent concerns antenna placement in a mobile device with a ground plane, a printed circuit board (PCB), and a first and second antenna. Petition, 1. One antenna supports cellular communications, while the other supports wireless connectivity services, i.e., using a wireless local area network (WLAN), Bluetooth, and the like. Petition, 4. The ’458 Patent purports to provide good isolation between the antennas by appropriately choosing the relative placement and orientation of each antenna. Petition, 4. Optimizing cellular and WLAN antenna isolation in a wireless device by properly choosing the antenna placement and orientation was well-known. Petition, 1, 4.

Fractus filed the application for the ’458 Patent with a preliminary amendment canceling application-claims 1-20 and adding application-claims 21-40 (hereinafter “originally-filed claims”). EX1002, 13, 15-19. The Examiner’s first action rejected the originally-filed claims for statutory-type double patenting over another Fractus patent and made no prior art rejection. EX1002, 463-464. In response, Fractus cancelled the originally-filed claims and replaced them with the claims that ultimately issued. EX1002, 476-480.

In the next office action the Examiner allowed the claims that issued as independent claims 1 and 8 (and the claims depending therefrom) without a rejection. EX1002, 486, 489-490.

The claim that issued as independent claim 14 had a single rejection. In the same final action after Fractus canceled the originally-filed claims and added the new claims, the Examiner rejected as-filed application-claim 55 as anticipated. EX1002, 486-489. Fractus then filed a Request for Continued Examination (RCE) (EX1002, 502) and amended application-claim 55 to add limitations concerning the dimensions of a “rectangle” in which a “second antenna” was “inscribed” (EX1002, 503, 506-507). In the next office action the Examiner allowed application-claim 55, which issued as independent claim 14, with the “reasons for allowance” citing the limitation that Fractus had added in its amendment after final action. EX1002, 523-525.

The Examiner never found or considered the prior art Wong (EX1005), Lee (EX1011), Gaucher (EX1012), or Zhao (EX1008) references used in the Petition’s grounds, and none was of record during prosecution. The prior art in the Petition’s grounds 1A (Wong in view of Lee) and 2 (Gaucher) separately demonstrate that the Examiner materially erred in deeming the subject matter of claims 1 and 8 allowable. The prior art in the Petition’s grounds 1B (Wong) and 3 (Zhao)

separately demonstrate that the Examiner materially erred in deeming the subject matter of claim 14 allowable.

In other words, for each of the three independent claims (claims 1, 8, and 14), the Petition provides two distinct Grounds with different references that separately demonstrate the Examiner's error in allowing that claim. Finding that even a single one of these six examples demonstrates material error would justify referring the Petition to the merits panel. Because the Examiner materially erred in allowing the '458 Patent, it would be an effective use of the Board's resources to correct the Examiner's error.

A. The Examiner Materially Erred in Allowing Independent Claim 1 Because It Recites a Second Antenna That Extends “Substantially Parallel” to the Side of a Ground Plane

The Examiner allowed as-filed application-claim 41 (which issued as claim 1) without rejection. EX1002, 477 and 489. The Examiner's “statement of reasons for the indication of allowable subject matter” stated that a prior art reference Honda¹ taught everything in the claim except “*the second antenna extends in a direction substantially parallel to the second side*” (Limitation [1.h]).² EX1002, 489. Thus, the Examiner allowed '458 Patent claim 1 (and claims 2-7

¹ U.S. Patent No. 6,992,627.

² The claim labels are provided in the Petition's claim list (Appendix A).

that depend therefrom) because he regarded Limitation [1.h] as describing inventive subject matter. That is demonstrably wrong.

The Petition presents two grounds (Grounds 1A and 2) demonstrating that Limitation [1.h] was in the prior art and that claim 1 is unpatentable. Petition, 32-34 (Ground 1A), 81-82 (Ground 2). Either showing is sufficient to demonstrate the Examiner's material error in allowing claim 1 based on the mistaken belief that Limitation [1.h] was inventive. The Examiner never identified or considered any of the prior art references used in Ground 1A (Wong in view of Lee) or Ground 2 (Gaucher). Because this prior art was "not before the examiner, the examiner could not have considered the [Petition's] combination... during prosecution." *Hamilton Technologies v. Tehrani*, IPR2020-01199, Paper 6 at 21 (Jan. 6, 2021) (instituting trial; finding that the Office materially erred in allowing claims while failing to consider the petition's references that were not before the examiner).

As in *Hamilton Technologies*, "the examiner did not have the benefit of the teachings" of the prior art used in the IPR Grounds and committed material error by failing to appreciate that Limitation [1.h] was not inventive, and that claim 1 is unpatentable in view of this prior art. *Id.* As the Board's precedential *Advanced Bionics* framework confirms, correcting material error in examination is an effective use of the Board's resources and makes discretionary denial unwarranted. *Advanced Bionics v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-

01469, Paper 6 at 8–9 (Feb. 13, 2020) (precedential) (error material to patentability weighs against discretionary denial).

1. Ground 1A Demonstrates That Wong Meets [1.h] and that Claim 1 is Unpatentable

Wong studied how antenna placement improved isolation between a cellular antenna and a WLAN antenna, on a PCB having a ground plane, in a mobile device like a personal digital assistant (PDA). Wong, 347-351; Petition, 7. The antenna isolation problem that Wong studied is precisely the same problem that the '458 Patent purports to address. Wong, Figs. 1-2, 348-350; EX1001, Abstract (“The invention... relates to enhancement of the isolation between first and second antennas in a handheld device.”); Petition, 7-9. Wong solved this problem in the same way the '458 Patent describes—by fixing the cellular (GSM/DCS) antenna at the top edge of the circuit board (i.e., PCB) and by varying the WLAN antenna position (e.g., P1-P10) along the PCB’s boundary. Wong, Figs. 1-2, 348-350; EX1001, Abstract, Figs. 7A-7I (showing antenna 701 fixed at top edge of circuit board and varying antenna 702 position); *see* Petition, 7-9.

Wong teaches every limitation of claim 1, except that Wong’s cellular antenna is a dual-band antenna that supports two frequency bands rather than three as required by Limitations [1.c] and [1.d]. Petition, 10-12, 16-38. Cellular antennas supporting three or more frequency bands were well-known as evidenced by Lee. Petition, 21-22; Lee, 359 (“the antenna [is] capable of *quad-band*

operation in the advanced mobile phone system”).³ A POSA had reason to use Lee’s quad-band antenna in place of Wong’s dual-band cellular antenna because Lee’s antenna supports four different cellular frequency bands used in North America and Europe—and thus could support a mobile device operable in North America and Europe—whereas Wong’s antenna supports only two cellular frequency bands used in Europe.⁴ Petition, 12-16.

Ground 1A’s simple combination of Wong and Lee (“Wong+Lee”) replaces Wong’s antenna with Lee’s quadband antenna which meets claim 1’s “*first antenna*.” Petition, 10-16. There should be no reasonable dispute that Wong+Lee meets every limitation of claim 1 and renders claim 1 obvious. Petition, 7-38.

Fractus’s Request alleges that the Petition’s patentability challenge is “weak.” Request, 17-18 & 20. But the Request never even attempts to

³ All emphasis is added unless otherwise indicated.

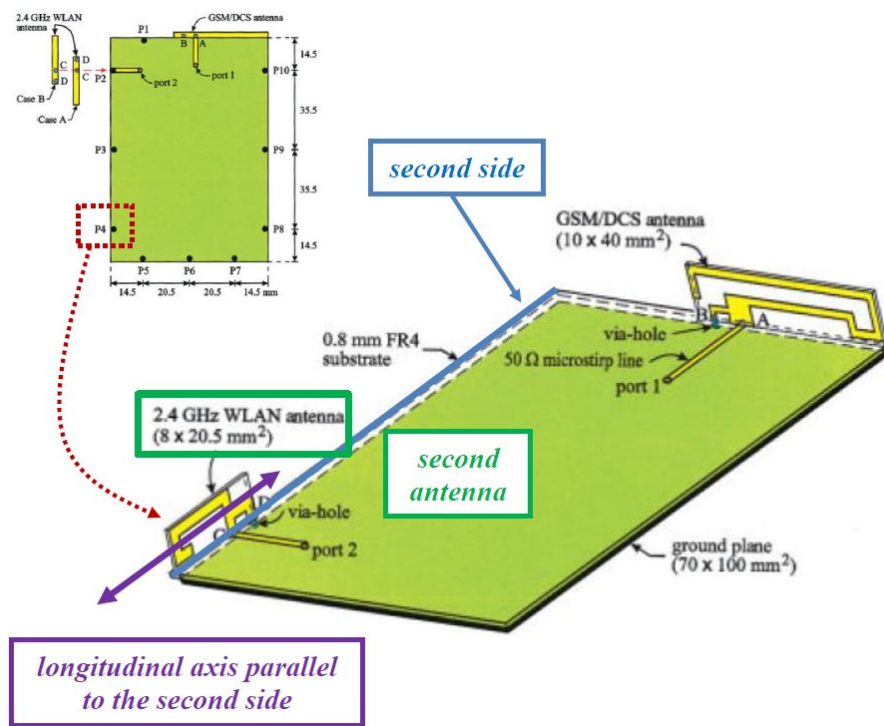
⁴ AMPS/GSM850 (824-894 MHz) and PCS1900 (1850-1990 MHz) are used in North America, while GSM900 (880-960 MHz) and DCS1800 (1710-1880 MHz) are used in Europe. Petition, 13. Lee’s quadband antenna covers all four cellular bands, whereas Wong’s GSM/DCS antenna covers only the two European bands. *Id.*

substantiate that assertion.⁵ The Request merely advances the boilerplate assertion that “the invalidity grounds propose combinations of the references that are contrary to the references’ explicit teachings and have no likelihood of success.” Request, 18. This also mischaracterizes the Petition’s arguments. The Petition advances a single combination (Ground 1A, Wong+Lee)—the remaining invalidity arguments rely on single-reference obviousness—Ground1B (Wong), Ground 2 (Gaucher), Ground 3 (Zhao)—not “combinations” as Fractus’s boilerplate erroneously argues. *Id.* As explained above the Petition’s single combination uses Lee’s quad-band antenna (Lee, 359, 361, Fig. 1(a)) in a mobile phone with Wong’s ground plane and WLAN antenna (Wong, 347-348, Fig. 1(a)). Petition, 9-16. Fractus’s assertion that this “combination[] [is] contrary to the references’ explicit teachings and [has] no likelihood of success” is baseless. Request, 18.

Limitation [1.h] requires that “*the second antenna extends in a direction substantially parallel to the second side*” where the antecedent for “*the second*

⁵ Fractus’s attempt to “incorporate[] herein the merits arguments and evidence from its forthcoming... POPR... by reference” (Request, 17) fails because Fractus has not yet advanced any merits arguments. This is Petitioner’s “opposition brief” on discretionary denial. Stewart Memorandum (Mar. 26, 2025), 2. Petitioner cannot oppose and respond to arguments Fractus has not even advanced yet.

side” is in Limitation [1.b], which makes clear that “the second side” is the longer side of a rectangular ground plane. Petition, 18-20. There is no reasonable dispute that Wong’s second antenna (Wong’s 2.4 GHz WLAN antenna) “*extends in a direction substantially parallel to the second side*” of a ground plane as recited in [1.h]. See Petition, 32-34 (ground 1A). This is clear from Wong’s figures annotated in the Petition and reproduced below.



Petition, 34 (annotating Wong, Figs. 1(a) and 2).

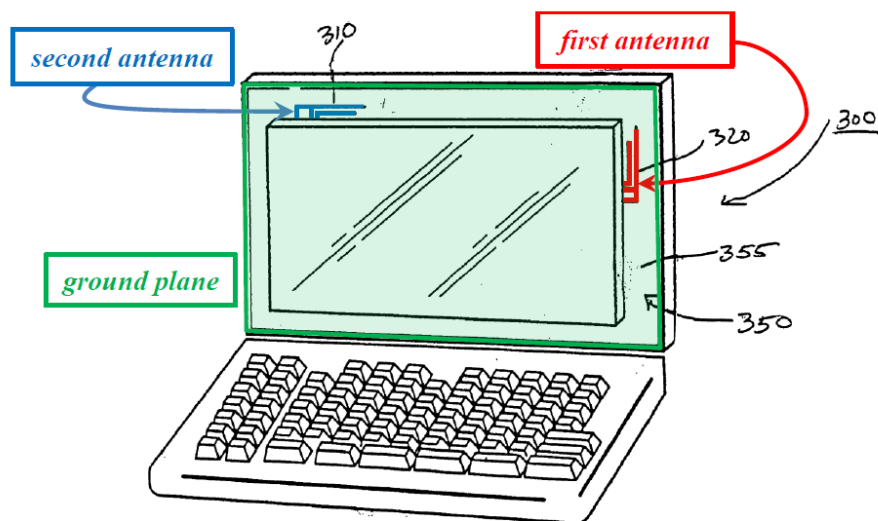
The Examiner allowed claim 1 (and claims 2-7) based on a limitation ([1.h]) that was not inventive. EX1002, 489. Had the Examiner considered Wong in view of Lee (as shown in Ground 1A) or Gaucher (as shown in Ground 2 and discussed below §II.A.2), the Examiner never would have allowed the claims. Doing so was

error material to patentability. It is an appropriate and effective use of the Board's resources to address and remediate this error.

Remediating this error is reason enough why this Petition should not be discretionarily denied. But this is one of many errors the Examiner committed.

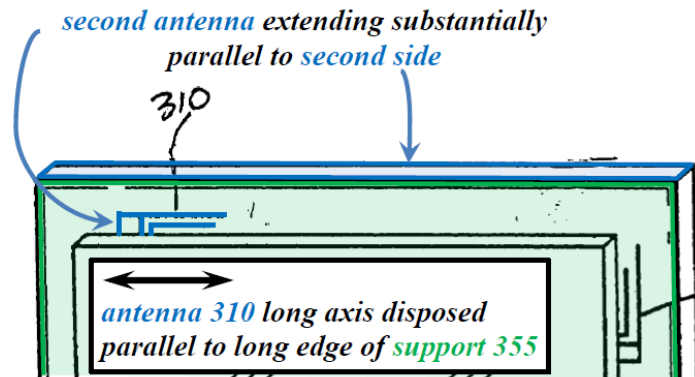
2. Ground 2 Demonstrates That Gaucher Also Meets [1.h]

Gaucher discloses “a laptop computer 300” with “a plurality of multiband antennas 310, 320” (i.e., first antenna 320 and second antenna 310) “mounted to” the laptop display's metal support frame 355 which “is used as a ground plane for the antennas.” Gaucher, [0025], [0032], Fig. 3 (annotated below); Petition, 65-70 (discussing Gaucher). As shown in Gaucher Figure 3 annotated below, the “plane” of the first antenna 320 and the second antenna 310 “is substantially parallel to the plane, or along the plane, of the metal support frame 355.” Gaucher, [0025]; Petition, 66. In Figure 3, the second antenna 310 is shown along the long side of the support frame rectangle and the first antenna 320 is shown along the short side of the support frame rectangle. Gaucher, [0025], Fig. 3; Petition, 66.



Petition, 66, annotating Gaucher Fig. 3.

The Examiner allowed claim 1 based on Limitation [1.h]’s requirement that *“the second antenna extends in a direction substantially parallel to the second side,”* where *“the second side”* is the longer side of the rectangular ground plane per [1.b]. Gaucher meets Limitation [1.h] as shown by the figure below. Petition, 81-82. Thus, the Examiner allowed claim 1 (and claims 2-7) based on a limitation ([1.h]) that was not inventive. EX1002, 489. Had the Examiner considered Gaucher, the Examiner would never have allowed claim 1 based on Limitation [1.h].



Petition, 82, annotating Gaucher Fig. 3.

Ground 2 shows that an obvious implementation of Gaucher meets every other requirement of claim 1 and renders it obvious. Petition, 71-84. Had the Examiner considered Gaucher, the Examiner never would have allowed claims 1-7. Doing so was error material to patentability. It is an appropriate and effective use of the Board’s resources to address and remediate this error.

As explained above, assuming Fractus is referring to this obvious implementation of Gaucher when it refers to “combinations,” then Fractus’s contention that this implementation “[is] contrary to the references’ explicit teachings and [has] no likelihood of success” is unsupported and baseless.

Request, 18; *supra* §II.A.1.

B. The Examiner Materially Erred in Allowing Independent Claim 8 Based on its Recitation that the Second Antenna Is Arranged “Substantially Close” to the Corner of the Portable Device

The Examiner allowed as-filed application-claim 48, which issued as claim 8, without rejection. EX1002, 489-490. The Examiner’s “statement of reasons for the indication of allowable subject matter” stated that the prior art Honda reference

taught everything in the claim except “*the second antenna is arranged substantially close to a first corner of the portable device; the first corner of the portable device corresponding to a first end of the first side with an end of the second side of the portable device*” (Limitations [8.h]-[8.i]). EX1002, 489-490.

Thus, the Examiner allowed claim 8 of the ’458 Patent because he regarded Limitations [8.h]-[8.i] as inventive. The Examiner was demonstrably wrong.

The Petition’s Grounds 1A and 2 also demonstrate that Limitations [8.h]-[8.i] were in the prior art and that claim 8 is unpatentable. Petition, 49-52 (Ground 1A), 92-95 (Ground 2). As in *Hamilton Technologies*, “the examiner did not have the benefit of the teachings” of the prior art used in the IPR Grounds and committed material error by failing to appreciate that Limitations [8.h]-[8.i] were not inventive, and that claim 8 is unpatentable in view of this prior art. IPR2020-01199, Paper 6 at 21. As with claim 1 (*supra* §II.A), either showing is sufficient to demonstrate the Examiner’s material error in allowing claim 8 based on the mistaken belief that Limitations [8.h]-[8.i] were inventive.

1. Ground 1A Demonstrates That Wong Meets [8.h]-[8.i]

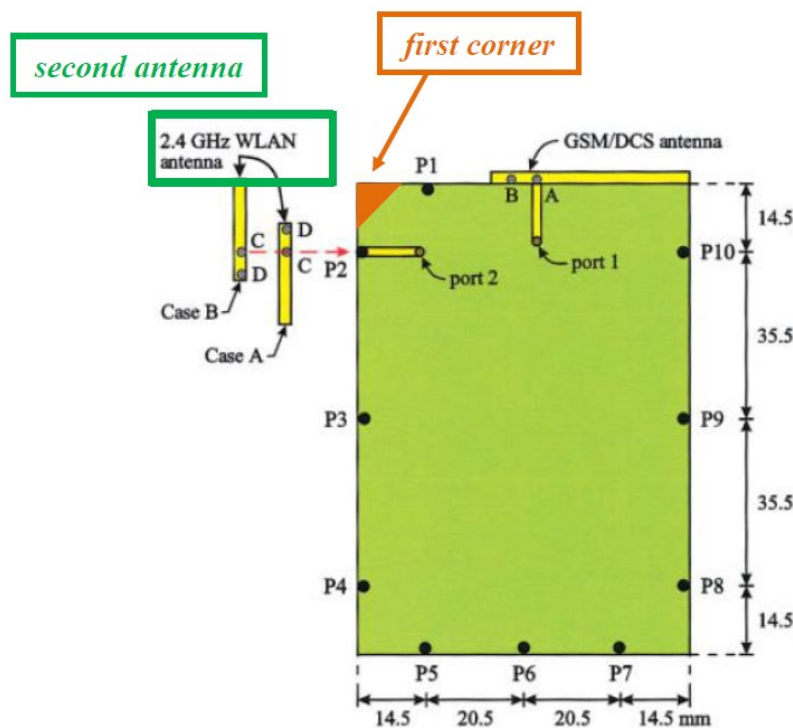
Wong discloses Limitations [8.h]-[8.i] that the Examiner mistakenly deemed inventive.

Limitation [8.h] recites “*the second antenna is arranged substantially close to a first corner of the portable device.*” As shown below, Wong’s WLAN antenna

(“second antenna”) is posited proximate⁶ the upper left corner of the ground plane.

Wong, Fig. 2 (annotated below). The Petition explains that a POSA would have set the size of the Wong+Lee PDA at roughly the same dimensions as the system circuit board because it was conventional for a wireless device’s system circuit board (i.e., the PCB) to have dimensions commensurate with the device housing.

Petition, 14 (citing corroborating evidence). Because Wong’s PCB is sized to fit a portable device, Wong describes the WLAN antenna “*arranged substantially close to a first corner of the portable device*” meeting [8.h]. Petition, 50-51.



⁶ Wong’s WLAN antenna is at least as close to the upper left corner as, for example, antenna 702 in Figure 7(a) of the ’458 patent. Petition, 49-51.

Petition, 50 annotating Wong, Fig. 2

Limitation [8.i] recites “*the first corner of the portable device corresponding to a first end of the first side [sic: intersecting] with an end of the second side of the portable device.*” Wong meets [8.i] for the same reasons it meets [8.h]. Petition, 51-52. Thus, the Examiner allowed claim 8 (and claims 9-13) based on limitations ([8.h]-[8.i]) that were not inventive. EX1002, 489-490. Had the Examiner considered Wong, the Examiner never would have allowed claim 8 based on Limitations [8.h]-[8.i].

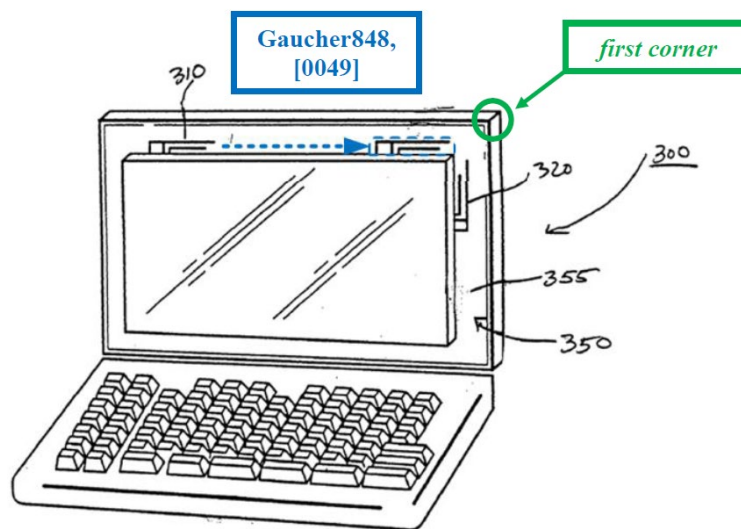
Ground 1A also shows that the simple Wong+Lee combination discussed *supra* §II.A.1 renders claim 8 obvious. Petition, 7-16, 46-52. As explained above, Fractus’s assertion that this “combination[] [is] contrary to the references’ explicit teachings and [has] no likelihood of success” is baseless. *Supra* §II.A.1.

2. Ground 2 Demonstrates That Gaucher also Meets [8.h]-[8.i]

Gaucher explicitly meets [8.h] “*the second antenna is arranged substantially close to a first corner of the portable device*” and [8.i] “*the first corner of the portable device corresponding to a first end of the first side with an end of the second side of the portable device.*” Petition, 92-94 ([8.h]), 94-95 ([8.i]).

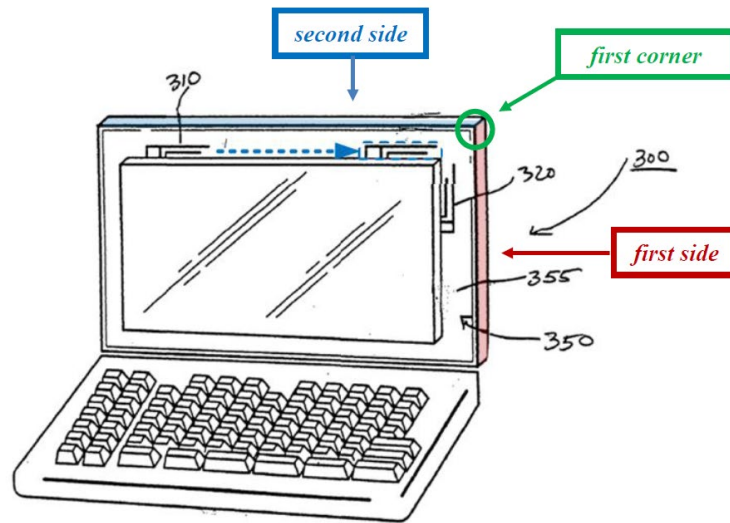
Gaucher incorporates Gaucher848 (EX1013) by reference and implements Gaucher’s antenna 310 (“*second antenna*”) using Gaucher848’s tri-band antenna. Gaucher, [0024], [0030]; Petition, 67 (discussing incorporation), 92-93 (discussing

[8.h]). Gaucher848 says the tri-band antenna can “be located on the right side of the upper portion of the frame (63).” Gaucher848, [0049]. Placing antenna 310 (*second antenna*) on the upper-right portion of support frame 355, as Gaucher848 specifically teaches, results in *the second antenna... arranged substantially close to the **top-right** corner of the portable device* meeting [8.h].



Petition, 94, annotating Gaucher Fig. 3

Gaucher also meets [8.i] because as shown in Figure 3, the first corner corresponds to a *first side* (lid’s right side) of the laptop intersecting with a *second side* (lid’s top side). Gaucher, Fig. 3; Gaucher848, [0049]; Petition, 94-95.



Petition, 95, annotating Gaucher Fig. 3

Thus, the Examiner allowed claim 8 (and claims 9-13) based on limitations ([8.h]-[8.i]) that were not inventive. EX1002, 489-490. Had the Examiner considered Gaucher, the Examiner never would have allowed claim 8 based on Limitations [8.h][[8.i].

Ground 2 shows that Gaucher also meets the other requirements of claim 8 and renders claim 8 obvious. Petition, 90-95. As explained *supra* §II.A.2, Fractus’s suggestion that this implementation of Gaucher is “contrary” to Gaucher’s “explicit teachings” or lacks a “likelihood of success” is baseless.

In short, the Examiner allowed claim 8 (and claims 9-13) based on two limitations ([8.h]-[8.i]) that were not inventive. Had the Examiner considered Gaucher, the Examiner would never have allowed the claims. Doing so was error

material to patentability. It is an appropriate and effective use of the Board's resources to address and remediate this error.

C. The Examiner's Allowance of Independent Claim 14 Because It Recites That the Length and Width of a Rectangle Enclosing a Second Antenna Sum to Less than a Quarter of an Operating Wavelength of That Second Antenna Was Material Error

In the same action in which the Examiner allowed the claims that issued as claims 1 and 8, the Examiner rejected as-filed application-claim 55 as anticipated by Honda (discussed *supra* §§II.A, II.B). EX1002, 487-490. Although this was the first action on application-claim 55, it was a final rejection. EX1002, 486.

Fractus responded by filing a request for continued examination (EX1002, 502), amending application-claim 55 to further recite “*the second antenna is inscribed in a second rectangular area; a sum of a length and a width of the second rectangular area is smaller than a quarter of an operating wavelength of the second antenna is smaller than a quarter of an operating wavelength of the second antenna*” (EX1002, 507), and arguing that the new language distinguished Honda (EX1002, 509-510).

The Examiner then allowed the claim (which issued as claim 14) and the claims depending from it (which issued as claims 15-20). EX1002, 524-525. The Examiner's “statement of reasons for allowance” simply parroted the language in application-claim 55 and agreed that Honda did not teach the limitations that Fractus had argued distinguished the reference (EX1002, 524-525). Thus, the

Examiner allowed claim 14 because he regarded Limitations [14.k] “*the second antenna is inscribed in a second rectangular area*” and [14.l] “*a sum of a length and a width of the second rectangular area is smaller than a quarter of an operating wavelength of the second antenna*” as describing inventive subject matter.⁷ The Examiner was demonstrably wrong.

The Petition’s Grounds 1B and 3 demonstrate that Limitations [14.k]-[14.l] were in the prior art⁸ and that claim 14 is unpatentable.⁹ As in *Hamilton Technologies*, “the examiner did not have the benefit of the teachings” of the prior art used in the IPR Grounds and committed material error by failing to appreciate that Limitations [14.k]-[14.l] were not inventive, and that claim 14 is unpatentable in view of this prior art. IPR2020-01199, Paper 6 at 21. As with claim 1 (*supra* §II.A), either showing is sufficient to demonstrate the Examiner’s material error in allowing claim 14 based on the mistaken belief that Limitations [14.k]-[14.l] were inventive.

⁷ The Examiner allowed certain dependent claims (which issued as claims 15-20) without explanation simply because they depended on the independent claim that had been allowed. EX1002, 525.

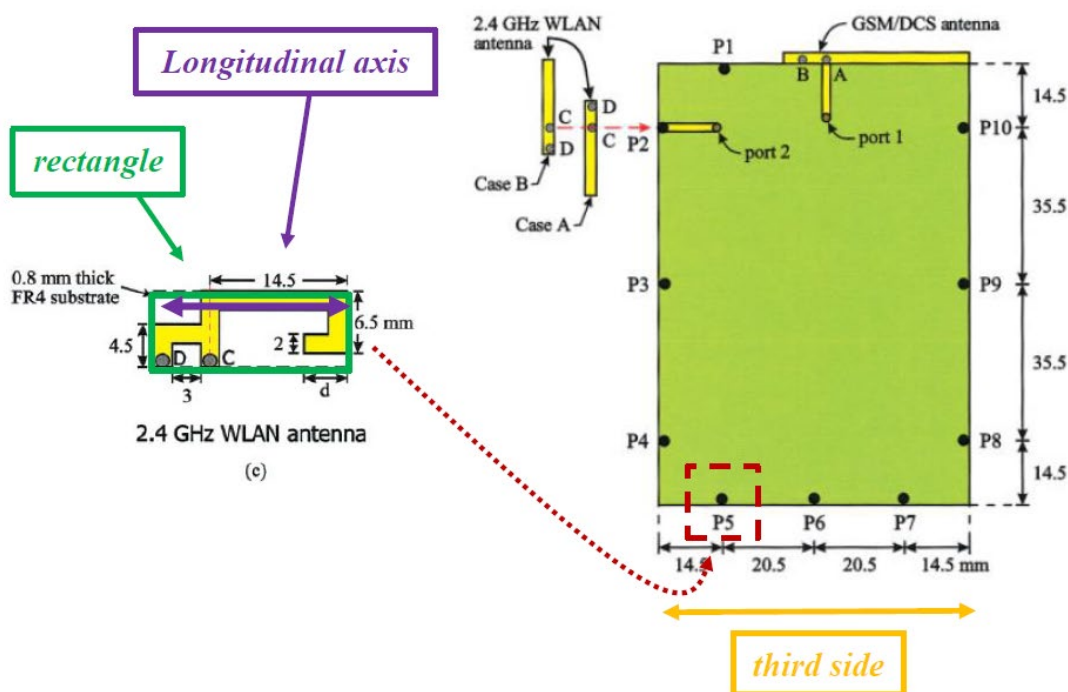
⁸ Petition, 61-62 (Ground 1B), 111-112 (Ground 3).

⁹ Petition, 55-63 (Ground 1B), 99-116 (Ground 3).

1. Ground 1B Demonstrates That Wong Meets [14.k]-[14.l]

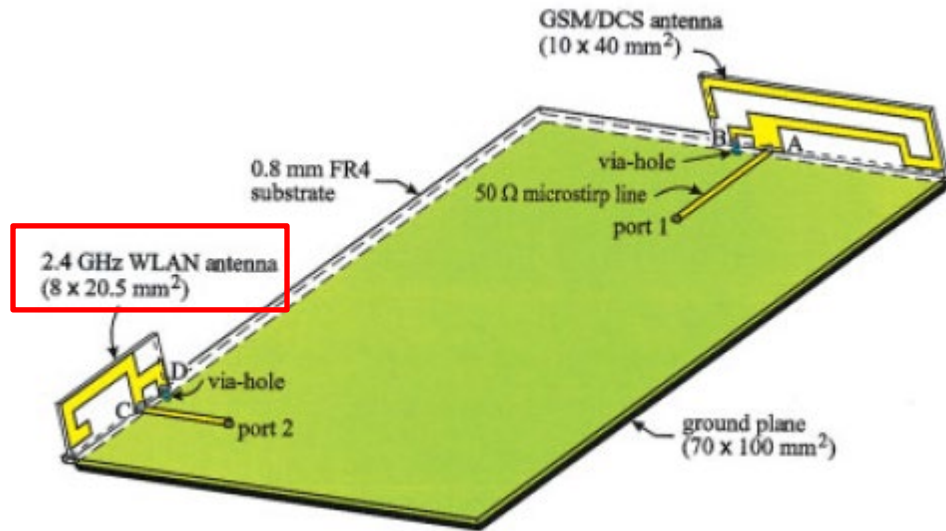
Wong alone renders claim 14 obvious. Petition, 55-63. As explained *supra* §II.A.1, Fractus's suggestion that this implementation of Wong is "contrary" to Wong's "explicit teachings" or lacks a "likelihood of success" is baseless.

There is no reasonable dispute that Wong meets [14.k] "*the second antenna is inscribed in a second rectangular area*" wherein Wong's WLAN antenna is the "*second antenna*." Although Wong does not show the WLAN antenna's orientation when positioned at P5 (e.g., a short edge of the PCB and ground plane), POSAs would have understood that the WLAN antenna would be orientated so that both feeding point C and shorting point D were fixed at the system circuit board's lower edge (the "*third side*" in annotated Figure 2 below). Petition, 60-61. With that orientation, *the WLAN antenna is inscribed in a rectangle* having a longitudinal axis that is parallel to the third side of Wong's ground plane. Wong, Figs. 1(c), 2 (annotated below); Petition, 60-61.



Petition, 60 (annotating Wong, Figs. 1(c), 2)

There is no reasonable dispute that a sum of a length and width of a rectangular area in which Wong’s WLAN antenna (“*second antenna*”) is “*inscribed*” for [14.k] provide “*a sum of a length and a width... smaller than a quarter of*” Wong’s WLAN antenna’s “*operating wavelength,*” thus meeting [14.l]. Petition, 61-62. In Wong, the WLAN antenna is inscribed in a rectangular area of 8mm×20.5mm, so “*a sum of a length and a width of the second rectangular area*” is 28.5 mm. *Id*; Wong, 348, Fig 1(a) (annotated below).



Wong, Fig. 1(a) (annotated)

A quarter of the WLAN antenna’s operating wavelength range—2400-2484 MHz—is 30.2-31.25 mm. Petition, 61-62; Wong 347. Wong meets the limitation for which issued claim 14 was allowed because 28.5mm is less than 30.2 mm, which is “*a quarter of an operating wavelength*” for the WLAN antenna. *Id.*

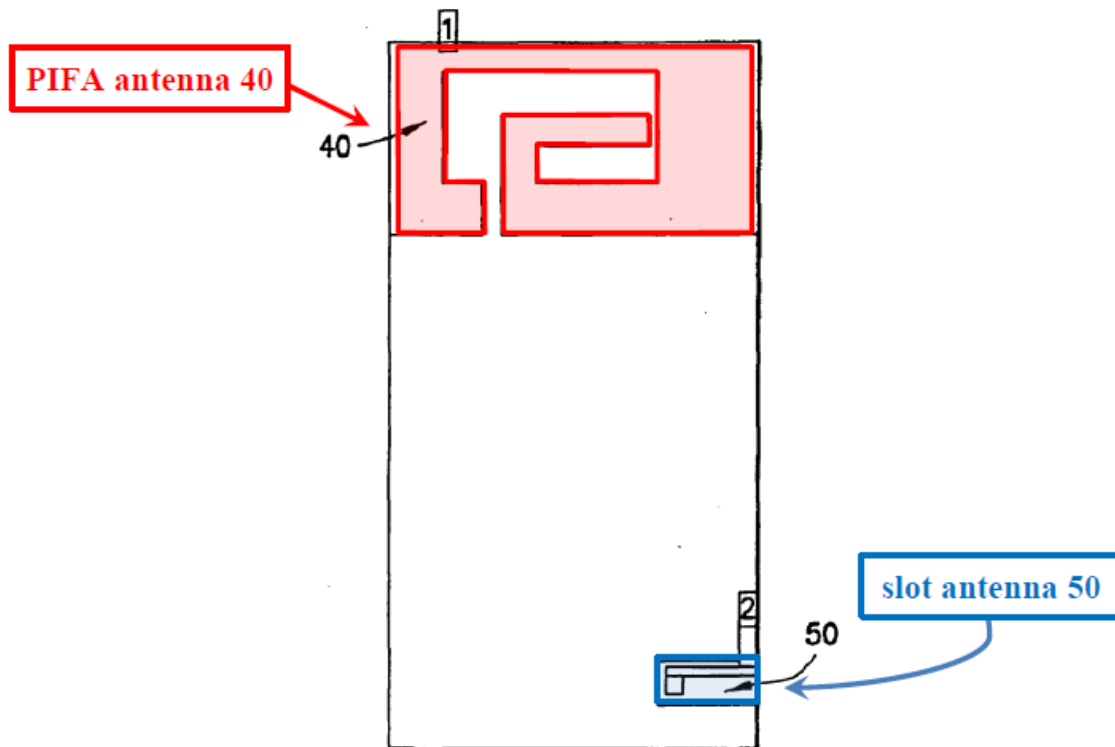
In short, Wong teaches the subject matter in [14.k]-[14.l] that the Examiner mistakenly deemed inventive and relied upon as the basis for allowing claim 14 (and claims 15-20).

2. Ground 3 Demonstrates That Zhao Meets [14.k]-[14.l]

Zhao discloses wireless ultra-wideband (“UWB”) communication systems comprising a quarter-wavelength slot UWB antenna 50 integrated on a 40mm×80mm PCB conventional for mobile handsets. Petition, 99; Zhao, [0002], [0004], [0007], [0031], [0038]. The Petition’s Ground 3 demonstrates that Zhao

renders obvious claim 14. Petition, 99-116. As explained *supra* §II.A.1, Fractus’s suggestion that this implementation of Zhao is “contrary” to Zhao’s “explicit teachings” or lacks a “likelihood of success” is baseless.

Zhao further discloses a dual-band PIFA (planar inverted-F antenna) antenna 40 placed along with the quarter-wavelength slot UWB antenna on the PCB. Petition, 99; Zhao, [0035], [0038], [0042], [0044], [0046]. The arrangement illustrated in Zhao’s Figure 7a (annotated below) presents the best isolation because the two antennas are separated by the greatest distance. Petition, 100-101; Zhao, [0046], [0049], [0055].



Petition, 100 (annotating Zhao, Fig. 7a)

There should be no reasonable dispute that Zhao teaches that the quarter-wavelength slot UWB antenna 50 is inscribed in a rectangular area, meeting [14.k]. Zhao meets [14.k] because Zhao’s slot antenna 50 (“*second antenna*”) is bounded by (*inscribed in*) a *rectangular area* of at most “12.75mm×4 mm,” shown as “rectangular slot 27” in planar view Figure 4. Zhao, Fig. 4, [0042], [0052]; *see also id.*, Fig. 7a (annotated detail below), [0046] (“The location[] of... antenna 50 [is] shown in Figure 7a...”); *see also* Petition, 108-109 (discussing [14.h]).



Petition, 111, annotating Zhao, Fig. 7a (detail)

There is no reasonable dispute that Zhao meets [14.l] because *second antenna* 50 (a “quarter-wavelength” slot antenna) measures ***at most*** “12.75mm×4mm” (Zhao, [0052]), thereby making “*a sum of a length and a width of the second rectangular area*” ***at most*** 16.75 mm, and a quarter of the slot UWB antenna’s operating wavelength range—between 3.1 GHz and 4.9 GHz—is 15.25-24.25 mm. Petition, 111-112; Zhao, [0038]. At 3.1 GHz a quarter of the 97 mm operating wavelength is 24.25 mm. Since 16.75 mm is ***smaller*** than “*a quarter of*

an operating wavelength” of second antenna 50 at 3.1 GHz—e.g., 24.25 mm—
Zhao’s UWB antenna meets [14.l]. Petition, 112.

Thus, Zhao teaches the subject matter in [14.k]-[14.l] that the Examiner mistakenly deemed inventive and relied upon as the basis for allowing claim 14 (and claims 15-20).

* * *

In short, the Examiner allowed claim 14 (and claims 15-20) based on two limitations ([14.k]-[14.l])) that were not inventive. Had the Examiner considered Wong (as shown in Ground 1B) or Zhao (as shown in Ground 3), the Examiner never would have allowed the claims. Doing so was error material to patentability. It is an appropriate and effective use of the Board’s resources to address and remediate this error.

D. The Examiner’s Material Errors in Allowing the ’458 Patent to Issue Weigh Against Discretionary Denial

As demonstrated above, the Examiner erred “in a manner material to the patentability of the challenged claims” by: (1) allowing claim 1 based on Limitation [1.h] despite that limitation reciting known subject matter that was not inventive (*supra* §II.A); (2) allowing claim 8 based on Limitations [8.h]-[8.i] despite those limitations reciting known subject matter that was not inventive (*supra* §II.B); (3) allowing claim 14 based on Limitations [14.k]-[14.l] despite

those limitations reciting known subject matter that was not inventive (*supra* §II.C).

Any one of these errors alone is reason enough why this case should not be discretionarily denied. *Anthony v. ControlTec*, IPR2025-00559, Paper 12 at 2 (Dir. July 16, 2025) (rejecting discretionary denial because material error was shown by the Examiner in overlooking prior art references used in the IPR’s grounds but not cited during prosecution); *Tesla v. Charge Fusion Technologies*, IPR2025-00152, Paper 11 at 2-3 (Dir. June 12, 2025) (same). The material errors committed by the Examiner make discretionary denial unwarranted because “it is an appropriate use of Office resources” to review the claims to correct the Office’s previous error. *Anthony*, IPR2025-00559, Paper 12 at 2.

1. Correcting the Examiner’s Material Error Outweighs Any Alleged Settled Expectations

Correcting the Office’s material error outweighs any settled expectations by the Patent Owner. In *Anthony*, like here, the examiner deemed subject matter allowable in a first action on the merits and the Director determined that the examiner’s material error in overlooking the references used in the IPR grounds outweighed the fact that challenged patents had been in force for 17 and 18 years. *Anthony*, IPR2025-00559, Paper 12 at 2. In *Xencor v. Merus*, the Director determined that the Office’s material error in allowing the patent outweighed settled expectations for a 9 year old patent. IPR2025-00604, Paper 12 at 2-3 (Dir.

July 17, 2025). Here, reviewing any one of the Examiner’s material errors outweigh the fact the ’458 Patent issued 11 years ago (August 2014).

2. If Trial Were Expected Before FWD, Correcting the Examiner’s Material Error Would Outweigh That Factor and Weigh Against Discretionary Denial

As shown below, FWD is expected more than two months before trial would be held in the parallel EDTX litigation. *Infra* §IV.A. But even if FWD were expected after trial in the parallel litigation (it is not), correcting the Examiner’s material errors outweighs that factor and weighs against discretionary denial. In *Microsoft v. Partec*, the Director rejected discretionary denial and determined that correcting the examiner’s material error outweighed a showing that a trial in a parallel proceeding was expected before FWD. IPR2025-00318, Paper 9 at 2-3. The Director reached the same conclusion in *Padagis*, IPR2025-00464, Paper 12 at 2-3.

III. FRACTUS’S ALLEGED “SETTLED EXPECTATIONS” BASED ON ITS LETTER THREATENING GEOTAB WITH SUIT ON OVER 100 PATENTS WHILE WITHHOLDING ANY INFRINGEMENT ANALYSIS ARE COMMERCIALY UNREASONABLE

Fractus argues that it had “settled expectations” because the ’458 Patent issued “over ten years ago” and Geotab was aware of the ’458 Patent “since at least 2021.” Request, 17. Fractus’s suggestion that Geotab “has had many years in which to raise these invalidity arguments... yet has chosen not to do so” (*id.*) is commercially unreasonable and relies on cases that are readily distinguishable.

Geotab and Fractus are not competitors. Geotab is in the fleet tracking business. Fractus's patents do not relate to fleet tracking. Fractus's '458 Patent concerns a mobile communications device with two antennas which, at best, involves only two of *many* components that can be used in a fleet tracking system. Any suggestion that Geotab should actively monitor patents issuing that cover any and all of the components that could go into Geotab's fleet tracking system and challenge all of those patents early in their lives is commercially unreasonable.

Fractus's suggestion that Geotab should have challenged the '458 Patent when Fractus first brought it to Geotab's attention is also commercially unreasonable. Fractus first contacted Geotab in late 2021, by letter that touted Fractus's "very large patent portfolio" and stated that "Fractus has analyzed some of Geotab's products and determined that Geotab... infringe[s] Fractus's patents." EX1043, 4. The letter listed nine patents and used checkboxes to identify which of three Geotab products supposedly infringed. *Id.*, 6-8. But the letter was clear that these were only "examples." *Id.*, 5 ("To be very clear, Exhibit I provides only examples."). The letter listed *over 100 patents* "available for licensing." *Id.*, 9. Any suggestion that Geotab should have immediately filed challenges against all these patents is commercially unreasonable.

So too is any suggestion that Geotab should have at least immediately challenged all nine "examples" that Fractus's letter identified. Fractus's letter did

not substantiate its conclusory (checked-box) assertion that any of those patents were infringed by Geotab. Notably, when Fractus later filed suit in the Eastern District of Texas, Fractus did not assert six of the nine “example” patents that Fractus’s letter specifically identified.¹⁰ EX2005, 1. The suggestion from Fractus—a non-practicing entity that does not commercialize products—that Geotab should have invested the substantial resources necessary to immediately challenge all nine of the “example” patents the letter identified despite Fractus failing to substantiate any infringement allegation is once again commercially unreasonable.

Worse yet, Fractus discouraged Geotab from taking any immediate action and instead encouraged Geotab to engage in business discussions. Specifically, Fractus’s letter stated that “Fractus has *a strong preference for resolving intellectual property infringement by negotiation* and invites Geotab to engage in meaningful discussions to determine where the companies’ interests align.” *Id.*, 5. Geotab attempted to do just that by promptly responding to Fractus’s letter. EX1044, 3; EX1045. Accepting at face value Fractus’s representation that it had “a strong preference for... negotiation” (EX1043, 5), Geotab requested that Fractus

¹⁰ The ’458 Patent, ’365 Patent, and ’677 Patent are the only patents identified in the letter that were among the five patents asserted in the Eastern District of Texas.

“provide claim charts... so that Geotab can understand the basis for Fractus’s claims.” EX1045.

But Fractus refused to provide any infringement analysis to support its conclusory accusations of infringement. Rather than provide the requested claim charts that Fractus asserted it possessed, Fractus responded with an “NDA” (EX1046) “to protect the exchange of information.” EX1044, 2-3. Geotab notified Fractus that signing an NDA was unnecessary given that any claim charts would be based on non-confidential information, and Geotab again requested that Fractus provide the claim charts it allegedly had that substantiated its infringement accusations. *Id.*, 2. Fractus again refused to provide its claim charts absent Geotab signing the NDA. *Id.*, 1-2. In the final communication between the parties on January 25, 2022, Geotab reiterated that “impos[ing] certain risks, liabilities, and potential claims on the parties” to an NDA was unnecessary because Fractus’s claim charts contained only non-confidential information and Geotab renewed its request that Fractus provide claim charts to substantiate its infringement allegations. *Id.*, 1. Fractus never responded to that final email. Instead, Fractus waited almost *three years* and then sued Geotab in the Eastern District of Texas on December 6, 2024. EX2005.

Allowing a non-practicing entity like Fractus to insulate its weak and facially-unpatentable claims from Office review by simply sending a letter

accusing a manufacturer like Geotab of infringing more than 100 patents, while refusing to substantiate those accusations, would contravene the very purpose of IPRs which is to weed out bad patents like the '458 Patent. *Thryv v. Click-to-Call Technologies*, 590 U.S. 45, 54 (2020).

Indeed, even if the Director were to find that Fractus had “settled expectations” for the '458 Patent, correcting the Office’s material error in allowing the '458 Patent to issue would outweigh those “settled expectations.” *Supra* §II.D.1; *Anthony*, IPR2025-00559, Paper 12 at 2; *Xencor*, IPR2025-00604, Paper 12 at 2-3; *Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9 at 2 (Dir. July 31, 2025).

IV. THE *FINTIV* FACTORS WEIGH AGAINST DISCRETIONARY DENIAL

Discretionary denial under *Apple v. Fintiv*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential) (“*Fintiv*”) is unwarranted. The statutory FWD deadline of November 28, 2026 is highly likely to precede Fractus’s district court trial against Petitioner Geotab in the Eastern District of Texas. The *Fintiv* factors weigh heavily against discretionary denial.

Fractus argues that “Trial in the District Court Litigation is set for September 14, 2026.” Request, 11. What Fractus defines as “the District Court Litigation” is actually a consolidation of Fractus’s case against Verizon with Fractus’s case against Geotab. Request, 9. Fractus neglected to inform the

Director that the Court consolidated those cases only for *pre-trial* issues. EX1047. There will not be a consolidated trial against Petitioner Geotab and Verizon; those cases will be tried separately. EX1047 (the cases are consolidated for pre-trial issues); 35 U.S.C. §299; *infra* §IV.A.2 (by statute these cases cannot be consolidated for trial). Fractus's case against *Verizon* is the lead case. EX2001 at 7 (entry 17). Even if one of Fractus's trials were to begin on September 14, 2006, there is no reason to believe it would be the trial against Geotab.

Worse yet, using Fractus's unarticulated argument that jury selection in a consolidated case sets trial for each consolidated case, Fractus disregards that (including the Verizon and Geotab actions) Judge Gilstrap has currently set jury selection for September 14, 2026 in *fifteen* cases. *Infra* §IV.A.2; EX1066 (listing cases consolidated only for pre-trial issues as separate cases). All fifteen cases cannot begin trial on the same day because the Court can only hold one trial at a time. Contrary to Fractus's misleading and incomplete presentation of the facts, there is no reason to believe that Fractus's case against Geotab will go to trial on September 14, 2026, as Fractus alleges.

The median-time-to-trial statistics in the Eastern District of Texas trial are a far more reliable indicator of when trial is likely to take place in Fractus's litigation against Petitioner Geotab. *NL Giken*, IPR2025-00250, Paper 14 at 2 (where a scheduled trial date preceded the FWD date but "the time-to-trial statistics suggest

trial would not begin until” after the FWD date, the Director correctly found that “it is likely that a final written decision in this proceeding will issue before the district court trial occurs” and referred the petition to the merits panel).

Applying the 25.9 month median-time-to-trial statistics in the Eastern District of Texas (*infra* §IV.A.1) indicates that a trial is not likely to be held until February 2, 2027, which is **65 days (more than two months) after the FWD** is expected by November 28, 2026. The earlier FWD weighs against discretionary denial under *Fintiv* factor 2.

Indeed, each *Fintiv* factor weighs against discretionary denial except factor 5 (same parties), which is neutral. A holistic assessment of the *Fintiv* factors makes clear that discretionary denial is not warranted.

Factor	Weights Against Discretionary Denial	Neutral	Basis
1	<i>infra</i> §IV.E		Geotab’s motion to stay is pending and Judge Gilstrap has granted stays post-institution in cases with less favorable timelines.
2	<i>infra</i> §IV.A		FWD will precede EDTX trial.
3	<i>infra</i> §IV.C		Petitioners diligently filed the Petition, and the <i>Markman</i> hearing and close of expert discovery will occur months after the institution due date.
4	<i>infra</i> §IV.B		Minimal overlap exists between the issues and the claims in the Petition and those that will reach trial in EDTX.

Factor	Weights Against Discretionary Denial	Neutral	Basis
5		<i>infra</i> §IV.F	Same parties are involved.
6	<i>infra</i> §IV.D		Examiner’s material error and strong merits favor institution.

A. Factor 2 Weighs Strongly Against Discretionary Denial Because the FWD Will Issue Before Trial

Despite the fact that the currently-scheduled trial date in EDTX falls before the date when the FWD will issue, the median time-to-trial statistics demonstrate that the trial is likely not going to take place until after the FWD issues. Under similar facts, the Director recently determined that discretionary denial was not warranted. *NL Giken*, IPR2025-00250, Paper 14 at 2 (referring Petition to the merits panel; the only consideration the Director expressly discussed was that while the scheduled trial date preceded the projected FWD date the “time-to-trial statistics suggest trial would not begin until” after the FWD date so “it is likely that” FWD “will issue before the district court trial occurs”).

1. Using the Median-Time-to-Trial Statistics for EDTX Reveals That Trial Will Likely Not Occur Until After the FWD

The median-time-to-trial for EDTX is 25.9 months from the complaint’s filing. EX1048, 35. Fractus filed the complaint on December 6, 2024. Applying the 25.9 month statistic means that trial is not expected to start until February 2,

2027.¹¹ EX2005 (Complaint filed Dec. 6, 2024). The statutory FWD deadline is November 28, 2026, more than two months (65 days) *before* trial under the median-time-to-trial statistics. *See* Paper 6 at 1 (filing date accorded on May 28, 2025). This weighs heavily against discretionary denial under *Fintiv* factor 2. *NL Giken*, IPR2025-00250, Paper 14 at 2.

Fractus relies on data “[o]ver the past two years” that purportedly illustrates that “Judge Gilstrap has an average time-to-trial of 22 months,” alleging that this means that a trial is likely to beat (albeit just barely) the FWD. Request, 14-15. The Director should reject this for several reasons.

First, the Director evaluates the median-time-to-trial based on the district-wide statistic, not numbers for individual judges. *See, e.g., NL Giken*, IPR2025-00250, Paper 14 at 2.¹²

¹¹ 25.9 months is 788 days using $\left(25.9 \text{ months} \times \frac{365 \text{ days}}{12 \text{ months}}\right)$.

¹² The Federal Court Management Statistics explain that EDTX statistics for the 12 months ending March 31, 2025 includes an average of 13 trials per judge.

EX1048, 35. Since EDTX has 10 active judges (<https://www.txed.uscourts.gov/?q=eastern-district-judges>), the median-time-to-trial captures the statistics for at least 130 civil trials. Since this samples at least 10 times as many civil trials as

Second, Fractus’s two-year window captures stale time-to-trial numbers that fail to account for the recent case load increases that have impacted Judge Gilstrap’s trial calendar and caused the Eastern District’s median-time-to-trial to jump 22% from 21.3 months (on March 31, 2024) to 25.9 months (on March 31, 2025) over the last year.¹³ EX1048, 35. A 12 month sample interval should be applied, just like the Federal Court Management Statistics calculate and report.

Third, in the twelve months ending August 28, 2025 (the date of this Opposition), Judge Gilstrap held 13 patent trials, with a median-time-to-trial of 759

Judge Gilstrap held in a 12 month interval, it reflects a larger sample of events that can derail trial schedule, making it a more accurate measure of median-time-to-trial under the district’s recent 12 month case load than limiting the analysis to the much smaller number of trials Judge Gilstrap himself has held in a similar 12 month interval.

¹³ The 22% increase in the district-wide median-time-to-trial is actually less than the increase in the size of Judge Gilstrap’s patent docket in that time frame. Between 2023 and 2024 Judge Gilstrap’s patent litigation docket increased more than 76%, with 453 case filings in 2023 increasing to 799 case filings in 2024. So far in 2025 another 727 patent cases have been assigned to Judge Gilstrap (with four months left to go). EX1074.

days (and an average of 760.8 days). EX1067. Both the median and “average” number of days round to **25 months**.¹⁴ That is materially longer than the “22 months” Fractus asserts (Request, 14) because those additional three months means that trial is likely to occur *after*, rather than before, the FWD. Thus, even if the Director considered Judge Gilstrap’s median-time-to-trial in patent cases to be the most reliable data, the Director should use the most recent 12-month data which reveals a time-to-trial of 25 months. Adding 25 months to the December 6, 2024 date on which Fractus filed the EDTX complaint reveals that Fractus’s case against Geotab is not likely to go to trial before January 2027, which is after the FWD is expected in this IPR. That weighs against discretionary denial.

2. The Evidence Does Not Support Fractus’s Argument That a Trial Will Begin on September 14, 2026

Fractus alleges that the Director should use September 14, 2026 as the anticipated trial date because Judge Gilstrap set jury selection to begin in the Geotab litigation on that date. Request, 9, 11. The Director should reject that argument for several reasons.

¹⁴ The 25 months is determined by $\left(\text{days} \times \frac{12 \text{ months}}{365 \text{ days}}\right)$ for Judge Gilstrap’s median (759 days) or average (760.8 days) time-to-trial.

First, Judge Gilstrap only consolidated the Geotab litigation with the Verizon litigation (the lead case) for **pre-trial** issues. EX1047. Verizon and Geotab will have separate trials.¹⁵ 35 U.S.C. §299. When Judge Gilstrap set jury selection for September 14, 2026, he did so in the lead case (i.e., the **Verizon** case) and provided no indication that this jury selection was for the Geotab case. EX1049.

Second, even if the September 14, 2026 jury selection date referred to the Geotab litigation, statistically that date is **highly unlikely** to hold true. Over the

¹⁵ As Judge Gilstrap has recognized, 35 U.S.C. Section 299 “bars...consolidation of [accused infringers’] cases for trial, if the only common fact and transaction among the defendants is that they are alleged to have infringed the same patent.” *Team Worldwide Corp. v. Wal-Mart Stores, Inc.*, 287 F.Supp.3d 651, 656 (E.D. Tex. 2018) (Gilstrap, J.) (quoting 157 Cong. Rec. 25402 (Sept. 8, 2011) (statement of Sen. Kyl)). That is true for Verizon and Geotab. Consistent with Section 299, Judge Gilstrap holds separate trials for cases that were consolidated for pretrial issues. For example, Judge Gilstrap consolidated *Netlist, Inc. v. Samsung Elecs. Co.*, No. 2:22-cv-00293, with *Netlist, Inc. v. Micron Tech. Texas, LLC*, No. 2:22-cv-00294, for pretrial issues (EX1069), but held separate trials in -00293 on Nov. 12, 2024 (EX1070) and in -00294 on May 20, 2024 (EX1071).

past year, only one of thirteen trials in Judge Gilstrap's court (No. 2:23-cv-00427) began on the originally-scheduled date. EX1067. One case (No. 2:22-cv-00494) did not go to trial until more than two and a half years (29.3 months) after the complaint was filed. *Id.*

Third, Judge Gilstrap currently has set jury selection on September 14, 2026 for *at least 15 separate cases*. EX1066 (listing cases). At most *1* of those 15 cases will be tried starting September 14, 2026. If all cases are treated as equally likely to start trial on September 14, 2006, then there is *more than a 93% chance [i.e., 14 in 15] that Geotab will not have trial* starting September 14, 2026. In *Boe Technology Group*, the Board found that factor 2 weighed *against* discretionary denial (or was at worst neutral) because Judge Gilstrap had set ten other cases for jury selection on the same day as the parallel litigation.

Because a number of cases are scheduled for jury selection on [the same date] in addition to the parallel proceeding, there is some *uncertainty whether the trial in that proceeding would actually begin on that date*. Even if many of the other cases settle or are disposed of before trial, even a brief postponement of the trial because one or more of the other cases remain may delay trial in the parallel proceeding until after a final decision would issue in an *inter partes* review.

Boe Technology Group Co., Ltd. v. Optronics Sciences LLC, IPR2024-01130, Paper 16 at 10 (Jan. 27, 2025) (instituting IPR).

3. Citing a Laundry List of Director Decisions Does Not Help Fractus

Fractus's Request devotes almost three pages to listing nineteen cases where the Director has discretionarily denied institution and in which there was a parallel litigation in EDTX with a "scheduled trial date" that beat the FWD. Request, 12-14.

Those cases are inapposite because none present the facts here where the median-time-to-trial statistics indicate that trial is not likely to occur until after the FWD. Eleven of the nineteen cases Fractus cites considered median-time-to-trial statistics and in all eleven the trial date under that median-time statistics was *earlier* than the FWD date (*see* EX1072 (listing relevant trial dates under median-time-to-trial where discussed in the decision))—not after the FWD date as here. Fractus's remaining eight cases did not discuss median-time-to-trial at all.

In contrast to the inapposite cases that Fractus cites, the *NL Giken* case was one in which the scheduled trial date was before the FWD due date but the district-wide median-time-to-trial statistics showed that a trial was unlikely to occur until *after* the FWD due date. *NL Giken*, IPR2025-00250, Paper 14 at 2. The Director found that those facts weighed *against* discretionary denial and should make the same finding here.

4. Factor 2 Weighs Against Discretionary Denial and Favors Institution

The facts detailed above demonstrate that it is likely that this IPR will reach an FWD *before* a trial in EDTX. This weighs against discretionary denial.

B. Factor 4 Weighs Against Discretionary Denial Because There Is Minimal Overlap Between the Issues and Patent Claims Addressed in the Petition and Those That Will Be Resolved in the EDTX Trial

Geotab’s timely-filed *Sotera* stipulation (Petition, 120) and Judge Gilstrap’s forced reduction in claims prior to trial mean that there will be minimal overlap between this IPR and the EDTX case with respect to the issues raised and the claims to be adjudicated. This weighs heavily against discretionary denial.

1. Fractus Disregards the Effect of Geotab’s *Sotera* Stipulation

Fractus’s factor 4 analysis alleges that “[t]he invalidity contentions... include the same arguments made in the Petition.... Accordingly, the fourth *Fintiv* factor favors discretionary denial.” Request, 19.¹⁶ Fractus cites no case law supporting this bald assertion—because none does.

¹⁶ Fractus inconsistently argues that the two proceedings have “identical invalidity issues” and that the “invalidity arguments in the district court are much more expansive.” Request, 16.

Fractus ignores the impact of Geotab’s *Sotera* stipulation. A *Sotera* stipulation remains a “highly relevant” consideration in the discretionary denial analysis. Boalick Memorandum (Mar. 24, 2025), 2-3.¹⁷ If a trial is instituted in this IPR, the *Sotera* stipulation will take effect and ensure that Petitioners “will not pursue, in the Texas Litigation, any ground raised or that reasonably could have been raised in IPR.” Petition, 120. Thus, contrary to Fractus’s assertions, there will be little to *no* overlap of the issues raised in the petition with those in the litigation so factor 4 weighs against denial.

Fractus’s suggestion that Geotab’s *Sotera* stipulation would have “minimal” efficiency because Geotab identified “more expansive” invalidity arguments in the district court than in IPR is baseless. Request, 16-17. While it is unclear what Fractus means by “more expansive” invalidity arguments, it appears to refer to product prior art that Geotab identified in the district court. Geotab’s prior art invalidity contentions do not combine any product with an antenna or other component in Wong, Lee, Gaucher, or Zhao, and are thus not cumulative of anything that will be decided in IPR. Geotab’s *Sotera* stipulation will prevent the district court from deciding invalidity based on printed publication prior art that

¹⁷ https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf

could have been raised in IPR. That removes overlapping invalidity issues from the Geotab litigation and weighs against discretionary denial.

Fractus alleges that “Petitioner here is asking the Board to assist it in seeking two bites at the apple” because Verizon has “raised the identical invalidity issues to those in this proceeding.” Request, 16. Nothing supports this incredible assertion. As Fractus admits, there is no relationship between Geotab and Verizon. Request, 16 (Verizon is “not a real party in interest here”). That Fractus may face validity challenges from Verizon as well as from Geotab is a direct result of Fractus’s decision to sue two unrelated parties simultaneously.

Geotab’s filing of a *Sotera* stipulation demonstrates that it is not seeking “two bites at the apple” and instead seeks to use the IPR process to “weed out” Fractus’s bad patent—precisely as the IPR process was intended to be used. *Thryv*, 590 U.S. at 54 (Congress intended for IPRs to “weed out bad patent claims efficiently” to avoid “overpatenting and its diminishment of competition.”). Geotab’s *Sotera* stipulation also eliminates “concerns of inefficiency and the possibility of conflicting decisions” in Fractus’s EDTX litigation against Geotab and ensures that the Petition presents “materially different grounds, arguments, and/or evidence than those presented in the district court” which “weigh[s] against exercising discretion to deny institution” under factor 4. *Fintiv*, IPR2020-00019, Paper 11 at 12-13.

Moreover, as discussed *infra* §IV.E (factor 1), there is a strong likelihood that a stay will be granted if an IPR trial is instituted. If so, the stay would extend to the Verizon case that is consolidated with Geotab’s case for pre-trial due dates.

2. Fractus Disregards That the IPR Will Test the Patentability of Far More Claims than the Geotab Litigation, Demonstrating the Minimal Overlap Between the IPR and the Litigation

Fractus also disregards that far fewer claims will be adjudicated in the district court case. Fractus opted to assert in EDTX only 10 of the patent’s 20 claims. The Petition challenges 18 claims. *Compare* EX1010, 2 (identifying 10 asserted claims from the ’458 Patent) *with* Petition, 2 (challenging ’458 Patent claims 1-10 and 12-19). Furthermore, Judge Gilstrap adheres to EDTX’s Model Patent Order, which will force Fractus to reduce the number of asserted claims to no more than *five claims per patent* and *sixteen in total* across the five patents asserted in Fractus’s litigation against Geotab. EX1050, ¶3. Thus, Fractus cannot try more than five claims from the ’458 Patent in EDTX, thirteen fewer claims than the eighteen claims challenged in IPR. *Id.* This weighs heavily against discretionary denial. *POSCO v. ArcelorMittal*, IPR2024-01377, Paper 11 at 15-16 (Mar. 18, 2025) (factor 4 “weighs heavily against discretionary denial” where Petition “addresses 16 more claims” than the parallel litigation); *Samsung Electronics v. SiOnyx*, IPR2024-01431, Paper 21 at 16 (Apr. 10, 2025) (factor 4 weighs against discretionary denial where parallel litigation will not adjudicate

invalidity of claim challenged in petition); *Samsung Electronics v. Dynamics*, IPR2020-00504, Paper 16 at 9 (Oct. 13, 2020) (discussing *Fintiv* factor 4: discretionary denial was not warranted because “claims remain in the [challenged patent]” that did not overlap with those addressed by the tribunal in the parallel litigation “and Petitioner has challenged their patentability in this proceeding.”).

3. Fractus’s Pattern of Serial Patent Litigations Weighs Against Discretionary Denial So That the Office Can Correct the Material Error That Resulted in Issuing Unpatentable Claims

Given Fractus’s nearly 20-year history of filing serial patent litigations against multiple defendants, one or more future suits involving these unpatentable claims is highly probable. To date, despite Fractus’s litigious practices, few of its patents have been substantively tested. Fractus has a history of settling cases early before the merits can be reached and its facially-unpatentable claims invalidated. EX1073 (listing cases that Fractus “Settled/Voluntarily Terminated”). This practice has encouraged Fractus to engage in repeated assertions of its patents without its claims being tested.

The Board is uniquely positioned to address the unpatentability of nearly every claim of the ’458 Patent in a single matter and avoid duplicative litigation and potentially inconsistent results reached by different tribunals against different current and future defendants. *Berkshire Hathaway Energy Company v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 2 (Dir. July 2, 2025) (rejecting discretionary

denial because resolving the dispute between the parties at the Office was more efficient than multiple district court cases). Having a merits panel address the unpatentability of the claims would be an appropriate and highly effective use of the Board’s resources because it will serve as an alternative to multiple district court cases against different parties that will each address only a handful of claims of the ’458 Patent at a time and could potentially lead to inconsistent results.

Factor 4 weighs heavily against discretionary denial.

C. Factor 3 Weighs Against Discretionary Denial

Factor 3 considers the “investment in the parallel proceeding by the court and parties.” *Fintiv*, IPR2020-00019, Paper 11 at 6, 9-12.

Factor 3 considers whether “the district court has issued substantive orders related to the patent” and whether “petitioner filed the petition expeditiously.”

Fintiv, Paper 11 at 9-12. As detailed below, the Petition was filed expeditiously **and** EDTX has issued no substantive orders related to the patent. EX2004 (amended docket control order in the consolidated Verizon/Geotab litigations).

Thus, factor 3 weighs against discretionary denial. *See Tesla, Inc. v. Autonomous Devices, LLC*, IPR2023-01172, Paper 21 at 8-9 (Jan. 8, 2024) (instituting trial).

1. Petitioner’s Diligence Favors Institution

Geotab filed its Petition on April 30, 2025, just 1.5 months after Fractus served infringement contentions on March 12, 2025 (EX1010, 8), which the Board has found to be diligent and weighs against discretionary denial. *Dish Network*

LLC v. Broadband iTV, Inc., IPR2020-01359, Paper 15 at 19-20 (Feb. 12, 2021)

(granting institution; petitioner established diligence by filing petition approximately three months after being served infringement contentions);

Berkshire Hathaway, IPR2025-00274, Paper 23 at 3 (referring petition to merits panel; petitioner demonstrated diligence by filing petition three weeks after being served infringement contentions), *citing id.*, Paper 18 at 46-47.

Moreover, Fractus served Geotab on January 3, 2025. EX1051. Geotab promptly filed its Petition on April 30, 2025, more than eight months before the statutory bar date on January 3, 2026. 35 U.S.C. §315(b). That likewise weighs against discretionary denial. The Board has found petitioners diligent even when the IPR was filed closer to the statutory deadline and found that the petitioner's diligence weighed against discretionary denial. *See Samsung Electronics Co., Ltd. v. Headwater Research LLC*, IPR2024-01396, Paper 13 at 7 (Apr. 1, 2025) (petitioner who filed IPR "approximately 4 months" before statutory deadline was diligent which weighed against denial); *Hanwha Solutions Corp. v. Maxeon Solar Pte. Ltd.*, IPR2024-01198, Paper 17 at 32-34 (Feb. 26, 2025) (instituting IPR where petition was filed "fewer than four months after [the] complaint"); *Nikon Corp. v. Optimum Imaging Technologies, LLC*, IPR2024-01373, Paper 17 at 18-21 (Apr. 23, 2025) (instituting trial; petitioner filing three months after service weighed against discretionary denial); *Savant Technologies LLC v. Feit Electric*

Co., Inc., IPR2025-00260, Paper 16 at 3 (Dir. June 12, 2025) (finding diligence when petition filed less than three months after claims asserted; referring petition to merits panel).

By any metric, Petitioner was diligent in filing the Petition which weighs against discretionary denial.

2. Close of Expert Discovery After the Due Date for Institution Weighs Against Discretionary Denial

Based on the May 28, 2025 notice of filing date accorded (Paper 6), the institution decision is due no later than November 28, 2025. Expert discovery closes in the EDTX litigation against Geotab on June 2, 2026—more than six months *after* the institution decision is due. EX2004. This weighs against discretionary denial. *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01433, Paper 13 at 11 (Apr. 7, 2025) (instituting trial; expert discovery closing just 2.5 months after institution due date weighed against discretionary denial); *Kia Corp. v. Emerging Automotive LLC*, IPR2024-01167, Paper 14 at 17 (Jan. 27, 2025) (same, instituting trial); *Samsung Display Co., Ltd. v. Pictiva Displays Int’l Ltd.*, IPR2024-01222, Paper 12 at 7 (Mar. 6, 2025) (instituting trial; weighing factor 3 in favor of institution given that expert discovery would not have begun by the institution deadline).

3. ***Markman* Hearing After Institution Due Date Weighs Against Discretionary Denial**

The *Markman* hearing is set for March 10, 2026—more three months *after* the institution decision is due by November 28, 2025. EX2004. Opening claim construction briefs are not due until January 27, 2026, two months *after* the institution decision is due. *Id.* This weighs against discretionary denial. *See SAP*, IPR2024-01433, Paper 13 at 11 (instituting trial; under factor 3 a *Markman* hearing set for 17 days after institution decision deadline “*favours institution*”); *Kia*, IPR2024-01167, Paper 14 at 17 (instituting trial; under factor 3 a *Markman* hearing 18 days after institution decision deadline “weighs *against discretionary denial*”). In addition, no exchange of terms or preliminary claim construction filings have occurred in the Geotab litigation, which also weighs against discretionary denial. *SAP*, IPR2024-01433, Paper 13 at 11 (factor 3 favored institution where claim construction terms had been exchanged but claim construction briefing was not complete). By the time the institution decision is due, only preliminary claim constructions will have been exchanged (three days prior to the deadline for the institution decision). EX2004 (amended docket control order).

Thus, factor 3 weighs against discretionary denial.

D. Factor 6 Weighs Against Discretionary Denial Because the Examiner Materially Erred and the Merits Are Strong

Factor 6 considers “[o]ther circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv*, Paper 11 at 5-6. Several “other circumstances” are present here that weigh against discretionary denial in this case, including the examiner’s material error during prosecution and the strong merits of the Petition.

1. The Examiner’s Material Error Weighs Against Discretionary Denial

As discussed *supra* §II, the Examiner materially erred during prosecution by failing to appreciate that the second antenna size and placement along a device PCB were known and that the challenged claims are unpatentable.

Correcting the Examiner’s material error is an additional “circumstance[]” that impacts the *Fintiv* analysis and weighs against discretionary denial. *Fintiv*, Paper 11 at 5-6; *Anthony*, IPR2025-00559, Paper 12 at 2 (rejecting discretionary denial because material error was shown by the Examiner in overlooking prior art references used in the IPR’s grounds but not cited during prosecution); *Tesla v. Charge Fusion*, IPR2025-00152, Paper 11 at 2-3 (same).

2. The Petition’s Strong Merits Weigh Against Discretionary Denial

In *Tesla Inc. v. Intellectual Ventures II LLC*, IPR2025-00339, Paper 10 at 2-3 (Dir. Jun. 13, 2025), the Director referred petitions to the merits panel after

finding that strong merits weighed against discretionary denial. In this case the Petition's merits are strong and weigh against discretionary denial.

The Petition shows that the '458 patent's purportedly inventive antenna placement (i.e., [1.h], [8.h]-[8.i]) was known and taught by both Wong and Gaucher. *See supra* §II.A-II.B. The Petition shows that the '458 patent's purportedly inventive antenna size (i.e., [14.k]-[14.l]) was known and taught by both Wong and Zhao. *See supra* §II.C.

The Petition's Ground 1A is based on a simple combination of Wong and Lee in which Wong's dual band cellular antenna is replaced with Lee's quad-band antenna. *See supra* §II.A.1. The resulting Wong+Lee combination indisputably meets claims 1 and 8. *See supra* §§II.A.1, II.B.1. The Petition's Ground 2 is based on Gaucher. *Supra* §II.A.2. Gaucher indisputably meets claims 1 and 8. *Supra* §§II.A.2, II.B.2.

The Petition's Ground 1B is based on Wong. *See supra* §II.C.1. Wong indisputably meets claim 14. *Id.* The Petition's Ground 3 is based on Zhao. *Supra* §II.C.2. Zhao indisputably meets claim 14. *Id.*

The merits of the Petition are strong, which weighs against discretionary denial.

E. Factor 1 Weighs Against Discretionary Denial Because Judge Gilstrap Often Provides Leave to Refile Stay Motions and Has Granted Stays On Less Favorable Timelines than Are Present Here

Factor 1 considers if “a stay... is likely to be granted if a proceeding is instituted.” *Fintiv*, Paper 11 at 6-7.

Geotab filed a motion to stay the case on June 30, 2025. That motion is pending. Fractus argues that Judge Gilstrap is unlikely to grant the stay now before the Board determines whether to institute the IPR. Request, 15 (“when the PTAB has not yet acted on a petition for inter partes review, the courts have uniformly denied motions for stay”). Fractus’s analysis is misleading because it ignores how Judge Gilstrap will handle Geotab’s request for a stay after the Board institutes a trial.

As *Fintiv* explains, even where “the district court has denied a motion for stay without prejudice,” which has not happened here, if the court “indicated to the parties that it will consider a renewed motion or reconsider a motion to stay if a PTAB trial is instituted” that can weigh against discretionary denial. *Fintiv*, Paper 11 at 6-7. It is Judge Gilstrap’s routine “well-established” practice to provide a defendant with leave to refile a motion to stay the case after an IPR has been instituted against an asserted patent. *See AGIS Software Dev. LLC v. Google LLC*, No. 2:19-CV-00361, 2021 WL 465424 at *1 (E.D. Tex. Feb. 9, 2021) (Gilstrap, J.) (providing leave to refile is “th[e] Court’s well-established practice”).

Fractus focuses on the wrong facts, noting statistics about Judge Gilstrap's tendency to deny *pre-institution* stay requests. Request, 15-16. Factor 1 considers how likely the district court is to grant a *post-institution* motion to stay. *Fintiv*, Paper 11 at 6-7.

Judge Gilstrap often stays litigation in favor of an instituted IPR. See, e.g., *Resonant Sys., Inc. v. Samsung Elecs. Co.*, No. 2:22-cv-00423, 2024 WL 1021023 at *2-4 (E.D. Tex. Mar. 8, 2024) (Gilstrap, J.); *Communication Technologies, Inc. v. Samsung Elecs. Am., Inc.*, No. 2:21-cv-00444, 2023 WL 1478447 at *2-5 (E.D. Tex. Feb. 2, 2023) (Gilstrap, J.); *Broadphone LLC v. Samsung Elecs. Co.*, No. 2:23-cv-00001, 2024 WL 3524022, at *2-3 (E.D. Tex. July 24, 2024) (Gilstrap, J.). Fractus does not cite a single contrary case in which Judge Gilstrap declined to stay a case when an IPR has been instituted against the challenged patent. As the above cases illustrate, if the IPR is instituted Judge Gilstrap is likely to grant a stay. Because “evidence exists that [a stay] may be granted if [this] proceeding is instituted,” factor 1 weighs against discretionary denial. *Fintiv*, Paper 11 at 6.

F. Factor 5 is Neutral

Fractus cites no case for its assertion that factor 5 “favors discretionary denial” because “Petitioner is a defendant” in the Geotab litigation. Request, 20. When the parties in IPR and litigation differ, factor 5 weighs against discretionary

denial; in the “far from unusual” circumstance that the IPR and litigation involve the same parties, this factor is neutral. *Shenzhen Root Technology Co., Ltd. v. Chiaro Technology Ltd.*, IPR2024-01296, Paper 9 at 20 (Feb. 25, 2025) (granting institution); *Google LLC v. Parus Holdings Inc.*, IPR2020-00846, Paper 9 at 20-21 (Oct. 21, 2020) (granting institution). Thus, factor 5 is neutral.

V. A HOLISTIC ASSESSMENT OF ALL CONSIDERATIONS WEIGHS AGAINST DISCRETIONARY DENIAL

Under the Director’s guidance, a holistic assessment of all considerations weighs against discretionary denial. The Examiner materially erred in allowing the claims—correcting that material error is a proper use of the Board’s resources. *Supra* §II.D. The FWD is likely to beat a trial in EDTX. Indeed, besides Geotab and Fractus each being parties to the IPR and EDTX litigation (*Fintiv* factor 5), which is neutral, the remaining five of six *Fintiv* factors weigh against discretionary denial. *Supra* §IV. But even if the Director were to find that the trial in EDTX against Geotab would precede the FWD date, correcting the Office’s material error would outweigh that factor as well. *Supra* §II.D.2. Similarly, while the ’458 Patent issued 11 years ago, the Director’s well-reasoned decisions make clear that correcting the Office’s material error in prosecution outweighs any alleged settled expectations Fractus could have that the ’458 Patent would not be challenged. *Supra* §§II.D.1, III.

Accordingly, the Director should deny the Request and refer the Petition to the merits panel.

Respectfully submitted,
Geotab Inc. and Geotab USA, Inc.

Date: August 28, 2025

By: /Adam R. Wichman/
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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24, the undersigned certifies that the foregoing **PETITIONERS' OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** contains 11,463 words excluding; a table of contents, a table of authorities, a certificate of service or word count, or appendix of exhibits or claim listing. Petitioners have relied on the word count feature of the word processing system used to create this paper in making this certification.

Date: August 28, 2025

/Dara Del Rosario/
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Paralegal
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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)

I certify that on August 28, 2025, a copy of the foregoing document, including any exhibits or appendices filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

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