

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

**PATENT OWNER'S REPLY TO PETITIONERS' REQUEST FOR
REHEARING OF DECISION GRANTING PATENT OWNER'S REQUEST
FOR DISCRETIONARY DENIAL AND DENYING INSTITUTION OF
INTER PARTES REVIEW**

I. Introduction

Petitioners' Request for Rehearing ("Request") mischaracterizes the Director's Decision Granting Patent Owner's Request for Discretionary Denial and Denying Institution of *Inter Partes* Review ("Decision") and should be denied. In addition, the remaining arguments presented in the Request do not comply with the requirements of 37 C.F.R. § 42.71, and therefore, should be disregarded.

II. Petitioners Mischaracterize the Decision

In section II of the Request, Petitioners allege:

The Director's Decision makes the erroneous factual finding that "***Petitioner*** appears to have had notice of the challenged patents for a significant period of time and ***was engaged in discussions with Patent Owner about the challenged patent until shortly before Patent Owner asserted the challenged patent.***" Decision, 3 (citing EX1043-EX1044). The final communication between the parties before "Patent Owner asserted the challenged patent" was January 25, 2022—almost ***three years*** before Fractus sued Geotab on December 6, 2024.

Request at 2-3 (Petitioners' emphasis).

In other words, Petitioners contend that the Decision contains a factual error because Fractus did not assert U.S. Patent No. 8,456,365 ("the '365 Patent"), one of the challenged patents, until "***three years***" after communication between the Parties concluded. Petitioners, however, misread the Decision, which is completely correct – Fractus asserted the '365 Patent against ADT in 2022, a fact clearly noted by Patent

Owner in its Brief in Support of Patent Owner's Request for Discretionary Denial in Inter Partes Review IPR2025-00928, Paper 7 ("928 Brief")¹:

The '365 Patent issued over twelve years ago, and Petitioner has been aware of it since at least 2021, when Patent Owner brought it to Petitioner's attention. In addition, Patent Owner sued ADT LLC for infringement of the '365 patent in 2022. Thus, Petitioner has had many years in which to raise these invalidity arguments and yet has chosen not to do so.

'928 Brief at 17; *see also* Petition at ix.

Accordingly, the Decision correctly holds that:

Petitioner appears to have had notice of the challenged patents for a significant period of time and was engaged in discussions with Patent Owner about the challenged patents until shortly before Patent Owner asserted the challenged patent. See Ex. 1043; Ex. 1044. Under these circumstances, the considerations that favor discretionary denial outweigh those that counsel against it.

Decision at 3.

Therefore, contrary to the allegation in the Request, the Decision did not make an erroneous factual finding and rehearing of the Decision is unwarranted.

¹ The Director jointly considered the Discretionary Denial Requests in IPR2025-00928 and IPR2025-00929. Petitioners do not contend that it was error for the Director to jointly consider these related proceedings in reaching her Decision.

III. Section III of the Request is Not Based on Matters Misapprehended or Overlooked by the Director

A request for rehearing must be premised on matters that the party believes were misapprehended or overlooked (37 C.F.R. § 42.71(d)) and are not an opportunity merely to disagree with the Board's assessment of the arguments or weighing of the evidence. *Everstar Merch. Co., Ltd. v. Willis Elec. Co., Ltd.*, IPR2019-01484, Paper 10, at 3-4 (PTAB Oct. 22, 2020). Section III of the Request, however, asks the Director to precisely do this – reweigh an alleged error in issuance of the '365 Patent versus the settled expectations of the parties.

The Decision makes clear that it was based upon “a holistic assessment of all of the evidence and arguments presented.” Decision at 3. Therefore, Petitioners' allegation that the Director overlooked the evidence of this alleged error (Request at 3) is incorrect. Further, as the Decision explicitly states, Petitioners had notice of the challenged patents for a significant period of time, Petitioners were engaged in discussions with Patent Owner about the challenged patents until shortly before Patent Owner asserted the challenged patent, and this course of events was what resulted in “the considerations that favor discretionary denial outweigh[ing] those that counsel against it.” Decision at 3. Petitioners' knowledge and communications regarding the subject patents were facts distinguishing the present case from those cited by Petitioner in section III of the Request. Accordingly, the Director did not

abuse her discretion as she provided an adequate evidentiary basis for her findings and articulated a satisfactory explanation for them. *Omega Pats., LLC v. BMW of N. Am., LLC*, No. 2022-2012, 2024 WL 227801, at *3 (Fed. Cir. Jan. 22, 2024).

IV. Sections IV and V of The Request Impermissibly Raise New Issues

A request for rehearing is limited to matters “previously addressed in a motion, an opposition, a reply, or a sur-reply.” 37 C.F.R. § 42.71; *see also Stage Completions Inc. v. Gryphon Oilfield Sols., LLC*, No. IPR2018-00776, 2019 WL 624640, at *2 (P.T.A.B. Feb. 13, 2019) (“Because we cannot misapprehend or overlook arguments not previously made, the Board does not consider arguments made in a request for rehearing unless the request “specifically identif[ies] ... the place where [that argument] was previously addressed in” the petition.”); *Everstar Merch.*, IPR2019-01484, Paper 10 at 3-4; *Commvault Sys., Inc. v. Realtime Data LLC*, IPR2017-02178, Paper Patent No. 11,865,287 Authorized Response to Director Review Request -3- 13, at 2-3 (PTAB July 19, 2018).

The arguments presented in sections IV and V of the Request, however, are new arguments not addressed in any of Petitioners’ previous filings. Specifically, Petitioners’ Opposition to Patent Owner’s Discretionary Denial Brief (“Opposition”) never argues in any of its **54 pages** that:

- A “settled expectation analysis” is contrary to law and exceeds the Director’s authority;

- The Federal Circuit rejected such a “settled expectation analysis”;
- The “settled expectation analysis” imposes a timing restriction that contradicts the AIA and the cases interpreting it;
- A “settled expectations analysis” is arbitrary and capricious;
- Judicial estoppel precludes a finding that Fractus had setting expectations;
- The “settled expectations analysis” violated APA comment and rulemaking requirements; and
- The Director is instituting a new timing requirement that exceeds the Director’s authority and is contrary to statute.

The arguments are not only new and should be disregarded, but they are specious: Non-institution decisions are a non-enforcement decision committed to agency discretion by law. *Apple Inc. v. Vidal*, 63 F.4th 1, 14 (Fed. Cir. 2023).

V. Conclusion

Petitioners’ Request is based on a mischaracterization of the Decision and presents impermissible arguments contrary to the rules and precedents for rehearing requests. Therefore, Petitioners’ Request should be denied.

Dated: October 24, 2025

Respectfully submitted,
/Mark J. DeBoy/
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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **PATENT OWNER’S REPLY TO PETITIONERS’ REQUEST FOR REHEARING OF DECISION GRANTING PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL AND DENYING INSTITUTION OF INTER PARTES REVIEW** was served via email (as previously consented to by counsel) on October 24, 2025 to lead and backup counsel of record for Petitioners as follows:

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Dated: October 24, 2025

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