UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SECURE COMMUNICATION TECHNOLOGIES, LLC,
Patent Owner.

Case No. IPR2025-01182
Patent No. 11,443,344

PETITIONERS' OPPOSITION TO
PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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ZyXEL Commc'ns Corp. v. UNM Rainforest Innovations,
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EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 11,443,344
1002	Prosecution History of U.S. Patent No. 11,443,344
1003	Declaration of Mark Lanning
1004	Curriculum Vitae of Mark Lanning
1005	U.S. Patent Application No. 2005/0250552 ("Eagle")
1006	U.S. Patent Application Publication No. 2010/0138481 ("Behrens")
1007	U.S. Patent No. 7,590,086 ("Olkkonen")
1008	Bluetooth Special Interest Group, Bluetooth Core Specification Version 2.1 + EDR (July 26, 2007)
1009	Bluetooth Special Interest Group, Assigned Numbers (December 14, 2002) (https://web.archive.org/web/20021214114356/http://www.bluetooth.org/assigned-numbers/baseband.htm)
1010	U.S. Patent Application Publication No. 2002/0131445
1011	U.S. Patent Application Publication No. 2002/0174364
1012	U.S. Patent Application Publication No. 2005/0164717
1013	U.S. Patent Application Publication No. 2006/0165100
1014	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00903, Paper 2 (Petition for *Inter Partes* Review) (P.T.A.B May 8, 2020)
1015	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00903, Paper 31 (Final Written Decision) (P.T.A.B Nov. 8, 2021)
1016	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00904, Paper 2 (Petition for *Inter Partes* Review) (P.T.A.B May 8, 2020)
1017	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00904, Paper 30 (Final Written Decision) (P.T.A.B Nov. 8, 2021)
1018	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00931, Paper 2 (Petition for *Inter Partes* Review) (P.T.A.B May 15, 2020)
1019	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00931, Paper 30 (Final Written Decision) (P.T.A.B Nov. 8, 2021)
1020	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00932, Paper 2 (Petition for *Inter Partes* Review) (P.T.A.B May 15, 2020)
1021	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00932, Paper 30 (Final Written Decision) (P.T.A.B Nov. 8, 2021)
1022	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00933, Paper 2 (Petition for *Inter Partes* Review) (P.T.A.B May 15, 2020)

Exhibit	Description
1023	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00933, Paper 30 (Final Written Decision) (P.T.A.B Nov. 8, 2021)
1024	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00934, Paper 2 (Petition for *Inter Partes* Review) (P.T.A.B May 27, 2020)
1025	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00934, Paper 31 (Final Written Decision) (P.T.A.B Nov. 30, 2021)
1026	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00977, Paper 2 (Petition for *Inter Partes* Review) (P.T.A.B May 27, 2020)
1027	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00977, Paper 31 (Final Written Decision) (P.T.A.B Nov. 30, 2021)
1028	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00978, Paper 2 (Petition for *Inter Partes* Review) (P.T.A.B. June 1, 2020)
1029	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00978, Paper 10 (Decision Denying Institution) (P.T.A.B. Dec. 4, 2020)
1030	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00979, Paper 2 (Petition for *Inter Partes* Review) (P.T.A.B. June 1, 2020)
1031	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00979, Paper 33 (Final Written Decision) (P.T.A.B Nov. 30, 2021)
1032	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00980, Paper 2 (Petition for *Inter Partes* Review) (P.T.A.B June 1, 2020)
1033	*Target Corporation v. Proxicom Wireless, LLC*, IPR2020-00980, Paper 32 (Final Written Decision) (P.T.A.B Nov. 30, 2021)
1034	*Target Corporation v. Proxicom Wireless, LLC*, Nos. 2022-1282, 2022-1283, 2022-1338, 2022-1339, 2023 U.S. App. LEXIS 24861 (Fed. Cir. Sep. 20, 2023) (nonprecedential)
1035	Apple Inc., iPhone 3G Technical Specifications (https://web.archive.org/web/20080725084414/http://www.apple.com/iphone/specs.html)
1036	Apple Inc., iPhone User Guide for iPhone OS 3.1 Software (https://cdsassets.apple.com/live/6GJYWVAV/user/ma616_iphone_ios3_1_user_guide.pdf)
1037-1040	[RESERVED]
1041	U.S. Patent No. 7,936,736
1042	U.S. Patent No. 8,090,359
1043	U.S. Patent No. 8,090,616
1044	U.S. Patent No. 8,116,749
1045	Prosecution History of U.S. Patent No. 8,090,616

Exhibit	Description
1046	*Samsung Electronics Co., Ltd. v. Secure Communication Technologies, LLC,* IPR2025-01049, IPR2025-01050, IPR2020-01051, Paper 10 (Settlement Prior to Institution of Trial) (P.T.A.B. Aug. 27, 2025)

I. INTRODUCTION

A patent in force for barely 3 years creates no "settled expectations." Nevertheless, PO argues settled expectations on the strained basis that Petitioner was aware of ancestors of the '344 patent since 2012. But two of those ancestor patents and several other patents in the '344 patent's family were cancelled long ago by the PTAB, some using the very same prior art applied in this petition[1]. These prior agency and Federal Circuit adjudications, cancelling claims based on the same architecture as the challenged claims here, were reasonably relied upon by the Petitioner. That PO's settled expectation theory attempts to reach back in time to ***claims cancelled in view of the very same invalidating art*** applied in this petition only highlights the material error of the agency in issuing substantially similar claims a ***second*** time. *See Meta Platforms, Inc. v. Resonant Systems, Inc.*, IPR2025-00823, Paper 8 at 2-3 (PTAB Sep. 12, 2025) (considerations counseling

[1] The four patents identified in exhibit 2004 include US 7,936,736 (IPR2020-00904; claims cancelled in view of Eagle (EX1005), which is the primary reference in this IPR; no appeal to CAFC); US 8,090,359 (IPR2020-00932; claim cancellations affirmed on appeal); US 8,090,616 (relating to an image comparison process never asserted against Google); and US 8,116,749 (asserted 2 days before filing of the discretionary brief and will be subject to a forthcoming IPR).

against discretionary denial include the cancellation or the disclaimer of substantially similar claims in related patents); *see also ClearCorrect Operating, LLC v. Align Tech., Inc.,* IPR2025-00814, Paper 14 at 3 (PTAB Aug. 29, 2025) (same proposition); and *Posco Co., Ltd. v. Arcelormittal*, IPR2025-00370, Paper 10 at 3 (PTAB June 25, 2025) ("that the Board previously determined related claims to be unpatentable—prior to the issuance of the challenged claims in this proceeding—tips the balance against discretionary denial"[2]).

Only through material error of the agency did a "new" set of claims in the '344 patent issue, even though they are directed to the very same non-inventive architecture—this time dressed up as an ad-hoc network configuration. Not surprisingly, given that the Bluetooth® ad-hoc features were prior art that was

[2] The '918, '344, and '971 patents that are now subject to IPRs issued on 2022-05-17, 2022-09-13, and 2023-06-27, respectively. The patents that PO asserted as establishing settled expectations include US 7,936,736 and US 8,090,359, which were the subject of IPR2020-00904 (FWD 2021-11-08) and IPRs 2020-00931 (FWD 2021-11-08; appealed with CAFC decision 2023-09-20) and -00932 (FWD 2021-11-08). Claims in those IPRs, and indeed in the majority of patents that were subject to IPR, were found unpatentable prior to issuance of the '918, '344, and '971 patents. *See* patent family tree below in §II.

itself incorporated into the ’344 specification, the very same art used to cancel the claims of the parent patents can, and is being, re-applied here together with such standard Bluetooth® teachings. As can be appreciated, ***Petitioner’s settled expectations*** are based on previous holdings of this agency and the Federal Circuit. Indeed, given the prior adjudication of the agency and Court, collateral estoppel prevents the same factual issues from being re-litigated before the PTAB. Consequently, far ***less*** agency resources need to be used to adjudicate this IPR as compared to the typical IPR.

PO’s only other argument for discretionary denial is that it filed a new lawsuit against Google and then amended its complaint to add two additional patents—US 8,116,749 (“’749 patent”) and US 11,995,685 (“’685 patent”)—***two days*** before filing its discretionary denial brief and that somehow PO’s obvious gamesmanship creates inefficiencies in moving forward here. It does not. The ’344 patent has been in force for only 3 years and presents a patentably indistinct claim scope with respect to earlier cancelled claims. In any event, an IPR filing is forthcoming for the ’685 patent again ***using the same art applied years ago by the PTAB to cancel patentably indistinct claims and applied in this filing***. Petitioner will work with the assigned merits panel to align the schedule in that case to optimize the agency’s resources. The ’749 patent, although older, has no settled expectations given the significant cancellation of overlapping claims throughout

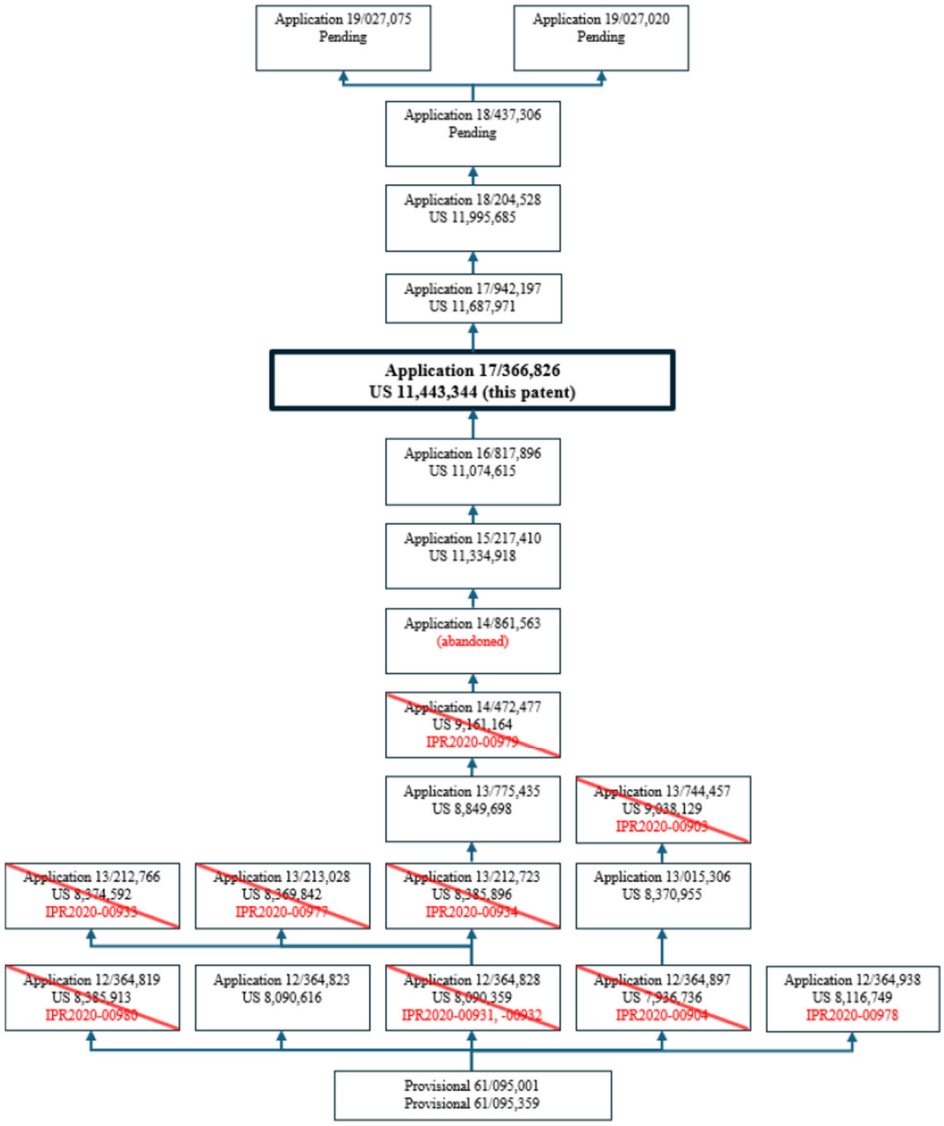
the patent family. And in any event, an IPR filing is forthcoming to explain those unrelated issues.

II. CANCELLED ANCESTOR PATENTS ARE THE ANTITHESIS OF SETTLED EXPECTATIONS

The ’344 is directed to a mobile communication architecture for “facilitating the exchange of information” between two wireless devices, each device employing short-range communication (*e.g.*, Bluetooth) and long-range communication (*e.g.*, cellular) wireless capabilities. EX1001, 1:5-24, 1:49-2:63. A first device may detect an identifier transmitted from a second device in short-range proximity and send information identifying the second device to a server via long-range communications. EX1001, 1:49-2:4, 5:25-34, 5:57-67. Based on policy information stored at the server, the server may alert the first device to the second device’s presence with, *e.g.*, the second device’s contact information. EX1001, 2:5-14, 6:7-14, 6:41-59, 6:60-7:8.

This architecture of exchanging information between nearby devices and servers was claimed in earlier patents within the ’344’s family (all claiming priority to the same provisional applications) and previously cancelled by the PTAB. As shown in the diagram below, a majority of the family’s earlier patents were challenged before the PTAB, and claims directed to the device-server

architecture were found unpatentable in all but one proceeding.[3] *See* EX1014-EX1033 (Petitions and Decisions in those IPRs). Unpatentability was further confirmed in the only two IPR proceedings appealed to the CAFC (from IPR2020-00931 and IPR2020-00933). *See* EX1034.



[3] IPR2020-00978 was denied institution for reasons/limitations not relevant to the '344 claims. EX1029, 15-18.

The ’344 claims were prosecuted while the above-described IPRs were pending, but the claims issued before all appeals in those IPRs were exhausted, to include three overall concepts: (1) the short-range and long-range communications architecture described above and found to be squarely in the prior art; (2) changing device identifiers over time, also found to be in the prior art; and (3) filtering based on short-range service identifiers. The PTAB already determined that the first two features, in combination, were well-known based on the Eagle (EX1005) and Behrens (EX1006) references used in this petition.[4] Likewise, the PTAB found that criteria-based filtering of short-range communicated identifiers was also known.[5]

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[4] *See* EX1015, 7-8 and 15-34 (PTAB determining that Eagle anticipated claims including a server receiving a unique identifier from a wireless device over a “wide area link,” where that wireless device received the unique identifier from another wireless device over a “local wireless link,” and transmitting information back to the wireless device based on a policy); EX1031, 46-49 (PTAB acknowledging that Behrens teaches using “a combination of UIDs” and that users may “exercise control over which or how many UIDs are transmitted”).

[5] *See* EX1015, 17, 24 (PTAB finding that Eagle discloses determining which unique identifiers to send to the server); EX1033, 18-23 (PTAB determining that prior art systems disclosed suppressing/filtering communications to servers where

These prior PTAB (and CAFC) determinations of unpatentability strongly caution against discretionary denial to the extent PO is attempting to use the same ***cancelled*** claim scope to assert settled expectations here.[6]

Precisely because PO's claims were being cancelled in previous IPRs, PO pursued continuation patents, including the '344, to change its filtering criteria to a newly claimed but existing parameter (service identifier) of Bluetooth/WiFi communications. Accordingly, there are no settled expectations in these oldest patents from the '344 patent's family because (1) their claims were cancelled, and (2) the '344 claims were drafted to layer on a patentably indistinct service identifier taken from the prior art.

A. The '344 Architecture Was Found Unpatentable

1. Common architecture claims cancelled

PO specifically references four patents from the '344 patent's family that were identified in an email to Google in 2012: US 7,936,736 ("'736 patent"), US

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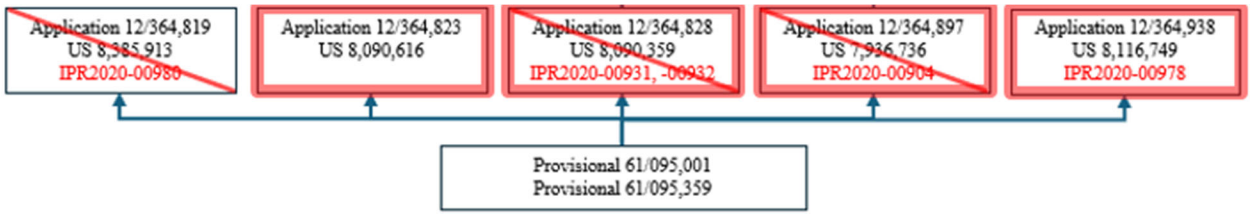
unique identifiers were previously encountered).

[6] *See* Section I.B of the *Interim Director Discretionary Process* at https://www.uspto.gov/patents/ptab/interim-director-discretionary-process (considerations include "Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims").

8,090,359 ("'359 patent"), US 8,090,616 ("'616 patent"), and US 8,116,749 ("'749 patent"). *See* Patent Owner's Brief in Support of Discretionary Denial (Paper 6, "PO-DD"), 2-3. These patents are among the earliest applications filed in this family and create no settled expectations here.



For example, the '736 patent claims, ***now cancelled***, included a server-based method of providing information to a wireless device based on first identification information associated with a first wireless device, second identification information associated with a second wireless device, and disclosure policy data. EX1041, claims 1, 15 (*see* left column in the table below). The '344 patent also claims this same base architecture, but from the mobile device's perspective (rather than the server's). To the extent PO is attempting to argue that the '736 patent provides settled expectations for the '344 because the '344 claims include the same base architecture, those expectations do not exist because those prior claims were ***cancelled***.

'736	**'344**
1. A method for a central server…, the central server performing the steps of: receiving first identification information from the first wireless	1. A method comprising: **receiving, at a wireless device, via a short range wireless protocol, a first plurality of beacon transmissions,**

device, the first identification information communicated from the first wireless device to the server via the wireless Wide Area Network, … **receiving second identification information, as collected by the first wireless device from the second wireless device via a separate local wireless link between the first and second wireless devices, and wherein the second identification information is communicated from the first wireless device to the server via the wireless Wide Area Network connection,** … retrieving disclosure policy data associated with the second identification information, the disclosure policy data representing rules for privacy of information concerning the second wireless device or privacy of information concerning an entity associated with the second wireless device; comparing the information disclosure policy data and the first identification information; and **providing further information to the first wireless device concerning the entity associated with second wireless device, but only to the extent that it is consistent with the step of comparing the information disclosure policy data.**	each beacon transmission comprising three fields (a) a MAC address, **(b) a unique identifier**, wherein the unique identifier of each respective beacon transmission does not directly identify a location of a beacon transmitter, and (c) a beacon service identifier, wherein the beacon service identifier of each respective beacon transmission identifies a wireless beacon service as opposed to identifying a communication network or a device accessible using the short range wireless protocol **receiving, at the wireless device via a second wireless protocol, stored information from one or more servers, the stored information relating to a particular entity or object associated with a first unique identifier, and wherein the second wireless protocol is different from the short range wireless protocol;** causing selection of one or more of the unique identifiers from the first plurality of beacon transmissions, by filtering the beacon transmissions which include a particular beacon service identifier indicating that a particular received beacon transmission is associated with a particular wireless beacon service; and **taking first further action relating to the stored information, if the first unique identifier is present among the selected one or more unique identifiers.**

The ’359 patent claims, ***also cancelled***, recite further narrowing features outside of the base architecture cancelled in the ‘736 patent such as the server receiving “feedback ratings relevant to an entity associated with either the first wireless device or the second device identifier information.” This feature is not recited in the claims of the ’344 patent, and, therefore, cannot create settled expectations with respect to the ’344 patent. EX1042, claims 1, 14.

The ’616 patent claims, although not previously challenged and not cancelled, recite further narrowing features outside of the base architecture of the cancelled ‘736 patent such as “receiving visual identification information… includ[ing] at least one identifying picture.” This feature is not recited in the claims of the ’344 patent and as such, cannot create settled expectations with respect to the ’344 patent.[7] EX1043, claims 1, 8, 22; EX1045, 272 (“Hammand nor Van Bosch et al. teach… receiving visual identification information from the trusted server also using the second wireless protocol…, wherein the visual identification information additionally includes at least an identifying picture of the object or entity associated with the second wireless device…”).

Finally, the ’749 patent claims, although not cancelled, recite further

[7] PO has not sued Petitioner for infringing the ’616 claims, nor does it appear that PO ever asserted the ’616 patent against any entity in any forum.

narrowing features outside of the base architecture of the '736 patent such as requiring a "predetermined event coordinated with [a] central server" to use modified identification information. The IPR targeting the '749 patent was the only IPR denied institution in this patent family, and it was denied in part because of this feature. EX1029, 15 ("Petitioner does not address the 'upon an occurrence of a predetermined event' recitation"). However, this feature is not recited in the claims of the '344 patent and as such, cannot create settled expectations with respect to the '344 patent. EX1044, claims 1, 7.

2. Material error to find prior art features added to the '344 claims distinguishing

The '344 patent claims include additional but patentably indistinct limitations versus its aforementioned parent patents, such as identifiers or addresses commonly used in then-existing industry-standard communication protocols (*e.g.*, reciting a "MAC address" and "beacon service identifier") and a basic filtering mechanism that does nothing more than identify a particular service. *See* Petition at 33-34 (Bluetooth Device Addresses (BD_ADDR) are MAC addresses included in Bluetooth communications), 20-25, 35-37 (service class information are beacon service identifiers used for filtering; class of device information exists in Bluetooth). The '344 patent itself relies on the Bluetooth industry standard for written description. *E.g.*, EX1001, p. 7 (listing the 802.11 and 802.15.4 specifications as prior art), Figs. 4-5 (illustrating "802.15.1-2002

(Bluetooth V1.2)" processes), 2:15-20 (utilizing "a Bluetooth or WiFi service beacon [that] comprises a first MAC address, a first unique identifier, and a beacon service identifier"). Indeed, PO argues that the '344 claims are distinguishable from Eagle specifically because Eagle does not disclose "Bluetooth 2.1[] parked slaves," "IEEE 802.11 specification[] beacon frames," or "802.11" beacons. POPR (Paper 7), 12-13. But as the IPR petitions plainly point out, Eagle specifically discloses Bluetooth beacons for use with its system. *See* Pet., 26, 30, 35, 62, (referencing Eagle [0008] and [0061]'s Bluetooth beacons and exemplary uses as restroom and tradeshow beacons). And the ad hoc parameters of the Bluetooth standard — that PO argues as somehow inventive —are taken directly from that prior art standard.

Therefore, in addition to the fact that the '344 patent cannot confer settled expectations because it has only been in force for three years, PO has no reasonable expectation that these additional claim features to prior art ad hoc networking parameters will confer patentability to the already-cancelled architecture.

3. No settled expectations

Accordingly, none of the '736, '359, '616, or '749 patents confer settled expectations on the '344 patent. While they all have substantially the same disclosures and have claim limitations directed to the same base architecture, that

base architecture has repeatedly been found unpatentable by the PTAB. Where claims did survive a previous challenge (as for the ’749 patent) or were not previously challenged (as for the ’616 patent), those “successes” were due to claim limitations not found in the ’344 patent. The ’344 patent, pursued in response to PO’s string of IPR losses, includes only patentably indistinct limitations PO simply drew from already existing wireless and Bluetooth standards. It was material error to allow the ’344 patent to resurrect and claim the same architecture–cancelled in claims in U.S Patent Nos. 7,936,736; 8,090,359; 8,369,842; 8,374,592; 8,385,896; 8,385,913; 9,038,129; and 9,161,164–based on standard wireless features, and there is no basis for denial found in the ’344 patent or its family’s history. The public had a settled expectation that the claim scope of the earlier cancellations of the agency and CAFC would not be reintroduced through standard ad hoc network features and resurrected. This material error must be corrected to safeguard the public from harassment based on claimed technology previously deemed to be within the public domain by both the agency and Federal Circuit.

B. No Settled Expectations from Unrelated Samsung Suit

PO also alleges that Petitioner has been aware of the challenged patents through PO’s unrelated district court action against Samsung (Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.) in July 2024 and PO’s subsequent district court action against Petitioner in August 2025. PO-DD, 4.

These arguments are irrelevant to PO's settled expectations.

Samsung and Google (Petitioner) are not the same company; nor are Samsung and Google real parties in interest in each other's respective IPR matters. Indeed, Samsung alone has now settled its dispute with PO. EX1046 (Samsung settlement and termination of IPR). Thus, the suit against Samsung has no bearing on PO's settled expectations of ***Petitioner***. And the suit against Google was filed mere months ago, which is not sufficient to give rise to any "settled expectations."

III. COLLATERAL ESTOPPEL FAVORS AGENCY REVIEW

The validity of the '344 patent itself has not been previously adjudicated at the PTAB. But, as noted above, other patents in the '344 patent's family have—and lost. This proceeding will raise similar issues to those raised in at least IPR2020-00903 (US 9,038,129), IPR2020-00904 (US 7,936,736), and IPR2020-00979 (US 9,161,164), where similar claims were found unpatentable in view of grounds asserting Eagle and Behrens as prior art. That is, the PTAB here will be reviewing the same disclosure (shared in the patent family), reviewing the same prior art (Eagle and Behrens), and analyzing claim limitations directed to the same technological system. *See also ZyXEL Commc'ns Corp. v. UNM Rainforest Innovations*, 107 F.4th 1368, 1383 n. 10 (Fed. Cir. 2024) (collateral estoppel regarding patentability applies to *issues* and does not require identical claim language). Consistency with the nine previous IPRs in this family will be best

maintained by continuing review at the PTAB. The PTAB can directly draw from its past analyses of the prior art, for which the Petition provides guidance. For example, the Petition explains that this '344 patent IPR proceeding will benefit from the following previous prior art findings:

Petition Page #	Claim Limitation[8]	Previous Board Holding
29	1.A.I	Eagle teaches receiving transmissions from a second wireless device via a short-range wireless protocol. *See* EX1015, 20; EX1017, 17-18.
32	1.A.II	Eagle teaches receiving a Bluetooth Device address as a unique identifier. Behrens teaches receiving MAC addresses in UIDs. *See* EX1015, 35-36; EX1031, 46-48.
34	1.A.III	Eagle teaches receiving a unique identifier from a second wireless device. Behrens teaches combination UIDs. *See* EX1015, 20; EX1017, 17-18; EX1031, 46-48.
37-39	1.B.I, 1.B.III	Eagle teaches communications with the server over a wide area link, not a local wireless link, and receiving stored information from the server. *See* EX1015, 19-30; EX1017, 16-18, 27-28.
39	1.B.II	Eagle teaches that the server stored information relates to the unique identifier received from the second device and to an entity associated with the second device. *See* EX1015, 20-21, 35; EX1017, 18, 27-28.
44	2.B.II	Behrens teaches changing UIDs.

[8] These features are first identified for the first set of claims (method claim 1), but also apply to device claim 29, program product claim 30, and their dependents.

		See EX1031, 46-48.
55	7	Eagle teaches receiving an alert from the server based on determinations regarding friends and trust networks. *See* EX1015, 21-30; EX1017, 19-28.
57	10	Eagle teaches determining whether to transmit a notification to the server based on timestamps. *See* EX1015, 17, 23-24; EX1017, 14.

The PTAB is therefore in the best position to efficiently and consistently review the claims of the ’344 patent in view of the same prior art it has already evaluated. *See* Memo regarding Interim Processes for PTAB Workload Management[9] at 2-3 (recognizing past PTAB adjudications on validity; aiming to improve PTAB efficiency); *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at 2 (PTAB Jul. 16, 2025) (existence of issues similar to those previously adjudicated may counsel against discretionary denial). It was material error for the USPTO examiner to allow the claims of the ’344 patent over known invalidating art (*i.e.*, Eagle and Behrens) based on trivial additions to the claims (*i.e.*, a service identifier), and the PTAB is most fit to continue its ongoing review of patents in this same patent family. *See Padagis*, Paper 12 at 3 (review of challenged patent is an appropriate use of Office resources in view of material error and contradictory

[9] https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf

findings); *see also ZyXEL*, 107 F.4th at 1383-84 (while issues of collateral estoppel, res judicata, and issue preclusion were available for the court to consider *sua sponte*, those issues were better left to the Board).

IV. NEW PATENTS ASSERTED IN COURT DO NOT RENDER THE IPR PROCEEDINGS USELESS

PO argues that these IPR proceedings will not be an efficient use of the Office's resources "because the district court would still have to decide the validity of the closely related '749 and '685 patents." PO-DD, 9-10. But PO added the '749 and '685 patents to its district court case against Petitioner, Google, just two days before filing its discretionary denial brief here, and PO only filed its lawsuit against Petitioner on August 4, 2025–over a month *after* Petitioner filed this IPR. PO's blatant gamesmanship in seeking discretionary denial should not be credited when deciding whether to refer this filing to the merits panel.

In any case, Petitioner is currently preparing petitions for IPR against both the '749 and '685 patents and, when filed, will request that the same PTAB panel be assigned to those proceedings for efficiency and consistency. Also, as noted above the '685 will be mapped to the same art applied here (with the same collateral estoppel issues), so there is only additional ***efficiency***, not inefficiency.

V. 35 U.S.C. §325(d) DOES NOT SUPPORT DENIAL IN THESE CIRCUMSTANCES

A. *Advanced Bionics* step one

The Petition presents a single ground of rejection based on Eagle (US

2005/0250552), Behrens (US 2010/0138481), and Olkkonen (US 7,590,086). Although Eagle and Behrens were among the approximately 1000+ patents, publications, and non-patent literature made of record during prosecution of the ’344 patent, Olkkonen was not. PO-DD, 11 (Olkkonen “not considered during prosecution”). Therefore, the examiner during prosecution never considered the combined teachings of Eagle, Behrens, and Olkkonen, and Ground 1 fails to satisfy *Advanced Bionics* step one.[10]

B. *Advanced Bionics* step two

Because the Ground fails *Advanced Bionics* step one, discretionary denial under §325(d) is unwarranted, and the Board need not reach step two.[11]

Even ignoring the lack of prior consideration under step one, demonstrable material error occurred during prosecution of the ’344 patent. The ’344 claims were allowed based on an after-final amendment adding that a beacon service identifier “identifies a wireless beacon service as opposed to identifying a

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[10] *Advanced Bionics, LLC v. Med-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) (whether the same or substantially the same art or arguments were presented to the Office).

[11] Whether the Office erred in its evaluation of the asserted prior art. *Advanced Bionics*, Paper 6 at 8.

communication network or a device accessible using the short range wireless protocol." EX1002, 522-550, 552-559. There are no substantive arguments on the record after that amendment, and so there is nothing in the record that indicates the Examiner substantively considered Eagle, Behrens, or any Olkkonen-equivalent disclosure with respect to the added limitation, beyond initialing the 1000+ IDS references submitted by PO.[12] EX1002, 392-506. *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 16 at 13-14 (PTAB June 25, 2025) (remarking that there was no record of substantive prior art consideration "[o]ther than initials on a lengthy IDS" with "over 1,000 other references," which the Director Review Decision noted as being "over 40 times the… typical IDS").

Indeed, PO admits that Olkkonen was not before the examiner and states it is "relie[d] on for one limitation, *i.e.*, 'filtering for… service identifiers.'" PO-DD, 11. And it is the same claimed service identifier that contributed to the allowance of the '344 patent. The Examiner erred by not rejecting claims over Eagle, Behrens, and Olkkonen (not even of record during prosecution) or any other art of

[12] *See Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017), factor (c), regarding the extent to which the asserted art was evaluated during examination.

record teaching the same, as set forth in the Petition.[13]

PO concludes that Petitioner made "no effort" and failed to address 325(d) in the Petition—but, of course, *this* opposition brief is the proper place for Petitioner's arguments.[14]

There is no reason to deny institution under §325(d), as the facts of this case fail to satisfy both *Advanced Bionics* steps one and two. PO's conclusory handwaving of the facts and erroneous understanding of the procedural rules does not favor a different outcome.

VI. CONCLUSION

The Director should deny Patent Owner's request for discretionary denial and refer the Petition to the merits panel.

Respectfully submitted,
Google LLC

Dated: October 10, 2025 By: /Scott A. McKeown/
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[13] *See Becton Dickinson* factors (e) and (f) regarding how the examiner erred in its evaluation of the asserted prior art and the extent to which additional evidence and facts warrant reconsideration of the prior art or arguments.

[14] *See* Sections I.C, III.A, and III.C of the *Interim Director Discretionary Process* at https://www.uspto.gov/patents/ptab/interim-director-discretionary-process.

CERTIFICATE OF SERVICE UNDER 37 C.F.R. §42.6(E)(4)

I certify that on October 10, 2025, a copy of the foregoing document, including any exhibits filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

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