

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

GINKO LLC,
Patent Owner.

IPR2025-01388
U.S. Patent No. 11,025,573

**PATENT OWNER GINKO LLC'S
REQUEST FOR DISCRETIONARY DENIAL**

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Process, Interim Director Discretionary Process, available at https://www.uspto.gov/patents/ptab/interim-director-discretionary-process	10, 13

EXHIBIT LIST

Exhibit	Description
EX2001	Ginko LLC's First Amended Complaint against Apple, Inc., <i>Ginko, LLC v. Apple, Inc.</i> , No. 1:24-cv-01279 (W.D. Tex.), ECF No. 29
EX2002	Apple, Inc.'s Invalidity Contentions served Sept. 26, 2025
EX2003	Apple, Inc.'s Answer and Counterclaims, ECF No. 60
EX2004	Scheduling Order, ECF No. 39
EX2005	U.S. Patent No. 7,194,419 to Robertson ("Robertson '419")
EX2006	U.S. Patent No. 7,606,725 to Robertson ("Robertson '725")
EX2007	U.S. Publication No. 2010/0088246 to Lim ("Lim")
EX2008	U.S. Publication No. 2014/0244744 to Lyren ("Lyren")
EX2009	"The Business Card Killer: Ginko, The One Tap Contact Exchange App," PRNewswire, accessible at https://www.prnewswire.com/news-releases/the-business-card-killer-ginko-the-one-tap-contact-exchange-app-300764710.html
EX2010	"Breakthrough Contact Exchange App Ginko Will Be Showcased At SXSW Startup Spotlight," PRNewswire, accessible at https://www.prnewswire.com/news-releases/the-business-card-killer-ginko-the-one-tap-contact-exchange-app-300764710.html
EX2011	"History of SXSW" SXSW.com, accessible at https://www.sxsw.com/about/history/
EX2012	"Partner Spotlight: SXSW," San Francisco Chamber of Commerce, accessible at https://www.sxsw.com/about/history/
EX2013	"How Siri Got Left Behind," The Ringer, accessible at https://www.theringer.com/2016/06/20/tech/apple-siri-lost-assistant-race-2ffc86fe5dfa

Petitioner Apple Inc. (“Petitioner”) requests *inter partes* review (“IPR”) of claims 1, 3–4, 6–12, and 14–15 of U.S. Patent No. 11,025,573 (“’573 Patent”). Paper 1 (“Pet.”). Pursuant to the March 26, 2025, Memorandum by the Director addressing the “Interim Processes for PTAB Workload Management” (“Director’s Memo”), Patent Owner Ginko LLC (“Ginko” or “Patent Owner”) respectfully requests the Director exercise discretion and deny institution of this IPR. Discretionary denial is warranted under 35 U.S.C. § 314(a), 35 U.S.C. § 325(d), and the *Fintiv* and *Advanced Bionics* factors.¹

I. FACTUAL BACKGROUND

A. The ’573 Patent

Ginko is the owner of the ’573 Patent, which is directed to breakthroughs in wireless communications and data sharing, including data and contact sharing between devices based on the relative proximity of devices. Provisional Application Nos. 62/195,534 and 62/234,246 were filed on July 22, 2015, and September 29, 2015, respectively. Claiming priority to these provisional applications is U.S. Patent Application No. 15/217,424 (“the ’424 Application”), filed on July 22, 2016, and issued on January 1, 2019, as U.S. Patent No. 10,171,985 (“the ’985 Patent”). On December 7, 2018, Ginko filed a continuation-in-part of the ’424 Application, U.S.

¹ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (Feb. 13, 2020) (precedential).

Patent Application No. 16/212,902 (“the ’902 Application”), which issued on June 1, 2021 as the ’573 Patent. The ’573 Patent claims priority to June 22, 2015. EX1001, cover page. Cited during the ’573 Patent’s examination were U.S. Pat. No. 7,606,725 (“Robertson ’725”) (EX2006) and U.S. Pat. No. 7,194,419 (“Robertson ’419”) (EX2005), which share the same disclosure as U.S. Pat. No. 8,380,796 (“Robertson ’796”) (EX1004), the reference cited by Petitioner in Ground 1. Pet., 2; EX1004. The ’573 Patent issued over the common disclosure of the three Robertson patents.

B. Apple Should Have Known About Ginko’s Patented Technology

One week after the ’573 Patent was filed, Ginko announced the launch of its mobile contact exchange app, which was released on Petitioner’s own iOS platform. *See* EX2009, 2 (“Ginko is the one tap contact exchange app that aims to reinvent how the world connects...The app operates on...iOS platforms”). Further, since 2018, Ginko has publicly promoted its patented technology, including at major technology industry events that Petitioner regularly monitors. *See* EX2010 (*e.g.*, South by Southwest (SXSW) festival). For example, in 2019, Ginko promoted its technology at the SXSW Startup Spotlight, a pitch competition for nascent startups at the festival that previously featured companies that Petitioner acquired, such as Siri. *See id.* (“Booth 2122 will be one of the hottest destinations this Monday at the SXSW Startup Spotlight in Austin, Texas. Ginko LLC (www.ginko.mobi), and their patented one tap contact exchange app will be onsite with its founders to showcase

their revolutionary technology”); *see also* EX2011, 21 (“Siri wins [2010] SXSW Accelerator ‘Innovative Web’ category at SXSW Interactive”); EX2012, 2 (“[W]e’ve had many startups from San Francisco and the Bay Area reach success following SXSW. Some success stories include...Siri (acquired by Apple)[.]”). Notably, Petitioner announced that it acquired Siri in April 2010, just *one month* after the startup’s SXSW demo and victory. *See* EX2013, 3–4 (“At a South by Southwest demo [in March 2010], the company showed how Siri...could book a table at a restaurant or summon a taxi.... Two months after the app launched, Apple acquired Siri for a reported \$200 million.”).

C. Petitioner is Challenging the ’573 Patent in a Parallel Case

1. Allegations in the Apple Case

Ginko, LLC filed suit against Apple, Inc. (“Apple”), asserting that Petitioner’s iPhone® and Watch® models equipped with the “NameDrop®” feature infringe Claims 10, 11, and 14 of the ’573 Patent. *See Ginko, LLC v. Apple, Inc.*, No. 1-24-cv-01279-DAE (W.D. Tex. Oct. 24, 2024) (“Apple Case”); *see also* EX2001, ¶¶ 1, 25–26. Ginko alleges that NameDrop® allows users to share contact information by bringing two Apple devices near one another—a process Ginko asserts is covered by the ’573 patent. EX2001, ¶¶ 27–33. Ginko also asserts that Petitioner actively induces infringement and that its infringement is willful. EX2001, ¶¶ 12–16, 42–49. Petitioner counters that “each of the Asserted Claims is invalid under at least 35

U.S.C. §§ 101, 102, 103, and/or 112.” EX2002, 4; *see also* EX2003, 24. Petitioner asserts that “[t]he Asserted Claims of the ’573 Patent are ineligible for patenting as directed to an abstract idea, namely, exchanging contact information[,]” and that the claims are “invalid for indefiniteness, lack of enablement, and/or written description[.]” EX2002, 43; EX2002, 361–471 (Ex. A-10). Petitioner asserts that “the first permission setting” limitation of independent Claim 10 is indefinite and at least one of the petitioned independent claims—Claim 1—is invalid “for lack of enablement and/or written description” as to the “processor” and “memory” limitations. EX2002, 44–45. Petitioner also charts several system references, including the “BlackBerry Messenger (‘BBM’) System,” “NFriendConnector System,” “LoKast System,” “Facebook Nearby Friends System,” “Friendthem System,” and “Bump System.” EX2002, 153–360 (Exs. A-04–09). Notably, 70% of the charted “references” in the invalidity contentions are systems that will not be considered by the Board.

2. Progress in the Apple Case Before an Institution Decision

Significant progress will have been made in the Apple Case before the institution decision deadline. To date, the Court resolved Petitioner’s partial motion to dismiss, and the parties have already exchanged preliminary infringement and invalidity contentions, their lists of claim terms for construction, and their proposed claim constructions. The parties conducted venue discovery with respect to

Petitioner's July 17, 2025, Opposed Motion to Transfer, and Ginko filed its Opposition to the Motion to Transfer on October 3, 2025. The deadline for the parties to disclose extrinsic evidence and claim construction experts is in eleven days, or November 21, 2025, and the parties will narrow the number of terms and exchange revised lists on December 12, 2025. EX2004, ¶ 6, c-d. Claim construction briefing begins one month later, with Petitioner filing its claim construction brief by January 16, 2026, Ginko responding by February 13, Petitioner replying by March 6, and Ginko filing a sur-reply by March 27, 2026. *Id.*, ¶ 6, e-h. A date for the Markman Hearing will be set once briefing has concluded. *Id.*, ¶ 6, k. Accordingly, by the March 10, 2026, institution deadline, the parties will have completed all claim construction briefing except for Ginko's sur-reply.

3. Status Before a Final Written Decision

By the Final Written Decision (FWD) deadline (March 10, 2027), the Court will hold a Markman hearing, and final contentions will have been served, fact and expert discovery concluded, and all dispositive motions filed, no later than 44 weeks after the hearing. EX2004, ¶¶ 9-13. If the hearing is scheduled to occur two weeks after Ginko files its sur-reply, all dispositive motions would be filed by February 12, 2027, one month before the FWD deadline. A trial would be all that remains as of the FWD deadline. A May 2027 estimate is consistent with the 26.2-month median time-to-trial and 31-month average time-to-trial in the Western District of Texas.

D. Petitioners’ Recently Served Stipulation

On October 10, 2025, Petitioner filed a limited stipulation that, notably, covers “(iii) any ground based on *a combination* of system prior art (i.e., prior art that is neither a patent or printed publication) and the references that form the basis of any ground raised in IPR2025-01388, or (iv) any ground that could be raised under 102 or 103 on the basis of system art *corresponding to a reference* that that[sic] forms the basis of any ground raised in IPR2025-01388.” EX1007-0002 (emphasis added). Although Petitioner asserts that “there will be no overlap between the issues raised in the Petition and the district court,” the stipulation does not cover the system references Petitioner asserts in its invalidity contentions, and only the *combinations* of system references and references raised in this Petition. Thus, the court will still have to address Petitioner’s invalidity arguments under 35 U.S.C. §§ 102 and 103.

II. THE DIRECTOR SHOULD EXERCISE DISCRETION UNDER 35 U.S.C. § 314(a) TO DENY THE PETITION

Institution is improper unless the petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314. Institution is within the Director’s discretion. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016); *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 366 (2018); *see also Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016). The Director applies *Fintiv*’s six-

factor balancing test to determine whether discretionary denial is appropriate. *Fintiv*, IPR2020-00019, Paper 11 at 6 (*Fintiv* Factors). The Director also evaluates the PTAB’s “ability...to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AIA proceedings, and other workload needs.” Director’s Memo at 3. Here, each of these factors weighs in favor of denying institution.

A. Factor 1 Weighs Substantially in Favor of Discretionary Denial

The district court has not stayed the proceedings, and Petitioner has not moved for a stay. Indeed, there is insufficient evidence that one would be granted even if Petitioner moved to stay. Statistics on Judge David Ezra’s patent cases show that Judge Ezra has not considered a motion to stay pending IPR. Accordingly, Factor 1 weighs substantially in favor of discretionary denial.

B. Factor 2 Is Neutral

The presence of “events in other proceedings related to the same patent” may weigh against granting a petition. Consolidated Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019)) at 58. In fact, the Director may consider whether “the validity of the challenged patent is already being adjudicated in another forum that will issue” a decision before the FWD. *See Entegris, Inc. v. Inpria Corp.*, No. IPR2025-00267, Paper 12 at 2 (July 2, 2025); *see also* Director’s Memo at 2. The Director may find that discretionary denial is warranted when “arguments, evidence, and statements” are being “incorporated by reference,” “and the issues presented in

the Petition are ‘the same as, or substantially similar to, those already or about to be litigated’[.]”) *Id.* (quoting *Fintiv*, IPR2020-00019, Paper 11 at 14).

Here, Factor 2 is either a neutral factor or weighs slightly in favor of discretionary denial. No trial date has been set by the Court. However, the validity of the ’573 Patent will likely be adjudicated by the FWD deadline, or shortly thereafter. According to the median (26.2 months) and average (31 months) time-to-trial statistics for the Western District of Texas, a trial is estimated to occur between December 2026 and May 2027. The Court’s scheduling order is consistent with a trial estimated to occur in Spring 2027. For example, if the Markman hearing is held two weeks after Ginko files its claim construction sur-reply, all dispositive motions would be filed by February 12, 2027, one month before the FWD deadline. EX2004, ¶ 13. This suggests that a trial will likely be held shortly after the FWD deadline. Although the trial’s proximity to the FWD deadline weighs slightly in favor of discretionary denial, since the Court has yet to issue an order addressing pretrial matters or establishing trial deadlines, this factor is, at minimum, a neutral factor.

C. Factor 3 Weighs in Favor of Discretionary Denial

Discretionary denial is warranted where the parties “have made meaningful investment in the district court proceeding,” such as when “the parties have exchanged infringement and invalidity contentions, have already conducted over seven months of fact discovery, and a Markman hearing is scheduled to occur before

the due date for an institution decision.” *Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00223, Paper 9 at 2 (June 12, 2025) (denying institution).

By the March 10, 2026, institution decision deadline, significant investments in the corresponding litigation will have been made. Claim construction is well underway and nearly all claim construction briefs will be filed by the institution deadline. Moreover, the parties have exchanged their infringement and invalidity contentions, with Petitioner largely asserting system references as prior art, and notably, raising multiple § 112 and § 101 invalidity grounds that cannot be resolved by the Board. *See supra* § I.C.1. Ginko and Petitioner have also engaged in venue discovery, with Ginko serving interrogatories and requests for production, and deposing Petitioner’s corporate representative. While fact discovery does not open until “one week after the claim construction hearing[,]” claim construction briefing will require substantial investment by the parties and the Court. In any event, fact discovery itself will rapidly proceed and be completed in just under seven months, or no later than thirty weeks. EX2004, ¶ 10. Importantly, the Court’s investment in the Apple Case as of the institution deadline will also have been substantial. EX2004, ¶ 8. The Court addressed Petitioner’s motion to dismiss, entered scheduling, protective, and ESI orders, and will soon resolve Petitioner’s contested motion to transfer. The third *Fintiv* factor weighs in favor of discretionary denial.

D. Factor 4 Weighs Substantially in Favor of Discretionary Denial

Whether a Petitioner timely files a stipulation that it will not raise any ground raised or that could have reasonably been raised in an IPR is “highly relevant, but will not be dispositive by itself.” Director’s Memo at 2-3, citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (Dec. 1, 2020) (“Sotera”).

Here, Petitioner’s carefully limited stipulation fails to moot Petitioner’s expansive invalidity theories in the Apple Case, and indeed, would not meaningfully narrow the issues. “Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful[.]” Process, § I.D. A stipulation is even less meaningful when the petitioner is asserting that a claim is anticipated or obvious in the petition, but asserts that the same claim is indefinite in the corresponding litigation. “[T]he Board does not institute an *inter partes* review based on an indefiniteness challenge.” *Ebates Performance Marketing, Inc. v. Int’l Business Machines Corp.*, IPR2022-00439, Paper 11 at 11 (Oct. 3, 2022).

In its invalidity contentions, Petitioner outlines multiple bases for invalidity, including both statutory grounds and system prior art references that fall outside the scope of the Petition. Petitioner argues that the asserted claims of the ’573 Patent are directed to an abstract idea—the exchange of contact information—and are therefore patent-ineligible under 35 U.S.C. § 101. Petitioner also asserts that various claims

are invalid due to indefiniteness, lack of enablement, and insufficient written description under 35 U.S.C. § 112. Petitioner argues that Claim 1 is invalid for failing to meet the enablement and written description requirements with respect to the “processor” and “memory” limitations. Petitioner challenges independent Claim 10 as indefinite with respect to the “first permission setting” and contact configuration. That Petitioner asserts indefiniteness only underscores that the PTAB is not the appropriate forum to resolve the ’573 Patent’s validity in view of the significant number of invalidity defenses at issue. *Arthrex, Inc. v. MedShape, Inc.*, IPR2025-00053, Paper 11 at 14-15 (Apr. 25, 2025) (“In sum, for some of the Challenged Claims Petitioner identifies issues of indefiniteness in claim construction presented in the Parallel Proceeding that we cannot resolve in this proceeding.... This suggests that even if Petitioner has shown a reasonable likelihood of prevailing..., Petitioner’s disputes as they relate to the Challenged Claims, as a whole, may be more efficiently addressed in the Parallel Proceeding”); *see also Nokia of Am. Corp. v. Pegasus Wireless Innovation LLC*, IPR2025-00037, Paper 14 at 13 (Apr. 25, 2025) (noting that a stipulation is not dispositive given “the district court will still have to resolve various § 112 issues raised by the Petitioner”).

Moreover, in support of its 35 U.S.C. §§102–103 invalidity contentions, Petitioner charts several system references, including the BlackBerry Messenger (BBM) System, NFriendConnector System, LoKast System, Facebook Nearby

Friends System, Friendthem System, and Bump System. About 70% of the references raised in Petitioner’s invalidity contentions are systems that will not be considered by the Board. *See Motorola Sols. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3–4 (Mar. 28, 2025) (Director Review) (“Petitioner’s invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot”). Petitioner’s stipulation only covers the *combinations* of system references and the references raised in this Petition. Petitioner does not stipulate to any ground based on system art alone. Thus, far from materially reducing the overlap between proceedings, a stipulation would not moot Petitioner’s system-based invalidity theories and §§ 101 and 112 grounds. *See Motorola Sols.*, IPR2024-01205, Paper 19 at 3–4 (denying institution noting “Petitioner’s stipulation does not ensure that the[] IPR proceedings would be a ‘true alternative’ to the district court proceeding”); *Shenzhen Tuoshu Tech. Co., Ltd v. Stratasys, Inc.*, IPR2025-00354, Paper 11 at 2–3 (June 12, 2025) (same); *Nokia of Am. Corp*, IPR2025-00037, Paper 14 at 13 (noting that a stipulation would not be dispositive given “that some issues will remain—the district court will still have to resolve various § 112 issues raised by the Petitioner”). Factor 4 weighs in favor of discretionary denial.

E. Factor 5 Weighs in Favor of Discretionary Denial

The parties to the Petition are the same as those in the Apple Case. Accordingly, Factor 5 weighs in favor of discretionary denial. *See Sotera*, IPR2020-01019, Paper 12 at 19 (precedential as to Section II.A).

F. Factor 6 Weighs in Favor of Discretionary Denial

“[C]onsistent with the discretionary considerations enumerated in existing Board precedent...and the Consolidated Trial Practice Guide (Nov. 2019), the parties are permitted to address all relevant considerations, which may include: ...[t]he strength of the unpatentability challenge; [s]ettled expectations of the parties, such as the length of time the claims have been in force;...and [a]ny other consideration bearing on the Director’s discretion.” Director’s Memo at 2–3.

1. Strength of the Unpatentability Challenge

The merits of the Petition are weak, as Ginko will establish more fully in its forthcoming Preliminary Response. *See Process*, § II.C.i (“[W]hen filing a brief for discretionary denial, a patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits.”). Accordingly, the sixth *Fintiv* factor weighs in favor of discretionary denial.

2. Settled Expectations

The sixth *Fintiv* factor also weighs in favor of discretionary denial because Ginko has settled expectations that the ’573 Patent would not be challenged.

“Although there is no bright-line rule on when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be.” *Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (June 18, 2025). “This approach aligns with other approaches to settled expectations and incentives, for example, for filing infringement lawsuits.” *Id.* (citing 35 U.S.C. § 286 (“Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.”)); *Nvidia Corporation v. Neural AI, LLC*, IPR2025-00606, Paper 18 at 3 (July 31, 2025) (“Petitioner’s failure to seek early review of the patents favors denial.”).

Although the ’573 Patent issued on June 1, 2021, since the priority date for the ’573 Patent is June 22, 2015, the ’573 Patent is already ten years into its enforceable patent term, and the application that issued as the ’573 Patent was filed over six years ago, on December 7, 2018. *See Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9 at 3 (July 24, 2025) (“the challenged patents have been in force for seven and six years, respectively, creating strong settled expectations for Patent Owner...”). Although the patent application was not immediately published, shortly after filing the application, in December 2018, Ginko launched its innovative mobile contact sharing application on Petitioner’s own iOS, and went on to promote the app as its patented technology through national media coverage and at prominent

technology industry events, such as SXSW—a festival known to have promoted and debuted at least one startup that Petitioner famously acquired shortly thereafter (*e.g.*, Siri). Petitioner should have been aware of Ginko’s patented technology in December 2018, or at minimum, March 2019, when Ginko demonstrated the app at SXSW. Ginko’s long-settled expectations weigh in favor of discretionary denial.

III. THE DIRECTOR SHOULD EXERCISE DISCRETION UNDER 35 U.S.C. § 325(d) TO DENY THE PETITION

The Director should deny institution under 35 U.S.C. § 325(d). Petitioner relies solely on art and arguments that are the same or substantially the same as those considered by the Examiner during prosecution, and Petitioner has not attempted to demonstrate material error by the Examiner. Under the *Advanced Bionics* framework, the PTAB must first determine whether the art or arguments were previously presented (step one), and, if so, whether the Office materially erred in allowing the claims (step two). *See, e.g., Advanced Bionics*, IPR2019-01469, Paper 6 at 10. The two step inquiry is guided by the non-exclusive factors articulated in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017) (“*Becton Dickinson*”), which address how the Examiner evaluated the art, how the petitioner’s arguments differ from those made during prosecution, and whether other facts warrant reconsideration.

A. Petitioners' Art and Arguments Were Already Considered

Although Petitioner raises three grounds for invalidity, the Petition is in fact asserting two sets of grounds. For Ground 1, Petitioner asserts obviousness in view of Robertson (U.S. Pat. 8,380,796) (EX1004), whereas for Grounds 2–3, Petitioner asserts obviousness in view of Ahuja (U.S. Publ. No. 2010/0280904) (EX1005). Given that Robertson is identical to, and Ahuja cumulative of, prior art already considered by the Examiner, the first *Advanced Bionics* prong warrants denial.

1. Robertson Was Already Considered by the Examiner

Petitioner concedes that two other related Robertson patents were cited in an Information Disclosure Statement (IDS) during the '573 Patent's prosecution and are listed on the face of the '573 Patent and its parent. Pet. at 5 (“[T]wo related applications[sic] to Robertson (US 7,606,725, US 7,194,419) were cited by the applicant during examination of the '573 patent[.]”); *see also* EX1003, 125–127 (showing the Examiner's signature that the IDS citing the Robertson patents was considered on August 12, 2020). Petitioner faults the Examiner for not citing U.S. Pat. No. 8,380,796 (“Robertson '796”), yet neglects that Robertson '796 shares the same *disclosure* with the other two patents, U.S. Pat. No. 7,194,419 (“Robertson '419”) (EX2005) and U.S. Pat. No. 7,606,725 (“Robertson '725”) (EX2006).² That

² In fact, the disclosures should mirror one another, given that Robertson '796 is a division of a continuation of a division of Robertson '419, and Robertson '725 is a continuation of Robertson '419.

Robertson '796 was not cited during prosecution does not mean its disclosure was not considered. For example, Petitioner asserts that “Robertson discloses *the first permission setting* (selected data settings) *being at least a first value* (selected or not selected) *indicating that a subset* (one or more selected permission levels) *of user data of a permitting user is to be shared with a permitted user.*” Pet., 17 (emphasis in original). In support, Petitioner cites EX1004, 7:53–58: “Unlike the prior art, which does not allow the first user to specify data field permissions for individual other users, the disclosed system allows the first user to specify permissions separately for each individual other user in whose personal database the first user has chosen to be included.” This exact excerpt is found in the disclosures of Robertson '725 (EX2006, 8:17–22) and Robertson '419 (EX2005, 8:16-21). Moreover, Petitioner significantly annotates FIG. 9 of Robertson '796 (EX1004):

The image shows a 'PSEUDO PERMISSION FORM' with the following elements and annotations:

- 600-2**: Instruction text: "Click on the boxes next to the Permission Levels that you would like to grant to your new contact"
- 600-4**: Contact name: "John Doe"
- 600-6**: Permission level: "Crossing Paths Notification Permission" (checked)
- 600-7**: Permission level: "Personal Information" (unchecked)
- 600-8**: Permission level: "Work Information" (checked)
- 600-10**: Permission level: "Birthday Notification" (checked)
- 600-12**: Permission level: "Friend of Friends Information" (checked)
- 600-14**: "Submit" button
- 600-16**: "Submit" button

Pet., 19.

Yet this permission form is “Figure 9” for all three patents. The three patents are not only related—their disclosures are virtually identical, sharing the same fourteen figures, specification, and priority chain. Accordingly, by raising Robertson ’796 as a single-reference ground for invalidity, Petitioner does nothing more than recycle prior art already considered by the Examiner. Prong 1 of the *Advanced Bionics* framework thus weighs in favor of discretionary denial.

2. Ahuja is Substantially Similar To References Considered by the Examiner

Similarly, Ahuja is cumulative of references cited during examination. Petitioner’s reliance on Ahuja (US 2010/0280904) warrants denial because both Lim (US 2010/0088246) (EX2007) and Lyren (US 2014/0244744) (EX2008), which were cited in the IDS, considered by the Examiner, and are directed to proximity based social networking applications, address the same features that Petitioner argues are included in Ahuja. Lim notes a system may “limit communications in the social network to users in a common geographic location, the common location region being determined by a region associated with a specific geographic location of respective GPS-enabled devices[.]” EX2007, [0020]. Petitioner argues that Ahuja discloses proximity/location-based identification of potential contacts and limiting communications to users in a defined region or geo-fence. *See, e.g.,* Pet., 31–34. Moreover, Lim’s system is implemented on “smart-mobile phones, PDAs, or any

other devices with internet capability” (EX2007, [0051]), just as Ahuja discusses a mobile and wireless device environment. *See, e.g.*, Pet., 29–33. Lim further discusses an initiation of contact requests by users: “the user initiates a request to communicate with the selected user by pressing the selected user’s ‘Goose me’ button.” EX2007, [0134], *see also* FIG. 7. Petitioner argues that Ahuja discloses initiation of contact or communication requests, and mutual or bidirectional acceptance of contact requests. *See, e.g.*, Pet., 39–43. Lim’s privacy controls allow users “to selectively hide a portion of the characteristic data or contact information from a selected subset of all users in the social network” (EX2007, [0019]), and “the receiving user may answer...by accepting the request.” EX2007, [0019]. “[I]f the request is accepted, the system establishes a communication connection between the users.” *Id.* Petitioner asserts that Ahuja discloses permission/profile-based selective data sharing. *See, e.g.*, Pet., 29–32.

Likewise, Lyren is cumulative of Lim and Ahuja, disclosing “electronic devices” which use proximity and location information to identify and match with other users, notifying users “when another individual with a common interest is discovered[,]” exchanging personal information, and having “privacy settings that provide rules and restrictions with regard to the personal information....” (EX2008, ¶¶ 24, 72, 146). Communications are limited to users within a specified physical area, such as a shopping mall or campus. *Id.*, ¶¶ 71-72. Accordingly, the features for

which Petitioner argues are present in Ahuja are cumulative of features in Lim and Lyren, which were already considered by the Examiner. The Petition does not present any new or materially different teachings. Prong 1 of the *Advanced Bionics* framework thus weighs in favor of discretionary denial.

B. Petitioner Does Not Point to Any Material Error

Upon satisfaction of Prong 1, the Board requires “a showing that the Office erred in evaluating the art...” *Advanced Bionics*, IPR2019-01469, Paper 6 at 8. Petitioners have not alleged any material defect or error of any kind that occurred during examination. While the Petition argues that the Robertson ’796 was not discussed in the prosecution history of the ’573 Patent (Pet., 5), the Examiner did consider the same identical disclosure via the two other Robertson patents and the Petition does not raise any failure by the Office to consider any disclosure of the references cited during examination, including Lim or the other Robertson patents. Nor does the Petition attempt to show that any of the references cited in the Petition disclose any new material that was not considered during examination. Thus, Prong 2 weighs heavily in favor of discretionary denial.

IV. CONCLUSION

Ginko respectfully requests the Director exercise discretion under Sections 314(a) and 325(d) to deny institution.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

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