UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

GINKO, LLC,
Patent Owner

Inter Partes Review No. IPR2025-01388

PETITIONER'S OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEFING

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I. INTRODUCTION

The Director should reject the request for discretionary denial in Ginko, LLC's Brief (Paper 8, the "DD Brief"). Discretionary denial is particularly inappropriate here because:

(1) the Office materially erred during prosecution;

(2) Patent Owner ("PO") cannot allege settled expectations because the '573 patent issued less than five years ago, and the PO has shifted the scope of the claims to cover a different technology; and

(3) the trial date in the corresponding district court litigation has not yet been set and a motion to transfer is pending but will occur no sooner than three months ***after*** the due date for a final written decision in this IPR.

The other *Fintiv* factors, settled expectations, and §325(d) analysis also strongly favor institution.

II. MATERIAL ERROR BY THE EXAMINER OUTWEIGHS THE FINTIV FACTORS

Discretionary denial is inappropriate "because the Office materially erred during prosecution of the challenged patent." *Xencor, Inc. v. Merus, N.V.,* IPR2025-00603, Paper 12 at 2-3 (Director July 17, 2025). On October 11, 2019, PO filed an information disclosure statement citing U.S. Patent No. 7,606,725 (hereinafter "Robertson '725") and U.S. Patent No. 7,194,419 (hereinafter "Robertson '419"). EX1003, 131. Robertson '725 and Robertson '419 are both

parent applications to U.S. Pat. No. 8,380,796 ("Robertson '796") (EX1004), which formed the basis of Petitioner's Ground 1 in the present proceedings. PO does not dispute that Robertson '796 shares a common disclosure with Robertson '725 and Robertson '419. The Examiner ultimately allowed the application without applying Robertson '725 or Robertson '419, thereby failing to recognize the pertinence of Robertson '725 and Robertson '419 to the pending claims.

In the Notice of Allowance, the Examiner did not make any statements on the record. EX1003, 21. Yet, the Petition shows that Robertson '796 individually discloses and/or renders obvious each limitation of the '573 patent. Accordingly, the Examiner materially erred when he failed to apply any of Robertson '796, Robertson '419, or Robertson '725 to the limitations during prosecution or to understand their significance. This alone is a sufficient reason to reject the request for discretionary denial. In *Xencor*, for example, the Director rejected a request for discretionary denial because the patent examiner allowed the claims on the basis that "the prior art does not teach or suggest replacing a neutral amino acid…with a positively charged amino acid in the cH3 domain[,]" but the petitioner presented evidence that a reference cited in an IDS during prosecution taught that limitation. IPR 2025-00604, Paper 12 at 3. Here too, the Examiner ignored the explicit teachings of Robertson '725 and Robertson '419 when he issued the notice of allowance.

The Director has explained that evidence of material error by the Office can outweigh other discretionary denial factors. Microsoft Corp., IPR2025-00318, Paper 9 at 3 ("Ordinarily, a scheduled district court trial date that precedes the date projected for a Board final written decision weighs in favor of exercising discretion to deny the Petition. Here, however, the Petitioner appears to show a material error by the Office and it is an appropriate use of Office resources to review the potential error."). Therefore, this error favors denying PO's Request for Discretionary Denial.

The legal and factual showings here satisfy the material error standard. Under the rationale of the *Xencor* and *Microsoft* decisions, these considerations outweigh other concerns, and accordingly, the denial of PO's request for discretionary denial is appropriate

III. DISCRETIONARY DENIAL IS NOT WARRANTED

A. Fintiv Factors Do Not Support Discretionary Denial

1. Factor 1 (Stay) Does not Support Discretionary Denial

This factor considers "whether a stay exists or is likely to be granted if a proceedings is instituted. *Fintiv*, Paper 11 at 6. Here, Petitioner has requested a stay in the corresponding litigation. EX1010. Therefore, at worst, this factor is neutral because the Board "will not attempt to predict" how the district court will proceed if a stay has been requested by either party. *Sand Revolution II, LLC v.*

Continental Intermodal Group – Trucking LLC, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative).

2. Factor 2 (Trial Date) Weighs Strongly Against Discretionary Denial

This factor considers the "proximity of the court's trial date to the Board's projected statutory deadline." *Fintiv*, Paper 11 at 9. "If the court's trial date is at or around the same time as the projected statutory deadline or even significantly after the projected statutory deadline," the decision whether to exercise discretionary denial likely will turn on other factors, "such as the resources that have been invested in the parallel proceeding" (factor 3). *Fintiv*, Paper 11 at 9.

Here, the district court has not set a trial date. EX2002, 6. The Board mailed its notice of filing date for this petition on September 10, 2025. Paper 3. This sets the statutory deadline for the Board's final written decision as March 10, 2027. According to the latest Federal Court Management Statistics, the median time from filing to trial in WDTX is 32.8 months. EX1008, 37. Based on the October 24, 2024, filing of the complaint, this brings the calculated expected trial date to somewhere between June 2027 and July 2027—more than three months ***after*** the statutory deadline for final written decision. The Director has held that such facts weigh against discretionary denial. *See, e.g., Amazon.com, Inc. v. NL Giken Inc.,* IPR 2025-00250, Paper 14 at 2 (Director May 16, 2026) (determining not to

exercise discretion to deny institution because "it is likely that a final written decision in this proceeding will issue before the district court trial occurs").

In their DD Brief, PO relies upon statistics to support their position that significant progress will be made before the March 10, 2027, final written decision deadline, including a 26.2-month median and 31-month average time-to-trial. However, PO provides no citations to support these metrics. Moreover, as PO is aware but failed to mention, the Court is currently weighing Defendant/Petitioner's request to transfer Venue from WDTX to NDCA, which would push the trial date even further than the currently projected timeframe of June 2027 to July 2027. The median time from filing to trial in NDCA is 37.6 months. EX1008, 66. This extends the calculated expected trial date even more than three months.

Therefore, this factor weighs against denial.

3. Factor 3 (Parallel Proceeding) Weighs Strongly Against Discretionary Denial

This factor considers "the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision." *Fintiv*, Paper 11 at 9. "If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution." *Fintiv*, Paper 11 at 9.

Here, the district court has not and is unlikely to make any substantive rulings bearing on the asserted '573 patent until after the institution decision.

EX1009 (Scheduling Order). This factor weighs strongly against discretionary denial because the earliest such order from the Court will follow a *Markman* hearing that will not even be set until ***after*** the institution deadline of March 10, 2026. *See Samsung Display Co. v. Pictiva Displays Int'l. Ltd.,* IPR2024-1222, Paper 12 at 7 (PTAB Mar. 6, 2025) (factor weighs against denial even though a *Markman* hearing had occurred in part because "much remains to be done, including expert discovery"); *SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01432, Paper 14 at 8-9 (PTAB Apr. 7, 2025) (factor favors institution even after *Markman* briefing was complete). PO's allegations that this factor weighs in favor of discretionary denial is without merit. The Court's order granting and denying-in-part Petitioner's motion to dismiss did not concern the subject matter of the '573 patent, and the order the Court may or may not issue before the institution date on Petitioner's transfer motion will not either. That the parties will have filed "all claim construction briefs… exchanged their infringement and invalidity contentions," and "engaged in venue discovery" and related transfer briefing does not weigh in favor of denial because none of that work by the parties is a substantive ruling on the '573 patent either. Nor can PO credibly claim that entering "scheduling, protective, and ESI orders" are milestones to be considered substantive rulings on the '573 patent when all were jointly filed as agreed-to motions to the court.

Accordingly, this factor weighs against discretionary denial.

4. Factor 4 (Issue Overlap) Weighs Strongly Against Discretionary Denial

This factor considers the "overlap between issues raised in the petition and in the parallel proceeding." *Fintiv,* Paper 11 at 12. Petitioner has already submitted a broadened *Sotera* stipulation ("*Sotera* plus stipulation") in this IPR. EX1007; *see also Sotera Wireless, Inc. v. Masimo Corp*., IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020) ("Sotera") (describing the standard less-broad Sotera stipulation). Petitioner's Sotera plus stipulation goes beyond the standard Sotera stipulation by extending to "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 [this IPR]" and "any ground that could be raised under §§ 102 or 103 on the basis of system art corresponding to a reference that forms the basis of any ground raised in [this IPR]." EX1007, 2. Petitioner's Sotera plus stipulation ensures that this IPR will be a true alternative to the parallel district court action. Indeed, the Director has described this type of stipulation as "broad" and as a factor that helps "tip the balance against discretionary denial." *Shenzen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 at 3 (Director Jul. 17, 2025); *Shenzen Tuozhu Tech. Co. v. Stratasys, Inc*., IPR2025-00438, EX1033 at 1 (stipulation with a scope identical to Petitioner's Sotera plus stipulation); *see also Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217,

Paper 9 at 2 (such a stipulation is "broad" and "counsel[s] against discretionary denial"); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, EX1067 at 2 (stipulation). Petitioner's Sotera plus stipulation therefore makes this factor weigh against discretionary denial.

In their briefing, PO alleges that the stipulation does not go far enough because "Petitioner does not stipulate to any ground based on system art alone" and that the stipulation is "far from materially reducing the overlap between proceedings." Paper 8, 12. However, Petitioner is not permitted to submit system art references in an IPR proceeding. Accordingly, through the *Sotera* plus stipulation, Petitioner ensures the Board that the IPR proceedings will act as a true alternative to the parallel district court action by removing any duplicate considerations between the two proceedings.

Therefore, this factor weighs against denial.

5. Factor 5 (Same Party) Weighs Against Discretionary Denial

Because Petitioner and PO are the parties in the district court litigation, and because the Board will issue a final written decision at least three months prior to any trial in the district court, this factor weighs against discretionary denial. *Samsung Elecs. Co. v. Staton Techiya, LLC*, IPR2022-00302, Paper 13 at 18-19 (PTAB Jul. 11, 2022) (factor five weighs against discretionary denial when

statutory deadline for final written decision is before expected trial date in parallel litigation).

6. Factor 6 (Other Considerations) Does Not Support Discretionary Denial

This factor considers any "other circumstances" as "part of a balanced assessment of all the relevant circumstances." *Fintiv,* Paper 11 at 14. Here, the merits of the petition are strong. The petition includes three grounds, two of which are based on separate references for each of the Challenged Claims of the '573 patent. The DD Brief identifies no weaknesses in any of the challenges. DD Brief, 19. This factor therefore also weighs against discretionary denial.

In sum, none of the *Fintiv* factors favor the Director exercising discretion to deny institution and several factors weigh strongly against discretionary denial.

IV. NO SETTLED EXPECTATIONS

A. '573 Patent Has Been in Force for Less Than Five Years

As the Director has stated, "early challenges favor robust, predictable patent rights and weigh against discretionary denial." *See ,e.g., Alpinestars S.p.A. v. Dainese S.p.A., IPR2025-00750*, Paper 14 at 2 (Director August 14, 2025). The '573 patent issued on June 1, 2021, and therefore has been in force less than five years. The Deputy Director has routinely denied requests for discretionary denial for patents that have been in force for less than six years when the Fintiv factors weigh against discretionary denial. *See id.; see also Apple Inc. v. Apex Beam*

Techs. LLC, IPR2025-00896, Paper 10, at 3 (Director Sept. 3, 2025) (denying discretionary denial request for patents issued in 2021-2023 when the final written decision was due before the projected trial date and a large number of patents was asserted); *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 3 (Director, Jul. 2, 2025) ("Lastly, the challenged patents issued in 2019 and 2020, such that Patent Owner had not developed strong settled expectations that favor discretionary denial."). The same result should apply here because the '573 patent has been in force for less than five years and the Fintiv factors weigh strongly against discretionary denial.

In the DD Brief, PO misapplies well-settled law by pointing to the priority date of the '573 patent instead of the issue date to argue that settled expectations apply because "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." Paper 8, 14. It is well established that the enforceable term of a patent does not begin at the priority date but instead begins on the issue date and ends 20 years from the priority date:

> TERM.—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States, or, if the application contains a specific reference to an earlier filed application…from the date on which the earliest such application was filed

35 US.C. §154(a)(2). Therefore, PO cannot rely on events prior to the issuance date of the ’573 patent to show settled expectations.

Further, PO cites to two non-patent events to allegedly show that Petitioner should have known about Ginko’s patented technology – a 2018 press release (EX2009) and a 2019 SXSW promotion (EX2010). Neither event is sufficient to show settled expectations. As noted above, settled expectations is predicated on the issue date of the patent, not marketing efforts by PO. Moreover, both the 2018 press release and the 2019 SXSW promotion occurred nearly two full years before the earliest publication of the ’573 patent on June 1, 2021. A practitioner performing a diligent search would not have been able to identify the ’573 patent during this time.

B. PO’s Claim Scope Does Not Encompass Petitioner’s Technology

PO is also not entitled to “settled expectations” because the scope of the asserted claims is not commensurate with their infringement theory. In their initial infringement contentions, PO has stretched the meaning of the asserted claims of the ’573 patent to encompass peer-to-peer communication between a first user device and a second user device. EX1006, 4-11. However, although the ’573 patent briefly references a peer-to-peer embodiment in the specification, the asserted and challenged claims are expressly limited to a server-mediated communication system whereby a first device communicates with a second device

of a potential contact through an intermediary server system. Petitioner's technology, by contrast, operates in a peer-to-peer manner without reliance on a server to mediate communications between devices. It would not have been reasonable for Petitioner to expect that PO would stretch the meaning of their claims to encompass a peer-to-peer architecture, particularly when the claims themselves are unambiguously directed to server-mediated systems. Even the press releases that PO relies upon to support their claim for settled expectations fails mention or reference "peer-to-peer" communication protocols for their technology. EX2009; EX2010. As such, PO cannot have formed any settled expectations regarding the '573 patent as it relates to peer-to-peer communication.

Accordingly, for the above reasons, PO has failed to establish settled expectations for the '573 patent.

V. §325(d) DOES NOT SUPPORT DISCRETIONARY DENIAL

Under §325(d), "the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. §325(d). In applying §325(d), the Board uses the two-part framework set out in *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). That framework in turn relies on the Becton factors. *Id.* at 7-11 (citing *Becton, Dickinson & Co. v. B. Braun*

Melsungen AG, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to §III.C.5, first paragraph) ("Becton")). The Becton factors include:

(a) the similarities and material differences between the asserted art and the prior art involved during examination;

(b) the cumulative nature of the asserted art and the prior art evaluated during examination;

(c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;

(d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art;

(e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and

(f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

See Becton, Dickson, Paper 8 at 17–18 (§ III.C.5, first paragraph).

Both prongs of the *Advanced Bionics* framework favor institution here.

A. Prong One of Advanced Bionics

The first prong of *Advanced Bionics* determines whether the same or substantially the same art was previously presented to the Office or whether the same or substantially the same arguments were previously presented. *Advanced*

Bionics, IPR2019-01469, Paper 6 at 8-10; *Becton*, IPR2017-01586, Paper 8 at 17-18. The first prong involves evaluation of *Becton* factors (a), (b), and (d).

It is undisputed that Ahuja, the primary reference relied on in the Petition for Grounds 2 and 3, was never before the Office. This fact is sufficient to avoid denial under §325(d). PO alleges, however, that Ahuja is cumulative of references cited during examination, by pointing to Lim (US 2010/0088246) and Lyren (US 2014/0244744), which were both cited in IDSs during examination. Paper 8, 18; EX1003, 132 (Lim IDS), 13 (Lyren IDS). Despite being cited by the PO, the Examiner never applied Lim and Lyren to the pending claims and there is no evidence that the Examiner appreciated the pertinence of Lim and Lyren to the pending claims. PO's sole basis for alleging Ahuja is cumulative to Lim and Lyren relies on high-level, broad descriptions of the references to allege that Ahuja is substantially the same as Lim and Lyren. Such a high-level, generalized, comparison between references cannot amount to a showing similarity between the references. When the references are considered beyond a surface-level analysis, it becomes clear that Lim and Lyren are completely different from Ahuja and, therefore, Ahuja cannot be considered similar to or cumulative of Lim and Lyren. Therefore, factors (a) and (b) weigh in favor of Petitioner.

For example, Lim is directed to online dating technology. EX2007, ¶51 ("the invention will be described with respect to online dating website systems that use

internet network architecture and infrastructure"). Lim describes structures on how users discover each other, initiate contact, and communicate, while imposing rules and incentives to reduce spammy solicitations and encourage timely, sincere engagement. EX2007, ¶87 ("Users can only request a limited number…of contact requests…at one time" which "minimizes date spamming and places a value on contact requests as a limited resource that encourages users to carefully evaluate…their contact requests"), ¶88 ("The timer concept associated with Autoduck and Wild Goose Chase ratings encourages prompt responses"), ¶77 ("The Wild Goose Chase rating provides an indication of how responsive a user is after a contact request has been accepted (goose). If a user has a high Wild Goose Chase rating, it may indicate that the user may 1) be on the site to simply get attention 2) is not sincere or responsible or 3) is too busy and is not responsive in dating."). Lim uses various techniques to achieve this result, such as queuing, timers, quotas, and a token/escrow mechanism to meter behavior, plus privacy controls, ratings, scheduling, and optional gifting/ads features. EX2007, ¶117 ("Each user will have an outgoing request queue 410 and an incoming request queue 412. Each message request within a queue is associated with a request timer 414."), ¶71 ("Holds the tokens that a user uses for contacts or gift purchases (e.g. goose request, nest egg purchase, or virtual flowers purchase) until the recipient user accepts the contact or the gift.").

Further, Lyren discloses autonomous user agents that, without contemporaneous user knowledge or instruction, select other users' devices, exchange personal information, algorithmically determine "common interests," and then take consequential social-network actions such as adding contacts to a user's social page and initiating communications and meetings. EX2008, ¶19 ("a method in which a first user agent of a first user selects, without knowledge of and instruction from the first user, an electronic device of a second user having a second user agent"), ¶46 ("This post can occur without express permission from, authorization from, or even knowledge of the first and/or second users (such as when the second user trusts a judgment of the second user agent to select and post photographs to the social networking webpage on behalf of the second user)"), ¶59 ("The user agent performs these tasks without instruction from the user to post the information and without knowledge of the user of the information being posted"), ¶72 ("This process of locating other individuals and exchanging personal information can occur without knowledge of and/or instruction from the users "), ¶¶34-37.

In contrast, Ahuja is not concerned with improving online dating technology through various safeguards to meter behavior, reduce spammy solicitations, and encourage timely, sincere engagement like that discussed in Lim. Ahuja is similarly not concerned with autonomous user agents that facilitate consequential

social-network actions like that discussed in Lyren. Accordingly, Ahuja is not merely cumulative of Lim and Lyren.

Moreover, the Petition presents evidence that the limitations added to the independent claims in order to obtain an allowance are disclosed by Ahuja. Although the Examiner did not provide any remarks when issuing the notice of allowance, the amendment immediately preceding the notice of allowance relied upon the following added limitations:

> "a communication to the potential contact to initiate a data exchange [is sent, based on a request]" where "the request comprises a first permission setting" that "[is] at least a first value or a second value" and where "the second value indicates that only chats are allowed from the permitted user to the permitting user"

EX1003, 57 (Amendments and arguments to claim 1),

> "receiving, from the user device of the user, a request for the user to become a contact with the potential contact, the request comprising a first permission setting, and the first permission setting being at least a first value indicating that a subset of user data of a permitting user is to be shared with a permitted user; sending, based on the request, a communication to the potential contact to initiate a data exchange"

EX1003, 58 (Amendments and arguments to pending claim 12, now issued claim 10),

> "receiving instructions from the user to set the first profile as public and set the second profile as private" and "on a condition that the selected profile is public, automatically sharing, without an explicit action by the first user, the selected profile with the second user; and on a condition that the selected profile is private, sharing the selected profile with the second user in response to the first"

EX1003, 58-59 (For pending claim 21, now issued claim 16),

> "identifying the second user as a potential contact for the first user based on proximity of the second user to the first user by: generating, on a device of the first user, a user interface display including a detection activation toggle function and a status indicator for an automatic mode; receiving a command from the user to activate the automatic mode; activating, in response to the command, the automatic mode, wherein the command is one of a first command or a second command, wherein the first command indicates that the automatic mode is activated until the user deactivates the automatic mode, and wherein the second command indicates that the automatic mode is activated for a first period of time; sending a request to a network server to search for user devices while the automatic mode is activated to identify potential contacts in response to user interface with the detection activation toggle function; and identifying the second user as the potential contact"

EX1003, 60-61 (Amendments and arguments for claim 30).

As set forth in the Petition, Ahuja discloses each of these amended limitations. Therefore, PO's position that Ahuja is cumulative of Lyren and Lim is without merit. Accordingly, discretionary denial under §325(d) with respect to Ahuja is not warranted.

Further, because Ahuja was never considered during examination, there is no overlap between the arguments made during examination and the manner in which petitioner relies on the prior art. Therefore, factor (d) weighs in favor of Petitioner.

With respect to Robertson '796 (EX1004), Petitioner notes, as acknowledged above, that parent applications to Robertson '796 – Robertson '725

and Robertson ’419 – were previously presented to the Office in an IDS filing. §II (Material Error by the Examiner). Because the Examiner only initialed the IDS but did not apply Robertson ’725 or Robertson ’419, a further inquiry is required under Prong Two of the Advanced Bionic framework. *See Ecto World, LLC and SV3, LLC v. RAI Strategic Holdings, Inc*., IPR2024-01280, Paper 13 at 5 (PTAB May 19, 2025) (“a petitioner must provide an analysis [under Prong Two of the Advanced Bionic framework] even when the asserted prior art is on an IDS, but the Examiner did not apply the reference”).

B. Prong Two of Advanced Bionics

The second prong determines whether the petitioner has demonstrated error in a manner material to the patentability of challenged claims. *Advanced Bionics,* IPR2019-01469, Paper 6 at 8-10; *Becton,* IPR2017-01586, Paper 8 at 17-18. The second prong involves evaluation of *Becton* factors (c), (e), and (f).

With respect to Ahuja, because the first Advanced Bionics prong is not met, the second prong need not be evaluated.

With respect to Robertson ’796, contrary to PO’s arguments, the Petition shows that the Examiner erred in allowing the claims and specifically erred in failing to apply Robertson ’725 and Robertson ’419 during examination. The Petition clearly shows that Robertson ’796 renders the challenged claims obvious and that the Examiner issuing those claims over Robertson ’725 and Robertson

’419 represents material error. §II (Material Error by the Examiner). Therefore, factors (e) and (f) weigh in favor of Petitioner.

Furthermore, during examination, the Examiner never formulated a rejection using either Robertson ’725 or Robertson ’419 and therefore materially erred by overlooking the teachings of Robertson ’725 and Robertson ’419. Instead, PO’s sole argument relies on mere initialing of an IDS by the Examiner, which is not sufficient to show that the Examiner materially considered Robertson ’725 or Robertson ’419. *See Ecto World*, Paper 13 at 5-6 (“[a] petitioner…may point to the fact that even though the asserted prior art is listed on an IDS, the Examiner did not issue any prior art rejections during examination, so the Examiner materially erred by overlooking certain teachings in the prior art on the IDS”).

Accordingly, for these reasons, denial under §325(d) is inappropriate.

VI. CONCLUSION

For the foregoing reasons, and in view of the clear material error by the Office, the lack of settled expectations, and the *Fintiv* and §325(d) factors weighing against discretionary denial, institution is warranted and the PO's request should be denied.

Date: December 10, 2025

Respectfully submitted,

/s/ *Larissa S. Bifano*

Larissa S. Bifano
Reg. No. 59,051
DLA Piper LLP (US)
33 Arch St., 26th Floor
Boston, MA 02110
Phone: 617.406.6013
Fax: 617.406.6100
larissa.bifano@dlapiper.com
Attorney for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) and 42.105 that on December 10, 2025, a true and correct copy of the foregoing document was served by emailing a copy of the same (by agreement) to the following attorney for Patent Owner:

IPTeam@simonlawpc.com

asimon@simonlawpc.com

rudy.telscher@huschblackwell.com

Date: December 10, 2025

/s/ Larissa S. Bifano

Larissa S. Bifano
Reg. No. 59,051
DLA Piper LLP (US)
33 Arch St., 26th Floor
Boston, MA 02110
Phone: 617.406.6013
Fax: 617.406.6100
larissa.bifano@dlapiper.com

Attorney for Petitioner