

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,

Petitioner,

v.

SECURE COMMUNICATION TECHNOLOGIES, LLC,

Patent Owner.

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Case IPR2026-00098

U.S. Patent No. 11,995,685

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**PATENT OWNER'S PRELIMINARY RESPONSE**

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## **PATENT OWNER'S EXHIBIT LIST**

| <b>Exhibit #</b> | <b>Description</b>                                                                                                                                                 |
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| 2001             | Declaration of James Proctor, Jr.                                                                                                                                  |
| 2002             | Mr. Proctor's November 2011 Correspondence with Google                                                                                                             |
| 2003             | LinkedIn Profile – Kyle Enright (Google)                                                                                                                           |
| 2004             | Mr. Proctor's February 2012 Correspondence with Google                                                                                                             |
| 2005             | LinkedIn Profile – Amar Mehta (Google)                                                                                                                             |
| 2006             | Application Data for Google's U.S. Patent Application No. 13/716,675                                                                                               |
| 2007             | December 2012 IDS from U.S. Patent Application No. 13/716,675                                                                                                      |
| 2008             | Application Data for Google's U.S. Patent Application No. 12/969,291                                                                                               |
| 2009             | May 2012 IDS from U.S. Patent Application No. 12/969,291                                                                                                           |
| 2010             | Application Data for Motorola Mobility's U.S. Patent Application No. 13/738,384                                                                                    |
| 2011             | May 2014 Notice of References Cited from U.S. Patent Application No. 13/738,384                                                                                    |
| 2012             | Application Data for Google's U.S. Patent Application No. 17/305,266                                                                                               |
| 2013             | July 2021 IDS from U.S. Patent Application No. 17/305,266                                                                                                          |
| 2014             | Complaint from <i>Secure Commc'n Techs., LLC v. Samsung Elecs. Co., Ltd. et al.</i> , No. 2:24-cv-484-JRG (E.D. Tex.)                                              |
| 2015             | Redacted Version of Samsung's Motion to Transfer Venue from <i>Secure Commc'n Techs., LLC v. Samsung Elecs. Co., Ltd. et al.</i> , No. 2:24-cv-484-JRG (E.D. Tex.) |
| 2016             | Complaint from <i>Secure Commc'n Techs., LLC v. Google, LLC</i> , No. 1:25-cv-1207 (W.D. Tex.)                                                                     |
| 2017             | First Amended Complaint from <i>Secure Commc'n Techs., LLC v. Google, LLC</i> , No. 1:25-cv-1207 (W.D. Tex.)                                                       |
| 2018             | Google blog article concerning Nearby Share                                                                                                                        |
| 2019             | Article from Techcrunch.com concerning Google Fast Pair                                                                                                            |
| 2020             | Article from Techcrunch.com concerning Android Device Manager (precursor to Google Find Hub)                                                                       |
| 2021             | Google blog article concerning generations of Pixel phones                                                                                                         |
| 2022             | First Amended Complaint from <i>Proxicom Wireless, LLC v. Target Corp.</i> , No. 6:19-cv-01886 (M.D. Fla.)                                                         |

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| 2023 | Complaint from <i>Proxicom Wireless, LLC v. Macy's, Inc.</i> , 6:18-cv-00064 (M.D. Fla.)                                                                                                                                                                                                                                                                  |
| 2024 | Excerpts from Gast, “802.11 Wireless Networks: The Definitive Guide,” 2nd ed. (2005)                                                                                                                                                                                                                                                                      |
| 2025 | G. Anastasi et al., “Energy conservation in wireless sensor networks: A survey,” <i>Ad Hoc Networks</i> 7 (2009) 537–568                                                                                                                                                                                                                                  |
| 2026 | Feeney & Nilsson, “Investigation the Energy Consumption of a Wireless Network Interface in an Ad Hoc Networking Environment,” <i>Proceedings IEEE INFOCOM 2001. Conference on Computer Communications. Twentieth Annual Joint Conference of the IEEE Computer and Communications Society</i> (Cat. No.01CH37213), Anchorage, AK, USA, 2001, pp. 1548-1557 |

## I. INTRODUCTION

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107, Patent Owner Secure Communication Technologies, LLC (“SCT” or “Patent Owner”) hereby submits this Preliminary Response to Petitioner Google, LLC’s (“Google” or “Petitioner”) Petition for *Inter Partes* Review of U.S. Patent No. 11,995,685 (the “’685 patent”). As set forth below, there are numerous flaws in Petitioner’s mapping of the three independent claims that warrant denial of institution: (1) Petitioner has failed to show that the references disclose a “beacon,” (2) Petitioner has failed to articulate what disclosure in the references allegedly discloses a “beacon service identifier,” (3) Petitioner has failed to show that the limitation “filtering the beacon transmissions which include a particular beacon service identifier” is disclosed or rendered obvious in view of Eagle and Olkkonen; (4) the alleged motivation to combine Eagle and Olkkonen in the manner proposed by Petitioner is flawed, and Eagle itself actually teaches away from such combination; and (5) Petitioner failed to show that the references disclose “taking first further action relating to the stored information.”

Notably, the *identical* flaws were present in three previously filed IPRs by Petitioner against three closely related patents. *See Google LLC v. Secure Commc’n Techs., LLC*, IPR2025-01181 (Paper 7 (POPR)), IPR2025-01182 (Paper 7 (POPR)), IPR2025-01183 (Paper 8 (POPR)) (collectively the “Denied Google IPRs”).

Notably, Petitioner had the benefit of reviewing the POPRs in the Denied Google IPRs before filing this Petition but made all of the same fundamental errors here. These flaws led the Director to deny institution in those earlier IPRs. *See* Denied Google IPRs, Paper 14. For the same reasons, the Director should deny institution here. Additionally, as discussed in Patent Owner’s Brief in Support of Discretionary Denial, the Director should exercise discretion to deny institution because the instant Petition lacks merit.

## II. SUMMARY OF PRELIMINARY RESPONSE

The ’685 patent has three independent claims—claims 1, 34, and 35—which recite several common limitations at issue in this Response. Claim 1 is representative:

|        |                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                 |
|--------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1[pre] | A method comprising:                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                            |
| 1[a]   | causing processing, at a wireless device, of a first plurality of beacon transmissions received at the wireless device via a short range wireless protocol, each beacon transmission comprising three fields (a) a MAC address, (b) a unique identifier, wherein the unique identifier of each respective beacon transmission is a numeric value, and [1.A.IV] (c) a beacon service identifier, wherein the beacon service identifier of each respective beacon transmission identifies a wireless beacon service in which the unique identifier is relevant to |

|      |                                                                                                                                                                                                                                                                                                                                                                                                                         |
|------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
|      | stored information relating to an entity or object associated with a transmitter of a respective beacon transmission;                                                                                                                                                                                                                                                                                                   |
| 1[b] | <b>[1.B.I]</b> causing a transfer of the stored information between the wireless device and one or more servers via a second wireless protocol, <b>[1.B.II]</b> wherein at least a portion of the stored information relates to a particular entity or object associated with a first unique identifier, and <b>[1.B.III]</b> wherein the second wireless protocol is different from the short range wireless protocol; |
| 1[c] | causing selection of one or more of the unique identifiers from the first plurality of beacon transmissions, by <b>filtering the beacon transmissions which include a particular beacon service identifier</b> ; and                                                                                                                                                                                                    |
| 1[d] | <b>taking first further action relating to the stored information</b> , if the first unique identifier is present among the selected one or more unique identifiers.                                                                                                                                                                                                                                                    |

Each of the limitations highlighted above are also present in claims 34 and 35. Notably, for these limitations, Petitioner lays its invalidity theory only for claim 1. *See* Pet. 26-38. For claims 34 and 35, Petitioner refers to its claim 1 allegations for these common limitations. Pet. 60-63 (for claim 34, referring back to claim 1

allegations); 64-65 (for claim 35, referring back to claim 1 allegations). Accordingly, Patent Owner’s analysis focuses on Petitioner’s allegations for claim 1.

Each of Google’s grounds relies on a combination of U.S. Patent Application Publication No. 2005/0250552 (“Eagle”) (Ex. 1005), U.S. Patent Application Publication No. 2010/0138481 (“Behrens”) (Ex. 1006), and U.S. Patent No. 7,590,086 (“Olkkonen”) (Ex. 1007). As set forth below, Petitioner has failed to show that its Eagle-Behrens-Olkkonen combination renders the common limitations obvious. First, Petitioner maps the claimed “beacon transmissions” to Eagle’s Bluetooth “inquiry response”—just as it did in the Denied Google IPRs. But Petitioner has wholly failed to articulate why this inquiry response message can be considered a “beacon transmission.” And, indeed, it cannot. Eagle’s inquiry response messages are *solicited*; they are only sent by a device *responding* to a Bluetooth inquiry message. In contrast, it is commonly understood that beacon transmissions are broadcast to all devices within range of the transmitting device, and that beacon transmissions are sent without regard to any inquiry or other prior communication.

Next, Petitioner fails to show (just as it did in the Denied Google IPRs) that its Eagle-Behrens-Olkkonen combination renders obvious the limitation “beacon service identifier” or “BSI.” Indeed, while Petitioner attempts to modify the inquiry response message from Eagle using “service class information” from Olkkonen, Petitioner’s allegations are so vague that it cannot reasonably be discerned what it is

identifying as the alleged “service class information.” Petitioner’s vague allegations do not discharge its initial burden. *Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.*, CBM2012-00003, Paper 8 at 14-15 (P.T.A.B. Oct 25, 2012) (“[I]t is the responsibility of the Petitioner to clearly articulate [the proposed combination].”).

Relatedly, Petitioner again fails to show that that its Eagle-Behrens-Olkkonen combination renders obvious the limitation “filtering the beacon transmissions which include a particular beacon service identifier,” just as it failed to do so in the Denied Google IPRs. Patent Owner’s best guess as to what Petitioner points to as Olkkonen’s “service class information” is disclosure of information “characterizing the ad hoc network” or “identifying the running application.” Petitioner does not explain how this information could function as a BSI within the context of the challenged claims to filter the beacon transmissions. Nor could it.

Further, Petitioner’s claim that a POSITA would have modified Eagle’s inquiry response to include Olkkonen’s service class information fails for several reasons. Petitioner’s proposal to modify Eagle’s inquiry response message to include “service class information” is based on Petitioner’s claim that Olkkonen discloses an inquiry response message that includes “service class information.” But this claim is demonstrably false. Nowhere does Olkkonen disclose an inquiry response that includes “service class information.” Moreover, Petitioner proposes to modify Eagle in view of Olkkonen to perform “filtering” at the wireless device (as opposed to

Eagle’s backend server). But Eagle itself teaches away from such combination as it cautions against increasing “computational burden” on the wireless device.

Finally, Petitioner’s theory for satisfying the claim element “taking first further action relating to the stored information” is also flawed. Indeed, for the “further action” limitation, Petitioner cites to the same disclosure it cited to for previous limitations, rendering Petitioner’s invalidity theory nonsensical.

Notably, the Director has already recognized these same flaws in denying institution of the Denied Google IPRs. Those IPRs challenged three patents related to the ’685 patent and contained similar limitations to those at issue here.<sup>1</sup> For example, claim 1 of the ’685 patent and claim 1 of the ’344 patent contain the same limitations discussed in this Response:

| <b>’685 Patent, Claim 1</b>                                                                                                                       | <b>’344 Patent, Claim 1</b>                                                                                                                                |
|---------------------------------------------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------|
| A method comprising:                                                                                                                              | A method comprising:                                                                                                                                       |
| causing processing, at a wireless device, of a first plurality of beacon transmissions received at the wireless device via a short range wireless | receiving, at a wireless device, via a short range wireless protocol, a first plurality of beacon transmissions, each beacon transmission comprising three |

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<sup>1</sup> IPR2025-01181 challenged claims of U.S. Patent No. 11,334,918 (the “’918 patent”), IPR2025-01182 challenged claims of U.S. Patent No. 11,443,344 (the “’344 patent”), and IPR2025-01183 challenged claims of U.S. Patent No. 11,687,971 (the “’971 patent”).

|                                                                                                                                                                                                                                         |                                                                                                                                                                                                                                                                                                                                |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| protocol, each beacon transmission comprising three fields (a) a MAC address, (b) a unique identifier, wherein the unique identifier of each respective beacon transmission is a numeric value, and (c) a beacon service identifier []; | 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 []                                                                                                  |
| causing a transfer of the stored information between the wireless device and one or more servers via a second wireless protocol [];                                                                                                     | receiving, at the wireless device via a second wireless protocol, stored information from one or more servers [];                                                                                                                                                                                                              |
| 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; and                            | 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.                                                                            | taking first further action relating to the stored information, if the first unique identifier is present among the selected one or more unique identifiers.                                                                                                                                                                   |

Google's Petition here should be denied because it suffers from the identical flaws as in the Denied Google IPRs.

### III. FACTUAL BACKGROUND

#### A. The '685 Patent

The '685 patent issued in May 2024 from U.S. Patent Application No. 18/204,528, filed in June 2023. The '685 patent claims priority to a series of continuation applications, as well as to U.S. Provisional Patent Application Nos.

61/095,001 and 61/095,359, both filed in September 2008. In its Petition, Google does not dispute that the challenged claims of the '685 patent are entitled to that priority date. The '685 patent issued over hundreds of cited references considered by the Examiner, including Eagle, Behrens, and Jones.

The claims of the '685 patent were invented by Messrs. James Arthur Proctor, III and James Arthur Proctor, Jr., a father and son duo who are the co-founders of Proxicom Wireless, LLC ("Proxicom"). Mr. James A. Proctor, III holds a B.S.E.E. from the University of Florida and an M.S.E.E. from the Florida Institute of Technology. He is a former faculty member at the Florida Institute of Technology where he taught graduate courses in electrical engineering. Mr. James A. Proctor, III has forty years of experience in engineering and management roles at Harris Corporation in Melbourne, Florida working with communications systems. Mr. James A. Proctor, Jr., holds a B.S.E.E. from the University of Florida and an M.S.E.E. from the Georgia Institute of Technology. Mr. Proctor, Jr. is an accomplished technology executive and serial entrepreneur in the wireless and communications field, having contributed to the startup, growth, operation, and exits of a number of programs and companies.

One inspiration for the inventions taught and claimed in the patents-in-suit was the difficulty that Mr. Proctor, Jr. experienced in sharing files securely. In 2008, Mr. Proctor, Jr. realized that devices such as laptops that had Wi-Fi and Bluetooth

capabilities for short-range communication could not communicate securely with other similar devices, or exchange documents using those short-range communication channels. In fact, users could be tracked by third parties with the then-existing peer-to-peer technology. A third party could copy the identifier associated with a user or user's device and misuse it. Accordingly, there was a need for technology that could facilitate secure communications between mobile devices using short-range communication technologies.

All of the challenged claims have features that distinguish them from the references cited by Google: (1) a beacon transmission that includes three elements, *i.e.*, a MAC address, a unique identifier, and a BSI; (2) the mobile wireless device's use of the BSI to filter short range transmissions that relate to the particular wireless beacon service; and (3) taking further action by the mobile wireless device itself (rather than a back-end server) related to the stored information if the particular unique identifier is present.

**B. Prior Litigation and IPR Proceedings Concerning Patents Related to the '685 Patent**

In *Proxicom Wireless, LLC v. Target Corp.*, No. 6:19-cv-01886 (M.D. Fla.) and *Proxicom Wireless, LLC v. Macy's, Inc.*, No. 6:18-cv-00064 (M.D. Fla.), Proxicom (SCT's predecessor in interest) accused Target Corporation ("Target") and Macy's, Inc. ("Macy's") of infringing different patents related to the '685 patent. Exs. 2022-2023. Specifically, Proxicom accused Target's and Macy's mobile app

features of infringement, including features for locating items on shopping lists and personalized in-store offers. Exs. 2022-2023. Target filed IPR petitions against the patents asserted against it. *See generally* Exs. 1014-1033; *see also* Pet. 3. Pleadings from those IPR petitions and the district court litigations were considered during the prosecution of the application leading to the '685 patent. *See* Ex. 1001.

On July 3, 2024, SCT filed a complaint in the U.S. District Court for the Eastern District of Texas, asserting the '918 patent, the '344 patent, and the '971 patent against Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, "Samsung"). *See* Ex. 2014. In that complaint, SCT accused features of Samsung's phones, tablets, and laptops of infringing claims of the '918, '344, and '971 patents. *See id.* Among the infringing features were the Nearby Share/Quick Share and Fast Pair features of Samsung's phones and tablets, which Samsung alleged were developed by Google. *See* Ex. 2015. Google then filed IPR petitions against the '918, '344, and '971 patents (*i.e.*, the Denied Google IPRs) on July 2, 2025, one day before the statutory bar date based on SCT's lawsuit against Samsung.<sup>2</sup> *See* Denied Google IPRs, Paper 2 (petitions). On December 23, 2025, the Director denied institution on the merits. *Id.*, Paper 14 at 1.

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<sup>2</sup> Samsung also filed IPR petitions concerning the challenged patents. *See Samsung Electronics Co., Ltd. v. Secure Commc'n Techs., LLC*, IPR2025-01049, IPR2025-

On August 4, 2025, SCT filed a complaint against Google in the U.S. District Court for the Western District of Texas. *See* Ex. 2016. SCT filed a First Amended Complaint (“FAC”) in that action on September 8, 2025. *See* Ex. 2017. In the FAC, SCT accuses Google of infringing not only the patents from the Denied Google IPRs, but also the ’685 patent and U.S. Patent No. 8,166,749, which Google subsequently challenged in IPR2026-00099. *See id.*

Unlike the Target and Macy’s litigations involving features for locating items on shopping lists and personalized in-store offers, SCT’s infringement allegations against Samsung concerned Find My Mobile (which allows users to locate their devices), Quick Share (which allows users to share files), and Fast Pair (which allows users to wirelessly pair devices). Ex. 2014 at 7-8. Similarly, SCT’s allegations against Google concern Find Hub (which allows users to locate their devices), Quick Share/Nearby Share (which allows users to share files), and Fast Pair (which allows users to wirelessly pair devices). Ex. 2017 at 7-8.

Not only do the infringement allegations in the Samsung and Google litigations differ from the Target and Macy’s litigations, but so does the language of

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01050, IPR2025-01051, Paper 6 (P.T.A.B. June 18, 2025). In August 2025, SCT reached a settlement with Samsung, and the district court action and all three IPR proceedings involving Samsung were all terminated.

the asserted claims. For example, the challenged claims of the '685 patent recite using “beacon transmissions” that include a “beacon service identifier” and performing further actions on the wireless device—elements not at issue in the Target and Macy’s matters. *Compare* Ex. 1001 *with* Exs. 1014-1033.

### **C. Background Concerning the Art in Google’s Petition**

Each of the grounds in Google’s Petition relies on a combination of Eagle, Behrens, and Olkkonen. The Petition relies on two additional references (Kallio and Jones) in Grounds 2-4 to address certain dependent claims. Because this Preliminary Response addresses defects in Google’s mapping of the independent claims, Patent owner will not address Kallio and Jones in this Preliminary Response.

Eagle discloses a system that relies on traditional Bluetooth general inquiry/inquiry response messaging where, when a new user’s device comes near a user’s device, the devices discover one another and exchange information, before sending information to a back-end server for processing. The back-end server compares the two users’ profiles, and if they are a “match,” then the server causes the user’s device to display an alert. Ex. 1005 at, *e.g.*, [0019]-[0021]. As detailed below, Eagle emphatically teaches that this matching determination is to be performed on the back-end server and not the user’s mobile device, citing numerous benefits to processing on the server (*e.g.*, “easi[er] updat[ing],” “more sophisticated comparison and notification functions using more complete data,” “better

performance,” and “improved privacy protection”) and problems avoided by avoiding processing on the mobile device (*e.g.*, “the computational burden and consequent power consumption to which the battery powered portable devices are subjected” and “conserv[ing] memory space”). *Id.*, [0009], [0024].

Behrens generally describes a system that allows users to get in contact with other users nearby. Ex. 1006 at, *e.g.*, [0002]-[0010]. In the system described in Behrens, the users’ devices transmit messages with one or more unique identifiers (“UIDs”), and the received UIDs are logged and sent to a server. *Id.*, [0053], [0074]. Google primarily relies on Behrens for its disclosure of UIDs, including multiple or changing UIDs. *See* Pet. 12.

Olkkonen generally describes the use of ad hoc networks between devices (*e.g.*, piconets in the case of Bluetooth communications). Ex. 1007, Abstract. Google relies on Olkkonen for the proposed modification of “us[ing] Olkkonen’s service class information to identify Eagle’s social introduction application . . . such that Identified Devices identifying Eagle’s service are included in notifications to the server, excluding devices not participating in Eagle’s service.” Pet. 20. Olkkonen’s information “characterizing the ad hoc network” may be displayed on a mobile device menu and selected by a user. Pet. 13 (citing Ex. 1007, Fig. 1) (highlighting in Petition).

#### IV. LEGAL STANDARDS

The Board may only institute an *inter partes* review where “the information presented in 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(a); 37 C.F.R. § 42.108(c). Petitioner bears the burden of showing that this statutory threshold has been met. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“[T]he Petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”); *Liberty Mut.*, Paper 8 at 14-15 (PTAB Oct. 25, 2012) (representative) (“[I]t is the responsibility of the Petitioner to clearly articulate [the proposed combination].”); 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4).

The Petition relies solely on obviousness, and more specifically upon combinations of two or more references for each ground. Section 103 of the Patent Act provides that “[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a) (emphasis added). If a single element of a claim is absent from the prior art, the claim cannot be considered obvious. *See CFMT, Inc. v. YieldUp Int’l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (“[O]bviousness requires a suggestion of all

limitations in a claim.”) (citing *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974)); *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (reversing obviousness rejection where prior art did not teach or suggest all claim limitations); *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 15 at 15 (PTAB Jan. 9, 2013) (refusing to institute an IPR under 35 U.S.C. § 103 where prior art did not disclose all claim limitations).

The conclusion of obviousness based on a combination of references must be supported with explicit analysis of a reason to combine those references. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). The Federal Circuit has stated that such reasons must be more than “mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *accord Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 (Fed. Cir. 2008) (agreeing with the district court’s reasoning that “some kind of motivation must be shown from some source, so that the jury can understand why a person of ordinary skill would have thought of either combining two or more references or modifying one to achieve the patented method”); *see also LG Elecs., Inc. v. Cellular Commc’ns Equip. LLC*, IPR2016-00197, Paper 7 at 7-11 (April 29, 2016) (faulting a petition’s obviousness analysis for lack of sufficient articulated reasons with rational

underpinnings for modifying references to achieve particular elements required in the claims).

**V. GOOGLE HAS FAILED TO DEMONSTRATE A REASONABLE LIKELIHOOD THAT IT WILL PREVAIL ON ANY CHALLENGED CLAIM**

As discussed below, Google’s proposed combination of Eagle, Behrens, and Olkkonen fails to disclose or render obvious several elements of the challenged claims, and there is no motivation to combine those references in the manner Google alleges. There is thus no reasonable likelihood that Google will prevail on any challenged claim.

**A. Eagle Does Not Disclose “Beacon Transmissions”**

Independent claims 1, 34, and 35 each recite a wireless device that receives a “plurality of beacon transmissions.”<sup>3</sup> The claimed “beacon transmissions” include

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<sup>3</sup> Claim 1 recites “[a] method comprising . . . causing processing, at a wireless device, of a first plurality of beacon transmissions received at the wireless device . . . .” Claim 34 recites “[a] mobile wireless device comprising . . . receiving from a beacon transmitter . . . a plurality of beacon transmissions . . . .” And claim 35 recites “[a] computer program product for installation in a non-volatile memory in a wireless device” that when executed “causes the wireless device to: process a first plurality of beacon transmission, received at the wireless device . . . .”

“a MAC address,” “a unique identifier,” and a “beacon service identifier” (“BSI”). Ex. 1001, claims 1, 34, and 35.

Google alleges that Eagle’s disclosure of traditional Bluetooth inquiry response messages satisfies the claimed “beacon transmissions” element. Pet. 27-28 (mapping the beacon transmission to “inquiry responses containing identifying information”); 30-34 (mapping the claimed beacon transmission requirements of a MAC address, unique identifier, and BSI to the “inquiry response”). But, Bluetooth inquiry responses are not beacon transmissions. Eagle itself does not describe the Bluetooth inquiry response messages as “beacon transmissions.” And critically, there can be no dispute that Eagle’s inquiry response messages are *solicited*; they are only sent by a device *responding* to a Bluetooth inquiry message. Ex. 1005, [0033]-[0038]; *see also* Ex. 1008 at 245 (“An inquiry response packet is transmitted from the slave to the master after the slave has received an inquiry message.”); *see also* Ex. 2024 at 109 (describing beacon frames in 802.11 as being “transmitted at regular intervals” and not in response to any other message), 110 (describing probe responses in 802.11 as being sent in response to probe requests). Google never explains why a POSITA would consider Eagle’s traditional Bluetooth inquiry response messages to be “beacon transmissions.” Nor could it.

It is commonly understood that beacon transmissions are broadcast to all devices within range of the transmitting device, and that beacon transmissions are

sent without regard to any inquiry or other prior communication. For example, in Bluetooth 2.1, parked slaves use a “beacon train” in which beacon messages are transmitted at a given interval (*i.e.*, the “beacon interval”), making clear that their transmission does not depend on first receiving an inquiry or other message.<sup>4</sup> Ex. 1008 at 120. Likewise, in the IEEE 802.11 specification, beacon frames are transmitted by access points at a given interval. Ex. 2024 at 109 (“Beacon frames . . . are transmitted at regular intervals to allow mobile stations to find and identify a network.”); *see also id.* at 88 (discussing beacon interval). And, in ad hoc 802.11 networks (an example specifically discussed in the ’685 patent specification), beacons are transmitted by members of the ad hoc network without any previous inquiry or other message being received. Ex. 1001, 8:12-54, Fig. 6; Ex. 2024 at 198.

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<sup>4</sup> Similarly, Bluetooth inquiry messages are transmitted to devices within range, without first receiving any kind of message or other prerequisite. *See* Ex. 1005, [0034]-[0035] (noting that inquiry messages are received by “devices that are in range with regard to the initiator”). However, Google does not rely on Bluetooth inquiry messages as meeting the “beacon transmission” claim element, and Google makes no attempt to map the claimed beacon transmission elements (*i.e.*, a MAC address, unique identifier, and BSI) to the contents of the inquiry message.

Notably, Google has made no effort to explain how or why Eagle’s inquiry response message would satisfy a POSITA’s common understanding of a “beacon transmission,” a term that Google does not seek to construe. As such, Google has not discharged its burden. *See Liberty Mut.*, Paper 8 at 14-15 (“[W]e address only the basis, rationale, and reasoning put forth by the Petitioner and resolve all vagueness and ambiguity in Petitioner’s arguments against the Petitioner . . . . [I]t is the responsibility of the Petitioner to clearly articulate [the proposed combination].”); 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4) (“The Board may exclude or give no weight to the evidence where a party has failed to state its relevance.”).

Google’s Petition makes a passing reference to Eagle’s disclosure that “Bluetooth transceivers . . . can be used as beacons to identify a device to other nearby devices.” Pet. 28 (citing Ex. 1005 at [0008]). This paragraph of Eagle does not help Google, because it merely characterizes the wireless *devices* in its system as “beacons” (Ex. 1005, [0008]) but does not characterize any of the traditional Bluetooth *messages* it utilizes as “beacons” or “beacon transmissions.” To the extent any of the traditional Bluetooth messages cited by Eagle could plausibly be characterized as a “beacon transmission,” it would be the general inquiry message and not the inquiry response message. This is because the general inquiry message is transmitted to all devices within range and is unsolicited. Ex. 1005 at [0034] (“The general inquiry is intended to be used by devices that need to discovery devices that

are made discoverable continuously or for no specific condition.”). In contrast, the inquiry response message relied on by Google is a solicited response to the inquiry. Ex. 1005, [0034]-[0035]. As such, the inquiry response cannot be considered a beacon transmission.

Nor is the distinction between beacon transmissions and inquiry responses (other types of solicited transmissions) without a difference. A POSITA would have known that beacon transmissions must be relatively small to avoid rapidly consuming the resources of the broadcasting device and devices in range of the broadcasting device that receive the transmissions. *See, e.g.*, Ex. 2024 at 193-98 (discussing buffering of “multicast and broadcast frames” at “DTIM Period[s]” as part of power management); Ex. 2025 at 538 (“[G]enerally data transmission is very expensive in terms of energy consumption.”); Ex. 2026 at 1550 (noting that the energy “costs of receiving and discarding are multiplied by the number of hosts which receive or discard the traffic”). Thus, even assuming *arguendo* that Eagle’s inquiry responses were beacon transmissions (or were modified to be beacon transmissions), a POSITA would not have been motivated to modify Eagle’s inquiry response message to include all of the elements required by the claimed beacon

transmission (*i.e.*, a MAC address, a unique identifier, and a BSI).<sup>5</sup> Neither Google nor its expert explain why a POSITA would have been motivated to modify the inquiry response messages in this manner, and neither considers the ramifications of packing the alleged beacon transmission with additional information (*e.g.*, consumption of additional resources). *See, e.g., TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019) (“[A] conclusory assertion with no explanation is inadequate to support a finding that there would have been a motivation to combine.”); *In re Kahn*, 441 F.3d at 988 (requiring “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”); *see*

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<sup>5</sup> Google does not argue that collateral estoppel applies to whether Eagle discloses “beacon transmissions.” Instead, Google only argues that collateral estoppel applies “regarding receiving transmissions from a second wireless device via short-range protocol.” Pet. 27. Nor could Google argue that collateral estoppel applies as to this issue, because the claims at issue in the IPRs Google relies on did not recite “beacon transmissions,” nor did the parties litigate (or the PTAB decide) whether Eagle discloses beacon transmissions. *See* Exs. 1014, 1016; *see also, e.g., Comair Rotron, Inc. v. Nippon Densan Corp.*, 49 F.3d 1535, 1537 (Fed. Cir. 1995) (noting that collateral estoppel only applies when, *inter alia*, “the issue was actually litigated” and “the identical issue was decided in the first action”).

*also Innogenetics*, 512 F.3d at 1374 (agreeing with the district court’s reasoning that “some kind of motivation must be shown from some source, so that the jury can understand why a person of ordinary skill would have thought of either combining two or more references or modifying one to achieve the patented method”); *LG Elecs.*, Paper 7 at 7-11 (faulting a petition’s obviousness analysis for lack of sufficient articulated reasons with rational underpinnings for modifying references to achieve particular elements required in the claims).

Indeed, in other parts of the Petition, Google cites to conserving “communication processing” resources of the mobile wireless device as a motivation to move Eagle’s back-end processing from the server to the mobile device. Pet. 19-20 (citing Ex. 1003, ¶ 112). Modifying Eagle’s inquiry response to include additional fields or information to satisfy the requirements of the claimed beacon transmission would run counter to this goal, as increasing the contents of the beacon transmission would increase consumption of “communications processing” resources. Google does not address this inconsistency or analyze why including additional elements in Eagle’s inquiry response message would not violate its expert’s stated goal of reducing “communication processing” by the mobile wireless device.

For these reasons, Google has failed to demonstrate that Eagle (which Google relies exclusively on for this element) discloses the claimed “beacon transmissions.”

**B. The Combination of Eagle and Olkkonen Does Not Disclose a BSI or that the BSI is Used to Filter the Beacon Transmissions Associated with the Wireless Beacon Service**

Independent claims 1, 34, and 35 each require that the claimed beacon transmissions include, *inter alia*, a BSI. The claimed BSI identifies a wireless beacon service. *See* claim 1 (“wherein the beacon service identifier of each respective beacon transmission identifies a wireless beacon service”), claim 34 (“wherein the beacon service identifier of each respective beacon transmission identifies a wireless beacon service”), claim 35 (“wherein the beacon service identifier of each respective beacon transmission identifies a wireless beacon service”).

**i. Google Does Not Identify With Any Particularity What Information from Olkkonen is the Alleged BSI.**

Google alleges that it would have been obvious to modify Eagle’s inquiry response message (the alleged “beacon transmission”) to include (in view of Olkkonen) “service class information [that] identifies Eagle’s social introduction system” (the alleged BSI). Pet. 32-33 (“Eagle-Olkkonen teaches each beacon transmission comprising *(c) a beacon service identifier (e.g., service class information), wherein the beacon service identifier of each respective beacon transmission identifies a wireless beacon service (e.g., service class information identifies Eagle’s social introduction system)*”). However, pages 32-33 of the Petition do not specifically identify any “service class information.” On page 33, the Petition vaguely states that “[s]ervice class information includes information that

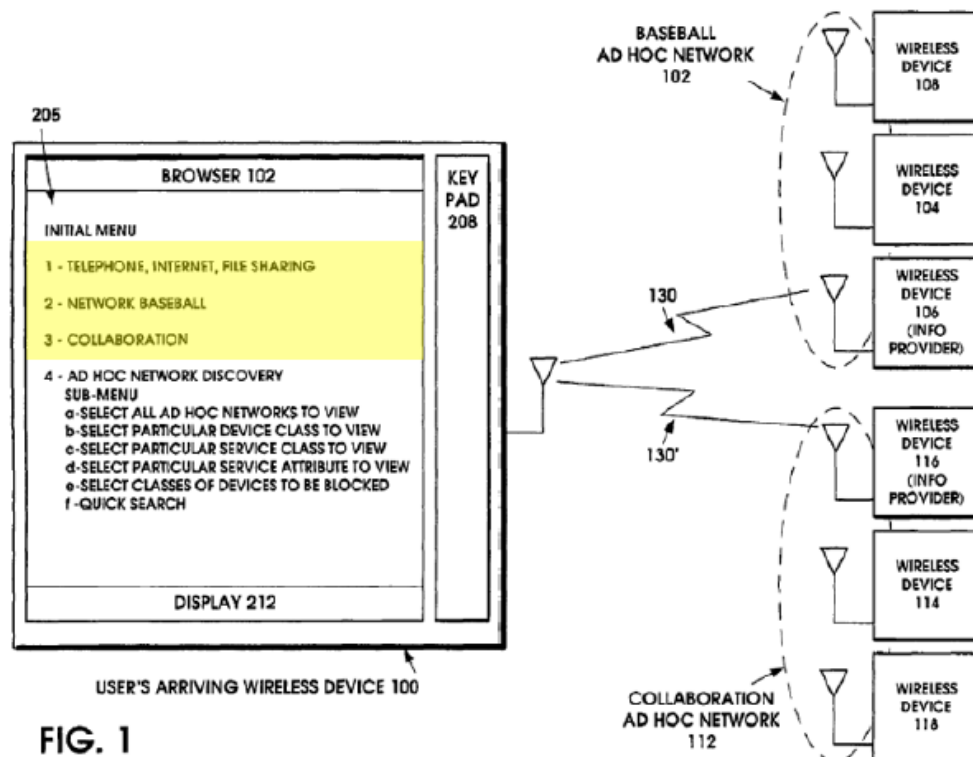
Identified Devices access from their service registries ‘characterizing the ad hoc network’ of which it is a member. This information includes service class information identifying the running application programs.”<sup>6</sup> *Id.* (citation omitted).

While the claim mapping on pages 32-33 of the Petition do not give an example of what Google means by information “characterizing the ad hoc network” or “identifying [the] running application,” Google cross-references an earlier portion of the Petition (§ VI.D.2, at pp. 19-23). There, Google alleges that “service class information (which may include service ‘attributes’) describes and identifies programs running in ad hoc networks (*e.g.*, a network baseball game).” Pet. 20 (citing Ex. 1007, Fig. 5, 30:22-28). Elsewhere in the Petition, Google indicates that

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<sup>6</sup> Olkkonen’s SDP service registries are shown in Figs. 5, 5A, 5B, 5C, and 5D. Ex. 1007, 10:8-18. Google does not identify any particular information stored in these registries as satisfying the claimed BSI. Notably, as set forth below, the information stored in these registries must be queried by another device sending a “SDP service search attribute request packet,” to which the device receiving this query responds with a “response to SDP service search attribute packet.” Ex. 1007, 25:21-29:65 (describing Figs. 4E-4L). Contrary to Google’s allegations, nothing in Olkkonen suggests including the information stored in these registries in a Bluetooth inquiry response message.

devices in Olkkonen's ad hoc networks "respond" to "inquiry messages" "with information characterizing the ad hoc network," and those responses "are compiled into a discovery menu listing those characteristics 'in accordance with the type of characteristics of interest to the user.'" Pet. 13 (citing Ex. 1007, 6:29-38). The Petition includes Figure 1 from Olkkonen and highlights it to demonstrate "information characterizing the ad hoc network" that a user may select from a menu:



*Id.* As best can be gleaned from the Petition's vague allegations, examples of Olkkonen's "service class information" may be "telephone, internet, file sharing," "network baseball," and "collaboration" as shown in Olkkonen's Fig. 1.

Neither SCT nor the Director should have to strain to interpret Google's vague allegations or guess as to what specific information Google alleges to be the claimed

BSI. Indeed, “it is the responsibility of the Petitioner to clearly articulate [the proposed combination].” *Liberty Mut.*, Paper 8 at 14-15; 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4). Because Google failed to identify specific information from Olkkonen that allegedly discloses the claimed BSI, and failed to explain why this information satisfies the challenged claims’ BSI, Google has not met its burden.

**ii. Google Has Not Shown How Any Alleged BSI in Olkkonen Is Used to Filter Beacon Transmissions Associated with a Wireless Beacon Service.**

As important, Google failed to articulate how Olkkonen’s “service class information” could function as a BSI within the context of the challenged claims. As previously stated, a mobile wireless device of the challenged claims uses the BSI to filter the beacon transmissions associated with a wireless beacon service. In other words, the claimed mobile device uses the BSI in its processing. Google acknowledges this requirement. *See* Pet. 33 (Google alleging that “it would have been obvious in Eagle’s system for an Identified Device to respond to inquiries from a Requester Device with *beacon service identifiers* such as service class information for filtering UUIDs as taught by Olkkonen.”).

Notwithstanding this statement, Google does not explain how Olkkonen’s information “characterizing the ad hoc network” or “identifying the running application” could function as an “identifier” in the context of challenged claims, or how the mobile wireless device could use this information to determine which

beacon transmissions are associated with the proximity beacon service. *See* Pet. 32-33, 36-37. For example, in the context of the challenged claims, an ad hoc name given to a network or program (such as “network baseball” (*see* Ex. 1007, Fig. 1)) could not function as a BSI. For it to do so, the mobile wireless device would need advanced knowledge of the name given to the network or program, such that it could determine whether a beacon transmission that includes, *e.g.*, service class information for “network baseball” is associated with a particular wireless beacon service. Nothing in Olkkonen suggests that the wireless devices have that capability, nor does Google allege any modification that would allow the devices to do so.

Also, as Google admits, the ad hoc name in Olkkonen is used to populate a menu that allows for *user selection*. While a user could select, *e.g.*, “network baseball,” from the menu based on his or her interests, Olkkonen does not disclose *its mobile device* using this information to process incoming beacon transmissions to determine which ones are associated with a particular proximity beacon service, as required by the claims.<sup>7</sup> For this additional reason, Google has not met its burden.<sup>8</sup>

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<sup>7</sup> The Petition makes passing reference to Olkkonen’s “device classes” (Pet. 14), such as “printers” or “fax machines” (Ex. 1007, 11:33-42). A device class cannot be a BSI, as it does not “identif[y] a wireless beacon service.”

<sup>8</sup> Google’s expert’s declaration is likewise deficient. *See* Ex. 1003, ¶¶ 142-146.

**iii. A POSITA Would Not Have Been Motivated to Include “Service Class Information” in an Inquiry Response.**

In addition to the defects in Google’s theory discussed above, Google proposes to modify Eagle’s Bluetooth inquiry response message to include Olkkonen’s service class information. This combination is premised on Google’s erroneous claim that Olkkonen discloses a Bluetooth inquiry response that includes service class information. Pet. 20 (alleging, *inter alia*, that “[t]his service identification information is received in Bluetooth inquiry responses”). Olkkonen does not disclose a Bluetooth inquiry response message that includes “service identification information.” Ex. 1007, Fig. 4B (depicting “Bluetooth FHS Packet Structure for an *Inquiry Response Packet* Sent by Ad Hoc Network Information Provider”). While this inquiry response message includes “class of device” field 522, it does not disclose a field for service class information. *Id.* This is consistent with Google’s other evidence, showing Bluetooth inquiry responses only include high-level “major service classes,” *e.g.*, networking, audio, or telephony, that are identified by particular bits in the inquiry response. Ex. 1009 at 2. This is also consistent with Eagle, which acknowledges that service class information is not included in inquiry responses. Ex. 1005, [0034]-[0035].

Olkkonen’s “service class information” is instead contained in the “SDP service registries” of devices in the piconet and disclosed later in the messaging sequence. Ex. 1007 at, *e.g.*, 13:40-43 (“the ad hoc network information provider 106

response over link 130 with information accessed from its SDP service registry characterizing the ad hoc network”). Olkkonen’s SDP service registries are shown in Figs. 5-5D. *Id.*, 10:8-18. The messaging requesting SDP service information, and the response messaging disclosing the SDP service information, are shown in Figs. 4E-4L. *Id.*, Figs. 4E, 4G, 4I, 4K (showing “SDP service search attribute request[s]” in “SDP service search attribute request packet[s]”), Figs. 4F, 4H, 4J, 4L (showing “SDP service search attribute response[s]” in respective “response[s] to SDP service search attribute request[s]”). As the sequence of Figure 4A-4L (and their accompanying disclosure) shows, this messaging takes place after the inquiry response. *See id.*, Figs. 4A-4L; 26:34-29:65.

Olkkonen’s failure to disclose a Bluetooth inquiry response message containing service class information is fatal to Google’s proposed combination. Indeed, the entire premise of Petitioner including Olkkonen in the combination is that it discloses a Bluetooth inquiry response message that includes “service class information.” Pet. 20 (“This service identification information [from Olkkonen] is received in Bluetooth inquiry responses.”) (citing Olkkonen). And because Olkkonen discloses service class information being disclosed in messaging subsequent to the inquiry response message, it actually teaches away from the proposed modification of including service class information in the inquiry response message. *Ricoh Co., Ltd. v. Quanta Computer Inc.*, 550 F.3d 1325, 1332 (Fed. Cir.

2008) (“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”) (quoting *In re Kahn*, 441 F.3d at 990); *see also, e.g., Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (finding no motivation to modify the prior art where doing so “would destroy the basic objective” of the prior art). Google has not articulated any reason a POSITA would have been motivated to deviate from these Bluetooth standard communication sequences as part of its proposed combination.

### **C. Eagle Teaches Away From Performing Filtering or Other Processing on the Mobile Wireless Device**

Claim 1 recites “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.” Similarly, claims 34 and 35 recite “[select/selecting] one or more of the unique identifiers from the [first/second] plurality of beacon transmissions, by filtering the beacon transmissions which include [a/the same] particular beacon service identifier.”

Google alleges that this element is met by the combination of Eagle and Olkkonen. Specifically, Google alleges that “Eagle teaches that it is unnecessary for a Requester Device to notify the server of every UID that it receives from nearby Identified Devices” (Pet. 19) and Olkkonen teaches filtering based on service class

information (the alleged BSI) (Pet. 20). *See also* Pet. 37 (“Olkkonen teaches filtering/selecting the UUIDs of Identified Devices that identify Eagle’s social introduction system in respective received service class information.”). Google attempts to combine the alleged features of Eagle and Olkkonen to satisfy the “filtering” limitation, claiming “Eagle-Olkkonen therefore teaches *causing selection of one or more of the unique identifiers from the first plurality of beacon transmissions (e.g., selecting UUIDs for notification to the server), by filtering the beacon transmissions which include a particular beacon service identifier (e.g., filtering received transmissions that include service information identifying Eagle’s social introduction system).*” *Id.* Thus, under Google’s theory, the alleged filtering in the Eagle-Olkkonen combination takes place at the Requester Device (mobile device) and not the server.

Even setting aside that, as discussed above, Olkkonen’s “service class information” is not a BSI, Eagle teaches away from performing such filtering on the wireless devices. Eagle requires the matching and other processing to be performed on the back-end server and explicitly and unequivocally teaches away from extensive processing being performed on the mobile device, setting forth a list of advantages of using a server for this processing and several disadvantages of using the mobile device for this processing:

The storage of profile data, the performance of matching functions, message transmission, and other functions at a *shared central server* offers several advantages over systems which rely on the portable devices themselves for storing and sharing information. *The performance of functions using a centralized infrastructure reduces the computational burden and consequent power consumption to which the battery powered portable devices are subjected.* The centralized structure can be more easily updated and is capable of performing more sophisticated comparison and notification functions using more complete data. *The robust capabilities of web servers, applications servers and database servers may be used to advantage to provide better performance from the individual devices, as well as functions such as improved privacy protection, profile editing, report generation, data analysis and system management functions not possible using the limited capabilities of the portable devices alone.*

Ex. 1005, [0009]. Eagle thus teaches away from the modification Google suggests. *Ricoh*, 550 F.3d at 1332 (“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”); *see also Trivascular*, 812 F.3d at 1068 (finding

no motivation to modify the prior art where doing so “would destroy the basic objective” of the prior art).

**D. The Combination of Eagle and Behrens Does Not Disclose or Render Obvious Receiving “Stored Information” or Taking Further Action(s) “Related to the Stored Information”**

Independent claims 1, 34, and 35 each require transfer of “stored information” from a server. Specifically, claim 1 recites “causing a transfer of the stored information between the wireless device and one or more servers via a second wireless protocol.” Claim 34 recites “transferring, between the wireless device and one or more servers via the second wireless protocol, stored information related to an entity or object associated with a first unique identifier.” Additionally, claim 35 recites “transfer stored information between one or more servers to the wireless device via a second wireless protocol, wherein the stored information related to an entity or object associated with a first unique identifier, and wherein the second wireless protocol is different from the Bluetooth wireless protocol.” Claims 1, 34, and 35 each require performing one or more “further action relating to the stored information.”

Google alleges that the claimed “further action” is met by four distinct actions, *i.e.*, “notifying the server, receiving profile information, displaying received profile information, and attempting contact.” Pet. 38. None of these actions meet the requirements of the challenged claims.

First, Google’s theory concerning “notifying the server” is contradicted by the claim language. Google alleges that the claimed “stored information” is the “stored profile information” that the Requester Device receives *after* it “notifies the server of an Identified Device” and “the server compares the Requester and Identified Devices’ profile information” and “determine[s] [that] they satisfy matching criteria.” Pet. 34-35. Thus, Google’s alleged “further action” of “notifying the server” is not a “further” action at all, but one that was already performed in Google’s mapping of the “causing a transfer of the stored information” step. Google’s attempt to map the same action to multiple claim elements is nonsensical.

Second, Google’s theory concerning “receiving profile information” reads the “further action” requirement out of the claims. Receiving profile information is precisely what Google alleges meets claim 1’s requirement of “causing a transfer of the stored information between the wireless device and one or more servers via a second wireless protocol.”<sup>9</sup> Pet. 35. Thus, here too, the action of “receiving profile information” is not a “further” action at all, because according to Google’s mapping it was already performed before the “further action” step (and, indeed, is alleged to meet that earlier step).

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<sup>9</sup> For similar elements of claims 34 and 35, Google cites back to its mapping for claim 1.

Third, Google’s theory concerning “displaying received profile information” fails to meet the claims’ requirement that the “further action” only be performed “if the [first/second] unique identifier is present among the selected one or more unique identifiers.” Google alleges that, according to Eagle, “[t]he Requester Device receives the profile data and displays it” and that “[t]he user of the Requester Device is thereby alerted to the presence of users sharing similar personal interests, for example.” Pet. 38. Thus, whether the Requester Device “display[s] received profile information” depends on whether the back-end server determines that the “Requester and Identified Devices’ profile information” “satisfy matching criteria.” Pet. 35. That is not the same as determining “if the [first/second] unique identifier is present among the selected one or more unique identifiers.” According to Google’s theory (and setting aside the problems with it, discussed elsewhere herein), that determination is made by “filtering/selecting the UIDs of Identified Devices that identify Eagle’s social introduction system in respective received service class information.” Pet. 37. Google has not shown how the claim language is met.

Fourth, Google’s theory concerning “attempting contact” fails for the same reasons that Google’s third theory concerning “displaying received profile information” fails. Under Google’s reading of Eagle, a user could only “attempt contact” if it receives the “profile information.” The “profile information” is received based on whether the back-end server determines that the “Requester and

Identified Devices’ profile information” “satisfy matching criteria.” Pet. 35. That is not the same as determining “if the [first/second] unique identifier is present among the selected one or more unique identifiers.” Thus, Google has not (and cannot) show that Eagle discloses this claim element.

**E. The Combination of Eagle and Olkkonen Does Not Disclose Determining that a Beacon Transmission Includes a Proximity Beacon Service Identifier**

Independent claims 1, 34, and 35 each require that the claimed wireless device filters the beacon transmissions that include a BSI. As discussed above, Eagle does not disclose beacon transmissions, and the combination of Eagle and Olkkonen does not disclose a BSI. Thus, the combination of Eagle and Olkkonen does not disclose the wireless device filtering beacon transmissions that include a BSI for the same reasons.

**F. Remaining Challenged Claims**

The remaining challenged claims all depend from claims 1 and 35, and Google has thus failed to show a reasonable likelihood that it will prevail as to any of those remaining challenged claims for the same reasons discussed above with respect to claim 1.

**VI. CONCLUSION**

For at least the reasons above and those in Patent Owner’s Brief in Support of Discretionary Denial, the Director should exercise discretion to deny institution, *inter alia*, because of the lack of any merit to the Petition. And, even if the Director

does not discretionarily deny institution, the Board should deny institution on the merits, because Google has failed to demonstrate a reasonable likelihood that it will prevail on any challenged claim.

Dated: February 19, 2026

By: /Brent Bumgardner/  
Brent Bumgardner  
Registration No. 48,476  
NELSON BUMGARDNER  
CONROY P.C.  
3131 W. 7th Street, Suite 300  
Fort Worth, Texas 76107  
Telephone: (817) 377-3486  
Email: brent@nelbum.com  
**Attorney for Patent Owner**

## **CERTIFICATE OF WORD COUNT**

Pursuant to 37 C.F.R. §42.24, the undersigned certifies that the foregoing Patent Owner's Preliminary Response contains 8,118 words excluding a table of contents, a table of authorities, Mandatory Notices under § 42.8, a certificate of service or word count, or appendix of exhibits or claim listing. Patent Owner has relied on the word count feature of the word processing system used to create this paper in making this certification.

Dated: February 19, 2026

By: /Brent Bumgardner/

Brent Bumgardner  
Registration No. 48,476  
NELSON BUMGARDNER  
CONROY P.C.  
3131 W. 7th Street, Suite 300  
Fort Worth, Texas 76107  
Telephone: (817) 377-3486  
Email: brent@nelbum.com

**Attorney for Patent Owner**

## **CERTIFICATE OF SERVICE**

The undersigned certifies that the foregoing Patent Owner's Preliminary Response was served February 19, 2026, to Lead and Back-up Counsel for Petitioner at the service address provided in Petitioner's Mandatory Notices:

Email: SMcKeown-PTAB@wolfgreenfield.com

Elizabeth.DiMarco@WolfGreenfield.com

VCheung-PTAB@wolfgreenfield.com

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By: /Brent Bumgardner/

Brent Bumgardner

Registration No. 48,476

NELSON BUMGARDNER

CONROY P.C.

3131 W. 7th Street, Suite 300

Fort Worth, Texas 76107

Telephone: (817) 377-3486

Email: brent@nelbum.com

**Attorney for Patent Owner**