

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SECURE COMMUNICATION TECHNOLOGIES, LLC,
Patent Owner.

Case No. IPR2026-00098
Patent No. 11,995,685

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S DISCRETIONARY DENIAL BRIEF**

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<i>ZyXEL Commc'ns Corp. v. UNM Rainforest Innovations,</i> 107 F.4th 1368 (Fed. Cir. 2024)	16, 17

LISTING OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 11,995,685
1002	Prosecution History of U.S. Patent No. 11,995,685
1003	Declaration of Mark Lanning
1004	Curriculum Vitae of Mark Lanning
1005	U.S. Patent Application No. 2005/0250552 (“Eagle”)
1006	U.S. Patent Application Publication No. 2010/0138481 (“Behrens”)
1007	U.S. Patent No. 7,590,086 (“Olkkonen”)
1008	Bluetooth Special Interest Group, Bluetooth Core Specification Version 2.1 + EDR (July 26, 2007)
1009	Bluetooth Special Interest Group, Assigned Numbers (December 14, 2002) (https://web.archive.org/web/20021214114356/http://www.bluetooth.org/assigned-numbers/baseband.htm)
1010	U.S. Patent Application Publication No. 2002/0131445
1011	U.S. Patent Application Publication No. 2002/0174364
1012	U.S. Patent Application Publication No. 2005/0164717
1013	U.S. Patent Application Publication No. 2006/0165100
1014	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00903, Paper 2 (Petition for <i>Inter Partes</i> Review) (P.T.A.B May 8, 2020)
1015	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00903, Paper 31 (Final Written Decision) (P.T.A.B Nov. 8, 2021)
1016	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00904, Paper 2 (Petition for <i>Inter Partes</i> Review) (P.T.A.B May 8, 2020)
1017	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00904, Paper 30 (Final Written Decision) (P.T.A.B Nov. 8, 2021)
1018	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00931, Paper 2 (Petition for <i>Inter Partes</i> Review) (P.T.A.B May 15, 2020)
1019	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00931, Paper 30 (Final Written Decision) (P.T.A.B Nov. 8, 2021)
1020	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00932, Paper 2 (Petition for <i>Inter Partes</i> Review) (P.T.A.B May 15, 2020)
1021	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00932, Paper 30 (Final Written Decision) (P.T.A.B Nov. 8, 2021)
1022	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00933, Paper 2 (Petition for <i>Inter Partes</i> Review) (P.T.A.B May 15, 2020)

Exhibit	Description
1023	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00933, Paper 30 (Final Written Decision) (P.T.A.B Nov. 8, 2021)
1024	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00934, Paper 2 (Petition for <i>Inter Partes</i> Review) (P.T.A.B May 27, 2020)
1025	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00934, Paper 31 (Final Written Decision) (P.T.A.B Nov. 30, 2021)
1026	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00977, Paper 2 (Petition for <i>Inter Partes</i> Review) (P.T.A.B May 27, 2020)
1027	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00977, Paper 31 (Final Written Decision) (P.T.A.B Nov. 30, 2021)
1028	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00978, Paper 2 (Petition for <i>Inter Partes</i> Review) (P.T.A.B. June 1, 2020)
1029	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00978, Paper 10 (Decision Denying Institution) (P.T.A.B. Dec. 4, 2020)
1030	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00979, Paper 2 (Petition for <i>Inter Partes</i> Review) (P.T.A.B. June 1, 2020)
1031	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00979, Paper 33 (Final Written Decision) (P.T.A.B Nov. 30, 2021)
1032	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00980, Paper 2 (Petition for <i>Inter Partes</i> Review) (P.T.A.B June 1, 2020)
1033	<i>Target Corporation v. Proxicom Wireless, LLC</i> , IPR2020-00980, Paper 32 (Final Written Decision) (P.T.A.B Nov. 30, 2021)
1034	<i>Target Corporation v. Proxicom Wireless, LLC</i> , Nos. 2022-1282, 2022-1283, 2022-1338, 2022-1339, 2023 U.S. App. LEXIS 24861 (Fed. Cir. Sep. 20, 2023) (nonprecedential)
1035	Apple Inc., iPhone 3G Technical Specifications (https://web.archive.org/web/20080725084414/http://www.apple.com/iphone/specs.html)
1036	Apple Inc., iPhone User Guide for iPhone OS 3.1 Software (https://cdsassets.apple.com/live/6GJYWVAV/user/ma616_iphone_ios3_1_user_guide.pdf)
1037	[RESERVED]
1038	U.S. Patent Application Publication No. 2007/0264991 (“Jones”)
1039-1040	[RESERVED]
1041	U.S. Patent No. 7,936,736
1042	U.S. Patent No. 8,090,359
1043	U.S. Patent No. 8,090,616

Exhibit	Description
1044	U.S. Patent No. 8,116,749
1045	Prosecution History of U.S. Patent No. 8,090,616
1046	<i>Samsung Electronics Co., Ltd. v. Secure Communication Technologies, LLC</i> , IPR2025-01049, IPR2025-01050, IPR2020-01051, Paper 10 (Settlement Prior to Institution of Trial) (P.T.A.B. Aug. 27, 2025)
1047	U.S. Patent Application Publication No. 2003/0224756 (“Kallio”)

I. INTRODUCTION

A patent in force for less than 2 years creates no “settled expectations.” Nevertheless, PO argues settled expectations on the strained basis that Petitioner was aware of ancestors of the ’685 patent since 2012. But those ancestor patents’ *claims were cancelled in view of the very same invalidating art* applied in this petition. PO’s reliance on those canceled claims only highlights the material error of the agency in issuing substantially similar claims in the ’685 patent a *second* time. The PTAB recently evaluated these same PO arguments and declined to discretionarily deny IPR petitions on patents in the same family as the ’685 patent.¹ The ’685 patent has been in force for less time than each of those older patents, and nothing has changed to increase settled expectations in the past two months.

PO’s only other argument is that this IPR should be discretionarily denied because trials for the other patents were not instituted on the merits. But the merits analysis will be performed later, and on a different petition record. The ’685 patent claims are not identical to the claims of the other patents, and there are no

¹ Petitions for IPR of US 11,334,918 (“’918 patent”; IPR2025-01181), US 11,443,344 (“’344 patent; IPR2025-01182), and US 11,687,971 (“’971 patent; IPR2025-01183) were referred for review on the merits on 2025-12-01. *See* paper 10 in each proceeding.

statements on the record explaining why those other trials were not instituted.

There is no reason to believe that the '685 patent claims will be denied; rather, the different '685 patent claims require separate consideration on the merits.

II. CANCELLED ANCESTOR PATENTS ARE THE ANTITHESIS OF SETTLED EXPECTATIONS

The '685 is directed to a mobile communication architecture for “facilitating the exchange of information” between two wireless devices, each device employing short-range communication (*e.g.*, Bluetooth) and long-range communication (*e.g.*, cellular) wireless capabilities. EX1001, 1:5-24, 1:49-2:63. A first device may detect an identifier transmitted from a second device in short-range proximity and send information identifying the second device to a server via long-range communications. EX1001, 1:49-2:4, 5:25-34, 5:57-67. Based on policy information stored at the server, the server may alert the first device to the second device’s presence with, *e.g.*, the second device’s contact information. EX1001, 2:5-14, 6:7-14, 6:41-59, 6:60-7:8.

This architecture of exchanging information between nearby devices and servers was claimed in earlier patents within the '685’s family (all claiming priority to the same provisional applications) and previously cancelled by the PTAB. As shown in the diagram produced in the Petition (*see* Petition at 3), a majority of the family’s earlier patents were challenged before the PTAB, and claims directed to the device-server architecture were found unpatentable in all but

one proceeding.² *See* EX1014-EX1033 (Petitions and Decisions in those IPRs).

Unpatentability was further confirmed in the only two IPR proceedings appealed to the CAFC (from IPR2020-00931 and IPR2020-00933). *See* EX1034.

The '685 claims were prosecuted while the above-described IPRs were pending, and include three overall concepts: (1) the short-range and long-range communications architecture described above and found to be squarely in the prior art; (2) changing device identifiers over time, also found to be in the prior art; and (3) filtering based on short-range service identifiers. The PTAB already determined that the first two features, in combination, were well-known based on the Eagle (EX1005) and Behrens (EX1006) references used in this petition.³ Likewise, the

² IPR2020-00978 was denied institution for reasons/limitations not relevant to the '685 claims. EX1029, 15-18.

³ *See* EX1015, 7-8 and 15-34 (PTAB determining that Eagle anticipated claims including a server receiving a unique identifier from a wireless device over a “wide area link,” where that wireless device received the unique identifier from another wireless device over a “local wireless link,” and transmitting information back to the wireless device based on a policy); EX1031, 46-49 (PTAB acknowledging that Behrens teaches using “a combination of UIDs” and that users may “exercise control over which or how many UIDs are transmitted”).

PTAB found that criteria-based filtering of short-range communicated identifiers (not as relevant to the claims of this patent) was also known.⁴ These prior PTAB (and CAFC) determinations of unpatentability strongly caution against discretionary denial to the extent PO is attempting to use the same *cancelled* claim scope to assert settled expectations here.⁵

In fact, precisely because PO's claims were being cancelled in previous IPRs, PO pursued continuation patents, including the '685, to change its filtering criteria to claim a parameter already existing in Bluetooth/WiFi communications—a service identifier. Accordingly, there are no settled expectations in these oldest patents from the '685 patent's family because (1) their claims were cancelled, and (2) the '685 claims were drafted only to add a well-known service identifier taken

⁴ See EX1015, 17, 24 (PTAB finding that Eagle discloses determining which unique identifiers to send to the server); EX1033, 18-23 (PTAB determining that prior art systems disclosed suppressing/filtering communications to servers where unique identifiers were previously encountered).

⁵ See Section I.B of the *Interim Director Discretionary Process* at <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (considerations include “Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims”).

from the prior art.

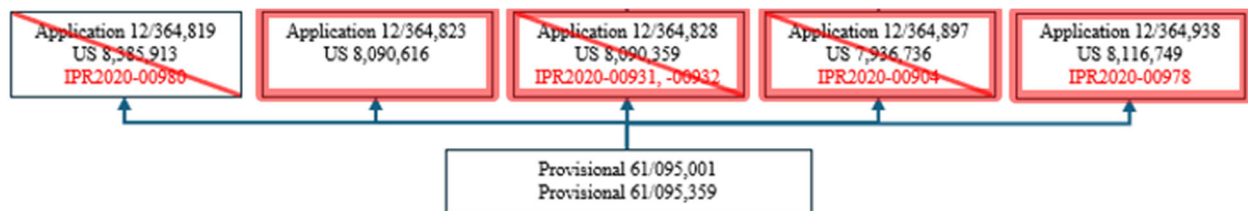
A. There Are No Settled Expectations from the '685 Patent Family

None of the patents related to the '685 patent confer settled expectations on the '685 patent itself. While they all have substantially the same disclosures and have claim limitations directed to the same base architecture, that base architecture has repeatedly been found unpatentable by the PTAB. Where claims did survive a previous challenge or were not previously challenged (as for the '616 patent), those outcomes were due to claim limitations not found in the '685 patent. The '685 patent, which was originally applied-for and prosecuted in response to PO's string of IPR losses, includes only patentably indistinct limitations PO simply taken from already existing wireless and Bluetooth standards. It was material error to allow the '685 patent to resurrect and claim the same architecture—already cancelled in claims in parent patents 7,936,736; 8,090,359; 8,369,842; 8,374,592; 8,385,896; 8,385,913; 9,038,129; and 9,161,164—based on standard wireless features, and there is no basis for denial found in the '685 patent or its family's history. The public had a settled expectation that the claim scope of the earlier cancellations of the agency and CAFC would not be reintroduced through standard ad hoc network features and resurrected. Moreover, the recent PTAB denials failed to provide the public notice of any material facts affecting settled expectations for the different '685 claims. The material error in allowing the '685 claims must be corrected to

safeguard the public from harassment based on claimed technology previously deemed to be within the public domain by both the agency and Federal Circuit.

1. Common architecture claims were cancelled

To argue that settled expectations for the '685 patent reach back further than its own short <2 year life, PO references four patents from the '685 patent's family that were identified in an email to Google in 2012: US 7,936,736 ("736 patent"), US 8,090,359 ("359 patent"), US 8,090,616 ("616 patent"), and US 8,116,749 ("749 patent"). *See* Patent Owner's Brief in Support of Discretionary Denial (Paper 6, "DD Req."), 2-3. These patents are among the earliest applications filed in this family and create no settled expectations here.



For example, the '736 patent claims, *now cancelled*, included a server-based method of providing information to a wireless device based on first identification information associated with a first wireless device, second identification information associated with a second wireless device, and disclosure policy data. EX1041, claims 1, 15 (*see* left column in the table below). The '685 patent also claims this same base architecture, but from the mobile device's perspective (rather than the server's). To the extent PO is attempting to argue that the '736 patent

provides settled expectations for the '685 because the '685 claims include the same base architecture, those expectations do not exist because those prior claims were *cancelled*.

'736	'685
1. A method for a central server..., the central server performing the steps of: receiving first identification information from the first wireless device, the first identification information communicated from the first wireless device to the server via the wireless Wide Area Network, ... receiving second identification information, as collected by the first wireless device from the second wireless device via a separate local wireless link between the first and second wireless devices, and wherein the second identification information is communicated from the first wireless device to the server via the wireless Wide Area Network connection, ... retrieving disclosure policy data associated with the second identification information, the disclosure policy data representing rules for privacy of information concerning the second wireless device or privacy of information concerning an entity associated with the second wireless device;	1. 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 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, 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; causing a transfer of stored information between the wireless device and one or more servers via a second wireless protocol, wherein at least a portion of the stored information relates to a particular entity or object associated with a first unique identifier, and wherein the second wireless protocol is different from the short range wireless protocol;

comparing the information disclosure policy data and the first identification information; and providing further information to the first wireless device concerning the entity associated with second wireless device, but only to the extent that it is consistent with the step of comparing the information disclosure policy data.	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 taking first further action relating to the stored information, if the first unique identifier is present among the selected one or more unique identifiers.
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The '359 patent claims, *also cancelled*, recite further narrowing features, added on top of the base architecture cancelled in the '736 patent such as the server receiving “feedback ratings relevant to an entity associated with either the first wireless device or the second device identifier information.” This additional feature is not recited in the claims of the '685 patent, and, therefore, cannot create settled expectations with respect to the '685 patent. EX1042, claims 1, 14.

The '616 patent claims, although not previously challenged, recite further narrowing features beyond the base architecture of the cancelled '736 patent such as “receiving visual identification information... includ[ing] at least one identifying picture.” This additional feature is not recited in the claims of the '685 patent and as such, cannot create settled expectations with respect to the '685 patent.⁶ EX1043, claims 1, 8, 22; EX1045, 272.

⁶ PO has not sued Petitioner for infringing the '616 claims, nor does it appear that

Finally, the '749 patent claims, although not cancelled, recite further narrowing features outside of the base architecture of the '736 patent such as requiring a “predetermined event coordinated with [a] central server” to use modified identification information. The IPR targeting the '749 patent was the only IPR denied institution among these older identified patents, and it was denied in part because of this feature. EX1029, 15. But this feature is not recited in the claims of the '685 patent and as such, cannot create settled expectations with respect to the '685 patent. EX1044, claims 1, 7.

2. It was material error to find prior art features added to the '685 claims distinguishing

The '685 patent claims the same base architecture as the canceled '736 patent claims, while adding patentably indistinct limitations versus the '736 patent and aforementioned parent patents, such as identifiers or addresses commonly used in then-existing industry-standard communication protocols (*e.g.*, reciting a “MAC address” and “beacon service identifier”) and a basic filtering mechanism that filters messages by a particular service. *See* Petition at 31 (Bluetooth Device Addresses (BD_ADDR) are MAC addresses included in Bluetooth communications), 19-23, 32-34 (service class information are beacon service identifiers used for filtering; class of device information exists in Bluetooth). The

PO ever asserted the '616 patent against any entity in any forum.

'685 patent itself relies on the Bluetooth industry standard for written description. *E.g.*, EX1001, p. 7 (listing the 802.11 and 802.15.4 specifications as prior art), Figs. 4-5 (illustrating “802.15.1-2002 (Bluetooth V1.2)” processes), 2:15-20 (utilizing “a Bluetooth or WiFi service beacon”). But as the IPR petitions plainly point out, Eagle specifically discloses Bluetooth beacons for use with its system. *See* Pet., 24, 28, 50, 57 (referencing Eagle [0008] and [0061]’s Bluetooth beacons, including exemplary restroom and tradeshow beacons). And the ad hoc parameters of the Bluetooth standard — that PO argues as somehow inventive —are taken directly from that prior art standard.

Therefore, in addition to the fact that the '685 patent cannot confer settled expectations because it has been in force for less than two years, PO has no reasonable expectation that these additional claim features to prior art ad hoc networking parameters will confer patentability to the already-cancelled architecture of the '736 parent patent.

3. Different claims require separate consideration

PO also asserts that because IPR trials for the related '918, '344, and '971 patents were not instituted, that favors discretionary denial for this '685 patent. That is not the case. The claims of the '685 patent have elements distinct from the claims of those other patents, and institution of IPR on the '685 patent should be decided on its own merits.

PO relies on a denial in *Google LLC v., Mullen Indus. LLC* (IPR2025-00227; DD Req., 11, 14) to support its position that denials of earlier petitions enhance settled expectations. But in that case, the “’540 patent” in question had “been in force since 2017 [8+ years] and was the subject of an earlier proceeding in which the Board denied institution of [IPR] based on the merits.” IPR2025-00227, Paper 14 at 4. The facts surrounding the ’540 patent are highly distinguishable from the facts here, as the ’685 patent is entitled to significantly less settled expectations (7 years’ difference) and the ’685 patent was never challenged in IPR. The fact pattern that was barely sufficient to “tip the balance in favor of discretionary denial” in *Google v. Mullen* is not applicable here.

In other cases where the PTAB discretionarily denied IPR based on related patent family denials on the merits, those cases benefited from fully informed opinions outlining the PTAB’s earlier reasons for denial on the merits. *See Sportradar v. Sportscast*, IPR2025-00634, Paper 16 at 2 (basing discretionary denial on denied merits 2025-06-03); *Liberty Energy v. U.S. Well Services*, IPR2025-00778, Paper 10 at 2 (basing discretionary denial on denied merits 2025-04-29). That is not the case here, as trials for the ’918, ’344, and ’971 patents were summarily denied. Neither PO, nor Petitioner, nor the PTAB can know if the same reasons for denying trial for the other challenged patents will also apply to the ’685 patent.

For example, the '685 patent includes limitations that require a “unique identifier” and “beacon service identifier” that “identifies a wireless beacon service,” wherein “the unique identifier” is a “numeric value” and “is relevant to stored information relating to an entity or object associated with a transmitter of a respective beacon transmission.” *See* Petition, 31-34 (discussion of limitations [1.A.III]-[1.A.IV]). The '918, '344, and '971 patents do not have these same requirements. The '918 patent also does not require any relevance to stored information. These different features in the '685 warrant specific consideration on the merits and not a summary denial based on other patents that merely overlap in subject matter.

'685	'918	'344	'971
[1.A.III] a unique identifier, wherein the unique identifier of each respective beacon transmission is a numeric value [1.A.IV] a beacon service identifier, wherein the beacon service identifier of each respective beacon transmission identifies a wireless beacon service in which the unique	[1.E.III] a respective unique identifier [1.E.IV] a Proximity Beacon Service Identifier (PBSI); [1.F.II] the PBSI indicates the particular short range transmission is a proximity beacon transmission associated with the proximity beacon service	[1.A.III] a unique identifier, wherein the unique identifier of each respective beacon transmission does not directly identify a location of a beacon transmitter [1.A.IV] a beacon service identifier, wherein the beacon service identifier of each respective beacon transmission identifies a	[1.A.III] a unique identifier, wherein the unique identifier of each respective beacon transmission does not directly identify a location of a beacon transmitter [1.A.IV] a beacon service identifier, wherein the beacon service identifier of each respective beacon transmission identifies that the

identifier is relevant to stored information relating to an entity or object associated with a transmitter of a respective beacon transmission		wireless beacon service as opposed to identifying a communication network or a device accessible using the short range wireless protocol	unique identifier is relevant to stored information associated with a wireless beacon service
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Similarly, the '918, '344, and '971 patents have limitations not present in the '685 patent. For example, the '918 patent uniquely includes “PBSI” data, the '344 patent requires that the beacon service identifier not “identify[] a communication network or a device accessible using the short range wireless protocol,” the '971 patent requires that the beacon service identifier “identif[y] that the unique identifier is relevant to stored information,” and the '344 and '971 patents both require that the unique identifier “not directly identify a location of a beacon transmitter.” Each of these limitations—none of which are in the '685 patent—could have caused the PTAB to deny institution in the other IPRs.

4. Previous denied petitions do not require discretionary denial on different claims

The PTAB’s previous denials contained no discussions on the merits, and there is no way of knowing if *any* of PO’s POPR arguments were persuasive and applicable to the '685 patent. DD Req., 11-12. In addition to the differences in claim limitations and scope discussed above, PO’s arguments were based on the false premise that the prior art did not describe known mechanisms, which the

Petition identified in the prior art and/or as part of known Bluetooth standards.

For example, the Petition plainly points out that Eagle discloses using transmission from Bluetooth beacons in its system. Pet., 24 (identifying Eagle’s tradeshow “greeting beacons”), 28 (citing Eagle at [0008], explaining that Eagle’s “Bluetooth devices transmit *beacon transmissions* when ‘used as beacons to identify a device to other nearby devices’” (emphasis in original)). While PO argues that Eagle’s disclosure is of no “help,” PO simultaneously argues that its patents’ claims are distinguishable because Eagle does not disclose beacon transmissions such as “Bluetooth 2.1[] parked slaves,” “IEEE 802.11 specification[] beacon frames,” or “802.11” beacons. IPR2025-01183, Paper 7, 12-14. But such specificity is recited nowhere in PO’s claims. And, even *if* these transmissions are required by the claims (they are not), Eagle’s transmissions disclosures are just as detailed as the PO’s specification because the Bluetooth standard is prior art to both and referenced in both.

Because the prior PTAB denials issued without any discussion of the merits, it is impossible to determine whether the ’685 patent should also be denied for the same unknown reasons as the other patents. The claims of the ’685 are different and require analyses on their own merits.

B. There Are No Settled Expectations from an Unrelated Samsung Suit

PO also alleges that Petitioner has been aware of the challenged patents

through PO's unrelated district court action against Samsung (Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.) in July 2024 and PO's subsequent district court action against Petitioner in August 2025. DD Req., 4. These arguments are irrelevant to PO's settled expectations.

Samsung and Google (Petitioner) are not the same company; nor are Samsung and Google real parties in interest in each other's respective IPR matters. Indeed, Samsung alone has now settled its dispute with PO. EX1046. Thus, the suit against Samsung—which did not involve the '685 patent—has no bearing on PO's allegations against *Petitioner*. The suit against Google was filed months ago—with the amended complaint adding in the '685 patent filed even later—which is not sufficient to give rise to any “settled expectations.”

III. COLLATERAL ESTOPPEL FAVORS AGENCY REVIEW

The validity of the '685 patent itself has not been previously adjudicated at the PTAB. But, as noted above, other patents in the '685 patent's family have—and lost. This proceeding will raise similar issues to those raised in at least IPR2020-00903 (US 9,038,129), IPR2020-00904 (US 7,936,736), and IPR2020-00979 (US 9,161,164), where similar claims were found unpatentable in view of grounds asserting Eagle and Behrens as prior art. That is, the PTAB here will be reviewing the same disclosure (shared in the patent family), reviewing the same prior art (Eagle and Behrens), and analyzing claim limitations directed to the same

claimed system. *See also ZyXEL Commc'ns Corp. v. UNM Rainforest Innovations*, 107 F.4th 1368, 1383 n. 10 (Fed. Cir. 2024) (collateral estoppel regarding patentability applies to *issues* and does not require identical claim language). The PTAB is also in the best position to evaluate the '685 patent on the merits based on its analyses from the prior denied trials. Consistency with the twelve previous IPRs in this family will be best maintained by continuing review at the PTAB. The PTAB can directly draw from its past analyses of the prior art, for which the Petition provides guidance.

For example, the Petition explains that this '685 patent IPR proceeding will benefit from the following previous prior art findings:

Claim	Previous Board Holding
1.A.I	Eagle teaches receiving/analyzing transmissions from a second device via a short-range wireless protocol. <i>See</i> EX1015, 20; EX1017, 17-18; Petition, 27.
1.A.II	Eagle teaches receiving a Bluetooth Device address as a unique identifier. Behrens teaches receiving MAC addresses in UIDs. <i>See</i> EX1015, 35-36; EX1031, 46-48; Petition, 30.
1.A.II I	Eagle teaches receiving a unique identifier from a second wireless device. Behrens teaches combination UIDs. <i>See</i> EX1015, 20; EX1017, 17-18; EX1031, 46-48; Petition, 31.
1.B.I, 1.B.II I	Eagle teaches communications with the server over a wide area link, not a local wireless link, and receiving stored information from the server. <i>See</i> EX1015, 19-30; EX1017, 16-18, 27-28; Petition, 34, 36.
1.B.II	Eagle teaches that the server stored information relates to the unique identifier received from the second device and to an entity associated with the second device. <i>See</i> EX1015, 20-21, 35; EX1017, 18, 27-28; Petition, 35.
2.B.II	Behrens teaches changing UIDs. <i>See</i> EX1031, 46-48; Petition, 40.
7	Eagle teaches receiving an alert from the server based on determinations

	regarding friends and trust networks. <i>See</i> EX1015, 21-30; EX1017, 19-28; Petition, 51.
10	Eagle teaches determining whether to transmit a notification to the server based on timestamps. <i>See</i> EX1015, 17, 23-24; EX1017, 14.

The PTAB is in the best position to efficiently and consistently review the claims of the '685 patent in view of the same prior art it has already evaluated. *See* Memo regarding Interim Processes for PTAB Workload Management⁷ at 2-3 (recognizing past PTAB adjudications on validity; aiming to improve PTAB efficiency); *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at 2 (PTAB Jul. 16, 2025) (existence of issues similar to those previously adjudicated may counsel against discretionary denial). It was material error for the USPTO examiner to allow the claims of the '685 patent over known invalidating art (*i.e.*, Eagle and Behrens) based on trivial additions to the claims (*i.e.*, a service identifier), and the PTAB is most fit to continue its ongoing review of patents in this same patent family. *See Padagis*, Paper 12 at 3 (review of challenged patent is an appropriate use of Office resources in view of material error and contradictory findings); *see also ZyXEL*, 107 F.4th at 1383-84 (while issues of collateral estoppel, res judicata, and issue preclusion were available for the court to consider *sua sponte*, those issues were better left to the Board).

⁷ <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>

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

A. *Advanced Bionics Step One*⁸

The Petition presents grounds of rejection based on Eagle (US 2005/0250552), Behrens (US 2010/0138481), Olkkonen (US 7,590,086), Kallio (US 2003/0224756), and Jones (US 2007/0264991). Although Eagle, Behrens, and Jones were among the approximately 1000+ patents, publications, and non-patent literature made of record during prosecution of the '685 patent, Olkkonen (present in every ground of rejection) and Kallio were not. DD Req., 15 (Olkkonen and Kallio “not considered during prosecution”). Therefore, the examiner during prosecution never considered the combined teachings of Eagle, Behrens, Olkkonen, Kallio, and Jones, and the grounds to satisfy *Advanced Bionics* step one.

B. *Advanced Bionics Step Two*⁹

Because the grounds fail *Advanced Bionics* step one, discretionary denial under §325(d) is unwarranted, and the Board need not reach step two.

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

⁹ Whether the Office erred in its evaluation of the asserted prior art. *Advanced Bionics*, Paper 6 at 8.

Even considering step two, demonstrable material error occurred during prosecution of the '685 patent. The first and only office action indicated that the pending claims were allowable except for double patenting issues. EX1002, 114-143. There is nothing in the record that indicates the Examiner substantively considered Eagle, Behrens, Jones, or any Olkkonen- or Kallio-equivalent disclosure beyond initialing the 1000+ IDS references submitted by PO.¹⁰ EX1002, 357-454, 568. *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 16 at 13-14 (PTAB June 25, 2025) (remarking that there was no record of substantive prior art consideration “[o]ther than initials on a lengthy IDS” with “over 1,000 other references,” which the Director Review Decision noted as being “over 40 times the size of a typical IDS”).

Indeed, PO admits that Olkkonen and Kallio were not before the examiner and that the Petition relies on those references “for the single limitations of ‘service identifiers and their use in filtering search results,’ and ‘MAC-address-formatted numbers as identifiers, respectively.’” DD Req., 15. The Examiner provided no reasons for allowance, but the service identifier limitations found in the

¹⁰ See *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017), factor (c), regarding the extent to which the asserted art was evaluated during examination.

independent claims could have contributed to the allowance of the '685 patent. The '685 patent prosecution history is silent as to how any prior art reference may have been considered and interpreted by the Examiner with respect to the service identifier limitations, if at all, and so the Examiner erred by not rejecting claims over Eagle, Behrens, and/or any other art of record teaching the same as Eagle, Behrens, and Olkkonen, as set forth in the Petition.¹¹

PO concludes that Petitioner made “no effort” and failed to address 325(d) in the Petition—but, of course, *this* opposition brief is the proper place for Petitioner’s arguments.¹² There is no reason to deny institution under §325(d), as the facts of this case fail to satisfy both *Advanced Bionics* steps one and two. PO’s conclusory handwaving of the facts and erroneous understanding of the procedural rules does not favor a different outcome.

V. CONCLUSION

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

¹¹ See *Becton Dickinson* factors (e) and (f) regarding how the examiner erred in its evaluation of the asserted prior art and the extent to which additional evidence and facts warrant reconsideration of the prior art or arguments.

¹² See Sections I.C, III.A, and III.C of the *Interim Director Discretionary Process*.

Respectfully submitted,

Date: February 19, 2026

/Scott A. McKeown/

Scott A. McKeown, Reg. No. 42,866
WOLF, GREENFIELD & SACKS, P.C.

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

I certify that on February 19, 2026, a copy of the foregoing document, including any exhibits filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

Brent Bumgardner
Charles Austin Ginnings
Christopher G. Granaghan
Timothy E. Grochocinski
Taryn N. Trusty

brent@nelbum.com
austin@nelbum.com
chris@nelbum.com
tim@nelbum.com
taryn@nelbum.com
SCT@nelbum.com

Date: February 19, 2026

/MacAulay Rush/
MacAulay Rush
Paralegal
WOLF, GREENFIELD & SACKS, P.C.