

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

SECURE COMMUNICATION TECHNOLOGIES, LLC,

Patent Owner.

Case IPR2026-00099

U.S. Patent No. 8,116,749

PATENT OWNER'S BRIEF IN SUPPORT OF DISCRETIONARY DENIAL

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Statutes

35 U.S.C. § 314	1, 7
35 U.S.C. § 325	1

PATENT OWNER’S EXHIBIT LIST

Exhibit #	Description
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

I. INTRODUCTION

Pursuant to 35 U.S.C. §§ 314 and 325 and the Director’s Interim Processes for PTAB Workload Management (“Interim Process Memo”), Patent Owner Secure Communication Technologies, LLC (“SCT”) respectfully requests that the Director exercise discretion to deny institution of this Petition regarding U.S. Patent No. 8,116,749 (the “’749 patent” or the “challenged patent”).

While the Director has declined to exercise discretion and deny institution as to Petitioner Google LLC’s (“Google”) other four related IPR petitions, the circumstances with respect to the ’749 patent are markedly different. Discretionary denial is warranted here because (i) the Board denied institution of a prior IPR petition on the ’749 patent, and (ii) the challenged claims of the ’749 patent have been in force for over 14 years, and Google has been on explicit notice of the ’749 patent for more than 13 years, both of which create settled expectations as to the validity of the challenged patent. In addition, the Board’s recent denials of institution on the merits of three of Google’s four related IPR petitions (with an institution decision on the fourth IPR petition pending) favor exercising discretion to deny institution here.¹

¹ The “challenged patents” refers to the ’749 patent and related patents that were challenged in Google’s now-denied petitions in IPR2025-01181, IPR2025-01182,

II. FACTUAL BACKGROUND

The application for the '749 patent was filed on February 3, 2009, and claims priority to two provisional applications (Nos. 61/095,001, filed September 8, 2008, and 61/095,359, filed September 9, 2008). The '749 patent issued on February 14, 2012, meaning that the challenged claims have been in force for over 14 years. The inventors filed three additional non-provisional applications on that date based on the same disclosure, namely U.S. Patent Application Nos. 12/364,823, which issued as U.S. Patent No. 8,090,616 (the "'616 patent"), 12/364,828, which issued as U.S. Patent No. 8,090,359 ("the '359 patent"), and 12/364,897, which issued as U.S. Patent No. 7,936,736 (the "'736 patent"). Importantly, *Google has been on explicit notice of the '749 patent for over 13 years* yet decided to wait over 13 years to challenge the validity of the '749 patent via the filing of this petition.

Specifically, in November 2011, Mr. James Proctor, Jr., one of the inventors of the challenged patents, emailed Kyle Enright, then Head of Business Development for Mobile Payments at Google, about the inventions disclosed in the challenged patents' family. *See* Exs. 2001-2003. Further, on February 9, 2012, Mr.

and IPR2025-01183, as well as the patent challenged in IPR2026-00098, whose institution decision is forthcoming. All challenged patents are co-asserted against Google in a parallel district court action.

Proctor emailed Amar Mehta, then Senior Counsel at Google, concerning the challenged patents' family and specifically identified the '749 patent (as well as the '616, '359, and '736 patent family members) by number to Mr. Mehta. *See* Exs. 2001, 2004, 2005. Mr. Proctor also indicated that, at the time, there were nine total patent applications in the patent family. *See* Ex. 2004.

In addition to the patentees' explicit notice to Google in 2012, Google has also known of the '749 patent and several of its family members since that time through Google's own patent prosecution activities. For example,

- Google cited the '749 patent on a December 17, 2012 Information Disclosure Statement during prosecution of Google's U.S. Patent Application No. 13/716,675 (which issued as U.S. Patent No. 9,185,148). *See* Exs. 2006-2007.
- Google cited U.S. Patent Application Publication No. 2010/0061294 (the publication that led to the '736 patent) on a May 3, 2012 Information Disclosure Statement during prosecution of Google's U.S. Patent Application No. 12/969,291 (which issued as U.S. Patent No. 8,364,172). *See* Exs. 2008-2011.
- The Examiner also cited the related '736 patent on a May 7, 2014 Notice of References Cited during prosecution of Google owned Motorola Mobility's U.S. Patent Application No. 13/738,384 (which

issued as U.S. Patent No. 8,923,831). *See id.*

- Google cited U.S. Patent Application Publication No. 2011/0300802 (the publication that led to the related '842 patent) during the prosecution of Google's U.S. Patent Application No. 17/305,266 (which issued as U.S. Patent No. 11,395,356) as the very first reference in a July 2, 2021 Information Disclosure Statement. *See* Exs. 2012-2013.

Notably, this last cited application was not identified in Mr. Proctor's correspondence with Google, highlighting that Google's knowledge of the patent family goes beyond the '749 patent and other patents specifically identified in Mr. Proctor's correspondence with Google.

On July 3, 2024, SCT filed a complaint in the U.S. District Court for the Eastern District of Texas, asserting three family members of the '749 patent, specifically U.S. Patent Nos. 11,334,918 (the "'918 patent"), 11,443,344 (the "'344 patent"), and 11,687,971 (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 on July 2, 2025, one day before the statutory bar date based on SCT's lawsuit against Samsung.² *See Google LLC v. Secure Commc'ns Techs., LLC*, IPR2025-01181, IPR2025-01182, IPR2025-01183, Paper 3 (P.T.A.B. July 10, 2025). On December 23, 2025, the Director denied institution for all three of Google's IPR petitions on the merits. *Id.*, Paper 14 at 1.

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 '918, '344, and '971 patents, but also the '749 patent and the '685 patent (the patent Google challenged in IPR2026-00098). *See id.* Google also filed a fourth IPR petition on the '685 patent, and this petition suffers from the identical flaws present in the three IPR petitions that the Board denied on the merits. An institution decision on this IPR petition is pending.

² Samsung also filed IPR petitions concerning the challenged patents. *See Samsung Elecs. Co., Ltd. v. Secure Commc'ns Techs., LLC*, IPR2025-01049, IPR2025-01050, 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 have all been terminated.

As Google's Petition acknowledges, another company has unsuccessfully challenged the '749 patent. *See* Pet. at 1-2. Specifically, the Board previously denied institution of IPR2020-00978 filed by Target Corporation challenging the validity of the '749 patent, finding on the merits that Target had not shown a reasonable likelihood of prevailing on any of the challenged claims. *See* Ex. 1029.

III. SUMMARY OF ARGUMENT

The '749 patent was the subject of a prior IPR that was denied institution on the merits. That fact alone warrants discretionary denial under recent Board precedent. In addition, the challenged claims have been in force for over 14 years, and Google has been on notice of the '749 patent for over 13 years (through both direct notice of the '749 patent to Google from one of the inventors and through Google's own patent prosecution activities), all of which create settled expectations as to the validity of the challenged claims of the '749 patent and warrant discretionary denial.

In addition, the Board has already denied institution on the merits as to three of Google's IPR petitions against the five challenged patents, with institution decisions in both IPR2025-00098 and this proceeding forthcoming. While the petitions which have already been denied institution relied on different prior art than the Petition here, from a practical standpoint, it does not make sense for the Board to consider this Petition in light of the Director's recent decisions in those other IPR

proceedings. Those denials of institution mean that instituting this IPR proceeding will not resolve the parties' dispute because the district court will have to decide the validity of the three patents as to which the Director has already denied institution. And, the merits of any IPR petition (a longstanding consideration in the discretionary denial analysis) are just as weak here as they were in the petitions as to which the Director has already denied institution.

IV. LEGAL STANDARD

35 U.S.C. § 314 provides the Director with discretion regarding whether to institute an IPR proceeding. *See Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 366 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review”) (emphasis omitted); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

As discussed in the Interim Process Memo, among the criteria that the Director may consider in determining whether to exercise discretion to deny institution are “[s]ettled expectations of the parties,” “[t]he strength of the unpatentability challenge,” and “[a]ny other considerations bearing on the Director’s discretion.”

V. THE DIRECTOR SHOULD EXERCISE DISCRETION TO DENY INSTITUTION UNDER THE INTERIM PROCESS MEMO

Several facts support exercising discretion and denying institution of the instant IPR petition under the Director's Interim Process Memo.

First, the '749 patent was the subject of a prior IPR petition as to which the Board denied institution on the merits—a fact which strongly favors discretionary denial here.

Second, not only have the challenged claims been in force for over 14 years, but Google has been on notice of the '749 patent since 2012—through direct correspondence with Mr. Proctor and through Google's own patent prosecution activities. Despite having direct notice of the '749 patent (as well as related patents) since 2012, Google waited nearly 14 years to challenge or dispute the validity of any claim of the '749 patent via the filing of this Petition. There are thus settled expectations as to the validity of the challenged claims, which favors discretionary denial.

Third, the Board has already denied institution of three of Google's five IPR petitions relating to the challenged patents at issue in the parallel district court action. From a practical standpoint, it does not make sense to spend the Office's resources considering the merits of this Petition given those prior decisions. Even if Google's IPR challenge here was successful, it would not resolve the entire dispute between SCT and Google, as the related patents for which institution was denied on the merits

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in IPR2025-01181, -01182, and -01183 are co-asserted in the pending parallel district court action in the Western District of Texas.

Fourth, the merits of Google’s unpatentability challenge are weak—just as they were in the three IPR petitions as to which the Director has already denied institution on the merits.

For at least these reasons, the Director should exercise discretion to deny institution.

A. A Prior IPR Petition Against the ’749 Patent Was Denied Institution on the Merits

As Google admits in its Petition, the ’749 patent was the subject of a prior IPR petition by Target Corporation. *See* Pet. at 1-2; Ex. 1028. The Board denied institution on the merits in that proceeding. *See* Ex. 1029. This fact alone warrants discretionary denial of Google’s petition here. *See, e.g., Google LLC v. Mullen Indus. LLC*, IPR2025-00227, Paper 14 at 4 (P.T.A.B. June 25, 2025) (exercising discretionary to deny institution where the challenged patent “was the subject of an earlier proceeding in which the Board denied institution of inter partes review based on the merits”).

B. Settled Expectations Favor Discretionary Denial

The challenged claims of the ’749 patent have been in force since February 2012—i.e., over 14 years. *See* Ex. 1001. Google has been on notice of the ’749 patent since February 2012, through both correspondence with Mr. Proctor and

through Google’s own patent prosecution activities. *See* Exs. 2001, 2004-2007; *see also* Exs. 2008-2013 (Google citing family members of the ’749 patent during its patent prosecution activities). Despite the passage of over 13 years, it was not until the filing of this IPR petition that Google challenged the validity of any claim of the ’749 patent. Moreover, until Google’s since-rejected petitions in IPR2025-01181, -01182, and -01183, at no point during the thirteen years since Google learned of the ’749 patent and related patents did Google assert invalidity or otherwise challenge the ’749 patent or related patents (i.e., through an IPR petition, a different USPTO proceeding, or a declaratory judgment action in district court). Google’s failure to act throughout this significant passage of time created settled expectations as to the validity of the challenged claims of the ’749 patent, which strongly favors discretionary denial. *See Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (P.T.A.B. July 31, 2025) (exercising discretion to deny institution when “the challenged patent has been in force for over six years, creating strong settled expectations”); *Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-004008, Paper 21 at 2 (P.T.A.B. June 18, 2025) (exercising discretion to deny institution when “the challenged patent ha[d] been in force almost eight years, creating settled expectations”); *see also Amazon.com, Inc. v. Audio Pod IP, LLC*, IPR2025-00757, Paper 15 at 2-3 (P.T.A.B. Aug. 14, 2025) (exercising discretion to deny institution when challenged patents “have been in force for approximately seven, eleven, seven,

eleven, and nine years, respectively, creating strong settled expectations” and where “Patent Owner informed Petitioner of its patent portfolio, including an issued ancestor patent to the challenged patents”); *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, IPR2025-00374, IPR2025-0076, IPR2025-00377, IPR2025-00378, Paper 10 (P.T.A.B. June 6, 2025) (exercising discretion to deny institution when petitioner “cited the then-pending application that issued as the challenged patent in an Information Disclosure Statement Petitioner filed in its own patent application” because of settled expectations).

Further, Google’s knowledge of the ’749 patent’s family predates its development of the products and features accused in the parallel district court action. For example, based on publicly available information, Google’s Nearby Share feature was not released until 2020, Google’s Fast Pair feature was not released until 2017, and the precursor to Google’s Find Hub feature was not released until 2013. *See* Exs. 2018-2020. In addition, the first Google Pixel smartphones (recent generations of which are accused products in the parallel district court action) were not released until 2016. *See* Ex. 2021. Thus, Google developed the accused products and accused features with full knowledge of the challenged patents’ family but failed to either license the patents or challenge their validity in any manner.

C. Google’s Previously Filed IPR Petitions, for Closely Related Patents in the Same Patent Family, Were Denied on the Merits

The Director has already denied institution of Google’s recent IPR petitions

on three closely related patents – the ’918, ’344, and ’971 patents. Given these prior denials of institution, the Office need not expend resources considering this IPR petition regarding the ’749 patent. Indeed, SCT’s operative district court complaint accuses Google of infringing not only the ’749 patent, but also the ’918, ’344, and ’971 patents for which the Director has already denied institution on the merits, and a fifth patent (the ’685 patent) that is the subject of a recent petition from Google (in IPR2026-00098). *See* Ex. 2017. It is not an efficient use of the Office’s resources to consider this Petition regarding the ’749 patent as the district court must still consider the validity of the ’918, ’344, and ’971 patents regardless of the outcome here. *See Amazon-Audio Pod*, Paper 15 at 3 (concluding that when “the district court will be considering the validity of [five related] patents . . . along with the validity of [an additional] patent . . . referring [an IPR petition concerning the additional patent] to the Board would be an inefficient use of Board resources and tips the balance to discretionary denial as to that patent too”); *see also Google v. Mullen*, Paper 14 at 4 (discretionarily denying institution of petitions on several patents based on one such patent being “the subject of an earlier proceeding in which the Board denied institution of *inter partes* review based on the merits” and finding that “Patent Owner’s settled expectations” favor discretionary denial).

D. The Merits of Google’s Petition Are Weak

As will be detailed in SCT’s forthcoming Preliminary Response, there are

fundamental flaws in the merits of Google's IPR petition. The Director should exercise discretion and deny institution of Google's IPR petition for this reason as well.³

VI. CONCLUSION

For at least the reasons above, the Director should exercise discretion and deny institution of Google's IPR petition.

³ Regarding prior IPR challenges to family members that were successful, as will be discussed in Patent Owner's Preliminary Response to the present Petition, there are several differences between the claims at issue in the prior IPR proceedings and those challenged here that warrant a different result.

Dated: March 16, 2026

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The undersigned certifies that the foregoing Patent Owner's Brief in Support of Discretionary Denial was served on March 16, 2026, to Lead and Back-up Counsel for Petitioner at the service address provided in Petitioner's Mandatory Notices:

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