

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. IPR2026-00099
Patent No. 8,116,749

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

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LISTING OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 8,116,749
1002	Prosecution History of U.S. Patent No. 8,116,749
1003	Declaration of Mark Lanning
1004	Curriculum Vitae of Mark Lanning
1005-1009	[RESERVED]
1010	U.S. Patent Application Publication No. 2002/0131445
1011	U.S. Patent Application Publication No. 2002/0174364 (“Nordman”)
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)
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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)

Exhibit	Description
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)
1035-1036	[RESERVED]
1037	U.S. Patent Application Publication No. 2004/0243519 (“Perttila”)
1038-1046	[RESERVED]
1047	U.S. Patent Application Publication No. 2003/0224756 (“Kallio”)
1048	<i>Secure Communication Technologies LLC v. Google LLC</i> , 1:25-cv-01207, Dkt. 11-7 (W.D. Tex. Sep. 8, 2025) (Amended Complaint, Exhibit 7)
1049	<i>Proxicom Wireless, LLC v. Macy’s, Inc.</i> , 6:18-cv-00064, Dkt. 49 (M.D. Fla. Aug. 10, 2018) (Joint Claim Construction Statement)
1050	<i>Proxicom Wireless, LLC v. Macy’s, Inc.</i> , 6:18-cv-00064, Dkt. 94 (M.D. Fla. Feb. 12, 2019) (Order in re Claim Constructions)
1051	U.S. Patent Application Publication No. 2010/0274859 (“Bucuk”)
1052	U.S. Patent Application Publication No. 2009/0028082
1053	U.S. Patent No. 9,305,119
1054	U.S. Patent Application Publication No. 2005/0204309
1055	<i>Proxicom Wireless, LLC v. Macy’s Inc.</i> , 6:18-cv-00064, Dkt. 1. (M.D. Fla. Jan. 12, 2018) (Complaint)
1056	<i>Proxicom Wireless, LLC v. Target Corp.</i> , 6:19-cv-01886, Dkt. 36 (M.D. Fla. Dec. 27, 2019) (Amended Complaint and Demand for Jury Trial)

Exhibit	Description
1057	U.S. Patent No. 7,213,742 (“Birch”)

I. INTRODUCTION

It was material error for the USPTO to issue U.S. Patent No. 7,116,749 (EX1001; the “’749”). The examiner explained his reasons for allowing the claims as failing to disclose a “first, direct, short range separate local wireless link”—but the claims recite no such feature. *See* §II.A below. Given this material error, it is of no consequence that the ’749 patent has existed for many years. The need to review and correct material examination errors outweighs any settled expectations arising from the ’749 patent’s age.

Additionally, the only two prior assertions of the ’749 patent were against retail store operations (Target and Macy’s) based on their use of in-store customer communication systems for communicating shopping-related information such as discounts on in-store products. *See, e.g.*, EX1056, 28-43 (describing Target’s alleged system of a mobile phone application, in-store beacons, and servers to, *e.g.*, provide “Cartwheel Offers” and “Target Circle Offers”), 54-57 (asserting infringement of the ’749 patent). *Now*, the Patent Owner (“PO”) is alleging infringement of this patent based on finding lost objects (*e.g.*, a Bluetooth earbud) using the Bluetooth® standard beaconing from Bluetooth Low Energy devices. EX1048 (infringement claim chart), 2-5 (referencing the “Find Hub Network... for tracking beaconing Bluetooth Low Energy (BLE) devices”). In this different technology space, Google “did not have reason to anticipate assertion of the patent

against it,” which “weigh[s] against Patent Owner’s settled expectations and weigh in favor of Petitioner’s expectations, and outweigh the considerations favoring discretionary denial.” *Home Depot U.S.A., Inc. v. H2 Intellect LLC*, IPR2025-00480, Paper 11 at 2-3 (P.T.A.B. Sep. 4, 2025).

Review of the ’749 patent must proceed on the merits. Only through a fulsome review can the Board address the material error that drove allowance of the ’749 patent and ensure that the claims are evaluated against the prior art based on what they actually require.

II. THE USPTO COMMITTED MATERIAL ERROR IN ALLOWING THE ’749 PATENT

The prosecution history of the ’749 patent (Application No. 12/364,938) illustrates that the Office committed material error in allowing the ’749 patent claims because the Examiner identified, as allowable, a claim limitation that *never existed* in the prosecuted claims. This discrepancy between what the Applicant prosecuted and what the Examiner allowed is a material error that the Office should review.

A. Overview of the Relevant Prosecution History

In the October 14, 2011, Notice of Allowance, the Examiner stated that “the reviewed prior art nowhere discloses the underlined limitations below in combination with the remaining limitations recited in the remaining dependent claims,” with certain limitations bolded and underlined in claim 1, as shown below.

EX1002, 267.¹***Allowable Subject Matter***

Claims 1-12 and 19-31 are allowed.

The following is an examiner's statement of reasons for allowance:

In the case of independent claims 1 and 7, and claims dependent thereon, the reviewed prior art nowhere discloses the underlined limitations below in combination with the remaining limitations recited in the remaining dependent claims. In particular, independent claim 1 of:

A method for exchange of information between one or more applications executing on at least a first wireless device and a second wireless device, the method comprising the steps of:

- at the first wireless device, providing initial identification information to a central server, said initial identification information having been collected by the first wireless device from the second wireless device via a first, direct, short range separate local wireless link between the second and first wireless devices, wherein the initial identification information is associated at the central server with an identity of a user or entity associated with the second wireless device, and
- wherein the initial identification information is provided to the central server, by the first wireless device, over a second wireless link;
- at the second wireless device upon an occurrence of a predetermined event coordinated with said central server, within a specific application on the second wireless device, providing modified identification information over the first, direct, short range local wireless link in place of the initial identification information, such that the modified identification information is associated at the central server with said identity of a user or entity associated with the second device; and
- at the first wireless device, collecting said modified identification information.

In addition, independent claim 7 also discloses similar limitations to those highlighted above.

¹ As noted by the Examiner, independent claim 7 was allowed for the same reasons. While Petitioner refers to claim 1 in the arguments herein, claim 7 was amended and allowed in the same ways as claim 1 during prosecution, and claim 7 therefore suffers from the same material error.

Thus, the Examiner allowed claim 1 of the '749 patent because it recited, in part, a “first, direct, short range separate local wireless link” (highlighted above).

However, a “first, direct, short range separate local wireless link” never existed in the claims. Claim 1, as originally filed on February 3, 2009, recited providing initial identification information collected by a first wireless device from a second wireless device “via a separate local wireless link” between the first and second devices. EX1002, 57, 59. This limitation was unchanged in the Applicant’s first amendment of August 13, 2010. EX1002, 127-128.

The Applicant’s amendment of December 14, 2010, substantially amended claim 1 and replaced the “separate” local wireless link with a “first, direct, short range” local wireless link. EX1002, 183, 185.

first wireless device from [[a]] <u>the</u> second wireless device via a <u>first, direct, short range</u> ~~separate~~ local wireless link between the <u>second</u> and <u>first</u> wireless devices, wherein the
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In the subsequent Office Action of July 21, 2011, the Examiner indicated that claim 1 was allowable with the nonexistent “first, direct, short range separate local wireless link” limitation. EX1002, 216-217. But the word “separate” was never part of the amended claim language. The Examiner repeated its reasons for allowance in the October 14, 2011, Notice of Allowance. EX1002, 267 (as shown further above). PO did not catch and/or attempt to correct this error.

B. The Office Committed a Material Error

Despite the Applicant having deleted and replaced “separate” in claims 1 and 7 with “first, direct, short range,” the Examiner reintroduced “separate” to create a wholly new term in its statement of reasons for allowance: a “first, direct, short range separate local wireless link between the second and first wireless devices.” EX1002, 183, 216-217.

This error was not harmless. The Examiner relied on the word and requirement of “separate” as distinguishing over the prior art, stating: “the reviewed prior art nowhere discloses the underlined limitations below in combination with the remaining limitations recited in the remaining dependent claims.” EX1002, 216-217.

The Examiner repeated and confirmed the error in the October 14, 2011, Notice of Allowance, again describing the limitations of claim 1 with the extra requirement of “separate.” EX1002, 267.

The Examiner therefore created a new fusion of requirements for the claimed wireless link—that the link be both “first, direct, [and] short range,” as the Applicant amended, and “separate.” A “first, direct, short range separate” wireless link never existed in any version of the claims at any point during prosecution, yet the Examiner relied on that specific requirement of the wireless link, **bolded and underlined**, to distinguish claims 1 and 7 over the prior art of record.

Since the Examiner immediately allowed claims 1 and 7 after the Applicant's amendment, the record is confused as to the Examiner's actual basis for allowing the claims and/or how the prior art may have met one form of wireless link but not the other. For example, independent claim 13, which was drafted and amended differently than claims 1 and 7 during prosecution, recited only a "direct" local wireless link and never included a "separate" requirement. For this reason, it appears that claim 13 was consistently rejected over the same prior art as claims 1 and 7 until the Applicant finally cancelled claim 13 altogether (*see* rejections over Birch in EX1002 at 93, 150, 213), and thus it seems likely that the Examiner believed the prior art links may have been "direct" and "short range" but not operating as "separate" links (*e.g.*, requiring a link to be a dedicated link for the claimed functions).

At best, the Examiner's reasons for allowance are based on a misapprehension of the actual claim language of the allowed claims, and it is impossible to know whether the Examiner would have still reached the conclusion of allowability if they had been evaluating the claims as submitted by the Applicant.

This constitutes a material error in the prosecution history. Applicant's amendment was clearly written, but the Examiner clearly committed material error by allowing the claims and stating reasons for allowance including claim language

that did not exist.

C. It is Appropriate to Review Material Errors Over Settled Expectations

The PTAB should refer this IPR for review on the merits so that the Board may review the '749 patent for the material error committed by the Office.

Material errors committed by the Office during prosecution have been found, consistently, to warrant referral and review on the merits by the Board as “an appropriate use of Office resources to review the potential error.” *Anthony Inc. v. Controltec, LLC*, IPR2025-00559, Paper 12 at 2 (P.T.A.B. Jul. 16, 2025); *see also Azurity Pharms., Inc. v. Helsinn Healthcare S.A.*, IPR2025-00945, Paper 11 at 3 (P.T.A.B. Sep. 19, 2025).

In fact, the same type of error committed here—in which the Examiner identified allowable claim features not actually recited—has previously been found to warrant referral. During prosecution of the patent at issue in *Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9 at 2 (P.T.A.B. Jul. 31, 2025), the examiner allowed claims over a specific “wherein” clause purportedly not found in the prior art of record, but that “wherein” clause only existed in one of the four independent claims. *See* U.S. Patent 9,402,120 (claim 1’s earbud housing “wherein” clause not found in independent claims 12, 20, or 22). During prosecution of the patent at issue in *Volkswagen Group of America, Inc. v. Longhorn Automotive Group LLC*, IPR2025-01064, Paper 9 at 2-3 (P.T.A.B. Oct. 10, 2025), pending claims issued

that “do not recite the limitation the patent examiner identified as the allowable subject matter.”

Discretionary denial was not appropriate in either *Skullcandy* or *Volkswagen* because there were discrepancies between the allowed claims and the issued claims. The error for the ’749 patent is even more egregious. The “first, direct, short range separate” limitation never existed in any pending claim of the ’749 patent (unlike *Skullcandy*, in which one independent claim did recite the allowed limitation) and the error was not previously discovered (unlike *Volkswagen*, in which both the applicant and examiner were aware of the error but failed to fix it). Thus, for the reasons discussed in *Skullcandy* and *Volkswagen*, discretionary denial is also not appropriate for the error here.

Moreover, material errors have consistently outweighed other factors that may have otherwise favored discretionary denial. For example, referral has been found appropriate in the face of patents that have been in force for sizable lengths of time. *See Anthony* at 2 (appropriate to review potential error “[a]lthough the challenged patents have been in force for approximately **eighteen and seventeen years**”); *Taiwan Semiconductor Manufacturing Co. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 at 3-4 (P.T.A.B. Sep. 3, 2025) (“Although the challenged patent has been in force for **fifteen years**, ...it is an appropriate use of Office resources to review the potential error”), *Activision Blizzard, Inc. v.*

Milestone Entertainment, LLC, IPR2025-00708, Paper 13 at 2-3 (P.T.A.B. Aug. 14, 2025) (efficient use of resources even though patent “has been in force for almost **twelve years**, creating strong settled expectations for Patent Owner”); *Volkswagen* at 2-3 (for a patent “in force for over **thirteen years**,” “Patent Owner’s settled expectations do not outweigh” Petitioner’s evidence that the Office materially erred). Here, the ’749 patent’s asserted settled expectations of fourteen years cannot overcome the need to review the Office’s error.

Furthermore, the need to review the Office’s material error should not be cast aside simply because a prior, unrelated IPR petition against the ’749 patent was denied institution. In *LifeVac LLC v. DCSTAR Inc.*, IPR2025-00454, Paper 11 (P.T.A.B. Jul. 11, 2025) (informative), the Acting Director declined to discretionarily deny a follow-on IPR even though the petitioner had previously challenged the same patent in a post-grant review that was denied institution, stating that “petitions for [IPR] will generally not be discretionarily denied because of an earlier petition for [PGR] when the [PGR] was not instituted.” Similarly here, the prior IPR petition against the ’749 patent was denied at institution and did not result in a final written decision on the merits. Moreover, that denial was due in significant part to deficiencies in the prior petitioner's presentation. That different and unrelated petitioner failed to address a limitation (*e.g.*, the claimed “predetermined event”) and did not “support adequately” its arguments (*e.g.*, that

the prior art disclosure mapped to the claimed changing IDs) and its motivation to combine the prior art. *See* Pet. at 2-3. A denial attributable to a petitioner's failure to make its case is a far cry from a merits determination of patentability. To treat such a denial as a basis for foreclosing review of a patent allowed on non-existent claim language would insulate the Office's error from any meaningful scrutiny.

Nor does *Google LLC v. Mullen Industries LLC*, IPR2025-00227, Paper 13 (P.T.A.B. Jun. 25, 2025), require discretionary denial here. *See* Paper 6 (DD Req.) at 9 and 12. The facts surrounding the '540 patent in *Google v. Mullen* are not analogous to those for the '749 patent. Significantly, the '540 patent had been dismissed from the parallel district court litigation by the time of the PTAB discretionary denial decision. The PTAB determined that the '540 patent IPR would have served no practical purpose and would have been “an inefficient use of Board resources.” *Google v. Mullen* at 4. That is not the situation here since the '749 patent remains actively asserted, and review of the '749 will have a substantive impact on the ongoing dispute between Google and PO. Further, *Google v. Mullen* involved no allegation of material error by the Office, which outweighs other considerations. The present case is fundamentally different.

The Examiner allowed the '749 patent based on a claim limitation that never existed in the claims. Where, as here, the Office's own examination record reflects a concrete and documentable error that affected the basis for allowance, review is

an appropriate use of Office resources. A prior petitioner's failure to adequately present its case does not cure the Office's error and should not bar the present Petitioner from seeking the review that the record plainly warrants. Referral for review on the merits is appropriate.

III. GOOGLE HAD LONG-SETTLED EXPECTATIONS THAT THE '749 PATENT WOULD NOT BE ASSERTED AGAINST IT

Regardless of the Office's material error requiring review of the '749 patent, Google had no reason to believe it infringed the '749 patent in the way PO now asserts. PO states that Google has been on notice of the '749 patent for 14 years and "waited nearly 14 years to challenge or dispute the validity... of the '749 patent," thereby allegedly creating settled expectations. DD. Req., 8. On these same facts, however, PO's 14-year wait between allegedly putting Google on notice of the '749 patent and actually asserting it against Google created settled expectations for Google that the '749 patent was not applicable to its business. Google's settled expectations of inapplicability and non-infringement outweigh any settled expectations that PO may have had in the '749 patent.

First, Google had not been under threat of infringement liability for the '749 patent during the almost 14 years that PO is asserting settled expectations. PO's correspondence that allegedly put Google "on notice" of the '749 patent and included the '749 patent among three others—US 7,936,736; 8,090,359; and 8,090,616—only presented these patents as potential interests or acquisitions for

Google. EX2004. The correspondence identified other “relevant” companies, such as Isis, PayPal Mobile, ShopKick, and Facecash, and identified the patents’ concepts as including purchase authentication, temporary credit card numbers, check-in services, and multi-factor authentication. EX2004. Prior to PO asserting the ’749 patent through the September 8, 2025, Amended Complaint, neither Google, nor any of its products or services, were identified as potentially infringing the ’749 patent.

Second, PO never sued any of those identified mobile commerce platforms. Therefore, to the extent Google was put on notice of the ’749 patent from PO’s initial correspondence, any expectations of infringement by its own products died over the 14 years in which the ’749 patent was not asserted against any of those “relevant” companies, but instead, large retailers offering in-store services.

In fact, the ’749 patent has never been asserted in any manner or in any industry that would have put Google on notice that PO would now assert the ’749 patent against Google’s Find Hub Network device tracking system. Where a patent has never been “commercialized, asserted, marked, licensed, or otherwise applied” in a particular technology space, there are no settled expectations. *Home Depot* at 2-3.

Prior to PO’s assertions in 2025, PO only asserted the ’749 patent twice in

the past: once against Macy’s Inc. in 2018 and once against Target Corp. in 2019.²

In both cases, the accused infringers were operators of retail stores, and PO alleged that the ’749 patent was infringed by systems of mobile devices running retail store applications, beacon devices inside retail stores, and related consumer data servers. EX1055 (Complaint against Macy’s), 8-10; EX1056 (Amended Complaint against Target), 54-57. PO’s assertion of the ’749 patent in the context of retail shopping industries is also commensurate with the Office’s understanding of the claims. *See* EX1002, 102-108 (narrowing searches L25-L29, S11-15, S20-S24, S26-S33, S36, S39-S40, S43-S45, S78, and S82 are all limited to prior art with e-coupons), 150 (the examiner’s primary prior art, Birch (US 7,213,742), is a System and Method for Value Creation that “facilitat[es] third participation in mobile commerce transactions” and “selectively implement[s] discounts;” *see* EX1057, Abstract); EX1056, 28-43, 54-57 (asserted infringement by Target App, Servers, and in-store beacons that provide product offers).

However, PO does not accuse Google, like it did Macy’s and Target, of operating a network of retail stores and shopping software applications. Instead, PO accuses Google of infringing the ’749 patent via Bluetooth-based apps that find and track the locations of personal electronic devices such as phones and

² Cases 6:19-cv-00064 and 6:19-cv-01886 in M.D. Fla.

accessories like earbuds. EX2017, 7-8 (Amended Complaint); EX1048 (infringement claim chart).

For 14 years—the vast majority of the ’749 patent’s term—PO neither sued Google nor pursued infringement claims against technologies like those it is accusing now. PO’s unprecedented shifts in supposed relevant technology spaces for the ’749 patent—from mobile commerce platforms to retail store operations, and now to Bluetooth device location tracking—“weigh[s] in favor of Petitioner’s expectations” of not anticipating assertion of the ’749 patent, and “outweigh[s]... considerations favoring discretionary denial.” *Home Depot* at 2-3.

Accordingly, to the extent settled expectations exist and are relevant in this case, PO’s inaction against mobile commerce platforms since 2012 and PO’s subsequent assertions against retail store operations in 2018-2019—neither of which relate in any way to the Bluetooth device location tracking technologies that PO pivoted to accusing in 2025—should weigh in favor of Google.

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

A. The Grounds Fail *Advanced Bionics* Step One³

The Petition presents grounds of rejection based on Bucuk (US 2010/0274859), Nordman (US 2002/0174364), Kallio (US 2003/0224756), and Perttila (US 2004/0243519). These prior art were not considered during prosecution of the '749 patent. Therefore, the prosecution examiner never considered the combined teachings of Bucuk, Nordman, Kallio, and Perttila, and the grounds fail *Advanced Bionics* step one.

B. The Grounds Nevertheless Satisfy *Advanced Bionics* Step Two⁴

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

Even considering step two, demonstrable material error occurred during prosecution of the '749 patent. The prosecution examiner allowed the claims of the '749 patent based on a limitation that never existed, which is a material error

³ *Advanced Bionics, LLC v. Med-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential) (whether the same or substantially the same art or arguments were presented to the Office).

⁴ Whether the Office erred in its evaluation of the asserted prior art. *Advanced Bionics*, Paper 6 at 8.

committed by the Office. *See* §II.B above. It is impossible to know whether the examiner assessed the prior art of record in view of the correct claims as pursued by the applicant/PO, making review of this error is now appropriate.

Moreover, not only were the '749 patent claims mistakenly allowed based on a non-existent limitation, but to the extent any of the prior art cited during prosecution of the '749 patent can be considered cumulative of the combined teachings of Bucuk, Nordman, Kallio, and Perttila, none of which were before the examiner during prosecution, the examiner erred by not rejecting claims over that prior art in the manner set forth in the Petition.⁵

Accordingly, even if the Petition grounds satisfy *Advanced Bionics* step one (they do not), step two is satisfied by the Office's material error during prosecution. Discretionary denial is not warranted.

C. The *General Plastics* Factors Do Not Support Denial

Petitioner has acknowledged that the instant IPR is the second IPR challenge

⁵ *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. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017).

for the '749 patent—the first was previously denied institution because of the prior petitioner's failure to adequately address the claims. *See* §II.C above.

The prior petition raises no bar under the factors established in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357 (P.T.A.B. Sep. 6, 2017). The prior petition was brought by a different and unrelated petitioner (factor 1), relied on different prior art and issues (factor 2), and resulted in minimal investment by the Board due to non-institution (factor 6). Google diligently prepared and filed the instant IPR petition just four months after the '749 patent was asserted against it in district court (factors 4-5), not as a strategic response to the prior IPR filings (factor 3).

There is no bar under §325(d).

V. CONCLUSION

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

Respectfully submitted,

Date: April 14, 2026

/Scott A. McKeown/

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

I certify that on April 14, 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:

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