

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

GOOGLE LLC,
Petitioner,

v.

SECURE COMMUNICATION TECHNOLOGIES, LLC,
Patent Owner.

IPR2026-00099
Patent 8,116,749 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

DECISION
Denying Institution of *Inter Partes* Review

Secure Communication Technologies, LLC (“Patent Owner”) filed a request for discretionary denial (Paper 6, “DD Req.”) in the above-captioned case, and Google LLC (“Petitioner”) filed an opposition (Paper 8, “DD Opp.”). On April 28, 2026, after considering the parties’ arguments and the record, and in view of all relevant considerations, I issued a Notice indicating that institution is denied in this proceeding. Paper 9.

Patent Owner argues in its discretionary denial request that the challenged patent has been in force for over fourteen years. DD Req. 2, 9–11. Accordingly, Patent Owner argues that it has developed settled expectations over that time period and that the patent is valid and enforceable. *See Dabico Airport Sols. Inc. v. Axa Power Aps*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025). Moreover, Patent Owner argues that Petitioner has been on notice of the challenged patent since at least February 2012, based on correspondence between Patent Owner and representatives for Petitioner identifying the challenged patent. DD Req. 2–3, 9–11 (citing Exs. 2001–2005). Patent Owner also argues that Petitioner cited US 8,116,749 B2 (“the ’749 patent”) to the Office in December 2012, during prosecution of Petitioner’s own Application No. 13/716,675. *Id.* at 3 (citing Exs. 2006–2007). Thus, Patent Owner argues that Petitioner’s “knowledge of the ’749 patent predates its development of the products and features accused in the parallel district court action.” *Id.* at 11 (citing Exs. 2018–2021).

Petitioner responds that Patent Owner’s conduct “created settled expectations for [Petitioner] that the ’749 patent was not applicable to its business.” DD Opp. 11. According to Petitioner, Patent Owner’s correspondence presented the challenged patent among other patents as “potential interests or acquisitions for” Petitioner and other mobile

commerce providers. *Id.* at 11–12 (citing Ex. 2004). Following that initial correspondence, Petitioner argues that the challenged patent has not been “commercialized, asserted, marked, licensed, or otherwise applied” in its technology space. *Id.* at 12 (citing *Home Depot U.S.A., Inc. v. H2 Intellect LLC*, IPR2025-00480, Paper 11 (director Sept. 4, 2025)). Rather, Petitioner argues that Patent Owner asserted the challenged patent against retail store operations “based on their use of in-store customer communication systems for communicating shopping-related information such as discounts on in-store products.” DD Opp. 1, 13 (citing Exs. 1055, 1056). Petitioner argues that “the ’749 patent has never been asserted in any manner or in any industry that would have put” Petitioner on notice that it would be asserted against Petitioner’s “Find Hub Network device tracking system,” for finding and tracking the locations of personal electronic devices. *Id.* at 12–14.

Petitioner’s arguments are not persuasive. Petitioner was aware of the challenged patent no later than February 2012, and Patent Owner specifically identified the patent as being of interest to mobile commerce providers. *See* Ex. 2004. Petitioner cited the challenged patent to the Office during prosecution of Petitioner’s own Application No. 13/716,675 in December 2012. *See* Ex. 2007. Application No. 13/716,675 is titled “Methods and Systems for Efficient Discovery of Devices in a Peer-to-Peer Network.” *See* Ex. 2006. Efficient discovery of devices in a peer-to-peer network appears to be relevant to both retail operations and the finding and tracking of personal electronic devices. Accordingly, Petitioner’s own actions indicate it was aware that the challenged patent was relevant to its technology space.

Finally, I do not agree with Petitioner’s assertion that the Office committed a material error during prosecution. While demonstrating error is

usually one of the strongest considerations weighing against discretionary denial, here Petitioner's material error argument is weak. Petitioner points to the notice of allowance, and focuses on a single phrase that appears in a rather long listing of limitations the examiner indicated were missing from the prior art. DD Opp. 2–3. According to Petitioner, the phrase “first, direct, short range separate local wireless link” never existed in the claims. *Id.* at 4. However, Petitioner acknowledges that the phrase “via a separate local wireless link” was part of the claims, as was the phrase “first, direct, short range” local wireless link. *Id.* Although the ultimate listing in the notice of allowance may constitute a clerical error, Petitioner has not demonstrated sufficiently that this error was material to the patentability of the challenged claims, especially considering the number of other limitations listed in the notice of allowance that the examiner determined to be missing from the reviewed prior art. Petitioner does not address those limitations in its error arguments. *Id.* at 3–6.

While certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on the complete record and a holistic assessment of all of the evidence in light of the arguments presented.

In consideration of the foregoing, it is:

ORDERED that the Petition is *denied*, and no trial is instituted.

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