

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

GAMBA GROUP HOLDINGS LLC,
Patent Owner.

Case IPR2026-00156
Patent 9,772,193

**PATENT OWNER'S REPLY
IN SUPPORT OF DISCRETIONARY DENIAL**

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EXHIBIT LIST

Ex.	Description
2001	Order (ECF No. 71), <i>AICP v. TSMC</i> , No. 2:25-CV-00324-JRG (E.D. Tex. Aug. 29, 2025)
2002	Order (ECF No. 53), <i>Telcom v. Samsung</i> , No. 2:24-CV-691-JRG (E.D. Tex. Aug. 27, 2025)
2003	Order (ECF No. 52), <i>Keyless Licensing v. Samsung</i> , No. 2:24-CV-00464-JRG (E.D. Tex. May 30, 2025)
2004	First Amended Docket Control Order (ECF No. 21), <i>Gamba v. Samsung</i> , No. 2:25-cv-00438-JRG (E.D. Tex. July 31, 2025)
2005	Order (ECF No. 73), <i>MyPort v. Samsung</i> , No. 2:22-cv-00114-JRG (E.D. Tex. June 13, 2023)
2006	U.S. Court Statistics for the 12-month period ending Dec. 31, 2025
2007	Samsung's Invalidity Contentions (cover pleading), <i>Gamba v. Samsung</i> , No. 2:25-cv-00438-JRG (E.D. Tex. Oct. 13, 2025)
2008	Exhibit C-01 to Samsung's Invalidity Contentions
2009	Exhibit C-07 to Samsung's Invalidity Contentions
2010	Google-Samsung Mobile Application Distribution Agreement (Android) (2011)
2011	Joint Trial Exhibit List (ECF No. 888), <i>United States v. Google</i> , No. 1:20-cv-03010-APM (D.D.C. Apr. 19, 2024)
2012	Redacted copy of Google-Samsung Revenue Share Agreement RSA (2020) (https://www.justice.gov/d9/2023-11/418307.pdf)
2013	L. Irwin, <i>Google paid \$8 billion to make its apps default on Samsung phones</i> , The Hill (Nov. 14, 2023) (https://thehill.com/policy/technology/4309219-google-paid-8-billion-to-make-its-apps-default-on-samsung-phones/)
2014	Complaint (ECF No. 1), <i>Gamba v. Samsung</i> , No. 2:25-cv-00438-JRG (E.D. Tex. Apr. 25, 2025)
2015	Ex. F to Complaint (ECF No. 1-6), <i>Gamba v. Samsung</i> , No. 2:25-cv-00438-JRG (E.D. Tex. Apr. 25, 2025)
2016	U.S. Patent No. 11,983,712 (issued May 14, 2024 from U.S. Appln. No. 17/023,029)
2017	Office Action, U.S. Appln. No. 17/023,029 (mailed June 27, 2022)
2018	U.S. Patent No. 9,911,133 (issued Mar. 6, 2018 from U.S. Appln. No. 13/436,925)
2019	Office Action, U.S. Appln. No. 14/802,016 (mailed Apr. 19, 2017)

Ex.	Description
2020	First Amended Complaint (ECF No. 32), <i>Gamba v. Samsung</i> , No. 2:25-cv-00438-JRG (E.D. Tex. Oct. 2, 2025)
2021	Ex. F to First Amended Complaint (ECF No. 32-6), <i>Gamba v. Samsung</i> , No. 2:25-cv-00438-JRG (E.D. Tex. Oct. 2, 2025)
2022	U.S. Appln. Pub. No. US 2017/0016975 A1 (U.S. Appln. No. 14/802,016, published Jan. 19, 2017)
2023	Supplemental Information Disclosure Statement, U.S. Appln. No. 13/436,925 (filed Sept. 30, 2016)
2024	Apr. 3, 2006 Specification, Application No. 11/396,843
2025	U.S. Patent No. 9,420,423
2026	U.S. Patent No. 9,538,332
2027	U.S. Patent No. 9,674,684
2028	E-mail chain, dated April 6-8, 2026, between counsel for PO and counsel for Samsung in connection with <i>Gamba v. Samsung</i> , No. 2:25-cv-00438-JRG (E.D. Tex.) [partially redacted]
2029	Protective Order (ECF No. 24), <i>Gamba v. Samsung</i> , No. 2:25-cv-00438-JRG (E.D. Tex. Aug. 8, 2025)
2030	Declaration of Ehud Mendelson, dated April 13, 2026
2031	Screenshots of LinkedIn messages, dated December 16, 2013, from Ehud Mendelson to Laura Sheridan (Google)
2032	Screenshots of LinkedIn messages, dated December 16, 2013, from Ehud Mendelson to Joshua McGuire (Google)
2033	E-mail, dated September 22, 2014, from Ehud Mendelson to Joshua McGuire (Google)
2034	Screenshots of LinkedIn message, dated October 13, 2015, from Ehud Mendelson to Noam Bardin (Google)
2035	Presentation (‘shortblue.pdf’), linked to in October 13, 2015 LinkedIn message of Ex. 2034
2036	Screenshots of LinkedIn messages, dated September 8 and 15, 2022, from Ehud Mendelson to David McClusky (Google)
2037	Presentation (‘indoor navigation and mapping info.pdf’), attachment to September 15, 2022 LinkedIn message of Ex. 2036
2038	Screenshots of LinkedIn message, dated September 7, 2024, from Ehud Mendelson to Tim Kowalski (Google)
2039	Screenshots of LinkedIn messages, dated September 7-14, 2024, between Ehud Mendelson and Aron Di Castro (Google)
2040	Patent List (‘patent list1 (1).pdf’), attachment to September 7, 2024 LinkedIn messages of Exs. 2038 and 2039

Ex.	Description
2041	1 st E-mail, dated October 28, 2024, from Ehud Mendelson to Aron Di Castro (Google)
2042	2 nd E-mail, dated October 28, 2024, from Ehud Mendelson to Aron Di Castro (Google)
2043	Presentation (‘indoor mapping navigation and indoor view3.pdf’), attachment to 2 nd October 28, 2024 E-mail of Ex. 2042

Petitioner's Opposition (Paper 7; "Opp.") launches attacks against PO and the Office but relies on only mischaracterizations, conjecture, and conclusory assertions. The Director should deny the Petition.

A. Petitioner's Allegations of Deceit are Baseless

Petitioner's Opposition argues PO "deceived the Office" to obtain the '193 Patent by characterizing family members as "divisionals" and "misrepresenting its patent's priority chains." Opp. 1-8, 19. Petitioner's deceit arguments are unsupported, irrelevant, and meritless.

Petitioner argues that the '193 Patent must contain new matter based on paragraph and page counts, but neither Petitioner nor its technical expert identifies any new subject matter. *Cf.* Opp. 4-5. Instead, Petitioner now relies on a *patent practice and procedure expert*, Mr. Bahr. *See, generally*, Opp. §III; Ex. 1016 ¶¶1-3. *First*, Bahr's testimony is improper because it addresses Office practice and procedures: "[t]estimony on United States patent law or patent examination practice **will not be admitted.**" 37 C.F.R. §42.65; *see generally* PTAB Trial Practice Guide §I.G. The Director is fully capable of understanding Office practice and procedures without the aid of Bahr's inadmissible 46-page declaration. *Second*, even if considered, Bahr's testimony should be given no weight. Bahr merely hypothesizes that it would be "remarkable" if there were not new subject matter, without any substantive analysis of the added paragraphs or whether it is required to support the

claims. *See* Opp. 5 quoting Ex. 1016 at ¶ 47. Such speculation is not evidence.

Petitioner further argues that characterizing the family as divisionals “misled the Examiner into not considering PO’s own earlier patents/publications.” Opp. 1-2. This is incorrect. The Examiner—who was the primary examiner on the ’193 Patent and the three most recent applications to which it claims priority (Exs. 2025-2027)—considered three prior patents in the family, and PO cited an application in the family. Ex. 1001 (References Cited include Pat. Nos. 8,896,485, 9,204,251, and 9,538,332, and Pub. No 2006/0253226 A1).

Furthermore, Petitioner’s broken priority chain argument (Opp. 6) is irrelevant to the Grounds, because no asserted Ground requires a priority date determination. *See* POPR (Paper 8) 18; *cf.* Opp. 6-8. Grounds not alleged in a Petition cannot provide a basis for an IPR. *See Koninklijke Philips NV v. Google LLC*, 948 F.3d 1330, 1336 (Fed. Cir. 2020); *Wasica Finance GmbH v. Continental Auto. Sys., Inc.*, 853 F.3d 1272, 1286-87 (Fed. Cir. 2017).

B. The Examiner Conducted a Proper Search

Petitioner asserts that the Examiner performed “an unduly narrow and defective search” because the Examiner did not search for “GPS.” *See* Opp. 2, 10, 11 (quoting Ex. 1016, Bahr Decl, ¶¶66, 67). The criticism is baseless and fatally premised upon Petitioner’s incorrect position—adopted by Petitioner’s experts—that the “literal scope” of Claim 12 is a single embodiment that uses GPS only. *See*

Opp. 8; Pet. 9; Ex. 1006, ¶43; Ex. 1016, ¶57. *First*, Claim 12 does not even mention GPS, so its “literal scope” (*contra* Pet. 9) does not require GPS. *See* POPR, (Paper 8), 10-11. *Second*, Claim 12 is a “comprising” claim, and Claim 15 adds a limitation to Claim 12. *See id.* at 11-12. Indeed, Claim 15 expressly recites “[t]he method as recited in claim 12, **further comprising**” employing GPS, “thus showing that [claim 15’s step] is not part of the [claim 12’s] step.” *See David Netzer Consulting Eng’r LLC v. Shell Oil Co.*, 824 F.3d 989, 996 (Fed. Cir. 2016).

Petitioner and Bahr also criticize the Examiner’s inclusion of “beacon” and “encoding” because they are not found in the Challenged Claims (Opp. 10 (citing Ex. 1016, ¶60)), but these terms are in Claim 1 and are broader than just “GPS.” The search was appropriate.

Petitioner and Bahr also criticize the Examiner for having searched class 455, subclass 41.2: short range RF communication under a telecommunications class (Opp. 10, quoting Ex. 1016, ¶62-65), but this class properly reflects Claim 12’s repeated references to “Bluetooth transceiver.” Thus, it is Petitioner and Bahr, not the Examiner’s search, that disingenuously fail to “show awareness of what these claims require and do not require.” *Contra* Opp. at 10, (quoting Ex. 1016, ¶¶62-65).

Petitioner and Bahr also argue that a search of additional subclasses within USPC classes 455 and 342, and/or “a complete CPC search” “would have uncovered” all three of the references relied on by Petitioner. *See* Opp. 11-12

(quoting Ex. 1016, ¶67). But neither Petitioner nor Bahr represents they actually performed such searches, nor do they address the volume of results such searches could have generated or why the Examiner would have specifically identified Baese, Phillips, or Soliman from among these hypothetical search results. “Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.” 37 C.F.R. §42.65.

Petitioner’s “evidence” of a deficient search is that the Examiner did not find the two primary references (Baese and Phillips) relied on in the Petition. Opp. at 2, 11. This is just a circular argument that could be made in any IPR asserting previously uncited art.

C. Petitioner Had Prior Notice but Was Not Diligent in Filing Its IPR

Petitioner argues it “had no prior notice of the ’193 patent” and “diligently filed an IPR” “as soon as [it] became aware of the ’193 patent...” Opp. 13-14, 18. That is untrue. As reflected in the accompanying declaration of Ehud Mendelson, the ’193 Patent’s inventor, he personally put Petitioner on notice of the ’193 Patent by 2022 (Ex. 2030 at ¶¶6-7; Exs. 2036, 2037) and again in 2024 (Ex. 2030 at ¶¶8-11; Exs. 2038-2043), after notifying Petitioner of the ’193 Patent’s family as early as 2013 (Ex. 2030 at ¶¶3-5; Exs. 2031-2035).¹ While Petitioner feigns ignorance,

¹ In addition, ’193 Patent family members have been cited in prosecution of

Petitioner's arguments do nothing to rebut PO's settled expectations of the '193 Patent's validity.

D. Petitioner's Real-Party-in-Interest Position Is Deficient

Petitioner bears the burden of identifying all real parties in interest ("RPIs") but wrongly attempts to shift that burden to PO. *See Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242-43 (Fed. Cir. 2018). Petitioner's Opposition acknowledges that "certain agreements ... exist between Samsung and Google," but does not comment on Petitioner's obligation to defend and indemnify Samsung for patent infringement claims based on Google Applications on Samsung Android smartphones. Instead, Petitioner characterizes them as mere "generic agreements" that PO has not shown to be "specific to any technology, let alone any technology at issue" without any substantiation. Opp. 16-17. But Petitioner and Samsung control access to their agreements. *See Worlds*, 903 F.3d at 1242-43 ("[A]n IPR petitioner will usually be in a better position, at least relative to the patent owner, to access evidence relevant to the [RPI] inquiry.").

Petitioner's own applications, confirming their relevance to Petitioner. *See* PO's DD brief (Paper 6) 4-5; Exs. 2016, 2017 (Pat. No. 9,538,332 cited in 2022); Exs. 2018, 2022 (Pat. No. 9,204,251 cited in 2017); Exs. 2019, 2023 (Pat. No. 9,204,257 cited in 2016).

In support of PO's argument, it sought to cite in this IPR documents produced in the EDTX Litigation after filing of PO's DD brief; however, Samsung has refused to consent to PO filing such documents in this IPR, even *under seal*. See Ex. 2028; Ex. 2029; *see also* Paper 6, at 17-19. Petitioner's (and Samsung's) attempt to use the purported confidential nature of the Google-Samsung relationship as both a sword and a shield in this IPR should be rejected. Petitioner has not rebutted PO's evidence and has failed to satisfy its burden of identifying all RPIs.

Date: April 13, 2026

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CERTIFICATE OF SERVICE

I hereby certify that on April 13, 2026, I caused a true and correct copy of the foregoing Patent Owner's Reply in Support of Discretionary Denial to be served via electronic mail upon the following attorneys of record for the Petitioner:

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