

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC
Petitioner

v.

VALTRUS INNOVATIONS LIMITED,
Patent Owner

IPR2026-00262

Patent No. 7,057,509

PETITIONER'S DISCRETIONARY DENIAL OPPOSITION

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Ex. 1004	Prosecution History of U.S. Patent App. No. 10/881,975	X
Ex. 1005	U.S. Patent No. 7,439,847 (“Pederson”)	X
Ex. 1006	U.S. Patent No. 7,212,113 (“Zanovitch”)	X
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I. INTRODUCTION

Patent Owner Valtrus Innovations Limited’s (“Valtrus”) request for discretionary denial (Paper 8 (“DD Req.”)) of this IPR involving U.S. Patent No. 7,057,509 (“’509 patent”) should be denied because, if anyone has settled expectations that should be considered, it is Google LLC (“Google”).¹ Valtrus contacted Google in 2021 about a portfolio that included the ’509 patent, sued Google in 2022 on *other* patents (followed by three additional suits before this IPR), but waited until a few weeks ago to file infringement claims against Google for the ’509 patent. Valtrus did not bring those claims until nearly 19 months after the ’509 patent expired, and only then in apparent retaliation for Google’s filing this IPR.

There was no indication that Valtrus would assert the ’509 patent against Google Maps until 2025 when Valtrus filed an action against Lenovo and Motorola based on their use of Google Maps. But even then, Valtrus did not assert the ’509 patent against Google. Following that action, Google challenged the ’509 patent via IPR—not by adding the ’509 patent to Google’s pending declaratory judgment action against Valtrus in N.D. Cal. in relation to other patents.

¹ Google disputes that “settled expectations” are a proper consideration for discretionary denial and reserves all rights to challenge the Director’s reliance on that consideration.

That sequence is the opposite of the concern addressed in *Magnolia*. There, the Director explained that AIA reviews are intended to provide a “quick and cost-effective alternative” to district court litigation and to narrow disputes, not expand them. *Magnolia Med. Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 2-3 (Director May 14, 2026). Here, Google used IPR as the first and only forum for challenging the ’509 patent. Valtrus then added the ’509 patent to the N.D. Cal. action. The Director should not reward that sequencing.

The remaining discretionary considerations likewise favor merits review. Google is a domestic developer and provider of the accused Google Maps product, while Valtrus, *a foreign entity*, identifies no competing domestic product, no U.S. manufacturing, no U.S.-based product development, and no U.S. employees. Reviewing Google’s petition on the merits would allow the Patent Office to ensure an erroneously issued patent cannot be leveraged by a *foreign* actor to impede innovation and progress in the United States. Such a review is essential to the health of a properly functioning patent system and consistent with the USPTO’s stated role as “America’s Innovation Agency.” The role of America’s Innovation Agency cannot be simply to protect the patents it issues; instead, it must include safeguarding American innovation from foreign actors who buy patent assets (like the ’509 patent) for asserting against American products (like Google Maps) that serve millions of Americans and American businesses on a daily basis.

The case for review is further underscored by material Examiner error during prosecution of the '509 patent. The Examiner failed to perform a thorough search and review of the prior art, causing important disclosures and anticipatory references like Zanolitch (Ex. 1006) to go overlooked. Merits review is warranted.

II. IF SETTLED EXPECTATIONS ARE CONSIDERED, THEY FAVOR GOOGLE, NOT VALTRUS

A. Valtrus Repeatedly Chose Not to Assert the '509 Patent Against Google Until After Google Filed This IPR

Valtrus ignores the case-specific chronology. Valtrus first contacted Google about a portfolio that included the '509 patent in 2021, but according to Valtrus, the parties “did not engage in substantive discussions.” (DD Req. 8.) Shortly thereafter, Valtrus sued Google in 2022 for alleged infringement of six patents—but not the '509 patent, even though Google Maps existed long before 2022. (*See* Ex. 1016 ¶2.) And Valtrus sued Google three more times before this IPR but still did not assert the '509 patent in any of those cases. *See Valtrus Innovations Ltd. v. Google LLC*, No. 3:24-cv-01795 (Jul. 12, 2024 N.D. Tex.); *Valtrus Innovations Ltd. v. Google LLC*, No. 3:24-cv-03249 (Dec. 27, 2024 N.D. Tex.); *Valtrus Innovations Ltd. v. Google LLC*, No. 5:25-cv-07179 (Aug. 25, 2025 N.D. Cal.).

The '509 patent expired on October 10, 2024 (Ex. 1001), without Valtrus ever having asserted it against Google or Google Maps. Valtrus’s decision not to assert the '509 patent against Google before expiration undercuts Valtrus’s claim that it

developed settled expectations in the patent's enforceability against Google. *See Google LLC v. Sandpiper CDN, LLC*, IPR2025-00806, Paper 13 at 2-3 (Director Sept. 12, 2025) (discretionary denial not appropriate because petitioner persuasively showed it expected non-enforcement when patent expired two years before IPR).

In 2025, after the '509 patent had expired, Valtrus asserted it against two companies (Lenovo and Motorola) based on their use of Google Maps. But that litigation does not support discretionary denial. It explains why Google filed this IPR. Google chose to challenge the '509 patent in the Office, using IPR as a true alternative to district court. In response, just eleven days before requesting discretionary denial, Valtrus added the '509 patent to a pending N.D. Cal. action where Google had filed declaratory judgment claims against Valtrus regarding other patents. (Ex. 1009, 30 (¶¶30-46).) Valtrus now invokes its counterclaims as a basis for discretionary denial (DD Req. 11) even though it is the party trying to create overlap in district court.

Valtrus waited until April 16, 2026 to assert the '509 patent against Google. That was more than four years after Valtrus first contacted Google, over three years after Valtrus sued Google on other patents, over a year-and-a-half after the '509 patent expired, and two months after Google filed this IPR. If settled expectations are considered at all, these facts favor Google, not Valtrus. *See Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 at 3 (Director Sept. 5, 2025) (denying

discretionary-denial request where challenged patents were not asserted against petitioner until after they expired); *Globus Med., Inc. v. Spinelogik, Inc.*, IPR2025-00226, Paper 8 at 2 (Director June 12, 2025) (denying discretionary-denial request for expired patent).

It is unsurprising that Valtrus did not assert the '509 patent against Google until after Google filed its IPR petition because Google Maps, the allegedly infringing product, is far afield from the '509 patent's technology (e.g., airport security systems and similar (Pet. 8-9)). Material deficiencies in the claim chart that Valtrus made available to Google in 2021 demonstrate as much. (*See generally* Ex. 1017.)² For example, Valtrus mapped the claimed "identification gateway," which the '509 patent embodiments depict as a physical gateway to/from the monitored environment (*see, e.g.*, Ex. 1001, Fig. 8), to "a cellular base station or Wi-Fi access point," which is not a physical gateway. (Ex. 1017, 11). And Valtrus hand-waved over the claimed "monitored environment" by vaguely pointing to the "environment surrounding the person," which renders that limitation meaningless and thus demonstrates that Google Maps could not plausibly infringe the '509 patent. (*Id.*)

Further confirming that Google Maps is far afield from the '509 patent, Valtrus previously asserted the '509 patent against TierPoint for alleged

² Obtained from the Dropbox link on page 2 of Patent Owner's Exhibit 2008.

infringement by a data center security system. (Ex. 2006 ¶¶ 33-35; *see generally* Ex. 1019 (Valtrus-TierPoint claim chart).) In its TierPoint complaint, Valtrus alleged that “[t]he ’509 patent is generally directed to a method of monitoring an object in a data center.” (Ex. 2006 ¶34.) Google Maps is not a data center or anything close to the accused TierPoint security system (*see generally* Ex. 1019). *Cf. Home Depot U.S.A., Inc. v. H2 Intellect LLC*, IPR2025-00480, Paper 11 (Director Sept. 4, 2025) (informative) (petitioner had settled expectations when a patent was not commercialized, asserted, licensed, or otherwise applied in a petitioner’s technology space).

B. Valtrus Fails to Show Settled Expectations

Valtrus contends over fifty entities have licensed its patent portfolio that includes the ’509 patent. (DD Req. 6.) But Valtrus omits that the portfolio contains over 1300 patents. (Ex. 1004, 1-36.) There is no evidence in the record that any of the licenses were driven by the ’509 patent. Even the two litigations Valtrus cites involved multiple different patents, so there is no way to determine if the ’509 patent played any role in those defendants licensing Valtrus’s portfolio. (*See* Ex. 2006 ¶4; Ex. 2007 ¶¶37-42.) Even if licensing can sometimes support settled expectations, Valtrus cannot shield all 1300-plus patents from IPR—entirely insulating Valtrus from this forum—based on portfolio-wide licenses. Without a demonstrated nexus between the licenses and the ’509 patent, portfolio-wide licenses do not show settled

expectations for that specific patent. That the '509 patent is twenty years old does not change the calculus. The patent expired nearly two years ago, weighing against Valtrus's settled expectations. *See, e.g., Apple*, IPR2025-00856, Paper 11 at 3.

Valtrus's reliance on Mr. Pradhan's current employment with Google similarly fails to move the needle. The '509 patent names three inventors and was filed by Hewlett-Packard Development Company, not Google or Valtrus. (Ex. 1001, Cover.) Valtrus asserts that one named inventor, Mr. Pradhan, has worked at Google X since 2020—approximately sixteen years after the application was filed and fourteen years after the patent issued. (DD Req. 9; Ex. 2005.) This is unlike cases where named inventors played a prominent role in the petitioner's company before advocating unpatentability of their own patent. *See Tessell, Inc. v. Nutanix, Inc.*, IPR2025-00322, Paper 14 at 2-3 (Director June 12, 2025) (discretionary denial warranted where nearly all named inventors worked for petitioner, two inventors founded petitioner, and the inventors advocated unpatentability of their own patent). Moreover, Valtrus does not show that Mr. Pradhan's work at Google has anything to do with Google Maps³ or provide any basis from which to conclude Mr. Pradhan, who does not work for Google's legal department (Ex. 2005), has any responsibility

³ Mr. Pradhan has recently been a named inventor on unrelated technologies such as "Systems and Methods for Greenhouse Gas Mitigation." (Ex. 1021, Cover.)

for Google’s patent litigation strategy.

III. GOOGLE’S U.S. OPERATIONS AND INVESTMENTS RELATED TO THE GOOGLE MAPS PRODUCT FAVOR REVIEW

Google is a great American innovator that has provided Google Maps for 21 years. (*See* Ex. 1010, 1; Ex. 1011 ¶3 (Google headquartered in California since its 1998 founding).) Over the past two decades, Google has continually updated and advanced Google Maps. (*See generally* Ex. 1010.) Institution would protect Google’s domestic operations and ongoing investments in U.S. development of Google Maps, including through U.S.-based employees working on Google Maps features. (*See* Ex. 1011 ¶¶3-8; Ex. 1012 ¶¶1-4; Ex. 1013 ¶¶2-9.)

In contrast, Valtrus is a non-practicing entity “focused on licensing” a “portfolio of patents originating from Hewlett Packard Enterprise Company.” (Ex. 1015, 2.) Valtrus has no product that competes with Google Maps, let alone one manufactured or developed in the United States. And the only allegedly licensed products in the record are TierPoint’s data centers, which are very different from and do not compete with Google Maps (*see* Ex. 2006 ¶¶33-35; Ex. 2001 ¶4; DD Req. 1-2), and Lenovo and Motorola’s “use of Google Maps” (Ex. 2001 ¶5; *see* DD Req. 1-2). But Lenovo and Motorola’s use of Google Maps—even if now licensed by Valtrus—is not a competing product (it is still Google Maps from Google).

The record does not show Valtrus has any domestic activity whatsoever beyond licensing and litigation. Valtrus is an Irish entity that is a subsidiary of Key

Patent Innovations Ltd. (“KPI”). (Paper 7, 2; Ex. 1009, 14 (¶1).) KPI is also an Irish entity. (Ex. 1009, 14 (¶3).) And at least as of May 30, 2024, Valtrus and KPI had no employees in the U.S. and were managed by an individual residing in Ireland. (Ex. 1014, ¶¶2, 4, 7.) Accordingly, merits review of this IPR would protect American innovation from a predatory foreign company that has done nothing but buy a patent portfolio and which contributes nothing to American value creation.

IV. MATERIAL OFFICE ERROR FAVORS MERITS REVIEW

The Examiner made multiple material errors when examining the application for the ’509 patent. First, the Examiner failed to filter Zanolitch out of her search results and recognize its pertinence as an anticipatory reference that taught the sole feature allegedly missing from the prior art of record. For example, one search included Zanolitch within a set of 721 results. But the Examiner failed to identify Zanolitch in that set. And, in running narrower searches, the Examiner used classification filters that excluded Zanolitch. Had the Examiner conducted a more careful review of the search results or not used such narrow classification filters, she would have identified Zanolitch. Second, the Examiner overlooked that Kovach, the sole reference applied against the ’509 patent during prosecution, taught the limitation that the Applicant added to the claims to secure allowance. This oversight further shows that the Examiner failed to conduct a thorough analysis and erred in allowing the ’509 patent. Merits review is warranted to correct these errors.

A. The Examiner Failed to Identify Zanolvitch in Her Search Results

Zanolvitch (Ex. 1006) anticipates claims 14-19 and 24-26. (Paper 1 (“Pet.”) 19-33.) In particular, Zanolvitch indisputably discloses the sole limitation that the Applicant added to every independent claim to secure allowance over the prior art: “comparing new content of said monitoring data of a monitored object with prior content of said monitoring data of said monitored object.” (Ex. 1004, 265, 276-87, 373-77.) As the Petition details, Zanolvitch discloses comparing the weight of a carry-on bag at an airplane (“new content of said monitoring data of a monitored object”) with the prior weight of the carry-on bag at a security checkpoint (“prior content of said monitoring data of said monitored object”). (Pet. 24-25; Ex. 1006, 24:34-44 (“a comparison can be made between the weight of a carry-on bag at the security checkpoint and the weight of the carry-on bag at the airplane”).)

Despite that disclosure, the Examiner failed to identify Zanolvitch and thus erred for at least two reasons. **First**, several of the Examiner’s search queries (Ex. 1004, 270-74) would have returned Zanolvitch, including one search (S8) with 721 results—a set of results in which Zanolvitch’s closely analogous airport-security disclosures that are strikingly similar to a core embodiment in the ’509 patent should have stood out. *Cf. Siemens Mobility, Inc. v. Metrom Rail, LLC*, IPR2024-00947, Paper 16 at 1, 10-12 (P.T.A.B. Apr. 4, 2025) (Delegated Director Review) (appearance in an Examiner’s search report does not show that the Examiner viewed

or substantively considered the reference). ***Second***, the Examiner would have located Zanolitch via other search strings that used narrower keywords, but the Examiner filtered those narrower strings by patent classifications that excluded Zanolitch's pre-grant publication.⁴ That the Examiner overlooked Zanolitch in some search results and excluded it from others by using narrow classification filters demonstrates error in the Examiner's prior art searching.

For the ***first error***, the Examiner's search string S8 (among others) would have included Zanolitch. Search string S8 was a combination of strings "S6 and S7" that resulted in 721 results (including Zanolitch). For example, search string S6, "vehicle with track\$" (Ex. 1004, 271), hits Zanolitch's phrase "vehicle tracking" (Ex. 1006, 20:4; Ex. 1018 ¶[0131]). And search string S7, "toll adj2 (gate or booth) or gateway" (Ex. 1004, 271), hits Zanolitch's "[g]ateway" (Ex. 1006, 32:51; Ex. 1018 ¶[0197]). So, Zanolitch would have been within the 721 results for string S8.

The '509 patent primarily describes applications of a monitoring system related to security. (*See, e.g.*, Ex. 1001, 4:16-18, 4:39-45, 5:62-64, 9:22-10:46.) The system can be used in an airport to identify and track a passenger, including to compare the monitoring data for that passenger to determine a change in the

⁴ Zanolitch's pre-grant publication published on November 10, 2005 (Ex. 1006, Cover), before the Examiner ran her prior art searches (Ex. 1004, 270-274).

passenger's baggage. (*See id.*, 9:22-10:46, Fig. 8.) Figure 8 shows an application where a monitored object is passenger 37, John Smith. (*Id.*) At time 1 ($t=T1$), John Smith is at gateway 1 and the identification system determines that he has two bags (#suitcases: 2). (*Id.*) Then at time 2 ($t=T2$), John Smith is at gateway 2 and the identification system determines that he has only 1 bag (#suitcases: 1). (*Id.*) By comparing the current monitoring data from $t=T2$ with the prior monitoring data from $t=T1$, the system determines that #suitcases changed (i.e., John Smith, now with one bag instead of two) and creates a warning message 870 reflecting that changed monitoring data. (*Id.*)

Like the '509 patent's Figure 8 embodiment, Zanolich discloses a system for tracking information associated with passengers in an airport and their baggage. (Ex. 1006, Abstract, 19:49-61; Pet. 10-14.) A passenger can be associated with their baggage, such as when they check in at the airport ticket counter. (Ex. 1006, 20:24-38.) The passenger and baggage are also identified, and an "item tracking module 3912 and passenger tracking module 3914 are updated with the item and passenger identification(s), respectively." (*Id.*, 20:38-41; *see also id.*, 25:22-27.) That baggage information is linked to the passenger in the system's data. (*Id.*, 20:41-44 ("[T]he item tracking module 3912 and passenger tracking module 3914 can store information indicating that 'Passenger X' has 2 checked bags and one carry on."))

As the passenger and his carry-on baggage move through the airport, they are

tracked via a system of threat scanning machines 106 and walk through metal detectors 3950. For example, at the airport security checkpoint, a “walk through metal detector 3950 can be equipped with a passenger identification scanning device” that “forwards information to the passenger tracking module 3914.” (*Id.*, 20:57-67.) And a threat scanning machine 106 “obtains the item tracking identification associated with the scanned baggage and forwards the result of the threat scanning to the item tracking module 3912,” which includes baggage information such as “weight, contents, dimensions, or the like.” (*Id.*, 20:39-56.)

After check-in and security, passengers and their items are subsequently tracked within the airport system. (*See, e.g., id.*, 24:17-26.) The system can also compare current passenger and baggage information to prior information and trigger an alert if a threat is detected (e.g., if a passenger’s carry-on weight changes between two checkpoints). (*See, e.g., id.*, 24:34-46, 25:10-21, 25:27-36.)

Accordingly, Zanolitch is indisputably relevant to the ’509 patent. And based on the similar airport-security-related disclosures in the ’509 patent and Zanolitch, discussed above and detailed in the Petition (*see* Pet. 10-14, 19-33), the Examiner should have recognized Zanolitch’s pertinence and erred by not rejecting the application for the ’509 patent over Zanolitch.

For the *second error*, search string S34 illustrates the problem with the Examiner’s limiting the keywords by narrow classifications. That search string

incorporates numerous keywords and resulted in just 75 results. (Ex. 1004, 273.) Those results would have included Zanolitch if the search was not limited by classification because all the keywords are found in Zanolitch, but its pre-grant publication was not in the searched classifications. (*Compare* Ex. 1004, 273 (searched classifications), *with* Ex. 1018, Cover (listed classifications).) This demonstrates error in the Examiner’s search methodology that resulted in excluding Zanolitch from otherwise narrow keyword search strings.

Search string S34 is a combination of string “S33 and new adj2 (content or information or data or id or identification),” where S33 is in turn a combination of “S32 and S30,” and S32 is a combination of “S31 and S29.” (Ex. 1004, 273.) The keywords in S34 and in each of those underlying search strings hit Zanolitch such that Zanolitch would have been in the search results if not for the classification filter in S31 incorporated into that search that excluded Zanolitch:

- S29 (“object or vehicle or person or item) with track\$”): Zanolitch includes “baggage may be *tracked* and associated with a particular *person*.” (Ex. 1006, 9:22-23 (emphasis added); Ex. 1018 ¶[0067].)
- S30 (“toll adj2 (gate or booth) or gateway or gate or entrance or exit”): Zanolitch includes “entrance.” (Ex. 1006, 24:36; Ex. 1018 ¶[0152].)
- S34 (“S33 and new adj2 (content or information or data or id or identification)”): Zanolitch uses the phrase “*new* risk *information*.”

(Ex. 1006, 25:66 (emphasis added); Ex. 1018 ¶[0158].)

Accordingly, the Examiner erred at least by not running these narrow search strings without limiting them by classification. Had the Examiner done so, Zanolitch would have been in the search results.

B. The Examiner Overlooked Important Teachings in Kovach

During prosecution, the Examiner made a single § 102 rejection over Kovach (Ex. 1023) but found that Kovach did not teach proposed claim 3 (“comparing new content of said monitoring data of a monitored object with prior content of said monitoring data of said monitored object”). (Ex. 1004, 285, 373-77.) Applicant amended all independent claims to include claim 3’s language and secured allowance. (*Id.*, 265, 276-87.) But the Examiner overlooked that Kovach discloses claim 3. Kovach teaches a system that compares a driver’s stored biometric data (“prior content of said monitoring data”) with physically observed biometric data (“new content of said monitoring data”) associated with a monitored vehicle or person (“monitored object”). (Ex. 1023, ¶[0045].) This additional error confirms the Examiner did not perform a careful examination of the prior art and supports referring for merits review. *See TSMC v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 at 3-4 (Director Sept. 3, 2025) (referring petition challenging patent in force for 10 years because examiner erred in finding claim features were not taught by Chien770 reference, even though Chien770 was not cited in the petition).

V. THE FINTIV FACTORS STRONGLY FAVOR INSTITUTION

Google filed this IPR petition as a true alternative to litigation. Indeed, Google filed a declaratory judgment action against Valtrus involving nine other patents (*see* Ex. 1020 ¶1) but challenged the '509 patent solely in this IPR. Valtrus's apparent attempt to avoid IPR by asserting the '509 patent against Google only after the Petition was filed should not be rewarded. (*See* DD Req. 11 (arguing Valtrus's recently filed counterclaims support discretionary denial)). Denying merits review under these circumstances would only encourage such gamesmanship.

A. Factor 1: Stay

Valtrus added the '509 patent to the N.D. Cal. action six weeks ago. (*See* Paper 6 n.1; Paper 7.) Although no stay motion has yet been filed, even without a stay, trial would not occur until over a year after the final written decision.

B. Factor 2: No Trial Date Has Been Set, and the Final Written Decision Will Issue Long Before Any District Court Trial

There is currently no trial date set in the N.D. Cal. action, but trial will almost certainly not occur until over a year after the final written decision in this IPR. The final written decision would be due by August 2027. By contrast, the most recent U.S. Courts Judicial Caseload Profile reports that the Northern District of California's median time from filing to civil trial is 38.9 months (Ex. 1022, 66), putting trial around April 2029 (measured from the January 2026 filing of Google's declaratory-judgment action; July 2029 if measured from Valtrus's April 2026

counterclaims when the '509 patent entered the N.D. Cal. action).

C. Factor 3: The N.D. Cal. Action Is in Its Infancy

Institution is an efficient use of Board resources because the N.D. Cal. action has barely begun. Valtrus added the '509 patent to that action via an April 2026 counterclaim. Nothing substantive has occurred with respect to the '509 patent.

D. Factor 4: Minimal Overlap Supports Merits Review

When Google filed the Petition, there was no litigation between Google and Valtrus involving the '509 patent. Any overlap that could occur is due to Valtrus's gamesmanship in adding the '509 patent to the N.D. Cal. action after Google filed this IPR. There is currently no meaningful overlap because no invalidity contentions, expert reports, or trial positions concerning the '509 patent have been served, and nothing substantive has occurred in the N.D. Cal. action regarding the '509 patent. In any event, Google's *Sotera* stipulation eliminates overlap. (Ex. 1024.) The N.D. Cal. action also concerns only claim 17 (Ex. 1009 ¶31), whereas the Petition challenges several additional claims 14-21 and 24-28. Valtrus's contention that "even if trial is instituted, over a dozen claims . . . will survive" (DD Req. 2) rings hollow because the Petition addresses twelve more claims than are at issue in the N.D. Cal. action.

E. Factor 5: Early FWD Supports Merits Review

With the N.D. Cal. trial likely years away, Board review will likely simplify or eliminate issues long before the district court reaches them.

F. Factor 6: Strong Merits Support Institution

The remaining circumstances favor Board review. The Petition presents focused prior art challenges to claims 14-21 and 24-28 based on prior art that was not identified during prosecution. (*See* Pet. 5-6.) Those challenges include multiple independent grounds, with two anticipation grounds based on Zanolitch and Pederson, plus obviousness grounds using Johnson and Maruya. (*Id.*)

During prosecution, the Applicant amended all claims to incorporate “said analyzer unit facilitates comparing new content of said monitoring data of a monitored object with prior content of said monitoring data of said monitored object,” which the Examiner found allowable over Kovach. (Ex. 1004, 276-86.) Both Zanolitch and Pederson anticipate this limitation, making them particularly compelling prior art. (Pet. 24-25, 50-52.) Those references were not considered during examination and have never been asserted against the ’509 patent, as there has been no prior adjudication or Petition concerning the ’509 patent in any forum.

Valtrus’s tentative antedating theory should be rejected. The Board previously rejected Valtrus’s similar attempt to leverage potential discovery for discretionary denial. *See Google LLC v. Valtrus Innovations Ltd.*, IPR2022-01497, Paper 39 (P.T.A.B. Nov. 7, 2023) (rejecting arguments that IPR discovery procedures could not adequately address Patent Owner’s attempt to antedate prior art). Here, Valtrus does not state that it will seek any specific discovery. Valtrus

merely speculates, for example, that it “may need to seek discovery.” (DD Req. 14.) And even if Valtrus could show diligence starting from the alleged January 2004 invention disclosure, that theory could not dispose of the Pederson-based grounds because Pederson was filed August 22, 2003—before January 2004. (Pet. 5-6; DD Req. 14.) Thus, substantial grounds will remain for Board review.

Valtrus’s merits arguments are weak and should be reserved for the merits panel. Zanolitch discloses “tracking data,” Pederson merges, and there is a motivation to combine with Johnson. For instance, the ’509 patent explains that tracking data can be descriptive information about the tracked object, including “the description of the tracked object, the trajectory of the tracked object, and the unique tracking identifier.” (Ex. 1001, 6:16-24; *see also* Pet. 21-22.) That is precisely in line with Zanolitch’s “tracking data” disclosures. (Pet. 21.) And even if Valtrus prevails on its Johnson argument, Grounds 1 and 3 are anticipation grounds based on Zanolitch and Pederson, respectively, so Valtrus’s criticism of the Johnson motivation-to-combine rationale is irrelevant to those grounds which cover all challenged claims. (Pet. 3, 19, 43.)

Valtrus also exaggerates and mischaracterizes the Petition’s reliance on Mr. Williams to allegedly “close gaps” and to establish motivation to combine references with Johnson. (DD Req. 15-18.) Expert testimony is expressly permitted in IPRs to explain the teachings of the prior art, what those teachings would have

conveyed to a POSITA, whether a POSITA would have had reason to combine references, and whether there would have been a reasonable expectation of success. The Petition stays within those bounds. Both the Petition and Mr. Williams provide a detailed explanation of the motivation to combine with evidentiary support. *See, e.g.*, Pet. 39-40, 61-63 (citing Ex. 1002); *see also Intel Corp. v. Qualcomm Inc.*, 21 F.4th 784, 797-99 (Fed. Cir. 2021) (rejecting the Board’s conclusion that an efficiency rationale was too generic where expert testimony explained how and why a skilled artisan would have combined prior art teachings).

VI. XXVI HOLDINGS AND ALPHABET ARE NOT RPIS

Valtrus offers no evidence that XXVI Holdings Inc. or Alphabet Inc. controlled, funded, directed, or had the opportunity to control this IPR. Google disclosed its corporate parentage and stated that neither XXVI Holdings Inc. nor Alphabet Inc. is a real party-in-interest. (Pet. 2 n.2.) And neither XXVI Holdings Inc. nor Alphabet Inc. is time-barred—if they had an interest in this proceeding they could have simply joined as co-petitioners. Nor are they parties in the N.D. Cal. litigation such that avoiding estoppel could provide a benefit. There was simply no reason for Google to misrepresent their status and Valtrus gives no basis for the Director to find Google’s disclosure was inaccurate.

VII. CONCLUSION

For the foregoing reasons, Google respectfully requests merits review.

Respectfully submitted,

Dated: May 26, 2026

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CERTIFICATE OF SERVICE

I certify that I caused to be served on the counsel identified below a true and correct copy of the foregoing Petitioner's Discretionary Denial Opposition by electronic means on May 26, 2026:

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