UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC and UBER FREIGHT US LLC,
Petitioners

v.

CARMA TECHNOLOGY, LTD.,
Patent Owner

IPR2026-00306

Patent No. 10,916,138

PETITIONERS' REQUEST FOR DIRECTOR REVIEW

TABLE OF CONTENTS

I. Introduction 1

II. Background 2

- **A. The Director's Discretionary Denial Decision** 2
- **B. The Venue Ruling Removed the Continuation Patents** 3
- **C. The Claim Construction Order** 3

III. Argument 7

- **A. The Removal of the Continuation Patents from the Parallel EDTX Litigation Favors Vacatur of the Discretionary Denial** 7
- **B. Every *Fintiv* Factor Now Favors Institution** 9
- **C. Olmi-based Error Warrants Merits Review Under *Padagis* and *Magnolia*** 12
- **D. Carma's Dormancy Defeats Any Settled Expectations Defense** 13

IV. Conclusion 14

TABLE OF AUTHORITIES

Cases ..... Page(s)

Arm Ltd. v. Daedalus Prime LLC,
IPR2025-00207, Paper 14 (Director Aug. 6, 2025) 7

Entegris, Inc. v. Inpria Corp.,
IPR2025-00267, Paper 21 (Director Oct. 31, 2025) 7, 8

Epic Games, Inc. v. IngenioShare, LLC,
IPR2022-00291, Paper 10 (P.T.A.B. May 24, 2022).....9

Magnolia Medical Technologies, Inc. v. Kurin, Inc.,
IPR2026-00097, Paper 17 (Director May 14, 2026).....12, 13

NeuMoDx Molecular, Inc. v. HandyLab, Inc.,
IPR2020-01133, Paper 23 (P.T.A.B. Aug. 6, 2021) 11

Padagis US LLC v. Neurelis, Inc.,
IPR2025-00464, Paper 12 (Director July 16, 2025) 12

Statutes

35 U.S.C. § 315(a)(2).....9

Other Authorities

37 C.F.R. § 1.56.....12

M.P.E.P. §§ 2001.05–.06.....12

LIST OF EXHIBITS

Ex. No.	Description	Previously Submitted
EX1001	U.S. Patent No. 10,916,138 ("the '138 patent")	X
EX1002	Declaration of Dr. Petros Ioannou, Ph.D.	X
EX1003	Curriculum Vitae of Dr. Petros Ioannou, Ph.D.	X
EX1004	Prosecution History of U.S. Patent App. No. 16/670,220	X
EX1005	UK Patent Application No. GB2397683A to Olmi ("Olmi")	X
EX1006	U.S. Patent No. 6,411,897 to Gaspard ("Gaspard")	X
EX1007	U.S. Patent Application Publication No. 2002/0123917 to Wolfe ("Wolfe")	X
EX1008	Joint P.R. 4-3 Statement (Dkt. Nos. 95, 95-1, 95-2) in *Carma Technology, Corp. v. Uber Technologies, Inc.*, Case No. 2:25-cv-00029 (E.D. Tex. Feb. 10, 2026)	X
EX1009	RESERVED	
EX1010	U.S. Patent Application Publication No. 2003/0040944 to Hileman ("Hileman")	X
EX1011-EX1012	RESERVED	
EX1013	U.S. Patent No. 7,366,522 to Thomas ("Thomas")	X
EX1014	RESERVED	

EX1015	Prosecution History of U.S. Patent No. 7,840,427	X
EX1016 – EX1029	RESERVED	
EX1030	U.S. Patent Application Publication No. 2001/0037174 to Dickerson ("Dickerson")	X
EX1031	U.S. Patent Application Publication No. 2003/0036935 to Nel ("Nel")	X
EX1032	International Patent Publication No. WO 2005/104059 A2 to Bhushan ("Bhushan")	X
EX1033	U.S. Patent No. 5,799,263 to Culbertson ("Culbertson")	X
EX1034	"A distributed geographic information system for the daily car pooling problem," Roberto Wolfler Calvo et al. Computers & Operations Research 31 (2004) 2263-2278 ("Calvo")	X
EX1035	U.S. Patent No. 10,520,325 to Lewinson ("Lewinson")	X
EX1036	Prosecution History of European Patent App. No. EP08725447A	X
EX1037	Email Chain Between Francis Hand and Jay Choi, Re: Letter re. Carma Technology (Nov. 14–30, 2016).	X
EX1038	Email Chain Between Lawrence Mulligan and Jay Choi, Re: Patent Violation — United States Patent 7,840,427 (Nov. 29, 2017–Feb. 14, 2018).	X

EX1039	Email Chain Between Jay Choi and Lawrence Mulligan, Re: Carma United States Patent 7,840,427 Carma-Uber (Apr. 2–May 21, 2018).	X
EX1040	Email Chain Between Joe Hurd and Dianna Jones, Re: Joe Hurd Follow Up (July 11–18, 2024).	X
EX1041	Email Chain Between Sean O'Sullivan, Ryan Rzepecki, and Parham Ghods, Re: Can you pass something like this along to Parham Ghods? (May 29–June 6, 2024).	X
EX1042	Email Chain Between Sean O'Sullivan, Shawn Carolan, and Andrew Macdonald, Re: Hey, it's been a while since we chatted . . . looking for an intro . . . (June 19–20, 2024).	X
EX1043	Letter from Mark N. Reiter, Gibson, Dunn & Crutcher LLP, to Gareth DeWalt, Bunsow De Mory LLP, Re: *Carma Tech., Corp. et al. v. Uber Techs., Inc. et al.*, No. 2:25-cv-00029 (E.D. Tex.): Notice of Sotera Stipulation (Apr. 30, 2026).	X
EX1044	Defendants' Answer to First Amended Complaint for Patent Infringement, *Carma Tech. Corp. v. Uber Techs., Inc.*, No. 2:25-cv-00029-JRG-RSP (E.D. Tex. May 1, 2026), ECF No. 126.	X
EX1045	Joint P.R. 4-5 Statement, *Carma Tech. Corp. v. Uber Techs., Inc.*, No. 2:25-cv-00029-JRG-RSP (E.D. Tex. Apr. 20, 2026), ECF No. 117.	X
EX1046	Docket Report, *Carma Tech. Corp. v. Uber Techs., Inc.*, No. 2:25-cv-00029-JRG-RSP (E.D. Tex. June 14, 2026).	X

EX1047	Prosecution History of U.S. Patent Application No. 17/155,221.	X
EX1048	Admin. Off. of the U.S. Courts, Federal Court Management Statistics: U.S. District Court — Judicial Caseload Profile (12-Month Period Ending Mar. 31, 2026).	X
EX1049	Report and Recommendation, Dkt. No. 305 (Aug. 27, 2026)	
EX1050	Claim Construction Order, Dkt. No. 303 (Aug. 27, 2026)	
EX1051	Amended Docket Control Order, Dkt. No. 328 (Sept. 3, 2026)	
EX1052	Order Setting Hearing re Motions, Dkt. No. 304 (Aug. 27, 2026)	
EX1053	Summary Judgment Motion, Dkt. No. 335 (Sept. 10, 2026)	

I. Introduction

Petitioners Uber Technologies, Inc. and Uber Freight US LLC ("Petitioners") request Director Review of the July 14, 2026 denials of institution in IPR2026-00306, -00307, -00308, and -00309 ("Petitions").[1] On August 27, 2026, Magistrate Judge Roy S. Payne issued a Report and Recommendation ("R&R") that fundamentally alters the parallel litigation landscape: it recommended dismissal of Uber Technologies, Inc. ("UTI") and Uber Freight Holding Corporation ("UFHC"). *See* EX1049 at 7–13. As a result, ***the patents addressed by the Petitions—the '138, '456, '668, and '071 patents, which the district court referred to as the "Continuation Patents"—are no longer at issue in that litigation***. *See* EX1050 at 1–2; EX1053 at 2. This leaves only the '427 patent, which is not at issue in the Petitions, asserted against remaining defendant Uber Freight US LLC ("UFUS")—and even that patent is subject to a pending case-dispositive motion for summary judgment of non-infringement. *See* EX1053 at 2. Accordingly, any predicate for *Fintiv*-based discretionary denial no longer exists.

Without the parallel litigation, the public interest weighs strongly in favor of institution. The Petitions present Olmi-based invalidity grounds that Carma elected

[1] The patents are 10,916,138 ("'138 patent"), 11,164,456 ("'456 patent"), 11,017,668 ("'668 patent"), and 10,741,071 ("'071 patent"), challenged respectively in IPR2026-00306, IPR2026-00307, IPR2026-00308, and IPR2026-00309. Petitioners are not seeking Director Review of IPR2026-00305 challenging 7,840,427 ("the '427 patent").

not to rebut, having declined to file a Patent Owner Preliminary Response in any of these proceedings. Olmi is a reference the EPO brought to Carma's attention and twice relied upon to reject claims in a European counterpart application, which Carma ultimately abandoned without overcoming Olmi. Yet, Carma never disclosed Olmi to the Office during prosecution of the Continuation Patents, and the Office did not independently locate it. It was not until examination of a subsequent continuation application that Olmi was located and applied in a rejection, which Carma overcame only by adding a limitation absent from any of the challenged claims.

Vacatur and institution are therefore warranted.

II. Background

A. The Director's Discretionary Denial Decision

On March 12, 2026, the Petitions were filed by Petitioners UTI and UFUS, with UFHC identified as a real party-in-interest. Paper 1. On July 14, 2026, the Director denied institution "after review of discretionary and non-merits considerations." Paper 9. The denial likely rested on the parallel EDTX litigation—*Carma Technology, Corp. v. Uber Technologies, Inc.*, No. 2:25-cv-00029 (E.D. Tex.)—which at the time involved three defendants (UTI, UFHC, and UFUS), all challenged patents, and a November 2, 2026 trial date.

B. The Venue Ruling Removed the Continuation Patents

On August 27, 2026, Magistrate Judge Roy S. Payne issued the R&R recommending dismissal of UTI and UFHC for improper venue under § 1406(a), leaving UFUS as the only defendant. EX1049 at 7–13. Because Carma is not asserting the ’138, ’456, ’668, and ’071 patents against UFUS, those patents will no longer be at issue. *See also* EX1053 at 2. Accordingly, the R&R’s recommendation eliminates the parallel EDTX litigation for the Continuation Patents challenged here.

C. The Claim Construction Order

On the same day, the court issued a Claim Construction Order. EX1050. For terms where the parties reached agreement, the Claim Construction Order adopted those constructions. EX1050 at 6–7. As for the disputed terms, the Claim Construction Order construed two limitations that are present only in the ’427 patent, and three limitations that are present only in the Continuation Patents. EX1050 at 7–26. For those latter limitations, Petitioners explain below how the court’s constructions are consistent with, or broader than, the Petitions’ proposed constructions.[2]

[2] Petitioners disagree with the constructions adopted by the district court and maintain that the narrower constructions they proposed are correct.

For "shared transport system," the court adopted a construction that rejected Petitioners' narrower "server" requirement and declined to adopt a disclaimer made during prosecution of the '427 patent. *Compare* Pet. at 6–12 *with* EX1050 at 22–23.

Petition Construction	**Claim Construction Order**
A server system that matches transport users with transport providers traveling an existing route defined before demand for transport and independently of a transport user's door-to-door trip	a network system that matches the supply and demand of transportation services by incorporating unused transportation capacity (i.e., empty seats) with a real-time allocation and matching service that enables individuals and goods to conveniently hire that capacity with attractive pricing, rapid responsiveness, better information availability and trusted security

The court rejected two limitations that the Petitions had proposed—(1) the court declined to impose a "server" requirement, and (2) the court declined to apply the '427 patent's prosecution history disclaimer concerning predetermined routes to the Continuation Patents—while adopting others. EX1050 at 20–22. Olmi satisfies each element of the construction the court adopted. Olmi discloses "a network

system" because its "central controlling computer system" communicates via a "data transmission system" with passenger and driver devices. EX1005 at 13, 29–31. The Olmi system "matches the supply and demand of transportation services" because it "intelligently groups travellers with compatible itineraries onto the same…transit vehicle." *Id.*, Abstract, 15–18, 35–38. It "incorporat[es] unused transportation capacity (i.e., empty seats)" because the intelligent grouping module matches passengers only with vehicles having "a sufficient quantity of available passenger places." *Id.*, 35–36. And it provides "real-time allocation and matching service" because it uses "real-time" data transmissions and provides passengers with "real-time" vehicle arrival countdowns. *Id.*, 44.

Olmi's system also provides a "matching service that enables individuals and goods to conveniently hire that capacity with attractive pricing, rapid responsiveness, better information availability and trusted security," because Olmi discloses (a) "conveniently hiring" via communicator devices (cell phones, PDAs), *id.*, 14; (b) "attractive pricing" through "automatic fare charging," *id.*, 79; (c) "rapid responsiveness" because "the controlling computer system will marshal a fast response that has a transit vehicle arrive to collect the traveller," *id.*, 18; (d) "better information availability" including pickup, destination, vehicle type, luggage requirements, time, and speed, *id.*, 44, 85–87, FIG. 8; and (e) "trusted security" because "the controlling computer system could monitor car pool journeys in real

time" and identify any "deviation from the intended route," *id.*, 83. *See also* Pet. at 17–23; EX1002 ¶¶ 57–70. Accordingly, the Petitions satisfy the court's construction of "shared transport system."

For "transport provider," the court rejected Petitioners' narrower construction based on a disclaimer made during the '427 patent's prosecution and broadly construed the term to mean "a driver providing transportation." *Compare* Pet. at 12–13 *with* EX1050 at 25–26.

Petition Construction	**Claim Construction Order**
A driver offering transport along an existing route defined before demand for transport and independently of a transport user's door-to-door trip	a driver providing transportation

Because the Petitions mapped Olmi to the narrower construction, Olmi's disclosures satisfy the court's broader construction.

For "pick-up location" and "drop-off location," the court adopted the plain and ordinary meaning of these terms and rejected Petitioners' narrower construction based on a disclaimer made during the '427 patent's prosecution. *Compare* Pet. at 13–14 *with* EX1050 at 23–24.

Petition Construction	**Claim Construction Order**
A node along an existing route defined before demand for transport and independently of a transport user's door-to-door trip	Plain and ordinary meaning

Because the Petitions mapped Olmi to the narrower construction, Olmi's disclosures satisfy the court's broader construction.

For the '138 patent's "provider characteristics," the parties agreed to adopt Petitioners' proposed construction. *Compare* Pet. at 14–16 *with* EX1050 at 7. The parties also adopted Petitioners' construction of the '668 patent's "anomalous condition" limitation. EX1050 at 7.

III. Argument

A. The Removal of the Continuation Patents from the Parallel EDTX Litigation Favors Vacatur of the Discretionary Denial

The Continuation Patents are no longer at issue in the parallel EDTX litigation, thereby eliminating any parallel litigation rationale for discretionary denial. This posture is analogous to *Arm* and *Entegris*, where the Acting Director vacated discretionary denials after the parallel litigations were dismissed. *See, e.g., Arm Ltd. v. Daedalus Prime LLC*, IPR2025-00207, Paper 14 (Director Aug. 6, 2025)

(vacating denial of institution after parallel litigation was dismissed); *Entegris, Inc. v. Inpria Corp.*, IPR2025-00267, Paper 21 (Director Oct. 31, 2025) (same).

The continued litigation of the ’427 patent against UFUS does not distinguish those cases. The ’427 patent is a different patent with different claims—a distinction the district court’s Claim Construction Order recognizes by treating the ’427 patent and the “Continuation Patents” separately. EX1050 at 1–2. Moreover, the patents were asserted against different entities with different businesses: at the time the R&R issued, Carma was asserting the ’427 patent, but not the Continuation Patents, against UFUS in connection with its freight services. EX1053 at 2. Petitioners are not seeking Director Review of the ’427 patent IPR (IPR2026-00305), further confirming the separation between the two sets of proceedings. There is therefore no duplicative proceeding as to the Continuation Patents, and the continued ’427 litigation provides no basis for discretionary denial.

Nor does the possibility of objections and *de novo* review of the R&R counsel against vacatur and institution. The R&R rests on jurisdictional facts—UTI has no regular and established place of business in the Eastern District of Texas, and UFHC is a holding company with no operations—that no objection can alter. EX1049 at 7–13. The Director need not await final resolution of every district court proceeding to act on materially changed circumstances. And to the extent the Continuation

Patents are relitigated in a different forum, trial in any such action would not occur until well after any PTAB final written decision—eliminating any *Fintiv* concern.

Because the parallel litigation that presumably formed the basis for discretionary denial no longer exists as to the Continuation Patents, and no foreseeable proceeding could give rise to a *Fintiv* concern, vacatur and institution are warranted.

B. Every *Fintiv* Factor Now Favors Institution

The R&R substantially shifts the *Fintiv* factors in favor of institution. *See, e.g., Epic Games, Inc. v. IngenioShare, LLC,* IPR2022-00291, Paper 10 at 33–34 (P.T.A.B. May 24, 2022) (finding patent owner's *Fintiv* arguments moot after a district court granted petitioner's motion to dismiss for improper venue).

Factor 1 (Stay). Under the R&R, the Continuation Patents are no longer at issue in the parallel EDTX case. To the extent any new district court action is filed, the likelihood of a stay pending these IPRs would be high if not automatic. *See* 35 U.S.C. § 315(a)(2).

Factor 2 (Trial Date). Under the R&R, there is no scheduled trial date involving the Continuation Patents. Even for the remaining '427 patent, the EDTX trial timeline has shifted from November 2, 2026, to January 11, 2027. EX1051. On August 27, 2026, the district court also ordered the parties to be prepared to discuss additional modifications to the Docket Control Order, "including the pretrial

conference schedule and trial date," in light of pending motions and the recently entered Claim Construction Order. EX1052 at 1–2. And to the extent a new case is filed involving the Continuation Patents, any trial would almost certainly occur years after any final written decision in the IPR proceedings. Accordingly, Factor 2 strongly favors institution.

Factor 3 (Investment). Any investment in the EDTX action is irrelevant to the Continuation Patents given the R&R's recommendation for dismissal of the defendants against whom those patents were asserted. UFUS remains in the case solely on the '427 patent, which is not at issue in these Director Review requests. Any new action would have zero court or party investment. Accordingly, there is no investment that could weigh against institution under Factor 3.

Factor 4 (Overlap). The dismissal impacting the Continuation Patents eliminates overlap between the parallel EDTX litigation and these IPRs. Although the parent '427 patent is still being litigated, none of the construed '427 patent terms appear in the Continuation Patents. The '427 patent is a different patent with different claims, and the district court's Claim Construction Order likewise recognized the differences between the '427 patent and the "Continuation Patents." EX1050 at 1–2. Nor would any newly filed proceeding with no schedule create the kind of overlap that *Fintiv* contemplates. Accordingly, Factor 4 weighs strongly in favor of institution.

Factor 5 (Parties). Under the R&R, UTI and UFHC will be dismissed and the parallel EDTX case will no longer involve the Continuation Patents. UFUS remains in the parallel EDTX litigation solely on the ’427 patent, which is not at issue in these Director Review requests. To the extent any new action arises involving the same parties and the Continuation Patents, this would be insufficient to support discretionary denial where the remaining *Fintiv* factors favor institution. *See, e.g., NeuMoDx Molecular, Inc. v. HandyLab, Inc.*, IPR2020-01133, Paper 23 at 13–14 (P.T.A.B. Aug. 6, 2021) (“The parties in this proceeding are identical to the parties in the parallel litigation. Because the final written decision in this case will issue before trial in the parallel litigation, this factor weighs against exercising discretion to deny institution.”). Accordingly, Factor 5 weighs decisively in favor of institution.

Factor 6 (Merits). As explained below, the Petitions present compelling Olmi-based grounds that demonstrate the material error in overlooking Olmi during prosecution. *See also* Paper 8 at 6–12. The court’s claim construction rulings only strengthen those grounds. Each construction is consistent with, or broader than, the Petitions’ proposed constructions, and Olmi satisfies the limitations under the court’s broader interpretations. The strength of the merits therefore weighs decisively in favor of institution under Factor 6.

C. Olmi-based Error Warrants Merits Review Under *Padagis* and *Magnolia*

The material error is that the Continuation Patents issued without the Office considering Olmi. Paper 8 at 6–12; *see also Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, at 2–3 (Director July 16, 2025) (informative) (material error by the Office weighs against discretionary denial). The Petitions present Olmi-based grounds that directly address that omission, and Carma elected not to file a Patent Owner Preliminary Response to rebut those grounds. Following the R&R, there is no proceeding in any forum examining the validity of the Continuation Patents. The public interest in the Office correcting its own error, and the absence of any PO response disputing Olmi's relevance, warrant merits review.

The EPO identified Olmi (UK Patent Application No. GB2397683A) as an "X" reference relevant to claims 1–17 of EP08725447A, twice rejected materially similar family claims over Olmi, and found Carma's attempted distinctions "not . . . convincing." EX1036 at 214, 218, 220, 253–58. Carma ultimately abandoned the EP application without overcoming Olmi. EX1036 at 266. Yet Carma did not disclose Olmi during prosecution of the Continuation Patents at issue here, despite the EPO rejection, implicating the duty to disclose material information from foreign counterpart prosecution. *See* 37 C.F.R. § 1.56; M.P.E.P. §§ 2001.05–.06. The Office failed to find Olmi in the EPO prosecution file or through regular searching. After the Continuation Patents issued, the material error was corroborated by how a U.S.

Examiner independently found and applied Olmi in Continuation Application No. 17/155,221, and Carma overcame that rejection only by adding a deviation detection feature absent from the challenged claims. EX1047 at 59–61, 91.

In view of the Olmi-based issues discussed above, the Office should review Petitioners' Olmi-based challenges "to determine whether the patent at issue may have been improvidently granted and whether and to what extent that right should continue to be recognized at all." *Magnolia Medical Technologies, Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 7 (Director May 14, 2026) (precedential). Declining review would invert *Magnolia* by treating the absence of any other merits forum as a reason not to conduct Office review. The public interest is best served by allowing the Office to consider the Olmi-based grounds rather than leaving the Continuation Patents tainted by the omission of material prior art.

D. Carma's Dormancy Defeats Any Settled Expectations Defense

Carma's prolonged dormancy favors institution. *See also* Paper 8 at 3–6. From 2016 to 2018, Carma accused UTI of infringing the '427 patent, its only issued patent at the time. UTI met with Carma, responded in writing with detailed non-infringement positions, and invited further discussion. EX1037–EX1039. Carma then went silent for more than six years before filing suit in January 2025, even as it continued prosecuting continuation applications that later matured into the Continuation Patents challenged here. EX1040–EX1042; EX1046. By that time,

those Continuation Patents had long since issued: the ’071 patent in August 2020, the ’138 patent in February 2021, the ’668 patent in May 2021, and the ’456 patent in November 2021. The Petitions were filed in March 2026, before any of the Continuation Patents reached six years of age. *See also* Paper 8 at 12–13.

The R&R reinforces the point: after more than six years of silence, Carma chose to sue in a district where, as the R&R found, UTI “has no regular and established place of business.” EX1049 at 11–12. That Carma’s belated enforcement effort was filed in an improper venue only underscores that institution would not disrupt any settled expectations.

IV. Conclusion

For the foregoing reasons, Petitioners respectfully request that the Director vacate the discretionary denials in IPR2026-00306, -00307, -00308, and -00309 and institute the Petitions.

Dated: September 11, 2026

By: / Naveen Modi /
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CERTIFICATE OF SERVICE

I hereby certify that on September 11, 2026, I caused a true and correct copy of the foregoing Petitioners' Request for Director Review and supporting exhibits to be served by electronic means on the counsel identified below:

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