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

IPR2026-00308

Patent No. 11,017,668

PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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I. Introduction

Carma's request for discretionary denial of the petitions for *inter partes* review of the challenged patents should be denied.[1]

First, the parties' pre-suit history weighs against denial. From 2016 to 2018, Carma accused Uber of infringing the '427 patent—Carma's only issued patent at the time. Uber met with Carma to discuss Carma's allegations and responded in writing with non-infringement positions. EX1037–EX1039. Despite Uber offering to continue the dialogue, Carma went silent and let the matter lie dormant for more than six years before filing suit in 2025—all while filing continuation applications in the same family that matured into the other four patents that Carma later asserted against Uber and Uber challenged in parallel IPR petitions. EX1040–EX1042; EX1046. Carma's hiatus supports Uber's settled expectation that Carma would not assert the '668 patent against Uber and undercuts Carma's broader claim that review of this patent would be unfair or disruptive.

Second, the grounds in these proceedings use Olmi (GB2397683A) as the primary reference to present an objectively corroborated Office error. After the '427 patent issued, Carma failed to overcome Olmi during counterpart European

[1] The challenged patents are U.S. Patent Nos. 7,840,427 ("the '427 patent"), 10,916,138 ("'138 patent"), 11,164,456 ("'456 patent"), 11,017,668 ("'668 patent"), and 10,741,071 ("'071 patent"), challenged respectively in IPR2026-00305, IPR2026-00306, IPR2026-00307, IPR2026-00308, and IPR2026-00309. *See also* DD Req. 11 n.1

Patent Office (EPO) prosecution of the corresponding EP application. The Office did not independently identify or consider Olmi during prosecution of the '427 patent, and ***Carma did not disclose Olmi to the Office*** during prosecution of the later-issued challenged patents, including the '668 patent. EX1036; EX1047. A later U.S. examiner independently found and applied Olmi in a family continuation after the challenged patents had been issued, further corroborating Olmi's significance. EX1047, 91. That incomplete examination record indicates that the '668 patent, as well as the related challenged patents, presents a substantial Office error issue favoring merits review.

Third, the challenged patents lack settled expectations. The '668 patent issued within the past six years and is unpatentable over Olmi. Additionally, Carma did not assert the '668 patent, or any related patents, after Uber's 2018 non-infringement response regarding the '427 patent and instead remained silent until 2025, when Carma filed the Carma Litigation. EX1037–EX1042; EX1046. Accordingly, Carma cannot be surprised that Uber has now filed this petition.

Fourth, the Carma Litigation does not alter the conclusion favoring merits review. As discussed further below, discretionary denial is unwarranted here despite the current trial schedule because the Carma Litigation remains in a fluid posture: Uber's motion to dismiss for improper venue or transfer under 28 U.S.C. § 1406(a) remains unresolved. EX1046.

For all these reasons, the Petition should be referred for merits review.

II. Pre-Suit Negotiation History Supports Uber's Settled Expectations

A substantial period of dormancy after pre-suit contact supports petitioner's settled expectations. *See Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11, at 2-3 (Director Sept. 5, 2025) (informative) (declining discretionary denial where petitioner had been contacted about the patent and patent owner did not sue until eleven years after the parties' discussion); *cf. DataDome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, Paper 14 (Director Aug. 14, 2025) (granting discretionary denial where patent owner asserted the patent two years after the parties' discussion).

Starting in August 2016, Carma accused Uber of infringing the '427 patent. DD Req. 1; EX1037.[2] Uber responded in November 2016 that it did not believe its services infringed the '427 patent. EX1037. When Carma renewed its allegations in November 2017, Uber requested a claim chart or other explanation of Carma's infringement theory. EX1038. Carma then supplied a claim chart, screenshots, and a summary asserting that Uber allegedly infringed the '427 patent whenever it matched one or more passengers with an Uber driver at a suggested pick-up or drop-off location. EX1038. Uber representatives then met with Carma representatives on February 26, 2018. EX1038. Between April 2-4, 2018, Carma requested a

[2] "DD Req." refers to Carma's Discretionary Denial Request. *See* Paper 7.

follow-up call, Uber offered one, and Carma said it would coordinate internally and get back to Uber—but never did. EX1039. On May 21, 2018, Uber followed up and explained in writing why it believed its services did not infringe, including because Uber's services are dynamic and do not use the claimed "predetermined transport vehicle journey." EX1039, 1. Uber also invited Carma to contact Uber with any questions or to discuss the matter further. EX1039, 1. Carma did not challenge Uber's explanation, accept Uber's invitation, or otherwise indicate that it still believed Uber infringed. EX1039. Instead, Carma went silent for more than six years before filing suit. EX1040–EX1042; EX1046.

After those discussions ended, Carma obtained the other four challenged patents, including the '668 patent, between 2020 and 2021. In mid-2024, Carma contacted Uber business personnel regarding a possible license or acquisition of its portfolio, but did not identify any infringement accusation, did not allege that Uber infringed, did not identify any patents, and did not respond to follow-up correspondence from Uber's legal team. EX1040–EX1042. Carma then filed the lawsuit asserting the challenged patents in early 2025. EX1046.

Those facts align closely with those in *Allani*. In *Allani*, the Director referred petitions to the Board despite patent age because the patent owner waited eleven years after earlier patent discussions to sue. *Allani* at 3. Similarly, here, Uber did not ignore Carma's accusation; it responded on the merits, requested supporting

detail, met with Carma, and explained why it believed its services did not infringe. EX1037–EX1039. Carma then allowed the dispute to lie dormant for over six years before filing suit in 2025. EX1040–EX1042; EX1046. Under those circumstances, Uber reasonably developed the settled expectation that Carma would not pursue a patent infringement suit, and Carma cannot plausibly claim unfair surprise or disruption from PTAB review now.

Carma argues that citations to Carma or O'Sullivan publications in Uber's own patent prosecution records support settled expectations favoring denial. DD Req. 1, 8–10. Not so. At most, those records show that certain Carma or O'Sullivan publications were considered in the context of Uber's own patent filings and that Uber fulfilled its disclosure obligations. But that does not show the materials were relevant to Uber's activities alleged by Carma, nor that Uber should have anticipated Carma's patent suit and preemptively filed IPRs, especially in light of the parties' pre-suit communications. Uber responded to Carma's express accusation on the merits, requested and reviewed claim charts, met with Carma, explained why Uber's services did not infringe, and invited further discussion; Carma then remained silent for more than six years. EX1037–EX1042. Under *Allani*, that dormancy—not the mere appearance of patent publications in prosecution records—drives the fairness and settled expectations analysis.

Nor does Uber's petition timing warrant denial. Carma argues that Uber waited until near the statutory bar to file its petitions. DD Req. 1–2, 11–12. But Uber filed timely petitions within the statutory period after Carma asserted five patents from a complex continuation family.

III. The Office Did Not Consider Olmi During Prosecution of the Challenged Patents

The Office has explained that, even where other discretionary considerations point toward denial, review remains appropriate when the petition appears to show a material Office error such that review is an appropriate use of Office resources. *See Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, at 2–3 (Director July 16, 2025) (informative). That principle applies here.

The material error is that the challenged patents, including the '668 patent, were issued without the Office considering Olmi. After the '427 patent issued, similar claims of the corresponding European application were rejected in view of Olmi. Not only did Carma fail to disclose Olmi to the Office during subsequent prosecution of the challenged patents, including the '668 patent, but a U.S. examiner independently found and applied Olmi to reject another continuation application after the challenged patents had already been issued. EX1036; EX1047, 91.

In the European search report, the EPO identified Olmi as an "X" reference relevant to claims 1–17. EX1036, 214. During EPO prosecution, the EPO identified

Olmi (D1, GB2397683A) as the primary reference and expressly found that Olmi "discloses all the features of claim 1," rendering claim 1 "not novel." EX1036, 218, 220. On July 31, 2012, the EPO again identified Olmi as D1, treated it as the closest prior art, and mapped Olmi to similar family claim features, including the shared transport system, capacity registry, nodes, demand registry, journey-to-nodes abstraction, and matching engine. EX1036, 253, 255–256. The EPO also considered Carma's attempted distinctions, found them "not . . . convincing," and concluded that it was "not at present apparent" what part of the application could support a new allowable claim. EX1036, 257–258. The EPO proceeding then closed with no further amendments or arguments from Carma to address Olmi. EX1036, 266.

That prosecution history is directly relevant to the claims challenged here. The amended claims in the EPO application recited the foundational claim architecture from which the challenged U.S. claims developed: a shared transportation method employing a ground transportation network or shared transport system, electronic registries of capacity and demand, a network of nodes, and a matching engine that matches capacity with demand between nodes. The following table comparing claim 1 of the '427 patent and the amended claims in the related EPO proceeding illustrates that overlap. EX1001; EX1036.

U.S. '427 Patent Claim 1	**EPO Claims 1-2 on 09/15/2009 (EX1036, 186)**	**EPO Claim 1 on 05/25/2012 (EX1036, 227)**
"A **method of sharing transportation** employing a **ground transportation network** comprising the steps of"	Claim 1: "A **method**, performed by a **ground transportation network** (11, 12), **of sharing transportation**, the method comprising the steps of"	Claim 1: "A **method**, performed by a **shared transport system** (11, 12), **of sharing transportation**, the method comprising the steps of"
"providing a computer network; establishing **an electronic registry** in said computer network **of capacity containing an indication of spare transport capacity and location of a plurality of transport vehicles**;"	Claim 1: "providing (723) **an electronic registry of capacity containing an indication of spare transport capacity and location of a plurality of transport vehicles**,"	Claim 1: "providing (723) **an electronic registry of capacity containing an indication of spare transport capacity and location of a plurality of transport vehicles**,"
"**establishing a network of nodes** in said computer network representing a plurality of **pick-up points** and a plurality of **drop-off points**;"	Claim 1: "**establishing a** shared transport **network of nodes** (803-806) which are **pick-up** or **drop-off points**,"	Claim 1: "**establishing a** shared transport **network of nodes** (803-806) which are **pick-up** or **drop-off points**,"

"**abstracting** a **geographic representation of a** predetermined **transport vehicle journey by calculating places where** said predetermined **transport vehicle journey intersects said nodes and representing said predetermined transport vehicle journey in the format of a set of said nodes**;"	Claim 2: "**abstracting geographic representation of a transport vehicle journey** to nodes (803-806) of said network **by calculating places where** a **transport vehicle's** (16-18) **journey intersects nodes** of said network **and representing the journey in the format of a set of nodes**,"	Claim 1: "**abstracting geographic representation of a transport vehicle journey** to nodes (803-806) of said network **by calculating places where** a **transport vehicle's** (16-18) **journey intersects nodes** of said network **and representing the journey in the format of a set of nodes**;"
"**providing an electronic registry** in said computer network **of demand containing an indication of the demand for transportation needs of a plurality of transport users**;"	Claim 1: "**providing** (723) **an electronic registry of demand containing an indication of the demand for transportation needs of a plurality of transport users**;"	Claim 1: "**providing** (723) **an electronic registry of demand containing an indication of the demand for transportation needs of a plurality of transport users**;"

"**effecting a match in a match engine** in said computer network **of said transport capacity of at least one transport vehicle in said electronic registry of capacity with said transport demand** for a journey **of at least one transport user in said electronic registry of demand for transport between at least two of said nodes**."	Claim 1: "**a matching engine** (701) **effecting a match of said transport capacity of at least one transport vehicle** (16-18) **in said electronic registry of capacity with said transport demand of at least one transport user** (13) **in said electronic registry of demand for transport between at least two of said nodes** (803-806)."	Claim 1: "**a matching engine** (701) **effecting a match of said transport capacity of at least one transport vehicle** (16-18) **in said electronic registry of capacity with said transport demand of at least one transport user** (13) **in said electronic registry of demand for transport between at least two of said nodes** (803-806),"

As this table confirms, the EPO applied Olmi to foundational family claim features reflected in the U.S. family.

This family history confirms Olmi's materiality to the challenged patents, including the '668 patent. The '427 and its EP counterpart were the family's earliest applications, claimed priority to the same provisional application, and established the baseline claim architecture from which the later continuations—and ultimately the challenged U.S. patents—were derived. EX1001; EX1036. Because the EPO applied Olmi against that foundational architecture and the applicant's claim amendments failed to overcome that reference, Olmi was plainly material to the family baseline from which the challenged claims emerged. EX1036. That incomplete examination record favors merits review.

Subsequent U.S. prosecution reinforces that conclusion. In Application No. 17/155,221, which is a non-challenged family member related to the '668 patent, a U.S. Examiner independently found and applied Olmi in a June 8, 2022 Office Action. EX1047, 91 (Olmi identified as Giuseppe). Just like Uber's Petitions and the EPO Examiner, the U.S. Examiner applied Olmi for its disclosure of a passenger selecting a car-pool vehicle from multiple available options and the system using that selection in the transport-provider request workflow. EX1047, 91. The Office Action also included an allowable dependent claim, which Carma incorporated in a September 6, 2022 amendment, after which the examiner issued a notice of allowance. EX1047, 10, 59-61, 64, 91. The allowable subject matter incorporated by Carma was directed to the feature of determining a "deviation" in the travel provider's path, which is not present in the challenged claims here. EX1047, 59-61. Accordingly, Carma only overcame the Olmi rejection by incorporating the allowable subject matter that is not recited by the challenged claims. EX1047, 3-4. In view of how Carma failed to rebut Olmi-based rejections in both the U.S. and Europe, the failure to consider Olmi during prosecution of the challenged patents, including the '668 patent, gives rise to the Office error issue presented here.

The Office's own rules and guidance underscore the significance of Olmi's absence from the prosecution records of the challenged patents, including the '668 patent. Material information from foreign counterpart prosecution must be disclosed

to the Office when it bears directly on patentability. 37 C.F.R. § 1.56; M.P.E.P. §§ 2001.05–.06. Olmi was precisely that kind of counterpart reference. The EPO identified Olmi as highly relevant family art, applied Olmi to overlapping family claim features, found the claims not patentable, and rejected Carma's attempted distinctions. EX1036. Yet Olmi was not before the Office during prosecution of the '427 patent, and Carma did not cite Olmi during prosecution of the later-issued challenged patents, including the '668 patent, after failing twice to overcome the EPO's Olmi-based rejection.[3] That incomplete examination record favors merits review.

IV. The Challenged Patents Lack Settled Expectations

The challenged patents, including the '668 patent, lack settled expectations. The four later-issued patents—the '071, '138, '668, and '456—which issued within the last six years, do not carry the kind of claim age or reliance interests that could justify discretionary denial. The '427 patent likewise does not support a settled-expectations argument. Although issued in 2010, the table above shows that its claim 1 architecture materially overlaps with the EP amended claims later rejected over Olmi. The rejection over Olmi was never overcome and the counterpart EP

[3] Nor did Carma provide Olmi to the Office with a request for supplemental examination of the challenged patents. *See* 35 U.S.C. 257; M.P.E.P. § 2802.

application went abandoned. EX1036, 266. In those circumstances, Carma could not reasonably expect that the challenged patents, including the '668 patent, would remain insulated from Board review notwithstanding the EPO record applying Olmi to similar claims and the later U.S. continuation record confirming Olmi's significance. Settled expectations therefore do not favor discretionary denial for any of the challenged patents.

V. The *Fintiv* Factors Favor Merits Review

Carma has asserted the challenged patents in the Carma Litigation involving the same parties and the same related patent family. As explained below, Factor 1 is neutral, Uber's *Sotera* stipulation materially reduces overlap under Factor 4, and the remaining factors do not justify discretionary denial when considered as part of the full record.

A. Factor 1 – A Stay is Premature

Uber has not requested a stay while Uber's motion to dismiss for improper venue or transfer under § 1406(a) remains pending. EX1044, 2 n.2; EX1046, Dkt. Nos. 21, 24. Stay-motion practice is therefore premature. If review is instituted, Uber may seek a stay, and the institution would change the stay analysis by allowing the district court to consider whether PTAB review of all asserted patents would simplify the case. Factor 1 is therefore neutral.

B. Factor 2 – The Trial Date is Subject to Change

Although the district court has set a trial date for November 2, 2026, the reliability of that schedule is diminished by the still-pending motion to dismiss or transfer. EX1044, 2 n.2; EX1046, Dkt. Nos. 21, 24. If the motion is granted, the case will either be dismissed entirely or transferred to the District of Delaware, where any new trial date would be expected well after the final written decision in this proceeding. EX1048, 14 (median time from filing to trial in civil cases is 41.1 months).

More importantly, *Allani* shows that a trial date preceding the projected final written decision does not, by itself, justify discretionary denial where other circumstances weigh against it. There, the Director declined discretionary denial even though trial was scheduled before the projected final written decision. *Allani* at 2–3. The same timing concern is present here, and the same conclusion should follow because, just like in *Allani*, Carma's long dormancy materially weakens any argument that PTAB review would be unfair or disruptive. Factor 2 therefore does not justify discretionary denial when considered with the full record, including Allani and the unresolved venue/transfer motion.

C. Factor 3 – The Unresolved Transfer Motion Diminishes Any Claimed Investment

Uber's motion to dismiss or transfer remains unresolved, so the case remains in a procedurally fluid posture. EX1044, 2 n.2; EX1046, Dkt. Nos. 21, 24. If that

motion is granted, the case could proceed in a different forum and on a different schedule, materially changing the current trial-date and investment calculus, and making Carma's reliance on the current Eastern District schedule less compelling.

The work completed to date does not change that conclusion. The docket reflects case management and procedural development, not adjudication of the specific unpatentability grounds presented here. EX1046. The district court has not addressed the Olmi-based Office error issues now before the Director. And *Allani* confirms that even meaningful district court investment does not require discretionary denial where the surrounding circumstances counsel otherwise. *Allani* at 2–3. In the present circumstances, Factor 3 therefore favors merits review.

D. Factor 4 – The *Sotera* Stipulation Favors Merits Review

Factor 4 does not support discretionary denial because Uber has filed a *Sotera* stipulation. Carma asks the Director to discount Uber's *Sotera* stipulation because it "does not include any indication that resolution of this IPR would remove any invalidity theory presented in District Court." DD Req. 13-15. Uber stipulates that, if review is instituted, it will not pursue in district court any ground of invalidity that was raised or reasonably could have been raised in these IPRs. EX1043. That is the only precedential stipulation formulation recognized in the Board's precedential decision in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 18–19 (PTAB Dec. 1, 2020) (precedential). Accordingly, Factor 4 favors merits review.

E. Factor 5 – These Proceedings Enable Simplification

These proceedings challenge all the patents asserted in the Carma litigation, and they involve the same parties. Carma argues that party identity favors denial, but party identity does not control the analysis. DD Req. 11, 14. Uber is challenging 5 patents of varying subject matter (e.g., the '138 patent is directed to transporting goods), which provides the parties with an opportunity to simplify the common Olmi-based Office error issues. *See Tesla, Inc. v. Intellectual Ventures II LLC,* IPR2025-00217, Paper 9 (Dir. June 13, 2025) (informative). Accordingly, Factor 5 does not favor discretionary denial.

F. Factor 6 – Compelling Merits Favor Review

Factor 6 favors merits review. Carma's discretionary denial briefs focus on timing, alleged notice, and overlap, but they do not meaningfully answer the central Office error problem: the challenged patents, including the '668 patent, issued without the Office considering Olmi, even though the EPO had applied Olmi to materially similar family claims and rejected Carma's attempted distinctions. EX1036. Additionally, a later U.S. examiner independently found and applied Olmi in a family continuation, further corroborating that Olmi was significant family art. EX1047, 91.

Just as importantly, the parties' pre-suit history materially undercuts any claim that PTAB review would be unfair or disruptive. *Allani* is instructive on that point.

There, the Director declined discretionary denial notwithstanding an early trial date and meaningful district court investment because the petitioner had advised the patent owner of its position and the patent owner then waited eleven years to sue. *Allani* at 2–3. Here, Uber responded to Carma's '427 allegations on the merits in 2016-2018, Carma then went silent, later obtained the other challenged patents, and only resurfaced more than six years later before filing suit in 2025. EX1037–EX1042; EX1046. Under *Allani*, those circumstances favor merits review.

The '668 patent presents a compelling case for merits review. It was issued on May 25, 2021; after the EPO applied Olmi but before the Office found Olmi, meaning Olmi was not considered during prosecution. EX1001; EX1036. All twenty claims of the '668 patent are challenged through Olmi-based combinations, specifically Olmi, Peer, and Poykko426, with Jeon added for claims 3 and 14. Pet. 2. The case for merits review is even stronger because the claims of the '668 patent were allowed after minimal examination and without prior-art rejections. EX1004. Merits review is therefore appropriate both because the Petition presents a serious Office error issue and because the settled expectations concern is weak.

VI. The Petition is Consistent with the District Court Positions

Carma's general and vague suggestion that Uber has taken inconsistent positions about the claimed invention is unsupported and legally insufficient. DD Req. 14-15. Carma points to no term-specific inconsistency between Uber's

positions in the Petition and its statements in the Carma Litigation. Indeed, after speculating that Uber might take an inconsistent position on a particular element, Carma itself conceded that Uber "did not address that element in the District Court claim construction briefing." DD Req. 15. That concession is dispositive: without any term-specific contradiction, Carma's speculation that Uber *might* later take an inconsistent position cannot carry the day. Uber's claim construction positions are reflected in the Joint P.R. 4-5 Statement and are consistent with the Petition. EX1045. Accordingly, Carma's argument fails as a matter of fact and law.

VII. Conclusion

For all these reasons, Carma's request for discretionary denial should be denied. Carma's pre-suit dormancy after Uber's non-infringement response undercuts any claim of unfair surprise or disruption from PTAB review. EX1037–EX1042. Carma's reliance on Uber prosecution materials does not change that result because awareness of patent publications is not notice that Carma would later assert this patent family after years of silence. DD Req. at 1, 8–10. The challenged patents also do not carry settled expectations warranting denial: four issued only between 2020 and 2021, and the '427 is materially undercut by the later EPO record applying Olmi to materially similar claims. DD Req. at 11 n.1; EX1036. The district court schedule and investment do not outweigh these considerations, particularly given the unresolved motion to dismiss or transfer and Uber's *Sotera* stipulation. EX1043;

EX1044, 2 n.2; EX1046. Most importantly, the challenged patents issued without the Office considering Olmi, even though the EPO treated Olmi as significant family art and a later U.S. examiner independently found and applied Olmi in a family continuation. EX1036; EX1047. The Director should deny Carma's request and refer the Petitions for merits review.

Dated: June 16, 2026

By: / Naveen Modi /
Naveen Modi (Reg. No. 46,224)
Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on June 16, 2026, I caused a true and correct copy of the foregoing Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and supporting exhibits to be served by electronic means on the counsel identified below:

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