

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO. LTD. and SAMSUNG ELECTRONICS  
AMERICA, INC.,

Petitioners

v.

MOBILE DATA TECHNOLOGIES LLC,

Patent Owner

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IPR2025-00536  
U.S. Patent No. 9,032,039

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**PATENT OWNER'S DISCRETIONARY DENIAL BRIEF**

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<b>Ex.</b>	<b>Description</b>
2001	E-mail serving amended infringement contentions in EDTX-Litigation
2002	Comparison between the specifications of the '039 and '801 Patents
2003	Petition for <i>Inter Partes</i> Review in IPR2025-00536 (Jan. 31, 2025)
2004	Reserved
2005	Reserved
2006	E-mail from the Board regarding the 535 and 536 IPR panel assignments (May 2, 2025)
2007	Reserved
2008	E-mail from Erick S. Robinson memorializing the phone conversation with Petitioners' counsel (September 26, 2024)
2009	Reserved
2010	Reserved
2011	Reserved
2012	Reserved
2013	E-mail exchange between Erick S. Robinson and Petitioners' counsel regarding a stay (October 17, 2024)
2014	E-mail exchange between Erick S. Robinson and Petitioners' counsel regarding a stay (February 19, 2025)
2015	E-mail exchange between Erick S. Robinson and Petitioners' counsel wherein Petitioners shared their motion to stay with Patent Owner (March 4, 2025)
2016	Second Amended Docket Control Order in the EDTX-Litigation (December 19, 2024)
2017	United States District Courts — National Judicial Caseload Profile (September 30, 2024)
2018	E-mail from Petitioners' counsel serving their initial and additional disclosures (October 16, 2024)
2019	E-mail from Petitioners' counsel serving their invalidity contentions (January 31, 2025)
2020	E-mail from Petitioners providing materials produced by third-party Microsoft Corporation and Sybase, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (April 25, 2025)
2021	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (March 7, 2025)

<b>Ex.</b>	<b>Description</b>
2022	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 24, 2025)
2023	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 21, 2025)
2024	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 11, 2025)
2025	E-mail from Petitioners providing materials produced by third-party AT&T Mobility LLC in response to Petitioners' subpoena in the EDTX-Litigation (February 5, 2025)
2026	Patent Owner's Infringement Contentions in the EDTX-Litigation (September 4, 2024)
2027	Petitioners' Invalidity Contentions in the EDTX-Litigation (January 31, 2025)
2028	E-mail exchange between Homayoon Rafatijo and Petitioners' counsel regarding Petitioners' contacting the Board for filing their proposed <i>Sotera</i> stipulation (April 21-23, 2025)
2029	E-mail from Petitioners' counsel with a draft of a proposed communication to the Board (April 30, 2025)
2030	E-mail from Petitioners' counsel with sharing with Patent Owner their proposed <i>Sotera</i> stipulation (April 18, 2025)
2031	Reserved
2032	Petitioners' proposed <i>Sotera</i> stipulation for '535 and '536 IPRs (April 18, 2025)
2033	Petitioners' claim chart against '039 Patent based on the Nokia 9210 System (January 31, 2025)
2034	Reserved
2035	Summary of verbatim (or nearly verbatim, strikethrough added) matches between the '536 petition to the Houh Declaration (Ex.1003)
2036	E-Mail from Petitioners providing Casio America, Inc.'s declarations certifying business records in response to Petitioners' subpoena in the EDTX-Litigation (May 9, 2025)
2037	Joel West & David Wood, <i>EVOLVING AN OPEN ECOSYSTEM: THE RISE AND FALL OF THE SYMBIAN PLATFORM</i> (2013)

<b>Ex.</b>	<b>Description</b>
2038	Bradston Henry, <i>Multiplayer Server Basics   Creating a Multiplayer Game Server - Part 1</i> (Oct. 25, 2021), <a href="https://dev.to/ibmdeveloper/multiplayer-server-basics-ep-1-creating-a-multiplayer-game-server-5aed">https://dev.to/ibmdeveloper/multiplayer-server-basics-ep-1-creating-a-multiplayer-game-server-5aed</a>
2039	Declaration of George Edwards in Regard to the Petitions for <i>Inter Partes</i> Review of U.S. Patent No. 9,032,039

## I. INTRODUCTION

On June 10, 2024, Mobile Data Technologies LLC (“Patent Owner”) filed a patent infringement complaint (the “Complaint”) against Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioners”) in the United States District Court for the Eastern District of Texas. *Mobile Data Technologies LLC v. Samsung Electronics Co. Ltd. et al.*, 2:24-cv-00435-JRG-RSP (E.D. Tex.) (“EDTX-Litigation”). In the Complaint, Patent Owner asserted four patents: U.S. Patent Nos. 8,825,801 (“the ‘801 Patent”), 9,032,039 (“the ‘039 Patent”), 9,619,578 (“the ‘578 Patent”), 9,922,348 (“the ‘348 Patent”). Patent Owner served its infringement contentions on September 4, 2024, for these patents. On October 6, 2024, Patent Owner filed an Amended Complaint, adding U.S. Patent No. 8,793,336 (“the ‘336 Patent”) to the EDTX-Litigation. On the same day, Patent Owner served its amended infringement contentions in which “[n]othing else was added other than a chart for the asserted claims of the ‘336 [Patent] and the file history for the ‘336 [Patent].” Ex.2001. In this proceeding, Patent Owner refers to the five patents asserted in the EDTX-Litigation as the “Asserted Patents.” As shown in Figure 1 below, the Asserted Patents arise from a common family and share nearly identical specifications. *See, e.g.*, Ex.2002 (comparing specifications of the ‘039 and ‘801 Patents).

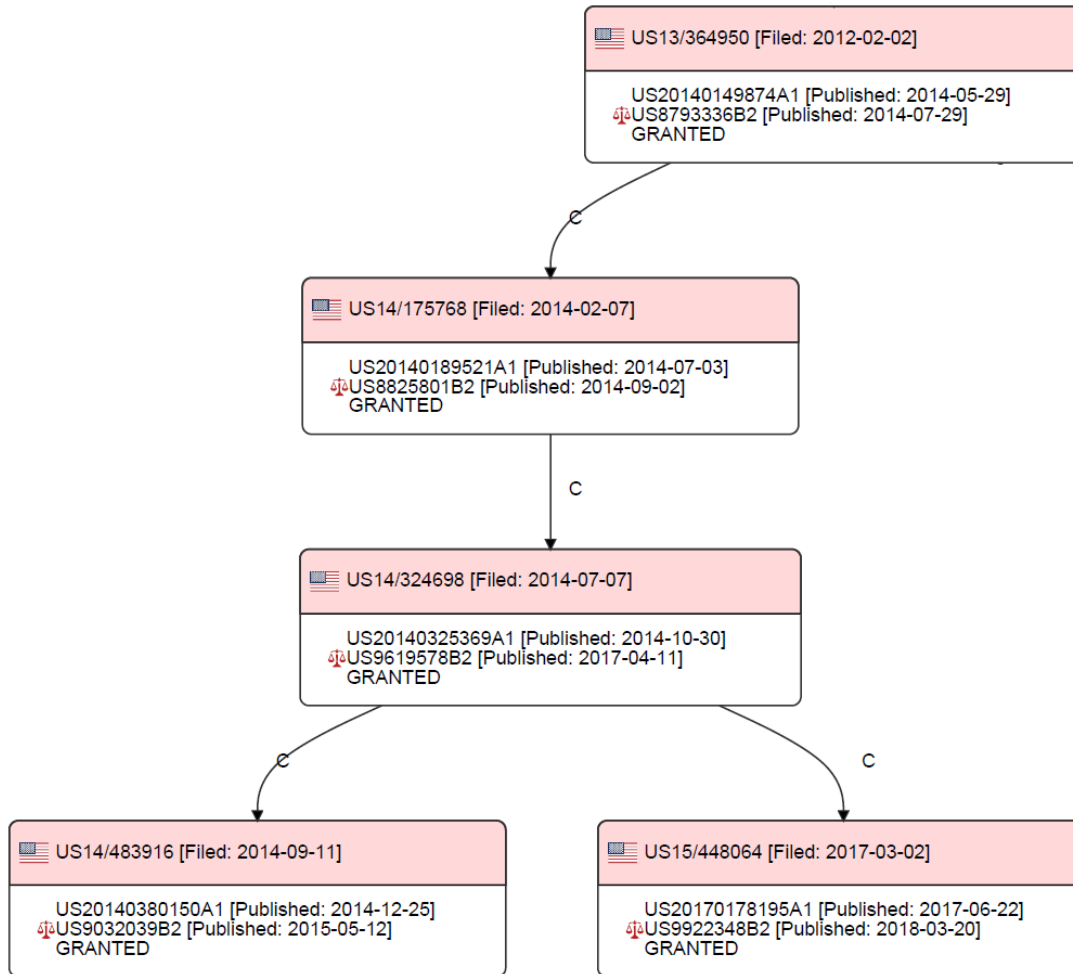


Figure 1. Family tree for the Asserted Patents.

Nearly eight months into the EDTX-Litigation, and after the service of both invalidity and infringement contentions, Petitioners filed *ten* IPR petitions—two against each Asserted Patent—on what they characterize as “mutually exclusive grounds.” The first set simply asserts the Neibauer-based combinations (“Neibauer Grounds”) that Meta Platforms, Inc. (“Meta”) advanced in *Meta Platforms, Inc. v. Mobile Data Techs., LLC*, IPR2024-00248 (P.T.A.B. 2023) (“Meta-MDT-IPRs”), a proceeding since settled. Petitioners concede that this first set rests on “common

references and arguments” recycled from the Meta-MDT-IPRs. Paper 3 at 4. However, characterizing them as merely “common references and arguments” is far too generous: Petitioners have copied the Meta-MDT-IPRs petition word-for-word and dropped it into the ‘535 Petition, substituting little more than the caption. The second set asserts invalidity grounds based on Randall-Forsyth and Pelkey-Eck combinations (collectively, the “Original Grounds”). Yet Petitioners advance identical claim construction positions in both the Original Grounds and the Neibauer Grounds—Petitioners’ proposed constructions appear verbatim in each petition. *See* Table 1.

Table 1: Petitioners’ proposed constructions for claim terms in ‘535 and ‘536 Petitions are identical.

<b>Term</b>	<b>‘535 IPR Construction</b>	<b>‘536 IPR Construction</b>
Mobile Device	“Petitioners apply the plain meaning which is consistent with Meta’s Meta-MDT-IPR and MDT-Meta-Litigation constructions.” Petition at 5.	“Petitioners apply the plain meaning which is consistent with Meta’s Meta-MDT-IPR and MDT-Meta-Litigation constructions.” Ex.2003 at 6.
Application-Based Information Channel	“Petitioners do not believe this term requires construction here.” Petition at 6.	“Petitioners do not believe this term requires construction here.” Ex.2003 at 7.
Wireless Network Limitations	“While Petitioners dispute PO’s construction, construction of the term is not needed because the prior art discloses this term under both constructions.” Petition at 6-7.	“While Petitioners dispute PO’s construction, construction of the term is not needed because the prior art discloses this term under both constructions.” Ex.2003 at 7.

A straightforward application of *Fintiv* framework to the facts of this case reveals the Board should exercise its discretion to deny institution of the ‘536 IPR.

The EDTX-Litigation is proceeding on a schedule for an April 2026 jury trial—five months before any *inter partes* review (“IPR”) would conclude between Petitioners and Patent Owner, even if the Board were to institute. In addition, there is substantial overlap between the ‘536 IPR Petition and the EDTX-Litigation as Petitioner relies on system art in the EDTX-Litigation that corresponds to the references relied upon in the Petition. Furthermore, the Petition relies excessively on expert testimony and suffers from fatal weaknesses, as demonstrated below.

Accordingly, the Board should exercise its discretion and deny institution of the Petition.

## **II. The Board Should Exercise Discretionary Denial Under *Fintiv* Framework**

The Board should deny institution under §314(a) in view of its precedential decisions in *NHK Spring* and *Fintiv*. In *NHK Spring*, the Board denied institution primarily because the related district court case would resolve all the issues before the Board. *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, 20 (P.T.A.B. Sept. 12, 2018) (precedential), *see also id.*, 11-18 (applying discretion under 35 U.S.C. §325(d)). Other cases—relying on *NHK Spring*—have also denied institution where the district court trial would resolve the invalidity issue before a final written decision would be issued by the Board. For example, in *E-One, Inc. v. Oshkosh Corp.*, the Board applied *NHK Spring*’s analysis under 35 U.S.C. §314(a) to deny institution. IPR2019-00161, Paper 16 (P.T.A.B. May 15, 2019). In *E-One*,

the Board reasoned:

In the § 314(a) portion of its analysis, [*NHK Spring*] noted that a district court proceeding involving the same patent was scheduled to go to trial before a final decision would have been due in the Board proceeding, and the Board proceeding would involve the same claim construction standard, the same prior art references, and the same arguments as in the district court.

*Id.*, 6. In both *NHK Spring* and *E-One*, factors warranting a denial of institution included the district court investing considerable time and resources to handle the same issues presented in the IPRs, and trials that were scheduled to be completed prior to a Board’s final written decision. The facts here warrant denial just as decided in *NHK Spring* and *E-One*.

In *Fintiv*, the Board emphasized six factors to consider under *NHK Spring* which are discussed below. *See Fintiv*, Paper 11 at 5-16. The Board stated that “[t]hese factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.*, 6. In evaluating the *Fintiv* factors, the Board must “take[] a **holistic view** of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

Importantly, no individual factor is dispositive by and of itself. *See* the March 24, 2025 Memorandum titled, “Guidance on USPTO’s Recission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’” (the “March 24, 2025 Memo”). For example, a timely-

filed *Sotera* stipulation is not dispositive. *Id.* at 3. Similarly, “compelling merits alone is not dispositive in making the assessment.” *Id.*; *see also Motorola Solutions, Inc. v. Stellar LLC*, IPR2024-01205,-01206,-01207,-01208, Paper 19 (P.T.A.B. Mar. 28, 2025) (vacating the decision granting institution and denying institution because “the Board did not give enough weight to the investment in the parallel proceeding and gave too much weight to Petitioner’s *Sotera* stipulation”).

Additionally, consistent with *Fintiv*’s holistic analysis, the Board should also consider other relevant considerations, including but not limited to “[t]he extent of the petition’s reliance on expert testimony,” “[s]ettled expectations of the parties, such as the length of time the claims have been in force,” and compelling economic interests. *See* the March 26, 2025 Memorandum titled, “Interim Processes for PTAB Workload Management” (the “March 26, 2025 Memo”) at 2-3.

Here, the overall balance of *Fintiv* factors and other relevant considerations weigh strongly in favor of denying institution under 35 U.S.C. §314(a).

**A. Factor 1: No stay has been entered in the EDTX-Litigation and there is no evidence that a stay will be granted.**

*Fintiv* Factor 1 weighs in favor of discretionary denial because the EDTX-Litigation has not been stayed. Indeed, no motion to stay the case is pending, and Petitioners have presented no evidence that Judge Gilstrap would grant a stay if such a motion were filed. Even if Petitioners filed a motion to stay today, under the precedent in the Eastern District of Texas, it would be denied.

As a threshold matter, the ‘039 Patent is not subject to an instituted IPR proceeding, and the Eastern District of Texas does not grant a stay when the Board has not issued the decision on institution:

It would have been virtually pointless for Samsung to have sought a stay before the IPR was instituted, as this Court would have almost certainly denied it; the decisions of courts in this district as well as other district courts make that abundantly clear.<sup>1</sup>

*CyWee Grp. Ltd. v. Samsung Elecs. Co.*, No. 17-cv-140, 2019 WL 11023976, at \*5 (E.D.Tex. Feb. 14, 2019); *see also Trover Group, Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047WCB, 2015 WL 1069179, at \*6 (E.D.Tex. Mar. 11, 2015) (Bryson, J.) (“This Court’s survey of cases from the Eastern District of Texas shows that when the PTAB has not yet acted on a petition for inter partes review, the courts have uniformly denied motions for a stay.”); *see also Samsung Elecs. Co. Ltd. v. Evolved Wireless LLC*, IPR2021-00950, Paper 10 at 10-11 (P.T.A.B. Nov. 29, 2021) (finding this factor weighed in favor of denial and denying institution where patent owner showed a stay was unlikely partly based on the court’s past decisions denying stays); *Samsung Elecs. Co. Ltd. v. Clear Imaging Research, LLC*, IPR2020-01552, Paper 12 at 12-13 (P.T.A.B. Mar. 3, 2021) (denying institution because, in part, Judge Gilstrap deemed unlikely to stay a case in similar circumstances).

Additionally, even if Petitioners file their motion to stay today—before the

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<sup>1</sup> All emphases are added unless otherwise is noted.

Board decides institution in the ‘536 IPR—the Eastern District of Texas would deny Petitioners’ motion to stay based on Petitioners’ delay. Petitioners had every opportunity to file a motion to stay the EDTX-Litigation any time between institution and withdrawal of the Meta-MDT-IPRs, namely between June 2024 and March 2025. In fact, Petitioners have been contemplating a motion to stay for over seven months, since the early stages of the EDTX-Litigation (*See* Exs.2008, 2013, and 2014), but still have not filed such a motion with the district court.

On September 26, 2024, Petitioners inquired about Patent Owner’s position regarding a stay of the EDTX-Litigation pending the issuance of final written decisions in Meta-MDT-IPRs. *See* Ex.2008. Patent Owner informed Petitioners that it opposed a stay, and Petitioners did not proceed with filing. Ex.2013. On February 19, 2025, after filing their IPR Petitions, Petitioners once again inquired about Patent Owner’s “position on a stay pending IPR.” *See* Ex.2014. And on March 4, 2025, Petitioners shared a draft of their motion to stay for Patent Owner’s review. Ex.2015. To date, Petitioners still have not filed a motion to stay. Eastern District of Texas precedent has denied a stay where there has been a much shorter delay than here. *See, e.g., Saint Lawrence Commc’ns LLC v. ZTE Corp.*, No. 2:15-CV-349-JRG, 2:15-CV-351-JRG, 2017 WL 3396399, at \*2 (E.D.Tex. Jan. 17, 2017) (“[Defendant’s] decision to **wait over a month to file its renewed motion to stay** following the PTAB’s decision to institute IPR ... further undermines its efforts to

obtain a stay.”).

Even if Petitioners’ delay in filing a motion to stay is overlooked, Petitioners’ delay in filing their IPR Petition is an independent basis in the Eastern District of Texas to deny a motion to stay. *See Tessera Advanced Technologies, Inc. v. Samsung Electronics Co., Ltd.*, No. 2:17-cv-00671-JRG, 2018 WL 3472700, at \*3 (E.D.Tex. July 19, 2018) (finding IPRs filed *nine months after initiation of the lawsuit* and *five months after service of infringement contentions* weighed against a motion to stay). Here, Petitioners filed their IPR Petitions nearly eight months after the initiation of the EDTX-Litigation and five months after service of Patent Owner’s infringement contentions. Under the Eastern District of Texas’s precedent, Petitioners’ delay in filing their IPR Petitions would weigh against grant of a motion to stay even if they filed one today.

Finally, the Eastern District of Texas has yet another independent reason to deny a motion to stay—any final written decision would not be due until well after the trial concludes. The EDTX-Litigation has been underway for almost a year now, and jury selection is less than a year away, on April 20, 2026. *See* Ex.2016. This is “a deadline that cannot be changed without an acceptable showing of good cause. Good cause is not shown merely by indicating that the parties agree that the deadline should be changed.” *Id.* at 5. An institution decision on the ‘536 IPR is not due until September 2025. By that date, the parties will have substantially completed the claim

construction process, with the *Markman* hearing scheduled for October 30, 2025. *See id.* at 4-5. A final written decision would not be due until September 2026, five months after trial is scheduled to begin. For this independent reason, the Eastern District of Texas is likely to find that a stay in circumstances like this case would unduly prejudice Patent Owner, disfavoring a stay. *See, e.g., MyPort, Inc. v. Samsung Electronics Co., Ltd., et al.*, No. 2:22-cv-00114-JRG, Dkt. No. 73 (E.D.Tex. June 12, 2023) at 4 (noting that patent owner has an interest in the timely enforcement of its patent rights and that granting a stay could delay the case by nearly two years where the PTAB decision is not due until over two months after jury trial is set to begin).

Accordingly, under circumstances of this case, *Fintiv* Factor 1 weighs overwhelmingly in favor of discretionary denial.

**B. Factor 2: The EDTX-Litigation’s Trial Date is Five Months Before the Expected Date of Any Final Written Decision**

*Fintiv* Factor 2 strongly weighs in favor of discretionary denial because by the time any final written decision in the ‘536 IPR would issue, the EDTX-Litigation would be concluded, and Petitioners’ invalidity challenges all addressed by the district court. “If a district court’s trial date is earlier than the Board’s projected statutory deadline for a final written decision, the Board generally has weighed this fact in favor of exercising discretion to deny institution.” *TMobile USA, Inc., et al. v. Wireless Alliance*, IPR2024-00608, Paper 16 (P.T.A.B. Sept. 3, 2024) (exercising

discretion to deny institution of inter partes review).

The '536 IPR was filed nearly 8 months after initiation of the EDTX-Litigation, and a decision whether to institute the '536 IPR is expected approximately on September 17, 2025. If instituted, any final written decision is expected approximately on September 13, 2026. 37 C.F.R. § 42.100. Jury selection in the EDTX-Litigation is scheduled to begin on April 20, 2026, five months before any final written decision from the Board. *See* Ex.2016, at 1. The jury selection is “a deadline that cannot be changed without an acceptable showing of good cause. Good cause is not shown merely by indicating that the parties agree that the deadline should be changed.” *Id.* at 5. Furthermore, while the case schedule has been amended, the parties have never attempted to extend any of the critical interim deadlines, such as claim construction, fact discovery, expert discovery, pre-trial conference, and jury selection. Thus, it is unlikely that the parties will agree to change the trial date now.

Even if the Board disregards the scheduled trial date, an analysis of the current median time-to-trial statistics still weighs against institution. *See* March 24, 2025 Memo at 3 (“[T]he Board may consider any evidence that the parties make of record that bears on the proximity of the district court’s trial date or the ITC’s final determination target date, ***including median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides.***”). The most recent

statistics on “United States District Courts – National Judicial Caseload Profile,” published by [www.uscourts.gov](http://www.uscourts.gov),<sup>2</sup> show that for a 12-month period ending September 30, 2024, a median time-to-trial in the Eastern District of Texas for civil cases is 21.9 months. Ex.2017 at 35. Accordingly, the projected trial date in the EDTX-Litigation for purposes of *Fintiv* in accordance with the March 24, 2025 Memo would be around March 29, 2026—even earlier than the scheduled trial date and nearly six months before the expected timing of a final written decision if this proceeding is instituted.

The Board has consistently found that this factor weighs in favor of exercising discretionary denial where the underlying litigation is in the Eastern District of Texas and the projected trial date is prior to the date when the final written decision would be due. *See, e.g., SAP America v. Cyandia, Inc.*, IPR2024-01496, Paper 13, 5-6 (P.T.A.B. Apr. 7, 2025) (holding that this factor weighs against institution when the trial would begin “about four months before the deadline for entering a final written decision in this proceeding”); *T-Mobile*, IPR2024-00608, Paper 16 at 13 (“Because

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<sup>2</sup> This website is “maintained by the Administrative Office of the U.S. Courts on behalf of the Federal Judiciary.” <https://www.uscourts.gov/>. The URL for the published statistics is [https://www.uscourts.gov/sites/default/files/2024-12/fcms\\_na\\_distprofile0930.2024.pdf](https://www.uscourts.gov/sites/default/files/2024-12/fcms_na_distprofile0930.2024.pdf).

the district court would address issues relating to the validity of the '662 patent in a trial that, by any measure, would occur many months before we would issue a final written decision, we weigh the second *Fintiv* factor as favoring discretionary denial.”).

Accordingly, this factor weighs in favor of exercising discretion to deny institution.

**C. Factor 3: Significant Investment in the Parallel Litigation Will Have Occurred by the Time the Board’s Institution Decision is Due**

*Fintiv* Factor 3 is a two-prong test. The first prong relates to the “amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv* at 9. The second prong is the petitioner’s diligence in filing the petition. “If the petitioner cannot explain the delay in filing its petition, [this fact has] favored denial.” *Fintiv* at 11-12 (recognizing that for Factor 3, “the parties should explain facts relevant to timing”). This factor weighs in favor of exercising discretion to deny institution, because the first prong is neutral, and the second prong strongly weighs in favor of discretionary denial.

Starting with the first prong, fact discovery between the parties is ongoing in the EDTX-Litigation, and each party has produced several volumes of documents. Exs.2018-2019. Petitioners have already served 10 third-party subpoenas requesting production of documents concerning invalidity. Several third parties have produced documents in response to Petitioners’ subpoenas. Exs.2020-2025, and 2036. In

addition, the parties have completed and exchanged their infringement and invalidity contentions.<sup>3</sup> By the projected institution date, the parties would have already expended significant time in discovery and will have also exchanged claim constructions, filed a joint claim construction statement, and completed claim construction discovery. *See* Ex.2016. The *Markman* hearing is also scheduled to occur about a month after the institution decision is due. *Id.* Under similar circumstances, the Board has consistently held that this prong is neutral. *See, e.g., Dell Inc. et al. v. Universal Connectivity Technologies Inc.*, IPR2024-01479, Paper 11, 6-7 (P.T.A.B. Apr. 7, 2025); *Lenovo Inc. et al. v. Universal Connectivity Technologies Inc.*, IPR2024-01479, Paper 17, 11-12 (P.T.A.B. Apr. 17, 2025); *Solus Advanced Materials Co., Ltd. v. SK nexilis Co.*, IPR2024-01460, Paper 14, 17-18 (P.T.A.B. Apr. 22, 2025).

Turning to the second prong, Petitioners were not diligent in filing their Petition. Petitioners waited for nearly eight months to file the '536 IPR Petition. Petitioners cannot justify this delay. Even if this is overlooked, Petitioners cannot explain why they failed to promptly file their Petition upon receiving Patent Owner's infringement contentions in the EDTX-Litigation. Petitioners were served with

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<sup>3</sup> Patent Owner served its infringement contention on September 4, 2024. Ex.2026. Petitioners served their invalidity contention on January 31, 2025. Ex.2027.

Patent Owner’s infringement contentions on September 4, 2024—nearly five months prior to filing the ‘536 IPR. Ex.2026. The five-month gap between service of infringement contentions and the filing of the ‘536 IPR Petition constitutes “substantial delay” that favors discretionary denial under *Fintiv* Factor 3. *AT&T Servs. v. ASUS Tech.*, IPR2024-00992, Paper 14 at 12 (P.T.A.B. Dec. 16, 2024) (five months between infringement contentions and the petition is a “substantial delay”).

Accordingly, this factor weighs in favor of exercising discretion to deny institution.

**D. Factor 4: There is Substantial Overlap Between This IPR and the EDTX-Litigation, Rendering Petitioners’ *Sotera*-style Stipulation Ineffective**

*Fintiv* factor 4 weighs strongly in favor of discretionary denial because “some of the claims challenged in the petition are also at issue in district court,” and the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as included in the EDTX-Litigation. *Fintiv* at 12-13.

The Board’s April 25, 2025 FAQs about the discretionary denial process<sup>4</sup> expressly list two criteria for an effective *Sotera* stipulation: one procedural and one substantive. Procedurally, “[a] petitioner should file a *Sotera* or *Sand* stipulation as soon as practicable, so that a patent owner may address the impact of the stipulation

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<sup>4</sup> [www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management](http://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management).

in its discretionary denial brief.” April 25, 2025 FAQs, Q.14. As to the substance, “the stipulation [must] materially reduce[] overlap between the proceedings,” noting that “[w]here the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful.” *Id.* Petitioners’ *Sotera*-style stipulation fails to meet either criterion.

Procedurally, Petitioners’ *Sotera*-style stipulation is untimely. Petitioners had ample opportunity to file their *Sotera*-style stipulation sooner and even at the time of filing the ‘536 IPR but waited for over 3 months to contact the Board to seek leave to file it.<sup>5</sup> Ex.2006. And despite Patent Owner promptly responding to Petitioners’

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<sup>5</sup> On April 18, 2025—nearly three months after filing their Petition, Petitioners contacted Patent Owner, proposing a *Sotera*-style stipulation. Ex.2030. On April 21, 2025, Petitioners informed Patent Owner that they intend to seek leave to file their proposed stipulation, asking Patent Owner to indicate its position by April 23, 2025. Ex.2028. Patent Owner responded on April 23, 2025, that “Patent Owner does not oppose Petitioner contacting the Board to seek leave to file these stipulations.” *Id.* It took Petitioners one week to respond with the draft of its proposed communication to the Board on April 30, 2025. Ex.2029. Petitioners sent its request for leave to file its *Sotera*-style stipulation to the Board on May 2, 2025. Ex.2006. As of the date of

inquiry (Ex.2028), Petitioners wasted yet another full week to email Patent Owner the draft of their proposed communication to the Board (Ex.2029). These delays are not excusable—the untimeliness of Petitioners’ filing has prejudiced Patent Owner. Patent Owner intended to file this Discretionary Denial brief on at least ten days before the two-month deadline—so that Petitioners’ response would arrive before the POPR was due, giving Patent Owner a meaningful opportunity to review and respond in the POPR. Furthermore, that Patent Owner had to invest time and resources to argue regarding the insufficiency of a not-yet-filed stipulation only serves Petitioners’ interest. Petitioners’ delay has thus prejudiced Patent Owner.<sup>6</sup>

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the filing of this Discretionary Denial brief, Petitioners’ *Sotera*-style stipulation is not filed. Accordingly, Patent Owner cannot address the “impact” of a stipulation that is not yet filed. As such, Patent Owner presents its arguments on the sufficiency of Petitioners’ April 18, 2025 proposed stipulation, assuming that Petitioners will not modify their proposed drafts in this IPR or any of the other IPRs based on Patent Owner’s arguments in this brief.

<sup>6</sup> Petitioners cannot hide behind their April 18, 2025 email to Patent Owner. First, the FAQs state that the stipulation must be “file[d] ... as soon as practicable”—sending a draft of a stipulation to Patent Owner does not relax the filing requirement. The reason is simple—until such time that such proposed stipulation is filed, it is

**1. There is Substantial Overlap Between the References in the Petition and the Corresponding System Art in the EDTX-Litigation**

Turning to the substance of Petitioners’ *Sotera*-style stipulation, Petitioners’ proposed draft does not reduce overlap between the proceedings. Petitioners’ draft stipulation provides that if the Board “institutes an *inter partes* review (“IPR”) in either or both of IPR2025-00535 and IPR2025-00536 concerning U.S. Patent No. 9,032,039, then Samsung will not pursue in this litigation the grounds raised or any other grounds that could have reasonably been raised before the PTAB in the instituted proceeding(s).” Ex.2032.<sup>7</sup> However, in view of Petitioners’ invalidity

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just that: a proposed draft. A petitioner can change its proposed draft at anytime before filing. Thus, Patent Owner could not reasonably address the impact of a draft stipulation that is not yet filed. Second, April 18, 2025—over three months from filing the Petitions—is not “as soon as practicable” by any stretch.

<sup>7</sup> Patent Owner files this Exhibit only to give the Board context for its arguments. Petitioners—not Patent Owner—must file any *Sotera* stipulation, and they have not done so. This Exhibit does not fulfill that duty, and no stipulation is considered filed because Patent Owner files this Exhibit. If the Board permits Petitioners to file a stipulation, it must be the very stipulation they delivered to Patent Owner on April 18, 2025—no revisions, no substitutions. *See* Ex.2006 at 2 (requesting “to

contentions, this stipulation is insufficient.

For Ground 1, Petitioners assert a combination of Randall and Forsyth. These references are directed at features of the Symbian operating system (“OS”). Randall (“The present invention will be described with reference to an implementation from Symbian Limited of London, United Kingdom. This implementation is called the ADS™ system.”); Forsyth (“An implementation of the present invention, called Forums™, is a new approach to group communication from Symbian Limited of London, United Kingdom. ... Forums runs on the object based operating system Symbian OS.”). Petitioners specifically focus on “the Symbian Forums service” described in Randall and Forsyth. Petition at 8-11.

In the EDTX-Litigation, Petitioners have asserted the “Nokia 9210 System” as a prior art system to challenge the validity of the ‘039 Patent. Ex.2027 at 35-36. As a threshold matter, the Nokia 9210 system relies on Symbian OS, which originates from a major joint venture between Psion and phone manufacturers Ericsson, Motorola, and Nokia to create Symbian Ltd. in June 1998. Ex.2037 at 5. Ex.2039 ¶9. The collaboration aimed to develop a standardized operating system for mobile devices—Symbian OS. *Id.* The Nokia 9210 Communicator was the first

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document the *Sotera* stipulations served on Patent Owner Mobile Data Technologies LLC *on April 18 and April 21, 2025*”).

device to run on the Symbian OS platform, with Nokia's Series 80 UI, which was the result of Symbian Ltd.'s 'Crystal' design." *Id.* at 5-6 and 10 (showing crystal design features). Thus, the Nokia 9210 System is a device that runs on Symbian OS.<sup>8</sup> Specifically, all of the Nokia 9210 features that Petitioners relied on in their invalidity claim chart are enabled by the Symbian OS and adequately described in Randall and Forsyth as explained below.<sup>9</sup>

For example, for limitation 1[A], Petitioners' Nokia 9210 System claim chart states that the "Nokia 9210 System allowed users to capture content in the form of messages." Ex.2033 at 5-7. The Petition alleges this feature is also described in both Randall and Forsyth. The Petition points to the disclosure in Randall that "**Short**

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<sup>8</sup> In fact, in 2009 Forsyth was assigned to Nokia Corporation, Finland, and later in 2015 it was assigned Nokia Technologies Oy. *See* Ex.1006.

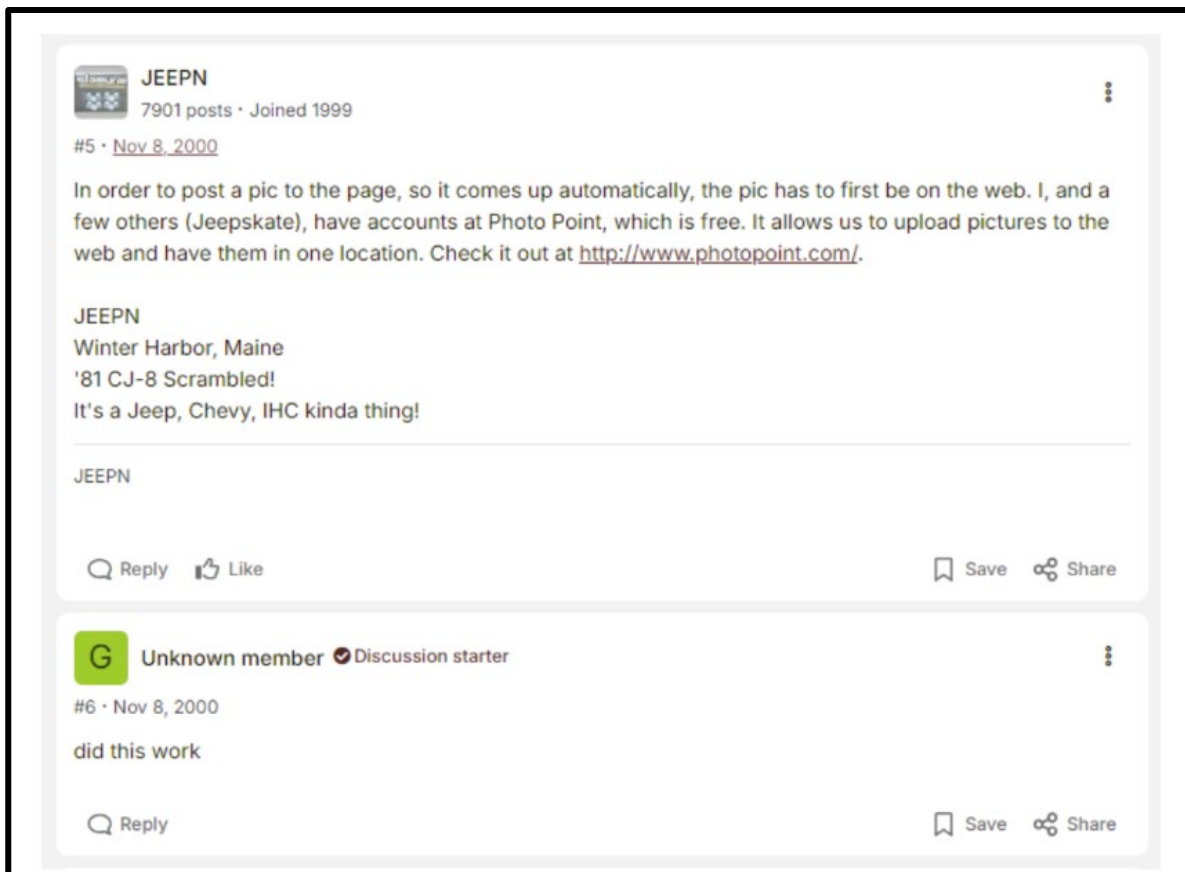
<sup>9</sup> The following discussion of Petitioners' invalidity claim chart and features of the Nokia 9210 System that Petitioners rely on is not an admission by Patent Owner that the Nokia 9210 System teaches, discloses, or otherwise suggests any claim limitation of the '039 Patent. The discussion has a limited purpose, which is to compare disclosures of the Nokia 9210 system and Randall-Forsyth. Patent Owner maintains that the Nokia 9210 System does not render obvious any claims of the '039 Patent for the same reasons the Randall-Forsyth combination does not.

**Message Service (SMS), Enhanced Messaging Service (EMS), Bio Messaging (BIO) and Smart Messaging** can all use GSM's signaling channel, which provides relatively slow but lightweight transport for messages required by the ServML Framework." Randall at 58:5-8; *see also* Forsyth at 3:24-31. And the Petition argues that Forsyth discloses "capturing a message at a wireless device." Petition at 23. Petitioners' Nokia 9210 System claim chart also points to the Nokia 9210 System as disclosing the ability to "create contact groups to save time by sending e-mails and short messages to all members of the contact group in one action." *See, e.g.*, Ex.2033 at 8 (citing Nokia 9210 User Guide). The Petition argues that Forsyth discloses "group based text messaging." Petition at 23. Thus, the Petitioners' assertions regarding disclosure in the Nokia 9210 System claim chart for limitation 1[A] matches with their assertions regarding corresponding disclosure in Randall and Forsyth. Ex.2039 ¶11.

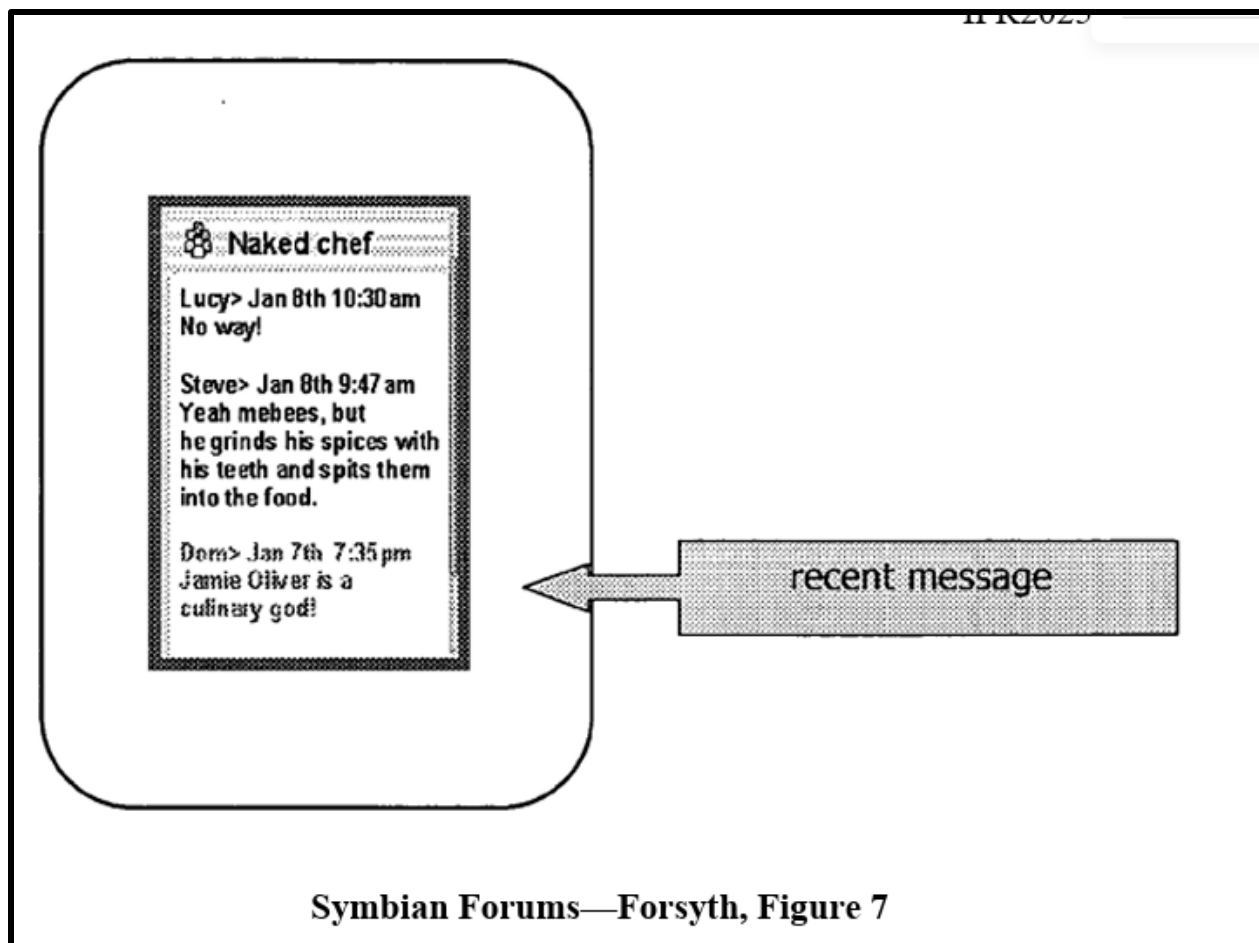
For limitation 1[B], Petitioners' Nokia 9210 System claim chart regarding the system art relies on "the *Contacts application* to create, edit, and manage all contact information, such as phone numbers and addresses." Ex.2033 at 7. Petitioners also contend that Forsyth discloses the same feature: "A '*group object*' is therefore a collection of information that describes or references at least the minimum amount of information about 2 or more entities (usually individual, but possibly also different aspects of the same individual) required for activities to be engaged in

between them, or content to be shared or exchanged. **It can be actual contact information for each member of a group**, or pointers to that contact information on a remote server.” Petition at 14 (citing Forsyth at 2:17-24). Forsyth also states that **“In Forums, a new group object can be created when a user defines the recipients of a message**, or (going beyond a simple messaging application) whenever the user defines the desired participants to be involved in group communication.” Forsyth at 2:48-52. That Forsyth discloses the features of Nokia 9210’s Contacts application is no coincidence—they both concern the Symbian OS. Ex.2039 ¶12.

For limitation 1[C], Petitioners’ Nokia 9210 System claim chart states that Nokia 9210 System allowed determination of “information associated with wireless messaging such as username and date/time, such as in the following exemplary forums, newsgroups, websites, and messengers.” Ex.2033 at 16. Petitioners included the following snippet in the Nokia 9210 System claim chart as an exemplary forum:



Ex.2033. This corresponds to Forsyth’s Figure 7 on which Petitioners rely to show the date/time and names of message participants. Petition at 33-34 (“As shown [in Forsyth’s Figure 7], each message has the user name, date/time and are associated with the Forum name (‘Naked Chef’)”).



Petition at 33. Ex.2039 ¶¶13-14.

For limitation 1[D], Petitioners’ Nokia 9210 System claim chart relies on server-related disclosures in the Nokia 9210 User Guide to conclude that the “Nokia 9210 System allowed users to provide captured content, such as messages, images, audio, video, or documents, to servers for insertion into Contacts, groups, and email threads.” Ex.2033 at 19-20. As above, this is also described in Forsyth and expressly relied upon by Petitioners in this proceeding. *See, e.g.*, Petition at 38-39 (“For example, in Scenario 1, response messages, captured at the mobile device, are ‘sent to the server, which then forwards on the increment to all the people on the current

(server-maintained) address list.”); *see also* Forsyth at 6:5-23 (“[T]he **initial message is created**; an address list for that message is created; these two are **sent to the message server**; the message server stores these two objects and **forwards a copy of the message to each of the people on the address list.**”). Ex. 2039 ¶15.

For limitation 1[E], Petitioners’ Nokia 9210 System claim chart asserts that the Nokia 9210 System “allowed users to **receive content from other users, such as messages, images, audio files, video files, or documents, at a mobile device via Contacts or groups.**” Ex.2033 at 28. But as noted above regarding limitation 1[B], “Contacts or group” are Symbian-specific features discussed thoroughly in Forsyth. Furthermore, Forsyth states that its “Forums offers many advantages to group communication since it is **an easy to understand messaging tool that facilitates open discussion amongst a group and allows multiple chat-style conversations to take place simultaneously.** . . . Forums is shared by all participants, so that any participant can invite someone new to the Forum. These advantages are best appreciated in the context of the following Scenario 1-group based text messaging.” Forsyth at 5:27-41. In addition, Petitioners rely on other features of Nokia 9210 system in their Nokia 9210 System claim chart, such as notification to the user that a text message is received. *See* Ex.2033 at 28 (citing Nokia 9210 User Guide at 50). Each of these features is explicitly discussed in Forsyth. *See, e.g.*, Forsyth at 6:28-31 (“After a user receives notification of a Forum

message, he can check the status of his Forums.”). Ex.2039 ¶16.

As the above analysis shows, each of the Nokia 9210 features Petitioners rely on in their Nokia 9210 System claim chart in the EDTX-Litigation is adequately described in Randall and Forsyth. Ex.2039 ¶18. Despite Petitioners’ statutory inability to raise the Symbian OS-based system (e.g., Nokia 9210 System) in this IPR, a substantial overlap of issues would remain even with Petitioners’ *Sotera*-style or any other narrower stipulations. Where, as here, “the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful.” April 25, 2025 FAQs, Q.14.

Because Petitioners intend to swap labels in the EDTX-Litigation to cloak the Ground 1 as a prior art system when it is the same art asserted in the ‘536 IPR Petition, *Fintiv* Factor 4 weighs strongly in favor of denying institution. *See, e.g., SAP America*, IPR2024-01496, Paper 13 at 8-9 (holding on similar facts that “we do not consider the presence of the *Sotera* stipulation in our case to ensure that inter partes review would be a ‘true alternative’ to the Litigation”).<sup>10</sup>

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<sup>10</sup> Similarly, for Ground 2 Petitioners rely on *Pelkey and Eck*, which disclose “an enhanced version of the Nintendo [*sic*] GameBoy,” which is allegedly a prior art system. Petition at 62. Petitioners’ *Sotera*-style stipulation does not preclude them

**2. The Ineffectiveness of Petitioners’ *Sotera*-style Stipulation is Further Highlighted by the Federal Circuit’s Decision in *Ingenico Inc. v. IOENGINE, LLC***

As the Board’s April 25, 2025 FAQs about the discretionary denial process make abundantly clear, the Board’s determination as to effectiveness of a *Sotera* stipulation hinges on “whether the stipulation materially reduces overlap between the proceedings.” April 25, 2025 FAQs, Q.14. A stipulation is not effective unless it guarantees that “the same or substantially the same claims, grounds, arguments, and evidence” will not be raised in the district court. *Fintiv* at 12-13. Under *Fintiv*, the analysis thus is not limited to whether the grounds of unpatentability are of the same nature (i.e., based exclusively on patents and printed publications) in different proceedings—the analysis must consider whether a petitioner raises substantially the same arguments and evidence in different proceedings. *Id.*

The recent Federal Circuit precedential decision in *Ingenico Inc. v. IOENGINE, LLC*, highlights why Petitioners’ *Sotera*-style stipulation is ineffective for *Fintiv* purposes. No. 23-1367, Document 58 (Fed. Cir. May 7, 2025). The Court held that the protection afforded by the IPR estoppel (35 U.S.C. § 315(e)) is narrow: a petitioner is not precluded from “relying on the same patents and printed

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from asserting an invalidity ground based on Nintendo GameBoy or combination of Nintendo GameBoy with Pelkey and Eck in the EDTX-Litigation.

**publications as evidence** in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use.” *Id.* at 14. The Court concluded that

[W]e hold that IPR estoppel applies **only** to a petitioner’s assertions in district court that the claimed invention is invalid under 35 U.S.C. §§ 102 or 103 because it was patented or described in a printed publication (or would have been obvious **only on the basis of prior art patents or printed publications**).

*Id.* at 15-16.

*Ingenico* thus permits Petitioners to use the very same prior art references raised in the ‘536 Petition in the EDTX-Litigation not only as evidence but also as a prior art reference in a ground that could not be raised in this IPR. For example, under *Ingenico*, Petitioners can present in EDTX-Litigation an invalidity ground based on the Nokia 9210 System and in view of Randall and Forsyth. Per *Ingenico*’s express holding, IPR estoppel does not apply to such a ground as it could not be raised in the IPR because the Nokia 9210 System is system art.

In fact, Petitioners have expressly reserved the right to do this in the EDTX-Litigation. Petitioners expressly state in their Nokia 9210 System invalidity claim charts in the EDTX-Litigation that

To the extent Plaintiff alleges that the Nokia 9210 System does not disclose any particular limitation of claims 1, 6-11, 13-15, 20-21, and 23-26 of the ‘336 Patent (the “Asserted Claims”), either expressly or inherently, **it would have been obvious to a person of ordinary skill in the art as of the priority date of the ‘336 patent to modify the Nokia 9210 System and/or combine the teachings of the Nokia 9210 System**

**with other prior art references, including but not limited to the prior art references presently found in Samsung's Invalidation Contentions** and any supplements thereto and the relevant section of charts for other prior art for the '336 Patent in a manner that would have rendered the Asserted Claims invalid as obvious.

Ex.2033 at 1. The four references relied upon in this IPR—Randall, Forsyth, Pelkey, and Eck—are amongst the “the prior art references presently found in Samsung’s Invalidation Contentions.” See Ex.2027 at 35-36. Thus, per *Ingenico*, Petitioners’ *Sotera*-style stipulation does not prevent Petitioners from concocting a ground of unpatentability by combining the very same prior art references asserted in the ‘536 IPR with a prior art system. Indeed, given that Randall, Forsyth, and the Nokia 9210 System are all directed at the Symbian OS, Petitioners can “**combine the teachings of the Nokia 9210 System with other prior art references,**” (i.e., Randall and/or Forsyth). Ex.2033 at 1.

Worse yet, Petitioners’ *Sotera*-style stipulation would not preclude them from recycling Randall, Forsyth, Pelkey, and Eck in the EDTX-Litigation for use **as evidence**. In fact, Petitioners have expressly reserved the right to do so in their invalidity contentions:

**Defendants’ reference to a particular device or product** in the claim charts of Exhibits C1-C23 **should be interpreted alternatively** as both **as a reference** to the product itself and **to any corresponding patents, publications, or product literature cited in Exhibits C1-C23 that relates to the cited device, or product.** In addition, Defendants may rely on other documents or things that have not yet been located to support its contentions regarding such prior art device(s) or product(s) that are referenced in the charts.

Ex.2027 at 39.

Accordingly, in view of *Ingenico* as well as Petitioners' express statements in their invalidity contentions, Petitioners' *Sotera*-style stipulation does not "materially reduce[] overlap" between this IPR and the EDTX-Litigation, as required by the Board. April 25, 2025 FAQs, Q.14. The Board should exercise its discretion to deny institution in this case.

**E. Factor 5: Petitioners are the Defendants in the EDTX-Litigation**

*Fintiv* factor 5 weighs in favor of exercising discretionary denial because the parties are the same in both proceedings. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 15 (P.T.A.B. May 13, 2020) ("Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.").

**F. Factor 6: Other Circumstances That Impact the Board's Exercise of Discretion, Including the Merits**

*Fintiv* factor 6 holistically weighs in favor of exercising discretionary denial.

**1. Settled expectations of the parties, such as the length of time the claims have been in force.**

The March 26, 2025 Memo lists "settled [as opposed to speculative] expectations of the parties" as a factor to be considered as part of the Board's holistic review. Patent Owner has a settled expectation in the validity of the challenged claims. First, these claims are entitled to the statutory presumption of validity. 35

U.S.C. § 282. Second, the challenged claims were in force from 2015 until they expired in June 2023. Accordingly, this factor weighs in favor of discretionary denial.

## **2. Petitioners' abuse of the IPR process**

Petitioners' filing two sets of petitions is nothing but a transparent attempt to circumvent the 14,000-word limit. Petitioners contend filing multiple petitions was necessary because Patent Owner allegedly proposed two alternative constructions for some of the claim terms. Paper 3 at 2-4. Yet, instead of addressing one claim construction in their first-ranked Petition and the other in the second-ranked Petition, Petitioners take identical claim construction positions in the '535 and '536 Petitions as shown in Table 1 above. This highlights two points. One, Patent Owner's proposed constructions are not truly alternatives as Petitioners characterize. Two, Petitioners' first-ranked and second-ranked Petitions substantially overlap.

## **3. Petitioners' inconsistent rankings of the Petitions**

Petitioners rank their twin Petitions inconsistently. Petitioners rank the Petition asserting the Original Grounds (i.e., the '536 IPR) higher than the Petition asserting the Neibauer Grounds (i.e., the '535 IPR) only for their Petitions against the '039 and '801 Patents. Paper 3 at 2. For other Asserted Patents, Petitioners consistently rank the Petition asserting the Neibauer Grounds higher.

The Asserted Patents belong to the same family, as shown in Figure 1 above,

and share nearly identical specifications. *See, e.g., Ex.2002.* Petitioners do not explain why their ranking of the Petitions is inconsistent, and thus Patent Owner objects to Petitioners' capricious ranking. The Board should resolve this inconsistency in favor of exercising discretion to deny institution.

**4. Petitioners' excessive reliance on expert testimony not focused to providing helpful context for the Board**

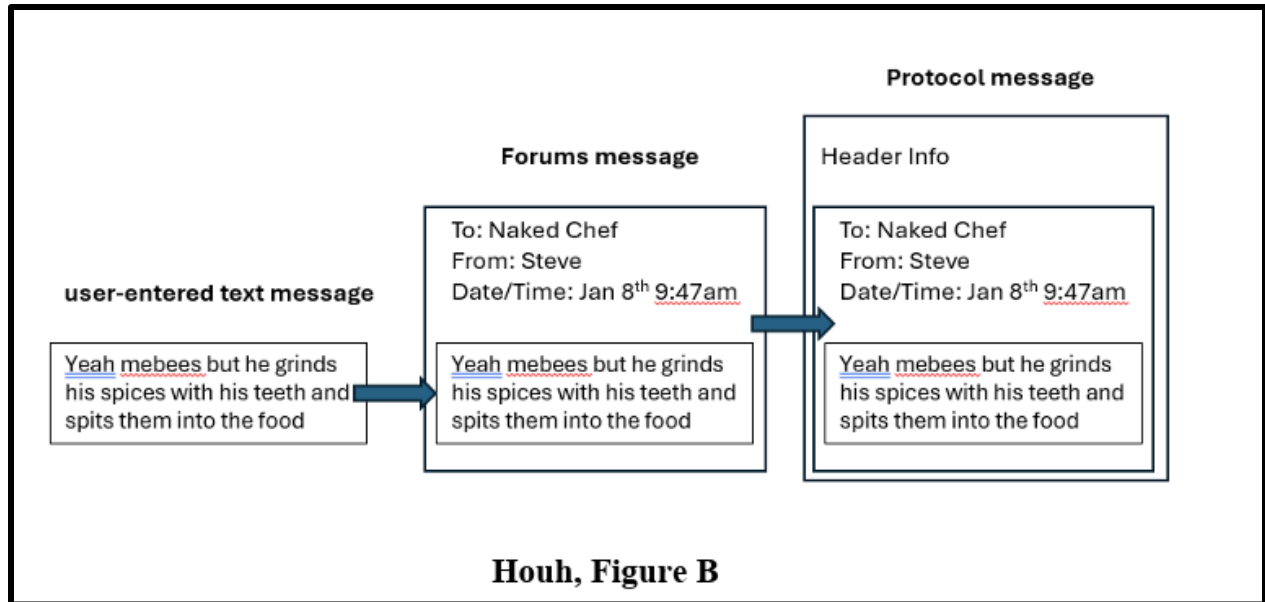
The Board's April 25, 2025 FAQs about the discretionary denial process states that because of the statutory requirement that "petitions [must] be based on prior art patents and printed publications," reliance upon expert testimony must meet two requirements. April 25, 2025 FAQs, Q.21. First, expert testimony must be "focused ... to provid[ing] helpful context or [] explain[ing] terms of art." April 25, 2025 FAQs, Q.21. Indeed, "*failure to provide focused expert testimony may weigh against institution.*" *Id.* Second, if a petitioner's reliance on expert testimony is "*extensive,*" it "*may suggest that the questions are better resolved in an Article III court,*" and thus weighs against institution. *Id.* Petitioners here have contravened both requirements regarding expert testimony.

**a) Petitioners' expert testimony is not focused to providing helpful context**

Petitioners' expert testimony is not "focused ... to provid[ing] helpful context." Petitioners' 216-page-long expert declaration for their 114-page Petition is not "focused expert testimony." Nor does it provide any helpful context. In fact,

contrary to the Board’s direction that “it is not necessary for an expert to explain every aspect of the prior art” (April 25, 2025 FAQs, Q.21), Petitioners’ expert testimony engages in a limitation-by-limitation obviousness analysis of the claims, and fills shortcomings in the prior art using only conclusory statements. Patent Owner presents examples here.

In discussing limitation 1[C]/18[E] for Ground 1, the expert testimony begins with a conclusory statement that “[t]he mobile device must also encapsulate the generated Forums message into a protocol message to be transmitted by over wireless network, as I illustrate in my Figure B below.” Ex.1003, ¶160. Other than his say-so, the expert offers no evidence supporting a conclusion that a message sent via Forsyth’s Forums is encapsulated into a protocol message. In fact, the expert concedes that “neither Randall nor Forsyth provides the details of the wireless messaging functionality of GSM-SMS or WAP.” *Id.* Nevertheless, he goes on to state that his conclusory opinion is “well-known to and within the general knowledge of a POSITA.” *Id.* Thus, the expert assumes without providing any explanation that the Forums message in Forsyth is somehow converted into a protocol message. For support, he cites his own made-up drawings, resulting in merely a circular argument. *Id.* Furthermore, it should go without saying that the expert’s drawings are not proper prior art in this proceeding.



Houh, Figure B

In the next few paragraphs, the expert cites Exhibits 1015 and 1014—references that are not included in any Asserted Ground—to discuss GSM and WAP functionality. Ex.1003, ¶¶162-164 (referencing disclosures in Exs.1015 and 1014). The expert does so to fill the gap he admits exists in Randall and Forsyth. But Forsyth is directed at neither WAP nor GSM and, as such, the expert’s explanation of “the wireless messaging functionality of GSM-SMS or WAP” does not constitute “providing helpful context” to understand any teaching of Forsyth. It is an attempt to gap-fill the prior art’s teachings by expert testimony.

In fact, Forsyth does not mention even once “WAP” or “Wireless Application protocol,” and teaches away from GSM-based platforms: “Wireless information devices based on the Symbian OS platform, are ‘smarter’ than current generation GSM phones in being able to offer multiple, advanced, robust client based applications.” Forsyth at 1:32-35. Forsyth specifically lists fundamental weaknesses

associated with GSM phones making it unsuitable for Forsyth, e.g., “no single system fully and successfully accommodates the unique characteristics of communicating between groups of mobile users.” Forsyth at 1:54-60.

As a further example, in his analysis of Ground 2, Petitioners’ expert relies on Eck’s disclosure of “PagerWorld” for limitation 1[B]/18[D]. Ex.1003, ¶289. Despite admitting that Eck “uses the word ‘PagerWorld’ in the [Multiple User Dungeon] title to reflect the communication means is paging,” the expert concludes that “a POSITA would have understood that such a MUD is equally applicable when the communication means is another messaging type such as SMS or messaging via a WAP protocol.” *Id.* But the expert provides no citation to any reference that supports, even remotely, his conclusion. The only support is his say-so.

Next, and in the same paragraph, the expert concocts yet another conclusory argument to establish that PagerWorld is “previously established.” The expert states that PagerWorld includes a client software and a server software. *Id.* From this he concludes that “[a]s such, PagerWorld is persistent,” and thus previously established, because “it remains in existence after individual users exit the world.” *Id.* But beyond pointing to Eck’s client-server architecture, Petitioners’ expert does not explain why Eck’s PagerWorld is persistent. He fails to cite any evidence to support his conclusory statement.

In fact, the expert’s conclusion is patently false. Having client and server

components does not mean an always-on or “persistent” service. Many portable-device applications (on game consoles or mobile devices) use a client/server model only ephemerally—the server runs only during an active session, then shuts down when the session ends. For example, in many local or peer-hosted multiplayer games, one device temporarily acts as a server for the duration of a match or session, but that server is not persistent beyond the session. *See* Ex.2038.

Importantly, in the context of peer-to-peer communication and file transfer, client-server architecture is commonly used in a non-persistent manner. For example, file-sharing applications establish a direct client-server link between devices on the fly. When a file is shared by one mobile device to another mobile device, the devices form an ad-hoc wireless network for the transfer. One mobile device serves the file (server), while the other receives (client). This “server” exists only for the duration of the file sharing; once the file is sent and the file-sharing session ends, the connection closes and no service remains running.

Such expert testimony “is particularly problematic in cases where, like here, expert testimony is offered not simply to provide a motivation to combine prior-art teachings, but rather to supply a limitation missing from the prior art.” *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 5 (P.T.A.B. Aug. 24, 2022) (precedential) (citing *Arendi S.A.R.L. v. Apple, Inc.*, 832 F.3d 1355, 1361-62 (Fed.Cir.2016)).

Accordingly, Petitioners' expert testimony fails to meet the standard set forth by the Board.

**b) Petitioner's reliance on expert testimony is "extensive"**

In addition to violating the requirement that expert testimony be focused on providing "helpful context," Petitioners also violate the requirement that their reliance on expert testimony not be "extensive." The overwhelming majority of the content of the Petition appears verbatim in Petitioners' expert testimony. Ex.2035 (providing numerous examples of copy-pasting from Ex.1003 into the Petition).

Importantly, as for the "wireless networking functionality" element in limitation 1[C], Petitioners rely exclusively on expert testimony to support an alternative argument.<sup>11</sup> Petitioners argue that "[t]he mobile device must further encapsulate the generated Forums message into a protocol message (e.g., GSM-SMS or WAP) to be transmitted over wireless network." Petition at 32-33. Instead of citing Randall or Forsyth for support and offering analysis in the Petition, Petitioners cite ¶¶160-164 of the expert testimony, which by itself constitutes impermissible incorporation by reference. *Cisco Systems, Inc. v. C-Cation Techs.*, IPR2014-00454, Paper 12 at 9 (P.T.A.B. Aug. 29, 2014) (informative) (providing that "practice of

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<sup>11</sup> As discussed below, Petitioners' first argument regarding this limitation 1[C] is weak and wholly deficient.

citing the Declaration to support conclusory statements that are not otherwise supported in the Petition also amounts to incorporation by reference”). Furthermore, Petitioners’ expert declaration does not qualify as a prior art in this proceeding. *Meta Platforms, Inc., et al. v. Eight kHz, LLC*, IPR2023-01023, Paper 10 at 31 (P.T.A.B. Jan. 9, 2024) (“We further note that several of Petitioner’s assertions are supported only by VR Book (Ex. 1063), which is not relied upon as the basis for this challenge, or Dr. Begault’s deposition testimony, **which does not qualify as prior art in this proceeding.**”).

In addition, these paragraphs of Petitioners’ expert declaration address references that are not relied upon as the basis for Petitioners’ Ground 1. *See* Ex.1003, ¶¶162-163 (discussing Ex.1015), ¶164 (referring to arguments made in §IV.A.1.c.(2) of the declaration with regard Ex.1014). Petitioners cannot rely—directly or indirectly through expert testimony—on references not asserted in Ground 1 to gap-fill a missing limitation in Randall and Forsyth. *See Meta Platforms, Inc.*, Paper 10 at 31 (P.T.A.B. Jan. 9, 2024) (“We further note that several of Petitioner’s assertions are supported only by VR Book (Ex. 1063), **which is not relied upon as the basis for this challenge**, or Dr. Begault’s deposition testimony, which does not qualify as prior art in this proceeding.”).

In fact, the reason Petitioners rely exclusively on their expert’s say-so for this limitation is that, as acknowledged by Petitioners’ own expert, “neither Randall nor

Forsyth provides the details of the wireless messaging functionality of GSM-SMS or WAP.” Ex.1003, ¶160.

As to Ground 2, Petitioners again copy-paste, almost verbatim, conclusory statements from their expert declaration into the Petition to provide a motivation to combine and to support limitations missing from Pelkey and Eck. See Table 2 below.

Table 2: Examples of verbatim copy-pasting from expert declaration into Petition’s Ground 2. Text in blue notes the differences between the declaration and Petition. See Ex.2035 at 20-22, #53; 25-26, #60.

Expert Testimony (Ex.1003)	The ‘536 Petition
<p><b>Motivation to Combine:</b></p> <p>Pelkey discloses the use of a network server and message server to facilitate game play and exchanging messages amongst users. <b>But it does not specifically disclose the integration of messaging and sharing content like photos and sound clips with other users within its client-server environment.</b> A POSITA would be motivated to apply the network and message server architecture in Pelkey to Eck in order to avoid the charge-based system for exchanging messages and photos via pager cartridge in Eck. In addition, a POSITA would be motivated to modify the “pager cartridge” in Eck as necessary to use PagerWorld in Pelkey given the disclosed benefits of PagerWorld including “exploration and adventure,” “chat and community interaction,” and “character growth.” (Eck, 10:13-19.) Notably, Pelkey does not describe any game play that includes in-game messaging in conjunction with the</p>	<p><b>Motivation to Combine:</b></p> <p>Pelkey discloses use of a network server and message server to facilitate game play and exchanging messages amongst users. A POSITA would be motivated to apply the network and message server architecture in Pelkey to Eck in order to avoid the charge-based system for exchanging messages and photos via pager cartridge in Eck. <b>(EX-1003, ¶272.)</b> In addition, a POSITA would be motivated to modify the “pager cartridge” in Eck as necessary to use PagerWorld in Pelkey given the disclosed benefits of PagerWorld including “exploration and adventure,” “chat and community interaction,” and “character growth.” <b>(Id.; EX1008, 10:13-19.)</b> Notably, Pelkey does not describe any game play that includes ingame messaging in conjunction with the aforementioned features. In addition, the combination is nothing more than the application of a known technique (Eck’s PagerWorld game) to a known</p>

aforementioned features. In addition, the combination is nothing more than the application of a known technique (Eck’s PagerWorld game) to a known method/product (Pelkey’s client-server based messaging server) which was ready for further improvement to achieve predictable results. Replacing the pager system infrastructure in Eck with the client-server architecture in Pelkey is the simple substitution of a one known element for another to achieve a predictable result (internet-based functionality).

Ex.1003, ¶272.

method/product (Pelkey’s client-server based messaging server) which was ready for further improvement to achieve predictable results. Replacing the pager system infrastructure in Eck with the client-server architecture in Pelkey is the simple substitution of a one known element for another to achieve a predictable result (internet-based functionality). **(EX-1003, ¶272.)**

**Supplying missing limitation:**

An exemplary MUD game described by Eck is “PagerWorld, a virtual community for the network of all users having pager cartridges.” (Eck, 10:20-23.) Although Eck uses the word “PagerWorld” in the MUD title to reflect the communication means is paging, a POSITA would have understood that such a MUD is equally applicable when the communication means is another messaging type such as SMS or messaging via a WAP protocol. PagerWorld includes client software in the portable game machine (client program) and corresponding software in the server (server program). (See Eck, 4:61-5:7, 9:40-59.) As such, PagerWorld is persistent—it remains in existence after individual users exit the world. PagerWorld is therefore a “previously established application-based information channel” under the agreed upon construction in the Meta-MDT-IPR because it is a “computer program-based medium for transferring information” among members of the PagerWorld community.

**Supplying missing limitation:**

An exemplary MUD game is “PagerWorld, a virtual community for the network of all users having pager cartridges.” (EX-1008, 10:20-23.) Although Eck uses the word “PagerWorld” in the MUD title to reflect the communication means is paging, a POSITA would have understood that such a MUD is equally applicable when the communication means is another messaging type such as SMS or messaging via WAP protocols. PagerWorld includes client software in the portable game machine (client program) and corresponding software in the server (server program). As such, PagerWorld is persistent—it remains in existence after individual users exit the world. PagerWorld is therefore a “previously established application-based information channel” under the agreed upon construction in the Meta-MDT-IPR because it is a “computer program-based medium for transferring information” among members of the PagerWorld community. **(EX-1003,**

Ex.1003, ¶289.	¶289.)
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As evidenced from the first entry in Table 2, Petitioners' sole basis for motivation to combine Pelkey and Eck is their expert's *ipse dixit* testimony which Petitioners copy verbatim from the expert declaration into the Petition. The only part of the expert's testimony that Petitioners omit is the portion that proves conclusively the expert's opinion is ***not*** based on the Ground 2 prior art references: "***But it [i.e., Pelkey] does not specifically disclose the integration of messaging and sharing content like photos and sound clips with other users within its client-server environment.***" Ex.1003, ¶272. And as discussed above, the second entry in Table 2 shows Petitioners' blatant attempt to gap-fill a missing limitation via conclusory expert testimony, contrary to well-established law. A "petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed.Cir.2016).

The Petition thus relies extensively on expert testimony that provides no helpful context in understanding key aspects of the Petition. The Board should weigh this factor in favor of discretionarily denying institution.

##### 5. The '536 Petition lacks merit

"A full merits analysis is not necessary as part of deciding whether to exercise

discretion not to institute, but rather the parties may point out, as part of the factor-based analysis, particular ‘strengths or weaknesses’ to aid the Board in deciding whether the merits tip the balance.” *Fintiv*, Paper 15 at 15. But even “compelling merits alone is not dispositive in making the [*Fintiv*] assessment.” March 24, 2025 Memo at 3; *see also Nokia Of America Corp v. Pegasus Wireless Innovation LLC*, IPR2025-00036, Paper 14, 17-18 (P.T.A.B. Apr. 25, 2025) (“We determine that the strength of the merits of Petitioner’s patentability challenges based on R3-173152, ... weighs against exercising discretion to deny institution of inter partes review. However, we determine that resolution of all of the disputes based on all of the issues between the parties regarding the challenged patent before the district court, which likely would occur many months before a subset of the issues could be resolved before the Board, would be more efficient and, therefore, weighs in favor of exercising discretion to deny institution of inter partes review. In sum, *we determine that the strength of the merits is obviated by the efficiency and timeliness of the parallel district court proceeding and, therefore, determine that considerations of the sixth Fintiv factor are neutral.*”). Accordingly, the Board need not engage in an assessment of merits, because of the strength of other factors and considerations, which suffice for *Fintiv* purposes. If, however, the Board considers an assessment of merits in its holistic approach to *Fintiv*, the ‘536 Petition is weak.

Finally, while Patent Owner addresses the merits of both Grounds asserted by

Petitioners, a showing that Petitioners have failed to meet their burden as to one Ground suffices to discretionarily deny institution. *See Samsung Electronics Co Ltd et al. v. Kp Innovations 2 LLC*, IPR2025-00101, Paper 13, 27-28 (P.T.A.B May 12, 2025). If the Board institutes review based on a determination that Petitioners have shown a reasonable likelihood of prevailing *on only one ground*, under *SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 373 (2018), the Board still must consider the other ground. *See BioDelivery Sciences International, Inc. v. Aquesitive Therapeutics, Inc.*, 898 F.3d 1205, 1209 (Fed.Cir.2018) (“We agree that *SAS* requires institution on all challenged claims and all challenged grounds.”). But it would not be an efficient use of the Board’s time and resources to institute review in such a case. *See Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10-11 (P.T.A.B. Nov. 7, 2018) (informative); *see also Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 at 41-43 (P.T.A.B. Jan. 24, 2019) (informative). As established below, Petitioner has not met its burden on either of the Grounds. Even if the Board determines Petitioner has met its burden on one of the Grounds, however, the Board should still exercise discretion to deny institution of all Grounds under *SAS*. *See Samsung Electronics Co Ltd et al.*, IPR2025-00101, Paper 13 at 27-28.

**a) Ground 1 Fails to Identify Disclosures that Teach Claim Limitations Present in Each Independent Claim**

Ground 1 of the Petition suffers from fatal weaknesses regarding multiple limitations present in each independent claim. Namely, Petitioners fail to plausibly identify disclosures that teach the individual limitations, and Petitioners' arguments are inconsistent.<sup>12</sup>

**(1) 1[B]/18[D]: “identifying a previously established application-based information channel”**

Petitioners' theory of obviousness centers around the notion that Forsyth's Forums is an application and that an individual Forum is an “application-based information channel.” *See* Petition at 24-30. Petitioners contend that within the Forums application, a user can create an individual Forum for group based text messaging by identifying the group of users “whom [the user] wishes to invite.” Petition at 24-25. With regard to 1[B]/18[D], Petitioners assert that “an individual Forum is ‘application-based information channel.’” Petition at 27. Creation of an individual Forum is enabled via utilization of a “group object” within Forums:

***Forums runs on the object based operating system Symbian OS. In Forums, a new group object can be created*** when a user defines the recipients of a message, or (going beyond a simple messaging

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<sup>12</sup> Consistent with Petitioners' approach, Patent Owner treats independent “mobile device” claims 1 and 18 together and treats “server-side” independent claims 19 and 23 together and with reference to overlapping limitations 1 and 18.

application) whenever the user defines the desired participants to be involved in group communication.

Forsyth at 2:47-52. Specifically, Forsyth states that the group object is application independent:

**Fundamental to Forums is the idea of there being an object which defines solely the identities of members of a group:** as such, it is content and **application independent.**

Forsyth at 5:15-17.

**Each group exists as an application independent object** and can hence be accessed by different applications and used for a wide variety of purposes—whenever an application designer wishes to include some kind of group communication functionality.

*Id.* at 5:55-60; *see also id.* at 2:37-39 (“No earlier system includes the concept of the content and **application independent ‘group’ object.**”). Thus, it is undisputed that the group objects created in Forums are application independent, per Forsyth’s express teaching. As such, contrary to Petitioners’ arguments, an individual Forum is not an *application-based* information channel. Neither Petitioners nor their expert explain how an “application independent” channel can be “application-based.”

Petitioners’ arguments regarding limitation 19[A]/23[C] suffer from the same issues and deficiencies.

**(2) 1[C]/18[E]: “determin[ing]/[e] information associated with at least one wireless networking functionality of the mobile device”**

In connection with limitation 1[C]/18[E], Petitioners’ argue that Randall-Forsyth teaches the recited “wireless networking functionality,” relying on encapsulation of sender name, date/time, and Forum name in a protocol (e.g., GSM-SMS or WAP) message. But it is admitted that neither Randall nor Forsyth describe any details of a protocol message or such encapsulation.

It is undisputed that neither Randall nor Forsyth have any express teaching as to the details of any “protocol message” encapsulation or that the mobile device ever determines or provides to a server any information tied to a specific wireless networking functionality. While Petitioners identify Randall’s and Forsyth’s passing references to the use of wireless networks, such as GSM-SMS and WAP (Petition at 30), Petitioners’ expert admits that “neither Randall nor Forsyth provides the details of the wireless messaging functionality of GSM-SMS or WAP.” Ex.1003, ¶160. Neither reference provides detailed explanation of a protocol message or how it may relate to wireless networking functionality of the mobile device. Petitioners thus resort to their expert’s explanation, repeating much of it *verbatim*. See, *supra*, §II.F.4.

More specifically, Petitioners improperly advance a theory based on their expert’s say-so: “The mobile device must further encapsulate the generated Forums

message into a protocol message (e.g., GSM-SMS or WAP) to be transmitted over wireless network.” Petition at 32-33 (citing five paragraphs of the expert declaration). Petitioners rely on its expert—essentially verbatim—including by reproducing an illustration he created whole-cloth—“Houh, Figure B.” Petition at 33; EX-1003, ¶160. Petitioners conclude that “information associated with the protocol message implemented by the wireless network (e.g., message type, content type)” is also the claimed “information associated with [a] wireless networking functionality of the mobile device.” Petition at 34. Despite the ‘039 Patent explicitly acknowledging that communication protocols, such as WAP, can be used, it does not identify this standard protocol header information as the claimed “information associated with [a] wireless networking functionality of the mobile device.” Petitioners’ exclusive reliance on their expert not only highlights the deficiencies in Randall and Forsyth. And as explained above, the expert impermissibly relies upon a “reference” not included in Ground 1. *See, supra*, §II.F.4 (citing *Cisco Systems, Inc. v. C-Cation Techs.*, IPR2014-00454, Paper 12 at 9 (P.T.A.B. Aug. 29, 2014) (informative) (providing that “practice of citing the Declaration to support conclusory statements that are not otherwise supported in the Petition also amounts to incorporation by reference”); *Meta Platforms, Inc., et al. v. Eight kHz, LLC*, IPR2023-01023, Paper 10 at 31 (P.T.A.B. Jan. 9, 2024) (“We further note that several of Petitioner’s assertions are supported only by VR Book (Ex. 1063), which

is not relied upon as the basis for this challenge, or Dr. Begault’s deposition testimony, which **does not qualify as prior art in this proceeding.**”)).

While use of GSM-SMS or WAP may indicate that the mobile device sends a Forums message via a wireless network, neither Forsyth nor Randall teaches that any information is separately **determined about the wireless networking functionality of the mobile device** (or associates it with the content, as addressed further, below in connection with limitation 1[D]/18[F]). In Forsyth’s scenario, the device simply transmits the user’s text over whatever protocol is available. Forsyth, 1:22-24. Randall adds nothing, merely mentioning that GSM and other networks could be used (*See* Randall, 1:11-13) and never providing detail on any protocol message content. *See* § II.F.4.

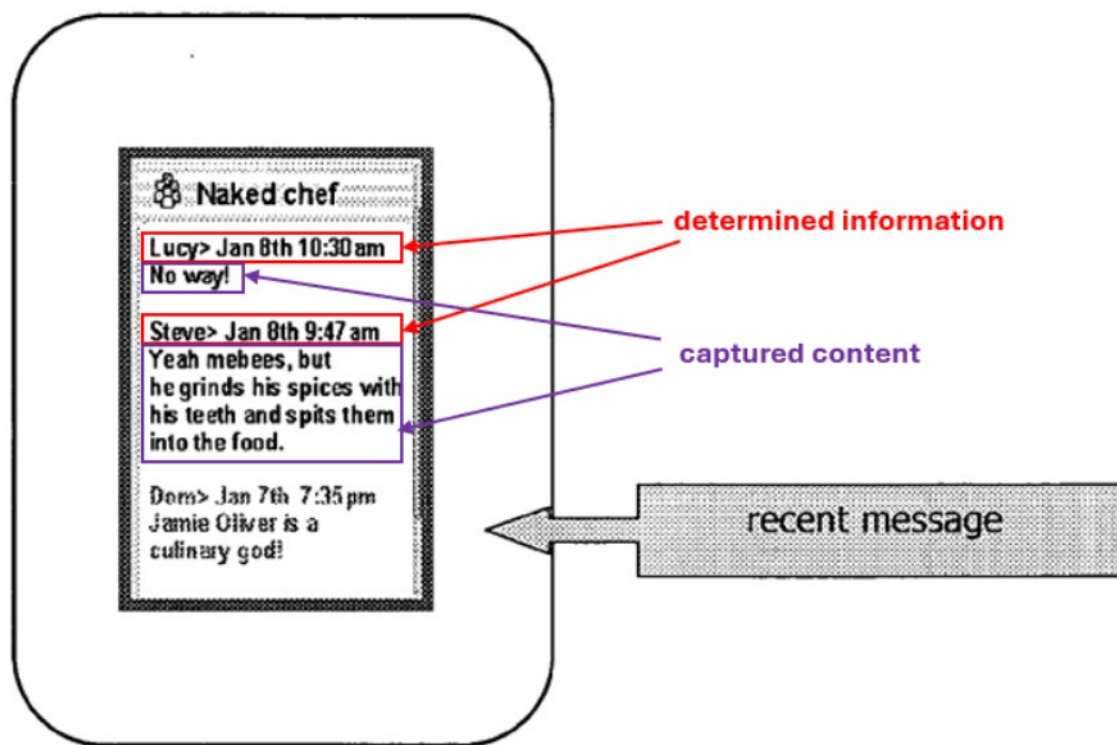
Petitioners’ arguments regarding limitation 19[B]/23[D] suffer from the same issues and deficiencies.

- (3) **1[D]/18[F]: provid[ing]/[e via said at least one network interface,] the captured content from the mobile device to at least one server for insertion in association with the determined information into the identified application-based information channel**

In connection with limitation 1[D]/18[F], Petitioners fail to identify any specific teaching or suggestion of providing captured content “in association with the determined information” (the “determined information” being that “associated

with at least one wireless networking functionality of the mobile device” (1[C])). As such, Petitioners fail to present a prima facie case of obviousness.

In addressing 1[D]/18[F], Petitioners also rely on determined information—sender name, date/time, and Forum name (shown in Petitioners’ annotated Forsyth, Figure 7 (below))—being provided with captured content *as encapsulated within a GSM-SMS or WAP protocol message*:



Symbian Forums—Forsyth, Figure<sup>13</sup>

The “*determined information associated with*” the action of sending the Forums message (e.g., sender name, date/time, Forum name) is **provided** along with the text message entered by the user (captured

<sup>13</sup> Forsyth, Figure 7, as annotated by Petitioners. Petition at 39.

content) **in the protocol message sent to the server.** (§V.B.1.b.3.) **As shown by Forsyth’s Figure 7 above,** this “*determined information*” (user identity, date/time, forum name) **is inserted “into the identified application-based information channel” with the “captured content”** and displayed on the Forum (Naked Chef) screen for each forum member. (EX-1003, ¶177).

Petition at 39. Such argument is facially flawed.

As an initial matter, as discussed above and admitted by Petitioners’ expert, “neither Randall nor Forsyth provide the details of the wireless messaging functionality of GSM-SMS or WAP” (EX-1003, 160), so Petitioners impermissibly rely on their expert and references not included within Ground 1. *See, supra*, §II.F.4.

Moreover, contrary to Petitioners’ argument and their expert’s assertion, Forsyth fails to teach or suggest sender name, date/time, and Forum name being “provided along with the text message entered by the user (captured content) in the protocol message sent to the server.” Petition at 39. Forsyth includes no discussion of such information being contained in a message from the mobile device to the server, and Petitioners point to none. Instead, Petitioners again rely on the unsupported, *ipse dixit* of their expert.

The only stated rationale for Petitioners’ (and their expert’s) position is the inclusion of the Forum name, user identity, and day/time in Forsyth’s Figure 7. Petition at 39 (“As shown in Figure 7 ...”). However, merely displaying the information does not support Petitioners’ and their expert’s statement that the information is “provided in the protocol message sent to the server.” Petition at 39.

Indeed, in Forums there is no reason for such information to be sent to the application-based information channel for “interaction between a user of the mobile device and one or more additional users”. ‘039 Patent, 1[B]/18[D]. As described in Forsyth and illustrated in the user interfaces of Figures 6-9 (relied on by Petitioners elsewhere),<sup>14</sup> a user selects a previously established Forum (e.g., Naked Chef) (Figure 6) and after selecting “Forum Reply,” the user enters a text message, which is posted to the selected Forum. Contrary to Petitioners and their expert, there is no reason for the mobile device message to include in the message the user identity, as the system already knows which user is logged into the system (having presented him/her with their individualized list of available Forums), or the Forum name (the user having already selected the particular Forum);<sup>15</sup> any user name, timestamp or Forum name may be added by the server as a matter of course, not because the

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<sup>14</sup> See, e.g., Petition at 28 (when addressing “identify[ing] a previously established application-based information channel” of 1[B]/18[D], explaining Figure 6 presents a user’s list of Forums and allows selection of one to “navigate[] to a screen associated with the Forum (e.g., Forsyth Figure 8)”); *id.* at 23 (explaining a user selecting “Forum Reply” (Figure 8) and “input[ting] a text message which ‘is posted to the Forum’” (Figure 9)).

<sup>15</sup> See *supra* note 14.

mobile device determined this information and sent it to the server, as required by the claim language.

Petitioners' arguments regarding limitation 19[C]/23[E] suffer from the same issues and deficiencies.

**(4) Petitioners' 1[B] and 1[C] Arguments are Contradictory**

**(a) Petitioners confuse “group based text messaging” capability with claimed “wireless networking functionality of the mobile device”**

Furthermore, Petitioners' argument regarding limitation 1[B]/18[A] is at odds with their 1[C]/18[E] argument. For 1[B], Petitioners cite “group based text messaging” as an example of creating a Forum within Forums. Petition at 25-26 (“Forsyth’s ‘group based text messaging’ Scenario 1 describes an example of creating a Forum (channel) within Forums.”). For 1[C], Petitioners contend that the same group based text messaging “is a functionality implementable by the mobile device via the wireless network.” Petition at 31. Accordingly, Petitioners rely on Forsyth’s group based text messaging teaching both limitation 1[B]’s “previously established application-based information channel” and limitation 1[C]’s “mobile device wireless networking functionality.” Petitioners’ approach underscores their misunderstanding of Forsyth, the ‘039 Claims, and the law.

Petitioners misconstrue Forsyth by mapping its disclosure of “group based text messaging” to the claimed “wireless networking functionality.” But Forsyth’s reference to “group based text messaging” is not a “wireless networking functionality” of the mobile device—it is a capability of Forums, which is an application as Petitioners acknowledge.

Petitioners admit that “group based text messaging” is no more than a capability of Forums, which Petitioners contend to be the claimed application (Petition at 25): “Forums is a ‘messaging tool that facilitates open discussion amongst a group’ including through ‘group based text messaging’ and ‘group based multi-media messaging.’” Petition at 23; *see also* Petition at 31 (“Forums supports ‘group based text messaging’ and ‘group based multi-media messaging.’”).

Forsyth itself confirms that Forums uses group objects to initiate group based text messaging. Forsyth at 3:35-45. A group object, Forsyth explains, is “a collection of information that describes or references at least the minimum amount of information about 2 or more entities (usually individual ...) required for activities to be engaged in between them.” Forsyth at 2:17-22. In the context of text messaging, Forsyth explains that “the collection of information” required to create a group object is information about the participant in the group: “In Forums, a new group object can be created when a user defines the recipients of a message.” Forsyth at 2:48-49. Forums supports “group based text messaging” by allowing a

user to select “a group of participants”—which is stored as an “application independent object”—to create a Forum. Forsyth at 5:50-62. Thus, Forsyth’s “group based text messaging” is a capability of Forums. Forums supports a text messaging activity because it is a “messaging tool.” Forsyth at 5:27-30. It is group based because “[i]n Forums, a new group object can be created when a user defines the recipients of a message, or (going beyond a simple messaging application) whenever the user defines the desired participants to be involved in group communication.” Forsyth at 2:48-53. Contrary to Petitioners’ mischaracterization (Petition at 31), Forsyth’s reference to “group based text messaging” is not a “wireless networking functionality of the mobile device”—it is a capability of Forums, which is an application, as Petitioners argue.

**(b) Petitioners fail to identify anything in Forsyth that teaches or suggests the claimed “information associated with [a] wireless networking functionality of the mobile device”**

Worse yet, because Petitioners confuse Forums’ “group based text messaging” capability with the claimed “wireless networking functionality of the mobile device,” they fail to identify any passage in Forsyth that teaches or suggests the claimed “information associated with [a] wireless networking functionality of the mobile device.” Unable to do so, Petitioners again resort to their expert declaration as gap-filler. Petitioners first argue that “information associated with the Forums

message (sender identity, date/time, and Forum name)” is the claimed “**information associated with** ... wireless networking functionality.” Petition at 34. Specifically, Petitioners falsely assume that because Forums’s messaging action is a wireless networking functionality of the mobile device, information about the message is “**information associated with** ... wireless networking functionality.”

These scenarios/examples also demonstrate the mobile device “determin[es] information specifying” the “messaging action” (send a message). Specifically, the mobile device must create a Forums message by (1) determining the sender (i.e., identity of the user in the Forum (e.g., Steve)) and the Forum name (e.g., Naked Chef) and (2) combining that information with the text, image, etc. provided by the user.

Petition at 32.

But this is patently false and inconsistent with Petitioners’ other arguments. First, Petitioners argue regarding limitation 1[A] that the Forums message is the claimed content: “The text message entered into the user interface is captured at the wireless device.” Petition at 23. Thus, information about the Forums message is at best information about the claimed content—not “**information associated with** ... wireless networking functionality.” Second, as explained above, Petitioners contend that a Forum created in Forums is the claimed “information channel.” Petition at 24-25, 28. Thus, information about the Forum’s name or its participants is at best information about the claimed information channel—not “**information associated with** ... wireless networking functionality.”

**(c) Petitioners’ alternate theory that the mobile device “must” further encapsulate the generated Forums message into a protocol message is based only on unsupported expert testimony**

Unable to point to any disclosure in Forsyth or Randall for limitation 1[C], Petitioners advance an alternative theory based on their expert’s say-so: “The mobile device must further encapsulate the generated Forums message into a protocol message (e.g., GSM-SMS or WAP) to be transmitted over wireless network.” Petition at 32-33 (citing five paragraphs of the expert declaration). Petitioners conclude that “information associated with the protocol message implemented by the wireless network (e.g., message type, content type)” is also the claimed “information associated with ... wireless networking functionality.” Petition at 34. But as explained above, Petitioners’ reliance on their expert declaration highlights a deficiency in their alternative argument for limitation 1[C]/18[E]: “neither Randall nor Forsyth provides the details of the wireless messaging functionality of GSM-SMS or WAP.” Ex.1003, ¶160.

As shown above, Petitioners’ confusion about the scope and meaning of limitations 1[B] and 1[C] led them to take inconsistent positions. Setting that aside, blurring the line between “previously established application-based information channel” and “mobile device wireless networking functionality” is problematic under well-established law. Petitioners and their expert fail to explain how two

separately recited claim elements are met by the same prior art feature, i.e., “group based text messaging.” *Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249 (Fed. Cir. 2010) (“Where a claim lists elements separately, ‘the clear implication of the claim language’ is that those elements are ‘distinct component[s]’ of the patented invention.”).

**b) Ground 2 Fails to Identify Disclosures that Teach Claim Limitations Present in Each Independent Claim**

Ground 2 of the Petition asserts that the combination of Pelkey (Ex.1007) and Eck (Ex.1008) discloses or renders obvious every element of the independent claims of the '039 patent. This ground also fails. First, Petitioners' explanation to combine Pelkey and Eck is nothing more than impermissible hindsight. Second, neither Pelkey nor Eck, alone or in combination, teaches all limitations of the challenged claims. Third, Petitioners also rely on improperly assumed interfaces and messaging behaviors that are not disclosed in either reference. These deficiencies are not minor gaps; they go to explicit claim limitations.

**(1) Petitioners fail to identify a basis to combine Pelkey and Eck**

Petitioners fail to identify any plausible motivation to combine the teachings of Pelkey and Eck. Petitioners merely state, without support, that a “POSITA would have been motivated to combine Eck’s teachings regarding PagerWorld with the network and message server architecture taught in Pelkey.” Petition at 62.

As an initial matter, the holes in Petitioners' argument are particularly notable given their admissions as to the deficiencies of Pelkey and Eck. Admitted deficiencies include:

(i) Eck does not describe a client-server structure as taught in Pelkey (Ex.1003, ¶271; Petition at 62-63);

(ii) Pelkey does not describe integration of messaging and sharing content like photos with multiple users (Ex.1003, ¶272);

(iii) Pelkey does not describe any in-game messaging (Ex.1003, ¶272; Petition at 63); and

(iv) Pelkey does not disclose details of the wireless network used to provide wireless messaging from the game system to the server (Petition at 75; Ex.1003, ¶300).

Petitioners argue that a "POSITA would be motivated to apply the network and message server architecture in Pelkey to Eck in order to avoid the charge-based system for exchanging messages and photos via pager cartridge in Eck. (EX-1003, ¶272.)" Petition at 63. This is contrary to the teaching of Eck, which solves any issue regarding "cost" an entirely different way. Specifically, Eck teaches that a user can turn to "user-generated custom libraries of words, phrases and graphics" to reduce

message length. This practice is called “coding,” which Eck expressly acknowledges can be used “to reduce message length” and thus “reduce message charges.” Eck, 16:59-60; *see also id.* 16:49-63 (“It can be seen that by using ‘coding’, the length of the messages may be reduced.”). Petitioners and their expert point to no evidence to support a combination of Pelkey and Eck based on cost reduction, failing to address the additional costs of the proposed modification (e.g., communication and bandwidth costs of the proposed network and message server architecture) or the specific savings that would motivate the combination or prompt a user to switch to GSM-SMS or WAP. *In re Schmidt*, 892 F.2d 1051, \*2 (Fed. Cir. 1989) (“[W]hile we agree that cost saving may serve as a motive for making a modification, **it must be clear at least that the modification, in fact, effects a reduction in the cost.**”).

Petitioners continue that “a POSITA would be motivated to modify the ‘pager cartridge’ in Eck as necessary to use PagerWorld in Pelkey given the disclosed benefits of PagerWorld including ‘exploration and adventure,’ ‘chat and community interaction,’ and ‘character growth.’” Petition at 63 (citing Ex.1003, ¶272; Ex.1008, 10:13-19). The statement is nonsensical: it admits that Eck, through its pager cartridge, already provides the benefits of ‘exploration and adventure,’ ‘chat and community interaction,’ and ‘character growth,’ so why would its structure and operation need to change? *See* Eck, 10:1-19 (explaining an application of “pager

cartridge 100” is Multiple User Dungeon (MUD) games that provide these benefits). Petitioners do not answer this question. Instead, the statement highlights their use of impermissible hindsight.

Finally, Petitioners parrot their expert’s conclusory opinions that Eck’s PagerWorld game is a known technique, Pelkey’s client-server based messaging server is a known method/product, and “[r]eplacing the pager system infrastructure system in Eck with the client-server architecture in Pelkey is the simple substitution of one known element for another to achieve a predictable result (internet-based functionality).” Petition at 63 citing EX-1003, ¶272. But the expert never explains what those modifications would be given differences in operation and architecture. Indeed, the expert provides no explanation of how a pager cartridge could be replaced with a hypothetical “GSM-SMS or WAP cartridge” in the system of Eck.

Petitioners have thus failed to provide a sufficient explanation of the combination of Pelkey and Eck or the motivation to combine them. This applies to all ‘039 Patent claims.

**(2) The hypothetical combination of Pelkey and Eck does not teach limitations of the independent claims**

Even if the combination of Pelkey and Eck were proper, Petitioners fail to present a prima facie case that the combination teaches the “previously established application-based information channel...,” as recited in limitation 1[B]/18[D] and

limitation 19[A]/23[D]. Here, again, Petitioners rely on the unsupported conclusions of their expert.

Parroting their expert, Petitioners argue that “PagerWorld” is persistent and thus a “previously established” information channel:

PagerWorld includes client software in the portable game machine (client program) and corresponding software in the server (server program). **As such, PagerWorld is persistent**—it remains in existence after individual users exit the world. PagerWorld is therefore a ‘previously established application-based information channel’....

Petition at 71 (citing Ex.1003, ¶289).

But as established above, there is no support for the conclusion that persistence—remaining in existence after individual users exit, as Petitioners contend—necessarily results from having both a client program and a server program. Nothing indicates that the architecture dictates this functionality. The only additional information in the expert’s cited paragraph not in the quoted portion of the Petition is a citation to Eck. *See* Ex.1003, ¶289 (citing Eck, 4:61-5:7, 9:40-59). But these cited passages merely described generally how to use Eck’s game machine (e.g., insert game cartridge in the slot, operate power switch) (*See* Eck, 4:61-5:7) and the general pager functionality (e.g., pager cartridge provides two-way paging and is addressable, messages may be from system operator); neither portion relates specifically to PagerWorld. Petitioners’ position that PagerWorld is persistent by virtue of it having both client and server programs is baseless.

Additionally, neither Pelkey nor Eck teaches the server-side operations required by claims 19, 22, and 23. Those claims recite that the server receives both the captured content and the associated information and integrates them into the shared information channel (Ex.1001, 20:20–37, 20:47–21:5). While both Pelkey and Eck describe server infrastructure, neither discloses the server performing any integration of content and networking information. Pelkey’s web server relays user messages between consoles (Pelkey, 5:36–48), but does not disclose assembling or curating integrated content. Eck’s messaging backend is similarly silent in this regard. Petitioners’ expert states that content is integrated “by virtue of appearing within the PagerWorld environment” (Ex.1003, ¶160), but does not explain what integration occurs or how. Petitioners have thus failed to identify any teaching of the claimed server-side processing and storage of combined content and contextual information.

**G. Holistic Assessment of *Fintiv* Factors and Considerations Weighs in Favor of Denying Institution**

On balance, the evidence of record favors exercising discretion to deny institution of the ‘536 IPR on *Fintiv* grounds.

**III. CONCLUSION**

Appropriate analysis under the framework described in *Fintiv* based on the evidence of record favors exercising discretion to deny institution of the ‘536 IPR.

Date: May 14, 2025

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**CERTIFICATE OF WORD COUNT**

Pursuant to 37 C.F.R. §42.24(d), the undersigned hereby certifies that the foregoing Patent Owner's Discretionary Denial Brief contains 13,732 words using the word count feature of Microsoft Word.

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