

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MOBILE DATA TECHNOLOGIES LLC,
Patent Owner

IPR2025-00536
U.S. Patent 9,032,039

**PETITIONERS' RESPONSE TO PATENT OWNER'S
DISCRETIONARY DENIAL BRIEF**

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Patent Trial and Appeal Board
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I. Introduction

Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. (“Petitioners” or “Samsung”) respectfully request that the Director decline to exercise discretionary denial and refer a three-member panel of the Board to consider the merits of the Petition against U.S. Patent 9,032,039 (“the ’039 patent”; EX-1001.)

The Board previously instituted IPR against five of the challenged claims (claims 19-23) on June 11, 2024 based on a petition filed by Meta Platforms, Inc. *See* IPR2024-00248 (the “Meta-MDT-IPR”), Paper 11. The Meta-MDT-IPR was scheduled for oral argument on March 11, 2025. But, just days before the hearing, PO settled its dispute with Meta, thus avoiding a Final Written Decision invalidating claims of the ’039 patent (and other related patents challenged by Meta).

Prior to PO’s March 2025 settlement, Petitioners filed parallel IPR Petitions on January 31, 2025, asserting (1) prior art Petitioners identified in this proceeding and (2) prior art from the Meta-MDT-IPR and related IPR proceedings in IPR2025-00535. In both proceedings, PO has asked the Director to exercise discretionary denial, seeking yet again to avoid an invalidity finding against the ’039 patent. PO even goes so far as to accuse Petitioners of abusing the IPR process. Yet it is PO that has attempted to game the system—rather than proceed to

a Final Written Decision in the Meta-MDT-IPR, PO settled with Meta right before the hearing, which completely belies any argument by PO about the supposed strength of its patent. Exercising discretionary denial against a patent for which the Board already instituted IPR would directly contradict Congress's purpose in enacting the AIA, which sought to "improv[e] patent quality and provid[e] a more efficient system for challenging patents that should not have issued." H.R. Rep. No. 112-98, 39-40 (2011) ("House Report"). PO's gamesmanship should not be rewarded. Indeed, exercising discretion to deny the pending petition would perversely incentivize patent owners facing instituted *inter partes* review to settle such proceedings (while still straining Board resources through the institution phase) and file serial litigation against another defendant in the same technical field in order to inoculate their patents from Board review.

Moreover, as discussed in greater detail below, Petitioners herein have amended their *Sotera* stipulation to ensure that institution of IPR proceedings presents a "true alternative" to district court litigation.

Accordingly, Petitioners respectfully submit that the Director should not exercise discretionary denial. As noted in its brief opposing discretionary denial in IPR2025-00535 (Paper 9, 16-17), Petitioners recognize that the Board may not have the resources to address two petitions directed to the '039 patent. Petitioners likewise recognize (i) that the Board may wish to proceed solely based on the

Neibauer grounds set forth in IPR2025-00535 given the Board's investment in analyzing and understanding these references in the Meta IPR proceedings and/or (ii) that the Board may only wish to proceed with one set of grounds against the five patents challenged by Petitioners in IPR Nos. 2025-00535-544.

For the '039 patent, Petitioners ranked the IPR2025-00536 petition higher than the Petition in IPR2025-00535 because Petitioners are challenging 16 claims in the patent not challenged by Meta. (*See* Paper 3, 2.) Put another way, Petitioners ranked the IPR2025-00536 petition higher because the Board would need to make some additional investment in analyzing the prior art regardless of which set of grounds was selected. While Petitioners prefer to proceed with the new grounds set forth in the IPR2025-00536, they are prepared to proceed on the grounds set forth in IPR2025-00535 if that is the Board's preference. Additionally, for the four other patents challenged in IPR2025-00537-544, Petitioners are similarly prepared to follow the Board's preference if it determines to institute IPR on only one set of grounds common across all five challenged patents.

II. Factual Background

A. Samsung Is an Innovator

Samsung is one of the most innovative companies in the world. Since 2020, Samsung has been awarded over 27,000 U.S. patents—the most of any company—including patents in cellular technologies, smartphone user interfaces, biometrics,

OLED displays, chip fabrication, and battery technologies. Samsung commercializes these innovations into hundreds of products and services across dozens of industries, including smartphones, cellular base stations, televisions, semiconductors, batteries for consumer products and electric vehicles, and household appliances like refrigerators, dishwashers, microwaves, and washing machines.

B. Patent Owner Mobile Data Technologies, LLC

PO is a Delaware limited liability company founded July 15, 2019. (EX-1029; EX-1030, ¶1.) According to PO, it “specializes in mobile technologies and social media solutions.” (EX-1030, ¶1.) However, PO has no online presence (no website or social media) and provides no products or services relating to “mobile technologies and social media solutions” or otherwise. Indeed, PO admitted in litigation that it has no product that practices the alleged invention of the ’039 patent. (EX-2026, 11 (“MDT does not assert that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention.”).)

Since its creation, PO’s only publicly known activity appears to have been the April 1, 2022 purchase of six related patents, including the ’039 patent (*see* EX-1031), and, as discussed further below, the subsequent assertion of those patents against Meta in November 2022 and against Petitioners in June 2024.

PO's litigation efforts are funded, at least in part, by a litigation funder named LIT-US Chisum 22-B LLC ("Chisum"); PO assigned a security interest in the '039 patent to Chisum on September 29, 2022, just before PO filed suit against Meta. (EX-1032.) Chisum's business is to fund patent litigations. (*See, e.g.*, EX-1033 (Entangled Media Dkt. No. 254), 1 ("[Plaintiff] has received and continues to receive litigation funding from non-party LIT-US Chisum 22-B LLC ... with respect to this litigation."); EX-1034, 3 ("[Plaintiff] entered into a financing transaction in September 2022, a portion of which included granting a security interest in the '494 Patent to LIT-US CHISUM 22-B LLC").)

C. PO's Prior Proceedings Against Meta

1. MDT Sues Meta in the MDT-Meta-Litigation

On November 23, 2022, PO filed suit against Meta Platforms, Inc. ("Meta") and Meta Platforms Technologies, LLC alleging infringement of the '039 patent, among other patents.¹ (EX-1035.) PO accused "Defendants' social media mobile applications and related software, including without limitation those made available under the Facebook brand" of infringement. (*Id.*, ¶88.)

¹ PO originally sued Meta in the Western District of Texas. Judge Albright granted Meta's motion to transfer to the Northern District of California. Prior to settlement, the case was captioned *Mobile Data Techs. LLC v. Meta Platforms, Inc.*, No. 3:24-cv-00896-WHA (N.D. Cal.) (the "MDT-Meta-Litigation").

2. The Instituted IPR Proceeding Against the '039 Patent

On December 6, 2023, Meta filed a petition for IPR challenging claims 19-23 of the '039 patent. IPR2024-00248, Paper 2. Ground 1 challenged claims 19-20, 22-23 based on Neibauer, Cheng, and Squibbs; Ground 2 challenged claim 21 based on those references in further view of Bandera. *Id.*, 3. Meta also raised Grounds 3-4 in further view of Harvey to account for a potential construction of “*application-based information channel*” Meta proposed in the MDT-Meta-Litigation. *Id.*, 3, 11.

On June 11, 2024, the Board instituted IPR of the '039 patent. IPR2024-00248, Paper 11. In so doing, the Board declined PO's request to exercise discretionary denial under § 325(d), “disagree[ing] with Patent Owner that all of the references Petitioner is relying on are the same or substantially the same as references that were before the Office.” *Id.*, 14. The Board noted that “there is no dispute that neither Harvey nor Bandera was considered by the Office, nor that Harvey is not substantially the same as any reference that was before the Office.” *Id.* The Board also rejected PO's argument that Bandera is substantially the same as US 2005/0177645 to Dowling et al., which was presented during prosecution. *Id.*, 14-15.

On the merits, the Board found “there is a reasonable likelihood that Petitioner [Meta] will prevail in demonstrating that claim 19 is unpatentable as

obvious in view of Neibauer, Cheng, and Squibbs.” *Id.*, 26. The Board stated that, “on the present record, Neibauer teaches limitation 19a,” which is the only limitation PO disputed pre-institution. *Id.*, 23. In particular, the Board concluded that “the photo sharing feature of the Yahoo! club [in Neibauer] is, on the present record ... the ‘application-based information channel’ of claim 19.” *Id.*, 22.

The Board scheduled oral argument (for the ’039 and five other related patents asserted against Meta) for March 11, 2025. IPR2024-00248, Paper 12.

3. PO’s and Meta’s Conflicting and Changing Views on Claim Construction

In the MDT-Meta-Litigation and the Meta-MDT-IPR, the parties identified the following terms for construction. (EX-1009, 1-4; EX-1010, 8-17; EX-1011, 2-8.)

a. Mobile Device

MDT-Meta District Court	
PO	plain and ordinary meaning; alternatively, “a piece of handheld equipment”
Meta	“any type of portable information processing device capable of being configured for communication over a network, including but not limited to a mobile telephone, a personal digital assistant (PDA), a palmtop computer, a hand-held computer, a laptop computer, a tablet computer, a global positioning system (GPS) receiver or other GPS-based navigational device, an MP3 player or other type of audio player, a pager, a watch or other timepiece, a camera, or a portable game player”

Meta-MDT-IPR	
PO	“a portable device with limited display space and limited navigational capabilities that connects to a mobile site and/or mobile channel via a wireless network”
Meta	construed based on express definition: “The term ‘mobile device’ as used herein is intended to include, without limitation, any type of portable information processing device capable of being configured for communication over a network”

b. “Application-Based Information Channel”

Meta and PO agreed to the construction “a computer program-based medium for transferring information” for the purpose of the Meta-MDT-IPR. (EX-1010, 17.)

c. Wireless Network Limitations

In the Meta-MDT-IPR, the parties dispute the construction of two limitations primarily over whether the wireless network is “independent” or “separate” from the Internet.” (EX-1010, 15-16; EX-1011, 5-8.)

(1) “Wireless Networking Functionalit[y]/[ies]”

Meta-MDT-IPR	
PO	“functionality implementable by the mobile device via the wireless network independent of the Internet”
Meta	to the extent the phrase requires express construction, “functionality implementable over a wireless network”

(2) “Wireless Network”

Meta-MDT-IPR	
PO	“a network separate from the internet that facilitates connection to the internet by a mobile device”
Meta	to the extent the phrase requires express construction, “a network that allows a device to communicate wirelessly over a network”

PO submitted its PO Response on October 1, 2024. (EX-1010.) As relevant here, PO proposed that “*mobile device*” be construed to mean “a portable device with limited display space and limited navigational capabilities that connects to a mobile site and/or mobile channel via a wireless network.” (*Id.*, 9.) This construction differed from PO’s litigation construction, which was “a piece of handheld equipment.” (EX-1009, 3.) PO also proposed “*application-based information channel*” to mean “a computer program-based medium for transferring information.” (EX-1010, 17.)

4. PO and Meta Settle on the Eve of Oral Argument

On March 7, 2025, just four days before oral argument, PO and Meta filed a joint motion to terminate the IPR. IPR2024-00248, Paper 38. The parties concurrently filed a copy of the settlement agreement as EX-2024; the agreement has been sealed as business confidential information by the Board. IPR2024-00248, Paper 39.

D. The MDT-Samsung Texas Litigation

PO sued Petitioners for patent infringement on June 10, 2024 alleging infringement of the '039 patent, among other patents. *Mobile Data Techs. LLC v. Samsung Elecs. Am., Inc.*, No. 2:24-cv-435-JRG-RSP (E.D. Tex.). PO served infringement contentions on the '039 patent on September 4, 2024, asserting 19 claims. In contrast, PO asserted only 5 claims against Meta, all of which were challenged in IPR2024-00248. Samsung challenges 21 claims in the pending Petition. A list of claims asserted by PO and challenged by Meta and Samsung is set forth in the table below.

'039 Patent Claims Asserted Against and Challenged by Meta	'039 Patent Claims Asserted Against Samsung	'039 Patent Claims Challenged by Samsung in IPR
19-23	1-4, 8, 9, 13-15, 17-19, 22-25, 28-30	1-4, 8, 9, 13-15, 17-25, 28-30

III. Discretionary Denial Would Contradict the Purposes of the AIA.

Nearly 15 years ago in 2011, Congress passed the Leahy-Smith America Invents Act (“AIA”) to address flaws in the patent system. Of particular concern was the proliferation of low-quality patents and the corresponding rise in abusive enforcement. *See, e.g., Thryv, Inc v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020) (“Congress, concerned about overpatenting and its diminishment of competition, sought to weed out bad patent claims efficiently.”); House Report, 39-40 (“[Q]uestionable patents [were] too easily obtained and too difficult to

challenge.”). With these concerns in mind, Congress identified as one of the primary goals of the AIA “establish[ing] a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.” House Report, 40.

A critical part of the AIA’s new system was the creation of the PTAB and IPR process, which was designed to combat general flaws in the patent system like low patent quality and costly and inefficient district court litigation, as well as problems directly associated with enforcement of low quality patents such as forum shopping and the economic impact of such litigation.

A. Weeding Out Bad Patents and Providing an Alternative to Costly and Inefficient District Court Litigation

In passing the AIA, Congress recognized that the USPTO, constrained by limited time and resources, had increasingly allowed the issuance of patents that did not meet the statutory standard. IPR (along with the AIA’s new Post-Grant Review proceeding) would provide a system “for challenging [these] patents that should not have issued,” “improv[ing] patent quality and restor[ing] confidence in the presumption of validity that comes with issued patents in court.” House Report, 39-40, 48. As the Supreme Court acknowledged, “inter partes review protects ‘the public’s paramount interest in seeing that patent monopolies are kept within their legitimate scope.’” *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*,

584 U.S. 325, 336-37 (2018) (quoting *Cuozzo Speed Techs. v. Com. for Intell. Prop.*, 579 U.S. 261, 279-80 (2016)).

Congress also enacted IPR to alleviate the high costs associated with defending patent infringement claims in district court, costs that frequently exceed millions of dollars regardless of patent quality. *See* House Report, 40 (AIA designed to “establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs”). IPR was expressly intended to provide a “quick and cost effective alternative[] to litigation,” House Report, 48, allowing accused infringers to challenge patents early and at significantly reduced expense. The AIA ensured that proceedings before the PTAB would be streamlined and time-limited, providing that final decisions must be issued within 12-18 months of institution. 35 U.S.C. § 316(a)(11). This expedited framework allows accused infringers to avoid the burdens of lengthy district court litigation, instead resolving disputes at a fraction of the cost and time typically required in Article III courts.

B. Curbing NPE Forum Shopping and Reducing Economic Impact of Litigating Bad Patents

Through creation of the PTAB and IPR, Congress aimed to curtail NPE litigation tactics like forum shopping and reduce the economic impact of NPE-driven litigation on innovators and the judicial system.

Congress created in the PTAB a centralized administrative forum for post-grant validity challenges. By enabling accused infringers to challenge questionable patents through IPR, with its procedural efficiencies and a lower burden of proof than district court litigation (preponderance of the evidence rather than clear and convincing), the AIA was intended to substantially diminish the strategic advantage of filing in any particular district court.

When “patents that should not have issued” (House Report 39-40) are litigated, they waste time and money that innovators could otherwise spend on R&D, as well as the judicial resources required to maintain sometimes years-long infringement suits.

Congress intended the AIA to help alleviate the economic burden caused by litigation of low quality patents. *See* House Report, 39 (citing Patent Reform in the 111th Congress: Legislation and Recent Court Decisions, Senate Judiciary Committee, 111th Cong. (2009) (statement of Prof. Mark A. Lemley, Stanford Law School) (“[A] number of the patent rules have given [litigants] unfair advantages in litigation, allowing them to enforce dubious patents in favorable jurisdictions, and to use the rules of patent remedies to obtain more money than their inventions were actually worth.”)). The AIA’s creation of the PTAB and IPR and limitations on joinder served to improve patent quality, reduce the costs and inefficiencies of district court litigation, and curb forum shopping—benefits

Congress recognized would disincentivize litigation of low quality patents and thus reduce its economic impact on innovators and the judicial system. *See, e.g.*, House Report, 39-40 (“[Q]uestionable patents [were] too easily obtained and too difficult to challenge.”); *America Invents Act: Hearing on H.R. 1249* (noting the importance of the AIA to “address this problem of nonpracticing entities that we believe exploit flaws in the current patent system”).

C. Congress Deliberately Set a One Year Statutory Bar to Give Petitioners a “Reasonable Opportunity” to Prepare Their Case

Congress held healthy debates over the length of time that a litigant defending patent infringement claims would have to file an IPR petition. In the bill passed in the Senate, litigants had 6 months to file an IPR petition. The final bill extended this provision to one year for reasons summarized in the Congressional Record:

High-technology companies, in particular, have noted that they are often sued by defendants asserting multiple patents with large numbers of vague claims, making it difficult to determine in the first few months of the litigation which claims will be relevant and how those claims are alleged to read on the defendant’s products. Current law imposes no deadline on seeking inter partes reexamination. And in light of the present bill’s enhanced estoppels, it is important that the section 315(b) deadline afford defendants a reasonable opportunity to identify and understand the patent claims that are relevant to the litigation.

157 Cong. Rec. 13,152, 13,187 (2011) (Sen. Kyl).

IV. Petitioners Filed Parallel Petitions to Address PO’s Alternative Constructions of “Mobile Device”

As noted above, PO proposed differing constructions for “*mobile device*” in the Meta-MDT-IPR and the MDT-Meta-Litigation, despite the fact that that the same claim construction standard applies in both proceedings. (*See* Petition, 5-6; 37 CFR § 42.100(b).) To address PO’s different constructions, Petitioners concurrently filed this Petition and the IPR2025-00535 Petition, which asserted prior art raised by Meta in the Meta-MDT-IPR and IPR proceedings for other related patents. In this Petition, Petitioners explained how prior art that is fundamentally different than the Meta prior art renders obvious the challenged claims under PO’s narrower construction. In particular, Petitioners explained:

Randall and Forsyth also teach wireless information devices (e.g., radio telephone and smartphone) that have limited display space and/or limited navigational capabilities. (*See* EX-1006, 4:61-62, Figures 2-11; EX-1005, 45:23-25 (“current architecture of the Internet is not well suited for the wireless device form factor ... for mobile devices with small displays.”).) For example, as shown in Forsyth’s Figure 6 (below), the wireless information device has a small display and the interface permits the user to navigate to only the listed forums—i.e., the mobile device has limited navigational capabilities. (EX-1003, ¶90.) Thus, the Randall-Forsyth combination discloses a “*mobile device*” even under PO’s overly narrow Meta-MDT-IPR construction. (*Id.*)

(Petition, 19; *see also* EX-1003, ¶90.)

As shown in, for example, Figure 1B, the “portable game machine” in Pelkey is a “portable device with limited display space.” It has “limited navigational capabilities” in that its functionality is limited by the gaming cartridge and selected navigational capabilities. Furthermore, the “portable game machine” is “a portable device with limited display space and limited navigational capabilities that connects to a mobile site and/or mobile channel via a wireless network” under PO’s Meta-MDT-IPR construction. (*Id.*)

(Petition, 65; *see also* EX-1003, ¶278.)

Petitioners filed parallel petitions challenging the ’039 patent so that PO could not strategically select which claim construction position to pursue depending on what references Petitioners presented. Petitioners’ position is consistent with the approach endorsed by the Board in at least *Apple Inc. v. Resonant Sys. Inc.*, IPR2024-00698, Paper 9, 13-14 (PTAB Oct. 21, 2024) (instituting two petitions that relied on “fundamentally different” prior art where patent owner advanced differing claim constructions, reasoning that “it would not serve the public’s interest to institute on only one petition and thus create a situation where Patent Owner could argue against one obviousness ground in one petition in a manner that would undermine Patent Owner’s position against Petitioner’s other obviousness ground in the other petition”). PO attempts to blame Petitioners for its differing claim construction positions, arguing that they are not “truly alternatives as Petitioners characterize.” (PO Br., 31.) But PO does not

dispute that the two constructions are in fact different. For example, if PO's narrower Meta-MDT-IPR construction of "*mobile device*" is adopted, the Board could potentially conclude that the Neibauer grounds raised in the IPR2025-00535 petition do not satisfy that limitation, whereas the prior art in this Petition directly covers a "*mobile device*" under PO's narrower construction. In short, institution of both petitions will ensure fairness and deny PO the opportunity to engage in further gamesmanship.

As noted above, Petitioners ranked this Petition higher than the IPR2025-00535 petition because Petitioners are challenging 16 claims in the patent not challenged by Meta. (*See* Paper 3, 2.) While Petitioners preference is to proceed with the new grounds set forth in this Petition, they will be prepared to proceed on the grounds set forth in IPR2025-00535 if that is the Board's preference.

Additionally, for the four other patents challenged in IPR2025-00537-544, Petitioners are similarly prepared to follow the Board's preference if it determines to institute IPR on only one set of grounds common across all five challenged patents.²

² PO complains that Petitioners "inconsistently" ranked their IPR petitions across five related patents, one of which is the '039 patent. (PO Br., 31.) Petitioners are not aware of any authority dictating how Petitioners should rank petitions across different patents, and PO cites no such authority. Regardless, as

V. Discretionary Denial Is Not Warranted Under *Fintiv*

A. Factor One Is Neutral or Favors Petitioners

Factor one considers “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 6 (PTAB Mar. 20, 2020) (precedential). This factor is neutral because no litigation stay has been requested and no objective evidence exists regarding whether a stay in the litigation will be granted. The Board’s practice is not to speculate regarding how a motion to stay may be decided. *Google LLC v. Mullen Indus. LLC*, IPR2025-00021, Paper 14, 8-9 (PTAB May 14, 2025).

Here, a decision instituting IPR would take place on or around September 11, 2025. The claim construction hearing is scheduled to occur on October 30, 2025. Judge Gilstrap has granted motions to stay filed on similar timelines. *See, e.g., Commc’n Techs., Inc. v. Samsung Elecs. Am., Inc.*, No. 2:21-cv-00444-JRG-RSP, Dkt. No. 134, 1-2 (E.D. Tex. Feb. 2, 2023) (granting motion to stay 13 days before *Markman* hearing where IPR instituted seven weeks before *Markman* hearing). Indeed, Judge Gilstrap has stayed cases based on IPR institution even after a *Markman* hearing where going forward would otherwise “risk[] an

noted above, Petitioners elect to move forward with the petitions based on their newly identified prior art as to all five patents. PO’s allegation of “inconsistent” rankings is therefore irrelevant.

inefficient consumption of limited judicial resources.” *Netlist, Inc. v. Micron Tech., Inc.*, No. 2:22-cv-00203-JRG-RSP, Dkt. No. 493, 1 (E.D. Tex. Feb. 10, 2024) (*sua sponte* staying case pending IPR after issuing *Markman* opinion and while summary judgment was pending); *see also STA Grp. LLC v. Motorola Sols., Inc.*, No. 2:22-cv -00381-JRG-RSP, 2024 WL 2852961, *2 (E.D. Tex. June 5, 2024) (granting motion to stay after issuing *Markman* order).

Indeed, Judge Gilstrap routinely grants contested stays in circumstances when all asserted claims of all asserted patents are challenged in the instituted IPRs, recognizing that PTAB review will likely result in simplification of issues before the court. *See, e.g., Resonant Sys., Inc. v. Samsung Elecs. Co.*, No. 2:22-CV-00423-JRG, 2024 WL 1021023, *3 (E.D. Tex. Mar. 8, 2024) (granting stay based on material likelihood of simplification of the issues due to instituted IPR on all asserted claims).

PO wrongly argues that Petitioners’ decision not to file a motion to stay prior to a decision on institution means Judge Gilstrap is unlikely to stay the district court case. (PO Br., 32-35.) Judge Gilstrap routinely stays cases where the motion to stay is first filed after IPR is instituted. *See, e.g., Cellspin Soft, Inc. v. ByteDance Ltd.*, No. 2:23-cv-00496-JRG-RSP, Dkt. No. 106, 5 (E.D. Tex. Jan. 26, 2025); *Broadphone LLC v. Samsung Elecs. Co., Ltd.*, No. 2:23-cv-00001-JRG-RSP, Dkt. No. 134, 1-2 (E.D. Tex. July 24, 2024); *Commc’n Techs.*, No. 2:21-cv-

00444-JRG-RSP, Dkt. No. 134, 1-2. PO's reliance on *Saint Lawrence Commc 'ns LLC v. ZTE Corp.*, No. 2:15-cv-349-JRG, 2017 WL 3396399, *2 (E.D. Tex. Jan. 17, 2017) is inapposite. As PO's brief acknowledges, the court criticized the defendant for waiting a month after IPR institution to file its motion to stay. (PO Br., 34.) In contrast, Petitioners anticipate filing a motion to stay within days after institution of its pending IPR petitions.

PO's argument that Petitioners' filing eight months after the PO initiated suit would result in denial of a motion to stay (PO Br., 34) is likewise contrary to Judge Gilstrap's practice. *See, e.g., Harbor Island Dynamic, LLC v. Samsung Elecs. Co., Ltd.*, No. 2:24-CV-00140-JRG-RSP, Dkt. No. 81, 1-2 (E.D. Tex. May 19, 2025) (granting motion to stay where petitions were filed roughly seven months after complaint filed); *Broadphone LLC*, No. 2:23-cv-00001-JRG-RSP, Dkt. No. 134, 1-2 (granting motion to stay where petition was filed ten months after the suit was initiated). The *Tessera* case relied on by PO is distinguishable. There, the PTAB had yet to render a decision on the IPR petitions. *Tessera Advanced Techs., Inc. v. Samsung Elecs. Co., Ltd.*, No 2:17-cv-00671-JRG, 2018 WL 3472700, *3 (E.D. Tex. July 19, 2018). Indeed, in denying the motion to stay, Judge Gilstrap specifically held that "the proper course is to follow the approach employed by a majority of the district court decisions (and all of the decisions in this district) and deny the motion for a stay pending a determination by the PTAB as to whether to

grant the petition for inter partes review. When that decision is made, the balance of factors bearing on the appropriateness of a stay may be very different, and issuance of a stay may be appropriate.” *Id.*, *4.

PO’s argument that Judge Gilstrap is unlikely to stay the case because the FWD is expected after the trial date (PO Br., 34-35) is further contradicted by numerous recent cases. *See, e.g., Harbor Island Dynamic, LLC*, No. 2:24-CV-00140-JRG-RSP, Dkt. No. 81, 5 (granting motion to stay where trial scheduled to begin January 5, 2026 and FWDs expected in March and April, 2026); *Cellspin Soft, Inc.*, No. 2:23-cv-00496-JRG-RSP, Dkt. No. 106, 5 (granting motion to stay where trial was scheduled to begin August 4, 2025 and FWDs were expected in September and October 2025); *Broadphone LLC*, No. 2:23-cv-00001-JRG-RSP, Dkt. No. 54, 4-6 (granting motion to stay case where trial was scheduled to start on February 10, 2025 notwithstanding expected FWD date in May 2025).

Finally, PO fails to acknowledge that Judge Gilstrap almost always grants uncontested motions to stay pending IPR. Specifically, Judge Gilstrap has granted over 88% (38/43) uncontested motions to stay pending IPR presented since 2014. (EX-1036.) If Petitioners’ IPR Petitions are instituted, PO cannot credibly oppose a stay. Indeed, PO requested a stay of the MDT-Meta-Litigation pending IPR while the petitions were still pending. (EX-1037.) Specifically, PO told the court that it “believes that the institution decisions and any [Final Written Decisions] will

simpl[if]y the issues in the case whether the IPRs are instituted, not instituted, or partially instituted. In other words, any outcome from the PTAB will streamline the relevant issues in this proceeding.” *Id.*, 5.

Thus, at bottom, whether the parallel case will be stayed is still to be determined and the Board “will not attempt to predict how the district court ... will proceed” regarding potential stays “because the court may determine whether or not to stay any individual case ... based on a variety of circumstances and facts.” *Sand Revolution II, LLC v. Cont’l Intermodal Grp.-Trucking LLC*, IPR2019-01393, Paper 24, 7 (PTAB June 16, 2020); *see also Hulu, LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00298, Paper 11, 11 (PTAB May 19, 2021) (because “neither party has produced evidence that a stay has been requested[,]” “[w]e decline to infer, based on actions taken in a different case with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here.”) (partially quoting *Fintiv*).

B. Factor Two: The District Court’s Trial Date Is Uncertain

Factor two considers the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Fintiv*, IPR2020-00019, Paper 11, 6. The district court litigation is currently scheduled for trial on April 20, 2026 (EX-2016), which is approximately five months before the Board would issue a final written decision if institution is granted. This date, however, is hardly

certain—as it currently stands, Judge Gilstrap has a total of 10 patent infringement trials set for the week of April 20, 2026 and 7 patent infringement trials scheduled for April 6, 2026. (EX-1038.) So it is unlikely that Petitioners will proceed to trial at that time.

Statistics maintained by the “United States District Court – Judicial Caseload Profile” indicate that, as of March 31, 2025, the median time to trial in civil cases in the Eastern District of Texas is 25.9 months.³ (EX-1039, 35.) This projects a trial date around August 10, 2026, roughly one month before the expected FWD date. Where the district court trial is expected to take place around one month before the FWD date, the Board generally considers this factor neutral, “not weigh[ing] for or against exercising [] discretion to deny institution.” *See, e.g., Hulu LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00158, Paper 9, 9-10 (PTAB Apr. 20, 2021) (granting institution where FWD was 1 month after anticipated trial date, reasoning that where trial date and FWD data are at or around same time, efficiency and fairness concerns are not particularly strong and other

³ PO wrongly contends that the September 30, 2024 statistics (which state the median time to trial is 21.9 months) represent “[t]he most recent statistics” available. (PO Br., 37.) In any event, the data presented by PO (which is based on statistics as of September 30) and the most recent data (which is based on statistics as of March 31) each demonstrate that the median time to trial in the Eastern District is increasing.

factors should be considered); *NeuMoDx Molecular, Inc. v. HandyLab, Inc.*, IPR2020-01132, Paper 20, 13 (PTAB Apr. 19, 2021) (granting institution where FWD was expected 11 days after anticipated trial date); *NetApp, Inc. v. Proven Networks, LLC*, IPR2020-01436, Paper 11, 11-12 (PTAB Apr. 9, 2021) (granting institution where FWD was expected one month after anticipated trial date). The new USDC statistics moot PO's reliance on *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13, 5-6 (PTAB Apr. 7, 2025), which found that factor 2 weighs in favor of discretionary denial where trial was expected about *six* months before the FWD. (PO Br., 12.) Even taking PO's outdated statistics as fact, PO's *SAP* argument fails because it omits that Petitioner argued in its briefing that the trial date would change because it had sought transfer (which was denied before the Board's decision) – not because of court congestion. *SAP Am.*, IPR2024-01496, Paper 13, 6. And, in any event, the Board has previously instituted IPR even in cases where the FWD issues four months after the projected trial date. *See, e.g.*, *Zynga, Inc. v. IGT*, IPR2022-00199, Paper 11, 14 (PTAB June 14, 2022) (citing *Fintiv*, IPR2020-00019, Paper 11, 9) (instituting trial while weighing this factor as “slightly in favor of discretionary denial” where trial was scheduled four months before FWD); *Samsung Elecs. Co., Ltd. v. CardWare Inc.*, IPR2023-00211, Paper 13, 10 (PTAB June 13, 2023) (instituting trial while weighing this factor as “marginally in favor of discretionary denial” when trial scheduled four months

before FWD); *Nokia of Am. Corp. v. IPRCom, GmbH & Co. KG*, IPR2021-00533, Paper 10, 9 (PTAB Aug. 12, 2021) (instituting trial while weighing this factor as “slightly in favor of exercising discretion to deny institution” when trial may occur four months before FWD); *Cellco P’ship v. Huawei Device Co., Ltd.*, IPR2020-01117, Paper 10, 18-20 (PTAB Feb. 3, 2021) (instituting trial while weighing this factor as “slightly in favor of exercising[] discretion to deny institution” when trial was scheduled four months before FWD).

Further weighing against discretionary denial, the USPTO took almost six weeks to issue the Notice of Filing Date Accorded to Petition (Paper 7). This stands in contrast to the roughly 20 days the Board was typically taking to issue such Notices over a studied three month period in 2024 and the 19 day historical average timeframe. (EX-1040, 2.) This delay was entirely outside Petitioners’ control and should not weigh in favor of discretionary denial. Had the notice issued in the historical average timeframe, the expected FWD date would have fallen within a week of the projected August 10, 2026 trial date, well within the bounds of what the Board has previously considered “around the same time as [the] deadline to reach a final decision.” See *NeuMoDx Molecular*, IPR2020-01132, Paper 20, 13 (granting institution where FWD was expected 11 days after anticipated trial date).

Thus, at most, Factor 2 is neutral. Indeed, one study found that, when the Board exercised discretionary denial based on future trial dates, the Board incorrectly guessed the actual trial date 94% of the time (48 out of 51 discretionary denials). (EX-1041, 2.) Even the Board has previously noted that “scheduled trial dates are unreliable and often change.” (EX-1042, 8.)

C. Factor Three: Little Investment Relating to Invalidity Will Have Occurred in the Litigation by the Institution Deadline

The consideration of investment in parallel litigation focuses on efforts relating to invalidity issues raised in the Petition—not on litigation efforts generally. *See, e.g., Apple, Inc. v. Koss Corp.*, IPR2021-00381, Paper 15, 16 (PTAB July 2, 2021) (“On the current record, the District Court Lawsuit is still in the early stages, with very little investment pertaining to the invalidity issues raised in the Petition.”); *Dell Techs. Inc. v. WSOU Investments, LLC*, IPR2021-00272, Paper 13, 10 (PTAB July 1, 2021) (“much of [the parties’] invested effort is unconnected to the patentability challenges presented here”); *Hulu, LLC*, IPR2021-00158, Paper 9, 11 (“Based on the present record, we are persuaded by Petitioner’s showing that the district court and the parties have not invested substantially in the merits of the invalidity positions.”)

Here, by the September 2025 institution deadline, the amount of work related to invalidity in the district court litigation will remain minimal. To date, as PO concedes, the only invalidity-specific work is service of infringement and

invalidity contentions and Petitioners' service of third-party subpoenas. (*See* PO Br., 39.) Even by September 2025, “substantial work [will] remain[] to be done **as it relates to invalidity**: fact discovery is in its early stages, expert reports are not yet due, and substantive motion practice is yet to come.” *Dell*, IPR2021-00272, Paper 13, 10 (emphasis added); *see also* EX-2016, 3-4 (fact discovery, expert report, and dispositive motion deadlines all occurring after September 2025).

PO wrongly contends that factor 3 is neutral where, as here, an institution decision will occur before a Markman hearing. Rather, under similar circumstances, the PTAB has found this factor to weigh against denying institution. *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15, 10-11 (PTAB Oct. 21, 2020) (precedential) (finding factor weighs against institution when no claim construction has issued and no significant discovery had been completed); *Juniper Network, Inc. v. Packet Intel. LLC*, IPR2020-00336, Paper 21, 18 (PTAB Sep. 10, 2020) (“the investment of time and effort that remains to bring the co-pending litigations to trial appears to far outweigh that which has already been invested” when discovery is not yet complete and district court has not issued a decision on claim construction); *Samsung Elecs. Co., Ltd. v. Headwater Rsch. LLC*, IPR2024-01396, Paper 13, 7 (PTAB Apr. 1, 2025) (finding the fact that “claim construction proceedings will not have completed and the district court will not have issued any substantive orders” by the time of the institution decision

“weighs against denial” despite “the parties [] likely [having] done some work”); *Mobileye Glob., Inc. v. Facet Tech. Corp.*, IPR2024-01110, Paper 16, 12-13 (PTAB Mar. 5, 2025) (weighing against denial and instituting in absence of claim construction and other substantive orders from district court).

Moreover, the district court has not issued any substantive order with respect to the '039 patent and no such substantive orders are expected prior to institution. *Fintiv*, IPR2020-00019, Paper 11, 9 (“If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.”).

Under this factor, PO complains again that Petitioners should have joined the Meta-MDT-IPR or filed the Petition earlier. (PO Br., 40.) But PO’s strategic filing of its suit against Petitioners—just four weeks before the July 11, 2024 joinder deadline (*see* EX-1044)—deprived Petitioners an adequate opportunity to analyze PO’s patent infringement claims and determine how best to proceed before that joinder deadline passed.

Indeed, Petitioners’ answer in the district court was not even due until October 7, 2024 (because Samsung Electronics Co. Ltd. agreed to waive service). And as noted above, Petitioners did not receive PO’s infringement contentions on the '039 patent until September 4, 2024. Those contentions assert infringement of 19 claims, a number far greater than the 5 claims challenged by Meta in IPR2024-

00248. Thus, had Petitioners sought to join the instituted petition, they would have nonetheless needed to file a second petition to address all claims asserted against Petitioners. For situations like this, the Board has in the past held that “it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding.” *Fintiv*, IPR2020-00019, Paper 11, 11.

Moreover, Petitioners’ delayed filing the Petition because they were concerned with the possibility that PO would propose different constructions in the MDT-Meta-Litigation and in the Meta-MDT-IPR; Petitioners thus thought it prudent to await final briefing in the Meta-MDT-IPR to ensure that there were no surprises. Petitioners’ concern turned out to be justified. In the MDT-Meta-Litigation, PO proposed “*mobile device*” broadly to mean “a piece of handheld equipment.” (EX-1009, 3.) However, in the Meta-MDT-IPR, PO proposed a new, narrower construction, clearly intended to exclude Meta’s cited prior art: “a portable device with limited display space and limited navigational capabilities that connects to a mobile site and/or mobile information channel via a wireless network.” (EX-1010, 24.) Petitioners had to take PO’s new construction into account, ultimately resulting in the filing of concurrent IPR petitions with different

prior art to account for PO's different constructions.⁴ (*See* Paper 3 (identifying parallel petitions against '039 patent).)

Accordingly, factor three weighs against discretionary denial.

D. Factor Four: Petitioners' *Sotera* Stipulation, As Amended Herein, Removes Any Overlap With the Litigation

On April 18, 2025, Petitioners stipulated, consistent with *Sotera*, "that if the [PTAB] 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. With this stipulation, *Fintiv* factor four weighs against discretionary denial.

PO raises procedural and substantive challenges to Petitioners' *Sotera* stipulation, both of which are meritless. Procedurally, PO argues that, because Petitioners have not yet filed their *Sotera* petition (Petitioners await permission from the Board to do so), "Petitioners have deprived Patent Owner of its strategic advantage" to address the stipulation. (PO Br., 43.) According to FAQs for Interim Processes for PTAB Workload Management ("the April 2025 FAQs"), the purpose

⁴ Notably, with respect to "*application-based information channel*," PO has taken yet another new claim construction position, which PO never presented in the Meta-MDT-IPR or the MDT-Meta-Litigation.

of filing a *Sotera* stipulation “as soon as practicable” is “so that a patent owner may address the impact of the stipulation in its discretionary denial brief.” April 2025 FAQs, Q-14. PO indisputably had an opportunity to—and did—address Petitioners’ stipulation in its discretionary denial brief. Moreover, as discussed below, Petitioners are affording PO an opportunity to respond to Petitioners amended *Sotera* stipulation which is being presented by Petitioners in view of recent Board decisions. Thus, there is no prejudice to PO, and its procedural argument should be rejected.⁵

Furthermore, PO presently asserts 70 claims in six asserted patents in the co-pending litigation. PO will doubtlessly narrow its case in the district court prior to trial—meaning that there will be claims addressed in the IPR proceedings that will not be addressed by the district court. The challenges to these unaddressed claims weigh against discretionary denial. *Palo Alto Networks, Inc. v. Centripetal Networks, LLC*, IPR2021-01157, Paper 10, 14 (PTAB Mar. 15, 2022) (declining to invoke § 314(a) and finding factor four weighs against discretionary “[t]aking into account the [*Sotera*-type] stipulation and the number of claims challenged in this

⁵ PO claims that Petitioners’ *Sotera* stipulation is a “proposed draft.” (PO Br., 43 n.13.) Not so. The April 18, 2025 letter from Petitioners’ counsel was clear and unwavering. (EX-2032.) As noted herein, Petitioners have revised their *Sotera* stipulation to be more restrictive in view of recent decisions by the Board.

proceeding that will not be addressed by the district court”). *See also Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00217, -219-222, -339, Paper 10, 3 (PTAB June 13, 2025) (denying request for discretionary denial, because, in part of the “large number and vast scope of the patents asserted in the district court litigation”).

Substantively, PO contends that Petitioners’ *Sotera* stipulation will not reduce overlap in proceedings because, in their preliminary invalidity contentions, Petitioners have asserted the Nokia 9210 System as product prior art. (PO Br., 19.) As PO notes, the Nokia 9210 System utilized Symbian OS, which is also discussed in Randall and Forsyth. (PO Br., 20.) Initially, Petitioners do not rely on Randall or Forsyth anywhere in their claim chart for the Nokia 9210 System. (*See* EX-2033.) Moreover, PO’s argument assumes that, if institution is granted, Petitioners will present the Nokia 9210 System at trial. But this is pure speculation on PO’s part. Aside from the Nokia 9210 System, Petitioners have identified eight other commercial prior art products in their invalidity contentions. (EX-2027, 20-21.) Petitioners have not decided what prior art they will ultimately pursue in the district court case, particularly given that Petitioners’ invalidity expert report is not due until December 1, 2025. (EX-2016, 4.)

Amended *Sotera* Stipulation

Notwithstanding the foregoing, in view of the Director’s Decision Granting Patent Owner’s Request for Discretionary Denial and Denying Institution of Inter

Partes Review in *Shenzen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00354, Paper 11, 2-3 (PTAB June 12, 2025), Petitioners agree that if IPR is instituted, they will not pursue in the related district court proceeding the grounds raised or any other grounds that could have reasonably been raised before the PTAB in the instituted proceeding(s) or any “combinations of the prior art asserted in these proceedings with unpublished system prior art.”⁶ Moreover, Petitioners agree that if IPR is instituted, they will not pursue in the related district court litigation any commercial prior art theory that is coextensive with prior art presented to the Board, including the Nokia 9210 System.⁷

E. Factor Five: Petitioners Are Defendants in the E.D. Texas Litigation

Petitioners agree that they are also defendants in the E.D. Texas litigation.

F. Factor Six: Other Circumstances Weigh Against Discretionary Denial

Factor six considers “other circumstances that impact the Board’s exercise of discretion, including the merits.” Petitioners address here the relevant considerations from the Director’s March 26, 2025 Memorandum.

⁶ Petitioners would not oppose a request by PO for a limited brief reply to address this more restrictive stipulation.

⁷ Petitioners have offered this amended *Sotera* stipulation in each of IPR Nos. IPR2025-00535 – IPR2025-00544. (EX-1045.)

1. The Petition Presents a Compelling Case of Unpatentability

The Petition, in light of the asserted prior art and the accompanying expert testimony of Dr. Houh, presents a compelling case of unpatentability under both Ground 1 (based on the Randall-Forsyth combination) and Ground 2 (based on the Pelkey-Eck combination). PO's arguments, based solely on attorney argument, do not compel a different result.

Ground 1: Randall-Forsyth Combination

Limitation [1B] – “*identifying a previously established application-based information channel*” (also limitations [18D], [19A], [23C]): PO argues that Petitioners' Randall-Forsyth combination does not disclose “*identifying a previously established application-based information channel*” because Forsyth's “group object,” which is used to create a new forum, is “application independent.” (PO Br., 44-45; *see* EX-1006, 5:15-17 (“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.”).) According to PO, “[n]either Petitioners nor their expert explain how an ‘application independent’ channel can be ‘application-based.’” (PO Br., 45.) That is false.

PO completely ignores its own agreed construction in the Meta-MDT-IPR for “*application-based information channel*,” which is “computer program-based medium for transferring information.” Applying this construction, Dr. Houh first

explains that “Symbian Forums, described by Randall and Forsyth, is an ‘*application*’ with a program component at the wireless device and a program component on the server” (EX-1003, ¶123.) Forsyth expressly confirms that Forums is an application: “FIGS. 2-11 are screen shots of the display of a wireless information device running the Forums application.” (EX-1006, 4:62-63.)

Dr. Houh provides additional detail regarding the Forums application and how a new individual Forum is created. (EX-1003, ¶¶124-128.) He then explains that “a Forum (e.g., ‘Naked Chef’ Forum) created in and available through Symbian Forums provides a means to share content (information) with identified members of the Forum—i.e., it is mechanism through which content/information is transferred to Forum members.” (EX-1003, ¶129.) Dr. Houh concludes that, based on this functionality performed through the Forums application, “an individual Forum is an ‘*application-based information channel*’ under the agreed upon Meta-MDT-IPR construction (‘a computer program-based medium for transferring information’).” (EX-1003, ¶129.)

PO latches on to Forsyth’s statement that creation of a “group object” for a new Forum is “application independent.” However, that Forsyth’s group object is “application independent” does not, as PO suggests, mean that it is not “*application-based*.” Instead, the term “application independent” means that the group object “can be created in one application and then immediately used in other

applications to specify a group for group communication.” (EX-1003, ¶48.)

Forsyth confirms this understanding:

- “The content and application independent group object is therefore a foundation stone for building applications which enable a huge range of new group based communication/interaction functions.” (EX-1006, 3:14-17.)
- “The present invention is founded on the insight of providing an object which defines solely the identities of members of a group: as such, it is application (and hence also content) independent. This means that a group created in one application (e.g. for text based instant messaging) can immediately be used in other applications (e.g. a diary/agenda application could use that same group as the recipient list for an invitation to a meeting)[.]” (EX-1006, 2:24-32.)
- “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. As noted above, this means that the same group object can be re-used across different applications, so that data and/or voice conferencing across a group is greatly simplified.” (EX-1006, 5:15-20.)

In other words, while Forsyth discloses that the group object can be used by multiple different applications, the object still operates within one or more applications as “a computer program-based medium for transferring information,” for the reasons described by Dr. Houh above; the group object is therefore an “*application-based information channel*.” To the extent PO now suggests that an

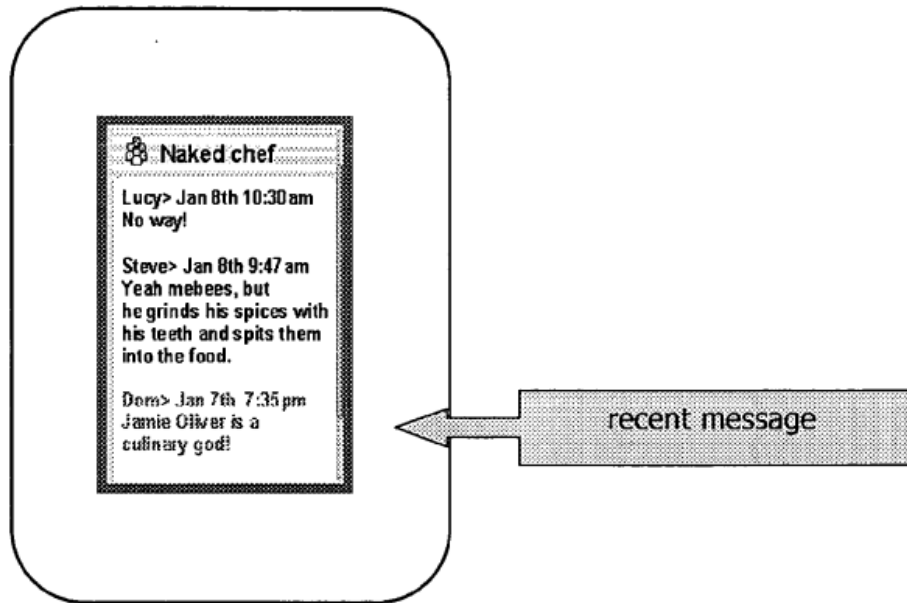
“*application-based information channel*” must be limited to use in a single application, that is not required by PO’s construction in the Meta-MDT-IPR or supported by the intrinsic evidence, nor has PO proposed such a claim construction here.

Limitation [1C] – “*determining information associated with at least one wireless networking functionality of the mobile device*” (also limitations [18E], [19B], [23D]): For limitation [1C], Petitioners identified the Randall-Forsyth combination’s messaging as the “*at least one wireless networking functionality of the mobile device,*” consistent with the disclosures of the ’039 patent. (*See, e.g.,* EX-1001, 1:41-43, 1:59-61, 9:37-42 (identifying messaging as a wireless network functionality); EX-1003, ¶157 (“Forsyth describes that Forums supports ‘group based text messaging’ and ‘group based multi-media messaging.’”) (citing EX-1006, 3:35-58, 5:45-49.))

Petitioners then explained how the Randall-Forsyth combination “*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 (e.g., “Yeah mebees but he grinds his spices with his teeth and spits them into the food”).

(Petition, 32; *see also* EX-1003, ¶159.) This messaging information is shown in Forsyth’s Figure 7 (below). In other words, the Forums message demonstrates that the mobile device determines “*information associated with at least one wireless networking functionality of the mobile device.*”



Forsyth, Figure 7

In addition to and separate from the information from the Forums message, Petitioners also identified information transmitted in a protocol message, such as in the well-known GSM-SMS and WAP communication protocols, as providing information associated with Randall-Forsyth’s messaging (the “*wireless networking functionality*”):

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. (EX-1003, ¶¶160-164.) The

protocol message includes information associated with the action of sending a message determined by the mobile device such as message type and content type identifier. (EX-1003, ¶¶162-163, *citing* EX-1015, 42-43, 60, 63.)

(Petition, 32-33.) GMS-SMS and WAP are both disclosed for use in the Randall-Forsyth combination. (EX-1005, 58:23-27 (Randall describing use of “existing transports such as ... WAP to access the services on the server side ...”), 14:10-11 (“This form of data transfer could be via SMS or packet delivery in packet based systems.”).)

Here, PO focuses on Dr. Houh’s statement that “neither Randall nor Forsyth provides the details of the wireless messaging functionality of GSM-SMS or WAP” (EX-1003, ¶160) to argue that a POSITA allegedly would not know how to use GSM-SMS or WAP as part of the combination. (PO Br., 46.) PO’s argument, however, improperly ignores the knowledge and creativity of a POSITA, which must be taken into account as part of any obviousness analysis. *See C.R. Bard, Inc. v. Medline Indus., Inc.*, No. 2020-1900, 2021 WL 3574043, *5 (Fed. Cir. Aug. 13, 2021) (vacating in part final written decision where “the Board’s obviousness analysis rigidly focused on the disclosures of individual prior-art references without considering a skilled artisan’s creativity and common sense”) (cleaned up; citation omitted). Indeed, the ’039 patent references multiple known protocols (e.g., “Internet protocol (IP), transmission control protocol (TCP), user datagram

protocol (UDP), real-time protocol (RTP), short message service (SMS), multimedia message service (MMS), wireless application protocol (WAP), session initiation protocol (SIP)” (EX-1001, 4:17-23)) without providing any details; the patent thus assumes a level of knowledge of a POSITA.

Consistent with this assumption, Dr. Houh explains, “[t]hese details [of GSM-SMS and WAP] were specified by standards governing the wireless network and would have been well-known to and within the general knowledge of a POSITA.” (EX-1003, ¶160.) Dr. Houh details the relevant knowledge that a POSITA would have had regarding GSM-SMS and WAP, including by referencing technical documents regarding these protocols that a POSITA would certainly have known about. (*See* EX-1003, ¶¶61-66 (citing EX-1013, EX-1014, EX-1015.)) Thus, it would have been well within the knowledge and capabilities of a POSITA to utilize GSM-SMS and WAP in conjunction with the teachings of Randall and Forsyth.⁸

⁸ PO also argues that, in referencing the GSM-SMS and WAP protocols, Dr. Houh “impermissibly relies upon a ‘reference’ not included in Ground 1.” (PO Br., 47.) It is well-settled that a POSITA’s knowledge can be applied to a ground for challenge without including each and every document establishing such background knowledge as part of the ground. *See, e.g., Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1337-38 (Fed. Cir. 2020). There is thus nothing improper about Dr. Houh’s opinions or Petitioners’ reliance on them.

Regardless, as already noted above, Forsyth itself discloses, in order to send a Forums message, information associated with the messaging functionality is determined by the mobile device, independent of the message-encapsulation protocols of GSM-SMS and WAP. To the extent that PO's criticism relates to the scope of disclosure of the step "*determining information associated with at least one wireless networking functionality of the mobile device,*" Petitioners note that the '039 patent contains virtually no disclosure of how the information associated with at least one wireless networking functionality is determined. In contrast, Forsyth discloses this limitation to the same or greater level of detail as taught in the '039 patent.

Limitation [1D] – “providing 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” (also limitations [18F], [19C], [23E]): For limitation [1D], the Petition states:

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 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.) The same process occurs for other captured content types (e.g., captured photos, music, graphics, etc.) posted to a Forum. (EX-1003, ¶¶178-179.)

(Petition, 39-40.)

PO contends that the Randall-Forsyth combination does not disclose limitation [1D] because “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.’” (PO Br., 50.) Initially, PO’s argument is incorrect because, as confirmed by Dr. Houh, Forsyth’s Figure 7 shows that all of the information (sender name, date/time, etc.) is presented together, meaning that the information must have been determined by the mobile device and sent to the server. (EX-1003, ¶¶161, 177.) As noted above, this information is separate and distinct from the information encapsulated in a protocol message (e.g., for GSM-SMS or WAP), which is yet another way that the Randall-Forsyth combination satisfies this limitation.

PO complains about Petitioners’ identification of the protocol message, but it yet again improperly ignores the knowledge a POSITA would have had, particularly as related to GSM-SMS and WAP. As explained above, even though Forsyth itself does not provide details of those communications protocols, it need not do so because that information would have been known to a POSITA. (*See* EX-1003, ¶¶160, 61-66; EX-1013; EX-1014; EX-1015.) And based on that knowledge,

a POSITA would have known that information about the messaging (“*wireless networking functionality*”) would have been provided in a protocol message. PO’s rigid application of the prior art should therefore be rejected.

Petitioners’ arguments for [1B] and [1C] are consistent: PO argues that the Petition’s arguments for limitations [1B] and [1C] are inconsistent because they allegedly rely on “group based text messaging” to satisfy both limitations. (PO Br., 52.) PO misrepresents the arguments in the Petition. For limitation [1B], the Petition clearly states that “an individual Forum is [an] ‘*application-based information channel*’ under the Meta-MDT-IPR construction.” (Petition, 27.) As PO notes, the Petition elsewhere states that Forsyth’s Scenario 1 “describes an example of creating a Forum (channel) within Forums” in the context of “group based text messaging.” (Petition, 25.) The two statements are consistent—each individual Forum is an “*application-based information channel*,” and Forsyth discloses enhancing the Forums experience through, for example, group based text messaging that is enabled by Forsyth’s group objects. In other words, Petitioners do not argue that “group based text messaging” itself is an “*application-based information channel*” in limitation [1B].

Turning to limitation [1C], PO argues that Forsyth’s “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.” (PO

Br., 53.) Yet again, PO ignores its own proposed construction of this term in the Meta-MDT-IPR. In particular, PO proposed “*wireless network functionality*” to mean “functionality implementable by the mobile device via the wireless network independent of the Internet.” There is no dispute that Symbian Forums operates as an application on the mobile device. (See, e.g., EX-1003, ¶123.) Any functionality of Forums, including group based text messaging, is therefore “functionality implementable by the mobile device.” Moreover, as already discussed above, the ’039 patent expressly identifies messaging as an example of wireless networking functionality. (See EX-1001, 1:41-43, 1:59-61, 9:37-42.) The specification does not support PO’s argument—there is no disclosure, express or implied, that messaging functionality implemented in an application on a mobile device is not functionality of the mobile device. PO’s attempt to draw a distinction between the functionality of Forums and functionality of the mobile device therefore fails.⁹

⁹ In this section of PO’s brief, PO argues yet again that limitation [1C] (“*determining information associated with at least one wireless networking functionality of the mobile device*”) is not disclosed by the Randall-Forsyth combination. (PO Br., 54-57.) Petitioners already explained above how the combination discloses limitation [1C].

Ground 2: Pelkey-Eck Combination

Motivation to combine Pelkey and Eck: With respect to Ground 2, PO first argues that Petitioners have failed to establish a motivation to combine Pelkey and Eck. (PO Br., 57-60.) As Dr. Houh notes, 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.) PO takes issue with this statement because “Eck teaches that a user can turn to ‘user-generated custom libraries of words, phrases and graphics’ to reduce message length.” (PO Br., 58-59.) But just because Eck teaches one way to reduce cost does not mean that a POSITA would not know of other ways to reduce costs, such as switching from the pager cartridge to a client-server architecture, as taught by Pelkey. Again, PO seeks to rigidly apply the prior art and fails to credit the knowledge and creativity of a POSITA, which is inappropriate. *See C.R. Bard*, 2021 WL 3574043, *5.

Dr. Houh goes on to state, “[i]n 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.’” (EX-1003, ¶272.) PO responds that “[t]he 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?” (PO Br., 59.) PO misunderstands Dr. Houh’s opinion here—he is discussing how Pelkey can be improved with the teachings of Eck. Indeed, in the very next sentence of his declaration, Dr. Houh notes that “Pelkey does not describe any game play that includes in-game messaging in conjunction with the aforementioned features.” (EX-1003, ¶272.)

Limitation [1B] – “*identifying a previously established application-based information channel*”: With respect to the “*previously established*” aspect of limitation [1B], Dr. Houh explains:

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.

(EX-1003, ¶289.)

PO argues that “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.” (PO

Br., 61.) In particular, PO asserts that Dr. Houh’s citations to Eck (EX-1008, 4:61-4:7, 9:40-59) do not support that PagerWorld is persistent. Initially, PO seeks a level of detail about the persistence of PagerWorld that is not provided anywhere in the ’039 patent. The specification uses the phrases “persistent version” and “persistent information” without giving any explanation as to what “persistent” means or how persistent information is provided to users.

Regardless, PO is wrong about Eck’s disclosures. Eck discloses that “pager cartridge 100 provides a two-way paging device that has the ability to receive messages from other users in the paging system as well as from the paging system operator. ... The system operator messages may be transmitted during off-peak messaging hours (such as nighttime) when air time and bandwidth are less of a transmission issue and more cost-effective.” (EX-1008, 9:40-52.) That system operator messages can be transmitted at specified times supports Dr. Houh’s opinion that PagerWorld, which is supported by pager cartridges 100 (EX-1008, 10:20-23), is persistent—the community exists for the system operator to distribute messages at scheduled times even if users are not online. Moreover, as Dr. Houh explained, the fact that messages are stored in the “Message Center” and captured images can be used to create a user’s “persona” further demonstrates that PagerWorld is “persistent.” (EX-1003, ¶¶290, 293-296.)

Claims 19, 22, 23: PO lastly argues that “neither Pelkey nor Eck teaches the server-side operations required by claims 19, 22, and 23.” (PO Br., 62.) According to PO, “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.” (PO. Br, 62.) PO’s argument is incomprehensible; paragraph 160 of Dr. Houh’s declaration addresses the Randall-Forsyth combination and has nothing to do with PagerWorld, which is relevant only to the Pelkey-Eck combination. Moreover, the phrase “by virtue of appearing within the PagerWorld environment” does not appear anywhere in Dr. Houh’s declaration.

In any event, Dr. Houh does explain how the Pelkey-Eck combination discloses a server that integrates captured content and determined information into an “*application-based information channel*.” For example, Dr. Houh first explains how the server is provided captured content for insertion into an “*application-based information channel*”:

[A] message “may be sent to all users in the paging system, to certain groups of users in the paging system or to a particular user in the paging system.” (Eck, 9:46-49, 20:8-9.) As noted above, the server forwards the message received from the portable game device to the intended recipients (one or more (or all) messaging system users). The users of the messaging (paging) system are members of the PagerWorld community (i.e., “*the identified application-based information channel*”). Thus, the combination of Pelkey and Eck discloses

“provid[ing] the captured content from the mobile device [portable game machine] to at least one server for insertion ... into the identified application-based information channel.”

(EX-1003, ¶306; *see also* EX-1003, ¶320 (for limitation [19C], referring back to analysis for limitation [1D]).)

Dr. Houh then explains how claim 19’s associated information (referred to as *“determined information”* in claim 1) is provided by the server along with the captured content:

The *“captured content”* is provided to the server *“for insertion with the determined information”* into the *“identified application-based information channel.”* The *“determined information[.]”* ... includes the information provided in the GSM-SMS message header. When a message is forwarded to a recipient, the header information remains in the forwarded GSM-SMS message. This is again reflected in Eck’s Figure 8C (below-left) and Figure 8D (below-right). Figure 8C provides a list of unopened message and “[s]electing a message takes the user to a Read Message screen” shown in Figure 8D. (Eck, 11:26-32.) As shown in this figure, the message received at the user’s device includes the captured content and the determined information.

(EX-1003, ¶307; *see also* EX-1003, ¶320.)

Accordingly, PO’s argument, based on quoted language that does not even appear in Dr. Houh’s declaration, should be rejected.

2. PO Should Not Be Permitted to Game the System

PO repeatedly accuses Petitioners of “abus[ing] the IPR process” in at least the following ways:

- By filing two petitions to address PO’s differing claim constructions. (PO Br., 31.)
- By ranking its two petitions on the ’039 patent in a manner different from its ranking as to the other challenged patents. (PO Br., 31-32.)

For example, PO argues that “Petitioners’ delay has ... prejudiced Patent Owner,” including because “Patent Owner had to invest time and resources to argue regarding the insufficiency of a not-yet-filed stipulation.” (PO Br., 17; *see also id.*, 31 (“Petitioners’ abuse of the IPR process”).) PO also argues that the Petition lacks merit. (PO Br., 41-62.)

But it is PO who has “gamed” the system by terminating the Meta-MDT-IPR mere days before oral argument due to settlement. On May 16, 2025, Petitioners’ asked PO to consent to Petitioners’ filing of the Settlement Agreement as a sealed exhibit with this response. PO refused via email. The parties met and conferred on May 23, 2025 and reached an impasse on the issue.

Because motions cannot be filed without authorization (*see* 37 C.F.R. § 42.20), Petitioners emailed the Board on May 28, 2025 and asked for permission to file a motion to compel production of the Settlement Agreement through the

routine discovery rules that obligate PO to produce information inconsistent with a position advanced by PO in its opening brief. *See* 37 C.F.R. § 42.51(b)(1)(iii).

Despite the fact that Petitioners were prohibited from including substantive argument in their email to the Board seeking authorization to file its motion to compel,¹⁰ on May 29, 2025, the Board denied Petitioners' request, stating that, "Petitioner has not provided sufficient relevance of the requested discovery to the Director's discretionary considerations." (EX-3101.) The Board, however, acknowledged that, "[m]indful of any protective orders, Petitioner may discuss any fact or circumstance they believe bears on the Director's discretion to institute, including what it believes to be inconsistent positions in Patent Owner's discretionary denial brief, in its opposition." (*Id.*)

By settling on the eve of trial, it is reasonable to infer that PO settled the Meta-MDT-IPR proceedings because it knew that Meta's arguments were strong on the merits and that it settled to avoid an adverse final written decision finding the challenged claims unpatentable. *See, e.g., My Health, Inc. v. ALR Techs., Inc.*, No. 2:16-cv-00535-RWS-RSP, 2017 WL 6512221, *5 (E.D. Tex. Dec. 19, 2017),

¹⁰ *See* U.S. Patent & Trademark Office, Patent Trial and Appeal Board Boardside Chat: AIA Motions Practice at 7 (March 18, 2021), https://www.uspto.gov/sites/default/files/documents/ptab_boardside_chat_aia_motions_practice_20210318.pdf.

report and recommendation adopted, 2018 WL 11327219 (E.D. Tex. Nov. 30, 2018) (quoting *SFA Sys., LLC v. Newegg Inc.*, 793 F.3d 1344, 1350 (Fed. Cir. 2015)) (noting, in a ruling finding the case exceptional, that patent owner’s practice of settling cases “right on the cusp of a merits determination ... supports the conclusion that [patent owner] was filing lawsuits ‘for the sole purpose of forcing settlements, with no intention of testing the merits of [the] claims’”). Indeed, if it felt it had a strong case on the merits, PO should have proceeded to a final written decision in the Meta-MDT-IPR.

3. No Forum Has Adjudicated the Validity of the Challenged Claims

That no forum has adjudicated the validity of the challenged claims of the ’039 patent weighs against discretionary denial. The Board has already found that there is a reasonable likelihood that at least claim 19 is invalid based on Neibauer, Cheng, and Squibbs. *See* IPR2024-00248, Paper 11, 20-26. Given this prior finding, allowing these suspect claims to stand unchallenged directly contradicts the purpose for which Congress created IPRs—“improving patent quality and providing a more efficient system for challenging patents that should not have issued.” House Report, 39-40.

4. Settled Expectations Weigh Against Discretionary Denial

The parties’ settled expectations weigh against discretionary denial. Petitioners first introduced the Samsung Members application that PO accuses of

infringement in April 2016.¹¹ (EX-1030, ¶27; EX-1043.) Despite this, neither PO nor its predecessor¹² ever asserted the '039 patent against Petitioners during the life of the patent, which issued on May 12, 2015 and expired in June 2023.¹³ (*See* EX-1001; PO Br., 31.) PO instead waited until June 2024 to sue (EX-1044)—a full year after the patent expired, and over eight years after Petitioners first introduced Samsung Members. Petitioners thus had no reason to believe they would be sued for infringement of the '039 patent and relied on these settled expectations for many years.

5. Petitioners' Reliance on Expert Testimony Provides Helpful Context to the Board

Petitioners' expert declaration provides helpful information regarding the unpatentability of the challenged claims. Dr. Houh's expert declaration (and

¹¹ The core functionality PO accuses of infringement—users sharing content with each other on mobile phones—existed as of April 2016. (*Compare* EX-1030, ¶27 (“Connect and share with others in the community”), *with* EX-1043, 3 (“Community provides a forum for Galaxy users around the world to talk freely with each other about anything related to Samsung products.”)).

¹² PO obtained ownership of the '039 patent on April 1, 2022. (EX-1031.)

¹³ PO asserts that it had settled expectations because “the challenged claims were in force since 2015 ... ” (PO. Br., 31), but PO did not acquire the '039 patent until April 1, 2022 (EX-1031).

Petitioners' reliance on his testimony) is consistent with the *Consolidated Trial Practice Guide* ("CTPG"), which states:

Expert testimony may have many uses. For example, it may be used to explain the relevant technology to the panel. It may also be used to establish the level of skill in the art and describe the person of ordinary skill in the art. Experts may testify about the teachings of the prior art and how they relate to the patentability of the challenged claims. Expert testimony may also be offered on the issue of whether there would have been a reason to combine the teachings of references in a certain way, or if there may have been a reasonable expectation of success in doing so.

(CTPG, 34-35.)

Dr. Houh's expert declaration helpfully addresses many of these uses. For example, Dr. Houh identifies the qualifications and experience of a POSITA. (EX-1003, ¶¶32-33.) He explains the teachings of the prior art (*see, e.g.*, EX-1003, ¶¶45-74 (Ground 1, explaining Randall and Forsyth)) and how they invalidate the challenged claims (*see, e.g.*, EX-1003, ¶¶82-261 (Ground 1)). He also details why a POSITA would have been motivated to combine the prior art and why there would be a reasonable expectation of success in doing so. (EX-1003, ¶¶75-81 (motivation to combine Randall and Forsyth).) In short, Dr. Houh's expert declaration provides "helpful context" regarding the prior art (April 2025 FAQs,

Q-21) and addresses key issues relating to the unpatentability of the challenged claims of the '039 patent.

PO complains that Petitioners supposedly failed to follow the guidance set forth in the Board's April 25, 2025 FAQ-21 regarding the relationship between a petition's reliance on expert testimony and the Board's discretion to institute IPR. (*See* PO Br., 32.) PO's arguments should be rejected.

First, PO faults Petitioners for not considering the Board's FAQs in the Petition, but of course Petitioners could not have done so—the Petition was filed on January 31, 2025, nearly three months before the FAQs were published.

Second, Petitioners' reliance on expert testimony does not mandate discretionary denial. Instead, the Board's FAQ-21 states only that “extensive reliance on expert testimony ... *may* suggest that the questions are better resolved in an Article III court.” April 2025 FAQs, Q-21. Under the specific facts of this case, Petitioners' reliance on expert testimony is appropriate and helpful. As noted above, Dr. Houh's expert declaration provides the Board with various categories of information relevant to the unpatentability of the challenged claims, which is consistent with the FAQs and the Consolidated Trial Practice Guide.

Third, the two examples of testimony PO discusses are in fact helpful to the Board. With respect to Ground 1, PO addresses Dr. Houh's testimony regarding limitation [1C] (“*determining information associated with at least one wireless*

networking functionality of the mobile device”) 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.) According to PO, “[o]ther than his say-so, [Dr. Houh] offers no evidence supporting a conclusion that a message sent via Forsyth’s Forums is encapsulated into a protocol message.” (PO Br., 33.) PO is wrong, for the same reasons discussed above (§V.F.1). In particular, Dr. Houh explains the knowledge a POSITA would have had with respect to GSM-SMS and WAP and how a POSITA would have applied protocol messages from those protocols to Randall and Forsyth. (EX-1003, ¶¶61-66, 160.)

PO also complains that “Forsyth is directed at neither WAP nor GSM” and that “Forsyth does not mention even once ‘WAP’ or ‘Wireless Application protocol,’ and teaches away from GSM-based platforms” (PO Br., 34.) PO’s argument is a red herring. Petitioners’ Ground 1 is based on the combination of Randall and Forsyth—not Forsyth alone. And it is undisputed that Randall—which addresses the same Symbian Forums service as Forsyth (*see, e.g.*, Petition, 8)—discloses the use of both WAP and GSM. (*See, e.g.*, EX-1005, 58:23-27 (“Using existing transports such as Circuit Switched Data (CSD) or WAP to access the services on the server side gives ServML a choice to route the transactions. Similarly, using standard IP formats such as MIME, SMTP and HTTP will enable

compatibility with Internet Messaging systems.”), 14:10-11 (“This form of data transfer could be via SMS or packet delivery in packet based systems.”) (emphasis added).)

As for Ground 2, PO argues that only Dr. Houh’s “say-so” supports the concept that users of PagerWorld in the Pelkey-Eck combination would be able to communicate using messaging over SMS or messaging over WAP protocol (PO Br., 35-36). As an initial matter, PO ignores that Ground 2 is premised on the combination of the teachings of Pelkey and Eck, both of which describe features of a modified version of the Nintendo Game Boy® or N64 game console. (EX-1003, ¶¶264-265.) Pelkey, for example, discloses “a messaging service for communicating messages between and among users of video game systems.” (EX-1003, ¶263 (citing EX-1007, 1:14-16).) The messaging service is implemented over a “network” that “includes game systems 10 connected via communications circuits (e.g., modems, network interfaces, etc.) to a wide area network.” (EX-1003, ¶263 (citing EX-1007, 2:60-62).) Eck, meanwhile, discloses PagerWorld, a specific environment where users can share photos and sound clips and exchange messages. (EX-1003, ¶271.) Eck itself discloses that the ability to exchange messages is not limited to a “pager” environment and includes other technologies like WAP. (EX-1003, ¶271 (citing EX-1008, 25:17-20).) Thus, the Pelkey and Eck

references themselves plainly disclose that the messaging communication infrastructure in Pelkey can be applied to Eck's PagerWorld environment.

For Ground 2, PO again argues that there is no support for Dr. Houh's opinion that the PagerWorld community is persistent. (PO Br., 35-36.) PO's argument is wrong here for the same reasons discussed above. (*See* §V.F.1.)

VI. Conclusion

For the reasons above, Petitioners respectfully submit that discretionary denial is inappropriate. The Director should refer the Petition to a three-member panel for consideration on the merits.

Date: June 17, 2025

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CERTIFICATE OF WORD COUNT UNDER 37 CFR § 42.24(d)

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Opposition to Patent Owner's Discretionary Denial Brief complies with the type-volume limits of the March 26 Stewart Memorandum because it contains 12,667 words according to the word-processing system used to prepare this Opposition, excluding the words in the Table of Contents, Table of Authorities, List of Exhibits, Certification Under § 42.24(d), and Certificate of Service. This word count was prepared using Microsoft Word.

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CERTIFICATE OF SERVICE

The undersigned certifies that a true copy of Petitioners' Response to Patent Owner's Discretionary Denial Brief and any new exhibits identified in the above Table of Exhibits have been served on the Patent Owner via e-mail to the following counsel of record:

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