

**From:** [Director Discretionary Decision](#)  
**To:** [Gordon, Lori A](#)  
**Cc:** [Trials](#); [Robinson, Erick](#); [Rafatijo, Homayoon](#); [Partridge, Jayme](#); [Dunn, Patrick](#); [jpiana@brownrudnick.com](#); [MDT-Samsung-BR](#); [Kline, Douglas J](#); [Reddy, Srikanth K](#); [Birbach, Naomi](#); [Gordon, Lori A](#); [DG-Samsung-MDT](#); [Director Discretionary Decision](#)  
**Subject:** RE: IPR2025-00535 through IPR2025-0544: Authorization to File Motion to Compel Routine Discovery or for Additional Discovery  
**Date:** Thursday, May 29, 2025 12:08:15 PM  
**Attachments:** [image001.png](#)  
[image002.png](#)  
[image003.png](#)  
[image004.png](#)  
[image005.png](#)  
[image006.png](#)

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Counsel – Petitioner’s request is denied. Petitioner has not provided sufficient relevance of the requested discovery to the Director’s discretionary considerations. Mindful 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.

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**From:** Trials <Trials@USPTO.GOV>  
**Sent:** Thursday, May 29, 2025 11:58 AM  
**To:** Director\_Discretionary\_Decision <Director\_Discretionary\_Decision@uspto.gov>  
**Subject:** FW: IPR2025-00535 through IPR2025-0544: Authorization to File Motion to Compel Routine Discovery or for Additional Discovery

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**From:** Gordon, Lori A <[LoriGordon@goodwinlaw.com](mailto:LoriGordon@goodwinlaw.com)>  
**Sent:** Wednesday, May 28, 2025 2:30 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Robinson, Erick <[ERobinson@brownrudnick.com](mailto:ERobinson@brownrudnick.com)>; Rafatijo, Homayoon <[HRafatijo@brownrudnick.com](mailto:HRafatijo@brownrudnick.com)>; Partridge, Jayme <[JPartridge@brownrudnick.com](mailto:JPartridge@brownrudnick.com)>; Dunn, Patrick <[PDunn@brownrudnick.com](mailto:PDunn@brownrudnick.com)>; [jpiana@brownrudnick.com](mailto:jpiana@brownrudnick.com); MDT-Samsung-BR <[MDT-Samsung-BR@brownrudnick.com](mailto:MDT-Samsung-BR@brownrudnick.com)>; Kline, Douglas J <[DKline@goodwinlaw.com](mailto:DKline@goodwinlaw.com)>; Reddy, Srikanth K <[SReddy@goodwinlaw.com](mailto:SReddy@goodwinlaw.com)>; Birbach, Naomi <[NBirbach@goodwinlaw.com](mailto:NBirbach@goodwinlaw.com)>; Gordon, Lori A <[LoriGordon@goodwinlaw.com](mailto:LoriGordon@goodwinlaw.com)>; DG-Samsung-MDT <[DG-Samsung-MDT@goodwinlaw.com](mailto:DG-Samsung-MDT@goodwinlaw.com)>  
**Subject:** IPR2025-00535 through IPR2025-0544: Authorization to File Motion to Compel Routine Discovery or for Additional Discovery

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**IPR2025-00535 (corresponding to Meta grounds): U.S. Patent 9,032,039**

**IPR2025-00536 (non-Meta grounds): U.S. Patent 9,032,039**

Honorable Board –

The parties provide the following joint email related to Petitioner’s request for authorization to file a Motion to Compel Routine Discovery and/or for Additional Discovery Relevant to Discretionary Denial Briefing.

Petitioner, Samsung, requests authorization to file a motion to compel routine discovery and/or motion for additional discovery of (1) the settlement agreement between MDT and Meta resulting in the termination of IPR2024-00248 and (2) any agreements between Meta and MDT related to settlement of IPR including, but not limited to, any term sheets.

Samsung has reason to believe the terms of the settlement agreement are inconsistent with positions taken by MDT in its discretionary denial briefs filed on May 7, 2025 and May 14, 2025 in the above-referenced IPRs. Further, although MDT chose not to cite directly to the agreement in its arguments in support of discretionary denial, MDT cited to the entire proceeding in its brief when referencing the settlement. ‘535 IPR, Paper 8 at 2. Samsung believes this and MDT’s other references to the settlement throughout its arguments justify routine discovery under 37 CFR § 42.51(b)(1)(i). While not specified in the email communication which Patent Owner has attached to this email, Petitioner raised its request under 37 CFR §42.51(b)(1)(i) in the conference call meet and confer held on the afternoon of May 23<sup>rd</sup> which Petitioner’s attendees will attest.

Additionally, discovery of the terms of the settlement agreement and timing of and content of any agreements related to settlement with Meta over the same patent is in the interest of justice, justifying additional discovery of this evidence at this stage of the proceeding. MDT has refused Samsung’s request for relief from the District Court protective order to permit filing the settlement agreement in this PTAB proceeding.

The parties have conferred via email and conference call and have failed to come to an agreement. Patent Owner’s position is provided below. Petitioner asks the Board to strike the portions of Patent Owner’s input below containing impermissible argument and Patent Owner’s impermissible inclusion of the parties’ communication as an attachment to this joint email. Petitioner further seeks a call to present its positions justifying the above requests.

Petitioner is available Thursday May 29 from 10am-5pm ET, Friday, May 30 from 10am-5pm ET, Monday June 1 from 10am-5pm ET and Tuesday, June 2 from 10am-5pm. Patent Owner is only available May 29 and June 3 between 11am-3pm ET. Patent Owner has indicated it will provide a court reporter.

Petitioner seeks to file a single motion in each IPR directed to both requests, limited to 5-pages, and

due one day after authorization is given by the Board. Petitioner requests Patent Owner's opposition brief be limited to the same number of pages and be due no later than 3 business days from the filing of Petitioner's brief. Petitioner further seeks authorization to file its motion under seal.

Although Patent Owner's discretionary denial briefs in IPR2025-00537 (U.S. Patent 8,825,801 – corresponding to Meta grounds), IPR2025-00538 (U.S. Patent 8,825,801 – non-Meta grounds), IPR2025-00539 (U.S. Patent 8,793,336 – corresponding to Meta grounds), IPR2025-00540 (U.S. Patent 8,793,336 – non-Meta grounds), IPR2025-00541 (U.S. Patent 9,922,348 – corresponding to Meta grounds), IPR2025-00542 (U.S. Patent 9,922,348 – non-Meta grounds), IPR2025-00543 (U.S. Patent 9,619,578 – corresponding to Meta grounds), and IPR2025-00544 (U.S. Patent 9,619,578 – non-Meta grounds) are not due until June 14, for efficiency, Petitioner seeks the same discovery in each of those IPR proceedings in view of the corresponding settlements of IPR2024-00247, IPR2024-00246, IPR2024-00250, and IPR2024-00249.

Patent Owner's position is as follows:

Patent Owner objects to Petitioners' communication as it improperly contains substantive arguments that require a response from Patent Owner in the interest of justice. Patent Owner requests the Director strike Petitioners' communication.

If the Director considers Petitioners' communication, Patent Owner opposes, as follows:

Petitioners failed to discharge their meet and confer obligation in good faith. As evidenced by Petitioners' May 16 email attached, Petitioners cited their "need to respond" and 37 CFR § 42.51(b)(1)(iii) as bases for their discovery request. In their proposed communication above, Petitioners for the first time cite 37 CFR § 42.51(b)(1)(i), which was not discussed in the meet and confer contrary to Petitioners' mischaracterization of the meet and confer. Accordingly, striking Petitioners' request is warranted on that basis alone.

Petitioners' discovery request is pre-mature and amounts to a fishing expedition. During the meet and confer, Petitioners failed to point to any positions taken by Patent Owner in its discretionary denial briefs in the above-referenced IPRs that are inconsistent with any provision of the MDT-Meta settlement agreement. Petitioners also fail to identify any statements in Patent Owner's discretionary denial briefs that are allegedly "inconsistent" with any provision of the MDT-Meta settlement agreement in their communication to the Board.

Furthermore, Petitioners mischaracterize Patent Owner's positions in its discretionary denial briefs as "repeated references to the settlement throughout its arguments." Patent Owner never referenced any settlement agreement in its briefs. The word "settle" appears only five times in the discretionary denial briefs, three of which refer to "settled expectations" of the parties under Fintiv factor 6, and none reference a settlement agreement between Patent Owner and Meta, as shown below:

1. "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**.” ‘535 IPR, Paper 8 at 2.

2. “A prompt joinder would have cast Petitioners as understudy should MDT and Meta **settle**, conserved the Board’s finite resources, and satisfied the Board’s preference for joinder where, like in this case, no new issues arise.” ‘535 IPR, Paper 8 at 10.
3. “**Settled** expectations of the parties, such as the length of time the claims have been in force.” ‘535 IPR, Paper 8 at 46.
4. “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.” ‘535 IPR, Paper 8 at 46.
5. “Patent Owner has a **settled** expectation in the validity of the challenged claims.” ‘535 IPR, Paper 8 at 46.

Accordingly, Petitioners’ reliance on 37 CFR § 42.51(b)(1)(i) is misplaced because Patent Owner never referenced any settlement or settlement agreement in its brief. Patent Owner cited to the entire proceeding because Petitioners put the Meta-MDT-IPRs at issue in their Notice of Ranking and throughout the Petition. *See, e.g.*, Paper 3; Petition at 6. Petitioners further filed as Exhibits in this IPR Patent Owner’s Response and Meta’s Reply from the Meta-MDT-IPRs. Merely stating that a proceeding that was mentioned by Petitioners is settled does not warrant a request for production of a highly confidential settlement agreement from that proceeding. Additionally, routine discovery is not justified under 37 CFR § 42.51(b)(1)(iii) as Petitioners fail to point to any inconsistent statements in Patent Owner’s brief that warrant routine discovery.

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Regards –

Lori A. Gordon  
Lead Counsel - Petitioner

**Lori Gordon**



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