

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

IPR2025-00540
U.S. Patent 8,793,336

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

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
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TABLE OF CONTENTS

I. Introduction.....1

II. Factual Background.....4

 A. Samsung Is an Innovator4

 B. Patent Owner Mobile Data Technologies, LLC.....4

 C. PO’s Prior Proceedings Against Meta.....6

 1. MDT Sues Meta in the MDT-Meta-Litigation6

 2. The Instituted IPR Proceeding Against the ’336 Patent.....6

 3. PO’s and Meta’s Conflicting and Changing Views on
 Claim Construction8

 a. Mobile Device8

 b. “Mobile Information Channel”.....9

 c. “Wireless Network”.....9

 4. PO and Meta Settle on the Eve of Oral Argument10

 5. The MDT-Samsung Texas Litigation.....10

III. Review of These Claims is an Efficient Use of Board Resources10

 A. The Board Previously Found a Reasonable Likelihood that the
 ’336 Patent is Invalid.....11

 B. The Examiner Erred in Issuing the ’336 Patent13

 C. Patent Owner is a PAE that Continues to Assert the ’336 Patent
 Despite the Board’s Prior Finding.....15

IV. The “Settled Expectations” of the Original Patent Owner do Not Inure
to a PAE that Recently Acquired a Patent.....16

V. Discretionary Denial Would Contradict the Purposes of the AIA.....22

 A. Weeding Out Bad Patents and Providing an Alternative to
 Costly and Inefficient District Court Litigation23

B.	Curbing NPE Forum Shopping and Reducing Economic Impact of Litigating Bad Patents.....	24
C.	Congress Deliberately Set a One Year Statutory Bar to Give Petitioners a “Reasonable Opportunity” to Prepare Their Case	25
VI.	Petitioners Filed Parallel Petitions to Address PO’s Alternative Constructions of “Mobile Device”	26
VII.	Discretionary Denial Is Not Warranted Under <i>Fintiv</i>	29
A.	Factor One Is Neutral or Favors Petitioners.....	29
B.	Factor Two: The District Court’s Trial Date Is Uncertain.....	34
C.	Factor Three: Little Investment Relating to Invalidity Will Have Occurred in the Litigation by the Institution Deadline.....	37
D.	Factor Four: Petitioners’ <i>Sotera</i> Stipulation, As Amended Herein, Removes Any Overlap With the Litigation	40
E.	Factor Five: Petitioners Are Defendants in the E.D. Texas Litigation	43
F.	Factor Six: Other Circumstances Weigh Against Discretionary Denial	43
1.	The Petition Presents a Compelling Case of Unpatentability.....	44
2.	PO Should Not Be Permitted to Game the System.....	46
3.	Unified is Not a Real Party in Interest to this Proceeding.....	49
4.	No Forum Has Adjudicated the Validity of the Challenged Claims	52
5.	Petitioners’ Reliance on Expert Testimony Provides Helpful Context to the Board.....	53
VIII.	Conclusion.....	57

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,</i> IPR2019-01469	14
<i>Anaheim Gardens, L.P. v. United States,</i> 953 F.3d 1344 (Fed. Cir. 2020)	16
<i>Apple Inc. v. Fintiv, Inc.,</i> IPR2020-00019	<i>passim</i>
<i>Apple Inc. v. Koss Corp.,</i> IPR2021-00255	35
<i>Apple Inc. v. Resonant Sys. Inc.,</i> IPR2024-00698	27
<i>Apple, Inc. v. Koss Corp.,</i> IPR2021-00381	37
<i>Applications in Internet Time, LLC v. RPX Corp.,</i> 897 F.3d 1336 (Fed. Cir. 2018)	50, 51
<i>Broadphone LLC v. Samsung Elecs. Co., Ltd.,</i> No. 2:23-cv-00001-JRG-RSP, Dkt. No. 134 (E.D. Tex. July 24, 2024)	32, 33
<i>C.R. Bard, Inc. v. Medline Indus., Inc.,</i> No. 2020-1900, 2021 WL 3574043 (Fed. Cir. Aug. 13, 2021)	45, 56
<i>Cellco P’ship v. Huawei Device Co., Ltd.,</i> IPR2020-01117	36
<i>Cellspin Soft, Inc. v. ByteDance Ltd.,</i> No. 2:23-cv-00496-JRG-RSP, Dkt. No. 106 (E.D. Tex. Jan. 26, 2025)	31, 33

<i>Commc 'n Techs., Inc. v. Samsung Elecs. Am., Inc.</i> , No. 2:21-cv-00444-JRG-RSP, Dkt. No. 134 (E.D. Tex. Feb. 2, 2023)	30, 32
<i>CrowdStrike, Inc. v. GoSecure, Inc.</i> , IPR2025-00068, -070.....	28
<i>Dell Techs. Inc. v. WSOU Investments, LLC</i> , IPR2021-00272	37, 38
<i>Google LLC v. Mullen Indus. LLC</i> , IPR2025-00021	30
<i>Harbor Island Dynamic, LLC v. Samsung Elecs. Co., Ltd.</i> , No. 2:24-CV-00140-JRG-RSP, Dkt. No. 81 (E.D. Tex. May 19, 2025)	32, 33
<i>Hulu LLC v. SITO Mobile R&D IP, LLC</i> , IPR2021-00158.....	35, 37
<i>Hulu, LLC v. SITO Mobile R&D IP, LLC</i> , IPR2021-00298	34
<i>Intel Corp. v. Proxense LLC</i> , IPR2025-00327, -328, -329	2, 19, 20, 21
<i>Juniper Network, Inc. v. Packet Intel. LLC</i> , IPR2020-00336	38
<i>Meta Platforms, Inc. v. Mobile Data Techs., Inc.</i> , IPR2024-00246	<i>passim</i>
<i>Mobile Data Technologies LLC v. Samsung Electronics America, Inc.</i> , No. 2:24-cv-435-JRG-RSP (E.D. Tex.).....	10
<i>Mobile Data Techs. LLC v. Meta Platforms, Inc.</i> , No. 3:24-cv-00896-WHA (N.D. Cal.).....	<i>passim</i>
<i>Mobileye Glob., Inc. v. Facet Tech. Corp.</i> , IPR2024-01110	39

<i>My Health, Inc. v. ALR Techs., Inc.</i> , No. 2:16-cv-00535-RWS-RSP, 2017 WL 6512221 (E.D. Tex. Dec. 19, 2017)	48
<i>Netlist, Inc. v. Micron Tech., Inc.</i> , No. 2:22-cv-00203-JRG-RSP, Dkt. No. 493 (E.D. Tex. Feb. 10, 2024)	31
<i>NeuMoDx Molecular v. HandyLab, Inc.</i> , IPR2020-01132	37
<i>Nokia of Am. Corp. v. IPCom, GmbH & Co. KG</i> , IPR2021-00533	36
<i>Nordlinger v. Hahn</i> , 505 U.S. 1 (1992).....	17
<i>Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC</i> , 584 U.S. 325 (2018).....	23
<i>Palo Alto Networks, Inc. v. Centripetal Networks, LLC</i> , IPR2021-01157	41
<i>Publishing Techs. LLC v. RPX Corp.</i> , No. 2020-1420, -1421 (Fed. Cir. Apr. 9, 2021).....	17
<i>Quibi Holdings, LLC v. JBF Interlude 2009 Ltd</i> , IPR2021-00231	35
<i>Resonant Sys., Inc. v. Samsung Elecs. Co.</i> , No. 2:22-CV-00423-JRG, 2024 WL 1021023 (E.D. Tex. Mar. 8, 2024)	31
<i>RPX Corp. v. Publishing Techs., LLC</i> , IPR2018-01131	17
<i>RPX Corp. v. Publishing Techs., LLC</i> , IPR2018-01132	17
<i>Saint Lawrence Commc’ns LLC v. ZTE Corp.</i> , No. 2:15-cv-349-JRG, 2017 WL 3396399 (E.D. Tex. Jan. 17, 2017)	32

<i>Samsung Elecs. Co., Ltd. v. CardWare Inc.,</i> IPR2023-00211	36
<i>Samsung Elecs. Co., Ltd. v. Headwater Rsch. LLC,</i> IPR2024-01396	39
<i>Samsung Elecs. Co. Ltd. v. MemoryWeb, LLC,</i> IPR2022-00222	19
<i>Samsung Elecs. Co., Ltd. v. Mobile Data Techs. LLC,</i> IPR2025-00539	<i>passim</i>
<i>Sand Revolution II, LLC v. Cont'l Intermodal Grp.-Trucking LLC,</i> IPR2019-01393	33
<i>SAP Am., Inc. v. Cyandia, Inc.,</i> IPR2024-01496	35
<i>Savant Technologies LLC v. Feit Electric Co., Inc.,</i> IPR2025-00260	22, 24
<i>Shenzen Tuozhu Tech. Co., Ltd. v. Stratasyys, Inc.,</i> IPR2025-00354	43
<i>Snap, Inc. v. SRK Tech. LLC,</i> IPR2020-00820	38
<i>STA Grp. LLC v. Motorola Sols., Inc.,</i> No. 2:22-cv -00381-JRG-RSP, 2024 WL 2852961 (E.D. Tex. June 5, 2024)	31
<i>Tesla, Inc. v. Navy,</i> IPR2025-00341	22
<i>Tesla, Inc. v. Intell. Ventures II LLC,</i> IPR2025-00217, -219-222, -339	<i>passim</i>
<i>Tessera Advanced Techs., Inc. v. Samsung Elecs. Co., Ltd.,</i> No 2:17-cv-00671-JRG, 2018 WL 3472700 (E.D. Tex. July 19, 2018)	32, 33
<i>Therabody, Inc. v. Hyperice IP Subco, LLC,</i> PGR2024-00053	14

<i>Thryv, Inc v. Click-To-Call Techs., LP</i> , 590 U.S. 45 (2020).....	22
<i>Unified Pats., Inc. v. Realtime Adaptive Streaming, LLC</i> , IPR2018-00883	49, 51
<i>Unified Pats., LLC v. Fat Statz, LLC</i> , IPR2020-01665	50
<i>Unified Pats., LLC v. MemoryWeb, LLC</i> , IPR2021-01413	49, 50
<i>Uniloc 2017 LLC v. Facebook Inc.</i> , 989 F.3d 1018 (Fed. Cir. 2021)	51, 52
<i>Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.</i> , IPR2017-00651	52
<i>Worlds Inc. v. Bungie, Inc.</i> , 903 F.3d 1237 (Fed. Cir. 2018)	50
<i>Zynga, Inc. v. IGT</i> , IPR2022-00199	36
Statutes	
35 U.S.C. § 316.....	24
Leahy-Smith America Invents Act	<i>passim</i>
Other Authorities	
37 C.F.R. § 42.20	47
37 C.F.R. § 42.51	48
37 CFR § 42.100	26
USPTO, <i>Consolidated Trial Practice Guide</i>	53
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	48

EXHIBIT LIST

Exh.	Reference
1001	U.S. Patent 8,793,336 to Harper (“the ’336 patent”)
1002	File History of U.S. Patent 8,793,336
1003	Declaration of Dr. Henry Houh in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent 8,793,336
1004	Curriculum Vitae of Dr. Henry Houh
1005	WO 02/17652 to Randall, et al. (“Randall”)
1006	U.S. Patent 7,047,030 to Forsyth (“Forsyth”)
1007	U.S. Patent 7,056,217 to Pelkey, et al. (“Pelkey”)
1008	U.S. Patent 6,716,103 to Eck, et al. (“Eck”)
1009	Joint Claim Construction Statement from <i>Mobile Data Techs. LLC v. Meta Platforms, Inc.</i> , No. 7:22-cv-00244-ADA-DTG (E.D. Tex.)
1010	Patent Owner’s Response to Petition (Paper 27) from <i>Mobile Data Techs. LLC v. Meta Platforms, Inc.</i> , IPR2024-00246
1011	Petitioner’s Reply (Paper 34) from <i>Mobile Data Techs. LLC v. Meta Platforms, Inc.</i> , IPR2024-00246
1012	“Wireless Java for Symbian Devices” by Allin (September 2001) (“Allin”)
1013	WAP Architecture (Version 12): “Wireless Application Protocol Architecture Specification, WAP-210-WAPArch-20010712” (July 12, 2001) (“WAP Architecture”)
1014	Wireless Datagram Protocol (Version 14): “Open Mobile Alliance, WAP-259-WDP-20010614-a” (June 14, 2001) (“WDP”)
1015	ETSI TS 123 040—Digital cellular telecommunications system (Phase 2+) (GSM); Universal Mobile Telecommunications System (UMTS);

Exh.	Reference
	Technical realization of the Short Message Service (SMS) (3GPP TS 23.040 version 3.6.0) (September 2001) (“GSM SMS Standard”)
1016	“Symbian OS Communications Programming” by Michael J. Jipping (June 2002) (“Jipping”)
1017	“Symbian Home Page,” (January 24, 2002), https://web.archive.org/web/20020124070457/http://www.symbian.com:80/
1018	“Symbian: OS Technology,” (February 2, 2002), https://web.archive.org/web/20020202090443/http://www.symbian.com/technology/technology.html
1019	“Symbian: OS Technology – Symbian OS phones and PDAs,” (February 2, 2002) https://web.archive.org/web/20020202133445/http://www.symbian.com/technology/symbos-phones.html
1020	U.S. Patent 6,947,396 to Salmi (“Salmi”)
1021	RESERVED
1022	RESERVED
1023	U.S. Patent 6,788,949 to Bansal (“Bansal”)
1024	U.S. Patent 7,802,207 to Agboatwalla, et al. (“Agboatwalla”)
1025	U.S. Patent 7,574,486 to Cheng, et al. (“Cheng”)
1026	“Operating System Concepts” (Fourth Edition) by Silberschatz et al. (January 1994) (“Silberschatz”)
1027	U.S. Patent 6,937,588 to Park (“Park”)
1028	Excerpt from Webster’s Dictionary of Computer Terms (page 98)
1029	RESERVED

Exh.	Reference
1030	RESERVED
1031	RESERVED
1032	File History of <i>Ex Parte</i> Reexamination of U.S. Patent 8,793,336
1033	RESERVED
1034	H.R. Rep. No. 112-98 (2011)
1035	Delaware Department of State, Division of Corporations, Entity Page for Mobile Data Technologies LLC, https://icis.corp.delaware.gov/ecorp/entitysearch/NameSearch.aspx
1036	First Am. Compl., <i>Mobile Data Techs. LLC v. Samsung Elecs. Am., Inc.</i> , No. 2:24-cv-00435-JRG-RSP, Dkt. No. 25 (E.D. Tex. Oct. 6, 2024)
1037	Patent Assignment Record for US 8,793,336 to Mobile Data Technologies LLC
1038	Patent Assignment Record for US 8,793,336 conveying Security Interest to Chisum
1039	Order Re Def.’s Mot. to Compel Litig. Funding Docs., <i>Entangled Media, LLC v. Dropbox Inc.</i> , No. 23-cv-03264-PCP (VKD), Dkt. No. 254 (N.D. Cal. Apr. 8, 2025)
1040	Order, <i>Electrolysis Prevention Sols. LLC v. Daimler Truck North Am. LLC</i> , No. 3:21-cv-00171-TEJ-WCM, Dkt. No. 147 (W.D.N.C. July 24, 2023)
1041	Complaint, <i>Mobile Data Technologies LLC v. Meta Platforms, Inc.</i> , Case No.7:22-cv-00244-ADA-DTG, Dkt. No. 1 (W.D. Tex. Nov. 23, 2022)
1042	<i>America Invents Act: Hearing on H.R. 1249 Before the Subcomm. on Intell. Prop., Competition, & the Internet of the H. Comm. on the Judiciary</i> , 112th Cong. (March 30, 2011)

Exh.	Reference
1043	157 Cong. Rec. 13,159 (2011)
1044	Docket Navigator, Gilstrap Uncontested Motions to Stay Pending IPR, 2014-present, pulled May 26, 2025
1045	Pl.’s Unopposed Mot. to Stay Proceedings Pending IPR, <i>Mobile Data Technologies LLC v. Meta Platforms, Inc.</i> , Case No.3:24-cv-00896-WHA, Dkt. No. 111 (N.D. Cal. Apr. 18, 2024)
1046	Pacer, List of Calendar Events Set for Judge Gilstrap for 4/1/2026-4/30/2026, pulled June 4, 2025
1047	United States District Court – Judicial Caseload Profile 2020-March 2025
1048	Jennifer Nall, DLA Piper, <i>How Delayed Notice of Date Accorded Mailings May Affect Inter Partes Review</i> (June 3, 2025), https://www.dlapiper.com/en/insights/publications/intellectual-property-news/2025/how-delayed-notice-of-date-accorded-mailings-may-affect-inter-partes-review
1049	Andrew T. Dufresne et al., Perkins Coie, <i>How Reliable are Trial Dates Relied on by the PTAB in the Fintiv Analysis?</i> , 1600 PTAB & Beyond (Oct. 29, 2021)
1050	Katherine K. Vidal, Under Sec’y of Com. for Intell. Prop. & Dir. of the USPTO, Mem. Re Interim Proc. for Discretionary Denials in AIA Post-Grant Procs. with Parallel Dist. Ct. Litig. (June 21, 2022), <i>rescinded</i> Feb. 28, 2025
1051	Email from N. Birbach to Counsel for PO re IPR Nos. IPR2025-00535 – IP2025-00544 – Updated Sotera Stipulation
1052	Samsung Newsroom, Samsung Members App Puts Galaxy Experts at Your Fingertips (Apr. 8, 2016), https://news.samsung.com/global/samsung-members-app-puts-galaxy-experts-at-your-fingertips

Exh.	Reference
1053	Complaint, <i>Mobile Data Techs. LLC v. Samsung Elecs. Am., Inc.</i> , No. 2:24-cv-00435-JRG-RSP, Dkt. No. 1 (E.D. Tex. June 10, 2024)
1054	RESERVED
1055	Excerpts of file history of <i>Inter Partes</i> Reexamination of U.S. Patent No. 8,135,801 B2
1056	<i>Unified Patents, LLC v. MemoryWeb LLC</i> , IPR2022-00222, Exhibit 2091
1057	Unified Patents Real Party-in-Interest (RPI) Decisions (May 20, 2019), https://www.unifiedpatents.com/rpi
1058	Unified Patents, FAQ (last visited June 25, 2025), https://www.unifiedpatents.com/faq

I. Introduction

This is precisely the type of situation where *inter partes* review is an efficient use of Board resources for at least two reasons. First, the Board has already found that there is a reasonable likelihood that the challenged claims of the '336 patent are invalid. Specifically, the Board instituted IPR against all challenged claims (claims 1, 6-11, 13-18, 20-27) on June 11, 2024 based on a petition filed by Meta Platforms, Inc. *See* IPR2024-00246 (the "Meta-MDT-IPR"), Paper 12. Patent Owner ("PO") is a Patent Assertion Entity ("PAE") who continues to assert the challenged patent despite the Board's prior finding. Second, the Examiner erred by failing to identify or apply the art set forth in the Petition, and as a result, none of this art was considered during prosecution.

PO cannot credibly claim that it had settled expectations as to the validity of the challenged patent. PO owned the patent for less than three years and has been defending it against invalidity challenges for nearly as long as it has owned the patent. Nor is PO entitled to the benefit of any settled expectations of prior owners of the patent. Even if it was, there is no evidence that the prior owners had such settled expectations. For example, two patents in the same family as the challenged patent were invalidated by the Board years ago, with both decisions affirmed on appeal by the Federal Circuit. Accordingly, to the extent there were any settled expectations concerning the validity of the '336 patent, such expectations included

that the patents were, at most, of questionable validity. Moreover, the accused product in the litigation (Petitioners’ “Samsung Members” application) was launched in 2016 with no claim for patent infringement asserted by PO at any point until 2024. Unlike Petitioners, neither PO nor its predecessors ever commercialized or applied the claimed technology in any way. Therefore, all of the reasons set forth in the Director’s recent guidance in *Intel Corp. v. Proxense LLC*, IPR2025-00327, 328, 329, Paper 12, 2-3 (PTAB June 26, 2025), weigh against discretionary denial.

Indeed, the facts here against discretionary denial are at least as strong as those presented in *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, -219-222, -339, Paper 10, 3 (Stewart June 13, 2025). In *Tesla*, the Director did not exercise discretion to deny institution because IPR was instituted on three ancestor patents to the challenged patent. *Id.* Here, the Board *instituted* IPR on the challenged patent and the Board has *invalidated* two patents in the same family with both findings summarily affirmed on appeal. As in *Tesla* the FWD date here would be after the likely trial date. And as in *Tesla*, the complexity of the district court case – where 70 claims are asserted across 5 different patents – weighs in favor of institution despite the FWD date. Put simply, the Director’s decision in *Tesla* cannot be reconciled with any decision exercising discretion to deny this petition.

Finally, the Director should not exercise discretion to deny the petition because doing so would reward PO's gamesmanship. PO sued Petitioners in the Eastern District of Texas on June 10, 2024, but did not assert the '336 patent until October 6, 2024 – a date strategically timed to prevent Petitioners from joining the Meta-MDT-IPR. 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 '336 patent (and other related patents challenged by Meta). Through its discretionary denial brief, PO essentially seeks the Director's assistance to yet again avoid an invalidity finding against the '336 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." (EX-1034, 39-40.) 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.

Accordingly, the Director should decline to exercise discretionary denial and refer a three-member panel of the Board to consider the merits of the Petition.

II. Factual Background

A. Samsung Is an Innovator

Samsung is one of the most innovative companies in the world. In the United States alone, Samsung has been awarded over 145,000 patents—the most of any company. 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-1035; EX-1036, ¶1.) According to PO, it “specializes in mobile technologies and social media solutions.” (EX-1036, ¶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 '336 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 '336 patent (*see* EX-1037), and, as discussed further below, the subsequent assertion of those patents against Meta in November 2022 and against Petitioners in October 2024.¹

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 '336 patent to Chisum on September 29, 2022, just before PO filed suit against Meta. (EX-1038.) Chisum’s business is to fund patent litigations. (*See, e.g.*, EX-1039 (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-1040, 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”).)

¹ PO asserted four related patents against Petitioners in June 2024 (EX-1053), but did not assert the '336 patent until filing an amended complaint in October 2024 (EX-1036).

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 ‘336 patent, among other patents.² (EX-1041.) PO accused “Defendants’ social media mobile applications and related software, including without limitation those made available under the Facebook brand” of infringement. (*Id.*, ¶88.)

2. The Instituted IPR Proceeding Against the ‘336 Patent

On December 6, 2023, Meta filed a petition for IPR challenging claims 1, 6-11, 13-18, and 20-27 of the ‘336 patent. IPR2024-00246, Paper 2. Ground 1 challenged claims 1, 6-11, 13-18, 20-21, and 23-27 based on Neibauer, Miller, and Cheng; Ground 2 challenged claim 7 based on those references in further view of Ausems; and Ground 3 challenged claims 21-22 based on the Ground 1 references in further view of Fransioli. *Id.*, 3. Meta also raised Grounds 4-6 in further view of Harvey to account for a potential construction of “*mobile information channel*” Meta proposed in the MDT-Meta-Litigation. *Id.*, 3, 10.

² 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”).

On June 11, 2024, the Board instituted IPR of the '336 patent. IPR2024-00246, Paper 12. 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.*, 14-15. The Board noted that "there is no dispute that Miller was not 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 Miller is substantially the same as US 7,802,207 to Agboatwalla et al., which was presented during prosecution. *Id.*

On the merits, the Board found "there is a reasonable likelihood that Petitioner [Meta] will prevail in demonstrating that claim 1 is unpatentable as obvious in view of Neibauer, Miller, and Cheng." *Id.*, 31. The Board stated that, "the combination of Neibauer and Miller teaches limitations 1a and 1b." which are the only limitations PO disputed pre-institution. *Id.*, 28. In particular, the Board concluded that "it would have been obvious to a person having ordinary skill in the art to use the features of the Yahoo! Club (information channels) [in Neibauer] with a mobile device, thus using a 'mobile information channel' as recited in claim 1." *Id.*, 24.

The Board scheduled oral argument (for the '336 and five other related patents asserted against Meta) for March 11, 2025. IPR2024-00246, Paper 13.

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, 2-3; EX-1010, 21-31; EX-1011, 2-10.)

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. “Mobile Information Channel”

MDT-Meta-Litigation	
PO	plain and ordinary meaning; alternatively, “a medium for transferring information that allows mobile device users to author content”
Meta	“a virtual location at the content management site at which user-authored content may be added for transmission to the mobile web site” where “content management site” = “a web site that allows a user without programming to create and manage content on a mobile website, or a portion thereof.”
Meta-MDT IPR	
PO	“a component of a mobile site configured to permit a wide variety of mobile devices to send and receive content over a wireless network”
Meta	“a medium for transferring information that allows mobile device users to author content”

c. “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.*, 21-22.) This

construction differed from PO’s litigation construction, which was “a piece of handheld equipment.” (EX-1009, 3.) PO also proposed “*mobile information channel*” to mean “a component of a mobile site configured to permit a wide variety of mobile devices to send and receive content over a wireless network.” (EX-1010, 19.)

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. IPR2024-00246, Paper 39. 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. IPR2024-00246, Paper 40.

5. The MDT-Samsung Texas Litigation

PO sued Petitioners for patent infringement on June 10, 2024 alleging infringement of four patents, none of which were the ’336 patent. *Mobile Data Technologies LLC v. Samsung Electronics America, Inc.*, No. 2:24-cv-435-JRG-RSP (E.D. Tex.). PO amended its complaint on October 6, 2024 to assert the ’336 patent and served infringement contentions on the same day, asserting 16 claims.

III. Review of These Claims is an Efficient Use of Board Resources

Reviewing the challenged claims would be an efficient use of Board resources because the Board already determined in the Meta-MDT-IPR there is a

reasonable likelihood that the same challenged claims are invalid. The Examiner thus erred in issuing these claims, and PO knows it. Facing an imminent adverse ruling against its litigation vehicle—the '336 patent—PO abruptly settled the Meta-MDT-IPR on the eve of trial and shifted tactics to once again avoid substantive review. The Board should not reward such maneuvering; its resources are better spent putting a stop to it.

A. The Board Previously Found a Reasonable Likelihood that the '336 Patent is Invalid

The Board already determined “there is a reasonable likelihood that Petitioner [Meta] will prevail in demonstrating that claim 1 is unpatentable as obvious in view of Neibauer, Miller, and Cheng.” IPR2024-00246, Paper 12, 31. This previous finding confirms that the '336 patent is, at the very least, of questionable validity. The Board’s resources would therefore be well-spent picking up where it left off in the Meta-MDT-IPR.

The Board’s prior conclusion in the Meta-MDT-IPR is compelling evidence of unpatentability warranting IPR institution. *See Tesla v. Intell. Ventures II*, IPR2025-00217, Paper 10, 2. The strength of Petitioners’ prior art challenge is further emphasized by a Federal Circuit decision, which affirmed that all claims of an ancestor patent were unpatentable.

In *Tesla*, the Director refused to discretionarily deny because three prior IPR institutions against an ancestor patent weighed in favor of unpatentability and

against discretionary denial. *Id.* The decision was made even though a stay was unlikely and trial was likely to proceed prior to an FWD. *Id.* In *Tesla*, the three ancestor IPRs were terminated prior to final written decision due to settlement. *Id.*, Paper 12. Petitioners here present an equally strong prior art challenge.

Indeed, the Board has, on multiple occasions, called into question the patentability of the '336 patent, so there is likely an even more compelling story of unpatentability in this Petition than in the one considered in *Tesla*. Where *Tesla* involved IPRs for an ancestor patent only, the '336 patent itself was subject to institution in the Meta-MDT-IPR. As discussed above (§II.C.2), the Board determined “there is a reasonable likelihood that Petitioner [Meta] will prevail in demonstrating that claim 1 is unpatentable as obvious.” IPR2024-00246, Paper 12, 21-31. And, as in *Tesla*, the Meta-MDT-IPR was terminated before a final written decision due to settlement, leaving the patentability of the '336 patent unresolved.

The Meta-MDT-IPR alone confirms the strength of Petitioners' challenge, but it is not the only instance where the Board cast doubt on the patentability of the '336 patent. In 2012, Facebook (predecessor to Meta) filed an *inter partes* reexamination request for US 8,135,801 (“the '5801 patent”), parent to the '336 patent. The Examiner found all 20 original claims and 11 claims added by amendment were either anticipated or rendered obvious. (EX-1055, 14.) This finding was affirmed by the Board and the Federal Circuit on appeal. (*Id.*, 14, 18-

19.) Where the ancestor IPRs in *Tesla* never reached a final decision on patentability, the unpatentability of the '5801 patent was determined by the Examiner, the Board, and the Federal Circuit. The history of evidence pointing to unpatentability is even more compelling than in *Tesla* and not only favors institution, it outweighs other factors in the same way it did in *Tesla*.

B. The Examiner Erred in Issuing the '336 Patent

Petitioners respectfully submit that the Examiner materially erred in allowing the claims of the '336 patent, as demonstrated by the Board's prior institution decision in the Meta-MDT-IPR and the Petition's thorough analysis of how the combinations of Randall-Forsyth and Pelkey-Eck render obvious the challenged claims.

The Examiner's first error was in failing to identify Randall, Forsyth, Pelkey, and Eck, as well as Miller from the Meta-MDT-IPR, as relevant prior art. Had the Examiner located and reviewed these references, the claims would not have issued. The Examiner's second error is in overlooking the teachings of Neibauer and Cheng from the Meta-MDT-IPR, which were cited in Information Disclosure Statements initialed by the Examiner. But had the Examiner actually analyzed the claims in view of Neibauer and Cheng, he would have realized that the claims were invalid. But for the Examiner's failure to identify Randall, Forsyth, Pelkey, Eck, and Miller and apply the teachings of Neibauer and Cheng to the

challenged claims, the '336 patent would not have issued. Petitioners' prior art in both this and the IPR2025-00539 petition renders obvious each of limitations [1B]-[1D] identified as missing from the prior art in the Notice of Allowance. (EX-1002, 357.) In other words, the Examiner erred by overlooking the teachings of Randall, Forsyth, Pelkey, Eck Miller, Neibauer, and Cheng that "impact patentability of the challenged claims." *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8 n.9 (PTAB Feb. 13, 2020).

The Examiner's material error in missing the teachings of Neibauer, Miller, and Cheng is confirmed by the fact that the Board already instituted IPR of the '336 patent, concluding that "there is a reasonable likelihood that Petitioner [Meta] will prevail in demonstrating that claim 1 is unpatentable as obvious in view of Neibauer, Miller, and Cheng." *See* IPR2024-00246, Paper 13, 21-31; *see also Therabody, Inc. v. Hyperice IP Subco, LLC*, PGR2024-00053, Paper 8, 10 (PTAB Apr. 21, 2025) ("We agree with Petitioner that the Examiner did not identify the pertinence of Mabuchi's disclosure and did not issue a rejection based on such disclosure or combined teachings, and that this constitutes Examiner error.").

Relying on the same disclosures identified by Petitioners in the IPR2025-00539 petition, the Board concluded, based on the record before it, that "the combination of Neibauer and Miller teach limitations 1a and 1b," "Neibauer teaches limitation 1b" and that "limitation 1c and 1d would have been obvious to a

person having ordinary skill in the art in light of Neibauer.” *See* IPR2024-00246, Paper 12, 21-31. The Examiner therefore materially erred in allowing the claims to issue.

C. Patent Owner is a PAE that Continues to Assert the '336 Patent Despite the Board's Prior Finding

Mobile Data Technologies, LLC is a PAE whose business model relies on collecting revenue from innovative companies like Samsung. As discussed above, PO has no online presence, provides no products or services relating to “mobile technologies and social media solutions” or otherwise, and has no product that practices the alleged invention of the '336 patent. (EX-2026, 11 (“MDT does not assert that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention.”).)

PO purchased the '336 patent, along with five other patents in the same family, on April 1, 2022 (*see* EX-1037) and immediately asserted the patents against Meta. When Meta came too close to invalidating the patents PO hoped would provide its only source of revenue, PO settled and shifted its focus to Petitioners. Despite knowing the '336 patent is weak, PO continues to enforce it against innovative companies, wasting both innovator and Board resources. Indeed, PO asserts 70 claims across five patents in the parallel district court proceeding. The Board is best situated to handle PO's overbroad enforcement of its weak patent. If this Petition is discretionarily denied, PO will no doubt continue its

enforcement campaign against other innovators, risking the possibility that the Board will once again be asked to review the claims of the '336 patent. Thus, it would be a prudent use of Board resources to nip PO's practices in the bud by finally determining the patentability of the '336 patent.

IV. The “Settled Expectations” of the Original Patent Owner do Not Inure to a PAE that Recently Acquired a Patent

PO cannot reasonably claim to have “settled expectations” in the validity of a patent which it had been actively litigating for more than 2.25 out of the 2.8 years it had owned the patent at the time this Petition was filed. (*Compare* EX-1037, with EX-1041.) PO's purported “settled expectations” belong to the original patent owner and did not transfer to PO when it acquired the '336 patent solely for the purpose of monetizing it through litigation in which validity was certain to be a contested issue. The parties' settled expectations thus weigh against discretionary denial.

PO acquired the '336 patent on April 1, 2022. It then quickly sued Meta less than eight months later on November 23, 2022. PO knew when it bought the '336 patent that innovators like Samsung would not simply lie down in the face of an infringement allegation. Indeed, a PAE in particular would understand that challenges to validity are a guarantee in patent litigation, and would thus have no expectation, let alone a “settled” expectation, that the validity of its patent would go unquestioned in any enforcement action. *Cf. Anaheim Gardens, L.P. v. United*

States, 953 F.3d 1344, 1350-51 (Fed. Cir. 2020) (“the timing of the purchase and knowledge of the purchaser”—especially “a sophisticated investor”—“are relevant considerations in determining whether a purchaser had reasonable investment-backed expectations” in the takings context); *Nordlinger v. Hahn*, 505 U.S. 1, 12-13 (1992) (“[A]n existing owner rationally may be thought to have vested expectations in his property or home that are more deserving of protection than the anticipatory expectations of a new owner at the point of purchase.”).

By the time it acquired the ’336 patent in April 2022, the patentability of the ’336 patent had been called into question on multiple occasions. (*Supra* §III.A.) Twelve years prior, Facebook sought reexamination of the ’5801 patent, resulting in a finding that all twenty claims were unpatentable in part over Neibauer. (EX-1055, 14.) That finding was later affirmed by both the Board and the Federal Circuit. (*Id.*, 14, 18-19.)

The ’336 patent’s vulnerability was further confirmed by the Board’s 2020 decision finding all claims of another related patent, U.S. Patent No. 7,908,342 (ancestor to the ’336 patent) unpatentable. *See RPX Corp. v. Publishing Techs., LLC*, IPR2018-01131, Paper 44 (PTAB Jan. 7, 2020); *RPX Corp. v. Publishing Techs., LLC*, IPR2018-01132, Paper 43 (PTAB Dec. 2, 2019); *both aff’d Publishing Techs. LLC v. RPX Corp.*, No. 2020-1420, -1421 (Fed. Cir. Apr. 9, 2021). Had PO conducted any sort of due diligence prior to purchasing the ’336

patent, it would have discovered these proceedings. Thus, to the extent there were any settled expectations of the parties concerning the validity of the '336 patent, such expectations included that the patents were, at most, of questionable validity.

PO's "settled expectations" post-acquisition are equally nonexistent. Besides the fact that PO has been litigating the '336 patent for almost the entirety of its ownership, PO should have been convinced beyond a doubt that the '336 patent was at risk when the Board instituted the Meta-MDT-IPR. The Board concluded that "there is a reasonable likelihood that Petitioner [Meta] will prevail in demonstrating that claim 1 is unpatentable as obvious in view of Neibauer, Miller, and Cheng." IPR2024-00246, Paper 11, 21-31.

PO argues "institution of [the] Meta-MDT-IPRs does not undermine PO's settled expectation" because the standard for institution is "reasonable likelihood of success" as to one challenged claim versus the "preponderance of the evidence" standard required to invalidate all claims. (PO Br., 41 n.18.) PO clearly does not even believe its own argument, given that it settled the Meta-MDT-IPR on the eve of trial, most likely because it expected Meta to succeed on the merits and wanted to avoid a final written decision finding the claims unpatentable.

Petitioners do not concede they had notice³ of the '336 patent since 2015 as PO suggests, but even if they had, it would be irrelevant to PO's settled expectations because PO did not own the '336 patent in 2015. And as discussed above, "settled expectations" of any predecessor-in-interest do not inure to a PAE. What's more, Petitioners' settled expectations weigh heavily against discretionary denial in this case.

The Director's recent guidance in *Intel Corp. v. Proxense LLC* is enlightening. IPR2025-00327, 328, 329, Paper 12, 2-3 (PTAB June 26, 2025). In *Intel*, the Director explained:

There may be persuasive reasons why the Board should review challenged claims several years after their issuance date. For example, ... a patent may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a

³ PO also alleges Petitioners had notice of the '336 patent based on a reexamination request filed in June 2023 by Unified Patents LLC ("Unified"). (PO Br., 42.) Even if one or both Petitioners were members of Unified, Unified "does not discuss details with its members concerning the preparation and prosecution of post-grant review challenges ... including whether Unified will (or will not) file" and "Unified retains sole and absolute discretion" over its post-grant challenges. (EX-1058, 2; *see also Samsung Elecs. Co. Ltd. v. MemoryWeb, LLC*, IPR2022-00222, EX-2121, 42-52 (PTAB Dec. 8, 2023) (declining to find Samsung as RPI in Unified IPR). PO offers no evidence that Samsung knew of or was in any way involved in Unified's challenge. PO thus does not prove notice.

petitioner's particular technology space, if at all. These non-exclusive examples provide considerations that weigh against a patent owner's claim of settled expectations and bears on the Director's discretion.

Id.

Here, PO admitted in litigation that it has no product that practices the alleged invention of the '336 patent. (EX-2026, 11.) And to Petitioners' knowledge, the '336 patent was never commercialized by PO's predecessor. Further, Petitioners first introduced the Samsung Members application that PO accuses of infringement in April 2016.⁴ (EX-1036, ¶27; EX-1052.) Despite this, neither PO nor its predecessor ever asserted the '336 patent against Petitioners during the life of the patent, which issued on July 29, 2014 and expired in August 2024. (*See* EX-1001; PO Br., 41-42.) PO instead waited until October 2024 to sue (EX-1036)—after the patent expired, and over eight years after Petitioners first introduced Samsung Members. Analogizing to real property law, the settled expectations of an alleged violator would exceed those of the property owner under such circumstances. *See, e.g.*, Restatement (First) of Prop. § 459 cmt. a (1993)

⁴ The core functionality PO accuses of infringement—users sharing content with each other on mobile phones—existed as of April 2016. (*Compare* EX-1036, ¶27 (“Connect and share with others in the community”), *with* EX-1052, 3 (“Community provides a forum for Galaxy users around the world to talk freely with each other about anything related to Samsung products.”)).

(“Through lapse of time old rights become obscure. A long continued use raises reasonable expectations of its continuance.”). Petitioners’ consistent and continuous use of the accused products, with no competing commercialization or enforcement for eight years should weigh heavily against discretionary denial. *See Intel*, IPR2025-00327, Paper 12, at 2-3. Petitioners had no reason to believe they would be sued for infringement and relied on these settled expectations for many years.

PO also argues that the age of the patent weighs in favor of discretionary denial. (PO Br., 41-42.) But PAEs like MDT should not benefit from strategically waiting to acquire and assert weak patents against innovative companies such as Samsung. The mere passage of time does not transform a low-quality patent into a stronger one. Granting weight to MDT’s so-called “settled expectations”—especially when Petitioners’ accused products were publicly available well before MDT’s formation (*see* EX-1035)—would be contrary to the public interest. Such reasoning would encourage PAEs to delay enforcement and assert patents only late in their life cycle, instead of promptly addressing alleged infringement. Adopting MDT’s argument would send the wrong message, effectively rewarding entities for acquiring questionable patents late in their term simply to shield them from *inter partes* review.

Under these circumstances, the age of the '336 patent weighs against discretionary denial. It certainly should not be treated as determinative in MDT's favor. *See, e.g., Tesla, Inc. v. Navy*, IPR2025-00341, Paper 12 (Stewart June 13, 2025) (no discretionary denial for 18-year-old patent); *Tesla v. Intell. Ventures II*, IPR2025-00217, Paper 10 (same for 14-year-old patent).

V. 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.”); (EX-1034, 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.” (*Id.*, 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. (See EX-1034, 40.)

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.” (EX-1034, 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 EX-1034, 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,” (*id.*, 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. (*See* EX-1034, 40.)

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” (EX-1034, 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.

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.*, EX-1034, 39-40 (“[Q]uestionable patents [were] too easily obtained and too difficult to challenge.”); EX-1042, 56 (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.

(EX-1043 (Sen. Kyl).)

VI. 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, 5-7; 37 CFR § 42.100(b).) Petitioners filed their petitions within four months of being made aware of PO's revised claim construction positions in its Response, and within weeks after the deadline for the last brief due in the Meta-MDT-IPR. To address PO's different constructions, Petitioners concurrently filed this Petition and the IPR2025-00539 Petition, in which Petitioners explain how fundamentally different prior art renders obvious the challenged claims under PO's narrower construction. For example, Petitioners explained:

[E]ven if PO's improper construction[] of ... "mobile device" were accepted, the combination of Neibauer, Miller, and Cheng still renders obvious limitation [1C]. Neibauer itself discloses services such as "Yahoo! Mobile" and "Yahoo! To Go" that enable content from Yahoo! services to be provided to handheld devices such as pagers, cell phones, web phones, and personal digital assistants (PDAs). (Neibauer, pp.166-174.) "Yahoo! To Go lets you receive Yahoo! information on your mobile device." (Neibauer, p.167.) For example, one option referred to as "Yahoo! On Your PDA" allowed users of browser-enabled PDAs to select particular Yahoo! content that would accessible from their PDA. (Neibauer, pp.171-174.) Although Neibauer does not expressly disclose that the Yahoo! Clubs feature was available on handhelds, it would have been obvious over Neibauer alone to allow user-created clubs to be accessed by handheld devices disclosed elsewhere in Neibauer.

(IPR2025-00539, Paper 3, 24; *see also id.*, EX-1002, ¶¶96, 144.)

Petitioners filed parallel petitions challenging the '336 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., 45.) 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 IPR2025-00539 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.⁵

As noted above, Petitioners ranked the IPR2025-00539 petition higher than the instant Petition to minimize the burden on the Board and PO if no Final Written Decision issued in the Meta-MDT-IPR. (*See* Paper 4, 2.) The grounds and

⁵ Petitioners acknowledge the Director's recent decision in *CrowdStrike, Inc. v. GoSecure, Inc.*, IPR2025-00068, -070, Paper 25 (Stewart June 25, 2025) that required a claim construction prior to institution, and a decision by the Board to institute on at most one petition. While Petitioners believe institution of both of its Petitions on the '336 patent is warranted, Petitioners understand that the Board may institute on one Petition after making a claim construction determination.

challenged claims in the IPR2024-00539 petition are the same as those in the Meta-MDT-IPR, so the Board will not need to invest additional time and resources into analyzing new prior art. 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 IPR2025-00539 if that is the Board's preference. Additionally, for the four other patents challenged in IPR2025-00535-538 and IPR2025-00541-544, 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.⁶

VII. 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

⁶ PO complains that Petitioners “inconsistently” ranked their IPR petitions across five related patents, one of which is the '336 patent. (PO Br., 48.) Petitioners are not aware of any authority dictating how Petitioners should rank petitions across different patents, and PO cites no such authority. Regardless, as 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.

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).

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-1045.) Specifically, PO told the court that it "believes that the institution decisions and any [FWDs] 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. 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-1044.)

Here, a decision instituting IPR would take place on or around October 13, 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 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., 14-16.) 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., 16.) 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., 16) 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., 16-17) 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).

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 six 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-1046.) 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. (EX-1047, 35.) This projects a trial date around August 10, 2026, roughly two months before the

expected FWD date. Where the district court trial is expected to take place around two months before the FWD date, the Board generally considers this factor to be neutral or weigh only “slightly” in favor of discretionary denial. *See, e.g., Hulu LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00158, Paper 9, 9-10 (Apr. 20, 2021) (granting institution where FWD was over one 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 factors should be considered); *Apple Inc. v. Koss Corp.*, IPR2021-00255, Paper 22, 10-12 (PTAB June 3, 2021) (granting institution where FWD was expected two months after anticipated trial date); *Quibi Holdings, LLC v. JBF Interlude 2009 Ltd*, IPR2021-00231, Paper 10, 8 (June 7, 2021) (granting institution where FWD was expected seven weeks after anticipated trial date).

The 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., 19-20.) PO’s *SAP* argument also 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. ICom, 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 ten 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-1048, 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 two weeks 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 v. HandyLab, Inc*, IPR2020-01132, Paper 20, 13 (PTAB Apr. 19, 2021) (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-1049, 2.) Indeed, the Board has previously noted that “scheduled trial dates are unreliable and often change.” (EX-1050, 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 October 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., 20.) Even by October 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 October 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 ’336 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 filed the Petition earlier. (PO Br., 21-22.) As explained above, 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. (*See* Paper 4 (identifying parallel petitions against '336 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 21, 2025, Petitioners stipulated, consistent with *Sotera*, "that if the [PTAB] institutes an *inter partes* review ('IPR') in either or both of IPR2025-00539 and IPR2025-00540 concerning U.S. Patent No. 8,793,336, 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 “substantially prejudiced PO.” (PO Br., 24.) According to FAQs for Interim Processes for PTAB Workload Management (“the April 2025 FAQs”), the purpose 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. Thus, there is no prejudice to PO, and its procedural argument should be rejected.⁷

Furthermore, PO presently asserts 70 claims in five 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

⁷ PO claims that Petitioners’ *Sotera* stipulation is a “proposed draft.” (PO Br., 24 n.12.) Not so. The April 21, 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.

account the [*Sotera*-type] stipulation and the number of claims challenged in this proceeding that will not be addressed by the district court”). *See also Tesla v. Intell. Ventures II*, IPR2025-00217, Paper 10, 3 (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., 26.) As PO notes, the Nokia 9210 System utilized Symbian OS, which is also discussed in Randall and Forsyth. (PO Br., 26.) 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.” 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.⁸

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.

⁸ Petitioners have offered this amended *Sotera* stipulation in each of IPR Nos. IPR2025-00535 – IPR2025-00544. (EX-1051.)

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

PO attempts to improperly narrow the scope of the "*first*" [1A] and "*second web-based interface*" [1C] limitations in arguing that these limitations are not disclosed by the combination of Randall and Forsyth. Indeed, the term "web-based interface" never appears in the specification of the '336 patent. As explained in the Petition, the Randall-Forsyth combination discloses the processing element of the server hosting Forums "*provid[es] a first web-based interface accessible to a first user*" either through (1) the communications interface of the server and/or (2) the user interfaces provided by server download (e.g., webpage downloads). (Petition, 23-35.) Likewise, the Randall-Forsyth combination provides "*a second interface,*" the user interface within each Forum that displays the messages/discussions posted/published to the Forum ("*mobile information channel*") and through this interface "*share[s] content*" with Forum members and facilitates further interaction through a context menu allowing a Reply and allowing other actions such as

private chats. (Petition, 36-38.) This user interface is different from the “*first web-based interface*” (e.g., the network communications interface, the content management user interface, the New Forum user interface, or the Forum Reply user interface). (*Id.*) Therefore, PO’s arguments are unpersuasive.

Ground 2: Pelkey-Eck Combination

With respect to Ground 2, PO first argues that Petitioners have failed to establish a motivation to combine Pelkey and Eck. (PO Br., 64-67.) 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, ¶213.) 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., 65.) 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, Inc. v. Medline Indus., Inc.*, No. 2020-1900, 2021 WL 3574043, *5 (Fed. Cir. Aug. 13, 2021).

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, ¶213.) 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,’ and so provides no explanation as to why its structure and operation would need to change.” (PO Br., 66.) 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, ¶213.)

PO also makes the same flawed argument regarding the “*first*” and “*second web-based interface*” limitations as it makes for Ground 1. (PO Br., 67-68.) For the same reasons discussed above, PO’s argument fails.

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., 45.)
- By waiting fewer than four months after receiving PO’s infringement contentions to file IPR petitions. (PO Br., 45-46.)
- By not identifying Unified Patents (“Unified”) as a real party in interest based on an *ex parte* reexamination petition filed by Unified without Petitioners’ knowledge. (PO Br., 47-48; *see infra* §VII.F.3.)
- By ranking its two petitions on the ’336 patent in a manner different from its ranking as to the other challenged patents. (*see* PO Br., 48-50.)

In addition, PO argues that the timing of Petitioners’ *Sotera* stipulation “has substantially prejudiced PO,” including because “PO had to invest time and resources to argue regarding the insufficiency of a not-yet-filed stipulation.” (PO Br., 24; *see also id.*, 45 (“Petitioners’ abuse of the IPR process”). PO also argues that the Petition lacks merit. (PO Br., 56-68.)

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,⁹ 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

⁹ *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.

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), *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. Unified is Not a Real Party in Interest to this Proceeding

Adding to its numerous “abuse” allegations, PO contends that Petitioners “intentional[ly] conceal[ed]” Unified Patents, LLC (“Unified”) as a supposed real party in interest (“RPI”). (PO Br., 47-48.) On the contrary, if any “intentional concealment” has taken place, it is surely on the part of PO, who ignores a voluminous record of PTAB decisions finding that (1) “an RPI analysis is not required at institution absent allegation of a time bar or estoppel based on an unnamed RPI,” *Unified Pats., LLC v. MemoryWeb, LLC*, IPR2021-01413, Paper 15, 18 (March 14, 2022) (citing *SharkNinja Operating LLC v. iRobot Corp.*,

IPR2020-00734, Paper 11, 18 (PTAB Oct. 6, 2020) (precedential)), and (2) Unified and its members are not RPIs based on membership and general shared interest alone, *see, e.g., Unified Pats., Inc. v. Realtime Adaptive Streaming, LLC*, IPR2018-00883, Paper 29, 14-15 (PTAB Oct. 11, 2018). The Board’s RPI jurisprudence confirms that Petitioners are the only RPIs to this proceeding, and PO’s assertion otherwise should be rejected.

The Board has repeatedly held that “an RPI analysis is not required at institution absent allegation of a time bar or estoppel based on an unnamed RPI.” *MemoryWeb*, IPR2021-01413, Paper 15, 18 (citing *SharkNinja*, IPR2020-00734, Paper 11, 18); *see also Unified Pats., LLC v. Fat Statz, LLC*, IPR2020-01665, Paper 51, 7 (PTAB Apr. 4, 2022). PO has made no such allegation because Unified does not implicate the statutory time bar or estoppel provisions. Nor has PO explained why RPI should be considered at the discretionary denial phase if it would not even be relevant to institution of this IPR. For this reason alone, PO’s argument fails.

Even if the Director finds the RPI analysis appropriate under the *Fintiv* framework, PO has not presented evidence sufficient to overcome the presumption that Petitioners have “identif[ied] accurately all RPIs.” *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1343 (Fed. Cir. 2018) (“AIT”). To overcome this presumption, PO “must produce *some* evidence that tends to show

that a particular third party should be named a real party in interest.” *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1244 (Fed. Cir. 2018) (emphasis in original). The Federal Circuit has cautioned against overly broad interpretations of RPI relationships, noting that “the heart of the [RPI] inquiry is focused on ‘whether a petition has been filed at a party’s behest,’” and “[w]ithout ... evidence of control, in addition to no evidence of joint funding, or even any evidence of substantial coordination between the parties as to their respective decisions to bring these proceedings, a finding that [third party] is an RPI of or in privity with [petitioner] here would be improper.” *Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018, 1028-29 (Fed. Cir. 2021).

The question of whether Unified and its members are RPIs based on membership and general shared interest is not new to the Board; faced with similar circumstances in past cases involving Unified with regard to the RPI issue, the Board has consistently found that Unified and its members were not RPIs. *See, e.g., Realtime Adaptive Streaming*, IPR2018-00883, Paper 29, 14-15; EX-1056, ii-vi (identifying 26 decisions finding Unified and its members were not RPIs); EX-1057 (discussing Unified’s history of success with RPI challenges).

The Board has also recognized that it “must be cautious not to ‘overextend[]’ the reasoning set forth in *AIT* to any situation where ‘a party benefits generally from the filing of the Petition and also has a relationship with

the Petitioner.” *Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.*, IPR2017-00651, Paper 148, 10 (PTAB Jan. 24, 2019) (precedential).

Here, the only support PO offers for its argument is Unified’s 2023 request for *ex parte* reexamination of the ’336 patent and Petitioners’ 2021 membership with Unified. (PO Br., 47-48.) PO does not contend that the Petition was “filed at [Unified’s] behest” (it was not), that Unified is funding Petitioners’ challenge (it is not), or even that Petitioners and Unified coordinated in their efforts to challenge PO’s patents (they did not). *See Uniloc 2017*, 989 F.3d at 1028-29. Without even a single allegation to suggest Unified is a “clear beneficiary” of Petitioner’s challenge, PO cannot credibly accuse Petitioners of abusing the IPR process by not identifying Unified as an RPI. PO’s argument should therefore be disregarded.

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

That no forum has adjudicated the validity of the challenged claims of the ’336 patent weighs against discretionary denial. The Board has already found that there is a reasonable likelihood that at least claim 1 is invalid based on Neibauer, Miller, and Cheng. *See IPR2024-00246*, Paper 12, 21-31. 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.” (EX-1034, 39-40.)

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 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, ¶¶43-72 (Ground 1, explaining Randall and Forsyth)) and how they invalidate the challenged claims (*see, e.g.*, EX-1003, ¶¶80-202 (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, ¶¶73-79

(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 ’336 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., 50-51.) 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 February 7, 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 one example of expert testimony PO discusses is in fact helpful to the Board. With respect to Ground 2, PO takes issue with Dr. Houh’s analysis of why users of PagerWorld in the Pelkey-Eck combination would be able to communicate using messaging over SMS or messaging over WAP protocol (PO Br., 51-53). 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, ¶¶205-206.) Pelkey, for example, discloses “a messaging service for communicating messages between and among users of video game systems.” (EX-1003, ¶204 (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, ¶204 (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, ¶212.) Eck itself discloses that the ability to exchange messages is not limited to a “pager” environment and includes other technologies like WAP. (EX-1003, ¶212 (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.

PO lastly points to four instances in the Petition where Petitioners supposedly rely on expert testimony for “missing limitations.” (PO Br., 53-56.) PO overlooks the role of expert testimony in explaining how a POSITA would interpret and apply a reference. For example, PO takes issue with the Petition relying on Dr. Houh’s testimony to support that “[a]lthough Randall illustrates the database as a standalone server, a POSITA would have understood and been motivated to implement the database functionality on the Forums server both for ease of maintenance and to reduce equipment costs.” (PO Br., 53-54 (quoting Petition, 19.) But Dr. Houh does not cite Randall to show it expressly teaches combining the database and Forums server. Rather, he explains that Randall describes a remote, application-agnostic database that supports data sharing across applications via a metalanguage schema. (EX-1003, ¶83.) From this, a POSITA would recognize that the database could be implemented on the same server as Forums to simplify the architecture and reduce costs. Dr. Houh’s opinion is grounded in Randall’s disclosure and is not an unsupported assertion, as PO suggests.

PO’s remaining examples are similarly flawed, improperly ignoring the knowledge and creativity of a POSITA, which must be taken into account as part of any obviousness analysis. *See C.R. Bard*, No. 2020-1900, 2021 WL 3574043, *5 (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).

VIII. 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: July 14, 2025

Respectfully submitted,

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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 12,864 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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