

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 No. 8,793,336

**PATENT OWNER'S REPLY
IN SUPPORT OF DISCRETIONARY DENIAL**

TABLE OF AUTHORITIES

Cases	Page(s)
<i>Ericsson Inc. v. Procomm Int'l Pte. Ltd.</i> , IPR2024-01453, Paper 15 (P.T.A.B. June 25, 2025)	1
<i>Intel Corp. v. Proxense LLC</i> , IPR2025-00327, -00328, -00329, Paper 12 (P.T.A.B. June 26, 2025)	1
<i>iRhythm, Inc. v. Welch Allyn, Inc.</i> , IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025)	1
<i>Rode Microphones, LLC v. Zaxcom, Inc.</i> , IPR2025-00557, Paper 11 (P.T.A.B. July 17, 2025)	2
<i>SAP Am., Inc. v. Valtrus Innov. Ltd.</i> , IPR2025-00416, Paper 10 (P.T.A.B. July 10, 2025)	1
<i>SAP Am., Inc. v. Valtrus Innov. Ltd.</i> , IPR2025-00416, Paper 8 (P.T.A.B. June 9, 2025)	1
<i>Tesla, Inc. v. Intellectual Ventures II LLC</i> , IPR2025-00217, Paper 9 (P.T.A.B. June 13, 2025)	2
<i>Vital Connect, Inc. v. Bardy Diagnostics, Inc.</i> , IPR2023-00381, Paper 7 (P.T.A.B. July 11, 2023)	2
<i>Wilson v. Rousseau</i> , 45 U.S. 646 (1846)	1

EXHIBIT LIST

Ex.	Description
2001	E-mail serving amended infringement contentions in EDTX-Litigation
2002	Comparison between the specifications of the '336 and '801 Patents
2003	Petition for <i>Inter Partes</i> Review in IPR2025-00539 (Feb. 7, 2025)
2004	Reserved
2005	Reserved
2006	E-mail from the Board regarding the 539 and 540 IPR panel assignments (May 2, 2025)
2007	Reserved
2008	E-mail from Erick S. Robinson memorializing the phone conversation with Petitioners' counsel (September 26, 2024)
2009	Reserved
2010	Reserved
2011	Reserved
2012	Reserved
2013	E-mail exchange between Erick S. Robinson and Petitioners' counsel regarding a stay (October 17, 2024)
2014	E-mail exchange between Erick S. Robinson and Petitioners' counsel regarding a stay (February 19, 2025)
2015	E-mail exchange between Erick S. Robinson and Petitioners' counsel wherein Petitioners shared their motion to stay with Patent Owner (March 4, 2025)
2016	Second Amended Docket Control Order in the EDTX-Litigation (December 19, 2024)
2017	United States District Courts — National Judicial Caseload Profile (March 31, 2025)
2018	E-mail from Petitioners' counsel serving their initial and additional disclosures (October 16, 2024)
2019	E-mail from Petitioners' counsel serving their invalidity contentions (January 31, 2025)
2020	E-mail from Petitioners providing materials produced by third-party Microsoft Corporation and Sybase, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (April 25, 2025)
2021	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (March 7, 2025)

Ex.	Description
2022	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 24, 2025)
2023	E-mail from Petitioners providing materials produced by third-party Casio America, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 21, 2025)
2024	E-mail from Petitioners providing materials produced by third-party Sony Electronics, Inc. in response to Petitioners' subpoena in the EDTX-Litigation (February 11, 2025)
2025	E-mail from Petitioners providing materials produced by third-party AT&T Mobility LLC in response to Petitioners' subpoena in the EDTX-Litigation (February 5, 2025)
2026	Patent Owner's Amended Infringement Contentions in the EDTX-Litigation (October 6, 2024)
2027	Petitioners' Invalidity Contentions in the EDTX-Litigation (January 31, 2025)
2028	E-mail exchange between Homayoon Rafatijo and Petitioners' counsel regarding Petitioners' contacting the Board for filing their proposed <i>Sotera</i> stipulation (April 21-23, 2025)
2029	E-mail from Petitioners' counsel with a draft of a proposed communication to the Board (April 30, 2025)
2030	E-mail from Petitioners' counsel sharing with Patent Owner their proposed <i>Sotera</i> stipulation (April 18, 2025)
2031	Reserved
2032	Petitioners' proposed <i>Sotera</i> stipulation for '539 and '540 IPRs (April 21, 2025)
2033	Petitioners' claim chart against '336 Patent based on the Nokia 9210 System (January 31, 2025)
2034	Reserved
2035	Summary of verbatim (or nearly verbatim) matches between the '540 petition to the Houh Declaration (Ex.1003)
2036	E-Mail from Petitioners providing Casio America, Inc.'s declarations certifying business records in response to Petitioners' subpoena in the EDTX-Litigation (May 9, 2025)
2037	Joel West & David Wood, <i>EVOLVING AN OPEN ECOSYSTEM: THE RISE AND FALL OF THE SYMBIAN PLATFORM</i> (2013)

Ex.	Description
2038	Bradston Henry, <i>Multiplayer Server Basics Creating a Multiplayer Game Server - Part 1</i> (Oct. 25, 2021), https://dev.to/ibmdeveloper/multiplayer-server-basics-ep-1-creating-a-multiplayer-game-server-5aed
2039	Declaration of George Edwards in Regard to the Petitions for <i>Inter Partes</i> Review of U.S. Patent No. 8,793,336
2040	Order of the EDTX court denying Samsung's Motion for Relief from Protective Order
2041	Redacted version of Samsung's Motion for Relief from Protective Order filed in the EDTX-Litigation (May 29, 2025)
2042	Patent Owner's and Meta's February 21, 2025 joint email to the Board regarding the settlement of the MDT-Meta-Litigation and Meta-MDT-IPRs
2043	U.S. Design Patent 753,156 Assigned to Samsung
2044	Prosecution History of the U.S. Design Patent 753,156 Assigned to Samsung
2045	Reserved
2046	Petitioner's Authorized Reply to Patent Owner's Preliminary Response (IPR2021-00917, Paper 7, Sept. 22, 2021)
2047	Declaration of Kevin Jakel in IPR2021-00917 (May 11, 2021)
2048	Petition for Inter Partes Review in IPR2024-00246 (Dec. 6, 2023)
2049	Petition for Inter Partes Review in IPR2025-00538 (Feb. 3, 2025)
2050	Declaration of Mahdi Eslamimehr for IPR2025-00540 of U.S. Patent No. 8,793,336
2051	Patent Owner's Discretionary Denial Brief in IPR2025-00539 (Paper 8)
2052	Comparison of independent claims of the '336 and '5801 Patents

TABLE OF ABBREVIATIONS

Abbr.	Description
CRU	Central Reexamination Unit
DD	Patent Owner's Discretionary Denial Brief in IPR2025-00540 (Paper 8)
Pet.	Petition for <i>Inter Partes</i> Review in IPR2025-00540 (Paper 3)
PO	Patent Owner Mobile Data Technologies LLC
R.	Petitioner's Response to Patent Owner's Discretionary Denial Brief in IPR2025-00540 (Paper 12)

The Director has held, on a nearly identical record, that discretionary denial is appropriate in the -00535 and -00536 IPRs. This brief is necessary only to address Petitioners' new red herring "settled expectations" arguments.

First, Petitioners' assertion that PO has no "credibl[e] claim" of settled expectations because "PO owned the patent for less than three years" misses the mark. R. 1, 16-17. An "assignee stands in the shoes or in the place of the patentee, and represents him." *Wilson v. Rousseau*, 45 U.S. 646, 703 (1846). Indeed, in *SAP Am., Inc.*, IPR2025-00416, Paper 10, 2 (July 2025), the Director discretionarily denied institution, finding "strong settled expectations" despite that "PO acquire[d] the challenged patent [in] 2021" (*Id.*, Paper 8, 20).

Second, *Intel Corp.*, IPR2025-00327, Paper 12, 2-3 (June 2025) (R. 19-20) confirms PO's settled expectations. Petitioners admit they "**applied**" the '336 Patent: "**Unlike Petitioners**, neither PO nor its predecessors ever commercialized or **applied the claimed technology** in any way." R. 2. Petitioners have known of the Asserted Patents family since May 2015, as the '5801 patent appears on the face of their U.S. Design Patent 753,156 and was cited during its examination. DD, 42-43. In *iRhythm, Inc.*, IPR2025-00363, Paper 10, 3 (June 2025), "settled expectations favor[ed] denial of institution" where petitioner knew of a family patent but delayed seeking review. *See also Ericsson Inc.*, IPR2024-01453, Paper 15, 3 (June 2025) (applying *iRhythm* where the challenged patent was "brought to Petitioner's attention" by Examiner).

Third, Petitioners' claim that "any settled expectations concerning the validity" is "questionable" is a red herring. R. 17-18. The original Examiner allowed the '336 Patent claims after full examination and Petitioners concede in the -539 IPR that Neibauer/Cheng "were considered by the Examiner." Ex.2051, 14-18. The Examiner also considered the '5801 reexam and its reliance on Neibauer/Cheng. *Id.* 16-17; *Cf. Rode Mics. LLC*, IPR2025-00557, Paper 11, 2 (July 2025) (finding material error where Examiner "did not reference the related PTAB proceedings that could have impacted the claims"). Further, the '336 Patent survived Unified's reexam, based on Neibauer, without amendment/cancellation. DD, 43-45; Ex.1032, 65. Petitioners failed to show material error by the original Examiner or CRU.

Fourth, the Board's prior institution of the Meta-IPR does not disturb PO's settled expectations. R. 18-19. The '336 Patent survived *ex parte* reexam with a higher standard than the IPR institution, confirming PO's settled expectations. Also, IPR institution is not evidence of material error by the Examiner. *See Vital Connect, Inc.*, IPR2023-00381, Paper 7, 20 (July 2023). Petitioners' reliance on *Tesla*, IPR2025-00217, Paper 9, 2 is also unavailing. R. 2, 11-12. There, an ancestor patent found unpatentable had "**similar claims.**" *Tesla*, 2. Here, it is undisputed that the '336 Patent claims are **substantially different** from those in the '5801 and '342 patents (Ex.2052; *see also* Ex.2051, 16). Further, unlike *Tesla*, the '336 Patent survived an *ex parte* reexam, and all Asserted Patents spring from the '336 Patent.

Date: July 21, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on July 21, 2025, I caused a true and correct copy of the foregoing Patent Owner's Reply in Support of Discretionary Denial to be served via electronic mail upon the following attorneys of record for the Petitioners:

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