

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WALMART INC. and WALMART STORES TEXAS, LLC,
Petitioner

v.

RAVENWHITE SECURITY, INC.,
Patent Owner

Case IPR2025-00810
U.S. Patent No. 10,594,823

PATENT OWNER'S DISCRETIONARY DENIAL REPLY BRIEF

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Patent Trial and Appeal Board
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PATENT OWNER'S UPDATED EXHIBIT LIST

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2001	Docket Control Order [43], <i>RavenWhite Licensing LLC v. The Home Depot, Inc. et al.</i> , Case No. 2:24-cv-00688 (E.D. Tex. Nov. 22, 2024)
2002	Complaint [1], <i>RavenWhite Licensing LLC v. Walmart Inc. et al.</i> , Case No. 2:23-cv-00418 (E.D. Tex. Sept. 15, 2023)
2003	<i>Intentionally Left Blank</i>
2004	Results charted from DocketNavigator.com, run on June 9, 2025, for success of Motions to Stay Pending IPR in the Eastern District of Texas
2005	Results charted from DocketNavigator.com, run on June 9, 2025, for success of Motions to Stay Pending IPR decided by Judge Rodney Gilstrap
2006	PREVAIL Act Fact Sheet
2007	Walmart Balance Sheet, accessed June 12, 2025 at: https://stock.walmart.com/financial-information/balance-sheet
2008	Fortune Announces 2025 Fortune 500 List, accessed June 12, 2025 at: https://www.prnewswire.com/news-releases/fortune-announces-2025-fortune-500-list-302470158.html
2009	Ventura, L., “World’s Largest Companies in 2024,” Global Finance Magazine, accessed June 12, 2025 at: https://gfmag.com/data/biggest-company-in-the-world/
2010	Morris, A., “IPBC Global 2025: Acting USPTO Director says IPR Use Needs to Change,” accessed June 16, 2025 at: https://www.iam-media.com/article/ipbc-global-2025-acting-uspto-director-says-ipr-use-needs-change
2011	Hassan Djirdeh, “The Three Browser Storage Mechanisms,” Progress Software, available at https://www.telerik.com/blogs/three-browser-storage-mechanisms
2012	Croft <i>et al.</i> , “Complete Guide to Cookies and Where They’re Stored,” All About Cookies, available at https://allaboutcookies.org/what-is-a-cookie-file

Exhibit No.	Description
2013	“In which location cookies are stored on the hard disk?” GeeksforGeeks, available at https://www.geeksforgeeks.org/javascript/in-which-location-cookies-are-stored-on-the-hard-disk/
2014	“How to delete cookies in Netscape,” BlackRock, available at https://blackrock.tal.net/vx/lang-en-GB/mobile-1/brand-3/candidate/faq/how_to/local/8
2015	“Visual Design Evolution of Netscape Navigator,” Version Museum, available at https://www.versionmuseum.com/history-of/netscape-browser
2016	“How to clean Infected Temporary Internet Files in Windows,” Bitdefender, available at https://www.bitdefender.com/consumer/support/answer/2138/
2017	“Browser history logs,” NXLog, available at https://docs.nxlog.co/integrate/browser-history.html
2018	“Adobe Flash Player 10 Administration Guide,” Adobe Systems Incorporated (2008), available at https://web.archive.org/web/20081216032621/http://www.adobe.com/devnet/flashplayer/articles/flash_player_admin_guide.html
2019	“Flash Player Help – Local Storage settings,” Adobe Systems Incorporated (2008), available at https://web.archive.org/web/20081025230757/http://www.macromedia.com/support/documentation/en/flashplayer/help/help02.html
2020	Deposition Transcript of Craig Ellis Wills, Ph.D., June 17, 2025
2021	<i>Curriculum Vitae</i> of Bernard J. Jansen, Ph.D.
2022	“What Is the 127.0.0.1 IP Address?,” Lifewire, available at https://www.lifewire.com/network-computer-special-ip-address-818385
2023	“Add pictures or attach files to emails in Outlook,” Microsoft, available at https://support.microsoft.com/en-us/office/add-pictures-or-attach-files-to-emails-in-outlook-bdfafef5-792a-42b1-9a7b-84512d7de7fc

Exhibit No.	Description
2024	“Send attachments with your Gmail message,” Google, available at https://support.google.com/mail/answer/6584
2025	“Open & download attachments in Gmail,” Google, available at https://support.google.com/mail/answer/30719
2026	“Adobe Flash Player 32.0 Administration Guide,” Adobe Systems Incorporated (2020), available at https://developer.adobe.com/flash/devnet/flashplayer/articles/flash-player-admin-guide
2027	Declaration of Dr. Bernard J. Jansen, Ph.D.
2028	Herrman, J., “What Are Flash Cookies and How Can You Stop Them?,” Popular Mechanics, accessed at https://www.popularmechanics.com/technology/security/how-to/a6134/what-are-flash-cookies-and-how-can-you-stop-them/ (Sept. 23, 2010)
2029	“What are Flash Cookies and how do they Work?,” CookieScan, accessed at https://www.cookiescan.com/what-are-flash-cookies-how-do-they-work/
2030	“What are session cookies?,” CookieYes, available at https://www.cookieyes.com/blog/session-cookies/
2031	Email from Jennifer Nall dated Jan. 13, 2025
2032	Raymond Camden, <u>Client-Side Data Storage</u> , O’Reilly Media, Inc. (2016)
2033	ECF Notice of Electronic Filing for Motion to Stay All Proceedings Pending Inter Partes Review of All Asserted Claims [65], <i>RavenWhite Licensing LLC v. The Home Depot, Inc. et al.</i> , Case No. 2:24-cv-00688 (E.D. Tex. Jun. 18, 2025)
2034	Complaint for Patent Infringement [1], <i>RavenWhite Licensing LLC v. Walmart Inc.. et al.</i> , Case No. 2:24-cv-00689 (E.D. Tex. Aug. 21, 2024)

Simultaneous with the filing of Patent Owner's ("PO") opening discretionary denial brief, a stay of the parallel district court case was issued. Nevertheless, fairness and settled expectations strongly favor denial of institution. Petitioner would be time-barred from filing this Petition if not for its joinder motion. The Director's recent decision in *Realtek Semiconductor Corp. v. ParkerVision, Inc.*, Nos. IPR2025-00324 & IPR2025-00325, Paper 11 (Jun. 25, 2025) emphasizes that petitions by time-barred parties should proceed only in exceptional circumstances. No such circumstance exists here. For the reasons discussed below and in PO's opening brief, the Director should deny institution.

I. PETITIONER'S STATEMENTS CONCERNING TIMING OF THE STAY ORDER IN THE PARALLEL DISTRICT COURT PROCEEDING ARE MISLEADING.

In its opening brief, PO stated that "[t]here is presently no stay of proceedings in the district court case." Paper 12 ("PO Brief"), 11. Petitioner characterizes this statement as "an overt misrepresentation regarding the parallel litigation." Paper 16 ("Pet. Brief"), 1. Although the district court has now stayed the case, Petitioner's assertion is highly misleading and omits the near-simultaneous timing of the district court stay and the filing of PO's opening brief.

The stay order in the district court proceeding issued at 5:45 PM Eastern Time on Friday, June 18, after close of business and a mere 30 minutes before PO's brief was submitted to the Patent Office. EX2033, 1. By that time, all filing

documents had been uploaded to the Patent Trial and Appeal Case Tracking System (P-TACTS) and were in process of being filed by supporting paralegals. The facts set forth in PO's brief were accurate when counsel instructed supporting paralegals to file the brief, and PO had no intention to misrepresent those facts.

PO agrees that the stay alters the analysis of *Fintiv* factors 1 and 2. Pet. Brief, 3-4. Although the stay order pauses the parties' claim construction briefing, Patent Owner's analysis regarding *Fintiv* factor 3 remains the same, as does its analysis regarding *Fintiv* factors 5 and 6, each favoring denial. PO Brief, 12-16. And regardless of the *Fintiv* factors, the Director should exercise discretion to deny institution based on fairness considerations and settled expectations. *Sandisk Techs. Inc. v. Polaris PowerLED Techs., LLC*, IPR2025-00515, Paper 15 at 2 (PTAB Jul. 16, 2025) (denying institution based on settled expectations despite a stay in the parallel litigation).

II. FAIRNESS CONSIDERATIONS AND SETTLED EXPECTATIONS STRONGLY FAVOR DENIAL OF INSTITUTION.

PO explained that instituting this IPR would unjustly deprive PO and Exclusive Licensee of their reasonable and settled expectation that they may rely on their property rights in the '823 patent, as well as unfairly enable an otherwise time-barred party to take over the IPR if the lead parties settle their dispute. PO Brief, 8-10. Petitioner alleges that PO's arguments are "contrary to recent precedent." Pet. Brief, 6. Not so. None of Petitioner's cited decisions are

precedential, most are almost a decade old, and the Director’s recent decision in *Realtek* directly contradicts Petitioner’s cited “authority.” Pet. Brief, 6-7.

First, Petitioner argues that 35 U.S.C. § 315 “clearly permits joinder under the present circumstances and the Board has granted joinder under these same circumstances on numerous occasions.” Pet. Brief, 7. That the statute *permits* joinder of otherwise time-barred petitioners does not mean that the Board should do so here. *See* PO Brief, 8-10. Petitioner cites two cases: *AT&T Services, Inc. v. Convergent Media Solutions, LLC*, IPR2017-01237, Paper 10 (PTAB May 10, 2017); *Qualcomm Inc. v. Bandspeed, Inc.*, IPR2015-00314, Paper 21 (PTAB Nov. 16, 2015). Both of those cases—neither of which are precedential—are almost a decade old and run contrary to the Director’s recent *Realtek* decision.

In *Realtek*, the petitioner similarly waited until its one-year time limit under § 315(b) expired, filing its copycat petition three months later with a motion to join an already-instituted IPR. *Realtek*, Paper 11 at 2; *see also Realtek*, Paper 8 at 5. In denying institution, the Director explained that “[p]etitions filed by time-barred parties should proceed *only in exceptional circumstances*,” and “*Realtek* does not present an exceptional circumstance here.” *Realtek*, Paper 11 at 3 (emphasis added). The Director thus held that “ParkerVision’s persuasive fairness arguments due to *Realtek* being a time-barred party favor exercising discretion to deny institution.” *Id.*

Petitioner does not identify any exceptional circumstances that would warrant joinder of its otherwise time-barred Petition. Pet. Brief, 6-10. Nor is there any such circumstance here. As in *Realtek*, Petitioner's choice not to file an IPR petition within the statutory time limit and waiting for institution of another IPR does not provide an "exceptional circumstance" that warrants institution. *Realtek*, Paper 11 at 3. Indeed, the Board has previously explained that "[b]roadly exercising the discretion granted to the Director in § 315(c) could effectively circumvent the time limitation in § 315(b) in many cases," and "when an otherwise time-barred petitioner requests same party and/or issue joinder, the Board will exercise this discretion only in limited circumstances." *Proppant Express Investments, LLC, et al., v. Oren Technologies, LLC*, IPR2018-00914, Paper 38 at 18-19 (PTAB Mar. 13, 2019) (PTAB Jul. 24, 2023). Petitioner's joinder strategy here is an attempt to "game the system," *id.*, 19, and the Petition should be denied for the same reasons as *Realtek*.

Second, Petitioner argues that "the Director has rejected discretionary denial requests based on 'settled expectations' arguments for patents much older than the patent-at-issue here." Pet. Brief, 7 (citing, *Cambridge Indus. USA, INC. v. Applied Optoelectronics, Inc.*, Nos. IPR2025-00434, IPR2025-00436, IPR2025-00437, Paper 11, 2-3 (PTAB June 26, 2025)). *Cambridge*, however, did not concern a time-barred petitioner, like here. *Cambridge*, Paper 11 at 2-3. Moreover, each

patent in *Cambridge* (U.S. Patent Nos. 10,379,301, 10,313,024, and 10,788,690) was the first U.S. patent to be filed in its respective family. *Id.* In contrast, the '823 patent in this proceeding is a continuation of U.S. Patent No. 8,533,350, published on May 10, 2007. EX1001, Cover (63). Thus, Petitioner has been on notice of the subject matter claimed in the '823 patent for over 18 years, and its delay in seeking review of the '823 patent favors denial. PO Brief, 8-9; *Dabico Airport Solutions Inc., v. AXA Power ApS*, IPR2025-00408, Paper 21 at 3 (PTAB June 18, 2025).

Finally, Petitioner argues that Exclusive Licensee RavenWhite Licensing LLC's voluntary dismissal of its original district court complaint somehow diminishes the settled expectations related to the '823 patent. Pet. Brief, 6 (“If a Patent Owner and its licensee cannot even determine who properly owns a patent, there are hardly any ‘settled expectations’ related to that patent.”). Not so.

Petitioner ignores that Exclusive Licensee refiled its complaint on August 21, 2024—before Petitioner was time-barred from filing an IPR petition—with no changes to either the plaintiff or defendants. *See* EX2034. Yet, Petitioner still decided to let its one-year time limit expire, underscoring PO's expectation that Petitioner would not pursue an IPR challenge against the '823 patent.

III. CONCLUSION

For at least the foregoing reasons and the reasons in PO's opening discretionary denial brief, the Director should discretionarily deny institution.

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER'S DISCRETIONARY DENIAL REPLY BRIEF** and associated Exhibits 2033-2034 were served in their entireties on July 28, 2025, upon the following parties via electronic mail:

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