

Petitioner's Response to Patent Owner's Discretionary Denial Brief

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

CELLULAR SOUTH, INC.,
Patent Owner.

Case IPR2025-00875
Patent 9,940,972 B2

**PETITIONER'S RESPONSE TO PATENT OWNER'S REQUEST
FOR DISCRETIONARY DENIAL OF INSTITUTION**

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I. INTRODUCTION

The Petition presents a strong challenge to the '972 patent based on new prior art that was not considered during prosecution. The related district court litigation is still at an early stage, and the court has indicated to the parties that a stay is highly likely if IPR is instituted. Even putting aside a stay, any trial will not take place until, at the earliest, several months after a Final Written Decision would be due. Patent Owner's purported "settled expectations" should be rejected. Accordingly, as explained below, Patent Owner's request for discretionary denial should be denied.

II. DISCRETIONARY DENIAL IS NOT WARRANTED

A. *Fintiv* Weighs Against Discretionary Denial

1. The Court Has Indicated That It Will Likely Grant a Stay if IPR is Instituted

Fintiv Factor 1 weighs in favor of institution and against discretionary denial.

Shortly after filing the Petition, Petitioner discussed a stay of the parallel litigation in the Northern District of California pending IPR at a case management conference. During that conference, the court indicated that it was inclined to grant a stay if IPR is instituted. The court explained, "So typically I would grant the request to stay if IPR is instituted, just so that you know. It doesn't seem to make sense for a district judge to go through all that work where there are parallel proceedings that would take precedence ultimately with respect to a decision. ...

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Those kinds of motions, I don't ever even grant hearings. I just basically grant them." (EX2011 (2025-07-07 CMC Transcript), 4:8-16.)

In *Fintiv*, the Board stated that "such guidance from the district court, if made of record, suggests the district court may be willing to avoid duplicative efforts and await the PTAB's final resolution of the patentability issues raised in the petition before proceeding with the parallel litigation," and weighs against exercising discretion to deny institution. *Apple Inc. v. Fintiv, Inc.*, Case No. IPR2020-00019, Paper 11 at 7 (P.T.A.B. Mar. 20, 2020). In fact, this factor weighs even more strongly against discretionary denial here. In *Fintiv*, the court had merely "indicated to the parties that it will consider a renewed motion or reconsider a motion to stay if a PTAB trial is instituted." *Id.* Here, however, the district court has gone further and plainly stated to the parties its practice of staying cases if IPR is instituted. That practice is reflected in dozens of stays pending IPR granted by the court, with *none* denied for instituted IPRs. (*See* EX1014.)

The district court provided only a single caveat to its general rule of staying proceedings upon IPR institution, and it does not alter the *Fintiv* analysis here. Specifically, the court said that "[t]he only reason why I wouldn't [stay the entire case] is let's say they grant one, but don't grant the other two and they're entirely different, I might stay one, not the others." (EX2011, 4:17-19.) The court in that caveat was explaining that should the Board institute IPR of only one of Patent

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Owner's asserted patents in the parallel litigation, the court might elect to stay the parallel proceedings only as to the patent for which IPR was instituted.¹ In other words, if the Board institutes IPR on all of Patent Owner's asserted patents, the district court will stay the parallel litigation. And if the Board institutes IPR on only the '972 patent addressed in this proceeding, the court would still stay the parallel litigation as to the '972 patent. In either event, parallel proceedings on the '972 patent would be stayed.

If IPR is instituted, Petitioner intends to follow the court's guidance and promptly bring a motion to stay the district court proceedings. There is good reason to believe that such a post-institution stay would be granted, as the district court has already informed the parties that it routinely grants such motions without a hearing. (EX2011, 4:8-15.) Indeed, once instituted, the IPR will simplify matters in the district court one way or another. The challenged claims of the '972 patent potentially will be (and indeed should be, for the reasons provided in the Petition) found unpatentable by the Board, thereby simplifying and reducing—if not eliminating—the claims asserted in the district court proceeding. And even if one

¹ The '972 patent is one of three patents asserted in the parallel district court litigation. Petitioner has moved for IPR on all claims of all asserted patents. *See* IPR2025-00875, IPR2025-00876, IPR2025-00877.

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or more asserted claims were to survive review (assumed *arguendo*), once instituted and in view of the prior art stipulation filed by Petitioner (and discussed further below), the estoppel provisions of § 315(e) will apply and simplify the invalidity issues raised in the district court. Also, Patent Owner has not alleged that it is a competitor of Petitioner, making a stay more likely to be granted.

Therefore, the high likelihood that the district court will stay the litigation, at least as to the '972 patent, following institution of this IPR weighs against discretionary denial.

2. Trial, If Any, Would Take Place Months After a Final Written Decision

Fintiv Factor 2 also weighs against discretionary denial.

As Patent Owner acknowledges, a district court trial is currently scheduled to take place three months *after* a Final Written Decision would be due. (DD Req. at 9-10.) And as discussed above, because of the high likelihood of a stay if IPR is instituted, the current trial date is a non-issue. Moreover, putting aside a stay, this later trial date combined with Petitioner's prior art stipulation discussed below, helps ensure both minimal overlap with this IPR and minimal investment in the litigation by the court and parties. It also helps avoid any possible inconsistent results between the PTAB and district court.

Patent Owner cites the Acting Director's decisions in *IRhythm Technologies* and *Smartsky Networks*, and the institution decision in *Samsung Bioepis* (DD Req.

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at 10-11), but those decisions actually support Petitioner on this factor—in all three, a later trial date “weigh[ed] against discretionary denial.” *IRhythm Techs., Inc. v. Welch Allyn, Inc.*, Case No. IPR2025-00363, Paper 10 at 2 (P.T.A.B. June 6, 2025); *Smartsky Networks LLC v. Gogo Business Aviation LLC*, Case No. IPR 2025-00672, Paper 10 at 2 (P.T.A.B. July 31, 2025); *Samsung Bioepis Co., Ltd. v. Regeneron Pharms., Inc.*, Case No. IPR2025-00176, Paper 12 at 13 (P.T.A.B. June 2, 2025). And *Kahoot* is irrelevant on this factor, because the parallel district court proceeding had been stayed. *Kahoot! AS v. Interstellar Inc.*, Case No. IPR2025-00696, Paper 12 at 2 (P.T.A.B. July 31, 2025).

3. The District Court Case Is Still Early Stage, with Minimal Investment by the Court and the Parties

Fintiv Factor 3 likewise weighs against discretionary denial.

As Patent Owner concedes, the parallel district court litigation (now in the Northern District of California) is just beginning. The bulk of the work and investment in the litigation (particularly as it relates to the validity of the ’972 patent) lies ahead. For example, the district court has not issued a claim construction order, and the claim construction hearing itself is not scheduled to occur in the district court until April 29, 2026—more than four months after the December 16, 2025 expected

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date for an institution decision.² (EX2010 at 3.)

Further, close of fact discovery is still 9 months away and much of fact discovery remains left to complete. For example, no depositions have been noticed, much less taken (party or third-party, individual or 30(b)(6)); document production is not complete; Patent Owner still has 9 of its 25 interrogatories left, while Petitioner has all 25 of its interrogatories left; no requests for admission have been propounded by any party; Petitioner has yet to serve invalidity contentions. (EX2010 at 2-4.) Expert discovery, where much of the pre-trial effort by the parties in addressing the validity of the '972 patent will lie, will not start until July 2026. (*Id.* at 4.) Briefing and the hearing on *Daubert* and dispositive motions lie even further in the future, in October and November 2026. (*Id.*)

Because there is much work left to be done in the district court litigation, there is no claim construction order and other key milestones lay long after an institution decision, the current investment in the parallel proceeding thus is not likely to reduce

² As noted above, if instituted, Petitioner anticipates that it will promptly move to stay the district court litigation pending resolution of the IPR.

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the chances of a stay being granted or result in the duplication of efforts and costs.³ *See Fintiv*, Paper 11 at 10 (“This investment factor is related to the trial date factor, in that more work completed by the parties and court in the parallel proceedings tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.”). Indeed, notwithstanding the efforts made in the case thus far, as discussed above, the district court went on the record to state its inclination to stay the parallel district court litigation pending IPR, if instituted. (EX2011, 4:8-15; *see also* Sections II.A.1 and II.A.2 (*Fintiv* Factors 1 & 2 analysis), *supra*.)

The events in the parallel litigation that Patent Owner identifies in its brief, including initial disclosures, its preliminary infringement contentions, and Petitioner's motion to dismiss pre-transfer in the Western District of Texas (*see* DD Req. at 11), only serve to demonstrate the early stage of the litigation. These are typical events and discovery that occur early in the lifecycle of any patent litigation, and “most of the investment from the court and the parties in the [parallel district court case] lies ahead.” *Illumina, Inc. v. Ravgen, Inc.*, Case No. IPR2021-01271,

³ This is particularly true in view of the district court's stated inclination to grant a stay if IPR is instituted, and in view of Petitioner's prior art stipulation. *See* Sections II.A.1, *supra*, and II.A.4, *infra*.

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Paper 12 at 28-29 (P.T.A.B. Jan. 26, 2022). Furthermore, most of the events identified by Patent Owner have no bearing on the post-transfer proceedings in the Northern District of California, and thus bear no relevance to Factor 3. Petitioner has not renewed its motion to dismiss in the Northern District of California, and Patent Owner has agreed to re-do its infringement contentions under the Northern District of California Patent Local Rules. Patent Owner's amended infringement contentions under the Northern District of California Patent Local Rules are not due until October 23, 2025. (EX2010 at 2.)

All told, the parallel litigation is at an earlier stage with far less investment than other cases in which the Board has declined requests for discretionary denial. *See, e.g., SAP Am., Inc. v. Cyandia, Inc.*, Case No. IPR2024-01433, Paper 13 at 10-11 (P.T.A.B. Apr. 7, 2025) (factor favors institution where claim construction terms and contentions exchanged, no *Markman* hearing held, and expert discovery to close in approximately two months); *Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*, Case No. IPR2025-00321, Paper 10 at 12 (P.T.A.B. June 18, 2025) (factor weighs against discretionary denial where “fact and expert discovery do not close until next year”).

Patent Owner also suggests that Petitioner was less than diligent in filing the Petition and that the timing of the filing supports its Request. (*See* DD Req. at 11-12.) Patent Owner is mistaken. Petitioner diligently filed its well-supported Petition within the statutory deadline, only three months after the case was transferred to the

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Northern District of California, without the benefit of Patent Owner's amended infringement contentions under the operative local patent rules, and many months before Petitioner's invalidity contentions are due. (EX1015; EX2010 at 2.) *See, e.g., Sotera Wireless, Inc. v. Masimo Corp.*, Case No. IPR2020-01019, Paper 12 at 17 (P.T.A.B. Dec. 1, 2020) ("*Sotera*") (finding the timing of the petition was reasonable where "Petitioner filed its Petition approximately two months after serving its initial invalidity contentions, and approximately two weeks before the statutory deadline.").

4. Petitioner's Stipulation Would Result in Minimal Overlap with the District Court Case

Fintiv Factor 4 also weighs against discretionary denial.

To begin with, if the parallel district court litigation is stayed, "there is no danger of overlap." *See ResMed Corp. v. Cleveland Med. Devices, Inc.*, Case No. IPR2025-00160, Paper 11 at 16 (P.T.A.B. June 13, 2025). Putting aside the likelihood of a stay, even if any claims survive this IPR, Petitioner's *Sotera* prior art stipulation minimizes the possibility of overlapping issues between this IPR and the district court litigation. (*See* Pet. at 3.) Though Patent Owner tries to twist the language of Petitioner's stipulation (DD Req. at 14-15), it is *not* limited to only the specific prior art references in the Petition's grounds. Petitioner provided nothing less than a *Sotera* stipulation.

5. Parties in the District Court Case

With respect to *Fintiv* Factor 5, while this IPR and the parallel district court litigation involve the same parties, such a consideration should be found in favor of institution or at least neutral to the discretionary denial analysis. *See, e.g., BOE Tech. Grp. Co. v. Optronix Scis. LLC*, Case No. IPR2024-01130, Paper 16 at 13-14 (P.T.A.B. Jan. 27, 2025) (factor neutral or in favor of institution where parties are the same in IPR and district court litigation); *Shenzhen Root Tech. Co. v. Chiaro Tech. Ltd. d/b/a Elvie*, Case No. IPR2024-01296, Paper 9 at 19-20 (P.T.A.B. Feb. 25, 2025) (factor neutral where parties are the same in IPR and district court litigation). For example, in *BOE Technology Group*, the Board found that this factor was “neutral or weigh[ed] slightly in favor of not exercising discretionary denial” because, like here, “the district-court trial—and hence any ruling on the validity of the claims asserted in the district court—may not occur before the entry of a final written decision in this IPR.” *BOE Tech. Grp. Co.*, Paper 16 at 13-14.

B. Other Considerations Also Weigh Against Discretionary Denial

In addition to the *Fintiv* factors above, several other considerations listed in the Acting Director's March 26, 2025 Memorandum on Interim Processes for PTAB Workload Management (“Memo”) also do not favor discretionary denial. (*See* Memo at 2.)

1. The Validity or Patentability of the Challenged Claims Has Not Been Adjudicated Before

For starters, neither the PTAB nor another forum has previously adjudicated the validity or patentability of the challenged patent claims. This IPR is the first and only post-grant challenge to the '972 patent at the Patent Office. Moreover, as noted in the Petition, the primary prior art reference relied on, Fontana [EX1003], was not identified during prosecution. (Pet. at 4.) And although the examiner initially identified Lau [EX1004] (*see* EX1007, pp.0069, 0071), the examiner never mentioned Lau again, not recognizing Lau's significance to the claims as amended during prosecution. (*See, e.g.*, EX1007, pp.00203-00206 (Reasons for Allowance); Pet. at 26-36.) The failure to identify and appreciate such material prior art references should not only weigh against discretionary denial generally, it should also weigh specifically against any alleged "settled expectations" of Patent Owner, as further explained next.

2. Patent Owner's "Settled Expectations" Should Be Rejected

With respect to "settled expectations," Patent Owner offers *zero* evidence—and Petitioner could find none—that any of the challenged claims have ever been "commercialized, asserted, marked, licensed or otherwise applied" in Petitioner's technology space. *Shenzhen Tuozhu Tech. Co. Ltd. v. Stratasys, Inc.*, Case No. IPR2025-00438, Paper 10 (P.T.A.B. July 17, 2025). Patent Owner offers only empty self-serving statements about an apparently defunct 2015 "Video-to-Data" product

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and presenting its “patent pending” technology at a conference that same year, years before the patent issued. (DD Req. at 18.) But “[a] ‘patent pending’ notice gives one no knowledge whatsoever.” *State Indus., Inc. v. AO Smith Corp.*, 751 F. 2d 1226, 1236 (Fed. Cir. 1985); *see also Fluidigm Corp. v. IONpath, Inc.*, No. C 19-05639 WHA, 2020 WL 408988, at *3 (N.D. Cal. Jan. 24, 2020) (quoting *State Indus.*). “Filing an application is no guarantee any patent will issue and a very substantial percentage of applications never result in patents.” *Id.* And “[w]hat the scope of claims in patents that do issue will be is something totally unforeseeable.” *Id.* That common unforeseeable change in scope is especially true here, as shown in the table below, which provides a side-by-side comparison of pending claim 1 as of 2015 and claim 1 as ultimately allowed (with underlining indicating added language and strike-through indicating deleted language):

Then-pending Claim 1 (2015)	As-allowed Claim 1 (2018)
<p>1. A method to generate video data from a video comprising:</p> <p>generating audio files and image files from the video;</p> <p>distributing the audio files and image files across a plurality of processors and processing the audio files and image files in parallel;</p> <p>converting audio files associated with the video to text;</p> <p>converting the image files associated with the video to video data;</p>	<p>1. A method to generate video data from a video comprising:</p> <p>generating audio files and image files from the video;</p> <p>distributing the image files across a plurality of processors and processing the image files in parallel, <u>wherein processing the image files comprises extracting one or more objects and identifying the one or more objects;</u></p> <p><u>processing the audio files;</u></p> <p>converting audio files associated with</p>

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Then-pending Claim 1 (2015)	As-allowed Claim 1 (2018)
cross-referencing the text and the video data with the video .	the video to text; converting the image files associated with the video to video data; <u>generating a topical meta-data that describes content of the video by deriving semantic information from the identification of the one or more objects and semantic information from the audio files;</u> <u>adding the topical meta-data to the video; and</u> cross-referencing the text and the video data <u>based on the generated topical meta-data to determine topics;</u> <u>generating video text based on the cross-referencing, wherein the video text describes content of the video;</u> <u>generating a text, image, or animation based on the video text; and</u> <u>placing the text, image, or animation in the video.</u>

(See EX1007 (’972 File History), p.0013; ’972, claim 1; *see also* EX1007, p.0079 (first amendment, in February 2016).) As shown in the table above, the scope of the ’972 patent as issued in 2018 is dramatically different from the application in 2015. Patent Owner’s activities related to its “patent pending” technology in 2015 are therefore not evidence supporting its purported settled expectations.

Putting aside the change in claim scope during prosecution, Patent Owner’s

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suggestion that Petitioner’s role as a corporate partner at the 2015 conference somehow implicates “settled expectations” is also meritless. (DD Req. at 18.)

Petitioner sponsors or otherwise participates in many technology conferences and conventions every year, with countless participants and presenters—including at least the following large conventions in 2015 according to public data:

Google I/O 2015	Google Cloud Next 2015
Mobile World Congress (MWC) 2015	Consumer Electronics Show (CES) 2015
South by Southwest (SXSW) Interactive 2015	SPROCKIT 2015
ANA Media Leadership Conference	FIRST Conference 2015
NeurIPS (NIPS) 2015	International Conference on Machine Learning (ICML) 2015
ACM SIGMOD 2015	USENIX LISA15
Game Developers Conference (GDC)	SIGGRAPH
Web Summit	TechCrunch Disrupt
Google Developer Days	O’Reilly Open Source Convention (OSCON) 2015
PyCon US 2015	Strata + Hadoop World 2015
Google Summer of Code Summit	@Scale 2015

This list does not include the many other meetups, hackathons, and local developer events Petitioner has supported through its Google Developer Groups and Google for Entrepreneurs (now known as Google for Startups) programs, which would be a much longer list. Patent Owner’s one-off presentation at one event where Petitioner

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provided some sponsorship, years before the patent issued, does not support its “settled expectations.” Patent Owner cites *Murata Manufacturing*, but unlike that case, there is no evidence here that Patent Owner and Petitioner even communicated, let alone discussed Patent Owner's work.⁴ *Murata Mfg. Co. v. Georgia Tech Research Corp.*, Case No. IPR2025-00383, Paper 14 at 2-3 (P.T.A.B. July 29, 2025) (*see also* cited DD Opp. (Paper 11) at 21-26). Here, Patent Owner has shown, at most, that Petitioner provided a space (Google Tech Corners) for the conference to take place.

Patent Owner's argument about a citation to a *different* patent in a 2021 information disclosure statement during prosecution of one of Petitioner's patent applications should also be rejected. (DD Req. at 17.) For starters, 37 C.F.R. § 1.97(h) is clear that an IDS is not an admission that the cited information is considered material to patentability. *See* 37 C.F.R. § 1.97(h). The examiner's silence regarding the citation is consistent with the reference's lack of materiality to Petitioner's patent application. More importantly, citation to a patent or patent application during prosecution does not support an expectation regarding the validity

⁴ Indeed, despite the existence of accused products at the time the '972 patent issued in 2018, Patent Owner waited six years—until 2024—to file suit. If any party should have settled expectations, it should be Petitioner.

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of that patent or patent application, nor an expectation that validity will not be challenged. As just one example, U.S. Patent No. 6,415,316 has been cited in over 100 patent applications.⁵ But even though claims of that patent were invalidated as obvious following a jury trial in 2014, the patent *continues* to be cited. *See, e.g., Rembrandt Social Media, LP v. Facebook, Inc.*, Case No. 1:13-cv-158, D.I. 523 (E.D. Va. June 13, 2014) (verdict form) (EX1015); U.S. Pat. App. No. 15/903,423, Feb. 26, 2021 Notice of References cited, page 2 (EX1016). Patents and patent applications are not cited during prosecution based on whether their claims are, or are believed to be, valid. Patent Owner cites *IRhythm Technologies* (DD Req. at 19), but unlike here, that case involved allegations and evidence that the petitioner “ha[d] an established and public track-record of monitoring existing patents.” *See IRhythm Techs., Inc. v. Welch Allyn, Inc.*, Case No. IPR2025-00363, Paper 7 at 30 (Patent Owner's discretionary denial brief); *see also IRhythm Techs., Inc. v. Welch Allyn, Inc.*, Case No. IPR2025-00363, Paper 10 at 3 (P.T.A.B. June 6, 2025). Patent Owner does not allege that Petitioner was drafting its own patent claims or developing products using the claims of Patent Owner's patents; and as noted, Patent Owner has not alleged that it is, or ever was, a competitor of Petitioner. The IDS's citation to a different patent does not support Patent Owner's purported settled expectations for

⁵ *See* EX1017 (stating that “US 6415316 B1 is cited by 123 patents”).

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the '972 patent.

Patent Owner's assertion that Petitioner should have petitioned for IPR at the time of the IDS, or even when the '972 patent first issued, should be rejected. (*See* DD Req. at 16-17.) It simply ignores reality. For example, Petitioner maintains an extensive and active patent prosecution docket, including roughly 26,800 issued U.S. utility patents and 6,200 pending U.S. utility applications. It is untenable to expect Petitioner to investigate all references cited during its prosecution matters, analyze their claims (and potential claims), and the claims in any related family members that may not even be cited, and file pre-emptive challenges at the PTAB to preserve a right to the IPR process. It would be an enormous expenditure of resources to challenge even a fraction of patents based on trying to predict possible future infringement allegations related to patents or applications cited during prosecution, let alone all patents that generally could relate to an area of technology in which Petitioner is involved. That expense would extend to patent owners and the PTAB. The timing of Petitioner's challenge to the '972 patent does not support settled expectations for Patent Owner.

Moreover, the examination itself of the '972 patent should undercut Patent Owner's expectations. As noted above, material errors were made during prosecution—including failing to identify at all the highly material Fontana prior art reference and not appreciating the significance of the Lau prior art reference to the

claims as amended. The ’972 patent therefore issued as a result of a clearly flawed prosecution, which should weigh against Patent Owner’s “settled expectations.”

3. The Merits of the Petition Are Strong, and Petitioner Relied Properly on Expert Testimony

The merits of the Petition are strong, presenting a compelling case of unpatentability. The Petition presents a straightforward combination of the teachings of Fontana [EX1003] and Lau [EX1004], optionally in further view of Arakawa [EX1005].⁶ The Petition does not use the expert report to “gap fill.” Patent Owner ignores that the Petition presents prior art disclosure for every element of the challenged claims from the cited prior art within the Grounds—there is not a single claim element for which Petitioner relies solely on expert testimony to demonstrate invalidity. *See Advanced Micro Devices Inc. v. Realtek Semiconductor Corp.*, Case No. IPR2023-00789, Paper 9 at 39 (P.T.A.B. Oct. 26, 2023) (rejecting patent owner assertion that petitioner improperly relied on expert testimony to fill a gap in its prior

⁶ To the extent Patent Owner is arguing that the Petition is weak on the merits *because* it presents only an obviousness theory, Patent Owner is wrong. “Obviousness makes up the vast majority of invalidations in IPR.” Stephen Yelderman, *Prior Art in Inter Partes Review*, 104 Iowa L. Rev. 2705, 2719 (July 2019) (available at <https://ilr.law.uiowa.edu/sites/ilr.law.uiowa.edu/files/2023-02/Yelderman.pdf>).

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art analysis); *Samsung Elecs. Co. v. Acorn Semi, LLC*, Case No. IPR2020-01282, Paper 20 at 28-29 (P.T.A.B. Feb. 10, 2021) (rejecting patent owner accusation petitioner required expert testimony to fill in gaps).

The evidence does not bear out Patent Owner's baseless assertions. Patent Owner cites to only two specific uses of expert testimony as supposed improper gap filling. The first is the observation in the Petition that "A POSA would understand 'semantic information' to refer to information conveying or associated with the meaning of content." (DD Req. at 21-22, quoting Paper 2 at 23.) But Patent Owner fails to note that this quoted language is not what the Petition relies upon to show that the limitation in question is disclosed by the prior art. Rather, this quote from the Petition properly references expert testimony for an ancillary statement of the plain and ordinary meaning of "semantic information." (*See* Pet., Paper 2 at 23.) The Petition relies upon teachings in the prior art to show the invalidity of this limitation. (Pet. at 20-24 (citing Fontana ¶¶0107, 0120-0121, 0139).)

Patent Owner's next complaint—that the Petition cites to expert testimony in support of the motivation to combine Fontana with Lau—is similarly baseless. As even Patent Owner acknowledges in its Request, the Petition cites extensively to the prior art to show the motivation to combine, and the motivation to combine is drawn from those prior art citations. (DD Req. at 22 ("the expert declaration is nearly identical to the petition, again with the only change being that the quotations are not

truncated, without providing any additional supporting evidence or any technical reasoning”) (emphasis added.) Patent Owner’s complaint seems to be that the expert points to the same portions of the prior art references as the Petition; that does not show improper reliance on expert testimony, but rather the opposite, that the prior art references themselves show the obviousness of the limitation in question. Rather than an over-reliance on expert testimony, the Petition properly and thoroughly demonstrates how each limitation is taught by the combination of Fontana and Lau, and how those references provide the motivation to combine. (*See, e.g.*, Pet. at 30-32 (explaining motivation to combine Fontana and Lau).) The expert declaration explains and supports, but does not supplant, the Petition’s reliance on the prior art references themselves.

III. CONCLUSION

Petitioner respectfully requests that the Director not exercise her discretion under 35 U.S.C. § 314(a) to deny institution of this proceeding.⁷

⁷ Petitioner reserves the right to challenge the March 26, 2025 Interim Processes for PTAB Workload Management, including that document’s list of “relevant factors,” at least because that document is legally invalid as (1) exceeding the Director’s authority, (2) arbitrary and capricious, and (3) adopted without notice-and-comment rulemaking.

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Dated: September 11, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH WORD COUNT

I hereby certify, pursuant to 37 C.F.R. § 42.24(d), that the attached **PETITIONER'S RESPONSE TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** contains 4,612 words according to the word-processing system used to prepare this paper.

Dated: September 11, 2025

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. § 42.6(e), that a complete copy of the attached **PETITIONER'S RESPONSE TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** and related documents were served on September 11, 2025, upon the parties via electronic mail:

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