

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEOTAB INC. AND GEOTAB USA, INC.,
Petitioners,

v.

FRACTUS, S.A.,
Patent Owner.

Case No. IPR2025-01027
Patent No. 11,349,200

**BRIEF IN SUPPORT OF PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

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Ex. 2002	Defendants' Preliminary Invalidity Contentions dated June 18, 2025 in 2:24-cv-01009-JRG-RSP (E.D.Tex.)
Ex. 2003	Invalidity Contentions for U.S. Patent No. 11,349,200 in 2:24-cv-01009-JRG-RSP (E.D.Tex.)
Ex. 2004	Amended Docket Control Order dated April 10, 2025 in 2:24-cv-01009-JRG-RSP (E.D.Tex.)
Ex. 2005	Complaint dated December 6, 2024 in 2:24-cv-01008-JRG-RSP (E.D.Tex.)
Ex. 2006	Docket Navigator Time to Trial Statistics for Judge Rodney Gilstrap (last accessed July 23, 2025)
Ex. 2007	Reexamination Certificate for U.S. Patent No. 11,349,200, issued October 18, 2024
Ex. 2008	Declaration of Mark J. DeBoy

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37 C.F.R. §42.613

I. INTRODUCTION AND SUMMARY OF ARGUMENT

Pursuant to the March 26, 2025 Memorandum by the Director that addresses “Interim Processes for PTAB Workload Management” (“Director Memo”), Patent Owner respectfully requests the Director exercise discretionary denial of institution. Several considerations favor discretionary denial of institution in this IPR.

First, the Director should exercise discretion to deny institution under 35 U.S.C. § 314(a), the Director Memo and the *Fintiv* factors because the parallel district court litigation will reach a final resolution in a jury trial before any final written decision by the Board. Indeed, the parallel litigation is well underway with the parties having exchanged invalidity and infringement contentions. Discretionary denial would likewise be wholly consistent with the Director’s decisions to date in similar circumstances.

Second, the validity of claims 11 and 12 of the patent at issue, U.S. Patent No. 11,349,200 (“the ‘200 Patent”), were already the subject of reexamination and there patentability was confirmed.

Third, the ‘200 Patent issued over 3 years ago and Petitioners have been aware of the patents in the same family as the ‘200 Patent since at least 2021, when Patent Owner brought those related patents to Petitioners’ attention. Petitioners’ awareness and failure to seek early review demonstrate the parties’ settled expectations and, accordingly, support discretionary denial of the Petition.

Fourth, the Petition's patentability challenge is weak and, accordingly, is unlikely to resolve the dispute between the parties. Specifically, the invalidity grounds either propose combinations of references that are contrary to the design requirements of the primary reference or misconstrue claim language in order to read the cited art on the patent claims.

II. FACTUAL BACKGROUND

The '200 Patent issued on May 31, 2022. Ex. 1001 at 1. Patent Owner gave notice to Petitioners of patents related to the '200 Patent in October of 2021, which Petitioners confirmed via a letter dated November 15, 2021. Ex. 2008 at ¶ 6; Ex. 2005 at ¶¶ 17-18. On December 6, 2024, Patent Owner filed suit against Petitioners in the U.S. District Court for the Eastern District of Texas alleging infringement of the '200 Patent and four other patents.¹ On that same date, Patent Owner filed suit

¹ U.S. Patent Nos. 8,810,458, 8,456,365 11,031,677 and 12,095,149. IPR Petitions as to U.S. Patent Nos. 8,456,365 and 8,810,458 were filed by Petitioners (IPR2025-00928 and IPR2025-00929) and accorded the filing date of April 30, 2025. On July 28, 2025, Patent Owner filed briefs requesting discretionary denial of those petitions. IPR2025-00928, Paper 7 and IPR2025-00929, Paper 7. Those requests are still pending. In addition, Petitioners filed an IPR Petition as to U.S. Patent No. 11,031677, which has been accorded the same filing date as the present

against Verizon, alleging infringement five other patents, three of which overlap with the patents asserted against Petitioners.² Ex. 2008 at ¶ 2. The cases were consolidated by order of the Court on February 18, 2025 (“District Court Litigation”). Ex. 2001 at 7 (entry 17). The District Court Litigation is continuing to proceed in accordance with the Court’s Docket Control Order with trial scheduled for September 14, 2026. Order. Ex. 2004 at 1. On June 18, 2025, Defendants served their joint invalidity contentions, which include, *inter alia*, the same invalidity contentions as those raised in this proceeding. Ex. 2008 at ¶ 4; Ex. 2002 at pp. 71-92; Ex. 2003 at E-02. On June 30, 2025, Petitioners moved to stay the District Court Litigation and to deconsolidate the case from the claims against Verizon. Ex. 2001 at 9 (entry 50). On July 14, 2025, Patent Owner opposed the motion to stay. Ex. 2001 at 9 (entry 50). The motion to stay is currently pending. Ex. 2001.

III. LEGAL STANDARD

As indicated in the Director Memo:

proceeding and Patent Owner is filing a Brief in Support of Discretionary Denial in that proceeding contemporaneously with the filing of this Brief. Petitioners have also filed a PGR Petition as to U.S. Patent No. 12,095,149 (PGR2025-00056), which has been accorded a filing date of June 17, 2025.

² The ‘200 Patent has not been asserted against Verizon.

[C]onsistent with the discretionary considerations enumerated in existing Board precedent (including *Fintiv*, *General Plastic*, and *Advanced Bionics**) and the Consolidated Trial Practice Guide (Nov. 2019), the parties are permitted to address all relevant considerations, which may include:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

Director Memo at 2-3 (*citing, Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential); *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (Sept. 6, 2017) (precedential as to § II.B.4.i); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gertite GmbH*, IPR201901469, Paper 6 (Feb. 13, 2020) (precedential)).

IV. DISCRETIONARY DENIAL IS APPROPRIATE

A Final Written Decision in this Proceeding is Unlikely Before the District Court Trial

Trial in the District Court Litigation is set for September 14, 2026,^{3,4} whereas, final written decisions in this proceeding and IPR2025-01026 are unlikely prior to January 1, 2027.⁵ The decisions in the two IPRs and the PGR for other patents

³ It is not clear, at this point, whether the District Court intends to trial the cases separately and, if so, whether Verizon or Geotab claims will be tried first.

⁴ Judge Gilstrap has numerous trials scheduled to begin on this date. It is standard practice for Judge Gilstrap to set multiple trials for the same date given the normal attrition of cases, but the Board, no doubt recognizing this is the case has consistently relied on the trial date in the Docket Order in assessing the trial date for discretionary denial purposes.

⁵ The Notice of Filing Date Accorded issued July 1, 2025 (Paper 8), the institution decision would be expected to issue no later than January 1, 2026. *See* 35 U.S.C. § 314(b) (setting the deadline for institution decision at three months after the patent owner's preliminary response); 37 C.F.R. § 42.107(b) (setting the deadline for patent owner's preliminary response at three months after the notice of filing date accorded). Thus, the projected deadline for a final written decision would be January

asserted against Petitioners (IPR2025-00928, IPR2025-00929, and PGR2025-00056) will all be completed after trial either slightly before this one or even further after the conclusion of the trial in the District Court Litigation. *See supra*, n. 1. In spite of awareness of the trial date in the District Court Litigation and having the benefit of the Director Memo, Petitioners delayed the filing of these three additional proceedings for more than two months, pushing their completion dates well past the litigation trial date.

As reflected in the chart below, decisions on discretionary denial requests with respect to cases pending in the U.S. District Court for the Eastern District of Texas made since the issuance of the Director Memo have consistently determined that discretionary denial should be exercised in such circumstances.

Decision	Scheduled Trial Date	Projected Final Decision by Board
<i>Full-Metal-Power B.V. v. Infocus Downhole Solutions USA LLC</i> , IPR-2025-00391, Paper 14 (June 25, 2025)	June 22, 2026	July 30, 2026
<i>Cisco Sys., Inc. v. WSOU Investments LLC</i> , IPR2025-00429, Paper 15 (June 25, 2025)	April 20, 2026	July 30, 2026

1, 2027—over three months after the trial in the District Court Litigation. *See* 37 C.F.R. § 42.100(c) (setting the deadline for a final written decision at one year after institution).

<i>Samsung Electronics, v. Cerence Operating Co.</i> , IPR2025-00458-00460, Paper 14 (June 25, 2025)	April 20, 2026	August 27, 2026
<i>Sportradar AG v. Sportcastr Inc.</i> , IPR2025-00265, 00266, 00268, 00269, 00273, 00275, Paper 19 (June 25, 2025)	January 23, 2026	July 8, 2026
<i>Google LLC. v. Truesight Communications LLC</i> , IPR2025-00024-25, Paper 13 (June 25, 2025)	October 6, 2025	July 2026
<i>Ericsson Inc. v. Procomm Int'l PTE LTD.</i> , IPR2024-01455, Paper 15 (May 16, 2025)	October 20, 2025	July 29, 2026
<i>Neogenomics Labs, Inc. v. Natera, Inc.</i> , IPR2025-00455, Paper 13 (June 12, 2025)	October 10, 2025	August 14, 2026
<i>Samsung Electronics Co., Ltd. v. Sinotechnix LLC</i> , IPR2025-00331, 00333, 00335-36, Paper 13 (July 2, 2025)	May 4, 2026	September 6, 2026
<i>SAP America Inc. v. Valtrus Innovations LTD.</i> , IPR2025-414-418, 420, Paper 12 (July 10, 2025)	September 22, 2025	August 2026
<i>Samsung Electronics Co. Ltd, and Samsung Electronics America, Inc. v. Vasu Holdings LLC</i> , IPR2025-446-450, Paper 12 (July 10, 2025)	November 3, 2025	August/September 2026
<i>Coretronic Corp. and Optoma Corp. v. Maxell, Ltd.</i> , IPR2025-474, 476-77, Paper 11 (July 10, 2025)	March 23, 2026	September 10, 2026
<i>Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. v. Mobile Data</i>	April 20, 2026	September 2026

<i>Technologies, LLC, IPR2025-535-36, Paper 16 (July 10, 2025)</i>		
<i>Sportradar AG v. Sportcastr, Inc. (d/b/a Panda Interactive), IPR2025-00313-16, Paper 18 (July 16, 2025)</i>	January 23, 2026	August 20, 2026
<i>IBM Corp. v. Virtamove, IPR2025-00591, 00599, Paper 8 (July 17, 2025)</i>	January 2026	October 10, 2026
<i>Charter Communications, Inc. v. Iarnach Technologies LTD., IPR2025-00473, Paper 14 (July 16, 2025)</i>	February 9, 2026	September 27, 2026
<i>Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc., v. Four Batons Wireless, LLC, IPR2025-00493-496, Paper 13 (July 17, 2025)</i>	March 2026	September 23, 2026
<i>Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc., v. Keyless Licensing LLC, IPR2025-00526-529, Paper 13 (July 17, 2025)</i>	April 20, 2026	October 9, 2026
<i>Samsung Electronics Co., Ltd. v. Headwater Research, IPR2025-00482, Paper 15 (July 24, 2025)</i>	January 2026	July 29, 2026
<i>BOE Technology Group Co., Ltd. v. Optronic Sciences LLC, IPR2025-00238-39, Paper 11 (July 29, 2025)</i>	May 4, 2026	October 2026
<i>Amazon.com, Inc. v. Kaifi LLC, IPR2025-00624-27, Paper 16 (July 29, 2025)</i>	March 16, 2026	October 11, 2026
<i>T-Mobile USA, Inc., AT&T Mobility LLC, Cellco Partnership d/b/a Verizon</i>	November 17, 2025	October 2026

<i>Wireless, Ericsson Inc. and Nokia of America Corp. v. Smart RF Inc.</i> , IPR2025-00612, 00691-92, 00727, Paper 13 (July 29, 2025)		
<i>AT&T Services Inc., Cellco Partnership d/b/a Verizon Wireless, and Nokia of America Corp.</i> , IPR2025-00360-62, Paper 12 (July 29, 2025)	October 20, 2025	October 15, 2026
<i>Vertiv Corporation v. Valtrus Innovations LTD.</i> , IPR2025-00667-69, Paper 11 (July 31, 2025)	April 6, 2026 and June 22, 2026	October 2026
<i>Samsung Electronics Co., Ltd., Samsung Electronics America, Inc. v. Cerence Operating Company</i> , IPR2025-00457, Paper 13 (August 4, 2025)	April 20, 2026	October 8, 2026
<i>Samsung Electronics Co., Ltd. v. Headwater Research LLC</i> , IPR2025-00481, 483-84, Paper 11 (August 4, 2025)	February 9, 2026	October 16, 2026,
<i>Transcend Information, Inc., v. Truesight Communications LLC</i> , IPR2025-00723, Paper 10 (August 4, 2025)	January 5, 2026	October 16, 2026
<i>Samsung Electronics Co., LTD. and Samsung Electronics America, Inc., v. Mobile Data Tech., LLC</i> , IPR2025-00537-44, Paper 15 (August 14, 2025)	April 20, 2026	October 2026
<i>REC Solar Holdings AS, v. Maxeon Solar PTE. Ltd.</i> , IPR2025-00592-95, Paper 8 (August 14, 2025)	June 1, 2026	October 17, 2026
<i>Taiwan Semiconductor Mfg. Co. LTD. v. Advanced Integrated</i>	June 22, 2026	October 18, 2026

<i>Circuit Process LLC</i> , IPR2025-00682-83, Paper 17 (August 14, 2025)		
<i>Samsung Electronics Co., LTD. and Samsung Electronics America, Inc., v. Genghiscomm Holdings, LLC</i> , IPR2025-00780-81, Paper 11 (August 14, 2025)	April 20, 2026	October 18, 2026
<i>Samsung Electronics Co., LTD. and Samsung Electronics America, Inc., v. Icashe, Inc.</i> , IPR2025-00639-45, Paper 11 (August 14, 2025)	April 6, 2026	October 16, 2026
<i>Samsung Electronics Co., LTD. and Samsung Electronics America, Inc., v. Genghiscomm Holdings LLC</i> , IPR2025-00788-93, Paper 11 (August 22, 2025)	April 20, 2026	October 2026
<i>Cisco Systems, Inc. v. WSOU Investments LLC d/b/a Brazos Licensing and Development</i> , IPR2025-00188, Paper 14 (August 22, 2025)	March 2026	June 17, 2026

While all these decisions rely upon the trial date in the Court’s docket control order, some also cite time to trial statistics. These statistics also support discretionary denial. Indeed, Judge Gilstrap’s historical practice confirms that trial will conclude before a final written decision in this proceeding. Over the past two years, Judge Gilstrap has an average time-to-trial of 22 months from filing of the complaint for

jury trials, whether one looks to the mean or median average. Ex. 2006.⁶ This average time to trial predicts a trial date of around October 6, 2026, consistent with the scheduled trial date of September 14, 2026, and well in advance of the expected January 1, 2027, final written decision date in this proceeding.

As the remainder of this brief demonstrates, there is no reason for the Board to deviate from its practice of granting discretionary denial when the same invalidity issues will be addressed more promptly in the District Court Litigation.

**Stay of the District Court Proceedings is Unlikely and,
Nevertheless, Will Not Avoid Duplicative Proceedings**

Several years ago, Judge Bryson (sitting by designation) surveyed “cases from the Eastern District of Texas” and concluded that “the universal practice” in this District is to “postpone[] ruling on stay requests or [] den[y] stay requests when the PTAB has not yet acted on the petition for review.” *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV-1047-WCB, 2015 WL 1069179, at *5-6 (E.D. Tex. Mar. 11, 2015) (“when the PTAB has not yet acted on a petition for inter partes review, the courts have uniformly denied motions for a stay”). This practice continues to this

⁶ Patent Owner has relied upon Judge Gilstrap’s statistics rather than district wide statistics, because they are a much more reliable indication of what will occur in cases pending before Judge Gilstrap, which is the relevant question.

day. Indeed, Judge Gilstrap, before whom this case is pending in the Eastern District of Texas, has held that, as is the case here, motions to stay will be denied if filed before the “last of the patents-in-suit to be acted upon by the PTAB.” *Acorn Semi, LLC v. Samsung Elecs. Co.*, No. 2:19-CV-00347-JRG, 2020 WL 10284981 at *2 (E.D. Tex. Sept. 14, 2020).

As noted above, the District Court Litigation involves multiple patents which are challenged by IPRs and a PGR with different filing dates. Given past practice it is unrealistic to believe that Judge Gilstrap will depart from his prior practice by granting a stay in this case.

Claims 11 and 12 have Already been Subjected to Reexamination

The Director Memo clearly states that one of the factors to be considered in whether to discretionarily deny a petition is “[w]hether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims.” Director Memo at 2. Claims 11 and 12 were the subject of U.S. Patent Reexamination No. 90/019,275 filed on October 12, 2023. That reexamination resulted in the issuance of an Ex Parte Reexamination Certificate on October 18, 2024, confirming the patentability of claims 11 and 12. Ex. 2007.

Claims 11 and 12 represent a subset of the claims challenged in the Petition, but per Petitioners' invalidity theories, they are essentially representative of all the independent claims challenged in the Petition. As indicated on pages 64-67, 69, and

70 of the Petition, Petitioners rely on the same art and obviousness rationales for independent claims 6 and 11 that they rely on for claim 1 – it is Petitioners' position that all independent claims in the '200 Patent should be invalid over the same obviousness theories. The confirmation of claim 11 in reexamination, therefore, supports discretionarily denying IPR of all claims challenged in the Petition.

Discretionary Denial Protects Patent Owner's Settled Expectations

The '200 Patent issued over three years ago, and Petitioners have been aware of patents related to the '200 Patent since at least 2021, when Patent Owner brought those patents to Petitioners' attention. Ex. 2008 at ¶ 6; Ex. 2005 at ¶¶ 17-18. Its pre-grant publication published four years ago, and at the same time its electronic patent file became publicly available for Petitioners' inspection and review. EX1001 at 1, 37 C.F.R. § 1.11.

Thus, Petitioners have had many years in which to raise these invalidity arguments and yet has chosen not to do so. *See Samsung Electronics Co., Ltd. v. Sinotechnix LLC*, IPR2025-00331, 00333, 00335-36, Paper 13 (July 2, 2025) (*citing Dabico Airport Sols. Inc. v. Axa Power Aps*, IPR2025-00408, Paper 21 at 2–3 (June 18, 2025); *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12, 2–3 (June 26, 2025)).

The Patentability Challenge is Weak

In accordance with the Interim Processes FAQs, Patent Owner incorporates herein the merit arguments and evidence from its forthcoming Patent Owner Preliminary Response (“POPR”) by reference. See Interim Processes FAQ No. 26 (“Notwithstanding the prohibition on incorporation by reference in 37 C.F.R. §42.6(a)(3), when filing a brief for discretionary denial, a patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits.”).⁷ As will be shown in the POPR, the invalidity grounds either require the skilled artisan to modify the primary reference in a way directly contrary to the design guidelines provided in the reference, or rely on a misunderstanding of claim terms to read the cited art on the patent claims.

The *Fintiv* Factors Favor Discretionary Denial

Patent Owner provides the following discussion of the *Fintiv* Factors, illustrating that discretionary denial of the Petition is appropriate even absent the discretionary denial guidance provided in the Director Memo.

⁷<https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>

***Fintiv* Factor 1: The district court has not granted a stay, likely will not do so**

As discussed in Section IV. B, *supra*, a stay in the District Court Litigation is unlikely. Accordingly, the first *Fintiv* Factor favors discretionary denial.

***Fintiv* Factor 2: The District Court Litigation's trial date is earlier.**

As discussed in Section IV.B, *supra*, the trial date in the District Court Litigation is earlier for this and all of the related post-grant proceedings arising out of the District Court Litigation. Accordingly, the second *Fintiv* Factor favors discretionary denial.

***Fintiv* Factor 3: The parties have invested resources in the District Court Litigation**

The parties have already exchanged detailed infringement and invalidity contentions in in the District Court Litigation. Ex. 2002; Ex. 2003. The parties will likely have exchanged proposed claim terms and preliminary claim constructions prior to an institution decision in this case. Ex. 2004 at 5. Accordingly, the third *Fintiv* Factor favors discretionary denial.

***Fintiv* Factor 4: The same invalidity contentions are at issue in the Petition and the District Court Litigation**

The invalidity contentions include the same arguments made in the Petition. Ex. 2008 at ¶ 4; Ex. 2002 at pp. 11-17; Ex. 2003 at pp. 380-451. Accordingly, the fourth *Fintiv* Factor favors discretionary denial.

***Fintiv* Factor 5: Petitioners are defendants in the District Court
Litigation.**

Petitioners are defendants in the District Court Litigation. Accordingly, the fifth *Fintiv* Factor favors discretionary denial.

***Fintiv* Factor 6: The Petition is meritless.**

As discussed in detail in Section IV.D and as will be discussed in the POPR, the patentability challenges in the Petition are weak and Petitioners are unlikely to prevail. Accordingly, the sixth *Fintiv* Factor favors discretionary denial.

V. CONCLUSION

Appropriate analysis under the framework described in the Director Memo and *Fintiv* based on the evidence of record favors exercising discretion to deny institution of the Petition.

Dated: September 1, 2025

Respectfully submitted,
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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** and accompanying **EXHIBITS** were served via email (as previously consented to by counsel) on September 1, 2025 to lead and backup counsel of record for Petitioners as follows:

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