UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

SECURE COMMUNICATION TECHNOLOGIES, LLC,

Patent Owner.

Case IPR2025-01181

U.S. Patent No. 11,334,918

PATENT OWNER'S BRIEF IN SUPPORT OF DISCRETIONARY DENIAL

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TABLE OF AUTHORITIES

Cases: **Page(s):**

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PATENT OWNER'S EXHIBIT LIST

Exhibit #	Description
2001	Declaration of James Proctor, Jr.
2002	Mr. Proctor's November 2011 Correspondence with Google
2003	LinkedIn Profile – Kyle Enright (Google)
2004	Mr. Proctor's February 2012 Correspondence with Google
2005	LinkedIn Profile – Amar Mehta (Google)
2006	Application Data for Google's U.S. Patent Application No. 13/716,675
2007	December 2012 IDS from U.S. Patent Application No. 13/716,675
2008	Application Data for Google's U.S. Patent Application No. 12/969,291
2009	May 2012 IDS from U.S. Patent Application No. 12/969,291
2010	Application Data for Motorola Mobility's U.S. Patent Application No. 13/738,384
2011	May 2014 Notice of References Cited from U.S. Patent Application No. 13/738,384
2012	Application Data for Google's U.S. Patent Application No. 17/305,266
2013	July 2021 IDS from U.S. Patent Application No. 17/305,266
2014	Complaint from *Secure Commc'n Techs., LLC v. Samsung Elecs. Co., Ltd. et al*., No. 2:24-cv-484-JRG (E.D. Tex.)
2015	Redacted Version of Samsung's Motion to Transfer Venue from *Secure Commc'n Techs., LLC v. Samsung Elecs. Co., Ltd. et al*., No. 2:24-cv-484-JRG (E.D. Tex.)
2016	Complaint from *Secure Commc'n Techs., LLC v. Google, LLC*, No. 1:25-cv-1207 (W.D. Tex.)
2017	First Amended Complaint from *Secure Commc'n Techs., LLC v. Google, LLC*, No. 1:25-cv-1207 (W.D. Tex.)
2018	Google blog article concerning Nearby Share
2019	Article from Techcrunch.com concerning Google Fast Pair
2020	Article from Techcrunch.com concerning Android Device Manager (precursor to Google Find Hub)
2021	Google blog article concerning generations of Pixel phones

I. INTRODUCTION

Pursuant to 35 U.S.C. §§ 314 and 325 and the Director's Interim Processes for PTAB Workload Management ("Interim Process Memo"), Patent Owner Secure Communication Technologies, LLC ("SCT") respectfully requests that the Director exercise discretion to deny institution of this Petition. Discretionary denial is appropriate because (i) Petitioner Google LLC ("Google") has been on notice of the patent family to which the challenged patents[1] belong for more than 13 years, creating settled expectations as to the validity of the challenged patent and its family members; (ii) Google's IPR petitions (even if successful) will not resolve the entirety of the parties' dispute, as those petitions only concern three of the five patents asserted in the parallel district court action, thereby undercutting any efficiency rationale; and (iii) the merits of the Petition are weak.

In addition, Google's IPR petition relies on the same or substantially the same prior art as was considered by the Examiner during prosecution of the challenged patent. The Director should thus also exercise discretion to deny institution under 35 U.S.C. § 325(d) because Google has not (and cannot) explain how the Office

[1] The "challenged patents" refers to the patent challenged in this proceeding, as well as those challenged in Google's concurrently filed petitions in IPR2025-01182 and -01183.

erred in a manner material to the patentability of the challenged claims as required by *Advanced Bionics, LLC v. Med-El Electromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020).

II. FACTUAL BACKGROUND

The challenged patent claims priority to two provisional applications (Nos. 61/095,001, filed September 8, 2008, and 61/095,359, filed September 9, 2008), as well as to a series of continuation applications, beginning with U.S. Patent Application No. 12/364,828 (the "'828 application"), filed February 3, 2009, which issued as U.S. Patent No. 8,090,359 (the "'359 patent"). On February 3, 2009, the inventors also filed three additional non-provisional applications based on the same disclosures, including U.S. Patent Application Nos. 12/364,823, which issued as U.S. Patent No. 8,090,616 (the "'616 patent"), 12/364,897, which issued as U.S. Patent No. 7,936,736 (the "'736 patent"), and 12/364,938, which issued as U.S. Patent No. 8,116,749 (the "'749 patent"). The inventors also later filed a continuation of the '828 application: U.S. Patent Application No. 13/213,028 (the "'028 application"), filed August 18, 2011, which issued as U.S. Patent No. 8,369,842 (the "'842 patent").

In November 2011, Mr. James Proctor, Jr., one of the inventors of the challenged patents, emailed Kyle Enright, then Head of Business Development for Mobile Payments at Google, about the inventions disclosed in the challenged

patents' family. *See* Exs. 2001-2003. On February 9, 2012, Mr. Proctor emailed Amar Mehta, then Senior Counsel at Google, concerning the challenged patents' family and specifically identified the '736, '359, '616, and '749 patents to Mr. Mehta. *See* Exs. 2001, 2004, 2005. Mr. Proctor also indicated that, at the time, there were nine total patent applications in the patent family. *See* Ex. 2004.

Google has also had knowledge of the challenged patents' family since 2012 through Google's own patent prosecution activities. Google cited the '749 patent during prosecution of Google's U.S. Patent Application No. 13/716,675 (which issued as U.S. Patent No. 9,185,148), via a December 17, 2012 Information Disclosure Statement. *See* Exs. 2006-2007. Google also cited U.S. Patent Application Publication No. 2010/0061294 (the publication that led to the '736 patent) during prosecution of Google's U.S. Patent Application No. 12/969,291 (which issued as U.S. Patent No. 8,364,172) via a May 3, 2012 Information Disclosure Statement, and the Examiner of Motorola Mobility's (owned by Google at the time) U.S. Patent Application No. 13/738,384 (which issued as U.S. Patent No. 8,923,831) cited it in a May 7, 2014 Notice of References Cited. *See* Exs. 2008-2011. Google also cited U.S. Patent Application Publication No. 2011/0300802 (the publication that led to the '842 patent) during the prosecution of Google's U.S. Patent Application No. 17/305,266 (which issued as U.S. Patent No. 11,395,356) as the very first reference in a July 2, 2021 Information Disclosure Statement. *See* Exs.

2012-2013. Notably, this last application was not identified in Mr. Proctor's correspondence with Google.

On July 3, 2024, SCT filed a complaint in the U.S. District Court for the Eastern District of Texas, asserting the challenged patents against Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, "Samsung"). *See* Ex. 2014. In that complaint, SCT accused features of Samsung's phones, tablets, and laptops of infringing claims of the challenged patents. *See id.* Among the infringing features were the Nearby Share/Quick Share and Fast Pair features of Samsung's phones and tablets, which Samsung alleged were developed by Google. *See* Ex. 2015. Google then filed IPR petitions against the challenged patents on July 2, 2025, one day before the statutory bar date based on SCT's lawsuit against Samsung.[2]

As Google's Petition references, others have filed IPR petitions concerning family members of the challenged patents. *See* Pet. at 1-3. However, as will be discussed in Patent Owner's Preliminary Response, there are several differences

[2] Samsung also filed IPR petitions concerning the challenged patents. *See* IPR2025-01049, -01050, -01051. In August 2025, SCT reached a settlement with Samsung, and the district court action and all three IPR proceedings involving Samsung have all been terminated.

between the claims at issue in those prior IPR proceedings and those challenged here. Google's Petition admits many of these differences by discussing ten such IPR petitions but only alleging collateral estoppel as to two of them. *E.g.*, Pet. at 36; Exs. 1014-1033. Even as to those two though, key differences in the claims exist, as Patent Owner will discuss in its Preliminary Response.

SCT filed a complaint against Google in the U.S. District Court for the Western District of Texas on August 4, 2025. *See* Ex. 2016. SCT filed a First Amended Complaint ("FAC") in that action on September 8, 2025. *See* Ex. 2017. In the FAC, SCT accuses Google of infringing not only the challenged patents, but also the '749 patent, which Google has been on notice of since 2012 but has not challenged via IPR. *See id*. The FAC also alleges infringement of U.S. Patent No. 11,995,685 (the "'685 patent"), which Google has also not challenged via IPR or otherwise. *See id.*

III. SUMMARY OF ARGUMENT

Google has known of the inventions in the challenged patents since at least 2012, yet chose to commercialize infringing functionalities—*e.g.*, Nearby Share, Fast Pair, and Find Hub—without ever seeking a license or timely challenging validity. During more than a decade of awareness, Google repeatedly cited members of the same patent family in its own prosecution, reinforcing the parties' settled expectations that the claims are valid. Even now, Google seeks review of only three

of the five patents asserted against it, guaranteeing that the Western District of Texas must still adjudicate the validity of the related '749 and '685 patents.

The Petition's merits fare no better; Google simply repackages arguments based on substantially the same art the Examiner and prior IPR panels already considered –*e.g.*, Eagle, Behrens, Perttila, and Jones – adding only Olkkonen for a single limitation, without identifying any material error in the PTO's prior findings that the challenged claims are allowable over this art. *Advanced Bionics* and § 325(d) therefore compel denial.

IV. LEGAL STANDARD

35 U.S.C. § 314 provides the Director with discretion regarding whether to institute an IPR proceeding. *See Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) ("[T]he agency's decision to deny a petition is a matter committed to the Patent Office's discretion."); *SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 366 (2018) ("[Section] 314(a) invests the Director with discretion on the question whether to institute review . . . ."") (emphasis omitted); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.").

As discussed in the Interim Process Memo, among the criteria that the Director may consider in determining whether to exercise discretion to deny institution are "[s]ettled expectations of the parties," "[t]he strength of the

unpatentability challenge," and "[a]ny other considerations bearing on the Director's discretion."

In addition, 35 U.S.C. § 325(d) provides the Director with discretion to deny institution if the challenge to the patent involves the same or substantially the same prior art or arguments previously considered by the USPTO. *Advanced Bionics*, Paper 6 at 8. In such a situation, the petitioner must show that the USPTO erred in evaluating the art or arguments, and if a petition fails to do so, the Director may exercise her discretion not to institute. *Id.* Further, if reasonable minds can disagree regarding the purported treatment of the art or arguments by the PTO, then it cannot be said that the PTO erred in a manner material to patentability. *Id*., at 9.

V. THE DIRECTOR SHOULD EXERCISE DISCRETION TO DENY INSTITUTION UNDER THE INTERIM PROCESS MEMO.

Several facts support exercising discretion to deny institution of Google's IPR petition under the Director's Interim Process Memo. First, Google has been on notice of the challenged patent family since 2012, creating settled expectations. Second, even if Google's IPR challenges were successful, they would not resolve the entire dispute between SCT and Google, as Google has not filed an IPR petition against the '749 patent. Third, the merits of Google's unpatentability challenge are weak. For at least these reasons, the Director should exercise discretion to deny institution.

A. The Parties Have Settled Expectations Because of Google's Prior Knowledge of the Challenged Patents' Family

Google had knowledge of the challenged patents' family through Mr. Proctor's discussions with Google in November 2011 and February 2012. *See* Exs. 2001-2005. In addition, Google continued to evidence its knowledge of the challenged patents' family for many years through its repeated disclosure (and examiner citation) of members of the challenged patents' family in its own patent applications, including prosecution activity as recent as 2021. *See* Exs. 2006-2013. Until its currently pending IPR petitions, at no point during the thirteen years since Google learned of the challenged patents' family did Google contend any patents in the family were invalid or otherwise challenge the validity of any member of the family, through an IPR petition, other USPTO proceeding, or through a declaratory judgment action in district court. While the challenged patents issued in 2022 and 2023, the Director has recognized that settled expectations can result from a petitioner's knowledge of earlier patents in the same family as the challenged patents. *See Amazon.com, Inc. v. Audio Pod IP, LLC*, IPR2025-00757, Paper 15 at 2-3 (PTAB Aug. 14, 2025). Moreover, not only did Google cite (in its own patent prosecution) the family members Mr. Proctor expressly identified in his February 2012 correspondence with Google, but Google also cited a different family member in a 2021 IDS in one of its own patent applications that Mr. Proctor did not identify in his correspondence with Google. *See* Exs. 2006-2013.

Moreover, Google's knowledge of the challenged patents' family predates its development of the accused products and accused features in the parallel district court action. For example, based on publicly available information, Google's Nearby Share feature was not released until 2020, Google's Fast Pair feature was not released until 2017, and the precursor to Google's Find Hub feature was not released until 2013. *See* Exs. 2018-2020. In addition, the first Google Pixel smartphones (recent generations of which are accused products in the parallel district court action) were not released until 2016. *See* Ex. 2021. Thus, Google developed the accused products and accused features with full knowledge of the challenged patents' family but failed to either license the patents or challenge their validity in any manner.

Google's failures in this regard—and the settled expectations of the parties—thus favor exercising discretion to deny institution of Google's IPR petition.

B. Even if Successful, Google's IPR Petitions Will Not Resolve the Entire Dispute Between SCT and Google, Leaving the District Court to Decide Validity of the '749 and '685 Patents—An Inefficient Result

SCT's operative district court complaint accuses Google of infringing not only the three patents that are the subject of its pending IPR petitions, but also the '749 and '685 patents. Given the close relationship between the '749 and '685 patents and the challenged patents, it is not an efficient use of the Office's resources to consider Google's IPR petitions against the challenged patents when the district

court will still be left to consider the validity of the ’749 and ’685 patents. *See Amazon-Audio Pod*, Paper 15 at 3 (concluding that when “the district court will be considering the validity of [five related] patents . . . along with the validity of [an additional] patent . . ., referring [an IPR petition concerning the additional patent] to the Board would be an inefficient use of Board resources and tips the balance to discretionary denial as to that patent too”).

Further, Google has been aware of the ’749 patent since at least February 9, 2012, but chose not to challenge the validity of the ’749 patent via an IPR petition or otherwise. *See* Ex. 2004. Moreover, given that the ’749 patent has been in force since 2012, and Google has had knowledge of the patent family since then, any IPR petitions Google may file in the future regarding the ’749 or ’685 patents should be discretionarily denied institution. *See, e.g.*, *Dabico Airport Sols., Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2 (PTAB June 18, 2025); *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (PTAB June 6, 2025).

In sum, resolution of the IPR petitions would not resolve the validity issues before the district court because the district court would still have to decide the validity of the closely related ’749 and ’685 patents, significantly undercutting any efficiency rationale. As such, the Director should exercise discretion and deny institution of Google’s IPR petitions.

C. The Merits of Google's IPR Petition Are Weak

As will be detailed in SCT's forthcoming Preliminary Response, there are fundamental flaws in the merits of Google's IPR petition. The Director should exercise discretion to deny institution of Google's IPR petition for this reason as well.

VI. THE DIRECTOR SHOULD EXERCISE DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 325(d)

In addition, or in the alternative, the Director should exercise discretion and deny institution of Google's IPR petition under 35 U.S.C. § 325(d) because the same or substantially the same prior art was already considered during prosecution of the challenged patent. Google's IPR petition relies primarily on the Eagle and Behrens references (as well as the Perttila and Jones references), all of which were unquestionably considered by the Examiner during prosecution. *See* Ex. 1001. Moreover, as Google's IPR petition recognizes, the Eagle and Behrens references were the subject of earlier IPR petitions of other members of the challenged patent family—and the pleadings from those IPR proceedings were also unquestionably considered by the Examiner during prosecution. *See id.* Google's only reference that was not considered during prosecution was Olkkonen, which Google admits it only relies on for one limitation, *i.e.*, the "feature of using a service identifier for filtering." Pet. at 5.

Despite knowing that it was relying on previously considered references,

Google's IPR petition makes no effort to explain how its grounds do not present the same or substantially the same prior art as was considered during prosecution. Because Google's IPR petition relies on the same or substantially the same art that was previously considered during prosecution, it is incumbent upon Google to demonstrate that the Office erred in a manner material to the patentability of the challenged claims. *See Advanced Bionics*, Paper 6 at 8. Because Google has failed to do so, the Director should exercise discretion to deny institution under 35 U.S.C. § 325(d).

VII. CONCLUSION

For at least the reasons above, the Director should exercise discretion to deny institution of Google's IPR petition.

Dated: September 10, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Patent Owner's Brief in Support of Discretionary Denial was served September 10, 2025, to Lead and Back-up Counsel for Petitioner at the service address provided in Petitioner's Mandatory Notices:

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