

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner

v.

TELCOM VENTURES LLC,  
Patent Owner.

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Case No. IPR2025-01421  
U.S. Patent No. 10,674,432

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**PETITIONER'S OPPOSITION TO PATENT OWNER'S  
REQUEST FOR DISCRETIONARY DENIAL**

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EX1002	Declaration of Sandeep Chatterjee, Ph.D.
EX1003	Curriculum Vitae of Sandeep Chatterjee, Ph.D.
EX1004	Prosecution History of U.S. Patent App. No. 16/251,834
EX1005	U.S. Patent Application Publication No. 2009/0170483 A1 to Barnett et al. (“Barnett”)
EX1006	International Patent Publication No. WO 2006/087503 A1 to Waters et al. (“Waters”)
EX1007	U.S. Patent No. 7,434,723 to White et al. (“White”)
EX1008	International Patent Publication No. WO 2006/094048 A2 to Morrison (“Morrison”)
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EX1011	U.S. Patent Application Publication No. 2008/0140569 A1 to Handel (“Handel”)
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EX1013	U.S. Patent Application Publication No. 2010/0145850 A1 to Nagai et al. ("Nagai")
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EX1018	International Patent Publication No. WO 02/09005 A1 to Smith et al. ("Smith")
EX1019	U.S. Patent Application Publication No. 2007/0058734 A1 to Kao et al. ("Kao")
EX1020	U.S. Patent Application Publication No. 2005/0249177 A1 to Huo et al. ("Huo")
EX1021	IEEE Std 802.11a-1999
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EX1030	Lex Machina Patent Litigation Report 2025
EX1031	U.S. Patent No. 9,832,708 to Karabinis et al. ("the '708 patent")
EX1032	Prosecution History of U.S. Patent App. No. 15/251,882
EX1033	U.S. Patent Application Publication No. 2007/0243872 A1 to Gallagher et al. ("Gallagher")
EX1034	National Judicial Caseload Profile for the Eastern District of Texas as of June 30, 2025 (excerpted from the Federal Court Management Statistics), available at <a href="https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0630.2025.pdf">https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0630.2025.pdf</a>

**I. INTRODUCTION**

Several factors come together to strongly compel institution of an *inter partes* review here. As an initial matter, there is evidence that the Examiner committed a material error in issuing the '432 patent. This alone compels institution. Moreover, the challenged patent, U.S. Patent No. 10,674,432 (“the '432 patent”), issued in 2020, and thus there are no settled expectations for Patent Owner Telcom Ventures LLC. Indeed, Patent Owner did not meaningfully attempt to commercialize or otherwise assert the '432 patent or any related patents until bringing suit against Apple and Samsung (“Apple Litigation” and “Samsung Litigation,” respectively) in 2024. Petitioner Google LLC, who is not a party to either litigation, thus could not expect enforcement of the '432 patent, weighing against discretionary denial. In addition, the fact that Google is not a party to either litigation makes this IPR a particularly warranted vehicle to challenge the '432 patent—Google filed this IPR before Patent Owner initiated any lawsuit against Google, and, relatedly, it would be unfair to discretionarily deny this IPR given that Google may not benefit from any settlement in the Apple or Samsung Litigation.

For all of these reasons, Google requests that the Director institute review.

**II. THE EXAMINER'S MATERIAL ERROR SUPPORTS REFERRAL TO THE BOARD**

Referral to the Board is warranted because the Examiner committed a material error in allowing the '708 patent, from which each of the other six patents challenged

by Petitioner, including the '432 patent, descend.<sup>1</sup> As discussed below, the Examiner overlooked clear teachings of the Gallagher reference that disclose the alleged missing features that were the reason for allowing the '708 patent's claims. *See Activision Blizzard, Inc. v. Milestone Ent., LLC*, IPR2025-00708, Paper 13 at 2-3 (Director Aug. 14, 2025) (material error in prosecution of a parent patent pertaining to the reason for allowing the parent patent's claims weighed against discretionary denial in a proceeding involving a child patent); *see also Samsung Elecs. Co., Ltd. v. Wilus Inst. of Standards & Tech. Inc.*, IPR2025-00933, Paper 11 at 3-4 (Director Oct. 10, 2025) (examiner committed material error by overlooking certain teachings in Noh, a reference applied by the examiner but not cited in petitioner's grounds). Even if other factors may favor discretionary denial, "it is an appropriate use of Office resources to review the potential error." *Taiwan Semiconductor Mfg. Co. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 at 4 (Director Sept. 3, 2025) (referring challenge to the Board even though the ITC hearing on the challenged patent was scheduled nine months before the projected FWD date).

Patent Owner filed the application leading to the '708 patent on August 30, 2016. (EX1031, Cover.) In the first Office Action, the Examiner included

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<sup>1</sup> Patent Owner points to the Director's rejection of other material error arguments, but the material error discussed here has not been considered. DD Req. 15-16.

obviousness rejections, finding that the claims were unpatentable over U.S. Patent Application Publication No. 2003/0220105 (“Daigremont”) in view of U.S. Patent Application Publication No. 2007/0243872 (“Gallagher”). (EX1032, 60-63.) In particular, the Examiner found that Daigremont did not explicitly teach independent claim limitations requiring that the communication between the smartphone and entity using the *first air interface* (responsive to the proximity criterion being satisfied between the smartphone and entity over the short-range link) was performed *concurrently* with the communication between the smartphone and base station using the *second air interface* (to receive a communications service from the base station). (*Id.*, 61, 63.) The Examiner found that Gallagher, however, teaches the concurrent communication limitation of the independent claims because it teaches unlicensed-use and licensed-use communications systems (i.e., first and second air interfaces, respectively) in which both communications may be performed concurrently. (*Id.*, 61-62 (citing EX1033, ¶¶[0060]-[0062]).)

On June 27, 2017, the Examiner held an interview initiated by Patent Owner. (*Id.*, 95.) The Examiner offered very little information on the substance of the interview, other than noting that applicant “discussed and explained the invention of claim 1 to get clarification and addition[al] advisement” and that Examiner and applicant discussed “proposed amendments...to place the application in condition for allowance but [agreement] was not reached.” (*Id.*) On July 14, 2017, Patent

Owner filed amended claims, which crucially did not propose amendments to the original independent claims (claims 1 and 5), but did add additional independent claims containing the concurrent communication limitation . (*Id.*, 98-107.)

In remarks, Patent Owner argued that the final “wherein” recitation of independent claims 1 and 5, which recites the concurrent communication limitation, is not disclosed by Gallagher. (*Id.*, 110-11.) Patent Owner noted that in the interview, “[t]he Examiner did not wish to discuss the novelty and/or unobviousness of the final ‘wherein’ recitation of independent Claims 1 and 5.” (*Id.*, 108.) The Examiner then issued a notice of allowance, explaining simply that the independent claims were “allowed in view of Applicant’s arguments or remarks.” (*Id.*, 142.)

The Examiner does not appear to have performed a wholesome examination, as evidenced by the fact that the Examiner failed to summarize the interview, declined to discuss the “wherein” limitation during the interview, and then reversed course from his initial rejection and issued a notice of allowance for the ’708 patent without explaining why he now found Patent Owner’s reasoning with respect to the “wherein” limitation persuasive. Indeed, the Examiner overlooked explicit disclosures in Gallagher of concurrent communication via unlicensed and licensed communication systems (i.e., first and second air interfaces). The very first sentence of Gallagher discloses that “[s]ome embodiments provide a method and apparatus for seamlessly providing voice and data services across a licensed wireless network

*while* accessing a second different communication network through a user equipment.” (EX1033, Abstract (emphasis added); *see also id.*, ¶¶[0012], [0024] (same).) “The first and second communication networks include licensed wireless networks, [and] unlicensed wireless networks...to name a few.” (*Id.*, Abstract; *see also id.*, ¶¶[0012], [0024] (same).) Thus, Gallagher explicitly discloses concurrent communication across unlicensed and licensed first and second air interfaces.

In its remarks, Patent Owner pointed to Gallagher's disclosure that the “ICS architecture 100 enables user equipment (UE) 102 to access a voice and data network 165 via either a licensed wireless communications session 106 or an ICS access interface 110 through which components of the licensed wireless network 165 are alternatively accessed.” (EX1032, 110 (quoting EX1033, ¶[0032]).) But this disclosure simply describes two ways of accessing a single communication network, i.e., the licensed wireless (voice and data) network 165—that is, the disclosure only describes one air interface. Patent Owner's cited portion of Gallagher *does not* address Examiner's initial finding that Gallagher discloses concurrent unlicensed and licensed communications through two separate networks (i.e., first and second air interfaces). Moreover, Gallagher explicitly describes ICS access interface 110—one of two ways of accessing licensed network 165—as enabling concurrent communication over both a first and second communication network. (EX1033, ¶¶[0025] (“[T]he ICS of some embodiments seamlessly integrates and establishes

voice and/or data services of a licensed wireless device through an unlicensed communication network.”), [0030] (“[T]he user equipment can communicate over two different communication networks without requiring any changes.”), [0053] (“[T]he ICS implementation will allow the user equipment of the first communication network to remain unaltered while still being able to receive the benefits of communicating over the second communication network.”).) Accordingly, Gallagher clearly supports concurrent communication over separate unlicensed and licensed communication networks (i.e., first and second air interfaces).

The Examiner's error in analyzing Gallagher is especially troublesome because these sorts of teachings were well known in the art at the time of the '432 and '708 patents. For example, as discussed in Barnett, which Petitioner relies upon in all grounds of all seven petitions, it was well known that smartphones were capable of communicating concurrently via both a first air interface (e.g., unlicensed NFC communication) and a second air interface (e.g., licensed cellular communication or a Wi-Fi interface). Pet. 8-13, 19-31, 37-38, 41-44 (discussing Barnett's NFC, cellular, and Wi-Fi communication capabilities); *see also Google LLC v. Telcom Ventures LLC*, IPR2025-01408, Paper 1 ('708 Pet.) at 24-29 (Aug. 11, 2025) (discussing Barnett's concurrent communication over first and second air interfaces).

The issue with the prosecution of the '708 patent—whether the prior art discloses concurrent communication over first and second communication networks—is also relevant to the '432 patent, which recites limitations directed to communication over first and second air interfaces. (EX1001, claims 1-17.) In addition, there is evidence that the Examiner relied on his previous findings for older patents (including the '708 patent) when allowing the '432 patent. For example, the same Examiner examined the applications leading to the '708 and '432 patents (EX1004, 68; EX1032, 56), and when examining the application leading to the '432 patent, which has similar claims to other patents in the family, the Examiner's only obviousness rejections under 35 U.S.C. § 103 (which were overcome by amendment) did not specifically address the concurrent communication features common to the '708 and '432 patents (EX1004, 72-76, 169-78, 275-77). Referral of this Petition to the Board is appropriate in these circumstances.

### **III. SETTLED EXPECTATIONS WEIGH AGAINST DISCRETIONARY DENIAL**

The '432 patent is part of a family of eleven patents that are a continuation of U.S. Patent No. 9,462,411 (“the '411 patent”) and share the same specification. While the '411 patent issued in 2016, the continuation patents that are the subject of Petitioner's IPRs issued more recently. In fact, a majority involve patents that issued in the last two years. The following table identifies the patents challenged by Petitioner:

U.S. Patent No.	Application date	Issue date	Proceeding
9,832,708	August 30, 2016	November 28, 2017	IPR2025-01408
10,219,199	November 1, 2017	February 26, 2019	IPR2025-01419
<b>10,674,432</b>	<b>January 18, 2019</b>	<b>June 2, 2020</b>	<b>IPR2025-01421</b>
11,770,756	March 7, 2022	September 26, 2023	IPR2025-01409
11,924,743	October 8, 2023	March 5, 2024	IPR2025-01349
11,937,172	November 29, 2023	March 19, 2024	IPR2025-01389
12,028,793	December 13, 2023	July 2, 2024	IPR2025-01401

As Patent Owner acknowledges, one of the relevant inquiries with respect to “settled expectations” is the length of time the claims have been in force. DD Req. 8; *see also Interim Processes for PTAB Workload Management* at 3 (considering the “[s]ettled expectations of the parties, such as the length of time the claims have been in force”).<sup>2</sup> Here, five of the seven challenged patents issued less than six years ago, and a sixth patent issued just over six years ago in 2019. The ’432 patent has been in force only since 2020. Thus, Patent Owner lacks settled expectations with respect to these patents. *See Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*,

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<sup>2</sup> Settled expectations should not be considered in IPRs. *See Celgene Corp. v. Peter*, 931 F.3d 1342, 1361-62 (Fed. Cir. 2019); *see also* 5 U.S.C. § 706(2)(A). But if they are considered, settled expectations favor Petitioner here.

IPR2025-00433, Paper 11 at 2 (Director June 27, 2025) (“[M]ost of the challenged patents have not been in force for a significant period of time (issued in 2020, 2019, and 2019), and, accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial as to at least those patents.”).

Patent Owner argues that the issue date of the '411 patent (the oldest family member), which is not challenged by Petitioner, creates settled expectations as to later issued patents, including the '432 patent. DD Req. 8-10. But none of Patent Owner's five cited cases support that the '411 patent, or any related patents issued more than six years ago, creates settled expectations as to later issued patents. In four of these cases, *all* of the challenged patents had been in force for more than six years. *See Yangtze Memory Techs. Co., Ltd. v. Micron Tech., Inc.*, IPR2025-00498, Paper 11 at 2 (Director Aug. 14, 2025) (three challenged patents in force for six to ten years); *iRhythm Techs., Inc. v. Welch Allyn*, IPR2025-00363, Paper 10 at 3 (Director June 6, 2025) (five challenged patents in force for seven to thirteen years); *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2-3 (Director June 18, 2025) (single challenged patent in force for over eight years); *Samsung Elecs. Co., Ltd. v. Cerence Operating Co.*, IPR2025-00458, Paper 14 at 2 (Director June 25, 2025) (all three challenged patents in force for more than eleven years). And in the fifth case, discretionary denial was granted because five of the seven challenged patents had been in force for eight to twelve years, creating settled

expectations with respect to those five patents, and the Director held it would have been an inefficient use of the Board's resources to refer the IPRs challenging the other two challenged patents to the Board. *Samsung Elecs. Co., Ltd. v. iCashe, Inc.*, IPR2025-00639, Paper 11 at 2-3 (Director Aug. 14, 2025).

In other words, in each case Patent Owner cites, discretionary denial was granted where all or nearly all of the challenged patents had been in force for over six years, with the Director finding that had created settled expectations for Patent Owner with respect to those patents. That is not the case here, where the majority of challenged patents, including the '432 patent, issued within the last six years.

Moreover, Patent Owner's suggestion that earlier patents create settled expectations as to later patents is contrary to the Director's decisions. In fact, on several occasions, the Director has held that where a family of patents has both older and newer patents, all challenges to these patents should be referred to the panel if it is an "efficient use of Board resources" to address related patents. *See Embody, Inc. v. LifeNet Health*, IPR2025-00248, Paper 13 at 3 (Director June 26, 2025) (referring challenges to a three-year-old and seven-year-old patent to the Board); *see also Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00478, Paper 10 (Director July 31, 2025) (referring a challenge to a ten-year-old patent to the Board where IPRs involving two related four-year old patents had already been referred to the Board). Referring all of Petitioner's IPR petitions to the Board would

be an efficient use of Board resources because there is significant overlap between the asserted patents and each petition asserts similar prior art using similar grounds and arguments. Indeed, all seven of Petitioner's petitions exclusively raise obviousness grounds based on Barnett, either alone or in combination with similar references in the same field of art, such as Waters, White, and Smith.

Patent Owner acknowledges that the '432 patent has only been in force since 2020, and instead suggests that Patent Owner has settled expectations because the Office has consistently issued patents in the family since 2016 while patents remained unchallenged until 2025. DD Req. 9-10. Patent Owner offers no support for this argument. Indeed, it is unsurprising that the patents remained unchallenged for many years when Patent Owner has not contended that the patents were ever "commercialized, asserted, marked, licensed, or otherwise applied in [Petitioner's] particular technology space." *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasy, Inc.*, IPR2025-00438, Paper 10 at 3 (Director July 17, 2025). Patent Owner merely argues that it has "invested a significant amount of time and resources into [prosecuting] this family of patents" (DD Req. 9-10) and has accused products in the Samsung Litigation and Apple Litigation that are allegedly directed to similar technologies as Patent Owner's patent applications (*id.* at 11). Patent Owner does not contend it ever sent a demand letter to anyone or made any efforts to commercialize, assert, mark, license, or apply the '432 patent in Petitioner's technology space until it filed

lawsuits against Samsung and Apple in 2024. The Director has held that Patent Owner's failure to commercialize, assert, mark, license, or apply challenged patents in Petitioner's particular technology space weighs against Patent Owner's claim of settled expectations. *Shenzhen*, IPR2025-00438, Paper 10 at 3.

Further weighing against Patent Owner's claim of settled expectations is Petitioner's activity in the technology space that Patent Owner is now asserting its patents against. Petitioner launched its first Google Wallet in 2011, but Patent Owner did not begin asserting the '432 patent or related patents against other players in the mobile payment space until thirteen years later. Thus, Petitioner could not have expected enforcement of the '432 patent or related patents. *See, e.g., Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 at 3 (Director Sept. 5, 2025) (petitioner did not expect enforcement of challenged patent because of patent owner's delay in asserting the patent in litigation, which weighed against discretionary denial).

#### **IV. PETITIONER IS NOT A PARTY TO THE PARALLEL LITIGATION**

Petitioner's lack of expectation of enforcement is underscored by the fact that Petitioner is not a Defendant in either the Apple or Samsung Litigation. The Director has held that when a petitioner is not a defendant in the parallel proceedings, that factor weighs against discretionary denial.

In *Multi-Color Corp. v. Brook & Whittle Ltd.*, PGR2025-00025, Paper 10 at 2 (Director July 16, 2025), the Director referred the challenged patent to the Board, despite the fact that the patent was at issue in two district court proceedings, at least one of which had a scheduled trial date four months before a final written decision (“FWD”) would be due. The petitioner was not a party to either proceeding and no trial date had been scheduled in the second parallel proceeding, both of which weighed against discretionary denial. *Id.* The present proceeding presents a very similar set of facts. The ’432 patent is at issue in the Samsung Litigation and Apple Litigation, and Petitioner Google is not a party to either proceeding. While the Samsung Litigation has a trial date scheduled for June 1, 2026, before the statutory deadline for the Board to issue a FWD in this IPR, there is no trial date set in the Apple Litigation. (EX2005, 1.) As discussed below (*see infra* Section VI), Petitioner disputes that trial in Samsung Litigation will occur by June 1, 2026, but even if the trial proceeds as scheduled, these factors weigh against discretionary denial because Petitioner is not a party in either the Apple or Samsung Litigation.

In another similar case, *Posco Co., Ltd. v. Arcelormittal*, IPR2025-00370, Paper 10 at 2 (Director June 25, 2025), the Director referred the challenged patents to the Board, despite a parallel International Trade Commission (“ITC”) investigation, in part because the petitioner was not a party in the ITC investigation. The Director noted that the ITC investigation would have completed nine months

before a FWD and that the parties had already made a substantial investment in the ITC proceeding, but found that the petitioner not being a party to the ITC investigation weighed against discretionary denial. *Id.* Instead, petitioner's customer was the party to the ITC proceeding. *Id.* Here, Patent Owner represents that the parties, the Court, and Petitioner Google have made "substantial investments" in the Samsung Litigation. DD Req. 18-19. Petitioner disputes that any substantial investments have been made in the Apple or Samsung Litigation (*see infra* Section VI), but even assuming such substantial investments, the fact that Petitioner is not a party to either litigation weighs against discretionary denial.

Patent Owner argues that Petitioner is "effectively" a party in the Samsung Litigation because Samsung phones that incorporate Google's technology are accused of infringement, counsel from the same law firm have entered appearances, and Petitioner has been subpoenaed for relevant documents and information pertinent to Patent Owner's claims in the Samsung Litigation. DD Req. 19-20. But Patent Owner does not and cannot dispute that Petitioner is not a party to the Samsung Litigation. *Id.* at 1-2, 18-20. Under these circumstances, it would be manifestly unjust to discretionarily deny this IPR based on the Samsung Litigation. Approximately 90% of district court patent cases are resolved through settlements or procedural rulings rather than on substantive grounds. (EX1030 at 18 ("In district court non-ANDA patent cases terminated in the past three years, about 90% were

resolved through settlements or procedural rulings rather than on substantive grounds.”.) Thus, if Petitioner’s challenges to the ’432 patent and related patents are discretionarily denied, there is a high chance that Petitioner will be bound to the outcomes of two proceedings which not only fail to provide Petitioner with an opportunity to present its invalidity theories in court, but may not involve any invalidity decisions at all.

Patent Owner also suggests that instituting Petitioner’s IPR petition would lead to “duplication of efforts” and “would frustrate the intended efficiencies of the AIA.” DD Req. 13-15. But Patent Owner provides no authority to support that the Board is duplicating efforts by considering challenges to the ’432 patent by a Petitioner who is not a party to any of the parallel proceedings. Nor is Patent Owner able to explain how the AIA’s “intended efficiencies” include an intent to bind a non-party to the invalidity decisions of parallel proceedings.

#### **V. PETITIONER’S USE OF EXPERT TESTIMONY DOES NOT SUPPORT DISCRETIONARY DENIAL**

Patent Owner asserts that Petitioner uses expert testimony to “fill in the gaps of the prior art,” but Patent Owner fails to identify any gaps in the prior art or portions of expert testimony that are used to fill such gaps. DD Req. 11-13. Patent Owner points to the Petition’s citation of Dr. Chatterjee’s declaration for statements such as “[a] POSITA would have understood,” “[a] POSITA would have been motivated to incorporate,” and “[a] POSITA would have also been motivated,” but

Patent Owner makes no attempt to explain how these statements indicate there are gaps in the prior art. *Id.* at 12-13. Petitioner relies on Dr. Chatterjee's testimony (EX1002, ¶¶51-145) only to explain the background knowledge of a person of ordinary skill in the art and the motivations to combine and modify, supported by citations to evidence as required. *See* 37 C.F.R. § 42.65(a); *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (P.T.A.B. Aug. 4, 2022) (precedential).

Patent Owner also suggests that the expert declaration "lacks focus" because it uses similar headings as those used in the Petition and addresses each limitation. DD Req. 12. To the contrary, Dr. Chatterjee's declaration demonstrates focus by providing clear headings that allow for easy reference between the Petition and expert testimony. While Dr. Chatterjee addresses each limitation of each claim, his declaration still provides a focused analysis of the prior art's disclosures of those claim limitations, weighing against discretionary denial.

## VI. THE *FINTIV* FACTORS FAVOR INSTITUTION

The factors enumerated in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (precedential) further confirm that the Petition should be instituted.

The **third factor (investment)** and **fifth factor (parties)** favor institution. As discussed above (*see supra* Section IV), Petitioner is not a party to any pending litigation, and thus there cannot be any substantial investment in any litigation

between Patent Owner and Petitioner. Even if the parties to the Apple or Samsung Litigation had made significant investments, the Director has held that a petitioner not being a party to these parallel proceedings weighs against discretionary denial. *Multi-Color*, PGR2025-00025, Paper 10 at 2; *Posco*, IPR2025-00370, Paper 10 at 2.

The **fourth factor (overlap)** favors institution because there is no substantial overlap between the current Petition and the Apple or Samsung Litigation. As Patent Owner appears to concede, none of the prior art presented in the Petition is asserted in the Apple Litigation. DD Req. 19. Patent Owner also appears to acknowledge that neither Petitioner's primary reference, Barnett (EX1005), nor one of Petitioner's secondary references, White (EX1007), is asserted in the Samsung Litigation. DD Req. 19. These two references are central to the Petition, which includes both Barnett and White in all asserted grounds (indeed, Barnett is included in all grounds in all seven IPRs filed by Petitioner, increasing the efficiencies associated with institution). *See* Pet. 8-74. As such, there is no substantial overlap between the issues raised in the Petition and those raised in the Apple or Samsung Litigation.

The **sixth factor (merits)** also favors institution as the merits of Petitioner's arguments are compelling. Indeed, the Petition raises new invalidity grounds not raised in either the Apple or Samsung Litigation, using prior art that was not considered by the Examiner for any of the seven patents challenged by Petitioner.

The **first factor (stay)** and **second factor (trial)** are at best neutral, but even if they weighed in favor of discretionary denial (*see* DD Req. 6-8, 16-18), the Director has referred challenges to the Board—even where a parallel proceeding's trial date is before the projected FWD date—because of circumstances such as (a) the trial date being set in only one of two parallel proceedings; (b) the petitioner not being a party to the parallel proceedings; and (c) a material error committed by the examiner in prosecuting the challenged patent. *See supra* Sections II, IV. Each of these is true here.

First, while a June 1, 2026 trial date is set in the Samsung Litigation, it is not clear the trial will occur before a FWD is issued for this IPR. The most recent 12-month data available for the Eastern District of Texas shows that the median time to trial in civil cases is 25.1 months, and the data shows that the median time to trial has increased in recent years. (EX1034, 1.) Moreover, no trial date is set in the Apple Litigation, and Apple currently has a motion to stay the Apple Litigation proceeding pending in the Northern District of California, where such motions are frequently granted even before institution. *See, e.g., Dialect, LLC v. Google LLC*, No. 24-cv-04388-JSC, 2024 WL 4314206, at \*4 (N.D. Cal. Sept. 26, 2024); *Apple Inc. v. AliveCor, Inc.*, No. 22-cv-07608-HSG, 2023 WL 9187388, at \*4 (N.D. Cal. Dec. 29, 2023); *see also Telcom Ventures LLC v. Apple, Inc.*, No. 3:25-cv-05041-RFL, Dkt. No. 105 (N.D. Cal. Oct. 10, 2025). The Director has found that a trial

date not being scheduled in a second parallel proceeding weighs against discretionary denial, even where the trial date in the first proceeding is scheduled before the FWD due date. *Multi-Color*, PGR2025-00025, Paper 10 at 2.

Second, even more critically, and as discussed above (*see supra* Section IV), Petitioner is not a party to either the Apple or Samsung Litigation, which also weighs against discretionary denial, even where the trial date is scheduled before the FWD due date. This is especially so here given, as also discussed above (*see supra* Section II), the Examiner made a material error in examining the '708 patent from which the '432 patent depends, and such circumstances warrant referral to the Board to review potential errors, even where a parallel proceeding trial is scheduled before the projected FWD due date.

Thus, the *Fintiv* factors favor institution, and provide an additional reason why the Director should refer the Petition to the Board.<sup>3</sup>

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<sup>3</sup> 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.

**VII. CONCLUSION**

Google respectfully requests institution.

Respectfully submitted,

Dated: November 19, 2025

By: /Naveen Modi/  
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Counsel for Petitioner

**CERTIFICATE OF SERVICE**

I hereby certify that on November 19, 2025, I caused a true and correct copy of the foregoing Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and supporting exhibits to be served by electronic means on the counsel identified below:

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