

Nos. 2024-1600, 2024-1601, 2024-1602, 2024-1603, 2024-1604, 2024-1605

United States Court of Appeals for the Federal Circuit

CAROLYN W. HAFEMAN,
Appellant

v.

GOOGLE LLC, MICROSOFT CORPORATION,
Appellees

Consolidated Appeals from the United States Patent and Trademark Office,
Patent Trial and Appeal Board in Nos. IPR2022-01188, IPR2022-01189,
IPR2022-01190, IPR2022-01191, IPR2022-01192, IPR2022-01193.

CAROLYN W. HAFEMAN'S OPENING BRIEF

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REPRESENTATIVE PATENT CLAIMS AT ISSUE ON APPEAL

U.S. Patent No. 10,325,122, Claim 1

1. A method for displaying information to assist with returning a computer comprising the steps of:

activating a processor to display on a display screen on the computer which displays information concerning return information for returning the computer to an owner from data stored in a memory of the computer, the screen displaying return information before or with a lock screen, to facilitate return of the computer and which is maintained on or before or with the lock screen so the return information is visible to anyone viewing the display screen, the lock screen locks the display screen and protects the computer;

initiating or changing return information which appears on the display through remote communication without assistance by a user with the computer, wherein the changing of the return information is done through an interactive program stored in the memory of the computer which is remotely accessed only by the owner of the computer or the party authorized by the owner to enable the initiating or changing of the display screen;

displaying the screen before or with a security prompt which prevents the user from accessing operatively the computer; and

activating the processor to allow a message to the user.

U.S. Patent No. 10,789,393, Claim 1

1. A method for displaying information to assist with returning a computer comprising the steps of:

activating a processor to display on a display screen on the computer which displays information concerning return information for returning the computer to an owner from data stored in a memory of the computer;

initiating or changing return information which appears on the display through remote communication without assistance by a user with the computer, wherein the initiating or changing of the return information is done through an interactive program stored in the memory of the computer which is remotely

accessed only by the owner of the computer or the party authorized by the owner to enable the initiating or changing of the display screen;

displaying the screen before or with a security prompt which prevents the user from accessing operatively the computer; and

activating the processor to allow a message to the user.

U.S. Patent No. 9,892,287, Claim 1

1. A method for displaying information to assist with returning a computer comprising the steps of:

activating a processor to display on a display screen on the computer which displays information concerning return information for returning the computer to an owner from data stored in a memory of the computer, the screen displaying recovery information, to facilitate return of the computer so the return information is visible to anyone viewing the display screen;

initiating or changing return information which appears on the display through remote communication without assistance by a user with the computer, wherein the changing of the return information is done through an interactive program stored in the memory of the computer which is remotely accessed only by the owner of the computer or the party authorized by the owner to enable the initiating or changing of the display screen;

displaying the screen before or with a security prompt which prevents the user from accessing operatively the computer; and

activating the processor to allow a warning message to the user.

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 24-1600, 24-1601, 24-1602, 24-1603, 24-1604, 24-1605

Short Case Caption Hafeman v. Google LLC

Filing Party/Entity Carolyn W. Hafeman, Appellant

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Name: Lawrence M. Hadley

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<p>Carolyn W. Hafeman</p>		

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4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

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None/Not Applicable Additional pages attached

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STATEMENT OF RELATED CASES

Pursuant to Fed. Cir. R. 47.5, counsel for Carolyn W. Hafeman provides as follows: (a) No other appeal in or from the same civil action or proceeding in the lower court or body was previously before this or any other appellate court; and (b) The Court's decision in this appeal may directly affect or be directly affected by the following pending case: *Carolyn W. Hafeman v. LG Electronics Inc.*, No. 6:21-cv-00696-ADA (W.D. Tex.).

PRELIMINARY STATEMENT

Carolyn W. Hafeman is a trailblazing female inventor who pioneered the “Find My Device” technology found in virtually every smartphone, laptop, tablet, and personal computer sold today. Hafeman has 11 patents on her inventions in the United States and Europe, including the three patents at issue in this appeal (U.S. Patents Nos. 10,325,122 (“122 patent”), 10,789,393 (“393 patent”), and 9,892,287 (“287 patent”), together the “Challenged Patents”).

In December 1996, Hafeman formed a company called World Computer Security Corporation. The company sold all types of products to help prevent computer theft, including recovery labels, alarms, and steel cables. At that time, studies showed that over 600,000 laptops were stolen annually, and the owner had only a three percent chance of recovery.

At a June 1999 trade show in San Diego, Hafeman envisioned a new computer security product. Her envisioned product would display a message instructing a person in possession of a lost or stolen computer how to return it to its rightful owner. The message could include the owner’s name and contact information. The message would be displayed and updated *without any assistance* from the person holding the device—not even requiring that the person touch a key or connect to the Internet—because the person could be a thief. Equally important, the message would be displayed *before* the password screen, so the device’s data was protected.

By 2002, Hafeman had documented her idea, filed her first patent application, and began creating a product implementing her vision that could be installed on devices and servers. This was a significant challenge given the requirement that the person possessing a lost or stolen computer had to see the most current owner information message without logging in (giving full access to the computer's contents) and connecting to a network. After several years of work, Hafeman completed a working software product in March of 2007. The new software program would allow the remote device to have continuous communication with a remote server via an interactive program and *before* the user satisfies any password or security prompt. The software could remotely communicate with a server by simply turning on the device—*before* the entry of any password or user-directed action. Hafeman named her product “The Retriever,” and in May 2007, she formed a new company, Front Door Software, to bring it to market.

The Retriever was a huge success. Hafeman sold The Retriever to customers in government, corporate, healthcare, and education, including dozens of major universities who made the product available to their students. It also proved popular with individual computer owners through sales at retail stores such as Staples and Office Max. The Retriever received rave reviews from the press and public for its ability to display a message to aid in the return of lost or stolen computers.

But like many products at the time, maintaining market share proved difficult

once major tech companies figured out how to provide the same technology and offer it for free as part of their device sales. Google introduced its “Find My Device” application for Android smartphones in 2013, and Microsoft followed suit for Windows computers in 2015. While Front Door Software’s revenues dramatically diminished, the U.S. Patent Office began issuing Hafeman’s patents.

In 2021, Hafeman sued LG Electronics, Inc., a major customer of both Google and Microsoft, for patent infringement in the U.S. District Court for the Western District of Texas. One year later, Google and Microsoft responded with six IPRs and identified LG as a real party-in-interest. The PTAB granted institution in all six IPRs, basing its decision on a priority date issue of the Challenged Patents and a “*Sotera*” stipulation made by LG and submitted by Google and Microsoft to the PTAB.

In the stipulation, LG promised not to raise in district court any invalidity defenses asserted in the IPRs. LG did just the opposite, violating its *Sotera* stipulation. The district court *agreed* that the stipulation was violated. Hafeman informed the PTAB and argued that the IPRs should be terminated. But the PTAB refused to terminate the IPRs or even *address* the violation in its Final Written Decisions (“FWDs”).

Aside from ignoring the *Sotera* violation, the PTAB made two reversible errors in the FWDs invalidating all claims of the Challenged Patents.

First, the PTAB erred in applying an implicit construction of “initiating or

changing return information which appears on the display through remote communication *without assistance by a user* with the computer”—a limitation found in each of the Challenged Patents—as *excluding* user-initiated communications with a remote computer. In contrast to the implicit construction, the Challenged Patents throughout describe the claimed improvement as initiating or changing return information *without* user assistance, including establishing communications with a remote computer. Thus, “without assistance by a user” *includes* the establishing of remote communication with a computer.

Second, under the legally correct meaning of “without assistance by a user,” the PTAB erred in finding that the Jenne/Cohen combination disclosed “all elements” of the Challenged Claims. The Jenne/Cohen combination expressly requires that a user first establish an Internet connection before receiving any updates from a remote computer.

Third, the PTAB erred in rejecting the strong objective indicia of nonobviousness of the Challenged Patents, including praise, market success, and copying by others. In large part, the PTAB refused to consider the indica of non-obviousness as it found no nexus between the Challenged Claims and The Retriever. But the specification uses the term “The Retriever” synonymously with the invention and no fewer than 34 times to describe the invention. LG even admitted to the district court that The Retriever practiced the claims.

This Court should reverse, or alternatively, vacate and remand.

JURISDICTIONAL STATEMENT

This appeal arises from six IPRs filed by Google LLC and Microsoft Corporation, challenging all claims of three patents owned by Hafeman: U.S. Patents Nos. 10,325,122, 10,789,393, and 9,892,287. Two IPR petitions were filed against each of the three patents. Appx7896, Appx8863, Appx9642, Appx10017, Appx10853, Appx11238. The PTAB asserted jurisdiction under 35 U.S.C. §§ 314(a), 318(a). Appx8094, Appx9020, Appx9803, Appx10173, Appx11015, Appx11393. The PTAB consolidated the two IPRs against each patent and issued three FWDs on January 23, 2024. Appx1, Appx37, Appx76. Hafeman timely appealed on March 25, 2024. Appx8538, Appx9145, Appx9972, Appx10302, Appx11194, Appx11518. This Court has jurisdiction under 28 U.S.C. § 1295(a)(4)(A) and 35 U.S.C. §§ 141(c), 319.¹

ISSUES PRESENTED

1. Whether the PTAB's failure to address the violation of the *Sotera* stipulation, as the district court found, in the FWDs and its refusal to terminate the IPRs based on the violation, were arbitrary, capricious, contrary to law, or otherwise

¹ Throughout this brief, Hafeman mainly cites to documents in the first two IPRs (IPR2022-01188, -01189), but the records in the six IPRs are substantially similar.

inconsistent with reasoned decision-making, particularly when the PTAB expressly relied on the *Sotera* stipulation as a basis to grant institution.

2. Whether the PTAB erred in implicitly construing “without assistance by a user” to *exclude* establishing communications between a lost or stolen computer with a remote server, when the specification describes the claimed improvement as an owner’s ability to initiate or change return information *without* a user doing *anything* other than turning on power.

3. Whether, under the legally correct meaning of “without assistance by a user” as *any* assistance, including the user establishing communications between a lost or stolen computer with a remote server, the Jenne/Cohen combination, which requires the user to establish an Internet connection, discloses this limitation.

4. Whether the PTAB erred in rejecting secondary considerations of non-obviousness, including praise, commercial success, and copying, based largely on the PTAB finding a lack of nexus between the Challenged Claims and Hafeman’s The Retriever product, even though the specification uses the term “The Retriever” synonymously with the invention and LG represented to the district court that The Retriever product practiced the Challenged Claims.

STATEMENT OF THE CASE

I. THE PATENTED TECHNOLOGY AND ITS ABILITY TO “INITIATE” OR “CHANGE” RETURN AND RECOVERY INFORMATION “WITHOUT USER ASSISTANCE”

This appeal concerns three of Hafeman’s patents (the ’122, ’393, and ’287 patents, together the “Challenged Patents”). The Challenged Patents share a common specification, and for purposes of this appeal, each recites substantially similar claim language.²

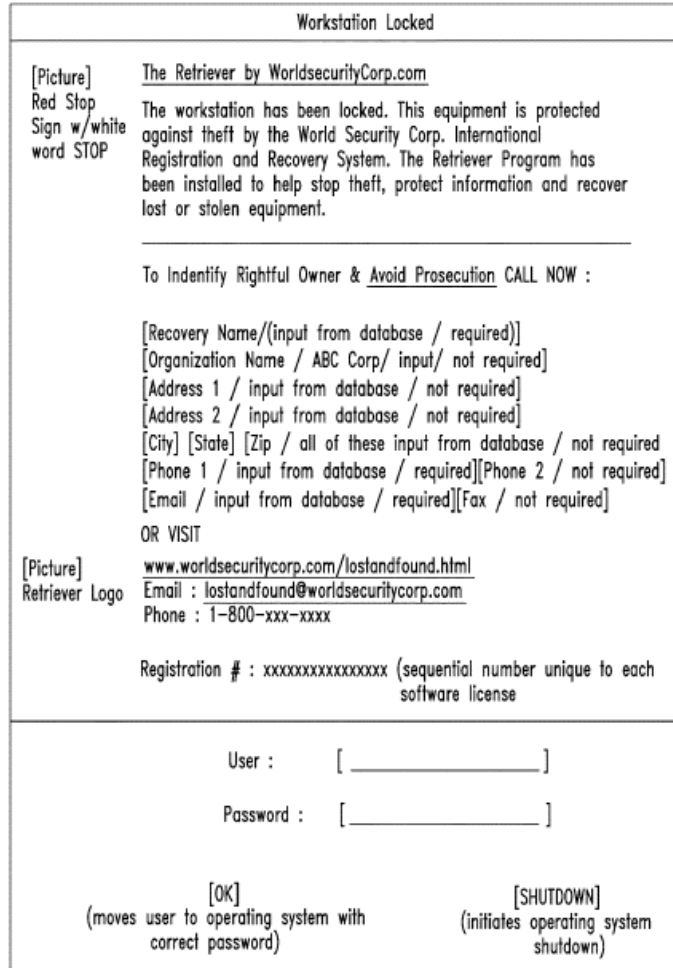
Prior to Hafeman’s inventions in the Challenged Patents, there were a number of “computer return or recovery products” on the market, including “physical labels,” “computer programs” using the “computer’s modem,” “Bios Based Password Identification systems,” and the personal digital assistant (PDA) recovery system. Appx125-26 (1:30-3:26). However, all of these had deficiencies that enabled a user to circumvent the return of the computer to the owner. Physical labels with return information could be defeated by simply removing the label, and could “not be interactively changed by the owner.” Appx125 (1:35-65). Modem-based programs would not work when the device lacked Internet access, and would not generally display return information. Appx125 (2:1-57). Bios-based systems could be defeated by removing the hard drive and installing it in a different computer, and

² In this brief, Hafeman cites to disclosures in the ’122 patent, but these same disclosures are in the ’393 and ’287 patents.

generally did not display return information. Appx125-26 (2:57-3:26). The PDA program gave control to the assigned-to individual, making it impossible for the owner of the device (*e.g.*, the individual's company) to regain control if the individual was disgruntled or uncooperative. Appx130 (11:63-12:6).

The Challenged Patents solved these, and other, problems in the prior art. They recognized that, in many situations, a device can have both an "Owner," and a "user." Appx126 (4:42-61). "The Owner has greater control over the computer 12 than the user." *Id.* The "owner" could be "a company that owns the computer 12," while the "user" could be "an employee of [the] company," to whom the computer is assigned. *Id.* The owner is "the person or entity that owns, rents, or licenses" the device, while the "user" is the person in current possession of it. *Id.*

The owner is "prompted to provide some recovery/return information that the owner would like displayed; for example, contact name, phone and email information." Appx128 (8:37-47). Using that information, the software "create[s] [a] recovery/return display 18 screen," such as the one shown in Fig. 2 below:



Appx116 (Fig. 2). This return/recovery screen is displayed during “the initial start up program of the computer 12, so that the recovery/return display 18 information [is displayed] during or before a password or security prompt screen.” Appx127 (6:20-36). Such pre-login (or during-login) display “ensures that the person finding the equipment will see the owner recovery/return information,” because “[i]f the program initiated after the password or security prompt screen, the person finding the lost or stolen equipment would have difficulty ever seeing the recovery/return display.” Appx128 (7:18-27).

As the Challenged Patents explain, “one of the most important and critical differences between the Retriever and the existing programs is the type of communication ... made possible with the Retriever.” Appx131 (13:16-20). In prior art systems, the user could change or update recovery information directly on the device. Appx131 (13:27-33). But if the device was lost or stolen—for instance, by a “disgruntled employee”—this would be useless. Appx131 (13:35-65). The person in possession of the device could simply list his own contact information as the proper “return” information, thwarting any attempt by the owner to recover the device. *Id.*

The Challenged Patents solved this problem by allowing the owner to control and change the return information from “an administration program ... [on] a computer 12 that is *completely remote* from the protected equipment.” *Id.* This “very unique and important feature ... allows the ‘owner’ to ... initiate a download of changes to the protected equipment, control the entire recovery screen displayed, and even override the ‘assigned to’ person’s input.” *Id.* This is because the protected equipment automatically establishes a connection with the owner’s recovery center *without any assistance by the user*. Such communication can be achieved by any suitable means, including “phone line ... cable, wi-fi, Bluetooth, satellite, etc.” *Id.* Such communication “allows the owner to eliminate erroneous or misleading ‘assigned to’ recovery information that might have been created by the rogue

‘assigned to’ individual” and “replace the display 18 screen with correct owner recovery information.” *Id.*

This communication capability gave the Challenged Patents an “on the fly ability to change owner recovery information.” Appx127 (6:9-10). This is extremely valuable for people who frequently change locations. Appx127 (6:11-19). For example, the Challenged Patents allow an owner who is traveling to change their return/recovery information at any time. *Id.*

Consistent with the specification’s description of this central improvement, the Challenged Patents all recite this feature as a claim limitation: the initiating or changing of the owner’s return/recovery information is done “without assistance by a user with the computer.” Appx132-33 (claims 1, 4, 7). The intrinsic record describes that, once the computer is powered on, the return/recovery information can be initiated or changed remotely without any input or action by the user, including any user input to connect to the Internet. This is because the computer automatically connects with the recovery center simply by being turned on. This makes complete sense, as a Good Samaritan or thief will likely not know the password and be unable to connect the device to the Internet, but the owner is still able to change their return/recovery information in such situations.

In Figure 3, the return/recovery dialog box appears on the monitor’s display screen before or simultaneously with any password or security prompt dialog box

(i.e., prior to the user pressing any key to enter a password). Appx117 (Fig. 3). The specification teaches that “[e]ach computer security program will attempt to display the recovery information on the initial screen when possible.” Appx128 (7:34-35). The invention offers a “unique communication power” that can “synchronize the international recovery center information” and “seize[] control of the display 18 monitor” before or with a security prompt. Appx131 (14:16-40). The Challenged Patents’ “back and forth” communication capability is a “critical” aspect of the invention because if the user does not know the password, then the return/recovery information would not be visible. Appx128 (8:34-36), Appx131 (13:17-27).

II. THE IPR AND DISTRICT COURT PROCEEDINGS

A. Hafeman Files Suit Against LG, and Google and Microsoft File Six IPRs Against Hafeman.

Hafeman filed suit against LG for patent infringement of the Challenged Patents on July 2, 2021. Appx4734. The suit progressed as the parties completed *Markman* proceedings, conducted fact discovery, and briefed a motion to dismiss. Appx4576, Appx4713-19, Appx4720. Over one year after the lawsuit was filed, on July 8, 2022, Google and Microsoft filed six IPR petitions at the PTAB, two petitions against each of the Challenged Patents. Appx7891, Appx7981. Google and Microsoft contended that the filing of two petitions against each Challenged Patents was “justifie[d]” because of a “priority dispute between the parties.” Appx7892. Each IPR petition identified LG as a real party-in-interest. Appx7979.

The six IPRs fall into two buckets. In the first bucket (IPR2022-01189, -01190, and -01192), Google and Microsoft attacked the priority date of the Challenged Patents and ranked the priority date issue first for consideration by the PTAB. Appx7894. In substance, Google and Microsoft argued that Hafeman was not entitled to her September 20, 2004, priority date because her application for her first-issued patent (Hafeman’s Application No. 10/945,332) allegedly lacked written description support for the limitation “initiating ... through remote communication.” Appx8883. Google and Microsoft alleged November 22, 2013—the filing date of Hafeman’s U.S. Patent No. 9,021,610—as the priority date. Appx8891. With the alleged November 22, 2013, priority date, Google and Microsoft asserted Hafeman’s own original patent application as “prior art,” arguing the original application disclosed the Challenged Claims. Appx8870. Google and Microsoft’s argument thus focused the first three IPRs exclusively on the priority date issue, Appx9132, Appx9140, and the PTAB agreed in the institution decisions, declining to analyze the asserted combinations. Appx9037, Appx9039. In the second, lower-ranked bucket (IPR2022-01189, -01191, and -01193), Google and Microsoft assumed the September 20, 2004, priority date and asserted prior art based on that date, including the Jenne and Cohen references. Appx7894, Appx7903-04.

Throughout the litigation, Google and Microsoft worked in close coordination with LG by sharing attorneys, exchanging documents, and providing witnesses to

each other. Appx8026-29. Hafeman further alleged that Google and Microsoft were indemnifying LG, and such allegation was never disputed. Appx8026. The PTAB acknowledged that “Google and Microsoft are standing in LG’s shoes.” Appx8100.

B. LG Files a *Sotera* Stipulation, Four Months After Filing the IPRs.

In the IPR petitions, LG, Google, and Microsoft offered no *Sotera* stipulation. Appx7976-78. In a *Sotera* stipulation, a party stipulates not to pursue in district court the same grounds or any grounds that could have been raised in the IPR. Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022), at 3 (“Interim Procedure”). Without a stipulation, LG expressly used and incorporated the IPR grounds in its final invalidity contentions in district court, despite the pending IPRs filed “in LG’s shoes.” Appx4750, Appx8100. Indeed, LG’s contentions included thousands of pages of claim charts using the IPR references. Appx4795-6999. As the IPRs progressed, LG continued to use the IPR grounds and references in district court, including in a motion for summary judgment, Appx7076, and in its requests for admission, Appx7111-13 (“Admit that ... ‘Cohen’ ... depicts a computer with a screen displaying Return or Recovery Information with a Security Prompt.”).

In early November 2022, Hafeman filed her IPR preliminary responses. Appx7997. Hafeman argued, among other things, that institution should be denied under the PTAB’s *Fintiv* precedent because there had been significant investment in

the same validity issues before the district court, and trial was scheduled for less than two months from the institution deadline (and ten months before any final written decision). Hafeman further showed the substantial overlap between the IPRs and LG's invalidity defenses. Appx8018-31. Hafeman explained that Google and Microsoft sought to re-litigate claim construction issues that had already been decided in district court. Appx8025-26. Finally, Hafeman argued that institution should be denied because no "*Sotera*" stipulation had been entered. Appx8022-23.

Attempting to save the IPRs, LG, Google, and Microsoft formed a plan. On November 30, 2022, with trial quickly approaching, LG belatedly sent Hafeman a *Sotera* stipulation. Appx4375. Despite the extensive invalidity litigation that had already taken place, LG claimed it "will not pursue in [this litigation] 'any ground that Google or Microsoft raised or reasonably could have raised' during the instituted IPRs." Appx4375. The PTAB granted Google and Microsoft's request to submit LG's stipulation and file supplemental briefing on the issue. Appx8066. Hafeman opposed the use of an untimely *Sotera* stipulation, arguing that the district court trial would begin within a few months. Appx8085-86. Hafeman further demonstrated that the *Sotera* stipulation was a sham—LG's invalidity expert, Dr. Sandeep Chatterjee, had submitted an expert report advancing the IPR grounds, including the Jenne/Cohen combination, even *after* LG sent the stipulation. Appx7176-78, Appx7182-85, Appx7458.

C. The PTAB Grants Institution Based on the *Sotera* Stipulation and the Priority Date Issue.

On January 31, 2023—after the completion of all fact and expert discovery in the district court and with trial less than two months away—the PTAB granted institution in all six IPRs. Appx8094. The PTAB found that LG’s *Sotera* stipulation “mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB.” Appx8100. The PTAB also found that two petitions against each Asserted Patent was “justified” “due to the priority date issue” of whether the Challenged Patents were entitled to the September 20, 2004 date. Appx8101. The PTAB recognized that priority date was the only material dispute between the parties and declined to analyze any of the prior art in the IPRs challenging priority date. Appx9037, Appx9039.

D. LG Violates the *Sotera* Stipulation.

LG quickly proved Hafeman correct in asserting that LG’s *Sotera* stipulation was a sham. One week after the IPRs were instituted, on February 6, 2023, LG moved for summary judgment on invalidity, raising the *same* priority date issue that formed the basis of the PTAB’s granting of institution. Appx7637. LG’s motion even cross-referenced and responded to Hafeman’s IPR arguments on this issue and unabashedly stated that the district court should reach the “same conclusion” the PTAB reached in its institution decisions. Appx7641.

Hafeman initially alerted the PTAB to LG's motion via email on March 17, 2023. Appx7832. In response, on March 20, 2023, the PTAB wrote that "any dispute regarding the scope or alleged violation of stipulations should be addressed in the district court proceedings in which such stipulations are to have effect." Appx7830.

On April 12, 2023, the district court found that LG's motion violated its *Sotera* stipulation. Appx7676-78 (*Hafeman v. LG Elecs., Inc.*, No. 6:21-CV-00696-ADA, 2023 WL 4362863, at *1 (W.D. Tex. Apr. 14, 2023)). As a result, the district court refused to consider LG's priority-date arguments, stating that "LG [was] estopped from raising the priority date issue in this Court." The district court further rejected LG's efforts to avoid the stipulation, including LG's argument that it was using other prior art references. *Id.* Indeed, the district court concluded that LG's challenges were "materially identical" to the IPR issues and lacked any "substantive difference." *Id.* But the damage had already been done: Hafeman was forced to defend the same invalidity challenges in both the IPRs and district court all the way through expert proceedings, depositions, and summary judgment. Appx8175.

E. The Parties Proceed to Trial in Texas.

The trial between Hafeman and LG occurred, as originally scheduled, from April 24 to 28, 2023, in Waco, Texas. After five days of trial, the jury returned its verdict, finding each of the asserted claims of the Challenged Patents to be non-infringed and invalid. Appx7626-36. Hafeman has filed a motion for judgment as a

matter of law and for a new trial, based in part on LG's violation of the district court's evidentiary rulings (which the district court found during trial). Hafeman's motion remains pending in the district court, and no judgment has been entered.

F. The PTAB Ignores the *Sotera* Violation.

In her patent owner response and sur-reply, Hafeman explained why the IPRs should be terminated based on the district court's finding that LG violated its stipulation. Appx8172-76, Appx8281-83. At oral argument, the PTAB questioned Hafeman's counsel at length about the *Sotera* violation. Appx8466-73. During their questioning, the PTAB seemed to view the violation as only the district court's issue, even though the PTAB had relied on the stipulation and used it to grant institution. Appx8469 (29:14-15) ([Judge Galligan:] "the court enforced [the stipulation]. So that was the point of the *Sotera* [stipulation], right?"), Appx8471 (30:5-6) ([Judge Smith:] "let's say we agree with you on 100 percent of the facts. We agree with you 100 percent. What would that have to do with us?"). Aside from the institution decision, however, the *Sotera* violation continued to infect the IPR proceedings through the FWDs, as Hafeman was forced to once again defend the priority date challenge through the duration of the IPRs. Appx9072-80, Appx9134-40.

III. THE PTAB's FWDs

On January 23, 2024, the PTAB issued its FWDs finding all claims in the Challenged Patents to be invalid. Appx1-36. The PTAB did not address the *Sotera*

violation, which formed the basis of its grant of institution, let alone explain why the IPRs should have continued after the district court determined it had been violated.

The PTAB consolidated the two IPRs against each Challenged Patent and found all Challenged Claims across the IPRs to be obvious based on the combination of Jenne and Cohen. Appx2, Appx36. The PTAB did not analyze any other combination. *Id.* The PTAB found that all limitations, including the “without assistance by a user” limitation, was met, and rejected the strong objective evidence of non-obviousness of the Challenged Claims. Appx20-24, Appx28-32.

IV. SUMMARY OF THE PRIOR ART

A. U.S. Pat. Pub. No. 2003/0122864 (“Jenne”)

Jenne has nothing to do with device security or recovery. Jenne does not disclose lock screens or the display of *any* recovery or return information—let alone remotely-changeable return information by the owner without user assistance.

Jenne, as confirmed in paragraph 27, requires the user to assist by connecting to the Internet to establish a remote connection before updating and downloading advertisements to the memory. Appx887 (¶ 27). Jenne displays advertisements during “user waiting times” on a computer, such as “booting [time], waking up from sleep mode, or similar events.” Appx886 (¶ 13). Jenne notes that there are many “user waiting times” during which a computer is performing a resource-intensive task, and the user cannot perform another task. Appx886 (¶ 18). Jenne proposes that

“computer manufacturers” could monetize that time, and “generate additional revenue” for themselves, by delivering and displaying ads during such times. Appx886-87 (¶¶ 18-20). To that end, Jenne proposes a system in which computer manufacturers can send ads to a “memory 520” on the computer, “through the Internet” after the user has connected to the Internet. Appx887 (¶ 25), Appx884 (Fig. 1). Such ads can be selected based on “user advertisement preferences” provided based on a survey or by “track[ing] the user’s Internet information,” such as browsing history. *Id.* Once stored in the memory 520, the advertisements are displayed during “waiting times,” such as boot-up. Appx887 (¶¶ 25-27).

B. EP 687968 A2 (“Cohen”)

Cohen discloses nothing about the remote change of return information. The words “remote,” “online,” or “Internet” do not appear in Cohen. Instead, Cohen discloses a purely local system in which “textual indica of personal ownership [are] entered by the owner” locally on the device. Appx891 (2:30-47). Cohen discloses that, during initial “set-up” of the device, the device “prompt[s] the user to enter personal ownership indicia, such as name and address.” Appx892 (4:27-44). Subsequently, whenever the device is turned on, the device displays the “personal ownership indicia” during the “Power-On-System Test (POST) process.” Appx893 (5:20-27). Thus, Cohen comes nowhere near disclosing the claimed features of remotely changing recovery/return information after setup.

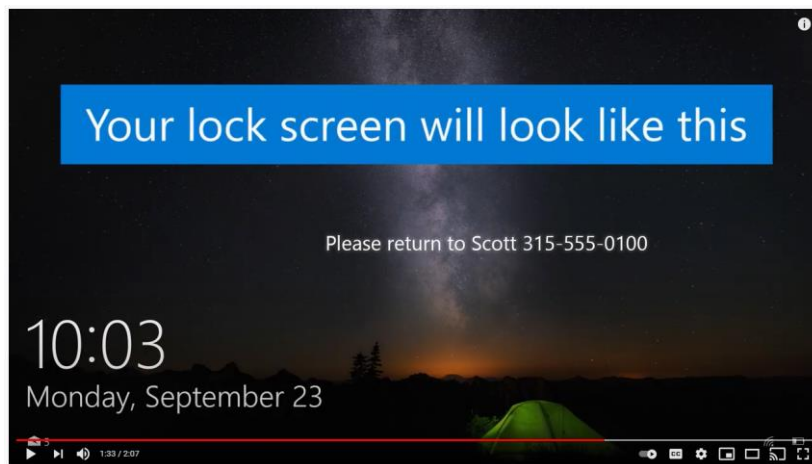
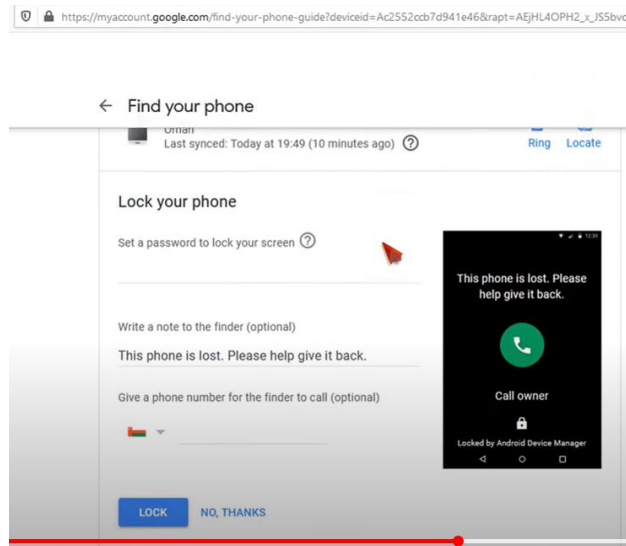
V. OVERVIEW OF STRONG SECONDARY CONSIDERATIONS

Hafeman's inventions in the Challenged Patents were embodied in Front Door Software Corporation's The Retriever product. The specification of the Challenged Patents refers to "the invention" as "The Retriever" dozens of times, Appx113-33, and LG even used the "The Retriever" as an alleged anticipatory reference in the district court. Appx7653 ("[Hafeman] admits that her own product, the Retriever, practiced the limitations of the Asserted Claims these systems anticipate the Asserted Claims.").

The Retriever received tremendous praise. In various news articles, including a 2009 article in the Associated Press, The Retriever was praised for its ability to locate and return lost or stolen computers by allowing the owner to display return/recovery information from a remote location before or with a password lock screen without the person possessing the device to do anything. Appx7728, Appx7729 (mentioning reviews in 57 such articles). The Associated Press article stated that The Retriever "displays your contact information [while your] computer boots up." Appx7728. Another article stated that The Retriever has gone "global," is getting customers from around the world, and works by sending "a bulletin-board message saying, 'This computer has been lost or stolen' to the computer screen." Appx7729. In 2011, the product placed first out of 175 companies at the Vator start-up pitch contest in San Francisco. Appx7737.

The Retriever also proved commercially successful. The Retriever sold for \$29.95, for a three-year license, and over 150,000 people in over 100 countries downloaded and used the product. Appx7728, Appx7738, Appx1337. Major universities like UCLA and Brown purchased The Retriever for their student bodies. Appx3020. In 2008, Hafeman signed a deal with Staples who ordered 7,500 Retriever product CDs for 40 stores. Appx1279. By 2009, there were over two million product activations of The Retriever, proving overwhelming product usage, and Hafeman had signed another deal with Office Max. Appx1333, Appx1378. These orders for thousands of CDs of The Retriever product occurred prior to the introduction of any audio or GPS features in The Retriever, which are not recited in the Challenged Claims. Appx7729.

Evidence also showed that others copied The Retriever product. In 2013 and 2015, Google and Microsoft released substantially similar “Find My Device” products in which an owner could send a custom message to their lost or stolen device without user assistance. Appx7741, Appx7746. Google and Microsoft’s products can be seen below:



Appx3792, Appx3855. Hafeman's substantially similar invention has a priority date of September 2004, approximately a decade earlier. Appx113.

SUMMARY OF ARGUMENT

1. The PTAB abused its discretion in handling the *Sotera* stipulation violation. The PTAB relied on the *Sotera* stipulation and priority date issue as the bases to grant institution in all six IPRs. Appx8099-101. In the IPRs challenging priority date, the PTAB recognized that priority date was the *only* material dispute

between the parties and *declined* to analyze any of the prior art. Appx9037, Appx9039. The district court subsequently determined that the *Sotera* stipulation had been violated by the filing of LG’s motion for summary judgment of invalidity because the challenges were “materially identical.” Appx7676-77. Put simply, the “prior art” associated with the priority date challenge (including Hafeman’s own patent applications and The Retriever product) added nothing. Appx7653. The PTAB then failed to address the stipulation’s violation in the FWDs. Appx1-36.

Under settled law, the PTAB had to provide *some* reasoning as to why it would permit the IPRs to continue. *Provisur Techs., Inc. v. Weber, Inc.*, 50 F.4th 117, 123 (Fed. Cir. 2022) (holding that PTAB abused its discretion where it did not address arguments made by the patent owner); *In re Thrift*, 298 F.3d 1357, 1364 (Fed. Cir. 2002) (emphasizing that the Board is required to “document its reasoning on the record to allow accountability” and to facilitate “effective judicial review”). The PTAB abused its discretion by failing to do so.

Moreover, when a necessary basis of institution is later determined to be incorrect, such as a mis-identification of real parties-in-interest or non-compliance with the one-year statutory bar, this Court has recognized the PTAB’s ability to terminate IPRs without issuing a final written decision. *Medtronic, Inc. v. Robert Bosch Healthcare Sys., Inc.*, 839 F.3d 1382, 1386 n.2 (Fed. Cir. 2016); *GTNX, Inc. v. INTTRA, Inc.*, 789 F.3d 1309, 1311-12 (Fed. Cir. 2015). The PTAB abused its

discretion in not terminating the IPRs once the undisputed facts established that the basis of its grant of institution, the *Sotera* stipulation, had been a sham all along.

Indeed, the USPTO's June 2022 Interim Procedure places significant value on *Sotera* stipulations to avoid duplication and conflict between district court proceedings and IPRs. Interim Procedure at 3. The PTAB thus allows IPRs to be instituted when such stipulations are provided, and denies IPRs when they are not. *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 10, 9 (PTAB Apr. 21, 2022) (denying institution where "Petitioner does not offer a stipulation, such as the one considered in *Sotera*"). Any value offered by such stipulations is destroyed if the stipulations prove to be a sham, which is exactly what occurred here. The IPRs constituted an abusive and duplicative attack on the Challenged Patents that drew significant time and investment by Hafeman to defend through expert discovery and summary judgment in the District Court and for the duration of the IPRs. Appx8175. Not having any consequences in IPR for the violation of a stipulation increases litigation costs for inventors and creates conflict with district court proceedings. Under the AIA and PTAB policy and precedent, "nothing short of termination" would be appropriate. *In re Vivint, Inc.*, 14 F.4th 1342, 1348 (Fed. Cir. 2021).

2. The PTAB implicitly construed "without assistance by a user"—a limitation in each of the Challenged Claims—to *exclude* establishing communications between a lost or stolen computer with a remote computer. This

was legally incorrect. The specification expressly describes the claimed improvement as an owner's ability to initiate or change return information *without* a user doing *anything* (other than powering on the device), such as establishing an Internet connection.

3. Applying its implicit, legally incorrect, construction, the PTAB erred in finding that the Jenne/Cohen combination met the “without assistance by a user” limitation. In Jenne, the *user* must establish an Internet connection for Jenne's software (the “commercial message application”) to update any information. Appx884 (Fig. 1), Appx886-88 (¶¶ 13, 24, 25, 27). Indeed, Google and Microsoft's expert, Dr. Erez Zadok, confirmed in his deposition and rebuttal report that Jenne teaches no other way to establish the Internet connection. Appx7774, Appx4563-66. Thus, Jenne does not disclose the required “without assistance by a user” limitation.

4. The PTAB declined to consider the substantial evidence of secondary considerations of non-obviousness that Hafeman offered based on a supposed lack of nexus between The Retriever and the invention. Appx29. But the specification expressly describes The Retriever *as the invention*, Appx113-22, Appx7653, and LG admitted as much in the district court. Appx7653. Thus, the PTAB erred in refusing to take into account the substantial evidence of secondary considerations that Hafeman offered. *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1072 (Fed. Cir. 2018).

STANDARD OF REVIEW

1. ***The Sotera Violation:*** This Court reviews de novo the PTAB’s compliance with the Administrative Procedure Act (“APA”). *In re NuVasive, Inc.*, 841 F.3d 966, 970 (Fed. Cir. 2016); *Google LLC v. EcoFactor, Inc.*, 92 F.4th 1049, 1054 (Fed. Cir. 2024). The APA requires the Court to “decide all relevant questions of law” and to set aside agency actions that are “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.” 5 U.S.C. § 706. “Agency action is an abuse of discretion when it ‘(1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the [agency] could rationally base its decision.’ A decision is arbitrary and capricious when the agency fails to articulate a ‘rational connection between the facts found and the choice made.’” *Vivint*, 14 F.4th at 1351.

2. ***Claim Construction:*** This Court reviews the issue of claim construction of a patent claim de novo with any underlying fact findings reviewed for substantial evidence. *Google*, 92 F.4th at 1054.

3. ***Obviousness Findings:*** This Court “review[s] the [PTAB’s] ultimate determination of obviousness de novo and its underlying findings of fact for substantial evidence.” *Virtek Vision Int’l ULC v. Assembly Guidance Sys., Inc.*, 97 F.4th 882, 886 (Fed. Cir. 2024).

4. *Secondary Considerations*: The PTAB’s legal decisions regarding secondary considerations are reviewed de novo and its underlying factual determinations for substantial evidence. *PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, 815 F.3d 734, 739 (Fed. Cir. 2016).

ARGUMENT

I. THE PTAB ABUSED ITS DISCRETION BY FAILING TO ADDRESS THE *SOTERA* VIOLATION AND TERMINATE THE IPRs

LG, through Google and Microsoft, made a binding promise to the PTAB. Based on that promise, that PTAB exercised its discretion to institute all six IPRs. The district court found that LG violated its promise. The PTAB then ignored the issue in its FWDs and found all claims to be invalid.

The PTAB acted arbitrarily and abused its discretion in doing so, particularly without addressing the broken promise in its FWDs. The USPTO uses a precedential six-factor test to determine whether to institute IPR when there is co-pending litigation in the district court. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020). Known as the *Fintiv* factors, the PTAB must consider proximity to trial, investment in the district court proceeding, overlap in issues, and the likelihood of a stay in district court. *Id.* In June 2022, the USPTO issued further binding agency guidance stating that “the PTAB will not discretionarily deny institution ... where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised

before the PTAB.” Interim Procedure at 3. This is known as a *Sotera* stipulation. *Id.* The USPTO’s binding guidance stated that the purpose of these stipulations is to reduce or eliminate “potentially conflicting decisions and duplicative efforts between the district court and the PTAB.” *Id.* at 7.

The district court found that LG violated the *Sotera* stipulation, and by extension, Google and Microsoft necessarily did so as well, standing in “LG’s shoes” for the IPRs. Appx8100. While the PTAB’s institution decisions are not appealable, *Apple Inc. v. Vidal*, 63 F.4th 1, 7 (Fed. 2023), its FWDs are. And in FWDs, the PTAB must comply with the APA. “Under the APA, the [PTAB] must fully and particularly set out the bases upon which it reached its decision.” *Provisur Techs.*, 50 F.4th at 123 (holding that PTAB abused its discretion where it did not address arguments made by the patent owner). To permit effective appellate review, the PTAB’s analysis must be “clearly disclosed and adequately sustained.” *SEC v. Chenery Corp.*, 318 U.S. 80, 94 (1943); *In re Thrift*, 298 F.3d at 1364 (emphasizing that the Board is required to “document its reasoning on the record to allow accountability” and to facilitate “effective judicial review”). Yet the PTAB here completely ignored the *Sotera* violation—a stipulation that LG voluntarily made and submitted to the PTAB—in its FWDs. This was a clear abuse of discretion. Beyond that, the *Sotera* violation warranted dismissal of the IPRs in the FWDs, as LG simultaneously

pursued the same invalidity challenges in the district court after promising it would not.

First, the PTAB should have recognized in the FWDs that the six IPRs would not have been instituted but for LG's stipulation and priority date challenge. Appx8100-01. Despite LG's continued use of the IPR grounds, the significant investment in district court, and the approaching trial, the PTAB concluded at institution that LG's stipulation "mitigate[d] concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB." Appx8100. The PTAB also found that two petitions against each Challenged Patent was "justified" "due to the priority date issue." Appx8101. When an Article III judge determines a stipulation has been violated, it deserves consideration by the administrative body that previously relied on it.

Second, the district court's action in precluding LG from making the priority date challenge did not cure the *Sotera* violation. Hafeman expended significant time and resources defending the priority challenge, including by submitting an opposition brief, expert report, and declaration, and presenting oral argument, in the district court, all of which occurred after the *Sotera* stipulation was submitted and the PTAB granted institution. Appx8282. Hafeman then had to defend against this issue *again* in her IPR patent owner responses, expert declarations, sur-replies, and at IPR oral argument. Stipulations should be self-executing by the parties that proffer

them and not require judicial intervention to enforce. The June 2022 USPTO Guidance states that *Sotera* stipulations are meant to create efficiency and less duplication of efforts. Interim Procedure at 7. LG, Google, and Microsoft's actions intentionally defied these rules.

Third, the *Sotera* violation should have been binding on Google and Microsoft (and LG) in the IPRs. The district court expressly found LG's motion violated the *Sotera* stipulation, rejecting the argument that the challenges differed based on the nominally different references. Appx7676-77. In the district court, LG argued that the Challenged Patents could not claim priority to September 20, 2004, based on the same limitation, using the same evidence and arguments, that had been raised in the IPRs. Appx7645-53. LG's motion even stated that the district court should reach the "same conclusion" the PTAB had made in its institution decisions. Appx7641. With this undeniable overlap, the district court properly found that there was "no substantive difference" between LG's challenge and the challenge being made in IPR. *Id.* Thus, Google and Microsoft should have been judicially estopped from challenging the *Sotera* violation.

Fourth, the fact that LG was not a party to the IPRs cannot justify the PTAB's failure to either address the *Sotera* violation in the FWDs or to dismiss the IPRs. Google and Microsoft identified LG as the real party-in-interest in the IPRs. Appx8949. Google and Microsoft never challenged Hafeman's allegation that

Google and Microsoft were likely indemnifying LG. Appx8026. Google, Microsoft, and LG were represented by many of the same attorneys, Appx7048, Appx7050, and the PTAB found that Google, Microsoft, and LG were all standing in the same “shoes.” Appx8100. LG’s *Sotera* stipulation was used to not only convince the PTAB to institute the IRPs, but to proceed with FWDs on the merits. These facts easily required the PTAB to at least address the *Sotera* violation in the FWDs and explain whether the violation warranted dismissal.

Under 37 C.F.R. §§ 42.71(a) and 42.72, the PTAB has broad authority to dismiss a petition and to terminate a trial without rendering a final written decision. This Court has recognized the PTAB’s authority to terminate proceedings post-institution based on a failure to list all real parties-in-interest in the petition, *Medtronic*, 839 F.3d at 1386, or where a petition was barred by an early-filed civil action, *GTNX*, 789 F.3d at 1311. In her patent owner responses, Hafeman provided authority holding that, when a party provides misrepresentations to obtain institution, the appropriate remedy is termination of the IPR. Appx8176 (citing *I.M.L. SLU v. WAG Acquisition, LLC*, IPR2016-01658, Paper 46, 13-14 (PTAB Feb. 27, 2018) (vacating institution and terminating IPR where the petitioner made inaccurate representations)). But the PTAB refused to consider either Hafeman’s argument or this authority in its FWDs.

The PTAB's FWDs should have not only addressed, but applied that remedy here. Google, Microsoft, and LG's *Sotera* violation forced Hafeman to defend invalidity challenges on two fronts in direct contradiction to the purpose of the America Invents Act, Public Law 112-29, 125 Stat. 284 (Sept. 16, 2011). This wasted Hafeman's, the PTAB's, and the district court's limited resources. *Vivint*, 14 F.4th at 1354 ("nothing short of termination ... would be appropriate" where decision was inconsistent with USPTO previous policy and decision-making). When a party violates a stipulation, courts have stricken arguments or even held a party in contempt. *See InVue Security Products Inc. v. Vanguard Products Group, Inc.*, 2020 WL 2425721, *2 (M.D. Fla. 2020) (striking invalidity ground that violated an IPR stipulation); *Codexis, Inc. v. EnzymeWorks, Inc.*, 759 F. App'x 962, 965 (Fed. Cir. 2019) (affirming district court order holding party in contempt for violating stipulation involving settlement terms). Given the heavy weight the PTAB placed on the *Sotera* stipulation at institution, termination is entirely appropriate here.

The IPRs should have been terminated. At a minimum, the Court should vacate and remand with directions that the PTAB address the appropriate remedy for the proven *Sotera* violation.

II. THE PTAB ERRED AS A MATTER OF LAW IN ITS IMPLIED CONSTRUCTION OF “WITHOUT ASSISTANCE BY A USER” TO EXCLUDE ESTABLISHING A REMOTE CONNECTION

The Challenged Claims in the three Challenged Patents recite “initiating or changing return information ... through remote communication *without assistance by a user* with the computer” or substantially similar language. Appx132-33 (claims 1, 4, 7). Thus, the Challenged Claims require that there be no “assistance” by the user to initiate or change return/recovery information.

In determining that Jenne discloses the “without assistance” limitation—the *only* prior art reference that Google and Microsoft relied on for this limitation, Appx7934—the PTAB impliedly construed “without assistance by a user” to exclude a user’s establishment of a remote network connection, such that the user still provides “no assistance” even if the user must establish an Internet connection. This implied construction was incorrect as a matter of law.

A. **“Without assistance by a user” means that a user can provide no assistance, including the establishment of an Internet connection.**

The “without assistance” claim limitation means what it says: the user *cannot* provide *any assistance whatsoever* (besides turning on power) to receive return and recovery information, including the establishment of an Internet connection. This is not only the legally correct meaning of “without assistance,” it is the cornerstone of Hafeman’s invention in the Challenged Patents.

The intrinsic patent documents overwhelming demonstrate that establishing a connection or pressing a key is “assistance.” In Figure 3, the return/recovery dialog box appears on the monitor’s display screen before or simultaneously with any password or security prompt dialog box (*i.e.*, prior to the user pressing a key to enter a password). Appx117 (Fig. 3). There is no step in Figure 3 for the user to establish an Internet connection, only to turn the computer on. *Id.* “Each computer security program will attempt to display the recovery information *on the initial screen when possible.*” Appx128 (7:33-35). The specification further explains that the return/recovery information can be displayed *before or during* any password or security prompt, so that “the person finding the equipment will see the owner recovery/return information.” Appx128 (7:24-29). This is an “important” or “critical” aspect of the invention, because if such information was only displayed *after* the password screen, and the user did not know the password (which is most likely), then the return/recovery information would never be visible. Appx128-29 (7:18-23, 7:30-33, 8:24-33, 10:1-7).

The distinction between the prior art and the Hafeman invention also compels the correct meaning of “without assistance.” As the specification explains, in the PDA prior art, the person in possession of the device “may never access” the network, but the invention allows the *owner* “to access” the equipment “over the Internet, phone lines, cable, etc.” Appx131 (14:4-15, 13:42-47 (“[t]he program ...

allows the ‘owner’ to ... initiate a download of changes to the protected equipment’’)). In other words, with power and an available connection, Hafeman’s invention allows establishment of a remote connection *automatically*—*i.e.*, without any assistance by the user. Appx125, 2:39-40 (“The present invention automatically initiates during the boot-up process of the equipment ...”), Appx126, 4:49-50 (“The apparatus 10 comprises a return screen 20 that the processor 14 automatically causes to appear during or after boot-up of the processor 14 ...”), Appx132, 15:63-66 (“The Retriever provides an interactive method of designing and changing the entire recovery screen ‘on the fly’ ... Organization logos or ads can be easily and quickly downloaded onto the recovery screens of protected equipment.”).

The Challenged Patents improve PDA’s “synchronization” capabilities (which still required user assistance to establish an Internet connection) by offering a “unique communication power” to “seize[] control of the display 18 monitor until a security prompt is satisfied.” Appx 131 (14:22-40). In this respect, the Challenged Patents provide a critical improvement over the prior art: if a thief or Good Samaritan finds the device, they will almost certainly not know the password to log-on. Appx130 (11:63-12:17). Thus, they cannot go into the settings and establish an Internet connection. But Hafeman’s invention still works, and the owner can “initiat[e] or chang[e]” return/recovery information when the user does not establish a connection by pushing a new message to the device via an interactive program

(e.g., “My computer is lost. Please return to the Hotel Metropol Moscow”), *even when the user has not already established a connection*. Appx128 (8:34-36) (the owner may “change the recovery/return information at any time”), Appx 131 (13:44-45) (the owner may “initiate a download of changes to the protected equipment”). Of course, the computer must be powered on, and there must be some form of connection available. Appx117 (Fig. 3) (“Turn Computer On”), Appx128 7:35-42 (explaining that in some operating systems, user has to boot-up the device). But with the Hafeman invention, a stolen computer remains useless to a thief. After all, what thief wants a stolen laptop when he cannot access the data and “THIS DEVICE IS STOLEN” is prominently displayed on the screen?

The prosecution history further demonstrates that no input or action by the user is needed to remotely initiate or change return/recovery information. During prosecution of a parent application, Hafeman added the “without assistance by a user” limitation by amendment filed December 21, 2006. Appx1133. Hafeman explained that, as a result of this amendment, the pending claims overcame the patent examiner’s rejection based on the Broyles reference. Appx1141-43. As she explained, to change “ownership information,” Broyles “requires that *the user depress a suitable key* to generate a keyboard interrupt at the proper time.” Appx1142. Thus, Hafeman overcame Boyles by making clear that the “without assistance by a user” limitation would *not* be satisfied if the user must press a

“suitable key” on the device’s keyboard. By the same rationale, logging on to establish a connection would also be user assistance because it also requires pressing a key (*i.e.*, submitting a username and password).

Later on in prosecution, Hafeman provided an applicant declaration demonstrating how a competitor’s product met the limitations of her claims. Hafeman stated that the product in which “[t]he user using the computer has *no* ability whatsoever to help initiate and control the display on the screen” would satisfy the “without assistance” limitation. Appx3061. Similarly, Hafeman stated that a product in which “[a]ll control over the display on the screens of the users is done without user assistance” would meet the limitation. Appx3065. Hafeman further explained that “[i]t would not make any sense for an owner using my invention to have to first try to find a way to contact the equipment user (possibly a thief!) to ask them to help push an interrupt key to help the owner display recovery information My product design and claimed features ... allows an owner to control the equipment *without any user assistance.*” Appx3083.

In sum, the legally correct meaning of “without assistance by a user” is *no user assistance* (besides turning on power) to receive return and recovery information, including the establishment on an Internet or remote connection.

B. The PTAB implicitly construed “without assistance” to allow a user to establish a remote connection.

In determining that Jenne met the “without assistance” limitation, Appx20-24, the PTAB necessarily and implicitly construed “without assistance” to *exclude* establishing remote communications, such as an Internet connection, between a lost device and a remote computer. This implicit construction was incorrect as a matter of law. *Google*, 92 F.4th at 1056 (“We have found implicit claim constructions even when the Board does not recognize that it is construing a claim.”).

Jenne undisputedly teaches the user must establish an Internet connection to update and download information into the memory. Appx21, Appx23. In the FWDs, the PTAB acknowledged Hafeman’s position that the Challenged Patents “allow[] an owner to push recovery information changes to the computer even when the user of the computer has not connected to the Internet, such as when a computer is found by someone who does not know the password and, therefore, cannot connect to the Internet.” Appx20. Nonetheless, by impliedly construing “without assistance” to *exclude* establishing an Internet connection, the PTAB found that Jenne met this limitation. Appx21.

In her patent owner response, Hafeman argued that “without assistance by a user” means that there can be “no input or action by the user ... to remotely initiate or change return/recovery information.” Appx8186. As Hafeman explained, if the person finding the lost or stolen device had to login and establish a connection, a

critical aspect of the invention would be rendered meaningless. *Id.* The PTAB rejected Hafeman's description of her own invention and then proceeded to implicitly construe "without assistance" in the FWDs to still allow a user's establishment of an Internet connection. The PTAB's reasons for doing so cannot withstand close examination.

First, the PTAB found that the claims do not "prohibit[]" user interactions such as "establishing the remote communication in the first instance." Appx21. But, as discussed above, the claim language, specification, and prosecution history all demonstrate that "assistance" includes the user pressing any key whatsoever, including to establish an Internet connection. The remote communication is controlled by the owner without any involvement of the user.

Second, the PTAB pointed to the following passage in the specification, finding that Hafeman's argument would "exclude" this functionality in the Challenged Patents:

Using this unique communication power, both 'owner' and "assigned to" information can be uploaded to the recovery center and/or downloaded to the protected equipment in order to synchronize the international recovery center information and the recovery information displayed on the initial display 18 screen. (This is a combination of the PDA type of synchronization between the main computer 12 and the PDA, and the McAfee anti-virus software Internet updating capability where *every time you go on-line, your computer 12 automatically checks to make sure that you have the most current anti-virus software and automatically updates your computer 12 with the latest changes.*) Nobody has ever before considered or designed a product *combining this type of communication ability with this type of recovery security*

program that seizes control of the display 18 monitor until a security prompt is satisfied. The Retriever design allows an equipment recovery capability that just does not exist on today's market, and is completely unique from all current products on the market[.]

Appx21 (citing Appx131 (14:22-40)) (first emphasis original). This passage (which Google and Microsoft did not even cite in their IPR papers) discusses two prior art communications systems—“PDA type of synchronization” and “McAfee anti-virus software.” Both required user assistance in establishing a network connection before any synchronization or anti-virus software updates could occur. *Id.* It then describes Hafeman's improvement (never before considered or designed) over these systems by eliminating the requirement for any user assistance to establish a remote network connection. As the passage explains, the Hafeman improvement takes “this type” of known technology—using PDA synchronization to update anti-virus software—and *combines it* with Hafeman's *recovery security program that seizes control of the display 18 monitor until a security prompt is satisfied. Id.*

In erroneously finding that the claimed invention also requires “the user [to go] online,” Appx22, the PTAB confused the distinction between using the known PDA and McAfee systems, on the one hand, with Hafeman's novel security program, which seizes control of the display until a security prompt is satisfied, on the other hand. The specification plainly explains that the invention improves both systems: the invention “synchronize[s] the international recovery center information and the recovery information displayed on the initial display 18 screen” and “seizes

control of the display 18 monitor until a security prompt is satisfied.” Appx131 (14:22-40). And the Internet connection can be established “automatically” and “on the fly” without any “assistance” by the user. Appx131 (13:32-24) (“This recovery display information can then be synchronized using the PDA synchronize capability.”), Appx 131 (14:8-10) (even if the user “never access[es]” the network, the owner can “attempt to access” the device “such as over the Internet, phone lines, cable, etc.”).

Third, although the PTAB acknowledged that Hafeman successfully traversed a reference (Broyles) during prosecution that required a system refresh by pressing a key to update return/recovery information, Appx23, it still stated that Broyles was different from Jenne because Jenne does not “requir[e] the user at the computer to press a particular key to start the process” of updating advertisements. Appx23. This misses the point. Jenne teaches (and Google and Microsoft’s own expert confirmed) that no information will be changed in Jenne unless an Internet connection is established by the user.” Appx4563 (¶ 75). The only way a user can establish an Internet connection in Jenne is by pressing a key. Thus, there is *no difference* between Broyles and Jenne relevant to the proper meaning of the “without assistance” limitation. If anything, a person’s act of logging and establishing a connection in Jenne is even *greater* assistance than touching a single key in Broyles.

In sum, the PTAB's reasoning for its implicit construction of "without assistance by a user" was legal error. *Google*, 92 F.4th at 1056.

III. THE JENNE/COHEN COMBINATION FAILS TO MEET THE "WITHOUT ASSISTANCE" LIMITATION UNDER THE LEGALLY CORRECT CONSTRUCTION

In the IPRs, Google and Microsoft bore the burden to prove "unpatentability by a preponderance of the evidence." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir. 2016); 35 U.S.C. § 316(e). This includes the "burden to prove that all claimed limitations are disclosed in th[at] prior art." *Par Pharm., Inc. v. TWi Pharms., Inc.*, 773 F.3d 1186, 1194 (Fed. Cir. 2014). Indeed, the PTAB could not eve "consider motivation to combine" unless Google and Microsoft first succeeded in proving that "all the elements of [the] invention are found in [the] combination of prior art references." *Id.*; *see also Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164 (Fed. Cir. 2006).

Google and Microsoft relied only on Jenne in arguing that the Jenne/Cohen combination satisfies the "without assistance by a user" limitation. Appx7934. Google and Microsoft did not rely on Cohen to supplement Jenne for the "without assistance by a user" limitation for good reason. Cohen's "ownership indicia," even if combined with Jenne, is limited to what is already stored on the computer. Appx893 (5:21-27). Thus, in Cohen, nothing is "initiat[ed]" or "change[ed]" using "remote communication."

Unlike the Challenged Patents, Jenne is useless for receiving remote instructions for returning a lost or stolen computer. With Jenne, if an owner loses her computer or has it stolen, the person holding the computer (the “user”) cannot connect to the Internet because he will not know the computer password, and thus he cannot get past the log-on screen and into the Wi-Fi settings. Without remote communications, the user can only turn on the computer and see ads already stored in memory. The owner has no way to send return or recovery information to the user because no remote connection exists. Appx884 (Fig. 1) (block 55 checks for Internet connection) Appx886-88, ¶ 13 (“commercial messages in the non-volatile memory may be securely updated through the Internet using a password”); ¶ 25 (“if an Internet connection to the system exists, the user may occasionally request to provide advertisement preferences”), ¶ 27 (“The Internet browser 545 can be connected with the Internet 525 by the user, and the user can access a website 530 through the Internet 525.”).

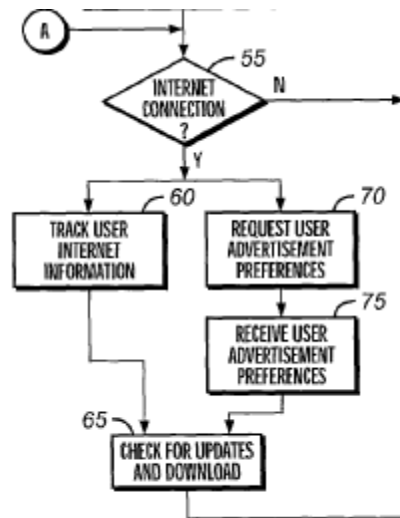
According to Google and Microsoft, Jenne’s downloads and updates “occur automatically during execution of the message application or via instruction by the manufacturer or authorized agent,” thereby satisfying the claim. *Id.* But the record contradicted Google and Microsoft’s assertion and neither Google and Microsoft’s own expert or the PTAB supported their position.

First, it is undisputed that Jenne’s system requires assistance from the user by logging in and establishing a connection before sending an advertisement through remote communication. Appx884 (Fig. 1, block 55), Appx887-88, ¶ 24 (“the commercial message application 50 checks to see if the computer 500 is connected to the Internet”), ¶ 27 (“The Internet browser 545 can be connected with the Internet 525 *by the user*, and the user can access a website 530 through the Internet 525.”).

Second, nowhere does Jenne teach that an owner can “initiat[e]” or “chang[e]” return/recovery information “without assistance by the user.” To the contrary, Jenne discloses an advertisement display system that has nothing to do with recovering lost or stolen mobile devices. Jenne displays advertisements during “user waiting times” on a computer, such as “booting [time], waking up from sleep mode, or similar events,” when which a computer performs resource-intensive tasks, preventing the user from performing other tasks. Appx886 (¶¶ 13, 18-20). To “generate additional revenue” during these “waiting times” by displaying ads, Jenne’s system teaches that computer manufacturers can collect user feedback and preferences, and then send ads into onboard memory “through the Internet.” Appx887 (¶ 25). Once stored in memory, the ads are displayed during the “waiting times.” Appx887 (¶¶ 25-27).

Indeed, any ‘manufacturer password’ only works *after* a user with the device connects to the Internet. As shown in Jenne’s Figure 1, the computer program on the remote computer checks to see if there is an Internet connection. If the answer is

“No,” no new updates or downloads can go into the memory of the remote computer in block 65. Instead, the computer can only display and rotate through old ads or messages that are already in the memory, and Jenne *does not* check for updates and downloads in block 65:



Appx884 (Fig. 1). Thus, when Jenne’s manufacturer checks for updates and downloads, it is required that the user connected to the Internet. Appx7771 (63:14-18) (Dr. Zadok acknowledging that when the manufacturer checks for updates and downloads, it must first pass through block 65). Thus, Jenne’s download and update process cannot occur unless the user has provided “assistance.”

Google and Microsoft’s own expert, Dr. Zadok, confirmed that Jenne teaches no other way the Internet connection is established. Appx7774, 76:15-16 (“Q. Putting aside the user, does Jenne teach anyone else connecting the device to the

Internet? A. I don't know if Jenne mentions anyone else who might connect to the Internet.”). Dr. Zadok further confirmed in his declaration that Jenne's software will “proceed to the remote changing of return/recovery information” only “if another entity (such as the owner) has already connected the device to the Internet.” Appx4563 (¶ 75). Thus, Dr. Zadok confirms that some “entity” in possession of the device must establish an Internet connection for Jenne to update any information.

Under the legally correct construction of “without assistance” as *no user assistance* (besides turning on power), Google and Microsoft failed to carry their burden of proof to show that limitation in the asserted “[Jenne] prior art.” *Par Pharm.*, 773 F.3d at 1194. Thus, as a matter of law, the Jenne/Cohen combination could not render the Challenged Claims obvious and the PTAB's decision should be reversed.

IV. THE PTAB ERRED IN ITS ANALYSIS OF THE STRONG SECONDARY CONSIDERATIONS OF THE CHALLENGED PATENTS

“[E]vidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not.” *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39 (Fed. Cir. 1983). Here, the nonobviousness of the claims of the Challenged Patents is confirmed by various secondary considerations: the praise Hafeman received for her inventions, the inventions' huge commercial

success, and copying by Google and Microsoft, all of which is described in detail above in the Statement of the Case. In rejecting Hafeman’s strong evidence of secondary considerations, the PTAB made multiple errors.

First, the PTAB wrongly found that there was no nexus between The Retriever software and the claimed invention. Appx29. The specification uses the term “The Retriever” to refer to the invention in the specification no fewer than 34 times, and Google and Microsoft’s attorneys had used The Retriever as an allegedly anticipatory reference in the district court. Appx126 (4:55), Appx7653. Thus, there was no dispute that The Retriever practiced the Challenged Claims.

The nexus was clear from the specification figures of the Challenged Patents, which prominently show The Retriever’s return/recovery and lock screens.

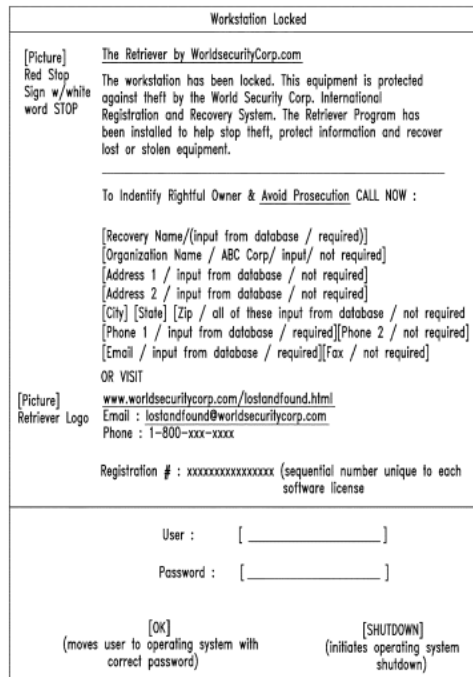


FIG.2

Appx116-24 (Figs. 2, 6, 8, 9, 10, 11). The Retriever met each and every limitation of the Challenged Patents, by allowing an owner to “initiat[e] or chang[e] return information which appears on the display through remote communication without assistance by a user” the return/recovery information was “display[ed] ... before with or with a security prompt.”

Second, the PTAB committed reversible legal error in finding that there was no nexus without providing any explanation. *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1329 (Fed. Cir. 2016) (“there is a presumption of nexus for objective considerations when the patentee shows that the asserted objective evidence is tied to a specific product and that product ‘is the invention disclosed and claimed in the patent.’”); *PPC Broadband, Inc. v. Corning Optical Commc’ns RF, LLC*, 815 F.3d 734, 747 (Fed. Cir. 2016) (“When the patentee has presented undisputed evidence that its product is the invention disclosed in the challenged claims, it is error for the Board to find to the contrary without further explanation.”).

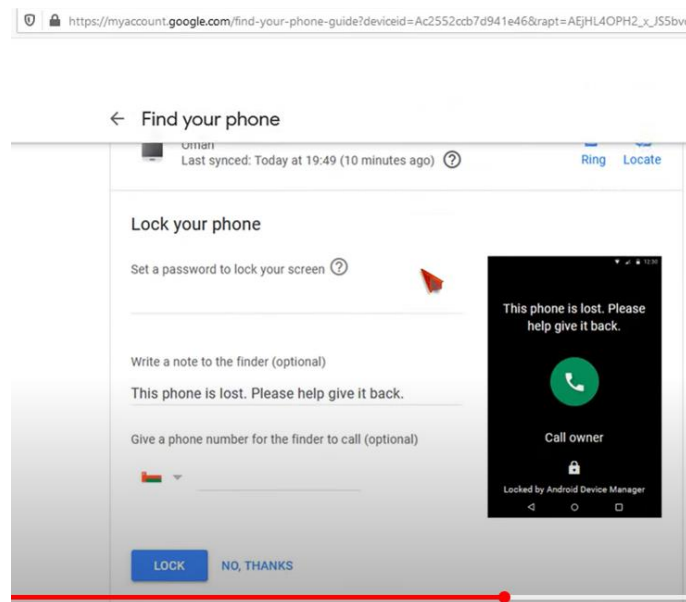
Third, the PTAB incorrectly found that the praise for the invention was directed only at non-patented features, such as a verbal alarm. Appx29-30. The evidence of record established that there was significant praise for displaying a custom message before or with the password lock screen, and that is the subject of the claimed invention. For example, the 2009 article in the Associated Press states “Front Door Software Corp.’s Retriever program displays your contact information

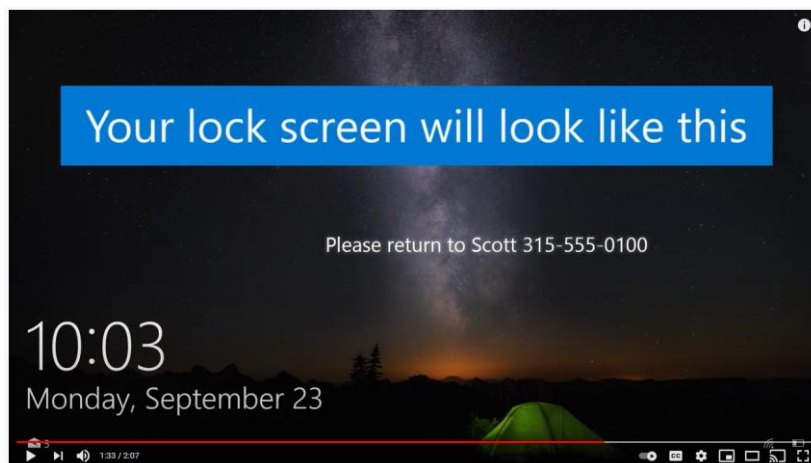
[as your] computer boots up. ... a big yellow and red banner appears on the screen, bolding [declaring] the laptop lost or stolen ... you can even let off steam [by] sending new messages to the nagging ‘Stolen Computer!’ screen.” Appx7728. This was just one of many articles praising the invention’s ability to display and change custom messages. Appx7728 (mentioning articles in the Seattle Times, London Times Online, Fox News, Channel 9, Channel 7, MSN.com, and the Rocky Mountain News). The start-up brochure from 2011 does not mention The Retriever’s audio features, but its “page view delivery capabilities” (*i.e.*, the return/recovery display screen). Appx7737. Even if there was some praise for non-patented features like the verbal alarm, that would not be a reason to disregard the commercial success of the patented invention. *PPC Broadband*, 815 F.3d at 747 (citation omitted) (“Because the evidence shows that the SignalTight connectors are “the invention disclosed and claimed in the patent, we presume that any commercial success of these products is due to the patented invention. This is true even when the product has additional, unclaimed features.”); *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1378 (Fed. Cir. 2000) (applying presumption even through commercial embodiment had unclaimed mobility feature).

Fourth, the PTAB incorrectly dismissed the evidence of The Retriever’s commercial success as unsupported. Appx30-31. Contrary to the PTAB’s conclusion, Hafeman offered evidence from Front Door Software’s website listing

customers from 104 colleges and universities and mentioning “thousands of additional customers.” Appx7738. Hafeman also pointed to evidence that The Retriever cost \$29.95 for a three-year license. Appx7728. Moreover, Hafeman submitted several declarations to the USPTO during prosecution in 2008 and 2009—before The Retriever’s verbal alarm was introduced—stating that The Retriever had generated over \$600,000 in sales. Appx1333, Appx1378. Staples alone ordered 7,500 units of the software in that period. *Id.*

Finally, the PTAB wrongly rejected evidence of copying. According to the PTAB, Google and Microsoft’s Find My Device programs are limited to “finding a device by ascertaining the location of the device.” Appx32. But the evidence showed otherwise. Google and Microsoft’s products allow a user to send and display a custom message to the device, just as The Retriever did.





Appx3792, Appx3855. In their IPR petitions, Google and Microsoft relied on a similar screenshot of Google's Find My Device. Appx7940, Appx7972. Copying does not require direct evidence. Rather, copying can be established when the products are substantially similar and there was access to the patented product. *Medtronic, Inc. v. Teleflex Innovations S.a.r.l.*, 70 F.4th 1331, 1340 (Fed. Cir. 2023). Nor is limitation-by-limitation correspondence required to show copying. *Id.* The PTAB's copying determination required direct evidence and correspondence contrary to this well-settled law.

In sum, the PTAB's refusal to consider secondary considerations of non-obviousness rested on a misapplication of the law and on incorrect descriptions of Google and Microsoft's Find My Device features of programs. The FWDs should be reversed for this reason as well.

CONCLUSION

The PTAB's decision invalidating the Challenged Claims should be reversed or vacated.

Dated: September 3, 2024

Respectfully submitted,

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