

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

FACEBOOK, INC., SAP AMERICA, INC., EBAY INC., EXPEDIA, INC.,
HOMEAWAY.COM, INC., SQUARESPACE, INC., WIX.COM, LTD.,
WIX.COM, INC., and GOOGLE LLC,¹
Petitioner,

v.

EXPRESS MOBILE, INC.,
Patent Owner.

IPR2021-01226
Patent 7,594,168 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

ORDER

¹ SAP America, Inc. filed a motion for joinder and a petition in IPR2022-00518. Expedia, Inc., eBay Inc., Homeaway.com, Inc., Squarespace, Inc., Wix.com, Ltd., and Wix.com, Inc. collectively filed a motion for joinder and a petition in IPR2022-00572. Google LLC filed a motion for joinder and a petition in IPR2022-00597. The Board joined all of these parties as petitioners in IPR2021-01226. This Order refers to all petitioners collectively as Petitioner.

Express Mobile, Inc. (“Patent Owner”) filed a request for Director Review of the Final Written Decision on Remand (“Decision,” Paper 60) in this *inter partes* review (“IPR”), and Petitioner filed an authorized response to the request. *See* Papers 62 (“Request”), 63 (“Response”).

On remand from the United States Court of Appeals for the Federal Circuit, the Board found that Petitioner established, by a preponderance of the evidence, that claims 1–4 and 6 of the challenged patent are unpatentable. Decision 19. In doing so, the Board acknowledged the guidance memorandum² instructing it to consider and address prior findings of fact and conclusions of law as to patent claims that already have been adjudicated in another forum, but concluded that a recent jury verdict finding claim 1 of the challenged patent not invalid had no effect on the Board’s patentability determination. *Id.* at 2–3, 15–19 (citing Ex. 2023, the jury verdict in *Express Mobile Inc. v. GoDaddy.com, LLC*, 1:19-cv-01937-MFK (D. Del. Nov. 7, 2025)).

In the Request, Patent Owner contends that although the Board agreed that the Memorandum applied, the Board erred in failing to explain why it reached a different conclusion than the district court. Request 9. Patent Owner argues the Board incorrectly reasoned that the Federal Circuit’s mandate precluded it from weighing the district court’s adjudication. *Id.* Patent Owner further faults the Board for having credited the GoDaddy.com expert’s district court trial testimony when the jury presumptively rejected the same testimony in its verdict. *Id.* at 9–10. And Patent Owner contends

² *See* Memorandum, “PTAB Consideration of Prior Findings of Fact and Conclusions of Law” (Sept. 16, 2025), available at https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf (“Memorandum”).

that the Board erred in accepting Petitioner’s remand arguments, which change how Petitioner mapped the prior art to the challenged claims. *Id.* at 11–14.

Petitioner responds that the verdict from the district court is not binding or relevant to this proceeding. Response 1. Petitioner argues that the Memorandum calls for reasoned consideration of prior adjudications, which the Board properly applied in finding that the district court trial testimony supported its obviousness determination. *Id.* at 1, 9. As to its arguments on remand, Petitioner contends that they explain how the same prior art embodiment as relied on in the Petition renders the claims unpatentable in view of the Federal Circuit’s decision. *Id.* at 13–14.

Having considered the Request and the Response, the Decision warrants further review by a Delegated Rehearing Panel (“DRP”). The Board determined that “the same or substantially the same issues of obviousness were presented during the district court trial” and acknowledged that the jury found claim 1 of the challenged patent not invalid. Decision 17. Given that the Board reached a conclusion that was different than the district court’s conclusion based on the *same or substantially same* evidence and arguments, the Board was required to provide a detailed explanation why such an outcome was warranted. *See* Memorandum 1. The Board provided no explanation, stating only that it was bound by the Federal Circuit’s mandate. *Id.* The Federal Circuit decision, however, vacated the Board’s final written decision in its entirety and remanded the IPR to the Board for “for further proceedings consistent with [the court’s] opinion.” *See Express Mobile, Inc. v. Meta Platforms, Inc.*, No. 2023-1646, 2025 WL 1693494, at *6 (Fed. Cir. June 17, 2025). It did not require the Board to ignore

intervening adjudications from other tribunals involving the same claims and prior art, effectively disregarding the Memorandum.

The Board did not give due consideration to the district court's findings or explain why the evidence or arguments in this IPR mandated a different outcome here than in the district court. Instead, the Board found support for its decision in the trial testimony of defendant GoDaddy.com's invalidity expert when the jury that was presented with that testimony did not find it persuasive.

Accordingly, Director Review of the Decision is delegated to a DRP to review the Decision and determine whether, in view of the district court's adjudication, Petitioner has presented meaningfully different evidence and arguments to the Board to warrant a different outcome under the preponderance of the evidence standard, or provided other reasons that require a different outcome here. The DRP should also consider whether the Board correctly determined that Petitioner's claim mapping on remand was timely in view of the parties' arguments in the Request and the Response. Request 11–15 (citing Decision 6, 10); Response 13–14.

Absent good cause, the DRP shall issue a decision within 60 days of this Order.

Accordingly, it is:

ORDERED that the request for Director Review is delegated to a DRP.

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