

Filed: April 15, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

DH INTERNATIONAL LTD.,
Patent Owner.

Case IPR2024-01322
Patent No. 9,022,294

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

TABLE OF CONTENTS

I.	Introduction.....	1
II.	The Board Acted Within Its Discretion In Granting IPR.....	2
III.	It Was Not Abuse To Grant Petitioner’s Supplemental Briefing.....	4

TABLE OF AUTHORITIES

Page(s)

Statutes

35 USC 314(a)	1, 2
---------------------	------

Cases

<i>SAS Institute Inc. v. Iancu</i> , 584 U.S. 357 (2018)	2
IPR2024-00029, paper 7 (Apr. 15, 2024)	4
IPR2024-01071, paper 13 (Jan. 7, 2025)	5
IPR2024-01203, paper 17 (Feb. 26, 2025)	3
IPR2024-01213, paper 6 (Feb. 24, 2025)	5
IPR2024-01381, paper 9 (Mar 18, 2025)	3
IPR2024-01110, paper 16 (Mar. 5, 2025)	5

I. Introduction

Patent Owner argues the Board abused its discretion in instituting *inter partes* review (“IPR”) “by (1) failing to apply the proper legal standard to the analysis of the claim elements, and (2) allowing Petitioner to submit a pre-institution reply on claim construction.” Request, 1. Patent Owner is wrong.

Patent Owner’s first argument wrongly presumes that the appropriate standard at institution is an “unsettled issue of law” and incorrectly accuses the Board of applying an “upon consideration” standard. Request, 2-4. By statute, the Board may institute an IPR when “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 USC 314(a). The Board expressly applied this standard. Decision on Institution (“DI”), 2. Patent Owner’s criticisms of the Board’s findings regarding Mooney and limitation [1.e] should be addressed during the IPR, not on Director Review. Patent Owner’s second argument misses the mark because the Consolidated Trial Practice Guide (TPG) expressly allows the Board to grant such briefing at its discretion. TPG, 52 Accordingly, Patent Owner has not demonstrated that the Board abused its discretion to institute an IPR, and trial should proceed as ordered.

II. The Board Acted Within Its Discretion In Granting IPR

Patent Owner urges the Director to grant its request for Director review because it allegedly presents an “important and unsettled issue of law” Request, 2-4 (advocating for a new institution standard). But the standard is not unsettled. By statute, the Board has discretion to institute where “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” *See* 35 USC 314(a); *SAS Institute Inc. v. Iancu*, 584 U.S. 357 (2018) (applying the same). The Board expressly (and repeatedly) applied this settled standard in deciding to institute IPR. DI at 2, 18, 20, 32, 36, 37.

Patent Owner fixates on the Board’s single use of the phrase “[u]pon consideration” to contend that this is “[t]he only statement in the DI of what standard the Board used when weighing facts related to the elements of the claims.” Request, 2. But this contention is disproven in the very same sentence, which ends with the Board’s articulation of the settled standard:

Upon consideration of the Petition, the Preliminary Response, the Pre-Institution Reply, Pre-Institution Sur-Reply, and the evidence of record, for the reasons set forth below, we conclude the Petition demonstrates a *reasonable likelihood that Petitioner would prevail in showing the unpatentability of at least one challenged claim* in the ’294 patent.” DI at 2 (emphasis added).

Patent Owner’s criticisms of the Board’s fact findings (Request, 4-12) do not demonstrate a misapplication of this settled standard.¹ Patent Owner presented these same arguments and evidence in its POPR. Paper 9, 22-27. The Board properly considered those arguments and evidence in its analysis and concluded the arguments and evidence set forth in the Petition “adequately support[.]” Petitioner’s assertion that Mooney discloses limitation [1.e]. DI, 20, 25-27. The Board also expressly directed the parties “to address the competing arguments and testimony ... during the inter partes review proceeding.” DI, 27. Thus, while the “reasonable likelihood” standard for institution was satisfied, the Board also recognized that the parties’ dispute would benefit from additional development at trial. *Id.* The Board routinely institutes IPR when the issues are “highly factual” in nature because such issues “are best resolved” through trial. IPR2024-01381, Paper 9 at 19 (Mar 18, 2025) (“[G]iven the highly factual nature of the competing expert testimony and the weighing necessary to resolve this issue, we view the issues as best resolved after further development during trial and after Petitioner has the opportunity to respond to Patent Owner’s arguments and evidence.”); IPR2024-

¹ Patent Owner’s charge that the Board’s findings do not meet the “preponderance of the evidence” standard is irrelevant because, as Patent Owner acknowledges, this standard applies “*only after institution.*” Compare Request, 2 with *id.*, 12.

01203, Paper 17 at 46 (Feb. 26, 2025) (similar); IPR2024-00029, Paper 7 at 61

(Apr. 15, 2024) (similar). It was not an abuse of discretion for the Board to do so.

III. It Was Not Abuse To Grant Petitioner’s Supplemental Briefing

Patent Owner argues that the Board abused its discretion because there was no “good cause” for granting pre-institution briefing, and in doing so, the Board “adversely impacted all the PO’s POPR arguments” and “prejudice[d] the PO.” Request, 13-14. The Board was within its discretion to grant such briefing, and Patent Owner was neither adversely impacted nor prejudiced by it.

Here, Petitioner sought a pre-institution reply to address Patent Owner’s constructions of three claim terms. Ex. 3001, 4. “Good cause exist[ed]” because of Patent Owner’s unforeseeable “claim constructions that contradict the patent’s disclosure[.]” *Id.* The Board authorized not only Petitioner’s reply, but a sur-reply of equal length and scope for Patent Owner. *Id.*, 1. The TPG expressly allows the Board to grant such briefing at its discretion: “The decision concerning whether the petitioner will be afforded a reply and the appropriate scope of such a reply rests with the panel deciding the proceeding to take into account the specific facts of the particular case.” TPG, 52. Indeed, as the Board noted, “[n]othing” in case law or the TPG “prevent[ed] Petitioner from responding to Patent Owner’s claim construction arguments as authorized by the Board.” DI, 12-13. Furthermore, “new evidence” or “new arguments that go beyond the issues authorized ... [would] not

be considered by the Board,” Ex. 3001, 1. Petitioner did not raise any such evidence or argument. *See generally* Paper 8. Thus, the Board had authority to grant Petitioner’s reply, and Petitioner’s reply was proper.

Moreover, the Board authorized Patent Owner to file a sur-reply of equal length and scope to Petitioner’s reply—which Patent Owner did. Ex. 3001, 1; Paper 9. Patent Owner was not “denied” anything simply because its opportunity to respond came after, rather than “prior[,] to granting the pre-institution reply.” Request, 13-14. The Board considered all arguments before issuing “preliminary” claim constructions, and Patent Owner (as with other proceedings) will have the opportunity to dispute during the IPR. DI, 14-15; DI, 11 (inviting “the parties to present any additional claim construction arguments in their respective Response, Reply, and Sur-Reply.”); IPR2024-01110, Paper 16 at 21-22 (Mar. 5, 2025) (“[C]laim construction, in general, is an issue to be addressed at trial ... Claim construction will be determined at the close of all the evidence and after any hearing.”); *accord* IPR2024-01213, paper 6 at 7 (Feb. 24, 2025), IPR2024-01071, Paper 13 at 16 (Jan. 7, 2025). Thus, Patent Owner’s allegations of prejudice and abuse of discretion are improper and contrary to the record.

Date: April 15, 2025

Respectfully Submitted,

/Erika H. Arner/
Erika H. Arner (Reg. No. 57,540)
Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Authorized Response to Director Review Request was served electronically via email on April 15, 2025, in its entirety on the following:

Robert P. Hart
robert@addyhart.com

Meredith Martin Addy
meredith@addyhart.com

Gregory B. Gulliver
gbgulliver@addyhart.com

litigation-dkt@addyhart.com

DHI-IPR@addyhart.com

Patent Owner has consented to service by email.

Dated: April 15, 2025

/Daniel E. Doku/
Daniel E. Doku
Senior Litigation Legal Assistant
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP