

PETITION FOR DIRECTOR REVIEW

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC and MOTOROLA MOBILITY LLC,

Petitioners,

v.

MULTIFOLD INTERNATIONAL INCORPORATED PTE. LTD.

Patent Owner

Case No. IPR2025-00058

U.S. Patent No. 9,158,494

**PATENT OWNER REQUEST FOR DIRECTOR REVIEW OF
DECISION ON INSTITUTION**

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I. INTRODUCTION

Pursuant to 37 C.F.R § 42.75(a), Multifold International Incorporated Pte. LTD. (“Patent Owner”) requests Director Review of the Decision on Institution in the *inter partes* review (“IPR”) of U.S. Patent No. 9,158,494 (the “’494 Patent”). See Paper 11 (“DI”).

The Interim Processes for PTAB Workload Management (“Interim Processes”) have the goals of “improv[ing] PTAB efficiency” and “maintain[ing] PTAB capacity.” *Id.* at 3. In determining whether a Petition meets these goals on institution, the Director “address[es] all relevant considerations.” *Id.* at 2. One such consideration—left to the Board to address in the first instance—is “where the petition presents an insufficient number of challenges that meet the reasonable likelihood standard indicating that institution is an inefficient use of resources.” *FAQs for Interim Processes for PTAB Workload Management* (“FAQs”), FAQ 9.

This Request presents the question of whether the Board may ignore FAQ 9 (and the corresponding long-standing PTAB practice) of denying institution where only a single dependent claim out of twelve challenged claims meets the reasonable likelihood standard. The POPR presented “voluminous evidence” that the Petition’s primary reference, Seo, was antedated by prior prototypes. Paper 8 [POPR], 14-79, Paper 9 [Prelim. Reply], 5. The POPR also presented evidence and

arguments demonstrating that challenged claims 14 and 18-20 were patentable over the prior art presented in the Petition. Paper 8 [POPR], 79-80. In their Preliminary Reply, Petitioners only identified a substantive issue as to antedating on claims 2 and 14. Paper 9 [Prelim. Reply], 5-10. Petitioners did not identify any issues as to the other challenged claims.

The DI based institution solely on claim 2. Paper 11 [DI], 25 (“we find that Petitioner establishes a reasonable likelihood that claim 2 is anticipated by Seo. Consequently, for the reasons just discussed, we decline Patent Owner’s request to deny institution.”). The Board did not address patentability of claim 14 and addressed the remaining 10 challenged claims by refusing to give any weight to the voluminous evidence provided by Patent Owner. Paper 11 [DI], 24-25. In doing so, the Board authorized full blown discovery in the trial stage with no explanation as to why such an expedition is consistent with FAQ 9 or would serve the PTAB’s stated goals of efficiency and maintaining capacity to handle AIA proceedings.

This Request asks the Director to grant Director Review, hold that the Board must act consistently with FAQ 9, and reverse the Board’s institution decision because it was based on one dependent claim out of twelve. In addition, the Director should reverse because the Board improperly refused to weigh evidence

and because detailed evidentiary disputes like this are better addressed in district court.

II. LEGAL STANDARD

Decisions of the Board challenged under Director Review are reviewed *de novo*. See Director Review Process at 5.A.ii.c, Standard of Review. See www.uspto.gov/patents/ptab/decisions/director-review-process. “Requests for Director Review of a Board’s final decision ... shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.” *Id.*, at 2B.

III. BACKGROUND

A. The ’494 Patent and the Imerj Project

The ’494 Patent relates to minimizing and maximizing applications on a dual screen device. EX1001 [’494 Patent], Title, Abstract. It is one of many inventions resulting from Flextronics’ 2010-2011 project to develop a dual screen smartphone. Paper 8 [POPR], 1. The project—referred to in Patent Owner’s papers as the “Imerj project”—employed over a hundred engineers and developers during the 2010 and 2011 time frame. EX2001 [Sirpal Decl.], ¶7; EX2002 [Cassar Decl.], ¶¶5, 43; EX2003 [Becze Decl.], ¶5 . While the ’494 Patent’s effective filing date is

based on a provisional filed on September 27, 2011, working prototypes of the Imerj smartphone were conceived in 2010 and operational for their intended purpose (i.e., performing the challenged claims) in January 2011. EX2001 [Sirpal Decl.], ¶¶25-38, 79-80; EX2002 [Cassar Decl.], ¶¶27-48; EX2003 [Becze Decl.], ¶¶21-25.

Below is a comparison of '494 Patent Fig. 1B next to a present-day photograph of an Imerj prototype manufactured in the fall of 2010:

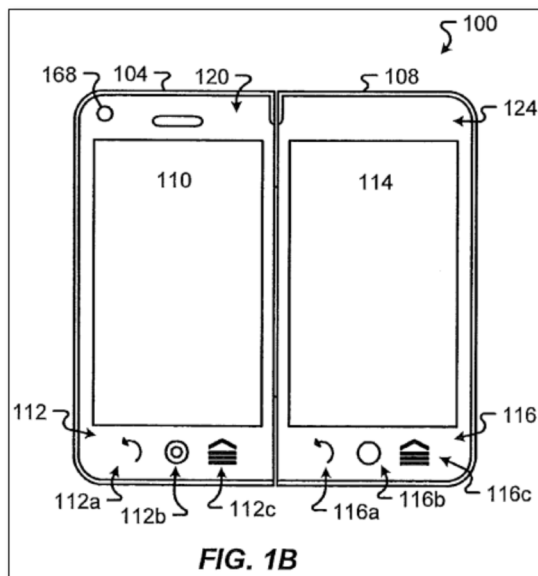


Fig. 1B

Exhibit 2017

Patent Owner provided the declaration of co-inventor Sanjiv Sirpal along with corroborating declarations of Ron Cassar and Ed Becze detailing when the claimed functionality was conceived and reduced to practice in the Imerj prototype smartphones. EX2001, EX2002, EX2003. Sanjiv Sirpal was Director of User

Experience on the Imerj project. EX2001, ¶6. Ron Cassar was the Director of Software Development on the Imerj project. EX2002, ¶4. Ed Becze was the Director of Product Design on the Imerj project. EX2003, ¶4. Ron Cassar and Ed Becze later co-founded the product design and development company Pegmatis, Inc., where both still work. EX2002, ¶1, EX2003, ¶1. Each declarant currently lives and works in the Toronto area.

B. Pre-Institution Proceedings

Google LLC and Motorola Mobility LLC (“Petitioners”) filed this IPR challenging claims 1, 2, 4, 6, 9, 10, 12–14, and 18–20 of the ’494 Patent. Pet., 4. The primary reference used in each ground is U.S. Pat. Appl. Publ. No. 2012/0306782 (“Seo”). *Id.* Seo has an earliest effective filing date of February 10, 2011 based on a provisional application. EX1005 [Seo].

Because Seo’s earliest priority date of February 10, 2011 is after the January 2011 actual reduction to practice through the Imerj smartphone, the ’494 Patent antedates Seo. *See ATI Techs. v. Iancu*, 920 F.3d 1362, 1369 (Fed. Cir. 2019); *Tyco Healthcare Grp. v. Ethicon Endo-Surgery, Inc.*, 774 F.3d 968, 975 (Fed. Cir. 2014).

The POPR briefed the antedating issue, and included the declarations discussed above and dozens of corroborating exhibits, including videos and

pictures of operational prototypes predating February 10, 2011. EXS2004-2087.

For example, Exhibits 2022 and 2023 are video excerpts of operational prototypes performing the claimed functionality in January 2010. The POPR provided a chart mapping the limitations of every challenged claim to the Imerj prototype. Paper 8 [POPR], 55-79. The POPR also pointed out that the Petition had failed to identify how the prior art allegedly taught or suggested claims 14 and 18-20. Paper 8, 79-80.

In response, Petitioners asked for and were granted a preliminary sur-reply. EX3001. In their preliminary sur-reply, Petitioners only argued that a single limitation found in claims 2 and 14 was missing from the prototypes. Paper 9 [Prelim. Reply], 5-10. Otherwise, Petitioners' arguments were speculative and did not pertain to specific claims. Paper 9 [Prelim. Reply], 1-5. For example, Petitioners argued that even though they failed to identify "disputed issues" in the "voluminous evidence" corroborating inventor Sirpal's declaration, trial should be instituted in order to conduct discovery so it can conduct discovery to identify issues. Paper 9 [Prelim. Reply], 5. But Petitioners had the opportunity in both the Petition and Preliminary Reply to identify issues and failed to do so. EX3001, 1.

Patent Owner's Preliminary Sur-Reply pointed out these and other mischaracterizations and omissions in Petitioners' Response. Paper 10 [Prelim.

Sur-Reply]. The Sur-Reply also reiterated that the Petition's unpatentability arguments as to claim 14 are facially deficient and even if Petitioners' arguments as to claim 2 were correct (they are not), the Board routinely denies institution where there is only a reasonable likelihood of a single challenged claim being unpatentable. Paper 10 [Prelim. Sur-Reply], 10 (citing *Par-Kan Company, LLC v. Unverferth Manufacturing Company*, IPR2024-01427, Paper 10, 15 (PTAB March 19, 2025) (denying institution based on swear-behind antedating 10 of 11 challenged claims because "instituting a trial with respect to all eleven claims based on evidence and arguments direct to [a single dependent claim] is not an efficient use of the Board's time and resources.") and *Deeper UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7, 2 (PTAB Jan. 19, 2019) (denying institution where reasonable likelihood of prevailing on only 2 of 23 claims)).

The DI found a reasonable likelihood that claim 2 of the '494 Patent was unpatentable. Paper 11 [DI], 36-37. On that basis, the Board instituted because "Petitioner has shown a reasonable likelihood that it would prevail in establishing that at least one challenged claim of the '494 Patent is unpatentable." Paper 11 [DI], 37. The DI ignored the authority cited above holding that instituting on a single dependent claim out of many challenged claims is an inefficient use of the Board's time and resources. Nor did the Board substantively address the

“voluminous” evidence provided by Patent Owner and assigned no weight to any of Patent Owner’s evidence or arguments for any of the other challenged claims.

IV. ARGUMENT

The Board’s decision reflects important issues of law and policy, erroneous conclusion of law, and abuse of discretion, including:

1. The Board’s institution based on a single dependent claim out of 12 challenged claims raises an important issue of law and policy and is legally erroneous. The decision contradicts not only decisions like *Par-Kan*, *Deeper UAB*, and *Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 (PTAB Nov. 7, 2018) (informative), but also the Acting Director’s guidance that the Board panel should not institute “where the petition presents an insufficient number of challenges that meet the reasonable likelihood standard indicating that institution is an inefficient use of resources.” FAQ 9. The Director should correct the Board’s erroneous decision and clarify, consistent with FAQ 9 and longstanding Board precedent, that the Board should deny institution where the overwhelming majority of challenged claims are not reasonably likely to be held unpatentable.

2. The DI committed legal error and abused its discretion by failing to give weight to any evidence antedating the challenged claims. The Board’s stated

rationales for doing so are unfounded and contradicted by the authority cited during briefing. The Board disregarded relevant and un rebutted testimony and evidence based on speculation. The Director should reverse the Board's error.

3. The Director's guidance suggests detailed evidentiary disputes such as this "are better resolved in an Article III court." FAQ 21 ("extensive reliance on expert testimony" weighs against institution.). The DI will require extensive discovery and witness testimony. This will result in much more evidence and testimony than the "voluminous" amount (according to Petitioners) already in the record. The Interim Processes' policy promoting efficiency and maintaining PTAB capacity are better served by denying institution and allowing the district court to address the antedation issue.

A. The Board Erred In Instituting Based On A Single Dependent Claim

Instituting a trial on one dependent claim out of a dozen challenged claims "is not an efficient use of the Board's time and resources." *Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 11 (PTAB Nov. 7, 2018) (informative) ("instituting a trial with respect to all twenty claims based on evidence and arguments directed to dependent claims 3 and 4 is not an efficient use of the Board's time and resources."). The Director's FAQs adopt this long-standing practice and indicate the PTO will discretionarily deny institution "where the

petition presents an insufficient number of challenges that meet the reasonable likelihood standard indicating that institution is an inefficient use of resources.”

FAQ 9.

Although Patent Owner’s Preliminary Sur-Reply pointed out that Petitioners had only identified a potential dispute for a single dependent claim out of twelve challenged claims (Paper 10 [Prelim. Sur-Reply], 10 (*citing Par-Kan and Deeper UAB*)), the DI ignored the issue. Patent Owner’s Preliminary Response presented detailed evidence of antedation, including a declaration of inventor Sirpal corroborated by two independent witnesses (Mr. Cassar and Mr. Becze) and dozens of exhibits, including pictures of prototype smartphones manufactured before February 2011, specification documents, corresponding emails and files, and videos of prototype devices practicing the challenged claims in January 2011. *Supra*, § III. In response, Petitioners identified no factual arguments or evidence that challenged claims 1, 2, 4, 6, 9, 10, 12-14 or 18-20 are not actually reduced to practice by the Imerj project prior to February 10, 2011. Paper 9 [Prelim. Reply], 1-5. Nor did the DI identify any specific issues with the evidence regarding those claims. Paper 11 [DI], 24-25.

Under these circumstances, institution is inefficient and time consuming for the Board. Instituting where a single dependent claim out of twelve challenged

claims has a reasonable likelihood of being held unpatentable contradicts FAQ 9, the Interim Processes, and longstanding Board policies as expressed in *Chevron Oronite*. The Director should reverse the Board, clarify that institution is inappropriate where the large majority of claims are not reasonably likely to be held unpatentable, and deny institution.

B. The Board Erred In Failing To Give Any Weight To Patent Owner's Evidence

The Board also erred in refusing to weigh the evidence. The Board gave *no weight* to the declaration of Mr. Sirpal, the corroborating declarations of Mr. Cassar and Mr. Becze, or the dozens of exhibits corroborating those declarations. DI, 24-25. *See id.*, Note 9 (“Patent Owner’s reliance on [*Shenzen*] for the proposition that we should give weight to its declarants testimony at this time is unavailing.”). The Board’s justification was that the witnesses collaborated on their declarations. *Id.* But neither Petitioners nor the Board provides any authority that collaboration is impermissible to help corroborate testimony.

To the contrary, the authority provided by Patent Owner is clear that witness declarations are entitled to weight where “no facts presented by Petitioners indicate that Patent Owner’s counsel rather than [declarants] were responsible for the substantive content of their declarations.” *Shenzhen Buxiang Network Technology Co., LTD. v. Sun Pleasure Co. Limited*, IPR2021-00080, Paper 43, 42-43 (PTAB

April 11, 2022). The Board purports to disregard *Shenzhen* because *Shenzen* was decided after institution. DI, 25, Note 9. Yet the Board does not even mention *Roofr Inc. v. Eagle View Technologies, Inc.*, IPR2023-00437, Paper 14, 13 (PTAB August 1, 2023), cited by Patent Owner, which denies institution based on much less evidence than presented here.

In *Roofr*, “Petitioner [] provided neither argument nor evidence to outweigh [PO]’s showing” of prior conception and reduction to practice. Paper 10 at 2-3. The same is true here—Petitioners have twice had the opportunity to address the Imerj project and both times failed to raise any factual disputes as to the vast majority of challenged claims. Paper 9, 1-5. Patent Owner’s evidence is almost entirely un rebutted. Even if certain evidence considered in a vacuum were entitled to little weight, the Board’s blanket refusal to provide any weight to Patent Owner’s evidence is inappropriate. *See Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983) (“It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included.”)

The process of reverse engineering the Imerj project requires cross-referencing between people with different memories and different evidence. The claimed functionality was only one part of a very large project. Few witnesses could ever recall off the top of their head the specific date that specific software

functionality was implemented on prototypes 15 years ago, especially on a project the scale of Imerj that involved hundreds of contributors.

The Board likewise discounts Mr. Cassar's testimony because corroborating Exhibits 2034 and 2035 refreshed his recollection. Paper 11 at 24. Exhibits 2034 and 2035 are emails that Mr. Cassar uses to help date when certain functionality was present in the prototypes. EX2002 [Cassar Decl.], ¶¶30-31; EX2034, EX2035. Again, few if any witnesses could recall the exact date they received an email 15 years ago without reviewing the relevant email.

Moreover, the Board erred in focusing on specific evidence in isolation rather than the evidence as a whole. *Fleming v. Escort Inc.*, 774 F.3d 1371, 1377 (Fed. Cir. 2014) ("all pertinent evidence is examined in order to determine whether the inventor's story is credible."). For example, the Board fails to address video excerpts showing prototypes performing the challenged claims in January 2011. EX2022, EX2023. The functionality shown in these clips is unrebutted by Petitioners. Paper 9, 4. No amount of discovery can change the reality that videos of the prototypes performing the claimed functionality exist. And metadata and a contemporaneous email attaching a link to the unexcerpted video corroborate Sirpal's testimony that the videos existed in early January 2011. Paper 8 [POPR], 42; EX2001 [Sirpal Decl.], ¶79, EX2024, EX2025. The Board's failure to properly

weigh the un rebutted videos and other evidence is legal error and will only result in inefficient and unnecessary discovery.

Further, Petitioners do not dispute that they knew of the Imerj project and co-inventor Mo Selim at all relevant times, *including before the Petition was filed*. EX3001 at 1. Mr. Selim is an employee of Petitioner Google. Paper 10 [PO Prelim. Sur-Reply] at 9; EX3001. Mr. Selim’s webpage calls the Imerj prototype “a revolutionary product” and dated his work on Imerj to “2010-2011.” *Id.* The fact that Petitioners were aware of its employee’s work on the “revolutionary” Imerj project and failed to acknowledge that fact—let alone provide contradictory evidence or testimony from him—strongly suggests Petitioners could not establish unpatentability no matter how many more resources are wasted litigating before the Board.

The Board’s blanket failure to give any weight to the largely un rebutted and “voluminous” evidence submitted by Patent Owner is legal error. The Director should reverse the DI and deny institution.

C. Under The Director’s Guidance, This Dispute Would Be Better Resolved In An Article III Court

The Board also ignored the Director’s guidance that detailed evidentiary disputes such as this “are better resolved in an Article III court.” FAQ 21 (“as a matter of efficiency, extensive reliance on expert testimony” weighs against

institution.). While FAQ 21 addresses expert testimony, the same efficiency concerns are present with the witnesses (and experts) in this case. Forcing the Board to wade through hundreds of pages of witness testimony along with hundreds of exhibits to evaluate credibility is not an efficient use of the Board's or the Parties' time. *See, e.g.*, Interim Processes, 3 (“These processes aim to improve PTAB efficiency”).

The DI illustrates this point. Instead of addressing the issues and evidence presented, the DI refused to weigh Patent Owner's evidence and instead vaguely requested “further development of the evidentiary record.” Paper 11 [DI] at 25. In doing so, the Board authorizes full discovery on the large majority of claims where Petitioners were unable to identify any rebuttal. *Id.* The record at trial is likely to be much more detailed, resulting in much more evidence and testimony. The district court is better equipped to handle such issues, especially if credibility is involved. The Board should reverse for this additional reason as well.

V. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests Director Review of the Board's decision and that the Director reverse the DI and deny institution.

Date: May 30, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This paper contains 15 pages, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. This paper complies with the type-volume limitation of 15 pages as mandated in 37 C.F.R. § 42.24(a)(1)(v).

Respectfully submitted,

/Stephen P. McBride/

Date: May 30, 2025

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following document, **PATENT OWNER REQUEST FOR DIRECTOR REVIEW OF DECISION ON INSTITUTION** was served on the Petitioner by electronic service, by agreement between the parties, on the date below:

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