

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
SAMSUNG ELECTRONICS CO., LTD.;
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners,

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

Case No. IPR2025-00227
U.S. Patent No. 9,635,540

**PATENT OWNER'S AUTHORIZED RESPONSE TO
PETITIONERS' REQUEST FOR REHEARING¹**

¹ Authorized pursuant to the PTAB's July 28, 2025 email to the parties in this proceeding. *See* Ex. 3100.

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35 U.S.C. § 314(d) 2

I. THE DECISION PROPERLY EXERCISED THE DIRECTOR'S DISCRETION TO DENY INSTITUTION "BASED ON A HOLISTIC ASSESSMENT OF ALL OF THE EVIDENCE AND ARGUMENTS PRESENTED"

The June 25, 2025 Decision Granting Patent Owner's Request for Discretionary Denial and Denying Institution of *Inter Partes* Review ("Decision") was correctly decided and should not be disturbed. It reflected sound exercise of the Director's discretion to deny institution of this proceeding "based on a holistic assessment of all of the evidence and arguments presented" (Decision, at 4), which is the proper standard.²

Petitioners' request for rehearing of the Decision ("Req.") is based on Petitioners' incorrect and misguided view that Petitioners are somehow entitled to institution as a matter of law. However, directly contrary to Petitioners' argument, the Supreme Court has held that a decision whether to institute review in *inter partes* review proceedings "is a matter committed to the Patent Office's discretion." *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016). In addition, the Supreme Court has held that the patent statute **bars review** of a Director's institution decision where, as here, "the grounds for attacking the decision to institute *inter*

² As noted in the Decision, Acting Director Coke Morgan Stewart "has delegated her authority in a Notice of Delegation." Decision, at n.1. Accordingly, pursuant to such delegation, the Decision exercising the Director's authority and discretion was issued by Kalyan K. Deshpande, Acting Deputy Chief Administrative Patent Judge. *Id.*

partes review consist of questions that are closely tied to the application and interpretation of statutes related to the Patent Office’s decision to initiate *inter partes* review.” *Thryv, Inc. v. Click-to-Call Techs., LP*, 140 S. Ct. 1367, 1369 (2020) (citing *Cuozzo*, 136 S. Ct. at 2141); 35 U.S.C. § 314(d) (“[t]he determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable”).³

Petitioners improperly seek to rehash the same arguments the Decision expressly and correctly considered as part of its “holistic assessment of all of the evidence and arguments presented.” Decision, at 4; *see also id.* at 3 (“This determination is based on the totality of the evidence and arguments the parties have presented.”). Petitioners, however, ignore that the Decision is strongly supported by the evidence including as set forth in detail in Patent Owner’s Discretionary Denial Brief (“Br.”).

For example, citing Patent Owner’s Brief, the Decision correctly decided that “it is an inefficient use of Board resources to review the ’540 Patent that has been

³ *See also Apple Inc. v. Iancu*, No. 5:20-CV-06128-EJD, 2021 U.S. Dist. LEXIS 218143, at *18 (N.D. Cal. Nov. 10, 2021) (holding that in order to “inquire into the lawfulness of the *NHK-Fintiv* rule, the Court would have to analyze ‘questions that are closely tied to the application and interpretation of statutes related to the [Director’s] decision to initiate inter partes review,’” which the Supreme Court’s *Cuozzo* decision “forbids”); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential).

dismissed from the district court litigation” (Decision, at 4), especially where, as here, Patent Owner has stipulated (the “*Mullen* Stipulation”) that it will “not assert again in the future against the Samsung petitioners any claim challenged in this Petition.” Br., at 10.

In addition, the Acting Director’s 2025 Memorandum enumerated “relevant considerations” for determining when to discretionarily deny institution of an IPR—all of which support the Decision’s denial of institution here. These include:

- “Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;”
- “Settled expectations of the parties, such as the length of time the claims have been in force;”
- “The strength of the unpatentability challenge;” and
- “The extent of the petition’s reliance on expert testimony[.]”

2025 Memorandum, at 2.

The strong bases that support the Decision’s denial of institution in this proceeding, and the reasons why the Director should rejected Petitioners’ request for rehearing or reconsideration, are as follows:

A. The Decision was Proper Because the *Mullen* Stipulation Renders It an Inefficient Use of Resources to Review the Subject Patent that Has Been Dismissed From the Litigation

The Decision correctly decided that “it is an inefficient use of Board resources to review the ’540 Patent that has been dismissed from the district court litigation.” Decision, at 4.

Indeed, Petitioners’ impetus for preparing the Petition (“Pet.”) was the assertion of the ’540 Patent in the parallel district court litigation. Pet., xiii.⁴ However, as the ’540 Patent was dismissed from the district court litigation and is no longer in dispute, denying institution will prevent unnecessary expenditure of the PTAB’s and the parties’ resources. As even former Director Vidal pointed out, post-grant proceedings like this one were established to “‘limit unnecessary and counterproductive litigation costs.’” Ex. 2002 at 1 (citing H.R. Rep. No. 112-98, pt. 1, at 40 (2011), 2011 U.S.C.C.A.N. 67, 69; *see* S. Rep. No. 110-259, at 20 (2008)).

In addition, as noted above, the Patent Owner has made its “*Mullen* Stipulation” in this proceeding in which Patent Owner has agreed it will “not assert again in the future against the Samsung petitioners any claim challenged in this Petition.” Br., at 10. This stipulation thus further confirms that instituting review

⁴ *Mullen Industries v. Samsung et al.*, No. 2:24-cv-00049-JRG (E.D. Tex.).

would be inefficient and supports the Decision’s denial of institution, notwithstanding that the claims of the ’540 Patent were dropped from the district court litigation. *E.g.*, *Samsung Elecs. Co., Ltd. v. Mojo Mobility Inc.*, IPR2023-01094, Paper 11 at 11 (PTAB Feb. 9, 2024) (“Patent Owner has stipulated not to assert infringement of any claims challenged in the Petition that have been or will be dropped from the Texas Litigation. . . . This diminishes the significance of the non-overlapping claims. We determine that, as in *Fintiv*, it would be inefficient to proceed.”); *see also SK Innovation Co. v. LG Chem., Ltd.*, IPR2020-01036, Paper 13 at 17 (PTAB Nov. 30, 2020) (“Additionally, Patent Owner’s stipulation that it will not present for the district court trial any claims challenged in the Petition but not addressed in the ITC’s final determination further minimizes ‘concerns of inefficiency and the possibility of conflicting decisions.’ *Fintiv*, Paper 11 at 11.”).

Petitioners’ argument that “Google is not a party to the Samsung litigation” is of no moment, misleading, and does not change the analysis. Req., at 9. *See e.g.*, *Fintiv*, IPR2020-00019, Paper 11 at 14 (“Even when a petitioner is unrelated to a defendant, however, . . . the Board may, nonetheless, exercise the authority to deny institution”); *Mylan Labs. Ltd. v. Janssen Pharms. N.V.*, IPR2020-00440, Paper 17 at 12 (PTAB Sept. 16, 2020) (denying institution under *Fintiv* in light of an upcoming district court trial notwithstanding that the petitioner was **not** the defendant in that trial), *aff’d*, 989 F.3d 1375, 1378 (Fed. Cir. 2021)).

It also cannot be genuinely disputed here that co-Petitioner Google LLC *is* related to, and collaborating with, the Samsung entities in both the district court case and this IPR proceeding. The Samsung Petitioners are the defendants in the upcoming November 3, 2025 district court trial, and Petitioner Google LLC, while not a named party in the district court proceeding, is voluntarily participating on Samsung's behalf in the district court case. Specifically, in the district court case, it is indisputable that Google LLC has (i) voluntarily submitted declarations on Samsung's behalf, (ii) produced documents and source code in response to subpoenas, and (iii) is represented by the same outside counsel that represents the Samsung entities. The Samsung Petitioners and co-Petitioner Google LLC are thus related, collectively involved in the district court case, and cooperating in the district court case on each other's behalf. Petitioners' citation to *CSPC Pharm. Grp. Ltd. v. Ipsen Biopharm Ltd.*, IPR2025-00505, Paper 11 (July 16, 2025) (*see* Req., at 11) is thus inapposite and misplaced because both Samsung and Google *are engaged, cooperating, and involved in* the parallel district court litigation.

B. The Decision was Proper Because the PTAB Has Already Adjudicated the Validity of the Challenged Patent Claims

The Decision also correctly held that the fact that “the ’540 Patent ... was the subject of an earlier proceeding in which the Board denied institution of *inter partes* review based on the merits” likewise favors denial of institution. Decision, at 4.

Indeed, Apple had previously petitioned the PTAB for *inter partes* review of the **same** claims challenged by the present Petition, and using much of the **same** art that the present Petition relies on, including the “Sheha” reference. Br., at 11. In the Board’s Decision denying institution of the Apple IPR, the Board held that Apple’s Sheha unpatentability grounds had “not demonstrated a reasonable likelihood of prevailing in establishing unpatentability of at least one claim of the ’540 patent.” *Id.* Thus, not only did the PTAB already adjudicate the patentability of the ’540 Patent in post-grant proceedings, ***the PTAB has already addressed, and rejected, a primary reference*** that Petitioners continue to rely heavily upon in the instant Petition.

Accordingly, as the Decision correctly held, this consideration strongly favors denying institution of the Petition.

Contrary to Petitioners’ apparent argument, the Decision did not implement a rigid rule that the PTAB could not “reconsider the validity” of the ’540 Patent. Req., at 7. Moreover, nothing required the Decision to credit Petitioners’ merits-based arguments. That is, the Decision was not required to adopt Petitioner’s argument that its addition (in addition to the “Sheha” Grounds previously considered in the Apple IPR) of another “set of Grounds ... never considered” in the Apple IPR raised compelling new issues. Req., at 8. The Decision, instead, was free to consider Patent Owner’s showing that such additional Grounds did not add anything meaningful to

Petitioners' challenges. *See, e.g.*, Br. at 12-13, 15-27. At bottom, Petitioners fail to demonstrate that the Decision erred.

C. The Decision was Proper Because there is a Settled Expectation of Validity for All Claims of the Subject Patent

Still further, the Decision correctly held that “the ’540 Patent has been in force since 2017” and that “settled expectations” likewise “tip the balance in favor of discretionary denial.” Decision, at 4.

As Patent Owner explained, there is a well-settled expectation that the ’540 Patent is valid. Br., at 12. The application that led to the ’540 Patent was filed over twenty years ago on March 25, 2003 and the ’540 Patent issued after fourteen years of prosecution. *Id.* In addition, the ’540 Patent has now been in force for over ***eight years***, and the PTAB has already confirmed its validity in post-grant proceedings. *Id.*; *see also supra* at Section I.B. Put simply, there was nothing improper in the Decision’s holding that Petitioner’s challenge does not rise to the level of warranting yet a further review of the ’540 Patent.

Petitioners’ citation to *Intel Corp. v. Proxsense LLC*, IPR2025-00327, Paper 12 at 2-3 (June 26, 2025) supports Patent Owner, not Petitioners. Req., at 1. Indeed, there, like here, the Director ***denied institution*** based on “settled expectations.” In addition, Patent Owner’s technologies ***have been*** “commercialized, asserted, marked, licensed, or otherwise applied in [the Petitioners’] particular technology

space,” which likewise confirms that the Decision’s reliance on “settled expectations” was appropriate. Indeed, Patent Owner’s patented technology had been used (infringed) for years at least by Apple, the Petitioners’ primary competitor, which resulted in Patent Owner’s prior suit against Apple.

Petitioners’ citation to *Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00531, Paper 10 (July 17, 2025), likewise supports Patent Owner, not Petitioners. Req., at 2. There, the petitioner presented “evidence that the challenged patents have never been commercialized, asserted, marked, licensed, or otherwise applied in Petitioner’s particular technology space.” In direct contrast, as noted above, Patent Owner presented evidence here that is patented technology had been used (infringed) for years at least by Petitioners’ primary competitor (Apple), which resulted in Patent Owner’s prior suit against Apple.

Lastly, Petitioners’ far-fetched argument that the Director is somehow precluded by judicial estoppel from considering “settled expectations” in the Director’s discretionary denial analysis is incorrect. Req., at 2-5. Petitioners rely heavily on *Celgene Corp. v. Peter*, 931 F.3d 1342 (Fed. Cir. 2019). *Id.* However, there, the PTAB merely took the position that IPRs are not unconstitutional. In other words, the PTAB took the position, and the Federal Circuit agreed, that it is not an unconstitutional “taking” for the PTAB to institute IPR proceedings. Contrary to Petitioners’ argument, there is simply no inconsistency with the Director’s additional

guidance that “settled expectations” can be considered as one factor within the Director’s “holistic analysis” in deciding whether to exercise discretion to deny institution of IPR proceedings. This is in no way a “clearly inconsistent” position that would need to be present as a prerequisite to Petitioners’ judicial estoppel argument. *See Trs. in Bankr. of N. Am. Rubber Thread Co. v. United States*, 593 F.3d 1346, 1353 (Fed. Cir. 2010) (explaining that judicial estoppel requires, for example, that “the party’s later position is ‘clearly inconsistent’ with its earlier position”).

D. The Decision was Proper Because the Merits of the Petition are Weak

Also supporting the Decision’s denial of institution is Patent Owner’s showing that Petitioners’ unpatentability challenges are weak. That Petitioners failed to demonstrate unpatentability here is not surprising because, as discussed *supra* at Section I.B, the Petitioners’ here still rely on much of the *same* art, including the “Sheha” reference, that was found to be deficient in Apple’s previously-filed IPR regarding the ’540 Patent.

Likewise favoring denial of institution on the merits, the Petition (i) strategically chose not to address known disputes over the claim terms’ meaning, (ii) recycled prior art grounds already dispensed with by the PTAB, and (iii) misread both the claims and the cited references. Br., at 12-13 (citing, *e.g.*, *Samsung Electronics Co, Ltd. v. California Institute of Technology*, IPR2023-00130, Paper 10

at 26 (PTAB May 4, 2023) (exercising discretion to deny institution because “[f]or essentially the reasons posed by Patent Owner, we agree that Petitioner’s showing is less than compelling, as it rests tenuously upon apparent logical leaps”); *Samsung Display Co., Ltd. v. Pictiva Displays Int’l Ltd.*, IPR2024-00855, Paper 12 at 13 (PTAB November 19, 2024) (exercising discretion to deny institution because “Petitioner’s challenges do not meet the compelling merits standard because a genuinely-disputed issue surrounds the correct [claim] construction That genuine dispute, in turn, casts doubt upon whether Petitioner ‘is highly likely’ to prevail in showing that the [claim] limitation would have been obvious over the asserted prior art references”)).

Petitioners cannot genuinely fault the Decision for Petitioners’ own strategy of attempting to repurpose Apple’s unsuccessful prior art and materially similar additive references. *E.g.*, Br., at 13.

E. The Decision was Proper Because Each Ground of the Petition Excessively Relied Upon the Declaration of a Purported Expert to Backfill Missing Information From the Cited References

Though not expressly referenced by the Decision, Patent Owner has also explained that Petitioners’ attempt to buttress lacking obviousness combinations with unsupported expert testimony also warrants discretionary denial. Br., at 13-15.

Each Ground of the Petition excessively relies on the declaration testimony of a purported “expert.” Indeed, the Petition cites to an expert declaration *hundreds* of

times, including to mischaracterize figures from the cited art and in attempts to backfill the references' plain deficiencies. Br., at 14. Unsurprisingly, the PTAB regularly rejects IPR challenges in such circumstances. *Id.* (citing *SFC Co., Ltd. v. LG Chem, Ltd.*, IPR2020-00178, Paper 16, at 37-39 (May 29, 2020); *TRW Automotive US LLC v. Magna Elecs. Inc.*, IPR2014-00258, Paper 16, at 19-23 (PTAB. Jun. 26, 2014) (rejecting obviousness analysis that failed to support rationale with supporting evidence and technical reasoning)).

Accordingly, contrary to Petitioners' arguments, the Decision committed no error when denying institution under the facts and circumstances here.

II. CONCLUSION

For each of the above-described reasons, Patent Owner respectfully requests the Director, or the Director's delegate, to deny Petitioners' Request for Rehearing of the Decision denying institution.

Dated: August 4, 2025

Respectfully submitted,

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