Paper No. __

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

_____

Case No. IPR2025-00366
Patent No. 11,234,117

PETITIONERS' REQUEST FOR REHEARING OF DECISION GRANTING PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL AND DENYING INSTITUTION OF *INTER PARTES* REVIEW

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I. INTRODUCTION

Petitioners respectfully request reconsideration of the Director's[1] decision discretionarily denying institution (Paper 16, "Decision"). As discussed below, the Decision is flawed in multiple respects, each of which warrants reversal.[2]

II. THE DIRECTOR'S "SETTLED EXPECTATIONS" FRAMEWORK CALLS FOR REFERRAL TO THE MERITS PANEL

The '117 patent issued only three years ago, in 2022. Under the Director's discretionary-denial framework that looks to "settled expectations"—in particular, ***lack thereof***—this should have resulted in this IPR being referred to the panel for consideration of its merits.

In other recent decisions, the Director has held that where the challenged patent "issued in 2022," the IPR is an "early challenge[] [that] favor[s] robust, predictable patent rights and weigh[s] against discretionary denial." *Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00573, Paper 9 (July 17, 2025); *see also Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00479,

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[1] References herein to the "Director" include Acting Director Stewart and/or any person to whom she delegated her authority to issue a discretionary decision.

[2] Unless otherwise indicated, all emphases herein are added, and internal citations are omitted.

Paper 10 (July 10, 2025) (where "the challenged patent issued in 2021," the "Patent Owner has not developed strong settled expectations that favor discretionary denial"); IPR2025-00486, Paper 9 (July 17, 2025) ("[IPR2025-00479, Paper 10's] analysis is incorporated here") (patent issued in 2020); *Amazon.com, Inc. v. SoundClear Techs. LLC*, IPR2025-00565, Paper 11 (July 10, 2025) (patent issued in 2021); *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, -00278, -00280, -00281, Paper 23 (July 2, 2025), IPR2025-00422, -00423, Paper 21 (July 17, 2025) (patents issued in 2019-2020); *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, -00436, Paper 11 (June 26, 2025), -00437, Paper 10 (June 26, 2025) (patents issued in 2019-2020).

In *Zhuhai CosMX Battery Co. v. Ningde Amperex Tech. Ltd.*, the Director held that because "the challenged patents have not been in force for a significant period of time (issued in 2024, 2023, and 2021)," this "tip[s] the balance against discretionary denial" despite it being "unlikely that a final written decision…will issue before district court trial occurs." IPR2025-00385, -00389, -00432, Paper 9 (July 2, 2025); IPR2025-00405, Paper 11 (July 2, 2025); IPR2025-00431, Paper 14 (July 2, 2025). In *Phison Electronics Corp. v. Vervain, LLC*, the Director explained that the fact that the challenged patent issued in 2021 "[o]rdinarily…might favor referral to the Board" despite the fact that the district

court's scheduled trial date was eight months before the Board's projected FWD due date. IPR2025-00215, Paper 15 (July 10, 2025). The only reason that IPR was denied was that Phison "ha[d] not offered a stipulation to address concerns of duplicative efforts and potentially conflicting decisions" (*id.*); whereas here the Samsung Petitioners have offered a *Sotera* stipulation (EX1079).

"Discretion is not whim," and must be "limited" according to "legal standards" to "promote the basic principle of justice that like cases should be decided alike." *Martin v. Franklin Cap. Corp.*, 546 U.S. 132, 139 (2005). As discussed above, the Director has held in other recent cases that a challenged patent having "not been in force for a significant period of time" because it issued in 2021 is a "consideration[] counseling against discretionary denial [that] outweigh[s] those that favor it." *Zhuhai*, IPR2025-00385, Paper 9. The Director should have denied Mullen's discretionary-denial request on that same basis here, where the '117 patent issued even more recently in 2022.

Additionally, as Petitioners' Opposition (Paper 15) pointed out, Mullen has never commercialized any product or service practicing the '117 patent—indeed, Mullen "makes no products, offers no services, and has no apparent business other than filing lawsuits." Opposition at 6. And Mullen did not assert the patent until recently in 2022. Opposition at 2. These facts, too, should have weighed against discretionary denial under the framework the Director has promulgated. *See*

Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc., IPR2025-00438, -00531, -00532, -00585, Paper 10 (Director July 17, 2025) (declining to discretionarily deny IPRs on patents issued in 2015, 2020, and 2021 despite district-court trial date, explaining that "evidence that the challenged patents have never been 'commercialized, asserted, marked, licensed, or otherwise applied' in Petitioner's 'particular technology space'" weighs against denial) (quoting *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 (Director June 26, 2025)).

The Decision denying institution should be reversed and the Petition should be referred to the merits panel.

III. THE DECISION'S APPLICATION OF *FINTIV* IS INACCURATE AND INCOMPLETE

The Decision does not properly weigh other relevant factors against the trial-timing factor as required by the PTAB's *Fintiv* precedent. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5 (Mar. 20, 2020) (precedential) ("As with other ***non-dispositive*** factors considered for institution under 35 U.S.C. § 314(a), an early trial date should be weighed as part of a 'balanced assessment of ***all relevant circumstances*** of the case, including the merits.'") (quoting Consolidated Trial Practice Guide November 2019 ("TPG") at 58). For example, the Decision does not even mention, much less properly address and weigh, the significant facts and arguments Petitioners raised under *Fintiv* Factors 4-6 (Opposition at 21-40),

discussed further below. Additionally, the Decision's assessment of the trial timing itself was inaccurate.

A. The Decision Did Not Acknowledge and Properly Weigh the Significant Number and Percentage of the Patent's Claims That Will Not Be Addressed in the District Court

The '117 patent contains 92 claims. This IPR's Petition (which challenges 27 of those claims), together with Petitioners' IPR2025-00365 and -00367 (which challenge the other 65 claims), demonstrate that all of them are unpatentable. In the district court, Mullen originally asserted ***all 92*** of those claims, requiring Samsung to address all of them in contentions and ten of them in claim construction, but now has elected only five of the 92 claims (i.e., only one or two of the claims challenged in each IPR) to potentially expose to invalidity scrutiny at trial. Opposition at 22, citing EX1085. All 92 of the '117 patent's claims are unpatentable as demonstrated in Petitioners' IPR Petitions, but the district court will never have the opportunity to address 95% of them (87 of the 92 claims). By discretionarily denying Petitioners' IPRs, the Director guarantees that Mullen will emerge from its Samsung litigation holding 87 intact claims to assert against companies that actually provide products or services in the United States, consuming their resources, despite the fact that Mullen has no valid right to those unpatentable claims.

This near-complete lack of overlap between the 27 claims demonstrated unpatentable in this IPR Petition and the two of those claims whose invalidity the district-court litigation will ever have the possibility of addressing should have weighed heavily against denying institution based on the litigation. Yet the Decision does not even mention it. The Decision should be reconsidered and reversed.

B. The Decision Did Not Acknowledge and Properly Weigh the Fact That Petitioner Google Is Not a Party to the Litigation

As Petitioners' brief explained, Google is a party to this IPR but is not a party to the district-court proceeding. Opposition at 37-39. Mullen's choice to allow only two challenged claims to be addressed in district court while stipulating not to assert others of this IPR's challenged claims of the '117 patent against Samsung does nothing to address Google's challenge and Google's interest in preventing those 25 other unpatentable claims from being asserted against future targets beyond Samsung. Opposition at 23. Google's IPR Petition, as an early challenge to a 2022 patent whose claims are unpatentable and a proven drain on the industry, is precisely the type of challenge the Director has recently encouraged parties to proactively present. *See Charles River Labs., Inc. v. Seikagaku Corp.*, IPR2025-00440, Paper 9 (July 10, 2025) (referring petition to merits panel where "Patent Owner and Petitioner are not engaged in a parallel litigation" and "the

challenged patent issued on February 1, 2022," because "[e]arly challenges favor robust, predictable patent rights and weigh against discretionary denial").

This factor should have weighed heavily against denial; yet the Decision does not even mention it. Denying this IPR because of the litigation against Samsung perversely penalizes Google for conserving the Board's resources by filing one Petition together with the Samsung co-Petitioners rather than each entity filing its own separate petition. Opposition at 20. The Decision should be reconsidered and reversed.

C. The Decision Did Not Acknowledge and Properly Weigh the Merits of the Petition's Unpatentability Challenge Against the Trial Timing

The PTAB's *Fintiv* precedent requires a "balanced assessment of all relevant circumstances of the case, ***including the merits***." *Fintiv*, IPR2020-00019, Paper 11 at 5 (quoting TPG at 58). Petitioners' brief demonstrated that the Petition's merits are compelling and strong, as the challenged independent claims are substantive replicas of claims challenged in Petitioners' IPR2025-00019 and -00021, this Petition's unpatentability grounds mirror those in those corresponding IPRs, and the only arguments Mullen could muster against this Petition's grounds are the ***same*** arguments that the Board's merits panel correctly ***rejected*** in granting institution of those corresponding IPRs. Opposition at 40-43; *see also id.*, 43-52. The Decision improperly does not acknowledge or address this showing, and

ignores the merits panel's recent determinations in those corresponding IPRs that the Petitions' "***merits are strong***." Opposition at 41 (quoting IPR2025-00019, Paper 14 at 13; also citing IPR2025-00021, Paper 14 at 12).

Additionally, the Decision improperly does not acknowledge or address the fact that the Board previously instituted Apple's IPR2023-00116 that presented a similar Sheha-based ground as this Petition does against the same claims of the '117 patent. Opposition at 41. Like in the Director's recent *Tesla* decisions, "discretionary denial of institution is not appropriate" here, where "the merits are strong because the Board previously determined there was a reasonable likelihood" that the claims "were unpatentable." *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, -00219, -00220, -00221, -00222, Paper 9 at 2 (June 13, 2025); IPR2025-00339, Paper 10 at 2 (June 13, 2025); *see* Opposition at 1, 3-5, 39-40.

D. The Decision Inaccurately Assessed the Prospective Timing of the District-Court Trial

Although the scheduled trial date in Mullen's lawsuit against Samsung in the Eastern District of Texas ("EDTX") is in November 2025, the Decision states that "the time-to-trial statistics suggest trial will begin in September 2025." This is not accurate. The most recently reported median time-to-trial for EDTX is 25.9 months, which would place the district-court trial in March 2026. EX1099 at 35; Opposition at 13-14. That is only five months before the August 2026 projected final written decision due date here. And EDTX has likely become only more

congested since this most recent statistic was compiled for the period ending March 31, 2025.

Further, the Decision does not acknowledge or address the evidence that post-trial briefing and decisions before Judge Gilstrap will likely take four months or more, such that the Board's final written decision may well precede the district court's final judgment. Opposition at 16-17, citing EX1087.

IV. THE DECISION'S FAILURE TO CREDIT PETITIONER'S *SOTERA* STIPULATION IS IMPROPER

On June 21, 2022, the Office issued a Memorandum authored by then-Director Vidal ("Vidal Memo")[3] stating that, "[c]onsistent with *Sotera Wireless, Inc.*, the PTAB will ***not*** discretionarily deny institution in view of parallel district court litigation 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." Vidal Memo at 3 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (Dec. 1, 2020) (precedential as to §II.A)). The Vidal Memo states that it was "issued under the Director's authority to issue ***binding agency guidance to govern*** the PTAB's implementation of various statutory provisions." Vidal Memo at 3 (citing 35 U.S.C. 3(a)(2)(A)).

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[3] https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

Over the course of several months in 2024, in reliance on this "***binding*** agency guidance," Petitioners prepared and filed this and two other IPRs to challenge all 92 claims of the '117 patent, as well as eight additional IPRs against 247 claims of seven other patents that Mullen had asserted against Samsung. While Petitioners were diligent in preparing all these IPRs, Petitioners nonetheless also relied on the Vidal Memo and reasonably expected that there would be no risk of discretionary denial in view of the parallel EDTX proceeding even if it took several months to fully develop robust and thoroughly supported patentability challenges to all 339 claims of these eight asserted patents. That is, Petitioners understood that there was no need to "race to the PTAB" so long as Samsung was willing to present a *Sotera* stipulation.

The Samsung Petitioners presented precisely such a stipulation by agreeing to "not pursue in the [district court] litigation any grounds that were raised or reasonably could have been raised in the IPR" if the IPR were instituted. EX1079. This is undisputedly the type of *Sotera* stipulation that the Vidal Memo said in no uncertain terms would dispositively prevent the PTAB from discretionarily denying institution in view of parallel district court litigation. Vidal Memo at 3 ("the PTAB will ***not*** discretionarily deny institution in view of parallel district court litigation 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"), 7 ("the PTAB will ***not*** discretionarily deny institution of an IPR…in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition"), 9 ("the PTAB will ***not*** deny institution of an IPR…under *Fintiv*…where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition").

Then, on February 28, 2025, the Office under new Acting Director Stewart rescinded the Vidal Memo without notice and without providing any explanation as to why the Vidal Memo was being rescinded. In rescinding the Vidal Memo, the Office did not suggest that the rescission should be applied retroactively and did not seek public comment on any such retroactive application.

A month later, the Office issued a new Memorandum by Judge Boalick ("Boalick Memo")[4] stating that, contrary to the Vidal Memo's guidance, "a timely-filed *Sotera* stipulation…will not be dispositive by itself," and that the Vidal Memo's "recission applies to any case in which the Board has not issued an

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[4] https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf

institution decision, or where a request for rehearing or Director Review of an institution decision was filed and remains pending." Boalick Memo at 2-3. Thus, after having induced Petitioners' reliance on the Vidal Memo's guidance that the *Sotera* stipulation would dispositively preclude discretionary denial based on the district court proceeding, the Office unfairly changed the rules of the game by retroactively applying the recission of the Vidal Memo to this IPR whose Petition had long since been filed and whose timing could not possibly be changed.

The Director's Decision denies institution of this IPR based on finding that "it is unlikely that a final written decision in these proceedings will issue before the district court trial occurs." This basis for discretionary denial undisputedly would not have been available under the Vidal Memo in view of Petitioner's *Sotera* stipulation. It is a violation of due process and the APA for the Director to retroactively apply the recission of the Vidal Memo's "binding" guidance to this Petition that had already been filed months before the Vidal Memo was rescinded, and whose timing in relation to the district court proceeding had already been set in reliance on that guidance. Opposition at 26-27; *see, e.g., Perry v. Sindermann*, 408 U.S. 593, 601 (1972) ("A person's interest in a benefit is a 'property' interest for due process purposes if there are such rules or mutually explicit understandings that support his claim of entitlement to the benefit…."); *FDA v. Wages & White Lion Invs., LLC*, 145 S. Ct. 898, 918 (2025) ("[W]hen an agency issues guidance, it

cannot 'change the requirements set forth therein without consideration of applicants' reasonable reliance interests, proper notice to applicants, and a reasonable opportunity for applicants to conform to the changed requirements."); *Dep't of Homeland Sec. v. Regents of the Univ. of Cal.*, 591 U.S. 1, 30-31 (2020) (similar); *Mexichem Fluor, Inc. v. EPA*, 866 F.3d 451, 462 (D.C. Cir. 2017) ("The Due Process Clause limits the Government's authority to retroactively alter the legal consequences of an entity's or person's past conduct. To satisfy the Due Process Clause, [an agency] must at a minimum 'provide regulated parties fair warning of the conduct a regulation prohibits or requires.'"); *Smith v. Metro. Sch. Dist. Perry Twp.*, 128 F.3d 1014, 1039-40 (7th Cir. 1997) ("[W]e must…refrain from giving retroactive effect to agency policy guidelines."); *McDonald v. Watt*, 653 F.2d 1035, 1044 (5th Cir. 1981) ("In general, the ill effect of retroactivity is the frustration of the expectations of those who have justifiably relied on a prior rule.").

The Office's recent FAQ #14[5] advises that "[w]here the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful." Likewise,

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[5] https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management

recent Director discretionary decisions have only credited a petitioner's stipulation as weighing against discretionary denial if the stipulation is "broad"—i.e., even broader than the scope of §315(e) estoppel invoked in *Sotera*. *See Shenzhen*, IPR2025-00438, Paper 10 at 3; *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2 (June 13, 2025). The implication of the Decision here is that the Director faulted Samsung's *Sotera* stipulation for not agreeing to forego in the district court Samsung's "other invalidity theories," including those relying on "system art" that could never have been brought in IPR. FAQ #14. This *ultra vires* basis for the Decision further violates the APA and separation of powers by end-running around the statute establishing the type of grounds permitted in IPR and the proper scope of estoppel (i.e., the grounds that an IPR petitioner should forego in district court) that already ensures IPR is a true alternative to the district court and *vice versa*. 35 U.S.C. §311(b), §315(e); *see, e.g., Util. Air Regul. Grp. v. EPA*, 573 U.S. 302, 327-28 (2014) ("[A]n agency may not rewrite clear statutory terms to suit its own sense of how the statute should operate.") ("Were we to recognize the authority claimed by [the agency], we would deal a severe blow to the Constitution's separation of powers."); Opposition at 30-31.

As the Federal Circuit explained in *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365 (Fed. Cir. 2025), "Congress intentionally limited an IPR's scope

to invalidity challenges based on 'prior art consisting of patents or printed publications.' 35 U.S.C. § 311(b). By design, a petitioner has no opportunity to challenge that the claimed invention was known or used by others, on sale, or in public use at IPR" based on system art. The IPR system that Congress designed by statute "does not preclude a petitioner from asserting" in district court "different grounds that could not be raised during an IPR." *Ingenico*, 136 F.4th at 1367. The Director does not have discretion to pressure petitioners to forego district-court defenses that could never have been raised in IPR in order to have their much more limited IPR grounds even considered on the merits.

For each of these reasons and those already discussed in Petitioners' Opposition at 26-37, the Decision's failure to credit Samsung's *Sotera* stipulation and refer this Petition to the merits panel is improper and should be reversed.

V. CONCLUSION

For each reason above, the Decision denying institution should be reversed.

Respectfully submitted,

Date: July 25, 2025

/Elisabeth Hunt/

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)

I certify that on July 25, 2025, a copy of the foregoing document, including any exhibits or appendices filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

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Date: July 25, 2025

/Dara Del Rosario/
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