

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

MURATA MANUFACTURING CO., LTD,
Petitioner,

v.

GEORGIA TECH RESEARCH CORPORATION,
Patent Owner.

IPR2025-00383 (Patent 7,489,914 B2)
IPR2025-00384 (Patent 7,489,914 B2)

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

DECISION
Denying Institution of *Inter Partes* Review

Georgia Tech Research Corporation (“Patent Owner”) filed a request for discretionary denial (Paper 9, “DD Req.”) in the above-captioned cases, and Murata Manufacturing Co., LTD (“Petitioner”) filed an opposition (Paper 12, “DD Opp.”).¹

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in these proceedings. This determination is based on the totality of the evidence and arguments the parties have presented.

Some factors counsel against discretionary denial. For example, there is no trial date set for the parallel district court proceeding involving Petitioner and Patent Owner. DD Opp. 8. As a result, there is currently no concern of inconsistent outcomes and duplication of efforts resulting from two proceedings operating in parallel. Additionally, in addressing the marking provisions of 35 U.S.C. § 287 in the parallel district court proceeding, Patent Owner asserts that it has never commercialized the challenged patent or marked any product with the number of the challenged patent. DD Opp. 19–20 (citing Ex. 1035, 18, 23).

Other factors, however, weigh in favor of discretionary denial. In particular, the challenged patent has been in force for more than 16 years, creating strong settled expectations for Patent Owner. Additionally, Petitioner and Patent Owner had discussions in 2007 regarding the technology space involving the challenged patent. *See, e.g.*, DD Opp. 21–26. Therefore, Petitioner was aware that Patent Owner was involved in the same technology space for a significant amount of time before filing its

¹ Citations are to papers in IPR2025-00383. The parties filed similar papers in IPR2025-00384.

Petition challenging Patent Owner's patent. A failure to seek early review of the patent favors denial and outweighs the above-discussed considerations.

Although certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions are denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *granted*; and

FURTHER ORDERED that the Petitions are *denied*, and no trial is instituted.

IPR2025-00383 (Patent 7,489,914 B2)

IPR2025-00384 (Patent 7,489,914 B2)

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