

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.

Petitioner,

v.

TJTM TECHNOLOGIES, LLC,

Patent Owner.

Case IPR2025-00586

Patent No. 8,958,853

**PATENT OWNER'S REQUEST TO DIRECTOR FOR
DISCRETIONARY DENIAL OF INSTITUTION**

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I. Introduction

Pursuant to the Interim Process for PTAB Workload Management memorandum dated March 26, 2025, Patent Owner respectfully requests that the Director exercise her discretion over institution of AIA proceedings under 35 U.S.C. §§ 314(a) and 324(a) and deny institution of IPR2025-00586, because the District Court found every challenged claim subject to this petition to be invalid. The Director should deny institution, having recently made it clear in *Hulu LLC v. Piranha Media Distribution, LLC* (IPR2024-01253), Paper 27, published March 4, 2025 (routine decision) that *Fintiv* strongly favors discretionary denial when claims have already been held invalid by a court.

The USPTO's new leadership has swiftly moved to clarify that discretionary denial should be exercised in accordance with binding guidance—rescinding on February 28, 2025 the 2022 interim guidance that had constrained such denials.

Petitioner has already persuaded a district court to find every claim is invalid under 35 U.S.C. § 101, and, as is well known, victory on appeal is statistically improbable. There is no need, and no reason, for the Office to *also* reconsider the claims. Institution should be denied in accordance with *Fintiv*.

II. Background

The '853 Patent issued in 2015 from a continuation of application no. 14/176,107 filed February 9, 2014, which claimed priority to U.S. Provisional Application No. 61/835,234 filed June 14, 2013.

Patent Owner filed an enforcement action on March 7, 2024 against Petitioner. Petitioner filed this IPR petition on March 5, 2025, on the eve of the one-year anniversary of the enforcement action, and months after the District Court ruled that all claims were invalid under § 101.

In the district court litigation, Petitioner filed a motion to dismiss under Rule 12(b)(6), asserting that the claims challenged in this proceeding are invalid as reciting ineligible subject matter under § 101. The District Court agreed with Petitioner and issued a decision granting Petitioner's motion to dismiss and dismissing with prejudice Patent Owner's infringement claim on October 22, 2024. *Ex. 1018, Docket Order.*

Because the patent claims already stand invalid, it is unnecessary to institute another proceeding to review them for patentability under other grounds. In the event the Federal Circuit reverses the district court's decision, Petitioner may raise such invalidity arguments in the district court on remand. Under these circumstances, that is the better and more efficient approach. *See, Hulu LLC v. Piranha, supra*, Paper 27, at 2-3.

III. The Director Should Again Rule that a District Court Final Judgment of Invalidity Favors Denial of an IPR Under NHK/Fintiv.

“The Director is permitted, but never compelled, to institute an IPR.” *Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1382 (Fed. Cir. 2021).

Both the Director’s routine *Hulu* decision and the Board’s precedential *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019) and *Fintiv* decisions address the role, in the decision whether to institute an IPR, of the pendency of district-court infringement litigation involving the same patents.

The Federal Circuit also emphasized the pendency of a district court proceeding in *Apple Inc. v. Vidal*, 63 F.4th 1, 8 (Fed. Cir. 2023). “The decisions articulate a discretionary standard for denying IPR petitions based on pending parallel litigation,” which may “rel[y] on the advanced state of the district court proceeding involving the same patent to deny institution, reasoning that, given the projected trial date in the parallel court case, conducting an IPR would be an inefficient use of agency resources.” *Id.* (internal quotation marks omitted).

A. The Director’s Routine Hulu Decision Resolved a Prior Split in Cases Applying Fintiv.

Many IPRs, including Director Review decisions, have addressed the question whether “the state of the district court proceeding involving the same patent” supports denial of institution under *NHK/Fintiv* when, in pending parallel litigation, a district court has already granted final judgment of invalidity under § 101 on the challenged claims. See, e.g., *Hulu LLC v. Piranha Media Distribution, LLC* (IPR2024-01253), Paper 27 (Dir. Mar. 4, 2025) (routine decision

denying institution where district court had found claims invalid under § 101); *AviaGames, Inc., v. Skillz Platform Inc.*, IPR2022-00530, Paper 12 (Aug. 9, 2022) (denying institution where district court had found claims invalid under § 101), *remanded*, Paper 14) (Dir. Mar. 2, 2023), *denial reinstated*, Paper 15) (Mar. 22, 2023). This is a critically important question under *Fintiv*. A core “directive” of *NHK/Fintiv* is that the “concerns of inefficiency and the possibility of conflicting decisions [a]re particularly strong” when “the time to trial in the district court case” will substantially precede the time to trial in an instituted IPR. *Apple*, 63 F.4th at 9; *see Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 Pat. App. LEXIS 13179, *8, 2020 WL 2126495 (Mar. 20, 2020) (precedential) (“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.”).

Logically, if a district court’s trial date earlier than the projected IPR deadline generally weighs in favor of discretionary denial, the same is all the more true if the trial court has already reached a final judgment of invalidity. *See, e.g., AviaGames*, Paper 12, 12-13 (“[a]s the District Court has completed its consideration of the [challenged] patent, we determine [*Fintiv* Factor 2] weighs heavily in favor of denying institution”). Most panel decisions applying *Fintiv* to this situation, including the *Hulu* and *AviaGames* Director Review decisions, have found that a prior district court judgment of § 101 invalidity favors denial of institution under *Fintiv*, just as makes sense under *Fintiv*’s reasoning.

A few non-binding Board panel decisions have taken a different view. *See, e.g., BMW of N. Amer. v. Mich. Motor Techs., LLC*, IPR2023-01224, Paper 12 (Feb. 15, 2024) (split decision 2-1). Such decisions, two of which were authored by the same administrative patent judge, reach a conclusion opposite to the Director’s decisions: that *Fintiv*’s factors almost all favor ***institution*** when the

district court has already concluded with a § 101 invalidity judgment. *Google LLC, v. Geoscope Techs. Pte. Ltd.*, IPR2023-01213, Paper 14 (Feb. 20, 2024), and *Apple Inc. v. Geoscope Techs. Pte. Ltd.*, IPR2024-00255, Paper 14 (May 31, 2024). But in almost all of these institution-favoring cases, only a subset of the claims challenged in the IPR were invalidated by the court under § 101. And unlike well-reasoned decisions applying *Fintiv*, like *AviaGames*, these cases fail to analyze the efficiency implications of the low statistical chance of success patent owners face on appeal—and the fact that, if the district court’s invalidity judgment is affirmed, the work in the instituted IPR will have been wasted, as has happened in several cases that refused to deny institution under *Fintiv* in this situation. *See, e.g., Snap, Inc. v. Sanderling Mgt. Ltd.*, IPR2021-00781, Paper 42, 2 (Dec. 28, 2022) (cited in *AviaGames* as having ended with the district court invalidity ruling intact); *Chegg, Inc. v. NetSoc, LLC*, IPR2019-01165, Paper 14, 11-13 (Dec. 5, 2019) (instituting IPR despite district court invalidity judgment); *id.*, Paper 37, 2 (Jan. 31, 2022) (dismissing IPR after affirmance of district court judgment).

In *AviaGames*, as in this case, “before the Patent Owner filed its Preliminary Response, the United States District Court . . . issued a decision determining that most of the challenged claims of the [challenged] patent were invalid as directed to patent-ineligible subject matter under 35 U.S.C. § 101.” *AviaGames*, Paper 14, 2; *see, also, Hulu, supra* (recent Director’s decision). Unlike this case, where *all* challenged claims have been held invalid, in *AviaGames* only **most** of the claims-at-issue had been held invalid. The *AviaGames* Board panel conducted an analysis of the *Fintiv* factors in light of that district court § 101 judgment, and determined that all favored denial of institution. *AviaGames*, Paper 12, 11-15. Weighing the factors, the panel found that “because a district court determined that the challenged claims were invalid under § 101, ‘the interests of efficiency and

integrity of the system would be best served by invoking to deny institution.””
Paper 14, 2.

The Director granted review, vacated the panel’s denial of institution, and remanded. Critically, the Director did not disturb any of the existing findings of the panel under the express *Fintiv* factors. *Id.*, 5-6. The Director’s only criticism of the panel’s analysis was that it had not applied the new “compelling merits” test, which Director Vidal thought needed to be balanced against the risk of inefficiency from instituting review of claims that had already been held invalid by the district court. *Id.*, 3, 5-6. The Director did not otherwise disturb the panel’s determination that the *Fintiv* factors all disfavored institution; indeed, she expressly directed that “[i]f the Board finds the record does not rise to th[e] high standard” of compelling merits the Board should “deny institution,” as it had before Director Review had been granted. *Id.* On remand, the Board found “the compelling merits standard” to be not met, and reinstated its denial of review under *Fintiv*. *Id.*, Paper 15, 27. Thus, the Board denied institution under both the ordinary standard and the no longer applicable “compelling merits standard” based on the district court’s determination that the challenged claims were invalid under § 101.

The Director’s decision in *Hulu* to deny institution reached the same result as in *AviaGames*, on a summary basis, without finding it necessary to weigh individual *Fintiv* factors. “Nevertheless, the *Fintiv* framework emphasizes efficiency concerns, and *Fintiv* encourages the parties to explain the impact of other facts and circumstances that exist in their proceeding on efficiency and integrity of the patent system. *Fintiv*, Paper 11 at 16. Here, as explained above, where a district court already has found the challenged claims invalid, the efficiency and integrity of the patent system is best served by denying institution.”

B. *The § 101 Invalidity Judgment Strongly Supports Fintiv Denial.*

The *Fintiv* analysis in *AviaGames* (followed by many other cases) clearly supports denial based on the § 101 judgment.

Factor 1: “the district court case cannot be stayed because it has concluded.” *E.g., AviaGames*, Paper 12, 23.

Factor 2: “the District Court has completed its consideration of the [’853] patent,” so “this factor weighs heavily in favor of denying institution.” *Id.*, 12-13.

Factor 3: favors denial “if, at the time of the institution decision, the District Court has issued substantive orders related to the patent.” *Fintiv*, 9-10. The § 101 “invalidity determination is a substantive order related to the [’853] patent,” so “this factor weighs in favor of denying institution.” *AviaGames*, Paper 12 , 13.

Factor 4: Here, “all... of the claims challenged in the petition are also at issue in district court,” *Fintiv*, 12-13—so here, even more than in *AviaGames*, where only *some* challenged claims were invalidated by the district court, “this factor favors discretionarily denying institution,” *AviaGames*, Paper 12 , 14 .

Factor 5: The petitioner and the defendant in the parallel proceeding are the same party. So this factor, too, weighs in favor of discretionary denial. *Id.*

Factor 6: As for other factors, merits of this Petition are addressed in the following section.

Even without reaching the merits, a canvass of the cases that have *declined* to deny institution in this situation reveals that granting institution has time and again led to waste and inefficiency—because when the court’s § 101 judgment has

been affirmed after the IPR was instituted, it moots and terminates the IPR, wasting months of toil. *See AviaGames*, Paper 12 , 9-10 & n.9. That may explain the Director's recent decision in *Hulu*, on a summary basis without going through the *Fintiv* factors in detail.

C. *The Merits Further Support Fintiv Denial.*

The Board's April 17, 2025 fireside chat regarding the new procedure indicated that the merits should be addressed in the context of Factor 6. Since the POPR has not yet been filed, a discussion of the merits follows.

The Petition relies most heavily on Cazan U.S. Pat. No. 8,275,351 (Ex. 1004) and secondarily on Frye U.S. Pub. 2012/0282906 (Ex. 1005). The evidence cited from these references does not give rise to a reasonable likelihood that the independent claims of U.S. Patent No. 8,958,853 (Ex. 1001) would be invalidated, so no IPR should be instituted.

The interface and suppression elements of claim 1 that are missing from the cited references include:

[1d] a memory controlled by the processor, the memory including instructions that when executed by the processor cause the processor to perform the steps of:

[1e] providing a graphical user interface through which a user customizes one or more functions of the mobile device when placed in an inactive mode;

[1f] receiving a user selection to automatically initiate the inactive mode in response to the pairing of the mobile device with a vehicle;

[1g] receiving a user selection of an away message to use when the mobile device is in inactive mode;

[1h] in response to the pairing of the mobile device and the vehicle, automatically initiating a process to place the mobile device in inactive mode; ... and

[1j] suppressing one or more sound, visual, or vibration communication cues that would have accompanied the communication had the mobile device not been in inactive mode.

(The element numbering is adopted from the Petition for ease of reference. Numbering is not part of the issued ‘853 Patent claims.)

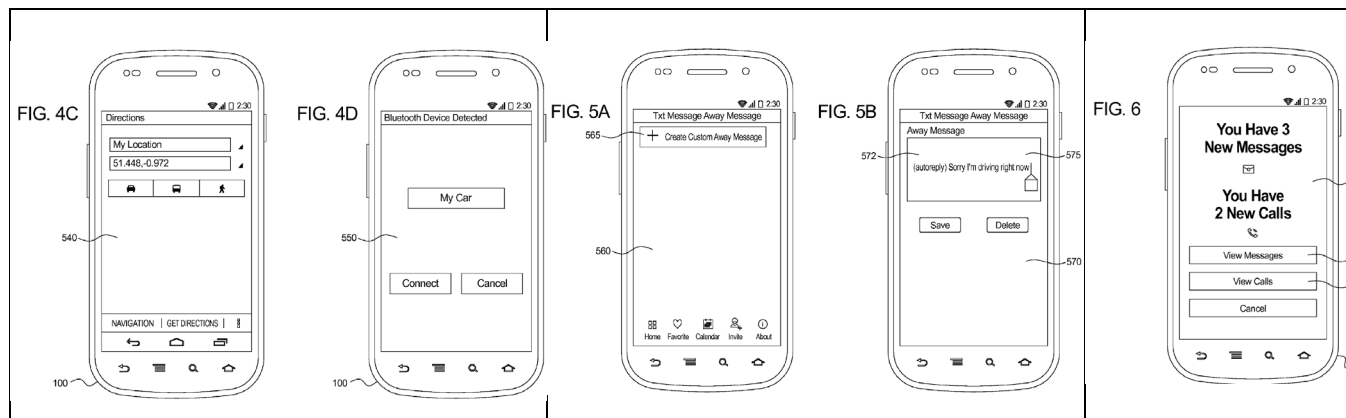
The evidence cited in the Petition must be viewed from the perspective of one of ordinary skill in the art, who would recognize that both cited references disclose interaction between a cell phone and a built in “telematics unit.” The secondary Frye reference further requires an RFID tag at a predetermined location in a vehicle. Both references use the built-in cellular capabilities of GM’s OnStar® as the example of a “telematics unit.” Cazanas is assigned to a parent of Verizon. It gives OnStar® as its only example of a telematics unit, at col. 5 line 17. It refers to the telematics unit 13 times and notes that a telematics unit traditionally provides road side assistance. *Id.*, at col. 5 line 7. Secondary reference Frye is assigned to General Motors, which builds OnStar® into its vehicles. Frye refers to the telematics unit 254 times. In the absence of hindsight, combining GM’s improvement on OnStar®, with Cazanas teaches a person of skill in the art to rely on a built-in telematics unit. Adding Frye to Cazanas would reinforce the role of the OnStar® or a similar telematics unit, which dominates Frye.

The cited Cazanias reference only mentions the possibility of a configuration interface in passing and never mentions suppressing distracting rings and beeps. No interface is claimed or given a written description or enabling disclosure. Suppression of communication cues is not mentioned as a technical problem or as a feature of Cazanias. *See*, Houh, ¶ 86 (acknowledging that Cazanias does not disclose suppressing rings and beeps) (Ex. 1002).

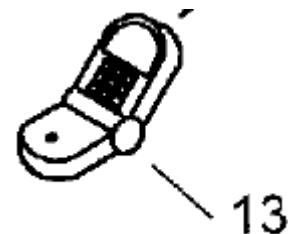
Interface

The interface elements [1d]-[1g] of the challenged claims include providing a graphical user interface to customize an inactive mode and receiving a user selection to initiate the inactive mode upon pairing with a vehicle. In contrast, Cazanias' claims make no mention of an interface, so there is no presumption that Cazanias provides an enabling disclosure. Instead, buried in Cazanias' dependent claims 7, 15 and 24 there is reference to "receiving an input of the response messaging service message from an end-user". There is no illustration or description of Cazanias' numeric menu interface, just a mention.

The challenged Patent illustrates a graphical user interface in figures 4A, 4B, 4C, 4D, 5A, 5B, 5C, 5D and 6 and describes the GUI operation at column 8. In these figures and accompanying narrative, the ‘853 Patent provides a written description and enabling disclosure of a graphical user interface.



In contrast, Cazan's FIG. 1 illustrates a flip phone 13 with a 12-key keypad, as reproduced here. Cazan's block diagram FIG. 2 is consistent with flip phone 13. One cannot see the numeric menu interface in Cazan's figures, but those who used flip phones in 2010, when Cazan was filed, will recall the numeric menu structure, with numbered choices selected by pressing number keys. A numeric menu structure responsive to this keypad is mentioned in passing in Cazan's col. 11:43-45. Cazan's most detailed disclosure of the phone 13 interface is in column 11 lines 33 to 55, which are partially quoted (not including the bold-faced sentence) in both the Petition, at 34-35, and the Declaration, ¶ 87:



As shown, the digital telephone handset 13 includes a display 56 for displaying messages, menus or the like, call related information dialed by the user, calling party numbers, incoming messaging service messages, and other information. Also, the display is used to input information such

as a response message or to configure the DNDA 15. If the mobile station executes location-based service Patents, the display 56 may provide other information regarding the determined location and/or surrounding areas, e.g. LAT/LON data, a rate of travel of the mobile station 13, and other information. **A keypad 58 enables dialing digits for voice and/or data calls and generating selection inputs keyed by the user based on any displayed menu.** The display 56 and keypad 58 are the physical elements providing a textual or graphical user interface. In addition to normal telephone related input/output, these elements are also used for display of menus and other information to the user and user input of selections. For example, these elements can be used to input information related to the response message or to configure other parameters of the DNDA 15. Of course other user interface elements may be used, such as a stylus and touch sensitive display screen, as in a PDA or mobile smartphone.

Cazanas, col. 11:33-55. No further disclosure of an interface is provided by Cazanas. Reference in these lines to using the illustrated 12-key keypad on a flip phone to “generate selection inputs” or “configure other parameters” is not a written description or enabling disclosure. Referring to a numeric menu interface as “graphical” is not a written description or enabling disclosure of the positively claimed graphical user interface. Passing mention of a “touch sensitive display screen” at the end of the paragraph is not enough to teach what is claimed, illustrated and described in the challenged Patent. Four words and a picture of a flip phone 13 with 12 keys is not enough teaching. Even though the iPhone had reached version 4 by 2010, Cazanas’ written description makes no effort to show that the inventor was possessed of the claimed graphical user interface. If the inventor had had our invention in mind, he would have disclosed it, but he didn’t.

An expert's opinion cannot overcome the deficiency of the reference.

The Houh declaration expertly glosses over the graphical user interface deficiency of Cazanias with phrases such as “use a graphical user interface of the mobile device ... in this manner as well.” Houh Decl., ¶ 88. The expert's diversionary argument is that the user could invoke a web browser running on the flip phone to access My-Verizon and configure the cell phone app using the web site from the flip phone. Houh, ¶ 88. This is not taught by Cazanias and is implausible for the flip phone illustrated. The Petition, at 36, cites this conclusory expert argument without citing any passage from Cazanias for running a browser on the flip phone 13.

The Petition, at 32-37, alternatively purports to rely on Frye to teach the graphical user interface claim element [1e], but actually relies on Frye for giving meaning to “inactive mode”. *Id.* at 34. There is no argument in the IPR that Frye teaches the claimed GUI. Neither the Overview of Frye (at 13-14), nor the discussion of element [1e] (at 24-26) cite Frye for any description of a GUI on the cell phone. Instead, Frye's OnStar® interface is built into the dashboard. *See*, Frye ¶ 0084; *also*, ¶ 0061.

Suppression Missing from Cazanias

There is no mention in Cazanias of either the problem of distracting phone rings or buzzes or the claimed solution of “suppressing one or more sound, visual, or vibration communication cues”. Houh's declaration, *infra*, ¶ 86, concedes as much. Instead, Cazanias' background focuses on compliance with new laws that prohibit hand-held use of mobile phone for calls or text messages while driving. Suppression of cues was not among requirements described in either Cazanias or Frye to satisfy those laws. Providing Cazanias' automated responses does not

inherently require the positively claimed suppression of communication cues.

The challenged Patent defines an inactive mode suppressing notifications as follows:

A user may enable an inactive mode of the device to suppress notification of incoming phone calls, text, emails, etc. and automatically notify the sender with an away message. By suppressing the communications distracted driving may be reduced. One drawback, however, is that senders may feel upset that they are not being answered when the sender is expecting the user to reply. Thus, in order to reassure senders that they will receive a response at the earliest convenient opportunity, the mobile device permits the user to send an away message upon receipt of a communication.

‘853 Patent, Summary, Ex. 1001. In contrast, there is no written or enabling description in Cazan as of a graphical user interface on the mobile device that controls “suppressing one or more sound, visual, or vibration communication cues”. Cazan as does not use the word “suppress*” or any synonym in its disclosure.

Nor does the Petition present a combination of Cazan as with secondary reference Frye that avoids the temptation of hindsight.

Suppression Missing from Any Combination Without Hindsight

In Frye, pairing of the cell phone 98 with the telematic unit does not trigger adjusting of the mobile device's operational mode. (Frye does not use the term inactive mode.) Instead, proximity of the cell phone to an RFID device 100, detected by detector 106, is

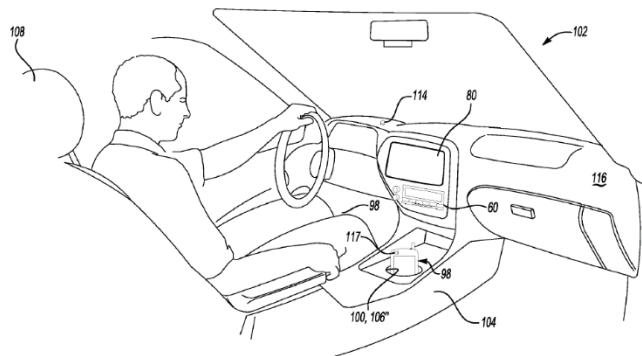


Fig-5

the trigger. Frye ¶¶ 0123, 0134. This RFID trigger is confirmed by Petitioner's expert. Houh, ¶¶ 0144, 0149. RFID tags are dumb devices that cannot "pair" with receivers in the manner that Bluetooth devices do. Frye expressly distinguishes between the phone 98 detecting the RFID tag in the cup holder and the phone pairing with OnStar®.

Preferably, the RFID connection is combined with speed sensing 706 by the telematic unit 14 which "ultimately activates" adjusted functionality. Frye ¶¶ 0060, 0124. (Interaction with RFID tags also was discussed in U.S. Pub. 2011/0039581 Cai assigned to Nokia, which the Examiner applied during prosecution.) Frye teaches a complex interaction among the mobile device 98, the telematics unit 14 and the RFID tag 117, mediated by the RFID reader/detector 106. Frye uses variations on "detect" 70 times, and uses "RFID connection" 72 times. Frye teaches suppression triggered by interaction between the cell phone and RFID tag, not pairing with the vehicle's telematics unit. Frye teaches obnoxious alerts triggered by pairing with the vehicle's telematics unit, forcing the user to place the cell phone next to the RFID tag, as further explained below.

Hindsight is a major problem in the Petition's proposed combination of

references. A person of ordinary skill in the art would see a clear path for functional combination of Frye, the secondary reference, with Cazanias, given Cazanias' motivating concern for satisfying new mobile phone call laws. The functional combination allows a driver to talk on the phone and to receive and reply to SMS messages legally, hands free, while driving. This is contrary to the challenged claims, which prevent the driver's attention from turning to the cell phone. The functional combination of references also requires placement of the phone next to the RFID tag, as opposed to the challenged claims that will be effective if the phone is in the driver's purse or backpack, given the extended range of Bluetooth.

Frye is directed to discouraging non-hands-free operation of cell phones while driving. Frye, ¶ 0014. When a cell phone 98 is positioned adjacent to an RFID tag 100, which has a short range, Frye describes the phone pairing with the telematics unit 14 as enabling "hands-free" operation of the cell phone. Frye, ¶ 0044. Hands-free operation includes both phone calls and SMS messages, as text-to-speech and audible response to SMS messages are disclosed. Frye, ¶ 0135; *accord*, Cazanias cols. 10-11 (triggering text-to-speech conversion of SMS, as opposed to blocking the incoming message). So, the combination of Frye with Cazanias would comply with the new laws by forcing placement of the cell phone where it could ring and legally be used in a hands-free manner. This functional combination is consistent with the objective of Cazanias to comply with the new cell phone laws and Frye's emphasis on legal hands-free messaging. Any other combination involves hindsight based on limitations of Claim 1.

A person of ordinary skill in the art also would see a clear path for structural combination of the RFID tag in GM's secondary reference with Verizon's primary reference. In addition to emphasizing reliance on the telematics unit, Frye forces

positioning of a phone near an RFID chip at a predefined location in a car. Pairing of the telematics unit with a cell phone that is not positioned near the RFID chip, not positioned in the predetermined location triggers flashing lights, beeping the driver, scrambling the currently playing audio (e.g. music, news radio, ...) and other means to get the driver's attention. Frye, ¶¶ 0057, 0061-62, 0092-93, 0159. Frye's app is intended to irritate and distract users, if necessary, to force a user to position the phone next to the RFID chip. This is contrary to the claimed result of pairing. Once the phone is near the RFID chip, Frye's app encourages hands-free communication while driving, as the mode preferred to suppressing hands-free calls or messaging.

Therefore, the argued teaching of Cazanas combined with Frye mistakenly depends on hindsight. The functional and structural combination of Cazanas and Frye, *sans* hindsight, would rely on a telematics unit and an RFID tag and to enable ringing and hands-free operation of cell phones in compliance with laws that were new and emerging at the time, laws which were discussed in both references.

On the merits, *Fintiv* Factor 6 strongly weighs against institution.

IV. Conclusion

To sum up, the Director should adopt the same approach as in the Director's recent *Hulu* decision that, under *Fintiv* (*Apple*, 63 F.4th at 8), when parallel court proceedings have already reached an appealable final judgment that the claims are invalid, efficiency requires non-institution and denial of an IPR petition.

Director Review should be granted, and the instituted proceedings stayed.

Date: May 2, 2025

Respectfully submitted,
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents were served by electronic service, by consent between the parties (Pet. at 7), on the date signed below:

PATENT OWNER'S REQUEST TO DIRECTOR FOR DISCRETIONARY DENIAL OF INSTITUTION

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