

From: [Director Discretionary Decision](#)
To: ebeffel@hmbay.com; [Andrew Baluch](#); [Trials](#)
Cc: [Beth Laughton](#); [docket](#); [Karen Gibson](#); [Blair Kittle](#)
Subject: RE: IPR2025-00586: Opposition to Request to Stay IPR pending Appeal
Date: Thursday, May 22, 2025 3:14:26 PM

Counsel –

Petitioner's request for authorization to file a request to stay the proceeding is denied. Petitioner may address the impact of *Hulu* on this proceeding in its opposition to Patent Owner's request for discretionary denial.

Thank you.

From: Ernie Beffel <ebeffel@hmbay.com>
Sent: Tuesday, May 20, 2025 1:05 PM
To: Andrew Baluch <baluch@smithbaluch.com>; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>; Trials <Trials@USPTO.GOV>
Cc: Beth Laughton <laughton@smithbaluch.com>; docket <docket@hmbay.com>; Karen Gibson <kgibson@hmbay.com>; Blair Kittle <BKittle@cpmlegal.com>
Subject: RE: IPR2025-00586: Opposition to Request to Stay IPR pending Appeal

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Dear Acting Director Stewart:

Patent Owner TJTM Technologies, LLC, a small entity, hereby opposes Petitioner Google's proposed expansion of its briefing in opposition to the pending Request for Discretionary Dismissal, from one to three briefs. Petitioner's request should be summarily denied without a telephone conference or further correspondence. The Patent Owner should not be prohibited from filing a Patent Owner's Preliminary Response (POPR), as Petitioner requests.

This letter reiterates the position that Patent Owner supplied to Petitioner prior to these letters to the Acting Director. A copy of our prior correspondence is attached. One can see from the attached that Petitioner edited its draft letter in light of Patent Owner's position, so there is no need to entertain a reply to this.

The statute and regulations give the Patent Owner control over commencement of the three-month period for deciding whether or not to institute an IPR. 35 USC 314 (three months from POPR filing); 37 CFR 42.107 (decision expedited by waiving

POPR). There is no provision in the statute or rules for prohibiting the Patent Owner from filing a POPR, either indefinitely or even for a specific, limited time. Provision for setting deadlines (35 USC 313) is different from prohibiting filing of a POPR. The case cited by Petitioner, *St. Jude Med., infra*, does not support prohibiting the filing of a POPR; it only supports extending the deadline for filing the POPR, at the Patent Owner's request.

Creating a new procedure that would give petitioners control over the IPR briefing schedule would be completely contrary to the workload streamlining that led to bifurcated consideration of discretionary dismissal and institution. A new procedure would increase the PTAB's workload and delay resolution of litigation after a successful appeal.

The Acting Director should apply *Hulu, infra*, and exercise the Office's discretion to dismiss this IPR request. The '853 patent that is targeted by this IPR request was found invalid under Section 101 by the District Court and sent to appeal seven months ago, after a dismissal without prejudice followed by a dismissal with prejudice. The odds that the '853 patent will be revived by the Federal Circuit are low (statistically speaking.) Under these circumstances, following *Hulu* leads directly to dismissal.

With 24 hours' notice, counsel for the Patent Owner can be available at most any time, if a conference call is desired. His cell phone number for scheduling is 415-902-6112.

Best regards,

Ernie Beffel

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From: Andrew Baluch <baluch@smithbaluch.com>

Sent: Monday, May 19, 2025 6:59 PM

To: Director_Discretionary_Decision@uspto.gov; Trials@USPTO.GOV

Cc: Beth Laughton <laughton@smithbaluch.com>; docket <docket@hmbay.com>; Ernie Beffel <ebeffel@hmbay.com>; Karen Gibson <kgibson@hmbay.com>

Subject: IPR2025-00586: Request to Stay IPR pending Appeal

Importance: High

Dear Acting Director Stewart (via the delegees on the Discretionary Denial Panel),

Petitioner respectfully requests authorization to file a motion to stay the above-captioned IPR before the filing of Patent Owner's preliminary response and until resolution of a pending Federal Circuit appeal (No. 25-1218) involving the challenged

patent. The parties have conferred, and Patent Owner stated it opposes this request.

To Petitioner's knowledge, this request for a stay presents an issue of first impression in the wake of *Hulu, LLC v. Piranha Media Distrib., LLC*, IPR2024-01252, Paper 27 at *2 (Apr. 17, 2025) (designated informative May 7, 2025), and at least for this reason, Petitioner submits that authorizing a motion is justified. The Director has the power to stay this IPR before the preliminary response is filed (currently due July 15, 2025). See 35 U.S.C. § 313 (providing that the Director sets the preliminary response deadline); *St. Jude Med., LLC v. The Regents of the Univ. of Cal.*, IPR2017-01338, Paper 23 (PTAB Feb. 5, 2018) (extending preliminary response deadline pending resolution of a motion to dismiss).

In parallel litigation, the district court held the challenged claims invalid under 35 U.S.C. § 101 at the early pleadings stage, and Patent Owner's appeal of that decision is pending before the Federal Circuit. (Pet. 6-7.) The *Hulu* decision found institution inefficient in a similar situation while also recognizing the possibility of changed circumstances should the district court's decision be reversed or vacated. Although a district court *could* address other validity issues following remand as *Hulu* recognizes, Petitioner seeks to present an alternative approach (i.e., staying the IPR) that better achieves *Hulu*'s goals of maximizing fairness and efficiency by preserving the Office's ability to later consider institution while not unduly prejudicing Patent Owner, who will not need to file a preliminary response unless and until the appeal is resolved in its favor. Petitioner respectfully seeks the opportunity to file a motion setting forth its rationale, including why its proposed approach would serve the public interest better than simply denying the petition.

Petitioner proposes an expedited briefing schedule, with Petitioner's motion due 1 week after authorization, Patent Owner's opposition due 1 week after Petitioner's motion, and Petitioner's reply due 1 week after Patent Owner's opposition. (The NOFDA was mailed on April 15, 2025, and the deadline for the POPR is currently July 15, 2025.) To permit fulsome consideration of the motion, the Board's authorization for the motion should hold the POPR deadline in abeyance and remove authorization for the filing of the POPR, pending a decision on the motion.

If a conference call is desired, the parties are available at the following dates and times:

Wednesday, May 21, 1:30pm–3:30pm ET;

Thursday, May 22, 10am–5pm ET;

Friday, May 23, 10am–5pm ET;

Tuesday, May 27, 10am–5pm ET;

Wednesday, May 28, 10am–5pm ET.

Respectfully submitted,

Counsel for Petitioner

Andrew Baluch

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