

Ernie Beffel

From: Ernie Beffel
Sent: Wednesday, June 18, 2025 11:22 AM
To: Director_Discretionary_Decision; Andrew Baluch
Cc: Beth Laughton; docket; Karen Gibson; Blair Kittle; Trials
Subject: RE: IPR2025-00586: Support for Discretionary Dismissal and Opposition to Stay IPR pending Appeal

To the Honorable Director Stewart and the Discretionary Decision Panel,

Thank you for the invitation yesterday to respond to Petitioner's *ex parte* request, made without seeking leave to file a motion, for the Office to ignore the procedure set in the Director's Memorandum of March 26, 2025 and to decide Patent Owner's *Request for Discretionary Dismissal* without the benefit of the Patent Owner's Preliminary Response (POPR). If summary discretionary dismissal of the IPR is forthcoming, without considering a POPR, Patent Owner will not object. After all, *Hulu LLC v. Piranha Media Distribution, LLC* (IPR2024-01253), Paper 27, (Director March 4, 2025) (informative), set a strong consideration favoring dismissal of an IPR following dismissal of litigation under section 101, without any extensive discussion of *Fintiv* or additional factors. The PTAB has applied *Hulu* even by order to show cause, in the absence of a request for discretionary dismissal. *See, e.g., Shopify Inc. v. DKR Consulting LLC*, IPR 2025-00132, paper 10, at 2-3 (May 29, 2024) (OSC; routine decision).

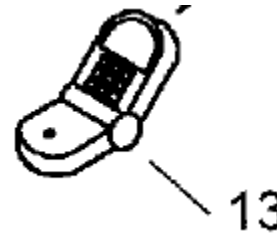
Patent Owner's position is that the Director's Memorandum calls for the POPR to be taken into consideration as part of the briefing of the pending *Request for Discretionary Dismissal*. This was made clear in FAQs, which aligned deadlines for filing an opposition to dismissal and for filing a POPR. Petitioner tried once for leave to file a motion that would have removed the POPR from the discretionary denial briefings; that the request to file a motion was denied. This time, Patent Owner has not asked to file a motion, it has just requested *ex parte* modification of the published procedure without a motion.

The POPR is worth waiting for if discretionary denial is not already called for under *Hulu*. Here are a few anticipated highlights.

First, there is a new, potentially dispositive consideration of settled expectations that was highlighted by the Director in the weeks that passed between filings the *Request for Discretionary Dismissal* and the *Opposition*, namely in *iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, IPR2025-00353 *et al.*, paper 10 (Director June 6, 2025) (routine decision granting discretionary denial). This Director's decision counsels a different perspective on repeated patent assertion. In *iRhythm*, at 3, the Director highlighted years of awareness of a patent before assertion against the petitioner. The Director found that awareness without filing a request for IPR for years settled expectations of the patent owner and favored discretionary dismissal. The Director granted the request for discretionary denial. Here, Google has been aware of Bovis' patent since at least 2018, when United Patents filed the first request for IPR, which was not instituted. Google was a founding member of United Patents. Decker (Oct. 14, 2013) *Google, NetApp Sidestep Courts to Combat Patent Claims*, at <https://www.bloomberg.com/news/articles/2013-10-14/google-to-netapp-sidestep-courts-to-combat-patent-claims>. Google undoubtedly subscribes to newsletters and press releases by United Patents. *See, e.g.,* <https://www.unifiedpatents.com/insights/2018/12/18/smtm-technology-patent-challenged-as-likely-invalid>. Even if Google wasn't aware of the inventor's assertion of this patent against Microsoft or Apple cell phones before the United Patents IPR request, Google became aware by 2018 of the likelihood that Google phone infringed Bovis' claims. Not only did Petitioner postpone filing the follow-on IPR until after assertion of the

patent, it waited 363 days after assertion, to nearly the last possible day, to request an IPR. Following the Director's rationale in *iRhythm* provides an additional, new basis for discretionary dismissal.

Second, there is an inexplicable denial in the *Opposition*, at 23, that 13 illustrated in Cazan's Figure 1 is a flip phone. An article that ties 2010, when Cazan's application was filed, is Bolton (2024) *History of the Flip Phone*, at <https://www.envirofone.com/en-gb/buy/advice-of-the-flip-phone>. While the primary reference does not call what Figure 1 cell phone 13 a "flip phone", neither does Cazan call out Apple's iPhone, Samsung's phone or any other device that actually had a screen in 2010. It shows what looks like a Motorola flip phone. Part of flip phones was numeric menus. The *Opposition* once again fails to quote the sentence in the primary reference, from a paragraph that Petitioner and its expert quoted in part, that recounts how a flip phone numeric keyboard was used to navigate menus. See, *Request for Discretionary Dismissal*, at 11-12, quoting Cazan, col. 11:33-55. Thus, the Petitioner's reading of the primary reference attempts to find a whole GUI teaching in four or five words, while ignoring the primary teaching based on a flip phone 13. The teaching in Cazan regarding GUIs is inadequate to support Petitioner's position.



the cell phone the flip phone to of the *Flip centre/history* we see in the or illustrate had a touch

Third, the *Opposition* ignores the OnStar® telematics unit tie between the primary and secondary reference, which we emphasized in the *Request for Discretionary Dismissal* at 12-13, before the three additional arguments on the merits. The technological tie between the references is important to evaluating whether picking a minor feature from a secondary reference (such as one briefly mentioned in Frye [0134]) for combination with the primary reference involves hindsight. The *Opposition* fails to acknowledge the legal principle from *Application of Shuman*, 361 F.2d 1008, 1011 (CCPA 1966), *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1141, 227 U.S.P.Q. (BNA) 543, 550 (Fed. Cir. 1985), and other cases, which bars selecting an obscure feature from a secondary reference and ignoring the secondary reference as a whole. Instead, the *Opposition* turns to a third reference, not listed as in the proposed combination of references, for a motivation that is directly at odds with the thrust of secondary reference Frye. The main point of Frye is to teach a way to force legal, safe hands-free talking on a cell phone placed in a restricted position, with no more new hardware than a cheap RFID tag. Hindsight is among the points that will be briefed in the POPR.

Of course, the POPR will be more extensive.

Therefore, it is Patent Owner's position that EITHER dismissal should be entered now, without needing the scheduled consideration of the POPR as part of the process, OR the procedure set forth in the Director's Memorandum should be followed and the POPR should be considered as part of the *Request for Discretionary Dismissal* briefing. Therefore, Petitioner's *ex parte* application, without seeking leave to file a motion, should be denied and the *Request for Discretionary Dismissal* should be granted, either now or after consideration of a timely POPR.

Best regards,

Ernie Beffel

Counsel for Patent Owner

Cc: Counsel for Petitioner

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ebeffel@hmbay.com | 650-712-0340 phone

From: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Sent: Tuesday, June 17, 2025 1:29 PM
To: Andrew Baluch <baluch@smithbaluch.com>; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Cc: Beth Laughton <laughton@smithbaluch.com>; docket <docket@hmbay.com>; Karen Gibson <kgibson@hmbay.com>; Blair Kittle <BKittle@cpmlegal.com>; Ernie Beffel <ebeffel@hmbay.com>; Trials <Trials@USPTO.GOV>
Subject: RE: IPR2025-00586: Stay IPR pending Appeal
Importance: High

Thank you for bringing this to our attention. In the future, please confer with opposing counsel before contacting us, and present their position along with yours in your email. To the extent Patent Owner wishes to respond to Petitioner's email, please do so before the close of business on June 18, 2025.

From: Andrew Baluch <baluch@smithbaluch.com>
Sent: Friday, June 13, 2025 6:51 PM
To: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Cc: Beth Laughton <laughton@smithbaluch.com>; docket <docket@hmbay.com>; Karen Gibson <kgibson@hmbay.com>; Blair Kittle <BKittle@cpmlegal.com>; ebeffel@hmbay.com; Trials <Trials@USPTO.GOV>
Subject: Re: IPR2025-00586: Stay IPR pending Appeal

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Dear Honorable Director (via the Discretionary Denial Panel),

This case appears to present an issue of first impression under the bifurcated institution process, which is why Petitioner would like to bring to your attention that today Petitioner has filed its opposition (Paper 8) to Patent Owner's request for discretionary denial (Paper 7). Over **one month remains** before the default deadline for the POPR (due July 15, 2025). Petitioner respectfully requests that the Director consider the opposition now, before the POPR due date of July 15.

By considering Petitioner's opposition before July 15, the Director will be able to consider the opposition's argument for a stay of this IPR by extending the POPR due date until the date of the Federal Circuit's mandate in the pending appeal. Paper 8, §III.A (arguing for stay based on Director's authority under 35 U.S.C. § 313).

Respectfully submitted,
Counsel for Petitioner
Andrew Baluch
SMITH BALUCH LLP
+1.202.880.2397

From: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Date: Thursday, May 22, 2025 at 3:14 PM
To: ebeffel@hmbay.com <ebeffel@hmbay.com>, Andrew Baluch <baluch@smithbaluch.com>, 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

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

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

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](mailto: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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