

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 RESPONSE TO PETITIONER'S REQUEST FOR
DIRECTOR REVIEW UNDER 37 C.F.R. § 42.75**

TABLE OF CONTENTS

TABLE OF CONTENTS	i
TABLE OF AUTHORITIES	ii
I. INTRODUCTION	1
II. BACKGROUND AND TIMELINE	1
III. ARGUMENT.....	3
IV. CONCLUSION	5
CERTIFICATE OF SERVICE	6

Table of Authorities

Cases

AMICUS BRIEF FILED by Susan G. Braden et al, 25-132 paper 49 (July 18, 2025).....	4
<i>In re: Google LLC</i> , 25-144, paper 2 (Aug. 18, 2025) (341 pg)	3, 4
<i>In re: SAP America, Inc.</i> , 25-132 (June 16, 2025).....	3

Statutes

35 U.S.C. § 101	1
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Agency Decisions

<i>Hulu LLC v. Piranha Media Distribution, LLC</i> , IPR2024-01253, Paper 22	2, 5
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Publications

E. McDermott, <i>Judges and Academics Tell CAFC to Reject SAP’s Mandamus Bid Over Revocation of Vidal’s Discretionary Denial Guidance</i> , IP Watchdog (July 21, 2025).....	3
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I. INTRODUCTION

Patent Owner responds to the Petitioner's Request Director Review under 37 C.F.R. § 42.75 of the decision denying institution. Paper 12 ("Decision").

II. BACKGROUND AND TIMELINE

The '853 Patent issued in on February 17, 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 35 U.S.C. § 101.

In the District Court, Petitioner moved 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 dismissed Patent Owner's infringement claim with prejudice on October 22, 2024. *Ex. 1018, Docket Order*. Patent Owner appealed and briefing concluded on May 16, 2025.

Patent Owner filed a Request for Discretionary Dismissal on May 2. Based on *Hulu LLC v. Piranha Media Distribution, LLC*, IPR2024-01253, Paper 22, we

urged that because the patent claims were invalidated by the District Court, it is unnecessary to institute another proceeding to review the same claims for patentability on other grounds. Petitioner submitted a request to file a motion for stay the IPR briefing in an email dated May 19, which Patent Owner opposed in an email dated May 20. The Director denied leave to file a motion in an email dated May 22.

On Wednesday, May 14, 2025 at 4:59:58 PM Eastern Daylight Time, Google sent an email with a purported *Sotera* stipulation. Ex. 1031. This purported stipulation followed Patent Owner's filing of the Request for Discretionary Dismissal by almost two weeks.

Petitioner filed its Opposition to Discretionary Dismissal five weeks ahead of its deadline, on June 6. Undaunted by denial of leave to file a motion, Petitioner repeated its request for a stay in an email dated June 13, without seeking leave to file a motion. The Director requested a response from Patent Owner, which we submitted by the next day on June 18. The Director has not yet responded to the June emails. The thread of emails from May and June is submitted as Ex. 2001.

On July 15, Patent Owner filed a Preliminary Response request the PTAB deny institution of the IPR. On August 14, 2025 the PTAB issued their decision deny institution of the Petitioner's Request for *Inter Partes* Review.

On September 12 Petitioner filed a Request for Director Review under 37 C.F.R. § 42.75 (“Request”). In an email from Director PTAB Decision Review, Patent Owner is authorized to submit a response limited to the issues raised in the Director Review request.

III. ARGUMENT

The Request to which we respond is a condensed version of the petition for writ of mandamus that Google filed in the Federal Circuit on August 18, 2025. *In re: Google LLC*, 25-144, paper 2 (Aug. 18, 2025) (341 pg). Google briefed the *Sotera* issue in paper 2.

Google’s mandamus petition followed petitions filed two months earlier by SAP and Motorola. *Consolidated as, In re: SAP America, Inc.*, 25-132 (June 16, 2025). Notably, one group of amici who opposed the *SAP* petition included three retired federal judges, the former vice chair of the International Trade Commission(ITC) and six academic scholars. E. McDermott, *Judges and Academics Tell CAFC to Reject SAP’s Mandamus Bid Over Revocation of Vidal’s Discretionary Denial Guidance*, IP Watchdog (July 21, 2025); AMICUS BRIEF FILED by Susan G. Braden, Ronald A. Cass, Richard A. Epstein, Bowman Heiden, Keith N. Hylton, Adam J. MacLeod, Adam Mossoff, Honorable Kathleen M. O'Malley, Kristen Osenga and Randall R. Rader, 25-132 paper 49 (July 18,

2025). The Acting Director filed a response on July 18, as paper 39. The Federal Circuit has not decided the case or scheduled argument, as of this submission.

On September 16, the Acting Director responded to Google in the Federal Circuit by filing the *Acting Director's Response to Petition for Writ of Mandamus, In re: Google LLC*, 25-144, paper 22 (Sep. 16, 2025) (34 pg). In the Office's response, the Acting Director Court concluded that "Petitioners' Statutory Complaints Are Barred by 35 U.S.C. § 314(d)," paper 22, at 12-18, that "Petitioners' Constitutional Claims Are Meritless," paper 22, at 18- 30 and that "Petitioners Cannot Satisfy the Remaining Mandamus Factors," paper 22, at 30-33.

One thing for the Patent Owner to add to the Acting Director's reasoning in the filings with the Federal Circuit relates to the delayed filing in this case by Google of a *Sotera* stipulation. Google's Request, at 3, indicates the guidance memorandum of March 24, 2025, announced that "'a timely-filed Sotera stipulation ... will not be dispositive by itself' to avoid Fintiv denial." The Request never gives the date of Google's *Sotera* stipulation (Ex. 1031), which was May 14. That is Google did not submit a *Sotera* stipulation until ten weeks after the IPR petition, six weeks after the Acting Director's guidance memorandum, a month after *Hulu* was decided, and two weeks after Patent Owner's request for discretionary denial based on *Hulu*. Google had no expectation when it filed its belated *Sotera* stipulation that such a stipulation would be dispositive in this case.

IV. CONCLUSION

Patent Owner respectfully urges the Office to adopt in this case the reasoning in the Acting Director's Response filed on September 16, 25-144, paper 22. Following that reasoning, the Request should be denied.

Respectfully submitted,

Date: September 17, 2025 / Ernest J. Beffel, Jr. /

Ernest J. Beffel, Jr., Reg. No. 43,892
Andrew Dunlap, Reg. Reg. No. 60,554
Haynes Beffel & Wolfeld LLP
Attorneys for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents, together with all exhibits filed therewith, are being served by electronic service, by consent between the parties (Pet. at 7), on the date signed below:

PATENT OWNER'S RESPONSE TO PETITIONER'S REQUEST FOR
DIRECTOR REVIEW UNDER 37 C.F.R. § 42.75

The names and address of the parties being served are as follows:

Andrew S. Baluch
Reg. No. 57,503
SMITH BALUCH LLP
700 Pennsylvania Ave. SE, Second Floor
Washington, DC 20003
(202) 880-2397, baluch@smithbaluch.com

Elizabeth A. Laughton
Reg. No. 70,484
SMITH BALUCH LLP
376 Boylston Street, Suite 401
Boston, MA 02116, (703) 585-8839
laughton@smithbaluch.com

Respectfully submitted,

Date: September 17, 2025

/ Ernest J. Beffel, Jr. /

Ernest J. Beffel, Jr., Reg. No. 43,892
Andrew Dunlap, Reg. No. 60,554
Haynes Beffel & Wolfeld LLP
Attorneys for Patent Owner
