

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

WESTERN DIGITAL TECHNOLOGIES, INC.,
Petitioner,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

IPR2025-00701
Patent 10,367,138 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
Referring the Petition to the Board

Godo Kaisha IP Bridge 1 (“Patent Owner”) filed a request for discretionary denial (Paper 6, “DD Req.”) in the above-captioned case, and Western Digital Technologies, Inc. (“Petitioner”) filed an opposition (Paper 8, “DD Opp.”).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in this proceeding. This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, the parallel district court proceeding involving the parties has been stayed. DD Opp. 1. As such, it is likely that a final written decision will issue before the district court trial occurs. As a result, there is no immediate concern of inconsistent outcomes or duplication of efforts resulting from two proceedings operating in parallel. In addition, there has not been significant investment by the parties in the parallel proceeding. Paper 1 (“Pet.”), 66.

Furthermore, Petitioner provides persuasive reasoning, supported by evidence, that the Office erred in a manner material to the patentability during patent examination, and, accordingly, discretionary denial under 35 U.S.C. § 325(d) is not appropriate. Pet. 4–5; DD Opp. 2. As Petitioner argues, the patent examiner identified MgO (magnesium oxide) barrier height and oxygen vacancy defects as allowable subject matter in the challenged patent. Pet. 2–4 (citing Ex. 1012, 312). Subsequently, the same patent examiner found the prior art taught the previously allowable subject matter, and rejected then-pending child applications of the challenged patent. Pet. 4–5; DD Opp. 2 (citing Ex. 1012, 312; Ex. 1086, 228 (withdrawal from issue), 257 (rejection); Ex. 1087, 200). Petitioner, therefore, appears to show a material error by the Office.

Although certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petition is referred to the Board to handle the case in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

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

FURTHER ORDERED that the Petition is referred to the Board; and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

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