

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

BOOTLER, LLC,
Patent Owner.

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

Case No. IPR2025-00967

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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<i>Shopify Inc. v. Dkr Consulting LLC</i> , No. IPR2025-00130, Paper 10 (P.T.A.B. May 29, 2025)	4, 5, 6

Statutes

35 U.S.C. § 101	1, 3, 4, 6
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PATENT OWNER'S EXHIBIT LIST

<u>Exhibit No.</u>	<u>Description</u>
2001	Opinion and Order granting Defendant's motion to dismiss and dismissing Plaintiff's complaint with prejudice. <i>Bootler, LLC v. Google, LLC</i> , Case No. 24-cv-3660, ECF No. 49 (N.D. Ill. Sep. 4, 2025)

I. INTRODUCTION

Patent Owner Bootler LLC (“Bootler” or “Patent Owner”) respectfully requests that the Director exercise his discretion over institution of AIA proceedings under 35 U.S.C. § 314(a) and deny institution of IPR2025-00967 in accordance with Interim Process for PTAB Workload Management memorandum dated March 26, 2025 (the “Memo”)¹ and the Board’s decision in *Hulu, LLC v. Piranha Media Distribution, LLC*, IPR2024-01252 & IPR2024-01253, Paper 27, (Apr. 17, 2025) (informative) (“*Hulu*”) applying *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020)(precedential)(“*Fintiv*”).

The U.S. District Court for the Northern District of Illinois has already found every challenged claim subject to this petition to be invalid for reciting ineligible subject matter under 35 U.S.C. § 101. (Ex. 2001.) Accordingly, it is unnecessary for the Patent Trial and Appeal Board (“Board” or “P.T.A.B.”) to institute another proceeding to review patentability under other grounds. If upon appeal, the Federal Circuit reverses the district court’s decision, Petitioner may raise its prior art

¹ <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>

invalidity arguments in the district court on remand. This approach shall be far more efficient than instituting the instant IPR. Accordingly, Patent Owner, requests that the Director exercise his discretion and deny institution under 35 U.S.C. § 314(a).

II. THE DISTRICT COURT’S INVALIDITY RULING FAVORS DISCRETIONARY DENIAL OF AN INTER PARTES REVIEW

Based on the district court’s invalidity rulings with respect to the claims at issue, informative and precedential Board decisions, as well as the Board’s own guidance, the Board should discretionarily deny *inter partes review* of the instant petition. Institution of *inter partes review* is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

A. The Board’s Analysis in *Hulu* Strongly Supports Discretionary Denial

The Board’s decision in *Hulu, LLC v. Piranha Media Distribution, LLC* is directly on point. The material facts present here exactly mirror those in *Hulu*, where the petitioner filed a motion to dismiss under Rule 12(b)(6), asserting that the claims challenged in the IPR proceedings are invalid as reciting ineligible subject matter under § 101. *Hulu* at 2. The district court granted the motion and dismissed with prejudice the patent

owner's claims. *Id.* Consequently, the Director found that because the claims already stood invalid it was unnecessary to institute another proceeding to review them for patentability on other grounds, noting that in such scenarios the efficiency and integrity of the patent system is best served by denying institution. *Id.* at 2-3. The Board should follow its own precedent by reaching the same result here.

B. Denial of Institution in Consistent with *Fintiv*

While as noted in *Hulu*, the *Fintiv* framework, which has historically guided the Board in deciding whether to institute *inter partes* review, does not fit neatly with the circumstances of cases such as *Hulu* and the instant case, where the district court has already determined that the challenged claims are invalid under § 101, the *Fintiv* framework does emphasize efficiency concerns, and 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. *Id.* at 3 citing *Fintive* at 5-6. Nevertheless, several of the *Fintiv* Factors independently support a discretionary denial, further reinforcing that institution is unwarranted.

Fintiv Factor 3, “the investment in the parallel proceeding by the court and the parties” favors denial. *Fintiv*, 5-6. The parties and the

district court have already invested substantial work and expense in the parallel district court litigation. The parties briefed and the district court already decided a key substantive motion to dismiss based on subject-matter ineligibility under 35 U.S.C. § 101. In the process of adjudicating this motion, the district court has already become well-versed with the underlying patented technology (per *Alice* Step One), and the general state of the art and specific disclosures of the pertinent prior art (per *Alice* Step Two). Accordingly, institution of this IPR would waste the Board's resources and not achieve anything in terms of judicial economy relative to other cases. As the Board noted in *Shopify Inc. v. Dkr Consulting LLC*, the efficiency of having the patent owner engage in inter partes review of claims already adjudicated to be unpatentable is further compounded by the strict statutory deadline for completing inter partes review proceedings, see 35 U.S.C. § 316(a)(11) ("requiring that the final determination ... be issued not later than 1 year after the date on which the Director notices the institution of a review"). *Shopify Inc. v. Dkr Consulting LLC*, No. IPR2025-00130, Paper 10 at 13 (P.T.A.B. May 29, 2025) ("*Shopify*").

Fintiv Factor 5, “whether the petitioner and the defendant in the parallel proceeding are the same party” also favors denial. *Fintiv* at 6. Here the parties are the same in both proceedings. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (P.T.A.B. May 13, 2020) (“*Fintiv II*”) (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”).

Fintiv Factor 6, “other circumstances that impact the Board’s exercise of discretion, including the merits” favors denial. *Fintiv*, at 6. As noted by the Board in *Shopify*, this factor includes a district court judgment invalidating all challenged claims as patent ineligible. *Shopify* at 6 (“[t]he policy goal expressed in *Hulu* also aligns directly with *Fintiv* in that the Board seeks ‘to balance considerations such as system efficiency, fairness, and patent quality.’ Thus, contrary to Petitioner’s assertions, prior Board precedent is consistent with our decision to exercise the Director’s discretionary denial authority for reasons of administrative efficiency and the integrity of the patent system as stated in *Fintiv* and *Hulu*.”)(internal citations omitted). While the *Hulu* decision is not precedential, the Board in *Shopify* was persuaded that following the *Hulu* decision “is the most administratively efficient approach that preserves

Board resources, the integrity of the patent system, and Petitioner's opportunity to challenge the validity of the ... patent claims in District Court if the need arises.” *Shopify* at 6; see also *Highlevel, Inc. v. Etison LLC*, No. IPR2025-00235, Paper 11 at 6 (P.T.A.B. June 2, 2025)(applying reasoning set forth in *Hulu* and denying institution of inter partes review where a district court already found the claims invalid under 35 U.S.C. § 101 in the parallel litigation). So, too, should the Board be persuaded here and rule consistently with *Fintiv* and *Hulu*, in denying institution of the IPR.

C. The Board’s Guidance Favors Discretionary Denial

The P.T.A.B.’s Interim Processes for P.T.A.B. Workload

Management Memorandum further supports discretionary denial, as instituting review here would contravene the Board’s own policies of allocating resources to matters where they will be the most effective. The P.T.A.B. Workload Management Memo enumerated a number of relevant considerations for the parties to address when arguing for or against discretionary denial, including in relevant part “whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims” and the Board’s ability to “comply with

pendency goals for *ex parte* appeals, its statutory deadlines for AIA proceedings, and other workload needs.” Memo at 2-3. As explained above in the context of *Hulu* and *Fintiv*, these factors support discretionary denial. The Memo also considers “compelling economic, public health, or national security interests; and any other considerations bearing on the Director’s discretion.” *Id.* at 2. Here, instituting the Petition would unfairly subject the Patent Owner to significant costs in having the patentability further examined when the patent has already been found invalid. Patent Owner is a small business with limited resources, while Petitioner, Google, is one the top five wealthiest companies in the world. Petitioner is economically capable of litigating its patent challenges at the district court and at the Federal Circuit. Unlike other smaller defendants, who may economically benefit from the lower costs and speedy resolution of Board proceedings, Google has nothing to gain by taxing the resources of the Patent Office. Accordingly, this factor further supports denying institution of *inter partes* review.

Discretionary denial of the instant petition would meet the goals articulated in the P.T.A.B. Workload Management Memo: to “improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, ...

and promote consistent application of discretionary considerations in the institution of AIA proceedings.” *Id.* at 3. In sum, denial thus aligns with not only *Fintiv* and *Hulu*, but with the Board’s own guidance on the responsible use of its resources.

III. CONCLUSION

The Director should follow the Board’s own guidance and adopt the same ruling here as in the recent *Hulu* decision that, under *Fintiv* when parallel court proceedings have already reached an appealable final judgment that the subject claims are invalid, efficiency requires non-institution and denial of an IPR petition.

Date: September 25, 2025

Respectfully submitted,

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CERTIFICATION UNDER 37 C.F.R. § 42.24

Under the provisions of 37 C.F.R. § 42.24(d) and the P.T.A.B. Workload Management Memorandum the undersigned hereby certifies that the word count for the foregoing Patent Owner's Discretionary Denial Brief totals 1,448 words, which is less than the 14,000 allowed under 37 C.F.R. § 42.24(b)(1) and the P.T.A.B. Workload Management Memorandum.

Date: September 25, 2025

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