

Filed on behalf of: Google LLC

Entered on: October 16, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

ADVANCED CODING TECHNOLOGIES LLC,
Patent Owner.

IPR2025-01278
Patent 9,042,448

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION**

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Exhibit List

Exhibit	Description
1001	U.S. Patent No. 9,042,448 to Sakazume (“the ’448 Patent”)
1002	Excerpts from the Prosecution History of the ’448 Patent (“the ’448 Patent File History”)
1003	Declaration and Curriculum Vitae of Dr. Clifford Reader
1004	[reserved]
1005	English Translation of Japanese Patent Publication No. 2007316161 A with Translation Certificate (“Phek”)
1006	Segall et al., <i>Spatial Scalability Within the H.264/AVC Scalable Video Coding Extension</i> ; IEEE Transactions on Circuits & Systems for Video Tech., Vol. 17, No. 9, September 2007 (“Segall”)
1007	Martins et al., <i>A Unified Approach to Restoration, Deinterlacing and Resolution Enhancement in Decoding MPEG-2 Video</i> , IEEE Transactions on Circuits & Systems for Video Tech., Vol. 12, No. 9, September 2002 (“Martins”)
1008	U.S. Patent Application Publication No. 2008/0137753 (“He”)
1009	U.S. Patent No. 5,886,736 (“Chen”)
1010	Schwarz et al., <i>Overview of the Scalable Video Coding Extension of the H.264/AVC Standard</i> , IEEE Transactions on Circuits & Systems for Video Tech., Vol. 17, No. 9, September 2007 (“Schwarz”)
1011	U.S. Patent Application Publication No. 2009/0154567 (“Lei”)
1012	Park et al., <i>Super-Resolution Image Reconstruction: A Technical Overview</i> , IEEE Signal Processing Magazine, pp. 21-36, May 2003 (“Park”)
1013	English Machine Translation of Japanese Patent Publication No. 2008053848 (“Hatanaka”)
1014	U.S. Patent Application Publication No. 2010/0165077 (“Yin”)
1015	U.S. Patent Application Publication No. 2009/0257664 (“Kao”)
1016	U.S. Patent Application Publication No. 2009/0046995 (“Kanumuri”)
1017	U.S. Pat. 6,470,051 (“Campisano”)
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1019	Lu et al., Mechanisms of MPEG Stream Synchronization, ACG SIGCOMM Computer Communication Review, Vol. 24, Issue 1, pp. 57-67 (January 1994) ("Lu")
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1025	U.S. Patent Publication No. 2008/0043832 ("Barkley")
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1029	Declaration of June Ann Munford
1030	Ely, MPEG Video Coding: A Simple Introduction, EBU Technical Review (Winter 1995) ("Ely")
1031	Japanese Patent Publication No. 2007316161 A with English Machine Translation
1032	ITU-T Recommendation H.264 (11/07)
1033	Karczewicz et al., The SP- and SI-Frames Design for H.264/AVC, IEEE TRANSACTIONS ON CIRCUITS AND SYSTEMS FOR VIDEO TECHNOLOGY, v.13 (July 2003)
1034	ISO/IEC 11172-2: 1993 (E) (MPEG1 Video)
1035	ISO/IEC 13818-2: 2000 (E) (MPEG2/H.262 Video)
1036	ITU-T Recommendation H.263 (02/98)
1037	Reader, Intraframe and Interframe Adaptive Transform Coding, Efficient Transmission of Pictorial Information, SPIE v.66, 108 (1975)
1038	Reader, MPEG4: Coding for Content, Interactivity, and Universal Accessibility, Optical Engineering 35(1), 104 (January 1996)
1039	Reader, MPEG Patents, in MPEG Video Compression Standard, Chapter 16, at 357-362 (Mitchell et al ed.) (1996)

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1042	ISO/IEC 14496-2: 2004 (MPEG4)
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1046	U.S. Patent Publication No. 2007/0140350 to Sakazume (“Sakazume”)
1047	IPR2024-00372, Paper 9
1048	Loop Filters in the Okubo RM2 (1986)
1049	U.S. Patent No. 6,580,754 to Wan et al. (“Wan”)
1050	Letter from P. Young to P. Lambrianakos re: Google’s Sotera Stipulation
1051-1052	[reserved]
1053	U.S. Patent No. 9,042,448 Patent Assignment, Reel: 059497 Frame: 0108 (“ACT Assignment”)
1054	About Advanced Coding Technologies LLC, https://advancedcodingtechnologies.com/about (last visited Aug. 28, 2025) (“About ACT”)
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1056	Complaint for Patent Infringement, <i>Advanced Coding Technologies LLC v. LG Electronics Inc.</i> , No. 2:22-cv-00501 (E.D. Tex. Dec. 30, 2022), ECF 1 (“ACT-LG Complaint”)
1057	Complaint for Patent Infringement, <i>Advanced Coding Technologies LLC v. Samsung Electronics Co.</i> , No. 2:22-cv-00499 (E.D. Tex. Dec. 30, 2022), ECF 1 (“ACT-Samsung Complaint”)
1058	Plaintiff Advanced Coding Technologies LLC’s Objections and Responses to Google’s First Set of Interrogatories, <i>Advanced Coding Technologies LLC v. Google LLC</i> , No. 2:24-cv-00353 (E.D. Tex. Nov. 20, 2024) (“ACT Rog Response”)

1059	Answer to Second Amended Complaint, <i>Advanced Coding Technologies LLC v. Google LLC</i> , No. 2:24-cv-00353 (E.D. Tex. Feb. 20, 2025), ECF 55 (“ACT-Google Answer”)
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1064	Complaint for Patent Infringement, <i>Advanced Coding Technologies LLC v. ByteDance Ltd.</i> , No. 2:22-cv-00129 (E.D. Tex. Apr. 29, 2022), ECF 1 (“ACT-TikTok Complaint”)
1065	Docket, <i>Advanced Coding Technologies LLC v. ByteDance Ltd.</i> , No. 2:22-cv-00129 (E.D. Tex.) (“ACT-TikTok Docket”)
1066	Order of Dismissal, <i>Advanced Coding Technologies LLC v. ByteDance Ltd.</i> , No. 2:22-cv-00129 (E.D. Tex. Sept. 27, 2023), ECF 138 (“ACT-TikTok Dismissal”)
1067	Order of Dismissal, <i>Advanced Coding Technologies LLC v. LG Electronics Inc.</i> , No. 2:22-cv-00501 (E.D. Tex. May 31, 2024), ECF 120 (“ACT-LG Dismissal”)
1068	Docket, <i>Advanced Coding Technologies LLC v. LG Electronics Inc.</i> , No. 2:22-cv-00501 (E.D. Tex.) (“ACT-LG Docket”)
1069	[reserved]
1070	Order of Dismissal, <i>Advanced Coding Technologies LLC v. Samsung Electronics Co.</i> , No. 2:22-cv-00499 (E.D. Tex. Sept. 13, 2024), ECF 222 (“ACT-Samsung Dismissal”)
1071	Complaint for Patent Infringement, <i>Advanced Coding Technologies LLC v. Apple Inc.</i> , No. 2:24-cv-00687 (E.D. Tex. Aug. 20, 2024), ECF 1 (“ACT-Apple Complaint II”)
1072	How We Started and Where We Are Today – Google – About Google, http://about.google/company-info/our-story/ (last visited Aug. 6, 2025) (“About Google”)
1073	A New Era of American Innovation – About Google Around the World, https://about.google/intl/ALL_us/around-the-globe/local-info/ (last visited Aug. 6, 2025) (“Google – New Era”)
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1075	Alliance for Open Media, https://aomedia.org/av1-adoption-showcase/ (last visited Aug. 28, 2025) (“AOM Adoption Showcase”)
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1079	Letter from IP Subcommittee Ranking Member Schiff to U.S. Dept. of Commerce, dated Apr. 18, 2025 (“Schiff letter to DOC”)

1080	The Patent Trial and Appeal Board and Inter Partes Review, https://crsreports.congress.gov (updated May 28, 2024) (“CRS Report”)
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1086	Judge Gilstrap Motion to Stay Results https://search.docketnavigator.com/patent/binder/0/0?print=true (last visited Sept. 4, 2025) (“Gilstrap Stay Results”)
1087	United States District Courts – National Judicial Caseload Profile, https://www.uscourts.gov/data-news/data-tables/2025/03/31/federal-judicial-caseload-statistics/c-5 (“Caseload Stats”)
1088	U.S. District Courts – Median Time Intervals from Filing to Disposition of Civil Cases Terminated, https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0331.2025.pdf (last visited Apr. 24, 2025) (“Median Time Intervals”)
1089	Minute Entry, <i>Advanced Coding Technologies LLC v. Google LLC</i> , No. 2:24-cv-00353 (E.D. Tex. July 19, 2024) (“Minute Entry re Scheduling Conference”)
1090-1091	[reserved]
1092	First Amended Complaint for Patent Infringement, <i>Advanced Coding Technologies LLC v. Google LLC</i> , No. 2:24-cv-00353 (E.D. Tex. Aug. 2, 2024), ECF 23 (“ACT-Google Amended Complaint”)
1093	U.S. District Court, Eastern District of Texas Calendar of Events Set for 3/2/2026-3/2/2026, Judge Rodney Gilstrap, Presiding (“Gilstrap March 2, 2026 Schedule”)
1094	Dufresne et al., “How Reliable Are Trial Dates Relied on by the PTAB in the Fintiv Analysis?” Perkins Coie (Oct. 29, 2021) (“Fintiv Study”)
1095-1099	[reserved]
1100	Petition for <i>Inter Partes</i> Review of United States Patent No. 10,218,995 Pursuant to 35 U.S.C. §§ 311-319, 37 C.F.R. § 42 (Jan. 8, 2024) (“372 IPR Petition”)
1101	Patent Owner’s Preliminary Response, <i>Samsung Elecs. Co. v. Advanced Coding Techs. LLC</i> , IPR2024-00372 (Apr. 22, 2024) (“372 IPR POPR”)

1102	Institution Decision, <i>Samsung Elecs. Co. v. Advanced Coding Techs. LLC</i> , IPR2024-00372, Paper 9 (July 18, 2024) (“372 IPR ID”)
1103-1109	[reserved]
1110	<i>Comm’n Techs., Inc. v. Samsung Elecs. Am., Inc.</i> , No. 2:21-cv-00444-JRG, 2023 WL 1478447 (E.D. Tex. Feb. 2, 2023)
1111	<i>Broadphone LLC v. Samsung Elecs. Co.</i> , No. 2:23-cv-00001-JRG, 2024 WL 3524022 (E.D. Tex. July 24, 2024)
1112	<i>Cobblestone Wireless, LLC v. Cisco Sys., Inc.</i> , No. 2:23-cv-00454-JRG-RSP, 2024 WL 5047854 (E.D. Tex. Dec. 9, 2024)
1113	<i>Foras Techs. Ltd. v. Aptiv PLC</i> , No. 2:23-cv-00314-JRG, 2024 WL 5348631 (E.D. Tex. July 25, 2024)
1114	<i>STA Grp. LLC v. Motorola Sols., Inc.</i> , No. 2:22-cv-00381-JRG-RSP, 2024 WL 2852961 (E.D. Tex. June 5, 2024)
1115	<i>Resonant Sys., Inc. v. Samsung Elecs. Co.</i> , No. 2:22-cv-00423-JRG, 2024 WL 1021023 (E.D. Tex. Mar. 8, 2024)
1116	<i>Vill. Green Techs., LLC v. Samsung Elecs. Co.</i> , No. 2:22-cv-00099-JRG, 2023 WL 416419 (E.D. Tex. Jan. 25, 2023)
1117	Guidance on USPTO’s recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” Mar. 24, 2025, https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf (“Interim Procedure for Discretionary Denials”)
1118	U.S. Patent No. 10,218,995 to Sakazume (“the ’995 Patent”)
1119	Memorandum, “PTAB Consideration of Prior Findings of Fact and Conclusions of Law,” Sept. 16, 2025, https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf (“Memo re PTAB Previous Findings”)
1120	Plaintiff’s Fourth Amended Disclosure of Asserted Claims and Infringement Contentions, Appendix D - Claim Chart for U.S. Patent No. 9,042,448 Against Google Products having AV1 Encoders and Google Encoders (“448 IC Chart”)
1121	Joshi, Urvang et al., “In-loop Frame Super-resolution in AV1,” 2019 Picture Coding Symposium (PCS), IEEE 2019 (“Joshi”)
1122	[reserved]
1123	Claim Construction Memorandum and Order, <i>Advanced Coding Technologies LLC v. Google LLC</i> , No. 2:24-cv-00353 (E.D. Tex.

	Oct. 10, 2025), ECF 86 (“ACT-Google Claim Construction Order”)
1124	Nomination of John A. Squires To Be Under Secretary of Commerce for Intellectual Property and the Director of the United States Patent and Trademark Office, Question for the Record, May 28, 2025, <i>available at</i> https://www.judiciary.senate.gov/imo/media/doc/2025-05-21_qfrresponses_squires.pdf (last visited Oct. 15, 2025)

Petitioner Google LLC (“Google”) submits this opposition to Patent Owner’s Request for Discretionary Denial of Institution (“PO Brief,” Paper 7) filed by Advanced Coding Technologies, LLC (“Patent Owner” or “ACT”). When holistically assessing the circumstances of this case, it is clear that reviewing the ’448 patent is an appropriate use of Office resources. The Petition should be referred for an institution decision on the merits by the Board and not denied discretionarily.

First, referral is warranted to correct the multiple errors that occurred in issuing the ’448 patent. As detailed below, the error resulting from the applicant’s duty of disclosure violation, causing the Office to erroneously allow claims that should have been rejected over the inventor’s previous work, alone supports referral. Further, the Board’s previous consideration of the ’448 patent’s related patent confirms that multiple errors occurred during examination. Evaluating and correcting those errors by referring Google’s Petition is an important use of the Office’s resources and preserves the integrity of the patent system.

Second, the sole discretionary factors addressed in the PO Brief, the status of the parallel litigation and “settled expectations,” do not warrant denial. ACT does not have the “settled expectations” it claims to have, and the litigation’s status, in combination with other factors, does not suggest discretionary denial is appropriate.

I. The Office’s Error During Examination Supports Referral

The record reflects significant Office errors during examination, including an

error caused by the applicant violating the rules, strongly supporting referral.

Although ACT does not argue §325(d) supports denial, and any such arguments are waived, §325(d) provides no basis to exercise discretion. *Advanced Bionics*' first part is not satisfied because the "same or substantially the same art" was not presented to the Office. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) ("*Advanced Bionics*"). Google's Petition relies on Phek, Martins, He, and Sakazume. Martins, He, and Sakazume were not cited by the applicant or examiner during examination, none appear on the patent's face, and none were applied in a rejection or identified in the examiner's reasons for allowance. Accordingly, this Petition's art and arguments are not the same as, or substantially similar to, the art or arguments previously presented to the Office. The Office, therefore, erred at least in not applying the teachings of Martins, He, and Sakazume.

Even if *Advanced Bionics* part 2 is reached, Office error pervaded examination, supporting referral. **First**, the Petition's Ground 2 shows obviousness of all claims over a combination relying primarily on teachings in Sakazume (Ex.1046). Pet.63-84. Ex.1046's first-named inventor, Satoru Sakazume, is the sole inventor of the '448 patent. Ex.1046, (75); Ex.1001, (75). The examiner's reasons for allowance (Ex.1002, 358-361) did not identify any specific allowable limitation, but allowance occurred after the applicant's amendment added limitations [1.6] and [1.7]. *See*

Ex.1002, 321-322. But as the Petition shows, Ex.1046 teaches the subject matter in [1.6] (Pet.80-81), and the Ex.1046-based combination renders obvious the subject matter in [1.7] (Pet.81-82). Although the '448 patent's inventor unquestionably knew his previous work, and should have known the material relevance of Ex.1046 to the patentability of the '448 patent's claims, the applicant **never submitted** Ex.1046 to the Office, in violation of 37 CFR § 1.56. Compounding the applicant's failure to abide by the rules, the Office erred as well, because the examiner never identified Ex.1046, despite searching for prior art by the inventor's name. *See* Ex.1002, 279, 297.

The "Office may consider unfair dealings as a factor when determining whether to exercise discretion to deny institution." *Tessell, Inc. v. Nutanix, Inc.*, IPR2025-00322, Paper 14 at 2 (Dir. June 12, 2025). Further, the Director's public statements argue "errors of all types should be avoided" so that patents are "'born strong,'" starting from grant. Ex.1124, 23. That cannot happen when applicants violate their duty of disclosure; strong patents are only born when all material prior art is considered. Where the applicant withheld material prior art from the Office, in clear violation of the Office's rules, and where the examiner did not find or apply prior art by the same inventor despite its relevance, it is an appropriate use of Office resources to refer this Petition. The Board's evaluation of the patent's merits can correct the ramifications of the applicant's unfair dealings and the Office's error,

further the Director's goals, and preserve the patent system's integrity.

Second, the Board previously found, in instituting IPR2024-00372, obviousness of similar claims in ACT's U.S. Patent 10,218,995 ("the '995 patent"), a divisional of the '448 patent (*see* Ex.1118, (62)). Specifically, the Board evaluated similar claims over teachings in Phek, Martins, and He, confirming Office error during examination; had the examiner found Martins and He and applied their teachings with Phek, the '448 patent's claims would have also been rejected.

The important policy goals and Office interests in correcting errors caused by the applicant's failure to comply with the duty of disclosure, the Board's *Advanced Bionics* precedent, the Board's previous evaluation of the related '995 patent, and the Director's discretionary decisions all support referral, and trial is warranted to review "a material error by the Office." *See, e.g., Microsoft v. ParTec*, IPR2025-00318, Paper 9, 3 (Dir. June 12, 2025) ("*ParTec*"); *Anthony Inc. v. Controltec LLC*, IPR2025-00559, Paper 9, 2 (Dir. July 16, 2025) (finding error where petition's reference was not considered during prosecution).

II. The Process Memorandum's Relevant Considerations Favor Institution

Relevant considerations in Board precedent and the Process Memorandum, including Process Memorandum Factors 1 and 3-7, support referral to a merits panel for institution. *See* Interim Director Discretionary Process ("IDDP"), § I.B.

A. The Board's Previous Evaluation of Related Claims (Process Memorandum Factor 1) Weighs Strongly Towards Referral

The Board's previous evaluation of the '995 patent weighs in favor of referral. ACT previously asserted the '995 patent against Samsung Electronics Co., Ltd., who in response filed a petition challenging the '995 patent, IPR2024-00372 (Ex.1100). The Board instituted IPR after evaluating that petition and ACT's counterarguments (*see* Ex.1101), finding a reasonable likelihood the petitioner had shown the '995 patent's claim 2 was obvious over prior art also asserted here.

Indeed, the Board's Institution Decision in IPR2024-00372 evaluated claims with very similar limitations, over substantially the same prior art as asserted here: the '995 patent's evaluated claim included "super-resolution enlarger" and "resolution converter" limitations, just like the '448 patent's challenged claims. *See* Ex.1102, 4-5; Pet.xiv. The IPR2024-00372 Petition asserted obviousness over teachings in Phek, Martins, and He, which are also used in the instant Petition. *See* Ex.1102, 4-5; Pet.1-2. Finally, the IPR2024-00372 Petition relied on Dr. Cliff Reader's testimony; Dr. Reader's testimony also supports this Petition. *See* Ex.1102, 4-5; Ex.1003. This factor, therefore, strongly weighs towards referral, as the obviousness of these claims is readily apparent from the Board's previous institution decision on similar claims, prior art, and evidence. Consistent with Office policy, deviating from the Board's previous finding would require a "detailed explanation" because substantially the same evidence and/or arguments as presented previously are now before the Office; referral is, therefore, warranted. *See* Ex.1119.

B. Strong Unpatentability Challenges Support Referral (Factor 3)

ACT does not address the Petition's strength or explain the merits' relevance; accordingly, this factor cannot weigh towards denial. *See generally* PO Brief; IDDP §II.C.i; *Twitch Interactive, Inc. v. Razdog Holdings LLC*, IPR2025-00307, Paper 18 at 3 (Dir. May 16, 2025) ("*Twitch*") (referring petition and noting patent owner's allegations in favor of discretionary denial lacked explanation).

Google's Petition shows explicit disclosure or teaching of each challenged claim limitation, backed by Dr. Reader's expert testimony (Ex.1003) confirming how a POSITA would have viewed the references' teachings and why those teachings would have been combined. Given the lack of **any** argument countering the strength of Google's Petition, this factor weighs strongly in favor of referral.

C. Reliance on Expert Testimony Supports Referral (Factor 4)

Consistent with precedent and Office guidance, Dr. Reader's testimony weighs towards referral because it provides a technology overview, a detailed summary of the art, and why/how the art would be combined to render obvious the claims. Additionally, the cited art, and additional evidence a POSITA would have considered in evaluating the patent, support his testimony. ACT does not address this factor or argue the Petition's reliance is not proper, which would be incorrect.

D. Settled Expectations Favor Referral (Factor 5)

Google's settled expectations and numerous other facts outweigh ACT's settled expectations argument relying solely on the patent's age. First, despite the

IDDP's requirement that a party's brief be "supported with facts **and evidence**" (IDDP § I.C.), ACT's brief includes no evidence supporting its expectations, rendering its argument plainly insufficient. *Twitch*, 3 ("alleged settled expectations" allegation not "sufficiently explained"). Nevertheless, even considering a patent's age and resultant potential settled expectations, there may be, as here, persuasive reasons why review and referral are warranted. *See Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2-3 (Dir. June 26, 2025) ("*Intel*"). These considerations weigh overwhelmingly against ACT's settled expectations claim.

No commercialization/marketing: The patent statute requires marking products commercializing the '448 patent's claims. *See* 35 USC § 287(a). ACT alleges compliance with §287 (Ex.1092, 36), but has not provided evidence of marked products. ACT is a non-practicing entity that did not commercialize the patent (*see* Ex.1054) and has not shown commercialization or marking by licensees.

ACT's '448 patent district court case accuses Google's products that implement the AV1 video coding standard, meaning ACT considers the mere use of the standard a factor in infringement. *See, e.g.,* Ex.1092, ¶148, PO Brief 4. But ACT cannot argue AV1's development or use is commercialization of the patent because there has been no determination this standard implicates the patent. Accordingly, this consideration weighs against ACT.

No assertion until 2024: The '448 patent was never asserted by its original

owners. ACT acquired the patent in February 2022 (Ex.1053) but did not assert the patent for over two years, until August 2024. Thus, for nine years (two during ACT's ownership), the patent sat dormant, with no evidence that it would be asserted. The lack of assertion cuts against any claim of settled expectations.

Additionally, ACT's delayed assertion, including after acquisition, meant Google had no reason to anticipate assertion. ACT's '448 patent infringement contentions (*see* Ex.1120, 7-10 citing Ex.1121) reference an IEEE paper published in 2019 (*see* Ex.1121), **three years** before ACT's acquisition and **five years** before ACT's assertion, to support its infringement theory. ACT's unexplained years-long delay of assertion after acquiring the patent, despite the relevant standard being known before its acquisition, led to Google expecting non-assertion, outweighing ACT's expectations. *See also Home Depot USA, Inc. v. H2 Intellect LLC*, IPR2025-00480, Paper 11 at 2-3 (Dir. Sept. 4, 2025) (referring petition where petitioner's reasons it did not anticipate assertion weighed against patent owner's expectations).

No licensing: ACT has alleged licensing to three parties, each apparently the product of ACT's assertions (detailed below), which began in 2022. Ex.1058, 25. ACT has only owned the patent since February 2022. Ex.1053. There is no evidence in this IPR that the previous owner licensed the patent. The lack of licensing prior to ACT's ownership cuts against ACT's settled expectations and in favor of review.

No application in technology space: Google does not infringe any claim of

the '448 patent, and there is no evidence that the '448 patent's claims are implicated by any standard. *See also* Ex.1059, 41. There is no evidence the '448 patent has been applied in Google's technology space, cutting against any settled expectations.

No long-standing knowledge: ACT gave no notice of its patents or allegations before filing suit, cutting against any settled expectations. *Cf. iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 2-3 (Dir. June 6, 2025).

Other facts contradict ACT's settled expectations: ACT's "settled expectations" argument is contradicted by the fact that it did not assert the '448 patent until **after** it knew its related '995 patent was likely unpatentable: ACT's amended complaint asserting the '448 patent against Google was filed in August 2024, after the July 2024 institution in IPR2024-00372. By that time, ACT knew that the '448 patent's validity was in question and would have expected a challenge to be a near-certainty. Indeed, even when ACT acquired the patent, it did so knowing it would be subject to challenge and would have **expected** challenges upon assertion. *See Celgene Corp. v. Peter*, 931 F.3d 1342, 1361-1362 (Fed. Cir. 2019) (patent owners have had the "expectation...for nearly four decades" that "patents are open to PTO reconsideration."). ACT's assignment enumerated rights, title, and interest in the patents including "reexaminations" confirming ACT had expectations that its purchased patents would be reviewed. Ex.1053, 19.

Further, ACT provides nothing to support its barebones, conclusory argument

of settled expectations and did not show it acquired the prior owner's expectations or show that it developed its own expectations after the acquisition. ACT withheld from the Director the purchase agreement, which would have shown, *e.g.*, the amount paid, and any validity representations, for the '448 patent. ACT's strategic decision to withhold relevant facts suggests the facts are adverse to ACT, and its discretionary denial request based on settled expectations without evidence to support existence of those settled expectations should be held against ACT.

While ACT refrained from providing evidence of its subjective expectations, ACT's litigation strategy provides substantial circumstantial evidence that ACT has no settled expectations in any one particular patent it acquired. ACT's pattern of filing multiple lawsuits asserting numerous patents and then settling the cases before any merits evaluation occurs, or once IPRs are instituted, indicates ACT has no settled expectations as to any asserted patent. *See, e.g.*, Ex.1064-1066 (filing and quickly settling suit against TikTok); Ex.1056-1057, 1067-1068, 1070 (filing suits against LG/Samsung and quickly settling LG suit before merits evaluation and Samsung suit after IPRs instituted). ACT apparently has no willingness to have its patents fully evaluated on the merits, whether by the Office or district court.

ACT's argument also runs contrary to governing statutes. While Congress has expressly immunized patents of a certain age from post-issuance challenges (*see, e.g.*, H.R. Rep. No. 112-98, pt. 1, at 46-48 (2011) (certain patents immunized from

inter partes reexamination)) or expressly limited them in other ways (see AIA §§ 3(n)(1), 6(f)(2)(A) (immunizing patents from PGR); AIA § 18 (sunset for CBMs)), Congress took the opposite approach for IPRs, eliminating any date-based carveout such that “**all patents can be challenged** in *inter partes* review,” regardless of age. See H.R. Rep. No. 112-98, at 46-48 (emphasis added). “Congress’s choice to depart from the model of a closely related statute is a choice neither we nor the agency may disregard.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 364 (2018).¹

Google’s settled expectations accordingly weigh in favor of referral and outweigh ACT’s underexplained settled expectations contentions.

E. Compelling Economic and Public Interests Supports Referral

Compelling economic interests also favor institution because Google’s strong economic presence in the United States has contributed to American innovation for almost 30 years. Ex.1072. Google employs over 100,000 people. Ex.1073. In 2024, Google invested over \$49 billion in research and development to power American technological leadership and to produce unprecedented leaps in artificial intelligence

¹ The Director’s application of “settled expectations” also exceeds his authority under the law and is barred by judicial estoppel based on the Office repeatedly advancing the position that a patentee lacked an expectation that its patents would not be challenged. See *Celgene*, 931 F.3d at 1361-62; see also 5 U.S.C. § 706(2)(A).

and quantum computing capabilities that advance national security. *See* Ex.1073. Moreover, in 2024 Google created \$850 billion in economic activity for American businesses, nonprofits, publishers, creators, and developers and maintains offices or data centers in 26 states. *See* Ex.1073.

ACT, by contrast, is a holding company formed just months before it acquired the '448 patent and others. Ex.1054. ACT does not practice the patent or sell any products and does not contribute to or otherwise use its intellectual property to advance domestic economic interests. This factor, therefore, favors institution.

ACT's request to reward its actions with discretionary denial of this IPR is unwarranted. This IPR epitomizes IPRs' very purpose: "to weed out bad patent claims" being levied against the industry and burdening American companies' technological and economic contributions via "overpatenting." *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020). In creating the PTAB, the "signature accomplishment" of the AIA (Ex.1079, 2), "Congress was [] concerned that poor-quality patents fueled litigation by so-called 'patent trolls,' a pejorative term for patent plaintiffs that do not manufacture or sell the patented products." Ex.1080, 2.

Referral and institution serves the public interest; doing so would streamline the instant dispute between ACT and Google and disputes involving other parties (*e.g.*, Apple, *see* Ex.1071). Institution and an unpatentability finding would prevent ACT from future unjustifiable assertions. Although the '448 patent is only currently

asserted against Google and Apple, ACT's litigation history and its allegations against products employing the widely-used AV1 standard suggests ACT's target list is lengthy, and ACT is likely to continue its pattern of serially asserting its patent against additional defendants that also use these standards, creating further inefficiencies with the courts and the Office. *See, e.g.*, Ex.1075 (AV1 implementers).

F. Other Considerations Support Referral (Factor 7)

The “complex and diverse” litigation, involving multiple patents in different families, “tip[s] the balance against discretionary denial”: “the Board is better suited to review a large number of patents involving diverse subject matter.” *Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00217, Paper 9 at 2 (Dir. June 13, 2025).

ACT's litigation involves six patents in five families, with distinct subject matter and differences in accused products; all patents are subject to Google's IPRs:

IPR	Patent No.	Claimed Subject Matter	Accused Product
IPR2025-00998	8,090,025	Motion Compensation and Smoothing Block Borders	AV1 encoder/decoder chipsets and software
IPR2025-00999	9,986,303	Adaptive Bitrate Streaming	AV1 encoder/decoder chipsets and software
IPR2025-01000	10,218,995	Super-Resolution Image Enhancement	AV1 encoder/decoder chipsets and software
IPR2025-01161	7,804,891	Communication Quality Judgment for Wireless Communication	5G NR Smartphones and WiFi 6 devices
IPR2025-01277	8,230,101	Storage of Multimedia Content	Network content delivery systems
IPR2025-01278	9,042,448	Super-Resolution Image Enhancement	AV1 encoder/decoder chipsets and software

Unique here, the Board is particularly well situated to evaluate this large

number of patents, having already performed a preliminary evaluation of half of the patents (*see, e.g.*, IPR2025-00998, Paper 8; IPR2025-00999, Paper 8), including the '448 patent's related patent, the '995 patent (*see* IPR2025-01000, Paper 8).

Additionally, review is justified based on ACT's litigation strategy of serially asserting patents against defendants alleging infringement by similar products, imposing inefficiencies on the courts and Office. *See also Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 2 (Dir. July 2, 2025) (patent owner's assertion against a large number of parties weighed in favor of referral because "resolving the dispute ... at the Office would be more efficient.").

G. Process Memorandum Factor 2 is Neutral

No new judicial precedent impacts this case; this consideration is neutral.

III. General Plastic Factors Weigh in Favor of Referral

ACT doesn't address *General Plastic*, which, nevertheless, does not weigh in favor of denial, because Google has not previously filed a petition against any claim of the '448 patent. *See Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential); *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) (precedential).

The '448 patent is also being challenged by Apple Inc., but ACT does not argue Apple's petition should impact the discretionary decision, and it should not. Google and Apple are not the same party and do not possess a *Valve*-like significant

relationship, and Google had no involvement with or input into Apple's IPR. Nor are the petitions "parallel petitions." *See* Trial Practice Guide, 58-59. Google and Apple are simply defendants in different district court proceedings with different allegedly infringing products; their separate IPR filings are the product solely of ACT's "staggered assertions," nothing more. *Volkswagen Group of Am., Inc. v. Neo Wireless LLC*, IPR2022-01537, Paper 8 at 11-12 (PTAB May 5, 2023).

IV. The *Fintiv* Factors Weigh in Favor of Referral

Most of the PO Brief argues the Director should deny the Petition under §314(a) given the parallel litigation. But efficiency, fairness, and the merits support institution, especially considering all factors holistically. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential) ("*Fintiv*").

A. Factor 1: No Stay Requested But May Be Granted, Weighing in Favor of Referral/Institution or at Worst Neutral

Factor 1 evaluates whether a stay exists or may be granted after institution (*Fintiv*, 6). Here, "the record contains adequate evidence that the District Court may grant a stay upon institution," even if "not specifically directed to this proceeding," and, thus, Factor 1 weighs against denial. *See Juniper Networks, Inc. v. Packet Intelligence LLC*, IPR2020-00336, Paper 21 at 16 (PTAB Sept. 10, 2020).

A stay is possible. In deciding whether to stay litigation pending IPR, the Eastern District of Texas considers: (1) whether a stay will unduly prejudice or present clear tactical disadvantage to the nonmoving party, (2) whether a stay will

simplify the issues in question and the trial of the case, and (3) whether discovery is complete and whether a trial date has been set. *BarTex Rsch., LLC v. FedEx Corp.*, 611 F. Supp. 2d 647, 649-50 (E.D. Tex. 2009).

The court often stays litigation even when the final written decision deadline lags the scheduled trial date by several months. *See, e.g.*, Ex.1110 (five months); Ex.1111 (three months). And the court regularly finds that instituted IPRs meet the stay factors and issues stays despite its otherwise aggressive procedural schedules. *See, e.g.*, Ex.1112; Ex.1113; Ex.1111; Ex.1114; Ex.1115; Ex.1110; Ex.1116. Judge Gilstrap also grants motions to stay IPRs regularly. *See* Ex.1086.

The court has also observed that the PTAB's IPR determinations "could narrow the issues before the court, prevent duplicative or unnecessary discovery, and encourage settlement or dismissal." *Norman IP Holdings, LLC v. TP-Link Techs., Co.*, No. 6:13-cv-384-JDL, 2014 WL 5035718, at *3 (E.D. Tex. Oct. 8, 2014). That is particularly relevant here, because after the Board instituted Samsung's IPR on ACT's patents, ACT swiftly settled its disputes with Samsung. And removing asserted patents/claims from litigation due to parallel IPR proceedings creates invaluable efficiencies in the district court. The court has also found that "the outcome of a PTO proceeding is likely to assist the court in determining patent validity or eliminate the need to try infringement issues." *NFC Tech. LLC v. HTC Am., Inc.*, No. 2:13-cv-1058-WCB, 2015 WL 1069111, at *1 (E.D. Tex. Mar. 11,

2015) (citations omitted). Thus, any IPR that would remove or greatly reduce asserted patents/claims is “likely to assist” the court by streamlining a potentially unwieldy trial. *Id.* Streamlining is especially helpful where, as here, the asserted patents cover different subject matter and Google’s IPRs cite different prior art. Significant efficiencies would be gained by adjudicating validity before the PTAB.

Even if this factor does not weigh in favor of institution based on the above, at the very least, Google has not requested a stay in the parallel litigation, so *Fintiv* factor 1 is neutral. *See, e.g., Hulu, LLC v. SITO Mobile R&D IP, Ltd.*, IPR2021-00298, Paper 11 at 10-11 (PTAB May 19, 2021). Factor 1, properly considered, should weigh in favor of institution, or, at worst, neutrally.

B. Factor 2: Schedule Weighs Neutrally for Referral/Institution

There is evidence that trial will not commence on the scheduled date, and, thus, Factor 2 does not weigh strongly in favor of discretionary denial. The Board considers “**evidence that the parties make of record that bears on the proximity of the district court's trial date ... including median time-to-trial statistics.**” (emphasis added). *See* Ex.1117. Recent statistics show the median time from filing to trial in the Eastern District of Texas is roughly 26 months. *See* Ex.1087 (26.2 months); Ex.1088 (25.9 months). Measured from ACT’s August 2024 amended complaint asserting the ’448 patent, trial will not occur until at least October 2026 — seven months after the currently scheduled March 2026 jury selection date and

three months before the projected final written decision statutory deadline. The Director has referred petitions even in light of a similar difference between a relevant ITC date and the FWD date, after holistically considering discretionary factors as a whole. *See, e.g., POSCO Co. v. ArcelorMittal*, IPR2025-00370, Paper 10 at 2-4 (Dir. June 25, 2025). A balanced *Fintiv* factor assessment has similarly resulted in institution despite a five-month or more gap between a scheduled trial date and FWD due date. *See Kia Corp. v. Emerging Auto. LLC*, IPR2024-00981, Paper 10 at 20, 23 (PTAB Dec. 18, 2024); *Google LLC v. Multimodal Media LLC*, IPR2024-00056, Paper 9 at 8 (PTAB Apr. 12, 2024) (instituting with approx. six months gap).

Additionally, Judge Gilstrap set the jury selection date **before** the '448 patent was added to the case; thus, time-to-trial statistics are even more likely to be accurate. *See Ex.1089; see also Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00321, Paper 10 at 10 (PTAB June 18, 2025) (statistics for Judge Gilstrap meant Factor 2 was neutral or slightly against denial). Other evidence bearing on the proximity of the trial date also suggests uncertainty. Judge Gilstrap's March 2, 2026, schedule shows jury selection in two other cases and pretrial conferences in five other cases. *See Ex.1093, 3-4 (Brewster and Wynne set for jury selection on March 2, 2026); see also BOE Tech. Grp. Co. v. Optronix Scis. LLC*, IPR2024-01131, Paper 15 at 11 (PTAB Feb. 12, 2025) (factor 2 neutral or slightly against discretion where multiple cases scheduled for jury selection on same date). One or more of these dates

is likely to slip, and trial is statistically very likely to be delayed. *See* Ex.1094 (study finding scheduled trial dates were “wrong 94% of the time” compared to actual trial dates, the vast majority being delayed three to six months). Factor 2 does not weigh strongly in favor of exercising discretion; at worst, it is neutral.

C. Factor 3: Investment Weighs In Favor of Referral/Institution

In the litigation, a claim construction order issued on October 10, 2025. *See* Ex.1123. No other pertinent orders have issued. Accordingly, the limited investment in the parallel proceeding (*Fintiv* at 9-12) weighs against discretionary denial.

D. Factor 4: Limited Overlap Weighs in Favor of Referral

Google's *Sotera* stipulation (Ex.1050) weighs strongly against exercising discretion. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential). There will be minimal or no overlap between the Board's invalidity evaluation and the court's favoring referral. *Fintiv* at 12-13.

E. Factor 5: Same Parties Weighs Neutrally for Referral/Institution

When the parties are the same, the Board regularly weighs this neutrally. *See, e.g., Nokia v. Soto*, IPR2023-00680, Paper 30 at 13 (Dir. Dec. 3, 2024).

F. Factor 6: Other Circumstances Weigh in Favor of Referral

“Other circumstances,” including the applicant's violation of Office rules by withholding material prior art, and the petition's merits, strongly favor referral. *See, e.g., ParTec*, 3 (referring petition based on petitioner's showing of material error despite scheduled district court trial date preceding projected final written decision

date). Additionally, decisions issued before the rescinded June 2022 Memo confirm a strong merits showing weighs towards referral and institution when taking a “holistic view of whether efficiency and integrity of the system are best served by denying or instituting review” (*Fintiv*, 6). *See also, e.g., Illumina Inc. v. Trs. of Columbia Univ.*, IPR2020-00988, Paper 20 at 8-15 (PTAB Dec. 8, 2020); *Synthego Corp. v. Agilent Techs., Inc.*, IPR2022-00402, Paper 11 at 12-19 (PTAB May 31, 2022); *Samsung Elecs. Co. v. Scramoge Tech., Ltd.*, IPR2022-00241, Paper 10 (PTAB June 13, 2022); *Illumina, Inc. v. Natera, Inc.*, IPR2019-01201, Paper 19 at 8 (PTAB Dec. 18, 2019); *NetNut Ltd. v. Bright Data Ltd.*, IPR2021-01492, Paper 12 at 9-16 (PTAB Mar. 21, 2022); *Coolit Sys., Inc. v. Asetek Danmark A/S*, IPR2021-01195, Paper 10 at 11 (PTAB Dec. 28, 2021).

V. Conclusion

A holistic assessment of the arguments and evidence present in this case demonstrates the Director should refer the Petition for a merits evaluation.²

² Petitioner reserves the right to challenge the March 26, 2025 Interim Processes for PTAB Workload Management, including that document's list of “relevant factors,” at least because that document is legally invalid as: (1) exceeding the Director's authority, (2) arbitrary and capricious, and (3) adopted without notice-and-comment rulemaking.

Respectfully submitted,

Dated: October 16, 2025

By: / Raghav Bajaj /

Raghav Bajaj (Reg. No. 66,630)
raghav.bajaj@lw.com
Latham & Watkins LLP
300 Colorado Ave. Suite 2400
Austin, TX 78701
Telephone: 737.910.7370
Fax: 737.910.7301

Counsel for Petitioner
Google LLC

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 16th day of October, 2025, a true and correct copy of the foregoing **Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution and all Exhibits** were served by electronic mail on Patent Owner's lead and backup counsel at the following email addresses:

Peter Lambrianakos
Vincent J. Rubino, III
Alfred R. Fabricant
Joseph M. Mercadante
Julian G. Pymonto
FABRICANT LLP
PTAB@fabricantllp.com
plambrianakos@fabricantllp.com
vrubino@fabricantllp.com
ffabricant@fabricantllp.com
jmercadante@fabricantllp.com
jpymonto@fabricantllp.com

By: / Raghav Bajaj /

Raghav Bajaj (Reg. No. 66,630)
raghav.bajaj@lw.com
Latham & Watkins LLP
300 Colorado Ave. Suite 2400
Austin, TX 78701
Telephone: 737.910.7370
Fax: 737.910.7301

Counsel for Petitioner
Google LLC