

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

CARDWARE INC.,
Patent Owner.

Case No. IPR2025-01514
U.S. Patent No. 11,176,538

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

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I. INTRODUCTION

Google's Petition should be instituted to review Patent No. 11,176,538 ("the '538 patent") because of the wholly inadequate examination associated with the '538 patent. The '538 patent issued following a first action allowance by an Examiner who failed to raise prior art rejections for five related patents. Patent Owner CardWare subsequently filed terminal disclaimers linking the '538 patent to these related patents, effectively admitting that the claims are not patentably distinct. Unsurprisingly, the Board has previously instituted trial against claims of these related patents, which prompted settlement and dismissal of the petitions. The '538 patent remains the sole outlier that should not be shielded from review only because another petitioner's petition was denied after applying the wrong references. This Petition applies the asserted references from the previously instituted petitions.

As discussed further below, Google respectfully submits that, in these circumstances, particularly given the strength of Google's unpatentability grounds, it would be a good use of the Office's resources to institute review.

II. THE PETITION SHOULD BE INSTITUTED TO CORRECT A LACKLUSTER EXAMINATION

The Examiner's lackluster examination resulted in the issuance of unpatentable claims. During prosecution, the Examiner failed to raise a single prior art rejection. In the Notice of Allowance, the Examiner simply stated that "none of

the prior art teaches” the claimed combination of features. EX1002 at 141. The same Examiner reached similar conclusions across the '538 patent's five parent patents: the Examiner failed to raise prior art rejections for four of them and found allowable all but 4 claims of another in the first Office action before withdrawing the rejection without a reasoned explanation. *See* EX1085 (patent family listing); EX1072 at 69–72, 112–117; EX1049 at 67–70, 134–141; EX1048 at 78–83, 108–114; EX1047 at 58–65; EX1078 at 79–86. The Office should not defer to such a deficient examination.

Post-issuance events confirm the deficient examination. After the '538 patent issued, CardWare filed terminal disclaimers to related U.S. Patent Nos. 10,339,520 (“the '520 patent”), 10,628,820 (“the '820 patent”), 10,810,579 (“the '579 patent”), and 11,328,286 (“the '286 patent”). EX1002 at 209 (the '520 patent), 211 (the '579 patent), 213 (the '820 patent), 215 (application “16/854,829” that issued as the '286 patent); *see also* EX1086, 1 (application 16/854,829 issued as the '286 patent). CardWare's post-issuance filings confirm that the original examination was deficient: the Examiner failed to identify the obvious overlap between these patentably indistinct claims. After CardWare filed its terminal disclaimers, Samsung filed six parallel petitions against the '520, '579, '820, and '286 patents. EX1053. The Board instituted five of these petitions, which prompted a settlement and termination soon after. EX1053; EX1059; EX1065; EX1067–EX1069; EX1087.

Google's Petition should be instituted because it corrects these oversights by applying the asserted references from the instituted petitions. Google relies on the Gomez, Phillips, and Casey references that were asserted in the previously instituted petitions. EX1065 at 5; EX1067 at 6; EX1068 at 8; EX1087 at 6. While the Board previously denied a challenge to the '538 patent, that petition relied on Royyuru and omitted Google's primary reference Gomez. EX1066 at 6; Pet. 4–5. Google's Petition applies Gomez combined with Phillips and Casey. Google's Petition additionally relies on the Law reference, which is a different publication than the Law reference previously asserted by Samsung. *Compare* Pet. at 4–5, *with* EX1066 at 6. Because Google's Petition leverages references previously reviewed by the Board, institution would be an efficient and good use of Office resources.

III. THE PETITION SHOULD BE INSTITUTED FOR THE BOARD TO EFFICIENTLY REVIEW THE '538 PATENT

The Petition should be instituted for the Board to adjudicate the '538 patent. The '538 patent is involved in two District Court cases, *CardWare Inc. v. Apple Inc.*, No. 1:25-cv-00446-ADA (W.D. Tex. Nov. 4, 2024) (“Apple district court case”) and *CardWare Inc. v. Google LLC*, No. 7:24-cv-00278-DC (W.D. Tex. Nov. 4, 2024) (“Google district court case”). As both the Google and Apple district court cases involving the same patents were filed in the same District but ended up with different Judges, the Board's adjudication of these patents may allow the District Court to avoid duplicative invalidity efforts and inconsistent outcomes. Google had also filed

petitions against the other three asserted patents (U.S. Pat. Nos. 10,339,520, 10,810,579, 11,620,634) on similar grounds. *See* IPR2025-01361, IPR2025-01344, IPR2025-01513. While the Director exercised discretion to deny institution in two of those proceedings (EX1081 (IPR2025-01344 and IPR2025-01361)), institution is strongly warranted here. The '538 patent suffered from insufficient examination as evident by the failure to issue rejections based on prior art or double patenting, which requires Board expertise to resolve. Instituting review here would still streamline the district court case by removing complex and insufficiently examined claims from the litigation. *See, e.g., Taiwan Semiconductor Mfg. Co. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 (Director Sept. 3, 2025) (referring only a subset of related IPRs).

The factors enumerated in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (precedential) further confirm that the Petition should be instituted.

***Fintiv* Factor 1 (stay)** weighs in favor of institution because the Google district court case may be stayed. Google would move to stay the Google district court case if the Board institutes review, and Judge Counts may be inclined to grant a stay. *See, e.g., Greenthread, LLC v. Cirrus Logic, Inc.*, WDTX-1-23-cv-00369-DC (Order Sep. 06, 2024) (granting post-institution stay). Furthermore, the parallel Apple and Google district court cases before two different Judges in the same

District create a unique risk of inconsistent outcomes within the District itself, which may be an additional reason for a stay pending the Board's review of the patentability issues.

***Fintiv* Factor 2 (trial)** weighs in favor of institution because time to trial statistics indicate that the Board's Final Written Decision ("FWD") is expected to occur at least 5 months before the trial in both the Apple and Google district court cases. The Board accorded a filing date on September 15, 2025, which means the Board is expected to issue a FWD by March 2027. *See* Paper 5. CardWare mentions that the Apple district court case is scheduled for trial in July 2026 and the Google district court case for September 2026 (DD Req. 3–5), but the current time-to-trial in the Western District of Texas is 32.8 months for civil cases generally (EX1084) or 43 months for patent cases specifically (EX1083), which is an increase from 41 months in the last two months (EX1050). The Apple and Google district court cases were both filed on November 4, 2024, which pushes the statistically expected trial dates to August 2027 or June 2028. CardWare's trial statistics are unpersuasive because they aggregate patent cases going back to 2008. *See* EX2017 ("2008"). Accordingly, *Fintiv* Factor 2 weighs in favor of institution.

***Fintiv* Factor 3 (investment)** weighs in favor of institution because the Board's review of the patentability of the '538 patent would absolve the Western District of Texas from duplicative effort and potentially inconsistent outcomes

between two different cases. Both the Apple and Google district court cases were filed on the same day in the Western District of Texas. The Apple case is with Judge Albright and the Google case is with Judge Counts. Each district court case has overlapping validity issues being considered on very similar schedules. Unless the Board resolves the patentability of the '538 patent, the resources of the Western District of Texas will be unnecessarily spent on the simultaneous consideration of overlapping issues. If both cases go to trial, there is a risk of inconsistent outcomes coming from the same District. Instituting the Petition to the Board may assist the Western District of Texas conserve judicial and party resources, and achieve the AIA's goal of efficient determination of patentability. Accordingly, *Fintiv* Factor 3 weighs in favor of institution.

***Fintiv* Factor 4 (overlap)** weighs in favor of institution because Google's *Sotera* stipulation (EX2014) eliminates any meaningful overlap between this proceeding and the Google district court case. CardWare speculates about system art (DD Req. 7–8), but system art cannot be raised before the Board.

CardWare's additional arguments about other types of challenges are irrelevant. First, CardWare conflates the use of references in obviousness grounds and the use of references to explain background knowledge in a § 101 contention. *See* DD Req. 8–9. Google's stipulation prevents overlapping grounds because courts have recognized that patent eligibility and obviousness are statutorily separated and

different inquiries. *See, e.g.*, MPEP § 2106 (collecting cases). Second, CardWare speculates about whether Google will file *ex parte* reexaminations (DD Req. 8–9), but Google has not challenged the '538 patent in such proceedings nor can Google do so because such proceedings are stayed while there is a pending IPR. Third, as for the Apple district court case (DD Req. 9), Google is not involved and CardWare recognized that “Apple, [is] a competitor of Petitioner” (DD Req. 5). CardWare’s decision to file suit against both Apple and Google on the same day is a litigation decision for which CardWare should not be rewarded with an ability to evade review. Accordingly, *Fintiv* Factor 4 weighs in favor of institution.

***Fintiv* Factor 5 (parties)** weighs in favor of institution because the Board’s FWD will issue before the statistically projected trial dates in the Apple and Google district court cases. In the Apple district court case, Google is not a party. In the Google district court case, the *Sotera* stipulation in this proceeding will effectively subject Google to estoppel before trial. *See NeuMoDx Molecular, Inc. v. HandyLab, Inc.*, IPR2020-01133, Paper 23 at 13–14 (P.T.A.B. Aug. 6, 2021) (“The parties in this proceeding are identical to the parties in the parallel litigation. Because the final written decision in this case will issue before trial in the parallel litigation, this factor weighs against exercising discretion to deny institution.”). Accordingly, *Fintiv* Factor 5 weighs in favor of institution.

***Fintiv* Factor 6 (merits)** weighs in favor of institution because, as explained

above, the Examiner only engaged in a cursory review of the claims. The '538 patent was never rejected during prosecution. The lackluster examination is confirmed by CardWare's multiple post-issuance terminal disclaimers and the Board's multiple institutions (followed by settlement) against multiple related patents. EX1065; EX1067–EX1069; EX1087. Institution would remedy the Office's lackluster review and preserve the integrity of the patent system by allowing the Board to use its expertise—with the patent family, the prior art, and examination practices—to review the '538 patent so that two different District Court Judges can avoid duplication or inconsistency. Accordingly, *Fintiv* Factor 6 weighs in favor of institution.

IV. OTHER PROCEEDINGS DO NOT WARRANT DISCRETIONARY DENIAL

CardWare argues that the existence of parallel district court litigations against Google and Apple favors denial to avoid “duplicative efforts” and “inconsistent outcomes.” DD Req. 10. This argument is meritless and ignores the facts of this proceeding. First, Google provided a *Sotera* stipulation. EX2014. Second, Google is not a party to the Apple litigation. Denying institution based on unrelated litigation would effectively allow a patent owner to immunize a patent from IPR simply by suing multiple defendants, thereby creating “parallel proceedings” that block access to the Board.

Third, far from creating inefficiency, instituting review is the most efficient course of action. A Final Written Decision from the Board adjudicating the challenged claims would resolve the validity issues for both the Google and Apple district court cases. CardWare warns of “inconsistent outcomes” between the Board and the District Courts, but the most significant risk of inconsistency lies within the Office itself. It would be the height of inefficiency and inconsistency to expend judicial resources to adjudicate claims that the Office has already preliminarily determined are unpatentable. To ensure administrative consistency and protect the integrity of the patent system, the Board should institute review and finalize the determination it began in 2023.

V. THE PETITION SHOULD BE INSTITUTED BECAUSE THE '538 PATENT HAS NOT DEVELOPED ANY SETTLED EXPECTATIONS SINCE ITS 2021 ISSUANCE

To the extent settled expectations are considered,¹ the Petition should be instituted because the '538 patent has not developed any settled expectations since its 2021 issuance. As explained above, there are numerous indicators of the '538 patent's susceptibility to unpatentability that prevent the development of settled

¹ Settled expectations should not be considered in IPRs. *See Celgene Corp. v. Peter*, 931 F.3d 1342, 1361-62 (Fed. Cir. 2019); *see also* 5 U.S.C. § 706(2)(A). But if they are considered, settled expectations favor Petitioner here.

expectations: the previous institution of the petition challenging the '538 patent, institutions against the related patents, and the Examiner's cursory examination.

CardWare's arguments about settled expectations arising from notice are misguided. CardWare's February 2023 subpoena for information about Google's products for a district court case against Samsung (DD Req. 14) is irrelevant because Samsung, not Google, was accused of infringement. Google was otherwise not involved in Samsung's case, and CardWare recognized that "Samsung, [is] a competitor of Petitioner." DD Req. 14. CardWare purportedly "provided specific notice" of the '538 patent to Google in October 2023 (DD Req. 14), but CardWare merely sent a letter that listed its patents (EX2019; EX2020).

CardWare's argument that Google could have joined Samsung or Apple in challenging patents (DD Req. 15–18) is nonsensical, and if anything illustrates CardWare's gamesmanship. Samsung's petition against the '538 patent was filed in November 2022, before CardWare's February 2023 subpoena. EX1085. CardWare and Samsung subsequently moved to terminate their petitions in October 2023 (*see, e.g.*, EX1082), and it was only that same month that CardWare sent Google a letter about the '538 patent (EX2019). In view of all these developments, it would have been a waste of resources for Google to challenge the '538 patent before CardWare filed its complaint in November 2024, after which Google timely filed this Petition

in September 2025. As for Apple's petitions, those were filed only a few months before Google, by which point Google was about to file its own petitions.

CardWare's road mapping arguments are meritless. DD Req. 16. CardWare is improperly conflating Google with unrelated third parties Samsung and Apple. Indeed, even CardWare recognized they are Google's competitors (DD Req. 5, 14); Google has never previously challenged the '538 patent or been a co-defendant with Apple or Samsung against CardWare. *Cf. Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 at 9–10 (P.T.A.B. Apr. 2, 2019) (precedential) (considering previous petitions by other petitioners if the petitioners have a “significant relationship”).

Google does not attempt to fix Samsung's denied grounds that relied on Royyuru, but rather presents new grounds that incorporate the same Gomez, Phillips, and Casey references that the Board has reviewed in decisions instituting petitions against related patents. As for the “new reference” Law, this reference is a different publication than the Law reference previously asserted by Samsung. Pet. at 4–5; *see also* EX1066 at 6 (different Law reference compared to Google's Petition). Presenting new grounds based on those the Board has previously instituted does not implicate “road mapping” concerns but rather aligns the '538 patent with the Board's findings on the rest of the family. *See also General Plastic Industries Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (P.T.A.B. Sept. 6, 2017)

(precedential) (delineating factors). Google's approach enables the Board to leverage its familiarity with the prior art to efficiently review grounds that were previously instituted while also curing the Examiner's oversights with new grounds.

As for CardWare's argument about repeat challenges (DD Req. 15–18), they overlook the landscape involving the '538 patent. CardWare lists Samsung's and Apple's petitions against the related patents (DD Req. 18), but these petitions arose from CardWare's own litigation activity. CardWare strategically settled with Samsung to terminate the instituted Samsung petitions, and then CardWare filed suit against both Apple and Google, who responded with their own petitions. CardWare's citation of *Intel Corp. v. Advanced Cluster Sys., Inc.*, IPR2025-00794, Paper 13 (Director Aug. 14, 2025), where the Board previously denied two petitions against the challenged patent, is inapposite. First, the Board's multiple institutions against patentably indistinct claims of the related patents offsets the Board's denial of Samsung's petition challenging the '538 patent. Second, Samsung's denied petition did not assert the Gomez, Phillips, and Casey combination that is now asserted by Google's Petition. Third, Apple's petitions were denied in a summary notice for discretionary reasons rather than on the merits. EX1080. Accordingly, CardWare's concerns over repeat challenges should be dismissed.

CardWare's final argument about its commercial efforts only cites its own Complaint. DD Req. 18–19 (citing EX2004 ¶¶13–17). Just like CardWare's filings

to the Patent Examiner omitted the petitions before the Board, CardWare's Complaint says its "innovations include its SmartTokenization™ technology" (EX2004 ¶15) but CardWare omits that its trademark filings indicated nonuse of SmartTokenization (EX1054 ("Filed Use: No...Currently Use: No")). The Petition should be instituted given CardWare's pattern of omissions and the lack of settled expectations.²

VI. THE PETITION SHOULD BE INSTITUTED GIVEN THERE IS NO INCONSISTENCY BETWEEN GOOGLE'S POSITIONS

The Petition should be instituted because there is no inconsistency between Google's positions in district court and this Petition. By asserting that Google's positions are "inconsistent" (DD Req. 12–14), CardWare misapprehends the distinction between indefiniteness challenges and obviousness challenges. The Director has appreciated this distinction by declaring that a "Petitioner's explanation may have risen to a sufficient level, for example, if Petitioner had shown that, notwithstanding the alleged indefiniteness of the claim term, an ordinarily skilled

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.

artisan would understand that the asserted art satisfies the claim limitation.” *Tesla, Inc., v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 at 3–4 (Director, Nov. 5, 2025) (informative). The Federal Circuit has similarly explained that because the Board cannot find claims indefinite, the Board should construe the claims under *Phillips* and evaluate their patentability in view of the prior art. *Samsung Elecs. Am., Inc. v. Prisia Eng'g Corp.*, 948 F.3d 1342 (Fed. Cir. 2020).

Here, Google's Petition explained that “given the correlation between the prior art references and the challenged claims of the '538 patent...any reasonable construction reads on the prior art.” Pet. 8. The lack of any specific constructions distinguishes Google's Petition from CardWare's cite to *Arthrex, Inc. v. Medshape, Inc.*, IPR2025-00053, Paper 11 at 14–15 (P.T.A.B. Apr. 25, 2025) (DD Req. 13–14), where a petitioner affirmatively imported patent owner's constructions from district court. *Arthrex* at 14 (“Petitioner asserts that, for purposes of its Petition, it will apply ‘Patent Owner's apparent interpretation’ from the Parallel Proceeding.”). Moreover, none of the challenged claims were found indefinite in either the Apple or Google district court cases. *See* EX1046; EX1052. Accordingly, Google's petition should be instituted.

VII. CONCLUSION

Google respectfully requests institution.

Respectfully submitted,

Dated: December 15, 2025

By: / Naveen Modi /
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CERTIFICATE OF SERVICE

I hereby certify that on December 15, 2025, I caused a true and correct copy of the foregoing Petitioner's Opposition to Patent Owner's Request For Discretionary Denial and supporting exhibits to be served by electronic means on the counsel identified below:

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