

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

BLUESTONE VENTURES INC.,
Patent Owner

U.S. Patent No. 11,473,925
Issue Date: October 18, 2022

Title: METHOD AND SYSTEM FOR DYNAMIC ESTIMATION AND
PREDICTIVE ROUTE GENERATION

Inter Partes Review No. IPR2026-00418

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF
INSTITUTION OF PETITION FOR *INTER PARTES* REVIEW OF
UNITED STATES PATENT NO. 11,473,925**

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Scheduling Order, <i>Bluestone Ventures Inc., v. Google LLC</i> , No. 7:25-cv-00569-DC-DTG (W.D. Tex. April 22, 2026) (Dkt. 28)
2002	Joint Claim Construction Statement, <i>Bluestone Ventures Inc., v. Google LLC</i> , No. 7:25-cv-00569-DC-DTG (W.D. Tex. September 21, 2026) (Dkt. 53)
2003	Google's Preliminary Invalidity and Subject-Matter Eligibility Contentions (cover pleading), <i>Bluestone Ventures Inc., v. Google LLC</i> , No. 7:25-cv-00569-DC-DTG (W.D. Tex. June 24, 2026)
2004	First Amended Scheduling Order, <i>Bluestone Ventures Inc., v. Google LLC</i> , No. 7:25-cv-00569-DC-DTG (W.D. Tex. October 2, 2026) (Dkt. 57)

Patent Owner Bluestone Ventures Inc. (“Bluestone”) respectfully requests that the Director deny institution of the Petition for *Inter Partes* Review (“Petition”) filed by Google LLC (“Google”) challenging claims 1-7 and 9-15 of U.S. Patent No. 11,473,925 (“’925 patent,” Ex. 1001).

I. INTRODUCTION

The *Fintiv* factors weigh in favor of discretionary denial. Bluestone respectfully submits that under the totality of circumstances, discretionary denial is strongly favored.

The same parties are litigating the validity of the same claims over the same prior art in district court: every claim of the ’925 patent asserted there is challenged in the Petition, and Google has charted the Petition’s references against the ’925 patent in its invalidity contentions. EX-2003, 2, 64, 75-76. The parties have already invested in that case. Contentions have been served and claim construction briefing is complete. EX-2001, 1-2; EX-2002. Google has not sought a stay pending this proceeding, and the litigation involves other asserted patents that Google has not challenged before the Office. EX-2003. On October 5, 2026, the district court granted Google’s motion to transfer the litigation to the Northern District of California, effective October 27, 2026. *Bluestone Ventures Inc., v. Google LLC*, No. 7:25-cv-00569-DC-DTG (W.D. Tex. October 5, 2026) (Dkt. 58). The transfer changes the forum and the schedule, but it does not change the overlap between the

two proceedings or the other considerations that favor denial.

Other considerations point the same way. The '925 patent expired on April 1, 2023, so institution would spend the Office's resources on claims that can no longer be amended and that have no prospective effect. Pet., 1. Google waited more than seven months after filing of the complaint, and until after it had served its invalidity contentions in the district court, to file the Petition. EX-1009; EX-2003, 152; Pet., 100. And the Petition's two grounds and obviousness combinations depend on a 138-page expert declaration that is cited 170 times. Pet., 2; EX-1003.

II. PARALLEL PROCEEDINGS

On December 12, 2025, Bluestone filed a complaint against Google in *Bluestone Ventures, Inc. v. Google LLC*, No. 7-25-cv-00569-DC-DTG (W.D. Tex.) (the "District Court Litigation"), alleging infringement of the '925 patent along with United States Patent Nos. 9,746,341; 10,274,337; 10,551,208; 10,677,608; 10,996,071; and 11,619,513. EX-1009, 1.

The complaint accuses Google Maps products and services. EX-1009, 2-3. In the District Court Litigation, Bluestone asserts claims 9, 11, and 13-15 of the '925 patent. EX-2003, 2. The court entered a scheduling order on April 22, 2026. EX-2001. Under that order, Bluestone's infringement contentions were served on April 29, 2026; Google served its invalidity contentions on June 24, 2026; claim construction briefing closed on September 16, 2026; and the parties filed their Joint

Claim Construction Statement on September 21, 2026. EX-2001, 1-3; EX-2002; EX-2003, 152. The *Markman* hearing originally set for September 29, 2026, has been taken off the calendar and has not yet been reset. *Bluestone Ventures, Inc. v. Google LLC*, No. 7-25-cv-00569-DC-DTG (W.D.Tex.) (Dkt. 47); EX-2004, 1. On October 2, 2026, on the parties' joint motion, the court entered a First Amended Scheduling Order. EX-2004, 1. Under that order, fact discovery opens on December 3, 2026; final infringement and invalidity contentions are due on January 27, 2027; fact discovery closes on July 21, 2027; expert discovery closes on October 20, 2027; and jury selection and trial are set for February 14, 2028. EX-2004, 1-3. On October 5, 2026, the court granted Google's motion to transfer the District Court Litigation to the Northern District of California. *Bluestone Ventures Inc., v. Google LLC*, No. 7:25-cv-00569-DC-DTG (W.D. Tex. October 5, 2026) (Dkt. 58). The court delayed transfer until October 27, 2026, to allow Bluestone an opportunity to seek review, and stayed all unreached deadlines until that date. *Id.* The Northern District of California has not yet entered a schedule.

Google filed the Petition on July 30, 2026, more than a month after it served its invalidity contentions in the District Court Litigation. Pet., 100; EX-2003, 152. Google moved to stay fact discovery pending resolution of its motion to transfer, and the court denied that motion as moot when it entered the First Amended Scheduling Order. EX-2004, 1. *Bluestone Ventures, Inc. v. Google LLC*, No. 7-25-

cv-00569-DC-DTG (W.D. Tex.) (Dkt. 54). No other IPRs were filed by Google on any of the other asserted patents alleged in the District Court Litigation.

III. LEGAL STANDARDS

“The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition ... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

According to the Director’s March 26, 2025, Memorandum, the Director may consider all relevant considerations in determining whether a petition should be granted, including Board precedent under *Advanced Bionics* and *Fintiv*. See Interim Director Discretionary Process, October 3, 2025 (<https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>); Interim Processes for PTAB Workload Management, March 26, 2025 (<https://www.uspto.gov/sites/default/files/documents/InterimProcessesPTABWorkloadMgmt-20250326.pdf>) (“Memorandum”).

The Memorandum advises parties to address all relevant considerations in seeking discretionary denial of institution, which may include several factors such as settled expectations of the parties, the length of time the claims have been in force, strength of the unpatentability challenge, and the extent of the petition’s reliance on expert testimony. Memorandum, 2-3.

When the patent owner raises an argument for discretionary denial due to a co-pending litigation, the Director also weighs the six *Fintiv* factors. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 5-6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”).

IV. ARGUMENT

A. The Patent is Expired.

Application number 17/322,839 was filed on May 17, 2021. EX-1001, (21). The ’925 Patent issued on October 18, 2022. *Id.*, (45). The ’925 Patent is subject to a terminal disclaimer. *Id.*, (*). The terminal disclaimer was filed on October 23, 2021, to overcome a double patenting rejection. EX-1002, 136-139, 170. As a result, the ’925 patent expired on April 1, 2023, and its claims have been expired for over three years. Pet., 1. It would be a waste of the Board’s resources to grant institution of an expired patent. Because the ’925 Patent has expired, its claims can no longer be amended and have no prospective effect. The only live dispute is Google’s liability for past infringement, and the district court will resolve that dispute at trial. Bluestone was the applicant for the ’925 patent and prosecuted it to issuance. EX-1001, (71).

B. Settled Expectations Support Discretionary Denial.

Bluestone’s strong settled expectations weigh heavily in favor of discretionary denial because while the ’925 patent issued four years ago, it is part of a mature portfolio of patents claiming priority back to 2002 and is now expired.

This patent claims priority to a provisional dating back to April 10, 2002. EX-1001, 1:7-60 (“claims priority from U.S. provisional patent application No. 60/371,941 filed Apr. 10, 2002; the entirety of all of which are expressly incorporated herein by reference.”). The Examiner did not err during prosecution as Petitioner asserts. Pet., 1.

Petitioner’s suggestion that the Office failed to conduct “a thorough examination” is contradicted by the record. Pet., 1. Two examiners reviewed the applications. EX-1002, 79, 188. The initial search covered thirteen CPC subgroups, inventor and assignee searches, keyword searches in multiple databases, and a review of parent applications. *Id.*, 209-210. The examiner updated that search twice. *Id.*, 81. When the applicant asked about amending claims, the examiner advised that amendment “would require further search and consideration.” *Id.*, 112. By that point the Office had examined the same specification in thirteen issued patents over nearly two decades. EX-1001, (60). Because the examiner did not write separate reasons for allowance does not suggest error.

Patent Owners have strong settled expectations because the priority date goes back to 2002 and the rest of the patents asserted in the district court litigation are between three and nine years old, having issued between August 29, 2017, and April 4, 2023, and are in the same portfolio. EX-1009, ¶¶ 62, 70, 75, 83, 104, 134, 142. The oldest asserted patent in the parallel district court litigation issued on August 29,

2017. United States Patent No. 9,746,341 (“the ’341 patent”). The ’341 patent is in the same technology field and the ’925 claims priority to the ’341 patent as well. EX-1001, 1:35-36.

Bluestone requests the Director discretionarily deny institution of the Petition.

C. The *Fintiv* Factors Support Discretionary Denial.

1. Factor 1 weighs in favor of denial because Google has not sought a stay pending this proceeding and such a stay is unlikely.

The District Court Litigation has not been stayed pending this proceeding and such a stay is unlikely. A motion to stay pending IPR proceedings has not been filed by Google. The only stay Google has sought, a stay of fact discovery pending resolution of its transfer motion, was denied as moot on October 2, 2026. EX-2004, 1. The court’s October 5, 2026, transfer order stays unreached deadlines only until October 27, 2026, when the transfer takes effect. *Bluestone Ventures Inc., v. Google LLC*, No. 7:25-cv-00569-DC-DTG (W.D. Tex. October 5, 2026) (Dkt. 58). For that reason alone, a stay cannot be considered “likely” and is speculative.

Moreover, the facts of this case make it highly unlikely for a stay to be granted. There are six other patents asserted against Petitioner in the pending district court litigation. EX-1009, 1. District courts routinely deny stay motions pending IPR proceedings involving less than all asserted patents. *See, e.g., AGIS*

Software Dev. LLC v. Google LLC, 2021 U.S. Dist. LEXIS 24195, at *9 (E.D. Tex. Feb. 9, 2021); *see also Arthrex, Inc. v. Medshape, Inc.*, IPR2025-00053, Paper 11, 8-9 (PTAB Apr. 25, 2025) (agreeing stay less likely when parallel proceedings involve patents not the subject of a petition).

District courts also regularly deny stay motions when the PTAB has yet to institute post-grant proceedings. *See Force Mos Tech., Co. v. Asustek Comput., Inc.*, 2024 U.S. Dist. LEXIS 66423, at *9 (E.D. Tex. Apr. 10, 2024). Courts are also unlikely to grant a stay where, as here, claim construction briefing is complete. EX-2001, 2; EX-2002.

At best, the likelihood of a stay is speculative, and this factor should not weigh against discretionary denial. *See Samsung Elecs. Co. Ltd. v. Vasu Holdings, LLC*, IPR2025-00446, Paper 12, 2 (PTAB July 10, 2025) (granting discretionary denial).

2. Factor 2 does not control because the transferee court has not yet set a trial date.

The Board is projected to issue a Final Written Decision (“FWD”) by February 3, 2028. Before the district court ordered transfer, jury selection and trial were set for February 14, 2028, eleven days after that date. EX-2004, 3. On October 5, 2026, the court ordered the District Court Litigation to be transferred to the Northern District of California effective October 27, 2026, and stayed all unreached deadlines until then. *Bluestone Ventures Inc., v. Google LLC*, No. 7:25-

cv-00569-DC-DTG (W.D. Tex. October 5, 2026) (Dkt. 58). The Northern District of California has not yet set a trial date. Even where the trial date is “at or around the same time as the projected statutory deadline or even significantly after the projected statutory deadline,” the decision whether to institute “will likely implicate other factors discussed herein, such as the resources that have been invested in the parallel proceeding.” *Fintiv*, 9.

As explained in the sections that follow, those other factors favor denial. Factor two therefore does not control the analysis here.

3. Factor 3 also weighs in favor of discretionary denial.

Factor 3 relates to the “investment in the parallel proceeding by the court and the parties” at the time of the institution decision. *Fintiv*, 5-6, 9. This factor weighs in favor of discretionary denial because of the significant investment the parties have already made. As recognized in *Fintiv*, significant investment by the parties undermines the likelihood of a stay and increases the risk of duplicative costs.

Bluestone has already served extensive infringement contentions and completed the *Markman* briefs. *See* EX-2001, 1-2 (April 29, 2026, deadline for infringement contentions; claim construction briefing closing September 16, 2026); EX-2002. Google served its invalidity contentions on June 24, 2026. *See* EX-2003;

see also EX-2001, 2.

As of the date of this brief, the *Markman* briefs have already been submitted. The *Markman* hearing originally set for September 29, 2026, has been taken off the calendar and has not yet been reset. EX-2001, 3; *Bluestone Ventures Inc., v. Google LLC*, No. 7:25-cv-00569-DC-DTG (W.D. Tex. Dec. 12, 2025) (Dkt. 47); EX-2004, 1.

The investment made by the parties in contentions and claim construction supports the finding that Factor 3 favors discretionary denial. *See Arthrex*, IPR2025-00053, Paper 11, 10-11 (denying institution where parties have invested significant time in the district court proceedings). The investment in developing the contentions and document production would, on its own, make Factor 3 at least neutral. *See Int’l Business Machines Corp. v. Digital Doors, Inc.*, IPR2023-00968, Paper 7, 10–11 (PTAB Dec. 1, 2023).

Additionally, “if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition,” this factor favors denial. *Fintiv*, 9-10. “Likewise, district court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Id.*, 10.

Additionally, the contentions and claim construction briefing that the parties have completed remain part of the record of the District Court Litigation following

transfer. EX-2001, 1-2; EX-2002. These factors favor denial of the Petition to prevent inefficient duplication and resource waste. *See Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19, 3 (PTAB Mar. 28, 2025) (vacating institution where parties served expert reports, filed claim construction briefs, and conducted depositions before institution decision); *see also Arthrex*, IPR2025-00053, Paper 11, 10-11 (denying institution where parties invested significant time in the district court proceedings).

4. Factor 4 weighs in favor of discretionary denial due to significant overlap of issues.

“[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Fintiv*, 12. Google’s preliminary invalidity contentions show a significant overlap of issues. Every claim of the ’925 patent asserted in the district court (claims 9, 11, and 13-15) is challenged in the Petition. EX-2003, 2; Pet., 2. In the district court, Google charts the Petition’s references against the ’925 patent: Yamashita, Durocher, and Irie, as well as the issued Dickerson patent, U.S. Patent No. 6,697,730, and asserts each “alone or in combination with one or more” of the others. EX-2003, 64, 75-76; *see also id.*, 9 (identifying the Dickerson publication relied on in the Petition as prior art). Google has also incorporated by reference “all prior art and invalidity contentions identified in any post-issuance review by the U.S. Patent and Trademark Office of any Asserted Patent.” *Id.*, 3.

Google has provided a *Sotera* stipulation. Pet., 96-97. But even though a “timely-filed *Sotera* stipulation ... is highly relevant, [it] but will not be dispositive by itself.” Memorandum, Guidance on USPTO’s recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” 2-3 (Mar. 24, 2025).¹ Google’s stipulation does not overcome the overwhelming weight of other factors favoring discretionary denial. *See, e.g., Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00333, Paper 12, 12-13 (PTAB July 7, 2021) (denying institution even with *Sotera* stipulation); *see also Motorola Sols. v. Stellar, LLC*, IPR2024-01205, Paper 19, 3-4 (PTAB Mar. 28, 2025) (“[A]lthough Petitioner’s *Sotera* stipulation may mitigate some concern of duplication between the parallel proceeding and this proceeding, the stipulation does not outweigh the substantial investment in the district court proceeding....”).

Factor four weighs in favor of discretionary denial.

5. Factor 5 weighs in favor of denial as the district court litigation and the Petition involves the same parties.

Fintiv factor five weighs in favor of denying institution because the parties in the parallel litigation are the same. *Fintiv*, 15; *see also HP Inc. v. Universal Connectivity Techs. Inc.*, IPR2024-01428, Paper 12, 9-10 (PTAB Apr. 8, 2025)

¹ Available at https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf.

(factor weighs in favor of denial where all parties are involved in the parallel district court litigations).

6. Factor 6 weighs in favor of discretionary denial.

Fintiv Factor 6 considers “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv*, 6. Several additional circumstances favor denial here.

First, institution would require the Board to adjudicate claims that are not in dispute anywhere. The Petition challenges claims 1-7 and 9-15, but Bluestone asserts only claims 9, 11, 13-15 in the District Court Litigation. Pet., 2; EX-2003, 2. Review of claims 1-7, 10, and 12 of an expired patent would consume the Office’s resources without resolving any live controversy between the parties.

Second, institution would not relieve the district court of deciding the validity of the ’925 patent. *Inter partes* review is limited to patents and printed publications, 35 U.S.C. § 311(b), and Google’s stipulation reaches only grounds that were raised or reasonably could have been raised in this proceeding. Pet., 96-97. In the District Court Litigation, Google charts system prior art against the ’925 patent, and also contends that the asserted claims are invalid under 35 U.S.C. §§ 101 and 112 and for double patenting. EX-2003, 3, 64, 130. None of those defenses can be resolved here, so the district court will try the validity of the ’925 patent regardless of the outcome of this proceeding.

Third, Google did not file the Petition until it had the benefit of the District Court Litigation. Google filed on July 30, 2026, more than seven months after filing of the complaint, after receiving Bluestone's infringement contentions, and more than a month after serving its own invalidity contentions. EX-1009; EX-2003, 1, 152; Pet., 100.

Finally, and as iterated throughout this brief, the '925 patent has expired, the Office conducted a search directed to the challenged claims before allowing them, the Petition's grounds are multi-reference obviousness combinations that depend heavily on expert testimony, and the Petition raises a preamble dispute that is already briefed in the district court. Each of these circumstances further supports denial.

D. The Weakness of the Petition's Grounds and Overreliance on Expert Testimony Further Supports Discretionary Denial.

The merits of Petitioner's unpatentability challenge are weak. Both of Petitioner's invalidity grounds are three or four reference obviousness combinations for the challenged independent claims, a tacit admission that none of the prior art discloses all the limitations of any challenged claim. *See* Pet., 2.

Petitioner's excessive reliance on a voluminous expert declaration as its sole evidentiary support for claim limitations further strengthens the case for denial. Memorandum, 2; *see also* FAQs for Interim Processes for PTAB Workload Management, FAQ No. 22. Google's expert declaration is **138** pages long. *See* EX-

1003. Google cites to the expert declaration at least **170** times. The Petition relies extensively on the expert declaration to fill in gaps and support all of its conclusions of obviousness. *See, e.g., compare* Pet., 18 *with* EX-1003, ¶¶ 98-109. Per the guidance of the Office, however, the role of an expert is to provide focused support (*e.g.*, explaining terms of art or relevant context), **not** to substitute and/or provide for limitations and the obviousness rationale from the prior art.

E. Google Asks the District Court to Resolve a Claim Construction Dispute That It Tells the Director Need Not Be Resolved

The Director has made clear that a petitioner should not take one claim construction before the Office and another in district court. *See Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (Director Nov. 3, 2025) (precedential) (“Revvo”); *Infineon Techs. Americas Corp. v. Mosaid Techs. Corp.*, IPR2025-01456, Paper 27 at 3–4 (Director Mar. 17, 2026). *Westinghouse Air Brake Technologies Corp. v. Railware, Inc.*, IPR2026-00133, Paper 17, 2-3 (Director May 15, 2026).

Here, Google tells the Director that “no terms need construction to resolve the controversy.” Pet., 3. At the same time, Google has asked the district court to construe the preamble of claim 9 of the ’925 patent. EX-2002, 2. Google identified that preamble as a disputed term requiring the court’s resolution, contending that it is limiting, while Bluestone contends that it should be given its plain and ordinary

meaning. *Id.* The Petition asserts that the preambles of claims 1 and 9 are limiting, but it does so in a single conclusory sentence for each claim and does not explain why a dispute that Google says the district court must resolve requires no resolution here. Pet., 3 & n.1, 14, 88.

If review were instituted, the Board would either have to decide on the same preamble dispute that is already fully briefed in district court or proceed on Google's untested assumption. Either course risks inconsistent rulings on the scope of the same claim in two forums and duplicates work the district court has already been asked to do. That result would detract from the Office's goal of providing greater predictability and certainty in the patent system, and it further supports discretionary denial.

V. CONCLUSION

For all of the foregoing reasons, Bluestone respectfully requests the Director exercise its discretion and deny the Petition.

Dated: October 5, 2026

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d) and the Interim Director Discretionary Process § II.C.iii, the undersigned certifies that this Brief in Support of Discretionary Denial complies with the type-volume limitations of those sections because it contains no more than 20 pages.

Dated: October 5, 2026

Respectfully Submitted,

By: / *Raymond W. Mort, III* /
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION OF PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 11,473,925 was served electronically via email on October 5, 2026, on the following counsel of record for Petitioner:

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