UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MURATA MANUFACTURING CO., LTD,
Petitioner,

v.
GEORGIA TECH RESEARCH CORPORATION,
Patent Owner.

IPR2025-00384
Patent 7,489,914

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

TABLE OF CONTENTS

Murata's request for Director Review (Paper 14) is not about overlooked evidence or legal error. It is about dissatisfaction with an outcome. Murata takes issue with how the Director weighed the record and now tries to recast the Director's determination as if the evidence had been ignored altogether. The Decision Denying Institution of *Inter Partes* Review (Paper 13, "Decision"), however, considered the very points Murata presses again and evaluated them in the broader context of multiple other factors. At bottom, Murata asks the Director to rehear and reweigh arguments already made and rejected. This is not the purpose of Director review, and it is no basis for overturning a discretionary denial.

I. THE DIRECTOR'S DENIAL WAS BASED ON A "HOLISTIC ASSESSMENT" OF THE RECORD

Murata argues that the age of the '914 Patent was "treated as the sole determinative factor in this proceeding." Paper 14, 2. Not so. The Director acknowledged that the age of the '914 Patent, "[i]n particular," created "strong settled expectations." Paper 14, 2–3. The Decision goes on to note that "[a]dditionally" Murata has been aware of the '914 Patent since 2007.[1] Paper 14, 2.

[1] In fact, the Decision cites Murata's discussion of the communications between JMD and Murata as support for this assertion. Paper 13, 2 (citing Murata's Opposition to Discretionary Denial 21–26 (Paper 11) ("DD Opp.")

So Murata's "failure to seek early review of the patent favors denial and outweighs the above-discussed considerations." Paper 13, 2–3.

The Decision also notes, "[a]lthough *certain arguments* are highlighted above, the determination to exercise discretion to deny institution is based on a *holistic assessment of all the evidence and arguments presented*." Paper 13, 3 (emphasis added). Indeed, the Director analyzed numerous arguments as part of the holistic review, including GTRC's arguments that: (1) Murata's IPR filings show that Murata was not dealing fairly with GTRC; (2) the district court is a better forum to develop and consider the evidence necessary to evaluate the validity challenges; and (3) the Petition failed the *Fintiv*-factors. Paper 8, i; *see also* Paper 13, 2 ("After considering the parties' arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in these proceedings."). Each of these arguments independently supports discretionary denial, and the Director holistically balanced the issues and record presented by both parties in the papers to deny institution. Murata's request fails to properly address any of these legitimate bases for denial.

II. MURATA'S REQUEST RECASTS DISAGREEMENT WITH THE OUTCOME AS ALLEGED ERROR

Murata's request ultimately reflects dissatisfaction with the Director's judgment, not any cognizable error. Rather than accept the discretionary denial on its own terms, Murata reframes its grievances as purported failures to properly

weigh the facts. Paper 14, i (alleging Decision failed to "properly weigh" the facts four times in section headings alone). But none of its examples withstand scrutiny. The Decision explicitly considered the very arguments Murata accuses the Director of overlooking, and the remainder of Murata's points rely on inapposite authority, immaterial disputes, or impermissible new evidence.

A. Murata's priority challenge misunderstands discretion, ignores the record, and would not affect the outcome

First, Murata contends that the Decision "failed to acknowledge, much less consider the '914 Patent's erroneous priority claim despite uncontested evidence." Paper 14, 4. This argument reflects a fundamental misunderstanding that pervades all of Murata's request. The Director is not required to consider Murata's arguments at all. As the Office has previously argued, "the Director's unfettered discretion to deny institution under § 314(a) means that there is no substantive standard by which the agency evaluates individual applications that are eligible for institution." USPTO's Motion for Summary Judgment at 11, *Apple Inc., v. Iancu*, No. 5:20-cv-06128, at 11 (N.D. Cal Sept. 21, 2023), ECF No. 157 (cleaned up);[2] *see also United States v. Arthrex, Inc.*, 594 U.S. 1, 8–9 (2021) ("Congress has committed the decision to institute inter partes review to the Director's

[2] Also available at https://storage.courtlistener.com/recap/gov.uscourts.cand.365219/gov.uscourts.cand.365219.157.0.pdf.

unreviewable discretion."); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) ("[T]he agency's decision to deny a petition is a matter committed to the Patent Office's discretion. 35 U.S.C. § 314(a) (no mandate to institute review)." (additional citations omitted)). In other words, there is no substantive requirement that the Director specifically evaluate every ground or weigh every factual contention raised by a petitioner because ultimately the decision whether to institute is at the Director's discretion.

Furthermore, as discussed above, the Decision already reflects the Director's judgment that a priority-date challenge—like the one Murata presses here—is just as appropriately litigated in district court. Paper 11, 31–32 (arguing "[t]he PTAB is well-suited to address the deficiencies in the prosecution that led to the '914 patent's overly broad claims"); *see also* Paper 13, 2 ("After considering the parties' arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in these proceedings."). Therefore, there is no "error" to address.

Even setting that aside, Murata's argument would not alter the outcome. The Decision rested on multiple, independent bases unrelated to priority. *See, e.g.*, Paper 13, 2 (noting that GTRC's "settled expectations" weigh in favor of discretionary denial); Paper 8, 22–27 (arguing that the district court is a better forum to develop and consider evidence).

B. Murata's non-enforcement claim ignores the record, relies on inapposite cases, and improperly introduces new evidence

Second, Murata asserts that the Director "failed to properly weigh Patent Owner's admission of non-enforcement for 16 years." Paper 14, 5. But the Decision expressly acknowledged this factor, crediting Murata's argument and citing the "settled expectations" section of its brief. Paper 13, 2 (citing DD Opp. 19–20). That is the opposite of failing to weigh.

Murata's only other support for this contention consists of isolated statements from other discretionary denial decisions, coupled with new evidence it is not entitled to introduce. But even on their own terms, the authorities that Murata cites are easily distinguished. Murata relies on *Intel Corp. v. Proxense LLC*, IPR2025-00327-329, Paper 12, 2–3 (June 26, 2025) to contend that prolonged non-enforcement should have weighed against discretionary denial. But in *Google LLC. v. Soundclear Tech. LLC.*, IPR2025-00344, Paper 15, 2–3 (Aug. 4, 2025), Acting Deputy Chief APJ Kalyan Deshpande rejected the very same argument, explaining that a lack of commercialization "without more, does not defeat Patent Owner's strong settled expectations," especially where the petitioner had long known of the asserted patents. The facts here are even less favorable to Murata: it knew about the '914 patent for more than a decade *longer* than the petitioner in *Soundclear*. Ex-2001 ¶ 10 (declaration of Dr. White noting "[a]s part of the April 2007 meeting, I co-authored and co-presented a PowerPoint presentation for Murata … [which

included] a specific reference to the title of the application that eventually issued as the '914 patent"); Ex-2003, 27.

Murata also cites *Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00438, -531-532, -585, -611, Paper 10, at 3 (July 17, 2025), but that case involved nine different patents across six families and diverse subject matter—circumstances that, as the Director observed, favored Board review. In contrast, this case involves only a single patent on a single technology—making it less, not more, appropriate for institution.

Finally, although Murata sought and was *denied* authorization to introduce a Law 360 article as new evidence, Ex-3100, Murata decided to use it anyway. Paper 14, 6. While the Director need not consider it on that basis, even if she did, the Decision never treated the "mere age of [the] patent" as "dispositive," as explained above.

C. Murata's settled expectations challenge ignores the record and relies on immaterial disputes

Third, Murata contends that the Director "failed to acknowledge—let alone consider and properly weigh—facts of Petitioner's settled expectations." Paper 14, 7. But, again, the Decision expressly acknowledged this argument, citing the "settled expectations" section of Murata's brief. Paper 13, 2 (citing DD Opp. 19–20). What Murata truly objects to, then, is not any omission, but the Director's assessment of which facts and arguments carried weight. But disagreement with

which arguments the Director found persuasive is not legal error; it is simply dissatisfaction with the discretionary judgment Congress committed to the Director.

Murata also nitpicks the Decision's reference to "Patent Owner" in relation to the 2007 meeting, arguing that this was factually incorrect. But this is immaterial. What matters is not whether GTRC was present, but that Murata attended and gained knowledge of the intellectual property that matured into the '914 Patent. GTRC's Request for Discretionary Denial plainly acknowledged that it was JMD and Murata engaged in discussions about "JMD's intellectual property," and it is undisputed that GTRC owned and exclusively licensed the technology disclosed in the '914 patent. Paper 8, 6–8; Ex-2001 ¶¶ 3–4 (Dr. White testifying that "JMD obtained an exclusive license from GTRC" for the inventions from when he was "research faculty" at Georgia Tech); *see also* Paper 10, 23 (acknowledging *JMD's* contention that the technology "had been developed at GTRC and exclusively licensed to JMD"). That knowledge is what establishes settled expectations.

Likewise, Murata's assertion that the "purported technology did not work" (Paper 14, 8) is irrelevant. Patentability does not turn on whether Murata found an early embodiment by a small start-up satisfactory. The critical fact is, again, Murata's awareness of the underlying intellectual property.

D. The Director had no obligation to address the merits in exercising discretion under § 314(a)

Fourth, Murata argues that the Director "failed to address the strength of the merits of the Petition." Paper 14, 10. But as discussed above, this misunderstands the law. The Director has no obligation to consider the merits when exercising discretion under § 314(a). *See Arthrex*, 594 U.S. at 8–9. Likewise, Murata's related claim—that the Decision "fails to comply with the Director's statutory obligation and thus deprives a reviewing court of a decisional record" (Paper 14, 12)—is just another attempt to repackage disagreement with the outcome as procedural error. Section § 314(c)'s written-notice requirement applies only when review is instituted; it does not compel merits analysis in a denial. *See* 35 U.S.C. § 314(c) (Director's written "notice shall include the date on which the review shall commence"), § 314(a) ("Director determines that" the petition shows "there is a reasonable likelihood that the petitioner would prevail").

E. The Director addressed the *Fintiv* factors and Murata's arguments

Fifth, Murata argues that the Director "failed to address the strength of the *Fintiv* factors or properly weigh it against other factors." Paper 14, 11. But again, this is demonstrably incorrect. The Decision expressly credited Murata's arguments and cited the "*Fintiv* factors" section of Murata's brief. Paper 13, 2 (citing DD Opp. 8).

F. The Director was not required to treat Murata's *Sotera* stipulation as dispositive

Finally, Murata claims that the "Decision's failure to credit Petitioner's *Sotera* stipulation and refer this Petition to the merits panel is improper." Paper 14, 13. But as discussed above, "Congress has committed the decision to institute inter partes review to the Director's unreviewable discretion." *Arthrex*, 594 U.S. at 8–9. Because the Director has unfettered discretion to deny institution under § 314(a), there is no substantive standard by which the PTO evaluates individual petitions. Therefore, the Director was under no obligation to treat Murata's *Sotera* stipulation as dispositive.

III. MURATA DOES NOT IDENTIFY ANY APA, DUE PROCESS, OR OTHER VIOLATIONS

Murata asserts that the Decision violates due process, but it is unclear what deprivation of rights Murata is alleging because there is no *right* to *inter partes* review. To the contrary, "the agency's decision to deny a petition [in an *inter partes* review] is a matter committed to the Patent Office's ***discretion***." *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (citing 35 U.S.C. § 314(a)) (emphasis added). Therefore, because institution is wholly discretionary, the denial of institution cannot give rise to a cognizable due process injury.

Nor does Murata show any violation of the APA. Under Federal Circuit precedent, there is no APA violation where "the party asserting the APA violation

'had notice … and an opportunity to be heard.'" *TQ Delta, LLC v. DISH Network LLC*, 929 F.3d 1350, 1356 (Fed. Cir. 2019). That standard is plainly met here. Murata was on notice that Director Vidal's June 21, 2022 Memorandum ("Vidal Memo")—which designated *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (Dec. 1, 2020) as precedential—did not "limit the Director's authority to issue, at any time and in any manner, policy directives." PTAB Standard Operating Procedures (SOP) 2 at 1 (July 24, 2023).[3] Therefore, because Murata was on notice that the Vidal Memo did not limit the Director's ability to issue policy directives, Murata was on notice that a *Sotera* stipulation would *not* "prevent the PTAB from discretionarily denying institution." Paper 14, 13. Murata also had a full and fair opportunity to be heard: it was permitted to submit a discretionary denial response up to 14,000 words, to introduce new evidence, and to develop its arguments in detail. That is more than sufficient process to defeat any APA claim.

Even more fundamentally, Murata's claims fail because there are multiple grounds for discretionary denial that predate and are independent of the Director's March 2025 Memorandum. For example, GTRC's Discretionary Denial paper

[3] Available at https://www.uspto.gov/sites/default/files/documents/20230724_ptab_sop2_rev11_.pdf

argued that the PTAB is an inappropriate forum in light of the need for extensive discovery (Paper 8, 22–27); *see also* Paper 8, 28–30 (arguing *Fintiv* factors). Those arguments alone provide ample and independent basis for denial, wholly apart from the March 2025 guidance. Murata's request for Director review selectively ignores these rationales.

IV. CONCLUSION

For the reasons set forth above, the Director should deny Murata's request to vacate the Decision.

Respectfully submitted,

/Warren Thomas/
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and agreement of the parties, I certify that on September 8, 2025, a copy of this paper and all accompanying exhibits were served on counsel for the Petitioner by email to:

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