

From: [Director Discretionary Decision](#)
To: [Trials](#); [Shulman, Daniel H.](#)
Cc: [Director Discretionary Decision](#); Elisabeth.Hunt@WolfGreenfield.com; [Saraswat, Anant K.](#); [Askuvich, Alissa E.](#); [Mitra, Sudip](#); [Malek, Monika](#); [Akarapu, Krishna](#)
Subject: RE: IPR2025-00967 and IPR2025-00968 [VED-VP.FID6191061]
Date: Thursday, September 18, 2025 7:41:34 AM

In view of the changed circumstances, Patent Owner may file a brief requesting discretionary denial. Patent Owner's brief is due within five business days of the date of this email. Petitioner may file an opposition to Patent Owner's discretionary denial brief. Petitioner's opposition is due within 10 business days of the date Patent Owner files its brief.

From: Shulman, Daniel H. <dshulman@vedderprice.com>
Sent: Monday, September 8, 2025 2:17 PM
To: [Trials](#) <Trials@USPTO.GOV>
Cc: Elisabeth.Hunt@WolfGreenfield.com; [Saraswat, Anant K.](#) <anant.saraswat@wolfgreenfield.com>; [Askuvich, Alissa E.](#) <aaskuvich@vedderprice.com>; [Mitra, Sudip](#) <smitra@vedderprice.com>; [Malek, Monika](#) <mmalek@vedderprice.com>; [Akarapu, Krishna](#) <kakarapu@vedderprice.com>
Subject: IPR2025-00967 and IPR2025-00968 [VED-VP.FID6191061]

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Dear Honorable Board,

Patent Owner, Bootler, LLC, hereby notifies the Board that the patents subject of the current IPR petitions (IPR2025-00976, 0098), for which an institution decision is pending, were held to be invalid under 35 U.S.C. § 101 on September 4, 2025 by the U.S. District Court for the Northern District of Illinois in *Bootler, LLC v. Google, LLC*, Case No. 24-cv-3660, ECF No. 49 (N.D. Ill. Sep. 4, 2025) (Memorandum and Order attached). While the District Court permitted amendment and refiling of the complaint on or by September 25, 2025, any such amendment would necessarily be limited to addressing the District Court's dismissal of Patent Owner's antitrust claims against Petitioner as no feasible amendment to a complaint could exist to revive a claim based on a patent held invalid under 35 U.S.C. § 101. Therefore, the District Court's judgment is effectively immediately final as to the validity of the patents at issue, and would be even if Patent Owner amended the complaint in that case.

Discretionary denials should be made to promote efficiency of proceedings. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 WL 2126495, Paper 11 at 5–6 (P.T.A.B. Mar. 20, 2020) (precedential). As the Board recognized in *Hulu, LLC v. Piranha Media Distribution, LLC*, IPR2024-01252 & IPR2024-01253, Paper 27 (Apr. 17, 2025) (informative), “[T]he *Fintiv* framework does not fit neatly with the circumstances of this case, where the district court already had determined that the challenged claims are invalid under § 101 before the Board's Decision. Nevertheless, the *Fintiv* framework

emphasizes efficiency concerns, and *Fintiv* encourages the parties to explain the impact of other facts and circumstances that exist in their proceeding on efficiency and integrity of the patent system. *Fintiv*, Paper 11 at 16. Here, as explained above, where a district court already has found the challenged claims invalid, the efficiency and integrity of the patent system is best served by denying institution.” *Hulu*, 2025 WL 1144790, at *1 (P.T.A.B. Apr. 7, 2025) (denying institution when claims had been held invalid under Section 101).

In light of the District Court’s order invalidating the subject patents, the Board’s application of the *Fintiv* factors to situations in which there has been a prior Section 101 invalidation compels discretionary denial of the IPRs. Accordingly, Patent Owner respectfully requests discretionary denial of the petitions.

Petitioner’s position:

Petitioner objects to this email from Patent Owner as it improperly contains substantive arguments and attachments without authorization in an email to the Board. Patent Owner’s email is an improper unauthorized motion in violation of 37 C.F.R. §42.20(a), §42.20(b), and the Trial Practice Guide (page 37). Additionally, Patent Owner’s request is untimely as Patent Owner’s deadline to request discretionary denial under the “Interim Processes for PTAB Workload Management” passed nearly a month ago with no action from Patent Owner, and these IPRs have already been referred to the merits panel. Per the Board’s Notice of Referral of August 14, 2025, “Patent Owner had the opportunity to file a brief requesting discretionary denial of institution” and “Patent Owner did not file such a brief;” therefore “this case is referred to a Board panel to consider the merits and non-discretionary considerations.”

For any and all of these reasons, Patent Owner’s request should not be considered. To the extent the Board does consider it, Petitioner requests authorization to file a brief to present Petitioner’s substantive arguments in opposition to Patent Owner’s discretionary denial request.

Regards,

Daniel H. Shulman, Shareholder

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Book time with me—

30 min Zoom: <https://calendly.com/danshulman/one-on-one-with-dan-shulman-at-vedder-price>

15 min Phone Call: <https://calendly.com/danshulman/legal-call-with-dan-shulman>

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