

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

BOOTLER, LLC,
Patent Owner.

Case No. IPR2025-00968

Patent No. 11,037,090

**PETITIONER'S OPPOSITION
TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF**

TABLE OF CONTENTS

I. INTRODUCTION1

II. INSTITUTION SHOULD NOT BE DENIED BASED ON *HULU*.....2

 A. *Hulu* Violates the APA, and Applying It Here Would Violate
 Google’s Due Process Rights2

 B. If *Hulu* Is Applied, the IPR Should Still Be Instituted.....6

III. THE *FINTIV* FACTORS OVERWHELMINGLY FAVOR
INSTITUTION8

 A. Factor 1: whether the court granted a stay8

 B. Factor 2: proximity of the court’s trial date to the Board’s projected
 statutory deadline for a final written decision.....8

 C. Factor 3: investment in the parallel proceeding by the court and the
 parties.....9

 D. Factor 4: overlap between issues raised in the petition and in the
 parallel proceeding10

 E. Factor 5: whether the petitioner and the defendant in the parallel
 proceeding are the same party11

 F. Factor 6: other circumstances that impact the Board’s exercise of
 discretion, including the merits11

IV. COMPELLING ECONOMIC AND PUBLIC INTEREST
CONCERNS FAVOR INSTITUTION11

 A. Compelling Economic Interests Favor Institution11

 B. Compelling Public Interests Favor Institution13

V. CONCLUSION.....13

TABLE OF AUTHORITIES

CASES

<i>Alice Corp. Pty. Ltd. v. CLS Bank International</i> , 573 U.S. 208 (2014)	9
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).....	2, 8
<i>Apple Inc. v. Geoscope Techs. Pte. Ltd.</i> , IPR2024-00255, Paper 14 (PTAB May 31, 2024).....	4
<i>Apple Inc. v. Vidal</i> , 63 F.4th 1 (Fed. Cir. 2023)	3
<i>AviaGames, Inc., v. Skillz Platform, Inc.</i> , IPR2022-00530, Paper 14 (PTAB Mar. 2, 2023).....	4, 10
<i>Coal. for Common Sense in Gov’t Procurement v. Sec’y of Veterans Affs.</i> , 464 F.3d 1306 (Fed. Cir. 2006)	3
<i>Hulu, LLC v. Piranha Media Distribution, LLC</i> , IPR2024-01252, Paper 27 (PTAB Apr. 17, 2025)	1, 6
<i>Landgraf v. USI Film Prods.</i> , 511 U.S. 244 (1994)	5
<i>Mexichem Fluor, Inc. v. Env’t Prot. Agency</i> , 866 F.3d 451 (D.C. Cir. 2017)	5
<i>Nikon Corp. v. Optimum Imaging Techs., LLC</i> , IPR2024-01374, Paper 19 (PTAB Apr. 29, 2025)	11
<i>Sony Grp. Corp. v. InMusic Brands, Inc.</i> , IPR2023-00294, Paper 10 (PTAB July 25, 2023).....	10
<i>Sotera Wireless, Inc. v. Masimo Corporation</i> , IPR2020-01019, Paper 12 (Dec. 1, 2020)	10
<i>Volvo Penta of the Ams., LLC v. Brunswick Corp.</i> , IPR2022-01366, Paper 15 (PTAB May 2, 2023).....	4

Wyze Labs, Inc. v. Sensormatic Elecs., LLC,
IPR2020-01486, Paper 14 (PTAB Apr. 6, 2021)5

STATUTES

35 U.S.C. § 1011
35 U.S.C. § 311(a)12
35 U.S.C. § 315(e)(2).....11
35 U.S.C. § 316(a)13
5 U.S.C. § 5533

REGULATIONS

37 C.F.R. § 42.1(b)6

LISTING OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 11,037,090
1002	Prosecution History of U.S. Patent No. 11,037,090
1003	Declaration of Mark Crovella, Ph.D.
1004	Curriculum Vitae of Mark Crovella, Ph.D.
1005	U.S. Patent Application Publication No. 2013/0282486 (“Rahle”)
1006	U.S. Patent No. 10,176,448 (“Rhodes”)
1007	U.S. Patent No. 6,651,057 (“Jin”)
1008	U.S. Patent No. 10,366,434 (“Belousova”)
1009	U.S. Patent Application Publication No. 2009/0119268 (“Bandaru”)
1010	U.S. Patent Application Publication No. 2005/0086206 (“Balasubramanian”)
1011	U.S. Patent Application Publication No. 2015/0026152 (“Singh”)
1012	U.S. Patent Application Publication No. 2008/0175243 (“Bhagwan”)
1013	U.S. Patent Application Publication No. 20100023751 (“He”)
1014	U.S. Patent No. 8,595,847 (“Petta”)
1015	Exhibit E to Complaint, <i>Bootler, LLC v. Google, LLC</i> , Case No. 1:24-cv-03660 (N.D. IL) (May 6, 2024)
1016	The American Heritage Dictionary of the English Language (2016)
1017	U.S. Patent No. 9,697,250 (“Ward”)
1018	U.S. Patent Application Publication No. 2017/0329871 (“Subramani”)
1019	U.S. Patent No. 6,594,751 (“Leivent”)
1020	U.S. Patent Application Publication No. 2010/02474771 (“Mori”)
1021	U.S. Patent No. 5,765,039 (“Johnson”)
1022	RESERVED
1023	RESERVED
1024	U.S. Patent Application Publication No. 2012/0246132 (“Sebastian”)
1025	U.S. Patent Application Publication No. 2017/0270184 (“Huang”)
1026	U.S. Patent No. 5,896,517 (“Wilson”)
1027	U.S. Patent Application Publication No. 2012/0233414 (“Meier”)
1028	U.S. Patent Application Publication No. 2012/0123910 (“George”)
1029	U.S. Patent Application Publication No. 2008/0295178 (“Beresniewicz”)
1030	U.S. Patent No. 6,542,893 (“Quernemoen”)
1031	U.S. Patent Application Publication No. 2012/0166366 (“Zhou”)
1032	U.S. Patent Application Publication No. 2013/0159348 (“Millis”)
1033	U.S. Patent No. 8,849,721 (“Fedorov”)

Exhibit	Description
1034	Plaintiff’s Memorandum in Support of Its Motion Under Federal Rule of Civil Procedure 54(b) to Make Judgment on Patent Claims Final in <i>Bootler, LLC v. Google, LLC</i> , Case No. 1:24-cv-03660 (N.D. IL) (Sep. 15, 2025) (Dkt. 51)
1035	Plaintiff’s Reply to Defendant’s Opposition to Plaintiff’s Motion Under Rule 54(b) to Make Judgment on Patent Claims Final in <i>Bootler, LLC v. Google, LLC</i> , Case No. 1:24-cv-03660 (N.D. IL) (Sep. 30, 2025) (Dkt. 57)
1036	Google’s <i>Sotera</i> Stipulation Dated July 21, 2025
1037	Our Story – Google, “From the garage to the Googleplex” (<i>available at</i> https://about.google/company-info/our-story/)
1038	A new era of American Innovation – Google, “Google is helping America become stronger, safer and more competitive than ever before” (<i>available at</i> https://about.google/intl/ALL_us/around-the-globe/local-info/)
1039	Google Economic Impact – Google, (<i>available at</i> https://economicimpact.google/)
1040	America Invents Act Report, June 1, 2011

I. INTRODUCTION

This case has already been “referred to a Board panel to consider the merits and non-discretionary considerations” for institution of IPR. Paper 7. As the Board noted, “Patent Owner had the opportunity to file a brief requesting discretionary denial of institution,” and “Patent Owner did not file such a brief” when it was due. *Id.* Presumably, Patent Owner understood that there was no reasonable basis for discretionarily denying this IPR. Patent Owner’s only reason for belatedly requesting discretionary denial now is that the district court recently dismissed Patent Owner’s infringement complaint against Petitioner Google because it did “not plausibly and specifically allege[] that the Asserted Patents’ claims are drawn to patent-eligible subject matter.” EX2001 at 12. That finding has no bearing on the challenged claims’ invalidity over the prior art at issue in this IPR. Patent Owner’s belated request for discretionary denial should be rejected.

Patent Owner suggests that *Hulu, LLC v. Piranha Media Distribution, LLC*, IPR2024-01252, Paper 27 (Apr. 17, 2025) categorically immunizes from IPR all patents found ineligible under 35 U.S.C. §101. To begin with, the Director should not apply *Hulu* because it violates the Administrative Procedure Act’s requirements for proper rulemaking practices and because rigidly applying *Hulu* to deny institution as Patent Owner asks would violate Google’s due process rights. And if the Director does consider the efficiency concerns raised in *Hulu*, the facts

here demonstrate that allowing the panel to continue its job in considering the Petition's merits for institution is the most efficient use of the parties' and tribunals' resources.

Patent Owner's brief belatedly raises *Fintiv*, but those factors also favor institution here. The district court and parties have invested little in the litigation proceeding as to the '090 patent, and the trial in that proceeding will not involve the '090 patent. There will be no duplication of efforts if this IPR moves forward, further favoring institution.

Patent Owner further wrongly characterizes the economic and public interests at issue, which in fact favor institution, not denial. The Director should reject Patent Owner's invitation to upend and violate the AIA by favoring lengthy and costly post-appeal district-court litigation over the just, speedy resolution of the meritorious prior-art unpatentability showings raised in this IPR.

II. INSTITUTION SHOULD NOT BE DENIED BASED ON *HULU*

A. *Hulu* Violates the APA, and Applying It Here Would Violate Google's Due Process Rights

The Director should not apply *Hulu* to deny institution because *Hulu*—and the Office's retroactive application thereof—violates the Administrative Procedure Act and the due process rights of petitioners like Google.

Hulu alters the Director's standard for institution and is therefore a substantive rule. An agency decision is a substantive rule, subject to notice-and-

comment requirements, if it “effect[s] a change in existing law or policy or...affect[s] individual rights and obligations.” *Coal. for Common Sense in Gov’t Procurement v. Sec’y of Veterans Affs.*, 464 F.3d 1306, 1317 (Fed. Cir. 2006) (citation omitted). *Hulu* checks both boxes, and the Director was therefore required to promulgate *Hulu*’s institution instructions through notice-and-comment rulemaking procedures. *See Apple Inc. v. Vidal*, 63 F.4th 1, 14 (Fed. Cir. 2023) (holding that the APA permits challenges to the Director’s process for promulgating institution instructions, and remanding for further proceedings on the merits). Moreover, applying *Hulu* as a *de facto* rule, as Patent Owner requests—to deny institution whenever a patent has been found ineligible under §101—without proper notice-and-comment rulemaking also violates the Administrative Procedure Act. *See* 5 U.S.C. §553.

It also severely prejudices Google and other similarly situated petitioners by forcing them into a corner: either give up early §101 defenses in district court or forego the ability to challenge the asserted patent in an IPR. The prejudice in this case is particularly burdensome. Google is now time-barred from filing any future petition against the ’090 patent. Denying institution would prevent Google from ever being able to pursue an IPR challenge, despite Google having spent time and resources to file its Petition in accordance with the statutory deadline. The

Office's application of *Hulu* is thus manifestly unfair and will prejudice Google if Patent Owner were to succeed in appealing the district court's §101 determination.

While any application of *Hulu* to deny institution would certainly be prejudicial, the *retroactive* application of *Hulu*'s new rule change exacerbates the prejudice and violates Google's due process rights. Specifically, the Office designated *Hulu* as "informative" the same day Google was already filing this Petition, and only after Google had invested substantial resources in preparing and filing it. Before *Hulu*, the Board's and Director's practice had been consistent: "the district court's judgment of invalidity under 35 U.S.C. § 101, i.e., a statutory ground that could not have been raised before the Board, does not raise concerns of inefficient duplication of efforts or potentially inconsistent results between the Board and the district court." *AviaGames, Inc., v. Skillz Platform, Inc.*, IPR2022-00530, Paper 14 at 3 (Mar. 2, 2023) (granting Director Review and vacating decision denying institution); *see also Volvo Penta of the Ams., LLC v. Brunswick Corp.*, IPR2022-01366, Paper 15 at 6 (May 2, 2023) (granting *sua sponte* Director Review and vacating decision denying institution) ("[A]lthough the district court held claim 1 invalid in each of the challenged patents, these claims are subject to further judicial review and, therefore, are not finally adjudicated"); *Apple Inc. v. Geoscope Techs. Pte. Ltd.*, IPR2024-00255, Paper 14 at 12 (May 31, 2024) (granting institution) (applying *AviaGames* and *Volvo*, holding that because the

district court invalidated the claims based on a “ground that could not have been raised before the Board, [this case] does not raise concerns of inefficient duplication of efforts or potentially inconsistent results.”); *Wyze Labs, Inc. v. Sensormatic Elecs., LLC*, IPR2020-01486, Paper 14 at 16 (Apr. 6, 2021) (granting institution) (“[The Board] cannot institute a trial in an inter partes review to determine whether the claims are directed to eligible subject matter under § 101,” making the patentability challenges in the petition “materially different from the legal issue considered by the [district] court.”).

The Office’s about-face in *Hulu* severely prejudices Google and all similarly situated petitioners and violates fundamental notions of due process. *See, e.g., Mexichem Fluor, Inc. v. Env’t Prot. Agency*, 866 F.3d 451, 462 (D.C. Cir. 2017) (“To satisfy the Due Process Clause, [the agency] must at a minimum provide regulated parties fair warning of the conduct a regulation prohibits or requires.”) (citation omitted); *Landgraf v. USI Film Prods.*, 511 U.S. 244, 269-70 (1994) (defining retroactive application as “whether the new provision attaches new legal consequences to events completed before its enactment”).

Hulu’s purported rationale that, if Patent Owner were to succeed on appeal, a petitioner like Google would be able to mount the same challenges in the district court is no true answer. That opportunity would come years from now, at far more expense to Google (and all parties). It is contrary to the AIA’s purpose of securing

a “just, speedy, and inexpensive” resolution to the parties’ dispute. *See* 37 C.F.R. §42.1(b). Applying *Hulu* to deny institution would thus manifestly prejudice Google, in violation of the APA and Google’s due process rights.

B. If *Hulu* Is Applied, the IPR Should Still Be Instituted

If the Director applies *Hulu*, then the “more efficient approach,” *Hulu*, Paper 27 at 3, under the facts of this case is to allow the panel to consider institution on the merits.

For starters, Patent Owner’s appeals to efficiency are specious. Patent Owner argues that the Board should deny institution based on the district court’s §101 decision that Patent Owner intends to challenge on appeal. Indeed, Patent Owner recently filed a motion under FRCP 54(b) asking the district court to make its §101 judgment final for the sole purpose of permitting “an early revival of the Patent...infringement claims” via “a successful appeal” of the §101 judgment without waiting for resolution of the other claims in Patent Owner’s lawsuit. EX1034 at 6-7; *see also* EX1035 at 5 (Patent Owner stating that it seeks to finalize and appeal the §101 judgment so that “[i]f the Federal Circuit reverses th[e] Court’s decision..., then that [infringement] case can be remanded...sooner”). Patent Owner’s admission that it will continue to litigate the district court’s §101 decision is anything but efficient. And its reliance on a decision that it intends to

appeal at its earliest opportunity is a blatant attempt to use that decision to avoid IPR institution without having to abide by the decision's invalidity findings.

Instead, the uncertain timing and facts of the related litigation (and Patent Owner's future appeal) counsel toward allowing the panel to continue its consideration of the Petition's merits for institution. Patent Owner has not yet appealed the §101 decision because the district court has not yet issued a final judgment. If the district court denies Patent Owner's pending Rule 54(b) motion, the court's §101 decision will not become final until after Patent Owner's remaining non-patent claims are also disposed of. When that will be is uncertain, as Patent Owner has only just recently filed an amended complaint. Only after entry of a final judgment on all claims will Patent Owner's appeal begin. Alternatively, even if Patent Owner's pending Rule 54(b) motion were granted and the §101 decision proceeded directly to appeal, the appeal itself would likely take almost two years, as the Federal Circuit's median time to disposition for district court appeals was 19.0 months in the most recent fiscal year.¹ Thus, any final

¹ United States Court of Appeals for the Federal Circuit, Median Time to Disposition in Cases Terminated After Hearing or Submission, available at <https://www.cafc.uscourts.gov/wp-content/uploads/reports-stats/FY2024/MedianDispositionTime-Merits.pdf>.

resolution of the §101 issue would likely occur no earlier than the end of 2027, a year after the anticipated final written decision in this case. The litigation timeline thus counsels toward allowing the merits panel to resolve the prior-art unpatentability of the '090 patent via this IPR.

III. THE *FINTIV* FACTORS OVERWHELMINGLY FAVOR INSTITUTION

A. Factor 1: whether the court granted a stay

Factor 1 weighs in favor of institution. The district court's dismissal of the patent infringement claims operatively serves as a stay pending appeal of the district court's §101 decision. No further work in the parallel litigation at present and through trial will affect or consider the '090 patent. And while Patent Owner has filed a motion to make the district court's §101 decision final for appeal, that motion is opposed and has not yet been decided, thus resulting in an indefinite stay of any determination on issues concerning the '090 patent. Thus, the quicker resolution of the '090 patent's unpatentability is to move forward with the IPR. This weighs in favor of institution.

B. Factor 2: proximity of the court's trial date to the Board's projected statutory deadline for a final written decision

Factor 2 weighs in favor of institution. The Board's final written decision is due by mid-November 2026; whereas there is no trial date scheduled in the district court, as the Patent Owner's amended complaint has only just been filed. If Patent Owner's motion to make the district court's §101 decision final is denied, the final

adjudication of the §101 decision via a Federal Circuit appeal will occur long after the Board’s final written decision in this case. And as discussed above in Section II.B, even if Patent Owner’s motion were granted, its appeal of the §101 decision likely would not be resolved before late 2027, a year after the anticipated final written decision by the Board.

C. Factor 3: investment in the parallel proceeding by the court and the parties

Factor 3 weighs in favor of institution because there has been little investment in the litigation proceedings as to the ’090 patent. Discovery was stayed pending the §101 motion, and then Patent Owner’s initial complaint was dismissed and replaced with an amended complaint that drops the patent infringement claim. Patent Owner alleges (Paper 8 at 4) that “the district court has already become well-versed with the...specific disclosures of the pertinent prior art (per *Alice* Step Two)” just by deciding the §101 motion; but that is not true. None of the prior-art references raised in this IPR’s Petition were before the district court in the §101 briefing. The district court resolved *Alice* Step Two by finding that the ’090 patent “is using computers to compute” and that Patent Owner “has not pointed to any ‘additional features’ that are ‘more than well-understood, routine conventional activity’” (EX2001 at 11)—not by considering any prior-art grounds under §102 or §103 as should be adjudicated in this IPR.

Given the early stage of the litigation, which has never left the pleading stage, the investment as related to the '090 patent has been minimal.

D. Factor 4: overlap between issues raised in the petition and in the parallel proceeding

Factor 4 weighs in favor of institution because there is no overlap between issues and no duplication of effort between the Board and the district court. The district court has only analyzed the '090 patent in the context of §101, the sole basis for its finding of invalidity. As the PTO has recognized, the Board cannot assess patent eligibility under §101 in an IPR, so there cannot be any inconsistent results or overlap in determinations between the Board's IPR decisions and the district court's §101 decisions. *See, e.g., AviaGames*, IPR2022-00530, Paper 14 at 2-3; *see also Sony Grp. Corp. v. InMusic Brands, Inc.*, IPR2023-00294, Paper 10 at 12-13 (July 25, 2023) (finding *Fintiv* factor 4 weighed against discretionary denial where “the grounds raised in the Petition, under § 103, have not been raised in the district court proceeding, and cannot be prior to any potential future remand from the Federal Circuit should the § 101 determination be reversed”).

Even if the district court were to eventually assess the '090 patent's validity on grounds beyond §101 (e.g., if the patent were to survive this IPR and Patent Owner successfully appealed the §101 decision), statutory estoppel and/or Google's *Sotera* stipulation (EX1036) would likewise prevent duplication of efforts. In that scenario, Google would be precluded from raising any ground that

it “raised or reasonably could have raised” during this proceeding. 35 U.S.C. §315(e)(2). Thus, under either scenario, there is no duplication of efforts.

E. Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same party

Factor 5 favors institution or is at most neutral. *See, e.g., Nikon Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01374, Paper 19 at 23-24 (Apr. 29, 2025) (explaining that “factor 5 generally...favors institution” when there is no scheduled district-court trial date that would precede the Board’s final written decision) (collecting cases).

F. Factor 6: other circumstances that impact the Board’s exercise of discretion, including the merits

Factor 6 weighs in favor of institution. The Petition presents compelling merits based on prior art that the Examiner should have identified in prosecution but did not. This warrants institution.

IV. COMPELLING ECONOMIC AND PUBLIC INTEREST CONCERNS FAVOR INSTITUTION

A. Compelling Economic Interests Favor Institution

Compelling economic interests favor institution. Google’s strong economic presence in the United States has contributed to American innovation for almost 30 years. EX1037; *see also* EX1038 (Google investments have facilitated innovation, supporting the goals of the USPTO, including by investing in research and development to power American technological leadership, and create leaps in AI

and quantum computing that advance national security). Google employs over 100,000 people, many in the United States and contributing to continued economic growth. EX1039.

Patent Owner is wrong to suggest that Google's size favors denial because allegedly "Google has nothing to gain" from "the lower costs and speedy resolution of Board proceedings." Paper 8 at 7. Lawsuits asserting invalid patents are unwarrantedly burdensome to any defendant, and divert resources away from being invested in the nation's economy. Indeed, it is Google that is faced with costly litigation that was initiated by Patent Owner's own choice. If Patent Owner truly sought to conserve costs, it should disclaim its invalid patent rather than seeking to appeal the §101 decision so it can "reviv[e]" its costly infringement lawsuit. EX1034 at 6-7.

The AIA was designed to "provid[e] a more efficient system for challenging patents that should not have issued; and reduc[e] unwarranted litigation costs" for all defendants, not just some types of parties or courts. EX1040 at 39-40.

Restricting PTAB access by foreclosing a means for certain companies to challenge patents, as Patent Owner proposes, is contrary to the AIA, which allows *broad access* to any member of the public, stating that "*a person who is not the owner of a patent* may file with the Office a petition to institute an inter partes review of the patent." *E.g.*, 35 U.S.C. §311(a). Denying petitions based on the

petitioner's size would at best constitute a failure to engage in proper rulemaking, and at worst, an unlawful decision that would exceed the Office's authority to prescribe regulations related to IPRs. *See, e.g.*, 35 U.S.C. §316(a).

B. Compelling Public Interests Favor Institution

Compelling public-interest factors also favor institution. One motivation behind the AIA was "improving patent quality and providing a more efficient system for challenging patents that should not have issued." EX1040 at 39-40. Institution of this Petition with its strong merits would accomplish the AIA's goals of improving patent quality and reducing litigation costs. As discussed further *supra*, there are compelling economic and efficiency reasons for the Board to assess the patentability of all claims under §102 and §103. Conversely, there would be substantial negative economic consequences to both parties and the public if the claims must be adjudicated in more expensive and time-consuming litigation following appeal of the §101 decision. IPR institution and a finding of unpatentability would prevent Patent Owner from unjustifiably asserting the '090 patent against others in the future.

V. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Director decline to exercise discretion to deny institution, and let the panel decide whether to institute based on the merits of the Petition.

Respectfully submitted,
Google LLC

Date: October 9, 2025

/Elisabeth Hunt/

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

I certify that on October 9, 2025, a copy of the foregoing document, including any exhibits filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

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