

From: [Trials](#)
To: [Jeremy Monaldo](#); [Trials](#)
Cc: [Peter Lambrianakos](#); [Vincent Rubino](#); [Alfred Fabricant](#); [Julian Pymonto](#); [IPR50095-0245IP1](#); [Joseph Mercadante](#); [PTAB@fabricantllp.com](#)
Subject: RE: IPR2025-01103 – Markman Order and Motion to Withdraw Challenges to Claims 1-6
Date: Tuesday, November 4, 2025 1:30:40 PM
Attachments: [image001.png](#)

Dear Counsel,

The Board authorizes Petitioner to file a Motion to Withdraw all challenges to claims 1-6 of U.S. Patent No. 8,230,101 and proceed only with the challenges to claims 7-12 raised in the Petition for IPR2025-01103. 37 CFR 42.20. The motion shall be filed no later than one week from the date of this email. Petitioner shall file a copy of the Markman order, issued on October 10, 2025 in Patent Owner's litigation with Google LLC captioned as Case No. 2:24-CV-353-JRG in the United States District Court for the Eastern District of Texas Marshall Division, as an exhibit in support of the Motion to Withdraw. Any response or opposition from Patent Owner must be filed within one week from the entry date of the Motion to Withdraw.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366



From: Jeremy Monaldo <Monaldo@fr.com>
Sent: Monday, November 3, 2025 1:44 PM
To: Trials <Trials@USPTO.GOV>
Cc: Peter Lambrianakos <plambrianakos@fabricantllp.com>; Vincent Rubino <vrubino@fabricantllp.com>; Alfred Fabricant <ffabricant@fabricantllp.com>; Julian Pymonto <jpymonto@fabricantllp.com>; IPR50095-0245IP1 <IPR50095-0245IP1@fr.com>; Joseph Mercadante <jmercadante@fabricantllp.com>; PTAB@fabricantllp.com
Subject: IPR2025-01103 – Markman Order and Motion to Withdraw Challenges to Claims 1-6

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Your Honors,

Petitioner writes to inform the Board of a *Markman* order issued on October 10, 2025 in Patent Owner’s litigation with Google LLC captioned as Case No. 2:24-CV-353-JRG in the United States District Court for the Eastern District of Texas Marshall Division. The *Markman* order found that the claim term “a list information transmission unit...” recited in claims 1 and 6 of U.S. Patent No. 8,230,101 (“the ’101 Patent”) is governed by § 112, ¶ 6 and is indefinite as lacking structural support. The finding of indefiniteness implicates claims 1-6 of the ’101 Patent, but does not implicate claims 7-12 of the ’101 Patent, which do not include the relevant claim term.

In an effort to streamline the Board’s review of the present petition and to make the most efficient use of Board resources, Petitioner requests authorization to file a motion to withdraw its challenges to claims 1-6 and for the present proceeding to move forward on only the challenges to claims 7-12.

Petitioner has conferred with Patent Owner and Patent Owner does not oppose a motion to withdraw the challenges to claims 1-6.

The parties are available for a conference call with the Board to discuss the proposed motion at the following dates and times:

Wednesday, November 5, 2025 10 AM – 1 PM and 2 PM – 5 PM ET
Thursday, November 6, 2025 – 11 AM – 12 PM and 2 PM – 3 PM ET
Friday, November 7, 2025 before 2:30 PM ET

Respectfully submitted,
Jeremy Monaldo

Jeremy Monaldo
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