

Filed on behalf of: Google LLC

Entered on: October 16, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

ADVANCED CODING TECHNOLOGIES LLC,
Patent Owner.

IPR2025-01277
Patent 8,230,101

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION**

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1004	WO 2001/076192 to Sloss et al.
1005	U.S. 2006/0161635 to Lamkin et al.
1006	U.S. 2006/0101489 to Roden et al.
1007	U.S. 7,895,633 to Van Hoff et al.
1008	WO 2006/073040 to Ito et al. (certified translation)
1009	"TiVo for Dummies," Andy Rathbone, Wiley Publishing, Inc. (2004)
1010	U.S. 2002/0026563 to Chamberlain et al.
1011	U.S. 5,835,698 to Harris et al.
1012	Plaintiff's Fourth Amended Disclosure of Asserted Claims and Infringement Contentions, Appendix E-1 - Claim Chart for U.S. Patent No. 8,230,101 Against Google Cloud Content Delivery Network (CDN) and Google Products Utilizing CDN
1013	Plaintiff's Fourth Amended Disclosure of Asserted Claims and Infringement Contentions, Appendix E-2 - Claim Chart for U.S. Patent No. 8,230,101 Against YouTube and Google Products Utilizing YouTube
1014	Plaintiff's Fourth Amended Disclosure of Asserted Claims and Infringement Contentions, Appendix E-3 - Claim Chart for U.S. Patent No. 8,230,101 Against Google Home App and Compatible Google Products
1015	"Online File Storage System" by T.K. Rou, Proceedings of the 2002 Student Conference on Research and Development, IEEE (2002)
1016	Declaration and Curriculum Vitae of June Munford
1017	Microsoft Computer Dictionary, 5 th ed. (excerpts)

1018	"File Structures," Folk et al., 2 nd ed. (1992)
1019	2005 Service Update Guide, TiVo Inc. (2005)
1020	"Torvalds on TiVo," Forbes, March 9, 2006, <i>available at</i> https://www.forbes.com/2006/03/09/torvalds-linux-licensing-cz_dl_0309torvalds2.html
1021	WO 2006/073040 to Ito et al. (Japanese language original)
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1053	U.S. Patent No. 8,230,101 Patent Assignment, Reel: 059497 Frame: 0108 ("ACT Assignment")
1054	About Advanced Coding Technologies LLC, https://advancedcodingtechnologies.com/about (last visited Aug. 28, 2025) ("About ACT")
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1067	Order of Dismissal, <i>Advanced Coding Technologies LLC v. LG Electronics Inc.</i> , No. 2:22-cv-00501 (E.D. Tex. May 31, 2024), ECF 120 (“ACT-LG Dismissal”)
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1070	Order of Dismissal, <i>Advanced Coding Technologies LLC v. Samsung Electronics Co.</i> , No. 2:22-cv-00499 (E.D. Tex. Sept. 13, 2024), ECF 222 (“ACT-Samsung Dismissal”)
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1072	How We Started and Where We Are Today – Google – About Google, http://about.google/company-info/our-story/ (last visited Aug. 6, 2025) (“About Google”)
1073	A New Era of American Innovation – About Google Around the World, https://about.google/intl/ALL_us/around-the-globe/local-info/ (last visited Aug. 6, 2025) (“Google – New Era”)
1074-1078	[reserved]
1079	Letter from IP Subcommittee Ranking Member Schiff to U.S. Dept. of Commerce, dated Apr. 18, 2025 (“Schiff letter to DOC”)
1080	The Patent Trial and Appeal Board and Inter Partes Review, https://crsreports.congress.gov (updated May 28, 2024) (“CRS Report”)
1081-1085	[reserved]
1086	Judge Gilstrap Motion to Stay Results https://search.docketnavigator.com/patent/binder/0/0?print=true (last visited Sept. 4, 2025) (“Gilstrap Stay Results”)
1087	United States District Courts – National Judicial Caseload Profile, https://www.uscourts.gov/data-news/data-tables/2025/03/31/federal-judicial-caseload-statistics/c-5 (“Caseload Stats”)
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1089	Minute Entry, <i>Advanced Coding Technologies LLC v. Google LLC</i> , No. 2:24-cv-00353 (E.D. Tex. July 19, 2024) (“Minute Entry re Scheduling Conference”)
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1094	Dufresne et al., “How Reliable Are Trial Dates Relied on by the PTAB in the Fintiv Analysis?” Perkins Coie (Oct. 29, 2021) (“Fintiv Study”)
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1110	<i>Comm’n Techs., Inc. v. Samsung Elecs. Am., Inc.</i> , No. 2:21-cv-00444-JRG, 2023 WL 1478447 (E.D. Tex. Feb. 2, 2023)
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1116	<i>Vill. Green Techs., LLC v. Samsung Elecs. Co.</i> , No. 2:22-cv-00099-JRG, 2023 WL 416419 (E.D. Tex. Jan. 25, 2023)
1117	Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” Mar. 24, 2025, https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf (“Interim Procedure for Discretionary Denials”)

1118-1121	[reserved]
1122	“What is Cloud CDN and how does it work?” https://cloud.google.com/blog/topics/developers-practitioners/what-cloud-cdn-and-how-does-it-work
1123	Claim Construction Memorandum and Order, <i>Advanced Coding Technologies LLC v. Google LLC</i> , No. 2:24-cv-00353 (E.D. Tex. Oct. 10, 2025), ECF 86 (“ACT-Google Claim Construction Order”)
1124	[reserved]
1125	E-mails between J. Mercadante (ACT counsel) to J. Lee (Google counsel) re: '101 Patent

Petitioner Google LLC ("Google") submits this opposition to Patent Owner's Request for Discretionary Denial of Institution ("PO Brief," Paper 7) filed by Advanced Coding Technologies, LLC ("Patent Owner" or "ACT"). When holistically assessing the circumstances of this case, it is clear that reviewing the '101 patent is an appropriate use of Office resources. The Petition should be referred for an institution decision on the merits by the Board and not denied discretionarily.

First, the sole discretionary factors addressed in the PO Brief, the status of the parallel litigation and "settled expectations," do not warrant denial. The circumstances of the parallel litigation changed materially since the PO Brief was filed: ACT withdrew its assertion of the '101 patent from the co-pending litigation, rendering its *Fintiv* arguments moot. ACT also does not have the "settled expectations" it claims to have.

Second, the Office erred in issuing the '101 patent. The § 325(d)/*Advanced Bionics* analysis confirms that multiple errors occurred during examination, and the Office's resources are effectively utilized in evaluating and correcting those errors.

Discretionary denial is not appropriate.

I. The *Fintiv* Factors Weigh in Favor of Referral

Most of the PO Brief argues that the Director should deny the Petition under §314(a) given the parallel litigation. But since the PO Brief was filed, ACT withdrew its assertion of the '101 patent, changing the circumstances significantly. Every

Fintiv factor, as well as efficiency, fairness, and the merits, supports referral and institution. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential) (“*Fintiv*”).

A. Factor 1: Litigation Stayed Regarding '101 Patent, Weighing in Favor of Referral/Institution

Factor 1 evaluates whether a stay exists or may be granted after institution (*Fintiv*, 6). Here, the **pending litigation is effectively stayed** with respect to the '101 patent, as ACT stated this week it “is no longer asserting infringement of the '101 Patent.” Ex.1125, 2.

ACT, however, only agreed to dismissing the '101 patent allegations **without** prejudice (and in fact refused to dismiss **with** prejudice), leaving open the possibility that ACT will later assert the '101 patent against Google. ACT's gamesmanship supports referral and institution, as the Board reviewing the '101 patent's merits while the patent is no longer at issue in district court would generate efficiencies, given the still-pending threat of assertion against Google as well as the pending assertion of the '101 patent against other parties that are currently targeted (e.g., Apple) and those that may be in the future. *See infra* §II.D. Accordingly, Factor 1 weighs heavily in favor of referral and institution.

Even if the Director were to consider the litigation as a whole (which would be error, as the litigation is no longer relevant to this IPR), “the record contains adequate evidence that the District Court may grant a stay upon institution,” even if

“not specifically directed to this proceeding,” and thus Factor 1 weighs against denial. *See Juniper Networks, Inc. v. Packet Intelligence LLC*, IPR2020-00336, Paper 21 at 16 (PTAB Sept. 10, 2020).

A stay of the entire litigation remains possible. In deciding whether to stay litigation pending IPR, the Eastern District of Texas considers: (1) whether a stay will unduly prejudice or present clear tactical disadvantage to the nonmoving party, (2) whether a stay will simplify the issues in question and the trial of the case, and (3) whether discovery is complete and whether a trial date has been set. *BarTex Rsch., LLC v. FedEx Corp.*, 611 F. Supp. 2d 647, 649-50 (E.D. Tex. 2009).

The court often stays litigation even when the final written decision deadline lags the scheduled trial date by several months. *See, e.g.*, Ex.1110 (five months); Ex.1111 (three months). And, the court regularly finds that instituted IPRs meet the stay factors and issues stays despite its otherwise aggressive procedural schedules. *See, e.g.*, Ex.1112; Ex.1113; Ex.1111; Ex.1114; Ex.1115; Ex.1110; Ex.1116. Judge Gilstrap also grants motions to stay IPRs regularly. *See* Ex.1086.

The court has also observed that the PTAB's IPR determinations “could narrow the issues before the court, prevent duplicative or unnecessary discovery, and encourage settlement or dismissal.” *Norman IP Holdings, LLC v. TP-Link Techs., Co.*, No. 6:13-cv-384-JDL, 2014 WL 5035718, at *3 (E.D. Tex. Oct. 8, 2014). That is particularly relevant here because after the Board instituted Samsung's IPRs on

ACT's patents, ACT swiftly settled its disputes with Samsung. And, removing asserted patents/claims from litigation due to parallel IPR proceedings creates invaluable efficiencies in the district court. The court has also found that "the outcome of a PTO proceeding is likely to assist the court in determining patent validity or eliminate the need to try infringement issues." *NFC Tech. LLC v. HTC Am., Inc.*, No. 2:13-cv-1058-WCB, 2015 WL 1069111, at *1 (E.D. Tex. Mar. 11, 2015) (citations omitted). Thus, any IPR that would remove or greatly reduce asserted patents/claims, even this IPR on the '101 patent, is "likely to assist" the court by streamlining a potentially unwieldy future trial against Google, Apple, or any other targeted party. *Id.* Streamlining is especially helpful where, as here, the asserted patents cover different subject matter and Google's IPRs cite different art. Significant efficiencies would be gained by adjudicating validity before the Board.

Even if this factor does not weigh in favor of institution based on the above, at the very least, Google has not requested a stay in the parallel litigation, so *Fintiv* factor 1 is neutral. *See, e.g., Hulu, LLC v. SITO Mobile R&D IP, Ltd.*, IPR2021-00298, Paper 11 at 10-11 (PTAB May 19, 2021). Factor 1, properly considered for how the district court will likely rule post-institution under the particular facts here, should weigh in favor of institution, or at worst, neutrally.

B. Factor 2: Schedule Weighs in Favor of Referral/Institution

Because ACT is no longer asserting the '101 patent, the litigation with respect

to the '101 patent is stayed, trial will not commence on the scheduled date, and Factor 2 therefore weighs strongly in favor of referral, as there is no possibility of inconsistent decisions or duplication of efforts.

Even if the Director were to consider evidence regarding the district court's trial date (*see* Ex.1117), statistics show the median time from filing to trial in the Eastern District of Texas is roughly 26 months. *See* Ex.1087 (26.2 months); Ex.1088 (25.9 months). So, trial in any subsequent, gamesmanship-driven litigation, asserting the '101 patent, would not occur for more than two years, well after any final written decision would issue in this IPR. Factor 2 therefore weighs strongly in favor of referral and against exercising discretion.

C. Factor 3: Investment Weighs In Favor of Referral/Institution

In the litigation, a claim construction order issued on October 10, 2025. *See* Ex.1123. No other pertinent orders have issued, and no further investment will occur with respect to the '101 patent. Accordingly, the investment in the parallel proceeding (*Fintiv* at 9-12) and circumstances here suggest that this factor weighs strongly in favor of referral and against discretionary denial.

D. Factor 4: No Overlap Weighs in Favor of Referral

Because the '101 patent is no longer asserted in the litigation, there is no overlap between the arguments presented before the Board and the invalidity arguments in district court, weighing strongly in favor of referral and against

discretionary denial. Notwithstanding this recent change, Google previously provided a *Sotera* stipulation (Ex.1024) that also weighs strongly against exercising discretion. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential). Given ACT's withdrawal of the '101 patent, Google's stipulation, and the estoppel provision, there is no overlap between the invalidity issues here and those in district court, favoring referral. *Fintiv*, 12-13.

E. Factor 5: Same Parties Weighs Neutrally for Referral/Institution

When the parties are the same, the Board regularly weighs this neutrally. *See, e.g., Nokia v. Soto*, IPR2023-00680, Paper 30 at 13 (Dir. Dec. 3, 2024).

F. Factor 6: Other Circumstances Weigh in Favor of Referral

"Other circumstances," such as the petition's merits, strongly favor referral. *See, e.g., Microsoft v. ParTec*, IPR2025-00318, Paper 9 at 3 (Dir. June 12, 2025) ("*ParTec*") (referring petition based on showing material error despite trial date preceding final written decision date). Additionally, pre-June 2022 decisions confirm a strong merits showing weighs towards referral and institution when taking a "holistic view of whether efficiency and integrity of the system are best served by denying or instituting review" (*Fintiv*, 6). *See also, e.g., Illumina Inc. v. Trs. of Columbia Univ.*, IPR2020-00988, Paper 20 at 8-15 (PTAB Dec. 8, 2020); *Synthego Corp. v. Agilent Techs., Inc.*, IPR2022-00402, Paper 11 at 12-19 (PTAB May 31, 2022); *Samsung Elecs. Co. v. Scramoge Tech., Ltd.*, IPR2022-00241, Paper 10

(PTAB June 13, 2022); *NetNut Ltd. v. Bright Data Ltd.*, IPR2021-01492, Paper 12 at 9-16 (PTAB Mar. 21, 2022); *Coolit Sys., Inc. v. Asetek Danmark A/S*, IPR2021-01195, Paper 10 at 11 (PTAB Dec. 28, 2021).

G. *Fintiv* Factor Summary

In light of ACT's dismissal of the '101 patent, a holistic *Fintiv* factor analysis strongly supports referral, not discretionary denial, and the Director should not exercise discretion to deny based on the litigation.

II. The Process Memorandum's Relevant Considerations Favor Institution

Relevant considerations in Board precedent and the Process Memorandum, including Process Memorandum Factors 3-7, support referral for a merits institution determination. *See* Interim Director Discretionary Process ("IDDP"), § I.B.

A. Strong Unpatentability Challenges Support Referral (Factor 3)

ACT does not address the Petition's strength or explain the merits' relevance; accordingly, this factor cannot weigh towards denial. *See generally* PO Brief; IDDP §II.C.i; *Twitch Interactive, Inc. v. Razdog Holdings LLC*, IPR2025-00307, Paper 18 at 3 (Director May 16, 2025) ("*Twitch*") (referring petition and noting patent owner's allegations in favor of discretionary denial lacked explanation).

Google's Petition shows explicit disclosure or teaching of each challenged claim limitation, backed by expert testimony from Dr. Mark Crovella (Ex.1003) confirming how a POSA would have viewed the references' teachings and why those teachings would have been combined. Given the lack of **any** argument countering

the strength of Google's Petition, this factor weighs strongly in favor of referral.

B. Reliance on Expert Testimony Supports Referral (Factor 4)

Consistent with precedent and Director/Board guidance, Dr. Crovella's testimony weighs towards referral because it provides a background overview of technologies relevant to the patent, a detailed summary of the art, and why and how the art would be combined to render obvious the claims. Additionally, his testimony is supported by the cited art and additional evidence a POSA would have considered in evaluating the patent. ACT hasn't addressed this factor or alleged Dr. Crovella's testimony is inappropriate in any way, nor would such an allegation be true.

C. Settled Expectations Favor Referral (Factor 5)

Google's settled expectations and numerous other facts outweigh ACT's settled expectations argument relying solely on the patent's age. First, despite the IDDP's requirement that a party's brief be "supported with facts **and evidence**" (IDDP § I.C.), ACT's brief includes no evidence supporting its expectations. Nevertheless, even considering a challenged patent's age and resultant potential settled expectations, there may be, as here, persuasive reasons why claims should be reviewed. *See Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2-3 (Director June 26, 2025) ("*Intel*"); *see also Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 at 3 (Director July 17, 2025) ("*Shenzen*"). The *Intel* considerations weigh overwhelmingly against ACT's settled expectations claim.

No commercialization/marketing: The patent statute requires marking products commercializing the '101 patent's apparatus claims. *See* 35 USC § 287(a). ACT alleges compliance with §287 (Ex.1092, ¶¶90) but hasn't provided evidence of marked products. ACT is a non-practicing entity that did not commercialize the patent (*see* Ex.1054) and hasn't shown commercialization or marking by licensees.

ACT's '101 patent district court case accused Google's products using well-known caching techniques. *See, e.g.,* Ex.1092, ¶¶163-173, PO Brief 4. But ACT cannot argue that these products' development or use is commercialization of the patent because there has been no determination that these products implicate the patent. Accordingly, this consideration weighs against ACT.

No assertion until 2024: The '101 patent was never asserted by its original owners. ACT acquired the patent in February 2022, but did not assert the patent for over two years, until August 2024. Thus, for 11 years (two during ACT's ownership), the patent sat dormant, with no evidence that it would be asserted. The lack of assertion cuts against any claim of settled expectations.

This delayed assertion, including after ACT's acquisition, in combination with other factors, meant Google had no reason to anticipate assertion. ACT's infringement contentions for the '101 patent cite, for example, Google blog posts from 2021 (*see* Ex.1017, 6 and Ex.1122) and online discussion board posts from 2016 (*see* Ex.1017, 18) to support its infringement theory. And, ACT's strained

infringement theory, which accuses Google's cloud-based caching techniques (Ex.1017) despite the '101 patent's focus on "HDD portable player[s]" (*see* Ex.1001, 1:5-12), is plainly unreasonable, and Google could not have expected assertion. ACT's unexplained years-long delayed assertion after acquiring the patent, despite relevant products being on the market before/near ACT's acquisition, and its tortured infringement read, leading to Google expecting non-assertion, outweigh ACT's expectations. *See also Home Depot USA, Inc. v. H2 Intellect LLC*, IPR2025-00480, Paper 11 at 2-3 (Dir. Sept. 4, 2025) (referring petition where petitioner's reasons it didn't anticipate assertion weighed against patent owner's expectations). Indeed, ACT's dropping of the '101 patent from the litigation (*see infra* §I.A) further supports that Google had no reason to anticipate assertion.

No licensing: ACT has alleged licensing to three parties, but each appears to be the product of ACT's assertions (detailed below), which began only in 2022. Ex.1058, 25. ACT has only owned the patent since February 2022. Ex.1053. There is no evidence provided by ACT in this IPR that the previous owner licensed the '101 patent. The lack of licensing of the '101 patent prior to ACT's ownership also cuts against any claim of settled expectations and in favor of review.

No application in technology space: Google does not infringe any claim of the '101 patent, and there is no evidence that the patent's claims are implicated by Google's products. *See also* Ex.1059, 41. There is no evidence that the patent has

been applied in Google's technology space, cutting against any settled expectations.

No long-standing knowledge of patent: ACT gave no actual or constructive notice of its patents or allegations to Google before filing suit, cutting against any claim of settled expectations. *Cf. iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 2-3 (Dir. June 6, 2025).

Other facts contradict ACT's settled expectations: ACT's underdeveloped settled expectations arguments are plainly insufficient. *Twitch*, 3 (“alleged settled expectations” allegation not “sufficiently explained”). And, when ACT acquired the patent, it did so knowing it would be subject to challenge and would have **expected** challenges upon assertion. *See Celgene Corp. v. Peter*, 931 F.3d 1342, 1361-1362 (Fed. Cir. 2019) (patent owners have had the “expectation...for nearly four decades” that “patents are open to PTO reconsideration.”). ACT's assignment enumerated rights, title, and interest in the patents, including “reexaminations” confirming that ACT had expectations that its purchased patents would be reviewed. Ex.1053, 19.

Further, ACT provided nothing to support its barebones, conclusory argument of settled expectations and did not show that it acquired the prior owner's expectations or show that it developed its own expectations after the acquisition. ACT withheld from the Director the purchase agreement, which would have shown, e.g., the amount paid, and any validity representations, for the '101 patent. ACT's strategic decision to withhold relevant facts suggests the facts are adverse to ACT,

and its discretionary denial request based on settled expectations without evidence to support existence of those settled expectations should be held against ACT.

While ACT refrained from providing evidence of its subjective expectations, ACT's litigation strategy provides substantial circumstantial evidence that ACT has no settled expectations in any one particular patent it acquired. ACT's pattern of filing multiple lawsuits asserting numerous patents and settling the cases before any merits evaluation occurs, or once IPRs are instituted, indicates ACT has no settled expectations as to any individual asserted patent. *See, e.g.*, Ex.1064-1066 (filing and quickly settling suit against TikTok); Ex.1056-1057, 1067-1070 (filing suits against LG and Samsung and quickly settling LG suit before merits evaluation and Samsung suit after Samsung's IPRs instituted). ACT apparently has no willingness to have its patents fully evaluated on the merits, whether by the Office or district court. Indeed, now that the '101 patent is no longer part of ACT's litigation against Google (*see supra* § I, Ex.1125), the '101 patent will not be evaluated on the merits by the court.

ACT's argument also runs contrary to governing statutes. While Congress has expressly immunized patents of a certain age from post-issuance challenges (*see, e.g.*, H.R. Rep. No. 112-98, pt. 1, at 46-48 (2011) (certain patents immunized from *inter partes* reexamination)) or expressly limited them in other ways (*see* AIA §§ 3(n)(1), 6(f)(2)(A) (immunizing patents from PGR); AIA § 18 (sunset for CBMs)), Congress took the opposite approach for IPRs, eliminating any date-based

carveout such that “**all patents can be challenged** in *inter partes* review,” regardless of age. *See* H.R. Rep. No. 112-98, at 46-48 (emphasis added). “Congress’s choice to depart from the model of a closely related statute is a choice neither we nor the agency may disregard.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 364 (2018).¹

Google’s settled expectations accordingly weigh in favor of referral and outweigh ACT’s underexplained settled expectations contentions.

D. Compelling Economic and Public Interests Supports Referral

Compelling economic interests also favor institution because Google’s strong economic presence in the United States has contributed to American innovation for almost 30 years. Ex.1072. Google employs over 100,000 people. Ex.1073. In 2024, Google invested over \$49 billion in research and development to power American technological leadership and to produce unprecedented leaps in artificial intelligence and quantum computing capabilities that advance national security. *See* Ex.1073. Moreover, in 2024, Google created \$850 billion in economic activity for American businesses, nonprofits, publishers, creators, and developers and maintains offices or

¹ The Director’s application of “settled expectations” also exceeds his authority under the law and is barred by judicial estoppel based on the Office repeatedly advancing the position that a patentee lacked an expectation that its patents would not be challenged. *See Celgene*, 931 F.3d at 1361-62; *see also* 5 U.S.C. § 706(2)(A).

data centers in 26 states. *See* Ex.1073.

ACT, by contrast, is a holding company formed just months before it acquired the '101 patent and others. Ex.1054. ACT does not practice the claimed invention or sell any products related to the claimed technology and does not contribute to or otherwise use its intellectual property for the advancement of economic interests in the United States. This factor therefore favors institution.

ACT's request to reward its actions with discretionary denial of this IPR is unwarranted. This IPR epitomizes IPRs' very purpose: "to weed out bad patent claims" being levied against the industry and burdening American companies' technological and economic contributions via "overpatenting." *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020). In creating the PTAB, the "signature accomplishment" of the AIA (Ex.1079, 2), "Congress was [] concerned that poor-quality patents fueled litigation by so-called 'patent trolls,' a pejorative term for patent plaintiffs that do not manufacture or sell the patented products." Ex.1080, 2.

Referral and institution serves the public interest; doing so would streamline the instant dispute between ACT and Google and disputes involving other parties (e.g., Apple, *see* Ex.1071). Institution and a finding of unpatentability would prevent ACT from future unjustifiable assertions. Although the '101 patent is only currently asserted against Apple, ACT's litigation history and its infringement allegations against users of Google's widely-used products, like YouTube and Google Cloud

Content Delivery Network, suggest that Google and Apple do not complete the list of ACT's targets, and ACT is likely to continue its pattern of serially asserting its patent against additional defendants, creating further inefficiencies with the courts and the Office. *See, e.g.*, Exs.1012-1014 (accusing "customers and end-users of the Accused Products" of infringing the claims).

E. Other Considerations Support Referral (Factor 7)

The "complex and diverse" parallel litigation here "tip[s] the balance against discretionary denial" because it involves multiple patents in different families claiming a diverse range of subject matter, and "the Board is better suited to review a large number of patents involving diverse subject matter." *Tesla-I*.

Prior to dismissal of the '101 patent, ACT's litigation involved six patents in five families, with distinct subject matter and differences in accused products; all patents are subject to Google's IPRs:

IPR	Patent No.	Claimed Subject Matter	Accused Product
IPR2025-00998	8,090,025	Motion Compensation and Smoothing Block Borders	AV1 encoder/decoder chipsets and software
IPR2025-00999	9,986,303	Adaptive Bitrate Streaming	AV1 encoder/decoder chipsets and software
IPR2025-01000	10,218,995	Super-Resolution Image Enhancement	AV1 encoder/decoder chipsets and software
IPR2025-01161	7,804,891	Communication Quality Judgment for Wireless Communication	5G NR Smartphones and WiFi 6 devices
IPR2025-01277	8,230,101	Storage of Multimedia Content	Network content delivery systems
IPR2025-01278	9,042,448	Super-Resolution Image Enhancement	AV1 encoder/decoder chipsets and software

Unique to this case, the Board is particularly well-situated to evaluate this large number of patents because the Board has already performed a preliminary evaluation, for purposes of instituting trial, of half of the patents. *See also* IPR2025-00998, Paper 8; IPR2025-00999, Paper 8; IPR2025-01000, Paper 8.

Additionally, review is justified based on ACT's litigation strategy of serially asserting patents against defendants alleging infringement by similar products, imposing inefficiencies on the courts and Office. *See also Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 2 (Director July 2, 2025) (patent owner's assertion against a large number of parties weighed in favor of referral because "resolving the dispute ... at the Office would be more efficient.").

F. Process Memorandum Factors 1-2 are Neutral

The '101 patent has not been previously evaluated, and there is no new judicial precedent impacting this case, making these considerations neutral.

III. The Office's Error During Examination Supports Referral

ACT presents no §325(d)-based arguments; any such arguments are waived. The record reflects significant Office error during examination, supporting referral.

Advanced Bionics' first part is not satisfied because the "same or substantially the same art" was not presented to the Office. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) ("*Advanced Bionics*"). Google's Petition relies on Sloss,

Lamkin, Rou, Chamberlain, Roden, Van Hoff, Ito, Rathbone, and Harris. Lamkin was listed in an IDS filed during examination (Ex.1002, 354), but none of the other references were cited by the applicant or examiner during examination, none appears on the patent, and none were applied in a rejection or identified in the examiner's reasons for allowance. Accordingly, this Petition's art and arguments are not the same as, or substantially similar to, the art or arguments previously presented. The Office therefore erred in not applying the teachings of the Petition's references.

Even if *Advanced Bionics* part 2 is reached, Office error pervaded examination, supporting referral. During examination, all claims were initially rejected as obvious over teachings of Rafey and Bae. *See* Ex.1002, 432-451. The applicant's first amendments and remarks did not result in allowance; rather, the examiner conducted a further search and added additional teachings from Kageyama in a final Office Action to again reject all claims as obvious. *See id.* 532-538. After additional amendments (*id.* 547-557), the Examiner and applicant conducted an interview, during which the examiner proposed "merging subject matter in the preamble ... into the body of the claims." *Id.* 567. The examiner then allowed the claims.

But it was error to identify the preamble's subject matter as sufficient for allowance because the references before the examiner confirm the subject matter was well-known before the '101 patent's priority date. The incorporated subject matter included, for example, an "internal storage device" and "stream-delivering"

data to a “network player,” as now recited in limitation 1.1. *See* Ex.1002, 569. But Lamkin teaches “storage and other memory,” i.e., “an internal storage device.” Ex.1005, ¶49. Lamkin also teaches using a “streaming protocol” for moving multimedia data over a network, i.e., “stream delivering” to a “network player.” Ex.1005, ¶54. The Office therefore erred in identifying for allowance claim limitations that were clearly in the prior art and erred in not applying the teachings of a reference that was before the examiner and demonstrated obviousness of the allegedly-allowable limitations. Google's Petition shows that these limitations were also known in other references. For example, the Petition's Ground 1 applies Sloss, which teaches a “data storage device” and “multimedia streaming” to show that this subject matter was obvious. *See* Pet.17-21. Ground 5 applies Roden, which teaches an “internal hard drive,” and Van Hoff, which teaches sending a “program stream,” to show obviousness of this subject matter. *See* Pet.54-57. Sloss, Roden, and Van Hoff were never considered.

The lack of Office consideration of pertinent teachings of the new references, and the Office's overlooking of pertinent teachings of the record prior art, including Lamkin, warrant referral, as these omissions constitute material error and justify reconsideration of the '101 patent's claims, especially since the features that were added for allowance were all known and obvious to apply in combination before the priority date, including as shown in the art before the examiner. For each of these

reasons, the *Advanced Bionics* second part is not satisfied.

Trial is therefore warranted because Google has “show[n] a material error by the Office and it is an appropriate use of Office resources to review the potential error,” weighing heavily against discretionary denial. *ParTec* at 3; *see also Taiwan Semiconductor Mfg. Co. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 at 3-4 (Dir. Sept. 3, 2025); *see also Yealink (USA) Network Tech. Co. v. Barco N.V.*, IPR2025-00491, Paper 18 at 2-3 (Dir. June 25, 2025); *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11 at 2 (Dir. June 12, 2025); *Microsoft Corp. v. XI Discovery, Inc.*, IPR2025-00253, Paper 13 at 2-3 (Dir. June 25, 2025); *Anthony Inc. v. Controltec LLC*, IPR2025-00559, Paper 9 at 2 (Dir. July 16, 2025); *Eunsung Glob. Corp. v. Hydrafacial LLC*, IPR2025-00445, Paper 14, at 2-3 (Dir. July 10, 2025) *Activision Blizzard, Inc. v. Milestone Entertainment LLC*, IPR2025-00708, Paper 13 at 2-3 (Dir. Aug. 14, 2025); *Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9 at 2 (Dir. July 31, 2025); *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12 at 2 (Dir. July 17, 2025); *Amazon.com, Inc., v. Soundclear Techs. LLC*, IPR2025-00565, Paper 11 at 2 (Dir. July 10, 2025).

IV. General Plastic Factors Weigh in Favor of Referral

ACT does not address *General Plastic*, which nevertheless does not weigh in favor of denial, because Google has not previously filed a petition against any claim of the '101 patent. *See Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-

01357, Paper 19 (PTAB Sept. 6, 2017) (precedential); *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) (precedential).

The '101 patent is also being challenged by Apple Inc., but ACT doesn't argue that Apple's petition should impact the discretionary decision, and it should not. Google and Apple are not the same party and do not possess a *Valve*-like significant relationship, and Google had no involvement with or input into Apple's IPR. Nor are the petitions "parallel petitions." *See* Trial Practice Guide, 58-59. Google and Apple are simply defendants in different district court proceedings with different allegedly infringing products; their separate IPR filings are the product solely of ACT's "staggered assertions," nothing more. *Volkswagen Group of Am., Inc. v. Neo Wireless LLC*, IPR2022-01537, Paper 8 at 11-12 (PTAB May 5, 2023).

V. Conclusion

A holistic assessment of the arguments and evidence present in this case demonstrates that the Director should refer the Petition for a merits evaluation.²

² Petitioner reserves the right to challenge the March 26, 2025 Interim Processes for PTAB Workload Management, including that document's list of "relevant factors," at least because that document is legally invalid as (1) exceeding the Director's authority, (2) arbitrary and capricious, and (3) adopted without notice-and-comment rulemaking.

Respectfully submitted,

Dated: October 16, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 16th day of October, 2025, a true and correct copy of the foregoing **Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution and all Exhibits** were served by electronic mail on Patent Owner's lead and backup counsel at the following email addresses:

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