

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

METARAIL, INC.,
Patent Owner.

IPR2024-01269 (Patent 10,789,626 B2)
IPR2024-01270 (Patent 9,633,378 B1)
IPR2024-01271 (Patent 10,262,342 B2)
IPR2024-01272 (Patent 10,152,734 B1)¹

Before FRANCES L. IPPOLITO and
BRIAN P. MURPHY, *Administrative Patent Judges*.

PER CURIAM.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ The combined caption is for administrative convenience only and does not indicate a joined case or an expanded panel. The parties are not authorized to use this caption absent express permission of the Board.

IPR2024-01269, Patent 10,789,626 B2
IPR2024-01270, Patent 9,633,378 B1
IPR2024-01271, Patent 10,262,342 B2
IPR2024-01272, Patent 10,152,734 B1

On October 2, 2024, Google LLC (“Petitioner”) filed Petitions pursuant to 35 U.S.C. § 311 requesting institution of *inter partes* review of the claims in U.S. Patent Nos. 10,789,626 B2, 9,633,378 B1, 10,262,342 B2, and 10,152,734 B1. Paper 2 (“Pet.”).² On January 28, 2025, Metarail, Inc. (“Patent Owner”) timely filed a Patent Owner Preliminary Response in each case. Paper 6 (“Prelim. Resp.”). On March 26, 2025, Acting Director Stewart issued a memorandum titled “Interim Processes for PTAB Workload Management” (“Director’s Memorandum” or “Dir. Mem.”).³

The Director’s Memorandum sets forth a new interim process that bifurcates decisions on whether to institute an IPR or PGR “between (i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations.” Dir. Mem. 1. With regard to the implementation date of the new interim process, the Director’s Memorandum states that “[t]he processes described herein will be implemented in IPR and PGR proceedings where the deadline for the patent owner to file a preliminary response *has not yet passed*.” Dir. Mem. 3 (emphasis added). The Preliminary Response deadline here was January 28, 2025, two months earlier than the Director’s Memorandum, meaning the deadline had passed at the time the Director’s Memorandum issued on March 26th.

² For convenience, all citations are to papers and exhibits entered in IPR2024-01269 unless otherwise indicated.

³ The Director’s Memorandum can be found at <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>.

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Patent Owner filed its Preliminary Response on January 28, 2025. Paper 6. The Preliminary Response did not contain a request for discretionary denial. *Id.* On March 31, 2025, Patent Owner, without prior authorization from the Board and without conferring with counsel for Petitioner, filed a paper titled “Patent Owner’s Brief Requesting Discretionary Denial of Institution.” Paper 9. Counsel for Petitioner sent an email to the Board about an hour later objecting to Patent Owner’s filing, to which Patent Owner responded. Ex. 3001.

Patent Owner’s argument that its discretionary denial briefing was authorized by the Director’s Memorandum is not persuasive and relies on a parsed quote that omits a critical qualifying phrase from the Director’s Memorandum. Ex. 3001, 1 (“the Memorandum states that ‘if the time for filing discretionary denial briefing as described herein has already lapsed . . .’”). The Director’s Memorandum only allows a Patent Owner to file discretionary denial briefing under the new bifurcated process “where the deadline for the patent owner to file a preliminary response has not yet passed” as of the March 26, 2025 date of the Director’s Memorandum. Dir. Mem. 3. The very next sentence in the Director’s Memorandum begins with a qualifier (omitted by Patent Owner): “In *that* situation, if the time for filing discretionary denial briefing as *described herein* has already elapsed, the patent owner may submit discretionary denial briefing within one month of the date of this memorandum.” *Id.* (emphases added).

The qualifier, “[i]n that situation,” refers to the situation where the preliminary response deadline had not yet passed as of March 26, 2025. The provision allows Patent Owners in that situation additional time to comply with the new bifurcated process, particularly where the two-month deadline for filing

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discretionary denial briefing had “already elapsed.” *Id.* For example, a patent owner faced with a preliminary response deadline of March 27, 2025 would have additional time to file discretionary denial briefing under the new bifurcated process. Patent Owner’s email argument attempting to justify the filing of an out-of-time discretionary denial brief misreads the Director’s Memorandum.

Therefore, because the Preliminary Response deadline in the above-referenced IPRs had already passed at the time the Director’s Memorandum was issued on March 26, 2025, Patent Owner’s Brief Requesting Discretionary Denial of Institution (Paper #9) is not authorized and will be expunged from the record.

Accordingly it is

ORDERED that Patent Owner’s Brief Requesting Discretionary Denial of Institution filed on March 31, 2025 in each of the above-referenced Inter Partes Review proceedings be expunged from the record.

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