



PTAB Committee

PTAB Committee Meeting

Revamped Director Review Under the New Administration

**Amster
Rothstein &
Ebenstein** LLP

Hosted By:

**Charles
Macedo**



**Ken
Adamo**



ZOOM WEBINAR



**April 15th
2025**

4-5 PM ET

RSVP: ADMIN@NYIPLA.ORG | 1.0 NY/NJ CLE AVAILABLE FOR ATTENDEES

Disclaimer



The following presentation reflects the personal opinions of its authors and does not necessarily represent the views of their respective clients, partners, employers or of Amster, Rothstein & Ebenstein LLP, the New York Intellectual Property Law Association, the PTAB Committee, or their members.

Additionally, the following content is presented solely for the purposes of discussion and illustration, and does not comprise, nor is to be considered, as legal advice.

Agenda – Revamped Director Review

Director Review Process

March 2025 Decisions (Coke)

Statistics (2024/Jan. 2025 – March 2035)

BONUS: Recent Informative Decision

Director Review Process

Director Review Updates (under Coke)

On February 5, 2025, Sections 3.E and 4.A were updated.

On March 5 and 18, 2025, Sections 2.B, 3.D, 4.B, 5.A, and 5.D were updated.

1. Purpose of Director Review

The Under Secretary of Commerce for Intellectual Property and Director of the USPTO (Director) is a statutory member of the Board. 35 U.S.C. § 6(a). The Director is “responsible for providing policy direction and management supervision for the Office,” *id.* § 3(a)(2)(A), and has “the authority to govern the conduct of proceedings in the Office,” *id.* § 2(b)(2)(A). The Director has an interest in creating binding guidance to increase fairness and efficiency, and for establishing consistency across Board proceedings.

In *United States v. Arthrex, Inc.*, the Supreme Court explained that “**constitutional principles chart a clear course: Decisions by [administrative patent judges (APJs)] must be subject to review by the Director.**” 594 U.S. 1, 24 (2021). The Court held that “the Director has the authority to provide for a means of reviewing PTAB decisions” and “may review final PTAB decisions and, upon review, may issue decisions [themselves] on behalf of the Board.” *Id.* at 25. Additionally, the Court in *Arthrex* made clear that “the Director need not review every decision of the PTAB” nor did it require the Director to accept requests for review or issue a decision in every case. *Id.* at 27. Instead, “[w]hat matters is that the Director have the discretion to review decisions rendered by APJs.” *Id.*; see also *Arthrex, Inc. v. Smith & Nephew, Inc.*, 35 F.4th 1328, 1338 (Fed. Cir. 2022) (noting that the Supreme Court “did not hold that the Director must rehear every Board decision, nor did it require the Director to issue a decision in response to every rehearing request”).

After receiving comments from the public as part of a Request for Comments and Notice of Proposed Rulemaking, the Office published [Rules Governing Director Review of Patent Trial and Appeal Board Decisions](#) on **October 1, 2024**, setting forth the process for the Director to review certain Board decisions. Further, although the Supreme Court’s decision in *Arthrex* “concern[ed] only the Director’s ability to supervise APJs in adjudicating petitions for *inter partes* review,” and “[did] not address the Director’s supervision over other types of adjudications conducted by the PTAB,” the Office also provides a mechanism for Director Review of certain other proceedings before the Board, e.g., post grant review proceedings and derivation proceedings. 594 U.S. at 26; 37 C.F.R. § 42.75(a).

2. Availability of Director Review

A. Overview

In *Arthrex*, the Supreme Court exclusively addressed the Director’s ability to review final decisions of the Board in *inter partes* review proceedings. 594 U.S. at 25–26. The Court did not address the Board’s other areas of jurisdiction. *Id.* Nonetheless, **for consistency and uniformity, Director Review requests are available for other areas of Board jurisdiction.** Specifically, a party to a Board decision may request Director Review of any decision on institution under 35 U.S.C. §§ 135, 314, or 324, any final decision under 35 U.S.C. §§ 135, 318, or 328, any decision granting rehearing of such a decision, or any other decision concluding a proceeding brought under 35 U.S.C. §§ 135, 311, or 321. 37 C.F.R. § 42.75(a). As used in 37 C.F.R. § 42.75 and herein, “final decision” includes both final written decisions in *inter partes* and post-grant review proceedings, as well as final decisions in derivations. 37 C.F.R. § 42.75(a).

Moreover, although the issues for which a party may request Director Review are limited as defined below, the Director retains unilateral discretion to initiate Director Review of Board decisions *sua sponte*. 37 C.F.R. § 42.75(b).

2. Availability of Director Review

B. Proceedings under part 42 of 37 C.F.R.

In a proceeding under part 42 of 37 C.F.R., and in lieu of filing a request for rehearing by the Board under 37 C.F.R. § 42.71(d), a party may file one request for Director Review of any decision on institution under 35 U.S.C. §§ 135, 314, or 324, any final decision under 35 U.S.C. §§ 135, 318, or 328, any decision granting rehearing of such a decision, or any other decision concluding a proceeding brought under 35 U.S.C. §§ 135, 311, or 321. 37 C.F.R. 42.75(c).

UPDATE

Requests for Director Review of a Board's **decision on institution** under 35 U.S.C. §§ 135, 314, or 324, or decisions granting rehearing of such a decision, shall be limited to decisions presenting (a) **an abuse of discretion**, (b) **important issues of law or policy**, (c) **erroneous findings of material fact**, or (d) **erroneous conclusions of law**. Both discretionary and merits-based issues may be raised, subject to limitations (a)–(d) above. The Director Review process provides a mechanism **to correct errors at the institution stage**, for example, to **avoid unnecessary trials for patent owners**.

Requests for Director Review of a Board's **final decision** under 35 U.S.C. §§ 135, 318, or 328, decisions granting rehearing of such a decision, or any other decision concluding a proceeding brought under 35 U.S.C. §§ 135, 311, or 321, shall be limited to decisions presenting (a) **an abuse of discretion**, (b) **important issues of law or policy**, (c) **erroneous findings of material fact**, or (d) **erroneous conclusions of law**. As a general matter, a request for Director Review of a final decision is **not an opportunity to raise issues related to the Board's decision on institution**, for example, whether a petition meets the reasonable likelihood standard or how the Board exercised the Director's institution discretion.

4. Determining Whether To Grant Director Review

B. Director Review Determination

UPDATE

The Director receives each request for Director Review, the underlying decision along with the associated arguments and evidence, and the recommendation of the Director Review Executive. From this information, the Director determines whether to grant or deny Director Review, or to delegate further consideration of a decision to a [Delegated Rehearing Panel](#) (Section 5.A.iii below). When reviewing a decision on Director Review, the Director may review the Board's **decision on institution**, the Board's **final decision**, the Board's **decision granting rehearing** of either of those decisions, or **any other decision** concluding a proceeding brought under 35 U.S.C. §§ 135, 311, or 321, which incorporate all matters and all orders entered in the proceeding. 37 C.F.R. § 42.75(a).

The USPTO strives to provide timely consideration of Director Review requests. The amount of time it takes to reach a decision depends on the complexity and number of issues raised.

5. Director Review

A. Process

UPDATE

As explained above, Director Review may be requested in a proceeding under part 42 of 37 C.F.R. where the Board's decision on institution under 35 U.S.C. §§ 135, 314, or 324; the Board's final decision under 35 U.S.C. §§ 135, 318, or 328; or the Board's decision granting rehearing of either a decision on institution or a final decision implicates potential (a) abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.

The Director's decision to grant or deny a request will be communicated directly to the parties in the proceeding. Director Review grants also will be posted on the [Status of Director Review requests](#) webpage. Director Review denials can be found on the Director Review status spreadsheet, which is updated monthly.

5. Director Review

A. Process; ii Grant of Director Review; b) Briefing, Discovery and Oral Argument

UPDATE

Responsive or *amici curiae* briefing may only be submitted if requested by the Director. If a request for either is made by the Director, the USPTO will set forth the procedures to be followed.

Any *amicus* brief submitted by a party with whom the Director has a conflict will be stricken. This process is consistent with Federal Rule of Appellate Procedure 29(a)(2) as adopted by the United States Court of Appeals for the Federal Circuit.

Director Review decisions also are generally made based on the existing record, without the need for additional discovery. However, the Director has discretion to order additional discovery if the Director deems necessary to assist the Director in evaluating the issues presented. 35 U.S.C. § 316(a)(5) (“The Director shall prescribe regulations . . . setting forth standards and procedures for discovery of relevant evidence . . . otherwise necessary in the interest of justice.”); 37 C.F.R. § 42.5(a).

Additionally, the Director has the discretion to order an oral hearing.

5. Director Review

A. Process; ii Grant of Director Review; c) Standard of Review

UPDATE

Decisions of the Board under Director Review are *reviewed de novo*.

Upon review, the Director may – in whole or in part – affirm, reverse, modify, vacate, or remand the decision to the Board for further proceedings. The Director may make any findings or conclusions that the Director deems proper based on the record.

5. Director Review

A. Conflicts of Interest

UPDATE

If the Director, the Director Review Executive, a consulting member of the PTAB, a member of the Advisory Committee, or other USPTO employee has a conflict of interest, **they shall recuse themselves from the Director Review process for that decision.**

In determining whether a conflict of interest exists, the USPTO follows the guidance set forth in the Standards of Ethical Conduct for Employees of the Executive Branch at 5 C.F.R. Part 2635 and will consult with the Department of Commerce Ethics Law and Programs Office, as necessary, to resolve any questions pertaining to conflicts of interest. Conflicts may include, for example, involvement in the examination or prosecution of the underlying patent or a related patent at issue. Further information is available in the [U.S. Department of Commerce USPTO Summary of Ethics Rules](#).

5. Director Review

A. Conflicts of Interest (cont)

UPDATE

Additionally, the Office has set forth procedures that the Office will follow in the event of an actual or potential conflict of interest by the Director of the USPTO. See [Director Recusal Procedure Memorandum](#).

As a matter of policy, the Director Review Executive and PTAB Administrative Patent Judges who consult with the Director or are also Advisory Committee members will additionally follow the guidance on conflicts of interest set forth in the PTAB's [SOP 1](#) and will recuse themselves from any discussion or analysis involving cases or related cases on which they are paneled.

March 2025 Decisions (Coke)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

SIEMENS MOBILITY, INC.,
GROUND TRANSPORTATION SYSTEMS USA, INC., and
PIPER NETWORKS, INC.,
Petitioner,

v.

METROM RAIL, LLC,
Patent Owner.

IPR2024-00947
Patent 9,731,738 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER

Siemens Mobility, Inc. v. Metrom Rail, LLC, IPR2024-00947 (see Delegated Rehearing Panel), Papers 14 (Stewart) (March 6, 2025)

- Order delegating Director Review to a Delegated Rehearing Panel

Siemens Mobility, Inc. v. Metrom Rail, LLC, IPR2024-00947 (see Delegated Rehearing Panel), Papers 14 (Stewart) (March 6, 2025)

Director_PTABDecision_Review@uspto.gov
571.272.7822

Paper 14
Date: March 6, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

SIEMENS MOBILITY, INC.,
GROUND TRANSPORTATION SYSTEMS USA, INC., and
PIPER NETWORKS, INC.,
Petitioner,

v.

METROM RAIL, LLC,
Patent Owner.

IPR2024-00947
Patent 9,731,738 B2

Before COKE MORGAN STEWART, Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.

ORDER

The Office has received a request for Director Review of the Decision Denying Institution for the above-captioned case. *See* Paper 13.

I have considered the request and determined that the Decision warrants review by a Delegated Rehearing Panel (“DRP”). Accordingly, I delegate Director Review of the Decision to a DRP to review the Decision and determine: (1) whether a reference appearing only in an Examiner’s search history is deemed previously presented art under 35 U.S.C. § 325(d) (*see* Decision 12–13); and (2) whether Kane1 is substantially the same as Knott, and, if not, whether the same or substantially the same obviousness arguments were previously presented to the Office (*see id.* at 13–17).

Absent good cause, the DRP shall issue a decision within 30 days of this Order.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

CRUSOE ENERGY SYSTEMS, LLC,
Petitioner,

v.

UPSTREAM DATA INC.,
Patent Owner.

PGR2023-00039
Patent 11,574,372 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of Commerce for
Intellectual Property and Acting Director of the United States Patent and
Trademark Office.*

ORDER

Crusoe Energy Systems, LLC v. Upstream Data Inc., PGR2023-00039 (see Patent eligibility and Delegated Rehearing Panel), Papers 46 & 47 (Stewart) (March 7 & 13, 2025)

- Order Initiating Director Review – [Paper 46](#) (Stewart March 7, 2025)
- Order delegating Director Review to a Delegated Rehearing Panel – [Paper 47](#) (Stewart March 13, 2025)

Crusoe Energy Systems, LLC v. Upstream Data Inc., PGR2023-00039 (see Patent eligibility and Delegated Rehearing Panel), Papers 46 (Stewart) (March 7, 2025)

DirectorPTABDecision_Review@uspto.gov
571.272.7822

Paper 46
Date: March 7, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED
STATES PATENT AND TRADEMARK OFFICE

CRUSOE ENERGY SYSTEMS, LLC,
Petitioner,

v.

UPSTREAM DATA INC.,
Patent Owner.

PGR2023-00039
Patent 11,574,372 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER
Initiating *Sua Sponte* Director Review

On January 21, 2025, the Board issued a Final Written Decision determining that Petitioner Crusoe Energy Systems, LLC (“Petitioner”) had shown that claims 1 and 24 of U.S. Patent No. 11,574,372 B2 are unpatentable because they are directed to ineligible subject matter under 35 U.S.C. § 101. Paper 45, 57–58. The Board also found that Petitioner had not shown that claims 2–4, 7–12, 15–30, 34–37, or 40 were unpatentable under § 101, nor proven that any of the challenged claims were unpatentable based on the other grounds raised in the Petition. *See id.*

I have reviewed the Board’s Decision, the relevant papers, and the relevant exhibits of record in this proceeding. I determine that *sua sponte* Director review of the Board’s Decision is appropriate to address the Board’s determination that claims 1 and 24 are unpatentable under § 101. 37 C.F.R. § 42.75(b). An opinion will issue in due course.

Crusoe Energy Systems, LLC v. Upstream Data Inc., PGR2023-00039 (see Patent eligibility and Delegated Rehearing Panel), Paper 47 (Stewart) (March 13, 2025)

Director_PTABDecision_Review@uspto.gov
571.272.7822

Paper 47
Date: March 13, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

CRUSOE ENERGY SYSTEMS, LLC,
Petitioner,

v.

UPSTREAM DATA INC.,
Patent Owner.

PGR2023-00039
Patent 11,574,372 B2

Before COKE MORGAN STEWART, Acting Under Secretary of Commerce for
Intellectual Property and Acting Director of the United States Patent and
Trademark Office.

ORDER

On March 7, 2025, I issued an Order (Paper 46) initiating *sua sponte* Director Review of the Board's Final Written Decision (Paper 45).

I have determined that the Decision warrants review by a Delegated Rehearing Panel ("DRP"). Accordingly, I delegate Director Review of the Decision to a DRP to review the Decision and determine whether the Board misapprehended or overlooked any material issue of fact or law in its determination that claims 1 and 24 are unpatentable under 35 U.S.C. § 101.

Absent good cause, the DRP shall issue a decision within 30 days of this Order.

Accordingly, it is:

ORDERED that the request for Director Review is delegated to a DRP.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

TESLA, INC.,
Petitioner,

v.

AUTONOMOUS DEVICES, LLC,
Patent Owner.

IPR2023-01055
Patent 11,238,344 B1

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER

Granting Director Review and Remanding to the Patent Trial
and Appeal Board for Further Proceedings

Tesla, Inc. v. Autonomous Devices, LLC, IPR2023-01055 (see Obviousness) Paper 49 (Stewart) (March 13, 2025)

Decision remanding for further proceedings

Tesla, Inc. v. Autonomous Devices, LLC, IPR2023-01055 (see Obviousness) Paper 49 (Stewart) (March 13, 2025)

Director_PTABDecision_Review@uspto.gov Paper 49
571.272.7822 Date: March 13, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

TESLA, INC.,
Petitioner,

v.

AUTONOMOUS DEVICES, LLC,
Patent Owner.

IPR2023-01055
Patent 11,238,344 B1

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER

Granting Director Review and Remanding to the Patent Trial
and Appeal Board for Further Proceedings

Autonomous Devices, LLC (“Patent Owner”) filed **a request for Director Review of the Final Written Decision** (“Decision,” Paper 47) for the above-captioned case. *See* Paper 48. In its request, Patent Owner argues that the Board’s analysis of claim 12 **did not make separate factual findings from its analysis of claim 11**. *See id.* at 3–5. Patent Owner also argues that **the Board provided insufficient analysis and mapping of two limitations in proposed substitute claim 21**, i.e., relating to a “type . . . location [and] size . . . of the first object,” and relating to “wherein the first data structure and the second data structure are correlated with the first one or more instruction sets” *See id.* at 5–11.

Tesla, Inc. v. Autonomous Devices, LLC, IPR2023-01055 (see Obviousness) Paper 49 (Stewart) (March 13, 2025)

Director_PTABDecision_Review@uspto.gov Paper 49
571.272.7822 Date: March 13, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

TESLA, INC.,
Petitioner,

v.

AUTONOMOUS DEVICES, LLC,
Patent Owner.

IPR2023-01055
Patent 11,238,344 B1

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER
Granting Director Review and Remanding to the Patent Trial
and Appeal Board for Further Proceedings

I agree that the Board's analysis of claim 12 **did not make separate factual findings**. *See* Decision at 83–86. Accordingly, I grant review and **remand to the Board for consideration of the arguments made in Patent Owner's request for Director Review.**

I instruct the Board on remand to **consider Patent Owner's arguments as to claim 12 and as to proposed substitute claim 21**. Regardless of the Board's disposition on remand, the **Board should explain more fully its findings as to claim 12 and proposed substitute claim 21**.

Absent good cause, the Board shall **issue a decision on remand within 30 days of this Order.**

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

CISCO SYSTEMS, INC.,
Petitioner,

v.

PORTSMOUTH NETWORK CORP.,
Patent Owner.

IPR2024-00954
Patent 8,199,637 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER

Cisco Systems, Inc. v. Portsmouth Network Corp., IPR2024-00954 (see Delegated Rehearing Panel)), Paper 9 (Stewart) (March 13, 2025)

Order delegating Director Review to a Delegated Rehearing Panel

Cisco Systems, Inc. v. Portsmouth Network Corp., IPR2024-00954 (see Delegated Rehearing Panel)), Paper 9 (Stewart) (March 13, 2025)

Director_PTABDecision_Review@uspto.gov
571.272.7822

Paper 9
Date: March 13, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

CISCO SYSTEMS, INC.,
Petitioner,

v.

PORTSMOUTH NETWORK CORP.,
Patent Owner.

IPR2024-00954
Patent 8,199,637 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER

I have considered the request and determined that the Decision warrants review by a Delegated Rehearing Panel (“DRP”). Accordingly, **I delegate Director Review of the Decision to a DRP to review the Decision** and determine: (1) whether the Board engaged in **an implicit claim construction of the claim limitation “propagating failure information by the detecting node to each node of the other nodes,”**¹ and if so, whether that construction was correct; and (2) whether **the Board properly considered Petitioner’s argument that Mitchell reads on the propagating failure limitation.**

Absent good cause, the DRP shall issue a decision within 30 days of this Order.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

MERCEDES-BENZ USA, LLC,
Petitioner,

v.

DAEDALUS PRIME LLC,
Patent Owner.

IPR2023-01343
Patent 8,898,494 B2

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER

Mercedes-Benz USA, LLC v. Daedalus Prime LLC, IPR2023-01343 (see Delegated Rehearing Panel), Paper 24 (Stewart) (March 25, 2025)

Order delegating Director Review to a Delegated Rehearing Panel

Mercedes-Benz USA, LLC v. Daedalus Prime LLC, IPR2023-01343 (see Delegated Rehearing Panel), Paper 24 (Stewart) (March 25, 2025)

Director_PTABDecision_Review@uspto.gov 571.272.7822	Paper 24 Date: March 25, 2025
UNITED STATES PATENT AND TRADEMARK OFFICE	
BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE	
MERCEDES-BENZ USA, LLC, Petitioner,	
v.	
DAEDALUS PRIME LLC, Patent Owner.	
IPR2023-01343 Patent 8,898,494 B2	
Before COKE MORGAN STEWART, Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office.	
ORDER	

I have considered the request and the response, and I have determined that the Decision warrants review by **a Delegated Rehearing Panel (“DRP”)**. Accordingly, I delegate Director Review of the Decision to a DRP to review the Decision and determine whether the Board: (1) ***misapprehended or overlooked Petitioner’s claim construction arguments for the claim term “workload”*** (Petitioner’s Reply 9–11) ***and erred in construing the term***, and (2) misapprehended or overlooked ***White’s disclosure in finding that White does not teach “a core workload monitor configured to determine a core workload for the first core” and “receiving a bus workload for a communication bus and a first processing element workload for a first processing element,”*** as claims 1 and 4 respectively require.

Absent good cause, the DRP shall issue a decision within 30 days of this Order.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STELLAR, LLC,
Patent Owner.

IPR2024-01205 (Patent 7,593,034 B2)
IPR2024-01206 (Patent 9,485,471 B2)
IPR2024-01207 (Patent 8,692,882 B2)
IPR2024-01208 (Patent 9,912,914 B2)¹

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER

Granting Director Review, Vacating the Decision Granting Institution, and
Denying Institution of *Inter Partes* Review

¹ This order applies to each of the above-listed proceedings.

Motorola Solutions, Inc. v. Stellar, LLC, IPR2024-01205, IPR2024-01206, IPR2024-01207 & IPR2024-01208, Paper 19 (Stewart) (March 28, 2025)

Decision vacating decision granting institution, and
denying institution

Motorola Solutions, Inc. v. Stellar, LLC, IPR2024-01205, IPR2024-01206, IPR2024-01207 & IPR2024-01208, Paper 19 (Stewart) (March 28, 2025)

Stellar (Patent Owner) argues the Board erred in each of these IPRs that “the Board erred in its fact-finding as to ***Fintiv factors 3 and 4***—the investment in the parallel proceeding and the overlap between issues raised in the petition and the parallel proceeding, respectively [and] when properly considered, the investment in the parallel proceeding and the overlap of issues favor exercising discretion to deny institution.”

Apple v. Fintiv, IPR2020-00019

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Motorola Solutions, Inc. v. Stellar, LLC, IPR2024-01205, IPR2024-01206, IPR2024-01207 & IPR2024-01208, Paper 19 (Stewart) (March 28, 2025)

Director_PTABDecision_Review@uspto.gov
571.272.7822

Paper 19
Date: March 28, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STELLAR, LLC,
Patent Owner.

IPR2024-01205 (Patent 7,593,034 B2)
IPR2024-01206 (Patent 9,485,471 B2)
IPR2024-01207 (Patent 8,692,882 B2)
IPR2024-01208 (Patent 9,912,914 B2)¹

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER
Granting Director Review, Vacating the Decision Granting Institution, and
Denying Institution of *Inter Partes* Review

¹ This order applies to each of the above-listed proceedings.

“The Board’s analysis of factors 3 and 4, and overall weighing of the *Fintiv* factors was erroneous. *See* Decision 11–12. ***The Board did not give enough weight to the investment in the parallel proceeding and gave too much weight to Petitioner’s Sotera⁴ stipulation (i.e., a stipulation* that Petitioner will not pursue in district court any ground it raised or reasonably could have raised in the *inter partes* review (IPR)) and its potential to reduce overlap with the issues raised in the parallel proceeding.”**

Motorola Solutions, Inc. v. Stellar, LLC, IPR2024-01205, IPR2024-01206, IPR2024-01207 & IPR2024-01208, Paper 19 (Stewart) (March 28, 2025)

Director_PTABDecision_Review@uspto.gov
571.272.7822

Paper 19
Date: March 28, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STELLAR, LLC,
Patent Owner.

IPR2024-01205 (Patent 7,593,034 B2)
IPR2024-01206 (Patent 9,485,471 B2)
IPR2024-01207 (Patent 8,692,882 B2)
IPR2024-01208 (Patent 9,912,914 B2)¹

Before COKE MORGAN STEWART, Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.

ORDER

Granting Director Review, Vacating the Decision Granting Institution, and
Denying Institution of *Inter Partes* Review

¹ This order applies to each of the above-listed proceedings.

“As to investment in the parallel proceeding, although the Board considered the time and effort the parties and the district court had invested preparing for trial, *the Board* found that “Patent Owner’s infringement case alone . . . could present a substantial, if not overwhelming, *burden on the district court’s resources*” and that “[t]rying invalidity issues adds to *that burden*.” Decision 11. *That analysis could apply in most, if not all, cases and misapprehends the relevant inquiry.*”

Motorola Solutions, Inc. v. Stellar, LLC, IPR2024-01205, IPR2024-01206, IPR2024-01207 & IPR2024-01208, Paper 19 (Stewart) (March 28, 2025)

Director_PTABDecision_Review@uspto.gov
571.272.7822

Paper 19
Date: March 28, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STELLAR, LLC,
Patent Owner.

IPR2024-01205 (Patent 7,593,034 B2)
IPR2024-01206 (Patent 9,485,471 B2)
IPR2024-01207 (Patent 8,692,882 B2)
IPR2024-01208 (Patent 9,912,914 B2)¹

Before COKE MORGAN STEWART, Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.

ORDER

Granting Director Review, Vacating the Decision Granting Institution, and
Denying Institution of *Inter Partes* Review

¹ This order applies to each of the above-listed proceedings.

“Additionally, by the time Patent Owner filed its Preliminary Response (Paper 8, “POPR”), *the parties had served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions.* See POPR 6–8; Ex. 2003–2005, 2007. The court also had *held a claim construction hearing and construed the disputed claim terms.* POPR 7; Exs. 2008, 2011. Thus, at the time of the POPR, the district court and the parties had invested substantial time and resources in the parallel proceeding preparing for a March 10, 2025, trial date—a date *eleven months before the Board’s projected final written decision date.* Decision 10–11. *Given the substantial time and effort the parties and the district court had invested in the parallel proceeding, factor 3 strongly favors discretionary denial.*”

Motorola Solutions, Inc. v. Stellar, LLC, IPR2024-01205, IPR2024-01206, IPR2024-01207 & IPR2024-01208, Paper 19 (Stewart) (March 28, 2025)

Director_PTABDecision_Review@uspto.gov Paper 19
571.272.7822 Date: March 28, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STELLAR, LLC,
Patent Owner.

IPR2024-01205 (Patent 7,593,034 B2)
IPR2024-01206 (Patent 9,485,471 B2)
IPR2024-01207 (Patent 8,692,882 B2)
IPR2024-01208 (Patent 9,912,914 B2)¹

Before COKE MORGAN STEWART, Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.

ORDER
Granting Director Review, Vacating the Decision Granting Institution, and
Denying Institution of *Inter Partes* Review

¹ This order applies to each of the above-listed proceedings.

“As to the **overlap of issues before the Board and in the parallel proceeding**, the Board noted Patent Owner’s argument that Petitioner’s invalidity expert report “repeats all of the assertions in th[e] Petition,” and found that Petitioner’s stipulation would potentially reduce the issues for trial in the parallel proceeding. Decision 11–12. But **Petitioner’s stipulation does not ensure that these IPR proceedings would be a “true alternative” to the district court proceeding**. See Request 8 (quoting Sotera, Paper 12 at 19). *Petitioner’s invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot*. See Exs. 2004, 2012. Accordingly, although Petitioner’s Sotera stipulation may mitigate some concern of duplication between the parallel proceeding and this proceeding, **the stipulation does not outweigh the substantial investment in the district court proceeding or Fintiv factors 1, 2, and 5, which the Board found weighed in favor of denial**. Decision 10–11. Considering the Fintiv factors as a whole, the efficiency and integrity of the system are best served by denying review.”

Motorola Solutions, Inc. v. Stellar, LLC, IPR2024-01205, IPR2024-01206, IPR2024-01207 & IPR2024-01208, Paper 19 (Stewart) (March 28, 2025)

Director_PTABDecision_Review@uspto.gov
571.272.7822

Paper 19
Date: March 28, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

MOTOROLA SOLUTIONS, INC.,
Petitioner,

v.

STELLAR, LLC,
Patent Owner.

IPR2024-01205 (Patent 7,593,034 B2)
IPR2024-01206 (Patent 9,485,471 B2)
IPR2024-01207 (Patent 8,692,882 B2)
IPR2024-01208 (Patent 9,912,914 B2)¹

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

ORDER
Granting Director Review, Vacating the Decision Granting Institution, and
Denying Institution of *Inter Partes* Review

¹ This order applies to each of the above-listed proceedings.

In consideration of the foregoing, it is:

ORDERED that Director Review is granted;

FURTHER ORDERED that the Board's Decision granting institution
of *inter parties* review (Paper 11) is vacated; and

FURTHER ORDERED that the Petition is *denied*, and no trial is
instituted.

CLE Code

Statistics

The Statistics for 2024 (Vidal)

Number of Requests	Party	Granted / Delegated	Denied	Withdrawn / Dismissed
67	Patent Owner	0	64	1 Withdrawn
84	Petitioner	19	64	1 Dismissed
	Sua Sponte	1		
1	Appellant			1

The Statistics for January 2025 (Vidal)

Number of Requests	Party	Granted / Delegated	Denied	Dismissed
9	Patent Owner	0	9	
18	Petitioner	0	18	
	Sua Sponte	1		

The Statistics for March 2025 (Coke)


Number of Requests	Party	Granted / Delegated	Denied	Dismissed
20	Patent Owner	1	9	10
9	Petitioner	2 – Delegated	7	
	Sua Sponte	1		

Bonus

NEW INFORMATIVE DECISION

Cambridge Mobile Telematics, Inc. v. Sfara, Inc. (majority opinion), IPR2024-00952, Paper 12 (December 13, 2024) (designated: March 20, 2025)

IPR2024-00952 Patent 8,989,952 B2	Paper 12 Entered: December 13, 2024
--------------------------------------	--



Patent Trial and Appeal Board
INFORMATIVE as to majority opinion
Designated: March 20, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAMBRIDGE MOBILE TELEMATICS, INC.,
Petitioner,

v.

SFARA, INC.,
Patent Owner.

IPR2024-00952
Patent 8,989,952 B2

Before JOHN F. HORVATH, ROBERT L. KINDER, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

Opinion for the Board filed by DOUGAL, *Administrative Patent Judge*.
Opinion Concurring filed by HORVATH, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

[AIA – denying institution where a petitioner argues for a means-plus-function construction in district court and a plain and ordinary meaning construction in a petition, but **fails to explain the difference in claim construction positions or, alternatively, to provide a means-plus-function construction**]



Questions
