APPENDICES

APPENDICES

APPENDIX A

No. 2026-111

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

In Re GOOGLE LLC,
Petitioner,

On Petition for Writ of Mandamus to the
United States Patent and Trademark Office in
Nos. IPR2025-00487 and IPR2025-00488.

January 27, 2026

ON PETITION AND MOTION

Before LOURIE, WALLACH, and STOLL, *Circuit Judges*.

Wallach, *Circuit Judge*.

The United States Patent and Trademark Office (PTO) denied Google LLC's petitions for *inter partes* review of VirtaMove, Corp.'s patent, reasoning the "patent[] ha[s] been in force for more than 14 years, creating strong settled expectations" and Google had not shown review would be an appropriate use of PTO resources. Appx2. Google now seeks a writ of mandamus directing the PTO to vacate that decision and to reconsider its petitions for IPR without consideration of those "settled expectations." The Director of the PTO and VirtaMove oppose the petition.

In recent decisions, this court considered and rejected similar challenges, by way of mandamus relief, to the PTO's use of "settled expectations" as a factor in denying institution of *inter partes* review. *See In re Cambridge Indus. USA Inc.*, No. 2026-101, 2025 WL 3526129 (Fed. Cir. Dec. 9, 2025) (denying mandamus relief based on arguments that use of "settled

expectations" violates separation of powers, exceeds statutory authority, and is arbitrary and capricious); *In re Sandisk Techs., Inc.*, No. 2025-152, 2025 WL 3526507 (Fed. Cir. Dec. 9, 2025) (same). Google has not shown a right to a different conclusion here based on *Celgene Corp. v. Peter*, 931 F.3d 1342, 1362 (Fed. Cir. 2019)—a case that did not involve or address the limits on our review of a denial-of-institution determination but rather whether final written decisions invalidating the challenged patent claims violated the Takings Clause.

Accordingly,

IT IS ORDERED THAT:

(1) The petition is denied.

(2) The unopposed motion at ECF No. 7 for leave to file a brief as amicus curiae is granted and the corresponding brief is accepted for filing.

FOR THE COURT

[Court Seal]

Jarrett B. Perlow
Clerk of Court

January 27, 2026
Date

APPENDIX B

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

GOOGLE LLC,
Petitioner,

v.

VIRTAMOVE, CORP.,
Patent Owner

IPR2025-00487 (Patent 7,519,814 B2)
IPR2025-00488 (Patent 7,519,814 B2)
IPR2025-00489 (Patent 7,784,058 B2)
IPR2025-00490 (Patent 7,784,058 B2)

Paper 11

July 11, 2025

Before KALYAN K. DESHPANDE,[1] *Acting Deputy Chief Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review

VirtaMove, Corp. ("Patent Owner") filed a request for discretionary denial of institution (Paper 8, "DD

[1] Coke Morgan Stewart, Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office, is recused and took no part in this decision. The Acting Director has delegated her authority in a Notice of Delegation. *See* https://www.uspto.gov/sites/default/files/documents/deshpande-delegationletter.pdf.

Req.") in the above-captioned cases, and Google LLC filed an opposition (Paper 9, "DD Opp.").[2]

After considering the parties' arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in these proceedings. This determination is based on the totality of the evidence and arguments the parties have presented.

Some factors counsel against discretionary denial. For example, there is currently no trial date set for the parallel district court proceeding involving Petitioner and the challenged patents. DD Opp. 6–7.

Other factors, however, weigh in favor of discretionary denial. In particular, the challenged patents have been in force for more than 14 years, creating strong settled expectations, and Petitioner does not provide any persuasive reasoning why an *inter partes* review is an appropriate use of Board resources. *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025). In the absence of any such reasoning, the Office is disinclined to disturb Patent Owner's strong settled expectations.

Although certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions are denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for dis-

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[2] Citations are to papers in IPR2025-00487. The parties filed similar papers in IPR2025-00488, IPR2025-00489, and IPR2025-00490.

cretionary denial is *granted*; and

FURTHER ORDERED that the Petitions are *denied*.

APPENDIX C

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

GOOGLE LLC,
Petitioner,

v.

VIRTAMOVE, CORP.,
Patent Owner

IPR2025-00487 (Patent 7,519,814 B2)
IPR2025-00488 (Patent 7,519,814 B2)
IPR2025-00489 (Patent 7,784,058 B2)
IPR2025-00490 (Patent 7,784,058 B2)[1]

Paper 14

October 1, 2025

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*.

ORDER

The Office received a request for Director Review of the Decision denying institution in each of the above-captioned cases and an authorized response to each

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

request. *See* Papers 12, 13.[2]

Having reviewed the requests and responses, it is:

ORDERED that the requests for Director Review are denied.

[2] Citations are to the record in IPR2025-00487. The parties filed similar papers in IPR2025-00488, IPR2025-00489, and IPR2025-00490.

APPENDIX D

MEMORANDUM

To: All PTAB Judges

From: Coke Morgan Stewart [/s]
Acting Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

Subject: Interim Processes for PTAB Workload Management

Date: October 1, 2025

The Patent Trial and Appeal Board (PTAB) is tasked with several statutory duties under 35 U.S.C. § 6(b), including deciding *ex parte* appeals from adverse examiner decisions by patent applicants and conducting America Invents Act (AIA) trial proceedings, such as *inter partes* reviews (IPRs) and post-grant reviews (PGRs). To ensure that the PTAB continues to meet its statutory obligations as to *ex parte* appeals, while continuing to maintain its capacity to conduct AIA proceedings, the Director will exercise her discretion on institution of AIA proceedings under 35 U.S.C. §§ 314(a) and 324(a) as outlined below.

First, decisions on whether to institute an IPR or PGR will be bifurcated between (i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations. Under this interim procedure, the Director, in consultation with at least three PTAB judges, will determine whether discretionary denial of institution is appropriate. If it is appropriate, the Director will issue a decision denying institution. If it is not appropriate, the Director will issue a decision regarding that determination and refer the

petition to a three-member panel of the PTAB assigned according to Standard Operating Procedure (SOP) 1 (Rev. 16). The three-member panel will then handle the case in the normal course including by issuing a decision on institution addressing the merits and other non-discretionary statutory considerations.

Second, to facilitate this bifurcated approach, the USPTO will permit parties to file separate briefing on requests for discretionary denial of institution. The discretionary denial briefing shall proceed as follows: (1) within two months of the date on which the PTAB enters a Notice of Filing Date Accorded to a petition, a patent owner may file a brief explaining any applicable bases for discretionary denial of institution; and (2) a petitioner may file an opposition brief no later than one month after the patent owner files its brief. Leave to file further briefing may be permitted for good cause. Consistent with 37 C.F.R. § 42.24, discretionary denial briefing will be limited to 14,000 words. A reply brief, if any, will be limited to 5,600 words. The merits briefing schedule and the schedule for requesting rehearing or Director Review as to a decision on institution remain unchanged.

Third, consistent with the discretionary considerations enumerated in existing Board precedent (including *Fintiv, General Plastic,* and *Advanced Bionics*[*]) and the Consolidated Trial Practice Guide (Nov. 2019), the parties are permitted to address all relevant considerations, which may include:

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[*] *Apple Inc. v. Fintiv, Inc.,* IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential); *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha,* IPR2016-01357, Paper 19 (Sept. 6, 2027) (precedential as to § II.B.4.i); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,* IPR2019-01469, Paper 6 (Feb. 13, 2020) (precedential).

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

The Director will also consider the ability of the PTAB to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AIA proceedings, and other workload needs. *See* 35 U.S.C. § 316(b).

These processes aim to improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, reduce pendency in *ex parte* appeals, and promote consistent application of discretionary considerations in the institution of AIA proceedings. The 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. 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.

The processes described herein are temporary in nature due, in part, to the current workload needs of the PTAB.

APPENDIX E

MEMORANDUM

To: All PTAB Judges

From: John A. Squires [/s]
Under Secretary of Commerce for
Intellectual Property and Director of the
United States Patent and Trademark Office

Subject: Director Institution of AIA Trial
Proceedings

Date: October 17, 2025

To improve efficiency, consistency, and adherence to the statutory requirements for institution of trial, effective October 20, 2025, the Director will determine whether to institute trial for *inter partes* review ("IPR") and post-grant review ("PGR") proceedings.[1] This process will maintain PTAB's capacity to conduct IPR and PGR trials and promote consistent application of considerations for institution of trial proceedings before the PTAB. This approach to institution

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[1] Congress provided that the Director determines whether to institute trials under the America Invents Act. *See* 35 U.S.C. § 314(a) ("The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."); *id.* § 314(b) ("The Director shall determine whether to institute an inter partes review under this chapter pursuant to a petition . . . ."); *id.* § 314(c) ("The Director shall notify the petitioner and patent owner, in writing, of the Director's determination under subsection (a), and shall make such notice available to the public as soon as is practicable."); *see also id.* § 324(a), (c), (d) (similar).

flows from the processes outlined in the March 26, 2025 memorandum entitled "Interim Processes for PTAB Workload Management" ("Interim Processes"),[2] under which the Director determines whether or not to deny a petition based on discretionary considerations.

Similar to the discretionary considerations process, the Director, in consultation with at least three PTAB judges, will determine whether to institute trials in all IPR and PGR proceedings. Upon review of discretionary considerations, the merits, and non-discretionary considerations, if the Director determines that institution is appropriate on at least one ground for one challenged claim, the Director will issue a summary notice to the parties granting institution. *See* 35 U.S.C. §§ 314(c), 324(d). Similarly, if the Director determines that institution is not appropriate, whether based on discretionary considerations, the merits, or other non-discretionary considerations, the Director will issue a summary notice denying institution. In proceedings involving novel or important factual or legal issues, the Director may issue a decision on institution addressing those issues. Additionally, where the Director determines detailed treatment of issues raised in a petition is appropriate (e.g., complex claim construction issues, priority analysis, or real party in interest determination), the Director may refer the decision on institution to one or more members of the PTAB. The Office has issued more than 580 decisions under the Interim Processes, providing substantial guidance on how the Director will handle discretionary considerations. Any instituted IPR or PGR proceeding will be referred to a three-member panel of the PTAB to

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[2] Available at https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf.

conduct the trial and that panel will be assigned according to PTAB Standard Operating Procedure (SOP) 1 (Rev. 16).[3]

This Memorandum supersedes the Interim Processes to the extent that (1) routine decisions on institution will be limited to summary notices, and (2) merit-based decisions on whether to institute petitions will not be referred to a three-member panel of the PTAB. The process for briefing discretionary considerations, as outlined in the Interim Processes and the Discretionary Decisions webpage,[4] and the process for briefing the merits and non-statutory considerations will remain the same. Further, all petitions referred to the PTAB for consideration of the merits and non-discretionary considerations under the Interim Processes prior to October 20, 2025 will remain with a three-member panel.

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[3] Available at https://www.uspto.gov/sites/default/files/documents/sop1_r16_final.pdf.

[4] Available at https://www.uspto.gov/patents/ptab/interim-director-discretionary-process.

APPENDIX F

Statutory Provision

35 U.S.C. 314: Institution of inter partes review

(a) Threshold.—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

(b) Timing.—The Director shall determine whether to institute an inter partes review under this chapter pursuant to a petition filed under section 311 within 3 months after—

(1) receiving a preliminary response to the petition under section 313; or

(2) if no such preliminary response is filed, the last date on which such response may be filed.

(c) Notice.—The Director shall notify the petitioner and patent owner, in writing, of the Director's determination under subsection (a), and shall make such notice available to the public as soon as is practicable. Such notice shall include the date on which the review shall commence.

(d) No Appeal.—The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.