UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC AND MICROSOFT CORPORATION,

Petitioners,

v.

CAROLYN W. HAFEMAN

Patent Owner.

IPR2022-01188 through IPR2022-01193

U.S. Patent Nos. 9,892,287; 10,325,122; 10,789,393

PATENT OWNER'S REQUEST FOR EXTRAORDINARY DIRECTOR REVIEW AND SUA SPONTE REVIEW

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I. INTRODUCTION

Patent Owner Carolyn W. Hafeman respectfully requests extraordinary Director Review, or sua sponte consideration by the Director, of six related inter partes reviews. Petitioners Google LLC and Microsoft Corporation obtained institution after LG Electronics Inc., the defendant in parallel litigation and a real party in interest, promised not to pursue in district court any ground raised or reasonably could have raised in the IPRs with a Sotera Stipulation commitment. Patent Owner maintains that the commitment was materially violated, yet no forum has resolved the requested consequence for Sotera Stipulation violations. She seeks review of the actual overlap and, if legally available, vacatur of institution and the resulting Final Written Decisions and termination of the proceedings.

This request is extraordinary but follows years of Patent Owner's persistent ongoing efforts to secure an answer and a consequence for her Sotera compliance issues. Judge Albright enforced the stipulation as to a priority-date challenge before trial but did not address other asserted IPR overlaps before the district court trial. Patent Owner also objected to other asserted overlap during the trial, as well as in post-trial motions. Patent Owner then appealed Sotera commitment issues on appeal before the PTAB Board. The Board did not resolve or address her requested termination remedy in its Final Written Decision. Patent Owner then appealed

Sotera commitment compliance issues at the Federal Circuit who dismissed her Sotera issue challenge as barred from panel review under 35 U.S.C. § 314(d).

Several significant developments have recently emerged in Patent Owner's ongoing efforts to identify the appropriate authority to address the alleged violations of the Sotera stipulations. On Feb 3, 2026, the USPTO participated in the Federal Circuit Appeal oral arguments and the representative for the Director stated: "*... this Court may not review the Director's exercise of discretion to institute". (Hafeman v. Google 2024-1600 Feb 3, 2026, 16:22-18:22)*.

On May 27, 2026, in ASUSTek Computer Inc. v. Nokia Technologies Oy, IPR2025-01153, Director Squires initiated sua sponte Director Review after Nokia's ordinary request had been rejected as untimely. Although that proceeding concluded without a final determination on the merits of the alleged Sotera violation because the parties had reached a settlement, the Director's decision to initiate review demonstrates that such allegations warrant serious consideration at the highest level of the USPTO. *(ASUSTeK Computer Inc. v. Nokia Technologies Oy*, *IPR2025-01153, Papers 27 and 30 (May 27 and July 14, 2026)).*

On June 5, 2026, the Federal Circuit panel decision for Patent Owner confirmed that § 314(d) prevented panel authority from reviewing Patent Owner's requested Sotera-related relief. (*Hafeman v. Google, Microsoft IPR2022-01188-01193, Document 87, page 13)*.

On June 22, 2026, in *Light & Wonder, Inc. v. Evolution Malta Ltd.*, IPR2025-01072, Director Squires issued a precedential decision establishing that exceptional circumstances may permit extension of the Director Review deadline, expressly identifying "a violation of a Sotera stipulation" as an example. (*Id.*, *Paper 30, at 3–4 (Director June 22, 2026) (precedential).)*

All these developments make the Director the only appropriate official to ask whether the Office can act and address this issue.

Patent Owner filed a Combined Petition for Panel Rehearing and Rehearing En Banc on October 1, 2026 (Federal Circuit Case No. 24-1600, Document 97). The Federal Circuit denied rehearing on November 4, 2026. Although that appellate request is no longer pending, the present request raises a distinct question: whether Petitioners complied with the Sotera commitments on which institution was premised and whether the Director may provide relief for any material violation. Patent Owner does not ask the Director to revisit the Federal Circuit's claim-construction ruling.

II. BACKGROUND

A. The claims and Federal Circuit rehearing history

Patent Owner owns U.S. Patent Nos. 9,892,287 (the '287 patent), 10,325,122 (the '122 patent), and 10,789,393 (the '393 patent). The patents concern technology designed to allow an owner to display owner return or

recovery information from remote for lost or stolen computers. Each one of these three patents include the recited claim language limitation of "**through remote communication without assistance by a user with the computer**".

It is critically important that the user with the lost or stolen computer cannot be required to assist in establishing remote communication because the user with the computer could be a thief. It is this feature that also distinguishes these patents from other suggested prior art examples because many products and patent publications at the time of the invention describe products that required users to establish remote communication. For example, the Jenne December 31, 2001, patent application required a user to help establish remote communication by first logging on to the Internet to initiate or change information on the remote computer. At the time of the invention the Blackberry product required a user to interact with the remote computer to see owner information displayed.

The Windows 2000 program would not only require a user who found a lost or stolen computer to establish remote communication by satisfying a security prompt to log in but also required the user who found the computer to have to physically run an ethernet wire from the lost or stolen remote computer to the owner's computer in order to allow the owner to display owner return information. Based on the configuration shown in the expert video Patent Owner received in discovery, let's say someone found a lost laptop at DIA airport in Denver. If the

owner lived in Boulder, CO, the person who found the laptop would have to help establish remote communication by first finding an ethernet cord 44 miles long and run the cord from the airport to the owner's computer and attach it. Then the person finding the lost laptop would have to run back to the airport and guess the username and password to login to the operating system to further assist to establish remote communication so the owner could display return information.

In addition, all three patents further include claim language limitations reciting ". . . **displaying the screen before or with a security prompt which prevents the user from accessing operatively the computer;** . . ." This language teaches that the invention operates before or with a security prompt so that the person possessing the lost or stolen computer—who could be a thief—would be prevented from establishing the remote communication. Once installed, the invention included a unique interactive program that could establish remote communication without assistance from the user with the computer, allowing the owner to communicate with the remote computer to display return or recovery information.

In her October 1, 2026 combined petition for panel rehearing and rehearing en banc, denied November 4, 2026, Patent Owner challenged the panel's statement that the phrase does not limit "the unrecited action of establishing an internet connection in the first instance." Panel Op. 14 (June 5, 2026). Patent Owner

maintained that the claim language must be read as a whole, together with its prosecution history, and that the "remote communication without user assistance" limitation cannot be severed from the claimed operation. This separate claim-construction dispute does not require the Director to resolve it in order to examine compliance with Petitioners' Sotera stipulations.

B. The stipulation and district-court ruling

Google and Microsoft filed six IPR petitions on July 8, 2022 (IPR2022-01188–01193). Patent Owner opposed institution under *Fintiv* because the Waco trial was approaching. On November 30, 2022, LG stipulated that, if instituted, it would not pursue in district court "any ground that [Google or Microsoft] raised or reasonably could have raised" in the IPRs (Ex. 1029). Petitioners argued this would prevent duplicative proceedings and conflicting decisions (IPR2022-01192, Paper 11, at 2). Relying on LG's stipulation, the Board declined discretionary denial and instituted review on January 31, 2023, less than 12 weeks before trial (*id.*, Paper 16, at 8–10).

Patent Owner identified overlap before her trial. In her December 15, 2022 preliminary sur-reply, Patent Owner argued that, despite Petitioners' December 9 Sotera commitment, LG's December 14, 2022, expert report continued to rely extensively on IPR grounds, including Cohen, forcing Patent Owner to litigate those grounds in district court. (*Patent Owner's Preliminary Sur-Reply, IPR2022-*

01192, at 1–2 (Dec. 15, 2022). On April 14, 2023, Judge Albright enforced the stipulation against LG's priority-date challenge but did not adjudicate Patent Owner's other alleged violations. (*W.D. Tex. Case 6:21-cv-00696-ADA Document 203 Filed 04/14/23 ECF No. 203).*

C. Trial-stage disputes and post-trial objections

On the first day of trial, Patent Owner objected that LG's reliance on Cohen, an IPR reference, was a "*backdoor attempt to get around the Sotera stipulation.*" *Trial Tr.* 8:13–17 (Apr. 24, 2023). LG counsel represented that Cohen was being asserted only in combination with "*this Windows 2000 system art,*" which "*could not possibly have been raised in the IPR.*" *Id.* at 6:10–15. When questioned by Judge Albright, counsel pointed to the Windows 2000 equipment defendants had set up in the courtroom and confirmed: "*It's that Windows system art right there.*" *Id.* at 10:1–4. Yet LG never demonstrated the physical Windows 2000 system live to the jury. Instead, its expert acknowledged relying on a video rather than a live demonstration. *Trial Tr.* 799:3–16 (Apr. 27, 2023).

On the third day of trial, LG sought to introduce DX-477, a video selected from 36 recordings the previous night, despite Patent Owner's objection that the selected video was absent from LG's exhibit list. The Court overruled the objection. *Trial Tr.* 472:4–473:3 (Apr. 26, 2023).

Patent Owner maintains that LG's shortened Windows 2000 demonstrative omitted critical steps shown in the longer expert recording provided during discovery, including repeated user logins on the remote computer and a physical wired connection between the computers. These omissions allegedly concealed the user assistance required to establish remote communication—the very limitation at issue in Patent Owner's claims. Patent Owner requests that the Director compare both recordings, the trial exhibits, and the publications relied upon to determine whether Petitioners' substitution of a materially incomplete demonstrative for genuine physical system art violated their Sotera stipulations.

When Patent Owner's counsel requested a live demonstration of the Windows 2000 equipment present in the courtroom, LG's expert, Dr. Sandeep Chatterjee, acknowledged: "*Okay. So they don't seem to be plugged in. We'll need to get power.*" *Trial Tr.* 800:3–15 (Apr. 27, 2023).

The exchange is striking. The lack of a live demonstration alone does not establish a Sotera violation; but the legal question is what ground LG actually advanced to combine Cohen with Windows 2000 physical system art, and did the demonstrative video substituted for a live demonstration of the equipment in the courtroom shown to the jury actually represent physical system art including the critical steps of the user establishing remote communication as described in Patent Owner's claims, or were those critical steps missing?

The BlackBerry theory presents a related issue. Dr. Chatterjee admitted he lacked a functioning BlackBerry Enterprise Server and relied on manuals rather than a live system. *Trial Tr.* 830:7–22 (Apr. 27, 2023). LG's closing argument confirmed that the discontinued back-end service prevented a live demonstration. *Id.* at 1128:24–1129:9 (Apr. 28, 2023). Patent Owner contends that a handheld device without a functioning server did not demonstrate the asserted remote operation. The Director should determine whether LG advanced a genuinely distinct physical-system ground or instead relied on patent-or-printed-publication grounds reasonably available in the IPRs.

Patent Owner continued to challenge LG's Sotera violations in her July 20, 2023, Motion for a New Trial and Partial Judgment as a Matter of Law and her September 25, 2023 Reply, specifically addressing Cohen, Windows 2000, BlackBerry, and the misleading demonstrative video. *Hafeman v. LG Electronics, Inc.*, *No. 6:21-cv-00696-ADA, ECF No. 262, at 8–10 (W.D. Tex. July 20, 2023); ECF No. 268, at 2–4 (Sept. 25, 2023).* Patent Owner's JMOL expressly requested comparison of the two videos: "*LG's efforts to evade this critical no user assistance limitation are made clear by comparing the two minute, thirty-one second video that LG introduced and referenced dozens of times at trial (see* ***Ex. 6****) with the eleven minute, fifty-eight second video attached to Dr. Chatterjee's expert report (see* ***Ex. 7),*** *which showed user assistance was required by logging on to the*

computer first with the username and password." *ECF No. 262, at 4 (July 20, 2023).*

For both Windows 2000 and BlackBerry, LG invoked physical system art to distinguish its district-court theories from the IPR grounds, without demonstrating either complete system live to the jury. Patent Owner requests that the Director **view and compare both linked videos (JMOL Exs. 6–7)** and determine whether LG's actual reliance on physical system art, demonstratives, and publications complied with its Sotera stipulation.

D. Repeated requests to the PTAB and Federal Circuit

Patent Owner raised the Sotera issue in all six October 20, 2023 PTAB sur-replies and requested termination. At the November 2, 2023 hearing, Judge Smith asked: "*Let's say we agree with you on 100 percent of the facts. We agree with you 100 percent. What would that have to do with us? I mean, when have we ever dismissed a petition because of a Sotera violation thing? What basis would we ever have for doing something like that?*" *Oral Hr'g Tr.* 30:4–8 (Paper 31, entered Dec. 7, 2023). Patent Owner's counsel responded: "*A broken stipulation is a basis.*" *Id.* at 31:11–13. This exchange confirms that Patent Owner sought relief for the alleged Sotera violations and pressed the Board to address its authority to enforce the stipulations. The Board's January 23, 2024 Final Written Decisions did not address Sotera compliance issues raised.

Patent Owner continued pursuing Sotera relief before the Federal Circuit. Her September 3, 2024 opening brief made it the first question presented and challenged the Board's failure to address it (Dkt. 20, at 6–7, 29–35). Google and Microsoft opposed (Dkt. 28, at 23–31). Her February 20, 2025 reply again sought termination or vacatur and remand (Dkt. 39, at 1–9). The June 5, 2026 panel decision dismissed this portion of the appeal. Panel Op. 13.

III. ARGUMENT

A. Director-level examination is warranted

A stipulation offered to secure discretionary institution should have meaningful consequences when materially violated. Otherwise, the same grounds may be litigated in both forums, imposing duplicative expense and risking conflicting outcomes—the very harms petitioners invoked the stipulation to prevent. The Director should examine the Board's reliance on LG's promise, the pretrial estoppel ruling, and the separately contested trial-stage grounds, with an opportunity for all parties to address the evidence and proper remedy.

B. Ingenico requires examination of the actual grounds

Patent Owner recognizes that *Ingenico Inc. v. IOENGINE, LLC*, *136 F.4th 1354, 1366–67 (Fed. Cir. 2025)*, distinguishes physical-system prior-art grounds from patent-or-printed-publication grounds, even when publications document a system. However, Petitioners invoked physical system art, including equipment

present in the courtroom, to justify Sotera compliance, while allegedly substituting a materially incomplete demonstrative video that omitted critical steps establishing remote communication. Patent Owner requests that the Director examine both the asserted invalidity grounds and the underlying evidence to determine whether the Windows 2000 and BlackBerry theories, including Cohen combinations, genuinely constituted distinct physical-system grounds or instead advanced patent-or-printed-publication grounds covered by the Sotera stipulations.

C. Exceptional timing, jurisdiction, and relief

The ordinary Director Review deadlines have long passed, the Board issued Final Written Decisions, and the Federal Circuit denied panel and en banc rehearing on November 4, 2026. Patent Owner therefore requests sua sponte consideration, or a lawful waiver or extension of ordinary review. The denial of rehearing does not itself resolve the distinct question of compliance with the Sotera commitments made to the USPTO. If there is no consequence for violating a Sotera commitment after the standard Director Review timeframe, then there is nothing to stop a petitioner from violating the commitment after that timeframe has expired. The Director's May 27, 2026 ASUSTeK v. Nokia and June 22, 2026 Light & Wonder actions demonstrate attention to Sotera compliance and exceptional timing.

IV. CONCLUSION AND REQUESTED RELIEF

Patent Owner respectfully requests that the Director examine the stipulation, the Board's reliance, Judge Albright's April 2023 ruling, the actual trial grounds and evidence, and the unresolved requests in multiple forums for an agency consequence. If the Director determines that a material violation undermined institution and that the Office retains remedial authority, Patent Owner requests vacatur of the institution decisions and resulting Final Written Decisions and termination of the six IPRs. Alternatively, she requests that the Director consider whether a limited remand or other Federal Circuit authorization may be sought.

The integrity of a promise used to secure institution warrants an answer, even when the answer must account for finality and appellate constraints.

V. REQUEST FOR PROCEDURAL RELIEF

To the extent permitted under 37 C.F.R. Part 42, including §§ 42.5(b), 42.75(b), and 42.75(c)(1), Patent Owner requests a waiver or extension for good cause, or alternatively, sua sponte Director Review based on exceptional circumstances.

Respectfully submitted,

/s/ Carolyn W. Hafeman

Carolyn W. Hafeman, Patent Owner pro se

Date: November 5, 2026

CERTIFICATE OF SERVICE

I hereby certify that on November 5, 2026, I served a copy of **PATENT OWNER'S REQUEST FOR EXTRAORDINARY DIRECTOR REVIEW AND SUA SPONTE REVIEW** by electronic mail upon the following counsel for Petitioners at the email addresses identified below:

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Dated: November 5, 2026

/s/ Carolyn W. Hafeman
Carolyn W. Hafeman, Pro Se