

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFESCAN, INC., SENSEONICS HOLDINGS, INC., and ASCENSIA
DIABETES CARE HOLDINGS AG,

Petitioners,

v.

CELLSPIN SOFT, INC.,

Patent Owner

IPR2025-00102 (Patent 11,234,121 B2)

IPR2025-00103 (Patent 9,900,766 B2)

IPR2025-00104 (Patent 8,904,030 B2)¹

**PATENT OWNER'S REQUEST FOR REHEARING
OF INSTITUTION DECISION**

¹ This request addresses issues common to the identified cases.

I. INTRODUCTION

This rehearing request arises from a straightforward issue: the Board granted institution without performing the independent, “on their own” evaluation the Director expressly required. Patent Owner Cellspin Soft, Inc. respectfully requests rehearing of the Board’s April 15, 2026 Decision granting institution (Paper 18). Rehearing is warranted because the Decision *fails to implement* the Director’s March 30, 2026 directive that these petitions be evaluated “on their own.”

The Director vacated the TikTok petitions and all joinder orders, resetting the procedural posture and requiring an independent evaluation of these petitions as standalone proceedings. The Institution Decision does not reflect that reset. Instead, it grants institution without reassessing the petitions in the posture the Director required. The Decision further *fails to address discretionary considerations* in that posture, including timing, efficiency, duplication, *and settled expectations*. Indeed, the Director was well aware of the procedural posture of these proceedings and could have readily affirmed institution based on the original TikTok proceedings just as the Board did. These omissions are material and warrant rehearing.

II. LEGAL STANDARD

Under 37 C.F.R. § 42.71(d), rehearing is warranted where the Board has misapprehended or overlooked matters that are material to the decision. The Board’s discretion under 35 U.S.C. § 314(a) is informed by considerations of fairness,

efficiency, and the integrity of the administrative process. *See Danisco US Inc. v. Novozymes A/S*, 744 F.3d 1325, 1336 (Fed. Cir. 2014). The Office has further emphasized that such discretion should be exercised to promote efficient use of resources and avoid duplicative or unnecessary proceedings. *See* USPTO Memorandum, “Interim Processes for PTAB Workload Management” (Mar. 26, 2025).

III. THE DECISION DOES NOT REFLECT THE STANDALONE EVALUATION REQUIRED BY THE DIRECTOR

The Director’s March 30, 2026 Decision expressly vacated institution of the TikTok petitions, vacated all joinder orders, and directed the Board to determine whether the petitions in IPR2025-00102, -00103, and -00104 “should be instituted on their own.” Director Decision, Paper 42 at 7.

That directive *required* the Board to *reset its analysis* and evaluate these petitions as standalone filings by different petitioners, not as extensions of a vacated, joinder-based proceeding.

The Board did **not** do so. The Institution Decision evaluates the petitions without addressing the effect of the Director’s vacatur and without indicating that Petitioners’ showings were reassessed independently in light of that change.

Again, the Director did not leave the prior framework intact; he vacated it and required a new evaluation. The Institution Decision does not reflect that reset. This is a material omission.

IV. THE BOARD PERFORMED NO FRESH FINTIV OR DISCRETIONARY ANALYSIS ON CURRENT FACTS

The Director's directive to evaluate these petitions "on their own" required the Board to reassess discretionary considerations under 35 U.S.C. § 314(a) in light of the changed procedural posture. Those considerations include the timing, efficiency, and duplication factors reflected in *Fintiv*.

Despite Patent Owner's specific requests, the Board performed no fresh *Fintiv* analysis on current facts. The Institution Decision contains no evaluation of the relevant discretionary factors following the Director's vacatur. Instead, it makes only a passing reference to the existence of a stay, without weighing any of the underlying considerations that inform whether institution would promote efficiency or result in duplicative proceedings.

This omission is material. The posture of the parallel district court litigation has materially evolved, including *the advanced stage of the TikTok case and the parties' April 9, 2026 Joint Statement* addressing whether the stay should be lifted. The Board did not consider these developments and did not evaluate their impact on the discretionary analysis. The Decision reflects a static snapshot of the litigation rather than a current assessment. A discretionary analysis under § 314(a) must be based on current facts, not a fixed point in time.

With the stay subject to being lifted, and as stated by Patent Owner during the telephonic hearing, the parallel district court case is likely to proceed on a schedule

that may reach key validity issues within approximately 7–8 *months*, potentially *preceding the Board’s final written decision*. This timing dynamic bears directly on whether institution would promote efficiency or instead result in duplicative proceedings.

The need for a fresh discretionary analysis is further underscored by the practical reality that these proceedings have not become truly independent. Even after the Director’s vacatur, TikTok continues to rely on the existence of these same petitions in the parallel district court litigation to oppose lifting the stay. *See Cellspin Soft, Inc. v. ByteDance Ltd.*, No. 2:23-cv-00496-JRG-RSP (E.D. Tex. Apr. 9, 2026), Joint Statement Related to Stay. This ongoing reliance confirms that the petitions are not functioning as independent proceedings being evaluated “on their own,” but instead remain intertwined in practice, underscoring why a renewed discretionary analysis on current facts was required.

The Board was also aware of additional parallel district court cases involving Autel Robotics and SZ DJI Technology, both of which are subject to U.S. Entity List restrictions. These cases further underscore the need for a fresh Fintiv analysis on current facts in the reset posture required by the Director.

Moreover, recent Office guidance confirms that discretionary considerations play a central role in determining whether institution is appropriate, particularly where petitions are duplicative or arise from complex procedural histories. *See*

USPTO Memorandum, “Interim Processes for PTAB Workload Management” (Mar. 26, 2025). Further, the Board has likewise recognized that duplicative challenges may weigh against institution in appropriate circumstances. *See Dabico Airport Sols., Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2–3 (PTAB June 18, 2025) (informative).

These petitions are derivative of a vacated proceeding and present the same prior art and theories previously advanced. As again noted by Patent Owner during the teleconference, *the same prior art* references and substantially *identical combinations at issue in these petitions are being asserted by TikTok in the parallel district court litigation*, creating a substantial risk of duplicative adjudication and requiring Patent Owner to defend the same invalidity case simultaneously before both the Board and the district court. The Board did not address whether instituting review under these circumstances would promote efficiency or instead result in duplicative adjudication.

The need for a fresh discretionary analysis is further underscored by the divergence in claim construction positions across forums. Under current USPTO practice, both the PTAB and district courts apply the *Phillips* standard, and the Director has emphasized the importance of consistency between proceedings. *See Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (Nov. 3, 2025) (precedential). Here, the constructions being advanced in the parallel

district court litigation diverge materially from those reflected in the instituted petitions. This creates a substantial risk that the same prior art and invalidity theories will be evaluated under different constructions, increasing duplication, inefficiency, and the potential for inconsistent outcomes. These considerations further underscore why a fresh discretionary analysis under § 314(a) on current facts was required.

Taken together, these factors required a fresh discretionary analysis tailored to the posture mandated by the Director. The Board did not perform one. These discretionary considerations were identified by Patent Owner in the post-vacatur posture, yet the Institution Decision does not reflect any analysis of them.

V. THE DECISION DOES NOT ADDRESS SETTLED EXPECTATIONS

Settled expectations are a recognized discretionary consideration under current PTAB practice, particularly where patents have been in force for a substantial period, yet the Board failed to consider them here.

U.S. Patent No. 8,904,030 B2 has been in force for over *eleven years*, and U.S. Patent No. 9,900,766 B2 for approximately *eight years*. Again, the Institution Decision contains no discussion of settled expectations, despite Patent Owner's specific request for briefing on this issue during the telephonic hearing.

The Board has recognized that longstanding patent rights and the absence of new prior art or materially distinct grounds may weigh against institution in appropriate circumstances. *See Dabico Airport Sols., Inc. v. AXA Power ApS*,

IPR2025-00408, Paper 21 at 2–3 (PTAB June 18, 2025) (informative). This consideration is particularly relevant where, as here, the petitions are derivative of prior challenges and rely on the same prior art and theories previously advanced.

The Board’s failure to address settled expectations further confirms that discretionary considerations were not evaluated in the standalone posture required by the Director’s directive. This consideration was likewise raised in the post-vacatur context but is not addressed in the Institution Decision.

VI. THE DECISION RELIES ON THE ABSENCE OF A BRIEFING RECORD IN A POST-VACATUR POSTURE THAT DID NOT PERMIT FULL BRIEFING

The Institution Decision states that “Patent Owner presents no arguments against institution.” Paper 18 at 2. At the same time, the Decision relies on representations made during the April 8, 2026 teleconference regarding the status of the parallel district court litigation. *Id.* at 3 n.3. The procedural history following the Director’s March 30, 2026 Decision reflects that the record was limited and incomplete in the reset posture. The sequence of events is as follows:

- **March 30, 2026** — The Director vacated institution of the TikTok petitions, vacated all joinder orders, and directed that these petitions be evaluated “on their own.”

- **April 2, 2026** — The Board indicated that the parties’ positions were “fully briefed” and that the cases could “move directly to Oral Argument.” *See* Paper 12 at 4.
- **April 3, 2026** — Patent Owner submitted a filing addressing institution in the changed posture, including discretionary considerations such as *Fintiv* and settled expectations.
- **April 6, 2026** — The Board expunged that submission as unauthorized and stated that Patent Owner “will be heard at the April 8, 2026 teleconference.” *See* Paper 14 at 2.
- **April 8, 2026** — During the teleconference, Patent Owner repeatedly identified the implications of the Director’s vacatur for institution, including (i) misalignment from reliance on the vacated TikTok record; (ii) the need for a fresh *Fintiv* analysis on current facts; (iii) questions regarding the true real parties in interest here; (iv) the need to consider settled expectations; and (v) claim construction divergence across forums, *and requested the opportunity to provide briefing on these issues.*
- **April 15, 2026** — The Board issued the Institution Decision without permitting full briefing on institution.

This sequence reflects that Patent Owner raised multiple issues in the precise forum the Board directed. It also reflects that the Board’s procedural approach *changed* between April 2 and April 15. The April 2 Order contemplated proceeding directly to Oral Argument based on a “fully briefed” record. The Institution Decision, however, adopts a different posture, proceeding to institution on a reset record following the Director’s vacatur. That change reflects that issues raised in the April 8 teleconference, including concerns regarding the posture of the record, were considered in shaping the Board’s approach.

At the same time, the Institution Decision *does not reflect* any corresponding consideration of the discretionary issues raised in that same context. The record thus reflects partial implementation of the issues presented:

- The Board *adjusted its procedural approach*, moving away from proceeding directly to Oral Argument, reflecting consideration of concerns regarding the posture of the record following the Director’s vacatur.
- Patent Owner also identified the need for a *fresh discretionary analysis on current facts*, including *Fintiv*.
- Patent Owner further raised *settled expectations*, given the age of the asserted patents.

- Patent Owner also identified *claim construction divergence across forums*, bearing directly on efficiency and consistency under current USPTO practice.

The Institution Decision reflects the procedural adjustment but *does not* reflect any corresponding consideration of these discretionary issues.

Following this sequence, *no opportunity was provided to develop a full briefing record on institution after the Director's vacatur*. Although the April 15 Decision resets the procedural posture and treats the petitions as standalone proceedings, it does not address the discretionary considerations raised in that posture.

Under these circumstances, the statement that “Patent Owner presents no arguments against institution” cannot be understood as a statement that no issues were raised. Rather, it reflects that no full briefing was permitted following the Director's vacatur. Patent Owner identified these issues in the context directed by the Board and requested the opportunity to provide full briefing, but no such opportunity was provided.

The Decision thus reflects a procedural posture in which issues were raised and considered in part, but not developed through a briefing record or addressed in the Decision. The absence of a developed record is then invoked to support institution. This procedural context directly explains the Decision's omission of any

fresh discretionary analysis on current facts, including timing, efficiency, duplication, and settled expectations.

In short, the record reflects that issues bearing on institution were raised and shaped the procedural posture, but were never developed through briefing or addressed in the Decision.

VII. CONCLUSION

The Director required a reset and an independent evaluation of these petitions “on their own.” The Board did not perform that evaluation. It granted institution without reassessing the petitions in the required posture and without conducting any fresh discretionary analysis on current facts.

These omissions go directly to the Director’s directive and the Board’s exercise of discretion under § 314(a). Rehearing is warranted.

Patent Owner preserves its right to seek Director Review pursuant to 37 C.F.R. § 42.75 should the Board deny this Request for Rehearing.

VIII. RELIEF REQUESTED

Patent Owner respectfully requests that the Board:

1. Grant rehearing;
2. Vacate the April 15, 2026 Institution Decision; and
3. Reconsider institution in light of the Director’s March 30, 2026 Decision and the correct procedural posture of these proceedings, together

with the consideration of full briefing on the issues relating to institution of these specific petitions.

In the alternative, Patent Owner requests that the Board deny institution of IPR2025-00104 and the related proceedings.

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Date: April 20, 2026

Respectfully submitted,

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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned certifies that on April 20, 2026, a copy of the foregoing document was served by electronic mail on the following:

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