

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**SAVANT TECHNOLOGIES LLC d/b/a GE LIGHTING,
ELONG INTERNATIONAL USA INC., AND
XIAMEN LONGSTAR LIGHTING CO. LTD.,**
Petitioners,

v.

FEIT ELECTRIC COMPANY, INC.,
Patent Owner.

Case No. IPR2025-00260
Patent No. 8,604,678

PETITIONERS' OPPOSITION TO DISCRETIONARY DENIAL

EXHIBIT LIST

Exhibit No.	Description
EX1001	U.S. Patent No. 8,604,678
EX1002	Declaration of William A. Doolittle, Ph.D.
EX1003	Curriculum Vitae of William A. Doolittle, Ph.D.
EX1004	File History for U.S. Pat. Appl. No. 13/273,212 (excl. references)
EX1005	U.S. Pat. Pub. No. 2009/0057699 (“Basin-2007”)
EX1006	U.S. Pat. Pub. No. 2007/0045761 (“Basin-2005”)
EX1007	U.S. Pat. Pub. No. 2008/0079015 (“Krummacher”)
EX1008	U.S. Patent No. 6,791,259 (“Stokes”)
EX1009	U.S. Patent No. 5,998,925 (“Shimizu-APA”)
EX1010	U.S. Patent No. 6,069,440 (“Shimizu”)
EX1011	U.S. Pat. Pub. No. US2010/0124243 (“Hussell”)
EX1012	DuPont: Polymers, Light and the Science of TiO ₂ (2007)
EX1013	DuPont: Titanium Dioxide for Coatings (2007)
EX1014	Erik S. Thiele and Roger H. French, “Computation of Light Scattering by Anisotropic Spheres of Rutile Titania”, Adv. Mater. 1998, 10, No. 15
EX1015	Erik S. Thiele and Roger H. French, “Light-Scattering Properties of Representative, Morphological Rutile Titania Particles Studied Using a Finite-Element Method”, J. Am. Ceram. Soc., 81 [3] 469–79 (1998)
EX1016	Robert W. Johnson, Erik S. Thiele, And Roger H. French, “Light-scattering efficiency of white pigments: an analysis of model core - shell pigments vs. optimized rutile TiO ₂ ”, TAPPI JOURNAL, November 1997, Vol. 80(11)
EX1017	William D. Ross, “Theoretical Light-Scattering Power of TiO ₂ and Microvoids”, Ind. Eng. Chem., Prod. Res. Develop., Vol. 13, No. 1, 1974
EX1018	Feit Electric’s Initial Infringement Contentions - Claim Charts (May 28, 2024)
EX1019	U.S. Patent No. 8,547,010 (“Jagt”)
EX1020	Int’l Pat. Pub. No. WO 2008/044171 A2 (“Van Woudenberg”)
EX1021	Declaration of Etai Lahav

Exhibit No.	Description
EX1022	Declaration of William A. Doolittle, Ph.D. regarding claims 11-14 of the '678 patent
EX1023	Sudhakar Madhusoodhanan and Devdatt S. Nagvekar, "UV Curable High Opacity Ink Jettable White Ink", RadTech e 5 2006 Technical Proceedings (2006)
EX1024	U.S. Pat. Pub. No. 2011/0001151 ("Toquin")
EX1025- EX1039	[Intentionally Omitted]
EX1040	<i>Feit Elec. Co. v. Elong Int'l USA Inc. and Xiamen Longstar Lighting Co.</i> , No. 3:24-cv-1089 (N.D. Tex.), Dkt. 60, Memorandum and Opinion Order, dated May 5, 2025.

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	BACKGROUND	3
III.	ARGUMENT.....	5
A.	The circumstances favor institution	6
1.	The Board’s strong institution decision on independent claim 1 supports institution of its dependent claims 11-14	7
2.	Patent Owner’s waiver of preliminary response supports efficient institution for claims 11-14	8
3.	Patent Owner’s tactical assertion of claims 11 and 12 necessitated the instant Petition	9
4.	Institution will ensure efficiency and avoid duplication in reviewing dependent claims 11-14	10
B.	Neither district court case supports denial under <i>Fintiv</i>	12
1.	The <i>Savant</i> case is already stayed pending <i>inter partes</i> review, weighing heavily against discretionary denial.....	13
2.	The <i>Elong</i> case is also not a basis for discretionary denial, because the challenged claims are not at issue	15
C.	The challenges to claim 1 were instituted in IPR2024-01357, weighing against discretionary denial under <i>General Plastic</i>	17
IV.	CONSENT TO REPLY	22
V.	CONCLUSION.....	22

TABLE OF AUTHORITIES

<i>Apple Inc. v. Immersion Corp.</i> , IPR2016-01372, Paper 7, Jan. 11, 2017	18
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11, March 20, 2020	<i>Passim</i>
<i>Code200, UAB et al v. Bright Data Ltd. f/k/a Luminati Networks Ltd.</i> , IPR2022-00861, Paper 18, Aug. 23, 2022.....	18, 19
<i>DexCom, Inc. v. Abbott Diabetes Care Inc. f/k/a TheraSense, Inc.</i> , IPR2024-00521, Paper 12, Aug. 22, 2024.....	<i>Passim</i>
<i>General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha</i> , IPR2024-01357, Paper 19, Jan. 11, 2017	<i>Passim</i>
<i>Mercedes-Benz USA, LLC et al v. Carucel Investments, LP</i> , IPR2019-01644, Paper 9, March 26, 2020	<i>Passim</i>
<i>NXP USA, Inc. f/k/a NXP Semiconductors USA, Inc. v. Impinj, Inc.</i> , IPR2021-01556, Paper 13, Sept. 7, 2022.....	21
<i>Qualcomm Inc. v. Cobblestone Wireless LLC</i> , IPR2024-01336, Paper 15, Mrch 7, 2025	2, 19
<i>Savant Techs. LLC d/b/a GE Lighting et al v. Feit Electric Co., Inc.</i> , IPR2024-01357, Paper 17, March 5, 2025	<i>Passim</i>

I. INTRODUCTION

The Board has already instituted trial on independent claim 1 of the '678 patent in IPR2024-01357. *Savant Techs. LLC v. Feit Elec. Co.*, IPR2024-01357, Paper 17 (Mar. 5, 2025). The instant Petition challenges the remaining dependent claims asserted against Savant, which were not included in the original petition because Patent Owner did not assert them until after the original petition was filed. Thus, the instant Petition contains a *pro forma* recitation of the same grounds against claim 1, but the operative challenged claims are dependent claims 11-14. Resolution of the challenge to these dependent claims in coordination with the challenge to independent claim 1 in IPR2024-01357 reduces duplicative litigation and is an efficient use of Patent Office resources, thus weighing strongly against discretionary denial.

With respect to *Fintiv*, none of claims 11-14 are actively being challenged in any ongoing district court proceeding. That is, while claims 11 and 12 have been asserted against Petitioner Savant, that action has been stayed pending *inter partes* review of the '678 patent. For this reason, Patent Owner's *Fintiv* argument relies on its district court case against co-Petitioners Elong and Longstar (PO Br. at 2-9 (evaluating *Fintiv* factors 1-3 only with respect to the *Elong* case)) but fails to explain that claims 11-14 are neither asserted nor challenged in that action. Because there is no risk of duplicative proceedings, the rationale of *Fintiv* does not

apply. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (Mar. 20, 2020) (precedential) (“These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.”). A holistic view of the *Fintiv* factors shows that discretionary denial is not warranted.

With respect to *General Plastic*, Patent Owner’s arguments (PO Br. at 13-17) are misplaced. The instant Petition relies upon the same grounds as the first petition filing, it just extends the earlier ground mappings to claims 11-14 as a consequence of their belated addition to the litigation. The present Petition was filed before Patent Owner’s preliminary response in IPR2024-01357 and before any institution decision, meaning the present Petition is not a ‘serial petition,’ because there was no activity in IPR2024-01357 that Petitioners could have used as a roadmap. *See Qualcomm Inc. v. Cobblestone Wireless LLC*, IPR2024-01336, Paper 15 at 16 (Mar. 7, 2025) (finding no roadmapping concern where a follow-on petition was “substantively identical” to the first petition and thus could not incorporate any insights from the first proceeding); *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15 (Sept. 6, 2017) (precedential) (factors relate to whether to discretionarily deny “follow-on petitions after the Board’s denial of one or more first-filed petitions on the same patent” due to concerns about the roadmapping). Nor is this Petition an improper ‘parallel

petition.’ It duplicates IPR2024-01357 with respect to independent claim 1 and was necessitated by Patent Owner asserting new claims after the filing of IPR2024-01357. *See DexCom, Inc. v. Abbott Diabetes Care Inc.*, IPR2024-00521, Paper 12 at 13-14 (Aug. 22, 2024) (rejecting discretionary denial arguments in similar circumstances) *Mercedes-Benz USA, LLC v. Carucel Invs., L.P.*, IPR2019-01644, Paper 9 at 11-13 (Mar. 26, 2020) (same). Again, the rationale of *General Plastic* does not apply, and a holistic view of the relevant factors shows that discretionary denial is not warranted.

Accordingly, the Director should decline to exercise her discretion to deny institution, and the Board should institute *inter partes* review of claims 11-14.

II. BACKGROUND

Patent Owner has brought three actions asserting the ’678 patent: *Feit Elec. Co. v. LEDVANCE LLC*, No. 5:24-cv-31 (E.D. Ky.), filed February 2, 2024; *Feit Elec. Co. v. Savant Techs. LLC d/b/a GE Lighting*, No. 1:24-cv-473 (N.D. Ohio), filed March 13, 2024 (“the Savant case”); and *Feit Elec. Co. v. Elong Int’l USA Inc. and Xiamen Longstar Lighting Co.*, No. 3:24-cv-1089 (N.D. Tex.), filed May 6, 2024 (“the Elong case”).

Petitioner Savant (along with LEDVANCE) filed IPR2024-01357, requesting *inter partes* review of the ’678 patent, on August 26, 2024. Savant alone

then moved to stay its district court case in view of its petition in IPR2024-01357.

Savant case, No. 1:24-cv-473, Dkt. 25 (N.D. Ohio).

Patent Owner asserted claims 11 and 12 of the '678 patent against Savant and only Savant on September 20. *Id.*, Dkt. 27. In response, on December 9, Savant filed the instant Petition, which Petitioners Elong and Longstar chose to join, to address those newly asserted claims. Concurrently, Elong and Longstar filed a duplicate of IPR2024-01357 as IPR2025-00258, along with a motion for joinder to IPR2024-01357. Petitioners structured the instant Petition to rely on the grounds presented in IPR2024-01357 with respect to independent claim 1; that is:

Ground	Claims	Description
1	1	Obvious over Basin-2007 in view of Basin-2005 (duplicate of IPR2024-01357 ground)
2	11-14	Obvious over Basin-2007 in view of Basin-2005 and Stokes
3	1, 11-14	Obvious over Krummacher in view of Shimizu and Stokes (duplicate of IPR2024-01357 ground with respect to independent claim 1)

On December 12, the district court denied Savant's motion for stay, with leave to renew should IPR2024-01357 be instituted. *Id.*, Dec. 12, 2024 Order ("Defendant's motion to stay pending resolution of inter partes review (Doc. 25) is

DENIED without prejudice. If the Patent Trial and Appeal Board accepts the petition for inter partes review, the parties may rebrief this issue.”).

The Board instituted IPR2024-01357 on March 5, 2025, rejecting Patent Owner’s arguments *in toto*. *Savant Techs. LLC v. Feit Elec. Co.*, IPR2024-01357, Paper 17 (Mar. 5, 2025). Savant renewed its motion for stay in the district court, which was ultimately granted on April 1. *Savant* case, No. 1:24-cv-473, April 1, 2025 Order (N.D. Ohio). LEDVANCE moved to stay its district court case, which was granted on April 2, 2025. *Feit Elec. Co. v. LEDVANCE LLC*, No. 5:24-cv-31, Dkt. 63 (E.D. Ky.).

Elong and Longstar also moved to stay their district court case following institution in IPR2024-01357, but that motion was denied on May 5 in view of the district court schedule and because Elong and Longstar’s joinder petition, IPR2025-00258, had not yet been instituted. *Elong* case, No. 3:24-cv-1089, Dkt. 60 (N.D. Tex.) (EX1040). Patent Owner has also requested discretionary denial of IPR2025-00258.

III. ARGUMENT

The Director should decline to exercise her discretion to deny institution of the Petition so that dependent claims 11-14 can be included in the ongoing IPR and addressed efficiently in coordination with the review of claim 1. Neither *Fintiv* nor *General Plastic* supports discretionary denial. *Fintiv* is inapplicable, because none

of claims 11-14 are currently being challenged in a district court. *General Plastic* is similarly inapplicable because the Petition is narrowly tailored to dependent claims 11-14 and is not directed to independent claim 1. Accordingly, the Board should institute *inter partes* review of claims 11-14.

A. The circumstances favor institution

Both *Fintiv* and *General Plastic* require a holistic analysis of all circumstances, beyond a mere mechanical application of enumerated factors, to determine whether discretionary denial is appropriate. *See Fintiv*, IPR2020-00019, Paper 11 at 6; *General Plastic*, IPR2016-01357, Paper 19 at 16. The Director’s recent guidance with respect to discretionary denial is consistent in emphasizing the importance of a holistic analysis. Interim Processes for PTAB Workload Management, p. 2 (Mar. 26, 2026) (“[C]onsistent 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[.]”). In view of such an analysis, the Director should decline to exercise her discretion to deny institution.

In IPR2024-01357, the Board has already issued a strong decision finding compelling merits and instituting *inter partes* review of independent claim 1. *See* IPR2024-01357, Paper 17 at 15 (Mar. 5, 2025). The Petition is narrowly tailored to

dependent claims 11-14, and Patent Owner has waived its Preliminary Response, further indicating a lack of substantive patentability arguments for dependent claims 11-14 separate from independent claim 1. Moreover, the Petition was directly necessitated by the Patent Owner's belated assertion of additional dependent claims after the filing of the petition in IPR2024-01357.

Accordingly, the Board should institute *inter partes* review of claims 11-14 to efficiently coordinate the review of dependent claims 11-14 with that of independent claim 1.

1. The Board's strong institution decision on independent claim 1 supports institution of its dependent claims 11-14

The Board's institution decision in IPR2024-01357 thoroughly rejected Patent Owner's patentability arguments.

The Board rejected Patent Owner's attempts to distinguish the prior art based on unclaimed features, stating "[i]t is unclear to us from [Patent Owner's brief] whether Patent Owner believes this is a claim construction argument or an obviousness argument, ... although, either way, we reject it." IPR2024-01357, Paper 17 at 17-20. Thus, the Board repeatedly characterized Patent Owner's proposed distinctions as "irrelevant." *Id.* at 24-25. The Board further rejected Patent Owner's nonobviousness arguments, stating "at this stage, we conclude that the skilled artisan would have found it obvious to include [the claimed feature]—as

disclosed in *so many references*.” *Id.* at 27-28 (emphasis added). Accordingly, the Board concluded IPR2024-01357 “presented strong evidence of unpatentability” for independent claim 1. *Id.* at 15.

Because claims 11-14 depend directly from claim 1 and Petitioners rely on the same unpatentability challenge already found persuasive by the Board, the decision instituting review of claim 1 strongly supports institution on claims 11-14.

2. Patent Owner’s waiver of preliminary response supports efficient institution for claims 11-14

Reviewing dependent claims 11-14 will impose no undue burden on the Board.

Patent Owner did not submit a Preliminary Response addressing claims 11-14, effectively conceding that it has no arguments that claims 11-14 are patentably distinct from independent claim 1, already under review in IPR2024-01357. Indeed, Patent Owner’s arguments confirm that the challenges presented against dependent claims 11-14 substantially overlap with the challenge to independent claim 1. (PO Br. at 14-15 (“[T]he claims at issue here are similar to the claims challenged” in IPR2024-01357.) Patent Owner thereby confirms the absence of substantive patentability distinctions between claims 11-14 and independent claim 1, reinforcing that review of these dependent claims will require minimal additional effort from the Board.

Patent Owner's decision to waive preliminary arguments is understandable, given that the only additional limitations in claims 11-14 pertain to Figure 10 of the '678 patent. (Pet'n at 21-28.) As discussed in detail in the Petition, Figure 10 cannot lend patentability to claims 11-14, however, because Figure 10 was duplicated from the prior art without attribution or disclosure to the Patent Office. *Id.*

Accordingly, review of claims 11-14 will efficiently build upon the Board's prior finding regarding claim 1, further demonstrating the appropriateness of institution.

3. Patent Owner's tactical assertion of claims 11 and 12 necessitated the instant Petition

The necessity for the instant Petition arose not from Petitioners' actions, but from Patent Owner's tactical structuring of its infringement allegations, intended to undermine Savant's motion to stay in district court.

The Board has previously determined that discretionary denial is not appropriate in similar circumstance, including in decisions such as *DexCom v. Abbott Diabetes Care*, where the Board found discretionary denial arguments "unavailing because General Plastic Factor 1 is directed to whether a 'petitioner previously filed a petition directed to **the same claims** of the same patent.'"

IPR2024-00521, Paper 12 at 13-14 (Aug. 22, 2024) (citing *General Plastic*). And

in *Mercedes-Benz v. Carucel*, the Board stated it was “not persuaded that the Petition here is truly a ‘follow-on petition,’ as that term is used in *General Plastic*, because there was no prior petition challenging” the dependent claims at issue. IPR2019-01644, Paper 9 at 11-13 (Mar. 26, 2020). For the same reasons set forth in *DexCom* and *Carucel*, discretionary denial is likewise inappropriate here.

Petitioners filed the instant Petition in direct response to Patent Owner’s tactical assertion of dependent claims 11 and 12 against Savant only after Savant moved to stay its district court case following the filing of the initial petition in IPR2024-01357. This subsequent assertion necessitated Petitioners’ action to comprehensively address all claims implicated by Patent Owner’s evolving infringement allegations.

Patent Owner’s decision to assert additional claims only after Petitioners filed IPR2024-01357 weighs strongly in favor of instituting review of these dependent claims.

4. Institution will ensure efficiency and avoid duplication in reviewing dependent claims 11-14

Instituting the instant Petition represents the most effective approach to resolving dependent claims 11-14, promoting judicial economy by coordinating closely with the existing review of base claim 1 in IPR2024-01357. *See Fintiv*,

IPR2020-00019, Paper 11 at 6; *General Plastic*, IPR2016-01357, Paper 19 at 16-17.

Separate proceedings for these closely-related dependent claims would lead to unnecessary duplication of effort, increased litigation costs, and potential inconsistency in outcomes. Addressing these dependent claims concurrently will significantly streamline proceedings, reduce burdens on the parties and the Patent Office, and ensure adjudicative consistency and efficiency.

Patent Owner argues incorrectly that instituting this Petition would result in duplication with the *Elong* case or with IPR2024-01357. There is no duplication with the *Elong* case, however, because the *Elong* case does not involve dependent claims 11-14. The patentability of base claim 1 will already be concurrently litigated in both the *Elong* case and IPR2024-01357, specifically because Patent Owner opposed a stay in the *Elong* case following institution of IPR2024-01357. For similar reasons, there is no duplication between the Petition and IPR2024-01357. The Petition was crafted with a *pro forma* duplicate challenge to claim 1 precisely to avoid any unnecessary duplication of effort between the proceedings. The Board will not need to decide the patentability of claim 1 with respect to the Petition, because it will have already decided the challenge to claim 1 in IPR2024-01357.

Conversely, if institution is denied, dependent claims 11 and 12 will be left dangling. Since claims 11 and 12 are not at issue in either the *Elong* case or IPR2024-01357, a denial of institution would require the district court in the *Savant* case to separately adjudicate the patentability of these dependent claims after the Board’s final written decision on independent claim 1 in IPR2024-01357. Requiring the district court to resolve the patentability of dependent claims 11-12 following the Board’s decision on independent claim 1 in IPR2024-01357 would be an inefficient use of judicial resources. *See Motorola Solutions Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (Mar. 28, 2025) (director review) (IPR proceedings should be “true alternative” to district court proceedings).

For all of these reasons, considerations of judicial efficiency and procedural economy strongly favor instituting *inter partes* review of dependent claims 11-14.

B. Neither district court case supports denial under *Fintiv*

The *Fintiv* factors “relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in [a] parallel proceeding. ... [T]he Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv*, IPR2020-00019, Paper 11 at 6 (Mar. 20, 2020) (precedential).

None of claims 11-14 are actively being challenged in district court. With the *Savant* case stayed, Patent Owner often relies on the *Elong* case as the parallel

district court case. (PO Br. at 2-9 (evaluating *Fintiv* factors 1-3 only with respect to the *Elong* case).) But claims 11-14 are neither asserted nor challenged in the *Elong* case. Because there is no risk of duplicative proceedings, the rationale of *Fintiv* does not apply.

Patent Owner's analysis misses the mark, because it takes each *Fintiv* factor in isolation and arbitrarily shifts between different district court proceedings without explanation. The Director correctly emphasizes the need for a holistic analysis of discretionary factors. See Interim Processes for PTAB Workload Management, p. 2 (Mar. 26, 2025). Under such an approach, discretionary denial is unwarranted.

1. The *Savant* case is already stayed pending *inter partes* review, weighing heavily against discretionary denial

The only district court case in which any of dependent claims 11-14 are asserted is the *Savant* case. However, the *Savant* case has already been stayed following the institution decision in IPR2024-01357, significantly mitigating concerns about inefficiency and duplication of efforts. Accordingly, *Fintiv* factor 1 weighs strongly against discretionary denial with respect to the *Savant* case. *Fintiv*, IPR2020-00019, Paper 11 at 6 (“A district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts.”).

In view of the stay, the remainder of the *Fintiv* factors also weigh strongly against discretionary denial. Factor 2 weighs strongly against denial, as the district court will not schedule trial in the *Savant* case until after the Board issues a final written decision in IPR2024-01357. *See id.* at 9. Factor 3 weighs against denial, because the district court stayed the *Savant* case in view of the limited investment in that case to date. *See id.* at 9-10.

With respect to factors 4 and 5, Patent Owner is correct that there is a substantial overlap between the Petition and invalidity in the *Savant* case. (PO Br. at 9-10.) Collectively, IPR2024-01357 and the instant Petition cover all claims asserted against *Savant* in district court, further simplifying or potentially fully resolving the validity issues. *See Stellar*, IPR2024-01205, Paper 19 at 3-4 (IPR proceedings should be “true alternative” to district court proceedings). In view of the stay pending *inter partes* review, the Petition will further simplify the *Savant* case, weighing against discretionary denial.

Savant previously provided a district court stipulation in connection with IPR2024-01357. IPR2024-01357, Paper 17 at 13-14. To the extent that any concern remains regarding potential inefficiency or duplication of efforts with respect to the *Savant* case, *Savant* provides the following expanded stipulation:

Petitioner *Savant* stipulates that if *inter partes* review is instituted for a claim of the '678 patent in either IPR2024-

01357 or IPR2025-00260, Savant will not assert that the claim is invalid under 35 USC §§102 or 103 in the related district court proceeding.

Thus, the combination of the existing stay and Savant's robust stipulation significantly reduces concerns of inefficiency or duplication, weighing heavily against discretionary denial.

2. The *Elong* case is also not a basis for discretionary denial, because the challenged claims are not at issue

Though a stay has been denied in the *Elong* case, none of claims 11-14 are asserted in that case. So, there is no overlap with the Petition and no potential for inefficiency or duplication of effort. Accordingly, *Fintiv* factor 4 (overlap of issues) weighs against discretionary denial based on the *Elong* case. Similarly, factor 5 (party overlap) also weighs against discretionary denial because Petitioner Savant is not a party to the *Elong* case.

In view of the lack of overlap, the remaining factors also disfavor discretionary denial. Because claims 11-14 are not part of the *Elong* case, no resources have been invested in them, no trial date has been set for them, and a stay has no relevance to them. Accordingly, factors 1 (stay), 2 (trial date), and 3 (investment in proceedings) all weigh against discretionary denial based on the *Elong* case.

To the extent that Patent Owner suggests overlap between the *Elong* case and the Petition's *pro forma* duplication of the challenges to claim 1 from IPR2024-01357 (PO Br. at 8-10), such overlap is not a basis for discretionary denial. IPR2024-01357 has been instituted and will determine the patentability of claim 1, so as discussed below, the Board will not need to decide the patentability of claim 1 again with respect to the Petition. To the extent there is overlap with the *Elong* case and claim 1, that overlap is with the already-instituted IPR2024-01357, not the Petition.

Nor are Elong and Longstar trying to use the present Petition as a back door challenge to claim 1 of IPR2024-01357. Elong and Longstar have already made their challenge to claim 1, along with every other claim asserted against them, in their joinder petition, IPR2025-00258. To remove any doubt, Elong and Longstar confirm that if institution of IPR2025-00258 is denied, they will withdraw from or agree to termination of their participation in the instant Petition.

Elong and Longstar have previously provided a district court stipulation for IPR2025-00258. *See* IPR2024-01357, Paper 17 at 13-14. For the avoidance of doubt, Elong and Longstar further stipulate as follows to avoid unnecessary duplication with the *Elong* case:

Petitioners Elong and Longstar stipulate that if *inter partes* review is instituted for a claim of the '678 patent in either

IPR2025-00258 or IPR2025-00260, Elong and Longstar will not assert that the claim is invalid in the related district court proceeding based on any grounds that include prior art asserted in the IPRs, including *inter alia* any grounds asserting that the invention was known, used, or on sale in this country based on prior art asserted in the IPRs.

For the above reasons, the *Elong* case does not weigh in favor of discretionary denial.

C. The challenges to claim 1 were instituted in IPR2024-01357, weighing against discretionary denial under *General Plastic*

Supplemental petitions that challenge dependent claims asserted after an initial petition filing and rely upon an earlier-filed challenge to the independent claims do not implicate the policy concerns underpinning *General Plastic*, because such petitions do not constitute improper serial petitions, as they do not rely upon any new prior art or arguments refined from earlier proceedings. *See General Plastic*, IPR2016-01357, Paper 19 at 16 (noting that discretionary denial is aimed at petitions that unfairly use prior proceedings as a roadmap); *DexCom*, IPR2024-00521, Paper 12 at 13-14 (rejecting discretionary denial where dependent claims were asserted after initial petition filing); *Carucel*, IPR2019-01644, Paper 9 at 11-13 (same).

In IPR2024-01357, Savant challenged every claim Patent Owner had asserted at that time. When filing IPR2024-01357, Savant had no reason to

anticipate that Patent Owner would later assert additional dependent claims. The instant Petition was filed specifically to address the newly asserted dependent claims 11 and 12 (along with closely related claims 13 and 14, previously unchallenged), relying on the same prior art as IPR2024-01357. The challenge to independent claim 1 was included solely to provide completeness and context for the dependent claim features of claims 11-14. In other words, the instant Petition substantively targets a distinct set of claims, none of which were substantively challenged in IPR2024-01357.

Patent Owner incorrectly argues that discretionary denial under *General Plastic* and *Apple Inc. v. Immersion Corp.* is warranted merely because the instant Petition's challenges to dependent claims rely on the previously presented challenges to independent claim 1 from IPR2024-01357. However, neither *General Plastic* nor *Immersion* involved scenarios where the petitioner duplicated a challenge to an independent claim solely to contextualize dependent claims asserted after the original petition. Instead, both *General Plastic* and *Immersion* involved successive petitions challenging the same claims with different prior art references, raising clear roadmapping and redundancy concerns absent here. See *General Plastic*, IPR2016-01357, Paper 19 at 17-18 (addressing petitions that improperly capitalize on prior Board decision); *Immersion*, IPR2016-01372, Paper 7 at 11-12 (Jan. 11, 2017) (denying institution where petitioner filed multiple

petitions against the same claims using different prior art, raising significant roadmapping concerns).

As the Director explained in *Code200*, “*General Plastic* factor 1 must be read in conjunction with factors 2 and 3.” *Code200*, *UAB v. Bright Data Ltd.*, IPR2022-0861, Paper 18 at 5 (Oct. 4, 2022) (director review). Where a prior petition was not denied on the merits, “factors 1-3 only weigh in favor of discretionary denial when there are ‘road-mapping’ concerns under factor 3 or other concerns under factor 2.” *Id.* at 5. And those concerns are minimized when “a petitioner files a later petition that raises unpatentability challenges substantially overlapping with those in the previously-filed petition and the later petition is not refined based on lessons learned from later developments.” *Id.*; *see also Qualcomm Inc. v. Cobblestone Wireless LLC*, IPR2024-01336, Paper 15 at 16 (citing *Code200* to decline discretionary denial of substantively-identical joinder petition). Here, the challenges to independent claim 1 in the instant Petition do not merely overlap substantially; they are duplicates of the challenges previously instituted in IPR2024-01357. Thus, no roadmapping occurred or could have occurred.

Because the Petition’s challenge to independent claim 1 is merely *pro forma* and the Petition substantively targets dependent claims 11-14, Petitioners have not “previously filed a petition directed to the same claims of the same patent.” *See General Plastic*, Paper 19 at 16. When faced with the same arguments, the panel in

Carucel expressed: “We are not persuaded that the Petition here is truly a ‘follow-on petition,’ as that term is used in *General Plastic*, because there was no prior petition challenging” the newly asserted dependent claims. IPR2019-01644, Paper 9 at 12. Similarly, in *DexCom*, the panel addressed a comparable argument and declined to discretionarily deny, because *General Plastic* applies to cases “where a petitioner previously filed a petition directed to **the same claims** of the same patents.” *DexCom*, IPR2024-00521, Paper 12 at 13-14. After a thorough analysis, the panel in *Cobblestone Wireless* similarly determined that a substantively-identical joinder petition did not fall within the scope of *General Plastic*. IPR2024-01366, Paper 15 at 14-18.

In this context, and as explained in the Petition, the remaining *General Plastic* factors support institution. *See id.*; *General Plastic*, IPR2016-01357, Paper 19 at 9-10, 16-18. The Petition does not rely on any new prior art but rather the same prior art (and arguments) as used to challenge the claims in IPR2024-01357. *See id.* at 16 (factor 2 evaluates whether the petitioner knew of or should have known of the prior art at the time of filing the earlier petition). The Petition was filed prior to Patent Owner’s preliminary response in IPR2024-01357, so the Petition did not and could not use IPR2024-01357 as a roadmap. *See id.* at 17 (factor 3 addresses whether the petitioner has already received a preliminary response or institution decision, creating potential roadmapping concerns).

As in *Carucel* and *DexCom*, the Petition was filed in direct response to Patent Owner asserting new claims against Savant after the initial petition filing in IPR2024-01357, fully justifying the time elapsed between the two petitions. See *General Plastic*, IPR2016-01357, Paper 19 at 18 (factor 4 considers the time elapsed between petitions; factor 5 examines justification for filing multiple petitions); *Carucel*, IPR2019-01644, Paper 9 at 12 (filing justified by newly asserted claims); *DexCom*, IPR2024-00521, Paper 12 at 13-14 (same). Because the Petition relies upon identical prior art and arguments as previously instituted in IPR2024-01357, instituting this Petition imposes no undue burden on the Board's resources and will not delay issuance of a final determination. See *General Plastic*, IPR2016-01357, Paper 19 at 18-19 (factor 6 considers Board resources; factor 7 considers whether petition timing impacts the proceeding's timeline).

Patent Owner assumes that either the Petition must be consolidated with IPR2024-01357, allegedly requiring an extension of the schedule in IPR2024-01357, or that the Petition will proceed entirely independently of IPR2024-01357, resulting in duplication and inefficiency. (PO Br. at 16-17.) To the contrary, while combined briefing or discovery could indeed lead to greater efficiency (see *Carucel*, IPR2019-01644, Paper 9 at 12), IPR2024-01357 will determine the patentability of claim 1 regardless of whether consolidation occurs. And given

IPR2024-01357 has already been instituted, the Board is the most efficient tribunal to resolve the patentability of dependent claims 11-14.

IV. CONSENT TO REPLY

In view of the timing of this case and the Patent Office's recent changes in guidance regarding discretionary denial (*see* Interim Processes for PTAB Workload Management (Mar. 26, 2025); and *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 (Sept. 7, 2022) no longer precedential as of April 25, 2025), Petitioners consent to Patent Owner having a reply to address *inter alia* the denial of stay in the *Elong* case and the stipulations made by Petitioners.

V. CONCLUSION

For all the foregoing reasons, particularly the absence of any overlapping proceeding on claims 11-14, the Director should decline to exercise her discretion to deny institution, and the Board should institute *inter partes* review of dependent claims 11-14 of the '678 patent.

Date: May 19, 2025

Respectfully submitted,

/s/ David C. Radulescu

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), I hereby certify that this motion complies with the type-volume limitation of 37 C.F.R. § 42.24 and the Director's Interim Processes for PTAB Workload Management (Mar. 26, 2025). The word count application of the word processing program used to prepare this motion indicates that the motion contains 4,643 words.

Date: May 19, 2025

/s/ David C. Radulescu
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CERTIFICATE OF SERVICE

I hereby certify that on May 19, 2025, a true and correct copy of the foregoing
was served by electronic mail upon the following counsel of record for Patent Owner:

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