UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPORTRADAR AG,
Petitioner

v.

SPORTSCASTR INC.,
(D/B/A PANDA INTERACTIVE),
Patent Owner.

IPR2025–00265
U.S. Patent No. 10,425,697

PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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I. INTRODUCTION

Patent Owner's discretionary denial arguments miss the mark because they disregard critical facts – the current Petition is a copycat petition, coupled with a Motion for Joinder, where the PTAB has already found that the underlying petition is strong on the merits and warrants trial[1]. The PTAB *is already* conducting a trial considering the patentability of the *same claims* challenged by the current petition *on the same grounds*, regardless of what else happens in the district court. Joining the current Petition to the existing trial, where the Sportradar AG (the "current Petitioner") has proffered a *Sotera* stipulation and has stipulated to undertake an understudy role, simply does not implicate the same concerns that *Fintiv*, *General Plastic* and the March 26, 2025 Stewart Memorandum seek to address.

More specifically, the current copycat petition is coupled to a Motion for Joinder with the Genius IPR, which ***was instituted on March 6, 2025*** (Paper 9 of the Genius IPR), and is well underway. Furthermore, the current Petitioner has proffered a *Sotera* stipulation, and has further stipulated, *inter alia*, ". . . to be bound by the Scheduling Order issued in IPR2024–01308." Motion for Joinder, Paper 9, p. 9.

[1] IPR2024–01308 (the "Genius IPR").

Patent Owner notes that the present petition "is one of four IPR petitions filed against the '697 patent, all relying on identical arguments and prior art references." Patent Owner characterizes these petitions as representing "wasteful, duplicative patent office litigation that the Board's *Fintiv* precedent was designed to prevent." Patent Owner's Discretionary Denial Brief, Paper 12, p.1 (emphasis removed). Patent Owner is wrong on all counts.

Two parallel petitions were previously filed by a different petitioner.[2] *Genius Sports Ltd. v. SportsCastr Inc. (d/b/a PANDA Interactive)*, IPR2024–01308, Paper 1; *Genius Sports Ltd. v. SportsCastr Inc. (d/b/a PANDA Interactive)*, IPR2024–01309, Paper 1. In those cases, Genius explained that two petitions were needed due to the large number of claims asserted by the Patent Owner in the related litigation, and the length of those claims. *Id.*, Paper 3 at 1. Patent Owner never challenged Genius' assertions that two separate IPR petitions were justified, and both cases were instituted on March 6, 2025. *Id*., Paper 9. The current Petitioner then diligently filed two copycat petitions corresponding to the now-instituted IPR2024–01308 and IPR2024–01309 petitions, respectively. *Sportradar Grp. AG v. SportsCastr Inc. (d/b/a/ PANDA Interactive)*, IPR2025–00265, Paper

[2] Genius Sports Ltd. is also a defendant in litigation brought by Patent Owner asserting the '697 patent.

3; *Sportradar Grp. AG v. SportsCastr Inc. (d/b/a/ PANDA Interactive)*, IPR2025–00266, Paper 3. In addition to the very nature of these petitions as being copycats of now-instituted petitions, the current Petitioner also explained why two parallel petitions were necessary. *Id*., Paper 2. The current petitioner then filed Motions for Joinder with the now-instituted IPR2024–01308 and IPR2024–01309 proceedings. *Id*., Paper 9. As part of the Motion for Joinder, the current Petitioner stipulated to take an "understudy" role in the instituted IPRs. *Id*. at 9.

The current Petitioner has done nothing more than what is authorized by statute and rule. 35 U.S.C. § 315(c) ("the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director . . . determines warrants the institution of an inter partes review under section 314."); 37 C.F.R. § 42.122(b) ("Joinder may be requested by . . . as a motion under § 42.22"). The current petition is neither duplicative nor wasteful, and for at least the reasons explained below, is not contrary to or prohibited by *Fintiv*.

Patent Owner should not be heard to complain about facing validity challenges when these challenges are precipitated by the Patent Owner's own litigious conduct.

Furthermore, Patent Owner's reliance upon *NHK Spring*[3] in support of its request for discretionary denial pursuant to 35 U.S.C. § 314(a) is also misplaced. *NHK Spring*, which preceded and gave rise to the *Apple v. Fintiv*[4] decision did *not* involve a situation wherein: (i) the petition under review was a copycat petition filed for purposes of seeking joinder to an underlying IPR trial that was already in progress; (ii) the petitioner has stipulated to undertake an understudy role in the case if granted, and had also proffered a *Sotera* stipulation; and (iii) the gap between the tentative trial date and the deadline for a final written decision was six ***weeks*** (as opposed to six ***months*** in *NHK Spring*). Thus, *NHK Spring* and *Fintiv* are unavailing.

To the contrary, the PTAB has repeatedly recognized that in cases with a much more similar fact pattern to the present case the *Fintiv* and *General Plastic* factors are mitigated if not irrelevant. For instance, the facts here are more akin to those in *Sawai USA, Inc. et al. v. Biogen MA Inc*., IPR2019–00789, Paper 17 (P.T.A.B. Sept. 12, 2019). In that case petitioner filed a copycat of an instituted IPR petition along with a motion for joinder, and agreed to take an understudy role.

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[3] *NHK Spring Co. v. Intri-Plex Techs., Inc.,* IPR2018–00752, Paper 8 (P.T.A.B. Sept. 12, 2018) (precedential).

[4] *Apple Inc. v. Fintiv Inc.*, IPR2020–00019, Paper 11 (P.T.A.B. March 20, 2020) (precedential).

Id. at 2, 6–7. The Board considered the holding in *NHK Spring*, as well as the related district court case that was scheduled to go to trial before a final written decision. Under these facts, the Board properly instituted the IPR and granted the joinder motion. *Id*. at 9–12. The Board correctly found there would be limited prejudice to the patent owner and little to no waste of Board resources in allowing joinder to the ongoing IPR. *Id*. The same rationale and analysis applies here.

II. *FINTIV* DOES NOT WARRANT DISCRETIONARY DENIAL

Fintiv seeks to address questions around efficiency – will the PTAB be duplicating efforts already undertaken in the district court? Again, this concern is not implicated by the current petition because the PTAB is already conducting a trial of the on the same claims and the same grounds. Instituting the current petition and joining it to the existing trial does nothing to increase the workload of the PTAB, nor represent any additional alleged duplication of effort. This is especially true considering that the current Petitioner has stipulated to an understudy role, and has offered a *Sotera* stipulation. *Id.* at 11 ("We recognize that there is a trial in the related district court litigation which may occur before a Final Written Decision is issued in the Mylan IPR, but perceive limited prejudice to Patent Owner and little, if any, waste of Board resources in allowing Petitioner to join an ongoing inter partes review proceeding.").

Furthermore, although the Director's June 2022 Guidance Memorandum was recently rescinded, the Petitioners' *Sotera* stipulations referenced above nonetheless resolve the Fintiv analysis strongly against discretionary denial. *Guidance Memorandum dated March 24, 2025 from Chief Administrative Patent Judge Boalick*, at p. 2–3 ("a timely-filed *Sotera* stipulation . . . is highly relevant"). Ex. 1051.

Consideration of the individual *Fintiv* factors themselves do not lead to a different conclusion.

A. *Fintiv* Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

As acknowledged by Patent Owner, "[t]o date, no stay in the district court has been granted or requested." Patent Owner's Discretionary Denial Brief at 4. Thus, how the district court chooses to treat such a request should not be inferred. *Google LLC et al. v. Mullen Industries LLC*, IPR2025–00019, Paper 14 at 10 (P.T.A.B. May 12. 2025) ("Given that [Judge Gilstrap] denied Samsung's motion to stay 'WITHOUT PREJUDICE . . .', we decline to speculate whether the District Court will grant a stay"); *Apple Inc. v. Fintiv, Inc.,* IPR2020–00019, Paper 15 at 12 (P.T.A.B. May 13, 2020) (informative) ("*Fintiv* II") ("We decline to infer . . . how the District Court would rule should a stay be requested by the parties in the parallel case.)"; *Sand Revolution II LLC v. Continental Intermodal Grp.*, IPR2019–01393, Paper 24 at 7 (P.T.A.B. June 16, 2020) (". . . we will not attempt to predict

how the district court in the related district court litigation will proceed because the court may determine whether or not to stay any individual case, including the related one, based on a variety of circumstances and facts beyond our control and to which the Board is not privy."); *Dish Network L.L.C. v. Broadband iTV, Inc.,* IPR2020–01359, Paper 15 at 11 (P.T.A.B. Feb. 12, 2021) ("It would be improper to speculate, at this stage, what the Texas court might do regarding a motion to stay…"*)*.

Patent Owner argues for discretionary denial asserting that "the district court does not have a track record of granting stays ***prior to institution***." Patent Owner's Discretionary Denial Brief, Paper 12 at 4 (emphasis added). As noted above, this argument should be rejected because it is speculative. This argument is also circular – Patent Owner argues on the one hand that the Board/Director should not institute because a stay has not yet been granted, and on the other, that the district court will not grant a stay without institution.

Fintiv factor 1 does not favor discretionary denial.

B. *Fintiv* Factor 2: proximity of the court's trial date to the Board's projected statutory deadline for a final written decision

As noted above, the Board is already conducting a trial of the same claims on the same grounds challenged by the current petition in the Genius IPR. Moreover, as further explained below, Patent Owner has stipulated that ***it will no longer assert any of the challenged claims in the district court litigation***. Ex. 1054

(confirming that only claims 19-20 of the '697 patent will be pursued); Ex. 1055. This, coupled with the petitioners' *Sotera* stipulations (in both IPRs) eliminate or at least mitigate concerns related to overlap in the trial schedule and the risk of conflicting decisions between the related litigation and the current requested IPR joinder. Neither *NHK Spring* nor *Fintiv* involved a copycat petition of an already instituted IPR and a motion for joinder, where the petitioner would serve in an understudy role. *Sawai*, IPR2019–00789, Paper at 9–12 (after considering *NHK Spring* and the related district court proceeding, which was scheduled to go to trial before final written decision, the Board instituted the IPR and granted the joinder motion). Likewise, the current petitioner filed a copycat of an already instituted IPR petition along with a motion for joinder, and agreed to take an understudy role. Even if trial concludes first, the institution and joinder of the current petition to the Genius IPR will not burden the Board or prejudice Patent Owner, as the Genius IPR is already instituted.

Trial is currently scheduled for January 23, 2026, while a final written decision in the Genius IPR is due March 6, 2026 – a difference of ***6 weeks***, not two months as alleged by Patent Owner. In view of the proximity of the Board's expected Final Written Decision, this factor is at best neutral. *See e.g., Cisco Systems Inc., v. Video Solutions PTE. Ltd.,* IPR2024–00194, Paper 7 (P.T.A.B. March 28, 2024) ("Where, as here, the trial date and the date of our final written

decision are at or around the same time, this factor is neutral"); *Fintiv*, IPR2020–00019, Paper 11 at 9 ("[i]f the court's trial date is at or around the same time as the projected statutory deadline . . . , the decision whether to institute will likely implicate other factors . . .").

Patent Owner cites median time-to-trial trial statistics in the Eastern District of Texas of "721days." However, such median statistics are not reliable indicators in the present case, due in no small part to the Patent Owner's own litigation conduct. For example, in March 2024 Patent Owner added a fourth asserted patent to its complaint, in September 2024 it amended its infringement contentions to add new claims and accused products, and most recently, on the last possible day to amend its complaint (February 14, 2025), added new antitrust allegations:

> Plaintiff filed its initial Complaint in October 2023 asserting only patent claims. ECF 1. Plaintiff filed an Amended Complaint in March 2024, adding a fourth asserted patent. ECF 17. The parties engaged in dispositive motion practice (e.g., ECF 40, 57), began discovery (ECF 43, 45, 94, 103), ***twice sought and obtained leave to amend the Docket Control Order*** (ECF 70, 93), and supplemented the protective order (ECF 99). On August 8, 2024, Plaintiff sought leave to amend its infringement contentions to add 117 new claims and numerous additional accused products (ECF 42), which the Court granted on September 30, 2024 (ECF 61). ***As a result, the DCO was amended to provide additional time necessitated by plaintiff's***

> ***addition of new claims and accused products***. (ECF 61, 70; see also ECF 93.)
>
> Then, on February 14, 2025—the last day to amend under the DCO—Plaintiff filed a Second Amended Complaint ("SAC") adding extensive new antitrust allegations . . .

Ex. 2042, p. 3 (emphasis added).

As noted above, this has necessitated multiple changes in the schedule, including the most recent 10 week delay in the trial date. Ex. 2039, p. 1. Whether Patent Owner is finished with its attempts to pile-on in the district court litigation remains to be seen.

Moreover, the Board has found on several occasions that this factor is not outcome determinative, even when presented with a potential trial date that is much sooner than the deadline for issuing a final written decision. *Ericsson Inc. v. XR Communications LLC,* IPR2024–00868, Paper 8 at 29 (P.T.A.B. Dec. 13, 2024) (finding the proximity of the trial date "weigh against exercising our discretion to deny institution" when trail date trial was scheduled "less than five months before the Final Written Decision"). The Board has reached similar conclusions, ***even under the holistic approach adopted after rescission of the Director's June 2022 Fintiv Guidance Memorandum***. *Samsung Display Co., Ltd., v. Pictiva Displays Int'l Ltd.,* IPR2024–01222, Paper 12 at 9 (P.T.A.B. Mar. 6, 2025) (post-rescission) ("[o]n balance, after weighing the *Fintiv* factors, we decline to exercise our

discretion to deny institution," even when the expected trial date was seven months before the final written decision deadline); *see also Posco Co., Ltd., v. Arcelormittal,* IPR2024–01376, Paper 11 at 13–14, 17 (P.T.A.B. Mar. 18, 2025) (post-rescission) (declining to exercise discretionary denial despite a trial date five months earlier than the expected final written decision in light of other factors); *Palo Alto Networks, Inc. v. Croga Innovations Ltd.,* IPR2024–01421, Paper 8 at 11, 13–14 (P.T.A.B. Mar. 14, 2025) (post-rescission) (instituting trial despite an expected litigation trial date approximately five months prior to the deadline for issuing a final written decision citing, *inter alia*, the petitioner's proffered *Sotera* stipulation).

Furthermore, the currently scheduled trial date in the related litigation is far from certain. Judge Gilstrap's trial schedule is chronically overbooked. Apparently Judge Gilstrap currently has ***fourteen trials*** scheduled during the same time as the trial in the related litigation. Ex. 1052. It is of course impossible for Judge Gilstrap to preside over fourteen trials at the same time. Therefore, unless *all* of these matters settle, something has to give, and trials will need to be rescheduled.

Finally, as previously noted, whenever trial does occur, it will not have the same scope as that of the Genius IPR for the current petition. Namely, both the Genius IPR and the current petition challenge claims ***1–9*** of the '697 patent. However, the court has ordered that the Patent Owner shall assert "no more than

five asserted claims per patent." Ex. 1053, p.2. This final election of no more than five asserted claims is due in August 1, 2025. *Id*.; Ex. 2039, p. 5. Therefore, it will be impossible for trial to move forward with all nine challenged claims given the court's order. In fact, Patent Owner has already stipulated that it will ***no longer assert <u>any</u> of the claims challenged in the present IPR***. Ex. 1054; Ex. 1055. This fact also weighs *against* exercising discretionary denial according to *Fintiv* factor 2. *Samsung Bioepis Co. v. Regeneron Pharm., Inc.,* IPR2023–00739, Paper 9 at 58 (P.T.A.B. Oct. 20, 2023) ("Because the district court action does not include all of the challenged claims within the scope of the litigation, we find that Fintiv factors 2 and 3 favors institution.").

Fintiv factor 2 does not favor discretionary denial.

C. Fintiv Factor 3: investment in the parallel proceeding by the court and the parties

Again, this factor is irrelevant, or at least mitigated – the Genius IPR has already been instituted. The current petitioner seeks to join an ongoing IPR trial as an understudy that will proceed regardless of what events transpire in the parallel district court proceeding. *See Sawai*, IPR2019–00789, Paper 17 at 11. In this regard, it is noted that the Patent Owner's arguments focus on what may or may not have transpired in the district court prior to the institution date of the *current*

IPR petition; namely, by July 8, 2025[5]. However, these arguments are made in a vacuum. Petitioner seeks joinder of the current petition with IPR2024–01308 which was instituted on ***March 6, 2025***, and has stipulated to act as an understudy and adhere to the schedule of this ongoing IPR proceeding. Therefore, the relevant inquiry should be focused on any alleged duplication of effort by the IPR proceeding *to be joined*, and not that of the current petition.

Even considering the institution date of the current petition, the Board's expected institution decision is prior to any expected substantive orders being issued by the district court related to validity, with the possible exception of a claim construction ruling. *Fintiv,* IPR2020–00019*,* Paper 11 at 10 ("If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution . . . ."). Although a *Markman* hearing was held on May 9, 2025, to date no claim construction ruling has been issued by the court. It is unclear whether any such ruling will be issued prior to the July 8, 2025 institution deadline, and

[5] The Patent Owner incorrectly represents that the institution decision in this case is due "on or around August 20, 2025." Patent Owner's Discretionary Denial Brief, Paper 12, p.6. The institution decision in this case is due no later than **July 8, 2025**.

certainly has not issued prior to the March 6, 2025 institution date of the underlying Genius IPR.

Regardless of what claim construction issues may be addressed in the district court, there is currently no claim construction dispute that requires resolution in the current IPR proceedings. *Genius*, IPR2024–01308, Paper 9 at 12 (P.T.A.B. March 6, 2025) ("At this early stage, Petitioner's proposed constructions of 'socket' and 'event socket' (Pet. 37) are not disputed by Patent Owner. Prelim. Resp. 10. Neither party provides an express construction for any other claim term. *See generally* Pet.; Prelim. Resp. 'The Board is required to construe 'only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.'") (citations omitted). Thus, it is unclear at the present time whether the claim construction activities undertaken in the district court will have any bearing on the resolution of these proceedings.

Moreover, as acknowledged by Patent Owner, much remains to be done in the related litigation, including completion of fact and expert discovery. Patent Owner's Discretionary Denial Brief at 6; Ex. 2039, pp. 4–5 (deadline to complete expert witness discovery of October 10, 2025 and deadline to complete fact discovery of August 22, 2025). Thus, the court and parties have not yet invested sufficient time in the parallel proceeding. *See Samsung,* IPR2024–01222, Paper 12 at 7 (P.T.A.B. March 6, 2025) (finding this factor weighs against exercise of

discretionary denial, despite the fact that a *Markman* hearing had already been conducted, citing "much remains to be done, including expert discovery"); *Hulu, LLC v. SITO Mobile R&D IP, LLC*, IPR2021–00298, Paper 11 at 12–13 (P.T.A.B. May 19, 2021) (finding factor 3 favors institution of trial even after issuance of a Markman ruling citing, *inter alia*, incomplete fact and expert discovery, as well as future dispositive and *Daubert* motion deadlines).

Petitioners' proffered *Sotera* stipulations in both the now-instituted Genius IPR as well as the current proceeding mitigate if not eliminate redundancy of efforts undertaken by the district court. Patent Owner argues that "while Petitioner proffers a *Sotera* stipulation, by the time of the Board's institution decision, the parties will have already expended resources to litigate validity of the challenged patent through opening expert reports." Patent Owner's Discretionary Denial Brief at 6. This is inaccurate. According to the court's current docket control order, expert reports are not due until August 29, 2025. Ex. 2039, p.5. This is not until well *after* the deadline for issuing an institution decision in this case of July 8, 2025.

Finally, as noted above in the discussion of *Fintiv* factor 2, whatever trial is undertaken by the district court will not be of the same scope as that of the Genius IPR or the current petition. Namely, both the Genius IPR and the current petition challenge claims 1 – 9 of the '697 patent. However, the court has ordered that the

Patent Owner shall assert "no more than five asserted claims per patent." Ex. 1053 p.2. Patent Owner has already stipulated that it will not pursue ***any*** of these challenged claims in the district court litigation. Ex.1054; Ex.1055. This fact also weighs *against* exercising discretionary denial according to *Fintiv* factor 3. *Samsung,* IPR2023–00739, Paper 9 at 58 (P.T.A.B. Oct. 20, 2023) ("Because the district court action does not include all of the challenged claims within the scope of the litigation, we find that Fintiv factors 2 and 3 favors institution.").

Fintiv factor 3 does not favor discretionary denial.

D. *Fintiv* Factor 4: overlap between issues raised in the petition and in the parallel proceeding

As previously noted herein, the Board is already conducting a trial of the same claims on the same grounds challenged by the current petition in the Genius IPR. Granting the copycat Petition and joining it to the Genius IPR represents no duplication of effort. Also, Patent Owner has stipulated that it will not pursue ***any*** of the challenged claims in the district court litigation.

Further, given the Petitioner's *Sotera* stipulation, concerns related to overlap with the related litigation are mitigated if not rendered irrelevant. Recent panels have found that a stipulation commensurate with the stipulation Petitioner has provided in this case strongly favors institution ***under the holistic approach taken after rescission of the Director's June 2022 Fintiv Guidance Memorandum***. *Palo*

Alto Networks, IPR2024–01421, Paper 8 at 12 (P.T.A.B. Mar. 14, 2025) ("A broad stipulation by a petitioner to not pursue in a parallel district court proceeding any ground raised or that could have been reasonably raised in its *inter partes* review petition mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions."); *Samsung Elecs. Co. v. Headwater Rsch. LLC*, IPR2024–01407, Paper 9 at 8 (P.T.A.B. Mar. 20, 2025) ("Based on Petitioner's stipulation, we determine there would be no overlap between issues raised in the Petition and in the parallel proceeding, thereby saving the resources of the district court. *Fintiv* factor 4, therefore, weighs strongly against exercising our discretion to deny institution"); *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024–01433, Paper 13 at 12 (P.T.A.B. Apr. 7, 2025) ("In light of the stipulation and nature of the asserted ground...this [factor] strongly favors institution."); *Google*, IPR2025–00019, Paper 14 at 12 ("We find that Petitioner's stipulation mitigates some, but not all of the concerns of overlap, and weighs against exercising discretionary denial.").

Factor 4 also strongly favors institution because it will only be possible for Patent Owner to pursue a subset of challenged claims of the '697 patent in district court. Namely, the current Petition challenges claims 1–9 of the '697 patent, however, the court has ordered that the Patent Owner shall assert "no more than five asserted claims per patent." Ex. 1053, p.2. Patent Owner has already stipulated

that it will not pursue ***any*** of the challenged claims in the district court litigation. Ex.1054; Ex.1055. Thus, this proceeding addresses issues that will not be resolved in district court, favoring institution. The number of asserted claims may be even further reduced before trial according to the case docket control order. Ex, 2039, p.2 (requiring "final election of Asserted Claims" 10 days before jury selection). Therefore, in addition to avoiding duplicative challenges based on the same grounds, the claims at issue in this proceeding will not be coextensive with those challenged in district court. *See Hanwha Sols. Corp. v. Maxeon Solar PTE. LTD.*, IPR2024–01203, Paper 17–19 (P.T.A.B. Feb. 26, 2025) (weighing factor 4 against denial where Petitioner challenged more claims in the IPR than in district court and noting that "some overlap of issues may exist" but "complete overlap does not exist" and that resolving the district court case will not address all challenged claims).

Fintiv factor 4 weighs strongly in favor of institution.

E. *Fintiv* Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same party

This factor is not relevant – Petitioner seeks joinder as an understudy. Moreover, *Fintiv* did not suggest Factor 5 *favors denial* when the petitioner and the defendant in the parallel proceeding are the same. *Fintiv*, IPR2020–00019, Paper 11 at 13–14 ("If a petitioner is *unrelated* to a defendant in an earlier court proceeding, the Board has weighed this fact ***against exercising discretion to deny***

institution under NHK") (emphasis added). Petitioner is also a defendant in the related litigation, as is true of most petitioners and IPR proceedings.

Fintiv factor 5 does not favor discretionary denial.

F. *Fintiv* Factor 6: other circumstances that impact the Board's exercise of discretion, including the merits

This factor weighs heavily in favor of institution. The current Petition is substantively identical to the instituted Genius IPR petition. *Google*, IPR2025–00019, Paper 14 at 12–13 ("The issues raised by Petitioner are similar, if not identical, to those raised in IPR2023–00091, which we instituted . . . we find that the merits are strong . . . [t]his factor weighs against exercising discretionary denial.").

Patent Owner argues "as detailed in Patent Owner's Preliminary Response (Paper 10), Petitioner fails to show a 'reasonable likelihood' that Petitioner would prevail on any challenged claim." Patent Owner's Discretionary Denial Brief at 8. However, Patent Owner neglects to mention that it presented the same arguments in its Preliminary Response filed in the Genius IPR[6]. The Board already considered

[6] The only substantive differences appear to be: (i) on p. 67 of the current Preliminary Response, different emails were cited, and (ii) on p. 70, a portion of Exhibit 2013 included in the Genius IPR Preliminary Response was omitted. Neither of these differences move the needle on Patent Owner's deficient secondary considerations arguments.

those arguments and found them to be unpersuasive in its Institution Decision dated March 6, 2025, issued long before the filing of the Patent Owner's Discretionary Denial Brief on April 25, 2025. *Genius*, IPR2024–01308, Paper 9, Institution Decision. As confirmed by the Board in the underlying Genius IPR, the current petition establishes that *multiple asserted grounds* demonstrate that each and every element of one or more of the challenged claims is found in the cited prior art references, that it would have been obvious to have combined those references in the manner proposed with ample motivation, and a person of ordinary skill in the art would have had a reasonable expectation of success when making the proposed modifications. *Id*. at 50, 59–60. The Board further confirmed that Patent Owner's secondary considerations arguments are inadequate and fail to establish a nexus between a commercial product and the claimed invention. *Id*. at 27–29.

Fintiv factor 6 weighs strongly in favor of institution.

III. *GENERAL PLASTIC* DOES NOT WARRANT DISCRETIONARY DENIAL

A. Patent Owner Abandoned its *General Plastic* Discretionary Denial Arguments

Patent Owner argued that institution should be denied under *General Plastic* in its opposition to Petitioner's Motion for Joinder. Patent Owner Opposition to Petitioner's Motion for Joinder, Paper 11 at 12–13. However, Patent Owner has

apparently abandoned those arguments with respect to its basis for requesting discretionary denial by the Director, as these arguments are no longer asserted in their Discretionary Denial Brief.

Based on recent guidance issued by the USPTO, it is Petitioner's understanding that any basis relied upon by Patent Owner to assert that the exercise of discretionary denial by the Director is appropriate should be included in their discretionary denial briefing. *FAQs for Interim Processes for PTAB Workload Management*, Ex. 1056, pp. 3–4 (Question 20: "Parties are encouraged to address any fact or circumstance they believe bears on whether the Office should or should not institute trial"; Question 22: "If a patent owner wishes to raise any applicable bases for discretionary denial, it must do so in a discretionary denial brief."; Question 23: "If a patent owner would like the Office to consider discretionary denial arguments, it must file a discretionary denial brief and address such issues in that brief").

Further, motions for joinder will be decided by a merits panel, and that the merits panel will not address discretionary considerations, except for those related to insufficient number of challenges meeting the threshold requirement and the inefficient use of resources. *Id*. at 2–3 (Question 9: "the Board panel will not address discretionary considerations, except where the petition presents an insufficient number of challenges that meet the reasonable likelihood standard

indicating that institution is an inefficient use of resources"; Question 12: "Once the Director determines that discretionary denial is not appropriate, the Board panel will not consider papers filed by parties relating to discretionary considerations"; Question 15: "A decision on whether to grant a joinder motion and join a party to an instituted proceeding will be decided by a Board merits panel").

In other words, the Director will not consider Joinder Motion briefing when deciding whether or not to exercise discretionary denial, and if the Director determines that the exercise of discretionary denial is not appropriate, the merits panel will not consider Patent Owner's discretionary denial arguments contained in the Joinder Motion briefing. Thus, the *General Plastic* arguments contained *only* in Patent Owner's Opposition to the Motion for Joinder are unavailing and not properly presented for consideration by the Director, or the merits panel, according to the new bifurcated procedure.

B. *General Plastic* Does Apply to the Facts of this Case

Even if the Director or the merits panel were to consider Patent Owner's *General Plastic* arguments, they clearly lack merit. The present petition is not a "follow-on" petition under *General Plastic*, but rather a copycat or me-too petition filed for purposes of preserving the petitioner's rights in the event that the original petitioner withdraws from the underlying IPR. *Sawai,* IPR2019–00789, Paper 17

at 10–11 (considering Patent Owner's General Plastic arguments and finding "Patent Owner's arguments in favor of discretionary denial do not persuade us that there is abuse of process where, as here, a different petitioner files a 'me-too' or 'copycat' petition in conjunction with a timely motion to join an inter partes review based upon the (essentially) copied petition filed by different petitioner."); *Amazon.com, Inc. v. Jawbone Innov., LLC*, IPR2023–00284, Paper 12 at 9 (P.T.A.B. May 15, 2023) ("[T]he *General Plastic* factors do not apply here because, unlike the *Uniloc* case, the instant petition is Petitioner's first petition, it is timely filed before the 1-year bar date, and it is merely a 'me too' petition that presents identical grounds and arguments as in the Google IPR."); *LG Elecs., Inc. v. Gesture Tech. Partners, LLC,* IPR2022–00092, Paper 8 at 5–6 (P.T.A.B. May 9, 2022) (the Board distinguishing the facts of *Apple v. Uniloc* and declining to apply the General Plastic factors); *Cent. Sec. Grp. – Nationwide, Inc. v. Ubiquitous Connectivity, LP,* IPR2019–01609, Paper 11 at 8 (P.T.A.B. February 26, 2020) ("[T]the *General Plastic* factors are not particularly relevant "where a different petitioner files a 'me-too' or 'copycat' petition in conjunction with a timely motion to join.") (citation omitted).

Petitioner acknowledges that, in limited circumstances, the Board has applied *General Plastic* in situations involving successive petitions filed by

different petitioners.[7] *Valve Corp. v. Elec. Scripting Prods., Inc.,* IPR2019–00062, Paper 11 at 2, 9–10 (P.T.A.B. Apr. 2, 2019) (precedential). However, *Valve* explains that application of g*eneral Plastic* in such situations is appropriate ***if*** the two petitioners have a "significant relationship" with each other. *Id*. at 9–10. The current Petitioner and the petitioner in the Genius IPR are not real parties-in-interest or privies, and have not been shown as having a "significant relationship." Patent Owner fails to even allege otherwise. *Videndum Production Solutions, Inc., v. Rotolight Ltd.*, IPR2023–01218, Paper No. 12 at 6 (P.T.A.B. Apr. 19, 2024) ("I determine that where, as here, the first and second petitioners are neither the same party, nor possess a significant relationship under *Valve, General Plastic* factor one necessarily outweighs the other *General Plastic* factors."). Therefore, *General Plastic* does not support the exercise of discretionary denial in this case.

C. Application of the General Plastic Factors Make Clear that the Exercise of Discretionary Denial is Unsupported

As noted above, at a minimum, the Director's holding in *Videndum* dictates that under the facts of the present case *General Plastic* factor 1 is resolved in the favor of Petitioner, and that this necessarily outweighs the other *General Plastic* factors. Even one were to consider each individual factor, this would not lead to a different result.

[7] Also, see the discussion of Factor 8 *infra*.

1. *General Plastic* Factor 1: whether the same petitioner previously filed a petition directed to the same claims of the same patent

As noted above, the current Petitioner and the petitioner in the Genius IPR are not the same party, nor do they have a significant relationship. Patent Owner admits as much. Patent Owner Opposition to Petitioner's Motion for Joinder, Paper 11 at 13. Application of this factor clearly, and overwhelmingly, favors institution. *Videndum*, IPR2023–01218, Paper No. 12 at 6.

2. *General Plastic* Factor 2: whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it

The petitioners are not the same party. This factor also is not relevant to the facts of this case. This is admitted by Patent Owner. Patent Owner Opposition to Petitioner's Motion for Joinder, Paper 11 at 13. The current Petition is a copycat petition which, by its nature, asserts the same prior art asserted in the first petition. This is clearly not a situation where the current petitioner held prior art in reserve in order to assert it in a later-filed second petition. This factor favors institution. *Amazon*, IPR2023–00284, Paper 12 at 10 ("Factors 2, 4, and 5 are designed 'to assess and weigh whether a petitioner should have or could have raised the new challenges earlier.'") (citation omitted).

3. *General Plastic* Factor 3: whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received

the Board's decision on whether to institute review in the first petition

This factor also is not relevant because the petitioners are not the same party. Patent Owner admits this. Patent Owner Opposition to Petitioner's Motion for Joinder, Paper 11 at 13. This is a copycat petition relying on the same references and same substantive arguments as the underlying Genius IPR petition. Clearly, no attempt has been made to "roadmap" the subsequent petition based on the contents of the preliminary response or institution decision. This factor favors institution. *Amazon*, IPR2023–00284, Paper 12 at 10.

4. *General Plastic* Factor 4: the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition

This factor favors institution for at least the same reasons discussed above in connection with factor 3. Patent Owner also acknowledges that this factor is not relevant. Patent Owner Opposition to Petitioner's Motion for Joinder, Paper 11 at 13. This factor favors institution. *Id*.

5. *General Plastic* Factor 5: whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent

This factor is likewise inapplicable. This is the first petition filed by the current Petitioner directed to the '697 patent. A companion copycat petition was filed on the same day, but directed to *different claims* of the '697 patent. This

factor favors institution. *Amazon*, IPR2023–00284, Paper 12 at 10 ("Petitioner is 'not raising new challenges but merely presents the same challenges that previously resulted in institution, and Petitioner acted within the time frame set forth under our Rules.' Reply 4. We agree with Petitioner.").

6. *General Plastic* Factor 6: the finite resources of the Board

Factor 6 does not support discretionary denial because granting the current Petition and joining it to the existing Genius IPR, where Petitioner stipulates to undertake a true understudy role, will not serve to further increase the workload of the PTAB or further the Patent Owner.

With respect to this factor, Patent Owner argues:

> Furthermore, notwithstanding Petitioner's understudy role, Petitioner would be able to continue the proceeding that would otherwise be terminated after settlement with the primary petitioner. As the Board noted, this possibility is relevant to Factor 6. *See T-Mobile USA, Inc. v. VoIP-Pal.com, Inc.,* IPR2023-00638, Paper 11 at 11-13 (PTAB, July 28, 2023); *Apple Inc. v. Uniloc 2017 LLC,* IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020). Accordingly, Factor 6 weighs against joinder as well.

Patent Owner Opposition to Petitioner's Motion for Joinder, Paper 11 at 14.

Once again, Patent Owner disregards critical facts and misapplies the Board's precedent. *T-Mobile* involved situation where (i) the copycat petition filed by the petitioner was the *second* petition filed, subsequent to *a failed first petition*; and (ii) the underlying proceeding to which petitioner sought to join was *already settled*, and the parties had already moved to terminate them. *T-Mobile*, IPR2023–00638, Paper 11 at 4. *Apple* also involved a situation where the copycat petition filed by the petitioner was the second petition filed, subsequent to a failed first petition. *Apple,* IPR2020–00854, Paper 9 at 6. Neither of those facts are present in the current case. This is ***not*** Petitioner's second attempt after a failed first attempt, and is not seeking an "end around" a first failed attempt by utilizing the joinder procedure. There has been no settlement with the petitioner of the Genius IPR, and whether any such settlement will occur in the future is nothing more than a matter of pure speculation at this point.

These divergent facts were pivotal in the Board's analysis of the *General Plastic* factors, including factor six. *T-Mobile*, IPR2023–00638, Paper 11 at 12 ("We agree with Patent Owner that . . . [j]oinder in this circumstance would allow Petitioner to continue the proceedings, even ***after settlement*** with the primary petitioner, based on a ***second attempt*** by Petitioner") (emphasis added); *Apple,* IPR2020–00854, Paper 9 at 12 ("we agree with Patent Owner that ***because this is Apple's second petition***, should Microsoft settle, Apple would stand in to continue

a proceeding that would otherwise be terminated. Joinder in this circumstance would allow Apple to continue a proceeding, even after settlement with the primary petitioner, ***based on a second attempt by Apple***.") (emphasis added). The decisions cited by Patent Owner does not support its arguments.

Furthermore, even assuming *arguendo* that the petitioner in the Genius IPR and Patent Owner were to settle, this would not result in any undue burden on either the Patent Owner or the PTAB. The statute contemplates, and controlling authority recognizes, completion of IPR proceedings by the Board ***even after settlement***. 35 U.S.C. § 317(a) ("If no petitioner remains in the inter partes review, the Office may terminate the review *or proceed to a final written decision*"); *Polaris Innovations Ltd. v. Brent,* 48 F.4th 1365 (Fed. Cir. 2022) ("the statute grants discretion to the Board to 'proceed to a final written decision under section 318(a)' ***even if 'no petitioner remains' in the proceeding***.") (citations omitted; emphasis added). Once joined, this case would assume the schedule of the Genius IPR, with the current Petitioner playing an understudy role.

Congress created *inter partes* review proceedings as an alternative forum for adjudicating the validity of a granted patent, as an alternative to district court litigation. Carrying out its statutorily directed mission is not a "burden" on the PTAB. *General Plastic* factor 6 favors institution.

7. *General Plastic* Factor 7: the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review

Factor 7 does not favor discretionary denial because Petitioner explicitly stipulated ". . . to be bound by the Scheduling Order Issued in IPR2024–01308." Motion for Joinder, Paper 9, p. 9. Granting the Motion for Joinder will in no way affect the Board's ability to meet the statutory deadline to render a final written decision. This factor favors institution.

8. *Shenzhen Silver Star* factor: the extent to which the petitioner and any prior petitioner(s) were similarly situated defendants or otherwise realized a similar-in-time hazard regarding the challenged patent

Patent Owner cites *Shenzhen Silver Star*[8] in support of its discretionary denial arguments. Patent Owner's arguments lack merit, and once again misapply the precedent of this Board. Patent Owner Opposition to Petitioner's Motion for Joinder, Paper 11 at 14–15.

Shenzhen Silver Star did not involve the filing of a copycat or me-too petition and a Motion for Joinder. There has clearly been no road mapping of the arguments and prior art cited current Petition based on contents of a prior preliminary response or institution decision in the Genius IPR, and no attempt to

[8] *Shenzhen Silver Star Intelligent Tech. v. iRobot Corp.*, IPR2018–00761, Paper 15 (P.T.A.B. Sept. 5, 2018)

"strategically stage" the prior art and arguments presented in the current Petition, contrary to the fact pattern in *Shenzhen Silver Star*. *Id*. at 10–12.

Patent Owner argues:

> Petitioner waited more than 3 months after Genius' filing of IPR2025-01308 to file its own petition and waited more than 6 months to file this joinder motion. This suggests an attempt to secure tactical advantage . . .

Patent Owner Opposition to Petitioner's Motion for Joinder, Paper 11 at 15.

First, Patent Owner provides no citation to authority for the proposition that a gap of three months between the filing of an original petition and a copycat petition is somehow excessive. Patent Owner also fails to explain what possible prejudice could be caused by the timing of the filing of the current petition coupled with a motion for joinder. The statute requires that a petition for *inter partes* review be filed within one year from the date of service of a complaint involving the challenged patent. 35 U.S.C. § 315(b). Petitioner has met this requirement for filing its petition.

Second, 37 C.F.R. § 42.122(b) requires that a motion for joinder be filed "no later than one month after the institution date of any *inter partes* review for which joinder is requested." Here the Genius IPR was instituted on March 6, 2025, and Petitioner promptly filed his motion for joinder on March 14, 2025. Pursuant to 35 U.S.C. § 315(c), ***"[i]f the Director institutes an inter partes review***, the Director,

in his or her discretion, may join as a party to that inter partes review." Thus, a prerequisite for joinder is the institution of the underlying IPR. Thus, there is absolutely nothing unreasonable about waiting for the underlying IPR to be instituted *before* filing a motion for joinder, or even before filing a petition for that matter.

Third, tellingly, Patent Owner fails to explain precisely what "tactical advantage" Petitioner achieved by the filing of its copycat petition and motion for joinder when it did.

Fourth, Patent Owner's reasoning could be extended to essentially any IPR petition and motion for joinder, even when filed in full compliance with the authorizing statutes and the rules. Patent Owner does not explain why the Director should ignore these governing statutes and rules expressly sanctioning joinder, and decline to institute the current Petition. The Director should respectfully decline the Patent Owner's invitation to do so. *LG Elecs.*, IPR2022–00092, Paper 8 at 6.

IV. PATENT OWNER'S "ADDITIONAL FACTORS" ARGUMENTS DO NOT WARRANT DISCRETIONARY DENIAL

Patent Owner cites the Stewart Memo[9] in support of its arguments that the Director should exercise discretionary denial because of Petitioner's "heavy reliance" on expert witness testimony, and alleged "anticompetitive" conduct on

[9] Ex. 2004.

part of the Petitioner. However, the Stewart Memo provides no indication as to what constitutes "heavy reliance" on expert witness testimony, and contains no mention whatsoever of alleged and unproven "anticompetitive" conduct as being a form of compelling economic interest supporting a request for the exercise of discretionary denial.

The Stewart Memo states that these additional factors are "consistent with the discretionary considerations enumerated in Board precedent." Ex. 2004 at 2. The only precedent cited as supporting reliance on these factors is *Fintiv*, *General Plastic* and *Advanced Bionics*[10]. However, none of these cases mention the alleged "heavy reliance" on expert witness testimony, or a compelling economic interest, as a basis for the exercise of discretionary denial.

The Stewart Memo also references the Consolidated Trial Practice Guide – November 2019 ("Trial Practice Guide") as being consistent with the consideration of the above-mentioned factors. Likewise, the Trial Practice Guide also does not

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

identify "heavy reliance" on expert witness testimony or compelling economic interests as a basis for the exercise of discretionary denial.

A. Reliance on Expert Testimony is Appropriate in This Case

Patent Owner's argument that the Petition's reliance on expert witness testimony justifies the exercise of discretionary denial disregards a critical fact – the current petition and expert testimony is substantively the same as the petition and expert testimony of record in the Genius IPR, which has already been instituted over the objections of Patent Owner. In other words, the Board has already at least preliminarily determined that the same argument and expert witness evidence at issue in the present case has merit, and Patent Owner's objections and rebuttal evidence do not defeat a *prima facie* showing.

1. Reliance upon Expert Witness Evidence is Sanctioned by Statute and PTAB Practice Norms and Guidance

The use of expert witness testimonial evidence by petitioners in these proceedings is expressly contemplated by statute: "[a] petition filed under section 311 may be considered ***only if*** . . . the petition identifies . . . the ***evidence that supports the grounds*** for the challenge to each claim, including . . . ***affidavits or declarations of supporting evidence*** and opinions, if the petitioner relies on ***expert opinions***" 35 U.S.C. § 312(a) (emphasis added).

The Board has long recognized the useful role of expert testimony in explaining complex technologies and how a person of ordinary skill in the art

would understand them, among other purposes. Trial Practice Guide, at 34–36. This is particularly true under 35 U.S.C. § 103, which necessarily considers whether "the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains."

2. There Has Been No Inappropriate Reliance on Expert Witness Testimony

Patent Owner argues that "the ***Board*** relied heavily on Petitioner's expert testimony, stating '[w]e, therefore, give [Patent Owner's expert]'s testimony less weight than [Petitioner expert]'s testimony at this preliminary stage. (IPR2024–01308, Paper 9, 49)'." Patent Owner's Discretionary Denial Brief, Paper 12 at 9 (emphasis added). Respectfully, the preliminary determination made by the Board that the Petitioner's evidence relied upon to support the petition is superior to the evidence relied upon by Patent Owner in its opposition thereto is not a reason to deny institution – it is a fact *supporting* institution pursuant to *Fintiv* factor 6.

As an initial matter, the *Board* has broad discretion to consider and weigh expert witness testimony when reaching its determinations. *Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010). Therefore, criticizing the *Board's* reliance on expert witness testimony is not a valid basis for the exercise of discretionary denial.

The Trial Practice Guide provides the following nonlimiting examples of circumstances where expert testimony may be offered to assist the PTAB:

(i) ***explain the relevant technology***;

(ii) ***establish the level of skill in the art*** and describe the POSITA;

(iii) ***explain the teachings of the prior art and how they relate to the patent's claims***;

(iv) address whether a POSITA would have found a ***reason to modify the prior art*** and, if so, whether there would have been ***a reasonable expectation of success***;

(v) explain how evidence of objective indicia of non-obviousness should be weighed against evidence of unpatentability; and

(vi) explain the nature and import of such objective indicia.

Trial Practice Guide at 34–35 (added).

The expert declaration in this case (Ex. 1001) is provided exactly for the purposes enumerated above and specified by the Trial Practice Guide. It supports the strength of the Petition because it provides detailed explanations of the presence of each limitation in the prior art and why a person of ordinary skill in the art would have found the prior art obvious to combine, including extensive citations to the prior art references themselves in support of this testimony.

The presence of all of the limitations recited in the claims has been shown to be present from the teachings of the prior art references themselves. The Petitioner does not solely rely on expert witness testimony to establish the presence of any of the claim limitations.

Patent Owner first argues that:

> [T]he Board's finding that the 'live data access server 130 is optional' is based solely on a footnote citing Petitioner's expert declaration. (IPR2024-01308, Paper 9, 46.). The Board also concluded that 'Spivey teaches or at least suggests that the firewall is optional' again based on the same footnote citing Petitioner's expert declaration. (IPR2024-01308, Paper 9, 46.).

Patent Owner's Discretionary Denial Brief, Paper 12 at 9.

This is simply not true. The Board in the Genius IPR Institution Decision referenced the disclosure of the Spivey reference extensively in support of its finding of fact with regard to the teachings of that reference with respect to the optional nature of both the live access data server 130 and the firewall. For example, the Board found:

> Based on the preliminary record, we also find that Petitioner's arguments and Dr. Wicker's testimony that live data access server 130 is optional ***are supported by Spivey***. For example, ***Spivey discloses*** that 'system 100 *may* include a live data access server 130.' ***Id. ¶ 38*** (emphasis added) (cited in Pet. 38 n.7). Live data access server is described as 'a public

> interface.' ***Id***. Furthermore, based on the preliminary record at this early juncture, we find that ***Spivey's disclosure*** that '[i]n some embodiments,' message queue server is not accessible to clients 'directly' because it is, for example, 'behind a firewall' supports that Spivey teaches or at least suggests that the firewall is optional. ***Id. ¶ 36*** (cited in Pet. 37 n.7).

Genius, IPR2024–01308, Paper 9 at 46 (emphasis added).

It should be noted that the abbreviated citation in the quote above ("*Id*.") refers to citations to the previously cited Exhibit 1017 – the Spivey reference. The Board's findings in this regard are clearly based upon the teachings of the prior art references themselves, and not solely upon Petitioner's expert witness testimony.

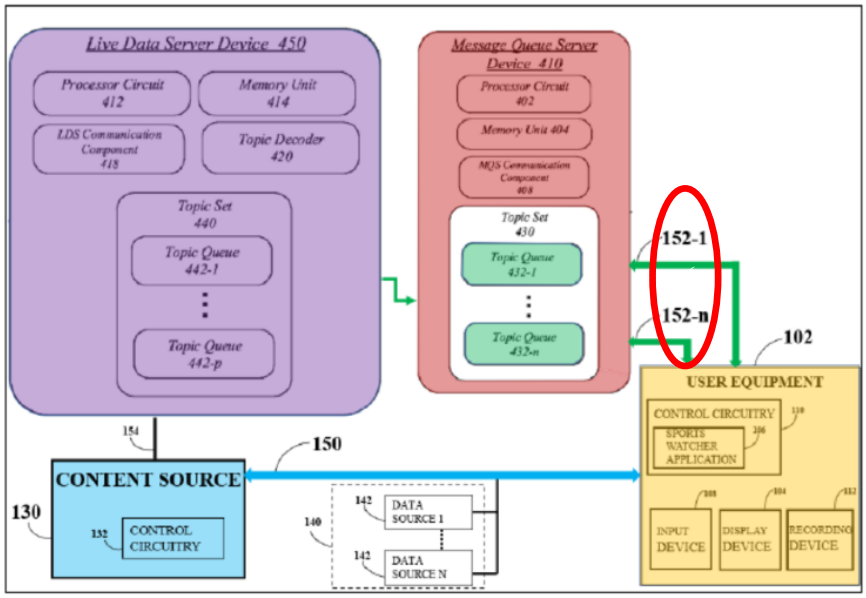
Next, Patent Owner argues:

> Another example of Petitioner's dependence on extrinsic testimony is its reliance on an entirely expert-created figure. This figure depicts an amalgamation of disparate prior art systems and fabricated components, purporting to represent a make-believe combined system that allegedly invalidates the claimed invention . . . The Board accepted and relied on 'Petitioner's annotated diagram' in instituting the Genius IPR. (IPR2024-01308, Paper 9, 42.) However, as illustrated in the figure, the '151-1'[**sic: 152-1**] and '151-2' [**sic: 152-n**] ***connections are entirely fictional creations*** by Petitioner's expert and ***do not originate from intrinsic evidence*** (Petition, 24.)

Patent Owner's Discretionary Denial Brief, Paper 12 at 9 (emphasis added).

These assertions are also demonstrably false.

The diagram in question is reproduced below (further annotated with a red circle):



This diagram is admittedly a graphical representation of the verbal description of the combined teachings of the combined prior art references themselves.

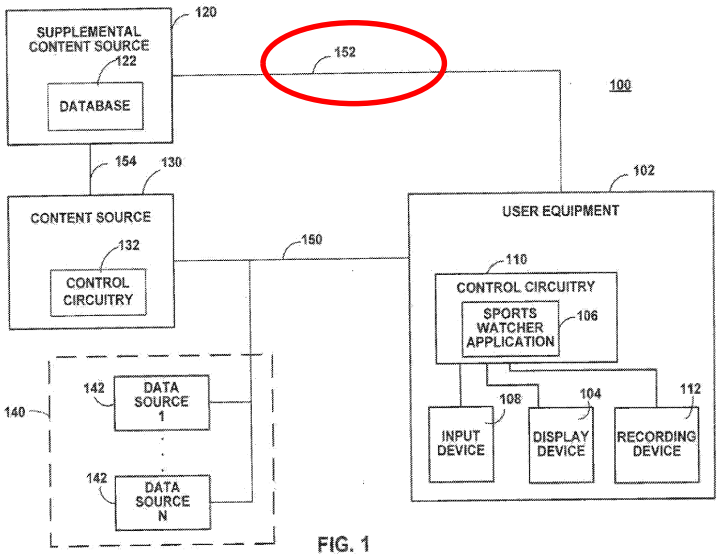
As correctly noted in the Board's institution decision in the Genius IPR, the contents of this diagram are based, at least in part on the combination of elements contained in Ellis' Figure 1 and Spivey's Figure 4:

> As can be seen from Petitioner's annotated, combined diagram of Ellis's Figure 1 and Spivey's Figure 4, in Petitioner's proposed combination, topic queues 432-1 through

> 432-n are connected to user equipment 102 via communication paths 152-1 through 152-n. Pet. 19.

Genius, IPR2024–01308, Paper 9 at 41.

Figure 1 of Ellis is reproduced below (annotated with a red circle):



Ex. 1016.

As evident from the above, Ellis discloses and teaches the formation of a connection (152) between a database comprising a supplemental content source and user equipment.

Furthermore, as correctly noted by the Board in the Genius IPR institution decision, for example:

> Petitioner also points to ***Spivey's disclosure*** of pushing data from topic queues and Ellis's disclosure of providing real-time sports scores. *Id.* (citing Ex. 1017 ¶ ***46***; Ex. 1016 ¶ ***41***; Ex. 1001 ¶ 565).

Genius, IPR2024–01308, Paper 9 at 41 (emphasis added).

The cited disclosures of both Spivey and Ellis expressly teach pushing data ***from a plurality of topic cues to subscribers or users***. Ex. 1017, ¶ 46 ("MQS communication component 308 may also. . . push data ***from topic queues*** 332-1, 332-n ***to the subscribers*** of the topics corresponding to those topic queues"); Ex. 1016, ¶ 41 ("***Each data feed may be individually accessed*** or subscribed to ***by user equipment 102***") (emphasis added).

Thus, the examples cited above clearly demonstrate that the contents of the diagram and Petitioner's arguments related thereto are derived from the teachings of the prior art references themselves and are not some sort of "fabrication" out of thin air. Petitioner's expert has properly opined on the manner in which the teachings of the prior art references would have been combined by a person having ordinary skill in the art, using the above-mentioned diagram as a visual aid in conveying these opinions. This is not improper reliance on expert witness testimony as alleged by Patent Owner.

More generally, the Board attributed more weight to Petitioner's expert in the Genius IPR because petitioner's expert (Dr. Wicker) testimony was *supported by the evidence of record*:

> After weighing the testimony of Dr. Wicker and Dr. Rubin, based on the preliminary record, we find Dr. Wicker's

> testimony ***to be supported by the evidence of record*** and we, therefore, give Dr. Wicker's testimony more weight.

Genius, IPR2024–01308, Paper 9 at 44–45 (emphasis added).

Patent Owner fails to provide one valid example where the Petitioner has relied upon expert witness testimony to provide a single claim limitation otherwise not found in the prior art. Thus, Patent Owner's arguments are unavailing. *See Advanced Micro Devices Inc. v. Realtek Semiconductor Corp*., IPR2023–00789, Paper 9 at 39 (P.T.A.B. Oct. 26, 2023) (finding Petitioner's citation of prior art and argument constituting sufficient support and rejecting Patent Owner's assertions of improper gap filling with expert testimony).

B. No Compelling Economic Interests Justify the Exercise of Discretionary Denial

First, Patent Owner's meritless and belated claims around alleged unproven and belated "anticompetitive" conduct are part of a transparent litigation tactic intended to gain leverage in the corresponding district court litigation. Petitioner has moved for dismissal of these meritless claims. Ex. 1057.

Second, the Stewart Memo never identifies alleged und unproven "anticompetitive" behavior as a "compelling economic interest" warranting exercise of discretionary denial. Patent Owner cites absolutely no authority establishing otherwise.

Third, respectfully, the Director is not in a position to adjudicate Patent Owner's heavily disputed, unproven and meritless antitrust law-based claims. *See Id*.

V. CONCLUSION

For the reasons explained herein, discretionary denial of the current petition, which is a copycat of a petition that has already been instituted with trial well underway, is inappropriate. Considering that the Petitioner has proffered a *Sotera* stipulation, has stipulated to taken understudy role in any instituted IPR, and has stipulated to adhere to the schedule of the Genius IPR, under the facts presented here, the concerns that *Fintiv*, *General Plastic* and the March 26, 2025 Stewart Memorandum are clearly not implicated. It is respectfully requested that the Director refer this case to a panel of the Board for consideration on the merits.

Date: May 23, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

This Petitioner's Opposition to Request for Discretionary Denial complies with the type–volume limitations as mandated in 37 C.F.R. §42.24 and the memorandum entitled Interim Processes for PTAB Workload Management dated March 26, 2025. According to the word processing system used to prepare this document, the brief contains 9,637 (14,000 limit) words.

Date: May 23, 2025

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CERTIFICATE OF SERVICE

In compliance with 37 C.F.R. § 42.6(e), the undersigned hereby certifies that a copy of the foregoing Petitioner's Opposition to Request for Discretionary Denial was served by email correspondence on the following correspondence email addresses of record for Patent Owner:

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Date: May 23, 2025

Respectfully submitted,

/Teresa C. Rodriguez/
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TABLE OF EXHIBITS

Exhibit No.	Description
Exhibit 1001	Declaration of Dr. Omid Kia, Ph.D.
Exhibit 1002	*Curriculum Vitae* of Dr. Omid Kia, Ph.D.
Exhibit 1003	U.S. Patent No. 10,805,687
Exhibit 1004	Claim Listing of U.S. Patent No. 10,805,687
Exhibit 1005	Reserved
Exhibit 1006	U.S. Patent No. 10,425,697
Exhibit 1007	Claim Listing of U.S. Patent No. 10,425,697
Exhibit 1008	Certified File History of U.S. Patent No. 10,425,697
Exhibit 1009	U.S. Patent No. 11,039,218
Exhibit 1010	Claim Listing of U.S. Patent No. 11,039,218
Exhibit 1011	Reserved
Exhibit 1012	U.S. Patent No. 11,871,088
Exhibit 1013	Director Vidal Memorandum re: *Sotera* Stipulations
Exhibit 1014	SportsCastr's Complaint for Patent Infringement against Genius Sports
Exhibit 1015	U.S. Patent Pub. No. 2015/0163379 ("Herzog")
Exhibit 1016	U.S. Patent Pub. No. 2014/0229992 ("Ellis")
Exhibit 1017	U.S. Patent Pub. No. 2016/0036910 ("Spivey")
Exhibit 1018	U.S. Patent Pub. No. 2015/0163379 ("Mitic")
Exhibit 1019	SportsCastr's Preliminary Infringement Contentions

Exhibit 1020	SportsCastr's Response to Genius Sports' First Set of Interrogatories
Exhibit 1021	Sportradar's proposed *Sotera* Stipulation to SportsCastr
Exhibit 1022	James F. Kurose & Keith W. Ross, *Application Layer*, in Computer Networking a Top–Down Approach (Michael Hirsch *et al.* eds., 4th ed. 2012) ("Kurose")
Exhibit 1023	John Dilley *et al.*, *Globally Distributed Content Delivery*, IEEE Internet Computing (Sept.–Oct. 2002).
Exhibit 1024	Mário Marques da Silva, Multimedia Communications and Networking (2012) ("Silva")
Exhibit 1025	*A Brief History of the Internet*, ONLINE LIB. LEARNING CENTER. (Feb. 9, 2024), https://www.usg.edu/galileo/skills/unit07/internet07_02.phtml ("Online Library")
Exhibit 1026	Hisayuuki Ohmata *et al.*, *Hybridcast: A new media experience by integration of broadcasting and broadband*, 2013 ITU Kaleidoscope: Building Sustainable Communities, April 2013 ("Ohmata")
Exhibit 1027	Henning Schulzrinne *et al.*, *RTP: A Transport Protocol for Real–Time–Applications*, DataTracker (January 1996), https://datatracker.ietf.org/doc/html/rfc1889 ("Schulzrinne")
Exhibit 1028	Brijesh Kumar, *Making Sense of Video Streaming Protocols*, LinkedIn. (Aug. 11, 2016), https://www.linkedin.com/pulse/making–sense–video–streaming–protocols–dr–brijesh–kumar/ ("Kumar")
Exhibit 1029	Ian Fette & Alexey Melnikov, *The WebSocket Protocol*, RFC Editor. (Dec. 2016), https://www.rfc–editor.org/rfc/rfc6455.html.
Exhibit 1030	Marcin Warczygłowa, *Real–time Web Application with Websockets and Vert.X* (Nov. 10, 2015), https://blog.allegro.tech/2015/11/real–time–web–application–with–websockets–and–vert–x.html.
Exhibit 1031	Randall Stewart & Chris Metz, *SCTP: new transport protocol for TCP/IP*, 5 IEEE 64, (2001) ("Stewart")

Exhibit 1032	Lydon Ong, John Yoakum &, *An Introduction to the Stream Control Transmission Protocol (SCTP)*, Datatracker. (May. 2002), https://datatracker.ietf.org/doc/rfc3286/ ("Ong")
Exhibit 1033	Jan Newmarch, *Introduction to Stream Control Transmission Protocol*, LINUX J. (Sep. 1, 2007), https://www.linuxjournal.com/article/9748 ("Newmarch")
Exhibit 1034	Kyung–Hoe Kim et al, *A transmission control SCTP for real–time multimedia streaming*, 54 Computer Networks 1418, (2010) ("Kim")
Exhibit 1035	High Scalability, *How Facebook Live Streams to 800,000 Simultaneous Viewers*, ByteByteGo (Jun. 27, 2016), https://blog.bytebytego.com/?utm_source=hs&utm_medium=ann&utm_campaign=top ("ByteGo")
Exhibit 1036	Hardeep Singh Parmar & Michael C. Thornburgh, *Adobe's Real Time Messaging Protocol*, Veriskope. (Dec. 21, 2002) ("Parmer")
Exhibit 1037	Ilya Grigorik, *WebRTC*, in High Performance Browser Networking, (2013) ("Grigorik")
Exhibit 1038	Sam Dutton, *Get started with WebRTC*, web.dev. (Jul. 23, 2012), https://web.dev/articles/webrtc–basics ("Dutton")
Exhibit 1039	Andy Salo, *MPEG DASH: A Technical Deep Dive and Look at What's Next*, RGB Networks, (2012) ("Salo")
Exhibit 1040	Jan Ozer, *Upstream, Justin.tv, Livestream, and Bambuser: Streaming Unplugged*, Streaming Media Magazine., Jun.–Jul. 2012 ("Ozer")
Exhibit 1041	Christopher Mueller, *MEPG–DASH vs. Apple HLS vs. Microsoft Smooth Streaming vs. Adobe HDS*, BITMOVIN. (Mar. 29, 2015), https://bitmovin.com/mpeg–dash–vs–apple–hls–vs–microsoft–smooth–streaming–vs–adobe–hds/ ("Mueller")
Exhibit 1042	Stefan Saroiu *et al.*, *An analysis of Internet Content Delivery Systems*, ACM SIGOPS Operating System Review, Vol. 36 (Dec. 31, 2002), https://doi.org/10.1145/844128.84415 ("Saroiu")

Exhibit 1043	Charles Marion & Julien Jomier, *Real–time Collaborative Scientific WebGL Visualization with Websocket*, Ass'n Computing Machinery, August 4–5, 2012 ("Marion")
Exhibit 1044	Mark Sweney, *First ads appear on YouTube Clips*, The Guardian, Aug. 22, 2007 ("Sweney")
Exhibit 1045	Richard Sandomir, *The Innovation That Grew and Grew*, N.Y. Times, June 12, 2014 ("Sandomir")
Exhibit 1046	Victoria Pimentel & Bradford G. Nickerson, *Communicating and Displaying Real–Time Data with WebSocket*, 16 IEEE (2012) ("Pimentel")
Exhibit 1047	Lucian Popa *et al.*, *HTTP as the narrow waist of the future internet*, 2010 ACM SIGCOMM Workshop, October 2013 ("Popa")
Exhibit 1048	Declaration of Dr. Stephen Wicker, Ph.D., dated August 22, 2024 (submitted in support of the IPR petitions in IPR2024–01305, IPR2024–01307, IPR2024–01308, IPR2024–01309, IPR2024–01310, and IPR2024–01311) ("Wicker Declaration")
Exhibit 1049	Comparison of the Declaration of Dr. Omid Kia, Ph.D. (Ex. 1001) to the Wicker Declaration (Ex. 1048)
Exhibit 1050	Declaration of Alexander Walden in Support of Petitioner's Notice of Intent to Designate a Provisionally Recognized PTAB Attorney as Back-Up Counsel
	Newly Added Exhibits Appear Below
Exhibit 1051	Guidance Memorandum dated March 24, 2025 from Chief Administrative Patent Judge Boalick
Exhibit 1052	U.S. District Court Eastern District of Texas, Calendar Events Set for 1/20/2026–1/26/2026, Judge Rodney Gilstrap Presiding
Exhibit 1053	Order dated March 23, 2025 – Limiting Asserted Claims and Prior Art

Exhibit 1054	Correspondence from Counsel for Patent Owner dated April 11, 2025, Stipulating Claims for Assertion in Litigation
Exhibit 1055	Correspondence from Counsel for Patent Owner dated April 14, 2025 Stipulating Claims for Assertion in Litigation
Exhibit 1056	FAQs for Interim Processes for PTAB Workload Management
Exhibit 1057	Sportradar Group AG's Redacted Motion to Dismiss Counts V and VI of the Second Amended Complaint