

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN TUOZHU TECHNOLOGY CO., LTD.,
Petitioner,

v.

STRATASYS, INC.,
Patent Owner.

Case IPR2025-00354
Patent 8,747,097

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

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I. INTRODUCTION

The Board should decline to exercise its discretion to deny institution under 35 U.S.C. §§ 314(a) and 325(d). Among other things, Patent Owner's § 314(a) arguments demand the Director *assume with certainty* that:

- (1) the PTAB's own precedent in *Sotera* no longer applies to the *Sotera* stipulation submitted in this proceeding,
- (2) Judge Gilstrap will deny the pending motion to dismiss, and
- (3) Judge Gilstrap will prioritize Patent Owner alone over twelve other plaintiffs currently scheduled to simultaneously start jury selection in Judge Gilstrap's courtroom on the exact same date in June 2026.

Such assumptions are foundational to all of Patent Owner's arguments, but they are misguided, premature, or both.

Not only does Petitioner's *Sotera* stipulation dispel Patent Owner's feigned concern of overlap between the proceedings, the facts below show there is little (or possibly no) gap between the dates of the Board's Final Written Decision and the court's final resolution after a jury trial. The merits of the Petition are robust because the prior art grounds are directly on point, which is exactly why Patent Owner now seeks to avoid the Office's consideration of those grounds. Moreover, the reality is that the statistical chance of the present parties being selected as the one trial to start on June 1, 2026 out of thirteen total trials simultaneously scheduled for the same

date in the same Court is small—less than 8%—and surely not 100% as silently assumed by Patent Owner. Review here is both ripe and just.

Regarding Patent Owner’s reach for § 325(d) discretion, it likewise assumes too much. The *Advanced Bionics* factors weigh strongly against discretionary denial—especially where Patent Owner does not contend that the obviousness combinations here were posited by the Examiner (they were not). The Petition’s newly cited prior art highlight how the Examiner erred during prosecution. Again, the strength of these prior art grounds is truly why Patent Owner now seeks to avoid the merits in a PTAB trial.

The public deserves more. The PTAB’s very “purpose and design” as reiterated by Supreme Court precedent is fulfilled by addressing the merits of the prior art here, not by shunning this much-needed review before it starts. *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020) (“By providing for inter partes review, Congress, concerned about overpatenting and its diminishment of competition, sought to weed out bad patent claims efficiently”).

II. PATENT OWNER’S BRIEF NEGLECTS CRITICAL ASPECTS OF THE PROCEDURAL POSTURE SINCE THE PETITION WAS FILED

Patent Owner’s brief (Paper 7) overlooks several critical aspects of the current posture of the litigation in the Eastern District of Texas (“EDTX”). A proper holistic

Fintiv analysis should account for the current state of the EDTX litigation and the pending Motion to Dismiss that is still being considered by Judge Gilstrap.

A. *The jury trial in Eastern District of Texas may never occur*

More than six months ago, Petitioner filed a motion to dismiss (for failure to name an indispensable party) in the EDTX litigation. It remains pending. *See* Pet., 82. The pendency of this motion reflects that it is far from a simple issue to decide. This agency has a history of exercising judicial restraint in not pre-judging the outcome of a decision to be made by an Article III Judge on an issue of law and Federal Court procedure and Petitioner believes that it would be proper for the Panel to continue this tradition of restraint here. The Director need not follow Patent Owner's demand to prematurely assume a result in Judge Gilstrap's court.

B. *The jury trial in Eastern District of Texas is redundantly scheduled with 13 other trials*

Patent Owner demands the Director adopt yet another assumption. It is undisputed that Judge Gilstrap currently has ***thirteen*** trials scheduled to start jury selection on June 1, 2026, with ***ten*** of those trials being complex patent trials. EX1021, 1-8. And there is no dispute that thirteen trials cannot start the same day. As such, Patent Owner's brief boldly assumes that Judge Gilstrap will prioritize Patent Owner over all twelve other plaintiffs scheduled to begin trial on the same day—forcing all other plaintiffs into a delayed schedule while Patent Owner is not

so delayed. Indeed, the litigation here is not even the only one of the identically scheduled trials in which copending IPR petitions have been filed.¹ There is no reason to assume that Judge Gilstrap would prioritize the trial in this matter over the other simultaneous cases where copending IPR petitions were also filed. Patent Owner's assumption that this case is the chosen one that will start jury selection on June 1, 2026, rather than any of the other twelve cases, is the flawed foundation to all of Patent Owner's *Fintiv* arguments.

This foundation assumes too much and cannot support discretionary denial. The Director need not adopt this assumption. It would be unjust for the Office to deprive the public of prompt, non-overlapping review merely because Patent Owner speculates Judge Gilstrap will force other plaintiffs to delay their scheduled jury trials to make way for Patent Owner alone. Even in a neutral statistical analysis, the

¹ Of the EDTX cases currently scheduled to simultaneously start jury selection on June 1, 2026, the various defendants have filed IPR petitions in at least: 2:24-cv-00260 (*Maxeon Solar Pte. Ltd. v. REC Solar Holdings AS*); 2:24-cv-00540 (*Hermes IP Management LLC v. Samsung Electronics Co. Ltd. et al.*); 2:24-cv-00634 (*OS-New Horizon Personal Computing Solutions Ltd. v. Samsung Electronics Co. Ltd. et al.*).

chance of the present parties being selected as the one trial to start on June 1, 2026 out of thirteen trials currently scheduled for the same date is small—less than 8%—and surely not 100% as assumed by Patent Owner.

III. THE *FINTIV* FACTORS WEIGH IN FAVOR OF INSTITUTION—35 U.S.C. § 314(a)

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

Factor 1 weighs against exercising discretionary denial. As discussed above, rather than merely requesting a Motion to Stay the EDTX litigation, Petitioner has filed a Motion to Dismiss—a far more dispositive motion worthy of consideration here because it does more than merely pause litigation in EDTX. BambuLab USA is an indispensable party under Rule 19, and simply does not reside in the Eastern District of Texas. Judge Gilstrap is still considering this motion. The fact that this motion was filed six months ago and remains pending carries more weight than a mere motion to stay. For at least this reason, Factor 1 therefore favors against discretionary denial.

Alternatively, even if the Director assumed Judge Gilstrap will deny the pending Motion to Dismiss, Factor 1 is “neutral” because there is no indication that if the action is maintained and a subsequent motion to stay is requested, the court will deny a stay. *Nikon Corp. et al. v. Optimum Imaging Technologies, LLC*, IPR2024-01372, Paper 17 at 10-11 (PTAB April 23, 2025) (Factor 1 is neutral when

no stay has been requested because the Board “will not attempt to predict how the court in the parallel district court proceedings would proceed if a stay is requested”). Patent Owner identifies a chart showing a generic “85%” denial rate for motions to stay before Judge Gilstrap yet provides no analysis as to the procedural posture or relevant circumstances for any of the particular cases for the identified motions to stay. Paper 7, 7. Patent Owner, of course, conveniently omits the fact that Judge Gilstrap has often granted a stay *after institution of IPR*—especially where the defendant/petitioner stipulates to be bound by the IPR “estoppel.” *See e.g.*, EX1025 (showing Judge Gilstrap’s reasoning for granting a stay after IPR is instituted). Nothing forbids such a motion to stay in the EDTX case here.

Here, Petitioner has filed IPR petitions challenging all of the asserted claims for all but one of the patents currently asserted in the district court, with pertinent and worthy prior art in each of the IPR petitions. Institution of IPR here would further the opportunity for a stay in the EDTX litigation (refer to the example in EX1025) such that validity would be determined by the PTAB and thereby streamline the district court case. Thus, at a minimum, Factor 1 remains “neutral.” *Nikon*, IPR2024-01372, Paper 17 at 10-11; *Sand Revolution II, LLC v. Cont’l Intermodal Grp. - Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative) (“facts beyond our control and to which the Board is not privy”).

B. *Factor 2: Proximity of the court's trial date to the Board's projected statutory deadline for a Final Written Decision*

As mentioned above, all of Patent Owner's arguments with respect to Factor 2 conveniently ignore the pending Motion to Dismiss. In doing so, Patent Owner's Factor 2 arguments effectively demand the Director should assume that Judge Gilstrap will deny the Motion to Dismiss and that jury selection will start on June 1, 2026. Discretionary denial should not be based on such premature assumptions. *Supra*, Section II(a) ("may never occur").

Even if the Director assumed Judge Gilstrap will deny the pending Motion to Dismiss, Patent Owner's assertion that the EDTX litigation will reach "a final resolution" in a jury trial before any final written decision in this forum (Paper 7, 1) is simply not true. A Final Written Decision for the present proceeding is expected on or before July 14, 2026 (Paper 6, 1), which is **1.5 months** after the theoretical start of jury selection in EDTX on June 1, 2026 (EX1019, 1). But, surely, any experienced patent litigator knows the beginning of jury selection is far from "a final resolution" (Paper 7, 1). Even if the jury trial were to begin on June 1, 2026 (which is a false assumption that overlooks twelve other plaintiffs also scheduled to start jury selection on that same date), Patent Owner's assertion ignores the amount of time required to achieve a final judgment ripe for any appeal—after the resolution of post-trial motions. Indeed, an analysis of pendency of cases handled by Judge

Gilstrap from LegalMetric reveals an average pendency for post-trial motions of 6.9 months after the jury trial. EX1022, 2. Therefore, the “final resolution” of the EDTX proceeding (if it occurs at all) would likely not occur until *sometime in early 2027*. By that time, the Board’s Final Written Decision would be in final repose or already under appeal. This IPR proceeding is the most efficient and prompt forum for achieving appealable finality, and it is the only forum that would address these prior art grounds after institution (refer to Factor 4). There is a meaningful difference between a theoretical date for the start of jury selection and an actual date of final resolution in the district court. Patent Owner’s Factor 2 analysis does not contemplate this difference.

Even more revealing, the most recent statistics for Judge Gilstrap reveal a median time-to-trial of 23.2 months for cases filed within the past three years, which would place *the beginning of the jury trial later in July 2026* based on the August 8, 2024 filing date for the complaint. EX2001, 7; EX2009. In other words, recent statistics for Judge Gilstrap indicate a likely EDTX trial date that is not necessarily before the expected Final Written Decision date. In such scenarios in which the median time-to-trial indicates that the likely trial date “is reasonably proximate to the projected statutory deadline for a final written decision,” Factor 2 weighs in favor of the Board “not exercising [its] delegated discretion to deny institution.” *Cisco Systems, Inc. v. Croga Innovations LTD.*, IPR2024-01283, Paper 8 at 44 (PTAB Feb.

13, 2025). Petitioner here requests nothing more than the same Factor 2 reasoning afforded the petitioner in *Cisco*. *Id.*

Weighing even further in favor against discretionary denial, Judge Gilstrap currently has **thirteen** trials simultaneously scheduled to start jury selection on June 1, 2026, all of which Patent Owner oddly ignores. *Supra* Section II(b); *see* EX1021, 1-8. By advocating for discretionary denial based on the scheduled jury selection date, Patent Owner is insisting that the Board must assume that Judge Gilstrap will prioritize the Patent Owner's litigation over the **twelve other** cases scheduled to begin jury selection on the same day. There is no dispute that ten of those twelve other cases are complex patent trials, yet Patent Owner has offered no evidence to suggest that Judge Gilstrap will favor the Patent Owner in this proceeding over the other patent owners. It would be unjust for the Patent Office to assume that an Article III judge would prioritize one patent owner (Stratasys) over all nine others (and over the three other non-patent plaintiffs).² Yet, by advocating for discretionary

² As explained above (Section II(b)), the litigation here is not even the only one of the identically scheduled trials in which copending IPR petitions have been filed. For example, defendants in at least three other EDTX cases scheduled to simultaneously start jury selection on June 1, 2026 have filed multiple IPR petitions. *Supra*, footnote 1.

denial, Patent Owner is asking the Director to assume that there is a 100% chance that Patent Owner's proceeding will be the one out of the thirteen cases actually selected to begin trial on June 1, 2026. Even in a neutral statistical analysis, the chance of the present parties being selected as the one trial to start jury selection on June 1, 2026 out of thirteen cases simultaneously scheduled for the same date is small—less than 8%. These additional considerations indicate that Factor 2 weighs against exercising discretion to deny IPR.

C. *Factor 3: Investment in the parallel proceeding by the court and the parties*

The investment in the parallel proceedings is low. The related District Court proceeding remains in its early stages with much of the work yet to be done. The only pending motions involve procedural/jurisdictional issues at the pleadings stage, discovery is only just beginning, and notable case milestones like a claim construction hearing have yet to be reached.

As is clear from the existence of a pending motion on the pleadings (Motion to Dismiss discussed in Section II, *supra*), the district court case is in its infancy. Indeed, while Plaintiff has completed preliminary infringement contentions and invalidity contentions have been served in the EDTX case, discovery is only just beginning in that proceeding and no depositions have yet been taken.

So far, each party has served an initial set of interrogatories and requested document production, but Patent owner has made no timely attempt to sufficiently respond at all. For example, while Patent Owner touts the “tens of thousands of pages of documents” that have been produced, it conveniently omits that Patent Owner’s statement from only a few weeks ago that

[Petitioners] had not produced *a single non-public technical document*. The “over 8,000 documents” referenced in [Petitioners’] letter are almost exclusively printouts of publicly available web pages, with *over three-quarters of the documents being printouts of a third-party website* (GitHub), most of which are simply screen captures of comments left by users on that site.

Ex. 1023. And beyond this above-quoted contradiction from Patent Owner, there remains a woeful failure of Patent Owner to sufficiently respond to Petitioner’s interrogatory and document requests at all. Patent Owner has provided almost nothing in terms of substantive production from Patent Owner in the litigation. Aside from initial production of *less than ten* confidential documents, Patent Owner only recently made its first substantial production of non-public documents on April 21, 2024. Even still, these documents narrowly relate to the Plaintiff’s earlier corporate reorganization—nothing related to invalidity based on prior art. EX1024.

Notable district court milestones are still on the distant horizon. There is no dispute that completion of fact discovery is not until January 12, 2026—months

away even assuming the discovery schedule is not further extended. EX1019, 4. And, similarly, no depositions have yet been taken and expert discovery has yet to begin. *Id.* (expert discovery not to be completed until February 2026). And the parties have neither argued nor briefed claim construction issues. EX1019, 5. Indeed, the parties have not even exchanged a list of identified claim terms. *Id.* Thus, even if even if the Director assumed Judge Gilstrap will deny the pending Motion to Dismiss, the bulk of the district court milestones have yet to occur—and certainly little or no investment from the parties regarding the merits of prior art/invalidity disputes. In accordance with PTAB precedent, the current stage of the parallel proceeding indicates that Factor 3 weighs against discretionary denial. *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 at 16-17 (Dec. 1, 2020) (designated “precedential” Dec. 17, 2020) (holding that Factor 3 weighs against discretionary denial when no *Markman* briefing has yet occurred as this indicates “relatively limited investment in the parallel proceeding”). Petitioner here requests nothing more than the same Factor 3 reasoning afforded the petitioner in the *Sotera* precedent. *Id.*

Furthermore, in addition to the parallel District Court proceeding being still in a relatively early stage, Petitioner’s diligence in filing the instant Petition in a timely manner further indicates that Factor 3 weighs against discretionary denial. Specifically, Petitioner was diligent in obtaining counsel, identifying highly relevant

prior art, securing the declaration testimony of Dr. Wolfe, and preparing the Petition—all within a mere 4.5 months of the August 8, 2024 filing of the Complaint in EDTX. *See* Paper 6, 1; EX2009. The PTAB has repeatedly (and justly) reasoned that “Petitioner’s diligence in filing the Petition also weighs in favor of not exercising discretion to deny institution.” *Peag LLC et al. v. Varta Microbattery GMBH*, IPR2020-01212, Paper 8 at 20 (PTAB Jan. 6, 2021); *see also Dish Network LLC v. Broadband iTV, Inc.*, IPR2020-01332, Paper 14 at 28-29 (PTAB Jan. 27, 2021). Patent Owner’s Factor 3 analysis does not contemplate this fact when reaching its flawed conclusion.

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

Factor 4 weighs strongly in favor of institution because on April 8, 2025, Petitioner served Patent Owner (and subsequently filed with the Board) a *Sotera* stipulation for this proceeding, as well as for all of the other IPR proceedings involving Petitioner and Patent Owner. *See* EX1020. *Sotera* is still precedential. *Sotera*, IPR2020-01019, Paper 12 at 18-19 (designated “precedential” Dec. 17, 2020). Specifically, Petitioner’s *Sotera* stipulation plainly states:

If IPR is instituted in IPR2025-00354, unless institution is later vacated, reversed or otherwise withdrawn by rehearing or Director Review, Shenzhen Tuozhu and the other defendants named in the related District Court Cases No. 2:24-cv-00644 (E.D. Tex.) and 1:24-cv-01511 (W.D.

Tex.) stipulate that they will not pursue in the 2:24-cv-00645 case or the 1:24-cv-01511 case, against the '097 Patent, ***the specific grounds asserted in IPR2025-00354 or any other ground that was raised or could have been reasonably raised in an IPR*** (i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patent or printed publications).

EX1020. In other words, if the Board proceeds to review the '097 patent in a PTAB trial, there will be no overlap with the parallel litigation because the litigation defendants will not pursue in the district court any “ground that was raised or could have been reasonably raised.” *Id.* As explained in the *Sotera* precedent, such a “stipulation ensures that an inter partes review is a ‘true alternative’ to the district court proceeding.” *Sotera*, IPR2020-01019, Paper 12 at 18-19 (designated “precedential” Dec. 17, 2020) (“mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions”).

This precedential decision carries weight here and is worthy of safeguarding. As such, “this factor ***weighs strongly in favor of not exercising discretion to deny institution*** under 35 U.S.C. § 314(a).” *Id.* (emphasis added); *see also Ocado Group PLC v. AutoStore Technology AS*, IPR2021-00311, Paper 11 at 17 (PTAB June 28, 2021) (finding that a *Sotera* stipulation “address[es] any concerns about overlap between the issues presented in the two fora”).

As Patent Owner identified in its Request for Discretionary Denial, Petitioner has identified five “system art” references in its District Court invalidity contentions. Paper 7, 14-15. There is no dispute these system art references are unavailable for consideration in this IPR. But that is where Patent Owner’s factual assertion ends and its error-riddled theories begin. Fatally, Patent Owner has identified no overlap between the identified system art references and the distinct publication references relied upon in the present proceeding. *Id.* In other words, Patent Owner presents no evidence or analysis that the “system art” references identified in Petitioner’s District Court invalidity contentions are derived from or describe the same or similar systems as those disclosed by the printed publication prior art relied upon in the IPR grounds here. Critically, Patent Owner cannot do so because no such connection exists. At most, the Patent Owner can merely demand that the Director must assume such a connection when none is cited or explained. This is not enough to eviscerate the *Sotera* precedent.

Patent Owner’s theory that relies upon a blind assumption that “Petitioner is not restrained from asserting very similar obviousness theories in the Related Litigation that include only minor differences from the Grounds raised in this Petition by including unpublished system art.” Paper 7, 15. Tellingly, Patent Owner neither cites evidence nor any concrete example from the litigation record that Petitioner could raise such arguments with “only minor differences” from the IPR

grounds here. *Id.* The fact that Patent Owner fails to identify any actual similarities between the “system art” identified in the District Court and the printed publications of the IPR grounds belies Patent Owner’s assumption that it would even be possible for Petitioner to advance a “very similar” system-art ground in the District Court. *Id.* Yet again, Patent Owner’s imaginative theories are not enough to undo the *Sotera* precedent, which maintains that Factor 4 weighs “strongly in favor” of not exercising discretion to deny IPR here. *Sotera*, IPR2020-01019, Paper 12 at 18-19 (designated “precedential” Dec. 17, 2020).

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

Petitioner is a defendant in the parallel EDTX proceeding. As such, this factor weighs in favor of discretionary denial.

F. *Factor 6: Other circumstances that impact the Board’s exercise of discretion, including the merits*

1. The strong merits of the Petition favor institution

On the merits and pertinence of the prior art cited in the Petition, the IPR Grounds here strongly favor institution. As one example, the merits of the instant Petition are strong because Petitioner identified printed publications that were not before the examiner during prosecution that expressly disclose the feature thought to be missing from the prior art at the time of allowance, all of which is confirmed by the only expert testimony in the record. As identified in the Petition, during

prosecution of the application that led to the '097 patent, the Applicant distinguished the allowed claims from the *Adusumilli* reference applied during prosecution by amending claim 1 to recite:

a three-dimensional scanner configured to capture three-dimensional information from *an object being fabricated within* the build volume *during a print job executing on the three-dimensional printer*;

EX1002, 85-94, 103-105; Pet., 5-6. As explained by the Applicant when amending the claims, “[a]ll of the scanning in *Adusumilli* is done prior to fabrication for the purpose of ‘captur[ing] the contour of the entire upper or lower gum line’ for creating a model as the basis for a denture fabrication.” EX1002, 107. (emphasis original). The Applicant went on to assert that the amended claim language distinguished over *Adusumilli* “[b]ecause the scanner in *Adusumilli* expressly performs a scan prior to fabrication” while the amended claims required “a scanner that captures three-dimensional information from *an object being fabricated* within the build volume *during a print job* executing on the three-dimensional printer.” *Id.* (emphasis original).

In response to this claim amendment and arguments by the Applicant, the Examiner withdrew all prior art-based rejections. EX1002, 121-123. As such, the Prosecution History indicates that the feature thought to be missing from the prior art during prosecution is “a three-dimensional scanner configured to capture three-

dimensional information from *an object being fabricated within* the build volume *during a print job executing on the three-dimensional printer.*”

The merits of the instant Petition are strong because Petitioner identified not one, but two references (Knighton and Bonassar) that were not before the Examiner and disclose precisely this feature that was thought to be absent from the prior art. Pet., 21, 54-55. For example, Knighton expressly discloses “a three dimensional scanner 130 is provided within the housing 100 to *scan the object 114 during fabrication.*” EX1005, 2:31-40, *see also* Abstract, 2:53-3:53; Pet., 21. Knighton goes on to state that the scanner, “may use laser ranging to create the three dimensional model *of the work in process* 114.” EX1005, 3:37-40; Pet., 21.

Similarly, Bonassar discloses “[o]ptical sensors *at the manufacturing site [to] continuously monitor* the composition, temperature, and dimensions of the product.” EX1004, 2:43-45, 5:37-39, Abstract; Pet., 54. These optical sensors disclosed by Bonassar include a 3D scanner in the form of “a non-contact ranging sensor device which can be scanned by the positioning system across the build surface” to “*automatically monitor the progress of a fabrication operation*” and “measure the geometry of the finished product.” EX1010, [0104] (describing “acquisition of the geometry of deposited material” during fabrication), [0105] (discussing various “machine vision sensing technologies”); Pet., 54-55.

The fact that the Petition identifies two distinct references that each separately disclose the feature thought to be missing from the prior art (a three-dimensional scanner that scans “*an object being fabricated within the build volume during a print job executing on the three-dimensional printer*”) by itself indicates the strong merits of the Petition. As such, for this reason alone, Factor 6 strongly favors institution.

2. The Motion to Dismiss in the EDTX proceeding weighs against discretionary denial

Patent Owner ignores the pending Motion to Dismiss (*supra* Section II(a)) for all Factors 1-5, acknowledging its existence only in Factor 6. Paper 7, 16-17. Even then, Patent Owner never directly explains why the still-pending Motion to Dismiss should be excluded from the Factor 6 category of “other circumstances that impact the Board’s exercise of Discretion.” *Id.* Because the District Court has not yet ruled on the Motion to Dismiss, that is exactly why it is such a “circumstance[]” worthy of consideration and weight here. *Supra* Section II(a). For the reasons noted above, the pendency and possible grant of the Motion to Dismiss should be weighed because it affects at least Factor 2 and Factor 6 (weigh against discretionary denial) and Factor 1 (weighs against discretionary denial or is, at a minimum, neutral).

3. The “additional factors” enumerated in the Director Memo favor institution

Reliance on Expert Testimony

Patent Owner’s assertions regarding reliance on expert testimony (Paper 7, 17-18) do not shift discretionary denial considerations. Petitioner properly relies on expert testimony from Dr. Wolfe to support the arguments made in the Petition—including detailed and focused testimony on how a POSITA would have applied predictably combined the identified references and how such combinations apply to the challenged claims. Here, Dr. Wolfe provided important context not available to the examiner during examination regarding the knowledge of a POSITA and the understanding that a POSITA would have gathered from the cited prior art references. Patent Owner’s arguments regarding reliance on expert testimony ignore the underlying reason for this factor. Indeed, Patent Owner never alleges that expert testimony is being used as a substitute for a prior art publication against any claim element or to fill in any claim elements missing from the cited prior art. The length of the expert declaration is a reflection of the number of claims, the requirements for a fulsome analysis under *KSR* and other precedent, and the PTAB’s own rules at 37 CFR § 42.65(a). Patent Owner essentially demands that this new factor regarding “[t]he extent of the petition’s reliance on expert testimony” should force petitioners to violate the requirement of 37 CFR § 42.65(a) that expert testimony “disclose the

underlying facts or data on which the opinion is based.” We disagree that the Director intended such a result.

Furthermore, if there were merit to Patent Owner’s assertion that “the declaration largely mirrors the wording and argument made in the Petition,” surely Patent Owner would have been able to find an example that did not require chopping up the wording of a single sentence into several small pieces. Paper 7, 17-18. That some phrasing in the Petition mirrors the testimony of Dr. Wolfe merely demonstrates that Petitioner puts credence in the sound judgment and focused analysis of Dr. Wolfe based on his decades of experience in the field.

Turning to the specific issue of Dr. Wolfe’s statements regarding Mazumder’s substrate on which a three-dimensional part is fabricated and the work space defined by that substrate (EX1003, ¶¶165-166), the testimony of Dr. Wolfe on this point does not “supplant the teachings of the references themselves,” as Patent Owner alleges. Paper 7, 18. Rather, Dr. Wolfe simply identifies the plain fact that a POSITA would have recognized that the term “substrate,” when used in the context of a Mazumder’s “direct material deposition system 10” for fabricating “three-dimensional products by applying sequentially layers of material 20 *on a substrate*” refers to a portion of the fabrication system that defines a work space in which objects are fabricated and thus is a “build volume.” EX1003, ¶¶165-166 (citing EX1004, 3:11-25, 4:7-10, FIG. 1). That is, Petitioner does not rely on Dr. Wolfe’s

testimony to fill in an element missing from the disclosures of Mazumder (or the other prior art of Ground 2A) but rather for the straightforward knowledge of a POSITA that the space defined by a substrate within a three-dimensional fabrication system *is* a build volume.

In an attempt to support its argument, Patent Owner later asserts a narrow interpretation for the term “build volume” requiring that “the build volume limits the size of an object that may be printed using the 3D printer.” Paper 7, 55. These additional arguments should be dismissed for at least two reasons. *First*, there is no such requirement recited by the claim language itself or in the identified examples from the specification that add this extra, unrecited limitation to the claims. *Second*, a substrate (such as the substrate 30 disclosed by Mazumder) is a physical portion of Mazumder’s system on which “sequential[] layers of material” are deposited as part of the three-dimensional fabrication process. EX1004, 3:11-25; EX1003, ¶165. It is therefore apparent that objects fabricated on the substrate 30 would be limited in size to objects that can actually fit on the substrate.

Finally, Patent Owner’s attorney argument with respect to the “build volume” recitation should be given less weight at this early stage because Patent Owner has presented no evidence to support its assertions. The straightforward explanation in the Petition that the substrate of Mazumder and the work space defined by the substrate is a build volume is supported by expert testimony. Pet., 53; EX1003,

¶¶165-166. By contrast, Patent Owner presents attorney argument alone even though Patent Owner had the opportunity to present expert testimony and/or other additional evidence to support its position, yet chose not to.

Length of Time the Claims Have Been in Force

Regarding Patent Owner’s assertion that “the ’097 Patent has been in force for over 10 years” (Paper 7, 18), Patent Owner essentially seeks to use the issuance of a patent ten years ago as a “submarine patent,” where members of the public independently developed an industry of at-home, high-quality 3D printer technology for many years while Patent Owner concealed any implication of its own improperly broad interpretation of the patent claims that it now asserts in the District Court for purposes of demonstrating alleged infringement. A decade after the filing date of the ’097 patent, the current Patent Owner acquired the ’097 patent in 2022 from the original assignee and then elected to become litigious later in 2024. Only then, did the public become aware of Patent Owner’s mistaken viewpoint of its allowed claim scope.

The Petition in this IPR proceeding is the prompt and direct result of Patent Owner’s very recent assertion of a claim scope that ensnares known prior art—a claim scope that the Examiner would have never allowed if foreseen at that time. The PTAB’s very “purpose and design,” as reiterated by the Supreme Court, is fulfilled by addressing the merits of the prior art here, not by shunning this much-

needed review before it starts. *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020) (“By providing for inter partes review, Congress, concerned about overpatenting and its diminishment of competition, sought to weed out bad patent claims efficiently”); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 279-80 (2016) (describing the PTAB’s basic “purpose” and the public’s “paramount interest in seeing that patent monopolies ... are kept within their legitimate scope”). Patent Owner’s contention that this new “length of time” factor somehow overrules this mandate is an unwise invitation for an abuse of discretion.

Compelling Economic or National Security Interests

Patent Owner’s assertions regarding “economic or national security interests” are similarly hollow. Paper 7, 19-20. Patent Owner does not even allege any “national security interests” that would arise from the claimed technology. *Id.* Similarly, economic interests favor institution as allowing Patent Owner to continue to assert claim scope that ensnares known prior art, and therefore that which rightfully belongs to the public, would allow Patent Owner to hold an unjust monopoly on such technology. Such an artificial monopoly would have negative economic consequences for the public by restricting the free market to determine the fair price for such technology that is rightfully within the public domain.

G. *Patent Owner's copy-and-pasted Preliminary Response arguments fail to identify any flaws in the grounds presented in the Petition*

With respect to Patent Owner's copying and pasting of essentially its entire Patent Owner's Preliminary Response ("POPR") into the contemporaneously filed Request for Discretionary Denial (*Compare* Paper 7, 28-67 *with* Paper 8, 3-43), such arguments should be dismissed for both policy interest reasons and because Patent Owner's arguments fail to show any actual flaws in the Petition's application of the proposed prior art combinations to the challenged claims.

First, Patent Owner's copying and pasting of all of its arguments from its POPR into the Request for Discretionary Denial flies directly in the face of the spirit of the March 26, 2025 Memorandum by the Director regarding "Interim Processes for PTAB Workload Management" (Director Memo). The new bifurcated process is intended to streamline the PTAB procedures and reduce the workload on the Board by splitting discretionary considerations from merit-based determinations for each petition. By copying and pasting the entirety of the POPR arguments into the Request for Discretionary Denial, Patent Owner is essentially insisting that the Director and the panel of consulting PTAB judges tasked with assessing discretionary considerations should also conduct a full merits review for every Petition prior to the assigned three-member PTAB panel repeating that same review. This insistence by Patent Owner is directly contrary to the efficiencies that the new

bifurcated process is intended to achieve. Indeed, Patent Owner's theory is belied by the Patent Office's recent "FAQs," which emphasized that "[t]he parties should not treat a discretionary denial brief or opposition as an additional opportunity for merits briefing."³

If the Director were to conduct a full merits analysis at this initial discretionary consideration stage, such an outcome would invite every future Patent Owner to similarly repeat their POPR arguments in the request for discretionary denial and thus turn the new, streamlined bifurcated process back into a unified process in which a single entity, the Director and panel of consulting PTAB judges, would be tasked with conducting both discretionary and merits analysis on an accelerated schedule from the standard six-month time frame for the PTAB to make institution determinations. The Board should decline this invitation from Patent Owner to conduct a full merits analysis as part of the discretionary considerations phase.

Second, as discussed on pages 18-19, *supra*, the merits of this case are strong because the Petition advances grounds based on not one, but two references that were not before the Examiner during prosecution and precisely the feature thought

³ https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term= at FAQ no. 25.

to missing from the prior art. Turning briefly to Ground 1A, as discussed above, Ground 1A relies on the previously unidentified Knighton reference as the primary reference in the combination and Knighton expressly discloses “a three dimensional scanner 130 is provided within the housing 100 to *scan the object 114 during fabrication.*” EX1005, 2:31-40, *see also* Abstract, 2:53-3:53; Pet., 21. Petitioner further described in detail the reasons that would have motivated a POSITA to apply the teachings of Luo and Anderson to Knighton to provide a 3D printing apparatus that included a control subsystem with a network interface and web server functionality and to present a visual display of the “three dimensional model of the work in process” (captured by Knighton’s scanner) at the remote user computer and how this predictable combination would have provided all elements of claims 1-2, 4-5, 9-10, 12, 15-16, 18. Pet., 12-36.

Patent Owner’s arguments with respect to Ground 1A fail to identify any flaws in the proposed combination described in the Petition because they improperly attack the references in isolation rather than the proposed combination as a whole. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.”). Knighton’s disclosures of automatically analyzing the “three dimensional model of the work in process” generated using its 3D scanner and taking corrective actions on this analysis is not a

teaching away from the additional functionality of displaying information obtained from sensors, including the scanned model information, as taught by Luo and displaying a two-dimensional rendering of the three-dimensional model as taught by Anderson. EX1005, 2:31-40. Such a modification would have achieved the numerous benefits discussed in the Petition and corroborated by the Crampton reference. Pet., 12-19; EX1009, 6:43-60, 8:3-15; EX1003, ¶90 (“...a POSITA would have recognized that displaying such models of scanned three-dimensional data was well-known in prior art systems.”). The disclosure of an alleged alternative solution is not a teaching away from one of the known alternative solutions. *See PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1197-98 (Fed. Cir. 2014) (“Our precedent...does not require that the motivation be the best option, only that it be a suitable option from which the prior art did not teach away.”); *see also Galderma Labs., L.P. v. Tolmar, Inc.*, 737 F.3d 731, 738 (Fed. Cir. 2013); *Bayer Healthcare Pharms., Inc. v. Watson Pharms., Inc.*, 713 F.3d 1369, 1376 (Fed. Cir. 2013); *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (“Our case law does not require that a particular combination must be the preferred, or the most desirable, combination described in the prior art in order to provide motivation for the current invention.”).

Both Luo and Anderson include clear disclosure of displaying a three-dimensional model of an object being fabricated and nothing in the prior art criticizes the functionality of displaying the “three dimensional model of the work in process”

generated by Knighton's 3D scanner based on those teachings of Luo and Anderson and thus there is no "teaching away" from such the proposed combination. *SightSound Techs., LLC v. Apple Inc.*, 809 F.3d 1307, 1320 (Fed. Cir. 2015); EX1006, 3; EX1012, FIG. 2A, [0018]-[0020], [0026]. As such, Patent Owner's assertion that "Luo does not disclose any capability for displaying three-dimensional models based on three-dimensional data scanned during a print job" (Paper 7, 46) fails because this argument improperly attacks the Luo reference in isolation rather than the proposed combination of Knighton, Luo, and Anderson. More specifically, the Petition does not rely on Luo as teaching the three-dimensional scanner. Rather, as discussed in the Petition, Luo (and Anderson) discloses displaying a rendering of a three-dimensional model of an object being fabricated by a rapid fabrication system and these teachings are properly combined with Knighton which discloses that such a three-dimensional model of the object can be generated by scanning the object as it is being fabricated within a rapid fabrication machine.

Patent Owner's arguments regarding application of Anderson to Knighton and Luo (Paper 7, 48-50) similarly fail because they attack Anderson in isolation. The Petition explains in detail that in the predictable combination, Knighton generates the status information, including a visual representation of "the three dimensional model of the work in process 114" created using information obtained from

Knighton's 3D scanner "scan[ning] the object 114 during fabrication" and Anderson and Luo provide disclosures for displaying such status information. Pet., 26-29; EX1005, 2:31-40; EX1006, 1, 3; EX1012, [0019], [0021], [0025], FIG. 2A.

With respect to Ground 2A, as discussed above on pages 21-22, the arguments presented in the Petition clearly reveal the understanding of a POSITA that the space defined by a substrate within a three-dimensional fabrication system, such as is disclosed by Mazumder, *is* a build volume. EX1003, ¶¶165-166 (citing EX1004, 3:11-25, 4:7-10, FIG. 1).

Patent Owner's remaining arguments with respect to Ground 2A mirror its arguments with respect to Ground 1A by similarly improperly attacking the references in isolation rather than the predictable combination described in the Petition. Paper 7, 58-62. As discussed above (and clearly articulated in the Petition), Bonassar discloses "[o]ptical sensors *at the manufacturing site [to] continuously monitor* the composition, temperature, and dimensions of the product." EX1004, 2:43-45, 5:37-39, Abstract; Pet., 54. These optical sensors disclosed by Bonassar include a 3D scanner in the form of "a non-contact ranging sensor device which can be scanned by the positioning system across the build surface" to "*automatically monitor the progress of a fabrication operation*" and "measure the geometry of the finished product." EX1010, [0104] (describing "acquisition of the geometry of

deposited material” during fabrication), [0105] (discussing various “machine vision sensing technologies”); Pet., 54-55.

As discussed in the Petition, Mazumder includes straightforward teachings for displaying information obtained using optical sensors and Bonassar provides disclosure of known 3D scanning machine vision, error detection, and error correction functionality that would have been predictably and beneficially applied to Mazumder’s system. Pet., 50-53; EX1004, 2:43-45, 3:26-39, 5:37-38, 5:51-63; EX1010, [0104]-[0105], [0110], [0145] (suggesting “3D laser scanning”). Bonassar’s system “compare[s] the state (geometry and other automatically detectable properties) of the simulation” based on a model of the object to be fabricated “to the state of *the real object being produced as measured by 3-D scanning* (or other) sensors.” *Id.*, [0097]. Similarly, Patent Owner’s assertions regarding Bonassar’s disclosure of including components that are not three-dimensional scanners, such as CCD cameras and microscopes, as part of its machine vision system ignore Bonassar’s express disclosure of “compar[ing] the state (geometry and other automatically detectable properties) of the simulation” based on a model of the object to be fabricated “to the state of *the real object being produced as measured by 3-D scanning* (or other) sensors.” EX1010, [0097]; Pet., 50-51.

Finally, similar to Patent Owner's arguments regarding motivation to combine with respect to Ground 1A, its arguments addressing motivation to combine for Mazumder and Bonassar, at most, reveal that there were multiple potential solutions to the problem of correcting errors during object fabrication. Paper 7, 62-66. However, as discussed above, the disclosure of an alternative solution is not a teaching away from one of the known alternative solutions. *See PAR Pharm.*, 773 F.3d at 1197-98 ("Our precedent...does not require that the motivation be the best option, only that it be a suitable option from which the prior art did not teach away."); *see also Galderma Labs.*, 737 F.3d at 738; *Bayer Healthcare Pharms.*, 713 F.3d at 1376; *In re Fulton*, 391 F.3d at 1201 ("Our case law does not require that a particular combination must be the preferred, or the most desirable, combination described in the prior art in order to provide motivation for the current invention.").

As discussed above, and in the Petition, Mazumder discloses using various sensors, including optical sensors, to determine the status of a three-dimensional fabrication process and provides that status information to a user to allow for correction of errors while Bonassar provides straightforward teaching that one such sensor that would be beneficial to Mazumder's system is a three-dimensional scanner that scans the object being fabricated during the fabrication process. EX1004, 2:43-45, 3:26-39, 5:37-38, 5:51-63; EX1010, [0104]-[0105], [0110], [0145]. The Petition properly relies upon Bonassar for all that it would have

reasonably suggested to one having ordinary skill the art and the law does not require Petitioner to bodily incorporate all aspects of Bonassar's teachings into Mazumder's system. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 807 (Fed. Cir. 1989); *Axonics, Inc. v. Medtronic, Inc.*, 73 F.4th 950, 957 (Fed. Cir. 2023). As such, the fact that Bonassar includes additional disclosure of techniques for automatic error correction of an object being fabricated is not a teaching away from incorporating a three-dimensional scanner into Mazumder's system (based on the teachings of Bonassar).

The above discussion of Patent Owner's copy-and-pasted POPR arguments only scratch the surface. However, based on the recently issued Patent Office guidance that "[t]he parties should not treat a discretionary denial brief or opposition as an additional opportunity for merits briefing," Petitioner will reserve additional discussion of the merits of the Grounds advanced in the Petition for the Petitioner's Reply after institution. See FAQs for Interim Processes for PTAB Workload Management at 25.

IV. THE DIRECTOR SHOULD EXERCISE DISCRETION TO GRANT INSTITUTION UNDER SECTION 325(d)

The *Advanced Bionics* framework sets forth a two-part inquiry to determine whether a §325(d) discretionary denial is warranted. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb.

13, 2020) (designated precedential: Mar. 24, 2020). Under this framework, the Board considers:

(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and

(2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Id., 8. This two-part-framework includes evaluation of the *Becton, Dickinson* factors. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (designated precedential as to Section III.C.5, first paragraph: Aug. 2, 2019). More specifically, in evaluating the first prong of the *Advanced Bionics* framework, the Board weighs the following non-exclusive factors first identified in the *Becton, Dickinson* precedential decision: (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; and ; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art. *Advanced Bionics*, 10; *Becton, Dickinson*, 17–18. If it is determined that the same or substantially the same art or arguments

previously were presented to the Office, the Board next evaluates the following *Becton, Dickinson* factors: (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of prior art or arguments. *Id.*

As explained below, application of the *Advanced Bionics* framework to this case reveals that discretionary denial under §325(d) is not warranted.

A. Factors (a), (b), and (d): The Patent Office did not previously consider the same or substantially the same art or arguments presented in the Petition

Although Anderson (EX1012) was cited by the examiner during prosecution (EX1002, 88), it was never considered in combination with the more pertinent teachings of Knighton and/or Luo. As discussed in § III.F.1, *supra*, Knighton, which was never before the Examiner during prosecution, discloses precisely the feature thought to be missing from the prior art during prosecution: “a three-dimensional scanner configured to capture three-dimensional information from an object being fabricated within the build volume during a print job executing on the three-dimensional printer.” EX1002, 85-94, 103-105; Pet., 5-8, 21; EX1005, 2:31-40, 3:39-53, 4:27-67, Abstract. For example, Knighton expressly discloses “a three

dimensional scanner 130 is provided within the housing 100 to *scan the object 114 during fabrication.*” EX1005, 2:31-40, *see also* Abstract, 2:53-3:53; Pet., 21. Knighton goes on to state that the scanner, “may use laser ranging to create the three dimensional model *of the work in process* 114.” EX1005, 3:37-40; Pet., 21.

The fact that Knighton and Luo were not before the Examiner during prosecution and that Anderson has never previously been considered in combination with Knighton and/or Luo reveals that the Petition does not rely on the same or substantially the same prior art as that previously presented to the Office. As the Board has made clear “[t]he fact that one piece of art from the combination was previously presented and/or argued to the Office alone is insufficient to satisfy the first prong of Advanced Bionics two-part test concerning whether the art previously presented to the Office was the same or substantially the same or whether the same or substantially the same arguments previously were presented to the Office.” *Thorne Research, Inc. v. Trustees of Dartmouth College*, IPR2021-00491, Paper 18 at 7-9 (PTAB Aug. 12, 2021). Where, as here, “[o]nly one of the references that serves as the basis of [Petitioner]’s obviousness grounds...was considered by the Examiner during prosecution,” such circumstances fail to demonstrate that the Grounds in the Petition are “the same or substantially the same art or arguments that previously were considered by the Examiner during prosecution” absent a showing that the additional references are cumulative of the art addressed during prosecution.

London Luxury v. E & E Co., LTD., PGR2021-00083, Paper 10 at 17-22 (PTAB Nov. 15, 2021). Petitioner requests nothing more than equal treatment to the petitioner in *London Luxury*.

Furthermore, Patent Owner fails to demonstrate that Knighton and/or Luo are substantially the same as either the Adusumilli or Anderson references applied by the Examiner during prosecution. As discussed in § III.F.1, *supra*, the challenged claims were allowed because, “[a]ll of the scanning in *Adusumilli* is done prior to fabrication for the purpose of ‘captur[ing] the contour of the entire upper or lower gum line’ for creating a model as the basis for a denture fabrication.” EX1002, 107. As such, the Applicant asserted that the amended claim language distinguished over Adusumilli “[b]ecause the scanner in *Adusumilli* expressly performs a scan prior to fabrication” while the amended claims required “a scanner that captures three-dimensional information from *an object being fabricated* within the build volume *during a print job* executing on the three-dimensional printer.” *Id.* Knighton fills this gap believed to be missing from the prior art by expressly disclosing “a three dimensional scanner 130 is provided within the housing 100 to ***scan the object 114 during fabrication.***” EX1005, 2:31-40. Knighton (in combination with Luo and Anderson) is therefore distinctly ***not*** substantially the same as the prior art previously presented to the office.

Patent Owner asserts that Anderson fails to disclose “providing a status of the print job for remote display by capturing and analyzing image content from a three-dimensional scanner” (Paper 7, 25), but the Petition does not rely on Anderson for disclosure of “capturing and analyzing image content from a three-dimensional scanner”; it relies on Knighton for this teaching.

In addition to these considerations, the Petition also advances Ground 2A which relies exclusively on references that were not before the Examiner during prosecution (Mazumder and Bonassar). Furthermore, Bonassar also discloses the features thought to be missing from the prior art through its disclosure of “[o]ptical sensors *at the manufacturing site [to] continuously monitor* the composition, temperature, and dimensions of the product.” EX1004, 2:43-45, 5:37-39, Abstract; Pet., 54. These optical sensors disclosed by Bonassar include a 3D scanner in the form of “a non-contact ranging sensor device which can be scanned by the positioning system across the build surface” to “*automatically monitor the progress of a fabrication operation*” and “measure the geometry of the finished product.” EX1010, [0104] (describing “acquisition of the geometry of deposited material” during fabrication), [0105] (discussing various “machine vision sensing technologies”); Pet., 54-55.

As such, because “Petitioner relies extensively on references not previously presented to the Office” to teach the claim recitations previously thought to be

missing from the prior art, “factors (a) and (b) weigh in favor of institution” and “§ 325(d) is not applicable to this proceeding.” *Comcast Cable Comms, LLC, v. Rovi Guides, Inc.*, IPR2019-01434, Paper 14 at 13-14 (PTAB Feb. 12, 2020); *see also Hydrite Chemical Co. v. Solenis Techs., L.P.*, IPR2015-01592, Paper 7 at 9 (PTAB Jan. 27, 2016) (declining to exercise discretion under §325(d) even though several asserted references were previously considered by the Office because “Petitioner has provided **additional art**, arguments, declaration evidence, and other information not previously considered by the Patent Office.”); *Nvidia Corp. v. Invensas Corp.*, IPR2020-00602, Paper 11 at 17-19 (PTAB Sept. 3, 2020) (granted institution because new secondary reference was not considered by the Examiner during prosecution); *Agrofresh Solutions Inc. v. Lytton Enterprise, Inc.*, IPR2021-00451, Paper 11 at 12-13 (PTAB July 27, 2021). Petitioner requests the same treatment as the petitioners in these cases.

B. Factors (c), (e), and (f): The Examiner erred by not identifying and applying the more pertinent Knighton, Luo, Mazumder, Bonassar, Mamoto, Crampton, Chandhoke, Ridley, Biton, and Bakhadyrov references presented in the Petition to the challenged claims prior to allowance.

As discussed in the previous section, the record reveals that the Petition does not rely on the same or substantially the same art or arguments previously presented to the Office. However, the second prong of the *Advanced Bionics* framework also favors institution under the precedential *Oticon Medical AB v. Cochlear Limited*

decision because the Examiner failed to identify Knighton, Luo, Mazumder, or Bonassar (not to mention Mamoto, Crampton, Chandhoke, Ridley, Biton, and Bakhadyrov). Failure to identify and apply the highly pertinent teachings of these references to the allowed claims “was error in the prosecution leading to the issuance of” the ’097 patent due to the fact that “the Examiner was simply not aware of” these references. *Oticon Medical AB v. Cochlear Limited*, IPR2019-00975, Paper 15 at 19-20 (PTAB Oct. 16, 2019) (designated precedential: Mar. 24, 2020). Where, as here, “[t]he Petition...presents different prior art than the Office was aware of,” this constitutes error by the Office during prosecution. *Id.*

V. THE TEXT OF 35 U.S.C. § 314(c) IS CONTRARY TO THE TYPE OF WRITTEN DECISION THAT PATENT OWNER IS REQUESTING HERE

To the extent Patent Owner is requesting a written decision that is silent on a determination of whether the IPR grounds in the Petition demonstrate a reasonable likelihood to prevail on at least one claim, Patent Owner overlooks the text of the statute. There is no dispute that § 314(a) includes the word “may” such that the Director has discretion to grant or deny institution of review. *See* 35 U.S.C. § 314(a). But the statute does not end there. Nor should the written decision in this case.

Reading further, it is clear that the text of § 314(c) includes the term “shall” and offers no discretion on what must be included in writing from the Office. And

it is straight forward: “The Director *shall* notify the petitioner and patent owner, in writing, of the Director’s *determination under subsection (a)*.” *See* 35 U.S.C. § 314(c). In other words, § 314(c) does not provide any option for a decision at the institution stage (grant or denial) that is silent on the “determination under subsection (a),” which must be a specific type of determination. Namely, the term “determine” appears in § 314(a) to describe the reasonable-likelihood-to-prevail determination based on the merits of the prior art grounds presented in the Petition:

§314

(a)Threshold.—

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

...

(c)Notice.—

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

See 35 U.S.C. § 314.

Thus, fulfillment of the statute is achieved when the written institution

decision expresses the “determination” of whether the IPR grounds in the Petition demonstrate a reasonable likelihood to prevail on at least one claim. *Id.* But Patent Owner’s brief (Paper 7) appears to request the opposite. Worse yet, Patent Owner’s brief is distinct from the information that must be weighed in order to achieve “the Director’s determination under subsection (a).” *Id.* In particular, § 314(a) specifies that “the determination” should be based upon “the information presented in the petition filed under section 311 [the Petition] and any response filed under section 313 [the Preliminary Response].” *See* 35 U.S.C. § 314(a). Patent Owner’s brief (Paper 7) is neither of those.

For at least these reasons, the Director should reject Patent Owner’s request.

VI. CONCLUSION

For the reasons discussed above, discretionary denial under either § 314(a) or § 325(d) is not warranted.

Respectfully submitted,

Dated: May 14, 2025

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CERTIFICATION UNDER 37 CFR § 42.24

Under the provisions of 37 CFR § 42.24, the undersigned hereby certifies that the word count for the foregoing Petitioner's Opposition to Patent Owner's Discretionary Denial Brief totals 9634 words, which is less than the 14,000 allowed under 37 CFR § 42.24.

Dated: May 14, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(1) and 42.6(e)(4)(iii), the undersigned certifies that on May 14, 2025, a complete and entire copy of this Petitioner's Opposition to Patent Owner's Discretionary Denial Brief and added supporting exhibits are provided via email to the Patent Owner via electronic mail on Patent Owner's lead and backup counsel listed below at the following email address:

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