

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

LG ELECTRONICS, INC. AND
LG ELECTRONICS USA, INC.

Petitioners,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2025-00394

U.S. Patent No. 10,199,072

**BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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<i>Agrinomix, LLC v. Mitchell Ellis Prods., Inc.,</i> IPR2017-00525, Paper 6 (PTAB Jun. 14, 2017)	6
<i>Albany Int’l Corp. v. Kimberly-Clark Worldwide, Inc.,</i> PGR2021-00019, Paper 22, 8-9 (P.T.A.B. June 22, 2021)	5
<i>Apple Inc. v. Fintiv, Inc.,</i> IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)	1, 4, 18, 20, 23, 26, 33
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG,</i> IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017)	3
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37 C.F.R. § 42.1	32
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PATENT OWNER’S EXHIBIT LIST

Description	Exhibit #
Notice Letter From Maxell to LG Electronics Sent July 19, 2021 and FedEx Tracking Showing Receipt July 28, 2021	2001
Joint Case Management Statement, <i>Maxell, Ltd. v. LG Electronics Inc. et al.</i> , No. 5:24-cv-04972-NW-SVK (N.D. Cal. Mar. 17, 2025)	2002
Docket Navigator Average Time to Trial and Markman Hearing Search Results (N.D. Cal.)	2003
March 24, 2025 Guidance on USPTO’s Recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation”	2004
Complaint, <i>Maxell, Ltd. v. LG Electronics Inc. et al.</i> , No. 5:23-cv-00152-RWS (E.D. Tex. Dec. 29, 2023)(“Complaint”)	2005
U.S. Patent No. 10,679,674	2006
U.S. Patent No. 9,818,449	2007
U.S. Patent No. 9,384,783	2008
U.S. Patent No. 8,644,684	2009
U.S. Patent No. 7,613,383	2010
U.S. Patent No. 11,017,815	2011
File History of U.S. Patent No. 10,679,674	2012
File History of U.S. Patent No. 9,818,449	2013
File History of U.S. Patent No. 9,384,783	2014
File History of U.S. Patent No. 8,644,684	2015
File History of U.S. Patent No. 7,613,383	2016
File History of U.S. Patent No. 11,017,815	2017
U.S. Patent Application Publication No. 2007/0022382(“Honkaniemi”)	2018
U.S. Patent No. 7,443,418(“Bryant”)	2019
LG’s Invalidity Contentions in District Court Litigation	2020

I. INTRODUCTION

Patent Owner Maxell, Ltd. ("Patent Owner") respectfully requests that the Board deny institution of the Petition filed by LG Electronics Inc. and LG Electronics U.S.A., Inc. (hereinafter "Petitioner" or "LG") challenging the patentability of claims 1-19 ("challenged claims") of U.S. Patent No 10,199,072 ("the '072 Patent") (LG-1001).

The Board should exercise its discretion pursuant to 35 U.S.C. § 314(a) or 35 U.S.C. §325(d) and deny the Petition. Application of the *Advanced Bionics / Becton, Dickinson* factors weighs strongly in favor of denying institution under § 325(d) because the Petition relies on art that was previously presented to or considered by the Office, or is merely cumulative to such art, and Petitioner fails to demonstrate any material error by the Examiner.

Application of the *Fintiv* factors under § 314(a) also weighs in favor of denial given the state of the parallel District Court litigation where the same validity challenges are being adjudicated. The Board has discretion to deny institution under these circumstances to promote fairness and efficiency and manage its docket, potentially considering factors beyond the established frameworks. Instituting an IPR here would contradict the goal of IPRs as an "effective and efficient alternative" to litigation, particularly given the substantial overlap and the finite resources of the

Board. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017) (precedential).

Accordingly, the Board should decline to institute the Petition.

II. THE MARCH 26, 2025 ACTING DIRECTOR'S MEMORANDUM

Pursuant to the Acting Director's Memorandum dated March 26, 2025 ("the Memo"), which outlines "Interim Processes for PTAB Workload Management" including a bifurcated approach for considering discretionary denial, Patent Owner respectfully submits that the Director should deny institution of the Petition. This filing is being made within two months of the Notice of Filing Date dated February 11, 2025 (Paper #5), in accordance with the standard briefing schedule for discretionary denial arguments set forth in the Memo.

The Memo outlines relevant considerations for discretionary denial:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;

- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

As explained more fully below, denial is warranted under 35 U.S.C. § 325(d) and 35 U.S.C. § 314(a). Additionally, other factors highlighted in the Memo—including Petitioner's undue delay in filing this challenge, the nature of its expert testimony (LG-1003), and the fact that the '072 Patent will expire shortly after the anticipated institution decision date—further support discretionary denial. Thus the petition is ripe for discretionary denial in light of the Memo's aim to “improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings,...and promote consistent application of discretionary considerations in the institution of AIA proceedings.” Memo at 3.

III. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

The Petition should be denied pursuant to the Director's discretion to deny institution of petitions. **First**, the Petition should be denied pursuant to 35 U.S.C. § 325(d) because the petition argues the “same or substantially the same art previously presented to the Office” and fails to demonstrate “that the Office erred in a manner material to the patentability of the challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8 (P.T.A.B. Feb. 3, 2020) (precedential); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, pp. 17-18 (P.T.A.B. Dec. 15, 2017)

(Precedential). **Second**, the Petition should be denied pursuant to 35 U.S.C. § 314(a) and the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020), given the parallel District Court litigation. **Finally**, other considerations such as Petitioner's undue delay in filing this challenge despite years of notice, Petitioner's expert testimony that merely parrots the petition, and that the '072 Patent will expire shortly after the Board's Institution Decision all favor discretionary denial.

A. Application of 35 U.S.C. § 325(d) Weighs In Favor Of Denying Institution

The Petition should be denied pursuant to 35 U.S.C. § 325(d) because the Petition improperly seeks reconsideration of validity based on art and arguments already reviewed by the Office. Under the framework established in *Advanced Bionics*, denial is warranted where “(1) the same or substantially the same prior art was previously presented to the Office or (2) the same or substantially the same arguments were previously presented to the Office.” *Advanced Bionics*, IPR2019-01469, Paper 6, at 8 (P.T.A.B. Feb. 3, 2020) (precedential). “Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Id.* at 7-8. Further, the Board has construed “previously presented” in 35 U.S.C. § 325(d) to refer to art and arguments

presented to the Office prior to the filing of the petition at issue. *Ironsource Ltd. v. Digital Turbine Inc.*, PGR2021- 00096, Paper 14 at 52 (P.T.A.B. Jan. 6, 2022). If this condition regarding prior presentation is met, the Board then considers whether the petitioner has demonstrated material error by the Office. *Advanced Bionics*, Paper 6 at 8.

Here, the first part of the framework is satisfied because the Petition relies heavily on references—Kaplan and Bryant—that were previously presented to the Office during prosecution of the '072 Patent. The remaining references—Horn and Sporer—are merely cumulative to art already considered during the prosecution of the '072 Patent itself. Furthermore, Petitioner fails to meet the second part of the framework, as it makes no credible showing that the Office materially erred in allowing the '072 Patent claims. Petitioner's arguments regarding alleged error rest on a misapplication of a Board's findings regarding the related yet distinct '783 patent in IPR2018-01432. Because the Petition relies on previously presented or cumulative art and fails to demonstrate material error, denial is appropriate. See *Albany Int'l Corp. v. Kimberly-Clark Worldwide, Inc.*, PGR2021-00019, Paper 22, 8-9 (P.T.A.B. June 22, 2021) (denying institution because “[i]f a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute review.”)

1. The Same Or Substantially The Same Art Was Previously Presented To The Office

The first part of the *Advanced Bionics* framework is met because the key prior art references supporting the Petition's grounds, Kaplan and Bryant, were previously presented to the Office during the prosecution of the '072 Patent. This alone is enough for the Board to exercise its discretion and deny institution. *See Clim-A-Tech Ind., Inc. v. William A. Ebert*, IPR2017-01863, Paper 13, at 18-19 (P.T.A.B. Feb. 12, 2018) (denying institution even though the 'Examiner did not base a rejection' on the reference asserted in the petition); *Biocon Pharma Ltd. v. Novartis Pharm. Corp.*, IPR2020-01263, Paper 12, 9 (P.T.A.B. Feb. 16, 2021) (holding that cited but unapplied references supported denying institution); *Sony Interactive Entm't LLC v. Terminal Reality, Inc.*, IPR2020-00711, Paper 15, at 11 (P.T.A.B. Oct. 13, 2020) (finding reference was previously considered by the PTO because it was listed in the Examiner's Notice of References Cited); *Agrinomix, LLC v. Mitchell Ellis Prods., Inc.*, IPR2017-00525, Paper 6 (P.T.A.B. Jun. 14, 2017) (denying institution for grounds based on prior art that was considered during prosecution even though the prior art reference was not relied upon to reject all the challenged claims.)

The remaining references —Horn and Sporer— are merely cumulative to art considered during the prosecution of the '072 Patent and its closely related applications, particularly Honkaniemi (EX2018). *See* U.S. Patent No. 11,017,815

(EX2011); U.S. Patent No. 10,679,674 (EX2006); U.S. Patent No. 9,818,449 (EX2007); U.S. Patent No. 9,384,783 (EX2008); U.S. Patent No. 8,644,684 (EX2009); U.S. Patent No. 7,613,383 (EX2010); *see also* EX2012-2017 (file history for related patents).

a. Kaplan and Bryant

Petitioner's main references for Grounds 1, 2A, 2B, 3, 4A and 4B—Kaplan (LG-1004) and Bryant (LG-1005)—were previously presented to and considered by the Examiner during prosecution of the '072 Patent. The Petition acknowledges that “Kaplan and a relative of Bryant ... were cited on the face of the '072 Patent,” Pet. 108, fulfilling the threshold requirement for § 325(d).

The Examiner reviewed both Kaplan and Bryant during prosecution. (LG-1002 at 35). Furthermore, the Bryant patent considered by the Examiner issued directly from the application published as LG-1005 (U.S. Pub. No. 2004/0201691). These references share the same title, inventors, application number, and filing date. More importantly, EX2018 and LG-1015 possess identical specifications and drawings. As they disclose the same teachings, the Examiner's consideration of the issued patent EX2018 is consideration of the earlier publication LG-1005.

Art considered by the Examiner during prosecution constitutes art “previously presented to the Office” under § 325(d). *See Advanced Bionics*, Paper 6 at 7-9. Furthermore, Kaplan and Bryant were also presented and considered during the

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prosecution of closely related applications within this patent family, further demonstrating the Office's familiarity with this art in the context of the claimed invention. Consequently, the current grounds based on this previously presented art are duplicative, representing substantially the same arguments based on substantially the same art already considered by the Office.

The Examiner explicitly noted consideration of the references listed on the Information Disclosure Statements submitted during prosecution:

Receipt date: 06/06/2018

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)		Application Number	15508175	
		Filing Date	2017-11-09	
		First Named Inventor	YOSHIDA, S.	
		Art Unit	2484	
		Examiner Name	TRAN, T. Q.	
		Attorney Docket Number	ASA-10782-05	

35/B08,375 - 0A01: 2484

9	5654746	A	1997-08-05	MCMULLAN, JR. et al.	
10	5734823	A	1998-03-31	SAIGH et al.	
11	7443418	B2	2008-10-28	BIRYANT et al.	
12	5758068	A	1998-05-26	BRANDT et al.	
13	5882793	B1	2005-04-19	FU et al.	
14	8291444	B1	2012-10-16	NEWELL	
15	5754548	B1	2004-06-22	YOSHII et al.	
16	7231360	B2	2007-06-12	SY	
17	5611813	B1	2003-08-26	BRATTON	
18	7249106	B2	2007-07-24	TANABE et al.	
19	7565675	B2	2009-07-21	SINCAGLIA et al.	

EPF Web 2.1.18

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /D.S./

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Preempt date: 08/08/2018 15/SUB,1/2 = 0801-2886

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)		Application Number		15606175	
		Filing Date		2017-11-09	
		First Named Inventor		YOSHIDA, S.	
		Art Unit		2454	
		Examiner Name		TRAN, T. Q.	
		Attorney Docket Number		ASA-10782-05	

31	9734900	B1	2004-05-11	TERANE et al.	
32	9724403	B1	2004-04-20	SANTORO et al.	

If you wish to add additional U.S. Patent citation information please click the Add button.

U.S. PATENT APPLICATION PUBLICATIONS						
Examiner Initial*	Cite No	Publication Number	Kind Code*	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
	1	20060166147	A1	2006-07-27	INOUE et al.	
	2	20060107289	A1	2006-05-18	DEYONKER et al.	
	3	20010056434	A1	2001-12-27	KAPLAN et al.	
	4	20040078383	A1	2004-04-22	MERCER et al.	
	5	20010052127	A1	2001-12-13	SEO et al.	
	6	20030122861	A1	2003-07-03	JUN et al.	
	7	20040068606	A1	2004-04-08	KIM et al.	

EPF Web 2.1.18

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /D.2./

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(LG-1002 at 45-59). Having reviewed the prior art landscape, including Kaplan and Bryant, the Examiner allowed the claims and provided a specific reason distinguishing the prior art:

The prior arts do not disclose include deleted information of the first group in the second group when the deleted information recorded on the recording medium was included in both the first group and the second group.

(LG-1002 at 28).

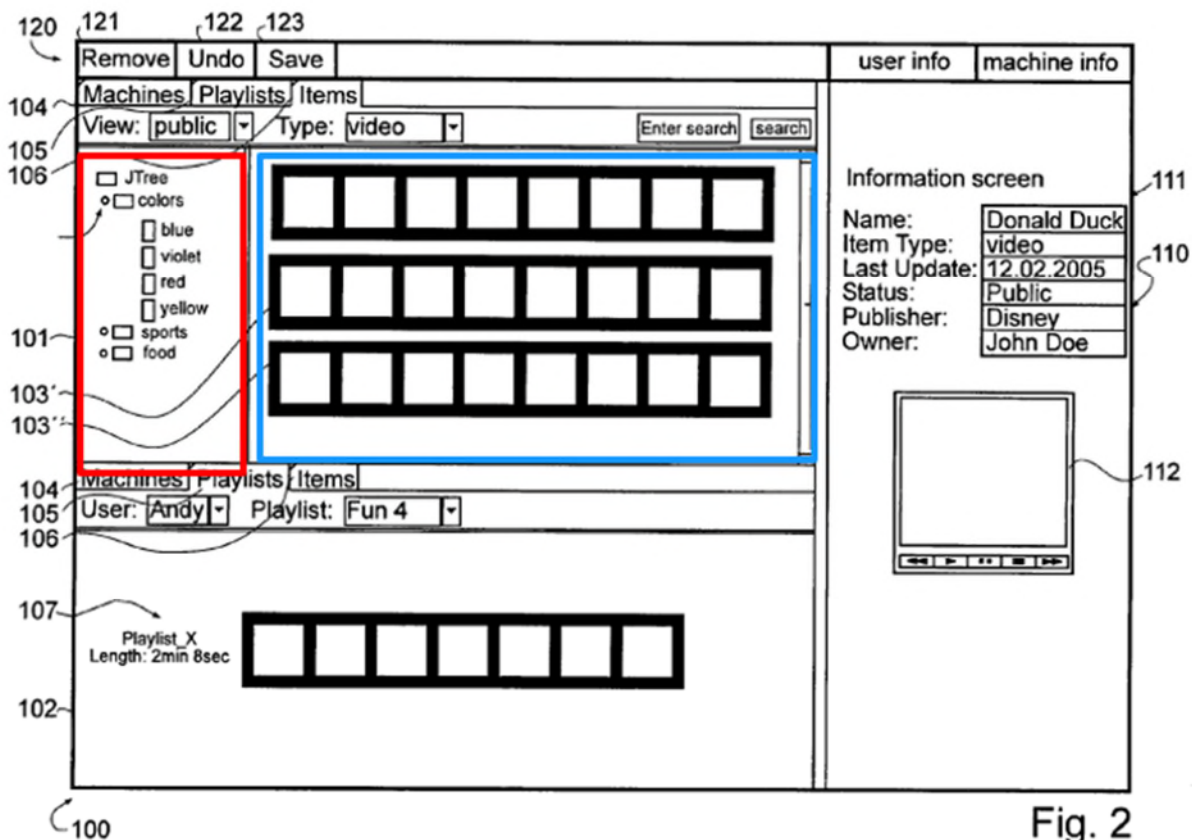
Petitioner's attempts to minimize the significance of this presentation by alleging Examiner error are unfounded, as discussed below. The Board routinely denies institution where art was previously before the Examiner, even if not applied in a rejection, because the Office had the opportunity to consider its substance. *See Clim-A-Tech Ind., Inc. v. William A. Ebert*, IPR2017-01863, Paper 13, at 18-19 (P.T.A.B. Feb. 12, 2018) (denying institution even though the 'Examiner did not base a rejection' on the reference asserted in the petition); *Biocon Pharma Ltd. v. Novartis Pharm. Corp.*, IPR2020-01263, Paper 12, 9 (P.T.A.B. Feb. 16, 2021) (holding that cited but unapplied references supported denying institution); *Sony Interactive Entm't LLC v. Terminal Reality, Inc.*, IPR2020-00711, Paper 15, at 11 (P.T.A.B. Oct. 13, 2020) (finding reference was previously considered by the PTO because it was listed in the Examiner's Notice of References Cited). Because the primary references for Grounds 1, 2A, 2B, 3, 4A, and 4B were previously presented and considered, making the current challenges duplicative, these grounds should be denied under § 325(d).

b. Horn

Grounds 5A and 5B, anchored by Horn (LG-1021), also warrant denial because Horn is cumulative to art explicitly cited and considered by the Examiner during prosecution of the '072 Patent, particularly Honkaniemi (EX2018). Horn's cumulativeness to Honkaniemi is demonstrated by the substantial similarity of the

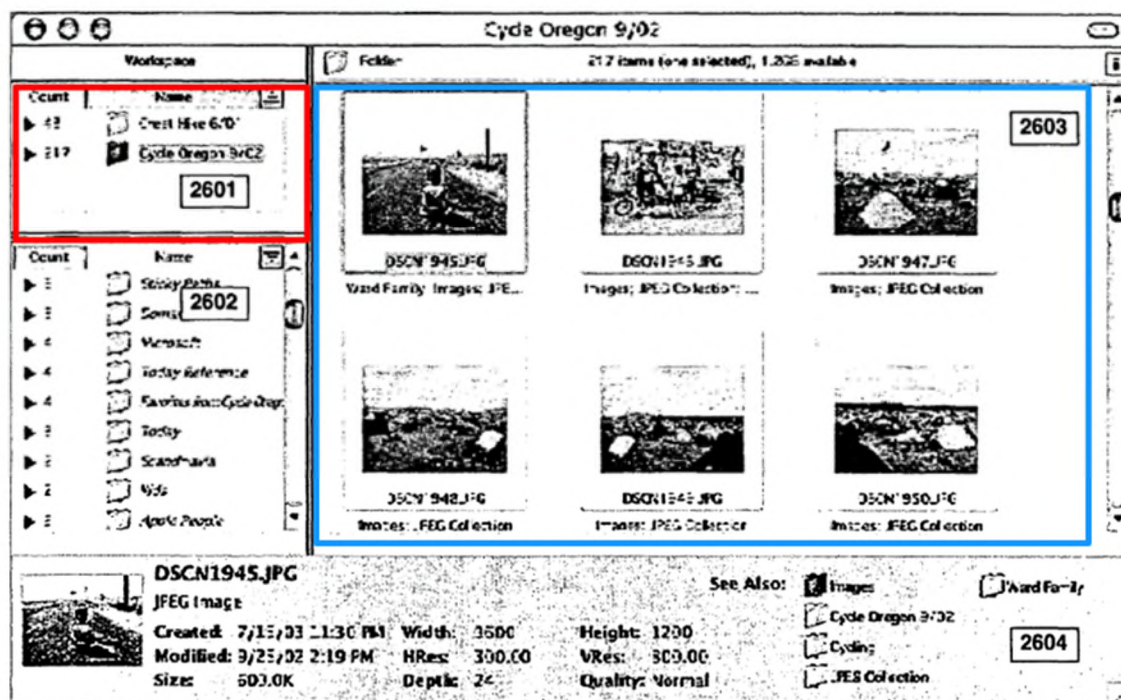
systems' disclosed functionalities as described in their respective specifications, especially when viewed in light of the Examiner's stated reasons for allowance over Honkaniemi.

Both Horn and Honkaniemi disclose graphical user interfaces designed to manage collections of digital content, including media files like video or movies, using distinct interface areas for navigation and for displaying content items as thumbnails.



EX2018 at FIG. 2. Honkaniemi describes a user interface (100) with a selectable “items view” (106) and “playlist view” (105), where items (103) like media files are represented as thumbnails (103 in FIG. 2, highlighted in blue) and can be organized via a category tree selector (106 in FIG. 2 highlighted in red) or within playlists (107). Selecting a category or playlist in one area displays the corresponding thumbnails in another area. (EX2018, ¶¶0010, ¶¶0021, ¶¶0024, ¶¶0028).

Figure 26



LG-1021 at FIG. 26. Similarly, Horn discloses a Metadata Filing System (MFS) for managing various data objects, including images and explicitly “movies”, organized into user-defined or system-defined “Collections”. (LG-1021, Abstract, ¶¶0049, ¶¶0103). Horn’s user interface (FIG. 26) depicts distinct areas or panes: one for

navigating organizational structures like Collections, Domains, or Folders (2601, analogous to Honkaniemi's 106, highlighted in red) and another area for displaying thumbnails of items (e.g., images, "movies") within the selected Collection/Folder (2603, analogous to Honkaniemi's 103, highlighted in blue). Horn's Collections pane thus provides analogous navigation to Honkaniemi's tree selector/playlist list, and both display content items as thumbnails within organized groups. (LG-1021, ¶0152, ¶¶0154-156); (EX2018, ¶0006, ¶0022, ¶0028, ¶0037).

Furthermore, the Examiner expressly referenced Honkaniemi in the Statement of Reasons for Allowance for the related '449 Patent regarding user interface features, including items arranged as thumbnails in playlists:

Honkaniemi (US 20070022382) discloses user interface includes items, each item having a media file and arranged to be visible as a thumbnail to the user interface. The items are arranged to establish at least one playlist so that a series of thumbnails are arranged to establish the playlist. See figures 1-3 and the record of patent 8644684 (12/567898) for more detail. The prior arts did not disclose continue to include deleted information of the first group in the second group when the deleted information recorded on the recording medium was included in both the first group and the second.

(EX2013 at 28). While Horn, like Honkaniemi, discloses a UI for organizing and displaying thumbnails in collections, Horn does not disclose this specific data management feature related to deleting items included in multiple groups. Horn's

teachings regarding UI layout and thumbnail display are therefore substantially the same as, and cumulative to, the corresponding teachings in Honkaniemi that the Examiner already considered and found insufficient for patentability based on a different feature. Horn presents nothing materially different from Honkaniemi regarding the basis upon which the Examiner allowed the claims.

c. Sporer

Similarly, Sporer, which Petitioner uses only in combination grounds (Grounds 2B, 4B, 5B), is cumulative of art previously considered by the Office during prosecution, such as Kaplan, Bryant, and Honkaniemi. Sporer generally teaches standard digital video processing circuits, including the use of common compression/decompression codecs (like MPEG and Motion-JPEG) to handle video input and playback within a computer system. (LG-1029 at 1:10-21, 8:51-10:5)

These are conventional components and functionalities for systems designed to manage and display multimedia content, such as those described in Kaplan and Bryant (which the Examiner reviewed during prosecution, LG-1002 at 35) and Honkaniemi (which the Examiner also reviewed during prosecution, LG-1002 at 28). These references disclose systems managing various media types, including video or image data suitable for video, inherently contemplating the need for standard processing like encoding/decoding. Therefore, Sporer's disclosure of conventional video processing circuitry adds nothing new to what was already

encompassed by the art considered during prosecution. Combinations involving Sporer do not present art or arguments materially different from those the Office already considered based on Kaplan, Bryant, and Honkaniemi, further supporting denial under § 325(d).

2. Petitioner Fails To Demonstrate A Material Error By The Office

Petitioner also fails the second part of the *Advanced Bionics* framework because it cannot show the Examiner materially erred in allowing the '072 Patent claims over the previously presented or cumulative art. Petitioner's allegation of "clear material error" (Pet. 108) rests almost entirely on misapplying the Board's findings in the Final Written Decision from IPR2018-01432 (LG-1040) concerning the related '783 patent. Petitioner's reliance on this decision is misplaced for several reasons.

First, the Final Written Decision in *Fandango Media LLC v. Maxell Ltd.*, IPR2018-01432 (P.T.A.B. Feb. 10, 2020) addressed different claims (specifically claims 2, 5, and 6) of the related, but distinct, '783 patent (LG-1040 at 2). Petitioner attempts to equate the Board's analysis of claim 2 of the '783 patent with claim 1 (element [1.g]) of the challenged '072 patent, but ignores critical differences in claim language, scope, and type:

'783 Claim 2	'072 Claim 1
A method comprising:	An information processing apparatus comprising:
reproducing selected video information from among a plurality of video information recorded on a recording medium by the recording unit,	a recording medium to store a plurality of video data;
displaying, on a display device, a user interface for a user to select desired video information to be reproduced from among the plurality of video information recorded on the recording medium by the recording unit;	an output unit configured to output a menu display for a user to select one group of video data among a plurality of groups of video data by a specifying position of a character corresponding to the one group of video data;
reproducing the selected video information read out from the recording medium	a reproducer configured to reproduce the selected video data read out from the recording medium;
	and a controller;
wherein a first area and a second area are displayed within a menu display, wherein the first area is configured to display at least first indication associated with a first group of video information for a first classification and second indication associated with a second group of video information for a second classification different from the first classification, and wherein the second area is configured to display thumbnails corresponding to video information recorded on the recording medium by the recording unit;	
wherein, when the first indication shown in the first area is selected, displaying, in the second area, a first group of thumbnails corresponding to the first group of video information;	wherein, when a first group of video data is selected in the menu display by specifying a position of a character corresponding to the first group of video data, the controller controls so that a first group of thumbnails corresponding

	to the first group of video data is displayed
	in a state that an order of the first group of thumbnails is editable,
wherein, when the second indication shown in the first area is selected, displaying, in the second area, a second group of thumbnails corresponding to the second group of video information,	wherein, when a second group of video data is selected in the menu display by specifying a position of a character corresponding to the second group of video data, the controller controls so that a second group of thumbnails corresponding to the second group of video data is displayed
	in a state that the order of the second group of thumbnails is editable,
wherein, even if one video information recorded on the recording medium included in both the first group of video information and the second group of video information is deleted from the first group of video information, the one video information continue to be included in the second group of video information.	wherein, even if one video data stored on the recording medium included in both the first group of video data and the second group of video data is deleted from the first group of video data, the controller controls so that the one video data continues to be included in the second group of video data
	and a thumbnail corresponding to the one video data is displayed as one of the second group of thumbnails when the second group of thumbnails is displayed.

Compare LG-1022 at Claim 2 *with* LG-1001 at Claim 1. Petitioner's argument ignores these material differences, rendering its reliance on the IPR2018-01432 obviousness finding for the different '783 claim improper for establishing Examiner error regarding the distinct '072 claims.

Second, the Examiner of the '072 patent correctly allowed the claims based on a specific finding distinguishing the prior art: the failure of the art to “disclose [or suggest] include deleted information of the first group in the second group when the deleted information recorded on the recording medium was included in both the first group and the second group.” (LG-1002 at 28). Petitioner fails to show how the Board's analysis in IPR2018-01432, concerning different claims of a different patent, demonstrates that this specific finding by the '072 Examiner was material error based on the art the Examiner considered (Kaplan, Bryant, and Honkaniemi).

Finally, Petitioner's reliance on the non-precedential institution decision in IPR2024-00735 involving another patent is similarly unavailing and irrelevant to whether the Examiner materially erred in this case based on the record before the Office during prosecution of the '072 patent. Petitioner has failed entirely to demonstrate any material error by the Examiner concerning the allowance of the challenged claims of the '072 Patent.

B. Application of 35 U.S.C. § 314(a) Weighs in Favor of Denying Institution

The Petition should also be denied pursuant to 35 U.S.C. § 314(a) because the factors established in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential), weigh in favor of denial due to the parallel District Court Litigation. *Maxell, Ltd. v. LG Electronics Inc. et al.*, No. 5-24-cv-04972 (N.D.

Cal.) (“District Court Litigation”). Petitioner’s analysis of these factors in the Petition is self-serving and ignores the actual progress and status of the District Court Litigation, thereby minimizing the substantial inefficiencies and prejudice inherent in instituting this duplicative proceeding, particularly on a nearly expired patent, given Petitioner’s refusal to file a *Sotera* stipulation. When properly analyzed based on the court docket, the *Fintiv* factors strongly favor denial. Institution would be inconsistent with the AIA’s goal of providing an “effective and efficient alternative” where, as here, the District Court is actively adjudicating the same core validity issues. *NHK Spring Co. v. Intrix-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018).

1. Status of Motion to Stay in Parallel Litigation (Factor 1)

Petitioner LG has filed a Motion to Stay the District Court Litigation Pending Inter Partes Reviews (Dkt. 124, filed Jan 24, 2025). The motion has been fully briefed by the parties (Dkt. 126, 128). However, the scheduled hearing was vacated (Dkt. 130), and the motion remains pending. While the motion is pending, no stay is currently in place, and the outcome is uncertain. Furthermore, significant resources were expended briefing the motion itself. This uncertainty, combined with the fact the case continues to proceed, means this factor weighs in favor of, or at least does not weigh against, denial.

2. Proximity Of The District Court's Trial Date (Factor 2)

Currently, no trial date is set in the parallel District Court Litigation. Following the case's transfer to the Northern District of California and initial scheduling (Dkt. 118), the matter was reassigned to a different judge (Dkt. 130). Pursuant to the Court's Reassignment Order, all previously scheduled hearing dates were vacated (Dkt. 130). Therefore, the schedule remains.

While the specific timeline is subject to the Court's scheduling, the *Fintiv* analysis considers the likely timing of trial relative to the Board's statutory deadline. Recent guidance confirms the Board may consider evidence beyond merely a set trial date, including average time-to-trial statistics for the district, recognizing that schedules can change. Based on averages for patent cases in the Northern District of California, trial often commences approximately 9 months following the Markman hearing. See EX2003 (showing that the average time to trial is 31 months and the average time to a Claim Construction order is approximately 22 months). Applying this average timeframe suggests a trial start date around late March 2026, assuming claim construction proceeds without significant delay once rescheduled. Petitioner's statistics about time-to-trial are misleading because they do not account for the fact the case was transferred and progress has occurred in the litigation.

A projected trial start date only three months after the Board's statutory deadline (approximately August 2026) still constitutes significant proximity under

Fintiv's holistic framework. The intensive, resource-heavy final trial preparations in the district court would substantially overlap with the concluding months of this IPR proceeding, generating the exact type of parallel litigation inefficiencies that discretionary denial aims to prevent.

Importantly, Factor 2 must be weighed holistically with all other *Fintiv* factors. Here, Factor 3 and Factor 4 provide compelling reasons for denial. As detailed below, the parties and the District Court have already invested substantial resources, including extensive motion practice on transfer and pleadings, exchange of detailed infringement and invalidity contentions, and significant discovery. This substantial investment, coupled with the significant overlap between the issues presented here and in the District Court, and the fact the parties are identical (Factor 5), strongly favors denial. Therefore, even when considering the current schedule uncertainty, Factor 2, viewed in light of the likely trial proximity and the overwhelming weight of other factors, supports the exercise of discretion to deny institution.

3. Significant Investment In The Parallel Proceeding (Factor 3)

The parties' and the court's investment in the parallel District Court Litigation weighs heavily in favor of discretionary denial. Since the case was filed approximately 15 months ago in the Eastern District of Texas on December 29, 2023, significant activity has occurred across two district courts. After contested

motion practice regarding venue, the case was transferred to the Northern District of California in August 2024. Notably, Defendants waited nearly a full year after the initial complaint – until late December 2024 and January 2025 – to file the first of their IPR petitions, allowing considerable litigation activity to proceed in the interim.

The substantial work and investment by the parties and the courts before the anticipated Institution Decision deadline is demonstrated by the following completed milestones:

- Complaint Filed in E.D. Texas (December 29, 2023) (EX2005);
- Contested Motion to Transfer Practice in E.D. Tex. (Briefing/Hearing Completed before July 1, 2024) (Dkt. 30, 44, 47, 51, 55, 59);
- Case Transferred to N.D. Cal. (August 9, 2024) (Dkt. 70-71);
- Defendants' Motion for Judgment on Pleadings (§101) Fully Briefed (Filed October 4, 2024; Opp. and Reply followed) (Dkt. 94, 105, 113);
- Initial Case Management Conference Held in N.D. Cal. (December 4, 2024) (Dkt. 117);
- Entry of Case Management & Scheduling Order (Setting path through Claim Construction) (December 5, 2024) (Dkt. 118);
- Entry of Stipulated Protective Order (December 10, 2024) (Dkt. 120-121);
- Plaintiff's N.D. Cal. Infringement Contentions Served (December 18, 2024) (Dkt. 125);

- Defendants' Motion to Stay Pending IPRs Fully Briefed (Filed January 24, 2025; Opp. and Reply followed) (Dkt. 124, 126, 128);
- Defendants' Invalidity Contentions Served (February 3, 2025) (EX2020 at 274);
- Parties Exchanged Proposed Terms for Construction under Patent L.R. 4-1 (February 18, 2025) (EX2002 at 7);
- Parties Exchanged Preliminary Claim Constructions & Extrinsic Evidence under Patent L.R. 4-2 (March 11, 2025) (EX2002 at 7);
- Filing of Detailed Joint Case Management Statement (March 17, 2025) (EX2002 at 7);
- Substantial Document Production Completed (Parties collectively produced >300,000 pages as of March 17, 2025) (EX2002 at 6);

This extensive activity clearly shows a significant investment by both the parties and the courts. The *Fintiv* analysis for Factor 3 requires assessing this investment as of the date the Institution Decision is anticipated (early August 2025). While Petitioner may have asserted investment was minimal when filing the Petition, that timeframe is not controlling. By the time the Institution Decision is due, the parties and courts will have undeniably made a substantial investment progressing this case through significant discovery and the entire claim construction preliminary

exchange process. Therefore, the third *Fintiv* factor weighs strongly against institution.

4. There Is Significant Overlap Between Issues Raised In The Petition And In The District Court Litigation (Factor 4)

The issues in this proceeding are substantially the same as in the District Court Litigation. Here, Petitioner asserts that Claims 1-19 of the '072 Patent are unpatentable (Pet. at 1). These claims cover and expand upon the claims asserted by Maxell against Petitioner in the District Court Litigation (EX2005, ¶160). Furthermore, the prior art references that Petitioner relies on in supporting its Petition – namely Bryant, Kaplan, Horn, and Sporer – are the exact same references Petitioner relies upon to challenge the validity of the '072 Patent in the District Court Litigation. These references are explicitly listed in Petitioner's (as Defendant LG) own Invalidity Contentions served in the district court case on February 3, 2025 (*e.g.*, EX2020 at 274).

Petitioner's failure to make a *Sotera* stipulation also weighs heavily against institution. As the Board recognized in *Sotera*, such stipulations mitigate concerns regarding "potentially conflicting decisions and duplicative efforts between the district court and the PTAB." (*Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (P.T.A.B. Dec. 1, 2020)). Contrary to making a *Sotera* stipulation, Petitioner, by challenging validity here while litigating in parallel

without such a stipulation, evidently intends to pursue the same or similar invalidity defenses using overlapping prior art in this proceeding and the District Court Litigation.

Given that the Petition is directed toward the same patent, encompasses the claims at issue in the parallel District Court proceeding, involves overlapping prior art and arguments, and since Petitioner has not sought to mitigate concerns regarding duplicative efforts or potentially conflicting decisions via a *Sotera* stipulation, this factor strongly favors denial of institution.

5. The District Court Litigation And The Petition Involve The Same Parties (Factor 5)

As noted in Patent Owner's Mandatory Notice, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the '072 Patent). Petitioners are parties to the District Court Litigation. Accordingly, this factor weighs in favor of discretionary denial.

6. Other Factors Favor Discretionary Denial (Factor 6)

Petitioner waited years after receiving notice of the '072 patent on July 28, 2021 (EX2001) to file this IPR, only after substantial litigation progress. This delay suggests tactical gamesmanship aimed at disrupting the District Court case. As recognized in the Memo regarding discretionary denials, such considerations regarding case management, efficient use of resources, and potential abuse of

process may be relevant to the denial analysis and weigh against institution here.

This factor favors denial.

Additionally, the '072 Patent is set to expire around the time of the institution decision. Instituting IPR on a patent that will be expired before the final written decision strikes at the core of inefficiency, particularly where Petitioner is pursuing the same invalidity grounds in the District Court litigation.

IV. ADDITIONAL FACTORS SET FORTH IN THE MEMORANDUM SUPPORT DISCRETIONARY DENIAL

Beyond the established frameworks of 35 U.S.C. § 325(d) and *Fintiv*, the Memo clarifies that the Director may weigh additional considerations relevant to fairness and efficiency. Several such considerations further support denying institution here.

A. Settled Expectations

The Memo notes that “settled expectations of the parties, such as the length of time the claims have been in force” may be considered. The '072 patent issued in January 2019 and relates to technology covered by a family of patents. This history, coupled with the imminent expiration of the '072 Patent, contribute to settled expectations regarding the patent's validity.

B. Imminent Patent Expiration and Efficient Resource Allocation

The Memo explicitly states that discretionary denial decisions will consider factors bearing on the efficient use of PTAB resources and overall workload

management. Instituting review of the '072 Patent, which will expire shortly, presents a clear case of inefficiency warranting denial.

The '072 Patent claims priority back to December 2004. Its term is therefore expected to expire around August 11, 2025. The institution decision in this matter is anticipated around early August 2025, and as such the patent will expire around the time of the Institution Decision. Proceeding with an IPR that will largely occur *post-expiration* is a demonstrably inefficient use of the Board's and the parties' resources. While the Board clearly has jurisdiction to do so in its discretion, committing substantial Board and party resources to adjudicate this patent under these circumstances, particularly while the same validity challenges are concurrently proceeding in the District Court Litigation, is contrary to the goals of improving PTAB efficiency and managing its workload, as highlighted in the Memo. This warrants discretionary denial.

C. Petitioner's Undue Delay and Gamesmanship

The Memo permits consideration of factors bearing on the efficient use of PTAB resources and potential abuse of process. Here, Petitioner waited years to file this IPR petition. Petitioner received notice of the '072 patent on July 28, 2021 (EX2001), yet did not file this Petition until early 2025 – a delay of over three and a half years. This IPR was filed only after substantial progress had been made in the parallel District Court litigation, including transfer, extensive motion practice, and

exchange of contentions. Such a lengthy and unexplained delay strongly suggests tactical gamesmanship aimed at disrupting the District Court case rather than seeking an efficient alternative to litigation early in the dispute. This weighs in favor of discretionary denial.

D. Petitioner’s Reliance on Expert Testimony

Significant portions of Dr. Cockburn’s declaration mirror the Petition’s language, restating arguments and assertions made by Petitioner’s counsel often nearly verbatim, without offering sufficient independent analysis, supporting data, or reasoning grounded in specific evidence beyond the Petition’s own assertions.

For example, the entirety of Ground 1 in the Petition and the corresponding section of Dr. Cockburn’s declaration are almost identical:

Petition (Pet. at 20-35)	Cockburn Decl. (LG-1003, ¶¶94-129)
[1.a] Bryant discloses or renders obvious [1.a]. LG-1005, [0007], [0032], [0036]-[0039], [0067], [0080]-[0081], FIG. 1; LG-1003, ¶¶94-97. Specifically, Bryant discloses a computer that receives files captured by and/or stored on a digital camera. LG-1005, [0007], [0032] (“images are transferred from the digital camera to a host computer”), [0038]-[0039], [0067], [0080]. The files from the digital camera include “still and motion video images.” LG-1005, [0036]. After the computer receives the transferred image files, the files are stored on the “hard drive 20 of the home computer 10” in “a default directory, such as in a ‘my collection’ directory.” LG-1005, [0081].	94. Bryant discloses or renders obvious a recording medium to store a plurality of video data. LG-1005, [0007], [0032], [0036], [0037] (“The hard drive 20 is one type of memory associated with the home computer 10. Other types of memory could alternatively be used with the home computer 10 to store downloaded image...”), [0038], [0039], [0067], [0080], [0081], FIG. 1. In particular, Bryant discloses a computer that receives files captured by and/or stored on a digital camera. LG-1005, [0007] (“transferring the first and second group of digital images, and the data identifying the first and second groups of digital images, from the digital camera to the computer”), [0032] (“the images are transferred from the digital camera to a host computer”), [0038] (“transfer images

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A POSITA would have understood that the "hard drive 20" of Bryant necessarily includes a circuitry ("recording unit," per claim 11), e.g., a hard disk controller, that serves as an intermediary between the CPU and the physical storage platter of the hard drive for "the hard drive 20 ... to store images downloaded from the digital camera." LG-1003, ¶¶95-97; LG-1005, [0037], FIG. 1. Such circuitry was well known long before the Critical Date to include in hard drives to provide buffering, error correction, servo control, etc. for writing data to the hard drive. LG-

[1.b]

Bryant discloses or renders obvious an output unit ("display monitor," "computer user interface screens") that performs the function of outputting a menu display ("user interface") for a user to select one group of video data (e.g., "All Images," "All Favorites," "Group") among a plurality of groups of video data (circled blue in FIGS. 9A-9C) by specifying a position of a character corresponding to the one group of video data. LG-1005, [0037]-[0038], [0087], [0089], [0149], [0154], FIGS. 9A-9C; LG-1003, ¶¶98-101; *see* [1.e.i], [1.f.i].

95. A POSITA would have understood that the "hard drive 20" of Bryant necessarily includes a circuitry (claim 11's "recording unit"), e.g., a hard disk controller, that serves as an intermediary between the CPU and the physical storage platter of the hard drive in order for "the hard drive 20 ... to store images downloaded from the digital camera." LG-1005, [0037], FIG. 1. Indeed, this kind of circuitry in hard drives was well known long before the Critical Date and included in hard drives to provide buffering, error correction, servo control, etc. for writing data to the hard drive.

98. Bryant discloses or renders obvious an output unit that performs the function of outputting a menu display for a user to select one group of video data (e.g., "All Images," "All Favorites," "Group") among a plurality of groups of video data (circled in blue in FIGS. 9A-9C, e.g., "All Images," "All Favorites," "Group") by specifying a position of a character ("By moving a selector 842 within a display section area 840, the user can select a display of ...") corresponding to the one

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group of video data. LG-1005, [0037]-[0038], [0087], [0089], [0149], [0154], FIGS. 9A-9C; *see also* discussion of Elements [1.e]-[1.f].

99. In particular, Bryant teaches "user interface screens" that facilitate user selection of desired video data to be played back and a "display monitor 14" that is a display device on which "images and information" are displayed "as a computer user interface screen (GUI screen)." LG-1005, [0029], [0036]-[0038], [0088]-[0090], [0149], FIGS. 1, 9A-9C. Bryant's "display monitor" is an output/display unit configured to output a menu display, as further discussed below. Bryant explains that images from a digital camera are transferred from a digital camera and stored on the computer, and then "[e]ach group of digital images is then organized as an electronic album, using the data in the local database, and is displayed on the display monitor 14." LG-1005, [0154].

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Bryant teaches "computer user interface screens" that facilitate user selection of desired video data to be played back and a "display monitor 14" that is a display device on which "images and information" are displayed "as a computer user interface screen." LG-1005, [0029], [0036]-[0038], [0088]-[0090], [0149], FIGS. 1, 9A-9C. Bryant explains that images are transferred from a digital camera and stored on the computer, and "[e]ach group of digital images is then organized as an electronic album, using the data in the local database, and is displayed on the display monitor 14." LG-1005, [0154]. Referencing Figure 9A, Bryant describes a "GUI screen 800A [that] includes an area 820 for displaying the thumbnail images," where, "[b]y moving a selector 842 within a display selection

[1.c]

Bryant discloses or renders obvious [1.c]. LG-1005, [0029], [0036]-[0038], [0080]-[0081], FIGS. 1, 3B, 9A-9C; LG-1003, ¶¶102-101. A POSITA would have understood that Bryant teaches and/or suggests reproducing the selected video data from the recording medium ("hard drive"). *Id.* Bryant discloses capturing "motion video images" with a camera and transferring them onto a computer where images can be "*viewed*, stored, retrieved and printed." LG-1005, [0003] (emphasis added), [0036]-[0038], [0080]-[0081]. A POSITA would have understood that a reason to transfer a video ("motion video image") to a user's computer is to reproduce for display and viewing (e.g., playback) the video from the recording medium when the user wants to view it. LG-1003, ¶104; LG-1005, [0036]. Moreover, a POSITA would have understood that "retrieving" an image, per Bryant, further teaches or suggests reproducing an image, especially in the case of retrieving those images for

[1.d]

Bryant discloses or renders obvious [1.d]. LG-1005, [0037]-[0039], [0088], [0098], FIG. 1; LG-1003, ¶112. A CPU motherboard is connected to the hard drive that stores the image/video files and the display monitor 14, and controls the display, by the display monitor, of thumbnails and images. LG-1005, [0038], [0088], [0098], FIG. 1. Thus, a POSITA would have understood that Bryant's

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the recording medium and

102. Bryant discloses or renders obvious a reproducing unit configured to reproduce selected video data read out from the recording medium. LG-1005,

104. A POSITA would have understood that Bryant at least renders obvious reproducing selected video data from the recording medium ("hard drive"). Specifically, Bryant describes a "digital photography system" capturing "motion video images" and loading them onto a home computer on which the images can be "*viewed*, stored, retrieved and printed." LG-1005, [0003] (emphasis added), [0036] ("still and motion video images"), [0037] ("The digital photography

[1.d] a controller,

112. Bryant discloses or renders obvious a controller. LG-1005, [0037]-[0039], [0088], [0098], FIG. 1. In particular, Bryant teaches a CPU motherboard that is connected to the hard drive that stores the image/video files and to the display monitor 14 and controls the display, by the display monitor, of thumbnails and images. LG-1005, [0038], [0088], [0098], FIG. 1. Thus, the motherboard is a controller that is "coupled to a display monitor 14," which a POSITA would have understood that the CPU motherboard controls what content is displayed by the display monitor 14. *Id.*, FIG. 1, [0038].

113. Bryant discloses or renders obvious that, when a first group of video data is selected in the menu display by specifying a position of a character corresponding to the first group of video data, the controller controls so that a first group of thumbnails corresponding to the first group of video data is displayed. LG-1005, [0088] ("In block 128 of FIG. 3, the user selects a display mode, and the

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[1.e.i]

Bryant discloses or renders obvious that, when a first group of video data (e.g., “All Favorites”) is selected in the menu display by specifying a position of a character (e.g., selecting and determining a position of a character) corresponding to the first group of video data (e.g., the user has selected “All Favorites” “[b]y moving a selector 842 within [the] display selection area”), the controller controls so that a first group of thumbnails corresponding to the first group of video data is displayed (circled red in FIG. 9B). LG-1005, [0089]-[0103], FIGS. 9A-9C; LG-1003, ¶¶113-116; *see also* LG-1001, 6:3-16.

[1.f.i]

Bryant discloses or renders obvious that, when a second group of video data (e.g., “All Images”) is selected in the menu display by specifying a position of a character (e.g., selecting and determining a position of a character) corresponding to the second group of video data (e.g., the user has selected “All Images”), the controller controls so that a second group of thumbnails corresponding to the second group of video data is displayed (circled red in FIGS. 9A for “All Images”). LG-1005, [0089]-[0103], FIGS. 9A-9C; LG-1003, ¶¶119-120; *see also* LG-1001, 5:67-68; *see* [1.e.i].

For example, Bryant discloses a local database with an assets table 600 data fields 610 for a given media object:

Given this structure—and the interfaces in FIGS. 9A-9C—a POSITA would have understood that Bryant teaches a media file can be simultaneously classified in multiple categories. LG-1003, ¶124. For example, the media file corresponding to the crane, 100_1690, is classified as a “Favorite,” as part of “Group/ 11,” and is included in “All Images.” LG-1005, FIGS. 9A-9C.

119. Bryant discloses or renders obvious that, when a second group of video data is selected in the menu display by specifying a position of a character corresponding to the second group of video data, the controller controls so that a

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second group of thumbnails corresponding to the second group of video data is displayed. LG-1005, [0089]-[0103], FIGS. 9A-9C.

123. For example, Bryant discloses a local database with general assets table 600 and a table of data fields 610 corresponding to media object 11 (652), shown below in Figure 8. LG-1005, FIG. 8.

124. As made clear by the underlying data structure as well as the interfaces shown in FIGS. 9A-9C, Bryant discloses that a given media file can be simultaneously classified in multiple categories. For example, the media file corresponding to the crane, 100_1690 (822G), is classified as a “Favorite,” as part of “Group/ 11,” and is included in “All Images.” *See* LG-1005, FIGS. 9A-9C.

The above examples are exemplary and pervade the Cockburn declaration.

Such parroting of attorney argument diminishes the weight, if any, that should be accorded to the testimony. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 (P.T.A.B. Feb. 10, 2023) (precedential) (according “little weight” to declaration testimony that contains a verbatim restatement of a petition’s conclusory assertions without additional supporting evidence or reasoning); *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1340–41 (Fed. Cir. 2020) (affirming Board decision giving no weight to expert testimony that “merely repeated Petitioner’s argument, nearly verbatim, without citation to the basis for his testimony”); *see also Wowza Media Sys., LLC v. Adobe Sys. Inc.*, IPR2013-00054, Paper 12 at 12 (P.T.A.B. Apr. 8, 2013) (“The Declaration . . . appears, for the most part, simply to track and repeat the arguments for unpatentability presented in the Petition [and] . . . is therefore no more helpful tha[n] the Petition in determining where the challenged recitation is found in the references.”). This practice raises concerns under 37 C.F.R. § 42.65(a). *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”).

Accordingly, Petitioner’s improper use of expert testimony further supports discretionary denial under 35 U.S.C. § 314(a).

E. The Board Should Reject Any Late *Sotera* Stipulation

Petitioner has not made a *Sotera*-style stipulation—that “if IPR is instituted, [Petitioner] will not pursue in the District Court Litigation any ground raised or that could have been reasonably raised in an IPR”—in its Petition, which weighs further in favor of discretionarily denying institution. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 13-14 (P.T.A.B. Dec. 1, 2020) (precedential). The Board should not accept any late *Sotera* stipulation offered after this Brief in Support of Patent Owner's Request for Discretionary Denial. Any withholding of the *Sotera* stipulation in its Petition is gamesmanship and prejudicial to Patent Owner in this proceeding, and is inconsistent with 37 C.F.R. § 42.1(b)'s mandate to “secure the just, speedy, and inexpensive resolution of every proceeding.” Indeed, Petitioner's gamesmanship in this regard prejudices Maxell because Maxell is forced to prepare overlapping validity defenses in the District Court Litigation and this proceeding throughout the pendency of this Petition.

Both the Board and the Director are clear that Petitioners cannot wait until after the Board renders its Institution Decision to address the issue of *Fintiv* and submit a *Sotera* stipulation. *NXP USA, Inc. v Impinj, Inc.*, IPR2021-01556, Paper 12, 5-6 (P.T.A.B. Aug. 25, 2022); *see also id.*, IPR2021-01556, Paper 13, 3-4 (P.T.A.B. Sept. 7, 2022) (Director Review) (finding “[p]ermitting a petitioner to wait and see if the Board denies institution under *Fintiv*, and then offer such a stipulation

for the first time on rehearing, frustrates these goals [of avoiding conflicting decisions] and would open the door to gamesmanship"). Petitioner's failure to provide a *Sotera* stipulation along with its Petition has prejudiced and continues to prejudice Maxell.

These additional factors, highlighted by recent USPTO guidance, provide further independent bases for the Director to exercise discretion and deny institution of this IPR petition.

V. CONCLUSION

For at least the foregoing reasons, the Board should deny institution of the Petition.

Dated: April 11, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 11th day of April, 2025, a copy of the attached
BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL TO PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 10,199,072, together with all exhibits was served by electronic
mail to the attorneys of record, at the following addresses:

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CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Preliminary Response and complies with the type-volume limitation of 37 CFR §42.24(a). The word count application of the word processing program used to prepare this Preliminary Response indicates that the Preliminary Response contains 6,048 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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