

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAMBRIDGE INDUSTRIES USA, INC.,

Petitioner,

v.

APPLIED OPTOELECTRONICS, INC.,

Patent Owner.

Case IPR2025-00436

Patent No. 10,313,024

**PATENT OWNER'S REQUEST TO DIRECTOR FOR DISCRETIONARY
DENIAL OF PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT 10,313,024**

(Pursuant to Director's Memorandum of March 26, 2025)

TABLE OF CONTENTS

	Page(s)
EXHIBITS	5
I. INTRODUCTION	6
II. FACTUAL BACKGROUND	7
A. The '024 Patent	7
B. The Litigation Between AOI and Petitioner	8
C. The Additional Litigation Involving the '024 Patent.....	10
D. The Petition for <i>Inter Partes</i> Review	11
III. INSTITUTION OF <i>INTER PARTES</i> REVIEW SHOULD BE DENIED PURSUANT TO THE DIRECTOR'S DISCRETION.	13
A. The Issues in the Petition Have Significant Overlap with the Issues in the Litigation.	14
B. The Parties Have Invested in the Litigation by Addressing Substantive Issues.....	16
C. There Are Settled Expectations in the '024 Patent.	17
D. Petitioner's Arguments on Unpatentability are Weak.	17
1. Ground 1: Mizobuchi Does Not Anticipate the '024 Patent Because It Fails to Disclose All the Limitations of Any Claim.	18
2. Ground 2: Akashi Does Not Anticipate the '024 Patent Because It Fails to Disclose All the Limitations of Any Claim.	20
E. The Petition Relies Almost Exclusively on the Declaration of an Expert.	22

F.	Petitioner and the Defendant Are the Same Party.....	23
G.	The Validity of the '024 Patent May Be Adjudicated by a District Court Before the PTAB's Decision Is Due if IPR is Instituted.	23
H.	There Are No Relevant Changes in the Law that Affect Patentability.....	25
I.	Petitioner Filed Petitions for IPR for Four of the Other Patents Asserted by AOI in the Litigation on the Same Date as this Petition.....	25
IV.	CONCLUSION	26

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11.....	14, 17, 23, 25
<i>Next Caller Inc. v. Trustid, Inc.</i> , IPR 2019-00963.....	16, 22, 25

Statutes

35 U.S.C. § 103.....	7, 8
35 U.S.C. § 316(a)(11).....	13

Other Authorities

PTAB’s “Consolidated Trial Practice Guide – November 2019,”	12
U.S. Patent No. 9,568,694.....	8, 12
U.S. Patent No. 10,313,024.....	<i>passim</i>
U.S. Patent Nos. 9,523,826.....	12

EXHIBITS

Exhibit No.	Description
2001	Acting Director Stewart’s March 26, 2025 Memorandum entitled “Interim Processes for PTAB Workload Management”
2002	CIG USA's Invalidity Contentions in <i>Applied Optoelectronics, Inc. v. Cambridge Industries USA, Inc.</i> , case no. 3-24-cv-01010-JD (N.D. CA)
2003	Scheduling Order in <i>Applied Optoelectronics, Inc. v. Accelight Technologies, Inc.</i> , case no. 4:24-cv-09041-HSG (N.D. CA)

I. INTRODUCTION

This request is submitted by Patent Owner Applied Optoelectronics, Inc. (“AOI”) to the Director of the United States Patent and Trademark Office (“USPTO”) pursuant to the Director’s Memorandum “Interim Processes for PTAB Workload Management” dated March 26, 2025 (the “March 26, 2025 Memorandum”, Exhibit 2001). This is AOI’s separate brief, pursuant to the March 26, 2025 Memorandum, requesting a discretionary denial of the Petition of Cambridge Industries USA, Inc. (“Petitioner” or “CIG USA”) for *inter partes* review (“IPR”) of U.S. Patent No. 10,313,024 entitled “Transmitter Optical Subassembly with Trace Routing to Provide Electrical Isolation between Power and RF Traces” (“the ’024 Patent”) (the “Petition”). This brief is timely as it is submitted within two months of the February 28, 2025 date on which the PTAB entered its Notice of Filing Date Accorded to Petition.¹

Pursuant to the March 26, 2025 Memorandum and the relevant factors, the Director should exercise their discretion and deny institution of *inter partes* review (“IPR”) of the ’024 Patent.

¹ AOI will separately file its Patent Owner’s Preliminary Response by the due date of May 28, 2025.

II. FACTUAL BACKGROUND

A. The '024 Patent

The application for the '024 Patent was filed on April 26, 2018 as application no. 15/963,246 with 17 claims, including two independent claims.

During prosecution, in a non-final Office Action mailed November 19, 2018, the Office rejected both independent claims and several dependent claims under 35 U.S.C. § 103 as obvious over U.S. Patent Application Publication No. 2005/0175350 to Hartzell in view of U.S. Patent Application Publication No. 2005/02259552 to Grebenkemper in further view of U.S. Patent Application Publication No. 2015/0162990 to Daiber. The Office rejected several dependent claims as obvious and further view of other references. The Office Action stated that claims 2-4 and 11-13 contained allowable subject matter if rewritten in independent form to include all the limitations of the base claim and any intervening claims.

On February 19, 2019, AOI filed an amendment amending the two independent claims to add limitations from dependent claims and canceling the dependent claims, and adding a new independent claim and two new dependent claims. A Notice of Allowance was mailed on March 26, 2019, allowing all pending claims. The Notice of Allowance contained a notice of allowability, but

did not set forth the reasons for allowance.

The '024 Patent issued on June 4, 2019, with 17 claims, including three independent claims.

B. The Litigation Between AOI and Petitioner

On February 20, 2024, AOI filed a lawsuit against Petitioner for patent infringement entitled *Applied Optoelectronics, Inc. v. Cambridge Industries, Inc.*, case no. 3:24-cv-01010-JD (N.D. CA) (the “Litigation”). The complaint alleges that Petitioner infringes eight of AOI’s patents, including the '024 Patent. AOI filed a First Amended Complaint on April 25, 2024.

On May 16, 2024, the parties exchanged initial disclosures. On June 6, 2024, AOI served its infringement contentions, stating that Petitioner infringes claims 1-4, 7, 8, 10-12, and 14-17 of the '024 patent. On October 15, 2024, Petitioner served its amended invalidity contentions. Exhibit 2002. Petitioner’s contentions stated that claims 1-4, 7, 8, 10-12, and 14-17 are invalid under either § 102 or § 103 on four grounds, the following grounds of which are relevant here: (1) anticipated by or obvious over U.S. Patent No. 9,568,694 to Mizobuchi; and (2) anticipated by or obvious over U.S. Patent Application Publication No. 2014/0140665 to Akashi.

On August 8, 2024, the District Court entered its scheduling order setting the

following pre-trial dates: a claim construction hearing on April 10, 2025, fact discovery cut-off on September 29, 2025, expert discovery cut-off on December 29, 2025, dispositive motion cut-off on January 28, 2026, and pre-trial conference on May 21, 2026. The court set a jury trial for June 8, 2026.

On November 7, 2024, Petitioner filed its answer and counterclaims against AOI. In its counterclaims, Petitioner alleges that each of the eight patents-in-suit is invalid. On November 15, 2024, AOI filed its answer to the counterclaims.

Pursuant to the District Court's Scheduling Order, between October 2024 and March 2025, AOI and Petitioner exchanged proposed terms for claim construction, exchanged preliminary claim constructions and extrinsic evidence, filed a joint claim construction statement and pre-hearing statement, exchanged damage contentions, and filed opening, responsive, and reply claim construction briefs.

On March 19, 2025, AOI and Petitioner jointly filed a Notice to Court of Filing of Petitions for *Inter Partes* Review, informing the District Court that Petitioner had filed petitions for IPR of five of the eight patents-in-suit. On April 4, 2025, the District Court issued an order staying the case pending further order, vacating the claim construction hearing set for April 10, 2025, and requiring the parties to file joint status reports on the status of the PTAB proceedings every 90

days beginning on July 7, 2025.

C. The Additional Litigation Involving the '024 Patent

In addition to the litigation against Petitioner, AOI has filed another patent infringement suit against another defendant, Accelight Technologies, Inc., entitled *Applied Optoelectronics, Inc. v. Accelight Technologies, Inc.*, case no. 4:24-cv-09041-HSG (N.D. CA). The complaint, filed on December 13, 2024, alleges infringement of the '024 Patent and five other AOI patents. Of the five other patents in the *Accelight* case, four are also the subject of the Litigation, and those four are the subject of separate petitions for IPR that Petitioner filed on January 17, 2025, the same day that Petitioner filed the Petition that is the subject of this request.² Thus, the Litigation with Petitioner and the *Accelight* case share five patents-in-suit, all of which are the subject of separate petitions for IPR that Petitioner filed in January 2025.

On March 28, 2025, AOI and defendant Accelight jointly filed a Notice to Court of Filing of Petitions for *Inter Partes* Review, informing the District Court

² AOI is filing Requests to the Director for Discretionary Denial of Petitioner's other four Petitions for IPR on grounds similar to this Request on the same day as this Request is filed.

that Petitioner had filed petitions for IPR of five of the six patents-in-suit. In the Joint Case Management Statement, defendant Accelright stated that one of the issues in the case was whether the asserted claims of the patents-in-suit were invalid. At the case management conference held on April 22, 2025, the court indicated that the case would move forward, and stated that it would set claim construction deadlines.

On April 23, 2025, the court entered a Scheduling Order which set the following dates: invalidity contentions and documents on May 30, 2025; exchange of proposed terms for claim construction on June 13, 2025; exchange of preliminary constructions and extrinsic evidence on July 7, 2025; damages contentions on July 22, 2025; a Joint Claim Construction Statement and Prehearing Statement to be filed on July 30, 2025; claim construction discovery cut-off on August 29, 2025; opening, responsive, and reply claim construction briefs to be filed on September 16, 2025, September 30, 2025, and October 7, 2025, respectively; a technical tutorial on October 17, 2025; and a claim construction hearing on October 31, 2025. See Exhibit 2003.

D. The Petition for *Inter Partes* Review

On January 17, 2025, 11 months after AOI filed its complaint in the Litigation and seven months after AOI served its infringement contentions in the

Litigation, Petitioner filed its Petition for IPR of the '024 Patent, PTAB Case IPR2025-436. On the same date, Defendant also filed petitions for IPR of four of the other AOI patents-in-suit: U.S. Patent Nos. 9,523,826; 10,788,690; 10,379,301; and 10,042,116.

In the Petition for IPR of the '024 patent, Petitioner challenges claims 1-4, 7, 8, 10-12, and 14-17. Petitioner asserts two grounds of invalidity: (1) that claims 1-17 are anticipated by U.S. Patent No. 9,568,694 to Mizobuchi; and (2) that claims 1-17 are anticipated by U.S. Patent Application Publication No. 2014/0140665 to Akashi.

The Petition relies on the 68-page declaration of Petitioner's expert, Dr. Andrew G. Kirk. Petitioner's other four petitions for IPR of the other four patents also rely on a declaration of Dr. Kirk.

On February 28, 2025, the PTAB issued its Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper 3).

Pursuant to the Notice of Filing Date, Patent Owner's Preliminary Response is due three months from the Notice date, by May 28, 2025. Pursuant to the PTAB's "Consolidated Trial Practice Guide – November 2019," the PTAB will determine whether to institute an IPR within three months of the date the Patent Owner's Preliminary Response was filed or was due, by about August 28, 2025.

Pursuant to 35 U.S.C. § 316(a)(11), the PTAB will set the trial date for the IPR within one year of the notice of institution, no later than about August 28, 2026.

III. INSTITUTION OF *INTER PARTES* REVIEW SHOULD BE DENIED PURSUANT TO THE DIRECTOR'S DISCRETION.

The Director should exercise their discretion pursuant to the Memorandum of March 26, 2025 and deny institution of IPR on the '024 Patent. The following factors support a discretionary denial:

- There is significant overlap between the issues in the Petition and in the Litigation. Many of the same claims are challenged, and some of the grounds, the key art, and the arguments are substantially the same in the Petition as in the Litigation. All of the art relied upon in the Petition is also relied upon by Petitioner in the Litigation.
- There has been significant investment in the Litigation in that substantive issues have already been addressed by the parties.
- There are settled expectations in the enforcement of the '024 Patent in that the patent has been in force for over five years.
- Petitioner's arguments on unpatentability are weak.
- The Petition relies heavily on the declaration of an expert.
- Petitioner and the defendant are the same party.

- The '024 Patent is one of the patents-in-suit in the Additional Litigation between AOI and defendant Accelight, and claim construction and the validity of the '024 Patent may well be adjudicated before the PTAB's decision in an IPR would be due.
- There are no relevant changes in the law that affect patentability.
- Four of the other five patents asserted by AOI in the Litigation are each the subject of an IPR filed by Petitioner on the same date as this Petition.

Each of these factors is discussed separately below in sections A through I.

A. The Issues in the Petition Have Significant Overlap with the Issues in the Litigation.

The Director may consider whether there is significant overlap between the issues raised in the Petition and in the Litigation. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, p. 6 (March 20, 2020) (precedential). “[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.”

Here, there is significant overlap in the issues raised in the Petition and in the Litigation.

First, many of the same claims are challenged in the Petition (claims 1-17) as are challenged in the Litigation (claims 1-4, 7, 8, 10-12, and 14-17).

Second, all of the art relied upon in the Petition (Wu and Mizue) is relied upon in the Litigation. The art at issue in the Petition is a subset of the art at issue in the Litigation.

Third, the two grounds for invalidity in the Petition are the same or substantially the same as two of the several grounds asserted in the Litigation. In the Petition, Petitioner argues that claims 1-17 are anticipated by Mizobuchi; in the Litigation, Petitioner argues that claims 1-4, 7, 8, 10-12, and 14-17 are anticipated by or obvious over Mizobuchi. In the Petition, Petitioner argues that claims 1-17 are anticipated by Akashi; in the Litigation, Petitioner argues that claims 1-4, 7, 8, 10-12, and 14-17 are anticipated by or obvious over obvious over Akashi.

Fourth, the arguments in the Petition are substantially the same as the arguments in the Litigation. Petitioner's arguments as to where the claim limitations are found in the prior art, on a limitation-by-limitation basis, are essentially the same in both proceedings. This is demonstrated by a comparison of the Declaration of Andrew G. Kirk in Support of Petition (pp. 32-50 as to Mizobuchi and pp. 50-67 as to Akashi) filed in the PTAB with Petitioner's Amended Invalidity Contentions and claim charts filed in the Litigation (Exhibit 2002, Ex. A-2 as to Mizobuchi and Ex. A-3 as to Akashi).

Thus, there is significant overlap in the challenged claims, the grounds, the art, and the arguments. Moreover, the Litigation involves one other reference and one additional ground not asserted in the Petition. And the Litigation also involves seven other patents. Thus, the issues in the Petition are essentially a subset of the issues in the Litigation; meaning that the Litigation will need to go forward regardless of whether IPR is instituted. The fact that the Litigation involves an additional challenge to the '024 Patent weighs in favor of a denial. See, *Next Caller Inc. v. Trustid, Inc.*, IPR 2019-00963, Paper 8, p. 12 (October 28, 2019) (informative).

Accordingly, this factor favors denial of institution.

B. The Parties Have Invested in the Litigation by Addressing Substantive Issues.

Pursuant to the District Court's Scheduling Order, between October 2024 and March 2025, AOI and Petitioner exchanged proposed terms for claim construction, exchanged preliminary claim constructions and extrinsic evidence, filed a joint claim construction statement and pre-hearing statement, exchanged damage contentions, and filed opening, responsive, and reply claim construction briefs.

Thus, the parties have spent significant time and effort in conducting discovery, in the claim construction process, and in briefing claim construction.

This factor weighs in favor of denial of institution.

C. There Are Settled Expectations in the '024 Patent.

The '024 Patent was issued on June 4, 2019. The patent has been in force for over five years. Thus, there are settled expectations of the parties that the '024 Patent is valid and enforceable.

This factor weighs in favor of denial of institution. See, Director's March 26, 2025 Memorandum, Exhibit 2001, p. 2.)

D. Petitioner's Arguments on Unpatentability are Weak.

The Director may consider the strength of the petitioner's unpatentability challenge in determining whether to discretionarily deny institution of IPR. Director's March 26, 2025 Memorandum, Exhibit 2001, p. 2; *Apple Inc. v. Fintiv, Inc.*, *supra*, pp. 14-15. If the merits are a "close call," that fact weighs in favor of denying institution if other factors favoring denial are present. *Id.* at p. 15.

Here, Petitioner alleges anticipation based on Mizobuchi (Ground 1) and anticipation based on Akashi (Ground 2). However, Petitioner is unlikely to succeed on the merits under either Ground 1 or Ground 2 because neither reference discloses all the limitations of any claim of the '024 Patent.³

³ For purposes of this Request to the Director for Discretionary Denial, AOI will

1. Ground 1: Mizobuchi Does Not Anticipate the '024 Patent Because It Fails to Disclose All the Limitations of Any Claim.

Independent claims 1, 12, and 15 all include the limitation requiring “a light engine driving circuit disposed on the substrate.” Claims 2-11 depend from claim 1. Claims 13-14 depend from claim 12. Claims 16-17 depend from claim 15. Therefore, all of the claims 1-17 include the requirement for “a light engine driving circuit disposed on the substrate.”

Petitioner states a first circuit board in Mizobuchi defines the claimed substrate, and Petitioner identifies the first circuit board in annotations to FIG. 2 (Mizobuchi). *See* Petition pp. 18-19. Petitioner further states that “[t]he substrate defined by the first circuit board carries a light engine driving circuit,” and allegedly identifies the light engine driving circuit in annotations to FIG. 2 (Mizobuchi). *See Id.* In addition, Petitioner states that “Mizobuchi discloses a light

only discuss a few specific examples of limitations the cited references fail to disclose.

engine driving circuit disposed on the substrate that includes a clock data recovery (“CDR”) circuit and a power supply circuit.”

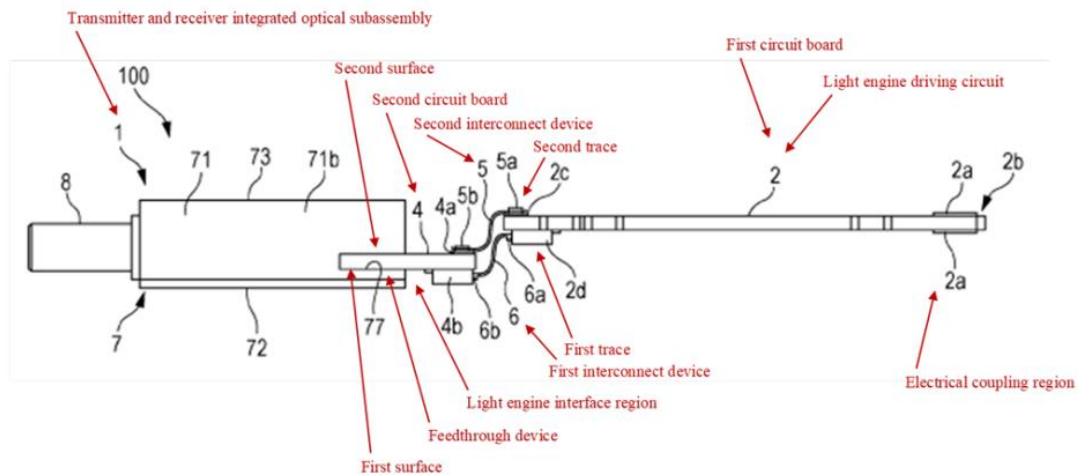


FIG. 2 (Mizobuchi)

Mizobuchi discloses that the first circuit board 2 includes a clock data recovery (CDR) circuit [and] a power supply circuit. *See* Mizobuchi, col. 3, l. 57-59. However, the clock data recovery circuit and power supply circuit are not the claimed “light engine driving circuit.” Instead, the light engine driving circuit in Mizobuchi is not on the substrate as Petitioner argues. The light engine driving circuit is the driver integrated circuit (IC) 14, which is inside the housing 7 of the transmitter and receiver integrated optical sub-assembly 1 as shown in FIG. 2 (Mizobuchi) above and FIG. 3A (Mizobuchi) below (annotations by Petitioner). *See* Mizobuchi col. 5, l. 43-53 and FIGS. 2 and 3a. As shown in the specification and figures, the transmitter and receiver integrated optical sub-assembly is not part

of the claimed substrate identified by the Petitioner. *See Id.*

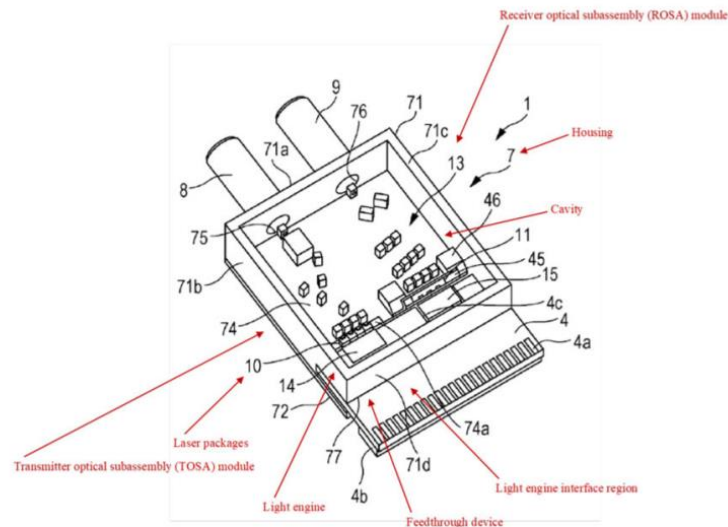


FIG. 3A (Mizobuchi)

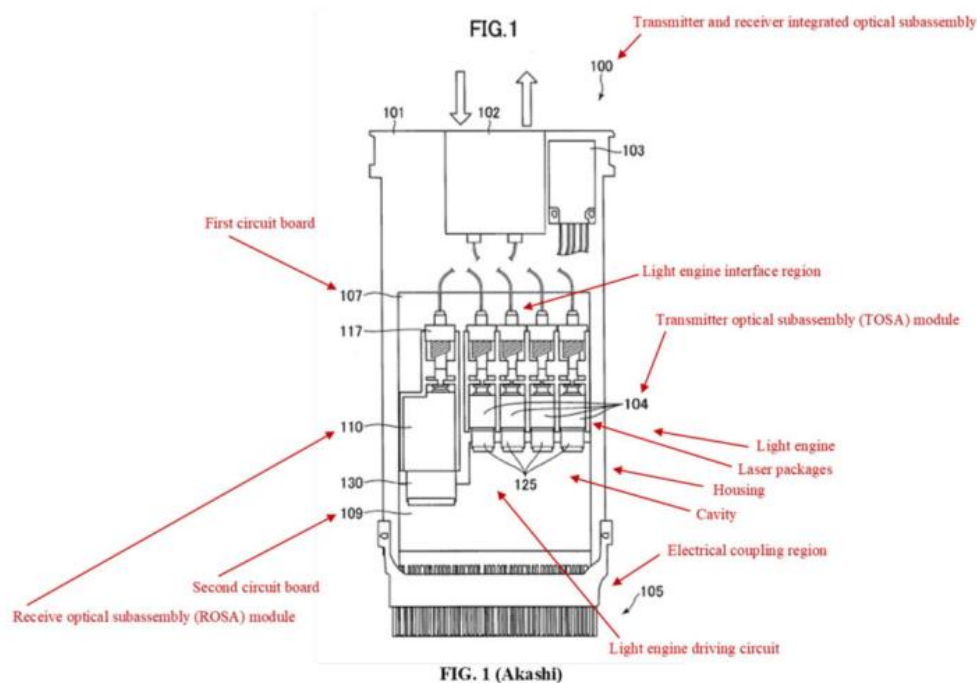
As a result, Mizobuchi does not disclose a “a light engine driving circuit disposed on the substrate” as required by claims 1-17 of the ’024 Patent.

Therefore, Petitioner is unlikely to succeed on the merits as to Ground 1.

2. Ground 2: Akashi Does Not Anticipate the ’024 Patent Because It Fails to Disclose All the Limitations of Any Claim.

First, independent claims 1, 12, and 15 all include the limitation requiring “a light engine driving circuit disposed on the substrate.” Claims 2-11 depend from claim 1. Claims 13-14 depend from claim 12. Claims 16-17 depend from claim 15. Therefore, all of the claims 1-17 include the requirement for “a light engine driving circuit disposed on the substrate.”

Petitioner identifies first circuit board 107 as the claimed substrate. *See* Petition at p. 30 and Petitioner’s annotated version of Akashi’s FIG. 1 at pp. 29, 33. Petitioner then points to an empty portion of first circuit board 107 and relies on expert testimony to say that “[a] POSITA would have understood that Akashi discloses a light engine driving circuit on the substrate 107.” *Id.* Akashi, however, does not disclose a light engine driving circuit disposed on the substrate and pointing to an empty portion of a circuit board does not satisfy the claim limitation.



Second, independent claims 1, 12, and 15 all include the limitation requiring “a light engine interface region for electrically coupling with the hermetically-sealed light engine.” Claims 2-11 depend from claim 1. Claims 13-14 depend from

claim 12. Claims 16-17 depend from claim 15. Therefore, all of the claims include the requirement for “a light engine interface region for electrically coupling with the hermetically-sealed light engine.”

Petitioner states that the first circuit board 107 includes “a light engine interface region (adjacent to optical connector 117). See Petition at p. 30 and Petitioner’s annotated version of Akashi’s FIG. 1 at pp. 29, 33. However, the region pointed to by Petitioner is the region containing optical fibers. The signals in that region are optical signals, not electrical signals. Claims 1-17 require that the light engine interface region is for electrically coupling, not optically coupling.

As a result, Petitioner has not identified the claimed light engine interface region.

Therefore, for at least these reasons, Petitioner is unlikely to succeed on the merits as to Ground 2.

E. The Petition Relies Almost Exclusively on the Declaration of an Expert.

An over-reliance on expert testimony may weigh in favor of discretionary denial of an IPR. See, *Next Caller Inc.*, *supra*, p. 14 (informative); see also, Director’s March 26, 2025 Memorandum, Exhibit 2001, p. 2. The Petition is based almost exclusively on the Declaration of Andrew Kirk, Petitioner’s expert (Exhibit 1003 to the Petition). As can be seen from the Petition, every limitation of every

challenged claim cites to Exhibit 1003 (see Petition, pp. 17-28 for Mizobuchi and pp. 29-41 for Akashi), and the Declaration of Dr. Kirk discusses every limitation of every claim (see Kirk Declaration, Ex. 1003, pp. 32-50 for Mizobuchi and pp. 50-67 for Akashi).

Accordingly, this factor weighs in favor of denial.

F. Petitioner and the Defendant Are the Same Party.

Here, the fact that Petitioner and the Defendant in the Litigation are the same party weighs in favor of denial of institution. See *Apple Inc. v. Fintiv, Inc.*, *supra*, pp. 13-14.

G. The Validity of the '024 Patent May Be Adjudicated by a District Court Before the PTAB's Decision Is Due if IPR is Instituted.

The Director may consider whether another forum has already adjudicated the validity of the challenged claims in determining whether to discretionarily deny institution of IPR. Director's March 26, 2025 Memorandum, Exhibit 2001, p. 2.

Here, the '024 Patent is one of the patents-in-suit in the Additional Litigation between AOI and defendant Accelight, filed on December 13, 2024. As noted above, five of the six patents-in-suit in the Additional Litigation are also in suit in the Litigation with Petitioner and are the subject of petitions for IPR filed by Petitioner.

In the Additional Litigation, the District Court has ordered the case to move forward, despite the parties' notifying the court that five of the six patents-in-suit are the subject of petitions for IPR filed by Petitioner. On April 23, 2025, the court entered a Scheduling Order which set all of the dates pertaining to claim construction between June 2025 and October 2025 (exchange of proposed terms, exchange of preliminary constructions and extrinsic evidence, damages contentions, a Joint Claim Construction Statement and Prehearing Statement, claim construction discovery cut-off, opening, responsive, and reply claim construction briefs, and a technical tutorial), and set a claim construction hearing on October 31, 2025. *See*, Exhibit 2003.

Defendant Accelight has stated that the validity of the asserted claims of the patents-in-suit is in issue and that it will be taking discovery on invalidity. The court has set invalidity contentions and documents due on May 30, 2025.

Thus, the validity of the '024 Patent may well be adjudicated in the Additional Litigation before the PTAB's decision in an IPR, which would be due on or about August 28, 2026 if IPR is instituted. Accordingly, this factor weighs in favor of denial.

H. There Are No Relevant Changes in the Law that Affect Patentability.

There have been no changes in the law or judicial precedent regarding patentability since the '024 Patent issued. Accordingly, this factor weighs in favor of denial of institution. *See*, Director's March 26, 2025 Memorandum, Exhibit 2001, p. 2.

I. Petitioner Filed Petitions for IPR for Four of the Other Patents Asserted by AOI in the Litigation on the Same Date as this Petition.

The Director may consider all relevant circumstances in determining whether to discretionarily deny institution of IPR. Director's March 26, 2025 Memorandum, p. 3; *Apple Inc. v. Fintiv, Inc.*, *supra*, p. 14. The Litigation involves eight AOI patents, five of which are the subject of petitions for IPR filed by Petitioner, including the '024 Patent. These facts indicate that Litigation will need to go forward regardless of the petitions for IPR. Therefore, it would be more efficient for the validity of the '024 Patent to be resolved in the Litigation, and the PTAB could conserve its resources by denying institution. *See, Next Caller Inc.*, *supra*, p. 14, fn. 13, with similar facts (informative). Therefore, this factor weighs in favor of denial.

IV. CONCLUSION

For the reasons set forth above, the Director should exercise their discretion pursuant to the Memorandum of March 26, 2025 and deny institution of IPR on the '024 Patent.

Dated: April 28, 2025

/Jo Dale Carothers/
Jo Dale Carothers (Reg. No. 74,180)
Weintraub Tobin Law Corporation
400 Capitol Mall, 11th Floor
Sacramento, CA 95814
Phone: 858.436.8152
Fax: 916.446.1611
Email: jcarothers@weintraub.com

CERTIFICATE UNDER 37 C.F.R. SECTION 42.24

AOI certifies that the word count in this Request, as determined by the Microsoft Word word-processing system is 3,870 words. This Request is in compliance with the 14,000-word limit pursuant to the Director's Memorandum of March 26, 2025 and 37 C.F.R. §42.24.

Dated: April 28, 2025

/Jo Dale Carothers/

Jo Dale Carothers (Reg. No. 74,180)

Weintraub Tobin Law Corporation

400 Capitol Mall, 11th Floor

Sacramento, CA 95814

Phone: 858.436.8152

Fax: 916.446.1611

Email: jcarothers@weintraub.com

CERTIFICATE OF SERVICE

The undersigned hereby certifies service on the Petitioner, pursuant to 37 C.F.R. §42.6(e) and by agreement of counsel, by electronic (e-mail) delivery of a true copy of the foregoing **PATENT OWNER'S REQUEST TO DIRECTOR FOR DISCRETIONARY DENIAL OF PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT 10,313,024 (Pursuant to Director's Memorandum of March 26, 2025)**, which was served on April 28, 2025 to the following Counsel for Petitioner via e-mail:

Nicola A. Pisano
Eversheds Sutherland LLP
12255 Camino Real, Suite 100
San Diego, CA 92130-2071
nicolapisano@eversheds-sutherland.com

Regis Worley
Eversheds Sutherland LLP
12255 Camino Real, Suite 100
San Diego, CA 92130-2071
regisworley@eversheds-sutherland.com

/Eric Caligiuri/
Eric Caligiuri (Reg. No. 58,121)
Weintraub Tobin Law Corporation
400 Capitol Mall, 11th Floor
Sacramento, CA 95814
Phone: 858.436.3140
Fax: 916.446.1611
Email: ecaligiuri@weintraub.com