

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

CORETRONIC CORPORATION and
OPTOMA CORPORATION,
Petitioners,

v.

MAXELL, LTD.,
Patent Owner.

Case No.: IPR2025-00474

U.S. Patent No. 8,593,580

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

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL SHOULD BE REJECTED	2
A.	The <i>Fintiv</i> Factors Do Not Support Discretionary Denial	2
1.	Status of Motion to Stay (Factor 1)	2
2.	Proximity of the District Court Trial Date (Factor 2)	4
3.	Investment in the Parallel Proceeding (Factor 3)	6
4.	Overlap of Issues (Factor 4).....	8
5.	Same Parties (Factor 5).....	10
6.	Other Circumstances (Factor 6).....	11
B.	Factors Set Forth in the March 26, 2025 Memorandum Do Not Support Denial.....	14
1.	The Petition is Properly Supported by Dr. Sasian’s Declaration	15
III.	CONCLUSION.....	16

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 15 (PTAB May 13, 2020)	<i>passim</i>
<i>Apple Inc. v. Maxell, Ltd.</i> , IPR2020-00200, Paper 11 (PTAB July 15, 2020)	9
<i>Apple Inc. v. Seven Networks, LLC</i> , IPR2020-00157, Paper 10 (PTAB June 15, 2020)	9
<i>Dish Network LLC v. Broadband iTV, Inc.</i> , IPR2020-01359, Paper 15 (PTAB Feb. 12, 2021)	4
<i>Green Revolution Cooling, Inc. v. Midas Green Technologies, LLC</i> , IPR2025-00196, Paper 7 (PTAB May 23, 2025)	5
<i>Head Sport GMBH v. Vermont Safety Developments LLC</i> , IPR2024-01099, Paper 15 (PTAB Jan. 15, 2025)	12, 13
<i>Liberty Energy, Inc. et al. v. U.S. Well Services, LLC</i> , IPR 2025-00031	8
<i>Markforged Inc. v. Continuous Composites, Inc.</i> , IPR2022-00679, Paper 7 (PTAB Oct. 25, 2022)	8
<i>Maxell, Ltd. v. Coretronic Corp.</i> , No. 5:24-cv-00088-RWS-JBB (E.D. Tex.)	1, 9
<i>MediaTek Inc. v. Daedalus Prime LLC</i> , IPR2025-00100, Paper 10 (PTAB May 19, 2025)	4
<i>Micron Tech., Inc. v. Yangtze Memory Techs. Co., Ltd.</i> , IPR2025-00034, Paper 19 (PTAB May 16, 2025)	10
<i>Nikon Corp. et al. v. Optimum Imaging Techs., LLC</i> , IPR2024-01374, Paper 19 (PTAB April 29, 2025)	3
<i>Optoma Tech. Inc. v. Maxell Ltd.</i> , No. 3:24-cv-08147-TLT, Dkt. 49 (N.D. Cal.)	5

<i>Samsung Elecs. Co., Ltd. et al. v. Mullen Indus. LLC,</i> IPR2025-00021, Paper 14 (PTAB May 14, 2025)	4, 10
<i>Sand Revolution II, LLC v. Cont’l Intermodal Grp. - Trucking LLC,</i> IPR2019-01393, Paper 24 (PTAB June 16, 2020)	7
<i>Sotera Wireless, Inc. v. Masimo Corp.,</i> IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020)	9, 10, 14, 15
<i>TCL Elecs. Holdings Ltd. v. Maxell, Ltd.,</i> IPR2025-00120, Paper 9 (PTAB May 20, 2025)	10, 14
<i>Trover Grp., Inc. v. Dedicated Micros USA,</i> No. 2:13-CV1047-WCB, 2015 WL 1069179 (E.D. Tex. Mar. 11, 2015) (Bryson, J.).....	2
<i>Viavi Sols. Inc. v. Zhejiang Crystal-Optech Co.,</i> No. 2:21-CV-00378-JRG, 2022 WL 16856099 (E.D. Tex. Nov. 10, 2022)	3
<i>VMWare, Inc. v. Intell. Ventures II LLC,</i> IPR2020-00859, Paper 13 (PTAB Nov. 5, 2020).....	3
<i>Williamson v. Citrix Online,</i> 792 F.3d 1339 (Fed. Cir. 2015) (en banc)	11, 12
<i>Xerox Corp. v. Bytemark, Inc.,</i> IPR2022-00624, Paper 12 (PTAB Feb. 10, 2023).....	15
<i>Zynga Inc. v. IGT,</i> IPR2022-00368, Paper 7 and 10 (PTAB July 8, 2022)	6

Statutes

35 U.S.C. § 112, paragraph 6.....	11
35 U.S.C. § 314(a)	1, 2
35 U.S.C. § 315(b)	14
35 U.S.C. § 315(e)(2).....	10

Other Authorities

37 C.F.R. § 42.104(b)(3).....	12
https://www.uspto.gov/patents/ptab/precedential-informative-decisions	12

I. INTRODUCTION

Petitioners Coretronic Corporation and Optoma Corporation (“Petitioners”) respectfully submit this Opposition to Patent Owner Maxell, Ltd.’s (“Patent Owner”) Request for Discretionary Denial of the Petition for *inter partes* review (“IPR”) of U.S. Patent No. 8,593,580 (“the ’580 Patent”). Patent Owner’s request, filed on May 12, 2025, seeks to avoid a merits-based review of the Petition’s well-supported grounds of unpatentability under 35 U.S.C. § 314(a), as well as the March 26, 2025 Acting Director’s Memorandum (“Memo”). Patent Owner’s arguments lack merit and therefore discretionary denial is unwarranted.

The Petition, filed on January 29, 2025, challenges claims 1, 3-11, 17, 18, and 32-38 of the ’580 Patent based on eight grounds, relying on prior art such as Ishino, Erchak, Li ’415, Bakker, and Uchiyama, which reveal significant deficiencies in the patentability of the challenged claims. Petitioners have not been involved in any previous review of the ’580 Patent, and the Office has not previously considered the cited references or their combinations. The *Fintiv* factors do not favor denial, as the parallel district court litigation in *Maxell, Ltd. v. Coretronic Corp.*, No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) remains at an early stage, with Petitioners committing to file a motion to stay upon institution and offering a *Sotera*-style stipulation to eliminate overlap between the two proceedings. Further, the additional factors set forth in the Memo, including the strength of the unpatentability challenges and the

propriety of expert testimony, further support institution. Accordingly, the Board should reject Patent Owner's request and institute trial in this proceeding.

II. PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL SHOULD BE REJECTED

A. The *Fintiv* Factors Do Not Support Discretionary Denial

Patent Owner argues that the Board should exercise discretion under 35 U.S.C. § 314(a) and *Fintiv* to deny institution due to parallel district court litigation. However, a comprehensive analysis of the *Fintiv* factors shows that discretionary denial is unwarranted. The parallel litigation is not sufficiently advanced to prejudice efficient resolution by the Board, and Petitioners' proactive measures mitigate any potential overlap or inefficiency.

1. Status of Motion to Stay (Factor 1)

Patent Owner asserts that no stay has been requested in the district court litigation and surmises that such a request "should fail." Paper 6 at 4-5. This argument is both speculative and premature. As of the date of this Opposition, fact discovery is ongoing with a deadline of August 7, 2025 (EX2003), and no final pretrial conference, trial preparations, or substantive rulings have occurred.

Requesting a stay of the district court proceedings pending an IPR that has not been instituted is premature. *See Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (Bryson, J.) ("In this district . . . it is the universal practice" to deny stay requests before the

PTAB has acted on a petition for review); *Viavi Sols. Inc. v. Zhejiang Crystal-Optech Co.*, No. 2:21-CV-00378-JRG, 2022 WL 16856099, at *5 (E.D. Tex. Nov. 10, 2022) (“It is the Court’s established practice to consider that motions to stay pending IPR proceedings which have not been instituted are inherently premature and should be denied as such.”).

In addition, Petitioners will promptly file a motion to stay the parallel litigation upon institution of this IPR. Courts frequently grant such stays, and the Board has not found that this factor weighs against institution where a Patent Owner offers only self-serving conjecture. *See, e.g., VMWare, Inc. v. Intell. Ventures II LLC*, IPR2020-00859, Paper 13 at 12 (PTAB Nov. 5, 2020) (“In the absence of any evidence specific to this case, we decline to speculate about the presiding judge’s inclinations.”) (*citing Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative) (“We decline to infer, based on actions taken in different cases with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here.”)); *Nikon Corp. et al. v. Optimum Imaging Techs., LLC*, IPR2024-01374, Paper 19 at 10 (PTAB April 29, 2025) (“We will not attempt to predict how the court in the parallel district court proceedings would proceed if a stay is requested because the court may determine whether or not to stay any individual case based on a variety of circumstances and facts beyond our control and to which the Board is not privy.”) (*citing Sand Revolution II, LLC v.*

Cont'l Intermodal Grp. - Trucking LLC, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative)); *MediaTek Inc. v. Daedalus Prime LLC*, IPR2025-00100, Paper 10 at 27 (PTAB May 19, 2025) (“The Board’s decision in [*Fintiv*] cautions against speculating whether the district court would grant a stay if one were requested. Therefore, this factor has a neutral effect on the overall balancing of the *Fintiv* factors.”); *Samsung Elecs. Co., Ltd. et al. v. Mullen Indus. LLC*, IPR2025-00021, Paper 14 at 8-9 (PTAB May 14, 2025) (“Given that the district court denied Samsung’s motion to stay ‘WITHOUT PREJUDICE to refiling of the same within fourteen (14) days following the PTAB’s institution decision on the last of the pending IPRs’ . . . we decline to speculate whether the district court will grant a stay. Thus, we find that factor 1 is neutral.”) Patent Owner provides no evidence specific to this case of judicial resistance to a stay. Thus, this factor is neutral.

2. Proximity of the District Court Trial Date (Factor 2)

Patent Owner contends that the scheduled trial date of March 23, 2026, over five months before the statutory Final Written Decision deadline of September 10, 2026, favors denial. Paper 6 at 5-7. However, this timeline provides the Board with sufficient opportunity to issue a decision before trial, aligning with the America Invents Act’s (AIA) goal of efficient patentability resolution since “the currently scheduled trial date is more than nine months away and much can change during this time.” *Dish Network LLC v. Broadband iTV, Inc.*, IPR2020-01359, Paper 15 at 15

(PTAB Feb. 12, 2021) (granting institution). As stated above, Petitioners will promptly file a motion to stay the parallel litigation upon institution of this IPR. If the motion to stay is granted, the trial date will be after the deadline for a Final Written Decision.

The Petition also cites median disposition times in the Eastern District of Texas that suggest a potential trial around May 2026 (Pet. at 8-9), preceding the statutory Final Written Decision deadline here by only three to four months.¹ Patent Owner’s dismissal of this statistical evidence as speculative overlooks the Board’s reliance on such data. *See Green Revolution Cooling, Inc. v. Midas Green Technologies, LLC*, IPR2025-00196, Paper 7 at 11 (PTAB May 23, 2025) (“We ‘may consider any evidence that the parties make of record that bears on the proximity of the district court’s trial date . . . , including *median time-to-trial statistics for civil actions in the district court* in which the parallel litigation resides.”) (quoting Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” issued on March 24, 2025, by Chief APJ Boalick) (emphasis in original).

¹ Petitioners filed a motion to transfer the district court case to the Northern District of California, where they had filed a declaratory judgment action and trial was scheduled for July 2027, well after the Final Written Decision deadline. *See Optoma Tech. Inc. v. Maxell Ltd.*, No. 3:24-cv-08147-TLT, Dkt. 49 (N.D. Cal.). Although the motion was denied, Petitioners plan to file a petition for writ of mandamus with the Federal Circuit.

Moreover, Patent Owner overstates its argument that this factor “strongly favors discretionary denial.” Paper 6 at 7. In similar cases where the scheduled trial date is five months before the statutory Final Written Decision deadline but subject to change, the Board has found that this factor only weighs “slightly in favor of discretionary denial.” *Zynga Inc. v. IGT*, IPR2022-00368, Paper 7 and 10 (PTAB July 8, 2022). Such is the case here.

3. Investment in the Parallel Proceeding (Factor 3)

Patent Owner argues that investment in the district court litigation, including a Markman hearing on May 9, 2025, and ongoing discovery, weighs against institution. Paper 6 at 7-9. However, as of the anticipated institution decision date (September 10, 2025), the parallel litigation will remain in its early stages. Fact discovery closes on August 7, 2025 and expert discovery closes on October 9, 2025 (EX2003), and no dispositive motions (beyond the pending 12(b) motions) or trial preparations have been completed. Petitioners just filed their answers to the complaint on June 2, 2025, no depositions relating to the ‘580 Patent or accused products have been taken, no expert reports have been exchanged, and the court has not engaged in claim construction beyond conducting a Markman hearing, with document production still ongoing. Thus, this case stands in stark contrast to *Motorola Sols., Inc. v. Stellar, LLC* cited by Patent Owner, where extensive expert discovery and trial preparation had occurred. The court’s denial of Petitioners’

motion to transfer (EX2005) and related dismissals (EX2006) reflect routine case management, not “significant investment” in the parallel proceeding. In *Sand Revolution II*, the Board observed that “aside from the district court’s Markman Order, much of the district court’s investment relates to ancillary matters untethered to the validity issue itself. . . . Also, we recognize that much work remains in the district court case as it relates to invalidity: fact discovery is still ongoing, expert reports are not yet due, and substantive motion practice is yet to come. Thus, although the parties and the district court have invested effort in the related district court litigation to date, further effort remains to be expended in this case before trial.” IPR2019-01393, Paper 24 at 10-11 (finding factor 3 “weighs only marginally, if at all, in favor of exercising discretion to deny institution . . .”).

Moreover, under *Fintiv*, the Board recognizes that “it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding,” and that if the petition is filed “promptly after becoming aware of the claims being asserted, this fact has weigh[s] against exercising the authority to deny institution . . .” *Id.* at 11. Here, Petitioners diligently prepared and filed the Petition approximately three months after receiving Patent Owner’s infringement contentions on October 28, 2024, about two months after Patent Owner supplemented those contentions on November 22, 2024, and less than seven months after being served with the complaint asserting seven patents against

Petitioners. In similar circumstances, the Board has found that this factor weighs against discretionary denial. *Markforged Inc. v. Continuous Composites, Inc.*, IPR2022-00679, Paper 7 at 32 (PTAB Oct. 25, 2022) (“[A]lthough the parties have invested some effort in the parallel district court proceeding, the majority of the work to prepare the invalidity case for trial remains to be done. We also acknowledge Petitioner’s diligence in filing the Petition less than 10 months after being served the complaint.”) (internal citations omitted). *See also Liberty Energy, Inc. et al. v. U.S. Well Services, LLC*, IPR 2025-00031, Paper 9 at 12-15 (PTAB Apr. 29, 2025) (finding that “Petitioner was reasonably diligent in filing the Petition” less than three months after receiving infringement contentions, which “play an important role in that regard. They inform Petitioner of the claims that are in fact at issue, as well as how Patent Owner views the scope of the claims, both of which are material considerations in preparing a petition.”)

Based on the foregoing, this factor is neutral or weighs against discretionary denial.

4. Overlap of Issues (Factor 4)

Patent Owner claims “significant overlap” between the issues raised in the Petition and district court litigation because the same claims and prior art are at issue. Paper 6 at 9-14. First, the district court will not determine patentability of all Challenged Claims since Patent Owner has not asserted claims 9, 11, 17, 18, 33-38

of the '580 patent in the district court. *See Maxell, Ltd. v. Coretronic Corp. et al.*, No. 5:24-CV-00088-RWS-JBB (E.D. Tex.), Dkt. 78 (“Plaintiff Maxell, Ltd.’s Preliminary Election of Asserted Claims”) (Mar. 11, 2025). Because ten additional claims are challenged in the Petition, there is no substantial overlap between the issues raised in the Petition and the district court litigation, and thus this factor favors institution. *See, e.g., Apple Inc. v. Maxell, Ltd.*, IPR2020-00200, Paper 11 at 22 (PTAB July 15, 2020) (factor 4 favored institution where unasserted claims are challenged before the Board); *Apple Inc. v. Seven Networks, LLC*, IPR2020-00157, Paper 10 at 17-20 (PTAB June 15, 2020) (“Fintiv factor 4 weighs strongly in favor of Petitioner” where the IPR trial would resolve claims “which the District Court Action will not address”).

While only nine of the nineteen Challenged Claims in the Petition are asserted in the district court, Petitioners have proposed a *Sand*-style stipulation not to pursue the Petition’s grounds in district court (Pet. at 9-10) and commit to a broader *Sotera*-style stipulation (filed concurrently herewith, EX1012), *i.e.* upon institution, Petitioners will not (i) pursue the grounds presented in the Petition in the parallel district court case, or (ii) pursue any other ground that reasonably could have been raised in the Petition in the parallel district court case. *Sotera* endorses such stipulations to eliminate overlap in proceedings, noting that they prevent duplicative

efforts and conflicting rulings. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13-14 (PTAB Dec. 1, 2020).

Patent Owner’s assertion that such a stipulation “does nothing” to mitigate potentially duplicative efforts and conflicting rulings ignores the stipulation’s binding nature and the Board’s precedent in *Sotera*. In fact, where such a stipulation and the estoppel provision of 35 U.S.C. § 315(e)(2) simply “reduces, but does not eliminate, the risk of significant overlap between the assertions in the Petition and those that may be raised in the parallel litigation,” the Board has recently found that “[t]his minimized risk of overlap alleviates concerns of inefficiency and the possibility of conflicting decisions” and “determine[d] that this factor weighs against exercising discretion to deny institution.” *Micron Tech., Inc. v. Yangtze Memory Techs. Co., Ltd.*, IPR2025-00034, Paper 19 at 10 (PTAB May 16, 2025).

Accordingly, “[t]his factor weighs strongly against discretionary denial.” *TCL Elecs. Holdings Ltd. v. Maxell, Ltd.*, IPR2025-00120, Paper 9 at 8 (PTAB May 20, 2025) (granting institution).

5. Same Parties (Factor 5)

Patent Owner notes that the parallel district court litigation involves the same parties. Paper 6 at 14-15. However, Optoma Technology, Inc. is identified as a real party-in-interest (Pet. at 1), but is not a party to the parallel litigation. Therefore, this factor is neutral. *See Google LLC et al. v. Mullen INDUS. LLC*, IPR2025-00021,

Paper 14 at 11 (PTAB May 14, 2025) (“Because of the involvement of a non-defendant, even if a named real party in interest in this proceeding, we find that this factor is neutral.”)

6. Other Circumstances (Factor 6)

Patent Owner alleges that the Petition is “flawed” because it does not identify the alleged claimed function in the challenged means-plus-function claims. Paper 6 at 15-16. However, this assertion is baseless.

First, the functions Patent Owner contends Petitioners failed to identify are explicitly recited in the claim limitations themselves and need not be redundantly recited in the Petition. The functions for analysis under 35 U.S.C. § 112, paragraph 6 are ***claimed*** functions. *Williamson v. Citrix Online*, 792 F.3d 1339, 1347 (Fed. Cir. 2015) (en banc) (“In enacting [35 U.S.C. § 112, paragraph 6], Congress struck a balance in allowing patentees to express a claim limitation by ***reciting a function*** to be performed ... while ... restricting the scope of coverage to only the structure, materials, or acts described in the specification as corresponding to the ***claimed function*** and equivalents thereof.” (emphasis added)). Each of the claim limitations in question recites a single function; there can be no question as to what the claimed function is for each limitation.

Second, there is no obligation to identify the claimed functions in the Petition, and Patent Owner’s reliance on *Williamson* and the Board rules for its assertion to

the contrary (Paper 6 at 15) is misplaced. *Williamson* requires a ***tribunal*** to identify the claimed function. 792 F.3d at 1351. But, as explained above, there can be no question as to what the claimed functions are. Similarly, the Board rule that Patent Owner quotes, 37 C.F.R. § 42.104(b)(3), requires a petition for *inter partes* review to “identify the specific portions of the specification that describe the ***structure, material, or acts corresponding to each claimed function***” (emphasis added); the rule is silent regarding any requirement to identify the ***claimed function***.

Patent Owner further cites *Head Sport GMBH v. Vermont Safety Developments LLC*, IPR2024-01099, Paper 15 at 34 (PTAB Jan. 15, 2025), a decision is neither precedential nor informative,² for the proposition that failure to comply with the supposed mandatory requirement for a petition to identify the claimed functions will result in the petition being denied. Paper 6 at 16. However, Patent Owner misrepresents *Head Sport*. In that case, the petitioner had contended in the parallel district court litigation that the claim limitation at issue was a means-plus-function but in the *inter partes* review petition, the petitioner advanced a claim construction that is ***not*** means-plus-function. *Head Sport*, IPR2024-01099, Paper 15 at 30-33. The Board determined that the claim limitation at issue was indeed a means-plus-function limitation. Because the petitioner’s analysis failed to address how the prior art met the claim limitations as the Board interpreted, the Board

² See <https://www.uspto.gov/patents/ptab/precedential-informative-decisions>

determined that the petitioner had failed to meet its burden to establish a reasonable likelihood that it would prevail. *Id.* at 50. In denying institution, the Board explicitly stated,

Our determination to deny institution of an inter partes review ***does not rely on discretionary denial or on Rule 42.104(b)(3)***, but rather it is based on Petitioner’s failure to demonstrate ***a reasonable likelihood*** that the challenged claims would have been obvious based on the asserted references using the claim construction we determined should apply ...

Id. at 50-51 (emphasis added). *Head Sport* has nothing to do with any supposed duty to identify any claimed function in any means-plus-function claim and, indeed, does not concern discretionary denial.

Consequently, Patent Owner’s allegation that Petitioner’s failure to identify the alleged claimed function in the challenged means-plus-function claims warrants discretionary denial is baseless.

Patent Owner also alleges that Petitioners “waited years after receiving notice of the ’580 patent on April 27, 2023” before filing the Petition, which “suggests tactical gamesmanship aimed at disrupting the District Court case.” Paper 6 at 16. But Maxell’s April 2023 correspondence asked Petitioners to evaluate a potential license, and did not explain which claims of each patent would be asserted against Petitioners or how Petitioners’ products allegedly satisfy the limitations of such claims. In reality, the Petition was diligently prepared and filed within two months after Petitioners received Patent Owner’s amended infringement contentions served

on November 22, 2024, and well within the one-year statutory deadline under 35 U.S.C. § 315(b). *Fintiv* explains that “it is often reasonable for a petitioner to wait to file its petition *until it learns which claims are being asserted against it in the parallel proceeding*.” IPR2020-00019, Paper 15 at 11 (emphasis added). And, contrary to Patent Owner’s specious assertion of bad faith, pre-litigation discussions and motion practice in district court (*e.g.*, motions to dismiss) were perfectly reasonable steps to resolve the parties’ dispute. In short, Patent Owner’s speculative claim of undue delay and gamesmanship is completely unsupported and should be rejected out of hand.

* * * * *

Based on a holistic evaluation of the above factors, the Board should not discretionarily deny institution. *See TCL*, IPR2025-00120, Paper 9 at 9 (instituting trial where factor 1 weighs slightly in favor of discretionary denial, factor 2 strongly favors discretionary denial, factor 3 weighs in favor of discretionary denial, factor 4 weighs strongly against discretionary denial because of *Sotera* stipulation, factor 5 supports discretionary denial, and factor 6 strongly supports institution).

B. Factors Set Forth in the March 26, 2025 Memorandum Do Not Support Denial

The Memo’s additional considerations do not justify denying institution for the reasons discussed below.

1. The Petition is Properly Supported by Dr. Sasian's Declaration

Patent Owner criticizes Dr. Sasian's declaration for supposedly "restating arguments and assertions made by Petitioners' counsel" and therefore lacking independent analysis. Paper 6 at 17-19. However, the examples cited by Patent Owner where the same language is used in the Petition and expert declaration is simply identifying features of and/or quoting from the prior art and therefore does not require extensive analysis or exposition by Dr. Sasian. *See id.* at 17-18 (Ishino discloses a projection-type image display and describes that the illuminator emits white light, and quoting excerpts).

In the *Xerox* case cited by Patent Owner, the expert declaration "merely offered conclusory assertions without underlying factual support and repeated, *verbatim*, Petitioner's conclusory arguments." IPR2022-00624, Paper 12 at 5 (PTAB Feb. 10, 2023). Here, by contrast, there are no such conclusory assertions in the Petition, which explains why the limitations of the challenged claims are necessarily present in the references or why they would have been obvious in light of the reference's disclosure and the knowledge of a POSITA, and further, all of the statements in Dr. Sasian's declaration are based on the teachings of the references he cited and the knowledge of a POSITA. *See, e.g.*, Sasian Decl. (Ex.1004) at ¶¶ 107-108, where Dr. Sasian explained why a POSITA would have had a motivation to combine the teachings of Ishino and Erchak to replace the light source of Ishino with

the light source of Erchak, and would have recognized that combining these teachings would have produced predictable and operable results.

The fact that the Petition mirrors the analysis in the declaration (not the other way around, as Patent Owner baselessly alleges) shows that the Petition is supported by Dr. Sasian's analysis and does nothing to diminish the weight that should be accorded to his testimony. Patent Owner's flawed argument in this regard provides no support at all for discretionary denial.

III. CONCLUSION

For the foregoing reasons Patent Owner's Request for Discretionary Denial should be rejected, and the Board should institute IPR to address the merits of the Petition's unpatentability challenges.

Dated: June 10, 2025

Respectfully submitted,

/Donald R. McPhail/
Donald McPhail
Counsel for Petitioners
Registration No. 35,811

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24, the undersigned attorney for the Petitioners declares that the argument section of this Petition has 3,709 words, according to the word count tool in Microsoft Word™.

/Donald R. McPhail/
Donald R. McPhail
Counsel for Petitioners
Registration No. 35,811

CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. §§ 42.105 and 42.6, that service was made via electronic mail on the Patent Owner's counsel as detailed below.

Date of service June 10, 2025

Manner of service Electronic Mail

Documents served PETITIONERS' OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL

Served upon:

Bryan C. Nese
MAYER BROWN LLP
1999 K Street, NW
Washington, DC 20006-1101
Telephone: 202-263-3266
bnese@mayerbrown.com

Robert G. Pluta
MAYER BROWN LLP
71 S. Wacker Drive
Chicago, IL 60606
Telephone: 312-701-8641
rpluta@mayerbrown.com