

Petitioner's Response to Patent Owner's Discretionary Denial Brief

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REVVO TECHNOLOGIES, INC.,
Petitioner,

v.

CEREBRUM SENSOR TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2025-00632
Patent 11,835,421

**PETITIONER'S RESPONSE TO PATENT OWNER'S
DISCRETIONARY DENIAL BRIEF**

Table of Contents

I.	INTRODUCTION	1
II.	ARGUMENT	1
A.	The Petition’s Strong Challenge Based on New Prior Art Weighs Against Discretionary Denial.....	1
B.	<i>Fintiv</i> Weighs Against Discretionary Denial	11
1.	The District Court Case is Already Stayed.....	11
2.	There is No Trial Date, and Trial, If Any, Would Take Place Months After Final Written Decision	13
3.	The District Court Case is Still Early Stage, with Minimal Investment by the Court and the Parties	14
4.	Petitioner’s Stipulation Would Result in Minimal Overlap with the District Court Case.....	19
5.	Parties in the District Court Case.....	21
C.	The Petition’s Early Challenge, and Other Considerations, Also Weigh Against Discretionary Denial	22
III.	CONCLUSION.....	25
	CERTIFICATE OF SERVICE	27

Table of Authorities

	Page(s)
Cases	
<i>10x Genomics, Inc. v. President & Fellows of Harvard Coll.</i> , Case IPR2023-01299, Paper 15, 2024 WL 993828 (PTAB Mar. 7, 2024)	16
<i>Advanced Micro Devices Inc. v. Realtek Semiconductor Corp.</i> , Case IPR2023-00789, Paper 9 (P.T.A.B. Oct. 26, 2023)	24
<i>Apple Inc. v. Fintiv, Inc.</i> , Case IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020)	11, 22
<i>BOE Tech. Grp. Co. v. Element Cap. Com. Co. Pte. Ltd.</i> , Case IPR2023-00808, Paper 9, 2023 WL 7715885 (P.T.A.B. Nov. 15, 2023)	15
<i>BOE Technology Group Co., Ltd. v. Optronix Scis. LLC</i> , Case IPR2024-01130, Paper 16 (P.T.A.B. Jan. 27, 2025)	21
<i>Cerebrum Sensor Techs., Inc. v. Revvo Techs., Inc.</i> , C.A. No. 1:24-cv-00245, D.I. 106 (D. Del. July 3, 2025)	11
<i>Comcast Cable Commc’ns, LLC v. Touchstream Techs., Inc.</i> , Case IPR2024-00323, Paper 13, 2024 WL 3530021 (P.T.A.B. July 24, 2024)	15-16
<i>Glux Visual Effects Tech (Shenzhen) Co. v. Ultravision Techs., LLC</i> , Case IPR2020-01052, Paper 28 (P.T.A.B. Nov. 17, 2021)	18
<i>Helios Streaming, LLC v. Vudu, Inc.</i> , No. 1:19-cv-01792-CFC-SRF, 2021 WL 8155604 (D. Del. Aug. 5, 2021)	12
<i>Illumina, Inc. v. Ravgen, Inc.</i> , Case IPR2021-01271, Paper 12 (P.T.A.B. Jan. 26, 2022)	16, 17
<i>Kajeet, Inc. v. Gryphon Online Safety, Inc.</i> , C.A. No. 1:19-cv-02370, docket text (D. Del. June 10, 2022)	12

Petitioner’s Response to Patent Owner’s Discretionary Denial Brief

<i>Micron Tech., Inc. v. Yangtze Memory Techs. Co.,</i> Case IPR2025-00190, Paper 21 (P.T.A.B. June 25, 2025)	22
<i>Motorola Sols., Inc. v. Stellar, LLC,</i> Case IPR2024-01205, Paper 19 (P.T.A.B. Mar. 28, 2025)	20
<i>ResMed Corp. v. Cleveland Medical Devices, Inc.,</i> Case IPR2025-00160, Paper 11 (P.T.A.B. June 13, 2025)	19
<i>Samsung Elecs. Co., Ltd v. Collect, LLC,</i> Case IPR2020-00476, Paper 14 (P.T.A.B. July 31, 2020)	18
<i>Samsung Elecs. Co. v. Acorn Semi, LLC,</i> Case IPR2020-01282, Paper 20 (P.T.A.B. Feb. 10, 2021)	24
<i>SAP Am., Inc. v. Cyandia, Inc.,</i> Case IPR2024-01433, Paper 13 (P.T.A.B. Apr. 7, 2025)	15
<i>SAP Am., Inc. v. Cyandia, Inc.,</i> Case IPR2024-01496, Paper 13 (P.T.A.B. Apr. 7, 2025)	21
<i>Shenzhen Root Tech. v. Chiaro Tech. Ltd. d/b/a Elvie,</i> Case IPR2024-01296, Paper 9 (P.T.A.B. Feb. 25, 2025)	22
<i>Shenzhen Tuoazhu Tech. Co., Ltd. v. Stratasys, Inc.,</i> Case IPR2025-00321, Paper 10 (P.T.A.B. June 18, 2025)	15
<i>Stingray Grp. Inc. v. Edwin A. Hernandez-Mondragon,</i> Case IPR2025-00350, Paper 18 (P.T.A.B. June 13, 2025)	15
<i>Twitch Interactive, Inc. v. RazDog Holdings LLC,</i> Case IPR2025-00307, Paper 18 (P.T.A.B. May 16, 2025)	24
<i>Western Digital Corp. v. Spex Techs., Inc.,</i> Case IPR2018-00084, Paper 14 (P.T.A.B. Apr. 25, 2018)	17-18
<i>Yealink (USA) Network Tech. Co. v. Barco N.V.,</i> Case IPR2025-00491, Paper 18 (P.T.A.B. June 25, 2025)	22

I. INTRODUCTION

The Petition presents a strong and early challenge to the recently-issued '421 patent based on new prior art that was not considered during prosecution. The related district court case was stayed at an early stage through a joint request *initiated by Patent Owner*. The case remains stayed and there was only minimal investment by the court and the parties in the case prior to the stay. Critically, there is no trial date. Moreover, at this point, any trial would not take place until at least many months after a Final Written Decision would be due in this IPR. Accordingly, as explained in detail below, Patent Owner's request for discretionary denial should be denied.

II. ARGUMENT

A. The Petition's Strong Challenge Based on New Prior Art Weighs Against Discretionary Denial

None of the art relied upon in the grounds of the Petition was before the examiner during prosecution of the '421 patent. As noted in the Petition, none of the references relied upon in the grounds—including specifically the references of Yamaguchi-727 and Yamaguchi-566—are substantially the same or cumulative of any of the references previously presented and considered by the examiner. (Pet. at 4-5.)

The strong showing of invalidity based on the grounds presented in the Petition has been further validated by the Patent Office in the pending prosecution

Petitioner's Response to Patent Owner's Discretionary Denial Brief

of the child application of the '421 patent, in which the examiner has rejected pending claims materially similar to those in the '421 patent for anticipation and obviousness over the Yamaguchi-566 (EX1007) reference relied on in Grounds 2 and 3 of the Petition. (*See* EX1029 (05/09/2025 Rejection) at Page 007-016 (Non-Final Rejection of Claims by Examiner in 18/828,624 for anticipation and obviousness based on Yamaguchi-566).) Both Yamaguchi references disclose this same overlapping and invalidating subject matter for the challenged claims of the '421 patent, as demonstrated by the grounds in the Petition under Yamaguchi-727 and Yamaguchi-566. (*See generally* Pet. at 16-84.)

As set forth in more detail below, now that the Patent Office has been made aware of the subject matter disclosed in Yamaguchi-727 and Yamaguchi-566, it has not allowed claims Patent Owner is presently pursuing with materially similar scope to those in the presently challenged '421 patent. Thus, the Patent Office has already tacitly recognized that the challenged claims of the '421 patent have a substantial likelihood of invalidity in view of the disclosures and teachings of Yamaguchi-727 and Yamaguchi-566, as relied on in the Grounds of the Petition.

On December 4, 2023, Patent Owner filed application No. 18/528,624 as a continuation of the presently challenged '421 patent. (*See* EX1026 (12/04/2023 Application Data) at Page 002.) After preliminary amendments to the claims by Patent Owner, including on October 31, 2024 (EX1027) and prior to any response

Petitioner’s Response to Patent Owner’s Discretionary Denial Brief

by the examiner, Patent Owner filed an IDS on February 4, 2025 for the first time identifying the material Yamaguchi-727 and Yamaguchi-566 prior art patent publications. (*See* EX1028 (02/04/2025 IDS) at Page 001.) Thereafter, the examiner issued rejections of the pending claims based on the disclosures of Yamaguchi-566 for anticipation and obviousness. (*See* EX1029 (05/09/2025 Rejection) at Page 007-016.) The subject matter of Yamaguchi—e.g., a “housing” with an electrical sensor device held within open “Housing space S” and a retaining member to affix the housing/sensor to a tire—are identical to those relied on by Petitioner for the challenged claims in the Petition.

The materially identical nature of the pending claims rejected by the examiner during prosecution of the 18/528,624 child application of the ’421 patent and the presently challenged claims are demonstrated in the following table comparing claim 1 of the ’421 patent and pending claims 58-59 of the ’624 application:

’421 Patent Claim 1	18/528,624 Pending Claims 58-59
	58[pre] A sensing system for monitoring an object that is rotated in use comprising:
1[pre]. A sensor assembly configured for attachment with an object that is rotated in use, the sensor assembly comprising:	58[a] a sensor assembly configured to connect with the object or an element that rotates with the object, the sensor assembly comprising:

Petitioner's Response to Patent Owner's Discretionary Denial Brief

1[a] a housing comprising an outer surface and an internal cavity that is enclosed within the housing;	58[b] a housing comprising an outer surface and an internal cavity that is enclosed within the housing; and
1[b] an electrical sensor device that is disposed within the internal cavity and attached therein to prevent movement of the device within the internal cavity,	58[c] an electrical device disposed within the internal cavity and attached thereto to prevent movement of the electrical device within the internal cavity,
1[c] wherein the internal cavity comprises an unfilled open space above or below the electrical sensor device in the housing,	[58[d] wherein the housing includes an opening through the outer surface to the internal cavity,] ¹
1[d] wherein the electrical sensor device is configured to sense, transmit and/or receive information regarding surrounding conditions, orientation and/or location when the sensor	58[e] wherein the electrical device comprises electrical components including one or more sensors [. . .] wherein the electrical device is configured to sense, transmit and/or receive information regarding surrounding conditions, orientation and/or location when the sensor

¹ Limitation 58[d] appears within limitation 58[e] in the 18/528,624 pending claims but has been placed here to show parallels with limitation 1[c] of the '421 patent.

Petitioner's Response to Patent Owner's Discretionary Denial Brief

assembly is attached with the object and the object is rotated in use; and	assembly is attached with the object and the object is rotated in use.
1[e] a retaining member that is configured to accommodate attachment of the housing therewith, wherein the retaining member has an outside surface configured for attachment to rotate with the object when the object is rotated in use.	59. The sensing system of claim 58, further comprising a retaining member configured to accommodate attachment of the housing therewith, wherein the retaining member has an outside surface configured for attachment with the object or the element that rotates with the object.

(*Compare* EX1001 ('421 patent), claim 1 *with* EX1027 (10/31/2024 Preliminary Amendment in 18/528,624) at Page 002 (pending claims 58-59).)

As demonstrated, the recited language of challenged claim 1 of the '421 patent in the present IPR Petition and pending claims 58-59 in the '624 child application that have been rejected by the Patent Office is essentially verbatim. Furthermore, the Yamaguchi disclosures the examiner applied in rejecting the claims of the pending '624 patent are the same Yamaguchi disclosures asserted by Petitioner against the claims of the '421 patent in the Grounds of the Petition, as shown in the following chart:

Petitioner's Response to Patent Owner's Discretionary Denial Brief

18/528,624	'421 Patent, Claim 1	Examiner's Rejection in 18/528,624/Petition Grounds based on Yamaguchi Disclosures
58[b]	1[a] a housing comprising an outer surface and an internal cavity that is enclosed within the housing;	“Yamaguchi teaches a housing 1 20 comprising an outer surface and an internal cavity [0021] (‘Housing space S’) – [0022][0028] (figs. 1-3) that is enclosed within the housing 1 20;” (EX1029 (05/09/2025 Rejection) at Page 007; <i>see</i> Pet. at 19-22 (citing same disclosures of Yamaguchi-727 regarding “housing case 20,” “housing space S,” “housing cap 30,” and Fig. 2); Pet. at 40-47 (Ground 2 combination of Yamaguchi-727 with Yamaguchi-566 disclosures relating to “housing,” “Housing space S,” electronic sensor board attached inside the housing by surface features, opening and unfilled open space above sensors).)
58[c]	1[b] an electrical sensor device that is disposed within the internal cavity and attached therein to	“Yamaguchi teaches . . . an electrical device 62-64 disposed within the internal cavity [0021] (‘Housing space S’) – [0022][0028] (figs. 1-3) and

Petitioner’s Response to Patent Owner’s Discretionary Denial Brief

	prevent movement of the device within the internal cavity,	attached thereto to prevent movement (implied figs. 1-3) of the electrical device within the internal cavity (figs. 1-3)” (EX1029 (05/09/2025 Rejection) at Page 007-008; <i>see</i> Pet. at 22-25 (citing same disclosures of Yamaguchi-727 regarding “circuit board 60” with “temperature sensor 62” and “pressure sensor 64” within “housing space S” and related figs); Pet. at 40-47 (Ground 2 combination of Yamaguchi-727 with Yamaguchi-566 disclosures relating to “housing,” “Housing space S,” electronic sensor board attached inside the housing by surface features, opening and unfilled open space above sensors).)
58[d]	1[c] wherein the internal cavity comprises an unfilled open space above or below the electrical sensor device in the housing,	“Yamaguchi teaches . . . wherein the housing 1 20 includes an opening [0021][0028] through the outer surface to the internal cavity [0021] (‘Housing space S’) – [0022][0028] (figs. 1-3),” (EX1029 (05/09/2025 Rejection) at Page 007-008; <i>see</i> Pet. at 25-27 (citing

Petitioner’s Response to Patent Owner’s Discretionary Denial Brief

		same disclosures of Yamaguchi-727 regarding “the opening in housing cap 30” and “housing space S” being unfilled so that “temperature sensor 62” and “pressure sensor 64” sense the tire air chamber conditions “via the opening in housing cap 30”); Pet. at 40-47 (Ground 2 combination of Yamaguchi-727 with Yamaguchi-566 disclosures relating to “housing,” “Housing space S,” electronic sensor board attached inside the housing by surface features, opening and unfilled open space above sensors).)
58[e]	1[d] wherein the electrical sensor device is configured to sense, transmit and/or receive information regarding surrounding conditions, orientation and/or location when the sensor assembly is attached with	“Yamaguchi teaches . . . wherein the electrical device 6 62 64 comprises electrical components including one or more sensors 62 64 [0032] [0033][0038]-[0039], . . . wherein the electrical device 6 62 64 is configured to sense, transmit and/or receive information regarding surrounding conditions, orientation and/or location

Petitioner’s Response to Patent Owner’s Discretionary Denial Brief

	the object and the object is rotated in use; and	when the sensor assembly is attached with the object 10 and the object 10 is rotated in use (abstract).” (EX1029 (05/09/2025 Rejection) at Page 007-008; <i>see</i> Pet. at 27-28 (citing same disclosures of Yamaguchi-727 regarding “circuit board 60” having “a temperature sensor 62, a pressure sensor 64, and an acceleration sensor 66 and the like”); Pet. at 40-47 (Ground 2 combination of Yamaguchi-727 with Yamaguchi-566 disclosures relating to “housing,” “Housing space S,” electronic sensor board attached inside the housing by surface features, opening and unfilled open space above sensors).)
59	1[e] a retaining member that is configured to accommodate attachment of the housing therewith, wherein the retaining member has an outside surface configured for	“Regarding claim 59 Yamaguchi teaches a retaining member 26 46 configured to accommodate attachment of the housing 1 20 therewith, wherein the retaining member 26 46 has an outside surface (figs. 1-3) configured for attachment with the object or the element that

Petitioner's Response to Patent Owner's Discretionary Denial Brief

	attachment to rotate with the object when the object is rotated in use.	rotates with the object 10 (figs. 1-3)[.]” (EX1029 (05/09/2025 Rejection) at Page 008; <i>see</i> Pet. at 29-32 (citing same disclosures of Yamaguchi-727 regarding “retaining member” with “part 26” to accommodate attachment of “housing case 20” with “part 26” and further that the retaining member has an outside surface configured for attachment to a “tire 10”); Pet. at 40-47 (Ground 2 combination of Yamaguchi-727 with Yamaguchi-566 disclosures relating to “housing,” “Housing space S,” electronic sensor board attached inside the housing by surface features, opening and unfilled open space above sensors).)
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Thus, had the Patent Office been made aware of the disclosures of Yamaguchi-727 and/or Yamaguchi-566 during prosecution, the claims of the '421 patent would not have issued for the same reasons that the Patent Office has rejected the pending claims in the child application of the '421 patent and Petitioner has explained in the present IPR challenge.

Petitioner's Response to Patent Owner's Discretionary Denial Brief

Accordingly, the Patent Office should not exercise its discretion to deny the present Petition. Rather, it should proceed to evaluate the patentability of the challenged claims of the '421 patent under the disclosures and teachings of the Yamaguchi-727 and/or Yamaguchi-566 prior art relied on in the Grounds in the same manner as the examiner has done in rejecting materially similar claims in Patent Owner's pending child application.

B. *Fintiv* Weighs Against Discretionary Denial

1. The District Court Case is Already Stayed

As noted in the Petition and acknowledged by Patent Owner, all deadlines in the related district court case are currently stayed. (Pet. at 4; Paper 7 ("DD Br.") at 9-10.) This ongoing stay weighs against discretionary denial. *Apple Inc. v. Fintiv, Inc.*, Case IPR2020-00019, Paper 11 at 6-7 (P.T.A.B. Mar. 20, 2020) (precedential). Patent Owner repeatedly asserts that it would seek to lift the stay if the parties' June 2025 mediation was unsuccessful. (DD Br. at 4, 6, 10, 11.) But even though that mediation proved unsuccessful, Patent Owner has done nothing to unstay the case. In fact, Patent Owner instead stipulated to further extend the stay until September 2025. *See Cerebrum Sensor Techs., Inc. v. Revvo Techs., Inc.*, C.A. No. 1:24-cv-00245, D.I. 106 (D. Del. July 3, 2025) (EX1030). As a result, the stay will remain

Petitioner's Response to Patent Owner's Discretionary Denial Brief

in place at least until around the time an institution decision is due.²

And even if Patent Owner reverses course and does eventually seek to lift the stay, Patent Owner offers only speculation that the stay would be lifted because, according to Patent Owner, Petitioner's IPRs "will not come close to resolving all of the parties' disputes." (DD Br. at 10.) But Patent Owner has not provided any evidence that the district court would lift the current stay or deny a further stay pending the outcome of Petitioner's IPRs. In fact, the judge currently assigned to the district court case, Judge Fallon, has repeatedly stayed proceedings pending IPR even after expressly acknowledging that the IPRs would not resolve all of the parties' disputes. *See Helios Streaming, LLC v. Vudu, Inc.*, No. 1:19-cv-01792-CFC-SRF, 2021 WL 8155604, at *2-3 (D. Del. Aug. 5, 2021); *Kajeet, Inc. v. Gryphon Online Safety, Inc.*, C.A. No. 1:19-cv-02370, Oral Order (D. Del. June 10, 2022) ("Plaintiff's position that the issues will not be simplified because the remaining patent-in-suit is not subject to IPR proceedings has been frequently rejected by courts.") (EX1031). Patent Owner has provided no reason to expect that Judge

² Patent Owner filed its Preliminary Response on June 17, 2025. An Institution Decision is therefore due no later than September 17, 2025, and a Final Written Decision would be due no later than September 17, 2026. *See* 35 U.S.C. §§ 314(b)(1) & 316(a)(11).

Fallon would rule differently here.

2. There is No Trial Date, and Trial, If Any, Would Take Place Months After Final Written Decision

There is no trial date in the district court case. And because that case has already been stayed for over five months and will be stayed for at least another two, any trial would not be scheduled to occur until long after a Final Written Decision issues in this IPR. For example, even if the stay were lifted in September (which is unlikely), if the sequence of events in the court's initial pre-stay scheduling order were shifted to account for the stay but otherwise maintained, summary judgment and *Daubert* briefing would not even be complete until sometime in January 2027—about four months *after* any Final Written Decision would be due in this IPR.³ (See EX2004 at Page 17 (chart of district court deadlines, with replies in support of dispositive/*Daubert* motions set for June 30, 2026).) An actual trial would certainly not take place until at least several months (and more likely at least about a year) after a Final Written Decision issues. For example, recent case statistics for the District of Delaware show a median time of forty-one months from case filing to jury trial. (See EX1032 at Page 001.) Here, forty-one months from the February 2024 start of the district court case would put trial in July 2027—ten months after a Final Written Decision.

³ A Final Written Decision would be due no later than September 17, 2026.

And in the unlikely event the district court were to lift the current stay, Patent Owner fails to explain how or why the court would accelerate the scheduled sequence of events. Nor is there any reason to expect it would do so. Patent Owner has not only shown no urgency in moving the district court case forward, it has told the court that it intends to expand the case's scope. (*See* EX2005 at Page 2.) If allowed, that expanded scope would result at a minimum in further delays associated with a do-over of much of the preliminary work that has been done so far. The fact that the related district court case has no trial date—and in the event a trial is scheduled, it would not be scheduled to take place until at least several months after a Final Written Decision—weighs against discretionary denial.

3. The District Court Case is Still Early Stage, with Minimal Investment by the Court and the Parties

At the time the district court case was stayed in February 2025, only minimal investment by the Court or the parties in the case had taken place. The most work-intensive stages of the case were far in the future—including substantial completion of document production (six months later in August 2025), dispositive and pretrial motions (over 15 months away), expert discovery (set to close over 14 months later in April 2026), and much of fact discovery (set to close more than 10 months later in December 2025). (*See* EX2004 at Page 16-17.) Furthermore, although the parties exchanged proposed constructions of disputed terms, no claim construction briefs had been filed, a *Markman* hearing was scheduled five months later, and a claim

Petitioner's Response to Patent Owner's Discretionary Denial Brief

construction decision would not have issued until sometime thereafter. (*Id.* at Pages 8-10.) As discussed above, if the district court case is ever unstayed, a new schedule will need to be set that will have to account for the more than seven months that will have passed during the stay.

The Board has found district court cases at similar or later stages to weigh against discretionary denial. *E.g.*, *Stingray Grp. Inc. v. Edwin A. Hernandez-Mondragon*, Case IPR2025-00350, Paper 18 at 7 (P.T.A.B. June 13, 2025) (“[M]uch work remains, and the court has suspended all deadlines.”); *SAP Am., Inc. v. Cyandia, Inc.*, Case IPR2024-01433, Paper 13 at 10-11 (P.T.A.B. Apr. 7, 2025) (factor favors institution where claim construction terms and contentions exchanged, no *Markman* hearing held, and expert discovery to close in approximately two months); *Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*, Case IPR2025-00321, Paper 10 at 12 (P.T.A.B. June 18, 2025) (factor weighs against discretionary denial where “fact and expert discovery do not close until next year”).⁴

⁴ Patent Owner's cited cases involve parallel litigation at substantially more advanced stages than the district court case here. *See BOE Tech. Grp. Co. v. Element Cap. Com. Co. Pte.*, Case IPR2023-00808, Paper 9 at 23, 2023 WL 7715885, at *8 (P.T.A.B. Nov. 15, 2023) (claim construction complete and close of fact discovery in two weeks); *Comcast Cable Commc'ns, LLC v. Touchstream Techs., Inc.*, Case

Petitioner's Response to Patent Owner's Discretionary Denial Brief

Patent Owner points to the minimal discovery and document production that has taken place in the district court case, including exchange of initial contentions. (DD Br. at 13-14.) But “most of the investment from the court and the parties in the [parallel district court case] lies ahead.” *Illumina, Inc. v. Ravgen, Inc.*, Case IPR2021-01271, Paper 12 at 28-29 (P.T.A.B. Jan. 26, 2022). Nearly a year of fact discovery remained when the case was stayed, and final contentions were not due until October and November 2025. (EX2004 at Page 17.) The parties’ minimal initial discovery in the district court case does not support discretionary denial. *E.g.*, *Illumina*, Case IPR2021-01271, Paper 12 at 28 (staying case where initial contentions had been exchanged but “final contentions are not due until the summer of 2022 [months later]”).

Patent Owner also points to the initial claim construction efforts the parties made in the district court litigation. (DD Br. at 14-15.) The Board has repeatedly found the investment in parallel proceedings factor to favor institution in situations

IPR2024-00323, Paper 13 at 9-10, 2024 WL 3530021, at *4 (P.T.A.B. July 24, 2024) (fact and expert discovery closed and *Markman* hearing held by date of institution); *10x Genomics, Inc. v. President & Fellows of Harvard Coll.*, Case IPR2023-01299, Paper 15 at 18-19, 2024 WL 993828, at *8 (P.T.A.B. Mar. 7, 2024) (claim construction order issued).

Petitioner's Response to Patent Owner's Discretionary Denial Brief

where, like here, only preliminary claim construction exchanges have taken place but briefing is incomplete, no *Markman* hearing has been held, and no claim construction order has been issued. *See, e.g., Illumina*, Case IPR2021-01271, Paper 12 at 28 (granting institution where “[c]laim construction briefing has begun, but will not be completed until [months later], and a hearing is not scheduled until [still later].”). Furthermore, the number of terms Petitioner proposed for construction is irrelevant, particularly since Petitioner dropped many of those terms in the interest of refining the disputes for the Court. (EX1017, Ex. A.) Regardless of the terms proposed during claim construction, the parties had not even begun to brief any terms, no *Markman* hearing was held, and no claim construction order was issued before the case was stayed. Accordingly, the parties’ and the Court’s investment in the claim construction process was minimal.⁵

⁵ Patent Owner also argues that Petitioner has taken an “inconsistent approach to claim construction in the Petition and in the district court litigation.” (DD Br. at 9.) But as explained in the Petition, Petitioner is simply adopting Patent Owner’s proposed constructions from the underlying district court litigation for purposes of this proceeding. (Pet. at 9-10.) Petitioner has therefore fully complied with 37 C.F.R. § 42.104(b)(3). *See, e.g., Western Digital Corp. v. Spex Techs., Inc.*, Case IPR2018-00084, Paper 14 at 11 (P.T.A.B. Apr. 25, 2018) (petition based on Patent

Petitioner's Response to Patent Owner's Discretionary Denial Brief

Patent Owner also argues that the stage of the district court case favors denial of institution given that Petitioner filed a motion to dismiss and each party filed a discovery motion in the district court case. (DD Br. at 13.) However, Petitioner's motion to dismiss did not involve substantial investment in the asserted patents by the Court or the parties. Instead, it was merely directed to the insufficiency of Patent Owner's pleadings before the district court. Indeed, Magistrate Judge Fallon *declined* to reach the claim construction merits in her report and recommendation on the motion—and such claim construction did not take place before the case was stayed. (EX2014 at 11-12.) Similarly, the parties' discovery motions in the district court case were merely related to threshold written discovery issues and did not

Owner district court claim constructions satisfied § 42.104(b)(3)); *Samsung Elecs. Co. v. Collect, LLC*, Case IPR2020-00476, Paper 14 at 12 (P.T.A.B. July 31, 2020) (“It is not a requirement of [rule] 104(b)(3) that for every term for which Petitioner has proposed an express construction in related district court litigation, Petitioner must propose the same construction in the Petition.”); *Glux Visual Effects Tech (Shenzhen) Co. v. Ultravision Techs., LLC*, Case IPR2020-01052, Paper 28 at 16-21 (P.T.A.B. Nov. 17, 2021) (adopting petitioner's “plain and ordinary meaning” claim construction arguments, which Patent Owner advanced in the related litigation, and construing the claim terms differently from the district court).

require the Court to invest in the patents or the underlying factual merits. Accordingly, the parties' limited motions in the district court case do not change the fact that the Court and the parties had only minimally invested in the case before it was stayed. *Apple*, Case IPR2020-00019, Paper 11 at 10 (“[A]t the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution[.]”). This factor therefore weighs against discretionary denial.

4. Petitioner's Stipulation Would Result in Minimal Overlap with the District Court Case

Since the district court case is stayed, there is currently no risk of substantive overlap with the present proceeding. *See ResMed Corp. v. Cleveland Medical Devices, Inc.*, Case IPR2025-00160, Paper 11 at 16 (P.T.A.B. June 13, 2025) (“[B]ecause the [district court] case is stayed, there is no danger of overlap[.]” (quotation marks omitted)). If IPR is instituted, as discussed above, the district court case will likely remain stayed throughout the present IPR. Accordingly, the present IPR could invalidate all challenged claims with no possibility of overlap with the district court case.

Even if any claims survive the present IPR, the possibility of overlapping issues between the present IPR and the district court case is minimal. Petitioner hereby stipulates that if this IPR is instituted, then Petitioner will not pursue in the related pending litigation (i) the specific grounds of invalidity that were raised or

Petitioner's Response to Patent Owner's Discretionary Denial Brief

grounds that reasonably could have been raised under 35 U.S.C. §§ 102 or 103 on the basis of prior art patents or printed publications in this IPR, and (ii) grounds of invalidity under 35 U.S.C. § 103 on the basis of any other prior art that could not have been raised in the IPR (e.g., system art) in combination with any of those prior art references relied on in the grounds for this IPR with respect to any challenged claim. To avoid any doubt, if the PTAB declines institution or rescinds institution of IPR, then Petitioner reserves the right to pursue any grounds of invalidity, including but not limited to the grounds in (i) and (ii), in the related pending litigation.

As a result of the above stipulation, Patent Owner's arguments about Petitioner re-using the prior art at issue in the Grounds of this IPR in combination with system art before the district court are moot. (DD Br. at 16-17.) Patent Owner also generally appears to object to Petitioner's ability to rely on unpublished system art at all before the district court. (DD Br. at 1-2, 17.) But since Petitioner cannot rely on unpublished system art in this IPR, such system art has no bearing on overlap between the proceedings.⁶ 35 U.S.C. § 311(b). Patent Owner suggests that the

⁶ Patent Owner's cited cases involve different facts. *Motorola Sols., Inc. v. Stellar, LLC*, Case IPR2024-01205, Paper 19 at 4 (P.T.A.B. Mar. 28, 2025) ("Petitioner's invalidity arguments in the district court are more expansive and include

Petitioner's Response to Patent Owner's Discretionary Denial Brief

Yamaguchi-727 and Yamaguchi-566 patent applications at issue in this IPR could be related to some unidentified Bridgestone system at issue in the district court case. (DD Br. at 1-2.) But Petitioner is not asserting any Bridgestone system developed under or mimicking the Yamaguchi-727 and Yamaguchi-566 prior art patent applications—and even if it were, Yamaguchi-727 and Yamaguchi-566 are published patent applications with no evident correspondence to a particular Bridgestone prior art system. Accordingly, Patent Owner's suggestion of overlap between this IPR and the district court case based on the Yamaguchi-727 and Yamaguchi-566 prior art is baseless.

5. Parties in the District Court Case

While the present IPR and the parallel district court proceeding involve the same parties, such a consideration should be found in favor of institution or neutral to the discretionary denial analysis. *See, e.g., BOE Tech. Grp. Co. v. Optronic Scis. LLC*, Case IPR2024-01130, Paper 16 at 13-14 (P.T.A.B. Jan. 27, 2025) (factor

combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner's stipulation is not likely to moot."); *SAP Am., Inc. v. Cyandia, Inc.*, Case IPR2024-01496, Paper 13 at 8-9 (P.T.A.B. Apr. 7, 2025) (publication art relied upon in IPR asserted as evidence of system art in parallel district court proceeding).

neutral or in favor of institution where parties are the same in IPR and district court litigation); *Shenzhen Root Tech. Co. v. Chiaro Tech. Ltd. d/b/a Elvie*, IPR2024-01296, Paper 9 at 19-20 (P.T.A.B. Feb. 25, 2025) (factor neutral where parties are the same in IPR and district court litigation).

C. The Petition's Early Challenge, and Other Considerations, Also Weigh Against Discretionary Denial

In addition to the strength of the Petition's merits and the *Fintiv* factors, other considerations also weigh against discretionary denial, including those listed in the Acting Director's March 26, 2025 Memorandum on Interim Processes for PTAB Workload Management ("Memo").

To start, "[s]ettled expectations of the parties, such as the length of time the claims have been in force" (*see* Memo at 2), weigh against discretionary denial. The '421 patent issued recently, in December 2023. This Petition's early challenge to the patent therefore weighs against discretionary denial. *See Micron Tech., Inc. v. Yangtze Memory Techs. Co.*, Case IPR2025-00190, Paper 21 at 3 (P.T.A.B. June 25, 2025) ("The challenged patents were issued recently, from 2021 through 2024. Early challenges favor robust, predictable patent rights and weigh against discretionary denial."); *Yealink (USA) Network Tech. Co. v. Barco N.V.*, Case IPR2025-00491, Paper 18 at 3 (P.T.A.B. June 25, 2025) ("[T]he challenged patent issued recently, in 2020....[which] weigh[s] against discretionary denial."). Patent Owner's brief does not even acknowledge "settled expectations" let alone argue that they weigh in favor

Petitioner's Response to Patent Owner's Discretionary Denial Brief

of discretionary denial.

Moreover, neither the PTAB nor another forum has previously adjudicated the validity or patentability of the challenged patent claims. (*See* Memo at 2.) This IPR is the first and only post-grant challenge to the '421 patent at the Patent Office. And as noted above, now that the Patent Office has been made aware of the subject matter disclosed and taught in the Yamaguchi-566 and Yamaguchi-727 prior art relied on in this Petition, it has rejected similar pending claims to those challenged in the '421 patent in the ongoing prosecution of the child application to the '421 patent. Thus, with respect to “[t]he strength of the unpatentability challenge” (*see* Memo at 2), the Patent Office has already tacitly acknowledged that the Yamaguchi-566 and Yamaguchi-727 prior art patent application is highly material in demonstrating the strength of the invalidity challenges presented in the Petition.

The Petition also relied properly on expert testimony. (*See* Memo at 2.) Patent Owner makes an undeveloped argument that “Revvo’s extensive reliance on expert testimony indicates that its assertions are better resolved in district court” and that “[t]he failure to provide focused expert testimony here weighs against institution.” (DD Br. at 19.) But neither Patent Owner’s Discretionary Denial Brief—nor its Preliminary Response, if considered—sufficiently explains its allegations, with Patent Owner’s Discretionary Denial Brief providing only a cite to “*See generally* Petition[.]” (DD Br. at 19-20.) Neither Patent Owner’s Discretionary

Petitioner's Response to Patent Owner's Discretionary Denial Brief

Denial Brief nor its Preliminary Response identifies any portions of expert testimony that could suggest Petitioner is using that testimony to fill gaps in the prior art or otherwise relying to an improper extent on its expert.

Patent Owner ignores that the Petition presents prior art disclosure for every element of the challenged claims from the cited prior art within the Grounds—there is not a single claim element for which Petitioner relies solely on expert testimony to demonstrate invalidity. *See Advanced Micro Devices Inc. v. Realtek Semiconductor Corp.*, Case IPR2023-00789, Paper 9 at 39 (P.T.A.B. Oct. 26, 2023) (rejecting patent owner assertion that petitioner improperly relied on expert testimony to fill a gap in its prior art analysis); *Samsung Elecs. Co. v. Acorn Semi, LLC*, Case IPR2020-01282, Paper 20 at 28-29 (P.T.A.B. Feb. 10, 2021) (rejecting patent owner accusation petitioner required expert testimony to fill in gaps). Instead, Patent Owner points only to the number of times the Petition allegedly cites its expert declaration (DD Br. at 19-20), recycling the same argument that recently failed in IPR2025-00307. *See Twitch Interactive, Inc. v. RazDog Holdings LLC*, Case IPR2025-00307, Paper 18 at 3 (P.T.A.B. May 16, 2025) (denying request for discretionary denial); *see also Twitch*, Case IPR2025-00307, Paper 13 at 28 (P.T.A.B. Apr. 30, 2025) (petitioner opposition brief explaining patent owner faulted petitioner for “cit[ing] its expert’s 269-page declaration at least 260 times in the Petition”) (alteration in original).

III. CONCLUSION

Petitioner respectfully requests that the Director not exercise her discretion under 35 U.S.C. § 314(a) to deny institution of this proceeding.

Dated: July 16, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH WORD COUNT

I hereby certify, pursuant to 37 C.F.R. § 42.24(d), that the attached **PETITIONER'S RESPONSE TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** contains 5,240 words according to the word-processing system used to prepare this paper.

Dated: July 16, 2025

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. § 42.6(e), that a complete copy of the attached **PETITIONER'S RESPONSE TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** and related documents were served on July 11, 2025, upon the parties via electronic mail:

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