

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REVVO TECHNOLOGIES, INC.

Petitioner,

v.

CEREBRUM SENSOR TECHNOLOGIES, INC.

Patent Owner.

IPR2025-00632

Patent 11,835,421

**PATENT OWNER'S OPPOSITION TO PETITIONER'S BRIEF
REGARDING DIRECTOR'S ORDER VACATING THE DECISION
GRANTING INSTITUTION**

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37 C.F.R. § 42.104(b)(3)	<i>passim</i>
83 Fed. Reg. 51342	1, 3

I. INTRODUCTION

The Director correctly found that Petitioner is engaging in forum gamesmanship by utilizing different claim construction positions in different forums where it best suits Petitioner's interest. This gamesmanship leads to inconsistent decisions across forums and upsets the goal of each forum to adopt and apply the correct claim constructions.

Petitioner cannot justify its actions. As the Director has correctly explained: “[s]imply noting that the petitioner is adopting a patent owner’s claim construction proposals from district court, however, is not a sufficient reason for advancing different positions in the two forums.” Paper 20 at 5. “Allowing petitioners to continue this practice does not further the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” *Id.* at 4; *see also* 83 Fed. Reg. at 51,342–43.

Yet, here, Petitioner has no explanation for its actions other than it is hedging its bets “in the event the district court declines to adopt the narrow construction.” Paper 23 at 1. But this is not an acceptable justification. Rather, this justification is expressly disallowed by the Director’s decision and PTAB precedent. *E.g.*, Paper 20 at 4 (“To that end, the rules discourage petitioners from seeking broader constructions at the Board to support a patentability challenge while seeking narrower constructions in litigation to avoid infringement liability.”). Put simply,

Petitioner's brief does not answer the Director's direction to provide "a sufficient reason why different claim construction positions are warranted." *Id.* at 5.

II. ARGUMENT

A. Petitioner's Conflicting Claim Constructions Are Improper

According to the Director, the Board's "claim construction rules are designed to ensure that the Board correctly construes claim terms and to minimize inconsistency in claim construction between forums." Paper 20 at 4. Thus, when a party contends a claim construction is wrong in the district court, yet urges the Board to adopt it at the same time during an IPR proceeding, the Board's hands are wrongly tied and the different forums are set on a crash course for inconsistency. Allowing Petitioners to engage in such cross-forum inconsistencies encourages Petitioners to seek the broader constructions in an attempt to invalidate the patent in the IPR, and then reserve the right to switch horses and seek narrower constructions to avoid infringement in the district court if the IPR does not go their way.

This gamesmanship is what Petitioner sets out to do in this case even though it is expressly disallowed by the Director's decision and PTAB precedent. *E.g.*, Paper 20 at 4 ("The Board's claim construction rules are designed to ensure that the Board correctly construes claim terms and to minimize inconsistency in claim construction between forums. ... To that end, the rules discourage petitioners from seeking broader constructions at the Board to support a patentability challenge while

seeking narrower constructions in litigation to avoid infringement liability.”); *Sun Pharmaceutical Industries, Inc. v. Nivagen Pharmaceuticals, Inc.*, IPR2025-00893, Paper 18 at 3 (Sept. 19, 2025) (“Here, however, Petitioner does not sufficiently explain why it advanced a narrow construction in district court and advances a broader construction in its Petition. The considerations favoring denial, therefore, outweigh the considerations that counsel against it.”); 83 Fed. Reg. 51342 (noting that the Board adopted the same standard for claim construction used in district courts to improve “uniformity and predictability,” “improve the integrity of the patent system,” and “increase judicial efficiency overall”).

Here, Petitioner expressly admits that it is using conflicting claim constructions as a backup plan “in the event the district court declines to adopt the narrow construction.” Paper 23 at 1. Nowhere does Petitioner explain why the IPR should proceed in its favor based on its own proposed claim constructions presented to the District Court. There is no attempt by Petitioner to square its arguments with those in the District Court, or to assuage concerns that advancing on different claim constructions will lead to different outcomes. According to the Director, this approach contradicts the Patent Office’s stated goal in modifying its claim construction rules so that “[petitioners] will have less flexibility to advance inconsistent arguments about claim scope, and ***will instead be required to choose a single claim construction that best captures the true meaning of the patent claim.***”

Paper 20 at 4 (emphasis added).

Petitioner argues that its conflicting claim constructions “are warranted for the precise reasoning and justification endorsed by the Director: ‘if a party advances a narrow construction in the district court and the district court declines to adopt the narrow construction, the party would have sufficient reason for advancing the broader, court-adopted construction in a proceeding before the Board.’” Paper 23 at 1-2. But Petitioner mischaracterizes the Director’s statements. The Director actually explained that “[a]llowing petitioners to continue this practice [of proposing different claim construction in the two forums] does not further the Office’s goal of “providing greater predictability and certainty in the patent system.” Paper 20 at 4-5. The narrow exception laid out by the Director is reserved for situations where “the district court *declines to adopt the narrow construction*” and only then the party would “have sufficient reason for advancing the broader, court adopted construction in a proceeding before the Board.” Paper 20 at 5; *see also Sun Pharmaceutical Industries*, IPR2025-00893, Paper 18 at 3 (Sept. 19, 2025) (same). That is not the case here where the District Court and PTAB are currently engaged in claim construction at the same time putting the forums on a crash course for conflicting results.¹ Indeed, after denying Petitioner’s motion to stay the litigation,

¹ The narrow exception identified by the Director does not exist here because there has been no District Court claim construction. The Petitioner’s approach thus “puts

the District Court entered a scheduling order, with claim construction briefing already underway. EX2021 (order denying motion to stay); EX2022 (scheduling order).

In sum, the Director gave narrow authority for additional briefing, as necessary, “to determine whether Petitioner has provided a sufficient reason why different claim construction positions are warranted.” *Id.* Petitioner has failed to do so. Petitioner’s submission points to nothing in its Petition that would be a “sufficient reason” to justify different claim constructions. In fact, the Petition’s claim construction section includes only two sentences of argument that fail to provide any reasoning for advancing competing constructions. Paper 2 at 9-10. And even Petitioner’s new stated reasoning that they have “advanced Patent Owner’s own broader construction before the Board in the event the district court declines to adopt the narrow construction” directly conflicts with well-settled PTAB precedent that prohibits using the PTAB to make backup arguments to hedge against a claim construction loss in district court.

B. Petitioner Provides No Justification For Arguing Conflicting Indefiniteness Positions

Furthermore, the Petitioner provides no justification at all for advancing constructions that Petitioner argues are indefinite at the District Court. Petitioner

the cart before the horse.”

summarily argues that “although Petitioner has proposed different constructions for the terms ‘internal cavity’ and ‘unfilled open space,’ and alternatively that such terms are indefinite, an ordinarily skilled artisan would understand that the asserted art satisfies these claim limitations notwithstanding the alleged indefiniteness. ... Here, the prior art plainly falls within the non-indefinite scope of the terms even though their outer bounds do not have reasonable certainty.” Paper 23 at 12. But Petitioner never explained in its Petition how the claims have a “non-indefinite” scope within a larger alleged indefinite range. Instead, Petitioner purported to adopt Patent Owner’s constructions without analyzing whether that construction was an alleged “non-indefinite” portion of an otherwise alleged indefinite claim. And Petitioner’s conclusory one paragraph argument in its brief does not provide justification for these competing indefiniteness positions. Paper 23 at 12. In sum, Petitioner’s argument of “non-indefinite scope” within an otherwise indefinite term is not only non-sensical, it fails to answer the Director’s question.

The Director recently rejected an IPR petition on the same grounds where Petitioner took indefiniteness positions in the District Court, yet applied meaning to the terms in the IPR. In *Tesla, Inc. v. Intellectual Ventures II LLC*, the petitioner argued in district court that the claim was indefinite but adopted patent owner’s construction in the IPR. IPR2025-00340, Paper 18 (Director, Nov. 5, 2025). The Director rejected petitioner’s basis for making these inconsistent arguments, holding

that petitioner’s reasoning “amounts to an assertion that a Petitioner should be permitted to raise inconsistent invalidity challenges in [] two forums.” *Id.* at 3.

So too here, Petitioner fails to provide any reasoning or justification for its competing indefiniteness positions. Petitioner just argues that “an ordinarily skilled artisan would understand that the asserted art satisfies these claim limitations notwithstanding the alleged indefiniteness.” Paper 23 at 12. In other words, Petitioner contends that as long as it argues a POSITA would have found the limitation both indefinite **and** disclosed by the prior art, it is free to make inconsistent invalidity challenges. This is not sufficient reasoning, and it fails for the same reason explained in *Tesla* as it merely “amounts to an assertion that a Petitioner should be permitted to raise inconsistent invalidity challenges in [] two forums.” *Tesla*, IPR2025-00340, Paper 18 at 3. *See also American Airlines, Inc. v. Intellectual Ventures I LLC*, IPR2025-01055, Paper 11 at 13 (“If, according to Petitioner, many limitations in claim 1 (and other claims) are indefinite, then how does Petitioner propose that the Board construe such limitations to assess Petitioner’s invalidity challenges—Petitioner is silent. Indeed, Petitioner provides no explanation for its different claim construction positions in the two forums. This alone favors denial of institution.”); *Samsung Electronics Co., Ltd. v. Wilus Institute of Standards and Technology Inc.*, IPR2025-00988, Paper 12 at 6 (“In this proceeding, Petitioner takes alternative positions on claim construction before the Board and a district court, but

fails to explain why alternative positions are warranted. Therefore, in accordance with *Revvo* and *Tesla*, we deny institution.”).

Petitioner attempts to avoid its lack of acknowledgement of the incoherency in its claim construction approaches, including indefiniteness, in this IPR and the District Court. Paper 23 at 6. But Petitioner was not “transparent” with this Board about its indefiniteness positions in the District Court. Nowhere does the Petition call out Petitioner’s indefiniteness positions in the District Court for the Board.² Such indefiniteness arguments are uniquely suited for District Court and not appropriate for IPR. *See Micron Technology, Inc. v. Innovative Memory Systems Inc.*, IPR2016-00324, Paper 11 at 10 (“Without addressing indefiniteness under 35 U.S.C. 112 ¶ 2, in inter partes petitions, as noted above, if the scope and meaning of the claims cannot be determined without speculation, the differences between the claimed invention and the prior art cannot be ascertained.”).

C. Petitioner’s Reliance on Pending Child-Application Rejections Is Irrelevant to Rule 42.104(b)(3) Compliance And Contrary To The Examiner’s Directive

Petitioner cites to office actions in a different, pending patent prosecution as alleged justification for its conflicting claim constructions. However, these office

² For similar reasons, the Petition does not make this apparent to the Director that Petitioner is taking incoherent indefiniteness positions in the District Court and in this IPR. Thus, the Director’s remand order cannot be viewed as implicitly accepting those incoherent indefiniteness positions, particularly in view of *Tesla*.

actions have no bearing on whether Petitioner has complied with Rule 42.104(b)(3) by explaining its conflicting claim construction positions taken in different forums. Petitioner also failed to make such arguments or justifications in its original Petition and provides no basis for why it should be entitled to supplement its arguments now.

Petitioner's argument is that because claims in a related application received a non-final rejection relating to art that Petitioner relies on in its Petition, this should justify instituting the *inter partes* review. Paper 23 at 11-12. Petitioner bases its argument on "consistency within the Patent Office," yet Petitioner makes no attempt to explain or justify the corollary concern of inconsistency between the Patent Office and the District Court, which is of greater concern due to Article III powers of district courts and the animating purposes of the AIA which created IPRs.³ Furthermore, Petitioner ignores that it is pointing to non-final office actions in a different application—the fact that the examiner has issued a non-final office action in a different application does not relieve Petitioner of its burden in this IPR to comply with Rule 42.104(b)(3) and explain its arguments. Moreover, nowhere does

³ Petitioner's express of concern of consistency within the Patent Office is grossly exaggerated given that even Petitioner acknowledges that the claims are not identical across the child application and the patent at issue in this IPR and prosecution of the child application is still ongoing. Paper 23 at 11. In any event, the District Court is proceeding with claim construction briefing toward a claim construction order that will inform claim construction for that child application. EX1036.

Petitioner argue that (a) the claim scope in the child application is the same as patent claim scope in this IPR; or (b) that the Examiner of the child application is applying claim constructions proposed by either Petitioner or Patent Owner in the District Court. For the same reason, nowhere does Petitioner attempt to reconcile the different claim constructions offered by Petitioner in the District Court and in this IPR.

Petitioner's arguments also go beyond the initial petition and attempt to inject new arguments when the Director instructed that additional briefing was only authorized to consider whether "Petitioner *has provided a sufficient reason*," looking retrospectively to the Petition. Paper 20 at 5 (emphasis added). Petitioner's new arguments should fail for this reason alone.

D. Petitioner's Arguments About the Specification Reinforce That It Is Improperly Attempting To Advance Multiple Claim Constructions

Petitioner argues the Board has "tacitly recognized the claim construction proposed by Petitioner in the district court proceeding is consistent with the express disclosures in the specification." Paper 23 at 7-8. In other words, rather than justifying its decision to use Patent Owner's constructions, Petitioner now wavers and argues in favor of its district court construction at least for the "housing" limitation. *Id.* at 7-10.

Petitioner's argument demonstrates the fatal problem with its IPR petition. First, in the IPR petition Petitioner summarily states "Petitioner accepts Patent

Owner's proposed constructions from the underlying district court litigation for purposes of this proceeding," falling far short of meeting its burden under Rule 42.104(b)(3) to explain its claim construction positions. Paper 2 at 9-10. Now, Petitioner wants to shift its position to argue that the correct construction is the construction advanced by Petitioner in the District Court. But Petitioner failed to meet its duty to explain this claim construction dispute in the Petition, much less to justify its decision to proceed on contrary claim construction. Petitioner's attempt to back-pedal at this stage warrants denial of institution.

Allowing the Petitioner to shift its position at this juncture and argue the Board should adopt a different claim construction exemplifies the problem with allowing a Petitioner to take conflicting claim construction positions in the first place. Rather than working towards the true and accurate construction of the claims, the Petitioner is presenting a moving target on claim construction. Such behavior defies the purpose of IPR proceedings and the spirit of compliance with Rule 42.104(b)(3) under PTO precedent. Paper 20 at 4 ("The Board's claim construction rules are designed to ensure that the Board correctly construes claim terms and to minimize inconsistency in claim construction between forums.").

Even more, Petitioner tries to put words in the mouth of the Board never uttered by the Board. Petitioner argues that the Board, at least tacitly, recognized that the "housing" term "exclude[s] any use of potting material." Paper 23 at 9. The

Board never found any such thing. But this is a key issue of claim construction presented in the District Court, and it involves a disclaimer analysis that is more appropriate for that forum than IPR because the District Court has the benefit of making that claim construction in view of the accused products in the case. EX2023 at 16-17 (“There can be no disclaimer of the use of both surface features and filling agents because that structure (or a similar structure) was not discussed in the patent specification or its file history, and Revvo [Petitioner] does not argue otherwise.”) (citing Federal Circuit cases).

III. CONCLUSION

Petitioner has failed to explain how its Petition provided a “sufficient reason why different claim construction positions are warranted” nor have Petitioner’s untimely new arguments justified its inconsistent claim construction positions. Petitioner’s stated purpose of adopting Patent Owner’s constructions as a backup plan “in the event the district court declines to adopt the narrow construction” is not an acceptable basis for arguing conflicting positions in different forums and would open the door to every Petitioner advancing different claim constructions in IPRs and District Court – the very result that the Director’s decision is directed to avoid.

The Director’s decision to vacate the institution decision was correct and Petitioner has not advanced sufficient reasoning to comply with Rule 42.104(b)(3). Therefore, the petition should be denied.

Dated: December 19, 2025

Respectfully submitted,

By: /Christopher D. Bright/
Christopher D. Bright
Reg. No. 46,578

Counsel for Patent Owner

CERTIFICATE OF SERVICE

I certify that on December 19, 2025, I caused to be served a true and correct copy of the foregoing PATENT OWNER'S OPPOSITION TO PETITIONER'S BRIEF REGARDING DIRECTOR'S ORDER VACATING THE DECISION GRANTING INSTITUTION by electronic means at the following addresses of record:

Orion Armon (Reg No. 65,421)

E-mail: oarmon@cooley.com

Jennifer Volk-Fortier (Reg No. 62,305)

E-mail: jvolkfortier@cooley.com

Dustin M. Knight (Reg. No. 76,239)

Email: dknight@cooley.com

Adam M. Pivovar (*pro hac vice* to be filed)

Email: apivovar@cooley.com

Reuben Chen (*pro hac vice* to be filed)

Email: rchen@cooley.com

Dated: December 19, 2025

By: /Christopher D. Bright/
Christopher D. Bright
Reg. No. 46,578
Counsel for Patent Owner