

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRANSCEND INFORMATION INC.,

Petitioner,

v.

TRUESIGHT COMMUNICATIONS LLC,

Patent Owner.

Patent No. 8,977,783

Filing Date: October 18, 2010

Issue Date: March 10, 2015

Inventors: Mark P. Hahn, Daniel V. Bolstad, and Joseph P. Zipperer

Title: HIGH-SPEED SECURE CONTENT TRANSFER
TO SD CARD FROM KIOSK

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2025-00723

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2001	First Amended Docket Control Order, Dkt. 28, <i>Truesight Commc'ns LLC v. Transcend Info. Inc.</i> , Case No. 2:24-cv-00186-JRG (E.D. Tex. August 14, 2024)
2002	Transcend Information Inc.'s Invalidity Contentions and P.R. 3-3 and 3-4 Disclosures, dated October 24, 2024, in <i>Truesight Commc'ns LLC v. Transcend Info. Inc.</i> , No. 2:24-cv-00186-JRG (E.D. Tex.)

I. INTRODUCTION

On March 12, 2025, Transcend Information Inc. (“Petitioner”) submitted a Petition (Paper 1, “Petition” or “Pet.”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 8,977,783 (Ex. 1001, the “’783 Patent”), challenging Claims 1-18 (the “Challenged Claims”). The Petition asserts that Claims 1-18 are rendered obvious over various proposed combinations of at least three references. The Board should deny the Petition for at least the reasons described below.

First, regarding Claim 1, Petitioner fails to demonstrate that the prior art discloses or renders obvious the limitations “requesting the plurality of media files and corresponding metadata file for each media file from a server” and “receiving the requested plurality of media files and the corresponding metadata files from the server.” While Petitioner generally alleges that “Thompson discloses” limitations 1b and 1c, Petitioner does not identify a single citation or shred of evidence in Thompson regarding requesting or receiving metadata, much less a metadata file. Pet. at 24-27. For each of these limitations, Petitioner advances a short conclusory, unsupported statement that “it would have been obvious to a POSITA that a download of a video file could and would include a metadata file.” *Id.* 25, 26. This short POSITA statement fails to identify a teaching, suggestion, or motivation to combine teachings, and fails to allege any expectation of success. Accordingly, there is no reasonable likelihood of success with respect to Claims 1-6.

Second, regarding Claims 7 and 12, Petitioner fails to demonstrate that the prior art discloses or renders obvious the limitation “writ[ing/e] all directory blocks together of the playable content portion of the media file and, thereafter in time, write all data blocks sequentially of the playable content portion of the media file.” While Petitioner generally alleges that “Thompson discloses this limitation,” Petitioner does not identify a single citation in Thompson to disclose the actual limitation. Pet. at 48-49. For each of these limitations, Petitioner advances a short conclusory, unsupported statement that “it would have been obvious to a POSITA to write directory blocks of a media file prior to writing data blocks.” *Id.* This short POSITA statement is based on an allegation of storing metadata, which Thompson does not address, as discussed above. Petitioner fails to identify any teaching, suggestion, or motivation to combine teachings, and fails to allege any expectation of success. Accordingly, there is no reasonable likelihood of success with respect to Claims 7-18.

Third, the Board should exercise its discretion to deny the Petition under 35 U.S.C. § 314(a). The Petition identifies co-pending district court litigation *Truesight Commc’ns, LLC v. Transcend Info. Inc.*, No. 2:24-cv-00186-JRG (E.D. Tex.) (“District Court Litigation”) with a trial date set for January 5, 2026. With Patent Owner’s Preliminary Response due July 16, 2025, institution of any grounds will result in the issuance of a Final Written Decision (“FWD”) by October 16, 2026.

The Board should exercise discretion to deny the Petition under 35 U.S.C. § 314(a) for at least the following reasons: (i) the parallel District Court Litigation exists between the same parties or real-parties-in-interest; (ii) the District Court Litigation involves the same subject patent (the '783 Patent) with substantially the same claims; (iii) the District Court's trial will be *over nine months before* the projected statutory deadline for FWD; (iv) the parties have heavily invested in the District Court Litigation with the deadline for substantial completion of discovery having passed on June 5, 2025, and the completion of fact and expert discovery and the filing of dispositive motions all due before the October 14, 2025, the deadline for an institution decision; and (v) there is no stay of the parallel District Court Litigation, and Petitioner has not sought a stay. Accordingly, the Board should exercise discretion to deny the Petition.

II. CLAIM CONSTRUCTION

For the purposes of this Preliminary Response, Patent Owner does not adopt any meaning other than the plain and ordinary meaning.

III. LEVEL OF ORDINARY SKILL IN THE ART

For the purposes of this Preliminary Response only, Patent Owner utilizes Petitioner's proposed level of skill in the art: "at least a bachelor's degree in computer science, computer engineering, electrical engineering, or a related field

and two to three years of experience in the field of data management.” Pet. at 6 (citations omitted).

**IV. PETITIONER HAS NOT DEMONSTRATED A REASONABLE
LIKELIHOOD OF SUCCESS FOR THE GROUNDS
ADVANCED IN THE PETITION, AND THE PETITION
SHOULD BE DENIED**

The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) so-called secondary considerations where in evidence. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983).

The Board has held that a failure to identify the differences between the claimed subject matter and the prior art is fatal to an obviousness challenge. *See, Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00355, Decision Denying Institution of *Inter Partes* Review, Paper 9 at 9-10 (P.T.A.B. June 26, 2015) (denying institution for failure to identify the differences between the claimed subject matter and the prior art).

In arriving at an obviousness determination, the Board must sufficiently explain and support the conclusions that the prior art references disclose all the elements recited in the Challenged Claims and a relevant, skilled artisan not only could have made, but would have been motivated to combine all the prior art references in the way the patent claims and reasonably expected success. *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017). That is, even if all the claim elements are found across a number of references, an obviousness determination must consider whether a person of ordinary skill in the art would have the motivation to combine those references. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *Los Angeles Biomedical Rsch. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.*, 849 F.3d 1049, 1067 (Fed. Cir. 2017) (vacating and remanding an obviousness determination, in part, because the Board did not make factual finding as to whether there was an apparent reason to combine all three prior art references to achieve the claimed invention and whether a person of skill in the art would have had a reasonable expectation of success from such a combination). This combinability determination, as supported by an articulated motivation to combine, requires a plausible rationale as to why those prior art references would have worked together. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013). Absent some articulated rationale, a “common sense” finding is no different than the conclusory statement “would have been

obvious.” *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017). Of additional importance, “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references” *Innogenetics, N.V. v. Abbott Lab’ys.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008).

A. Independent Claim 1: The Petition Fails to Show How the References Teach or Render Obvious Claim Limitations 1b and 1c: “requesting the plurality of media files and corresponding metadata file for each media file from a server” and “receiving the requested plurality of media files and the corresponding metadata files from the server”

Claim limitations 1b and 1c recite *requesting the plurality of media files and corresponding metadata file for each media file from a server and receiving the requested plurality of media files and the corresponding metadata files from the server*, respectively. Petitioner alleges that claim limitations 1b and 1c are disclosed by Thompson alone. Pet. at 24-25.

Regarding claim limitation 1b, Petitioner addresses the alleged disclosure in one single paragraph. *Id.*

Thompson discloses requesting media files based on a user’s selection. Ex[1005] at [0042] (“the video kiosk 100 can connect to an external network location to retrieve video content on-the-fly when requested by a user or to retrieve video content for local storage on one or more mass storage devices in the video kiosk 100.)” Thus, because the kiosk disclosed by Thompson includes functionality for

requesting media files in response to user input, a POSITA would have understood that Thompson's kiosk includes a "media file request module" for requesting media files from a server communicatively coupled to the kiosk. Ex[1003], ¶ 83.

Citing paragraph 0042 of Thompson, Petitioner alleges that "Thompson discloses requesting media files based on a user's selection." Paragraph 0042 is limited to a discussion of video content. Petitioner does not cite to any other section of Thompson to allege disclosure of the *requesting . . . corresponding metadata file for each media file from a server*.

Petitioner dedicates another single paragraph to explaining away this deficiency. Pet. at 25.

To the extent that Thompson's retrieval of "video content" does not disclose a "corresponding metadata file," it would have been obvious to a POSITA that a download of a video file could and would include a metadata file. Ex[1003], ¶ 84. As the '783 Patent explains, "[m]etadata includes the title of the playable content, and expanded descriptive information about the content, such as the actors, the director, and/or other information that may appear on or inside a DVD box, for example." Ex[1001] at 3:36-39. Thompson discloses that the control program and electronics 2300 can load "extra features" or "additional video". Ex[1005] at [0123]. Including such information with the download of a video file would have been obvious to a POSITA, as such information is useful to display to the user during playback of the video content. Ex[1003], ¶ 85. Further, providing such information with video rentals was common practice. Ex[1003], ¶ 85.

Petitioner contends that “a download of a video file could and would include a metadata file.” *Id.* Petitioner does not address or explain how the actual limitation of requesting is met under this alleged possibility. Petitioner’s identification of a DVD box or other video content does not address the limitation. Petitioner’s obviousness statement is conclusory and lacking in evidentiary support. The Petition reads out the limitation *requesting . . . corresponding metadata file for each media file from a server*. To the extent Petitioner intends to rely on an obviousness argument to modify the Thompson reference, Petitioner fails to properly articulate any teaching, suggestion, or motivation in the prior art, and Petitioner fails to identify any expectation of success.

Similarly, regarding claim limitation 1c, Petitioner alleges disclosure in one single paragraph. Pet. at 26.

Thompson discloses a kiosk that receives a media file from a server. Ex[1005] at [0101] (“if the local mass storage device 2200 does not have a video title desired by a user, the video kiosk 100 can contact the content server 2210 on-the-fly to download the desired video content.”). Thus, because the kiosk disclosed by Thompson includes functionality for “communicat[ing] with a store server” and “receiv[ing] media files from the store server” a POSITA would have understood that Thompson’s kiosk includes a “server interaction module” of the type claimed in the ’783 Patent. Ex[1003], ¶ 87.

Again, Petitioner does not identify any citation or explain how the above discloses *receiving . . . the corresponding metadata files from the server*. Petitioner dedicates another single paragraph to explaining away this deficiency. *Id.* at 26-27.

To the extent that Thompson’s retrieval of “video content” does not disclose a “corresponding metadata file,” it would have been obvious to a POSITA that a download of a video file could and would include a metadata file. Ex[1003], ¶ 88. Again, as the ’783 Patent explains, “[m]etadata includes the title of the playable content, and expanded descriptive information about the content, such as the actors, the director, and/or other information that may appear on or inside a DVD box, for example.” Ex[1001] at 3:36-39. Thompson discloses that the control program and

electronics 2300 can load “extra features” or “additional video.” Ex[1005] at [0123]. Including such information with the download of a video file would have been obvious to a POSITA, as such information is useful to display to the user during playback of the video content. Ex[1003], ¶ 85. Further, providing such information with video rentals was common practice. Ex[1003], ¶ 85.

Petitioner contends that “a download of a video file could and would include a metadata file.” *Id.* at 26. Petitioner does not address or explain how the actual limitation of requesting is met under this alleged possibility. Petitioner’s identification of a DVD box or other video content does not address the limitation.

Petitioner's obviousness statement is conclusory and lacking in evidentiary support. The Petition reads out the limitation *receiving . . . the corresponding metadata files from the server*. To the extent Petitioner intends to rely on an obviousness argument to modify the Thompson reference, Petitioner fails to properly articulate any teaching, suggestion, or motivation in the prior art, and Petitioner fails to identify any expectation of success.

Accordingly, Petitioner has failed to show a reasonable likelihood of success as to Claims 1-6, and the Petition should be denied.

B. Independent Claims 7 and 12: The Petition Fails to Show How the References Teach or Render Obvious Claim Limitations 7c and 12c: “writ[ing/e] all directory blocks [together] of the playable content portion of the media file [together] and, thereafter in time, write all data blocks sequentially of the playable content portion of the media file”

Claim limitation 7c recites *writing all directory blocks of the playable content portion of the media file together and, thereafter in time, writing all data blocks sequentially of the playable content portion of the media file*. Claim limitation 12c recites *write all directory blocks together of the playable content portion of the media file and, thereafter in time, write all data blocks sequentially of the playable content portion of the media file*. Petitioner alleges that these limitations are disclosed by Thompson alone. Pet at 48.

Petitioner submits a single paragraph to support its allegations of disclosure of the entire limitation by Thompson. *Id.* at 49.

Thompson discloses pre-allocating space on the SD card for media file storage before writing, ensuring efficient content transfer. Ex[1005] at [0105] (“The video kiosk 100 also comprises programming circuits 2260 to program encrypted video content and associated keys into a removable solid-state memory device 2270.”).

Petitioner provides no explanation regarding how the excerpt at Thompson paragraph 0105 relates to the claim limitation.

Petitioner appears to advance an alternative theory based on obviousness with no supporting evidence.

Further, it would have been obvious to a POSITA to write directory blocks of a media file prior to writing data blocks. Ex[1003], ¶ 142. A POSITA would recognize that directory blocks store metadata such as file names, sizes and locations of data blocks, and data blocks store the actual media content. *Id.* Writing directory blocks first followed by sequential data blocks is a well-known technique in file system design, which ensures that the file system can properly reference the data before it is fully written. *Id.* Modern file systems inherently use this approach for storage on removable media. *Id.*

Petitioner provides no actual evidence other than citation to conclusory expert testimony and waves its hand at the entire limitation as being “well-known” without

evidence. Regardless, Petitioner's allegations must be supported by evidence to be successful and there is none in the record. Petitioner's obviousness statement is conclusory and lacking in evidentiary support. The Petition reads out the entire limitation of *writing all directory blocks of the playable content portion of the media file together and, thereafter in time, writing all data blocks sequentially of the playable content portion of the media file*. To the extent Petitioner intends to rely on an obviousness argument to modify the Thompson reference, the Petition fails to properly articulate any teaching, suggestion, or motivation in the prior art, and Petitioner fails to identify any expectation of success.

Accordingly, Petitioner has failed to show a reasonable likelihood of success as to Claims 7-18, and the Petition should be denied.

V. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE BOARD UNDER 35 U.S.C. § 314(a)

The circumstances of the parallel District Court Litigation, *Truesight Commc'ns, LLC v. Transcend Info. Inc.*, No. 2:24-cv-00186-JRG (E.D. Tex.), necessitate denial of the Petition under the Board's precedent, as every factor considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (considering (a) "whether the petitioner and the defendant in the parallel proceeding are the same party"; (b) "overlap between issues raised in the

petition and in the parallel proceeding”; (c) “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision”; (d) “investment in the parallel proceeding by the court and the parties”; (e) “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted”; and (f) “other circumstances that impact the Board’s exercise of discretion, including the merits.”).

As set forth below, these factors collectively demonstrate that efficiency and integrity of the AIA are best served by denying review. First, the Petitioner is the defendant in the parallel proceeding. *See infra* Section II.A. Second, the District Court Litigation involves substantially the same claims at issue in the Petition. *See infra* Section II.B. Third, trial in the District Court Litigation is set for January 5, 2026, more than nine months prior to the projected statutory deadline for a Final Written Decision of this Petition on October 16, 2026. *See infra* Section II.C. Fourth, the parties (and Patent Owner in particular) have invested significant resources on developing legal and factual issues of validity and infringement in the District Court Litigation and will have invested substantially more resources before any decision on this Petition. *See infra* Section II.D. Fifth, Petitioner has not sought a stay of the District Court litigation, and any request would likely be denied. Finally, no other factors favor institution. *See infra* Section II.F.

Accordingly, the Board should exercise discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

A. The Parallel District Court Litigation and the Petition Involve the Same Parties

As Petitioner notes, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the '783 Patent). Pet. at 1, 66. Petitioner is a party to the District Court Litigation captioned as *Truesight Commc'ns, LLC v. Transcend Info. Inc.*, No. 2:24-cv-00186-JRG (E.D. Tex.). The District Court Litigation involves causes of action asserting the '783 Patent against Petitioner's products, which include memory modules and storage devices, such as SD cards including, but not limited to, SD cards, microSD Cards, CFexpress cards, CompactFlash Cards, CFast 2.0 cards, and Expansion cards. Exhibit 1011. Petitioner concedes that it is a real party-in-interest and that Petitioner has not sought a stay in the District Court Litigation, nor will it until the IPR is instituted. Pet. at 66 (“Further, Petitioner intends to request a stay *if the IPR is instituted.*”) (emphasis added).

Petitioner also waited nearly eight months after service of Patent Owner's infringement contentions on Petitioner. Exhibit 2001.

Accordingly, this factor weighs strongly in favor of discretionary denial.

B. The District Court Litigation Involves Substantially the Same Claims

There is complete overlap between the claims and grounds at issue in this Petition and the District Court Litigation because the Petition challenges all claims asserted in the District Court Litigation under the same grounds. Ex. 2002 at 3-4. "In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions." *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020).

Accordingly, this factor weighs strongly in favor of discretionary denial.

C. Proximity of the District Court's Trial Date

The proximity of the District Court Litigation's trial date to the Board's projected statutory deadline for a Final Written Decision weighs strongly in favor of discretionary denial.

The parties' trial is scheduled for January 5, 2026. Ex. 1010 (Second Amended Docket Control Order, Dkt. 31, *Truesight Commc'ns LLC v. Transcend Info. Inc.*, Case No. 2:24-cv-00186-JRG (E.D. Tex. October 15, 2024)). Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final

Written Decision of this Petition is October 16, 2026. As the District Court’s trial will be *nearly nine months before* the projected statutory deadline, this factor weighs strongly in favor of denying institution. *See Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 10-12 (P.T.A.B. June 24, 2020) (denying institution where the jury trial was scheduled to conclude approximately ten months before the statutory deadline); *Edward LifeSciences Corp. v. Evalve, Inc.*, IPR2019-01479, Paper 7, at 6-13 (P.T.A.B. Feb. 26, 2020) (denying institution where jury trial would conclude more than nine months before a final decision would be due); *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude “several months,” before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 (“Because the trial date is substantially earlier than the projected statutory deadline for the Board’s final decision, this factor weighs in favor of discretionary denial.”); *Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00329, Paper 13 at 7-15 (P.T.A.B. Jul. 6, 2021) (denied when two related trials predate FWD by eleven months and seven months, respectively); *F5 Networks, Inc. v. WSOU Invs., LLC*, IPR2022-00239, Paper 12 at 7-8 (P.T.A.B. May 19, 2022) (denied when trial

predates FWD by six months); *Google LLC v. EcoFactor, Inc.*, IPR2021-00488, Paper 12 at 11-12 (P.T.A.B. Aug. 11, 2021) (denied when trial predates FWD by six months); *Cisco Sys., Inc. v. Oyster Optics, LLC*, IPR2021-00238, Paper 10 at 11-13 (P.T.A.B. Jun. 1, 2021) (denied when trial predates FWD by seven months); *Samsung Elecs. Co. v. Truesight Commc'ns LLC*, IPR2025-00123, Paper 12 at 6-7 (Apr. 22, 2025) (denied when trial predates FWD by six months). The nearly nine-month differential between the January 2026 trial date and the October 2026 FWD by far justifies discretionary denial.

Accordingly, this factor weighs strongly in favor of discretionary denial.

D. Significant Investment and Petitioner's Delay in Filing the Petition

The parties' investment in the parallel proceeding weighs strongly in favor of discretionary denial. In the District Court Litigation, the parties have already exchanged preliminary infringement and invalidity contentions, and the parties have already completed claim construction proceedings. The deadline for substantial completion of document production passed on June 5, 2025. Ex. 1010. Claim construction is also complete in the District Court Litigation

Before the October 16, 2025, statutory deadline for an institution decision, the parties will have completed fact and expert discovery, and the parties will have filed their dispositive motions and responses thereto in the District Court Litigation. *Id.*

A trial date is set for January 5, 2026, which is approximately seven months away. *Id.* Accordingly, the parties' and Court's substantial investment in this proceeding weigh strongly in favor of denial of institution.

E. No Stay of the Parallel District Court Litigation

There is no stay of the parallel District Court Litigation. Petitioner concedes that it has not sought a stay in the District Court Litigation and will not seek a stay until the IPR is instituted. Pet. at 66 ("Further, Petitioner intends to request a stay *if the IPR is instituted.*") (emphasis added). Even if Petitioner files a motion to stay, the Eastern District of Texas routinely denies requests to stay pending IPRs before institution on all asserted claims of all asserted patents. *See Force Mos Tech., Co. v. ASUSTek Comput., Inc.*, No. 2:22-CV-00460-JRG, 2024 WL 1586266, at *4 (E.D. Tex. Apr. 11, 2024) (citation omitted).

Accordingly, the lack of a stay and future unlikelihood of a stay before an institution decision weighs strongly in favor of denial of institution.

F. Other Factors Favor Discretionary Denial

Petitioner claims that the merits of the Petition and this IPR being the sole IPR challenging the '783 Patent weigh against discretionary denial. Pet. at 67. However, the merits of the Petition are weak and rely extensively on a 66-page expert declaration to fill holes in the references. Taking Claim 1 as an example, Petitioner relies on expert-asserted POSITA knowledge to teach missing elements in 1-Pre, 1B,

1C, 1D, 1E, 1F, 1G, 1H, and 1I. Similarly, in the absence of any relevant disclosure in claim limitations 7c and 12c, Petitioner relies exclusively on expert testimony to disclose the entirety of the limitations 7c and 12c. Pet. 48-49. Petitioner's extensive reliance on and over-use of expert testimony should weigh in favor of denial.

When viewing the factors together, the Petition should be denied in the Board's discretion under 35 U.S.C. § 314(a).

VI. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition in its entirety.

Respectfully submitted,

Dated: July 16, 2025

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE specified in 37 C.F.R. § 42.24 has 3,650 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

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CERTIFICATE OF SERVICE

A copy of the foregoing Patent Owner's Preliminary Response has been served on Petitioner's counsel of record as follows:

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