

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Google LLC,
Petitioner,

v.

Withrow Networks Inc.,
Patent Owner.

Case No. IPR 2025-00775
U.S. Patent No. 10,771,849 B2

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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2001	<i>Withrow Networks, Inc. v. Google, LLC and YouTube, LLC</i> , No. 5:24-cv-03203-PCP (NDCA), Complaint filed May 24, 2024 (D.I. 1) (“Complaint”)
2002	<i>Withrow Networks, Inc. v. Google, LLC and YouTube, LLC</i> , No. 5:24-cv-03203-PCP (NDCA), Order Denying Motion to Dismiss dated January 21, 2025 (D.I. 44) (“Order Denying Motion to Dismiss”)
2003	<i>Withrow Networks, Inc. v. Google, LLC and YouTube, LLC</i> , No. 5:24-cv-03203-PCP (NDCA), Answer filed February 4, 2025 (D.I. 48) (“Answer”)
2004	<i>Withrow Networks, Inc. v. Google, LLC and YouTube, LLC</i> , No. 5:24-cv-03203-PCP (NDCA), the parties’ Joint Case Management Statement dated February 7, 2025 (D.I. 48) (“Joint Case Management Statement”)
2005	<i>Withrow Networks, Inc. v. Google, LLC and YouTube, LLC</i> , No. 5:24-cv-03203-PCP (NDCA), Motion to Stay Case Pending the Resolution of Petition for <i>Inter Partes</i> Review dated March 25, 2025 (D.I. 60) (“Motion to Stay”)
2006	<i>Withrow Networks, Inc. v. Google, LLC and YouTube, LLC</i> , No. 5:24-cv-03203-PCP (NDCA), Opposition to Motion to Stay dated April 8, 2025 (D.I. 63) (“Opposition to Motion to Stay”).
2007	<i>Withrow Networks, Inc. v. Google, LLC and YouTube, LLC</i> , No. 5:24-cv-03203-PCP (NDCA), Reply Re Motion to Stay Case Pending the Resolution of Petition for <i>Inter Partes</i> Review dated April 15, 2025 (D.I. 70) (“Reply re Motion to Stay”)
2008	<i>Withrow Networks, Inc. v. Google, LLC and YouTube, LLC</i> , No. 5:24-cv-03203-PCP (NDCA), Stipulation and Order re Electronically Stored Information dated March 24, 2025 (D.I. 59) (“ESI Order”)
2009	<i>Withrow Networks, Inc. v. Google, LLC and YouTube, LLC</i> , No. 5:24-cv-03203-PCP (NDCA), Order re Dispute re Proposed

Exhibit No.	Description
	Protective Order dated March 28, 2025 (“Order on Discovery Letter Brief”).
2010	<i>Withrow Networks, Inc. v. Google, LLC and YouTube, LLC</i> , No. 5:24-cv-03203-PCP (NDCA), Stipulated Protective Order dated April 10, 2025 (“SPO”)
2011	Judge P. Casey Pitts Standing Order for Civil Cases (Aug. 2024)
2012	Exhibit 0 to Invalidity Contentions Served in NDCA Litigation

In accordance with the United States Patent and Trademark Office’s “Interim Processes for PTAB Workload Management” Guidance Memorandum dated March 26, 2025 (“Guidance”), Withrow Networks, Inc. (“Withrow” or “Patent Owner”) submits this Request for Discretionary Denial of the Petition for *Inter Partes* Review challenging claims 1-9 (the “challenged claims”) of U.S. Patent No. 10,771,849 B2 (the “’849 Patent”) filed by Petitioner Google LLC (“Google” or “Petitioner”). Patent Owner’s Request for Discretionary Denial is filed within two months of April 17, 2025, the date on which the Board entered a Notice of Filing Date Accorded in this proceeding. *See* Paper 3.

I. Introduction

This Petition presents a textbook case for discretionary denial under 35 U.S.C. § 314(a). On May 24, 2024, Withrow filed a complaint against Google and YouTube, LLC (“YouTube”) (collectively, the “District Court Defendants”), in United States District Court for the Northern District of California Case No. 5:24-cv-03203-PCP alleging that the District Court Defendants infringe the ’849 Patent (“NDCA Litigation”). ***Over three hundred days later***—and only after the district court denied Google’s motion to dismiss, the parties submitted a proposed case schedule that can be reasonably expected to reach a final resolution before an IPR decision, Withrow served its infringement contentions, Google served its invalidity contentions, the district court implemented a protective order, and the parties began

to engage in discovery—Google filed the instant Petition on March 24, 2025, requesting institution of IPR of the '849 Patent. As explained further below, each of the six *Fintiv* factors support discretionary denial here:

- **Factor 1 (likelihood of stay)**—the NDCA Litigation is not stayed;
- **Factor 2 (trial date)**—the Final Written Decision in this IPR (expected around October 17, 2026) is likely to issue after trial in the NDCA Litigation, which is reasonably expected to be completed by the summer of 2026 based on the schedule to which the parties agreed;
- **Factor 3 (investment in parallel proceeding)**—The NDCA Litigation has advanced well beyond the early stages, the parties have already expended significant resources, and the parties will continue to expend significant resources over the next 6 months before a decision on institution of this IPR;
- **Factor 4 (overlapping issues)**—the issues in the NDCA Litigation overlap completely with the invalidity challenges here, including presenting the same art and arguments in both proceedings;
- **Factor 5 (overlapping parties)**—the parties in this IPR are both involved in the NDCA Litigation;
- **Factor 6 (other considerations)**—in addition to the relative weakness of the Petition, other relevant considerations outlined in the Director's Guidance, including "[t]he extent of the petition's reliance on expert

testimony” and the “[s]ettled expectations of the parties,” weigh in favor of discretionary denial.

On balance, the *Fintiv* Factors strongly favor denial here. Accordingly, Patent Owner respectfully requests that the Director exercise her discretion under 35 U.S.C. § 314(a) to deny institution of this proceeding.¹

Additionally, the Director should discretionarily deny the Petition under 35 U.S.C. § 315(d)/325(d) because every ground raised in the Petition relies on prior art and arguments that were previously considered by the USPTO during prosecution. Petitioner alleges that the challenged claims are invalid based on five (5) different §103 grounds—(1) U.S. Patent No. 6,389,473 (“Carmel”) in view of Mattavelli²; (2) Carmel in view of U.S. Patent No. 5,867,230 (“Wang”); (3) Carmel in view of Wang and Wolters³; (4) Carmel in view of Wang, Wolters, U.S. Patent No. 7,398,312 (“Guo”), U.S. Patent No. 7,099,389 (“Yu”), and U.S. Patent

¹ By submitting this Request for Discretionary Denial, no waiver of any argument is intended by Patent Owner. Patent Owner will file its Preliminary Response to the Petition addressing the merits of the Petition and other non-discretionary statutory considerations within three months from the date of the PTAB’s Notice of Filing Date Accorded and, should institution be granted, will file a Patent Owner Response according to the PTAB’s Scheduling Order. *See* 37 C.F.R. § 42.107; 37 C.F.R. § 42.120; Guidance at 2.

² Marco Mattavelli, Sylvain Brunetton, *Computational Graceful Degradation for Video Decoding*, Signal Processing IX Theories and Applications, Proceedings of Eusipco-98 Ninth European Signal Processing Conference (1998) (“Mattavelli”).

³ Martin Wolters et al., *A closer look into MPEG-4 High Efficiency AAC*, Audio Engineering Society (AES), 115th AES Convention (Oct. 10-13, 2003) (“Wolters”).

No. 7,096,481 (“Forecast”); and (5) Carmel in view of Mattavelli, Guo, Yu, and Forecast. All five §103 grounds of alleged invalidity are premised on the primary Carmel reference that the United States Patent Office (the “USPTO”) already considered when it examined the patent application that led to the ’849 Patent. The Director should therefore exercise her discretion to deny institution under 35 U.S.C. § 315(d)/325(d).

II. The Director Should Exercise Her Discretion to Deny Institution of the Petition.

A. The Director Should Deny Institution Under 35 U.S.C. § 314(a).

The Director should deny institution under 35 U.S.C. § 314(a) because the *Fintiv* factors weigh in favor of discretionary denial. There is no requirement that the Board institute an IPR proceeding. *See e.g., Harmonic Inc. v. Avid Tech.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). Rather, the decision to institute an IPR proceeding is discretionary. *See* 35 U.S.C. § 314(a) (“[t]he Director may not authorize an *inter partes* to be instituted unless...”); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). In determining whether to exercise discretion to deny institution, the Director “consider[s] the effect of any such regulation [under this section] on the economy, the integrity of the patent

system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.” 35 U.S.C. § 316(b).

The Board has discretion under 35 U.S.C. § 314(a) to deny institution based on efficiency considerations that stem from parallel proceedings on the same patent. *See NHK Spring Co. v. Intrix-Plex, Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential) (“*NHK Spring*”). The PTAB considers six factors for determining whether discretionary denial due to efficiency considerations relating to parallel proceedings is appropriate (the “*Fintiv* factors”):

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties;
4. Overlap between the issues raised in the petition and in the parallel proceeding;
5. Whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. Other circumstances that impact the Board’s exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). As the Board explained in *Fintiv*, “[t]hese factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* In

evaluating these factors, the Board takes “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

Here, a compelling case exists for denying IPR institution under the *Fintiv* factors.⁴

1. Factor 1 is Neutral and Does Not Weigh Against Discretionary Denial.

The first *Fintiv* factor considers whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted. Here, in the NDCA Litigation, the District Court Defendants have moved for a stay pending *inter partes* review, (*see* EX2005), Patent Owner has filed an opposition to that motion, (*see* EX2006), the District Court Defendants filed a reply (*see* EX2007), and as of the date of this filing, the district court has not yet issued a decision on the District Court Defendants’ requested stay. “In the absence of specific evidence, [the Board] will not attempt to predict how the district court in the related district court litigation will proceed” regarding a stay. *Sand Revolution II, LLC v. Cont’l Intermodal Grp.--Trucking LLC*, IPR2019-01393, Paper 24, at 7 (P.T.A.B. June

⁴ On February 28, 2025, the USPTO rescinded the “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” dated June 21, 2022 (“Interim Procedure”). Thus, rather than follow the Interim Procedure, the Board will now weigh the *Fintiv* factors as it had done prior to the Interim Procedure’s issuance, in view of the Board’s earlier precedent including *Fintiv*.

16, 2020) (informative). Accordingly, factor one is neutral and does not weigh against discretionary denial.

2. Factor 2 Weighs in Favor of Denial Because Trial in the Parallel Litigation Will Likely Occur Before the Board’s Final Written Decision.

The second *Fintiv* factor considers the proximity of the trial date to the Board’s projected statutory deadline to issue a final written decision in an IPR proceeding. Here, the parties jointly proposed a speedy schedule in the parallel district court litigation in which trial is likely to occur by the summer of 2026. (*See* EX2004, 12-13). Under that proposed schedule, claim construction briefing would be finished by September 18, 2025. (*See* EX2004, 13). And assuming a claim construction ruling within two months—a two-month estimate seems reasonable given that the parallel district litigation involves one patent and nine claims—the parties would finish their *Daubert* and dispositive motion briefing in that matter by July 2026 and be ready to proceed to trial shortly thereafter. (*See* EX2004, 13). This schedule is consistent with Judge Pitts’s standing order, which expects an initial trial date of “no more than 24 months between the initial CMC and trial[.]” (Ex. 2011, 2). In this case, the initial CMC was first scheduled for August 29, 2024, making the initial anticipated trial date no later than August 29, 2026.⁵

⁵ The initial CMC was ultimately pushed to February 21, 2025, due to Google’s request to postpone the CMC until its then-pending motion to dismiss under 35

In contrast, because Patent Owner’s Preliminary Response in this IPR is not due until July 17, 2025, (*see* Paper 3; 37 C.F.R. § 42.107(b)), the expected date for the Board’s Institution Decision is not until October 17, 2025. *See* 35 U.S.C. § 314(b). And if the proceeding is instituted, the expected date of the Board’s Final Written Decision is one year later on October 17, 2026, which could be further extended by up to another six months. *See* 35 U.S.C. § 316(a)(11).

Based on this schedule, the parallel district court litigation will likely conclude prior to the Board issuing a decision. This timeline undisputedly favors denial. The Board has held time and time again that a trial date which precedes a final written decision deadline by even a mere one or two months favors discretionary denial. *See, e.g., NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18 at 8-9 (PTAB May 2, 2022) (two-month period between trial date and deadline for final decision weighed in favor of discretionary denial); *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 at 6-9 (PTAB May 15, 2019) (one-month period between trial date and deadline for final written decision weighed in favor of discretionary denial); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12-13 (PTAB May 13, 2020) (second factor favors denial when “the currently scheduled District Court trial is scheduled to begin two months before our deadline

U.S.C. § 101 was ruled upon. However, the parties nevertheless proposed a schedule that should reach trial the summer of 2026.

to reach a final decision”); *eClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (favoring denial where beginning of jury trial was “roughly one to two months” before final decision was due); *10x Genomics, Inc. v. President and Fellows of Harvard Coll.*, IPR2023-01299, Paper 15 at 17 (PTAB Mar. 7, 2024) (finding fact that it was most likely that the district court’s trial would occur at least one month before an IPR decision weighed against institution). For the foregoing reasons, factor two weighs in favor of exercising discretion to deny institution.

3. Factor 3 Weighs in Favor of Denying Institution Due to Significant Investment in the Parallel Litigation by the Parties.

Under the third *Fintiv* factor, the Board considers “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, IPR2020-00019, Paper 11 at 9. “This investment factor is related to the trial date factor, in that more work completed by the parties and the court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Id.*, 10. This factor weighs in favor of discretionary denial.

Here, the parties and the district court have expended and will continue to expend significant resources in the parallel litigation before institution in this IPR.

Patent Owner filed the NDCA Litigation against Petitioner almost a year ago on May 28, 2024. The case is well beyond the early stages and the parties have expended significant resources and effort moving the case toward trial. The parties and the district court invested meaningful resources to investigate the eligibility of the '849 Patent claims, resulting in a full round of briefing on Petitioner's motion to dismiss, a hearing before the district court, and a decision denying Petitioner's motion to dismiss. (*See* EX2002). Additionally, Patent Owner served, and District Court Defendants responded to, a First Set of Interrogatories and Requests for Production. The parties have met and conferred multiple times regarding this set of discovery. Patent Owner served extensive infringement contentions against three (3) defendant instrumentalities (YouTube, Google Transcoder API, and Google Livestream API), many with multiple variants, totaling over 700 pages of analysis—these infringement contentions were accompanied by over 3,600 pages of materials. Defendants served their invalidity contentions, on April 21, 2025, and produced 13,638 pages of documents. Patent Owner also served a Second Set of Requests for Production and third-party subpoenas to three (3) of YouTube's streaming partners. And an ESI Order that required approximately four (4) weeks of negotiations was entered on March 24, 2025 (*see* EX2008) and a heavily disputed Protective Order was entered by the district court on April 10, 2025. (*See* EX2009; EX2010). Further, Petitioner has failed to explain why it waited ten

months—while the parties and the court made significant investments in advancing the parallel litigation forward—to file its Petition and motion to stay.

Additionally, significant activity in the parallel litigation will take place before the expected institution decision date of this proceeding on October 17, 2025. Under the schedule the parties jointly proposed by in the NDCA Litigation, claim construction briefing will be finished and damages contentions will be exchanged, all before the expected institution decision. (*See* EX2004, 13). Thus, by the time this proceeding reaches an institution decision, even more investment by the parties and court will have occurred.

Finally, it is also noteworthy that Petitioner raises validity challenges in the district court based not only on prior art patents and printed publications, but also failure of written description, lack of enablement, and claim indefiniteness. (*See* EX2003, 14). As a result, the district court will be in the best position to resolve all of the validity issues relating to the '849 Patent.

Because there has been significant investment in the parallel proceeding by the parties and the district court, and those investments will be ongoing through the expected institution date of this proceeding, factor three weighs in favor of exercising discretion to deny institution.

4. Factor 4 Weighs in Favor of Denial Because the Issues in the Parallel Proceedings Significantly Overlap.

The fourth factor addresses the overlap between the issues raised in the petition and in the parallel proceeding. Here, the overlap of issues between the parallel proceeding and the potential IPR proceeding are complete. The same patent—the '849 Patent—and the same claims—claims 1-9—are at issue in both the NDCA Litigation and this matter. Moreover, the District Court Defendants have asserted an invalidity defense in their Answer (*see* EX2003) including obviousness under 35 U.S.C § 103—*i.e.*, the same basis for Petitioner's Petition for IPR. On April 21, 2025, Petitioner served its invalidity contentions in the NDCA Litigation, and it is asserting the same combinations of prior art, including each prior art reference asserted in the Petition: Carmel, Mattavelli, Wang, Wolters, Guo, Yu, and Forecast. (EX2012.)

Accordingly, factor four weighs in favor of exercising discretion to deny institution. *Fintiv*, IPR2020-00019, Paper 11 at 12 (“[I]f the petition includes the same or substantially the same claims, ground, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.”); *see also, e.g., Code200, UAB v. Luminate Networks, Ltd.*, IPR2020-01506, Paper 10 at 11-12 (PTAB Feb. 16, 2021) (“In light of the common prior art asserted here and in the [] district court case, as well as the common challenge to the sole independent claim and all but two of the dependent claims of the [’384] patent, we agree with the

Patent Owner that the overlap in issues between the two proceedings is substantial.”).

Moreover, Petitioner has not, to this point, offered a *Sotera* stipulation. *Inter Partes* Review is intended to be a “quick and cost effective alternative[] to litigation,” not an avenue for Petitioner to argue invalidity a second time in a second venue. *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1317 (Fed. Cir. 2018) (quoting H. Rep. No. 112-98, at 40, 48 (2011)). Indeed, Petitioner’s failure to offer a *Sotera* stipulation, despite the substantial overlap between the proceedings, only highlights the concerns of duplicative efforts and conflicting outcomes raised by *Fintiv*.

5. Factor 5 Weighs in Favor of Denial Because the Parties Are the Same in Each Proceeding.

The fifth *Fintiv* factor considers whether the petitioner and the defendant in the parallel proceeding are the same party. As set forth above, Petitioner is a defendant in the parallel district court proceeding. “[B]ecause the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Samsung Elecs. Co. v. Clear Imaging Research, LLC*, IPR2020-01401, Paper 12 at 21-22 (PTAB Feb. 17, 2021) (*quoting Fintiv*, IPR2020-00019, Paper 15 at 15).

6. Factor 6 Weighs in Favor of Denial Due to Other Circumstances Impacting the Exercise of Discretion.

The sixth factor addresses other circumstances that impact the Board's exercise of discretion. Here, these additional factors likewise weigh in favor of exercising discretion to deny institution. The district court can resolve more disputed issues than the limited nature of IPR proceedings, which can only address a limited set of validity challenges. IPR proceedings often only address some validity issues, leaving others for the district courts to deal with. As a result, when a patent survives an IPR, it adds complexity to the proceeding as the district court must then weigh questions of the scope of IPR estoppel. *See, e.g., EIS Inc. v. IntiHealth Ger GmbH*, 2023 WL 6797905, 19-1227-GBW (D. Del. Aug. 30, 2023) (addressing scope of IPR estoppel). Petitioner's enablement and written description issues identified in the NDCA Litigation (*see* EX2003, 14) are beyond the reach of IPRs and, as a result, an IPR proceeding will not make the validity determination more efficient in this instance.

Moreover, the merits of the Petition are weak. While Patent Owner will provide a more comprehensive analysis of the merits of the Petition in its Preliminary Response due July 17, 2025, *see* Paper 3, it is clear from even a cursory review of the Petition that it does not present "a compelling unpatentability challenge." *See Fintiv*, IPR2020-00019, Paper 11 at 13-14. Each of Petitioner's invalidity grounds are based on obviousness, a tacit admission by Petitioner that

none of the prior art discloses all the limitations of the challenged claims. *See* Paper 1 at 2. Further, the primary reference, Carmel, was already considered by the USPTO when the application leading to the '849 Patent was examined. *See, e.g.*, U.S. Pat. No. 10,771,849 at Page 2; *see also* EX1008, 526. The Petition also (a) improperly equates claimed “fluidity” with “continuity” to stretch the invalidity argument, (b) conflates the element of “autonomously adjusting” ***playback*** with the separately claimed elements of “selecting” and “autonomously adjusting” the ***selection***, and (c) even combines Carmel with Mattavelli which **reduces** the quality as opposed to **maintaining** the quality by using, *inter alia*, optimized decoding processes as required by the claim.

The Petition’s extensive reliance on expert testimony further demonstrates that the merits of Petitioner’s challenge are not strong. *See* Guidance at 2 (listing additional “relevant considerations” including “[t]he extent of the petition’s reliance on expert testimony”). Petitioner cites its expert’s 262-page declaration over 100 times in the Petition, often relying on large swaths of expert testimony to backfill and plug holes in its arguments. This is a clear sign that Petitioner’s merits-based arguments cannot stand on their own.

Even if the Petition presented a strong case on the merits (it does not), it would be outweighed by the other *Fintiv* factors that strongly favor denial. The Board has made clear that “the merits do not outweigh the other *Fintiv* factors.”

NXP USA, PGR2022-00005, Paper 18 at 12-13 (finding that where factor 1 was neutral and factors 2-5 favored or slightly favored denial, factor 6 was neutral because it “would not impact [the] ultimate determination”); *Samsung Elecs.*, IPR2020-01401, Paper 12 at 23-25 (finding that where factors 1 and 4 slightly favored denial, factors 2 and 3 strongly favored denial, and factor 5 weighed in favor of denial, those factors outweighed any merits of the case considered in factor 6); *Fintiv*, IPR2020-00019, Paper 11 at 15 (“if the merits of the grounds raised in the petition are a close[] call, then that fact has favored denying institution when other factors favoring denial are present”). Here, the Petition is exceptionally weak on the merits but, even if it were not, that fact would not outweigh *Fintiv* factors 2, 3, 4, and 5, which all strongly favor discretionary denial.

In addition to the weakness of the merits of the Petition, additional considerations also favor discretionary denial of this proceeding. For example, the “settled expectations of the parties” clearly favor denial. *See* Guidance at 3 (listing additional “relevant considerations” including “[s]ettled expectations of the parties, such as the length of time the claims have been in force”). The ’849 Patent issued almost 5 years ago on September 8, 2020 and its parent application was filed **20 years ago** on April 18, 2005. *See* Ex.1001 at cover.

Accordingly, on balance, the *Fintiv* factors strongly favor denial of institution of this IPR.

B. The Board Should Deny Institution Under 35 U.S.C. § 315(d)/325(d).

The Petition should also be discretionarily denied under 35 U.S.C. § 315(d)/325(d). Under § 325(d), “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” “Previously presented art includes art made of record by the Examiner, and art provided to the Office by an application, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Ivantis v. Sight*, IPR2022-01530, Paper 14 at 9 (PTAB, Mar. 27, 2023) (internal quotations omitted). This is the case here.

All five § 103 grounds of alleged invalidity are premised primarily on a single piece of prior art—Carmel—that was already considered when it examined the patent application that led to the ’849 Patent:

- Ground 1: *Carmel* in View of Mattavelli;
- Ground 2: *Carmel* in View of Wang;
- Ground 3: *Carmel* in View of Wang and Wolters;
- Ground 4: *Carmel* in View of Wang, Wolters, Guo, Yu, and Forecast;
- Ground 5: *Carmel* in View of Mattavelli, Guo, Yu, and Forecast.

Petition, Paper 2, p. 3.

The USPTO has already considered and issued the '849 Patent over Carmel, which Patent Owner submitted in its IDS and is listed on the face of the '849 Patent. U.S. Pat. No. 10,771,849 at Page 2; *see also* EX1008, 526. As a result, Carmel is not a sound basis to invalidate the '849 Patent and instituting these proceedings would not be an efficient use of the Board's resources. *See Ivantis v. Sight*, IPR2022-01530, Paper 14 at 14 (denying institution where “the Examiner considered many *similar* prior art references, including references containing the same figures that Petitioner asserts here, during the prosecution leading to the [challenged] patent.”) (emphasis added). Here, the primary reference is not just similar—it is identical.

III. Conclusion

In summary, the *Fintiv* factors and other relevant considerations strongly favor denial of the Petition under § 314(a). Most importantly, the NDCA Litigation (1) has not been stayed and will likely reach a determination of the validity of the '849 Patent before the Board in this IPR, (2) has advanced well beyond the early stages, (3) has resulted in significant expenditures of time and resources by the district court and the parties, and (4) will address issues that overlap significantly with those raised here. In addition, the Petition should be denied under § 325(d), as Petitioner's primary reference on all its grounds has already been considered by the

USPTO examiner. Accordingly, Patent Owner respectfully requests that the Director exercise her discretion under to deny institution of this proceeding.

Dated: April 25, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that this Request for Discretionary Denial complies with the type-volume limitations of 37 C.F.R. §42.24 because it contains 4235 words (as determined by the Microsoft Word word-processing system used to prepare the Petition), excluding the parts of the Petition exempted by 37 C.F.R. §42.24.

Dated: April 25, 2025

/s/ Roger Thompson
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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** and accompanying exhibits were served on the date below via email at the following email addresses:

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