

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BELDEN INC. and PPC BROADBAND, INC.
Petitioners,

v.

COMMSCOPE, INC. OF NORTH CAROLINA,
Patent Owner

Case No. IPR2025-00833
U.S. Patent No. 9,266,697

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

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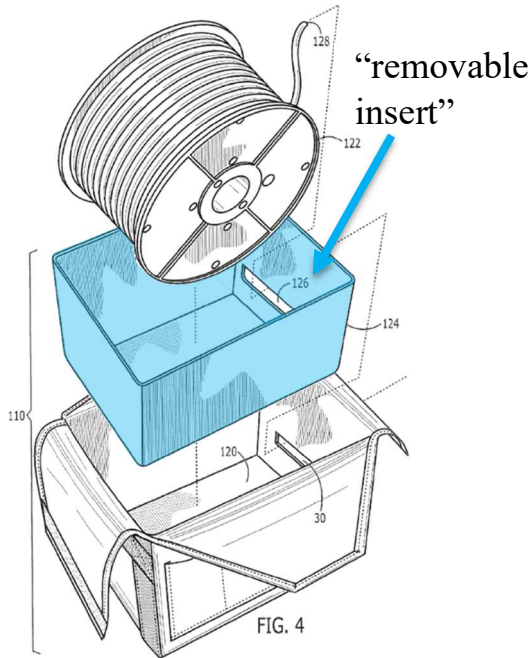
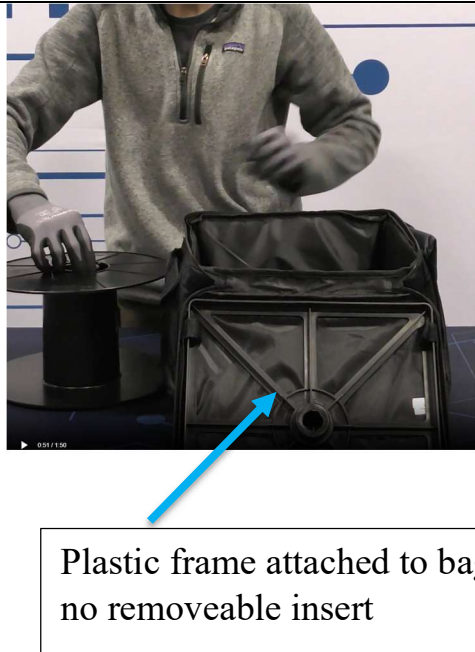
I. Introduction

Patent Owner raises multiple arguments that unnecessarily complicate the central issues in this IPR concerning a very simple alleged invention. Petitioner PPC—not Patent Owner—had settled expectations, as it had no reason to believe its decade-old product would be accused of infringement after being on the market for so long. Moreover, the prosecution history reveals a specific, material error; the Examiner failed to search for prior art based on the Board’s construction in the *ex parte* appeal decision reversing the Examiner, which should be corrected by the Office. Finally, even though Patent Owner withdrew its prior agreement to stay the litigation in view of this IPR, trial is not scheduled to occur until at least six months after a final written decision will be issued.

First, PPC began marketing the allegedly infringing product at least as early as September 25, 2014—more than one year before the ’697 patent issued. CommScope only recently asserted this patent, despite having no reasonable basis for infringement. Properly construed, the asserted independent claims are not close to covering the accused products.

For example, independent claim 10 recites “a removable insert within the interior of the main compartment.” Because “removable insert” does not specify sufficient structure, it should be interpreted as a means-plus-function term under Section 112, 6th paragraph. The relevant case law, such as *Williamson v. Citrix*

Online, LLC, 792 F.3d 1339, 1348-49 (Fed. Cir. 2015), clarifies that functional terms without adequate structural detail must be analyzed under this provision. The '697 patent discloses a specific insert design, which is absent from the accused products, confirming that there is no reasonable basis for infringement:

'697 Patent (annotated)	Accused PPC Product
 FIG. 4	 Plastic frame attached to bag – no removeable insert

In fact, the Board already determined that it was conventional for a cable payout container to have two frames on opposite ends in the container, and claims to a communication cable payout bag having a pair of plastic frames within the bag allegedly covering the accused product are not patentable. *See PPC Broadband, Inc.*

v. Times Fiber Commc'ns, Inc., IPR2022-00946, Paper 47 at 20-23, 109 (PTAB Dec. 6, 2023).¹

Second, the '697 patent issued as a direct consequence of a critical misstep rooted in how the Examiner construed a key claim element—a material error under the Board's 325(d) framework. In the *ex parte* appeal, the Board adopted a definition of “flexible material” different from the Examiner's interpretation, but the Examiner failed to search for prior art under the Board's construction after the appeal, resulting in missed and overlooked references. As detailed in the prosecution history (Ex. 1003), pages 27-29, this new construction meant that certain prior art—bags made of flexible material (e.g., *Redzisz*)—became highly relevant to patentability.

Rather than conducting a prior art search consistent with the Board's interpretation, the search history prior to allowance (Ex. 1003, pp. 19-20) reveals that only an interference search was performed.

EAST Search History (Prior Art)

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¹ See also *Times Fiber*, IPR2022-00946, Paper 2 at 5-9 (discussing prior art disclosing well-known, conventional cable payout containers with a pair of frames supporting a cable reel in the container).

Id. There was no targeted search for bags made of flexible material as interpreted by the Board. This incomplete approach caused the Examiner to miss and overlook references that were crucial for determining patentability.

Newly cited prior art—*Redzisz* (Ex. 1005)—directly addresses this oversight, demonstrating that such bags made of flexible material were already notoriously old and well known in the art. The Examiner failed to conduct a prior art search for bags made of flexible material as defined by the Board, resulting in an incomplete evaluation of patentability and an erroneous allowance of the claims. The Petition provides clear evidence that the prior art said to be missing was, in fact, available, but not considered due to the Examiner’s limited search.

This sequence of events underscores a specific, material error in the examination process—one that is both documented in the record and directly relevant to the issues now in this IPR. The new references fill the precise gap left by the Examiner’s failure to search, reinforcing the Petition’s position that institution is warranted on these grounds.

Finally, denial of institution under *Fintiv* is unwarranted because the projected final written decision in this proceeding precedes the district court trial date by six months. Ex. 2004, 12 (Scheduling Order). Upon the issuance of the final written decision, Petitioners would be bound by the statutory estoppel provision under 35

U.S.C. § 315(e)(2), thereby eliminating any risk of duplicative proceedings or inconsistent outcomes between the Board and the district court.

II. New Prior Art and Clear Examiner Error Support Referral Under § 325(d).

Advanced Bionics provides a two-part framework for evaluating whether denial under § 325(d) is warranted: (1) whether the same, or substantially the same, prior art or arguments were previously presented to the Office; and (2) if the first prong is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims. *See, e.g., Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7-8 (PTAB Feb. 13, 2020). When applying this framework, the Board considers six factors outlined in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17-18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton, Dickinson*”).

Here, the Director should not exercise her discretion under 35 U.S.C. § 325(d) to deny institution because the *Becton, Dickinson* factors favor institution. The Petition presents new prior art, new claim construction, and arguments not previously presented to the Office.

A. The Petition Presents New Prior Art and Arguments That Were Not Previously Presented to the Office (Factors (a), (b), and (d)).

Every ground in the Petition relies on new prior art references—*Redzisz* (Ex. 1005), *Bass* (Ex. 1009), and *Barnett* (Ex. 1008)—to show precisely what the Office said was missing in the prior art was in fact old and well known in the art.

1. [Grounds 1-2] The Petition Relies on New Prior Art, *Redzisz*, Regarding the “*a main compartment constructed of a flexible material*” Limitations Not Disclosed in the Examiner’s Art and Presents a New Prior Art Combination Not Presented to the Office.

Regarding Grounds 1 and 2, Patent Owner never disputes that *Redzisz* was not presented to the Office during prosecution, and the combination of *Cohn* and *Redzisz* was not before the Office. PO Req. 11-14. Nevertheless, Patent Owner argues that: 1) *Cohn* is cumulative of *Cote*; 2) *Redzisz* does not disclose the claimed “*main compartment constructed of a flexible material*,” and 3) the combination of *Cohn* and *Redzisz* is no different than the art and arguments that were already before the Office. *Id.* None of these assertions is true.

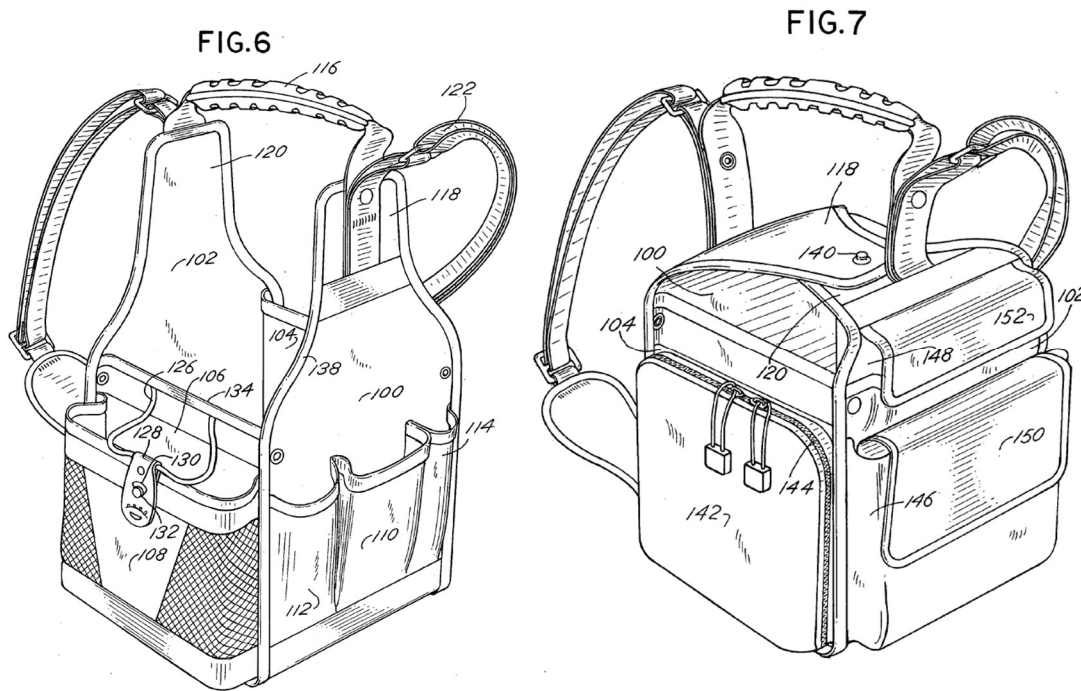
a. *Cohn* Is Not Cumulative of *Cote*.

Patent Owner suggests that *Cohn* is cumulative to *Cote* because “*Cohn* and *Cote* each disclose similar rigid boxes containing a cable reel.” PO Req. 11-14. This assertion is baseless. Although both *Cohn* and *Cote* disclose rigid boxes containing cable reels, the Petition presents *Cohn* in a materially different way than how *Cote* was considered during prosecution. Specifically, the Petition demonstrates that

Cohn’s box, **when inserted in *Redzisz*’s bag**, satisfies the claimed “removable insert.” *See* Pet. 24-27. In contrast, the Examiner never viewed *Cote*’s box as the claimed “removable insert.” Instead, the Examiner mapped *Cote*’s box to a distinct component in the claims—the claimed “main compartment ... constructed of a flexible material”—and mapped only the box’s interior support to the “removable insert within the interior of the main compartment.” Ex. 1003, 28-31. During the *ex parte* appeal, the Board found that the Examiner erred in concluding that *Cote*’s box is made of a flexible material, noting that the reliance on cardboard as the claimed “flexible material” was unreasonable. *See id.*, 27-29. Thus, the Petition presents *Cohn* in a new light—the combination of *Cohn* and *Redzisz* was never considered by the Office.

b. *Redzisz* Discloses the Claimed “main compartment constructed of a flexible material” Limitations.

Redzisz discloses a bag made from a flexible material, such as canvas, as shown below. *Redzisz* (Ex. 1005), [0003], [0005], [0028], [0037]-[0038], FIGS. 6-9; Pet. 23-24.



Redzisz, FIGS. 6-7.

Patent Owner's argument that *Redzisz* fails to disclose a bag constructed of a "flexible material" contradicts *Redzisz*'s express disclosure. *Redzisz* repeatedly describes the bag as constructed from flexible fabric materials, such as canvas. For example:

- "The rigid or semi-rigid end and bottom panels are covered on both sides with a **fabric or flexible material**, ..." *Redzisz*, [0005].
- "The front panel 28 and the back panel 30 are each **comprised of flexible material such as canvas**, plastic or the like. **The fabric utilized to make the case is thus typically a canvas material, a fabric material** or flexible plastic material and is substantially the same fabric material for all panels 28, 30 and material covering 20, 22." *Redzisz*, [0028].

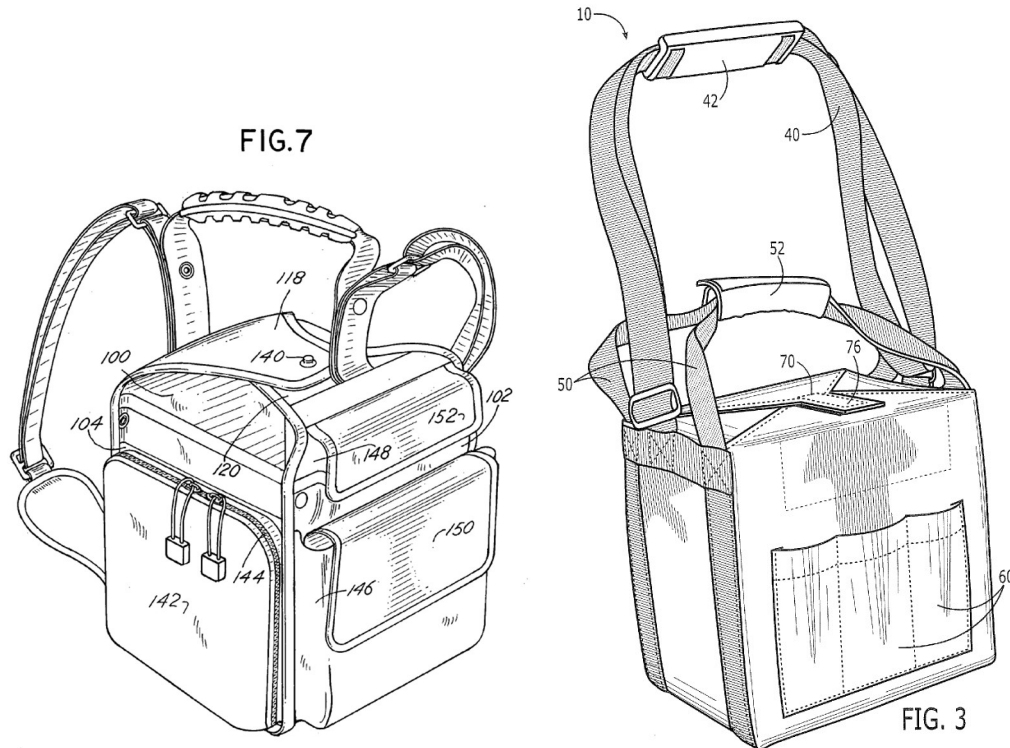
- “[T]he end panels are fabricated and configured from **a material which enables those end panels to be folded one over the other** and fastened together to thereby facilitate retention.” *Redzisz*, [0035].
- “The bag or case of FIGS. 6-9 has a feature, perhaps illustrated more clearly in FIG. 7, wherein **the upper end 118 of end panel 100 may be folded over** and joined with **the upper end 120 of panel 102 which is also folded over.**” *Redzisz*, [0038].
- “As depicted, for example, in FIG. 8, the first end panel 100 includes a semi-rigid or rigid polyethylene board 101 **encapsulated between layers of fabric.**” *Redzisz*, [0039].
- “It has been found that the elimination of a reinforcing board in the upper ends 118 and 120 is possible assuming that **the fabric material** forming the covering of the boards or reinforcing elements 101 and its companion element 10A in FIG. 9 **are adequately heavy, for example, a heavy canvas or plastic fabric material.**” *Redzisz*, [0041].

Patent Owner argues that “Redzisz clearly and repeatedly discloses a tool carrying ‘case’ constructed of integral ‘*generally rigid*’ panels and reinforcing bars.” PO Req. 12-13. This is wrong. First, *Redzisz* expressly and repeatedly refers to the container as a “bag or case.” *Redzisz*, [0037] (“bag or case”), [0038] (“bag or case”), [0042] (“box, bag or case,” “tool bag,” “the bag”), [0043] (“the bag”). Although *Redzisz*’s bag can include reinforcing panels, the panels are covered by or

encapsulated within “flexible material, such as canvas, plastic or the like” or “fabric material.” *Redzisz*, [0028], [0030], [0040]-[0041]. Thus, even if *Redzisz*’s reinforcing elements are not made of a “flexible material,” *Redzisz* still discloses a bag with “a *main compartment constructed of a flexible material*” consistent with the claim language. *See* Pet. 23-24.

To the extent that Patent Owner argues that the claimed “*main compartment constructed of a flexible material*” should be construed to mean *exclusively* made of a “flexible material,” such a narrow interpretation is unsupported. Nothing in the specification of the ’697 patent or in the claim language limits the “main compartment” to be *exclusively* made of a flexible material. Notably, Patent Owner did not advance this narrow interpretation in the parallel district court litigation. Ex. 1022 (Joint Claim Construction Chart).

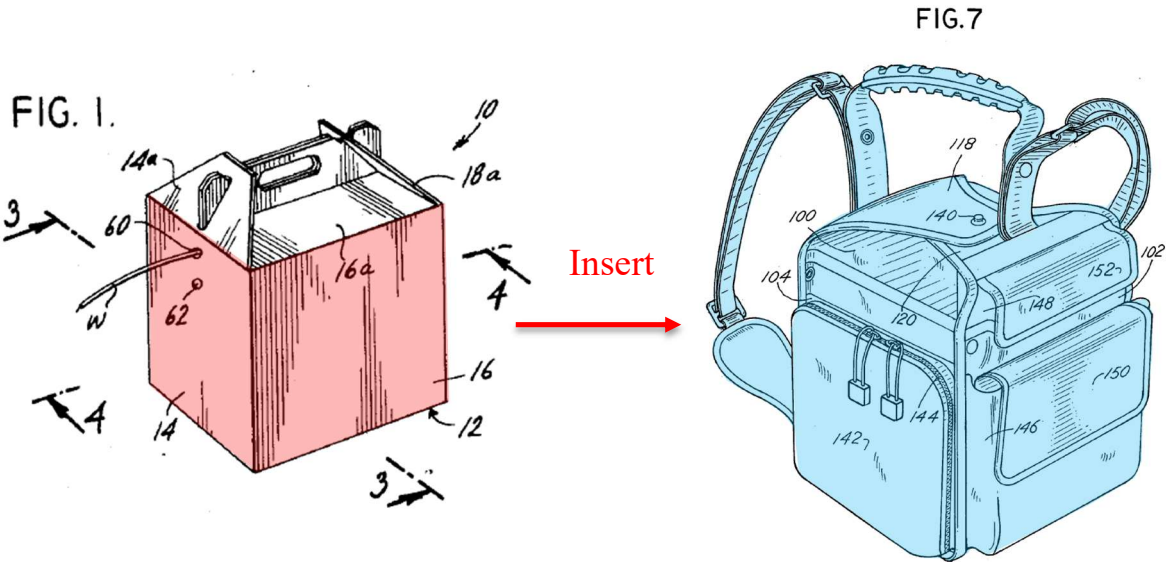
Indeed, *Redzisz*’s bag is similar to the bag of the ’697 patent, both having a substantially rectangular main compartment made of a flexible material (e.g., canvas), a pair of flaps fastened together, a handle strap, a shoulder strap, and at least one storage pouch on the exterior of the main compartment. *Redzisz*, [0028], [0033], [0035], [0038], [0041], FIGS. 6-9; Ex. 1001, 2:44-50, 3:28-4:7, 5:49-52, FIG. 3; Pet. 16-17, 23-24, 29-30, 32-37.



Compare Redzisz, FIG. 7 with Ex. 1001, FIG. 3.

c. The Combination of Cohn and Redzisz Was Not Presented to the Office.

The Petition establishes that a person of ordinary skill in the art at the time of the alleged invention (“POSITA”) would have found it obvious to use *Redzisz*’s bag to carry *Cohn*’s cable payout device, as shown below, to “allow free use of both hands, provide more mobility and flexibility, and reduce risk of injury for cable installers in the field.” Pet. 18-22.



Cohn, FIG. 1 (annotated)

Redzisz, FIG. 7 (annotated)

Such a prior art combination that allows for carrying a cardboard box in a bag was not previously presented to the Office. Indeed, the Examiner’s rejections based on *Cote* or *Young* mapped a support structure in the box to the claimed “removable insert” and separately mapped the box or bag to the claimed “main compartment.” The Petition introduces a new combination—using *Redzisz*’s bag to carry *Cohn*’s cable box—that was not considered by the Office.

Moreover, the Petition presents a new means-plus-function construction of the claimed “removable plastic insert” (claim 9) and “removable insert” (claim 10), relying on *Williamson*, 792 F.3d at 1348-49. The *Williamson* opinion was issued in June 2015, during the pendency of Applicant’s *ex parte* appeal of the Examiner’s Final Rejection issued in June 2012. Ex. 1003, 94. Although *Williamson* issued

during the pendency of the *ex parte* appeal, neither the Examiner, nor the Board, applied *Williamson* to the claims. About three months after the *Williamson* opinion, the Board issued the Decision on Appeal. Ex. 1003, 23-35. And about three months after the Decision on Appeal, the Examiner cancelled the claims rejected on grounds affirmed by the Board and allowed those claims rejected on grounds reversed by the Board. Ex. 1003, 7-13.

The Petition establishes that the terms “removable plastic insert” and “removable insert” should be properly construed as means-plus-function terms under the Federal Circuit’s guidance in *Williamson*. Pet. 9-13. The Petition further establishes that the combination of *Cohn* and *Redzisz* renders obvious the claimed “removable plastic insert” and “removable insert” under the proposed means-plus-function constructions. No prior art reference was previously considered under this construction. For at least this additional reason, the combination of *Cohn* and *Redzisz* is non-cumulative and warrants institution.

2. [Grounds 3-8] The Petition Relies on New Prior Art *Bass* or *Barnett* for “removable insert” and Presents New Prior Art Combinations Not Presented to the Office.

Regarding Grounds 3-8, Patent Owner does not dispute that *Bass* (Grounds 3-5) and *Barnett* (Grounds 6-8) were never presented to the Office during prosecution, nor was the combination of *Young* with *Bass* or with *Barnett* before the Office. PO Req. 14-15. Nevertheless, Patent Owner asserts that: 1) each of *Bass* and

Barnett is cumulative of *Cote*; 2) each of *Bass* and *Barnett* is cumulative of *Eastwood*; and 3) the combination of *Young* and *Bass* or *Young* and *Barnett* is cumulative of *Young* and *Eastwood* considered by the Office. *Id.* None of these assertions are correct.

a. Neither *Bass*, Nor *Barnett* Is Cumulative of *Cote*.

Patent Owner suggests that *Bass* and *Barnett* are cumulative of *Cote* because “*Cote*, like *Bass* and *Barnett*, discloses a cable reel in a relatively stiff box, with a similarly-configured cable payout.” PO Req. 14. Patent Owner again ignores Petitioners’ prior art combination. The Petition relies on *Bass* and *Barnett* for teaching the claimed “removable insert,” not for the claimed “main compartment,” to which the Examiner mapped *Cote*’s box during prosecution. Pet. 46-50, 54-56, 68-74; Ex. 1003, 28-31. The Petition shows how *Bass* and *Barnett* each are applied in combination with *Young*, presenting new, non-cumulative grounds.

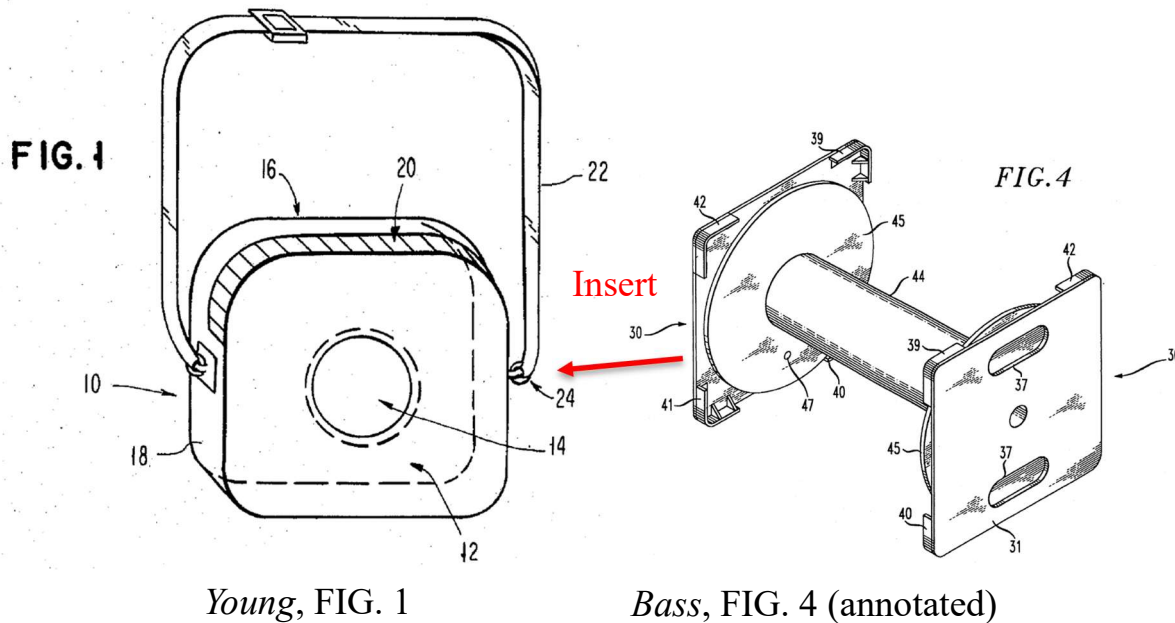
b. Neither *Bass*, Nor *Barnett* Is Cumulative of *Eastwood*.

Patent Owner suggests that *Bass* and *Barnett* are cumulative of *Eastwood* previously considered by the Office because “each similarly discloses generally rigid cable reel boxes/cases, with similarly-configured cable payout.” PO Req. 14-15. This is a false red herring. Petitioner relies on *Bass* and *Barnett* in a significantly different way than how *Eastwood* was considered during prosecution. The Petition relies on *Bass* and *Barnett* for teaching the claimed “removable insert,” not for the

claimed “cable lock,” for which Petitioner relies on *Eastwood*, as previously found by the Examiner and affirmed by the Board. Pet. 46-50, 54-56, 68-74, 86-91; Ex. 1003, 28-34, 43-44, 56-57, 78, 103-104; *id.*, 34-35 (“We agree with the Examiner’s view ... we agree with the Examiner’s conclusion that *Eastwood* teaches or suggests the disputed limitation.”). As such, neither *Bass* nor *Barnett* is cumulative of *Eastwood*.

c. The Combination of *Young* and *Bass* Was Never Presented to the Office.

The Petition establishes that a POSITA would have found it obvious to use *Bass*’s reel and end plates in *Young*’s cable payout bag to facilitate cable payout and prevent cable damage, as shown below. Pet. 46-50. When carried in *Young*’s cable payout bag, *Bass*’s end plates constitute the claimed “removable insert.” Pet. 46-50, 54-56. This combination of *Young* and *Bass* was never presented to the Office and is not cumulative of any of the *Young*-based combinations considered by the Examiner.



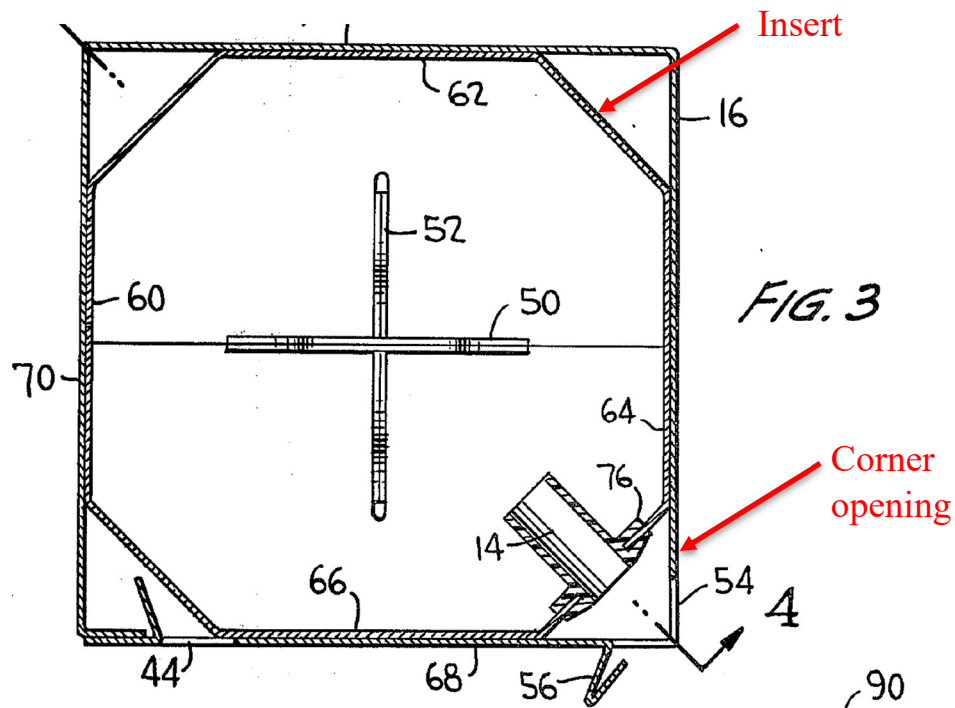
During prosecution, the Examiner rejected the pending claims as unpatentable over *Young* and *Eastwood* (Ex. 1003, 146), *Young* and *Godshaw* (Ex. 1003, 140-142), and *Young, Kotzur* (Ex. 1024), and *Godshaw* (Ex. 1003, 142-145). The Petition's grounds are not cumulative of any of these grounds.

First, as discussed above, *Bass* is not cumulative of *Eastwood*. The Examiner relied on *Eastwood* for disclosing the claimed “cable lock,” not for the claimed “removable insert,” for which the Petition relies on *Bass*. Ex. 1003, 33, 43-44, 56-57, 78, 103-104; Pet. 46-50, 54-56.

Second, *Bass* is not cumulative of *Godshaw*. The Examiner relied on *Godshaw* for disclosing “a pair of handle straps” and “at least one storage pouch on the exterior of the bag.” Ex. 1003, 140; *see also id.*, 141 (“It would have been obvious to one of

ordinary skill in the art at the time of the invention to add a pair of handle straps to the bag of Young to make the bag more versatile allowing the user to carry over their shoulder or with the hands as taught by *Godshaw*."); *id.*, 142 ("It would have been obvious to one of ordinary skill in the art at the time of the invention to add the storage pockets of Godshaw to the bag of Young to provide storage for the handle straps when not in use as taught by Godshaw."). The Examiner did not rely on *Godshaw* for disclosing the claimed "removable insert."

Third, although the Examiner relied on *Kotzur* for disclosing the claimed "removable insert" (Ex. 1003, 142-145), *Kotzur*'s insert is not feasible with *Young*'s bag. As shown below, *Kotzur*'s insert is designed to have a tube insert 14 that is aligned with an opening 54 at a corner of the container for wire payout. Ex. 1024, 2:4-11, 3:13-17, 3:26-28, FIGS. 1-3. *Kotzur*'s insert, when placed in *Young*'s bag, would not allow the wire to be paid out from the exit opening of *Young*'s bag. The Examiner did not explain how a person of ordinary skill in the art would have had reasonable expectations of success in using *Kotzur*'s insert in *Young*'s bag. Ex. 1003, 142-143. The Petition's combination of *Young* and *Bass* remedies this deficiency of the Examiner's *Young-Kotzur* combination by providing a compatible insert structure in *Young*'s bag. Pet. 47-50, 54-56.



Kotzur, FIG. 3 (annotated).

The Petition explains that a person of ordinary skill in the art would have been motivated and expected success in using *Bass*'s reel and end plates in *Young*'s bag for smooth cable payout. Pet. 46-50. For example, the Petition explains that a cable installation technician would have used basic practical skills to place *Bass*'s reel and end plates in *Young*'s bag, allowing cable to exit from *Young*'s exit opening. Pet. 49-50; *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). The Petition establishes that this would have been an application of a known technique to improve a known device in the same way taught and yield predictable results—an improved cable payout apparatus. Pet. 50; *KSR*, 550 U.S. at 417.

Patent Owner argues that *Young* only discloses paying out cable “from the center of the coil,” and the challenged claims are distinguishable from *Young* by reciting the limitation of “*cable payout passageway is configured to receive therethrough the loose end of cable from the outer portion of the reel of communications cable.*” PO Req. 18. Although *Young* alone may not disclose this limitation, Petitioners’ *Young*-based combinations do. *See* Pet. 49-50, 71. Unlike the Examiner’s *Young-Kotzur* combination where *Kotzur*’s insert would only allow cable payout from the corner, Petitioners’ combination of *Young* and *Bass* allows cable to be paid out from *Young*’s central exit opening. Pet. 49 (discussing one of the suitable ways to place *Bass*’s end plates in *Young*’s bag: “a POSITA would have placed *Bass*’s end plates against the two sides of *Young*’s bag ... the loose end of the cable of *Bass*’s reel would pay out from the outer portion of the reel through *Young*’s exit opening.”).

Further, Petitioner’s combination of *Young* and *Bass* was not and could not have been presented to the Office because it applies Patent Owner’s apparent construction raised in the parallel district court litigation. There, Patent Owner contended that two separate square-shaped frames supporting the reel—like *Bass*’s end plates—constitute the claimed “removeable insert.” Ex. 1025 (Plaintiff’s Infringement Contention), 15-18. The Petition shows that *Bass*’s end plates used in *Young*’s bag disclose the claimed “removal insert” under Patent Owner’s apparent

construction in the parallel district court proceeding. Pet. 13-14, 54-56. In contrast, none of the Examiner's combinations, e.g., using *Kotzur*'s insert in *Young*'s bag, would satisfy Patent Owner's apparent construction. As such, Petitioners' combination of *Young* and *Bass* is new and non-cumulative.

d. The Combination of *Young* and *Barnett* Was Never Presented to the Office.

Neither was the combination of *Young* and *Barnett* presented to the Office. As discussed above, the Petition relies on *Barnett* for disclosing the claimed "removable insert" (Pet. 70-74), unlike the Examiner's reliance on *Eastwood* for the claimed "cable lock" (Ex. 1003, 146), and unlike the Examiner's reliance on *Godshaw* for the claimed "handle straps" and "storage pouch" (Ex. 1003, 140-142). And like the Petition's combination of *Young* and *Bass*, the Petition's *Young* and *Barnett* combination also allows cable payout from *Young*'s exit opening, addressing the deficiencies of the Examiner's *Young-Kotzur* combination. Pet. 70-71 (discussing one of the suitable ways to place *Barnett*'s insert in *Young*'s bag: "a POSITA would have known ... [to place] the end walls of *Barnett*'s insert against the two sides of *Young*'s bag.")).

The Petition explains how a POSITA would have been motivated and expected success in using *Barnett*'s reel and insert supporting the reel in *Young*'s bag to facilitate cable payout and prevent cable damage. Pet. 70-71. For example, the

Petition explains that a cable installation technician would have used basic practical skills to place *Barnett*'s reel and insert in *Young*'s bag to facilitate cable payout. Pet. 71. The Petition also establishes that using *Barnett*'s reel and insert in *Young*'s bag to facilitate cable payout would have been an application of a known technique to improve a known device in the same way taught and yield predictable results—an improved cable payout apparatus. Pet. 71-74; *KSR*, 550 U.S. at 417.

B. The Office Erred in a Manner Material to the Patentability of the Challenged Claims (Factors (c), (e), and (f)).

Because the Petition presents new prior art, grounds, and arguments not yet presented to the Office, *Advanced Bionics* step 2 is moot, and the Director need not consider whether the Office materially erred. But even if the Director does reach the second step of *Advanced Bionics*, discretionary denial under § 325(d) would still be unwarranted because the record establishes that the Office made material errors during prosecution of the '697 patent.

Here, the Examiner erred in a manner material to the patentability of the '697 patent by: 1) failing to reject the Challenged Claims based on an obviousness combination affirmed by the Board in the *ex parte* appeal; 2) overlooking *Redzisz* and the new, non-cumulative combination of *Cohn* and *Redzisz*; and 3) overlooking *Bass* or *Barnett* in combination with *Young* that addresses the deficiencies in the Examiner's *Young* combination. *Ecto World, LLC, et al. v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 5 (Director May 19, 2025) (precedential)

(“[A] petitioner may argue that it satisfies the second part of *Advanced Bionics* because the asserted prior art was not a basis for rejection during examination, is not substantially the same as prior art the Examiner applied, and includes specific teachings that impact patentability of the challenged claims.”).

1. The Examiner Made a Material Error by Overlooking *Redzisz* and the *Cohn* and *Redzisz* Combination.

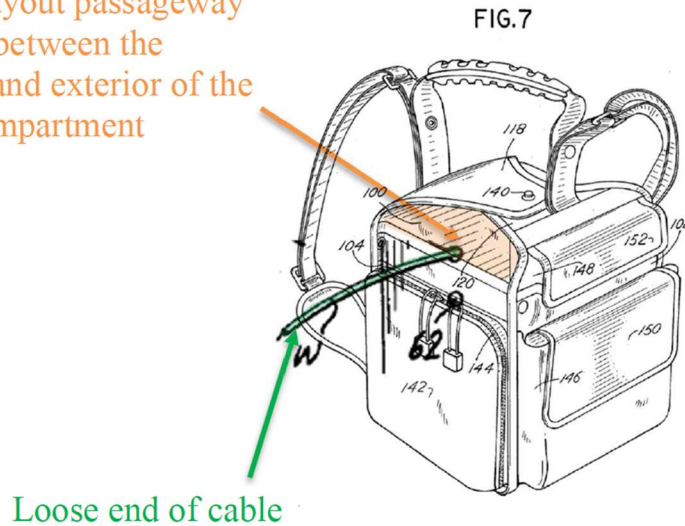
As discussed above, *Redzisz* and the combination of *Cohn* and *Redzisz* were not presented to the Office during prosecution. *See supra* Section II.A.1. Because this IPR prior art was “not before the examiner, the examiner could not have considered the combination ... during prosecution.” *Hamilton Techs. LLC v. Fleur Tehrani*, IPR2020-01199, Paper 6 at 21 (PTAB Jan. 6, 2021). The Petition demonstrates that the Examiner materially erred by failing to identify *Redzisz* and overlooking the combination of *Cohn* and *Redzisz*. *Id.* (finding “that the examiner materially erred in allowing the claims ... because the examiner did not have the benefit of the teachings of” the IPR prior art); *Advanced Bionics*, IPR2019-01469, Paper 6 at 8-9.

In the Decision on Appeal, the Board noted that the interpretation of the claim limitation “flexible material” was an issue central to the dispute in the Appeal and found that the Examiner unreasonably viewed *Cote*’s cardboard box as made of a “flexible material.” *See* Ex. 2003, 27-29. In response to the Decision on Appeal,

rather than conducting a targeted prior art search for bags made of a “flexible material” consistent with the Board’s interpretation (Ex. 1003, 19-20), the Examiner allowed the claims rejected on grounds based on the wrong construction. Ex. 1003, 7-13. This incomplete examination caused the Examiner to miss and overlook references that disclose bags made of flexible material (e.g., *Redzisz*’s bag)—crucial for determining patentability.

The Petition shows that a person of ordinary skill in the art would have found it obvious to use *Redzisz*’s bag to carry *Cohn*’s cable payout device to “allow free use of both hands, provide more mobility and flexibility, and reduce risk of injury for cable installers in the field.” *See* Pet. 18-22; *see supra* Section II.A.1.c. The Petition shows how using *Cohn*’s device in *Redzisz*’s bag discloses the claimed “main compartment constructed of a flexible material” and “removable insert.” *See* Pet. 22-27. The Petition also shows how using *Cohn*’s device in *Redzisz*’s bag discloses the allegedly allowable limitation requiring a “cable payout passageway ... configured to receive therethrough the loose end of cable from the outer portion of the reel of communications cable,” as shown below. *See* Pet. 30-32.

Cable payout passageway
defined between the
interior and exterior of the
main compartment



Cohn, FIG. 1 (excerpted, annotated); *Redzisz*, FIG. 7 (modified, annotated). The Petition thus establishes how the Examiner committed a material error by failing to conduct a search for the crucial limitation “flexible material” and identify *Redzisz* and by overlooking a combination of *Cohn* and *Redzisz* that impact the patentability of the challenged claims.

2. The Examiner Made a Material Error by Overlooking *Bass/Barnett* and the *Young* and *Bass/Barnett* Combinations.

As explained above, neither *Bass*, nor *Barnett*, is cumulative of prior art considered during prosecution, such as *Cote*, *Godshaw*, *Eastwood*. See *supra* Section II.A.2. And as discussed above, the combinations of *Young* and *Bass* and *Young* and *Barnett* are not cumulative to any of the *Young*-based combinations the Examiner previously considered. The Examiner materially erred by failing to identify the relevant teachings of *Bass* or *Barnett*, and by overlooking an

obviousness rejection to the Challenged Claims based on the combination of *Young* and *Bass* or *Young* and *Barnett*. Indeed, as discussed above, the Examiner acknowledged that “Young discloses a communications cable payout bag, comprising a main compartment ... constructed of a flexible material.” (Ex. 1003, 140). The Examiner did not have *Bass* or *Barnett* presented to him, and did not have the benefit of the Petition’s showing that a person of ordinary skill in the art would have found it obvious to use *Bass*’s reel and end plates—or *Barnett*’s reel and insert—as the claimed “removable insert” in *Young*’s bag to facilitate cable payout and prevent cable damage. *See* Pet. 46-50; *see also id.*, 70-71. And both of the Petitions’ *Young*-based combinations disclose the limitation reciting “cable payout passageway ... configured to receive therethrough the loose end of cable from the outer portion of the reel of communications cable,” Pet. 59-61, 76-77, which addresses the alleged deficiency in *Young*. *See supra* Section II.A.2; PO Req. 18-19. The Petition therefore shows that the Examiner committed a material error by failing to identify *Bass* or *Barnett* and overlooking the combinations of *Young* and *Bass* and *Young* and *Barnett* that impact the patentability of the Challenged Claims.

3. Additional Evidence and Facts Call for Referral.

As instructed by the Director, “even if a petitioner fails to make a persuasive argument that the Examiner erred by overlooking particular teachings in the prior art provided on an IDS, a petitioner may be able to demonstrate that discretionary denial

is inappropriate under *Becton Dickinson* factor (f).” *Ecto World*, IPR2024-01280, Paper 13 at 6. “That factor considers the extent to which additional evidence and facts warrant reconsideration of the prior art or arguments.” *Id.*

Here, additional evidence and facts call for institution.

As discussed above, Applicant’s *ex parte* appeal of the Examiner’s June 2012 Final Rejection lasted for over three years until the Decision on the Appeal issued in September 2015. Ex. 1003, 23-35. During the pendency of the Appeal, the Federal Circuit issued the *Williamson* opinion in June 2015. Ex. 1003, 94. Although *Williamson* issued during the appeal, the Examiner did not reconsider or discuss any claim term under the *Williamson* opinion in view of the prior art before allowing claims. *See* Ex. 1003, 7-13.

The Petition explains how the terms “removable plastic insert” and “removable insert” should be properly construed as means-plus-function terms under the Federal Circuit’s guidance in *Williamson*. Pet. 9-13. The Petition explains how the function of the “removable [plastic] insert” is “being able to support a cable reel, while also being able to be removed from the main compartment.” *See* Pet. 10; Ex. 1002, ¶¶ 34-35; Ex. 1001, 2:3-6, 4:56-65, FIG. 4. The corresponding structure as disclosed in the specification is “a [plastic] structure that includes a box made of solid formed plastic or corrugated plastic with an open top, or equivalents thereof.” *See* Pet. 10-13; Ex. 1002, ¶¶ 34-35; Ex. 1001, 4:56-5:18, FIG. 4. The Petition further

establishes that the combination of *Cohn* and *Redzisz* renders obvious the claimed “removable plastic insert” and “removable insert” under these proposed means-plus-function constructions. Pet. 18-22, 24-27.

Thus, the Examiner materially erred by failing to reconsider the claims and the prior art after the appeal in light of *Williamson*.

Moreover, the Examiner was not presented with Patent Owner’s apparent construction of the claimed “removable [plastic] insert,” which includes two separate square-shaped frames supporting a cable reel—like *Bass*’s end plates. Ex. 1025 (Plaintiff’s Infringement Contention), 15-18. The ’697 patent does not disclose such a structure. Had the Examiner had the information now presented by the parties for the first time in this proceeding, the Examiner would have conducted a broader prior art search covering such frames and identify *Bass*, and the Challenged Claims would not have been allowed over the combination of *Young* and *Bass* as shown in the Petition. See Pet. 46-50, 70-71.

C. Evidence of Material Error Favors Referral.

Discretionary denial is not warranted, even if other considerations may support discretionary denial, because it is an appropriate use of Office resources to review the evidence of material errors during prosecution as shown in the Petition. See *Microsoft Corp. v. Partec Cluster Competence Center GmbH*, IPR2025-00318, Paper 9 at 3 (Director June 12, 2025) (“discretionary denial of institution is not

warranted because of Petitioner’s showing of material error during patent examination” and “it is an appropriate use of Office resources to review the potential error”).

Even if the Director were to find that discretionary denial is permissible under either of Patent Owner’s other arguments discussed below—settled expectations and *Fintiv*—it would not be appropriate to exercise discretion here. As the Director emphasized, “the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented.” *Microsoft*, IPR2025-00318, Paper 9 at 3 (determining not to exercise discretion because Petitioner showed material error); *see also Anthony, Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 12 at 2 (July 16, 2025) (determining not to exercise discretion because even if the challenged patents have been in force for approximately 17 and 18 years, Petitioner persuasively explains that the examiner materially erred by overlooking prior art teachings); *Eunsung Glob. Corp. v. HydraFacial LLC*, IPR2025-00445, Paper 14 at 3 (Director July 10, 2025) (determining not to exercise discretion because “the patent examiner overlooked certain teachings in [the prior art] that appear to disclose the allowable features of the claims”); *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11 at 1 (Director June 12, 2025) (determining not to exercise discretion because the examiner overlooked the teachings of a reference not previously considered by the Office); *Embodiment, Inc. v.*

LifeNet Health, IPR2025-00248, Paper 12 at 2 (Director June 26, 2025) (determining not to exercise discretion because Petitioner shows that new references not previously considered by the Office disclose limitations Patent Owner argued that the prior art failed to disclose during prosecution).

III. Additional Factors Set Forth in the Workload Memorandum Support Referral.

The March 26, 2025 Memorandum (“Workload Memo”) states that “parties are permitted to address all relevant considerations” and then identifies several example considerations. Patent Owner identifies two—settled expectations and prior Office expenditures. *See* PO Req. 2-8. But neither supports discretionary denial, nor do any of the other factors identified in the Workload Memo. To the contrary, these factors favor referral for consideration on the merits.

A. The Parties’ Settled Expectations Support Referral.

There is no bright-line rule for when expectations become settled. *See Dabico Airport Sols. Inc. v. AXA Powers ApS*, IPR2025-00408, Paper 21 at 3 (Director June 18, 2025). Although “the ’697 patent has been in force for over 9 years,” PO Req. 2, 4, Patent Owner does not enjoy any settled expectations as to the validity of the broad and unsupported scope it now asserts in the parallel district court litigation.

At the district court, Patent Owner contends that two separate square-shaped frames supporting a cable reel constitute the claimed “removeable [plastic] insert,” Ex. 1025 (Plaintiff’s Infringement Contention), 15-18, and that the Challenged

Claims encompass a communication cable payout bag containing such pair of frames. But Patent Owner should not have any settled expectations as to the validity of such board interpretation of the claims. As discussed above, the claimed “removeable [plastic] insert” should be construed as a means-plus-function term, and the only corresponding structure as disclosed in the specification is a [plastic] structure that includes a box with an open top. *See supra* Sections II.A.1.c, II.C. Nowhere does the ’697 patent disclose or suggest that the “removable [plastic] insert” can include two separate components. *Intel Corp. v. Proxense, LLC*, IPR2025-00327, Paper 12 at 2 (Director June 26, 2025) (noting one of the “persuasive reasons why the Board should review challenged claims several years after their issuance date” is that “a significant change in law may have occurred since the patent issued, and a petitioner can explain how that change in law directly bears on the patentability of the challenged claims”).

By asserting the ’697 patent broadly against Petitioner’s communication bag, Patent Owner seeks to monopolize all means of using a bag to carry a supported cable reel, beyond the disclosure and claim scope permitted by law. *See O’Reilly v. Morse*, 56 U.S. 62, 120 (1853) (holding that Morse’s claim on *all* means of achieving telegraphic communication is invalid because the specification did not describe how to make and use them all); *see also Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1305 (Fed. Cir. 2011) (holding that instead of “allow[ing] the

claim language to become divorced from what the specification conveys is the invention,” “a construction of ‘body’ that limits the term to a one-piece body is required to tether the claims to what the specifications indicate the inventor actually invented”).

In fact, Patent Owner attempts to capture the conventional technology for cable reel payout containers that predates the ’697 patent. Patent Owner acknowledges that it is aware of *PPC Broadband, Inc. v. Times Fiber Commc’ns, Inc.*, IPR2022-00831, Paper 2 (PTAB Apr. 21, 2022). PO Req. 4. Indeed, Petitioner PPC filed six related IPRs challenging claims directed to cable communication bags containing a pair of frames that support a cable reel in the bag. *See also PPC Broadband, Inc. v. Times Fiber Commc’ns, Inc.*, IPR2022-00830, -00947, -00946, -01087, -01088. Except for two of those six proceedings in which all challenged claims were disclaimed, the Board found all challenged claims unpatentable, as shown below:

IPR Case No.	Outcome
IPR2022-00830	Paper 10 at 5 (PTAB Oct. 24, 2022) (IPR not instituted because all the claims challenged by Petitioner have been disclaimed)
IPR2022-00831	Paper 9 at 3 (PTAB Oct. 24, 2022) (IPR not instituted because all the claims challenged by Petitioner have been disclaimed)

IPR2022-00946	Paper 46 at 109 (PTAB Dec. 20, 2023) (finding all challenged claims unpatentable)
IPR2022-00947	Paper 47 at 112 (PTAB Dec. 20, 2023) (finding all challenged claims unpatentable)
IPR2022-01087	Paper 46 at 117 (PTAB Dec. 18, 2023) (finding all challenged claims unpatentable)
IPR2022-01088	Paper 43 at 107 (PTAB Jan. 2, 2024) (finding all challenged claims unpatentable)

In those IPRs, Petitioner provided a technical overview of telecommunication cable reel payout containers and showed that using a pair of frames to support a cable reel in a container, such as a cardboard box, was well known and conventional in the art. *See, e.g., Times Fiber*, IPR2022-01088, Paper 2 at 4-8 (discussing *Johanson* (Ex. 1026), *Wilkinson* (Ex. 1027), and *Galgano* (Ex. 1028)); *Times Fiber*, IPR2022-00946, Paper 46 at 20 (Board acknowledging that it was conventional for a cable payout container to have two frames on opposite ends in the container). References such as *Wilkinson*, *Galgano*, and *Bass* confirm that such use of a pair of frames supporting a cable reel in a container predates the '697 patent. And substituting a cardboard box with a bag was well within the technical grasp of ordinary skill. *See Times Fiber*, IPR2022-00831, Paper 2 at 7-8 (citing Examiner's rationale equating

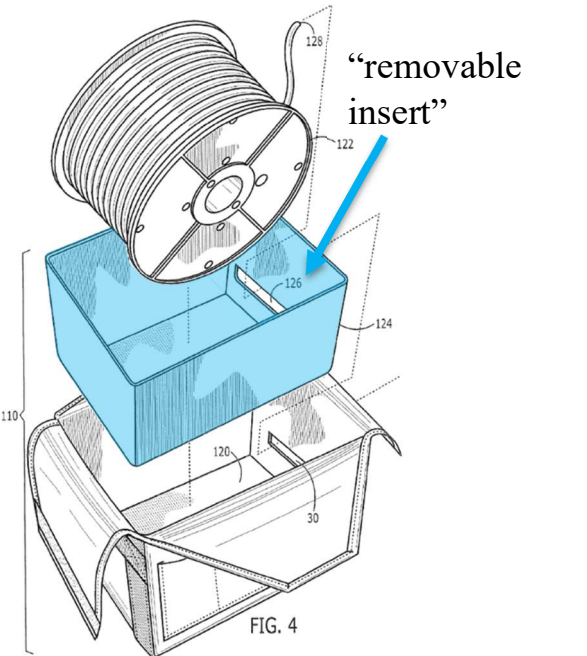
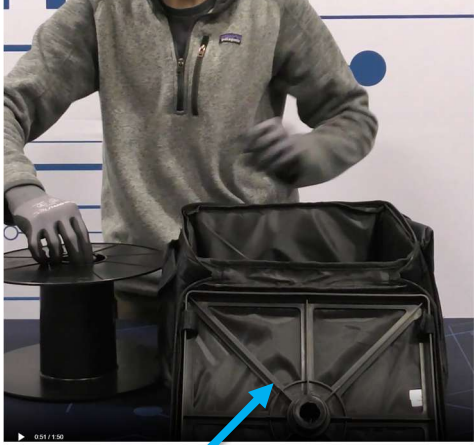
cable transport boxes and bags in rejecting claims directed to a communication cable payout bag including a pair of frames supporting a cable reel within the bag); *Times Fiber*, IPR2022-00831, Ex. 1003 at 52-53 (“boxes and bags are old and well known art equivalents for storing, transporting, and dispensing items stored in them,” “obvious to ... store the cable reel of Galgano et al. in a bag to make the assembly lighter and easier to carry from one place to another”). And in those IPRs, the Board affirmed that claims to a communication cable payout bag having a pair of frames supporting a cable reel within the bag are not patentable. *Times Fiber*, IPR2022-00946, Paper 46 at 109; *Times Fiber*, IPR2022-00947, Paper 47 at 112; *Times Fiber*, IPR2022-01087, Paper 46 at 117; *Times Fiber*, IPR2022-01088, Paper 43 at 107.

Notably, patent owner Times Fiber in those IPRs argued that CommScope’s Tech Service Bag (Ex. 2006)—alleged commercialization of the ’697 patent—copied the invention claimed in Times Fiber’s patents. *Times Fiber*, IPR2022-00947, Paper 18 at 42 (Mar. 28, 2023) (“To compete with Times Fiber, at least PPC and CommScope marketed copies of the claimed invention ...”), 45 (“Kenneth Wood of CommScope stated that their reusable reel and Tech Bag are ‘very similar to the other companies and a very successful program.’”); *see also Times Fiber*, IPR2022-00947, Ex. 2005 (showing Amphenol’s tech service bag having a pair of frames).

The truth is that Petitioner PPC’s accused bag is fundamentally different from the claimed bag of the ’697 patent. The accused bag has two frames supporting a

cable reel within the bag. Ex. 1025 (Plaintiff's Infringement Contention), 15-18. The '697 patent discloses only one embodiment for the "removable insert"—a box with an open top that can be closed using a closure mechanism. Ex. 1001, FIG. 4, 1:45-46 ("a closure mechanism that is configured to close the removable insert in the main compartment), 5:39-44 ("a closure mechanism 70 (not shown in FIG. 4) configured to close the removable insert 124 in the main compartment 120."). The two separate frames in the accused bag product do not have an open top and cannot be closed like the box of the '697 patent. Patent Owner cannot reasonably claim to have settled expectations that the '697 patent be immune from the Board's review while asserting such broad interpretation of the claims that lacks support in the specification. *See* Ex. 1001, *generally*.

In contrast, after almost a decade on the market, Petitioners had settled expectations that Patent Owner would not assert the '697 patent. As discussed above and shown below, Petitioners' accused bag product is fundamentally different from the bag claimed by the '697 patent because the accused bag product does not have the claimed "removable insert."

'697 Patent (annotated)	Accused PPC Product
 FIG. 4	 Plastic frame attached to bag

Compare Ex. 1001, FIG. 4 with excerpt from Ex. 1025 at 17 (Patent Owner alleging a plastic frame attached to the bag constitute “part of the removable insert”); see *BOE Tech. Grp. Co., Ltd. v. Optronix Scis. LLC*, IPR2025-00238, -00239, Paper 11 at 2 (PTAB July 29, 2025) (noting that one of the considerations weighing against denial is Petitioner’s “settled expectations that the challenged patents would not be asserted against it because the challenged patents are directed to technology that is fundamentally different from what Petitioner uses in its products”).

Petitioners had no reason to challenge the claims of the patents in an IPR until Patent Owner asserted the '697 patent in district court. Indeed, Petitioners had no expectation that Patent Owner would assert the '697 patent against the accused bag

product. The '697 patent was issued in February 2016. Ex. 1001, cover page (45). Petitioner PPC began marketing the alleged infringing product at least as early as September 25, 2014—more than one year before the '697 patent issued. *Times Fiber*, IPR2022-00947, Paper 2 at 10-18 (showing that the accused bag was publicly displayed in an industry-wide conference and marketed in 2014). Although “Patent Owner and Petitioners compete in the same technology space,” PO Req. 4, Patent Owner never asserted the '697 patent against Petitioner PPC for over a decade. Nor did Patent Owner assert the '697 patent against Times Fiber or Amphenol, who also markets a communication cable payout bag with a pair of frames. *Times Fiber*, IPR2022-00947, Ex. 2006. *Shenzen Tuozhu Tech. Co., Ltd. v. Stratsys, Inc.*, IPR2025-00438, Paper 10 (Director July 17, 2025) (finding that Petitioner’s evidence that the challenged patents had never been “commercialized, asserted, marked, licensed, or otherwise applied” in Petitioner’s “particular technology space” weighs against Patent Owner’s claim of strong settled expectations of a patent that had been in force for approximately 10 years).

Petitioner PPC’s continuous manufacture and marketing of the accused bag since before the issuance of the '697 patent weighs heavily against discretionary denial. It demonstrates that PPC—and others (e.g., Amphenol) who also sell similar communication bags—had settled expectations that the '697 patent would not apply to such products. *See Intel*, IPR2025-00327, Paper 12 at 2-3 (explaining it “weigh[s]

against a patent owner’s claim of settled expectation” when “a patent may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner’s particular technology space”); *cf. Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1273 (Fed. Cir. 1999) (“A patentee, of course, may sleep upon the right to exclude others from making, using, offering to sell or selling a patented invention. This right is held by the patentee against the public; by inexcusably failing to exercise timely its right to exclude, the patentee, in effect, authorizes the public to infringe—to ‘make, use, offer to sell, or sell’ a patented invention—during the laches period.”); *Hall v. Aqua Queen Mfg., Inc.*, 93 F.3d 1548, 1553 (Fed. Cir. 1996) (patentee should have known of the infringement because for at least eleven years prior to the suit, the accused infringer had engaged in “pervasive, open, and notorious activities in the industry, an industry in which [the patentee] had already been a central and active figure for at least eight years.”).

Denying institution in these circumstances would undermine the “settled expectations” of PPC and other communication bag manufacturers and reward Patent Owners’ strategic delay in asserting the ’697 patent to monopolize conventional technology for cable payout containers. Under the circumstances at issue here, on balance, the age of the ’697 patent, the fundamental difference in the accused bag product from the claimed invention, and PPC’s continuous marketing

of the product over a decade prior to the patent's issuance all weigh against discretionary denial.

Finally, even if Patent Owner had any settled expectations—which, as discussed above, it does not—those expectations would be outweighed by the need to correct Examiner's material errors made during examination as discussed above. *See supra* Section II.B.3; *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12 at 2-3 (Director July 17, 2025) (finding that reviewing the Office's material error outweighed settled expectations for a nine-year-old patent); *see also Anthony*, IPR2025-00559, Paper 12 at 2 (determining not to exercise discretion to petitions involving 17- and 18-year-old patents because the examiner materially erred by overlooking prior art teachings).

B. The PTAB Has Not Adjudicated Patentability of the Challenged Claims Based on Petitioners' Prior Art.

Patent Owner argues that the Board has already considered the challenged claims and appears to argue that the combination of *Cohn* and *Redzisz* (Grounds 1 and 2) is cumulative of the combination of *Cote* and *Godshaw* previously evaluated by the Board. PO Req. 6-7. Not so.

As discussed above, the Petition relies on new prior art references, *Redzisz*, *Bass*, and *Barnett*, and new prior art combinations *Cohn* and *Redzisz*, *Young* and *Bass*, and *Young* and *Barnett* not previously presented to the Office. *See supra*

Section II.A. The Petition shows that the combination of *Cohn* and *Redzisz* cures the deficiencies of the *Cote* reference for the claimed “flexible material” identified by the Board (*see supra* Section II.A.1), and discloses the claimed “removable [plastic] insert” under a proper means-plus-function interpretation. *See supra* Section II.A.1.c.

The Petition also shows that the combinations of *Young* and *Bass* and *Young* and *Barnett* disclose the limitation reciting a “cable payout passageway ... configured to receive therethrough the loose end of cable from the outer portion of the reel of communications cable,” which was allegedly missing from *Young*. *See supra* Sections II.A.2.c, II.A.2.d. The Petition further shows how the combination of *Young* and *Bass* renders the Challenged Claims unpatentable under Patent Owner’s apparent construction in the district court litigation—an interpretation that was not available to the Examiner or the Board during prosecution and appeal. *See supra* Section II.A.2.c.

Reviewing the Petition’s new prior art combinations and obviousness arguments would not be a waste of the Office’s resources. Rather, it presents an opportunity to review the parties’ claim construction positions and to correct the material errors the Examiner made when allowing the ’697 patent. *See supra* Section II.B.

IV. The *Fintiv* Factors Support Referral.

The *Fintiv* factors support institution in this case. The Petition presents strong evidence of unpatentability and corrects material errors by the Office—none of which are persuasively rebutted by Patent Owner. Significant work remains in the parallel litigation: institution would come months before the close of fact discovery, expert discovery, and dispositive motions. Further, trial in the district court is scheduled to begin on May 17, 2027—about six months *after* the projected final written decision in this IPR. The circumstances here show that institution of this Petition will further the Director’s and the Office’s goals of an efficient, focused proceeding that is not duplicative of efforts by the district court.

A. Factor 1 Favors Institution Because the District Court Is Likely to Grant a Stay.

In the parallel district court litigation, Patent Owner asserted only the ’697 patent subject to this IPR. Although neither party has yet moved to stay the district court case, Petitioners intend to move for a stay after institution of this IPR. It is likely that such a motion to stay will be granted. Since 2019, Judges in the District of Delaware have granted stays pending PTAB review about 70% of the time. Ex. 1029 (showing 65% to 77% grant rate for motions to stay pending IPR by Judges in the District of Delaware from 2019 to 2024). For Judge Andrews, the judge presiding over the parallel litigation, the grant rate is even higher—approximately 82%. Ex. 1030 (showing 74% to 94% grant rate for motions to stay pending IPR by

Judge Andrews from 2019 to 2024). Because these statistics include pre-institution motions, the likelihood of a stay being granted post-institution is even higher. As such, this factor weighs in favor of institution or at least should be treated as neutral.

B. Factor 2 Favors Institution Because the Trial Date Is Six Months After the Projected Final Written Decision.

Factor 2 strongly favors institution because the district court trial is scheduled to begin six months *after* the projected final written decision in this proceeding. The District Court has set the jury trial to begin on May 17, 2027. Ex. 2004 at 12 (Scheduling Order). The projected deadline for a final written decision in this IPR is November 23, 2026. *See* Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response, Paper 6 (setting preliminary response date for August 25, 2025); 35 U.S.C. § 324(c) (setting expected institution decision for three months after preliminary response); 35 U.S.C. § 326(a)(11) (requiring final determination by one year after institution decision, extendable by six months). To the extent the Director considers median-time-to-trial data a more reliable indicator of when trial will occur, under the 40.2-month median-time-to-trial in the District of Delaware (*see* Ex. 1031), the parallel trial will not begin until August 2027, about nine months after the projected final written decision.

“As such, it is likely that a final written decision this proceeding will issue before the district court trial occurs,” which favors institution. *Amazon.com v. NL*

Giken, IPR2025-00250, Paper 14 at 2 (Director May 16, 2025) (determining not to exercise discretion because the time-to-trial statistics suggest trial will begin six months after projected final written decision due date); *see also Twitch Interactive v. Razdog Holdings*, IPR2025-00307, Paper 18 at 2 (Director May 16, 2025) (determining not to exercise discretion because the median time-to-trial statistics suggest trial will begin seven months after the projected final written decision); *Google LLC v. BrodTl Inc.*, IPR2025-00472, Paper 19 at 2 (Director June 25, 2025) (determining not to exercise discretion because the median time-to-trial statistics suggest trial will begin seven months after the projected final written decision); *Berkshire Hathaway Energy Co. et al. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 2 (Director July 2, 2025) (determining not to exercise discretion because the projected final written decision would be issued one month before the district litigation is “trial ready”).

Accordingly, the projected final written decision issuing before the parallel proceeding’s trial date by at least six months strongly weighs in favor of institution.

C. Factor 3 Favors Institution Because the Case Is in Its Early Stages and There Has Been No Significant Investment in the District Court.

Factor 3 weighs in favor of institution because the parallel district court litigation remains in its early stages, with limited investment by the parties and the court. Although the Court is expected to hold a claim construction hearing by the

projected institution decision deadline of November 23, 2025, substantial work remains, and significant events will have yet to occur for months. For example, fact discovery is scheduled to close on March 27, 2026, four months after institution. Ex. 2004 at 1 (Scheduling Order). Expert discovery will not close until August 7, 2026, about nine months after institution. *Id.* at 10. And case dispositive motions are due by September 25, 2026, nearly ten months after institution. *Id.* at 11. As such, much more work remains in the district court litigation.

The Board has consistently found that, where discovery is ongoing and significant work remains, Factor 3 weighs against denial. *See Bio-Rad Lab'ys, Inc. v. Cal. Inst. of Tech.*, IPR2024-01451, Paper 11 at 9-10 (PTAB Mar. 27, 2025) (concluding that Factor 3 “weighs against exercising our discretion to deny institution” where the *Markman* hearing was held, but “much more work remains, including, expert reports, expert discovery, expert depositions, and pretrial motions and disclosures”); *see also Snap Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15 at 9-13 (PTAB Oct. 21, 2020) (presidential as to § II.A) (finding *Fintiv* favor 3 favors institution because the district court proceeding was in its early stages where the parties have only exchanged preliminary contentions and claim construction positions, and the District Court has not issued a claim construction order).

Given the limited investment and the substantial work remaining in the district court litigation, Factor 3 weighs in favor of institution.

D. Factor 4 Favors Institution Because There Is No Risk of Overlapping Issues Between This IPR and the Parallel Litigation.

There can be no overlapping issues between this IPR and the parallel litigation because the projected final written decision will issue six months before the scheduled trial date in the district court litigation. Ex. 2004 at 12. As a result, the concerns raised in *Fintiv* regarding “inefficiency and the possibility of conflicting decisions” are not present here. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6-8 (PTAB Mar. 20, 2020).

Patent Owner argues that the Petitioner has not offered a stipulation to reduce overlap. PO Req. 22-23. This argument is unavailing. No stipulation is necessary. Following the issuance of the final written decision in this IPR, Petitioners will proceed to trial in the district court litigation bound by the estoppel provision of 35 U.S.C. § 315(e)(2). Instituting this IPR would either result in cancellation of the asserted claims or invoke the statutory estoppel against Petitioners at the district court. As such, instituting this IPR eliminates “any concerns of duplicative efforts between the district court and the Board,” thereby achieving the same purpose as a *Sotera* stipulation and ensuring that this IPR is a “true alternative” to the district court proceeding. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 9 (Dec. 1, 2020) (precedential as to § II.A).

Accordingly, this factor strongly weighs in favor of institution.

E. Factor 5 Is Neutral Because the Statutory Estoppel Will Bind Petitioners in the District Court Litigation.

Factor 5 is neutral in this case because the statutory estoppel under 35 U.S.C. § 315(e)(2) will apply to Petitioners in the parallel district court litigation. The parties before the Board and district court are the same, as is typical in IPRs. As discussed above, the projected final written decision in this IPR will issue at least six months before the scheduled trial date. As a result, the conclusion of this IPR will invoke the § 315(e)(2) estoppel, and Petitioners will be estopped from asserting in the district court any ground that was raised or reasonably could have been raised during this IPR.

Although Factor 5 can sometimes weigh slightly in favor of discretionary denial when the same parties are involved in both proceedings, it is not dispositive. Under the circumstances here, where § 315(e)(2) estoppel will apply before trial, Factor 5 should be treated neutral. *See, e.g., Snap*, IPR2020-00820, Paper 15 at 16 (“[W]e regard the consideration of the fifth *Fintiv* factor as neutral or, at most, weighing slightly in favor of exercising discretion to deny institution”).

F. Factor 6 Favors Institution Because the Petition Presents a Strong Case.

The Petition presents a strong case of unpatentability that further supports institution. The Petition relies on a new primary reference, *Redzisz*, which was not presented to the Office during prosecution. *See supra* Section II.A.1. Patent Owner

asserted that *Cohn* was cumulative of *Cote* cited by the Examiner and that *Redzisz* fails to disclose a bag constructed of a “flexible material.” *See* PO Req. 11-14. But neither is correct. As discussed above, the Petition relies on *Cohn* for the claimed “removable insert” while the Examiner relied on *Cote* for the claimed “main compartment made of a flexible material,” and *Redzisz* expressly discloses the bag is made of a flexible material, such as canvas. *Redzisz*, [0003], [0005], [0028], [0037]-[0038], FIGS. 6-9; Pet. 29; *see supra* Section II.A.1. The Petition also applies controlling case law on means-plus-function interpretation and shows the Challenged Claims are unpatentable over the combination of *Cohn* and *Redzisz* under such means-plus-function interpretation of the claimed “removable [plastic] insert.” *See supra* Section II.A.1.c. The Examiner did not conduct any means-plus-function analysis on the claims or evaluate the prior art over the claims under any means-plus-function interpretation during prosecution. *See supra* Section II.C.

The Petition also shows the combinations of *Young* and *Bass* and *Young* and *Barnett* disclose the limitation of “cable payout passageway is configured to receive therethrough the loose end of cable from the outer portion of the reel of communications cable” allegedly missing from *Young*. *See supra* Section II.A.2; PO Req. 18, 24-25. The Petition further shows how the combination of *Young* and *Bass* renders the challenged claims unpatentable under Patent Owner’s apparent

construction in the district court litigation, which was not available to the Examiner and the Board during prosecution and *ex parte* appeal. *See supra* Section II.A.2.

Accordingly, the strength of the grounds presented in the Petition weighs in favor of institution. *See supra* Section II.

V. Conclusion

For the reasons above, Petitioners request that the Director not exercise discretion to deny institution of this proceeding.

Respectfully submitted,

Dated: August 25, 2025

By: / Cory Bell /
Cory Bell, Reg. No. 75,096
Lead Counsel

CERTIFICATE OF COMPLIANCE

As calculated by the “Word Count” feature of Microsoft Word for Microsoft 365, the foregoing **Petitioners’ Opposition to Patent Owner’s Request for Discretionary Denial** contains 9,696 words, excluding this Certification and the following: Table of Contents, Table of Authorities, and Certificate of Service.

Dated: August 25, 2025

By: / Cory Bell /
Cory Bell, Reg. No. 75,096
Lead Counsel

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Petitioners' Opposition to Patent Owner's Request for Discretionary Denial** was served on August 25, 2025, via e-mail directed to counsel of record for the Patent Owner at the following:

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