UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

FERID ALLANI
Patent Owner.

CASE IPR2025-00856
U.S. Patent No. 8,271,877

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

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TABLE OF ABBREVIATIONS

Abbreviation	Term
Allani	Patent Owner Ferid Allani
Petitioner or Apple	Petitioner Apple Inc.
Petition	Paper 1 of IPR2025-00856
POSITA	Person of ordinary skill in the art
The ’271 patent	U.S. Patent No. 8,271,877
The ’058 patent	U.S. Patent No. 10,943,058
The Challenged Patents	The ’877 and ’058 patents
The Challenged Claims	Claims 1-19 of the ’877 patent
PTAB or the Board	Patent Trial and Appeal Board
IPR	*Inter Partes* Review
WDTX	Western District of Texas
The Interim Processes Memo	Interim Processes for PTAB Workload Management dated March 26, 2025
Rossman	U.S. Patent No. 6,119,155
Himmel	U.S. Patent No. 6,037,934
King	U.S. Patent No. 6,353,839
Boyle	U.S. Patent No. 6,138,158

LIST OF EXHIBITS

EX2001	Letter from Lewis E. Hudnell, III to Jayna Whitt, Esq. dated November 2, 2012
EX2002	Original Complaint for Patent Infringement in *Allani v. Apple Inc.*, Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2003	Executed Summons in *Allani v. Apple Inc.*, Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2004	Cover Pleading of Plaintiff's Preliminary Infringement Contentions in *Allani v. Apple Inc.*, Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2005	Cover Pleading of Defendant's Preliminary Invalidity Contentions in *Allani v. Apple Inc.*, Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2006	Cover Pleading of Defendant's First Amended Preliminary Invalidity Contentions in *Allani v. Apple Inc.*, Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2007	Cover Pleading of Defendant's Second Amended Preliminary Invalidity Contentions in *Allani v. Apple Inc.*, Case No. 6-24-cv-00304-ADA (W.D. Tex.)

EX2008	Scheduling Order in *Allani v. Apple Inc.*, Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2009	Claim Construction Order in *Allani v. Apple Inc.*, Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2010	Law360 Article dated May 11, 2021
EX2011	Time to Milestone Statistics
EX2012	Excerpts from discovery responses served in *Allani v. Apple Inc.*, Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2013	Email from counsel for Apple dated July 1, 2025
EX2014	Notices of Subpoena served by Apple in *Allani v. Apple Inc.*, Case No. 6-24-cv-00304-ADA (W.D. Tex.)
EX2015	Notice of Agreed Extension of Deadline in *Allani v. Apple Inc.*, Case No. 6-24-cv-00304-ADA (W.D. Tex.)

I. INTRODUCTION

Under 35 U.S.C. § 314(a), Allani respectfully requests that the Director, in consultation with a Board panel, deny institution of Petitioner's Petition because all of the factors that the Board considers when exercising its discretion weigh against institution. Factor 1 weighs against institution because a stay of the district court case is unlikely. Factor 2 weighs against institution because the district court case will reach trial well before a final written decision issues. Factor 3 weighs against institution because the parties have made significant investments in the district court case, including completing claim construction and serving their respective infringement and invalidity contentions. Factor 4 weighs against institution because there is substantial overlap between the district court cases involving Petitioner and the issues raised in this IPR. Factor 5 weighs against institution because the parties in this proceeding are the same as they are in the district court case. Factor 6 weighs against institution because Petitioner delayed in filing the Petition and the merits of the Petition are weak.

Additionally, under the Interim Processes Memo, discretionary denial is appropriate in the instant IPR because several of the factors that the Director considers weigh in favor of denying the Petition. Most significantly, the settled expectation of Allani strongly weighs in favor of denial. The '877 patent has been

in force for almost 13 years and Petitioner has been aware of the '877 patent for almost 13 years. These facts alone are sufficient to warrant denying the Petition.

In short, based on a holistic assessment of all of the evidence, the Director should exercise her discretion and deny institution under 35 U.S.C. § 314(a).

II. FACTUAL BACKGROUND

IPR procedures began on September 16, 2012, as part of the AIA. Two days later, on September 18, 2012, the '877 patent issued.[1] Petitioner has had knowledge of the '877 patent since at least November 2, 2012 based on a letter that Mr. Allani sent Petitioner notifying Petitioner of the '877 patent.[2] Since that time, Petitioner and Mr. Allani have engaged in numerous communications regarding Mr. Allani's patents, including the '877 patent. Through subsequent correspondence, Mr. Allani informed Petitioner how the Accused Instrumentalities practiced one or more claims of the '877 patent. In addition, on or about June 27, 2013, Mr. Allani met with representatives from Petitioner at Petitioner's offices in Sunnyvale, California. At the meeting, Mr. Allani further explained how the Accused Instrumentalities practice the '877 patent and discussed a potential business arrangement concerning the '877 patent. Mr. Allani explained the value of the '877 patent to Petitioner and offered

[1] EX1001.
[2] EX2001.

to license his patents in good faith. Petitioner reviewed Mr. Allani's '877 patent and advised Mr. Allani that it was not interested in taking a license. Petitioner, however, failed to provide Mr. Allani with any legitimate basis as to why it does not need a license.

The '058 patent published on January 15, 2015 and issued on March 9, 2021.[3] The '058 patent is a divisional of the '877 patent and shares the same specification as the '877 patent.

On June 3, 2024, Allani sued Petitioner for patent infringement in the WDTX.[4] The complaint asserts that Petitioner willfully infringed the Challenged Patents.[5] Allani promptly served Petitioner on June 28, 2024.[6]

On October 17, 2024, Allani served its preliminary infringement contentions.[7] In its final contentions, Allani asserts that Petitioner infringes claims 12, 15, and 17-19 of the '877 patent.[8] Allani also asserts that Petitioner infringes claims 24-27 of the '058 patent.[9]

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[3] IPR2025-00857 at EX1001.
[4] EX2002.
[5] *Id.* at ¶¶53-56, ¶¶65-68.
[6] EX2003.
[7] EX2004.
[8] *Id.* at 1.
[9] *Id.*

On January 9, 2025, Petitioner served its preliminary invalidity contentions.[10] Petitioner served first amended invalidity contentions on April 17, 2025 and second amended invalidity contentions on May 14, 2025.[11] In its second amended contentions, Petitioner asserts that the Challenged Patents are rendered obvious by the combination of Rossman and 8 other references, including Himmel, King, and Boyle.[12] Petitioner also asserts invalidity under 35 U.S.C. §§ 101, 112.[13]

On October 11, 2024, the WDTX entered a scheduling order in the district court case setting trial for June 8, 2026.[14] The WDTX issued a claim construction order on May 30, 2025.[15]

In direct response to the WDTX complaint, on April 24, 2025—almost 11 months after Allani filed suit—Petitioner filed petitions for *inter partes* review asserting that all of the asserted claims of the Challenged Patents are invalid.[16] At the time of filing the petitions, the ’877 patent had been in force for almost 13 years. The application that led to the ’058 patent had been published for over ten years.

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[10] EX2005.
[11] EX2006, EX2007.
[12] *Id.* at 28, 39-40.
[13] *Id.* at 47-51.
[14] EX2008.
[15] EX2009.
[16] *See* IPR2025-00856, Paper 1; IPR2025-00857, Paper 1.

III. THE BOARD SHOULD EXERCISE ITS DISCRETION UNDER 35 U.S.C. § 314(A).

A. All Of The *Fintiv* Factors Weigh Against Institution.

35 U.S.C. § 314(a) gives the Director discretion to deny institution of IPRs due to the advanced state of parallel district court litigation regarding the same issues.[17] The Board has set forth six factors for determining whether discretionary denial in light of such parallel litigation is appropriate:

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 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;
6. other circumstances that impact the Board's exercise of discretion.[18]

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[17] *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19-21 (P.T.A.B. Sept. 12, 2018) (precedential).
[18] *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (P.T.A.B. Mar. 20, 2020) (precedential) ("*Fintiv I*").

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."[19]

Contrary to what Petitioner claims, the six-factor test addressed does not favor institution. Rather, the Director should exercise her discretion and deny institution. Considering the *Fintiv* factors, institution would not be an efficient use of Board resources.

1. Factor One (Evidence exists that a stay will not be granted)

Factor 1 weighs against institution because the district court will not likely stay the parallel action. Indeed, Judge Albright has publicly stated that he will rarely stay cases pending the outcome of IPRs absent special circumstances, as he believes that patent owners deserve jury trials in federal court.[20] Absent any special circumstance in this case—Petitioner alleges none—there is no reason to suggest that Judge Albright will issue a stay, particularly because he has already issued a claim construction order and fact discovery is underway as discussed below.

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[19] *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7-17 (P.T.A.B. May 13, 2020) (informative) ("*Fintiv II*").
[20] EX2010.

Moreover, the Board ordinarily will not attempt to predict how a district court will proceed if a stay has not been granted.[21] Thus, Factor 1 weighs against institution or is at worst neutral.

2. Factor Two (Proximity of trial date)

Factor 2 looks to "proximity of the court's trial date to the Board's projected statutory deadline for a final written decision."[22] "If the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under NHK."[23] "[T]he Board may consider any evidence that the parties make of record that bears on the proximity of the district court's trial date…, including median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides."[24]

In the instant IPR, Factor 2 weighs heavily against institution because the scheduled trial date of June 8, 2026 is over five months earlier than November 22, 2026—the projected date of the Board's final written decision if trial is instituted in

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[21] *See Fintiv II*, Paper 15 at 12 ("We decline to infer, based on actions taken in different cases with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here."); *Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (June 16, 2020) (informative).
[22] *Fintiv I*, Paper 11 at 5-6.
[23] *Id.* at 9.
[24] *See* Guidance on USPTO's recission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation," dated Mar. 24, 2025.

this IPR.[25] Petitioner's claim that the scheduled trial date is speculative is belied by the fact that the median time-to-trial for patent cases before Judge Albright is 25.9 months.[26] Moreover, there is no evidence in the record that the scheduled trial date will change.[27] Thus, the district court case, which was filed June 3, 2024, would be expected to go to trial by August 4, 2026 at the latest, which is still over three and half months before the projected final written decision date. By either measure, the Challenged Patents will be adjudicated far sooner in the district court than they will be by the Board. Indeed, the Board has denied institution on account of even smaller gaps between the final written decision and trial.[28] Accordingly, Factor 2 weighs against institution.

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[25] *See* EX2008 at 6; 35 U.S.C. § 316(a)(11); *see, e.g., Dell Inc. v. Universal Connectivity Techs, Inc.*, IPR2024-01480, Paper 12 at 9-10 (P.T.A.B. Apr. 24, 2025) (factor "strongly favors exercising discretionary denial" where "trial is set about six months before a final written decision"); *SAP America v. Cyandia, Inc.*, IPR2024-01496, Paper 13 at 5-6 (P.T.A.B. Apr. 7, 2025) (holding that this factor weighs against institution when the trail would begin "about four months before the deadline for entering a final written decision in this proceeding").

[26] EX2011.

[27] *See Google LLC v. Cerence Operating Co.*, IPR2024-01465, Paper 15 at 9 (P.T.A.B. Apr. 23, 2025) ("[T[he district court has set a trial date … almost seven months before the final written decision in this proceeding would be due…. Although a number of cases may be scheduled for jury selection on the same day as the District Court Litigation, nothing in the record indicates a trial in the District Court Litigation would not take place months before our deadline to reach a final decision.").

[28] *See, e.g., EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (P.T.A.B. Apr. 13, 2022) (finding this factor weighed in favor of discretionary denial and denying institution where "the beginning of the jury trial in the WDTX Cases is

3. Factor Three (Investment in parallel proceeding)

Factor 3 also weighs against institution because the parties have made significant investments in the district court case. The parties have completed claim construction and the district court has issued a claim construction order.[29] Additionally, each party has served responses to the other party's written discovery, Petitioner has already produced over 830,000 pages (seven volumes) of documents, Petitioner has served six third-party subpoenas seeking documents concerning potential system prior art, and Allani has reviewed Petitioner's source code.[30] Further, the parties have served their respective preliminary infringement and invalidity contentions and are due to serve their respective final infringement and invalidity contentions by July 24, 2025.[31] And, by the time of a potential institution decision in late-November 2025—the relevant timing under *Fintiv*—the parties will have completed fact discovery.[32] The Director and the Board have routinely found

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roughly one or two months before any final decision would have been due had inter partes review been instituted"); *Fintiv II*, Paper 15 at 13 (finding this factor weighed in favor of discretionary denial and denying institution where the district court trial was scheduled to occur two months before the deadline for the Board to reach a final written decision).

[29] EX2009.

[30] EX2012-EX2014.

[31] EX2004-EX2007, EX2015.

[32] EX2008 at 4.

this factor to strongly favor denial under similar circumstances—and even when less investment has been made.[33]

The reason why the district court litigation will be so far along at the time of potential institution is because Petitioner unduly delayed filing the Petition. Allani served Petitioner with the Complaint explaining Allani's infringement theories on June 28, 2024.[34] Allani served its preliminary infringement contentions on October 17, 2024 meaning that Petitioner knew full well the entire scope of the case and which claims were at issue for over six months before filing this Petition.[35] The six-month gap between service of infringement contentions and the filing of the Petition constitutes "substantial delay" that favors discretionary denial under Factor 3.[36] Petitioner's choice to delay filing its Petition until two months before the statutory

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[33] *See, e.g.*, *BOE Tech. Grp. Co. v. Element Capital Commercial Co.*, IPR2023-00808, Paper 9 at 23-24 (P.T.A.B. Nov. 15, 2023) (denying institution in part because claim construction was complete and fact discovery was nearly completed); *Roku, Inc. v. Ioengine, LLC*, IPR2022-01553, Paper 11 at 11-12 (P.T.A.B. May 5, 2023) (finding Factor 3 weighed "heavily" in favor of denial due to the "completion of preliminary disclosures and claim construction, and the near-completion of discovery."); *Samsung Elecs. Co., Ltd. v. Mojo Mobility Inc.*, IPR2023-01093, Paper 11, 13-14 (P.T.A.B. Jan. 8, 2024) (finding Factor 3 weighed in favor of denial because "[f]act discovery is well underway (fact discovery is set to close a little more than two months after the issuance of this decision) and substantial preparation for a… *Markman* Hearing (including briefing) will be completed by [institution].").
[34] EX2003.
[35] EX2004.
[36] *See AT&T Servs. v. ASUS Tech.*, IPR2024-00992, Paper 14 at 12 (P.T.A.B. Dec. 16, 2024) (five months between infringement contentions and the petition is a "substantial delay").

deadline ensured that the district court's trial date, which the district court set on October 11, 2024, would come nearly six months before the projected date for a final written decision. Petitioner offers no explanation for its delay.[37] Accordingly, Factor 3 weighs against institution.

4. Factor Four (Overlap of issues)

Factor 4 weighs against institution because the Petition presents arguments that significantly overlap with arguments made in the district court. The Challenged Claims cover all of the claims asserted in the district court litigation. All of the prior art references that Petitioner relies upon overlap with the prior art references that Petitioner relies on in its invalidity contentions.[38] In those contentions, Petitioner asserts that claims 12, 15, 17-19 of the '877 patent are invalid in view of Rossman, its primary reference, and Himmel in view of King.[39] In fact, Petitioner amended its invalidity contentions after it filed the instant IPR to add contentions based on Rossman, Himmel, King, and Boyle.[40]

Moreover, Petitioner's invalidity contentions are still far more expansive than the invalidity arguments set forth in the Petition. For example, Petitioner's invalidity contentions assert that the '877 patent is anticipated or rendered obvious in view of

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[37] Paper 1 at 63.
[38] *Compare* EX2007 at 17-18 *with* Paper 1 at 4.
[39] EX2007 at 39-40.
[40] *Compare* EX2007 *with* EX2006.

32 total prior art patents and applications, 12 non-patent literatures, and 18 prior art systems.[41] Petitioner's invalidity contentions further assert that the '877 patent claims are invalid under 35 U.S.C. §§101 and 112.[42]

Thus, Petitioner's invalidity contentions overlap with and are still significantly more expansive than the prior art arguments made in the Petition. This overlap raises "concerns of inefficiency and the possibility of conflicting decisions"[43], as the district court will likely decide the validity of the '877 patent claims months prior to any Final Written Decision, based on substantially similar (and indeed far more expansive) invalidity arguments.

Although Petitioner stipulates that they will not pursue (i) the specific grounds raised in IPR2025-00856, (ii) any other grounds that could have reasonably been raised before the PTAB in that instituted proceeding (i.e., any ground that could have reasonably been raised under §§ 102 or 103 on the basis of prior art patents or printed publications), (iii) any ground based on a combination of system prior art and the references asserted as part of a ground, or (iv) any system art prior art theory that is coextensive with prior art presented to the Board, this stipulation has several deficiencies.[44] First, Petitioner has not specified what grounds it could have

[41] EX2007 at 17-21.
[42] *Id.* at 47-51.
[43] *Fintiv I*, Paper 11 at 12.
[44] *See* EX1043.

reasonably raised under §§ 102 or 103 on the basis of prior art patents or printed publications raised in the instant IPR. Second, Petitioner has not asserted any ground based on a combination of system prior art and the references asserted as part of a ground in the instant IPR. Third, Petitioner has not specified what system art prior art theories it has asserted in the district court litigation are coextensive with the prior art it has presented to the Board. Thus, Petitioner has effectively offered no stipulation to mitigate concerns of inefficiency and conflicting decisions.

Petitioner would also be free to pursue subsequent *ex parte* reexamination petitions on grounds that could have been raised in the Petition. Thus, if the Board were to institute, Petitioner would be able to serially challenge the validity of the '877 patent in this proceeding, in the district court, and in an *ex parte* reexamination proceeding. This scenario is the exact opposite of the efficiency contemplated when the AIA introduced the IPR process as a more efficient and streamlined alternative to other invalidity challenges.

Further, Petitioner's claim construction proposals require the Board to construe the term "icon" to include textual icons.[45] But the district court has already construed this term as "plain and ordinary meaning."[46] By construing this term again, the Board will merely be duplicating the efforts of the parties and the WDTX.

[45] Paper 1 at 6-7.
[46] EX2009 at 2.

Given the significant investment by the parties in the district court case and the substantial overlap with this IPR, Factor 4 weighs against institution.

5. Factor Five (Same parties)

Petitioner and Allani are the same parties in the district court case, which weighs against institution.

6. Factor Six (Other factors)

Factor 6 weighs against institution for at least three reasons.

First, Petitioner unduly delayed filing the Petition. Allani promptly served Petitioner with the district court complaint on June 28, 2024.[47] Yet Petitioner waited until April 24, 2025 to file its Petition—almost ten months later. At that time, the parties had already served their respective infringement and invalidity contentions and completed claim construction briefing.[48] This delay is highly prejudicial to Allani, and antithetical to the statutory purpose of IPRs, which is to provide a "quick and cost effective alternative[] to litigation."[49] Petitioner was fully aware of the '877 patent—having had discussions with Allani regarding the '877 patent over 12 years ago—and the district court case timing. Petitioner also was likely aware of the '058 patent, which published as an application over ten years ago. Petitioner had ample opportunity to file IPRs citing to the prior art that it knew about in January 2025

[47] EX2003.
[48] EX2008 at 1-3, EX2004, EX2005.
[49] *See* H.R. Rep. No. 112–98, pt. 1, at 48 (2011) (emphasis added).

when it served its preliminary invalidity contentions. It chose not to. Instead, Petitioner waited, thus making it extremely likely that the validity of the Challenged Patents will be decided in the district court months before any Final Written Decision in these proceedings.

Second, contrary to Petitioner's assertions, the Petition fails to present any compelling merits of unpatentability.[50] The Petition does not even allege any anticipatory prior art under §102. Instead, the Petition relies solely on obviousness combinations under §103 (relying on nearly 124 pages of expert testimony).[51] Thus, the Petition only serves to highlight the novelty of the challenged claims, and the web of repurposed §103 prior art presented in the Petition and expert declaration (including many dozens of shadow references) fails to render the challenged claims obvious for reasons that Allani will highlight in its POPR merit-based briefing, including the fact that numerous claim limitations are not disclosed by any of the alleged combination references.

Third, as discussed further below, additional considerations as outlined in the Interim Processes Memo weigh strongly in favor of discretionary denial, in particular the length of time the Challenged Claims have been in effect. In view of

[50] *Contra* Paper 1 at 63.
[51] EX1003.

these circumstances, Allani respectfully submits that the Director should exercise her discretion to deny institution.

B. ADDITIONAL CONSIDERATIONS WEIGH IN FAVOR OF DISCRETIONARY DENIAL

In addition to the above factors, as explained in the Interim Processes Memo,[52] additional relevant considerations may weigh in favor of discretionary denial, including:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

[52] *See* Interim Processes for PTAB Workload Management dated March 26, 2025.

As discussed further below: 1) no changes in the law support reconsideration of validity of the ’877 patent claims; 2) the Petition is weak and is overly reliant on expert testimony; and 3) the claims have been in effect for over 13 years.

1. No changes in the law support reconsideration of patentability

First, no changes in the law support reconsideration of the validity of the ’877 patent claims, and Petitioner does not identify any such change.

2. The Petition is weak and overly reliant on expert testimony.

Second, the Petition is particularly weak and overly reliant expert testimony to gap-fill holes in the prior art. For example, as discussed in the Interim Processes Memo FAQ, “[w]hile the Board may consider expert testimony, as a matter of efficiency, extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court.”[53] Thus, a “failure to provide focused expert testimony may weigh against institution.”[54]

As discussed above, the Petition relies on nearly 124 pages of expert testimony in an attempt to cobble together up to four different enumerated combination references to support the Petition’s invalidity grounds.[55] This

[53] *See* FAQs for Interim Processes for PTAB Workload Management at numbered item 21.
[54] *Id.*
[55] EX1003.

overreliance on expert testimony to overcome deficiencies in the prior art is an additional relevant consideration weighing against institution.

3. Settled expectations weigh heavily against institution.

As noted above, the '877 Patent issued in 2012—two days after IPRs became effective—and has been in effect for nearly thirteen years. Allani notified Petitioner of its need to take a license to the '877 patent over 12 years ago. Despite being on notice and despite having IPRs available to it essentially since IPR's inception, Petitioner waited until now to pursue its challenges in the PTAB. Under similar circumstances, the Director has found the settled expectations of the patent owner to weigh heavily in favor of denying institution, and in some instances denied institution based on settled expectations alone.[56] Accordingly, the settled

[56] *See iRhythm, Inc. v. Welch Allyn, Inc.*. IPR2025-00363, Paper 10 at 3 (P.T.A.B. Jun. 6, 2025) (stating "Petitioner's awareness of Patent Owner's applications and failure to seek early review of the patents favors denial and outweighs the above-discussed considerations" one of the patents has been in force since as early as 2012 and Petitioner was aware of it as early as 2013); *see also Samsung Electronics America, Inc. et. al. v. Four Batons Wireless, LLC*, IPR2025-00493, Paper 11 at 2 (P.T.A.B. July 17, 2025) (noting a six month gap between the estimated trial date and stating "the challenged patents have been in force for over ten years, creating *strong* settled expectations … .") (emphasis added); *Coretronic Corporation et al v. Maxell, Ltd.*, IPR2025-00474, Paper 11 at 2 (P.T.A.B. July 10, 2025) (noting a five month gap between the estimated trial date and the final written decision date and stating "[T]he challenged patents have been in force for approximately eight, twelve, and fifteen years, creating *strong* settled expectations … .") (emphasis added); *NXP USA, INC. et al. v. Redstone Logics LLC*, IPR2025-00485, Paper 11 at 2 (P.T.A.B. July 10, 2025) ("Additionally, the challenged patent has been in force for approximately twelve years, creating *strong* settled expectations … .") (emphasis

expectations of Allani of being able to adjudicate the Challenged Claims before an Article III Court weigh against institution.

IV. CONCLUSION

In conclusion, all six *Fintiv* Factors weigh in favor of discretionary denial. Furthermore, additional relevant considerations further weigh in favor of discretionary denial. Thus, considered as a whole, the relevant facts all weigh in favor of the Director exercising her discretion and denying the Petition under § 314(a).

Date: July 22, 2025

Respectfully submitted,

By: /s/ Lewis E. Hudnell, III
Lewis E. Hudnell, III
Reg. No. 51,185
Stanley H. Thompson, Jr.
(Special Counsel)
Reg. No. 45,160
Hudnell Law Group P.C.
800 W. El Camino Real Suite 180
Mountain View, CA 94040
T: 650-564-3698
F: 347-772-3034
lewis@hudnelllaw.com
stan@hudnelllaw.com

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added); *Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 2 (P.T.A.B. Jun 18, 2025) ("[T]he challenged patent has been in force almost eight years, creating settled expectations.").

CERTIFICATE OF WORD COUNT

Under 37 C.F.R. § 42.24, I certify that Sections I-IV of this PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION have a total of 4,164 words according to the word count tool in Microsoft Word™.

By: /s/ Lewis E. Hudnell, III
Lewis E. Hudnell, III
Reg. No. 51,185

Date: July 22, 2025

CERTIFICATE OF SERVICE

I certify that the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** was served on July 22, 2025 on the Petitioners by filing this document through Patent Trial and Appeal Case Tracking System (P-TACTS) as well as e-mailing a copy to PTAB@eriseip.com.

By: /s/ Lewis E. Hudnell, III
Lewis E. Hudnell, III
Reg. No. 51,185
Hudnell Law Group P.C.
800 W. El Camino Real
Suite 180
Mountain View, CA 94040
T: 650-564-3698
F: 347-772-3034
lewis@hudnelllaw.com