

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Milwaukee Electric Tool Corporation,

Petitioner,

v.

Klein Tools, Inc.,
Patent Owner

U.S. PATENT NO. 11,713,209

Case No. IPR2025-00892

**PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF *INTER PARTES REVIEW***

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<u>Exhibit #</u>	<u>Description</u>
2001	Complaint for Patent Infringement, <i>Klein Tools, Inc. v. Milwaukee Electric Tool Corp.</i> , Case No. 25-cv-00143, February 4, 2025, Docket No. 1
2002	Email between Counsel re Motion to Stay, dated between March 24-25, 2025
2003	Defendant's Unopposed Motion to Stay Pursuant to 28 U.S.C. § 1659 and for an Extension of Time to Respond to the Complaint, <i>Klein Tools, Inc. v. Milwaukee Electric Tool Corp.</i> , Case No. 25-cv-00143, March 27, 2025, Docket No.11
2004	Order Granting Motion to Stay, <i>Klein Tools, Inc. v. Milwaukee Electric Tool Corp.</i> , Case No. 25-cv-00143, March 28, 2025, Docket No. 12
2005	Order No. 7: Procedural Schedule, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, May 1, 2025
2006	United States Patent and Trademark Office Memorandum re Interim Processes for PTAB Workload Management, March 26, 2025
2007	First Amended Complaint under Section 337 of the Tariff Act of 1930, as Amended, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442, May 5, 2025
2008	Excerpt of First Supplemental Domestic Industry Claim Chart for U.S. Patent No. 11,713,209, In the Matter of Certain Glow Fish Tape Systems, Safety Helmet Systems, and Components Thereof, Investigation No. 337-TA-1442
2009	Klein Tools New Glow Fish Tape Perfect for Low Light Applications, December 17, 2020

<u>Exhibit #</u>	<u>Description</u>
2010	Excerpts of Techtronic Industries Annual Report 2023
2011	United States Patent and Trademark Office FAQs for Interim Processes for PTAB Workload Management
2012	United States Patent and Trademark Office Memorandum re Guidance on USPTO’s recession of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, March 24, 2025

I. INTRODUCTION

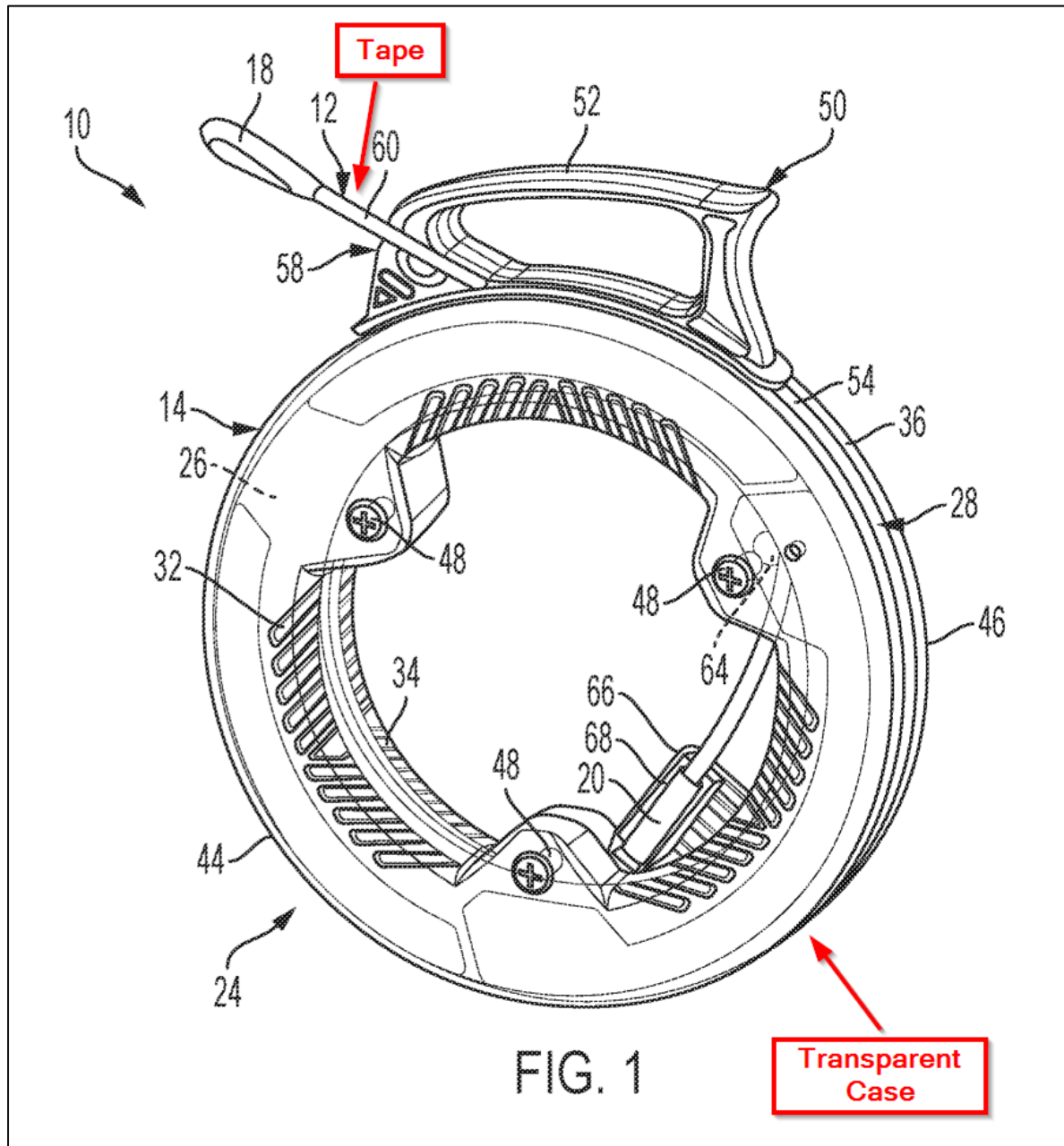
A parallel ITC investigation involving this same patent, parties, prior art, claims, and grounds is set to complete trial one year before the PTAB would issue its final written decision, with the ITC investigation entirely concluding five months before the PTAB would issue its final written decision. Notably, in two IPRs involving the same parties as involved here, albeit in opposite roles, the Director recently exercised her discretion to deny institution on nearly identical facts. *See Klein Tools, Inc. v. Milwaukee Electric Tool Corporation*, IPR2024-01400, Paper 22 at 2-3 (June 11, 2025) (Director Stewart reversing Board decision to grant institution based on parallel ITC proceeding under *Fintiv* where the “ITC ... is scheduled to issue a final determination six months before the statutory deadline for the Board’s written decision”). Unlike the grounds in *Klein Tools v. Milwaukee*, the grounds presented in this petition are weak. Accordingly, Patent Owner respectfully requests that the Director exercise her discretion and deny institution of this *inter partes* review under 35 U.S.C. § 314(a).

II. BACKGROUND

A. The '209 Patent

The '209 Patent is related to fish tape, commonly used in construction. The invention of the '209 Patent relates to, among other things, fish tape systems where

the fish tape comprises luminescent material that can be energized while in the case. See Ex-1001 at Abstract. The preferred embodiment is depicted below:



Id. at Fig. 1 (annotated).

B. The Parallel, Fast-Moving ITC Investigation

Patent Owner and Petitioner are parties to two parallel proceedings concerning the '209 Patent: ITC Investigation No. 337-TC-1442 (the “Parallel ITC Investigation”) and District of Delaware Case No. 1:25-cv-00143-JLH (the “District Court Case”) since February of 2025. *See* Ex-1016; Ex. 2001. Petitioner informed Patent Owner of its intention to file its request for a “mandatory” 28 U.S.C. § 1659 stay of the District Court Case pending resolution of the Parallel ITC Investigation, which Patent Owner did not oppose, and the District Court granted. *See* Exs. 2002; 2003; 2004. The purpose of a § 1659 stay is to “avoid[] litigation in two forums at once.” *In re Princo Corp.*, 478 F.3d 1345, 1355 (Fed. Cir. 2007).

The Parallel ITC Investigation is already at an advanced stage. Claim construction is fully briefed, and the parties will argue the issues next week. Ex. 2005. The parties are less than a month away from the fact discovery cutoff and completion. Ex. 2005 at 2. Indeed, the parties have collectively served 44 interrogatories (even more when discrete subparts are counted), supplemented their interrogatory answers a total of 11 times, produced 44,900 pages of documents, and started depositions. Trial is less than four months away, starting on November 17, 2025 and finishing no later than November 21, 2025. Ex. 2005 at 3. The Chief ALJ is slated to release his final initial determination on February 18, 2026, and

the Commission is scheduled to complete its investigation by June 18, 2026. *Id.* at 3.

C. This IPR’s Schedule

The Preliminary Patent Owner Response is due on August 21, 2025. *See* Paper 5 at 1. The Board’s decision on whether to institute *inter partes* review will therefore be due on November 21, 2025—the same day trial is set to finish in the Parallel ITC Investigation. *See* Ex. 2005 at 3. Assuming *inter partes* review is instituted (it should not be), the Board’s final written decision would be due on November 21, 2026—over five months after the completion of the Parallel ITC Investigation. *See id.* at 3.

III. DISCRETIONARY DENIAL CONSIDERATIONS

On March 26, 2025, Director Coke Morgan Stewart issued and signed a memorandum titled “Interim Processes for PTAB Workload Management” (the “March 26 Memo”). The March 26 Memo provides for a bifurcation between requests for discretionary denials and requests for merits-based denials. *See* Ex. 2006 at 1. The March 26 Memo explains that for requests for discretionary denials the PTAB will consider *Fintiv*¹ factors and other factors, such as “[t]he extent of

¹ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential).

the petition’s reliance on expert testimony,” and “[s]ettled expectations of the parties.” *Id.* at 2.

Instituting or denying a petition under § 314(a) “is a matter committed to the Patent Office’s discretion.” *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016); *see also Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (under § 314(a) “the PTO is permitted, but never compelled, to institute an IPR proceeding”).

When there is a parallel proceeding that “will analyze the same issues and will be resolved before any trial of the Petition concludes,” institution of an IPR trial “would not be consistent with ‘an objective of the AIA ... to provide an effective and efficient alternative to district court litigation.’” *NHK Spring Co. v. Intri-Plex Techs.*, IPR2018-00752, Paper 8 at 20 (Sept. 12, 2018) (precedential) (citations omitted). In *NHK*, the Board used its discretion to deny institution under § 314(a) because a parallel district court proceeding was scheduled to end before the Final Written Decision (“FWD”) deadline and “Petitioner assert[ed] the same prior art and arguments” in that parallel proceeding. *NHK*, IPR2018-00752, Paper 8 at 19-20. The same rationale applies to a parallel ITC investigation. *Fintiv*, IPR2020-00019, Paper 11 at 8 (March 20, 2020) (“[A]n earlier ITC trial date may favor exercising authority to deny institution under *NHK* if the ITC is going to decide the same or substantially similar issues to those presented in the petition.”).

Indeed, the Board has routinely denied institution under *Fintiv* based on a parallel ITC investigation. *E.g.*, *Klein Tools, Inc. v. Milwaukee Electric Tool Corporation*, IPR2024-01400, Paper 22 at 1-4 (June 11, 2025) (Director Stewart reversing Board decision to grant institution based on parallel ITC proceeding under *Fintiv*); *Samsung Electronics Co., Ltd. v. Sionyx, LLC*, IPR2025-00161, Paper 14 at 4-11 (May 21, 2025) (discretionarily denying institution of IPR under *Fintiv* in view of parallel ITC proceeding); *Innoscence America, Inc. v. Infineon Technologies Americas Corp.*, IPR2025-00010, Paper 11 at 5-20 (May 16, 2025) (same); *Arashi Visian (U.S.) LLC D/B/A Insta360 v. GoPro, Inc.*, IPR2025-00017, Paper 11 at 7-16 (April 28, 2025) (same); *Eunsung Global Corp. v. HydraFacial LLC*, IPR2024-01491, Paper 17 at 8-19 (Apr. 11, 2025) (same).

Fintiv articulated six factors to consider in determining whether to exercise discretion to deny institution based on a parallel district court or ITC proceeding: (1) whether the court granted a stay or evidence exists that one may be granted if an IPR proceeding is instituted; (2) proximity of the court's trial date to the Board's projected statutory deadline for a FWD; (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; and (6) other circumstances that impact the Board's exercise of discretion, including the merits. *Fintiv*, IPR2020-

00019, Paper 11 at 5-6. These factors are evaluated by taking “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

IV. ARGUMENT

A. All *Fintiv* Factors Weigh Strongly in Favor of Denial

1. *Petitioner Has Not Requested a Stay from the ITC, and, in any event, the ITC Would Not Grant One*

Petitioner has not requested a stay in the Parallel ITC Investigation. Even if the Petition were instituted, it is highly unlikely that the ITC would issue a stay at this late stage because trial is set to be complete by November 21, 2025—the same as the deadline for any institution decision here. Ex. 2005 at 3. Moreover, it is extremely unlikely that an ITC proceeding will be stayed pending IPR because, under 19 U.S.C. § 1337(b)(1), the ITC has a statutory mandate to conclude its investigation at “the earliest practicable time” and has refused requests, in essentially all instances, to stay investigations pending instituted IPRs. *See also, e.g., In the Matter of Certain Automated Storage and Retrieval Systems, Robots, and Components Thereof*, Investigation No. 337-TA-1228, Order No. 6 (Mar. 9, 2021); *In the Matter of Certain Laser-Driven Light Sources, Subsystems Containing Laser-Driven Light Sources, and Products Containing Same*, Investigation No. 337-TA-983, Order No. 8 (Mar. 3, 2016).

Although the Parallel District Court Litigation is stayed under 28 U.S.C. § 1659 pending the Parallel ITC Investigation, this does not alter the analysis. *See* Ex. 2004. *Fintiv* explains that the focus should be on “whether the patentability disputes before the ITC will resolve all or substantially all of the patentability disputes between the parties, regardless of the [District Court] stay.” *Fintiv*, IPR2020-00019, Paper 11 at 8-9.

The first factor thus weighs in favor of denying institution. *See Eunsung Global Corp. v. Hydrafacial LLC*, IPR2024-01491, Paper 17 at 11 (Apr. 11, 2025) (finding Factor 1 weighs in favor of discretionary denial when there is no evidence that ITC proceedings will be stayed despite stay of the parallel district court litigation).

2. *The ITC Trial is One Year Before the FWD, and the ITC’s Completion of Investigation is Five Months Before the PTAB’s FWD*

The ITC trial will conclude one year before the Board’s FWD deadline, and the ITC’s Completion of Investigation will finish five months before the Board’s FWD deadline. *See* Ex. 2005 at 3. This situation tracks *Arm*, where Director Stewart discretionarily denied institution because “the projected final written decision due date in the Board proceeding is in June 2026” and “[t]he district court’s scheduled trial date [(which is akin to the ITC’s trial date or Completion of Investigation date)] is January 26, 2026 and the time-to-trial statistics suggest trial

will begin ... between March and May 2026.” *Arm Ltd. V. Daedalus Prime LLC*, IPR2025-00207, Paper 10 at 2 (May 16, 2025) (inner quotation marks omitted). Further, the nearly five-month gap between the conclusion of the parallel proceeding (here, the ITC investigation) and the Board’s projected FWD date is larger than in *Fintiv*, where this factor was found to weigh in favor of denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (May 13, 2020) (the district court trial was scheduled two months before a projected FWD). The five-month gap is also larger than the gap between the conclusion of an ITC investigation and the Board’s FWD in an IPR where the Board found that this factor favored denial. *Philip Morris Products, S.A. v. Rai Strategic Holdings, Inc.*, IPR2020-00919, Paper 9 at 9 (Nov. 16, 2020) (considering a two-month gap). The second *Fintiv* factor therefore weighs strongly in favor of denial of institution.

3. *All Parties and the ITC Have Invested Heavily in the Parallel ITC Investigation*

The parties’ and the Commission’s investment in the Parallel ITC Investigation is substantial, and therefore this factor weighs heavily in favor of discretionary denial. The substantial work and investment by the parties and the Commission before the Board’s institution determination deadline is demonstrated by the following milestones that will be completed by November 21, 2025:

- case management conferences from May 2025 to trial (November 2025);
- a preliminary case management conference;

- claim construction briefing;
- a claim construction hearing;
- all document production;
- all written discovery (including interrogatories);
- all fact depositions;
- third-party discovery;
- opening and rebuttal expert reports;
- all expert depositions;
- motions *in limine*;
- final exhibit lists;
- final pre-hearing conference; and
- trial (*i.e.*, an evidentiary hearing).

See Ex. 2005. Under less extreme circumstances—where “fact discovery was complete, expert discovery was already underway, final invalidity and infringement contentions had been exchanged, and the district court had issued a *Markman* order” and “nearly all substantive work ***other than the trial itself*** will be complete by the time of th[e] institution date”—the Director held that the parties had “invested” “substantial time and effort” and that this “strongly favors discretionary denial.” *See Neogenomics Lab’ys, Inc. v. Natera, Inc.*, IPR2025-00455, Paper 13 at 2 (June 12, 2025) (emphasis supplied, brackets in original); *see also, Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00223, Paper 9 at 2 (June 12, 2025) (“[T]he parties have made meaningful investment in

the district court proceeding. For example, the parties have exchanged infringement and invalidity contentions, have already conducted over seven months of fact discovery, and a *Markman* hearing is scheduled to occur before the due date for an institution decision.” (internal citations omitted)).

The third *Fintiv* factor thus weighs in favor of denying institution. *See Eunsung*, Paper 17 at 12-13 (finding Factor 3 weighs in favor of discretionary denial where the parties have made substantial investments in view of trial scheduled before the institution decision).

4. *All of the Issues Raised by the IPR Are Present in the Parallel ITC Investigation*

All the grounds Petitioner raises here are present in the Parallel ITC Investigation.² Indeed, Petitioner incorporated its Petition by reference into its ITC

² Petitioner has not filed any *Sotera* (or other) stipulation confirming that it will not pursue in the ITC and in the district court any ground it raised or reasonably could have raised here. Even if Petitioner elects to enter a *Sotera* stipulation, the investment in the parallel proceeding by the parties and the Commission outweighs the impact of such a later-filed stipulation. *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 2 (Mar. 28, 2025) (Director Stewart reversing Board decision to deny discretionary denial because “[t]he Board did not give enough weight to the investment in the parallel proceeding

interrogatory responses for its substantive obviousness arguments on the '209 Patent. *See Fintiv*, IPR2020-00019, Paper 11 at 12 (“[I]f the petition includes the same *or substantially the same* claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” (emphasis supplied)). Further, all the claims at issue in the ITC investigation are at issue here. *See* Ex-1016 at 1; Ex. 2008 at 1. Accordingly, *Fintiv* Factor 4 weighs strongly in favor of denying institution.

5. *The Parties Are Identical*

The same parties involved in this proceeding are also involved in the Parallel ITC Investigation. Ex. 2007 at 1. *Fintiv*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020) (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”). *Fintiv* Factor 5 strongly favors denial.

and gave too much weight to Petitioner’s *Sotera* stipulation (*i.e.*, a stipulation that Petitioner will not pursue in district court any ground it raised or reasonably could have raised in the *inter partes* review (IPR)) and its potential to reduce overlap with the issues raised in the parallel proceeding.”).

6. *The Petitioner's Patentability Challenge is Weak*

Petitioner's challenge is weak. For one, Petitioner does not assert any anticipation grounds—only obviousness grounds based on two-way, or even three-way, combinations—implicitly conceding that the claimed inventions of the '209 Patent are new. Moreover, not a single one of the references relied on by Petitioner discloses a key limitation that appears in every Challenged Claim: “a fish tape having a length extending from a first end to a second end, the length of the fish tape comprising a luminescent material that emits light after being energized by exposure to a light source.” To the contrary, the Hartranft (Grounds 1 and 2) and KP1 (Ground 3) references relied on by Petitioner describe conventional fish tape, which the inventors of the '209 Patent sought to improve with their claimed inventions. *See* Ex-1004 at [0002], [0009]; Ex-1008 at 1; *see also* Ex-1001 at 1:10–37. And the Bruin (Grounds 1 and 2) and SP1 (Ground 3) references do not describe fish tape *at all*, but rather a “[c]able [c]atcher” (Ex-1005 at 1:1-6) and “[f]ish [s]ticks” (Ex-1009 at 1-2).

Lacking any prior art disclosure of this critical inventive element, Petitioner turns to its expert to fill the gap. Citing Dr. Eby, Petitioner asserts that a POSITA would have found it obvious to add fluorescent or luminescent material to the conventional fish tape of Hartranft or KP1. Paper 2 at 10-12, 55–58. But this amounts to nothing more than improper hindsight reasoning, using the claimed

inventions of the '209 Patent as a roadmap. *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Pat. Litig.*, 676 F.3d 1063, 1073 (Fed. Cir. 2012) (“This hindsight analysis is inappropriate because obviousness must be assessed at the time the invention was made.”); *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.”).

In the alternative, Petitioner asserts, again citing Dr. Eby, that it would have been obvious to replace the fish tape of Hartranft and KP1 with the “cable catcher” and “fish sticks” of Bruin and SP1. Paper 2 at 12-15, 58-62. But these components are not interchangeable with fish tape, as they differ significantly in their construction and applications, and could not be stored in, deployed from, or reloaded into Hartranft’s or KP1’s cases. *See, e.g.*, Ex-1004 at [0002]–[0003], Fig. 2; Ex-1005 at 4:18–30, Figs. 1–3; Ex-1008 at 1–2; Ex-1009 at 1–2. Rather, Petitioner’s proposed modification would render the devices of Hartranft and KP1 “inoperable for [their] intended purpose.” *Univ. of Maryland Biotechnology Inst. v. Presens Precision Sensing GmbH*, 711 F. App’x 1007, 1010 (Fed. Cir. 2017) (“[A] person of ordinary skill generally would not be motivated to modify a reference ... by making it ‘inoperable for its intended purpose.’”) (internal citations omitted) (quoting *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)).

Further belying Petitioner’s obviousness argument is the fact that Petitioner’s copycat product came out years after the ’209 Patent’s application published and Patent Owner’s commercial embodiment of the claimed inventions launched. *See* Ex-1001 at Cover (stating application published on May 27, 2021); Ex. 2009 (showing that Patent Owner’s product launched in December of 2020); Ex. 2010 at 27 (showing that Petitioner’s infringing product launched in 2023).

In any event, even if the Petition does not present weak grounds (it does), the other factors outweigh this one and warrant denial. *See, e.g., Supercell Oy v. Gree, Inc.*, IPR2020-00215, Paper 10 at 18 (June 10, 2020) (“Despite the Petitioner’s strong case on the merits, we determine that the facts underlying factors 2–5 collectively outweigh the facts underlying factor 6[, the merits factor].”); *Klein Tools, Inc.*, IPR2024-01400, Paper 22 at 3 (“With respect to factor 6, under *Fintiv*’s holistic assessment, the merits of the Petitions do not outweigh the other factors, which all favor denial. Thus, a holistic analysis of all the circumstances demonstrates that the efficiency and integrity of the system are best served by denying institution.” (citation omitted)).

7. *This Case is Nearly Identical to Klein*

In *Klein*, the Director exercised her discretion to reverse the Board’s decision to institute IPR because “the ITC investigation is unlikely to be stayed” and “the ITC ... is scheduled to issue a final written determination six months

before the statutory deadline for the Board’s final written decision.” *See Klein Tools, Inc. v. Milwaukee Electric Tool Corporation*, IPR2024-01400, Paper 22 at 2 (June 11, 2025). Further, the Director noted that “the ITC investigation involves the same parties, the same challenged claims, and includes overlapping prior art references.” *Id.* at 2-3. So too here, the ITC investigation is unlikely to be stayed, and the ITC is scheduled to issue a final written determination five months before the statutory deadline for the Board’s final written decision. *See id.* Indeed, the basis to deny institution here is even stronger as the parties are the same, the challenged claims are the same, and the prior art references are identical (indeed the grounds themselves are identical), not just overlapping as they were in *Klein*. *See id.* Further like *Klein*, by the time the institution decision is due, the ITC evidentiary hearing will be complete. *Id.* at 2. And unlike *Klein*, this petition’s merits are weak. *See id.* at 3. Thus, this request for discretionary denial is stronger than the request in *Klein*.

B. Additional Factors Weigh Against Institution

1. The Petition Relies Extensively on Expert Testimony

The March 26 Memo explains that “[t]he extent of the petition’s reliance on expert testimony” is a factor the Director may use to deny institution. *See Ex. 2006 at 2.* Further, the Patent Office FAQ explains that “extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues

may suggest that the questions are better resolved” in another tribunal. *See* Ex. 2011. Here, as discussed above in § IV.A.6, the Petition relies on Dr. Eby’s declaration to fill in a critical gap in the alleged prior art, as not a single one of the references relied on by Petitioner discloses “a fish tape having a length extending from a first end to a second end, the length of the fish tape comprising a luminescent material that emits light after being energized by exposure to a light source,” a key limitation that appears in every one of Challenged Claim.

Further, Petitioner relies extensively on expert testimony. Dr. Eby’s lengthy declaration—225 paragraphs across 105 pages—is cited 84 times in the Petition. This is not the “focused testimony” that the PTAB anticipates from experts. *See* Ex. 2011.

2. *The Relatively Early Challenge of the ’209 Patent Is Not a Significant Factor*

Consistent with the Board’s approach in *NeoGenomics Laboratories, Inc. v. Natera, Inc.*, IPR2025-00455, Paper 13 (June 12, 2025) (discretionarily denying a petition challenging U.S. Patent No. 11,319,596, issued May 3, 2022), the relatively recent issuance of U.S. Patent No. 11,713,209, August 1, 2023, does not constitute a significant factor in the discretionary denial analysis whereas here:

- Trial in the parallel proceeding will occur well before the PTAB’s final written decision,

- The parties and the tribunal have already made substantial investments in the parallel proceeding, and
- There is no indication that the parallel proceeding will be stayed in favor of the IPR.

In such circumstances, the efficiency, avoidance of duplicative proceedings, and respect for the investment in the parallel forum are paramount. The recency of the patent, standing alone, does not outweigh these considerations and should not preclude discretionary denial of institution.

3. *That an ITC Invalidity Ruling Would Not Bind the Office or the Courts Does Not Weigh Against Denying Institution*

As *Fintiv* noted, “as a practical matter, it is difficult to maintain a district court proceeding on patent claims determined to be invalid at the ITC.” *Fintiv*, IPR2020-00019, Paper 11 at 9. Despite awareness of the well-known non-binding nature of ITC invalidity rulings, the Board has found that a parallel ITC case can be the basis for discretionary denial. *Id.*; *see also* Ex. 2012. (March 24, 2025 memorandum from Chief Judge Boalick); *Intel Corp. v. Koninklijke Philips N.V.*, IPR2021-00328, Paper 16 at 6-7 (Mar. 29, 2022) (“non-binding effect of the ITC’s decision” did not “turn” *Fintiv* factor 6 to “*strongly* weighing” in favor of institution) (emphasis original); *supra* § III (collecting cases where institution was discretionarily denied based on a parallel ITC investigation).

4. *The Settled Expectations Factor Should Tip in Favor of Denial of Institution*

The March 26 Memo states that one factor for consideration is “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Ex. 2006 at 2. However, the Director has held that this factor favors denial where a Petitioner challenges a recently issued patent (2024) but “has not offered a stipulation to address concerns of duplicative efforts and potentially conflicting decisions in view of a significantly earlier trial date in a co-pending case that is unlikely to be stayed.” *Phison Electronics Corporation v. Vervain, LLC*, PGR2025-00011, Paper 14 at 3 (Jul. 10, 2025). The same circumstances are present here. Accordingly, as in *Phison*, this factor should “tip[] ... in favor of discretionary denial.” *See id.*

5. *Petitioner Has Not Requested Review of all Four Patents Involved in the ITC Investigation*

The March 26 Memo states that the Director may consider “[a]ny other consideration[] bearing on [her] discretion.” Ex. 2006 at 3. There are four patents at issue in the Parallel ITC Investigation (Ex. 2007) but Petitioner has only requested review of three of those patents (IPR2025-00724, IPR2025-00892, PGR2025-00048). Consequently, (1) the ITC is even more unlikely to issue a stay (if one were requested) since the proceedings before the PTAB would not completely resolve the validity issues and, relatedly, (2) the ITC will be tasked

with resolving validity issues related to the fourth patent regardless of whether the three trials are instituted.

V. CONCLUSION

It would be a highly inefficient waste of the limited resources of the Board and the parties to grant a weak petition for IPR, instituting a trial that would not be completed until well after the Parallel ITC Investigation has ended. Institution should be denied under 35 U.S.C. § 314(a), *Fintiv*, and the March 26 Memo.

Case No. IPR2025-00892
U.S. Patent No. 11,713,209

Date: July 18, 2025

Respectfully submitted,

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CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner Request for Discretionary Denial of *Inter Partes* Review totals 4,134 words as counted by Microsoft Word 2016, the word-processing system used to prepare this paper, which is less than the 14,000 words allowed under 37 C.F.R. §§ 42.24(a)(1)(i) and 42.24(b)(1), exclusive of caption page, the table of contents, the table of authorities, the certificates of service and of word count, and the table of exhibits.

Date: July 18, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a complete copy of the foregoing document was served on July 18, 2025 on counsel of record for the Petitioner via email to the following addresses:

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