

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUN PHARMACEUTICALS INDUSTRIES INC.,

Petitioner

v.

NIVAGEN PHARMACEUTICALS, INC.,

Patent Owner

IPR2025-00893

Patent No. 11,878,076

**PATENT OWNER'S BRIEF IN SUPPORT OF REQUEST FOR
DISCRETIONARY DENIAL**

LIST OF EXHIBITS

Exhibit	Description
Ex2001	<i>Nivagen, Inc. v. Sun Pharmaceuticals Industries, Inc.</i> , Civil Action No. 2:24-cv-36 (E.D. Tex.) (the “Nivagen lawsuit”), docket sheet (printed on July 18, 2025)
Ex2002	The Nivagen lawsuit, D.I. 37, Docket Control Order (scheduling order)
Ex2003	Sun’s May 8, 2025 Amended Invalidity Contentions served in the Nivagen lawsuit
Ex2004	The Nivagen lawsuit, D.I. 54, Joint Claim Construction and Prehearing Statement
Ex2005	Sun’s Fourth Set of Requests for Production served upon Nivagen in the Nivagen lawsuit
Ex2006	Sun’s Seventh Set of Interrogatories served upon Nivagen in the Nivagen lawsuit
Ex2007	Sun’s Sixth Set of Requests for Admissions served upon Nivagen in the Nivagen lawsuit
Ex2008	Sun’s Motion for Letter Rogatory to Nobelpharma in the Nivagen lawsuit
Ex2009	Nivagen’s third-party subpoena to Blank Rome LLP in the Nivagen lawsuit
Ex2010	Nivagen’s third-party subpoena to Curia Global in the Nivagen lawsuit
Ex2011	A collection of deposition notices in the Nivagen lawsuit
Ex2012	Collection of expert confidentiality undertakings by disclosed experts in the Nivagen lawsuit
Ex2013	An email chain regarding product sample production and the use of the information obtained from the samples in the Nivagen lawsuit

Ex2014	Eastern District of Texas Patent Rule 4-1 disclosures exchanged between the parties on April 10, 2025 (proposed claim terms for construction) in the Nivagen lawsuit
Ex2015	Eastern District of Texas Patent Rule 4-2 disclosures exchanged between the parties on May 1, 2025 (preliminary constructions and extrinsic evidence) in the Nivagen lawsuit
Ex2016	Eastern District of Texas P.R. 4-3(b) disclosure (Declaration of Alexander Klibanov, Ph.D.) served by Nivagen upon Sun on May 22, 2025 in the Nivagen lawsuit
Ex2017	A redacted version of Nivagen’s opening claim construction brief filed as D.I. 58 (June 9, 2025) in the Nivagen lawsuit
Ex2018	Sun Pharma’s third-party subpoena to Corbel Capital Partners, served in the Nivagen lawsuit
Ex2019	Emails among litigation counsel regarding a potential <i>Sotera</i> stipulation that includes “commercial embodiments”-based patent invalidity theories
Ex2020	Email chain dated June 3, 2025 among litigation counsel in the Nivagen lawsuit, regarding motion to stay, motion to dismiss or transfer venue, and the IPR Petition
Ex2021	Exhibit B-1 (“’608 Publication”) served by Sun to Nivagen as part of Sun’s May 8, 2025 Amended Invalidity Contentions disclosures, in the Nivagen lawsuit
Ex2022	Exhibit B-2 (“Nobelbar”) served by Sun to Nivagen as part of Sun’s May 8, 2025 Amended Invalidity Contentions disclosures, in the Nivagen lawsuit
Ex2023	Exhibit B-8 (“Hikma/DailyMed”) served by Sun to Nivagen as part of Sun’s May 8, 2025 Amended Invalidity Contentions disclosures, in the Nivagen lawsuit
Ex2024	Hikma/West-Ward press release, found at https://www.hikma.com/media/xybpzxvf/us-brand-launch-press-release-final-26-june-2018.pdf /

Ex2025	National Drug Code Directory search result for “0641-0476”, found at https://dps.fda.gov/ndc/searchresult?selection=finished_product&content=PRODUCTNDC&type=0641-0476
Ex2026	National Drug Code Directory search result for “0641-0477”, found at https://dps.fda.gov/ndc/searchresult?selection=finished_product&content=PRODUCTNDC&type=0641-0477
Ex2027	Sun’s October 22, 2024 Invalidity Contentions served in the Nivagen lawsuit
Ex2028	Declaration of Brent A. Batzer Esq.

TABLE OF CONTENTS

I.	SUMMARY OF REASONS TO DENY THE PETITION	1
II.	THE PARALLEL DISTRICT COURT LITIGATION.....	7
III.	INSTITUTION SHOULD BE DENIED UNDER 35 U.S.C. § 314(a).....	13
A.	The Parallel Litigation Will Not Be Stayed (<i>Fintiv</i> Factor 1).....	13
B.	Trial Is Scheduled to Begin Less Than Seven Months Away (<i>Fintiv</i> Factor 2).....	15
C.	The Court and the Parties Have Invested Substantially in the Parallel Litigation (<i>Fintiv</i> Factor 3).....	16
D.	The Patent Invalidity Issues Sun Raised in the Lawsuit and the Issues Presented in Sun’s IPR Petition Are Identical and Based on the Same Prior Art Disclosures (<i>Fintiv</i> Factor 4).....	17
1.	Sun Relies on the Same Prior Art References in the Lawsuit and in its Petition, and Makes the Same Arguments	17
a.	Ground 1: Sun relies on the same references, same disclosures, same combination, and same arguments in the Petition and the Nivagen lawsuit	18
b.	Ground 2 and Ground 3 are identical to the arguments Sun already made and still maintains in the parallel litigation.....	26
2.	Sun Seeks to Invalidate All Claims of the ’076 Patent in the Lawsuit and in Its Petition.....	28
3.	Sun Has Not Entered a <i>Sotera</i> Stipulation	28

E. Patent Owner and Petitioner Are the Same Parties to the Parallel Litigation (<i>Fintiv</i> Factor 5).....	29
F. Other Circumstances That Impact the Board’s Exercise of Discretion (<i>Fintiv</i> Factor 6).....	31
1. Sun’s Contradictory Claim Construction Positions Would Render the Board’s Decision on the Merits Redundant At Best	31
2. Sun’s Reserving “Commercial Embodiments” as Additional Prior Art in the Parallel Litigation Also Tends to Make the Board’s Decision on the Merits Redundant	32
IV. CONCLUSION	33

TABLE OF AUTHORITIES

Cases

<i>Immersion Sys. LLC v. Midas Green Techs., LLC</i> , IPR2021-01176, Paper 16 (Jan. 6, 2022)	16
<i>Lionra Technologies Ltd. v. Cisco Systems, Inc.</i> , 2025 WL 1239317 (E.D. Tx. April 29, 2025).....	14
<i>Realtime Data LLC v. Actian Corp.</i> , 2016 WL 9340796 (E.D. Tx. Nov. 29, 2016)	14
<i>Samsung Elecs. Co. v. Ancora Techs., Inc.</i> , IPR2020-01184, Paper 11 (Jan. 5, 2021)	16
<i>Toyota Motor Corp. v. Emerging Auto. LLC</i> , IPR2024-00785, Paper 13 (Mar. 11, 2025)	16

I. SUMMARY OF REASONS TO DENY THE PETITION

Sun Pharmaceutical Industries, Inc.’s (“Sun” or “Petitioner”) Petition for IPR is a wasteful and futile exercise. The Petition should be denied, which would allow the pending U.S. District Court case between the same two parties to proceed to a jury trial in February 2026 and decide exactly the same patent invalidity theories Sun slightly repackaged and presented again in its Petition.

First, the trial in the district court is less than seven months away. Not until page 69 of the Petition did Sun mention that “there is a trial date currently scheduled for February 2026” in an ongoing District Court lawsuit. Sun tried to downplay the significance of the upcoming trial date by stating, “Petitioner has filed a motion to dismiss or transfer to the District of New Jersey that is particularly strong.” (Paper 1, Petition at 69; Ex1048). Sun failed to point out that its motion to dismiss or transfer has been pending since June 27, 2024, more than a year ago, and Sun has filed a letter with the Court on June 18, 2025, more than one month ago, to urge a ruling on its long-dormant motion, but there is no indication that the court will rule on it before trial. (Ex2001, Nivagen lawsuit docket sheet, at D.I. 19 (motion brief), D.I. 61 (Sun’s letter to court regarding the motion); Ex1048 (which is D.I. 19 on the docket sheet, a redacted version of Sun’s Rule 12 motion paper filed under seal on June 27, 2024, D.I. 16)).

During the year since Sun filed its motion to dismiss or transfer venue, Nivagen Pharmaceuticals, Inc. (“Nivagen” or “Patent Owner”)¹ and Petitioner have been litigating according to a case schedule set in September 2024, and are now only less than three weeks from the end of fact discovery, three weeks from the Markman hearing, and less than seven months to trial. (Ex2002 (Nivagen lawsuit, D.I. 37, Docket Control Order (scheduling order), at 1 (jury selection to start on Feb. 17, 2026), 3 (deadline to complete fact discovery set for Aug. 8, 2025; Markman hearing on Aug. 14, 2025)). These deadlines in the case schedule have never been extended. (*Id.*). Furthermore, following its filing of the Petition, Sun never filed a motion to stay the litigation in the District Court. (*See generally* Ex2001 (no motion to stay filed as of July 18, 2025)).

Second, there is complete identity of issues in the parallel litigation and in Sun’s Petition. Sun’s arguments in its Petition are *completely subsumed* in Sun’s

¹ Patent Owner Nivagen Pharmaceuticals, Inc. is a pharmaceutical company based in Sacramento, California. The name “Nivagen, Inc.” shown in the caption of the parallel litigation was a typographical error, and does not refer to a different company from Patent Owner. Patent Owner has notified the District Court in its case filings the correct name of the company. (*See, e.g.* Ex2004 at 1 n. 1).

patent anticipation and obviousness contentions in the District Court proceedings.

In fact, after Sun filed the Petition, it amended the invalidity contentions in the parallel litigation to incorporate “all papers and exhibits filed in [the IPR] proceeding, including any prior art references and declarations.” (Ex2003 (Sun’s May 8, 2025 amended invalidity contentions), at 2 (internal pagination)). After that incorporation, nothing in Sun’s Petition, not even a single page of reference or a single line of argument, is left out of the parallel litigation.

Specifically, Ground 2 and Ground 3 of the Petition are anticipation and obviousness theories based on Ex1005 (U.S. Patent Application Publication No. 2021/0085608, i.e. the ’608 Publication, which is the publication of the application for an earlier patent in the same family as the challenged ’076 patent). Ex1005 is the same document known as “B-1” in Sun’s invalidity contentions served in the parallel litigation. (Ex2003 at 301 (internal pagination pin cites used for this Exhibit)). These same theories based on Ex1005 have been set forth in Sun’s invalidity contentions. (*See id.* at 301-02 (a table identifying Ex1005/B-1 as anticipating and rendering obvious all claims of the ’076 patent)).

Ground 2 and Ground 3 of the Petition are premised on a “lack of written description supporting an earlier priority date” argument, which is exactly the same as Sun contended in the parallel litigation. (*See* Ex2003 at 133-46, 301-03).

Ground 1 of the Petition is also a repackaging of identical obviousness theories set forth in Sun's invalidity contentions served in the parallel litigation, which rely on a combination of:

- (i) Ex1012 (known as "B-7" or "Parker" in Sun's invalidity contentions, Ex2003 at 302),
- (ii) disclosures regarding a liquid solution phenobarbital sodium product ("B-8" or "Hikma/DailyMed" in the litigation contentions, Ex2003 at 302; Ex2023) which encompasses the entirety of Ex1013 (referred to as "West-Ward" by Sun in the Petition, except that the "West-Ward" entity *is Hikma*, and the products described in "Hikma/DailyMed" are exactly the same as those described in "West-Ward" (*see* Ex2024, Ex2025, Ex2026)), and
- (iii) the same disclosures on the Nobelpharma product (a collection known as "B-2" or "Nobelbar" in the litigation, Ex2022, and Ex1009 of the Petition).

(Ex2003 at 304 (identifying a combination of Nobelbar, Parker, and Hikma/DailyMed as rendering obvious all claims of the '076 patent); Ex2022 (a claim chart based on a combination of various references disclosing "Nobelbar"))).

Patent Owner will explain in more detail in Part III.D (regarding *Fintiv* Factor 4), below, that for each of the Grounds Sun raised in the Petition, the same disclosures Sun relied upon were already included in its litigation contentions, and the same arguments were made.

Third, Sun’s litigation tactics have the practical effect of rendering the Board’s Final Written Decision merely advisory. Patent Owner wishes to bring to the Board’s attention two aspects of Sun’s litigation tactic that will result in a waste of the Board’s time and efforts, should the Board institute the IPR.

First, Sun’s claim construction positions in its Petition and in litigation are contradictory and irreconcilable. In its Petition, Sun advocates for “the broader plain and ordinary meaning in this proceeding” on all claim terms. (Petition at 13). To support the Petition, Sun’s expert declarant Dr. Suryanarayanan opined that, “[f]or purposes of addressing the anticipation and obviousness issues in this proceeding, the claim elements include straightforward language and are readily understandable according to their ordinary and customary meaning—without the need to inject specialized definitions or substitute terminology.” (Ex1015 at 37-38, ¶ 87). Accordingly, the Petition did not include any alternative patent invalidity arguments based on any *narrower* claim construction on the “composition” claim term found in all claims of the ’076 patent.

In stark contrast, Sun advocates during the parallel litigation the application of a clear and unmistakable disclaimer to narrow the plain and ordinary meaning of the “composition” term. (Ex2004 at 3).² Because Sun waited a full year after it had been sued to file its IPR Petition, a jury trial is now only seven months away, the lawsuit would have gone to trial and a likely appeal would have been fully briefed before the Board issues a Final Written Decision. This timing, coupled with Sun’s contradictory claim construction positions, would render the Board’s Decision merely advisory, resulting in a waste of the Board’s resources.

Second, for its patent obviousness theories in litigation, Sun “further identifies [as prior art] *the commercial embodiments* of the inventions described in Exhibits

² Sun filed its Responsive Claim Construction Brief on July 17, 2025, arguing for its “disclaimer” position, but the brief was filed under seal. (Ex2001 at D.I. 63). Sun is trying to have it both ways on claim construction. As Patent Owner mentioned above, Sun incorporated in its May 8, 2025 Amended Invalidity Contentions “all papers and exhibits, including declarations” from the IPR Petition, which include Dr. Suryanarayanan’s opinion that “the claim elements include straightforward language and are readily understandable according to their ordinary and customary meaning—without the need to inject specialized definitions or substitute terminology.” (Ex2003 at 2; Ex1015 at 37-38, ¶ 87).

B-1 to B-8” (Ex2003 at 302-03) (emphasis added). No doubt, this tactic is to guard against a Board finding that, based on the “PIF” (a Nobelpharma publication disclosing information about the Nobelbar product), “Parker,” and “DailyMed” (Hikma, i.e. West-Ward, liquid formulation product) disclosures, the claims of the ’076 patent are not obvious. Sun is positioning itself to argue the same patent obviousness arguments in litigation, albeit basing such arguments on “commercial embodiments” rather than publications regarding the same commercial products. If Sun is allowed to make these “commercial embodiments”-based arguments in the parallel litigation, this tactic could render superfluous a Board Decision upholding the challenged claims based on document evidence, because Sun would be making essentially the same arguments both in court and before the Board regardless of whether the Board institutes the IPR and what the Board’s decision will be. Sun’s tactic is plainly designed to “eat the cake and have it too.” Instead of achieving efficiency, it is designed for ensuring redundancy.

II. THE PARALLEL DISTRICT COURT LITIGATION

Nivagen sued Sun for patent infringement on January 23, 2024. (Ex2001 at D.I. 1). Sun was served the Summons on April 22, 2024, one year to the date before Sun filed its Petition. (*Id.* at D.I. 9). Originally, a number of defendants related to Sun were also sued, but they were dismissed from the lawsuit by party agreement. (*Id.* at D.I. 14).

Sun filed a motion to transfer venue on June 27, 2024. (*Id.* at 16; *see also* Ex1048 (redacted motion paper, D.I. 19)). Sun argued that it “does not reside in this district” and the case should be either dismissed or transferred to the District of New Jersey. (Ex1048 at page 0 (Statement of the Issues to Be Decided by the Court)). Nivagen opposed Sun’s motion. (Ex2001 at D.I. 21). The briefing on the motion was concluded on July 26, 2024, about a year ago. (*Id.* at D.I. 30). Contrary to Sun’s characterization of its Rule 12 motion as “particularly strong,” (Petition at 69), a characterization with which Patent Owner completely disagrees, the fact remains that, after Sun filed its motion, the court held an in-person scheduling conference on September 10, 2024, and issued the Docket Control Order on September 27, 2024, without commenting or ruling on the motion. (Ex2001 at the Sep. 10, 2024 Minute Entry (conference), D.I. 37; Ex2002). After litigating the case for more than a year, and after it filed the Petition stating to the Board that its Rule 12 motion “is particularly strong,” Sun finally filed a letter on June 18, 2025 urging the court to rule on the pending motion to dismiss, but the court has not decided the motion, set a hearing, or responded to Sun’s letter request in any other way. (*See* Ex2001 at D.I. 61 *et seq.*).

Patent Owner and Petitioner have been litigating according to the case schedule set forth in the Docket Control Order. The Docket Control Order has never been modified, except that the parties moved to extend the deadline for exchanging

privilege logs, which the court granted. (Ex2001 at D.I. 47). Disclosures and contentions have been timely exchanged and repeatedly supplemented. Petitioner has amended its invalidity contentions twice. The May 8, 2025 version of the invalidity contentions totals 328 pages, although some of it is directed to a patent that is no longer in the case. (Ex2003 at 3 (table listing two patents); Ex2001 at D.I. 45 (dismissal of counts directed to U.S. Patent No. 11,406,598)). The parties served upon each other numerous discovery requests, and responded to them. Petitioner in particular served upon Patent Owner four sets of Requests for Production of Documents, seven sets of Interrogatories, and six sets of Requests for Admissions. (Ex2005, Ex2006, Ex2007).

Pursuant to the document requests and the District's local rules, the parties have produced more than 500,000 pages of documents and numerous additional files in native format by the document production deadline of April 3, 2025, weeks before the filing of the Petition. (Ex2028 (Batzner Declaration) at ¶ 32). The parties also exchanged nearly 700 pages of privilege logs. (*Id.* at ¶ 33). There have been disputes on fact discovery, which were resolved or are in the process of being resolved. (*See, e.g.* Ex2001 at D.I. 62 (Sun's motion to compel discovery), July 8, 2025 entry (NOTICE of Hearing on Motion)). Both parties have also engaged in third-party discovery, and have obtained more than 10,500 pages of documents from third parties. (Ex2008 (Sun's Letter Rogatory to Nobelpharma), Ex2009 (Nivagen's

subpoena to Blank Rome LLP), Ex2010 (Nivagen's subpoena to Curia Global), Ex2018 (Sun's subpoena to Corbel Capital Partners)). More than ten F.R.Civ.P. 30(b)(1) fact witness depositions as well as F.R.Civ.P. 30(b)(6) depositions on numerous topics have been noticed or are being arranged. (Ex2011 (deposition notices)).

The parties have retained multiple experts and started expert discovery in the litigation. (Ex2012 (experts' signed undertakings for the Protective Order)). Nivagen has obtained samples of the accused product from both Sun (after a lengthy negotiation among litigation counsel) and other sources, and conducted testing on the samples as part of the litigation. (See Ex2013 (email regarding sample production and a negotiation on the use of the information obtained from the samples)). The opening expert reports are due on September 5, 2025, six weeks away. (Ex2002 at 3). All expert discovery in the lawsuit must be completed by October 24, 2025, which is before an Institution Decision for this IPR Petition is expected to issue. (*Id.*).

Pursuant to the Eastern District of Texas's local patent rules, the parties have made several rounds of disclosures regarding claim construction. (Ex2014 (P.R. 4-1 exchanges of proposed claim terms); Ex2015 (P.R. 4-2 exchange of preliminary claim constructions and extrinsic evidence); Ex2004 (Joint Claim Construction and Prehearing Statement)); Ex2016 (Declaration of Dr. Alexander Klibanov)). Patent

Owner filed its opening claim construction brief on June 2, 2025, relying in part on an expert declaration by Dr. Alexander Klibanov. (Ex2001, D.I. 56; Ex2017 (redacted opening claim construction brief filed on the public docket)). Sun filed its responsive claim construction brief on July 17, 2025. (Ex2001, D.I. 63). As noted above in Part I, Sun’s claim construction position in the litigation is that the term “composition” found in all claims of the ’076 patent should *not* be accorded its ordinary and customary meaning, which is totally at odds with Sun’s position and Dr. Suryanarayanan’s opinion presented in the Petition. (See Petition at 13; Ex1015 at 37-38, ¶ 87). Patent Owner will be filing a reply claim construction brief on July 24, 2025 pursuant to the case schedule, and then compile and file a Joint Claim Construction Chart by July 31, 2025. (Ex2002 at 3). An in-person Markman hearing will be held in Marshall, Texas on the morning of August 14, 2025, a few weeks from now. (*Id.*).

Both Patent Owner and Petitioner will be serving expert reports on infringement, invalidity, and damages issues in the litigation, starting on September 5, 2025. (*Id.*). Expert depositions will be concluded by October 24, 2025. (*Id.*). The parties will file any dispositive motions by November 12, 2025, and then engage in pretrial activities. (*Id.* at 2-3). A Pretrial Conference will be held in Marshall, Texas on January 15, 2026, less than 6 months from now. (*Id.* at 1). The trial in the lawsuit will begin with jury selection on February 17, 2026.

Petitioner filed its last-minute Petition on April 22, 2025, precisely one year after it was served with the lawsuit, and in the middle of fact discovery and claim construction activities in the parallel litigation. (Ex2001 at D.I. 9 (service of process on April 22, 2024)). Following the filing of the Petition, the parties continued their active discovery and claim construction efforts without any changes in the case schedule. As of this filing, the court has not ruled on Sun’s pending motion to dismiss or transfer venue. (*See* Ex2001, D.I. 61 *et seq.*). Petitioner has not filed a *Sotera* stipulation in the parallel litigation. (*See generally* Ex2001).³ Petitioner has

³ Sun’s counsel wrote to Nivagen’s counsel on June 18, 2025 that Sun “will agree to a *Sotera* stipulation should the PTAB institute its IPR against the ’076 patent.” (Ex2019). However, Nivagen’s counsel pointed out that a promise to file a stipulation *after* the Institution Decision is not effective. (*Id.*). According to the March 24, 2025 PTAB memorandum, the Board will only consider “a timely-filed *Sotera* stipulation” “as part of its holistic analysis under *Fintiv*.” (Guidance Guidance on USPTO’s recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” at 2-3). Nivagen’s counsel further pointed out that any *Sotera* stipulation filed in the parallel litigation that does not address Sun’s reservation of rights regarding using

not moved to stay the litigation based on its filing of the IPR Petition or for any other reason. (*Id.*). There is no indication that the court would move the trial date set for February 17, 2026.

III. INSTITUTION SHOULD BE DENIED UNDER 35 U.S.C. § 314(a)

A. The Parallel Litigation Will Not Be Stayed (*Fintiv* Factor 1)

The parallel litigation will not be stayed. This factor therefore favors denial of institution. Any suggestion by Petitioner to the contrary would be speculative at best, and completely without factual basis. The trial date in the parallel litigation was set for February 17, 2026, less than seven months away. (Ex2002 at 1). This trial date has never been changed, and neither party to the parallel litigation has ever filed a motion or an informal request to change the trial date. (*See* Ex2001). In the Eastern District of Texas where the parallel litigation is, a motion to stay the litigation is routinely denied when the motion is based on an IPR petition filing but the trial date is only several months away. *See Lionra Technologies Ltd. v. Cisco*

“commercial embodiments” to advance the same patent obviousness defenses would not achieve efficiency, but only ensure redundancy. (Ex2019).

Systems, Inc., 2025 WL 1239317 at *2 (E.D. Tx. April 29, 2025) (denying a motion to stay when “the PTAB’s final written decision, which could be subject to further appeals, is not due until a date more than five months after the jury trial is set to begin. Such a delay would prejudice Plaintiff’s ability to vindicate its patent rights.”); *Realtime Data LLC v. Actian Corp.*, 2016 WL 9340796 at *3 (E.D. Tx. Nov. 29, 2016) (denying a motion to stay because “[s]taying this litigation in order to wait for an IPR decision that is not due until months *after* trial has already taken place would prejudice Plaintiff.”) (emphasis in the original).

Patent Owner does not intend to request a stay or postponement of trial in the parallel litigation. Patent Owner chose the forum for the lawsuit, agreed to a case schedule, and has been diligently litigating toward a jury trial in just a few months’ time. As discussed below in Part III.D, all Grounds in Sun’s IPR Petition present prior art disclosures and arguments identical to Sun’s main patent invalidity defenses in the parallel litigation. A jury trial in the parallel litigation will decide all issues Sun presented in its IPR Petition, in addition to other types of patent invalidity defenses and issues of infringement and damages calculation, at least several months before the Board issues a Final Written Description in the event that the Board institutes Sun’s redundant IPR Petition.

**B. Trial Is Scheduled to Begin Less Than Seven Months Away
(*Fintiv* Factor 2)**

As discussed above, a trial in the parallel litigation is scheduled to begin with jury selection on February 17, 2026. There is no indication from the court that the trial schedule would be stayed or postponed, and neither party has moved for any changes to the case schedule. By the time an Institution Decision would be issued in late November pursuant to 35 U.S.C. § 314(b) and in view of the August 23, 2025 deadline for Patent Owner's Preliminary Response, (Paper 6 at 1), the parties would have completed expert discovery, filed any dispositive motions, and started pretrial activities, with jury selection less than three months away. (Ex2002 at 1 (trial starts on Feb. 17, 2026), 3 (dispositive motion deadline on Nov. 12, 2025, and deadline to complete expert discovery on Oct. 24, 2025)). Given the timing, it is not likely that the trial date would be moved. This factor therefore weighs squarely in favor of Patent Owner.

If Sun's Petition is instituted in November 2025, a Final Written Decision would be expected in November 2026 pursuant to 35 U.S.C. § 316(a)(11), nine months after a jury verdict is likely to have been reached in the parallel litigation. If the losing party at trial appeals the jury verdict, by the time the Final Written Decision is issued, the appeal would be halfway over. Therefore, this factor weighs heavily in favor of the Board's denial of institution of Sun's Petition. The Board has denied institution in view of similar or even smaller gaps between trial and final

written decisions. *Toyota Motor Corp. v. Emerging Auto. LLC*, IPR2024-00785, Paper 13 at 13 (P.T.A.B. Mar. 11, 2025) (“Factor 2 weighs *heavily* in favor of discretionary denial” when the trial is scheduled for “approximately eight months before the Board would issue its Final Decision”) (emphasis added); *Samsung Elecs. Co. v. Ancora Techs., Inc.*, IPR2020-01184, Paper 11 at 15 (P.T.A.B. Jan. 5, 2021) (“Because the currently scheduled District Court trial is scheduled to begin eight and a half months before our deadline to reach a final decision, we find that [factor 2] weighs in favor of exercising our discretion to deny institution under § 314(a).”); *Immersion Sys. LLC v. Midas Green Techs., LLC*, IPR2021-01176, Paper 16 at 12-13 (P.T.A.B. Jan. 6, 2022) (factor 2 weighs in favor of denial of institution when the trial was scheduled for approximately three months before the due date for the final written decision).

C. The Court and the Parties Have Invested Substantially in the Parallel Litigation (*Fintiv* Factor 3)

At the outset of the parallel litigation, Sun filed a motion to dismiss or transfer venue. (Ex2001 at D.I. 16; *see also* Ex1048 (redacted motion paper)). The motion was fully briefed. (Ex2001 at D.I. 21, D.I. 30).

The court then held a scheduling conference in September 2024, and set a case schedule that was 17 months to trial. (Ex2001 at the September 10, 2024 Minute Entry; Ex2002). Since then, the litigation has progressed for more than 10 months, and we are now less than 7 months to trial. (Ex2002). The parties have engaged in

fact discovery including serving and responding to multiple sets of interrogatories and requests for admission, exchanging numerous letters and emails disputing the sufficiency of these responses and other issues, serving infringement and invalidity contentions amounting to hundreds of pages, collecting, reviewing, and producing documents amounting to more than 500,000 pages, exchanging nearly 700 pages of privilege logs, obtaining more than 10,500 pages of documents through third-party discovery, arranging multiple Rule 30(b)(1) and Rule 30(b)(6) depositions, filing claim construction briefs, preparing for the upcoming Markman hearing, and working with various expert witnesses for the case. (*See* Ex2003-Ex2018, Ex2027-Ex2028).

The parties are now three weeks away from the close of fact discovery in the parallel litigation. (Ex2002 at 3). Claim construction briefing will be completed this week, and the court will hold a Markman hearing on August 14, 2025. (*Id.*). The opening expert reports are due to be served on September 5, 2025. (*Id.*). The parties are working diligently to meet these deadlines.

This factor therefore weighs heavily in favor of Patent Owner.

D. The Patent Invalidity Issues Sun Raised in the Lawsuit and the Issues Presented in Sun’s IPR Petition Are Identical and Based on the Same Prior Art Disclosures (*Fintiv* Factor 4)

1. Sun Relies on the Same Prior Art References in the Lawsuit and in its Petition, and Makes the Same Arguments

a. Ground 1: Sun relies on the same references, same disclosures, same combination, and same arguments in the Petition and the Nivagen lawsuit

Petitioner relied on the same references. For Ground 1, Petitioner relies on three references that are all included in its May 8, 2025 Amended Invalidity Contentions served in the parallel litigation. All three references (PIF, Parker, West-Ward) were in those contentions in exactly the same form. (Ex2003 at 110, 146-47). The PIF and West-Ward references were *also* redundant with numerous other references in those contentions, as shown in detail below.

References for Ground 1 of the Petition	References in Sun’s Invalidity Contentions in the Parallel Litigation
“PIF” (Ex1008 (Japanese language), Ex1009 (English translation)), which is a “Pharmaceutical Interview Form” found on Nobelpharma Co.’s web site regarding a	• Ex2003 at 146 (the same “PIF” reference); • Ex2003 at 83 (“Deliberation Results Report” disclosing the same Nobelbar® product approved and marketed in Japan and described in PIF), 101 (“Kawada 2009” disclosing the same Nobelbar® product), 103 (“Kawada 2011” disclosing Nobelbar clinical trial), 109 (“Nobelbar Label” for the same product);

“Nobelbar®” product in Japan (Ex1011)	• Ex.2022 (Exhibit B-2 to Sun’s Amended Invalidity Contentions), at 1 (characterizing the Deliberation Results Report, Kawada 2009, Kawada 2011, and Nobelbar Label references, collectively, as “documents describing aspects of Nobelbar,” and referring to these four references collectively as “Nobelbar”); • The Nobelbar® <i>commercial product</i> itself (Ex2003 at 302 (“Sun further identifies the commercial embodiments of the inventions described in Exhibits B-1 to B-8” as prior art))
“Parker” (Ex1012)	• Ex2003 at 110 (U.S. Patent Application Publication No. US 2017/0143719 (“Parker”), same as Ex1012)
“West-Ward” (Ex1013) (on page 1/11: National Drug Codes or NDC	• Ex2003 at 147 (“<i>Label: PHENOBARBITAL SODIUM – phenobarbital sodium injection,</i>

Codes for the West-Ward product shown as: 0641-0476-21 and -25; 0641-0477-21 and -25)	DAILYMED (updated August 2011),” same as Ex1013); • Ex2003 at 65 (“Hikma” disclosing Hikma phenobarbital sodium injection product with 65 mg/mL and 130 mg/mL strengths – which <i>is</i> the “West-Ward” product, as discussed below regarding Ex2023 through Ex2026); • Ex2023 (Sun’s Amended Invalidity Contentions Exhibit B-8, a claim chart identifying purportedly patent-invalidating disclosures from the Hikma reference), showing NDC codes 0641-0476-25 and 0641-0477-25 for the Hikma product, which are the same codes for the “West-Ward” product in Ex1013;⁴
---	---

⁴ West-Ward Pharmaceuticals Corp. became part of the Hikma Group decades ago. (Ex2024). A search in the National Drug Code Directory maintained by the FDA for the NDC Codes shown in Ex1013 (“West-Ward”) resulted in phenobarbital sodium 65 mg/mL (Ex2025, search result for 0641-0476) and 130 mg/mL (Ex2026,

	• The Hikma (i.e. West-Ward) commercial product itself (Ex2003 at 302 (“Sun further identifies the commercial embodiments of the inventions described in Exhibits B-1 to B-8” as prior art))
--	--

Petitioner pointed to the same disclosures from the Nobelbar/PIF, Parker, and West-Ward/Hikma references. Petitioner provides a summary of the relevant disclosures from the PIF, Parker, and West-Ward references. (Petition at 13-15, Part VIII.A, B, and C). Petitioner pin cites for support the Declaration of Raj Suryanarayanan, Ph.D. submitted in support of the Petition. (*Id.* (citing Ex1015 ¶¶ 89-90, 93-94, 97, 102)). A comparison of the disclosures as summarized by the Petition and Dr. Suryanarayanan, on one hand, and the disclosures deemed relevant

search result for 0641-0477) injection products by Hikma Pharmaceuticals USA Inc. The NDC Directory explains that, for each code, the -21 suffix as shown in Ex1013 (West-Ward) means “1 vial” and the -25 suffix means “1 carton” containing 25 vials. (Ex2025, Ex2026). Therefore, any difference in the suffixes of the NDC codes pertains to only how the product is packaged, and not the product itself.

by Sun during the parallel litigation, on the other hand, makes it clear that Sun is relying on the same disclosures from the same or equivalent (and redundant) references.

First, regarding PIF (Ex1008/1009) vs. Nobelbar (Exhibit B-2 in the parallel litigation), in its Petition, Sun relies on the PIF reference as disclosing “a lyophilized injection composed of [274 mg per vial of] phenobarbital sodium only, without additives.” (Petition at 14). Petitioner also cited to paragraph 97 of the Suryanarayanan Declaration for support on this point, which includes statements that “Nobelbar was Japan’s first intravenous phenobarbital preparation approved for neonatal convulsions and status epilepticus,” and phenobarbital can “gradually decompos[e] when exposed to moist air.” (Petition at 14 (citing Ex1015 at ¶ 97)).

During the parallel litigation, Petitioner referred to the same PIF reference as prior art to the ’076 patent. (Ex2003 at 146-47). However, Petitioner avoided using PIF as part of a “Nobelbar” collection it used for prior art combination. (See Ex2022 at face page (“Nobelbar” is an amalgam of Deliberation Results Report, Kawada 2009, Kawada 2011, and Nobelbar Label, but not PIF); Ex2003 at 301-11 (obviousness combinations including “Nobelbar” but *not* the PIF reference)). Nevertheless, Sun pointed to the same disclosures from the Nobelbar collection in its Invalidity Contentions as it does in the Petition. Sun summarized the Nobelbar references as disclosing the lyophilized 274-mg per vial phenobarbital sodium

product in Japan with “no additives.” (Ex2003 at 84, 101-03, 109). Sun pointed to disclosures in its “Nobelbar” collection the use of the Nobelbar® product for treating neonatal convulsion and status epilepticus. (*Id.* at 84, 103-04). Sun also pointed to disclosures regarding phenobarbital sodium’s solubility and stability. (*Id.* at 84 (phenobarbital sodium “is hygroscopic and can change forms at relative humidity of 68% or higher”), 103 (“instability of phenobarbital sodium in water”)).

These disclosures regarding the availability of a lyophilized phenobarbital sodium product in Japan, its “no additives” feature, its use in particular groups of patients, and its instability on exposure to high humidity, which are presented by Sun in both the Petition here and the parallel litigation in the Eastern District of Texas, are summarized and organized in Exhibit B-2 to Sun’s May 8, 2025 Invalidity Contentions in the parallel litigation regarding the Nobelbar collection. (Ex2022, throughout).

Second, Sun also relies on Parker, Ex1012, in both Sun’s IPR Petition and the parallel litigation. In the Petition, Sun described Parker as disclosing “a stable formulation of phenobarbital sodium injection that minimizes impurity formation during extended storage.” (Petition at 14 (citing Ex1015 at ¶ 102)). According to the Petition, Parker disclosed potential hydrolysis products of phenobarbital sodium, “such as PEAU, 2EPMM, and PBG.” (*Id.*). Dr. Suryanarayanan made the same observation regarding the disclosures of stability and impurities in Parker, and

further opined that the Parker liquid solution formulation “relies on a minimal amount of water and includes a C1-C4 alcohol (e.g. ethanol) and propylene glycol to stabilize the active ingredient and substantially reduce impurity formation.” (Ex1015 at ¶ 102).

Sun’s description of Parker (Ex1012) during the parallel litigation is exactly the same as the above. (Ex2003 at 110-12). According to Sun’s description in its May 8, 2025 Invalidity Contentions, Parker disclosed phenobarbital sodium hydrolysis and the potential degradation products including PEAU, 2EPM, and PBG. (*Id.* at 110). To solve the hydrolysis/degradation problem, Parker disclosed a liquid formulation that is “extremely stable” by adding a C1-C4 alcohol and propylene glycol to the formulation. (*Id.* at 111). Sun further noted that the Parker formulation can have low levels of impurities after two years storage, “demonstrating its stability over time.” (*Id.*).

Third, Sun relies on a “West-Ward” reference (Ex1013) in its Petition, and describes it as “disclos[ing] commercially available products of ‘Phenobarbital Sodium Injection, USP,’ sold in dosages of 65 mg/mL and 130 mg/mL in a 1 mL vial.” (Petition at 15). Dr. Suryanarayanan offered the exact same description of what West-Ward disclosed in his declaration. (Ex1015 at ¶ 103).

During the parallel litigation, Sun disclosed the Material Safety Data Sheet for the same product, and called it “West-Ward.” (Ex2003 at 129-30). However,

the “West-Ward” reference in the parallel litigation is not the same “West-Ward” (Ex1013) Sun uses for the Petition. Instead, Sun disclosed a “DailyMed” reference in the parallel litigation, which *is* the West-Ward reference in the Petition. (Ex2003 at 147; *Cf* Ex1013 (same URL, same title)). According to Sun, DailyMed “discloses that ‘Phenobarbital Sodium Injection, USP’ was available in concentrations of 65 mg/mL and 130 mg/mL in 1 mL vials,” which is exactly the same disclosures from Ex1013 Petitioner Sun is relying on.

Furthermore, Sun disclosed a “Hikma” reference in the parallel litigation, which is a 2018 product catalog. (Ex2003 at 93). As explained in footnote 4, above, the Hikma phenobarbital sodium injection products in 65 mg/mL and 130 mg/mL strengths *are* the same West-Ward products. They share the same NDC codes. In the parallel litigation, Sun combined the “Hikma” and “DailyMed” references into “Hikma/DailyMed” and referred to them collectively as “B-8.” (Ex2003 at 302; Ex2023). Sun summarized “Hikma” as “disclosing concentrations of ‘Phenobarbital Sodium Injection, USP C-IV’ available at 65 mg/mL and 130 mg/mL with a 1 mL fill volume.” (Ex2003 at 93). Again, this is exactly the same disclosure Sun is using for the Petition.

Petitioner proposed the same prior art combination. For Ground 1, Petitioner relies on PIF as the primary prior art reference, in combination with Parker and West-Ward, in its attempt to invalidate claims 1-20 of the ’076 patent. (Petition

at 13). Petitioner has done exactly the same thing before. In the parallel litigation, Sun contended that the “Nobelbar” collection (i.e. the same disclosures as PIF Ex1008/Ex1009) serves as the primary prior art reference, which, in combination with (i) Parker alone, (ii) Hikma/DailyMed (i.e. West-Ward Ex1013) alone, or (iii) Parker and Hikma/DailyMed, would invalidate claims 1-20 of the ’076 patent. (Ex2003 at 304). The Nobelbar, Parker, Hikma/DailyMed combination is exactly the same as in Ground 1 of the Petition.

Sun placed particular emphasis and importance to the Nobelbar/Parker/West-Ward prior art combination during the parallel litigation. Sun first relied on the ’608 Publication (same as Ex1005 in the Petition). (Ex2003 at 303). This is similar to Grounds 2 and 3 in the Petition, which will be discussed in detail below. Then, Sun used Nobelbar as the primary reference, and the top three combinations based on Nobelbar all involve Parker and/or Hikma/DailyMed. (*Id.* at 304). Therefore, not only are the same prior art combinations from Ground 1 found in Sun’s Amended Invalidity Contentions, these combinations feature prominently in the parallel litigation. There is no difference between Sun’s position in the litigation and its approach in the Petition.

b. Ground 2 and Ground 3 are identical to the arguments Sun already made and still maintains in the parallel litigation

Grounds 2 and 3 of the Petition are based on the '608 Publication⁵ and came straight out of Sun's Amended Invalidity Contentions served in the parallel litigation. Grounds 2 and 3 started with the argument that the first patent application and the preceding provisional application in the chain of priority documents did not disclose the "full scope" of the claimed subject matter in the '076 patent. (Petition at 39-53, 65). The "full scope," according to Petitioner, includes both crystalline and amorphous material, and compositions both with and without organic solvents. (*Id.* at 42-49). Petitioner alleged that, due to the lack of full scope written description in the earlier priority documents, the publication of the first patent application (i.e. the '608 Publication) became prior art to the challenged '076 patent claims, and anticipates or at least renders obvious all claims of the '076 patent. (*Id.* at 53-67).

Sun made exactly the same arguments in the parallel litigation, and is maintaining these arguments. Sun served its second Amended Invalidity Contentions on May 8, 2025, *after* it filed the Petition with the Board, in which it maintains that the priority date of the '076 patent is in 2022, and not 2019, because the 2020-filed original application or the 2019-filed provisional application did not disclose the "full scope" of the '076 patent claims, which, again, Sun contends

⁵ Ex1005, the publication of a U.S. patent application that matured into U.S. Patent No. 11,406,598, a grandparent patent to the '076 patent.

should include both crystalline and amorphous material, and compositions both with and without organic solvents. (Ex2003 at 53-55). Therefore, Sun argued in the parallel litigation that the '608 Publication is prior art to the '076 patent and renders "claims 1-20 of the '076 Patent obvious ... and invalid as anticipated under 35 U.S.C. § 102." (Ex2003 at 316; *see also id.* at 301 (Table); Ex2021 (claim chart for Exhibit B-1, which is the '608 Publication)).

2. Sun Seeks to Invalidate All Claims of the '076 Patent in the Lawsuit and in Its Petition

There is a complete overlap of the claims Sun seeks to invalidate with an IPR proceeding and in court. This generates an additional layer of redundancy. Sun seeks to invalidate all 20 claims of the '076 patent in each of the three grounds it alleges. (Petition at 1-3). Identically, Sun seeks to invalidate all 20 claims with either a combination of Nobelbar, Parker, and Hikma/DailyMed, or the '608 Publication, in the parallel litigation. (Ex2003 at 304, 316).

3. Sun Has Not Entered a *Sotera* Stipulation

Once Sun filed its Petition, Nivagen's counsel wrote to Sun's counsel in the parallel litigation (who are the same counsel for Petitioner in this Board proceeding) whether Sun would enter a *Sotera* stipulation in the parallel litigation, thereby mitigating the redundancy and waste for both proceedings to go forward in parallel. (Ex2019). Sun's counsel responded that it would "evaluate your question in due course." (*Id.*). On June 18, 2025, instead of sending a draft of such a stipulation,

Sun’s counsel sent an email stating that Sun “will agree to a Sotera stipulation should the PTAB institute its IPR against the ’076 patent.” (*Id.*). However, Nivagen’s counsel pointed out that such a stipulation *after* the Institution Decision is not effective under the current Board guideline. (*Id.*). Nivagen’s counsel further pointed out that any *Sotera* stipulation that left open the loophole of later using “commercial embodiments” in the litigation to advance the same patent obviousness defenses as those presented in Sun’s Petition would not achieve efficiency, but only ensure redundancy. (*Id.*). No *Sotera* stipulation has been filed in the parallel litigation. (*See* Ex2001 (no *Sotera* stipulation filed)).

Because Petitioner is using the same prior art references and prior art combination, relying on the same disclosures from each piece of prior art and presenting the same analysis, and seeking to preserve redundancy (e.g. making redundant arguments based on “commercial embodiments”) rather than achieving efficiency by removing any duplicative arguments between the IPR Petition and the parallel litigation, Factor 4 regarding similarity, or in this case, identity, of the issues weighs squarely in favor of Patent Owner.

E. Patent Owner and Petitioner Are the Same Parties to the Parallel Litigation (*Fintiv* Factor 5)

Not only are the same two pharmaceutical companies (Nivagen and Sun) parties to the parallel litigation and this Board proceeding, the parties are represented

by the same counsel in both proceedings. (*See, e.g.*, Ex2019 (email among litigation counsel, who are the same counsel in this Board proceeding)). Sun is also relying on the same technical expert in both the litigation and the Board proceedings, namely, Dr. Suryanarayanan. (Ex2012 (Dr. Suryanarayanan disclosed as expert for the parallel litigation); Ex2015 (Sun disclosing Dr. Suryanarayanan as an expert for claim construction in the parallel litigation); Ex1015). This factor therefore weighs squarely in favor of Patent Owner.

Petitioner's actions suggest that it is treating its Petition as a "dry run" of sorts to test out its patent anticipation and obviousness theories for the upcoming jury trial. Petitioner waited a full year after it was served the parallel litigation before filing the Petition on April 22, 2025. (*See* Ex2001 at D.I. 9). Petitioner waited until the last day it could file the Petition to do so, even though Petitioner had already formulated the same patent invalidity theories it eventually presented to the Board ***back in October 2024, or even earlier.*** (Ex2027 (Sun's Oct. 22, 2024 Invalidity Contentions served in the parallel litigation), at 294 (setting forth the same '608 publication-based patent anticipation and obviousness theory as Grounds 2 and 3 of the Petition), 296 (identifying the same "Nobelbar/Parker/Hikma" combination as Ground 1 of the Petition)). The delay in the filing of the Petition means that the court is much less likely to stay the case or move the trial date because of the IPR filing. Therefore, this case presents a clear-cut example of a Petitioner designing and timing its Petition

to be redundant to the parallel litigation. By the time the Board is expected to issue its Final Written Decision in this case, the jury trial at the district court would have been completed months ago, and any appeal process by the losing party would be well underway. All issues presented in the Petition would have been decided, and the jury verdict and any Federal Circuit decision from the parallel litigation would be controlling over a Board Decision.

F. Other Circumstances That Impact the Board’s Exercise of Discretion (*Fintiv* Factor 6)

1. Sun’s Contradictory Claim Construction Positions Would Render the Board’s Decision on the Merits Redundant At Best

As noted above, Sun is currently and simultaneously taking contradictory claim construction positions in the parallel litigation and in its Petition. Both Sun and its expert declarant advocate for “the broader plain and ordinary meaning in this proceeding” on all claim terms before the Board, “[f]or purposes of addressing the anticipation and obviousness issues.” (Petition at 13; Ex1015 at 37-38). To help with its noninfringement arguments, on the other hand, Sun urges the District Court to find that a clear and unmistakable disclaimer applies to narrow the meaning of the claim term “composition.” (Ex2004 at 3). “Composition” is the only disputed claim term for the ’076 patent in the parallel litigation. (*Id.*).

After the court holds a Markman hearing in August 2025 and decides on the claim construction, a jury will apply the court’s construction in February 2026 and

rule on the same issues Sun is petitioning the Board to decide, namely anticipation and obviousness based on the '608 Publication, and obviousness based on a combination of the Nobelbar, Parker, and Hikma/West-Ward disclosures. The jury verdict and the ensuing appeal on the claim construction and the patent invalidity issues would render the Board's findings in a Final Written Decision redundant at best (when the claim construction from the parallel litigation is the same as Sun takes before the Board here), and overruled at worst (should Sun gets its wish in the parallel litigation, and the claim construction for the jury's decision and on appeal is a narrow one, different from the claim construction position Sun is taking before the Board).

2. Sun's Reserving "Commercial Embodiments" as Additional Prior Art in the Parallel Litigation Also Tends to Make the Board's Decision on the Merits Redundant

Sun stated in its May 8, 2025 Amended Invalidity Contentions that "Sun further identifies the commercial embodiments of the inventions described in Exhibits B-1 to B-8" as prior art. (Ex2003 at 302). As discussed above, these Exhibits in Sun's Invalidity Contentions disclose aspects of the Nobelbar® and Hikma/West-Ward products. For emphasis, Sun further specifically identified the Nobelbar® commercial product as a prior art to the '076 patent. (*Id.* at 303). Sun did not explain what information from the Nobelbar and Hikma/West-Ward commercial products is relevant to its patent anticipation and obviousness theories

but cannot be found in the document prior art references “Exhibits B-1 to B-8” or their equivalents (i.e. Ex1008/Ex1009, Ex1013) discussed in the May 8, 2025 Amended Invalidity Contentions and in the Petition.

Sun’s using “commercial embodiments” as a separate basis for the same patent anticipation and obviousness theories is apparently designed to guard against a loss on the merits before the Board. Sun may also be considering entering a *Sotera* stipulation after the Board’s Institution Decision, which it has not done so far, but Sun will not include “commercial embodiments”-based patent invalidity theories in any such stipulation. (*See* Ex2019). This way, Sun hopes to be able to advance the same defenses in the parallel litigation after the Board institutes the Petition, or even after the Board issues a Final Written Decision against it. Sun’s attempt at splitting references disclosing a product from the product itself demonstrates that Sun is treating the IPR proceeding as merely a sounding board for the litigation, or an insurance policy at best. Sun’s Petition is designed to be redundant with the parallel litigation, to generate advisory opinions by the Board.

IV. CONCLUSION

The *Fintiv* factors overwhelmingly favor a discretionary denial of Sun’s Petition. There is no evidence whatsoever that the District Court will stay the parallel litigation. The same parties involved in this IPR proceeding are actively litigating in court and preparing for the trial that is less than seven months away.

The parties have already expended tremendous amount of time and energy in the parallel litigation. Most important, Sun’s Petition is designed to be duplicative of its arguments in the parallel litigation. Sun had those prior art references at least by October of 2024, and articulated the same prior art combination and arguments months before it filed the Petition. The duplication is by design—Sun clearly wants to make the same arguments both in court and before the Board. In sum, “the efficiency and integrity of the system are best served by denying review” of Sun’s Petition. *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 4 (P.T.A.B. Mar. 28, 2025).

For the foregoing reasons, Patent Owner respectfully requests that the Board exercise its discretion to deny Sun’s Petition in its entirety.

Respectfully Submitted,

Dated: 18 July 2025

/s/ Shashank Upadhye/
Shashank Upadhye, 48,209
Upadhye Tang LLP

Attorney for Patent Owner

CERTIFICATE OF WORD COUNT

Under 37 C.F.R. § 42.24(d), Patent Owner certifies that this Request for Discretionary Denial has a word count of 7536, excluding the portions exempted by 37 C.F.R. § 42.24(a), as calculated by the built-in word-count function in the Microsoft Word software used to prepare this document.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that on July 18, 2025, a complete copy of the foregoing Request for Discretionary Denial, Exhibit List, and all supporting exhibits were served electronically on Petitioner's counsel of record at the below. Petitioner's counsel agreed to dispense with service of paper copies.

J. Derek Vandenburg
Alexandra J Olsen
Samuel T. Lockner
Peter M. Kohlhepp
Carlson Caspers Vandenburg & Lindquist
225 South Sixth Street, Suite 4200
Minneapolis, MN 55402
(612) 436-9618

/s/ Shashank Upadhye/
Shashank Upadhye