IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

CORETRONIC CORPORATION and
OPTOMA CORPORATION,

Petitioners,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2025-00942

U.S. Patent No. 9,900,569

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

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
EX2001	Complaint, *Maxell, Ltd. v. Coretronic Corp.*, No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (Dkt. 1) (filed July 9, 2024)
EX2002	March 26, 2025, Memorandum to All PTAB Judges from Coke Morgan Stewart, Acting Secretary of Commerce for Intellectual Property, Regarding the Interim Processes for PTAB Workload Management
EX2003	First Amended Docket Control Order, *Maxell, Ltd. v. Coretronic Corp.*, No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (Dkt. 65) (January 7, 2025)
EX2004	Second Amended Docket Control Order, Maxell, Ltd. v. Coretronic Corp., No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (Dkt. 116) (July 17, 2025)
EX2005	Order Denying Motion to Transfer, *Maxell, Ltd. v. Coretronic Corp.*, No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (Dkt. 105) (June 3, 2025)
EX2006	Order Granting Motion to Dismiss, *Optoma Technology, Inc.v. Maxell, Ltd.*, No. 3:24-cv-08147-TLT (N.D. Cal.) (Dkt. 58) (March 14, 2025)
EX2007	Plaintiff's Preliminary Election of Asserted Claims, *Maxell, Ltd. v. Coretronic Corp.*, No**.** 5:24-cv-00088-RWS-JBB (E.D. Tex.) (Dkt. 78) (March 11, 2025)
EX2008	Defendants' Invalidity Contentions, *Maxell, Ltd. v. Coretronic Corp.*, No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (served on December 27, 2024)
EX2009	March 24, 2025, Memorandum to Members of the Patent Trial and Appeal Board from Scott R. Boalick, Chief Administrative Patent Judge, Guidance on USPTO's Recission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation"
EX2010	United States District Courts –National Judicial Caseload Profile, https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0331.2025.pdf

EX2011	Claim Construction Order, *Maxell, Ltd. v. Coretronic Corp.*, No. 5:24-cv-00088-RWS-JBB (E.D. Tex) (Dkt. 111) (June 30, 2025)
EX2012	Notice of Docketing, *Optoma Technology, Inc. v. Maxell, Ltd.*, No. 2025-1659 (Fed. Cir.) (April 18, 2025)
EX2013	Report and Recommendations re [020] Defendants' Motion to Dismiss, *Maxell, Ltd. v. Coretronic Corp.*, No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (Dkt. 96) (May 16, 2025)

I. INTRODUCTION

Patent Owner Maxell, Ltd. ("Patent Owner") respectfully requests that the Director deny institution of the Petition filed by Coretronic Corp. and Optoma Corp. (hereinafter "Petitioners") challenging the patentability of claims 1-4 ("challenged claims") of U.S. Patent No. 9,900,569 ("the '569 Patent") (CORETRONIC-1001).

The Director already denied institution for four petitions related to the same District Court Litigation. *Coretronic, Corp. v. Maxell, Ltd.*, IPR2025-00474, IPR2025-00476, IPR2025-00477, Paper 11, at 1-3 (P.T.A.B. Jul. 10, 2025); *Coretronic, Corp. v. Maxell, Ltd.*, IPR2025-00475, Paper 11, at 1-3 (P.T.A.B. Jul. 17, 2025). This Petition was filed several months *after* those four petitions. The delay in filing this Petition has only strengthened the factors favoring denial, and thus the Petition should be denied pursuant to 35 U.S.C. § 314(a). *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential).

Moreover, settled expectations, defects in the Petition, and other factors, also provide ample reasons for denial. Instituting an IPR here would contradict the goal of IPRs as an "effective and efficient alternative" to litigation, particularly given the substantial overlap and the finite resources of the Board. *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (P.T.A.B. Sept. 6, 2017) (precedential).

Accordingly, the Director should decline to institute the Petition.

II. THE MARCH 26, 2025 ACTING DIRECTOR'S MEMORANDUM

Pursuant to the Memo, which outlines "Interim Processes for PTAB Workload Management," including a bifurcated approach for considering discretionary denial, Patent Owner respectfully submits that the Director should deny institution of the Petition. This filing is being made within two months of the Notice of Filing Date dated June 16, 2025 (Paper #5), in accordance with the standard briefing schedule for discretionary denial arguments set forth in the Memo.

The Memo outlines relevant considerations for discretionary denial:

- 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.

As explained more fully below, denial is warranted under 35 U.S.C. § 314(a). Additionally, other factors highlighted in the Memo—strength of Petitioners'

Unpatentability Challenges, Petitioners' undue delay in filing this challenge despite years of notice (EX2001 ¶ 433), the nature of its expert testimony (EX1004)—further support discretionary denial. Thus, the petition is ripe for discretionary denial in light of the Memo's aim to "improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, . . . and promote consistent application of discretionary considerations in the institution of AIA proceedings." Memo at 3.

III. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

The Petition should be denied pursuant to the Director's discretion to deny institution of petitions. **First**, the Petition should be denied pursuant to 35 U.S.C. § 314(a) and the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020), given the parallel District Court litigation. **Second**, additional Factors set forth in the "Interim Processes for PTAB Workload Management" Memorandum favor the Director discretionarily denying the Petition.

A. Application of 35 U.S.C. § 314(a) Weighs in Favor of Denying Institution

The Petition should be denied pursuant to 35 U.S.C. § 314(a) because the factors established in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential), weigh strongly in favor of denial due to the parallel District Court Litigation: *Maxell, Ltd. v. Coretronic Corp.*, No. 5:24-cv-00088-RWS-JBB (E.D. Tex.) (filed July 9, 2024) ("District Court Litigation"). The Director

has already reviewed and denied institution of four other petitions related to the same District Court Litigation. *Coretronic, Corp. v. Maxell, Ltd.*, IPR2025-00474, IPR2025-00476, IPR2025-00477, Paper 11, at 1-3 (P.T.A.B. Jul. 10, 2025); *Coretronic, Corp. v. Maxell, Ltd.*, IPR2025-00475, Paper 11, at 1-3 (P.T.A.B. Jul. 17, 2025). Trial is predicted to occur ***at least four months*** prior to a Final Written Decision ("FWD") in this proceeding.

Institution of this proceeding would create substantial inefficiencies and prejudice, particularly given the progress of the District Court Litigation and settled expectations regarding the '569 Patent, which issued over seven years ago. Institution would be inconsistent with the AIA's goal of providing an "effective and efficient alternative" where, as here, the District Court is actively adjudicating the same core validity issues. *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018).

1. Status of Motion to Stay in District Court Litigation (Factor 1)

This factor weighs against institution. Petitioners waited nearly a year[1] into litigation to file the Petition and failed to request a stay. Further, circumstances indicate that any requested stay, would likely be denied. *See Polaris Power Techs.,*

[1] The Complaint was filed July 9, 2025, EX2001 at 1, while the Petition was filed 10 months later, on May 14, 2025. Paper 5 at 1.

LLC v. Samsung Elecs. Co., No. 2:22-CV-00469-JRG, 2023 WL 12065780, at *1 (E.D. Tex. Aug. 18, 2023) ("[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings."*); Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) ("In this district, that is not just the majority rule; it is the universal practice. This Court's survey of cases from the Eastern District of Texas shows that when the PTAB has not yet acted on a petition for inter partes review, the courts have uniformly denied motions for a stay.").

Even in the event of potential institution, the late stage of litigation, prejudice, tactical disadvantage to Patent Owner, and the lack of potential simplification of the issues would weigh strongly against such a motion. *See Croga Innovations Ltd. v. Cisco Sys., Inc.*, No. 2:24-CV-00065-JRG, 2025 WL 1117472, at *2 (E.D. Tex. Apr. 15, 2025) (denying a stay where the final written decision for an IPR would issue four months after scheduled trial and parties had filed claim construction briefs, indicating substantial investment); *Lennon Image Techs., LLC v. Macy's Retail Holdings, Inc.*, 2:13-CV-00235-JRG, 2014 WL 4652117, at *1 (E.D. Tex. Sept. 18, 2014).

Similarly, the statutory deadline for institution (December 10, 2025) occurs almost four months *after* fact discovery closes (August 21, 2025) and over a month after expert discovery closes (October 23, 2025). EX2004 at 3-4. The Director has

already indicated that "there has been meaningful investment in the parallel proceeding by the parties" in reference to an the investment of the parties at an ***earlier*** point in time. *Coretronic, Corp. v. Maxell, Ltd.*, IPR2025-00474, IPR2025-00476, IPR2025-00477, Paper 11, at 1-3 (P.T.A.B. Jul. 10, 2025); *see also Coretronic, Corp. v. Maxell, Ltd.*, IPR2025-00475, Paper 11, at 1-3 (P.T.A.B. Jul. 17, 2025).

These investments have only grown since. The District Court has now issued a claim construction order and depositions have been held. EX2011; EX2004 at 1; *see Intell. Ventures II v. FedEx Corp.*, No. 2:16-cv-00980-JRG, Dkt. 141 at 5 (E.D. Tex. Oct. 24, 2017) ("The Court agrees that the Parties have already invested substantial effort and resources during discovery and in preparing claim construction briefing. . . . These circumstances weigh against staying this case.").

Thus, the first factor weighs against institution.

2. Proximity of the District Court's Trial Date (Factor 2)

The Director already denied four petitions related to the same District Court litigation. *Coretronic, Corp. v. Maxell, Ltd.*, IPR2025-00474, IPR2025-00476, IPR2025-00477, Paper 11, at 1-3 (P.T.A.B. Jul. 10, 2025); *see also Coretronic, Corp. v. Maxell, Ltd.*, IPR2025-00475, Paper 11, at 1-3 (P.T.A.B. Jul. 17, 2025). Based on the District Court's scheduled trial date and time-to-trial statistics, the

Director concluded "it [was] unlikely that a final written decision in these proceedings [would] issue before the district court trial occurs." *Id.*

The projected trial date, based on time-to-trial statistics, precedes the Board's projected statutory deadline for the final written decision by several months. The Director and Board have routinely found such cases to weigh strongly in favor of denying institution. *See Dell Inc.*, Paper 12, at 10 (finding this factor "strongly favors exercising discretionary denial" when both scheduled and statistical trial dates preceded expected final written decision date by several months); *Charter Comms., Inc. v. Adaptive Spectrum & Signal Alignment, Inc.*, IPR2024-01379, Paper 16, at 10-11 (P.T.A.B. Apr. 17, 2025) (finding this factor favors exercising discretionary denial when "regardless of which trial date estimate is considered, they all provide for a trial date months before a projected statutory deadline for a final written decision in this proceeding"); *Int'l Business Machines Corp. v. Digital Doors, Inc.*, IPR2023-00969, Paper 8, at 10-11 (P.T.A.B. Dec. 5, 2023).

For example, statistics show that the case will be tried approximately 25.9 months from filing, around September 2026. EX2010. This projected trial date precedes the expected final written decision date by approximately ***four*** months.

Recently, the court issued a second docket control order that changed the scheduled trial date. While the pretrial conference date is scheduled for March 24, 2026, the actual trial date will be rescheduled. The scheduled pretrial conference

date indicates an even earlier trial date than the time-to-trial statistics, because the pretrial conference is slated for over ***eight*** months before the statutory deadline for issuing a Final Written Decision in this matter on December 10, 2026. EX2004. The pretrial conference date is indicative of the trial date. Fed. R. Civ. P. 16(e) ("The court may hold a final pretrial conference to formulate a trial plan, including a plan to facilitate the admission of evidence. ***The conference must be held as close to the start of trial as is reasonable***, ..."). Given that the "statistical" trial dates are well before the due date for the Final Written Decision, the second factor strongly favors discretionary denial. *See Dell Inc.*, Paper 12, at 10 (finding this factor "strongly favors exercising discretionary denial" when both scheduled and statistical trial dates preceded expected final written decision date by several months); *Charter Comms., Inc. v. Adaptive Spectrum & Signal Alignment, Inc.*, IPR2024-01379, Paper 16, at 10-11 (P.T.A.B. Apr. 17, 2025) (finding this factor favors exercising discretionary denial when "regardless of which trial date estimate is considered, they all provide for a trial date months before a projected statutory deadline for a final written decision in this proceeding").

3. Significant Investment in the Parallel Proceeding (Factor 3)

The investment in the parallel District Court Litigation strongly weighs in favor of discretionary denial. This factor is judged from the date of the institution

decision, which is expected to be no later than December 10, 2025. *See Fintiv*, Paper 11, at 9.

The Director has already indicated that there has been "meaningful investment in the parallel proceeding," in denying institution of four petitions related to the same District Court Litigation. *Coretronic, Corp. v. Maxell, Ltd.*, IPR2025-00474, IPR2025-00476, IPR2025-00477, Paper 11, at 1-3 (P.T.A.B. Jul. 10, 2025); *see also Coretronic, Corp. v. Maxell, Ltd.*, IPR2025-00475, Paper 11, at 1-3 (P.T.A.B. Jul. 17, 2025). This Petition was filed several months after those four petitions, meaning the investments in parallel proceeding have only increased.

For example, the Director indicated that "the parties have participated in a *Markman* hearing" as a sign of meaningful investment. *Id*. The District Court has now issued a claim construction order based on the *Markman* hearing. EX2011. Further, by the time of the institution decision, fact discovery will be complete on August 21, 2025, approximately four months before the statutory institution date, December 10, 2025. EX2004. Expert discovery will similarly be complete on October 23, 2025, approximately two months before the statutory date institution date. *Id.* The parties have already exchanged extensive infringement and invalidity contentions. Opening and rebuttal expert reports will have been served on September 18, 2025, and October 9, 2025, respectively, after substantial expense and effort by

counsel and experts on both sides, all which precedes the statutory institution date. *Id.* at 3-4.

Further, the District Court has invested many hours in holding arguments and issuing numerous rulings on Petitioners' motions to dismiss and the parties' other various motions. *See, e.g.*, EX2011. For example, the Court has considered and denied a motion to transfer to the Northern District of California, and a district court in the Northern District of California has already dismissed a related declaratory judgment action filed by Petitioners' subsidiary, Optoma Technology, Inc., which is now pending appeal at the Federal Circuit. EX2005; EX2006; EX2012. The Court has also considered numerous motions to dismiss and issued reports and recommendation denying these motions to dismiss. EX2013; EX2006. This extensive activity shows a significant investment by both the parties and the courts. *See Motorola Sols., Inc., v. Stellar, LLC*, Paper 19, at 3 (Mar. 28, 2025) (finding "substantial time and effort" invested by parties and the district court, where the district court held a claim construction hearing, parties had served extensive infringement and invalidity contentions, parties had served opening expert reports, and conducted several depositions).

As explained in *Fintiv*, the investment in the District Court Litigation by the District Court and the parties is judged from the date of the anticipated institution decision, which is expected to be about December 10, 2025. As presented above, the

District Court and the parties have made and will continue to make substantial investments in the District Court Litigation. Those investments will continue to compound in the four months between now and the due date for an institution decision. Indeed, at Institution, the District Court Litigation will essentially be ready for trial. This *Fintiv* factor strongly weighs in favor of denial.

4. There is Significant Overlap Between Issues Raised in the Petition and in the District Court Litigation (Factor 4)

This proceeding raises substantially the same issues as in the District Court Litigation. Here, Petitioners assert that Claims 1-4 of the '569 Patent are unpatentable. Pet. at 2. These claims fully overlap with the claims that Maxell asserted against Petitioners in the District Court Litigation. EX2007 at 1. Furthermore, Petitioners rely on the same references as they relied upon to challenge the '569 Patent's validity in the District Court Litigation. Served on December 27, 2024, five months before filing their petition, Petitioners' (as Defendants) own Invalidity Contentions explicitly list and analyze these references. EX2008 at 8.

Petitioners submitted a *Sotera* stipulation, but such a stipulation fails to mitigate concerns regarding "potentially conflicting decisions and duplicative efforts between the district court and the PTAB." *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 18-19 (P.T.A.B. Dec. 1, 2020). For example, in addition to "paper" art in the District Court Litigation, Petitioners also

assert "system art" such as user manuals and other technical documents for Hitachi and BenQ projectors. EX1011; EX1012; EX1013. In light of *Ioengine*, Petitioners can still assert this "system" art in the District Court litigation, notwithstanding their *Sotera* stipulation. *See Ingenico Inc. v. IOENGINE, LLC,* 136 F.4th 1354 (Fed. Cir. 2025) (holding, even where a petitioner could not have offered system art in a PTAB proceeding, estoppel does not preclude a petitioner from later raising said art in a District Court action). Thus, as demonstrated here, a *Sotera* stipulation "may not be particularly meaningful" where "the petitioner is relying on corresponding system art in a co-pending proceeding." FAQs for Interim Processes for PTAB Workload Management (available at https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management).

Additionally, prior to the Board's institution decision (scheduled for December 16, 2025), the District Court litigation will have already completed fact discovery, expert discovery, and summary judgment motions, addressing many of the same references asserted here. EX2004. The parties will have already invested a substantial amount of time and effort addressing these overlapping issues; thus, Petitioner's stipulation fails to mitigate concerns of duplicative efforts and provide a true alternative to the District Court.

Further, Petitioners' stipulation cannot outweigh the other *Fintiv* factors. A *Sotera* stipulation is not dispositive on its own. EX2009 at 2-3 (stating that a *Sotera*

stipulation would be "highly relevant, but will not be dispositive by itself"). Given that the Petition is directed toward the same patent, encompasses the claims at issue in the parallel District Court Litigation, involves overlapping prior art and arguments, and does not seek to mitigate concerns regarding duplicative efforts or potentially conflicting decisions via a *Sotera* stipulation, this factor strongly favors denial of institution. *See, e.g.*, *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 2 (P.T.A.B. March 28, 2025) (overall weighing of the *Fintiv* factors was erroneous because the Board did not give enough weight to the investment in the parallel proceeding and gave too much weight to Petitioner's *Sotera* stipulation); *Cisco Systems, Inc. v. Estech Systems, Inc.*, IPR2021-00333, Paper 12 at 12-13 (P.T.A.B. July 7, 2021) (denying institution under Fintiv based on holistic analysis of all factors even when petitioner filed a *Sotera* stipulation because the Board was "not persuaded … the stipulations proffered here are sufficient when weighed against other factors.").

5. The District Court Litigation and the Petition Involve the Same Parties (Factor 5)

As noted in Patent Owner's Mandatory Notice, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the '569 Patent). Petitioners are both parties to the District Court Litigation. Accordingly, this factor weighs in favor of discretionary denial. *See Sotera*,

IPR2020-01019, Paper 12 at 19 (stating that this factor supports denying institution when the "parties are the same in the inter partes proceeding and in the parallel proceeding").

6. Other Factors Favor Discretionary Denial (Factor 6)

The Petition does not present a strong case on the merits, let alone a "compelling meritorious challenge," which further supports denial of institution. The Petition sets forth flawed challenges. For example, the Petition extensively relies on an expert declaration that largely parrots verbatim the wording of the Petition. EX1004.

Petitioner also waited years to file this IPR, suggesting tactical gamesmanship aimed at disrupting the district court case. Maxell notified Petitioner of the '569 Patent on April 27, 2023. EX2001 ¶ 433. As recognized in the Memo regarding discretionary denials, such considerations regarding case management, efficient use of resources, and potential abuse of process may be relevant to the denial analysis and weigh against institution here.

Additionally, while Petitioners make a *Sotera* stipulation, it offers only minimal effect. The parties will have already prepared expert reports and completed expert discovery by the time the Board renders an institution decision. For efficiency's sake, the parties should address the validity issues in the district court rather than this forum. Congress created the *inter partes* review process as "a quick,

inexpensive, and reliable alternative to district court litigation." S. Rep. No. 110-259, at 20 (2008). Forcing Maxell to prepare its validity case in the district court litigation—including engaging experts and carrying out expert discovery—prior to the Board's institution decision fails to achieve the stated goals for *inter partes* reviews.

Although Petitioners filed the Petition prior to the statutory deadline (July 2025), they did not do so as quickly as they might have. Indeed, rather than prioritize this proceeding, Petitioners filed three motions to dismiss (including two based on invalidity) in the District Court Litigation, a motion to transfer venue, and a declaratory judgment action. Plainly, the Petition was not a priority for Petitioners. This factor is (at best) neutral.

IV. ADDITIONAL FACTORS SET FORTH IN THE MEMORANDUM SUPPORT DISCRETIONARY DENIAL

Beyond the established frameworks of 35 U.S.C. § 314(a) and *Fintiv*, the Memo clarifies that the Director may weigh additional considerations relevant to fairness and efficiency. Other such considerations further support denying institution here.

A. Settled Expectations

The '569 Patent has been in force for over seven years. Such pendency has been shown to establish settled expectations for a Patent Owner. *OnePlus Tech.*

(Shenzhen) Co., Ltd. v. Pantech Corp., IPR2025-00637, Paper 17 at 2 (P.T.A.B. Aug. 14, 2025). The '569 Patent issued in February 2018 and relates to technology covered by a family of patents. The patent owners assigned the '569 several times throughout its lifespan and continued payment of all maintenance fees, demonstrating an intent to keep the patent alive and enforce the patent. Because the Patent is still active and has been in force for over seven years, settled expectations weigh in favor of discretionary denial. *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433, 435, Paper 11 at 2-3 (PTAB Jun. 26, 2025) (denying institution for settled expectations for challenged patents that "have been in force for nine and seven years").

In addition, Petitioners knew of the '569 Patent for over two years prior to this Petition's filing. Maxell sent notice letters regarding the '569 Patent in April 2023. EX2001 ¶433. This history contributes to settled expectations regarding the patent's validity. Settled expectations regarding other patents asserted in the same district court litigation contributed to denial of those petitions. *Coretronic, Corp. v. Maxell, Ltd.*, IPR2025-00474, IPR2025-00476, IPR2025-00477, Paper 11, at 2 (P.T.A.B. Jul. 10, 2025) ("Furthermore, the challenged patents have been in force for approximately eight, twelve, and fifteen years, creating strong settled expectations, . . .").

B. Petitioners' Undue Delay and Gamesmanship

The Memo permits consideration of factors bearing on the efficient use of Board resources and potential abuse of process. Here, Petitioners waited nearly two years to file this Petition after first learning of Maxell's infringement allegations in April 2023. EX2001, ¶ 433.

Petitioner only filed the IPR after the parties made substantial progress in the parallel District Court Litigation, including extensive motion practice and exchange of contentions. Such a lengthy and unexplained delay strongly suggests tactical gamesmanship aimed at disrupting the District Court Litigation rather than seeking an efficient alternative to litigation early in the dispute. This weighs in favor of discretionary denial.

V. CONCLUSION

For at least the foregoing reasons, the Board should deny institution of the Petition.

Dated: August 18, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 18th day of August, 2025, a copy of the attached Brief in Support of Patent Owner's Request for Discretionary Denial, together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:.

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Respectfully submitted,

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CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)

Pursuant 37 CFR 42.24(d), the undersigned certifies that this Preliminary Response and complies with the type-volume limitation of 37 CFR §42.24(a). The word count application of the word processing program used to prepare this Preliminary Response indicates that the Preliminary Response contains 3,653 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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