

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

L'OREAL USA, INC.

Petitioner

v.

BRIGHTEX BIO-PHOTONICS, LLC.

Patent Owner

Case No. IPR2025-00971

U.S. Patent No. 9,542,595

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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Patent Trial and Appeal Board

U.S. Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

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PATENT OWNER EXHIBIT LIST

Exhibit SRX	Reference
2001	U.S. Patent No. 9,542,595 (“the ’595 patent”)
2002	2009 Non-Disclosure Agreement Between L’Oreal and Brightex Bio-Photonics (Patent Owner)
2003	2013 Non-Disclosure Agreement Between L’Oreal and Brightex Bio-Photonics (Patent Owner)
2004	2019 Non-Disclosure Agreement Between L’Oreal and Brightex Bio-Photonics (Patent Owner)
2005	July 14, 2009 Email from Petitioner L’Oreal USA to Brightex Bio-Photonics (Patent Owner) During 2009 NDA Review, <i>Brightex Bio-Photonics, LLC v. L’Oreal USA, Inc.</i> , D.E. No. 1-3 (N.D. Cal.)
2006	Complaint, <i>Brightex Bio-Photonics, LLC v. L’Oreal USA, Inc.</i> , D.E. No. 1 (N.D. Cal.)
2007	Answer by Petitioner, <i>Brightex Bio-Photonics, LLC v. L’Oreal USA, Inc.</i> , D.E. No. 42 (N.D. Cal.)
2008	Defendant/Petitioner Stipulation Consent for Magistrate to Adjudicate Case, <i>Brightex Bio-Photonics, LLC, v. L’Oreal USA, Inc.</i> , Case No. 24-cv-07919-JCS, D.E. No. 20 (Dec. 9, 2024)
2009	Plaintiff/Respondent Stipulation Consent for Magistrate to Adjudicate Case, <i>Brightex Bio-Photonics, LLC, v. L’Oreal USA, Inc.</i> , Case No. 24-cv-07919-JCS, D.E. No. 19 (Nov. 26, 2024)
2010	Time to Trial Survey for N.D. Cal. Statistics, U.S. Courts, https://www.uscourts.gov/data-news/reports/statistical-reports/federal-judicial-caseload-statistics (2025)
2011	<i>Brightex Bio-Photonics, LLC, v. L’Oreal USA, Inc.</i> , Case No. 24-cv-07919-JCS, D.E. No. 57 (July 2, 2025)
2012	L’Oreal USA’s Stipulation Regarding Invalidity Contentions, <i>Brightex Bio-Photonics, LLC, v. L’Oreal USA, Inc.</i> , Case No. 24-cv-07919-JCS, D.E. No. 47, May 12, 2025 (<i>Sotera</i> Stipulation)

2013	L'Oreal Invalidity Contentions, served May 20, 2025.
2014	PTO Memorandum, March 24, 2025, 2-3 (<i>Sotera</i> Stipulation addressed)
2015	Declaration of Raj Chhibber in Support of Patent Owner's Request for Discretionary Denial
2016	"Interim Processes for PTAB Workload Management," dated March 26, 2025 ("March 26, 2025 Guidance")
2017	Patent Case Management and Pretrial Order, D.E. No. 34, March 14, 2025.
2018	L'Oreal Disclosure Claim Constructions and Extrinsic Evidence, June 23, 2025
2019	U.S. Patent Publ. No. 2011/0301441 A1 to "Bandic"

Patent Owner, Brightex Bio-Photonics, LLC (“Brightex” or “Patent Owner”), submits this paper requesting discretionary denial of the Petition for *Inter Partes* Review (“Petition”) pursuant to the Board’s recent guidance on “Interim Processes for PTAB Workload Management,” dated March 26, 2025 (“Guidance”), other guidance provided by the PTO, and denial decisions interpreting the same.

I. INTRODUCTION

The subject U.S. Patent No. 9,542,595 (“the ‘595 Patent”) issued on January 10, 2017, which makes the ‘595 Patent more than eight (8) years old. For the ‘595 Patent, a provisional application was filed on March 25, 2013, a non-provisional application was filed on March 25, 2014, and publication of the ‘595 Patent application occurred on October 23, 2014, U.S. Publ. No. 2014/0314315 before issuance on January 10, 2017.

Petitioner L’Oreal (and its foreign parent L’Oreal S.A.) (collectively, “L’Oreal”) were technology development “partners” with Brightex for more than fifteen years before L’Oreal’s 2025 Petition filing. Three separate five-year Non-Disclosure Agreements were signed between Brightex and L’Oreal in 2009, 2013 and 2019, respectively. *See* SRX 2002–2004, NDAs. During their technology development partnership, L’Oreal had a business practice of requesting up-to-date information from Brightex (under the NDAs) about its patent filings and issuances.

As shown in the Declaration of Raj Chhibber (CEO of Brightex), L'Oreal requested such patent filing information, and received requested updates, during at least five meetings between Brightex and L'Oreal personnel. SRX 2015, Raj Chhibber Decl., ¶¶6-7, pp. 3-6.

Pursuant to requests for information during these partnership meetings on and after 2013, L'Oreal was notified by Brightex about the existence of the '595 Patent provisional application filing in April of 2013, the publication of the '595 Patent non-provisional application in 2014, and the issued '595 Patent on and after January, 2017. For that reason, Petitioner has been aware of: (1) the '595 Patent provisional application filing for more than twelve years before its Petition filing, (2) the non-provisional application publication of the '595 Patent for more than eleven years before its Petition filing; and (3) the issuance of the '595 Patent for more than eight years before its Petition filing.

Their technology development partnership also required Brightex to deliver to L'Oreal and its affiliates multiple application programs that incorporated Brightex's patented technology in 2014. In a separate Brightex/L'Oreal November 2013 product delivery contract, Brightex was obligated to provide L'Oreal affiliate brands La Roche-Posay (LRP) and Garnier with application programs using Brightex's patented technology. L'Oreal admits that the contract terms were

fulfilled when its affiliates received Brightex’s application programs in 2014 and L’Oreal admitted that the Brightex application program “was the first to go live and did so on September 23, 2014.”¹ Despite admitting that Brightex’s 2014 application program “was the first to go live,” Petitioner L’Oreal now argues that Brightex’s technology on the ‘595 Patent is shown in older prior art, and therefore is obvious under the Patent Act.

The final NDA between Brightex and L’Oreal expired in 2024, and L’Oreal filed the present IPR Petition the following year in 2025. Despite knowing about the ‘595 Patent application filing as early as 2013 and the ‘595 Patent issuance in 2017, L’Oreal took no action to contest the ‘595 Patent until 2025. Based on the advanced age of the ‘595 Patent, and the early (and regular) notice provided to Petitioner about the ‘595 Patent, Patent Owner Brightex has reasonable “settled expectations” that weigh heavily in favor of granting the present discretionary denial request.

Further, as a technology “partner” that shared confidential information and developed multiple products with, and for, L’Oreal for more than fifteen (15) years,

¹ SRX 2007, L’Oreal Answer, ¶33, p. 9 (“L’Oreal USA admits that BTBP developed applications under the November 2013 Agreement, including an application for the Garnier brand.”); Answer, ¶34, p. 9 (“L’Oreal USA admits that, of the applications BTBP developed under the November 2013 Agreement, the application for the Garnier brand was the first to go live and did so on September 23, 2014.”).

Patent Owner Brightex also has legitimate “settled expectations” that L’Oreal would not leverage its confidential position in the technology partnership, or the confidential information it acquired during their partnership, in order to advance its own interests by filing of an *Inter Partes* Review seeking invalidation of Brightex’s ‘595 Patent.² While L’Oreal is not the inventor of the ‘595 Patent, there is a previous relationship between L’Oreal and Brightex, and Patent Owner submits that the same “unfair dealings” arise in their advocacy for unpatentability of technology they have utilized.

While Brightex’s “settled expectations” strongly favor a discretionary denial of L’Oreal’s Petition for Inter Partes Review, there are other relevant factors and issues that support the present request for discretionary denial. For the reasons set forth herein, Patent Owner Brightex respectfully requests a discretionary denial of L’Oreal’s Petition for an *Inter Partes* Review of the ‘595 Patent.

² Where there is a past relationship between the Petitioner and Patent Owner, the Office has determined that “it is not an appropriate to use of Office resources” to institute an *Inter Partes* Review proceeding. *Gator Bio, Inc. v. Sartorius Bioanalytical Instruments, Inc.*, IPR2025-00633, Paper 9 at 2 (Director July 24, 2025)(“ It is not an appropriate use of Office resources where inventors applied for and were issued a patent but now advocate for its unpatentability.”); *citing Tessell, Inc. v. Nutanix, Inc.*, IPR2025-00322, Paper 14 at 2 (Director June 12, 2025). “[T]he Office may consider unfair dealings as a factor when determining whether to exercise discretion to deny institution under 35 U.S.C. § 314(a).” *Id.*

II. FACTUAL BACKGROUND

The ‘595 Patent issued over eight years ago on January 10, 2017, and its application was published eleven years ago on October 23, 2014. SRX 2001, ‘595 Patent. During its technology partnership with L’Oreal, Patent Owner Brightex shared confidential information, which included discussions of the ‘595 Patent technology, with L’Oreal USA (Petitioner) and its parent, L’Oreal for more than 15 years; and Brightex even developed and provided an application product to L’Oreal pursuant to a 2013 product development agreement. L’Oreal has known about, and even received a benefit from, the ‘595 Patent through its direct dealings with Patent Owner Brightex.

During their partnership, L’Oreal had an established business practice of requesting up-to-date patent filing and status information from Brightex. SRX 2015, Raj Chhibber Decl., ¶¶6-7, pp. 3-6. As shown in the Declaration of Raj Chhibber (CEO of Brightex), Brightex identifies at least five meetings where L’Oreal personnel asked Brightex for such patent information, and L’Oreal received the requested patent information (including the filings, publication, and issuance of the ‘595 Patent) under the terms of the parties’ NDAs. SRX 2015, Raj Chhibber Decl., ¶¶6-7, pp. 3-6.

A. L’Oreal’s Technology Partnership with Brightex from April 30, 2013 Through 2019 – After Filing, During Prosecution, and After Issuance of the ‘595 Patent

On March 25, 2013, Patent Owner Brightex filed its provisional application Serial No. 61/805,126, which is the priority application that matured into the ‘595 Patent. SRX 2001, The ‘595 Patent. A non-provisional application was filed by Brightex on March 25, 2014, and that application was published on October 23, 2014. *Id.* The ‘595 Patent issued on January 10, 2017. *Id.*

On April 30, 2013, L’Oreal USA and its affiliates entered into a Mutual Non-Disclosure Agreement with BTBP (the “2013 L’Oreal-BTBP NDA”), which stated that L’Oreal USA was discussing whether Brightex would “perform certain services or supply certain goods” relating to “current and future scientific, technical, business, strategic, marketing and creative affairs.” SRX 2003, 2013 Non-Disclosure Agreement between Brightex and L’Oreal. In its Answer, “L’Oreal USA admits that it entered into a Mutual Non-Disclosure Agreement with BTBP on April 30, 2013 (the “2013 Mutual NDA”).” SRX 2007, Answer, ¶30, p. 7.

Brightex alleges that the “April 2013 L’Oreal-BTBP NDA provided, in part, that L’Oreal USA, ‘together with its parent, subsidiaries and affiliates,’ agreed to receive from Brightex ‘certain confidential and proprietary information’ regarding BTBP’s skin analysis and treatment technology.” SRX 2006, Complaint, ¶30, p. 11.

Petitioner admitted that the above quoted statement was the purpose of the 2013 NDA in its Answer. SRX 2007, Answer, ¶30, p. 7. Like the 2009 and 2019 NDAs, the term of the 2013 NDA was five years, which spanned from 2013 to 2018. SRX 2003, NDA, ¶10(e), p. 4.

Regarding the confidential information shared with Petitioner under the 2013 NDA, Patent Owner Brightex alleges that:

BTBP disclosed to L’Oreal USA the initial version of its DeepTag technology, which was an e-diagnostic platform (*i.e.*, an application on a phone or website) capable of performing many of the functions of BTBP’s Clarity Pro System in a fraction of the time. BTBP disclosed many aspects of its DeepTag technology to Defendant’s personnel, including (1) the concept of a guide to show a user how to take images of their skin in a way that was optimal to skin measurement and analysis, (2) the analysis of user-taken images on remote servers and the division of the face into regions as described in the Clarity Pro System above, (3) the specific algorithms used for facial detection and tracking, (4) the methods by which the DeepTag platform utilized the measurements taken from the user images in order to rank skin conditions in terms of severity and recommend the appropriate products. BTBP also disclosed its methods by which to map skin measurements to specific products for recommendation purposes.

SRX 2006, Complaint, ¶30, p. 11. In its Answer, “L’Oreal USA admits that BTBP performed demonstrations related to its DeepTag technology.” SRX 2007, Answer, ¶30, p. 8.

Patent Owner Brightex alleges that:

BTBP created applications for L’Oreal USA to conduct tests using the DeepTag technology. These applications, as provided to Defendant, had

fully functional user interfaces and included BTBP's automated skin analysis systems and real-time image capturing and evaluation services. These applications took the form of apps installed on L'Oreal smart devices (i.e., cell phones) and applications designed to be accessed via a website URL. L'Oreal USA was particularly interested in understanding how to obtain skin measurements in order to recommend products in order to make sales directly from an application.

SRX 2006, Complaint, ¶ 19, p. 7. In its Answer, "L'Oreal USA admits that BTBP provided L'Oreal USA with sample applications to demonstrate certain purported capabilities of BTBP's DeepTag technology." SRX 2007, Answer, ¶31, p. 8.

Patent Owner Brightex alleges that:

L'Oreal USA and BTBP then entered into an agreement effective November 21, 2013, pursuant to which L'Oreal USA contracted with BTBP for BTBP to create and implement what L'Oreal USA called a "customized e-diagnostic platform" for L'Oreal USA brands of cosmetics and beauty products (the "November 2013 L'Oreal E-Diagnostic Platform Agreement") for two L'Oreal products -- "LRP" and "Garnier." In particular, the November 2013 L'Oreal E-Diagnostic Platform Agreement specifically provided as follows:

BTBP has developed an e-diagnostic platform that takes and displays an image of a person which can be viewed to diagnose features of the person that might be improved with the use of products from the Beauty Industry and that permits the person to select and apply such products to the image and then view the results ("E-Diagnostic Platform"). LUSA desires to have BTBP create and implement a customized E- Diagnostic Platform ("LUSA Customized E-Diagnostic Platform") for the LUSA brands of products identified in **Schedule A** ("LUSA Brands") and to host the LUSA

Customized E-Diagnostic platform on BTBP servers for access by consumers through the various media identified in **Schedule A**.

BTBP has agreed to create, implement and host the LUSA Customized E-Diagnostic Platform in accordance with the terms and conditions set forth in this Agreement.

BTBP referred to this L’Oreal E-Diagnostic Platform as the BTBP DeepTag platform.

SRX 2006, Complaint, ¶32, p. 12. In its Answer:

L’Oreal USA admits that it entered into an agreement with BTBP effective November 21, 2013 (the “November 2013 Agreement”). L’Oreal USA admits that the quoted language in paragraph 32 at lines 12–18 appears in the November 2013 Agreement.

SRX 2007, Answer, ¶32, p. 8.

Patent Owner Brightex alleges that:

BTBP then designed and delivered fully functional applications that incorporated BTBP technology for two of L’Oreal’s brands, LRP and Garnier. BTBP worked with these brands to determine their preferred user-interfaces, uploading of products, and testing of the applications.

SRX 2006, Complaint, ¶33, p. 12. In its Answer, “L’Oreal USA admits that BTBP developed applications under the November 2013 Agreement, including an application for the Garnier brand.” SRX 2007, Answer, ¶33, p. 9.

Patent Owner Brightex alleges that:

testing of the LRP application was to be completed on July 10,

2014, and was scheduled to launch on July 13, 2014. Garnier, by comparison, was scheduled to complete testing on July 1, 2014, and launch on July 8, 2014.

SRX 2006, Complaint, ¶34, p. 12. In its Answer, “L’Oreal USA admits that, of the applications BTBP developed under the November 2013 Agreement, the application for the Garnier brand was the first to go live and did so on September 23, 2014.”

SRX 2007, Answer, ¶34, p. 9.

Patent Owner Brightex alleges that: “On April 20, 2015, Pritesh Davda (Assistant Vice President of Digital Marketing for L’Oreal USA) informed BTBP that L’Oreal was working on its own “Skin Genius” application, which was “like what [BTBP] built for LRP,” La Roche-Posay (L’Oreal affiliate). SRX 2006, Complaint, ¶35, p. 13. In its Answer, “L’Oreal USA admits that, as of April 20, 2015, Pritesh Davda was employed by L’Oreal USA and held the title of Assistance Vice President of Digital Marketing IT.” SRX 2007, Answer, ¶35, p. 9.

During the five-year term of the 2013 NDA Agreement and after Brightex provided application programs to L’Oreal affiliates in 2014, “L’Oreal USA admits that, as of May 2016, L’Oreal’s Technology Incubator located in San Francisco had spearheaded a number of game changing digital services, including the Makeup Genius virtual try-on tool.” SRX 2007, Answer, ¶7, p. 2. L’Oreal’s Technology Incubator, located in San Francisco near Brightex’s San Jose headquarters,

“includes physicists, engineers UX specialists, hardware designers and data scientists working cross functionally brand and product-wise to help L’Oreal USA evolve from a beauty company to a technology company in the beauty and cosmetic commercial space.” SRX 2006, Complaint, ¶7, p. 3.

During the five-year term of the 2013 NDA Agreement and after Brightex provided L’Oreal affiliates with application programs, L’Oreal also claimed that it began introducing its own “Makeup Genuis” product to the public, which L’Oreal claimed was innovated at their research facility in Clark, New Jersey. SRX 2006, Complaint, ¶36-37, p. 13. Patent Owner Brightex alleges that L’Oreal’s “Clark, New Jersey facility is the L’Oreal USA facility that worked extensively with BTBP to learn details about the BTBP Clarity technology, and then ‘to create, implement and host the LUSA Customized E-Diagnostic Platform’ that ‘takes and displays an image of a person which can be viewed to diagnose features of the person that might be improved with the use of products from the Beauty Industry and that permits the person to select and apply such products to the image and then view the results.’” SRX 2006, Complaint, ¶37, p. 13.

After issuance of the ‘595 Patent in 2017, Patent Owner Brightex alleges that L’Oreal approached Brightex again in 2019 for technology disclosures as follows:

in October 2019, L’Oreal USA’s parent corporation approached BTBP to discuss whether it could obtain more information on BTBP’s automated

skin analysis technology and entered into another NDA to learn additional technology to pursue this technology in its business. L'Oreal Paris Headquarters once again contacted BTBP and discussed how they can leverage BTBP's technology. L'Oreal wanted to obtain further information on the features BTBP had added to DeepTag; of specific interest to L'Oreal were measurements related to skin tone and skin color for potential use in accurate makeup and beauty products recommendation. These were new features to the DeepTag platform that BTBP had added since L'Oreal USA's previous contact. As part of the discussions, BTBP provided L'Oreal with additional information under the NDA including sample apps demonstrating the new DeepTag features that showed their accuracy and how the measurements can be integrated into product recommendation. The native apps were installed onto L'Oreal's smart devices and web apps were made accessible to them via URL links.

SRX 2006, Complaint, ¶40, p. 14.

In its Answer, "L'Oreal USA admits that, in October 2019, L'Oreal SA entered into a Non-Disclosure Agreement with BTBP," and L'Oreal USA admits that BTBP provided L'Oreal with sample apps to demonstrate certain purported capabilities of BTBP's DeepTag technology. SRX 2007, Answer, ¶40, p. 10; SRX 2004, 2019 NDA. On October 15, 2019, L'Oreal SA and its affiliates entered into a third Non-Disclosure Agreement with BrighTex (the "2019 NDA") pursuant to which L'Oreal requested information on "software and hardware solutions proposed by BrighTex Bio-Photonics for skin and fiber (mainly hair and eye lashes) diagnostics, their overall operating principle and their performances." SRX 2004, 2019 NDA, p. 1.

B. Brightex's Prior Joint Research Projects with L'Oreal

Prior to 2013, L'Oreal and Brightex engaged in research projects involving earlier technology. Patent Owner Brightex alleges that "L'Oreal USA acquired from BTBP a copy of BTBP's Clarity Pro Clinical Research System in late 2007." SRX 2006, Complaint, ¶19, p. 7. In its Answer, "L'Oreal USA admits that BTBP provided L'Oreal USA a copy of BTBP's Clarity Pro Clinical Research System." SRX 2007, Answer, ¶19, p. 4.

Patent Owner Brightex alleges that in "2007 and 2008, L'Oreal USA and its affiliates performed initial tests of the BTBP Clarity Pro Clinical Research System and reviewed published studies showing a strong correlation between the results of visual grading techniques and BTBP's Clarity Pro Clinical Research System." SRX 2006, Complaint, ¶20, p. 7. In its Answer, "L'Oreal USA admits that it tested BTBP's Clarity Pro Clinical Research System." SRX 2007, Answer, ¶20, p. 4-5.

Patent Owner Brightex alleges that:

In late 2008, L'Oreal USA visited BTBP facilities to see a demonstration of the BTBP Clarity Pro Clinical Research System to learn about the BTBP Clarity Pro system. Daniel Kung, who was L'Oreal USA's Senior Chemical Engineer, contacted Shefali Sharma, Marketing Director for BTBP on July 14, 2009 and indicated that Germain Puccetti's skin team was having "positive experiences ... with BTBP" and expressed interest in moving "towards a formal proposal for some" additional work with BTBP regarding a similar product for his hair team. *See* Exhibit 3.

SRX 2006, Complaint, ¶21, p. 7. Exhibit 3 is attached hereto as SRX 2005, which

is a 2009 email described above. Exhibit 3, SRX 2005, Emails. In its Answer:

L'Oreal USA admits that L'Oreal USA personnel visited BTBP facilities to attend a demonstration of BTBP's Clarity Pro Clinical Research System. L'Oreal USA admits that Exhibit 3 to the Complaint purports to be a copy of an email sent by Daniel Kung to Shefali Sharma on July 14, 2009, and that the quoted language in paragraph 21 appears in Exhibit 3. L'Oreal USA admits that, as of July 14, 2009, Mr. Kung was employed by L'Oreal USA and his title was Senior Chemical Engineer.

SRX 2007, Answer, ¶21, p. 5.

L'Oreal's customary business practice of requesting up-to-date information from Brightex, under the protections of the NDAs, regarding Brightex's patent filings and issuances is shown dating back to meetings at least as early as 2011. SRX 2015, Raj Chhibber Decl., ¶8, p. 7. As shown in the Declaration of Raj Chhibber (CEO of Brightex), L'Oreal requested such information, and received updates on the filings (including the filings, publication, and issuance of prior Brightex patents) during the course of at least five meetings between Brightex and L'Oreal personnel. SRX 2015, Raj Chhibber Decl., ¶¶6-7, pp. 3-6.

On April 1, 2009, L'Oreal USA and its affiliates entered into a Mutual Non-Disclosure Agreement with Brightex (the "2009 L'Oreal-BTBP NDA") pursuant to which L'Oreal USA was investigating whether Brightex would "perform certain services or supply certain goods" relating to the computerized skin analysis. SRX 2002, 2009 L'Oreal-BTBP NDA. The term of the 2009 NDA was five years spanning

2009 to 2014. SRX 2002, NDA, ¶10(e), p. 4.

Patent Owner Brightex alleges:

Pursuant to the 2009 L'Oreal-BTBP NDA, L'Oreal USA and its affiliates held numerous meetings and conferences with BTBP personnel regarding the nature, function, and operation of the BTBP Clarity Pro Clinical Research System. BTBP disclosed to L'Oreal USA how the Clarity Pro System performed automated skin analysis by analyzing images of skin before and after application of beauty care products. This was done to measure minute changes in the skin caused by the skin and beauty care products. As explained to L'Oreal USA, one of the benefits of the Clarity Pro System was its ability to automatically reposition facial images to ensure the before and after images lined up correctly based on regions of the skin. The system then identified a variety of skin conditions in these skin regions. More specifically, the concept of extracting a skin map (a pixel region within an image that belongs to the subject's skin) from an image using color and intensity information using digital algorithms was disclosed and demonstrated to L'Oreal USA. The concept of sub-categorization was also disclosed and shown to L'Oreal USA (*i.e.*, pores of different sizes were placed into different size/severity categories). L'Oreal USA tested the System by using a pore constrictor on a test subject, which showed that after the use of a pore constrictor, fewer visible pores were present in the largest, most severe category identified by the system. Critically, BTBP also demonstrated the system's ability to detect and measure skin features (such as sunspots and wrinkles) by looking at their color and intensity differences relative to the surrounding skin, rather than by looking at universal color and intensity values. This concept, as disclosed to Defendant, is what allowed the system to tailor its analysis of skin to an individual subject (*i.e.*, person), rather than relying on a single static algorithm for all subjects, ensuring significantly more accurate results. BTBP also disclosed and explained the system's ability to calibrate images of a subject automatically by using a color standard (or chart) that is visible within the image in a static position. This ability allowed for the correction of images by comparing the color standard's recorded values to their known or established values and making automatic corrections to the images to standardize colors between images. This ability, as disclosed to Defendant, also increased the

accuracy of the system.

SRX 2006, Complaint, ¶23, p. 7-8. In its Answer:

L’Oreal USA admits that it communicated with BTBP personnel regarding BTBP’s Clarity Pro System. L’Oreal USA admits that it tested BTBP’s Clarity Pro System. L’Oreal USA admits that BTBP performed demonstrations of BTBP’s Clarity Pro System for L’Oreal.

SRX 2007, Answer, ¶23, p. 5.

Patent Owner Brightex alleges that:

in May 2009, a scientist from L’Oreal USA by the name of Dr. Germain Puccetti, located in Clark, New Jersey, visited BTBP’s facilities in San Jose, California, to gather information on BTBP systems, and he reviewed images of facial skin obtained using the BTBP Clarity Pro Clinical Research System (“the System”) during that visit to BTBP. L’Oreal USA’s tests using the BTBP technology and systems verified that the Clarity Pro system was able to automatically and accurately measure “before and after” changes in the photographic images of the skin at a quality level comparable to that performed by a professional visual grader of the skin. This meant that studies of facial skin could be made cheaper and faster than visual grading so that a cosmetics company such as L’Oreal USA could get products to market quicker with less overhead. Thus, L’Oreal USA, through testing of the BTBP Clarity Pro Clinical Research System, demonstrated that consumers could automatically find small variations in skin to see and prove small improvements in skin conditions caused by active ingredients.

SRX 2006, Complaint, ¶24, p. 9. In its Answer:

L’Oreal USA admits that, in 2009, Dr. Germain Puccetti visited BTBP’s facilities in San Jose, California. L’Oreal USA admits that, as of 2009, Dr. Puccetti was a scientist employed by L’Oreal USA based in Clark, New Jersey. L’Oreal USA admits that it tested BTBP’s Clarity Pro System.

SRX 2007, Answer, ¶24, p. 5-6.

Patent Owner Brightex alleges that:

in June 2010, L’Oreal USA personnel again visited BTBP facilities and attended a presentation and demonstration of BTBP instruments used in the System. During this visit, L’Oreal USA brought its Head of US Hair Instrumental Evaluation Fred Cervantes, and the Head of International Hair Jean-Yves Kempf. As one L’Oreal USA Senior Engineer commented in June 2010, “it was great for Fred and Jean-Yves to see the capabilities and potential from collaborating with your company. I am hoping that this will help build momentum for this project.”

SRX 2006, Complaint, ¶25, p. 9. In its Answer:

L’Oreal USA admits that, in or around June 2010, Fred Cervantes and Jean-Yves Kempf visited BTBP facilities to attend a demonstration of BTBP’s Clarity Pro System. L’Oreal USA admits that, as of June 2010, Mr. Cervantes and Mr. Kempf were employed by L’Oreal USA.

SRX 2007, Answer, ¶25, p. 6. With respect Dr. Balooch and the positions he has held at L’Oreal:

L’Oreal USA admits that, in or around late 2010, Dr. Guive Balooch was employed by L’Oreal USA and held the title of Senior Research Scientist. L’Oreal USA admits that, in or around late 2010, Dr. Balooch worked at the L’Oreal U.S. Advanced Research facility in Clark, New Jersey. L’Oreal USA admits that Dr. Balooch presently holds the title of Global Managing Director of Augmented Beauty and Open Innovation, and leads a global team focused on uncovering and developing “disruptive innovations” through strategic partnerships, investments, and acquisitions for the group. L’Oreal USA admits that, from approximately December 2014 to October 2022, Dr. Balooch held the title of Global Vice President and was the head of the L’Oreal Global Technology Incubator (GTI) and California Research Center (CRC), and that his work included a focus on strategic partnerships with start-ups and digital/scientific innovations.

SRX 2007, Answer, ¶27, p. 6-7.

Patent Owner Brightex alleges that:

On July 1, 2011, Dr. Balooch visited BTBP's facilities in San Jose to obtain information on BTBP's technology, and he oversaw a demonstration and planned experiments of the Clarity Pro technology and was provided in-depth information on the new features of the Clarity Pro system. In September of 2011, L'Oreal USA ordered a BTBP Clarity LITE unit for further study, a move which L'Oreal USA asserted would build further "confidence in BTBP."

SRX 2006, Complaint, ¶29, p. 10. In its Answer:

L'Oreal USA admits that, on or around July 1, 2011, Dr. Balooch visited BTBP's facilities in San Jose to attend a demonstration of BTBP's Clarity Pro System. L'Oreal USA admits that, in 2011, BTBP provided L'Oreal USA a BTBP Clarity LITE unit.

SRX 2007, Answer, ¶29, p. 7.

III. THE DIRECTOR SHOULD EXERCISE HER DISCRETION AND DENY INSTITUTION UNDER 35 U.S.C. §314(a)

Pursuant to the Memorandum titled "Interim Processes for PTAB Workload Management," dated March 26, 2025 (SRX 2016) and the Notice Extending Deadline for Discretion Briefing (Paper 6), Patent Owner respectfully submits this brief explaining why the Director should exercise her discretion to deny institution of Petitioner's Petition for Inter Partes Review. In the Interim Processes Memo, the Director identified several considerations, including, among others, "[t]he strength of the unpatentability challenge," "[t]he extent of the petition's reliance on expert testimony," "[s]ettled expectations of the parties, such as the length of time the

claims have been in force,” and “[a]ny other considerations bearing on the Director’s discretion.” SRX 2016, 2-3.

In light of the totality of the evidence presented herein,³ the Director should exercise her discretion and deny institution on all grounds because the settled expectations of the Patent Owner, Brightex. The ‘595 Patent issued more than eight years before L’Oreal filed the Petition, and L’Oreal was fully aware of the ‘595 Patent application filing status from April 2013, within a month of the ‘595 Patent provisional application filing in March 2013. Accordingly, L’Oreal was aware of the ‘595 Patent for more than twelve years before it took any action to contest the validity of the Brightex ‘595 Patent. “[I]n general, the longer the patent has been in force, the more settled expectations should be.” *Dabico Airport Solutions Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2–3 (June 18, 2025). “In particular, the challenged patent has been in force [...]”⁴ eight years, creating settled expectations.” *Id.* In light of the facts set forth herein, Patent Owner Brightex has legitimate “settled expectations” that weigh heavily in favor of granting the present discretionary denial

³ In this Argument, Patent Owner will initially address Factor 5 (same parties) and Factor 6 (Settled Expectations) from the *Fintiv Factors*, with considerations of the “Heavy Reliance on Expert Testimony,” the “Merits of the Petitioner’s Arguments are Weak,” the “Inefficient Use of the Board’s Resources” and the “Unnecessarily Burden the Board’s Resources.” Following that analysis, Patent Owner will then address the other *Fintiv Factors* 1-4 outlined by the Office.

⁴ The ‘595 Patent has been in force over eight years, exceeding even *Dabico*’s ‘169 Patent and creating even stronger settled expectations.

request.

Furthermore, Brightex was recognized as L'Oreal's technology "partner" over at least a 15-year period, which saw Brightex sharing confidential information regarding its patented technology and delivering application products to L'Oreal affiliates pursuant to a product delivery contract. Apart from the age of the subject patent, Patent Owner Brightex had "settled expectations" that L'Oreal would not leverage its confidential position in their technology partnership, or use the confidential information it acquired during their product development projects, in an effort to advance its own interests by filing of an *Inter Partes* Review seeking invalidation of Brightex's patented technology.⁵ While Brightex's "settled expectations" strongly favor a discretionary denial of L'Oreal's Petition for *Inter Partes* Review, there are other facts and issues that also support the present request for discretionary denial.

⁵ Where there is a past relationship between the Petitioner and Patent Owner, the Office has determined that "it is not an appropriate to use of Office resources" to institute an *Inter Partes* Review proceeding. *Gator Bio, Inc. v. Sartorius Bioanalytical Instruments, Inc.*, IPR2025-00633, Paper 9 at 2 (Director July 24, 2025)(" It is not an appropriate use of Office resources where inventors applied for and were issued a patent but now advocate for its unpatentability."); citing *Tessell, Inc. v. Nutanix, Inc.*, IPR2025-00322, Paper 14 at 2 (Director June 12, 2025). "[T]he Office may consider unfair dealings as a factor when determining whether to exercise discretion to deny institution under 35 U.S.C. § 314(a)." *Id.*

As discussed herein, the *Fintiv* factors predominately weigh in favor of denying institution under 35 U.S.C. § 314(a).⁶ A consideration of all the evidence weighs against institution. For the reasons set forth herein, the Director should exercise her discretion to deny institution in the present case.

A. Factor 5: Parties Involved with Petition and Litigation

The Petitioner and the defendant in the Parallel Litigation are the same parties, so “this factor weighs in favor of discretionary denial.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 15 (P.T.A.B. 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.”). Accordingly, *Fintiv* factor 5 weighs in favor of exercising discretionary denial.

B. Factor 6: Other Circumstances Weigh Against Institution

1. The Settled Expectations of the Patent Owner Favor Exercise of Discretionary Denial

The “[s]ettled expectations of the parties, such as the length of time the claims have been in force,” coupled with Petitioner’s delayed filing of the IPR Petition after a long-standing awareness of the patent at issue, should be considered in assessing whether to exercise discretion in denying institution. In addition to the age of the

⁶ See *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18 at 7 (P.T.A.B. May 2, 2022) (weighing *Fintiv* factors and denying institution); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (“*Fintiv*”).

‘595 Patent, the Petitioner L’Oreal’s long-standing awareness of Patent Owner’s 595 Patent application filings, published applications, and issued patent weigh in favor of denying institution. Further, Petitioner’s failure to seek early review of the patents favors denial, which has been found to outweigh the other *Fintiv* considerations.

In the present case, U.S. Patent No. 9,542,595 issued on January 10, 2017 based on a provisional application filed on March 25, 2013. A non-provisional application was filed on March 25, 2014, and the ‘595 Patent non-provisional application was published on October 23, 2014 at U.S. Publ. No. 2014/0314315. As such, the patent at issue has been “in force” for more than eight years. L’Oreal has known about the filing of the ‘595 Patent provisional application since April 2013 (more than twelve years ago), the publication of the ‘595 Patent application since 2014, and the issuance of the ‘595 Patent on January 10, 2017.

For fifteen years from 2009 to 2024, Patent Owner, BrighTex and L’Oreal were product and technology development partners, with L’Oreal receiving extensive disclosures, and developed application products, from BrighTex, including information about BrighTex’s “software and hardware solutions proposed by BrighTex Bio-Photonics for skin and fiber” diagnostics. SRX 2004, 2019 NDA, p. 1.

L’Oreal and Brightex entered into three (3) Non-Disclosure Agreements that spanned a fifteen (15) year period from 2009 through 2024, as follows: (1) term of 2009 NDA was five years from 2009 to 2014, (2) term of 2013 NDA was five years from 2013 to 2018; and, (3) term of 2019 NDA was five years from 2019 to 2024. *Id.*, SRX 2002-2004. As part of their fifteen-year technology development partnership, L’Oreal had a routine business practice of requesting updates on Brightex patent filings and status (including the ‘595 Patent status) as part of meetings between Brightex and L’Oreal personnel. SRX 2015, Decl. of Raj Chhibber, ¶¶6-7, pp. 3-6. Brightex provided the requested information on Brightex patent filings to L’Oreal under the applicable NDA confidentiality protections.

Brightex was recognized in the 2019 NDA as L’Oreal’s “Partner” (SRX 2004 2019 NDA, p. 1); and, as part of this partnership, Brightex disclosed information relating to its facial and hair recognition technology, including technology covered by the ‘595 Patent. SRX 2004, 2019 NDA (“Partner” designation to Brightex). L’Oreal also executed a separate November 2013 Agreement with Brightex requiring Brightex to produce and deliver to L’Oreal affiliates multiple application programs that “takes an image of a person which can be viewed to diagnose features of the person that might be improved with the use of products from the Beauty Industry and that permits the person to select and apply such products to the image

and then view the results (“E-Diagnostic Platform”).”⁷

As admitted by L’Oreal’s Answer in the parallel litigation, Patent Owner Brightex complied with the terms of this November 2013 Agreement by delivering to L’Oreal affiliates the “customized e-diagnostic platform” using its ‘595 patented technology.⁸ L’Oreal admits that the Brightex application programs were the “first to go live” in 2014. *Id.* Despite that admission regarding the “Brightex application being the “first to go live,” L’Oreal now argues that Brightex’s patented technology is obvious in light of prior art.

Based on these facts, L’Oreal had ample notice of the ‘595 Patent filing and issuance since at least as early as April 30, 2013. And, L’Oreal also had awareness of the ‘595 Patent printed application since 2014 (eleven years before IPR filing date) the issued ‘595 Patent since January 10, 2017 (eight years before IPR filing date). Petitioner was fully aware of the ‘595 Patent since 2013, but L’Oreal took no action to address the ‘595 Patent for over twelve years. Instead of taking prompt actions to address the ‘595 Patent, Petitioner waited a year after their final NDA expired in 2024 to file the present 2025 Petition against the ‘595 Patent.

⁷ SRX 2006, Complaint, ¶31, p. 12; SRX 2007, Answer, ¶31, p. 8 (L’Oreal admits to terms).

⁸ SRX 2006, Complaint, ¶33-34, p. 12; SRX 2007, Answer, ¶33-34, p. 8 (L’Oreal admits application program delivered and “was first to go live” in 2014).

Based on the advanced age of the ‘595 Patent and the early (and regular) notice provided to Petitioner regarding the ‘595 Patent filing status, Patent Owner Brightex has legitimate “settled expectations” that weigh heavily in favor of granting the present discretionary denial request.⁹ Furthermore, as a recognized technology “partner” that shared confidential information and technology with L’Oreal for more than fifteen (15) years, Patent Owner Brightex’s “settled expectations” were that L’Oreal would not leverage its confidential position in their partnership, or the confidential information it acquired during their product development projects, to advance its own interests by filing of an *Inter Partes* Review seeking invalidation of a Brightex patent. *See* Discussion at p. 4.

The “settled expectations” of Patent Owner Brightex strongly favor granting this discretionary denial of L’Oreal’s Petition for Inter Partes Review. In fact,

⁹ Although there is no bright-line rule on when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be. *Dabico Airport Solutions Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2–3 (June 18, 2025); *Caihong Display v. Corning, Inc.*, IPR2025-00633, Paper 18 at 2 (July 10, 2025). “This approach aligns with other approaches to settled expectations and incentives, for example, for filing infringement lawsuits.” *Id.*, citing 35 U.S.C. § 286 (“Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.”). *Id.* “Moreover, patent applications (after 18 months) and issued patents are almost always publicly available to provide notice to the public, other inventors, competitors, and commercial interests.” *Id.*, citing 35 U.S.C. § 122. Interested parties may find published patents and patent applications using the Office’s automated search systems as well as publicly available resources on the Internet. *Id.*, citing 35 U.S.C. § 41(i).

Petitioner’s “settled expectations” have been found to outweigh other *Fintiv* factors to be considered in this request. *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363 et al., Paper 10 at 3 (June 6, 2025)(“favors denial and outweighs the above-discussed considerations.”). Based on an assessment of all of the evidence and arguments presented, the petition is denied under 35 U.S.C. § 314(a).

2. *The Petition Relies Heavily On Expert Testimony*

“The extent of the petition’s reliance on expert testimony” should also be considered in assessing whether to exercise discretion to deny institution. SRX 2016, March 26, 2025 Guidance. In this regard, L’Oreal’s IPR Petition places heavy emphasis on the expert testimony declaration of Mr. Milan Sonka. Most notably, the Sonka Declaration (EX 1003 to IPR Petition) is 125 pages long, and supports a Petition that is only 73 pages in length. While a 73-page Petition is an extensive length, the Petitioner’s attachment and reliance on an Expert Report that is almost double that page length shows, as an initial matter, the undue reliance placed on the expert testimony to support the present Petition.

Moreover, neither the Petition nor the expert report contain any advocated claim construction for any claim terms in the ‘595 Patent. This omission places the entire claim construction exercise on the Board to conduct, which is improper. Instead of relying construed claim terms, L’Oreal’s 125-page expert report simply asserts conclusory assertions that are unconnected to any proper claim construction

or proposed definition. The L'Oreal expert can make these conclusory assertions because he is unconstrained by an actual definition or construction of a claim term for the '595 Patent.

While Petitioner does not offer any proposed claim construction in the Petition before the Board, the Petitioner and Patent Owner have completed the submission of claim construction terms to the parallel litigation. As shown on page 4 of the Joint Case Management Statement (SRX 2011), the parties agreed that “[p]ursuant to Fed. R. Civ. P. 26(a)(1), the Patent Local Rules, and the Court’s Patent Case Management and Pretrial Order (Dkt. 34), the parties have exchanged their initial disclosures and their respective Pat. L.R. 3-1 through 3-4, 4-1, and 4-2 disclosures.” SRX 2011, Joint Case Management Statement, p. 4. As shown on page 2 of the Court’s Scheduling Order (SRX 2017) in the parallel litigation, the parties exchanged of proposed claim terms to be construed under Local Patent Rule 4.1 (item H), the parties met and conferred on proposed claim terms under Local Patent Rule 4.1(b) (item I), the parties exchanged proposed claim constructions and extrinsic evidence under Local Patent Rule 4.2(a),(b) (item J), and the met and conferred about the proposed claim constructions to reach a possible agreement on defined terms under Local Patent Rule 4-2(c).

L'Oreal expends significant resources in defining numerous claim terms in the '595 Patent, as shown in by its proposed claim constructions in their Local Patent Rule 4-2 Disclosures. SRX 2018, L'Oreal Disclosure Claim Constructions and Extrinsic Evidence, June 23, 2025; SRX 2011. Accordingly, the Petitioner is apparently advocating for heavy reliance by the Board on 125 pages of its expert's opinions (which are untethered from any proposed claim construction), while the Petitioner has taken extensive claim construction positions in the parallel litigation.

Looking at the substance of the Grounds for Invalidity asserted in the Petition, the expert report advocates only 35 U.S.C. §103 obviousness grounds as support, which are asserted based primarily on a single Bandic prior art reference (Petition EX 1005, U.S. Patent App. Pub. No. 2011/0301441 ("Bandic")). There are no Section 102 grounds of invalidity raised in the Petition by L'Oreal. And L'Oreal and its expert agree that the Bandic reference is not a Section 102 anticipating prior art reference. In the present Petition, L'Oreal relies heavily upon Sonka's expert report to support the 103 obviousness argument by "filling in the gaps" in the teachings of the Bandic reference that do not disclose, teach or suggest the claimed subject matter in the '595 Patent.

One look at the Bandic reference tells the Board why a 125-page expert report is necessary to bolster the Section 103 obviousness grounds. SRX 2019, U.S. Patent

App. Pub. No. 2011/0301441 (“Bandic”). The Bandic reference has a 138-page written disclosure with 217 sheets of drawings – almost two drawings for every page of written description. As shown in SRX 2019, Bandic discloses a “patchwork” over one hundred different embodiments showing different technologies without any indication of how, or why, these different embodiments could be combined together or modified by a person of ordinary skill in the art, to meet all the subject claim limitations in the ‘595 Patent.

The Bandic reference does not disclose a single, unitary embodiment based on a cogent disclosure of technology. As shown in the Bandic (SRX 2019) reference, the phrase “certain embodiments” is used 148 times to reference different technology disclosures. The phrase “some embodiments” is used 26 times to reference different technology disclosures. The phrase “an aspect of the invention” is used 34 times to reference different technology disclosures. And the phrase “an exemplary embodiment” is used 18 times to reference different technology disclosures. There is no teaching in Bandic, or elsewhere, that ties all these different teachings into a coherent disclosure of the subject claims in the ‘595 Patent, which is why Petitioner must rely heavily on the Sonka expert opinion to provide such suggestions and modifications. Essentially, the Sonka expert opinion improperly attempts to “fill in the gaps” in the Bandic “patchwork” of different technologies and

attempts to paint a much different picture of the Bandic teachings than actually disclosed in the reference.

The Board has indicated that “it is not necessary for an expert to explain every aspect of the prior art” (April 25, 2025 FAQs, Q.21), Petitioners’ expert testimony engages in a limitation-by-limitation recitation of the claims that simply “parrots” the claim language without explanation, and fill shortcomings in the prior art through conclusory statements.¹⁰ In our case, Petitioner’s expert report does just that – it “parrots” claim language with conclusory assertions.

And the Board indicated that that expert testimony must be “focused ... to provide helpful context or explain terms of art.”¹¹ Petitioners’ 125-page expert

¹⁰ The PTAB has also found that an expert declaration that merely parrots the petition arguments without providing additional technical detail, analysis, or evidentiary support is entitled to little if any weight. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 (P.T.A.B. Feb. 10, 2023)(precedential) (according “little weight” to declaration testimony that contains a verbatim restatement of a petition’s conclusory assertions without additional supporting evidence or reasoning); *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1340–41 (Fed. Cir. 2020) (affirming Board decision giving no weight to expert testimony that “merely repeated Petitioner’s argument, nearly verbatim, without citation to the basis for his testimony”); *see also Wowza Media Sys., LLC v. Adobe Sys. Inc.*, IPR2013-00054, Paper 12 at 12 (P.T.A.B. Apr. 8, 2013) (“The Declaration . . . appears, for the most part, simply to track and repeat the arguments for unpatentability presented in the Petition [and] . . . is therefore no more helpful tha[n] the Petition in determining where the challenged recitation is found in the references.”).

¹¹ The PTAB’s April 25, 2025 FAQs about the discretionary denial process expressly state “extensive reliance on expert testimony ... may suggest that the questions are better resolved in an Article III court.” April 25, 2025 FAQs, Q.21. The Board emphasized the statutory requirement that “petitions [must] be based on prior art

declaration for a 73-page Petition, however, is not focused testimony and does not provide helpful context. Instead of pointing to a focused teaching or suggestion to combine the different teachings in Bandic, Petitioner L'Oreal relies heavily upon the Sonka expert report to tie loosely connected “embodiments” and “aspects of the invention.” Even with a 125-page expert report, however, Petitioner still fails to provide a sufficient explanation of where the prior art discloses, teaches or suggests the combination of embodiments, or why the Petitioner’s proposed combination was possible, probable or workable based on the Petitioner’s primary Bandic reference.

The Petitioner’s “failure to provide focused expert testimony may weigh against institution.” *Id.* The present Petition is heavily reliant on expert testimony, which suggests that these invalidity arguments are better resolved by the Article III court.¹² Therefore, Petitioner’s heavy reliance on its expert testimony supports a discretionary denial.

3. The Merits Of The Petition Are Weak

“The strength of the unpatentability challenge” should also be considered in assessing whether to exercise discretion to deny institution. SRX 2016, March 26,

patents and printed publications,” as opposed to expert opinions. *Id.*

¹² The PTAB’s April 25, 2025 FAQs about the discretionary denial process expressly state “extensive reliance on expert testimony ... may suggest that the questions are better resolved in an Article III court.” April 25, 2025 FAQs, Q.21. The Board emphasized the statutory requirement that “petitions [must] be based on prior art patents and printed publications,” as opposed to expert opinions. *Id.*

2025 Guidance. “A full merits analysis is not necessary as part of deciding whether to exercise discretion not to institute, but rather the parties may point out, as part of the factor based analysis, particular ‘strengths or weaknesses’ to aid the Board in deciding whether the merits tip the balance.” *Fintiv*, Paper 15 at 15.

As noted in the preceding section, Petitioner L’Oreal has to place undue reliance on the 125-page expert declaration of Milan Sonka because of the weakness in its primary Bandic reference. The Sonka Declaration (EX 1003 to IPR Petition) is 125 pages long and supports a Petition that is only 73 pages in length. The need to support their Petition with such an extended expert report is indicative of the weakness of the patentability challenge.

Moreover, the Petition and the expert report do not contain any advocated claim construction for any terms in the ‘595 Patent. Petitioner has proposed claim constructions in the parallel proceeding, but Petitioner wants to place the burden of claim construction in the Petition on the Board. Petitioner L’Oreal’s actions demonstrate the weakness in their Bandic-based invalidity arguments, including L’Oreal’s conspicuous omission of any claim construction from their Petition (even though they apparently possessed the precursors to such positions in the parallel litigation). Hiding their claim construction positions from the Board in this burden-shifting exercise only makes sense if L’Oreal wants to hide the weakness of their

patentability challenge based on Bandic.

Looking at the substance of the Grounds for Invalidity, Petitioner only asserts 35 U.S.C. §103 obviousness grounds to support the Petition. There are no Section 102 grounds of invalidity grounds raised in the Petition by L'Oreal. L'Oreal and its expert agree that the Bandic reference does not disclose all claim elements and does not constitute Section 102 anticipating prior art reference. To “fill in the gaps” in the teachings of Bandic reference, the Petitioner has to rely on 125 pages of Sonka’s expert report, which is a tactic that demonstrates the weakness in their obviousness challenge.¹³

The primary reference common to all grounds of obviousness is the Bandic prior art reference (Petition EX 1005, U.S. Patent App. Pub. No. 2011/0301441 (“Bandic”)). As discussed in the preceding section, Bandic is a 138-page written disclosure with 217 sheets of drawings. Essentially, the Bandic reference discloses

¹³ Petitioner fails to perform a proper obviousness analysis, which requires, among other things, ascertaining the “differences between the prior art and the claims at issue.” *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *see also In re Stepan Co.*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017) (“Whether a rejection is based on combining disclosures from multiple references, combining multiple embodiments from a single reference, or selecting from large lists of elements in a single reference, there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.”). The Petition’s obviousness analysis is insufficient for this additional reason.

a “patchwork” of over one hundred different embodiments and “aspects of the invention” that fail to provide any substantive indication of how, or why, these different embodiments could be combined together, or modified by a person of ordinary skill in the art, to meet all the limitations in the subject claims of the ‘595 Patent.¹⁴ For this reason, the patentability challenges based on the Bandic references are, at best, weak.

Moreover, Petitioner does not sufficiently explain where in Bandic’s many disparate embodiments the Examiner’s allowed combinations may be found and

¹⁴ *Captioncall, LLC v. Ultratec, Inc.*, IPR2020-01215, 2021 WL 278381, at *7 (P.T.A.B. Jan. 27, 2021) (denying institution when petitioner relied on “distinct” embodiments from a reference and another reference explaining that “[a]nticipation requires all elements arranged as in the claim without the need to pick and choose elements from different disclosures”); *Masimo Corp. v. Apple Inc.*, IPR2023-00745, Paper 44 (final written decision), 36 (P.T.A.B. Oct. 15, 2024) (determining that the challenged claim is not unpatentable, explaining: “In essence, Petitioner invites the Board to piece together a single theory that meets all claim elements from these disparate theories that each require distinct structures....”) (*citing Amazon.com, Inc., et al. v. Avago Technologies General IP (Singapore) PTE. LTD.*, IPR2017-01112, Paper 11, at 13 (P.T.A.B. Aug. 23, 2017) (“Petitioner is inviting us to assume the role of archeologist of the record, which invitation we decline.”)); *Nearmap US, Inc. v. Eagle View Technologies, Inc.*, IPR2024-00716, Paper 9, 18 (P.T.A.B. Oct. 9, 2024) (denying institution of inter partes review, explaining that “[t]he question before us is not whether we could come up with a way to understand how the asserted prior art could render the challenge claims unpatentable, but rather did Petitioner provide the arguments and evidence to show that the challenged claims are unpatentable.”); *Netflix, Inc. v. DivX, LLC*, 84 F.4th 1371, 1379 (Fed. Cir. 2023) (“While the Board should review a petition holistically, it is not obligated to cobble together assertions from different sections of a petition or citations of various exhibits in order to infer every possible permutation of a petitioner’s argument.”)

merely presents cumulative prior art of the nature already considered by the Office in the original prosecution, such as LaForgia. In the notice of allowance mailed on August 31, 2016, the Examiner explained:

The following is an examiner's statement of reasons for allowance: based on applicant's amendment/persuasive arguments, filed on 8/23/16, claims 1-2, 4, 7-10, 12-16 and 18-20 (renumbered as 1-15) are allowed.

L'Oreal EX. 1002, p. 12 (Notice of Allowability). A review of the amendments by the then-Applicant reveals that the Examiner was convinced, for example, that the combination of the color calibration limitation and the simulated application limitation in Claim 8 was allowable. *See, e.g.*, 8/23/16 Amendment, p. 2-9 (L'Oreal EX. 1002 at 32-39), including amendments made to Claim 8 as follow:

8. **(Currently amended)** ~~The method of claim 1, further comprising:~~ A method for analyzing a skin of a subject and identifying a cosmetic product for the subject, comprising:

at an electronic device with one or more processors and memory storing one or more programs for execution by the one or more processors:

calibrating colors of a first digital image, wherein the first digital image depicts at least a portion of a face of the subject, and the first digital image includes a plurality of pixels;

displaying the first digital image; ~~and~~
dividing the display of the first digital image into two sides, wherein one side of the first digital image is displayed with no cosmetic product applied, and one side of the first digital image is displayed with a simulated application of a cosmetic product;

transferring the first digital image; and

transferring information of a cosmetic product,
wherein skin pixels in the plurality of pixels are identified,
color space values are identified from the skin pixels, and
the cosmetic product is identified at least based on the
color space values.

8/23/16 Amendment, p. 3-4 (L'Oreal EX. 1002 at 33-34). Depicted visually, this claimed concept can be seen in Figure 4B of the '595 Patent:



Figure 4B

Bandic fails, wholly and completely, to teach or render obvious the simulated application of a cosmetic product (debatably the entire purpose of the claim). Petitioner relies on Bandic's "simulation tools 132," "algorithm 150 for determining a skin state 158," and providing a split-display to "also include a split image with the original face on one half and a new simulated output on the other half." Petition at 24-25. But Bandic's simulation tools (132) are "prediction/simulation tools" of

treatments after a period of time, and thus its display has nothing to do with the ‘595 patent’s cosmetic product *as it would appear on one side of the first digital image*. Bandic at [0423].

Despite this, Petitioner argues “[b]ecause the simulation tool 132 could simulate product usage on the facial image, a POSITA would find it obvious that the simulation could be for a cosmetic product.” Petition at 25. But this statement is simply a repeated unsupported conclusion of Sonka. *See* EX1003 at ¶ 109 (“A POSITA would find it obvious that product usage simulation could include cosmetic product simulation.”). There is no support for such a conclusion, and citations to a different tool in Bandic (skin type determination tools 130) do not cure this deficiency. Bandic does not disclose the simulation of a cosmetic product; it discloses the simulation of a skin treatment over time. This flaw in Bandic is pervasive and contaminates both the Petition and Sonka’s analysis.

As set forth above, Petitioner and its expert still fail to provide a sufficient explanation of where the prior art discloses, teaches or suggests the combination of embodiments or why the Petitioner’s proposed combination was possible, probable or workable. The Petition’s weak merits weigh heavily against institution. Accordingly, the Petition’s scattershot presentation of weak challenges to the ‘595

Patent based on the Bandic reference further supports discretionary denial.¹⁵

4. *Instituting This Petition Would Be An Inefficient Use of The Board's Resources*

Under both the prior discretionary denial standards (including that set forth in *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 (P.T.A.B. Mar. 6, 2019) (informative)) and pursuant to the new factors set forth in the Guidance, the present request for discretionary denial should be granted because allowing the Petition to proceed would be an inefficient use of the Board's resources as set forth herein. SRX 2016, March 26, 2025 Guidance. The Petition only presents a weak invalidity challenge and the Petition places undue reliance on their expert testimony to “fill in the gaps” in the obviousness claims based on the Bandic reference.

Additionally, the challenged patent has been in force for more than 8 years and the Petitioner has known about the challenged patent since the filing of the provisional application in 2013 (more than twelve years ago). The Patent Owner has strong settled expectations based on its long-standing technology and product

¹⁵ See *Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10–11 (P.T.A.B. Nov. 7, 2018) (informative); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 at 41–43 (P.T.A.B. Jan. 24, 2019) (informative) (denying institution where the petitioner showed a reasonable likelihood of success on just 2 of 23 challenged claims); *Samsung Electronics America, Inc. et al. v. Collision Communications, Inc.*, IPR2024-01247, Paper 14, 21–22 (P.T.A.B. Feb. 7, 2025) (denying institution where the petitioner failed to show a reasonable likelihood of success for some of challenged claims).

development partnership with L’Oreal. Petitioner has not provided any persuasive reasoning why an inter partes review is an appropriate use of Board resources. *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025- 00408, Paper 21 at 2–3 (Director June 18, 2025). While there may be certain reasons why the Office should review the challenged patent, in the absence of persuasive reasoning why an IPR proceeding is an appropriate use of the Office resources, the Office should be disinclined to disturb the settled expectations of Patent Owner.

5. *Instituting This Petition Would Unnecessarily Burden The Board*

Under both the prior discretionary denial standards (including those set forth in *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 (P.T.A.B. Mar. 6, 2019) (informative)) and pursuant to the new factors set forth in the Guidance, all the facts and circumstances in this matter indicate that exercising discretionary denial would allow the Board to allocate resources elsewhere. The fifteen-year technology development partnership between Brightex and L’Oreal supports a discretionary denial because the Office has determined that, where there has been a past relationship between the Petitioner and Patent Owner, “it is not an appropriate to use of Office resources” to institute an *Inter Partes* Review proceeding.¹⁶

¹⁶ *Gator Bio, Inc. v. Sartorius Bioanalytical Instruments, Inc.*, IPR2025-00633, Paper 9 at 2 (Director July 24, 2025)(“ It is not an appropriate use of Office resources where inventors applied for and were issued a patent but now advocate for its

Requiring the Board to adjudicate the validity of patent claims in the present Petition would not be an appropriate use of Office resources given the extensive background between the parties. This Petition would place an unnecessarily heavy burden on the Patent Office, which warrants the Director exercising discretion to deny the challenge regarding discretionary denial pursuant to the Board's Guidance. SRX 2016, March 26, 2025 Guidance.

Instituting review of this Petition is therefore unlikely to streamline any dispute or expand the industry's freedom to operate in this space. Therefore, granting the Patent Owner's request for a discretionary denial promotes the underlying purpose of IPR proceedings.¹⁷ The Director should deny institution of the present Petition.

C. **Fintiv Factors 1-4: Mixed Support for Granting Or Rejecting Request for Discretionary Denial Does Not Overcome Favorable *Fintiv* Factors 5 and 6**

Fintiv Factors 1 to 4 present the Director with, at best, only mixed support for granting, or rejecting, the present request for discretionary denial. Based on the mixed results under these four *Fintiv* factors, the prior analysis of the *Fintiv* factors

unpatentability.”); *citing Tessell, Inc. v. Nutanix, Inc.*, IPR2025- 00322, Paper 14 at 2 (Director June 12, 2025).

¹⁷ See Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48680-01 (Aug. 14, 2012) (codified at 37 C.F.R. § 42.100 (2017)).

five and six clearly establish that instituting the present IPR proceeding would be: (1) contrary to the Patent Owner's settled expectations, (2) an inefficient use of the Board's resources based on the weakness of the case and the Petitioner's heavy reliance on expert testimony, and (3) an unnecessary burden on the Board's resources under a holistic view of all the facts and circumstances in this matter.

Granting this discretionary denial is appropriate in the present case because instituting review of this Petition is unlikely to streamline any dispute or expand the industry's freedom to operate in this space. The present discretionary denial promotes the purposes of IPR proceedings.

1. Factor 1: The Parallel Litigation Has Been Stayed, But The Parties Have Consented to the Magistrate Handling All Aspects of the Case

On July 7, 2025, the Northern District of California stayed the parallel litigation pending the outcome of the IPR filed by L'Oreal. *Brightex Bio-Photonics, LLC v. L'Oreal USA*, Civil Action No. 3:24-cv-07919-JCS (N.D. Cal.), D.E. No. 59. While the Court's stay of the underlying parallel litigation would appear to weigh against granting this request for a discretionary denial, the issuance of a stay does not preclude granting a request for discretionary denial, and shown in *Amazon v. Virtamove*, IPR2025-00561, Paper 9, at 2 (July 11, 2025).

In *Amazon*, "the district court proceeding involving Petitioner and the challenged patents has been stayed," and that stay was found to weigh against a

discretionary denial. But the Director granted the discretionary denial request because “other factors” overcame the weight of an issued district court stay of that proceeding, such as the “strong settled expectations” of the Patent Owner based on the age of the patent at issue. *Id.*, citing *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-0040, Paper 21 at 2-3 (June 18, 2025).

Moreover, both parties have consented to Magistrate Judge Spero for all purposes in this matter. SRX 2008, L’Oreal Consent; SRX 2009, Brightex Consent to Magistrate. Prior to the stay granted just last month, the Magistrate Judge had set a claim construction hearing for October 29, 2025 and dispositive motion deadlines to be set after the Claim Construction Order, before setting a trial date in 2026. Accordingly, the Magistrate Judge has the ability, if the present request for discretionary denial is granted, to re-establish comparable dates and deadlines for the parallel litigation without a significant delay in that proceeding. Accordingly, Patent Owner Brightex contends that this factor, when viewed on the whole, does not preclude the grant of its request for a discretionary denial.

2. Factor 2: The Board Would Likely Issue A Final Written Decision Slower Than A Magistrate’s Trial

Fintiv factor 2 weighs in favor, or is at least is neutral, with respect to the requested discretionary denial because, if the district court’s stay is lifted, Patent Owner Brightex believes that the Magistrate’s trial date will come before the

statutory deadline for a final written decision. In Factor 2, the Board weighs “proximity of court’s trial date to statutory deadline for final written decision.” *Fintiv*, IPR2020-00019, Paper 11 at 9.

Should the Director not exercise her discretion to deny institution, the Board is expected to decide whether to institute the proceeding by December 15, 2025, with a final written decision date possibly up to a year later on December 15, 2026. 37 C.F.R. § 42.107; 37 C.F.R. § 42.100. This factor weighs against institution because a trial could be scheduled by the Magistrate in the parallel litigation (if the stay is lifted) before the final written decision date.

Both parties have consented to Magistrate Judge Spero for all purposes in the parallel litigation, which should all the underlying litigation to proceed more quickly than average Northern District of California “time to trial” survey results. SRX 2008 and 2009, Parties Consent to Magistrate for all Trial Purposes, *Brightex v. L’Oreal*, Civil Action No. 3:24-cv-07919, DE. 19 and 20.¹⁸ As noted in the Guide to the

¹⁸ SRX 2016, March 26, 2025 Guidance (“[T]he Board may consider any evidence that the parties make of record that bears on the proximity of the district court’s trial date or the ITC’s final determination target date, including median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides.”). Accordingly, the Magistrate should be able most schedule a trial much earlier than the recent statistics on “United States District Courts – National Judicial Caseload Profile,” published by www.uscourts.gov, show that for a 12-month period ending March 31, 2025, a median time-to-trial in the Northern District of California for civil cases. SRX 2010, Time to Trial, N.D. Cal. Statistics.

Federal Magistrate Judge System, as follows:

Consenting to a Magistrate Judge also offers the parties the prospect of an early, firm trial date. Magistrate Judges often have more flexible trial schedules than District Judges because they do not preside over felony cases, which are given priority and may bump civil trials. The parties are also more likely to consent when a Magistrate Judge has already become familiar with a case because of his or her pre-trial management and discovery supervision in the case. The parties may feel comfortable with the Magistrate Judge from that experience.

“A Guide to the Federal Magistrate Judge System,” Peter G. McCabe, Aug. 2014, p.

59, [FBAWhitePaperonMagistrateJudges.pdf](#); <https://www.fedbar.org/judiciary-division/wp-content/uploads/sites/5/2022/08/FBAWhitePaperonMagistrateJudges.pdf>.

Brightex believes that by the time any final written decision in the present Petition issues, the Magistrate Judge in the Northern District of California could have concluded the parallel litigation. “If a district court’s trial date is earlier than the Board’s projected statutory deadline for a final written decision, the Board generally has weighed this fact in favor of exercising discretion to deny institution.” *TMobile USA, Inc., et al. v. Wireless Alliance*, IPR2024-00608, Paper 16 (P.T.A.B. Sept. 3, 2024) (exercising discretion to deny institution of inter partes review). Accordingly, the district court would likely address issues relating to the validity of the ’595 patent in a trial that, by most measures, should occur many months before

the Board would issue a final written decision if the parallel court stay is lifted. Under this circumstance, the second *Fintiv* factor should favor discretionary denial, or at least be neutral toward granting the denial.

3. Factor 3: The Court And Parties Have Invested Heavily In The Parallel Litigation

Fintiv factor 3 weighs in favor of discretionary denial, and against institution, because the parties and the Court have invested significant resources in the Parallel Litigation. The Board weighs “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, IPR2020-00019, Paper 11 at 9.

In the parallel litigation, fact discovery recently opened on April 4, 2025. On March 21, 2025, Plaintiff served its first sets of interrogatories and requests for production. On May 5, 2025, Defendant responded to the interrogatories, and Defendant has been exchanging communications with the Plaintiff on the sufficiency of those responses. On May 5, 2025, Defendant responded to Plaintiff’s requests for production with 41 demands to revise and edit the district court’s Standard Protective Order before producing their responsive documents.

After extensive negotiations, the parties agreed to a Protective Order, which was entered by the district court. *Bightex Bio-Photonics v. L’Oreal*, Civil Case No. 3:24-cv-07919-JCS, D.E. 54. Defendant had begun to produce responsive

documents to these requests for production on June 13, 2025, and Defendant has produced thousands of pages of documents after entry of the Protective Order. The Plaintiff and Defendant have collectively produced over 64,000 pages of documents, to date.

The parties have exchanged preliminary positions on claim construction and invalidity. SRX 2019, L'Oreal's Proposed Claim Construction, SRX 2013, L'Oreal Invalidity Contentions. In fact, the Plaintiff and Defendant have exchanged mandatory Patent Rule disclosures under Local Patent Rules 3-1, 3-2, 3-3, 3-4 and 4-1 and 4-2 disclosures, and the parties have exchanged Initial Disclosures required under the Federal and Local Rules. SRX 2011, Joint Case Management Statement, p. 4, lns. 7-9.

A deposition had been scheduled, and rescheduled, several times regarding the sufficiency of the Defendant's document production. Additional depositions of the Defendant were contemplated to be taken by the Plaintiff prior to the district court's institution of a stay. While discovery was not completed, discovery in this matter was proceeding and substantial steps had been taken to advance discovery proceedings. In fact, L'Oreal's Motion to Stay the district court proceeding acknowledged that "limited discovery has occurred" as of June 13, 2025.

Thus, the district court and the parties have already invested significant resources in the parallel litigation, and will continue to invest significant resources in the Parallel Litigation if this discretionary denial request is granted; which, accordingly, weighs against institution.¹⁹ Accordingly, Patent Owner Brightex contends that this factor, when viewed on the whole, favors granting the request for a discretionary denial.

4. Factor 4: There Is Significant Overlap Between Issues Raised In This Petition And In The Parallel Litigation

Fintiv Factor 4 weighs in favor of a discretionary denial, and against institution, because there is significant overlap between the Petition and the Parallel Litigation. Under this factor, the Board weighs “overlap between issues raised in petition and in parallel proceeding.” *Fintiv*, IPR2020-00019, Paper 11 at 9.

There is only one patent currently at issue in the parallel litigation, the ‘595 Patent, which is the same patent at issue in the L’Oreal *Inter Partes* Petition. On May 20, 2025, Defendant L’Oreal produced their invalidity contentions to Patent Owner, and L’Oreal contended in those pleadings that the ‘595 Patent was invalid under Section 103 based on the same prior art cited in their *Inter Partes Petition*.

¹⁹ See *NXP USA*, PGR2022-00005, Paper 18 at 9-10 (weighing factor 3 in favor of discretionary denial); *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, 2025 WL 947070, at *1 (P.T.A.B. Mar. 28, 2025) (Order Granting Director Review, Vacating the Decision Granting Institution, and Denying Institution of Inter Partes Review) (finding “factor 3 strongly favors discretionary denial”).

SRX 2013, L'Oreal Invalidity Contentions.

Based on a comparison of the invalidity positions, all of the invalidity positions taken by L'Oreal in the Petition are already covered in L'Oreal's Invalidity Contentions set forth in the parallel litigation. *See* SRX 2013, Invalidity Contentions. Specifically, L'Oreal's IPR Petition identifies four Section 103 grounds for invalidity based on the following Bandic and Rubinstenn references.

2. Grounds

Ground	Claim(s)	Reference(s)
1 (§103)	5, 6, 11	Bandic
2 (§103)	5, 9, 11	Rubinstenn103, Bandic
3 (§103)	1, 2, 3, 4	Rubinstenn103, Rubinstenn300, Bandic
4 (§103)	9, 13, 10, 15, 7, 12, 8, 14	Rubinstenn103, Rubinstenn300, Bandic

And L'Oreal's Section 103 grounds for invalidity in their Invalidity Contentions identify the same basis for invalidity based on the same Bandic and Rubenstein references. SRX 2013, Invalidity Contentions, p. 8 (see below).

APPX.	PRIOR ART GROUND
A	Bandic , alone or in combination with the knowledge of a POSITA.
B	Rubinstenn '103 , alone or in combination with the knowledge of a POSITA and/or Bandic.
C	Rubinstenn '103 , alone or in combination with the knowledge of a POSITA and/or one or more of Bandic and Rubinstenn '103.

L'Oreal's invalidity contentions in the Northern District of California also assert

additional invalidity contentions not found in the L'Oreal Petition, but all the invalidity arguments raised in L'Oreal's IPR Petition are duplicated and covered by the L'Oreal positions in the parallel litigation.²⁰

Fintiv factor 4, therefore, weighs strongly in favor of discretionary denial because “the claims challenged in the petition are also at issue in district court,” and the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as included in the parallel litigation. *Fintiv* at 12-13. Because there is significant overlap between the issues raised in the Petition and the parallel litigation, Patent Owner Brightex contends that this factor, when viewed on the whole, favors granting the request for a discretionary denial.

IV. CONCLUSION

For the reasons above, Petitioner respectfully requests that the Director grant this request for a discretionary denial of the present Petition.

²⁰ L'Oreal has submitted a *Sotera* stipulation. See SRX 2012, L'Oreal's *Sotera* Stipulation. As interpreted by the PTO, however, *Sotera* stipulations are not exclusively controlling over decisions to institute IPR proceedings. As such, the existence of the stipulation, by itself, should be considered, but it is not determinative of the Director's decision on this denial request.

Dated: August 11, 2025

Respectfully submitted,

By /s/ Michael W. Doell
Michael W. Doell (Reg No. 79,493)
1700 Pacific Avenue, Suite 4750
Dallas, Texas 75201
Telephone: (214) 466-1270
Facsimile: (214) 635-1842
Email: mike.doell@bjciplaw.com

D. Scott Hemingway (Reg. No. 36,366)
Hemingway & Hansen, LLP
1700 Pacific Ave., Suite 1820
Dallas, TX 75201
Telephone: (214) 292-8301

Counsel for PATENT OWNER

**CERTIFICATE OF WORD COUNT
UNDER 37 CFR §42.24(D)**

The undersigned certifies that the word count for this *Petition for Inter Partes Review* totals 12,056 words, excluding parts appropriately exempted by 37 C.F.R. § 42.24(a)(1). The word count was made using the built-in word count function in the Microsoft® Word software used to prepare this document.

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By /s/ Michael W. Doell
Michael W. Doell (Reg No. 79,493)
1700 Pacific Avenue, Suite 4750
Dallas, Texas 75201
Telephone: (214) 466-1270
Facsimile: (214) 635-1842
Email: mike.doell@bjciplaw.com

CERTIFICATE OF SERVICE

I certify that the above captioned **PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** and all associated exhibits were served in their entireties on August 11, 2025, upon the following parties via electronic mail.

Cory Owan (Reg. No. 79,841)
owan-ptab@perkinscoie.com
Ramsey Al-Salam
al-salam-ptab@perkinscoie.com
Jessica Delacenserie
delacenserie-ptab@perkinscoie.com
Sarah Anderson
anderson-ptab@perkinscoie.com

PERKINS COIE LLP
1301 Second Avenue, Suite 4200
Seattle WA 98101-3099
206.359.8000 (phone)
206.359.9000 (fax)

Dated: August 11, 2025

By /s/ Michael W. Doell
Michael W. Doell (Reg No. 79,493)
1700 Pacific Avenue, Suite 4750
Dallas, Texas 75201
Telephone: (214) 466-1270
Facsimile: (214) 635-1842
Email: mike.doell@bjciplaw.com

Counsel for PATENT OWNER