

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TREASURE GARDEN, INC.,

Petitioner,

v.

ATLEISURE, LLC

Patent Owner

Case IPR2025-01005

Patent 8,104,492

**PATENT OWNER'S REQUEST TO DIRECTOR FOR DISCRETIONARY
DENIAL OF PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT 8,104,492**

EXHIBITS

Exhibit No.	Description
2001	Petitioner's Noninfringement and Invalidity Contentions in <i>ATLeisure, LLC v. Treasure Garden, Inc.</i> , Case No. 1:24-cv-02270
2002	Declaration of Jason Bliss, dated July 15, 2025

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I. INTRODUCTION

This request is submitted by Patent Owner ATLeisure, LLC (“ATLeisure”) to the Director of the U.S. Patent and Trademark Office (“USPTO”) pursuant to the Director’s Memorandum “Interim Processes for PTAB Workload Management” dated March 26, 2025 (the “March 26, 2025 Memorandum”). This is ATLeisure’s separate brief, pursuant to the March 26, 2025 Memorandum, requesting the discretionary denial of the Petitions of Treasure Garden, Inc. (“Petitioner”) for *inter partes* review (“IPR”) of U.S. Patent No. 8,104,492 entitled “Adjustable offset umbrella” (“the ‘492 Patent”). This brief is timely as it is submitted within two months of June 16, 2025, the date on which the PTAB entered its Notice of Filing Date Accorded to Petition.

Pursuant to the March 26, 2025, Memorandum and the relevant factors discussed herein, the Director should exercise her discretion and deny institution of *inter partes* review (“IPR”) of the ‘492 Patent.

II. FACTUAL BACKGROUND

A. The '492 Patent

Independent Claim 1 is directed to an umbrella 10 comprising a main pole 14 having a lower end for support by a support surface and extending generally upward to an upper end. The umbrella includes a sliding member 16 associated with the main pole and selectably moveable thereon between lower and upper locations along the main pole. The umbrella also includes locking means 74 for releasably securing the sliding member to the main pole at a selected location along the main pole, and an umbrella canopy 20 having a central region.

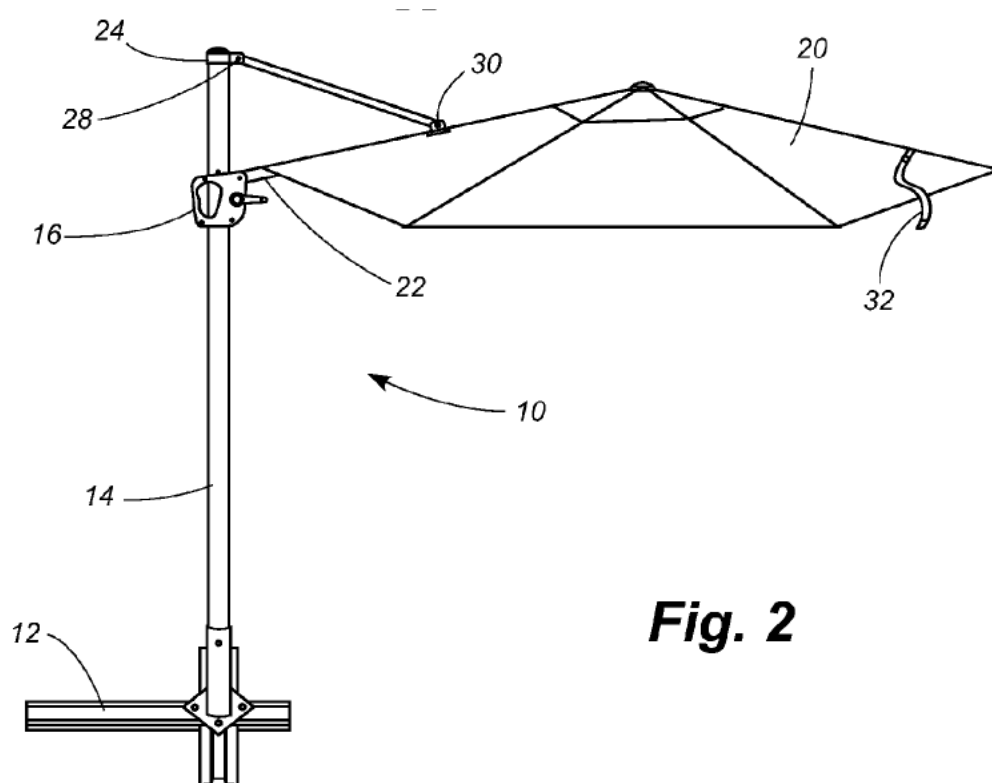


Fig. 2

Figure 2 of the '492 Patent

The umbrella also includes an arm 22 associated with the central region and extending radially therefrom to an outer end operatively associated with the sliding member, and a brace 26 having a first end pivotably attached to an upper portion of the pole above the sliding member and a second end pivotably attached to the arm. The umbrella also includes a winding mechanism having a winder hub 84 mounted to the sliding member and movable therewith. The umbrella further comprises a line 60 having a first end that winds around the winder hub, an intermediate portion extending from the winder hub along the arm to the umbrella canopy, and a second end that engages the umbrella canopy.

Rotation of the winder hub tensions or relaxes the line depending upon the direction of rotation of the winder hub. The operation of the winding mechanism to apply tension to the line opens and closes the umbrella canopy in response to movement of the line. As shown by Figure 6, reproduced below, the angle of the umbrella canopy with respect to the main pole can be controlled by moving the sliding member along the main pole. In other words, the patented invention provides separate mechanisms for opening and closing the umbrella canopy and for adjusting the angle of the umbrella canopy, which provides for enhanced control, which is in contrast to the prior art.

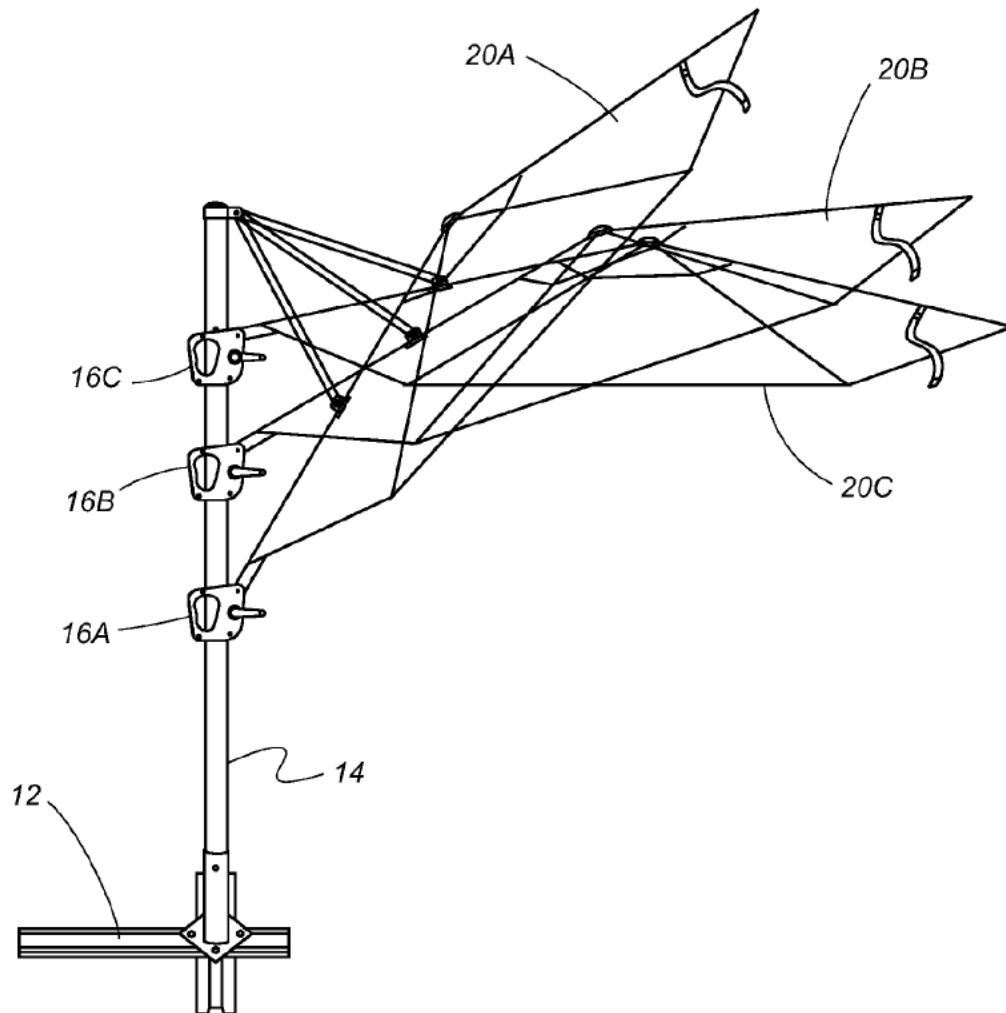


Figure 6 of the '492 Patent

B. Relevant Prosecution Details for the '492 Patent

The '492 patent claims priority to U.S. Provisional Patent Application Serial No. 61/050,353, which was filed May 5, 2008, and included six claims, including claims 2-4, which were each directed to respective “locking means” embodiments. *See* EX1002 at 171. On May 5, 2009, the U.S. Non-provisional Patent Application Serial No.

12/435,640 was filed and included the original six claims filed in the provisional application. EX1002 at 169-191.

On June 24, 2010, the Examiner issued a first Office Action, rejecting the claims as anticipated over U.S. Patent No. 5,937,882 to Harbaugh, owned by the present Patent Owner, and as obvious further in view of U.S. Patent No. 6,478,037 to Tung and U.S. Patent No. 5,284,171 to Liu. See EX1002 at 139-142.

Applicant filed a response on February 3, 2011. EX1002 at 125. The response included no claim amendments and argued against the rejections of record. EX1002 at 126-128. On April 12, 2011, the Examiner issued a final Office Action sustaining the rejections of record. See EX1002 at 102-103.

After an Examiner Interview on May 6, 2011, Applicant filed a response on May 16, 2011, along with a Request for Continued Examination. EX1002 at 92-106. In the response with the RCE, Applicant amended independent Claim 1 and also added new dependent Claim 7. EX1002 at 92-96. Claims 2-6 were maintained in their original form as filed in the provisional application, including claims 2-4 directed to three “locking means” embodiments. *Id.*

On August 23, 2011, the Examiner issued a Notice of Allowance withdrawing the rejections of record and making a minor Examiner’s Amendment. EX1002 at 67-

69. On December 8, 2011, Applicant paid the issue fee. EX1002 at 58. The '492 patent issued on January 31, 2012. EX1003.

For context, independent claim 1 of the '492 Patent articulates the invention as follows:

1. An umbrella comprising:
a main pole having a lower end for support by a support surface and extending generally upward to an upper end;
a sliding member associated with the main pole and selectably moveable thereon between lower and upper locations along the main pole;
locking means for releasably securing the sliding member to the main pole at a selected location along the main pole;
an umbrella canopy having a central region;
an arm associated with the central region and extending radially therefrom to an outer end operatively associated with the sliding member;
a brace having a first end pivotably attached to an upper portion of the pole above the sliding member and a second end pivotably attached to the arm;
a winding mechanism having a winder hub around which a line can be wound, the winder hub being mounted to the sliding member and movable therewith;
a line having a first end that winds around the winder hub, an intermediate portion extending from the winder hub along the arm to the umbrella canopy, and a second end that engages the umbrella canopy;
wherein rotation of the winder hub tensions or relaxes the line depending upon the direction of rotation of the winder hub, and
wherein operation of the winding mechanism to apply tension to the line opens and closes the umbrella canopy in response to movement of the line; and
wherein the angle of the umbrella canopy with respect to the main pole can be controlled by moving the sliding member along the main pole.

C. The Litigation Between ATLeisure and Petitioner

On May 23, 2024, ATLeisure filed a lawsuit against Petitioner for patent infringement entitled *ATLeisure, LLC, v. Treasure Garden, Inc.*, Case No. 1:24-cv-

02270-TWT (N.D. GA) (the “Litigation”). The complaint alleges that Petitioner infringes the ‘492 Patent.

On July 24, 2024, the parties exchanged initial disclosures. On July 25, 2024, the District Court entered its scheduling order adopting the parties’ proposed schedule, including claim construction briefing due on January 16, 2025 (ATLeisure) and February 6, 2025 (Treasure Garden). On August 23, 2024, ATLeisure served its infringement contentions, stating that Petitioner infringes claims 1 and 5-7 of the ‘492 patent. On September 23, 2024, Petitioner served its noninfringement and invalidity contentions. Exhibit 2001. Petitioner’s contentions stated that claims 1-7 were invalid under either §102 or §103 based on twenty different grounds (specific to subsets of claims). Since the outset of litigation (including the consolidated case), the parties have exchanged multiple rounds of discovery requests and responses, and ATLeisure has produced more than 20,000 pages. The parties completed claim construction briefing and on February 28, 2025, the District Court indicated it would appoint a special master to determine claim construction. While the parties have agreed on a special master, they await his appointment to resolve claim construction.

On November 25, 2024, ATLeisure filed an action captioned *ATLeisure, LLC, v. Qingdao Activa Shade Inc. and Activa Leisure, Inc.*, Case No. 1:24-cv-05424-TWT (N.D. GA), manufacturers of the products accused of infringement in the

action against Treasure Garden. On April 9, 2025, the District Court consolidated both the action against Treasure Garden and the action against Qingdao Activa Shade and Activa Leisure¹. The parties submitted a proposed scheduling order, which (pursuant to local rules) links trial and other deadlines off the claim construction ruling, which has yet to be issued. As such, there is no trial date currently set.

On May 22, 2025, 364 days after the lawsuit was filed against Petitioner, it filed two petitions for *Inter Partes* Review. On the same day, Petitioner filed a motion to stay the litigation pending the outcome of these proceedings. No ruling has been made by the District Court.

D. The Additional Litigation Involving the ‘492 Patent

In addition to the ongoing consolidated litigation against Petitioner (and Defendants Qingdao Activa Shade, Inc., and Activa Leisure, Inc.), the ‘492 patent is well-known in the industry, having been asserted in four other actions. Specifically, the ‘492 patent has been asserted in *ATLeisure, LLC v. Red Star Traders, LLC*, Case No. 1:12-cv-02253-TWT (N.D. Ga.); *ATLeisure, LLC v. Ace Evert, Inc.*, Case No. 1:12-cv-01260-CAP (N.D. Ga.); *ATLeisure, LLC v. Sunvilla Corp.*, Case No. 1:20-cv-04662-TWT, (N.D. Ga.); and *ATLeisure, LLC v. Lowes*

¹ The Consolidated Action is Case No. 1:24-cv-02270-TRJ.

Home Centers, LLC, Case No. 6:22-cv-00682-WWB-RMN (M.D. Fla.). All of these disputes were resolved prior to a final judgment.

Not only has the ‘492 patent been the subject of multiple prior litigations, but it has also been the subject of one prior IPR petition. In 2021, an IPR petition was filed on the ‘492 patent by Zhejiang Zhengte Co. Ltd., IPR2021-00430. In that proceeding, the petitioner asserted two grounds of invalidity:

Ground 1	The Liu ‘453 Patent anticipates claims 1 and 5-7 and renders obvious claim 2-4 in view of the Tung Patent, the Liu ‘171 Patent, the Liu ‘068 Patent, the Wang Patent, the Bertola Patent, and the Harbaugh Publication.	Claims 1-7
Ground 2	The Liu ‘068 Patent renders obvious claims 1-7 in view of the Liu ‘453 Patent, the Liu ‘171 Patent, the Wang Patent, the Bertola Patent, and the Tung Patent.	Claims 1-7

The Tung ‘037, the Liu ‘171, the Wang ‘460, and the Bertola ‘895 patents relied upon in the 2021 IPR petition are also relied upon in both petitions currently pending². On July 12, 2021, the Board denied institution of IPR2021-00430. (Paper 7.)

² The Tung ‘037 and Liu ‘171 Patents were also relied on by the Examiner in the original prosecution.

E. The Petition for *Inter Partes* Review

On May 22, 2025, almost a year to the day after the lawsuit was filed against Petitioner, two petitions for *Inter Partes* Review were submitted, purportedly split into art groups (partially) based on a weak priority theory championed by Petitioner. In this proceeding, Petitioner contends claims 1 and 5-7 are anticipated by the Wang ‘109 Patent (Chinese Patent No. ZL 2007200720183886.3 / CN 201076109Y), and the Wang ‘439 Patent (Chinese Patent No. ZL 200820088054.8 / CN 201197439Y). Neither of these patents even qualifies as prior art if the ‘492 patent is properly accorded priority to the provisional filing. Petitioner also contends claims 1-7 are rendered obvious by three different combinations of the Glatz ‘980 Patent (U.S. Patent No. 6,014,980) with one or more of the Bertola ‘895 Patent (German Patent No. DE20014895U1), the Wang ‘460 Patent (Chinese Patent No. ZL 200720106096.5 / CN 201001460Y), the Tung ‘037 Patent (U.S. Patent No. 6,478,037) and/or the Liu ‘171 Patent (U.S. Patent No. 5,284,171). (Petition, p. 3.) The Petition relies on a 135-page declaration of Petitioner’s expert, Dr. Richard W. Klopp.

In a second IPR petition, IPR2025-01006, filed by the Petitioner on the same date, two grounds of obviousness are asserted. For Ground 1, Petitioner asserted claims 1-7 obvious based on the Wang ‘460 Patent in view of the Tung ‘037 Patent, the Liu ‘171 Patent and/or the Bertola ‘895 Patent. For Ground 2, Petitioner claims 1-7 obvious

based on the Ma ‘763 Patent (U.S. Patent No. 6,321,763) in view of the Ma ‘297 Patent Application (European Patent Application No. EP1602297), the Bertola ‘895 Patent, the Tung ‘037 Patent, and/or the Liu ‘171 Patent. The second petition relies on a 118-page declaration of Petitioner’s expert, Dr. Richard W. Klopp.

Because Petitioner filed two separate petitions, it also filed its “Notice Ranking and Explaining Material Differences between Petitions for Inter Partes Review of U.S. Patent No. 8,104,492.” (Paper 3.) In its Notice, Petitioner admits that while priority is an issue that impacts whether the patents in Grounds 1 and 2 of this petition qualify as prior art under 35 U.S.C. §102, the patents relied on in Ground 3 of this petition are not impacted by priority. Indeed, all art in Ground 3 is also relied on by Petitioner in its second IPR petition (IPR2025-01006).

On June 16, 2025, the PTAB issued its Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper 6). Pursuant to the Notice of Filing Date, Patent Owner’s Preliminary Response is due three months from the Notice date, by September 16, 2025. Pursuant to the PTAB’s “Consolidated Trial Practice Guide – November 2019,” the PTAB will determine whether to institute an IPR within three months of the date the Patent Owner’s Preliminary Response was filed or was due, by about December 16, 2025. Pursuant to 35 U.S.C. §316(a)(11), the PTAB will set the trial date for the IPR within one

year of the notice of institution, no later than about June 16, 2026.

**III. INSTITUTION OF *INTER PARTES* REVIEW SHOULD BE DENIED
PURSUANT TO THE DIRECTOR'S DISCRETION.**

The Director should exercise her discretion pursuant to the Memorandum of March 26, 2025 and deny institution of this IPR on the '492 Patent. The following factors support a discretionary denial:

- There are settled expectations in the enforcement of the '492 Patent in that the patent has been in force for over thirteen years.
- There is significant overlap between the issues in the Petition and in the Litigation. The same claims are challenged, and the grounds, the art, and the arguments are substantially the same in the Petition as in the Litigation. All of the art relied upon in the Petition is also relied upon by Petitioner as a subset of art presented in the Litigation.
- The challenge by Petitioner is weak, relying on an illogical priority theory based on immaterial changes to the figures accompanied by unchanged language in the relevant claim and no change to the function of the disclosed embodiments.
- There has been significant investment in the Litigation in that substantive issues have already been addressed by the parties.
- The two Petitions are duplicative and redundant.

- There are no relevant changes in the law that affect patentability.

Each of these factors is discussed separately below in sections A through F.

A. There Are Settled Expectations in the ‘492 Patent.

The Director has recognized that settled expectations alone are sufficient to deny institution. In *iRhythm Tech., Inc. v. Welch Allyn, Inc.*, IPR2025-00363 (Paper 10, June 6, 2025), the Director granted discretionary denial of a petition directed towards a patent that had been “in force since as early as 2012...” In *Apotex Inc., v. Alkermes Pharma Ireland Limited*, IPR2025-00514 (Paper 10, July 2, 2025), the Director denied institution of the petition where the challenged patent had been in force for more than 14 years, which created “strong settled expectations.” In resolving four petitions in *Samsung Electronics Co. Ltd. et al. v. Sinotechnix LLC*, IPR2025-00331/333/335/336 (Paper 13, July 2, 2025), the Acting Deputy Chief Administrative Patent Judge found patents in force for more than ten years created strong settled expectations. The ‘492 Patent was issued more than thirteen years ago, on January 31, 2012, falling squarely within the date range establishing settled expectations.

Even in instances where the patents have been in force for fewer years than the ‘492 Patent, settled expectations can make discretionary denial proper. For example, in *Dabico Airport Solutions, Inc. v. AXA Power APS*, IPR2025-00408

(Paper 21, June 18, 2025), “the challenged patent [had] been in force almost eight years, creating settled expectations.” In *Sig Sauer Inc. v. Lone Star Future Weapons, Inc.*, IPR2025-00410 (Paper13, June 26, 2025), the Director found discretionary denial appropriate where the challenged patent had been in force for over ten years. In *Intel Corp. v. Proxense LLC*, IPR-00327/00328/00329, the challenged patents had been in force for over *nine* years, creating settled expectations supporting the discretionary denial of all three petitions. In *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433 and IPR2025-00435 (Paper 12, June 27, 2025), the Director recognized that for two filed petitions, where the patents had been in force for nine and seven years, the settled expectations supported discretionary denial, while denying discretionary denial for other petitions directed at more recent patents.

Not only is the timing of the ‘492 Patent—which has been in force for thirteen years—sufficient to establish settled expectations under several recent decisions, but there are additional facts that further bolster the settled expectations. In particular, the ‘492 Patent is well known in the industry, with ATLeisure selling hundreds of thousands of patented umbrellas while separately licensing the ‘492 patent nearly thirty times to industry participants, resulting in more than \$12MM in license fees. (EX2002, ¶¶3-4.) Additionally, the ‘492 Patent has been

successfully asserted in four prior lawsuits, and has remained valid in view of a prior IPR petition. Thus, there are settled expectations of the parties that the ‘492 Patent is valid and enforceable. This factor weighs in favor of denial of institution. See, Director’s March 26, 2025 Memorandum, p. 2.

B. The Issues in the Petition Have Significant Overlap with the Issues in the Litigation.

“[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, p. 6 (March 20, 2020) (precedential). Here Petitioner has identified and relied on numerous references it contends are prior art in the litigation. Every reference identified in this proceeding (and in the second IPR petition) is also relied on by the Petitioner in the Litigation. The same claims are challenged in the Petition as are challenged in the Litigation: claims 1-7. Grounds 1 and 2 of the Petition are asserted in the Litigation, while combinations largely analogous to Ground 3 are relied on by Petitioner in the Litigation, combining the Glatz ‘980 Patent in view of three references identified in Ground 3. (EX2001, pp. 7-9.) Similarly, Petitioner’s arguments as to where the claim limitations are found in the prior art, on a limitation-by-limitation basis, are essentially the same in both the Petition and the Litigation.

Thus, the challenged claims are the same, the grounds are the same or substantially the same, the art is the same or substantially the same, and the arguments are substantially the same. Moreover, the Litigation involves numerous additional grounds not asserted in the Petition, including additional anticipation and obviousness theories. (*Id.*) The fact that the Litigation involves additional challenges to the ‘492 Patent weighs in favor of a denial. *See, Next Caller Inc. v. Trustid, Inc.*, IPR 2019-00963, Paper 8, p. 12 (October 28, 2019). Accordingly, this factor favors denial of institution.

C. Petitioner’s Priority Challenge is Weak and Ignores Unchanged Claim Language

As Petitioner acknowledges, if the Board determines that the claims of the ‘492 Patent properly claim priority back to the provisional filing, neither the Wang ‘109 nor the Wang ‘439 Patents are prior art, and Petitioner’s anticipation theories necessarily fail. Only if the priority claim to the provisional filing is rejected could Grounds 1 and 2 even be considered.

The ‘492 patent claims priority back to U.S. Provisional Patent Application Serial No. 61/050,353, which was filed May 5, 2008, and included six claims. *See* EX1003. On May 5, 2009, the U.S. Non-provisional Patent Application Serial No. 12/435,640 was filed and included the original six claims filed in the provisional application. EX1002. When the ‘492 patent issued, claims 2-6 remained unchanged from their form

as filed in the provisional application. EX1002, p. 95. Importantly, originally filed Claims 2-5 each specifically claims a particular locking means embodiment that issued as included in the provisional application.

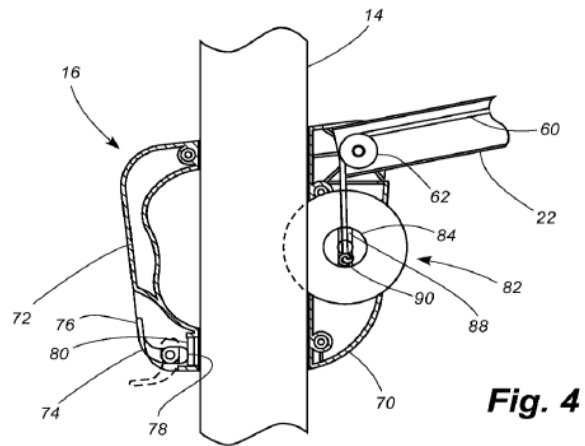
The priority issue raised by Petitioner relates to one of the three specific embodiments of the locking means claim limitation recited in both the provisional and utility patent, namely the “cam” locking means that is the subject of dependent claim 2. In the provisional application, the lever of the cam locking means is pivotally attached to the lower portion of the sliding member and rotates towards the sliding member to lock the sliding member in place. In the ‘492 patent, the lever of the cam locking means is pivotally attached to the upper portion of the sliding member and rotates towards the sliding member to lock the sliding member in place. According to Petitioner, attaching the lever of the cam locking means higher on the same sliding member, and functioning in exactly the same manner to lock/unlock the sliding member, is a distinction that should vitiate priority for all claims of the ‘492 patent. Petitioner’s arguments are wrong for numerous reasons.

The cam locking means is expressly disclosed in the provisional application and therefore the inventor had possession of the claimed subject matter. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). First, the written description in the provisional application described a “cam lock member 74 comprises

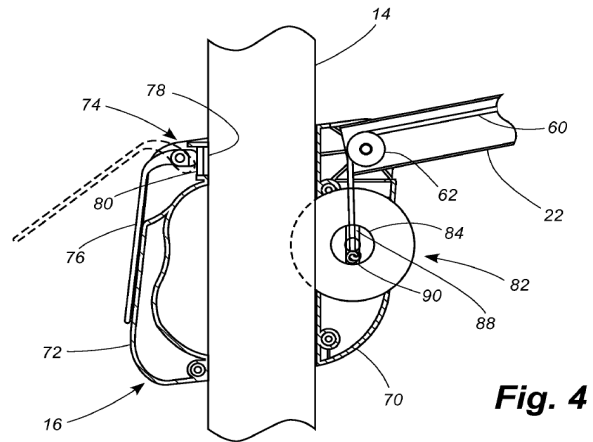
a lever portion 76 and a cam surface 78.” (Ex-1003, ¶25.) When the cam latch member 74 is in a “stored” position, “the cam surface 78 bears against a spring loaded button 80, which in turn clamps against the main pole 14 to secure the sliding member 16 against the pole.” (*Id.*) When the cam latch member 74 was rotated from the stored position, “the cam surface 78 is rotated free of the button 80. The spring then causes the button to retract, and the sliding member 16 can move freely up and down the pole 14.” (*Id.*) Put more simply, rotating the cam lever causes a cam surface to clamp (or unclamp) the spring loaded button against the main pole to lock (or unlock) the sliding member in place.

In the issued patent, the inventor describes a mechanism that locks the sliding member in exactly the same way, relying on all of the same components. In fact, Figure 4 in the utility patent is the same mechanism (with all of the same numbered elements), but the left side of the sliding member inverted from the provisional figure, as shown if comparing the original Figure 4, the issued Figure 4, and by inverting the left half of the original Figure 4 vertically by 180 degrees:

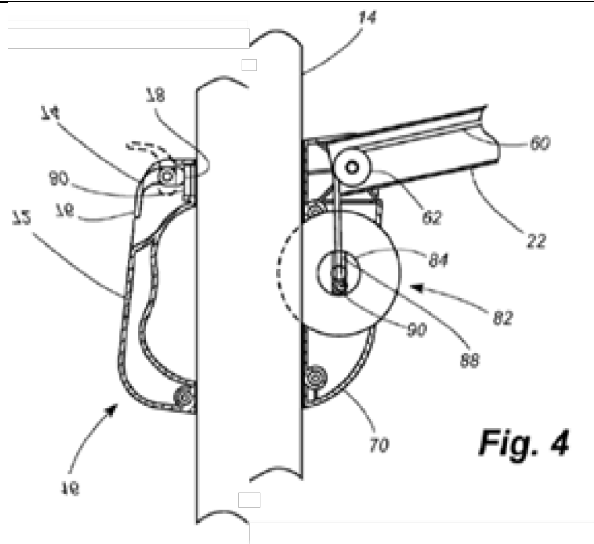
EX1003-Original Figure 4



EX1001-Issued '492 Patent



EX1003-Original Figure 4 inverted
in identified section



A comparison of the figures and the specification reveals that the only difference in the description is that in the provisional application, the lever portion 76 rotates from the lower portion of the sliding member, while in the issued patent the lever portion 76 rotates from the upper portion of the sliding member. (Ex-1001, 3:25-38.) In both the provisional application and the issued patent, the cam lock member 74 is pivotally mounted. (Ex-1001, 3:28; Ex-1003, ¶25.) In both the provisional application and the issued patent, when the cam lock member 74 is in the “stored” or first position (as described in claim 2), “the cam surface 78 bears against a spring loaded button 80, which in turn clamps against the main pole 14 to secure the sliding member 16 against the pole.” (Ex-1001, 3:32-35; Ex-1003, ¶25.) Likewise, in both the provisional application and the issued patent, when “the cam surface 78 is rotated free of the button 80 [t]he spring then causes the button to retract, and the sliding member 16 can move freely up and down the pole 14.” (Ex-1001, 3:38-40; Ex-1003, ¶25.) The two embodiments are functional equivalents in every sense of the phrase.

Not only did the text of the specification of the provisional application expressly describe the cam locking means as claimed in the ‘492 patent, but it also included claim 2, which was part of the specification of the provisional application and unchanged in the ‘492 patent, establishing the inventor possessed the invention (and the cam locking means embodiment) claimed as of the filing date of the provisional application. *See*,

e.g., *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 988 (Fed. Cir. 2002) (J. Rader, dissenting); *In re Koller*, 613 F.2d 819, 823, 204 USPQ 702, 706 (CCPA 1980) (“Original claims constitute their own description.”). Claim 2 is specifically directed to the cam locking means and is claimed identically in both the provisional application and the issued ‘492 patent. Claim 2 does not require a particular location of the cam latch member as it pertains to positioning on the sliding member. Instead, regardless of the location of the cam lever on the sliding member, the functionality of the cam locking means as described and claimed in the provisional application requires only that the cam latch member is rotatable with respect to the sliding member such that the cam surface clamps or unclamps the main pole. (Ex-1003, p. 16.) The recitation of the cam locking means embodiment in claim 2 establishes, without any doubt, that the inventor possessed the invention as of the filing date of the provisional.

Petitioner’s challenge is without merit, as it ignores the fact that the cam locking means functions the same in the provisional and issued ‘492 patent, while claim 2 is directed to the cam locking means and is unchanged from the provisional filing. Because Petitioner’s priority theory is weak and unsupportable, the petition itself is weak, favoring discretionary denial.

D. The Parties Have Invested in the Litigation by Addressing Substantive Issues.

Pursuant to the District Court’s Scheduling Order, ATLeisure and Petitioner

exchanged proposed terms for claim construction, exchanged preliminary claim constructions, filed a joint claim construction statement, and filed opening and responsive claim construction briefs. The parties have also conferred and agreed upon a proposed special master for claim construction and have spent significant time and effort in conducting discovery, in the claim construction process, and in briefing claim construction. This factor weighs in favor of denial of institution.

E. The Two Petitions are Redundant and Attempt to Skirt the Word Limit.

The Director may consider all relevant circumstances in determining whether to discretionarily deny institution of an IPR. Director's March 26, 2025 Memorandum, p. 3; *Apple Inc. v. Fintiv, Inc.*, *supra*, p. 14. While Petitioner contends that it filed two separate petitions because of disputes in priority, it acknowledges that Ground 3 from this Petition does not turn on priority at all. Instead, it articulates an obviousness theory based on art for which there is no question on priority, just like the second filed petition. In fact, all art in Ground 3 is also referenced in the second petition. Rather than limiting its arguments in this Petition to those related to priority, Petitioner used the two separate filings to circumvent the word limits. The instant petition includes 13,719 of the 14,000 available words, while the second filed petition (where priority is not in dispute) consumed 13,635 words. If Petitioner had truly filed discrete petitions, distinguishing the petitions between one in which priority was an issue and a second where it was not,

at least one of the grounds asserted by Petitioner would have been precluded. This is an abuse of the process and supports discretionary denial. Therefore, this factor weighs in favor of denial.

F. There Are No Relevant Changes in the Law that Affect Patentability.

There have been no changes in the law or judicial precedent regarding patentability since the '492 Patent issued. Accordingly, this factor weighs in favor of denial of institution. *See*, Director's March 26, 2025 Memorandum, p. 2.

IV. CONCLUSION

For the reasons set forth above, the Director should exercise her discretion pursuant to the Director's Memorandum of March 26, 2025 and deny institution of this IPR on the '492 Patent.

Dated: July 15, 2025

Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. SECTION 42.24

ATLeisure certifies that the word count in this Request, as determined by the Microsoft Word word-processing system is 4,588 words. This Request is in compliance with the 14,000-word limit pursuant to the Director's Memorandum of March 26, 2025 and 37 C.F.R. §42.24.

Dated: July 15, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies service on the Petitioner, pursuant to 37 C.F.R. §42.6(e), by electronic (e-mail) delivery of a true copy of the foregoing PATENT OWNER’S REQUEST TO DIRECTOR FOR DISCRETIONARY DENIAL OF PETITION FOR INTER PARTES REVIEW OF U.S. PATENT 8,104,492 (Pursuant to Director’s Memorandum of March 26, 2025), which was served on July 15, 2025 to the following Counsel for Petitioner via e-mail:

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