

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OmniVision Technologies, Inc.,
Petitioner,

v.

RE Secured Networks, LLC,
Patent Owner.

U.S. Patent No. 6,838,651

Inter Partes Review Case No. 2025-01019

**PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

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LIST OF PATENT OWNER’S EXHIBITS

Exhibit	Description
2001	Docket in parallel litigation as of Aug. 20, 2025
2002	Amended Answer (Docket No. 57 in parallel litigation), filed Oct. 28, 2024
2003	Excerpt of Plaintiff’s Preliminary Invalidation Contentions in parallel litigation, dated Jan 15, 2025
2004	Scheduling Order (Docket No. 35 in parallel litigation), dated Jul 31, 2024
2005	Amended Scheduling Order (Docket No. 56 in parallel litigation), dated Oct. 25, 2024
2006	Amended Scheduling Order (Docket No. 76 in parallel litigation), dated March 11, 2025
2007	Docket Navigator Time to Trial Statistics for the District of Delaware from Jan. 1, 2019 through Aug. 20, 2025
2008	Excerpt of OmniVision Technologies, Inc.’s Responses and Objections to Defendant’s First Set of Interrogatories (Nos. 1-6) in parallel litigation, dated Jan. 22, 2025

Pursuant to the Director’s March 26, 2025 Memorandum Regarding Interim Processes for PTAB Workload Management (the “Director’s Memorandum”), Patent Owner, RE Secured Networks, LLC (“Patent Owner”), respectfully submits this Request for Discretionary Denial of Institution of the Petition filed by OmniVision Technologies, Inc. (“Petitioner” or “OmniVision”) seeking *inter partes* review (“IPR”) of U.S. Patent No. 6,838,651 (“the ’651 patent”).

The *Fintiv* factors all favor discretionary denial in this case, with a lot of work by the parties and the Court in the parallel litigation to date, and even more resources will be expended before the decision on institution would issue. Moreover, there is complete overlap in the parties and issues in the parallel litigation, no stay or likelihood of a stay even if review is instituted, and a jury trial date almost two months before a Final Written Decision would issue in this case.

Additionally, this is a *very* clear case of settled expectations—which, on its own, merits denial of institution. The ’651 patent issued over twenty (20) years ago and Petitioner has admittedly been aware of the ’651 patent and its applicability to the relevant technology space for twelve and a half years. In fact, Petitioner admits that it learned of the ’651 patent through litigations where the ’651 patent was asserted against companies that incorporate Petitioner’s sensors in their own products.

Patent Owner respectfully requests that the Director exercise the discretion to

deny institution of review in this case.

I. THE DIRECTOR SHOULD EXERCISE DISCRETION TO DENY INSTITUTION PURSUANT TO 35 U.S.C. § 314(a)

Section 314(a) “invests the Director with discretion on the question whether to institute review.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 366 (2018). As shown below, the *Fintiv* factors all weigh in favor of denying institution under Section 314(a). *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (considering (a) “whether the petitioner and the defendant in the parallel proceeding are the same party”; (b) “overlap between issues raised in the petition and in the parallel proceeding”; (c) “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision”; (d) “investment in the parallel proceeding by the court and the parties”; (e) “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted”; and (f) “other circumstances that impact the Board’s exercise of discretion, including the merits.”).

A. Factor 1: The Petitioner and the [Counterclaim] Defendant in the Parallel Litigation are the Same Party

The Petitioner herein is OmniVision Technologies, Inc., the same party as the counterclaim Defendant in the parallel district court litigation, captioned *OmniVision Technologies, Inc. v. RE Secured Networks, LLC* (D. Del. Case No. 1:24-cv-00187) before Judge Hall, with pretrial matters before Magistrate Judge Burke. *See* Petition

at 1 (Related Matters); Ex. 1016 at 2; Ex. 2001 (Docket) at D.I. 18. Petitioner filed the parallel litigation on February 12, 2024, as a declaratory judgment action asserting non-infringement of U.S. Patent Nos. 7,323,671 (the “’671 Patent”) and 7,800,145 (the “’145 Patent”).¹ Ex. 1016 at 7-8. Patent Owner answered on May 20, 2024, with a counterclaim of infringement of the ’671 and ’145 Patents along with a counterclaim of infringement of the challenged ’651 Patent. Ex. 1016 at 27-24. Patent Owner amended its answer on October 28, 2024, to assert a fourth patent, U.S. Patent No. 7,495,274 (the “’274 Patent”). *See* Ex. 2002 (Amended Answer) at 9, ¶ 2. Because the parties are the same in both the instant proceeding and the parallel litigation, Factor 1 favors discretionary denial.

B. Factor 2: There is Complete Overlap Between Issues Raised in the Petition and in the Parallel Litigation

Petitioner has raised the exact same prior art in the instant Petition as in the parallel litigation. In the instant Petition, Petitioner’s grounds rely on four alleged prior art references: Japanese Patent Application Pub. No. 2000-12819 (“*Isogai*”) (Ex. 1005); U.S. Patent No. 5,982,984 to Inuiya et al. (“*Inuiya*”) (Ex. 1006); U.S. Patent No. 7,133,073 to Neter (“*Neter*”) (Ex. 1007); and U.S. Patent No. 6,704,049 to Fossum (“*Fossum*”) (Ex. 1008).

In the parallel litigation, Petitioner’s preliminary invalidity contentions with

¹ The ’671 and ’145 Patents share a common inventor with the ’651 Patent, and also relate to image sensor technology.

respect to the '651 Patent facially lists 100 prior art references (including U.S. and foreign patent documents and non-patent literature) as anticipating and/or rendering obvious alone, in view of the common knowledge of those or ordinary skill in the art, and/or in combination with one or more of the other prior art references, the claims of the '651 Patent. While OmniVision states in its contentions that it intends to rely on the listed 100 references either individually or in combination, OmniVision provided claim charts for just four of the 100 listed references that each provide information on a single reference. The four exemplary charts provided for the '651 Patent in OmniVision's invalidity contentions in the parallel litigation pertain to *Fossum*, *Inuiya*, *Isogai*, and *Neter*. See Ex. 2003 (Excerpts of Plaintiff's Preliminary Invalidity Contentions).

In other words, out of the 100 prior art references listed in the contentions, Petitioner provided charts for the four references applied in the instant Petition and there is thus complete overlap between the issues raised in the Petition and those in the parallel litigation. Factor 2 therefore favors discretionary denial.

C. Factor 3: The Court's Trial Date in the Parallel Litigation is Two Months Before the Board's Projected Statutory Deadline for a Final Written Decision

The parallel litigation will proceed with a 5-day jury trial scheduled to begin on October 26, 2026. See Ex. 2003 (Scheduling Order at 16, ¶ 21) (Patent Owner notes that this document is entitled "Proposed Scheduling Order," (*id.* at 1), but is,

in fact, the operative scheduling order, signed by Magistrate Judge Burke (*id.* at 17)); *see also* Exs. 2004-2005 (Amended Scheduling Orders not altering trial date). The notice according a filing date in the instant proceeding is dated June 20, 2025 (Paper 5), which makes Patent Owner’s Preliminary Response due on September 20, 2025 (Paper 5), and the Decision on Institution due on December 20, 2025. 35 U.S.C. § 314(b). This makes the projected statutory deadline for a Final Written Decision December 20, 2026 (U.S.C. § 316(a)(11)), approximately two months after the start (and seven weeks after the end) of the 5-day Jury trial in October of 2026.

Since the trial in the parallel litigation will take place approximately two months before the potential Final Written Decision in this proceeding, review should be denied. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12-13 (P.T.A.B. May 13, 2020) (denying institution where trial was scheduled to begin “approximately two months” before final written decision); *see also NXP USA, Inc. v. Redstone Logics LLC*, IPR2025-00485, Paper 11 (P.T.A.B. July 10, 2025) (denying institution where parallel trial was expected before final written decision); *Lam Research Corp. v. Inpria Corp.*, IPR2025-00256, Paper 12 (P.T.A.B. July 2, 2025); *Cisco Sys., Inc. v. WSOU Invs. LLC*, IPR2025-00429, Paper 15 (P.T.A.B. June 25, 2025).

As stated in *Shenzen Tuozhu Technology Co. v. Stratasy, Inc.*:

Under the circumstances of this case, it will be inefficient to maintain two parallel proceedings when the district court scheduled trial date and the

projected final written decision due date are in close proximity. Exercising discretion to deny the petition in this case reduces the inefficiencies and burdens on the parties to maintain two parallel proceedings.

IPR2025-00354, Paper 11 (P.T.A.B. June 12, 2025) (denying institution where trial date preceded projected final written decision date by approximately six weeks).

Because a trial date is set, Patent Owner submits that statistics about time to trial in Delaware are not particularly relevant, but Patent Owner notes that the October 2026 trial date set is approximately 32 months after the February 2024 complaint, which is in line with the 32 months median time to trial for the District of Delaware. *See* Ex. 2007 (Docket Navigator Time to Trial Statistics for the District of Delaware from Jan. 1, 2019 through Aug. 20, 2025).

This case will proceed to trial in district court approximately two months before the projected statutory deadline for a final written decision in this proceeding, and Factor 3 therefore favors discretionary denial.

D. Factor 4: The Parties and the Court have Invested Significant Time and Resources in the Parallel Litigation

Both the parties and the district court have invested significant time and resources in the parallel litigation. Fact discovery has been ongoing for a year and is scheduled to close on or before October 8, 2025. *See* Ex. 2005 (Amended Scheduling Order at 2). Moreover, all expert reports in the parallel litigation (opening reports, rebuttal reports, and reply reports) are scheduled to be completed by December 17, 2025 (*See* Ex. 2004 (Scheduling Order) at 5-6, ¶ 7(f)(i)), *i.e.*, days before the

December 20 projected statutory deadline for an institution decision in the instant proceeding.

The parties have fully briefed their claim construction arguments and Magistrate Judge Burke held a Markman hearing on August 11, 2025 for approximately 5 hours. The parties are continuing to meet and confer regarding the disputed claim terms based on Judge Burke's requests at the *Markman* hearing.

Factor 4 therefore favors discretionary denial.

E. Factor 5: There is no Stay in the Parallel Litigation and the Litigation is Unlikely to be Stayed Even if Review is Instituted

There is currently no stay in place in the parallel litigation. *See* Ex. 2001 (Docket in parallel litigation as of Aug. 20, 2025). But even if the Board were to institute review of the instant Petition, which it should not do, the parallel litigation is unlikely to be stayed.

The parallel litigation is in the District of Delaware, which employs a three-prong standard in deciding a motion to stay: “(1) whether granting the stay will simplify the issues for trial; (2) the status of the litigation, particularly whether discovery is complete and a trial date has been set; and (3) whether a stay would cause the non-movant to suffer undue prejudice from any delay, or allow the movant to gain a clear tactical advantage.” *Toshiba Samsung Storage Tech. Korea Corp. v. LG Elecs., Inc.*, 193 F. Supp. 3d 345, 348 (D. Del. 2016).

The main reason that there would be no stay granted even if this proceeding

were instituted is that, as discussed above, the parallel litigation includes four asserted patents. In addition to the '651 patent challenged herein, Patent Owner has asserted infringement of its '671, '145, and '274 Patents in the parallel litigation. As a result, the instant proceeding, even if it were instituted, would not simplify the issues in the parallel litigation. *See Topia Tech., Inc. v. Egnyte, Inc.*, No. 21-cv-1821, D.I. 143 (D. Del. Sept. 6, 2023) (Magistrate Judge Burke) (denying request for stay where two out of six patents were subject of instituted IPRs because of lack of simplification of issues); *3Shape A/S v. Align Tech., Inc.*, No. 18-cv-00886-LPS, D.I. 368 (D. Del. Feb. 26, 2021) (Judge Hall) (denying stay where “only one of the two patents-in-suit is part of the IPR. So there is going to be a trial either way, even if the outcome of the IPR is entirely favorable” to the defendant); *see also 10X Genomics, Inc. v. Parse Biosciences, Inc.*, No. 22-1117, D.I. 164 (D. Del. Feb. 20, 2024) (citing *Courtesy Products, LLC v. Hamilton Beach Brands, Inc.*, 2015 WL 5145526, at *2 (D. Del. Sept. 1, 2015); *Toshiba Samsung Storage Tech. Korea Corp. v. LG Elecs., Inc.*, 193 F. Supp. 3d 345, 349 (D. Del. 2016) (denying stay due to lack of simplification where three out of six asserted patents were subject of instituted IPRs).

As discussed above in relation to Factor 4, there has also been significant work done in the parallel litigation by the parties as well as the Court. Fact discovery is scheduled to close on or before October 8, 2025. *See* Ex. 2005 (Amended Scheduling

Order at 2). And all three rounds of expert reports will be completed by December 17, 2025 (*See* Ex. 2004 (Scheduling Order) at 5-6, ¶ 7(f)(i)), before the statutory deadline for an institution decision in the instant proceeding. Expert discovery will then conclude the following month on January 23, 2026. *See* Ex. 2004 (Scheduling Order at 4, ¶ 7(a)).

The *Markman* hearing took place on August 11, 2025, with any disputes remaining following subsequent discussions between the parties to be addressed by the Court at a later date.

As noted above in relation to Factor 3, the trial date is set for October 26, 2026. *See* Ex. 2004 (Scheduling Order at 16, ¶ 21). So, by the time of the decision on whether to institute herein, the status of the litigation will be such that fact discovery is complete and a trial date set. *Toshiba*, 193 F. Supp. 3d at 348.

And further, any stay of the parallel litigation in view of the instant proceeding, would be prejudicial to Patent Owner. It was Petitioner's decision to initiate the parallel litigation as a declaratory judgment action. However, despite knowing about the '651 Patent for over a decade prior to the parallel litigation (as explained further below), Petitioner did not file its petition until one year after Patent Owner filed its counterclaims in the parallel litigation—forcing the parties to expend resources in the parallel litigation for as long as possible prior to filing the instant IPR petition. Not only did Petitioner delay in filing its petition, but the petition itself

copies the same grounds that were previously asserted in a prior IPR that was filed by Samsung in 2021 (as explained further below). It would prejudice the Patent Owner to stay the parallel litigation in view of Petitioner's decision to delay filing its copycat IPR petition until the last possible moment—after the parties have expended significant resources in this matter.

Thus, as the parallel litigation is not currently stayed, and there is unlikely to be any stay even if institution is granted, Factor 5 favors discretionary denial.

F. Factor 6: Other Circumstances

1. Settled Expectations

There are extraordinarily strong settled expectations in this case that, per prior decisions of the Director, are sufficient on their own to warrant discretionary denial of institution. The Director's Memorandum includes the following as a relevant consideration for discretionary denial: "Settled expectations of the parties, such as the length of time the claims have been in force." Director's Memorandum at 2.

"[A]lthough 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*, IPR-2025-00408, Paper No. 21 at 3 (P.T.A.B. June 18, 2025).

The '651 patent issued over 20 years ago. *See* Ex. 1001 at 1 (issue date of Jan. 4, 2005). The '651 patent was in force for over 17 years and has since expired.

Recent decisions from the Acting Director have found settled expectations in cases having shorter periods of patents being in force. *See Dabico*, Paper No. 21 at 2 (discretionary denial based on settled expectations for patent in force for almost 8 years); *Amgen Inc. v. Bristol-Myers Squibb Company*, IPR2025-00601 and -00602, Paper No. 9 at 3 (P.T.A.B. July 24, 2025) (discretionary denial based on settled expectations for patents in force for seven and six years); *iRhythm Tech., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025) (discretionary denial based on settled expectations for patent in force for approximately 13 years); *Apotex Inc., v. Alkermes Pharma Ireland Limited*, IPR2025-00514, Paper 10 (P.T.A.B. July 2, 2025) (discretionary denial based on strong settled expectations for patent in force for over 14 years); *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12, 2–3 (P.T.A.B. June 26, 2025) (discretionary denial based on strong settled expectations for patent in force for over 10 years).

The argument for settled expectations here is stronger than in the above-cited cases because, compared to those cases, the '651 patent: (1) was in force for a longer period of time prior to the Petition being filed (over 17 years); (2) had issued a longer period of time prior to the Petition in question (over 20 years); and (3) has since expired. Further, as discussed in greater detail below (regarding Petitioner's interrogatory responses), the '651 Patent was also previously asserted in the particular technology space in question here, and Petitioner admits that it was aware

of those assertions for over a decade. *See Imperium (IP) Holdings v. Apple, Inc et al.* (E.D. Tex. Case No. 4:11-cv-00163-RC-ALM); *Pictos Technologies, Inc. f/k/a Imperium IP Holdings (Cayman), Ltd. v. Samsung Electronics Co., Ltd. et al.* (E.D. Tex. Case No. 4-21-cv-00376-ALM); *Certain Digital Imaging Devices and Products Containing the Same and Components Thereof* (I.T.C. Inv. No. 337-TA-1231).

Patent Owner notes that the assignee of the '651 patent has changed since the prior litigations, but this does not affect the settled expectations analysis. *See, e.g., SanDisk Technologies, Inc. v. Polaris PowerLED Technologies, Inc.*, IPR2025-00515, -00516, and -00517, Paper No. 15 at 2 (P.T.A.B. July 16, 2025) (finding settled expectations for patents in force for nine, twelve, and twelve years despite more recent assignment to Patent Owner); *SAP America, Inc. v. Valtrus Innovations Ltd.*, IPR2025-00415, -00417, and -00418, Paper No. 12 at 3 (P.T.A.B. July 10, 2025) (finding settled expectations for patents originally assigned to Hewlett-Packard entities and more recently re-assigned to Patent Owner).

Nor can Petitioner point to a lack of notice as grounds for denying the existence of settled expectations. As a threshold matter, “actual notice of a patent or possible infringement is not necessary to create settled expectations.” *Dabico*, Paper No. 21 at 3. But in any event, ***Petitioner admits that it has been aware of the '651 patent since October of 2012***, over twelve and a half years before filing the instant

Petition. As stated in Petitioner's interrogatory responses in the parallel litigation:

OmniVision was aware of this patent as of late October 2012. The '651 patent was previously asserted against companies incorporating OmniVision image sensors in Imperium (IP) Holdings v. Apple, Inc et al., Case No. 4:11-cv-00163-RC-ALM (E.D. Tex.). OmniVision was made aware of the '651 patent by one or more defendants in the matter.

Ex. 2008 (Excerpt of Petitioner's Responses to Patent Owner's First Set of Interrogatories in parallel litigation) (portions redacted).

So not only has Petitioner been well aware of the '651 patent for over a decade, but Petitioner became aware of the '651 patent in connection with a prior litigation that asserted the '651 patent against one or more of Petitioner's customers that incorporated OmniVision image sensors in its products. Yet Petitioner still did not challenge the validity of the '651 patent until now—over a year after filing the declaratory judgment action that initiated the parallel litigation. In fact, Petitioner waited until the very last possible day to file the instant Petition on May 20, 2025—exactly one year after Patent Owner filed its counterclaims asserting the '651 patent against Petitioner in the parallel litigation on May 20, 2024 (Ex. 1016 at 11). Petitioner's decision to delay filing its IPR until the very last possible day is even more egregious considering that Petitioner uses the exact same grounds and copies a prior expert declaration from a previous IPR petition filed by Samsung years earlier (as discussed further below).

2. The Petition's Copied Grounds are Weak and the Petition Relies on Former Petitioner's Expert

The Petition's Grounds are completely copied from a prior Petition filed by Samsung Electronics Co., Ltd. against the '651 patent, IPR2021-00437.²

Ground 1: Claims 1 and 18 are unpatentable under pre-AIA 35 U.S.C. § 102(b) as anticipated by Japanese Patent Publication 2000-12819 to Isogai *et al.* ("*Isogai*") (Ex.1005)²;

Ground 2: Claim 2-5 and 19-22 are unpatentable under § 103(a) as being obvious over *Isogai* and U.S. Patent No. 7,133,073 to Neter ("*Neter*") (Ex.1007);

Ground 3: Claim 2-5 and 19-22 are unpatentable under § 103(a) as being obvious over *Isogai* and U.S. Patent No. 6,704,049 to Fossum *et al.* ("*Fossum*") (Ex.1008);

Ground 4: Claims 1-3 and 18-20 are unpatentable under § 102(b) as being anticipated by U.S. Patent No. 5,982,984 to Inuiya *et al.* ("*Inuiya*") (Ex.1006);

Ground 5: Claim 4-5 and 21-22 are unpatentable under § 103(a) as being obvious over *Inuiya* and *Neter*; and

Ground 6: Claim 4-5 and 21-22 are unpatentable under § 103(a) as being obvious over *Inuiya* and *Fossum*.

Listing of Grounds in IPR2021-00437 (Paper 1 at 3)

² Patent Owner notes that this prior Samsung IPR was settled prior to a decision on institution.

Ground	Claims	Basis for Rejection
1	1 and 18	Anticipated pursuant to 35 U.S.C. § 102 by <i>Isogai</i> (Ex. 1005) and the knowledge of an ordinary artisan
2	1-5 and 18-22	Obvious pursuant to 35 U.S.C. § 103 over <i>Isogai</i> and U.S. Patent No. 7,133,073 to <i>Neter</i> (Ex. 1007)
3	1-5 and 18-22	Obvious pursuant to 35 U.S.C. § 103 over <i>Isogai</i> and U.S. Patent No. 6,704,049 to <i>Fossum</i> (Ex. 1008)
4	1-3 and 18-20	Anticipated pursuant to 35 U.S.C. § 102 by <i>Inuiya</i> (Ex. 1006) and the knowledge of an ordinary artisan
5	1, 4-5, 18, and 21-22	Obvious pursuant to 35 U.S.C. § 103 over <i>Inuiya</i> and <i>Neter</i>
6	1, 4-5, 18 and 21-22	Obvious pursuant to 35 U.S.C. § 103 over <i>Inuiya</i> and <i>Fossum</i>

Listing of Grounds in instant Petition at 4-5.

In addition to copying the grounds, and large portions of text, Petitioner also submitted the 158-page declaration from Samsung's IPR2021-00437 from R. Jacob Baker, Ph.D., P.E. as Exhibit 1015 herein, which is relied upon extensively throughout the Petition. Notably, Dr. Baker is not Petitioner's expert, and this use of a four-year-old declaration by another party's expert is improper. There are no statements in the Petition about Dr. Baker working for Petitioner herein and Patent Owner does not expect to be able to depose Dr. Baker on his old declaration without compelled discovery. It is also notable that there are no statements to the effect that Dr. Baker's opinions have not changed in the years since his declaration was submitted by Samsung. *See OpenSky Industries, LLC v. VLSI Technology LLC*,

IPR2021-01064, Paper No. 102 at 42-43 (P.T.A.B. Oct. 4, 2022).

Petitioner separately submitted a 15-page declaration of Albert Theuwissen, Ph.D. Ex. 1002. The declaration is mostly background information. This declaration states “I agree with Dr. Baker’s opinion and incorporate the contents of Dr. Baker’s Declaration in its entirety as if fully set forth herein.” *Id.*, ¶ 38. Dr. Theuwissen then adds nine paragraphs of additional opinions. *Id.*, ¶¶ 41-49.

After being introduced, Dr. Theuwissen’s declaration is cited four times in the Petition.

Dr. Baker’s declaration is cited *191 times* in the Petition.

Patent Owner submits that it is improper for one expert to submit another expert’s report as his own. If this proceeding were to be instituted, which it should not be, Patent Owner will be forced to depose one expert on another expert’s work, which will disadvantage Patent Owner. The prior Baker declaration is essentially hearsay without a sufficient opportunity to question Dr. Baker on its contents.³ *See*

³ Any additional arguments regarding the merits of the Petition itself may be addressed in a forthcoming Preliminary Response, should Patent Owner choose to file one. *See* Interim Director Discretionary Process, Available at <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (“when filing a brief for discretionary denial, a patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits.”). However, respectfully, Patent Owner submits that there is no reason for either the parties or the Board itself to further delve into the merits of the Petition given the overwhelming evidence supporting that the Petition should be discretionarily denied.

37 CFR § 42.51(b)(1)(ii) (authorizing routine discovery of “[c]ross examination of affidavit testimony prepared for the proceeding”).

* * *

As outlined above, all of the *Fintiv* factors favor discretionary denial. It would simply not be a worthwhile use of the Board’s resources to institute review in this case. The parallel litigation, between the same parties, including the same prior art as in the Petition, which is not and will not be stayed, will proceed to jury trial before a final written decision can issue in this case. The ’651 patent is also subject to extremely well settled expectations as it issued over 20 years ago, and the Petitioner admits that it has been aware of the patent for over 12 years.

Patent Owner respectfully requests discretionary denial of review.

Dated: August 20, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that this brief complies with the type-volume limitations of 37 CFR § 42.24 and the Director's March 26, 2025 Memorandum on Interim Processes for PTAB Workload Management. This brief contains 4,090 words as calculated by the "Word Count" feature of Microsoft Word, the word processing program used to create it, which is less than the 14,000 word count limit.

Dated: August 20, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.205(b), the undersigned hereby certifies that on December 27, 2024, a complete and entire copy of the foregoing **Patent Owner's Request for Discretionary Denial of Institution** and Exhibits 2001-2008 were served on Petitioner by filing through the Patent Trial and Appeal Case Tracking System (P-TACTS) and via email to dblostone@beneschlaw.com, cmcmahon@beneschlaw.com, tdamario@beneschlaw.com, and chemphill@beneschlaw.com, as authorized in Petitioner's mandatory notices:

Dated: August 20, 2025

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