

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,

Petitioner,

v.

LONGHORN AUTOMOTIVE GROUP LLC,

Patent Owner.

Patent No. 8,265,353

Inter Partes Review No. IPR2025-01064

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
DISCRETIONARY DENIAL REQUEST**

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Ex-1006	U.S. Patent No. 5,744,802 to Muehllehner et al. (“Muehllehner”)
Ex-1007	U.S. Patent No. 5,871,013 to Wainer et al. (“Wainer”)
Ex-1008	Bushberg, Jerrold T., et al. <i>The essential physics of medical imaging</i> , Lippincott Williams & Wilkins. 2d Ed. (2002)
Ex-1009	Mattes, David, et al. “Nonrigid multimodality image registration,” <i>Medical imaging 2001: image processing</i> . Vol. 4322. Spie (2001)
Ex-1010	Katsaggelos, Aggelos K. “Iterative image restoration algorithms,” <i>Optical engineering</i> 28.7, 735-748 (1989)
Ex-1011	S. A. Nehmeh, Y. E. Erdi, C. C. Ling, K. E. Rosenzweig, O. D. Squire, L. E. Braban, E. Ford, K. Sidhu, G. S. Mageras, S. M. Larson, J. L. Humm, “Effect of respiratory gating on reducing lung motion artifacts in PET imaging of lung cancer,” <i>Medical Physics</i> 29 (3) (Mar. 2002), https://doi.org/10.1118/1.1448824
Ex-1012	Woo, Sang-Keun, et al. “Development of a motion detecting system for respiratory-gated PET using laser optical displacement sensor,” <i>2003 IEEE Nuclear Science Symposium, Conference Record</i> (IEEE Cat. No. 03CH37515), Vol. 3. IEEE (2003) https://doi.org/10.1109/NSSMIC.2003.1352255
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Ex-1014	Schöder, H., Erdi, Y.E., Larson, S.M. et al. “PET/CT: a new imaging technology in nuclear medicine,” <i>European Journal of Nuclear Medicine and Molecular Imaging</i> , 30, 1419–1437 (2003), https://doi.org/10.1007/s00259-003-1299-6
Ex-1015	Osman, Medhat M., et al. “Respiratory motion artifacts on PET emission images obtained using CT attenuation correction on PET-

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	CT,” <i>European journal of nuclear medicine and molecular imaging</i> 30, 603-606 (2003), https://doi.org/10.1007/s00259-002-1024-x
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Ex-1017	Ritchie CJ, Hsieh J, Gard MF, et al: “Predictive respiratory gating: A new method to reduce motion artifacts on CT scans,” <i>Radiology</i> 190:847-852 (1994), https://doi.org/10.1148/radiology.190.3.8115638
Ex-1018	U.S. Patent Publication No. US 2006/0071932 A1 to Weese, et al. (“Weese-932”)
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Ex-1020	U.S. Patent Publication No. 2003/0004405 A1 to Townsend et al.
Ex-1021	Goerres, Gerhard W., et al. “PET-CT image co-registration in the thorax: influence of respiration,” <i>European journal of nuclear medicine and molecular imaging</i> 29, 351-360 (2002), DOI 10.1007/s00259-001-0710-4
Ex-1022	Chen, George TY, Jong H. Kung, and Kevin P. Beaudette. “Artifacts in computed tomography scanning of moving objects,” <i>Seminars in radiation oncology</i> , Vol. 14. No. 1. WB Saunders, (2004), https://doi.org/10.1053/j.semradonc.2003.10.004
Ex-1023	Kachelrieß, Marc, et al. “Kymogram detection and kymogram-correlated image reconstruction from subsecond spiral computed tomography scans of the heart,” <i>Medical Physics</i> . 29.7, 1489-1503 (2002), https://doi.org/10.1118/1.1487861
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I. Introduction

Longhorn's request for discretionary denial (Paper 6, "Request") should be rejected. Three circumstances unique to the '353 patent overturn any purported expectations asserted by Patent Owner: the Office indisputably made a material error by issuing claim 1; Longhorn unexpectedly shifted its alleged invention from medical scanning into new areas of technology (automotive technology); and Longhorn asserted the '353 patent alongside numerous unrelated patents. *See* Ex-1030, at 2 (Acting Director interview). Each consideration independently warrants referral on the merits, and all three collectively do so overwhelmingly.

First, Longhorn has no settled expectations of validity because claim 1 contains a material error that the applicant identified after allowance and the Office agreed to fix but did not. Claim 1 requires "associating . . . second images with second movement states of the mobile object **using the first measurements.**"¹ Ex-1001. But the examiner relied on a different requirement with different scope to allow the claims: "associating . . . second images with second movement states of the mobile object, **the second movement states being determined by the second measurements.**" Ex-1002, at 810. Seeing this discrepancy, the applicant admitted it had inadvertently introduced "**using the first measurements**" in a previous office

¹ Colored claim language used for clarity throughout.

action response and attempted to correct that mistake for the claims to become “the same versions allowed by the examiner” that “includes the language quoted in the Examiner’s Reasons for Allowance.” Ex-1002, at 834-35, 840. And the examiner agreed to make that change. Ex-1002, at 844-845. But the Office nevertheless mistakenly issued claim 1 with the wrong requirement—“**using the first measurements.**” Longhorn now *asserts* claim 1 despite its known, material error. Ex-1031, at 1 (asserting all claims), 52-73 (asserting the erroneous limitation).

Given this history, Longhorn’s only expectation—from allowance of the ’353 patent onward—can be that claim 1 issued in error and is subject to further review by the Office. Indeed, because the examiner repeatedly quoted the old language in subsequent actions, it appears the issued language was not examined for patentability, including for obviousness or requirements under 35 U.S.C. § 112. Ex-1002, at 762, 763, 810. The primary references in the Petition, *Weese* and *Wainer*, each disclose this limitation under both the erroneous language and the correct language in multiple ways. Paper 1, 66-78, 66 n.1, 137 & n.3. Neither were previously considered by the Office, so “it is an appropriate use of Office resources to review the potential error” in light of these newly identified references. *Taiwan Semiconductor Manuf. Co. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 at 4 (P.T.A.B. Sept. 3, 2025); *Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9 at 2 (P.T.A.B. July 31, 2025).

Second, Longhorn, a non-practicing entity that does not participate in the automobile market, “unexpectedly shift[ed] its invention into new areas of technology” (Ex-1030, at 2) by asserting all claims of this medical radiation-based imaging patent against automakers’ visible-spectrum camera systems (Ex-1031). The ’353 patent contains no mention whatsoever of vehicles or cameras. Instead, it only claims and describes radiation-based medical imaging technology. The applicant previously admitted that the only support in the specification for the independent claims lies in passages that only describe radiation-based medical imaging techniques. Ex-1002, at 783-785; *see* Ex-1032. And Longhorn asserted dependent claims that expressly require “radiation attenuation” and “radiation emission” techniques (Ex-1031, at 120-121 (asserting claim 5), 155-156 (claim 14)). There can be no settled expectations that this technology applies to automobile cameras or that it is valid because Petitioner had not previously challenged this patent.

Third, in the district court proceedings involving the ’353 patent, Longhorn asserted the ’353 patent alongside *seven* unrelated patents. None of those patents share an applicant, inventor, subject matter, original assignee, or priority relationship with the ’353 patent. None involve imaging systems, much less the ’353 patent’s medical imaging technology. Such sprawling allegations in district court by a patent

owner weigh against any settled expectations deriving from the age of challenged patent.

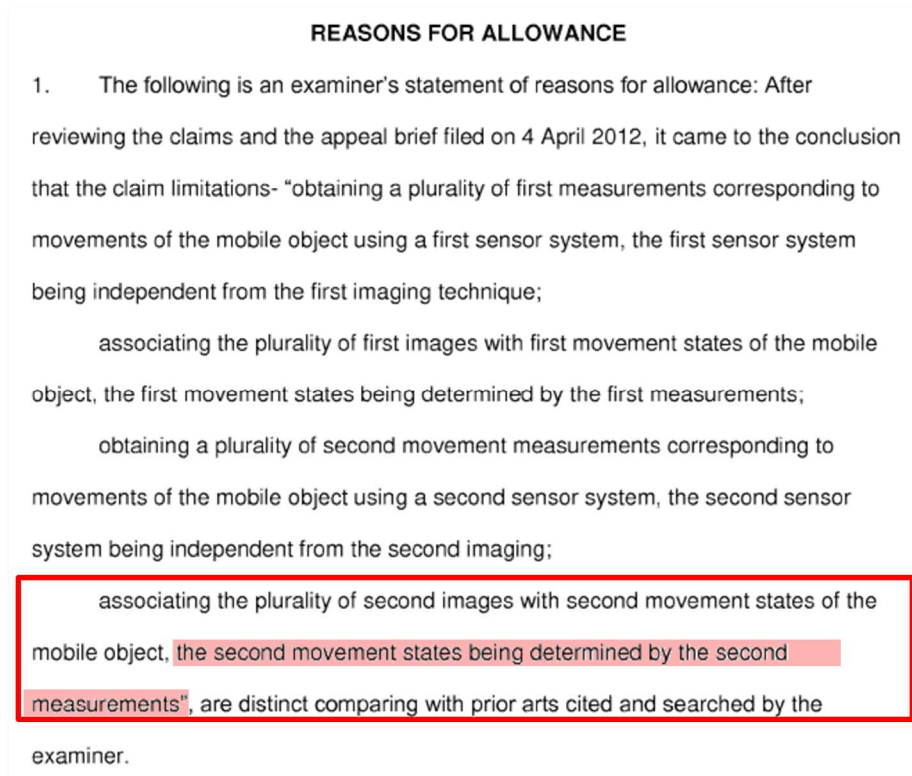
Every other *Fintiv* consideration also weighs against discretionary denial or is neutral. And Patent Owner’s arguments for discretionary denial are all misplaced. They range from factual errors (e.g., asserting that “the issues in the parallel District Court litigation are identical to this proceeding”), *id.* at 3, to procedural errors (e.g., identifying only a preliminarily scheduled trial date, not the statistics-based trial date as embraced by the Board), *id.* at 1, to legal errors (e.g., considering under *Fintiv* Factor 1 whether a stay is likely pre-, not post-institution), *id.* at 8-9. The Board should not deny institution here.

II. Patent Owner Has No Settled Expectations the ’353 Patent is Valid and Enforceable

A. The Office Issued Claim 1 With a Known, Material Error

1. The Examiner Did Not Allow the Subject Matter of Claim 1, and the Office Agreed to Fix this Error But Did Not

Claim 1 requires “associating . . . second images with second movement states of the mobile object **using the first measurements.**” That is not the limitation the examiner relied on to allow the claims:



Ex-1002, at 810 (annotated). As shown, the examiner allowed the claim for reciting “associating . . . second images with second movement states of the mobile object, **the second movement states being determined by the second measurements.**”

Id. Yet in the claim listing prior to allowance, neither independent claim recited this limitation. Instead, both claims recited associating second images and second movement states “**using the first measurements,**” a wholly different requirement. Ex-1002, at 787, 792, 794, 796-97.

Spotting those differences, the original applicant admitted to “inadvertent” errors in a prior amendment filed September 27, 2011, which had carried forward. Ex-1002, at 834. Before then, as of March 8, 2011, the independent claims had

recited the language the examiner relied on for allowance: “**the second movement states being determined by the second measurements.**” Ex-1002, at 673, 675-76. But on September 27, the applicant inadvertently modified the claim listing for both independent claims to recite “**using the first measurements**” without including appropriate claim markups. Ex-1002, at 732 (no markups to claim 15), 734 (misquoting claim 12 in strikethrough and preserving mistake in underline when reordering the limitation).

Following that mistake, the examiner nevertheless quoted the old, correct claim language—“**the second movement states being determined by the second measurements**”—in all subsequent actions. The examiner did so when analyzing the prior art in the final office that followed the applicant’s inadvertent modification of the independent claims. Ex-1002, at 762, 763. And at allowance, the next and final time the examiner quoted the claims, the examiner again quoted the old, correct language. Ex-1002, at 810.

After allowance, the applicant identified the error and attempted to fix it so the independent claims contained “the language quoted in the Examiner’s Reasons for Allowance” (Ex-1002, at 834), which was “**the second movement states being determined by the second measurements**” (Ex-1002, at 840-843). The applicant explained “[c]laims 15 and 16 above are versions of those claims as amended in the listing of the claims filed on March 8, 2011. In the listing of the claims filed

September 27, 2011, no amendments were made to claims 15 and 16.” Ex-1002, at 834.

The markups in the claim listing after allowance agreed with the applicant’s admission it had unintentionally introduced new claim language without proper markups on September 27, 2011. Ex-1002, at 834, 840-842. Because the applicant made no amendments to claim 15 on September 27, the amendment after allowance clarified that the March 8, 2011 claims were the claims of record. The amendment after allowance thus included no claim markups for claim 15 (issued claim 1) and labeled claim 15 as “Previously Presented” in the claim listing. Ex-1002, at 840. The amendment likewise clarified that the March 8 claims were the claims of record and explained claim 26 (issued claim 12) was “an amended version of the claim based on the version presented in the listing of the claims filed [M]arch 8, 2011.” Ex-1002, at 834. The listing of claim 26 thus contained claim markups relative to that version of the claims and a “Currently Amended” label. Ex-1002, at 842.

REMARKS

Applicants hereby present a complete listing of the claims to correct inadvertent typographical errors included in claims 15, 16, and 26 found in the listing of the claims filed September 27, 2011. In order to correct these typographical errors, the listing of the claims above have the following changes with respect to the listing of the claims filed September 27, 2011:

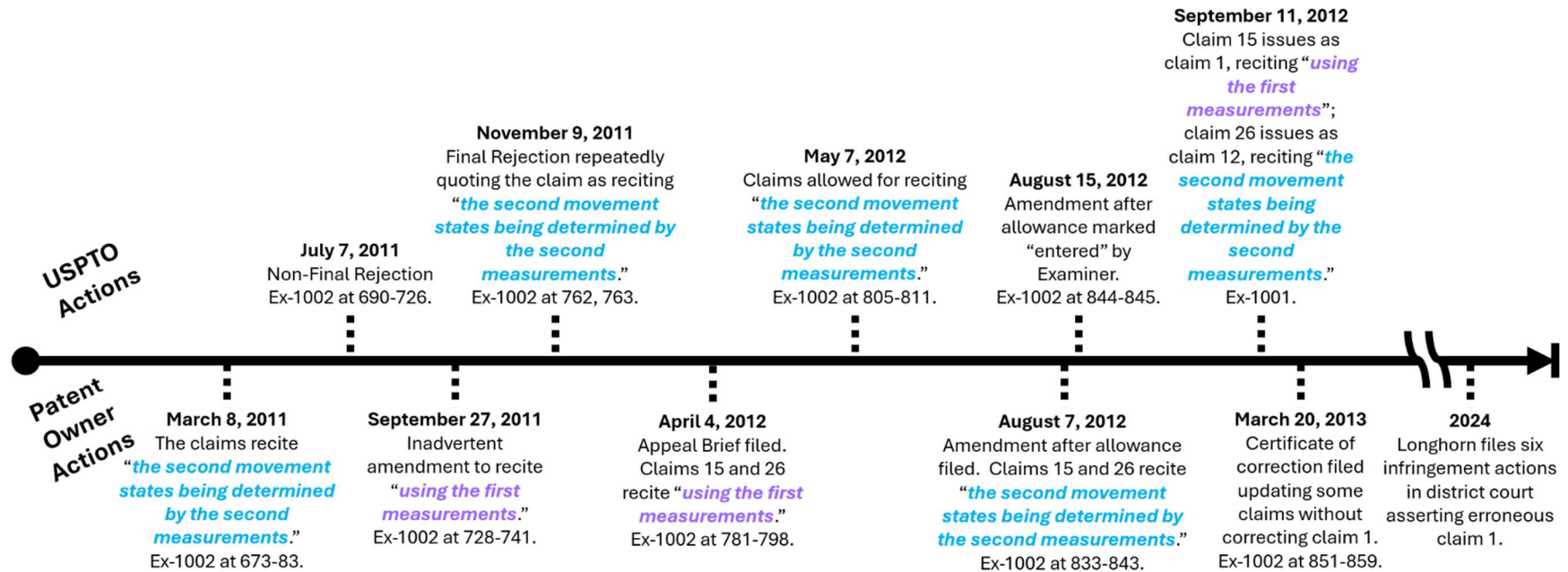
- Claims 15 and 16 above are versions of those claims as amended in the listing of the claims filed on March 8, 2011. In the listing of the claims filed September 27, 2011, no amendments were made to claims 15 and 16. The versions of these claims above are the same versions allowed by the Examiner, as claim 15 above includes the language quoted in the Examiner's Reasons for Allowance, mailed on May 7, 2012.
- Claim 26 above is an amended version of the claim based on the version presented in the listing of the claims filed March 8, 2011. Due to the typographical errors included in the amendment filed September 27, 2011, that amendment is being discarded in favor of the amended version presented above. However, the amendment does not substantively alter claim 26—rather the amendment only changes the order of the recited means elements. As amended above, claim 26 reflects the language quoted in the Examiner's Reasons for Allowance, mailed on May 7, 2012. As such, Applicants submit that no substantive issues, whether under 35 U.S.C. §§ 102, 103, or 112, are being raised by the amendment to claim 26 presented above.

Ex-1002, at 834:

The examiner agreed to enter the applicant's proposed amendments to ensure the proper claim listing issued. Ex-1002 at 844-845. Yet the Office failed to do so

even though the Office was on notice of the discrepancy between the allowed subject matter and the previous listing of the claims. When the patent issued, then-claim 26 issued as claim 12 with the correct language—“**the second movement states being determined by the second measurements**”—but then-claim 15 issued as claim 1 with the wrong requirement—“**using the first measurements.**” Ex-1001. The Office thus erred by failing to issue then-claim 15 with the correct, unamended language of March 8, 2011, as the examiner had agreed to do.

In the intervening 13 years since the patent issued, Patent Owner and its predecessors never attempted to correct this known error, despite making *other* corrections after the patent issued (Ex-1002, at 851-859) and despite asserting the erroneous claim *six* times in district court last year (*see* Paper 1, at 151). Even after the Petition identified the discrepancy between claims 1 and 12 (Paper 1 at 66 n.1, 115 n.2, 137 n.3), Patent Owner has done nothing to correct this known material error in claim 1.



2. The Office’s Material Error in Issuing Claim 1 and Patent Owner’s Failure to Correct that Error Overturns Any “Settled Expectations”

The Office’s error in issuing claim 1 overturns any settled expectations of validity and strongly weighs against discretionary denial. The applicant identified a discrepancy between the scope of the allowable subject matter and the claim listing. Ex-1002, at 834. The applicant put the Office on notice of this problem, and the examiner agreed to fix it by entering the amendment after allowance. Ex-1002, at 844-845. That the Office nonetheless issued claim 1 with the wrong language was “a material error, and it is an appropriate use of Office resources to review the potential error.” *Taiwan Semiconductor*, IPR2025-00847, Paper 11 at 4; *Skullcandy*, IPR2025-00690, Paper 9 at 2.

There can be no dispute that the features recited in claim 1—“associating . . . second images with second movement states of the mobile object **using the first measurements**”—differ in scope from the subject matter the examiner identified as allowable—“associating . . . second images with second movement states of the mobile object, **the second movement states being determined by the second measurements.**” Such different words presumptively carry different meanings. *SimpleAir, Inc. v. Sony Ericsson Mobile Commc’ns*, 820 F.3d 419, 431 (Fed. Cir. 2016). Indeed, when the examiner agreed to enter the amendment after allowance that should have restored the proper version of the claims, he did not check the box

indicating the amendment was merely “a matter of form not affecting the scope of invention.” He instead checked the box labeled solely as “entered,” thereby acknowledging the amendment affected claim scope.

1. ☒ The amendment filed on 7 August 2012 under 37 CFR 1.312 has been considered, and has been:
- a) ☒ entered.
- b) ☐ entered as directed to matters of form not affecting the scope of the invention.

Ex-1002 at 845.

The Board consistently finds that a material error during examination is sufficient reason to reject discretionary denial, regardless of the duration of a patent owner’s alleged settled expectations. The Board’s reasoning is made clear in numerous recent decisions:

- *Taiwan Semiconductor*, IPR2025-00847, Paper 11 at 4 (no discretionary denial for **fifteen year-old** patent given examiner’s mistake in allowing claims over art that appeared to disclose the allowable features);
- *Anthony Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 12, at 2-3 (P.T.A.B. July 16, 2025) (rejecting discretionary denial for **17- and 18-year old** patents given examiner’s material error in prosecution);
- *Microsoft Corp. v. XI Discovery, Inc.*, IPR2025-00253, Paper 13, at 2-3 (P.T.A.B. June 25, 2025) (rejecting discretionary denial for **17-year**

old, *8-year old*, and *5.5-year old* patents given examiner's material error in prosecution);

- *Skullcandy*, IPR2025-00690, Paper 9, at 2 (rejecting discretionary denial for *9-year old* patent given examiner's mistake about what claim limitations were present in claims);
- *Eunsung Global Corp. v. Hydrafacial LLC*, IPR2025-00445, Paper 14, at 2-3 (P.T.A.B. July 10, 2025) (rejecting discretionary denial for *8.5-year old* patent given examiner's mistake about prior art's disclosure); and
- *Embody, Inc. v. Lifenet Health*, IPR2025-00248, Paper 13, at 2-3 (P.T.A.B. June 26, 2025) (rejecting discretionary denial for *6.5-year old* patent given prior art remedying reason for allowance).

The facts here weigh particularly heavily against discretionary denial, since the Office's mistake in allowing claim 1 is not disputed, nor can it be disputed because the applicant originally identified the error in the claim and the examiner agreed to make the changes the applicant requested. Moreover, because the examiner repeatedly quoted the old, correct language in all actions after the applicant inadvertently introduced the error, it is likely *the erroneously issued language was never reviewed for patentability*. See Ex-1002, at 762, 763, 810; *supra* § II.A.1. And the primary references *Weese* and *Wainer*—never considered by the Office—

each disclose this limitation under both the erroneous language and the correct language in multiple ways. Paper 1, 66-78, 66 n.1, 137 & n.3. The Office should consider the potentially unexamined, erroneously-issued limitation in view of these newly identified references.

Further, Patent Owner's failure to correct this known, material error unsettles any expectations it may have had regarding validity of the '353 patent. No assignee ever petitioned the Office to withdraw the patent from issue under 37 C.F.R. § 1.313(c) to make the claims "the same versions allowed by the Examiner," as the applicant had attempted to do before the patent issued. *See* Ex-1002, at 834. Instead, Patent Owner and its predecessors maintained a claim that differed in scope from the allowed subject matter. And Patent Owner now *asserts* claim 1 with the mistaken language. Ex-1031, at 1, 52-73. The only expectation Patent Owner may have is that claim 1 is subject to further review by the Office.

B. Patent Owner Unexpectedly Shifted the Alleged Invention Into New Areas of Technology: From Medical PET/CT Scanning to Automotive Technology

The '353 patent is directed to medical imaging technology, yet Patent Owner has "unexpectedly shifted" this patent to accuse automotive camera systems, which also counsels against discretionary denial. *See* Ex-1030, at 2. Patent Owner's assertion of this patent beyond the scope of medical imaging overturns any purported settled expectations that this patent is valid simply because it has not previously been

challenged. Patent Owner could not possibly have expected Petitioner—an automaker—to be previously aware of this medical imaging patent and challenge it before Patent Owner stretched the claims to accuse vehicle imaging systems. The accused vehicles do not have and have no need for medical imaging techniques, which enable visualizations inside living beings. *E.g.*, Ex-1001, at 1:8-20.

Throughout, the '353 patent describes only radiation-based medical imaging systems to visualize patients' organs, never visual-spectrum cameras, and never any vehicle-based imaging systems. The title, "Method of ***Reconstructing*** an Image Acquired Using Several Imagery Modes," expressly refers to ***reconstructing*** images from radiation projections. Ex-1001, at Title (emphasis added); *see id.*, at 2:4-7 (reconstructing radiation emission projections), 3:20-48 (reconstructing CT projections), 7:24-48 (reconstructing patient images from radiation emission). The patent confirms, "[t]his ***invention*** is particularly applicable to medical imagery, therefore ***it will be assumed that a patient is being examined.***" *Id.*, at 3:42-44 (emphases added). The Abstract describes that "[m]easurements of a mobile object and particularly ***a living being*** are made using two techniques, normally ***radiation attenuation*** and ***radiation emission.***" *Id.* at Abstract (emphases added). The patent addresses the problem of imaging artifacts due to patient movement during a "heart or breathing cycle, or another periodic biologic cycle." *Id.*, at 2:36-60; *see id.*, at 2:43-3:2, Fig. 2 (breathing cycle). None of the patent's disclosure relates to

automobile camera systems. Patent Owner's unsupported expansion of the claimed subject matter topples any purported settled expectations.

During prosecution, the applicant acknowledged the independent claims require medical imaging technology by expressly offering support for the claims only in passages and figures that describe radiation-based medical imaging techniques. Ex-1002, at 783-785; *see* Ex-1032 (chart compiling cited support from prosecution). Indeed, as the Petition pointed out, limitations [12a-i] and [12c-i] invoke means-plus-function language, and the only disclosed structures that could possibly correspond to the claimed functions are medical imaging systems (e.g., CT or PET systems). Paper 1 at 9-13; Ex-1003 at ¶¶ [063]-[071], [088]-[095]. The applicant asserted intrinsic support for these limitations in passages and figures that generally describe radiation methods and specifically disclose radiation detectors. Paper 1, at 10-13; Ex-1002 at 784 (applicant-identified claim support); Ex-1003, at ¶¶ [063]-[071] (expert analysis), [088]-[095] (same). No accused vehicle contains such radiation technology or any other medical imaging technology.

As another example, asserted claims 5 and 14 in the parallel litigations narrow the independent claims to expressly require a particular configuration of medical imaging techniques. These claims explicitly compel using “radiation attenuation” as the claimed “first imaging technique” and “radiation emission” as the claimed “second imaging technique.” Ex-1001, at claims 5, 14. Yet Patent Owner stretches

them to cover vehicle camera systems. Ex-1031, at 120-121 (asserting claim 5), 155-156 (claim 14). Patent Owner does not explain how the accused vehicle cameras implement “radiation attenuation” or “radiation emission” techniques. *Id.* Here, again, Patent Owner’s unfounded expansion of the claimed subject matter counsels against settled expectations.

C. Petitioner’s Broad Stipulation and Patent Owner’s Diverse Assertion of Patents Weighs Against Discretionary Denial

Longhorn asserted the ’353 patent in six district court litigations involving *seven* unrelated patents. Broad stipulations by a petitioner combined with sprawling allegations in district court by a patent owner weigh against the age of challenged patents, thus weighing against discretionary denial. These circumstances are present here.

In *Tesla, Inc. v. Intellectual Ventures II LLC*, the petitioner “filed a broad stipulation and asserts that the merits are strong” based on prior successful validity challenges. IPR2025-00217, Paper 9, at 2 (P.T.A.B. June 13, 2025). The petitioner also noted “the complex and diverse litigation,” which spanned many patent families and involved “a diverse range of subject matter,” which helped “tip the balance against discretionary denial.” *Id.* at 2-3. “The large number and vast scope of the patents asserted in the district court litigation . . . weigh[ed] against discretionary denial,” even though—unlike here—the trial date preceded a FWD date, there was

insufficient evidence regarding a potential stay, and the parties made meaningful investments in the parallel litigation. *Id.* at 2-3. These considerations prevailed in the analysis for six challenged patents, including one **14-years old**, one **9.5-years old**, and one **8-years old**. *Id.* at 2-3. Similarly, in *Tesla, Inc. v. U.S. Sec’y of the Navy*, the Board made essentially the same findings with respect to litigation scope and diversity, and rejected discretionary denial for a patent **18-years old**. IPR2025-00341, Paper 12, at 2-3 (P.T.A.B. June 13, 2025). *See also Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10, at 3 (P.T.A.B. July 17, 2025) (“The large number and vast scope of the patents asserted in” litigation “weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter.”).

Consistent with the Board’s reasoning in both *Tesla* matters and *Shenzhen Tuozhu*, here Petitioner has filed not only a broad stipulation in its Petition, Paper 1, at 88, but also a much broader stipulation here, *infra* § III.D. These stipulations go beyond basic IPR estoppel, ensuring that this proceeding, if instituted, will serve as Petitioner’s sole proceeding to adjudicate the patentability of the ’353 patent based on prior art.

Also consistent with both *Tesla* matters, Patent Owner’s allegations in district court are diverse and sprawling. Patent Owner asserts five patents in the parallel litigation—each coming from different and unrelated owners and inventors, and

each covering unrelated technology. Specifically, Patent Owner alleges that U.S. Patent No. 8,810,803 relates to “headlight systems,” Ex-1033 ¶16; U.S. Patent No. 7,987,002 relates to mobile applications, *id.* ¶17; U.S. Patent No. 7,513,238 relates to pistons in “internal combustion engines,” *id.* ¶18; the U.S. Patent No. 8,085,192 patent relates to vehicle navigation systems, *id.* ¶20; and the ’353 patent allegedly relates to imaging used in “driver assistance systems,” *id.* ¶19. Patent Owner purports to accuse 23 different vehicle models, among two different brands, of infringing these five unrelated patents, including “all trims and configurations” across an unlimited period of time.² *See id.* ¶15; *see also id.* ¶¶24, 38, 53, 69, 87. Consistent with the Board’s approach in these circumstances, the diverse and wide-ranging nature of Patent Owner’s allegations in district court weigh further against according any weight to Patent Owner’s purported settled expectations.

In other litigations involving the ’353 patent, Patent Owner asserts additional patents unrelated to the ’353 patent, as identified in the table below. This too weighs against settled expectations. U.S. Patent No. 7,089,101 relates to a driver assistance method for a driving maneuver. *See* Ex-1034, claim 1. U.S. RE44331 is for a vehicle collision detector. *See* Ex-1035, claim 1. U.S. Patent No. 7,634,666 relates to a crypto-engine for cryptographic processing of data. *See* Ex-1036, claim 1. None

² Patent Owner’s allegations are sprawling and diverse, but also lacking in particularity and support as required by the district court’s caselaw and local rules.

of the patents asserted alongside the '353 patent share a priority relationship or inventor with the '353 patent. None were filed by the '353 patent's original non-inventor assignee, the Commissariat à l'Energie Atomique (CEA), a French governmental organization. Ex-1037; Ex-1038; Ex-1039; Ex-1040; Ex-1041; Ex-1042. All seven co-asserted patents fall far afield from the medical imaging techniques of the '353 patent, which never mentions any vehicles, let alone any of the technology claimed in the unrelated patents. The *Tesla* matters and *Shenzen Tuozhu* show these circumstances strongly weigh against any settled expectations.

Cases	Patent Number	General Claimed Technology Area	First Recorded Assignee
• <i>Longhorn Auto. Grp. v. Volkswagen Grp. of Am, Inc.</i>, 2:24-cv-00933 (E.D. Tex.)	7,513,238	A directly injecting internal combustion engine.	Daimler AG , Stuttgart (DE). Ex-1038.
• <i>Longhorn Auto. Grp. v. Mitsubishi Motors Corp.</i>, 2:24-cv-00685 (E.D. Tex.)	7,987,002	An interface to a distributed control system (e.g., for vehicles).	Kvaser Consultant AB , Molndal (Sweden). Ex-1039
• <i>Longhorn Auto. Grp. v. Mazda Motor Corp.</i>, 2:24-cv-00686 (E.D. Tex.) • <i>Longhorn Auto. Grp. v. Volvo Car Corp.</i>, 2:24-cv-00603 (E.D. Tex.) • <i>Longhorn Auto. Grp. v. Hyundai Motor Co.</i>, 2:24-cv-00603 (E.D. Tex.) • <i>Longhorn Auto. Grp. v. Nissan Motor Co.</i>, 2:24-cv-00397 (E.D. Tex.)	8,810,803	Lens system for projecting a pattern of light (e.g., in a vehicle headlight).	Reatrix Systems, Inc. Redwood City, CA (US) . Ex-1040.
• <i>Longhorn Auto. Grp. v. Volkswagen Grp. of Am, Inc.</i>, 2:24-cv-00933, 2:24-cv-00685 (E.D. Tex.)	8,085,192	A location information device with secure data storage (e.g., in a vehicle).	Rothschild Trust Holdings, LLC , FL (US). Ex-1041.
• <i>Longhorn Auto. Grp. v. Hyundai Motor Co.</i>, 2:24-cv-00603 (E.D. Tex.)	7,089,101	A driver assistance method for a driving maneuver.	DaimlerChrysler AG , Stuttgart (DE). Ex-1042.
	RE44331	A vehicle collision detector.	Livy SRVCS, Limited Liability Company , Dover, DE (US). Ex-1043.
• <i>Longhorn Auto. Grp. v. Nissan Motor Co.</i>, 2:24-cv-00397 (E.D. Tex.)	7,634,666	A crypto-engine for cryptographic processing of data.	City University of Hong Kong , Kowloon, Hong Kong (HK). Ex-1044.

D. A Lack of Commercialization, Marking, or Assertion Overcomes Alleged Settled Expectations

Based on all evidence available to Petitioner, Patent Owner has not commercialized, marked, or asserted the '353 patent, which further counsels against discretionary denial. Nor does Patent Owner contend that it or its predecessors has engaged in any of these activities. *See* Paper 6, at 10-11. This weighs against Patent Owner's contention of settled expectations.

In *Intel Corp. v. Proxense LLC*, the Board explained that “[t]here may be persuasive reasons why the Board should review challenged claims several years after their issuance date,” including when “a patent may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner’s particular technology space, if at all.” IPR2025-00327, Paper 12, at 2-3 (P.T.A.B. June 26, 2025). Here, Patent Owner, a non-practicing entity, acquired the '353 patent from another non-practicing entity, AI-Core Technologies, LLC, on October 6, 2023. Ex-1045. Prior to this assignment, the '353 patent was owned by a series of non-practicing entities and holding companies. Ex-1045 (AI-Core Technologies, LLC); Ex-1046, Ex-1047 (Intellectual Ventures Assets 195 LLC); Ex-1048 (Xylon LLC); Ex-1049 (Intellectual Ventures Fund 23 LLC). There is no evidence that any of these owners has ever commercialized, marked, or asserted the '353 patent.

Regarding marking under 35 U.S.C. § 287(a), in response to a motion to dismiss highlighting Patent Owner's failure to allege marking, Ex-1050, Patent Owner responded with an amended complaint retaining the exact same deficient allegations of compliance with the statute but no allegations of marking, Ex-1033. Further, none of the patent's current or former owners compete with Petitioner or any real party-in-interest. Because Patent Owner and its predecessors failed to commercialize, mark, or assert the '353 patent for nearly the entire life of the patent—or make any allegation that such activities occurred—this too weighs against Patent Owner's alleged settled expectations.

E. Patent Owner's Alleged Settled Expectations are Conclusory, Unexplained, and Entitled to No Weight

Settled expectations must account for a patent's full life, including examination, as the Office's decisions reflect. *E.g., Anthony*, IPR2025-00559, Paper 12, at 2-3 (no settled expectations given examiner error); *Taiwan Semiconductor*, IPR2025-00847, Paper 11 at 4 (same); *Microsoft*, IPR2025-00253, Paper 13, at 2-3 (same); *Skullcandy*, IPR2025-00690, Paper 9, at 2 (same); *Eunsung Global*, IPR2025-00445, Paper 14, at 2-3 (same); *Embody*, IPR2025-00248, Paper 13, at 2-3 (same). In addition to being contrary to caselaw, Patent Owner's argument for settled expectation is a classic conclusory statement lacking reasoning, particularly, or evidence of any kind. *See* Paper 6, at 10-11. The Board gives such

conclusory arguments little or no weight, and such statements cannot favor discretionary denial.

Patent Owner references the age of the '353 patent and then simply concludes that Patent Owner has settled expectations because the patent issued thirteen years ago. *See* Paper 6, at 10. The argument gives no explanation, particularity, or evidence of what expectations Patent Owner possessed—especially given that the patent issued with the wrong claim language. Paper 6, at 10-11; *see supra* § II.A. This is a purely conclusory statement.

Nowhere does Patent Owner explain, much less substantiate, *what* its supposed expectations are. For example, if Patent Owner means to contend that it expects the '353 patent to be valid, this is objectively implausible under the unique facts here, where the applicant identified an error in claim scope that the examiner agreed to fix but nevertheless remained present at issue. *See supra* § II.A. Alternatively, if Patent Owner means to contend that it expected no IPR to be filed challenging the '353 patent, this too is implausible. Patent Owner's decision to purchase and then litigate the patent, prompting this IPR, was a choice entirely within Patent Owner's control. Indeed, if Patent Owner's expectation was to do what it did—purchase and litigate the '353 patent—Patent Owner should have

expected³ those it sued to challenge the validity of the patent. Patent Owner further fails to provide any evidence or argument supporting settled expectations based on any amount of financial, time, or other investments dedicated to research, development, or other activities. *Cf. Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9, at 2-3 (P.T.A.B. July 24, 2025) (considering such factors). And Patent Owner does not explain how any settled expectations pertaining to the '353 patent can account for the jarring shift from the patent's disclosure of PET/CT scanning to Patent Owner's current allegations against automakers involving vehicle cameras. The Request does not explain how Petitioner—an automaker—would have been aware of this medical imaging patent and challenged it before Patent Owner stretched the patent to accuse vehicle systems. *See supra* § II.B.

On this record, Patent Owner's invocation of "settled expectations" is generic, unexplained, and conclusory—the type of contention given no weight by the Board in every other context. *Cf.* 37 C.F.R. §§ 42.104(b)(4)-(5) (conclusory arguments and references to evidence in petition are inadequate); 37 C.F.R. § 42.65(a) (conclusory expert testimony receives "little or no weight"); *Avant Tech., Inc. v. Anza Tech., Inc.*, IPR2018-00828, Paper 7, at 10-11 (P.T.A.B. Oct. 16, 2018) (citing *In re Magnum*

³ These actions by Patent Owner all predated the Office's March 26, 2025 memorandum on Interim Processes for PTAB Workload Management, and thus Patent Owner cannot claim settled expectations derived from that memorandum.

Oil Tools Int'l, Ltd., 829 F.3d 1364, 1380 (Fed. Cir. 2016) (conclusory statements cannot show obviousness); *Nikon Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01372, Paper 17, at 40 (P.T.A.B. Apr. 23, 2025) (conclusory statements cannot defeat obviousness); *Intuitive Surgical, Inc. v. Ethicon LLC*, IPR2018-01248, Paper 34, at 41 (P.T.A.B. Feb. 6, 2020) (conclusory statements cannot show anticipation); *Denso Corp. v. Collision Avoidance Techs. Inc.*, IPR2017-01709, Paper 28, at 21 (P.T.A.B. Jan. 22, 2019) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318-39 (Fed. Cir. 2005)) (conclusory statements cannot support claim construction); *Samsung Elecs. Co., Ltd. v. Sung*, IPR2024-00534, Paper 14, at 29 (P.T.A.B. Sept. 18, 2024) (conclusory statements cannot show level of skill in the art); *HTC Corp. v. Uniloc 2017 LLC*, IPR2018-01589, Paper 9, at 9 (P.T.A.B. Feb. 27, 2019) (conclusory statements do not support joinder); *Hanshow Am. Inc. v. SES-Imagotag Inc.*, IPR2024-00190, Paper 10, at 9-10 (P.T.A.B. May 20, 2024) (conclusory statements do not show differences between parallel IPRs for purposes of discretionary denial); *Nokia of Am. Corp. v. General Access Solutions, Ltd.*, IPR2024-00461, Paper 13, at 19 (P.T.A.B. June 14, 2024) (conclusory statements do not show privity or real party-in-interest for purposes of discretionary denial); *Shenzhen Silver Star Intelligent Tech. Co., Ltd. v. iRobot Corp.*, IPR2018-00882, Paper 9, at 11 (P.T.A.B. Oct. 1, 2018) (conclusory statements about petitioner's knowledge of prior art do not support discretionary denial). There is no reason to

credit Patent Owner’s conclusory assertion of settled expectations when such assertions are given no weight in every other context.

III. The *Fintiv* Factors Weigh Against Discretionary Denial

A. Factor 1 (Likelihood of a Stay) is Neutral Given the Many Ongoing Post-Grant Challenges to the Asserted Patents

Factor 1, considered in terms of how the district court actually rules on post-institution motions to stay, is neutral. Patent Owner’s argument to the contrary is legally erroneous: it focuses on the likelihood of a stay “before institution” and fails to address the district court’s willingness to grant stays post-institution. Paper 6, at 8-9.

Fintiv Factor 1 is concerned with whether a stay exists or may be granted “if a proceeding is *instituted*.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (emphasis added). Patent Owner argues “there is no stay in the parallel District Court Litigation, and a stay will likely not be entered before an institution decision here.” Paper 6, at 4; *see also id.*, at 8. This argument is circular and incomplete—it fails to address the likelihood of a *post*-institution stay, as contemplated by *Fintiv*. Where, as here, “the record contains adequate evidence that the District Court may grant a stay upon institution,” even if “not specifically directed to this proceeding,” this weighs against discretionary denial. *See Juniper Networks, Inc. v. Packet Intelligence LLC*, IPR2020-00336, Paper 21, at 16

(P.T.A.B. Sept. 10, 2020) (“[T]he District Court’s statements provide some evidence that it *may* grant a stay upon institution considering all circumstances at the time the motion is filed”—“This is all the first *Fintiv* factor asks.”) (emphasis in original).

Given the facts here, a stay is possible. In the district court case, a *Markman* hearing will not be held until February 26, 2026, **two months** after the Decision on Institution (DI) deadline of December 23, 2025, confirming the district court will have yet to invest significant resources. Ex-1051 at 4. Indeed, *Markman briefing* will not have begun by then. *Id.* at 5 (briefing scheduled January 15, 2026–February 5, 2026). Moreover, fact discovery will remain open until March 30, 2026, **three months** thereafter, and expert discovery will not have begun. *Id.* at 4. As the court has characterized a more advanced schedule, “[t]he most burdensome parts of the case—filing and responding to pretrial motions, preparing for trial, going through the trial process, and engaging in post-trial motions practice—all lie in the future.” *Cywee Grp. Ltd. v. Samsung Elecs. Co.*, No. 2:17-CV-00140-WCB, 2019 WL 11023976, at *6, *10 (E.D. Tex. Feb. 14, 2019) (Bryson, J., of the Federal Circuit sitting by designation) (granting stay although “claim construction had been conducted and discovery was nearly complete”). By the DI deadline in the present case, the *Markman* hearing, fact and expert discovery, and all the “most burdensome parts” of the case will have yet to occur.

The district court often stays litigation even when the FWD deadline lags the scheduled trial date by several months. *See, e.g., Commc'n Techs., Inc. v. Samsung Elecs. Am., Inc.*, No. 2:21-cv-00444-JRG, 2023 WL 1478447, at *1, *5 (E.D. Tex. Feb. 2, 2023) (Gilstrap, J.) (five months); *Broadphone LLC v. Samsung Elecs. Co.*, No. 2:23-cv-00001-JRG, 2024 WL 3524022, at *2-3 (E.D. Tex. July 24, 2024) (Gilstrap, J.) (three months). Here, a FWD will likely *precede* the expected trial date by 0.5 months. *See infra* § III.B. This timing is more favorable for a stay than many cases in which the court has granted a stay. *See, e.g., Resonant Sys., Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:22-cv-00423-JRG, 2024 WL 1021023, at *2-4 (E.D. Tex. Mar. 8, 2024) (Gilstrap, J.) (granting stay with claim construction briefing underway, two depositions taken, close of fact discovery two months away, and IPR filed three months after invalidity contentions); *Commc'n Techs.*, 2023 WL 1478447, at *3 (“[W]ith the close of discovery, the claim construction hearing, and the trial setting all in the future, the Court concludes that this factor weighs in favor of a stay. . . .”); *Broadphone*, 2024 WL 3524022, at *2-3 (granting stay motion where “[a] significant amount of discovery remains, the claim construction hearing has not occurred, and trial is currently [7 months away]”); *e-Watch Inc. v. Apple, Inc.*, No. 2:13-cv-1061-JRG, 2015 WL 12915668, at *3 (E.D. Tex. Mar. 25, 2015) (granting a stay partially because, “[b]y the time [Defendant] filed its renewed motion, the claim construction briefing process . . . had not yet fully completed, . . . over three-

and-a-half months remained within the fact discovery period . . . and over five months remained within the expert discovery period” (citations omitted)).

Further, Petitioner diligently and expeditiously filed the Petition on May 30, 2025, less than **two months** after Patent Owner’s service of infringement contentions on April 4, 2025. Ex-1052. That is fast. *See Samsung Elecs. Co., Ltd v. Mojo Mobility Inc.*, IPR2023-01090, Paper 11, at 19 (P.T.A.B. Jan. 11, 2024) (finding “Petitioner was diligent in filing the Petition, which was filed within **four months** of service of infringement contentions”) (emphasis added); *Samsung Elecs. Co., Ltd. v. CardWare Inc.*, PGR2023-00012, Paper 14, at 19 (P.T.A.B. Aug. 11, 2023) (finding “the Petition was expeditious” where filed “**four months** after the service of preliminary infringement contentions”) (emphasis added). Indeed, the Petition was filed **five months before** invalidity contentions are due. Ex-1051. That is also extraordinarily quick. *See Nikon Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01374, Paper 19, at 19 (P.T.A.B. Apr. 29, 2025) (finding “Petitioner was diligent in filing its Petition” two months before invalidity contentions); *Tesla, Inc. v. Autonomous Devices, LLC*, IPR2023-01172, Paper 21, at 9 (P.T.A.B. Jan. 8, 2024) (finding petitioner’s “diligence in filing the Petition . . . before serving its initial invalidity contentions . . . weighs against discretionary denial”); *Apple Inc. v. Parus Hldgs., Inc.*, IPR2020-00686, Paper 9, at 14-15 (P.T.A.B. Sept. 23, 2020) (finding “Petitioner acted expeditiously” where petition was filed “just after” invalidity

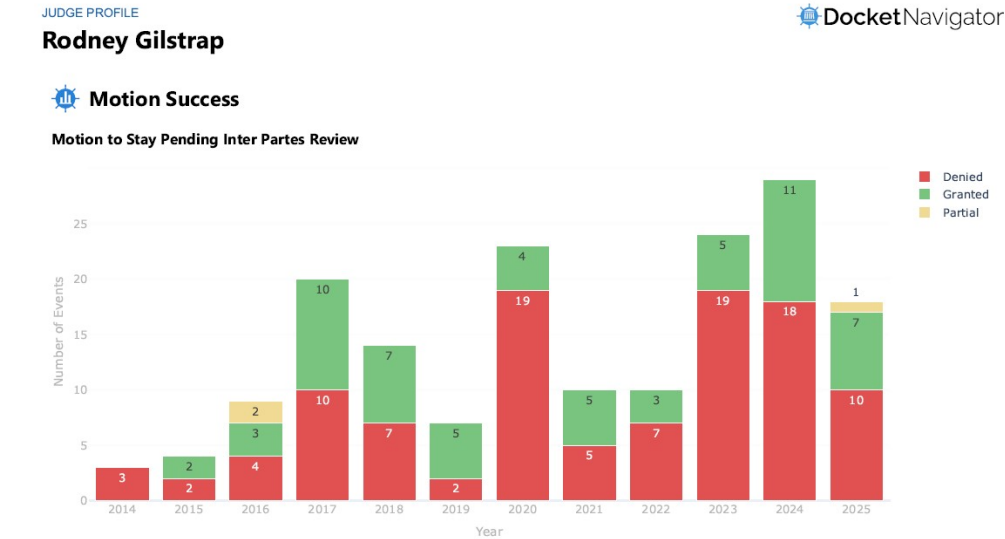
contentions). As discussed above, Judge Gilstrap grants stays in cases with more advanced schedules than the present case. *See, e.g., Commc'n Techs.*, 2023 WL 1478447, at *3; *Resonant Sys.*, 2024 WL 1021023, at *2-4.

Lastly, while Patent Owner asserts that the court “routinely denies requests to stay pending IPRs before institution on all asserted claims of all Asserted Patents,” Paper 6 at 8, here each of Patent Owner’s five asserted patents has an active post-grant validity challenge. In addition to the present proceeding, U.S. Patent No. 7,513,238 is challenged in *Nissan Motor Co., Ltd. v. Longhorn Automotive Group LLC*, IPR2025-01089 (P.T.A.B.); U.S. Patent No. 7,987,002 is challenged in *Ex Parte* Reexamination Control No. 90/019,867, with an office action dated August 6, 2025, rejecting 10 claims; U.S. Patent No. 8,085,192 is challenged in *Volkswagen Group of Am., Inc. v. Longhorn Automotive Group LLC*, IPR2025-01064 (P.T.A.B.); and U.S. Patent No. 8,810,803 is challenged in *Koito Mfg. Co., Ltd. v. Longhorn Automotive Group LLC*, IPR2025-00955 (P.T.A.B.).⁴ Nevertheless, given the pending status of these challenges to the asserted patents, and the potential for others

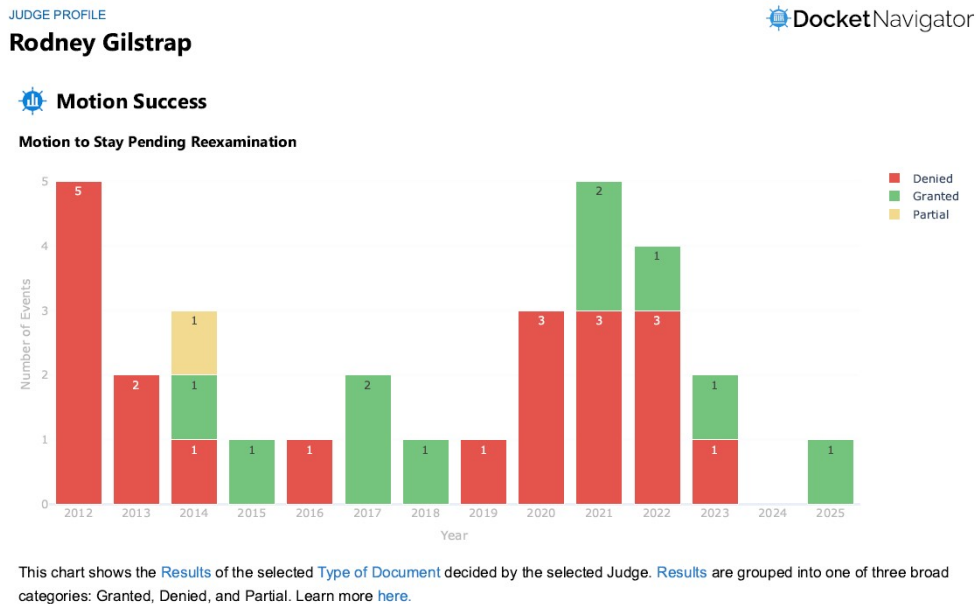
⁴ *Volkswagen Group of America, Inc. v. Longhorn Automotive Group LLC*, IPR2025-00925 (P.T.A.B.) challenges U.S. Patent No. 8,085,192 and, while discretionarily denied on September 12, 2025, remains open for Director Review and further proceedings. *Koito Manufacturing Co., Ltd. v. Longhorn Automotive Group LLC*, IPR2025-00955 (P.T.A.B.) challenges U.S. Patent No. 8,810,803 and, while discretionarily denied on September 19, 2025, also remains open for Director Review and further proceedings.

in the future, this factor should be weighed neutrally. *See Nikon Corp.*, IPR2024-01374, Paper 19, at 10 (concluding “[w]e will not attempt to predict how the court in the parallel district court proceedings would proceed if a stay is requested because the court may determine whether or not to stay any individual case based on a variety of circumstances and facts beyond our control and to which the Board is not privy,” and weighing Factor 1 neutrally). By contrast, Patent Owner’s reliance on *Force Mos Technology, Co., Ltd. v. ASUSTek Computer, Inc.* is inapt, since in that case only two of the three asserted patents were challenged, the petition was filed nearly a year after the case was filed, and the petition was filed more than five months after infringement contentions were served. No. 2:22-CV-00460-JRG, 2024 WL 1586266, at *3 (E.D. Tex. Apr. 11, 2024). No comparable circumstances exist here.

Further, based on Docket Navigator statistics, Judge Gilstrap has trended toward granting motions to stay for both IPRs and requests for reexamination in recent history. *See* Ex-1053; Ex-1054.



Ex-1053



Ex-1054

Notably, included in the calculations of denials are requests for stay filed prior to the institution of Patent Office challenges which are denied without prejudice, with the understanding that motions will be refiled and likely granted following

institution. The actual grant-rates are thus higher than they may appear. Based on these statistics and trends, it is likely that a stay will be granted in the parallel litigation post-institution.

Thus, Factor 1, properly considered for how the district court will likely rule post-institution under the particular facts here, should weigh neutrally.

B. Factor 2 (Parallel Trial Date) is at Least Neutral for Discretionary Denial Because the Board is Likely to Issue a Final Written Decision 0.5 Months Before a District Court Trial

Factor 2 weighs against discretionary denial because the Board will likely issue its FWD *0.5 months before* any district court trial, and well before the district court renders its final judgment. Patent Owner's contrary argument is artificial because it fails to account for any statistical time-to-trial data for the district court, which the Board regularly considers instead of just initially scheduled trial dates. According to the current and official federal government statistics for the Eastern District of Texas, trial is expected to begin approximately 25.9 months from the filing of the case. Ex-1055 at 35.⁵ Trial will likely begin in *mid-January 2027—0.5 months after* a FWD on December 23, 2026.

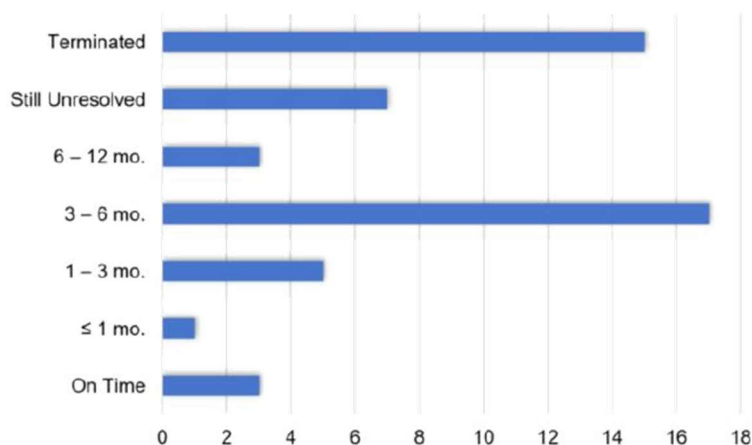
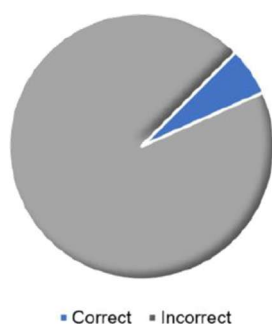
⁵ The actual date is likely to be later, since this case took substantial time to accomplish service for the foreign defendants—2.5 months for Volkswagen AG and 6 months for Audi AG. Ex-1056, at 5, 8.

The Board routinely considers statistical time-to-trial data for cases before the district court in evaluating *Fintiv* Factor 2, not merely initially scheduled trial dates. *See, e.g., Aylo Freesites Ltd v. WellcomeMat, LLC*, IPR2024-00710, Paper 13, at 14-15 (P.T.A.B. Sept. 5, 2024) (considering “recent ***median time-to-trial statistics*** for the Eastern District of Texas” making FWD date two months before expected trial date, and finding “*Fintiv* Factor 2 weighs against” discretionary denial) (emphasis added); *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00321, Paper 10, at 10 (P.T.A.B. June 18, 2025) (considering “recent ***median time-to-trial statistics*** for Judge Gilstrap” and finding “this factor is neutral or weighs slightly against discretionary denial”) (emphasis added); *BOE Tech. Group Co., Ltd. v. Optronix Sciences, LLC*, IPR2024-01133, Paper 16, at 10-11 (P.T.A.B. Jan. 27, 2025) (considering “***median time to trial***” statistics for Judge Gilstrap to conclude that trial “is around the same time or after the” FWD date, and thus “this factor weighs against” discretionary denial) (emphasis added).

The Board considers statistically forecasted trial dates over initially scheduled dates for good reason. The district court case here is scheduled for jury selection on August 17, 2026, but 10 cases are scheduled to begin jury selection that day alone, with 31 cases scheduled to begin jury selection throughout August 2026. *See* Ex-1057. The trial date is statistically very likely to be delayed, as shown below. *See* Ex-1058 (studying reliance on the initially scheduled trial dates in *Fintiv* analysis

and finding the dates were “wrong 94% of the time” compared to the actual trial dates, the vast majority being delayed 3-6 months). Statistically, trial in the present case likely will begin well after the FWD deadline.

PTAB Accuracy Predicting Future Trial Dates



Ex-1058, at 2-3

As described in the table below, data from Docket Navigator indicates that of the cases before Judge Gilstrap making it to trial in the last year, *all* cases except one were delayed—half by four months or more. Ex-1059. Statistically, therefore, the Board will likely reach a FWD before trial begins (especially since the Board often issues DIs and FWDs before their statutory deadlines).

Case	Filing	Original Trial	Actual Trial	Days Trial Delayed
<i>Mojo Mobility Inc v. Samsung Elecs. Co., Ltd., et al.</i> , No. 2-22-cv-00398	10/7/2022	8/5/2024	9/6/2024	32

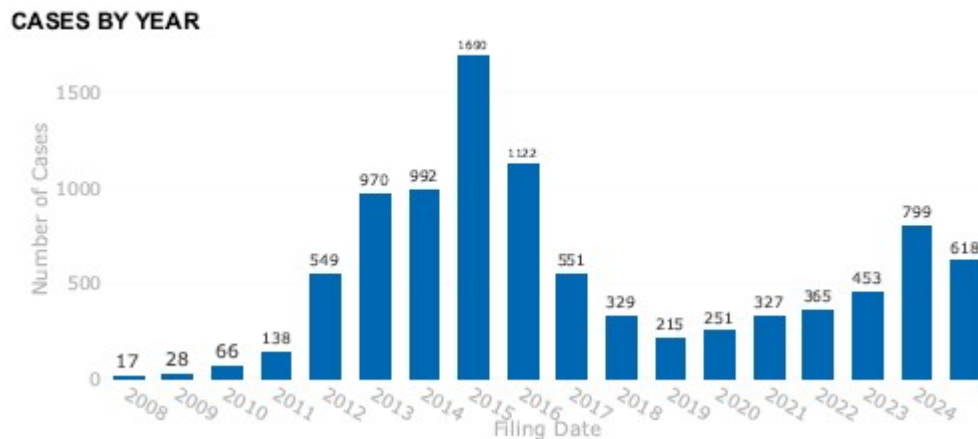
<i>Pardalis Tech. Licensing, LLC v. Int'l Bus. Machines Corp.</i> , No. 2-22-cv-00452	11/22/2022	8/19/2024	9/20/2024	32
<i>Touchstream Techs., Inc. d/b/a Shodogg v. Charter Commc'ns, Inc. et al.</i> , No. 2-23-cv-00059	2/16/2023	10/28/2024	3/3/2025	126
<i>Headwater Research LLC v. Samsung Elecs. Co., Ltd. et al.</i> , No. 2-23-cv-00103	3/10/2023	1/6/2025	4/21/2025	105
<i>General Access Solutions, Ltd. v. T-Mobile US, Inc. et al.</i> , No. 2-23-cv-00158	4/6/2023	1/27/2025	4/7/2025	70
<i>Daingean Techs. Ltd. v. T-Mobile USA, Inc. et al.</i> , No. 2-23-cv-00347	7/24/2023	4/7/2025	7/7/2025	91
<i>Headwater Research LLC v. Verizon Commc'ns Inc. et al.</i> , No. 2-23-cv-00352	7/28/2023	5/19/2025	7/16/2025	58
<i>Empire Tech. Development LLC v. Samsung Elecs. Co., Ltd. et al.</i> , No. 2-23-cv-00427	9/18/2023	6/23/2025	6/23/2025	0
<i>Netlist, Inc. v. Samsung Elecs.</i>	8/1/2022	4/15/2024	11/12/2024	211

<i>Co., Ltd. et al.</i> , No. 2-22-cv-00293				
<i>Correct Transmission, LLC v. Nokia Corp. et al.</i> , No. 2-22-cv-00343	9/2/2022	4/15/2024	10/30/2024	198
<i>Headwater Research LLC v. Samsung Elecs. Co., Ltd. et al.</i> , No. 2-22-cv-00422	10/26/2022	8/5/2024	1/13/2025	161
<i>Force MOS Tech. Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2-22-cv-00460	11/28/2022	10/7/2024	2/7/2025	123
<i>Multimedia Techs. Pte. Ltd. v. LG Elecs. Inc. et al.</i> , No. 2-22-cv-00494	12/23/2022	11/18/2024	5/19/2025	182
<i>General Access Solutions, Ltd. v. Cellco Partnership d/b/a Verizon Wireless et al.</i> , No. 2-22-cv-00394	10/10/2022	6/24/2024	12/6/2024	165
			Average	111

Ex-1059 Judge Gilstrap Trial Delays (Past Year)

These delays are almost certain to worsen by the scheduled jury selection date here. The trials above involve cases filed in 2022 and 2023. *Id.* The present case was filed in late 2024. As indicated below, the district court's case filings have essentially ***doubled*** since 2022 and 2023—a continuing trend—with 927 cases

projected by the end of 2025 based on caseload to date. *See* Ex-1060. This is also suggested by the federal judicial data noted above, which show a continuously increasing time-to-trial in the Eastern District of Texas: 19.0 months in 2023, 21.3 months in 2024, and 25.9 months in 2025. Ex-1055. Delays are thus likely to lengthen, and delays last year already averaged nearly four months, ranging up to seven months. *See* Ex-1059. Just 1 of 14 jury trials began as scheduled. *Id.*



Ex-1060 Judge Gilstrap Docketed Cases by Year

The main purpose of *Fintiv* Factor 2 is to ensure efficiency and avoid duplicative efforts. Given Petitioner’s broad stipulations here, there can be no repetition or inefficiency: the IPR would be a true alternative for prior art challenges, as Congress intended. *See* 77 Fed. Reg. 48612 (Aug. 14, 2012) (“The purpose of the AIA and this final rule is to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.”).

Patent Owner's cited cases are all irrelevant because, unlike here, they concern situations where a district court trial date precedes a FWD. In *Supercell Oy v. Gree, Inc.*, the trial date was nearly 11 months **before** the FWD date, and had special certainty since it was "accelerated" by two weeks by the court and the petitioner's request for a continuance was denied. IPR2020-00513, Paper 11, at 9 (P.T.A.B. June 24, 2020). By contrast, here the expected trial date is 0.5 months **after** the FWD date and no special certainty exists as in *Supercell*. Likewise, in *Edward LifeSciences Corp. v. Evalve, Inc.*, a trial was scheduled nine months **before** the FWD and the court's "comments in the docket reflect an intent to preserve this trial date." IPR2019-01479, Paper 7, at 7 (P.T.A.B. Feb. 26, 2020). Similarly, in *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, trial was set six months **before** a FWD. IPR2019-01218, Paper 7, at 9-10 (P.T.A.B. Jan. 7, 2020). In *Next Caller Inc. v. TRUSTID, Inc.*, the trial was not only set to occur "several months" **before** a FWD, but was also "on track." IPR2019-00961, Paper 10, at 14-15 (P.T.A.B. Oct. 16, 2019). In *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, trial was set six months **before** a FWD. IPR2020-00122, Paper 15, at 7 (P.T.A.B. May 15, 2020). In *Cisco Sys., Inc. v. Esteche Sys., Inc.*, **two** trials **preceded** a FWD: one by 11 months and the other by 7 months. IPR2021-00329, Paper 13, at 7-15 (P.T.A.B. July 6, 2021). In *F5 Networks, Inc. v. WSOU Invs., LLC*, trial was set for six months **before** a FWD and, "even if [petitioner's] requested extension were granted, the 'trial would still

occur nearly five months **before** a FWD.” IPR2022-00239, Paper 12, at 8 (P.T.A.B. May 19, 2022) (emphasis added). In *Google LLC v. EcoFactor, Inc.*, trial was set “more than six months **before**” a FWD, and the “parties agreed that trial should proceed” within one month of scheduling. IPR2021-00488, Paper 12, at 12 (P.T.A.B. Aug. 11, 2021) (emphasis added). In *Cisco Sys., Inc. v. Oyster Optics, LLC*, trial was set for seven months **before** a FWD. IPR2021-00238, Paper 10, at 12 (P.T.A.B. June 1, 2021). Lastly, in *Samsung Elecs. Co. v. Truesight Commc’ns LLC*, trial was “likely to occur at least six months **before** the projected statutory deadline for a” FWD. IPR2025-00123, Paper 12, at 7 (P.T.A.B. Apr. 22, 2025) (emphasis added). Patent Owner’s argument that the “final rule governing Director Review of PTAB decisions” postdated *Fintiv* also misses the point. Paper 6, at 7. The authority cited and compared in detail above by Petitioner postdates *Fintiv* and considers FWD deadlines, not Director Review deadlines, under the *Fintiv* framework. Not surprisingly, Patent Owner offers no legal authority to support its challenge to the Board’s established practice of considering FWD dates under *Fintiv*. *Id.*, at 7-8. Indeed, Patent Owner’s argument about post-FWD Director Review deadlines backfires, because the district court analog would be post-trial briefing, which extends for several months⁶—much longer than Director Review decisions. If

⁶ A post-trial motion may be filed 28 days after entry of judgment. Fed. R. Civ. P. 59(b). Once a motion is filed, a response is due in 14-days, a reply is due 7 days

Director Review and post-trial motions were considered in the *Fintiv* calculus—which they are not—the result would weigh even more against discretionary denial.

Underscoring the inapplicability of discretionary denial here, denial has been withheld in recent cases where—unlike here—scheduled trial dates predated the FWD deadline. *See Samsung Display Co., Ltd. v. Pictiva Displays Int’l Ltd.*, IPR2024-01222, Paper 12, at 7, 24 (P.T.A.B. Mar. 6, 2025) (seven-month difference); *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01433, Paper 13, at 9, 27 (P.T.A.B. Apr. 7, 2025) (six-month difference); *Kia Corp. v. Emerging Automotive LLC*, IPR2024-01167, Paper 14, at 15, 49 (P.T.A.B. Jan. 27, 2025) (same); *IBM Corp. v. Digital Doors, Inc.*, IPR2023-00973, Paper 10, at 12, 25 (P.T.A.B. Jan. 19, 2024) (five-month difference); *Autonomous Devs.*, IPR2023-01172, Paper 21, at 7, at 17 (same); *MediaTek Inc. v. Daedalus Prime LLC*, IPR2025-00100, Paper 10, at 27, 35 (P.T.A.B. May 19, 2025) (four-month difference). The circumstances here are much more favorable for institution, and unsuitable for discretionary denial, since the FWD will significantly predate the expected trial and Petitioner has entered stipulations far broader than in any of these exemplary cases. *See Tesla, Inc. v. U.S. Sec’y of the Navy*, IPR2025-00341, Paper 12, at 2-3 (P.T.A.B. June 13, 2025) (broad

thereafter, and a sur-reply may be filed 7 days after that—unless these dates are extended. E.D. Tex. Local Rule CV-7(e)-(f). After this of 56 days of briefing, which often is extended, the motion is submitted to the court for consideration in due course.

stipulation outweighed other *Fintiv* factors, including trial date). For all of these reasons, *Fintiv* Factor 2 is at least neutral for discretionary denial.

C. Factor 3 (Investment in Parallel Proceeding at the DI Deadline) Weighs Against Discretionary Denial Because the District Court Case Will be in Its Early Stages, With the *Markman* Hearing After the DI Deadline

“If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.” *Fintiv*, IPR2020-00019, Paper 11, at 10. Factor 3 thus weighs against discretionary denial because the DI deadline (December 23, 2025) is before the onset of even claim construction *briefing* (January 15, 2026-February 5, 2026), let alone the *Markman* hearing (February 26, 2026), and the court has yet to hold any hearings or issue any substantive decisions related to the ’353 patent. Ex-1051. Indeed, Petitioner’s invalidity contentions for the ’353 patent are not due until September 27, 2025. *Id.* This weighs against discretionary denial. *See Nikon Corp.*, IPR2024-01374, Paper 19, at 18 (granting institution where “the district court has not issued any substantive orders related to the” challenged patent).

Patent Owner points only to its infringement contentions and the fact that “claim construction proceedings will begin on October 23, 2025, more than two (2) months before the institution deadline” in support of discretionary denial. *See* Paper 6, at 8-9. That is not enough. *See SAP*, IPR2024-01433, Paper 13, at 10-11

(rejecting the notion that such activities constitute significant investment and concluding Factor 3 favors institution); *Kia*, IPR2024-01167, Paper 14, at 16-17 (same); *Autonomous Devs.*, IPR2023-01172, Paper 21, at 7-9 (same). No party has responded to interrogatories in the parallel litigation, and the only document productions to date have been those strictly required by the Eastern District of Texas local rule P.R. 3-2 (document production accompanying initial disclosures). Indeed, Patent Owner has produced only a single PDF file compromised only of public information. Ex-1061. No answer has been filed in response to the complaint, and two motions to dismiss remain pending before the Court. Ex-1056. The close of fact discovery, expert discovery, and the claim construction hearing fall well after the DI deadline. Ex-1051. It is thus false for Patent Owner to claim—without any legal or factual support—that “[t]he parties’ and the Court’s investment in the parallel proceeding weighs in favor of discretionary denial.” Paper 6, at 9. Factor 3 weighs strongly ***against*** discretionary denial. *See SAP*, IPR2024-01433, Paper 13, at 11 (finding Factor 3 weighs against discretionary denial where *Markman* hearing was rescheduled from before DI deadline to after DI deadline); *Kia*, IPR2024-01167, Paper 14, at 17 (finding Factor 3 weighs against discretionary denial where “[f]act and expert discovery are ongoing [for six more weeks and 11 more weeks], respectively” and *Markman* hearing was rescheduled from before DI deadline to after DI deadline); *Autonomous Devs.*, IPR2023-01172, Paper 21, at 8-9 (finding

Factor 3 weighs against discretionary denial where “fact discovery is ongoing[and] expert discovery has not begun” and “the District Court has yet to issue a claim construction order”).

Comparing the timeline in the present case to other cases with analogous timelines, as in the table below, confirms that Factor 3 weighs against discretionary denial. *Compare* Ex-1051, *with* Ex-1062—Ex-1070.

Stage	<i>SAP</i> (Instituted)	<i>Kia</i> (Instituted)	<i>Pictiva</i> (Instituted)	Parallel Case
Service of Complaint	219 days (9½ mos.) before IPR	294 days (10 mos.) before IPR	287 days (9½ mos.) before IPR	122 days (4 mos.) before IPR ⁷
Invalidity contentions	127 days before IPR	109 days before IPR	62 days before IPR	
	IPR Filed			
				97 days after IPR
CC Briefing ⁸	47 days before DI	53 days before DI	72 days before DI	
CC Hearing			30 days before DI	
	Decision on Institution (DI)			
CC Briefing				24 days after DI
CC Hearing	17 days after DI	18 days after DI		65 days after DI
Fact Discovery Close	1 month after DI	1 month after DI	4 days after DI	3 months after DI
Expert Discovery Close	2½ months after DI	2½ months after DI	1½ months after DI	5 months after DI
Est. Trial	4 days before FWD	2 months before FWD	2½ months before FWD	
	Final Written Decision (FWD)			
Est. Trial				0.5 months after FWD ^{9,10}

⁷ Complaint served on January 28, 2025.

⁸ Using the due date for the Opening Claim Construction Brief.

⁹ Using 25.9 months from the filing of the Complaint as estimated in current federal government statistics for Eastern District of Texas. Ex-1055.

¹⁰ Using estimated FWD of December 23, 2026.

In all three cases above, Factor 3 was found to weigh affirmatively *against* discretionary denial. *See SAP*, IPR2024-01433, Paper 13, at 11 (“We conclude that [Factor 3] *favours institution*.” (emphasis added)); *Kia*, IPR2024-01167, Paper 14, at 17 (finding Factor 3 “weighs *against discretionary denial*” (emphasis added)); *Pictiva*, IPR2024-01222, Paper 12, at 7 (finding Factor 3 “*weighs against denial*” (emphasis added)). There is no reason to find otherwise in the present case, where the case schedule has not advanced as much.

Unlike the cases above, the DI deadline in the present case precedes claim construction briefing. It also precedes the *Markman* hearing by three months—far more than in any of the cases above. The present case is much less advanced by comparison. Each of the dates for the close of fact discovery, close of expert discovery, and trial are months longer relative to the DI deadline when compared to the cases above.

Moreover, as explained for Factor 1, “the most burdensome parts of the case” still “all lie in the future” after the DI deadline. *Cywee*, 2019 WL 11023976, at *6. Comparing the present case to comparable cases before Judge Gilstrap demonstrates that the court itself would agree the stage of this case is not advanced. *See supra* § III.A. What matters, as shown above, is the significant substantive work that would remain after the DI deadline, such that investment in the parallel proceedings before the DI deadline will have been minimal. So much time remains in the

schedule after the DI deadline that instituting IPR would minimize (perhaps altogether eliminate) the investment by the parties and the court necessary to resolve the disputes. Tellingly, Patent Owner provides no legal authority in support of its position that Factor 3 supports denial of institution. *See* Paper 6, at 8.

Lastly, Patent Owner’s unexplained assertion of “[d]elay” by Petitioner is incorrect. Paper 6, at 8. Because Petitioner was diligent filing the Petition, this further weighs against discretionary denial under *Fintiv* Factor 3. The Petition was filed within ***two months*** of Patent Owner’s infringement contentions in district court, and the Board has held filing a petition “within ***four months***” shows diligence. *See Mojo Mobility*, IPR2023-01090, Paper 11, at 19 (“this factor weighs against exercising discretion to deny institution”). Further, the Petition was filed such that the *Markman* hearing is scheduled three months after the DI, which also demonstrates diligence. *See Canadian Solar Inc. v. Maxeon Solar Pte. Ltd.*, IPR2024-01038, Paper 13, at 31 (P.T.A.B. Jan. 14, 2025) (petitioner acted “expeditiously” where “the Markman hearing is not scheduled to occur for several months”). Indeed, petitions are deemed “expeditious” even if filed such that the DI occurs ***after*** the *Markman* hearing but before an order. *See CardWare Inc.*, PGR2023-00012, Paper 14, at 19 (“[T]his factor weighs slightly against exercising discretion to deny institution”). By any measure, the Petition here was expeditious and Petitioner was diligent.

Because investment in the parallel district court litigation has been and will remain minor by the DI deadline, Factor 3 weighs against discretionary denial.

D. Factor 4 (Overlap Between Petition and Parallel Proceeding) Weighs Against Discretionary Denial Because Petitioner Has Committed to Extraordinarily Broad Stipulations and the Petition Includes Additional Claims

Factor 4 weighs strongly against discretionary denial because Petitioner has committed to extremely broad stipulations that would eliminate all overlap between this IPR and the district court action.

First, a *Sotera* stipulation remains a weight “*strongly against*” denial. *Samsung Elecs. Co. v. Truesight Commc’ns LLC*, IPR2024-01477, Paper 12, at 14 (P.T.A.B. Apr. 21, 2025) (emphasis added). Petitioner offered a *Sotera* stipulation here with the Petition. Paper 1, at 151. Patent Owner identifies no issue with this stipulation. *See generally* Paper 6. Thus, this stipulation alone weighs heavily against discretionary denial.

Additionally, to avoid any doubt about potential overlap between this IPR and the district court proceeding, Petitioner now further offers a stipulation that extends well beyond *Sotera*, making this IPR an absolute alternative to district court for invalidity based on prior art. Specifically, Petitioner stipulates that if the Board institutes this IPR and institution is not subsequently vacated, reversed, or otherwise withdrawn by rehearing or Director Review, Petitioner will not pursue against any

of the claims challenged in this IPR proceeding, in any pending district court litigation, the following: (i) the specific grounds raised in the instituted IPR proceeding; (ii) any other grounds that reasonably could have been raised before the Board in the instituted IPR proceeding (i.e., any ground that reasonably could have been raised under pre-AIA §§ 102 or 103 on the basis of prior art patents or printed publications); or (iii) any other invalidity ground under pre-AIA §§ 102 or 103 involving any type of legally recognized prior art, including any patent, printed publication, or system art.

These stipulations weigh very heavily against discretionary denial. *See, e.g., Tesla*, IPR2025-00341, Paper 12, at 2; *Tesla, Inc. v. Intell. Ventures II*, IPR2025-00339, Paper 10, at 2 (P.T.A.B. June 13, 2025). They would ensure that this IPR, if instituted, would be a true alternative to litigation and would substantially simplify issues in district court. *See Shenzhen Tuozhu Technology*, IPR2025-00321, Paper 10, at 13-14 (noting that “Patent Owner does not address Petitioner’s updated second stipulation” and broad stipulation “weighs against exercising discretion to deny institution”).

E. Factor 5 (Whether the Parties Are the Same) Does Not Favor Discretionary Denial Because the Parties Are Almost Always the Same

The parties or RPIs here overlap with those at the district court. Although the Board has taken varying approaches to the weighing of this factor under such

circumstances, persuasive Board authority reasons that this factor should be considered “neutral” where, as here, other *Fintiv* factors more heavily guide the analysis. “Under these circumstances, the fifth *Fintiv* factor’s weight is neutral.” *Shenzhen Root Tech. Co., Ltd. v. Chiaro Tech. Ltd.*, IPR2024-01296, Paper 9, at 20 (P.T.A.B. Feb. 25, 2025). Patent Owner’s position to the contrary, Paper 6 at 4-5, fails to account for this authority, or indeed any Board authority at all.

F. Factor 6 (Other Considerations—including Settled Expectations, Material Error During Prosecution, Complexity of the Case, and the Strength of the Petition) Weighs Against Discretionary Denial

All considerations under Factor 6 weigh heavily *against* discretionary denial, aside from possible adjudication on other forums, which is neutral.

1. Settled Expectations Weigh Against Discretionary Denial

Patent Owner’s “settled expectations” argument, Paper 6 at 9-10, is refuted by consistent Board decisions rejecting discretionary denial where a material mistake was made during examination. Patent Owner’s conclusory assertions to the contrary fail to account for these facts and caselaw. *See supra* § II.A. Patent Owner can have no settled expectations deriving from the age of the patent because: the Office made an error in issuing claim 1 that the applicant identified but was not corrected; Patent Owner has shifted this patent to accuse new areas of technology; Petitioner makes a broad stipulation and Patent Owner has asserted this patent alongside diverse,

unrelated patents; and Patent Owner has not commercialized, marked, or previously asserted this patent. *See supra* § II.A.

2. The Strength of Petitioner’s Grounds Weighs Against Discretionary Denial

Patent Owner’s assertion that “the Petition is weak,” Paper 6 at 10, is not only conclusory and unexplained, but demonstrably false. Patent Owner nonsensically contends the “Petition is effectively a copy-and-paste of the expert declaration” because a “substantive portion” of the Petition is 125 pages long while the “substantive grounds” of the expert declaration are 231 pages long. Paper 6, at 10. That defies logic. The Petition is self-evidently not a “copy-paste” of the declaration in the cited portions. It is 106 pages shorter. Patent Owner’s unexplained assertion should be rejected. *Twitch Interactive, Inc. v. Razdog Hldgs. LLC*, IPR2025-00307, Paper 18, at 3 (P.T.A.B. May 16, 2025).

Moreover, the fact that the declaration is longer than the Petition weighs against discretionary denial. *See iRhythm Tech., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10, at 2-3 (P.T.A.B. June 6, 2025). Dr. Peterson provides the additional “technical detail, explanation, or statements” the Board seeks from experts. *See Xerox, Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12, at 5 (P.T.A.B. Feb. 10, 2023). As just one example, Dr. Peterson devotes over ten pages of text and figures to the Technical Background section, where he presents and discusses numerous

references. Peterson, ¶¶42-53. That is nearly twice the Petition’s six-page Technical Background section, which relies on Dr. Peterson’s expert opinion for supporting detail. Paper 1, at 3-9. Such appropriate presentation of expert opinion “weighs *against* discretionary denial.” See *iRhythm*, IPR2025-00363, Paper 10, at 2-3 (emphasis added) (finding use of “expert to explain the background knowledge of a person of ordinary skill in the art” and “provide[] citations to evidence in support of his statements in the required manner” weighed against discretionary denial).

The strength of Petitioner’s grounds is also demonstrable. The Petition presented *thirteen* ways the prior art reference *Weese* alone renders all claims obvious. And it explained why *Wainer* alone also renders all claims obvious. This is no surprise. The independent claims “form combination images ‘based on’: two imaging techniques, two independent ‘movement measurements,’ and two movement states.” Paper 1, at 3 (citing Ex-1001, at 1:8-35; Peterson ¶¶36-50). *Weese* and *Wainer* do the same, each describing combining images from two imaging modalities using measurements from two sensor systems to account for patient movement. See, e.g., Paper 1, at 17-22 (*Weese* overview), 78-83 ([1e] analysis, describing thirteen ways *Weese* combines CT and PET images), 25 (*Wainer* overview), 138-141 ([1e] analysis, describing fusion of dual-gated images in *Wainer*).

The merits here are thus strong. Because the merits are demonstrable and Patent Owner has made no specific argument to the contrary, *see* Paper 6 at 10, this further supports rejecting discretionary denial on this record.

3. No Forum Has Adjudicated Any Claim of the '353 Patent, and the Lack of Serial Challenges Do Not Favor Discretionary Denial

No forum has yet considered the validity of the '353 patent, and with Petitioner's broad stipulations, this IPR would be the sole proceeding in which Petitioner would do so were this IPR instituted. No claim of the '353 patent has been reexamined, and the '353 patent has not been reissued. This is the only Petition filed against the '353 patent. Thus, there are no "multiple, serial" petitions here. *See Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 18, at 3-6 (P.T.A.B. Aug. 23, 2022) (citing *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017)) (discussing considerations for discretionary denial involving serial challenges). This weighs against discretionary denial.

In addition, the Petition challenges some claims not asserted in other cases involving the '353 patent, which further weighs against discretionary denial. Patent Owner no longer asserts claims 12-18, which this IPR challenges, in *Longhorn Auto. Grp. v. Mitsubishi Motors Corp.*, 2:24-cv-00685 (E.D. Tex.), *Longhorn Auto. Grp. v. Mazda Motor Corp.*, 2:24-cv-00686 (E.D. Tex.), and *Longhorn Auto. Grp. v.*

Volvo Car Corp., 2:24-cv-00603 (E.D. Tex.). *See* Ex-1071. Patent Owner is likely to drop these claims in other litigations too because, as the Petition pointed out, they include means-plus-function limitations but the '353 patent does not disclose sufficient structure. Paper No. 1, at 9-17. That the Petition challenges claims not present in those cases weighs against discretionary denial.

In view of the above considerations, this consideration is neutral for discretionary denial.

IV. *Inter Partes* Review of the '353 Patent Is an Appropriate Use of Office Resources in View of Compelling Economic Considerations

Compelling economic and policy considerations also make IPR of the '353 patent an appropriate and valuable use of the Office's resources. Petitioner is a vibrant U.S. company and a significant contributor to the U.S. economy. Petitioner, an indirect subsidiary of Volkswagen AG, handles operations of a worldwide family of storied automotive brands. Ex-1072. In addition, Volkswagen Group of America Chattanooga Operations, LLC, a wholly owned subsidiary of Petitioner, operates a state-of-the-art assembly facility in Chattanooga, Tennessee. *Id.* Petitioner's headquarters are in Reston, VA.

Petitioner has approximately 10,000 employees in the United States. *Id.* Of these employees, approximately 4,500 are based in Chattanooga, TN, where Petitioner's 3.8 million square-foot facility produces models such as the Volkswagen

ID.4, Atlas, and Atlas Cross Sport. Ex-1073, at 1. Since 2008, Petitioner invested more than \$4.3 billion in the Chattanooga assembly plant, which has led to more than 125,000 direct and indirect jobs. *Id.*, at 3. Indeed, the unemployment rate in Chattanooga in 2008 was more than 10%, but by 2023 it dropped to 3.5%—a testament to Petitioner’s commitment to job creation in the United States. *Id.* The facility and several employees are pictured below:



In view of Petitioner’s significant positive impact on and contribution to the U.S. economy, sound economic and public policy rationales support Petitioner being able to bring the present Petition for consideration by the Office. By contrast, Petitioner is aware of no comparable evidence of Patent Owner’s contributions or support. On balance, therefore, this factor should weigh against discretionary denial.

V. Conclusion

For the foregoing reasons, under the particular facts of this case this Petition should be referred to the Board panel with instructions to consider the merits.

Dated: September 23, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

As calculated by the “Word Count” feature of Microsoft Word for Microsoft 365, the foregoing **Petitioner’s Opposition to Patent Owner’s Discretionary Denial Request** contains 11,250 words, excluding this Certification and the following: Table of Contents, Table of Authorities, List of Exhibits, and Certificate of Service.

Dated: September 23, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Petitioner's Opposition to Patent Owner's Discretionary Denial Request and Exhibits 1030-1073** were served on September 23, 2025, via e-mail directed to counsel of record for Patent Owner at the following:

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Patent Owner has consented to electronic service by email.

Dated: September 23, 2025

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