UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROAMPAC HOLDINGS INC.,
Petitioner,

v.

SIGMA TECHNOLOGIES INT'L, LLC,
Patent Owner.

Case IPR2025-01143
Patent No. 11,072,148

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

TABLE OF CONTENTS

I. INTRODUCTION 1
II. DISCRETIONARY DENIAL UNDER *FINTIV* IS NOT WARRANTED 3
A. Factor 1: The Court is Likely to Grant a Stay Upon Institution 3
B. Factor 2: The PTAB's Final Written Decision Will Issue Before the District Court Trial 4
C. Factor 3: Minimal Investment Has Been Made in the Litigation, Particularly By Pratt 5
D. Factor 4: There Will Be Little to No Overlap Between the Proceedings 8
1. Majority of the Claims are at Issue Before the PTAB Only 9
2. Petitioner's *Sotera* Stipulation Eliminates the Risk of Overlap Between the Proceedings 10
E. Factor 5: Petitioner and Defendant Being the Same Weighs Slightly Against Discretionary Denial or, at Worst, Neutralizes this Factor 12
F. Factor 6: Patent Owner's Remaining Considerations Do Not Favor Discretionary Denial 13
1. Patent Owner Has Not Developed Settled Expectations 13
a. The '148 Patent has been in force for only four years 13
b. Patent Owner fails to show commercialization of the '148 Patent 15
2. The IPR Petition Asserts References the Examiner Did Not Consider 18
3. No Other Factors Support Discretionary Denial 19
III. CONCLUSION 20

TABLE OF AUTHORITIES

Page(s)

Cases

Amazon.com, Inc. v. NL Giken Inc.,
IPR2025-00250, Paper 14 (Director May 16, 2025) 4

Apple Inc. v. Apex Beam Techs. LLC,
IPR2025-00896, Paper 10 (Director Sept. 3, 2025) 5, 14

Apple Inc. v. Fintiv, Inc.,
IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) .....*passim*

Consumeron, LLC v. MapleBear Inc.,
No. CV 21-1147-GBW-MPT, 2023 WL 3434002 (D. Del. May 12, 2023) 4

Dabico Airport Sols. Inc. v. AXA Power APS,
IPR2025-00408, Paper 21 (Director June 18, 2025) 13, 14

Facebook, Inc. v. Search and Social Media Partners, LLC,
IPR2018-01620, Paper 8 (PTAB Mar. 1, 2019) 6

Fox Grp., Inc. v. Cree, Inc.,
700 F.3d 1300 (Fed. Cir. 2012) 9

GD Energy Prods. LLC v. Kerr Mach. Co.,
PGR2025-00031, Paper 11 (Director June 25, 2025).....19

Google LLC v. Wildseed Mobile, LLC,
IPR2023-00247, Paper 10 (PTAB June 6, 2023) 8

Google LLC v. Withrow Networks, Inc.,
IPR2025-00775, Paper 10 (Director Aug. 14, 2025).....14

HP Inc. v. Slingshot Printing LLC,
IPR2020-01084, Paper 13 (PTAB Jan. 14, 2021) 13

Ingenico Inc. v. IOENGINE, LLC,
136 F.4th 1354 (Fed. Cir. 2025) 11

iRhythm Techs., Inc. v. Welch Allyn, Inc.,
IPR2025-00363, Paper 10 (Director June 6, 2025) 17, 19

Microsoft Corp. v. Edge Networking Sys., LLC,
IPR2025-00617, Paper 12 (Director July 31, 2025).....14

Motorola Solutions, Inc. v. Stellar, LLC,
IPR2024-01205, Paper 19 (Director Mar. 28, 2025).....12

NVIDIA Corp. v. Invensas Corp.,
IPR2020-00603, Paper 11 (PTAB Sept. 3, 2020).....12

Palo Alto Networks, Inc. v. Centripetal Networks, Inc.,
IPR2021-01149, Paper 10 (PTAB Feb. 22, 2022).....9

Regeneron Pharm., Inc. v. Novartis Pharma AG,
IPR2021-00816, Paper 13 (PTAB Oct. 26, 2021).....19

Samsung Display Co., Ltd., v. Pictiva Displays Int'l Ltd.,
IPR2024-1222, Paper 12 (PTAB Mar. 6, 2025) 8

Samsung Elecs. Co. v. GhengisComm Holdings, LLC,
IPR2025-00780, Paper 11 (Director Aug. 14, 2025).....15

Samsung Elecs. Co. v. GhengisComm Holdings, LLC,
IPR2025-00788, Paper 11 (Director Aug. 25, 2025).....14, 15

TankLogix, LLC v. SitePro, Inc.,
IPR2025-00650, Paper 10 (Director July 31, 2025).....5, 14

Statutes

35 U.S.C. § 286.....13

35 U.S.C. § 314(b) 6

Other Authorities

37 C.F.R. §42.65(a).....20

EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,072,148
1002	Prosecution File History for U.S. Patent No. 11,072,148
1003	Declaration of Glenn May
1004	Curriculum Vitae of Glenn May
1005	U.S. Patent Publication No. US 2014/0044903 ("Gundlach")
1006	S. Yializis, *Multi-Layer, Low Emissivity, Metallized Materials for Replacing Aluminum Foils in Heat Reflection and Energy Management Applications*, Society of Vacuum Coaters, 52nd Annual Technical Conference Proceedings, 755-759 (May 2009) ("Yializis")
1007	*The Voluntary Standard for Repulping and Recycling Corrugated Fiberboard Treated to Improve Its Performance in the Presence of Water and Water Vapor*, Fibre Box Association (August 16, 2013) ("Voluntary Standard Reference")
1008	U.S. Patent Application Publication No. 2015/0053086 ("Rebouillat")
1009	Plaintiff's Complaint, *Pratt Retail Specialties, LLC v. ProAmpac LLC*, No. 1:24-cv-01073-RGA (D. Del.)
1010	The Wayback Machine – Corrugated Packaging Alliance, "Recyclable Wax Alternatives" Webpage as of September 6, 2015, https://web.archive.org/web/20150906053842/http://www.corrugated.org/ViewPage.aspx?ContentID=41
1011	The Wayback Machine – The Voluntary Standard PDF Provided Via the Corrugated Packaging Alliance Website on September 10, 2015, https://web.archive.org/web/20150910004711/www.corrugated.org/upload/cpa/documents/vol_std_protocol_2013.pdf
1012	ASTM C1371, *Standard Test Method for Determination of Emittance of Materials Near Room Temperature Using Portable Emissometers*, ASTM International (June 2015)

Exhibit No.	Description
1013	*The Oxidation of Metallized Aluminum Films Used in Reflective Insulation and Radiant Barrier Applications*, Reflective Insulation Manufacturers Association International (RIMA-I), Technical Bulletin #106 (May 2009)
1014	ISBN Search Website, https://isbnsearch.org/isbn/9781615831579
1015	C. Bishop, *Vacuum Deposition onto Webs, Films, and Foils* (2d ed. 2011)
1016	M. Linder et al., *Thickness Measurement Methods for Physical Vapor Deposited Aluminum Coatings in Packaging Applications: A Review*, Coating 7(1), 9 (Jan. 14, 2017)
1017	A. Brody et al., *Innovative Food Packaging Solutions*, 73(8) Journal of Food Science 107 (2008)
1018	Declaration of Jonathan M. Hernandez in Support of Motion for *Pro Hac Vice* Admission
1019	Motion Success for Stay Pending IPR Before Judge Andrews (2019-2024), Docket Navigator, available at https://search.docketnavigator.com/patent/judge/1625/0 (last visited Oct. 2, 2025)
1020	Order Granting Def.'s Mot. to Stay Pending the IPR of the Patents-in-Suit, *Targus Int'l LLC v. Victorinox Swiss Army, Inc.*, Case No. 1:20-cv-00464-RGA (D. Del. July 14, 2021), Dkt. 199
1021	Stipulation and Order to Stay Case Pending IPR, *Analog Devices, Inc. v. Xilinx, Inc.*, Case No. 1:19-cv-02225-RGA (D. Del. Feb. 22, 2021), Dkt. 202
1022	Oral Order, *Nikolai Tankovich v. Candela Corp*., Case No. 1:22-cv-01458-RGA-SRF (D. Del. Oct. 2, 2023), Dkt. 92
1023	Motion Success for Stay Pending IPR (Post-Institution) Before Judge Andrews (2019-2024), available at https://search.docketnavigator.com/patent/judge/1625/0 (last visited Oct. 2, 2025)
1024	Pratt Retail Specialties, LLC's Initial Disclosure of Asserted Claims and Infringement Contentions, served July 18, 2025

Exhibit No.	Description
1025	Pratt Retail Specialties, LLC's Amended Initial Disclosure of Asserted Claims and Infringement Contentions, served Aug. 1, 2025
1026	U.S. Courts, Table N/A–U.S. District Courts–Combined Civil and Criminal Federal Court Management Statistics (June 30, 2025), available at https://www.uscourts.gov/data-news/data-tables/2025/06/30/federal-court-management-statistics/n-a-1 (last visited Sept. 23, 2025)
1027	Joint Stipulation and Proposed Order, *Pratt Retail Specialties, LLC v. ProAmpac Holdings Inc.*, No. 1:24-cv-01073-RGA (D. Del. June 18, 2025), Dkt. 42
1028	Docket Text Order re [Dkt. 42] Stipulation and Proposed Order to Amend Certain Case Deadlines, *Pratt Retail Specialties, LLC v. ProAmpac Holdings Inc.*, No. 1:24-cv-01073-RGA (D. Del. June 18, 2025)
1029	ProAmpac Holdings Inc.'s Notice of Service, *Pratt Retail Specialties, LLC v. ProAmpac Holdings Inc.*, No. 1:24-cv-01073-RGA (D. Del. Sept. 25, 2025), Dkt. 77
1030	ProAmpac Holdings Inc.'s Objections and Responses to Pratt Retail Specialties, LLC's Interrogatory No. 8, dated Aug. 27, 2025
1031	Plaintiff Pratt Retail Specialties, LLC's Responses and Objections to Defendant ProAmpac Holdings Inc.'s Second Set of Interrogatories (No. 4), dated Sept. 22, 2025
1032	Plaintiff Pratt Retail Specialties, LLC's First Requests for Production to Defendant ProAmpac LLC (No. 1), dated Apr. 10, 2025

I. INTRODUCTION

Patent Owner Sigma Technologies International, LLC's ("Patent Owner") Request for Discretionary Denial ("Request") should be denied because efficiency, fairness, and the merits support institution. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). As shown below, none of the *Fintiv* factors favor denial. Further, Patent Owner provides unsupported and overly optimistic positions in its Request, all of which should be rejected.

First, Patent Owner obscures how little Plaintiff Pratt Retail Specialties, LLC ("Pratt") has done to prosecute the co-pending district court litigation. Pratt has invested little to no time in that case since filing its complaint in September 2024, serving just one document request in April 2025 and then waiting several more months to serve other discovery, delaying service of its initial infringement contentions, and only producing two documents total until today. The majority of the work remains to be done in the litigation, which will occur mostly *after* the institution decision. Given the litigation's status and the district court judge's 90% rate of granting stay motions post-institution, there is a strong likelihood the litigation will be stayed if the PTAB institutes the IPR.

Second, there will be little to no overlap between the proceedings. The PTAB will consider the patentability of all 15 claims in U.S. Patent No. 11,072,148 ("the

’148 Patent”) upon institution, while the district court will consider less than half of those claims. Importantly, if instituted, the IPR proceeding will conclude *before* the trial date in the district court and should moot Pratt’s infringement case. Further ProAmpac Holdings Inc.’s (“Petitioner”) *Sotera* stipulation (Paper 6) quells any concerns of duplicate efforts or conflicting decisions.

Third, Patent Owner has not shown it has settled expectations in the ’148 Patent, which has been in force for a mere four years. There is no evidence showing Petitioner would have anticipated assertion of the patent against it during that short period. Nor is there sufficient evidence that the patent was commercialized, asserted, licensed, or otherwise applied in the recyclable packaging space. Further, Patent Owner did not allege it marks its products with the patent number. Pratt admitted in the litigation it does not mark its products with the patent number.

Fourth, Petitioner’s invalidity grounds are strong and based on prior art the Examiner did not consider, including Yializis (EX1006). Yializis was authored by an alleged inventor of the ’148 Patent, bears Patent Owner’s name, and was published nearly ten years before the patent was filed. EX1006, 755; EX2002, ¶3. Yet, Yializis was never disclosed during prosecution. EX1001, (56); *see generally* EX1002 (no IDS filed by applicant). Patent Owner has since acknowledged Yializis is relevant to the ’148 Patent, admitting “Yializis (Ex. 1006) discusses thin metallized films already contemplated in the ’148 specification.” Request at 13-14.

Because Patent Owner cannot show that any *Fintiv* factor weighs in favor of discretionary denial, and based on a holistic assessment of all of the evidence and arguments presented, the Request should be denied.

II. DISCRETIONARY DENIAL UNDER *FINTIV* IS NOT WARRANTED

A. Factor 1: The Court is Likely to Grant a Stay Upon Institution

This factor weighs against discretionary denial. While the Court denied Petitioner's initial motion to stay pending IPR, that motion was denied without prejudice. EX2004. The Court also stated it will "promptly" consider a renewed motion and schedule oral arguments if the IPR is instituted. *Id.* It is likely the Court will grant Petitioner's renewed motion to stay.

From 2019 through 2024, the Honorable Judge Richard G. Andrews, who is presiding over the district court litigation, has granted approximately 84% of the motions to stay pending IPR filed in his court. EX1019. Of the small percentage of the motions that were denied, Judge Andrews denied four of them without prejudice, so the defendant could renew the motion if the corresponding IPR was instituted. Three of those four cases were later stayed following institution, while the fourth case was not instituted, mooting the need to renew the motion to stay. EX1020-EX1022. During that same time period, Judge Andrews's grant rate for stay motions filed after institution increased to approximately 90%. EX1023.

Moreover, Pratt has alleged infringement of only claims 7-11, 13, and 14 of

the ’148 Patent. EX1025, 2-3. Upon institution, the PTAB will adjudicate the patentability of all claims, including the seven claims at issue before the Court, strengthening the likelihood that a stay will be granted if an IPR is instituted. *See, e.g.*, *Consumeron, LLC v. MapleBear Inc.*, No. CV 21-1147-GBW-MPT, 2023 WL 3434002, at *2 (D. Del. May 12, 2023) (granting stay where “PTAB has granted IPR proceedings with respect to every asserted claim”).

B. Factor 2: The PTAB’s Final Written Decision Will Issue Before the District Court Trial

This factor weighs against discretionary denial. Based on the Notice of Filing Date Accorded (Paper 4), a final written decision (“FWD”) will issue no later than January 2, 2027, which is before the district court’s currently scheduled trial date of January 4, 2027. EX2005, §15. However, that scheduled trial date is not realistic based on recent Federal Court Management Statistics, which indicate the median time to trial in the District of Delaware is now 35 months from the filing of a case. EX1026, 14. Pratt filed its complaint in the district court on September 25, 2024. EX2003, 1. Based on the Delaware time-to-trial statistics, the district court trial is unlikely to occur until late August 2027, more than seven months after the projected FWD due date. As such, it is highly likely the FWD will issue long before the district court trial occurs, reducing any concern of significant duplication of efforts or inconsistent outcomes. *See, e.g.*, *Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-

00250, Paper 14 at 2 (Director May 16, 2025) (denying discretionary denial request where FWD was due ten days *after* scheduled trial but six months *before* date suggested by time-to-trial statistics for District of Delaware); *Apple Inc. v. Apex Beam Techs. LLC*, IPR2025-00896, Paper 10 at 2 (Director Sept. 3, 2025) (denying discretionary denial request where FWD was due two weeks before scheduled trial date and two months before date suggested by time-to-trial statistics); *TankLogix, LLC v. SitePro, Inc*., IPR2025-00650, Paper 10 at 2 (Director July 31, 2025) (denying discretionary denial request where FWD was due ten days before scheduled trial date and 11 months before date suggested by time-to-trial statistics). Therefore, this factor weighs against discretionary denial.

C. Factor 3: Minimal Investment Has Been Made in the Litigation, Particularly By Pratt

This factor considers "the amount and type of work *already completed* in the parallel litigation by the court and the parties *at the time of the institution decision*." *Fintiv*, Paper 11 at 9 (emphasis added). "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." *Id.* at 10. Patent Owner cites *Fintiv* to argue that denial is favored when "the district court has issued substantive orders related to the patent at issue in the petition." Request at 5 (citing *Fintiv*, Paper 11 at 9-10). However, Patent Owner's argument misses the mark.

Here, the statutory deadline for the institution decision is January 2, 2026. 35 U.S.C. § 314(b). Patent Owner fails to cite a single order that has been or will be issued by the district court before that date. Request at 5-7; EX2003, 1-4 (showing no substantive orders). Instead, Patent Owner identifies events that are scheduled to occur *after* institution, including the January 8, 2026 *Markman* hearing. Request at 5; EX2005, §8. Thus, the district court has not and will likely not issue any substantive orders, including a claim construction order, related to the '148 Patent before institution. This factor weighs against discretionary denial for this reason alone. *Cf. Facebook, Inc. v. Search and Social Media Partners, LLC*, IPR2018-01620, Paper 8 at 24 (PTAB Mar. 1, 2019) (finding district court proceeding in its early stages, with no claim constructions issued and discovery open).

Moreover, contrary to Patent Owner's representations of the case status and "investments" made in the district court litigation, there has been a minimal amount of work completed by the parties—particularly by Pratt. Request at 5-7. Since filing its complaint in September 2024, Pratt has continuously delayed the case and showed little desire to push it forward. For example, Pratt did not serve its complaint on Petitioner until November 18, 2024. EX2003, 1 (D.I. 8). Pratt then waited until April 10, 2025, a month after discovery had opened, to serve a single request for production ("RFP") for samples of the accused products. *Id.* at 2 (D.I. 28); EX1032. Several months later, Pratt requested and received a 30-day extension to serve its

infringement contentions to complete testing of the accused products, pushing out Petitioner's initial invalidity contentions deadline and the claim construction schedule as well. EX1027; EX1028. Despite that extra month, Pratt did not even finish that testing before serving its initial infringement contentions. EX1024, 2-4. Further, it was not until July 28, 2025, nearly seven weeks after Petitioner filed its IPR petition that Pratt served another set of discovery requests on Petitioner. EX2003, 4 (D.I. 56). Pratt has provided no explanation for its delays.

Pratt has also made little to no investment responding to Petitioner's discovery requests. Until today, Pratt had produced no documents in response to Petitioner's RFPs, served on July 8, 2025, August 27, 2025, and September 25, 2025. *Id.* at 4 (D.I. 48, 64); EX1029 (D.I. 77). The only two documents it had previously produced were the '148 Patent and its file history, publicly available documents that were required to be produced as part of Pratt's initial disclosures. EX1024, 9; EX1025, 9; EX2005, §3.g.i. Pratt's production today was three documents, two of which were heavily redacted for unknown reasons.

Most of the work remains to be done in the district court litigation. In addition to claim construction and responding to outstanding discovery requests, the parties have yet to notice or take depositions, serve expert reports, file dispositive motions, or prepare any other trial work. The PTAB has found factor 3 weighs against discretionary denial in cases that had advanced well beyond the stage of the co-

pending litigation. *See, e.g., Samsung Display Co., Ltd., v. Pictiva Displays Int'l Ltd.*, IPR2024-1222, Paper 12 at 7 (PTAB Mar. 6, 2025) (finding factor 3 weighed against denial, even though *Markman* hearing was held, because "much remains to be done, including expert discovery"); *Google LLC v. Wildseed Mobile, LLC*, IPR2023-00247, Paper 10 at 23-25 (PTAB June 6, 2023) (finding factor 3 favored institution and "much work remains," even though infringement and invalidity contentions exchanged, and with written discovery in progress and claim construction discovery before institution). Given the early stage of the district court litigation, factor 3 weighs against discretionary denial.

D. Factor 4: There Will Be Little to No Overlap Between the Proceedings

The overlap between issues raised in the petition and the parallel litigation, if any, is minimal because less than half of the claims of the '148 Patent are asserted in the district court, while all claims are challenged here, and Petitioner has stipulated to not pursuing any grounds it raised or reasonably could have raised during this proceeding in that litigation. Factor 4 weighs heavily against discretionary denial. *See Fintiv*, Paper 11 at 12-13 ("[I]f the petition includes materially different grounds, arguments and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution."). Patent Owner's arguments to the contrary, addressed below, do not warrant a different conclusion.

1. Majority of the Claims are at Issue Before the PTAB Only

Patent Owner falsely claims the parallel litigation "encompasses all of the invalidity issues raised in Petitioner's IPR petition." Request at 7. Not so. The district court will only consider the invalidity of the seven asserted claims of the '148 Patent (the sole patent-in-suit), while the IPR petition challenges all 15 claims of the patent, including two additional independent claims. EX1025, 2-3; Paper 1 at 17. Because the PTAB will address more than twice the number of claims than will be addressed by the Court in the district court litigation, factor 4 weighs against discretionary denial. *Palo Alto Networks, Inc. v. Centripetal Networks, Inc.*, IPR2021-01149, Paper 10 at 10-11 (PTAB Feb. 22, 2022) ("Taking into account the stipulation and the number of claims challenged in this proceeding that will not be addressed by the district court, …this factor weighs against exercising our discretion to deny."); *cf. Fox Grp., Inc. v. Cree, Inc.*, 700 F.3d 1300, 1308-09 (Fed. Cir. 2012) ("There was no case or controversy with respect to the unasserted claims…therefore the district court did not have jurisdiction over the unasserted claims.").

Further, Patent Owner claims the IPR petition will only resolve "whether the '148 Patent is invalid under 35 U.S.C. §§ 102 ('anticipated') and 103 ('obvious')." Request at 7. Patent Owner grossly mischaracterizes the number of issues that will be resolved by the IPR petition. Most of the issues in the district court litigation will be effectively resolved/rendered moot, if the PTAB finds the claims of the '148

Patent to be unpatentable. For example, should the PTAB invalidate the '148 Patent, there will be no need to try Pratt's infringement claims or the issues related to damages (e.g., lack of marking), because an invalid patent cannot be infringed. Even if some, but not all, of the claims survive, the infringement issues will nonetheless be simplified.

Patent Owner's emphasis on antitrust, inequitable conduct, and other issues in the district court litigation that are not reviewable in an IPR proceeding misses the mark. Request at 7-8. Factor 4 evaluates "concerns of inefficiency and the possibility of conflicting decisions" when substantially identical prior art is raised in both the district court and the IPR proceeding. *Fintiv*, Paper 11 at 12. It has nothing to do with whether the district court proceeding includes issues outside the PTAB's jurisdiction. For this additional reason, factor 4 weighs against discretionary denial.

2. Petitioner's *Sotera* Stipulation Eliminates the Risk of Overlap Between the Proceedings

Petitioner projects the PTAB will issue a FWD shortly before the currently scheduled trial date and seven months before a projected trial based on the latest time-to-trial statistics for the District of Delaware. *Supra*, §II.A.2. The estoppel arising from the FWD will ensure that the grounds addressed during the IPR will differ from any grounds of invalidity presented during trial, should trial even be needed. Moreover, Petitioner submitted a *Sotera* stipulation that precludes it from

presenting at trial "the specific grounds of invalidity raised in the Petition or any grounds of invalidity that reasonably could have been raised in an *inter partes* review against [the '148 Patent] under 35 U.S.C. §§102 or 103 on the basis of prior art patents or printed publications." Paper 6 at 2 (citations omitted). That *Sotera* stipulation further ensures not only that the grounds raised during IPR will differ from any grounds of invalidity of the '148 Patent presented during trial in the district court litigation, but also that Petitioner will not present different grounds that reasonably could have been raised. Accordingly, if the PTAB institutes the IPR, there will be no overlap in the invalidity arguments between the two proceedings.

Patent Owner argues Petitioner "violated its own *Sotera* stipulation" by serving "invalidity contentions asserting prior art never raised in the Petition." Request at 9-10. Not so. As is standard, Petitioner's *Sotera* stipulation goes into effect upon institution. Paper 6 at 2.

Patent Owner's argument that Petitioner's *Sotera* stipulation "no longer has sufficient breadth" in view of *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354 (Fed. Cir. 2025) is meritless. Request at 9. As stated in the Crouch article cited by Patent Owner, that case concerns instances where a prior art "system was fully documented in publications that could have been raised during the IPR." EX2008, 1. Here, Patent Owner did not identify a single patent or publication asserted in Petitioner's invalidity contentions or in this proceeding that could be used as

evidence of the prior art product asserted in Petitioner's invalidity contentions.

Patent Owner's reliance on *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (Director Mar. 28, 2025) is similarly inapt. In that case, the parties had already completed expert reports, claim construction briefing, and several depositions in the parallel litigation, and the court had held a *Markman* hearing and construed the disputed claim terms. *Id.* at 3. Trial was also set for 11 months before the projected FWD date. *Id.* Accordingly, the Director found "the stipulation does not outweigh the substantial investment in the district court proceeding or *Fintiv* factors 1, 2, and 5." *Id.* at 4. Here, in stark contrast, the parties and the Court have made minimal investment in the litigation, the FWD will issue before trial, and Petitioner's *Sotera* stipulation mitigates any concern of duplication between the proceedings. *Supra*, §§II.A-C. Thus, factor 4 weighs against discretionary denial.

E. Factor 5: Petitioner and Defendant Being the Same Weighs Slightly Against Discretionary Denial or, at Worst, Neutralizes this Factor

Petitioner is the defendant in the parallel district court litigation. Because Petitioner is the same party in both proceedings, and the PTAB will reach a decision on the merits of the unpatentability of the '148 Patent before the district court, this factor weighs slightly against discretionary denial. *See NVIDIA Corp. v. Invensas Corp.*, IPR2020-00603, Paper 11, at 23 (PTAB Sept. 3, 2020) ("Because NVIDIA is the same party in both district court case and this proceeding, and we are likely to

reach the merits at or around the same time as the district court, this factor weighs slightly against discretionary denial."). At worst, this factor is neutral. *See HP Inc. v. Slingshot Printing LLC*, IPR2020-01084, Paper 13 at 9 (PTAB Jan. 14, 2021) (finding factor 5 "neutral" where the parallel proceeding has the same parties).

F. Factor 6: Patent Owner's Remaining Considerations Do Not Favor Discretionary Denial

This factor weighs against discretionary denial. As detailed below, Patent Owner's arguments to the contrary based on alleged settled expectations, cumulative prior art, and improper expert testimony are meritless and flawed. Request at 13-16.

1. Patent Owner Has Not Developed Settled Expectations

Process Memorandum Factor 5 considers the "[s]ettled expectations of the parties, such as the length of time the claims have been in force." Process Memorandum at 2. Patent Owner fails to support its claim of settled expectations in the '148 Patent, which has been in force for a mere four years, with sufficient evidence or arguments.

a. The '148 Patent has been in force for only four years

The Director has held that settled expectations do not arise until a patent has been "in force" for six years, aligning this timeframe "with other approaches to settled expectations and incentives, for example, for filing infringement lawsuits." *Dabico Airport Sols. Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 2-3 (Director June 18, 2025) (citing 35 U.S.C. § 286 ("Except as otherwise provided by

law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.")). Notably, in that case (which Patent Owner cited), the Director was assessing the settled expectations of a patent that had been "in force almost eight years." *Id.* at 2.

Here, the '148 Patent has not been in force long enough for Patent Owner to have settled expectations in it. It has presently been in force for a mere four years (less than four years at the time the IPR petition filed), which is half as long as the patent in *Dabico*. EX1001, (45) (issued July 27, 2021); Paper 1 at 72 (filed June 11, 2025). The short in-force period weighs against Patent Owner's settled expectations. Indeed, the Director has frequently found patentees do not have settled expectations in patents with similar, and longer, lifespans. *See, e.g.*, *Apex Beam*, Paper 10 at 2 (no settled expectations as to patent that had been in force for four years); *Microsoft Corp. v. Edge Networking Sys., LLC*, IPR2025-00617, Paper 12 at 2 (Director July 31, 2025) (no settled expectations as to patents that had been in force for four and five years); *TankLogix*, Paper 10 at 2-3 (no settled expectations as to patents that had been in force for four and five years); *Google LLC v. Withrow Networks, Inc.*, IPR2025-00775, Paper 10 at 2 (Director Aug. 14, 2025) (no settled expectations as to patent that had been in force for nearly five years).

Patent Owner also cites *Samsung Electronics Co. v. GhengisComm Holdings, LLC*, IPR2025-00788, Paper 11 (Director Aug. 25, 2025), for the proposition that

"settled expectations may arise during a period as short as three years." Request at 12. That case is inapposite. It never mentions settled expectations, and there was no indication that they could arise after just three years. Rather, as provided in the analysis incorporated into that decision from related cases (IPR2025-00780 and IPR2025-00781), the petition was denied based on a "holistic assessment of all of the evidence and arguments" and a number of other factors. *GhengisComm*, Paper 11 at 2. In particular, the FWDs in those cases would have issued six months after trial, there was "insufficient evidence" that the district court was likely to stay the case if the PTAB instituted the IPRs, and two of the patents at issue had been in force for "eight and six years." *Samsung Elecs. Co. v. GhengisComm Holdings, LLC*, IPR2025-00780, Paper 11 at 2 (Director Aug. 14, 2025). Here, the FWD will issue before the district court trial, Judge Andrews is highly likely to stay the case upon institution, and the '148 Patent is only four years old. *Supra*, §§II.A-B. All of those factors, and the lack of settled expectations, weigh against discretionary denial.

b. Patent Owner fails to show commercialization of the '148 Patent

According to Patent Owner, it made a "six-year period of investment into the commercialization of the claimed inventions," and settled expectations start before the '148 Patent even issued because it and Pratt were purportedly trying to commercialize the alleged inventions before the patent issued. Request 11-12. For

at least the following three reasons, Patent Owner's commercialization argument is flawed, unsupported, and cannot overcome the short period in which the '148 Patent has been in force.

First, Patent Owner's argument is based on improper hearsay. For example, Patent Owner claims that it and Pratt executed an "Exclusive Supply Agreement on December 8, 2020" that allegedly "reflect[ed] a mutual intent to commercialize the technology." *Id.* at 2, 12. However, Patent Owner did not attach that agreement to its Request. Nor did it attach the exclusive license to the '148 Patent that it also claims to have executed with Pratt.[1] And the Declaration (EX2002) that Patent Owner attached to its Request says nothing about the scope, the terms, or any requirements of those agreements. Patent Owner's failure to attach those agreements is prejudicial to Petitioner because Petitioner cannot address agreements to which it has no access. Indeed, without those agreements, neither the Director nor Petitioner have any idea what they say or if they have anything to do with the commercialization of the alleged inventions.

Second, Petitioner had no reason to be aware of or anticipate assertion of the '148 Patent against it, weighing against Patent Owner's settled expectations and for Petitioner's settled expectations. Patent Owner does not allege that Petitioner

[1] Nor were the Exclusive Supply Agreement or exclusive license produced by Pratt to Petitioner in the district court litigation.

had pre-suit knowledge of the patent. Nor could it. Petitioner did not become aware of the '148 Patent until after Pratt filed its complaint. EX1030, 2-3. Because the '148 Patent includes apparatus claims, any product that practices those claims should have been marked in accordance with 35 U.S.C § 287(a). But Patent Owner did not allege it marks its products with the '148 Patent number, and Pratt admits "it has not marked any Pratt products that fall within the scope of one or more of the Asserted Claims of the Asserted Patent (U.S. Patent No. 11,072,148)." EX1031, 2.

Third, Patent Owner's cited authority does not support its argument that it has settled expectations. As a threshold matter, Patent Owner admits that settled expectations are based on "the length of time the claims have been in force." Request at 11 n.2 (citing Process Memorandum at 2). Patent Owner cites *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (Director June 6, 2025) for the proposition that a petitioner's awareness of a challenged patent before filing a petition is relevant when assessing the "settled expectations" factor. Request at 11-12. Here, neither Patent Owner nor Pratt gave Petitioner actual or constructive notice of the '148 Patent before Pratt filed its lawsuit, and Petitioner never cited the patent in an IDS, so *iRhythm*'s reasoning does not apply. Patent Owner's reliance on *Dabico* and *Samsung* are equally inapposite as discussed above. *Supra*, §II.F.1.a.

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For the above reasons, Patent Owner does not have settled expectations in

the ’148 Patent.

2. The IPR Petition Asserts References the Examiner Did Not Consider

Patent Owner’s argument that the “Petition brings nothing new” is meritless. Request at 13. All of Petitioner’s grounds present strong, new references that the Examiner never considered and that expressly teach elements the applicant argued were not present in the examined prior art. Paper 1 at §§III, VII, XV; EX1001, (56) (listing no reference asserted in Grounds 1-5). For example, the petition asserts a single prior art reference, Gundlach (EX1005), that discloses the exact same packaging stack as the stack claimed in the ’148 Patent, as well as “maintaining the emissivity at the claimed value” and “the packaging having an emissivity that is equal to or smaller than a first value of 0.10,” which were identified by the Examiner as limitations purportedly missing from the prior art of record. EX1002, 173.

Patent Owner’s arguments against Yializis, Rebouillat, and the Voluntary Standard Reference equally have no merit. Patent Owner has not identified a single reference or argument considered during prosecution that is cumulative of those references. Not only is that prior art new, but it is also compelling. For example, Yializis was authored by an alleged inventor of the ’148 Patent. EX1001, (72); EX1006, 755. By Patent Owner’s own admission, Yializis is clearly relevant. Request at 13 (Patent Owner admitting Yializis discloses “thin metallized films

already contemplated in the '148 specification"). Yet, Yializis was never disclosed to the Examiner during prosecution. EX1001, (56); *see generally* EX1002 (no IDS ever filed by applicant). Thus, the inclusion of all new art and the compelling merits of the IPR petition weigh against denial. *See Regeneron Pharm., Inc. v. Novartis Pharma AG*, IPR2021-00816, Paper 13 at 26 (PTAB Oct. 26, 2021) (no denial where "the Petition presents new art" and "there was no single reference before the Examiner" that included multiple key elements).

3. No Other Factors Support Discretionary Denial

Patent Owner argues that "Petitioner's case hinges almost entirely on a 117-page declaration from its expert, Glenn May." Request at 14-15. Not so. Consistent with precedent and guidance from the Director and PTAB, Mr. May's testimony weighs against discretionary denial, because it helpfully provides an overview of the technologies relevant to the '148 Patent and background knowledge of a POSITA, as well as detailed summaries of the prior art and how they would be combined to render obvious each limitation of the challenged claims. Further, his testimony is supported by the cited art and evidence that a POSITA would have considered in evaluating the patent's invalidity. *See GD Energy Prods. LLC v. Kerr Mach. Co*., PGR2025-00031, Paper 11 at 2 (Director June 25, 2025) (finding persuasive that testimony merely complied with regulations for disclosure of "underlying facts or data" weighed against discretionary denial); *iRhythm*, Paper 10 at 2-3 (finding

reliance on testimony to "explain the background knowledge of a person of ordinary skill in the art" and expert's "citations to evidence" in the required manner weighed against discretionary denial); *see also* 37 C.F.R. § 42.65(a) (requiring underlying facts or data for expert testimony).

Patent Owner's argument that Petitioner has not justified the use of PTAB resources to invalidate the '148 Patent is also meritless. Request at 16. Prior to filing the present opposition, Petitioner was barred from making such arguments. EX2011, 2. Consistent with the Processes Memorandum, Petitioner does so now. The PTAB should use its resources to invalidate the '148 Patent for the reasons stated above, including because the IPR petition presents a compelling case on the merits based on new, strong prior art references, including a prior art reference that Patent Owner admits is relevant and yet never disclosed to the Examiner during prosecution. *Supra*, §II.F.2. Moreover, as explained above, this is the only proceeding where eight of the fifteen claims of the '148 Patent can be evaluated, making the PTAB the exclusive forum for reviewing over half of the claims.

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For the above reasons, *Fintiv* factor 6 weighs against discretionary denial.

III. CONCLUSION

For the foregoing reasons, Patent Owner's request for discretionary denial should be denied.

Dated: October 2, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), the undersigned certifies that a copy of the foregoing PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL is being served on counsel of record by filing the document through the Patent Trial and Appeal Case Tracking System (P-TACTS), with a copy served via electronic mail to the following email address, as authorized in Patent Owner's Mandatory Notices:

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