

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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GOOGLE LLC,  
Petitioner,

v.

VALTRUS INNOVATIONS LIMITED,  
Patent Owner.

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Case IPR2025-01157  
Patent No. 7,939,967

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**PATENT OWNER'S  
DISCRETIONARY DENIAL BRIEF**

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Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
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**EXHIBIT LIST**

| <b>Exhibits</b> | <b>Description</b>                                                                                                                                                                               |
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| EX2002          | Docket Control Order, Dkt. 21, <i>Valtrus Innovations LTD., et al v. Equinix, Inc.</i> , Case No. 25-cv-00016-JRG (E.D. Tex)                                                                     |
| EX2003          | Docket Control Order, Dkt. 22, <i>Valtrus Innovations LTD., et al v. TierPoint, LLC</i> , Case No. 25-cv-00323-JRG (E.D. Tex)                                                                    |
| EX2004          | Scheduling Order, Dkt. 34, <i>Valtrus Innovations, LTD., and Key Patent Innovations Limited v. Google LLC</i> , Case No. 24-03249-S (N.D. Tex)                                                   |
| EX2005          | LegalMetric District Report, Texas Northern District Court in Patent Cases, January 2020-January 2025                                                                                            |
| EX2006          | United States District Courts — National Judicial Caseload Profile                                                                                                                               |
| EX2007          | Defendant’s Invalidity and Ineligibility Contentions and Disclosures Pursuant to Patent Rule 3-3, <i>Valtrus Innovations LTD., et al v. TierPoint, LLC</i> , Case No. 25-cv-00323-JRG (E.D. Tex) |
| EX2008          | Defendant’s Invalidity and Ineligibility Contentions and Disclosures Pursuant to Patent Rule 3-3, <i>Valtrus Innovations LTD., et al v. Equinix, Inc.</i> , Case No. 25-cv-00016-JRG (E.D. Tex)  |
| EX2009          | Redacted Email Correspondence between Counsel regarding Valtrus/Equinix – Follow up on Meet and Confer, August 22, 2025                                                                          |
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## I. INTRODUCTION<sup>1</sup>

The Board should exercise its discretion to deny the Petition. The challenged U.S. Patent No. 7,939,967 (“the ’967 patent”) has been *in force for over 14 years*, since May 10, 2011. *See* EX1001, field 45. The Patent Owner therefore has strong settled expectations of validity and no challenge. Such settled expectations are further strengthened by the fact that *over fifty entities have become licensees and/or received rights to Valtrus’ patent portfolio* since 2023, including as a result of settlement of litigation involving the ’967 patent. EX2001.

Discretionary denial is also appropriate “[b]ecause there are multiple ongoing district court proceedings, and discretionary denial of the Petition[] reduces the chances of duplicative workloads and inconsistent outcomes.” *Comcast Cable Communications, LLC v. Entropic Communications, LLC*, Case No. IPR2025-00183, Paper 11 at 3 (P.T.A.B. June 25, 2025). Here, the ’967 patent is involved in *three* active parallel district court proceedings, including two in the Eastern District of Texas, including *Valtrus Innovations Ltd. et al. v. Equinix, Inc.*, Case No. 2:25-cv-00016 (E.D. Tex. Jan. 7, 2025) (“the Equinix Case”) and *Valtrus Innovations Ltd. et al. v. TierPoint, LLC*, Case No. 2:25-cv- 00323 (E.D. Tex. April 1, 2025) (“the TierPoint Case”). *See* Paper 5 at 1. The Equinix Case is scheduled for trial on

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<sup>1</sup> All emphases are added unless otherwise noted.

September 14, 2026, about 3.5 months earlier than the expected final written decision (“FWD”) in this proceeding. *See* EX2002 at 1. The TierPoint Case is scheduled for trial on November 2, 2026, two months earlier than the expected FWD in this proceeding. *See* EX2003 at 1. The same references and grounds of challenge will also appear in the district court actions *See infra*, Section III.4. Moreover, by the time of the expected institution decision (January 2, 2026), the parties in the Equinix Case will have filed a joint claim construction statement; and Patent Owner and Petitioner will have completed claim construction briefing in their parallel district court action (“the Google Case”). *See* EX2002 at 4; EX2004 at 3. Thus, substantial resources will have been invested in the parallel district court actions.

Discretionary denial is further appropriate because the Petition relies heavily on Dr. Baker’s testimony to justify the Petition’s modification of the references (including for alleged anticipation), and what Petitioner alleges would be understood by or obvious to a POSITA. Petitioner’s extensive reliance on expert testimony to bridge the gap in the references suggest that validity of the ’967 patent is better resolved in an Article III court. *See* Memorandum on Interim Process for PTAB Workload Management at 2 (“[t]he extent of the petition’s reliance on expert testimony” is a factor to consider in discretionary denial); archived FAQ #22. These and the merits of the Petition will be further addressed in the POPR.

## II. THE SETTLED EXPECTATIONS OF THE PARTIES FAVORS DISCRETIONARY DENIAL

The '967 patent was issued more than *fourteen years* ago, on May 10, 2011, creating strong settled expectations of patent rights. *E.g., Amazon.com v. Audio Pod IP, LLC*, IPR2025-00757, Paper 15 (P.T.A.B., Aug. 14, 2025) (denying institution even though no trial date has been set, because the challenged patents have been in force for between seven to eleven years and there are strong settled expectations); *Google LLC v. VirtaMove, Corp.*, IPR2025-00487, Paper 11 at 2 (P.T.A.B., July 11, 2025) (denying institution even though no trial date has been set because of the strong settled expectations created by a 14-year old patent); *Apotex Inc., v. Alkermes Pharma Ireland Limited*, IPR2025-00514, Paper 10 at 2 (P.T.A.B. July 2, 2025) (denying institution where the “the challenged patent has been in force for more than 14 years, creating *strong settled expectations*”); *Samsung Electronics Co. Ltd. et al. v. Sinotechnix LLC*, IPR2025-00331, Paper 13 at 2 (P.T.A.B, July 2, 2025) (patents in force for ten years created “*strong settled expectations*”).

In addition to the 14 years of being in force, the settled expectations are further bolstered by additional facts. First, the '967 patent was assigned by the inventors to Hewlett-Packard (“HP”) in 2009. The inventors were employees of HP, a Fortune 500 company, and HP continued to own the patent for over a decade without any record of being challenged at the USPTO or in a district court action. Second, since

Valtrus obtained a portfolio of patents that includes the '967 patent, it has successfully licensed the '967 patent to over fifty companies without litigation. *See* EX2001, ¶¶ 2-3 (Decl. of Angela Quinlan). Third, the '967 patent was asserted against several additional companies, including CyrusOne, LLC; Digital Realty Trust, Inc.; and Dawn Acquisitions LLC d/b/a Evoque Data Center Solutions. *See id.*, ¶ 4; Paper 5 at 1-2. These cases settled, also resulting in rights being granted to the '967 patent. *See* EX2001, ¶ 4. Finally, there have been no applicable changes in the law since the '967 patent issued that would impact the settled expectations.

Recent decisions also make clear that settled expectations alone can justify discretionary denial. For example, in *SmartSky Networks LLC v. Gogo Business Aviation LLC*, IPR2025-00672, Paper 10 (P.T.A.B., July 31, 2025) (“*SmartSky*”), the Acting Director exercised her discretion and denied the petition because “the challenged patent has been in force for *seven years*, creating strong settled expectations, and Petitioner does not provide any persuasive reasoning why an *inter partes* review is an appropriate use of Board resources under these circumstances.” *Id.* at 2. Discretionary denial was granted there even though “a final written decision is likely to issue before the district court trial occurs.” *Id.* Likewise, in *Tanklogic, LLC v. SitePro, Inc.*, IPR2025-00647, 648, 649, 650, 651, 652, 653, Paper 10 (P.T.A.B., July 31, 2025) (“*Tanklogic*”), the Acting Director exercised discretion to deny petition against three patents that had been in force for seven, eleven, and nine

years, even though “it is likely that a final written decision in [those] proceeding[s] will issue before the district court trial occurs.” *Id.* at 2-3. Similarly, in *HS Hyosung Advanced Materials Corp. v. Kolon Industries, Inc.*, IPR2025-00662, Paper 12 (P.T.A.B., Aug. 14, 2025) (“*Kolon*”), citing “strong settled expectation,” the Acting Director exercised her discretion and denied challenges to patents that had been in force for seven, six and nine years, respectively, even though the parallel district court litigation had been stayed. *Id.* at 2.

Thus, strong settled expectations attach to the ’967 patent that has been in force for more than ***fourteen years*** with many licensees; and the Acting Director should exercise her discretion to deny the petition. *See Intel Corp. v. Proxense LLC*, IPR2025-00327/00328/00329, Paper 12 at 2-3 (P.T.A.B., June 26, 2025) (discretionary denial exercised for a patent that had been in force for nine years).

### **III. THE *FINTIV* FACTORS SUPPORT DISCRETIONARY DENIAL.**

In addition to the strong settled expectations discussed above, the *Fintiv* factors as outlined in *Apple v. Fintiv*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”) also support discretionary denial of institution.

#### **1. Factor 1: Whether the Court Granted a Stay or Evidence Exists That One May Be Granted if a Proceeding Is Instituted.**

No stay has been granted in any of the three cases involving the ’967 patent, and there is no reason to believe that one may be granted for the reasons below.

**(a) The Equinix Case and TierPoint Case**

Both the Equinix Case and the TierPoint Case are before Judge Gilstrap in the Eastern District of Texas. There, the district court’s established practice is to deny motions to stay filed before institution of *inter partes* review. *See Polaris Power Techs. v. Samsung Elecs. Co.*, No. 2:22-CV-469-JRG, 2023 U.S. Dist. LEXIS 246491, at \*4-5 (E.D. Tex. Aug. 18, 2023) (“[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.”).

A stay is also unlikely post-institution. Judge Gilstrap routinely denies contested motions to stay district court litigation pending IPRs when the district court trial is scheduled before the Board’s final decision. *See, e.g., MyPort, Inc. v. Samsung Elecs. Co., Ltd.*, Case No. 2:22-cv-00114-JRG, Order, Dkt. 73 (E.D. Tex. June 13, 2023) (denying a motion to stay when trial was scheduled and “the PTAB [final written] decision is not due until over two months after jury trial is set to begin”); *General Access Solutions, Ltd. v. Cellco Partnership*, Case No. 2:22-cv-00394-JRG, Order, Dkt. No. 225 (E.D. Tex. May 22, 2024) (Ex. 2025 at 3) (denying a motion to stay when the final written decision was expected after the trial).

**(b) Google Case**

Google filed a motion to stay the Google Case on July 18, 2025. The Court has not ruled on the motion and legal metrics indicates that the grant rate for stay

motions pending IPR in the Northern District of Texas is exactly 50% over the last five years. EX2005 at 64 (of the 16 motion to stay pending IPR, 8 were granted, 4 were denied without prejudice and 4 were denied). There are no individual statistics for Judge Scholer assigned the Google Case. Thus, one cannot make any inference on whether a contested motion to stay will be granted.

But even if the statistics indicated any leaning towards granting or denying a contested motion to stay, because a “judge determines whether to grant a stay based on the facts of each specific case as presented in the briefs by the parties,” the Acting Director should “decline to infer, based on actions taken in different cases with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here.” *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at (P.T.A.B. May 13, 2020). At any rate, the fact that a parallel litigation may be stayed or is actually stayed does not overcome the strong settled expectations created by the age of the ’967 patent (14 years). *Kolon* (denying institution even though the parallel litigation has been stayed due to “strong settled expectation” created by patents that had been in force between six and nine years).

Therefore, this factor weighs in favor of denying institution or is neutral.

**2. Factor 2: Proximity of the Court’s Trial Date to the Board’s Projected Statutory Deadline for a Final Written Decision.**

The three parallel district court actions are scheduled for trial either before or

at most slightly after the expected FWD. The multiple trials that are close in time to FWD will result in “duplicative workloads” and potential “inconsistent outcomes” if the IPR is instituted. *See Comcast Cable Communications, LLC v. Entropic Communications, LLC*, Case No. IPR2025-00183, Paper 11 at 3 (P.T.A.B. June 25, 2025) (“*Comcast*”). This factor thus weighs in favor of discretionary denial.

Specifically, the Equinix Case and the TierPoint Case are scheduled for trial on September 14, 2026 and November 2, 2026, respectively. EX2002; EX2003. The scheduled trial date (just over 20 months from filing) is consistent with the Court’s historical median time-to-trial of 21.9 months. *See* EX2006 at 35. Thus, if this IPR is instituted, the Equinix Case and the TierPoint Case will have already gone to trial roughly **3.5 months** and **2 months**, respectively, before the Board’s expected statutory deadline to issue a FWD in this case in early January 2027. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under NHK.” *Fintiv* at 9; *see also LinkPlay Technology Inc. v. Sonos, Inc.*, IPR2025-00509, 510, 511, Paper 11 (P.T.A.B., July 31, 2025) (Acting Director exercised discretionary denial in part because the scheduled trial date is about two months before the projected final written decision).

This factor is in favor of discretionary denial even though Equinix and TierPoint are not the Petitioner. For example, in *TCO AS v. NCS Multistage Inc.*,

PGR2020-00078, Paper 16 (PTAB Feb. 18, 2021), the patent-at-issue was the subject of both the “TCO litigation,” which involved the same parties as the PGR proceedings and was set for trial after the final written decision would be due, and the “Nine litigation,” which involved a different defendant and was set to go to trial before the final written decision. *Id.* at 2–3, 11. The Board relied on the third-party Nine litigation to conclude that Factor 2 weighed in favor of denial. *See id.* at 11-12.

Likewise, in *Fitbit, Inc. v. Philips North America LLC*, Case No. IPR2020-00828, Paper 13 (P.T.A.B., Nov. 3, 2020) (“*Fitbit*”), the patent was involved in two parallel litigations, one against the petitioner (“the Fitbit case”), and one against an unrelated third party (“the Garmin case.”). *See id.* at 2. Under Factor 2, the Board expressly stated that it would “consider the facts surrounding the [third party] *Garmin* case, including the trial date, as relevant to our determination of whether to invoke our discretion to deny institution.” *Id.* at 10. To that end, the Board found that “[t]he fact that trial in the *Garmin* case will likely take place several months prior to the final design weight in favor of invoking our discretion to deny institution.” *Id.* at 10-11; *see also Google LLC v. Cerence Operating Company*, IPR2024-01465, Paper 15 at 7-9, 14-15 (PTAB April 23, 2025) (where Google and Samsung were both petitioners, but Google was not a defendant in a parallel litigation set for trial before a final written decision in the IPR, the Board found that the early trial date weighed in favor of discretionary denial under Factor 2, and that

no consideration was given to the fact that Google was not a defendant in the parallel litigation); *see also id.* at 14-15 (addressing the fact that Google was not a defendant in the parallel litigation only under Factor 5); *Arm Ltd. et al. v. Daedalus Prime LLC*, IPR2025-00207, Paper 14 (P.T.A.B. Aug. 6, 2025) (the Acting Director originally exercised discretion to deny institution even though the Petitioner, Arm, was not a party to the parallel litigation whose schedule was relied on for the original denial).

Furthermore, with respect to the Google Case schedule, recent decisions show that, for patents like the '967 patent with strong settled expectations, a trial date slightly after the FWD does not outweigh Patent Owner's settled expectations of patent rights. *See SmartSky* (discretionary denial exercised for a patent that had been in force for over 7 years, even though "a final written decision is likely to issue before the district court trial occurs."); *Tanklogic* (same).

Here, the Google Case is currently scheduled for trial in February 2027 (EX2004 at 1), just after the expected statutory deadline for issuing a FWD in this IPR, if instituted. That the trial date for the Google Case is slightly after the expected FWD date provides additional reasons in favor of discretionary denial because, given the closeness in time between the expected trial date and the projected FWD, nearly all substantive work will have completed in the district court when the Board issues its FWD and the duplicative proceedings also increase the likelihood of inconsistent outcome. *See Comcast* at 3. This factor thus weighs in favor of discretionary denial.

Thus, the multiplicity of the proceedings and the closeness in time between the trials and the expected FWD weigh in favor of discretionary denial.

**3. Factor 3: Investment in the Parallel Proceeding by the Court and the Parties.**

There will have been substantial investment in at least *two* parallel district court proceedings by the time an institution decision is expected on January 2, 2026.<sup>2</sup> For example, in all three cases, the parties have already prepared and exchanged infringement contentions, invalidity contentions, and initial and additional disclosures, and started discovery. EX2002, EX2003, EX2004. Moreover, in the Google Case, the parties will have completed claim construction briefing well before the institution date. EX2004, 3. In the Equinix Case, (1) the parties will have exchanged claim terms and submitted a Joint Claim Construction Statement by the expected institution decision date (EX2002, 4), and (2) because the deadline for claim construction discovery is less than two weeks after the expected institution decision date and the opening claim construction brief is due less than two weeks thereafter, substantial investment will have been made by Valtrus by the time of the institution decision. *See id.*, 3-4. Thus, Factor 3 weigh in favor of denial.

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<sup>2</sup> January 2, 2026 is six month from the date of the Notice of Filing Date Accorded.

**4. Factor 4: Overlap Between Issues Raised in the Petition and in the Parallel Proceeding.**

**(a) Potentially Complete Overlap with the Asserted Grounds in all Three Parallel Cases**

The Petition presents the exact same issues as those raised in the parallel litigations. *First*, Google asserts in the Google Case each of the prior art references and the obviousness grounds relied on in the Petition. *See* EX2010 (Google’s Invalidity Contentions), 35-36 (listing invalidity claim charts for Chang, Edelen, Jung, Susong and Zak), 36 (stating that charts apply to anticipation and obviousness), 23 (listing combination of “Chang + Edelen,” corresponding to Ground 5), 34 (listing combination of “Susong + Zak,” corresponding to Ground 3).

*Second*, Equinix’s invalidity contentions “incorporate[] by reference all other bases for invalidity that may be identified in other filings, including in any interrogatory responses or in submissions before the United States Patent and Trademark Office (e.g., during *Inter Partes* Review proceedings) concerning the Asserted Patents and all related patents and/or parent applications ....” EX2008 at 9; *see also id.* at 21-22 (reserving right to rely on any papers or evidence submitted in connection with “*inter partes* review proceedings involving the Asserted Patents or related patents.”). In fact, Equinix has stated that it “is going to move to amend its invalidity contentions for the ’967 patent to ***include the prior art cited by Google, Digital Realty and CyrusOne.***” EX2009, 3. Thus, Equinix is clearly purporting to

sweep in all of the same prior art and “bases for invalidity” that is in the Petition.<sup>3</sup>

*Third*, TierPoint's invalidity contentions in the TierPoint Case incorporate the Petition and Dr. Baker's declaration, and list out each of the specific grounds raised in the Petition. EX2007 at 34-35.

Moreover, Google's *Sotera* stipulation will not eliminate overlap. In particular, Google's invalidity contentions expressly include obviousness grounds that combine each of the asserted references with system art. *See* EX2010 at 9-10 (identifying seven system art: “Allen-Bradley,” “Cisco,” “Dell,” “Emerson,” “GE Fanuc”, “HP”, and “Lenior”), 20-34 (proposing various combinations of the seven system art references with each of “Zak,” “Jung,” “Susong” and “Chang” asserted in this proceeding). But Google's *Sotera* stipulation does not disclaim any of these purported system-art grounds if trial is instituted, nor prevent Google from pursuing in the district court combinations that include the IPR references using essentially the same arguments as presented in the Petition, but with some system art sprinkled in. Thus, just like in *Motorola Solutions, Inc. v. Stellar, LLC*, Case No. IPR2024-01205, Paper 19 (P.T.A.B. March 28, 2025), ***Petitioner's Sotera stipulation does***

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<sup>3</sup> Nothing herein should be interpreted as Valtrus agreeing that there is good cause for Equinix to amend its invalidity contentions under Patent Local Rule 3-6 or that it should be allowed to assert art identified by Google at trial.

*not ensure IPR would be a “true alternative”* because Petitioner’s invalidity arguments “include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot,” and thus the same or similar issues would remain in the parallel Google Case. *Id.* at 3-4; *see also Cisco Systems, Inc. v. WSOU Investments LLC*, IPR2025-00188, Paper 14, 3 (P.T.A.B. Aug. 22, 2025) (Director Review finding “Petitioner’s invalidity arguments in the district court include combinations of the prior art asserted in this proceeding with unpublished system prior art,” and therefore “Petitioner’s stipulation here does not ensure that this proceeding would be a true alternative to the district court proceeding and is entitled to less weight.”).

*Fourth*, Google’s stipulation does not impact the invalidity issues in the Equinix Case or TierPoint Case which, as noted above, purport to incorporate all of the IPR prior art and arguments. *See Formycon AG v. Regeneron Pharmaceuticals, Inc.*, IPR2025-00233, Paper 15 at 19-20 (P.T.A.B. June 2, 2025) (finding *Sotera* stipulation did not effectively mitigate concerns raised by overlap because “other defendants remain free to litigate the same grounds” in a parallel proceeding).

Thus, given the common and overlapping grounds of challenges in the IPR and district court cases, the overlap in issues between this proceeding and the parallel litigations is substantial, if not complete. Under these circumstances, Factor 4 weighs heavily in favor of denial. *See Code200, UAB v. Luminati Networks Ltd.*, IPR2020-

01506, Paper 10, at 11–12 (PTAB Feb. 16, 2021) (“In light of the common prior art asserted here and in the [] district court case, as well as the common challenge to the sole independent claim and all but two of the dependent claims of the patent, we agree with the Patent Owner that the overlap in issues between the two proceedings is substantial.”); *see also Teso LT UAB v. Luminati Networks Ltd.*, IPR2021-00122, Paper 12, at 10 (PTAB Apr. 20, 2021) (denial of institution favored where Petition’s prior art references were all identified in the district court invalidity contentions, the same independent claims were challenged in both proceedings, and “the additional claims challenged in the Petition are all dependent claims”); *eClinicalWorks*, IPR2022-00229, Paper 10 at, 12 (finding Factor 4 weighed in favor of denial where Preliminary Invalidity Contentions showed overlap of asserted claims, art and arguments asserted in the Petition); *U.S. Venture, Inc. v. Sunoco Partners Mktg. & Terminals L.P.*, IPR2020-00728, Paper 10, at 11–14 (PTAB Oct. 1, 2020) (finding overlap between primary references asserted in Petition and litigation weighed in favor of denial).

**(b) Substantially the Same Claims at Issue**

While more claims are challenged in the Petition than are asserted in the parallel district court proceedings, “that difference does not materially affect the overlap” because the additional “claims challenged in the Petition collectively raise the same disputed and overlapping issues identified above.” *Formycon AG v.*

*Regeneron Pharmaceuticals, Inc.*, IPR2025-00233, Paper 15 at 20 (PTAB June 2, 2025) (“*Formycon*”). Here, the Google Case involves claims 1-8 (EX2010 at 1), the Equinix Case involves claims 1-11 (EX2008 at 2), and the TierPoint Case involves claims 1 and 3-11 (EX2007 at 2), while the Petition challenges claims 1-15. However, the Petition relies on substantially the same prior art and arguments for the unasserted claims as it does for the asserted claims, as summarized in the table below. (Claims in red are not asserted in either the Equinix or Google Case and “\*” indicates an independent claim).

| Ground | Claims                              | Analysis of Later Sets of Claims                                                                                                                                                                                          |
|--------|-------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1      | 1(*), 2-3, 8, 14 (*), 15            | Pet. 19-20 (referring to discussions under elements of claim 1 for Elements [14a]-[14d] and to claim 2 for Element [14e]); Pet. 21 (relying on the same output 66 as in claim 14, and same Zak passage as cited for 1[d]) |
| 2      | 1-7; 9 (*), 10-11, 12-13, 14(*), 15 | Pet. 38-44 (analysis for claims 9-15 generally referencing back to earlier discussion of Susong for claims 1-8)                                                                                                           |
| 3      | 2, 8, 11, 14(*), 15                 | Pet. 48-49 (discussion of claim 11 referring back to claims 2-8); 49 (referencing Ground 2 and claim 2)                                                                                                                   |
| 4      | 1(*), 4-7, 9(*)-10, 13              | Pet. 62-65 (analysis of claims 9-10 and 13 relies principally, if not entirely, on analysis of earlier claims).                                                                                                           |
| 5      | 1-8, 9(*)-10, 11-13, 14(*)-15       | Pet. 66-67 (not differentiating analysis for claims 9-10 and 13 from those for claims 1 and 4-7), Pet. 75 (relying principally on analysis for claims 2 and 8 under Ground                                                |

|  |  |                                                                                                                                                                                                                                              |
|--|--|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
|  |  | 4 with general motivation-to-combine analysis that applies also to claims 1-8), Pet. 76-77 (claim 12 analysis tracks claim 3 and claim 14 analysis mirrors claim 1); Pet. 78 (claim 15 analysis referring back to claim 3 and element 14[c]) |
|--|--|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

Because under every ground in the Petition, the analysis is the same or substantially the same for the unasserted claims as it is for asserted claims, and therefore the fact that the Petition challenges more claims than are at issue in the parallel proceedings “does not materially affect the overlap.” *Formycon* at 20.

**5. Factor 5: Whether the Petitioner and the Defendant in the Parallel Proceeding Are the Same Party.**

The parties are the same in the Google Case. While the parties are not the same in the Equinix Case or the TierPoint Case, “the issues are the same as, or substantially similar to, those already or about to be litigated” in those cases, as detailed above under Factor 4, and the “circumstances weigh against redoing the work” of the Equinix or TierPoint court. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 14 (PTAB March 20, 2020); *see also Fitbit* at 15 (Factor 5 favored denial because “[e]ven when a petitioner is unrelated to a defendant, ... if the issues are the same as, or substantially similar to, those already or about to be litigated ... the Board may, nonetheless, exercise the authority to deny institution.”).

Likewise, in *Mylan Laboratories Ltd. V. Janssen Pharmaceutica NV*, Case No. IPR2020-00440, the Board exercised its discretion to deny trial where the parties

were the same in one case (the “Mylan litigation”) but the defendant was different in a second case (the “Teva litigation”). Paper 17 at 22. The Board found that “although the defendant in the Teva litigation is unrelated to the Petitioner, we have found that ‘the issues [in both the Mylan and Teva litigations] are the same as, or substantially similar to, those already or about to be litigated.’” *Id.* at 23 (citing *Fintiv* at 14 and the Board’s Factor 4 discussion). As a result, the Board concluded that “because the Petitioner is the same as the defendant in the Mylan litigation, and because the issues in both the Teva and Mylan litigations are substantially the same as those raised in the Petition, *Fintiv* factor #5 favors denial.” *Id.*

For the same reasons, Factor 5 favors denial here.

**6. Factor 6: Other Circumstances That Impact the Board’s Exercise of Discretion, Including the Merits.**

As noted in Section II, settled expectation strongly favors discretionary denial.

This Petition is also not a good use of the Board’s limited resources for additional reasons. Specifically, the petition asserts three primary references and five grounds against 15 claims, without explaining the need for multiple grounds on the same claims or the strengths or weaknesses for each ground. A trial will thus require the Board to devote its limited resources to study multiple references, address multiple grounds, resolve multiple disputes on potentially dispositive issues between the experts, and address the additional limitations for dependent claims, in order to

address the merits of every ground and every claim in its FWD. This extensive amount of work required of the Board, coupled with the strong settled expectations, weighs in favor of discretionary denial.

In addition, as will be discussed in the POPR, each of Petitioners' asserted grounds has notable weaknesses that rely extensively on expert testimony to fill critical gaps, which further supports discretionary denial. *See Dell Inc. v. Universal Connectivity Technologies Inc.*, IPR2024-01480, Paper 12 at 13-14 (PTAB Apr. 24, 2025) ("This factor supports the exercise of discretion if the merits of a case include weaknesses that call into question the strength of the petition."), 22 ("The discussion above identifies weaknesses in the Petition that we have considered in our evaluation of *Fintiv* factors.").

For example, Petitioner argues that Zak *anticipates* certain of the challenged claims, but then has to rely on its expert's testimony to justify reshuffling certain circuit components from the disclosed backup power supply 12 to the switch power supply 11 in order to meet the claim requirements for "the first power supply." *See* Pet. at 13 (conceding that "Zak refers to different collections of components as 'power supplies'" than what Petitioner mapped to).

As another example, Grounds 2 and 3 rely on Susong alone or in combination with Zak, but require expert testimony to justify what Susong allegedly disclosed and, if not disclosed, why the missing limitations would be allegedly obvious.

As to Ground 4, which is based on yet another primary reference, Chang, the Petition relies on expert testimony to argue that what Chang describes as a “power source” is actually the claimed “power supply,” instead of the claimed “source of electrical energy.” Pet. 53-57. Petitioner also relies on its expert to argue that “the second power supply” it identified is “configured to transition from a lesser output level to a greater output level in response to an activation signal,” even though the signal that caused the connection of the input side to the output side (which allegedly caused the increase in power output) is a signal sent, not to the alleged second power supply, but to another component—a so-called power source switching module 104. *See* Pet. 57-58; EX1008, [0043]-[0045], [0048]-[0049]. The addition of a secondary reference in Ground 5 does not address and does not remedy this deficiency.

Thus, each of the *Fintiv* factors favors denial.

#### **IV. CONCLUSION**

For the foregoing reasons, the Acting Director should exercise her discretion to deny institution of the Petition pursuant to Section 314(a).

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Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify, pursuant to 37 C.F.R. section 42.6, that on September 2, 2025, a complete copy of the **PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** and **EXHIBITS 2001 - 2010** were served upon the following, by ELECTRONIC MAIL:

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