UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIVEINTENT, INC.,
Petitioner

v.

ALMONDNET, INC.,
Patent Owner

Case IPR2025-01160
U.S. Patent No. 8,494,904

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

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LIVEINTENT1002	Excerpts from the Prosecution History of the ’904 Patent
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LIVEINTENT1004	U.S. Patent No. 5,918,014A (Robinson)
LIVEINTENT1005	U.S. Patent No. 6,415,322B1 (Jaye)
LIVEINTENT1006	U.S. Patent Publication No. 2002/0026351A1 (Coleman)
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LIVEINTENT1008	U.S. Patent & Trademark Office, Memorandum on Interim Processes for PTAB Workload Management (Mar. 26, 2025)
LIVEINTENT1009	August 25, 2025 Stipulation
LIVEINTENT1010	U.S. Patent No. 6,925,440 (’440 Patent)
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LIVEINTENT1014	U.S. Patent No. 7,979,307 (’307 Patent)
LIVEINTENT1015	Excerpts from the Prosecution History of the ’307 Patent
LIVEINTENT1016	U.S. Patent No. 8,244,582 (’582 Patent)
LIVEINTENT1017	Excerpts from the Prosecution History of the ’582 Patent
LIVEINTENT1018	U.S. Patent No. 8,244,583 (’583 Patent)
LIVEINTENT1019	Excerpts from the Prosecution History of the ’583 Patent
LIVEINTENT1020	U.S. Patent No. 8,239,264 (’264 Patent)

LIVEINTENT1021	Excerpts from the Prosecution History of the ’264 Patent
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LIVEINTENT1023	Excerpts from the Prosecution History of the ’249 Patent
LIVEINTENT1024	First Amended Complaint, *AlmondNet, Inc. v. LiveIntent, Inc.*, 1:24-cv-00831, D. Del., filed November 12, 2024
LIVEINTENT1025	U.S. Patent No. 8,677,398 (’398 Patent)
LIVEINTENT1026	U.S. Patent No. 8,959,146 (’146 Patent)
LIVEINTENT1027	U.S. Patent No. 10,984,445 (’445 Patent)
LIVEINTENT1028	Scheduling Order, *AlmondNet, Inc. v. LiveIntent, Inc.*, 1:24-cv-00831, D. Del., filed August 25, 2025

I. INTRODUCTION

The Patent Trial and Appeal Board (Board) is uniquely suited to assess the patentability of the challenged claims of the ’904 Patent. The ’904 Patent is part of a sprawling family of eight U.S. patents with claims of overlapping subject matter. The prosecution histories of these patents tell a simple story for those familiar with patent prosecution procedure, such as the Board. In examining the entire family, the Examiner never conducted a search for a feature known to be critical to the claimed invention of the ’904 Patent and several of its family members—profile attribute collection via URL redirection. And the Examiner altogether failed to evaluate applicant-cited references, which included the Robinson and Jaye references that form the grounds of the Petition, much less assess whether these references teach the URL redirection feature. If the Examiner had conducted such a search or even superficially considered the applicant-cited references, the Examiner would have determined URL redirection of a partial profile was well-known in the prior art and found the ’904 Patent claims unpatentable. This fact pattern amounts to a pervasive material error, stretching across several patent family members and reflecting a pattern of examination flaws that the Patent Office is best equipped to understand. Such a material error favors referral.

The Board’s review of the ’904 Patent would also represent the most effi-

cient allocation of judicial and administrative resources. In addition to the significant errors that occurred during examination of the ’904 Patent family, Patent Owner has asserted in a parallel district court litigation three other patents with divergent subject matter, creating a complicated technological backdrop ill-suited for a district court. The Board’s technical expertise and familiarity with patent law and examination make it the optimal forum to address and simplify this complexity.

Other considerations also favor referral. The ’904 Patent’s enforceable life has been repeatedly disrupted by intervening events—including a statutory disclaimer in 2017 and Board findings of unpatentability of similar claims of related family members in 2023 and 2024—thus negating the Patent Owner’s assertion of settled expectations merely on the basis that the ’904 Patent issued more than twelve years ago. Furthermore, the parallel district court litigation is in its infancy, and LiveIntent, Inc. (Petitioner) has filed a stipulation to prevent overlap of issues between this *Inter Partes* Review (IPR) and that litigation.

Under these circumstances, allocating Patent Office resources to review the ’904 Patent would allow the Patent Office to correct its own material errors and avoid unnecessary burden on the district court, which has been drawn into the dispute between Petitioner and Patent Owner because these material errors led to the improper issuance of the ’904 Patent. Referral to the Board is therefore appropriate.

II. THE '904 PATENT ISSUED ONLY AS A RESULT OF THE EXAMINER'S MATERIAL ERROR DURING PROSECUTION, THUS JUSTIFYING REFERRAL OF THE PETITION.

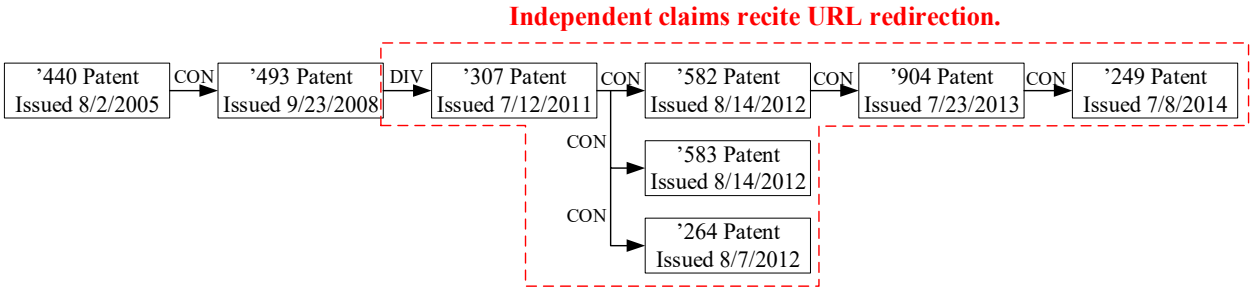
Material error during prosecution weighs heavily against discretionary denial and can overcome a Patent Owner's settled expectations in a challenged patent. *Anthony, Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 12, at 2 (PTAB July 16, 2025) (finding material error overcame settled expectations of 18-year-old and 17-year-old patents); *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12, at 2-3 (PTAB July 17, 2025) (9-year-old patent); *Eunsung Global Corp. v. Hydrafacial LLC*, IPR2025-00445, Paper 14, at 2 (PTAB July 10, 2025) (8-year-old patent).

Here, the Examiner failed to engage with applicant's submission of pertinent prior art references—including Robinson and Jaye—issuing no prior art rejections and offering no meaningful analysis of these references. This lapse was not an isolated oversight but part of a broader pattern of inadequate examination permeating the entire '904 Patent family that reflects a troubling departure from the level of scrutiny expected for patent examination. This material error warrants referral.

A. As a Preliminary Matter, the '904 Patent Is Part of an Eight-Member Patent Family in Which Six of the Patents Have Independent Claims Reciting URL Redirection.

As summarized in the diagram below, the '904 Patent is part of a family altogether including eight U.S. patents. The '904 Patent is (1) a continuation of the '582 Patent, which is (2) a continuation of the '307 Patent, which is (3) a division

of the ’493 Patent, which is (4) a continuation of the ’440 Patent—the first-filed U.S. parent patent in this family. LIVEINTENT1001 code (60), 1:10-19. The ’249 Patent is a continuation of the ’904 Patent. LIVEINTENT1022 code (60), 1:11-14. In addition to the ’904 Patent, the applicant filed for two other continuation patents during the’493 Patent’s pendency—the ’583 and ’264 Patents. Relevant to the Examiner’s material error in allowing the ’904 Patent, independent claims of the ’307 Patent and all subsequent family members (including the ’904 Patent) recite URL redirection. LIVEINTENT1014, 16:47-49; LIVEINTENT1016, 16:53-56; LIVEINTENT1018, 16:45-52; LIVEINTENT1020, 16:47-54; LIVEINTENT1001, 16:61-66; LIVEINTENT1022, 16:56-59.



B. The Examiner Found the ’904 Patent Claims Allowable Because They Recite URL Redirection, but He Did Not Consider the Relevant Teachings of Applicant-Cited References Robinson and Jaye.

1. The Examiner Did Not Consider Any Applicant-Cited References During Examination of the ’904 Patent.

The ’904 Patent file history is devoid of any evidence that the Examiner evaluated any references first cited by the applicant, including Robinson and Jaye.

The Examiner raised only a nonstatutory double patenting rejection with respect to the '582 and '307 Patents. LIVEINTENT1002, 71-72. The Examiner did not issue a single prior art rejection, cite a single prior art reference, or provide any analysis of the references cited in the applicant's Information Disclosure Statements (IDSs). *Id.*, 74, 77-79, 82, 173-175; *see id.*, 38-39, 71-72. But the applicant-cited references—including Robinson and Jaye (*id.*, 77)—render obvious several claims of the '904 Patent, including independent claims 1, 11, and 21 (Pet. 5-77). The Examiner's oversight of Robinson's and Jaye's teachings represents material error.

2. The Examiner Similarly Failed to Consider Robinson and Jaye in Examining Related Family Members Whose Examinations Served as the Basis for the Examiner's Allowance of the '904 Patent Claims.

The Examiner's reasons for allowance further underscore his failure to consider Robinson and Jaye. In the '904 Patent file history, the only possible indications of any substantive consideration of the cited references were: (1) the Examiner's terse reasons for allowance, stating "[a]ll previous rejections are withdrawn due to Applicant's amendments and arguments (***See prosecution of child*** [sic] ***applications***)," [1] and (2) his search notes indicating that he reviewed the search and

[1] All emphases in this opposition are added unless otherwise specified. Furthermore, LiveIntent understands the Examiner to have been referring to the prosecution of ***parent*** applications in his reasons for allowance.

examination of the ’582 and ’307 Patents—the reference patents for the nonstatutory double patenting rejection. LIVEINTENT1002, 39, 41, 64, 71-72, 80.

But, in examining these earlier patents, the Examiner similarly failed to consider Robinson and Jaye. During examination of the ’307 Patent, the Examiner signed an IDS citing Jaye. LIVEINTENT1015, 163. But his substantive remarks were entirely devoted to a rejection in view of the prior art reference *Their Time Has Come*, Direct, v11, n8, p1+, June 1999 (Acxiom) and did not otherwise include any analysis of Jaye. *Id.*, 106, 136-137, 152-154. Similarly, during examination of the ’582 Patent, the Examiner signed IDSs citing both Robinson and Jaye. LIVEINTENT1017, 150-152. But the file history otherwise includes no indicia that the Examiner substantively reviewed Robinson and Jaye, having raised no prior art rejections and having issued only double patenting rejections. *Id.*, 122-123, 140-142, 147-148. And the Examiner’s reasons for allowance was a glib statement that “[a]ll previous rejections are withdrawn due to Applicant’s amendments and arguments.” *Id.*, 122.

In fact, in the entirety of the file histories of these three patents, the only evidence that the Examiner considered ***any*** prior art of record was the Examiner’s Acxiom rejection during examination of the ’307 Patent. LIVEINTENT1015, 136-138, 152-54. This rejection, however, further establishes the Examiner’s failure to evaluate new references ***first cited by the applicant***. Although the applicant’s IDSs

for the ’904, ’307, and ’582 Patents included Acxiom, Acxiom was not new to the Examiner. LIVEINTENT1002, 175; LIVEINTENT1015, 383; LIVEINTENT1016, 175. Rather, the Examiner first cited and asserted Acxiom during prosecution of the original parent patent, the ’440 Patent. LIVEINTENT1011, 59-63, 68; LIVEINTENT1015, 383. The Examiner’s reliance on Acxiom in examining the ’307 Patent at best suggests he was recycling prior art from his initial examination of the ’440 Patent, rather than conducting even a cursory review of the references newly presented by the applicant.

3. The Examiner Allowed the ’307, ’582, and ’904 Patent Claims Because of His Determination That the Prior Art Fails to Disclose URL Redirection Despite Jaye Teaching the Very Feature.

Beyond altogether failing to consider Robinson and Jaye, the Examiner did not consider their specific teachings on collecting profile attributes via URL redirection.

This feature was critical to the allowance of the ’307, ’582, and’904 Patents claims, which all recite URL redirection. *See supra* Section II.A. The Examiner allowed the ’307 Patent claims because he credited the applicant’s assertion that Acxiom fails to teach URL redirection. LIVEINTENT1015, 106, 121-122, 145-146. This reasoning similarly led to the allowance of the ’582 and ’307 Patent claims. When the applicant filed the ’582 Patent claims, the applicant indicated

that the claims were "slightly modified from the claims allowed in [the '307 Patent]" and, "[b]ecause the modifications [were] not significant to the reasons for allowance [for the '307 Patent], [the '582 Patent application] [stood] in condition for allowance as well." LIVEINTENT1017, 192. The '307 and '582 Patent claims were in fact so similar that the Examiner initially rejected the '582 Patent claims "as claiming the same invention as that of claims 1-10 of [the '307 Patent]." LIVEINTENT1017, 147. Likewise, when the applicant filed the '904 Patent claims, the applicant presented these claims as modifications to the '582 Patent claims. LIVEINTENT1002, 95. In view of these similarities, the Examiner rejected the claims as being obvious in view of the claims of the '582 and '307 Patent claims, and cited the examination of these earlier patents in allowing the '904 Patent claims. *Id.*, 39, 71-72. Therefore, the applicant's assertion during examination of the '307 Patent that Acxiom fails to disclose URL redirection led to allowance of the '307, '582, and '904 Patent claims.

But, as discussed above, the Examiner overlooked the fact that applicant-cited reference Jaye taught this feature. *See supra* Sections II.B.1-2. Specifically, Jaye teaches redirection of partial profiles, expressly stating "redirection may be used to transfer the user to the enterprise server." LIVEINTENT1005, 6:47-50; LIVEINTENT1015, 163; *see* Pet. 35-40.

The file histories of the '904, '307, and'582 Patents therefore support only

one reasonable conclusion: The Examiner should have but failed to consider Jaye's teachings on URL redirection—the very feature leading to the allowance of claims across the '307, '582, and'904 Patents. *See supra* Sections II.B.1-2. The Patent Office has an interest in devoting resources to remedy this material error, and thus discretionary denial of the Petition is inappropriate.

C. The Examiner Erroneously Limited His Examination of All Family Members Following the First-Filed U.S. Application—the '440 Patent— By Never Having Updated His Search Strategy After Examining the '440 Patent.

1. The Examiner Did Not Conduct Any Searches in Examining Any Family Member of the '904 Patent Filed After the '440 Patent.

The prosecution histories of other family members of the '904 Patent further illustrate the extent of the Examiner's error, particularly his failure to conduct an examination of the claims in each patent independently and thoroughly after examining the'440 Patent, the original parent patent in the patent family. The examination of the '440 Patent set in stone the art the Examiner considered in allowing all subsequent family members, leading to misplaced reuse of the Acxiom reference.

The record shows the Examiner conducted searches and evaluations of the prior art specific to the subject matter of the '440 Patent claims. Although the applicant did not submit any references to the Patent Office, the initial examiner, Examiner Stewart, issued a non-final office action including a rejection of the claims as being anticipated by a reference he identified in his own search—U.S. Patent

No. 6,055,513 (Katz). LIVEINTENT1011, 180-86. In the next office action, Examiner Ouellette, who conducted all subsequent examination in this patent family, maintained the rejection in view of Katz. *Id.*, 144-47. Then, in response to multiple rounds of claim amendments, the Examiner issued one office action rejecting the claims as being unpatentable over Katz in view of U.S. Patent No. 5,855,008 (Goldhaber), then another office action rejecting the claims in view of Acxiom, and then a notice of allowance, explaining in detail the limitations of independent claim 1 that were absent in Acxiom, Katz, and Goldhaber. *Id.*, 22-27, 57-64, 87-88, 107-110, 129-130. With each office action and the notice of allowance, the Examiners attached their search strategies and prior art search results and listings of search terms and, in one office action, specifically identified several pertinent prior art references in his remarks. *Id.*, 33-38, 68-69, 71-73, 114-117, 119, 149-50, 186, 188-90. The final listing of search terms included 50 search strings used during the course of prosecution of the ’440 Patent. *Id.*, 33-38.

The Examiner failed to afford this same level of review to any of the later-filed family members. In the seven patent applications that followed the ’440 Patent, including the ’904 Patent application, the Examiner alleged that he searched Class 705 and conducted searches using examiner search tools, including the Examiner’s Automated Search Tool (EAST) and DIALOG Scientific and Technical

Network (DIALOG)[2], and yet did not attach search histories indicating search strings and the scope of his search.[3] Moreover, in these seven applications, the Examiner raised only two prior art rejections in view of a single reference (Acxiom) in only two of the seven applications, the '493 and '307 Patent applications. LIVEINTENT1013, 57-60; LIVEINTENT1015, 152-54. The Examiner's Acxiom rejection for the '307 Patent application—one of two family members whose examination the Examiner considered in allowing the '904 Patent—was so perfunctory that the applicant criticized it as "simply quot[ing] the entirety of [the independent claim] and cit[ing] the entire Acxiom article as a whole; nowhere does it identify any specific quotation from or portion in Acxiom that corresponds to the elements of the claimed invention." LIVEINTENT1015, 146; *see id.*, 152-54. In the other five applications, including the '904 Patent application, the Examiner did

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[2] *See* MPEP §§ 901.05(c), 901.06(a) (Rev. 9 Aug. 2012).

[3] LIVEINTENT1013, 33, 69; LIVEINTENT1015, 114, 159; LIVEINTENT1017, 128, 149; LIVEINTENT1019, 19, 58; LIVEINTENT1021, 18; LIVEINTENT1002, 41, 80; LIVEINTENT1023, 133, 153, 190; *see* MPEP §§ 719.05(II) (stating that "examiners must include a complete search history [of any electronic search] in the form of a printout to be placed in the application file" and indicating both EAST and DIALOG provided search history printouts).

not raise any prior art rejections and was entirely silent about the prior art. LIVEINTENT1017, 122-123, 140-142, 147-148; LIVEINTENT1019, 15-16, 45-47; LIVEINTENT1021, 15-16; LIVEINTENT1003, 39-40, 71-73; LIVEINTENT1023, 125-126, 146-149, 179-181. The Examiner's repeated neglect in reviewing prior art in this patent family highlights the flawed examination resulting in the erroneous allowance of the '904 Patent.

2. The Examiner Specifically Failed to Take Any Efforts to Search for Prior Art Teaching URL Redirection of Partial Profiles, Even Though the Examiner Knew This Feature Was Key to Patentability of the Claims.

The Examiner recognized the significance of URL redirection to the claims of the '307 Patent and subsequent family members, including the '904 Patent, and yet allowed these claims without conducting even a minimal search for this feature.

First, the Examiner understood the '307 Patent claims as being directed to an invention distinct from its predecessors, specifically, profile attribute collection via URL redirection. During prosecution of the '493 Patent preceding the '307 Patent, the applicant added claims 93-100, explaining that these new claims were "directed to methods of collecting profile attributes and recording their sources, by use of redirection from a visited website . . . ." LIVEINTENT1013, 48. In the Examiner's view, however, these new claims "incorporated a new invention and would require a restriction." *Id.*, 23. The Examiner thus withdrew and canceled these claims consistent with the applicant's constructive election of the originally

presented claims. *Id.*, 25. The applicant then filed a divisional application (which issued as the '307 Patent) directed to these withdrawn and canceled claims—i.e., the claims directed to collecting profile attributes by use of redirection. LIVEINTENT1015, 379; *see id.*, 377-378. Moreover, during prosecution of the '307 Patent, the applicant repeatedly argued that Acxiom does not disclose URL redirection, and the Examiner credited this argument. *See supra* Section II.B.3. Thus, the restriction requirement and the applicant's repeated arguments on URL redirection confirm the Examiner knew that profile attribute collection via URL redirection was a significant feature of the '307 Patent.

Second, the Examiner recognized this feature to be similarly critical to the claims of all patents that followed—including the '904 Patent. *See supra* Section II.A. Indeed, for each of these patents, the applicant filed terminal disclaimers with respect to the '307 Patent to overcome nonstatutory double patenting rejections or to otherwise advance the application to allowance. LIVEINTENT1017, 140-141, 147-148; LIVEINTENT1019, 15, 22, 45-47; LIVEINTENT1021, 15, 26; LIVEINTENT1003, 39-40, 61, 64, 71-72; LIVEINTENT1023, 134, 147.

Third, despite knowing that URL redirection of partial profiles was critical to the claimed invention of the '307 Patent and its progeny, the Examiner took no efforts to search the prior art for this feature. As discussed above, the Examiner conducted searches for only the '440 Patent claims (*see supra* Section II.C.1), but

these searches were not directed to URL redirection. The search strings recorded in the ’440 Patent file history do not include a keyword search for URL redirection, much less redirection. LIVEINTENT1011, 34-38. Furthermore, no matter how thorough the Examiner searched the claims of the ’440 Patent, his searches would not have specifically targeted URL redirection because none of the claims of the ’440 Patent recite redirection. LIVEINTENT1010, 16:38-20:4.

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In sum, the Examiner allowed the ’904 Patent claims without evaluating any applicant-cited references, without addressing the teachings of Robinson and Jaye as they pertain to URL redirection, and without conducting a search specific to URL redirection. These repeated failures reflect a breakdown in the examination process that undermines the credibility of the ’904 Patent. Referral is therefore necessary to preserve the integrity of the Patent Office’s examination procedures.

III. BOARD REVIEW WOULD STREAMLINE COMPLEX ISSUES IN THE CO-PENDING DISTRICT COURT LITIGATION.

AlmondNet’s assertion of multiple patents covering diverse subject matter in the district court litigation supports instituting IPR, as the Board is better suited to assess validity in such complex cases. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9, at 2-3 (Jun. 13, 2025). The ’904 Patent, one of four asserted patents, is distinct from the others, which belong to unrelated families and cover different aspects of electronic advertising: The ’398 Patent involves actions

triggered by devices on the same network (LIVEINTENT1025, 24:49-54), the '146 Patent focuses on displaying ads based on profile attributes across media properties (LIVEINTENT1026, 12:64-13:5), and the '445 Patent relates to delivering ads by comparing visitor profiles with stored requests (LIVEINTENT1027, 15:3-14). In contrast, the '904 Patent concerns URL-redirected partial profiles for third-party ad delivery. LIVEINTENT1001, 16:61-17:5. Despite all relating to electronic advertising, the patents' diverse and complex subject matter justifies institution to streamline issues in the co-pending litigation, conserving resources for the parties, judiciary, and Board.

IV. PATENT OWNER OVERESTIMATES ITS SETTLED EXPECTATIONS REGARDING THE '904 PATENT.

Patent Owner's claim of settled expectations for the '904 Patent is undermined by a history of developments affecting its scope and validity. ***First***, four years post-issuance, Patent Owner disclaimed dependent claims 2, 12, and 22, altering the patent's legal scope. LIVEINTENT1002, 1, 19; *Yahoo! Inc. v. AlmondNet, Inc.*, CBM2017-00051, Paper 7, at 23-24 (Sept. 6, 2017). ***Second***, the related '582 and '249 Patents, with similar claims, faced instituted IPRs, supporting institution here. The '582 Patent's claims were found unpatentable (*Meta Platforms, Inc. v. AlmondNet*, Inc., IPR2022-01436, Paper 30, at 2 (PTAB Mar. 13, 2024)), and the '249 Patent's claim 1 was likely unpatentable over Merriman and Jaye, the latter used in this Petition (*Freewheel Media, Inc. v. AlmondNet, Inc.*, IPR2024-

00416, Paper 10, at 1, 11, 37 (PTAB Oct. 1, 2024)). Patent Owner did not defend most of the '249 Patent claims. *Freewheel*, IPR2024-00416, Paper 13, at 4-5. ***Finally***, the '904 Patent's flawed examination process, resulting in material error, outweighs settled expectations. *See Anthony*, IPR2025-00559, Paper 12, at 2; *supra* Section II. Thus, discretionary denial is unwarranted despite the patent's age.

V. NEITHER THE PETITION'S EXPERT TESTIMONY NOR ITS RELIANCE ON OBVIOUSNESS GROUNDS FAVORS DISCRETIONARY DENIAL.

Patent Owner argues that the Petition's extensive expert testimony (over 100 pages) favors discretionary denial, as district courts better assess witness credibility and the declaration's length suggests a weak unpatentability challenge. Paper 7, at 4-5 (DD Req.). However, the Petition does not rely on expert testimony to fill gaps in prior art (Robinson, Jaye, Coleman), and the declaration complies with the Consolidated Trial Practice Guide (TPG), establishing the level of skill in the art, explaining prior art teachings, and providing reasons to combine references without substituting for prior art disclosures. *iRhythm Techs., Inc. v. Welch Allyn, Inc*., IPR2025-00377, Paper 10, at 2 (PTAB June 6, 2025); TPG 34-36; LIVEINTENT1003 ¶¶10-21, 22-84, 86-110. Thus, the expert testimony does not support denial.

Patent Owner also claims the Petition's reliance on obviousness (§ 103) rather than anticipation (§ 102) indicates a weak challenge. DD Req. 5. However, the

statutory basis does not determine the challenge's merits, which depend on the strength of facts and law. Patent Owner identifies no evidentiary or legal flaws in the Petition's prior art or arguments. Thus, the use of obviousness does not favor discretionary denial.

VI. THE *FINTIV* FACTORS DO NOT FAVOR DISCRETIONARY DENIAL.

Every *Fintiv* factor is either neutral or weighs against discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

A. Factors 1 and 5: No Stay Has Been Requested, and the Same Parties Are in the Co-Pending Litigation.

Factors 1 and 5 are neutral. No litigation stay has been requested, and no evidence establishes how the district court would resolve such a request if IPR is instituted. And the parties in the co-pending litigation and this IPR are the same.

B. Factors 2-3: The Court's Trial Date Would Occur Well After the Final Written Issue Is Issued, and Limited Resources Would Have Been Expended by Institution.

Factors 2 and 3 favor referral and, at worst, are neutral. Trial is scheduled for October 4, 2027. LIVEINTENT1028, 12. The Final Written Decision is expected in December 2026—well before the scheduled trial date. And as Patent Owner acknowledges, the district court case has not seen significant progress. DD Req. 7. Indeed, Patent Owner and Petitioner have not exchanged infringement or invalidity

contentions, proposed terms for claim constructions, or scheduled depositions. Patent Owner's opening claim construction brief is due September 25, 2026, fact discovery is not expected to be completed until August 28, 2026, and opening expert reports are not due until January 15, 2027. LIVEINTENT1028, 3-5, 7.

C. Factor 4: There Is No Overlap Between the Issues in the Petition and the District Court Proceeding.

Factor 4 strongly favors institution. In Patent Owner's view, the stipulation is insufficiently broad because it permits Petitioner to raise an invalidity ground based on system prior art in combination with prior art that reasonably could have been raised in this IPR proceeding. DD Req. 8. But the breadth of Petitioner's stipulation is identical to the breadth of stipulations in other proceedings where the Director determined the stipulations weighed against discretionary denial. *See Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9, at 2 (PTAB June 13, 2025); *Tesla*, IPR2025-00217, Paper 8, at 10-11 (PTAB May 27, 2025) (stipulation having same breadth as Petitioner's stipulation); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00341, Paper 12, at 2 (PTAB June 13, 2025); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00341, Paper 10, at 10-11 (PTAB May 27, 2025) (stipulation having same breadth as Petitioner's stipulation). Patent Owner's observation that the stipulation ***could*** be even broader does not alter the conclusion that Petitioner's stipulation weighs against discretionary denial.

Patent Owner claims Petitioner's stipulation allows subsequent *ex parte*

reexamination requests, potentially causing inefficiencies. DD Req. 9. However, this is irrelevant to inefficiencies with respect to co-pending district court litigation and speculative, as no such reexamination exists. Statutory and administrative mechanisms mitigate inefficiencies: Estoppel under 35 U.S.C. § 315(e)(1) prevents Petitioner from raising IPR grounds in later reexaminations; the Director can manage concurrent proceedings under 35 U.S.C. § 314(d); and the Patent Office can deny abusive reexamination requests under 35 U.S.C. § 325(d). *In re Vivint, Inc.*, 14 F.4th 1342, 1354 (Fed. Cir. 2021). Thus, Petitioner's stipulation is unnecessary.

D. Factor 6: Other Circumstances Weigh in Favor of Referral.

Factor 6 strongly favors referral. As discussed above, contrary to Patent Owner's assertion, the Petition's reliance on obviousness grounds has no bearing on the merits of unpatentability. DD Req. 11; *see supra* Section V. The Petition's merits are strong at least because it offers compelling evidence as to why the prior art teaches the URL redirection feature that led to the allowance of the '904 Patent. *See supra* Section II.B.3. And the other factors raised in Patent Owner's briefing—including settled expectations and expert testimony—do not favor discretionary denial, as discussed above. DD Req. 11; *see supra* Section V. In fact, other factors, such as material error and litigation complexity, favor referral. *See supra* Sections II-III.

VII. CONCLUSION

For these reasons, a holistic evaluation of the record strongly weighs against discretionary denial. Petitioner therefore respectfully requests that this case proceed to an institution determination on the merits.

Respectfully submitted,

Dated October 8, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on October 8, 2025, a complete and entire copy of this Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and Accompanying Exhibits were provided by email to the Patent Owner by serving the correspondence email address of record as follows:

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