

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STARBUCKS CORPORATION,
Petitioner,

v.

PI-DESIGN AG,
Patent Owner.

IPR2025-01178
Patent No. 8,695,486

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

TABLE OF CONTENTS

TABLE OF AUTHORITIES	ii
I. INTRODUCTION	1
II. DENIAL OF INSTITUTION UNDER § 314 IS WARRANTED	1
A. The Challenged Patent Has Been in Force for 11 Years.....	1
B. Petitioner Has Long Known of the Challenged Patent.	2
C. Petitioner Did Not Challenge the Patent Earlier in the Parties’ Long and Contentious Relationship.....	4
D. Petitioner is the Defendant in the Parallel District Court Proceeding. .	5
E. Petitioner Delayed Filing Its Petition.....	6
F. Petitioner Has Not Offered a Stipulation to Address Concerns of Duplicative Efforts and Conflicting Decisions.	6
III. CONCLUSION.....	7

TABLE OF AUTHORITIES

Cases

<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).....	5
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 15 (PTAB May 13, 2020)	5
<i>Dabico Airport Sols. Inc. v. AXA Power ApS</i> , IPR2025-00408, Paper 21 (Director June 18, 2025)	2
<i>DataDome S.A. v. Arkose Labs Holdings, Inc.</i> , IPR2025-00693, Paper 14 (Director Aug. 14, 2025)	7
<i>Google LLC v. SoundClear Techs. LLC</i> , IPR2025-00344, Paper 15 (Director Aug. 4, 2025) (Deshpande, J.)	2
<i>Kahoot! AS v. Interstellar Inc.</i> , IPR2025-00696, Paper 12 (Director July 31, 2025).....	3, 5
<i>Murata Mfg. Co. v. Georgia Tech Res. Corp.</i> , IPR2025-00383, Paper 14 (Director July 29, 2025).....	3
<i>NVIDIA Corp. v. Neural AI, LLC</i> , IPR2025-00606, Paper 18 (Director July 31, 2025).....	5

Statutes

35 U.S.C § 315(b)	6
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Other Authorities

Director’s March 26, 2025, Memorandum Regarding Interim Processes for PTAB Workload Management	1, 6
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PATENT OWNER'S EXHIBIT LIST

No.	Description
EX2001	Aug. 12, 2015, Transmittal Letter and IDS filed during prosecution of Petitioner's U.S. Pat. No. 9,232,873
EX2002	IDS filed during prosecution of Petitioner's U.S. Pat. No. D1,041,989
EX2003	Petitioner's Answer, Affirmative Defenses, and Counterclaim in <i>Bodum USA, Inc. et al. v. Starbucks Corp.</i> , Case No. 1:23-cv-02946 (N.D. Ill.)
EX2004	Patent Owner's Amended Complaint in <i>Bodum USA, Inc. et al. v. Starbucks Corp.</i> , Case No. 1:23-cv-02946 (N.D. Ill.)
EX2005	Declaration of Petitioner's former CEO filed in Case No. 1:23-cv-02946
EX2006	Patent Owner's Complaint for Declaratory Judgment and Product Disparagement in <i>Bodum Holding AG et al. v. Starbuck Corp.</i> , Case No. 19-cv-04280 (S.D.N.Y).

Unless otherwise noted, all highlighting in the Exhibits has been added.

I. INTRODUCTION

Pursuant to the Director’s March 26, 2025, Memorandum regarding Interim Processes for PTAB Workload Management (“Director’s March Memorandum”), Patent Owner requests that the Director exercise discretion to deny institution of the Petition for numerous reasons.

First, the challenged patent has been in force for more than 11 years, thus creating strong settled expectations for Patent Owner.

Second, Petitioner has known about the challenged patent for a significant amount of time.

Third, despite a long, contentious relationship, Petitioner waited years to challenge the patent. Failure to seek early review of the patent favors denial.

Fourth, Petitioner is the defendant in a parallel district court infringement action.

Fifth, Petitioner further delayed filing its petition once the suit was filed.

And Sixth, Petitioner has not offered a stipulation to address concerns of inefficiency, duplicative efforts, and potentially conflicting decisions.

II. DENIAL OF INSTITUTION UNDER § 314 IS WARRANTED

A. The Challenged Patent Has Been in Force for 11 Years.

The Director should exercise discretion to deny institution because the challenged patent has been *in force for more than 11 years* (EX1001 at 1), thus

creating strong settled expectations for Patent Owner. An *inter partes* review is not an appropriate use of Board resources under these circumstances. *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2-3 (Director June 18, 2025).

B. Petitioner Has Long Known of the Challenged Patent.

The exercise of discretion to deny institution is particularly appropriate here because Petitioner knew about the inventions disclosed in the challenged patent for *ten years before filing its Petition*. See *Google LLC v. SoundClear Techs. LLC*, IPR2025-00344, Paper 15 at 2-3 (Director Aug. 4, 2025) (Deshpande, J.) (concluding discretionary denial is appropriate where challenged patents were in force ten years and petitioner had knowledge of them for six years).

The challenged patent issued on April 15, 2014. EX1001 at 1. On August 12, 2015—nearly *ten years* before filing the Petition—Petitioner filed an IDS during prosecution of its U.S. Pat. No. 9,232,873, citing to the Office 36 of Patent Owner’s (*i.e.*, Bodum and Pi-Design)¹ patents and published patent applications. EX2001 at 3-7. One of the references cited was U.S. Patent Publication No. US 2011/0088561.

¹ The challenged patent is assigned to Pi-Design AG, which is a subsidiary of Bodum Holding AG. The inventor of the challenged patent is Jorgen Bodum. Bodum USA, Inc. is a licensee of Pi-Design AG in the United States. For simplicity, this Request will refer to Pi-Design and Bodum as Patent Owner.

Id. at 4, Cite No. 42. ***That reference is the published application that led to the challenged patent.*** See EX1001 at 1 (showing challenged patent's application number US 2011/0088561). Moreover, at the time Petitioner filed that IDS, the challenged patent had been issued for over a year. *See id.*

Later, on August 4, 2022—nearly three years before filing the Petition—Petitioner filed an IDS during prosecution of its U.S. Pat. No. D1,041,989, citing to the Office 16 of Patent Owner's patents and published patent applications. EX2002 at 1, Cite Nos. 3-17. ***One of those references was the challenged patent.*** *Id.*, Cite No. 15.

Petitioner was plainly ***aware long ago*** that Petitioner and Patent Owner are ***involved in the same technology space***, and Petitioner was ***aware of the challenged patent for a significant amount of time*** before filing its Petition. A failure to seek early review of the challenged patent favors denial and outweighs other factors (such as no trial being set). *Murata Mfg. Co. v. Georgia Tech Res. Corp.*, IPR2025-00383, Paper 14 at 2-3 (Director July 29, 2025).²

² Patent Owner concedes that some considerations could weigh against discretionary denial. No trial date is currently set in the parallel district court proceeding, the claim construction process has not yet begun, and the parties have asked the district court to extend deadlines. To the extent these are given any weight, they do not outweigh the factors here that favor denial. For example, in *Murata*, the Director held that the failure to seek early review of the patent outweighs such factors. *See also Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (Director July 31, 2025) (even though the parallel district court proceeding had been stayed, strong settled

C. Petitioner Did Not Challenge the Patent Earlier in the Parties’ Long and Contentious Relationship.

Petitioner and Patent Owner have had a commercial relationship for three decades. *See* EX2003 at 3 ¶ 13; *see also* EX2004 at 3 ¶ 13. Their relationship in the U.S. has been contentious since before the challenged patent issued in 2014.

For example, in the Fall of 2007, Patent Owner sued Petitioner for infringing the trade dress of one of Patent Owner’s iconic French press coffeemakers. EX2004 at 3 ¶ 15; EX2005 at 1 ¶ 4. That case was resolved with a 2008 Confidential Settlement Agreement and Release. EX2004 at 3 ¶ 15.

Patent Owner sued Petitioner again in 2019 for product disparagement. EX2006. That case was dismissed in November 2021 after the parties entered into another Confidential Settlement Agreement and Release.

In June and August 2022, the parties held meetings with the goal to “restart” their relationship. EX2005 at 3 ¶ 10. Those efforts were not successful and, in May 2023, Patent Owner sued Petitioner for violating the 2008 Settlement Agreement.

expectations from the patent being in force for over *six years* tipped the balance in favor of discretionary denial). For brevity, Patent Owner will not address the other *Fintiv* factors since they are outweighed by the factors Patent Owner addresses here. By choosing not to directly address those other *Fintiv* factors, Patent Owner does not concede that they weigh against discretionary denial.

See EX2004 at 5. That suit is currently pending. *See* Pet. at 10. Then, in June 2024, Patent Owner sued Petitioner for infringing the challenged patent. *See id.*

Starbucks had every incentive to challenge the patent earlier ***but did not do so***. Petitioner’s failure to seek early review of the patent favors denial. *NVIDIA Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18 at 3 (Director July 31, 2025). The fact that Patent Owner did not previously accuse Petitioner of infringement does not counsel otherwise. *See Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (Director July 31, 2025) (stating that merely “because Patent Owner did not previously assert the challenged patent against Petitioner does not defeat Patent Owner’s settled expectations”).

D. Petitioner is the Defendant in the Parallel District Court Proceeding.

Fintiv Factor 5 looks to “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential). Specifically, when “the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020) (informative). Here, Petitioner is the defendant in the parallel litigation in the Northern District of Illinois. Pet. at 10. Thus, this also weighs in favor of discretionary denial.

E. Petitioner Delayed Filing Its Petition.

Petitioner's subjective delay after notice of infringement also weighs in favor of discretionary denial. *See* Director's March Memorandum (permitting parties to address all relevant considerations bearing on the Director's discretion). Not only did Petitioner wait years to file its Petition after knowing of the challenged patent, but after Patent Owner filed suit Petitioner waited until almost the last day to file its Petition before the one-year statutory bar in 35 U.S.C § 315(b).³ Similarly, Petitioner waited more than seven months to file the Petition after serving its November 15, 2024, Initial Invalidity Contentions required by the district court's Local Patent Rules. It is not an effective use of Board resources to address issues that Petitioner has no urgency to raise.

F. Petitioner Has Not Offered a Stipulation to Address Concerns of Duplicative Efforts and Conflicting Decisions.

Despite being aware of the Director's March Memorandum (*see* Pet. at 72), and despite filing its Petition nearly three months after the Memorandum issued, Petitioner nevertheless does *not* include a stipulation to address concerns of inefficiency, duplicative efforts, and potentially conflicting decisions with the parallel infringement action. This weighs in favor of discretionary denial even

³ Patent Owner filed its infringement action against Petitioner on June 25, 2024, and Petitioner waited 363 days before filing its Petition on June 23, 2025.

though there is no scheduled trial date. *DataDome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, Paper 14 at 3 (Director Aug. 14, 2025).

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion to deny institution.

Date: August 28, 2025

Respectfully submitted,

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CERTIFICATION REGARDING WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), Patent Owner certifies that there are 1603 words in the paper excluding the portions exempted under 37 C.F.R. §42.24(a)(1).

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that the above document was served on August 28, 2025 by filing this document through the Patent Trial and Appeal Case Tracking System (PTACTS) as well as delivering a copy via electronic mail upon the following attorneys of record for Petitioner:

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