

IPR2025-01184
Patent No. 7,055,169

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PINTEREST, INC.
Petitioner,
v.

OPENTV, INC.
Patent Owner.

Case IPR2025-01184
U.S. Patent No. 7,055,169

**PATENT OWNER'S MEMORANDUM
IN SUPPORT OF DISCRETIONARY DENIAL**

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Ex. 2019	May 6, 2021 Email from A.Waxler, VP of IP Licensing, NAGRA, regarding Kudelski Presentation to Pinterest 5.5.2021 v1.1
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INTRODUCTION

The Director should deny institution of Petitioner’s request for *inter partes* review of U.S. Patent No. 7,055,169 (the “’169 patent”). The ’169 patent is expired. It issued on May 30, 2006 to Patent Owner OpenTV, Inc. (“Patent Owner” or “OpenTV”) and has been in force through September 28, 2023. Petitioner Pinterest, Inc. (“Petitioner” or “Pinterest”) has known of the ’169 patent and its infringement for over four years, yet it delayed in challenging the patent. Moreover, as described further below, there are significant credibility issues with Petitioner’s expert, Dr. Immanuel Freedman, that are better suited for resolution by a district court. Finally, consideration of the six *Fintiv* factors support discretionary denial.

It is not efficient or prudent for the Board to use its resources by analyzing the ’169 patent. Accordingly, pursuant to Acting Director Stewart’s March 26, 2025 Memorandum titled “Interim Processes for PTAB Workload Management” (“Interim Processes Memorandum”), and the Board’s decision in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (precedential), Patent Owner respectfully requests that the Director exercise discretion and deny Petitioner’s request for *inter partes* review of the ’169 patent.

BACKGROUND

OpenTV sued Pinterest in the District of Delaware on November 27, 2024. *OpenTV, Inc. v. Pinterest, Inc.*, No. 1:24-cv-01301-JCG (D. Del.), Dkt. 1. Ex. 2001. In this litigation, OpenTV asserts four patents against Pinterest, including the '169 patent. Ex. 2002. In response, Pinterest has asserted that all asserted claims, across all asserted patents, are invalid. Ex. 2003 at 103. Trial is scheduled for July 12, 2027. Ex. 2004 at 26.

To date, Pinterest has only filed one IPR petition challenging the '169 patent. Pinterest has not moved to stay the district court litigation, in whole or in part.

ARGUMENT

The efficiency and integrity of the system is best served if the Director denies institution.

Institution of *inter partes* review is a matter of discretion. *Cuozzo Speed Techs. v. Lee*, 579 U.S. 261, 273 (2016) (citing 35 U.S.C. § 314); *Mylan Lab'ys Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1382 (Fed. Cir. 2021) (“[N]o petitioner has a right to such institution.”). Where institution does not align with the AIA’s objective “to provide an effective and efficient alternative to district court litigation,” it should be denied. *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (P.T.A.B. Sept. 6, 2017) (precedential).

When determining whether to exercise discretion to deny institution, “all relevant considerations” may be considered, including (i) “[w]hether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims”; (ii) “[w]hether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability”; (iii) “[t]he strength of the unpatentability challenge; (iv) “[t]he extent of the petition’s reliance on expert testimony”; (v) “[s]ettled expectations of the parties, such as the length of time the claims have been in force; (vi) “[c]ompelling economic, public health, or national security interests”; and (vii) “[a]ny other considerations bearing on the Director’s discretion.” Interim Processes Memorandum at 2-3.

On balance, these factors, including those enumerated in *Apple v. Fintiv*, weigh in favor of the Director exercising discretion to deny institution, and leaving any invalidity analysis of the ’169 patent to the district court in the parallel district court litigation.

A. Strong settled expectations exist for OpenTV because the ’169 patent is expired and was in force for a full patent term.

Strong settled expectations for OpenTV merit discretionary denial because the ’169 patent is an expired patent and prior to expiration was in force for a full statutory term.

“Although there is no bright-line rule on when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be.” *Dabico Airport Sols. Inc. v. Axa Power Aps*, No. IPR2025-00408, Paper 21 at 3 (P.T.A.B. June 18, 2025). The Director has previously given settled expectations of a patent owner significant weight in determining whether to grant discretionary denial, even doing so where *Fintiv* factors would weigh against discretionary denial. *E.g., Irhythm Techs., Inc. v. Welch Allyn, Inc.*, No. IPR2025-00363, Paper 10 at 2-3 (P.T.A.B. June 6, 2025) (“Several arguments weigh against discretionary denial . . . Nevertheless, Patent Owner argues that because one of the patents has been in force since as early as 2012 and Petitioner was aware of it as early as 2013 . . . settled expectations favor denial of institution[.]”).

Here, the length of time that the ’169 patent has been in force strongly favors discretionary denial. The ’169 patent was filed on April 21, 2003, and issued on May 30, 2006. It has been in force for its full statutory term, including a patent term adjustment of 160 days. This is more than sufficient to create “strong settled expectations” for the Patent Owner in this case. *See e.g., Oneplus Tech. (Shenzhen) Co., Ltd. v. Pantech Corp.*, No. IPR2025-00637, Paper 17 at 2 (P.T.A.B. Aug. 14, 2025) (challenged patent was in force for over seven years); *Datadome S.A. v. Arkose Labs Holdings, Inc.*, No. IPR2025-00693, Paper 13 at 2 (P.T.A.B. Aug. 14,

2025) (challenged patents were in force for approximately seventeen years and ten years).

In addition, the '169 patent has been asserted in numerous litigations since 2012. *See* Exs. 2005 to 2010. While none of these cases reached the merits, each one resulted in settlements between the parties. *See* Exs. 2011 to 2016. OpenTV's strong settled expectations as evidenced by the patent's expiration and its litigation history thus provide compelling reasons to grant discretionary denial.

B. Pinterest has known of the '169 patent and its infringement for more than four years before filing this Petition.

Additionally, Pinterest's longstanding knowledge of the '169 patent and failure to diligently seek review also favors discretionary denial. Petitioner's awareness of a patent and "failure to seek early review of the patent[]" weighs in favor of discretionary denial. *See Irhythm*, Paper 10 at 3; *see also AT&T Services Inc. v. ASUS Technology Licensing Inc.*, No. IPR2024-00992, Paper 14 at 12 (P.T.A.B. Dec. 16, 2024) (denying institution where petitioner filed petition five months after receiving infringement contentions and failed to "present[] any factual evidence to justify this delay").

OpenTV filed its action against Pinterest on November 27, 2024. *See* Ex. 2001. However, Pinterest became aware of the '169 patent much earlier. The parties were in discussion *for years*, beginning in November 2020. Ex. 2017 at 2; Ex. 2018

at 1. In May 2021, Patent Owner provided Pinterest a claim chart showing Pinterest's infringement of the '169 patent. Ex. 2017 at 2; Ex. 2019; Ex. 2020 at 15-20. The parties' discussions continued throughout 2021, 2022 and 2023. Ex. 2017 at 2; Ex. 2018 at 1. Before filing suit, Patent Owner reached out in July 2024, again identifying the '169 patent. Ex. 2018 at 1, 2. At no point did Pinterest take steps to challenge the '169 patent in the Patent Office.

At bottom, Pinterest delayed filing its IPR Petition for years. Pinterest's Petition provides no explanation for its significant delay in filing this petition. This further weighs in favor of discretionary denial.

C. Pinterest's Petition contains extensive improper expert testimony and is subject to a credibility challenge better dealt with in district court.

The Director should deny institution because Pinterest relies heavily on a 129-page expert declaration from Dr. Immanuel Freedman that is subject to credibility challenges better suited for resolution by an Article III court. Expert testimony is not a substitute for patents and printed publications. *See, e.g.*, Consolidated Trial Practice Guide (CTPG) at 34-36 (Nov. 2019). An obviousness determination cannot be based on conclusory expert testimony. *See, e.g., TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019); *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Nor can expert testimony be used to improperly fill gaps in the prior art. Acting Director Stewart's July 31,

2025 Memorandum titled “Enforcement and Non-Waiver of 37 C.F.R. § 42.104(B)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews” (“As a practical matter, enforcement of Rule 104(b)(4) means that applicant admitted prior art (AAPA), expert testimony, common sense, and other evidence that is not ‘prior art consisting of patents or printed publications’ (collectively, ‘general knowledge’) may not be used to supply a missing claim limitation.”); *see also Xerox Corp. v. Bytemark, Inc.*, No. IPR2022-00624, Paper 9 at 15-16 (P.T.A.B. Aug. 24, 2022) (precedential) (denying institution where petition relied on expert testimony to supply a claim limitation not found in the art). Moreover, where there is extensive reliance on expert testimony, “questions are better resolved in an Article III court.” FAQ for Interim Processes at #22 (<https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>).

First, Pinterest relies extensively on conclusory expert testimony filling gaps in the patents and printed publications, including for a missing claim element. For example, in Pinterest’s discussion of U.S. Patent No. 6,141,018 (“Berl”)—the primary reference cited by Petitioner in Grounds 1-4—Pinterest relies on at least the following conclusory and unsupported statements from Dr. Freedman:

- “A POSITA would understand that both alternatives are viable options for a content author who wants all resources to be prerequisites, given the similar teleological functionality.” Ex. 1004 ¶ 80.
- “A POSITA would have understood that the ActiveX marquee contemplated by Beri is only one possible part of a web page, and that web pages may contain other resources, such as images or text, in addition to the ActiveX object marquee. Therefore, it is my opinion that the ActiveX marquee may be considered a subset of the resources on a web page because it may one of the components that are referenced, loaded, and executed as part of fully rendering a web page.” Ex. 1004 ¶ 81.
- “A POSITA would have understood that the term “resource” refers to any external file, object, script, image, or content that a web page pulls and utilizes Thus, if DrawImmediately is disabled, and if the web page comprises images additional to the marquee object, the resources additional to the marquee object will then be treated as prerequisites.” Ex. 1004 ¶ 81.

Pinterest explicitly relies on these conclusory and unsupported statements as evidence to add to the alleged prior art reference to manufacture a missing claim element. *See also* Ex. 1004 ¶¶ 87, 101. For example, Pinterest argues in their

petition that claim element 1[B] (“determining whether said one or more directives includes a prerequisite directive which indicates that acciuisition [sic] of a subset of said set of resources is a prerequisite for initiating the presentation;”) is taught by Beri. *See* Petition at 25-26. Pinterest, however, cites only to paragraph 81 of the Freedman Declaration in support of, for example, the proposition that “[u]nder the interpretation that the web page is a presentation, the HTML document and/or all objects in the HTML document correspond to the one or more directives, and all the resources in the HTML document and/or all objects are a set of resources, the one or more images and/or ActiveX marquee constitutes a subset of the resources on the entire web page,” and indeed appears to *copy and paste directly from this declaration* in significant portions of this discussion. *Compare id. with* Ex. 1004 ¶ 81. Pinterest’s reliance on these statements to fill gaps in Beri thus runs contrary to the Director’s July 31, 2025 memorandum.

Second, while Pinterest’s extensive, improper, and unsupported expert testimony already raises credibility issues, here those issues are even more acute because of the volume of identical (and uncredited) text between the declaration of Dr. Freedman and a prior expert declaration submitted in IPR2018-00463. Expert testimony that parrots (without credit) the words of other expert reports and declarations raises issues of credibility. *See Applications in Internet Time, LLC v. Salesforce, Inc.*, No. 2024-1133, 2024 WL 4456271, at *5 (Fed. Cir. Oct. 10, 2024)

(“AIT reasoned that Dr. Bederson’s opinions as to Popp were questionable based on the fact that much of his testimony was identical to that of Dr. Schmidt—Salesforce’s expert in a separate *ex parte* reexamination proceeding—and that Dr. Bederson could not specify how much of his report he wrote or edited. These allegations provide specific bases for doubting the credibility of Dr. Bederson’s testimony and go to the kinds of facts that *TypeRight* recognized *could* preclude summary judgment.”)

Here, pages of Pinterest’s proffered expert declaration from Dr. Freedman are identical (or nearly identical) to the expert declaration of Dr. Stephen Melvin, submitted in IPR2018-00463. *Compare* Ex. 2021 (Melvin Decl.), ¶¶ 3, 4, 27, 28, 34, 35, 36, 50, 51, 65, 66, 68, 69, 84, 91, 92, 94, 99 *and* Ex. 1004 (Freedman Decl.), ¶¶ 3, 4, 29, 36, 37, 38, 39, 40, 41, 46, 47, 48, 75, 77, 81, 86, 167, 187, 188, 192, 222. Many of these examples of verbatim copying relate to substantive opinions regarding what the art allegedly discloses:

Melvin Decl. (IPR2018-00463)	Freedman Decl. (IPR2025-01184)
Beri explains the structure and operation of the Internet and how some “resources,” such as images, are transferred over the Internet to a user’s computer:	Beri explains the structure and operation of the Internet and how some “resources,” such as images, are transferred over the Internet to a user’s computer:

Melvin Decl. (IPR2018-00463)	Freedman Decl. (IPR2025-01184)
The Internet comprises a vast number of computers interconnected so that information can be exchanged among the computers. Various protocol and other interface standards have been developed for the Internet so that each computer will understand information of the other computers. ... The Internet facilitates information exchange between servers and clients that are located throughout the World. Each computer on the Internet has a unique address (e.g., “acme.com”). When a client wishes to access a resource (e.g., document), the client specifies a Uniform Resource Locator (“URL”) that uniquely identifies the computer on which the server executes and the resource. An example of a URL is “http://acme.com/page1.” In this example, the server is identified by “acme.com” and the resource is	The Internet comprises a vast number of computers interconnected so that information can be exchanged among the computers. Various protocol and other interface standards have been developed for the Internet so that each computer will understand information of the other computers. ... The Internet facilitates information exchange between servers and clients that are located throughout the World. Each computer on the Internet has a unique address (e.g., “acme.com”). When a client wishes to access a resource (e.g., document), the client specifies a Uniform Resource Locator (“URL”) that uniquely identifies the computer on which the server executes and the resource. An example of a URL is “http://acme.com/page1.” In this example, the server is identified by “acme.com” and the resource is

Melvin Decl. (IPR2018-00463)	Freedman Decl. (IPR2025-01184)
identified by “ page1. ” NFLE 1006 at 1:11–36 (emphasis added). Ex. 2021, ¶ 50	identified by “ page1. ” Ex. 1006 at 1:11-36 (emphases added). Ex. 1004, ¶ 46
A POSITA would have understood that the ActiveX marquee contemplated by Beri is only one possible part of a web page, and that web pages contain other resources as well, such as images or text, outside of the ActiveX object marquee. Ex. 2021, ¶ 68	A POSITA would have understood that the ActiveX marquee contemplated by Beri is only one possible part of a web page, and that web pages may contain other resources, such as images or text, in addition to the ActiveX object marquee. Ex. 1004, ¶ 81
Armstrong’s web page includes a prerequisite directive which indicates that acquisition of a subset of said set of resources is a prerequisite for initiating the presentation. Armstrong discloses that web pages may have embedded resources such as images, fonts, colors, and text strings, and that the “primary purpose of HTML is to specify text- and image-based” web pages. NFLE 1009 at 259–262. Specifically, Armstrong states that HTML is “used to embed images, documents, applets, and, in our case,	Armstrong’s web page includes a prerequisite directive which indicates that acquisition of a subset of said set of resources is a prerequisite for initiating the presentation. Armstrong discloses that web pages may have embedded resources such as images, fonts, colors, and text strings, and that the “primary purpose of HTML is to specify text- and image-based” web pages. Ex. 1009 at 259-262. Specifically, Armstrong states that HTML is “used to embed images, documents, applets, and, in our case,

Melvin Decl. (IPR2018-00463)	Freedman Decl. (IPR2025-01184)
ActiveX controls.” <i>Id.</i> at 260. Embedded resources are designated as prerequisite resources because the presentation of the web page is prohibited until the embedded resources are downloaded. In contrast, for resources indicated by data path properties such as TextPath, the initiation of the presentation of the web page can begin immediately, before the image or other resources pointed to by the data path properties are downloaded. <i>Id.</i> at 261–63, 267–68. Ex. 2021, ¶ 91	ActiveX controls.” Ex. 1009 at 260. Embedded resources are designated as prerequisite resources because the presentation of the web page is prohibited until the embedded resources are downloaded. In contrast, for resources indicated by data path properties such as TextPath, the initiation of the presentation of the web page can begin immediately, before the image or other resources pointed to by the data path properties are downloaded. Ex. 1009 at 261-63, 267-68. Ex. 1004, ¶ 187
As discussed above, both Armstrong and Harrington disclose directives which are indicative of an audio, video and/or graphic presentation requiring a set of resources, and a POSITA would have been motivated to combine Armstrong and Harrington. Ex. 2021, ¶ 99	As discussed above, both Armstrong and Harrington disclose <i>directives</i> which are indicative of an audio, video and/or graphic presentation requiring a set of resources, and a POSITA would have been motivated to combine Armstrong and Harrington given their overlap. Ex. 1004, ¶ 222 (emphasis in original)

Dr. Freedman does not credit Dr. Melvin with any of this language, and instead appears to pass this off as his own opinion. Just as in *Applications in Internet Time, LLC v. Salesforce, Inc.*, these non-exhaustive examples of identical or near identical text raise questions regarding the credibility of Pinterest’s expert, Dr. Freedman. These credibility challenges to Pinterest’s expert are better resolved in a district court. Discretionary denial is therefore appropriate.

D. The validity and/or patentability of the ’169 patent has already been extensively analyzed in other fora.

Substantially similar art and arguments to those now put forth by Pinterest were considered by the USPTO during the original prosecution of the ’169 patent.

1. Grounds 1 to 8 rely upon substantially similar art (Beri and Armstrong) to what was already presented to The Office during the prosecution of the ’169 patent.

Pinterest raises eight grounds in its Petition that are premised on Beri or Tom Armstrong, *Designing and Using ActiveX Controls* (“Armstrong”), with a variety of secondary art. These grounds are summarized as follows:

Ground	Claim(s)	Statutory Basis	Prior Art
1	1, 2, 22, 23	§ 103	Beri
2	3, 22	§ 103	Beri in view of Harrington
3	11	§ 103	Beri in view of Kunze
4	12	§ 103	Beri in view of Del Sesto
5	1, 2, 23	§ 103	Armstrong
6	3, 22	§ 103	Armstrong in view of Harrington
7	11	§ 103	Armstrong in view of Kunze
8	12	§ 103	Armstrong in view of Del Sesto

Under *Advanced Bionics* and its statutory basis, 35 U.S.C. § 325(d), “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, No. IPR2019-01469, Paper 6 at 7 (P.T.A.B. Feb. 13, 2020) (quoting 35 U.S.C. § 325(d)). “Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent. The proceedings in which the art was previously presented include, for example: examination of the underlying patent application....” *Id.* at 7-8.

The lynchpin of Pinterest’s arguments center around Beri and Armstrong allegedly teaching ActiveX controls. *See* Pet. at 16-17, 50-51. However, ActiveX controls were substantively discussed in *two* of the prior art references before the Office during the original prosecution of the ’169 patent. *See, e.g.,* Ex. 2022 (U.S. Pat. No. 6,188,401 (“Peyer”)) at 5:66 to 6:11, 6:26-34; ; Ex. 2023 (US Pat. App. No. 2002/0194219 A 1 (“Bradley”)) at 0107, 0229 to 0232.

Under *Advanced Bionics*, the burden thus falls to Petitioner to demonstrate step 2 of the *Advanced Bionics* inquiry that “that the Office erred in a manner

material to the patentability of challenged claims.” *Advanced Bionics*, Paper 6 at

8. To date, Petitioner has made no such showing. As such, there is therefore no need to re-evaluate the patentability of these claims in light of Petitioner’s duplicative art. This further weighs in favor of granting discretionary denial.

2. The prior IPR institution on the ’169 patent does not favor institution here.

Patent Owner expects that Petitioner will raise prior institution of IPR on the ’169 patent in *NFL Enterprises LLC v. OpenTV, Inc.*, IPR2018-00463 (the “NFL IPR”) in opposing discretionary denial. The context of the NFL IPR, however, does not support institution here. First, Patent Owner filed its preliminary response focusing on claim 22 on April 18, 2018 at a time when patent owners could choose to focus on getting some claims denied at institution while leaving other claims with factual issues for the trial phase, *See* IPR2018-00463, Paper No. 6. In fact, if some claims were denied at institution, a patent owner might be able to proceed in district court on those claims. On April 24, 2018, however, the Supreme Court issued the *SAS* decision requiring the PTAB to institute on all or none of the claims. *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 371 (2018). Not surprisingly, the PTAB subsequently instituted on all challenged claims. *See* IPR2018-00463, Paper No. 8. Patent Owner was caught up in the ever-evolving PTAB practice of that historical moment. If the

law were different, as it is now, Patent Owner may have done what it intends to do now: contest institution on all claims.

Second, the Board in the NFL IPR adopted the “broadest reasonable construction” applicable to non-expired patents at the time. *See* IPR2018-00463, Paper No. 8 at 8-9. Any claim construction disputes related to the expired ’169 patent would now be under the *Philips* standard. *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 55 Fed. Reg. 51340 (<https://www.federalregister.gov/documents/2018/10/11/2018-22006/changes-to-the-claim-construction-standard-for-interpreting-claims-in-trial-proceedings-before-the>). Finally, the Board in the NFL IPR credited the testimony of the NFL’s expert, Dr. Melvin. *See* IPR2018-00463, Paper No. 8 at 11 (citing to Ex. 1004, Declaration of Dr. Melvin), 16 (same), 17 (same). Here, on the other hand, there are significant questions of credibility for Petitioner’s expert, such that the Board should not credit Pinterest’s expert testimony.

E. *Fintiv* factors also support discretionary denial.

The *Fintiv* factors also support discretionary denial of the ’169 patent Petition. Under *Fintiv*, the Board considers a series of factors aimed at deciding whether the goals of efficiency will be met by letting the invalidity analysis proceed through the parallel district court litigation involving the asserted patent,

or whether it would be more efficient for the Board to address the invalidity issues raised. *See Fintiv*, IPR2020-00019, Paper 11 at 6. These factors assess various objective metrics such as comparing the proximity of the court's trial date to the Board's projected statutory deadline for a final written decision, assessing the similarities between what is at issue in both proceedings, and relative investment to date by parties in the district court proceedings, etc. *Id.* More specifically, the Board has considered the following six factors under *Fintiv*: (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (2) proximity of the court's trial date to the Board's projected statutory deadline for a final written decision; (3) investment in the parallel proceeding by the court and the parties; (4) overlap between issues raised in the petition and in the parallel proceeding; (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and (6) other circumstances that impact the Board's exercise of discretion, including the merits. *Fintiv*, IPR2020-00019, Paper 11 at 6.

In this case, the *Fintiv* analysis also weighs in favor of discretionary denial, as allowing these proceedings to go forward will result in piecemeal litigation.

Fintiv Factors 1, 4 and 5 – The Petitioner (Pinterest) is the same as the defendant in the district court litigation. *See Ex. 2001*. Pinterest has not requested that the district court stay the proceedings, and likely would not receive a stay even if requested, as Pinterest has only challenged one of the four patents asserted in the

district court litigation. *See, e.g., Tigo Energy Inc. v. SMA Solar Tech. Am. LLC*, No. CV 22-915-GBW, 2024 WL 1637511, at *3 (D. Del. Apr. 16, 2024).

Moreover, Pinterest has raised §102 and §103 defenses in the district court litigation, Ex. 2003 at 103, and Pinterest's *Sotera* stipulation does not foreclose Pinterest's ability to raise substantially similar system art in the district court proceeding. *See* Ex. 2024. By way of example, Pinterest's two main references in the Petition—Beri and Armstrong—relate to ActiveX controls. While invalidity contentions have not yet been served, Patent Owner anticipates that Pinterest will raise prior art ActiveX systems in the district court litigation, rendering the district court effort largely duplicative of the work and analysis that would be conducted by the Board in these proceedings.

Fintiv Factor 2 – the district court has set a trial date of July 12, 2027. *See* Ex. 2004 at 26. This is after the Board's projected deadline to issue a written decision (January 2027), however only by six months. Considering the issues discussed above, this short period of time is insufficient to override the numerous reasons to exercise discretionary denial. *E.g., Irhythm*, Paper 10 at 2-3.

Fintiv Factor 3 – the Patent Owner has already invested significantly in the district court litigation. Patent Owner has been in litigation with Pinterest for approximately ten months, and in that time has defended two motion to dismiss and a motion for judgment on the pleadings. Ex. 2025.

Fintiv Factor 6 – Under the Director’s recent guidance, a strong showing of other factors, such as strong settled expectations and the like, is more than sufficient to merit discretionary denial. *Irhythm*, Paper 10 at 2-3. Due to the exceptionally strong showing of, *inter alia*, settled expectations discussed above, as well as significant credibility issues relating to Pinterest’s proffered expert testimony, discretionary denial is appropriate under the *Fintiv* framework as well.

Furthermore, even if Pinterest were successful in these proceedings, Pinterest’s approach of challenging only one of the four patents at issue in the district court litigation will not result in efficiency. The district court will still be required to assess Pinterest’s §102 and §103 defenses in the context of these other three patents. At bottom, the PTAB will not be able to resolve the overall dispute between the parties. Instead, the parties, the PTAB, and the district court will be engaged in piecemeal litigations on multiple fronts, which is not efficient for anyone. Discretionary denial is therefore appropriate.

CONCLUSION

For the foregoing reasons, discretionary denial is appropriate, and the Director should decline to institute *inter partes* review of the ’169 patent.

IPR2025-01184
Patent No. 7,055,169

Date: September 18, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on September 18, 2025, a copy of this Patent Owner's Discretionary Denial Brief, including all accompanying attachments, appendices, and exhibits, has been served in its entirety via e-mail on Attorneys for Petitioner at the following e-mail addresses:

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