

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIMICRON TECHNOLOGY CORP.,
Petitioner,

v.

IMBERATEK LLC,
Patent Owner

Case: IPR2025-01244

U.S. Patent No. 7,989,944

**BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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Patent No. 7,989,944

Brief in Support of Patent Owner's Request for Discretionary Denial

PATENT OWNER'S EXHIBIT LIST

Description	Exhibit #
February 25, 2020 First Notice Letter	2001
April 7, 2020 Unimicron Response	2002
May 5, 2020 Second Notice Letter	2003
May 29, 2020 Unimicron Response	2004
Article: Apple joins the ranks of SoIC, UNIMICRON to take advantage of it, and simultaneously wins big orders	2005
Apple Supplier List	2006
'944 Patent Transaction History	2007

I. INTRODUCTION

Patent Owner, ImberaTek LLC ("Patent Owner"), respectfully requests that the Director deny institution of the Petition for *Inter Partes* Review filed by Unimicron Technology Corp. (hereinafter "Petitioner" or "Unimicron") challenging the patentability of claims 1-3, 8, 9, 11-26, and 29-31 of the U.S. Patent No. 7,989,944 ("the '944 Patent").

For more than five years, Petitioner did nothing despite having actual notice that its products infringed the '944 Patent. Petitioner consciously chose not to investigate. Only now, after Patent Owner initiated litigation against one of its customers and the patent has expired, has Petitioner filed this *inter partes* review Petition. This Petition is not the "effective and efficient alternative" to litigation Congress envisioned; it is a late-filed, tactical weapon aimed at disrupting Patent Owner's strong and settled expectation in the validity of its patent rights. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017) (precedential).

As set forth below, the Director should exercise discretion and deny institution. A holistic analysis of the discretionary factors weighs in favor of denial, particularly given that the patent has now expired after being in force for fourteen years. Furthermore, Petitioner's delay and its apparent use of the IPR process for licensing gamesmanship, provide additional, independent grounds for denial.

Accordingly, Patent Owner respectfully requests that the Petition be denied in its entirety.

II. BACKGROUND

The '944 Patent issued on August 2, 2011 and expired on May 20, 2025. EX1001. On February 25, 2020, ImberaTek sent a notice letter to Unimicron specifically identifying the '944 Patent. EX2001. Unimicron responded on April 7, 2020 indicating that it needed more information. EX2002. ImberaTek sent a second notice letter on May 5, 2020 again identifying the '944 Patent and further explaining Unimicron's need for a license due to "Unimicron's manufacture and sale of Qualcomm's APQ8064, MSM8974, MSM8994; Samsung's Exynos 4214, 4212 ARM Mobile Application Processors; and Samsung's Exynos 5410 ARM SoC." EX2003. On May 29, 2020, Unimicron responded but again complained that it needed detailed information and again omitted contact information to allow the parties to engage in licensing discussions. EX2004.

On June 24, 2022, ImberaTek filed suit against Samsung Electronics in the Eastern District of Texas asserting the '944 Patent and identifying Samsung Exynos chips as some of the accused products. *ImberaTek LLC v. Samsung Electronics Co., Ltd. et al*, 2-22-cv-00233, Dkt. 1, at 9, 26-32 (E.D. Tex. June 24, 2022). On December 9, 2022, Samsung filed a petition challenging the '944 Patent. *Samsung Electronics Co., Ltd. et al v. ImberaTek LLC*, IPR2023-00323, Paper 1 (PTAB Dec.

9, 2022). The IPR was terminated due to settlement on January 24, 2023 prior to institution. *Id.* at Paper 10 (PTAB Jan. 24, 2023).

On February 5, 2024, ImberaTek filed suit against Apple in the Western District of Texas asserting the '944 Patent. *ImberaTek LLC v. Apple Inc.*, 1-24-cv-00129, Dkt. 1, at 19-21 (W.D. Tex. Feb. 5, 2024). On February 6, 2025, Apple filed a petition challenging the '944 Patent. *Apple Inc. v. ImberaTek LLC*, IPR2025-00578, Paper 1 (PTAB Feb. 6, 2025). On June 4, 2025, the IPR was terminated due to settlement prior to institution. *Id.* at Paper 11 (PTAB June 4, 2025). Unimicron is a known supplier to Apple. *See, e.g.*, EX2005; EX2006, at 23 (Apple Supplier list). Thus, Imberatek's patents have been actively enforced and licensed in the industry putting other industry players on further notice of the patents.

On July 8, 2025, after the patent had expired and after ImberaTek settled with Samsung and Apple, Unimicron filed this Petition.

Consequently, Unimicron has been on notice of ImberaTek's patents since at least the letter dated February 25, 2020 and further information regarding infringement was publicly available through suits initiated on this patent against Samsung and Apple. Nonetheless, it waited more than five years—long enough for the '944 patent to expire—before filing the current IPR.

III. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

The Petition should be denied pursuant to 35 U.S.C. § 314(a) because a holistic review of the circumstances of this proceeding warrant the Director exercising discretion not to institute. Under 35 U.S.C. § 314(a), the Director “is permitted, but never compelled, to institute an IPR proceeding.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016). Moreover, the Director “possesses broad discretion in deciding whether to institute review” and “[i]n making this decision, the Director has complete discretion to decide not to institute review.” *Saint Regis Mohawk Tribe v. Mylan Pharms. Inc.*, 896 F.3d 1322, 1327 (Fed. Cir. 2018). Indeed “[t]he Director bears the political responsibility of determining which cases should proceed” and “[w]hile he/[she] has the authority not to institute review on the merits of the petition, he/[she] could deny review for other reasons such as administrative efficiency.” *Id.*

Further, the *Interim Processes for PTAB Workload Management* (“*Process Memo*”) does not limit discretionary denial to the *Fintiv* factors and lack of a *Fintiv* analysis does not (and cannot) remove the ultimate discretion of the Director in deciding institution. *See Apple Inc. v. Vidal*, 63 F.4th 1, 7, 13 (Fed. Cir. 2023) (“the Director must be able to give guidance in the form of instructions to her delegatee(s)—the Board (or Board panels)—about how to make the institution determinations on her behalf” but “[w]e have also made clear that any institution

decision made by the Board as delegatee of the Director is subject to reversal by the Director”). Moreover, settled expectations have been found enough to warrant discretionary denial. *See Yangtze Memory Techs. Co., Ltd. v. Micron Tech., Inc.*, IPR2025-00498, Paper 11 at 2 (Director Aug. 14, 2025) (finding settled expectations based on patents “in force for approximately ten, six, and six years” weighed in favor of denial where there is no parallel proceeding). Here, multiple additional factors set forth in the *Process Memo* demonstrate that denial is warranted here.

IV. ADDITIONAL FACTORS SET FORTH IN THE MEMORANDUM SUPPORT DISCRETIONARY DENIAL

The *Process Memo* clarifies that the “parties are permitted to address all relevant considerations” and the Director may weigh additional considerations relevant to fairness and efficiency. *Process Memo*, at 2-3. Several such considerations support denying institution here.

A. Settled Expectations

The '944 Patent expired on May 20, 2025, before the Petition was filed, and prior to that it was in force for almost fourteen years. The *Process Memo* notes that “settled expectations of the parties, such as the length of time the claims have been in force” may be considered. *Process Memo*, at 2. The '944 Patent issued in August 2011 and relates to technology covered by a family of patents. The '944 Patent has been assigned throughout its lifespan, and all required maintenance fees have been paid, showing an intent to keep the patent alive and enforce. The '944 Patent expired

on May 20, 2025, after Patent Owner had paid for the full term of the patent, and the '944 Patent was in effect for the full term before this Petition was filed. EX2007 (showing maintenance fee payment history). Between grant of the patent and expiration, the patent was in force for almost fourteen years. **This alone weighs in favor of denial because of the strong settled expectations surrounding the '944 Patent.** *See, e.g., Coretronic, Corp. v. Maxell, Ltd.*, IPR2025-00474, IPR2025-00476, IPR2025-00477, Paper 11, at 2 (PTAB Jul. 10, 2025) ("Furthermore, the challenged patents have been in force for approximately eight, twelve, and fifteen years, creating strong settled expectations, . . ."); *see Samsung Elecs. Co. v. GenghisComm Holdings, LLC*, IPR2025-00780, Paper 11, at 2 (PTAB Aug. 14, 2025) ("the challenged patents have been in force for approximately eight and six years, creating strong settled expectations for Patent Owner, and Petitioner does not provide any persuasive reasoning why an inter partes review is an appropriate use of Board resources.").

In addition, Petitioner was aware of the '944 Patent for over five years prior to the filing of the Petition, as ImberaTek sent notice letters regarding the '944 Patent in February and May of 2020. EX2001; EX2003. This history contributes to settled expectations regarding the patent's validity. *See, e.g., Google LLC v. Soundclear Technologies LLC*, IPR2025- 00344, Paper 15, at 2-3 (PTAB Aug. 4, 2025) (finding strong settled expectations of the patent owner based on a ten-year-old patent, and

Petitioner's knowledge of the patents for six years even though the parallel litigation was stayed).

The Board has repeatedly recognized the importance of a patent owner's "settled expectations" in its discretionary denial analysis. The Board is often disinclined to disturb the settled rights of a patent owner where a patent has been in force for many years and a petitioner, despite being aware of the patent or technology, delayed its challenge. *See, e.g., Murata Mfg. Co. v. Georgia Tech Rsch. Corp.*, IPR2025-00383, Paper 13, at 2–3 (PTAB July 29, 2025) (denying institution on a 16-year-old patent where petitioner had long awareness of the technology); *Amazon.com, Inc. v. Audio Pod IP, LLC*, IPR2025-00757, Paper 15 at 2–3 (PTAB Aug. 14, 2025) (denying institution based on petitioner's decade-long awareness of the patent portfolio). Patent Owner's settled expectations in this case are strong, given Petitioner's five-year delay after being put on notice of the patent, a suit against one of its customers asserting this patent, and the patent having been in force for almost fourteen years prior to expiring in May of this year. The PTAB should follow its own recent precedent and respect the parties' and Board resources by denying institution.

Settled expectations can also be shown through "an extraordinary amount of investment, time, and resources dedicated to research, development, trials, and regulatory approval." *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601,

Paper 9 at 2 (PTAB July 24, 2025). Here, the '944 Patent was in force for almost fourteen years; maintenance fees were paid through the last required period; and Patent Owner invested in prosecution, enforcement, and licensing efforts—including multiple notice letters, litigations against Apple and Samsung, and resolutions of those matters—further reinforcing settled expectations surrounding the patent's validity and value. Accordingly, these considerations also weigh heavily in favor of denial under § 314(a).

B. Patent Expiration and Efficient Resource Allocation

The *Process Memo* states that discretionary denial decisions will consider factors bearing on the efficient use of PTAB resources and overall workload management. **Instituting review of the '944 Patent, which is expired, presents a clear case of inefficiency warranting denial.** The institution decision in this matter is anticipated around January 2026, at which point the patent will have been expired for seven months. Proceeding with an IPR on an expired patent is a demonstrably inefficient use of the Board's and the parties' resources.¹ While the Director clearly

¹ While there is still a claim for past damages attributable to infringing the '944 Patent through a district court case, the limited nature of that dispute does not justify expending the Board's resources on a review of the '944 Patent here.

has jurisdiction to do so in its discretion, committing substantial Board and party resources to adjudicate this patent under these circumstances is contrary to the goals of improving PTAB efficiency and managing workload, as highlighted in the *Process Memo*. There is also little potential benefit to the industry or the public at large in the PTAB reviewing a patent that expired. The '944 Patent subject matter is already available to the public. Referring the IPR to a panel and allowing institution of review here is thus unlikely to expand the industry's freedom to operate in this space more than already exists and, as a result, it does not promote the legislative purpose of IPRs. *See Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, 28 F.4th 1371, 1381 (Fed. Cir. 2022) ("the basic purpose of IPR proceedings... [is] to reexamine an earlier agency decision and ensure 'that patent monopolies are kept within their legitimate scope.'").

This alone warrants discretionary denial.

C. Petitioner's Undue Delay and Gamesmanship

Petitioner's gamesmanship is evidenced by its strategic five-year delay in challenging the '944 Patent. Petitioner first received notice of the patent in March 2020, but this inaction was a conscious decision as it sat and waited while ImberaTek litigated against its customer, Apple.

Instead of investigating Patent Owner's claims, Petitioner waited five years, holding these invalidity challenges in reserve and waiting to see how the matter

progressed against Samsung and Apple. It only filed this Petition on July 8, 2025—after Patent Owner settled its disputes with Samsung and Apple and after the patent had expired. Notably, the notice letters to Unimicron listed numerous patents. The suits against Samsung and Apple asserted six and nine patents respectively. Yet, Unimicron only filed IPRs on the '944 Patent and U.S. Patent 8,368,201. Any resolution on these two patents does not negate Unimicron's need for a license to the remaining patents identified in ImberaTek's letters. This conduct is based in gamesmanship.

There are no other actions pending involving the two patents Unimicron challenges here, and every other case involving these patents was resolved through a resolution between the parties involved. Indeed, Petitioner is holding out in reaching resolution with ImberaTek (as demonstrated by the lack of meaningful licensing negotiations), and while it is certainly allowed to contest the patents, it should not tie up substantial resources of the Board just to resolve this private dispute with ImberaTek over the terms needed to reach a license agreement.

This pattern of conduct is compelling evidence that this Petition is a tactic for disrupting the licensing discussions and weighs strongly in favor of discretionary denial.

D. Petitioner's Reliance on Expert Testimony

Significant portions of Dr. Baker's declaration mirror the Petition's language, restating arguments and assertions made by Petitioner's counsel often nearly verbatim, without offering sufficient independent analysis, supporting data, or reasoning grounded in specific evidence beyond the Petition's own assertions.

For example, the entirety of Ground 1 in the Petition and the corresponding section of Dr. Baker's declaration are almost identical.

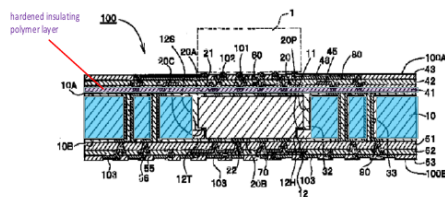
Petition

If the preamble is deemed limiting, Ogawa teaches a *circuit board*. EX-1002, ¶50. For example, Ogawa describes “a wiring board” 100 comprising a “core board main body 10” in which capacitor 20 is embedded. EX-1006, Title, Abstract, [Claim 1]-[Claim 14], [00043]-[0045], [0052], [0054], [0056], [0063], [0065], [0066], [0069]-[0073], [0086], [0097], [0104] [0005]-[0007], [0017], [0020], [0023]-[0025], [0066], [0068], [0106], [0108], FIGS. 6, 10-12. Core board main body 10 is made of “a glass-epoxy resin composite material” *Id.*, [0044], [0063], [0066], [0067], [0088], [0097]; EX-1002, ¶50.

Ogawa's disclosure of suitable material for core board main body 10 is thus just like the '944 patent's description for its “baseboard 1 is selected for the circuit-board manufacturing process,” such as “a glass-fibre reinforced epoxy board.” EX-1001, 3:46-55, Cl. 9; EX-1002, ¶51.

Accordingly, through Ogawa's disclosure of “wiring board” comprising “core board main body 10” to incorporate IC chips, Ogawa provides [1pre].

Ogawa's core board main body 10, as it is adjacent to insulation layer 41 and 51 made of insulating material, provides an *insulating material layer*. EX-1006, [0006], [0007], [0009], [0016], [0018], [0022], [0024], [0026], [0033], [0042], [0043], [0049], [0050], [0072], [0078]-[0083], [0085], [0087], [0090], [0096], [0098], [0103], [0105], FIG. 12; EX-1002, ¶53. Ogawa's core board main body 10 contacts insulating layers 41 and 51 at 51 (*first side*) and at 41 (*second side*). EX-1002, ¶53.



EX-1002, ¶53 (EX-1006, FIG. 1 (Annotated))

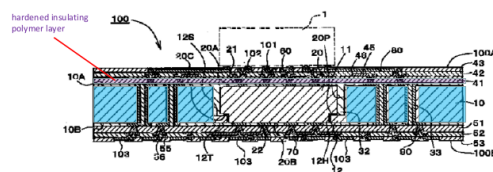
Baker Decl. (EX-1002)

50. In my opinion, if the preamble is deemed limiting, Ogawa teaches a *circuit board*. For example, Ogawa describes “a wiring board” 100 comprising a “core board main body 10” in which capacitor 20 is embedded. EX-1006, Title, Abstract, [00043]-[0045], [0052], [0054], [0056], [0063], [0065], [0066], [0069]-[0073], [0086], [0097], [0104] [0005]-[0007], [0017], [0020], [0023]-[0025], [0066], [0068], [0106], [0108], FIGS. 6, 10-12. Core board main body 10 is made of “a glass-epoxy resin composite material” *Id.*, [0044], [0063], [0066], [0067], [0088], [0097].

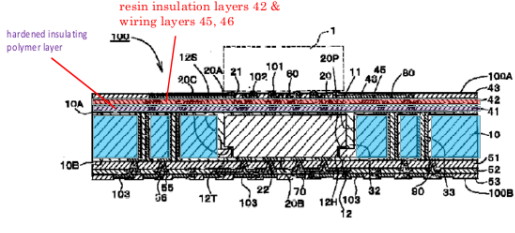
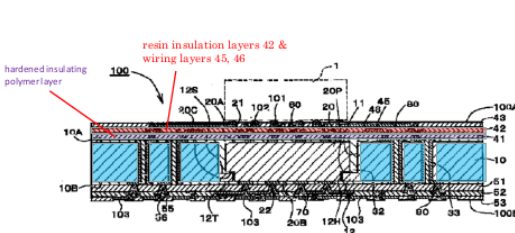
51. In my opinion, Ogawa's disclosure of suitable material for core board main body 10 is thus just like the '944 patent's description for its “baseboard is selected for the circuit-board manufacturing process,” such as “a glass-fibre reinforced epoxy board.” EX-1001, 3:46-55.

52. Accordingly, through Ogawa's disclosure of “wiring board” comprising “core board main body 10” to incorporate IC chips, Ogawa provides [1pre].

53. In my opinion, Ogawa's core board main body 10, as it is adjacent to insulation layer 41 and 51 made of insulating material, provides an *insulating material layer*. EX-1006, [0006], [0007], [0009], [0016], [0018], [0022], [0024], [0026], [0033], [0042], [0043], [0049], [0050], [0072], [0078]-[0083], [0085], [0087], [0090], [0096], [0098], [0103], [0105], FIG. 12. Ogawa's core board main body 10 contacts insulating layers 41 and 51 at 51 (*first side*) and at 41 (*second side*).



EX-1006, FIG. 1 (Annotated)

Petition	Baker Decl. (EX-1002)
Ogawa's core board main body 10, as it contacts insulating layers 41 and 51, provides an <i>insulating material layer</i>, having a first side (and second side) on the lower (and upper) side, and thus Ogawa discloses [1a] in this second manner. EX-1002, ¶54.	54. To be clear, Ogawa's core board main body 10, as it contacts insulating layers 41 and 51, provides an <i>insulating material layer</i>, having a first side (and second side) on the lower (and upper) side, and thus Ogawa discloses [1a] in this second manner.
Ogawa anticipates Elements [1b]-[1c]. EX-1002, ¶55. For example, Ogawa describes a "wiring layers 45 and 46" that are "made of Cu plating and penetrate the upper resin insulation layers 41 and 42". EX-1006, [0082], Fig. 9(b) ("As a result, as shown in FIG. 9(b), the wiring layers 45, 55 including via portions 45V and 55V in the via holes 41VH and 51VH, that penetrate the resin insulation layers 41 and 51, respectively, and connected to the top surface connection pad 21, the bottom surface connection pad 22, and the like, respectively, are formed and insulated from each other."), [0082], FIG. 9(b); EX-1002, ¶55. The wiring layers 45 and 46 are patterned through photoetching or laser and provide <i>conductive pattern layers</i>. EX-1002, ¶55.	55. In my opinion, Ogawa anticipates Elements [1b]-[1c]. For example, Ogawa describes a "wiring layers 45 and 46" that are "made of Cu plating and penetrate the upper resin insulation layers 41 and 42". EX-1006, [0082], Fig. 9(b) ("As a result, as shown in FIG. 9(b), the wiring layers 45, 55 including via portions 45V and 55V in the via holes 41VH and 51VH, that penetrate the resin insulation layers 41 and 51, respectively, and connected to the top surface connection pad 21, the bottom surface connection pad 22, and the like, respectively, are formed and insulated from each other."), [0082], FIG. 9(b). The wiring layers 45 and 46 are patterned through photoetching or laser and provide <i>conductive pattern layers</i>.
Ogawa's patterned wiring layers 45, 55 are arranged on the two opposite sides of the wiring board, with a portion of the conductor circuit layers 45 (<i>at least one first conductive pattern layer</i>) on the lower side (<i>first side</i>) and another portion of the conductor circuit layers 55 (<i>at least one second conductive pattern layer</i>) on the upper side (<i>second side</i>). <i>Supra</i>, Analysis of Element [1a]; EX-1002, ¶56.  EX-1002, ¶56 (Composite Based on EX-1006, FIG. 1 (Annotated))	56. In my opinion, Ogawa's patterned wiring layers 45, 55 are arranged on two opposite sides of the wiring board, with a portion of the conductor circuit layers 45 (<i>at least one first conductive pattern layer</i>) on the lower side (<i>first side</i>) and another portion of the conductor circuit layers 55 (<i>at least one second conductive pattern layer</i>) on the upper side (<i>second side</i>). <i>Supra</i>, Analysis of Element [1a].  Composite Based on EX-1006, FIG. 1 (Annotated)

The above examples are exemplary and pervade the Baker declaration.

Such parroting of attorney argument diminishes the weight, if any, that should be accorded to the testimony. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 (PTAB Feb. 10, 2023) (precedential) (according “little weight” to

declaration testimony that contains a verbatim restatement of a petition's conclusory assertions without additional supporting evidence or reasoning); *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1340–41 (Fed. Cir. 2020) (affirming Board decision giving no weight to expert testimony that “merely repeated Petitioner's argument, nearly verbatim, without citation to the basis for his testimony”); *see also Wowza Media Sys., LLC v. Adobe Sys. Inc.*, IPR2013-00054, Paper 12 at 12 (PTAB Apr. 8, 2013) (“The Declaration . . . appears, for the most part, simply to track and repeat the arguments for unpatentability presented in the Petition [and] . . . is therefore no more helpful tha[n] the Petition in determining where the challenged recitation is found in the references.”). This practice raises concerns under 37 C.F.R. § 42.65(a). *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”).

Accordingly, Petitioner's improper use of expert testimony further supports discretionary denial under 35 U.S.C. § 314(a).

V. CONCLUSION

These additional factors, highlighted by recent USPTO guidance, provide independent bases for the Director to exercise discretion and deny institution of this IPR petition. For at least the foregoing reasons, the Director should deny institution of the Petition.

Patent No. 7,989,944

Brief in Support of Patent Owner's Request for Discretionary Denial

Dated: September 17, 2025

Respectfully submitted,

/James A. Fussell Reg No 54885 /

James A. Fussell, III

Registration No. 54,885

Mayer Brown LLP

1999 K Street NW

Washington, D.C. 20006

Telephone: 202-263-3000

Facsimile: 202-263-3300

jfussell@mayerbrown.com

Amanda S. Bonner

Registration No. 65,224

Mayer Brown LLP

71 S. Wacker Drive

Chicago, IL 60606

Telephone: 312-782-0600

Facsimile: 312-706-8157

asbonner@mayerbrown.com

Cliff A. Maier

Registration No. 59,526

Mayer Brown LLP

Two Palo Alto Square, Suite 300

Palo Alto, CA 94306

Telephone: 650-331-2000

cmaier@mayerbrown.com

Attorneys for ImberaTek

Patent No. 7,989,944

Brief in Support of Patent Owner's Request for Discretionary Denial

CERTIFICATE OF SERVICE

I hereby certify that on this 17th day of September, 2025, a copy of the attached BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 7,989,944, together with all exhibits was served by electronic mail to the attorneys of record, at the following addresses:.

Mainak H. Mehta (Reg. No. 46924)

miku.mehta@procopio.com

Ali Uyanik (Reg. No. 67080)

ali.uyanik@procopio.com

Robert Sloss

robert.sloss@procopio.com

Respectfully submitted,

Date: September 17, 2025

By: /James A. Fussell Reg No 54885/
James A. Fussell (Reg. No. 54,885)