UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIANTIC INC.,

Petitioner,

v.

IMAGINEAR, INC.,

Patent Owner.

IPR2025-01273
Patent No. 11,666,827

PATENT OWNER'S BRIEF IN SUPPORT OF DISCRETIONARY DENIAL

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PATENT OWNER EXHIBIT LIST

Exhibit	Description of Exhibit
EX2001	November–December 2018, Email Chain between Shaun MacDonald of Extreme Venture Partners and Vikram Grover and Omar Tellez of Niantic, copying Ron Laurie of Inflexion Point Strategy (IPS1-7) ("Patent Acquisition Proposal to Petitioner") [UNDER SEAL]
EX2002	Declaration of Alen Paul Silverrstieen ("Silverrstieen Decl.")
EX2003	Inflexion Point Strategy Patent Acquisition Opportunity Summary
EX2004	*ImagineAR, Inc. v. Niantic, Inc*., No. 1:24-cv-01252-JDW (D. Del.), D.I. 63, Sept. 8, 2025 ("DC 101 Op")
EX2005	Docket for *ImagineAR, Inc. v. Niantic, Inc*., No. 1:24-cv-01252-JDW (D. Del.) ("Litigation Docket")
EX2006	*ImagineAR, Inc. v. Niantic, Inc*., No. 1:24-cv-01252-JDW (D. Del.), D.I. 41-1, May 9, 2025 ("Agreed Schedule")
EX2007	*ImagineAR, Inc. v. Niantic, Inc*., No. 1:24-cv-01252-JDW (D. Del.), D.I. 48, June 4, 2025 ("Protective Order")
EX2008	*ImagineAR, Inc. v. Niantic, Inc*., No. 1:24-cv-01252-JDW (D. Del.), D.I. 68, Sept. 12, 2025 ("Order on Mot. to Compel")
EX2009	Compendium of Subpoenas served in *ImagineAR, Inc. v. Niantic, Inc*., No. 1:24-cv-01252-JDW (D. Del.)
EX2010	*ImagineAR, Inc. v. Niantic, Inc*., No. 1:24-cv-01252-JDW (D. Del.), D.I. 75, Sept. 17, 2025 ("Order on Letter Rogatory")
EX2011	Petitioner's Motion to Quash PO's Subpoena to ("Mot. to Quash")
EX2012	Patent Owner's Infringement Contentions Cover Document
EX2013	Petitioner's Invalidity Contentions Cover Document
EX2014	Declaration of Erik M. Bokar ("Bokar Decl.")
EX2015	September 3, 2025, Email and Letter from Petitioner's Counsel to Patent Owner's Counsel regarding Case Narrowing, ("9/3/2025 Case Narrowing Email")
EX2016	August 22, 2025, Letter from Petitioner's Counsel to Patent Owner's Counsel ("8/21/25 Ltr.")
EX2017	June 5, 2025, Patent Owner's Third Set of Requests for Production to Petitioner in Litigation ("PO's 3rd RFPs")
EX2018	September 15, 2025, Petitioner's Responses and Objections to Patent Owner's 3rd Set of Interrogatories ("Pet.'s Resp. to ROG 16")

I. INTRODUCTION

Patent Owner ImagineAR, Inc. ("PO") respectfully requests that the Director exercise her discretion to deny institution under 35 U.S.C. § 314(a) because PO has settled expectations in the challenged patents given Petitioner Niantic, Inc.'s ("Petitioner's") years-long awareness of the patents and choice not to pursue earlier patentability attacks—an awareness that Petitioner has deliberately concealed in the pending litigation despite PO's numerous and longstanding discovery requests.

The litigation between the parties in the District of Delaware (the "Litigation") is well advanced and that also supports denial. It would waste Board resources to review the same invalidity issues raised in the Litigation, especially since the Litigation is likely to conclude before or on a similar timeline as the IPRs.

The Director should also deny institution because the Petitions are weak and depend almost entirely on expert testimony to fill significant gaps in the prior art.

The remaining *Fintiv* factors also support discretionary denial: (i) the Litigation is not stayed; (ii) the parties have heavily invested in discovery, infringement contentions, invalidity contentions, and claim construction in the Litigation; and (iii) the Petitions recycle the same art and arguments raised in the Litigation and Petitioner has offered a weak *Sotera* stipulation that fails to prevent Petitioner from raising duplicative invalidity challenges.

For these reasons, the Director should deny the Petitions.

II. BACKGROUND

A. Petitioner's IPR Petitions And The Challenged Patents.

On July 14, 2025, Petitioner requested *inter partes* review of U.S. Patent Nos. 10,946,284 (the "'284 patent") (IPR2025-01274), 11,484,797 (the "'797 patent") (IPR2025-01275), 11,666,827 (the "'827 patent") (IPR2025-01273), and 12,070,691 (the "'691 patent," collectively, the "Patents") (IPR2025-01276, collectively, the "Petitions")). The Patents have an effective filing date of November 19, 2012, and share the same specification. (*See* EX1001, [60]; EX1002, [60], [63]; EX1003, [60], [63]; EX1004, [60], [63].) In the Petitions, Petitioner asserts that the Patents' claims are invalid as obvious in view of Kolo (U.S. Patent Appl. Publ. 2012/0244945) or Kolo in combination with Zyda (U.S. Patent Appl. Publ. 2011/0214071).

B. Petitioner's Prior Awareness Of The Patents And Deliberate Concealment Of That Awareness In The Litigation.

In late 2018, patent broker Inflexion Point Strategy ("IPS") offered to sell the application that led to the '284 patent, *i.e.*, U.S. Pat. Appl. No. 15/215,406 (the "'406 Appl.") to Petitioner and PO. (EX2001, Patent Acquisition Proposal to Niantic[1]; EX2002, Silverrstieen Decl., ¶¶ 2-7; EX2003, Inflexion Point Strategy Patent

[1] Petitioner's employees who were involved in the potential purchase of the Patents in 2018 were Mr. Vikram Grover, Petitioner's head of business development and IP and Omar Tellez, Petitioner's VP of strategic partnerships and a member of Petitioner's executive team. (EX2001, Patent Acquisition Proposal to Niantic at 2; *see also* https://www.linkedin.com/in/vikram-grover-97b439/.; https://www.linkedin.com/in/omartellez/.) Patent Owner received EX2001 from IPS in response to a third-party subpoena.

Acquisition Summary.) PO—not Petitioner—took that opportunity and acquired the application that led to the '284 patent (and the rights to the remaining Patents). (EX2002, Silverrstieen Decl., ¶ 8.) Petitioner did not try to invalidate the Patents after it declined to purchase the rights to the application that led to the '284 patent (and the other Patents) from 2018 through July 14, 2025. (IPR2025-1273, Pet. at 94, IPR2025-1274, Pet. at 66, IPR2025-1275, Pet. at 66, IPR2025-1273, Pet. at 97.)

Years later, in early 2023, PO hired patent broker Patent Infusion to put its patent portfolio (including the rights to the Patents) on the market. (EX2002, Silverrstieen Decl., ¶¶ 9-10.) Around March 2023, Patent Infusion emailed Petitioner an email outreach that offered to sell PO's patent portfolio, including the rights to the Patents. (*Id.*) Patent Infusion attached a listing of PO's patents, including the '284 and '797 patents, to its email. (*Id.*) Petitioner did not try to invalidate the Patents after it declined to purchase the rights to the Patents from 2023 through July 14, 2025. (IPR2025-1273, Pet. at 94, IPR2025-1274, Pet. at 66, IPR2025-1275, Pet. at 66, IPR2025-1273, Pet. at 97.)

Petitioner then deliberately concealed its awareness of the Patents in the Litigation. Two of Petitioner's senior level employees had received the offer to purchase the rights to the Patents in 2018. (*See* n. 1, *supra*.) And in June 2025, PO reminded Petitioner of the patent brokers who offered the Patents to Petitioner when PO asked Petitioner about its pre-Litigation knowledge of the Patents. (EX2017,

PO's 3rd RFPs.) Yet, Petitioner recently stated that it was "unaware of any such communications or meetings" about the Patents. (EX2018, Pet.'s Resp. to ROG 16.)

C. The Parallel District Court Litigation Is Well Underway.

On November 13, 2024, PO sued Petitioner in the District of Delaware (the "DC") on seven patents. (*See ImagineAR, Inc. et al. v. Niantic, Inc.*, No. 1:24-cv-01252-JDW (D. Del. Nov. 13, 2024) (*i.e.*, the "Litigation"). (EX1005, Original Complaint.)[2] The case is pending before Judge Wolson.

The parties submitted a Rule 16/26 report and agreed schedule on May 9, 2025. (EX2005, Litigation Docket, D.I. 41; EX2006, Agreed Schedule.) The DC entered an agreed protective order on June 4, 2025. (EX2007, Protective Order.) Fact discovery in the Litigation is well underway. Since March 2025, the parties have served and responded to extensive written discovery. (EX2005, Litigation Docket, D.I. 32, 36, 37, 38, 40, 45, 49, 50, 52, 53, 55, 58, 59, 67.) The parties have already produced tens of thousands of pages of documents, (EX2014, Bokar Decl., ¶¶ 5-6), and the DC recently ordered Petitioner to produce additional critical documents and information by the end of September 2025 (EX2008, Order on Mot. to Compel). The parties have also engaged in wide-ranging third-party discovery, serving more than a dozen subpoenas and seeking a letter rogatory. (EX2009,

[2] The DC issued a decision on the merits when it invalidated three patents under 35 U.S.C. § 101, leaving only the Patents in the Litigation. (EX2004, DC 101 Op.)

Compendium of Subpoenas; EX2010, Order on Letter Rogatory.) Petitioner recently moved to quash a subpoena in the Eastern District of Virginia. (EX2011, Mot. to Quash.) As a result, a forum beyond the DC is also involved in the parties' dispute.

The parties have also exchanged extensive infringement and invalidity contentions for the Patents. (EX2012, Infringement Contentions Cover Document; EX2013, Invalidity Contentions Cover Document; EX2014, Bokar Decl., ¶¶ 7-12.) Petitioner's invalidity contentions raise Section 101 and 112 invalidity issues and non-publication prior art. (EX2013, Invalidity Contentions Cover Document.) The claim construction process has started and is set to conclude by January 9, 2026. (EX2006, Agreed Schedule.) By the end of 2026, the DC will have held a claim construction hearing, issued a claim construction opinion, and taken the Litigation through expert discovery, summary judgment, and *Daubert* motions. (*Id.*) Petitioner has not requested a stay. (EX2005, Litigation Docket.)

Almost nine months after PO filed the Litigation, Petitioner filed its Petitions. All of the prior art raised in the Petitions is included in Petitioner's invalidity contentions in the Litigation. (EX2012, Invalidity Contentions Cover Document.) Institution decisions ("IDs") should issue by January 21, 2026, and final written decisions ("FWDs"), if necessary, by January 21, 2027.

III. LEGAL STANDARDS

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."). The Director should deny institution when it does not align with the AIA's objective "to provide an effective and efficient alternative to district court litigation." *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (Sept. 6, 2017) (precedential).

The Director takes "a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (Mar. 20, 2020) (precedential) (citing *NHK Spring Co. v. Interi-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (Sept. 12, 2018)) (precedential).) When determining whether to exercise her discretion to deny institution under 35 U.S.C. § 314, the Director considers six factors: (i) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (ii) proximity of the court's trial date to the Board's projected statutory deadline for a final written decision; (iii) investment in the parallel proceeding by the court and the parties; (iv) overlap between issues raised in the petition and in the parallel proceeding; (v) whether the petitioner and the defendant in the parallel proceeding are the same party; and (vi) other circumstances that impact the Board's exercise of discretion, including the merits. *Fintiv*, IPR2020-00019, Paper 11 at 6.

IV. ARGUMENT

The Director should deny institution because PO has settled expectations in the Patents, the Litigation is well advanced and it would be a waste of Board resources to review the same invalidity issues Petitioner raised in the Litigation, the Litigation is likely to conclude before or on a similar timeline as the IPRs, the Petitions are weak on the merits and depend almost entirely on expert testimony to fill significant gaps in the prior art, and the remaining *Fintiv* factors favor denial.

A. PO Has Settled Expectations, And The Other Considerations Favor Denial (*Fintiv* Factor 6).

1. PO Has Strong Settled Expectations.

PO's settled expectations in the Patents weigh heavily against the Board reviewing the patentability of the Patents because Petitioner knew of the Patents for years yet chose not to act until now. Strong settled expectations exist when a petitioner becomes aware of a patent and fails to challenge it. *See Belden, Inc. v. Commscope, Inc.,* IPR2025-00833, Paper 13 (Sept. 12, 2025) (denying institution; petitioner aware of the patent since 2022); *Geotab Inc. v. Fractus, S.A.*, IPR2025-00928, Paper 11 (Sept. 12, 2025) (denying institution; petitioner aware of the patent since 2021); *Google, Inc. v. SoundClear Techs., Inc.,* IPR2025-00345, Paper 12 at 2-3 (Aug. 4, 2025) (denying institution; petitioner aware of the patent since 2019); *Nvidia Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18 at 2-3 (July 31, 2025) ("actual notice of the challenged patents [learned from a presentation] and

Petitioner's failure to seek early review of the patents favors denial.").

Here, Petitioner received actual notice of the Patents ***seven years ago*** when a third-party patent broker approached Petitioner in 2018 with an offer to purchase the rights to the application that led to the '284 patent and the other three Patents. (EX2001, Patent Acquisition Proposal to Niantic; EX2002, Silverrstieen Decl., ¶ 7; *see also* EX2003, Inflexion Point Strategy Patent Acquisition Summary.) Petitioner did not acquire the rights to the Patents at that time. Instead, PO did. (EX2002, Silverrstieen Decl., ¶ 8.) In 2023, PO hired a patent broker that contacted Petitioner with a second offer to purchase the rights to the Patents. (EX2002, Silverrstieen Decl., ¶¶ 9-10.) Petitioner again declined to purchase the rights to the Patents. Despite Petitioner's knowledge of, and familiarity with, the Patents and their obvious relevance to Petitioner's commercial products,[3] Petitioner failed to challenge the patentability of the Patents ***from 2018 through July 14, 2025.***

That history—two clear opportunities to acquire rights to the Patents and two deliberate decisions to walk away without purchase or challenge—reinforces that PO was entitled to rely on Petitioner's inaction and develop settled expectations for the Patents. It would also be unfair ***not*** to treat PO's expectations in the Patents as

[3] The Board is more likely to find settled expectations when the challenged patents are directly relevant to a petitioner's technology space. *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, No. IPR2025-00377, Paper 10 (June 6, 2025); *Murata Manf., Co. Ltd. v. Georgia Tech. Res. Corp.*, IPR2025-00383, Paper 14 at 2-3 (July 29, 2025).

settled given Petitioner's deliberate attempt to conceal its knowledge of the Patents from PO, the DC in the Litigation, and the PTAB. (*See* § II.B., *supra*.) The Director should deny institution for this reason alone.

PO also has strong settled expectations in the '284 patent because it issued nearly five years ago and published nine years ago. Settled expectations begin to develop as early as patent publication. *See Dabico Airport Solutions, Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (June 18, 2025) ("patent applications (after 18 months) and issued patents are almost always publicly available to provide notice to the public, other inventors, competitors, and commercial interests. 35 U.S.C. § 122. … As such, actual notice of a patent or of possible infringement is not necessary to create settled expectations."); *iRhythm Techs., Inc. v. Welch Allyn, Inc*., No. IPR2025-00377, Paper 10 at 3 (June 6, 2025) ("Petitioner's awareness of Patent Owner's applications and failure to seek early review of the patents favors denial"); *Amgen Inc. v. Bristol-Myers Squibb Company*, IPR2025-00601, Paper 9 (July 24, 2025) (patents in force at least three years may have settled expectations). The '284 patent published on November 10, 2016, and issued on March 16, 2021. (EX1001, [45], [65].) At no point did any party challenge the validity of the '284 patent until Petitioner did. Through the passage of time, PO has developed settled expectations in the '284 patent, which also supports denial.

Denial for the remaining Patents is also appropriate in view of the settled expectations PO has developed in the '284 patent and any related applications and patents. Where settled expectations exist for a patent, it would be inefficient to institute on younger, related patents also at issue in a parallel proceeding. *See Samsung Elecs. Co., Ltd. v. iCashe, Inc.*, IPR2025-00639, Paper 11 at 3 (Aug. 14, 2025) (denying review of a family of patents because earlier, related patents developed settled expectations). The Patents are all related, share the same specification, and are all asserted in the Litigation. (EX1002, [63], EX1003, [63], EX1004, [63].) The settled expectations that PO has developed in the '284 patent favor denial for that patent and the other Patents because instituting solely on the other Patents would mean litigating invalidity for related patents in two forums. As discussed below, this is an inefficient use of resources.

Moreover, the commercial realities of how patents are enforced and licensed favors extending PO's settled expectations in the '284 patent to the other related Patents. Participants often treat patent families as a unit when making enforcement and licensing decisions. Extending settled expectations to an entire patent family better reflects commercial reality, promotes stability, and prevents entities like Petitioner from exploiting continuations to evade the very reliance interests the

doctrine of settled expectations is designed to protect.[4] The Director should deny institution for these reasons too.

2. Institution Would Unnecessarily Burden The Board And Inefficiently Use Board Resources.

Institution would also be an inefficient use of Board resources and unnecessarily burden the Board because the four Petitions challenge many more claims than the DC will address in the Litigation. The purpose of discretionary denial is to "allay[] concerns about inefficiency and duplication of efforts." *Fintiv*, Paper 11 at 6. Here, Petitioner challenges 112 total claims. Meanwhile, in the Litigation, Petitioner is pressing PO to narrow the case and "elect 18 claims across no more than 3 patents." (EX2015, 9/3/25 Email and Ltr. re: Case Narrowing.) As such, if the Board institutes the Petitions and the DC narrows the Litigation to 18 claims across three patents, the Board would waste resources determining the patentability of over 90 claims and at least one patent not at issue in the Litigation. Determining the patentability of nearly 100 claims not at issue in a parallel proceeding is an unnecessary burden to place on the Board and favors denial.

3. Petitioner's Unpatentability Challenge Is Weak.

A weak unpatentability challenge favors denial. (*See* March 24, 2025, Interim Procedure Memorandum.) PO's forthcoming Preliminary Responses will confirm

[4] *See Transcore v. Elec. Trans. Consultants Corp.,* 563 F.3d 1271 (Fed. Cir. 2009).

the absence of a reasonable likelihood that any of the claims is unpatentable. (*See* Interim Processes FAQ No. 25 ("Notwithstanding the prohibition on incorporation by reference in 37 C.F.R. §42.6(a)(3), when filing a brief for discretionary denial, a patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits.").) For instance, Petitioner presents a weak, single-reference obviousness challenge for most of the claims that uses expert testimony to try to fill clear gaps in the prior art. (*See* § IV.A.4, *infra.*) This supports discretionary denial under 35 U.S.C. §314(a). *See Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10–11 (Nov. 7, 2018) (failing to present grounds that had a reasonable likelihood of prevailing for most claims); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 at 41–43 (Jan. 24, 2019) (same).

4. The Petitions Rely Heavily On Expert Testimony To Fill Gaps In The Prior Art.

Discretionary denial is appropriate because the Petitions rely heavily on expert testimony to fill gaps in the prior art. Expert testimony is not a substitute for patents and printed publications, and the Director should deny institution where a petition improperly relies on expert testimony to fill gaps in the prior art. (*See, e.g.*, Consolidated Trial Practice Guide, PTAB, at 34-36 (Nov. 2019)); *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15-16 (Aug. 24, 2022) (precedential); *see also Jiangsu Sainty Sumex Tools Corp. Ltd. v. Milwaukee Elec. Tool Corp.*, IPR2021-00373, Paper 19 at 26 (July 6, 2021).

Here, Petitioner asserts only one ground against the sole independent claim of each Patent: single-reference obviousness over Kolo. (Petition at 1.) Petitioner repeatedly relies on only expert testimony to attempt to establish at least the following limitations that Petitioner concedes are missing from Kolo:

- "storing the real world player geographic location in the storage [means / memory]." (IPR2025-1274, Pet. at 23; IPR2025-1275, Pet. at 23; IPR2025-1273, Pet. at 28-29; IPR2025-1276, Pet. at 31.)
- "[creating in / retrieving from] a database a local element script associated with the real world player geographic location." (IPR2025-1274, Pet. at 24-28; IPR2025-1275, Pet. at 24-28; IPR2025-1273, Pet. at 29-39; IPR2025-1276, Pet. at 32-42.)
- "retrieving from the database mapping information related to the real world player geographic location of the player." (IPR2025-1274, Pet. at 31; IPR2025-1275, Pet. at 31-32; IPR2025-1273, Pet. at 43; IPR2025-1276, Pet. at 47.)
- "actuating the [corresponding] local element script … and not actuating the [corresponding] local element script." (IPR2025-1274, Pet. at 32-33; IPR2025-1275, Pet. at 33; IPR2025-1273, Pet. at 46-47; IPR2025-1276, Pet. at 50-51.)

Petitioner's overreliance on expert testimony to fill prior art gaps favors denial.

B. The Litigation Has Not Been Stayed (*Fintiv* Factor 1).

Fintiv Factor 1 favors denial because Petitioner has not requested a stay of the Litigation, and the Litigation is not stayed. *See Phison Electronics Corp. v. Vervain, LLC,* IPR2024-00213, Paper 14 at 3 (July 10, 2025). Far from being stayed, the parties are actively pursuing discovery, the DC has already issued several substantive rulings, and claim construction proceedings are underway. (*See* §§ IV.C-D, *infra*.)

C. The Trial Date Is Likely To Be Scheduled Earlier Than Or At The Same Time As The Final Decisions Deadline (*Fintiv* Factor 2).

Factor 2 favors denial because the Litigation trial date is likely to be scheduled before or at the same time as the projected FWD deadlines. Factor 2 favors denial when the trial date falls before or near the statutory FWD deadline. *Nvidia Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 16 (July 31, 2025); *Fintiv*, Paper 11 at 9.

According to the parties' agreed schedule, the trial date is likely to be scheduled before the January 21, 2027, FWD deadline. (EX2006 Agreed Schedule.) The parties will complete claim construction briefing by January 9, 2026. (*Id.*, 5-6.) The DC typically holds a claim construction hearing within two months after claim construction briefing and issues claim construction orders within one month of the hearing. *See, e.g.*, *Microchip Technology, Inc. v. Aptiv Services US, LLC*, No. 1:23-cv-00778-JDW, D.I. 25, D.I 125 (D. Del.); *Aptiv Technologies AG v. Microchip Technology, Inc.*, 1:23-cv-00307, D.I. 34, D.I. 201 (D. Del.); and *L2 Mobile Technologies LLC v. TCL Electronics Holdings Limited*, 1:22-cv-01306, D.I. 39, D.I 87 (D. Del.). Thus, the DC will likely issue a claim construction order no later than April 1, 2026. Applying the agreed schedule, the likely remaining deadlines are:

Event	**Estimated Date**
Final Infringement Contentions	April 22, 2026
Final Invalidity Contentions	May 13, 2026
Opening Expert Reports	June 3, 2026
Complete Expert Discovery	July 29, 2026
Dispositive and *Daubert* Motions	September 9, 2026

Dispositive motion briefing will likely be complete by October 21, 2026, (assuming 28 days to respond and 14 days to reply), and the DC typically sets a trial date within three months of dispositive and *Daubert* motion briefing. *See, e.g.*, *Microchip Technology Inc. v. Aptiv Services US LLC*, 1:17-cv-01194-JDW, D.I. 284. That places the trial date on or before January 2027. Because the trial date in the Litigation is likely to be scheduled before the FWD deadline (*i.e.*, January 21, 2027) or around the same time as the FWD deadline, this factor favors denial.

D. The Court And The Parties Have Invested Significantly In The Parallel Litigation (*Fintiv* Factor 3).

The DC's heavy investment in the Litigation favors denial. *See Formycon AG v. Regeneron Pharma., Inc.*, IPR2025-00223, Paper 15 at 13-17 (June 2, 2025) (issuing substantive orders shows significant investment). The DC has already issued several substantive opinions. First, the DC issued an opinion invalidating three unrelated patents, (EX2004, DC 101 Op.), and another order regarding PO's request to issue a letters rogatory to a Japanese company (EX2010, Order on Letter Rogatory). The DC also recently granted PO's motion to compel discovery and ordered Petitioner to supplement its document production and interrogatory responses by the end of September 2025. (EX2008, Order on Mot. to Compel.) These orders reflect the DC's active engagement and investment in the Litigation.

This factor also favors denial because Petitioner and PO have heavily invested in the Litigation. *See Fintiv II*, Paper 15 at 15 (exchanging detailed contentions,

multiple rounds of written discovery, and completing claim construction briefing is heavy investment); *see also Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 4 (Mar. 28, 2025) ("serv[ing] extensive infringement and invalidity contentions, . . . [and] fil[ing] claim construction briefs" is heavy investment).

First, the parties have conducted significant patent-related discovery. The parties have exchanged extensive infringement and invalidity contentions. (EX2012, Infringement Contentions Cover Document; EX2013, Invalidity Contentions Cover Document; EX2014, Bokar Decl., ¶¶ 7-12.) PO's infringement contentions span over 650 pages. (EX2014, Bokar Decl., ¶ 8.) Petitioner's invalidity contentions identify 84 prior art references, include 48 invalidity charts, and span over 5,000 pages. (EX2013, Invalidity Contentions Cover Document; EX2014, Bokar Decl., ¶¶ 9-11.) By January 21, 2026, ID deadline, the parties will have completed claim construction briefing and a claim construction hearing will be imminent. (*See* § IV.C, *supra*.; EX2006, Agreed Schedule.)

Second, the parties have served multiple sets of written discovery requests and responses and will have completed nearly a year of fact discovery by the ID. (EX2005, Litigation Docket, D.I. 32, 36, 37, 38, 40, 45, 49, 50, 52, 53, 55, 58, 59, 67.) PO has produced over 5,000 pages of documents, Petitioner has produced 25,000 pages of documents, and the parties have collectively served over a dozen subpoenas on third party inventors, patent brokers, and law firms. (*See* EX2014,

Bokar Decl., ¶¶ 5-6; EX2009, Compendium of Subpoenas.) Petitioner also recently moved to quash a third-party subpoena in another jurisdiction, which will require a second district court (E.D. Va.) to invest in the Litigation. (EX2011, Mot. to Quash.)

The DC's and the parties' investment in this case will accelerate in the coming months, which further favors denial. By the Board's projected January 21, 2027, FWD deadline, the DC will have already issued its claim construction opinion. (*See* § IV.C, *supra*.; EX2006 Agreed Schedule.) In addition, fact and expert discovery will have closed, the DC will have decided dispositive motions, and the jury trial will be complete or imminent. (*See* § IV.C, *supra*.; EX2006, Agreed Schedule.)

That Petitioner waited over eight months to file its Petitions after PO sued also favors denial. (*See* EX1005, Original Complaint.) A delay in filing a petition favors discretionary denial, particularly "if the petitioner cannot explain the delay." *Fintiv*, IPR2020-00019, Paper 11 at 12; *Ericsson, Inc. v. Procomm Int'l PTE. Ltd.,* IPR2024-01455, Paper 15 at 2 (May 16, 2025). Here, PO filed the Litigation on November 13, 2024. (EX1005, Original Complaint.) Petitioner did not file its Petitions until July 14, 2025. (*See generally* Petitions.) Petitioner provides no explanation for its delay. Because additional resources will be invested before the Board's ID due to Petitioner's delay, denial is also warranted.

E. The Significant Overlap Between Issues Raised In The Petition And In The Litigation Heavily Favors Denial (*Fintiv* Factor 4).

Fintiv Factor 4 heavily favors denial because Petitioner challenges the same

patents and claims with the same prior art in each of the IPRs and in the DC. A petition that "includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding" favors denial. *Fintiv*, IPR2020-00019, Paper 11 at 12. Petitioner is asserting the same prior art—Kolo and Zyda—and the same invalidity arguments in both forums. (*See* EX2013, Invalidity Contentions Cover Document.)[5] Petitioner's multi-forum reliance on Kolo and Zyda introduces a risk of inconsistent outcomes because the Board and the DC would consider the same validity challenges based on the same evidence.

Fintiv Factor 4 also weighs in favor of denial because Petitioner's *Sotera* stipulation, (EX1050,) is weak and does not ensure that any IPR proceeding would avoid duplicative efforts and inconsistencies for at least two reasons. ***First***, Petitioner's invalidity contentions include combinations of the asserted art, *i.e.*, Kolo and Zyda, with other system art, "which Petitioner's stipulation is not likely to moot." *See Motorola*, Paper 19 at 4. A *Sotera* stipulation does not guarantee that an IPR would be a "true alternative" to the district court proceeding where system art is asserted in the district court. *Motorola*, Paper 19 at 2-4; *see also Ingenico Inc. v. IOENGINE, LLC,* 136 F.4th 1354, 1366 (Fed. Cir. 2025). Here, Petitioner's *Sotera* stipulation merely precludes it from raising in the Litigation prior art grounds it

[5] Petitioner's invalidity contentions for Kolo and Zyda in the DC span ***over 750 pages***. (EX2014, Bokar Decl., ¶11); *see Fintiv II*, Paper 15 at 15.

raised or reasonably could have raised in the IPRs. However, Petitioner's invalidity contentions identify 16 different prior art systems relevant to the Patents that cannot be raised in IPRs. (EX2013, Invalidity Contentions Cover Document, at 11.) Petitioner extensively charted five of those prior art systems. (EX2014, Bokar Decl., ¶ 12.) Petitioner asserts that Kolo and Zyda may be combined with these 16 prior art systems to render the claims of the Patents obvious. (EX2013, Invalidity Contentions Cover Document, at 23, 26, 27-30.) Petitioner can sidestep its *Sotera* stipulation by combining Kolo and Zyda with the 16 prior art systems such that its stipulation will not avoid duplicative efforts or inconsistent rulings. ***Second***, the stipulation does not bind all real parties-in-interest and would not prevent the DC from considering the same art and arguments from other parties. Petitioner represented to PO that additional parties may be necessary to fully adjudicate PO's claims in the Litigation. (EX2016, 8/21/25 Ltr. (identifying Scopely, Inc., Niantic Spatial, Inc., and Reality Crisis Oy).) However, none of these parties signed Petitioner's (or any) *Sotera* stipulation. (*See* EX1050.) These related entities/commercial partners could join the Litigation and moot Petitioner's *Sotera* stipulation. Petitioner's stipulation therefore does not mitigate the *Fintiv* concerns.

F. Petitioner Is A Party To The Litigation (*Fintiv* Factor 5).

Factor 5 favors denial because the Petitioner is the defendant in the Litigation. *See NXP USA, Inc. v. Impinj Inc*. PGR2022-00005, Paper 18 at 12 (May 2, 2022).

V. CONCLUSION

For the foregoing reasons, the Director should deny institution.

Date: September 22, 2025

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CERTIFICATE OF SERVICE

I hereby certify, in accordance with 37 C.F.R. § 42.205, that the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** was served via electronic mail on September 22, 2025 on the following counsel of record for Petitioner and to Niantic-ImagineAR-IPRs@perkinscoie.com:

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