UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIANTIC, INC.,

Petitioner,

v.

IMAGINEAR, INC. AND IMAGINEAR, INC.,
Patent Owner.

IPR2025-01273

U.S. Patent No. 11,666,827

PETITIONER'S BRIEF OPPOSING DISCRETIONARY DENIAL

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1002	U.S. Patent No. 11,484,797 ("'797Pat")
1003	U.S. Patent No. 11,666,827 ("'827Pat")
1004	U.S. Patent No. 12,070,691 ("'691Pat")
1005	Complaint, *ImagineAR, Inc. and Imagine AR, Inc. v. Niantic, Inc.*, 1-24-cv-01252 (D. Del.)
1006	Declaration of Stacy Friedman ("Friedman")
1007	Curriculum Vitae of Stacy Friedman
1008	File History of U.S. Patent Application No. 14/084,113 ("'113App")
1009	File History of U.S. Patent No. 10,946,284 ("'284FH")
1010	File History of U.S. Patent No. 11,484,797 ("'797FH")
1011	File History of U.S. Patent No.11,666,827 ("'827FH")
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I. INTRODUCTION

Discretionary denial is not appropriate in this IPR because the PTAB is the most efficient forum to resolve issues of invalidity as to the Challenged Patent. No trial date has been set in the co-pending district court litigation, and time-to-trial statistics show the Board's Final Written Decision ("FWD") is expected well before a district court trial. Further, Petitioner diligently filed its petitions. Indeed, at the time the petitions were filed, PO had not yet even served infringement contentions in the district court.

In addition, the '827 Patent issued in 2023, and the other three patents challenged in IPRs—which share the same specification as the '827 Patent (collectively, "Challenged Patents")—issued between 2021 and 2024.[1] IPR2025-01274 (U.S. 10,946,284); IPR2025-01275 (U.S. 11,484,797); IPR2025-01276 (U.S. 12,070,691). This is not a case where PO has developed settled expectations but

[1] PO asserted seven patents in the co-pending district court litigation. None of the seven patents had previously been asserted in litigation, and none has been previously challenged before the Office (either in IPR or ex parte reexam). On September 8, 2025, the district court held three of the asserted patents invalid under Section 101. EX1051; DD Req., 5 n.2. Petitioner has challenged the remaining four patents in IPR.

instead where Petitioner has brought early challenges, which the Director has repeatedly found favor robust, predictable patent rights and weigh against discretionary denial.

The PTAB is also the most efficient forum to resolve invalidity because PO continues to file continuation applications that claim priority to the ’827 Patent and the other three patents challenged in IPR. Specifically, at the time it sued Petitioner in the co-pending litigation, PO had one pending continuation application, and after that suit was filed, PO filed two more. All three continuation applications remain pending. These IPRs will promote efficiency because if the challenged claims are held unpatentable, PO would be estopped from obtaining patentably indistinct claims in those continuation applications. *See* 37 C.F.R. §42.73(d)(3)(i); *SoftView LLC v. Apple Inc.*, 108 F.4th 1366 (Fed. Cir. 2024).

Patent Owner’s arguments do not show that discretionary denial is warranted here because they are based on selective omissions of important facts or sweeping generalizations that are not supported. When PO’s arguments are examined critically, it is clear that PO has no settled expectations that its patents would not be challenged. The PTAB should reach the merits of this IPR.

II. ARGUMENT

As discussed in detail below, the *Fintiv* factors weigh strongly against discretionary denial, so the Director should not exercise discretion to deny institution.

Notably, trial in the parallel district court proceeding is likely to occur well after the FWD deadline in these IPRs. In addition, the '827 Patent issued 2 years ago, and as discussed below, PO has not shown persuasively why it has developed settled expectations in that short time.

A. No Stay Has Been Requested, so Factor 1 is Neutral

No motion to stay has been filed, and so this factor is neutral. *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 7 (June 16, 2020) (informative). If these IPRs are instituted, Petitioner intends to move for a stay.

B. Lack of a Trial Date and Time-to-Trial Statistics Weigh Strongly Against Discretionary Denial (Factor 2)

The FWD here is likely to issue well before trial in the district court, so this factor weighs strongly against discretionary denial. A FWD in this IPR is expected no later than January 21, 2027. On the other hand, no trial date has been set in the district court. *See* EX1052. Based on the lack of a trial date alone, this factor weighs against discretionary denial. *E.g., Imperative Care, Inc. v. Inari Med., Inc.,* IPR2025-00289, Paper 9 at 2 (Director June 12, 2025) (lack of trial date weighs against discretionary denial).

In addition, time-to-trial statistics support that any district court trial will come well after FWD. Specifically, the District of Delaware's 35-month median time to trial shows trial would occur in mid-October 2027, about 9 months after the January

21, 2027 FWD deadline. EX1053. Considering Judge Wolson's statistics for patent cases instead, median time to trial is 62.2 months, and trial would occur in January 2030, about 3 years after the FWD deadline. EX1054.

PO's argument that the trial "is likely to be scheduled before or at the same time as the projected FWD deadlines" is speculative because it based only cherry-picked cases, rather than overall statistics. DD Req., 15-16.

Because no trial date has been set and statistics show trial will likely occur well after the FWD deadline, this factor weighs strongly against exercising discretion to deny institution.

C. Relatively Light Investment in the Parallel Proceeding Weighs Against Discretionary Denial (Factor 3)

The parallel proceeding is in its infancy and will remain so at the expected time of an institution decision in this IPR (no later than January 21, 2026). Accordingly, this factor weighs against discretionary denial.

To date, the parties have engaged in some written discovery, produced initial infringement and invalidity contentions, and noticed some depositions, but the bulk of the work in the parallel proceeding has not begun. The lion's share of the work left in the case will occur long after the institution decision. Notably, case deadlines in the district court's recently-issued scheduling order are cued off of the issuance of a claim construction order, but the *Markman* hearing is not scheduled until February 5, 2026, after an institution decision will have issued in this IPR. EX1052,

4. Additionally, notable work that remains to be done after IPR institution includes completing document production (including source code review), fact witness depositions, final infringement and invalidity contentions, opening and rebuttal expert reports, expert witness depositions, objections to expert testimony, case dispositive motions, and any pretrial motions. *See id.*

A closer look at PO's investment in the parallel proceeding reveals that its investment has been light. Although PO touts producing "over 5,000 pages of documents," the vast majority of those 5,000 pages are publicly available Niantic documents related to the products PO accuses of infringement. DD Req., 17; EX1055, 4-5. To date, PO has not even asked to examine any source code of the accused products made available by Niantic.

Even on its face, the investment in the case so far falls far short of investment that weighed in favor of denial in the cases cited by PO. *Formycon AG v. Regeneron Pharms., Inc.*, IPR2025-00233,[2] Paper 15 at 13-17 (Jun. 2, 2025) (investment included "a two-week trial…and three other preliminary-injunction proceedings focused on validity of the [challenged patent]"); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13-14 (May 13, 2020) (where the district court "issued a detailed 34-page claim construction order [and] [t]he parties also exchanged both initial and

[2] PO incorrectly cites to IPR2025-00223. DD Brief, 16.

final infringement and invalidity contentions" factor three weighs only "somewhat in favor of discretionary denial"); *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (Mar. 28, 2025) (investment included the district court issuing a claim construction order and the parties exchanging opening and rebuttal expert reports and conducting several depositions). By contrast, here the district court will not have even held a *Markman* hearing before the institution decision.

In cases where the *Markman* hearing and the other notable deadlines discussed above are set to occur after the institution decision, the Board has weighed factor 3 against exercising discretion. *See Cambridge Indus. USA, Inc. v. Applied Optoelectrics, Inc.*, IPR2025-00434, Paper 11 at 2 (Director June 26, 2025) (vacated *Markman* hearing date weighs against denial); *Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00311, Paper 9 at 12-14 (June 18, 2025) (factor 3 weighs against discretion where *Markman* hearing and fact and expert discovery deadlines occur after institution decision).

In addition, PO faults Petitioner for the timing of filing its IPR petitions. DD Req., 18. But Petitioner filed those petitions early in the district court litigation, which has moved slowly, and before PO had even provided infringement contentions. EX2006, 2.

Accordingly, this factor weighs against exercising discretion.

D. FWD Likely Preceding Trial and Petitioner's *Sotera* Stipulation Weigh Strongly Against Discretionary Denial (Factor 4)

Because the FWD is likely to precede trial in the parallel proceeding, this factor weighs strongly against discretionary denial because the estoppel provision of 35 U.S.C. § 315(e)(2) will eliminate any overlap with the district court.

To eliminate any possibility of overlap in the extremely unlikely event that trial in the district court occurs before a FWD, Petitioner provided a *Sotera* stipulation, agreeing to be "bound by the full scope of the estoppel under 35 U.S.C. § 315(e)(2)." EX1050.

Although Petitioner's *Sotera* stipulation will likely be moot because the FWDs are expected to precede district court trial by months to years, *see* § II.B, the Director should also disregard PO's arguments related to the *Sotera* stipulation. DD Req., 19-20. First, Niantic's *Sotera* stipulation covers the full breadth of estoppel that Congress prescribed under §315(e)(2). Thus, the stipulation "mitigates any concerns of duplicative efforts…" *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 19 (Dec. 1, 2020) (precedential as to §II.A)). Second, although PO speculates about real parties in interest that would not be bound by Petitioner's *Sotera* stipulation, none of them are parties to the district court proceedings. At the time PO submitted its DD Brief, the agreed June 6, 2025 deadline to join parties without leave had long passed without any move by PO to add the RPIs to the district court case. EX2006. Since then, the district court has moved the deadline to

November 7, 2025. EX1052. Petitioner does not intend to add any of the RPIs to the case, and PO has not approached the district court to do so either.

Because of the lack of actual overlap, this factor weighs strongly against exercising discretion.

E. Overlap of the Parties Weighs Against Discretionary Denial (Factor 5)

In circumstances such as these, where a FWD "is likely to issue before the district court trial," the Board has "weigh[ed] this factor against exercising discretion." *BMW of N. Am., LLC v. Mich. Motor Techs. LLC*, IPR2023-01234, Paper 11 at 14-15 (Jan. 26, 2024) (collecting cases).

F. PO Lacks Settled Expectations and Other Considerations Weigh Strongly Against Discretionary Denial (Factor 6)

1. Petitioner Expected to Be Able to Challenge the '827 Patent and PO Has Not Developed Settled Expectations Otherwise

Patent Owner lacks settled expectations because the '827 Patent has been in force since only June 6, 2023. Patents issued fewer than 6 years prior to IPR filing generally do not support a finding of settled expectations. *E.g.*, *Shenzen Tuozhu Tech. Co. v. Stratasys, Inc.,* IPR2025-00438, Paper 10 at 2 (Director July 17, 2025) (no settled expectations for patents issued in 2020-2024); *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11 at 2-3 (Director June 26, 2025) (no settled expectations for patents issued 2019-2020). PO has not articulated any "good reasons why [it] has strong settled expectations in a patent that has only

been in force for [fewer than six years]," such as, "for example an explanation of how an extraordinary amount of investment, time, and resources dedicated to research, development, trials, and regulatory approval correlates to settled expectations." *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9 at 2-3 (Director July 24, 2025). By contrast, PO acquired U.S. Patent Application No. 15/215,404 ("'406 App."), which led to the Challenged Patents, and thus has made no investment in research or development. And because PO does not practice the subject matter of the patents, it also has not invested in related activities such as trials or regulatory approvals. EX1056, 9-10. Indeed, based on a corporate statement issued by PO, it acquired the '406 App. "for no additional fee" when it stood abandoned.[3] EX1057, 1.

Despite the patent age and PO having acquired an application it knew was abandoned, PO argues it nevertheless has settled expectations because of unsolicited third-party brokers. But the facts surrounding these communications show they do not support settled expectations.

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[3] In early 2020, PO issued a corporate update which mentioned PO's acquisition of the patent portfolio that included the '406 App. EX1057. The statement notes that "One patent, 'Systems and Method for Capture and Use of Local Elements in Gameplay' was included for no additional fee and was classified as abandoned." *Id.*

As background on the Challenged Patents, on November 19, 2013, the Applicant filed its first non-provisional application, 14/084,113 ('113 App.). EX1008, 1-53. On January 20, 2016, the '113 App. received a first Office action rejecting all pending claims. *Id.*, 60-71. The Applicant never responded to that Office action, and the '113 App. went abandoned. *Id.*, 83-84.

Days before the '113 App. went abandoned, the Applicant filed the '406 App. on July 20, 2016, as a continuation of the '113 App. EX1009, 5, 8, 50. The application that led to the issuance of the '827 Patent (17/952,026) was the grandchild of the '406 App. The '406 App. received three Office actions between October 2016 and May 2018 (*id.*, 61-72, 79-85, 106-19, 131-43, 148-58) before it went abandoned on August 18, 2018 (when the Applicant had not responded to the last rejection within three months). 37 C.F.R. 1.134, 1.135; EX1009, 149 (notifying applicant of shortened 3-month period to reply), 163-164 (Notice of Abandonment). After the '406 App. had been sold in its abandoned state, the Applicant then filed a Petition to Revive 10 months later. *Id.*, 174. The next continuation application in the family (17/172,623 that led to the '797 Patent) was filed on February 10, 2021, EX1002, (22), shortly before the '406 App. issued as the '284 Patent, EX1001, (45).

PO argues that it has settled expectations in the '827 Patent because Petitioner became aware of the patent and failed to challenge it. DD Req., 8-9. In support, PO relies on: (1) a third party broker's communications with Petitioner in late 2018,

(2) another third party broker's communications with Petitioner in 2023, and (3) the '406 App.'s publication in 2016. *Id.*, 9-10. None of these supports PO's settled expectations.

First, PO points to solicitations by Inflexion Point Strategy ("IPS"), a broker representing the company from whom PO acquired patent rights, XMG Studio, Inc. ("XMG"), in attempts to sell XMG's patent portfolio in late 2018. *See* DD Req., 3-4; EX2001; EX2002, ¶8 (stating that PO purchased XMG's patents on May 19, 2019); EX2003. But the '406 App. was abandoned during the entire time that IPS was soliciting Niantic regarding sale of XMG's portfolio. The Applicant did not petition to revive the '406 App. until June 11, 2019, after PO had purchased that abandoned application and well after Niantic had ceased communication with IPS. EX1009, 178-79. Moreover, this was not a threat of infringement or a licensing demand—it was an offer to sell a portfolio, after which apparently ImagineAR acquired said portfolio. Petitioner would have had no reason to bring an invalidity challenge against patents an entity merely offered to sell.

Further, it appears that IPS and XMG knew the '406 App. was abandoned when negotiating the sale of the patent portfolio, including sale of the '406 App. to

PO "for no additional fee." EX1057.[4] In any event, because the '406 App. was abandoned throughout the entire duration of the IPS discussions with Niantic in late 2018, Petitioner had no reason to monitor that application (particularly because the Applicant never revived the abandoned '113 App. as discussed above) to see if it was revived or resulted in issued patents. PO has not developed settled expectations regarding the Challenged Patents by virtue of XMG's inclusion of the then-abandoned '406 App. in a patent portfolio it attempted to sell.[5]

Second, PO points to another third-party broker's 2023 failed attempt to establish contact with Petitioner regarding the sale of PO's patent portfolio. DD Req. 4, 9. PO's agent did not receive a response from Niantic to its generic 2023

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[4] And thus it seems in reviving the '406 App., PO improperly made the statement that "[t]he entire delay in filing the required reply…was unintentional" given that XMG (and PO) knew the '406 App. was abandoned at least as early as when it was negotiating sale of its patent portfolio to PO yet did not immediately attempt to revive the application. EX1009, 178-79.

[5] PO states "Petitioner did not try to invalidate the Patents ... from 2018 through July 14, 2025," the date the IPRs were filed. DD Req., 4. This is misleading at best because the earliest any patent issued in this family was the '284 Patent, which issued on March 16, 2021. EX1001.

solicitation emails.[6] EX1058-EX1060. Accordingly, PO could not have developed an expectation that anyone from Niantic had so much as read the email, much less had been put on notice regarding the existence of the ’284 Patent. Nor did the 2023 emails allege that Niantic infringed the ’284 Patent; at most, they stated that the portfolio (including five other patents) “may relate to today’s top location-based mobile games.” *Id*. Notably, the ’827 Patent had not issued at the time of the 2023 email (*see* EX2002, ¶10 (March 2023 email); EX1003 (’827 Patent with June 2023 issue date)). And again, this was not an infringement threat or a licensing demand. Similar to the earlier communications, the 2023 correspondence was an offer to re-sell the portfolio acquired from the predecessor-in-interest. Petitioner would have had no reason to seek to invalidate patents that a broker was merely offering to sell.

Further, it does not appear that PO’s agent (or PO) followed up with Petitioner after those March 2023 e-mails went unanswered.[7] Instead, PO waited 20 months in silence and then sued Petitioner for allegedly infringing 7 patents.

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[6] That emails mentioned only the ’284 Patent, contrary to PO’s assertion that the ’797 Patent was also listed. EX1058-EX1060; DD Brief, 4.

[7] PO argues “Petitioner did not try to invalidate the Patents after it declined to purchase the rights to the Patents from 2023 through July 14, 2025.” DD Req. 4. This is also misleading because PO cites no evidence that Petitioner “declined”

Third, the publication of the '406 App. does not support notice that should give rise to PO's settled expectations. As PO acknowledges, that application published on November 10, 2016. DD Req., 10. But as discussed above, the '406 App. went abandoned after a non-final rejection in 2018, and the Applicant's third party broker called Petitioner's attention to that application while it was abandoned. Thus, any constructive notice from the publication of that application was negated by the Applicant's allowing the application to go abandoned and the decision to point Petitioner to it while it was in an abandoned state.

Further, the cases cited by PO in support of its settled expectations argument (DD Req., 8-10) are inapposite because each case involved discretionary denial for patent(s) in force for over 6 years. *Belden Inc. v. Commscope, Inc.*, IPR2025-00833, Paper 13 (Director Sept. 12, 2025) (patent in force for 9 years and commercialized for 7 (with notice provided to the public via patent marking)); *Geotab Inc. v. Fractus, S.A.*, IPR2025-00928, Paper 11 at 3 (Director Sept. 12, 2025) (patent in force for 11 years and the petitioner had "engaged in discussions with Patent Owner about the challenged patents until shortly before Patent Owner asserted the challenged patent"); *Google LLC v. SoundClear Techs. LLC*, IPR2025-00345, Paper 15 at 2-3 (Director

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anything because PO has pointed to no response that PO's broker received to its unsolicited 2023 emails.

delegate Aug. 4, 2025) (patent in force for 10 years); *Nvidia Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18 at 2-3 (Director July 31, 2025) (patent in force for 11 years, with notice given to petitioner in 2017 by the patent's previous owner, which had a commercial relationship with petitioner); *iRhythm Techs., Inc. v. Welch Allyn, Inc*., No. IPR2025-00377, Paper 10 (Director June 6, 2025) (patent in force for 13 years); *Murata Mfg., Co. v. Ga. Tech. Rsch. Corp*., IPR2025-00383, Paper 14 at 2-3 (Director July 29, 2025) (patent in force for 16 years); *Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (Director June 18, 2025) (patent in force for 8 years); *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9 (July 24, 2025) (instituting IPR against a patent that had been in force for only 3 years, while discretionarily denying IPRs against patents in force for 6 and 7 years).

For *Samsung Elecs. Co. v. iCashe, Inc.*, IPR2025-00639, Paper 11 at 3 (Aug. 14, 2025) (Director delegate), PO omits important facts that are not present here. DD Req., 11. There, the Director discretionarily denied seven IPRs where (1) five were filed against patents that had been in force for 8 to 12 years, and (2) the district court's scheduled trial date and projected trial date based on time-to-trial statistics both preceded the scheduled FWD by several months. The Director noted that two of the IPRs related to patents that "have not been in force as long as the other patents challenged" and that "ordinarily such circumstances might counsel against discretionary denial." *Id.*, 3. However, the Director ultimately exercised discretion

to deny the remaining two IPRs "because the district court will be considering the validity of the patents challenged in [the other 5 discretionarily denied IPRs]…and tips the balance to discretionary denial as to those patent[s] too." *Id.* Here, as discussed above, no trial is scheduled and time-to-trial statistics place trial well after the FWDs. *See supra*, § III.B. In other words, in *iCashe*, some of the related patents issued more than six years earlier, and for those that had not, the trial date tipped the balance in favor of exercising discretion. Here, the trial date is expected ***after*** the FWDs, and ***none*** of the related patents issued more than 6 years ago.

In sum, PO has not developed settled expectations regarding the Challenged Patents because they are recently issued, a third party broker called Petitioner's attention to the '406 App. when it was abandoned without any indication that it would or could be revived, and another third party broker did not establish contact with Petitioner during PO's 2023 attempts to sell its portfolio including the '284 Patent.

2. Institution Would Be an Efficient Use of the Board's Resources and Promote Efficiency in the Parallel Proceeding

Institution would be an efficient use of the Board's resources due to the high degree of overlap between the four IPRs. The four IPRs against the Challenged Patents, and the Challenged Patents themselves, overlap to a great degree, so it would be an efficient use of the Board's resources to address validity of all four

patents. *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at 4 (Director July 16, 2025) ("it is an efficient use of Board resources to address [] related patent[s]"); *Embody, Inc. v. Lifenet Health*, IPR2025-00248, Paper 13 at 3 (Director June 26, 2025) (same). Each of the four IPRs relies on the same grounds based on Kolo and Zyda to challenge every claim of each of the Challenged Patents. In addition, the Challenged Patents share a specification and their claims overlap extensively. Indeed, Petitioner's expert put in a single declaration addressing all four IPRs and extensively cross-references his analysis regarding the '827 Patent when addressing the other three patents. *See* EX1006. Therefore, it would be an efficient use of the Board's resources to address the validity of all four Challenged Patents based on Petitioner's largely identical challenges.

In addition, the Board can address the validity of all claims of the Challenged Patents. At the time the IPR petitions were filed, PO had not yet served infringement contentions and so had not identified asserted claims. EX2006, 2. Even with its infringement contentions, PO still asserted 108 of the 112 Challenged Claims across the 4 Challenged Patents. EX2015. And PO's final infringement contentions are not due until 21 days after a claim construction order, which has no date certain or deadline for issuance. EX1052, 4. Thus, it makes sense that Petitioner challenged all claims of the Challenged Patents. The parties' pending proposals for case narrowing

in district court (which have not been entered)[8] do not support PO's inefficiency arguments (particularly in light of PO's continued filing of continuation applications as discussed below).

3. PO's Pending Continuation Applications Further Support That the Board's Resolution of These IPRs Is Efficient and Necessary

PO continues to file continuation applications with the same priority chain as the Challenged Patents here. At the time the co-pending litigation was filed, PO had one such pending continuation application (No. 18/813,579, EX1062), and PO filed two more continuation applications after suing Petitioner (Nos. 19/175,119, EX1063, and 19/176,364, EX1064). PO may well continue to file more continuation applications in the future. At present, as long as PO files terminal disclaimers,[9] nothing prevents PO from obtaining patentably indistinct claims through such continuation applications and asserting them against Petitioner in future litigation.

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[8] PO mentions only Petitioner's proposal while failing to mention that its proposal would still put 45 claims at issue in the district court across all four Challenged Patents. EX1061. PO's proposal would also delay claim narrowing until after the claim construction order (and thus after the institution decision). *Id.*

[9] As PO has already done in App. Nos. 19/175,119 and 19/176,364. EX1063, 110; EX1064, 93.

These IPRs represent an efficient way to resolve the parties' disputes and avoid future litigation involving subsequently issued, patentably indistinct claims. Specifically, if the challenged claims are held unpatentable in these IPRs, PO would be estopped from obtaining patentably indistinct claims in those continuation applications. *See* 37 C.F.R. §42.73(d)(3)(i); *SoftView LLC*, 108 F.4th 1366.

This further supports that the PTAB is the most efficient forum to resolve unpatentability of the Challenged Patent.

4. Strong Merits Weigh Against Denial and PO's Vague Accusations of Gap-Filling are Baseless

The merits here are strong. Petitioner presents two grounds, a straightforward single-reference obviousness ground based on Kolo that addresses the independent claim and several dependent claims, and a single combination with Zyda that addresses the remaining dependent claims in each of the Challenged Patents. Because all the claims in the Challenged Patents were plainly unpatentable as obvious in view of Kolo and Zyda, Petitioner did not need to rely on complex multi-reference combinations or an overlap of Challenged Claims between grounds in its challenges.

PO does not provide any analysis to support its contention that the merits of Petitioner's IPRs are weak. *See* DD Req., 12-13. Instead, PO merely lists four limitations and cites to portions of the Petitions that explain why those limitations would have been obvious in view of Kolo. *Id.*, 14. Nowhere in the portions of the

Petitions cited by PO does Petitioner "concede" that any limitations are missing from Kolo. *See id.* And PO does not explain why those limitations are allegedly missing from Kolo. *Id.* Nor does PO explain why it believes that Petitioner "conceded" those limitations are missing in the portions of the Petitions PO cites or why/how the Petitions allegedly rely on expert testimony to fill those alleged gaps in the prior art. *Id.* Instead, each portion of the Petitions that PO cites relies extensively on the prior art reference (Kolo), as well as expert testimony, to explain how a POSITA would have understood those disclosures. Accordingly, PO's conclusory and unsupported allegations of weak merits and gap-filling do not support discretionary denial.

III. CONCLUSION

All relevant considerations here weigh against discretionary denial of institution in this IPR. Notably, there is no trial date in the district court litigation, statistics show such a trial will occur well after FWD, and PO has no settled expectations as to the Challenged Patent which issued approximately two years before this IPR was filed. Accordingly, the Director should refer this IPR to a PTAB panel to evaluate the merits.

Respectfully submitted,

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Date: October 21, 2025

CERTIFICATE OF SERVICE

The undersigned hereby certifies that true copies of Petitioner's Brief Opposing Discretionary Denial and EXHIBITS 1051-1064 were served upon the below-listed counsel by electronic mail:

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