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 REPLY BRIEF IN SUPPORT OF DISCRETIONARY DENIAL

TABLE OF CONTENTS

I. THE DISTRICT COURT'S SCHEDULE CONFIRMS THAT THE TRIAL WILL PREDATE A FINAL WRITTEN DECISION. 1

II. NEW EMAILS SHOW THAT PETITIONER'S UPPER MANAGEMENT ANALYZED THE CHALLENGED PATENT FAMILY YEARS AGO, REINFORCING PATENT OWNER'S SETTLED EXPECTATIONS AND PETITIONER'S CONCEALMENT. 2

III. PETITIONER'S LIMITED STIPULATION ALSO FAVORS DENIAL BECAUSE IT IS INCONSISTENT WITH THE USPTO'S OCTOBER 17, 2025, PROPOSED RULES AND CURRENT POLICY. 4

IV. CONCLUSION 5

TABLE OF AUTHORITIES

Page(s)

Federal Statutes

35 U.S.C. § 315(e)(2).....5

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")
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")
EX2019	November 2018–January 2019, Email Chain between Shaun MacDonald of Extreme Venture Partners and Vikram Grover and

	Omar Tellez of Niantic, copying Ron Laurie of Inflexion Point Strategy (IPS106-114)
EX2020	November 2018–January 2019, Email Chain between Shaun MacDonald of Extreme Venture Partners and Vikram Grover and Omar Tellez of Niantic, copying Ron Laurie of Inflexion Point Strategy (IPS126-136)
EX2021	USPTO's October 17, 2025 Proposed Rules, 90 Fed. Reg. 48335 (Oct. 17, 2025)

Patent Owner ("PO") submits this Reply to support its request that the Director deny institution in view of three developments. ***First***, the district court in the co-pending Litigation has entered a scheduling order, suggesting that trial will occur earlier than originally expected and, in any event, ***before*** the Board issues a FWD. ***Second***, newly revealed documents show that Petitioner's senior executives not only knew of, but ***analyzed***, the challenged patent family approximately seven years ago, which further emphasizes Petitioner's concealment in the Litigation and bolsters PO's settled expectations. ***Third***, the USPTO's recent Notice of Proposed Rulemaking further highlights that institution is improper because Petitioner's *Sotera* stipulation does not bar validity attacks in the Litigation. These recent developments confirm that the Director should deny institution.

I. THE DISTRICT COURT'S SCHEDULE CONFIRMS THAT THE TRIAL WILL PREDATE A FINAL WRITTEN DECISION.

When PO filed its opening brief, the district court in the Litigation had not yet entered a scheduling order. PO therefore relied on the parties' proposed schedule to approximate a trial date. (Paper 7 at 15-16.) Based on the proposed schedule, PO expected trial to occur in January 2027, around the same time as the projected FWD deadline of January 21, 2027. (*Id.*) The district court's recent October 8, 2025 Schedule (EX1052) suggests an earlier trial date. The Schedule sets a *Markman* hearing date of February 5, 2026, more than a month ***earlier*** than that originally

projected by PO. (EX1052, ¶ 6; Paper 7 at 15-16.)[1] Carrying that forward based on the Schedule, dispositive motion briefing will be complete by October 1, 2026. Assuming a conservative three-month gap between the completion of dispositive motion / *Daubert* briefing and trial (*see* EX1052, ¶¶ 3, 7, 9, 10; Paper 7 at 16), PO expects that trial will now occur no later than January 1, 2027, *i.e.*, at least several weeks ***before*** the projected FWD date.

Tellingly, Petitioner's response focuses on average time to trial statistics, but ignores the actual Litigation Schedule, which Petitioner had the benefit of considering in its response. (Paper 10 at 3-4.) By relying on averages, Petitioner would have the Director believe that trial will occur no sooner than one year ***after*** dispositive motion and *Daubert* briefing is complete, and possibly more than three years later. (Paper 10 at 3-4.) Of course, Petitioner fails to identify any reason for such delay. Ultimately, the Schedule confirms that the district court will resolve validity challenges first. This development supports discretionary denial.

II. NEW EMAILS SHOW THAT PETITIONER'S UPPER MANAGEMENT ANALYZED THE CHALLENGED PATENT FAMILY YEARS AGO, REINFORCING PATENT OWNER'S SETTLED EXPECTATIONS AND PETITIONER'S CONCEALMENT.

Recently produced emails between Petitioner and a third-party patent broker

[1] The timing of the *Markman* hearing is significant because it best indicates when the district court will issue its *Markman* order, which in turn sets future case deadlines. (*See, e.g.,* EX1052, ¶ 6.) The judge in the Litigation typically issues *Markman* orders about one month after the hearing. (Paper 7 at 15 (citing cases).)

strengthen PO's settled expectations to the challenged patents. Specifically, these emails demonstrate that Petitioner's upper management analyzed the challenged patent family in 2018–2019 but never attempted to invalidate it. From the get-go, Petitioner intended to put the patents and applications before its most senior officers, including its CEO and CTO, for analysis and consideration. (EX2001 at 1 ("you mentioned you wanted to circle back with your CTO, Phil Keslin, and CEO, John Hanke"); EX2019 at 1 ("Let me follow up with our CTO this week.").) As promised, Petitioner emailed the patent broker to confirm that Petitioner's CTO had begun to analyze the challenged patent family and would share the results with Petitioner's executive team:

> I met with our CTO [Phil Keslin] today. He has started reviewing the patents but has a number of things on his plate at the moment. In terms of process, he is the key guy to help us evaluate and will then share his perspective with the rest of our exec team.

(EX2020 at 1.) Considered collectively, these emails show that Petitioner's most senior officers, including its CTO and CEO, were involved in the analysis of, and decision not to purchase, the challenged patent family almost seven years ago.

These newly produced emails reinforce that this IPR is a strategic afterthought that would undermine PO's settled expectations if instituted. These emails demonstrate not only Petitioner's awareness but, critically, its substantive engagement with the patent family it now seeks to challenge. Despite this prior analysis, Petitioner elected not to purchase the portfolio or to question its validity

until filing this IPR. This deliberate inaction underscores that Petitioner's IPR is a litigation tactic rather than a response to any genuine validity concern. The Director should not permit Petitioner to avail itself of the IPR process now when Petitioner analyzed the patent family years earlier and could have sought review over the last half decade. Importantly, PO relied on Petitioner's inaction, expecting that a sophisticated entity that analyzed and declined to challenge the patents would not later attack their validity. Petitioner's analysis of the challenged patent family strengthens PO's settled expectations and weighs against institution.

That Petitioner concealed these new documents in the Litigation also favors discretionary denial. Petitioner withheld its internal and third-party communications regarding its prior knowledge and analysis of the challenged patent family until ***after*** PO submitted its initial discretionary denial brief.[2] Petitioner's conduct suggests that the petition is not a good-faith effort to challenge validity, but a calculated attempt to undermine PO's settled expectations and avoid a discretionary denial.

III. PETITIONER'S LIMITED STIPULATION ALSO FAVORS DENIAL BECAUSE IT IS INCONSISTENT WITH THE USPTO'S OCTOBER 17, 2025, PROPOSED RULES AND CURRENT POLICY.

Petitioner's stipulation falls well short of the USPTO's proposed rule, which favors discretionary denial. The USPTO's October 17, 2025, proposed rules

[2] Petitioner has not authorized PO to submit Petitioner's internal emails as exhibits in this IPR, further concealing such documents and impeding the Board's ability to consider evidence directly bearing on the settled expectations factor.

generally mandate IPR denial when a petitioner does not agree to forego all 102 and 103 validity challenges in parallel district court litigation:

> Under the proposed revisions, this section would provide that the Office will not institute an IPR when a petitioner intends to pursue invalidity challenges under §§ 102 or 103 in other venues, such as district court …. This proposed section would further require the Petitioner to file the stipulation in any other venue where it is litigating with the patent owner. The Office's view is that this requirement would promote fairness and efficiency by channeling similar patent challenges to a single forum and ensure that IPRs should generally serve as a complete substitute for at least some phase of the litigation.

(EX2021 at 4 (internal quotations and citations omitted), 7.)[3] Petitioner's stipulation does not preclude it from continuing to litigate prior art invalidity defenses in district court. (EX1050 (expressly limited to the estoppel under 35 U.S.C. § 315(e)(2).) Under the USPTO's proposed rule, Petitioner's limited *Sotera*-style stipulation requires denial of institution. Even without adoption, the proposed rule reflects ***current*** USPTO policy that disfavors institution where, as here, the Petitioner failed to commit to challenging validity in one forum. Either way, this development favors denial.

IV. CONCLUSION

For these additional reasons, the Director should deny institution.

[3] 90 Fed. Reg. 48335 (Oct. 17, 2025).

Date: November 3, 2025

/s/ James J. Lukas, Jr.
James J. Lukas, Jr. (Reg. No. 59,114)
GREENBERG TRAURIG, LLP
360 North Green Street, Suite 1300
Chicago, IL 60607
Telephone: (312) 456-8400
Facsimile: (312) 456-8435
lukasj@gtlaw.com

Gary Jarosik (Reg. No. 35,906)
Matthew J. Levinstein (To appear *pro hac vice*)
Benjamin P. Gilford (Reg. No. 72,072)
Erik Bokar (To appear *pro hac vice*)
GREENBERG TRAURIG, LLP
360 North Green Street, Suite 1300
Chicago, IL 60607
Telephone: (312) 456-8400
Facsimile: (312) 456-8435
jarosikg@gtlaw.com
gilfordb@gtlaw.com
bokare@gtlaw.com

Attorneys for Patent Owner

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 November 3, 2025 on the following counsel of record for Petitioner and to Niantic-ImagineAR-IPRs@perkinscoie.com:

Lead Counsel	**Back-Up Counsel**
Jessica C. Kaiser, Reg. No. 58,937 kaiser-ptab@perkinscoie.com PERKINS COIE LLP 1900 Sixteenth St., Suite 1400 Denver, CO 80202-5255 Phone: 303.291.2300	Christopher Marando Reg. No. 67,898 Marando-ptab@perkinscoie.com PERKINS COIE LLP 700 Thirteenth Street N.W. Suite 800 Washington, DC 20005-3960 Phone: 202.654.6200 Atanas Baitchev Reg. No. 82,414 baitchev_ptab@perkinscoie.com PERKINS COIE LLP 11452 El Camino Real Suite 300 San Diego, CA 92130-2080 Phone: 858.720.5700

Date: November 3, 2025

/s/ James J. Lukas Jr.
James J. Lukas, Jr., Reg. No. 59,114