UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIANTIC, INC.,

Petitioner,

v.

IMAGINEAR, INC.,

Patent Owner.

IPR2025-01273

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

PETITIONER'S SUR-REPLY BRIEF OPPOSING DISCRETIONARY DENIAL

TABLE OF CONTENTS

I. FWD IS LIKELY TO PRECEDE THE DISTRICT COURT TRIAL DATE. 1

II. PETITIONER EXPECTED TO BE ABLE TO CHALLENGE THE ’827 PATENT AND PO HAS NOT DEVELOPED SETTLED EXPECTATIONS OTHERWISE 3

III. THE USPTO’S PROPOSED RULES ARE NOT IN EFFECT AND ARE NOT A BASIS TO DENY INSTITUTION. 4

IV. CONCLUSION 5

EXHIBIT LIST

No.	Exhibit
1001	U.S. Patent No. 10,946,284 ("'284Pat")
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")
1012	File History of U.S. Patent No. 12,070,691 ("'691FH")
1013	U.S. Patent Application Publication No. 2012/0244945 ("Kolo")
1014	U.S. Patent Application Publication No. 2011/0214071 ("Zyda")
1015	Computer Dictionary, Microsoft Press (1st ed., 1991)
1016	Wikipedia, the free encyclopedia, Role-Playing Game, at https://web.archive.org/web/20100220021543/http://en.wikipedia.org/wiki/Role-playing_game (last visited Jun. 18, 2025)
1017	Wikipedia, the free encyclopedia, Role-playing game (pen and paper), at https://web.archive.org/web/20100111053448/ http://en.wikipedia.org/wiki/Role-playing_game_(pen_and_paper) (last visited Jun. 18, 2025)
1018	Wikipedia, the free encyclopedia, Tabletop role-playing game, at https://web.archive.org/web/20111025135658/ http://en.wikipedia.org/wiki/Tabletop_role-playing_game (last visited Jun. 20, 2025)

No.	Exhibit
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1020	Dungeons & Dragons, Player's Handbook, Wizards of the Coast, 4th Edition (Jun. 2008)
1021	Dungeons & Dragons, Rules Compendium, Wizards of the Coast, 4th Edition (Sep. 2010)
1022	Rolemaster Arms Law & Claw Law, Iron Crown Enterprises Inc., 2nd Edition (Sep. 1989)
1023	Rolemaster Character Law, Iron Crown Enterprises, 2nd Edition (Aug. 1999)
1024	Rolemaster Standard Rules, Iron Crown Enterprises, 1st Edition (1995)
1025	Spell Law, Iron Crown Enterprises, 2nd Edition (1989)
1026	Character Law & Campaign Law, Iron Crown Enterprises, 2nd Edition (1989)
1027	Wikipedia, the free encyclopedia, Role-playing video game, at https://web.archive.org/web/20100819005654/ http://en.wikipedia.org/wiki/Computer_role-playing_game (last visited Jun. 18, 2025)
1028	Wikipedia, the free encyclopedia, Massively multiplayer online role-playing game, at https://web.archive.org/web/20100716092631/ http://en.wikipedia.org/wiki/Massively_multi-player_online_role-playing_game (last visited Jun. 18, 2025)
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1030	Wikipedia, the free encyclopedia, Virtual world, at https://web.archive.org/web/20110917110743/ http://en.wikipedia.org/wiki/Virtual_world (last visited Jun. 18, 2025)
1031	Wikipedia, the free encyclopedia, Second Life, at https://web.archive.org/web/20110331154407/ http://en.wikipedia.org/wiki/Second_Life (last visited Jun. 18, 2025)
1032	Dan Jerker B. Svantenson, Geo-Location Technologies and Other Means of Placing Borders on the 'Borderless' Internet, 23 J. Marshall J. Computer & Info. L. 101 (2004) ("Svantenson")

No.	Exhibit
1033	"Internet Gambling Company PartyGaming PLC Enters Non-Prosecution Agreement with U.S. and will Forfeit $105 Million," Press release, United States Attorney for the Southern District of New York, April 7, 2009
1034	Darrel Etherington, Shadow Cities finds that mobile gaming is surprisingly stationary, Sep. 27, 2011 at https://web.archive.org/web/20110930120146/ http://gigaom.com/2011/09/27/grey-area-mobilize-2011/ (last visited Jun. 18, 2025)
1035	Jim Squires, Shadow Cities Walkthrough, May 30, 2011 at https://web.archive.org/web/20110604160126/ https://www.gamezebo.com/games/shadow-cities/walkthrough (last visited Jun. 18, 2025)
1036	Liz Gannes, Google Launches Ingress, a Worldwide Mobile Alternate Reality Game, November 15, 2012 at https://web.archive.org/web/20121115163246/ https://allthingsd.com/20121115/google-launches-ingress-a-worldwide-mobile-alternate-reality-game/ (last visited Jun. 18, 2025)
1037	Rolemaster Fantasy Role Playing, Iron Crown Enterprises, 2nd Edition (1999)
1038	Dungeons & Dragons, Monster Manual Deluxe Edition, Wizards of the Coast, 4th Edition (Jun. 2008)
1039	Wikipedia, the free encyclopedia, Statistic (role-playing games), at https://web.archive.org/web/20100525145809/ http:/en.wikipedia.org:80/wiki/Statistic_%28role-playing_games%29 (last visited Jun. 4, 2025)
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1042	Wikipedia, the free encyclopedia, Experience point, at https://web.archive.org/web/20100403064932/ http:/en.wikipedia.org/wiki/Experience_point (last visited Jun. 4, 2025)
1043	U.S. Patent Application Publication No. 2009/0149248

No.	Exhibit
1044	U.S. Patent Application Publication No. 2011/0183754 ("Alghamdi")
1045	U.S. Patent No. 8,639,725
1046	U.S. Patent Application Publication No. 2012/0253488
1047	The Greatest Games of All Time – Punch Out – Features at GameSpot, at https://web.archive.org/web/20071007124852/ http://www.gamespot.com/features/6122838/index.html (last visited Jul. 3, 2025)
1048	Kevin F. King, Geolocation and Federalism on the Internet: Cutting Internet Gambling's Gordian Knot, The Columbia Science and Technology Law Review Vol. XI 2010
1049	Dungeons & Dragons, Player's Handbook 2, Wizards of the Coast, 4th Edition (Mar. 2009)
1050	Sotera Stipulation Letter
1051	Memorandum, *ImagineAR, Inc. v. Niantic, Inc.*, No. 1-24-cv-01252 (D. Del. Sept. 8, 2025), ECF No. 63
1052	Scheduling Order, *ImagineAR, Inc. v. Niantic, Inc.*, No. 1-24-cv-01252 (D. Del. Oct. 8, 2025), ECF No. 88
1053	Federal Court Management Statistics, June 2025
1054	Judge Joshua D. Wolson Time to Milestone Statistics, Docket Navigator
1055	Letter Regarding Discovery Deficiencies, *ImagineAR, Inc. v. Niantic, Inc.*, No. 1-24-cv-01252 (D. Del.), dated Sept. 8, 2025
1056	Plaintiff's First and Second Supplemental Objections and Responses to Defendant's First Set of Interrogatories, *ImagineAR, Inc. v. Niantic, Inc.*, No. 1-24-cv-01252 (D. Del. Sept. 30, 2025)
1057	Andrew Kessel, *Imagination Park touts ongoing augmented reality developments in corporate update* (Mar. 10, 2020, 10:30) https://www.proactiveinvestors.com/companies/news/914663/imagination-park-touts-ongoing-augmented-reality-developments-in-corporate-update-914663.html
1058	March 2, 2023 Solicitation Email from Patent Infusion
1059	March 7, 2023 Solicitation Email from Patent Infusion

No.	Exhibit
1060	March 16, 2023 Solicitation Email from Patent Infusion
1061	Plaintiff's Email Regarding Case Narrowing, *ImagineAR, Inc. v. Niantic, Inc.*, No. 1-24-cv-01252 (D. Del. Sept. 19, 2025)
1062	File History of U.S. Patent Application No. 18/813,579
1063	File History of U.S. Patent Application No. 19/175,119
1064	File History of U.S. Patent Application No. 19/176,364
1065	Docket, *Aptiv Techs. AG v. Microchip Tech., Inc.*, 1:23-cv-00307 (D. Del.)
1066	Docket, *Microchip Tech., Inc. v. Aptiv Servs. US, LLC*, No. 1:23-cv-00778-JDW, (D. Del.)
1067	Docket, *L2 Mobile Techs. LLC v. TCL Electronics Holdings Limited*, 1:22-cv-01306, (D. Del.)
1068	Docket, *Microchip Technology Incorporated v. Delphi Automotive Systems, LLC*, 1:17-cv-01194 (D. Del)
1069	Scheduling Order, *Microchip Technology Incorporated v. Delphi Automotive Systems, LLC*, 1:17-cv-01194 (D. Del)

As discussed in the Discretion Opposition (IPR2025-01273 ("DD Opp."), Paper 10), discretionary denial is not appropriate in this case. Rather than addressing any new developments which support such denial, PO's Discretion Reply shows the lengths to which PO will go to avoid a decision on the merits. The Director should institute this IPR.

I. FWD Is Likely To Precede The District Court Trial Date.

The district court has not yet set a trial date. EX-1052. This alone, or when considered together with relevant time-to-trial statistics, shows an FWD will almost certainly occur well before a district court trial. *Id.*; DD Opp., 3-4. Nothing has changed affecting this analysis.

Both the parties' proposed schedule (EX-2006) and the district court's entered one (EX-1052) set *Markman* briefing to be complete by January 9, 2026, do not set a date certain for a *Markman* order, tie deadlines through case dispositive motions to the date that order issues, and do not set a trial date or provide a way to calculate one. Put simply, PO cannot predict a trial date based on the now-set *Markman* hearing date more accurately than time-to-trial statistics.

PO's concocted trial date (26 months after complaint filing) is based on two unfounded assumptions: (1) Judge Wolson "typically issues Markman orders about one month after the hearing" (DD Reply, 2 n.1), and (2) he sets a trial date within

three months of dispositive/Daubert briefing (*id.*, 2). None of the cases PO cites for these assumptions supports a trial in just over two years.

First, PO cites three cases to support its one-month-to-*Markman*-order assumption but conveniently ignores their specific facts. *See* EX-1065, 1066, 1067. For all three cases, PO fails to note the *Markman* hearing was delayed by months or in one case over a year from when it was originally scheduled. EX-1065, D.I. 34 (originally setting Markman hearing for April 25, 2024), D.I. 138 (rescheduling it to June 21, 2024); EX-1066,[1] D.I. 24 (originally setting Markman hearing for April 25, 2024), D.I. 25 (rescheduling it to June 4, 2024), D.I. 72 (further rescheduling it to June 21, 2024); EX-1067, D.I. 39 (originally setting Markman hearing for January 24, 2023), D.I. 67 (rescheduling it to February 6, 2024). Thus, at best, PO's cherry-picked cases support the *Markman* hearing will occur at least 2 months after it is currently scheduled, or April 5, 2026, delaying PO's speculative trial date to March 2027, ***after*** the expected FWD (no later than Jan. 21, 2027).

Second, PO cites a single case to support its three-months-from-dispositive-briefing-to-trial assumption. DD Reply 2 (citing DD Req. 16). PO, however, neglects to mention that in that case, trial began over four years after the complaint was filed.

[1] This case is related to the first, and the district court severed counterclaims from the first into a new case. D.I. 1.

EX-1068, D.I. 1, D.I. 353. And in the only docket entry PO cites (DD Req. 16 (citing D.I. 284)), the district court vacated the prior schedule and delayed trial by four months. EX1069. Indeed, in that case, time from completion of dispositive motion briefing to start of trial was two years, not three months. EX-1068, D.I. 223-24 (reply dispositive motion briefs filed Feb. 4, 2020), D.I. 353 (trial began April 5, 2022). Thus, that case does not support that the co-pending litigation will make it to trial in 26 months from filing, as PO alleges here.

In sum, PO relies on a cascade of assumptions not supported by the cases it cites to manufacture a trial date near the FWD deadline. This speculation should be rejected.

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

The '827 Patent issued on June 6, 2023. PO continues to claim settled expectations for such a newly-issued patent, but the emails PO cites in its Discretion Reply are more of the same that Petitioner already addressed in the Opposition. The two cited exhibits (EX-2019, 2020) relate 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/early 2019. But PO has no answer to the fact that the relevant part of that portfolio (the '406 App.) was abandoned during the entire time that IPS was soliciting Niantic. DD Opp. 9-12. Petitioner had no reason to monitor an abandoned

application to see if it would later be revived or result in issued patents.[2] PO's strident statements about its settled expectations do not withstand scrutiny, and they should be rejected.

III. The USPTO's Proposed Rules Are Not in Effect and Are Not a Basis to Deny Institution.

In a last-ditch effort to argue for discretionary denial, PO points to the October 17, 2025 Notice of Proposed Rulemaking that would require a stipulation broader than the statutory estoppel prior to institution. DD Reply 4-5 (citing EX-2021). But these proposed rules are not in effect and may be modified based on comments received or may never be promulgated at all. PO recognizes this, but states "the proposed rule reflects ***current*** USPTO policy." *Id.*, 5 (emphasis in original). Not so. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 18-19 (Dec. 1, 2020) remains precedential as to §II.A. That decision found a "broad" stipulation of the same scope as Petitioner provided here (EX-1050) "mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of

[2] And as noted in the Opposition, 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. DD Opp. 11.

potentially conflicting decisions" and weighed that stipulation strongly against discretionary denial. *Sotera,* IPR2020-01019, Paper 12, at 18-19.

PO's argument invites the Director to engage in shenanigans by applying proposed rules retroactively to this IPR, contrary to the Office's own binding precedent and prior to the Office even completing the notice-and-comment rulemaking process. The Director should decline to do so.

IV. 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. This IPR should be instituted.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that true copies of Petitioner's Sur-Reply Brief Opposing Discretionary Denial and Exhibits 1065-1069 were served upon the below-listed counsel by electronic mail:

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