

From: [Director Discretionary Decision](#)
To: gilfordb@gtlaw.com
Cc: [Director DI](#); [Trials](#); [Director Discretionary Decision](#); kaiser-ptab@perkinscoie.com; marando-ptab@perkinscoie.com; baitchev_ptab@perkinscoie.com; imaginear_perkins@perkinscoie.com; lukasj@gtlaw.com; levinsteinm@gtlaw.com; bokare@gtlaw.com
Subject: RE: IPR Nos. 2025-01273, -01274, -01275, and -01276: Request for Authorization for a Reply
Date: Thursday, October 30, 2025 10:53:31 AM
Attachments: [image001.png](#)

Patent Owner is authorized to file a 5-page reply in IPR2025-01273, -01274, -01275 and -01276 due no later than Monday, November 3, 2025, limited to addressing the arguments raised below. Petitioner is authorized to file a 5-page sur-reply due no later than Wednesday, November 5, 2025.

From: gilfordb@gtlaw.com <gilfordb@gtlaw.com>
Sent: Wednesday, October 29, 2025 7:08 PM
To: Director_DI <Director_DI@uspto.gov>; Trials <Trials@USPTO.GOV>
Cc: kaiser-ptab@perkinscoie.com; marando-ptab@perkinscoie.com; baitchev_ptab@perkinscoie.com; imaginear_perkins@perkinscoie.com; lukasj@gtlaw.com; levinsteinm@gtlaw.com; bokare@gtlaw.com
Subject: RE: IPR Nos. 2025-01273, -01274, -01275, and -01276: Request for Authorization for a Reply

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Dear Director Squires,

Patent Owner ImagineAR, Inc. ("Patent Owner") respectfully requests leave to file a short reply brief not exceeding five (5) pages in support of Patent Owner's requests for discretionary denial in IPR Nos. 2025-01273, -01274, -01275, and -01276.

Good cause exists for Patent Owner's request because of several significant developments that arose, and new evidence that was produced, after Patent Owner filed its discretionary denial briefs on September 22, 2025 (Paper No. 7), including but not limited to:

- (i) the court in the parallel district court litigation (*ImagineAR, Inc. v. Niantic, Inc.*, Case No. 1:24-cv-01252-JDW (D.Del.) (the "Litigation")) entered a scheduling order that now makes clear that the Litigation will reach a validity determination well before any final written decision in the IPRs (Litigation, Dkt. No. 88);
- (ii) Patent Owner has received new documents that Petitioner previously concealed in the Litigation that further show Petitioner's top executives had prior knowledge of, and conducted analyses regarding, the challenged patents in 2018 and before filing these IPRs, which is relevant to the settled expectations factor that the Director considers in exercising discretion under 35 U.S.C. § 314(a) and further demonstrates that Petitioner's IPR challenges were not a reaction to newly discovered prior art or unforeseen

circumstances, but rather a strategic, belated attempt to relitigate validity issues already within its knowledge and consideration for years; and

- (iii) the October 17, 2025, Proposed Rulemaking on Required Stipulations (to amend 37 C.F.R. part 42) that the USPTO issued and which would, among other things, mandate IPR denial where a petitioner did not stipulate to forego other validity challenges in parallel district court litigation and would also require denial of Petitioner's petitions because Petitioner's *Sotera*-style stipulation does not preclude Petitioner from continuing to challenge validity in the Litigation.

In light of the October 17, 2025, Memorandum Transferring Institution Authority to the Director, a short reply brief to address and introduce these new developments and evidence and show how they further support that the Director should exercise its authority to discretionarily deny Petitioner's petitions is warranted. A reply will also allow the Director to have a complete and current record to review.

Counsel for Patent Owner has conferred with counsel for Petitioner, and counsel for Petitioner has provided the following response:

Petitioner opposes Patent Owner's request for a reply on discretion because none of the three items Patent Owner identifies demonstrate good cause for a reply. If the Director were to authorize a reply (which he should not), Petitioner requests it be authorized to file a sur-reply of equal length.

Initially, despite the fact that the "new" events to which Patent Owner refers occurred weeks ago, Patent Owner first disclosed this request to Petitioner today and demanded a position and response within hours. Petitioner does not agree that good cause exists for a reply. As to each specific category:

- i. The scheduling order to which Patent Owner refers is already in the record in each IPR (Ex. 1052) and issued three weeks ago, on October 8. The schedule was almost entirely based on an agreed-upon joint submission (also in the IPR record at Ex. 2006) filed by the parties over five months ago, on May 9, 2025. Thus, PO had the ability to and did address the schedule in its discretion request. It is not clear what "validity determination" Patent Owner believes the district court will reach, as there is no such process set out in the scheduling order.
- ii. Patent Owner's assertion of "concealed" evidence is inappropriate and false. The productions to which it refers are 1) a production by Petitioner over three weeks ago, on October 3, that related to the same types of broker discussions and potential patent sales the parties have already addressed in the discretionary briefing, and 2) a production by a third party to Patent Owner nearly two weeks ago, on October 17, that Petitioner understands is similar but has not yet reviewed, because Patent Owner just shared with Petitioner the roughly 700-page third-party production this evening despite receiving it weeks ago (and sending this request and demanding a response today). Petitioner also notes that the earliest of the challenged patents had not even issued in 2018. Further, during the meet and confer process, Petitioner asked Patent Owner to

- identify even one document produced after the discretion request that showed good cause for a reply, and Patent Owner refused to do so.
- iii. The NPRM does not establish good cause for further briefing. The Director is well aware of the proposed rules already, which are not yet in effect. Any argument by Patent Owner on the proposed rules now would be speculation as to what rules will actually be promulgated at some later date.

Respectfully requested,

Benjamin Gilford
Shareholder

Greenberg Traurig, LLP
90 South 7th Street | Suite 3500 | Minneapolis, MN 55402
T +1 612.259.9683 | C 847.431.2364
gilfordb@gtlaw.com | www.gtlaw.com | [View GT Biography](#)



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