

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIVEINTENT, INC.,
Petitioner

v.

DATONICS LLC AND ALMONDNET, INC.,
Patent Owner

Case IPR2025-01318
U.S. patent No. 10,984,445

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

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EXHIBITS

EX1001	U.S. patent No. 10,984,445 to Shkedi (“the ’445 patent”)
EX1002	Excerpts from the Prosecution History of the ’445 patent (“the Prosecution History”)
EX1003	Declaration and Curriculum Vitae of Dr. Michael Mitzenmacher
EX1004	U.S. Pub. No. 2005/0165644 to Gil Beyda <i>et al.</i> (“Beyda”)
EX1005	U.S. Pub. No. 2009/0254971 to Frederick S. M. Herz <i>et al.</i> (“Herz”)
EX1006	U.S. Pat. No. 7,949,562 to Robert J. Collins
EX1007	U.S. Pub. No. 2005/0096979 to Ross Koningstein
EX1008	August 25, 2025 Stipulation
EX1009	Complaint dated March 30, 2016, <i>AlmondNet, Inc. et al v. Yahoo! Inc.</i> , Case No. 1-16-cv-01557 (EDNY)
EX1010	Docket Entries for <i>AlmondNet, Inc. et al v. Yahoo! Inc.</i> , Case No. 1-16-cv-01557 (EDNY)
EX1011	Docket Entries for <i>AlmondNet, Inc. v. Oath Holdings Inc.</i> , Case No. 1-19-cv-00247 (DDE)
EX1012	Notice of Allowance dated Jun. 6, 2012 from U.S. Patent Application No. 11/765,433
EX1013	U.S. Patent No. 8,280,758
EX1014	Non-Final Office Action dated Sep. 15, 2016 from U.S. Patent Application No. 14/080,999
EX1015	Non-Final Office Action dated Aug. 3, 2020 from U.S. Patent Application No. 16/425,259
EX1016	Notice of Allowance dated October 4, 2018 from U.S. Patent Application No. 15/822,974

EX1017	U.S. patent No. 10,134,054
EX1018	U.S. patent No. 11,093,970
EX1019	Information Disclosure Statement dated May 29, 2019 from U.S. Patent Application No. 16/425,259
EX1020	U.S. Patent No. 10,475,073
EX1021	Form 1449 (initialed IDS) dated August 3, 2020 from U.S. Patent Application No. 16/425,259
EX1022	Complaint dated July 18, 2024, <i>AlmondNet, Inc. et al v. LiveIntent, Inc.</i> , Case No. 1-24-cv-00831 (DDE)
EX1023	U.S. Patent No. 8,677,398
EX1024	U.S. Patent No. 8,959,146
EX1025	U.S. Patent No. 8,494,904
EX1026	Information Disclosure Statement dated February 28, 2019 from U.S. Patent Application No. 16/194,203
EX1027	Information Disclosure Statement dated January 24, 2020 from U.S. Patent Application No. 16/678,196
EX1028	Docket Entries for <i>AlmondNet, Inc. et al v. LiveIntent, Inc.</i> , Case No. 1-24-cv-00831 (DDE)

I. INTRODUCTION

The Patent Trial and Appeal Board (Board) is uniquely suited to assess the patentability of the challenged claims of the '445 patent. The '445 patent is part of a family of six U.S. applications with four issued patents that claim overlapping subject matter, and Patent Owner continues to expand the family.¹ Moreover, during prosecution, Applicant cited the prior art from several other patent families by the same inventor spanning dozens of applications and issued patents. *See* EX1002, 628. The prosecution histories of these patents tell a simple story for those familiar with patent prosecution. In examining the '445 patent, the Examiner failed to consider two disclosures, one of which was highlighted to the Examiner by the Applicant and the other of which was cited by another Examiner in a related application as particularly relevant to very similar subject matter. Had the Examiner simply considered these disclosures—Beyda (EX1004) and Herz (EX1005)—the Examiner should have known about prior to issuing the '445 patent, the Examiner would have determined that the '445 patent claims are unpatentable. This failure amounts to a pervasive material error that the Patent Office is best equipped to understand. Such a material error favors referral.

¹ *See, e.g.*, pending family member 17/401,052.

Patent Owner's alleged settled expectations are negated by this material error, and by its failure to directly cite Herz (EX1005) during prosecution of the application that issued as the '445 patent, despite having cited Herz in a related family and having notified the Examiner of this related family in every other application in the '445 patent family, except the application that led to the '445 patent. Further still, the '445 patent only issued within the last five year.

The Board's review of the '445 patent would also represent the most efficient allocation of judicial and administrative resources. In addition to the significant errors that occurred during examination of the '445 patent family, Patent Owner has asserted in a parallel district court litigation three other patents with divergent subject matter, creating a complicated technological backdrop ill-suited for a district court. The Board's technical expertise and familiarity with patent law and examination make it the optimal forum to address and simplify this complexity.

Furthermore, the parallel district court litigation is in its infancy, and LiveIntent (Petitioner) has filed a broader-than-*Sotera* stipulation to prevent overlap of issues between this *Inter Partes* Review (IPR) and that litigation.

Under these circumstances, allocating Patent Office resources to review the '445 patent would allow the Patent Office to correct its own material errors and

avoid unnecessary burden on the district court, which has been drawn into the dispute between Petitioner and Patent Owner because these material errors led to the improper issuance of the '445 patent. Referral to the Board is therefore appropriate.

II. The '445 Patent Issued Only As A Result Of The Examiner's Material Error During Prosecution, Thus Justifying Referral Of The Petition.

Material error during patent prosecution strongly favors granting review over discretionary denial. Correcting such errors is critical, often overriding a Patent Owner's settled expectations or factors supporting a *Fintiv* denial. For settled expectations, see *Anthony, Inc. v. ControlTec, LLC* ("*Anthony*"), IPR2025-00559, Paper 12, at 2 (PTAB July 16, 2025) (strong settled expectations in patents that have been in force for approximately 18 and 17 years overcome by a material error showing, making it "an appropriate use of Office resources to review the potential error."); *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12, at 2-3 (PTAB July 17, 2025) (petition issued as a result of a "material error" was referred to panel despite strong expectations in a nine-year-old patent); *Eunsung Global Corp. v. Hydrafacial LLC* ("*Eunsung*"), IPR2025-00445, Paper 14, at 2 (PTAB July 10, 2025) (petition referred despite an eight-year-old patent). For *Fintiv*, see *Microsoft Corporation v. Partec Cluster Competence Center GMBH*, IPR2025-00318, Paper 9, at 2 (PTAB June 12, 2025) (petition referred despite trial one month before Final Written Decision due to Examiner's oversight of prior art); *Padagis v. Neurelis*,

Inc., IPR2025-00464-466, Paper 12, at 2-3 (PTAB July 16, 2025) (petition referred despite trial five months prior due to Examiner’s contradiction of prior Board priority date ruling). *See also Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11, at 2 (PTAB June 12, 2025); *Microsoft Corp. v. XI Discovery, Inc.*, IPR2025-00253, Paper 13, at 2 (June 25, 2025).

As explained in §§IV-VI below, Patent Owner has no settled expectations and *Fintiv* denial is plainly inappropriate. Even if this were not the case, however, referral to the merits panel would still be appropriate to allow the Board to correct a material error that occurred during prosecution of the ’445 patent.

The Ground set forth in the Petition demonstrates the obviousness of the Challenged Claims based upon two prior art references: Beyda (EX1004) and Herz (EX1005). The Examiner failed to apply either of these references in any rejections against the claims of the ’445 patent, despite being aware of the materiality of the Beyda reference and having should been aware of the Herz reference.

A. Applicant Specifically Highlighted the Relevance of Beyda to the Examiner

The applicant cited the Beyda reference in an Information Disclosure Statement (IDS) filed with the application on February 9, 2018. EX1002, 617. However, applicant went even further in highlighting the relevance of Beyda to the Examiner. In a “Supplemental Information Disclosure Statement” filed on May 10, 2018—over a month before the Examiner issued his first Office Action—applicant

notified the Examiner that Beyda was one of several references relied upon by a defendant in a co-pending litigation² to allege invalidity of the claims of “a parent patent.” EX1002, 500. And the applicant explained to the Examiner that the defendant particularly focused on Beyda (“chart D-8”) among three other references, suggesting it was “closest to the claims of the parent patent.” EX1002, 500-501. Applicant encouraged that “the examiner should review them and reach his own conclusions.” EX1002, 501. Nonetheless, the Examiner did not rely upon Beyda in any of his rejections, nor did he seek to explain why he had found the claims distinguished over Beyda. *See generally* EX1002.

That the defendant in that litigation identified Beyda as particularly relevant to validity is unsurprising, as the parent application publication of Beyda was cited in the Notice of Allowance of parent U.S. application No. 11/765,433 (the ’433 application). EX1012, 6-7. The ’433 application was the original application filed in

² Though not specifically identified in the IDS, the litigation appears to be *Almond-Net, Inc. et al v. Yahoo! Inc.*, Case No. 1-16-cv-01557 (EDNY), in which parent U.S. patent No. 8,244,574 was asserted. EX1009, 11. This litigation was transferred to the District of Delaware, where AlmondNet dismissed the litigation before any findings regarding validity. *See* EX1010, 10; EX1011, 10-11.

the family of which the '445 patent is a child. *See* EX1001, 1:8-15. The '433 application issued as U.S. Patent No. 8,280,758 (*see* EX1001, 1:8-15), the claims of which are very similar to those of the '445 patent. *Compare* EX1013, 14:30-55 *with* EX1001, 14:60-15:28. The Examiner of the '433 application (Donald Champagne) found that the parent application publication to Beyda (U.S. Pub. No. 2005/0125289) disclosed all of the limitations of the allowed claims except “select[ing] a first of a plurality of electronic-advertising-space-controlling entities.”³ EX1012, 6-7. Yet, despite this clear indication of pertinence, the Examiner of the '445 patent (Michael J. Sittner—a different examiner) never utilized Beyda in any rejections or sought to explain any distinctions between it and the claims of the '445 patent. *See generally* EX1002.

Instead, the Examiner Sittner focused his analysis on U.S. Pub. Nos. 2007/0067297 (Kublickis), 2007/0130005 (Jaschke), and 2005/0097204 (Horowitz). *See* EX1002, 11, 419, 432, 470, 482. These are the same references Examiner Sittner relied upon in nearly every prior-art-based rejection of claims in the

³ The Petition relies upon a combination with Herz for a similar limitation of the '445 patent. *See* Petition, 38-42 (addressing limitation [1.b.i], which recites, in part, “automatically select[ing] a media property entity of a plurality of media property entities”)

family of the '445 patent since he took over examination of the patent family. *See, e.g.,* EX1014, 10; EX1015, 6. It is clear that Examiner Sittner became particularly focused on the Kublickis and Jaschke to the exclusion of other highly relevant references, such as Beyda. This constitutes the Examiner's **first material error**.

B. The Examiner Should Have Been Aware of Herz

Herz was never directly cited by either the Examiner or the Applicant during original prosecution of the '445 patent. *See* EX1001, pp. 2-5 (listing "References Cited"). However, the Examiner should have been aware of Herz, and the Examiner's failure to identify and consider Herz constitutes the Examiner's **second material error**.

Specifically, Herz was cited by an examiner in a Notice of Allowance for U.S. application No. 15/822,974 (the '974 application). EX1016, 16. The '974 application is from the same inventor as the '445 patent: Roy Shkedi. EX1016, 1; EX1017, p. 1. Herz was one of only nine references cited by that examiner in the Notice of Allowance, in which he reviewed "the closest prior art of record." *See* EX1016, 6-16. The '974 application issued as U.S. patent No. 10,134,054. EX1017, p. 1.

The '054 patent was listed in a PLUS search conducted by Examiner Sittner with respect to the '445 patent on July 26, 2019. *See* EX1002, 281. The PLUS search explains that it is "a list of patents that are most closely related linguistically

to the application searched.” *Id.* (emphasis added). Had Examiner Sittner considered the ’054 patent, he would have seen that it is by the same inventor and contains claims related to tagging computers in order to track visitors across media properties, similar to the ’445 patent. *Compare* EX1017, 13:13-56 with EX1001, 14:60-15:28. It would have been prudent for the Examiner, seeing these distinct similarities called out by his own PLUS search, to look into the nine prior art references cited by the different examiner of the ’054 patent, which are starred on the first few pages of the ’054 patent. *See* EX1017, pp. 1-6 (noting “* cited by examiner”).

(56)		References Cited	
U.S. PATENT DOCUMENTS			
2007/0179853	A1	8/2007	Feige et al.
2007/0192166	A1	8/2007	Van Luchene
2007/0192168	A1	8/2007	Van Luchene
2007/0198385	A1	8/2007	McGill et al.
2007/0203794	A1	8/2007	Hajdukiewicz et al.
2007/0214048	A1	9/2007	Chan et al.
2007/0260624	A1	11/2007	Chung et al.
2008/0052392	A1	2/2008	Webster et al.
2008/0109306	A1	5/2008	Maigret et al.
2008/0319850	A1	12/2008	Shaul et al.
2009/0049468	A1	2/2009	Shkedi
2009/0106100	A1	4/2009	Mashinsky
2009/0172723	A1	7/2009	Shkedi et al.
2009/0222329	A1	9/2009	Ramer et al.
2009/0234711	A1	9/2009	Ramer et al.
2009/0234861	A1	9/2009	Ramer et al.
2009/0254971	A1 *	10/2009	Herz G06Q 10/10 726/1

EX1017, p. 4.

Moreover, Examiner Sittner should have been aware of Herz through his review of other members of the ’445 patent family. For example, U.S. application No. 16/425,259 (the ’259 application) issued as U.S. patent No. 11,093,970 and is

a child of the '445 patent. EX1018, p. 1. The '259 application was also examined by Examiner Sittner. *See* EX1018, p. 1; EX1002. In examining the '259 application, Examiner Sittner received and reviewed an IDS that stated “Assignee also wishes to direct Examiner to the applications listed in the table below, which share the same first inventor, as well as the references cited therein,” and listed nine applications. EX1019, 1. One of the nine applications was U.S. application No. 16/194,203—a child application of the '054 patent that issued as U.S. patent No. 10,475,073. *Id.*; EX1020, p. 1. One of the references cited in the '054 patent was Herz. EX1020, p. 4 (listing Herz under “References Cited”). Examiner Sittner initialed the IDS that requested he review the references cited in the '054 patent on August 3, 2020, and yet did not rely upon Herz in any of his rejections or otherwise seek to distinguish the claims of the '445 patent from Herz. *See* EX1021.

In other words, the same Applicant (and indeed the same prosecuting attorney) of the '445 patent asked Examiner Sittner to review a related application that cited Herz seven months before Examiner Sittner issued the Notice of Allowance for the '445 patent. *See* EX1002, 56-72. Thus, the Examiner should have known of Herz and should have considered it before allowing the '445 patent. Had he done so, he would have seen what is apparent from the Petition: Beyda and Herz render the claims of the '445 patent obvious.

C. The Material Errors During Prosecution of the '445 Patent Warrant Referral

These significant errors—failing to consider key prior art references of which the Examiner was aware or clearly should have been aware—strongly weighs against discretionary denial and independently justifies referring the Petition to the merits panel. Indeed, the Director has referred petitions to the merits panel under similar and even less compelling circumstances.

For example, in *Anthony*, the Board stated that, “[a]lthough the challenged patents have been in force for approximately 18 and seventeen years, Petitioner appears to show a material error by the Office and it is an appropriate use of Office resources to review the potential error.” *Anthony*, 2. In *Anthony*, the Director referred the patent to the merits panel due to the examiner’s inadequate and incomplete prosecution. And the deficiency of that search was revealed by the examiner’s failure to identify and consider the Carter reference, which was shown by the petitioner to disclose the allowable subject matter. Here, the Examiner’s deficient search is even more evident than in *Anthony*, as Beyda was specifically called out to the Examiner by the Applicant during prosecution and Herz was cited prominently in a related family of patent applications from the same inventor. And yet the Examiner clearly overlooked the teachings of those references by failing to consider them with respect to the '445 patent. Further, in *Eunsung*, the challenged

patent, which had been in force for 8 years, was referred to the merits panel because the Examiner overlooked certain teachings in a prior art reference that disclosed the allowable features of the challenged claims. *Eunsung*, 2. By overlooking the teachings of Beyda and Herz and their demonstration that the Challenged Claims are obvious, the Office committed a similar material error “and it is an appropriate use of Office resources to review the potential error.” *Anthony*, 2.

III. BOARD REVIEW WOULD STREAMLINE COMPLEX ISSUES IN THE CO-PENDING DISTRICT COURT LITIGATION.

AlmondNet’s assertion of a “large number and vast scope of [] patents” directed toward “a diverse range of subject matter” in the parallel district court proceeding is the precise situation for which “the Board is better suited to review” issues of validity. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9, at 2-3 (Jun. 13, 2025). The ’445 patent is one of four patents originally asserted in the district court litigation, and the other three patents are in unrelated families and cover subject matter distinct from the ’445 patent. EX1022, 1.

For example, the ’445 patent is related to delivering an advertisement to a visitor device as a result of comparing (1) a visitor profile linked to a visitor device by a tag and (2) stored requests from media property entities. EX1001, 15:3-14. However, the ’398 patent is related to causing an action to be performed on a second electronic device (e.g., displaying an advertisement) in response to recognizing that a second electronic device is connected to the same local area network as a

first electronic device. EX1023, 24:49-54. The '146 patent is related to displaying an advertisement to an electronic visitor on a second media property based on a profile attribute correlated with the advertisement being received after the electronic visitor visits a first media property. EX1024, 12:64-13:5. And the '904 patent is related to receiving a URL-redirected partial profile for use with delivering third-party advertisements. EX1025, 16:61-17:5.

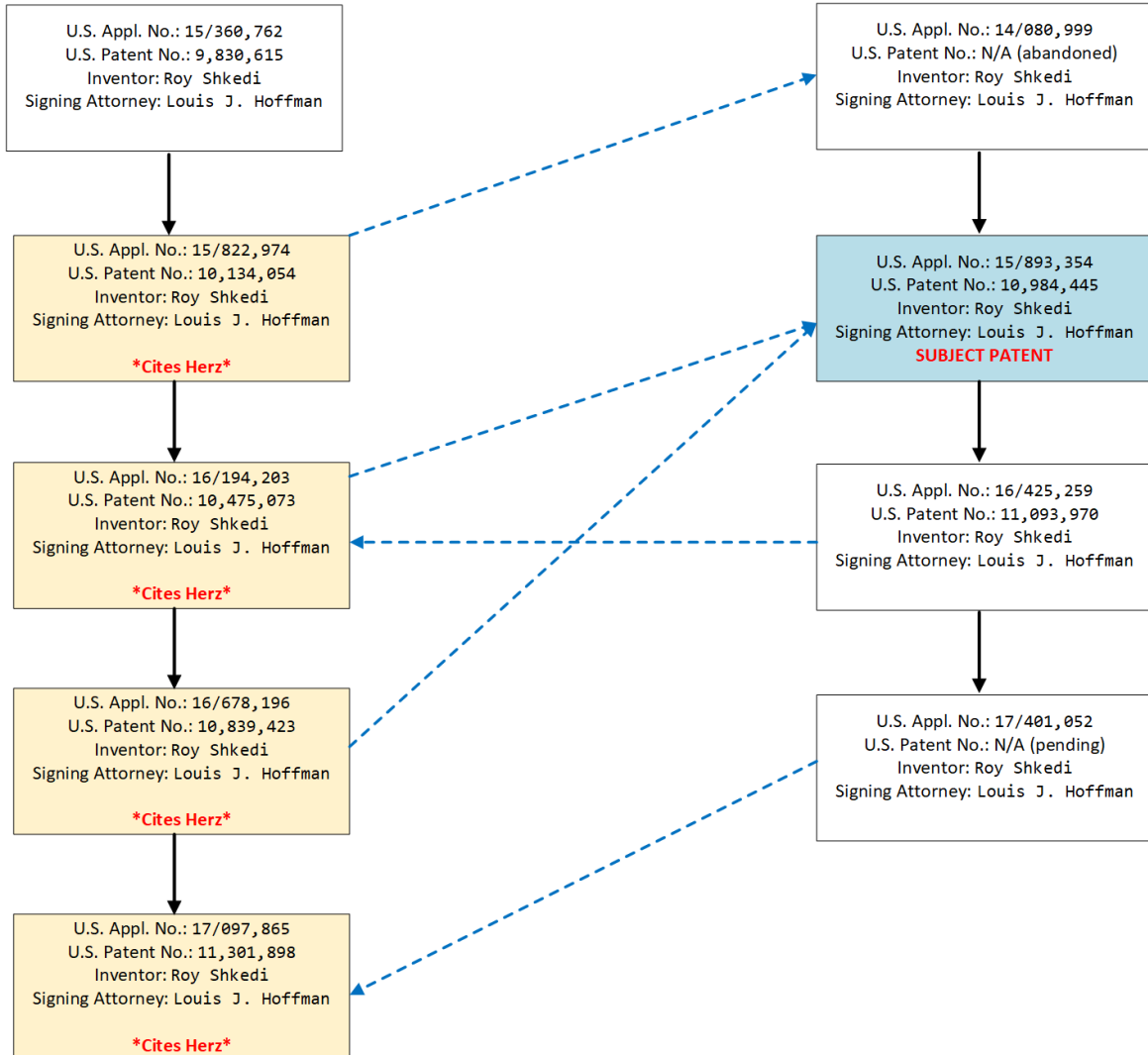
Although all related to electronic advertising, these patents focus on a broad array of complex and disparate subject matter within electronic advertising. Such diverse technology in the district court litigation favors institution, as institution here would help narrow the issues in the co-pending litigation, ultimately conserving resources of the parties, the judiciary, and the Board.

IV. THERE EXIST NO SETTLED EXPECTATIONS WITH RESPECT TO THE '445 PATENT.

Patent Owner's claim of settled expectations for the '445 patent is undermined by their failure to cite Herz during prosecution despite clear evidence it knew of Herz. More importantly, the '445 patent issued within the last five years, an insufficient amount of time to have developed settled expectations.

As explained above, the Applicant (*i.e.*, Patent Owner) of the '445 Patent knew about Herz well before issuance of the '445 Patent, yet did not cite Herz to the Examiner. Patent Owner knew of Herz at least as early as the Notice of Allowance that led to the '054 Patent, where the examiner reviewed a short list of "the

closest prior art of record” that included Herz. *See* EX1016, 6-16. That Notice of Allowance was addressed to LOUIS J. HOFFMAN, P.C., the firm of the same attorney that prosecuted the ’445 Patent on behalf of Patent Owner. EX1016, 1, *see generally* EX1002. As shown in the following diagram, Patent Owner and their attorney knew that the family of the ’445 Patent and the family of the ’054 Patent were sufficiently related as to cross-cite the families in IDSs filed in many of the respective applications.



Yet, despite citing the application that issued as the '445 Patent in IDSs in two applications in the family of the '054 patent, Patent Owner conspicuously did not cite any members of the family of the '054 patent in the application that issued as the '445 patent. In other words, Patent Owner left the Examiner of the '445 patent completely on his own to find the family of the '054 patent in which Herz was cited, despite having directed another examiner of members of the '054 patent family to the application that issued as the '445 patent. *See* EX1026, 1 (citing U.S. Application No. 15/893,354); EX1027, 1 (same). This demonstrates knowledge of relevance, and yet failure to cite, a related patent family and the key references cited in it (including Herz). This knowing failure should quash any settled expectations.

Furthermore, the '445 patent issued in 2021, and thus, has been in force for less than six years – not long enough to establish a legitimate claim to settled expectations, much less strong settled expectations. *See, e.g., Advanced Micro Devices, Inc. et al. v. Concurrent Ventures, LLC et al., IPR2025-00479* at 2 (“Additionally, the challenged patent issued in **2021**, and Patent Owner has not developed strong settled expectations that favor discretionary denial”), at 3; *Zhuhai Cosmx Battery Co. LTD. v. NingDe Amperex Technology Limited, IPR2025-00385*, Pap. 9 at 2 (“the challenged patents have not been in force for a significant period of time

(issued in 2024, 2023 and **2021**), and, accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial.” (emphasis added)). Indeed, relative to the recent issuance, post grant challenges to such young patents have been consistently characterized as “early” and “favor[ing] robust, predictable patent rights and weigh[ing] against discretionary denial.” *See Micron Technology, Inc. v. Yangte Memory Technologies Co. Ltd.*, IPR2025-00190, Pap. 21 at 3 (PTAB June 25, 2025) (patent issued in 2021 deemed “issued recently.”). While Patent Owner notes that an early family member of the ’445 Patent issued October 2, 2012, Patent Owner chose not to assert that patent against Petitioner, so the age of that unasserted patent should play no roll in assessing the settled expectations of an asserted patent. *See* EX1022, 1.

There is another petition pending against the ’445 Patent filed by Amazon: IPR2025-00873. Amazon’s petition was filed three months before the petition in this case. This is roughly the same amount of time between when Amazon and Petitioner were served with complaints identifying the ’445 Patent. The petition in this case was filed before Patent Owner’s discretionary denial brief was due in that case⁴ and over a month before the POPR was due, so there was no opportunity for

⁴ This petition was filed on July 18, 2025, and the discretionary denial brief in IPR2025-00873 was due on July 21, 2025.

Petitioner to use the Amazon IPR to “playbook” in preparing this petition. Moreover, the Amazon petition and the petition in this case rely upon entirely different prior art, further mitigating any chance to “playbook.” Indeed, because the Amazon petition addresses different prior art, institution of that IPR would not address the material errors identified in Section II, *supra*. Accordingly, the Amazon petition should not weigh against referral of this petition—nor does Patent Owner argue it should.

V. NEITHER THE PETITION’S EXPERT TESTIMONY NOR ITS RELIANCE ON OBVIOUSNESS GROUNDS FAVORS DISCRETIONARY DENIAL.

Patent Owner argues that the petition’s extensive expert testimony favors discretionary denial, as district courts better assess witness credibility. Paper 7 (“DD”), 6-7. However, Patent Owner states that the expert merely “explain[s] the relevance of the prior art,” and Patent Owner does not even assert that the petition relies on expert testimony to fill gaps in prior art for one simple reason: no such gaps exist. DD, 4. Further, the declaration complies with the Consolidated Trial Practice Guide (TPG), establishing the level of skill in the art, explaining prior art teachings, and providing reasons to combine references without substituting for prior art disclosures. *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00377, Paper 10, at 2 (PTAB June 6, 2025); TPG 34-36; VLI-1003, *generally*. Thus, the expert testimony does not support denial.

Patent Owner's claims that the petition's relies on obviousness (§ 103) rather than anticipation (§ 102) is similarly unavailing. DD, 12. The statutory basis does not determine the challenge's merits, which depend on the strength of facts and law. Patent Owner identifies no evidentiary or legal flaws in the petition's prior art or arguments. Thus, the use of obviousness does not favor discretionary denial.

VI. THE *FINTIV* FACTORS DO NOT FAVOR DISCRETIONARY DENIAL.

Every *Fintiv* factor is either neutral or weighs against discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

A. Factors 1 and 5: No Stay Has Been Requested, and the Same Parties Are in the Co-Pending Litigation.

Factors 1 and 5 are neutral. No litigation stay has been requested in the LiveIntent trial. Further, the parties in the co-pending litigation and this IPR are the same.

B. Factors 2-3: The Court's Trial Date Would Occur Well After the Final Written Issue Is Issued, and Limited Resources Would Have Been Expended by Institution.

Factors 2 and 3 favor referral and, at worst, are neutral. The LiveIntent trial is scheduled for October 4, 2027. EX1028, 5. The Final Written Decision is expected in late January, 2027—well before the scheduled trial date. Indeed, Patent Owner and Petitioner have not exchanged infringement or invalidity contentions,

proposed terms for claim constructions, or scheduled depositions. Claim construction briefs are due September 25, 2026, fact discovery is not expected to be completed until August 28, 2026, and opening expert reports are not due until January 15, 2027. EX1028, 5.

C. Factor 4: There Is No Overlap Between the Issues in the Petition and the District Court Proceeding.

Factor 4 strongly favors institution. In Patent Owner's view, Petitioner's broader-than-*Sotera* stipulation is insufficiently broad because it permits Petitioner to raise an invalidity ground based on system prior art in combination with prior art that reasonably could have been raised in this IPR proceeding. DD, 9-11. But the breadth of Petitioner's stipulation is identical to the breadth of stipulations in other proceedings where the Director determined the stipulations weighed against discretionary denial. *See Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9, at 2 (PTAB June 13, 2025); *Tesla*, IPR2025-00217, Paper 8, at 10-11 (PTAB May 27, 2025) (stipulation having same breadth as Petitioner's stipulation); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00341, Paper 12, at 2 (PTAB June 13, 2025); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00341, Paper 10, at 10-11 (PTAB May 27, 2025) (stipulation having same breadth as Petitioner's stipulation). Patent Owner's observation that the stipulation *could* be even broader does not alter the conclusion that Petitioner's stipulation weighs against discretionary denial.

Patent Owner claims Petitioner's broader-than-*Sotera* stipulation allows subsequent *ex parte* reexamination requests, potentially causing inefficiencies. DD, 10-12. However, this is irrelevant to inefficiencies with respect to co-pending district court litigation and speculative, as no such reexamination exists. Statutory and administrative mechanisms mitigate inefficiencies: estoppel under 35 U.S.C. § 315(e)(1) prevents Petitioner from raising IPR grounds in later reexaminations; the Director can manage concurrent proceedings under 35 U.S.C. § 314(d); and the patent Office can deny abusive reexamination requests under 35 U.S.C. § 325(d). *In re Vivint, Inc.*, 14 F.4th 1342, 1354 (Fed. Cir. 2021). Thus, an even broader stipulation is unnecessary.

D. Factor 6: Other Circumstances Weigh in Favor of Referral.

Factor 6 strongly favors referral. As discussed above, contrary to Patent Owner's assertion, the Petition's reliance on obviousness grounds has no bearing on the merits of unpatentability. DD, 12-13; *see supra* Section V. The Petition's merits are strong at least because it offers compelling evidence as to why the prior art teaches all features of the Challenged Claims of the '445 patent. *See supra* Section II. And the other factors raised in Patent Owner's briefing—including settled expectations and expert testimony—do not favor discretionary denial, as discussed above. DD, 4-5; *see supra* Section IV. In fact, other factors, such as material error and litigation complexity, favor referral. *See supra* Sections II-III.

VII. CONCLUSION

For these reasons, a holistic evaluation of the record strongly weighs against discretionary denial. Petitioner therefore respectfully requests that this case proceed to an institution determination on the merits.

Respectfully submitted,

Dated October 31, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on October 31, 2025, a complete and entire copy of this Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and Accompanying Exhibits were provided by email to the Patent Owner by serving the correspondence email address of record as follows:

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