

UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT TRIAL AND APPEAL BOARD

BOE TECHNOLOGY GROUP CO., LTD.

Petitioner

v.

BISHOP DISPLAY TECH LLC

Patent Owner

Case No. IPR2025-01330

Patent No. 7,995,047

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

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EXHIBIT LIST

Ex.	Description of Documents
1001	U.S. Patent No. 7,995,047 (“’047”)
1002	File History of U.S. Patent No. 7,995,047 (“’047FH”)
1003	Declaration of Dr. Alex Kattamis in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 7,995,047 (“Kattamis”)
1004	U.S. Patent Pub. No. 2006/0170629 (“Baek”)
1005	U.S. Patent Pub. No. 2005/0231241 (“Date”)
1006	International Patent Pub. No. WO2006/080260 (“Inomoto”)
1007	U.S. Patent Pub. No. 2005/0017765 (“Sasaki”)
1008	Docket Control Order, <i>Bishop Display Tech LLC v. BOE Technology Group Co., Ltd.</i> , No. 2:25-CV-00310-JRG (E.D. Tex. Jul. 23, 2025)
1009	John A. Camara, ELECTRICAL ENGINEERING REFERENCE MANUAL FOR THE ELECTRICAL AND COMPUTER PE EXAM, 6th ed. (Professional Publications, Inc.: 2002), ISBN: 1-888577-56-8 (“Camara”)
1010	Willem den Boer, ACTIVE MATRIX LIQUID CRYSTAL DISPLAYS, 1st ed. (Newnes: 2005), ISBN: 0-750678-13-5 (“den Boer”)
1011	M.K. Han, “AM backplane for AMOLED,” Proc. Of ASID 6 (Oct. 8-12, 2006): 53-58 (“Han”)
1012	U.S. Patent Pub. No. 2006/0227091 (“Nohtomi”)
1013	U.S. Patent Pub. No. 2006/0255787 (“Schaffer”)
1014	U.S. Patent Pub. No. 2003/0025120 (“Chang”)
1015	U.S. Patent No. 7,221,349 (“Hashido”)
1016	Motion Success for Stay Pending IPR (Post-Institution) (E.D. Tex.), DOCKETNAVIGATOR (last visited October 28, 2025)

Ex.	Description of Documents
1017	<i>SEVEN Networks, LLC v. Apple Inc.</i> , Case No. 2:19-cv-115-JRG, Dkt. 313 (E.D. Tex. Sept. 22, 2020)
1018	First Amended Docket Control Order, <i>Bishop Display Tech LLC v. BOE Technology Group Co., Ltd.</i> , No. 2:25-CV-00310-JRG, Dkt. 37 (E.D. Tex. Aug. 21, 2025)
1019	United States District Courts – Judicial Caseload Profile, Eastern District of Texas, Mar. 31, 2025, https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0331.2025.pdf
1020	Complaint, <i>Bishop Display Tech LLC v. BOE Technology Group Co., Ltd.</i> , No. 2:25-CV-00310-JRG, Dkt. 1 (E.D. Tex. Mar. 20, 2025)
1021	U.S. District Court for the Eastern District of Texas Calendar Events Set for 1/11/2027 for Judge Rodney Gilstrap

Other than the prosecution history, Ex. 1002, all citations to exhibits reference original page numbers found in the underlying document. Unless noted, all emphases are added.

I. INTRODUCTION

Discretionary denial is not warranted. The Petition demonstrates (and Patent Owner (“PO”) has not provided any contrary argument) that each element of every claim is found in the prior art. The ’047 patent never should have issued.

First, the Examiner made several material errors during prosecution, each alone sufficient to deny PO’s discretionary denial request. The Examiner erred by failing to identify that Hashido (Ex. 1015), a reference applied during prosecution, disclosed the exact limitations the Examiner believed was missing to allow the ’047 patent. The Examiner also erred by failing to find the other anticipatory reference applied in the Petition, namely Baek (Ex. 1004), which also discloses the allegedly missing limitation. These anticipatory references exemplify the strength of the Petition and the Examiner’s material error in finding the claims novel over the prior art. These material errors outweigh any settled expectations PO has in the ’047.

Second, the *Fintiv* factors do not support discretionary denial. Upon institution, BOE intends to seek to sever and stay the ’047 patent from the Texas Litigation, which Judge Gilstrap has done in previous cases. There is still much work to be done in the district court, as the case is at a very preliminary stage with no case milestones occurring until after an institution decision is expected in this IPR by February 5, 2026. Indeed, a claim construction hearing is scheduled for July 20, 2026, and district court trial is scheduled for January 11, 2027. While the trial

is currently scheduled the month before a final written decision is expected in this IPR (February 5, 2027), it is unlikely the trial date will hold. Time-to-trial statistics and the fact that eight other trials are scheduled for the same day before Judge Gilstrap strongly support that the district court trial date will be pushed several months beyond the expected final written decision date. Further, this IPR challenges all claims of the '047 patent that will necessarily not be addressed by the district court in the Texas Litigation where PO asserted only claim 1. The Petition also has compelling merits that PO does not meaningfully dispute in its request.

When holistically assessing the facts, evidence, circumstances, and other considerations (detailed below), discretionary denial is not appropriate.

II. INSTITUTION IS WARRANTED IN VIEW OF THE EXAMINER'S MATERIAL ERRORS AND THE PETITION'S STRONG MERITS

During prosecution, the Examiner made several material errors that led to the '047 patent being issued. The Examiner rejected the claims for anticipation based on two figures and corresponding teachings in the specification of the U.S. Patent No. 7,221,349 ("Hashido," Ex. 1015). The applicant subsequently amended the independent claims and explained how only one of the figures did not meet the new limitations, ignoring the other figure used in the Examiner's rejection. The Examiner erred in overlooking that the teachings of the second figure—that he had originally relied on in his rejection—teach the new limitations applicant added to the claims. *See, e.g., Carbyne, Inc. v. Tritech Software Sys.*, IPR2025-00959, Paper 11

at 2 (Director Oct. 3, 2025) (finding examiner error warrants review where a reference cited on an information disclosure statement disclosed the limitations identified by the Examiner as novel in the reasons for allowance); *Taiwan Semiconductor Manufacturing Co. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11, at 3-4 (Director Sept. 3, 2025) (referring to the panel because “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 Inc. v. ControlTec, Inc.*, IPR2025-00559, Paper 12, at 2 (Director July 16, 2025) (referring to the panel in view of petitioner’s showing of material error). The Petition relies on similar art that teaches these same limitations, supporting that the Examiner materially erred by finding these new limitations were not disclosed in the prior art. These failures, individually and collectively, constitute material errors that warrant institution.

A. The Examiner materially erred by overlooking disclosures in Hashido used in a rejection during prosecution that anticipate the purportedly novel feature of the claims

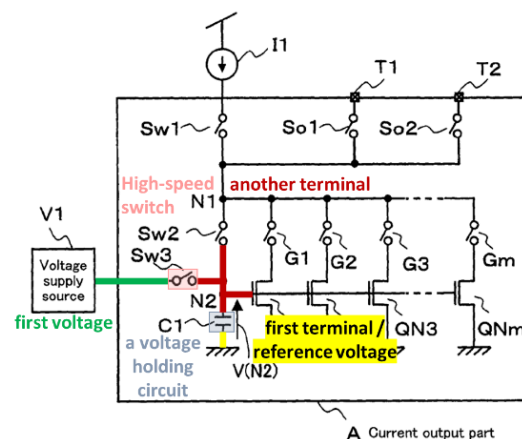
During prosecution, the Examiner rejected the claims as being anticipated by Hashido’s Figures 2 and 4 and corresponding teachings. Ex. 1002, 110-114. Regarding independent claim 1, the Examiner found that Hashido’s Figures 2 and 4 disclose the limitation “a voltage holding part” and that column 9, lines 24-56, discloses the limitation “under said voltage supply mode, said current output part receives said first voltage from said first voltage supply part and holds said voltage

in said voltage holding part.” Ex. 1002, 110-111. Regarding independent claim 10, the Examiner found that Hashido’s Figure 4 and column 13, lines 30-35, disclose “a high-speed switch for controlling connection/disconnection states of said voltage supply part with respect to said voltage holding part.” Ex. 1002, 113-114.

In view of the rejection, the applicant amended the claims, which led to their allowance, but explained that only Hashido’s Figure 2 did not teach the new limitations of the claims—ignoring the teachings of Hashido Figure 4. The applicant amended independent claim 1 to recite “a voltage holding [[part]] circuit having a terminal being connected to a reference voltage different from the first voltage” and that “under said voltage supply mode,...the first voltage is supplied to another terminal of said voltage holding [[part]] circuit.”¹ Ex. 1002, 126. The applicant amended independent claim 10 to recite “the voltage holding circuit having a first terminal and a second terminal, the first terminal being connected to a fixed voltage” and “a ~~high-speeding~~ high-speed switch for controlling connection/disconnection states of said voltage supply [[part]] source with respect to the second terminal of said voltage holding [[part]] circuit.” Ex. 1002, 129-130. The applicant argued that Hashido did not teach these new elements of the claims, focusing only on Figure 2 and not on Figure 4. Ex. 1002, 134. In view of applicant’s amendments and

¹ Unless otherwise specified, the amendments added the underlined portions.

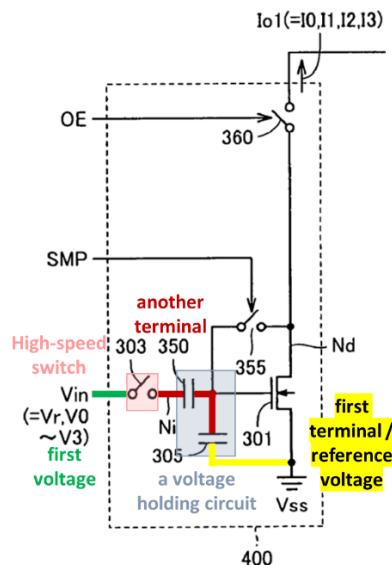
arguments, the Examiner mistakenly agreed despite the applicant not mentioning any deficiencies in the Figure 4 disclosures that the Examiner previously considered. The Examiner overlooked that Figure 4 teaches these allegedly novel aspects of the claim and thus committed material error by allowing the '047 patent. Ex. 1002, 148. It is in the Office's and the public's interest to correct these material errors.



² Unless otherwise specified, annotations correspond to the '047 claim language.

Similarly, Hashido's Figure 4 and corresponding teachings, which were originally relied on by the Examiner, disclose these allegedly novel limitations. For example, Hashido discloses an analog current supply circuit 400³ that includes an "input voltage V_{in} " supplied via "a switch 303" to capacitors 350 and 305," whereby one terminal of capacitor 305 is connected to "predetermined voltage V_{ss} " and capacitor 350 is "arranged between an input node N_i and a node N_g ." Hashido, 1:40-59, 3:6-10. When "switch 303 is turned on," input voltage V_{in} is supplied to the terminal of capacitor 350, which "transmits a voltage change" to capacitor 305 via "capacitive coupling." Hashido, 1:52-63, 3:3-10.

FIG.4



³ Current supply circuit 400 of Figure 4 is a "conventional current supply circuit[]" described in connection with Figures 21 and 23. Hashido, 1:40-67, 2:64-3:14, 4:30-35, 8:4-5, 8:9-11, 12:38-41.

Hashido, Figure 4 (annotated and excerpted).

It was material error that the Examiner failed to appreciate Hashido's disclosures in Figure 4 and corresponding specification teachings, both of which explicitly disclose the aspects of the claims that the Examiner found were novel. The Examiner thus should have maintained the anticipation rejection based on Hashido. The severity of the Examiner's material error here far exceeds other material errors that have been found to justify rejecting requests for discretionary denial. An overlooked anticipatory reference applied by the Examiner is an exceptional error that stands out from the rest. *See, e.g., Taiwan Semiconductor*, IPR2025-00847, Paper 11, at 3-4 (Director Sept. 3, 2025); *Anthony*, IPR2025-00559, Paper 12, at 2 (Director July 16, 2025). Indeed, the Director has rejected discretionary denial requests where, like here, the Petitioner sufficiently demonstrated a reference considered during prosecution "disclose[s] the purportedly missing claim limitations" identified by the Examiner as novel in the reasons for allowance. *See, e.g., Carbyne*, IPR2025-00959, Paper 11 at 2 (Director Oct. 3, 2025).

B. The Examiner materially erred by overlooking other anticipatory references, including one applied in the Petition

Compounding the Examiner's error in overlooking the express and anticipatory disclosures of Hashido, the Examiner also should have found other anticipatory references. The allegedly missing limitations in '047 claims 1 and 10 were known in the art, including in the §102 anticipation reference discussed in the

Petition. Baek discloses the allegedly novel aspects of the claims as well. Pet. 43-44 (citing Ex. 1004 (Baek), [0052], [0055]-[0058], [0062], Fig. 5), 46-57 (citing Ex. 1004 (Baek), Fig. 5). It appears that the Examiner's searches were too narrow and therefore did not yield results, like Baek, that disclose the claims. For example, nearly all of the Examiner's searches included the term "calibrat\$3," presumably to find references discussing calibration modes, but that term is not present in the claims. Ex. 1002, 120-124. Nearly all of the searches also included the term "(high\$2 fast\$2)" or "(high\$1 speed\$3)," presumably to find references discussing high-speed switches, but that term is present in claim 10 only, not claims 1-9. *Id.* These searches were too narrow to find references that disclose the claims. Further, none of the searches included the term "capacitor" or variants thereof, and while that term does not appear in the claim, the '047 and the art describe the claimed voltage holding circuits as capacitors. Pet. 43-44; *supra* Section II.A. Failure to find references like Baek constitutes Examiner error that the Board should now correct. *See Oticon Medical AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15 at 19 (PTAB Oct. 16, 2019) (precedential in relevant part) (finding "error in the prosecution" where examiner failed to locate and consider relevant prior art relied on in petition).

Indeed, the material errors here—considering anticipation by Hashido from prosecution and Baek from the Petition (among others)—are stronger than in previous decisions rejecting requests for discretionary denial. For example, in

Anthony, the petitioner argued that the examiner materially erred by granting the challenged claims after failing to locate a §103 reference, called Carter, that was not of record during prosecution. IPR2025-00559, Paper 9, at 16-17 (May 27, 2025). The petitioner explained that “Carter is strikingly similar prior art” and operates in the same manner as the challenged patent. *Id.* at 15. The referral decision found: “Petitioner persuasively explains the patent examiner erred by overlooking the teachings of Carter.” IPR2025-00559, Paper 12, at 2 (Director July 16, 2025). Here, the Examiner failed to locate Baek. And even more concerning, the Examiner failed to appreciate the anticipatory disclosures in Hashido, which was actually applied during prosecution. If overlooking Carter, a §103 reference, was sufficient to justify review of a patent applied for in March 2005, then overlooking §102 anticipatory references like Hashido and Baek should justify rejecting the discretionary denial request. *See also Microsoft Corp. v. XI Discovery, Inc.*, IPR2025-00253, Paper 13, at 2 (Director June 25, 2025); *Microsoft Corp. v. Partec Cluster Competence Center GmbH*, IPR2025-00318, Paper 9, at 3 (Director June 12, 2025).

In fact, Hashido and Baek anticipate the allegedly missing limitations that led to allowance; the Examiner should have at least considered a §103 rejection before allowing the claims.

III. ANY SETTLED EXPECTATIONS ARE OUTWEIGHED BY THE EXAMINER’S MATERIAL ERRORS DURING PROSECUTION

PO's alleged settled expectations in the '047 patent, which has been in force for 14 years, are not a bar to institution, particularly in view of the Examiner's material errors. Indeed, the Director has referred petitions to the Board where similar Examiner errors were present and the patents had settled expectations. *See, e.g., Taiwan Semiconductor*, IPR2025-00847, Paper 11, at 3-4 (Director Sept. 3, 2025) (referring to the panel because "Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error," despite a later IPR trial date reviewing a 15-year old patent); *Anthony*, IPR2025-00559, Paper 12, at 2 (Director July 16, 2025) (referring to the panel and finding that petitioner's showing of material error favored referring to panel for 17- and 18-year-old patents). The Examiner errors committed during prosecution outweigh any alleged settled expectations, and the discretionary denial request should be rejected.

Further, Petitioner disputes that it was on notice of the '047 patent since July 29, 2020 (*see* DD Req. at 18), as Petitioner no longer employed one of the recipients when the letter was received, and BOE has been unable to confirm that the other recipient, a salesperson, ever received the letter.

IV. *FINTIV* DOES NOT SUPPORT DISCRETIONARY DENIAL

A. Factor 1 (Likelihood of a Stay)

This factor is neutral given that no litigation stay has been requested and no evidence establishes how the district court would resolve such a request even if a

stay were requested upon institution. As a starting point, neither party has requested a stay of the litigation. PO starts by citing various cases from the EDTX where a motion to stay was filed in the co-pending litigation prior to institution in the IPR and the motion was denied. DD Req. at 4-5 (citing cases). However, the critical inquiry under this factor is whether “evidence exists” regarding whether a stay will be “granted if a proceeding is instituted.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential).

PO cites no case that precludes the possibility of a stay being granted in the EDTX after institution. On the contrary, PO acknowledges, as it must, that the EDTX does not automatically deny stays after institution. *See* DD Req. at 5-8. Among decisions made in the EDTX last year on motions to stay that were brought after institution, 28 percent of these motions were granted (i.e., 7 of 25 cases). Ex. 1016. To date in 2025, EDTX has granted 33 percent of post-institution motions to stay (i.e., 7 of 21 cases). *Id.*

As stated in the Petition, BOE intends to seek to sever the '047 patent from the Texas Litigation and stay that litigation as Judge Gilstrap has done in a past case. For example, in *SEVEN Networks, LLC v. Apple Inc.*, Judge Gilstrap severed patents into “a new, separate cause of action” where IPRs were instituted for a subset of asserted patents and then stayed the severed action pending resolution of the IPRs. *See, e.g.*, Ex. 1017, Case No. 2:19-cv-115-JRG, Dkt. 313 (E.D. Tex. Sept. 22, 2020).

PO relies on inapposite trial-ready cases when arguing Judge Gilstrap routinely denies such motions. DD Req. at 8. In *Polaris Powerled Techs., LLC v. Samsung Elecs. Am., Inc.*, Judge Gilstrap denied defendant's motion to stay the case pending appeals of IPRs for a subset of patents because the case was "at a very advanced stage." Case No. 2:22-cv-00469-JRG, 2024 U.S. Dist. LEXIS 218301 (E.D. Tex. Dec. 3, 2024). Similarly, in *RFCyber Corp. v. Google LLC*, Judge Gilstrap denied defendant's motion to stay pending completion of IPRs for a subset of the patents because the "case ha[d] already completed claim construction and [was] set for trial" in two months. Case No. 2:20-cv-00274-JRG, 2022 U.S. Dist. LEXIS 250095 (E.D. Tex. Jan. 4, 2022). None of these case milestones in the Texas Litigation has occurred or are even close to occurring before an institution decision is expected in early February 2026, and the claim construction hearing is set for almost six months after an institution decision is expected. Ex. 1018, at 4-5.

B. Factor 2 (Parallel Trial Date)

This factor is neutral. Assuming the Board institutes, a final written decision will issue in this proceeding by February 5, 2027. Trial is tentatively scheduled to occur in the parallel district court action on January 11, 2027, less than one month before the expected final written decision date. See Ex. 1018, at 1. PO wrongly contends that this weighs "in favor of denying institution." DD Req. at 8. The Board has explained that "median time-to-trial statistics for civil actions in the district court

in which the parallel litigation resides” must also be considered. USPTO March 24, 2025 Guidance on Its Recission of the “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” at 3, https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf. This is because certain district courts—including the EDTX where the parallel action in this case is pending—routinely schedule early trial dates that are then pushed back and delayed as the schedule progresses. Typically, it takes 26 months to reach trial in the EDTX. *See* Ex. 1019. The complaint in the district court action was filed in March 2025. *See* Ex. 1020. Thus, it is entirely possible that the district court trial will occur as late as May 2027. This is well after the expected date of a final written decision. The Director has found that “these considerations” involving the time-to-trial statistics “neither favor nor counsel against discretionary denial.” *Volkswagen Grp. Of Am., Inc. v. Longhorn Automotive Grp. LLC*, IPR2025-01064, Paper 9 at 2 (Director Oct. 10, 2025) (finding this factor as neutral where the scheduled district court trial date preceded the expected final written decision date, but the time-to-trial statistics suggested the district court trial would begin after the final written decision date); *see also Carbyne*, IPR2025-00959, Paper 11 at 2 (time-to-trial statistics suggested a district court trial date 9 months after the expected final written decision date).

The prospect of the currently scheduled trial date being delayed is significant given that Judge Gilstrap currently has at least *eight* trials simultaneously scheduled to start jury selection on January 11, 2027, only one of which is the PO litigation involving the '047 patent. *See* Ex. 1021. By advocating for discretionary denial based on the scheduled jury selection date, PO assumes without basis that Judge Gilstrap will prioritize its litigation over the other cases scheduled to begin jury selection on the same day. Even if no one of the eight cases were favored over the others, the likelihood that PO's litigation would be the one selected to start jury selection on January 11, 2027, is small—just one in *eight*.

PO's cited cases regarding factor 2 are inapposite. DD Req. at 8-9. In *Linkplay Technology Inc. v. Sonos Inc.*, the parties agreed to a trial date before the final written decision date and delay would occur only “under extraordinary circumstances.” IPR2025-00509, Paper 10 at 2 (Dir. July 31, 2025). In *NVIDIA Corp. v. Neural AI, LLC*, the time-to-trial statistics confirmed that the scheduled district court trial would precede the final written decision due date by over one month. IPR2025-00606, Paper 18 at 2 (Dir. July 31, 2025). In *Zhuhai Cosmix Battery Co. v. Ningde Amperez Technology Ltd.*, there was no indication that the time-to-trial statistics would push the expected district court trial date past the final written decision due date. IPR2025-00385, Paper 9 at 2 (Dir. July 2, 2025). In *Google LLC v. Cerence Operating Co.*, there was “nothing in the record indicat[ing]

a trial in the District Court Litigation would not take place months before our deadline to reach a final decision.” IPR2024-01465, Paper 15 at 8-9 (Dir. April 23, 2025). And the Board in *EClinicalWorks, LLC v. Decapolis LLC* and *Fintiv* did not consider the median time-to-trial statistics when denying institution. IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022); IPR2020-00019, Paper 15 at 13.

C. Factor 3 (Investment in Parallel Proceeding)

This factor favors institution. As of the Petition’s filing, PO had only served infringement contentions. As of the filing of this paper, the case has not otherwise advanced much other than Petitioner serving invalidity contentions. The parties have served and responded to a few discovery requests and disclosures, but no depositions have been scheduled or have occurred. The parties will not begin claim construction proceedings (by exchanging proposed claim terms for construction) until late March 2026 after an institution decision is expected in early February 2026, and a claim construction order is not expected until after the claim construction hearing scheduled for July 30, 2026. Ex. 1018.

By the time an institution decision is entered in this proceeding, far more investment will remain in the litigation, which counsels against discretionary denial. *See, e.g., Am. Airlines, Inc. v. Intellectual Ventures I LLC*, IPR2025-00785, Paper 11 at 2-3 (Director Aug. 29, 2025) (finding Petitioner’s “evidence that there has been little investment in the district court proceedings” as “weigh[ing] against

discretionary denial”); *Nintendo Co. v. Resonant Sys., Inc.*, IPR2025-00680, Paper 18 at 2 (Director Aug. 14, 2025) (finding “there has not been significant investment by the parties in the parallel proceeding” where claim construction proceedings would not start before the institution decision due date and other case milestones were far off). PO’s only cited case is inapposite, as the parties there had already “served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs [and had a claim construction hearing], and conducted several depositions.” *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3 (Director March 28, 2025).

D. Factor 4 (Overlap Between Petition and Parallel Proceeding)

This factor favors institution, which would avoid the presentation at trial of issues better decided by the Board. For example, as noted above, institution of an IPR could result in a stay of the district court case, preventing any overlap. Even without a stay, the IPR proceeding will likely conclude before trial, triggering IPR estoppel for those issues addressable in an IPR. In *Tanklogix v. Sitepro*, IPR2025-00650, Paper 10 at 2 (Director July 31, 2025), this factor weighed in favor of institution when trial was scheduled a mere 10 days after the due date for a final written decision in the related IPR. Moreover, in the unlikely event IPR estoppel does not apply because, e.g., the trial is not continued, Petitioner’s *Sotera* stipulation would eliminate any risk of relitigating IPR issues in district court.

Further, this IPR challenges all claims of the '047 patent, whereas PO has asserted only claim 1 in the Texas Litigation. Thus, this IPR presents compelling invalidity arguments that will necessarily not be addressed by the district court in the Texas Litigation, which weighs against discretionary denial.

E. Factor 5 (Whether the Parties Are the Same)

This factor does not weigh in favor of denial. Because the parties are the same, the combination of estoppel and Petitioner's *Sotera* stipulation eliminates the risk that the same invalidity theories will be raised in the IPR and in district court.

F. Factor 6 (Other Considerations)

Considerations under this factor weigh heavily against discretionary denial. As discussed above, the Petition is particularly strong because all the grounds explicitly include the element relied on by the Examiner for the reason for allowance, citing references the Examiner should have located after a reasonable search (or recognized was disclosed by the art relied upon during prosecution)—a fact that PO has not even contested substantively. *Supra* Section II.

PO argues the merits of the Petition are weak but fails to elaborate and makes no attempt to argue the merits as part of the discretionary denial process—demonstrating that PO's arguments are weak. *See Samsung Electronics Co., Ltd., v. SiONyx, LLC*, IPR2024-01431, Paper 21, at 17 (PTAB Apr. 10, 2025) (“On the present record, the merits of the Petition are strong....We emphasize that Patent

Owner provides very little argument, on the merits, with regard to the Haddad¹³⁸ reference.”). Instead, PO attempts only to incorporate by reference its preliminary response, which does not accord with the principles of due process as this preliminary response will not be filed until Petitioner’s responsive brief is due.

V. THOROUGH AND FOCUSED EXPERT TESTIMONY PROPERLY SUPPORTS THE PETITION

Proper use of expert testimony here does not support discretionary denial. PO argues that Petitioner over-relies on the expert testimony of Dr. Alex Kattamis (Ex. 1003), DD Req. at 15-17, but it fails to “identify any portions of the expert testimony that suggest Petitioner is using its expert to fill gaps in the prior art.” *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11 at 2 (Director June 26, 2025) (referring the petition to the Board where the patent owner failed specifically identify issues with the expert testimony). There are no gaps in the prior art, and Dr. Kattamis’ technical analysis discloses facts in support of his conclusions, including that the challenged claims are anticipated and/or obvious. PO fails to identify a single limitation for which Dr. Kattamis purportedly gap-filled, and this failure dooms its argument. Petitioners’ reliance on expert evidence is entirely compliant with Federal Circuit precedent. Both *Phillips* and *KSR*, which form the foundation for claim construction and obviousness, require one to evaluate a patent and prior art from the perspective of a POSITA. Moreover, the Federal Circuit has made clear that attorney argument alone is insufficient. As such, PO’s

criticism of the Petition vis-à-vis Dr. Kattamis’ expert declaration (Ex. 1003) is misplaced. This consideration weighs against discretionary denial.

Contrary to PO’s argument that the Petition is somehow flawed because “Mr. Kattamis’ [sic] declaration contains much of the same language as the Petition,” DD Req. at 16-17, the Board does “*not* accord [expert] testimony little or no weight simply because it is verbatim to what Petitioner states in the Petition. The *Xerox* case...does not require or indicate otherwise.” *Unified Patents, LLC v. Togail Techs., Ltd.*, IPR2023-00338, Paper 7, at 11 (PTAB Aug. 18, 2023); *see also Amazon.com, Inc. v. Nokia Techs. OY*, IPR2024-00691, Paper 10 at 65-66 (PTAB Sept. 24, 2024). “Rather, the critical inquiry is whether a declaration discloses underlying facts or data on which the opinion is based.” *Bizlink Tech., Inc. v. Anderson Power Prods., Inc.*, IPR2024-00687, Paper 7, at 27-28 (PTAB Nov. 22, 2024). As explained above, this is exactly what the Kattamis Declaration does. The Kattamis Declaration discloses, in detail, the underlying facts (e.g., the disclosures in references, the expert’s knowledge and experience, etc.) on which his opinions are based. It is unsurprising that there is overlap between the Petition and Kattamis Declaration, particularly where the Petition relies on the Kattamis Declaration and both quote and rely on specific disclosures from the references. Thus, the Kattamis Declaration is entitled to its full weight. *See Hum Indus. Tech., Inc. v. Amstead Rail Co.*, IPR2023-00540, Paper 10, at 37 (PTAB Aug. 11, 2023) (“If declaration

testimony is supported sufficiently and, in turn, supports contentions in the Petition, we do not give it little to no weight simply because it is repeated in the Petition[.]”).

Indeed, the cases that PO cites involved unsupported expert testimony and not any alleged issues with similarities between petitions and expert declarations. In *Kinetic Techs., Inc. v. Skyworks Solutions, Inc.*, the Board denied institution after finding that “Dr. Mohapatra’s Declaration does not provide any factual basis for its assertions.” IPR2014-00529, Paper 8, 14-15 (PTAB Sept. 23, 2014). Likewise, in *Xerox Corp. v. Bytemark, Inc.*, the Board denied institution because “Dr. Jones does not cite to any additional supporting evidence or provide any technical reasoning to support his statement.” IPR2022- 00624, Paper 9, at 15. (PTAB Aug. 24, 2022). Here, PO does not assert that Dr. Kattamis’ opinions are conclusory or not factually supported, nor can it due to the extensive citations to evidentiary support therein.

VI. CONCLUSION

For the reasons set forth in the Petition and herein, *inter partes* review of the ’047 patent would be an appropriate use of Board resources. Petitioner respectfully requests that the Director deny PO’s discretionary denial request.

Respectfully submitted,

Dated: November 5, 2025

/James L. Davis, Jr./

Name: James L. Davis, Jr.

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Counsel for Petitioner

CERTIFICATE OF COMPLIANCE

Pursuant to §42.24(d), the undersigned certifies that the foregoing Petitioner's Opposition to Patent Owner's Discretionary Denial Request contains, as measured by the word-processing system used to prepare this paper, 4,690 words and 20 pages. This word count does not include the items excluded by §42.24 as not counting towards the word limit.

Dated: November 5, 2025

/James L. Davis, Jr./

Name: James L. Davis, Jr.

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Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on November 5, 2025, I caused a true and correct copy of the foregoing Petitioner's Opposition to Patent Owner's Discretionary Denial Request and supporting exhibits to be served via electronic mail to Patent Owner's counsel listed below:

Justin B. Kimble, justin@nelbum.com
David T. DeZern, david@nelbum.com

Dated: November 5, 2025

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