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Filed on behalf of Meta Platforms, Inc.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner

v.

DIALECT, LLC,
Patent Owner

Case No. IPR2025-01335
U.S. Patent No. 8,015,006

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

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1004	Curriculum Vitae of Daniel Lopresti
1005	U.S. Patent No. 7,085,723 to Ross et al. (“Ross”)
1006	WO 00/11571 to Hartono et al. (“Hartono”)
1007	U.S. Patent No. 5,937,383 to Ittycheriah et al. (“Ittycheriah”)
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1009	U.S. Patent No. 7,249,018 to Ross et al. (“Ross018”)
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1014	Appendix B – Infringement Contentions for U.S. Patent No. 8,015,006, Dialect LLC v. Meta Platforms, Inc., No. 7:25-CV-00060-DC-DTG (W.D. Tex. July 16, 2025)
1015	Reserved

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1016	U.S. Provisional Patent Application No. 60/261372 to Ross et al.
1017	IBM® ViaVoice® for Windows® Personal Edition, User's Guide, Release 10 (August 2002)
1018	Excerpts from IBM ViaVoice™ 98 Home Edition User Guide (July 1998)
1019	Excerpts from Frederick Jelinek, <i>Statistical Methods for Speech Recognition</i> , The MIT Press (1997)
1020	Michael McTear, <i>Spoken Dialogue Technology: Enabling the Conversational User Interface</i> , 34 ACM Computing Surveys No. 1, pp. 90-169 (Mar. 2002)
1021	Liam Comerford, et al., <i>The IBM Personal Speech Assistant</i> , IBM Watson Research Center, IEEE (2001)
1022	Eric J. Glover, et al., <i>Architecture of a Metasearch Engine that Supports User Information Needs</i> , In International Conference on Information and Knowledge Management, Proceedings, pp. 210-216, ACM (1999)
1023	Dragon Naturally Speaking® 5, User's Guide (August 2000)
1024	Definitions of “asynchronous” and “token” from Microsoft Computer Dictionary, Fourth Edition, Microsoft Corporation (1999)
1025	Definition of “dictionary” from Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc. (1990)
1026	Definition of “dictionary” from The American Heritage Dictionary of The English Language, Houghton Mifflin Co. (1992)

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I. INSTITUTION IS THE MOST EFFICIENT USE OF RESOURCES

The PTAB is the most efficient and best-equipped forum to adjudicate the patentability of expired U.S. Patent No. 8,015,006 (the “’006 Patent”). Institution is warranted for multiple reasons.

First, institution is necessary to correct a material error. During prosecution, the Examiner improperly narrowed search terms, overlooking the challenged claims, resulting in the ’006 Patent. If the Examiner had properly focused a search on the claims at issue, references such as Ross (EX1005) and Aridor (EX1010) would have almost certainly been found during prosecution.

Second, the FWD here will issue well before any trial in the parallel litigation—almost two months earlier under the current schedule, and likely closer to ten months ahead of trial based on time-to-trial statistics. In any event, there will be no overlap as Meta has entered a *Sotera* “plus” stipulation.

Third, PO asserted the ’006 Patent in multiple district courts (NDCA, WDTX, EDTX), and in each instance, the FWD here would issue before any scheduled trial. Institution would therefore promote efficiency and consistency, particularly given the Office’s material error.

PO’s arguments for discretionary denial lack merit. PO first contends that “settled expectations” favor denial. Not so. Although the ’006 Patent issued in 2011, Meta had no knowledge of it until PO filed the parallel litigation. Indeed, PO

recently dismissed its pre-suit indirect and willful infringement claims against Meta in the parallel litigation for lack of any factual basis showing pre-suit knowledge. And if anything, PO's failure to assert the patent until mere days before its expiration created settled expectations for Meta of non-enforcement of the patent.

PO then argues that institution should be denied based on an *ex parte* request for reexamination ("EPR") filed by Unified Patents, LLC ("Unified") and a non-instituted IPR filed by Google, LLC ("Google"). However, as confirmed by both Meta and Unified, Meta was not involved in Unified's EPR. And any roadmapping and duplication are unfounded since they involve different prior art and claims.

Finally, PO relies on the parallel litigation in WDTX and the *Microsoft* litigation in EDTX to urge denial. But as discussed, the parallel litigation favors institution, not denial. And the *Microsoft* litigation is immaterial. After PO filed its request for discretionary denial in this case, PO moved to stay all deadlines and filed a notice of settlement in its litigation against Microsoft.

In sum, the Director's objectives of efficiency and consistency strongly favor institution. The PTAB, and not the multiple district courts where the '006 Patent is asserted, would be the proper forum to determine patentability of the expired '006 Patent. PO's request for discretionary denial should be denied.

II. PO IGNORES CONSIDERATIONS ESTABLISHING THAT THE PTAB IS THE MOST EFFICIENT FORUM

PO purports to follow the Director's guidance on "Interim Processes for PTAB Workload Management." DDR, 1. But PO overlooks key considerations under that guidance—specifically, whether institution is necessary to correct a material error, the *Fintiv* factors, and the need for efficiency and consistency in addressing validity of a patent that is asserted in multiple forums. Each of these considerations weigh decisively in favor of institution.

A. IPR is Necessary To Correct A Material Error By The Office

1. The Examiner found different allowable subject matter in different groups of independent claims

The application of the '006 Patent resulted in five independent claims at allowance: claims 20 and 21 (later issued as claims 1 and 4) and claims 24, 27 and 31 (later issued as claims 5, 6 and 10), each directed to different subject matter.

Originally dependent claims, the applicant amended claims 20, 21, 24, 27, and 31 to independent form to include all of the limitations of their respective base and any intervening claims, in order to obtain allowance. EX1002, 147. In the Notice of Allowance, the Examiner identified purported points of novelty as follows:

- For claims 20 and 21: "updating a user-specific vocabulary when a predetermined confidence level is not met." EX1002, 237–238.

- For claim 24: “providing grammar with required and optional values... inferring criteria from a current context in combination with a format transformation.” EX1002, 238.
- For claim 27: “applying scraping criteria to extract the values” as part of “submitting a plurality of queries and obtaining a plurality of results to web crawlers for multiple information sources and scoring.” EX1002, 238–239.
- For claim 31: “both format conversion and variable substitution in combination with parsing to determine a meaning and a context associated with a request involving a grammar by a domain agent.” EX1002, 239.

**2. The Examiner's improperly narrowed search ,
overlooked the challenged claims**

The Examiner did not perform an adequate search covering all independent claims. Although the Examiner identified different points of novelty across the independent claims, the Examiner limited the search to the subject matter of claims 20 and 21, which are not challenged in this proceeding. Specifically, before issuing the Notice of Allowance, the Examiner's search criteria focused on terms associated with claims 20 and 21. EX1002, 246-248. The Examiner repeatedly searched for “dictionary” or “vocabulary,” terms tied to the purported point of novelty in claims 20 and 21, without expanding the search to address the distinct subject matter of the other independent claims 24, 27 and 31. EX1002, 237.

Had the Examiner focused the search on the purported points of novelty in

claims 24 and 27, the Examiner would likely have located the Ross and Aridor references. For claim 24, the Examiner identified “providing grammar with required and optional values... inferring criteria from a current context in combination with a format transformation” as the point of novelty “not disclosed or reasonably suggested by the prior art of record.” EX1002, 238. Similarly, for claim 27, the Examiner identified “applying scraping criteria to extract the values” as part of “submitting a plurality of queries and obtaining a plurality of results to web crawlers for multiple information sources and scoring” as not disclosed or reasonably suggested by the prior art of record. EX1002, 238-239. However, there is no record of the Examiner's search criteria focused on the purported points of novelty.

For example, claim 24 concerns “grammar” used by the domain agent. Although the Examiner discusses this concept in the Notice of Allowance, “grammar” does not appear on the Examiner's search record. EX1002, 238. However, “grammar” appears in Ross almost 80 times, and therefore, it is highly likely that the Examiner would have identified Ross through a targeted search. *See* EX1038 (Ross with instances of “grammar” highlighted). Similarly, claim 27 involved submitting a plurality of “queries,” yet the term “query” does not appear in the Examiner's search record. However, Aridor uses the term “query” (or some variation) more than 130 times and thus would have been easily identified through a targeted search. *See* EX1039 (Aridor with instances of “query” highlighted).

Accordingly, a thorough and properly directed search should have led the Examiner to Ross (EX1005) asserted in Grounds 1 and 2, and Aridor (EX1010) asserted in Grounds 2 and 4.

3. Correcting a material error by the Office is an appropriate and worthwhile use of Board resources

The Director has repeatedly emphasized the importance of correcting material errors made by the Office. *Apple Inc. v. Advanced Coding Technologies LLC*, IPR2025-01103, Paper 11, at 2 (Oct. 17, 2025) (“Petitioner provides persuasive evidence that the Office erred in a manner material to the patentability of the challenged claims.”); *Anthony Inc. v. ControlTec LLC*, IPR2025-00559, Paper 12 (July 16, 2025) (“Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error.”).

This is so even when PO argues it had strong settled expectations. *Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9, at 2 (July 31, 2025) (“While ordinarily [strong settled expectation] counsels for discretionary denial, Petitioner persuasively explains that the patent examiner materially erred during prosecution of the challenge patent.”); *Xencor, Inc. v. Merus N.V.*, IPR2025-00605, Paper 12, at 2-3 (July 17, 2025) (“discretionary denial under 35 U.S.C. § 325(d) is not appropriate because the Office materially erred during prosecution of the challenged patent”).

For example, in *Taiwan Semiconductor Manufacturing Company Ltd. and Apple Inc., v. Marlin Semiconductor Ltd.*, the Director declined to discretionarily

deny IPR on a patent despite it being “in force for fifteen years, [because] Petitioner appear[ed] to show a material error by the Office.” IPR2025-00847, Paper 11, at 4 (September 3, 2025). Accordingly, the Director concluded that it was “an appropriate use of Office resources to review the potential error.” *Id.*

Here, the Examiner failed to use basic search strategies that would have identified at least Ross and Aridor. The Examiner's error in issuing the '006 Patent is therefore material, and the Board's resources are well spent correcting that error.

B. *Fintiv* Confirms That Institution is Warranted

The FWD will issue before trial in the parallel litigation and Meta has entered a broad stipulation. Thus, the *Fintiv* factors support institution and will further the Board's objectives to advance “efficiency, fairness, and the merits.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 5-6 (Mar. 20, 2020).

Factor 1 (stay) favors institution because stay is likely. *Imperative Care, Inc. v. Inari Medical, Inc.*, IPR2025-00289, Paper 9, at 2 (June 12, 2025) (“evidence that the district court is likely to grant a stay if this proceeding is instituted” weighs against discretionary denial). Although Judge Counts (who is the judge in the parallel litigation) has not previously ruled on a contested motion to stay pending post-grant proceedings, Magistrate Judge Gilliland (who often decides similar motions for Judge Counts) has granted such motions if the post-grant proceeding is instituted at an early stage of the case (*see* EX1029) or if the FWD issues before trial

(*see* EX1030). Both would occur here, since institution would occur just as discovery opens (*see* EX1031), and the FWD will issue before trial (*see* Factor 2).

Factor 2 (proximity to trial) strongly favors institution because the FWD will issue by February 19, 2027, almost two months before trial in the parallel litigation currently scheduled for April 5, 2027 (*see* EX1031). *See FreightCar Am., Inc. v. Nat'l Steel Car Ltd.*, IPR2025-01046, Paper 20, at 2 (Oct. 10, 2025) (“likely that a final written decision in these proceedings will issue before a district court trial occurs” weighs against discretionary denial); *Am. Airlines, Inc., et al. v. Intellectual Ventures I LLC*, IPR2025-00785, Paper 11, at 2-3 (Aug. 29, 2025) (“likely that a final written decision in this proceeding will issue before a district court trial occurs, reducing concern of inconsistent outcomes or significant duplication of efforts”). Further, the trial date will likely slip, as the current median time-to-trial statistics for WDTX is 32.8 months (*see* EX1031), suggesting that trial will not take place until November 2027, about ten months after the FWD deadline. *See Amazon.com, Inc. et al. v. NL Giken Inc.*, IPR2025-00250, Paper 14, at 2 (May 16, 2025) (time-to-trial statistics suggesting trial would be six months after the FWD weighs against discretionary denial).

Factor 3 (investment in parallel litigation) favors institution. There has been little parallel party and judicial investment. *Am. Airlines, Inc.*, IPR2025-00785, Paper 11, at 2-3 (“evidence that there has been little investment in the district court

proceedings” favors institution). A claim construction order has not issued, and fact discovery has not yet opened. *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15, at 10 (Oct. 21, 2020) (finding “the District Court proceeding was in its early stages” where “no claim construction orders have issued”).

Factor 4 (overlap) strongly favors institution because Petitioner has entered a broad *Sotera* “plus” stipulation that will eliminate overlap between the district court litigation and the instant proceeding if instituted. *See Samsung Elec. Co., Ltd. v. Wilus Institute of Standards and Tech. Inc.*, IPR2025-00933, Paper 11, at 3 (Oct. 10, 2025) (“Petitioner has filed a broad stipulation that reduces the concern of inconsistent outcomes or significant duplication of efforts.”); *Tesla, Inc. v. United States*, IPR2025-00341, Paper 12, at 2 (June 13, 2025). (“Petitioner has filed a broad stipulation” that counsels against discretionary denial). In addition, with the broad *Sotera* “plus” stipulation, if instituted, Meta has committed not to pursue any combination that includes a reference listed in the grounds, even when combined with any other prior art that could not have been raised, such as system prior art. *See* EX1032.

Factor 5 (same party) is neutral. The Board considers “whether the petitioner and the defendant in the parallel proceeding are the same party” because the Board may exercise its discretion where institution would mean “redoing the work of another tribunal” on the same or substantially same issues for the same

parties. Here, even though the same parties are involved in the present proceeding and the parallel litigation, there is little danger of redoing the work of the district court since Meta has entered a broad stipulation. *Snap*, at 17 (“there is not substantial overlap..., [thus] we regard the consideration of the fifth *Fintiv* factor as neutral”).

Factor 6 (other considerations) strongly favors institution. *First*, the Petition presents strong arguments for unpatentability. *See Samsung Elecs. Co. Ltd. v. Dynamics Inc.*, IPR2020-00505, Paper 11, at 14 (Aug. 12, 2020) (finding case merits favor institution). *Second*, institution is consistent with the significant public interest against “leaving bad patents enforceable.” *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 55 (2020). Indeed, Meta has a significant patent portfolio of its own, and institution here would further the intent of the AIA to prevent the “diver[sion of] resources from the research and development of inventions.” H.R. Rep. No. 112-98, pt. 1, at 48 (2011). *Third*, this Petition would be the sole challenge to the ’006 Patent before the Board—a “crucial fact” favoring institution. *Google LLC v. Uniloc 2017 LLC*, IPR2020-00115, Paper 10, at 6 (May 12, 2020).

C. Centralizing Validity Determination at the PTAB is the Most Efficient Use of Resources and Will Promote Consistency

When “the litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient.” *Harbor Freight Tools USA Inc., et al. v. Champion Power Equipment, Inc.*, IPR2025-00805, Paper 20, at 2 (Sept. 19, 2025). Here, in

addition to the stayed and settled *Microsoft* litigation in the Eastern District of Texas (EDTX) and the parallel litigation pending in the Western District of Texas (WDTX), PO asserted the '006 Patent against Google in the Northern District of California (NDCA). As a result, the '006 Patent is headed to trial in at least two different district courts, creating a significant risk of inconsistent outcomes. Under these circumstances, and consistent with the Board's reasoning in *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 (July 2, 2025), resolving the dispute between the parties at the Office would be more efficient.

Board review will conserve resources and ensure uniformity across multiple proceedings. The FWD here would issue before trial in any of the three pending litigations. As discussed, trial in WDTX will occur almost two months after the FWD, if not more. EX1031. Parties in the EDTX case have filed a joint motion to stay, and PO filed a notice of settlement on November 4, 2025. Meanwhile, the NDCA case is currently stayed pending the appeal of the FWD for another patent, and based on the median time-to-disposition for the Federal Circuit, would not complete until July 2027. EX1042.

III. PO'S REFERENCED CONSIDERATIONS CONFIRM THAT DISCRETIONARY DENIAL IS NOT APPROPRIATE

PO's request for discretionary denial only confirms that the PTAB is the most efficient forum for determining patentability of the '006 Patent.

A. PO Has No Settled Expectations As To Meta

PO argues that settled expectations support discretionary denial. DDR, 3-5. They do not. To the contrary, settled expectations, if any, favors institution.

Neither PO nor its predecessors ever provided Meta with actual notice of the challenged patent. *Cf. NVIDIA Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18, at 3 (July 31, 2025) (“Petitioner had actual notice of the challenged patents and Petitioner’s failure to seek early review of the patents favors denial.”); *Google LLC v. SoundClear Tech. LLC*, IPR2025-00344, Paper 15, at 3 (Aug. 4, 2025) (“Petitioner had knowledge of the challenged patents as early as 2019.”). Indeed, with no evidence that Meta had knowledge of the ’006 Patent, PO recently dismissed its indirect and willful infringement in the parallel litigation. EX1035.

Notably, unlike other proceedings where petitioners cited to the challenged patent in the prosecution of its own patents, PO contends that Meta cited to a different patent than the ’006. *Cf. iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10, at 2 (June 6, 2025) (“Petitioner was aware of it as early as 2013—having cited the then-pending application that issued as the challenged patent in an Information Disclosure Statement Petitioner filed in its own patent application”).

Specifically, PO contends that Meta should have known about the ’006 Patent because allegedly Meta cited U.S. Patent No. 8,112,275 (“’275 Patent”) during the

prosecution of “no fewer than thirty-nine” Meta patents. DDR, 4. This argument is misplaced. The ’275 Patent has a different claim scope than the ’006 Patent and does not show knowledge of the ’006 Patent. Notwithstanding, Meta’s patent portfolio includes thousands of filings, and it is unreasonable to suggest that Meta is or should be aware of every patent that is cited during prosecution of any one of its patents. *Intellectual Ventures I LLC v. Symantec Corp.*, 234 F. Supp. 3d 601, 611 (D. Del. 2017) (Stark, J.) (rejecting argument that citation to asserted patent on the face of two patents owned by defendant constitutes knowledge); *Spherix Inc. v. Juniper Networks, Inc.*, No. 14-578-SLR, 2015 WL 1517508, at *6 (D. Del. Mar. 31, 2015) (“The fact that the ’123 patent was referenced during prosecution of two of defendant’s over 1,700 patents [] is not compelling evidence of knowledge, i.e., that the patent was ‘called to the attention’ of defendant.”).

Regardless, to the extent that there were any settled expectations, Meta had reasonably expected PO would not enforce the ’006 Patent. PO filed the parallel litigation two days before the patent expired on February 9, 2025. *See Google LLC v. Sandpiper CDN, LLC*, IPR2025-00806, Paper 13, at 2 (Sept. 12, 2025) (challenged patents asserted after expiration, and therefore petitioner “expected non-enforcement”); *Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11, at 3 (Sept. 4, 2025) (no discretionary denial where “Patent Owner did not assert the challenged patents against Petitioner until after they expired”); *Globus Medical, Inc. v.*

Spinelogik, Inc., IPR2025-00225, Paper 8, at 2 (June 12, 2025) (“expected non-enforcement of the challenged patent” asserted after expiration). Accordingly, Meta had a reasonable expectation that PO would not assert the ’006 Patent as there was virtually no life left on the patent.

B. Unified’s EPR Does Not Involve Meta

1. Meta is not an RPI in Unified’s EPR nor is Unified an RPI in Meta’s IPR

PO argues that an EPR filed by Unified supports discretionary denial. DDR, 5-8. Specifically, PO contends that Meta is affiliated with Unified and coordinated with Unified in filing this IPR and Unified’s EPR. That is incorrect. Unified had no involvement in Meta’s Petition (EX1041, ¶2), and Meta had no involvement in Unified’s EPR. EX1041 ¶3.

PO offers no evidence of coordination between Meta and Unified because none exists. As confirmed by sworn testimony, “Meta did not have any prior knowledge of, or involvement in, the preparation and filing of the request for the EPR on the ’006 Patent.” EX1041., ¶3. Indeed, “Meta did not direct Unified in identifying the patent or group of patents to be considered for the EPR.” *Id.*

Meta’s lack of involvement is consistent with Unified’s post-grant proceeding process, which does not involve its members. *See* EX1040. “Unified’s decisions to file a PGR, IPR, or EPR are made independently without the input, assistance, or approval of any of Unified’s Members.” EX1040 ¶4. Unified also “controls every

aspect of such a challenge, including controlling which patent and claims to challenge, which prior art to apply and the grounds raised in the challenge, when to bring any challenge, and whether to settle or otherwise end any challenge.” *Id.*

The Board has repeatedly reviewed and confirmed that Unified is not an RPI to its members. *Unified Pats. LLC v. Uniloc 2017 LLC*, IPR2019-00453, Paper 38, at 56-59 (July 22, 2020) (finding petitioner's client was not an RPI because there was insufficient evidence of pre-IPR filing communications between petitioner and its client and no specific evidence the petition was filed at the client's behest); *Unified Pats., Inc. v. Bradium Techs. LLC*, IPR2018-00952, Paper 60, at 10-16 (December 19, 2019) (rejecting contention that United failed to name RPIs because there was no evidence of pre-IPR filing communications).

PO's further request that the Director open a *sua sponte* investigation into Unified's activities and policy practices is misplaced and irrelevant to this Petition. The only question before the Director and Board is whether the challenged claims of the '006 Patent are unpatentable, and the record shows that they are.

2. The Unified's EPR favors institution, not denial

The Board, not the CRU, is the better forum to resolve patentability of the '006 Patent. Resolving patentability before the Board would be more efficient, subject to a firm statutory deadline, and would create estoppel on Meta so that the parties would no longer need to resolve patentability in WDTX.

The Board has recognized that there is “no regulation, rule, case law, or Office guidance” holding that the filing of potentially overlapping patentability challenges before multiple branches of the Office constitutes “an abuse of the patent system.” *Resmed Corp., v. Cleveland Medical Devices, Inc.*, IPR2025-00160, Paper 11, at 8 (June 13, 2025). As in *Resmed*, this Petition does not rely on any of the same prior art combinations as the pending EPR, which remains in its early stages, having only recently been ordered on September 19, 2025. *Id.* at 10-11.

The Board has also confirmed that when an IPR and EPR proceed on the same patent, “the Board shall stay the reexamination proceeding to avoid duplication efforts within the Office.” *American Airlines and Southwest Airlines v. Intellectual Ventures LLC.*, IPR2025-00785, 00786, Paper 11 at 2 (August 29, 2025) (referral despite ordered EPR). This practice reflects the greater efficiency of IPRs, which proceed under a fixed statutory deadline and provide finality that can be relied upon in parallel proceedings.

In addition, if the Board institutes review, Meta will be estopped from asserting any invalidity grounds that were raised or reasonably could have been raised during IPR (EX1032), and a FWD would trigger estoppel under 35 U.S.C. § 315 of the same scope.

C. Meta's Challenge is Independent of Any Prior Challenges

PO alleges Meta's Petition raises concerns of roadmapping. DDR, 8. Those allegations are unfounded. Meta's Petition stands on its own and fully articulates each asserted ground of unpatentability. *See generally* Pet. Meta also relies on different prior art and was not an RPI in Google's previous IPR challenge . EX1037, 15; *Toshiba Am. Info. Sys., Inc. v. Wallex Microelecs. Ltd.*, IPR2018-01538, Paper 11, at 20-22 (Mar. 5, 2019) ("Nor are we persuaded that Petitioner used our prior Institution Decisions ... as a 'roadmap' in a manner unfair to Patent Owner. The asserted grounds in the current Petition are based on different prior art.").

PO incorrectly compares this case to *Amazon Web Services v. Croga Innovations, Ltd.*, IPR2025-00884, Paper 9, at 2 (September 3, 2025) ("*AWS*"). In *AWS*, there had cumulatively been four IPRs filed, two of which were denied on the merits. The petitioner also admitted that its later petition "addresses the precise deficiency identified by the Board in denying the earlier petitions," which raised legitimate roadmapping concerns. *Id.* There, the Director in *AWS* had further noted that in an EPR on the same patent, the Office had already issued a final rejection on the challenged claims and the EPR was already in "an advanced stage." *Id.* at 3.

The circumstances here are entirely different. Only one prior IPR exists, and Meta's Petition does not attempt to address or correct any supposed deficiency from

that earlier IPR. Moreover, unlike *AWS*, the EPR on the '006 Patent was only recently ordered on September 19, 2025, and is in its early stages.

PO's suggestion that the Petition would duplicate the Office's efforts is also misplaced. The EPR challenges claims 1-5, while Meta's Petition challenges claims 5 and 6. And there is no overlap in prior art relied upon in the two proceedings. *Cf. Apotex Inc. v. Alkermes Pharma Ireland Limited*, IPR2025-00514, Paper 10, at 2 (July 2, 2025) (granting discretionary denial where the ordered "reexamination includes substantially overlapping art and nearly identical issues as Petitioner seeks to raise in this *inter partes* review"). In addition, the Board has made clear that if an IPR and EPR proceed on the same patent, "the Board shall stay the reexamination proceeding to avoid duplication efforts within the Office." *American Airlines and Southwest Airlines v. Intellectual Ventures LLC.*, IPR2025-00785, 00786, Paper 11, at 2 (August 29, 2025) (referral despite ordered EPR).

D. Activities in the Parallel Litigation Weigh in Favor of Institution

PO's arguments that the activities in the parallel litigation weigh in favor of denial are incorrect. If anything, they weigh in favor of institution.

PO claims that Petitioner has presented overlapping validity contentions, however Petitioner has entered a broad *Sotera* "plus" stipulation that will eliminate overlap between the district court litigation and the instant proceeding if instituted. *See Samsung Elec. Co., Ltd. v. Wilus Institute of Standards and Tech. Inc.*, IPR2025-

00933, Paper 11, at 3 (Oct. 10, 2025) (“Petitioner has filed a broad stipulation that reduces the concern of inconsistent outcomes or significant duplication of efforts.”); *Tesla, Inc. v. United States*, IPR2025-00341, Paper 12, at 2 (“Petitioner has filed a broad stipulation” that counsels against discretionary denial). In addition, Meta agreed to an even broader restriction through its *Sotera* “plus” stipulation, committing that, if instituted, it will not pursue any combination that includes a reference listed in the grounds, even when combined with any other prior art that could not have been raised in IPR, such as system prior art. *See* EX1032.

PO further contends that denial is warranted because “trial in the parallel *Meta* case has been scheduled to occur shortly after when a final written decision in this case could be expected.” DDR, 9. But that weighs against discretionary denial, not for it. Notably, as currently scheduled, the trial will occur almost two months after the expected FWD issue date, and, even then, the trial date will likely slip, as the current median time-to-trial statistics for WDTX is 32.8 months (*see* EX1033), suggesting that trial will not take place until November 2027, ten months after the FWD deadline. In addition, PO’s claim that parties will have invested considerable resources carries little weight because Magistrate Judge Gilliland (who will likely decide any stay motion here) has granted motions to stay if the post-grant proceeding is instituted at an early stage of the case (*see* EX1029) or if the FWD issues before trial (*see* EX1030), both of which are true here as well. *See Freightcar America*,

Inc. v. National Steel Car Limited., IPR2025-01046, Paper 20, at 2 (October 10, 2025) (“Petitioner offers persuasive evidence that the district court is likely to stay its proceeding if the Board were to institute trial.”)

E. The *Microsoft* Litigation Is Irrelevant

PO and Microsoft have reached a settlement in principle and the litigation between them will be dismissed shortly. EX1036. Therefore, the *Microsoft* litigation has no bearing on this proceeding. But even if the *Microsoft* litigation was not resolved, the validity of the '006 Patent would certainly be more efficiently resolved at the PTAB. Under the Director's September 16, 2025, Memorandum, the Board **must** consider outcomes in other forums. But there is no such requirement in WDTX. Thus, institution would ensure consistency, particularly where, as here, the patent is also asserted in other district courts. In stark contrast, denial would force PO to litigate the validity of the '006 Patent in the parallel litigation in WDTX, potentially leading to completely different outcomes in different forums.

IV. CONCLUSION

Petitioner respectfully requests that the Board reach the merits of the Petition.

Dated: November 19, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on November 19, 2025, a true and correct copy of the foregoing **PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** is being served by electronic mail on PO's counsel of record listed below, pursuant to its Mandatory Notices.

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