UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOP GLORY TRADING GROUP INC. and

DP DREAM PAIRS INC.,

Petitioners,

v.

COLE HAAN LLC,

Patent Owner.

Case No. IPR2025-01394
Patent No. 11,041,262

PETITIONERS' OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,041,262 ("'262" or "'262 Patent")
1002	File History of U.S. Patent No. 11,041,262 ("'262FH")
1003	Declaration of Dr. Sabit Adanur in Support of Petition for *Inter Partes* Review of U.S. Patent No. 11,041,262 ("Adanur")
1004*	U.S. Patent Pub. No. 2010/0154256 ("Dua")
1005*	U.S. Patent No. 6,931,762 ("'762" or "'762 Patent")
1006*	U.S. Patent No. 6,910,288 ("'288" or "'288 Patent")
1007*	Alan J. Flusser, *Clothes and the Man: The Principles of Fine Men's Dress* (1985) ("Flusser")
1008*	U.S. Patent No. 7,949,570 ("Litke")
1009*	U.S. Patent Pub. No. 2014/0237856 ("Podhajny")
1010*	U.S. Patent Pub. No. 2014/0109286 ("Blakely")
1011	U.S. Patent No. 10,327,511 ("'511" or "'511 Patent")
1012	File History of U.S. Patent No. 10,327,511 ("'511FH")
1013	*Reserved*
1014	*Reserved*
1015*	U.S. Patent No. 8,028,440
1016*	U.S. Patent Pub. No. 2015/0313316
1017*	U.S. Patent Pub. No. 2013/0260104
1018*	Complaint for Patent Infringement in *Cole Haan LLC v. Top Glory Trading Group Inc. et al.*, 2:25-cv-00176 (D.N.J.)
1019*	*Man-Made Fiber and Textile Dictionary* (4th ed. Issued 1978, Reprinted 1983)

Exhibit No.	Description
1020*	Wingate, *Fairchild's Dictionary of Textiles* (6th ed. 1979)
1021*	H. Stoll GmbH & Co., *Stoll Training: Manual Flat Knitting Machine* (2013)
1022*	American & Efird, *Footwear Glossary: Shoe Construction Terminology*, available at https://www.amefird.com/wp-content/uploads/2010/01/2Footwear-Glossary-Shoe-Construction-03-08-08.pdf (2008)
1023*	David J. Spencer, *Knitting Technology: A Comprehensive Handbook and Practical Guide* (3rd ed. 2001)
1024*	Wonseok Choi, *Three Dimensional Seamless Garment Knitting on V-Bed Flat Knitting Machines*, 4 J. Textile and Apparel, Tech. and Mgmt., 1-33 (2005)
1025*	National Judicial Caseload Profile (2024)
1026*	Hong et al., *The Development of 3D Shaped Knitted Fabrics For Technical Purposes on a Flat Knitting Machine*, 19 Indian Journal of Fibre & Textile Research, 189-94 (September 1994)
1027*	Lewis et al., *A Machine Knitter's Guide To Creating Fabrics* (1986)
1028*	*Complete Textile Glossary* (Celanese Acetate 2001)
1029*	U.S. Patent No. 1,803,554
1030*	U.S. Patent No. 1,841,518
1031*	U.S. Patent No. 2,675,631
1032*	U.S. Patent No. 5,345,638
1033*	U.S. Patent No. 2,440,393
1034*	U.S. Patent No. 2,147,197
1035*	U.S. Patent No. 2,400,692
1036	*Reserved*

Exhibit No.	Description
1037*	European Patent No. 1338690A1
1038*	A. W. Koester, *Fashion Terms: Apparel Fabric Glossary* (1992)
1039*	Sabit Adanur, *Wellington Sears Handbook of Industrial Textiles* (Johnston Industries Group 1995)
1040*	D. Ann Gioello, *Understanding Fabrics: From Fiber to Finished Cloth* (1982)
1041*	Cammy Sessa, "*Clothes and the Man" by Flusser*, The Virginian-Pilot, Sept. 7, 1995, at 37, available at: https://pilotonline.newsbank.com/sign-up?docref=doc/image/v2%253A146D908D09F2E7FE%2540NGPA-VAVP-1811A5D2D47F25A0%25402449968-18109F1A6F5E4F71%254036-18109F1A6F5E4F71%2540
1042*	Phyllis G. Tortora, *Understanding Textiles* 344 (4th ed. 1992)
1043*	Jess Power, *Functional to Fashionable: Knitwear's Evolution Throughout the Last Century and into the Millennium*, 5 J. Textile and Apparel, Tech. and Mgmt. 1-16 (2006)
1044*	*Advances in Knitting Technology* (K.F. Au ed. 2011)
1045*	William Morrow, *Best Sellers for Winter,* Publishers Weekly, Sept. 20, 1985, at 97
1046*	Alan J. Flusser, *Getting a Solid Footing,* The New York Times Magazine, Sept. 13, 1981, § 6, at 98, available at: https://www.nytimes.com/1981/09/13/magazine/getting-a-solid-footing.html
1047*	Alan Flusser, *Dressing the Man*, 188-208, HarperCollins, 2002
1048*	Michael Gross, *Dressing by the Books: Getting the Word to Men,* The New York Times, Oct. 19, 1985, § 1, at 52, available at: https://www.nytimes.com/1985/10/19/style/dressing-by-the-books-getting-the-word-to-men.html
1049*	Internet Archive Capture dated October 12, 1985, of "Clothes and The Man; The Principles of Fine Men's Dress", available at: https://web.archive.org/web/20150105224030/http://www.amazon.com:80/Clothes-Man-Principles-Fine-Dress/dp/0394546237

Exhibit No.	Description
1050	Declaration of Jonathan Bradford
1051*	*Spandex Technology* (1965)
1052*	Pointelle, *Merriam-Webster's Collegiate Dictionary* (10th ed. 2001)
1053*	Pointelle, *The Oxford American College Dictionary* (2002)
1054*	U.S. Patent No. D905,386
1055	Search Disclosure Declaration (Confidential, Board Only)
1056	*Cole Haan LLC v. Top Glory Trading Group et al.*, 25-cv-00176-ES-SDA, Dkt. No. 54-1 (D.N.J. Oct. 1, 2025)
1057	*Cole Haan LLC v. Top Glory Trading Group et al.*, 25-cv-00176-ES-SDA, Dkt. No. 8 (D.N.J. Jan. 30, 2025)
Petitioners have used the same exhibit number to refer to the same document across IPR2025-01392 and -01393, except for those exhibits without an *, which indicates that the exhibit is unique to each IPR proceeding.	

TABLE OF ABBREVIATIONS

Abbreviation	Description
’262 or ’262 Patent	U.S. Patent No. 11,041,262 (Ex. 1001)
’262FH	File History of U.S. Patent No. 11,041,262 (Ex. 1002)
Claims / Challenged Claims	Claims 1-13 of the ’262 Patent
’511 or ’511 Patent	U.S. Patent No. 10,327,511 (Ex. 1011)
’511FH	File History of U.S. Patent No. 10,327,511 (Ex. 1012)
IPR	*Inter Partes* Review
Petitioners	Petitioners Top Glory Trading Group Inc. and DP Dream Pairs Inc.
PO	Patent Owner
POSITA	Person of Ordinary Skill in the Art
PTAB	Patent Trial and Appeal Board
USPTO	United States Patent and Trademark Office

I. INTRODUCTION

This Petition is one of four petitions filed by Petitioners Top Glory Trading Group Inc. and DP Dream Pairs Inc. in September 2025 against four patents assigned to Patent Owner ("PO"). Discretionary denial is not warranted. PO's request should be rejected and this Petition should be considered on the merits.

First, the Examiner erred in applying patentable weight to ornamental claim limitations. The Examiner improperly gave patentable weight to aesthetic arrangements of a broguing design. As a result, the Examiner failed to reject the Challenged Claims over references or combinations that teach the non-ornamental limitations.

PO's request does not—and cannot—explain why these limitations are entitled to patentable weight. Instead, PO acknowledges that these limitations are "design" elements during prosecution of the related '511 Patent, and during prosecution of two design patents on the exact ornamentation recited by the Challenged Claims. The Examiner erred, and this issue should be addressed by the Board on the merits to account for the error.

Second, the *Fintiv* factors weigh against discretionary denial. The New Jersey Case is still in its infancy—the Court has not set a *Markman* hearing or a trial date, and little substantive work has been completed since PO filed its Complaint. Petitioners' *Sotera* stipulation will also eliminate potential overlap between the

Petition and district court proceedings, thus minimizing duplicative efforts and inconsistencies.

Third, PO has no settled expectations with respect to the ’262 Patent. The parties’ 2022 settlement agreement tolled any settled expectations that PO had because the agreement prevented Petitioners from raising a challenge against the then one-year-old ’262 Patent. PO cannot now claim that the ’262 Patent has been “in force for over four years *without challenge*.” Br. at 5–6. Indeed, Petitioners did not “fail[] to seek early review of the ’262 Patent”—they instead reached a mutual agreement with PO not to challenge the patent while Petitioners sold their remaining inventory. And when PO sent correspondence in 2023—when the ’262 Patent was two years old—Petitioners raised their invalidity positions, and PO appeared to have acquiesced to those positions. PO never responded to the invalidity arguments presented by Petitioners in early 2024. Rather than respond to those invalidity arguments, PO presented a new infringement theory against different products at the end of 2024, following nine months of silence. PO has therefore been on notice of Petitioners’ invalidity position for at least two years. It cannot now plead settled expectations.[1]

[1] The ’262 Patent’s parent (’163 Patent, IPR2025-01393) and grandparent (’511 Patent, IPR2025-01392) lack settled expectations for at least the same reason.

Fourth, PO's other discretionary considerations fail to demonstrate why discretionary denial is warranted. The Petition appropriately relies on its expert consistent with the Director's past precedent and complies with the rules by setting out a discrete set of grounds.

Discretionary denial is therefore not warranted. PO's request should be denied and the Petition's merits should be considered.

II. DISCRETIONARY DENIAL IS NOT WARRANTED

A. Denial Under 35 U.S.C. § 325(d) Is Inappropriate[2]

Under the two-part *Advanced Bionics* framework, there is no basis for discretionary denial under 35 U.S.C. § 325(d), as the Grounds raised by this Petition are not the same or substantially the same as those raised during prosecution. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Pap. 6, *8 (P.T.A.B. Feb. 13, 2020) (precedential) (establishing a two-part framework for addressing 35 U.S.C. § 325(d)).

1. The Examiner Erred by Applying Patentable Weight to Ornamental Features

Petitioners' arguments questioning whether the "patentable weight" of certain claim limitations is novel, and the Examiner's failure to consider these arguments was error. The Examiner improperly gave patentable weight to ornamental and

[2] Petitioners submitted a Search Disclosure Declaration. *See* Ex. 1055.

aesthetic arrangements of broguing designs. The Examiner's only comment during prosecution of the '511 Patent[3] is that the broguing lines relate to the "***aesthetic appeal***" of the shoe. Ex. 1012 at 109–10. Nevertheless, the Examiner failed to reject the Challenged Claims over references that teach the non-aesthetic claim limitations.

This "patentable weight" argument was not considered during prosecution of the '511 Patent. PO's only arguments regarding the Examiner's "***aesthetic appeal***" characterization are: (1) the Examiner cannot use aesthetic designs as the basis for a prior art rejection, and (2) "the claimed knit pattern inherently has mechanical function as it is incorporated in and forms a portion of the upper." Ex. 1012 at 136–38. Both arguments are flawed.

First, Petitioners agree that "matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art." *In re Seid*, 161 F.2d 229, 73 USPQ 431 (C.C.P.A. 1947); MPEP § 2144.04. But the Examiner never reached this issue. Instead, the Examiner relied on aesthetic motivations as a basis to combine or modify references as part of an obviousness analysis—which is not prohibited by *Seid*. Regardless, the Examiner's failure to consider the lack of patentable weight for the

[3] The '511 Patent is the grandparent of the '262 Patent. The '262 Patent had no substantive prosecution other than an obviousness-type double patenting rejection, which Applicants overcame by filing a terminal disclaimer.

claims' ornamental limitations was error that should be reviewed by the Board.

Second, the Examiner erred by accepting PO's unavailing and circular mechanical-function argument. PO's argument—that the broguing designs have mechanical function because they are incorporated in the upper—does not and cannot explain *what* mechanical function the *broguing lines* provide. This is because the broguing lines have no mechanical function. PO's comparison of the related '511 Patent to that of *Ex parte Hilton*, 148 USPQ (BNA) ¶ 356, 1966 WL 6407 (Bd. App. 1965) is equally unavailing because the facts of *Hilton* are also wholly dissimilar to the prosecution history of the '511 Patent. The patent in *Hilton* concerned fried potatoes in the shape of a chip, which was challenged against a prior art reference concerning fried potatoes in the shape of a french fry. *Id.* at *1. The Board held that "while it may be true in some cases that the particular shape of a product is of no patentable significance, . . . the shape (chips) is important [in this case] ***because it results in a different product [i.e., chips] which is distinct from the reference product [i.e., french fries]***." *Id.* Unlike *Hilton*, though, the broguing designs result in the same product: a shoe. The '511 Patent's purported novelty—like that of the '262 Patent—does not yield a "*distinct*" "product." PO's contrary argument was plainly incorrect, and the Examiner's acceptance of its argument was material error.

The Examiner's errors are further compounded by PO describing the claimed broguing lines as ornamental design features. *E.g.*, Ex. 1012 at 134 (arguing that the

"***knitted design patterns***" of the prior art do not include "the ***lines of broguing*** of claim [1]"). Not only did PO repeatedly refer to this limitation as "***knitted design patterns***" during prosecution of the '511 Patent, but PO later obtained design patents on nearly identical designs claimed by the '262 Patent. PO's design patents—D905,386 and D816,308—claim an "ornamental design for a shoe." Figures 1–4 of the '262, D'386, and D'308 Patents are *nearly identical*. PO cannot now claim that the broguing patterns embody mechanical functions because its slate of utility patents is being challenged.

The Examiner's error in failing to consider these arguments greatly impacted prosecution. The Petition, therefore, should be considered on the merits to rectify the Examiner's errors.

2. Petitioners' New Grounds of Unpatentability Were Not Considered During Prosecution

Petitioners rely on the following Grounds—none of which were considered by the Patent Office:

- Ground 1: Dua '256 (Ex. 1004) (Cls. 1–13);
- Ground 2: Dua '256 in view of Dua '762 (Ex. 1005) / Dua '288 (Ex. 1006) (Cls. 1–13);
- Ground 3: Dua '256 in view of Flusser (Ex. 1007) (Cls. 1–8, 11, 12);
- Ground 4: Dua '256 in view of Dua '762 / Dua '288 and Flusser (Cls. 1–8,

11, 12);

- Ground 5: Dua ’256 in view of Litke (Ex. 1008) (Cls. 1–8, 11, 12);
- Ground 6: Dua ’256 in view of Dua ’762 / Dua ’288 and Litke (Cls. 1–8, 11, 12).

Pet. at 7.

Dua, Flusser, and Litke were never identified in an IDS or considered. In fact, the Examiner never issued a rejection on any prior art grounds—neither §§ 102 nor 103—during the ’163 Patent’s prosecution.

The primary reference, Dua ’256 (including Dua ’762 / Dua ’288, which are incorporated by reference) is not the same or substantially the same as Dua ’011 cited during the ’511 Patent’s prosecution at least because Dua ’011 does not incorporate by reference Dua ’762 / Dua ’288 or disclose a knitted ***dress shoe*** upper. Indeed, as PO’s claim chart makes clear, Dua ’256 includes different figures and specification language that is not substantially similar to Dua ’011. Br. at 9–10 (with reference to the comparisons of Dua ’256 Figs. 6 and 7D and Dua ’011 Figs. 1 and 11).

PO’s claim chart also demonstrates how Dua ’256 meets each and every claim limitation. *See, e.g.*, Br. at 8–11. It does not matter whether PO contends that it “does not concede” invalidity—PO explicitly spells out that both Dua ’256 and Dua ’011 disclose the claim limitations, giving merit to the Petition and demonstrating further

examiner error. Sections 102–103 do not ask whether the PO "concedes" invalidity—they ask whether the claims are novel and nonobvious.

Furthermore, Flusser's disclosure that there are approximately seven men's dress shoe styles, and Litke's disclosure of stitched wingtip patterns, are unlike any prior art reference considered by the Examiner. No reference by the Examiner details that there is a specific, finite number of options to choose from among men's dress shoes. This is disclosed in Flusser, and PO does not challenge that it would have been at least obvious to try these seven options. The Crannell reference, as PO recognizes, discloses a pressed wingtip pattern as opposed to Litke's stitched wingtip pattern. These combinations are dissimilar to the Examiner's knit upper and separately processed upper combination previously considered. Br. at 11–12.

B. The *Fintiv* Factors Collectively Weigh Against Discretionary Denial

The rest of the *Fintiv* factors collectively weigh against discretionary denial.

1. Factor 1 (Stay) Is At Least Neutral

Fintiv factor 1 "weigh[s] against exercising authority to deny institution" where there is no stay but "the district court has denied a motion for stay without prejudice and indicated to the parties that it will consider a renewed motion . . . to stay if a PTAB trial is instituted." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Pap. 11, *6–7 (P.T.A.B. Mar. 20, 2020) (precedential). Petitioners' pre-institution motion to stay is currently pending before the district court. PO contends that "[a]ny

assertion that a stay will be granted is speculative." Br. at 13. Not so. Petitioners present compelling evidence in favor of a stay before the Court—Petitioners' motion is likely to be granted based on the merits, not speculation. *See* Ex. 1056 at 5–14.

PO's assertion that a stay will likely be denied is mere speculation. PO's only argument is that the District of New Jersey's practice "is to defer any stay until after institution." Br. at 13. But as explained in Petitioners' motion, the District of New Jersey—along with other courts in the Third Circuit—have granted pre-institution motions on several occasions, especially where no trial date has been set and "little substantive work will be done before" the Board's institution decision—as is the case here. Ex. 1056 at 4–5. This factor, therefore, is at least neutral.

2. Factor 2 (Trial Date) Does Not Support Discretionary Denial

If this IPR is instituted, the final written decision would issue in early 2027. There is currently no trial scheduled or *Markman* hearing date set. This factor, therefore, strongly weighs against discretionary denial.

PO argues that "other considerations" such as alleged "settled expectations," "lack of material error," and "§ 325(d)" make review "an inefficient use of Board resources, despite no trial date being set." Br. at 13–14. As explained in Sections II.A and II.C, PO's arguments with respect to these considerations do not merit discretionarily denying this IPR petition.

3. Factor 3 (Parallel Proceeding) Supports Institution and Factor 4 (Issue Overlap) Supports Institution

The district court has not made a single substantive ruling regarding any of the four challenged patents. This factor strongly weighs against discretionary denial. *Fintiv*, IPR2020-00019, at *9–10 (finding no "orders related to the patent at issue in the petition" weighing against discretionary denial).

The parties have invested little time and resources into the New Jersey Case. Fact and expert discovery will not close until 45 and 180 days after the *Markman* decision (with a hearing yet to be scheduled, but will occur sometime after May 15, 2026). Thus, fact and expert discovery will not close for at least another 8 to 12 months, and no fact or expert deposition has been taken or scheduled.

Petitioners filed a case-dispositive motion to dismiss, but the Court has yet to rule on this motion. Even so, the Board has granted institution in cases far more advanced than here. *See Samsung Display Co. Ltd. v. Pictiva Displays Int'l Ltd.*, IPR2024-01222, Pap. 12, *7 (P.T.A.B. Jan. 23, 2025) (finding that *Fintiv* factor 3 weighs against denial, even after *Markman* because "much remains to be done, including expert discovery"); *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01432, Pap. 14, *8–9 (P.T.A.B. Apr. 7, 2025) (finding that *Fintiv* factor 3 favors institution even after *Markman* briefing was complete).

PO greatly embellishes Petitioners' patentable weight argument by claiming

the Board will have to decide issues under § 101. Br. at 14–16. This is false. Nowhere in the Petition do Petitioners ask the Board to invalidate the ’262 Patent under § 101. Petitioners even analyzed the prior art assuming all terms were entitled to patentable weight. *See, e.g.*, Pet. at 29–60. As the Petition argues, whether the Board agrees with Petitioners on patentable weight or not, the result is the same: the Challenged Claims are invalid in view of the prior art.

PO’s arguments are also rebutted by Petitioners’ broad *Sotera* stipulation (Pet. at 14), which guarantees no overlap between the instant IPR proceedings and the district court litigation. This strongly favors institution.

4. Factor 5 (Same Party) Is Neutral

Petitioners are defendants in the New Jersey Case—making this factor “neutral.” *HP Inc. v. Slingshot Printing LLC*, IPR2020-01084, Pap. 13, *9 (P.T.A.B. Jan. 14, 2021).

5. Factor 6 (Other Considerations) Weighs Against Discretionary Denial

Petitioners’ IPR petition: (1) includes art not previously before the Examiner; (2) presents compelling grounds and other arguments on the merits that the Examiner did not previously consider; and (3) argues—with clarity and brevity—where the Examiner erred when prosecuting the Challenged Claims. The Board’s efficiency and PO’s lack of settled expectations weigh against discretionary denial.

PO’s other considerations, such as settled expectations, do not advance any

compelling reason to discretionarily deny institution. As recent decisions have made clear, a patent being in force for six years or more does not automatically create settled expectations for the PO. *See, e.g.*, *Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00438, Pap. 10, *3 (P.T.A.B. July 17, 2025) (declining to exercise discretionary denial for all challenged patents in a set of IPRs even though one of them had been "in force for approximately 10 years"). Indeed, "[t]here may be persuasive reasons why the Board should review challenged claims several years after their issuance date." *Intel Corp. v. Proxense, LLC*, IPR2025-00327, Pap. 12, *2–3 (Director June 26, 2025).

PO has no settled expectations with respect to the '262 Patent because the parties' 2022 settlement agreement tolled any settled expectation. The agreement prevented Petitioners from raising a challenge against the '262 Patent in 2022, when the '262 Patent was one year old. PO cannot now claim that the '262 Patent has been "in force for over four years *without challenge*." Br. at 5–6. Indeed, Petitioners did not "fail[] to seek early review of the '262 Patent"—they instead reached a mutual agreement with PO not to challenge the patent while Petitioners sold their remaining inventory.

PO also knew of Petitioners' invalidity position for over two years—it cannot now claim settled expectations. PO reasserted the '262 Patent against Petitioners in late 2023 when the patent was two years old. During negotiations, Petitioners

repeatedly asserted that the ’262 Patent is invalid in view of the prior art. PO recognized Petitioners’ position, never responded to Petitioners’ letter renewing its invalidity position, and then waited more than a year before filing its Complaint. PO cannot now claim settled expectations after acknowledging Petitioner’s invalidity position years ago.

Furthermore, PO’s arguments with respect to DP Dream Pairs are belied by the allegations in its complaint, which assert that “Miracle Miles Group Inc., Top Glory Trading Company, and DP Dream Pairs Inc. are all owned by and affiliated with Brian Cao.” Ex. 1057, ¶ 33. PO cannot sever Top Glory and DP Dream Pairs with respect to raising invalidity and also treat Top Glory and DP Dream Pairs as a single “Defendants” entity for purposes of allegedly establishing knowledge for willful infringement. *Id.*, ¶ 30 (“Cole Haan believes Defendants either had knowledge of the Asserted Patents prior to the filing of this Complaint or engaged in willful blindness as to the Asserted Patents.”).

PO’s lack of settled expectations with respect to a patent validity challenge from Top Glory weighs against discretionary denial.[4]

[4] The ’262 Patent’s parent (’163 Patent, IPR2025-01393) and grandparent (’511 Patent, IPR2025-01392) lack settled expectations for at least the same reason.

C. PO's Other Discretionary Considerations Fail to Demonstrate Why Discretionary Denial is Warranted

PO's other discretionary considerations—such as alleged overreliance on expert testimony and failure to satisfy 37 C.F.R. § 42.104(b)—fail to demonstrate why discretionary denial is warranted.

1. The Petition Appropriately Relies on Expert Witness Testimony

The Petition properly relied on the testimony of Dr. Sabit Adanur to support its invalidity positions. The Petition carefully walks through each and every claim limitation and analyzes each element against the prior art. Dr. Adanur's testimony does not fill in gaps in prior art, but instead properly "explain[s] the background knowledge of a person of ordinary skill in the art." *iRhythm, Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Pap. 10, *2–3 (Director June 6, 2025) (finding such reliance proper). PO begrudgingly admits as much—indeed, PO argues that Dr. Adanur "gap-fills" the "broguing" limitations, then quickly walks back its argument by admitting that Dr. Adanur "rel[ies] on the teachings of Flusser and Litke." Br. at 18–19. PO merely disagrees with Dr. Adanur's reasoning why a POSITA would have been motivated to combine the references.

Disagreement between Petitioners and PO is expected, which is why the Board should consider the Petition on the merits. Rather than taking PO's attorney arguments regarding invalidity at face value, the Board should analyze the entire

breadth of evidence in this case. This includes Petitioners' brief, Dr. Adanur's opinions, PO's arguments, *and* PO's forthcoming expert declaration. This issue is best considered on the merits, not a discretionary denial request. PO's request should be denied such that the merits can be properly weighed.

2. The Petition Complies with 37 C.F.R. § 42.104(b)

The Petition complies with the regulations governing IPR procedure, including 37 C.F.R. § 42.104(b). The Petition does not include "and/or" grounds. Rather, PO's attempt to cabin "'762/'288" as an "and/or" ground is misguided. The "/" refers to both references being used as backup references within a single ground to the extent the references are not incorporated into the primary Dua reference. Pet. at 23–29. This is proper practice, and the Board should not discretionarily deny the Petition for this reason.

III. CONCLUSION

For the above reasons, PO's request for discretionary denial should be denied.

Dated: December 11, 2025

By: /*James L. Davis, Jr.*/
Name: James L. Davis, Jr.
Registration No. 57,325
Lead Counsel for Petitioners

CERTIFICATE OF COMPLIANCE

Pursuant to § 42.24(d), the undersigned certifies that the foregoing Petitioners' Opposition to Patent Owner's Discretionary Denial Brief contains 15 pages. This page count does not include the items excluded by § 42.24 as not counting towards the page limit. *Interim Director Discretionary Process*, https://www.uspto.gov/patents/ptab/interim-director-discretionary-process.

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on December 11, 2025, a complete and entire copy of this Petitioners' Opposition to Patent Owner's Discretionary Denial Brief and all supporting exhibits were served to the following attorneys of record for the Patent Owner listed below:

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