

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLTAGE, LLC,
NINGBO VOLTAGE SMART PRODUCTION CO.
Petitioners

v.

SHOALS TECHNOLOGIES GROUP, LLC
Patent Owner

Inter Partes Review No.: IPR2025-01443
U.S. Patent No. 12,015,375

PETITIONERS' OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL

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Petitioners' Opposition to Discretionary Denial Request
U.S. Patent No. 12,015,375

LIST OF EXHIBITS

Exhibit No.	Description of Exhibit
1001	U.S. Patent No. 12,015,375
1002	Notice of a Commission Final Determination Finding No Violation of Section 337; Termination of the Investigation, Certain Photovoltaic Connectors and Components Thereof, Inv. No. 337-TA-1365 (Jan. 14, 2025, EDIS Doc. ID 841065).
1003	File History for U.S. Patent No. 12,015,375
1004	U.S. Provisional Patent Application No. 62/047,773
1005	Original Japanese Language Publication of JPH10-135499A
1006	Certified English Translation of JPH10-135499A ("Machida")
1007	U.S. Patent Publication No. 2011/0011642 A1 ("Solon")
1008	Order No. 20: Construing Claim Terms, Certain Photovoltaic Trunk Bus Cable Assemblies and Components Thereof, Inv. No. 337-TA-1438 (July 23, 2025, EDIS Doc. ID 858239).
1009	U.S. Patent Publication No. 2014/0272293 A1 ("Saitou")
1010	Wikipedia entry for "American wire gauge" (archived on Wayback Machine on July 13, 2014)
1011	Webpage "The Original MC4 DC PV connector offers a unique high contact quality" (https://www.staubli.com/global/en/electrical-connectors/industries/renewable-energy/the-original-mc4.html)
1012	Original Korean Patent No. 10-1428689
1013	Certified English Translation of Korean Patent No. 10-1428689 ("Kim")
1014	Complainant Shoals Technologies Group, LLC's Unopposed Motion to Terminate in Part as to Certain Claims of the Asserted Patents, Inv. No. 337-TA-1438 (Aug. 19, 2025, EDIS Doc. ID 859963).
1015	Order No. 29: Initial Determination Granting Motion for Partial Termination of Certain Asserted Claims, Inv. No. 337-TA-1438 (Aug.

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	26, 2025, EDIS Doc. ID 860398).
1016	<i>Shoals Technologies Group, LLC v. Int'l Trade Comm'n</i> , Case No. 25-1439 (Fed. Cir. Feb. 13, 2025).
1017	<i>Sotera</i> Stipulation
1018	Petitioner's Search Disclosure Declaration by Junhao Ma
1019	U.S. Patent No. 12,015,376
1020	Stipulation Between Complainant and Voltage Respondents Regarding Prosecution Bar, Inv. No. 337-TA-1365 (Sept. 20, 2023, EDIS Doc. ID 804593).
1021	Order No. 8: Ordering Production from Paul G. Johnson, Inv. No. 337-TA-1438 (May 19, 2025, EDIS Doc. ID 851508).
1022	Decision Granting Request for Prioritized Examination (Track I) & Filing Receipt of U.S. Application No. 18/523,464
1023	Filing Receipt of U.S. Application No. 18/739,127
1024	Filing Receipt of U.S. Application No. 19/021,810
1025	Decision Granting Request for Prioritized Examination (Track I) & Filing Receipt of U.S. Application No. 19/078,979
1026	Decision Granting Request for Prioritized Examination (Track I) & Filing Receipt of U.S. Application No. 19/086,937
1027	Federal Court Management Statistics June 2025, Middle District for North Carolina

I. INTRODUCTION

The Director should deny Patent Owner's Request for Discretionary Denial ("Request"). In this particular case, Patent Owner's litigation counsel has taken advantage of USPTO continuation practice rules in order to get multiple bites at the apple to obtain an infringement ruling on patents directed to technology that has already been found not to be infringed by Petitioners.¹ PTAB resources should be employed to review IPR petitions directed to patents obtained through this type of behavior, as it undercuts the policies of the USPTO intended to promote innovation and decreases efficiencies within the USPTO by forcing examiners to review applications that are clearly not directed to the purported "inventions" originally identified by the inventors. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11

¹ Patent Owner continues this behavior of obtaining new patents through continuation practice. The USPTO has recently issued a new patent on another continuation application—U.S. Patent No. 12,407,295—and Patent Owner has now asserted that patent in its Third Amended Complaint against Petitioners in the district court. *See Shoals Technologies Group, LLC v. Voltage, LLC et al*, Case No. 1:25-cv-00026, D.E. 74 (M.D.N.C. Oct. 10, 2025). Notably, during prosecution of that patent, Patent Owner did not identify or provide the IPR Petition for the '375 Patent to the Examiner for consideration.

at 6 (PTAB Mar. 20, 2020) (precedential) (“[T]he Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review”).

None of the considerations outlined in the March 26 Memo² support denial of institution. For example, challenged U.S. Patent No. 12,015,375 (“the ’375 Patent”) issued in June 2024. There are no “settled expectations.” No forum has adjudicated the validity or patentability of the challenged claims.

Patent Owner claims that the fourth enumerated consideration—the extent of reliance on expert testimony—favors denial because Petitioners’ arguments “rely heavily on expert testimony.” Request at 11. But there is no expert declaration or testimony cited in the Petition. This misrepresentation is not an isolated error. Patent Owner has engaged in a pattern of misconduct before the USPTO in the prosecution of the ’375 Patent’s family in furtherance of a litigation strategy that should not be endorsed.

In particular, Patent Owner’s litigation counsel filed and then prosecuted the application that issued as the ’375 Patent while concurrently asserting two related patents against Petitioners in the ITC. Patent Owner stipulated that its counsel at the

² See Director’s March 26, 2025 Memorandum regarding Interim Processes for PTAB Workload Management, (the “March 26 Memo”)

law firm, Maschoff Brennan (“ITC Counsel”), would “institute an ethical wall prohibiting the involvement of all attorneys who have access to [Petitioners’] confidential information disclosed in the Investigation from the prosecution of [the ’375 Patent], and any subsequent applications.” *See* Stipulation Regarding Prosecution Bar) (EX1020). They did not. *See* Order No. 8: Ordering Production from Paul G. Johnson (EX1021) (Administrative Law Judge rejecting protection of e-mail communications under work-product doctrine based on “sufficient *prima facie* evidence that the communications were incident to alleged misconduct relevant to” Petitioner’s unenforceability defenses).

Petitioners have sought the unenforceability of the ’375 Patent based on unclean hands and, as Patent Owner acknowledges, the MDNC Court granted Petitioners’ request for an expedited schedule and earlier bench trial on the unenforceability of the ’375 Patent in February 2026. Yet Patent Owner seeks to leverage this imminent bench trial as justification to deny institution. But the bench trial will only address unenforceability, not whether the ’375 Patent is valid. PTAB resources should be employed to review IPR petitions directed to patents obtained through improper prosecution conduct, which undercuts the policies of the USPTO intended to promote innovation and decreases efficiencies within the USPTO by forcing examiners to review applications that diverge from the purported “inventions” originally identified by the inventors. *See Fintiv, Inc.*, Paper 11 at 6.

Patent Owner's request that the PTAB should use its discretion to avoid review of this patent does not align with the policy behind discretionary denial, which is intended to promote innovation and preserve resources. Patent Owner's behavior serves none of those objectives—its continuation practice by its litigation counsel seeks protection of subject matter that it never contemplated as its “invention,” wasting USPTO resources. Indeed, in the past two years, Patent Owner has filed five more continuation applications from the '375 Patent, seeking Track One Priority Examination in three of them. EX1022 (Track One) (eventually issued as U.S. Patent No. 12,015,376 on June 18, 2024); EX1023; EX1024; EX1025 (Track One); EX1026 (Track One) (eventually issued as U.S. Patent No. 12,407,295 on September 2, 2025). Removing IPR petitions as a tool to challenge such patents for discretionary reasons would not advance the USPTO's goals. Likewise, Patent Owner's actions have resulted in a second round of duplicative district court and ITC litigations based on the '375 Patent and other continuations, needlessly expending the resources of the parties and multiple judicial bodies. *See Fintiv*, IPR2020-00019, Paper 11 at 6. This conduct should be discouraged.

Additionally, on August 19, 2025, *one day* before the Evidentiary Hearing of the parallel proceeding, *In re Certain Photovoltaic Trunk Bus Cable Assemblies and Components Thereof*, Inv. No. 337-TA-1438 (U.S.I.T.C.) (“1438 Investigation”), Patent Owner moved to withdraw *sixteen* claims of the asserted twenty-two claims

of the '375 Patent. *See* Unopposed Motion to Terminate in Part as to Certain Claims (EX1014). With the Patent Owner's motion granted, only six claims remained asserted for the '375 Patent in that proceeding. *See* Order No. 29: Initial Determination Granting Motion for Partial Termination (EX1015). The ITC has no opportunity to address invalidity of those withdrawn claims—yet those claims continue to be pursued by Patent Owner in district court. This IPR provides an opportunity for the Board to address serious validity challenges raised without the same concerns for judicial economy that may be otherwise present. Also, Petitioners have filed a *Sotera* stipulation for the district court parallel proceeding, *Shoals Technologies Group, LLC v. Voltage, LLC et al*, Case No. 1:25-cv-0002 (M.D.N.C.) ("Second MDNC Case"), which will prevent duplication of efforts concerning the full scope of claims challenged in that case.

In addition, concurrent with this Opposition, Petitioner voluntarily submits a Search Disclosure Declaration ("SDD") (*see* EX1018) in accordance with the Memorandum issued by Director Squires on November 17, 2025 ("SDD Memo"). The SDD describes Petitioners' search methodology as sought by the SDD Memo, which will be considered as a non-exclusive, non-dispositive **favorable discretionary factor** supporting institution. *See* SDD Memo at 2.

Finally, this Petition relies on a strong primary reference (Machida) that was not considered during prosecution. Contrary to Patent Owner's claim, Petitioners do

not rely on any expert testimony. These considerations, which will allow for a streamlined-efficient review by the Board, should be taken into consideration under the Director's Workload Management guidance, and further justify institution. Thus, this IPR should be instituted.

II. THE PROCEDURAL HISTORY

Patent Owner originally asserted two related patents against Petitioners in both *In re Certain Photovoltaic Connectors and Components Thereof*, Inv. No. 337-TA-1365 (U.S.I.T.C.) ("1365 Investigation") and *Shoals Technologies Group, LLC v. Voltage, LLC et al*, Case No. 1:23-cv-365 (M.D.N.C.) ("First MDNC Case"): U.S. Patent No. 10,992,254 ("254 Patent"), and U.S. Patent No. 11,689,153 ("153 Patent").

On March 25, 2024, the Commission terminated the '254 patent from the 1365 Investigation based on Patent Owner's withdrawal of the complaint as to that patent and declined to review that termination. *See* EX1002 at 2. In its Final Determination dated January 14, 2025, the Commission found no violation by Petitioners of the '153 patent and terminated the 1365 Investigation in its entirety. *See* EX1002 at 4. Patent Owner has appealed that determination. *See Shoals Technologies Group, LLC v. Int'l Trade Comm'n*, Case No. 25-1439 (Fed. Cir.) (EX1016). The First MDNC Case remains stayed pending final resolution (including all appeals) of the 1365 Investigation.

But while the 1365 Investigation was pending, and despite Patent Owner's stipulating that its ITC Counsel would not, ITC Counsel continued to involve itself in prosecution the continuation applications that matured into the '375 Patent and U.S. Patent No. 12,015,376 ("the '376 Patent") (EX1019). Both patents later issued on June 18, 2024. *See* EX1001 at 1; EX1019 at 1. On January 9 and 10, 2025, days before the ITC confirmed no Section 337 violation in the 1365 Investigation, Patent Owner filed two new cases asserting the '375 and '376 Patents against Petitioners: the 1438 Investigation and the Second MDNC Case.

Thereafter, Petitioners diligently searched for and identified prior art. EX1018. A *Markman* order issued on July 20, 2025. EX1008. Less than a month later, and prior to the evidentiary hearing, Petitioner filed the instant Petition.

Days later, and the night before the start of Evidentiary Hearing of the 1438 Investigation, Patent Owner moved to withdraw the majority of the asserted claims against Petitioner. *See* EX1014; EX1015. Thus, while the hearing was held, it did not concern most of the claims challenged in the Petition. Contrary to Patent Owner's narrative, Petitioners only presented a single invalidity ground at the hearing against those remaining claims based on a prior art system that has no overlap with any of the grounds the Petition.

The deadline for issuing the Final Initial Determination on that subset of claims was schedule for December 30, 2025; however, that date and the deadline for the

Commission decision and completion of the investigation is expected to change in view of the recent government shutdown.

In the Second MDNC case, Petitioners have filed a motion to dismiss for failure to state a claim, which remains pending. A bench trial to determine whether these patents are unenforceable based on Patent Owner's unclean hands and inequitable conduct, is scheduled for February 26–27, 2026. That bench trial will not involve Petitioner's invalidity challenges. A jury trial is currently scheduled for August 24–28, 2026.

III. *FINTIV* FACTORS OVERALL WEIGH AGAINST DISCRETIONARY DENIAL

To avoid any potential overlap between this IPR and the Second MDNC Case, Petitioners provide concurrently herewith a *Sotera* stipulation certifying that, if the PTAB institutes this IPR, Petitioners will not pursue the challenged claims based on any ground raised or that reasonably could have been raised during this IPR in the Second MDNC Case. *See* EX1017.³ Patent Owner's arguments under 35 U.S.C.

³ Petitioners have not filed a *Sotera* stipulation with respect to the pending ITC proceeding given the stage of that investigation. Nevertheless, there is no overlap between the Petition and the prior art being considered in the ITC. Moreover, Patent Owner withdrew most of the asserted claims from that proceeding, while the claims challenged in the Petition all remain pending in the Second MDNC Case.

§ 314(a) are, therefore, moot.

In determining whether to exercise discretion under 35 U.S.C. § 314(a) to deny institution in view of a parallel proceeding, the Board developed a framework that includes consideration of six factors (the “*Fintiv* factors”). *See Fintiv*, No. IPR2020-00019, Paper 11 at 5–6.

“These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* 6. In evaluating the *Fintiv* factors, the Board takes “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review,” recognizing that “there is some overlap among these factors” and that “[s]ome facts may be relevant to more than one factor.” *Id.* More recently, the Director issued a memorandum identifying additional exemplary discretionary criteria that may be considered and stating that parties are “permitted to address all relevant considerations.” *See* March 26 Memo. Taking a holistic view of the factors outlined for consideration, the sum of factors weighs against discretionary denial here.

A. *Fintiv* Factor 6: other circumstances that impact the Director’s exercise of discretion, including the merits

Considerations, including protecting the integrity of the USPTO system, the strength of the Petition, the lack of reliance on expert testimony, the absence of settled expectations, and the ability to correct a material error made by the Office in

issuing the challenged claims, each provide additional support for institution and weigh against discretionary denial.

First, as noted above, Patent Owner's prosecution of new continuation patents, including the '375 Patent, through prohibited involvement by its ITC Counsel, raises concerns regarding prosecution regularity. One tribunal has already noted "sufficient *prima facie* evidence" that communications involving this ITC Counsel were incident to questionable practices. *See* EX1021. Shielding patents like this one—that deviate from the purported invention by the inventors—from an IPR proceeding harms the integrity of the USPTO system.

Patent Owner's litigation strategy stymies innovation rather than promoting it. The '375 Patent was *filed for after* Patent Owner sued Petitioners in the ITC on related patents, and prosecuted using information Patent Owner obtained through litigation. Ignoring this history, Patent Owner's Request suggests "copying" by Petitioners. But that is false, as shown by the ITC's determination that there was no violation by Petitioners of the originally asserted patents.

Second, the Petition is strong. It relies primarily on Machida—which was not considered during prosecution—alone, and cites aspects of Machida for every claim limitation in certain of the challenged claims. As shown below, the technical solutions of the '375 Patent and Machida are the same, both aiming to electrically couple the drop line to the feeder cable at the nexus inside a joint encapsulated by a

mold:

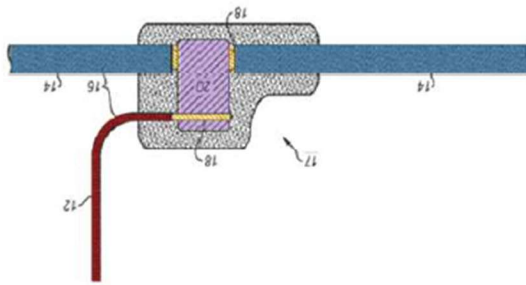


**FIG. 1³: Figure 7 of '375 Patent
(flipped and annotated)**

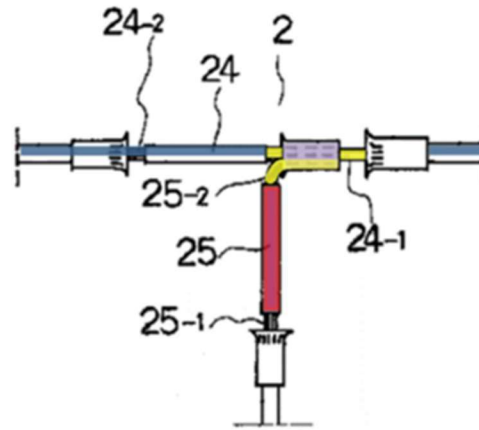


**FIG. 2: Figure 3 of Machida
(annotated)**

See Petition at 3-4. Patent Owner's argument that Machida was "apparently abandoned by Petitioner at the ITC Evidentiary Hearing in favor of what was presumably better invalidating art" (Request at 12) is a red herring. Petitioners made a strategic decision—given the remaining claims asserted by Patent Owner after it dropped so many and given the number of issues to be tried—to assert a single invalidity ground based on system prior art. That decision was by no means a concession that Machida fails to invalidate the claims asserted in this Petition.

Third, the Petition does not rely on any expert testimony, which is a factor that the Board is to consider according to the Board's interim processes workload memo.⁴

⁴ Patent Owner misstate that this IPR has "extensive expert testimony presented here"

The PTAB should be able to analyze the Petition, and underlying references, focused on the prior art without any expert declaration or deposition testimony to “fill in the gaps.” It will be able to do so for a primary reference that was not considered by the Examiner during prosecution.

Fourth, there are no “settled expectations” for this patent related to the validity of this patent that can justify a discretionary denial here. The '375 Patent issued in June 2024, and there have been no prior IPR or PGR challenges. Patents issued for less than six years establish no settled expectations. *See, e.g., Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 10 at 2–3 (PTAB June 26, 2025) (finding that patents issued for less than six years establish no settled expectation); *c.f., e.g., Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 12 at 3 (PTAB June 27, 2025) (finding opposite). The '375 Patent issued far less than six years ago and was challenged as early as practical after it was asserted against Petitioners in litigation. EX1008. Thus, there are no settled expectations of validity that can justify a discretionary denial here.

Five, this IPR is able to correct a material error made by the Examiner. Machida, which was asserted alone for many claims (Ground 1), was never presented to or considered by the Office. Nor was the combination of Machida and Solon (Ground

while there is none. *See* Request at 11.

2) or Machida and Kim (Ground 3). During prosecution, various claims of the '375 Patent were rejected only once under § 102 over Fujimoto or Harrison. EX1003, 92–104. In the Amendment and Remarks, the Applicant argued that Fujimoto fails to disclose “at least a portion of the section of exposed wire of the drop line is parallel to the section of exposed wire of exposed wire of the feeder cable” in the amended claim 1 (*id.* at 59, emphasis original) and that Harrison fails to disclose “the joint including the section of the feeder cable and the section of the one or more drop lines” as well as “a monolithic mold” in the amended claim 1 (*id.* at 61–62, emphasis original). Those amendments and remarks eventually led to the allowance of the '375 Patent. *See* Petition 9–10. Machida, as presented in the Petition, discloses these same elements (*see id.* at 18–23 & 28–29), which distinguished Fujimoto and Harrison and led to allowance. Kim and Solon disclose other claimed elements to the extent they are contended not to be met by Machida. The Examiner materially erred in not considering the relevant teachings of Machida, and in not rejecting the claims for the reasons presented in the Petition. *See Microsoft Corp. v. Partec Cluster Competence Center GmbH*, IPR2025-00318, Paper 9 at 2–3 (PTAB June 12, 2025) (finding Examiner’s successful identification of the primary § 103 reference with failure of locating two § 103 secondary references is still material error).

Patent Owner also appears to suggest that 35 U.S.C. § 325(d) should apply because Solon was cited in the '375 Patent and considered by the Patent Office. *See*

Request 13. However, Solon, which is a secondary reference that was cited only for certain well-known features in only a subset of claims, should not render any § 325(d) concerns. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (Feb. 13, 2020) (designated: March 24, 2020).

Finally, *Fintiv* Factors 1 and 2 are far from dispositive. In a recent decision, the PTAB found that the projected final written decision due date would be at least six months *after* the scheduled district court trial date and that the district court is unlikely to stay its proceeding even if the IPR is instituted. *Samsung Elecs. Co., Ltd. v. Wilus Inst. Of Stds. & Tech., Inc.*, IPR2025-00933 Paper 11 at 2 (PTAB Oct. 10, 2025). However, the challenged patents had been in effect for less than six years. *Id.* at 3. The PTAB denied Patent Owner's request for discretionary denial in view of holistic considerations, including a lack of settled expectations, "[t]he large number and wide scope of the patents asserted in the district court litigation" and material errors made by the Office, all outweighed *Fintiv* Factor 1 and Factor 2. *Id.* at 3–4. Here, the '375 Patent is issued for far less than six years and the Examiner made material errors (*see supra*). Similar to *Samsung*, the Request should be denied.

B. *Fintiv* Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

The Second MDNC Case has not been stayed thus far. However, a bench trial on Petitioners' equitable defenses of unenforceability is scheduled for February 26–27, 2026. *See* Request Exhibit EX2003. No invalidity issues will be involved in the

bench trial. A separate, later jury trial on all other remaining issues (if any), is scheduled for August 24–28, 2026. *See id.* Thus, while a stay has not been granted, if the district court finds the '375 Patent to be unenforceable in the bench trial, the jury trial would likely be vacated or stayed pending appeal of the unenforceability ruling. In that case, and in view of the *Sotera* stipulation, this IPR would be the first instance that the validity of the '375 Patent is challenged.

On the other hand, if the district court does not find the '375 Patent to be unenforceable, this IPR should still be instituted and proceed based on the *Sotera* stipulation—any ground raised or that reasonably could have been raised during this IPR, will not be presented in the jury trial.

Under either scenario, this IPR will be the only time these invalidity grounds for the '375 Patent are presented by Petitioners to a tribunal, resulting in judicial efficiency. Patent Owner's argument that "[Petitioners'] defenses would be heard in both forums" (*see* Request at 7) is no longer applicable. Therefore, Factor 1 is neutral.

C. *Fintiv* Factor 2: proximity of the court's trial date to the Board's projected statutory deadline for a final written decision

Patent Owner's argument that institution would "make no sense" rests on a false premise: that "the validity of the '375 Patent will have been fully and previously vetted twice in two other separate tribunals." Request at 7. Not so.

At the ITC, Patent Owner withdrew *sixteen* claims of the asserted twenty-two claims of the '375 Patent from the 1438 Investigation, leaving only six claims to be

addressed by the Commission. *See* EX1015. For that limited subset of claims, the ITC was only presented with a single invalidity ground based on a prior art system. Moreover, as the PTAB is well aware, the ITC determines whether a Section 337 violation has occurred and an invalidity finding does not actually render the patent invalid. *See Texas Instruments v. Cypress Semiconductor Corp.*, 90 F.3d 1558 (Fed. Cir. 1996) (holding that an invalidity determination in an ITC section 337 action does not have preclusive effect). That trial in the ITC has already occurred should have no bearing on this factor.

Even if the ITC issues a determination on invalidity, that determination will not “decide the same or substantially similar issues to those presented in the petition” since more than two-thirds of the challenged claims were withdrawn by the Patent Owner in the ITC *after* the Petition was filed. The limited overlap favors discretionary denial of institution under Factor 2. *See Fintiv*, No. IPR2020-00019, Paper 11 at 8).

Nor will the same or substantially similar issues be presented in the jury trial scheduled in the Second MDNC Case. Under the *Sotera* stipulation, Petitioners will not pursue the challenged claims based on any ground raised or that reasonably could have been raised during this IPR.

Finally, statistics suggest that median filing-to-trial time in MDNC is 42.4 months in 2023 and 30.5 months in 2024, both much longer than that of the Second MDNC Case (about 20 months). EX1027. The trial date in MDNC, even if it is set,

is highly uncertain in nature. Thus, this factor weighs against discretionary denial.

D. *Fintiv* Factor 3: investment in the parallel proceeding by the court and the parties

The Board considers the investment by both the court and the parties at the time of the institution decision for Factor 3. *See Fintiv*, No. IPR2020-00019, Paper 11 at 9.

Patent Owner's emphasis on the volume of invalidity claim charts and expert reports exchanged is misleading. First, the argument ignores the fact that the volume of invalidity contentions is a direct result of the number of claims that Patent Owner chose to assert. Indeed, Patent Owner withdrew the majority of its asserted claims *on the eve of the ITC hearing*, and ultimately, only one invalidity ground was presented on a subset of the '375 Patent claims. Thus, the investment by the ITC in adjudicating invalidity will not relate to "the same or substantially similar issues to those presented in the petition." *See Fintiv*, No. IPR2020-00019, Paper 11 at 8.

The alleged investment in the Second MDNC Case is even less persuasive. Patent Owner identifies Petitioners' invalidity contentions served in August, but does not identify any "investment" that it, or the Court, has made with respect to those contentions. There have been none. While the parties are expected to exchange expert reports in early 2026 (around the time of the institution decision), that exchange will not require any investment from the Patent Owner or the Court because the parties' investment will be limited and non-duplicative of the grounds

raised in the Petition pursuant to the *Sotera* stipulation.

Finally, Patent Owner's reliance on the February 26–27, 2026 bench trial does not help its argument. As explained in Section III.B above, whether the district court finds the '375 Patent to be unenforceable has no bearing on the invalidity issues raised in this Petition. Thus, this factor weighs in favor of institution because any investments are non-duplicative.

E. *Fintiv* Factor 4: overlap between issues raised in the petition and in the parallel proceeding

“[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Fintiv*, No. IPR2020-00019, Paper 11 at 12. As Patent Owner concedes, Machida, the primary reference for each invalidity ground in this IPR, was not presented at the Evidentiary Hearing in the 1438 Investigation. *See* Request at 9 & 12. Nor will it be presented in the Second MDNC case under the *Sotera* stipulation. The grounds and arguments are not “the same or substantially the same” between the IPR and either parallel proceeding.

In addition, Patent Owner has withdrawn *sixteen* claims of the asserted twenty-two claims of the '375 Patent, and only six claims remained being considered in the 1438 Investigation. *See* EX1015. Thus, the claims at issue are also not the same between the 1438 Investigation and this IPR.

Those withdrawn claims remain asserted in the Second MDNC Case. However,

the *Sotera* stipulation would eliminate any such overlap. Factor 4 weighs strongly against discretionary denial.

F. *Fintiv* Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same party

The parties are the same across the 1438 Investigation, the Second MDNC Case, and this IPR. Patent Owner provides no explanation for its conclusory statement that this factor favors denial of institution. This factor, if given any weight, should be neutral. *See Shenzhen Root Tech. Co., Ltd. v. Chiaro Tech. Ltd.*, IPR2024-01296, Paper 9 at 20 (PTAB Feb. 25, 2025) (finding that *Fintiv* factor 5 is neutral if parties are the same in parallel proceedings) (citing *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15 at 16 (PTAB Oct. 21, 2020) (precedential as to Section II.A); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020); *Nokia v. Soto*, IPR2023-00680, Paper 30 at 13 (PTAB Dec. 3, 2024)); *see also Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (PTAB May 15, 2020) (APJ Crumbley, dissenting).

IV. CONCLUSION

For the reasons set forth above, Petitioners respectfully request that the Director deny Patent Owner's Request for Discretionary Denial of institution of this Petition.

Petitioners' Opposition to Discretionary Denial Request
U.S. Patent No. 12,015,375

Respectfully submitted,

DATED: November 24, 2025

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U.S. Patent No. 12,015,375

Certificate of Service

Pursuant to 37 C.F.R. § 42.6(e), I certify that the foregoing PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL, with accompanying exhibits, are being served by email on the following counsel of record on November 24, 2025.

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Respectfully submitted,

Dated: November 24, 2025

/Scott L. Bittman/
Scott L. Bittman