

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RJ BRANDS, LLC d/b/a CHEFMAN,
Petitioner,

v.

SharkNinja Operating LLC,
Patent Owner.

Inter Partes Review Case No. IPR2025-01529
U.S. Patent No. 11,389,026

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

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PETITIONER’S EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,389,026 (“the ’026 Patent”)
1002	Expert Declaration of David Smith (“Smith Declaration”)
1003	<i>Curriculum Vitae</i> of David Smith
1004	File History of U.S. Patent Application 17/219,238 that issued as the ’026 Patent
1005	U.S. Provisional Application No. 62/874,193 (“the ’193 Provisional”), filed July 15, 2019
1006	File History of U.S. Patent Application No. 17/159,414 (“the ’414 Parent Application”)
1007	File History of U.S. Patent No. 11,672,377 (“the ’377 Continuation Patent”)
1008	PCT Publication No. WO2021011642A1 (“the ’642 PCT”)
1009	<i>SharkNinja Operating LLC v. RJ Brands, LLC</i> , No. 1:24-cv-08984-CPO-MJS, Dkt. No. 1 (DNJ, Sept. 5, 2024)
1010	Chinese Utility Model Patent No. CN110664270A (“Zhang”) with Certified English Translation
1011	Chinese Utility Model Patent No. CN210354396U (“Guo”) with Certified English Translation
1012	PCT Publication No. WO2018095949A1 (“Philips”)
1013	U.S. Patent Application Publication No. 2017/0231430A1 (“Moon”)
1014	PCT Publication No. WO2019068193A1 (“Conrad”)
1015	U.S. Patent Application Publication No. 2017/0245686A1 (“Man”)
1016	U.S. Patent Application Publication No. 2014/0366746A1 (“Tsai”)
1017	U.S. Patent No. 7,708,008 (“Elkasevic”)
1018	Petitioner’s Sotera Stipulation Representation, dated December 23, 2025

I. INTRODUCTION – DISCRETIONARY DENIAL IS INAPPROPRIATE

The Director should reject Patent Owner’s request for discretionary denial. Discretionary denial is fundamentally inappropriate where, as here, institution is necessary to correct a material prosecution error, there are no settled expectations to protect, and the parallel district court case will not proceed to trial until well after the Board’s Final Written Decision.

First, the Office materially erred during prosecution by failing to apply the correct priority date after new figures—on which the challenged claims expressly depend for written description support—were added during the PCT phase. That error directly enabled allowance of the claims and squarely warrants *inter partes* review. Discretionary denial cannot be used to insulate claims that issued only because of a clear mistake by the Office.

Second, Patent Owner cannot credibly assert settled expectations. The ’026 patent issued only 3.5 years ago, in July 2022, and was challenged promptly after litigation commenced, before any infringement contentions were served. Any claimed reliance interests are minimal and speculative and carry no weight under *Fintiv* or Director-review precedent. EX2001.

Third, there is no risk of inefficiency or conflicting outcomes. Trial in the parallel district court action is scheduled no earlier than April 2028—more than a

year after the expected Final Written Decision if this Petition is instituted. Institution will therefore advance, not undermine, efficiency and consistency. EX2001.

The remaining *Fintiv* factors, the absence of settled expectations, and the § 325(d) analysis all strongly favor institution. Patent Owner’s discretionary-denial request is a transparent attempt to avoid merits review of improperly issued claims and should be denied.

II. ARGUMENT

A. The Patent Office Erred During Prosecution

First and foremost, under the two-part Advanced Bionics framework, there is no basis for discretionary denial under 35 U.S.C. § 325(d), as at least some of the Grounds raised by this Petition are not the same or substantially the same as the art or arguments raised during the ‘026 Patent’s prosecution. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Pap. 6, *8 (precedential) (establishing two-part framework for addressing 35 U.S.C. § 325(d)). Discretionary denial is inappropriate “because the Office materially erred during prosecution of the challenged patent.” *Xencor, Inc. v. Merus, N.V.*, IPR2025-00603, Paper 12 at 2-3 (Director July 17, 2025). As explained in the Petition, the ‘026 Patent should not be entitled to the priority date that Patent Owner asserts. During prosecution, applicant added new figures to its specification that it relies upon for its

claims. Certain claim limitations are not shown or disclosed in the specification in any other area outside of these figures.

With respect to the references that challenge the priority date of the '026 Patent, Patent Owner incorrectly alleges “Chefman makes no attempt to demonstrate that any error occurred by the Office during prosecution.” *Patent Owner Request for Discretionary Denial (“P.O. RFDD”)*, pap. 6, at 4. This is simply untrue. The Petition fully details material error in (1) failure by the Patent Office to acknowledge the proper priority date, and (2) failure by the Patent Office to consider material prior art regardless of whether the provisional or PCT date is applied as the priority date. Institution and review of the '026 patent is appropriate because the Office committed specific material error during the patent’s prosecution. (*Microsoft Corp. v. Partec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, 3 (PTAB June 12, 2025) (“it is an appropriate use of Office resources to review the potential error.”).

1. The Patent Office Erred by Applying the Wrong Priority Date

First, the Examiner’s failure to apply the proper priority date resulted in a failure to consider the Zhang reference relied on in Grounds 1 and 2. All Challenged Claims require the first and second cooking containers each “forming a continuous outer surface...” See limitation 1[f], 11[f], 16[e] of the Challenged Claims. *Petition*, Paper 1 at ix-xiii, 6-12. The Examiner failed to appreciate that, when the Applicant filed the '642 PCT, the Applicant added disclosure that was not present in the '193

Provisional, and it was only in this new disclosure that a “continuous outer surface” was disclosed. Specifically, as outlined in detail in the Petition, only in the ’642 PCT filed well after the claimed priority date were new figures (Figures 13-15) added. *See Id.* at p. 6-12. The Applicant during prosecution elected the species covering Figures 8-15, not Figures 1-7, of the ’026 Patent, and thus support must come from Figures 11-15. *See Id.* at p. 7-8. Figs 9-11 do not, and cannot support any argument that the claimed “continuous outer surface” is shown therein. *See Id.* at p. 10. Fig. 13, which was added during filing of the ’642 PCT and is not supported by the ’193 Provisional, is the only figure in the ’026 Patent that shows the outer housing in perspective view. *See Id.* at 11-12. Because the “continuous outer surface” claim limitations were not disclosed in the ’193 Provisional, the ’026 Patent is not entitled to a priority date corresponding to the July 15, 2019, filing date of the ’193 Provisional.

The Examiner’s failure to apply the proper priority date which, at earliest, corresponds to the date of filing of the ’642 PCT, resulted in material error because material prior art (Zhang) which has a date intervening the filing of the ’193 Provisional and the filing of the ’642 PCT. Had the Examiner not erred in applying the correct priority date, the Zhang reference should have been considered. *See Microsoft*, IPR2025-00318, Paper 9, at 3 (PTAB June 12, 2025) (finding that

discretionary denial is not appropriate where the examiner overlooked material prior art).

2. Regardless of the Applied Priority Date, the Patent Office Erred by Failing to Consider Material Prior Art

Second, the Patent Office erred even if the priority date issue is not present as Ground 3 of the Petition relies on prior art (Philips) with that was overlooked and predates the filing date of the '193 Provisional. *See Microsoft*, IPR2025-00318, Paper 9, 3 (finding that discretionary denial is not appropriate where the examiner overlooked material prior art).

Thus, the Examiner erred by not finding and considering material prior art, including the references raised in the Petition. The '026 Patent was allowed with the Examiner alleging:

The prior art on the record does not anticipate or render fairly obvious in combination to teach the additional limitations of the claimed invention such as ... said first cooking container being removably receivable within said first internal compartment to close off an opening to said first internal compartment when inserted therein, and a second cooking container defining a second cooking volume, said second cooking container being removably receivable within said second internal compartment to close off an opening to said second internal compartment when inserted therein ... the first and second heating elements being independently operable to independently cook food contained within the first and second cooking containers, ... as cited in the independent claim 1; wherein the first and second cooking containers are substantially horizontally coplanar when disposed in the first and second internal cooking compartments respectively, and

wherein the first and second cooking containers have respective first and second perforated bases, ... as cited in the independent claim 18; and the first and second cooking containers being configured to engage with first and second respective channels inside the housing to define first and second respective air ducts therein ... as cited in the independent claim 23.

EX1004, p. 020-021. However, as shown in the Petition, the Examiner erred as all limitations of the Challenged Claims are met by the prior art when properly considered. Instituting the Petition would permit the Board to correct this error. Indeed, Zhang teaches and suggests the limitations the Examiner concluded was missing from the prior art, where Zhang teaches *two* cooking containers removably receivable within respective internal compartments that close respective openings thereto. *See Petition*, Paper 1 at pp. 21-32. Similarly, Philips teaches and suggests the limitations the Examiner concluded was missing from the prior art, where Philips also teaches *two* cooking containers removably receivable within respective internal compartments that close respective openings thereto. *See Id.* at pp. 56-70.

Accordingly, for at least the above reasons, because the Examiner failed to properly search for and consider the prior art, including references disclosing the limitations that the Examiner believed to confer patentability, the Patent Office erred in allowing the '026 patent. Institution is appropriate here to review this error.

3. The Board's Patent Law Expertise is Particularly Valuable for Priority Date Challenges

The Patent Owner alleges “Institution of discretionary denial should also be denied because Chefman knowingly selected grounds that trigger a complicated priority date dispute that the District Court is better equipped to resolve.” *P.O. RFDD*, p. 7. However, the fact that there is a priority dispute strongly favors Petitioner, and warrants consideration of the merits. The Board has, on numerous occasions, considered patent priority challenges. *See e.g., Samsung Electronics Co. Ltd., v. Wilus Institute of Standards and Technology Inc.*, IPR2025-01111, Paper 2, 6-14 (PTAB June 9, 2025)(presenting intervening art grounds challenging the priority date of the challenged patent); Paper 11, 5 (PTAB October 10, 2025) (denying discretionary denial). Priority Challenges are precisely the type of factual determinations where the Board’s combination of technical acumen and patent law expertise would prove especially valuable. The Board has recognized that resolving such defects is “an appropriate use of Office resources to review” in determining whether a “potential error” during prosecution has occurred. *Padagis LLC, v. Neurelis*, IPR2025-00464, Paper 12, p.3 (PTAB, July 16, 2025) While such an analysis would be standard for the Board, the complexity of the priority issues would be unfairly prejudicial to Petitioner if deferred to the district court.

Therefore, the fact that there is a priority challenge, and that an outcome of that priority challenge supports whether the Patent Office materially erred, by not

considering the Guo reference cited in Grounds 1 and 2, strongly favors denial of discretionary denial.

4. Patent Owner's Statements Regarding Moon are a Red Herring

The Patent Owner presents a red herring when it argues that Moon was “previously considered by the Office during prosecution.” *P.O. RFDD*, p. 4. Moon is relied on in Ground 3 against claims 1-4, and 7-20. *See Petition*, 56-101. The other two grounds rely on all new prior art that was not considered, or cited, during prosecution of the '026 Patent. Specifically, Moon is relied on for teaching of: “a continuous outer surface” (*Petition*, at 64-66; alternative to Philips’ teaching of the same limitation); a “handle” (*Petition*, at 73-75); and a “programmable” interface (*Petition*, at 83-84). Moon was never cited against these limitations.

Contrary to the Patent Owner’s position, the fact that Moon was before the Examiner is evidence of material error by the Patent Office. Material error during prosecution—such as overlooking features allegedly justifying patentability that are clearly disclosed in the art before the Examiner—weighs heavily against discretionary denial. *see, e.g., Eunsung Global Corp. v. Hydrafacial LLC*, IPR2025-00445, Paper 14, at 3 (PTAB July 10, 2025) (referring petition where examiner overlooked teachings in the prior art). The reliance on Moon in the petition is for features so clearly present in Moon, and when combined with the other references such as Philips. Any reliance on Moon in the Petition is merely an indication that

the Patent Examiner clearly overlooked features disclosed in Moon relevant to patentability of the '026 Patent.

Accordingly, Petitioner's citation to Moon as a secondary reference in ground 3 is not justification for discretionary denial.

B. Patent Owner Cannot Have Settled Expectations of Validity

1. The Patent Owner's Arguments are Misleading

The '026 Patent was issued approximately 3.5 years ago. Therefore Patent Owner attempts to rely on *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9 at 2 (PTAB July 24, 2025) to imply that the PTAB has recognized "strong settled expectations in a patent that has been in force for," for example, "three years." *P.O. RFDD*, p. 4. But Patent Owner misconstrues the PTAB's holding and truncates its cited quotation. The full *Amgen* citation states:

Although there may be good reasons why a patent owner has strong settled expectations in a patent that has only been in force for three years, for example an explanation of how an extraordinary amount of investment, time, and resources ***dedicated to research, development, trials, and regulatory approval correlates to settled expectations, Patent Owner has not sufficiently articulated such reasons in these proceedings.***

Amgen Inc. v. Bristol-Myers Squibb Co., IPR2025-00601, Paper 9 at 2 (PTAB July 24, 2025); emphasis added. The *Amgen* case relates to patent Nos. 9,856,320, 10,174,113, 11,332,529 each related to Cancer immunotherapy, antibodies, and pharmaceuticals which, as is well-known, require significant investment, time, and

resource due to clinical trials, FDA approval, all which occur after research and development of the product.

Patent Owner, by truncating the quote, extends the PTAB's analysis in a pharmaceutical patent to non-pharmaceutical patent technologies – and in this case small appliances. Patent Owner then alleges that “SharkNinja has invested significant time and effort to obtain a patent portfolio protecting its innovative FOODi line of appliances, including the '026 Patent. ... SharkNinja has confidently invested millions of dollars developing its Foodi line of appliances.” *P.O. RFDD*, at p. 5-6. Mere investment in time and effort is not analogous to the PTAB's *Amgen* analysis, which was limited to the pharmaceutical technology field that requires “extraordinary amount of investment, time, and resources *dedicated to research, development, trials, and regulatory approval correlates to settled expectations.*” *Amgen*, IPR2025-00601, Paper 9 at 2.

Thus, the Patent Owner's argument regarding settled expectations, based on the *Amgen* decision, fails when the entire quote, including portions intentionally left out by the Patent Owner, are considered.

2. The Board Consistently Declines to Apply Settled Expectations of Validity to even Older Claims than the Challenged Claims

Patent Owner cannot have any settled expectation of the validity of the challenged claims. As the Director has stated, “early challenges favor robust, predictable patent rights and weigh against discretionary denial.” *See ,e.g.,*

Alpinestars S.p.A. v. Dainese S.p.A., IPR2025-00750, Paper 14 at 2 (Director August 14, 2025). Patent Owner does not identify any Board decision that found three-year-old claims to create any settled expectation of validity. Indeed, even the *Amgen* decision found no settled expectation of validity. *Amgen*, IPR2025-00601, Paper 9 at 2 (ruling in favor of Petitioner and finding no settled expectations of validity for the Patent Owner in a three-year old patent). To the contrary, the Board has consistently declined to apply settled expectations even to older claims. *See, e.g., Microsoft Corp. v. Edge Networking Sys., LLC*, IPR2025-00617, Paper 12, 2. (PTAB July 31, 2025) (finding no strong settled expectations for patents issued in 2020, 2021, and 2023). The Deputy Director has routinely denied requests for discretionary denial for patents that have been in force for less than six years when the Fintiv factors weigh against discretionary denial. *See Alpinestars S.p.A. v. Dainese S.p.A.*, IPR2025-00750, Paper 14 at 2 (Director August 14, 2025).; *see also Apple Inc. v. Apex Beam Techs. LLC*, IPR2025-00896, Paper 10, at 3 (Director Sept. 3, 2025) (denying discretionary denial request for patents issued in 2021-2023 when the final written decision was due before the projected trial date and a large number of patents was asserted); *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 3 (Director, Jul. 2, 2025) (“Lastly, the challenged patents issued in 2019 and 2020, such that Patent Owner had not developed strong settled expectations that favor discretionary denial.”). Challenges to patents that have been in force for many

years longer have still been consistently characterized as “early” and “favor[ing] robust predictable patent rights and weigh[ing] against discretionary denial.” *See, e.g., Tanklogix, LLC v. Sitepro, Inc.*, IPR2025-00650, Paper 10, at 2 (PTAB July 31, 2025); *Cambridge Industries USA, Inc. v. Applied Optoelectronic, Inc.*, IPR2025-00434, -00436, Paper 11, at 2-3 (PTAB June 26, 2025); *Berkshire Hathaway,, IPR2025-00274*, Paper 23, at 3 (PTAB July 2, 2025); *Webgroup Czech Republic, A.S. et al., v. Dish Technologies LLC.*, IPR2025-00467, Paper 14, at 2 (PTAB July 16, 2025).

Accordingly, the Patent Owner cannot have settled expectations of validity of the '026 Patent. Discretionary denial is unwarranted, and the case should be considered on the merits.

C. The *Fintiv* Factors favor referral to the Board

1. Factor 1: The Likelihood of a Stay is Neutral at Best

This factor considers “whether a stay exists or is likely to be granted if a proceeding is instituted. *Fintiv*, Paper 11 at 6. Here, Petitioner intends to request a stay in the corresponding litigation if institution occurs. Therefore, at worst, this factor is neutral because the Board “will not attempt to predict” how the district court will proceed if a stay has been requested by either party. *Sand Revolution II, LLC v. 4 Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative).

2. Factor 2: The Parallel Trial Date Weighs Against Discretionary Denial

The second *Fintiv* factor assesses the “proximity of the court’s trial date to the Board’s projected statutory deadline for a written decision.” *Fintiv, Inc.*, IPR2020-00019, Paper 11 at 12. Factor 2 weighs against discretionary denial. The Board mailed its notice of filing date for this petition on September 23, 2025. This sets the statutory deadline for the Board’s Final Written Decision as March 23, 2027. The District Court Case is currently scheduled for trial in April 2028, and a Final Written Decision will issue more than a year before this case reaches trial. *See* EX2001.

3. Factor 3: The Investment in Parallel Proceeding Weighs Against Discretionary Denial

Factor 3 weighs against discretionary denial because the District Court Case involving the Petitioner is at very early stages, as admitted by Patent Owner. *Id.* To date, no discovery has taken place and with a 2028 trial date, any pressing deadlines will occur well after the institution date.

The Board recently denied discretionary denial on a Petition filed after the parties had exchanged infringement and invalidity contentions, and when claim construction is in preliminary phase. *See e.g., Samsung Electronics Co. Ltd., v. Wilus Institute of Standards and Technology Inc.*, IPR2025-01164, Paper 7, 15-16; Paper 11, 5 (denying discretionary denial). No depositions have occurred, and claim construction is still in its preliminary phase—the deadline for identifying proposed

claim terms is February 17, 2026, and the parties are scheduled to exchange preliminary claim constructions on March 11, 2026, mere days before the deadline for institution. Further, Markman is not scheduled until March of 2027 – well after the institution decision will occur and perhaps prior to a Final Written Decision in the present proceeding if instituted. *See SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01495, Paper 13, 7 (PTAB Apr. 7, 2025) (finding that *Fintiv* **factor 3 weighs against discretionary denial** where the *Markman* hearing is scheduled two weeks **after** the decision on institution is due); *Samsung Display Co. v. Pictiva Displays Int’l. Ltd.*, IPR2024-01222, Paper 12 at 7 (PTAB Mar. 6, 2025) (factor weighs against denial even though a Markman hearing had occurred in part because “much remains to be done, including expert discovery”);

Thus, Factor 3 weighs against discretionary denial.

4. Factor 4: The Overlap Between Petition and Parallel Proceeding Weighs Strongly Against Discretionary Denial Because Petitioner Agreed to Sotera Stipulations

The fourth *Fintiv* factor assesses the “overlap between the issues raised in the petition and in the parallel proceeding.” *Fintiv, Inc.*, IPR2020-00019, Paper 11 at 12. Petitioner represented to Patent Owner that it will not pursue in district court any invalidity grounds that it raised in the Petition or reasonably could have raised in an *Inter Partes* Review Petition. *See* EX1018. As the PTAB recognized in *Fintiv*, such

a stipulation “mitigates concerns of duplicative efforts and conflicting decisions,” and “weighs strongly in favor of institution.” (IPR2020-00019, Paper 11 at 12–13.)

5. Factor 5: Whether the Parties are the Same is Neutral

The parties before the Board in this inter partes review proceeding and in the parallel district court litigation are the same. Where the parties are identical between two parallel proceedings, the Board has held that this factor is “neutral or, at most, weighing slightly in favor of exercising discretion to deny institution.” *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15, at p. 16 (PTAB Oct. 21, 2020); see also *Shenzhen Root Tech. Co., Ltd. v. Chiaro Tech. Ltd.*, IPR2024- 01296, Paper 9, 19-20 (PTAB Feb. 25, 2025) (finding this factor neutral where parties are the same in both proceedings). Even if this factor weighs in favor of discretionary denial, this factor is not dispositive, and it should not outweigh the other factors favoring institution. See, e.g., *Cisco Sys., Inc. v. WSOU Invs.*, IPR2025-00188, Paper 10, 17, 23 (PTAB June 13, 2025) (instituting *inter partes* review even though the same parties were involved in the proceedings before the Board and the district court).)

6. Factor 6: Other Considerations, Including the Strength of the Petition, Weight Strongly Against Discretionary Denial

The petition is strong and likely to succeed on the merits. The only argument presented by the Patent Owner as to why the petition is not strong is because the Petitioner provided evidence as to what reference teach in view of the person of ordinary skill in the art – e.g., what “a POSITA would understand” or what “a

POSITA would recognize” when reading the cited prior art. *P.O. RFDD* at 10-11. This doesn’t make the Petition weak, it in fact does the opposite. How a POSITA would understand cited prior art is foundational to the obviousness analysis. 35 *U.S.C.A. § 103(a)* (“... obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains”). The obviousness analysis requires showing of “whether it would have been obvious ***to the hypothetical person of ordinary skill in the art***” and thus requires a showing of what the POSITA would understand. See *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1364 (Fed.Cir.2001). Mr. Smith’s explanation of how a POSITA would have understood the prior art is the purpose of expert testimony. *Unification Techs. LLC v. Micron Tech. Inc.*, No. 2023-1348, 2024 WL 3738401, at *7 (Fed. Cir. Aug. 9, 2024) (affirming Board’s unpatentability finding where expert’s opinion explained “how an ordinarily skilled artisan would have understood [the prior art’s] description of” the claim term).

The Petition relies on Mr. Smith to explain the background knowledge of a POSITA, and Mr. Smith’s testimony is supported by citations to evidence in the required manner. See 37 C.F.R. § 42.65(a); *iRhythm Technologies v. Welch Allyn Inc.*, IPR2025-00377, Paper 10 at 2-3 (Director June 6, 2025). Thus, the Petition’s showing of what “a POSITA would understand” or what “a POSITA would

recognize” when reading the cited prior art, supported by expert declaration evidence, is a component of what makes the Petition strong.

III. CONCLUSION

For the foregoing reasons, and in view of the clear material error by the Office, the lack of settled expectations, and the *Fintiv* and §325(d) factors weighing against discretionary denial, institution is warranted and the Patent Owner’s request should be denied.

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CERTIFICATE OF SERVICE

I hereby certify that on December 23, 2025, a true and correct copy of the foregoing PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL was served by electronic mail upon the following counsel of record for Petitioners.

/Bradley D. Liddle
Bradley D. Liddle