

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONTEL PRODUCTS CORPORATION,
Petitioner

v.

HAPPY PRODUCTS, INC.,
Patent Owner

IPR2025-01536
U.S. Patent No. RE48,479

PATENT OWNER'S DISCRETIONARY DENIAL BRIEFING

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2001	Patent No. RE48479 FH
2002	Complaint for Patent Infringement (including Exhibits A-D)
2003	Amended Complaint
2004	Motion to Dismiss Pursuant to Rule 12(b)(6) & Motion to Strike Pursuant to Rule 12(f)
2005	Proposed Joint Discovery Plan
2006	Text Order - Denial for Defendant's Request to Stay re: [40]
2007	Pretrial Scheduling Order
2008	Joint Letter to Magistrate Judge Almonte re Dispute Concerning Stay Pending IPR
2009	Opinion by Judge Padin re: [40] Defendant's Motion to Dismiss
2010	Pet. Stat for All Civil Trials in DNJ
2011	DNJ Patent Time to Trial Stat
2012	DNJ-2-24-cv-09819 Docket Sheet
2013	Ontel Products Corporation's Invalidity Contentions for U.S. Patent No. RE48,479 (HC-OAEO) (4)
2014	Patent No. 9642454 FH
2015	'479 patent Diagrams

Patent Owner Happy Products, Inc. (“Patent Owner”) respectfully requests that the Director exercise discretion under 35 U.S.C. § 314(a) and § 325(d) to deny Petitioner Ontel Products Corp.’s (“Petitioner”) Petition for *inter partes review* (“IPR”) of U.S. Patent No. RE48,479 (the “’479 patent”), a 2021 reissue of a patent (U.S. Patent No. 9,642,454 (the “’454 patent”) that was known to Petitioner as of 2018, and which has already received two thorough examinations by the USPTO. Pursuant to the “Interim Processes for PTAB Workload Management” Memorandum (the “*Interim Processes*”),¹ this brief only addresses Patent Owner’s bases for discretionary denial.² Here, all the considerations bearing on the Director’s discretion strongly support denying the Petition.

¹ <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf> (Mar. 26, 2025), accessed on Dec. 22, 2025.

² Following the FAQs for Interim Processes for PTAB Workload Management (“Interim Workload FAQs”), Patent Owner will file a Preliminary Response on the Petition’s merits pursuant to 37 C.F.R. § 42.107(a) consistent with the *Interim Processes* (see 37 C.F.R. § 42.107(b)), and requests that the Director “consider the merits in the [forthcoming] merits briefing” (i.e., the Preliminary Response) as part of the discretionary denial analysis. *Id.* at FAQ 12. See www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management, FAQ 12, accessed on Dec. 22, 2025.

I. LEGAL STANDARDS FOR DISCRETIONARY DENIAL

A. Discretionary Denial Under § 314(a)

The Director has discretion to deny institution under 35 U.S.C. § 314(a). *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261 (2016). The *Interim Processes* identifies considerations for such discretion, including (but not limited to) those discussed in Section V below. *Interim Processes*, 2–3. The presence of parallel district court litigation is another factor bearing on the exercise of discretion to deny institution. See *NHK Spring Co. Ltd. v. Intri-Plex Techs. Inc.*, IPR2018-00752, Paper 8 at 20 (P.T.A.B. Sept. 12, 2018) (precedential); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 17 (P.T.A.B. May 13, 2020) (precedential) (hereinafter “*Fintiv*”); see also *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (P.T.A.B. Sept. 6, 2017). *Fintiv* set forth six factors considered in determining whether to exercise discretion in view of parallel litigation, as discussed in Section III below. *Fintiv*, IPR2020-00019, Paper 15 at 7–8.

B. Discretionary Denial under § 325(d)

“[Reflect[ing] a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown,” 35 U.S.C. § 325(d) independently allows the Director to deny institution if either “[a] the same or substantially the same art . . . or . . . arguments previously were presented to the Office.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8, 9 (PTAB Feb. 13, 2020) (precedential) (citing 35 U.S.C. § 325(d)). In

such cases “the Director generally will exercise discretion not to institute *inter partes* review” unless, the Petitioner shows “that the Office erred in a manner material to the patentability of challenged claims.” *See id.* In exercising discretion under § 325(d), the USPTO considers several non-exclusive factors as discussed below in Section I *apple Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential in relevant part).

II. BACKGROUND

A. Prosecution History of the ’454 and ’479 Patents

Patent Owner’s provisional application, Ser. No. 61/896,540, was filed on October 28, 2013 (“Cannon Provisional”). Patent Owner’s first non-provisional application, Ser. No. 14/518,443, was filed on October 20, 2014 (“Cannon Application”) and published on April 3, 2015 as US 2015/0115124 (“Cannon Publ’n”). Patent Owner’s application, Ser. No. 15/192,737, was filed on June 24, 2016 (“Continuation”) as a continuation-in-part of the Cannon Application. The ’454 patent issued on May 9, 2017 from the Continuation Application.

Patent Owner’s reissue application (Ser. No. 16/262,797) based on the ’454 patent was filed on January 30, 2019 (“’479 Reissue Application”) and issued on March 23, 2021 as US RE48,479 (“the ’479 patent”). The ’479 patent claims priority to the Cannon Provisional, the Cannon Application, and the Continuation. The ’479 patent has the same figures, title, and descriptions as the ’454 patent, and includes the same first 10 claims as the ’454 patent, as well as 19 additional claims.

Collectively, the '454 and '479 patents spent about four and a half years in examination. Two different examiners rigorously evaluated and identified references Klepar II (US D703,216), Dean (US 3,746,296) and Barcalo (1,928,806), relied on by Petitioner in the Petition. Ex. 2001 at 225, 235, 236.

B. Parallel District Court Litigation

1. Overall Case Status

Patent Owner filed suit against Petitioner on October 15, 2024, in the United States District Court for the District of New Jersey (“DNJ”). Exs. 2002, 2003. Its operative First Amended Complaint brings 2 counts that Petitioner has infringed the '479 reissue patent (including claims of the original '454 patent) since early 2019. It also asserts: (a) 1 count of Trade Dress Infringement, (b) 3 counts of False Advertising, (c) 2 counts of Unfair Competition under N.J.S.A. § 56:4-1 and New Jersey common law, respectively, and (d) 1 count for Tortious Interference—for a total of 9 counts. Ex. 2003. Three other cases, against retailers who sell and/or sold Petitioner’s accused product(s), have been stayed pending the outcome of the case against Petitioner.

On March 28, 2025, Petitioner filed a Motion to Dismiss the Patent Owner’s trade dress infringement and certain other non-patent claims under Fed. R. Civ. P. 12(b)(6). Ex. 2004. On April 26, 2025, Petitioner sought to stay the case pending resolution of its Motion to Dismiss. Ex. 2005, which Judge Almonte denied on May 2, 2025 while Petitioner’s Motion to Dismiss remained pending. Ex. 2006. The Court

entered its Pretrial Scheduling Order (“PSO”) on May 12, 2025, setting all dates through the pre-trial stage, including dates for patent contentions, fact discovery, *Markman* briefing, and expert discovery. Ex. 2007.

On October 29, 2025, Petitioner requested another stay, this time pending final disposition of Petitioner’s recently-filed IPR (the instant proceeding). Ex. 2008. On November 13, 2025, Judge Padin denied in total Petitioner’s Motion to Dismiss. Ex. 2009. On November 14, 2025, Judge Almonte denied Petitioner’s request to stay the case pending resolution of the IPR, on the grounds that no IPR had been instituted. Ex. 2012. The parallel litigation is proceeding on all nine (9) counts asserted against Petitioner.

2. Contentions and *Markman*

Pursuant to the PSO, Petitioner and Patent Owner exchanged their patent-related contentions. Ex. 2007. *Markman* briefing of the disputed terms is underway, to be completed on January 16, 2026 with a *Markman* hearing held soon thereafter, and a *Markman* order would reasonably issue within the first half of 2026. Ex. 2007.

3. Discovery

Fact discovery is ongoing and has been active since May 2025. Patent Owner and Petitioner have already exchanged dozens of interrogatories (“ROGs”), and hundreds of requests for production (“RFPs”). Fact discovery will remain open through 45 days after a *Markman* decision is rendered. Expert reports will be served by 150 days after a *Markman* decision is rendered, and expert discovery will close

180 days after a *Markman* decision is rendered. Ex. 2007. Thus, the case is expected to be ready for summary judgment and/or trial **by late 2026**.

In contrast, as a decision regarding institution is not due until April 22, 2026, any final written decision (“FWD”) would likely not issue **until April 22, 2027**.

C. The Petition

The Petition presents three grounds for obviousness of the ’479 patent claims. (Pet. at 4.) Ground 1 asserts obviousness of claims 1, 2, 8–10, 12, 13, 15–17, and 19 based on the Cannon Publ’n in view of Diebel or Barcalo and/or the POSA’s knowledge; ground 2 asserts obviousness of claims 12, 13, 15–17, and 19 based on Klepar I in view of Barcalo or Dean and/or the knowledge of a Person of Ordinary Skill in the Art (“POSA”); and ground 3 asserts obviousness of claims 20–21 and 27–29 based on Barcalo in view of Klepar I/II and/or the POSA’s knowledge. *Id.*

III. APPLYING THE *FINITIV* FACTORS UNDER § 314(a) WEIGHS HEAVILY IN FAVOR OF DISCRETIONARY DENIAL

Where, as here, a corresponding district court litigation is unlikely to be stayed, the parties and issues overlap, a heavy investment has been made to litigate those issues, and the merits of the petition are not compelling, discretionary denial is favored. Accordingly, and as explained below, the petition should be denied.

A. Factor 1: The District Court Has Denied Petitioner’s Request for a Stay Twice and Is Unlikely to Grant a Stay if Review Is Instituted

The district court has denied two stay requests from Petitioner. Each time arguments about purported “simplifications” of the case, namely, potential dismissal

of Patent Owner’s trade dress and unfair competition claims, since denied, and the instant IPR Petition, were rejected. These rulings demonstrate the Court’s intention to let the case proceed, even if some claims are dismissed.

Even in the run-of-the-mill patent infringement case that includes one or two ancillary claims, it is “well-settled that where the scope of the civil litigation exceeds the scope of the IPR proceedings, it is less likely that resolution of the IPR proceedings will simplify the civil litigation’s issues.” *Gesture Tech. Partners, LLC v. LG Elecs. Inc.*, No. 21-19234 (JMV) (MAH), D.I. 50, at *10 (D.N.J. Apr. 4, 2022). Here, the bulk of the district court litigation—7 out of the 9 counts of the Amended Complaint—will be untouched by any resolution in the IPR proceedings. Because the scope of the pending case far exceeds the scope of the IPR proceedings, any motion to stay pending IPR is unlikely to be granted. *Beal v. Premier Ent. AC, LLC*, 2025 U.S. Dist. LEXIS 160495, at *5 (D.N.J. Aug. 19, 2025).

In short, it is highly unlikely a stay would be granted. As such, Factor 1 weighs heavily in favor of discretionary denial.

B. Factor 2: The District Court’s Trial Date Is Likely to Be Before the Final Written Decision Date

The precedential *Fintiv* decision, IPR2020-00019 at Paper 11, discussing the earlier *NHK* decision, expressly noted that: “[U]nder § 314(a) . . . an earlier district court trial date present[s] efficiency considerations that provide[] an additional basis, separate from the independent concerns under 35 U.S.C. § 325(d), for denying

institution. *Fintiv*, IPR2020-00019, Paper 11 at 3.

While a trial date has not been set in the parallel litigation, the PSO has claim construction briefing concluding in January 2026, and both fact and expert discovery to be completed within 180 days of the court's *Markman* decision on the disputed claim terms. Thus, the case should be ready for trial before the end of 2026—several months before any FWD. Accordingly, the rationale for discretionary denial in *NHK* also applies here. Indeed, in the later *Fintiv* and other cases, the Board expressly denied institution where a trial would occur 1–3 months before the expected FWD. IPR2020-00019, Paper 15 at 13; *see also Samsung Elecs. Co., v. SiOnyx, LLC*, IPR2025-00064, Paper No. 16 at 11 (P.T.A.B. Jun. 6, 2025) (trial date ~2 months before FWD deadline); *Cisco Sys. v. WSOU Invs. LLC*, IPR2025-00188, Paper No. 14 at 3 (P.T.A.B. Aug. 22, 2025) (trial date ~3 months before FWD deadline); *eClinicalWorks, LLC, et al. v. Decapolis LLC*, IPR2022-00229, Paper No. 10 at 9 (P.T.A.B. Apr. 13, 2022) (trial date 1–2 months before the expected FWD deadline).

Petitioner states that the median time-to-trial in the DNJ is 63.4 months (Pet. at 82.), but that figure is misleading and inaccurate because it encompasses *all civil trials* over one 12-month period. Ex. 2010. Including non-patent cases of minimal relevance inflates the result well beyond what is reasonably expected for this particular case. What matters is the figure for patent cases, which have certain procedural requirements (contentions and claim construction) keeping them on an

expeditious path to trial. Ex. 2007 at 1–3, *See* DNJ L. Pat. R.

The relevant figures that apply to the parallel litigation tell a different story. From the four years beginning January 1, 2022, the DNJ’s historical median time-to-trial for patent cases is 27 months. Ex. 2011. Thus, based on the October 15, 2024, filing of the Complaint, the statistics and currently operative Pretrial Scheduling Order indicate that the parties’ trial date is likely to occur in or around **January 2027—three months in advance** of the projected April 2027 FWD deadline.

Thus, Factor 2 weighs in favor of discretionary denial.

C. Factor 3: Substantial Effort Has Been Invested in the Parallel Litigation and More Will Be Invested Before an Institution Decision

Petitioner argues that the parties have not significantly invested time in the parallel district court litigation at the present. (Pet. at 82.) This is not only incorrect but also ignores that this factor assesses “the amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision.*” *Fintiv*, Paper 11 at 9.

The parties have expended significant effort thus far, including, among other things, preparing and filing numerous motion and letter briefings, preparing and serving hundreds of pages of infringement and invalidity contentions, propounding and responding to hundreds of discovery requests, producing and reviewing numerous documents, conducting numerous meet-and-confers, and going through the *Markman* briefing process—which will complete before an institution decision.

Furthermore, Judges Padin and Almonte have already invested substantial resources in the litigation, with 115 docket entries as of the filing of this brief. Ex. 2012. Under similar circumstances, institution is typically denied. *See, e.g., Samsung Elecs.*, Paper No. 11 at 8–9 (P.T.A.B. Feb. 9, 2024) (denying institution following the completion of fact discovery and *Markman*); and *10X Genomics*, Paper No. 15 at 18 (P.T.A.B. Mar. 7, 2024) (denying institution when parties had exchanged contentions, proceeded through *Markman* and completed substantial fact discovery).

Additionally, by the expected institution decision date, the parties and the court will have invested even more in the litigation. The parties will be proceeding through both fact and expert discovery, briefing and resolving discovery disputes, completing *Markman* briefing, and a participating in *Markman* hearing, which the court will conduct before ruling on claim construction issues.

Thus, Factor 3 also weighs heavily in favor of discretionary denial.

D. Factor 4: There Is Substantial Overlap Between Proceedings

There is substantial overlap between the issues raised in the Petition and the district court litigation. The references relied on in the Petition are *a subset* of those presented in the parallel district court litigation. The primary references in the Petition—the Cannon Publ’n, Klepar I, and Barcalo, and additional references Dean and Klepar II—were also discussed and identified in Petitioner’s invalidity contentions in the parallel litigation, for the same claims challenged in the Petition.

Ex. 2013 at 27–30; (Pet. at 4–5.) And all of the claims of the '479 patent asserted in the underlying litigation are challenged in the Petition. *See* Ex. 2013 at 2; (Pet. at 17.) Also, no differences regarding the Person of Ordinary Skill (POSA) or the POSA's motivations to combine references are presently apparent.

There is one important difference regarding the Cannon Publ'n—the publication of the Cannon Application to which the '479 patent claims priority. The Petition alleges obviousness of the claims over the Cannon Publ'n in view of additional references. In the district court, Petitioner contends that the Cannon Publ'n *anticipates* claims 1–2, 8–10, 12–13, 15–17, and 19. These contentions are wholly inconsistent with Petitioner's position that the Cannon Publ'n lacks written description support for the claims, such that the '479 patent cannot claim priority to the Cannon Application. In other words, Petitioner's contention that the Cannon Publ'n is prior art is plainly contradicted by its contentions in the parallel litigation that the Cannon Publ'n *discloses* every limitation of claim 1 and its challenged dependent claims. Both cannot be true simultaneously.

Except for this one difference—which supports a conclusion that the Cannon Publ'n is *not* prior art—all of the references and arguments relied on in the Petition are also presented in the parallel litigation. Thus, the IPR would be duplicative of the parallel district court litigation and an inefficient use of the Board's and the court's resources. *See, e.g., Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-

00122, Paper 15 at 10 (P.T.A.B. May 15, 2020).

At the time Petitioner filed its Petition, it knew that there would be significant overlap between the arguments it selected to advance therein and those arguments it chose to make in the parallel litigation. So Petitioner should have, at the very least, filed a *Sotera* stipulation at the time of its Petition filing. But it did not.

Thus, Factor 4 weighs heavily in favor of denying institution.

E. Factor 5: Petitioner Is a Defendant in the Parallel Litigation

Petitioner does not dispute that it is a defendant in the parallel litigation. “Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Fintiv*, Paper 15 at 15.

F. Factor 6: The Petition’s Weaknesses Weigh in Favor of Denial

Under the sixth *Fintiv* factor, the Director may consider other circumstances that impact the Director’s exercise of discretion, including the merits. *Fintiv*, IPR2020-0019, Paper 11 at 14–15; *see also Interim Processes* at 2 (stating that the parties may address all relevant considerations, including “[t]he strength of the unpatentability challenge”). While certain flaws are summarized below, the merits will be addressed extensively in Patent Owner’s forthcoming Preliminary Response.

1. The Cannon Publ’n is Not Prior Art

Petitioner’s primary reference for **Ground 1** is the Cannon Publ’n.

	Claims	IPR Prior Art	Prosecution Prior Art
1	1, 2, 8-10; 12, 13, 15-	US 2015/0115124 (“Cannon Publ’n”) US 8,960,421 (“Diebel”)	[Cannon Appl’n]

	17, 19	US 1,928,806 (“Barcalo”)	US 1,928,806 (“Barcalo”)
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But as noted above and discussed below, the Cannon Publ’n is *not* prior art—it is a publication of an application to which the ’479 patent properly claims priority. The prosecution history reflects rigorous review by the Examiners and, as appreciated during examination of the reissue application, the differences from the priority Cannon Application pertain to the unnecessary verbatim recitation of angles that would have been not just evident to a POSA (and the Examiner) given other disclosures in the patent and its file history but immediately apparent.

In the parallel litigation, Petitioner conceded that the Cannon Application discloses all the limitations of the claims. Ex. 2013 at 85–94. The Petition itself admits that, with respect to the plane angles recited in claim 1, “it would have been obvious to a POSA,” in view of Cannon (i.e., the priority application) “to calibrate the back support” to achieve the recited angle. (Pet. at 45.) And similarly, with respect to the viewing angles recited in claim 1, the Petition admits that “it would have been it would have been obvious to a POSA . . . to modify the plane angles in Cannon and then estimate and optimize for the viewing angles.” (Pet. at 46.)

Where, as here, a claimed limitation would be understood by (“obvious to”) a POSA from the disclosures of the specification, there is no lack of written description for non-disclosure of that limitation. *See All Dental Prodx LLC v. Advantage Dental Prods.*, 309 F.3d 774, 779 (Fed. Cir. 2002) (finding adequate written description

where a POSA “would recognize upon reading the specification that [] new language reflects what the specification shows has been invented.”); *c.f. Nuvo Pharms. (Ireland) Designated Activity Co. v. Dr. Reddy’s Lab’ys Inc.*, 923 F.3d 1368, 1380 (Fed. Cir. 2019) (written description was lacking because a POSA “reading the specification would **not** have otherwise recognized” the claimed limitation). Thus, the ’479 priority claim is legitimate and the Cannon Publ’n is not prior art.

For this reason, Ground 1 of the Petition—the only ground for alleged unpatentability of claims 1, 2, and 8–10—is without merit.

2. The Grounds are Based on Prior Art Considered During Prosecution, Over Which the ’479 Patent Properly Issued

With the sole exception of Klepar I, which is duplicative of Klepar II—all of the art in **Grounds 2 & 3** was before the Examiners and considered in prosecution:

	Claims	IPR Prior Art	Prosecution Prior Art
2	12, 13, 15-17, 19	US 2015/0189781 (“Klepar I”) US 1,928,806 (“Barcalo”) US 3,746,296 (“Dean”)	US 1,928,806 (“Barcalo”) US 3,746,296 (“Dean”)
3	20, 21, 27-29	US 1,928,806 (“Barcalo”) US 2015/0189781 (“Klepar I”) US D703,216 (“Klepar II”) US 3,746,296 (“Dean”)	US 1,928,806 (“Barcalo”) US D703,216 (“Klepar II”) US 3,746,296 (“Dean”)

But the utility patent application of Klepar I describes ***the exact same*** tablet stand as the Klepar II design patent, and any differences in their respective figures are due to the different standards for such. *Compare* MPEP §§ 1503.02 with 608.01(f); *see also* MPEP § 2125. It is, at best, cumulative; Petitioner identifies

nothing in Klepar I beyond what would have been apparent to a POSA viewing the figures of Klepar II. *Compare* Ex. 1012 at Fig. 2 with Ex. 1013 at Fig. 1; *see also* Ex. 2015. Petitioner cites Klepar I’s discussing “a multi-position stand” with two panels “configured to support” an electronic display with a third side that forms a base, and its explanation that the device is used to position and support a media at different viewing angles (Pet. at 34–35), but this merely describes what the figures of Klepar II, already considered, depict to a POSA.

3. Petitioner’s Grounds Impermissibly Rely on the Knowledge of a POSA for Disclosure of Recited Claim Elements

On July 31, 2025, the Patent Office clarified that, pursuant to 37 C.F.R. § 42.104(b)(4), “*an IPR petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.*”³ *See Qualcomm Inc. v. Apple Inc.*, IPR2023-1208, 2023-1209, D.I. 55 (P.T.A.B. Apr. 23, 2025). “[E]xpert testimony, common sense, and other *evidence that is not ‘prior art consisting of patents or printed publications’* (collectively, ‘general knowledge’) *may not be used to supply a missing claim limitation.*” *Id.* “The Board *shall deny an IPR petition that fails to comply with Rule 104(b)(4).*” *Id.*

³https://www.uspto.gov/sites/default/files/documents/aapa_memo_final_signed.pdf?utm_campaign=subscriptioncenter&utm_medium=email&utm_source=govdelivery, accessed on Dec. 22, 2025.

Because the Petition impermissibly relies on the “knowledge of the POSA” to supply various claim limitations absent from the prior art, Rule 104(b)(4) requires denial. Indeed, the Petition’s statement of grounds explicitly identifies the “knowledge of the POSA” as a “basis for unpatentability. (Pet. at 4.)

The Petition’s mapping of the claims to the cited prior art confirms that it is *exclusively* relying on the knowledge of the POSA for at least one limitation of each independent claim (i.e., 1, 12, & 20) and for each of the three Grounds, for example:

- In claim 1, the “*plane angle of 40 degrees*” (Pet. at 45 (“it would have been obvious to a POSA to calibrate the back support relative to a virtual plane . . . such that a third plane angle is 40 degrees.”)); and the *viewing angles of 36, 74, and 49 degrees* (see Pet. at 46);
- In claim 12, the *support angle* (Pet. at 51 (“[i]t would have been obvious to a POSA to configure a media support apparatus having a support back and support edge that are configured to support a media device as a support angle.”)); and the “*third support back*” (Pet. at 59 (a POSA would be motivated “to change the orientation of L-channel (32) such that it generates three support backs”)); and
- In claim 20, the “edge support width with an edge angle to an adjacent back support in the range of 85 to 120 degrees to [a] back support.” (Pet at 74 (“determining width and angle of the edge support . . . would be the routine work of the POSA” and “a POSA would have a reasonable expectation that the edge supports that would be configured . . . would be in the range of 85 to 120 degrees.”)

Under 37 C.F.R. § 42.104(b)(4), this independently requires denial of the Petition.

Overall, Factor 6 favors denial due to the weaknesses of Petitioner’s challenges.

IV. THE OVERLAP WITH PREVIOUSLY-CONSIDERED ART AND ARGUMENTS WARRANTS DENIAL UNDER 35 U.S.C. § 325(D)

Here, discretionary denial under § 325(d) is warranted because “the same or substantially the same prior art . . . [was] presented to the Office” (*Advanced Bionics* at 7), and Petitioner’s cursory attorney argument (Pet. at 83–84) does not show that the Office erred in a manner material to the patentability of the challenged claims.

A. Substantially the Same Prior Art Was Previously Presented to the USPTO (*Becton-Dickinson* factors 1–2, and 4)

Factors 1 and 2: Because all of the art cited in the Petition is substantially the same as or cumulative of the art cited and applied during prosecution, the first two *Becton-Dickinson* factors favor denying institution. Barcalo, Dean, and Klepar II were previously considered by the Examiner(s) and rejected. *See, e.g.*, 2001 at 12, 37, 87–89, 231–36. And the Cannon Publ’n is *not* prior art—it is a publication of an application, *previously considered by the Examiner(s)*, to which the ’479 patent legitimately claims priority. *See, e.g.*, Ex. 2014 at 62; Ex. 2001 at 37, 52, 67–68. Diebel was not of record, but is cumulative of previously-considered prior art with similar disclosures of varying viewing angles, which were rejected. *See, e.g.*, Ex. 2001 at 12, 22–25, 87–92, 145–46, 173, 183–96, 235. Klepar I is cumulative of the previously-considered Klepar II, and Petitioner identifies therein nothing else material to the claims. *See, e.g.*, 2001 at 22–25, 87–92, 145–46, 173, 183–96, 235.

Factor 4: Based on the extensive overlap between arguments made during

prosecution and the arguments in the Petition, this factor also weighs in favor of denying institution, as will also be elaborated in the Preliminary Response.

B. Petitioner Has Not Shown Material Error (Factors 3, 5, & 6)

The Petition's two-paragraph discussion of "errors" only disputes the Examiners' conclusions (Pet. at 83–84); it falls far short of showing any "material error" by the Examiner under prong two of the *Advanced Bionics* framework.

Factor 3: As noted above, the prior art relied on by Petitioner was considered by the Office during the prosecution and reissue. This favors denial.

Factor 5: Petitioner has not met its burden to identify evidence to demonstrate how the Examiners erred in evaluating the asserted prior art. *See Advanced Bionics* at 9. Rather, the presumption of regularity for Examiners indicates that Examiners acted lawfully, in good faith, and followed procedures, and Petitioner has not shown otherwise. *See W. Elec. Co. v. Piezo Tech., Inc.*, 860 F.2d 428, 433 (Fed. Cir. 1988). Petitioner's argument that Examiner should have utilized (unspecified) "other prior art" in view of the Barcalo reference (Pet. at 84) ignores that Barcalo was the basis for initial rejection during the reissue prosecution and Klepar II was specifically discussed as having similar disclosures. This factor also favors denial.

Factor 6: Nothing presented in the Petition warrants reconsideration. As the forthcoming Preliminary Response will elaborate, the Petition primarily rehashes the teachings of Barcalo and Klepar II. The Petition's single-sentence assertion that the

Examiner didn't appreciate the "priority" issue is legally insufficient and factually unsupported. (Pet. at 84.) The record reflects a consistent and proper assessment.

Petitioner also mischaracterizes Patent Owner's position in the parallel litigation (Pet. at 85); the actual position, consistent with Patent Owner's arguments during prosecution, is that each of the three sides of the media support has two different plane angles. *See*, Ex. 2015. And that argument was already considered and accepted by the Examiner during prosecution. Ex. 2001 at 88. There is nothing that would warrant reconsideration of the prior art or arguments.

Finally, Petitioner is incorrect that its reliance on its expert's conclusory declaration supports institution (*see* Pet. at 85); rather, as discussed below, it supports denial. Moreover, the two examiners overseeing the original and reissue proceedings were considered experts in the field, and did not need the extraneous and erroneous declaration supplied by Petitioner.

Because all of the *Becton-Dickinson* factors weigh against Petitioner, the Director should exercise discretion under § 325(d) and decline to institute IPR.

V. OTHER *INTERIM PROCESSES* CONSIDERATIONS FAVOR DENIAL

First, institution of the IPR would not be a "true alternative" but rather will merely be an addendum to the parallel litigation, resulting in duplication of effort and potentially inconsistent rulings. *See Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3–4 (P.T.A.B. Mar. 28, 2025).

Second, as discussed above and as will be further detailed in the forthcoming Preliminary Response, the invalidity challenge is not well-founded on the merits.

Third, Petitioner’s extensive reliance on a 126-page expert declaration that offers minimal (if any) explanation and merely parrots the conclusory statements in the Petition further supports discretionary denial. Especially in view of Patent Owner’s plans to respond with its own expert, this “suggest[s] that the questions are better resolved in an Article III court.” *See* PTAB Interim Workload FAQs.

Fourth, the “[s]ettled expectations of the parties, such as the length of time the claims have been in force” also supports denial. *See Interim Processes* at 2. The ’479 patent is a reissue dated March 23, 2021 (nearly 5 years ago) of the ’454 patent, issued on May 9, 2017 (over 8.5 years ago), and its first 10 claims are identical to those of the ’454 patent. Petitioner was aware of the ’454 patent from ordering Patent Owner’s marked products since October 2018, and of the existence of the new claims of the ’479 patent since Patent Owner’s Amazon UPNE filing on April 1, 2021.

Finally, denial is supported by the compelling need to protect American economic interests, i.e., the interests of American innovators whose businesses are, like Patent Owner’s, being eviscerated by cheap counterfeits imported from China.

VI. CONCLUSION

All six *Fintiv* factors, § 325(d), and the other considerations outlined in this brief favor discretionary denial. The Director should therefore exercise discretion to deny institution under § 314(a) and § 325(d).

Respectfully submitted,

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CERTIFICATE OF PAGE COUNT

The undersigned certifies that this brief is no more than 20 pages, exclusive of table of contents, table of authorities, table of exhibits, and certificates, according to the page count of the word-processing system used to prepare this paper.

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CERTIFICATE OF SERVICE

I hereby certify that on December 22, 2025, I caused a true and correct copy of **PATENT OWNER'S DISCRETIONARY DENIAL BRIEFING** to be served via electronic mail on the following counsel for Petitioner:

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