

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACCELIGHT TECHNOLOGIES, INC.,

Petitioner,

v.

APPLIED OPTOELECTRONICS, INC.,

Patent Owner.

Case IPR2025-01567

Patent No. 10,379,301

**PATENT OWNER'S REQUEST TO DIRECTOR FOR DISCRETIONARY
DENIAL OF PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT 10,379,301**

**(Pursuant to Acting Director's Memorandum of March 26, 2025 and
Director's Memorandum of October 17, 2025)**

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EXHIBITS

Exhibit No.	Description
2001	Acting Director Stewart’s March 26, 2025 Memorandum entitled “Interim Processes for PTAB Workload Management”
2002	Director Squires’ October 17, 2025 Memorandum entitled “Director Institution of AIA Trial Proceedings”
2003	In IPR2025-00434 filed by Cambridge Industries USA Inc.: Patent Trial and Appeal Board’s Decision denying petition for inter partes review (IPR2025-00434) of U.S. Patent No. 10,379,301 dated July 29, 2025
2004	Petitioner's Invalidity Contentions in <i>Applied Optoelectronics, Inc. v. Accelight Technologies, Inc.</i> , case no. 4-24-cv-09041-HSG (N.D. CA) served on May 30, 2025
2005	District Court’s Scheduling Order in <i>Applied Optoelectronics, Inc. v. Accelight Technologies, Inc.</i> , case no. 4-24-cv-09041-HSG (N.D. CA) filed on April 23, 2025
2006	District Court’s Order in <i>Applied Optoelectronics, Inc. v. Accelight Technologies, Inc.</i> , case no. 4-24-cv-09041-HSG (N.D. CA) staying case filed on October 9, 2025
2007	District Court’s Scheduling Order in <i>Applied Optoelectronics, Inc. v. Cambridge Industries, Inc.</i> , case no. 3:24-cv-01010-JD (N.D. CA) filed on August 8, 2024
2008	July 31, 2025 Memorandum from Acting Director Stewart
2009	Director Squires’ November 17, 2025 Memorandum entitled “Voluntary Search Disclosure Declarations as a Favorable Factor in Institution Decisions”

I. INTRODUCTION

This request is submitted by Patent Owner Applied Optoelectronics, Inc. (“AOI”) to the Director of the United States Patent and Trademark Office (“USPTO”) pursuant to the Acting Director’s March 26, 2025 Memorandum “Interim Processes for PTAB Workload Management” and the Director’s October 17, 2025 Memorandum “Director Institution of AIA Trial Proceedings” (collectively the “Memoranda,” Exhibits 2001 and 2002).

This is AOI’s separate brief, pursuant to the Memoranda, requesting a discretionary denial of the petition (the “Petition”) of Accelight Technologies, Inc. (“Petitioner” or “Accelight”) for an *inter partes* review (“IPR”) of U.S. Patent No. 10,379,301 (the “’301 Patent”, Exhibit 1001) entitled “Multi-Channel Parallel Optical Receiving Device.”

The Director should exercise his discretion and deny the Petition for IPR in this case because the ’301 Patent has already been the subject of a different IPR petition which was denied by the Board on July 29, 2025 for similar substantive reasons as this Petition fails here, because there are settled expectations in this over six-year old patent, as well as or the other reasons set forth below.

For example, in denying CIG’s prior petition for IPR of the ’301 patent, the Board found the identified art “failed to disclose ‘the plurality of optoelectronic

diodes electrically connected to the light receiving chip via bonding wire,’ as recited in limitation [1d]” of independent claims 1 of the ’301 Patent. Similarly, here, Accelight admits the cited art “does not explicitly disclose [the] optoelectronic diodes,” and instead argues “[a] POSITA would have known that a ‘surface-illuminated’ photodetector is an optoelectronic diode.” See Petition at p. 24. But, in an IPR, Accelight cannot argue that a person of ordinary skill in the art (POSITA) would inherently understand or fill a gap based on background knowledge. See Exhibit 2008. Further, the cited art fails to identify other limitations such as “the plurality of optoelectronic diodes electrically connected to the light receiving chip via bonding wire” limitation, the “optical fiber connector disposed on an end of the carrier” limitation, and the “an arrayed waveguide grating further disposed on a top surface of the carrier that defines a midpoint of the carrier” limitation.

For these reasons, and the others outlined below, the IPR should be denied.

II. FACTUAL BACKGROUND

A. The ’301 Patent

Application no. 15/432,242 for the ’301 Patent was filed on February 14, 2017. See “’301 Patent File History”, Exhibit 1002. (Please see Exhibit 1002 for the full prosecution history.) The ’301 Patent issued on August 13, 2019 with seven claims, including two independent claims.

B. Prior and Pending Petitions for IPR Filed Against AOI Patents

The '301 Patent was the subject of a prior petition for IPR filed by another party, Cambridge Industries USA, Inc. ("CIG"). CIG's petition, IPR2025-00434, was filed on January 17, 2025. In that proceeding, AOI filed a request for discretionary denial, and then a Preliminary Response. On July 29, 2025, the Board denied CIG's petition for IPR on substantive grounds. *See* Exhibit 2003.

Specifically, the three-Judge panel of the Board was "not persuaded that Petitioner demonstrates a reasonable likelihood of prevailing on its anticipation challenge to independent claim 1" because, at a minimum, the art identified by CIG "does not disclose 'the plurality of optoelectronic diodes electrically connected to the light receiving chip via bonding wire,' as recited in limitation [1d]" of independent claims 1 and 7 the '301 Patent. *See id.* at p. 18; *see also id.* at p. 26. The Board also found some of the art "does not disclose 'an arrayed waveguide grating further disposed on a top surface of the carrier that defines a midpoint of the carrier' and that 'the top surface of the carrier underlies the middle of the arrayed waveguide grating,' as recited in limitation [1f]" of the '301 Patent. *Id.* at p. 25. Thus, the Board has already denied IPR of the '301 Patent on substantive grounds.

On January 17, 2025, CIG also filed petitions for IPR for U.S. Patent No.

10,042,116 ('116 Patent); U.S. Patent No. 9,523,826 ('826 Patent); U.S. Patent No. 10,313,024 ('024 Patent); and U.S. Patent No. 10,788,690 ('690 Patent). Two of those petitions were discretionarily denied by the Acting Director (for the '116 and '826 patents). And, like the petition for IPR of the '301 Patent, the petition for IPR of the '024 Patent was denied by the Board on substantive grounds. Thus, only one of the five IPR petitions filed by CIG was instituted (for the '690 patent).

Similar to CIG, Petitioner, in addition to this petition for IPR of the '301 Patent, has also filed petitions for IPR of four other AOI patents: the '116 Patent, '826 Patent, '690 Patent, and U.S. Patent No. 9,448,367 ('367 Patent) (which is the only patent that has not been the subject of a prior IPR petition). AOI is separately filing Requests Discretionary Denial of Petitioner's petitions for IPR of the '116, '826, and '367 patents.

Thus, of the five AOI patents challenged by Petitioner in IPRs, three are the subject of prior petitions for IPR that were denied, including the previous petition for IPR of the '301 Patent.

C. The Litigation Between AOI and Petitioner Accelight

On December 13, 2024, AOI filed a lawsuit against Petitioner for patent infringement in the case captioned *Applied Optoelectronics, Inc. v. Accelight Technologies, Inc.*, case no. 4:24-cv-09041-HSG (N.D. CA) (the "Accelight

Litigation”). The complaint alleges infringement of six AOI patents, including the ’301 Patent. In the Accelight Litigation, Accelight alleges that each of the six patents-in-suit is invalid. Accelight has filed petitions for IPR of five of the six patents.

On April 15, 2025, AOI served its infringement contentions, stating that Petitioner infringes claims 1-4 of the ’301 Patent. On May 30, 2025, Petitioner served its invalidity contentions. *See* Exhibit 2004. In its invalidity contentions, Petitioner contends that claims 1-4 are invalid under either § 102 or § 103 based on four grounds that each rely on one or more of five different references. The following grounds are relevant here: (1) anticipated by or obvious over U.S. Patent No. 9,110,260 to Lee, or obvious over Lee in view of U.S. Patent Application Publication No. 2014/0169389 to Kim; (2) anticipated by or obvious over Kim, or obvious over Kim in view of another reference. *See* Exhibit 2004, p. 9.

Pursuant to the District Court’s Scheduling Order, between May 30, 2025 and October 7, 2025, Petitioner served invalidity contentions and documents; the parties exchanged proposed terms for claim construction, preliminary constructions and extrinsic evidence, and damages contentions; and the parties filed a Joint Claim Construction Statement and Prehearing Statement, and opening, responsive, and reply claim construction briefs. *See, e.g.* Exhibit 2005.

On October 9, 2025, the District Court granted the parties' joint motion to stay the case based on Petitioner's petitions for IPR. *See* Exhibit 2006. The Court ordered the parties to regularly file joint status reports, including after any PTAB decision on any of Petitioner's petitions for IPR.

D. The Litigation Between AOI and CIG

On February 20, 2024, AOI filed a lawsuit against CIG for patent infringement in the case captioned *Applied Optoelectronics, Inc. v. Cambridge Industries, Inc.*, case no. 3:24-cv-01010-JD (N.D. CA) (the "CIG Litigation"). The complaint alleges that Petitioner infringes eight of AOI's patents, including the '301 Patent. In the CIG Litigation, CIG alleges that each of the eight patents-in-suit is invalid. CIG has filed petitions for IPR of five of the eight patents.

Pursuant to the District Court's Scheduling Order, between May 2024 and March 2025, AOI and CIG exchanged initial disclosures, infringement and invalidity contentions, proposed terms for claim construction, preliminary claim constructions, and extrinsic evidence; filed a Joint Claim Construction Statement and Prehearing Statement; exchanged damage contentions; and filed opening, responsive, and reply claim construction briefs. *See* Exhibit 2007.

On March 19, 2025, AOI and CIG notified the District Court that CIG had filed petitions for IPR of five of the eight patents-in-suit. On April 4, 2025, the

District Court issued an order staying the case, ordering the parties to regularly file joint status reports on the status of CIG's petitions for IPR.

E. The Petition for *Inter Partes* Review

On September 26, 2025, nine months after AOI filed its complaint in the Accelight Litigation, Petitioner filed its Petition for IPR of the '301 Patent.

In the Petition, Petitioner challenges claims 1-4 of the '301 Patent. Petitioner asserts two grounds of invalidity: (1) claims 1-4 are obvious over Kim (U.S. Patent Application Publication No. 2014/0169389, Ex. 1004); and (2) claims 1-4 are obvious over Ho (U.S. Patent Application Publication No. 2014/0341578, Ex. 1005) in view of Lee (U.S. Patent Application Publication No. 2014/0183344, Ex. 1006).

Pursuant to the Notice of Filing Date, Patent Owner's Preliminary Response is due by January 7, 2026. Pursuant to the PTAB's "Consolidated Trial Practice Guide – November 2019" and the Director's October 17, 2025 Memorandum (Ex. 2002), the Director will determine whether to institute an IPR within three months of the date Patent Owner's Preliminary Response was filed or was due, by about April 7, 2026. If IPR is instituted, pursuant to 35 U.S.C. § 316(a)(11), the PTAB will set the trial date within one year of the notice of institution, no later than about April 7, 2027.

III. INSTITUTION OF *INTER PARTES* REVIEW SHOULD BE DENIED PURSUANT TO THE DIRECTOR'S DISCRETION.

The Director should exercise his discretion pursuant to the Memoranda (Exhibits 2001 and 2002) and deny institution of IPR on the '301 Patent. The following factors support a discretionary denial:

- In just the last few months, the '301 Patent has already been the subject of a different petition for IPR (by CIG) which was denied by the Board.
- There is significant overlap between the issues in the Petition and in the Accelight Litigation.
- There has been significant investment in the Accelight Litigation in that substantive issues have already been addressed by the parties.
- There are settled expectations in the enforcement of the '301 Patent as the patent has been in force for over six years.
- Petitioner's arguments on unpatentability are weak.
- Petitioner and the defendant are the same party.
- The '301 Patent is one of the patents-in-suit in the CIG Litigation, and claim construction and validity of the '301 Patent may well be adjudicated before the PTAB's decision in an IPR.
- There are no relevant changes in the law that affect patentability.
- The Accelight Litigation must go forward because not all asserted

patents are subject to IPRs.

- Any Search Disclosure Declaration (“SDD”) filed by Petitioner pursuant to Director’s November 17, 2025 Memorandum is at a most a neutral, rather than favorable, factor with respect to this Petition because Petitioner primarily relies on U.S. patents and applications.

Each of these factors is discussed separately below in sections A through J

A. A Petition for IPR of the ’301 Patent has Already been Denied.

CIG filed its petition for IPR of the ’301 Patent, IPR2025-00434, on January 17, 2025, challenging all claims, including claims 1-4 that are challenged here. In that proceeding, AOI filed a request for discretionary denial, followed by the Patent Owner’s Preliminary Response. The Board denied CIG’s petition on July 29, 2025 because the Board found the identified art failed to disclose all of the limitations of claims 1-7 of the ’301 Patent. *See Exhibit 2003.*

B. The Issues in the Petition Significantly Overlap the Issues in the Accelight Litigation.

There is significant overlap between the issues (claims, art, arguments, and evidence) asserted in the Petition and in the Accelight Litigation. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, p. 6 (March 20, 2020) (precedential). “[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.”

First, the same claims are challenged in the Petition as are challenged in the Accelight Litigation (claims 1-4). Second, two of the three references relied upon in the Petition (Lee and Kim) are also relied upon by Petitioner (together with one other reference) in two of the invalidity grounds asserted in the Accelight Litigation. See Exhibit 2004, p. 9. Third, both of the grounds for invalidity in the Petition are the same or substantially the same as two of the grounds asserted in the Accelight Litigation. In Ground 1 of the Petition, Petitioner argues that claims 1-4 are obvious over Kim; in the Accelight Litigation, Petitioner argues that claims 1-4 are anticipated by or obvious over Kim. In Ground 2 of the Petition, Petitioner argues that claims 1-4 are obvious over Ho in view of Lee; in the Accelight Litigation, Petitioner argues that claims 1-4 are anticipated by or obvious over Lee.

Moreover, the Accelight Litigation involves three other references and two other grounds challenging the '301 Patent that are not asserted in the Petition. And the Accelight Litigation also involves five other patents. Thus, the Accelight Litigation will need to go forward regardless of whether IPR is instituted. The fact that the Accelight Litigation involves additional challenges to the '301 Patent

weighs in favor of a denial. *See Next Caller Inc. v. Trustid, Inc.*, IPR 2019-00963, Paper 8, p. 12 (October 28, 2019) (informative).

C. The Parties Have Invested in the Accelight Litigation by Addressing Substantive Issues.

The Accelight Litigation progressed to a claim construction hearing before the case was stayed on October 9, 2025. The parties had exchanged proposed terms for claim construction, preliminary constructions and extrinsic evidence, and damages contentions; and the parties filed a Joint Claim Construction Statement and Prehearing Statement, and opening, responsive, and reply claim construction briefs. Thus, the parties have spent significant time and effort in litigating substantive issues. *See* Exhibits 2005 and 2006.

D. There Are Settled Expectations in the '301 Patent.

The '301 Patent was issued on August 13, 2019. The patent has been in force for over six years, almost one-third of the life of the patent. Thus, there are settled expectations that the '301 Patent is valid and enforceable.

E. Petitioner's Arguments on Unpatentability are Weak.¹

Similar to CIG's denied petition, the cited art here fails to disclose "a plurality of optoelectronic diodes disposed on the top surface of the end of the

¹ For purposes of this Request to the Director for Discretionary Denial, AOI will

carrier, and the plurality of optoelectronic diodes electrically connected to the light receiving chip via bonding wire, wherein the optoelectronic diodes and the light receiving chip are disposed directly on the same top surface of the end of the carrier” as required by independent claim 1. Claims 2-4 depend from claim 1 and thus also fail to disclose this limitation.

1. Ground 1 - Kim

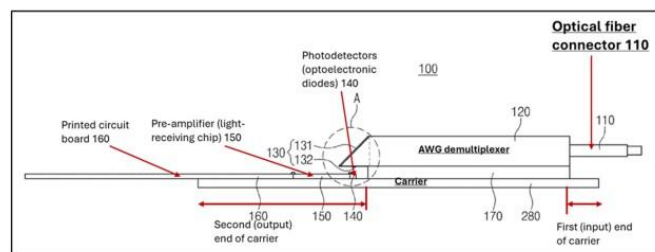
For example, with respect to Kim, Petitioner admits “Kim does not explicitly disclose that the photodetectors 140 are optoelectronic diodes,” and instead argues “[a] POSITA would have known that a ‘surface-illuminated’ photodetector is an optoelectronic diode.” See Petition at p. 24. However, such an approach using “general knowledge”—a broad category encompassing AAPA, expert declarations, common sense, and other non-patent or non-printed publication evidence—*cannot be used* to supply a missing claim limitation in an IPR. See Exhibit 2008 at p. 1, July 31, 2025 Memorandum from Acting Director Stewart (emphasis added). Thus, as here, if a prior art reference admittedly lacks a specific element, petitioners can no longer argue that a person of ordinary skill in the art (POSITA) would

only discuss a few specific examples of limitations the cited references fail to disclose.

inherently understand or fill that gap based on background knowledge, and the IPR should be denied. *See id.* (“As a practical matter, enforcement of Rule 104(b)(4) means that applicant admitted prior art (AAPA), expert 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. Per 35 U.S.C. § 312(a)(4), the Board shall deny an IPR petition that fails to comply with Rule 104(b)(4).”).

Kim also fails to disclose the “the plurality of optoelectronic diodes electrically connected to the light receiving chip via bonding wire.” For example, there is no disclosure or mention of a “bonding wire” in Kim. Instead, Kim discloses “the pre-amplifier 150 is electrically connected to an end of the photodetector 140.” *See* Ex. 1004 at ¶ 29. Petitioner admits Kim explicitly fails to disclose the “bonding wire” limitation as also required by claim 1. *See, e.g.,* Petition at pp. 25-26 (“wire bonding of components on a circuit board has been a routine and standard practice in the electronics and optoelectronics industries long before the effective filing date of the ’301 patent. It would thus have been obvious to a POSITA based on Kim’s disclosure that photodetectors (optoelectronic diodes) 140 and pre-amplifier (light receiving chip) 150 of Kim are electrically interconnected through wire-bonding.”).

Kim also fails to disclose the “optical fiber connector disposed on an end of the carrier” limitation. Instead, Kim discloses the optical connector [110] is disposed above the what Petitioner identifies as the carrier [180/280], and is connected to the AWG [120]. Thus, Kim does not disclose optical fiber connector [110] disposed *on an end of the carrier* [180/280], as required in the claims of the ’301 Patent. This is shown in Petitioner’s annotated Figure 3 from Kim:



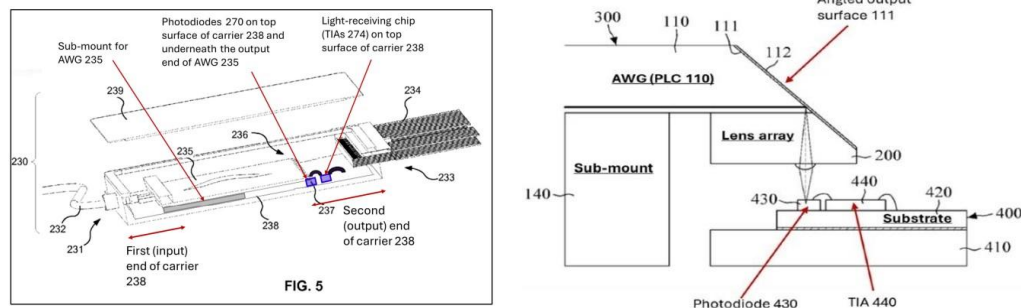
And, Petitioner again admits Kim does not directly disclose the “optical fiber connector disposed on an end of the carrier” limitation. Instead, Petitioner argues a POSITA would inherently understand the limitation only required an optical contacted disposed at an end region of the carrier. See Petition at p. 27 (“As shown in Figure 3 [of Kim] optical connector 110 is coupled to the input end of AWG demultiplexer 120, with optical connector 110 being disposed at the first (input) end of carrier 180/280. A POSITA would have understood that the claim element ‘an optical fiber connector disposed in an end of the carrier’ does not mean that the connector is coupled directly to the end of the carrier; rather, it means that the connector is disposed at an end region of the carrier.”).

disclosure that pre-amplifier 150...would have been positioned towards an end region of carrier 180/280.”); Petition at p. 31 (“It would have been obvious to a POSITA, based on Kim’s disclosures of AWG demultiplexing and four photodetectors corresponding to the 4-channel input optical signal, that AWG 120 demultiplexes the 4-channel input optical signal into individual channels in parallel based on their wavelengths. Indeed, a POSITA would have known that an AWG demultiplexer, like the one disclosed in Kim, necessarily divides (demultiplexes) the received multiplexed input signal into corresponding channels in parallel.”)

2. Ground 2 – Ho in view of Lee

The Ho-Lee Combination also fails to disclose the “an arrayed waveguide grating further disposed on a top surface of the carrier that defines a midpoint of the carrier” limitation. First, PLC 110 in Lee is not clearly directed to a AWG chip, and PLC 110 is actually a fiber array instead of an AWG structure. *See* Ex. 1006 at ¶ 34 (“an optical fiber array using a planar lightwave circuit (PLC) in which an optical output is established in the form of multi-core process or a V-groove of a silicon optical bench (SiOB) is widely used in the ROSA module.”). Regardless, PLC 110 in Lee is not disposed on what Petitioner has identified as substrate [400], but instead on sub-mount [140] and lens array [200]. Similarly, in Ho, Petitioner also admits the AWG is not mounted on the top surface of the carrier. *See* Petition

at p. 62 (“It would have been obvious to a POSITA that because AWG 235 is mounted on a submount, which is then mounted on carrier 238, AWG 235 is indirectly disposed on the top surface of carrier 235.”). This is shown Petitioner’s annotated Figure 5 of Ho and Figure 2 of Lee:



The Ho-Lee Combination also fails to disclose the “an optical fiber connector disposed in an end of the carrier” limitation. Again, Petitioner improperly argues a POSITA would understand the limitation only required an optical contacted disposed at an end region of the carrier. See Petition at p. 60 (“A POSITA would have understood that the claim element ‘an optical fiber connector disposed in an end of the carrier’ does not mean that the connector is coupled directly to the end of the carrier; rather, it means that the connector is disposed at an end region of the carrier.”); see also Exhibit 2008.

Finally, there would have been no motivation to modify the output end of Ho’s AWG [235] in view of Lee to have an inclined surface cut at a 45-degree angle to vertically reflect the demultiplexed outputs 237 to the photosensitive

surfaces of photodiodes 270 when Ho already discloses an effective and efficient way to couple the AWG [235] to the vertical photodetectors [236]. *See* Ex. 1005 at ¶¶43-44.

F. Petitioner and the Defendant are the Same Party.

Here, the fact that Petitioner and the defendant in the Accelight Litigation are the same party weighs in favor of denial of institution. *See Apple Inc. v. Fintiv, Inc., supra*, pp. 13-14.

G. The Validity of the '301 Patent May Be Adjudicated by a District Court Before the PTAB's Decision is Due if IPR is Instituted.

The '301 Patent is one of eight patents-in-suit in the CIG Litigation between AOI and defendant CIG, filed on February 20, 2024. As noted above, five of the eight patents-in-suit in the CIG Litigation were the subject of IPRs filed by CIG, and four of those have been denied by the Director or the Board. Although the CIG Litigation is currently stayed, the District Court may well lift the stay and proceed to claim construction which was fully briefed when the stay went into effect.

Thus, the validity of the '301 Patent may be adjudicated in the CIG Litigation before the Board's decision in an IPR, if instituted, which would be due by about April 7, 2027.

H. There Are No Relevant Changes in the Law that Affect Patentability.

There have been no changes in the law or judicial precedent regarding patentability since the '301 Patent issued. Accordingly, this factor weighs in favor of denial of institution. *See* Memorandum, Exhibit 2001, p. 2.

I. The Accelight Litigation Must Go Forward Because Not All Asserted Patents Are Subject to IPRs.

The Director may consider all relevant circumstances in determining whether to discretionarily deny institution of IPR. *See* Exhibit 2001, p. 3; *Apple Inc. v. Fintiv, Inc.*, *supra*, p. 14. The Accelight Litigation involves six AOI patents, five of which are the subject of petitions for IPR filed by Petitioner, including the '301 Patent. These facts indicate that the Accelight Litigation will need to go forward regardless of the petitions for IPR. Therefore, it would be more efficient for the validity of the '301 Patent to be resolved in the Accelight Litigation, and the PTAB could conserve its resources by denying institution. *See, Next Caller Inc.*, *supra*, p. 14, fn. 13, with similar facts (informative). Therefore, this factor weighs in favor of denial.

J. Any Search Disclosure Declaration filed by Petitioner Does Not Favor Institution.

Any Search Disclosure Declaration ("SDD") filed by Petitioner pursuant to the Director's SDD Memo is at most a neutral, rather than favorable, factor with

respect to this Petition because Petitioner merely relies on U.S. patents and applications for its invalidity arguments. *See, e.g.*, Exhibits 1004-1007.

Specifically, the Director's SDD Memo states that "[t]he voluntary submission of an SDD will be considered as a non-exclusive, nondispositive favorable discretionary factor supporting institution, *particularly where the SDD reveals new or underutilized pathways relevant to Office search practice.*" *See* Ex. 2009 at p. 2 (emphasis added). Given that Petitioner relies on U.S. patents and applications in its Grounds for alleging invalidity, finding these alleged prior art references neither requires, nor reveals, "*new or underutilized pathways relevant to Office search practice.*" *Id.* To the extent that Petitioner may argue that other references located via their search were found using new or underutilized pathways, that would not relate to this Petition because Petitioner did not rely upon them here. Therefore, the filing of an SDD with respect to this Petition should not favor institution.

IV. CONCLUSION

For the reasons set forth above, the Director should exercise his discretion and deny institution of IPR on the '301 Patent.

Dated: December 4, 2025

/Jo Dale Carothers/

Jo Dale Carothers (Reg. No. 74,180)
Weintraub Tobin Law Corporation
400 Capitol Mall, 11th Floor
Sacramento, CA 95814
Email: jcarothers@weintraub.com

CERTIFICATE OF SERVICE

The undersigned hereby certifies service on the Petitioner, pursuant to 37 C.F.R. §42.6(e) and by agreement of counsel, by electronic (e-mail) delivery of a true copy of the foregoing **PATENT OWNER'S REQUEST TO DIRECTOR FOR DISCRETIONARY DENIAL OF PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT 10,379,301 (Pursuant to Acting Director's Memorandum of March 26, 2025 and Director's Memorandum of October 17, 2025)**, which was served on December 4, 2025 to the following Counsel for Petitioner via e-mail:

Arpita Bhattacharyya
Perkins Coie LLP
3150 Porter Drive
Palo Alto, CA 94304
Bhattacharyya-ptab@perkinscoie.com

Robert F. McCauley
Perkins Coie LLP
3150 Porter Drive
Palo Alto, CA 94304
rmccauley@perkinscoie.com

Aaron E. Schindler
Perkins Coie LLP
33 East Main Street, Suite 201
Madison, WI 53703
aschindler@perkinscoie.com

/Eric Caligiuri/
Eric Caligiuri (Reg. No. 58,121)
Weintraub Tobin Law Corporation
400 Capitol Mall, 11th Floor
Sacramento, CA 95814
Phone: 858.436.3140
Fax: 916.446.1611
Email: ecaligiuri@weintraub.com