

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Stanley Black & Decker, Inc.,
Petitioner,

v.

Howmet Aerospace Inc,
Patent Owner.

Case IPR2025-01581
Patent No. 11,885,358

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL
OF INSTITUTION**

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LIST OF EXHIBITS

Exhibit	Description
2001	International Patent Application Publication No. WO2004/102016 (“PCT-Kleinman”)
2002	Redline comparison of specification of PCT-Kleinman to specification of Ex-1006, US2006/0251490 (US-Kleinman)
2003	International Patent Application Publication No. WO2015/033330 (“PCT-Brewer”)
2004	Redline comparison of specification of PCT-Brewer to specification of Ex-1004, US2016/0215808 (US-Brewer)
2005	Complete file history for U.S. Patent No. of 11,885,358
2006	Docket Navigator Search Results for Decisions on Motions to Stay by Judge Hall
2007	<i>Howmet Aerospace Inc., v. Stanley Engineered Fastening, et al.</i> , Case No. 1-25-cv-01335 (D. Del.), Dkt. No. 1, Plaintiff’s Complaint.

I. INTRODUCTION

The Director should exercise his discretion and deny institution as the validity of U.S. Patent No. 11,885,358 (“’358 patent”) is more appropriately adjudicated before the District Court for several reasons.

First, the Petition asserts that four different claim terms are indefinite, and Petitioner admits this forum **cannot** resolve indefiniteness. It is a waste of the Board’s and the parties’ resources to attempt to address obviousness with four claim terms allegedly being indefinite—it is more efficient for the District Court to simultaneously address the alleged indefiniteness and validity of the ’358 patent. For this reason alone, the Director should discretionarily deny the Petition.

Second, the Petition recycles the prior art. Petitioner presents four grounds of invalidity, with Grounds A-B applying Corbett as the primary reference, and with Grounds C-D applying Kleinman as the primary reference. All grounds (A-D) apply Brewer as a secondary reference. Yet, both Kleinman and Brewer were already before the Office, a fact Petitioner hides by using different patent numbers. Further, Corbett is duplicative of Kleinman. That is, all of Petitioner’s grounds apply art that was already considered, or duplicates what was already considered, by the Office.

Third, the *Fintiv* factors favor Patent Owner. The District Court is a more efficient forum to resolve validity in view of the alleged four allegedly indefinite claim terms. Further, the Petition is non-meritorious given it fails to be properly

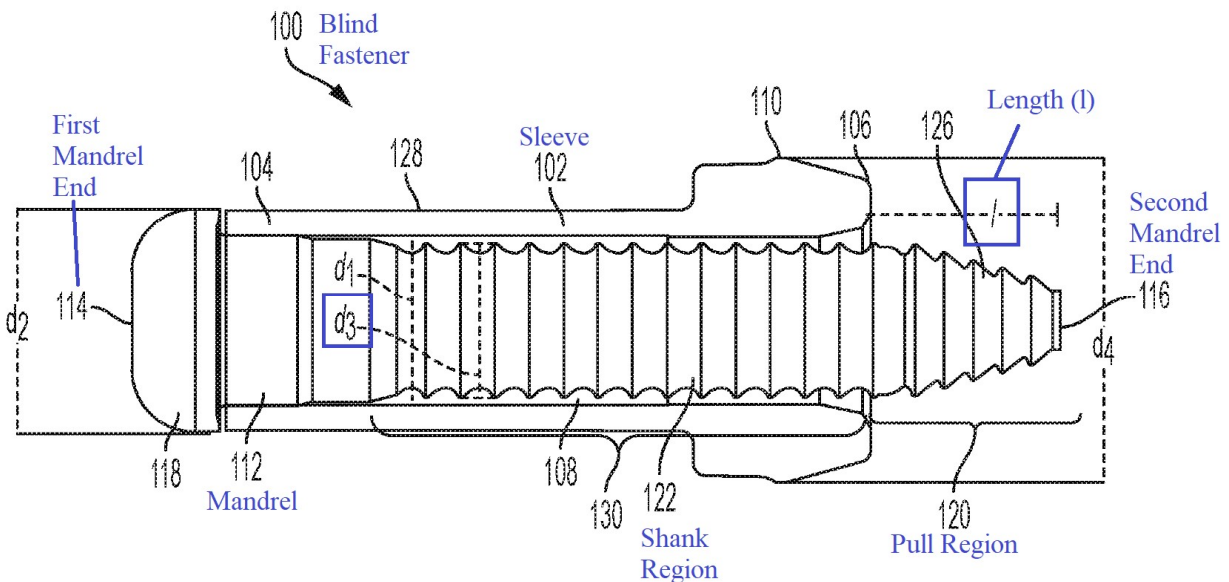
supported by expert testimony on the alleged indefinite claim terms, the Office already found the claims valid over the Kleinman and Brewer references, and the Corbett teachings are duplicative of Kleinmann.

Accordingly, discretionary denial is warranted and appropriate.

II. BACKGROUND

A. The '358 Patent

The '358 patent describes and claims a blind fastener having a mandrel and sleeve. As illustrated in FIG. 1 (below), the blind fastener 100 includes a sleeve 102 and a mandrel 112 having a first mandrel end 114 and a second mandrel end 116. (Ex-1001 at 3:58-4:16.) The second mandrel end 116 can comprise a pull region 120 configured to be engaged by an installation tool, and the pull region 120 can comprise an axial length, l , that is no greater than 4 times a diameter, d_3 , of the shank region 122. (*Id.* at 4:27-39.)



(*Id.* at FIG. 1 (annotations added).) The design of the blind fastener enables the “use of a smaller installation tool for installation since the force required to install the blind fastener may be less than a force that can fracture the mandrel” while also allowing “the sleeve wall thickness [to] be reduced by, for example, 10% or 15%, which can save material cost.” (*Id.* at 7:28-37.)

B. Parallel District Court Litigation

On October 31, 2025, Howmet filed a complaint alleging direct and indirect infringement of the ‘358 patent by Stanley Engineered Fastening LLC, Avdel UK LTD, and Avdel Holding Limited and requested a permanent injunction against the defendants. *Howmet Aerospace Inc., v. Stanley Engineered Fastening, et al.*, Case No. 1-25-cv-01335 (D. Del.) (hereinafter “*Delaware Case*”), Dkt. No. 1, Complaint. (Ex-2007 at 1.) The *Delaware Case* is pending before Judge Jennifer Hall in the District Court for District of Delaware.

III. DENIAL IS APPROPRIATE AS PETITIONER INTENDS TO PURSUE ADDITIONAL INVALIDITY DEFENSES AND DIFFERENT CLAIM CONSTRUCTIONS IN DISTRICT COURT

A. Petitioner’s Four Indefiniteness Arguments Show That the District Court Is Better Suited To Resolve The Parties’ Disputes

The Petition argues four different terms of the ’358 patent are indefinite. (Pet. at 11-16, 26-29, 37.) Petitioner’s first indefiniteness argument is that the term “*pull region*” is indefinite:

“As shown below, this limitation [*pull region*] **is indefinite** as to whether ‘*pull region*’ means ... [three possible meanings].”

(*Id.* at 11 (emphasis added).)

Petitioner’s second indefiniteness argument is that the term “*pull region comprising an axial length*” is indefinite:

“This limitation **is also indefinite** as to whether the ‘pull region comprising an axial length’ encompasses an axial length of a portion of the pull region or of the entire pull region. Ex. 1013, pp. 3, 5.”

(*Id.* at 12 (emphasis added).)

Petitioner’s third indefiniteness argument is that the term “*diameter*” is indefinite:

“‘[A] diameter’ is indefinite as to whether it means maximum diameter (at ref. 112), an intermediate diameter (e.g., d1), a ‘major diameter’ d3 of the grooved portion, or a ‘root diameter’ of the grooved portion.’ 358 Patent, FIG. 1, 4:31- 39. Petitioner endeavors to apply this indefinite limitation despite its indefiniteness.”

(*Id.* at 26.)

Petitioner’s fourth indefiniteness argument is that the term “*generally cylindrical*” is indefinite:

“The term ‘generally [cylindrical]’ (both instances) in claim 10 is indefinite, so Petitioner interprets this limitation as best Petitioner can.”

(*Id.* at 37 (emphasis added).) Yet, as the Petition concedes, “Petitioner ***cannot*** pursue indefiniteness here.” (Pet. at 12 (emphasis added).) It is a waste of the

Board's and parties' resources to attempt to resolve obviousness with four different claim terms allegedly being indefinite—the parties' dispute is far better suited for the District Court where all of Petitioner's indefiniteness arguments will be resolved. Indeed, the existence of broader invalidity contentions in District Court weigh heavily in favor of discretionary denial. *See, e.g., Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB Mar. 28, 2025) (vacating institution decision despite *Sotera* stipulation because “Petitioner’s invalidity arguments in the district court are more expansive and include combinations of prior art asserted in these proceedings with unpublished system prior art”); *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-000354, Paper 11 at 2-3 (PTAB Jun. 12, 2025) (denying institution despite *Sotera* stipulation based on petitioner’s broad invalidity contentions in district court).

In addition to indefiniteness, Petitioner is not precluded from seeking other invalidity defenses in the *Delaware* Case. The Federal Circuit recently held that “IPR estoppel does not preclude a petitioner from relying on the same patents and printed publications as evidence in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use.” *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1366 (Fed. Cir. 2025). Given its indefiniteness positions, it is almost certain Petitioner will assert additional invalidity contentions in the *Delaware* Case that cannot be resolved here.

It is much more efficient for the *Delaware* Case to resolve all invalidity issues as opposed to the piecemeal approach that would occur at the PTAB.

B. Petitioner’s Different Claim Constructions Positions and Reservation Of Rights Proves The District Court Is The Proper Forum

In arguing indefiniteness, Petitioner argues three different constructions of “*pull region comprising an axial length*,” including arguing that “the ‘axial length’ means the entire axial length of the pull region, and the ‘pull region’ means the entire ‘region configured to be engaged by an installation tool.’” (Pet. at 11-12.) Petitioner proposes no constructions for the allegedly indefinite terms “*diameter*” or “*generally cylindrical*.” (*Id.* at 26-29, 37.) Petitioner further states:

“Petitioner reserves its indefiniteness defenses and interprets the challenged claims as best it can in Grounds A-D despite their indefiniteness.”

(Pet. at 16 (emphasis added).) Accordingly, Petitioner seemingly intends to pursue multiple different claim constructions in the *Delaware* Case. Yet, the recent precedential decision in *Revvo Technologies v. Cerebrum Sensor Technologies, Inc.*, provides that petitioners should not pursue “different claim constructions in the two forums.” IPR2025-00632, Paper 20, 4 (“*Revvo*”).

In *Revvo*, the Director stated that the “Board’s claim construction rules are designed to ensure that the Board correctly construes claims terms and to minimize inconsistency in claim construction between forums.” (*Id.* at 4.) The Director

further stated that “the rules discourage petitioners from seeking broader constructions at the Board to support a patentability challenge while seeking narrower constructions in litigation to avoid infringement liability.” (*Id.* at 5.)

Petitioner’s duality on indefiniteness and claim constriction is exactly the thing *Revvo* seeks to remove from the PTAB. As Petitioner’s four different indefiniteness positions and reservations of rights show, Petitioner intends to pursue different claim construction and invalidity positions in the *Delaware* Case. Petitioner’s attempt to pursue inconsistent claim construction positions should be denied, and the whole of the parties dispute should be resolved before the District Court.

C. Petitioner’s Mere Attorney Argument and Parroted Expert Positions On Indefiniteness Favor Discretionary Denial

In arguing the claims are indefinite, Petitioner cites its expert declaration as supposedly supporting its allegations. (Pet. at 15, citing Ex. 1002, ¶¶80-88.) Yet, Petitioner’s expert testified that she merely adopted Petitioner’s counsel’s positions on indefiniteness and claim construction of the allegedly indefinite terms “*pull region*” and “*axial length*”:

“I have been informed that *Petitioner asserts* that this limitation is indefinite because it is not clear whether ‘pull region’ means [*listing of potential meanings*]. *Petitioner asserts* that this limitation is *also unclear* as to whether the ‘pull region comprising an axial length’

encompasses an axial length of a portion of the pull region or of the entire pull region. ... I have been informed that because Petitioner cannot pursue indefiniteness here, ***Petitioner has conservatively proposed*** [a narrow construction]. Several facts support this construction over a ‘standout’ construction.”

(Ex-1002 at ¶81.) Petitioner’s expert also simply adopts counsel’s indefiniteness positions on the terms “*diameter*” and *generally cylindrical*” without analysis as to whether such positions are correct from the viewpoint of a POSITA:

“118. I have been informed that ***Petitioner asserts that this limitation is indefinite*** because it is unclear whether the term diameter refers to....”

“149. I have been informed that ***Petitioner asserts that this limitation is indefinite*** as to the scope of the term “generally” (both instances).”

(Ex-1002 at ¶¶118, 149.) As the language “*Petitioner asserts*” and “*Petitioner has conservatively proposed*” shows, Petitioner’s expert ***did not*** undertake an independent analysis of the allegedly indefinite terms. Instead, she merely adopted Petitioner’s counsel’s opinion, which is improper. *Phillips. Endress + Hauser, Inc. v. Hawk Measurement Sys. Pty. Ltd.*, 122 F.3d 1040, 1042 (Fed. Cir. 1997) (“Indeed, this court has on numerous occasions noted the impropriety of patent lawyers testifying as expert witnesses and giving their opinion regarding the proper interpretation of a claim as a matter of law, the ultimate issue for the court to decide.”). Petitioner should not be rewarded for presenting indefiniteness arguments,

incapable of being resolved here, and without its expert taking a position thereon. Further, the Federal Circuit has held Petitions should not be based on mere attorney argument and parroted expert testimony. *Bell Semiconductor LLC v. NXP B.V.*, 2024 WL 4984053 at *3 (Fed. Cir. 2024) (unpub.) (“Board accurately characterized NXP’s expert testimony as conclusory and correctly pointed out that the only evidence in NXP’s petition was a citation of their expert’s declaration that parrots the language of the petition.”); *Garmin International, Inc. v. LoganTree, LP*, 825 Fed.Appx. 894, 898 n.5 (Fed. Cir. 2020) (unpub.) (“The Board, however, correctly found that Garmin’s expert merely parroted attorney argument without any supporting evidence or reasoning.”).

IV. THE DIRECTOR SHOULD EXERCISE HIS DISCRETION AND DENY INSTITUTION UNDER 35 U.S.C. § 325(d)

The Director should discretionarily deny the Petition under 35 U.S.C. § 325(d) in view of *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”) and the recent precedential decision of *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 (May 19, 2025) (precedential) (designated: May 19, 2025) (“*Ecto*”). The Petition presents four grounds of invalidity, all of which apply art already considered by the Office, or art that is cumulative to the art that was already before the Office. Accordingly, discretionary denial is warranted.

A. Part One of *Advanced Bionics* Is Satisfied

The first part of the *Advanced Bionics* framework involves evaluating “whether the same or substantially the same prior art or argument previously was presented to the Office.” *Ecto* at 3. All of Petitioner’s grounds are based on such art or arguments.

1. Kleinman and Brewer were already before the Office

Petitioner presents four grounds of invalidity, with Grounds A-B applying Corbett as the primary reference, and with Grounds C-D applying Kleinman as the primary reference. (Pet. at 15-16.) All grounds (A-D) apply Brewer as a secondary reference. (*Id.*) Yet, both Kleinman and Brewer were already before the Office, a fact Petitioner hides by using different patent numbers and purposefully excluding the complete file history of the ’358 patent from its filing.¹

Petitioner’s Kleinman is US2006/0251490A1 (“US-Kleinman”). (Pet. at 1.) The face of the ’358 patent cites the PCT version of Kleinman, WO2004/102016 (“PCT-Kleinman”). (Ex-1001 at 2.) PCT-Kleinman was cited in an IDS initialed by the Examiner. (Ex-2005 at 60.) There are no material differences between US-

¹ Patent Owner includes the complete file history for the ’358 patent with this submission. (*See* Ex-2005).

Kleinman and PCT-Kleinman; US-Kleinman claims priority to PCT-Kleinman and the GB priority applications recited by PCT-Kleinman:

US-Kleinman	PCT-Kleinman
(21) Appl. No.: 10/545,908	(21) International Application Number: PCT/GB2004/002042
(22) PCT Filed: May 11, 2004	(22) International Filing Date: 11 May 2004 (11.05.2004)
(86) PCT No.: PCT/GB04/02042	(25) Filing Language: English
(30) Foreign Application Priority Data	(26) Publication Language: English
May 14, 2003 (GB) 0311053.3	(30) Priority Data:
May 19, 2003 (GB) 0311368.5	0311053.3 14 May 2003 (14.05.2003) GB
(Ex-1006 at 1.)	0311368.5 19 May 2003 (19.05.2003) GB
	(Ex-2001 at 1.)

Further, the two patent specifications are essentially identical. (Ex-2002 (redline comparison of the specifications of US-Kleinman and PCT-Kleinman).) Thus, Kleinman was already before the Office.

Brewer is no different. Petitioner's Brewer is US2016/00215808 ("US-Brewer"). (Pet. at 1.) The face of the '358 patent cites the PCT version of Brewer, WO2015/033330 ("PCT-Brewer"). (Ex. 1001 at 2.) PCT-Brewer was cited in an IDS initialed by the Examiner. (Ex-2005 at 56.) There are no material differences between US-Brewer and PCT-Brewer; US-Brewer claims priority to PCT-Brewer and the GB priority application recited by PCT-Brewer:

US-Brewer	PCT-Brewer
(21) Appl. No.: 14/914,908	(21) International Application Number: PCT/IB2014/065857
(22) PCT Filed: Nov. 11, 2014	(22) International Filing Date: 6 November 2014 (06.11.2014)
(86) PCT No.: PCT/IB2014/065857	(25) Filing Language: English
§ 371 (c)(1), (2) Date: Feb. 26, 2016	(26) Publication Language: English
(30) Foreign Application Priority Data	(30) Priority Data:
Sep. 9, 2013 (GB) 1315989.2	1315989.2 9 September 2013 (09.09.2013) GB
(Ex-1004 at 1.)	(Ex-2003 at 1.)

Further, the disclosures of the two patent specifications are essentially identical. (Ex-2004 (redline comparison of the specifications of US-Brewer and PCT-Brewer).)

Thus, Brewer was also already before the Office.

2. The first part of the *Advanced Bionics* framework is satisfied for Grounds C-D

As shown in the prior section, both Kleinman and Brewer were already before the Office. Yet, Petitioner’s Ground C asserts all claims are obvious based on the combination of Kleinman and Brewer. (Pet. at 15 (“(C) Claims 1-20 were obvious over Kleinman and Brewer”).) Thus, it is indisputable that the art applied for Ground C is “the same prior art that was previously presented on an IDS” which “is sufficient to satisfy the first part of the *Advanced Bionics* framework.” *Ecto* at 4. Ground D does not save Petitioner as it only challenges claims dependent claims, 6-7, 11 and 20. (Pet. at 16.). Accordingly, the first part of the *Advanced Bionics* framework is satisfied for Grounds C-D.

3. Grounds A-B are duplicative of Grounds C-D

Petitioner's Grounds A and C are essentially identical except Corbett is cited in Ground A whereas Kleinman is cited in Ground C. (Pet. at 15-16 (claims 1-20 challenged in Grounds A and C based on Corbett+Brewer or Kleinman+Brewer, respectively.) Thus, by simple logic, Corbet and Kleinman must present generally similar teachings. The Petition confirms as much.

Specifically, Petitioner repeatedly argues Corbett and Kleinmann are interchangeable. The below excerpts are representative:

“Ground A: Claims 1-20 Were Obvious Over Corbett In View Of Brewer

Brewer taught that a ‘problem’ with conventional swage fasteners with multiple, “relatively small pull grooves” like in Corbett (or Kleinman) ‘is that ...’

“POSITAs would understand from Brewer that such shortcomings of swage fasteners like Corbett’s (or Kleinman’s)...”

“POSITAs would be motivated to so modify Corbett (or Kleinman) to obtain any of the benefits Brewer attributes to its single groove pull region...”

(Pet. at 16, 18 (emphasis added); *see also id.* at 19-23.) Thus, Petitioner concedes that Corbett and Kleinmann are duplicative of one another, i.e., Petitioner concedes that there are no material differences between Grounds A and C. Grounds B and D identically apply Kendall and Fulbright as tertiary references to dependent claims

(*id.* at 15-16), i.e., Grounds B and D do not save the duplicity of Grounds A and C. Accordingly, the first part of the *Advanced Bionics* framework is also satisfied for Grounds A-B.

B. The Second Part of Advanced Bionics Shows Discretionary Denial Is Warranted

As *Ecto* explains:

“[A] petitioner must provide an analysis [under *Advanced Bionics*, part two] even when the asserted prior art is on an IDS, but the Examiner did not apply the reference. In that analysis, a petitioner must explain, with reference to *Becton Dickinson* factors (c), (e), and (f), how the Examiner erred in overlooking the prior art.

[I]f the Examiner applied the asserted prior art or substantially the same prior art during examination, then a petitioner must demonstrate that, for example, the previously presented art teaches the limitations of the challenged claims, and that no reasonable examiner could have found otherwise.”

Ecto at 5-6 (emphasis added).

Petitioner’s case fails under *Ecto*. Petitioner presents no analysis or explanation with respect to Corbett, Kleinman and Brewer as to the relevant *Becton Dickinson* factors, including “(c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis,” “(e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of

the asserted prior art,” and “(f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments for rejection.” *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017). Instead, Petitioner purposefully hides the fact that Kleinman and Brewer were already considered by the Office—behavior that should not be rewarded. Petitioner also purposefully excludes the complete file history of the ’358 patent from its IPR filing; the complete file history shows the Examiner considered and initialed IDSs disclosing Kleinman and Brewer. (Ex-2005 at 56, 60.)

For the above reasons, both prongs of *Advanced Bionics* are satisfied for all grounds and the Board should discretionarily deny the Petition on § 325(d) grounds.

V. THE *FINTIV* FACTORS FAVOR DISCRETIONARY DENIAL

Fintiv sets forth six factors to assess in determining whether to deny institution based on one or more parallel proceedings:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and

6. other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). “[I]n evaluating the factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* at 6. The majority of these factors favor denying institution in view of the *Delaware* Case.

A. Factor 1 is Neutral or Weighs Against Institution

The first *Fintiv* factor is neutral or weighs against institution because the District Court has not granted a stay, nor is there evidence that one may be granted. *Fintiv* at 7-8. According to DocketNavigator, Judge Hall, who is presiding over the *Delaware* Case, has denied pre-institution stays in prior cases. (Ex-2006 at 1-7.) Specifically, Judge Hall has denied over 40% of the stay requests made in view of a parallel IPR proceeding. (*Id.*) Accordingly, this factor is neutral or weighs against institution.

B. Factor 2 Is Neutral as the Trial Date is Unknown

Fintiv Factor 2 looks to the proximity of the court's trial date to the Board's projected statutory deadline for a final written decision. *Fintiv* at 7. According to Docket Navigator, the median time-to-trial in the District Court of Delaware is 28 months. Thus, if the *Delaware* Case proceeds according to the median statistics, the

trial for the *Delaware* Case would be in March of 2028. Although the Final Written Decision in the instant IPR would be due April 28, 2027, a trial date has not yet been set in the *Delaware* Case by Judge Hall and, therefore, a projected date for trial is unknown. According, Factor 2 is neutral.

C. Factor 3 Weighs Against Institution

The third factor concerns “the amount and type of work already completed in the parallel litigation by the court and the parties and the time of the institution decision.” *Fintiv* at 9. By the time the Board decides whether to institute an IPR in April 2026, significant investment is likely to have been made by the parties in the *Delaware* Case as the parties will likely have exchanged infringement contentions and invalidity contentions and begun fact discovery. Accordingly, the *Delaware* Case is likely to be in an advanced stage by the time the Board issues an institution decision. Accordingly, the third factor weighs in favor of discretionary denial.

D. Factor 4 Weighs Against Institution as Overlap Between the Proceedings Is Highly Likely

Fintiv factor 4 considers the “overlap between issues raised in the petition and in the parallel proceeding.” *Fintiv* at 12. On December 12, 2025, Petitioner entered a stipulation in this IPR stating that it will not pursue 102 or 103 prior art invalidity grounds raised in this IPR in a parallel proceeding, including system art corresponding to the invalidity grounds raised in this IPR. (Paper 8 at 2.) However,

Petitioner will still rely on other unpatentability theories in the *Delaware* Case as its indefiniteness arguments in the Petition show. (Pet. at 11-16, 26-29, 37.) Thus, the invalidity issues to be litigated in the *Delaware* Case are more expansive than the grounds in the Petition. *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB Mar. 28, 2025) (denying institution despite Sotera stipulation because “Petitioner’s invalidity arguments in the district court are more expansive” than the petition). Accordingly, factor 4 weighs in favor of a discretionary denial.

E. Factor 5 Weighs Against Institution as the Parties are the Same

Fintiv factor 5 considers whether the petitioner and the defendant in the parallel proceeding are the same party. *Fintiv* at 13. The Defendants in the *Delaware* Case are Stanley Engineered Fastening LLC, Avdel UK LTD, and Avdel Holding Limited. (Ex-2007 at 1.) Each of these parties is identified as a real party-in-interest by Petitioner in the Petition. (Pet. at 78-79.) Accordingly, factor 5 weighs in favor of a discretionary denial.

F. Factor 6 Weighs Against Institution as the Board Cannot Address Petitioner’s Indefiniteness Assertions, and Petitioner’s Prior Art Was Already Considered

Fintiv factor 6 concerns other circumstances that impact the Board’s exercise of discretion, including the merits. *Fintiv* at 14. Here, Petitioner argues four different claim terms are indefinite and agrees that the Office cannot address indefiniteness. (Pet. at 11-16, 26-29, 37.) Further, Petitioner’s expert merely adopts

and parrots Petitioner's attorney argument that the claims are indefinite. (Ex-1002 at ¶¶81, 118, 149.) As previously noted, the Board disfavors Petitions based on mere attorney argument and parroted expert testimony. Petitioner also purposefully hides the fact that the Kleinman and Brewer references were already considered by the Office. Petitioner's Corbett-based grounds are also duplicative of the Klienman based grounds.

Petitioner also includes a "conditional ground" of invalidity:

"Petitioner conditionally adds Denham and Jeal to [sic] supplemental invalidity ground C1 asserting that claim 5 was obvious over Kleinman in view of Brewer, Denham, and Jeal if the Board prefers that they be formally cited in an invalidity ground."

(Petition at 62, N.4.) Petitioner's "conditional ground" is not allowed, places overreliance on expert testimony, and shows the Petition is weak.

For the forgoing reasons, factor 6 heavily weighs in favor of a discretionary denial.

G. *Fintiv* Conclusion

As shown above, the totality of the *Fintiv* factors weigh in favor of discretionary denial, and Patent Owner respectfully requests the Director exercise his discretion under 35 U.S.C. § 314 to deny the Petition.

VI. CONCLUSION

For the above reasons, Patent Owner respectfully requests that the Board discretionarily deny the Petition and decline to institute a trial in this IPR.

Respectfully submitted,
GREENBERG TRAURIG, LLP

Date: December 29, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** was served on the following counsel via electronic mail:

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