IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO., LTD., and

SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioners,

v.

MASSIVELY BROADBAND LLC.,

Patent Owner.

_____

Case No. IPR2025-01594

U.S. Patent No. 10,224,999

_____

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

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1006	Intentionally Omitted
1007	U.S. Patent 7,209,523 ("Larrick")
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1010	U.S. Patent Application Pub. No. 2003/0002456 ("Soomro")
1011	U.S. Provisional Application No. 60/498,324
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1013	U.S. Patent Application Pub. No. 2005/0233709 ("Gardner")
1014	Patent Owner Preliminary Infringement Contentions, Ex. 7 (September 16, 2025)
1015	Curriculum Vitae of Mark Mahon Ph.D.
1016-1049	Intentionally Omitted
1050	"NYU Wireless' Rappaport envisions a 5G, millimeter-wave future," available at https://www.fierce-network.com/special-report/nyu-wireless-rappaport-envisions-a-5g-millimeter-wave-future
1051	U.S. District Court Time-to-Trial Statistics for EDTX (Sept. 2025)

I. INTRODUCTION

The Director should deny Patent Owner's request for discretionary denial in this proceeding (Paper 9) ("Request") as well as the eleven other IPR proceedings against patents asserted by Patent Owner (the "Challenged Patents"). Each of the relevant factors weigh against denial. *First*, the *Fintiv* factors heavily weigh against denial because trial is scheduled to occur after the projected dates of all twelve of the Final Written Decisions.

Second, Patent Owner lacks settled expectations because the '999 patent was recently issued in 2019—and given the significant overlap between the IPR petitions against this family, it would be an efficient use of Board resources to consider the merits of all of them. In addition, Patent Owner also lacks settled expectations because despite its contentions that the sole inventor on all twelve Challenged Patents, Dr. Rappaport, had collaborated with Petitioners for multiple decades and had made significant contributions to the industry, Dr. Rappaport ***never*** indicated to Petitioners of any potential infringement of his patents and ***never*** told any industry standards groups that his patents were related to the accused Wi-Fi, 4G-LTE and 5G standards.

Third, Patent Owner has asserted, and Petitioners have challenged, twelve patents belonging to three unrelated families that cover four different technologies. Given the wide scope of the subject matter of the Challenged Patents, the Board is

better positioned to adjudicate the validity of these patents.

Finally, institution is appropriate to cure the material errors committed by the examiner during prosecution of the '999 patent. Specifically, the examiner allowed the claims over the considered art because they lacked disclosure of traffic filtering. Yet the '999 patent itself acknowledges that repeaters with traffic filtering were known in the art. The examiner therefore overlooked a broad swath of prior art that covers such well-known functionality—including the Petition's Ganz reference that was not presented to the examiner.

II. THERE ARE NO SETTLED EXPECTATIONS IN THE VALIDITY OF THE '999 PATENT

A. Patent Owner Lacks Settled Expectations

Patent Owner has asserted the '999 patent and the following related patents: U.S. Pat. Nos. 10,797,783 ("'783 patent"), 9,667,337 ("'337 patent"), 8,923,754 ("'754 patent"), and 7,676,194 ("'194 patent"). These patents belong to what Patent Owner calls the "Intelligent Wireless Broadband Relay patent family." Request at 6.

Patent Owner lacks settled expectations because the '999 patent was recently issued on March 5, 2019. In addition, the '783 patent was issued on October 6, 2020. Because these two patents have not been in force for much time, Patent Owner lacks settled expectations. *Cambridge Industries USA, Inc. v. Applied Optoelectronics,*

Inc., IPR2025-00433, Paper 11 at 2 (June 27, 2025) ("[M]ost of the challenged patents have not been in force for a significant period of time (issued in 2020, 2019, and 2019), and, accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial….").

As for the other three patents, although they were issued earlier, they claim subject matter that is similar to the '783 and '999 patents. As a result, there is significant overlap between the IPR petitions against this family of patents. It would therefore be an efficient use of Board resources to decide the merits of all five petitions, which further weighs against discretionary denial. *Embody, Inc. v. LifeNet Health*, IPR2025-00248, Paper 13 at 3 (Director June 26, 2025) ("Patent Owner has not developed strong settled expectations that favor discretionary denial as to the first patent, and it is an efficient use of Board resources to address the related patent.").

In particular, each of the IPR petitions, including the petition against the '999 patent, asserts a combination of Ganz and Larrick as rendering obvious at least the independent claims of the Challenged Patents. This is because, as explained in fuller detail below, the Challenged Patents claim well-known repeater functionality that receives transmissions on 100 MHz of bandwidth and/or a data rate of 100 mbps, which the '999 patent describes as "ultrawideband." As described in each of the IPR petitions, Ganz discloses said repeater functionality, whereas Larrick discloses a

transceiver operating with ultrawideband bandwidth and data rates—indeed, Larrick is titled "***Ultra-wideband*** Receiver and Transmitter." Thus, the consistent use of these core references makes analysis of one petition highly informative of the others.

Additionally, the '999 patent expired in August 2024, prior to Patent Owner filing its Complaint asserting it in June 2025. This fact weighs against discretionary denial as well. *Apple Inc. v. Ferid Allani*, IPR2025-00856, -00857, Paper 10 at 3 (Director Sept. 4, 2025) (finding discretionary denial "not appropriate" where "Patent Owner did not assert the challenged patents against Petitioner until after they expired.").

B. Patent Owner's First-Time Assertion and Lack of Commercialization Undercut Any Claim of Settled Expectations

As far as Petitioners are aware, Patent Owner has never "commercialized, asserted, marked, licensed, or otherwise applied in … petitioner's particular technology space" any of the twelve Challenged Patents, except through the lawsuit that it filed against Petitioners. *Shenzen Tuozhu Technology Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 (Director July 17, 2025). Nor does Patent Owner contend it has ever sent a demand letter to anyone—certainly, Patent Owner did not tell Petitioner prior to the filing of this lawsuit in 2025 that it required a license to the Challenged Patents.

Yet as Patent Owner contends, the sole inventor on all twelve patents,

Professor Theodore Rappaport, has "[f]or nearly three decades" "collaborated with [Petitioners] closely." Request at 2. During this multi-decade collaboration, Prof. Rappaport encouraged Samsung to invest in his research, granting Samsung full access to that research in return. Samsung (along with the industry writ large) made significant, well-publicized investments in the accused technology and prominently participated in the relevant standard-setting efforts. *See* Ex. 1050. But in all that time, despite the parties' close collaboration on development of the relevant standards, not once did Prof. Rappaport ever raise the possibility or suggestion that Petitioners' products infringed any of the Challenged Patents.

As Patent Owner acknowledges, Prof. Rappaport's work was widely published in technical papers and textbooks, including publications cited by Petitioners. Nor is it the case that an inventor's academic publication of his work means, as Patent Owner suggests, that the industry has acquiesced to his work and that Samsung should somehow be precluded from challenging Prof. Rappaport's patents now. Such an argument would chill industry-academic collaboration, forcing companies to shun participation in and contribution to academic research to avoid future preclusion arguments. Thus, as a result of Prof. Rappaport sitting on his patent rights, Petitioners had settled expectations that Prof. Rappaport's published research was prior art that was available for use, that they did not infringe the Challenged Patents, and that Prof. Rappaport would not enforce the Challenged

Patents. *Ford Motor Company v. AutoConnect Holdings* LLC, IPR2025-01342, Paper 10 (Director Dec. 4, 2025) ("[A]fter a decade-long and continuous customer-supplier relationship, Petitioner had developed a well-settled expectation that it would not be accused of infringing the challenged patents."). Petitioner's expectation of non-enforcement was confirmed after the '999 patent expired in 2024. *Google LLC v. Sandpiper CDN LLC*, IPR2025-00806, Paper 13 (Director Sept. 12, 2025) ("Petitioner, on the other hand, persuasively argues that the challenged patent … expired in 2023 … and, accordingly, it expected non-enforcement of the challenged patents.").

In addition, Patent Owner has asserted that the '999 patent and its related patents are infringed through Petitioner's use of the Wi-Fi 5/6/6E, 4G-LTE and 5G wireless standards. Exs. 1014. As Patent Owner has made abundantly clear, Prof. Rappaport had significant involvement in the development of the 5G mmWave standard and claims significant contributions "in wireless communications [that] are widely recognized in the industry." Request at 3-4. Frankly, Prof. Rappaport is a known expert in the field. Yet despite Prof. Rappaport's long involvement in the industry and despite the '999 patent claiming priority to an application filed over two decades ago, he has never claimed that the '999 patent or any patents in its family are essential or even related to any of the wireless standards he now accuses of infringement.

III. EFFICIENCY AND CONSISTENCY STRONGLY WEIGH AGAINST DISCRETIONARY DENIAL

Patent Owner has asserted, and Petitioner has challenged, twelve patents across three different families directed to vastly different subject matter and technologies. As a result, the Board is a much more suitable venue for reviewing the Challenged Patents. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 (Director June 13, 2025) ("The large number and vast scope of the patents asserted in the district court litigation (id. at 7) weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter.").

As discussed above, the '999 patent and four other asserted patents belong to what Patent Owner calls the "Intelligent Wireless Broadband Relay patent family" and claim repeater functionality operating on ultrawideband bandwidth and data rates. Request at 6-7. For this patent family, Patent Owner has accused devices that support Wi-Fi hotspot functionality or provide 5G cellular data connectivity. Exs. 1014.

Patent Owner has also asserted three patents in what it calls the "Network Monitoring patent family." Request at 6-7. These patents claim the collection and use of information, including location information, of wireless devices. For this patent family, Patent Owner has accused Samsung's Knox Suite, which is enterprise

software running on a server that can track the locations of Samsung devices within an enterprise.

Finally, Patent Owner has asserted four patents in what it calls the "Smart Antenna patent family." Request at 6-7. Two of these patents (the '763 and '358 patents) are directed to wireless devices equipped with a single, tunable, multi-band antenna capable of transmission and reception on two or more frequency bands simultaneously, and Patent Owner has accused Samsung smartphones and tablets containing certain Qorvo and/or Qualcomm modules that allegedly support active tuning across multiple frequency bands, or ICs that work in substantially the same way. The other two (the '625 and '548 patents) are directed to sensor-based beamsteering in wireless devices equipped with a steerable antenna configured to transmit/receive mmWave signals in the frequency range of 10-500 GHz, and Patent Owner has accused Samsung 5G smartphones containing certain Qualcomm antenna modules allegedly capable of beam tracking and beamforming to avoid obstructions.

Thus, the twelve challenged patents are directed to three different families and four different technologies: (1) wireless repeater functionality using ultrawideband bandwidth, (2) the collection and use of location information of devices, (3) tunable antenna-equipped wireless devices configured for multi-band operation, and (4) sensor-based beamsteering in wireless devices with steerable antennas operating at high-frequencies.

Patent Owner nevertheless argues that it would be inefficient for the Board to "evaluate all 340 challenged claims across the Asserted Patents," since Patent Owner claims it will "narrow the case to a small subset of those claims." Request at 2-3. To the contrary, evaluating all of the challenged claims at once is a far more efficient use of the Board's resources than resolving challenges to a small number of claims, which will inevitably lead to subsequent proceedings when Patent Owner asserts other claims in subsequent litigations, based on Patent Owner's vague assertion it will at some point narrow the case to a smaller number of claims. Further, denying institution based on the aggregate volume of petitions (which are entirely the result of Patent Owner's decision to assert a wide variety of patents in litigation) would merely incentivize patentees to flood the courts with complex litigation involving large numbers of patents. In addition, Patent Owner is currently asserting 131 claims in the parallel litigation, including nearly all independent claims of the twelve Challenged Patents. The claims that Patent Owner is not asserting are almost all short, dependent claims for which the Board will not need to expend much effort to adjudicate. In addition, the District Court involves significantly more prior art than those being raised in the IPR petitions, making it far more likely that the parties will expend less resources resolving the IPR petitions before the Board. Moreover, there is significant overlap between the IPR petitions for each family of patents. As already discussed above, the IPR petitions challenging the '999 patent and its related

patents all assert the combination of Ganz in view of Larrick. Thus, there are significant efficiencies in instituting the IPR petitions.

IV. THE EXAMINER ERRED IN ALLOWING THE '999 PATENT

The examiner erred in allowing the '999 patent by overlooking significant prior art, including applicant admitted prior art. As discussed above, the '999 patent claims wireless repeater functionality operating on ultrawideband bandwidth and data rates. In particular, the '999 patent claims receiving and transmitting a signal using bandwidth of 100 MHz or more or a data rate of 100 mbps or more and ignoring or filtering some of the received signal if from an undesirable source.

Yet the '999 patent admits that both repeater functionality and ultrawideband were well-known. Specifically, the '999 patent admits that repeaters are "well known in the art, and they have been manufactured for decades in the cellular and PCS industries, and more recently, … for the IEEE 802.11a/b marketplace [and] for IEEE 802.11g wireless LAN WiFi standard." Ex. 1001, 3:20-26. The '999 patent describes a prior art "Buffalo Technology … bridge and repeater product" that includes "MAC Address filtering." *Id.*, 3:26-42.

The '999 patent also admits that ultrawideband was well-known. The '999 patent describes that "[u]ltrawideband technologies are about to become mainstream, and are described in" various patent applications and publications. Ex. 1001, 2:14-21. The patent also describes that "[t]he IEEE 802.15.3 standards bodies

have been developing Physical (PHY) and MAC layer standards for dynamic channel selection and repeater service for UWB, which falls under the general IEEE 802.15.3 standards body." Ex. 1001, 2:21-25. In addition, the patent describes that UWB chips capable of 100 megabits per second were already commercially available (*id.*, 3:7-10) and that mesh networking will provide efficient network paths that allow very high data rates across the internet (*id.*, 3:11-13).

Despite this applicant admitted prior art, the '999 patent merely purports to invent the combination of repeater filtering functionality with ultrawideband. In particular, the '999 patent claims that the "presently proposed 802.15.3 standard" for ultrawideband "is not adequate to provide one or more of sufficient security, proper traffic filtering, bandwidth provisioning, network management features, or flexibility of networks that can be installed or controlled easily by a consumer." Ex. 1001, 2:46-56.

However, the use of ultrawideband in a repeater was not what the examiner found novel. During prosecution of the '999 patent, the examiner rejected the then-independent claims which merely claimed ultrawideband communications on a repeater, but stated that certain dependent claims would be allowed if rewritten in independent form.

In response, the applicant turned each of the dependent claims into independent form. For all independent claims, the applicant added a maximum

bandwidth and data rate, *i.e.* the bandwidth must be between 100 to 500 MHz and (where claimed) the data rate must be between 100 and 480 mbps. For independent claim 32, the applicant added the use of beacon frames. For independent claim 33, the applicant added a wired connection port for the repeater to bridge with the wireless interface (*i.e.* send wireless communications over the wired port, or send wired communications over the wireless interface). For independent claims 33 and 39, the applicant added OFDM signals.

Yet each of these limitations were well-known functions of wireless devices. The patent itself states in the background acknowledges that "UWB devices [in development] … will … provide … burst rates ***up to 480 Megabits per second***." Ex. 1001, 1:43-46. The patent states that companies like "Time Domain, Xtreme Spectrum Inc, Motorola, Intel and Texas Instruments, are likely to be leading manufacturers or developers of products for UWB communications." *Id.*, 1:49-55. The patent further describes that a "powerpoint presentation by Nishant Kumar … as we asll in the IEEE standards proceedings" describes how "[d]evices use passinv scanning to listen for ***beacon frames*** …" *Id.*, 2:26-31. The patent also acknowledges that the "Ultrawideband Physical Layer standard committee, is working on creating a standard that may … be Multiband ***OFDM*** transmission." *Id.*, 2:57-60. Finally, the patent identified "well known" prior art "[r]epeaters" systems that provided a ***relay bridge between wired and wireless ports***, including a device

from "Buffalo" that provides WiFi "and has 10/100 Ethernet LAN connection port," as well as the SMC Networks "SMC 2671W 2.4 GHz 11 Mbps Wireless Ethernet Adapter, which provides an interface between the wired internet backbone and the wireless LAN network." *Id.*, 3:29-48.

As a result, despite considering art that describes relaying transmissions which use UWB bandwidth and data rates, the examiner overlooked the significant body of prior art that discloses repeaters/relays which provide any of the common functions described above (less than 500 MHz bandwidth, less than 480 mbps data rate, OFDM, beacon frames, wireless/wired bridge)—a significant error in view of the fact that the '999 patent admits that such functions were well-known in the art. Such prior art includes Ganz, Larrick, and Soomro, the references raised in the petition, which indisputably describes such functions. *See, e.g.*, Ex. 1007 (Larrick) ("UWB signal … with a 3 dB bandwidth of 400 MHz"); Ex. 1010 (Soomro), ¶36 ("the beacon transmission rule within the IEEE 802.11-1999 standard"); *Id.*, ¶4 ("802.11a standard … based on orthogonal frequency division multiplexing (OFDM) for the physical (PHY) layer"); Ex. 1005 (Ganz), 3:39-43 ("The host radio station 2, provides data communications from the land line link 4 (i.e., Internet or other private distribution data sources) to users 26 remotely located from the host radio station 2, by a network of WBCRs 10,100, 72, 40.").

Ganz, Larrick, and Soomro were not before the examiner. In overlooking this

art, the examiner committed material error, and "it is an appropriate use of Office resources to review the[se] potential error[s]." *Taiwan Semiconductor Manufacturing Co. v. Marlin Semiconductor Ltd*., IPR2025-00847, Paper 11 (Director Sept. 3, 2025); *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025 00153, Paper 11 at 3 (June 12, 2025) ("Petitioner relies on Letendre to teach a 'slide,' and Patent Owner does not dispute that Letendre teaches a 'slider.'").

V. THE *FINTIV* FACTORS WEIGH AGAINST DISCRETIONARY DENIAL

The *Fintiv* factors heavily weigh against denial, including the fact that trial is scheduled to occur after the statutory deadline for the Board's Final Written Decision in ***all twelve*** IPR proceedings, as well as Petitioner's broad stipulation.

A. Factor 1: The District Court Has Not Indicated Its View on a Stay

Patent Owner attempts to predict how the District Court might rule on a potential post-institution stay motion. Request at 11-13. However, the Board declines to engage in such speculation when the district court has not expressed any position on the matter, instead treating this factor as neutral. *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (P.T.A.B. May 13, 2020) ("We decline to infer, based on actions taken in different cases with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here.").

Patent Owner concedes that the District Court would likely consider and

potentially approve a stay if institution occurs across all twelve petitions. Request at 11, 17; *see also Cobblestone Wireless, LLC v. Cisco Systems, Inc.*, No. 2:23-cv-00454-JRG, 2024 WL 5047854 (E.D. Tex. Dec. 9, 2024) (granting stay following institution of IPR against asserted patent); *Emerging Automotive LLC v. Kia Corp. et al.*, No. 2:23-cv-00437-JRG, Dkt. 301 (E.D. Tex. Jun. 30, 2025) (granting stay following institution of IPRs and *ex parte* reexamination against all asserted patents). Indeed, the District Court has shown a recent willingness to grant stays even close to trial. *Stellar LLC v. Motorola Solutions, Inc. et al.*, No. 4:23-cv-750-SDJ, Dkt. 156 (E.D. Tex. Feb. 24, 2025) (imposing stay two weeks before trial, even while awaiting institution decisions on some asserted patents); *Emerging Automotive LLC v. Kia Corp. et al.*, No. 2:23-cv-00437-JRG, Dkt. 301 (E.D. Tex. Jun. 30, 2025) (approving stay three weeks pre-trial).

B. Factor 2: Trial Is Scheduled After the Final Written Decisions

As Patent Owner concedes, trial is currently scheduled for May 17, 2027. That is well after the April 8, 2027 statutory deadline for the Board's Final Written Decision in this proceeding. It is also after the statutory deadline for the FWD in the last-filed IPR, May 8, 2027. This factor therefore substantially weighs against denial.*Google LLC v. Cellular South, Inc.*, IPR2025-00875, Paper 10, (Director Oct. 17, 2025) ("[I]t is likely that a final written decision in this proceeding will issue before the district court trial occurs, reducing the risk of duplication of effors and

inconsistent outcomes.").

Patent Owner cites to a cherry-picked "median 655 days to trial for cases pending being between Jan. 1, 2022 and Oct. 22, 2025 before Judge Gilstrap." Request at 17. But Patent Owner fails to heed Chief APJ Boalick's instruction to use "median time-to-trial statistics for civil actions ***in the district court.***" March 24, 2025 Guidance on USPTO's Rescission of Vidal Memo. The Eastern District of Texas's official time-to-trial statistics show that the most recent median time-to-trial for the district court is 24.5 months, which would place trial sometime in June 2027, after the current trial date. Ex. 1051. Patent Owner's statistic also fails to consider the significant rise in cases before Judge Gilstrap over the past year.

C. Factor 3: The Parties' Limited Investment In The District Court Litigation Weighs Against Discretionary Denial

This factor significantly weighs against discretionary denial. At the time of the Board's institution decision, the parallel litigation will still be in its early stages with limited investment by the court and parties—including a lack of a *Markman* hearing.

While Patent Owner emphasizes that the parties have exchanged contentions (Request at 17-18), that is not what the Board considers to be significant investment. More relevant is the fact that the District Court's *Markman* hearing is scheduled for November 10, 2026, many months after the Board's date for deciding institution.

Ex. 2018 at 4. Indeed, by the institution decision date of April 7, 2026, the parties will not even have begun the process of claim construction by exchanging proposed terms. Fact discovery has only just begun and is not scheduled to be completed until December 28, 2026. Expert discovery will not be completed until February 1, 2027. These dates establish that there has been very little investment in the litigation. *Cf. Coretronic Corp. v. Maxell Ltd.*, IPR2025-00941, Paper 9 (Sept. 26, 2025) (finding meaningful investment where "the parties have participated in a *Markman* hearing, fact discovery was scheduled to close on August 21, 2025, and expert discovery will close soon.").

The primary reason there has been little progress in the litigation so far, despite Judge Gilstrap's propensity for aggressive scheduling, is because Petitioner was diligent in bringing these IPR petitions—all twelve petitions covering a wide swath of subject matter were filed between 3 to 5 months after Patent Owner filed its complaint.

D. Factor 4: Petitioner's Broad Stipulation

Petitioner has filed a broad stipulation that closes the loophole that the Director identified in *Motorola*. *Motorola Sols.*, IPR2024-01205, Paper 19 at 4 ("Petitioner's invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner's stipulation is not likely to moot.").

Specifically, Petitioner stipulates that, if this petition is instituted (and not later denied institution or dismissed without a Final Written Decision), Petitioner will not assert in the parallel litigation:

> (1) any grounds of invalidity arising under U.S.C. § 102 or § 103 involving only patent or printed publication prior art that could have reasonably been raised before the Board with respect to U.S. Pat. No. 10,224,999 (the '999 patent), including the same grounds in the Petition (Paper 1); or
>
> (2) any grounds of invalidity arising under U.S.C. § 102 or § 103 with respect to the '999 patent that include U.S. Pat. No. 6,584,080 ("Ganz"), U.S. Pat. No. 7,209,523 ("Larrick"), WO 03/058850 ("Engels"), U.S. Patent Application Pub. No. 2004/0136373 ("Bareis"), U.S. Patent Application Pub. No. 2003/0002456 ("Soomro"), or U.S. Patent Application Pub. No. 2005/0233709 ("Gardner").

This stipulation includes a *Sotera* stipulation as well as a stipulation not to use any of the IPR prior art, even in combination with system art that could not be raised in the IPR. This stipulation therefore removes any overlap between the parallel litigation and this proceeding, and significantly weighs against denial. *Samsung Electronics Co., Ltd. v. Wilus Institute of Standards and Technology Inc.*, IPR2025-00933 *et al.*, Paper 11 (Director Oct. 10, 2025) ("Petitioner has filed a broad stipulation that reduces the concern of inconsistent outcomes or significant duplication of efforts.").

Patent Owner nevertheless argues that Petitioner's stipulation is "materially narrower" than the stipulation the Office has proposed in its Notice of Proposed Rulemaking. Request at 18. However, Petitioner has already stated it would update

its stipulation to be consistent with such proposed rules if and when they are made final. Paper 7, 2 n.1.

E. Factor 5: Petitioners Being the District Court Defendants Does Not Outweigh the Factors Weighing Against Discretionary Denial

Petitioner is the defendant in the district court case. This factor does not outweigh the other factors discussed above.

F. Factor 6: The Merits of the Petition are Strong

Patent Owner does not dispute the substance of the petition. Instead, Patent Owner argues that Petitioner's expert "largely repeats the Petition verbatim." Request at 19-20 ("[P]arroting of the Petition's text"). Petitioner cites to no evidence that Dr. Mahon "repeat[ed]" or "parrot[ed]" the Petition—as opposed to the Petition significantly relying on Dr. Mahon's opinions. Indeed, Dr. Mahon makes clear that he "prepared this declaration" and "provid[ed] certain opinions relating to the patentability of the '999 patent." Ex. 1002, 1. Clearly, his declaration reflects his opinions, and the Petition is supported by his opinions.

Patent Owner argues that the "Board routinely discounts" "parroting of the Petition's text without technical reasoning." Request at 20. But the Board does not ignore expert testimony just because it is worded similarly with the petition—expert testimony is discounted only if it lacks reasoning or supporting evidence. *See PLR Worldwide Sales Ltd. v. Flip Phone* Games, IPR2024-00171, Paper 31 at 41 ("Xerox

stands for the proposition that a declaration is entitled to little weight when it restates a petition's unsupported, conclusory assertions without any additional supporting evidence or reasoning. … [W]e find that the assertions in the Petition are … not conclusory, thus distinguishing this situation from the one described in *Xerox*."). Although Patent Owner accuses Dr. Mahon of providing "unsupported assertions," Patent Owner does not identify any such conclusory remarks. Indeed, Dr. Mahon heavily cites to the prior art and other references, and provides detailed explanation and analysis.

VI. CONCLUSION

Patent Owner has identified no legitimate basis for the Director to deny institution based on any discretionary factors. Institution should be granted.

DATED: January 8, 2026

Respectfully submitted,

By */s/ James Glass*

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on January 8, 2026, true and correct copies of the foregoing document and supporting materials were served in its entirety at the following email addresses:

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