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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVIDBOTS CORP. and AVIDBOTS USA CORP.,
Petitioners,

v.

BRAIN CORPORATION.,
Patent Owner

Case No. IPR2025-01600
US Patent No. 10,001,780

**PATENT OWNER'S BRIEF IN SUPPORT OF
DISCRETIONARY DENIAL UNDER 35 U.S.C. §314(a)**

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2001	Proposed Protective Order
2002	Redlined Protective Order
2003	Complaint for Patent Infringement, <i>Brain Corp. v. Avidbots Corp. et al.</i> , Case No. 1:24-cv-12569, Dkt. 1 (N.D. Ill. Dec. 6, 2024)
2004	Declaration of Daniel P. Hughes
2005	Northern District of Illinois Local Patent Rules
2006	Joint Initial Status Report & Notification of Docket Entry, <i>Brain Corp. v. Avidbots Corp. et al.</i> , Case No. 1:24-cv-12569, Dkts. 40 & 42 (N.D. Ill.)
2007	Report of the Parties' Planning Meeting, <i>Brain Corp. v. Avidbots Corp. et al.</i> , Case No. 1:24-cv-12569, Dkt. 34 (N.D. Ill.)
2008	Defendant Avidbots's Second Supplemental Non-Infringement and Invalidity Contentions, <i>Brain Corp. v. Avidbots Corp. et al.</i> , Case No. 1:24-cv-12569 (N.D. Ill.)
2009	Certificate of Service of Complaint in <i>Brain Corp. v. Avidbots Corp. et al.</i> , Case No. 1:24-cv-12569, Dkt. 8 (N.D. Ill.)
2010	HIGHLY CONFIDENTIAL – ATTORNEYS' EYES ONLY - Exhibit 97 to December 11, 2025 Cabrerra Deposition in <i>Brain Corp. v. Avidbots Corp. et al.</i> , Case No. 1:24-cv-12569 (N.D. Ill.)
2011	HIGHLY CONFIDENTIAL – ATTORNEYS' EYES ONLY - Exhibit 99 to December 11, 2025 Cabrerra Deposition in <i>Brain Corp. v. Avidbots Corp. et al.</i> , Case No. 1:24-cv-12569 (N.D. Ill.)
2012	HIGHLY CONFIDENTIAL – ATTORNEYS' EYES ONLY - Excerpts of December 11, 2025 Cabrerra Deposition in <i>Brain Corp. v. Avidbots Corp. et al.</i> , Case No. 1:24-cv-12569 (N.D. Ill.)

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2016	Printout of November 16, 2019 Wayback Machine archive of https://www.braincorp.com/patents (captured on January 7, 2026)
2017	Printout of April 16, 2022 Wayback Machine archive of https://www.braincorp.com/patents (captured on January 7, 2026)
2018	HIGHLY CONFIDENTIAL – ATTORNEYS’ EYES ONLY – Document produced by Avidbots bearing production nos. AVID0576615–AVID0576616

I. INTRODUCTION

Patent Owner Brain Corporation (“PO”)’s ’780 Patent has been in force since 2018 and reflects the innovations of a team of engineers in San Diego, California to optimize the navigation of autonomous industrial robots. Petitioner Avidbots Corp. (“Petitioner”) is a foreign entity who [REDACTED]

[REDACTED]

Petitioner aggressively litigated in the district court for nearly eleven months before pivoting to Patent Office review. The Director should deny the petition because all six *Fintiv* factors and additional considerations favor denial.

First, Petitioner cannot show the district court is likely to grant Petitioner’s motion to stay. Petitioner waited until days before its statutory deadline to file its final IPR petition and then waited another month before moving stay. During that extensive delay, the parties have exchanged multiple rounds of contentions and will exchange *final* contentions in a few days. The parties have finished document productions, including the production of over **1.4 million** pages of documents and hundreds of thousands of source code files. The parties have taken 65 hours of depositions, including depositions on over 100 Rule 30(b)(6) topics. And the district court devoted substantial time to the case and held nine hearings.

Second, a trial date is not set, but the case is likely to proceed to trial in early 2027 before the statutory deadline for a final written decision.

Third, the parties have substantially invested in the district court litigation. By the May 2026 institution deadline, the parties will have completed final contentions, all of fact discovery, and most of claim construction.

Fourth, the issues raised in the petition overlap with district court issues. The petition challenges all claims asserted in one Asserted Patent in the district court and raises invalidity arguments that overlap with the district court proceeding. Petitioner has also filed other petitions that also overlap with its district court theories.

Fifth, Petitioner is the named defendant in the district court litigation.

Sixth, other factors favor denial. Settled expectations weigh heavily against institution because the '780 Patent issued in June 2018 and has been in force for seven-and-a-half years. Since then, PO has released numerous products that practice the '780 Patent and become the market leader based in part on its patented technology. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Further, as discussed in more detail in PO's forthcoming Patent Owner Preliminary Response, the merits of the petition are weak and rely on expert testimony that largely parrots the petition itself. The parties will also raise factual

disputes best addressed in district court, including the dates of non-patent literature, Petitioner's copying of PO, and secondary considerations of non-obviousness based on PO's patent practicing products. Additionally, compelling economic or national security interests warrant denial because PO is the U.S. market leader headquartered in California, whereas Petitioner is a foreign company attempting to supplant PO through unauthorized use of PO's patented technology.

Accordingly, all relevant factors weigh in favor of discretionary denial.

II. STATEMENT OF FACTS

A. PO Sues Petitioner In The Northern District Of Illinois

PO is an American company headquartered in San Diego, California. EX2003, ¶1. PO pioneered the commercial robotics domain by developing innovative solutions in robotics and artificial intelligence, namely cleaning and inventory robotics. EX2003, ¶12. PO's pioneering Brain Operating System ("BrainOS") allows users of autonomous floor care devices to teach, clean, and review routes. *See id.*, ¶ 13-14. Among other things, BrainOS uses PO's patented technology regarding map generation, the use of repulsive forces in route planning, and object detection. *See id.* ¶¶ 32, 48, 65, 81, 94.

Petitioner is a Canadian company that has recently begun competing against PO for PO's largest United States customers. On December 6, 2024, PO sued Petitioner for infringing five patents on PO's pioneering technology. EX2003. In

particular, PO alleges that the “Avidbots Autonomy platform” uses PO’s patented technology on map generation, repulsive forces, and object detection. PO alleged infringement of five patents in three patent families: (1) the ’780 Patent and U.S. Patent No. 10,379,539, (2) U.S. Patent Nos. 10,274,325 and 10,823,576, and (3) U.S. Patent No. 10,728,436 (collectively, the “Brain Asserted Patents”).

After obtaining an extension of time to respond, Petitioner unsuccessfully moved to dismiss PO’s complaint. EX2004, ¶ 4. Petitioner then retaliated against PO by asserting meritless claims that PO infringes Petitioner’s patents. *Id.*

B. The Parties Have Largely Completed Discovery

In the twelve months that the district court case has been pending, the parties engaged in significant discovery. The Local Patent Rules (“LPR”) in the Northern District of Illinois set aggressive deadlines for contentions and fact discovery. EX2005. For example, the LPR set the following deadlines: (1) initial disclosures due 14 days after the answer, (2) initial infringement contentions due 14 days later, (3) initial non-infringement, unenforceability, and invalidity contentions due 14 days later, and (4) responses to initial non-infringement, unenforceability, and invalidity contentions due 14 days later. EX2005, §§2.1, 2.2, 2.3, 2.5. The parties thus began exchanging contentions promptly even before the district court issued a schedule.

In June 2025, the district court issued a schedule for adjudicating the parties’ patent infringement claims. *See* EX2006 (parties’ proposed schedule and order

adopting schedule). That schedule set the following deadlines: (1) final infringement and invalidity contentions due January 14, 2026, (2) final responsive contentions due February 11, 2026, (3) close of fact discovery on March 25, 2026, and (4) claim construction briefing from April to May 2026. *Id.*, 8-9.

Given these deadlines, the parties spent the past twelve months substantially completing discovery. The parties served and responded to nearly 200 requests for production and 40 interrogatories. EX2004, ¶7. The parties have now **completed** both ESI and standard document productions totaling over 1.4 million pages. *Id.*, ¶8. They also produced hundreds of thousands of source code files for inspection. *Id.*, ¶9. The parties have also completed 65 hours of depositions, including nearly all technical depositions necessary for final contentions. *Id.*, ¶10. They also provided testimony on over 100 Rule 30(b)(6) topics. *Id.*, ¶11. And the parties took significant third party discovery. *Id.*, ¶12.

The district court has also been extremely involved in pushing the case forward. The court has now held a total of ten hearings, including status hearings as often as every two weeks at times during the discovery period. *Id.*, ¶13.

C. Petitioner Delays Seeking IPR

PO repeatedly informed Petitioner that it should promptly petition for IPR if it intended to do so. When Petitioner suggested it might petition for IPR in an April 2025 joint status report, PO responded “[i]f [Petitioner] were truly interested in

efficiency, it would petition for IPR promptly” instead of seeking to “delay this case as long as possible and then petition for IPR and seek a stay at the last minute.”

EX2007, 19. Petitioner did not file any IPR petitions at that time.

In June 2025, the parties filed another joint report adjusting the schedule to accommodate Petitioner’s patent allegations. When Petitioner again suggested it might petition for IPR, PO again responded that Petitioner should “petition for IPR promptly” instead of delaying. EX2006, 12. Again, Petitioner did not do so.

Petitioner finally filed this IPR petition on October 30, 2025—nearly eleven months after PO filed suit. Paper 1. On November 10, 2025, the Patent Office accorded the Petition a filing date. Paper 3. A decision on whether to institute IPR is expected by May 10, 2026. If instituted, a final written decision would be expected by May 10, 2027.

D. Petitioner Delays Petitioning For IPR Of The Other Patents

On November 6, 2025, Petitioner filed a second IPR petition on the ’576 patent. IPR2025-01603. From December 1-4, 2025, Petitioner filed separate IPR petitions on each of the other Brain Asserted Patents. *See* IPR2025-01601, -01602, -01604. Petitioner filed each of those petitions just a few *days* before the statutory deadline of December 10, 2025. EX2004, ¶ 3; EX2009. The decisions on whether to institute are expected by June 2026. If instituted, final written decisions would be

expected by June 2027. PO will separately ask the Patent Office to exercise its discretion and deny institution of each of those IPRs.

E. Petitioner Delays Moving To Stay

After waiting until the last minute to petition for IPR, Petitioner then delayed its motion to stay until January 2, 2026—more than two months after Petitioner filed this IPR. EX2004, ¶4. PO opposed the next business day. *Id.* As of the filing of this paper, the district court has not yet ruled on the motion.

III. ARGUMENT

Institution of inter partes review is discretionary. The “Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). As the Supreme Court has explained, § 314(a) “invests the Director with discretion on the question *whether* to institute review.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 366 (2018); *see also Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

In determining whether to exercise its discretionary power under § 314(a), the PTAB balances the six factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (PTAB “Precedential” Mar. 20, 2020) (“*Fintiv* factors”). The Director

also considers a number of factors, including settled expectations of the parties, the strength of the unpatentability challenge, and other considerations. *See* USPTO Director Memo, *Interim Processes for PTAB Workload Management* (March 26, 2025); *see also* USPTO Director Memo, *Director Institution of AIA Trial Proceedings* (October 17, 2025).

Here, the *Fintiv* factors and other relevant facts weigh heavily against instituting IPR for at least the reasons described below.

A. *Fintiv* Factor 1: Petitioner Cannot Show The Parallel District Court Litigation Was Stayed Or Is Likely To Be Stayed

Factor 1 asks “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). Here, Petitioner cannot show the district court is likely to grant its motion to stay.

The movant’s delay in moving to stay weighs heavily against the district court staying the litigation. *Ellenby Techs., Inc. v. Fireking Security Grp.*, 533 F. Supp. 3d 656, 663 (N.D. Ill. 2021) (discussing another case in explaining “defendants had filed their IPR petition eight months after bringing the patent suit, a time frame the court considered ‘long,’ whereas here that time frame is 10 months.”). The Northern District of Illinois sets a very aggressive default schedule for patent cases. EX2005; EX2006. Given the speed in which parties must complete pretrial activities—and the burdensome nature of doing so—PO notified Petitioner long ago that it should

promptly petition for IPR if it intended to do so. EX2006, 12; EX2007, 19. Yet Petitioner delayed filing this petition until October 30. Petitioner also delayed petitioning for IPR on the remaining asserted patents until just days before the statutory deadline. *See* IPR2025-01601, -01602, -01604. And Petitioner did not file its motion to stay until January 2026. EX2004, ¶4.

A litigation that has proceeded past the initial stages is unlikely to be stayed. *Multimedia Content Mgmt. LLC v. Dish Network L.L.C.*, 2019 WL 11706231, at *2 (W.D. Tex. May 30, 2019) (quoting *CANVS Corp. v. U.S.*, 118 Fed. Cl. 587, 595–96 (2014)). As discussed below, *infra* §II.C., Petitioner’s delay in seeking a stay resulted in the parties completing much of the required pretrial tasks. Before the deadline to institute IPR, the parties will have completed fact discovery, served final patent contentions, narrowed to 20 claims per side across all asserted patents, and nearly completed claim construction briefing. EX2004, ¶14. The parties will then be proceeding toward expert reports and trial.

Accordingly, Petitioner cannot show the district court is likely to grant a stay. *Fintiv* Factor 1 weighs in favor of denying institution.

B. *Fintiv* Factor 2: The District Court Trial Will Likely Occur Before A Final Written Decision

A trial date scheduled earlier than the projected statutory deadline for a final written decision weighs against institution. *Fintiv*, Paper 11 at 9. Here, the district court has not scheduled a trial date because courts in the Northern District of Illinois

typically do not set a trial date until after claim construction. However, the Patent Local Rules provide aggressive default deadlines that will result in a claim construction hearing in June 2026—just a few weeks after the deadline to institute IPR. Given the stage of the case, PO currently estimates trial will be scheduled for March 2027. *See* EX2006, 11. Thus, trial will likely occur months before the May 2027 statutory deadline for a final written decision. Assuming trial occurs as expected, that schedule weighs against instituting IPR. *See Immersion Sys. LLC v. Midas Green Techs., LLC*, IPR2021-01176, Paper 16 at 12-13 (PTAB Jan. 6, 2022) (district court trial “three months prior to when a final written decision would be statutorily due” weighs in favor of exercising discretion to deny petition).

Even if trial were delayed and occurred after the projected final written decision, this factor would at most be neutral in view of the length of time this patent has been in force and the stage of the district court proceedings. *See Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00223, Paper 9, at 2 (PTAB June 12, 2025) (finding trial would occur after final written decision, but denying institution “because of the parties’ meaningful investment in the district court proceedings”); *Intel Corp. v. General Video LLC*, IPR2025-01036, Paper 13, at 2-3 (PTAB October 17, 2025) (finding trial would occur after final written decision, but denying institution based on settled expectations); *Micron Tech., Inc. v. Palisade Techs., LLP*, IPR2025-01008, Paper 15, at 2-3 (PTAB October 17, 2025) (finding it

was unclear whether trial would occur after the final written decision, but denying institution based on settled expectations); *see also Sun Pharm. Indus., Inc. v. Nivagen Pharm., Inc.*, IPR2025-00893, Paper 18, at 2-3 (PTAB September 19, 2025) (denying institution even though trial would occur more than two years *after* final written decision and PO identified no settled expectations because patent was in force for only one year).

Accordingly, *Fintiv* Factor 2 weighs in favor of denying institution or is, at most, neutral.

C. *Fintiv* Factor 3: The Parties Have Substantially Invested In The District Court Litigation

“[M]ore work completed by the parties and court in the parallel proceeding tends to support” a finding that “instituting would lead to duplicative costs.” *Fintiv*, Paper 11 at 10. Here, the parties’ substantial efforts in the district court weigh heavily against institution.

As described above, the parties have already engaged in motion practice regarding PO’s Complaint and Petitioner’s Answer and Counterclaims. EX2004, ¶4. PO and Petitioners have exchanged initial infringement and invalidity contentions and are scheduled to exchange final contentions on January 14, 2026, and February 11, 2026. *Id.* at ¶ 6. In its infringement contentions, PO showed in detail how Petitioners’ Accused Products infringe multiple claims of the Asserted Patents, including the ’780 Patent.

The parties have also completed the bulk of discovery in the district court case, including by (a) completing both ESI and standard document productions totaling over 1.4 million pages of documents, (b) making hundreds of thousands of source code files available for inspection, (c) responding to nearly 200 requests for production and 40 interrogatories, (d) serving subpoenas totaling 271 topics on 27 third parties, (e) providing testimony on over 100 Rule 30(b)(6) topics, and (f) taking over 65 hours of depositions. EX2004, ¶¶7-12 The district court has been extremely involved in pushing the case forward and has already held ten hearings. *Id.*, ¶13. The parties have also substantially focused the dispute by narrowing to just 20 claims per side total. *Id.*, ¶14.

Moreover, the parties will incur additional costs even before institution. In addition to final contentions in January and February, the parties will: (a) exchange claim terms for construction on February 25, 2026, (b) narrow to ten claim terms on March 4, 2026, (c) complete fact discovery on March 25, 2026, (d) file opening claim construction briefs on April 1, 2026, and (e) file responsive claim construction briefs on April 29, 2026. EX2006, 9.

Further, claim construction briefing will be complete on May 20, 2026—just ten days after the institution deadline. Thus, the district court will be addressing claim construction and summary judgment long before the PTAB addresses the same issues. Any final written decision would simply revisit the earlier rulings from the

district court. Such duplicative efforts contradict the main purpose of inter partes review—“to establish a more efficient and streamlined patent system that will improve patent quality and ***limit unnecessary and counterproductive litigation costs.***” Practice Guide at 56 (emphasis added) (quoting H.R. Rep. No. 112–98, pt. 1, at 40 (2011), 2011 U.S.C.C.A.N. 67, 69). Instead of limiting unnecessary litigation costs, Petitioner aggressively litigated the district court case for nearly a year before petitioning for IPR at the last minute.

Accordingly, *Fintiv* Factor 3 weighs in favor of denying institution.

D. *Fintiv* Factor 4: The Issues Raised In The Petition Overlap With The District Court Issues

“[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.” *Fintiv*, Paper 11 at 12. This Petition addresses all of the claims of the ’780 Patent that PO asserts in the district court. It also includes grounds that overlap with the parallel proceeding. In particular, the first two grounds in the Petition rely on “Beardsley” as the primary reference and three of four grounds rely on “Khatib” as a secondary reference. Pet., 3. Petitioners’ invalidity contentions rely on both Beardsley (as an issued patent) and Khatib. EX2008, 25-28 (exhibit pagination).

Further, Petitioner’s *Sotera* stipulation does not ensure the IPR proceeding is a true alternative to district court litigation. Pet., 2. A *Sotera* stipulation “does not ensure” that an IPR proceeding would be a “true alternative” if “Petitioner’s

invalidity arguments in the district court are more expansive” and include “unpublished system prior art” not mooted by the *Sotera* stipulation. *Motorola Sols. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3–4 (PTAB Mar. 28, 2025) (denying institution). Here, Petitioner relies on **thirteen** pieces of unpublished “system” prior art in the district court. EX2008, 28-29. Petitioner has also reserved the right to assert **any** one or more of these “systems” with any other pieces of alleged prior art, including the alleged prior art that it asserts in its IPR petition. *Id.*, 30.

Further, Petitioner did **not** provide a *Sotera* stipulation in three of the five related IPRs it filed (IPR2025-01602, -01603, and -01604). That provides a further reason to deny institution of all petitions because it guarantees that these IPRs would not be a “true alternative” to the copending litigation.

Accordingly, *Fintiv* Factor 4 weighs in favor of denying institution.¹

E. Fintiv Factor 5: Petitioner Is The Defendant In The District Court Litigation

Factor 5 weighs in favor of denying institution because Petitioner is the defendant in the parallel district court proceeding. *See Fintiv*, Paper 11 at 9.

¹ Petitioner’s voluntary search disclosure should be entitled to little weight because it does not reveal “new or underutilized pathways relevant to Office search practice” or attempt to show Office error. *See* Director Memo, Voluntary Search Disclosure Declarations as a Favorable Factor in Institution Decisions (November 17, 2025), p. 2. Rather, Petitioner admits to using standard well-known tools (“Google Scholar, Google Patents, and Google Search”) and does not attempt to show Office error. *See* Paper 6, ¶4.

F. Fintiv Factor 6 And Other Circumstances Favor Denial

Several other circumstances also favor denial, either under *Fintiv* Factor 6 or more broadly under the guidelines in the Director memorandums. *First*, the Patent Office has recently explained that “settled expectations” favor discretionary denial. *Dabico Airport Solutions Inc. v. AXA Power APS*, IPR-2025-00408, Paper 21 at 3 (PTAB June 18, 2025) (denying institution where “the challenged patent has been in force almost eight years, creating settled expectations”). Here, the ’780 Patent issued in June 2018—nearly eight years ago. EX1001, Cover. Since that time, PO has extensively invested in the robotic cleaning field and become the market leader by selling software that uses the ’780 Patent.

Second, evidence from the district court also shows that Petitioner has been

[REDACTED] EX2010 ([REDACTED]
[REDACTED]); EX2011 ([REDACTED]
[REDACTED]
[REDACTED]);
EX2012 at 152:10-153:11. [REDACTED]
[REDACTED]. See EX2013-EX2015; EX2012 at 212:5-213:5 ([REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]). [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

EX2015 at -290, -403; EX2012 at 220:10-221:7 ([REDACTED]
[REDACTED]). That website included the '780 Patent

at the time. EX2016, EX2017. [REDACTED]

[REDACTED] EX2013; EX2012 at 226:18-22, 231:22-232:5,
232:20-233:4. [REDACTED]

[REDACTED]. EX2018 [REDACTED]

[REDACTED]). [REDACTED]

[REDACTED]

[REDACTED]

Third, Petitioner's asserted grounds for invalidity are weak. For example, Petitioner fails to demonstrate that the asserted non-patent literature qualifies as prior art. Pet., 4. Instead of presenting arguments in the Petition, Petitioner improperly incorporates those arguments by reference to a declaration. *Id.* But that declaration merely repeats the dates appearing on documents, which are inadmissible hearsay. EX1008, ¶¶24-27, 44-46. The Petition also fails to demonstrate that the proposed obviousness combinations disclose limitations such as (a) "each route pose comprises a footprint ... and each route pose has a plurality of points disposed therein" or (b) "determine forces on each of the plurality of points of each route pose." *See, e.g.*, Pet., 25-33, 78-83. The forthcoming Patent Owner Preliminary Response will provide further details on how the Petition lacks merit.

Fourth, the Petition relies extensively on unfocused expert testimony that largely mirrors the Petition without further substantive analysis. For example, Claim 1 requires "determin[ing] forces on each of the plurality of points of each route pose." Pet., 31. But the Petition did not explain how the art discloses this requirement. Instead, the Petition relied on its expert declaration to argue that a POSITA would understand a particular figure as showing a system calculating "repulsive velocities" on multiple points. *Id.* (citing EX1003, ¶80). But the expert

merely repeated the same sentence without further explanation. EX1003, ¶80. Thus, the Petition should be denied because it relies on unfocused expert testimony that does little more than repeat the Petition nearly verbatim. 37 C.F.R. §42.65(a); *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15–17 (PTAB Aug. 24, 2022) (precedential) (according “little weight” to testimony that restated a petition’s conclusory assertions without additional evidence or reasoning).

Further, the PTAB does not allow “evidence that is not ‘prior art consisting of patents or printed publications’” to “be used to supply a missing claim limitation.” *See* July 31, 2025 Memorandum from Stewart to PTAB re Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews at 1; *c.f. Qualcomm Inc. v. Apple Inc.*, 134 F.4th 1355, 1364–65 (Fed. Cir. 2025) (“[applicant-admitted prior art] is not a prior art patent or printed publication” and “the plain meaning of § 311(b) does not permit the basis [of a petition] to include [applicant-admitted prior art]”). Yet that is exactly what the Petition does by relying on expert testimony to supply a claim limitation rather than the references.

Fifth, the district court is a more efficient forum to resolve the parties’ dispute. The Petition raises factual disputes better addressed in district court through live witness testimony and cross-examination. For example, a jury would be better suited to determining whether the references are prior art, particularly here where

Petitioner's declarants testified that a reference was somehow published on IEEE Xplore *before* IEEE Xplore was ever online. *See* EX1008, ¶¶17, 25-27.

This IPR will also involve detailed discussion of objective indicia of nonobviousness, including copying and commercial success, which would involve significant evidence better suited for a jury. Additionally, the district court has already employed its flexible case management tools to narrow issues, including by requiring PO to narrow to just 20 claims total across all five asserted patents. In contrast, the PTAB lacks these tools and must issue a final written decision on *all* claims challenged by Petitioner. *See SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 371 (2018). Thus, the PTAB is a far less efficient forum for resolving this dispute.

Sixth, there have been no new changes in the law or new judicial precedent issued since the issuance of the '780 Patent that could affect patentability.

Seventh, compelling economic or national security interests warrant denial. PO is the U.S. leader in the robotic cleaning space and is headquartered in San Diego, California. In contrast, Petitioner is a foreign corporation attempting to enter the United States market and supplant PO through unauthorized use of PO's patented technology. The United States has a compelling interest in preventing such foreign companies from using the PTAB to further such purposes.

Finally, Petitioner appears to have engineered the timing of its IPR petition to obtain the benefit of duplicative challenges to the '780 Patent in district court *and* in

the PTAB. Doing so would tie up the PTAB's limited resources for Petitioner's benefit at the expense of patent owners in this and other PTAB proceedings. As a consequence, Petitioner's request for review in this proceeding would frustrate the PTAB's ability to comply with pendency goals for ex parte appeals and statutory deadlines for other AIA proceedings. *See* 35 U.S.C. § 316(b).

Accordingly, *Fintiv* Factor 6 and additional considerations weigh in favor of denying institution.

IV. CONCLUSION

Accordingly, PO respectfully requests that the Patent Office exercise its discretion to deny institution of inter partes review of the '780 Patent.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. §42.6(e) and with the agreement of counsel for Petitioners, a true and correct copy of **PATENT OWNER’S BRIEF IN SUPPORT OF DISCRETIONARY DENIAL UNDER 35 U.S.C. §314(a) AND EXHIBITS** are being served electronically on January 12, 2026, to the e-mail addresses shown below:

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