

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. IPR2025-01601
U.S. Patent No. 10,379,539

PETITIONER'S BRIEF OPPOSING DISCRETIONARY DENIAL

A large black rectangular redaction box covers the text of the petition. It is positioned below the title and above the mailing address.

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PETITIONERS' EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 10,379,539
1002	File History for U.S. Patent No. 10,379,539 (Appl. No. 16/011,499)
1003	Declaration of Nickolaos Papanikolopoulos
1004	U.S. Patent Appl. Pub. No. 2015/0284010 (“Beardsley”)
1005	J. Minguez, L. Montano, J. Santos-Victor, “Abstracting Vehicle Shape and Kinematic Constraints from Obstacle Avoidance Methods”, 20(1) Autonomous Robots 43-59 (2006) (“Minguez”)
1006	O. Khatib, “Real-Time Obstacle Avoidance For Manipulators and Mobile Robots,” 5 Int’l J. of Robotics Research 90–98 (1986) (“Khatib”)
1007	J.A. Castellanos, J. Montiel, J. Neira, J.D Tardos, “The SPmap: A probabilistic framework for simultaneous localization and map building,” 15(5) IEEE Trans. Robotics and Automation 948–952 (1999) (“Castellanos”)
1008	Declaration of Dr. Mary K. Bolin
1009	Maki K. Habib, “Real Time Mapping and Dynamic Navigation for Mobile Robots,” 4(3) Int’l J. of Advanced Robotic Systems 323 (2007) (“Habib”)
1010	Chang, Ya-Chun, Yamamoto, Yoshio, On-line path planning strategy integrated with collision and dead-lock voidance schemes for wheeled mobile robot in indoor environments, Industrial Robot, An International Journal 35(5) 421-34 (2008) (“Yamamoto”)
1011	Oussama Khatib et al., “Robots in Human Environments: Basic Autonomous Capabilities”, 18(7) International Journal Of Robotics Research 684-696 (1999) (“Khatib ’99”)
1012	Choset et al., “Principles of Robotic Motion Theory, Algorithms, and Implementation”, Massachusetts Institute of Technology Press (2005) (“Choset”)
1013	International Organization for Standardization, “Robots and robotic devices — Safety requirements for personal care robots” 13482 First Edition (2014)

*Brief Opposing Discretionary Denial
of IPR of U.S. Patent No. 10,379,539*

Exhibit	Description
1014	Plaintiff Brain Corporation’s Objections And Responses To Defendants’ First Set Of Interrogatories (NOS. 1–9) (Redacted Excerpt)
1015	J. Scholz, S. Chitta, B. Marthi and M. Likhachev, “Cart pushing with a mobile manipulation system: Towards navigation with moveable objects,” IEEE International Conference on Robotics and Automation 6115-6120 (2011)
1016	<i>Joint Development and License Agreement</i> , Brain Corp and Third-Party OEM (BRAIN_0004188) (sealed)
1017	<i>14/208,709 Documents & transaction history</i> , Patent Center – USPTO (last visited Mar. 2, 2026)
1018	<i>Brain Corp. v. Avidbots Corp. et al.</i> , Case No. 1:24-cv-12569, Dkt. 126 (N.D. Ill. Jan. 21, 2026)
1019	Plaintiff Brain Corporation’s First Supplemental Objections and Response to Defendants’ Third Set of Interrogatories (No. 20) (redacted) (Nov. 21, 2025) (sealed)
1020	<i>Brain Corp. v. Avidbots Corp. et al.</i> , Case No. 1:24-cv-12569, Dkt. 138 (N.D. Ill. Feb. 4, 2026)
1021	<i>Janitorial Equipment and Supplies</i> , Freedonia (BRAIN_0228245) (sealed)
1022	Brain Email (BRAIN_0228244) (sealed)
1023	<i>Joint Development and License Agreement</i> , Brain Corp and Third-Party OEM (BRAIN_0003580) (sealed)
1024	<i>Joint Development and License Agreement</i> , Brain Corp and Third-Party OEM (BRAIN_0316136) (sealed)
1025	<i>Joint Development and License Agreement</i> , Brain Corp and Third-Party OEM (BRAIN_0003708) (sealed)
1026	<i>Brain Corp. v. Avidbots Corp. et al.</i> , Case No. 1:24-cv-12569, Dkt. 145 (N.D. Ill. Feb. 17, 2026)
1027	Board Meeting (BRAIN_0389368) (sealed)
1028	Brain Email (BRAIN_0013142) (sealed)

*Brief Opposing Discretionary Denial
of IPR of U.S. Patent No. 10,379,539*

Exhibit	Description
1029	<i>Docket Sheets Search: Courts: Illinois (all districts), Types of Document: Motion to Stay Pending Inter Partes Review, Results of Motion: Granted, DOCKETNAVIGATOR (Feb. 9, 2026)</i>
1030	<i>Docket Sheets Search: Courts: Illinois (all districts), Types of Document: Motion to Stay Pending Inter Partes Review, Results of Motion: Denied, Denied in part granted in part, Denied without prejudice, DOCKETNAVIGATOR (Feb. 9, 2026)</i>
1031	<i>Brain Corp. v. Avidbots Corp. et al., Case No. 1:24-cv-12569, Dkt. 40 (N.D. Ill. Jun. 5, 2025)</i>
1032	<i>Time to Milestones: Courts Illinois Northern District (all districts), Case Filing Date: On or After Jan. 1st, 2008, DOCKETNAVIGATOR (Feb. 1, 2026)</i>
1033	Defendant Avidbots’s Final Invalidity Contentions (excerpted and redacted to remove indication that it contains HC-AEO because the excerpted version does not contain HC-AEO information) (Jan. 14, 2026)
1034	Appl. No. 15/340,807, “Notification of loss of small entity status” (Feb. 25, 2026)
1035	Appl. No. 15/341,612, “Notification of loss of small entity status” (Feb. 25, 2026)
1036	Appl. No. 15/845,891, “Notification of loss of small entity status” (Feb. 25, 2026)
1037	Appl. No. 16/011,499, “Notification of loss of small entity status” (Feb. 25, 2026)
1038	Appl. No. 16/356,160, “Notification of loss of small entity status” (Feb. 25, 2026)
1039	Avidbots’s List of Proposed Claim Terms for Construction (Feb. 25, 2026)

TABLE OF ABBREVIATIONS

Abbreviation	Term
'499 Application	U.S. Patent Application No. 16/011,499
'539 Patent	U.S. Patent No. 10,379,539
Board	Patent Trial and Appeal Board
Challenged Claims	Claims 1–20 of U.S. Patent No. 10,379,539
Ex.	Exhibit
Fig.	Figure
IPR	<i>inter partes</i> review
Litigation	<i>Brain Corp. v. Avidbots Corp. et al.</i> , Case No. 1:24-cv-12569 (N.D. Ill.)
Patent Office	United States Patent and Trademark Office
Petitioners or Avidbots	Avidbots Corp. and Avidbots USA Corp.
POSITA	person of ordinary skill in the art

The Board should not exercise its discretion to deny this petition because the Patent Owner made deliberate, false, and unrepaired assertions of small entity status from the date of the application to the present. Given that the Patent Owner obtained the patent by paying reduced fees when it was not entitled to do so and given that Patent Owner made numerous false claims to small entity status, the equities do not favor a discretionary denial. Those who seek equity must come with clean hands. Patent Owner's request for the Board to exercise its discretion requires that it has played by all of the rules the Patent Office imposed and it clearly failed to do so. Holding otherwise would penalize those that have.

Moreover, the '539 patent is a weak patent that was allowed by Examiner error. The IPR process was designed to address this type of weak patent. The patent is directed to the use of simulated forces, which were well-known in the art since at least 1986. The Examiner allowed the patent with only a single rejection directed towards double-patenting, even though the Examiner acknowledged that "[t]here are inventions in the field that provide similar functionality and/or have similar features." Ex1002, 90–91. The Examiner never cited or distinguished any such invention, and instead granted a summary and erroneous allowance in view of a terminal disclaimer. Ex1002, 92, 118–19.

The other *Fintiv* factors also favor institution and weigh against denial on discretionary grounds. The Court presiding over the Litigation has not yet set a trial

date. Any trial is likely to occur more than one year after a Final Written Decision. The district court Litigation is at a stage where institution will result in an efficient outcome for all parties and for the court, because institution would come before claim construction (and thus before amended contentions and re-opening of discovery in view of claim construction under the local rules of the Northern District of Illinois where the Litigation is pending) and before opening expert reports. A stay is therefore likely to promote efficient resolution of the case.

Brain's claims of infringement are without merit, and its patents claim features that were well-known in the art.

I. BACKGROUND

Brain sued Avidbots in the Northern District of Illinois on December 6, 2024 (the "Litigation"). Brain alleges that Avidbots's floor-cleaning robots infringe five patents including the '539 patent, whose parent application was filed on November 2, 2016, and which issued on August 13, 2019.

The '539 patent is directed to the use of simulated "forces" that attract and repel the robot along the path to avoid obstacles. Pet., 1. This technique was known by 1986. Pet., 1; Ex1006. The Examiner acknowledged that there "are inventions in the field that provide similar functionality and/or have similar features, as the prior art of record shows," but did not cite or meaningfully examine any of these inventions. Ex1002, 92. Instead, the Examiner issued only a double-patenting

rejection, which was followed by a summary and erroneous allowance. Ex1002, 90–91, 118–19. This Petition identifies four grounds of invalidity based on references that were not before the Examiner.

Avidbots is a robotics company that first sold a floor-cleaning robot, the ARS-2, on October 23, 2015, more than one year before the effective filing date of the '539 patent, and more than one year before Brain sold its first robot. Ex1018, 30; Ex1001, 1. Avidbots filed counterclaims against Brain for infringement of five of Avidbots patents on May 19, 2025. Four of the five Avidbots patents claim priority to a Provisional Application filed April 24, 2015, more than one year before the effective filing date of the '539 patent.

Brain is a software company that licenses its patents and its software to floor-cleaner manufacturers (“OEMs”) to enable semi-autonomous floor cleaning. Ex2003, ¶14. Such OEMs include significant global companies and equipment manufacturers, such as Minuteman (a part of the German Hako group), Tennant, SoftBank Robotics, Nilfisk, and Kärcher. Ex1020, 4. Brain claims that it has applied for and received 240 patents, and that it marks each of the floor-cleaning robots it makes with its OEMs with about 100 Brain patents, and each including the '539 patent. Ex2003, ¶18; Ex2017. [REDACTED]

[REDACTED]

[REDACTED]

Brain signed this agreement days before it filed the '499 Application (which issued as the '539 patent) and falsely paid the filing fee based on a claim to small entity status. Ex1001, 1; Ex1002, 73. Brain has continued to pay small entity fees through August 2, 2023, when it paid its 3.5-year maintenance fee. Ex1037. Similarly, Brian claimed small entity status for each of the other Asserted Patents (recently paying a 7.5-year maintenance fee associated with Patent No. 10,000,780 on December 9, 2025), yet it is not entitled to do so and has not been entitled to do so for nearly a decade at least. Brain filed a notice of loss of small entity status with respect to the five patents it asserts in the Litigation only *after* Avidbots brought Brain's misconduct to the Office's attention. And yet Brain *still* claims small entity status for the other approximately 95 patents with which it marks its inventions. This type of extensive fraud on the Patent Office should not be encouraged by awarding this Patent Owner a Discretionary Denial.

II. ARGUMENT

A. Brain Cannot Have Settled Expectations in a Patent After Deliberately Withholding Fees Owed to the Office Since the Filing of the Patent's Parent Application

Brain deliberately and falsely claimed small entity status from the day it first submitted the Parent Application to the '539 patent, through its most recent maintenance fee payment on August 2, 2023. Ex1037. Brain has not been eligible for Small Entity status since at least October 25, 2016, just days before it submitted

the Parent Application to the '539 patent, when it licensed its patent applications, patents and technology to Minuteman International. [REDACTED]; Ex1020, 22. Brain, its CEO, and its officers, one of whom was an inventor on the '539 Patent, knew then and knows now that Minuteman has had about 2,000 employees for the duration of the license agreement, from October 25, 2016, to the present. Avidbots brought this to Brain's attention in its January 14, 2026, contentions, and, Brain did not take any action to attempt to cure its false statements or to pay what it owes until after Avidbots raised Brain's misconduct before this Office. Brain cannot have settled expectations in its patent when it has deliberately withheld from the Office the fees required to be paid to obtain that patent.

Brain cannot deny that it licensed its patents, including the '539 patent, to a non-small entity, and is therefore ineligible for small entity status. Indeed, Brain has taken the position in the Litigation that its agreements with its OEMs include licenses to the Asserted Patents, to include the '539 patent. For example, in its Answer to Avidbots's Amended Counterclaims, it said, "Brain admits that it provides its OEM Partners certain license rights to the Asserted Patents." Ex1020, 22. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] According to its patent marking website, Brain considers the Minuteman RoboScrub to be an embodying product of the '539 patent, and indeed of each of the other Asserted Patents. Ex2017. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Indeed, Brain touted its relationship with Minuteman in a press release dated October 18, 2016, and described Minuteman as “a wholly owned subsidiary of the Hako Group, a \$750 million multi-national equipment manufacturer.” *Brain Corp’s Artificial*

Intelligence Software Announced for Use in Minuteman Products (Oct. 18, 2016),

<https://www.braincorp.com/resources/brain-corps-artificial-intelligence-software-announced-for-use-in-minuteman-products-4e948>. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] By “licens[ing] certain rights” in the ’539 patent to Minuteman, Brain was no longer qualified to obtain the benefit of the discounted rates that it paid in the prosecution, issuance, and maintenance of the ’576 patent.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Brain's conduct in the two months since Avidbots served its invalidity contentions confirms that Brain is deliberately withholding fees even though it knows that it is not eligible for small-entity discounts. In its Motion for Discretionary Denial of IPR of another patent which Brain asserted against Avidbots, Brain claimed that it is "investigating" whether Brain is eligible for small entity status, and will "promptly" pay what it owes. IPR2025-01602, Paper 8, 17 (Feb. 11, 2026). Brain filed a "Notice of loss of entitlement to small entity status" for each of the patents asserted in the Litigation on February 25, 2026, and authorized the Director to charge the deficiency for each transaction for these patents since November 1, 2016. Ex1034, Ex1035, Ex1036, Ex1037, Ex1038. In these filings, Brain swore that "small entity status is no longer appropriate in this application or patent," and, by paying fees dating to November 1, 2016, agreed with Avidbots's position that it has not been entitled to claim small entity fees since that date. *See, e.g.,* Ex1037, 1. Brain has not, however, authorized the Director to

reclaim Brain's deficient fees for the approximately 95 other patents with which Brain marks its cleaning robots, even though the same licenses apply with equal force to those patents. *See, e.g.*, Ex2017 (marking each cleaning robot with approximately 100 patents, including, *e.g.*, Patent No. 9,987,743); Ex1017, 1 (showing that Brain paid small entity fees during the prosecution of Patent No. 9,987,743 through its recent 7.5-year maintenance payment, and has not filed a notice of loss of entitlement to small entity status for that patent). Thus, even though Brain acknowledges that its licenses with its OEMs requires it to pay the full fee for prosecution of patents necessary to operate its floor cleaners since at least November 1, 2016, it continues to refuse to pay the full fee associated with *each* of the approximately 100 patents that are the subject of its agreements with its OEMs.

Brain has systematically, deliberately, and falsely claimed small entity status for its entire portfolio for a decade. Brain authorized payment of the \$24,839 deficiency associated with the patents asserted in the Litigation only after Avidbots notified the Office regarding these specific patents, weeks after Brain itself had affirmative notice. These patents represent only 5% of the issued patents with which Brain marks its floor-cleaning robots; the remaining 95% are also covered by the same licenses. Brain has not taken any steps to repair the deficiencies associated with these other patents. Brain therefore continues to withhold Office hundreds of thousands of dollars in fees from the Office. "When entities ineligible for the small

or micro entity status fee reductions pay fees in an unentitled reduced amount, they take improper advantage of the fees paid by other entities.” *Statutory Penalties for False Assertions or Certifications of Small and Micro Entity Status*, 1536 OG 204, at *1–2 (Jul. 8, 2025). Having knowingly withheld fees at expense of the Office and of other entities, Brain cannot now have settled expectations in the validity of its patents.

B. Each *Fintiv* Factor is Either Neutral or Weighs Towards Institution

1. A Stay is Likely to Issue if the Petition is Instituted

In the Northern District of Illinois, where the Litigation is pending, courts commonly grant stays after institution is granted, after denying a pre-institution motion in the first instance. *See, e.g., Medline Industries, Inc. v. CR Bard, Inc.*, 1-17-cv-07216 (N.D. Ill. Sep. 10, 2019); *Ellenby Technologies, Inc. v. FireKing Security Group et al*, 1-20-cv-02253 (N.D. Ill. Sep. 1, 2021). The Local Patent Rules require that a defendant file a motion for a stay pending IPR prior to service of final contentions, or else waive the right to a stay. Ex2005, 11. That first motion may be denied without prejudice, in view of the uncertainty of institution, where a subsequent motion after institution may be granted. *Compare, e.g., Medline Industries, Inc. v. CR Bard, Inc.*, 1-17-cv-07216 (N.D. Ill. Dec. 17, 2018); *Medline Industries, Inc. v. CR Bard, Inc.*, 1-17-cv-07216 (N.D. Ill. Sep. 10, 2019). In the Litigation, the Avidbots moved for a stay and the Court denied Avidbots’s motion,

without prejudice. Ex2023. Moreover, DocketNavigator shows that, including denials of stay later granted (as in *Medline*) the Northern District of Illinois grants motions to stay pending IPR at a rate of 72%. Ex1029 (showing 94 grants of motions to stay); Ex1030 (showing 36 denials of motions to stay). In view of the Local Rules and precedent, the likelihood of a stay weighs towards institution.

2. The Court Declined to Set a Trial Date, and a Trial is Likely to Occur More Than One Year After a Final Written Decision

In the Litigation, the Court declined Brain's request that the Court set a date for the trial, and indeed for any date past submission of the parties' claim construction briefs on May 20, 2026, rejecting Brain's "estimate[d]" calendar. Ex1031; Mot. 10. In doing so, the Court agreed with Avidbots's argument it is unknown when a claim construction order will issue and whether fact discovery will need to be reopened based on that order. Ex2006, 13. Accordingly, there is no scheduled trial date.

Moreover, any trial is likely to occur after a Final Written Decision (FWD) in the IPR, which will issue on or before May 19, 2027. According to DocketNavigator, the median time to claim construction from the date of filing in the Northern District of Illinois is 26 months, and the median time to a jury trial is 50 months, two years after claim construction. Ex1032. Thus, even if the Court rules on claim construction within a few weeks of a June 17, 2026, hearing, as Brain

apparently assumes (Mot., 8–10), District statistics indicate a trial is still not likely to occur until July of 2028, more than one year after the FWD. Ex1032. Thus, this factor weighs towards institution.

3. Lack of Investment in the Litigation Weighs Towards Institution

The Litigation is still in its opening phases and will not have advanced substantially by the time of institution. Claim construction briefing is not scheduled to complete until May 20, after the May 19 date by which the Board is expected to make an institution decision.

Further, the Northern District of Illinois Local Rules allow contentions to be amended and discovery reopened in view of a claim construction different than that sought by either party. Ex2005, 11. Because the Litigation consists of five Brain patents asserted against Avidbots, and five Avidbots patents asserted against Brain, the Court has agreed to hear double the number of disputed claim terms as would normally be permitted. Ex2006, 3; Ex1031. Given the complexity of the case, it is likely that at least one ruling on a disputed term will cause parties' Final Contentions to be amended and discovery to be reopened.

Further, the deadline for serving opening expert reports is keyed off the later of the Court's claim construction ruling or the close of discovery after the claim construction ruling. Thus, opening expert reports are likely to be due months after an institution decision in this IPR, at the earliest.

The statistics Brain cites reinforce that, contrary to Brain’s assertion, parties have not “completed the bulk of discovery,” when considered in context of the parties’ discovery agreement. Mot., 11. For example, Brain says that parties have together served “40 interrogatories,” but does not mention that the parties have a limit of 40 interrogatories *per side*, for a total of 80 interrogatories. Mot., 11; Ex2006, 3.¹ Similarly, Brain says that parties have collectively taken “over 65 hours of depositions,” but does not mention that parties have a limit of 100 hours per side, for a total of 200 hours. Mot., 11; Ex2006, 3.²

In short, document and witness discovery is at a midpoint, claim construction has not yet occurred, and expert discovery is not yet underway. Institution would

¹ In its Motion requesting Discretionary Denial of another petition, Brain incorrectly predicted that the Litigation Court was likely to reject Avidbots’s request for additional depositions. IPR2025-1602, Paper 8, 11 n.1 (Feb. 11, 2026). Instead, the Court permitted Avidbots to serve additional 30(b)(6) topics and seek additional testimony. Ex1026.

² Brain also references “significant third-party discovery,” but did not explain that most third-party discovery (including all depositions) related to Avidbots’s claims against Brain for infringement of Avidbots’s patents, not Brain’s patents or claims. Mot., 5, 11.

allow the Court to pause the Litigation, including claim construction and further discovery, while specialized Patent Judges consider the validity of Brain's patents. The lack of investment of the parties in the Litigation therefore weighs towards institution.

4. Lack of Overlap Between Cases Weighs Towards Institution

To the extent that there is any overlap between the Petition and the Litigation, a Final Written Decision is likely to dispose of a significant portion of the case. In its January 14, 2026 Contentions, Avidbots raises five prior art invalidity grounds against the '539 patent, four of which are identical to grounds presented in the Petition. Ex1033, 5. A Final Written Decision would therefore moot four of the five prior-art invalidity grounds asserted against the '539 patent. 35 U.S.C. § 315(e)(2).

The fifth prior-art invalidity ground concerns Avidbots's own system prior art. Avidbots brought its products to market before Brain filed the parent Application to the '539 patent, yet the features Brain now accuses of infringing its '539 patent were present in Avidbots's own prior art systems. Ex1033, 2 n.6. Avidbots asserts its own system prior art in combination with several background publications raised in the Petition to give context to its systems and thereby show that the '539 patent would have been obvious in view of Avidbots's systems and what was well-known in the prior art. This ground therefore does not overlap substantially with the Petition.

Further, Avidbots challenges all 20 claims of the '539 patent in its Petition, whereas Brain has only asserted that Avidbots infringes four claims (1, 3, 4, and 6). Pet., 3; Ex1033, 5. The validity of the other 16 claims are not within the scope of the Litigation.

The lack of overlap between the IPR and the Litigation therefore weighs towards institution.

5. The Identity of the Parties is Neutral Relative to Institution

The Office routinely grants institution where parties are the same between the Litigation and the IPR, including under the Discretionary Review process. *See, e.g., Terumo BCT, Inc. v. Haemonetics Corp.*, IPR2025-01374, Paper 13 (Dec. 11, 2025). Brain has not pointed to any other factor related to the identity of the parties, such as “a prior verdict of no invalidity” in the Litigation, that would weigh against institution—indeed it cannot. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 14 n.27 (Mar. 20, 2020 (*citing Stryker Corp. v. KFx Med., LLC*, IPR2019-00817, Paper 10 (Sep. 16, 2019))). This factor is therefore neutral relative to institution.

6. Other Considerations Weigh Towards Institution

Brain deliberately withheld payment of fees from the Patent Office for nearly ten years during the prosecution and maintenance of the '539 patents. § III.A, *supra*. In doing so, Brain took “improper advantage of the fees paid by other entities.” *Statutory Penalties for False Assertions or Certifications of Small and Micro Entity*

Status, 1536 OG 204, at *1 (Jul. 8, 2025). Other considerations therefore weigh towards institution on this basis alone.

Each of the other considerations Brain cites weigh towards institution.

For example, Brain argues that it has settled expectations in the challenged patent because it issued just over six years prior to filing the Petition, but neglects to inform the Office that it has withheld fees from the Office since 2016. *Mot.*, 15.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Settled expectations therefore weigh towards institution, even in view of the parties' competitive relationship.

The Director should not credit Brain's bare assertion that the grounds are weak for failure to point out where the reference disclose forces computed against a "plurality of points disposed therein." Mot., 16. Indeed, the Petition distinctly points out where this limitation may be found in the asserted grounds. *See, e.g.,* Pet., 34. Brain reserves the remainder of its argument regarding the merits of the Petition to its POPR, and Avidbots likewise reserves the right to respond to the POPR. The strength of the Petition therefore weights towards institution.

Avidbots is not seeking different claim constructions in the Litigation compared to the IPR, nor is it seeking a construction of indefiniteness for any claim term among the patents that Brain asserted in the Litigation, contrary to Brain's claim. Ex1039, 1–2; Mot., 17. Parties exchanged proposed claim terms on February 25, 2026. For the '539 Patent, Avidbots only proposes that the preamble for independent claim 1 and its dependents is limiting, at least because it provides antecedent basis for the limitations of the claims. Ex1039, 1. The Petition shows that the references meet this limitation. Pet., 17–23, 78–79. There is therefore no inconsistency between the Petition and the Avidbots's position in the Litigation, and this consideration likewise weighs towards institution.

The district court will not be a more efficient forum to resolve the parties' dispute concerning the validity of the '539 patent. The PTAB is an expert forum experienced in adjudicating patent validity in a "streamlined administrative

proceeding.” *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1376 (Fed. Cir. 2022).

Brain’s argument that the PTAB will not be able to evaluate the credibility of Petitioner’s expert declarants should be afforded little weight, in view of the PTAB’s long experience adjudicating such disputes. Similarly, the Director should not credit Brain’s assertion that adjudication will “involve detailed discussion of objective indicia of nonobviousness,” where the Brain has not presented any evidence of such indicia with respect to any particular claim, whether here or in the Litigation. Pet., 113. Furthermore, consideration of all claims of the ’539 patent at once before a panel of experts will be more efficient than piecemeal litigation from multiple defendants over the remaining lifespan of the ’539 patent. Efficiency therefore weighs towards institution.

Brain argues that compelling economic or national security interests warrant denial because Avidbots is based in Canada, but Brain did not identify any evidence that floor-cleaning robots are a matter of national concern, nor any authority showing that the IPR process is meant to discriminate against foreign Petitioners. Indeed, the Patent Office has recently instituted several Petitions from foreign companies. *See, e.g., Samsung Elecs. Co., Ltd. v. Wilus Inst. of Standards and Tech. Inc.*, IPR2025-00988 Paper 15 (Feb. 6, 2026). Moreover, to the extent that Brain claims foreign manufacture and importation is relevant to discretionary denial, Brain neglected to inform the Director that it licenses its patents to SoftBank, a large foreign company,

for the Whiz, which is manufactured abroad and imported into the United States. Compelling economic or national security interests therefore weigh towards institution.

Finally, Avidbots denies Brain's baseless accusation that it "engineered the timing of its IPR petition to obtain the benefit of duplicative challenges." Mot., 20. Avidbots filed the Petition when it was ready and filed for a stay in District Court (which Brain opposed) to avoid duplicative proceedings. Should institution be granted, Avidbots will again seek a stay to avoid duplicative proceedings. *See* § III.B.1.

Accordingly, each additional consideration weighs toward institution and against discretionary denial.

III. CONCLUSION

Avidbots respectfully requests that the Director refer the Petition to a panel of the Board for a preliminary review of the merits.

*Brief Opposing Discretionary Denial
of IPR of U.S. Patent No. 10,379,539*

DATED: March 4, 2026

Respectfully Submitted,

/Brian M. Buroker/

Brian M. Buroker (Reg. No. 39,125)
GIBSON, DUNN & CRUTCHER LLP
1700 M Street, NW
Washington, DC 20036
Phone: (202) 955-8500
Fax: (202) 467-0539
Email: bburoker@gibsondunn.com

*Attorney for Petitioners Avidbots Corp. and
Avidbots USA Corp.*

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that a complete copy of Petitioner's Brief Opposing Discretionary Denial was served on the Patent Owner via email to the following addresses of record as indicated in its Mandatory Notices:

Daniel P. Hughes
2DPH@knobbe.com
Adam Powell
2ABP@knobbe.com
Sheila N. Swaroop
2SNS@knobbe.com
Daniel C. Kiang
2DCK@knobbe.com

DATED: March 4, 2026

Respectfully Submitted,

/Brian M. Buroker/
Brian M. Buroker (Reg. No. 39,125)

*Attorney for Petitioners Avidbots
Corp. and Avidbots USA Corp.*