

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN AIRLINES, INC. and SOUTHWEST AIRLINES CO.,
Petitioners,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

IPR2026-00043
U.S. Patent No. 7,721,282

**PETITIONERS' BRIEF IN OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

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PETITIONERS' LIST OF EXHIBITS

Exhibit No.	Description of Document
1001	U.S. Patent No. 7,721,282
1002	Prosecution File History of U.S. Patent No. 7,721,282 (Application No. 11/395,816)
1003	Expert Declaration of Erez Zadok, Ph.D.
1004	Erez Zadok, Ph.D. Curriculum Vitae
1005	U.S. Patent No. 7,089,300, entitled "Method and Apparatus for Administering the Operating System of a Net-Booted Environment," filed on October 18, 1999, and issued on August 8, 2006 to Cameron Stuart Birse, et al. ("Birse")
1006	U.S. Patent Application Publication No. 2005/0235092, entitled "High Performance Computing System and Method," filed on April 15, 2004, and published on October 20, 2005 to James D. Ballew, et al. ("Ballew")
1007	U.S. Patent No. 6,981,114, entitled "Snapshot Reconstruction From An Existing Snapshot and One or More Modification Logs," filed on October 16, 2002, and issued on December 27, 2005 to Weibao Wu, et al. ("Wu")
1008	U.S. Patent Application Publication No. 2003/0191911, entitled "Using Disassociated Images for Computer and Storage Resource Management," filed on April 2, 2003, and published on October 9, 2003 to Donald Kleinschnitz, Jr., et al. ("Kleinschnitz")
1009	File History for U.S. Patent Application No. 11/026,622 (the "'622 Application", now abandoned)
1010	Claim Listing
1011	Microsoft Computer Dictionary, 3rd ed., 1997, excerpts ("Microsoft Computer Dictionary")
1012	Internet Small Computer Systems Interface (iSCSI), RFC 3720, IETF,

Exhibit No.	Description of Document
	April 2004, https://www.rfc-editor.org/rfc/pdf/rfc3720.txt.pdf
1013	File System Design for an NFS File Server Appliance, Dave Hitz et al., Network Appliance, USENIX 1994 (“Hitz”)
1014	SnapMirror: File System Based Asynchronous Mirroring for Disaster Recovery, Hugo Patterson et al., Network Appliance, USENIX 2002 (“Patterson I”)
1015	U.S. Patent 6,668,264B1 to Patterson et al., Filed Apr. 3, 2001, Issued Dec. 23, 2003, titled “Resynchronization of a target volume with a source volume” (“Patterson II”)
1016	U.S. Patent 7,334,095B1 to Fair et al. Filed Apr. 30, 2004 (“Fair”)
1017	U.S. Patent 8,209,680B1 to Le et al., Filed June 30, 2003, Issued June 26, 2012, titled “System and method for disk imaging on diverse computers” (“Le”)
1018	Complaint, <i>Intellectual Ventures I LLC et al. v. Southwest Airlines Co.</i> , No. 7:24-cv-00277 (W.D. Tex. Nov. 2, 2024) [Dkt. 1]
1019	Complaint, <i>Intellectual Ventures I LLC et al. v. American Airlines, Inc.</i> , No. 4:24-cv-980-ALM (E.D. Tex. Nov. 2, 2024) [Dkt. 1]
1020	Second Amended Complaint (redacted), <i>Intellectual Ventures I LLC et al. v. Southwest Airlines Co.</i> , No. 7:24-cv-277 (W.D. Tex. Sept. 10, 2025) (Dkt. 67)
1021	Amended Complaint, <i>Intellectual Ventures I LLC et al. v. American Airlines, Inc.</i> , No. 4:24-cv-980 (E.D. Tex. Aug. 25, 2025) [Dkt. 76]
1022	Complaint, <i>Intellectual Ventures I LLC et al. v. American Airlines, Inc.</i> , No. 4:25-cv-00576-ALM (E.D. Tex. May 30, 2025)
1023	IV’s Claim Chart re the ’282 patent in <i>Intellectual Ventures I LLC et al. v. American Airlines, Inc.</i> , No. 4:25-cv-576-ALM (E.D. Tex. May 30, 2025).

Exhibit No.	Description of Document
1024	IV's Claim Chart re the '282 patent in <i>Intellectual Ventures I LLC et al. v. Southwest Airlines Co.</i> , No. 7:24-cv-277-ALM (W.D. Tex. Nov. 2, 2024).
1025	Defendant Southwest Airlines Co.'s Opening Claim Construction Brief in <i>Intellectual Ventures I LLC et al. v. Southwest Airlines Co.</i> , No. 7:24-cv-277-ALM (W.D. Tex. Nov. 2, 2024).
1026	Scheduling Order in <i>Intellectual Ventures I LLC et al. v. American Airlines, Inc.</i> , No. 4:24-cv-980-ALM (E.D. Tex. Nov. 2, 2024).
1027	Notice of Transfer to Northern District of Texas in <i>Intellectual Ventures I LLC et al. v. Southwest Airlines Co.</i> , No. 7:24-cv-277-ALM (W.D. Tex. Nov. 2, 2024).

I. INTRODUCTION

The '282 Patent's validity should be resolved by the PTAB ("the Board"), not in court. The '282 Patent has clear validity issues that are explained by the Petition—the merits of which Patent Owner does not contend with. Moreover, Patent Owner asserts the '282 Patent as part of a multi-district litigation campaign involving twelve patents from ten different families (collectively the "Parallel Litigations"). This proceeding, if instituted, will save significant resources and resolve validity without the need for multiple trials by multiple district courts (the Northern and Eastern Districts of Texas, collectively the "District Courts").

The three arguments in Patent Owner's brief fail to justify discretionary denial. Patent Owner first attempts to argue that, due to previous institution decisions concerning six other patents asserted in the Parallel Litigations, the District Courts "are better suited to review the validity of the remaining patents." PO Request at 1-3, 5-8. This argument is not persuasive. There are still six patents in the Parallel Litigations whose validity has not been considered by the Board, with four pending petitions and two yet to be filed. The solution for the already-overburdened courts in the Parallel Litigations is not to heap another six patents on top of the six for which institution has been denied—that outcome would only exacerbate the challenge of resolving both invalidity and infringement in the District Courts on twelve patents.

Patent Owner also argues that Petitioner Southwest pursues inconsistent claim construction positions before the District Court and this proceeding. PO Request at 3-4, 8-12. But this argument is unavailing, as Patent Owner relies on Petitioner Southwest’s *Preliminary* Invalidity Contentions while ignoring Southwest’s subsequent Opening Claim Construction Brief. Further, the constructions proposed in the District Court case are consistent with the arguments and art provided in the Petition. There is no risk of inconsistent claim construction positions between the Parallel Litigations and this proceeding.

Patent Owner further argues that the fact that the ’282 Patent issued over 15 years ago gives rise to “settled expectations” which favors discretionary denial. PO Request at 4, 12-16. Although Patent Owner may have included the ’282 Patent in its portfolio-wide licenses, there is no evidence that Patent Owner ever licensed the ’282 Patent, either directly or through a portfolio-wide license, *to an airline*. Indeed, the ’282 Patent is a software patent that does not concern avionics or aviation generally. Thus, the fact that the ’282 Patent may have been in force for years but has not been commercialized, asserted, marked, licensed, or otherwise applied in petitioner’s particular technology space—airlines—is a “persuasive reason” why the Board should review challenged claims several years after their issuance. *Intel Corp. v. Proxsense, LLC*, IPR2025-00327, Paper 12 (PTAB June 26, 2025).

Finally, though Patent Owner’s request for discretionary denial is silent with respect to *Fintiv*, that analysis counsels in favor of institution. Trial is not yet set in either of the Parallel Litigations, and an institution decision will predate any significant expenditure in adjudicating the validity and infringement of the ’282 Patent.

Thus, the number and range of the patents asserted in the Parallel Litigations, the lack of inconsistent arguments between the Parallel Litigations and this proceeding, and *Fintiv* all counsel that discretionary denial is inappropriate here. The Petition should be instituted because its arguments against the ’282 Patent are strong, and the Board is best positioned to efficiently resolve validity given the existing strain on the District Courts. Petitioners respectfully request that the Board review the merits of the Petition and institute trial.

II. THE DIRECTOR SHOULD ALLOW THE PETITION TO PROCEED ON THE MERITS

A. The Board is best suited to review this patent because of the breadth of the twelve patents asserted in the Parallel Litigations.

“The large number and vast scope of the patents asserted” in the Parallel Litigations weighs against discretionary denial. *Shenzen Tuozhu Tech. Co., Ltd. v. Stratasy, Inc.*, IPR2025-00438, Paper 10 at 3 (Director July 17, 2025) (“*Stratasy*”). Contrary to Patent Owner’s arguments, the Board declining to institute the earlier petitions does not alter this rationale, it strengthens it—there are

still twelve patents at issue in the Parallel Litigations, and this proceeding, if instituted, *will* lighten the District Courts' loads in the Parallel Litigations.

The '282 Patent is one of twelve different patents (from ten different families) with a diverse range of subject matter asserted in the Parallel Litigations. This fact led the Director to decline Patent Owner's earlier requests for discretionary denial. *E.g.*, Exs. 2001, 2002, and 2003. It should do so here as well. Patent Owner is wrong that the Board's denial of institution in the earlier proceedings now strengthens its case for discretionary denial. If anything, those earlier denials only reinforce the need for the Board to review the '282 Patent's validity, as it is now clear that the District Courts will adjudicate the validity and infringement of a large number of unrelated patents, *i.e.*, the six patents for which discretionary denial was denied but for which the Board denied institution. The Board can prevent that burden from growing even larger by instituting the Petition and resolving the '282 Patent's validity outside of the Parallel Litigations.

Patent Owner's argument that "no results by the Board in the four remaining IPRs will avoid the need for the District Courts to address the validity of patents spanning a 'diverse range of subject matter'" defies common sense. PO Request at 7. It would only exacerbate the judicial-economy problem faced by the District Courts if additional patents in the Parallel Litigations were left for their adjudication. Further waste and inefficiency can be avoided by having a

specialized tribunal—the Board—review the '282 Patent's validity. Doing so would undeniably lessen the load on the already-overburdened District Courts in the Parallel Litigations.

This point is especially salient given the '282 Patent's unique subject matter when compared to the other 11 patents at issue in the Parallel Litigations. The '282 Patent is only one of two patents in the Parallel Litigations to concern distributing application environments, the other being U.S. Patent No. 8,332,844. However, the aspects of distributing application environments addressed by each of these two patents are significantly different from each other, as demonstrated by their respective claims and by the classifications assigned to each by the Patent Office:

<u>Patent</u>	<u>Classification</u>	<u>Exemplary Claim</u>
7,721,282	<p>(51) Int. Cl. G06F 9/445 (2006.01) G06F 9/44 (2006.01)</p> <p>(52) U.S. Cl. 717/176; 717/175; 709/203</p> <p>(58) Field of Classification Search 717/172–177, 717/149; 709/203–204</p>	<p>“A system for distributing an application environment comprising:</p> <p>a compute node comprising a computer system;</p> <p>a first storage unit for storing blocks of a root image of the compute node,</p> <p>wherein the first storage unit comprises a first non-volatile memory, wherein the root image comprises a computer program, wherein the blocks comprise sections of data, and wherein a file of the root image comprises at least one block;</p>

<u>Patent</u>	<u>Classification</u>	<u>Exemplary Claim</u>
		<p>a second storage unit for storing a leaf image, the leaf image comprising new data blocks and changes to the blocks of the root image, wherein the second storage unit comprises a second non-volatile memory; and</p> <p>a union block device for interfacing between the compute node and the first and second storage units to distribute the application environment to the compute node, wherein the union block device comprises a driver,</p> <p>wherein the union block device creates the application environment by merging the blocks of the root image stored on the first storage unit with the blocks of the leaf image stored on the second storage unit;</p> <p>the union block device comprises a low-level driver for interfacing between the first and second storage units and the file system of the compute node;</p> <p>and the union block device, upon receiving a write request from the compute node for a sector X, creates an appropriate persistent mapping for sector X.”</p>
8,332,844	(51) Int. Cl. <i>G06F 9/445</i> (2006.01) (52) U.S. Cl. 717/176 (58) Field of Classification Search 345/557; 717/176	“A system for providing data to a plurality of compute nodes, the system comprising:”

<u>Patent</u>	<u>Classification</u>	<u>Exemplary Claim</u>
		<p>a first storage unit configured to store blocks of a root image of said compute nodes;</p> <p>a plurality of second storage units configured to store leaf images of respective compute nodes, said leaf images including only additional data blocks not previously contained in said root image and changes made by respective compute nodes to the blocks of said root image, wherein said leaf images of respective compute nodes do not include blocks of said root image that are unchanged by respective compute nodes; and</p> <p>a cache configured to cache blocks of said root image previously accessed by at least one of said compute nodes.”</p>

The '282 Patent's unique stature in the Parallel Litigations is obscured in Patent Owner's discretionary denial brief, which contains an inaccurate table that omits two of the patents in the Parallel Litigations and describes the subject matter of the remaining patents at such a high level of generality that the comparison between patents is meaningless. PO Request at 6. For example, Patent Owner incorrectly characterizes four of the patents at issue of being in the “technology area” of “distributed networking”—the '282 Patent, the '844 Patent, and two other patents (U.S. Patent Nos. 7,712,080 and 7,257,582). PO Request at 6-7. Unlike the

'282 Patent (and the '844 Patent), these two other patents are not directed to distributing application environments; instead, as demonstrated by their titles, these patents are directed to parallel processing methods. Indeed, Patent Owner asserts these two patents against a different software application (Spark) than it asserts for the '282 Patent (Docker). Exs. 1023, 1024. Thus, Patent Owner's argument that the subject matter areas of other patents in the Parallel Litigations encompass that of the '282 Patent is just not true.

Moreover, the '282 Patent is one of *six* patents asserted in the Parallel Litigations that has not yet reached an institution decision before the Board. This scenario reflects others in which the Board has declined to exercise its discretion to deny institution. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2-3 (Director June 13, 2025) (declining to discretionarily deny institution where *six* patents from a single litigation were before the Board). Thus, even setting aside the six previously decided institution decisions and the unique subject matter of the '282 Patent, the breadth and complexity that would be added to the Parallel Litigations from the patents where institution has not been denied would be reason enough for the Board not to discretionarily deny this Petition.

Lastly, any resolution of the '282 Patent's validity by the Board will save effort and expense in *two* district court proceedings. The cost-saving and efficiency associated with the Board reviewing this patent counsels that discretionary denial

is inappropriate here. *Harbor Freight Tools USA Inc. v. Champion Power Equipment, Inc.*, IPR2025-00805, Paper 20 at 2 (Director September 19, 2025) (declining to discretionarily deny review of a patent asserted in a thirteen-patent multi-district parallel litigation).

In sum, that IPR petitions concerning previous patents asserted in the Parallel Litigations were not instituted changes nothing with respect to Petitioners' arguments of efficiency and judicial economy. There remains an unworkably high number of patents for the District Courts to adjudicate, and six patents asserted in the Parallel Litigations have not reached institution decisions by the Board. Any review of the '282 Patent's validity will save resources in two different venues. On these facts, discretionary denial is not warranted.

B. There is no risk of inconsistent arguments before the district court proceedings and this proceeding that would disfavor institution.

Patent Owner claims discretionary denial is appropriate based on Petitioner Southwest's statements before the district court in its Preliminary Invalidity Contentions regarding indefiniteness which allegedly creates a failure "to present a consistent and legally sound claim construction" across the Parallel Litigations and this proceeding. PO Request at 9. There is no danger of inconsistent claim constructions between this proceeding and the Parallel Litigations, so this is not a valid basis for discretionary denial.

Southwest Airlines made the statements relied on by Patent Owner in its

Preliminary Invalidity Contentions. Ex. 2004. Highlighting the fact that its invalidity contentions were preliminary—and therefore not its final contentions—Southwest Airlines stated that it “reserve[s] the right to revise, amend, and/or supplement these indefiniteness contentions as part of the claim construction briefing process as provided for in the Court’s scheduling order.” *Id.* at 279. Consistent with the fact that its invalidity contentions are preliminary and consistent with Southwest’s reservation of rights, Southwest did ***not*** include any indefiniteness contentions in its Opening Claim Construction Brief in the district court case. *See* Ex. 1025 at 3-12. Although Southwest filed its Opening Claim Construction Brief on October 14, 2025, well-before Patent Owner filed its present Request, Patent Owner failed in its Request to appreciate the fact that Southwest did not include any indefiniteness arguments in its Opening Claim Construction Brief with respect to the ’282 Patent. *See* Ex. 1025 at 3-12.

Notably, the constructions presented in Southwest’s Opening Claim Construction Brief are consistent with how the elements of the claims are discussed in the Petition in this proceeding. First, the Petition indicates that the “analysis in Sections VI-X [of the Petition] establishes that the challenged claims are obvious under any reasonable interpretation under the *Phillips* standard.” Petition at 11-12. These sections of the Petition analyze the claim elements in a manner consistent with the District Court constructions.

Southwest's Opening Claim Construction Brief proposes that "root image" in Claims 1 and 15 of the '282 Patent is "a base image of the application environment operating at the block level below the file system" and that "leaf image" in Claims 1 and 15 is "a node-specific image of the application environment operating at the block level below the file system." Ex. 1025 at 5-9. The IPR Petition in this proceeding explains that the '282 Patent uses a "root image" stored in blocks on a first storage unit and containing data common to compute nodes, and that compute nodes also have access to a second storage unit that stores a leaf image. Petition at 7-8. The Petition further explains that the leaf images provide the blocks that have been changed by respective compute nodes, so that "[t]o the compute nodes 120a-n, it appears that they have access to their own version of the application environment." Petition at 7, 9. The Petition asserts that the prior art operates in the same manner using master/shared operating system images storing blocks common to all clients and shadow images that are node-specific images containing blocks changed by clients. Petition at 28-43. As further explained below, both the '282 Patent's and the prior art's root images and leaf images operate below the file system because both the '282 Patent and the prior art use low-level drivers ("union block devices" ("UBDs") in the '282 Patent and "block device drivers" in the prior art) to handle the root images and leaf images and distribute the application environment to compute nodes. Petition at 44-47.

Southwest's Opening Claim Construction Brief also proposes that "union block device" in Claims 1 and 15 of the '282 Patent is "drivers operating at the block level below the file system" and that "merging the blocks of said root image with the blocks of respective leaf images to create cohesive respective application environments" in Claim 15 is "combining the root image and the leaf image at the block level below the file system." Ex. 1025 at 9-12. These constructions are also consistent with the analysis in the IPR Petition of this proceeding. As also indicated above, the IPR Petition in this proceeding explains that the '282 Patent uses UBDs that operate as low-level drives below the file system to merge blocks of the root image and leaf image for respective compute nodes to distribute the application environment. Petition at 9-10. The Petition asserts that the prior art operates in the same manner using block device drivers that "dynamically merge" user modifications with the system environment and that "appear to the file system" as "device driver[s]," such that the file system "need not be aware of the particular mechanism used to coordinate user modifications." Petition at 44-51.

Therefore, there is thus no risk of inconsistent claim construction positions between the Parallel Litigations and this proceeding. Patent Owner's argument to the contrary should be disregarded.

C. A “Persuasive Reason” for the Board to Review is that the ’282 Patent Has Not Previously Been Asserted In Petitioners’ “Technology Space”—Airlines

Patent Owner further contends that the fact that the ’282 Patent has been in force for over 15 years demonstrates that the parties’ “settled expectations” weigh in favor of discretionary denial. PO Request at 12-15.

As stated in *Intel*, IPR2025-00327, Paper 12, a “persuasive reason” why the Board should review challenged claims several years after their issuance, occurs when, in cases like the present one, the patent has not been asserted in the petitioner’s particular technology space:

There may be persuasive reasons why the Board should review challenged claims several years after their issuance date As another example, a patent may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner’s particular technology space, if at all. These non-exclusive examples provide considerations that weigh against a patent owner’s claim of settled expectations and bears on the Director’s discretion.

Id. at 2-3.

Here, the Petitioners are American Airlines, Inc. and Southwest Airlines Co. Both Petitioners are airlines. As airlines, Petitioners are not in the business of systems for distributing application environments and therefore Petitioners are not in the technology space of the ’282 Patent.

As best understood by Petitioners, the '282 Patent, despite having been issued over 15 years ago, has *never* been “commercialized, asserted, marked, licensed, or otherwise applied” in the “airline” technology space until Patent Owner sued Petitioners in November 2024 in district courts in Texas. Petition at 1-2. Indeed, Patent Owner offers no facts that would show that the '282 Patent has been “commercialized, asserted, marked, licensed, or otherwise applied” in the “airline” technology space prior to Patent Owner’s district court actions against Petitioners on the '282 Patent. Instead, Patent Owner argues that it “negotiates primarily portfolio-wide licenses that license all of its patent rights (including rights under the '282 Patent) to each licensee” and therefore “the '282 Patent has been continuously and purposefully licensed in the very same technology space that is the subject of the infringement claims pending against Petitioners in the district courts.” PO Request at 14-15. Patent Owner has not shown that the '282 Patent has ever been licensed to an *airline*.

There is no evidence of the '282 Patent ever being “commercialized, asserted, marked, licensed, or otherwise applied” in Petitioners’ technology space—airlines. This weighs against Patent Owner’s claim of settled expectations. *See Stratasys*, IPR2025-00438, Paper 10 at 3 (Petitioner’s evidence that the challenged patents have never been “commercialized, asserted, marked, licensed,

or otherwise applied’ in Petitioner’s ‘particular technology space’ is evidence that ‘weighs against Patent Owner’s claim of strong settled expectations.”)

Setting aside the fact that Petitioners are airlines, the ’282 Patent laid dormant for years until November 2, 2023, when Patent Owner was assigned the ’282 Patent. Only then was the ’282 Patent asserted in *any* industry, much less the airline technology space. *See* Petition at 1-2. The current Patent Owner (Intellectual Ventures II LLC), therefore, cannot have had any “settled expectations,” but, rather, should have *expected* validity challenges in response to asserting a previously dormant patent.

These facts weigh against discretionary denial.

D. *Fintiv* favors institution.

1. Factor 1 (likelihood of a stay) is neutral.

The relevant inquiry into *Fintiv* Factor 1 is “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Apple, Inc. v. Fintiv, Inc.*, IPR2020-08019, Paper 15 at 12 (PTAB May 13, 2020) (informative) (“*Fintiv*”). Here, there is no indication from either court in the Parallel Litigations as to how it would rule on such a stay if a proceeding were instituted. Therefore, this factor does not weigh for or against denial. *Fintiv* at 12; *Sand Revolution II, LLC v. Continental Intermodal Grp.-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative) (“*Sand Revolution*”).

2. Factor 2 (proximity of the trial date) weighs against discretionary denial because a Final Written Decision will likely predate any trial.

The Board is set to issue its Final Written Decision on the '282 Patent by April 20, 2027. Further, trial is not yet set in either of the Parallel Litigations. Factor 2 accordingly weighs against discretionary denial. *Murata Mfg. Co., Ltd. v. Georgia Tech Research Corp.*, IPR2025-00384, Paper 13 at 2 (Director July 29, 2025).

3. Factor 3 (investment in the parallel proceeding) weighs against discretionary denial because institution would predate substantial investment in the Parallel Litigations.

Fintiv Factor 3 weighs strongly against discretionary denial because, on the likely date of the Board's institution decision, neither court in the Parallel Litigations is likely to have issued substantive orders related to the '282 Patent, and there will undoubtedly be substantial remaining investment in the merits of the parties' invalidity positions.¹ *Sand Revolution* at 10.

The institution decision is also certain to predate any adjudication in the Parallel Litigations of the '282 Patent's validity or infringement, as trial is not yet set in either of the Parallel Litigations. This IPR is by far the most efficient way to resolve the '282 Patent's validity going forward, so Factor 3 weighs strongly

¹ The Southwest case originally filed in the Western District of Texas has been transferred to the Northern District of Texas, resetting the schedule for the Southwest District Court case. Ex. 1027.

against discretionary denial.

4. Factor 4 (overlap between issues in the petition and parallel proceedings) weighs against discretionary denial because overlap between the proceedings is minimal.

Factor 4 weighs against discretionary denial because the Petition includes materially different arguments and evidence than what will be presented in the Parallel Litigations. *Sand Revolution* at 11-12. Specifically, the Petition addresses substantially more claims than are at issue in the Parallel Litigations, and, pursuant to *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020), Petitioners stipulated not to pursue any grounds in the Parallel Litigations that could have been raised in this proceeding. Petition at 5.

This proceeding would address materially different issues than the Parallel Litigations. In the Parallel Litigations, Patent Owner asserted sixteen claims of the '282 Patent (1, 4, 5, 8-10, 13, 15-17, 20, 21, 24-26, 29), so Petitioners would only seek review of those sixteen claims in that forum. Conversely, Petitioners seek review of all 30 claims of the '282 Patent in this proceeding, including the claims asserted in the Parallel Litigations. Petition at 1. This weighs against discretionary denial because this proceeding can resolve substantial validity issues that the Parallel Litigations cannot.

Moreover, Petitioners have stipulated to “not pursue in the District Court Litigation any ground raised or that could have been reasonably raised in an IPR,”

thereby eliminating any potential overlap between this proceeding and the Parallel Litigations. Petition at 5 (citing *Sotera*). Factor 4 weighs against denial. *Stratasys* at 3.

5. Factor 5 (identity of the parties) is neutral.

When the Petitioners are the same as the named defendants in the district court litigations, the Board has found that this factor adds “little if anything to the discretionary denial analysis.” *Aylo Freesites Ltd. f/k/a MG Freesites Ltd. v. WellcomeMat, LLC*, IPR2024-00710, Paper 13 at *17-18 (PTAB Sept. 5, 2024). As in *Aylo*, the fact that there is overlap between Petitioners and defendants in the Parallel Litigations adds little to the discretionary denial analysis here, so Factor 5 is neutral. *Id.* at 18.

* * *

Of the five *Fintiv* factors to be considered, Factors 2, 3, and 4 weigh against denial, and Factors 1 and 5 are neutral. The *Fintiv* analysis thus favors institution.

III. CONCLUSION

For the foregoing reasons, the Director should deny Patent Owner's Request for Discretionary Denial and thus allow the Petition to proceed on the merits.

Dated: January 20, 2026

Respectfully submitted,

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CERTIFICATE OF WORD COUNT UNDER 37 C.F.R. § 42.24(d)

The undersigned certifies that the word count of the foregoing PETITIONERS' RESPONSE TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL, excluding the table of contents, table of authorities, exhibit list, certificate of service, certificate of word count, and any appendix of exhibits or claim listing, is 3,991.

Dated: January 20, 2026

Respectfully submitted,

By: /Keith D. Harden/
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Registration No. 74,472

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that a copy of the foregoing PETITIONERS' BRIEF IN OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL and all exhibits identified therein were served on January 20, 2026 by email on the following counsel of record for Patent Owner:

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