

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACCELIGHT TECHNOLOGIES, INC.,

Petitioner,

v.

APPLIED OPTOELECTRONICS, INC.,

Patent Owner.

Case IPR2026-00093

Patent No. 9,523,826

**PATENT OWNER'S REQUEST TO DIRECTOR FOR DISCRETIONARY
DENIAL OF PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT 9,523,826**

**(Pursuant to Acting Director's Memorandum of March 26, 2025 and
Director's Memorandum of October 17, 2025)**

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EXHIBITS

Exhibit No.	Description
2001	Acting Director Stewart’s March 26, 2025 Memorandum entitled “Interim Processes for PTAB Workload Management”
2002	Director Squires’ October 17, 2025 Memorandum entitled “Director Institution of AIA Trial Proceedings”
2003	In IPR2025-00433 filed by Cambridge Industries USA, Inc.: Director’s Decision Granting Patent Owner’s Request for Discretionary Denial and Denying Institution of <i>Inter Partes</i> Review dated June 27, 2025
2004	In IPR2025-00433 filed by Cambridge Industries USA, Inc.: Director’s Decision denying Request for Rehearing dated August 21, 2025
2005	Petitioner's Invalidity Contentions in <i>Applied Optoelectronics, Inc. v. Accelight Technologies, Inc.</i> , case no. 4-24-cv-09041-HSG (N.D. CA) served on May 30, 2025
2006	District Court’s Scheduling Order in <i>Applied Optoelectronics, Inc. v. Accelight Technologies, Inc.</i> , case no. 4-24-cv-09041-HSG (N.D. CA) dated April 23, 2025
2007	District Court’s Order as Modified Granting Joint Administrative Motion to Stay Pending IPR Institution Decisions in <i>Applied Optoelectronics, Inc. v. Accelight Technologies, Inc.</i> , case no. 4-24-cv-09041-HSG (N.D. CA) dated October 9, 2025
2008	District Court’s Scheduling Order in <i>Applied Optoelectronics, Inc. v. Cambridge Industries, Inc.</i> , case no. 3:24-cv-01010JD (N.D. CA) dated August 8, 2024
2009	Director Squires’ November 17, 2025 Memorandum entitled “Voluntary Search Disclosure Declarations as a Favorable Factor in Institution Decisions”
2010	U.S. Court of Appeals for the Federal Circuit’s Order Denying Petition for Writ of Mandamus filed by Cambridge Industries USA, Inc. in IPR2025-00433 dated December 9, 2025

I. INTRODUCTION

This request is submitted by Patent Owner Applied Optoelectronics, Inc. (“AOI”) to the Director of the United States Patent and Trademark Office (“USPTO”) pursuant to the Acting Director’s March 26, 2025 Memorandum “Interim Processes for PTAB Workload Management” and the Director’s October 17, 2025 Memorandum “Director Institution of AIA Trial Proceedings” (collectively the “Memoranda,” Exhibits 2001 and 2002).

This is AOI’s separate brief, pursuant to the Memoranda, requesting a discretionary denial of the petition (the “Petition”) of Accelight Technologies, Inc. (“Petitioner” or “Accelight”) for an *inter partes* review (“IPR”) of U.S. Patent No. 9,523,826 (the “’826 Patent”, Exhibit 1001) entitled “Pluggable Optical Transceiver Module.”

The Director should exercise his discretion and deny the Petition for IPR in this case for the simple fact that the ’826 Patent has already been the subject of a different IPR petition which was discretionarily denied by the Acting Director on June 27, 2025, for which Director rehearing was then also denied on August 21, 2025, and for which a petition for writ of mandamus was denied by the Federal Circuit Court of Appeals. *See* Exhibits 2003, 2004, and 2010. In denying the prior IPR petition of the ’826 Patent, the then Acting Director found “Patent Owner’s settled expectations as to the [’826 Patent] are strong[] and discretionary denial is

appropriate as to these proceedings.” Exhibit 2003 at p. 3. However, the Acting Director also noted that “[a]lthough certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented.” *Id.*

Thus, for the above-mentioned reason as well as the further reasons set forth below, including without limitation, because there are settled expectations in this nine-year old patent, the Director should similarly exercise his discretion and deny this Petition for IPR for the same reasons as have already been found by the Acting Director and for which the Federal Circuit held did not justify mandamus relief.

II. FACTUAL BACKGROUND

A. The '826 Patent

Application no. 14/504,500 for the '826 Patent was filed on October 2, 2014. See “'826 Patent File History”, Exhibit 1002. (Please see Exhibit 1002 for the full prosecution history.) During prosecution, the Office rejected several claims as under 35 U.S.C. § 103 as obvious over U.S. Patent Application Publication no. 2011/0081114 to Togami, et al in view of U.S. Patent No. 7,201,520 to Mizue, et al (“Mizue”). The '826 Patent issued on December 20, 2016, with seven claims, including two independent claims.

B. Prior and Pending Petitions for IPR Filed Against AOI Patents

The '826 Patent was the subject of a prior petition for IPR filed by another

party, Cambridge Industries USA, Inc. (“CIG”). CIG’s petition, IPR2025-00433, was filed on January 17, 2025. In that proceeding, AOI filed a request for discretionary denial, similar to this request, which was granted on June 27, 2025. *See* Exhibit 2003. CIG then filed a request for rehearing by the Director, which was denied on August 21, 2025. *See* Exhibit 2004. On October 10, 2025, CIG filed a petition for writ of mandamus in the Court of Appeals for the Federal Circuit, and, on December 9, 2025, the petition was denied. *See* Exhibit 2010. Thus, a request for IPR of the ’826 Patent has already been denied twice and mandamus relief denied.

Petitioner, in addition to this petition for IPR of the ’826 Patent, has also filed petitions for IPR of four other AOI patents: U.S. Patent No. 10,379,301 (“’301 Patent”); U.S. Patent No. 10,042,116 (“’116 Patent”); U.S. Patent No. 10,788,690 (“’690 Patent”); and U.S. Patent No. 9,448,367 (“’367 Patent”) (which is the only patent that has not been the subject of a prior IPR petition). AOI has separately filed Requests for Discretionary Denial of Petitioner’s petitions for IPR of the ’301, ’116, and ’367 patents.

On January 17, 2025, CIG had also previously filed petitions for IPR on the ’301 Patent, the ’116 Patent, the ’690 Patent, and U.S. Patent 10,313,024 (“’024

Patent”).¹ The petition on the ’116 Patent was also discretionarily denied by the Acting Director on June 27, 2025 along with the ’826 Patent. And, the IPR petitions on the ’301 Patent and ’024 Patent were subsequently denied institution by the Board on substantive grounds. Thus, only one of the five IPR petitions filed by CIG was instituted — the one for the ’690 patent.

Thus, of the five AOI patents challenged by Petitioner in IPRs, three are the subject of prior petitions for IPR that have already been denied, including the prior petition for IPR of the ’826 Patent, which was discretionarily denied.

C. The Litigation Between AOI and Petitioner Accelight

On December 13, 2024, AOI filed a lawsuit against Petitioner for patent infringement in the case captioned *Applied Optoelectronics, Inc. v. Accelight Technologies, Inc.*, case no. 4:24-cv-09041-HSG (N.D. CA) (the “Accelight Litigation”). The complaint alleges Petitioner infringes six AOI patents, including the ’826 Patent. In the Accelight Litigation, Accelight alleges that each of the six patents-in-suit is invalid. Accelight has filed petitions for IPR of five of the six patents. On April 15, 2025, AOI served its infringement contentions, stating that

¹ CIG is accused of infringing these and other patents in separate litigation captioned *Applied Optoelectronics, Inc. v. Cambridge Industries, Inc.*, case no. 3:24-cv-01010-JD (N.D. CA).

Petitioner infringes claims 1–7 of the '826 Patent. On May 30, 2025, Petitioner served its invalidity contentions. *See* Exhibit 2005. In its invalidity contentions, Petitioner contends that claims 1–7 are invalid under either 35 U.S.C. § 102 or § 103 based on five separate arguments that each rely on one or more of six different references. The following arguments from Petitioner's invalidity contentions in the Accelight Litigation are relevant here: (1) obvious over a China patent in view of U.S. Patent No. 7,201,520 to Mizue (Exhibit 2004); (2) anticipated by or obvious over China patent CN 203026708 to Li (Exhibit 1007 and English translation Exhibit 1005) or obvious over Li in view of Mizue; (3) anticipated by or obvious over Mizue, or obvious over Mizue in view of Li; (4) anticipated by or obvious over a China patent in view of China patent CN 201749226 to Liu (Exhibit 1008 and English translation Exhibit 1006); and (5) obvious over a China patent in view of Li with or without Mizue. *See* Exhibit 2005, pp. 9–10.

Pursuant to the District Court's Scheduling Order, between May 30, 2025 and October 7, 2025, Petitioner served invalidity contentions and documents; the parties exchanged proposed terms for claim construction, preliminary constructions and extrinsic evidence, and damages contentions; and the parties filed a Joint Claim Construction Statement and Prehearing Statement, and opening, responsive, and reply claim construction briefs. *See, e.g.*, Exhibit 2006.

On October 9, 2025, the District Court granted the parties' joint motion to

stay the case based on Petitioner's petitions for IPR. The Court ordered the parties to regularly file joint status reports, including after any PTAB decision on any of Petitioner's petitions for IPR. *See* Exhibit 2007.

D. The Litigation Between AOI and CIG

On February 20, 2024, AOI filed a lawsuit against CIG for patent infringement in the case captioned *Applied Optoelectronics, Inc. v. Cambridge Industries, Inc.*, case no. 3:24-cv-01010-JD (N.D. CA) (the "CIG Litigation"). The complaint alleges that Petitioner infringes eight of AOI's patents, including the '826 Patent. In the CIG Litigation, CIG alleges that each of the eight patents-in-suit is invalid. CIG has filed petitions for IPR of five of the eight patents.

Pursuant to the District Court's Scheduling Order, between May 2024 and March 2025, AOI and CIG exchanged initial disclosures, infringement and invalidity contentions, proposed terms for claim construction, preliminary claim constructions, and extrinsic evidence; filed a Joint Claim Construction Statement and Prehearing Statement; exchanged damage contentions; and filed opening, responsive, and reply claim construction briefs. *See* Exhibit 2008.

On March 19, 2025, AOI and CIG notified the District Court that CIG had filed petitions for IPR of five of the eight patents-in-suit. On April 4, 2025, the District Court issued an order staying the case, ordering the parties to regularly file joint status reports on the status of CIG's petitions for IPR.

E. The Petition for *Inter Partes* Review

On November 3, 2025, 11 months after AOI filed its complaint in the Accelight Litigation, Petitioner filed its Petition for IPR of the '826 Patent.

In the Petition, Petitioner challenges claims 1–7 of the '826 Patent. Petitioner asserts three grounds of invalidity: (1) claims 1–7 are anticipated by Mizue (U.S. Patent No. 7,201,520, Ex. 1004); (2) claims 1–6 are obvious over Li (China patent CN 203026708, Exhibit 1007, and English translation, Exhibit 1005) in view of Liu (China patent CN 201749226, Exhibit 1008, and English translation, Exhibit 1006); and (3) claim 7 is obvious over Li.

Pursuant to the Notice of Filing Date, Patent Owner's Preliminary Response is due by February 13, 2026. Pursuant to the PTAB's "Consolidated Trial Practice Guide – November 2019" and the Director's October 17, 2025 Memorandum (Ex. 2002), the Director will determine whether to institute an IPR within three months of the date Patent Owner's Preliminary Response was filed or was due, by about May 13, 2026. If IPR is instituted, pursuant to 35 U.S.C. § 316(a)(11), the PTAB will set the trial date within one year of the notice of institution, no later than about May 13, 2027.

III. INSTITUTION OF *INTER PARTES* REVIEW SHOULD BE DENIED PURSUANT TO THE DIRECTOR'S DISCRETION.

The Director should exercise his discretion pursuant to the Memoranda (Exhibits 2001 and 2002) and deny institution of IPR on the '826 Patent. The following factors support a discretionary denial:

- In the last few months, the '826 Patent has already been the subject of a different petition for IPR (by CIG) that was discretionarily denied. Further, CIG's request for Director rehearing of that discretionary denial was also denied, and CIG's petition for writ of mandamus was denied by the Federal Circuit.
- Some of the art relied upon in the Petition was also identified by the United States Patent and Trademark Office ("USPTO" or the "Office") Examiner and considered by the USPTO during prosecution.
- There is significant overlap between the issues in the Petition and in the Accelight Litigation. The same claims are challenged, and some of the grounds, key art, and arguments are substantially the same.
- There has been significant investment in the Accelight Litigation in that substantive issues have already been addressed by the parties.
- There are settled expectations in the enforcement of the '826 Patent as

the patent has been in force for *nine* years.

- Petitioner’s arguments on unpatentability are weak.
- Petitioner and the defendant are the same party.
- The ’826 Patent is one of the patents-in-suit in the CIG Litigation, and claim construction and validity of the ’826 Patent may well be adjudicated before the PTAB’s decision in an IPR, if instituted, would be due, as only one of the five IPR petitions filed by CIG was instituted.
- There are no relevant changes in the law that affect patentability.
- The Accelight Litigation must go forward because not all asserted patents are subject to petitions for IPR.
- Any Search Disclosure Declaration (“SDD”) filed by Petitioner pursuant to the Director’s November 17, 2025 Memorandum entitled “Voluntary Search Disclosure Declarations as a Favorable Factor in Institution Decisions” (“Director’s SDD Memo,” Exhibit 2009) is at a most a neutral, rather than favorable, factor with respect to this Petition because Petitioner relies only on patents for its invalidity arguments in the Petition.

Each of these factors is discussed separately below in sections A through K.

A. A Petition for IPR of the '826 Patent has Already been Denied Twice.

CIG filed its petition for IPR of the '826 Patent, IPR2025-00433, on January 17, 2025. In that proceeding, AOI filed a request for discretionary denial of IPR, similar to this request. The Acting Director granted AOI's request on June 27, 2025. *See* Exhibit 2003. The decision was based on "the totality of the evidence and arguments," but specifically addressed the parallel litigation in the Northern District of California and the Patent Owner's settled expectations. *Id.* at pp. 2–3. CIG then filed a request for rehearing by the Director, which was denied on August 21, 2025. *See* Exhibit 2004. On October 10, 2025, CIG filed a petition for writ of mandamus in the Court of Appeals for the Federal Circuit, and, on December 9, 2025, the petition was denied. *See* Exhibit 2010. Thus, a request for IPR of the '826 Patent and mandamus relief have already been denied.

B. The Petition is Based in Part on Art Considered by the Office.

The Director may consider whether the same or substantially the same prior art or arguments were previously before the Office during prosecution. 35 U.S.C. § 325(d); *Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GMBH*, IPR2019-01469, Paper 6, pp.7-8 (Feb. 13, 2020) (precedential); *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, p. 17 (Sept. 6, 2017) (precedential).

Pursuant to § 325(d), the Board uses a two-part test for this factor:

(1) whether the same or substantially the same art or arguments were previously presented to the Office; and, if the first part is met, (2) whether the petitioner has shown that the Office erred in a material way with respect to patentability.

Advanced Bionics, supra, at p. 8. If the first part is met, and the petitioner does not demonstrate material error by the Office, “the Director generally will exercise discretion not to institute IPR.” *Id.* at p. 9.

Here, the first part of the *Advanced Bionics* test is met because some of the same art was previously considered by the Office during prosecution of the '826 Patent. As discussed above, one of Petitioner’s three grounds for invalidity of claims 1–7 relies on Mizue. In an Office Action, the Examiner rejected several claims based on Mizue and another reference. See, File History, Ex. 1002, pp. 76–78. The second part of the *Advanced Bionics* test is also met. Petitioner has not shown that the Office made a material error in evaluating Mizue. Petitioner has failed to show how the Office erred in not finding the claims anticipated as Petitioner’s expert opines.

C. The Issues in the Petition Significantly Overlap the Issues in the Accelight Litigation.

There is significant overlap between the issues (claims, art, arguments, and evidence) asserted in the Petition and in the Accelight Litigation. See *Apple Inc. v.*

Fintiv, Inc., IPR2020-00019, Paper 11, p. 6 (March 20, 2020) (precedential). “[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.”

First, the same claims are challenged in the Petition as are challenged in the Accelight Litigation (claims 1–7). Second, all three of the references relied upon in the Petition (Mizue, Li, and Liu) are also relied upon by Petitioner (together with several other references) in all five of the invalidity grounds asserted in the Accelight Litigation. *See* Exhibit 2005, pp. 9-10. Third, all three of the grounds for invalidity in the Petition are the same or substantially the same as three of the grounds asserted in the Accelight Litigation. In Ground 1 of the Petition, Petitioner argues that claims 1–7 are anticipated by Mizue; in the Accelight Litigation, Petitioner argues that claims 1–7 are anticipated by Mizue. In Ground 2 of the Petition, Petitioner argues that claims 1–6 are obvious over Li in view of Liu; in the Accelight Litigation, Petitioner argues that claims 1–7 are obvious over Li in view of Mizue or obvious over another reference in view of Liu. In Ground 3 of the Petition, Petitioner argues that claim 7 is obvious over Li; in the Accelight Litigation, Petitioner argues that claims 1–7 are obvious over Li. *See id.*

Moreover, the Accelight Litigation involves three other references and several other grounds challenging the ’826 Patent that are not asserted in the

Petition. And the Accelight Litigation also involves five other patents. Thus, the Accelight Litigation will need to go forward regardless of whether IPR is instituted. The fact that the Accelight Litigation involves additional challenges to the '826 Patent weighs in favor of a denial. *See Next Caller Inc. v. Trustid, Inc.*, IPR 2019-00963, Paper 8, p. 12 (October 28, 2019) (informative).

D. The Parties Have Invested in the Accelight Litigation by Addressing Substantive Issues.

The Accelight Litigation progressed to the point for a claim construction hearing before the case was stayed on October 9, 2025. The parties had exchanged proposed terms for claim construction, preliminary constructions and extrinsic evidence, and damages contentions; and the parties filed a Joint Claim Construction Statement and Prehearing Statement, and opening, responsive, and reply claim construction briefs. Thus, the parties have spent significant time and effort in litigating substantive issues. *See Exhibits 2006 and 2007.*

E. There Are Settled Expectations in the '826 Patent.

The '826 Patent was issued on December 20, 2016. The patent has been in force for *nine* years, almost one-half of the life of the patent. Thus, there are settled expectations that the '826 Patent is valid and enforceable.

F. Petitioner's Arguments on Unpatentability are Weak.

The Director may consider the strength of the petitioner's unpatentability challenge in determining whether to discretionarily deny institution of IPR.

Director’s March 26, 2025 Memorandum, Exhibit 2001, p. 2; *Apple Inc. v. Fintiv, Inc.*, *supra*, pp. 14-15. If the merits are a “close call,” that fact weighs in favor of denying institution if other factors favoring denial are present. *Id.* at p. 15.

Here, Petitioner alleges anticipation based on Mizue (Ground 1) and obviousness based on Li in view of Liu (Ground 2) or Li alone (Ground 3). However, Petitioner is unlikely to succeed on the merits under any of these grounds because none of these references discloses all of the limitations of any claim of the ‘826 Patent or renders any claim obvious.²

1. Ground 1: Mizue Does Not Anticipate the ‘826 Patent Because It Fails to Disclose All the Limitations of Any Claim.

Mizue fails to disclose all the limitations of any claim of the ‘826 Patent. For example, independent claim 1 requires “an elastic component, wherein the main body has a first limiting surface and a second limiting surface forming the limiting space, the first limiting surface is closer to the head part than the second limiting surface, and the elastic component is located in the limiting space and between the first limiting surface and the limited part and is covered by the extending arm such

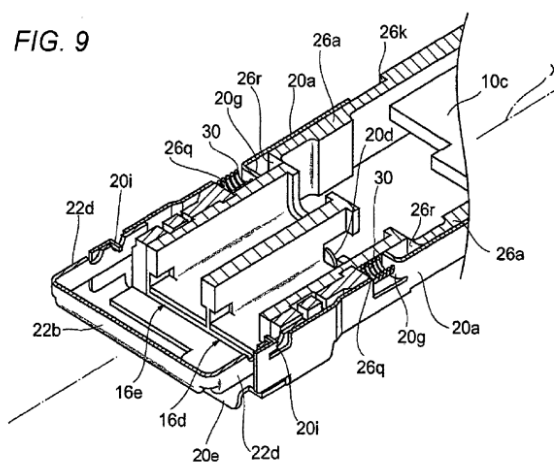
² For purposes of this Request to the Director for Discretionary Denial, AOI will only discuss a few specific examples of limitations the cited references fail to disclose.

that the elastic component is confined by the main body and the sliding component.”

Claims 2–6 depend from claim 1 and thus also contain this limitation.

Similarly, independent claim 7 requires “ an elastic component, wherein the main body has a first limiting surface and a second limiting surface forming the limiting space, the first limiting surface is closer to the head part than the second limiting surface, and the elastic component is located in the limiting space and between the first limiting surface and the limited part and is covered by the extending arm such that the elastic component is confined by the main body and the sliding component.”

Figure 9 of Mizue



This claim element requires the elastic component is *both* covered by the extending arm *and* confined by the sliding component. As shown in Figure 9 (reproduced below), Mizue does not disclose this claim limitation.

As shown in Mizue's Figure 9, the elastic component is not covered by the sliding component.

Therefore, Mizue does not meet the required limitation that "an elastic component, wherein the main body has a first limiting surface and a second limiting surface forming the limiting space, the first limiting surface is closer to the head part than the second limiting surface, and the elastic component is located in the limiting space and between the first limiting surface and the limited part and is covered by the extending arm such that the elastic component is confined by the main body and the sliding component."

Because claims 2-6 depend from claim 1, Mizue also does not disclose all the limitations of the dependent claims.

Accordingly, Petitioner has not shown that Mizue anticipates the '826 Patent. For at least these reasons, Petitioner is unlikely to succeed on the merits of Ground 1.

2. Ground 2: Claims 1-6 are Not Obvious Over Li in view of Liu.

Li in view of Liu fails to disclose all the limitations of any claim of the '826 Patent. For example, independent claim 1 requires "an elastic component, wherein the main body has a first limiting surface and a second limiting surface forming the limiting space, the first limiting surface is closer to the head part than the second limiting surface, and the elastic component is located in the limiting space and

between the first limiting surface and the limited part and is covered by the extending arm such that the elastic component is confined by the main body and the sliding component.” Claims 2–6 depend from claim 1 so contain this limitation.

Petitioner relies on Li for this claim limitation. However, As Petitioner admits, “Li discloses a return spring.” *See* Petition at p. 66. That is the opposite of the claimed AOI invention, which is a compress spring. as a result, the return spring in Li is placed closer to the second limiting surface, not the first limiting surface as claimed in claim 1.

Therefore, Li in view of Liu does not meet the required limitation that “an elastic component, wherein the main body has a first limiting surface and a second limiting surface forming the limiting space, the first limiting surface is closer to the head part than the second limiting surface, and the elastic component is located in the limiting space and between the first limiting surface and the limited part and is covered by the extending arm such that the elastic component is confined by the main body and the sliding component.”

Because claims 2-6 depend from claim 1, Li in view of Liu also does not disclose all the limitations of the dependent claims.

3. Ground 3: Claim 7 is Not Obvious Over Li.

For the same reasons as for Ground 2, claim 7 is not obvious over Li. Claim 7 has a similar limitation that is not disclosed by Li or obvious over Li.

G. Petitioner and the Defendant Are the Same Party.

Here, the fact that Petitioner and the defendant in the Accelight Litigation are the same party weighs in favor of denial of institution. *See Apple Inc. v. Fintiv, Inc., supra*, pp. 13–14.

H. The Validity of the '826 Patent May Be Adjudicated by a District Court Before the PTAB's Decision is Due if IPR is Instituted.

The '826 Patent is one of eight patents-in-suit in the CIG Litigation between AOI and defendant CIG, filed on February 20, 2024. As noted above, five of the eight patents-in-suit in the CIG Litigation were the subject of IPRs filed by CIG, and four of those have been denied by the Director or the Board. Although the CIG Litigation is currently stayed, the District Court may well lift the stay and proceed to claim construction that was fully briefed when the stay went into effect.

Thus, the validity of the '826 Patent may be adjudicated in the CIG Litigation before the Board's decision in an IPR, if instituted, which would be due by about May 13, 2027.

I. There Are No Relevant Changes in the Law that Affect Patentability.

There have been no changes in the law or judicial precedent regarding patentability since the '826 Patent issued. Accordingly, this factor weighs in favor of denial of institution. *See Memorandum, Exhibit 2001, p. 2.*

J. The Accelight Litigation Must Go Forward Because Not All Asserted Patents are Subject to Petitions for IPR.

The Director may consider all relevant circumstances in determining whether to discretionarily deny institution of IPR. *See* Memorandum, Exhibit 2001, p. 3; *Apple Inc. v. Fintiv, Inc.*, *supra*, p. 14. The Accelight Litigation involves six AOI patents, five of which are the subject of petitions for IPR filed by Petitioner, including the '826 Patent. These facts indicate that the Accelight Litigation will need to go forward regardless of the petitions for IPR. Therefore, it would be more efficient for the validity of the '826 Patent to be resolved in the Accelight Litigation, and the PTAB could conserve its resources by denying institution. *See, Next Caller Inc.*, *supra*, p. 14, fn. 13, with similar facts (informative). Therefore, this factor weighs in favor of denial.

K. Any Petitioner Search Disclosure Declaration Does Not Favor Institution.

Any Search Disclosure Declaration (“SDD”) filed by Petitioner pursuant to the Director’s SDD Memo is at a most a neutral, rather than favorable, factor with respect to this Petition because Petitioner relies only on patents for its invalidity arguments. *See, e.g.*, Exhibits 1004-1008.

Specifically, the Director’s SDD Memo states that “[t]he voluntary submission of an SDD will be considered as a non-exclusive, nondispositive favorable discretionary factor supporting institution, *particularly where the SDD*

reveals new or underutilized pathways relevant to Office search practice.” See Ex. 2009 at p. 2 (emphasis added)]. Given that Petitioner relies only on patents in its Grounds for alleging invalidity, finding these alleged prior art references neither requires, nor reveals, “*new or underutilized pathways relevant to Office search practice.” Id.* To the extent that Petitioner may argue that other references located via their search were found using new or underutilized pathways, that would not relate to this Petition because Petitioner did not rely upon them here. Therefore, the filing of an SDD with respect to this Petition should not favor institution.

IV. CONCLUSION

For the reasons set forth above, the Director should exercise his discretion and deny institution of IPR on the '826 Patent.

Dated: January 13, 2026

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CERTIFICATE OF SERVICE

The undersigned hereby certifies service on the Petitioner, pursuant to 37 C.F.R. § 42.6(e) and by agreement of counsel, by electronic (e-mail) delivery of a true copy of the foregoing **PATENT OWNER'S REQUEST TO DIRECTOR FOR DISCRETIONARY DENIAL OF PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT 9,523,826 (Pursuant to Acting Director's Memorandum of March 26, 2025 and Director's Memorandum of October 17, 2025)**, which was served on January 13, 2026 to the following Counsel for

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