

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EOPTOLINK TECHNOLOGY USA INC.,
Petitioner,

v.

APPLIED OPTOELECTRONICS, INC.
Patent Owner.

IPR2026-00094
U.S. Patent No. 10,578,818

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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STATUTES

35 U.S.C. § 102	1, 7, 15, 19
35 U.S.C. § 103	1, 7, 15, 19

PETITIONER’S UPDATED EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 10,578,818 to Chen et al. (“the ’818 patent”)
1002	Prosecution History of the ’818 patent
1003	U.S. Patent Publication No. 2015/0263453 to Wang et al., published September 17, 2015
1004	U.S. Patent Publication No. 2014/0104808 to Koutrokois, published April 17, 2014
1005	U.S. Patent No. 9,523,826 to Tsai et al., issued December 20, 2016
1006	U.S. Patent Publication No. 2017/0363828 to Zhu et al., published December 21, 2017
1007	Declaration of Dr. Michael Lebby
1008	Chinese Patent Publication No. CN109856733A to Chen et al., published June 7, 2019, and including English translation
1009	Chinese Patent Publication No. CN107907948A to Feng et al., published April 13, 2018, and including English translation
1010	U.S. Patent Publication No. 2011/0081114A1 to Togami et al., published April 7, 2011
1011	Joint Administrative Motion to Stay Pending IPR Institution Decisions, filed Dec. 5, 2025, in Case No. 5:24-cv-08165-NW (“Eoptolink Litigation”)
1012	Order Granting Joint Administrative Motion to Stay in the Eoptolink Litigation, dated Jan. 13, 2026
1013	Declaration of Dirk Lutz

I. INTRODUCTION

The Director should reject Patent Owner’s request for discretionary denial (Paper 7, “DD Req.”). Patent Owner’s primary argument for discretionary denial is the purported “settled expectations” arising from the age of the ’818 patent, which issued in March 2020, and is presently less than six years old. However, the age of the patent is just one of several discretionary factors and, standing alone, does not outweigh Petitioner’s reasonable expectation that the ’818 patent—which had never been previously asserted or licensed—would not be unexpectedly enforced against Petitioner in November 2024, nearly five years after the patent’s issuance.

Importantly, one of Petitioner’s products accused of infringing the ’818 patent has been available in the U.S. since at least as early as August 2018, and therefore the November 2024 enforcement of a patent issued in March 2020 was entirely unexpected. Patent Owner’s claimed “settled expectations” are therefore outweighed by Petitioner’s reasonable expectation that its longstanding product would not be met with baseless infringement accusations after **over six years** on the market—particularly given that Petitioner had invested substantial time and resources in developing the U.S. market for that product—while Patent Owner remained silent.

Patent Owner’s purported concern about issue overlap between the PTAB and the district court is also moot given Petitioner’s broad *Sotera*-plus stipulation not to pursue in the district court any invalidity grounds under §§ 102 or 103 based on

patents or printed publications, or any combination of system art with patents or printed publications. Paper 6. Moreover, Patent Owner’s claimed investment in the district court case is overstated given that the parties have not yet begun fact discovery, the claim construction process has not commenced, and the case is stayed.

Based on a holistic assessment of the facts and evidence presented here—namely, (a) the complexity and interrelated nature of the six patents asserted in the parallel district court action, (b) Patent Owner’s failure to meet its duty of disclosure to the Office and material errors by the examiner, (c) Petitioner’s *Sotera*-plus stipulation, (d) judicial efficiency and consistency gained by evaluating this IPR together with IPR2026-00093 (as opposed to two separate district court litigations), and (e) the compelling merits of the Petition—the Director should deny the discretionary denial request. Additionally, the *Fintiv* factors, particularly the stay of the district court case, strongly weighs against discretionary denial.

II. BACKGROUND ON PATENT OWNER AOI’S PENDING LITIGATIONS AGAINST CIG, ACCELIGHT, AND EOPTOLINK

Patent Owner AOI has launched a series of litigations against perceived competitors to monetize Patent Owner’s patents—years after they were issued—by alleging infringement by products that have been in the U.S. market for almost as long as the life of most of the asserted patents. To date, Patent Owner has filed actions against Molex, LLC; Cambridge Industries USA, Inc. (“CIG”); Eoptolink

Technology USA Inc. (“Eoptolink”); and Accellight Technologies, Inc. (“Accellight”). Patent Owner has no intention of engaging in the merits of their lawsuits; instead, they have been harassing competitors by pressing for quick settlements before the cases reach any significant milestone in district court and before IPR petition(s) are filed or instituted. The undersigned counsel knows about Patent Owner’s litigation conduct because she is representing Petitioner Eoptolink in Case No. 5:24-cv-08165-NW (N.D. Cal.) (“Eoptolink Litigation”),¹ **which is currently stayed in view of pending IPR institution decisions.** Same counsel also represents Accellight against Patent Owner in Case No. 4:24-cv-09041-HSG (N.D. Cal.) (“Accellight Litigation”), which is also stayed in view of pending IPR institution decisions. Same counsel previously represented Molex, LLC against Patent Owner in Case No. 4:23-cv-04787-JST (N.D. Cal.), which settled and has been dismissed.

In each case, Patent Owner has asserted a different set of patents, with some overlap among the asserted patents across the various suits. All asserted patents in the various lawsuits, however, relate to optical transceivers. In the Eoptolink

¹ The ’818 patent at issue in this IPR was not asserted in the Accellight Litigation, in the litigations against Molex and CIG, or in any other district court case prior to the Eoptolink Litigation.

Litigation, Patent Owner has asserted six patents (identified in the table on pages 12-14, below), each directed to technologies and components of optical transceiver modules. Of the six patents asserted in the Eoptolink Litigation, only U.S. 9,448,367 is also asserted in the Accelight Litigation; the other five patents have not been asserted against any other party.

Although the '818 patent at issue in this IPR has not been asserted in the Accelight Litigation, Patent Owner has asserted a very similar patent, U.S. 9,523,826 ("the '826 patent"), against Accelight. Both the '818 and the '826 patents are directed to pluggable optical transceivers and share many common features and characteristics (more on this below). The '826 patent is prior art to the '818 patent, which Patent Owner failed to disclose to the Office.

III. PATENT OWNER'S "SETTLED EXPECTATIONS" CLAIM BASED ON THE AGE OF THE PATENT IS OUTWEIGHED BY PETITIONER'S SETTLED EXPECTATION OF NO ENFORCEMENT

Patent Owner argues that because the '818 patent issued in March 2020 and has been in force for almost six years, it has "settled expectations" in the validity of the patent. DD Req., 7. But Patent Owner's unsupported claim of "settled expectations" carries little weight, given that Patent Owner had not previously asserted the '818 patent, and as such, the patent was never challenged in either the Patent Office or a district court. Aside from conclusory attorney argument, Patent Owner has not presented any evidence of reliance on the claimed validity of the '818

patent, or evidence of licensing or commercial interest in the '818 patent, to justify its claim of “settled expectations.” Nor should Patent Owner have developed expectations in the validity of a patent that faced only a **single office action** during prosecution and was never thoroughly searched and examined by the Office. Paper 1 (“Pet.”), 9-12; *see infra* Section IV.A.

More importantly, Patent Owner’s purported “settled expectations” is outweighed by Petitioner’s reasonable expectation that it would not face sudden and baseless infringement claims against a product that had been offered for sale in the U.S. since at least as early as August 2018. Ex. 1013, ¶¶2-3. **Patent Owner waited nearly five years after the patent issued to assert it, during which time Petitioner invested substantial time and resources to build a U.S. market for the accused product, while Patent Owner remained silent.** *Id.*, ¶3. With no prior communication between Patent Owner and Petitioner regarding the '818 patent (or any other patent) or alleged infringement, Petitioner had no reason to anticipate an infringement action in November 2024, asserting a patent that had been around for nearly five years but was never previously asserted. *Id.*

IV. THE DISCRETIONARY FACTORS STRONGLY FAVOR INSTITUTION RATHER THAN DENIAL

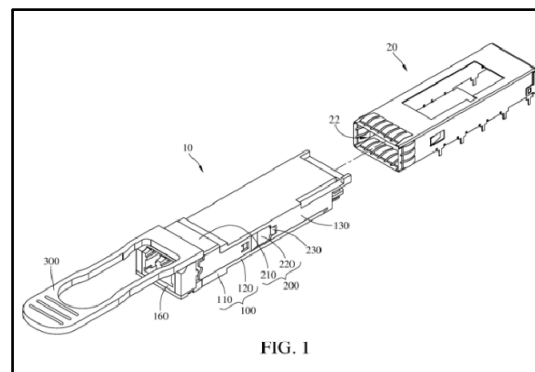
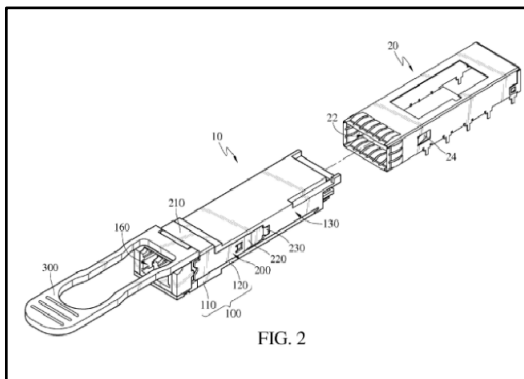
A holistic assessment of the factors outlined in Acting Director Stewart’s Memorandum of March 26, 2025 confirms that discretionary denial is not warranted.

A. Patent Owner's Failure to Meet the Duty of Disclosure to the Patent Office and Material Errors by the Examiner During Prosecution Weigh Against Discretionary Denial

The errors made by Patent Owner and the examiner during prosecution warrant referral to the Board.

1. Patent Owner's failure to disclose the earlier filed '826 patent or the counterpart Chinese patent application on the same invention

The challenged claims in this IPR recite a fundamental component of optical networking—an optical transceiver module configured to be plugged in and unplugged from a socket in a host device—that has been routinely used in the optoelectronics industry for years before the effective filing date of the '818 patent. Pet., 1. In fact, Patent Owner previously filed and obtained the '826 patent, which discloses the same alleged invention. *Compare* Ex. 1001, Figs. 1-3, 8, with Ex. 1005, Figs. 2, 4A-5B, 6. A side-by-side comparison of Figure 2 of the '826 patent and Figure 1 of the '818 patent shows the similarities and substantial overlap in the subject matters of the two patents:



Ex. 1005, Fig. 2; Ex. 1001, Fig. 1

But despite the similarities between the '826 and the '818 patents, **Patent Owner did not claim priority, or any relationship, to the earlier '826 patent** when filing and prosecuting the '818 patent; instead, the '818 patent was filed in an entirely distinct patent family. **Nor did Patent Owner disclose the '826 patent as prior art, or submit the office action or the prior art references cited during prosecution of the '826 patent, to the Office during prosecution of the '818 patent.** *See* Ex. 1002, 54-56 (the single IDS submitted by Patent Owner).

More notably, Patent Owner submitted claims that are substantially similar to those of the '818 patent for parallel prosecution before the China National Intellectual Property Administration (CNIPA). Ex. 1008 (Chinese Patent Pub. No. CN109856733A, which claims priority to U.S. Appl. No. 16/153,685 that issued as the '818 patent). But the counterpart claims were rejected based on prior art, such as CN107907948 (discussed below), and were never granted. Yet, **Patent Owner did not identify the counterpart Chinese patent application to the Office during prosecution of the '818 patent.**

By filing for and obtaining multiple patents in the U.S. on substantially the same invention—without claiming priority or properly disclosing the relationship between the subject matters of the patents to the Office—Patent Owner has improperly extended the patent term for its alleged pluggable optical transceiver invention, and also attempted to avoid double patenting and §§ 102 or 103 rejections

based on its own prior art. Notably, the Petition highlighted Patent Owner's failure to submit its own related patent filings to the Office, but Patent Owner does not address this in its discretionary denial request. *See* Pet., 1-2. Patent Owner's silence concedes its attempt to improperly extend the patent term for the alleged pluggable optical transceiver invention. Such attempt to game the patent system through unjustified extension of patent term should not be allowed. Likewise, Patent Owner's failure to disclose material prior art—particularly, the '826 patent and the references that were applied during examination of the '826 patent—violates its duty of disclosure and candor to the Office and should not be excused.

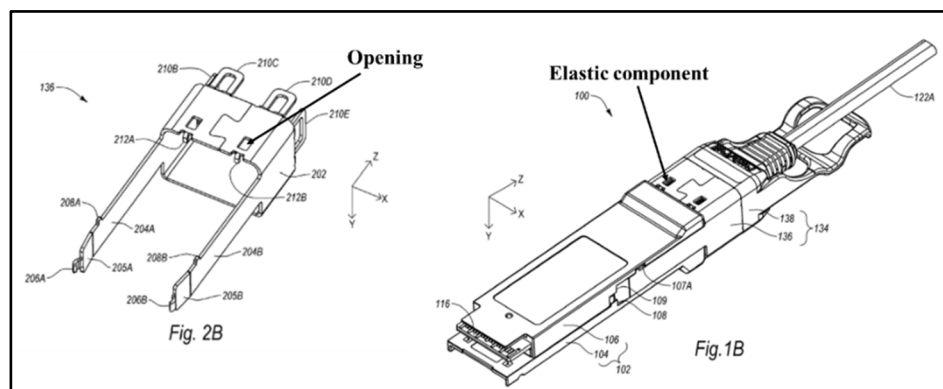
2. The examiner erred by failing to conduct an adequate search and overlooking material prior art

The examiner allowed the claims based largely on Patent Owner's incorrect assertions and without conducting an adequate prior art search or examination. Specifically, the examiner initial issued an office action rejecting all pending claims as obvious over U.S. Patent Publication No. 2015/0093083 to Tsai et al. (which issued as the '826 patent) in view of U.S. Patent Publication No. 2017/0363828 to Zhu et al. Ex. 1002, pp. 38-46. Without contesting the merits of the examiner's rejection, Patent Owner amended the independent claims to add the limitation "wherein the linkage arm comprises an opening connected with the confined groove of the main body to receive the elastic component in the confined groove." *Id.*, pp.

26, 28. Patent Owner argued that the opening disclosed by Tsai “does not allow for mounting/unmounting of the spring 400” and that Zhu is similarly deficient. *Id.*, p. 32 (emphasis in original). The examiner unduly credited Patent Owner’s argument that Tsai and Zhu do not teach openings in the linkage arm through which elastic components may be received into the confined grooves—even though it is well known that elastic components (springs) may be compressed for insertion through small apertures—and the examiner allowed the claims on that basis without sufficient search and examination. *Id.*, p. 15 (notice of allowance), pp. 22-25 (EAST Search History showing that the supplemental search conducted on November 16, 2019 was cursory, with many search queries being identical to the search in May 2019, and the search was completed within approximately 22 minutes (from 21:24 to 21:46) leaving no time for adequate review of the search results).

In allowing the ’818 patent, the examiner materially erred by not conducting a meaningful, feature-focused search directed to the apparently novel feature: openings in the linkage arms for insertion of elastic components. The search history does not indicate any targeted search for the term “opening,” or its common equivalents such as “hole,” “access,” or similar terminology. *Id.* (note search queries in S20–S38). Nor did the examiner specifically search for or consider that elastic components may be compressed for insertion through small openings on the linkage arms of the transceiver body. *Id.*

The examiner also materially erred by overlooking prior art references available to the examiner that teach elastic components that are compressed for insertion through small openings into the confined grooves of the transceiver. *See* Ex. 1007, ¶¶99, 146. For instance, U.S. Patent Publication No. 2011/0081114 (Togami) **cited during prosecution** discloses the core concept relied upon for allowance of the '818 patent—namely, the elastic component is installed into the confined groove through an opening formed in the linkage arm—but the examiner failed to fully consider and apply Togami during prosecution. Ex. 1002, pp. 47-51 (listing Togami in the Notice of References); Ex. 1010, Figs. 1B, 2B, 6 (Togami teaching openings through which springs may be inserted). Thus, the examiner erred by allowing claims based on a limitation that was clearly disclosed in available prior art. *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 5-6 (Director May 19, 2025) (precedential as to § A) (examiner materially errs by overlooking relevant teachings in prior art).



Ex. 1010 (Togami), Figs. 1B, 2B (showing openings near the spring-engaging tabs, indicating that the springs may be inserted through the openings during assembly)

Furthermore, as discussed in the Petition, several prior art references disclose linear elastic components, e.g. springs, that are capable of insertion through small openings in the linkage arm (fastening component) into confined grooves in an outer surface of the transceiver's main body. For example, both Wang (Ex. 1003) and Koutrokois (Ex. 1004) disclose such elastic components that are retained by a fastening component that has openings for insertion of the elastic components into confined grooves of the main body. Chinese patent publication CN107907948, cited during prosecution of the Chinese counterpart application, also discloses this limitation. Ex. 1009, ¶[0044] (disclosing with reference to Figure 6 that handle 3 includes square holes 35 through which springs 4 may be installed). The examiner failed to find and apply such prior art references, even though the practice of compressing a spring by hand to insert it through a small opening is routine and commonly used in many assembly processes. Ex. 1007, ¶¶99, 146.

The errors made during prosecution warrant referral to the Board. *Taiwan Semiconductor Mfg. Co. v. Marlin Semiconductor Ltd.*, IPR2025-00847 et al., Paper 11 (Director Sept. 3, 2025) (“[I]t is an appropriate use of Office resources to review the potential error[s].”). Patent Owner's failure to meet the duty of candor and disclosure to the Patent Office also provides a compelling basis for use of Office resources to review the patentability of the challenged claims.

B. The Complex and Diverse District Court Litigation Weighs Against Discretionary Denial

A “complex and diverse” district court litigation “tip[s] the balance against discretionary denial.” *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2 (Director Jun. 13, 2025); *see also Shenzhen Tuozy Tech. Co. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 at 3 (Director July 17, 2025) (same). As the Acting Director explained in *Tesla* and *Tuozy*, “[t]he large number and vast scope of the patents asserted in the district court litigation ... weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter.” *Tesla*, Paper 9 at 3; *Tuozy*, Paper 10 at 3.

As in *Tesla* and *Tuozy*, the Eoptolink Litigation is complex and diverse. It involves **six patents in six unique patent families covering interrelated technologies and components of optical transceivers**, as the table below shows.

Patent No.	Title	Technology	District Court Case	Eoptolink IPR?
9,448,367	Multi-channel optical transceiver module including dual fiber type direct link adapter for optically coupling optical subassemblies in the transceiver module	Adapter for coupling external fiber optic connectors (such as LC connectors) with the internal components of an optical transceiver	Accelight Litigation Eoptolink Litigation	Yes (IPR2026-00019)
10,578,818	Optical transceiver	Optical transceiver configured for easy	Eoptolink Litigation	Yes

Patent No.	Title	Technology	District Court Case	Eoptolink IPR?
		plugging and unplugging from a host device socket		(IPR2026-00094)
10,714,890	Transmitter optical subassembly arrangement with vertically-mounted monitor photodiodes	TOSA arrangement for an optical transceiver, the TOSA having vertically-mounted monitor photodiodes	Eoptolink Litigation	Yes (IPR2026-00122)
11,177,887	Substrate with stepped profile for mounting transmitter optical subassemblies and an optical transmitter or transceiver implementing same	Optical transceiver substrate having a stepped profile to improve mounting and alignment of TOSA modules on the substrate	Eoptolink Litigation	Yes (IPR2026-00123)
9,509,433	Aligning and directly optically coupling photodetectors to optical	Direct coupling of photodetectors to demultiplexed optical signals from an AWG	Eoptolink Litigation	No ²

² Eoptolink has not filed IPR petitions against the '433 and '470 patents because the Eoptolink products accused of infringing those patents have limited sales in the U.S., and therefore damages, if any, associated with the alleged infringement of the '433 and the '470 patents would be minimal compared to the alleged infringement of the other patents asserted in the Eoptolink Litigation.

Patent No.	Title	Technology	District Court Case	Eoptolink IPR?
	demultiplexer outputs in a multichannel receiver optical subassembly	demultiplexer in a receiver optical subassembly (ROSA)		
10,230,470	Multilayered flexible printed circuit with both radio frequency (RF) and DC transmission lines electrically isolated from each other and an optical transceiver using same	Multilayered flexible printed circuit (FPC) of an optical transceiver, featuring insulating layers that electrically isolate RF and DC (power) traces on the FPC	Eoptolink Litigation	No ²

Given the significant number of interrelated patents in the Eoptolink Litigation, the PTAB is particularly well-positioned to efficiently and consistently adjudicate the patentability of the '818 patent (and the other patents challenged through IPRs). More specifically, because the challenged patents pertain to closely related optical transceiver technologies with substantial overlaps in concepts and subject matters, the PTAB is in a better position than the district court to conduct a unified review of the interrelated technical issues presented by the patents. This approach will advance judicial efficiency and foster “consistency and predictability to the public.” *POSCO Co., Ltd. v. ArcelorMittal*, IPR2025-00370, Paper 10 at 3 (Director Jun. 25, 2025). The complexity and interrelated nature of the patents

asserted in the district court action tips the balance against discretionary denial.

C. Petitioner's *Sotera*-Plus Stipulation to Not Pursue Any Invalidity Grounds Under §§ 102 or 103 Using Patents or Printed Publications in the District Court Weighs Against Discretionary Denial

Petitioner has stipulated that if IPR is instituted, Petitioner will not pursue in the Eoptolink Litigation (i) the specific grounds raised in this Petition, (ii) any other grounds that reasonably could have been raised under §§ 102 or 103 on the basis of prior art patents or printed publications, or (iii) any ground based on a combination of system prior art and the prior art references asserted in the Petition. *See* Paper 6 (filed Nov. 20, 2025). Because of this stipulation, **the only prior-art ground that will remain in the district court litigation is anticipation or single-reference obviousness based on Petitioner's own product, EOLQ-161HG-10-L**, which was in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention. Ex. 2003, 7, 9. Petitioner does not contemplate combining this prior art system with any patent or printed publication. *Id.*, 9.

In the IPR, Petitioner could not raise any prior-art grounds based on its own products or systems, which Petitioner may raise in the district court. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367 (Fed. Cir. 2025). Petitioner's broad stipulation guarantees that there will be no §§ 102 or 103 ground based on patents or printed publications in the district court, thus ensuring that the IPR will be a true alternative to the district court litigation for prior art-based invalidity challenges.

Patent Owner's concern about "significant overlap between the issues" asserted in the Petition and the district court litigation is disingenuous because it fails to address (or even acknowledge) Petitioner's stipulation to not pursue any invalidity challenges based on patents or printed publications in the district court. *See* DD Req., 5-7. Petitioner's stipulation ensures that there will be minimal (if any) overlap in the issues before the PTAB and the district court, thereby promoting judicial efficiency and reducing the risk of inconsistent decisions, which favors institution.

D. Judicial Efficiency and Consistency Strongly Weigh Against Denial

The '818 patent at issue in this IPR and US 9,523,826, which is the subject of IPR2026-00093, claim related subject matter. Specifically, both the '818 and the '826 patents are directed to pluggable optical transceivers and there is substantial overlap in the disclosures of the two patents. *Compare* Ex. 1001, Figs. 1-3, 8, *with* Ex. 1005 Figs. 2, 4A-5B, 6; Pet., 1-2, 5-9. In fact, the Petition uses the '826 patent as prior art against the '818 patent. Pet., 4. The PTAB can therefore efficiently and consistently extend its analysis in this IPR proceeding to IPR2026-00093, and vice versa. Streamlining the evaluation of the two IPRs will benefit the PTAB, the district court, and Patent Owner by conserving resources and avoiding inconsistencies.

Furthermore, because the '818 patent and the '826 patent are asserted in separate district court actions before two different judges, the Hon. Judge Wise and the Hon. Judge Gilliam, there is a significant risk of inconsistent and inefficient

determinations regarding claim constructions and the validity of the patents. Evaluation of the two technologically similar patents by the PTAB, rather than two separate district courts, will substantially mitigate the risk of inconsistent decisions and promote judicial efficiency. This strongly weighs against discretionary denial.

E. The Merits of the Petition are Compelling and Support Institution

The Petition is strong, well-reasoned, well-supported, and straightforward. Each of the challenged claims 1–12 is rendered unpatentable based on Wang (Grounds 1–3) and Koutrokois (Grounds 4–6). Indeed, Patent Owner’s silence regarding the merits of the prior art and the unpatentability grounds in the Petition confirms the strength of the Petition.

Furthermore, there are no § 325(d) concerns in this IPR because the asserted primary references, Wang and Koutrokois, were not considered by the Patent Office during prosecution. Although the publication of the ’826 patent (Tsai) was applied as the primary obviousness reference against all pending claims during prosecution, the Petition applies Tsai in a markedly different and nominal manner—as only a secondary reference against dependent claims 8, 11, and 12. Ex. 1002, pp. 38-46; Pet., 4. More importantly, the examiner did not consider the combination of Wang or Koutrokois with Tsai during prosecution. Additionally, as discussed above, the examiner made material errors in the consideration of Tsai, the available prior art references, and did not conduct a proper and adequate search of the prior art before

allowing the '818 patent. *See* Section IV.A, above. Accordingly, *Advanced Bionics* steps one and two are not satisfied. Nor has Patent Owner requested discretionary denial under § 325(d), which further confirms that the *Advanced Bionics* considerations do not apply to this Petition.

V. THE *FINTIV* FACTORS WEIGH STRONGLY AGAINST DENIAL

Factor 1 (Stay): The Eoptolink Litigation is stayed pending IPR institution decisions, and the stay is highly likely to continue if one or more IPRs are instituted. Ex. 1012. Therefore, this factor weighs strongly against discretionary denial.

Factor 2 (Trial Date): All dates in the Eoptolink Litigation have been vacated in view of the stay, and therefore a district court trial before the PTAB's projected statutory deadline for the final written decision is highly unlikely. Ex. 1012. Therefore, this factor weighs strongly against discretionary denial.

Factor 3 (Parallel Proceeding): Contrary to Patent Owner's assertion, the Eoptolink Litigation is at an early stage. Ex. 1011, 2. No interrogatories or document requests have been propounded by either party; thus, fact discovery has barely started in the case. *See id.* Additionally, the claim construction process has not started and will remain paused in view of the stay. Because the parties have invested very little in the Eoptolink Litigation thus far, this factor weighs strongly against discretionary denial.

Factor 4 (Issue Overlap): Petitioner has submitted a very broad stipulation

in this IPR to not pursue any invalidity ground under §§ 102 or 103 using prior art patent or printed publication if IPR is instituted. Paper 6; Ex. 2003, 9; *supra* Section IV.C. Indeed, the only prior-art invalidity ground that will remain in the district court is based on Petitioner's own product, which could not have been raised in the IPR. Ex. 2003, 9. Petitioner's stipulation goes beyond a standard *Sotera* stipulation in meaningfully reducing overlap between the PTAB and the district court, and ensures that this IPR will be a true alternative to the Eoptolink Litigation for prior-art based invalidity defenses. This factor weighs strongly against discretionary denial.

Factor 5 (Same Party): Because Petitioner and Patent Owner are the same parties as in the Eoptolink Litigation, and because the Board will likely issue a final written decision prior to any trial in the district court, this factor weighs against discretionary denial. *Samsung Elecs. Co. v. Staton Techiya, LLC*, IPR2022-00302, Paper 13 at 18-19 (P.T.A.B. July 11, 2022) (factor five weighs against denial when statutory deadline for final written decision is before trial date in parallel litigation).

Factor 6 (Other Considerations): The Petition is strong, well-supported, and the unpatentability positions are straightforward. *See* Section V.E, above. Patent Owner's silence on the merits underscores the strength of the Petition. This factor therefore also weighs against discretionary denial.

In sum, none of the *Fintiv* factors favors discretionary denial, and several factors weigh strongly against discretionary denial.

**VI. PATENT OWNER’S MISPLACED AND UNFOUNDED CRITICISMS
UNDERScore THE PETITION’S MERITS**

Patent Owner disregards Petitioner’s broad stipulation, which substantially resolves any potential overlap of issues between the PTAB and the district court. Patent Owner also fails to acknowledge the stay of the Eoptolink Litigation, which strongly favors institution of IPR. Rather than engaging with the substantive facts and evidence that support institution, Patent Owner instead raises irrelevant arguments, such as referencing a Search Disclosure Declaration (“SDD”) that was never filed by Petitioner. *See* DD Req., 8-9. These tactics only serve to distract from the central issues before the PTAB. Patent Owner’s criticisms of a non-existent SDD are irrelevant and underscore the weakness of Patent Owner’s request for discretionary denial.

VII. CONCLUSION

Patent Owner has not articulated any legitimate ground for discretionary denial, aside from referencing the “age” of the patent, which alone does not outweigh the numerous other factors and circumstances that support institution. Petitioner respectfully requests institution of IPR based on the merits of the Petition.

Dated: February 13, 2026

Respectfully submitted,

/Arpita Bhattacharyya/

Arpita Bhattacharyya, Reg. No. 63,681
Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on February 13, 2026, a copy of **PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** and **EXHIBITS 1008-1013** were served upon the below-listed counsel by electronic mail:

Jo Dale Carothers - jcarothers@weintraub.com
Eric Caligiuri - ecaligiuri@weintraub.com

Dated: February 13, 2026

By: / Kate Rose /
Kate Rose