

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAGNOLIA MEDICAL TECHNOLOGIES, INC.,
Petitioner,

v.

KURIN, INC.,
Patent Owner.

IPR2026-00097
Patent 12,138,052

PETITIONER'S BRIEF AGAINST DISCRETIONARY DENIAL

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<i>Revision to Rules of Practice Before the Patent Trial and Appeal Board</i> , 90 Fed. Reg. 48335 (Oct. 17, 2025)	8
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PETITIONER’S LIST OF EXHIBITS

Previously Filed:

- Ex. 1001: U.S. Patent No. 12,138,052 (“the ’052 Patent”)
- Ex. 1002: Expert Declaration of Karl Leinsing
- Ex. 1003: Curriculum Vitae of Karl Leinsing
- Ex. 1004: Certified Prosecution History of U.S. Patent No. 12,138,052 (“ the ’052 Patent”)
- Ex. 1005: Certified Prosecution History of U.S. Patent No. 10,010,282 (“ the ’282 Patent”)
- Ex. 1006: Certified Prosecution History of U.S. Patent No. 10,143,412 (“ the ’412 Patent”)
- Ex. 1007: Certified Prosecution History of U.S. Patent No. 11,185,266 (“ the ’266 Patent”)
- Ex. 1008: Certified Prosecution History of U.S. Patent No. 11,963,769 (“ the ’796 Patent”)
- Ex. 1009: Certified Prosecution History of U.S. Patent No. 11,832,944 (“ the ’944 Patent”)
- Ex. 1010: Certified Prosecution History of U.S. Patent No. 12,357,209 (“ the ’209 Patent”)
- Ex. 1011: Certified Prosecution History of U.S. Patent No. 12,390,137 (“ the ’137 Patent”)
- Ex. 1012: WO Pub. No. 2014/085800 (“Bullington800”)
- Ex. 1013: U.S. Patent App. Pub. No. 2014/0336536 (“Brancazio”)
- Ex. 1014: U.S. Patent App. Pub. No. 2012/0245042 (“Liu”)

- Ex. 1015: U.S. Patent No. 5,286,279 (“Wu”)
- Ex. 1016: U.S. Patent No. 6,103,271 (“Morrison”)
- Ex. 1017: U.S. Patent App. Pub. No. 2014/0208978 (“Sunder”)
- Ex. 1018: U.S. Patent No. 7,923,053 (“Kitching”)
- Ex. 1019: U.S. Patent No. 10,039,483 (“Bullington483”)
- Ex. 1020: *Reserved*
- Ex. 1021: *Reserved*
- Ex. 1022: U.S. Patent No. 7,087,047 (“Kraus”)
- Ex. 1023: *Reserved*
- Ex. 1024: *Reserved*
- Ex. 1025: U.S. Patent No. 12,357,209 (“the ’209 Patent”)
- Ex. 1026: U.S. Patent App. Pub. No. 2014/0155782 (“Bullington782”)
- Ex. 1027: U.S. Patent App. Pub. No. 2015/0032067 (“Bullington067”)
- Ex. 1028: U.S. Patent App. Pub. No. 2014/0039348 (“Bullington348”)
- Ex. 1029: The American Heritage Dictionary, Office Edition, Houghton Mifflin Company, (4th Ed. 2001)
- Ex. 1030: The New Oxford American Dictionary, Oxford University Press (2001)
- Ex. 1031: Defendant’s Second Amended Answer and Counterclaims, *Magnolia Medical Techs. v. Kurin, Inc.*, C.A. No. 24-1124-CFC, Dkt. 95 (D. Del. Nov. 21, 2024)
- Ex. 1032: U.S. Patent No. 3,882,026 (“McPhee”)
- Ex. 1033: U.S. Patent No. 9,694,304 (“Perreault”)
- Ex. 1034: U.S. Patent No. 4,832,034 (“Pizziconi”)

- Ex. 1035: Joint Claim Construction Brief, *Magnolia Medical Techs. v. Kurin, Inc.*, C.A. No. 24-1124-CFC, Dkt. 153 (D. Del. Mar. 10, 2025)
- Ex. 1036: Letter to Deputy Clerk, District of Delaware regarding construction of term “housing that defines”, *Magnolia Medical Techs. v. Kurin, Inc.*, C.A. No. 24-1124-CFC, Dkt. 339 (D. Del. Jul. 9, 2025)
- Ex. 1037: Hackh’s Chemical Dictionary (McGraw-Hill, Inc. 1969)
- Ex. 1038: Random House Webster’s College Dictionary (Random House, Inc. 2005)
- Ex. 1039: Membrane, Cambridge Advanced Learner’s Dictionary (Cambridge Univ. Press), archived at <https://web.archive.org/web/20150914225839/https://dictionary.cambridge.org/dictionary/english/membrane>
- Ex. 1040: Petitioner’s Search Disclosure Declaration (filed under seal)

Filed Herewith:

- Ex. 1041 Letter from Gregory Bullington (Magnolia) to Bob Rogers (Kurin), February 23, 2023.
- Ex. 1042 Examiner Search History excerpted from Certified Prosecution History of the ’052 Patent (Ex. 1004).
- Ex. 1043 Excerpts from Trial Transcript, *Magnolia Medical Technologies, Inc. v. Kurin, Inc.*, C.A. No. 24-1124-CFC, Dkt Nos. 447 and 449 (D. Del. December 8 and 10, 2025).

I. INTRODUCTION

The '052 Patent issued improperly, largely because Patent Owner failed to disclose relevant art, such as the Bullington800 reference. This *inter partes* review (“IPR”) should be instituted to remedy that failure. Specifically, Petitioner has invested considerable resources into researching and developing techniques to reduce false positive blood culture test results, and filed a number of patent applications that embody the results of these efforts. One such application published as Bullington800, the primary reference asserted in the Petition. Patent Owner’s principal and the first named inventor on the '052 Patent, Mr. Bob Rogers, was an advisor to *Petitioner* beginning before Bullington800 was filed on December 2, 2013, and remained an advisor at least until 2015 before declining a position on Petitioner’s board of directors and starting his own venture to pursue patents directed to the same concepts, resulting in the '052 Patent.

In February of 2023, over a year before the filing date of the '052 Patent, Mr. Rogers was made aware of the application that published as Bullington800. Yet Patent Owner failed to disclose it during prosecution. Material errors in the

Examiner's search strategy,¹ coupled with Patent Owner's critical omission, prevented Bullington800 from being discovered during prosecution. That the '052 Patent exists despite being directed towards concepts already disclosed by Petitioner is an error that demands correction, and the Board is best suited to resolve what is essentially an issue of competing priority dates for disclosure of the concept embodied in the '052 Patent.

The Petition is strong, and merits institution. In addition to Petitioner's own prior art reference that invalidates the claims of the '052 Patent, the Petition includes additional combinations using prior art absent from the prosecution history that render the claims obvious. Petitioner also submitted a *Sotera* stipulation with the Petition. Moreover, Patent Owner has no settled expectations in the '052 Patent to counter the merits of the Petition.

Patent Owner spills much ink alleging that invalidity was already litigated and that Petitioner applies certain claim constructions in a manner that differs from what Petitioner argued during the corresponding litigation. But invalidity of the '052 Patent over the prior art has never been adjudicated on the merits, and Patent

¹ Petitioner has submitted under seal a Search Disclosure Declaration with a detailed explanation of the search strategies and techniques used to find the prior art asserted in the Petition. Ex. 1040.

Owner's assertion that Petitioner applies different claim constructions is simply wrong on the facts.

For at least these reasons, discretionary denial of the Petition is inappropriate.

II. IPR IS NECESSARY TO REMEDY PATENT OWNER'S OMISSIONS AND THE OFFICE'S ERRORS DURING PROSECUTION

A. Patent Owner Failed to Disclose All Relevant Art

The '052 Patent issued, in part, thanks to the absence of Petitioner's own highly relevant art, including Bullington800, from the prosecution history. The omission of this art is all the more glaring given the history of the parties. Gregory Bullington—first named inventor of Bullington800 and Petitioner's founder—made Mr. Rogers—first named inventor of the '052 Patent and Patent Owner's founder—aware of Petitioner's patent applications related to medical devices at least as early as 2013. Ex. 1043, 277:19-280:19, 284:7-286:19, 289:9-23 (Mr. Bullington's testimony describing contact between Mr. Bullington and Mr. Rogers between 2013 and 2015); *see also id.*, 874:16-876:15 (Mr. Rogers' testimony describing same). Mr. Rogers advised Mr. Bullington regarding Petitioner's business between 2013 and 2015, a period that includes the December 2, 2013 filing of Bullington800. Ex. 1043, 277:19-281:11, 289:9-23, 875:1-11. Mr. Bullington even met with Mr. Rogers in person in March of 2015 and offered Mr. Rogers a seat on Petitioner's board of directors. Ex. 1043, 284:7-286:12, 755:15-760:2, 761:9-23, 876:21-877:10. Mr. Rogers declined Mr. Bullington's offer and, ten days later, began analyzing

Petitioner's product with one of Patent Owner's other co-founders. Ex. 1043, 284:21-285:15, 287:6-288:23, 762:9-16, 876:21-879:25. Patent Owner subsequently filed the provisional application that constitutes the earliest priority claim of the '052 Patent in 2015. Ex. 1004, p. 44.

Patent Owner filed the application for the '052 Patent on July 24, 2024. Ex. 1001, cover. Notably, the filing occurred over a year *after* Mr. Rogers received a letter on February 23, 2023 from Mr. Bullington that included a list of patents and applications assigned to Petitioner and relevant to the work being done by Patent Owner. Ex. 1041. The list included PCT App. No. PCT/US2013/072563, the application that published as Bullington800. Ex. 1041, p. 7; Ex. 1012, cover. That Patent Owner was aware of the letter and its contents cannot be in doubt, as further evidenced by the fact that Patent Owner filed an IDS on August 26, 2024 listing over thirty references included in the letter. Ex. 1004, pp. 2566-2595. Yet, Bullington800 is conspicuously absent from Patent Owner's disclosures. *Id.* The inclusion of the application that published as Bullington800 in the February 23 letter and Mr. Rogers's long-standing general knowledge of Petitioner's intellectual property demonstrate that Patent Owner reasonably should have known about Bullington800. Institution should be granted to address the merits of Bullington800 and not reward Patent Owner for its failure to provide it to the examiner.

B. Examiner Error Also Contributed to Allowance

The Examiner for the application that issued as the '052 Patent (“the '088 Application”) also committed a material error at least because the Examiner failed to conduct an adequate search. In the sole Office Action issued during prosecution, the Examiner indicated that claims 10 and 23 would be allowable if rewritten in independent form. Ex. 1004, pp. 5573-5579. Claims 10 and 23 both recited, *inter alia*, “a housing that defines the inlet port, the sampling channel, and the outlet port.” Ex. 1004, pp. 37, 39. The Examiner’s search history clearly shows that at no point after the July 24, 2024 filing date of the '088 Application and before issuing the Office Action on September 17, 2024 did the Examiner conduct a search for a “housing,” let alone one that “defines the inlet port, the sampling channel, and the outlet port.” *See generally*, Ex. 1042. The search history includes a few searches with the term “housing” or the letters “hous” performed during prosecution of parent applications predating the filing of the '088 Application, but there is no indication that the Examiner ever searched for those terms in the context of the claims of the '088 Application. Ex. 1042, pp. 84, 87, 91, 97.

Patent Owner took advantage of the Examiner’s oversight and incorporated claims 10 and 23 into independent claims 1 and 14. Ex. 1004, pp. 5825-5832. The Examiner subsequently performed only a single search query limited to databases for U.S. patents and U.S. published applications, and thus excluded a wide range of

international publications as prior art, including Bullington800. The Examiner then issued a Notice of Allowance stating that Petitioner’s reference “Patton” is “the most pertinent prior art.” Ex. 1004, p. 5904.

The inventor (Richard Patton) of what the Examiner considered to be “the most pertinent prior art” is also an inventor on the Bullington800 reference asserted in the Petition. Ex. 1001, cover. Both the Patton reference and Bullington800 are owned by Petitioner. However, the Examiner failed to conduct any searches specifically for inventions associated with inventor Richard Patton and/or with Petitioner.

Thus, IPR also should be instituted to correct the Examiner’s errors.

III. DENIAL UNDER § 314(A) WOULD BE IMPROPER

A. Factors Outlined in the March 26, 2025, Interim Processes Memorandum Weigh Against Discretionary Denial

The USPTO’s memorandum on workload management introduced several factors in considering discretionary denial. These factors, including the sole factor addressed by Patent Owner, counsel against denial.

1. There are No Settled Expectations of Patentability

Patent Owner makes no mention of settled expectations, and has no settled expectations regarding the validity of the ’052 Patent. *Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (PTAB Acting Director Jun. 18, 2025); *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-

00434, Paper 11 at 2-3 (PTAB Acting Director Jun. 26, 2025) (stating when “most of the challenged patents have not been in force for a significant period of time (issued in 2020, 2019, and 2019),” then “Patent Owner has not developed strong settled expectations that favor discretionary denial”).

The '052 Patent issued November 12, 2024, and thus was in force for only one year prior to the filing of the Petition. The former Acting Director and the Director have both repeatedly declined to exercise discretionary denial based on settled expectations for patents in force for much longer periods of time. *Evenflo Co. v. Baby Jogger, LLC*, IPR2025-01122, Paper 12 at 2 (PTAB Nov. 20, 2025) (patents less than two years old); *3D Sys. Corp. v. Intrepid Automation, Inc.*, IPR2025-01241, Paper 11 at 2 (PTAB Nov. 20, 2025) (patents less than four and five years old); *ASUSTeK Computer, Inc. v. Nokia Techs. Oy*, IPR2025-01153, Paper 13 at 2 (PTAB Nov. 20, 2025) (patent less than six years old); *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00603, Paper 8 at 2 (PTAB Acting Director Jul. 24, 2025) (patent less than three years old). Thus, there are no settled expectations of patentability for Patent Owner, and reviewing the '052 Patent would promote consistency with the Board's prior discretionary denial decisions.

The analysis of the settled expectations factor is not limited to Patent Owner; Petitioner has its own settled expectations that are relevant here. *See* March 26, 2025 Memorandum, p. 2 (describing that relevant considerations may include “[s]ettled

expectations **of the parties**”) (emphasis added). Here, Petitioner had settled expectations that the Office would reject applications directed to embodiments publicly disclosed by Petitioner more than ten years ago, and thus prevent the assertion of such patents against Petitioner.

For at least these reasons, the Board should not discretionarily deny institution.

2. The Validity of the Claims Has Not Been Adjudicated on Prior Art Grounds

If Institution is granted, the Board will be the first tribunal to consider the merits of the validity of the ’052 Patent in view of the prior art. The corresponding litigation, which did not try the issue of invalidity or unpatentability of the ’052 Patent under §§ 102 or 103, was the only other proceeding involving the ’052 Patent. Accordingly, this proceeding does not “cover the same ground as district court litigation” and avoids “consum[ing] Office and party resources re-litigating issues....that are being litigated elsewhere.” Revision to Rules of Practice Before the Patent Trial and Appeal Board, 90 Fed. Reg. 48335 (Oct. 17, 2025).

Patent Owner argues that invalidity was litigated. DD Brief, § I.A. But Petitioner did not assert invalidity over the prior art to the jury—Petitioner argued for invalidity only under § 112, which is not a ground that can be raised in IPR. Patent Owner also argues that Petitioner asserted “the very same prior art” (referring to Bulington800) in a motion for summary judgment, but the District Court’s

decision not to grant summary judgment was not an adjudication of invalidity on the merits but rather a determination that there were disputed issues of fact (which are exactly what the Board is equipped to determine). Ex. 2004, pp. 1-2. And, Patent Owner wholly ignores that the Petition includes obviousness grounds in view of references (Brancazio and Liu) absent from the motion for summary judgment. DD Brief, p. 4; Ex. 2003. Patent Owner glosses over all the above crucial details in arguing that the Petition should be denied based on the prior litigation. DD Brief, p. 8.

Patent Owner bases its argument on the fact that Petitioner's invalidity expert was precluded from offering at trial his anticipation and obviousness opinions prior to the filing of the Petition. This argues *in favor of* institution, not against it. The factor that is relevant to discretionary denial is whether there was an adjudication of the validity or patentability of the challenged patent claims on the merits. *See* March 26, 2025 Memorandum, p. 2. The exclusion of Petitioner's expert (on a technicality, no less), is not such an adjudication. Indeed, the District Court's sole reason for excluding the opinions was that the expert's report did not specify a construction upon which he was relying for a specific term. Ex. 2006, pp. 2-3.

The truth of the matter is that no forum "has already adjudicated the validity or patentability of the challenged patent claims," and thus this factor weighs in favor of institution. *See* March 26, 2025 Memorandum, p. 2.

3. Petitioner’s Challenges are Strong

The strong merits of Petitioner’s challenge favor institution. Indeed, Patent Owner does not address this factor and does not argue that Petitioner’s challenge is not strong on the merits. The Petition relies on art that was not before the examiner, including art (Bullington800) that Patent Owner was made aware of yet suspiciously left off its IDS, and which teaches the elements the examiner mistakenly believed to be missing from the prior art. *See* Pet., §§ VI.A-C.

4. Petitioner Properly Relies on Expert Testimony

Petitioner’s reliance on expert testimony is proper. Patent Owner makes no argument to the contrary. The expert testimony does not attempt to, *e.g.*, improperly fill in gaps in the art, but instead supplies the type of technical context the Board has consistently recognized as useful. *See iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 2–3 (PTAB Acting Director Jun. 6, 2025) (failure to identify any expert testimony that suggests Petitioner is using its expert to fill gaps in the prior art weighs against discretionary denial, granting denial on other grounds); FAQs for Interim Processes, No. 22 (appropriate testimony includes “provid[ing] helpful context or [] explain[ing] terms of art”). Further, there is no evidence that this IPR will devolve into an undue series of “disputes between experts” as Patent Owner has not identified an expert or used that expert to dispute anything here. *See* FAQs for Interim Processes, No. 22.

Accordingly, this factor also weighs in favor of institution.

B. There is No Inconsistency in Petitioner’s Application of the District Court Claim Construction

Petitioner’s application of the claims in the Petition is consistent with Petitioner’s positions taken at litigation, and Patent Owner’s arguments to the contrary are incorrect. Tellingly, Patent Owner does not claim that Petitioner has adopted different constructions than the District Court. Nor could it; the Petition expressly adopted the District Court’s constructions (Pet., § V.C), and at trial neither the Court nor Patent Owner objected or otherwise indicated that Petitioner was applying the claims in any manner inconsistent with those constructions. In short, the litigation tried the issue of infringement applying the Court’s claim constructions, and the Petition seeks to determine patentability applying those same claim constructions.

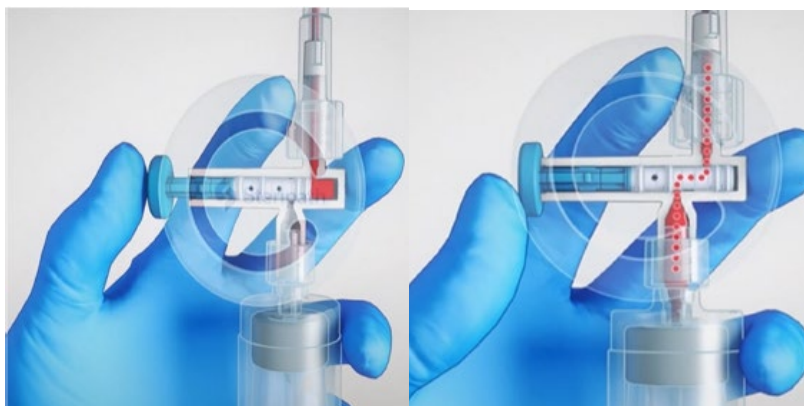
Claim element [1C]² was not given an express construction at trial, and Petitioner’s application of the plain and ordinary meaning is consistent with the District Court construction. Ex. 2008, 1887:9-1888:1. Patent Owner argues that “Petitioner sought to avoid infringement by arguing that the accused product’s outlet

² “a chamber connected with the inlet port and configured to collect a first portion of the blood sample when under a drawing force applied from the outlet port from a blood sample collection device”.

port did not *directly* apply a drawing force to the relevant chamber.” DD Brief, p. 22. But Patent Owner mischaracterizes Petitioner’s trial arguments. Petitioner’s expert at trial explained that “the bladder regulates the pressure. So you could apply a larger pressure or a less pressure, but the bladder regulates the pressure that actually is applied to the blood sample.” Ex. 2008, 1597:9-1598:7. Petitioner’s expert further explained the importance of the bladder “creat[ing] a gentle negative pressure.” Ex. 2008, 1598:1-14. Petitioner’s position at trial was *not* that no intermediate component can be involved in collecting the first portion of the blood sample, but was simply what Petitioner’s attorney stated at trial: if “the drawing force comes from the bladder *instead of* from the vacuum at the outlet, that is no infringement.” Ex. 2008, 1808:14-17 (emphasis added). In the prior art, the drawing force comes from the vacuum at the outlet, and there is no discrepancy. *See* Pet., §§VI.A.1.d, VI.A.13.d.

Petitioner’s accused device, that the jury found did not infringe the ’052 Patent, operates differently from Bullington800 because in Bullington800 the drawing force comes from the vacuum at the outlet and not from a bladder or some other component. Ex. 2007, p. 10. The Petition explains that in Bullington800 “the **chamber**...draws a flow of blood from the patient when *the suction force introduced by the syringe coupled to the outlet port* pulls the **first member 537** (increasing the

2008, 1600:5-10, 1887:9-13. And there is no inconsistency between the way the construction was applied in District Court and the Petition. At trial, Petitioner's expert explained that in the noninfringing product the housing "requires the button in combination with the housing...to *form* the sampling channel" and that in operation "when [the button is] completely depressed, it creates a pathway....this pathway is *only created* once the button is pressed...." Ex. 2008, 1600:12-1601:19 (emphasis added). The below images show that in the noninfringing product the sampling channel simply does not exist (left image) until the button is pressed (right image), and the button is not part of the housing.



Ex. 2002, pp. 119-123.

The noninfringing product is readily distinguishable from Bullington800. Remove the **valve** and the **first member** from Bullington800, and the **sampling channel** still exists, with its limits fixed or defined by the housing. See Ex. 1012, Figs. 16, 17, above. On the other hand, remove the button from the noninfringing product and there is no sampling channel "connected with the inlet port and

configured to convey a subsequent portion of the blood sample to the outlet port” as claimed. And that is exactly what was argued at trial: “Without the button, there is no sampling channel.” Ex. 2008, 1808:18-1809:1. Patent Owner is thus wrong to state that Petitioner argued the sampling channel “could not be defined by *anything but* the housing.” DD Brief, p. 19.

Accordingly, there is no discrepancy between the constructions applied and the arguments made at trial, versus those made in the petition.

C. The *Fintiv* Factors Favor Institution

The circumstances surrounding this Petition and the corresponding litigation are distinguishable from the typical situation contemplated by the Board when it set forth the factors to consider for discretionary denial in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). The *Fintiv* decision dealt with the question of whether IPR “would be an inefficient use of Board resources in light of the ‘advanced state’ of the parallel district court litigation **in which the petitioner had raised the same invalidity challenges.**” *Fintiv*, Paper 11 at 2 (citation omitted) (emphasis added). But here invalidity based on §§ 102 or 103 was not raised at trial and the Board will be the first to determine whether the prior art renders the claims unpatentable. To any extent that the *Fintiv* factors apply, the factors collectively favor institution.

1. Factor 1: Whether A Stay Exists Or Is Likely To Be Granted

No stay is necessary here to “allay[] concerns about inefficiency and duplication of effort.” *Fintiv*, Paper 11 at 6. The corresponding litigation’s trial ended December 16, 2025, when the jury rendered a verdict. Ex. 2007. As explained above, Petitioner did not argue invalidity under §§ 102 or 103 at trial. No adjudication of invalidity of the ’052 Patent in light of the prior art will occur on the merits before a final written decision is issued by the Board. There is thus no risk of duplicating the efforts of the jury, or of the parties in arguing before the jury, to adjudicate invalidity of the ’052 Patent over the prior art on the merits. This factor favors institution.

2. Factor 2: Proximity of the court’s trial date to the Board’s projected statutory deadline

Trial in the corresponding litigation began on December 8, 2025, but trial on the invalidity of the ’052 Patent in light of the prior art never occurred, and is not scheduled, because Petitioner did not argue invalidity over the prior art at trial. Thus, there is currently no District Court trial date in proximity to the projected May 25, 2027 deadline for the Board’s final written decision. This factor favors institution.

3. Factor 3: Investment In The Parallel Proceeding

The investment in the parallel proceedings is limited by the fact that invalidity over the prior art was not an issue raised at trial. Patent Owner alleges that by the time of the likely institution decision (May 2026) “a jury will have heavily invested

in the District Court proceeding.” DD Brief, p. 10. Patent Owner’s argument is misleading—the jury will not have made any investment in the District Court proceeding for issues relevant to this Petition, because invalidity in light of the prior art was not put before the jury. *See* Ex. 2007; *Intel Corp. v. VLSI Tech. LLC*, IPR2019-01192, Paper 15 at 11 (PTAB Jan. 9, 2020) (“When considering the impact of parallel litigation in a decision to institute, the Board seeks, among other things, to minimize the duplication of work by two tribunals to resolve the same issue.”).

The circumstances surrounding this Petition and the corresponding litigation are distinguishable from the *Azurity* case. Unlike *Azurity*, here there is no risk of an inconsistent decision, and the fact that invalidity in light of the prior art was not before the jury limits the concerns of duplicative efforts or additional expenses for the parties. *See Azurity Pharmaceuticals, Inc. v. Heron Therapeutics, Inc.*, PGR2025-00035, Paper 11 at 2-3 (PTAB Acting Director Aug. 14, 2025) (noting the concerns with a final written decision issuing after trial were “significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions.”).

The above facts all lessen the relevance of the prior investment in the co-
ending litigation. And, the Petition was filed within a timeframe, after being served the Complaint, that the Board has recognized as diligent. *See Intel Corp.*, Paper 15 at 12 (eleven months); *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15 at

11-12 (PTAB Oct. 21, 2020) (a year).

To any extent that this factor weighs against institution, it is not of sufficient weight to warrant denial.

4. Factor 4: Overlap Between Issues Raised In The Petition And In The Parallel Proceeding

The issues raised in the Petition were not presented at trial, and there is no risk of inconsistent decisions. As the Board stated in *Fintiv*, “if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution....” *Fintiv*, Paper 11 at 12-13.

Patent Owner’s argument that there was “substantial overlap” is misleading. Petitioner never argued invalidity over Bullington800, or any §§ 102 or 103 art, to the jury. Bullington800 was never even entered into evidence at trial. Patent Owner mentions Petitioner’s motion for summary judgment on invalidity over Bullington800, but fails to mention that the motion was denied because there were disputed material facts (Ex. 2004, p. 2), and those disputed facts were never tried. Moreover, the Petition includes additional strong grounds for invalidity that rely on references not included in the motion.

Also, Petitioner filed a *Sotera* stipulation in accordance with the language suggested in the USPTO’s October 16, 2025, Notice of Proposed Rulemaking. Pet., § VIII. Contrary to Patent Owner’s argument, Petitioner did not “g[i]ve up nothing

with its stipulation.” DD Brief, p. 12. Petitioner gave up its right to raise invalidity over the prior art at trial, and has “done its part to ‘mitigate[] any concerns of duplicative efforts.’” *Luminex Int’l Co. v. Signify Holdings B.V.*, IPR2024-00101, Paper 20 at 30 (PTAB Nov. 21, 2024); *see also Shenzhen TuoZhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00611, Paper 10 at 3 (PTAB Acting Director Jul. 17, 2025) (listing “a broad stipulation” as one of the factors that “tip the balance against discretionary denial.”).

This factor weighs heavily in favor of institution.

5. Factor 5: The Parties’ Relationships

The parties to the corresponding litigation are the same as the parties to this IPR. This factor does not overcome the weight of the factors favoring institution.

6. Factor 6: Petitioner Deserves Efficient Resolution of Validity Over the Prior Art

Petitioner presents compelling unpatentability challenges based on Petitioner’s own art and other art absent from the prosecution history that merit institution, especially in light of Patent Owner’s failure to disclose highly relevant art it knew or should have known of, and the subsequent errors committed during prosecution.

Further, efficiency and integrity favor resolving the patentability of the ’052 Patent in the tribunal most apt at resolving what is essentially a question of which party first disclosed the features claimed in the ’052 Patent. *See Thryv, Inc. v. Click-*

To-Call Techs., LP, 590 U.S. 45, 54 (2020) (“Congress . . . sought to weed out bad patent claims efficiently” through IPRs). The PTAB is the best tribunal to provide a consistent decision—validity can be resolved, avoiding duplicative efforts and inconsistent outcomes across potential future lawsuits involving the ’052 Patent.

For at least these reasons, the *Fintiv* factors weigh against denial.

IV. CONCLUSION

Review should be instituted and Claims 1-24 canceled.

Dated: February 25, 2026

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CERTIFICATION UNDER 37 CFR §42.24(d)

Under the provisions of the Interim Processes for PTAB Workload Management and 37 CFR §42.24, the undersigned hereby certifies that the page limit for the foregoing Petitioner's Brief Against Discretionary Denial totals 20 pages, which is equal to the allowed pages under the Interim Director Discretionary Process.

Pursuant to 37 C.F.R. §42.24(a)(1), this count does not include the table of contents, the table of authorities, mandatory notices under §42.8, the certificate of service, this certification of word count, the claims listing appendix, or appendix of exhibits.

Dated: February 25, 2026

By: /Frederic M. Meeker/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that I caused a true and correct copy of this **PETITIONER'S BRIEF AGAINST DISCRETIONARY DENIAL** in connection with IPR2026-00097 to be served via e-mail on February 25, 2026, in its entirety on the following counsel of record for Patent Owner:

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Dated: February 25, 2026

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