

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EOPTOLINK TECHNOLOGY USA INC.,

Petitioner,

v.

APPLIED OPTOELECTRONICS, INC.,

Patent Owner.

Case IPR2026-00122
Patent No. 10,714,890

**PATENT OWNER'S REQUEST TO DIRECTOR FOR DISCRETIONARY
DENIAL OF PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT 10,714,890**

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

TABLE OF CONTENTS

	Page(s)
EXHIBITS	iv
I. INTRODUCTION	1
II. FACTUAL BACKGROUND	1
A. The ‘890 Patent	1
B. Prior and Pending Petitions for IPR Filed Against AOI Patents	2
C. The Litigation Between AOI and Eoptolink	2
D. The Petition for <i>Inter Partes</i> Review	3
III. INSTITUTION OF <i>INTER PARTES</i> REVIEW SHOULD BE DENIED PURSUANT TO THE DIRECTOR’S DISCRETION.	4
A. The Issues in the Petition Overlap the Issues in the Litigation.....	5
B. The Parties Have Invested in the Litigation by Addressing Substantive Issues.....	7
C. There Are Settled Expectations in the ’890 Patent.	7
D. Petitioner and the Defendant are the Same Parties.	7
E. There are No Relevant Changes in the Law that Affect Patentability.....	7
F. Any Search Disclosure Declaration filed by Petitioner Does Not Favor Institution.	8
IV. CONCLUSION.....	8

TABLE OF AUTHORITIES

	Page(s)
Federal Cases	
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11	5, 7
<i>Next Caller Inc. v. Trustid, Inc.</i> , IPR 2019-00963, Paper 8.....	6
Federal Statutes	
35 U.S.C. § 102	3
35 U.S.C. § 103	3
35 U.S.C. § 316(a)(11).....	4
Other Authorities	
Japanese Patent Publication No. JP 2010-161146, Ex. 1004	4
PTAB’s “Consolidated Trial Practice Guide – November 2019”	4
U.S. Patent No. 6,837,627.....	3
U.S. Patent No. 6,841,733.....	3
U.S. Patent No. 9,306,371, Ex. 1006	4
U.S. Patent No. 9,331,789.....	3
U.S. Patent No. 9,385,830.....	3
U.S. Patent No. 9,385,830, Ex. 1005	4
U.S. Patent No. 9,448,367.....	2
U.S. Patent No. 10,578,818.....	2
U.S. Patent No. 10,714,890.....	<i>passim</i>
U.S. Patent No. 11,177,887.....	2

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	Petitioner Eoptolink’s Invalidity Contentions in <i>Applied Optoelectronics, Inc. v. Eoptolink Technology USA Inc.</i> , case no. 5-24-cv-08165-NW (N.D. CA) served on August 18, 2025
2004	District Court’s Case Management and Trial-Setting Order in <i>Applied Optoelectronics, Inc. v. Eoptolink Technology USA Inc.</i> , case no. 5-24-cv-08165-NW (N.D. CA) filed September 8, 2025
2005	Director Squires’ November 17, 2025 Memorandum entitled “Voluntary Search Disclosure Declarations as a Favorable Factor in Institution Decisions”
2006	District Court’s Order Granting Joint Administrative Motion to Stay as Modified in <i>Applied Optoelectronics, Inc. v. Eoptolink Technology USA Inc.</i> , case no. 5-24-cv-08165-NW (N.D. CA) filed January 13, 2026

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 Eoptolink Technology USA Inc. (“Petitioner”) for an *inter partes* review (“IPR”) of U.S. Patent No. 10,714,890 (the “’890 Patent”, Exhibit 1001) entitled “Transmitter Optical Subassembly Arrangement with Vertically-Mounted Monitor Photodiodes.”

The Director should exercise his discretion and deny the Petition for IPR in this case because there are settled expectations in this patent that is five and a half years old and thus is in its sixth year of enforceability as well as for the other reasons set forth below.

II. FACTUAL BACKGROUND

A. The ‘890 Patent

Application no. 16/268,765 for the ’890 Patent was filed on February 6,

2019. *See* “’890 Patent File History,” Exhibit 1002. (Please see Exhibit 1002 for the full prosecution history.) The ’890 Patent issued on July 14, 2020 with 19 claims, including three independent claims.

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

In addition to this petition for IPR of the ’890 Patent, Petitioner has also filed petitions for IPR of three other AOI patents, U.S. Patent No. 9,448,367 (“’367 Patent”) (filed jointly with another party); U.S. Patent No. 10,578,818 (“’818 Patent”); and U.S. Patent No. 11,177,887 (“’887 Patent”). AOI has filed Requests to Director for Discretionary Denial of Petitioner’s petitions for IPR of the ’367 Patent and the ’818 Patent, all on grounds similar to those asserted in this Request.

C. The Litigation Between AOI and Eoptolink

On November 19, 2024, AOI filed a lawsuit against Petitioner for patent infringement entitled *Applied Optoelectronics, Inc. v. Eoptolink Technology USA Inc.*, case no. 5:24-cv-08165-NW (N.D. CA) (the “Litigation”). The complaint alleges that Petitioner infringes six of AOI’s patents, including the ’890 Patent. In the Litigation, Petitioner alleges that each of the six patents-in-suit is invalid. Petitioner has filed petitions for IPR of four of the six patents.

On June 13, 2025, AOI served its infringement contentions, stating that Petitioner infringes claims 1–3, 5, and 7 of the ’890 Patent. On August 18, 2025,

Petitioner served its invalidity contentions. *See* Exhibit 2003. Petitioner contends that claims 1–3, 5, and 7 are invalid under either 35 U.S.C. § 102 or § 103 on four grounds based on five different references. The following grounds asserted in the Litigation by Petitioner are relevant here: (1) Claims 1–3, 5, and 7 are obvious over U.S. Patent No. 9,331,789 to Sato (“Sato-1”) in view of U.S. Patent No. 9,385,830 to Sato (“Sato-2”); (2) Claims 1–3, 5, and 7 are obvious over U.S. Patent No. 6,841,733 to Schiaffino in view of Sato-2 and/or Sato-1; and (3) Claims 1–3, 5, and 7 are obvious over U.S. Patent No. 6,837,627 to Nakanishi in view of Sato-2 and/or Sato-1.

Between June 2025 and December 2025, AOI and Petitioner exchanged initial disclosures, and infringement and invalidity contentions. On December 5, 2025, AOI and Petitioner filed a Joint Administrative Motion to Stay Pending IPR Institution Decisions based on Petitioner’s petitions for IPR. On January 13, 2026, the District Court entered an order granting the motion and staying the case until June 5, 2026, and requiring the parties to file status reports in the event of any decisions on Petitioner’s petitions for IPR of the patents-in-suit. *See* Exhibit 2006.

D. The Petition for *Inter Partes* Review

On November 25, 2025, almost one year after AOI filed its complaint in the Litigation, Petitioner filed its Petition for IPR of the ’890 Patent.

In the Petition, Petitioner challenges claims 1–9 and 15–19 of the ’890 Patent. Petitioner asserts three grounds of invalidity: (1) Claim 1 is anticipated by Takashi (Japanese Patent Publication No. JP 2010-161146, Ex. 1004); (2) Claims 2–9 are obvious over Takashi in view of Sato-2 (U.S. Patent No. 9,385,830, Ex. 1005); and (3) Claims 15–19 are obvious over Ho (U.S. Patent No. 9,306,371, Ex. 1006) in view of Takashi in further view of Sato-2.

Pursuant to the Notice of Filing Date, Patent Owner’s Preliminary Response is due by March 3, 2026. Pursuant to the PTAB’s “Consolidated Trial Practice Guide – November 2019” and the Director’s October 17, 2025 Memorandum (Exhibit 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 June 3, 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 June 3, 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 ’890 Patent. The following factors support a discretionary denial:

- There is overlap between the issues in the Petition and in the Litigation.

Certain claims, grounds, and art are the same or substantially the same.

- There has been significant investment in the Litigation in that substantive issues have already been addressed by the parties.
- There are settled expectations in the enforcement of the '890 Patent as the patent has been in force for five and a half years and thus is in its sixth year of enforceability.
- Petitioner and the defendant in the Litigation are the same party.
- There are no relevant changes in the law that affect patentability.
- Any Search Disclosure Declaration (“SDD”) filed by Petitioner pursuant to Director’s November 17, 2025 Memorandum is at a most a neutral, rather than favorable, factor with respect to this Petition because Petitioner relies solely on patents and published patent applications, and Petitioner does not rely on any prior art stemming from currently unknown search pathways.

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

A. The Issues in the Petition Overlap the Issues in the Litigation.

There is overlap between the issues (claims, art, arguments, and evidence) asserted in the Petition and in the 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, a subset of the claims challenged in the Petition (claims 1–9 and 15–19) are challenged in the Litigation (claims 1–3, 5, and 7).

Second, one of the references relied upon in the Petition (Sato-2), which forms part of the basis of two of the three grounds asserted in the Petition, is also relied upon by Petitioner in three of the four invalidity grounds asserted in the Litigation. *See* Ex. 2003, p. 9.

Third, two of the grounds for invalidity asserted in the Petition are similar to three of the grounds asserted in the Litigation. Specifically, in Ground 2 of the Petition, Petitioner argues that Claims 2–9 are obvious over Takashi in view of Sato-2. In Ground 3 of the Petition, Petitioner argues that claims 15–19 are obvious over Ho in view of Takashi in further view of Sato-2. In the Litigation, Petitioner argues that claims 1–3, 5, and 7 are obvious over Sato-1 in view of Sato-2, obvious over Schiaffino in view of Sato-2 and/or Sato-1, and obvious over U.S. Nakanishi in view of Sato-2 and/or Sato-1.

Moreover, Petitioner’s challenges to the ’890 Patent in the Litigation involve three other references and other grounds that are not asserted in the Petition. And the Litigation also involves five other patents. The fact that the Litigation involves additional challenges to the ’890 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).

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

The Litigation has progressed substantively. The parties have exchanged initial disclosures, infringement contentions, and invalidity contentions.

C. There Are Settled Expectations in the '890 Patent.

The '890 Patent was issued on March 3, 2020. The patent has been in force for five and a half years and thus is in its sixth year of enforceability. Therefore, there are settled expectations that the '890 Patent is valid and enforceable. For this reason alone, the Director should exercise his discretion and deny Petitioner's request for IPR of the '890 Patent.

D. Petitioner and the Defendant are the Same Parties.

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

E. 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 '890 Patent issued. Accordingly, this factor weighs in favor of denial of institution. *See Memorandum, Exhibit 2001, p. 2.*

F. Any Search Disclosure Declaration filed by Petitioner Does Not Favor Institution.

Any Search Disclosure Declaration (“SDD”) filed by Petitioner pursuant to the Director’s SDD Memo is at most a neutral, rather than favorable, factor with respect to this Petition because Petitioner relies solely on U.S. patents and published patent applications for its invalidity arguments. *See, e.g.*, Exhibits 1003–1005.

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* Exhibit 2005 at p. 2 (emphasis added). Given that two of the three references that Petitioner relies upon in its Grounds for alleging invalidity are U.S. patents, finding these alleged prior art references neither requires, nor reveals, “*new or underutilized pathways relevant to Office search practice.*” *Id.*

Thus, to the extent that Petitioner may argue that other references located via its 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 '890 Patent.

Dated: February 3, 2026

/Jo Dale Carothers/

Jo Dale Carothers (Reg. No. 74,180)

Weintraub Tobin Law Corporation

400 Capitol Mall, 11th Floor

Sacramento, CA 95814

Phone: 858.436.8152

Fax: 916.446.1611

Email: jcarothers@weintraub.com

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 10,714,890 (Pursuant to Acting Director's Memorandum of March 26, 2025 and Director's Memorandum of October 17, 2025)**, which was served on February 3, 2026 to the following Counsel for Petitioner via e-mail:

Arpita Bhattacharyya
Perkins Coie LLP
3150 Porter Drive
Palo Alto, CA 94304
Bhattacharyya-ptab@perkinscoie.com

Robert F. McCauley
Perkins Coie LLP
3150 Porter Drive
Palo Alto, CA 94304
rmccauley@perkinscoie.com

Taryn Willett
Perkins Coie LLP
3150 Porter Drive
Palo Alto, CA 94304
TWillett@perkinscoie.com

/Eric Caligiuri/
Eric Caligiuri (Reg. No. 58,121)
Weintraub Tobin Law Corporation
400 Capitol Mall, 11th Floor
Sacramento, CA 95814
Phone: 858.436.3140
Fax: 916.446.1611
Email: ecaligiuri@weintraub.com