

IPR2026-00141
U.S. Patent No. 11,627,242

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIRD BUDDY, INC.

Petitioner,

v.

FREDERICK PERKINS

Patent Owner.

Case No. IPR2026-00141
U.S. Patent No. 11,627,242

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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PATENT OWNER’S EXHIBIT LIST

Exhibit No.	Description
2001	License Agreement (Redacted) between Perkins and Woodstream dated July 31, 2023
2002	Correspondence between Inventor Perkins and Mr. Buzzard, May 2023
2003	<i>Woodstream et al v. Bird Buddy Inc.</i> , C.A. No. 1:24-cv-01236-JCB (D. Del.), D.I. 1, Complaint (November 8, 2024)
2004	Intentionally Left Blank
2005	U.S. Patent No. 9,247,719 – Bennett
2006	U.S. Patent No. 9,137,974 – Boehm
2007	Morris, A., “IPBC Global 2025: Acting USPTO Director Says IPR Use Needs to Change,” IAM (June 10, 2025)
2008	Answer to Amended Complaint and Counter Claims, filed September 5, 2025 (Case 1:24-cv-01236-JCB, Doc. 32)
2009	Scheduling Order (Case 1:24-cv-01236-JCB, Doc. 38)
2010	Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” (“Guidance Memo”) (March 24, 2025, available at: https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf)

Woodstream Corporation (“Woodstream”) and Patent Owner Frederick Perkins (“Perkins” or “Applicant”) respectfully submit this brief (“Discretionary Denial Brief”)¹ requesting that the Board exercise its discretion to deny institution of Bird Buddy, Inc.’s (“Petitioner” or “Bird Buddy”) Petition for *inter partes* review (“Petition”) challenging claims 1-6 of U.S. Patent No. 11,627,242 (the “’242 Patent”). Denial is warranted under 35 U.S.C §§ 314(a), (d), and 325(d), and in light of *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (“*Advanced Bionics*”), and *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (“*Fintiv*”).

I. INTRODUCTION

Institution of IPR would waste Board resources and should be denied under 35 U.S.C §§ 314(a), (d), and 325(d). First, the ’242 Patent underwent nearly eight years of prosecution, including two PTAB appeals—both resolved in the Applicant’s favor. Further review of the ’242 Patent is unmerited. Section 325(d) was enacted to prevent the resurrection of previously resolved and thoroughly considered prosecution issues. Discretionary denial is warranted on that basis alone.

Second, and in addition to denial under § 325(d), denial under the *Fintiv* factors and § 314(a), (d), is also warranted to prevent both the court and the parties

¹ This Discretionary Denial Brief is timely submitted given the Notice of Filing Date issued December 1, 2025. Paper 4.

from expending substantial resources in parallel proceedings, creating inefficiency and a risk of inconsistent outcomes. The Petition mirrors the invalidity arguments pending in parallel district court litigation. (*See* EX2008). No stay has been sought or indicated. The Scheduling Order (EX2009) provides for a *Markman* claim construction determination well before the projected Final Written Decision (“FWD”) date, and jury selection and trial is scheduled to begin in close proximity to the projected FWD date, if instituted. Petitioner may have submitted a *Sotera* stipulation (Paper 2), but potential substantive overlap remains as explained below. Patent Owner also has settled expectations. Each of these reasons favors denial.

II. THE PETITION SHOULD BE DENIED UNDER § 325(D)

A. Applicable Law

Discretionary denial is warranted under 35 U.S.C. § 325(d) because the Petition relies on the same or substantially the same prior art and arguments previously presented to the Office, and Petitioner fails to identify any material error in the Office’s patentability analysis. The Director may deny institution when “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). *Advanced Bionics* provides a two-part framework for evaluating whether denial under section 325(d) is warranted: (1) whether the same or substantially the same prior art or argument previously was presented to the Office; and (2) if the first part is satisfied, whether the petitioner has demonstrated

that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics at 8. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*,

IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) provides insight into how to apply the *Advanced Bionics* framework to

325(d). The Board has identified the following non-exclusive factors in evaluating whether to exercise discretion pursuant to § 325(d):

(a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art; (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Id. at 17–18. Factors (a), (b), and (d) relate to the first portion of the *Advanced Bionics* framework, and the remaining factors relate to the second portion of the framework. *Advanced Bionics*, Paper 6 at 10.

As to the first part of the *Advanced Bionics* framework, *Ecto World* has clarified that “[c]hallenging the claims using the same prior art that was previously presented on an IDS is sufficient to satisfy the first part of the *Advanced Bionics* framework.” *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 4 (PTAB May 19, 2025). And as to the second part of the *Advanced*

Bionics framework, *Ecto World* clarified that “if the Examiner applied the asserted prior art..., then the petitioner must demonstrate that ... the previously presented art teaches the limitations of the challenged claims, and **that no reasonable examiner could have found otherwise.**” *Ecto World*, Paper 13, at 6 (citing *Advanced Bionics* at 9 (“If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.”) (emphasis added). “[G]eneralized statements as to the strength of its Petition fail to identify sufficiently a material error.” *Ecto World*, Paper 13, at 6.

B. Analysis

Petitioner relies on three primary references in seeking review of the ’242 Patent—U.S. Pat. Pub. 2016/0106072 (EX1005 (“Bennett”)), U.S. Pat. Pub. 2012/0048203 (EX1006 (“Bonham”)), and U.S. Pat. Pub. 2007/0295277 (Ex 1007 (“Kin”))—for Grounds 1, 2, and 3, respectively. (Pet. pp.35–36). Each reference is cited against the ’242 Patent’s independent claim 1. The remaining Grounds 1A-1C, 2A-2C, and 3A-3C rely on one of these primary references—Bennett, Bonham, and Kin, respectively—together with additional secondary references, to challenge the dependent claims depending from claim 1. Because each primary reference constitutes previously considered art or art that is substantially similar to previously considered prior art and arguments, denial is warranted.

1. USPTO Properly Considered Bennett (Grounds 1, 1A, 1B, 1C)

Petitioner relies on Bennett (EX1005), a continuation publication with an identical disclosure to Bennett '719 (EX2005), which was expressly considered during prosecution of the '242 Patent. Bennett '719 was first cited in the initial Office Action (EX1004 p.52), and later applied against dependent claims 3 and 12 in combination with other references in a Final Action (EX1004 pp.241, 245, 246). Further, as reflected in the Examiner's Answer to Appeal brief, the Office previously considered and cited Bennett '719's teaching of a gravity-fed bird feeder. (EX1004 pp.328–329). Because Bennett '719 is identical to Bennett, part one of *Advanced Bionics* is met. Therefore, the burden is on Petitioner to prove under part two of *Advanced Bionics* that the Office materially erred.

Petitioner contends that the Examiner failed to properly consider Bennett, as being applied only to dependent claims, and not as a primary reference against independent claim 1. (Pet. p.26, n.1). Because this is contradicted by the record and Petitioner provides no other basis for the Examiner to have committed material error, much less that no reasonable examiner could have found otherwise, Petitioner has not met its burden, warranting denial.

During examination, the Examiner considered Bennett to be “pertinent” art. (EX1004 p.52). Each subsequent Office Action included Bennett as references considered, and the Examiner applied it against dependent claims in a Final Office Action. (EX1004 pp.241, 245, 246). Because the Examiner applied Bennett to the

claims during examination, Petitioner cannot argue Bennett was overlooked. Instead, the evidence shows the Examiner considered Bennett carefully, understood its teachings, and applied it to dependent claim 3. (*See, e.g.*, EX1004 pp.241, 245–246). Dependent claims necessarily incorporate each and every limitation of its independent claim. Thus, the Examiner must have considered Bennett for each element of claim 1 in analyzing claim 3. Further, the Examiner continued to apply Bennett after several rounds of office actions and a first appeal, which underscores the Examiner’s awareness, reevaluation, and application of the relevant art.

Additionally, in the second appeal, the Board acknowledged Bennett (*see, e.g.*, EX1004 p.343) and noted that the Examiner did not expressly rely on Bennett to teach the limitations of claim 1 (EX1004 p.349). The Board could have (but did not) formulate a new ground of rejection against claim 1 based on Bennett. If the Board decided that Bennett clearly provided all the elements of claim 1, the Board could have designated a new ground of rejection in the decision consistent with 31 C.F.R. § 41.50(b). Instead, the Board decision noted that certain elements of claim 1 were lacking in the art cited against claim 1, and those elements were not cited as being provided by Bennett (EX1004 p.349). The Board, with full knowledge of the pending claim 1, as well as the teachings of Bennett, declined to present a new ground of rejection based on Bennett, and instead *reversed* the Examiner’s decision rejecting claims 1 and 3, affirming Bennett does not disclose each and every element

of claim 1. For at least these reasons, Petitioner cannot demonstrate that the Office overlooked Bennett in prosecution of the '242 Patent, and instead it was used as a basis for rejection which was ultimately overturned by the Board.

Because of the Examiner *and* the Board's consideration of Bennett, Petitioner must show Bennett teaches the limitations of the challenged claims, and that no reasonable examiner could have found otherwise. *Ecto World*, Paper 13, at 6. But instead, Petitioner relies on its own generalized statements concerning the merits of the Petition in arguing that Bennett teaches all limitations of claim 1 *and* claim 3 as part of Ground 1 even though it has relied on Bennett as a single 103 reference; thus implying that Bennett does not disclose each and every claim element. (Pet. p.26 n.1 ("As will be shown below, Bennett... fully discloses the independent claims.").) This is fatal to the Petition. Paper 13, at 6.

Nevertheless, the Petition misconstrues Bennett's teachings—particularly the location or manner of mounting Bennett's imaging sensors 113.² For example, Petitioner states "[Bennett's] *cameras (112) may be located in the cap of the bird feeder or nested along or in the sides of the bird feeder*, as shown in FIG. 1A. (EX1001 ¶¶ 37-40; EX1005 ¶ 49)." (Pet. p.28) (emphasis added). Petitioner also relies on its expert's declaration, which similarly mischaracterizes Bennett and relies

² Bennett interchangeably numbers the imaging or audio sensors as 112 and 113; *compare* [0078] *with* [0081] of US Publ. 20160106072.

on circular logic, stating “...the cameras are internally mounted. POSITA would have been able to tell the cameras were internally mounted because the cameras that are mounted in the caps are mounted inside the caps and protrude outward...” (EX1001 ¶101). The arguments fail. Bennett’s Figures 1A and 3A (EX1005), *do not* teach imaging sensors 113 *internally* mounted *in* the cap 136, nor *internally* mounted into the sides of the vessel 101 of the bird feeder. Instead, with reference to Bennett’s figures, the imaging sensors 113 appear to be *surface* mounted, and not provided “in the cap of the bird feeder” nor “in the sides of the bird feeder.” Rather, imaging sensors 113 are positioned on a support *surface*, such as the underside of the cap 136 in Figure 3A, or sides of the vessel 101 in Figure 1A (EX1005). Bennett further teaches “The cap 136 may also be fitted with electrical loads [...] or fitted with sensors such as, but not limited to, audio 112 and imaging 113 sensors depicted mounted *to* the cap 136 in FIG. 3A.” (EX1005, [0040]) (emphasis added).

Turning to the ’242 Patents claim language, claim 1 requires “...the camera *internally* mounted to the bird feeder” such that it “is aligned with the feed port to observe feeding birds;” (EX1003, claim 1) (emphasis added). This limitation is not taught by Bennett, providing a distinction between claim 1 and Bennett, such that there was no material error.

In light of the above, Petitioner’s generalized argument that “material error” occurred in application of Bennett to the prosecution of ’242 Patent dissolves into a

simple disagreement with the Examiner's and the Board's well-reasoned judgment, and therefore warrants denial.

2. *USPTO Properly Considered Art Substantially Similar to Bonham (Grounds 2, 2A, 2B, 2C)*

Bonham (EX1006) discloses a bird house with a camera positioned above the interior and oriented to monitor the inside the housing (Ex 1006, Abstract and Fig. 1). Bonham is substantially duplicative of Boehm, which the Examiner identified as pertinent art. (EX1004 p.52). Boehm teaches "...automatically detecting the presence of a bird in a housing. The housing can be adapted to substantially surround the bird. The housing can define an aperture adapted for the bird to enter and exit the housing." (EX2006, Abstract). Like Bonham, Boehm has a housing with an aperture sized for bird passage ([0008]), and provides a sensor 2640, such as a camera ([0036]) positioned above the enclosure interior, for monitoring the interior of the housing to detect birds within the housing (EX2006, [0019], Figs. 1,2). Thus, for all aspects relevant to claim 1 of the '242 Patent, Boehm and Bonham are substantially similar, and their teachings are substantially duplicative, for purposes of comparison to the challenged claim. Accordingly, Bonham raises substantially the same art and teachings as the previously considered Boehm.

The Office did not make a material error in allowing the '242 Patent over Boehm (providing a bird trap with a monitoring camera). Instead, in raising Bonham (directed to a bird house with a camera), Petitioner raises substantially duplicative

art. Petitioner is attempting to circumvent the Examiner's judgment by proposing a new reference that is cumulative to Boehm in all material aspects relevant to the claims of the '242 Patent. Examiner noted Boehm as pertinent and part of the record (EX1004 p.52). The Examiner determined that '242 Patent was patentable over Boehm, in view of the full prosecution record. Petitioner's disagreement with that judgment does not establish error, particularly where the Examiner elected not to apply Boehm in any rejection and the claims were adjudicated through two Boards of Appeal. To the contrary: the Examiner identified and considered Boehm as pertinent in the first office action (EX1004 p.52), and then did not apply Boehm in any other rejection through the remainder of the prosecution.

Petitioner does not identify any misunderstanding or misapprehension in the record with regard to Boehm. Instead, Petitioner merely disagrees with the Examiner's judgment, and seeks to supplant the Examiner's analysis. Introducing Bonham, however, requires unreasonably misinterpreting the language of the '242 Patent, as the '242 Patent teaches a bird *feeder*, while Bonham is expressly directed to a bird *house*, like Boehm is expressly directed to a bird *trap*. The Examiner's decision to minimally cite to Boehm is reasonable in light of Boehm not teaching nor suggesting several limitations of the '242 Patent's claims. For example, Boehm is directed to a housing having a sensor 2640 (e.g., camera) for recognizing a bird that has entered the housing (EX2006, [0019], Figs. 1, 2). Boehm, like Bonham,

would not be considered to provide, for example, a bird feeder having a feeder housing, a feeder bottom, and a feed port disposed on the feeder bottom, with a camera disposed in close proximity to the feed port, as required in originally filed claim 1 of the '242 Patent (EX1004 pp.30–32). Accordingly, there is no material error in the Office's earlier consideration of Boehm, and Petitioner should not be allowed to supplant Boehm with a substantially duplicative reference, Bonham.

3. *USPTO Properly Considered Art Similar to Kin (Grounds 3, 3A, 3B, 3C)*

Kin (EX1007) discloses a pet feeding station (*see* Fig. 2) that provides food and water to pets by filling respective bowls, controllably supplying either food or water to each of the filling areas 351, 352 provided in base 35. Kin also teaches "...the photo of the environment and the sound of the pet is sent to the operating device 1 through the image acquisition device 321 and the microphone 322 of the input unit 32 so that the pet raiser sees the environment and the status of the pet through the operating device 1..." (EX1007, [0017]).

Kin is substantially duplicative of Sung, which was repeatedly considered through prosecution of the '242 Patent, including an appeal to the PTAB. (EX1004 pp.207–209). Sung likewise teaches a system for providing food to an animal, where the "system may include an animal scale, a food tray, a food scale, a water tray, a water scale, a facial camera, and a processor." (EX1019, [0003]). "The system may allow for an animal to be fed, watered, and their health monitored remotely by a user

. . .” (EX1019, [0019]). Sung, Fig. 2, depicts a pet feeder with separate food and water bins that each, respectively, supply the food and water when triggered to do so. Sung teaches a camera is provided “...for observing a face of the animal when the animal is facing at least one of the food tray or the water tray.” (EX1019, [0004]). The teachings of Kin directed to a pet feeder system are substantially duplicative of the previously considered art of Sung in all material aspects.

Further, Petitioner’s arguments supporting Kin against the claims of the ’242 Patent are substantially similar to those the Examiner provided in citing Sung. The Examiner cited Sung as providing a “smart animal system that provide food and camera system that observed and identify animals, therefore Sung Smart Animal Feeder system intended use can included bird, since bird is animals. [SIC]” (EX1004 p.107). Applicant appealed to the PTAB, noting the Sung reference does not disclose the limitations of Applicant’s claimed bird feeder, specifically identifying Sung as failing to disclose a *bird* feeder; instead merely teaching a generic feeder that would not be understood as a bird feeder. (EX1004 p.152 ((May 2, 2018 Appeal Brief)). The PTAB decision decisively rejected the Examiner’s arguments noting, “[Sung] fails to provide written description support for subject matter related to bird feeders disclosed in Sung ‘945 and asserted against the present application. Although the Examiner has asserted that birds may be a well-known type of pet, other than cats and dogs, the ‘461 Provisional provides no support for such a contention. In view of

the forgoing, we find the prior art fails to disclose (under § 102) or to teach or suggest (under § 103) each claimed limitation.” (EX1004 pp.207–209 (Sept. 3, 2019 Decision of Appeal (“DOA”))). Thus, the Board recognized Sung as teaching a *pet* feeding station but provides no teaching of a bird feeder as required in claim 1 of the ’242 Patent. The Office, acting through the PTAB in its adjudicatory capacity, has previously determined that a general pet feeder, such as provided by Sung, does not render the claims of the ’242 Patent unpatentable.

Petitioner raises substantially the same argument in Ground 3 of the petition (Pet. p.94). Petitioner states “Kin discloses a bird feeder because it is a pet feeder. (EX10001 ¶¶ 164-168; EX1007 ¶1)” (Pet. p.97). Petitioner’s arguments are therefore substantially duplicative of Examiner’s arguments in applying Sung, which the PTAB decisively rejected. (EX1004 pp.207–209 (DOA)).

Thus, to remain consistent with the Board decision, Kin may teach a remote interactive *pet* feeder but cannot be considered to provide a *bird* feeder. Where Petitioner cites Kin, it is in all material aspects to the claimed subject matter, substantially similar art, and relies upon similar arguments as raised with Sung, which were already rejected by the Board.

Petitioner does not argue against the Board’s decision rejecting Sung; but in raising Kin, Petitioner attempts to relitigate the same issues and arguments raised with regard to Sung—which the Board rejected outright. Specifically, the Board

rejected the Examiner's argument that Sung, while teaching a *pet* feeder, would anticipate a claim directed to a *bird* feeder (EX1004 pp.208–209). Kin *also* teaches a generic pet feeder that does not identify birds. Consequently, Kin is duplicative art, and mirroring Sung, does not disclose the bird feeder taught by the '242 Patent.

C. Conclusion

Under § 325(d) and the *Advanced Bionics* framework, discretionary denial is warranted. The Petition relies on art that is identical to or substantially the same as art previously considered, and Petitioner fails to demonstrate any material error in the Office's analysis. Institution would impermissibly undo the diligent work of the Examiner and two PTAB panels. Accordingly, the Board should deny institution.

III. INSTITUTION SHOULD BE DENIED UNDER § 314(A) AND *FINTIV*

Denial is also warranted under § 314(a) and the *Fintiv* framework. In this context, the Board considers six non-exhaustive factors: 1) Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; 2) Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision; 3) Investment in the parallel proceeding by the court and the parties; 4) Overlap between issues raised in the petition and in the parallel proceeding; 5) Whether the petitioner and the defendant in the parallel proceeding are the same party; and 6) Other circumstances that impact the Board's exercise of discretion, including the merits. *Fintiv*, IPR2020-00019, Paper 11 at 6. Here,

evaluation of the *Fintiv* factors favors denial.

A. Factor 1 – Absence of a Stay or Likelihood of Stay Favors Denial

No motion to stay has been filed in the Delaware District Court matter, and the court has given no indication that it would entertain a stay if one were presented. Even if requested, the District of Delaware seldom grants *pre-institution* stays—which is the current state of the proceedings here. *See, e.g., IOENGINE, LLC v. PayPal Holdings, Inc.*, C.A. No. 18-452-WCB, 2019 U.S. Dist. LEXIS 141545, at *19-20 (D. Del. Aug. 21, 2019) (collecting cases); *Invensas Corp. v. Samsung Elecs. Co.*, C.A. No. 17-1363, 2018 U.S. Dist. LEXIS 169999, at *6 (D. Del. Oct. 2, 2018). Consistent with *Fintiv* and the Board’s post-2022 decisions, this factor weighs in favor of discretionary denial.

B. Factor 2 – The District Court’s Expected Trial Activities in the Parallel Litigation Undercuts Institution

Fintiv instructs the Board to consider timing considerations and deadlines to prevent duplicative proceedings. In precedential *Apple, Inc. v. Ferid Allani*, the Board noted efforts in pretrial matters, e.g., discovery, claim construction, filing of infringement and invalidity contentions, may justify discretionary denial, stating “Even though a district court trial date that may occur after a projected final written decision date reduces the possibility of conflicting decisions, that benefit does not outweigh the efficiencies gained by avoiding parallel proceedings in this instance because of the parties’ meaningful investment in the court proceedings discussed

above.” IPR2025-00857, Paper 11 at 2-3 (PTAB Sept. 5, 2025).

In the current parallel proceedings ongoing in the District of Delaware Court (No. 1:24-cv-01236-JCB), the Court’s Scheduling Order provides for a *Markman* hearing on August 19, 2026, and jury selection and trial on June 21, 2027. (Ex 2009 pp.1, 4). If instituted, the Board’s projected FWD would be approximately June 1, 2027— only three weeks before the trial is scheduled to commence. Significant claim construction, discovery, and pretrial activity will occur prior to the FWD date. Because no stay has been requested, the District Court is likely to continue progress in parallel with these proceedings and may engage with the merits first or require duplicative efforts. The proximity of the trial date to the statutory FWD and likelihood of duplicative efforts in the parallel proceeding show that this factor weighs heavily in favor of discretionary denial.

C. Factor 3 –Parallel Proceeding Investment Favors Denial

Absent a stay, the parallel litigation will continue. The Scheduling Order sets the trial date three weeks after the projected FWD from the Board, if instituted (EX2009 pp.1, 4). Consequently, significant investment in resources and pretrial activities by both parties would occur before the Board’s projected FWD. To date, the parties and the court have already invested significantly in the Delaware action. Petitioner filed a motion to dismiss, which the Court denied. Discovery is ongoing, and a deposition of a third-party witness is scheduled, requiring additional and

ongoing investments. The investments made previously, along with the expectation that the litigation must continue in the absence of a request for a stay being filed, renders an IPR an inefficient duplication of effort, and weighs against institution.

D. Factor 4 – There Is an Overlap in Issues and Cumulative References Despite a *Sotera* Stipulation

There is substantive overlap between issues raised in the Petition and those before the District Court. Bird Buddy’s Answer to Amended Complaint and Counterclaims (EX2008) expressly cites Bonham in challenging the validity of the ’242 Patent. Similarly, Petition relies on Bennett, Bonham, and Kin—each of which is either identical to or cumulative of art previously considered in the ’242 Patents prosecution. (Pet. pp.36–37). Despite Petitioner’s *Sotera* stipulation (Paper 2), the Board’s recent guidance minimizes its impact. (*See* EX2010 pp.2–3) A *Sotera* stipulation may be relevant, but it is not dispositive, and all *Fintiv* factors should still be weighed. Further, the stipulation does not eliminate all substantial overlap, particularly where the litigation continues on parallel tracks, as is expected here, as the FWD will issue only several weeks before trial and may be appealed. Factor 4 thus favors denial.

E. Factor 5 – Identical Parties Favors Denial

The parties here and in the district court action are identical. Petitioner is the defendant, and Perkins and Woodstream are both plaintiffs in the underlying litigation. The Board has consistently treated this fact as weighing in favor of denial. *See Int’l Bus. Machines Corp. v. Digital Doors, Inc.*, IPR2023-00970, Paper 7 at 13

(PTAB Jan. 12, 2024) (“Because Petitioner here is a defendant in the parallel district court litigation, this factor favors denial of institution under § 314(a).”); *Ericsson Inc. v. Collision Comm., Inc.*, IPR2022-01233, Paper 12 at 16 (PTAB Jan. 19, 2023) (same). Factor 5 also favors denial.

F. Factor 6 – Other Circumstances (Merits, Settled Expectations, Workload Management) Factors Strongly Favor Denial

1. *Weak Merits*

Patent Owner has identified the problems inherent to Petitioner’s grounds, including erroneous claim parsing that mischaracterizes the invention. Grounds 1–3 relies on art identical to or cumulative of references already considered during prosecution. Bennett, cited in ground 1, contains the same content as art previously overcome and affirmed on appeal (see, e.g., EX1004 p.349) and does not teach all limitations of claim 1, notably lacking a camera that is *internally* mounted and aligned with the feed port. Bonham (EX1006) and Kin (EX1007) merely repackage cumulative references unrelated to a “bird feeder” (Boehm (EX2006) and Sung (EX1019), respectively) without adding materially different teachings. The Petition thus fails to present a compelling case for invalidity. These arguments will be developed further in the preliminary response.

2. *Settled Expectations*

In 2023, after the ’242 Patent issued, Inventor Perkins offered Bird Buddy a license; Bird Buddy said it would review the patent (EX2002) but did not pursue

a license. Woodstream later obtained an exclusive license with enforcement rights (EX2001), creating settled expectations. In *Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00950, Paper 11 at 3 (PTAB Sept. 19, 2025) (precedential), the Board ordered denial of institution and stated:

although the challenged patent has not been in force for a significant period of time (issued in 2021), Patent Owner presents evidence that it has licensed the challenged patent, which creates some settled expectations favoring Patent Owner.

In *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 3 (PTAB June 18, 2025) (precedential), the Board also noted that:

patent applications (after 18 months) and issued patents are almost always publicly available to provide notice to the public, other inventors, competitors, and commercial interests. 35 U.S.C. § 122. Interested parties may find published patents and patent applications using the Office's automated search systems as well as publicly available resources on the Internet. *See* 35 U.S.C. § 41(i). As such, actual notice of a patent or of possible infringement is not necessary to create settled expectations.

On top of actual notice provided in 2023 (EX2002), under *Dabico*, Petitioner had constructive notice a decade ago when US20160366319A1 was published in 2016. Petitioner could have challenged the validity of the '242 Patent at any point in the intervening year-and-a-half between actual notice and filing of the District Court complaint. (EX2003). Instead, Petitioner waited for nearly a year of litigation to file its Petition, exacerbating the risk of parallel proceedings. Instituting review under these circumstances would undermine settled expectations, reward delay (tactical or

not), and promote inefficiency. Accordingly, institution should be denied.

3. *PTAB Workload*

Under the Director’s March 24, 2025 Memorandum (EX2010), the Board may consider its workload when deciding whether to institute “redundant or low-value” proceedings. This proceeding falls squarely within that category. The Director has also emphasized that the PTAB should focus on “important cases” and does not “need to be an on-demand extension of purely private disputes.” (EX2007). The Petition relies on previously considered or cumulative art, offers no compelling merits, and would not meaningfully simplify the district court action. Instituting review would expend scarce Board resources at a time when its docket is already saturated.

G. Collective Analysis of *Fintiv* Factors

Taken together, the *Fintiv* factors favor denial. Given the Petition’s weak merits, the risk of duplicative proceedings with identical parties and overlapping issues, the Board’s workload considerations, and the parties’ settled expectations, institution would waste Board and party resources and would not meaningfully advance resolution of the dispute.

IV. CONCLUSION

For the foregoing reasons, the Director should deny institution of the Petition under 35 U.S.C. §§ 314(a) and/or 325(d), *Advanced Bionics*, and/or *Fintiv*.

IPR2025-00694
U.S. Patent No. 11,627,242

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Respectfully submitted,

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Back-Up Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that on February 2, 2026, that a true and correct copy of the foregoing was served on Counsel for Petitioner via filing through the P-TACTS, as well as by delivering a copy via electronic mail to the following email address(es):

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