

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioners,

v.

KIWI INTELLECTUAL ASSETS CORPORATION,

Patent Owner.

IPR2026-00164

U.S. Patent No. RE50,307

**PATENT OWNER KIWI INTELLECTUAL ASSETS CORPORATION'S
REQUEST FOR DISCRETIONARY DENIAL**

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I. INTRODUCTION

Challenged U.S. Patent No. RE50,307 (“the ‘307 Patent”) has already been reviewed three times: once during initial prosecution, and again for each of the *two times* Patent Owner sought narrowing reissue. Despite their knowledge of the ‘307 Patent’s predecessor for more than ten years, Petitioners did bring any concerns regarding the validity of the claimed subject matter to the USPTO. And when they finally got around to filing their IPR Petition, Petitioners relied on recycled art already reviewed by the Patent Office. Nonetheless, Petitioners proceeded with the challenge and structured it based on claim constructions different from what Petitioners intend to seek in district court. Petitioners apparently hope they can convince the Board to invalidate the claims under constructions they contend are incorrect while simultaneously intending to argue for narrower constructions in district court to avoid a finding of infringement. That Petitioners advance different constructions in different forums solely for strategic advantage is a compelling reason to deny the Petition. For all the reasons discussed below, Patent Owner respectfully submits that discretionary denial is appropriate.

II. INSTITUTION SHOULD BE DENIED UNDER 35 U.S.C. §§ 314(a) AND 325(d)

A. PETITIONERS' CHOICE TO ADOPT BROAD CONSTRUCTIONS FOR INVALIDITY AND NARROW CONSTRUCTIONS IN LITIGATION MANDATES DENIAL

Discretionary denial is appropriate—if not required—by the Director’s precedential decision in *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, due to Petitioner’s failure to proffer a “single claim construction that best captures the meaning of the patent claim.” *Revvo*, IPR2025-00632, Paper 20, 4.

The Board’s rules require that a petitioner identify “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3). As the Director has explained, “the rules discourage petitioners from seeking broader constructions at the Board to support a patentability challenge while seeking narrower constructions in litigation to avoid infringement liability.” *Revvo*, IPR2025-00632, Paper 20, 4. “Simply put, you can’t have it both ways and certainly not without a sufficient explanation.” *Revvo*, IPR2025-00632, Paper 36, 3.

Yet that is exactly what Petitioners seek to do here. Petitioners offer narrowing constructions for several claim terms. (Pet. at 4–5.) Petitioners recognize that Patent Owner does not agree with their constructions. (*Id.* at 5.) Rather than identifying how the claims should be construed, however, Petitioners chose to “present invalidity positions under both interpretations.” *Id.* at 6.

Petitioners openly admit that Grounds 1-3, 6 and 7 are invalid only under Patent Owner's constructions. This is clear from the very start:

As explained in Grounds 1-3 and 6-7, the Andre, Zhenyu, and Yuming references disclose the "simultaneous" limitation, under PO's broad interpretation in district court.

(Pet. at 1 (annotated).) Indeed, Petitioners explain throughout the Petition that these grounds are based solely on "PO's interpretation" or "PO's claim interpretations," which it will contest in district court. (*See e.g.*, Pet. at 6, 11, 21, 44, 52, 99 103; *see also* EX1003 ¶¶ 119, 233, 418.) Grounds 4 and 5 also rely in part on the disputed construction and thus are also improper. (Pet. at 2, 61.)

Petitioners' justification for relying on this broader construction is that "Petitioners' disclaimer/lexicography positions may not be adopted by the Board or the district court." (Pet. at 6.) But allowing Petitioners to adopt a broader claim construction when attempting to invalidate the claims because the district court "might in the future decline to adopt constructions that [Petitioners] propose[] in related district court litigation" is "error." *Revvo*, IPR2025-00632, Paper 36, 4. As in *Revvo*, Petitioners' argument "amounts to nothing more than an assertion that a petitioner should be permitted to raise different claim constructions in the two forums when there is a chance that the district court will reject that petitioner's preferred construction." *Id.* But the Board's rules and the Director's *Revvo* decision

“do[] not provide for conditional future outcomes, and while petitioner would no doubt like to ‘wait and see,’ [the Board] cannot and will not.” *Id.*

Petitioners are the master of their Petition, and here they chose to include Grounds 1-3 and 6-7. It makes no difference that Petitioners also included Grounds 4 and 5 based on constructions they plan to assert in district court. The Board institutes either on all grounds or no grounds. The Board must therefore choose between (1) allowing a petitioner to circumvent *Revvo* by including at least one ground under its preferred interpretation and thereby avoiding denial while still getting to argue for invalidity under the broader construction at the merits stage; or (2) enforcing its rules and making Petitioners face the consequences of their own choices. As in *Revvo*, then, “[t]he appropriate course of action under these circumstances is to deny institution.” *Revvo*, IPR2025-00632, Paper 36, 4.

B. PATENT OWNER’S EFFORTS TO REQUEST FURTHER REVIEW SUPPORT DENIAL

Inter partes review is also unnecessary here because the claimed subject matter has already been reviewed multiple times by the USPTO, including twice at the behest of Patent Owner.

Patent Owner filed U.S. Patent Application No. 12/759,408 in 2010. That application issued as U.S. Patent No. 8,198,563 (EX1016, the “Original Patent”) in 2012. Patent Owner then filed U.S. Patent Application No. 17/020,359 as a narrowing reissue application in 2020, eight years after issuance, citing more than

250 additional references for the Examiner's consideration. (EX1019 at 222, 423-432.) Indeed, Patent Owner identified the Andre, Lufan, and Zhenyu references relied upon by Petitioners in this proceeding. (*Id.* at 427, Entry 149 (Zhenyu) and Entry 151 (Lufan); 222, Entry 3 (Andre).) After considering these references, the Examiner issued U.S. Patent No. RE49,287 (EX1018, the “‘287 Patent”).

Patent Owner thereafter filed yet another narrowing reissue application related to the Original Patent, citing both the references cited in the ‘287 Patent as well as some additional references. (EX1002 at 979-996.) Those additional references included the Lee reference on which Petitioners rely. (*Id.* at 980, Entry 48.) This reissue application, U.S. Patent Application No. 17/974,866, subsequently issued as the ‘307 Patent. The claims of the ‘307 Patent included all the limitations of the ‘287 Patent as well as additional limitations.

These voluntary efforts by Patent Owner to ensure full and robust examination of the claims of the ‘307 Patent weigh heavily in favor of denial. Had a third party twice submitted prior art through the reexamination process to initiate further prosecution, there is little doubt denial would be appropriate. *Adv. Micro Devices v. Adv. Cluster Sys., Inc.*, IPR2025-00862, Paper 14, 3 (“[R]epeated prior challenges weigh against institution.”). If anything, patent owners should be encouraged to file reissues where appropriate so the USPTO can consider additional art without taxing the limited resources of the Board.

**C. PETITIONERS' RELIANCE ON ART ALREADY
CONSIDERED BY THE EXAMINER SUPPORTS DENIAL**

Under 35 U.S.C. § 325(d), the Director may reject a Petition where “the same or substantially the same prior art or arguments previously were presented to the Office.” The Board has used a two-step process to evaluate challenges under Section 325(d). *See Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6, 8 (precedential). At *Advanced Bionics* step one, the Board considers “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office.” *Id.* If so, the analysis proceeds to *Advanced Bionics* step two, where the Board considers “whether the petitioner has demonstrated that the Office erred in a manner material to patentability of the challenged claims.” *Id.* Petitioners bear the burden of demonstrating material error. *Ivantis, Inc. v. Sight Sciences, Inc.*, IPR2022-01540, Paper 14, 14. “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.” *Advanced Bionics*, IPR2019-01469, Paper 6, 9.

Andre-Based Grounds

The first three grounds in the Petition (collectively, the “Andre-based Grounds”) are based on Andre (EX1005), alone or in combination with Lufan

(EX1007) and/or the USB 3.0 Specification (EX1015). These references were previously considered and Petitioners have failed to establish material error.

Both Andre and Lufan were identified by Patent Owner during prosecution of the ‘287 Patent (EX1019 at 127, 135, 222, 427), and cited again by Patent Owner for the ‘307 Patent (*id* at 301, 307, 980, 986). Indeed, Petitioners’ expert admits these references were cited. (EX1003 ¶¶ 101, 105.)

The USB 3.0 reference was not explicitly cited during prosecution. However, USB 3.0 is referenced throughout the specification of the ‘307 Patent. (*E.g.*, EX1001 at 7:19-20 (referring to a “USB 3.0 socket”); 16:58 (referring to a “micro USB 3.0 socket”).) Indeed, the term “USB 3.0” appears almost 40 times in the specification of the ‘307 Patent. Accordingly, USB 3.0 was before the Examiner during prosecution. *Accord. Ocado Grp. PLC v. Autostore Tech. AS*, IPR2021-00398, Paper 10, 19 (finding reference was before the Patent Office when cited in the specification). Petitioners also allege that a POSITA would have known USB 3.0 referred to a standard published by the USB Implementers Forum. (*See, e.g.*, EX1003 ¶¶ 72, 73, 78, 113.) Moreover, because the USB 3.0 reference is cited primarily for features of dependent claims, it is also irrelevant to this analysis. *See Samsung Electronics Co. Ltd. v. Neodron Ltd.*, IPR2020-00334, Paper 11, 14 (ignoring references cited only for dependent claim at step one).

Petitioners have failed to show that the Patent Office made a material error in its consideration of these references. Petitioners only make the conclusory

allegation that “[t]he Examiner specifically erred by accepting applicants’ arguments that the prior art lacked ‘simultaneous’ electrical connections.” (Pet. at 1.) Even if that position were supported, there are several problems with it.

First, Petitioners are clear that the Andre-based Grounds invalidate the claims only under claim constructions they believe are incorrect. *See supra*, Section II.A. Petitioners cannot argue that the underlying constructions are incorrect *and* also argue that no reasonable Examiner could have allowed the claims based on that “incorrect” construction. Petitioners’ attempt to have it both ways dooms their argument from the outset.

Second, the Andre-based Grounds fail before even reaching the “simultaneous electrical connection” issue raised by Petitioners. As the Board has previously observed, material error may include misapprehending specific teachings of prior art “where those teachings *impact patentability of the challenged claims.*” *Advanced Bionics*, IPR2019-01469, Paper 6, 8 n.9 (emphasis added). But the prosecution history here indicates that the challenged claims are allowable over the references in Grounds 1-3 without even considering the “simultaneous electrical communication” limitation. Each of Andre, Lufan, and USB 3.0 were before the USPTO during prosecution of the ‘287 Patent. *See also supra* Section II.B. The Examiner nonetheless granted claims without the “simultaneous electrical connection” limitation. (EX1018; EX1019 at 21-22.) All limitations of claim 34 of the ‘287 Patent are included in the claims of the ‘307 Patent. (*Compare*

EX1018, Claim 34 *with* EX1001, Claim 34.) Thus, the “simultaneous electrical connection” limitation was not the reason—or at least not the *only* reason—that the Examiner allowed the claims over the Andre-based Grounds.

Any allegations of material error that Petitioners might make are further undermined by the decision of *another* Examiner to allow the claims of the ‘307 Patent over these references. (*Compare* EX1019 at 20 (Examiner Christopher E. Lee) *with* EX1002 (Examiner William E. Dondero).) Petitioners may disagree with the decision of multiple examiners, but mere disagreement is not material error. Patent Owner will further address certain failings of the Andre-based Grounds in its Preliminary Response.

Petitioners’ failure to establish material error for the Andre-based Grounds should end the inquiry. Petitioners chose to seek review on duplicative grounds, but the Board either institutes on all grounds or none. And there is no reason for the Board to dedicate any administrative resources to an analysis of Petitioners’ Andre-based Grounds that are founded on constructions that Petitioners will controvert in litigation.

Lufan-Based Grounds

Remaining Grounds 4-7 (collectively, the “Lufan-based Grounds”) focus on combinations of Lufan, Yuming, and certain secondary references. The inclusion of these separate Grounds does not change the fact that discretionary denial is appropriate and requested here.

The primary Lufan reference and the USB 3.0 reference were before the Patent Office during prosecution, as discussed above. The Lee reference was cited by Patent Owner during prosecution of the ‘307 Patent. (EX1002 at 301, 980; *see also* EX1003 ¶ 111.) And Zhenyu was likewise cited during prosecution of both the ‘287 and ‘307 Patents. (EX1002 at 307, 986; EX1019 at 127, 427; *see also* EX1003 ¶ 103.)

Yuming was not itself cited during prosecution of the ‘307 Patent. However, it is cumulative of numerous references that were cited and considered during prosecution. Indeed, Petitioners allege in the Petition that Andre discloses the same features that Yuming allegedly discloses. (Pet. at 11.) Having taken that position, Petitioners cannot now turn around and argue that Yuming is substantially different than Andre. Thus, Petitioners’ alleged combination of Lufan with Yuming is no different for purposes of the *Advanced Bionics* inquiry than the alleged combination of Lufan with Andre in Ground 2. Petitioners also claim that Zhenyu (like Andre) discloses the same “simultaneous” disclosure that Yuming allegedly provides. (Pet. at 1 (alleging that Andre, Zhenyu, *and* Yuming disclose the “simultaneous” limitation).)

Yen, which is cited only for grounds 6 and 7, was not cited during prosecution.¹ However, Yen is cited only as supporting the motivation to combine other references. (Pet. at 9.) It is thus irrelevant to the *Advanced Bionics* step one analysis. *Accord. Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1376 (Fed. Cir. 2022) (distinguishing between use as a basis for a petition and use to furnish a motivation to combine).

Petitioners also fail to establish material error with respect to any of these grounds. Initially, as with Grounds 1-3, Petitioners claim that Grounds 6-7 are invalid only under a claim construction they believe is incorrect. *Supra*, Section II.B. Moreover, although Petitioners contend that the material error was based on the “simultaneous electrical connection” limitations, the Petition fails to establish how this element is met for Grounds 6 and 7. Instead, Petitioners offer a single paragraph which alleges that “the Lufan-Yuming-Socket, Zhenyu, and Yen” invalidate the claims only under PO’s interpretation, and then relies on both its analysis for Ground 4 and the expert declaration. (Pet. at 103.) But Petitioners’ reliance on Ground 4 to support this argument is improper. For example, the analysis of Ground 4 is based in part on Lee, which is absent from Ground 6. And

¹ Even if Yen were otherwise relevant here, Grounds 6 and 7 are improperly based on a claim construction that Petitioners adopt only for purposes of invalidity. *See supra* Section II.A.

Ground 6 additionally includes both Zhenyu and Yen, which are not involved in Ground 4. Indeed, despite alleging that Zhenyu discloses the “simultaneous electrical connection” limitation (Pet. at 1), this analysis fails to explain how Zhenyu discloses that limitation. This type of conclusory allegation relying on analysis only in the expert declaration is insufficient to establish material error.

Finally, Petitioners’ material error arguments are incorrect. Although Petitioners focus solely on the “simultaneous electrical connection” limitation, the prosecution history is more nuanced. For example, in explaining the reasons for the indication of allowable subject matter, the Examiner stated that “the prior art of record, when taken as a whole, does not disclose or suggest *the combinations* of claim 35² including a socket structure with duplex electrical connection, wherein the socket structure is operative to simultaneously electrically connection via first and second contacts *in conjunction with the rest of the limitations of claim 35.*” (EX1002 at 79-82 (emphasis added).) In other words, the Examiner allowed the claims not just based on the absence of the “simultaneous electrical connection” limitations in the prior art, but based on the absence of such limitations which could be properly combined with the other elements of the claims. In that regard, it is notable that Petitioners did not attempt to simply combine the alleged “simultaneous electrical connection” in Andre, Zhenyu, and Yuming (Pet. at 1)

² Claim 35 issued as independent claim 34.

with the existing Teicher-Lee combination asserted by the Examiner (EX1002 at 186). It is further notable that Petitioners were required to combine four or more references (as in Grounds 5-7) to allege invalidity of the claimed combination.

Petitioners’ material error argument also fails because it consists entirely of a conclusory allegation of error (Pet. at 1)³ and the invalidity arguments. But “material error” is not synonymous with the merits of the invalidity challenge and “does not necessarily consider the merits.” *ABS Global, Inc. v. Cytonome/ST, LLC*, IPR2021-00306, Paper 13, 9 n.5. However, Petitioners also fail on the merits. For example, Grounds 4 and 5 rely on an entirely unsupported claim construction. *See infra*, Section II.F. Petitioners thus cannot meet the institution standard. *Samsung Electronics America, Inc. v. Cobblestone Wireless, LLC*, IPR2024-00319, Paper 16, 20 (“Where a petitioner [] relies on a particular construction of a claim term in order to demonstrate unpatentability . . . the petitioner must provide a sufficient basis to support that construction.”). Patent Owner will address other deficiencies in these Grounds in its forthcoming Preliminary Response.

³ The word “erred” appears only in the Introduction. The root term “err” does not otherwise appear in the Petition.

D. THE SETTLED EXPECTATIONS OF THE PARTIES SUPPORT DENIAL

Petitioners have had knowledge of the ‘307 Patent and its predecessors for more than ten years without attempting to challenge it. For example, the Original Patent was discussed during prosecution of Petitioners’ U.S. Patent Application No. 14/260,501 in 2015. (EX2001 at 140, 160.) In fact, the Original Patent—cited under the publication number for the original application and referred to as “Tsai”—was the primary reference cited in that application and was used to reject the claims under 35 U.S.C. § 102(b). (*Id.* at 140-142.) The Original Patent itself was also cited during prosecution of Petitioners’ U.S. Patent Application No. 15/082,408 in 2018. (EX2002 at 195.) These facts weigh in favor of denial. *See, e.g., Qualcomm Inc. v. Callabo Innovations, Inc.*, IPR2025-01015, Paper 10, 2 (citation of published application during prosecution of petitioner’s patent application favors denial); *Jinkosolar Co., Ltd. v. Longi Green Energy Tech. Co., Ltd.*, IPR2025-00859, Paper 10, 3 (same). The fact that it was the original application does not change the result. *See NVIDIA Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18, 3 (finding settled expectations based on knowledge of “the original patent that the [challenged reissue patent] issued from.”).

Moreover, the Original Patent was granted in 2012. (EX1016.) Patent Owner has owned claims covering the full breadth of the challenged claims for 13 years. This length of time also raises settled expectations. *See Analog Devices, Inc. v.*

Number 14 B.V., IPR2025-00550, Paper 10, 2. Opportunities to challenge the claims for narrowing reissues such as the ‘307 Patent begin when the original patent issues. *See* 35 U.S.C. § 325(f) (barring PGR of narrowing reissues based on issue date of original patent). And this makes sense: if a party believes that the narrower claims of the reissue are invalid, then the same challenge would have applied even more forcefully to the broader rights of the original patent. Indeed, this was precisely the rationale the USPTO offered when it asked Congress to limit third-party submissions of prior art to a limited period after the *first* publication of an application: “republishations overwhelmingly only narrow the claims, and in such cases *anyone who would want to submit prior art could have done so at the first publication.*” (EX2003 at S1377 (emphasis added).) In this way, parties’ settled expectations for narrowing reissues extend back to the original patent and are not reset like they might be if a *broadening* reissue were sought and granted.

Petitioners could have efficiently challenged these claims previously in numerous ways. *See, e.g.*, 37 C.F.R. § 1.565(d) (merger of reissue and *ex parte* reexam); 37 C.F.R. § 1.291 (protest); 35 U.S.C. § 301 (citation of prior art); 35 U.S.C. § 315(d) (coordination of IPR and other proceedings). But the Board should not permit Petitioners to forego such challenges and then entertain an argument that they had no opportunity to raise their challenges earlier.

E. PARALLEL DISTRICT COURT LITIGATION FAVORS DENIAL

The parallel district court action (Pet. at 110) also favors denial. Petitioners have proposed a stipulation to allegedly eliminate overlap. (EX1028.) But the Director has indicated that the failure to disclaim any challenges under 35 U.S.C. §§ 102 and 103 favors denial. (EX2004 at 6, 9, 12.) And the stipulation here guarantees duplication in several respects. Because it is conditioned not merely on institution but on the institution not being vacated, reversed, or otherwise withdrawn, the Parties will need to continue litigating these references through any appeals in case the institution decision is later vacated. *See Bungie, Inc. v. Worlds Inc.*, IPR2015-01264, Paper 64, 1, 4, 10 (vacating institution after five years on remand from Federal Circuit). Statutory estoppel takes effect upon a final written decision, but the stipulation here would apparently allow Petitioners to continue to assert all prior art in district court until there was no possibility institution might be reversed or withdrawn. And even when it becomes applicable, the stipulation will raise additional disputes, *e.g.*, regarding what it means for system art to “correspond[] to a reference that forms the basis of any ground . . .” (EX1028.) For example, does the reliance on the USB 3.0 specification mean that Petitioners will not rely on products related to the specification which Petitioners contend was “widely implemented by manufacturers in the industry by 2009”? (EX1003 ¶ 113.)

Patent Owner believes so, but Petitioners may disagree. The district court will need to consider the prior art here in any case, at least to determine the scope of waiver.

Additional factors also favor denial. For example, the Parties in both proceedings are the same and no stay has been granted. And by the institution deadline, the Parties will have invested significant resources in the litigation. For example, the Parties will have exchanged infringement and invalidity contentions and will be well into the fact discovery period before the institution decision deadline in early June. (EX2005.)

Finally, while the trial in this case is set for after the final written decision deadline, the schedule nonetheless poses a significant risk of wasted resources if this proceeding is instituted. Most importantly, a *Markman* hearing is scheduled for April 2027. (*Id.*) Petitioners will attempt to demonstrate that the claims of the ‘307 Patent are invalid based on their proposed constructions. However, they admit there is a strong likelihood that their “disclaimer/lexicography positions may not be adopted by the . . . district court.” (Pet. at 6.) Why else would they have sought to take a different position to pursue invalidity in this proceeding? And in the likely scenario where Petitioners’ constructions are not adopted, the Parties and the Board will have no opportunity to address the district court’s construction, thus guaranteeing wasted resources of the Board, the district court, or both.

F. ADDITIONAL FACTORS SUPPORT DENIAL

Several additional issues support denial. For example, the Petition is required to identify “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3). The petitioner accordingly must “explain, in detail, how the challenged claim is to be construed with supporting factual and legal analysis.” *Duo Sec., Inc. v. Strikeforce Techs., Inc.*, IPR2017-01064, Paper 7, 8. Yet here, Petitioners merely state their proposed constructions without any analysis. (Pet. at 5.) Although Petitioners allege “disclaimer” for the “simultaneous” and “duplex” terms (*id.*), Petitioners do not attempt to explain how disclaimer applies here. *But see TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1063–64 (Fed. Cir. 2016) (party asserting disclaimer bears burden of proof). And Petitioners’ proposed construction of “reverse mirror” is supported only with an unexplained citation that purports to define the separate term “functional reverse mirror.” (Pet. at 5.) The Petition also relies on other constructions that are entirely unsupported (*id.* at 44-45 (conclusory definition of “castellated”), 45 (alleging grooves are a specific type of recess)) or which appear only in the expert declaration (EX1003 ¶ 219 (expert reliance on conclusory interpretation of “reverse mirror”)). It is unclear how the Board could analyze Petitioners’ constructions even if it wanted to do so.

Similarly, the Petition “must specify where each element of the claim is found in the prior art” 37 C.F.R. § 42.104(b)(4). Yet Petitioners fail to apply the prior art to the actual language of each challenged claim in the Petition.

Instead, Petitioners are content to say “close enough” because the claims are allegedly “substantially” the same as or “substantially” identical to other claims, leaving it to the expert declaration to provide the required analysis. (*See, e.g.*, Pet. at 40, 43, 44, 54.) This type of language appears at least 35 times in the Petition.

In addition, Petitioners argue that both Zhenyu and Yuming disclose the “simultaneous” limitations. (*See, e.g.*, Pet. at 1.) But Petitioners then allege the claims are invalid based on a combination of, *inter alia*, Zhenyu and Yuming. (Pet. at 103.) Petitioners rely on a broad-brush summary that leaves it to the Board to determine whether Petitioners are relying on Yuming or Zhenyu to disclose this limitation. *See Salpeter v. Arp Wave, LLC*, IPR2019-01384, Paper 12, 24.

Indeed, this analysis is representative of yet another problem with the Petition: offloading arguments to the 279-page expert declaration rather than providing a clear explanation of Petitioners’ infringement positions in the Petition itself, and thereby circumventing the page limits. In Ground 6, for example, the entirety of the analysis for around 80 claims consists of five paragraphs over three pages in the Petition which incorporates nearly **70 pages** of the expert declaration. (*Compare* Pet. at 103-104 *with* EX1003 ¶¶ 249-308.) As another example, Petitioners’ explanation for invalidity of more than 85 claims under Ground 2 spans only six pages but refers to almost 60 paragraphs of expert testimony. (*Compare* Pet. at 52-57 *with* EX1003 ¶¶ 249-308.) The Board will have no choice but to rely on the expert declaration *rather than* the Petition in evaluating these

grounds. *But see Cisco Sys., Inc. v. C-Cation Techs., Inc.*, IPR2014-00454, Paper 12 (“[The] practice of citing [expert declaration] to support conclusory statements that are not otherwise supported in the Petition also amounts to improper incorporation by reference.”).

Of course, Petitioners really had no choice but to cut corners: it would have taken far more than the 54 words they had remaining to address these issues. (Pet. at 109.) Petitioners otherwise would not have been able to try to invalidate the challenged claims based on claim constructions they will contest in district court.

III. CONCLUSION

Discretionary denial is respectfully requested under the facts and factors surrounding the ‘307 Patent. These factors include Petitioners’ efforts to invalidate the claims based on claim constructions they will contest in litigation, the USPTO’s three prior reviews of the claimed subject matter, Petitioners’ longstanding knowledge of the ‘307 Patent family, and the USPTO’s prior review of most of the cited references. When these factors are considered individually, each weighs strongly in favor of discretionary denial and would be sufficient to warrant denial. However, when these factors are evaluated together, discretionary denial is extremely compelling and should be granted. Based on a holistic review of the circumstances here, Patent Owner respectfully asks that the Director exercise discretion to deny institution.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a) and (b), I certify that on February 5, 2026, a true and accurate copy of this paper, **PATENT OWNER KIWI INTELLECTUAL ASSETS CORPORATION'S REQUEST FOR DISCRETIONARY DENIAL**, was served on the following counsel for Petitioners via email, pursuant to Petitioners' consent to e-mail service:

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Dated: February 5, 2026

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