

Filed on behalf of Golden Eye Technologies LLC
By: Terry A. Saad (tsaad@bosfirm.com)
Marcus Benavides (mbenavides@bosfirm.com)
Brandon V. Zuniga (bzuniga@bosfirm.com)
Bragalone Olejko Saad PC
901 Main Street
Suite 3800
Dallas, TX 75202
Tel: 214.785.6670
Fax: 214.786.6680

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOLDEN EYE TECHNOLOGIES LLC

Petitioner

v.

CISCO SYSTEMS, INC.

Patent Owner

Case IPR2026-00188
U.S. Patent No. 9,271,243

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF
INSTITUTION**

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PATENT OWNER’S EXHIBIT LIST

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Ex. 2001	Doc. 37 – First Amended Docket Control Order
Ex. 2002	Median Time From Filings to Trial For Civil Cases in Which Trials Were Completed, Table T-3, https://www.uscourts.gov/data-news/reports/statistical-reports/federal-judicial-caseload-statistics/federal-judicial-caseload-statistics-2025-tables
Ex. 2003	Petitioner Cisco’s Cover Pleading of its Invalidity Contentions
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Ex. 2005	Exhibit C-1 of Petitioner Cisco’s Invalidity Contentions
Ex. 2006	Appendix C of Petitioner Cisco’s Invalidity Contentions
Ex. 2007	Patent Owner Golden Eye’s Complaint in the Eastern District of Texas Litigation
Ex. 2008	Petitioner Cisco’s Answer in the Eastern District of Texas
Ex. 2009	Declaration
Ex. 2010	Harfang IP Licensing Webpage
Ex. 2011	Sep. 16, 2016 PCT Search Report for PCT/US2016/032887
Ex. 2012	March 15, 2018 IDS Listing U.S. Pub. 20140321300
Ex. 2013	Nov. 29, 2019 Communication for European Search Report Listing “US 2014/321300”
Ex. 2014	Nov. 29, 2019 European Search Report listing “US 2014/321300”

I. INTRODUCTION

Pursuant to the Director’s March 26, 2025 Memorandum regarding Interim Processes for PTAB Workload Management (“March 2025 Memo”), Patent Owner Golden Eye Technologies LLC (“Patent Owner”) respectfully requests that the Director exercise discretion to deny institution of Cisco System, Inc.’s (“Petitioner”) petition for inter partes review (the “Petition”) of U.S. Patent No. 9,271,243 (the “’243 patent”). A holistic assessment of the relevant facts and circumstances of this case warrants discretionary denial under 35 U.S.C. § 314(a) to preserve Office resources and honor the settled expectations of the Patent Owner.

Discretionary denial is particularly appropriate here because the parallel litigation in the Eastern District of Texas (“EDTX”) has reached an advanced stage. *Golden Eye Technologies LLC v. Cisco Systems, Inc.*, No. 2:25-cv-00898-JRG (EDTX). The parties have exchanged infringement and invalidity contentions and are currently engaged in fact discovery. With the Final Written Decision (“FWD”) not expected until July 2027—a mere five weeks before the August 16, 2027 trial date—the Board’s determination would arrive after the parties and court have completed most of their work. This trial schedule is consistent with the EDTX’s median time-to-trial of approximately 25 months, making it likely that the court will reach a verdict concurrently with the issuance of the Final Written Decision.

Furthermore, a stay of the EDTX proceedings is highly unlikely. That case

includes the assertion of four other patents, some not subject to an IPR. Thus, the institution of this review, would not provide a valid basis for staying the district court litigation because, regardless of the outcome of this proceeding, other disputes involving additional patents must be litigated. Thus, this proceeding does not provide the “efficient alternative to litigation” intended by the AIA. Instead, institution would force the parties to litigate the same validity issues in two forums simultaneously, unnecessarily duplicating efforts and expense. Because a final district court verdict is expected to arrive at or near the same time as any Board determination, maintaining this IPR would serve only as a wasteful redundancy and create a substantial risk of inconsistent decisions between the two tribunals.

Finally, the Director should consider the Patent Owner’s strong settled expectations. Since issuance on February 23, 2016, the ’243 patent has been in force for more than 10 years and will have reached more than 11 years of its term before any FWD. As recognized by *Samsung v. Mobile Data Tech.*, such longevity “creates strong settled expectations for Patent Owner[s]” that should not be disturbed by the inefficiencies of parallel, late-stage proceedings. In view of these and other considerations addressed below, discretionary denial of the Petition is warranted.

II. DISCRETIONARY DENIAL IS WARRANTED UNDER §314(a).

Under 35 U.S.C. § 314(a), the Board has discretion to deny institution of Cisco’s petition for *inter partes* review. *See also Cuozzo Speed Techs., LLC v. Lee*,

579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). Where a parallel district court litigation involving the same issues as the petition for IPR has reached such an advanced state that trial would conclude prior to or even close to the deadline for the Board’s final written decision, denial of institution is warranted under § 314(a). *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19-20 (PTAB Sept. 12, 2018) (precedential). The Director has reiterated that the “existing Board precedent” established under *Fintiv* (among other relevant precedent also discussed herein) requires analysis of “discretionary considerations” under § 314(a). *See* March 2025 Memo at 2. The Board has set forth six ***Fintiv* factors** for determining whether discretionary denial in light of parallel litigation is appropriate: **(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; **(6)** other circumstances that impact the Board's exercise of discretion. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential). The Board “takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting

review.” *Id.*, Paper 15 at 7-17 (PTAB May 13, 2020) (informative).

A. *Fintiv* Factor 1: The court has not granted a stay and no evidence exists that one may be granted if a proceeding is instituted.

Factor 1 heavily favors discretionary denial as the court in the Eastern District of Texas (“EDTX”) has not granted a stay, Petitioner has not moved for one, and a stay is unlikely. EDTX courts regularly deny stay motions when the PTAB has not issued a decision to institute. As noted in *Barkan Wireless IP Holdings v. Samsung Elecs.*, EDTX judges maintain a “consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.” 2019 WL 8647996, at *2 (E.D. Tex. Mar. 15, 2019). Similarly, the court in *Trover Group v. Dedicated Micros USA* held that when the PTAB has not acted, EDTX courts have “uniformly denied motions for a stay.” 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015).

Furthermore, Petitioner neither presents evidence to support a stay nor voices intent to seek one. *See* Pet. at 14 (relying solely on its insufficient *Sotera* stipulation to negate a discretionary denial). Indeed, where a “Petitioner present[ed] no evidence that it has requested a stay [] or that a stay is likely,” the Board has found Factor 1 to favor discretionary denial. *Luxshare Precision Industry v. Amphenol Corp.*, IPR2022-00132, Paper 10 at 9 (PTAB May 3, 2022). This aligns with the Board’s reasoning in *Samsung v. Mobile Data Tech.*, where institution was denied in part for “insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial.” *See* IPR2025-00537, Paper 15 at 2.

The complexity of parallel litigation makes a stay even less likely. Here, the EDTX case involves five asserted patents, some not subject to IPR, and none subject to an instituted IPR. *See SB IP Holdings, LLC v. Vivint, Inc.*, No. 4:21-cv-00912, Doc. 59 (E.D. Tex. April 6, 2023) (denying motion to stay when not all patents were subject to an instituted IPR). Because an IPR of the '243 patent cannot resolve the entire controversy, a stay would cause “piecemeal” litigation. Without any stay likely, institution would ensure “significant duplication of effort” and “additional expense for the parties.” Factor 1, therefore, favors denial.

B. *Fintiv* Factor 2: The EDTX trial will occur at or near the same time as any final written decision.

The second *Fintiv* factor weighs heavily in favor of discretionary denial because the district court trial is scheduled to begin nearly simultaneously with the Board’s projected statutory deadline for issuing a final written decision. The Eastern District of Texas has set a firm date for jury selection and trial to commence on August 16, 2027, and median time-to-trial statistics for this venue suggest that trial will occur at approximately 25.9 months from filing—aligning with the scheduled date. *Compare* Ex. 2001 (Doc. 37) at 1 *with* Ex. 2002. Based on the filing date of the Petition, in comparison, the Board’s Final Written Decision is not expected until July 7, 2027—just one month prior to the trial date and *after* significant deadlines in the parallel litigation such as the deadline for filing motions for summary judgment.

As demonstrated in *Shenzhen Tuozhu Technology Co. v. Stratasy, Inc.*, the

Board generally denies institution when a trial date is close to the projected FWD deadline because such proximity ensures that the district court will have already addressed the Petitioner's invalidity challenges by the time the Board reaches a conclusion. *See* IPR2025-00354, Paper 11 at 2 (PTAB June 12, 2025) (granting discretionary denial when the projected FWD was within approximately one month of the trial date). For example, even before reaching trial, Petitioner will have had the opportunity to seek summary judgment on invalidity of the '243 patent *before* the issuance of the Board's final written decision. *See* Ex. 2001 (May 10, 2027 – deadline to file Dispositive Motions). Thus, the trial date (and other relevant deadlines) in the parallel litigation is sufficiently close to the issuance of the FWD in this proceeding to eliminate any benefits from proceeding with this IPR.

C. *Fintiv* Factor 3: Investment of significant resources before an institution decision and Petitioner's lack of diligence favor denial.

The Board utilizes a two-prong test to assess *Fintiv* factor 3. The first prong relates to the “amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9 (PTAB Mar. 20, 2020). Under the second prong, the petitioner must explain any lack of diligence. If it cannot do so, this factor favors denial. *Id.* at 11-12. Because the first prong is, at best, neutral and the second prong weighs in favor of discretionary denial, this factor weighs in favor of discretionary denial. *See, e.g., Samsung Electronics Co. v. SiOnyx, LLC*, IPR2025-

00065, Paper 16, 11-12 (PTAB June 6, 2025) (determining that the first prong is neutral even when “the claim construction phase has not even begun yet”).

Importantly, the parties passed the critical milestone of exchanging infringement and invalidity (including eligibility) contentions, on November 10, 2025 and January 19, 2026. *See* Ex. 2001 (Doc. 37) at 5. Thus, Petitioner has already committed to its primary invalidity theories and prior art searches in district court.

Moreover, the parties are currently engaged in active fact discovery, having already exchanged a significant volume of documents, including Petitioner producing over 125,000 pages of documents. By the time the Board issues its institution decision in July 2026, the parties will have continued significantly on this trajectory toward a March 2027 completion of discovery. Ex. 2001 at 2.

Also, because the EDTX litigation involves additional patents (at least U.S. Pat. Nos. 9,344,978 and 9,918,236) that are not subject to any petition for IPR, the district court must proceed with discovery, claim construction, and trial as to all other non-IPR patents, regardless of the Board’s decision on the ’243 patent. The EDTX court’s investment therefore is fixed and will not change. Institution here would only force the Court and the parties to manage a bifurcated and “piecemeal” validity analysis, thereby undermining the efficiency goals of the AIA.

Turning to the second prong, Petitioner was not diligent in filing its Petition. Petitioner was on notice of the ’243 patent and its corresponding application at least

as early as September 16, 2016, when the application resulting in the '243 patent was cited during prosecution of one of Petitioner's own patents. *See* Ex. 2011 (Sep. 16, 2016 PCT Search Report for PCT/US2016/032887 citing U.S. Pub. 2014/0321300); Ex. 2012 (March 15, 2018 IDS listing U.S. Pub. 20140321300); Exs. 2013, 2014 (Nov. 29, 2019 European Search Report and corresponding Communication listing "US 2014/321300"). Additionally, Petitioner was on notice of the '243 patent via licensing discussions at least as early as March 2022. Ex. 2007 (Complaint alleging licensing discussions for '243 patent) at ¶ 53; Ex. 2008 (Answer) at ¶ 53. Despite its knowledge, Petitioner waited nearly ten years—until the litigation was in an advanced stage and the patent was nearing its tenth anniversary—to file its Petition. Petitioner's near ten year delay in filing its Petition demonstrates a lack of diligence and tips this factor in favor of denial. Thus, the district court's and the parties' substantial investment in the parallel EDTX litigation further warrants discretionary denial under *Fintiv*'s Factor 3.

D. *Fintiv* Factor 4: The issues raised in the Petition substantially overlap with those raised in the EDTX case.

The fourth *Fintiv* factor heavily favors denial because the Petition presents issues that overlap with litigation in district court. Under this factor, the Board weighs whether the "petition includes the same or substantially the same claims, grounds, arguments, and evidence" as a parallel court case. The efficiency and integrity of the system are best served when an IPR provides a meaningful alternative

to litigation, not a “significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions.” *See Samsung v. Mobile Data Tech.* at 2; *see also Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-0109, Paper 12, 19 (PTAB Dec. 1, 2020). Here, the challenged claims include the claims asserted in litigation—claims 1, 2, 4 and 11. Petitioner’s *Sotera* stipulation will not remedy the redundancy of invalidity theories presented nor does it address the countless additional invalidity theories Petitioner presents in the district court litigation.

Significantly, Petitioner relies on the same prior art in this IPR proceeding as it does in the district court litigation. *Compare* Pet. at 19, 60 (identifying Hills, Wang, and Calhoun as allegedly invalidating prior art) *with* Ex. 2003 at 19, 20 (Invalidity Contentions). For example, in its district court disclosures, Petitioner lists Hills and Wang as primary prior art sources to challenge the “group[ing]” of “wireless access points using a same channel...” limitation of claim 1—the same references presented in Ground 1 of the Petition. *Compare* Ex. 2004 (Ex. C-2) at 4-11 and Ex. 2005 (Ex. C-1) at 3-7 *with* Pet. at 30-34, 70. Similarly, Petitioner’s reliance on Calhoun to address the “*transmit[ting] an output strength*” feature is common to both forums. *Compare* Ex. 2006 (App’x C) at 3, 5 *with* Pet. at 60-66, 73.

Conspicuously, Petitioner’s district court contentions lack the Petition’s specificity, instead taking a scattershot approach by listing 10 patents/publications and 4 systems as primary sources and then adding 4 more secondary references

without explicitly detailing the combinations later developed for this IPR. More egregiously, Petitioner attempts to preserve nearly infinite combinations in district court via the vague assertion that “these primary references may be combined with each other or with the secondary references . . . to render this [’243] patent obvious.” Ex. 2003 at 20. This blanket statement obscures any specificity in Petitioner’s invalidity positions and highlights that Petitioner has no intention of giving meaningful effect to its *Sotera* stipulation. By refusing to commit to specific combinations in district court while moving forward on the same art here in just one specific combination, Petitioner is seeking a “trial run” of its theories at the PTAB while keeping its options open for trial. Such duplicative and tactical maneuvering is exactly what the *Fintiv* factors are designed to prevent. *See, e.g., Shenzhen*, Paper 11 at 2 (finding Petitioner’s invalidity arguments to be “more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot”).

Though Petitioner purports to mitigate the overlap of its Petition grounds by offering a *Sotera* stipulation (Pet. at 17-18), this gesture is rendered hollow by Petitioner’s district court invalidity contentions. By broadly asserting eighteen prior art references while also contending that any of these “may be combined with each other” (Ex. 2003 at 20), Petitioner has obscured any restriction on what “reasonably could have been raised” in this IPR. This tactical ambiguity ensures Petitioner’s

stipulation provides no real safeguard against duplication, leaving open an improper avenue to relitigate these same references in the district court under the guise of “new” combinations not specifically detailed in the Petition.

Indeed, the recent Federal Circuit precedential decision in *Ingenico Inc. v. IOENGINE, LLC* expressly states that a petitioner is not precluded from “relying on the same patents and printed publications as evidence in asserting a ground that could not be raised during the IPR.” 136 F.4th 1354, 1366 (Fed. Cir. 2025). In other words, Petitioner’s *Sotera* stipulation is ineffective in preventing Petitioner from using the same prior art references in the EDTX court not only as “evidence” but also as grounds that were purportedly “not raised” in this IPR—such as the vast array of combinations involving the dozens of other references buried in its contentions. Because Petitioner seeks a “trial run” of its theories at the PTAB while maintaining an amorphous “all-of-the-above” defense in the EDTX court, this factor weighs heavily in favor of discretionary denial.

E. *Fintiv* Factor 5: Petitioner is defendant in parallel EDTX lawsuit.

The fifth *Fintiv* factor weighs in favor of exercising discretionary denial because the Petitioner and the Defendant Cisco Systems, Inc. are the same party.

F. *Fintiv* Factor 6: Other circumstances that impact the Board’s exercise of discretion, including the merits, favor denial.

As discussed in detail in Section III below, the consideration of all other relevant factors also weighs against institution.

III. OTHER HOLISTIC CONSIDERATIONS COMPEL DENIAL

Beyond the procedural overlap of parallel proceedings, a holistic assessment of factors supporting the “efficiency and integrity of the system” supports denial. *See Fintiv*, Paper 11 at 6. Under the March 2025 Memo at 2, “the parties are permitted to address all relevant considerations”, including: (1) settled expectations of the parties, such as the length of time the claims have been in force; (2) strength of the unpatentability challenge; and (3) extent of the petition’s reliance on expert testimony. Here, consideration of these and other factors demonstrate that institution would reward tactical delay and undermine the stability of the patent system.

A. The ’243 patent’s over nine-year history, including industry licensing, creates strong settled expectations that warrant denial.

The “settled expectations” doctrine promotes stability by protecting long-standing patents under a heightened presumption of validity. *See Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21, at 2-3 (PTAB June 18, 2025) (informative) (denying institution where “the challenged patent has been in force almost eight years, creating settled expectations”); *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 11 at 3 (PTAB June 26, 2025) (denying institution where “strong settled expectations” existed for seven- and nine-year-old patents) *aff’d In re Cambridge*, 2025 WL 3526129 (Fed. Cir. Dec. 9, 2025); *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9 (July 24, 2025) (informative) (denying institution where “the challenged patents have been in

force for seven and six years, respectively, creating strong settled expectations for Patent Owner”). Recently designated informative decisions emphasize that the longer a patent has been in force, the more settled the expectations of the patent owner. *See Precedential and informative decisions*, USPTO, <https://www.uspto.gov/patents/ptab/precedential-informative-decisions> (designating in 2025 as informative each of *Dabico*, IPR2025-00408, Paper 21; *Amgen*, IPR2025-00601, Paper 9; *Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00950, Paper 11 (PTAB Sept. 19, 2025)). The Federal Circuit has repeatedly rejected challenges to the use of “settled expectations” as a denial factor. *See In re Google LLC*, 2026 WL 204945, at *1 (Fed. Cir. Jan. 27, 2026) (citing *In re Sandisk Techs.*, 2025 WL 3526507 (Fed. Cir. Dec. 9, 2025)).

Critically, the ’243 patent was issued on February 23, 2016, and has been in force for over *ten years*. By the time the Board issues a Final Written Decision in July 2027, the ’243 patent will have been in force for over eleven years. The Board has increasingly adopted a “six-year guideline” for this factor, noting that once a patent surpasses the six-year statute of limitations for past damages found in 35 U.S.C. § 286, expectations regarding its validity become significantly more established. *See Dabico*, IPR2025-00408, Paper 21 at 3 (stating this approach “aligns with other approaches to settled expectations and incentives, for example, for filing infringement lawsuits”). The ’243 patent has now far exceeded this six-year

threshold. As such, Patent Owner should be afforded “strong settled expectations” to heavily favor a discretionary denial in this proceeding.

Furthermore, these settled expectations are reinforced by Petitioner’s own conduct. As already discussed above, Petitioner was on notice of the ’243 patent at least as early as 2016 and/or 2022. *See supra* at 8. Despite this knowledge, Petitioner waited nearly a decade—until litigation was in an advanced stage and the patent neared its tenth anniversary—to file its Petition. In *iRhythm Tech., Inc. v. Welch Allyn, Inc.*, the Director found a petitioner’s long-standing awareness of a patent, combined with a decade-long period of enforceability, created “settled expectations” justifying discretionary denial even when other factors favored institution. IPR2025-00363, Paper 10 at 3 (PTAB June 6, 2025); *see also Ericsson Inc. v. Procomm International PTE. Ltd.*, IPR2024-01452, Paper 16, at 2-3 (PTAB June 25, 2025) (the patent’s long enforcement period and Petitioner’s prior awareness of the patent tipped the balance of the holistic assessment in favor of discretionary denial).

Meanwhile, Patent Owner has been actively licensing the ’243 patent since 2021, with licensees including well-known leaders in the wireless networking industry. *See* Ex. 2009; Ex. 2010 (licensing webpage); *Alliance Laundry Systems v. Payrange*, IPR2025-00950, Paper 11 at 3 (PTAB, Sep. 19, 2025) (informative) (finding settled expectations from licensing, even for a relatively young patent).

Allowing Petitioner’s challenge to proceed now would disturb Patent Owner’s

settled expectations and reward Petitioner's tactical delay. The '243 patent has enjoyed nearly ten years of undisturbed validity without Petitioner seeking an earlier review. This consideration weighs heavily in favor of discretionary denial.

B. The Petition's lack of merit warrants denial.

Using a holistic approach guided by the *Fintiv* factors, it is clear the Petition suffers from a number of fatal flaws. As an initial sign of weakness, the Petition fails to identify any single anticipatory reference that discloses all elements of any challenged claim. Instead, the Petition resorts to cobbling together an argument that the challenged claims are rendered obvious by two or even three separate references. Yet, none of these references teaches "group[ing] wireless access points using a same channel." Thus, even if the references could be combined as proposed, a person of ordinary skill in the art would never arrive at independent claim 1 or 11. Worse still, the Petition's grouping deficiency propagates into later portions of claims 1 and 11 as well as their dependent claims. Thus, even leaving aside numerous other deficiencies, the Petition utterly fails to show that a skilled person would have looked at the cited references and then arrived at even a single claim of the '243 patent.

The Petition also fails to comply with 37 C.F.R. § 42.104(b) by failing to specify where each claim element is found. At least with respect to independent claim 11, the Petition fails even to address the correct claim language as provided in a Certificate of Correction. Petitioner admitted this when it "s[ought] permission to

file a Corrected Petition and an updated Expert Declaration (Ex. 1003) to address the updated claim language in the Certificate of Correction.” *See* Board’s Ex. 3001 (Feb. 18, 2026 letter from PTAB to Petitioner in IPR2026-00188 denying request to correct Petition). This glaring deficiency in the Petition remains unremedied.

The Petition also fails to identify the requirements of at least independent claim elements [1.1.1] and [11.2.1], “*a grouping unit configured to group wireless access points using a same channel*” and “*grouping wireless access points using a same channel*” (among other claim elements referring to grouped wireless access points). Instead of grouping access points based on their use of a common channel, Hills teaches a “group” of “all access elements associated with a given central control element **24** or all access elements in a given physical location, such as a floor of a building.” Pet. at 31 (citing Ex. 1005 at 12:29-32). Hills does not teach grouping APs based on the same channel. Furthermore, when analyzing the APs in such a group, Hills uses brute force to analyze signal strength. Hills’ Figure 4 teaches that “for each access element (AP_i) (**102**)” in a group, a “coverage analyzer **21**” looks at “the signal strength detected by the access element from all other access elements (AP_j) in the matrix (**104**)” and “compares” each such signal strength against a coverage threshold.” Ex. 1005 at 12:34-37. Meanwhile, Figure 4 illustrates that *only after* conducting this threshold comparison for *each* pair of access elements does Hills’ “coverage analyzer **21** also determine[] whether AP_i and AP_j operate on the

same channel (108) and whether a coverage hole has been detected as to AP_i (110).”

Ex. 1005 at FIG. 4, 12:40-42. Obviously, there would be no need to check whether two APs operate on the same channel if Hills had already grouped APs by channel. It is precisely because Hills does *not* group APs by channel, that it spends computing resources to analyze information for *every* AP, not just those APs using a specific channel. This inefficiency teaches away from the more efficient manner of optimizing output strength of an access point based only on those APs on the same channel, as taught by the '243 patent.

Nor does the Petition rely on Wang or Calhoun to remedy this deficiency in Hills. Pet. at 30-34. For example, Wang is cited merely “to the extent argued that Hills’ disclosure is not sufficient to disclose the corresponding structure” of the “*grouping unit*.” Pet. at 33. Moreover, as explained below, the testimony of Petitioner’s expert, Dr. Hansen, fails to remedy this deficiency. Thus, the Petition relies entirely on Hills to teach any grouping of APs by channel, and Hills is clear that it does not rely on channel use information as a criterion for grouping APs.

Additionally, regarding any motivation to combine Hills and Wang, the Petition is undermined by reliance (and in some cases sole reliance) on the Hansen Declaration and a *non-existent* section X.A.3 of the Petition. See Pet. at 33 (Ex. 1003 ¶ 82), 43 (Ex. 1003 ¶ 108), 46 (Ex. 1003 ¶ 119), 49 (Ex. 1003 ¶ 126), 50 (Ex. 1003 ¶ 129), 54 (Ex. 1003 ¶ 141), 55 (Ex. 1003 ¶ 144), 56 (Ex. 1003 ¶ 149), 57 (Ex. 1003

¶ 152), 58 (Ex. 1003 ¶ 155), 65 (Ex. 1003 ¶ 172). Meanwhile, the Hansen Declaration (like the Petition) relies heavily on non-existent section VII.A.3. *See* Ex.1003 ¶¶ 82, 108, 119, 126, 129, 141, 144, 149, 152, 155, 172. These pervasive deficiencies undermine the credibility of both documents.

These credibility problems are further exacerbated by the Hansen Declaration parroting the Petition’s incorrect statements regarding cited art. For example, after failing to demonstrate how any cited reference teaches grouping “access points using a same channel,” the Petition (along with the Hansen Declaration) incorrectly states: “Hills discloses grouping access elements on the same floor using the same channel (e.g., *access* elements 16, 18), which renders obvious ‘group[ing] wireless access points using a same channel.’” Ex. 1003, ¶79.” Pet. at 32 (emphasis added). But elements 16 and 18 are “*client*” elements, not “*access*” elements. *Compare* Pet. at 32 (wrongly pointing to “*access* [sic] elements **16, 18**” in Hills’ Fig. 2A (emphasis added)) *with* Hills 6:7-11 (“FIG. **2A** illustrates ... *access* elements **12-15** for wireless communication with remote *client* elements **16, 18**” (emphasis added)). Moreover, even if Hills “client elements” were “access elements” (and they are not), the Petition cites no evidence that these client elements use the same channel, much less that they are grouping “access points using a same channel.”

Because the Petition fails to identify any reference or combination of references as disclosing these elements, the merit of Petitioner’s challenge to the

claims is deficient and unlikely to result in a showing that any of the challenged claims are unpatentable, whether independent claims 1 or 11, or their dependent claims. The above provides illustrative examples of the deficiencies that pervade the Petition. However, other deficiencies of the Petition are discussed in further detail in Patent Owner's forthcoming Patent Owner Preliminary Response. As will be demonstrated, the Petition's lack of merit heavily favors a discretionary denial.

C. Petitioner's excessive reliance on expert testimony to fill gaps in the prior art favors denial.

Dr. Hansen has provided a declaration spanning 98 pages. Ex. 1003. In large part, it appears that the declaration is used to establish facts for which the Petitioner was unable to rely (or chose not to rely) on the cited references themselves. For example, the Petition references the Hansen Declaration (*i.e.*, Ex. 1003) at least 152 times. Of these references, the Hansen Declaration is listed at least 87 times as the sole supporting reference. This excessive citation is a clear indicator of over-reliance. Worse still, a significant portion of this over-reliance is focused on a critical element that the cited references fail to teach, namely, grouping access points using a same channel. For this single feature, the Petition relies on the Hansen Declaration alone at least 19 times (although the Hansen Declaration is cited even more times in combination with other citations). Pet. at 19-28 (including 12 sole citations to Hansen's Declaration regarding Hills, Wang, and their combination, which the Petition relies upon for the grouping-by-channel feature); Pet. at 31-37 (including 7

sole citations to Hansen’s Declaration regarding grouping-by-channel). Furthermore, this over-reliance extends to other features including the recited “map generator,” “extractor,” and “optimal output strength calculator” as well as how they are configured to use or compute variables such as “RSSI,” “output strength,” “a highest RSSI value among the grouped wireless access points” a “predetermined threshold value of the RSSI,” and a “corrected output strength value.” *See, e.g.,* Pet. at 38-63, 65-65 (where each page includes at least one sentence followed solely by a citation to the Hansen Declaration).

The Petition’s over-reliance on Dr. Hansen’s testimony itself (even if the Board were to ignore the Hansen Declaration’s credibility problems) is indicative of the Petition’s lack of merit and weighs heavily against institution.

IV. CONCLUSION

On balance, the evidence of record favors exercising discretion to deny institution of the Petition on *Fintiv* grounds, the strong settled expectations of the Patent Owner, the weakness of the merits, and the over reliance on expert testimony.

Case IPR2026-00188

Patent 9,271,243

Dated: March 13, 2026

Respectfully submitted,

/Marcus Benavides/

Marcus Benavides

Attorney for Patent Owner

Registration No. 58,289

Bragalone Olejko Saad PC

901 Main Street

Suite 3800

Dallas, TX 75202

CERTIFICATION REGARDING PAGE COUNT

Pursuant to 37 C.F.R. §42.24(d) and the Interim Director Discretionary Process web page at II.C.ii, Patent Owner certifies that its Brief Requesting Discretionary Denial is limited to 20 pages and that there are 4994 words in the paper, each count excluding the portions exempted under 37 C.F.R. §42.24(a)(1).

CERTIFICATE OF SERVICE

The undersigned hereby certifies that document has been served via electronic mail on January 29, 2026, to Petitioner at the email address Theodore M. Foster at ipr.theo.foster@haynesboone.com; David L. McCombs at david.mccombs.ipr@haynesboone.com, Gregory P. Huh at gregory.huh.ipr@haynesboone.com and Calmann J. Clements at calmann.clements.ipr@haynesboone.com, pursuant to Petitioner's consent in its Petition at p. 67.

/Marcus Benavides/
Marcus Benavides
Attorney for Patent Owner
Registration No. 58,289
Bragalone Olejko Saad PC
901 Main Street
Suite 3800
Dallas, TX 75202