

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BEATBOT TECHNOLOGY (USA) CO. LTD.,

Petitioner,

v.

ZODIAC POOL SYSTEMS LLC,

Patent Owner.

Case No.: IPR2026-00200

U.S. Patent No. 11,262,766 B2

**PETITIONER'S RESPONSE TO PATENT OWNER'S BRIEF
REQUESTING THAT INSTITUTION OF THE PETITION
BE DENIED ON DISCRETIONARY GROUNDS**

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PETITIONER’S UPDATED EXHIBIT LIST

No.	Exhibit
1001	U.S. Patent No. 11,262,766 B2 (“’766 Patent”)
1002	File History of the ’766 Patent
1003	Declaration of Jason Janét, Ph.D. (“Janét”)
1004	Curriculum Vitae of Jason Janét, Ph.D.
1005	Chinese Publication No. CN1540119A (“Cui”)
1006	German Publication No. DE102007053310A1 (“Knoll”)
1007	Chinese Publication No. CN101139007A (“Fu-007”)
1008	U.S. Patent No. 3,321,787 (“Myers”)
1009	U.S. Patent No. 4,168,557 (“Rasch”)
1010	Jonathan Horgan & Daniel Toal, <i>Review of Machine Vision Applications in Unmanned Underwater Vehicles</i> , Proc. 9th Int’l Conf. on Control, Automation, Robotics and Vision 1 (2006)
1011	Prosecution History of U.S. Patent No. 9,388,595
1012	Prosecution History of U.S. Patent No. 10,338,599
1013	U.S. Patent No. 9,995,051 B2
1014	U.S. Publication No. 20140015959A1 (“Durvasula”)
1015	Chinese Publication No. CN101481957A (“Fu-957”)
1016	U.S. Publication No. 20060053572A1 (“Porat”)
1017	U.S. Publication No. 20140263087A1 (“Renaud”)
1018	Joint Claim Construction Hearing Statement and Joint Claim Construction Worksheet, <i>Beatbot Tech. (USA) Co. Ltd. v. Zodiac Pool Sys. LLC</i> , Case No. 3:25-cv-01946 (S.D. Cal. Mar. 23, 2026), Dkt. 35
1019	Patent Owner's Opposition to Beatbot's Motion to Stay, <i>Beatbot Tech. (USA) Co. Ltd. v. Zodiac Pool Sys. LLC</i> , Case No. 3:25-cv-01946 (S.D. Cal.), Dkt. 30-1
1020	Page from Fluidra’s Corporate Website, www.fluidrausa.com/en/company (captured on April 16, 2026)

No.	Exhibit
1021	Fluidra, S.A. 2025 Annual Report
1022	Photographs of Retail Packaging of the Polaris Freedom SC Cordless Robotic Pool Cleaner
1023	Declaration of Xingdi Li in Support of Petitioner's Response to Patent Owner's Brief Requesting That Institution of The Petition be Denied on Discretionary Grounds
1024	Declaration of Wei Yuan in Support of Petitioner's Response to Patent Owner's Brief Requesting That Institution of The Petition be Denied on Discretionary Grounds
1025	Zodiac Pool Systems LLC's Preliminary Infringement Contentions (served December 9, 2025), <i>Beatbot Tech. (USA) Co. Ltd. v. Zodiac Pool Sys. LLC</i> , No. 3:25-cv-01946 (S.D. Cal.)

I. INTRODUCTION

Contrary to Patent Owner's assertion, this proceeding is uniquely *unsuited* to the application of discretionary denial. When Patent Owner threatened Petitioner with suit, Petitioner promptly initiated judicial proceedings two weeks later. Petitioner initiated this IPR a mere *six months* after learning of the '766 Patent's existence, and a mere *six weeks* after Patent Owner identified the asserted claims.

Patent Owner attempts to support its request for discretionary denial by casting Petitioner as a foreign goliath, when really that is a better characterization of Patent Owner itself. Petitioner (Beatbot) and its real party-in-interest (Xingmai) are collectively a three-year-old startup with fewer than 500 employees and still in pre-IPO funding. Patent Owner (Zodiac) on the other hand is a wholly-owned subsidiary of a 50+ year-old publicly-traded Spanish corporation (Fluidra), with approximately 6,500 employees, operations in 47 countries, and a market cap in excess of \$5 *billion* USD. There is indeed a David and Goliath story here, but it is Beatbot/Xingmai as the scrappy startup that the long-in-the-tooth foreign goliath Zodiac/Fluidra is trying to chase out of the market with patents that should never have been granted.

For all of the background that Patent Owner casts in the wrong light, the details that Patent Owner fails to mention at all are equally as damning to its request. Zodiac emphasizes that Beatbot's pool cleaners are made in China, but fails to mention that its own pool cleaners are made in Malaysia. Zodiac emphasizes that it

competes with Beatbot, but fails to mention that it does not even practice the asserted patents. Zodiac points to boilerplate language in Beatbot’s invalidity contentions that make passing reference to indefiniteness, but fails to mention that the same document shows that Beatbot did not preserve any such indefiniteness positions.

Zodiac’s request is a thin shell of half-truths and omissions that is easily pierced on even a cursory review. The district court already expressed its preference for the Director and the Board to address invalidity when it granted a stay in favor of the IPR proceedings. For these reasons and others discussed below, the Director should decline to exercise discretion to deny institution.

II. INSTITUTION IS WARRANTED IN THIS CASE

A. The March 11, 2026 Memorandum Does Not Support Discretionary Denial Here

Patent Owner, Zodiac Pool Systems LLC (“Zodiac”), devotes the first and longest section of its brief to application of the March 11, 2026 Memorandum, *Additional Discretionary Institution Considerations* (“March 11 Memo”). The March 11 Memo outlines three specific factors for consideration: (1) the extent to which the accused products are manufactured in the United States; (2) the extent to which the patent owner’s competing products are manufactured in the United States; and (3) whether the petitioner is a small business that has been sued for infringement. March 11 Memo at 2. Zodiac alleges that “compelling economic interests” favor denial because it “employs hundreds of people in the U.S.A.” while “the RPI...

manufactures its products in China.” Patent Owner Brief (“POB”) at 3–7. That account is one-sided, and the full record shows these factors favor institution.

1. Factor 1: Beatbot’s Manufacturing Outside the U.S. Does Not Support Denial

The March 11 Memo does not create a blanket bar against IPR petitions filed by companies that manufacture abroad. Rather, its concern is the offensive use of IPRs by large multinational companies—“the most frequent users of IPR and PGR proceedings”—that lack any U.S. manufacturing stake. March 11 Memo at 1.

Petitioner, Beatbot Technology (USA) Co. Ltd. (“Beatbot”), is the opposite of that target. Beatbot is a startup company founded in 2022 that filed this Petition defensively after Patent Owner accused Beatbot of infringement in a July 2025 cease-and-desist letter. Declaration of Xingdi Li (“Li Decl.”) ¶ 4; Declaration of Wei Yuan (“Yuan Decl.”) ¶ 4. Beatbot is not a serial IPR filer wielding the PTAB against domestic innovation, but a small company exercising its statutory right under 35 U.S.C. § 311 to challenge claims asserted against it.

Although final assembly of the accused product occurs abroad, Beatbot maintains a meaningful and growing U.S. commercial presence: a U.S. customer support line; pop-up retail demonstrations in cities including Miami and Scottsdale; sales through Amazon and its U.S.-facing website; and sponsorship of the U.S. SailGP Team. Li Decl. ¶¶ 7–10. Patent Owner’s characterization of Beatbot as a “shell corporation” with no U.S. presence (POB at 3) is factually wrong.

2. Factor 2: Patent Owner's Competing Products Are Not Manufactured in the United States

The Memo's second factor asks whether Patent Owner's competing products are manufactured in the United States. Patent Owner does not engage with that question. *See generally* POB. Instead, Patent Owner contrasts its "623 employees in the United States" (POB at 4; Madrid Decl. (Ex. 2018) ¶ 3) with Beatbot's foreign manufacturing—implying that Zodiac is a domestic manufacturer defending U.S. operations against a foreign challenger. That implication is wrong. Patent Owner's corporate parent, Fluidra, is a Spanish multinational with 6,500 employees, 47 countries of operation, 135 sales offices, and 36 production centers worldwide. Yuan Decl. ¶ 9 (Ex. 1018).

Patent Owner describes no facts as to its own product relevant to this factor. It asserts only that its "Polaris line of pool cleaners" competes with the accused product. POB at 4. A representative example—the Polaris Freedom SC Cordless Robotic Pool Cleaner—is actually manufactured in Malaysia. Yuan Decl. ¶ 11 (Ex. 1020). And Patent Owner admitted in district court that its products do not even practice the '191 Patent. Yuan Decl. ¶ 12 (Ex. 1025 at 6–7).

The Memo aims to protect companies that invest in U.S. manufacturing—not to give one foreign-manufacturing party a tactical edge over another because its corporate parent employs more U.S.-based sales and marketing staff. Where none of the relevant products are U.S.-manufactured, this factor is at best neutral.

3. Factor 3: Beatbot Is a Small Business That Has Been Sued for Infringement

The March 11 Memo also considers “all relevant facts that the parties raise, including the Small Business Administration’s size standards set forth in 13 C.F.R. §§ 121.801 through 121.805 and 37 C.F.R § 1.27(a) that would render a person, business, or nonprofit organization eligible for reduced patent fees,” and “encourages petitioners who are small businesses that have been sued for infringement to identify themselves to assist the Office in understanding how frequently small businesses use IPRs and PGRs to defend against claims of infringement.” March 11 Memo at 1–2.

Beatbot fits squarely within that category. Under 37 C.F.R. § 1.27(a), a “small entity” is a business concern with fewer than 500 employees. Beatbot, including its real parties-in-interest, Xingmai Innovation Technology (Suzhou) Co., Ltd. (“Xingmai”), satisfies that threshold. Li Decl. ¶ 6.

Patent Owner’s contrary arguments miss the mark. Patent Owner points to (i) marketing materials referencing “500+ patents,” “100,000+ customers,” and “2,000+ retail stores” (POB at 5, citing Ex. 2019), and (ii) an approximately “USD 140 million” venture funding round (POB at 5, citing Ex. 2014). Neither speaks to the controlling standard. The Memo pegs the small-business inquiry to the SBA size standards and § 1.27(a), which turn on employee headcount—not patent counts, customer counts, retail partnerships, or capital raised. The \$140 million figure, in

particular, reflects investor capital committed to fund operations, not Beatbot's valuation, revenue, or profit; many venture-backed startups with nine-figure funding rounds remain pre-profitability.

The David-and-Goliath comparison Patent Owner invites is also the reverse of what Patent Owner suggests. Patent Owner highlights its “623 employees in the United States” (POB at 4) without disclosing that Zodiac is a wholly owned subsidiary of Fluidra, S.A. (“Fluidra”), a publicly traded, Spain-headquartered multinational with approximately 6,500 employees worldwide (Yuan Decl. ¶ 9 (Ex. 1018)), a market capitalization of approximately \$5.2 billion USD (Yuan Decl. ¶ 10 (Ex. 1019 at 29)), and numerous subsidiaries across multiple geographic regions (Yuan Decl. ¶ 10 (Ex. 1019 at 53–57)). Beatbot, by contrast, is a roughly three-year-old startup with fewer than 500 employees. Li Decl. ¶¶ 4, 6. The Memo was designed to surface precisely this asymmetry—a small business defending an infringement campaign by a well-resourced patent owner—and it favors institution here.

B. The Merits of the Petition Are Strong, and the Prior Art Was Not Meaningfully Addressed During Prosecution

Patent Owner attacks the Petition's merits on four grounds: (i) the Petition relies on obviousness rather than anticipation; (ii) Durvasula was “considered” during prosecution; (iii) the priority-date challenge is “improper in this forum”; and (iv) Fu-007 was also “considered.” POB at 6–8. Each is incorrect.

1. The Absence of Anticipation Grounds Does Not Indicate Weak Merits

Patent Owner argues that “Petitioner’s failure to identify any anticipatory art serves as an initial indication of the weaknesses of the Petition’s merits.” POB at 6. This is a non sequitur. Obviousness under § 103 is a fully independent statutory ground. The Petition presents *four* independent grounds across *four* primary references (Petition at 2)—not the “eight grounds” Patent Owner alleges (POB at 6). The strength of a petition should be measured by the quality of its obviousness showing—not by the absence of § 102 grounds, and Patent Owner identifies no authority equating an obviousness-only petition with a weak one.

2. The Priority Date Challenge Is Legally Proper

Patent Owner argues that the Petition’s priority-date challenge “attempts to raise a Section 112(a) challenge for lack of written description, which necessarily is improper in this forum.” POB at 6. That mischaracterizes the Petition. The Petition does not challenge the validity of the ’766 Patent under § 112(a). It challenges the ’766 Patent’s entitlement to the July 10, 2012 filing date of the ’918 Application—an antecedent inquiry that determines whether certain references qualify as prior art under § 102. Petition at 7–18. The Federal Circuit has squarely held that petitioners may make exactly that showing in IPR. *See Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1373–74 (Fed. Cir. 2023); *Indivior UK Ltd. v. Reddy’s Labs. S.A.*, 18 F.4th 1323, 1328–30 (Fed. Cir. 2021).

The Petition identifies two limitations recited in Claims 1–5 of the ’766 Patent that find no written description support in the ’918 Application: (i) the “controller... on or in the body” and (ii) “away from” limitations. Petition at 7–16. The absence of either limitation independently defeats the ’766 Patent’s claim of priority to the July 10, 2012 filing date.

a. The Specification Does Not Disclose “a Controller Positioned On or In the Body.”

The ’918 Application—U.S. Application No. 13/545,918, filed July 10, 2012—is the earliest application in the ’766 Patent’s claimed priority chain. Petition at 4–5; EX1001, field (63). It uniformly describes controller 42 as remote from the vehicle body—never “on or in” it. The specification depicts controller 42 as part of dry station 46/246, portable electronic device 464, or remote server 254/554, in each case located outside the pool and connected to the submerged vehicle only by wired or wireless communication links. Petition at 8–13. Every figure confirms this architecture: FIG. 1 (controller 42 outside pool 22, remote from vehicle 30); FIGS. 2, 4, and 9 (controller 42 in dry station 46/246 or portable electronic device 464); FIGS. 3 and 5 (controller 42 in remote server 254/554). Petition at 9–12. The ’918 Application nowhere describes or suggests positioning the controller on or in the vehicle body. Petition at 12–13.

The four paragraphs Patent Owner identifies (§§[0020], [0021], [0023], [0029]) confirm rather than rebut this gap. POB at 6–7. Paragraphs [0020] and

[0023] describe what controller 42 is and what it does—not where it sits. Paragraph [0021] describes controller 42 as “communicat[ing] with vehicle 30” across a wired or wireless connection—language that presupposes physical separation between controller and vehicle. Paragraph [0029] places the controller in or accessible through dry station 246, which is outside the pool. None describes a controller on or in the vehicle body.

Claims 1–5 of the ’766 Patent recite “a controller (i) positioned on or in the body” and therefore cannot claim priority to July 10, 2012. The earliest application disclosing this limitation is the ’065 Application, filed July 11, 2016. Petition at 7–18. Once the priority date shifts to no earlier than that date, all four primary references (Durvasula, Cui, Knoll, and Renaud) qualify as prior art under AIA § 102(a)(1). The ’918 Application also fails to support a separate limitation in Claims 1–5: “at least one control signal to cause movement of the body within the swimming pool...away from...the first portion of the submerged surface.” Patent Owner does not address this defect, which independently defeats the 2012 priority date for Claims 1–5.

3. The Prior Art Was Not Meaningfully “Addressed and Overcome” During Prosecution

Patent Owner contends that “Durvasula’s specification...was considered in the original prosecution, as was the asserted secondary reference, Fu-007.” POB at

7–8. The record shows otherwise. Application claims 20–22, which issued as Claims 1–3, were never subjected to any substantive prior art examination.

The '766 Patent issued from U.S. Application No. 17/143,624 (the “'624 Application”), which claims priority through a series of intermediate continuations to the earliest '918 Application. EX1001, fields (21), (63); Petition at 4–5. Applicant filed a preliminary amendment in the '624 Application cancelling original Claims 1–19 and adding new independent Claims 20–24, explaining they were “variants of allowed claim 20 of the Allowed Parent” and “retain features identified by the Examiner as patentable in the Allowed Parent Application.” EX1002 at 40–42. The sole Office Action contained only a non-statutory double-patenting rejection, which Applicant overcame via a terminal disclaimer; no § 102 or § 103 rejection was ever issued against Claims 20–24, which later issued as Claims 1–5 of the '766 Patent. EX1002 at 70–86, 116–118, 132–138. Consistent with that history, the Notice of Allowability stated that the references of record, alone or in combination, failed to disclose the controller features. EX1002 at 132–138.

Moreover, Fu-007 was listed in an IDS but was never mentioned, analyzed, or applied to any claim during prosecution of the '766 Patent or its priority chain. EX1002 at 57, 93. This is the paradigm case of examiner error warranting institution. As the Board has recognized, material error during examination—particularly an examiner’s failure to apply highly relevant prior art—renders discretionary denial

inappropriate. *See Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at 3 (PTAB July 16, 2025) (informative); *Spectrum Sols. LLC v. DNA Genotek Inc.*, IPR2022-00134, Paper 7 at 13 (PTAB June 6, 2022) (granting institution “[g]iven the simple nature of [the examiner] error (not applying a known anticipatory prior art reference), and the strength of the anticipation showing in the Petition”). Nor is Fu-007 cumulative of the prosecution record. The Petition applies Fu-007 in specific obviousness combinations with Durvasula, Cui, Knoll, and Renaud—combinations the Examiner never considered—supported by expert testimony the Examiner never had. Petition at 2.

4. The Petition Relies on Four Independent Primary References—Not “Cumulative” Art

Patent Owner attempts to create the impression that the Petition is narrowly built on Durvasula and Fu-007—two references that were alleged “already considered.” POB at 6–8. This misrepresents the scope of the Petition. The Petition presents *six* grounds of obviousness across *four* independent primary references. Petition at 2. Critically, Grounds 3 and 4 (Knoll and Renaud) are standalone grounds that do not rely on Durvasula or Fu-007 at all. Neither Knoll nor Renaud was cited, discussed, or considered during the prosecution of any member of the ’766 Patent family. It is impossible for Patent Owner to characterize Knoll and Renaud as “the same or cumulative of art addressed and overcome during prosecution” when the

Examiner never saw them. Unable to make such a characterization, Patent Owner ignores these grounds entirely in its request.

5. Patent Owner’s “Other Deficiencies” Are Unsubstantiated

Patent Owner states that “[t]he other references have further deficiencies, which will be discussed in more detail in Patent Owner’s Preliminary Response.” POB at 8. This is not an argument—it is a placeholder. The merits should be evaluated based on what Patent Owner has actually articulated, not on the promise of future contentions. Moreover, Patent Owner stopped its argument six pages short in the request, and so certainly had—but did not use—the opportunity to explain the supposed deficiencies in these additional grounds.

C. Patent Owner’s Remaining Arguments Are Meritless

Patent Owner further argues—inconsistent claim construction positions, heavy reliance on expert testimony, settled expectations, and the contention that IPR is not a “true alternative.” POB at 8–15. Each of these is either factually incorrect, legally unsupported, or both.

1. Petitioner’s Claim Construction Positions Are Consistent

Patent Owner argues that Petitioner “takes inconsistent claim construction positions regarding the scope of the Challenged Claims” by seeking broad constructions at the PTAB while “arguing that several terms are indefinite under § 112 in the District Court.” POB at 8–9 (citing Ex. 2005 at 14). This argument is misleading, and Patent Owner knew it was misleading when it filed its brief.

In its Petition, Petitioner stated that “no constructions are necessary except for the means-plus-function (MPF) limitation.” Petition at 16. In the District Court, the parties filed a Joint Claim Construction Hearing Statement and Joint Claim Construction Worksheet on March 23, 2026—one week *before* Patent Owner filed its brief, confirming that “[t]he Parties identified one term for construction, and the Parties reached an agreed construction for that term.” Yuan Decl. ¶ 6 (Ex. 1018 at 2). The single term the parties agreed upon is the means-plus-function limitation—the same and only term Petitioner identified for construction in its Petition. *Id.* There is no inconsistency; Petitioner’s IPR position (only the MPF term requires construction) is identical to its District Court position. *Compare* Petition at 16–17 *with* Ex. 1018 at 2. Patent Owner was a signatory to the Joint Statement, and therefore knew that Petitioner’s claim construction positions are consistent when it filed its brief on March 30, 2026. Patent Owner’s characterization of an inconsistency is not merely wrong; it is a misrepresentation.

Moreover, Patent Owner’s reliance on the boilerplate § 112 language in Beatbot’s Preliminary Invalidity Contentions (Ex. 2005 at 14) is equally misleading. Beatbot served its Preliminary Invalidity Contentions before the proposed claim construction, and the passage Patent Owner quotes is standard reservation-of-rights language preserving Beatbot’s right to assert § 112 defenses based on claim constructions that may later be adopted. Beatbot’s invalidity contentions do not

assert any actual § 112(b) indefiniteness ground. *See* Ex. 2005 at 27–29. Thus in the only two places that Beatbot could have presented actual indefiniteness positions, it did not do so. A fact that Patent Owner was fully aware of, but apparently did not consider worth bringing to the Director’s attention.

2. Petitioner’s Reliance on Expert Testimony Was Appropriate

Patent Owner argues that Petitioner’s “extremely long declaration presents a text-book case of over-reliance on an expert” because “large swaths of the Petition are identical copy-and-paste from Dr. Janét’s purported testimony.” POB at 9–11. This argument fails as a matter of law and fact.

As a matter of law, since the March 2025 Interim Processes Memo, reliance on expert testimony has favored discretionary denial only where unsupported expert testimony was offered to fill gaps in the prior art—not because a petition and declaration are similar. *See, e.g., iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00378, Paper 10 at 2–3 (June 6, 2025) (rejecting assertion that petitioner is “over-reliant on expert testimony” when nothing “suggest[s] Petitioner is using its expert to fill gaps in the prior art”); *Cambridge Indus. USA, Inc. v. Applied Optoelects., Inc.*, IPR2025-00437, Paper 10 at 2 (June 26, 2025) (same). Patent Owner has not identified a single instance where Dr. Janét’s testimony was used to fill gaps in the prior art rather than to explain and apply the references.

Patent Owner’s comparison chart (Ex. 2021) is itself misleading. Patent Owner’s chart omits more than 40 pages of expert analysis, including Dr. Janét’s definition of a POSITA, his explanation of relevant legal standards, his overview of the technology and its historical development, his walkthrough of the ’766 Patent, and his analysis of the prosecution history, priority date, and claim construction. *See, e.g.,* Janét Decl. ¶¶ 28–49, 60–96. Patent Owner characterizes these omissions as “non-substantive” or “identical”—but the omitted material includes Dr. Janét’s independent technical conclusions on the most contested issues in this proceeding, including the priority-date analysis on which the Petition’s prior-art case depends.

Moreover, the decisions Patent Owner cites do not support its argument. Each predates bifurcated review, involved the Board’s merits evaluation at institution, and discounted the proffered testimony because it was conclusory and filled gaps in the prior art—not because the testimony resembled the petition.

3. Patent Owner Has No Settled Expectations

Patent Owner argues that “[s]ettled expectations weigh in favor of denial” based on (i) Petitioner’s awareness of the Challenged Patent for “over six months” and (ii) the age of the patent family. POB at 11–13. Neither argument has merit.

The ’766 Patent issued on March 1, 2022. It is less than five years old. Patent Owner has no settled expectations regarding a patent of this youth. As the Director has repeatedly recognized, early challenges to young patents favor robust,

predictable patent rights and weigh against discretionary denial. *See Light & Wonder, Inc. v. Evolution Malta Ltd.*, IPR2025-01072, Paper 11 at 2 (Oct. 17, 2025) (no strong settled expectations for patents issued in 2020, 2021, and 2023); *see also Samsung Elecs. Co. v. Wilus Inst. of Standards & Tech. Inc.*, IPR2025-00935, Paper 12 at 2–3 (Sept. 26, 2025).

Patent Owner’s reliance on Petitioner’s “six months” of awareness is unavailing. Petitioner received Patent Owner’s cease-and-desist letter on July 17, 2025, filed a declaratory judgment action two weeks later, and filed this Petition on January 26, 2026—just six weeks after Patent Owner served its preliminary infringement contentions. Ex. 2024 at 6; Yuan Decl. ¶ 12 (Ex. 1025). Indeed, the District Court considered Patent Owner’s identical “delay” argument in the parallel litigation and expressly rejected it, finding that Petitioner’s “delay in filing petitions for IPR is not as great as [Defendant] suggests.” *Id.* That chronology reflects prompt defensive action at every stage, not the long-standing, business-building reliance on a patent’s existence that the settled-expectations doctrine targets.

Patent Owner’s reliance on the patent family’s age fares no better. Patent Owner argues that “family members first issued nearly a decade ago.” POB at 12. But the relevant inquiry is the age of the challenged patent. Each patent in a family has its own claims and its own validity, and the ’766 Patent issued in 2022 with claims that were never substantively examined against prior art. *See* § II.B.3, *supra*.

Patent Owner cannot bootstrap settled expectations from an older family member to shield a young patent whose claims were allowed through examiner error.

4. This IPR Is a True Alternative to District Court Litigation

Patent Owner argues that “Petitioner’s conduct to date suggests that IPR is not a true alternative to District Court litigation.” POB at 13–14. This argument is contradicted by the record—and, remarkably, by Patent Owner’s own prior representations to the District Court.

Patent Owner first faulted Petitioner for not filing a *Sotera* stipulation. In opposing Beatbot’s motion to stay, Patent Owner argued: “Beatbot has not filed a *Sotera* stipulation in support of its IPR petitions . . . In not agreeing to refrain from such challenges, Beatbot indicates to both the PTAB and to this Court that other invalidity grounds (or the same specific grounds) may—or will—be brought in this action, undermining any claim of simplification.” Yuan Decl. ¶ 7 (Ex. 1019 at 6–7). Petitioner then filed a *Sotera*-plus stipulation, expressly agreeing not to advance in the District Court “(i) the specific grounds raised in the IPRs; (ii) any other grounds that could have reasonably been raised before the PTAB (i.e., any 35 U.S.C. §§ 102 or 103 grounds based on prior art patents or printed publications); or (iii) any ground based on a combination of system prior art and the prior art patents or printed publications described in (i) or (ii).” Paper 6; Ex. 2024 at 4. Patent Owner now asks

the Director to “discount” the very stipulation it told the District Court was essential. POB at 13–14.

The District Court agreed with Petitioner and stayed the litigation pending these IPR proceedings. Ex. 2024 at 12. That ruling is powerful confirmation that this IPR is a meaningful and potentially dispositive proceeding—the opposite of Patent Owner’s “not a true alternative” position. With the litigation now stayed, there is no risk of duplicative proceedings; the IPR is the only currently active invalidity forum.

Patent Owner’s remaining grounds for “discounting” the stipulation also fail. Patent Owner points to Petitioner’s § 101 motion for judgment on the pleadings and to boilerplate § 112 language in Petitioner’s invalidity contentions. POB at 13–14. Patent Owner would require a petitioner to waive patent eligibility challenges that the PTAB cannot adjudicate, and that is not the law. The District Court denied the § 101 motion without prejudice precisely because “if IPRs are instituted, the decision of the PTAB could simplify the issues presently before the Court in Plaintiffs’ Motion to Dismiss.” Ex. 2024 at 12–13. The court is deferring to this proceeding, not running parallel to it. As to § 112, Petitioner has not asserted any actual indefiniteness invalidity positions. *See* §II.C.1, *supra*.

5. The RPI’s Patent Application Does Not Support Denial

Patent Owner argues that because the RPI, Xingmai, is prosecuting a patent application with claims of allegedly “similar scope” to the challenged patent, this

“weighs in favor of discretionary denial.” POB at 14–15. This argument is a non sequitur. The fact that Xingmai is seeking its own patent for pool robot technology does not present inconsistencies. It reflects the normal operation of the patent system, and each patent must independently satisfy the requirements of patentability.

D. The *Fintiv* Factors Uniformly Favor Institution

Patent Owner conspicuously declined to address the *Fintiv* factors in its brief. The reason is apparent: the factors weigh strongly against discretionary denial.

1. Factor 1: The District Court Has Stayed the Litigation

The District Court stayed the litigation in the Southern District of California pending these IPR proceedings. Ex. 2024. This factor weighs strongly against discretionary denial.

2. Factor 2: No Trial Date Exists

With the litigation stayed, there is no trial date. There is thus no risk that the district court trial will precede the Final Written Decision—there is no trial to precede it. This factor also weighs strongly against discretionary denial.

3. Factor 3: Minimal Investment of Resources

The district court case is in its early stages. Ex. 2024 at 6. The parties exchanged infringement and invalidity contentions. The parties reached an agreed construction on the single term at issue and requested that the court vacate all other claim construction proceedings. *Id.* No expert reports have been served, and no depositions have been taken. *Id.* This factor weighs against discretionary denial.

4. Factor 4: The *Sotera-Plus* Stipulation Eliminates Duplicative Adjudication

As discussed above, Petitioner filed *Sotera-plus* stipulation (Paper 6). There will be no duplicative adjudication of the issues presented in this Petition. This factor weighs strongly against discretionary denial. *See Toyota Motor Corp. v. AutoConnect Holdings LLC*, PGR2025-00041, Paper 9 at 3 (Sept. 8, 2025).

5. Factor 5: Substantially the Same Parties

Beatbot is the Petitioner and the district court plaintiff/counterclaim-defendant. Zodiac is the Patent Owner and the district court defendant/counterclaim-plaintiff. The overlap of parties is complete, and thus this factor is neutral.

6. Factor 6: The Merits of the Petition Are Strong

The Petition presents six grounds of obviousness under § 103 across four independent primary references. Petition at 6. Patent Owner's entire merits defense is conclusory and fails to engage with the substance of the prior art. *See Genius Sports Ltd. v. Sportscast Inc.*, IPR2024-01310, Paper 47 (Mar. 13, 2026) (conclusory assertions do not create a dispute over patentability). This factor weighs strongly in favor of institution.

* * *

In sum, every *Fintiv* factor either weighs against discretionary denial or is neutral. Patent Owner's decision not to address *Fintiv* was a strategic concession because it had nothing favorable to say.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that true copies of the foregoing PETITIONER'S RESPONSE TO PATENT OWNER'S BRIEF REQUESTING THAT INSTITUTION OF THE PETITION BE DENIED ON DISCRETIONARY GROUNDS and associated exhibits have been served on Patent Owner at the following address:

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Christopher S. Leah, cleah@ktslaw.com

Dated: April 28, 2026

By: /Meghan Bright/
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