

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

X CORP.
Petitioner

v.

SEARCH AND SHARE
TECHNOLOGIES, LLC,
Patent Owner

Case No. IPR2026-00235
U.S. Patent No. 11,106,744

PETITIONER'S OPPOSITION TO
PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

TABLE OF CONTENTS**Page**

I.	Introduction.....	1
II.	The Board Should Institute Review Based On Patent Owner Overreach, Examiner Error, And Strong Prior Art.....	2
A.	Patent Owner’s Assertion Of A “Web Search” Patent Against A Social Media Company Supports Institution.	2
B.	The Examiner’s Error—Allowing Claims Rejected As Obvious In A Predecessor Application—Supports Institution.....	3
C.	The Strength Of The Prior Art Supports Institution.	6
III.	Neither Any Settled Expectations Nor The Existence Of A Parallel Litigation Weigh Against Institution.....	9
A.	Patent Owner Has No Legitimate Settled Expectations In The Validity Of The ’744 Patent.	9
1.	The ’744 Patent Issued Less Than Five Years Ago.....	9
2.	No Evidence Suggests That Patent Owner Ever Used The ’744 Patent Before 2025, When It Sued X.	10
B.	The Parallel District Court Litigation Was Stayed At Its Outset, Thus The <i>Fintiv</i> Factors Strongly Favor Institution.....	10
IV.	Section 325(d) Provides No Basis For Discretionary Denial Because The Petition Presents New Grounds, Not Cumulative Of Those Considered During Prosecution.....	12
A.	Patent Owner’s § 325(d) Argument Fails At <i>Advanced Bionics</i> Step One—The Petition Presents New, Non-Cumulative Grounds Based On The New Palmon Reference.	12
B.	Neither <i>Advanced Bionics</i> Step Two Nor <i>Becton Dickinson</i> Applies To The Newly Presented Art And Grounds In The Petition.....	15

Opposition to Request for Discretionary Denial

C.	No Policy Considerations Support Applying § 325(d).	16
V.	Patent Owner’s Other Objections Have No Merit.	17
A.	Patent Owner’s 35 U.S.C. § 314(a) Arguments Do Not Support Denial Of Institution.	17
B.	Patent Owner’s Argument Regarding “Claim Construction Behavior” Is Specious.	18
VI.	Conclusion	20

TABLE OF AUTHORITIES

	Page(s)
<u>Cases</u>	
<i>Abbott Labs v. Miracor Medical SA</i> , IPR2025-00116, Paper 13 (PTAB Jun. 11, 2025).....	19
<i>Activision Blizzard, Inc. v. Milestone Entertainment, LLC</i> , IPR2025-00708, Paper 13 (Dir. Aug. 14, 2025)	4
<i>Advanced Bionics LLC v. MED-EL Elektromedizinische Geräte GmbH</i> , IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020)	13
<i>Berkshire Hathaway Energy Co. v. Birchtech Corp.</i> , IPR2025-00274, Paper 23 (Dir. Jul. 2, 2025).....	9
<i>Comcast Cable Comms., LLC v. Rovi Guides, Inc.</i> , IPR2017-01145 Paper 8 (PTAB Nov. 7, 2017).....	19
<i>Ecto World, LLC v. RAI Strategic Holdings, Inc.</i> , IPR2024-01280, Paper 13 (PTAB May 19, 2025)	16
<i>Home Depot U.S.A., Inc. v. H2 Intellect LLC</i> , IPR2025-00480, Paper 11 (Dir. Sep. 4, 2025)	2
<i>Intel Corp. v. Proxense LLC</i> , IPR2025-00327, Paper 12 (Dir. Jun. 26, 2025).....	10
<i>Microsoft Corp. v. Partec Cluster Competence Center GMBH</i> , IPR2025-00318, Paper 9 (Dir. Jun. 12, 2025).....	4
<i>OnePlus Tech. (Shenzhen) Co. v. Pantech Corp.</i> , IPR2025-00756, Paper 11 (Dir. Oct. 3, 2025).....	9
<i>Shenzen Tuozhu Tech. Co. v. Stratasys, Inc.</i> , IPR2025-00438, Paper 10 (Dir. Jul. 17, 2025).....	9
<i>Tesla, Inc. v. Intell. Ventures II LLC</i> , IPR2025-00217, Paper 9 (Dir. Jun. 13, 2025).....	11

Opposition to Request for Discretionary Denial

Unified Patents LLC v. Togail Techs., Ltd.,

IPR2023-00338, Paper 7 (PTAB Aug. 18, 2023).....18

Statutes

35 U.S.C. § 325(d) 1, 12, 16

PETITIONER’S EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent No. 11,106,744 (“’744 Patent”).
1002	Declaration of Dr. Loren G. Terveen
1003	U.S. Patent Publication No. 2006/0059134 to <i>Palmon</i> (“Palmon”).
1004	U.S. Patent Publication No. 2005/0234891 to <i>Walther</i> (“Walther”).
1005	U.S. Patent Publication No. 2005/256866 to <i>Lu</i> (“Lu”).
1006	U.S. Patent Publication No. 2009/0299824 to <i>Barnes Jr.</i> (“Barnes”).
1007	U.S. Patent Publication No. 2010/0011282 to <i>Dollard et al.</i> (“Dollard”).
1008	File History of U.S. Patent No. 11,106,744
1009	File History of U.S. Patent Application No. 15/142,479
1010	File History of U.S. Patent Application No. 13/420,503
1011	U.S. Patent No. 6,219,045 to <i>Leahy et al.</i> (“Leahy”).
1012	Comparison Between Claims of the ’744 Patent and Claims of the U.S. Patent Application No. 13/420,503, as filed.
1013	U.S. Patent No. 8,788,492 to Lu et al. (“ <i>Lu Patent</i> ”)
1014	File History of U.S. Patent Application No. 11/081,860 (“Walther Application”).
1015	U.S. Patent Publication No. 2006/0069699 to <i>Smadja et al.</i> (“Smadja”)
1016	Stipulation
1017	<i>Search and Share Techs. v. X Corp.</i> , No. 1:25-CV-01540-RP (W.D. Tex.), Dkt. 42 (Order Granting Motion To Stay) (Apr. 2, 2026)

I. INTRODUCTION

Search and Share Technologies has taken recently issued U.S. Patent No. 11,106,744 (“’744 Patent”), which it characterizes as directed to a “web-search system” (Paper 7 (“Br.”) 4), and sued X Corp. (“X”) for infringement based on the X social media platform (an entirely different technology). But the ’744 Patent does nothing more than rehash ground covered by the prior art (unsurprisingly, as web search has existed since the dawn of the Internet). Indeed, the challenged claims were previously found to be obvious and issued only due to an examiner error.

Against that backdrop, X promptly identified prior art and filed an *inter partes* review Petition challenging the ’744 Patent on multiple grounds. And that Petition is strong. Patent Owner effectively concedes that the Petition’s prior art discloses all but one element of the claims and, as explained in Section II.C, that prior art indisputably discloses that purportedly missing element as well.

Moreover, the ’744 Patent presents the paradigmatic case for *inter partes* review. There are no settled expectations, because the ’744 Patent has been in force for less than five years, and Patent Owner provides no evidence of reliance, commercialization, or use. The District Court stayed the parallel litigation before it even entered a schedule, thus there is no risk of inconsistency or inefficiency and all *Fintiv* factors support institution. And the Petition presents new prior art, different from that considered during prosecution, rendering § 325(d) inapplicable.

Opposition to Request for Discretionary Denial

Recognizing the strength of the Petition, Patent Owner argues for discretionary denial, accusing X of “subterfuge” and a “hide-the-ball” approach to claim construction (Br. 1, 5-7), but those inflammatory accusations are contradicted by the record. Indeed, the provocative nature of Patent Owner’s arguments underscores its weak position—the Petition is timely, compelling, and provides an efficient means for resolving the parties’ dispute regarding validity. Accordingly, X respectfully requests that the Petition be referred to the merits panel.

II. THE BOARD SHOULD INSTITUTE REVIEW BASED ON PATENT OWNER OVERREACH, EXAMINER ERROR, AND STRONG PRIOR ART.

A. Patent Owner’s Assertion Of A “Web Search” Patent Against A Social Media Company Supports Institution.

First, the Board should institute review of the ’744 Patent because the Patent Owner has taken a patent directed to one technology—web search—and attempted to assert it against a different technology—social media. Where a patent owner takes a patent directed toward one technology and directs it toward another, that weighs against discretionary denial. *See Home Depot U.S.A., Inc. v. H2 Intellect LLC*, IPR2025-00480, Paper 11, 2–3 (Dir. Sep. 4, 2025) (assertion of patent that “previously targeted smartphones, tablets, and watches” against “proprietor of a chain of hardware stores” weighed against discretionary denial). That is so because X had no reason to challenge the validity of the ’744 Patent before now—there was no expectation that X would be targeted by a patent directed to a fundamentally

Opposition to Request for Discretionary Denial

different space for a technology that has existed since the dawn of the Internet.

No dispute exists that the '744 Patent is a “web search” patent. Patent Owner itself characterized the patent as “directed to a web-search system” and described the system in terms of its behavior “when another user performs a web search.” Br. 4. The claims address “search results comprising . . . web content” (EX1001, Claim 1), and the specification describes a “search engine to index web content” (EX1001, Abstract). The specification even contrasts the purported invention with other well-known web-search engines, “such as GOOGLE® and BING®.” EX1001, 3:53–4:32; 8:41–47. And Patent Owner’s complaint against X asserted that its patents “address deficiencies in conventional search engines.” EX2001 (Am. Compl.) ¶ 18.

By contrast, X is a social media platform, not a web search engine like that described in the '744 Patent. Patent Owner itself has described X as “one of the world’s most influential social media and communications companies.” EX2001 ¶23. And Patent Owner’s allegations focus on X’s “flagship” social media platform, not web search. *See, e.g.*, EX2001 ¶¶ 32, 40, 65, 81 (accusing “X’s platform” of meeting various claim limitations).

B. The Examiner’s Error—Allowing Claims Rejected As Obvious In A Predecessor Application—Supports Institution.

Second, the Board should institute review of the '744 Patent to correct a material error by the Examiner—the inconsistent treatment of the same claims across two related applications. *See Activision Blizzard, Inc. v. Milestone Entertainment,*

Opposition to Request for Discretionary Denial

LLC, IPR2025-00708, Paper 13 at 2–3 (Dir. Aug. 14, 2025); *Microsoft Corp. v. Partec Cluster Competence Center GMBH*, IPR2025-00318, Paper 9 at 3 (Dir. Jun. 12, 2025) (“Petitioner appears to show a material error by the Office and it is an appropriate use of Office resources to review the potential error.”).

A predecessor application, the ’503 Application, was originally filed with claims *identical* to the Challenged Claims of the ’744 Patent. *See* Pet., 7–8; EX1012 (showing that the original ’503 Application claims were identical to the Challenged Claims). During prosecution of the ’503 Application, the examiner twice rejected those claims as obvious over two references, Barnes and Dollard. *See* EX1010, 82–88, 128–140. And the applicant (Patent Owner) ultimately conceded and overcame those rejections only after making substantial narrowing amendments to the claims. *See* EX1010, 283–286.

Then, in a grandchild continuation application that led to the ’744 Patent, the applicant reverted to the originally rejected ’503 Application claims. But this time, the same Examiner allowed those same claims without any amendment. *See* Pet., 8; EX1008, 182–185, 207–213; EX1010, 40–43; EX1001, Claims 1–20. Critically, the Examiner allowed the previously-rejected claims without even applying the Barnes and Dollard references nor providing any explanation. *See* EX1008, 186–187 (omitting Barnes and Dollard from the sole Office Action). The Examiner’s failure to apply Barnes and Dollard during the prosecution of the ’744 Patent—and to reject

Opposition to Request for Discretionary Denial

its claims accordingly—is a material error: the claims should have been rejected as obvious, just as they repeatedly were in the '503 Application.

The allowance of claims that were repeatedly rejected in the earlier application calls the '744 Patent's claims into serious question, and that weighs strongly against discretionary denial. In *Activision*, the Office found merits review warranted where “the challenged claims omit limitations added during prosecution of the parent patent that appear to have been the patent examiner’s reason for allowing the parent patent’s claims,” concluding that, “[u]nder these circumstances, it is an efficient use of Board resources” to address the challenged patent. *Activision*, 5. The same principle applies here. The '744 Patent's claims omit the narrowing amendments that were added during prosecution of the '503 Application and formed the basis for allowance of that application. By reverting to broader claims that had previously been rejected as unpatentable, the '744 Patent reintroduced claim scope that the Examiner had already found unpatentable. Accordingly, the '744 Patent presents precisely the circumstance *Activision* found warranted Board review.

Patent Owner argues that Examiner nominally “considered both references” (Br. 16), but that is no excuse for allowing the *same claims* rejected as obvious in a previous application. Even if those references are listed as purportedly “considered” because they were included in an IDS, the Examiner did not apply *Barnes* and *Dollard* to the Challenged Claims. EX1008, 186-187. And the inconsistency itself

Opposition to Request for Discretionary Denial

is proof of error—the same claims cannot be both obvious and unpatentable (in the '503 Application) and allowable (in the '744 Patent). That error warrants review of the Challenged Claims here.

C. The Strength Of The Prior Art Supports Institution.

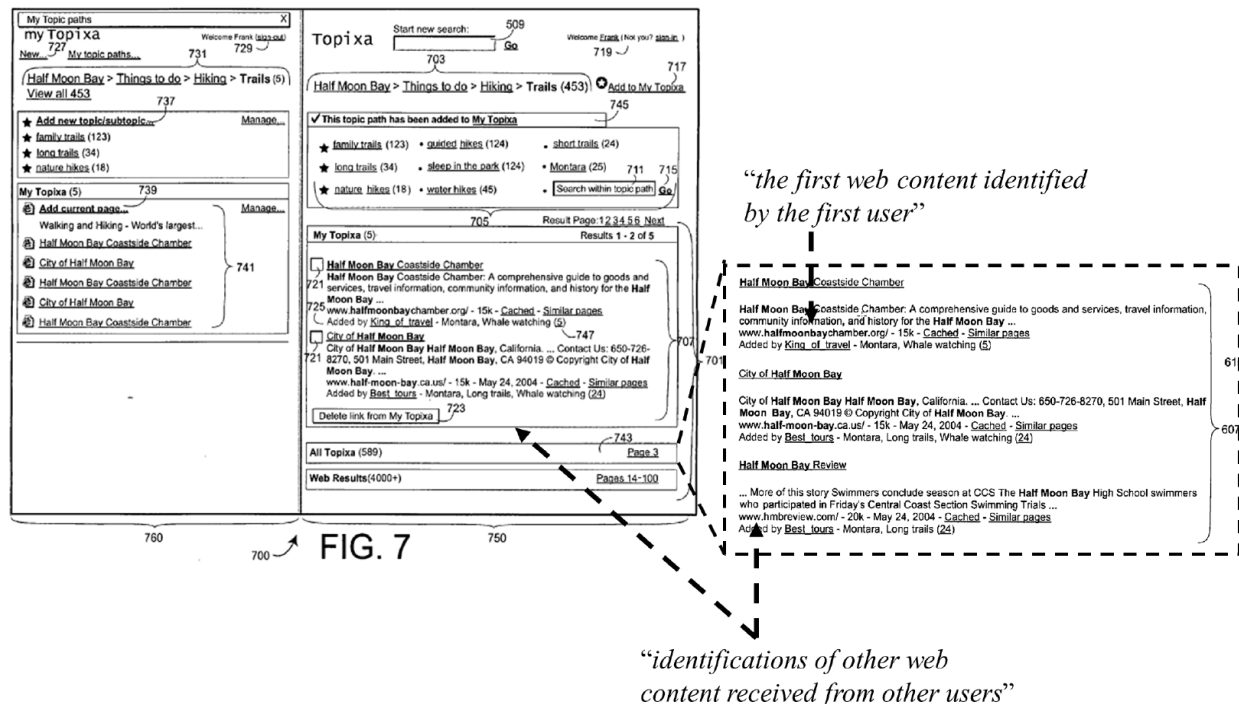
Third, the Board should institute review of the '744 Patent based on the strength of the grounds in the Petition, which disclose the very element that Patent Owner contends was missing from the prior art considered during prosecution.

As an initial matter, Patent Owner effectively concedes that the prior art relied upon in the Petition discloses nearly all of the claim limitations. Patent Owner itself helpfully maps the prior art to those limitations. *See* Br. 8-11 (analyzing the prior art), 13 (mapping prior art to claim limitations). Patent Owner identifies only one element supposedly “missing from the prosecution art,” which it describes as “search results with user-identified content positioned ‘relative to’ other user-identified content within a unified ranking.” *Id.*, 11, 13. That description corresponds to the final limitation of claim 1, which requires search results “comprising the first web content identified by the first user in a position *relative to* identifications of other web content received from other users.” EX1001, claim 1.¹

¹ An identical requirement appears in independent claim 10, although it is not present in the independent claim 19. EX1001.

Opposition to Request for Discretionary Denial

The Petition squarely addresses—and demonstrates—that the additional limitation was also disclosed by the prior art. Specifically, it explains how Palmon discloses search results in which content identified by one user is positioned relative to content identified by other users as required by that limitation: “the search results include the URL and web content identified by King_of_travel (*‘first user’*) in a position relative to URLs received from Frank (in the My Topixa section) and Best_tours (*‘other users’*), as illustrated below.” Pet., 37. The Petition further demonstrates this point using annotated figures from Palmon, showing contents from different users positioned relative to each other:



Pet., 38 (showing annotated Figure 7 of Palmon). As shown, the results are arranged in a ranked, top-to-bottom order and numbered, leaving no plausible dispute that

Opposition to Request for Discretionary Denial

Palmon presents web content from different users “relative to” each other. *See id.* (showing “Results 1-2 of 5”).

Patent Owner attempts to avoid Palmon’s disclosure by arguing that Palmon “present[s] content in three fixed, segregated categories” not “in a unified result set.” Br. 11-12. But Patent Owner’s wordplay does not hold water, for two independent reasons. **First**, even accepting Patent Owner’s framing, Palmon presents content from different users ranked “relative to” each other *within a single category*, i.e., “in a unified result set.” *See* Pet., 37-39 (identifying content from multiple users within the “My Topixa” section). Palmon thus discloses the claim limitation even if Patent Owner contends it must be myopically focused on individual categories.

Second, and more fundamentally, Patent Owner’s “unified result set” requirement is not found in its claims—the claim language does not mention “a unified ranking” or expressly prohibit “categorical divisions,” nor does Patent Owner attempt to show how those points distinguish Palmon from its claims. And Palmon unquestionably discloses web content identified by different users positioned “*relative to*” each other, as required by the express language of the claims.

Patent Owner’s arguments are thus nothing more than a distraction from a fatal flaw in its patent—Palmon discloses the only claimed element supposedly missing from the prior art.

III. NEITHER ANY SETTLED EXPECTATIONS NOR THE EXISTENCE OF A PARALLEL LITIGATION WEIGH AGAINST INSTITUTION.**A. Patent Owner Has No Legitimate Settled Expectations In The Validity Of The '744 Patent.****1. The '744 Patent Issued Less Than Five Years Ago.**

As an initial matter, the '744 Patent's short time in force weighs against any settled expectation of validity. The '744 Patent was not issued until August 31, 2021—less than five years ago—thus Patent Owner could not have developed any settled expectations of validity. This IPR is exactly the kind of early challenge that “favor[s] robust, predictable patent rights and weigh[s] against discretionary denial.” *See OnePlus Tech. (Shenzhen) Co. v. Pantech Corp.*, IPR2025-00756, Paper 11 at 2 (Dir. Oct. 3, 2025) (finding that a five-year-old patent “has not been in force for a significant period of time”). Indeed, the Director has repeatedly determined that patents that have been in force for less than six years “have not been in force for a significant period of time” and therefore “Patent Owner has not developed strong settled expectations that favor discretionary denial.” *See, e.g., Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 at 2 (Dir. Jul. 17, 2025) (addressing patents that had been in force between one and five years); *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 3 (Dir. Jul. 2, 2025) (finding “Patent Owner has not developed strong settled expectations that favor discretionary denial” in patents in force for five to six years).

**2. No Evidence Suggests That Patent Owner Ever Used
The '744 Patent Before 2025, When It Sued X.**

Moreover, during the first four years after the '744 Patent issued, no evidence suggests that Patent Owner ever commercialized or otherwise used its patent, much less did so in the social media space. That complete absence of any evidence that a patent was “commercialized, asserted, marked, licensed, or otherwise applied in a petitioner’s particular technology space . . . weigh[s] against a patent owner’s claim of settled expectations.” *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2–3 (Dir. Jun. 26, 2025).

Although Patent Owner asserts it “relied on the patent as a valid and enforceable right,” it provides no evidence any such reliance. *See* Br. 19. Patent Owner cites no practicing search engine of its own (and certainly no social media platform), provides no evidence of any license to the '744 Patent, shows no marked products, and identifies no evidence it ever asserted the '744 Patent before 2025, the year it sued X. *See id.* Accordingly, for that additional reason, Patent Owner has no settled expectations in the validity of the '744 Patent.

**B. The Parallel District Court Litigation Was Stayed At Its Outset,
Thus The *Fintiv* Factors Strongly Favor Institution.**

In addition to the lack of settled expectations, institution will be the most efficient method of addressing the validity of the '744 Patent because the District Court stayed the parallel litigation at the very beginning of the case pending

Opposition to Request for Discretionary Denial

resolution of the IPR. EX1017. Indeed, every single *Fintiv* factor favors institution—a fact that Patent Owner does not dispute in its brief.

To start, Factors 1 and 2 strongly favor institution. The parallel district court case is stayed pending resolution of this IPR (factor 1), which also ensures that the final written decision will issue well before any trial (factor 2).

Factor 3 also strongly favors institution. The district court proceeding was stayed at its outset, before any scheduling order was even issued. EX1017. Indeed, the stay is the only decision issued by the district court to date and the parties have invested little into the district court litigation—they have not started claim construction, fact discovery, or advanced beyond the very beginning stages of the case. Accordingly, factor 3 also favors institution.

Factors 4 and 5 similarly favor institution because the IPR proceeding will create a single avenue to efficiently resolve validity disputes regarding the '744 Patent. X entered into a broad stipulation in the district court that eliminates any meaningful overlap in invalidity issues (EX1016), which favors institution under factor 4. *See Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00217, Paper 9 at 2 (Dir. Jun. 13, 2025) (recognizing similar “broad” stipulation favored institution). And the complete overlap in the parties in the district court (factor 5) similarly avoids duplicate litigation over validity and thus supports institution.

Finally, factor 6 supports institution because other circumstances strongly

Opposition to Request for Discretionary Denial

weigh in favor of institution. As discussed in § II above, Patent Owner's assertion of the '744 Patent against social media, a new technology space; the Examiner's error in allowing obvious claims; and the strength of the prior art all favor institution.

IV. SECTION 325(D) PROVIDES NO BASIS FOR DISCRETIONARY DENIAL BECAUSE THE PETITION PRESENTS NEW GROUNDS, NOT CUMULATIVE OF THOSE CONSIDERED DURING PROSECUTION.

Furthermore, the Petition cannot be discretionarily denied under § 325(d) because the grounds presented are neither “the same” nor “substantially the same” as prior art presented during prosecution. *Cf.* 35 U.S.C. § 325(d). To the contrary, the primary reference in all four presented grounds (Palmon) is new and non-cumulative. Indeed, Palmon expressly discloses real-time ranking based on human input—the feature supposedly missing from the prior art presented during prosecution—through its use of user-designated “favorites” to influence web search results. *See* Pet., 14-16. Because Palmon discloses the very feature relied upon to distinguish prior art during prosecution, it cannot be cumulative.

A. Patent Owner's § 325(d) Argument Fails At *Advanced Bionics* Step One—The Petition Presents New, Non-Cumulative Grounds Based On The New Palmon Reference.

Petition's argument does not survive *Advanced Bionics* step one, because the grounds presented in the petition are indisputably new and materially different from the prior art considered during prosecution. *See Advanced Bionics LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7-8 (PTAB Feb. 13,

2020) (precedential).

As an initial matter, there is no dispute that Petitioner’s references (Palmon, Walter, and Lu) were not considered during prosecution—they are neither mentioned in the file history nor listed on the face of the patent. *See* EX1001, 1-3; EX1008. Patent Owner does not contend otherwise. *See generally* Br. 8-13.

Unable to argue that the references were previously considered, Patent Owner instead asserts that Palmon, Walther, and Lu are “substantially similar” to art considered during prosecution, Verma and Cierniak. Br. 8. But Patent Owner’s own analysis demonstrates the contrary. The crux of the issue (and Patent Owner’s argument) concerns the “relative to” limitation,² discussed in § II.C above, which Patent Owner contends is absent from the prior art and was the basis for allowance of the claims. *See* Br. 11 (citing EX1008, 186, 207-213).³

² *See, e.g.*, EX1001, claim 1 (reciting “search results comprising the first web content identified by the first user in a position relative to identifications of other web content received from other users”).

³ While the prior art considered during prosecution differs substantially from the grounds presented in the Petition, X agrees with Patent Owner that both sets of prior art disclose all other limitations of the challenged claims, and thus focuses its briefing on the “relative to” limitation.

Opposition to Request for Discretionary Denial

In particular, Patent Owner now contends that the prosecution art (Verma) did not disclose the “relative to” limitation and contends that Palmon, Walther, and Lu also do not disclose the “relative to” limitation, thus the Petition’s grounds are cumulative of Verma. *See* Br. 11-13. Patent Owner is incorrect for at least two reasons. First, and most importantly, as discussed above, Palmon **does** disclose the “relative to” limitation. *See supra* § II.C. And Patent Owner’s attempt to distinguish Palmon based on supposed “categorical divisions” and lack of “a unified ranking” are neither tied to the claims nor accurate reflections of Palmon. *See id.*

Second, the applicant’s own statements during prosecution of the ’744 Patent demonstrate that Palmon (as well as Walther and Lu) are not substantially similar to the Verma prior art. As Patent Owner acknowledges, the applicant distinguished Verma from the alleged invention arguing that Verma uses “a ‘regular’ search engine to obtain results, **then refines** those results based on the ‘user recommended results,’” whereas the alleged invention required that “‘human input affects the search results in real time.’” *See* Br. 11 (quoting EX1008, 187). In other words, the applicant relied on Verma’s “two-stage process” (*id.*, 13) to distinguish it from the alleged invention.

That distinction is dispositive here. None of the Petition’s references—Palmon, Walter, or Lu—employ Verma’s “two-stage process.” As explained in Section VII.A of the Petition, unlike Verma, Palmon does not use any “‘regular’

Opposition to Request for Discretionary Denial

search engine” nor does it subsequently refine the results of a regular search engine (*i.e.*, a “two-stage process”). Br. 11. Rather, Palmon indexes web content using human input (e.g., marking the web content as a favorite), and directly generates search results based on that human input (as well as human inputs from multiple other users). *See* Pet., 11-16. Indeed, Patent Owner itself fails to identify any “two-stage process” in Palmon, Walter, and Lu—it merely describes them as providing results in categories. *See* Br. 13.

Put simply, the Petition’s references do not share the defining characteristic—a “two-stage process”—upon which the applicant relied to distinguish Verma during prosecution. That alone confirms they are not “substantially similar” to the prior art previously considered. Because the Petition relies on new, non-cumulative art, *Advanced Bionics* step one is not satisfied, and discretionary denial is unwarranted.⁴

B. Neither *Advanced Bionics* Step Two Nor *Becton Dickinson* Applies To The Newly Presented Art And Grounds In The Petition.

The Board should not proceed to step two of *Advanced Bionics* because the Palmon reference is substantially different from the prior art previously considered

⁴ Patent Owner’s assertion that the petition art is “cumulative” because it is “contemporaneous” with the prosecution art (Br., 13) is unsupported by law or logic. The date of publication says nothing about whether the references disclose the same subject matter.

Opposition to Request for Discretionary Denial

by the Office. *See Advanced Bionics* at 7-8. Palmon and the grounds based thereon are not “the same or substantially the same prior art or arguments” previously presented to the Office, thus § 325(d) cannot provide any basis for discretionary denial here. *See* 35 U.S.C. § 325(d). Accordingly, the Board need not consider Patent Owner’s step two analysis (Br. 14-16). Petitioner notes, however, that the Examiner’s material error here would warrant institution for the reasons discussed in § II.B above even were § 325(d) applicable.

Similarly, Patent Owner’s *Becton Dickinson* analysis is inapplicable here because § 325(d) does not apply. *Becton Dickinson* only provides “insight into how to apply the framework under 35 U.S.C. § 325(d).” *See Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 3 (PTAB May 19, 2025) (precedential). The Board thus need not address Patent Owner’s *Becton Dickinson* analysis (Br. 16-18), which is largely duplicative of its other § 325(d) arguments.

C. No Policy Considerations Support Applying § 325(d).

Patent Owner also argues that institution “would contravene the policy underlying 35 U.S.C. § 325(d), which is designed to prevent serial challenges” (Br. 18) but that argument adds nothing to Patent Owner’s other flawed complaints. The Petition is not a “serial challenge”—it is the *first* post-grant challenge to the ’744 Patent and was filed promptly after Patent Owner’s venture into the social media space. Nor is the Petition based on “yet another set of references teaching the same

Opposition to Request for Discretionary Denial

concepts” (Br. 18)—the Petition is based on new, non-cumulative art, and demonstrates that the ’744 Patent claims are invalid. *See supra* § IV.A.

V. PATENT OWNER’S OTHER OBJECTIONS HAVE NO MERIT.

Patent Owner also raises a grab-bag of other objections to institution, but none warrant denying *inter partes* review of a recently issued patent, newly asserted against a different industry in light of newly presented and strong prior art.

A. Patent Owner’s 35 U.S.C. § 314(a) Arguments Do Not Support Denial Of Institution.

Patent Owner concludes its arguments with four brief and unsupported arguments against institution (Br. 19-20) but none are compelling.

First, the previous examination by the Patent Office (*id.*, 19) does not weigh against institution for at least two reasons previously discussed: (1) the Examiner erred during prosecution in allowing the same claims he had found obvious in a previous patent (*see supra* § II.B) and (2) the Petition presents new art, not previously considered by the Office. *See supra* § II.C.

Second, Patent Owner lacks any settled expectations in its recently issued and previously unasserted patent for the reasons previously addressed. *See supra* § III.A. And Patent Owner’s inability to provide either legal support or evidence for its claim of settled expectations (Br. 19) is a tacit admission that none exist.

Third, the strength of the Petition weighs in favor of institution. Patent Owner itself admits that only one element was missing from the prior art raised in

Opposition to Request for Discretionary Denial
prosecution, and the Petition presents art disclosing that element (and all the others).

See supra § II.C.

Fourth, “reliance on expert testimony” (Br. 20) does not weigh against institution. The Petition does not rely on Dr. Terveen’s declaration to fill “gaps” in the art identified during prosecution; rather, those are filled by the newly presented art. *See supra* § II.C. Indeed, Patent Owner does not and cannot identify any limitation where the Petition relies solely on expert testimony. *See* Br. 20. To the contrary, Dr. Terveen properly applies his technical knowledge and factual analysis to explain the prior art disclosure, grounded in the express teachings of the references themselves. *See Unified Patents LLC v. Togail Techs., Ltd.*, IPR2023-00338, Paper 7 at 11 (PTAB Aug. 18, 2023) (crediting expert declaration supported by factual determinations). Dr. Terveen’s analysis thus supports the merits of the Petition; it is no basis for discretionary denial.

B. Patent Owner’s Argument Regarding “Claim Construction Behavior” Is Specious.

Finally, Patent Owner accuses Petitioner of “subterfuge” because the Petition supposedly “actively avoids setting forth any position on how the claims of the ’744 patent should be construed” yet “argued that the Office’s claim construction would simplify the dispute” while moving for a stay. Br. 5-6. Patent Owner is wrong and its characterization of X’s positions is incorrect.

To start, X did *not* “argue[] that the Office’s claim construction would

Opposition to Request for Discretionary Denial

simplify the dispute,” as Patent Owner contends (Br. 6). X never suggested there would be an “Office’s claim construction” at all. And Patent Owner’s motion citations (Br. 6 (citing pages 5 and 7 of EX2002)) show no different. In fact, X only argued (1) that “a ruling on one patent may still be highly relevant to claim construction and other issues for the other [related] patent” (EX2002, 5)—an unremarkable statement regarding the relevance of new prosecution history from a related patent—and (2) the case was “in its earliest stages,” before claim construction and other significant milestones. EX2002, 7. Patent Owner’s characterization of X’s brief is thus incorrect.

Furthermore, the lack of claim construction proposals in the Petition is no “subterfuge” as Patent Owner contends (Br. 6); rather, it is the natural and **required** result of strong prior art. It is black-letter law that “only those terms which are in controversy need to be construed and only to the extent necessary to resolve the controversy.” *Comcast Cable Comms., LLC v. Rovi Guides, Inc.*, IPR2017-01145 Paper 8 at 17 (PTAB Nov. 7, 2017); *Abbott Labs v. Miracor Medical SA*, IPR2025-00116, Paper 13 at 11 (PTAB Jun. 11, 2025) (same). No such construction was necessary here—the limitations are disclosed by the prior art under their plain and ordinary meaning. Nor is there anything objectionable in statements asserting “to the extent” a position is taken later (Br. 6)—those simply address arguments that Patent Owner may later advance.

Opposition to Request for Discretionary Denial

Simply put, Patent Owner’s inflammatory allegations of “subterfuge” (Br. 6), “hid[ing] its cards” (*id.*), “gam[ing] the U.S. patent system” (*id.*, 7), and “mak[ing] promises . . . and then ignor[ing] those promises” (*id.*) are unsupported and false. They are nothing but a tenuous attempt to distract from the weakness of Patent Owner’s substantive arguments.

VI. CONCLUSION

The Petition presents newly asserted art that challenges a recently issued “web search” patent on both compelling anticipation and obviousness grounds. No basis exists to deny institution before consideration of its merits. Patent Owner has no settled expectations in its recently issued patent—especially when identical claims were found obvious in a related patent—and the district court has already stayed the parallel proceeding, thus clearing the way for an efficient resolution by the Board. Accordingly, X respectfully requests that the Petition be referred to the merits panel for further consideration and institution on its merits.

Dated: May 12, 2026

Respectfully submitted,

/Taeg Sang Cho/

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DESMARAIS LLP

Opposition to Request for Discretionary Denial

CERTIFICATE OF SERVICE

The undersigned certifies that on May 12, 2026 a complete copy of the foregoing **Petitioner's Opposition to Patent Owner's Discretionary Denial Brief and corresponding exhibit** were served on counsel of record for the Patent Owner by filing the documents through P-TACTS and by sending via electronic mail to the following addresses:

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