

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IPG PHOTONICS CORPORATION,
Petitioner

v.

TRUMPF LASER UND SYSTEMTECHNIK GMBH,
Patent Owner

Case IPR2026-00251
Patent 12,240,054

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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EXHIBIT LIST

TRUMPF-2001	Trumpf Email of July 31 2019
TRUMPF-2002	IPG Email of August 16 2019
TRUMPF-2003	RESERVED
TRUMPF-2004	United States Patent No. 12,237,642
TRUMPF-2005	Director Squires Testimony to House Sub-Committee
TRUMPF-2006	Trumpf Fact Sheet
TRUMPF-2007	Lincoln Brunner, Tube Laser helps company transition from distributor to fabricator, The Tube and Pipe Journal, August 20, 2025, https://www.thefabricator.com/tubepipejournal/article/tubepipefabrication/tube-laser-helps-company-transition-from-distributor-to-fabricator (last visited April 26, 2026)
TRUMPF-2008	IPG Complaint, Case No. 2:26-cv-00035, E.D. Tx (Jan. 2026)
TRUMPF-2009	Prosecution History Associated with US Patent No. 11,806,804
TRUMPF-2010	Prosecution History Associated with US Patent No. 11,215,761
TRUMPF-2011	Prosecution History Associated with US Patent No. 10,281,656
TRUMPF-2012	Prosecution History Associated with US Patent No. 9,482,821
TRUMPF-2013	Prosecution History Associated with US Patent No. 8,781,269

I. INTRODUCTION

IPG Photonics Corporation (“**IPG**” or “**Petitioner**”)’s *inter partes* review (IPR) petition challenging Trumpf’s U.S. Patent No. Patent 12,240,054 (the “**’054 patent**”) is precisely the type of IPR petition that should be discretionarily denied by the Honorable Director for several reasons.

First, Trumpf has strong settled expectations with respect to the ’054 patent. IPG was aware of the ’054 patent family since July 1, 2019, but waited more than six years to submit an invalidity challenge for a patent in this family.

Second, Trumpf is entitled to quiet title of the ’054 patent as the subject matter at issue in the ’054 patent family has been scrutinized repeatedly during prosecution. Indeed, in reliance on the quality examination of these patents, Trumpf continued to develop its portfolio covering the subject matter in the ’054 patent.

Third, policy and efficiency considerations also weigh against institution of the ’054 petition. Here, there is **no** counterpart district court litigation, and Trumpf has **not** asserted that IPG infringes the ’054 patent. Rather, IPG’s petition is retaliatory in nature, following on-going European patent litigation between the parties¹. But meritless, retaliatory IPR petitions with no counterpart US district

¹ See e.g., *Trumpf Laser Systemtechnik SE v IPG Laser GmbH & Co. KG*, Case number: UPC_CFI_733/2024 addressing European Patent Nos. EP 2 624 031. The

court or ITC case are not an efficient use of the PTAB's resources. Rather, they are counterproductive to US manufacturing. Founded in 1969, Trumpf's first US company, then named Trumpf America Inc., is one of the leading manufacturers in North America of fabricating equipment and industrial lasers, including the subject matter at issue in the '054 patent. IPG's '054 petition ultimately seeks to disrupt Trumpf's investments and manufacturing activities in the United States. For these reasons and for the reasons further explained below, IPG's '054 petition should be discretionarily denied by the Honorable Director.

II. SETTLED EXPECTATIONS ASSOCIATED WITH THE '054 PATENT WARRANT DENIAL OF THE '054 IPR PETITION

The '054 patent is part of a larger family of patents that IPG has been aware of for more than six years. Specifically, the '054 patent is a continuation of US Patent No. 11,806,804, which is a divisional of US Patent No. 11,215,761, which is a continuation of US Patent No. 11,215,761, which is a continuation of US Patent No. 10,281,656, which is a continuation of US Patent No. 9,482,821, which is a continuation of US Patent No. 8,781,269. EX1001, pp1-2. On July 31, 2019, Trumpf contacted IPG regarding IPG's infringing actions related to "at least claim 1 of US 8,781,269, claim 1 of US 10,281,656, and claim 20 of US 9,620,925," and '054 IPR petition was filed shortly after the hearing on January 22, 2026 (Düsseldorf) for case UPC_CFI_733/2024.

also provided claim charts reflecting the same. Trumpf-2001, 1. IPG acknowledged receipt at least as of August 16, 2019, and the parties engaged in discussions for the next three years until August 12, 2022 when IPG unilaterally discontinued the discussion. Trumpf-2002, 1. During the three years of discussions, the parties signed a non-disclosure agreement and discussed numerous details of the subject matter at issue in US Patent Nos. 8,781,269 and 10,281,656, which are two of the first three patents in the '054 patent family. Thus, IPG has been intimately familiar with the subject matter at issue in the '054 patent for more than six years.

Meanwhile, legal patent proceedings that IPG has been involved with since 2018 have demonstrated a continued knowledge of Trumpf patents, including patents in the '054 patent family. For example, IPG filed US patent application 17/299,490 on December 3, 2019, which claims priority to a provisional application filed on December 3, 2018. Trumpf-2004, p1. IPG's application 17/299,490 issued as US Patent No. 12,237,642 on February 25, 2025. Trumpf-2004, p1. During prosecution of application 17/299,490, IPG repeatedly cited to multiple Trumpf patents, including US Patent Nos. 8,781,269 and 10,281,656 (which are parents of the '054 patent) and at least six other patent documents listing inventor "Huber," who is the first listed inventor of the '054 patent. Trumpf-2004, p2. During the same time period, Trumpf filed the application

corresponding to the '054 patent on November 6, 2023, which ultimately issued as a patent on March 4, 2025. Yet, IPG waited almost a year after the issuance date to file its IPR petition on February 20, 2026.

Having had full knowledge of the '054 patent family for more than six years, IPG chose to forego requesting PTAB review of patentability of any member of the family preceding the '054 patent. Meanwhile, further demonstrating its full awareness of the '054 patent family, IPG cited those patents during prosecution of IPG's own patent application. IPG's inaction against any patent in the '054 patent family, which of course have very similar subject matter as they are all continuations or divisional applications of each other, further justifies the strong settled expectations held by Trumpf and an expectation of quiet title with respect to the '054 patent. And because Trumpf is entitled to strong settled expectations with respect to the '054 patent, IPG's '054 IPR petition should be discretionarily denied.

III. THE '054 PATENT FAMILY HAS UNDERGONE QUALITY EXAMINATION ENTITLING PATENT OWNER TO AN EXPECTATION OF QUIET TITLE

As noted above in Section II, the '054 patent is preceded by five patents in its family. Each of these patents was examined for novelty, utility, and other statutory requirements. The family of applications was also examined by different Examiners (Examiner Akm Ullah followed by Examiner Michelle Connelly).

Trumpf-2010, 16; Trumpf-2013, 7. Each examiner conducted a prior art search on similar features as those recited by the '054 patent claims, and each confirm that the subject matter at issue in these patents is patentable even after being subject to repeated checks. *See generally* Trumpf-2009, Trumpf-2010, Trumpf-2011, Trumpf-2012, Trumpf-2013. As such, the patents in the '054 patent family emerged after undergoing the scrutiny of repeated examinations suggesting the strong merits and quality of the '054 patent. Indeed, the '054 patent is an example of the kind of continuous quality examination that Patent Owners should benefit from and be entitled to quiet title. And, in reliance on the quality examination and quiet title, Trumpf continued to develop its portfolio, from the earliest patent (US Patent No. 8,781,269) to the '054 patent.

As explained in the next section, fairness and policy considerations strongly favor discretionary denial so that Trumpf can maintain its reasonable right to quiet title.

IV. POLICY AND EFFICIENCY CONSIDERATIONS FAVOR IPR DENIAL

The importance of providing patent owners with some form of quiet title and to protect US manufacturing and commercialization investments made by patent owners has been identified as a paramount interest.

[T]he USPTO has used the Director institution process to promote early challenges to patent validity, which helps ensure that U.S.

patents are “born strong.” This increases investment, commercialization, and job growth, and, importantly, fosters more innovation. *The changes implemented reinforce the USPTO’s focus on protecting patent owners’ investments in commercialization, licensing, and marketing products tied to a particular patent.* The changes also *provide patent owners with some form of quiet title* and allow patent owners, who spend resources on prosecuting a patent, to rely on the patent issued to them.

Trumpf-2005, 7 (emphasis added).

Allowing IPG’s challenge to the ’054 patent would not support the USPTO current policy objectives for at least the following reasons.

A. IPG is Attempting to Disrupt Trumpf’s Valuable Contributions to the US Laser Manufacturing Industry

First, IPG’s petition attempts to disrupt Trumpf’s contribution to the American laser manufacturing industry. Trumpf is one of the largest manufacturers of fabricating equipment and industrial lasers in North America. Trumpf America Inc. was founded in 1969 and has a 400,000 square foot North American headquarter based in Farmington, Connecticut. Trumpf-2006, pp1-2. As of June 2022, the Trumpf Group employed more than 1,000 people in the United States, and generated sales revenue in the 2021-2022 fiscal year of approximately \$4.7 billion. Trumpf-2006, pp1-2. In IPG’s infringement

complaint filed against Trumpf involving a different patent, IPG alleged that numerous US manufacturing companies rely on Trumpf products, and that Trumpf is involved in substantial economic activity in the United States. Trumpf-2008, ¶¶[0009], [0011].

Trumpf's revolutionary impact on US laser manufacturing is even lauded by neutral third-party sources. For instance, an article published in the Tube and Pipe Journal on August 20, 2025, highlighted the Trumpf TruLaser® Tube 7000 fiber laser cutting machine as being "the first machine in that line to be manufactured in the U.S." (referring to the Trumpf laser in the manufacturing line of American Steel and Aluminum based in Auburn, Massachusetts). Trumpf-2007, 1. The article even suggests the high degree of customer satisfaction and reliability of Trumpf's laser products when referring to "the third TRUMPF tube laser that ASA has bought since 2018, has been operating at its plant in Syracuse, N.Y., since the spring and marks the full transition of TRUMPF's TruLaser Tube 7000 series production to U.S. shores." Trumpf-2007, 1. As indicated by the article, Trumpf has transitioned manufacturing of certain laser products to the US to further boost US manufacturing.

The move to manufacture these lasers in the U.S. marks a significant transition of its own for TRUMPF, which previously manufactured the bulk of its machines in Europe (*though many of its machines sold*

in North America have been assembled at the company's Farmington, Conn., campus).

Though the *decision to relocate manufacturing from Germany to New England* coincides with a general reshoring push from many U.S. manufacturers, the company's move was based purely on proximity to *a thriving North American market that now generates a significant portion of its total sales.*

Trumpf-2007, 3.

Keen on disrupting Trumpf's technological and market success, IPG is resorting to patent invalidity challenges, like the '054 IPR petition, to harm Trumpf's business in the United States. The Honorable Director should not endorse such tactics by instituting an IPR review, as doing so would harm American manufacturing and further encourage other parties to leverage the USPTO as a tool to hurt American manufacturers.

V. CONCLUSION

For all the above-noted reasons, Patent Owner, Trumpf, requests the Honorable Director discretionarily deny institution of IPR2026-00251. Trumpf asks the Director to prioritize judicial and Board resources, and to allow Trumpf to prioritize the support that it offers the US workforce and economy over this meritless, retaliatory and late attack on the '054 patent.

Respectfully submitted,

Dated: April 27, 2026

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on April 27, 2026, a complete and entire copy of this Patent Owner's Request for Discretionary Denial and Accompanying Exhibits were provided by email to the Petitioner by serving the correspondence address of record as follows:

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