

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner

v.

TIR TECHNOLOGIES LIMITED,
Patent Owner.

IPR2026-00346

U.S. Patent No. 9,800,633

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

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<i>Yealink (USA) Network Tech. Co. v. Barco N.V.,</i> IPR2025-00491, Paper 18 (June 25, 2025)	10

EXHIBIT LIST

No.	Exhibit
1001	U.S. Patent No. 9,800,633
1002	File History of the '633 patent
1003	Declaration of Dr. Aviel D. Rubin
1004	Curriculum Vitae of Dr. Aviel D. Rubin
1005	U.S. Patent No. 6,289,358 (“Mattis”)
1006	U.S. Patent Application Pub. No. 2010/0070608 (“Hosur”)
1007	U.S. Patent Application Pub. No. 2009/0119322 (“Mills”)
1008	U.S. Patent Application Pub. No. 2009/0310668 (“Sackstein”)
1009	U.S. Patent No. 7,860,950 (“Menon”)
1010	Gourley, D., Totty, B., <i>HTTP: The Definitive Guide</i> , O’Reilly, (2002)
1011	Dilley, D., et al., <i>Globally Distributed Content Delivery</i> , IEEE Internet Computing (Sep. Oct. 2002)
1012	Buyya, R., Pathan, M., Vakali, A. (Eds.), <i>Content Delivery Networks</i> , Springer (2008)
1013	Dean, M., et al. (Eds.), <i>Web Information Systems Engineering – WISE 2005 Workshops</i> , Springer (2005)
1014	Plaintiff Tir Techs. Ltd.’s Responsive Claim Construction Brief, <i>Tir Techs. Ltd. v. Amazon.com Services LLC, et al.</i> , No. 25-dv-00865 (W.D. Tex. April 22, 2026)
1015	Schneier, B., <i>Applied Cryptography, Second Edition: Protocols, Algorithms, and Source Code in C</i> , John Wiley & Sons, Inc. (1996)

No.	Exhibit
1016	Ball, M., <i>A Quarter Century of Streaming Video</i> , https://www.thestreamingbook.com/chapters/a-quarter-century-of-streaming-video
1017	Ruether, T., <i>History of Streaming Media [Infographic]</i> , https://www.wowza.com/blog/history-of-streaming-media#h-1990-2000-streaming-debuts-as-a-proof-of-concept (Feb. 21, 2023)
1018	U.S. Patent Application Pub. No. 2002/0065926
1019	U.S. Patent Application Pub. No. 2011/0289533
1020	U.S. Patent Application Pub. No. 2004/0015986
1021	U.S. Patent Application Pub. No. 2004/0117455
1022	U.S. Patent Application Pub. No. 2002/0191696
1023	Shen, B., Lee, S-J., Basu, S., <i>Caching Strategies in Transcoding-enabled Proxy Systems for Streaming Media Distribution Networks</i> , HP Laboratories Palo Alto, HPL-2003-261 (2023)
1024	U.S. Patent Application Pub. No. 2003/0035481
1025	Deneke, T., <i>Scalable Distributed Video Transcoding Architecture</i> , Åbo Akademi Univ., Master of Science Thesis (Sep. 2011)
1026	U.S. Patent Application Pub. No. 2007/0198734
1027	U.S. Patent No. 7,941,453
1028	U.S. Patent Application Pub. No. 2004/0101138
1029	U.S. Patent Application Pub. No. 2007/0204064
1030	U.S. Patent Application Pub. No. 2011/0088076
1031	U.S. Patent Application Pub. No. 2004/0010613
1032	Cacheda, F., Plachouras, V., Ounis, I., <i>A case study of distributed information retrieval architectures to index one terabyte of text</i> ,

No.	Exhibit
	Information Processing & Management, Vol. 41, Issue 5, pp. 1141-1161 (Sep. 2005)
1033	U.S. Patent Application Pub. No. 2007/0250900
1034	Complaint, <i>Tir Technologies Limited v. Meta Platforms, Inc.</i> , No. 8:25-cv-2345, Dkt. 1 (C.D. Cal. Oct. 16, 2025)
1035	Stipulation Letter, dated June 23, 2026
1036	Export of search on https://ppubs.uspto.gov/pubwebapp/ (highlighted annotations added)
1037	Docket Navigator, Time to Milestones Report of Judge Robert Pitman
1038	Corporate Records Report of Tir Technologies Limited, <i>available at</i> https://core.cro.ie/e-commerce/company/5192574
1039	Defendant Meta Platforms, Inc. Reply in Support of its Motion to Dismiss the First Amended Complaint, <i>Tir Techs. Ltd. v. Meta Platforms, Inc.</i> , C.A. No. 8:25-cv-2345, Dkt. 38 (Mar. 2, 2026)
1040	Plaintiff Tir Technologies Ltd.'s Notice of Appeal, <i>Tir Techs. Ltd. v. Meta Platforms, Inc.</i> , C.A. No. 8:25-cv-2345, Dkt. 63 (July 23, 2026)
1041	U.S. Court of Appeals for the Federal Circuit Median Time to Disposition Report, <i>available at</i> https://www.cafc.uscourts.gov/wp-content/uploads/reports-stats/FY2025/MedianDispositionTime-Merits.pdf

I. INTRODUCTION

The Office should reach the merits of this IPR challenging U.S. Patent No. 9,800,633 (“’633 Patent,” Ex-1001). To start, the Petition presents art that the Office should have located but did not, which undermines the very reason for the ’633 Patent’s allowance; accordingly, the Examiner committed material error in allowing the ’633 Patent to issue. Although the ’633 Patent is over six years old, that error overcomes any settled expectations PO may have.

Further, that Examiner error shows this IPR will be an efficient use of the Office’s resources. PO argues a co-pending litigation against an unrelated third party shows otherwise, but statistics show trial in that litigation is likely to occur after a Final Written Decision here. Moreover, that third party has not raised the key prior art at issue in this IPR. And regardless, the Examiner error shows this IPR should proceed to the merits even if that trial was likely to occur first (which it is not).

Although PO contends discretionary denial is separately warranted because Petitioner has taken inconsistent claim-construction positions in separate proceedings, Petitioner has not (it has argued for plain meaning in both proceedings). The district court dismissed PO’s complaint based on the same plain-meaning understanding of the claims advanced in the Petition, and PO identifies no inconsistency.

Lastly, PO's contention that the Petition is effectively moot because the district court proceedings were dismissed is not correct. Three days after filing its discretionary denial brief, PO appealed that dismissal (which did not address invalidity). The co-pending litigation between the parties thus remains live, and the appeal means the Office will be *the only* body to evaluate patent invalidity on the Petition's presented grounds in the foreseeable future.

PO's discretionary denial request should therefore be denied, and this Petition should be referred for an institution decision on the merits.

II. THE OFFICE SHOULD REJECT PO'S DISCRETIONARY REQUEST

The '633 Patent is directed to a distributed video-delivery network intended to serve, upon request, different versions of video files that are optimized for different devices. *See, e.g.*, Ex-1001, Abstract, 1:21-52. Its purported point of novelty was to include within requests for video a "key" that represented the specific version of video being sought. *Id.*, Abstract, 3:22-38; Ex-1002, 122. The request's key would then be compared against a database of "reference keys" to locate the different pieces of the requested version of video stored throughout the network so that they could be combined into the complete video. Ex-1001, 3:39-4:41. Using keys in requests to represent different versions of a file, and comparing those keys to a database of reference keys to locate the different pieces of the requested file, however, was already expressly taught by the prior art.

All grounds in the Petition rely on a reference (Mattis, Ex-1005) that was not located by the Examiner, yet discloses what the Examiner found lacking during prosecution. Mattis is also not at issue in any co-pending litigation. PO does not mention Mattis in its discretionary denial request, and instead misconstrues the record to request discretionary denial based on *Advanced Bionics*, settled expectations, supposedly inconsistent claim constructions in parallel proceedings, and Office efficiency. Each argument fails.

A. The Petition presents new art and arguments that undermine the Office’s original basis of allowance that are not advanced in any other proceeding.

PO has not identified a basis for discretionary denial under §325(d) and, in fact, addressing the grounds in the Petition is an important use of Office resources to correct Examiner error. *Advanced Bionics* sets forth a two-part framework for assessing discretionary denial under §325(d): “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. Med-El Elektromedizinsche Gerate GMBH*, IPR2019-01469, Paper 6, at 8 (Feb. 13, 2020) (precedential).

1. The same or substantially the same art or arguments were not considered during prosecution.

PO incorrectly asserts that the Petition is duplicative of the Office’s original prosecution. Paper 7, 8-9 (“DD”). Specifically, PO overlooks that no proceeding has raised the one reference central to the Petition and present in every ground: *Mattis* (Ex-1005). PO also does not acknowledge that *Mattis* teaches the exact key-database features the Examiner considered missing from the prior art. PO’s §325(d) argument falls apart with a correct reading of the Petition and the prosecution history.

The Petition challenges every claim of the ’633 Patent on three primary grounds: (1) *Mattis* in view of Hosur; (2) Hosur in view of *Mattis*; and (3) Mills in view of *Mattis*.¹ Paper 1, 3 (“Pet.”). PO, however, points out that two references cited in the Petition—Mills and Sackstein—had already been considered by the Examiner. DD, 8.

As noted in the Petition (Pet., 6), the ’633 Patent issued without any prior-art rejection, after minor claim amendments to overcome antecedent-basis issues. Ex-1002, 120-22, 135-42, 174. Although the Examiner previously considered (but never

¹ The Petition relies upon Sackstein and Menon for narrow, secondary teachings. *See, e.g.,* Pet., 17-18, 42, 65-66 (relying on Sackstein for distributed transcoding/searching in each Ground to the extent not already express), *id.*, 84-85 (relying on Menon for “previews” to the extent not present in other references).

applied) Mills and Sackstein during prosecution (*see id.*, 131-33), the Examiner found that the claims were allowable over the prior art because none taught the combination of (1) a “request [that] includes a key specifying [optimization] parameters” for a specific version of the file, (2) that the “key is used to identify a local *preview*” of the file, and (3) that a “cache database includ[es] keys corresponding to optimized version on *other* video optimization servers.” *See id.*, 122-23. Petitioner does not dispute that neither Mills nor Sackstein taught those combined limitations. *See, e.g.*, Pet., 66-76. Petitioner instead contends that Mattis (not previously before the Office) supplies the exact key-database concept for locating multiple pieces of multimedia (*see, e.g.*, Pet., 8-12, 63-66) that the Examiner considered missing (Ex-1002, 122-23).² And the Petition also provides reasons to combine Mattis with the other cited art. Pet., 15-18, 40-42, 63-66.

PO does not dispute that Mattis was never before the Office. DD, 8-10. In fact, PO’s brief does not even mention Mattis (let alone address Mattis’s teachings) or explain why arguments based on Mattis are not new. *Id.* A proper reading of the Petition thus demonstrates that discretionary denial under §325(d) is inappropriate

² As set forth in the Petition, Hosur could also be read as teaching the key-database concept the Examiner considered missing, but Hosur was not before the Examiner either, and the Petition combines Hosur with Mattis anyway. *See, e.g.*, Pet., 40-53.

because, by presenting Mattis as new art, as well as new arguments based on Mattis, the first part of *Advanced Bionics* framework is not met. *E.g.*, *Ceva Sante Animale S.A. v. Targan, Inc.*, IPR2024-00595, Paper 9, 11 (Aug. 5, 2024) (“The Examiner did not consider any combination involving Pierre because Pierre is not of record in the prosecution history. In its combination of [a reference before the Office] and Pierre, Petitioner asserts new, non-cumulative arguments”).

Because the same or substantially the same art or arguments have not previously been considered by the Office, the Director need not consider the second part of the *Advanced Bionics* framework to determine that §325(d) denial is not warranted. Petitioner, nevertheless, discusses the second part below because the Examiner did, in fact, err, showing that considering the grounds including Mattis here is an important use of the Office’s resources.

2. The Examiner erred by conducting inadequate searches for prior art that resulted in not locating and applying Mattis.

Under the second part of the *Advanced Bionics* framework, discretionary denial under §325(d) is inappropriate if the Office materially erred during examination. *Advanced Bionics*, IPR2019-01469, Paper 6, 8-9. Here, the Examiner’s deficient searches, resulting in the failure to locate and apply Mattis (or a reference like it) during prosecution, constitute such a material error. Pet., 8-12; *see UATP IP LLC v. Slick Slide LLC*, PGR2024-00054, Paper 8, 38-39 (Apr. 8, 2025) (finding failure to combine a reference before the examiner with other pertinent references

not before the examiner that taught the purported point of novelty constituted material error); *Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, 2-3 (June 12, 2025); *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464-466, Paper 12, 3 (July 16, 2025) (informative).

During prosecution, the Examiner considered the particular use of keys and database lookups to be the patent's principle point of novelty. *See* Ex-1002, 122-23. But the prosecution history indicates the Examiner never ran a search specifically targeting this feature. Rather, every search for a "key" or "database" that was not immediately narrowed also required "transcoding" or "optimizing" or "redirecting [links]" in close proximity, which are distinct features of the claimed invention. *See, e.g., id.*, 192-201 (S41-47, 51, 53-54, 63, 67, 78, 107-110, 120-22, 126). In other words, the Examiner never ran a search separately targeting whether the claimed key-database lookup to locate pieces of a file was known in the art, more generally. As a result, the Examiner failed to locate Mattis (or other references like it), which taught the exact keys and database-lookup structures that the Examiner considered novel. *Pet.*, 8-12.

Had the Examiner run a search specifically targeting the perceived point of novelty, the Examiner would have found Mattis among a limited number of other

references. For instance, a search of the Patent Office’s public search database³ for “cache SAME key SAME database SAME version AND (piece OR portion)” before the priority date (@ad<=“20120718”) would have revealed Mattis among only 70 results. Ex-1036 (export of USPTO search results with Mattis highlighted). The Examiner appears to have focused the search largely on anticipatory references that taught both the transcoding features as well as the database features of the claimed invention. The Examiner, however, failed to search for references that should have been considered in a proper obviousness analysis that combines these features together and considers motivations to combine them, as the Petition does.

The Office should take up the Petition’s grounds, which all rely on Mattis, to reconsider whether the ’633 Patent should have been issued. In sum, both parts of the *Advanced Bionics* framework show that institution should not be discretionarily denied under §325(d), and in fact, the clear and material Examiner error in failing to conduct a proper search shows this IPR should be evaluated on the merits.

B. The Litigation Against An Unrelated Third Party Does Not Favor Discretionary Denial.

PO points to its litigation against Amazon (who is unrelated to Petitioner here) and argues that Amazon has identified in its invalidity contentions three references that overlap with those in the Petition (Sackstein, Hosur, and Menon). DD, 3 (citing

³ <https://ppubs.uspto.gov/pubwebapp/>

Ex-2003, 9, 18-19), 9 (citing same). Like its prosecution history arguments, PO does not contend that Amazon (or any other third-party litigant) has raised Mattis. Thus, Petitioner is aware of no other proceeding that would consider the Grounds presented in the Petition or the impact of Mattis on the patentability of the claims.

PO also mentions in passing that the Amazon litigation is set for trial one month before any Final Written Decision here, again suggesting these proceedings are not an efficient use of Office resources. DD, 2 (citing *Tir Techs. Ltd. v. Amazon.com Servs. LLC*, No. 1:25-cv-00865 (W.D. Tex.)). Putting aside that the Amazon trial would not address invalidity based on Mattis regardless, trial statistics suggest the Amazon trial would occur in December 2028, nearly a year *after* a Final Written Decision, despite the current case schedule. Ex-1037 (finding average time to jury trial is 42.6 months from the filing of the complaint); *Amazon.com*, No. 1:25-cv-00865, Dkt. 1 (W.D. Tex. June 4, 2025) (complaint filing). Indeed, the claim construction hearing originally set for June 2026 has already been delayed until August 2026. *Compare* Dkt. 40 at 4 (setting Markman hearing for June 24, 2026), *with* Dkt. 68 (resetting Markman hearing for August 25, 2026). This indicates that the currently set trial date in that litigation is far from certain, but even considering it, the Examiner error discussed above shows considering the merits of this IPR would still be an appropriate use of Office resources. *Padagis*, IPR2025-00464-466, Paper 12, 2-3 (informative) (finding “review of the challenged patents [for material

Examiner error] is an appropriate use of Office resources” despite an earlier trial); *Samsung Elecs. Co. v. Wilus Instit. of Standards and Tech. Inc.*, IPR2025-00933, Paper 11, 2-4 (Oct. 10, 2025) (same). Thus, the Amazon litigation does not justify discretionary denial either.

C. Examiner error outweighs any alleged settled expectations based solely on patent age, particularly where the patent was only recently acquired for assertion.

PO argues it has settled expectations in the '633 Patent because it was issued more than eight years ago. DD, 10. Even if the patent's age allegedly created some expectation, the Examiner error discussed above in §II.A.2 outweighs any such expectation (particularly in light of PO's recent formation, acquisition, and assertion of the challenged patent).

First, as discussed above, the Office committed a material error in allowing the challenged claims (§II.A.2, *supra*); this outweighs any settled expectations PO may have. *See, e.g., Anthony Inc. v. Controltec, LLC*, IPR2025-00559, Paper 12, 2 (July 16, 2025) (referring petitions based on a material error even though challenged patents were in force several years); *Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9, 2 (July 31, 2025) (referring petition based on material error despite “settled expectations”); *Yealink (USA) Network Tech. Co. v. Barco N.V.*, IPR2025-00491, Paper 18, 2-3 (June 25, 2025) (referring petition where Examiner failed to appreciate that claim referred to services “well known in the art”); *Microsoft*, IPR2025-00318,

Paper 9, 2-3 (referring petition and determining it was material error to overlook teachings of cited references and combined teachings with references not previously presented).

Second, regardless of whether a material error occurred during prosecution, PO fails to acknowledge that it could not have developed “settled expectations” because PO did not exist before 2023 and has no known relationship with the prior owner, Skyfire Labs, Inc. Ex-1038.⁴ Indeed, PO did not even acquire the ’633 Patent until April 2025. Before PO’s acquisition, the patent had never been asserted in litigation. PO cannot proclaim that it had an expectation in the validity of an eight-year-old patent that has only been asserted for the first time in the last year. *Cf. Siemens Gamesa Renewable Energy, Inc. v. Gen. Elec. Co.*, IPR2022-01479, Paper 11, 11-12 (Mar. 7, 2023) (declining to invoke discretionary denial because “this will be the first proceeding to determine the merits”).

D. Petitioner has taken a consistent view of what the claims require in all proceedings.

PO’s argument that discretionary denial is also warranted because Petitioner has taken inconsistent claim construction positions (DD, 4-6) mischaracterizes the record. Petitioner has never sought a construction of any claim term in the ’633 Patent other than plain meaning—not here nor in the district court. Although PO

⁴ <https://core.cro.ie/e-commerce/company/5192574>

characterizes Petitioner's motion to dismiss in the district court as presenting a claim construction that is inconsistent with the Petition, the motion did not advance a claim construction and PO identifies no actual inconsistency regardless. The Board should not invoke its discretion when Petitioner has been consistent about what the claims require. But even if the district court's decision could be read as invoking claim construction, Petitioner would stipulate to be bound to that supposed construction (as discussed below), and it would make no difference to the Petition's merits here.

In the co-pending litigation, Petitioner sought to dismiss PO's infringement claims because the claims' plain words require that a single key in a single request be used to locate at least two different pieces of a file (a first "preview" and second "portion" that are then "stitched" together). Ex-2004, 11-14.⁵ In the district court complaint, however, PO alleged that Petitioner's system uses a separate request and separate key to locate each individual piece of a file. *Id.*, 14-17. In other words, to locate the two claimed pieces of a file (the first preview and second portion), the complaint alleges Petitioner's system uses two different requests with two different keys. *Id.*

⁵ For clarity, in litigation, Petitioner did not contend that the claim is limited to one request and one key, but instead that the same request and key is referred to throughout the claim to locate two pieces of a file. Ex-1039 at 2.

In opposition to the motion to dismiss, PO argued that the articles “*a* request” and “*a* key” are construed as “one or more,” and thus PO was permitted to rely on different requests and keys in Petitioner’s system to locate the two claimed pieces of a file. Ex-2005, 8-10. But Petitioner argued in reply for its motion to dismiss that binding Federal Circuit authority foreclosed this view: because the claims recite “*the* key” to locate two different pieces of a file, the claims are referring to the same key throughout. Ex-1039, 6-9 (citing *In re Varma*, 816 F.3d 1352, 1363 (Fed. Cir. 2016) (“For a dog owner to have ‘a dog that rolls over and fetches sticks,’ it does not suffice that he have two dogs, each able to perform just one of the tasks”))).

The district court agreed with Petitioner and dismissed the case. *See* Ex-2001. Specifically, the district court found that, consistent with Federal Circuit precedent, even if the claim is not limited to one request and one key, the claim’s plain words require that a single key be used to locate the two claimed pieces of a file. *Id.*, 5. Indeed, despite PO’s protestations that the district court was engaging in improper claim construction on the pleadings, the district court rejected this argument, noting “[w]hether or not we classify our analysis as ‘claim construction’ makes no difference. The Court need not review prosecution histories or extrinsic evidence. *The mere plain words of the claims before the Court are alone enough to reach a determination.*” *Id.*, n.4 (emphasis added). At base, no claim construction occurred,

and to the extent it did, the district court's decision was based on the plain meaning, precisely the construction Petitioner advanced in the Petition (Pet., 7).

The cases PO cites do not suggest claim construction occurred in district court, because each of those cases evaluated the *definitions* of claim terms that were not present in the claims themselves. *See, e.g., Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998) (noting “it is manifest [in claim construction] that a claim must explicitly recite a term *in need of definition* before a definition may enter the claim”) (emphasis added); *id.* at 1250-51 (evaluating whether the term “when” refers to “as soon as” or “at or after”); *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1353 (Fed. Cir. 2001) (evaluating whether “local server computer” required caching/aliasing function); *Google LLC v. EcoFactor, Inc.*, 92 F.4th 1049, 1056 (Fed. Cir. 2024) (assessing whether finding that the prior art taught the claims involved an implicit claim construction as to what the claims require). Here, to the contrary, there was no argument as to what a “key” is, but only whether the plain words of the claims refer to the same key throughout.

But even if claim construction occurred in district court, that is relevant to discretionary denial only if Petitioner has taken an inconsistent position as to the claims' scope. Petitioner here has not. PO contends an inconsistency exists, but never identifies it. DD, 6 (arguing Meta advanced “a broader construction in the Petition” without explaining how). PO cannot identify an actual inconsistency

because the Petition adopted the view that the claims require a single key to locate at least two different pieces of a file. *See, e.g.*, Pet., 22-30 (noting a single object or name key is used to locate multiple “fragments” of a file), 44-52 (same), 69-74 (same).⁶ That is the same view Petitioner took of the claims in the district court. *See* Ex-2004, 11-14.

For this reason, even if the Board considered a claim construction to have occurred in the district court, Petitioner has taken the same position here. Further, for the avoidance of doubt, Petitioner stipulates its grounds require a single key to locate at least two different pieces of a file and Petitioner will not argue otherwise in this IPR. *See, e.g., Caption Health, Inc. v. The Univ. of British Columbia*, IPR2025-01422, Paper 15, at 2-3 (Dec. 18, 2025) (referring petition in part because “Petitioner’s stipulation [to apply the same construction in all proceedings] resolves any potential inconsistency in claim construction positions between forums”).

⁶ For the Hosur-Mattis grounds, the Petition also contended that Hosur’s single set of parameters (which constitutes “a key”) is used to locate multiple portions of a file. *See, e.g.*, Pet., 47-48.

E. PO is appealing dismissal of the parallel proceedings involving Petitioner, and thus the Office remains the most efficient forum to resolve patent validity

Finally, PO contends that there is no need for these proceedings because its district court action against Petitioner has been dismissed. DD, 7. But PO failed to apprise the Board that, just days after submitting its discretion brief, PO appealed the district court's dismissal. Ex-1040. The parallel proceedings have therefore not "ended" as PO proclaims. Given the length of an appeal process, as well as the far-off resumption of proceedings if PO succeeds in its appeal, the Office is by far the most efficient forum to evaluate patent validity of PO's still-pending claims.

PO filed its discretionary denial request on July 20, 2026. Just three days later (on July 23), PO filed a Notice of Appeal in the co-pending district court proceedings challenging the dismissal of its infringement claim. Ex-1040. Based on the latest available statistics, the median time to decide a Federal Circuit appeal from the district court is 20.5 months. Ex-1041. PO's appeal is therefore expected to remain pending—and the issue of infringement unresolved—until *April 2028*. This IPR proceeding, in contrast, is estimated to reach a Final Written Decision by November 2027. The Board is therefore the far more efficient forum to decide the validity of the patent while PO's appeal (which does not even involve invalidity) remains pending.

Although PO contends the circumstances here are like those in *Ericsson Inc. v. Procomm Int'l Pte. Ltd.*, IPR2024-01453, Paper 15, at 2-3 (June 25, 2025), PO is mistaken. In that case, the Acting Director found that discretionary denial of a petition was warranted after the patent owner had *voluntarily* dismissed the patent in a co-pending litigation against the petitioner, and the patent was then dismissed *with prejudice*. See also Order, *Procomm Int'l Pte. Ltd. v. Verizon Commc'ns., Inc.*, C.A. No. 2:24-00009, Dkt. 47 (E.D. Tex. Mar. 2, 2025) (“Before the Court is [the parties’] Joint Motion Regarding Stipulation of Dismissal of Asserted Patent. After consideration, and noting its joint nature, the Court GRANTS the Motion,” dismissing the subject patent with prejudice) (internal citation omitted). Because the patent was dismissed voluntarily and with prejudice, there was no risk of an appeal or a reassertion of the patent against the petitioner. Thus, the proceedings involving that patent against that petitioner had truly been terminated, rendering the petition a moot point. See *Procomm*, IPR2024-01453, Paper 15, at 2-3. Accordingly, that case does not support discretionary denial here either.

III. CONCLUSION

As discussed above, persuasive reasons support reaching the merits of this IPR, and PO’s request for discretionary denial should be denied.

Dated: August 19, 2026

Respectfully submitted,

/ Jessica Kaiser/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that true copies of Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and EXHIBITS 1036-1041 were served upon the below listed counsel by electronic mail:

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