

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIVINT LLC,
Petitioner,

v.

DUKE W. ZINSER,
Patent Owner.

Case IPR2026-00375
Patent No. 7,583,191

**PATENT OWNER DUKE W. ZINSER'S REQUEST FOR
DISCRETIONARY DENIAL OF PETITION FOR *INTER PARTES*
REVIEW OF U.S. PATENT 7,583,191**

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Patent Owner Duke W. Zinser's Request for Discretionary Denial of Petition for <i>Inter Partes</i> Review of U.S. Patent 7,583,191, dated May 19, 2026, filed in <i>Vivint LLC v. Zinser</i> , IPR2026-00300, Paper 6 (P.T.A.B. May 19, 2026)
2002	Notice of Decisions on Institution, entered in <i>Vivint LLC v. Zinser</i> , IPR2026-0300, Paper 10 (P.T.A.B. July 14, 2026)
2003	Patent Owner's Complaint for Patent Infringement, dated September 18, 2025, filed in <i>Zinser v. Vivint, LLC</i> , No. 4:25-cv-01030-ALM, Dkt. 1 (E.D. Tex.)
2004	Information Disclosure Statement by Applicant, dated June 9, 2016
2005	Information Disclosure Statement by Applicant, dated May 3, 2017
2006	Information Disclosure Statement by Applicant, dated January 5, 2018
2007	Respondents' Disclosure of Invalidity Contentions, dated April 23, 2021, served in <i>In the Matter of Certain IP Camera Systems Including Video Doorbells and Components Thereof</i> , No. 337-TA-1242 (ITC)
2008	Ex. B-8b, 10,200,660 Invalidity Chart to Respondents' Disclosure of Invalidity Contentions, served in <i>In the Matter of Certain IP Camera Systems Including Video Doorbells and Components Thereof</i> , No. 337-TA-1242 (ITC)
2009	USPTO Reexam File for U.S. Patent No 7,583,191
2010	Patent Scheduling Order, dated April 7, 2026, entered in <i>Zinser v. Vivint, LLC</i> , No. 4:25-cv-01030-ALM, Dkt. 21 (E.D. Tex.)
2011	Verified Response of Respondent Vivint Smart Home, Inc. to Complaint of Skybell Technologies, Inc., SB IP Holdings, LLC and Eyetalk365, LLC, and to Notice of Investigation, dated February 25, 2021, filed in <i>In the Matter of Certain IP Camera Systems Including Video Doorbells and Components Thereof</i> , No. 337-TA-1242 (ITC)

Exhibit No.	Description
2012	FCC DFS Test Report for Vivint Doorbell Camera Pro (Gen 2), dated September 27, 2022
2013	2025 Form 10-K for NRG Energy, Inc.
2014	Vivint LinkedIn Page, https://www.linkedin.com/company/vivint/about/ (last access August 7, 2026)
2015	Petitioner's Opposition to Patent Owner Duke W. Zinser's Request for Discretionary Denial, dated June 19, 2026, filed in <i>Vivint LLC v. Zinser</i> , IPR2026-0300, Paper 8 (P.T.A.B. June 19, 2026)
2016	Order Setting Trial, dated June 9, 2023, entered in <i>SB IP Holdings, LLC v. Vivint, Inc.</i> , No. 4:20-cv-886, Dkt. 374 (E.D. Tex. June 9, 2023)
2017	Tenth Amended Scheduling Order, dated July 14, 2020, entered in <i>Innovation Sciences, LLC v. Resideo Techs. Inc.</i> , No. 4:18-cv-475, Dkt. 92 (E.D. Tex. July 14, 2020)
2018	Amended Scheduling Order, dated December 1, 2020, entered in <i>Wapp Tech Ltd. P'ship v. Seattle Spinco, Inc.</i> , No. 4:18-cv-00469-ALM, Dkt. 258 (E.D. Tex. Dec. 1, 2020)
2019	Order, dated June 13, 2023, entered in <i>MyPort, Inc. v. Samsung Elecs. Co., Ltd.</i> , No. 2:22-cv-00114-JRG, Dkt. 73 (E.D. Tex.)
2020	FCC Radio Test Report for Vivint Indoor Camera Pro, dated January 5, 2023
2021	FCC Radio Test Report for Vivint Outdoor Camera Pro (Gen 3), dated July 9, 2025
2022	Defendants' Preliminary Invalidity Contentions, dated May 11, 2026, served in <i>Zinser v. Vivint, LLC, et al.</i> , No. 4:25-cv-1030-ALM (E.D. Tex.)
2023	Email correspondence to G. Sorden, et al. from B. Greene re: <i>Zinser v. Vivint</i> (EDTX Case No. 4:25-cv-01030-ALM), dated June 18, 2026

Patent Owner, Duke W. Zinser (“Zinser” or “Patent Owner”), requests that the Director of the U.S. Patent and Trademark Office exercise his discretion to deny institution in this *inter partes* review (“IPR”) proceeding pursuant to the Memorandum, “Interim Processes for PTAB Workload Management,” dated March 26, 2025 (the “March 26th Memo”), the Memorandum, “Additional Discretionary Institution Consideration – U.S. Manufacturing and Small Business Use of AIA Proceedings,” dated March 11, 2026 (the “March 11th Memo”), and 35 U.S.C. §§ 314 and 325.

I. INTRODUCTION

Petitioner Vivint LLC (“Petitioner” or “Vivint”) previously filed an IPR against the 26 claims of U.S. Patent No. 7,583,191 (the “’191 Patent”) that were issued in September 2025 after reexamination. *See generally Vivint, LLC v. Zinser*, IPR2026-00300 (P.T.A.B. March 16, 2026). In requesting discretionary denial, Patent Owner argued that Vivint’s longstanding knowledge of the patent, the age of the patent, and the timing of the trial in the district court warranted discretionary denial. Ex. 2001 at 6-14. The Director then discretionarily denied that IPR. Ex. 2002 at 1.

The grounds to discretionarily deny this IPR are stronger than in the previous IPR. The claims at issue here issued with the patent on September 1, 2009—almost seventeen (17) years before Vivint filed this IPR. And Vivint knew

about the '191 Patent long before it filed this IPR. Indeed, Vivint cited the '191 Patent in three (3) of its patent applications between June 2016 and February 2018. Vivint also charted the '191 Patent as a primary prior art reference in an ITC matter in 2021. So, Vivint knew about the '191 Patent for a decade before filing this IPR, citing it repeatedly over the years. Despite this, Vivint never challenged the patent. The advanced age of the '191 Patent and Vivint's longstanding knowledge of it warrant discretionary denial. *See iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (P.T.A.B. June 6, 2025) (discretionarily denying the petition because the patent had been in force for 13 years and petitioner cited the patent in its own patent application over a decade earlier). Indeed, the patent claims have been in force for 17 years and Vivint has repeatedly cited this patent in its own prosecution over the past decade.

Other factors favor denial and are stronger here than in the first IPR. The final pretrial conference in the parallel district court litigation is scheduled for May 14, 2027, with trial likely to follow within two weeks after that conference. The Board's Final Written Decision ("FWD") must be issued by December 9, 2027, over six months after the jury trial—double the three-month difference in the first IPR. And the additional factors from the Director's March 11th Memo similarly favor discretionary denial since the accused Vivint products are manufactured outside of the United States and Vivint is not a small business.

Thus, Patent Owner respectfully requests that the Petition be discretionarily denied.

II. FACTUAL BACKGROUND

A. The '191 Patent

In early 2006, Duke Zinser conceived an invention to help deal with the frequent door-to-door solicitations he was receiving. He invented a system that would stream both audio and visual data to help the user decide whether to answer the door. Zinser filed his patent application on November 14, 2006, and the '191 Patent issued on September 1, 2009. Ex. 1001. The '191 Patent was one of the pioneering patents in this industry. Indeed, it has been cited in 214 patent applications. Showing respect for the pioneering nature of the '191 Patent, one of Petitioner's major competitors licensed the patent in 2013. Ex. 2003 at ¶ 24.

B. Vivint's Decade-Long Knowledge of the '191 Patent

Vivint knew about the '191 Patent for almost a decade before it filed this IPR. Vivint first cited the '191 Patent in an Information Disclosure Statement ("IDS") by Applicant submitted on June 9, 2016. Ex. 2004. Vivint submitted the IDS in conjunction with its Patent Application 14/596,047. *Id.* The first patent application disclosed in the IDS is the publication number of the '191 Patent. *See id.* at 1; Ex. 1001 at 1. Similarly, Vivint cited the '191 Patent in one of its patent

applications in May 2017 and another in February 2018. *See* Exs. 2005 at 2; 2006 at 1. So, Vivint has known about the '191 Patent since at least 2016.

In addition, Vivint cited the '191 Patent as a respondent in an ITC matter (ITC Investigation No. 337-TA-1242) in April 2021. This ITC matter concerned certain doorbell camera products sold by Vivint and others. Vivint, along with other industry participants, cited the '191 Patent as one of its primary prior art references in its invalidity contentions. Ex. 2007 at 31, 45, 59, 73, 87, 101, 115. As part of these contentions, Vivint submitted 70-plus page invalidity charts where it mapped the disclosures in the '191 Patent, a primary reference, to the patents at issue in the ITC action. *See* Ex. 2008. Vivint submitted its contentions on April 23, 2021, over five years before it filed this IPR.

C. Reexamination and the Litigation Between Zinser and Vivint

Zinser filed for a reexamination of the '191 Patent on June 19, 2024. The reexamination originally discussed all of the claims in the patent, including the claims at issue in this IPR. Specifically, the reexamination request, when discussing the substantial question of patentability, says that the original dependent claims “inherit all features and limitations of the base claim from which they depend” and as a result “are invalid for at least the reasons set forth with respect to” the independent claims. Ex. 2009 at 173-74. Zinser provided charts for the original independent claims but not the original dependent claims (of which the

claims at issue in this IPR are a subset). On July 31, 2024, the Patent Office issued a “Decision Sua Sponte Vacating the *Ex Parte* Reexamination Filing Date” because “the Request does not provide any explanation of which teachings within [the cited prior art] meet or suggest the limitations of [the original dependent claims].” Ex. 2009 at 717.

Petitioner then filed a Corrected Request that sought reexamination of only the original independent claims. That reexamination resulted in the cancellation of those independent claims—claims 1, 8, 14, and 19—and the issuance of new claims 21-47. The reexamination certificate noted that the original dependent claims, including the claims at issue in this IPR, were not reexamined. Ex. 2009 at 1. Zinser filed his Complaint on September 18, 2025 seeking relief for Vivint’s infringement of the ’191 Patent in the U.S. District Court for the Eastern District of Texas, Case 4:25-cv-01030-ALM (the “Litigation”) that day. In the Litigation, Zinser originally asserted 31 claims of the ’191 Patent, including six of the original dependent claims, which have been in force since September 1, 2009, and are the subject of this IPR. Consistent with the scheduling order in the Litigation, Zinser reduced the number of asserted claims to ten on August 10. Of those ten claims, three are subject to this IPR and seven are not.

On April 7, 2026, the Court issued its Patent Scheduling Order providing certain case deadlines (the “Order”). Ex. 2010. Based on that Order, the Final

Pretrial Conference is set for May 14, 2027. *Id.* at 5. The Court did not set a trial date, but in view of the Court's typical practice, the trial will likely be set within two weeks after the final pretrial conference, that is, in late May or early June 2027.

D. Discretionary Denial of the First IPR Petitioner Filed Regarding the '191 Patent

Vivint filed its first IPR, IPR2026-00300, on March 16, 2026 seeking to invalidate the 26 claims of the '191 Patent issued during the reexamination. On May 19, 2026, Patent Owner filed his Request for Discretionary Denial in that IPR arguing, among other things, that the age of the patent, Vivint's longstanding knowledge of the patent, and the timing of the trial in the district court warranted discretionary denial. Ex. 2001 at 6-14. The Director granted Zinser's discretionary denial request on July 14, 2026 and indicated that a written opinion would be forthcoming. Ex. 2002 at 1.

E. Schedule in this IPR Proceeding

Vivint filed its Petition in this IPR on June 1, 2026 seeking to invalidate original dependent claims 5, 7, and 15-18. The Petition was accorded a filing date by the Notice of Filing Date Accorded to Petition mailed June 9, 2026. So, the Board's institution decision must be made by December 9, 2026. If the IPR is instituted, the Board must issue its Final Written Decision ("FWD") by December

9, 2027. As discussed above, the trial in the underlying Litigation will likely occur over six months earlier in late May or early June 2027.

F. The Manufacture of the Accused Products and Size of Petitioner

In the Litigation, Zinser has accused Vivint’s video doorbell camera system of infringing. This includes components of the system, including the video doorbell, a control panel, and indoor and outdoor cameras. These products are manufactured outside of the United States. For example, in the ITC, Vivint admitted that its video doorbell products are manufactured outside of the United States. Ex. 2011 at 18 (“Vivint admits that the Vivint Doorbell Camera Pro is manufactured outside of the United States”). Similarly, the FCC Test Report for the accused Vivint Doorbell Camera Pro (Gen 2) shows that the manufacturer for that product is Chicony Electronics Co., Ltd., located in Taiwan. Ex. 2012 at 1.

Vivint is also a large company. According to the 2025 10-K that Vivint’s parent company, NRG Energy Inc. (“NRG”), filed, Vivint is a nationwide smart-home and security platform that serves customers in all 50 U.S. states and the District of Columbia. Ex. 2013 at 14. Vivint’s LinkedIn page states it has over 10,000 employees. Ex. 2014. And Vivint ended 2025 with approximately 2.4 million Vivint Smart Home customers, and its cloud platform supported more than 37 million connected in-home devices (about 16 devices per household). Ex. 2013

at 10, 51. The Vivint division of NRG’s business generated revenue of \$2.144 billion in 2025 and \$1.991 billion in 2024. *Id.* at 146-47.

III. INSTITUTION OF INTER PARTES REVIEW SHOULD BE DENIED

A. This IPR Presents a Stronger Case than the First IPR Where Discretionary Denial was Granted

In the first IPR Vivint filed (IPR2026-00300), the claims at issue had only been in force for less than six months when Vivint filed that IPR. The relative youth of those claims was one of Vivint’s arguments in opposing discretionary denial. Ex. 2015 at 17-20. Here, there is no such argument. The claims at issue here issued almost seventeen years before Vivint filed this IPR. The Board has found patents in force for less time created settled expectations that warranted discretionary denial. *Dabico Airport Solutions Inc. v. AXA Power Aps*, IPR2025-00408, Paper 21 at 2 (P.T.A.B. June 18, 2025) (finding settled expectations for a patent that had issued “almost eight years” before the filing of the IPR); *see Samsung Elecs. Co., Ltd. v. Cerence Op. Co.*, IPR2025-00458, Paper 14 at 2 (P.T.A.B. June 25, 2025) (same for a patent that issued for eleven years before the IPR); *Cambridge Indus. USA, Inc. v. Applied OptoElectronics, Inc.*, IPR2025-00433, Paper 12 at 3 (P.T.A.B. June 27, 2025) (same for patents that had issued seven and nine years before the IPR); *Samsung Elecs. Co., Ltd. v. Mobile Data Techs., LLC*, IPR2025-00535, Paper 16 at 2 (P.T.A.B. July 10, 2025) (same for

patents that “have been in force for over ten years”). So, the almost seventeen-year life of the patent alone warrants discretionary denial.

Further, Vivint had known about the ’191 Patent, including the claims at issue here, for at least a decade before filing this IPR. Vivint included the ’191 Patent in IDS’s for three separate patent applications in 2016, 2017, and 2018. Exs. 2002; 2003; 2004. Vivint also heavily relied on the ’191 Patent in its invalidity contentions in an ITC matter, which it submitted on April 23, 2021—five years before this IPR was filed. Vivint used the ’191 Patent as one of its primary references, citing to it on seven different pages in its invalidity contentions. Ex. 2007 at 31, 45, 59, 73, 87, 101, 115. Attached to the contentions, Vivint submitted 70-plus page invalidity charts that map the disclosures in the ’191 Patent to the patents at issue in the ITC action. *See* Ex. 2008.

The fact that Vivint has known about the patent for ten years is sufficient to warrant discretionary denial. *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (P.T.A.B. June 6, 2025) (finding settled expectations because Petitioner cited the patent in an IDS filed in its own patent application 12 years earlier); *see Amazon.com, Inc. v. Audio Pod IP, LLC*, IPR2025-00757, Paper 15 at 2-3 (P.T.A.B. Aug. 14, 2025) (holding petitioner’s knowledge of the patent portfolio for 13 years, which included a related patent, favored discretionary denial); *Ericsson Inc. v. ProComm Int’l PTE. Ltd.*, IPR2024-01452, Paper 15 at 3

(P.T.A.B. June 25, 2025) (finding settled expectations because “Petitioner was aware of [the patent] as early as 2013—having been brought to the Petitioner’s attention in a Notice of References Cited during the prosecution of one of its own patents”).

The Interim Director’s decision in *iRhythm* is instructive here. In that case, the petitioner had cited the patent at issue in an IDS for its own patent application in 2013, twelve years before the petitioner filed its IPR. *iRhythm*, IPR2025-00363, Paper 10 at 3. Unlike here, the trial in the district court was set to occur six months *after* the FWD. *Id.* at 2. Nonetheless, the Interim Director found that petitioner’s knowledge based on the IDS was dispositive and discretionarily denied the petition. *Id.* at 3. The case for discretionary denial is stronger than in those cases because not only has Vivint known about the patent for a decade, but, as discussed below, the trial here is set to occur sixth months *before* the FWD.

Thus, just like in *iRhythm*, Zinser had settled expectations that Vivint would not challenge his patent, and the Petition should be discretionarily denied.

B. The Trial Date Favors Discretionary Denial

As with settled expectations, the trial date presents a stronger argument in favor of discretionary denial than in the first IPR. The decision on institution in this IPR must be made by December 9, 2026 and the Board must issue the FWD by December 9, 2027. In the Litigation, the Court set the final pretrial conference for May 14, 2027. Ex. 2010. While the District Court did not set a trial date, the Court typically sets jury trials within two weeks after the final pretrial conference. *See SB IP Holdings LLC v. Vivint, Inc.*, No. 4:20-cv-886, (E.D. Tex. June 9, 2023) (setting trial five days after final pretrial conference), Ex. 2016 at 1; *Innovation Sciences, LLC v. Resideo Techs. Inc.*, No. 4:18-cv-475, Dkt. 92 (E.D. Tex. July 14, 2020) (setting trial for 14 days after the final pretrial conference), Ex. 2017 at 2; *Wapp Tech Ltd. P'ship v. Seattle Spinco, Inc.*, No. 4:18-cv-00469-ALM, Dkt. 258 (E.D. Tex. Dec. 1, 2020) (setting trial 13 days after the final pretrial conference), Ex. 2018 at 3.

Based on the Court's usual practice, the jury trial will likely take place in late May or early June 2027, over six months before the December 2027 deadline for the FWD. In the first IPR, the time between trial and the FWD was three months, so the six months between trial and the FWD here present a stronger case in favor of discretionary denial. Ex. 2001 at 11.

The Board has routinely denied institution when the jury trial predates the FWD. *See, e.g., Samsung Elecs. Co., Ltd. v. Sinotechnix LLC*, IPR2025-00331, Paper 13 at 2 (P.T.A.B. July 2, 2025) (finding that the jury trial predating the final written decision weighed in favor of discretionary denial); *Ericsson Inc. v. Active Wireless Techs. LLC*, IPR2024-00886, Paper 8 at 8-9 (P.T.A.B. Nov. 12, 2024) (collecting cases). The Board has found that this factor favors the denial of institution even when the length between trial and the FWD is less than the six-month gap here. *See NXP USA, Inc. v. Redstone Logics LLC*, IPR2025-00485, Paper 11 at 2 (P.T.A.B. July 10, 2025) (holding that a 2.5-month period between the trial date and FWD deadline favored discretionary denial); *EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (P.T.A.B. Apr. 13, 2022) (similar regarding a one-to-two-month period).

In the Litigation, the District Court has not granted a stay nor is it likely to do so. Vivint has not sought a stay and judges in the Eastern District of Texas routinely deny any requests to stay litigations prior to the institution of an IPR. *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (citing cases for the proposition that “[t]his Court’s survey of cases from the Eastern District of Texas shows that when the PTAB has not yet acted on a petition for inter partes review, the courts have uniformly denied motions for a stay”); *AR Design Innovations LLC v. Ashley*

Furniture Indus., Inc., No. 4:20-cv-392-SDJ, 2021 WL 6496714, at *3-4 (E.D. Tex. Jan. 11, 2021) (citing *Trover*); see *Luminati Networks Ltd. v. Teso LT, UAB*, No. 2:19-CV-00395-JRG, 2020 WL 6803255, at *1 (E.D. Tex. Oct. 30, 2020).

Even if this IPR is instituted, the District Court is unlikely to stay the Litigation. This is true for two reasons. First, since the Director discretionarily denied Vivint’s first IPR, seven of the ten asserted claims in the Litigation are not subject to an IPR. So, the majority of the claims in the Litigation will proceed regardless of the outcome of this IPR. Indeed, courts in the Eastern District have denied motions to stay when only a subset of the asserted claims were part of an IPR. *Uniloc 2017 LLC v. Samsung Elecs. Am., Inc.*, No. 2:19-cv-00259-JRG-RSP, 2020 WL 1433960, at *6 (E.D. Tex. Mar. 24, 2020) (“The parties agree that, at most, only eight of the nineteen Asserted Claims are challenged...The Court would inevitably need to resolve the dispute concerning those remaining claims. Therefore, the pending IPRs do not offer the prospect of enough simplification of the issues to justify a stay.”); *Headwater Research LLC v. Samsung Elecs. Co., Ltd.*, No. 2:23-cv-00103-JRG-RSP, 2024 WL 5080240, at *2 (E.D. Tex. Dec. 11, 2024) (denying motion to stay because one of the asserted patents was not part of an IPR).

Second, district courts are less likely to stay litigation when, as here, the FWD would issue after the trial. See, e.g., *MyPort, Inc. v. Samsung Elecs. Co.*,

Ltd., No. 2:22-cv-00114-JRG, Dkt. 73 (E.D. Tex. June 13, 2023) (denying a motion to stay when “the PTAB [FWD] is not due until over two months after jury trial is set to begin”), Ex. 2019 at 4; *Solas OLED Ltd. v. Samsung Display Co., Ltd.*, No. 2:19-CV-00152-JRG, 2020 WL 4040716, at *2 (E.D. Tex. July 17, 2020) (denying a motion to stay when, among other issues, “the Final Written Decisions on the aforementioned IPRs could not be issued before the scheduled infringement trial in this case”).

Thus, because trial will occur six months before the FWD and the District Court is unlikely to stay the underlying Litigation, discretionary denial is warranted.

C. The Director’s Recent Factors Regarding Domestic Industry Favor Discretionary Denial

In his March 11th Memo, the Director identified additional factors that he will consider when determining whether discretionary denial is appropriate. Those three factors are:

1. The extent to which any products accused of infringement in a parallel proceeding are manufactured in the United States or are related to investments in American manufacturing operations;
2. The extent to which any products made, sold, or licensed by the patent owner that compete with the accused products are manufactured in the United States; and
3. Whether the petitioner is a small business that has been sued for infringement of the patent at issue.

These factors are either neutral or favor Patent Owner.

With respect to the first factor, in the Litigation, Patent Owner has accused Petitioner's video doorbells, indoor and outdoor cameras, and related security products of infringement. These products are manufactured outside of the United States. *See Magnolia Med. Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 4 (P.T.A.B. May 14, 2026) (precedential) (noting that “[s]ome stakeholders have asserted that the availability of IPRs and PGRs is important to protect American manufacturers and small businesses”) (internal citations omitted). For example, in filings before the ITC, Vivint “admit[ted] that the Vivint Doorbell Camera Pro is manufactured outside of the United States.” Ex. 2011 at 18. Other government filings similarly show that the accused products are manufactured outside the United States. The FCC Test Report for the accused Vivint Doorbell Camera Pro (Gen 2) states that the manufacturer of that product is located in Taiwan. Ex. 2012 at 1. Similar FCC test reports for two additional accused products—the Vivint Indoor Camera Pro and Vivint Outdoor Camera Pro—indicate that Taiwanese companies, Chicony Electronics Co., Ltd. and WNC Corporation, manufacture them, respectively. Ex. 2020 at 1; Ex. 2021 at 1. Thus, this factor favors discretionary denial.

Regarding the second factor, Zinser is an individual patent owner and does not manufacture or sell any products. Nor are there currently any products “licensed by the patent owner that compete with the accused products.” While the ’191 Patent was previously licensed to a Vivint competitor, that license expired in January 2025, a year and a half before Vivint filed this IPR. Ex. 2003 at ¶ 24. Thus, this factor is neutral.

Regarding the final factor, Vivint is not a small business. For example, Vivint advertises that it has over 10,000 employees. Ex. 2014. In 2025, Vivint had approximately 2.4 million Vivint Smart Home customers, and its cloud platform supported more than 37 million connected in-home devices. Ex. 2013 at 10, 51. Given its size, it is unsurprising that Vivint has generated significant revenues. According to Vivint’s parent company’s (NRG), the Vivint segment of its business generated revenue of \$2.144 billion in 2025 and \$1.991 billion in 2024. *Id.* at 146-47. So, this factor also favors discretionary denial.

Thus, two of these factors favor discretionary denial and one is neutral.

D. The Remaining *Fintiv* Factors Favor

While several of the *Fintiv* factors, such as whether a stay is likely and the proximity of the trial date, have been addressed above, the remaining factors favor discretionary denial overall. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (P.T.A.B. Mar. 20, 2020) (precedential).

1. The Stage and Overlap with the Litigation Favors Denial

As detailed above, the trial in the Litigation will occur six months before the FWD issues in this IPR. By the time of institution in December, the claim construction process will be completed in late September, months before the FWD. Ex. 2010. Fact discovery will close on December 14, five days after the FWD deadline, with opening expert reports due on December 22. *Id.*

Further, unlike this IPR, the Litigation will resolve all invalidity issues regarding the '191 Patent since seven of the ten claims currently asserted in the Litigation are not subject to an IPR. And that resolution will occur months before the FWD issues. *See Nokia of Am. Corp. v. Pegasus Wireless Innovation LLC*, IPR2025-0037, 2025 WL 1204426, at *6 (P.T.A.B. Apr. 25, 2025) (“We determine that resolution of all of the disputes based on all of the issues between the parties regarding the challenged patent before the district court, which likely would occur many months before a subset of the issues could be resolved before the Board, would be more efficient and, therefore, weighs in favor of exercising discretion to deny institution of *inter partes* review.”).

Also, as the Director recently stated, “all too often the co-pending litigation involves...the same arguments as the AIA review.” *See Magnolia Med. Techs.*, Paper 17 at 3. Indeed, the Petition here is an example of when the IPR process is not used as an “alternative” to litigation. For example, in the Litigation, Vivint has

included the same prior art it asserted in the Petition, Schranz, as one of its primary references in its invalidity contentions. Ex. 2022 at 16, 21-22. Further, those contentions include numerous patents, patent applications, and printed publications that Vivint could have asserted in this IPR. *Id.* at 16-17, 22-24 (listing the prior art with all but one reference being a patent, patent application, or printed publication).

Thus, this factor favors discretionary denial.

2. Petitioner Has Not Filed a *Sotera*-type Stipulation, but Provided One in Correspondence

Petitioners often file a *Sotera*-type of stipulation either in the IPR or in the Litigation. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18 (P.T.A.B. Dec. 1, 2020) (precedential). Those stipulations state that Petitioner will not pursue the same invalidity grounds it raised or could have raised in the IPR. As of the filing of this brief, Petitioner has not filed any such stipulation in any IPR or in the District Court. Petitioner has, however, provided correspondence to Patent Owner that includes a *Sotera*-type of stipulation. Ex. 2023. Because Petitioner has not filed a stipulation, but has provided that stipulation in correspondence, this factor is neutral. *See Intel Corp. v. Professor Masahiro IIDA*, IPR2023-00864, Paper 9, at 1-3 (P.T.A.B. Sept. 19, 2023) (Patent Owner citing cases that correspondence without a filing in the District Court does not comport

with the relevant rules regarding stipulations).

3. The Parties Here and in the Litigation Are Identical Favoring Denial

Petitioner and Patent Owner are both parties to the Litigation. Additionally, Vivint, Inc., which is a party to the Litigation, but not to this IPR, converted to Vivint, LLC (the Petitioner) in 2024. Thus, this factor also favors discretionary denial.

4. Other Factors Favor Denial

As discussed above, other factors such as the discretionary denial of the first IPR involving the '191 Patent, the advanced age of the '191 Patent, and Vivint's knowledge of the patent for a decade before filing this IPR support Zinser's settled expectations and favor discretionary denial.

IV. CONCLUSION

The three most important factors all favor discretionary denial: (1) the claims at issue had been in force for over 16 years before Vivint filed this IPR; (2) Vivint has known about the '191 Patent, which included the claims at issue in this case, for a decade before it filed this IPR and; (3) trial in the district court case is scheduled to occur six months before the FWD deadline. These facts present a stronger case here than in the first IPR where the Director granted discretionary denial. Thus, Zinser respectfully requests that the Director again exercise his discretion and deny institution in this IPR proceeding.

Dated: August 10, 2026

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CERTIFICATE UNDER 37 C.F.R. SECTION 42.24

Zinser certifies that the page count in this Request is 19 pages. This Request is in compliance with the 20-page limit. *See*

<https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>.

CERTIFICATE OF SERVICE

I, Gary R. Sorden, hereby certify that on the 10th day of August, 2026, the foregoing PATENT OWNER DUKE W. ZINSER'S REQUEST TO DIRECTOR FOR DISCRETIONARY DENIAL OF PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT 7,583,191 was served on the following by email:

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