

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIVINT LLC,
Petitioner,

v.

DUKE W. ZINSER,
Patent Owner.

Case IPR2026-00300
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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35 U.S.C. § 325	1

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	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.)
2002	Information Disclosure Statement by Applicant, dated June 9, 2016
2003	Information Disclosure Statement by Applicant, dated May 3, 2017
2004	Information Disclosure Statement by Applicant, dated January 5, 2018
2005	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)
2006	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)
2007	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.)
2008	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)
2009	FCC DFS Test Report for Vivint Doorbell Camera Pro (Gen 2), dated September 27, 2022
2010	2025 Form 10-K for NRG Energy, Inc.
2011	Vivint LinkedIn Page, https://www.linkedin.com/company/vivint/about/ (last accessed April 2, 2026)
2012	US Reissued Patent 49,461, dated March 14, 2023

Exhibit No.	Description
2013	Reissue Application Declaration by the Inventor for U.S. Patent No. 9,189,828, Reissue Application No. 15/808,201
2014	Order Setting Trial, dated June 9, 2023, entered in <i>SB IP Holdings, LL v. Vivint, Inc.</i> , No. 4:20-cv-886, Dkt. 374 (E.D. Tex.)
2015	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.)
2016	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.)
2017	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. June 13, 2023)
2018	FCC Radio Test Report for Vivint Indoor Camera Pro, dated January 5, 2023
2019	FCC Radio Test Report for Vivint Outdoor Camera Pro (Gen 3), dated July 9, 2025
2020	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.)

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

When U.S. Patent No. 7,583,191 (the “’191 Patent”) issued, almost seventeen years ago, on September 1, 2009, it was one of the pioneering patents in the doorbell camera and home security industry. Indeed, it has been cited in 214 patent applications. Petitioner Vivint LLC (“Petitioner” or “Vivint”) itself 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 nearly a decade and cited it repeatedly over the years. Despite this, Vivint never challenged the patent until it filed this IPR. The 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).

Other factors similarly favor denial. 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 September 19, 2027, over three (3) months after the jury trial. And the new factors from the Director's March 11th Memo also 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. Again, the '191 Patent was one of the pioneering patents in this industry. Showing respect for the pioneering nature

of the '191 Patent, one of Petitioner's major competitors licensed the patent in 2013. Ex. 2001 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 to the '191 Patent in an Information Disclosure Statement ("IDS") by Applicant submitted on June 9, 2016. Ex. 2002. 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* Ex. 2002 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. 2003 at 2; 2004 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 the primary prior art references in its invalidity contentions. Ex. 2005 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. 2006. Vivint submitted its contentions on April 23, 2021, approximately 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 August 15, 2024. The reexamination resulted in the cancellation of the original independent claims, claims 1, 8, 14, and 19, and the issuance of new claims 21-47. The reexamination certificate issued on September 18, 2025. Zinser filed his Complaint 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 asserted 31 claims of the '191 Patent, including five of the original dependent claims, which have been in force since September 1, 2009, and 26 new claims issued in the reexamination.

On April 7, 2026, the Court issued its Patent Scheduling Order providing certain case deadlines (the "Order"). Ex. 2007. 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. Schedule in this IPR Proceeding

Vivint filed its Petition on March 16, 2026 seeking to invalidate the new claims 21-47, which issued in the reexamination. The Petition was accorded a filing date by the Notice of Filing Date Accorded to Petition mailed March 19,

2026. So, the Board's institution decision must be made by September 19, 2026. If the IPR is instituted, the Board must issue its Final Written Decision ("FWD") by September 19, 2027. As discussed above, the trial in the underlying Litigation will likely occur over three months earlier in late May or early June 2027. Further, Petitioner has not submitted a *Sotera*-type stipulation in either this IPR or the district court case.

E. 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 central 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. 2008 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. 2009 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. 2010 at 14. Vivint's LinkedIn page states it has over

10,000 employees. Ex. 2011. 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. 2010 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. Zinser Had Settled Expectations Given the Age of the '191 Patent and Vivint's Decade-Long Knowledge of the Patent

The '191 Patent issued over sixteen 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 over sixteen-year life of the patent alone warrants discretionary denial.

The fact that the claims challenged in this IPR issued more recently from a narrowing reexamination does not affect this analysis. Those claims resulted from a reexamination of the '191 Patent that Patent Owner initiated. Because it was a reexamination, the claims had to overcome prior art and the newly issued claims were narrower than the original claims. *See* 35 U.S.C. § 305 (“No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter”). So, the reexamination only reinforced Zinser’s settled expectations that Vivint would not challenge the patent because the subsequent claims were narrower and, therefore, more difficult to challenge.

The only “settled expectations” case Patent Owner has located concerning newly issued claims of an older patent is *Nvidia Corp. v. Neural AI, LLC*, IPR2025-00608, Paper 16 (P.T.A.B. July 31, 2025). In that case, the Interim Director found that the newly issued claims counseled against discretionary denial. *Id.* at 2-3. But those claims were the result of a reissuance, not a reexamination. During that reissuance, the patentee sought to *broaden* the scope of the claims in

the patent.¹ For example, the specification of reissued patent states that it is a “broadening reissue.” *See* Ex. 2012 at 1:14-15, 24-25. Similarly, one of the grounds the patentee cited for reissuance was that the “Applicant erred by claiming less than it had a right to claim in [original patent] US 9,189,828.” Ex. 2013 at 1. And the patentee ultimately obtained broader claims in the reissued patent. *See, e.g.*, Ex. 2012 at Claim 21 (directed to an entirely different system and lacking material elements found in original claims, such as an “accelerator”). So, the patentee there, unlike Zinser, obtained broader claims through the reissuance process and so did not have settled expectations in those newly issued claims. *See Nvidia Corp.*, IPR2025-00608, Paper 16 at 2-3 (finding that newly issued claims counseled against discretionary denial). Whereas Zinser obtained narrower claims and overcame additional prior art during the reexamination process. *See* 35 U.S.C. § 305. So, the situation in *Nvidia* is distinguishable and does not counsel against discretionary denial here.

But the *Nvidia* decision is analogous regarding a different issue—Petitioner’s prior knowledge of the patent. In *Nvidia*, the Interim Director found that even though the broader claims of the reissued patent were too recent to

¹ The Reissued Patent RE49,691 was a continuation of another Reissue Application, 15/808,201, which was filed within two years of issuance of the underlying patent.

warrant discretionary denial, Nvidia's prior knowledge of the pre-reissued patent created settled expectations that outweighed the relative youth of the reissued claims. *Nvidia Corp.*, IPR2025-00608, Paper 16 at 3.

Here, Vivint has known about the '191 Patent for almost a decade. 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. 2005 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. 2006.

The fact that Vivint has known about the patent for almost 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. 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 here because not only has Vivint known about the patent for a decade, but, as discussed below, the trial here is set to occur three 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

The Board’s decision on institution must be made by September 19, 2026 and the Board must issue the FWD by September 19, 2027.

In the Litigation, the Court set the final pretrial conference for May 14, 2027. Ex. 2007. 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.) (setting trial five days after final pretrial conference), Ex. 2014 at 1; *Innovation Sciences, LLC v. Resideo Techs. Inc.*, No. 4:18-cv-475, Dkt. 92 (E.D. Tex.) (setting trial for 14 days after the final pretrial conference), Ex. 2015 at 2; *Wapp Tech Ltd. P'ship v. Seattle Spinco, Inc.*, No. 4:18-cv-00469-ALM, Dkt. 258 (E.D. Tex.) (setting trial 13 days after the final pretrial conference), Ex. 2016 at 3. Based on the Court's usual practice, the jury trial will likely take place in late May or early June 2027, over three months before the deadline for the FWD.

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). Where, as here, there is a three-month time gap between the trial and the FWD deadline, the Board has found that this factor favors the denial of institution. *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) (same).

Even if this IPR is instituted, the District Court is unlikely to stay the Litigation. This is true for two reasons. First, there are five asserted claims that are not subject to an IPR so there will be live claims in the Litigation regardless of the outcome of this IPR. 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). And the fact that Petitioner has not made any *Sotera*-type declaration similarly weighs against the district court staying the parallel litigation. *See Realtime Data, LLC v. Rackspace US, Inc.*, No. 6:16-cv-00961-RWS-JDL, 2017 WL 772654, at *3 (E.D. Tex. Feb. 28, 2017) (finding that the fact that two of the asserted claims were not under IPR and defendant did not make a full estoppel declaration slightly weighed against a stay).

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. 2017 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 three 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. 2008 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. 2009 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. 2018 at 1; Ex. 2019 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, over a year before Vivint filed this IPR. Ex. 2001 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. 2011. 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. 2010 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, since Petitioner is not a small business, 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. 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 three months before the FWD issues in this IPR. By the time of institution in September, the parties will have served their infringement and invalidity contentions. Ex. 2007. The parties will also have completed claim construction discovery and briefing with the claim construction hearing occurring shortly after the FWD deadline, on September 28, 2026. *Id.* Further, unlike this IPR, the Litigation will resolve all invalidity issues regarding the '191 Patent since five claims asserted in the Litigation are not

challenged in this 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.”).

Further, 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. 2021 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 Made a *Sotera*-type Stipulation

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. Thus, this factor favors discretionary denial. *See Roku, Inc. v. Ioengine, LLC*, IPR2023-01553, 2023 WL 5111069, at *6 (P.T.A.B. May 5, 2023) (finding the lack of a complete *Sotera* stipulation favored discretionary denial).

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 age of the '191 Patent and Vivint's knowledge of the patent for a decade before filing this IPR support Zinser's settlement expectations and favor denial.

So, these remaining *Fintiv* factors also favor denial here.

IV. CONCLUSION

The three most important factors here all favor discretionary denial: (1) the '191 Patent had been in force for over 16 years before Vivint filed this IPR; (2) Vivint had known about the '191 Patent for nearly a decade before it filed this IPR and; (3) trial in the district court case is scheduled for three months before the FWD deadline. These facts are dispositive in favor of discretionary denial. Thus, Zinser respectfully requests that the Director exercise his discretion and deny institution in this IPR proceeding.

Dated: May 19, 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 19th day of May, 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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