

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIVINT LLC
Petitioner,

v.

DUKE W. ZINSER,
Patent Owner,

U.S. Patent No. 7,583,191
Issue Date: September 1, 2009
Title: SECURITY SYSTEM AND METHOD FOR USE OF SAME

Inter Partes Review No.: IPR2026-00375

**PETITIONER'S OPPOSITION TO PATENT OWNER DUKE W. ZINSER'S
REQUEST FOR DISCRETIONARY DENIAL**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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PETITIONER'S EXHIBIT LIST

<i>Exhibit #</i>	<i>Description</i>
1001	U.S. Patent No. 7,583,191 (“’191 Patent”)
1002	Prosecution History of the ’191 Patent (“File History”)
1003	IPR2026-00300 Declaration of Petitioner’s Expert James Parker
1004	U.S. Patent Publication 2004/0086093 (“Schranz”)
1005	Reexam Prosecution History of the ’191 Patent
1006	U.S. Pat. No. 6,429,893
1007	U.S. Pat. No. 6,778,084
1008	U.S. Patent Publication 2002/0147982
1009	<i>Curriculum Vitae</i> of James Parker
1010	James Parker Patent Summary
1011	<i>Intentionally Left Blank</i>
1012	Excerpts of Plaintiff’s Disclosure of Asserted Claims and Infringement Contentions (2026-04-16)
1013	<i>Intentionally Left Blank</i>
1014	<i>Intentionally Left Blank</i>
1015	<i>Intentionally Left Blank</i>
1016	Letter from B. Greene to G. Sorden dated May 20, 2026
1017	<i>Intentionally Left Blank</i>
1018	Email from B. Greene to G. Sorden dated June 18, 2026 (<i>Sotera Plus</i> Stipulation)

I. INTRODUCTION

Vivint, LLC (“Petitioner”) opposes the request by Duke W. Zinser (“Patent Owner” or “PO”) for Discretionary Denial of Institution (Paper 6, “Request”). The Challenged Claims of the ’191 Patent never should have issued, as demonstrated by the prosecution of the original claims, the Patent Owner’s assertion during the reexamination proceeding that the claims are invalid, and further in view of strong new evidence of invalidity in the Petition.

First, the Petition is based on prior art that was not before the Patent Office during examination, but would have been if the examiner had spent more time searching and used search criteria tied to the features asserted to distinguish over the prior art. The IPR prior art, U.S. Patent Publication 2004/0086093 (“Schranz”) (EX-1005), is nearly identical to the subject matter of the ’191 Patent and discloses the very limitations that were thought to be missing from the prior art as a result of the examiner’s erroneous searches. The resources of the Office should be used to correct these errors. Underscoring the importance of this Petition to the validity of the ’191 Patent and the integrity of the patent system, PO does not even request denial under 35 U.S.C. § 325(d).

Second, there is no basis to shield the ’191 Patent’s invalidity using the “settled expectations” doctrine. This doctrine does not apply because in June

2024, the Patent Owner asserted that the Challenged Claims of the '191 Patent were invalid when it filed a Request for Reexamination.

Third, there is no basis to give the invalidity of the '191 Patent a pass under *Fintiv*, given the strong evidence of apparent examiner error here, and in view of Patent Owner's delay in asserting the Challenged Claims. Further, Petitioner has issued a *Sotera* Plus stipulation so there will be no overlap in validity issues between the District Court and the PTAB.

Finally, relevant to the public interest, Petitioner's accused product in the litigation is a system that is designed/installed and hosted in the United States provided through Petitioner's U.S. investments and represents a substantial investment in U.S. jobs and infrastructure.

II. BACKGROUND

Patent Owner asserts that because the Director discretionarily denied the petition in IPR2026-00300 that was directed only to newly issued reexamined claims of the '191 Patent, the Director should deny the present Petition because the "grounds to discretionarily deny this IPR are stronger than in the previous IPR." Paper 8 at 1. Not so. As described below, Patent Owner waited until after Petitioner filed the previous IPR to then assert claims that Patent Owner had previously asserted were invalid. The resources of the Office would be well-spent to institute review of claims that the Patent Owner previously asserted to the Office

were invalid in order to send a strong message that such gamesmanship will not be tolerated.

In the initial Complaint filed in the Related Litigation on September 18, 2025, Patent Owner only asserted the claims newly issued in the reexamination: “Claims 21 – 47 of the ’191 Patent.” EX-1011 ¶39. Relying on the Complaint and Patent Owner’s previous admission that the original dependent claims of the ’191 Patent were invalid in the Request for Reexamination, Petitioner filed IPR2026-00300 on March 16, 2026, challenging 21-47, the only claims that were added and issued during the reexamination. IPR2026-00300, Paper 1.

On April 16, 2026, seven months after it filed the Complaint, and after having received the Petition for IPR2026-00300 challenging the newly issued claims, Patent Owner served its infringement contentions, asserting for the first time, originally issued claims 2-7, 15-18, and 20. EX-1012, 2. These are the very same claims that Patent Owner asserted “are invalid” in its Request for Reexamination. EX-1005, 4-5 (“Accordingly, claims 2-7 and 20 are invalid for at least the reasons set forth with respect to claims 1 and 19....Accordingly, claims 9-13 and 15-18 are invalid for at least the reasons set forth with respect to claims 8 and 14.”).

On May 8, 2026, Patent Owner withdrew its assertion of claims 2-4, 6, and 20. Accordingly, this Petition is only directed to the remaining asserted claims

from the originally issued '191 Patent: Claims 5, 7, and 15-18. Claims that the Patent Owner (a) previously represented to the USPTO “are invalid” and (b) did not include in the original complaint. EX-1005, 4-5; EX-1011 ¶39. This Petition uses the same prior art references that were the basis for the grounds in IPR2026-00300.

III. STIPULATIONS

Petitioner stipulates that if the Board grants the Petition and institutes an *inter partes* review, unless institution is later vacated, reversed or otherwise withdrawn by rehearing or Director Review, Petitioner will not pursue in the Litigation the specific grounds that it raised in the Petition, nor any other ground that Petitioner could have reasonably raised in an IPR against the challenged claims of the '191 Patent, nor any invalidity ground based on system prior art corresponding to the printed publication asserted in the specific invalidity ground that it raised in the IPR petition. *See Sotera Wireless, Inc. v. Masimo Corp.*, Case IPR2020-01019, Paper 12 (Dec. 1, 2020) (precedential); *Magnolia Medical Technologies, Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 3 (Director, May 14, 2026) (precedential); EX-1018. Moreover, given the Director’s new guidance in decisions designated informative on May 13, 2026, Petitioner stipulates that it will not pursue in the Litigation any indefiniteness ground under 35 U.S.C. §112

against any claim of the '191 Patent.¹

IV. INSTITUTION IS WARRANTED TO CORRECT THE ERRONEOUS ORIGINAL ISSUANCE OF THE '191 PATENT

A. The '191 Patent Should Never Have Been Issued

As explained in the Petition, the '191 Patent issued based on the examiner's mistaken belief that, while the prior art disclosed security systems that disclosed the same architecture including a video camera, an external speaker, and a control unit for relaying captured video and audio to a cellular telephone, the prior art did **not** disclose a doorbell in a doorway for indicating the presence of a visitor. However, Schranz discloses these very features. Like the '191 Patent claims, Schranz discloses that when a visitor approaches a doorway, an event is detected, *e.g.*, by ringing of the doorbell. In turn, a video camera and external microphone capture visual and audio communications at the doorway. The captured doorway visual and audio communications are transmitted to a cellular telephone via a control unit that is in communication with the video camera and external microphone as well as a cellular network for communicating with the cellular

¹ By email sent to PO's counsel on June 18, 2026, Petitioner entered the above (i) "*Sotera Plus*" stipulation, *i.e.*, a conventional *Sotera* stipulation with additional assurances regarding certain system prior art, which the Board has found favorable to institution, and (ii) "*No Indefiniteness*" stipulation. *See* EX-1018.

telephone. *See Vivint LLC v. Zinser*, IPR2026-00300, Paper 2, p. 3-4 (Mar. 16, 2026).

In the first Office Action, the examiner rejected all claims as anticipated by Chang (U.S. Pat No. 6,778,084). EX-1002, 58. In response, Patent Owner amended all independent claims to recite that a doorbell provides a triggering event for capturing entry point visual and audio:

1. (Currently amended) A ~~security~~ doorbell monitoring system comprising:

~~an entry point~~ a doorway having an environment;

a doorbell located in the doorway, the ringing of the doorbell being a triggering event;

a video camera and an external microphone disposed in the entry point, the video camera and external microphone, responsive to the triggering event, for capturing entry point visual and audio communications at the entry point and transmitting the captured entry point visual and audio communications;

an external speaker disposed in the entry point, the external speaker for rendering received cellular audio communications;

a control unit disposed in communication with the video camera, the doorbell, and the external microphone, the control unit for communicating at least one portion of the entry point visual and audio communications received from the video camera and external microphone, and for communicating the received cellular audio communications to the external speaker; and

a cellular telephone disposed remotely to the ~~entry point doorway~~ and the control unit, the cellular telephone for capturing cellular audio communications at the cellular telephone, transmitting the cellular audio communications to the control unit, and rendering the at least one portion of entry point communications received from the control unit.

EX-1002, 80-81.

Patent Owner argued that the use of the doorbell allowed detection of a visitor to distinguish over Chang's detection of an intruder:

Anticipation Analysis

As amended, Applicant's independent claims recite a doorbell monitoring system or method that notifies an individual of a doorbell ringing triggered by the ringing of the doorbell. Applicant's claims monitor a doorbell for detecting the presence of visitors. As discussed, the cellular telephone audio and visual communicating to and from the cellular phone may include systems which utilize the Public Switched Telephone Network (PSTN), satellite telephone network (PSTN), satellite-based networks, the Internet, and other systems known in the art.

Contrary to Applicant's claims, in each application disclosed by Chang, the presence of an intruder is detected by actuation of an intrusion device rather than the ringing of a doorbell. The result is Chang is different with respect to the claimed invention. Chang does not work in connection with an everyday, non-emergency event, triggered by a visitor ringing the doorbell. Chang only works with emergency, alarm events.

EX-1002, 92-93.

As an initial matter, the examiner should not have accepted the Patent Owner's arguments that adding a doorbell to a prior art security system in order to identify a "visitor" instead of an "intruder" imparts patentability. There is nothing in the '191 Patent that describes anything other than commercial off-the-shelf security components, such as video cameras, speakers, and cellular phones, being

used together for their intended purpose. Thus, the addition of a doorbell to actuate the video camera in the doorway in response to a user should have indicated to the examiner that this is nothing more than an obviousness combination of components used for their intended purpose in a specific environment, *i.e.*, a doorway.

In response to these arguments, it appears that the examiner spent two minutes searching on April 24 (from 3:26 pm-3:28 pm).²

² The examiner began his search on April 24, 2009 at 15:26 and conducted the last search at 15:28 and printed out the search results for the record at 15:28.

EAST Search History

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	0	security with system with doorway with (activate trigger) with video with audio	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2009/04/24 15:26
L2	271	security and system and doorway and (activate trigger) and video and audio	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2009/04/24 15:27
L3	10	2 and cellular and speaker and doorbell and entry	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2009/04/24 15:27
L4	0	340/540. ccls. and cellular and speaker and doorbell and entry	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2009/04/24 15:27
L5	3	340/541. ccls. and cellular and speaker and doorbell and entry	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2009/04/24 15:28
S26	11	doorbell with activated with security	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2009/04/13 09:36

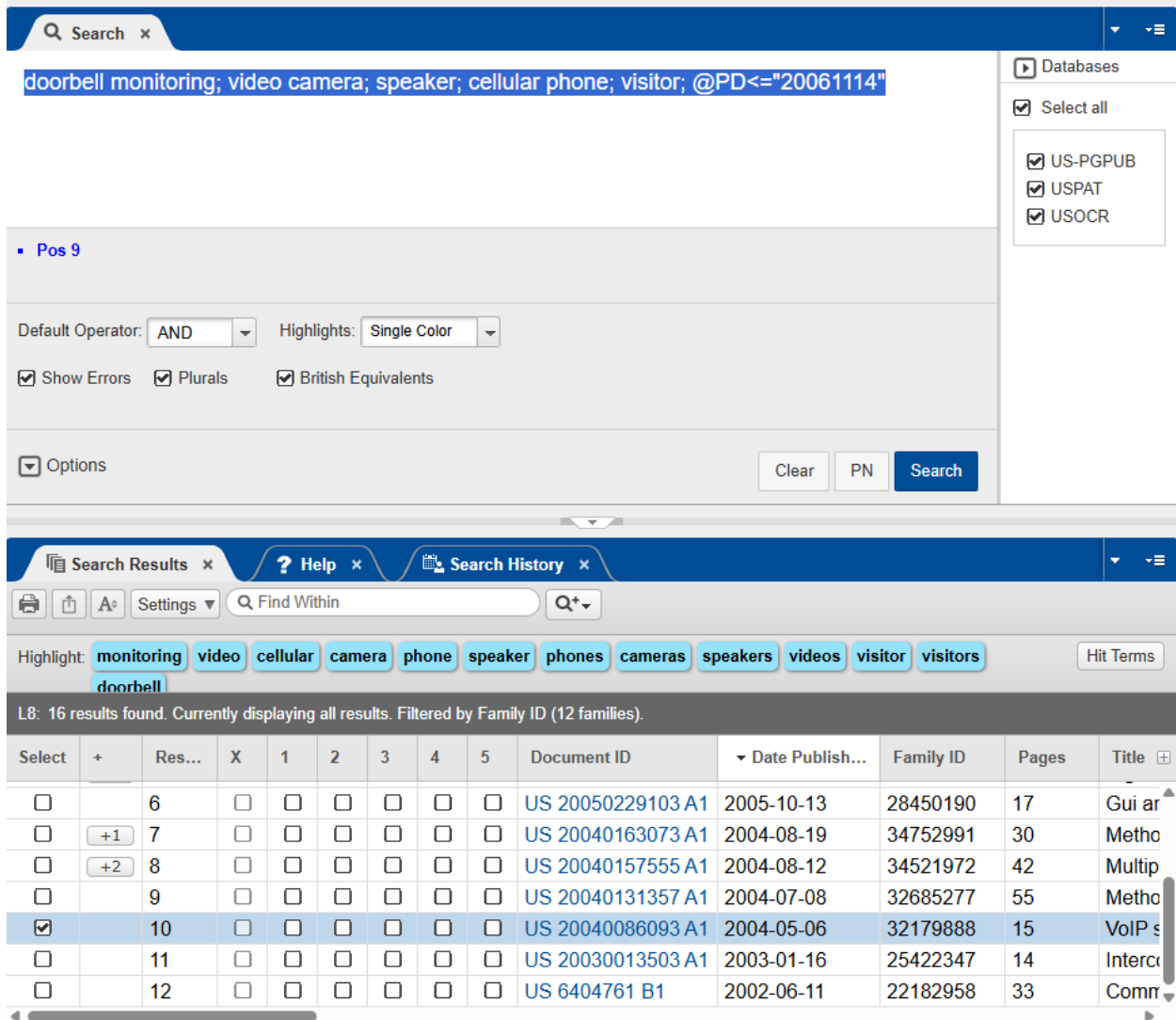
4/ 24/ 09 3:28:38 PM

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EX-1002, 102.

However, the examiner was unable to locate any relevant art of a doorbell monitoring system that captures video and audio of a visitor and forwards the captured data to a cellular phone. The examiner's search for "security and system and doorway and (activate trigger) and video and audio" yielded 271 hits. This should have indicated to the examiner that this was a crowded field and warranted more searching than the two minutes he spent. For example, the search below uses

some of the basic features from Claim 1 (“doorbell monitoring”, “video camera”, “speaker”, “cellular phone”) and the term “visitor” to capture the distinguishing features alleged by the Patent Owner:



The screenshot displays a patent search interface. The search bar contains the query: "doorbell monitoring; video camera; speaker; cellular phone; visitor; @PD<="20061114". The interface includes a sidebar with database selection options (US-PGPUB, USPAT, USOCR) and a main results area. The results area shows a table of 12 patent families, with the 10th result highlighted. The table columns include Select, Res..., X, 1, 2, 3, 4, 5, Document ID, Date Publish..., Family ID, Pages, and Title.

Select	+	Res...	X	1	2	3	4	5	Document ID	Date Publish...	Family ID	Pages	Title
☐		6	☐	☐	☐	☐	☐	☐	US 20050229103 A1	2005-10-13	28450190	17	Gui ar
☐	+1	7	☐	☐	☐	☐	☐	☐	US 20040163073 A1	2004-08-19	34752991	30	Metho
☐	+2	8	☐	☐	☐	☐	☐	☐	US 20040157555 A1	2004-08-12	34521972	42	Multip
☐		9	☐	☐	☐	☐	☐	☐	US 20040131357 A1	2004-07-08	32685277	55	Metho
☒		10	☐	☐	☐	☐	☐	☐	US 20040086093 A1	2004-05-06	32179888	15	VoIP s
☐		11	☐	☐	☐	☐	☐	☐	US 20030013503 A1	2003-01-16	25422347	14	Interco
☐		12	☐	☐	☐	☐	☐	☐	US 6404761 B1	2002-06-11	22182958	33	Comr

This search identifies 12 patent families, one of which is Schranz, the sole prior art reference used in IPR2026-00375. If the examiner had spent a little more time and used search terms directed to the argument and amendment presented by

the Patent Owner, the examiner would have easily located the Schranz reference because it discloses all the limitations of the claims as described in the Petition.

Thus, it was the examiner's error that erroneously allowed the original claims to issue.

V. THE SETTLED EXPECTATIONS DOCTRINE DOES NOT WARRANT SHIELDING THE '191 PATENT FROM REVIEW

The Challenged Claims issued on September 1, 2009. However, in June 2024, the Patent Owner asserted that the Challenged Claims were invalid when Patent Owner requested *Ex Parte* Reexamination of the '191 Patent. Because all independent claims of the '191 Patent were found to be invalid during reexamination and Patent Owner admitted that the remaining dependent claims do not recite patentable features, the Patent Owner could not have settled expectations that the Challenged Claims were not invalid.

In the Request for Reexamination filed June 19, 2024 ("Request"), the Patent Owner stated:

In particular, pursuant to 37 U.S.C. § 1.510(b)(1), Patent Owner/Assignee submits the following statement pointing out the substantial new questions of patentability ("SNQP"):

- SNQP 1: Claims 1-7 and 19-20 are obvious over *Von Bauer* in combination with *Menard*.
- SNQP 2: Claims 8-18 are obvious over *Von Bauer* in combination with *Menard* and *Klein*.

EX-1005, 2.

In its Request, Patent Owner explained that the challenged dependent claims “depend directly or indirectly” from the independent base claims and “inherit all features and limitations” of the base claims and are therefore “invalid for the same reasons” as the base claims³. EX-1005, 345-47. This is an admission that the dependent claims do not recite any patentable features. This demonstrates that Patent Owner **did not** have settled expectations as of June 2024 that the dependent claims were patentable. EX-1005, 345-47.

During reexamination, Patent Owner cancelled the independent claims that were rejected by the examiner as invalid over the prior art. In support of its Request, Patent Owner identified portions of the Von Bauer reference that discloses the limitations recited in the independent claims. These same citations also disclosed the limitations recited in the Challenged Claims of the present IPR. The table below identifies the Challenged Claims and maps them to the citations to Von Bauer that Patent Owner submitted in its Request:

³ But for the defect in the Patent Owner’s Request, the original dependent claims would have likewise been found unpatentable during the Reexamination.

Challenged Claim in this IPR	Patent Owner's citations to Von Bauer in the Request
5. The system as recited in claim 1, wherein the at least one portion of the entry point visual and audio communications comprises data selected from the group consisting of audio data, at least one image and audio data, and streaming visual and audio data.	Circuitry included in the sensing station responds to actuation of the doorbell button, or triggering of an optional infrared sensor by the presence of a person near the sensor, to send via radio waves an annunciator signal to a monitoring station within the building. Both visual images of, and voice transmissions from, the visitor may be sent via the RF link. An RF transceiver within the sensing station also permits voice communications to be sent from a person at the monitoring station and outputted from a loudspeaker in the sensing station, permitting two-way voice conversations between the visitor and monitor viewer. EX-1002 148-149 (citing Von Bauer 5:6-18)
7. The system as recited in claim 1, wherein the connection between the control unit and cellular telephone comprises a network connection over a cellular network.	Another object of the invention is to provide a video doorbell system including a hand-held portable device for communicating by voice with a remote location and for controlling operation of a video monitoring system. EX-1002 150 (citing Von Bauer 4:24-27) Another object of the invention is to provide a video doorbell system including a telephone interface unit providing a capability for two-way voice communication between the telephone handset and a remote micro phone and loudspeaker installation, and for controlling operation of the system.

	EX-1002 150 (citing Von Bauer 4:28-34) Circuitry included in the sensing station responds to actuation of the doorbell button, or triggering of an optional infrared sensor by the presence of a person near the sensor, to send via radio waves an annunciator signal to a monitoring station within the building. Both visual images of, and voice transmissions from, the visitor may be sent via the RF link. An RF transceiver within the sensing station also permits voice communications to be sent from a person at the monitoring station and outputted from a loudspeaker in the sensing station, permitting two-way voice conversations between the visitor and monitor viewer. EX-1002 148-149 (citing Von Bauer 5:6-18)
15. The system as recited in claim 14, wherein the means for relaying at least a portion of the captured visual and audio communications and means for relaying the audio communications for the cellular phone operate substantially simultaneously.	Another object of the invention is to provide a video doorbell system including a telephone interface unit providing a capability for two-way voice communication between the telephone handset and a remote microphone and loudspeaker installation, and for controlling operation of the system. EX-1002 150 (citing Von Bauer 4:28-34) Circuitry included in the sensing station responds to actuation of the doorbell button, or triggering of an optional infrared sensor by the presence of a person near the sensor, to send via radio waves an annunciator

	signal to a monitoring station within the building. Both visual images of, and voice transmissions from, the visitor may be sent via the RF link. An RF transceiver within the sensing station also permits voice communications to be sent from a person at the monitoring station and outputted from a loudspeaker in the sensing station, permitting two-way voice conversations between the visitor and monitor viewer. EX-1002 148-149 (citing Von Bauer 5:6-18)
18. The system as recited in claim 14, further comprising means for forwarding the captured visual and audio communications to a video monitor located onsite to the entry point.	Circuitry included in the sensing station responds to actuation of the doorbell button, or triggering of an optional infrared sensor by the presence of a person near the sensor, to send via radio waves an annunciator signal to a monitoring station within the building. Both visual images of, and voice transmissions from, the visitor may be sent via the RF link. An RF transceiver within the sensing station also permits voice communications to be sent from a person at the monitoring station and outputted from a loudspeaker in the sensing station, permitting two-way voice conversations between the visitor and monitor viewer. EX-1002 148-149 (citing Von Bauer 5:6-18)

Thus, it appears that the basis for Patent Owner's assertion that the dependent claims were "invalid for the same reasons" as the base claims was because the same citations to Von Bauer that Patent Owner identified as

invalidating the independent claims also invalidated the dependent claims. In view of this knowledge, the Patent Owner could not have any settled expectations that the Challenged Claims are patentable since June 2024.

Tellingly, Patent Owner also does not make any §325(d) arguments, effectively conceding that the Petition's grounds present an important challenge never considered by the Office. Thus, as a threshold matter, IPR2026-00375 is particularly important here because the Office's original prosecution and reexamination failed to uncover or consider the art and grounds of this Petition, which are neither cumulative nor redundant to the examination upon which the patent rests for its validity. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, p. 8 (Feb. 13, 2020).

VI. THE *FINTIV* FACTORS WARRANT INSTITUTION

As explained above, instituting this IPR to correct the Examiner's material error "serves the interest of overall system efficiency and integrity." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 15 (PTAB Mar. 20, 2020) (precedential). Additionally, Patent Owner should not be rewarded for its gamesmanship in belatedly asserting claims that it knows to be invalid in order to increase its chances of receiving a discretionary denial. Further, Petitioner's broad stipulation "reduces the concern of inconsistent outcomes or significant duplication of efforts" and thus counsels against discretionary denial." *Tesla, Inc. v Bulletproof Property*

Management, LLC, IPR2026-00204, Paper 14 at 3 (PTAB June 15, 2026)(informative). The *Fintiv* factors warrant consideration of the merits and institution because, as explained below, they either favor institution or are neutral.

A. Factor 1: Likelihood of a Stay

No party has requested a stay, and the district court has not indicated whether a stay would be granted. Therefore, this factor is neutral. *See Hulu, LLC v. SITO Mobile, Ltd.*, IPR2021-00298, Paper 11, 10-11 (PTAB May 19, 2021).

B. Factor 2: Timing of Trials and Factor 3: Investment in Parallel Proceedings

As described above, Patent Owner delayed asserting the Challenged Claims until Petitioner had filed the previous petition in IPR2026-00300. Thus, although the trial has tentatively been scheduled six months before a Final Written Decision, Patent Owner should not be able to benefit from such delay and thus these factors should be neutral.

C. Factor 4: Overlap of Issues

Factor 4 favors institution. In view of Petitioner's *Sotera Plus* stipulation (*see* §II), there will be no overlap between the issues raised in the Petition and issues to be adjudicated in the Litigation.

D. Factor 5: Overlap of Parties

Factor 5 is neutral. The Board has long recognized that it is commonplace for petitioners to be defendants and does **not** weigh in favor of denial. *See, e.g., HP Inc.*

v. Slingshot Printing LLC, IPR2020- 01084, Paper 13 at 9 (Jan. 14, 2021).

E. Factor 6: The Petition’s Merits, and Demonstration of Apparent Examiner Error, Strongly Favor Institution

As explained above, §III, the evidence of invalidity in the Petition is overwhelming, presents prior art unlike any considered by the examiner when deciding to issue the Challenged Claims, and demonstrates apparent examiner error as being the reason that Schranz was not previously before the Office. In addition, Patent Owner’s previous assertion that the Challenged Claims were invalid supplies additional support that differentiates these Challenged Claims from the claims challenged in IPR2026-00300. The integrity of the patent system compels that the Director should not exercise discretion to prevent correcting this error in the original patent grant by considering the merits of the critical evidence of invalidity presented in the Petition. *Magnolia*, 6-8; *Fintiv*, 14-15.

VII. PETITIONER’S U.S. INVESTMENT IN THE DESIGN AND INSTALLATION OF THE ACCUSED SYSTEMS FAVORS INSTITUTION

As admitted in the Request, Petitioner’s accused product in the litigation is a system that is designed/installed and hosted in the United States provided through Petitioner’s U.S. investments and represents a substantial investment in U.S. jobs and infrastructure, including 10,000 jobs and hosted two data centers in the U.S. By contrast, the PO is an individual that provides zero investment in U.S. design/manufacturing/installation.

VIII. CONCLUSION

PO has identified no legitimate basis for the Director to deny institution on any discretionary factors. Institution should be granted.

Respectfully submitted,

Dated: September 9, 2026

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CERTIFICATION OF SERVICE ON PATENT OWNER

Pursuant to 37 C.F.R. §§ 42.6(e), 42.8(b)(4) and 42.105, the undersigned certifies that on the 9th of September, 2026, a complete and entire copy of this Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and supporting exhibit were served via email and/or electronic download by agreement of Patent Owner, to the Patent Owner's counsel of record in this manner.

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