

Filed: September 23, 2026

Filed on behalf of **Luxottica of America Inc. and Meta Platforms, Inc.**

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUXOTTICA OF AMERICA INC. AND META PLATFORMS, INC.,

Petitioners,

v.

SOLOS TECHNOLOGY LIMITED,

Patent Owner.

Case IPR2026-00376

U.S. Patent No. 12,216,339

**PETITIONERS' RESPONSE TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

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Patent Owner (“PO”) requests discretionary denial under § 314(a). The Director should deny PO’s request and refer this IPR for institution.

I. INTRODUCTION

The relevant considerations overwhelmingly favor referral and institution:

- The challenged claims issued less than seventeen months before the Petition was filed, leaving no settled expectations to protect.
- The challenged claims issued when PO failed to disclose Asukai to the Examiner, despite the Japanese Patent Office earlier rejecting counterpart claims over Asukai’s disclosure.
- PO cannot invoke portfolio-level expectations to shield a portfolio it prosecuted while repeatedly withholding known prior art from the Office.
- There is no schedule in the district court litigation, and based on the local rules, the FWD will issue before any trial.
- Petitioners’ coordinated challenges and broad stipulation mitigate any potential inefficiency or district-court overlap.

PO’s settled-expectations theory fails. The relevant inquiry is the length of time the challenged claims have been in force, not the age of different, unrelated patents or the order in which Petitioners challenged them. Petitioners filed this IPR promptly, within seventeen months of the claims issuing, and had no reason—much less an obligation—to withhold challenges until petitions could be filed against

every asserted patent simultaneously. And on the merits, PO's expert-gap-filling arguments lack merit: Asukai, Liu, and Lisy disclose the disputed joint-use teachings, and Dr. Feland explains those disclosures and supports alternative obviousness rationales as required.

This is a case in which the Office's own interests in accurate examination demand referral. PO asks the Director to preserve recently issued claims from review even though the Examiner never considered the Petition's references, including Asukai. But the Examiner should have had the benefit of Asukai during prosecution, especially given that the JPO applied Asukai's PCT counterpart to reject claims that nearly mirrored the claims at issue here. Despite the express rejection, PO never disclosed Asukai to the Examiner. The Petition detailed that material error, which PO disregarded in its discretionary-denial brief.

PO asks the Director to exercise discretion to protect claims that issued from an examination record PO itself rendered materially incomplete. Discretionary denial exists to protect settled expectations and prevent abuse of the IPR system, not to shield a patent from correction of errors that the patent owner caused.

This IPR should be referred for institution, and PO's request for discretionary denial should therefore be denied.

II. THIS IPR SHOULD BE REFERRED FOR INSTITUTION**A. There Are No Settled Expectations**

The challenged '339 patent issued on February 4, 2025, and the Petition was filed on June 18, 2026—less than seventeen months later. Ex.1002, 1-2; Pet., cover. “Early challenges” like this one “favor robust, predictable patent rights and weigh against discretionary denial.” *ResMed Corp. v. Cleveland Med. Devices, Inc.*, IPR2025-00246, Paper 10, at 2 (June 12, 2025). PO’s contrary theory asks the Director to measure expectations by the age of different, unrelated patents not challenged here. The Office’s guidance addresses the length of time “the claims” have been in force, not how long a related specification, application, or patent family has existed. Ex.2004, 2. That distinction follows fundamental patent law. Claims define the scope of the patentee’s right to exclude and provide the public notice of the boundaries of that right. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc); *Johnson & Johnston Assocs. v. R.E. Serv. Co.*, 285 F.3d 1046, 1052 (Fed. Cir. 2002) (en banc). Indeed, the Federal Circuit has explained that claims give notice “to the public at large, including potential competitors, after the patent has issued,” and that “the claims, not the specification, provide the measure of the patentee’s right to exclude.” *Johnson & Johnston*, 285 F.3d at 1052. The challenged claims—and the exclusionary rights they define—first came into force when the challenged patent issued. *See* 35 U.S.C. § 154(a)(2) (the patent grant has “a term

beginning on the date on which the patent issues”). Accordingly, any expectations attributable to the challenged patent are measured from the issuance of these claims, not from the age of materially different claims appearing elsewhere in Patent Owner’s portfolio.

PO identifies no authority allowing a newly issued patent to inherit settled expectations from older, unrelated patents merely because PO asserted them in the same complaint. Nor does PO identify any rule requiring a defendant faced with multiple asserted patents to file every IPR simultaneously or in descending order of patent age. PO’s sequencing theory would invert the settled-expectations doctrine: a patent owner could create “settled expectations” in newly issued claims simply by asserting them alongside older patents, while penalizing petitioners for promptly challenging the new claims. Nothing in the Director’s guidance supports that result.

The cases PO cites do not help. *Dabico* involved a patent that had been in force for almost eight years, not claims less than seventeen months old. *Dabico*, IPR2025-00408, Paper 21 at 2-3 (Director June 18, 2025) (informative). *Magnolia* involved a materially different “second bite at the apple” concern after an opportunity to litigate validity in district court. *Magnolia*, IPR2026-00097, Paper 17 at 9-10 (Director May 14, 2026) (precedential). Neither decision suggests that settled expectations for one patent can be borrowed from another, or that petition sequencing can transform recently issued claims into settled ones. Because the

challenged '339 patent claims are recent, and PO's sequencing theory is unsupported, settled expectations weigh strongly against discretionary denial.

B. PO's Repeated Withholding Defeats Its Portfolio-Level Settled-Expectations Theory

PO's settled-expectations theory fails for an additional, portfolio-level reason. PO asks the Director to consider Petitioners' IPRs as a coordinated campaign against the five patents PO asserted in the Litigation. DD Br., 1-5. PO cannot ask the Office to view Petitioners' challenges collectively while ignoring PO's own repeated material withholding during prosecution of that same asserted portfolio. *See* Ex.2004, 2 (permitting parties to address "all relevant considerations," including "[a]ny other considerations bearing on the Director's discretion"); *Magnolia*, IPR2026-00097, Paper 17 at 2-8 (discretionary institution serves fairness, efficiency, and predictability). The Director's framework permits evaluation of "[a]ny other considerations bearing on the Director's discretion." Ex.2004, 2. PO's repeated pattern of withholding material art from the U.S. Examiner is such a consideration. At least two asserted patents issued from U.S. prosecution records distorted by the same pattern: PO confronted material prior art in foreign prosecution, amended counterpart claims rather than overcome the art on the merits, pursued U.S. claims that were nearly identical to the rejected counterpart claims, and failed to disclose that art to the U.S. Examiner.

Regarding the '339 patent, the JPO rejected nearly identical counterpart claims based on Asukai's PCT counterpart; PO amended those claims to add narrowing limitations absent from the challenged U.S. claims; and then PO filed the U.S. application, without ever disclosing Asukai or its counterpart to the Examiner. Pet., 1, 5-7. PO's asserted '174 patent reflects the same conduct. While the U.S. application was pending, the JPO rejected counterpart claims over Matsunari and Ono; PO amended the Japanese claims rather than distinguish those references; and PO never disclosed them to the U.S. Examiner. IPR2026-00413, Paper 3 at 1, 7-11.

Settled expectations are not an equitable safe harbor for a patent owner that obtained and asserted claims after withholding material art. *See Microsoft Corp. v. Sandpiper CDN, LLC*, IPR2026-00180, Paper 15 at 3 (Director May 6, 2026). Nor should PO be allowed to invoke its five-patent assertion campaign to criticize Petitioners' filing sequence while insulating PO's portfolio-level withholding from scrutiny. The asserted portfolio is not a source of settled expectations; it is a reason to deny PO's request for discretionary protection. Where PO's assertion campaign includes multiple patents issued from examination records rendered incomplete by PO's withholding material prior art, fairness and Office integrity favor institution.

C. PO's Withholding of Asukai Caused Material Office Error

The '339 patent never should have issued, and institution is required to correct this material error. The error is straightforward: the Examiner allowed the

challenged claims without considering Asukai, even though PO was aware that Asukai discloses the same eyewear/external-sensor joint-use functionality that PO now treats as central to patentability. Pet., 18-25; DD Br., 9-15. That error occurred because PO withheld Asukai after the JPO had already applied Asukai's PCT counterpart to reject similar counterpart claims.

PO pursued Japanese counterpart claims directed to the same core eyewear-based assistance architecture later claimed in the '339 patent. Pet., 5. In June 2022, the JPO rejected those claims based on Asukai's PCT counterpart, explaining that claim 1 was disclosed in Asukai and could be made based on Asukai. *Id.*, 6; Ex.1013, 14-19. PO did not argue that the pending claims were patentable. Instead, PO amended the Japanese claims to add narrowing "risk level" limitations and argued that those limitations were not disclosed by Asukai's disclosure. Pet., 6; Ex.1013, 20-32.

PO then filed the U.S. application that issued as the '339 patent, but did not disclose Asukai to the U.S. Examiner. Pet., 6-7. The Examiner rejected most pending claims over other art, identified certain dependent-claim subject matter as allowable, and PO amended the independent claims to incorporate that subject matter. *Id.*, 7; Ex.1002, 119-143. Asukai and its counterparts were not before the Examiner. Pet., 7. Thus, the Examiner never had an opportunity to consider whether

Asukai's disclosure of combining eyewear-sensor data with external-sensor data rendered the allowed claims unpatentable.

That omission was material. This is not a case where the Examiner considered Asukai and reached a different conclusion. Nor is Asukai cumulative of the record considered during prosecution. The Examiner explained that claim 1 was allowable because the "prior art of record does not disclose or suggest a method comprising "... receiving second data from a second sensor, wherein the second sensor is an external sensor;... wherein the analyzing uses the first data and the second data; determining a context of the user, wherein determining uses the first data and the second data." Ex.1002, 34-35. As shown in the Petition, Asukai discloses those specific limitations. Pet., 16-25. Asukai therefore would have been material to the Examiner's patentability analysis. Further, the JPO had already applied Asukai's PCT counterpart to similar claims, and PO's response confirms that Asukai's disclosure is significant: PO narrowed the Japanese claims rather than defend them as patentable over Asukai. PO knew that Asukai's PCT counterpart had forced it to narrow the Japanese claims. Yet PO never disclosed Asukai or its counterpart to the U.S. Examiner, and obtained broader U.S. claims without those narrowing limitations.

Director decisions confirm that material Office error weighs strongly against discretionary denial. In *Xencor*, the Director recognized strong settled expectations

in a patent that had been in force for approximately nine years, but nonetheless declined discretionary denial because the petitioner showed that the Office materially erred by overlooking relevant prior-art teachings. *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12 at 2-3 (Director July 17, 2025). *Anthony* is even more instructive: there, the challenged patents had been in force for approximately eighteen and seventeen years, but the Director declined discretionary denial because the petitioner showed that the Examiner overlooked relevant prior-art teachings, making review “an appropriate use of Office resources.” *Anthony Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 9 at 2 (Director July 16, 2025).

This case is stronger than *Xencor* and *Anthony*. The ’339 patent had been in force for less than seventeen months when the Petition was filed, and the material prior art was absent from prosecution because PO withheld it after a foreign patent office had already applied it to similar claims. PO should not be permitted to rely on the issuance of claims from that materially incomplete record as a reason for the Office to decline review. The evidence of material Office error weighs strongly in favor of institution and against discretionary denial.

D. PO’s Requested Claim-Scope Waiver Is No Basis for Discretionary Denial

PO asks the Director to deny institution unless Petitioners prospectively stipulate that they will maintain in district court that no express claim construction is required and will forgo indefiniteness defenses. DD Br., 6-8. That request is not

grounded in any actual inconsistency. PO admits claim construction has not begun and that it does not yet know Petitioners' district-court positions. *Id.*, 7. There is therefore no inconsistent position for the Director to evaluate.

Nor does the Petition create one. Petitioners stated that no construction is required beyond the ordinary meaning informed by the intrinsic record, and then addressed two terms only to clarify how the descriptions apply to the prior art. Pet., 7-8. That position is directed to whether any construction is necessary to resolve the grounds. It is not a representation that no claim-scope issue could ever arise, and it is not a waiver of defenses unavailable in IPR.

PO's cited decisions do not support imposing such a waiver. *Revvo*, *Tesla*, and *Terumo* involved actual inconsistent claim-scope positions already taken across forums. *See Revvo*, IPR2025-00632, Paper 20 at 3-5 (Director Nov. 3, 2025) (precedential); *Tesla*, IPR2025-00340, Paper 18 at 2-4 (Director Nov. 5, 2025) (informative); *Terumo*, IPR2025-01374, Paper 20 at 3-5 (Director May 12, 2026) (informative). They do not require petitioners to preemptively surrender district-court positions not yet even asserted. Nor could the absence of an indefiniteness challenge in the Petition create an inconsistency: IPRs are limited to §§ 102 and 103 grounds based on patents and printed publications, and indefiniteness is not an available IPR ground. 35 U.S.C. § 311(b).

PO's requested rule would improperly convert a petitioner's routine statement that no express construction is necessary for IPR into a broad district-court waiver. The Director's discretionary-denial framework prevents gamesmanship based on real inconsistent positions; it does not require speculative policing of positions that may never be taken. Because no actual inconsistency exists, PO's requested claim-scope waiver has no basis for discretionary denial.

E. The Prior Art Discloses the Joint-Use Limitations; Dr. Feland Does Not Supply Them

PO argues that the Petition's prior art fails to disclose the limitations of the challenged claims and that the Petition relies on impermissible expert gap-filling. DD Br., 8-15. As an initial matter, PO's arguments are merits-based arguments that are more appropriate for its Patent Owner Preliminary Response, not discretionary denial. Nonetheless, PO's arguments mischaracterize the Petition and lack merit.

Petitioners' expert, Dr. Feland, does not supply the claimed joint use of data from an eyewear-incorporated sensor and an external sensor. Instead, the Petition identifies the express disclosures in Asukai and Liu, and maps the respective disclosures of relevant sensors, their locations, the connecting system architecture, and data used for the state analysis and/or context determination against the claims. Dr. Feland explains how a POSA would understand those disclosures and provides the analysis showing motivation to combine and reasonable expectation of success to support the obviousness analysis. Indeed, the very testimony that PO points to is

the type permitted by the July 31, 2025 Memorandum. Ex.2005, 1-2. The Office’s former FAQ Q22 likewise described “focused testimony” that “provide[s] helpful context” and “support[s] a motivation to combine” as appropriate expert testimony. FAQs for Interim Process for PTAB Workload Management, at Q22 (archived; superseded by Interim Director Discretionary Process webpage).

Dr. Feland’s “testimony is merely complying with regulations requiring disclosure of ‘underlying facts or data’” and is of the exact nature contemplated by the applicable rules. *GD Energy Products, LLC v. Kerr Machine Co.*, PGR2025-00031, Paper 11, at 2 (June 25, 2025) (citing 37 C.F.R. § 42.65(a)). This is confirmed by the July 31, 2025 Memorandum, which expressly permits expert testimony to demonstrate a POSA’s knowledge, explain how a POSA would understand a prior-art reference, and support motivations to combine. Ex.2005, 1-2; *see Unification Technologies LLC v. Micron Technology Inc.*, Nos. 2023-1348, -1351, -1352, 2024 WL 3738401, at *7 (Fed. Cir. Aug. 9, 2024) (nonprecedential).

PO relies on *iRhythm* and *Cambridge Industries* to support its position that Dr. Feland’s testimony is somehow improper. But PO’s reliance is misplaced. These cases merely stand for the principle that expert testimony cannot supply missing prior-art disclosure. *See iRhythm Technologies*, IPR2025-00363, Paper 10 at 2-3 (Director June 6, 2025); *Cambridge Industries*, IPR2025-00434, Paper 11 at 2 (Director June 26, 2025). But as explained below and set forth in detail in the

Petition, the references expressly disclose the claimed limitations. Dr. Feland's testimony demonstrates the knowledge of a POSA, explains how a POSA would understand a prior-art reference, supports motivations to combine, and explains the POSA's reasonable expectation of success. PO's arguments fail.

1. Asukai Itself Discloses the Claimed Joint Use

PO attempts to manufacture a gap by isolating Asukai's architecture from its examples and insisting that each example repeat every architectural detail. That is not how Asukai is written, nor how the Petition maps it. The Petition reads Asukai as a whole, identifying the disclosed eyewear device, sensor locations, communications architecture, recognition units, and examples showing how sensor data is used for state analysis and context determination. A reference "must be considered for all it teaches." *Neurent Med. Inc. v. Aerin Med. Inc.*, IPR2024-00277, Paper 41 at 32–33 (P.T.A.B. July 11, 2025).

Asukai first discloses the required sensor sources. Information processing device 10 may be implemented as a spectacle-type head-mounted display ("HMD"), and the device includes sensor unit 122, which senses data for recognizing a user situation or action. Pet., 11-17. Sensor unit 122 includes cameras, microphones, acceleration sensors, gyro sensors, location-information acquisition units, biological sensors, gaze sensors, and environmental sensors. *Id.* Asukai teaches that those sensors may be provided in the information processing device, in a connected

external wearable device or smartphone, or in both. *Id.* Thus, Asukai, not Dr. Feland, discloses the eyewear-incorporated sensor and external sensor.

Asukai also discloses using those sources for state analysis and context determination. The Petition explains that Asukai's recognition pipeline uses sensor data to recognize situation and action, may use nearby external-sensor data "in addition to" sensor-unit data, and identifies emotion from the recognized situation/action. *Id.*, 18-22. Because the '339 patent identifies emotional condition as a user "state" and environment, activity, and physical orientation as "context" (*id.*, 8), that pipeline maps to both disputed operations. Under Asukai's source architecture, HMD sensor data and connected external-sensor data feed the same situation/action-recognition and emotion-identification process. *Id.*, 18-22. Dr. Feland explains that disclosed data flow; he does not create it.

The examples confirm this reading without repeating sensor placement. In the commuting example, Asukai recognizes commuting from location information and walking with downward-facing head orientation from acceleration information, then identifies negative emotion from that situation/action pair; the Petition maps acceleration data to first data from the eyewear-incorporated sensor and location information to second data from the external sensor. *Id.*, 19-20, 23. In the parenting example, Asukai uses same-episode inputs for state and context: room-camera data to recognize room condition, microphone data to recognize scolding, and camera,

smart-band, and/or microphone data to identify the parent's negative emotion, including voice from a room or parent-worn HMD microphone. *Id.*, 20-21, 24-25.

The Petition's "to the extent" analyses are not concessions. They address PO's anticipated objection that each example must restate sensor locations and joint processing already disclosed elsewhere. *Id.*, 14, 19, 22. Even under that view, using Asukai's HMD and external sensors together in its pipeline would have been obvious. *Id.* That alternative theory is grounded in Asukai's sensors, architecture, and recognition process, not expert testimony used to create a missing limitation.

2. Liu's Eyewear/Terminal Architecture Discloses the Joint Use

PO's Liu argument repeats the same flawed argument it makes for Asukai: it dissects Liu into isolated sensor lists and processing statements while ignoring the integrated sports-management system mapped in the Petition. Liu is not a collection of unrelated devices. It describes smart eyewear 110 and terminal 130 operating together in a single integrated system. The eyewear includes biosensors, positioning/movement sensors, imaging sensors, locating functionality, and processing capability, while the terminal includes additional biosensors, high-resolution cameras, GPS/navigation functionality, and processing capability. Pet. 44, 46-50. Terminal 130 communicates with the eyewear, transmits sensor information and exercise advice to it, forms a "binding relationship" with it, and extends the eyewear's functions by sharing the burden of collecting, storing, and

processing data. *Id.*, 49-51. Liu’s expressly disclosed relationship supplies the architecture for jointly using eyewear and terminal data.

Liu discloses that joint use for state analysis and context determination. Liu evaluates physiological condition and exercise status, determines whether an emergency has occurred based on physiological conditions, movement, position, and/or environmental images, and determines movement, activity, orientation, position/location, and surrounding environment. *Id.*, 50-54. Those determinations map to user state and context under the ’339 patent’s descriptions. *Id.*, 8, 50-54. And Liu does not process those categories in disconnected silos: the same eyewear/terminal architecture provides the data, exchanges it through the binding relationship, and shares collection, storage, and processing. *Id.*, 49-54. Liu further teaches using “multiple sensors and devices” for a “comprehensive evaluation” of exercise status. *Id.*, 50-52. Thus, Liu discloses analyzing state and determining context using eyewear and terminal data together. Dr. Feland explains how a POSA would understand that data flow; he does not supply any missing limitation.

The Petition’s “[t]o the extent” paragraphs are not concessions. *Id.*, 51-52, 54-56. They provide alternative obviousness analyses to the extent PO demands a more explicit statement that eyewear- and terminal-derived data are used together in the same state analysis or context determination. *Id.* Those alternatives are grounded in Liu’s own eyewear/terminal coupling, data exchange, shared

collection/storage/processing, multiple-device evaluation, and complementary data categories for the same exercise event. *Id.* Dr. Feland explains the motivation and reasonable expectation of success for that obvious implementation, including improved accuracy, reliability, completeness, and reduced ambiguity. *Id.* That is permissible obviousness analysis, not expert gap filling.

Xerox is inapposite. There, the petition did not allege the reference expressly taught the disputed limitation, and the declarant repeated the petition's conclusion. *Xerox*, IPR2022-00624, Paper 9 at 14-16 (Director Aug. 24, 2022) (precedential). Here, the Petition identifies Liu's device relationship, sensor locations, communication and shared-processing architecture, data categories, and state/context analyses, then ties reasoning to them. Dr. Feland explains Liu and supports obviousness; he does not supply the joint use.

3. Lisy Also Includes the Multi-Device Joint Use Teaching PO Says Is Missing

PO argues that the Petition's additional references do not cure the alleged gap-filling. DD Br., 15-19. PO contends that Lisy discloses only a "general" fusion concept and lacks the claimed, multi-device joint use in the mapped state/context operations, but Grounds 5-8 show those exact teachings in Lisy. Pet., 75-79.

Lisy discloses head-mounted systems, including eyewear, that collect physiological and environmental information and pair with other user-worn systems such as a smartwatch or phone. *Id.*, 75-76. Lisy states that the system may "fuse[]"

data” from sensors on the various devices to provide a “more complete and robust set of data,” recommendations, alerts, and warnings. *Id.*, 76. Lisy also uses physiological and secondary/environmental sensor data to derive user-condition metrics. *Id.* Thus, Lisy itself, not Dr. Feland, supplies the express teaching of jointly processing data from head-mounted and external sensors.

PO argues that Lisy’s fusion teaching is too “general” because Lisy does not identify the exact Asukai or Liu sensor pairings. DD Br., 18-19. But Lisy need not independently disclose every limitation or recite those precise pairings. Lisy identifies the fusion relationship; Asukai and Liu identify the relevant sensors, source locations, architectures, and state/context operations. Dr. Feland explains why a POSA would apply Lisy’s fusion technique to those sensor streams and why doing so would predictably enhance the existing analyses. Pet., 76-79; Ex.1003, ¶¶283-84, 287, 289-90. That is a conventional obviousness analysis, not expert testimony used to supply a missing limitation. Even accepting PO’s premise, Lisy supplies the multi-device sensor-fusion teaching PO says is missing.

F. Efficiency Considerations Favor Institution

Institution of this IPR would advance efficiency, fairness, and merits-based adjudication. No trial date has been set. *RØDE Microphones, LLC, et al. v. Zaxcom, Inc.*, IPR2025-00557, Paper 11, at 2 (July 17, 2025). The FWD will almost certainly issue before trial in the parallel litigation given that the local rules set trial

approximately two years after the Scheduling Conference, which has not even occurred. The District of Massachusetts has granted all six motions to stay pending IPR that have been considered since 2024. *Imperative Care, Inc. v. Inari Medical, Inc.*, IPR2025-00289, Paper 9, at 2 (June 12, 2025) (“evidence that the district court is likely to grant a stay” weighs against discretionary denial). And Petitioners have entered a broad stipulation. *Samsung Elec. Co. v. Wilus Institute of Standards and Tech. Inc.*, IPR2025-00933, Paper 11, at 3 (Oct. 10, 2025) (“Petitioner has filed a broad stipulation that reduces the concern of inconsistent outcomes or significant duplication of efforts.”).

PO’s efficiency argument fails because it ignores Petitioners’ challenges to PO’s asserted portfolio. PO argues that this IPR could remove “at most” one patent from the Litigation. DD Br., 19. But Petitioners already filed IPR petitions challenging three of the five asserted patents and intend to challenge the remaining two. *See* Pet.; IPR2026-00412, Paper 4; IPR2026-00413, Paper 3; IPR2026-00420, Paper 1. If instituted, those proceedings could eliminate or materially narrow issues and strongly support a stay, particularly because the district court case remains at an early stage with no schedule. PO cannot assume denial of the other petitions and then use that assumption to manufacture inefficiency here. DD Br., 7 n.1, 19.

Regardless, the Petition’s broad stipulation mitigates potential overlap. Petitioners have stipulated that, if review is instituted, they will not pursue in the

Litigation any ground raised or reasonably available here, or any §§ 102 or 103 ground relying on a reference asserted in Grounds 1-8, whether alone or with system art or other prior art unavailable in IPR. Pet., 80. That stipulation is broader than a standard *Sotera* stipulation and would substantially narrow the district-court invalidity case. *Amazon* and *Samsung* are therefore inapposite. DD Br., 19-20. PO cannot rely on decisions involving litigation that necessarily proceed based on other asserted patents while ignoring Petitioners' other petitions and broad stipulation.

PO also overstates the burden on the Board. The Petition challenges sixteen claims through overlapping grounds organized around two primary references—Asukai and Liu. Pet., 9. Shan addresses a discrete voice-interface limitation, while Lisy discloses an additional sensor-fusion teaching. The grounds share common mappings and issues; they are not unrelated proceedings packaged into one petition.

Chevron Oronite does not support denial. There, the petitioner showed a likelihood of success for only two of twenty challenged claims. *Chevron Oronite*, IPR2018-00923, Paper 9 at 10-11 (Director Nov. 7, 2018) (informative). Here, the Petition presents developed challenges to every challenged claim, with overlapping grounds that can be efficiently resolved together. PO identifies no authority holding that sixteen claims, two primary references, and coordinated alternative grounds are an inefficient use of Board resources—especially where institution may simplify or resolve the parallel litigation. Efficiency therefore favors institution.

Respectfully submitted,

Dated: September 23, 2026 /Ali S. Razai/

Ali S. Razai (Reg. No. 60,771)

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CERTIFICATE OF SERVICE

I hereby certify that on the date below, a true and correct copy of **PETITIONERS' RESPONSE TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** is being served via email pursuant to 37 C.F.R. § 42.6(e), to counsel for Patent Owner as addressed below:

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