UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OPTIVER US LLC and OPTIVER TRADING US LLC,
Petitioner,

v.

HFT SOLUTIONS, LLC,
Patent Owner.

Case IPR2026-00385
U.S. Patent No. 11,018,678

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

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PATENT OWNER'S EXHIBIT LIST (NONE FILED)

Exhibit No.	Description
Ex. 2001	*HFT Solutions, LLC, v. Optiver US LLC et al*, Case No. 7:25-cv-00415, Dkt. 1 (Sept. 8, 2025, W.D. Tex)
Ex. 2002	Optiver reports strong financial results for 2024, available at https://www.optiver.com/insights/news/optiver-reports-strong-financial-results-for-2024/

I. INTRODUCTION

This IPR will not act as an alternative to district court litigation. No one has ever accused Optiver of infringing the ’678 patent. Patent Owner has not asserted it against Optiver, has not threatened to assert it, and has asserted no claim of the patent against anyone. The ’678 patent has sat quietly on the public record since May 25, 2021. Nothing about it is in dispute anywhere nor could Optiver even file a declaratory judgment action for this IPR to be an alternative.

Optiver nevertheless asks the Office to spend a year of its resources reviewing it, along with four sister patents that are equally unasserted, in five petitions filed the same day. The three patents Patent Owner actually did assert against Optiver, in a district court case now pending in the Western District of Texas, are not among them. Optiver has left those alone, having seen Citadel’s failed attempts as to two.

Institution would therefore relieve no court of anything. It would resolve no live controversy, avoid no trial, and eliminate no duplicative invalidity dispute. Whatever else may justify committing the Office's limited resources to a patent that has been in force for nearly six years, Optiver has offered nothing.

The Petition is also weak in a way that bears directly on the Director's discretion. Its expert declarant does not merely explain what a skilled artisan knew. He supplies disclosure the references do not contain, opining that a 2011 journal article "inherently discloses" the contents of a separate 2009 user guide, and then

carrying entire grounds on that opinion. Where the case for unpatentability rests on the declarant rather than on the prior art, review is not a sound use of Office resources.

Institution should be denied.

II. THE DIRECTOR'S CONSIDERATIONS WEIGH IN FAVOR OF DISCRETIONARY DENIAL

A. Without Even The Possibility For A District Court Action, Optiver Can Offer No Reason To Not Exercise Discretion

As the Director explains, "[t]he purpose of AIA reviews was, and is, to provide a quick and cost-effective *alternative* to district court patent litigation for resolving disputes over patent validity." *Magnolia Med. Tehc., Inc. v Kurin, Inc.*, IPR2026-00097, Paper 17 at 1 (PTAB May 14, 2026). But here, there is not district court patent litigation and no dispute for which this IPR may be an alternative.

While HFT has asserted three patents against Optiver (specifically Optiver US LLC and Optiver Trading US LLC), they are from entirely different families and cover materially different technology. Ex. 2001. Nor has HFT threatened Optiver with any other patent, much less the ones Optiver selected for its IPRs. As such not only is there no district court patent litigation for this IPR to be an alternative to, there is no possibility for Optiver to file a declaratory judgment action to which this IPR could be an alternative.

The Director has denied institution where a petitioner failed to explain why Office resources should be committed to the patent it challenged. In *Dabico Airport Solutions Inc. v. AXA Power ApS*, the challenged patent had been in force almost eight years, and the Director denied because "Petitioner does not provide any persuasive reasoning why an inter partes review is an appropriate use of Office resources." IPR2025-00408, Paper 21 at 3 (PTAB June 18, 2025). The Director acknowledged there may be persuasive reasons to review a challenged patent, but concluded that, absent such information, the Office was disinclined to disturb the patent owner's settled expectations. *Dabico*, IPR2025-00408, Paper 21 at 3. The Director applied the same rule a month later in *Analog Devices, Inc. v. Number 14 B.V.*, denying institution where the patents had been in force more than thirteen years and the petitioner again supplied no persuasive reasoning on the appropriateness of the expenditure. IPR2025-00550, Paper 10 at 2 (PTAB July 16, 2025) (citing *Dabico*, Paper 21 at 2–3). The case at hand is so much more problematic.

The showing absent in *Dabico* and *Analog Devices* is only more absent here, and conspicuously so. The petitioners in those cases were at least defending themselves against the patents they challenged. Optiver is not. It has never been sued on the '678 patent, never been charged with infringing it, and never received a demand concerning it. The Petition identifies no product of Optiver's that the '678 patent reads on, no licensing demand, no notice letter, and no controversy of any

kind. It offers no reason why this patent, of the many thousands issued in 2021, warrants the Office's attention now.

What the Petition does offer is a footnote disclosing that Optiver is defending a district court case brought by Patent Owner on three *different* patents in a *different* family. Pet. b n.1. Optiver does not explain, because it cannot, how canceling claims of a patent that is not in that case would advance its defense of that case. The connection Optiver draws is that the patents share an inventor. A common inventor is not a reason to commit Office resources to an unasserted patent.

This IPR, as well as its four sister petitions, cannot satisfy even the most fundamental goal of an IPR, being an alternative to district court litigation because no such litigation exists. Without even this most humble reason for the Director to not exercise its discretion in denying institution, denial is the only proper action.

B. The Petition Depends On Its Declarant To Supply Disclosure The Prior Art Does Not Contain

The extent of a petition's reliance on expert testimony is an enumerated discretionary consideration. It matters most when the expert is not explaining what a skilled artisan knew but is instead supplying what the references lack. The Director drew exactly that line in *iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, rejecting an over-reliance argument because the patent owner there "does not identify any portions of the expert testimony that suggest Petitioner is using its expert to fill gaps in the prior art," and finding instead that the petitioner "appears to rely on its expert

to explain the background knowledge of a person of ordinary skill in the art." IPR2025-00363, Paper 10 at 2 (PTAB June 6, 2025). Patent Owner identifies those portions here.

Grounds 1 and 2 rest on the declarant's opinion that one reference "inherently discloses" the contents of a different document. Giordano (Ex. 1005) is a 2011 article in IEEE Transactions on Nuclear Science. Virtex-UG (Ex. 1009) is a separate Xilinx user guide published in 2009. The only textual link between them is Giordano's statement that the procedure it followed for activating the alignment circuit was the one suggested in the GTP user's guide. Ex. 1005, 197. From that single sentence, Dr. Schaefer concludes that "[a] POSITA would have known to reference Xilinx documents on the GTP transceiver to understand the relevant inherent features," and that "Giordano inherently discloses the features of Virtex-UG." Ex. 1003 ¶ 113; *accord id.* ¶ 77.

That is not an inherency analysis. Dr. Schaefer states the governing standard correctly earlier in his declaration, acknowledging that an inherent disclosure is one "necessarily present or implied." Ex. 1003 ¶ 30. At ¶ 113 he applies a different test, asking not what Giordano necessarily contains but what a skilled artisan would have known to look up. A reference does not disclose, inherently or otherwise, the contents of every document a reader might consult after reading it. Nor does

Giordano's passing statement that it followed a procedure suggested in a user guide incorporate that guide's substantive disclosures by reference.

The declarant himself does not stand behind the opinion. At ¶ 247 he writes that "[w]hile Giordano already inherently discloses and incorporates Virtex-UG, if necessary," a skilled artisan would have been motivated to look to Virtex-UG and combine it. Ex. 1003 ¶ 247. The conditional concedes the point.

The dependency is not incidental. Dr. Schaefer supports grounds 1 and 2 with the identical formulation, that Virtex-UG "which Giordano inherently discloses and incorporates by reference" discloses the claim. Ex. 1003 ¶¶ 146, 196. The Petition makes the same move on its own face, asserting in a footnote that "Giordano inherently discloses the features of Virtex-UG, and further incorporates Virtex-UG by reference," and citing for that proposition not Giordano but the declaration. Pet. 3 n.4 (citing Ex. 1003 ¶¶ 77, 113). Petitioners' authority for what their primary reference discloses is their own expert.

The pattern extends to the claim mapping. The Petition cites the Schaefer declaration 199 times. It cites Giordano, Lee, Virtex-UG, and Raymond 153 times combined. Patent Owner does not repeat its merits arguments here and reserves them for its Preliminary Response, where the sufficiency of Petitioners' showing under each ground will be addressed. *See* 37 C.F.R. § 42.6(a)(3); Interim Director Discretionary Process § II.C.i. The point for present purposes is discretionary. A

petition whose unpatentability case depends on its declarant to supply what the references do not contain is a poor candidate for the Office's resources.

C. The Structure Of Petitioners' Five-Petition Campaign Weighs In Favor Of Denial

The Director may consider whether it is fair to permit a petition to proceed when deciding whether to exercise discretion under § 314(a), and fairness considerations alone have supported denial. In *Realtek Semiconductor Corp. v. ParkerVision, Inc.*, the Director denied institution because "ParkerVision's fairness arguments are persuasive," resting the denial on the equities of the petitioner's litigation conduct. IPR2025-00324, Paper 11 at 2 (PTAB June 25, 2025). *Realtek* arose from a time-barred copycat petition and its § 315(b) analysis does not apply here. Its principle does: the Office weighs the fairness of what the petitioner has done.

What Optiver has done is file five petitions on a single day against five patents, none of which has been asserted against it, while leaving unchallenged the three patents that have been. The challenged patents are the '587, '865, '678, '069, and '655 patents, in IPR2026-00383 through IPR2026-00387. The asserted patents are the '286, '305, and '381 patents, in *HFT Solutions, LLC v. Optiver US LLC*, No. 7:25-cv-00415 (W.D. Tex. filed Sept. 8, 2025). The two sets do not overlap at all.

The asymmetry between the parties sharpens the point. Patent Owner is a small Delaware company operating out of New Canaan, Connecticut. Optiver's

ultimate parent, Optiver Holding B.V., reported revenue of approximately €3.5 billion and net income of approximately €1.4 billion for 2024. Ex. 2002. Optiver has committed five petitions and Gibson Dunn to patents it does not contend anyone has accused it of infringing. Requiring a patent owner to defend five inter partes reviews on unasserted patents, on the Office's schedule and at the Office's expense, in order to prosecute a district court case about three others, is not a fair use of the Office's processes.

The Petition's real-party-in-interest disclosure compounds the concern. Petitioners identify Optiver US LLC and Optiver Trading US LLC as the real parties-in-interest. In the same paragraph they disclose that Optiver Services US LLC is a corporate affiliate and services entity that supports both petitioners, and that Optiver Holding BV is the ultimate parent of all three. Pet. at v. Having volunteered those relationships, Petitioners name neither entity as a real party-in-interest and offer no explanation for the omission. The governing framework is *Corning Optical Communications RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) (precedential except § II.E.1). Optiver has the best knowledge of this critical analysis but treats it as optional. This only further emphasizes the lack of importance of the petitions and the fairness in discretionary denial.

D. The ’678 Patent Has Been In Force A Year Shy Of Six Years, And Petitioners Have Never Been Charged With Infringing It

The ’678 patent issued on May 25 , 2021. Ex. 1001. By the date this brief is due it will have been in force five years and two and a half months. The Director has explained that there is no bright-line rule for when expectations become settled, and that “the longer the patent has been in force, the more settled expectations should be.” He has analogized to the six-year limitation on recovery in 35 U.S.C. § 286. *Dabico*, IPR2025-00408, Paper 21 at 3.

Petitioners may respond that Patent Owner never asserted the ’678 patent against them, so no expectations could have settled as between these parties. *Dabico* forecloses that argument. The Director there explained that published applications and issued patents are publicly available to provide notice, and concluded that “actual notice of a patent or of possible infringement is not necessary to create settled expectations.” *Id.* Settled expectations arise from the passage of time after public issuance, not from an assertion.

Although the Director declined to find strong settled expectations in *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, observing that most of the patents there “have not been in force for a significant period of time (issued in 2020, 2019, and 2019),” that decision issued on June 26, 2025, when a patent issued in 2020 had been in force under five years. IPR2025-00433, Paper 11 at 2 (PTAB June 26, 2025). The ’678 patent stands at nearly six, at the threshold the Director drew from § 286 in *Dabico*. Patent Owner does not contend that this

consideration alone would carry the day, and it is not the strongest ground for denial presented here. It adds weight to a record that already favors denial.

IV. THE BALANCE OF EVIDENCE FAVORS DENIAL

The Director's determination rests on a holistic assessment of all the evidence and arguments presented. Taken together, the circumstances here present an unusually clean case for denial.

There is no parallel proceeding, so institution would spare no court any labor and would resolve no pending dispute. There is no controversy at all concerning the ’865 patent, because Petitioners have never been accused of infringing it. Petitioners offer no reason why review of this patent is an appropriate use of the Office's resources, which is the showing whose absence drove the denials in *Dabico* and *Analog Devices*. The Petition's unpatentability case depends on a declarant who supplies disclosure the references do not contain, importing a 2009 user guide into a 2011 article by opinion and carrying entire grounds on that import. The Petition is one of five filed the same day against unasserted patents while the asserted patents go unchallenged. And the ’678 patent has been in force nearly six years.

Institution would commit the Office's resources to a patent no one is fighting over, on a Petition that leans on its expert to supply what its references omit, for a petitioner that has not explained why any of this is worth the Office's time. Institution should be denied.

V. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion under 35 U.S.C. § 314(a) to deny institution of *inter partes* review of the ’678 patent.

Date: August 10, 2026

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on August 10, 2026, by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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