

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BEATBOT TECHNOLOGY (USA) CO. LTD.,

Petitioner,

v.

ZODIAC POOL SYSTEMS LLC,

Patent Owner.

Case No. IPR2026-00395

U.S. Patent No. 11,003,191 B2

**PETITIONER'S RESPONSE TO PATENT OWNER'S BRIEF
REQUESTING THAT INSTITUTION OF THE PETITION
BE DENIED ON DISCRETIONARY GROUNDS**

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I. INTRODUCTION

Patent Owner's request for discretionary denial does not warrant a different result. Its *General Plastic* arguments reprise its Joinder Opposition and rest on *Apple v. Uniloc*, which addressed a first petition denied on the merits; here, the May 19, 2026 Notice denied Beatbot's earlier petition on "discretionary and non-merits considerations," days after the Director instituted IPR2026-00158. The Director has separately found that the Office materially erred during prosecution. The March 11 Memo factors favor institution, Patent Owner does not address *Fintiv*, and, upon institution, Beatbot's *Sotera-Plus* stipulation (Paper 9) eliminates any duplicative adjudication of the instituted grounds in the district court.

Beatbot's Petition is a verbatim copy of the petition the Director instituted in IPR2026-00158, challenging the same claims 1–3 of the '191 patent on the same grounds, the same prior art, and the same expert analysis. Beatbot seeks only to join that instituted proceeding as a silent understudy—adding no new grounds, no new evidence, and no incremental burden on the Board or Patent Owner.

The Director should decline to exercise discretion to deny institution, institute *inter partes* review of claims 1–3, and grant the pending Motion for Joinder to IPR2026-00158.

II. THE GENERAL PLASTIC FACTORS DO NOT SUPPORT DENIAL

A. Patent Owner's Brief Reprises Its Joinder Opposition

The *General Plastic* sections of Patent Owner's Request (Paper 10) are near-verbatim reproductions of its Joinder Opposition (Paper 7, filed July 6, 2026). Joinder briefing closed with Beatbot's August 6, 2026 reply (Paper 8). The Director thus has the benefit of a full round of briefing on every argument Zodiac now reprises, and Beatbot incorporates by reference the arguments set forth in its motion for joinder and joinder reply (Papers 3 and 8, respectively).

B. The Director Denied IPR2026-00202 on Discretionary, Non-Merits Grounds, and *Uniloc* Is Therefore Inapposite

The Director denied Beatbot's prior IPR "after review of discretionary and non-merits considerations," without evaluating the § 314(a) merits. IPR2026-00202, Paper 10 at 2–3. This fact pattern maps onto *Intel Corp. v. VLSI Tech. LLC*, IPR2022-00366, Paper 14 (PTAB June 8, 2022) ("*Intel*"). There, the Board distinguished *Uniloc* because the earlier petitions "were denied in light of a potential overlap with district-court litigation The Board did not consider the substantive merits," whereas in *Uniloc* "the evidence and arguments presented failed to meet substantively the reasonable likelihood threshold required for institution." *Id.* at 8–9. The Board found *Intel* "presents a situation notably different from *Uniloc*." *Id.*; *see also Code200, UAB v. Bright Data Ltd.*, IPR2022-00862, Paper 19 (PTAB Oct. 19, 2022) (reaching the same conclusion where the first denial was discretionary).

Patent Owner contends in a footnote that *Intel* has been countermanded by *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020)

(“*Uniloc*”). Request for Discretionary Denial (Paper 10) at 8 n.3. Not so. No countermanding is needed because *Uniloc*'s holding is confined to a merits-based first denial. *Intel* and *Code200* apply *Uniloc* to a different fact pattern—where the first denial was discretionary, not substantive. *Uniloc*'s reasoning about serial attacks presupposes that the first petition failed on the merits; where the first petition was denied on non-merits grounds, the concern about successive substantive attacks on the same claims simply does not arise.

C. Factors 1–3: The Petition Presents No Roadmapping

General Plastic factors 1 through 3 address the roadmapping concern—whether a petitioner used a patent owner's arguments or the Board's feedback to refine a successive challenge. *Intel* at 11. In *Intel*, the Board found that factors 1 through 3 target “roadmapping,” which was absent because “Intel's Petition makes no changes from the instituted [lead] petition.” *Id.* at 10.

The same is true here. Beatbot replicated Wybotics's instituted petition in its entirety and asked only to join the existing proceeding as an understudy. Nothing in Beatbot's Petition could have been shaped by anything Zodiac filed afterward. There is no new claim construction, no new expert theory, and no new prior-art combination.

This is an independent alternative ground that does not depend on how IPR2026-00202 was denied. Even if the Director were to conclude that the denial

of IPR2026-00202 weighs against Beatbot under some formulation of *General Plastic*, that conclusion would not support an inference of roadmapping where the present Petition is a verbatim copy of a petition filed months before Zodiac submitted any responsive briefing.

Patent Owner's Factor 2 inference rests on Beatbot's Mandatory Notices identifying the Wybotics IPR as a "Related Matter." Yet Patent Owner itself has acknowledged in the parallel proceedings (IPR2026-00393 and IPR2026-00394) that those Mandatory Notices misidentified the corresponding Wybotics proceeding, which limits the inferential weight such a cross-reference can bear as to knowledge of the specific prior art applied.

D. Factors 4–5: No Shifting Prior Art, and the Filing Was Diligent

No shifting of prior art. Beatbot's first petition (IPR2026-00202) relied on entirely different art and different combinations—Durvasula, Cui, Knoll, Renaud, and Fu-007. The present Petition relies on the same art as the Wybotics petition. There has been no shifting whatsoever.

The filing was diligent. Institution issued on May 15, 2026. Beatbot filed the present Petition and Motion for Joinder on June 5, 2026—twenty-one days later—well within the one-month window prescribed by 37 C.F.R. § 42.122(b).

Patent Owner contends that Beatbot should have filed a joinder petition earlier, rather than pursuing its own independent petition in IPR2026-00202. But when

Beatbot filed IPR2026-00202 on January 26, 2026, there was no instituted proceeding to join. The referral to the Director in Wybotics's IPR did not issue until April 14, 2026; the Director's decision on discretionary denial did not issue until May 6, 2026; and institution was not granted until May 15, 2026. Patent Owner's contention that Beatbot should have copied the Wybotics petition earlier—because Wybotics made a “persuasive” error showing—asks Beatbot to have anticipated determinations issued months later.

In *Intel*, the Board found that factors 4 and 5 “have limited relevance” where the joinder petition “raises no new challenges.” *Intel* at 11. That observation applies with full force here: the present Petition is identical to the instituted petition and raises no new challenges of any kind.

E. Factor 6: The Settlement Rationale Was Squarely Rejected in Intel

Patent Owner argues that joinder will reduce its incentive to settle with Wybotics. The *Intel* Board squarely addressed this argument:

That statement is true for all joinder authorized by § 315(c). We are not persuaded to weigh it in favor of exercising our discretion to deny joinder here.

Intel at 12. The Board will expend resources on the instituted grounds regardless of whether joinder is granted; Beatbot's participation as an understudy adds no new issues and no incremental burden.

F. Factor 7 Is Neutral

Patent Owner concedes that Factor 7 is neutral. Beatbot agrees, and there is nothing further to address on this factor.

III. THE DIRECTOR HAS ALREADY DETERMINED THAT THE OFFICE MATERIALLY ERRED

The Director has already found that the Office materially erred during prosecution of the challenged patent. In the May 6, 2026 Decision (IPR2026-00158, Paper 12), the Director determined that “[p]etitioner provides persuasive reasoning, supported by evidence, that the Office materially erred during prosecution and, accordingly, discretionary denial is not appropriate.” *Id.* at 4.

During prosecution, the examiner allowed the claims because the art of record did not teach the “controller” feature. The Director found that CN101139007 B (“Fu”), “listed on an information disclosure statement (‘IDS’) considered by the examiner, plainly discloses [the controller] feature.” Fu “was not applied in any rejection against the claims challenged in the above-captioned proceedings, nor otherwise distinguished or discussed.” *Id.*

The Director squarely rejected Patent Owner’s attempt to rehabilitate the prosecution history. Patent Owner “refers to arguments made in the prosecution of the parent application, but does not address differences in the challenged claims or why Fu does not disclose the subject matter found allowable in the prosecution of the challenged patent. . . . Accordingly, Patent Owner’s arguments are not persuasive.”

IV. DR. JANÉT'S DECLARATION INTRODUCES NO NEW EVIDENCE

Patent Owner argues that Beatbot's reliance on a different expert declarant—Dr. Janét—transforms the Petition into something more than a copy of the instituted petition. That is incorrect. The Board has granted joinder even where the joining petitioner relied on a different expert, so long as that expert's declaration was substantively identical to the lead petitioner's. In *Everlight Electronics Co. v. Document Security Systems, Inc.*, IPR2018-01225, Paper 14 (PTAB Sept. 27, 2018), the Board granted joinder where the joining petitioner “relie[d] on a different expert,” that expert “reviewed and agreed with the expert declaration supporting [the lead petitioner's] IPR” and the petitioner's “expert declaration [wa]s substantially identical.” The Board found that the joinder petition “does not present any ground or matter not already at issue in the [lead] IPR.” *See id.* at 10–11.

The same analysis applies here. Dr. Janét's declaration (EX1032) ¶ 23 states that he reviewed the Reinholtz declaration and “agree[s] with the facts, analysis, and conclusions in the Reinholtz declaration” and “adopt[s] the testimony in sections IV–XIV of the Reinholtz declaration . . . as [his] own for purposes of this proceeding.” Dr. Janét offers no new opinions. His declaration is the functional equivalent of the declaration the Board has already instituted on.

Patent Owner attacks EX1032 ¶¶ 20–22, which contain reservations of rights—to rebut Patent Owner's arguments, supplement the declaration, and use

exhibits. But those reservations are materially identical to Dr. Reinholtz's own EX1010 ¶¶ 20–22. Patent Owner's theory would equally condemn the declaration the Board instituted on. If the Reinholtz declaration was adequate for institution notwithstanding those reservations, the Janét declaration—which mirrors them verbatim—cannot be disqualifying.

Beatbot has proposed, and will abide by, the following understudy conditions: (a) all filings shall be consolidated with Wybotics unless they solely concern issues not involving Wybotics; (b) Beatbot will advance no new grounds beyond those instituted; (c) Beatbot will be bound by any discovery or deposition agreement between Patent Owner and Wybotics; and (d) Beatbot will receive no direct, cross-examination, or redirect time beyond that permitted for Wybotics alone. Beatbot assumes an active role only if Wybotics ceases to participate.

In addition, Beatbot will seek no separate cross-examination of Patent Owner's witnesses, including Patent Owner's declarant Dr. Hagen Schempf. Beatbot relies solely on Dr. Janét and will present him for deposition on the adopted opinions only if Wybotics ceases to participate. These commitments eliminate any incremental burden on Patent Owner or the Board.

V. THE MARCH 11 MEMO FACTORS FAVOR INSTITUTION

The March 11, 2026 Memorandum, "Additional Discretionary Institution Considerations" ("March 11 Memo"), outlines three factors the Director will

consider in exercising institution discretion: (1) the extent to which the accused products are manufactured in the United States; (2) the extent to which the patent owner's competing products are manufactured in the United States; and (3) whether the petitioner is a small business that has been sued for infringement.¹

The Memo's concern is the offensive use of IPRs by large multinational companies—"the most frequent users of IPR and PGR proceedings"—that lack any U.S. manufacturing stake. In applying these factors, the Director considers "all relevant facts that the parties raise, including the Small Business Administration's size standards set forth in 13 C.F.R. §§ 121.801 through 121.805 and 37 C.F.R. § 1.27(a)."

All three factors favor institution.

A. Factor 1: The Memo Targets Offensive Use by Large Multinationals

Beatbot filed its IPR petition defensively, after receiving a cease-and-desist letter from Patent Owner in July 2025. Motion for Joinder (Paper 3) at 2. The March 11 Memo targets "the most frequent users of IPR and PGR proceedings"—large multinationals that file offensively to challenge patents held by domestic competitors. Beatbot, a small business that received a cease-and-desist letter and filed a

¹See March 11, 2026 Memorandum, "Additional Discretionary Institution Considerations" ("March 11 Memo").

declaratory judgment action before filing any IPR petition, is the opposite of the Memo's target. Declaration of Xingdi Li ("Li Decl.") in IPR2026-00202 (EX2009), ¶ 4.

B. Factor 2: Patent Owner's Competing Products Are Not Manufactured in the United States

The Polaris Freedom SC Cordless Robotic Pool Cleaner—a representative Patent Owner competing product—is manufactured in Malaysia. Patent Owner still did not address this fact. *See* Paper 10 at 5–6. Patent Owner has not argued, much less demonstrated, that any of its competing products are manufactured in the United States.²

This factor accordingly favors institution. Where a patent owner's competing products are manufactured abroad, the Memo's concern about protecting domestic manufacturing is not implicated.

C. Factor 3: Beatbot Is a Small Business That Has Been Sued for Infringement

Under 37 C.F.R. § 1.27(a), a "small entity" is a business concern with fewer than 500 employees. Beatbot, including its real party in interest Xingmai, satisfies

²Zodiac's own admission in the co-pending district court action that its products do not practice the '191 patent claims—the claims challenged here—bears directly on Factor 2 of the March 11, 2026 Memorandum.

that threshold. Li Decl. ¶ 6. Beatbot was founded in 2022 and filed its IPR petition defensively—only after receiving a cease-and-desist letter from Patent Owner in July 2025.

Patent Owner quotes Beatbot's Li declaration ¶ 10 (Ex. 1021 in -00395): “Beatbot maintains three (3) U.S.-based personnel who perform functions such as U.S. sales and marketing user research.” Far from undermining Beatbot's position, this fact corroborates Beatbot's small-entity status. A company with three U.S.-based personnel is precisely the kind of small business the March 11 Memo is designed to protect.

The § 1.27(a) standard turns on employee headcount—not patent counts, customer counts, retail partnerships, or capital raised. Patent Owner's arguments that Beatbot has raised more than \$140 million and maintains various commercial partnerships are irrelevant to the regulatory standard. Nothing in § 1.27(a) or the March 11 Memo asks whether a small entity has successfully raised capital; the standard is the number of employees.

The contrast with Patent Owner is stark. Patent Owner is a wholly owned subsidiary of Fluidra, S.A., a publicly traded, Spain-headquartered multinational with approximately 6,500 employees, operations in 47 countries, 135 sales offices, 36 production centers worldwide, and a market capitalization of approximately \$5.2 billion USD. Fluidra is the archetype of the large multinational whose offensive use

of the patent system the March 11 Memo addresses. Beatbot—a small business that received a cease-and-desist letter and filed a declaratory judgment action before filing any IPR petition—is the opposite.

VI. THE *FINTIV* FACTORS WEIGH AGAINST DISCRETIONARY DENIAL

Patent Owner did not address the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). Each factor nonetheless weighs against discretionary denial.

A. Factors 1 and 2: The Stay Has Been Lifted and No Trial Date Has Been Set

The stay in the co-pending Southern District of California action was lifted by minute order on July 14, 2026. SDCA Dkt. 42. But the amended schedule entered thereafter sets no trial date. *See* Order Modifying Schedule Following Lifting of Stay, SDCA, Dkt. No. 43 (July 21, 2026)

Oral argument in the joined IPR proceeding (IPR2026-00158) is set for February 18, 2027. The final written decision is due within one year of the May 15, 2026 institution date. The final written decision will therefore precede any district court trial. These factors weigh against discretionary denial.

B. Factor 3: Investment in the Parallel Proceeding Is Minimal

No expert reports have been served. No depositions have been taken. Under the SDCA amended schedule, the case remains at an early stage of litigation.

The district court action thus has no trial date, no expert discovery, and no claim construction ruling. Factor 3 weighs against discretionary denial.

C. Factor 4: The Sotera-Plus Stipulation

Beatbot's *Sotera-Plus* stipulation (Paper 9) is conditioned on institution. If and when the Board institutes *inter partes* review in this proceeding (IPR2026-00395), Petitioner and any real parties in interest (RPIs) will not advance against the claims challenged in IPR2026-00395 in the co-pending district court proceeding: (i) the specific grounds raised in IPR2026-00395; (ii) any other grounds that could have reasonably been raised before the PTAB in that instituted proceeding (i.e., any ground that could have reasonably been raised under 35 U.S.C. §§ 102 or 103 on the basis of prior art patents or printed publications); or (iii) any ground based on a combination of system prior art and the prior art patents or printed publications described in (i) or (ii). Factor 4 accordingly weighs against discretionary denial.

The concern underlying the Director's observation in the lead proceeding is absent here. The Director observed that Wybotics's institution-contingent stipulation was "inadequate to address the conflicting constructions," but held: "Despite the conflicting claim construction and Petitioner's inadequate stipulation, however, it is an appropriate use of Office resources to review the potential error identified above." Beatbot presents no conflicting claim construction: its Petition applies the plain and ordinary meaning except for the single means-plus-function

term, and in the district court the parties identified one term and reached an agreed construction on that same term, as reflected in the March 23, 2026 Joint Claim Construction Hearing Statement. Beatbot's preliminary invalidity contentions assert no actual § 112(b) indefiniteness ground; the § 112 language in those contentions is standard reservation-of-rights language. Those facts address the concern underlying the Director's observation for reasons independent of any stipulation covering indefiniteness.

D. Factor 5: Overlap of Parties

There is complete party overlap: Beatbot is both the petitioner in this IPR and the plaintiff in the SDCA action. This factor is neutral.

E. Factor 6: The Merits

The merits have been confirmed by the Director's material-error determination, as discussed in Section III above. The IPR2026-00158 Scheduling Order (Paper 16) imposes a five-business-day related-matters reporting requirement, which provides a mechanism for managing the parallel district court case. Factor 6 weighs against discretionary denial.

Beatbot's district court claim constructions remain the plain and ordinary meaning, plus the single agreed means-plus-function term. The parties confirmed in the March 23, 2026 Joint Claim Construction Hearing Statement that "[t]he Parties identified one term for construction, and the Parties reached an agreed

construction for that term.” No inconsistency will arise from the October 9, 2026 claim construction proceedings.

VII. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Director decline to exercise discretion to deny institution, institute inter partes review of claims 1–3 of U.S. Patent No. 11,003,191 B2, and grant the pending Motion for Joinder to IPR2026-00158.

Dated: September 9, 2026

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing
PETITIONER'S RESPONSE TO PATENT OWNER'S BRIEF REQUESTING
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