

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DUKE MANUFACTURING CO.,
Petitioner

v.

MARMON FOODSERVICE TECHNOLOGIES, INC.
Patent Owner.

Case IPR2026-00406
Patent 10,852,002

PATENT OWNER'S BRIEF IN SUPPORT OF DISCRETIONARY DENIAL

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PATENT OWNER'S EXHIBIT LIST

EX NO.	DOCUMENT
2001	Complaint, <i>Marmon Foodservice Technologies, Inc. v. Duke Manufacturing Co.</i> , Case No. 4:25-cv-01491-ZMB (E.D. Mo.), Dkt. 1, filed October 3, 2025.
2002	Joint Proposed Scheduling Plan, <i>Marmon Foodservice Technologies, Inc. v. Duke Manufacturing Co.</i> , Case No. 4:25-cv-01491-ZMB (E.D. Mo.), Dkt. 45, filed August 25, 2026.
2003	Docket Report, <i>Marmon Foodservice Technologies, Inc. v. Duke Manufacturing Co.</i> , Case No. 4:25-cv-01491-ZMB (E.D. Mo.), retrieved September 8, 2026.
2004	Duke Manufacturing Co.'s Response To Marmon's Request For An Initial Pretrial Conference, <i>Marmon Foodservice Technologies, Inc. v. Duke Manufacturing Co.</i> , Case No. 4:25-cv-01491-ZMB (E.D. Mo.), Dkt. 36, filed June 8, 2026.
2005	Declaration of Michael Mattingly

I. Introduction

Pursuant to 35 U.S.C. § 314(a) and the Memorandum by the Acting Director dated March 26, 2025, setting forth the “Interim Processes for PTAB Workload Management” (the “Memorandum”), Patent Owner Marmon Foodservice Technologies, Inc. (“Marmon” or “Patent Owner”) respectfully submits this brief requesting that the Director deny institution of the Petition for inter partes review (Paper 1 or “Pet.”) filed by Duke Manufacturing Co. (“Duke” or “Petitioner”). The Director possesses broad discretion to deny institution even where a petitioner arguably satisfies the threshold merits standard because “non-institution remains within the Director’s discretion: No law compels institution.” *Magnolia Med. Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 7 (May 14, 2026) (quoting *Apple Inc. v. Squires*, 166 F.4th 1349, 1353 (Fed. Cir. 2026)); *United States v. Arthrex, Inc.*, 594 U.S. 1, 8-9 (2021). Institution should be denied under 35 U.S.C. § 314(a) because this Petition will not materially simplify the parallel litigation, will substantially duplicate ongoing district-court proceedings, will impose an extraordinary burden on limited Office resources, and would upset settled expectations arising from a mature and heavily commercialized patent family.

In the parallel litigation pending in the U.S. District Court for the Eastern District of Missouri (*Marmon Foodservice Technologies, Inc. v. Duke*

Manufacturing Co., No. 4:25-cv-01491), Marmon has asserted nine patents—seven utility patents and two design patents—protecting its proprietary multi-zone food-holding technology. Despite representing to the district court that it “intend[s] to file IPR petitions challenging the asserted patents” and would seek a stay of the litigation, Duke has filed only a single petition directed to U.S. Patent No. 10,852,002 (“the ’002 patent”). Ex. 2004 at 2. Duke’s decision to challenge one patent while leaving eight asserted patents untouched demonstrates that this proceeding cannot simplify the parallel litigation. In fact, instituting Duke’s petition would only duplicate efforts already underway before the *Duke* Court. The *Duke* Court ordered the parties to move forward with discovery—despite Duke’s suggestion it would file multiple IPRs and seek a stay. Furthermore, the Court has already expended judicial resources evaluating the pleadings and recently denied Duke’s attempt to dismiss the design patent infringement claims. Ex. 2003, Dkt. 50. Because the enforcement, validity, and scope of those other eight patents *will* be adjudicated by Eastern District of Missouri, instituting Duke’s petition guarantees duplication of judicial resources.

This is just the opposite of Congress’ intent in creating inter partes review, which Congress viewed as a “quick and cost effective alternative to litigation.” H.R. Rep. No. 112-98, at 48 (2011). In *Magnolia*, the Director emphasized that AIA reviews should not be used as an additional forum layered upon district-court

litigation and observed that many petitioners pursue PTAB review “in parallel with litigation to gain litigation leverage.” *Magnolia*, Paper 17 at 2-4. Here, Petitioner challenges only one of the nine patents it has allegedly infringed. Accordingly, even complete success in this proceeding would leave the overwhelming majority of the dispute pending before the Eastern District of Missouri. Institution would not be an alternative to litigation; it would merely create a second forum for the same commercial dispute.

Petitioner asserts within a single Petition twelve obviousness grounds involving as many as fifteen references. If instituted, the Board would be required to manage and adjudicate this sprawling challenge through final written decision, imposing a substantial burden on limited Office resources. *See* 35 U.S.C. § 316(b); *Magnolia*, IPR2026-00097, Paper 17 at 6 (recognizing that discretionary institution decisions may consider “the economy, efficient administration of the Office, [and] the ability of the Office to timely complete its AIA reviews”). Petitioner’s sprawling petition crams these grounds and disparate prior art references into the word limit, raising substantial particularity concerns under 35 U.S.C. § 312(a)(3) and relying on an impermissible hindsight mosaic supported by 620 of pages of expert re-engineering. Were Marmon’s patent truly obvious, Petitioner’s presentation would have been more direct. The Board has no obligation to dedicate its resources and

time to unraveling Petitioner’s knotted arguments, particularly when the *Duke* Court will also do so.

Petitioner chose to challenge the ’002 patent, but that is simply one patent in Marmon’s foundational multi-zone food-holding patent family that has been continuously commercialized in the market since 2015. The parent patents in this family (such as U.S. Patent Nos. 9,976,750 and 9,980,322) issued in May 2018—more than eight years ago. Marmon has invested heavily in domestic manufacturing, assembly in its Illinois facility, and supply chain networks across the Upper Midwest based on the settled expectation that this entire portfolio protects its market position against copycat competitors.

The Director should exercise its discretion under 35 U.S.C. § 314(a) and deny institution of the Petition.

II. Discretionary Denial is Warranted Under § 314(a)

The Director possesses broad statutory discretion under § 314(a) to deny institution even where the petition otherwise satisfies the threshold requirements for review. As the Director recently explained: “Even if certain statutory preconditions for institution are met, non-institution remains within the Director’s discretion: No law compels institution.” *Magnolia*, IPR2026-00097, Paper 17 at 7. The Director further explained that discretionary institution decisions properly consider “the economy, efficient administration of the Office, the ability of the Office to timely

complete its AIA reviews, and the integrity of the patent system.” *Id.* at 6 (citing 35 U.S.C. § 316(b)). Consistent with those principles, the Board may deny institution where review would duplicate judicial proceedings, inefficiently consume Office resources, undermine settled expectations, or otherwise fail to advance the purposes Congress intended for AIA proceedings.

A. The Petition Does Not Advance the Congressional Purpose of AIA Proceedings

Congress created AIA proceedings to provide an efficient alternative to district court litigation, not an additional forum for litigating the same dispute. H.R. Rep. No. 112-98 at 48. In *Magnolia*, the Director explained that many petitioners no longer use the PTAB as a litigation alternative but instead seek review “in parallel with litigation to gain litigation leverage.” IPR2026-00097, Paper 17 at 3. The Director further observed that when AIA review serves merely as an additional vehicle for asserting validity challenges, “the parties spend more time and resources litigating patent validity than they would have in the absence of AIA reviews.” *Id.*

Such concerns are directly implicated here. Petitioner previously advised the district court that it intended to pursue IPR challenges to the asserted patents generally. Ex. 2004 at 2. Yet Petitioner ultimately selected only one patent from the nine-patent case. The resulting mismatch between its once-stated PTAB strategy and its actual filing conduct demonstrates that this proceeding cannot function as the efficient litigation alternative contemplated by Congress. Regardless of the outcome

of this proceeding, the parties will continue litigating infringement, validity, damages, equitable defenses, and eight additional patents in Missouri. Accordingly, institution will not materially simplify the litigation. Rather, institution would create a second forum adjudicating validity issues associated with the same commercial dispute. Under the rationale articulated in *Magnolia*, this Petition falls outside the purpose Congress intended for AIA review.

B. Parallel District Court Litigation Strongly Favors Discretionary Denial Under the *Fintiv* Framework

Under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), six holistic factors are evaluated to determine whether parallel district court litigation warrants discretionary denial. Every factor weighs heavily in favor of denial here.

i. Factor 1: The District Court Is Unlikely to Grant a Stay

The parallel proceeding in the Eastern District of Missouri involves nine asserted patents (seven utility and two design patents):

Asserted Patent	Patent Type	Issue Date
U.S. Patent No. 9,976,750	Utility	May 22, 2018
U.S. Patent No. 9,980,322	Utility	May 22, 2018
U.S. Patent No. 10,492,641	Utility	Dec. 3, 2019
U.S. Patent No. 10,512,363	Utility	Dec. 24, 2019
U.S. Patent No. 10,841,981	Utility	Nov. 24, 2020
U.S. Patent No. 10,852,002	Utility (Challenged Here)	Dec. 1, 2020
U.S. Patent No. 11,771,264	Utility	Oct. 3, 2023

U.S. Patent No. D1,020,455	Design	Apr. 2, 2024
U.S. Patent No. D1,064,814	Design	Mar. 11, 2025

Ex. 2001 at 2–4.

The Eastern District of Missouri considers the following factors when evaluating stay motions: (1) whether discovery is complete and whether a trial date has been set; (2) whether a stay of litigation will simplify the issues in question and facilitate the trial; and (3) whether a stay would unduly prejudice or present a clear tactical disadvantage for the non-moving party. *Amsted Rail Co., Inc. v. Hum Indus. Tech., Inc.*, No. 4:22-CV-00445-AGF, 2023 WL 2864553, at *2 (E.D. Mo. Apr. 10, 2023).

A stay in the parallel litigation is virtually impossible because Petitioner is doing nothing to simplify the issues in question, and a stay would unduly prejudice or present a clear tactical disadvantage for the Patent Owner. Even if the Board were to institute review and invalidate every challenged claim of the '002 patent, eight asserted patents and extensive infringement counts regarding Duke's products would remain unresolved. Courts in the Eastern District of Missouri place significant weight on simplification when evaluating stays pending IPR. *Amsted*, 2023 WL 2864553, at *2. Under Duke's own articulation of the stay standard, PTAB review justifies a stay only where it is likely to streamline the litigation through claim cancellation or estoppel. Ex. 2004 at 2-3. That rationale is absent here because

institution would leave virtually the entire litigation intact. Because an IPR on a single patent cannot simplify the broader dispute, the district court would not halt the litigation.

In fact, the *Duke* Court has already signaled a disinclination to delay proceedings. After Marmon requested to move forward with scheduling and discovery over Duke's opposition, the Court ruled that neither Duke's partial motion to dismiss nor its potential "intent to file IPR petitions" warranted an "effective stay of the case." Ex. 2003, Dkt. 38. By rejecting Duke's pre-filing stay arguments and ordering the parties to proceed with immediate case management and discovery, the Court has made clear that it intends to resolve this multi-patent dispute expeditiously. That forward momentum was cemented when the Court adjudicated Duke's partial motion to dismiss and denied Duke's attempt to dismiss the design patent infringement claims, confirming that all nine patents remain active in the litigation. Ex. 2003, Dkt. 50.

Moreover, the inability of this proceeding to simplify the broader litigation further weighs against institution. The Petition concerns only one patent among nine asserted patents. Thus, even complete success before the Board would leave virtually the entire district-court action intact. Such circumstances confirm that this proceeding is not functioning as an "alternative to litigation" envisioned by Congress and discussed by the Director in *Magnolia*. IPR2026-00097, Paper 17 at 3.

ii. Factor 2: The District Court Trial Schedule Substantially Overlaps with the Projected Final Written Decision

The district court is actively moving forward on a parallel track for this nine-patent action. Ex. 2002 at 2-3; Ex. 2003, Dkt. 39. Pursuant to the Joint Proposed Scheduling Plan filed on August 25, 2026, the parties have proposed a comprehensive timeline for claim construction. Ex. 2002 at 5–9. The parties have exchanged Rule 26 disclosures, filed their Joint Proposed Scheduling Plan, and proposed a contention and claim-construction schedule that begins in September 2026 and culminates in a Markman hearing in June 2027. Ex. 2002 at 3-7; Ex. 2003, Dkts. 43, 45.

In contrast, if the Board institutes trial, the statutory deadline for a Final Written Decision under 35 U.S.C. § 316(a)(11) would not mature until January 2028. Because the district court is aggressively advancing merits discovery and claim construction as required by the Local Patent Rules, institution would create overlapping validity adjudications and duplicate federal judicial and administrative resources. Similar timing concerns supported discretionary denial in *Elong International USA Inc. v. Feit Electric Co.* where the Director denied institution because trial was expected to occur before issuance of a Final Written Decision, meaningful investment had already occurred in the district court proceeding, and there was insufficient evidence that a stay would be granted. IPR2025-00258, Paper 16 at 2-3 (June 25, 2025).

iii. Factor 3: Substantial Investment Has Already Been Expended in the Parallel Litigation

The parallel litigation was commenced on October 3, 2025. Ex. 2001 at 25. So far, Petitioner appeared, moved to partially dismiss, briefed that motion, requested oral argument, opposed Marmon's request for an initial pretrial conference, exchanged Rule 26 disclosures, participated in preparation of a Joint Proposed Scheduling Plan, and appeared for Rule 16 scheduling proceedings. Ex. 2003, Dkts. 24-45. Indeed, the district court affirmatively moved the case forward despite Petitioner's then-pending motion to partially dismiss and its stated intention to pursue IPR review, by granting Marmon's request for an initial pretrial conference. Ex. 2003, Dkts. 38-39. Furthermore, the district court has already expended substantial judicial resources managing the docket and adjudicating Petitioner's partial motion to dismiss. Ex. 2003, Dkt. 50. Accordingly, substantial judicial and party resources have already been invested in the litigation. By the time the Board issues an institution decision in early 2027, document discovery, invalidity contentions, and claim construction briefing will be substantially complete, and significant further resources would be expended.

iv. Factors 4 & 5: Complete Identity of the Parties and Substantial Overlap of Invalidity Issues

The fourth and fifth *Fintiv* factors assess the overlap of issues and the identity of the parties. Both factors require denial of the petition.

The parties are identical in both forums: Marmon Foodservice Technologies, Inc. and Duke Manufacturing Co. Ex. 2001. The invalidity issues will likely substantially overlap. The challenged claims of the '002 patent in this proceeding are the exact same claims at issue in the parallel district court litigation. *Id.*

Crucially, Petitioner has failed to file a *Sotera* stipulation. Ex. 2003. As a result, Petitioner remains free to pursue overlapping invalidity theories in the parallel district court action while simultaneously litigating patentability before the Board. The resulting duplication of effort, inefficiency, and risk of inconsistent adjudications are precisely the concerns animating both the *Fintiv* and *Sotera* decisions. *Fintiv*, IPR2020-00019, Paper 11 at 5-16; *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020) (precedential as to § II.B). Indeed, the Director recently reiterated that Congress intended AIA reviews to narrow disputes rather than create “another forum where litigation can be expanded.” *Magnolia*, IPR2026-00097, Paper 17 at 3-4. The absence of any meaningful limitation on Petitioner’s parallel invalidity case confirms that institution would expand, rather than streamline, the parties’ dispute, thereby frustrating the efficiency objectives underlying both the AIA and the Board’s discretionary denial jurisprudence.

This overlap is acutely problematic regarding Petitioner’s primary prior art, the “IRHS Documents,” which are a collection of documents allegedly relating to a

single Duke prior art *product*. IPRs are restricted to patents and printed publications under 35 U.S.C. § 311(b), yet Petitioner is inefficiently attempting to raise a prior art product argument here. The district court is the only forum with jurisdiction to adjudicate this prior art directly as a product under the public-use or on-sale provisions. Without a *Sotera* stipulation, Petitioner remains free to assert the printed publications here while simultaneously asserting the actual physical product in the district court.

v. Factor 6: Petitioner’s Tactical Forum-Shopping and Serial Warfare Subvert the AIA’s Core Efficiency Objectives

Factor 6 strongly favors denial because institution would not advance the efficiency objectives underlying the AIA. In *Magnolia*, the Director explained that discretionary denial may be appropriate where a petitioner uses PTAB review as a litigation supplement rather than as an alternative to litigation. Paper 17 at 2-10. The Director expressly cautioned against circumstances in which validity disputes are expanded across multiple forums rather than streamlined through AIA review. *Id.*

That is exactly what is happening here. Petitioner represented to the district court that “Duke will soon file its first tranche of IPR petitions”; “Duke intends to file IPR petitions challenging the asserted patents”; and thus it would seek a stay of the district court case. Ex. 2004 at 1–2. The *Duke* Court nevertheless moved the case forward and initiated case management proceedings. Ex. 2003, Dkts. 38-39. Thus, while Petitioner previously represented to the district court that it intended to file

IPR petitions challenging the asserted patents, it has, to date, elected to challenge only one patent out of nine asserted patents. The Director recently recognized that repeated challenges and multiple proceedings can increase costs, consume additional Office resources, and undermine the AIA's intended role as an efficient alternative to litigation. *Magnolia*, IPR2026-00097, Paper 17 at 3-5.

Petitioner also did not provide a broad *Sotera* stipulation that would eliminate duplicative validity litigation. Consequently, institution would leave the district court and the Board simultaneously adjudicating overlapping issues involving the same parties. Institution, therefore, would not narrow the dispute. Rather, it would multiply proceedings, increase costs, and consume additional administrative and judicial resources. Under *Magnolia*, those circumstances strongly favor discretionary denial.

C. The Petition's Voluminous Twelve-Ground Matrix and Sprawling Prior Art Mosaic Impose an Impermissible Administrative Burden on the Board

Administrative burden independently supports discretionary denial under 35 U.S.C. § 314(a) because the Petition presents an unmanageable "kitchen sink" challenge. The Director recently explained that institution decisions should account for "the economy, efficient administration of the Office, [and] the ability of the Office to timely complete its AIA reviews." *Magnolia*, Paper 17 at 6 (citing 35 U.S.C. § 316(b)). Those considerations weigh heavily against institution here.

The Petition contains the following grounds and number of references for each ground:

Ground	Basis	No. of References
1	Obvious Over the IRHS Documents*	4
2	Obvious Over IRHS Documents in view of Hartfelder and/or Shei'099	6
3	Obvious Over IRHS Documents in view of Veltrop and Poole	6
4	Obvious Over IRHS Documents in view of Fortmann'967 and/or Fortmann'197	6
5	Obvious Over IRHS Documents in view of Hartfelder, Shei'099, Prince Castle, and Reese	8
6	Obvious Over IRHS Documents in view of Hartfelder, Shei'099, Veltrop, Poole, Fortmann'967, Fortmann'197, Prince Castle, Reese, and Shei'155	13
7	Obvious Over IRHS Documents in view of Hartfelder, Shei'099, Veltrop, Poole, Fortmann'967, Fortmann'197, Prince Castle, Reese, and Shei'155	13
8	Obvious Over IRHS Documents in view of Hartfelder, Veltrop, Shei'155, Vaseloff, and McMillan	9
9	Obvious Over Fortmann'748 in view of IRHS Documents, Jones, Fortmann'197, Fortmann'967, McMillan, Vaseloff, Hartfelder, and/or Shei'099	12
10	Obvious Over Fortmann'748 in view of IRHS Documents, Jones, Fortmann'197, Fortmann'967, McMillan, Vaseloff, Hartfelder, Shei'099, Veltrop, and/or Shei'155	14
11	Obvious Over Fortmann'748 in view of IRHS Documents, Jones, Fortmann'197, Fortmann'967, McMillan, Vaseloff, Hartfelder, Shei'099, and/or Prince Castle	13

See Paper 1 at 8–303.

*The “IRHS Documents” are comprised of IRHS Manual (Ex. 1005), IRHS Specifications (Ex. 1006), Duke Website (Ex. 1007), and IRHS Service Manual (Ex. 1008). Paper 1 at 3.

As such, the Petition asserts twelve separate obviousness grounds and relies on combinations involving as many as fifteen references. Rather than presenting a limited number of focused validity challenges, Petitioner asks the Board to parse dozens of overlapping permutations scattered across hundreds of pages of briefing and expert testimony. Such sprawling presentations are precisely the type of burden that prior panels have found inconsistent with efficient Office administration. *See Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 at 19-21 (PTAB Mar. 6, 2019); *Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10-11 (PTAB Nov. 7, 2018).

Moreover, to force twelve grounds and up to fifteen references into the 14,000-word limit, Petitioner made conclusory, high-level assertions that raise significant particularity concerns under 35 U.S.C. § 312(a)(3). *See generally*, Paper 1. Petitioner treats the prior art as interchangeable components, presenting modular

combinations without explaining how a person of ordinary skill in the art would reconcile physical, mechanical, and thermal incompatibilities. *Id.*

In *Adaptics*, the Board exercised its § 314(a) discretion to deny institution because the petitioner asserted an unduly burdensome number of reference combinations. As the Board held:

Presenting an unduly burdensome number of combinations impairs the Office's efficiency and justifies complete denial of the petition in the interests of efficient administration of the Office and procedural fairness to Patent Owner.

IPR2018-01596, Paper 20 at 19–21; *see also Chevron.*, IPR2018-00923, Paper 9 at 10–11 (denying institution under § 314(a) where sprawling obviousness combinations placed an unreasonable burden on the Board to decode the grounds); *accord Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 at 41–43 (PTAB Jan. 24, 2019).

Forcing the Board to unpack this matrix is an unreasonable drain on Office resources.

D. The Petition Impermissibly Relies on Convoluting, Retrospective Expert Testimony to Construct a Hindsight Reconstruction Rather Than Standalone Disclosures

The extraordinary scope of Petitioner's evidentiary submission further underscores the burden institution would impose. Petitioner's obviousness theories rely heavily upon a purported expert declaration spanning 620 pages and 1,029

paragraphs. Evaluating the Petition would require the Board to navigate a massive network of prior-art combinations, expert analysis, and reconstruction arguments before even reaching the merits. Such demands are particularly inappropriate where, as here, parallel litigation involving the same patent (and, presumably, the same arguments) will proceed regardless of whether institution is granted.

Under 35 U.S.C. § 311(b), an inter partes review is limited to anticipation and obviousness challenges based upon patents or printed publications. Although expert testimony may assist the Board in understanding the teachings of the prior art, it cannot substitute for the prior art itself by supplying missing disclosures, providing unsupported motivations to combine, or transforming deficient references into a viable unpatentability case. *See TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1359-62 (Fed. Cir. 2019) (“Conclusory expert testimony does not qualify as substantial evidence.”); *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1366 (Fed. Cir. 2016) (“conclusory statements and unspecific expert testimony” cannot support an obviousness determination); *In re Van Os*, 844 F.3d 1359, 1361-62 (Fed. Cir. 2017) (“a conclusory assertion with no explanation is inadequate to support a finding that there would have been a motivation to combine”).

Here, Petitioner does not present a straightforward challenge based on what the prior-art references themselves disclose. Instead, Petitioner relies on an

elaborate, retrospective engineering project by its purported expert, Dr. Glenn E. Vallee. Ex. 1003.

The declaration improperly: (1) supplies missing physical elements, (2) reconfigures prior art systems to match the claims of the '002 patent, and (3) relies on impermissible hindsight to attribute artificial motivations to a person of ordinary skill in the art. *See* Ex. 1003. As such, the declaration requires the Board to evaluate an extraordinary number of alleged modifications, combinations, and motivations spanning twelve asserted grounds and numerous prior-art references. This excessive reliance on circular expert declarations demonstrates that the alleged obviousness is a product of 2026 hindsight rather than the state of the art in 2016. And Petitioner's 620-page-long expert-driven reconstruction demonstrates that the Petition is not grounded in clearly articulated printed publication teachings, but instead depends upon extensive hindsight assisted analysis that would impose a substantial burden on the Board to unravel. Accordingly, the Board and the Director should decline to expend their resources unpacking hundreds of pages of expert re-engineering.

E. Portfolio Maturity and Patent Owner's Settled Domestic Investment Expectations Over a Decade Compel Discretionary Denial

Settled expectations are a recognized discretionary consideration. *See Magnolia*, Paper 17 at 8-9 (identifying settled expectation as a factor properly

considered in institution decisions and finding that reliance interests inform the discretionary analysis). Where substantial commercial investment has developed around a mature patent family, those expectations weigh in favor of denial.

Here, Marmon’s settled domestic investment architecture in its holding-bin technology is anchored by a mature patent portfolio dating back to the 2015 commercial rollout of its Extended Holding Bin (EHB) product line. Ex. 2005 at ¶ 6. This deep commercial reliance is evidenced by parent patents that have been in force for over eight years, substantial domestic sales and revenue, over \$[REDACTED] in capital and R&D expenditures, domestic assembly in Illinois, and a strict posture of market exclusivity backed by continuous physical patent marking. *Id.* at ¶¶ 8–16.

Petitioner appears to have isolated the ’002 patent because its December 1, 2020, issue date sits near the 6-year mark. *See* Ex. 1001. However, the ’002 patent is not an isolated legal instrument; it is an integral member of Marmon’s foundational “Multi-Zone Food Holding Bin” patent portfolio that has existed for nearly a decade. Ex. 2001 at 2–4. Marmon and its predecessor Prince Castle have been fast-food equipment innovators since the 1950s supplying food holding equipment to major quick-service restaurant (QSR) customers for the history of the market segment. Development leading to the inventive product was born from customer relationships dating to at least the late 1990s. Ex. 2005 at ¶ 4. In 2015, Prince Castle introduced its next-generation Extended Holding Bin (EHB), a multi-

zone holding oven featuring independently controllable upper and lower heating to maintain food quality over extended holding periods. *Id.* at ¶ 5. Marmon’s multi-zone holding technology is protected by a continuous family of utility patents, including U.S. Patent Nos. 9,976,750 (issued May 22, 2018) and 9,980,322 (issued May 22, 2018)—both of which have been in force for more than eight years. Ex. 2001 at 2–4. The ’002 patent shares a common lineage, common technical core, and overlapping claim coverage with this family of utility patents, including the ’750 ’322 patents and U.S. Patent Nos. 10,492,641, 10,512,363, 10,841,981, and 11,771,264. *Id.*

Since 2015, Marmon has sold over [REDACTED] EHB units and generated over \$ [REDACTED] in revenue from the domestically manufactured EHB line. Ex. 2005 at ¶ 8. Marmon’s business, capital allocation, and domestic supply chains settled around the exclusive rights established by this entire patent family starting in 2015. *Id.* at ¶ 9. Evaluating the ’002 patent in a vacuum ignores the economic reality that Marmon’s commercial operations have been deeply entrenched around this patented technology for over ten years.

Marmon’s patented multi-zone technology is actively embodied in its flagship Prince Castle EHB product line (such as the EHB24 configuration), and has been so embodied since the product line was first launched. *Id.* at ¶ 7. To support this technology, Marmon has committed extensive domestic capital, including investing

heavily in growing and maintaining its domestic supply chains, manufacturing, and assembly of the patented multi-zone food holding systems. *Id.* at ¶ 10. Since 2014, Marmon has spent approximately \$[REDACTED] in R&D, engineering, capital expenditures, and marketing to develop, launch, and maintain the EHB line. *Id.* at ¶ 11. All EHBs sold in the U.S. market are assembled in Marmon’s facility in Carol Stream, Illinois, from parts made primarily in the U.S., thus supporting a supply chain of manufacturing across the Upper Midwest. *Id.* at ¶ 12.

Marmon has continuously marked its Prince Castle EHB product line. *Id.* at ¶ 13. Beginning in 2018 after the issue of the first two patents in the family, the physical label applied to EHB units has expressly listed U.S. Patent Nos. 9,976,750 and 9,980,322. The label was later updated in 2020 to also expressly list U.S. Patent Nos. 10,492,641 and 10,512,363. Throughout, the label directed the public to a virtual marking website (www.princecastle.com/patents), which was updated to list the ’002 patent after that patent issued. *Id.*

After Marmon introduced its EHB product in 2015, Duke introduced products incorporating the features claimed by Marmon’s patent portfolio—first launching the HS2 in 2016 and later the ReadyFlex in 2023—to compete directly for major fast-food restaurant customers. *Id.* at ¶ 15. Marmon invested significant capital and resources over several years to procure and cultivate a robust, mature patent portfolio. *Id.* at ¶ 14. Throughout this time, Marmon has strictly maintained market

exclusivity: Marmon has never licensed the '002 patent or any other patent in its family. *Id.* at ¶ 16. When Marmon experienced a significant loss in market share following Duke's ReadyFlex launch, Marmon moved to enforce its patent portfolio against Duke. *Id.* at ¶ 17.

Where a patent owner has spent a decade embedding an entire patented technology family into the domestic market, instituting an unmanageable twelve-ground review against a single patent in that portfolio destroys the settled investment expectations the patent system is designed to protect.

III. Conclusion

This case presents the convergence of multiple discretionary denial considerations. Marmon has simultaneously developed substantial reliance interests through nearly a decade of commercialization and investment in the patented technology. Yet, the Petition challenges only one patent in a nine-patent district court action and therefore cannot materially simplify the litigation. Indeed, the Petition asserts twelve grounds involving extensive combinations of prior-art references supported by a massive expert declaration. Moreover, Petitioner has declined to provide a broad *Sotera* stipulation. Considered together, these circumstances strongly favor denial under § 314(a). For the foregoing reasons, Patent Owner respectfully requests that the Director and the Board exercise their discretion under 35 U.S.C. § 314(a) to deny institution of *inter partes* review.

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CERTIFICATE OF COMPLIANCE WITH WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), I certify that this **PATENT OWNER'S BRIEF IN SUPPORT OF DISCRETIONARY DENIAL** complies with the type-volume limits set forth in the Memorandum and 37 C.F.R. § 42.24 because it contains 4,793 words, excluding the parts of the Brief that are exempted by 37 C.F.R. § 42.24(a), according to the word processing system used to prepare this Brief.

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CERTIFICATE OF SERVICE

I hereby certify that on September 8, 2026, I electronically filed the foregoing using the Patent Trial and Appeal Case Tracking System (P-TACTS) and served an email copy upon counsel of record for Petitioner, as follows:

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