

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZOOM COMMUNICATIONS, INC.,
Petitioner

v.

RICOH COMPANY, LTD.,
Patent Owner

Case IPR2026-00411
Patent No. 11,256,464

**PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	U.S. Patent Application Publication No. US 2013/0249773 A1
2002	U.S. Patent No. 10,740,059
2003	Plaintiff Ricoh Company Ltd.'s Original Complaint for Patent Infringement [Dkt. 1] <i>Ricoh Company, Ltd. v. Zoom Communications, Inc.</i> , No. 1:25-cv-01095-JCG (D. Del.), dated August 29, 2025
2004	District Court's Opinion and Order Denying Defendant Zoom Communication, Inc.'s Motion to Dismiss [Dkt. 39] <i>Ricoh Company, Ltd. v. Zoom Communications, Inc.</i> , No. 1:25-cv-01095-JCG (D. Del.), dated May 1, 2026
2005	Docket Navigator listing of docket entries for <i>Ricoh Company, Ltd. v. Zoom Communications, Inc.</i> , DDE-1-25-cv-01095 (accessed August 25, 2026)
2006	District Court's Scheduling Order [Dkt. 53], <i>Ricoh Company, Ltd. v. Zoom Communications, Inc.</i> , No. 1:25-cv-01095-JCG (D. Del.), dated August June 15, 2026.

Patent Owner respectfully requests discretionary denial.

First, the Petition advances weak challenges based on prior art that does not disclose several claim elements. The Petition tries to fill those gaps with conclusory expert testimony in ways plainly foreclosed by the Office's explicit guidance that "expert testimony ... may not be used to supply a missing claim limitation." Memorandum re Enforcement and Non-Waiver of 37 C.F.R. § 42.104(B)(4) And Permissible Uses of General Knowledge In Inter Partes Review (July 31, 2025) (July 2025 Memorandum) at 1.

Second, Petitioner had ample opportunity to timely challenge the '464 Patent, but chose delay. Petitioner was notified in writing of its infringement of the '464 Patent over two years before filing the instant Petition, which came roughly eleven months after Petitioner was served with Patent Owner's Complaint. Rather than prepare and file its petition promptly after *either* of these events, Petitioner first asked the district court to invalidate all claims as patent ineligible. Only after the Court denied Petitioner's § 101 challenge in a detailed, 58-page opinion did Petitioner turn to the PTAB. And still, even after a further two-month delay, Petitioner does so without a stipulation to avoid duplication or inconsistency.

Third, Patent Owner has settled expectations in the '464 Patent, which will have been in force for roughly four-and-one-half years by the time of institution and issued from an application published just shy of six years ago. The '464 Patent also

claims priority to a parent patent that issued over six years ago from an application that published nearly nine years ago.

Weak challenges and petitioner delay should not be rewarded with institution.

I. PETITIONER’S WEAK CHALLENGES FAVOR DENIAL

As will be explained further in the POPR, both Petition grounds fail to establish that all elements of the independent claims are disclosed or rendered obvious by the art. Each ground relies heavily on unsupported inherency theories and conclusory expert testimony to supply missing claim limitations. *See* “Interim Processes for PTAB Workload Management” at 2 (Acting Director Mar. 26, 2025) (may consider the “extent of the petition's reliance on expert testimony”).

A. Ground 1: Watson in view of Nimri

1. Limitations [1.c]/[5.c]/[9.c] – the first display displays the first captured image and the second captured image

The Petition does not show that its Watson-Nimri combination displays both the first captured image and the second captured image on a single display at the local workstation. Petitioner relies solely on Watson for allegedly teaching that “the first display displays the first captured image and the second captured image.” *See* Pet., 25-26, 30, 37. For the claimed “first display,” Petitioner identifies [red] VDU1 58 of a [yellow] local workstation 50, shown below in Watson’s FIG. 1. Pet., 25-26.

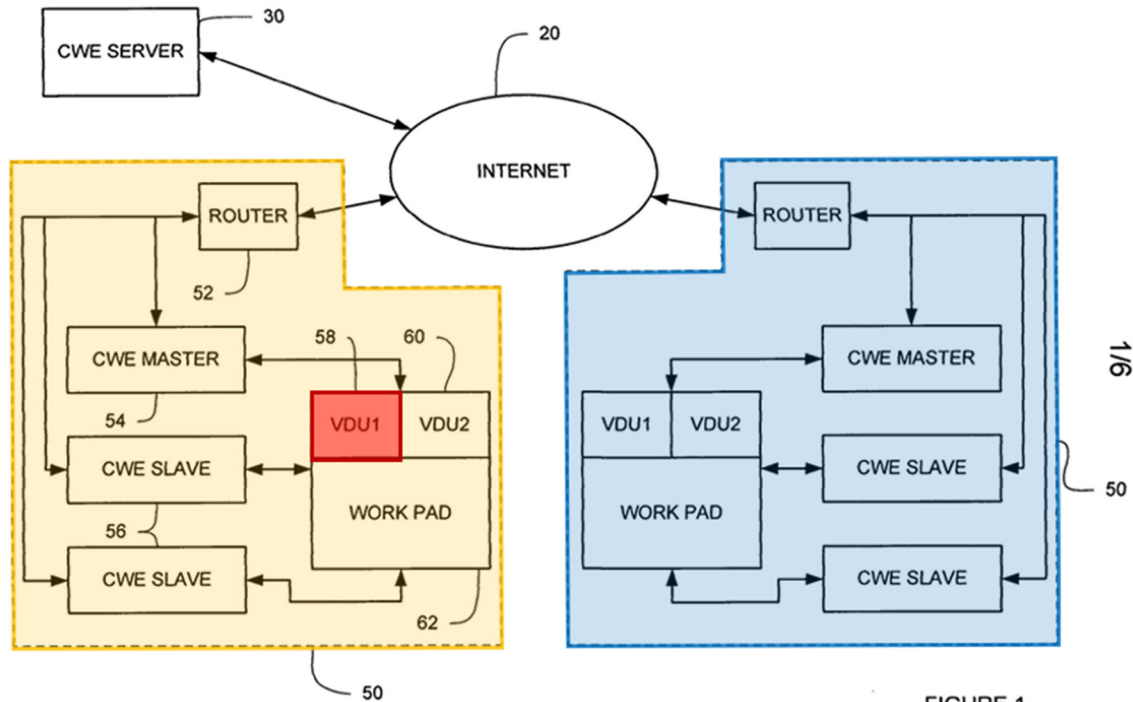


FIGURE 1

EX1004, FIG. 1 (annotated). Petitioner then identifies “[t]he video captured by camera 64 *at the local workstation*” as corresponding to the “first captured image.” Pet., 30. Petitioner alleges that this “‘first captured image’[] is ... transmitted via the network to the [blue] *remote workstation*.” Pet., 30¹; *see id.*, 29 (“camera 64 captures a view of the local user, and this captured image is transmitted via the internet to the remote workstation”). While Watson discloses sending this image to the *remote* workstation (blue above), it does not describe displaying this image at VDU1 of the *local* workstation—the alleged “first display.”

The Petition does not substantively evaluate this claim element. Instead, it provides only the conclusory assertion that “in Watson’s normal operating state:

¹ All emphasis added unless otherwise noted.

VDU 1 is displaying the videoconference (first and second captured images) and VDU 2 is displaying the shared document tile (the third image).” Pet., 37 (citing EX1004, p. 6; EX1003, ¶115). The cited record does not support the conclusion that Watson’s VDU1 simultaneously displays both “the first captured image and the second captured image.” *See* EX1004, p. 6²; EX1003, ¶115.

Page 6 of Watson’s specification provides two sentences related to VDU1 58: (1) describing generically that a first visual display unit 58 “presents video conferencing facilities” and (2) explaining that the “CWE slave 56 manages video conferencing, and thus displays video conferencing images at VDU1 (58).” EX1004, 13/23. Neither sentence explicitly teaches that VDU1 at the [yellow] local workstation displays both the first captured image (captured at the local workstation) *and* the second captured image (captured as the remote workstation), as claimed. Petitioner’s citation to paragraph 115 of its expert declaration (EX1003) merely parrots the conclusion advanced in the Petition. Petitioner’s expert (Dr. Almeroth) provides no explanation as to why “present[ing] video conferencing facilities” and

² The Petition’s citation to “p. 6” of Watson is unclear as to whether Petitioner is citing to Watson’s FIG. 5 (EX1004 page 6/23) or page 6 of Watson’s specification (EX1004 page 13/23). In any event, Watson’s FIG. 5 (EX1004 page 6/23) does not disclose displaying any images at VDU 1 and fails to show the claimed feature.

“display[ing] video conferencing images” (EX1004, 13/23) would teach that VDU1 at the local workstation displays the first captured image (i.e., the video captured by the camera at the local workstation). EX1003, ¶115. It is too late now for Petitioner to fill this gap. Accordingly, Watson does not disclose displaying the local camera image at VDU1 of the [yellow] local workstation, as required by Petitioner’s theory.

Petitioner may respond by pointing to its mapping of Limitation [1.a], where the Petition asserts that the “CWE slave 56 that “manages video conferencing” necessarily receives the remote user’s captured image over the network and displays it on VDU 1 *alongside the local user’s self-view.*” Pet., 30. As explained above, however, the cited portion of Watson (p. 7) does **not** disclose displaying the local user’s self-view on VDU1 (or any other display) at the local workstation, nor is such an operation “necessarily present” in Watson. Indeed, Watson could simply transmit the local camera image to the remote workstation without displaying it at the local workstation. Thus, to the extent Petitioner meant to assert that displaying the local camera image at the local VDU1 was inherent, it did not do so and could not meet its burden regardless. *PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1195–96 (Fed. Cir. 2014) (“must ... meet a high standard in order to rely on inherency to establish the existence of a claim limitation in the prior art in an obviousness analysis—the limitation at issue **necessarily** must be present”). Accordingly, Petitioner’s Ground 1 plainly falls short on Limitations [1.c], [5.c], and [9.c] .

B. Ground 2A/2B: Weiser

1. Limitations [1.pre]/[5.pre] – communication device connected to an image capturing apparatus, a first display, and a second display

Petitioner's mapping is internally inconsistent. For the preamble, Petitioner identifies Weiser's computing device 102 as the claimed communication device and the "one or more display devices 175" as the first and second displays. Pet., 51-52. Petitioner then turns to Weiser's FIG. 3B (annotated below) to identify two *other* displays 304A/B where video streams 302A-302D are mixed into "a first mixed video stream 306A for display on a first display 304A" and "a second mixed video stream 306B for display on a second display 304B." *Id.*; EX1006, 29:22-35.

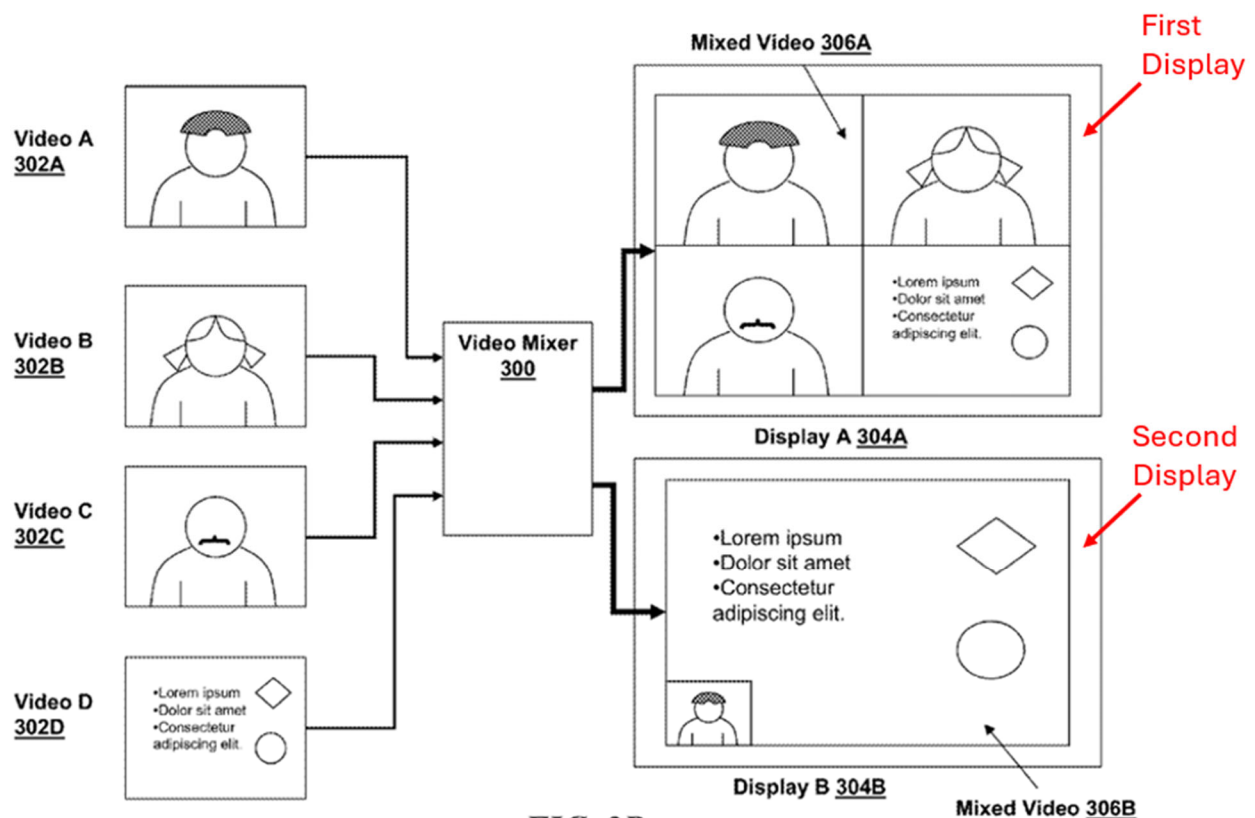


FIG. 3B

Petitioner overlooks that first display 304A and second display 304B are *not* the same as the display device(s) 175 connected to a single computing device 102. Rather, first and second displays 304A, 304B are two separate displays—each connected to respective computing devices of different individuals at different geographical locations. *See* EX1006, 29:16-35. Thus, first display 304A is remote from, and connected to a different computer than, second display 304B. *Id.*

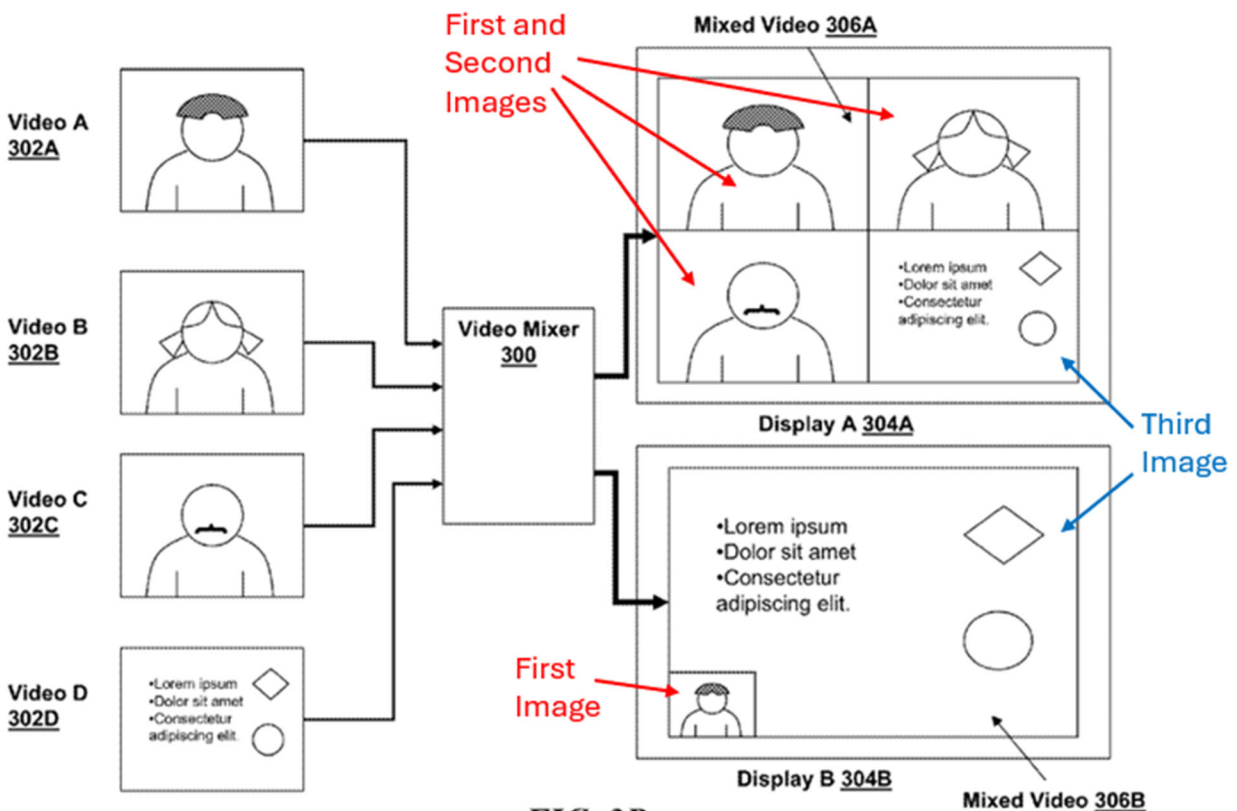
As Weiser explains, the “first mixed video stream 306A may be provided to the *presenter* ... while a second mixed video stream 306B ... may be provided to the *viewer participants*.” EX1006, 29:28-35. That is, mixed video stream 306A is provided to a display 304A used by the presenter (e.g., displayed on “a first participant’s laptop” (*id.*, 28:49-51) and mixed video stream 306B is provided to a display 304B used by one of the viewer participants (e.g., displayed on “a second participant’s videophone” (*id.*, 28:51-52)). These distinct displays 304A/304B belonging to different recipients at different locations are not the two display devices 175 connected to a single computing device, as Petitioner alleges.

Petitioner’s reliance on a first set of displays (display devices 175) for the preamble and other displays (304A/304B) for other limitations (Pet., 51-56, 58-62) cannot legally anticipate. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369-70 (Fed. Cir. 2008) (anticipation requires disclosure of “all of the limitations of the claims arranged or combined in the same way as in the claim”).

2. *Limitations [1.c]/[5.c]/[9.c] - in response to supply of the third image being finished ... automatically ... control the second display to display none of the first captured image, the second captured image, and the third image*

a. **Petitioner's 102 ground is unsupported**

Weiser does not describe how it controls its displays “in response to supply of the third image being finished.” Petitioner asserts two uncorroborated theories to fill Weiser’s silence, but each scenario is explicitly contradicted by Weiser. For each theory, Petitioner asserts that “the first and second images (from local and remote cameras) are displayed on one monitor, and a third image (a presentation) is provided on a second monitor.” Pet., 60; EX1006, FIG. 3B (annotated by PO, below).



At base, Petitioner's mapping fails because the first display (Display A (304A)) and second display (Display B (304B)) are in different places and each is connected to a different "communication device." Critically, Petitioner attempts to map the claimed "communication device" to Weiser's computer, on the mistaken assumption that Weiser discloses a single computer connected to both of Display A and Display B. Pet., 60. But, as explained above, Weiser discloses that the two are separate and therefore cannot meet the claimed "communication device connected to an image capturing apparatus, a first display, and a second display," much less the claimed display control circuit of the communication device or behavioral properties thereof. The details of Petitioner's two theories fare no better.

In a first theory, Petitioner alleges that a "first presenter ... is replaced in the role of presenter by another participant." Pet., 61-62. Weiser does not explicitly describe such a scenario or what would be displayed. Yet, Petitioner contends—without any evidentiary support—that the presentation and presenter (in display 304B) "will be replaced with images corresponding to the second presenter." Pet., 62; EX1003, ¶¶183-184 (expert parroting Petition and citing only to EX1006, 4:33-44 to support that a participant can have the role of a "presenter"). Petitioner's reliance on Weiser's generic statements and conclusory expert testimony cannot establish anticipation. See EX1003, ¶¶182-186.

In addition to its evidentiary failures, Petitioner's first theory necessarily fails because its scenario is directly contradicted by the very Weiser passage the Petition relies upon. As explained above in Section I.B.1, Weiser's FIG. 3B displays a first mixed video stream 306A on a "presenter" display 304A and displays a different mixed video stream 306B on a separate "viewer" display 304B. EX1006, 29:22-35. Thus, the video depicted on a given display changes based on the user's role, meaning a new presenter would simply see the "presenter" mixed video 306A *instead of* the "viewer" mixed video 306B. *Id.* This operation directly contradicts Petitioner's theory that the "first display 304A continues to display the first and second images, as, regardless of the change in presenter role." Pet., 62.

Accordingly, if the first presenter were replaced by a different presenter under Petitioner's posited scenario, the first presenter's role would change (to a "viewer") and the presenter's first display 304A would shift from showing the "presenter" mixed video 306A with "viewer participants" (the alleged first and second images) to, instead, displaying the "viewer" mixed video 306B with the new, second presenter and their new presentation. EX1006, 29:22-35. Thus, Weiser does not disclose or suggest the claimed operation under Petitioner's first theory.

In a second theory, Petitioner alleges that the presentation is "no longer being shown because the presenter is done." Pet., 62. Petitioner contends that such a scenario would result in the presentation not being shown on the second display or

the first display. Again, Petitioner provides no evidence to support this operation and, instead, relies solely on conclusory expert testimony. *See* Pet., 62-65 (citing EX1003, ¶¶187-190). Perhaps recognizing the insufficiency of its evidence, Petitioner falls back on a flawed inherency theory that: when a request to close the connection is received “the mixing would have no choice but to exclude that stream” (Pet., 63), despite its expert recognizing that other choices were available. EX1003, ¶58 (admitting a device “can display the last frame of the content indefinitely” when the presentation of content is finished). Even if Weiser had disclosed displays 304A and 304B connected to the same computer, Petitioner’s expert’s acknowledgement of this alternative scenario precludes any argument or finding of inherency.

In addition to its evidentiary failures, Petitioner’s second theory also fails because it rests on the same mistaken belief that Weiser’s displays 304A and 304B are at the same computer, rather than what they are: displays of separate computers showing distinct output streams sent to different recipients at different locations. EX1006, 29:22-35. In Petitioner’s second theory, the first presenter is no longer presenting (i.e., no longer a presenter) and their role would simply change, thereby changing what stream is displayed on their display. *See* EX1006, 29:22-35. Thus, Weiser’s operation contradicts Petitioner’s theory that display 304A is “unaffected by termination of the presentation/document stream.” Pet., 63-64.

Further, Petitioner’s speculation about ending the presentation (Video D, mapped to the third image) (Pet., 64) does not explain why the participant camera feeds (mapped to the first/second images) would not be displayed on the second display (304B). Petitioner’s alleged operation is not disclosed in Weiser (EX1003, ¶189 (not citing Weiser)) and is *not* necessarily present. For example, mixed video 306B “provided to the viewer” (at display 304B) could still show the presenter (Video A) after the presentation (Video D) stops (e.g., for the presenter to take questions) *or* the viewer display 304B could simply display images of the participants as in stream 306A. EX1006, 29:36-39. Either would display first and/or second images (participant camera feeds) on second display 304B. Accordingly, Weiser does not expressly or inherently anticipate the independent claims.

b. Petitioner’s “alternative obviousness rationale” cannot support institution

At the outset, this ground is unsupported and based on the same misunderstanding explained above. *See* Pet., 65 (erroneously contending that Weiser teaches “dual-display configurations for video conferencing”); EX1006, 29:22-35 (describing single display configurations). Nevertheless, Petitioner’s obviousness ground cannot support institution because, among other shortcomings, it fails to comply with 37 C.F.R. § 42.104(b)(4).

The Petition’s obviousness theory relies on expert testimony to supply the missing claim limitation. *See* Pet., 65 (conceding that “Weiser does not explicitly

describe [Limitations [1.c]/[5.c]/[9.c]]” and contending a “POSITA would have been motivated to clear the content from the second display when its content source ends” to meet these Limitations). As the Office has explained, “expert testimony ... may *not* be used to supply a missing claim limitation.” July 2025 Memorandum, 1. Petitioner’s asserted modification “to clear the content from the second display” (Pet., 65) is clearly used to supply a missing limitation. Because Ground 2B relies on testimony for that limitation—and not patents or printed publications—it violates Rule 104(b)(4) and the Board “shall deny” this ground. July 2025 Memorandum, 1.

In addition to its evidentiary failures, Petitioner’s alternate obviousness theory rests on the incorrect premise that Weiser’s “presenter” display 304A and mixed video 306A are simultaneously presented to the *same user* as its “viewer” display 304B and mixed video 306B. But they are not. As such, the Petitioner’s assertion that it would have been obvious, when a presenter stopped presenting, to simply “clear” the “viewer” mixed video 306B while maintaining the “presenter” mixed video 306A is divorced from the reality of Weiser’s disclosure. Thus, Petitioner’s “alternative obviousness rationale” is also unsupported and facially flawed.

II. THE CIRCUMSTANCES FAVOR DENIAL

The ’464 Patent issued from an application that first published October 8, 2020 as US 2020/0319838A1. *See* EX1001, 1/17 (§(65) Prior Publication Data). The ’464 Patent claims priority to two earlier U.S. applications as early as 2013.

EX1001, 1-2/17 ((§63) Related US Application Data). The first priority application published as US 2013/0249773 in September of 2013 and the second published in 2017 and issued as U.S. Patent 10,740,059 B2 (“the ’059 Patent”) in 2020. EX2001 1/18 (§(43) Pub. Date); EX2002, 1/20 (§(45) Date of Patent), §(65) Prior Publication Data). The ’464 Patent was allowed in October 2021 and ultimately issued on February 22, 2022. EX1002, 164, 217.

On April 11, 2024, Patent Owner notified Petitioner of the ’464 Patent and its relevance to Petitioner’s products, services, and software. EX2003, 9.

On August 29, 2025, Patent Owner sued Petitioner for infringement of seven patents, including the ’464 Patent. EX2003, 4, 31-33, 63-65.

Petitioner moved to dismiss, asking the Court to invalidate all asserted patents, including the ’464 Patent, under 35 U.S.C. § 101. EX2004, 4-5. After Patent Owner amended its complaint, Petitioner renewed its motion to dismiss, again asking the Court to invalidate the asserted patents under § 101. EX2004, 5. After full briefing, the Court conducted oral argument on April 1, 2026. EX2005, 3-4.

On May 1, 2026, the Court denied Petitioner’s Motion with a detailed, 58-page opinion analyzing the asserted patents, representative claims, and their respective improvements over conventional technology. EX2004, 2, 9-56.

On July 10, 2026, Petitioner filed its IPR Petition against the ’464 Patent.

A. Petitioner's strategic delay favors denial

Petitioner filed its Petition: *thirteen years* after the first parent U.S. patent application was published (EX2001), *six years* after the parent '059 Patent issued (EX2002), over *five years* after the '464 Patent's claims were allowed (EX1002, 164), almost *five years* after the '464 Patent issued (EX1001), over *two years* after Petitioner received written notice of its infringement of the '464 Patent (EX2003, 9), nearly *eleven months* after Petitioner was sued for infringing the '464 Patent (EX2005), and *three months* after the district court denied Petitioner's § 101 challenge (EX2005). Petitioner could have filed an IPR petition at any of multiple points along that timeline, for example, within a reasonable time after receiving the April 2024 letter from Patent Owner identifying the relevance of the '464 Patent to Petitioner's own products. But Petitioner waited.

“The 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. Techs. v. Kurin*, IPR2026-00097, Paper 17, 2 (PTAB May 14, 2026) (Precedential) (emphasis in original). Petitioner's actions deprived the PTAB of any chance of realizing that purpose here.

Petitioner did not seek *inter partes* review as a quick and cost-effective alternative for resolving this dispute. Petitioner instead elected to delay filing—creating unnecessary risks of overlap with the district court—until the last possible

moment. Indeed, Petitioner first asked the district court to invalidate the patent, and only after being disappointed by the Court's refusal to do so (and a further three month delay) did Petitioner look to the PTAB for a different answer. Petitioner here seeks IPR "as a means by which the petitioner presents additional invalidity arguments under sections 102 and 103" and to force "the parties [to] spend more time and resources litigating patent validity than they would have in the absence of AIA review." *Magnolia Med. Techs.*, IPR2026-00097, Paper 17, 3. While not expressly prohibited, that strategy—of delay, wait-and-see, and then use the PTAB for a second bite at the apple that increases "time and resources"—is antithetical to the policy goals articulated in *Magnolia Medical Technologies*.

B. Petitioner's failure to avoid overlap and inconsistency favors denial

Petitioner offers nothing the overlap and risk of inconsistent rulings inherent in the timing of its Petition. To start, Petitioner provides no stipulation to address the inevitable overlap of issues between the Board and District Court. *Phison Elecs. Corp. v. Vervain, LLC*, IPR2025-00213, Paper 14, at 3 (P.T.A.B. July 10, 2025) (Acting Dir. Review) ("The absence of such a stipulation tips the balance in favor of discretionary denial."); *DataDome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, Paper 13, at 3 (P.T.A.B. Aug. 14, 2025) (Acting Dir. Review) (no stipulation "weighs in favor of discretionary denial"). By foregoing any stipulation, Petitioner shows it will continue to fight patent validity at the district court. Thus, this Petition

is being used as an “*addition* to, not an *alternative* to, the litigation”—inconsistent with the purpose of AIA reviews. *Magnolia*, IPR2026-00097, Paper 17, 3-4.

Moreover, Petitioner has not sought a stay or asserted that it will do so. Even so, a stay is highly unlikely before institution (the ’464 Patent is one of eight patents Petitioner challenges via IPR Petitions, the last of which would not be instituted before March of 2027). *See Omni MedSci., Inc. v. Whoop, Inc.*, No. 25-140, 2025 U.S. Dist. LEXIS 264946, *6-7 (D. Del. Dec. 23, 2025) (“The general rule. . . is . . . that stays are almost never granted before [IPR] review is instituted.”) (citation omitted). Further, with seven asserted patents, a complete stay of litigation remains highly unlikely absent institution of IPRs against *all seven* asserted patents. *Siemens Indus., Inc. v. Westinghouse Air Brake Techs. Corp.*, No. CV 16-284-LPS, 2018 WL 3046511, at *1 (D. Del. June 20, 2018) (denying stay where IPR proceedings were instituted for 8 of 12 patents because it “may slightly simplify some portion of the issues for trial, but would not simplify the majority of the case”); *Courtesy Prods., L.L.C. v. Hamilton Beach Brands, Inc.*, No. CV 13-2012-SLR/SRF, 2015 WL 5145526, *2 (D. Del. Sept. 1, 2015) (denying stay where “IPRs instituted by the PTAB do not address all of the claims at issue, meaning that the parties’ dispute will not be fully resolved by the IPRs, regardless of the outcome”).

Petitioner’s litigation strategy also deprives the Board of the ability to avoid inefficiency or the risk of inconsistent positions. For example, Petitioner’s § 101

Motion forced the Court to invest substantial resources studying all seven asserted patents—including the '464 Patent—to issue its detailed, 58-page opinion declining Petitioner's request to invalidate their claims. *See* EX2004. Petitioner's choice to prioritize pursuit of that substantive motion at the pleading stage ensured that it has not yet needed to take any formal claim construction or prior art positions in the litigation, or even produce invalidity contentions, as of the filing of this brief. Moreover, rather than live with the Court's ruling on its § 101 motion, Petitioner has now asked the Court to transfer the case to the Northern District of California in search of a *third* venue in which to challenge validity. EX2005, 4 (Dkt. 44).

Thus, through its own delay, Petitioner engineered circumstances by which—despite already having taken, and missed, a shot at validity—it can also take a shot at an IPR before having to crystallize any prior art litigation positions.

Coupled with its delayed filing strategy and previous validity challenge at the district court, Petitioner's failure to mitigate any overlapping issues or duplicative efforts proves this Petition is the result of gamesmanship and not a true “alternative” to litigation. In addition to the parties' and the Court's investment of significant resources in the resolution of Petitioner's substantive § 101 motion, by the time of institution in January 2027, the parties will have further invested significant resources in infringement contentions, invalidity contentions, substantial completion of technical document production, and exchanging claim terms for construction.

EX2006, 29/30. Because Petitioner had the opportunity to seek AIA review of the '464 Patent as an alternative to litigation and yet chose not to, denial of institution serves the public interest and will help deter future gamesmanship.

C. Patent Owner has settled expectations in the '464 Patent

Patent Owner has settled expectations of its rights in the '464 Patent. The '464 Patent issued in February of 2022 and, at the time an institution decision is expected in January 2027, will have been in force for five years. *See* EX1001, 1/17. “Although there is no bright-line rule on when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be.” *Dabico Airport Sols. Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (PTAB June 18, 2025) (Precedential).

The strength of Patent Owner’s settled expectations is further underscored by the public notice of the '464 Patent and its patent family. *Id.*, 3 (“actual notice of a patent or of possible infringement is not necessary to create settled expectations”). Here, public notice of the '464 Patent extends over six years before the filing of this Petition. U.S. Pat. Pub. No. 2020/0319838 A1 (the '838 Publication), which issued as the '464 Patent, was published in October of 2020. As this application was publicly available, it “provide[d] notice to the public” *See Dabico*, IPR2025-00408, Paper 21, 3 (“actual notice ... is not necessary to create settled expectations”).

Further, the claims that issued as the '464 Patent were allowed in October of 2021—almost five and a half years before the time an institution decision is expected.

The '464 Patent's family also provides further constructive notice. The '464 Patent claims priority to a U.S. Patent Application that was filed in March of 2013 and published in September of 2013—thirteen years before the Petition was filed. The '464 Patent is also a direct continuation the '059 Patent that first published in August of 2017 and issued in August of 2020. As such, Patent Owner's expectations around this technology are well-settled for this patent family. *See Samsung Elecs. Co. & Samsung Elecs. Am., Inc. v. GenghisComm Holdings, LLC*, IPR2025-00780, -781, Paper 11, 2 (Acting Dir. Aug. 22, 2025) and *Samsung Elecs. Co. & Samsung Elecs. Am., Inc. v. GenghisComm Holdings, LLC*, IPR2025-00792, -793, Paper 12, 2 (Aug. 22, 2025) (holding “strong settled expectations for Patent Owner” in patents that had been in force for as little as three years because “essentially the same discretionary considerations” that existed for co-owned patents “in force for approximately eight and six years” also existed with respect to the younger patents).

III. CONCLUSION

For the foregoing reasons, institution should be denied.

Dated: September 21, 2026

Respectfully submitted,

/Eagle H. Robinson/
Eagle H. Robinson (Reg. No. 61,361)

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on September 21, 2026, complete copies of the foregoing Patent Owner's Request for Discretionary Denial of Institution and EX2001-EX2006 were served on Petitioner via email (by consent), at the following email address(s):

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/Eagle H. Robinson/

Eagle H. Robinson (Reg. No. 61,361)