

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZOOM COMMUNICATIONS, INC.,
Petitioner

v.

RICOH COMPANY, LTD.,
Patent Owner

Case IPR2026-00435
Patent No. 11,546,548

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

TABLE OF CONTENTS

I.	PETITIONER’S WEAK CHALLENGES FAVOR DENIAL	1
A.	Limitations [1.g]/[9.f]/[10.h]/[17.f]: the art does not simultaneously display “video images from each transmission terminal”	2
1.	<i>Lee’s terminals do not simultaneously display “video images from each transmission terminal”</i>	<i>2</i>
2.	<i>Nam does not simultaneously display “video images from each transmission terminal”</i>	<i>5</i>
B.	Petitioner’s Grounds fail to disclose or render obvious other claimed limitations	9
1.	<i>Limitations [1.a]/[9.a]/[10.a]/[17.a]: the GUI elements shown on Lee’s terminals are not stored in the conference server</i>	<i>9</i>
2.	<i>Limitations [1.b]/[9.b]/[10.b]/[17.b]: the identified “update” is not “to a state indicating that the first transmission terminal is attending a video communication”</i>	<i>12</i>
II.	THE CIRCUMSTANCES FAVOR DENIAL	14
A.	Petitioner’s strategic delay favors denial	15
B.	Petitioner’s failure to avoid overlap and inconsistency favors denial	17
C.	Patent Owner has settled expectations in the ’548 Patent.....	19
III.	CONCLUSION.....	20

PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	U.S. Patent No. 10,735,689
2002	U.S. Patent No. 9,621,848
2003	U.S. Patent 9,307,197
2004	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
2005	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
2006	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)
2007	Scheduling Order [Dkt. 53], <i>Ricoh Company, Ltd. v. Zoom Communications, Inc.</i> , No. 1:25-cv-01095-JCG (D. Del.), dated June 15, 2026.

Patent Owner respectfully requests discretionary denial.

First, the Petition's grounds fail to disclose multiple claim elements, including the specific limitation that the examiner found missing in the art during prosecution.

Second, Petitioner had ample opportunity to timely challenge the '548 Patent, but chose delay. Petitioner was notified of its infringement of the '548 Patent over two years before filing the instant Petition, which came roughly one year after Patent Owner's Complaint. Rather than prioritize and promptly file its petition after these events, Petitioner first asked the district court to invalidate all claims as patent ineligible. Only after the court denied that request in a detailed, 58-page opinion did Petitioner turn to the PTAB, without any mitigating efforts.

Third, Patent Owner has settled expectations in the '548 Patent, which will have been in force for four years by the time of institution and claims priority to three parent patents that each issued over six years before the filing of the Petition.

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

I. PETITIONER'S WEAK CHALLENGES FAVOR DENIAL

Petitioner's prior art does not disclose or suggest the subject matter the Examiner identified as being patentable. Further, the Petition offers only vague, conclusory analysis that lacks the particularity required of an IPR Petition. All proposed grounds are exceptionally weak on the merits because they plainly fail to

show even the specific limitation the Examiner found missing from the art. *See* EX1002, 217.

A. Limitations [1.g]/[9.f]/[10.h]/[17.f]: the art does not simultaneously display “video images from each transmission terminal”

During prosecution, the Examiner agreed that Limitation [1.g]—“wherein the first transmission terminal is configured to display video images from each transmission terminal attending the video communication simultaneously”—“is not in the cited references.” EX1002, 217. After performing a “further search” for this Limitation and not finding it in the art, the Examiner allowed the claims. EX1002, 217, 220, 432. The cited prior art references do not disclose or suggest this feature.

1. Lee’s terminals do not simultaneously display “video images from each transmission terminal”

For Ground 1, Petitioner asserts that the attendant icons shown in Lee’s transmission terminals disclose the claimed feature. Pet., 57-58. They do not, as these *icons* do not display “video images.”

In Lee’s system, a first conference room 10 includes a teleconferencing system which includes a *single* “camera device 20” that captures image data (i.e., video) of the entire first conference room and “outputs the image data to a teleconferencing system 35 of the second conference room 30.” EX1004, ¶¶[0085]-[0086]. The teleconferencing system of first conference room 10 also includes a teleconference monitor 21 that is a display device configured to “display images

picked up by a camera device 35a in the second conference room 30.” *Id.* ¶[0088].

Thus, as shown in the partial view of Lee’s FIG. 1 (below), [orange] camera 20 captures a video of the entire first conference room 10 (including the “presenter ... and the scene”) to be sent to a second conference room and [orange] wall-mounted monitor 21 displays the video captured by a camera in the second conference room. EX1004, ¶¶[0085]-[0088].

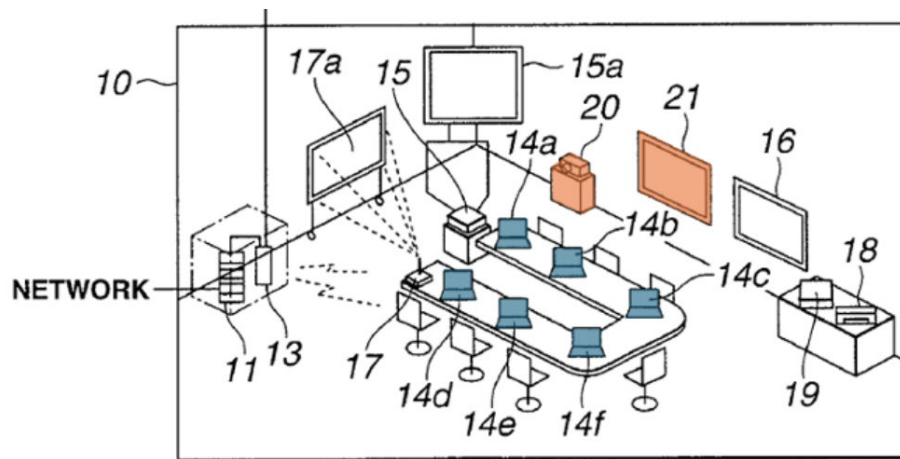


FIG. 1

First conference room 10 also includes multiple [blue] client PCs or terminals 14 that are operated by attendants; however, these terminals are not described as capturing video of any participant. EX1004, ¶¶[0075]-[0077].

Each terminal includes a display mechanism (i.e., screen) for displaying GUIs, such as the contents of a presentation or display icons. *Id.*, ¶¶[0076], [0095], [0097]-[0098], [0102]. Examples of the GUI objects shown in the screen of the terminal can be seen in Lee’s FIGs. 4A and 5 (inset below).

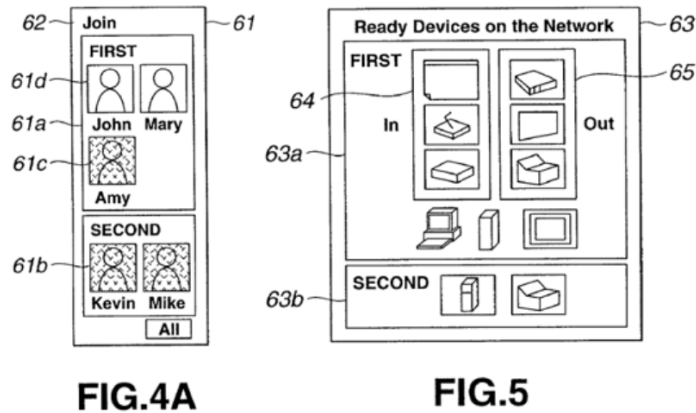


FIG. 4A depicts “an attendant icon display 61 in which the attendants operating the other client PCs are displayed *as icons*” (*id.*, ¶[0103]¹) and FIG. 5 depicts an available equipment display 63 that “displays the images representing the individual equipments *as icons*” (*id.*, ¶[0107]). These icons are not video streams (like that shown on the separate teleconference monitor 21).

Lee never uses the term icon to mean video or anything more than a static image. *Cf.* EX1004, ¶¶[0085]-[0086] (describing video from camera as “image data”). It is indisputable that the equipment “icons” of Lee’s equipment display 63 (FIG. 5 above) are static images corresponding to the equipment and not a video stream of the equipment itself. *See id.*, ¶[0108] (describing “printer” and “client PC” among the icons). Lee’s attendant “icons” share the same meaning—static images corresponding to users, not a video stream of the users. Indeed, for Lee’s attendant “icons” to be video streams, there would need to be individual video streams of each

¹ All emphasis added unless otherwise noted

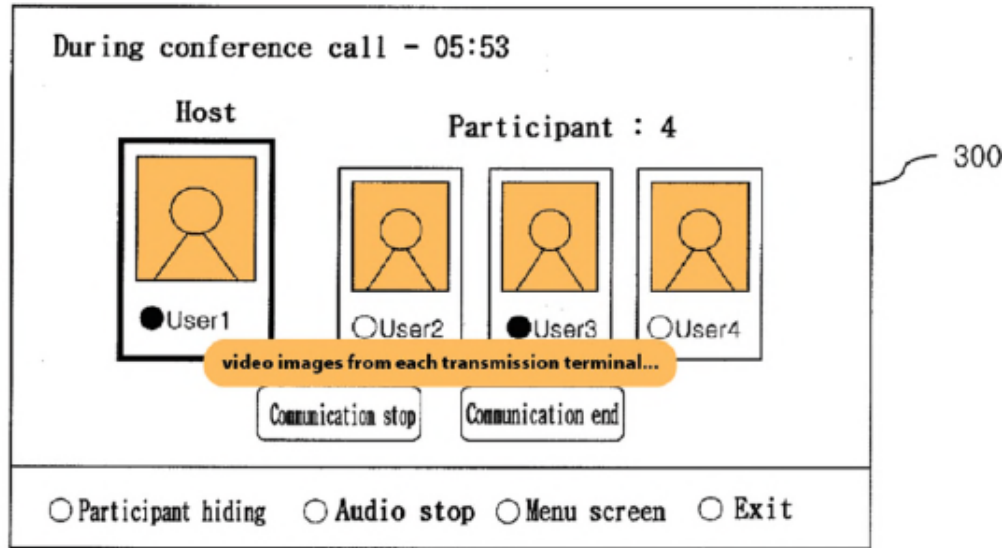
user in the first place. Yet, the cited portions of Lee provide no such mechanism; instead, relying on a single camera to capture video of the entire room (with each participant) in one single video stream. EX1004, ¶[0086], FIG. 1.

Accordingly, the only interpretation of “icon” that is consistent with Lee’s disclosure is that the icons displayed on the terminals are static images that represent various objects/attendants, distinct from the video streams displayed by the teleconferencing system. Petitioner provides no explanation to the contrary, only baldly asserting that Lee’s FIG. 12 shows the terminal “has a display screen displaying video images.” Pet., 57-58. The depth of Petitioner’s analysis is that the attendant icons look like people and must be a video stream; but, as explained above, this is squarely contradicted by Lee.

As the attendant “icons” displayed in the client terminals do not “display video images from each transmission terminal attending the video communication simultaneously,” Petitioner’s Ground 1 fails.

2. Nam does not simultaneously display “video images from each transmission terminal”

For Ground 2, Petitioner’s Nam-based obviousness theory makes the same errors—mistaking static icons for video images. Petitioner contends that Nam’s FIG. 33 (below and *annotated by Pet’r* to add “video images” text) supplies the missing limitation because it discloses a conference call with a plurality of users simultaneously in which the participants are shown as “video images.” Pet., 81-82.



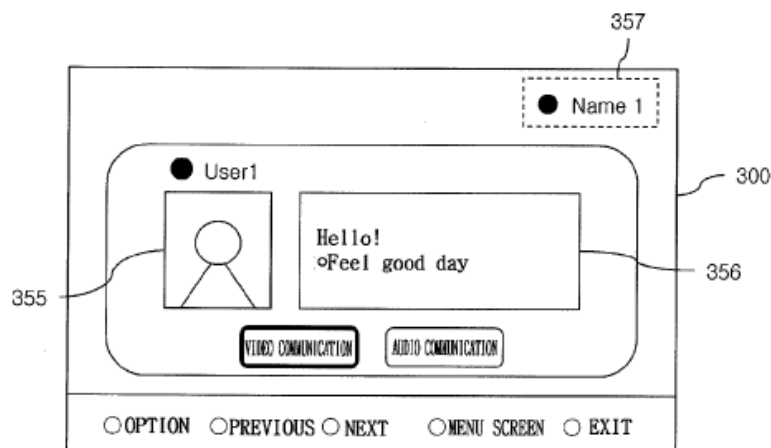
However, Nam makes clear that Petitioner’s annotated orange-highlighted images are “icon[s].” EX1005, ¶[0204]; *see also id.*, FIGs. 34-37, ¶¶[0208]-[0217] (confirming the above images are “icons” and providing a video communication button for requesting “video communication” with a user associated with one of the icons). Nam also makes clear that its “icons” are distinct from video streams—which Nam refers to as “communication image.” EX1005, ¶¶[0144]-[0149] (differentiating static “icon” from “communication image” shown in video conference); *see also id.*, ¶¶[0210]-[0211] (differentiating user 1 “icon” of FIG. 33 from “video communication”). Accordingly, Petitioner’s Ground 2 theory relies on the same mistake, as Nam’s static “icons” are not video images.

Petitioner also cites to a separate interface of Nam in which two users can have direct video communication (FIG. 17), but that is distinct from the multi-participant “conference call” interface shown in FIG. 33. Pet., 85-86. Petitioner

does not reconcile these two distinct interfaces or explain how Nam's one-on-one video conference would result in Lee's terminal displaying a video stream of multiple different attendants. *See* Pet., 85-88. Independent of Petitioner's unexplained and conclusory assertions—which cannot establish obviousness—Nam's videoconferencing does not disclose the claimed feature.

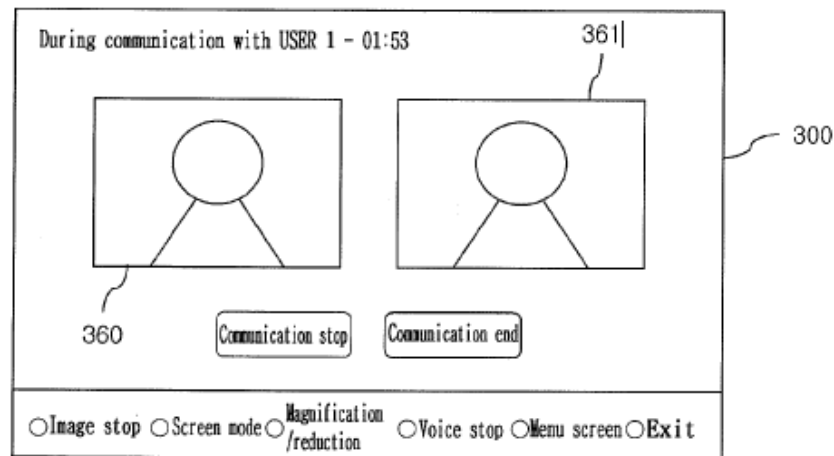
Nam's interface allows the “current user at the display device 10” to select a single user (e.g., “user 1”) to have video communication with from among multiple user icons as shown in FIG. 9. *See* EX1005, ¶[0144]. The resulting interface, shown in FIG. 14 (below), depicts an “icon 355” of user 1 and a “video communication” button to request “image communication” with user 1. *Id.*, ¶[0145].

FIG. 14



“When the user selects the ‘video communication’ button, the communication image 360 of the other party at another device and the communication image 361 of the current user at the display device 10 may be displayed on the screen 300 as shown in FIG. 15.” EX1005, ¶[0149].

FIG. 15



This user-to-user communication fails to meet the claimed features, as it does not display video images “from each transmission terminal,” which Petitioner identifies as the multiple terminal users of Lee’s conference system (or multiple conference participants of Nam’s conference call). Accordingly, Nam’s one-on-one video communication does not supply the missing limitation.

Additionally, the implementation of a user-to-user video conference would make little sense in light of Lee’s conference room architecture. As explained in Section I.A.1, Lee does not capture individual video of the users and, instead, uses a single camera (20/35) to capture video of the entire conference room that is then displayed on a separate monitor (21). Nam also does not disclose capturing and displaying individual video of multiple users in a conference. Thus, there is no evidence-backed explanation to arrive at the features of Limitation [1.g].

Further, displaying a video from each PC terminal (14/33) on one of Lee's terminals is not possible via Lee's existing hardware and several additional camera sources would need to be added, which would overlap with the existing video stream. Such a modification would be superfluous and conflict with Lee's system, which already display the participants on a separate, larger monitor. *See* EX1004, FIG. 1 (monitor 21 is larger than terminals 14/33). Further, such a modification would offer no benefit over Lee's existing setup, as Petitioner's alleged improvement—to “gauge the reactions of other participants” (Pet., 88)—was already achieved via Lee's teleconference monitor 21.

B. Petitioner's Grounds fail to disclose or render obvious other claimed limitations

1. Limitations [1.a]/[9.a]/[10.a]/[17.a]: the GUI elements shown on Lee's terminals are not stored in the conference server

Both Grounds rely solely on Lee for Limitation [1.a]. Pet., 85-88. However, the Petition does not show that Lee's “attendant information storage section 42” stores Lee's first and second “attendance states,” as required by its mapping.

Petitioner identifies the “attendant information storage section 42” (“AIS section” 42) of Lee's conference server 11 as the claimed *storage medium*. Pet., 37; EX1004, FIG. 7. Petitioner then identifies the “attendant information file”—which is prepared after the server “receives personal data indicating the name, mail address and IP address of the attendants operating the respective client PCs” (EX1004,

¶[0122])—as the claimed first and second identification names. Pet., 38. However, Petitioner concedes this “attendant information file” does not disclose storing the claimed “attendance state[s] associated with those terminals.” Pet., 38-40. Instead, Petitioner relies on an obviousness theory “to store [the] attendance state in ... [AIS] section 42.” Pet., 40.

To start, Petitioner’s obviousness theory tries to fill Lee’s missing disclosure via expert testimony. But this violates Rule 104 and cannot support institution. *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) at 1 (“expert testimony ... may not be used to supply a missing claim limitation.”)

Aside from its procedural failings, Petitioner’s theory is supported solely by unexplained and conclusory expert testimony that is insufficient to meet Petitioner’s burden. Petitioner asserts that the use of a “shaded” display and a “normal” display for an icon on the chairman’s terminal “reflects an attendance state” and proposes to modify Lee “to store that attendance state in Lee’s ... [AIS] section 42 (storage medium).” Pet., 39-40. But this modification conflates different aspects of computing operations. The shaded/normal display of the attendant icons on the chairman’s terminal 14 (EX1004, FIG. 4A) are GUI elements rendered by software stored at that terminal (e.g., on a monitor). EX1004, ¶[0102] (“the GUI program displays GUI screens corresponding to the teleconference control program”), FIG. 3

(GUI program). Even if this GUI element “reflects an attendance state,” it is illogical to “store *that* attendance state” (i.e., the displayed GUI element) in AIS section 42 of conference server 11, as Petitioner alleges. Pet., 39-40. In fact, conference server 11 does not even include a GUI program—the very mechanism that Petitioner alludes to for the attendance state. EX1004, FIG. 6.

Petitioner does not identify what exactly is being stored in AIS section 42 or how a shaded/normal display icon rendered via a GUI program at one terminal is being stored internally in a separate computer (conference server). Accordingly, Petitioner’s modification lacks particularity as it is unclear what element is being mapped to the claimed first and second attendance states or how Lee’s AIS section 42/conference server 11 is being modified to store GUI display elements. *Harmonic Inc.v. Avid Tech, Inc.*, 815 F.3d 1356, 1363 (“[T]he petitioner has the burden from the onset to show with particularity why the patent ... is unpatentable.”).

Finally, Petitioner’s conclusory motivation is contradicted by Lee itself. Citing the same shading/normal display change operations, Petitioner contends its modification is necessary because “Lee’s server must maintain and update attendee status information to determine who is attending, who is authorized, whether the chairman is present, and whose information should be transmitted to participating terminals.” Pet., 40. But Lee’s operation confirms that the storage of any attendance state information in Lee’s conference server 11 is not required.

In Lee's operation, when *conference server 11* receives "a conference leaving request" from a terminal, it "[i] sends a conference leaving notice to the chairman terminal (step ST18) and [ii] updates the contents of the attendant information file in the [AIS] section 42 (step ST19)." EX1004, ¶¶[0174]-[0175]; FIG. 20. Once the chairman terminal receives the conference leaving notice (step ST27), "the chairman terminal"—*not* the conference server—"updates the display screen which displays the attendants so that the display of the leaving attendant is shaded." *Id.*, ¶[0176].

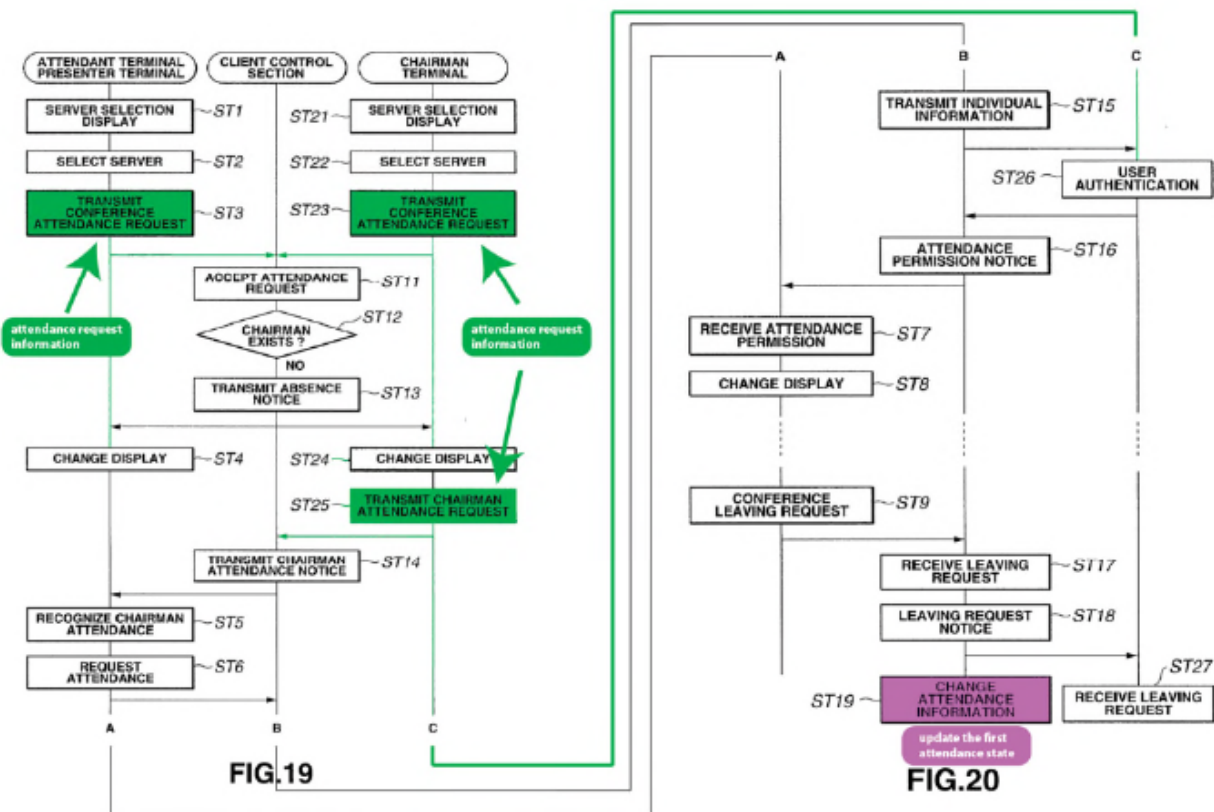
The updated attendant information file in the [AIS] section 42 is *not* sent to Lee's chairman terminal, which updates the shaded/normal display icon based solely on the conference leaving notice. EX1004, ¶¶[0174]-[0175]. That is, the operation to update the shaded/normal display icon is performed via a terminal—not a conference server—and is performed independent of the information file stored in the AIS section 42 of the conference server. *Id.* Accordingly, Petitioner's motivation—that conference server 11 "must maintain and update attendee status information"—is contradicted by the actual operation within Lee.

2. *Limitations [1.b]/[9.b]/[10.b]/[17.b]: the identified "update" is not "to a state indicating that the first transmission terminal is attending a video communication"*

Limitation [1.b] recites to "update the first attendance state ... to a state indicating that the first transmission terminal is attending a video communication, based on attendance request information for video communication." However, the

only “update” identified by Petition is for a terminal “leaving” a conference, not attending a video communication.

The Petitioner relies solely on Lee for Limitation [1.b]. Pet., 85-88. Petitioner identifies Lee’s step ST19 (purple highlighting below) as updating the first attendance state. Pet., 44 (citing EX1004, FIGs. 19-20 (annotated by Pet’r)).



As described by Lee and conceded by Petitioner, the identified “update” occurs when a terminal “leaves during the conference.” EX1004, ¶[0174]; Pet., 44. That update—to indicate a user *disconnected* from the conference—would *not* “indicat[e] that the first transmission terminal is attending a video communication.” Thus, any update in the attendant information file at step ST19 would not meet the claim.

To the extent that Petitioner intends to assert that some other communication in Lee would meet the claimed feature, this would render its claim 1 mapping inconsistent. As explained above in Section I.A.1, Petitioner alleges the “first attendance state” is the information of the attendant information file stored in AIS section 42. Pet., 37-38. However, none of the other steps described in FIGs. 19-20 update this attendant information file. EX1004, ¶[0162] (attendant information file is created at step ST11); *see id.*, ¶¶[0157]-[0179] (updating attendant information file only when the terminal leaves the conference). Accordingly, Petitioner’s mapping either fails to teach the claimed feature or is inconsistent with its previous mapping of the “first attendance state.”

II. THE CIRCUMSTANCES FAVOR DENIAL

The ’548 Patent issued from an application that first published October 1, 2020, as US 2020/0314383A1. *See* EX1001, 1/29 (§(65) Prior Publication Data). The ’548 Patent claims priority to three earlier U.S. patents: (1) U.S. Patent 10,735,689, which first published in June 2017 and issued in August 2020 (EX2001, 1/28); (2) U.S. Patent 9,621,848, which first published in June 2016 and issued in April 2017 (EX2002, 1/28); and (3) U.S. Patent 9,307,197, which first published in February 2012 and issued in April 2016 (EX2003, 1/27). *See* EX1001, 1-2/29 (§(60) Related U.S. Application Data). The ’548 Patent was first published in October 2020 and ultimately issued on January 3, 2023. EX1002, 86, 446.

On April 11, 2024, Patent Owner notified Petitioner of the '548 Patent and its relevance to Petitioner's products, services, and software. EX2004, 9.

On August 29, 2025, Patent Owner sued Petitioner for infringement of seven patents, including the '548 Patent. EX2004, 4, 55-57, 63-65.

Petitioner moved to dismiss, asking the Court to invalidate all asserted patents, including the '548 Patent, under 35 U.S.C. § 101. EX2005, 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. EX2005, 5. After full briefing, the Court conducted oral argument on April 1, 2026. EX2006, 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. EX2005, 2, 9-56.

On August 4, 2026, Petitioner filed its IPR Petition against the '548 Patent.

A. Petitioner's strategic delay favors denial

Petitioner filed its Petition: *fourteen years* after the first parent U.S. patent application was published (EX2003), *ten years* after the parent '197 Patent issued (EX2003), *nine years* after the parent '848 Patent issued (EX2002), *six years* after the parent '689 Patent issued (EX2001), almost *four years* after the '548 Patent issued (EX1001), over *two years* after Petitioner received written notice of its infringement of the '548 Patent (EX2004, 9), *one year* after Petitioner was sued for

infringing the '548 Patent (EX2006), and *three months* after the district court denied Petitioner's § 101 challenge (EX2006). 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 '548 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 to address the overlap and risk of inconsistent rulings inherent in the timing of its Petition. 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, 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, 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 ’548 Patent is one of seven 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”).

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 ’548 Patent—to issue its detailed, 58-page opinion declining Petitioner’s request to invalidate their claims. *See* EX2005. Petitioner’s early prioritization of its invalidity arguments 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. 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 resolving 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. EX2007, 29/30. Because Petitioner had the opportunity to seek AIA review of the ’548 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 ’548 Patent

Patent Owner has settled expectations of its rights in the ’548 Patent. The ’548 Patent issued in January of 2023 and, at the time an institution decision is expected in January 2027, will have been in force for four years. *See* EX1001, 1/29. “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) (Acting Dir. Review) (Precedential).

The strength of Patent Owner’s settled expectations is further underscored by the public notice of the ’548 Patent and its patent family. *Id.*, 3 (“actual notice of a patent or of possible infringement is not necessary to create settled expectations”).

Here, U.S. Pat. Pub. No. 2020/0314383 A1, which issued as the '548 Patent, was published in October 2020—over six years before the time an institution decision is expected. EX1002, 86. Because 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”).

The '548 Patent's family also provides further constructive notice. The '548 Patent claims priority to three U.S. Patents that each issued over six years before the Petition was filed. 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: October 12, 2026

Respectfully submitted,
/Chad Wallis/
Chad Wallis (Reg. No. 78,733)

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on October 12, 2026, complete copies of the foregoing Patent Owner's Request for Discretionary Denial of Institution and EX2001-EX2007 were served on Petitioner via email (by consent), at the following email address(s):

asbonner@mayerbrown.com

CMcCraw@mayerbrown.com

CMaier@mayerbrown.com

nciulla@mayerbrown.com

/Chad Wallis/

Chad Wallis (Reg. No. 78,733)