
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HYUNDAI MOTOR AMERICA INC.
Petitioner,

v.

GERM DOME INDUSTRIES LLC
Patent Owner.

PGR2026-00030
Patent No. 12,296,061

**PATENT OWNER'S SUR-REPLY IN SUPPORT OF ITS PRELIMINARY
RESPONSE**

As authorized by the Board (Ex. 3101), Patent Owner Germ Dome Industries LLC (“Germ Dome”) files this sur-reply in support of its request for discretionary denial.

Germ Dome’s request for discretionary denial is based on *Magnolia Medical Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 (Director May 14, 2026). [POPR, Paper 11 at 3-6.] *Magnolia* was decided and made precedential just 12 days before Germ Dome filed its POPR. *Magnolia* raises concerns over AIA reviews complicating rather than simplifying litigation where petitioners raise parallel validity challenges in district court and at the Office, and for the first time applies these concerns as a basis for discretionary denial. *Magnolia Medical Technologies*, Paper 17 at 3; *see also* 10 (referring to “Congress’s stated goals for the AIA to be used as a litigation alternative.”)

Importantly, parallel validity challenge concerns were not addressed in the March 11 Memo. These concerns apply here because Petitioner Hyundai Motor America Inc. (“Hyundai”) launched two nearly simultaneous validity attacks on the ‘061 Patent in parallel district court litigation and in the Office. [See generally POPR at 5-6.] Hyundai does not point to any authority that pre-dates *Magnolia* indicating parallel-validity challenges would be a basis for discretionary denial.

Nor does Hyundai offer any explanation for its parallel validity challenges. While this case is at an earlier stage than *Magnolia*, the concern is the same. Hyundai is not using this PGR as a litigation alternative; rather, it raised one invalidity ground (§ 101 eligibility) before the district court and different invalidity grounds in this PGR (art-based grounds under §§ 102 and 103) at nearly the same time, thereby requiring Germ Dome to simultaneously fight Hyundai's attacks in two different forums. [*Id.* at 6] Notably, Hyundai chose to file a PGR and not an IPR, and so it could have included § 101 grounds in the instant Petition. 35 U.S.C. § 321(b).

Hyundai's assertion that institution would serve the public interest by "streamlining the parallel district court case..." is unavailing. [Hyundai's Reply to POPR, Paper 12 at 4.] Hyundai has already chosen to involve the district court in an invalidity attack that it could have brought in the instant Petition for PGR, but deliberately chose not to. Hyundai's actions are not in line with streamlining the parallel litigation.

Finally, as requested by the Director in the March 11 Memo., Germ Dome also identified facts in its POPR relevant to domestic manufacturing considerations.¹ [*Id.* at 4-5.] Germ Dome agrees that the circumstances of this case do not fit squarely into the domestic manufacturing considerations as they are described in the March 11 Memo. nor does this case have the procedural posture where *Fintiv*-based discretionary denial would normally be granted. That is why Germ Dome did not initially request discretionary denial. However, the new parallel-validity challenge concern described in *Magnolia* does apply to this case, and so Germ Dome requested consideration of its discretionary denial arguments based on new authority not available at the time Germ Dome’s discretionary denial brief would have been due.

EVIA LAW PLC

/Jessica Fleetham /

Jessica Fleetham, Registration No. 70,951
Steven Susser, admitted *pro hac vice*
231 S Old Woodward Suite 220
Birmingham, MI 48009
248.243.1201

Dated: June 10, 2026

¹ It is worth mentioning that Hyundai’s claim “PO does not contend that it practices or licenses the ‘061 Patent in the United States” is incorrect. [Paper 12 at 3 (emphasis in original).] The ‘061 Patent is licensed to Phonesoap, L.L.C. as described in the Declaration of Dean Schumacher, Exhibit 2009 at ¶ 9 (“... As part of the settlement, Germ Dome licensed the ‘380 Patent family, **including the ‘061 Patent**, to Phonesoap.”) (emphasis added).

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that a true and correct copy of the foregoing Patent Owner's Sur Reply in Support its Preliminary Response were served on counsel of record by filing this document through P-TACTS and via email to the following addresses:

Robert C.F. Perez, robert.perez@pillsburylaw.com

Christopher Kao, christopher.kao@pillsburylaw.com

Brock Weber, brock.weber@pillsburylaw.com

Matthew Grillo, matthew.grillo@pillsburylaw.com

EVIA LAW PLC

/Jessica Fleetham /

Jessica Fleetham

Registration No. 70,951

231 S Old Woodward Suite 220

Birmingham, MI 48009

248.243.1201

Dated: June 10, 2026