

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHORESHADE LLC

Petitioner,

v.

SOLBELLO, INC.

Patent Owner.

PGR2026-00064

Patent RE50606

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

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EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. RE50606 (“the Reissue Patent”)
1002	Declaration of Stephen Melamed
1003	Mr. Melamed’s Curriculum Vitae
1004	Prosecution History for Reissue Patent
1005	U.S. Pat. App. No. 62/892,700 (“Provisional Application”)
1006	Prosecution History for Provisional Application
1007	PCT/US2020/038920 (“PCT Application”)
1008	Prosecution History for PCT Application
1009	U.S. Pat. No. 11,596,211 (“Original Patent”)
1010	Prosecution History for Original Patent
1011	Prosecution History for Related European Pat. App. No. 4,585,774 (the “European Application”)
1012	U.S. Pat. Publ. No. 2013/0019794 to Neal (“Neal”)
1013	DE202014103145U1 (“German Reference”)
1014	Certified Translation of German Reference
1015	U.S. Pat. Publ. No. 2008/0196754 to Saiz (“Saiz”)
1016	U.S. Pat. No. 10,190,330 to Barnes et al. (“Barnes”)
1017	Initial Litigation Complaint, Filed Nov. 7, 2025
1018	First Motion for Preliminary Injunction, Filed Nov. 7, 2025
1019	Petitioner’s Motion to Dismiss Initial Litigation Complaint, Filed Nov. 19, 2025

Exhibit No.	Description
1020	Petitioner's Response to First Motion for Preliminary Injunction, Filed Nov. 19, 2025
1021	Order Denying First Motion for Preliminary Injunction, Entered Dec. 22, 2025
1022	Rule 26(f) Report in Litigation, Filed Feb. 17, 2026
1023	Order Staying Litigation, Entered Feb. 23, 2026
1024	Second Motion for a Preliminary Injunction, Filed Apr. 30, 2026
1025	Response to Second Motion for Preliminary Injunction, Filed May 7, 2026
1026	Order Denying Second Motion for Preliminary Injunction, Entered May 18, 2026
1027	Scheduling Order of May 26, 2026
1028	Solbello's Infringement Contentions of June 15, 2026
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1033	Motion to Stay District Court Case, Filed July 2, 2026
1034	District Court Invalidity Contentions, Served July 23, 2026
1035	Transcript for May 8, 2026 Hearing

I. INTRODUCTION

Discretionary denial is inappropriate in this PGR proceeding, where institution is favored. The Petition presents five independent grounds to invalidate U.S. Pat. No. RE50606 (“Reissue Patent”), supported by an 83-page expert declaration. Petitioner provided a *Sotera* stipulation in the district court proceedings and also does so here.¹

Patent Owner's arguments for discretionary denial exaggerate the court's previous consideration of validity issues, admit that any trial in the district court would likely occur after the Board's statutory deadline, and attempt to avoid institution because of some late-asserted claims alleged to be infringed in the litigation only under the doctrine of equivalents.

Due to a concession by Patent Owner **agreeing to a narrower claim construction that mooted the issue**, Section 112 arguments were dropped at the second preliminary injunction hearing, with Petitioner's counsel stating that

¹ Petitioner was unaware of the Board's guidance against including discretionary issues in the Petition and thus included initial discussion on discretionary denial in its Petition in error. Petitioner regrets any resulting inconvenience.

Petitioner would “skip over the 112 argument.”² Consequently, the court’s validity determinations were focused only on whether claim 44 had “novelty” (i.e., the Section 102 arguments, not the additional Section 112 or Section 103 grounds in the Petition). Patent Owner, however, has since contended that claim 44 should be construed more broadly than the agreed claim construction considered by the court (*see* Ex. 1028 at 26), putting the unresolved Section 112 issues at issue again.

Regarding the Section 102 grounds the court did consider, the statement in the court’s order on which Patent Owner relies is largely dicta as it was unnecessary to reach the court’s ultimate conclusion that the injunction should be denied, and the court did not provide any substantive reasoning on this issue. Also, the record considered by the court was substantially different from that presented by the Petition because the court’s determination was made without the benefit of any expert testimony. The court also made clear that “Defendant is not precluded from challenging validity in future briefing or at trial,” showing that the court was not definitively ruling on the issue (which was presented in briefing for the first time a

² The court’s order only states that Patent Owner argued that the Reissue Patent “has a presumption of validity and does not lack novelty,” (Ex. 1026 at 8), showing the written description and enablement arguments were not considered after Patent Owner’s claim construction concession noted above.

day before the hearing). If institution is denied, Petitioner will absolutely pursue all these same grounds through to trial, but this time with the benefit of expert testimony and additional evidence that is the subject of the Petition.

No trial date has been set by the court, so Patent Owner's contention that the court might render a validity determination "before or soon after the Board's statutory deadline" (Paper 10 at 8) is pure speculation. Moreover, even in the unlikely event that the court declines to stay the court action while this PGR proceeding is pending, Patent Owner seems to acknowledge that the trial could occur several months after the Board's statutory deadline at the earliest. If calculated correctly, the earliest the court would likely reach a validity determination under the rosiest scenario for Patent Owner is in the first half of 2028, well after the Board's statutory deadline of December 30, 2027.

Patent Owner also contends that discretionary denial is appropriate because there are additional claims being asserted in the litigation that are not addressed by the Petition. None of these claims, however, were mentioned in the Complaint or either of the two motions for preliminary injunction that Patent Owner filed. Moreover, none of these claims is alleged to be literally infringed. That Patent Owner has also asserted some throwaway claims in the litigation only under the doctrine of equivalents should not result in discretionary denial as to the more important claims.

Given these issues, discretionary denial is inappropriate.

II. THE BOARD SHOULD INSTITUTE POST-GRANT REVIEW

The Board balances six factors in considering discretionary denial when parallel litigation is ongoing. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). In this PGR proceeding, the *Fintiv* factors and other considerations, including the Interim Processes for PTAB Workload Management,³ weigh strongly against discretionary denial.

A. Factor 1 favors institution (possibility of a stay)

The litigation is pending in the Southern District of Georgia. A stay would be appropriate under the relevant legal standard, particularly if a PGR is instituted. A Motion to Stay pending the outcome of this PGR was filed on July 2, 2026, Ex. 1033, is fully briefed, and the parties are awaiting a decision from the court.

Caselaw suggests the stay will be granted. Courts in the Eleventh Circuit have frequently granted stays when an IPR or a PGR was awaiting an institution decision by the PTAB. *See, e.g., Doubleday Acquisitions LLC v. Envirotainer AB*, No. 1:21-cv-03749, 2022 WL 18778991, at *5 (N.D. Ga. June 3, 2022). “In the patent litigation context, courts have reasoned that a stay pending a related [PTAB] proceeding should

³ Interim Processes for PTAB Workload Management (March 26, 2025), <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>.

be liberally granted, especially when the [PTAB's] review may assist the court in disposing of the civil action.” *Phelan Grp., LLC v. Mercedes-Benz Grp. AG*, No. 1:25-cv-1399, 2025 WL 3303050, at *2 (N.D. Ga. Oct. 3, 2025) (emphasis added) (additional citations omitted). After a decision to institute, a stay is even more likely.

The court case is still early in the proceedings. While Patent Owner filed its litigation Complaint on November 7, 2025, Ex. 1017, Patent Owner has filed two separate motions for a preliminary injunction, both of which have been denied. Petitioner filed a motion to dismiss (Ex. 1019) and its response to the preliminary injunction motion (Ex. 1020) on November 19, 2025, stating that no infringing act (e.g., making, using, offering to sell, selling, or importing) had occurred since the grant of the Reissue Patent for the accused first generation product and that Petitioner was moving in any event to a second generation product. A hearing was conducted on December 1, 2025, resulting in entry of an order on December 22, 2025, denying the first motion. Ex. 1021. Based on agreement of the parties, the case was stayed on February 23, 2026, pending a ruling on the initial motion to dismiss. Ex. 1023.

On April 30, 2026, while the case was stayed, Patent Owner filed a second preliminary injunction motion focusing exclusively on Petitioner's second generation product. Ex. 1024. Petitioner filed a response to the second preliminary injunction motion (Ex. 1025) on May 7, 2026, and a hearing was conducted the next day (on May 8, 2026). The court denied the second preliminary injunction motion

on May 18, 2026,⁴ concluding that Patent Owner failed to show a likelihood of success on its infringement claims for the second generation product. Ex. 1026.

The court has since entered a Scheduling Order (Ex. 1027) resulting in service of Patent Owner's infringement contentions (Ex. 1028) and invalidity contentions (Ex. 1034). The parties have proceeded through further claim construction deadlines which, if the case continues, will eventually lead up to a claim construction hearing at an unscheduled date in the future. No other discovery has been conducted in the litigation and no discovery requests have been served.

Given the early stage of the case, a stay of that proceeding is relatively likely, particularly if this Petition is instituted, and this factor favors institution.

B. Factor 2 favors institution (proximity of trial date to final written decision)

Fintiv states that, “[i]f the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” IPR2020-00019, Paper 11 at 9. Where the trial date is after the projected statutory deadline, this has weighed against

⁴ The court also lifted the stay in the same order denying the second motion for a preliminary injunction.

discretionary denial. *Canadian Solar Inc. v. Maxeon Solar Pte. Ltd.*, IPR2024-01040, Paper 13 at 13–14 (PTAB Jan. 14, 2025).

Any final written decision in the PGR will be due by December 30, 2027. Patent Owner states that a trial would likely “be completed by early April 2028, based on national time-to-trial statistics,” Paper 10 at 10, but this would be over three months after a final written decision is due.

While no trial date or pretrial conference date has been set in the court litigation, the trial date will likely fall well after the Board's statutory deadline, even assuming the court does not grant a stay. With a stay, any final written decision would of course occur long before any trial in the litigation.

Assuming that the court enters a claim construction order on March 1, 2027 (the February 28, 2027 suggested by Patent Owner falls on a Sunday), which is three months after reply claim construction briefs are submitted, the last day for filing civil motions (e.g., motions for summary judgment) would be on October 27, 2027.

Patent Owner's brief ignores that, pursuant to the local rules in the district court, thirty-five (35) days would be necessary for full briefing to occur on a motion for summary judgment, including a response and a reply, so any reply would be due on December 1, 2027. Sur-reply briefs will likely be requested. After that, the court would need to conduct a hearing for any summary judgment motions and enter an order for any motions. The parties would also need to file motions in limine, and the

court would need to resolve motions in limine and conduct a pretrial conference before a trial could occur. Much of this work would be conducted during the December holidays, resulting in further delays in the schedule. Given all of this, any trial in the court case would presumably occur in the first half of 2028 at the earliest, even assuming there are no delays in this case.⁵

However, there is no guarantee that the current schedule will be maintained. The case has already been stayed once, and no written discovery requests have been served by either party. Additionally, Petitioner filed a partial motion to dismiss on unrelated grounds on June 1, 2026. Given that this motion remains unresolved, the pleadings still are not closed. The uncertainty of the trial date also causes this factor to favor institution. *See Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 8–10 (PTAB June 16, 2020) (uncertainty over trial date weighed against discretionary denial); *see also Multi-*

⁵ In *Bentley Motors Ltd. v. Jaguar Land Rover Ltd.*, No. IPR2019-01539, Paper 9 (PTAB Mar. 10, 2020), fact discovery had already closed on January 17, 2020, well before the decision denying institution on March 10, 2020. Here, some papers required under claim construction deadlines have been exchanged but no discovery requests have been served, and the stage of the proceedings is drastically different from the stage of proceedings in *Bentley Motors*.

Color Corp. v. Brook & Whittle Ltd., PGR2025-00025, Paper 10 at 2 (PTAB July 16, 2025) (precedential) (instituting PGR proceeding even when the trial date was four months before the final written decision due date). This factor favors institution.

C. Factor 3 favors institution (investment in parallel proceeding)

While the court has entered two orders denying Patent Owner's motions for preliminary injunction asserted by Patent Owner, these did not involve a substantial investment into the invalidity issues. The orders largely focused on Patent Owner's failure to show infringement on both occasions.

In the most recent preliminary injunction order, the court stated as follows:

During the May 8, 2026 Hearing, Plaintiff argued the '606 Patent has a presumption of validity and does not lack novelty, distinguishing it from the prior art submitted by Defendant. For the purposes of deciding this motion, the Court finds Plaintiff successfully rebutted Defendant's challenges to validity with contrary evidence. Although the Court finds Defendant did not create a substantial question as to validity at the preliminary injunction stage, Defendant is not precluded from challenging validity in future briefing or at trial. (internal citations omitted).

No further reasoning was provided in the order regarding validity.

While Section 112 arguments were discussed in the briefing, they were not discussed in the hearing, with Petitioner's counsel stating that it would "skip over

the 112 argument.” Hearing Transcript (Ex. 1035) at 22:25–23:4. This was because Patent Owner agreed earlier in the hearing to Petitioner’s proposed narrower claim construction of the term that is the subject of the Section 112 issue. *Id.* at 3:9–18. However, Patent Owner characterized its concession on claim construction as being merely for the purposes of that motion. *Id.*

Patent Owner’s infringement contentions (Ex. 1028 at 26) reveal that it now intends to walk back from that concession, using a broader construction. This construction puts unresolved Section 112 issues squarely at issue again, with written description challenges and enablement challenges being fatal to the claims. Additionally, claim construction remains unresolved.

Patent Owner cites *Peloton Interactive, Inc. v. ICON Health & Fitness, Inc.*, IPR2021-00342, Paper 14 at 12 (PTAB July 7, 2021), but the facts weigh even more strongly against discretionary denial here than in that case. Unlike *Peloton*, the parties here have not spent millions of dollars litigating in the court, and expert reports have not been generated in the district court proceedings. While seven depositions occurred and 83,000 pages of documents had been exchanged in *Peloton*, no depositions have occurred and no discovery requests have been served in the district court proceedings here. Similar to *Peloton*, while invalidity was presented as an issue at the preliminary injunction stage, the court focused on a failure to show a likelihood of infringement in resolving the preliminary injunction motions. The

petitioner in *Peloton* noted that the court had only read “a total of ten pages of invalidity briefing and s[at] through a few minutes of oral argument,” *id.* at 11, similar to the amount of material the court reviewed here. Also as in *Peloton*, no issues exist, such as claim construction, that the court has already resolved that would be duplicated here. *Id.* at 12. This factor favors institution.

D. Factor 4 strongly favors institution (overlap in issues)

As was done in *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential), Petitioner stipulates that it will not pursue in the litigation the grounds it raised or could have reasonably raised in the Petition if this proceeding is instituted. This ensures that any post-grant review is a “true alternative” to the district court proceeding. *Id.* at 19. Given this stipulation, any concerns of duplicative efforts between the court and the Board, as well as concerns of potentially conflicting decisions, are mitigated. *Id.* Patent Owner's overlap arguments do not give appropriate consideration to this *Sotera* stipulation.

If the final written decision cancels the claims raised in the Petition, those claims will no longer need to be addressed in the litigation. If the final written decision does not cancel the claims, then this would simplify the issues by focusing the remaining litigation for these claims on issues of non-infringement, providing further clarity on the appropriate constructions for various claims, and informing

subsequent litigation proceedings if any issues remain at that point.⁶ *MED-EL Elektromedizinische Geräte GmbH v. Sonova AG*, IPR2020-00176, Paper 13 at 15 (PTAB June 3, 2020) (stating that overlap may inure to the district court's benefit by simplifying issues for trial should the Board reach its determination on the challenges raised in the Petition before trial).

Patent Owner asserts additional patent claims in the district court proceeding that are not asserted here, but Patent Owner's own actions reveal a lack of confidence in those claims. Patent Owner does not mention any of these additional claims in the Complaint and never asserted these additional claims in the district court litigation during the preliminary injunction proceedings. Instead, Patent Owner made the strategic decision to then assert only claim 44 (presumably because it believed that its infringement argument was stronger for claim 44 than for the other claims). Patent Owner only raised these additional claims in its infringement contentions submitted after losing on the preliminary injunction motions and shortly before this Petition was filed. Moreover, Patent Owner concedes these additional claims are not literally infringed by relying solely on the doctrine of equivalents. Ex. 1028 at 28, 30. It is

⁶ Even for additional claims that Patent Owner now asserts in the litigation, the PGR is likely to be helpful to the court by, for example, simplifying claim construction.

thus apparent that Patent Owner itself realizes that the infringement allegation for these claims is weak. Thus, this factor strongly favors institution.

E. Factor 5 favors institution (whether petitioner and defendant in the parallel proceeding are the same party)

As in most PTAB proceedings, Petitioner is a defendant in the litigation. Ex. 1017. This factor favors institution since the PTAB will fully resolve the validity issues first. *Google LLC v. Parus Holdings, Inc.*, IPR2020-00846, Paper 9 at 21 (PTAB Oct. 21, 2020) (noting that factor could weigh for or against exercising discretion to deny institution, “depending on which tribunal was likely to address the challenged patent first”).

F. Factor 6 favors institution (other circumstances)

The Interim Processes for PTAB Workload Management sets forth various considerations for parties to address in discretionary denial briefing. Petitioner will address each of these issues below and will also show how it acted expediently to get the Petition on file under the circumstances.

i. Strength of the Unpatentability Challenge

The unpatentability challenges presented in the Petition are strong, presenting five different grounds for invalidation of claims 44, 45, and 47 attacking the claims based on entirely different rationales. The strength of the challenges causes this factor to favor institution. *Fintiv*, IPR2020-00019, Paper 11 at 14–15.

ii. Extent of the Petition's Reliance on Expert Testimony

An 83-page declaration was submitted, strongly suggesting that discretionary denial would be inappropriate. Patent Owner ironically asserts in conclusory fashion that the expert declaration is conclusory, but the expert declaration here has significantly more detail than the expert declaration in *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential). In that case, the expert declaration merely repeated, verbatim, the conclusory assertion it was offered to support, with no citation to any additional supporting evidence or any technical reasoning to support his statement. *Id.* In the expert declaration submitted in this case, detailed reasoning was provided by the expert going far beyond merely repeating conclusory assertions. *See, e.g.*, Ex. 1002 at ¶¶ 170–178.

iii. Settled Expectations of the Parties

The Reissue Patent has only been in force for a limited period of time, and no settled expectations have developed regarding the patent rights in the Reissue Patent. The Petition was filed within the statutory window for filing post-grant review, and “[p]etitions for post-grant review are favored because they must be filed no later than nine months from the grant of the patents (35 U.S.C. § 321(c)), are close in time to examination, and occur before expectations in the patent rights are strongly settled.” *Multi-Color*, PGR2025-00025, Paper 10 at 2–3. The Office has declined to find settled expectations for older patents. *Tesla, Inc. v. Bulletproof Property Mgmt.*,

LLC, IPR2026-00204, Paper 14 at 4 (PTAB Director June 15, 2026) (2-years-old); *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11 at 2–3 (PTAB Director June 26, 2025) (5–6 years old at the time of the decision). Any settled expectations in Patent Owner's other patents or alleged awareness of other its patents may not be imputed to the claims of the Reissue. Patent Owner has not otherwise articulated why it has strong settled expectations in the patent.

iv. Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims

As noted above, the issue of validity, even as to the Section 102 grounds, has not been concluded and is still before the court. Moreover, the court gave no substantive consideration to the Section 112 grounds due to Patent Owner's claim construction concession that it has since reversed. The Section 103 ground in the Petition was not before the court in any way in connection with the preliminary injunction proceedings and would also need to be considered in the future.

v. Compelling Economic Interests

The small business status of Petitioner and the location where products are manufactured also weigh against discretionary denial. Petitioner is a small American business, qualifying as a small entity under 37 C.F.R. § 1.27(a). Petitioner does not have its products manufactured in the United States, but neither does Patent Owner, which imports its products from China. Schulze Declaration (Ex. 1029); Ex. 1030

(import records showing Patent Owner imports its products from China); Ex. 1031 (showing box for Patent Owner's product showing that product was made in China).

Patent Owner states that the court “viewed the evidence on infringement of the '606 Patent as presenting a close call.” Paper 10 at 4. That misinterprets the court's order. Patent Owner agreed to construe a term in claim 44 as “at least one rib located proximate the top end of said mast, and specifically designed to rotate relative to the mast.” Ex. 1026 at 8–9.⁷ Patent Owner argued that claim 44 was infringed under the doctrine of equivalents if the accused device rotated as a whole, i.e., the mast itself rotated relative to the ground. Ex. 1026 at 9. The court only noted that, “[b]ased on the evidence submitted, the issue of whether the ShoreShade rotates is, at best, a draw” and that the court could not “determine it is more likely than not that the [accused product] rotates with the wind.” Ex. 1026 at 13. Because Patent Owner could not even establish that the accused product rotated with the wind at all, the court found that the accused product “does not infringe the '606 Patent under the doctrine of equivalents.” Ex. 1026 at 13. As a result, it was unnecessary to reach other more complicated questions that Patent Owner was required to show to resolve infringement under the doctrine of equivalents. Far from a close call, Patent Owner failed to establish even the most basic premise required for its infringement case.

⁷ This is the conceded claim construction that Patent Owner has since walked back.

Despite this, Patent Owner has apparently asserted this same patent (and likely the same exact claim) against at least 12 other businesses in Amazon APEX proceedings. Counsel for Patent Owner stated at the May 8 Hearing: “I believe on Amazon we’ve shut down maybe 12 copycats already in the last year or so that are doing very similar things, frankly, to what ShoreShade is doing.” Ex. 1035 at 15:14–17. Since May 8th, Patent Owner likely has continued asserting the patent against other businesses, and these entities are likely other small businesses. Furthermore, Patent Owner is likely asserting infringement arguments against those entities that have the exact same weaknesses as those presented against Petitioner. “AIA reviews are not solely about resolving ‘a private dispute’” and “[t]he Office institutes review to reconsider its own decision and correct a possible error in the original patent grant” *Magnolia Med. Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 6 (PTAB May 14, 2026) (precedential). Thus, there are public interests for other parties not involved here, making this factor strongly favor institution.

vi. Patent was Improvidently Granted

The PTAB has stated that “the central purpose of IPRs is to determine whether the patent at issue may have been improvidently granted and whether and to what extent that right should continue to be recognized at all.” *Magnolia*, IPR2026-00097, Paper 17 at 7. This is undoubtedly a central purpose in PGR proceedings as well.

Here, Patent Owner has expanded the scope of its patent through a reissue patent application beyond what was disclosed in the application in an attempt to capture other alleged infringers, causing the claims to be invalid for lack of enablement and lack of written description. However, the prosecution history for the Reissue Patent reveals that rejections were never made on these grounds, making it unclear if the Examiner meaningfully considered these issues.

The Petition raises grounds that are not cumulative of prosecution, with certain references never considered by the Examiner. The only prior art relied upon in the Petition that was previously presented to the Office was Saiz. However, Petitioner presents in the Petition an obviousness combination based on Saiz in view of Barnes, and Barnes was never considered during prosecution.

Based on the treatment of similar application claim 41 in the sole office action issued during prosecution of the Reissue Patent, the only substantive limitation of application claim 47, which ultimately became claim 44 of the Reissue Patent, that the Examiner apparently believed was missing from the prior art was “wherein an entire surface area of said sail is unrestrained from the proximal edge to the free edge.” **Importantly, Barnes, which the Examiner did not consider, meets this limitation.** This constitutes a material difference between Barnes, a reference not before the Examiner, and other prior art involved during examination. Thus, Barnes is not cumulative of the art evaluated during examination. The Examiner erred in not

considering Barnes, which relates to the main product of one of the biggest companies in the beach shade market, and erred by failing to cite the free-sailing canopy 12 of Barnes to formulate an obviousness rejection of claims 44, 45, and 47.

vii. Petitioner Acted Expediently to Get Petition Filed

Petitioner filed this Petition quickly enough to fall within the nine-month statutory period for PGR petitions. After the second preliminary injunction motion was denied in May, Patent Owner still was not willing to drop its claims of infringement. Thus, it was only at this time that it became apparent that a petition was necessary. The additional time taken to complete the Petition after resolution of the preliminary injunction motion was not gamesmanship, but sheer necessity. *Peloton*, IPR2021-00342, Paper 14 at 14.

Patent Owner provided supplemental infringement contentions on June 15th, fifteen short days before the Petition's filing. "[I]t is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding." *Fintiv*, IPR2020-00019, Paper 11 at 11.⁸

⁸ Patent Owner inaccurately argues Petitioner did not base its decision of which claims to attack on Solbello's infringement contentions (Paper 10 at 14). Petitioner could not have known it would need to include claims 45 and 47 in its Petition until their addition to the infringement contentions.

Patent Owner's argument that Petitioner delayed in filing the Petition ignores the history set forth above. Also, Petitioner is a small U.S. business and does not have unlimited resources to devote to patent litigation. Petitioner devoted the resources it had to defending against unexpected preliminary injunction motions. "Petitioner had no control over whether or when Patent Owner filed a motion for a preliminary injunction." *Peloton*, IPR2021-00342, Paper 14 at 13. Petitioner worked expeditiously to file the Petition after the second motion's resolution.

III. CONCLUSION

Because each of the *Fintiv* factors favors institution, Petitioner diligently filed this Petition after service of Patent Owner's infringement contentions, and this is a PGR proceeding where institution is favored, the PGR should be instituted.

Dated: September 28, 2026

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PGR of U.S. Pat. No. RE50606
Petitioner's Opposition to Request for Discretionary Denial

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d) and the Interim Director Discretionary Process,⁹ Petitioner hereby certifies, in accordance with and reliance on the word count provided by the word-processing system used to prepare this paper, that the number of words in this paper, including footnotes, is 4,570 and that the number of pages does not exceed 20 pages. Pursuant to 37 C.F.R. § 42.24(a), the word count excludes the table of contents, table of authorities, certificate of service, certificate of word count, and table of exhibits.

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⁹ Interim Director Discretionary Process,

<https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>.

CERTIFICATE OF SERVICE

I certify that, in accordance with 37 C.F.R. § 42.6(e), service was made on
Patent Owner as detailed below.

Date of Service	September 28, 2026
Manner of Service	Electronic Service (by agreement)
Documents Served	- Petitioner's Opposition to Patent Owner's Request for Discretionary Denial - Certificate of Word Count - Petitioner's Exhibit List - Exhibits 1033-35
Persons Served	Ryan K. Simmons Email: docket@wardandsmith.com; rks@wardandsmith.com Joseph A. Schouten Email: jas@wardandsmith.com Mark S. Wigley Email: mswigley@wardandsmith.com Ward and Smith, P.A. 751 Corporate Center Drive Suite 300 Raleigh, NC 27607 919-277-9100

Dated: September 28, 2026

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