

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EP FAMILY CORP.,

Petitioner

v.

OFFICE KICK, INC.,

Patent Owner

Case IPR2025-00471
Patent No. 11,849,843

**PATENT OWNER'S PRELIMINARY REPOSENSE
ON DISCRETIONARY DENIAL**

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. THE BOARD SHOULD EXERCISE ITS DESCRIPTION AND DENY INSTITUTION	3
A. Discretionary Denial is Appropriate Under Section 325(d).....	4
1. Factor (a): “The Similarities and Material Differences Between the Asserted Art And the Prior Art Involved During Examination”	9
2. Factor (b): “The Cumulative Nature of the Asserted Art and The Prior Art Evaluated During Examination”	12
3. Factor (c): “The Extent To Which The Asserted Art Was Evaluated During Examination, Including Whether The Prior Art Was The Basis For Rejection”	19
4. Factor (d): “The Extent Of The Overlap Between The Arguments Made During Examination And The Manner In Which Petitioner Relies On The Prior Art Or Patent Owner Distinguishes The Prior Art”	20
5. Factor (e): Whether Petitioner Has Pointed Out Sufficiently How The Examiner Erred In Its Evaluation Of The Asserted Prior Art.....	24
6. Factor (f): The Extent to Which Additional Evidence and Facts Presented In The Petition Warrant Reconsideration Of Prior Art Or Arguments	24
B. The <i>Fintiv</i> Factors Favor Denial of the Petition	27
1. <i>Fintiv</i> Factor 1: Whether the Court Granted a Stay or Evidence Exists that One May be Granted if a Proceeding is Instituted.....	31

2.	<i>Fintiv</i> Factor 2: Proximity of the Court’s Trial Date to the Board’s Projected Statutory Deadline for a Final Written Decision	32
3.	<i>Fintiv</i> Factor 3: Investment in the Parallel Proceeding by the Court and the Parties	34
4.	<i>Fintiv</i> Factor 4: Overlap Between Issues Raised in the Petition and in the Parallel Proceeding	35
5.	<i>Fintiv</i> Factor 5: Whether the Petitioner and the Defendant in the Parallel Proceeding Are the Same Party	35
6.	<i>Fintiv</i> Factor 6: Other Circumstances that Impact the Board’s Exercise of Discretion, Including the Merits	36
III.	ADDITIONAL FACTORS ALSO SUPPORT DISCRETIONARY DENIAL.....	38
IV.	CONCLUSION.....	38

TABLE OF AUTHORITIES

Cases

<i>10X Genomics, Inc. v. President and Fellows of Harvard College,</i> IPR2023-01299 (PTAB Mar. 7, 2024).....	33
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,</i> IPR2019-01469 (PTAB Feb. 13, 2020).....	3, 5, 6, 8, 14, 24
<i>Apotex Inc. v. Auspex Pharms., Inc.,</i> IPR2021-01507 (PTAB Mar. 9, 2022).....	14
<i>Apple Inc. v. Fintiv, Inc.,</i> IPR2020-00019 (PTAB Mar. 20, 2020).....	4, 27, 29, 30, 32, 33, 35, 36
<i>Apple Inc. v. Uniloc USA, Inc.,</i> IPR2017-00224 (PTAB May 25, 2017).....	24
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG,</i> IPR2017-01586 (PTAB Dec. 15, 2017).....	6, 9, 27
<i>CSL Behring GMBH v. Shire Viropharma Inc.,</i> IPR2019-00459 (PTAB Jul. 2, 2019).....	25
<i>Cultec, Inc. v. StormTech,,</i> IPR2017-00777 (PTAB Aug. 22, 2017).....	14
<i>Cuozzo Speed Techs., LLC v. Lee,</i> 579 U.S. 261, 136 S. Ct. 2131 (2016).....	2, 29
<i>EClinicalWorks, LLC v. Decapolis LLC,</i> IPR2022-00229 (PTAB Apr. 13, 2022).....	33
<i>Edge Endo, LLC v. Maillefer Instruments Holding, S.A.R.L.,</i> IPR2018-01349 (PTAB Jan. 14, 2019).....	26
<i>Eyenovia, Inc. v. Sydnexis,</i> IPR2022-00963 (PTAB Nov. 8, 2022).....	14
<i>Fellowes, Inc. v. Treefrog Devs., Inc.,</i> IPR2020-01509 (PTAB Feb. 22, 2021).....	14

<i>Harmonic Inc. v. Avid Tech., Inc.</i> , 815 F.3d 1356 (Fed. Cir. 2016)	3, 29
<i>Hopkins Mfg. Corp. v. Cequent Performance Prod., Inc.</i> , IPR2015-00613 (PTAB Aug. 7, 2015).....	27
<i>In re Portola Packaging, Inc.</i> , 110 F. 3d 786 (Fed. Cir. 1997)	13
<i>Ivantis, Inc. v. Sight Sciences, Inc.</i> , IPR2022-01529 (PTAB Mar. 21, 2023)	14
<i>Kartri Sales Co. v. Zahner Design Grp.</i> , IPR2016-01327 (PTAB Jan. 3, 2017)	26
<i>Microsoft Corp. v. Koninklijke Philips N.V.</i> , IPR2018-00279 (PTAB June 8, 2018)	14
<i>Neil Ziegmann, N.P.Z., Inc. v. Stephens</i> , IPR2015-01860 (PTAB Sept. 6, 2017).....	24
<i>NetApp, Inc. v. Realtime Data LLC</i> , IPR2017-01195 (PTAB Oct. 12, 2017).....	29
<i>Ocado Grp. PLC v. Autostore Tech. AS</i> , IPR2021-00412 (PTAB July 21, 2021)	14
<i>Puma N. Amer., Inc. v. Nike, Inc.</i> , IPR2019-01042 (PTAB Oct. 31 2019).....	8
<i>SAS Inst., Inc. v. Iancu</i> , 584 U.S. 357 (2018).....	29
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019 (PTAB Dec. 1, 2020)	35, 36
<i>Unified Patents Inc. v. Berman</i> , IPR2016-01571 (PTAB Dec. 14, 2016)	8
<i>United States v. Chemical Found, Inc.</i> , 272 U.S. 1, 47 S.Ct. 1, 71 L.Ed. 131 (1926)	13

Vovomart (HK) Enterprises Co., Ltd. v. Office Kick, Inc.,
PGR2022-00048(PTAB January 12, 2023).....8

Statutes

35 U.S.C. § 314..... 2, 3, 5, 28, 29, 32, 38
35 U.S.C. § 315..... 27, 28
35 U.S.C. § 316.....32

Other Authorities

Consolidated Trial Practice Guide
84 Fed. Reg. 64,280 (Nov. 21, 2019)2, 29

EXHIBIT LIST (37 C.F.R. § 42.63(e))

Exhibit (Ex.)	Description
2003	File History of U.S. Patent No. 11,849,843
2004	U.S. Patent No. 12,193,569
2005	U.S. Patent No. 317,468 (Morstat)
2006	German Patent No. DE102013008020 (Baudermann)
2007	U.S. Patent No. 6,220,558 (Broder)
2008	U.S. Patent Publication No. 2003/0213415 (Ross)
2009	WO1991017906A1 (Lindahl)
2010	U.S. Patent No. 8,950,343 (Huang)
2011	Comparison of U.S. Patent No. 8,950,343 and U.S. Patent Publication No. 2014/0041554
2012	EP531385 B1 (Lindahl)
2013	DE69111809 T2 (Lindahl)
2014	File History of U.S. Patent No. 12,193,569
2015	March 26, 2025 Interim Processes for PTAB Workload Management
2016	<i>EP Family Corp. v. Office Kick, Inc.</i> , Case No. 2:24-cv-00667 AB (PVCx), Dkt. 58 (C.D. Ca. Feb. 4, 2025)
2017	<i>EP Family Corp. v. Office Kick, Inc.</i> , Case No. 2:24-cv-00667 AB (PVCx), Dkt. 52 (C.D. Ca. Jan. 3, 2025)
2018	<i>EP Family Corp. v. Office Kick, Inc.</i> , Case No. 2:24-cv-00667 AB (PVCx), Dkt. 47 (C.D. Ca. Sep. 11, 2024)
2019	<i>EP Family Corp. v. Office Kick, Inc.</i> , Case No. 2:24-cv-00667 AB (PVCx), Dkt. 1 (C.D. Ca. Jan. 24, 2024)
2020	Declaration of Mark Benden Ph.D.

Exhibit (Ex.)	Description
2021	April 28, 2025 Docket Report for <i>EP Family Corp. v. Office Kick, Inc.</i> , Case No. 2:24-cv-00667 AB (PVCx) (C.D. Ca.)
2022	United States District Courts – Judicial Caseload Profiles for District Courts, available at https://www.uscourts.gov/sites/default/files/2025-02/fcms_na_distprofile1231.2024.pdf

Pursuant to 37 C.F.R. § 42.107(a), Patent Owner Office Kick, Inc. submits the following preliminary response on discretionary denial to the Petition for Inter Partes Review of U.S. Patent No. 11,849,843 (the “’843 patent”) (IPR-2025-00471, Paper 2, hereafter “Petition”) filed by EP Family Corp. (“Petitioner”).

I. INTRODUCTION

The Petition includes four Grounds that rely on six prior art references. The Board should exercise its discretion and deny institution pursuant to Section 325(d) at least because a majority of the prior art references (four of the six references) asserted by Petitioner were previously considered by the Examiner during prosecution, including Petitioner’s primary references (Lindahl, Ex. 1011; Clarke, Ex. 1012, and Huang, Ex. 1015), which it relies on its Section 103 Grounds.

Importantly, the Petitioner erroneously asserts that the PTO examiner never considered two of the references (Lindahl, Ex. 1011 and Huang, Ex. 1015) during prosecution. Even a cursory review of the prosecution history (not to mention the cover of the ’843 patent itself) reveals that the examiner considered both references before allowing the patent to issue.

Petitioner’s remaining two references (Yamamoto, Ex. 1012 and Clark, Ex. 1013) are secondary references relied on by Petitioner, and are substantially the same or similar, as well as cumulative, to prior art references of record already considered by the Examiner during prosecution. Petitioner fails to present any new

arguments not already before the Examiner, and Petitioner is nonetheless silent with respect to any error committed by the Examiner during prosecution. Thus, a weighing of the *Advanced Bionics* and *Becton Dickinson* factors supports denial of institution pursuant to Section 325(d).

In addition, the Board has authority to determine whether to institute review, 35 U.S.C. § 314; 37 C.F.R. § 42.4 (a), and may exercise its discretion to refuse institution based on such circumstances as where, like in this matter, a petitioner and the Patent Owner are in a parallel proceeding in district court or other circumstances that impact the Board's exercise of its discretion. Consolidated Trial Practice Guide – November 2019; *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 136 S. Ct. 2131, 2140 (2016) (“the agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); Ex. 2015, March 26, 2025 Interim Processes for PTAB Workload Management (“decisions on whether to institute an IPR or PGR will be bifurcated between (i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations”).

Here, the *Fintiv* factors collectively weigh in favor of discretionary denial of institution. Although a stay was granted in the parallel district court litigation, concerns about the Petitioner’s good faith temper the weight of *Fintiv* Factor 1. Factor 2 supports denial, as the district court’s trial date (as previously set for February 3, 2026 before the stay) precedes the PTAB’s final written decision

deadline by nearly six months, consistent with prior PTAB precedent. Factor 3 also supports denial given the significant investment by the court and parties, including completed claim construction and related orders. Factor 4 favors denial due to the substantial overlap of issues between the Petition and the district court action and the Petitioner's failure to submit a *Sotera* stipulation. Factor 5 weighs toward denial as the parties in the PTAB and district court proceedings are identical. Finally, Factor 6 favors denial because the Petition relies on prior art previously considered by the Patent Office, lacks the required element-by-element analysis for several grounds, improperly incorporates arguments by reference, and relies heavily on expert testimony, further underscoring procedural deficiencies and weak merits on the preliminary record.

II. THE BOARD SHOULD EXERCISE ITS DISCRETION AND DENY INSTITUTION

Institution of inter partes review is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016). The Director has delegated her discretion to the Board. *See* 35 U.S.C. § 314(a); *see also* 37 C.F.R. § 42.4(a).

The Board may deny a petition to institute a proceeding where (a) the petitioned challenges to the patent are based on matters the Office previously considered (*see Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential)), or (b)

there exists parallel district court litigation concerning the same patent. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (designated precedential May 5, 2020) (“*Fintiv*”).

As explained in Subsection II(A), below, discretionary denial is appropriate because all petitioned grounds are based on publications that were either of record during prosecution of the ’843 patent, or are substantially the same as, or cumulative of, publications the Office considered during prosecution. Further, the Petition does not demonstrate how the examiner somehow erred in evaluating the prior art and combinations thereof or in evaluating arguments the applicant presented.

As explained in Subsection II(B) below, discretionary denial also is appropriate because the parties here are involved in a parallel district court litigation concerning this patent where, among other things, the parties will have concluded fact and expert discovery before the statutory deadline for an institution decision in this proceeding, and a jury trial regarding the validity of the challenged patent is scheduled to conclude long before the statutory deadline for a final written decision in this proceeding.

A. Discretionary Denial is Appropriate Under Section 325(d)

To institute *inter partes* review, a petitioner must “demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is

unpatentable.” 35 U.S.C. § 314(a). In particular, Congress gave the Board broad discretion to stop harassment and to “reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

Under Advanced Bionics, first, the Board determines whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office. *Advanced Bionics*, Paper 6 at 8. *Second*, if either of these conditions exists, the Board determines whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Id.*

In evaluating whether to exercise discretion under Section 325(d), the Board weighs the following non-exclusive factors:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or patent owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8, at 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first para.); *see also*, *Advanced Bionics*, Paper 6 at 9–11. Factors (a), (b), and (d) relate to whether the art or arguments presented in the petition are the same or substantially the same as those previously presented to the Office. *Advanced Bionics*, Paper 6 at 10. Factors (c), (e), and (f) “relate to whether the petitioner has demonstrated a material error by the Office” in its prior consideration of that art or arguments. *Id.* Only if the same or substantially the same art or arguments were previously presented to the Office will the Board consider whether petitioner has demonstrated a material error by the Office. *Id.* “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

Here, and as more fully explained below, the six *Becton Dickinson* factors strongly support denying the Petition under § 325(d). For example, Petitioner admits that two of the prior art references (*i.e.*, Clarke (Exhibit 1014) and Zhang (Exhibit 1016)) were already before the Examiner during prosecution. *See* Pet. at 13 (“this Petition relies on six prior art references, four of which were not before the Office during prosecution”); *id.* at 28 (admission regarding Clarke); *id.* at 30 (admission regarding Zhang).

In addition, Petitioner wrongly asserts and argues Lindahl and Huang were “not before the Examiner.” Pet. at 25 (Lindahl) and 29 (Huang). This is untrue. To the contrary, both of these references were submitted in an IDS and considered by the examiner as described below. Thus, four of six references upon which the Petitioner’s arguments rely were already considered by the Examiner during prosecution of the ’843 Patent. The remaining two references were later considered during prosecution of “child” patents to the ’843 patent, but did not prevent those patents from issuing. For example, Examiner Wilkens considered the claims of that child, U.S. Patent No. 12,193,569 (Ex. 2004), to be patentably indistinct from the claims of the ’843 Patent. Ex. 2014 at 183-185. Indeed, those claims are broader than the claims of the ’843 as they lack a platform element. In response, Applicant filed a terminal disclaimer and the patent ultimately issued. *Id.* at 243-246; Ex. 2004.

During prosecution, the Examiner considered the same or substantially similar art and combinations. As described above herein, the examiner has already considered each of Lindahl, Huang, Zhang, and Clarke during prosecution.

With respect to the remaining references that Petitioner asserts (*e.g.*, Yamamoto and Clark), while these were not before the examiner, and as further described below, they are substantially similar with respect to art already considered by the Examiner, and are at best cumulative with respect to features

already considered by the Examiner. Further, Petitioner relies on Yamamoto and Clarke as secondary references to argue against same claim features that the Examiner previously considered with respect to other secondary references of record. Therefore, Yamamoto and Clarke are substantially similar and cumulative to previously considered art for this reason as well.

Still further, Petitioner has failed to dispute or identify any material error in the Examiner's findings. This is improper because Petitioner effectively asks the Board, with its Petition, to re-adjudicate substantially the same issues, and without demonstrating any Examiner error. This is precisely the context in which an exercise of discretion under § 325(d) is appropriate. *See, e.g., Puma N. Amer., Inc. v. Nike, Inc.*, IPR2019-01042, Paper 10 at 10-21 (PTAB Oct. 31 2019) (informative decision) (denying institution of IPR based on art considered during examination); *Unified Patents Inc. v. Berman*, IPR2016-01571, Paper 10, at 12 (PTAB Dec. 14, 2016) (informative decision) (same); *Vovomart (HK) Enterprises Co., Ltd. v. Office Kick, Inc.*, PGR2022-00048, Paper 14 at 7-15 (PTAB January 12, 2023).

As demonstrated below, the *Advanced Bionics* test is satisfied because: (1) four of the references asserted by Petitioner are the same references considered by the Examiner during prosecution; and the remaining two references are substantially the same and cumulative of art previously presented to, and

considered, by the Examiner Wilkens where the Petitioner presents substantially the same arguments previously presented to and considered by the Examiner; and (2) Petitioner has not identified any error committed by Examiner Wilkens at all, much less any error material to the patentability of challenged claims.

These factors are explained in additional detail below in the context of the *Becton Dickinson* factors.

1. Factor (a): “The Similarities and Material Differences Between the Asserted Art And the Prior Art Involved During Examination”

The Petition relies on six asserted references (Exs. 1011-1016) across its four grounds. Each of these references is similar to, and possesses no material differences from, the prior art involved during examination. In fact, three of the references (Exs. 1011 and 1015-1016), either themselves or in the form of a related disclosure, are cited on the cover of the '843 patent, and have been already considered by the same Examiner, Janet Wilkens, who examined not only the '843 patent, but also its parent and children applications.

In addition, Examiner Wilkens discussed Huang (Ex. 1014) in depth in several office actions. *See, e.g.*, Ex. 2004, File History of U.S. Patent No. 11,849,843 at 2908. With respect to Patent Owner's patent portfolio as a whole, to date, Examiner Wilkens reviewed all six prior art references on which the petitioned grounds rely. None of the asserted art has prevented the Examiner from

issuing Patent Owner’s applications, including the ’843 patent. *See, e.g.*, Ex. 2005, U.S. Patent No. 12,193,569 (citing Yamamoto and Clark); Ex. 2014 File History of U.S. Patent No. 12,193,569 at 531-534 (attaching Examiner signed IDS indicating consideration of Yamamoto and Clark to Corrected Notice of Allowability dated December 18, 2024).

For the purposes of convenience, Patent Owner provides the below table that shows the previous citations of the references for all Grounds in this case upon which Petitioner relies:

#	Reference	Grounds	Examiner’s Considerations of Same/Similar Art
1	Lindahl (Ex. 1011)	1, 2	<p>Cited on the cover of the ’843 patent in the form of multiple publications including as WO1991017906 (Ex. 2009) (<i>also</i> Ex. 2003 at 651-64) (Lindahl PCT publication), as EP 531385 B1 (Ex. 2012) (Lindahl EPO publication), and as DE69111809 T2 (Ex. 2013) (<i>also</i> Ex. 2003 at 1858-71) (Lindahl German publication) (collectively the “Lindahl publications”).</p> <p>Patent Owner submitted the Lindahl publications in IDSs, and examiner considered these publications during prosecution of the ’843 Patent. <i>See</i> ’843 File History, Information Disclosure Statement by Applicant (Signed by examiner on Sep. 23, 2022 as “date considered” regarding WO1991017906 and EP 531385) (Ex. 2003, at PDF pages 1482-84 and 1538-55); <i>see id.</i> Information Disclosure Statement by Applicant (Signed by examiner on May 12, 2023 as “date</p>

#	Reference	Grounds	Examiner's Considerations of Same/Similar Art
			<p>considered" regarding DE69111809) (Ex. 2003, at PDF page 2516-21).</p> <p>There is no substantive distinction among these references and Ex. 1011 as cited by Petitioner, where the Petitioner's citations, arguments, and annotated Figures of Lindahl in the Petition (upon which Petitioner's arguments depend) each appear in the Lindahl publications as considered by the Examiner.</p>
2	Yamamoto (Ex.1012)	1, 4	Not cited during prosecution of the '843 patent; but cited during prosecution of continuing patents to the '843 patent; nonetheless, cumulative to references considered for '843 patent.
3	Clark (Ex.1013)	1-4	Not cited during prosecution of the '843 patent; but cited during prosecution of continuing patents to the '843 patent; nonetheless, cumulative to references considered for '843 patent.
4	Clarke (Ex.1014)	2, 3	Cited on the cover of the '843 patent as U.S. Patent 3,282,566; Patent Owner submitted Clarke in an IDS, and the examiner considered this reference. Petitioner admits that this reference was considered by the Examiner. <i>See</i> Pet. at 28.
5	Huang (Ex.1015)	3	<p>Cited on the cover of the '843 patent as U.S. Patent 8,950,343. <i>Compare</i> Ex. 2010, <i>with</i> Ex. 2011 (comparison of disclosures).</p> <p>Patent Owner submitted Huang in an IDS, and the examiner considered this reference. <i>See</i> '843 File History, Information Disclosure Statement by Applicant (Signed by examiner on Sep. 23, 2022 as "date considered" regarding the '343 Patent) (Ex. 2003, at 1538-57).</p>

#	Reference	Grounds	Examiner's Considerations of Same/Similar Art
			There is no substantive distinction between the '343 patent and the publication of its application, where the Petitioner's citations, arguments, and annotated Figures to the publication of the application of Huang (upon which Petitioner's arguments depend) appear in the '343 Patent.
6	Zhang (Ex.1016)	4	Cited on the cover of the '843 patent as CN 203934825; Patent Owner submitted Zhang in an IDS, and the examiner considered this reference. Petitioner admits that this reference was considered by the Examiner. <i>See</i> Pet. at 30.

The two references not cited during prosecution, Yamamoto (Ex. 1012) and Clark (Ex. 1013), are now asserted by Petitioner to argue that “a scissor lift platform where the scissor mechanism is operable from a completely collapsed position to a fully deployed one” and a “platform element” were known in the art, respectively. However, as described below, these features were already considered by Examiner Wilkens during prosecution as shown below for Factor (b). Therefore, these references (Yamamoto and Clark), and their related features upon which Petitioner relies, are at best similar to, cumulative to, and possess no material differences from, the prior art involved during examination.

2. Factor (b): “The Cumulative Nature of the Asserted Art and The Prior Art Evaluated During Examination”

Four of Petitioners' six references—Lindahl, Clarke, Huang and Zhang—are IDS-submitted prior art cited on the face of the '843 Patent—either explicitly or in a form containing an identical disclosure (*e.g.*, a publication of the reference)—and are therefore presumed to have been fully considered by the Examiner, both alone and in combination with other cited references. In fact, the Examiner signed the respective IDSs (as cited above herein) indicating that she considered these references. *See In re Portola Packaging, Inc.*, 110 F. 3d 786, 790 (Fed. Cir. 1997) (noting the examiner is presumed to have fully considered references both alone and in combination as regulations require examiner to evaluate each cited reference and determine which provides the most appropriate statutory ground for rejection), citing 37 C.F.R. § 1.106(b) (“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his command”), and *United States v. Chemical Found, Inc.*, 272 U.S. 1, 15 (1843) (government officials presumed to have “properly discharged their official duties”).

The prosecution history of the '843 Patent shows that the Examiner considered the teachings of these cited references on which Petitioner now relies. For example, communications dated September 30, 2022 and May 12, 2023, the Examiner noted on previously submitted IDSs that “ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH.” Ex. 2003, 1547-1555. None of the references that Petitioner asserts (but were already before the Office)

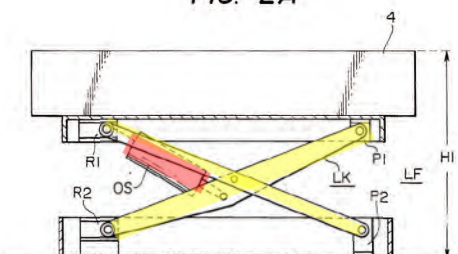
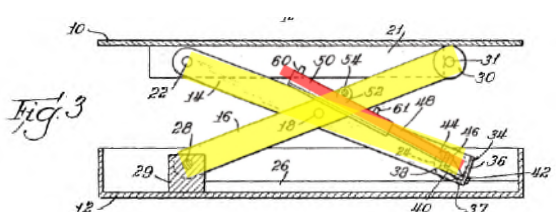
were lined-through by the Examiner, and, thus they were considered. *Advanced Bionics*, Paper 6 at 7–8; *accord Cultec, Inc. v. StormTech*, IPR2017-00777, Paper 7 at 10 (PTAB Aug. 22, 2017) (denying institution under 325(d) where examiner used identical language to indicate consideration of references on IDS); *Ivantis, Inc. v. Sight Sciences, Inc.*, IPR2022-01529, Paper 16 at 16 (PTAB Mar. 21, 2023); *Eyenovia, Inc. v. Sydnexis*, IPR2022-00963, Paper 7 at 10–11 (PTAB Nov. 8, 2022); *Fellowes, Inc. v. Treefrog Devs., Inc.*, IPR2020-01509, Paper 11 at 7–8, 17 (PTAB Feb. 22, 2021); *Ocado Grp. PLC v. Autostore Tech. AS*, IPR2021-00412, Paper 9 at 34–35 (PTAB July 21, 2021); *Microsoft Corp. v. Koninklijke Philips N.V.*, IPR2018-00279, Paper 11 at 12, 14-15 (PTAB June 8, 2018).

There is no requirement for the examiner to have applied any of these publications in a rejection for the publications to have been previously presented to the Office. *Apotex Inc. v. Auspex Pharms., Inc.*, IPR2021-01507, Paper 9 at 25 (PTAB Mar. 9, 2022) (“A reference submitted, but not substantively discussed during prosecution, nonetheless qualifies as prior art previously presented to the Office.”). Nevertheless, as explained below, Clarke was applied in a rejection the applicant overcame.

The remaining two references (Yamamoto and Clark) not cited during prosecution of the ’843 patent, are nonetheless cumulative with respect to art already considered by the Examiner. Specifically, the “scissor lift platform” of

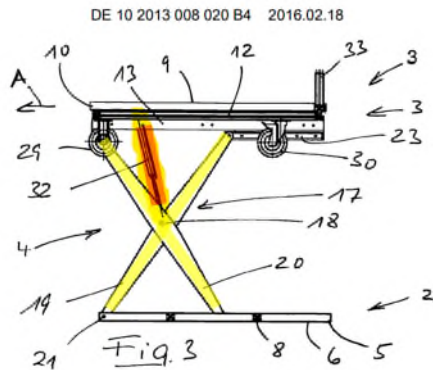
Yamamoto is cumulative of **both** the Morstatt (US 317,468) (Ex. 2005) and Baudermann (DE102013008020) (Ex. 2006) references (and others) examined by Examiner Wilkens during prosecution of the '843 patent. These previously considered references have gas springs in combination with scissor legs and are summarized in the table below.

Each of these references shows a gas spring, spring, or hydraulic cylinder (as highlighted in orange), scissoring legs (as highlighted in yellow). One reference (JPS5861051U) includes a handle (as highlighted in green). All references (except Yamamoto) were previously considered during prosecution (indicated as “cited art”) and have a set of “scissoring legs” and a gas spring/hydraulic cylinder/spring, which are the features for which Petitioner asserts Yamamoto for:

Comparison of Yamamoto With Prior Art Having Gas/Hydraulic or Other Springs and Scissor Leg Features Already Considered by the Examiner During Prosecution of the '843 Patent	
<p>Yamamoto (Ex. 1013): <i>FIG. 2A</i></p>  <p>Scissor Legs and Hydraulic cylinder</p>	<p>Clarke (Ex. 1014) (cited art):</p>  <p>Gas Spring and Scissor Legs</p>

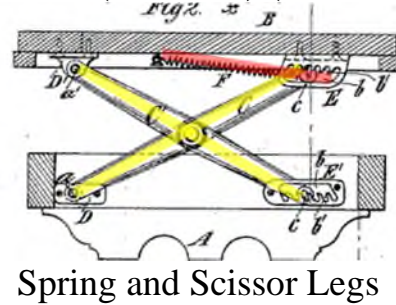
Comparison of Yamamoto With Prior Art Having Gas/Hydraulic or Other Springs and Scissor Leg Features Already Considered by the Examiner During Prosecution of the '843 Patent

Baudermann (Ex. 2006) (cited art):



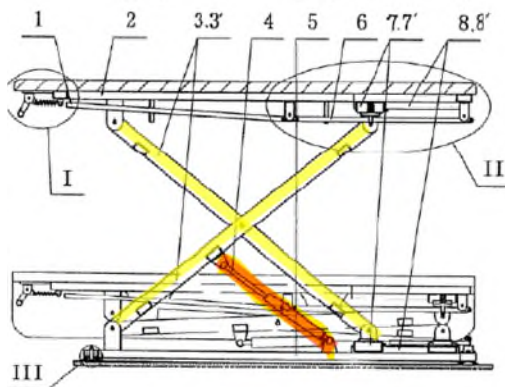
Gas Spring, Scissor Legs and Slidable Surface

Morstat (Ex. 2005) (cited art):



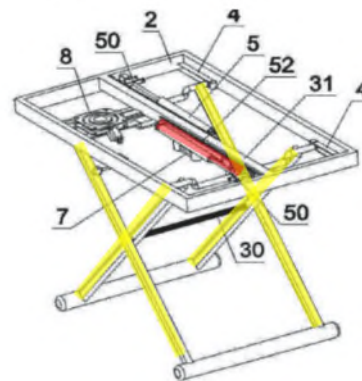
Spring and Scissor Legs

Huang (Ex. 1015) (cited art):



Gas Spring and Scissor Legs

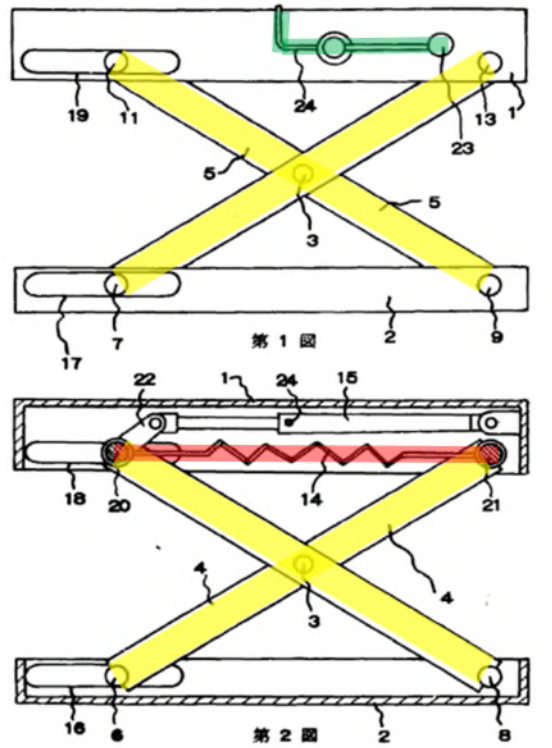
Zhang (Ex. 1016) (cited art):



Gas Spring and Scissor Legs

Comparison of Yamamoto With Prior Art Having Gas/Hydraulic or Other Springs and Scissor Leg Features Already Considered by the Examiner During Prosecution of the '843 Patent

JPS5861051U (Ex. 2003 at 891) (cited art):



実開58-61051

実用新案登録出願人 天龍工業株式会社

101

Spring, Scissor Legs and Handle

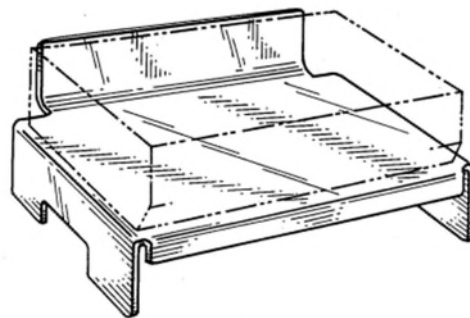
At best, the disclosure of Yamamoto is cumulative of already examined cited art. Yamamoto's failures to disclose additional aspects of the challenged claims, such as a gas spring or handle, render it inferior, or at least cumulative, to Morstatt, Baudermann and/or JPS5861051U, which include such features. Petitioner failed to provide any reasoning of how the Examiner's review of these references was somehow in error, and may not belatedly do so in its reply to this

paper. To be clear, the scissor lift teachings of Yamamoto relied upon by Petitioner fail to provide any more detailed teaching than Morstatt's and/or Baudermann's respective teachings of gas spring and scissor leg configuration, or JPS5861051U's spring, scissor leg and handle configuration, examined during prosecution.

Petitioner asserts Clark (Ex. 1013) regarding the claim element “*a platform element sitting on the work surface platform, the platform element including an elevated platform surface above the work surface platform.*” Clark is a design patent that claims an “original design for a computer printer stand.” However, as shown in the below chart, Clark's design is cumulative of prior art references already considered by Examiner Wilkens for this element during the prosecution of the '843 Patent.

Comparison of Clark With Prior Art Platform Element Features Already Considered by the Examiner During Prosecution of the '843 Patent

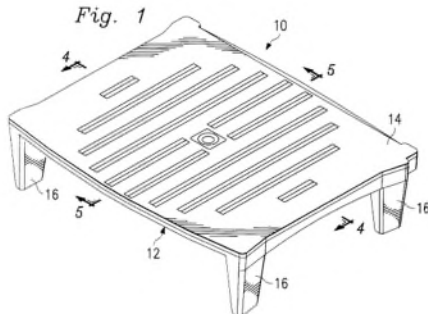
Clark (Ex. 1013):



Printer stand

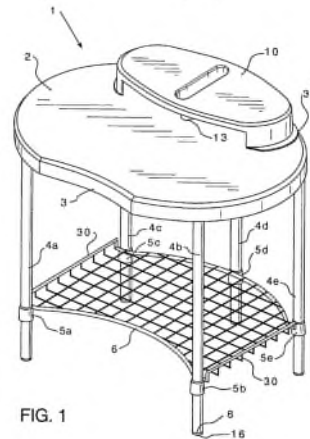
Comparison of Clark With Prior Art Platform Element Features Already Considered by the Examiner During Prosecution of the '843 Patent

Broder (Ex. 2007) (cited art):



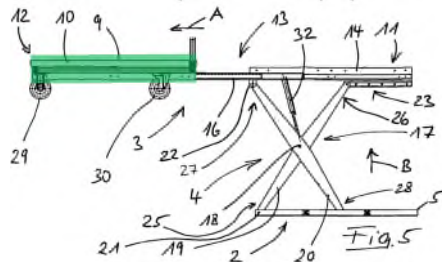
Monitor stand

Ross (Ex. 2008) (cited art):



Monitor stand

Baudermann (Ex. 2006) (cited art):



“Platform element”

As shown in the above chart, each of Broder, Ross and Baudermann include, according to the Examiner, the “platform element” and its features including an elevated platform surface above the work surface platform. Thus, Clark’s depicted printer stand is at best cumulative art to the art already considered by the Examiner.

3. **Factor (c): “The Extent To Which The Asserted Art Was Evaluated During Examination, Including Whether The Prior Art Was The Basis For Rejection”**

As noted above with respect to Factors (a) and (b), four of six references relied upon in the Petitioner—Lindhahl, Huang, Zhang and Clarke—were considered by Examiner Wilkens. Clarke was substantively discussed in a rejection under 35 U.S.C. § 103 that was quickly overcome by the Applicant. *See* Ex. 2003 at 2951-73 (June 13, 2023 Office Action rejecting claims) and 3197 (October 19, 2023 Office Action noting arguments regarding Clarke were persuasive). Clarke also was cited in rejection during the prosecution of U.S. Patent No. 12,226,015. Ex. 2014 at 188. Despite being of record in most of the twenty-seven issued patents, neither Lindahl, Huang nor Zhang have been used in a substantive rejection. Instead, Examiner Wilkens has relied upon more relevant art such as those identified above, and none of these references prevented issuance of Patent Owner's patents, including the '843 patent.

4. Factor (d): “The Extent Of The Overlap Between The Arguments Made During Examination And The Manner In Which Petitioner Relies On The Prior Art Or Patent Owner Distinguishes The Prior Art”

Petitioner combines reference (Lindhahl) with references (Yamamoto and Clark) in the same way the Examiner applied and considered each of Baudermann, Li, Broder and Ross references, respectively. Notably, both Baudermann and Morstat are more comprehensive references than either Lindahl or Yamamoto with respect to teachings of gas springs and scissor legs. Similarly, Baudermann, Broder

and Ross are more comprehensive references than Clark with respect to teaching of a platform element. The charts below listed below various claim elements that the Examiner reviewed across prior art references that are substantially similar to and cumulative with respect to the references cited by Petitioner.

Claim Limitation	Alleged in Office Action(s) by Examiner				
	Baudermann	Morstat	Broder	Ross	JPS5861051U
“a work surface platform”	√	√	X	X	√
“a platform element”	√	X	√	√	X
“a base”	√	√	X	X	√
“a height adjustment mechanism, including”	√	√	X	X	√
“a first set of pivot arms” and “second set of pivot arms”	√	√	X	X	√
“element that connects...”	√	√	X	X	√
“a base pivot point”	√	√	X	X	√
“a platform pivot point”	√	√	X	X	√
“a sliding mechanism”	√	√	X	X	√
“a gas spring”	√	√	X	X	√ (spring)
“fixed to work surface”	√	√	X	X	√
“handle”	X	X	X	X	√

√ = “alleged by Examiner” ; X= “not alleged by Examiner”

A comparison of the chart above (showing the claim elements already considered by the Examiner), and the chart below (showing the claim elements for which Petitioner puts forth its two new references, Yamamoto and Clark) demonstrates the extensive overlap between the same set of claim elements analyzed during examination by the Examiner and the features in Yamamoto and Clark.

Claim Limitation	Alleged In Petition	
	Yamamoto	Clark
“a work surface platform”	√	X
“a platform element”	X	√
“a base”	√	X
“a height adjustment mechanism, including”	√	X
“a first set of pivot arms” and “second set of pivot arms”	√	X
“element that connects...”	√	X
“a base pivot point”	√	X
“a platform pivot point”	√	X
“a sliding mechanism”	√	X
“a gas spring”	X	X
“fixed to work surface”	√	X
“handle”	X	X

√ = “alleged by Petitioner” ; X= “not alleged by Petitioner”

As shown in the charts above, the Petition’s “new” references (Yamamoto and Clark) fail to present any claim element, and related features, not already considered by Examiner Wilkens in prior art references such as Baudermann,

Morstat, JPS5861051U and Ross. Moreover, because the systems taught by Baudermann, Morstatt and JPS5861051U already included teachings of gas springs (or other springs) and scissor legs (and with respect the same/similar claim elements) and handles (JPS5861051U), and because Broder and Ross were alleged by Examiner Wilkens to teach platform elements, there exists complete overlap between the prior art considered and/or arguments made during examination, and the new art (Yamamoto and Clark) upon which Petitioner relies.

Additionally, Examiner Wilkens also found Yamamoto and Clark to be a non-issue in the prosecution of one of Patent Owner's related patents, U.S. Patent No. 12,193,569 (Ex. 2004). Again, the same examiner has considered Yamamoto and Clark, and issued the patent over them with claims broader than those of the '843 as they lack a platform element. Ex. 2014 at 531-536 (December 18, 2024 Notice of Allowance including IDS signed by Examiner Wilkens indicating consideration of Yamamoto and Clark).

Further, with respect to Grounds 2 and 3, Examiner Wilkens had full knowledge of Lindahl, Huang, and Zhang, and did not discuss their teachings in any rejections. *See generally* Ex. 2003. And rejections based on Clarke were overcome. Ex. 2003 at 3197-98.

Still further, with respect to Grounds 1 and 4, Petitioner's citing to and swapping out different published versions of Lindahl and Huang does not

somehow raise a new issue. *Apple Inc. v. Uniloc USA, Inc.*, IPR2017-00224, Paper 7 at 8-9 (PTAB May 25, 2017) (denying institution where considered reference was swapped with an uncited version having same disclosure).

5. Factor (e): Whether Petitioner Has Pointed Out Sufficiently How The Examiner Erred In Its Evaluation Of The Asserted Prior Art

Where the Office has considered the same or substantially the same unpatentability arguments, *see Advanced Bionics*, Paper 6 at 10, the Board should consider whether the Petition articulates a material error by the examiner during prosecution. *Id.* Indeed, the “petitioner has the initial burden to identify such errors made by the examiner” in evaluating the prior art. *Neil Ziegmann, N.P.Z., Inc. v. Stephens*, IPR2015-01860, Paper 13, at 10 (PTAB Sept. 6, 2017) (expanded panel).

Unsurprisingly, the Petition identifies no examiner error or mistake in comprehending the prior art or in examination of the issued claims. It also fails to offer any reason why the references on which it relies are more relevant or, to a lesser extent, not cumulative of those the Examiner considered. This factor weighs heavily in favor of denying institution under 325(d).

6. Factor (f): The Extent to Which Additional Evidence and Facts Presented In The Petition Warrant Reconsideration Of Prior Art Or Arguments

Petitioner does not provide sufficient additional evidence or facts to warrant reconsideration of prior art and arguments already considered and rejected by

Examiner Wilkens. Petitioner relies almost exclusively on the same prior art examined or otherwise considered by the Examiner that Patent Owner overcame. The only “new” art cited for the Petition’s Grounds is Yamamoto and Clark. Neither warrants reconsideration of the evidence and arguments the Examiner already considered. As explained above, Yamamoto is, at best, cumulative of the gas spring and/or scissor legs teachings of each of Baudermann, Morstat, JPS5861051 U, Lindahl, Clarke, Huang and Zhang. As a whole, these references already considered by the Examiner are more comprehensive than Yamamoto, or are at least render Yamamoto cumulative to the various scissor leg designs of these references already considered by Examiner Wilkens during prosecution of the ’843 patent or its related applications. Similarly, Clark is, at best, cumulative of the platform element teachings of Baudermann, Broder and Ross. As a whole, these references already considered by the Examiner are more comprehensive than Clark, or are at least render Clark cumulative in view of these references that have been already considered by Examiner Wilkens during prosecution of the ’843 patent or its related applications.

Further, Petitioner’s declarant (and Petitioner itself) fails to address any examiner error. *See CSL Behring GMBH v. Shire Viropharma Inc.*, IPR2019-00459, Paper 8, at 19 (PTAB Jul. 2, 2019) (“But the mere fact that Petitioner has presented expert declaration evidence in support of its unpatentability challenge is

not in itself a basis to proceed with institution.”). The declaration mirrors the arguments presented in the Petition and relies on the same or similar structures in the prior art as considered and applied by Examiner Wilkens, as explained above. Such conclusory and redundant evidence does not warrant reconsideration of the prior art. *See Edge Endo, LLC v. Maillefer Instruments Holding, S.A.R.L.*, IPR2018-01349, Paper 15, at 19 (PTAB Jan. 14, 2019) (expert declaration that “largely mirror[ed] the arguments presented in the Petition” did not “warrant reconsideration of the prior art or arguments.”).

Furthermore, as detailed in the Patent Owner’s preliminary response on the merits, filed contemporaneously with this brief, the Petition and the declaration upon which it relies, are each entitled to little or no weight because the alleged reasons to combine the various references are conclusory and lack rational underpinnings. *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”).

The PTAB has denied institution when a petitioner and its expert “[m]erely stat[e] ‘design choice’ when confronted with a missing limitation, without citing any authority or references to establish why the feature in question amounts to a mere design choice.” *Kartri Sales Co. v. Zahner Design Grp.*, IPR2016-01327, Paper 10, at 17 (PTAB Jan. 3, 2017); *see also Hopkins Mfg. Corp. v. Cequent*

Performance Prod., Inc., IPR2015-00613, Paper 9, at 15, 17 (PTAB Aug. 7, 2015) (“Petitioner’s [and its expert’s] mere assertion that such a combination would have been an obvious ‘design choice,’ without facts and reasoning explaining why this is so, fails to provide such a reason for why the claimed invention would have been obvious”). Here, Petitioners and their declarant offer nothing more than conclusory statements that the combination would result in, *e.g.*, “reduced cost,” but at the same time fail to provide any underpinning facts (*e.g.*, cost analysis).

Thus, consideration of the *Becton Dickinson* factors weighs in favor of dismissing the Petition under § 325(d).

B. The *Fintiv* Factors Favor Denial of the Petition

The Panel should not countenance Petitioner’s thinly-veiled effort to satisfy the letter of 35 U.S.C. § 315(a) while flouting its spirit. The precedential *Fintiv v. Apple* decision instructs that the Board exercise its discretion and deny institution to prevent Petitioner from engaging in just this type of “gamesmanship in AIA proceedings, given the existence of parallel proceedings between the Office and the district courts.” *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

Here, Petitioner filed a declaratory judgment action on January 24, 2024, in the United States District Court for the Central District of California (“the DJ action”). Ex. 2019. 35 U.S.C. § 315(a)(1) bars IPRs where declaratory judgment

actions challenging validity of a claim of the patent are filed prior to the filing of a petition for IPR. While the DJ action has only two counts for declaratory judgment of non-infringement, Petitioner states in the DJ action that there is a “justiciable controversy ... as to whether ... the ’843 Accused Product [would] infringe, either directly or indirectly, *any valid* and enforceable claims of the ’843 Patent[,]” attempting to bury a defense of invalidity in a claim styled as DJ of non-infringement (emphasis added). Petitioner repeats its statement questioning the validity of the ’843 Patent four times in the DJ complaint. These allegations place the Patent Owner and the Board on notice that Petitioner intends to assert invalidity of one or more claims of the ’843 Patent in the litigation.

Instituting an IPR now would effectively countenance Petitioner’s subversion of 35 U.S.C. § 315(a)(1) by potentially preserving an opportunity for Petitioner to amend the Complaint in the DJ action, after the conclusion of this IPR, to raise duplicative invalidity arguments. This should not be allowed.

Institution of *inter partes* review is discretionary. 35 U.S.C. § 314 states that the “Director *may not* authorize an inter partes review to be instituted unless ... the information presented in the petition ... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged.” 35 U.S.C. § 314(a) (emphasis added). As the Supreme Court has explained, § 314(a) “invests the Director with discretion on the question *whether* to

institute review.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 358 (2018). Pursuant to the Director's discretion, the Board is “permitted, but never compelled, to institute an IPR proceeding.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016); *see also* *Cuozzo Speed Techs. v. Lee*, 579 U.S. 261, 273 (2016) (“decision to deny a petition is a matter committed to the Patent Office's discretion”) (citing 35 U.S.C. § 314(a)). Irrespective of whether the minimum standards for institution are met, other reasons, such as “events in other proceedings related to the same patent,” may favor denying a petition. Consolidated Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019)) (“CTPG”) at 58 (citing *NetApp, Inc. v. Realtime Data LLC*, IPR2017-01195, Paper 9, at 12-13 (PTAB Oct. 12, 2017) and explaining that the Board in *NetApp* denied institution under § 314(a) where it “likely would not have been able to rule on patentability until after the district court trial date”).

In determining whether to exercise its discretionary power under § 314(a), the Board balances a set of six factors, as articulated in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (PTAB Mar. 20, 2020) (precedential). These factors consider the following:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;

4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv, IPR2020-00019, Paper 11, at 5-6. In evaluating these factors, the Board “takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* at 6.

On March 26, 2025, Acting Director of the USPTO, Coke Morgan Stewart, sent out a memorandum titled “Interim Processes for PTAB Workload Management” that, *inter alia*, spelled out additional relevant considerations for exercising discretionary denial, including the “strength of the unpatentability challenge” (see *Fintiv* factor 6) and the “extent of the petition’s reliance on expert testimony.” *See Ex. 2015.*

Here, the factors favor discretionary denial. A co-pending litigation in the Central District of California (“Related Litigation”) involving both Petitioner and Patent Owner and substantially the same claims of the same patents will outpace a PTAB proceeding. The Petition fails to cite any credible reason why the “efficiency and integrity of the system” would not be “best served” by discretionary denial. *Fintiv*, IPR2020-00019, Paper 11, at 6. In fact, Petitioner does not address discretionary denial or the *Fintiv* factors at all. Petitioner also relies

almost exclusively on expert testimony, without underlying factual support, and does not even bother to provide an element-by-element analysis for Grounds 2-4, instead merely citing to its expert. Thus, both the *Fintiv* factors and the “Stewart” factors favor discretionary denial.

1. *Fintiv* Factor 1: Whether the Court Granted a Stay or Evidence Exists that One May be Granted if a Proceeding is Instituted

A stay has already been granted pending an institution decision, so this factor would normally weigh in favor of institution. However, as the district court noted, “[g]amesmanship is completely inappropriate and would weigh significantly against a stay[.]” Ex. 2016 at 7. Despite the court’s concern over Petitioner’s alleged bad faith and lack of response thereto, the court could not “definitively find” that Petitioner sought a “stay in bad faith.” *Id.* at 7.

Nonetheless, a stay has been granted, but the weight of this factor should be considered given the questionable circumstances on which Petitioner secured a stay and the district court’s accompanying concern. In particular, trial was previously scheduled to begin October 20, 2025, but, as noted in Patent Owner’s Opposition to Petitioner’s Motion to Stay in the Related Litigation, Petitioner was able to secure a previous stay of the case by feigning interest in settlement to buy more time to prepare its IPR petitions, including the petition at issue here. *See* Ex.

2017. Afterward, the court set a new trial date of February 3, 2026 before ultimately staying the case in view of this Petition.

2. *Fintiv* Factor 2: Proximity of the Court’s Trial Date to the Board’s Projected Statutory Deadline for a Final Written Decision

Given that trial in the Related Litigation was set to begin before any final written decision would have been due, factor 2 favors discretionary denial. PTAB precedent makes clear that factor 2 favors discretionary denial “[i]f the court’s trial date is earlier than the projected statutory deadline.” *Fintiv*, IPR2020-00019, Paper 11, at 9.

Here, the Court’s trial date in the Related Litigation would have been earlier than the projected statutory deadline. The Court had set a trial date for February 3, 2026. Ex. 2018. The projected statutory deadline for any final written decision is July 28, 2026. *See* Notice of Filing Date Accorded, Paper 3 (setting preliminary response date for April 28, 2025); 35 U.S.C. § 314(b) (setting institution decision for 3 months after a preliminary response); 35 U.S.C. § 316(a)(11) (requiring a final determination by 1 year after institution decision, extendable by 6 months).

In general, the Court’s trial date is consistent with the U.S. court case statistics for the United States District Court for the Central District of California. Since 2019, the median time from filing to trial for civil cases has varied between 20.0 months and 29.7 months, for an average of 24.6 months. *See* Ex. 2022 at 68

(“From Filing to Trial (Civil Only)”). Applying these median timings to the present case, which was filed in January 2024, trial would be expected between January and February 2026.

This factor thus weighs heavily in favor of denial, because trial is set to begin nearly six months in advance of the expected final written decision deadline. For example, the PTAB exercised discretionary denial in *Fintiv* in part because trial was scheduled to begin “approximately two months” before a final written decision. *Fintiv*, IPR2020-00019, Paper 15, at 12-13 (PTAB May 13, 2020). Other PTAB decisions have exercised discretionary denial with even shorter periods between a trial and final written decision. For instance, in *EClinicalWorks, LLC v. Decapolis LLC*, the PTAB denied institution where trial would begin “roughly one to two months before any final decision.” *EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022). Consistent with previous PTAB decisions, such as those in *Fintiv* and *EClinicalWorks*, finding that even a trial date set shortly before any final written decision weighs somewhat in favor of denial, here, factor 2 weighs heavily in favor of discretionary denial, because the jury trial in the Related Litigation would occur nearly six months before a final written decision would be due. *See also 10X Genomics, Inc. v. President and Fellows of Harvard College*, IPR2023-01299, Paper 15 at 17 (PTAB Mar. 7, 2024) (denying institution and finding factor 2 weighing in favor of discretionary denial

where trial would occur at least one month before a final written decision would be due).

3. *Fintiv* Factor 3: Investment in the Parallel Proceeding by the Court and the Parties

The proceedings of the Related Litigation are well underway. Thus far, the parties in the Related Litigation have negotiated and proposed numerous orders, exchanged initial disclosures, exchanged additional disclosures, exchanged infringement and non-infringement contentions, served discovery requests and deposition notices, and participated in claim construction, including proposing terms and briefing. Moreover, the Court has held a scheduling conference with the parties and entered numerous orders in the case, including a Scheduling Order and an order regarding the aforementioned claim construction process.

- June 25, 2024 – Scheduling Order setting trial for 10/20/2025. *See* Ex. 2021 (Dkt. 35).
- September 6, 2024 – Joint Claim Construction and Prehearing Statement. *See* Ex. 2021 (Dkt. 44).
- September 9, 2024 – Amended Order Granting Joint Stipulation to Stay pending settlement discussions and resetting deadlines. *See* Ex. 2021 (Dkt. 47).
- January 2, 2025 – Opening Claim Construction Briefing. *See* Ex. 2021 (Dkt. 51).
- January 15, 2025 – Order regarding Claim Construction. *See* Ex. 2021 (Dkt. 53).

- February 7, 2025 – Order Granting Plaintiff’s Motion to Stay Pending IPR. *See* Ex. 2021 (Dkt. 58).

Factor 3 “favors denial” of the Petition “if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue[.]” *Fintiv*, Paper 11 at 10 (“Likewise, district court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.”). Thus, factor 3 weighs in favor of discretionary denial because the parties have already completed claim construction, resulting in a corresponding order by the district court.

4. *Fintiv* Factor 4: Overlap Between Issues Raised in the Petition and in the Parallel Proceeding

The overlap in issues between the Petition and the Related Litigation is significant. Petitioner has challenged only the claims asserted by Patent Owner in the Related Litigation (claims 1-3, 6-14, and 16-17 of the ’843 Patent). Moreover, Petitioner has failed to provide a “Sotera stipulation” not to pursue in a parallel proceeding the same grounds as in the Petition or any grounds that could have reasonably been raised in the Petition. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 19 (PTAB Dec. 1, 2020) (precedential as to § II.A). Thus, factor 4 weighs in favor of discretionary denial.

5. *Fintiv* Factor 5: Whether the Petitioner and the Defendant in the Parallel Proceeding Are the Same Party

The parties are the same here as in the Related Litigation. Petitioner EP Family Corp. is the declaratory judgment plaintiff in the Related Litigation, and Patent Owner is the defendant. As the PTAB explained in *Fintiv*, factor 5 weighs in favor of discretionary denial where “the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, IPR2020-00019, Paper 15 at 15; *see also Sotera*, IPR2020-01019, Paper 12 at 19 (holding, in a case where the parties were the same in the two proceedings, that the fifth *Fintiv* factor “supports denying institution”). Thus, factor 5 weighs in favor of exercising discretion to deny institution.

6. *Fintiv* Factor 6: Other Circumstances that Impact the Board’s Exercise of Discretion, Including the Merits

As explained in *Fintiv*, “if the merits of a ground raised in the petition seem particularly strong on the preliminary record, this fact has favored institution,” but “if the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present.” *Fintiv*, IPR2020-00019, Paper 11 at 14-15. The Board does not, however, typically need to perform a full merits analysis to evaluate this factor. *Id.* at 15.

Here, as discussed above regarding 325(d), Petitioner’s grounds are based on the same or substantially the same prior art and arguments previously presented to,

and considered by, the Patent Office during examination of the '843 Patent, and its related family.

Moreover, the Petition does not provide an element-by-element analysis of Grounds 2-4, expressly ignoring the PTAB's rules with respect to IPRs, so the Board should not even consider these grounds. *See, e.g.*, 37 C.F.R. § 42.104 (b)(4) (“petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon”); 37 C.F.R. § 42.104 (b)(5) (petition must identify the “supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge”); 37 C.F.R. § 42.6(a)(3) (“[a]rguments must not be incorporated by reference from one document into another document”); *see also Medivis, Inc. v. Novarad Corp.*, IPR2023-00042, Paper 37 at 10 (PTAB Apr. 23, 2024) (PTAB “rules prohibit parties' incorporation of arguments by reference”); *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim’”) (quoting 35 U.S.C. § 312(a)(3)); *Corephotonics, Ltd. v. Apple, Inc.*, 84 F.4th 990, 1001-1002 (Fed. Cir. 2023) (IPR petition “must provide an understandable explanation of the element-by-element specifics of the patentability

challenges, including the identification of particular portions of prior art on which the petitioner is relying.”).

Finally, under the discretionary considerations enumerated in Acting Director Stewart’s memo, the Petition relies almost exclusively on expert testimony, further supporting discretionary denial. Ex. 2015.

Thus, for at least these reasons, factor 6 weighs in favor of exercising discretion to deny institution.

III. ADDITIONAL FACTORS ALSO SUPPORT DISCRETIONARY DENIAL

As outlined in the March 26, 2025 memorandum (Ex. 2015), the strength of the merits also may be considered in assessing whether to deny institution. Here, the Patent Owner’s preliminary response on the merits, filed contemporaneously with this brief, outlines the numerous substantive deficiencies that plague the Petition, including the failure to properly allege that all elements are present in the prior art, the failure to properly allege motivation to combine, and the failure to provide analysis in the Petition itself but instead merely incorporate arguments from an expert’s declaration. At least for these additional set forth in Patent Owner’s merits brief, discretionary denial is further appropriate.

IV. CONCLUSION

For at least the reasons discussed herein, the Director should exercise her discretion to deny institution under both § 325(d) and § 314(a).

Respectfully submitted,

April 28, 2025

/ Ryan N. Phelan (Reg. No. 60,674)/

MARSHALL, GERSTEIN & BORUN LLP

Ryan N. Phelan (Reg. No. 60,674)

Raymond R. Ricordati, III (Reg. No. 62,856)

Benjamin T. Horton (*pro hac vice*)

Isaku M. Begert (*pro hac vice*)

Counsel for Patent Owner

CERTIFICATE OF COMPLIANCE

The undersigned certifies that, pursuant to 37 C.F.R. § 42.24(d), the foregoing patent owner preliminary response complies with 37 C.F.R. § 42.24(b)(1) permitting up to 14,000 words because, excluding the exempted portions of the response, the response contains 7,982 words as counted by the word-processing system used to prepare the patent owner preliminary response.

CERTIFICATE OF FILING AND SERVICE

The undersigned hereby certifies that, pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing “PATENT OWNER’S PRELIMINARY RESPONSE ON DISCRETIONARY DENIAL” and Exhibits 2003 – 2022 are being filed via the Patent Trial and Appeal Case Tracking System (P-TACTS) and are being served today, April 28, 2025, by electronic mail on counsel for the Petitioner:

Kevin Terraza (kterrazas@terrazaspllc.com) and

Joshua G. Simon (jsimon@calljensen.com).

/Ryan N. Phelan (Reg. No. 60,674)/

Ryan N. Phelan (Reg. No. 60,674)

rphelan@marshallip.com

MARSHALL, GERSTEIN & BORUN LLP

Counsel for Patent Owner