UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

QPRIVACY USA LLC,
Patent Owner.

IPR2025-00837
U.S. Patent No. 11,106,824

REQUEST FOR REHEARING OF DECISION ON INSTITUTION

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I. Introduction

Petitioner Cisco Systems, Inc. ("Cisco") respectfully requests rehearing of the August 29, 2025 Order denying institution of inter partes review. The Order overlooks Petitioner's *Sotera* stipulation and incorrectly states that instituting this IPR would result in a "significant duplication of effort" between the district court litigation and this IPR.

II. Requests for Rehearing Are Authorized Following Director Discretionary Denial.

Per the Interim Director Discretionary Process, if the Director exercises discretion to deny institution, a party may file a request for rehearing or Director Review within 30 days of the Director's Decision. PTAB, *Interim Director Discretionary Process*, https://www.uspto.gov/patents/ptab/interim-director-discretionary-process, § V.C. (last visited Sept. 25, 2025). A request for rehearing must identify all matters that were "misapprehended or overlooked," and "the place where each matter was previously addressed." 37 C.F.R. § 42.71(d).

III. The Director Overlooked Petitioner's *Sotera* Stipulation.

In denying institution, the Director incorrectly concluded that there would be a "significant duplication of effort" between the district court trial and this IPR. Paper 11 at 2. In doing so, the Director overlooked Petitioner's *Sotera* stipulation. *See* Petition, 76.

The Office considers a *Sotera* stipulation "highly relevant" in deciding whether to issue a discretionary denial. *See* Guidance on USPTO's recission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation", at 3 (Mar. 24, 2025), https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf. Petitioner's stipulation tracks the language of *Sotera Wireless, Inc. v. Masimo Corp*. IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A.), by agreeing not to pursue in district court "the specific grounds asserted here, or any other ground that could have been reasonably raised against the Challenged Claims in an IPR." Petition, 76.

The Director concluded that there would be a "significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions." Paper 11, 2. But Petitioner stipulated not to pursue "grounds that could have been raised under §§ 102 or 103 on the basis of prior art patent or printed publications" in the co-pending district court litigation. Petition, 76. This stipulation "mitigates **any** concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions." *Sotera*, IPR2020-01019, Paper 12, 19 (emphasis added).

The Director did not address Petitioner's stipulation in the Order. Thus, the Director appears to have overlooked this stipulation by erroneously concluding that

this proceeding creates a risk of duplicative efforts.

IV. Petitioner's *Sotera* Stipulation is Supported by Federal Circuit Caselaw.

To the extent that the Director did not overlook, but perhaps misapprehended the *Sotera* stipulation, the Order is contrary to Federal Circuit caselaw addressing the interplay between IPR and district court defenses.

In *Ingenico Inc. v. IOENGINE, LLC*,[1] the Federal Circuit addressed the relationship between invalidity defenses that may be raised in inter partes review and in district court litigation. The court held that IPR estoppel under 35 U.S.C. § 315(e)(2) is limited to IPR-eligible art:

> [W]e hold that IPR estoppel applies only to a petitioner's assertions in district court that the claimed invention is invalid under 35 U.S.C. §§ 102 or 103 because it was patented or described in a printed publication (or would have been obvious only on the basis of prior art patents or printed publications).

Ingenico, 136 F.4th at 1366.

The court grounded its holding in the statutory text of §§ 311(b) and 315(e)(2), explaining that "grounds" are the §§ 102/103 theories available in IPR—limited by § 311(b) to patents and printed publications. *Id. Ingenico* thus

[1] 136 F.4th 1354 (Fed. Cir. 2025).

confirms that Congress deliberately preserved for the courts invalidity grounds based on public use, sale, knowledge or use by others, and other non-patent and non-printed-publication evidence.

Because Petitioner stipulated to not pursue "grounds that could have been raised under §§ 102 or 103 on the basis of prior art patent or printed publications" in the co-pending district court litigation, Petitioner's stipulation is in accordance with the separation of grounds of *Ingenico*. Petition, 76. As such, the stipulation mitigates any risk of duplicative efforts.

V. Relief Requested

Because the Order overlooked or misapprehended Petitioner's *Sotera* stipulation, Director Review is warranted. Petitioner respectfully requests that the Director:

- grant rehearing;
- vacate the denial of institution (Paper 11); and
- refer the Petition to a panel for issuance of a merits-based institution decision.

Respectfully submitted,

Dated: September 29, 2025

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CERTIFICATE OF SERVICE

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

Date of service	September 29, 2025
Manner of service	Electronic Email: tom@dunham.cc, elizabetho@cherianllp.com; tomd@cherianllp.com
Documents served	**REQUEST FOR REHEARING OF DECISION ON INSTITUTION**
Persons served	Thomas Dunham Elizabeth O'Brien Cherian LLP 2001 L St. NW Suite 650 Washington, DC 20036

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