

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NKT PHOTONICS INC.  
and NKT PHOTONICS A/S  
Petitioners

v.

OMNI CONTINUUM LLC  
Patent Owner

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Case No. IPR2025-00839  
Patent 7,433,116

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

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## I. INTRODUCTION

Pursuant to the Director’s Memorandum issued on March 26, 2025, NKT Photonics Inc. and NKT Photonics A/S (“Petitioners” or “NKT”) file this opposition to Patent Owner’s Request for Discretionary Denial, Paper 7 (“Request”). Patent Owner has requested discretionary denial of institution of the Petition for *Inter Partes* Review of U.S. Patent 7,433,116 (“the ’116 Patent”) (EX1001). Request at 1. The Request should be denied for at least three reasons. First, and contrary to Patent Owner’s arguments, five of the *Fintiv* factors clearly favor Petitioners and the institution of this IPR. Second, and also contrary to Patent Owner’s arguments, application of the Director’s newly created “settled expectations” factor favors institution. Moreover, application of the newly created “settled expectations” factor against Petitioners would be a violation of Petitioners’ APA and due process rights. Third, application of the Director’s newly created “settled expectations” factor is a violation of the separation of powers clause of the Constitution because it limits the time frame that petitioners have to file a petition based on the length of time the patent claims have been in force. For at least the above reasons, as more fully addressed below, the Request should be denied.

## II. DISCRETIONARY DENIAL OF INSTITUTION IS NOT WARRANTED UPON A WEIGHING OF THE *FINTIV* FACTORS

As noted in Patent Owner’s Request, the Director considers six factors when deciding a Patent Owner’s request for discretionary denial of an IPR when there is a parallel proceeding involving the same patent:

1. whether the trial court granted a stay or the likelihood 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 (“FWD”);
3. the trial court’s and the parties’ investment in the parallel proceeding;
4. the amount of overlap between the 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.

*Apple Inc. v. Fintiv, Inc.* (“*Fintiv*”), IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential).

As described below in more detail, five of these factors clearly favor Petitioners and the institution of this IPR. The sole factor that does not is Factor 5 (Petitioners are the defendants in the parallel district court proceeding), which does

not overcome the other factors that weigh in Petitioners' favor. For this reason alone, Patent Owner's Request should be denied.

**A. Factor 1 – Likelihood of Stay**

Patent Owner asserts that “Factor 1 weighs in favor of denial because the district court has not granted a stay of the parallel litigation, and there is no indication that it will do so.” Request at 7. While the district court has not yet granted a stay, Patent Owner's suggestion that it will not do so is contrary to the prior practice of the district court, which has granted stays in similar circumstances in prior cases. When, as here, there is evidence that the Judge in the district court proceeding will stay the litigation if an IPR is instituted, Factor 1 leans in favor of denying Patent Owner's request for discretionary denial of institution. At worst, this factor is neutral.

As stated in *Sand Revolution*, the case cited by Patent Owner in support of its Request:

In the absence of specific evidence, we will not attempt to predict how the district court in the related district court litigation will proceed because the court may determine whether or not to stay any individual case, including the related one, based on a variety of circumstances and facts beyond our control and to which the Board is not privy. Therefore, we do not find that this factor weighs in favor

of either exercising or not exercising discretion to deny institution under 35 U.S.C. § 314(a).

*Sand Revolution II, LLC v. Cont'l Intermodal Grp.—Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB Jun. 16, 2020) (informative). Patent Owner has provided no evidence that the district court or judge in the parallel proceeding will not grant a stay if the Board institutes trial in this proceeding.

Patent Owner further states that “NKT has not even requested a stay in the district court.” Request at 7. But the Board has not yet granted institution. Once the present case is instituted, Petitioners will file a motion requesting a stay of the parallel litigation.

Patent Owner states that “a stay is unlikely because the district court case involves another patent (U.S. Patent No. 7,519,253) not subject to an IPR. (Ex. 2005 at 15.)” Request at 7. Patent Owner further asserts that “[t]he district court is unlikely to halt its progress simply because an IPR petition was filed for the ’116 Patent, especially given Petitioner’s long delay in filing its Petition.” *Id.* Again, Patent Owner provides no evidence that a stay is unlikely. On the contrary, the court and judge (Judge Talwani) in the parallel proceeding have stayed court proceedings pending the outcome of IPR proceedings. *See* Figures 1 and 2 below.

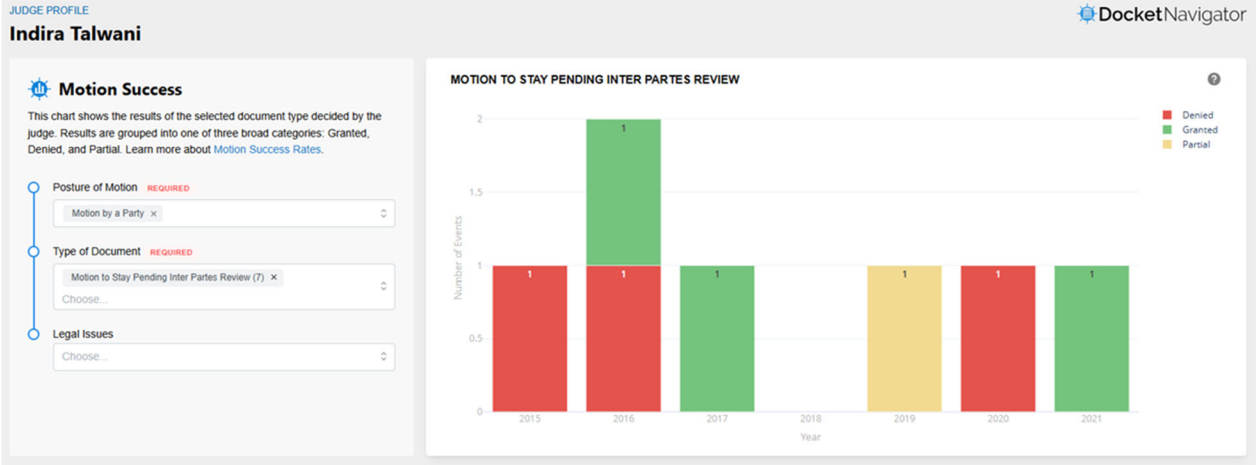


Figure 1 (EX1016)

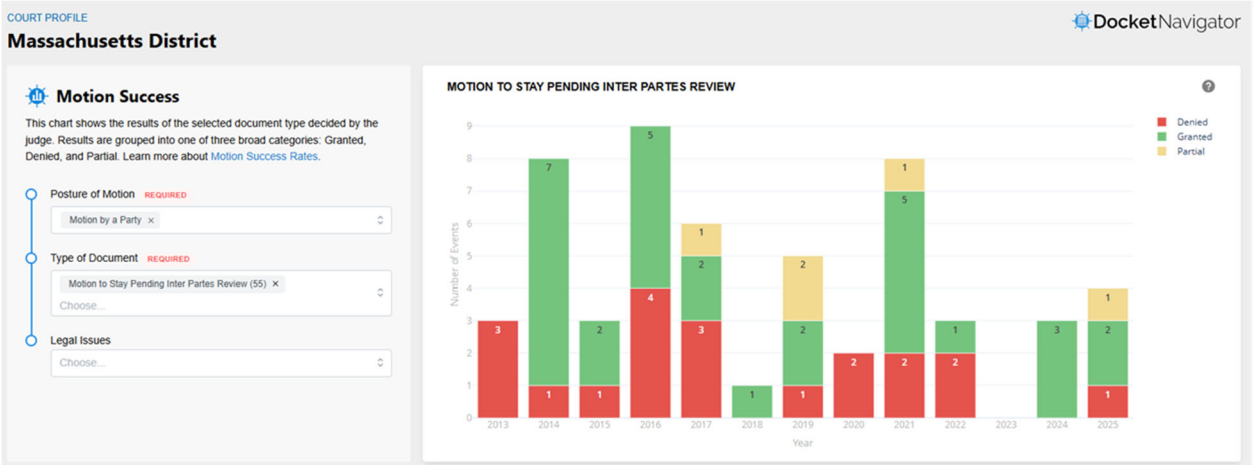


Figure 2 (EX1017)

Moreover, Judge Talwani has issued a stay in a proceeding where institution of an IPR proceeding had not occurred with respect to all asserted patents. *Realtime Data LLC d/b/a IXO v. Acronis, Inc.*, Civ. Action No. 1:17-cv-11279 (D. Mass.). In that case, Judge Talwani issued an order stating the following:

In light of the PTAB’s institution of two IPR proceedings on the ’204 patent, and after consideration of the stage of the litigation, whether a stay will simplify the issues in

question, and whether a stay will unduly prejudice or present a clear tactical disadvantage to Plaintiff, those proceedings relating solely to the '204 patent, including construction of the 4th and 9th terms identified by the parties in their Joint Claim Construction and Prehearing Statement 76, are stayed pending further court order, and the Motion is otherwise DENIED. In the interest of efficient case management, further discovery as to all patents is stayed during claim construction, except as necessary for claim construction.

*Realtime Data LLC d/b/a IXO v. Acronis, Inc.*, Civ. Action No. 1:17-cv-11279 (D. Mass.), Electronic Order dated March 12, 2019 (Dkt. 79). EX1018.

Thus, not only does Patent Owner fail to provide any evidence that the court or the judge in the parallel proceeding are unlikely to grant a stay when there are other patents involved, there is evidence that the judge has granted a stay with respect to a patent subject to institution when there are other asserted patents that are not subject to institution.

The circumstances regarding the additional patent (U.S. Patent No. 7,519,253 (“the ’253 Patent”)) and why Petitioners have not sought *inter partes* review of that patent warrant further discussion.

Patent Owner previously asserted infringement of the ’253 Patent and another patent (U.S. Patent No. 8,971,681 (“the ’681 Patent”)) against NKT Photonics Inc.

in a district court proceeding that was filed on February 17, 2023, and served on March 7, 2023. Notably, Patent Owner did not assert the '116 Patent in the first proceeding between the parties. Upon NKT Photonics Inc.'s successful motion to dismiss that first proceeding, Patent Owner dropped any claim of infringement of the '253 Patent and only proceeded with allegations of infringement of the '681 Patent in its amended complaint. That case was subsequently dismissed. *See Omni Continuum LLC v. NKT Photonics Inc.*, Civ. Action No. 1:23-cv-10359 (D. Mass.), Stipulation and Order of Dismissal dated March 7, 2024 (Dkt. 60). EX1019.

Subsequently, as part of the parallel litigation to this proceeding, Patent Owner reasserted the '253 Patent against Petitioners in a complaint filed on April 17, 2024 (EX2005) and served on April 18, 2024 (EX1029), which was after the statutory period for filing an IPR challenging the claims of the '253 Patent had expired on March 7, 2024. From this history, it is clear that it is Patent Owner (and not Petitioners) who is gaming the system by both not asserting the '116 Patent in the first district court proceeding and then reasserting the '253 Patent in the second district court proceeding after the deadline for filing an IPR expired so it can argue that a stay would not be likely because Petitioners have not filed an IPR petition challenging the claims of the '253 Patent. Patent Owner should not be rewarded for such actions by a denial of institution.

Regardless, Factor 1 does not weigh in favor of the use of discretion to deny institution. There is no evidence suggesting that it is unlikely that the court will deny a stay. Absent such evidence the Board has indicated that this factor is neutral. But here, there is evidence that the court will grant a stay if there is institution on one of multiple patents asserted in the parallel litigation. Thus, this factor weighs in favor of not using discretion to deny institution.

**B. Factor 2 – Timing of Trial**

Patent Owner asserts that the timing of the district court trial compared to the potential Final Written Decision supports discretionary denial. Request at 7. Patent Owner is incorrect; a trial date (should it occur) is far more likely to occur after the Board’s projected deadline for issuing a FWD. As a result, Factor 2 favors institution.

At the outset, Patent Owner fails to mention that the district court has not yet set a trial date. Instead, Patent Owner states, “any actual trial date set by the District of Massachusetts for this case *would likely come* several months before the FWD, making the IPR process redundant” and that “an IPR under these circumstances would be a waste of judicial resources because the district court can resolve the invalidity issues first.” Request at 7–8 (emphasis added.). But Patent Owner’s analysis of the likely timing of a trial is flawed.

The Petition was accepted by the PTAB on May 13, 2025 (Paper 6). A Decision on Institution is expected by November 13, 2025, which would result in

obtaining a Final Written Decision on November 13, 2026. Thus, the relevant inquiry for Factor 2 is whether it is likely that the district court trial will occur before November 13, 2026.

The district court proceedings are at the claim construction stage, with the parties' briefing completed on March 14, 2025. EX1041. The district court recently set a date for the Markman hearing of October 31, 2025. EX1026. It is unlikely that fact and expert discovery will close before summer 2026, and motions for summary judgment will likely not be briefed and ruled on until the end of 2026. A trial in mid-2027 is the earliest that could reasonably be expected, assuming reasonably speedy rulings by the district court and no additional delays.

Patent Owner does not address the specific events in the district court proceedings to project when the district court case may go to trial, but, instead, relies upon Docket Navigator to identify the median time to trial. Request at 7. EX2006. According to Patent Owner, the median time to trial in the District of Massachusetts is 27 months. *Id.* A reproduction of the data in Patent Owner's Exhibit 2006 is found in Figure 3 below.

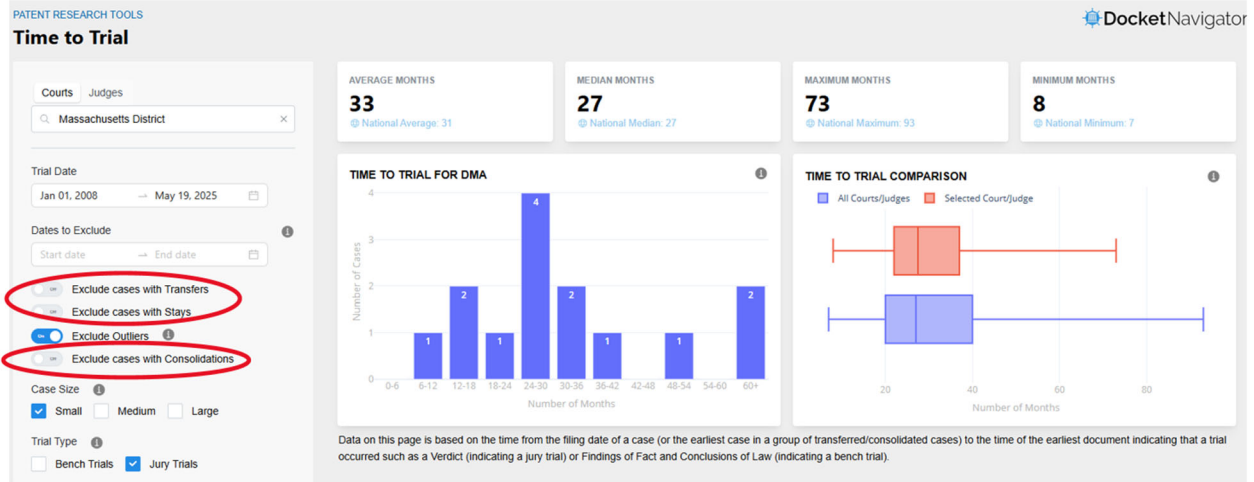


Figure 3 (EX1020)

Notice in Figure 3 that Patent Owner did not exclude cases, such as cases involving transfers, stays, and consolidations with other cases (circled in red in Figure 3), that are unlike the parallel proceeding involving Patent Owner and Petitioners. Had Patent Owner excluded such proceedings, the median time to trial increases from 27 months to 36 months. See Figure 4 below.

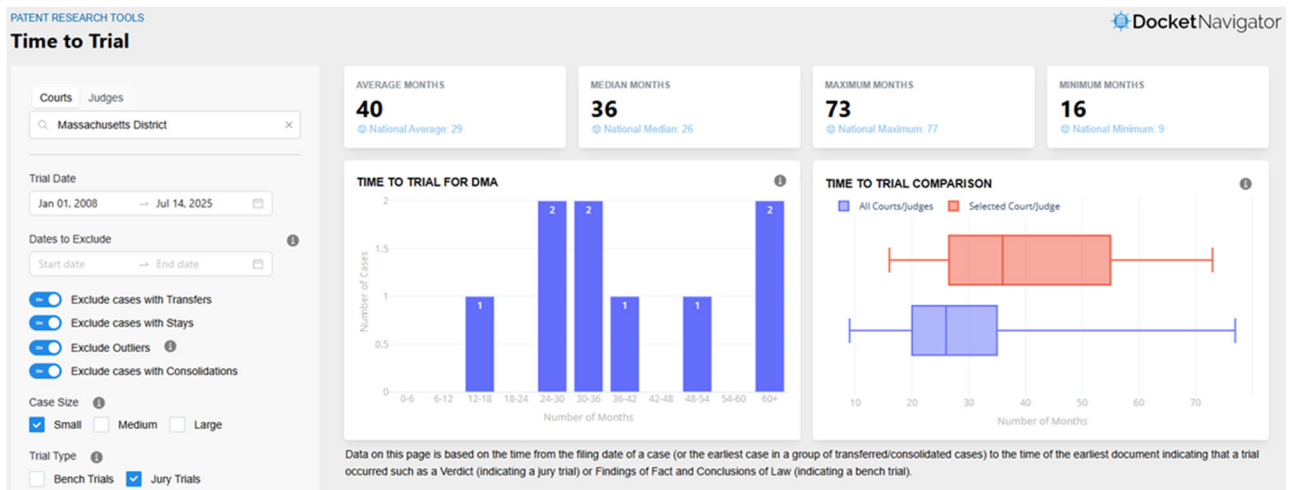


Figure 4 (EX1021)

Had Patent Owner excluded such irrelevant cases, then the median time to trial would have been in April of 2027—five months after the November 2026 Final Written Decision of the present case.

Also note that if Patent Owner had limited the data to the last fifteen years, the median time to trial extends to 37 months or May 2027—six months after the November 2026 Final Written Decision of the present case. *See* Figure 5 below.

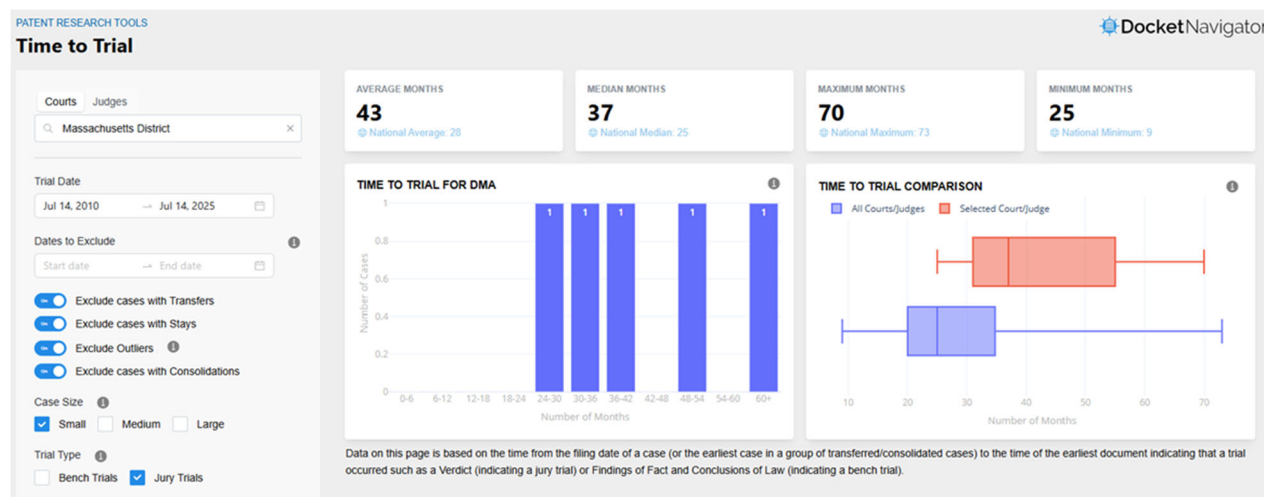


Figure 5 (EX1022)

And if Patent Owner limited the data to the last ten years, then the median time frame based on two cases is 51 months or July 2028—more than a year after the November 2026 Final Written Decision in the present case. *See* Figure 6 below.

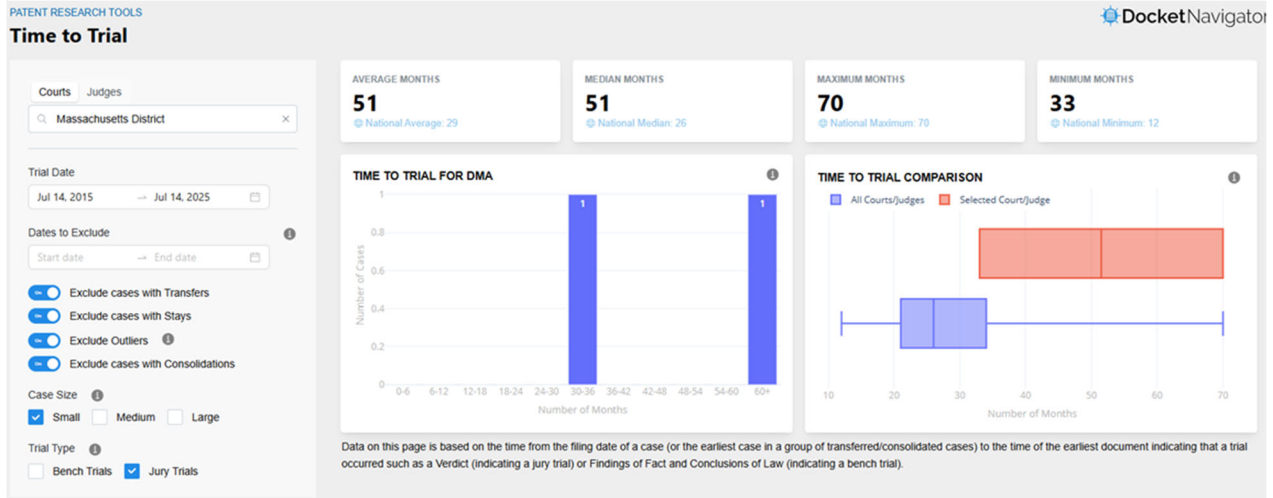


Figure 6 (EX1023)

And if Patent Owner had limited the data to the last five years, then the median time frame based on one case is 70 months or February 2029, again years after the November 2026 Final Written Decision in the present case. See Figure 7 below.

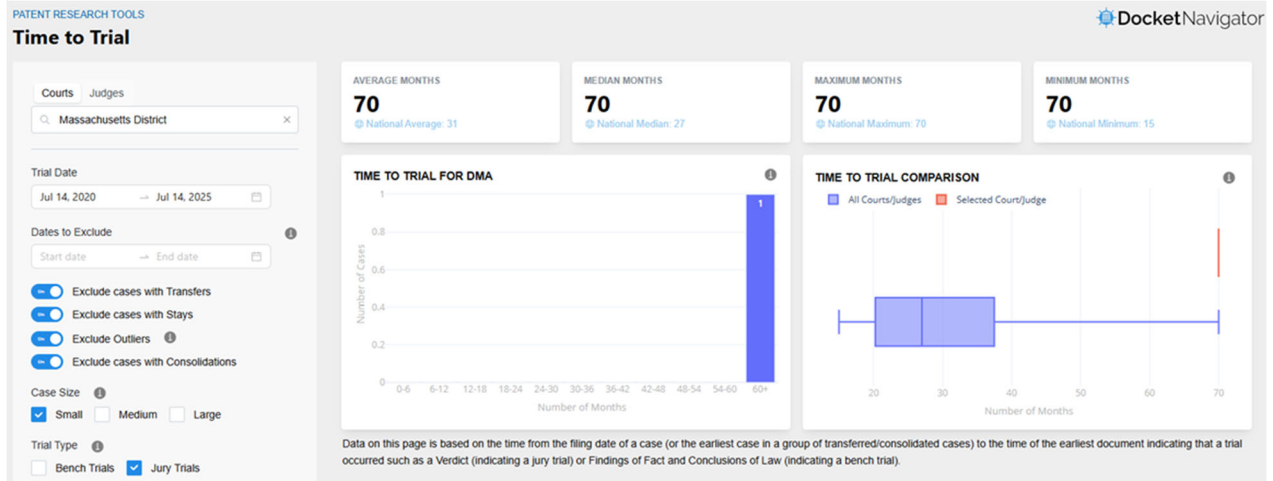


Figure 7 (EX1024)

Patent Owner’s assertions about the timing to trial are simply flawed as they include data that does not apply to the present parallel litigation and do not consider the actual progress of the proceedings in the district court. The fact of the matter is

(i) that there is no trial scheduled; (ii) NKT Photonics A/S was not even served until September 24, 2024 (EX1025); (iii) a Markman Hearing has been scheduled for October 31, 2025 (EX1026); (iv) fact and expert discovery are not even remotely complete; and (v) summary judgment motions remain. Neither the data from Docket Navigator, nor the actual proceedings in the district court, support a trial occurring prior to a Final Written Decision in this proceeding.

For at least the above reasons, Factor 2 does not weigh in favor of the use of the Board's discretion to deny institution. Factor 2 weighs in favor of institution.

**C. Factor 3 – Investment in Parallel Proceeding**

Patent Owner asserts that Factor 3 (regarding the investment by the district court and the parties) favors discretionary denial of institution. Request at 8. This is also incorrect. The parties and district court have relatively little time invested in the parallel proceedings to date. Factor 3 favors institution for the following reasons.

Patent Owner states that “NKT filed its IPR petition on April 11, 2025, just a few days before the one-year IPR filing deadline” and this “is a significant delay on Petitioner's part, considering Omni served the Complaint on April 18, 2024.” Request at 8. According to Patent Owner, the “Board consistently views unexplained delays in filing petitions as a factor supporting denial, especially when the district court litigation has progressed significantly.” *Id.* Patent Owner's arguments are misplaced.

As Patent Owner acknowledges, Petitioners filed the petition on time, before the statutory one-year IPR filing deadline. This occurred within seven months of the service of NKT Photonics A/S. EX1025. More importantly, Factor 3 “concerns the degree of investment” by the district court, not the timing of the IPR filing. *CrowdStrike, Inc., v Webroot Inc.*, IPR2023-00126, Paper 9 at 10 (PTAB May 5, 2023). Indeed, what is relevant to Factor 3 is “if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition,” and, if so, “this fact favors denial” of the Petition. *Id.* at 10 (citing *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 at 9–10 (PTAB Mar. 20, 2020)). Here, the court has not issued substantive orders related to the patent at issue in the petition.

*Fintiv* indicates that if the district court issues claim construction orders that may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial. *Id.* There has been no claim construction hearing let alone a claim construction order in the parallel litigation. “If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.” *Id.* See also *Facebook, Inc. v. Search and Social Media Partners, LLC*, IPR2018-01620, Paper 8 at 24 (PTAB Mar. 1, 2019) (district court proceeding in its early stages, with no claim constructions having been determined); *Amazon.com, Inc. v. CustomPlay, LLC*, IPR2018-01496, Paper 12 at 8–9 (PTAB Mar. 7, 2019) (district court

proceeding in its early stages, with no claim construction hearing held and district court having granted extensions of various deadlines in the schedule). Here, since there are no issued orders related to the '116 Patent at issue in the petition, this weighs against exercising discretion to deny institution.

Patent Owner asserts that the current “level of investment, including discovery and motion practice, is a well-recognized reason to deny institution.” Request at 8. But Patent Owner cites no cases in support for its reasoning. Further, one should not be fooled by Patent Owner’s assertions of its level of investment. Patent Owner has only produced 41 documents that amount to about 2,800 pages (most of which relate to the prosecution history and assignment records of two separate patents) to date in the parallel proceeding. EX1027, ¶¶ 4–5. No depositions have been taken. No expert reports have been provided. Simply put, the level of investment in this case does not support discretionary denial of institution.

For at least the above reasons, Factor 3 does not weigh in favor of the use of the Board’s discretion to deny institution. Factor 3 favors institution.

**D. Factor 4 – Overlap of Issues**

Patent Owner asserts that Factor 4 supports discretionary denial. Request at 9. Patent Owner further asserts that, the “challenged claims and the asserted claims in the district court are the same” and “NKT relies on two of the nineteen invalidity references asserted in the district court litigation.” *Id.* According to Patent Owner,

this “leads to duplicative efforts and the potential for conflicting decisions, undermining the efficiency and integrity of the patent system.” *Id.* Patent Owner’s assertions are incorrect. Petitioners submit with this opposition a *Sotera*-type stipulation. EX1028.

The *Sotera*-type stipulation limits the arguments Petitioners raised or could have been raised in the district court if the IPR is instituted. Petitioners may not pursue the same or similar invalidity theories in both forums. Submission of the stipulation relieves all burdens on the system by removing any purported inefficiencies of addressing the same arguments in two separate forums and removes inefficiencies from both forums by precluding arguments in the district court proceeding that could have been made in this proceeding.

Petitioners note Patent Owner’s citation to *Motorola Solutions*, where the Director denied institution despite the filing of a *Sotera*-type stipulation. Request at 9. *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205 *et al.*, Paper 19 at 3–4 (PTAB Mar. 28, 2025). According to the Director, the Board failed to adequately consider the significant investments made by the parties in the parallel district court litigation. *Id.* In that case, the parties had invested significant resources in the case—they had already served infringement and invalidity contentions, expert reports, claim construction briefs, and they had conducted depositions. *Id.* Further, the district court had already held a claim construction hearing and construed the claim

terms. *Id.* Most importantly, the trial date was set to occur eleven months before the board's projected final written decision. *Id.* Here, however, there have been no depositions, no claim construction hearing or decision, no expert reports, and no trial date set.

Petitioners note that the filing of the *Sotera* stipulation, while not dispositive under current guidance from Chief Administrative Patent Judge Boalick, is “highly relevant . . . as part of the [Board’s] analysis under *Fintiv*.” Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” March 24, 2025. EX1032 (“March 2025 Chief Judge’s Memo”). Petitioners further note that they relied upon the longstanding direction of former Commissioner Vidal’s Memorandum “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” June 21, 2022. EX1030 (“June 2022 Director Vidal Memo”). In that Memorandum, former Director Vidal states consistent “with *Sotera Wireless, Inc.*, the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have been reasonably been raised before the PTAB.” EX1030 at 3. Rescinding the longstanding procedure without notice and comment is highly prejudicial to Petitioners who have

relied on the procedure during its granted statutory period to file a petition. *See* Section III, *infra*.

For at least the above reasons, Factor 4 does not weigh in favor of the use of the Board’s discretion to deny institution. Factor 4 strongly weighs in favor of institution.

**E. Factor 5 – Overlap of Parties**

Petitioners are defendants in the parallel district court litigation, and Patent Owner is the plaintiff. These facts should not outweigh the overwhelming weight of the other factors supporting denial of Patent Owner’s Request for discretionary denial.

**F. Factor 6 – Other Circumstances**

Patent Owner states that Factor 6 supports discretionary denial of the petition. Request at 5–6. Patent Owner’s assertions are again incorrect. This factor strongly favors institution.

**1. Patent Owner’s Settled Expectations and Petitioner’s Delay**

Patent Owner asserts that “NKT has known about the ’116 patent since 2012, when it tried to license the patent” (citing to EX2002; EX2003). Request at 5. In making the statement, Patent Owner implies that Petitioners knew that they needed a license to the ’116 Patent but took their chances in not getting one. Patent Owner’s implications are incorrect and do not stand up to the actual facts.

First, Patent Owner wrongly suggests that it was Petitioners that were seeking a license to the '116 Patent back in 2012. *Id.* In fact, Petitioners approached Patent Owner about the '253 Patent, not the '116 Patent. EX1034. It was Patent Owner that wanted to bundle various patent families into a single license and first suggested this approach in 2012. EX2002.

Petitioners never wanted or needed a license to the '116 Patent and were chiefly considering a license for the '253 Patent. EX1034. It was not until 2017 that Patent Owner first told Petitioners that it believed Petitioners infringed the '116 Patent. EX1037. Patent Owner provided no explanation as to why it held such a belief, though. *Id.* In response, Petitioners responded shortly thereafter that they did not infringe the '116 Patent (or any other patents). EX1038. And, Patent Owner no longer pursued the claim that Petitioners infringed the '116 Patent. In fact, as late as 2022, Patent Owner was not suggesting that Petitioners infringed the '116 Patent. EX1039. And, again, Petitioners informed Patent Owner that it did not infringe any of Patent Owner's 15 patents. EX1040. As a result, Petitioners reasonably believed that Patent Owner had dropped its claim that Petitioners infringed the '116 Patent.

Indeed, on February 17, 2023, Patent Owner filed suit against only NKT Photonics Inc. that alleged infringement of two different patents (U.S. Patent Nos. 7,519,253 and 8,971,681). Notably, Patent Owner did not assert that Petitioners infringed the '116 Patent in that lawsuit. EX1042. The first time that Petitioners

learned of Patent Owner's renewed belief that Petitioners infringed the '116 Patent was on April 17, 2024, when Patent Owner filed suit against Petitioners for allegedly infringing that patent. EX2005. Petitioners note that Patent Owner's second lawsuit was filed against Petitioners only one month after the parties settled the prior lawsuit involving the '253 and '681 Patents and without any prior notice or discussion that it was doing so.

Patent Owner suggests that the "settled expectations" prong of the Interim Guidance only relates to Patent Owners but that is not the case. Request at 6. The Interim Guidance states that it is the "[s]ettled expectations of **the parties**, such as the length of time the claims have been in force." EX1033 at 2 (emphasis added.). Here, the parties had communications for more than twelve years before the patent infringement complaint was filed by Patent Owner. Petitioners had no reason to challenge the claims of the '116 Patent as they had not practiced the claimed invention and Patent Owner gave no indication after 2017 that it believed otherwise. Clearly, after such a long period of time, Petitioners did not expect that the patent would be asserted against them.

It was Patent Owner's delay in asserting the '116 Patent that prompted the filing of the petition. It is clearly unreasonable for Petitioners to believe that Patent Owner was going to assert the '116 Patent after so many years the claims were in force, and so close to the expiration of the patent. And as a matter of policy, would-

be licensees of technology should not be expected to file a petition against every patent they consider in license negotiations. This would put a great burden on the system and be particularly harmful to patent owners especially patent owners with little means to defend IPR proceedings.

Patent Owner asserts that “NKT’s thirteen years of inaction, followed by a last-minute filing, suggests strategic gamesmanship rather than a genuine effort to offer an efficient alternative to litigation.” Request at 1. However, Patent Owner needs to look into the mirror to find inaction and gamesmanship. It was Patent Owner’s inaction that is egregious. Patent Owner had plenty of opportunity for over ten years to file an infringement complaint against NKT based on the ’116 Patent if it truly believed NKT was infringing the patent. Indeed, there was a prior district court case that Patent Owner filed against NKT and did not assert the ’116 Patent. Had Patent Owner really been concerned about inefficiency, then it would have asserted the ’116 Patent in the earlier district court proceeding.

## **2. Petition’s Reliance on Expert Testimony**

Patent Owner asserts that “NKT’s expert’s declaration is nearly a verbatim copy of the petition.” Request at 6. According to Patent Owner, “[t]his approach to presenting arguments, where the expert merely parrots the legal brief, is a problematic use of expert testimony and can merit little weight from the Board.” *Id.* Once again, Patent Owner’s arguments are misplaced.

Patent Owner cites to *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 16 (PTAB Aug. 24, 2022) as authority to give little weight to Petitioners' expert. However, Patent Owner fails to understand the case that it cites. In *Xerox*, the Board states:

Petitioner's only evidence in support of its assertion that blocking the purchaser would require recording the blocking in a record in the user's account is the opinion of its Declarant, Dr. Jones. Pet. 28 (citing Ex. 1003 ¶ 54). We have reviewed this excerpt from Dr. Jones' declaration and note that it merely repeats, verbatim, the conclusory assertion for which it is offered to support. See Ex. 1003 ¶ 54 (Dr. Jones declaring that "[a] POSITA would understand that such a blocking would require recording the blocking in a data record associated with that user's account."). Dr. Jones does not cite to any additional supporting evidence or provide any technical reasoning to support his statement. Thus, the cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.

*Id.* at 15.

Patent Owner fails to understand that the point of the *Xerox* decision is that an expert's testimony is problematic if it is conclusory and unsupported, not if the Petition includes the same statements. Here, Patent Owner failed to provide any

evidence that Petitioners' expert provided either conclusory or unsupported evidence. Further, Patent Owner failed to provide any evidence that Petitioners' expert fails to provide additional supporting evidence or provide any technical reasoning to support his statements. Without pointing to any instance where the Petitioners' expert's testimony is conclusory, unsupported, or wanting of supporting evidence or technical reasoning, it is Patent Owner's argument that should be given no weight.

**3. Patent Owner Does Not Make Any Arguments Based on the Merits of Petitioners' IPR Petition**

Finally, Petitioners note that Patent Owner made no arguments relating to the merits of Petitioners' IPR petition when it asked the Director to deny institution of Petitioners' IPR petition.

For at least the above reasons, Factor 6 does not weigh in favor of the use of the Board's discretion to deny institution. Factor 6 strongly weighs in favor of institution.

**III. FAILURE TO NOTIFY THE PUBLIC OF CHANGES IN PTAB POLICY IS PREJUDICIAL TO PETITIONERS' RELIANCE INTERESTS AND IS A VIOLATION OF PETITIONERS' APA AND DUE PROCESS RIGHTS**

The Director should not deny institution based on the exercise of her discretion because doing so would violate Petitioners' rights under the Administrative Procedures Act ("APA") and their due process rights.

As indicated above, Patent Owner served its complaint in the parallel district proceeding on NKT Photonics Inc. on April 18, 2024 (EX1029) and on NKT Photonics A/S on September 24, 2024 (EX1025). This gave Petitioners until April 18, 2025, to file its petition asserting the unpatentability of the asserted claims of the '116 Patent. 35 U.S.C. § 315(b). At the time of service of both NKT Photonics Inc. and NKT Photonics A/S, Director Vidal had already issued binding policy by publishing procedures for addressing *Sotera*-type stipulations. Specifically, on June 21, 2022, the USPTO Director issued a memo establishing that the Board “*will not* discretionarily deny institution of an IPR ... in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.” Memorandum “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” June 21, 2022 (“June 2022 Director Vidal Memo”). EX1030 at 7. This procedure impacted not only whether a petitioner would file a *Sotera*-type stipulation but also when a petition could be filed without fear of a discretionary denial. *Id.* The procedure was not discretionary, and Petitioners relied on the procedure in determining whether and when to file its petition and a *Sotera*-type stipulation, believing that they would have the full statutory period to file their petition as long as they also filed a timely *Sotera*-type stipulation.

On February 28, 2025, ten months after Patent Owner served NKT Photonics Inc., and without any advance notice, the USPTO posted a statement on its website that it “rescinded the June 21, 2022, memorandum.” “USPTO rescinds memorandum addressing discretionary denial procedures.” (“February 2025 Rescission Post”) (EX1031). The February 2025 Rescission Post provided no explanation for the change and simply referred parties to guidance in effect before the June 2022 Director Vidal Memo. *Id.*

On March 24, 2025, the Chief Administrative Patent Judge issued a memo stating for the first time that the rescission would retroactively change the rules applicable to petitions filed before the rescission, including in “any case in which the Board has not issued an institution decision, or where a request for rehearing or Director Review of an institution decision was filed and remains pending.” “Guidance on USPTO’s rescission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’” (“March 2025 Chief Judge’s Memo”) (EX1032). Contrary to the June 2022 Director Vidal Memo’s “binding agency guidance,” the March 2025 Chief Judge’s Memo stated that “a timely-filed *Sotera* stipulation” would now be “highly relevant, but will not be dispositive by itself. Instead, the Board will consider such a stipulation as part of its holistic analysis under *Fintiv*.” *Id.* at 2–3. This memorandum was a clear

indication that the USPTO had changed its prior policy set forth in the June 2022 Director Vidal Memo and relied upon by Petitioners.

On March 26, the Acting Director issued a memo with interim processes for how “the Director will exercise her discretion on institution of AIA proceedings” prospectively, i.e., “where the deadline for the patent owner to file a preliminary response has not yet passed.” “Interim Processes for PTAB Workload Management” (“March 2025 Director Stewart Memo”) (EX1033). The March 2025 Director Stewart Memo neither references nor explains the rescission of the June 2022 Director Vidal Memo.

Despite the February 2025 Rescission Post and the March 2025 Chief Judge’s Memo, it was reasonable for Petitioners to act in reliance on the June 2022 Director Vidal Memo for numerous reasons. First, the June 2022 Director Vidal Memo described itself as “binding agency guidance,” assuring IPR petitioners that the Board panels reviewing their petitions would abide by this guidance. EX1030 at 3. Second, prior to the issuance of the February 2025 Rescission Post, the Board consistently followed the June 2022 Director Vidal Memo as binding agency guidance. Third, the June 2022 Director Vidal Memo indicated that the Office expected to replace its binding agency guidance with formal rulemaking so the public could expect this guidance to stay in place until such time. *Id.* at 9. Fourth,

Petitioners were not aware of the change in policy until over ten months after the statutory period for filing the petition had passed.

Effectively, the issuance of the February 2025 Rescission Post and the March 2025 Chief Judge’s Memo were a retroactive change in policy provided with no notice and after Petitioners in this case had acted for ten months in reliance on the binding agency policy provided in the June 2022 Director Vidal Memo.

The APA requires all rules to be adopted through notice-and-comment procedures, save for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice.” 5 U.S.C. § 553(b). Regardless of how the agency characterizes it, an agency pronouncement is a “binding,” substantive rule if it “effect[s] a change in existing law or policy or ... affect[s] individual rights and obligations.” *Coal. for Common Sense in Gov’t Procurement v. Sec’y of Veterans Affs.*, 464 F.3d 1306, 1317 (Fed. Cir. 2006). The agency’s 2025 Rescission Post did both and thus required notice-and-comment rulemaking. Congress did not delegate to the Patent Office the authority to retroactively rescind such binding agency guidance, meaning that parties could rely on the guidance without fear that the policy would change without sufficient notice for those already facing parallel litigation. Specifically, “a statutory grant of legislative rulemaking authority will not, as a general matter, be understood to encompass the power to promulgate retroactive rules unless that power is conveyed by Congress in express terms.” *Bowen v.*

*Georgetown Univ. Hosp.*, 488 U.S. 204, 208 (1988); *Smith v. Metro. Sch. Dist. Perry Twp.*, 128 F.3d 1014, 1039 (7th Cir. 1997) (“[W]e must . . . refrain from giving retroactive effect to agency policy guidelines.”). “[W]hen Congress’s delegates seek to exercise delegated legislative policymaking authority: their rules too should be presumed prospective in operation unless Congress has clearly authorized retroactive application.” *De Niz Robles v. Lynch*, 803 F.3d 1165, 1172 (10th Cir. 2015) (finding that executive agency did not have authority to apply rule retroactively). The February 2025 Rescission Post and the June 2025 Chief Judge’s Memo are not proper as they fundamentally changed Patent Office policy without adoption through notice-and-comment rulemaking. *See* 35 U.S.C. § 316(a); 5 U.S.C. §§ 553, 706(2)(D).

Moreover, Congress did not grant the Patent Office authority to make retroactive rules or guidelines, nor to retroactively rescind binding agency procedure. *Cf.* 35 U.S.C. §§ 2(b)(2), 316(a); *see also, e.g., Tafas v. Dudas*, 511 F. Supp. 2d 652, 666 (E.D. Va. 2007) (“Congress did not expressly grant the PTO” “the power to promulgate retroactive rules.”); William C. Neer, Comment, Discerning the Retroactive Policymaking Powers of the United States Patent and Trademark Office, 71 Admin. L. Rev. 413, 432 (2019) (“The USPTO does not have the power to make retroactive rules.”). Thus, Petitioners were justified in relying on the June 2022

Director Vidal Memo because the Patent Office did not have the authority to retroactively rescind it.

It cannot be disputed that the rescission of the June 2022 Memo was a clear change in policy and contrary to Congressional intent. This change in policy impacted not only petitioners with pending petitions waiting for finality of institution decisions but also would-be petitioners who relied on the procedure after being served with a complaint with the belief that the filing of a *Sotera*-type stipulation would relieve them of discretionary denial concerns—such as Petitioners in this proceeding.

Moreover, the change-in-position doctrine addresses the problem of reliance on prior agency policy when an agency changes its policy. Under that doctrine, “[a]gencies are free to change their existing policies as long as they provide a reasoned explanation for the change,” “display awareness that [they are] changing position,” and consider “serious reliance interests.” *Encino Motorcars, LLC v. Navarro*, 579 U.S. 211, 221–22 (2016) (quoting *F.C.C. v. Fox Television Stations, Inc.*, 556 U.S. 502, 515 (2009)). The change-in-position doctrine applies “to an agency’s divergence from a position articulated in nonbinding guidance documents,” including in situations “when an agency altered a position first stated in a policy statement,” where “the policy statement instituted ‘a standardized review process’ that ‘effectively’ resembled adjudication.” *FDA v. Wages & White Lion Invs., LLC*,

145 S. Ct. 898, 918 n.5 (2025) (quoting *Dep't of Homeland Sec. v. Regents of Univ. of Cal.*, 591 U.S. 1, 18 (2020)).

Even if the Board were to view the June 2022 Memo as “nonbinding”—contrary to the Director’s own characterization—the June 2022 Director Vidal Memo provided (in unqualified terms) that “the PTAB will not discretionarily deny institution of an IPR ... in view of parallel district court litigation where a petitioner” presents a *Sotera*-type stipulation. EX1030 at 3. Here, the February 2025 Rescission Post drastically altered the legal consequences of Petitioners’ belief it could avoid discretionary denial by submission of a *Sotera*-type stipulation. Yet, there was no explanation for the change in policy or recognition of would-be petitioners’ reliance interests. Thus, the policy of the June 2022 Director Vidal Memo should be followed as it was published as binding policy.

“To satisfy the Due Process Clause, [an agency] must at a minimum ‘provide regulated parties fair warning of the conduct a regulation prohibits or requires.’” *Mexichem Fluor, Inc. v. EPA*, 866 F.3d 451, 462 (D.C. Cir. 2017). Such “fair warning” or “fair notice” requires that, “when an agency issues guidance, it cannot ‘change the requirements set forth therein without consideration of applicants’ reasonable reliance interests, proper notice to applicants, and a reasonable opportunity for applicants to conform to the changed requirements.’” *Wages & White Lion*, 145 S. Ct. at 918 (describing the concept of “fair notice” from a 5th

Circuit decision). In rescinding the June 2022 Memo, the Office did not acknowledge the reliance interests of Petitioners who had been served with a complaint but believed that they could rely on the mandated policy of the June 2022 Memo. The policy was clear and binding during the first ten months of Petitioners' statutory period to file its petition.

The USPTO acknowledged it was changing policy—it “rescinded” the June 2022 Memo. And, a month later, the Chief APJ’s Memo offered “additional guidance” regarding the change. But the March 2025 Chief Judge’s Memo simply explained the effect of the rescission, including that it would apply “to any case in which the Board has not issued an institution decision, or where a request for rehearing or Director Review of an institution decision was filed and remains pending,” and that *Sotera* stipulations would no longer be “dispositive.” EX1032 at 2–3. The March 2025 Chief Judge’s Memo did not offer any reasons for the change. *Id.*

Even had the March 2025 Chief Judge’s Memo offered reasons for the new policy that still would not have been enough. “When an agency changes course, as [the USPTO] did here, it must be cognizant that longstanding policies may have engendered serious reliance interests that must be taken into account.” *Regents*, 591 U.S. at 30. The June 2022 Director Vidal Memo did not just lead Petitioners “to believe” that the presentation of a *Sotera* stipulation would preclude a discretionary

denial based on parallel litigation. *Wages & White Lion*, 145 S. Ct. at 927. It expressly and unequivocally provided that “the PTAB will not deny institution of an IPR ... under *Fintiv* ... where a petitioner” presents a *Sotera* stipulation. EX1030 at 9. Moreover, the June 2022 Memo stated that the USPTO planned to engage in notice-and-comment rulemaking to address parallel litigation, with the June 2022 Memo’s rules controlling “[i]n the meantime.” EX1030.

For at least all of the reasons stated above, the Board should continue to follow the policy of the June 2022 Memo with respect to Petitioners filing of a *Sotera*-type stipulation.

#### **IV. DENYING INSTITUTION BASED ON THE LENGTH OF TIME A PATENT IS IN FORCE REWRITES THE IPR STATUTE AND VIOLATES SEPARATION OF POWERS**

The Director should not use her discretion to deny institution based on the length of time a patent is in force because it would violate the separation of powers.

The U.S. Constitution gives each branch of government different powers, and no branch can “encroach upon the powers confided to the others.” *Kilbourn v. Thompson*, 103 U.S. 168, 191 (1880); *see also Miller v. French*, 530 U.S. 327, 341 (2000). Congress has the “duty of making laws,” the President has “the duty of executing them,” and the judiciary has “the duty of interpreting and applying them.” *Massachusetts v. Mellon*, 262 U.S. 447, 488 (1923). This separation of powers is “essential to the preservation of liberty” (*Mistretta v. United States*, 488 U.S. 361,

380 (1989)) because it “prevents the accumulation of all powers, legislative, executive, and judiciary, in the same hands” (*Patchak v. Zinke*, 583 U.S. 244, 249–50 (2018) (internal quotation marks omitted)). The Supreme Court interprets Congress’ grant of rulemaking authority in light of its decision in *Chevron U. S. A. Inc. v. Natural Resources Defense Council, Inc.*, 467 U. S. 837 (1984). See *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 262 (2016). Where a statute is clear, the agency must follow the statute. *Chevron*, at 842–43. But where a statute leaves a “gap” or is “ambigu[ous],” the Court typically interpret the statute as granting the agency leeway to enact rules that are reasonable in light of the text, nature, and purpose of the statute. *Id.* at 843.

Here, the statute is clear that Congress did not intend to deny institution based on the length of time a patent is in force. Quite the contrary, in the America Invents Act (“AIA”), Congress gave the public a choice between a narrow patent challenge procedure (IPR) or a broader patent challenge procedure (post grant review (“PGR”)) and provided deadlines depending on the type of challenge presented. Specifically, Congress provided in 35 U.S.C. § 311(c) the deadline for filing an Inter Partes Review Petition:

(c) Filing Deadline.—A petition for inter partes review shall be filed after the later of either—

(1) the date that is 9 months after the grant of a patent; or

(2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review.

35 U.S.C. § 311(c).

Note that the statute provides no limitation on when an IPR proceeding can be initiated based on the length of time the claims have been in force. Had Congress intended to place limits on when a party could file an inter partes review petition, it certainly would have done so. Indeed, Congress did place a limit on when a party could file a post grant review. 35 U.S.C § 321(c) (“Filing Deadline.—A petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be)”). Thus, it is clear Congress intended no limits on the timing of when an IPR petition could be filed during the time the claims are in force.

In fact, in *Apple v. Gesture Technology*, the Federal Circuit confirmed that the Patent Trial and Appeal Board (“Board”) has jurisdiction over IPRs concerning expired patents. *Apple Inc. v. Gesture Tech. Partners, LLC*, 127 F.4th 364, 367 (Fed. Cir. 2025). The Court concluded that the review of an earlier grant of a patent “inherently involves the adjudication of a public right,” noting that “it is irrelevant whether the patent has expired” because even expired patents “confer a limited set of rights to the patentee” that “create[] a live case or controversy, which can be

adjudicated by an IPR and in proceedings...on appeal.” *Id.* at 369. This has been the policy of the USPTO since the inception the AIA.

Yet the application of the March 2025 Director Stewart Memo rewrites the filing deadline for IPR proceedings in contravention to the direct intent of the statute and removes the ability to adjudicate the public right recognized by the Federal Circuit. In the March 2025 Director Stewart Memo, the Director provides yet another change in policy indicating that the “[s]ettled expectation of the parties, such as the length of time the claims have been in force” is a relevant consideration bearing on the Director’s decision to use discretion to deny institution. EX1033 at 2. In application of the Director’s directive, the Director began the process of denying institution based on the length of time patent claims have been in force.

The first application of the “settled expectations” factor came on June 6, 2025 in *iRhythm Technologies v. Welch Allyn, Inc.*, Nos. IPR2025-00363, IPR2025-00374, IPR2025-0076, IPR2025-00377, IPR2025-00378, Paper 10 (PTAB Jun. 6, 2025). The Patent Owner requested discretionary denial in five IPRs and in a three-page decision the Director granted discretionary denial in all five cases. *Id.* The Director listed several reasons weighing against discretionary denial: the Board’s projected written decision would precede the district court’s trial date, a high likelihood of a stay if the IPR was instituted, and the patent owner did not identify any unsupported

expert testimony. *Id.* at 2. Yet the key factor appeared to be the fact that one of the patents had been in force since 2012. *Id.* at 2–3.

In another case, on June 18, 2025, in *Dabico Airport Solutions*, the Director relied almost exclusively on the settled expectations factor. *Dabico Airport Solutions Inc. v. AXA Powers APS*, No. IPR2025-00408, Paper 21 (PTAB Jun. 18, 2025). The Director stated, “the challenged patent has been in force almost eight years, creating settled expectations,” and further explained that while there “is no bright-line rule on when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be.” *Id.* at 2–3. The Director then analogized this temporal benchmark to the six-year time limitation on damages under 35 U.S.C. § 286. *Id.* at 3. Notably, the Director also emphasized how patent applications are almost always publicly available, encouraging interested parties to use the USPTO’s systems and publicly available resources to find them, ending with “actual notice of a patent or of possible infringement is not necessary to create settled expectations.” *Id.*

In *Intel Corporation v. Proxense LLC*, the Director reinforced the burden on petitioners to affirmatively demonstrate why the patent owner does not have settled expectations. *Intel Corp. v. Proxense LLC*, Nos. IPR2025-00327, IPR2025-00328, IPR2025-00329, Paper 12 (PTAB Jun. 26, 2025). Citing the *Dabico* decision, the

Director noted “the challenged patents have been in force over nine years, creating settled expectations.” *Id.* at 2.

In *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, the Director drew a distinction in how timing affects settled expectations based on the specific IPRs at issue. *Cambridge Indus. USA, INC. v. Applied Optoelectronics, Inc.*, Nos. IPR2025-00433, IPR2025-00435, Paper 12 (PTAB Jun. 27, 2025); *see also Cambridge Indus. USA, INC. v. Applied Optoelectronics, Inc.*, Nos. IPR2025-00434, IPR2025-00436, IPR2025-00437, Paper 11 (PTAB Jun. 26, 2025) (denying patent owner’s request for discretionary denial). The patents challenged in IPR2025-00433 and IPR2025-00435 had been in force for seven and nine years, respectively, and were deemed to give rise to settled expectations. *Id.* at 3. In contrast, the other three challenged patents, unrelated by family, were issued in 2020 and 2019, and the Director concluded that they had not yet given rise to settled expectations. *Id.* at 2. The Director noted that those patents had not been in force for a “significant period of time.” *Id.* This distinction highlights how the Director has established time limits on filing an IPR based on the length of time a patent claim has been in force.

As demonstrated in the above cases, the Director’s application of “settled expectation” from the March 2025 Director Stewart Memo has effectively rewritten the filing deadlines provided by Congress in 35 U.S.C. §311(c). Had Congress intended a filing deadline for IPR proceedings it would have provided such in the

statute. Thus, any reliance here of “settled expectations” to grant discretionary denial would not only be violation of Petitioners’ APA and due process rights (for the reasons establish in Section II *supra*) it would be a violation of the separation of powers. The application of the “settled expectations” analysis of the March 2025 Director’s Memo in inconsistent with the statute and violates the constitutional separation of powers. *See Utility Air Regul. Grp. v. EPA*, 573 U.S. 302, 327 (2014).

In *Utility Air*, the Supreme Court determined that an EPA rule “would deal a severe blow to the Constitution’s separation of powers” because it rewrote clear statutory thresholds and was “inconsistent with” the statute’s structure and design. *Id.* at 321, 327. The Court “reaffirm[ed] the core administrative-law principle that an agency may not rewrite clear statutory terms to suit its own sense of how the statute should operate.” *Id.* at 328. *See also Washington v. Trump*, 768 F. Supp. 3d 1239, 1263 (W.D. Wash. 2025) (When the executive branch’s actions “purport to condition congressionally appropriated funds in a manner that effectively rewrites the law, they usurp Congress’s legislative role and thus amount to an end run around the separation of powers.”); *cf. City of Portland v. United States*, 969 F.3d 1020, 1041 (9th Cir. 2020) (finding that a regulation effectively rewrote a statute when it “depart[ed] from the carefully crafted balance” in the statute).

Accordingly, for at least the reasons stated above, the Director should not apply any “settled expectations” analysis in consideration of her discretion to deny institution.

## V. CONCLUSION

For at least the foregoing reasons the balancing of the *Fintiv* factors alone strongly supports the institution of this IPR and denial of Patent Owner’s Request. However, there are further reasons for denying Patent Owner’s Request, including upholding Petitioners’ APA rights and due process rights, as well as preserving the Constitutionally granted separation of powers. Petitioners respectfully request, therefore, that the Director deny Patent Owner’s request for discretionary denial of institution and allow the Board to fully consider the merits of Petitioners’ request for *inter partes* review of the ’116 Patent and institute said IPR.

Date: August 13, 2025

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**APPENDIX A—LIST OF EXHIBITS**

EXHIBIT	DESCRIPTION
1001	U.S. Patent No. 7,433,116, issued on October 7, 2008
1016	DocketNavigator Judge Profile, Judge Talwani - Motions to Stay Pending <i>Inter Partes</i> Review downloaded August 12, 2025
1017	DocketNavigator Court Profile, Massachusetts District - Motions to Stay Pending <i>Inter Partes</i> Review downloaded August 12, 2025
1018	Electronic Order dated March 12, 2019 (Dkt. 79) in <i>Realtime Data LLC d/b/a IXO v. Acronis, Inc.</i> , Civ. Action No. 1:17-cv-11279 (D. Mass.)
1019	Stipulation and Order of Dismissal dated March 7, 2024 (Dkt. 60) in <i>Omni Continuum LLC v. NKT Photonics Inc.</i> , Civ. Action No. 1:23-cv-10359 (D. Mass.)
1020	Annotated copy of Exhibit 2006
1021	DocketNavigator Time to Trial – Massachusetts District – January 1, 2008-July 14, 2025
1022	DocketNavigator Time to Trial – Massachusetts District – July 14, 2010-July 14, 2025
1023	DocketNavigator Time to Trial – Massachusetts District – July 14, 2015-July 14, 2025
1024	DocketNavigator Time to Trial – Massachusetts District – July 14, 2020-July 14, 2025
1025	Summons returned executed by NKT Photonics A/S, served on September 24, 2024 (Dkt. 67) in <i>Omni Continuum LLC v. NKT Photonics Inc.</i> , Civ. Action No. 1:24-cv-11007 (D. Mass.)
1026	Electronic Notice of Hearing entered on July 15, 2025 (Dkt. 90) in <i>Omni Continuum LLC v. NKT Photonics Inc.</i> , Civ. Action No. 1:24-cv-11007 (D. Mass.)

EXHIBIT	DESCRIPTION
1027	Declaration of Michelle Miller in Support of its Opposition to Patent Owner’s Request for Discretionary Denial
1028	<i>Sotera</i> Stipulation
1029	Summons returned executed by NKT Photonics Inc., served on April 18, 2024 (Dkt. 7) in <i>Omni Continuum LLC v. NKT Photonics Inc.</i> , Civ. Action No. 1:24-cv-11007 (D. Mass.)
1030	USPTO Memorandum “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” dated June 21, 2022 (“June 2022 Memo”).
1031	USPTO News “USPTO rescinds memorandum addressing discretionary denial procedures,” dated February 28, 2025 available at <a href="https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures">https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures</a> (“February 2025 Rescission Post”)
1032	USPTO Memorandum “Guidance on USPTO’s rescission of Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” dated March 24, 2025 (“March 2025 Chief Judge’s Memo”)
1033	USPTO Memorandum, “Interim Processes for PTAB Workload Management,” dated March 26, 2025 (“March 2025 Director’s Memo”)
1034	November 13, 2012 Letter from NKT Photonics to Professor Islam
1035	Not assigned
1036	Not assigned
1037	Letter from Brooks Kushman dated July 5, 2017
1038	Letter from NKT Photonics dated August 17, 2017
1039	Letter from Brooks Kushman dated February 17, 2022

EXHIBIT	DESCRIPTION
1040	Letter from NKT Photonics dated May 2, 2022
1041	PACER Docket Report for <i>Omni Continuum LLC v. NKT Photonics Inc.</i> , Civ. Action No. 1:24-cv-11007 (D. Mass.) printed on July 25, 2025
1042	Complaint filed in <i>Omni Continuum LLC v. NKT Photonics Inc.</i> , Civ. Action No. 1:23-cv-10359 (D. Mass) on February 17, 2023
2002	October 30, 2012 Email Chain re NKT Licensing Call
2003	May 10, 2013 Email attaching Draft License Agreement
2005	Omni Complaint for Patent Infringement, D. Mass. Case No. 1:24-cv-11007-IT
2006	D. Mass. Median Time to Trial

**CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24**

Pursuant to Acting Director Stewart's March 26, 2025 Memorandum on Interim Processes for PTAB Workload Management, the undersigned certifies that the foregoing Opposition to Patent Owner's Request for Discretionary Denial of Institution totals 9,541 words, excluding the parts which are exempted by 37 C.F.R. § 42.24.

Date: August 13, 2025

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this 13th day of August, 2025, a true and correct copy of the foregoing **PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** is being served via electronic mail upon Patent Owner's counsel as follows:

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