

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

ALLIANCE LAUNDRY SYSTEMS, LLC,  
Petitioner,

v.

PAYRANGE LLC,  
Patent Owner.

---

IPR2025-00950  
U.S. Patent No. 10,891,608

---

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

**TABLE OF CONTENTS**

I. INTRODUCTION ..... 1

II. BACKGROUND ..... 3

    A. Patent Owner’s Patent Assertion Campaign ..... 3

        1. Patent Owner’s Lawsuits Against KioSoft ..... 3

        2. Patent Owner’s Lawsuits Against CSC ..... 5

    B. In 2024, Patent Owner’s Aggressions Turned Towards  
        Petitioner ..... 7

III. DISCRETIONARY DENIAL IS NOT WARRANTED ..... 8

    A. Prior Unsuccessful Challenges by Unrelated Petitioners Do Not  
        Warrant Discretionary Denial ..... 8

        1. The Patentability of the ’608 Patent Has Never Been  
            “Adjudicated;” the Prior Challenges by Unrelated  
            Petitioners Were Denied at Institution ..... 9

        2. An Exception From The Acting Director’s *LifeVac*  
            Decision is Not Warranted ..... 10

        3. Efficiency Considerations Weigh Against Discretionary  
            Denial ..... 17

        4. This Case has Important Distinctions from the *Advanced*  
            *Cluster* Decision ..... 20

    B. Discretionary Denial Under 35 U.S.C. § 325(d) and *Advanced*  
        *Bionics* is Not Warranted ..... 22

        1. The Examiner Did Not Evaluate the Asserted Art During  
            Examination ..... 23

        2. There is No Overlap Between the Art in the Petition and  
            the Art Considered by the Examiner ..... 24

        3. The Examiner’s Prior Art Analysis Was Erroneous ..... 25

C.	Discretionary Denial Under <i>Fintiv</i> is Not Warranted .....	26
1.	Petitioner’s Declaratory Judgment Does Not Warrant Discretionary Denial .....	26
2.	The <i>Fintiv</i> Factors Do Not Support Discretionary Denial.....	28
D.	Additional Considerations in the March 2025 Memorandum Favor Institution .....	36
1.	There Are No Settled Expectations that Would Support Discretionary Denial .....	37
2.	Petitioner Should Have Access to this Forum to Efficiently Establish the Unpatentability of the Challenged Claims .....	39
IV.	CONCLUSION.....	40

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>CASES</b>	
<i>Adv. Micro Devices, Inc. v. Concurrent Ventures, LLC</i> , IPR2025-00478, Paper 10 (Director Jul. 31, 2025).....	18
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Gerate Gmbh</i> , IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020).....	<i>passim</i>
<i>Alliance Laundry Systems LLC v. PayRange Inc.</i> , No. 1:24-cv-00733 (D. Del. Jun. 20, 2024).....	<i>passim</i>
<i>Alliance Laundry Systems LLC v. PayRange Inc.</i> , No. 1:24-cv-00733, Dkt. 11 (D. Del. Aug. 23, 2024).....	33
<i>Alliance Laundry Systems LLC v. PayRange Inc.</i> , No. 1:24-cv-00733, Dkt. 18 (D. Del. Oct. 4, 2024).....	35
<i>Amazon.com, Inc. v. NL Giken Inc.</i> , IPR2025-00250, Paper 14 (Director May 16, 2025) .....	32
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) .....	<i>passim</i>
<i>Apple Inc. v. Vidal</i> , 63 F.4th 1 (Fed. Cir. 2023) .....	9, 10
<i>Ariosa Diagnostics v. Isis Innovation Ltd.</i> , IPR2012-00022, 2013 WL 2181162 (PTAB Feb. 12, 2013) .....	27
<i>Avery Dennison Retail Information Services LLC et al v. EVERYTHING Limited</i> , IPR2021-01259, Paper 14 (PTAB Jan. 25, 2022) .....	28
<i>Azurity Pharmaceuticals, Inc. v. Exelixis, Inc.</i> , IPR2025-00427, Paper 13 (Director July 2, 2025).....	12
<i>Becton, Dickinson &amp; Co. v. B. Braun Melsungen AG</i> , IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) .....	22, 23, 24, 25

<i>Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.</i> , IPR2025-00434, Paper 11 (Director June 26, 2025) .....	32, 38
<i>Canfield Scientific, Inc. v. Melanoscan, LLC</i> , IPR2017-02125, Paper 7 (PTAB Mar. 30, 2018) .....	27
<i>Cellco P’ship v. Gen. Access Sols., Ltd.</i> , IPR2023-00978, Paper 20 (PTAB Dec. 14, 2023) .....	11
<i>Chemours Co. FC, LLC v. Daikin Indus. Ltd.</i> , No. 1:17-cv-01612, Dkt. 77 (D. Del. Jan. 3, 2019) (Noreika, J.) .....	29
<i>CSC ServiceWorks, Inc. v. PayRange Inc.</i> , IPR2023-01188, Paper 1 (PTAB Jul. 17, 2023) .....	6
<i>Ecto World, LLC v. RAI Strategic Holdings, Inc.</i> , IPR2024-01280, Paper 13 (Director May 19, 2025) .....	22, 23, 24, 25
<i>Elbit Sys. of Am., LLC v. Thales Visionix, Inc.</i> , 881 F.3d 1354 (Fed. Cir. 2018) .....	15
<i>Embodify, Inc. v. LifeNet Health</i> , IPR2025-00248, Paper 12 (Director Jun. 26, 2025) .....	18
<i>Embodify, Inc. v. Lifenet Health</i> , IPR2025-00248, Paper 13 (Director June 26, 2025) .....	39
<i>Ford Motor Co. v. Neo Wireless LLC</i> , IPR2023-00763, Paper 28 (Vidal Mar. 22, 2024) .....	13
<i>GD Energy Prods., LLC v. Kerr Machine Co.</i> , PGR2025-00031, Paper 11 (Director Jun. 25, 2025) .....	15, 16, 39
<i>Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) .....	39
<i>Google LLC v. Withrow Networks Inc.</i> , IPR2025-00775, Paper 10 (Deshpande Aug. 15, 2025) .....	38
<i>Imperative Care, Inc. v. Inari Med., Inc.</i> , IPR2025-00289, Paper 9 (Director June 12, 2025) .....	30

<i>Intel Corp. v. Advanced Cluster Systems, Inc.</i> , IPR2025-00794, Paper 13 (Director Aug. 14, 2025).....	19, 20, 21
<i>KioSoft Technologies, LLC v. PayRange Inc.</i> , PGR2021-00084 (PTAB May 27, 2021).....	3, 14
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	15
<i>Kubota North American Corp. v. Vermeer Manufacturing Co.</i> , IPR2025-00169, Paper 16 (PTAB Jun. 10, 2025) .....	23
<i>Laser Dynamics, Inc. v. Quanta Computer, Inc.</i> , 694 F.3d 51 (Fed. Cir. 2012) .....	38
<i>LifeVac v. DCSTAR Inc.</i> , IPR2025-00454, Paper 11 (Director Jul. 11, 2025).....	<i>passim</i>
<i>Merck Sharp &amp; Dohme LLC v. Halozyme, Inc.</i> , PGR2025-00006, Paper 29 (Director June 12, 2025).....	32
<i>Microsoft Corp. v. ParTec Cluster Competence Center GmbH</i> , IPR2025-00318, Paper 9 (Director Jun. 12, 2025).....	9
<i>Nuance Comms., Inc. v. MModal, LLC</i> , No. 1:17-cv-01484, Dkt. 226 (D. Del. Apr. 11, 2019) (Noreika, J.).....	29
<i>Padagis US LLC v. Neurelis, Inc.</i> , IPR2025-00464, Paper 12 (Director Jul. 16, 2025).....	18
<i>PayRange Inc. v. KioSoft Technologies, LLC et al.</i> , 1:20-cv-24342 (S.D. Fla.).....	3
<i>PayRange, Inc. v. CSC ServiceWorks, Inc.</i> , No. 22-cv-502-MN (D. Del.).....	5
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) .....	15
<i>PLR Worldwide Sales Ltd. v. Flip Phone Games, Inc.</i> , IPR2024-000209, Paper 28 (PTAB Apr. 24, 2025) .....	15

<i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , IPR2025-00246, Paper 10 (Director Jun. 12, 2025) .....	26, 33, 34
<i>Samsung Elecs. Co. v. Headwater Research LLC</i> , IPR2024-01396, Paper 13 (PTAB Apr. 1, 2025) .....	34
<i>Samsung Elecs. Co. v. Mullen Indus.</i> , IPR2024-01472, Paper 9 (PTAB Mar. 31, 2025) .....	34
<i>Skechers U.S.A., Inc. v. Nike, Inc.</i> , IPR2025-00142, Paper 11 (PTAB Jun. 12, 2025) .....	11, 12, 21
<i>Sony Group Corp. v. Inmusic Brands, Inc.</i> , IPR2023-00294, 2023 WL 5167545 (PTAB July 25, 2023) .....	36
<i>Synthego Corp. v. Agilent Techs., Inc.</i> , IPR2022-00402, Paper 11 (PTAB May 31, 2022) .....	28
<i>Tesla, Inc. v. Charge Fusion Techs., LLC</i> , IPR2025-00032, Paper 11 (PTAB May 19, 2025) .....	16
<i>Tesla, Inc. v. Intellectual Ventures II LLC</i> , IPR2025-00217, Paper 9 (Director June 13, 2025) .....	19, 35
<i>Trove Brands, LLC v. CamelBak Products, LLC</i> , IPR2025-00140, Paper 14 (PTAB Jun. 6, 2025) .....	28
<i>Twitch Interactive, Inc. v. Razdog Holdings LLC</i> , No. IPR2025-00307, Paper 18 (Director May 16, 2025) .....	37
<i>Valve Corp. v. Elec. Scripting Prods., Inc.</i> , IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) .....	12
<i>Videndum</i> , IPR2023-01218, Paper 12 .....	12
<i>Waters Corp. v. Agilent Techs., Inc.</i> , No. 1:18-cv-01450, Dkt. 95 (D. Del. Aug. 6, 2019) (Noreika, J.) .....	30
<b>STATUTES</b>	
35 U.S.C. § 101 .....	24, 33

35 U.S.C. § 102 .....4  
35 U.S.C. § 103 .....4, 6, 36  
35 U.S.C. § 325(a)(3).....27  
35 U.S.C. § 325(d) .....22

**PETITIONER’S EXHIBIT LIST**

<b><u>Exhibit No.</u></b>	<b><u>Description</u></b>	<b><u>Publication Date (unless otherwise noted)</u></b>	<b><u>Type of Prior Art</u></b>
1001	USPN 11,891,608 (the '608 Patent) (Patent submitted for <i>Inter Partes</i> Review)	Dec. 18, 2013 (earliest possible priority date based on filing of provisional application)	N/A
1002	File History for USPN 10,891,608	N/A	N/A
1003	Declaration of Dr. B. Clifford Neuman Under 37 C.F.R. § 1.68 in Support of Petition for <i>Inter Partes</i> Review of the '608 Patent	N/A	N/A
1004	<i>Curriculum Vitae</i> of Dr. B. Clifford Neuman	N/A	N/A
1005	USPN 9,092,768 (“ <i>Breitenbach</i> ”)	Jan. 11, 2011	§ 102(a)
1006	USPN 5,734,150 (“ <i>Brown</i> ”)	Oct. 16, 1995	§ 102(a)
1007	USPN 5,036,966 (“ <i>Kaspar</i> ”)	June 12, 1989	§ 102(a)
1008	Redline comparison of Claim 1 of the '608 Patent to Claims 7, 13, and 19 of the '608 Patent	N/A	N/A
1009	USPN 3,457,391 (“ <i>Yamamoto</i> ”)	July 19, 1965 (issuance date)	§ 102(a)(1)
1010	USPN 3,931,497 (“ <i>Gentile</i> ”)	Jan. 6, 1976 (issuance date)	§ 102(a)(1)
1011	USPN 6,810,234 (“ <i>Räsänen</i> ”)	Oct. 26, 2004	§ 102(a)(1)
1012	US Patent Pub. No. 2003/0130902 (“ <i>Athwal</i> ”)	Nov. 4, 2002	§ 102(a), (d)
1013	Michael L. Kasavana et al., <i>Innovative VDI Standards:</i>	December 2009	N/A

<u>Exhibit No.</u>	<u>Description</u>	<u>Publication Date (unless otherwise noted)</u>	<u>Type of Prior Art</u>
	<i>Moving an Industry Forward</i> , 4 J. Int'l Mgmt Studies 3 (2009).		
1014	Multi-Drop Bus / Internal Communication Protocol (National Automatic Merchandising Association, Version 3.0, March 26, 2003)	March 26, 2003	N/A
<b>1015 (NEW)</b>	<b>Decision Referring Petitions to the Board (PGR2025-00027, PGR2025-00028, IPR2025-00573)</b>	<b>July 17, 2025</b>	<b>N/A</b>
<b>1016 (NEW)</b>	<b>Docket Navigator statistics regarding Judge Noreika decisions on motions to stay pending IPR/PGR</b>	<b>N/A</b>	<b>N/A</b>
<b>1017 (NEW)</b>	<b>Docket Navigator statistics regarding District of Delaware decisions on motions to stay pending IPR/PGR</b>	<b>N/A</b>	<b>N/A</b>
<b>1018 (NEW)</b>	<b>PayRange's Opposition to CSC's Motion to Stay Pending Inter Partes Review, <i>PayRange Inc. v. CSC ServiceWorks, Inc.</i>, No. 1:23-cv-00278, Dkt. 59 (D. Del. Feb. 23, 2024)</b>	<b>N/A</b>	<b>N/A</b>
<b>1019 (NEW)</b>	<b><i>Nuance Comms., Inc. v. MModal, LLC</i>, No. 1:17-cv-01484, Dkt. 226, (D. Del. Apr. 11, 2019) (Noreika, J.)</b>	<b>N/A</b>	<b>N/A</b>
<b>1020 (NEW)</b>	<b><i>Waters Corp. v. Agilent Techs., Inc.</i>, No. 1:18-cv-01450, Dkt. 95 (D. Del. Aug. 6, 2019) (Noreika, J.)</b>	<b>N/A</b>	<b>N/A</b>

<u>Exhibit No.</u>	<u>Description</u>	<u>Publication Date (unless otherwise noted)</u>	<u>Type of Prior Art</u>
<b>1021 (NEW)</b>	<i>PayRange Inc. v. CSC ServiceWorks, Inc.</i> , No. 23-cv-278, Dkt. 61 (D. Del. Feb. 26, 2024)	N/A	N/A
<b>1022 (NEW)</b>	Excerpted Copy of U.S. District Courts—Combined Civil and Criminal Federal Court Management Statistics- Profiles for the Reporting Period ending June 30, 2024, available at <a href="https://www.uscourts.gov/data-news/reports/statistical-reports/federal-court-management-statistics/federal-court-management-statistics-june-2024">https://www.uscourts.gov/data-news/reports/statistical-reports/federal-court-management-statistics/federal-court-management-statistics-june-2024</a> .	N/A	N/A
<b>1023 (NEW)</b>	Institution Decision, <i>Alliance Laundry Systems, LLC v. PayRange LLC</i> , PGR2025-00027, Paper 12 (PTAB Aug. 25, 2025)	N/A	N/A
<b>1024 (NEW)</b>	Institution Decision, <i>Alliance Laundry Systems, LLC v. PayRange LLC</i> , PGR2025-00028, Paper 12 (PTAB Aug. 25, 2025)	N/A	N/A
<b>1025 (NEW)</b>	Notice of PGR Institution Decisions, <i>Alliance Laundry Systems, LLC v. PayRange LLC</i> , 1:24-cv-00733, Dkt. 33 (D. Del. Aug. 26, 2025)	N/A	N/A

## I. INTRODUCTION

The Acting Director has already rejected three requests from Patent Owner for discretionary denial of related patents. *See* Ex. 1015. Following referral, on August 25, 2025, the merits panel instituted post-grant review of the first two challenges to related patents in proceedings PGR2025-00027 and PGR2025-00028. *See* Exs. 1023, 1024. Because similar discretionary denial factors apply to this fourth proceeding, and because it would be most efficient for the Board to adjudicate all four challenged petitions on the merits, discretionary denial should be denied here as well.

*First*, the challenged patent, U.S. Patent No. 10,891,608 (“the ’608 Patent,” Ex. 1001) **has never been finally adjudicated by the Board**. While the Board has previously denied institution of a PGR and an IPR filed by two different petitioners, denial of institution is not an “adjudication.” Additionally, the present Petition presents different invalidity grounds than those presented in prior proceedings.

*Second*, challenges to three of the four patents in the parallel District of Delaware litigation<sup>1</sup> have already been referred to a merits panel, and two of those

---

<sup>1</sup> *Alliance Laundry Systems LLC v. PayRange Inc.*, No. 1:24-cv-00733 (D. Del. Jun. 20, 2024) (“Delaware Litigation”).

have already been instituted.<sup>2</sup> *See* Ex. 1015 (referring three petitions); Ex. 1023 (instituting PGR of related '920 Patent); Ex. 1024 (instituting PGR of related '423 Patent). Board adjudication of the '608 Patent (the fourth and final related patent) would be the most efficient use of resources as the Board is best suited to evaluate all invalidity challenges of the four related patents.

*Third*, as the Acting Director already found for the other three patents at issue, the related Delaware Litigation does not support denial under the *Fintiv* factors. *See* Ex. 1015. The Delaware Litigation is at an incredibly early stage and has essentially been paused since late 2024. No discovery has been requested or exchanged, there is no timeline for claim construction proceedings, no case schedule is in place, **and no trial date has been set.** Provided this IPR proceeding is instituted, the Board will issue its Final Written Decision well before any trial. Moreover, because the Board has already instituted PGR of the first two patents, Petitioner is in the process of preparing its motion to stay the Delaware Litigation. Statistics confirm that there is a high (upwards of **84%**) likelihood that the district court will stay the case.

*Finally*, there are no “settled expectations” that would support discretionary denial. The '608 Patent only issued in January 2021—less than 4.5 years before the

---

<sup>2</sup> The third proceeding (IPR2025-00573), a petition for IPR of the '772 Patent, remains pending, with an institution decision expected on or before October 7, 2025.

Petition was filed. And the petition was filed on April 29, 2025, just eight months after Patent Owner first accused Petitioner of infringing the '608 Patent in its Answer and Counterclaims filed August 23, 2024. The young age of the patent and Petitioner's early challenge undercut any "settled expectations."

For these reasons and as further explained below, Petitioner respectfully requests that the Acting Director again deny Patent Owner's discretionary denial request.

## **II. BACKGROUND**

### **A. Patent Owner's Patent Assertion Campaign**

Beginning in early 2020, Patent Owner began an aggressive campaign of patent litigation against companies that make, use, sell, or develop mobile payment systems, including KioSoft Technologies, LLC ("KioSoft") and CSC ServiceWorks, Inc. ("CSC"). A complete overview of Patent Owner's prior proceedings is included in the Petition, Paper 1, at \*\*1–5. Petitioner below highlights certain history that bears directly on issues of discretionary denial.

#### **1. Patent Owner's Lawsuits Against KioSoft**

PayRange asserted the '608 Patent against KioSoft in litigation captioned *PayRange Inc. v. KioSoft Technologies, LLC et al.*, 1:20-cv-24342 (S.D. Fla.). KioSoft thereafter filed a Petition for Post-Grant Review against Claims 1-20 of the '608 Patent. See *KioSoft Technologies, LLC v. PayRange Inc.*, PGR2021-00084,

Paper 1 (PTAB May 27, 2021). KioSoft’s Petition included six separate grounds of invalidity, three of which relied on U.S. Pat. No. 9,092,768 (“*Breitenbach*”) as either an anticipatory reference under 35 U.S.C. § 102 or a primary reference in an obviousness combination with other secondary references under 35 U.S.C. § 103. *See id.* at \*\*14–15. While Petitioner here relies on the same reference, *Breitenbach*, as a primary reference for both of its grounds of invalidity, neither of the two secondary references relied upon by KioSoft—U.S. Pat. No. 7,110,954 (“*Yung*”) and U.S. Pat. No. 6,743,095 (“*Cole*”)—are relied upon by Petitioner here. *Compare id.* at \*15 *with* Paper 1 at \*\*5–6. Instead, Petitioner relies on two secondary references— U.S. Patent No. 5,734,150 (“*Brown*”) and U.S. Patent No. 5,036,966 (“*Kaspar*”)—**that were never considered during prosecution.** *See* Ex. 1002 at 189, 210–212; *see also* Exs. 1005, 1006.

On December 16, 2021, the Board issued a decision denying institution of Post-Grant Review of the ’608 Patent. *See* PGR2021-00084, Paper 12. In doing so, the Board determined that petitioner KioSoft did “not sufficiently explain” how *Breitenbach* taught a retrofit device capable of “fooling” a payment accepting machine (e.g., a vending machine) by replicating a “coin-in” signal, which petitioner KioSoft argued “inherently” meant the retrofit device “stores and determines the number of electrical pulses.” *Id.* at \*27 (citing Petition at 60). The Board found that the obviousness grounds failed for similar reasons because petitioner KioSoft did

not rely upon *Yung* or *Cole* to cure the deficiency of *Breitenbach* related to limitation 1.4(a)<sup>3</sup> (“storing, in the memory of the payment module, a number of the electrical pulses that must be received by the control unit to initiate an operation of the offline payment operating machine”). *Id.* at \*28.

By contrast, the present Petition demonstrates how *Brown* teaches limitation 1.4(a) and why it would have been obvious for a POSA to combine *Breitenbach* with *Brown* to arrive at the claimed invention of independent Claim 1 (as well as Claims 2, 3, 5–9, 11–15, 17, and 18). *See* Pet. at \*\*18–23, 35–37. Kiosoft’s prior failed PGR petition does not warrant discretionary denial. *See LifeVac v. DCSTAR Inc.*, IPR2025-00454, Paper 11 at \*2 (Director Jul. 11, 2025) (“[P]etitions for *inter partes* review will generally not be discretionarily denied because of an earlier petition for post-grant review when the post-grant review was not instituted.”).

## **2. Patent Owner’s Lawsuits Against CSC**

Patent Owner previously sued CSC ServiceWorks, Inc. (“CSC”) for infringement of the ’608 Patent (and others) in Delaware District Court: *PayRange, Inc. v. CSC ServiceWorks, Inc.*, No. 22-cv-502-MN (D. Del.); *see also* No. 23-cv-278-MN (D. Del.); No. 24-cv-279-MN (D. Del.). CSC thereafter filed a petition for

---

<sup>3</sup> Using the nomenclature in the present Petition rather than the nomenclature in the petition filed by KioSoft.

IPR against Claims 1-2, 4-8, 10-14, 16-20 of the '608 Patent. *See CSC ServiceWorks, Inc. v. PayRange Inc.*, IPR2023-01188, Paper 1 (PTAB Jul. 17, 2023). CSC's first ground of invalidity under 35 U.S.C. § 103 relied on a combination of U.S. Patent Publication No. 2010/0227671 ("*Laaroussi*"), U.S. Patent No. 10,121,318 ("*LeMay*"), and U.S. Patent No. 4,374,557 ("*Sugimoto*"). *Id.* at \*13. CSC's second ground of invalidity relied on the combination of the same references as well as U.S. Patent No. 6,840,860 ("*Okuniewicz*"). *Id.* **The present Petition does not rely on any of the same references as CSC's petition in IPR2023-01188.** *Compare id.* at \*13 *with* Paper 1 at \*\*5–6.

On January 24, 2024, the Board issued a decision denying institution of CSC's IPR petition for the '608 Patent. *See* IPR2023-01188, Paper 12. In doing so, the Board determined that the combination of *Laaroussi* and *Sugimoto* failed to meet limitations 1.3 and 1.4(a)<sup>4</sup> because CSC did not "adequately account for the differences between *Laaroussi*'s signal, *Sugimoto*'s pulses, and the particular pulses recited by" these limitations. *Id.* at \*\*15–17.

In contrast, the present Petition demonstrates how *Breitenbach* teaches limitation 1.3, *Brown* teaches limitation 1.4(a), and why it would have been obvious

---

<sup>4</sup> Using the nomenclature in the present Petition rather than the nomenclature in the petition filed by CSC.

for a POSA to combine *Breitenbach* with *Brown* to arrive at the claimed invention of independent Claim 1 (as well as Claims 2, 3, 5-9, 11-15, 17, and 18). *See* Pet. at \*\*18–23, 35–37. This prior failed IPR petition filed by CSC—which relied entirely on different prior art than the present Petition—does not warrant discretionary denial of the instant Petition. *See LifeVac*, IPR2025-00454, Paper 11 at \*2.

**B. In 2024, Patent Owner’s Aggressions Turned Towards Petitioner**

Patent Owner argues that, in pre-suit correspondence, Patent Owner “desire[d] to engage in further discussion with the intent to seek amicable resolution” with Petitioner, but “Petitioner chose the path of litigation by filing a declaratory judgment action of noninfringement.” DD. Req. at \*4. That argument mischaracterizes the history of this dispute.

Despite Petitioner *granting Patent Owner a license* to make Patent Owner’s own products compatible with Petitioner’s machines, Patent Owner began a campaign of aggression against Petitioner in early 2024. On March 14, 2024, Patent Owner sent a letter accusing Petitioner of infringing a number of patents.<sup>5</sup> *See* Declaratory Judgment Compl., ¶ 51, *Alliance Laundry Systems LLC v. PayRange Inc.*, No. 1:24-cv-00733 (D. Del. Jun. 20, 2024). Patent Owner’s pre-suit

---

<sup>5</sup> U.S. Patent No. 11,966,920 (“920 Patent”), U.S. Patent No. 11,972,423 (“423 Patent”), and U.S. Patent No. 11,481,772 (“772 Patent”). Each of these have also been asserted by Patent Owner in the Delaware Litigation.

correspondence, including the original March 14 letter, **did not** accuse Petitioner of infringing any claim of the '608 Patent. *Id.* After Patent Owner refused to accept the clear evidence in Petitioner's pre-suit correspondence and continued to threaten and harass Petitioner, Petitioner reasonably filed its action for declaratory judgment of non-infringement. *Id.* The District of Delaware is an efficient forum for Petitioner's non-infringement claim: that Court previously heard multiple cases involving Patent Owner and is already familiar with its patents.

Despite never accusing Petitioner of infringing the '608 Patent in any pre-suit correspondence, Patent Owner counterclaimed for infringement of the '608 Patent with its Answer. *See* Ex. 2001, Counterclaims, ¶¶ 69–84. Thus, contrary to its characterizations, *Patent Owner* started this fight.

### **III. DISCRETIONARY DENIAL IS NOT WARRANTED**

#### **A. Prior Unsuccessful Challenges by Unrelated Petitioners Do Not Warrant Discretionary Denial**

Patent Owner argues that the present Petition should be denied because it is the third petition challenging the '608 Patent. DD Req., Paper 6 at 1. But patentability was never “adjudicated” in the prior challenges, which were brought by petitioners unrelated to Petitioner here. Moreover, because challenges to three other related patents have already been referred—and two have been instituted—efficiency is an important consideration that should be given heavy weight. *See* Exs.

1015, 1023, 1024. On balance, the prior challenges do not warrant discretionary denial.

**1. The Patentability of the '608 Patent Has Never Been “Adjudicated;” the Prior Challenges by Unrelated Petitioners Were Denied at Institution**

Patent Owner mischaracterizes the prior two petitions against the '608 Patent as instances where “[t]he claims of the '608 patent have already been adjudicated twice before the Board.” *Id.* But the two prior petitions were denied at the institution stage. The claims of the '608 Patent have never reached a final written decision and therefore have never been “adjudicated.” *See, e.g., Apple Inc. v. Vidal*, 63 F.4th 1, 6 (Fed. Cir. 2023) (“The Board...perform[s] the IPR adjudication if a review is instituted with the Board’s ‘final written decision’ in the IPR.”) (internal citation omitted).

Further, while the present Petition relies on the same primary reference, *Breitenbach*, as the KioSoft PGR petition, it relies on entirely different secondary references. The teachings of the secondary references and the resultant *combinations* with the primary reference have never been considered by the Office either during prosecution or in a post-grant proceeding. *See Microsoft Corp. v. ParTec Cluster Competence Center GmbH*, IPR2025-00318, Paper 9 (Director Jun. 12, 2025) (denying request for discretionary denial where petitioner provided persuasive evidence that the Office erred by overlooking the teachings of the *combinations* of

references). And the present Petition has **no overlap** with the prior art relied upon in the CSC IPR petition. Accordingly, the present challenge is not “substantially similar to those raised against a related patent.” DD Req. at \*8 (quoting *Azurity Pharmaceuticals, Inc. v. Exelixis, Inc.*, IPR2025-00427, Paper 13 at \*2 (Director July 2, 2025)).

Because the Board merely declined to institute review of both prior proceedings, the Board has never reached a final written decision on the claims of the '608 Patent and, thus, has never “adjudicated” the validity of these claims. *See Apple*, 63 F.4th at 6.

**2. An Exception From The Acting Director’s *LifeVac* Decision is Not Warranted**

The Acting Director recently considered—and rejected—similar arguments to those advanced by Patent Owner here. In *LifeVac, LLC v. DCSTAR Inc.*, the Acting Director denied petitioner’s request for discretionary denial, concluding that “petitions for *inter partes* review will generally not be discretionarily denied because of an earlier petition for post-grant review when the post-grant review was not instituted.” *See* IPR2025-00454, Paper 11, at \*2 (Director Jul. 11, 2025) (disregarding the earlier challenge because it “did not result in a final written decision”). Moreover, in *LifeVac*, both challenges were brought by the same party, whereas here, Petitioner has no relationship to the two prior petitioners who

challenged the '608 Patent. *Id.*; see also *Cellco P'ship v. Gen. Access Sols., Ltd.*, IPR2023-00978, Paper 20 at \*19 (PTAB Dec. 14, 2023) (“Once resolution of factor 1 [of *General Plastic*] indicates that Petitioner had not previously filed a petition against the same patent, factors 2–5 bear little relevance.”).

Patent Owner concedes as much, noting that “petitions for *inter partes* review will generally not be discretionarily denied because of an earlier petition for post-grant review when the post-grant review was not instituted.” DD. Req. at \*7 (quoting *LifeVac*, IPR2025-00454, Paper 11 at \*2). Nevertheless, Patent Owner asks for an exception, arguing that “the circumstances presented in this case fall outside this general guideline.” *Id.* No such exception is warranted.

*First*, Patent Owner argues for an exception because “the IPR petition submitted by the petitioner in *LifeVac* challenged the claims of the patent based on wholly new prior art compared to the previous PGR proceeding, reducing road-mapping concerns.” DD Req. at \*8. As an initial matter, the PTAB has “disagree[d] that...purported road-mapping is a reason to discretionarily deny institution.” *Skechers U.S.A., Inc. v. Nike, Inc.*, IPR2025-00142, Paper 11 at \*5 (PTAB Jun. 12, 2025).

Additionally, because Petitioner has no relationship with the two prior petitioners, the “Office’s well-established policy that application of the *General Plastic* framework does not extend to serial petitions where the first and second

petitioners are neither the same party nor have a ‘significant relationship’” applies. *Id.*; *see also Videndum*, IPR2023-01218, Paper 12 at \*2 (a second petitioner’s reliance on a first petitioner’s earlier-filed petition, “even ‘as a menu or road map,’ is not sufficient to create a significant relationship that favors denial under the first *General Plastic* factor”).

Thus, the facts of this proceeding are distinguishable from Patent Owner’s cited decisions. DD Req. at \*\*7–8. In *Comcast Communications, LLC v. Entropic Communications, LLC*, the petition was discretionarily denied due, in part, to denials of the **same petitioner’s** prior challenges to a related patent having “similar claims to those in the challenged patent.” *See* IPR2025-00183, Paper 11 at \*2 (Director June 25, 2025). The same is true of the recent decision in *Azurity Pharmaceuticals, Inc. v. Exelixis, Inc.*, where the petition was discretionarily denied due, in part, to a denial of the **same petitioner’s** prior challenge to a related patent. *See* IPR2025-00427, Paper 13 at \*2 (Director July 2, 2025).

Petitioner here has no relationship with the prior petitioners, much less a “significant relationship,” and Patent Owner has not argued as much. *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 at \*10 (PTAB Apr. 2, 2019) (precedential). Accordingly, *Comcast* and *Azurity* do not apply. *See Comcast*, IPR2025-00183, Paper 11 at \*2 (noting the disfavored “practice of the *same party* filing multiple petitions challenging the same patent”) (emphasis added); *Azurity*,

IPR2025-00427, Paper 13 at \*2 (identifying earlier challenges brought by the same petitioner). And Petitioner’s reliance on the same primary reference as a prior petitioner does not create any “implicit” relationship. *See, e.g., Ford Motor Co. v. Neo Wireless LLC*, IPR2023-00763, Paper 28 at \*4–5 (Vidal Mar. 22, 2024) (rejecting patent owner’s argument that Ford’s use of prior Volkswagen and Dell IPRs “as a roadmap for its Petition” was sufficient to create “an ‘implicit’ relationship”).

*Second*, Patent Owner argues for an exception to *LifeVac* because “the strength of Petitioner’s unpatentability challenge and its reliance on expert testimony further support discretionary denial because they mimic deficiencies identified by the Board in the previous proceedings against the ’608 patent.” DD Req. at \*\*9–10. This is wrong. The Petition explains the grounds in great detail, including for the limitations found inadequately addressed in the prior institution decisions.

Specifically, Patent Owner alleges the Petition “does not address” “Breitenbach’s descriptions of storing operation instructions remote from the machine 108 at controller 102.” *Id.* (citing *KioSoft*, PGR2021-00084, Paper 12 at \*27). But this is a strawman: Petitioner **does not rely on Breitenbach to teach the relevant limitation**. The KioSoft petition relied upon *Breitenbach* as allegedly teaching limitation 1.4(a) (“storing, in the memory of the payment module, a number of the electrical pulses that must be received by the control unit to initiate an

operation of the offline payment operating machine”). *KioSoft*, PGR2021-00084, Paper 2 at \*60 (“Breitenbach inherently stores in the memory of the retrofit device...the number of electrical pulses[.]”). By contrast, the present Petition **does not** rely on *Breitenbach* for limitation 1.4(a) and instead demonstrates how *Brown* teaches this limitation and why it would have been obvious for a POSA to combine *Breitenbach* with *Brown* to arrive at the claimed invention of independent Claim 1. *See* Pet. at \*\*18–23, 35–37 (explaining how *Brown* teaches “[t]he exact nature of which coin signals are to be generated may be predetermined and stored in memory 22[.]”).

As to Petitioner’s use of expert testimony, Patent Owner made nearly identical arguments in the three prior proceedings. *See* PGR2025-00027, Paper 6 at \*\*31–32; PGR2025-00028, Paper 6 at \*\*28–30; IPR2025-00573, Paper 6 at \*\*24–25. The Acting Director rightly dismissed those arguments out of hand and without comment, and should do the same here. *See* Ex. 1015; *see also* Ex. 1023 at \*32 (crediting “Dr. Neuman’s testimony [which] specifically addresse[d] how those limitations were well-understood, routine, and conventional.”); Ex. 1024 at \*26 (same). But to the extent the Acting Director considers this argument anew, it still fails.

Petitioner’s expert properly explained how a POSA would understand certain claim limitations and disclosures of the prior art. *Id.* at \*10. Indeed, a POSA’s

understanding is critical both to claim construction issues and to obviousness considerations. *See, e.g., Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417, 418, 421 (2007). Nor can the understanding of a POSA be proven only with attorney argument, which is not evidence. *E.g., Elbit Sys. of Am., LLC v. Thales Visionix, Inc.*, 881 F.3d 1354, 1359 (Fed. Cir. 2018) (“Attorney argument is not evidence.”) (internal quotations omitted). Indeed, the Board recently confirmed that expert testimony is *essential* to properly support arguments that are evaluated from the perspective of a POSA. *See, e.g., PLR Worldwide Sales Ltd. v. Flip Phone Games, Inc.*, IPR2024-000209, Paper 28 at \*32 (PTAB Apr. 24, 2025) (“It is well settled that mere attorney argument unsupported by factual evidence is entitled no probative value.”); *see also, e.g., GD Energy Prods., LLC v. Kerr Machine Co.*, PGR2025-00031, Paper 11 at \*2 (Director Jun. 25, 2025) (rejecting patent owner’s argument that petitioner had improper “extensive reliance” on expert testimony, and finding instead that “the testimony is merely complying with regulations requiring disclosure of ‘underlying facts or data’”). And in the Institution Decisions for the related patents, the merits panel credited Petitioner’s use of expert testimony, finding, *e.g.*, “Dr. Neuman’s opinion that the recited components were well-understood, routine, and conventional is supported by disclosures in the” challenged patent. *See* Ex. 1023 at \*31; Ex. 1024 at \*26.

Patent Owner is also wrong that the Petition insufficiently explains “how the art taught the claimed electrical pulses.” DD Req. at \*9. To the contrary, the Petition and its citations to Dr. Neuman’s report analyze and explain the signals that are described in the prior art to arrive at the claimed invention. Specifically, Dr. Neuman is a POSA and used his expertise to explain background information and the understanding of a POSA as to both claim interpretation and obviousness issues, including how a POSA would understand *Breitenbach’s* disclosure of a retrofit device that “replicat[es] a ‘coin-in’ signal indicative of the proper payment amount[.]” *See e.g.*, Ex. 1003 at ¶¶ 104–108 (explaining that “a POSA would have understood that a “coin-in” signal is an electrical pulse emulating an analog signal generated by the coin receiving switch of the offline payment-operated machine in response to insertion of a coin of a predetermined type”).

Dr. Neuman’s robust expert testimony, and Petitioner’s citation of it in support of the Petition, is a “feature, not a bug of his testimony,” a feature that the Board recently commended. *See, e.g., Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00032, Paper 11 at \*39 (PTAB May 19, 2025); *see also, e.g., GD Energy Prods.*, PGR2025-00031, Paper 11 at \*2; *see also* Ex. 1023 at \*31; Ex. 1024 at \*26. Accordingly, Petitioner’s proper reliance on evidence-backed expert testimony to support the strong unpatentability grounds in the Petition weighs against discretionary denial. *See* March 2025 Memorandum; *see also* Ex. 1015.

*Finally*, one of the factors that informs discretionary denial is the need “[t]o maintain consistency with Discretionary Decisions that the Director has already issued.” *See* Interim Director Discretionary Process Webpage (“Discretionary Webpage”), Section I.A.<sup>6</sup> This need to maintain consistency with prior decisions weighs against an exception to the *LifeVac* decision in this case.

### **3. Efficiency Considerations Weigh Against Discretionary Denial**

Not only has Patent Owner failed to demonstrate any reason for deviating from the *LifeVac* holding, but the reasons why it would be *inefficient* to discretionarily deny IPR of the ’608 Patent are legion.

*First*, there are three other related patents at issue in this dispute, with two subject to PGR challenges and the other subject to an IPR challenge. *See* PGR2025-00027 (’920 Patent), PGR2025-00028 (’423 Patent), IPR2025-00573 (’772 Patent). The Acting Director previously referred these three to a merits panel. *See* Ex. 1015. And for the first two, the Board considered the merits and instituted PGR. *See* Ex. 1023, Institution Decision (PGR2025-00027); Ex. 1024, Institution Decision (PGR2025-00028);). As such, because “the parallel district court proceeding between Petitioner and Patent Owner involves other patents that have been referred

---

<sup>6</sup> <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (last visited August 28, 2025).

to the Board...it is an efficient use of Board resources to address the challenged patent as well.” *Adv. Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00478, Paper 10 at \*3 (Director Jul. 31, 2025). And not only have three of the other patents been “referred to the Board,” two have already been instituted for PGR; thus, this is an even stronger case for the ’608 Patent to be referred to a merits panel than the case presented in *Adv. Micro Devices. Id.*

*Second*, not only are all four patents in the same litigation, they are also related. All four patents claim priority to the same priority application.<sup>7</sup> They also share the exact same technical field and background, and substantial portions of the figures and specification are identical across all four patents. *Compare* Ex. 1001 with ’920 Patent, ’423 Patent, ’772 Patent. The Acting Director has made clear that “it is an efficient use of Board resources to address [a] related patent.” *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at \*\*3–4 (Director Jul. 16, 2025); *see also Embody, Inc. v. LifeNet Health*, IPR2025-00248, Paper 12 at \*3 (Director Jun. 26, 2025) (same). Accordingly, because the ’608 Patent includes significant overlap with the two patents instituted for PGR and one referred patent, it is an efficient use of Board resources to address this related patent. *Id.*

---

<sup>7</sup> U.S. App. No. 14/456,683 (issued as U.S. Pat. No. 9,256,873).

*Third*, discretionary denial of the '608 Patent IPR would result in many inefficiencies. Now that PGR of two related patents has been instituted, Petitioner is in the process of seeking a stay of the Delaware Litigation. *See* Ex. 1023, 1024; *see also* Ex. 1025 (August 26, 2025 Notice of PGR Institution Decisions, filed with the District Court). But if the '608 IPR is discretionarily denied, it could result in a partial stay of the Delaware Litigation excluding the '608 Patent, while at least the two other patents proceed through the PGR and IPR process at the PTAB. Alternatively, the Delaware Litigation may be stayed in its entirety and then reopened only after final written decisions and any related appeals are resolved with the at least two other patents. Either scenario is far less efficient than the Board adjudicating the validity of all four patents.

*Finally*, the four patents in the Delaware Litigation collectively include dozens of claims with varying scope of claimed subject matter. “The large number and vast scope of the patents asserted in the district court litigation weighs against discretionary denial, as the Board is better suited to review a large number of patents[.]” *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at \*\*2–3 (Director June 13, 2025) (internal citation omitted).

**4. This Case has Important Distinctions from the *Advanced Cluster* Decision**

The Acting Director recently denied a petition where one of the relevant factors was that “the challenged patent was involved in two prior Board proceedings.” See *Intel Corp. v. Advanced Cluster Systems, Inc.*, IPR2025-00794, Paper 13 at \*\*2–3 (Director Aug. 14, 2025). In *Advanced Cluster*, the prior Board proceedings were brought by different petitioners. *Id.* Petitioner is not aware of any other decisions discretionarily denying institution based on prior challenges brought by different petitioners, and Patent Owner here has cited none. But even if the facts of *Advanced Cluster* warranted an exception from the *LifeVac* principle, on balance, the facts here do not.

*First*, the *Advanced Cluster* challenged patent had been in force for approximately six years, which the Acting Director found created settled expectations for Patent Owner. *Id.* By contrast, here the ’608 Patent had only been in force for approximately 4.5 years before the Petition was filed, which the Acting Director has repeatedly held does *not* create settled expectations. See Pet.; Ex. 1001; *see also infra* Section III.D.1.

*Second*, the two prior proceedings in *Advanced Cluster* were both petitions for *inter partes* review, whereas, here, one of the prior proceedings was a petition for post-grant review and another was a petition for *inter partes* review. *Advanced*

*Cluster*, IPR2025-00794, Paper 13 at \*\*2–3. Accordingly, the prior failed PGR petition brought by a party unrelated to Petitioner does not warrant discretionary denial per the Acting Director’s recent guidance. *LifeVac*, IPR2025-00454, Paper 11 at \*2 (“[P]etitions for *inter partes* review will generally not be discretionarily denied because of an earlier petition for post-grant review when the post-grant review was not instituted.”). Similarly, the prior failed IPR petition brought by a party unrelated to Petitioner likewise does not warrant discretionary denial. *Skechers*, IPR2025-00142, Paper 11 at \*7 (“[A]bsent any evidence indicating that Skechers and lululemon are the same party or have a significant relationship with regard to the challenged patent, we decline to discretionarily deny Skecher’s later petition in view of lululemon’s earlier petition.”).

*Third*, the countervailing efficiency factors of this dispute—which were not present in *Advanced Cluster*—warrant the use of Board resources to consider Petitioner’s arguments on the merits. *See generally* Section III.A.3. The Acting Director has already referred three proceedings for related patents. *See* Ex. 1015. And the first two to be considered on their merits were instituted, with the Board finding “that the information presented in the Petition demonstrates it is more likely than not that at least one challenged claim is unpatentable.” Ex. 1023 at \*2; *see also* Ex. 1024 at \*2 (same). The Acting Director previously recognized that a stay of the Delaware Litigation is likely. *See* Ex. 1015 at \*2 (“[T]here is a high likelihood of a

stay should these proceedings be instituted.”). If the District Court stays the case in its entirety but the present Petition is discretionarily denied, the ’608 Patent will not be adjudicated for several years. But the alternative would be even less efficient: with a partial stay, Petitioner’s challenges to the first three patents would proceed in this forum and be stayed in the District Court, while the ’608 Patent proceeds in the District Court in parallel. Neither option is an efficient use of party or judicial resources, and these efficiency considerations should outweigh concerns regarding the two prior challenges by other petitioners.

**B. Discretionary Denial Under 35 U.S.C. § 325(d) and *Advanced Bionics* is Not Warranted**

Patent Owner did not argue that the two-part framework of *Advanced Bionics* or Section 325(d) support discretionary denial. *See* DD Req. However, even if the Acting Director considers this issue, it does not support discretionary denial. The *Advanced Bionics* framework considers: (1) whether the same, or substantially the same, prior art or arguments were previously presented to the Office; and (2) if the first prong is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims. *See, e.g., Advanced Bionics, LLC v. MED-EL Elektromedizinische Gerate Gmbh*, IPR2019-01469, Paper 6, at \*\*7–8 (PTAB Feb. 13, 2020); *see also Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13, at \*\*2-4 (Director May 19,

2025) (precedential as to Section A). The factual inquiry is guided by six *Becton, Dickinson* factors. *Id.* (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017)).

Here, the three references relied upon in the Petition—*Breitenbach, Brown*, and *Kaspar*—were **never presented during prosecution of the application that issued as the '608 Patent.** Patent Owner does not assert otherwise, nor does it argue that the references are cumulative of any reference that was presented. Accordingly, prong one of the *Advanced Bionics* analysis and *Becton, Dickinson* Factor (a) weigh against discretionary denial. *See, e.g., Kubota North American Corp. v. Vermeer Manufacturing Co.*, IPR2025-00169, Paper 16 at \*16 (PTAB Jun. 10, 2025) (declining to discretionarily deny the petition where the reference relied upon “was not previously presented to the Office”). Because the first prong of *Advanced Bionics* fails, there is no need to analyze the second prong. *Id.*

### **1. The Examiner Did Not Evaluate the Asserted Art During Examination**

*Becton, Dickinson* Factors (a) and (c) consider “(a) the similarities and material differences between the asserted art and the prior art involved during examination” and “(c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection.” *Becton, Dickinson*, IPR2017-01586, Paper 8 at \*17; *see also Advanced Bionics*, IPR2019-

01469, Paper 6 at \*8; *Ecto World*, IPR2024-01280, Paper 13, at \*5. During prosecution, the '608 Patent faced only a single Office Action rejecting all pending claims under 35 U.S.C. § 101 and under non-statutory double-patenting over U.S. Patent No. 9,875,473. *See* Ex. 1002, pp. 179–87.

Thus, the asserted prior art “was not a basis for rejection during examination.” *See Ecto World*, IPR2024-01280, Paper 13, at \*5. And the asserted prior art “is not substantially the same as prior art the Examiner applied.” *Id.* Rather, the Examiner did not “apply” any art (only patent eligibility and non-statutory double-patenting rejections), and Patent Owner does not contend otherwise, or argue that the asserted art is cumulative of the references considered during prosecution.

**2. There is No Overlap Between the Art in the Petition and the Art Considered by the Examiner**

*Becton, Dickinson* Factors (b) and (d) consider “(b) the cumulative nature of the asserted art and the prior art evaluated during examination” and “(d) the extent of the overlap between the arguments made during examination and the manner in which the Petitioner relies on the prior art or Patent Owner distinguishes the prior art.” *Becton, Dickinson*, IPR2017-01586, Paper 8 at \*\*17–18. Neither *Breitenbach*, nor *Brown*, nor *Kaspar* were ever considered during prosecution and, consequently, the combination of these references was not considered by the Examiner as there were no prior-art-based rejections against the '608 Patent during prosecution.

Accordingly, these references cannot be cumulative of the art evaluated by the Examiner and/or cited in an Office Action, and Patent Owner has not asserted, much less demonstrated, that *Breitenbach*, *Brown*, and *Kaspar* are cumulative of any prior art references evaluated by the Examiner.

Further, the present Petition asserts unpatentability based on obviousness, which does not overlap with the patent eligibility and double-patenting rejections issued during prosecution. Thus, *Becton*, *Dickinson* Factors (b) and (d) strongly weigh against discretionary denial.

### **3. The Examiner's Prior Art Analysis Was Erroneous**

*Becton*, *Dickinson* Factors (e) and (f) consider “(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 the prior art or arguments.” *Id.*; *see also Advanced Bionics*, IPR2019-01469, Paper 6 at \*8; *Ecto World*, IPR2024-01280, Paper 13, at \*\*5-6.

During prosecution, the references relied upon in the Petition were never considered by the Office and “the Examiner did not issue any prior art rejections during examination.” *Ecto World*, IPR2024-01280, Paper 13, at \*\*5–6. The Examiner’s failure to identify and apply the teachings of the prior art references relied upon in the instant Petition relative to the claims of the ’608 Patent

demonstrates that “the Examiner materially erred by overlooking certain teachings in the prior art.” *Id.*; *see also Advanced Bionics*, IPR2019-01469, Paper 6 at \*8 n.9. The Petition demonstrates how *Breitenbach* alone teaches nearly every limitation of every Challenged Claim, and how *Brown* and *Kaspar* teach the modest remaining claimed features not expressly taught by *Breitenbach*. *See, e.g., Pet.* at \*\*18–77. Thus, the Examiner committed a material error that weighs against discretionary denial by failing to identify or apply *Breitenbach*, *Brown*, *Kaspar*, and their respective teachings.

**C. Discretionary Denial Under *Fintiv* is Not Warranted**

**1. Petitioner’s Declaratory Judgment Does Not Warrant Discretionary Denial**

That Petitioner first filed an action for declaratory judgment of non-infringement and then subsequently filed the present Petition for IPR does not warrant discretionary denial. The Acting Director recently found as much when it rejected Patent Owner’s arguments and referred three other proceedings to a merits panel. Ex. 1015; *see also ResMed Corp. v. Cleveland Med. Devices, Inc.*, IPR2025-00246, Paper 10 (Director Jun. 12, 2025) (denying request for discretionary denial following petitioner’s declaratory judgment action). In *Epic Games, Inc. v. Acceleration Bay LLC*, the court held: “[u]nlike a patent infringement defendant (which cannot bring an IPR more than one year after being sued) or a declaratory

judgment plaintiff seeking a judgment of invalidity (which cannot seek an IPR at all), *a declaratory judgment counterclaimant faces no apparent restrictions on seeking an IPR.*” No. 4:19-cv-04133, 2020 WL 1557436, \*1, 3 (N.D. Cal. Apr. 1, 2020) (emphasis added). Any interpretation to the contrary would usurp the role of Congress because “Congress has spoken, using unambiguous language, concerning ‘a civil action challenging the validity of a claim of the patent,’ as in § 315(a)(1), and ‘counterclaim,’ as in § 315(a)(3). In our view, the above-referenced policy considerations do not override the unambiguous statutory language.” *Canfield Scientific, Inc. v. Melanoscan, LLC*, IPR2017-02125, Paper 7 at \*\*2–3 (PTAB Mar. 30, 2018).

Congress specifically endorsed Petitioner’s actions by enumerating “[a] counterclaim challenging the *validity* of a claim of a patent” exception to the bar against institution of a post-grant review after the filing of a civil action. 35 U.S.C. § 325(a)(3). The “unambiguous statutory language” of Section 325 makes it clear that Petitioner’s filing of a declaratory judgment of *non-infringement* does not bar Petitioner from subsequently filing a petition for post-grant review. *Canfield Scientific*, IPR2017-02125, Paper 7, at \*\*3–4; *see also, e.g., Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2012-00022, 2013 WL 2181162, at \*4–5 (PTAB Feb. 12, 2013).

Consistent with Congress’s statutory scheme, the Board routinely institutes *inter partes* review proceedings where a petitioner first filed a declaratory judgment of non-infringement, and recently instituted PGR for two patents related to the ’608 Patent under the same circumstances. *See* Exs. 1023, 1024; *see also, e.g., Trove Brands, LLC v. CamelBak Products, LLC*, IPR2025-00140, Paper 14 at 2–3 (PTAB Jun. 6, 2025) (granting institution of IPR where Petitioner had “filed suit against Patent Owner seeking a declaratory judgment of noninfringement in district court litigation”); *Synthego Corp. v. Agilent Techs., Inc.*, IPR2022-00402, Paper 11 at 12 n.14 (PTAB May 31, 2022) (same). As one PTAB panel stated, “we are not persuaded that, in the general case, the equities weigh against permitting a petitioner who filed a declaratory judgment action of non-infringement against a patent to also file a petition challenging the patentability of claims of that patent.” *Avery Dennison Retail Information Services LLC et al v. EVERYTHING Limited*, IPR2021-01259, Paper 14 at 14–15 (PTAB Jan. 25, 2022).

## **2. The *Fintiv* Factors Do Not Support Discretionary Denial**

The Board also considers six *Fintiv* Factors<sup>8</sup> when considering discretionary denial, five of which weigh heavily against discretionary denial here. *Apple Inc. v.*

---

<sup>8</sup> The *Fintiv* Factors are: “1. [W]hether 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

*Fintiv, Inc.*, IPR2020-00019, Paper 11, at \*\*5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). By referring the petitions challenging the three other patents of the Delaware Litigation, the Acting Director has already agreed that *Fintiv* does not support discretionary denial as the *Fintiv* analysis for the ’608 Patent is nearly identical to that of the other three patents of the Delaware Litigation. *See* Ex. 1015. However, for the sake of completeness, Petitioner demonstrates below why discretionary denial under *Fintiv* is not appropriate here.

***Fintiv* Factor 1** weighs against discretionary denial because Petitioner is in the process of seeking a stay of the Delaware Litigation and, as recognized by the Acting Director in the decision to refer the related patents to a merits panel, “there is a high likelihood of a stay should th[is] proceeding[] be instituted.” Ex. 1015 at \*2. Judge Noreika, who is presiding over the Delaware Litigation, routinely grants motions to stay when IPRs or PGRs have been instituted. *See, e.g.*, Ex. 1019, *Nuance Comms., Inc. v. MModal, LLC*, No. 1:17-cv-01484, Dkt. 226, at 25:13–30:20 (D. Del. Apr. 11, 2019) (Noreika, J.) (staying case where “the PTAB [h]as instituted on all of the asserted claims of all [asserted] patents”); Ex. 1018, *Chemours Co. FC*,

---

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.”

*LLC v. Daikin Indus. Ltd.*, No. 1:17-cv-01612, Dkt. 77, at 29:1–32:24 (D. Del. Jan. 3, 2019) (Noreika, J.) (same). In fact, according to Docket Navigator statistics analyzing motions to stay pending IPR/PGR filed both before and after institution, Judge Noreika grants or partially grants **84%** of such motions and the District of Delaware grants or partially grants **68%** of such motions.<sup>9</sup> *See* Exs. 1016, 1017. The significant likelihood that the Delaware Litigation will be stayed weighs against discretionary denial. *See, e.g., Imperative Care, Inc. v. Inari Med., Inc.*, IPR2025-00289, Paper 9 at 2 (Director June 12, 2025) (denying request for discretionary denial where no trial date was scheduled and there was evidence that the district court was likely to grant a stay if IPR was instituted).

That Petitioner has not yet requested a stay is of no import, as the customary practice in the District of Delaware is to wait until after institution to seek a stay; pre-institution motions to stay are typically denied as premature. *See, e.g., Ex. 1020, Waters Corp. v. Agilent Techs., Inc.*, No. 1:18-cv-01450, Dkt. 95 (D. Del. Aug. 6, 2019) (Noreika, J.) (denying “request to stay the litigation pending IPR without prejudice to renew after the PTAB decision on institution”). And in view of the

---

<sup>9</sup> Exhibit 1016 shows that Judge Noreika granted motions to stay in their entirety in 45 out of 55 cases (82%) and granted one partial motion to stay (2%). Exhibit 1017 shows that the District of Delaware granted motions to stay in their entirety in 370 out of 578 cases (64%) and granted partial motions to stay in 22 other cases (4%).

Board's institution of PGR of two related patents, Petitioner is in the process of preparing its motion to stay and expects to file it in short order. *See, e.g.*, Ex. 1025.

Indeed, in Patent Owner's prior litigation with CSC before Judge Noreika, Patent Owner opposed CSC's motion to stay *precisely because* it was filed pre-institution. Patent Owner argued that "CSC's motion [to stay] is premature because the PTAB has still not yet issued an institution decision" and "[t]he appropriate time to consider a stay is after all of the institution decisions have been entered." *E.g.*, Ex. 1021, No. 23-cv-278, Dkt. 59 at 1, 4 (arguing that "courts almost invariably deny requests for stays pending IPR proceedings when the stay requests are filed before the IPR is instituted") (citing *IOENGINE, LLC v. PayPal Holdings, Inc.*, No. 18-452, 2019 WL 3943058, at \*6 (D. Del. Aug. 21, 2019)). Judge Noreika thereafter denied the motion to stay without prejudice, and ordered that CSC could renew its motion after the PTAB's institution decision. *See* Ex. 1021, No. 23-cv-278, Dkt. 61 (D. Del. Feb. 26, 2025). Petitioner's decision here to wait until after the recent PGR institution decisions before seeking a stay respects Judge Noreika's practice and does not support discretionary denial.

**Fintiv Factor 2** weighs heavily against discretionary denial because, as the Acting Director previously found, "the related district court proceeding has **no scheduled trial date**, [and] there has been relatively little investment in that proceeding." Ex. 1015 at \*2 (emphasis added). No case schedule has even been

entered. *See, e.g.*, Delaware Litigation, Dkts. 21–28, 30; *see also, e.g.*, *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11 at \*2 (Director June 26, 2025) (denying discretionary denial where there was no scheduled trial date or Markman hearing date). Moreover, based on recent statistics, it is unlikely that the Delaware Litigation would reach trial before March 2027. *See* Ex. 1022 (noting a median time of 32.9 months from filing to trial in the District of Delaware); *see also, e.g.*, USPTO March 24, 2025 Guidance (“Boalick Memo”) (noting that “the Board may consider . . . median time-to-trial statistics”). By contrast, the Board’s statutory Final Written Decision deadline in this proceeding will be approximately November 2026. Accordingly, the extremely early stage of the Delaware Litigation weighs heavily against discretionary denial. *See, e.g.*, *Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-00250, Paper 14 at \*2 (Director May 16, 2025) (rejecting discretionary denial where it was “likely that a final written decision in this proceeding will issue before the district court trial occurs”); *Merck Sharp & Dohme LLC v. Halozyme, Inc.*, PGR2025-00006, Paper 29 at \*2 (Director June 12, 2025) (finding that this factor weighed against discretionary denial where district court had not yet scheduled a trial date and the final written decision was projected to issue years before any trial).

***Fintiv* Factor 3** weighs heavily against discretionary denial for similar reasons: due to the nascency of the Delaware Litigation, the parties (and especially

the Court) have invested very little in it. *No discovery has been requested or exchanged, no contentions have been exchanged, and there is not even an overall case schedule or deadlines for claim construction proceedings.* And the very little time invested in the Delaware Litigation is limited to Section 101 issues—there has been *no investment* concerning Sections 102, 103, or claim construction. Indeed, because Petitioner’s motion to dismiss is pending, Petitioner has not even answered Patent Owner’s counterclaims. This weighs heavily against discretionary denial. *See, e.g., Fintiv*, IPR2020-00019, Paper 11, at \*10 (“[i]f, 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.”). Indeed, in the *ResMed* decision, the Acting Director denied the request for discretionary denial even though the parties had “invested some resources into the district court proceeding.” IPR2025-00246, Paper 10 at \*2. Here, by contrast, the very little investment in the district court proceeding was limited to Section 101 issues, wholly unrelated to the issues in the present Petition.

Finally, Factor 3 “weigh[s] against exercising the authority to deny institution” because Petitioner “filed the petition expeditiously.” *Fintiv*, IPR2020-00019, Paper 11, at \*11. Petitioner filed the Petition almost 4 months before its statutory deadline to do so. *See Pet.; Alliance Laundry Systems LLC v. PayRange Inc.*, No. 1:24-cv-00733, Dkt. 11 (D. Del. Aug. 23, 2024). Several recent decisions

(including decisions issued after the March 2025 Memorandum) have agreed that similar expeditious filings weigh against denial. *See, e.g., Samsung Elecs. Co. v. Mullen Indus.*, IPR2024-01472, Paper 9 at \*10 (PTAB Mar. 31, 2025) (“Petitioner’s diligence in filing its Petition (a) less than five months after receiving Patent Owner’s infringement contentions and (b) prior to the parties briefing claim construction issues weighs against exercising discretionary denial.”); *Samsung Elecs. Co. v. Headwater Research LLC*, IPR2024-01396, Paper 13 at \*7 (PTAB Apr. 1, 2025) (“[W]e find Petitioner’s diligence in filing its Petition approximately 4 months before it was statutorily required to do so, and while litigation is in its early stages, weighs against denial, not for it.”); *ResMed*, IPR2025-00246, Paper 10 at \*2 (“Early challenges favor robust, predictable patent rights and weigh against discretionary denial”).

Accordingly, *Fintiv* Factor 3 weighs against denial.

***Fintiv* Factor 4** weighs against discretionary denial because any overlap between the pending motion to dismiss in the Delaware Litigation and present IPR proceeding will be resolved by staying the district court litigation. Further, Petitioner included a *Sotera* stipulation in its Petition, and will file the same in the Delaware Litigation with its forthcoming motion to stay. Pet. at \*77.

Also favoring institution is the fact that the Petition challenges all claims of the ’608 Patent, which includes claims Patent Owner is not asserting in the Delaware

Litigation. *See Alliance Laundry Systems LLC v. PayRange Inc.*, No. 1:24-cv-00733, Dkt. 18 at PageID.968 ¶ 76 (D. Del. Oct. 4, 2024). These additional challenged (but unasserted) Claims 3, 4, 9, 10, 14–16, and 20 differ in scope from asserted Claims 1, 2, 5, 6–8, 11–13, and 17–19, meaning that important issues in the Petition will *not* be resolved in the Delaware Litigation—further reducing the degree of overlap between this proceeding and the Delaware Litigation. *See, e.g., Fintiv*, IPR2020-00019, Paper 11, at \*13 (examining whether the district court will “resolve key issues in the petition”); *see also, e.g., Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at \*\*21–22 (PTAB May 20, 2025) (“Petitioner elected to challenge additional, unasserted claims for efficiency reasons.”); *id.*, Paper 10 (Director June 13, 2025) (denying request for discretionary denial).

Accordingly, Factor 4 weighs heavily against discretionary denial because (i) Petitioner’s *Sotera* stipulation will eliminate overlap with invalidity issues in the Delaware Litigation; and (ii) the patentability of the unasserted claims will not be resolved in the Delaware Litigation.

***Fintiv* Factor 5** weighs slightly in favor of discretionary denial, as the parties to this proceeding are the same as the Delaware Litigation. However, the Board declines to discretionarily deny when, like here, “when balanced with factors 1-4, there is no indication of inefficiencies or duplication of efforts between the PTAB

and the district court.” *Sony Group Corp. v. Inmusic Brands, Inc.*, IPR2023-00294, 2023 WL 5167545, at \*6 (PTAB July 25, 2023).

***Fintiv* Factor 6** weighs heavily against discretionary denial. Petitioner has strong grounds of invalidity under Section 103. *Cf.* Exs. 1023, 1024 (instituting PGR of two related patents to the ’608 Patent under Section 103). As demonstrated in the Petition, Claims 1–3, 5–9, 11–15, 17 and 18 are invalid under Section 103 over *Breitenbach* in view of *Brown*. Pet. at \*\*18–52. Further, Claims 4, 10, 16, 19, and 20 are invalid under Section 103 over *Breitenbach* in view of *Brown* further in view of *Kaspar*. *Id.* at \*\*52–77. While the Board previously denied the PGR petition filed by KioSoft challenging the ’608 Patent based on invalidity grounds relying on *Breitenbach*, the present Petition addresses and cures any purported deficiencies with *Breitenbach* by relying on additional references *Brown* and *Kaspar*. See *KioSoft*, PGR2021-00084, Paper 12.

There is thus a strong likelihood that the Board will find the Challenged Claims invalid under the grounds asserted herein. The Board should not discretionarily deny institution under *Fintiv*.

**D. Additional Considerations in the March 2025 Memorandum Favor Institution**

In addition to the frameworks of *Advanced Bionics* and *Fintiv* weighing against discretionary denial, “all relevant considerations” outlined in the March 2025

Memorandum similarly weigh against discretionary denial. *See, e.g., Twitch Interactive, Inc. v. Razdog Holdings LLC*, No. IPR2025-00307, Paper 18 at \*3 (Director May 16, 2025) (denying request for discretionary denial). Again, by referring the petitions challenging the three other patents of the Delaware Litigation, the Acting Director has already agreed that the additional considerations of the March 2025 Memorandum do not support discretionary denial as these additional considerations for the '608 Patent are nearly identical to those of the other three patents. *See* Ex. 1015. However, for the sake of completeness, Petitioner demonstrates below why discretionary denial under the additional considerations of the March 2025 Memorandum is not appropriate here.

**1. There Are No Settled Expectations that Would Support Discretionary Denial**

Patent Owner cites to prior statements and press releases from former Patent Owner targets allegedly supporting the validity of the challenged claims. *See* DD Req. at \*\*3–4. But these statements cannot establish “settled expectations of the parties,” for several reasons.

*First*, the statements Patent Owner cites to, by their very nature, cannot establish “settled expectations.” *See* DD Req. at \*\*3–4. Patent Owner extracted these statements as part of settlement—by any definition, they were *not* objective, independent assessments of Patent Owner’s patents. Indeed, because of the

“coercive environment of patent litigation,” the Federal Circuit places strict limitations on when settlement agreements can be used for damages analyses. *See, e.g., Laser Dynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51, 77-78 (Fed. Cir. 2012). The same logic undercuts any probative value of the press releases issued by Patent Owner’s targets following settlement.

*Second*, the ’608 Patent is very young. It issued on January 12, 2021, approximately 4.5 years before the Petition was filed on April 29, 2025. *See* Pet.; Ex. 1001. The Acting Director previously recognized that the related ’772 Patent, which issued in 2022, shortly after the ’608 Patent, had “not been in force for a significant period of time,” and that “Patent Owner has not developed strong settled expectations that favor discretionary denial.” Ex. 1015 at \*2

Moreover, the Petition was filed very early in the dispute between the parties, just over eight months after Patent Owner first accused Petitioner of infringing the ’608 Patent when it counterclaimed for infringement. The short life of the ’608 Patent, and Petitioner’s early challenge to it, weigh against discretionary denial. *See, e.g.,* Ex. 1015 at \*2 (“[E]arly challenges favor robust, predictable patent rights and weigh against discretionary denial.”); *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11 at \*2 (Director June 26, 2025) (finding no strong settled expectations for patents that issued in 2020 and 2019); *Google LLC v. Withrow Networks Inc.*, IPR2025-00775, Paper 10 at \*2 (Deshpande

Aug. 15, 2025) (finding no settled expectations favoring discretionary denial for patent issued in 2020). *Embody, Inc. v. Lifenet Health*, IPR2025-00248, Paper 13 at \*\*2–3 (Director June 26, 2025) (finding no strong settled expectations for patent issued in 2022); *GD Energy Prods.*, PGR2025-00031, Paper 11 at \*2 (denying discretionary denial and holding that “early challenges to patents favor robust, predictable patent rights and weigh against discretionary denial”).

**2. Petitioner Should Have Access to this Forum to Efficiently Establish the Unpatentability of the Challenged Claims**

“Compelling economic...interests” also heavily weigh against discretionary denial here. March 2025 Memorandum, at \*2. Patent Owner is aggressively asserting its patents and it is in the public’s interest to disincentivize patent owners from abusing the system like this, as companies like Petitioner and others are forced to spend money defending against meritless patent assertions. And if the present Petition is discretionarily denied, there is a high likelihood that the parties will expend far greater resources in the Delaware Litigation. *See, e.g., Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at \*16-17 (PTAB Sept. 6, 2017) (“[W]e recognize that an objective of the AIA is to provide an effective and efficient alternative to district court litigation.”). Accordingly, this factor also weighs against discretionary denial.

#### **IV. CONCLUSION**

For at least the reasons above, Petitioner respectfully requests that the Director deny Patent Owner's request for discretionary denial, and instead refer the Petition to a merits panel for consideration.

Respectfully submitted,

Dated: August 28, 2025

By: /Sarah E. Waidelich/  
Sarah E. Waidelich (Reg. No. 78,706)  
Honigman LLP  
315 E. Eisenhower Parkway, Suite 100  
Ann Arbor, MI 48103  
(734) 418-4242  
swaidelich@honigman.com

*Attorney for Petitioner Alliance Laundry Systems LLC*

**CERTIFICATE OF SERVICE**

The undersigned certifies that the foregoing Petitioner's Opposition to Patent Owner's Request for Discretionary Denial was served on the date below on Patent Owner at the email addresses below:

<b>Lead Counsel</b>	<b>Back-Up Counsel</b>
Matthew A. Argenti Wilson Sonsini Goodrich & Rosati PC 650 Page Mill Road Palo Alto, CA 94304 Tel: (650) 354-4154 Email: <a href="mailto:margenti@wsgr.com">margenti@wsgr.com</a>	Michael T. Rosato Wilson Sonsini Goodrich & Rosati PC 701 Fifth Ave., Suite 5100 Seattle, WA 98104 Tel: 206-883-2529 Email: <a href="mailto:mrosato@wsgr.com">mrosato@wsgr.com</a>
	Jad A. Mills Wilson Sonsini Goodrich & Rosati PC 701 Fifth Ave., Suite 5100 Seattle, WA 98104 Tel: 206-883-2554 Email: <a href="mailto:jmills@wsgr.com">jmills@wsgr.com</a>
	Tasha M. Thomas Wilson Sonsini Goodrich & Rosati PC 1700 K. Street, NW, Fifth Floor Washington, DC 20006 Tel: 202-973-8883 Email: <a href="mailto:tthomas@wsgr.com">tthomas@wsgr.com</a>

Dated: August 28, 2025

/Sarah E. Waidelich/  
Sarah E. Waidelich  
(Reg. No. 78,706)

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME  
LIMITATION, TYPEFACE REQUIREMENTS, AND TYPE STYLE  
REQUIREMENTS**

This Petitioner's Opposition to Patent Owner's Request for Discretionary Denial complies with the type-volume limitation in 37 C.F.R. § 42.24, and the Director's March 2025 Memorandum on Interim Processes for PTAB Workload Management, in that it contains 8,950 words, excluding the parts exempted by 37 C.F.R. § 42.24, as measured by the word processing software used to prepare the document.

This Petition complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft Office 365 in 14-point Times New Roman.

Dated: August 28, 2025

/Sarah E. Waidelich/  
Sarah E. Waidelich  
(Reg. No. 78,706)