

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BELDEN INC. AND PPC BROADBAND, INC., AND OPTERNA AM, INC.,
Petitioners,

v.

COMMSCOPE TECHNOLOGIES LLC,
Patent Owner.

Case IPR2025-01119
U.S. Patent No. 10,996,417

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

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EXHIBIT LIST

EXHIBIT	DESCRIPTION
EX1001	U.S. Patent No. 10,996,417 (“’417 Patent”)
EX1002	U.S. Patent No. 5,109,467 (“ <i>Hogan</i> ”)
EX1003	U.S. Patent No. 6,220,413 (“ <i>Walters</i> ”)
EX1004	U.S. Patent No. 5,987,203 (“ <i>Abel</i> ”)
EX1005	File History of the ’417 Patent (U.S. Application No. 15/875,564) (“’564 Application”)
EX1011	U.S. Patent No. 6,933,441 (“ <i>Fuller</i> ”)
EX1012	U.S. Patent No. 4,595,255 (“ <i>Bhatt</i> ”)
EX1013	U.S. Patent No. 6,201,920 (“ <i>Noble</i> ”)
EX1014	U.S. Patent No. 6,591,053 (“ <i>Fritz</i> ”)
EX1015	U.S. Patent Application Publication No. US2006/0210230 A1 (“ <i>Kline</i> ”)
EX1016	U.S. Patent No. 7,315,681 (“ <i>Kewitsch</i> ”)
EX1017	U.S. Patent No. 7,400,814 (“ <i>Hendrickson</i> ”)
EX1021	Declaration of Dr. Charles A. Eldering in Support of IPR Petition
EX1023	File History of the ’418 Patent (U.S. Application No. 15/875,605)
EX1024	U.S. Patent No. 10,996,418 (“’418 Patent”)
EX2001	U.S. Patent Publication No. 2006/0153516 (“ <i>Napiorkowski</i> ”)
EX2002	U.S. Patent No. 5,987,207 (“ <i>Hoke</i> ”)
EX2003	U.S. Patent No. 6,721,484 (“ <i>Blankenship</i> ”)

EXHIBIT	DESCRIPTION
EX2004	U.S. Patent No. 7,493,003 (“ <i>Kowalczyk</i> ”)

I. INTRODUCTION

Patent Owner's Request for Discretionary Denial (Paper 6 ("Request")) asks the Director to deny institution despite the undisputed facts that the primary reference in the Petition (*Hogan*) (i) was never considered during prosecution, and (ii) discloses all of the allegedly missing limitations directed to conventional enclosure features added by amendment to secure allowance. Faced with these undisputed facts, Patent Owner theorizes that *Hogan* is somehow cumulative to four prior art references buried in voluminous Information Disclosure Statements ("IDS's"), but never relied upon by the Examiner for any rejection. But *Hogan* is not cumulative of any of these references, alone or in combination, because it discloses a key feature of the claimed invention (*i.e.*, adapters/connectors located on a spool for storing cable) not disclosed by any of them. Indeed, many of them do not even disclose spools and all of them separate the adapters/connectors from their cable storage, thus teaching away from the key feature. Furthermore, the original Examiner that considered the IDS's in which these prior art references were disclosed was replaced by a second Examiner, who immediately allowed the amended claims without rejection. By Patent Owner's own admission that *Hogan* and these prior art references all disclose the conventional enclosure features added by amendment, the second Examiner's failure to reject the amended claims confirms that she erred in a manner material to the patentability of the Challenged Claims. For

all of these reasons, discretionary denial is not warranted.

II. LEGAL STANDARDS.

The Board uses the *Advanced Bionics* two-part framework for evaluating arguments under § 325(d). *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (Feb. 13, 2020) (precedential) (“*Advanced Bionics*”). In applying this framework, the Board considers six *Becton, Dickinson* factors that address discretion to deny institution when a petition presents the same or substantially the same prior art or arguments previously presented to the U.S. Patent and Trademark Office (“USPTO” or “Office”). *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton, Dickinson*”). Despite the Board’s guidance that “the *Becton, Dickinson* factors provide useful insight into how to apply the [statutory] framework under 35 U.S.C. § 325(d),” *Advanced Bionics*, Paper 6 at 9, Patent Owner failed to even reference or apply those factors in its Request.

As will be explained, a proper analysis of the *Becton, Dickinson* factors demonstrates that (i) *Hogan* is not cumulative of any of *Napiorkowski, Hoke, Blankenship*, or *Kowalczyk*, and (ii) even if *Hogan* discloses any claimed features similar to those disclosed in the four prior art references, the Office erred in a manner material to the patentability of the Challenged Claims by not issuing a single

rejection based on that prior art.

III. PETITIONER’S REQUEST DOES NOT SATISFY *ADVANCED BIONICS* PART ONE BECAUSE *HOGAN* IS MATERIALLY DIFFERENT TO AND NOT CUMULATIVE OF ANY OF THE FOUR PRIOR ART REFERENCES.

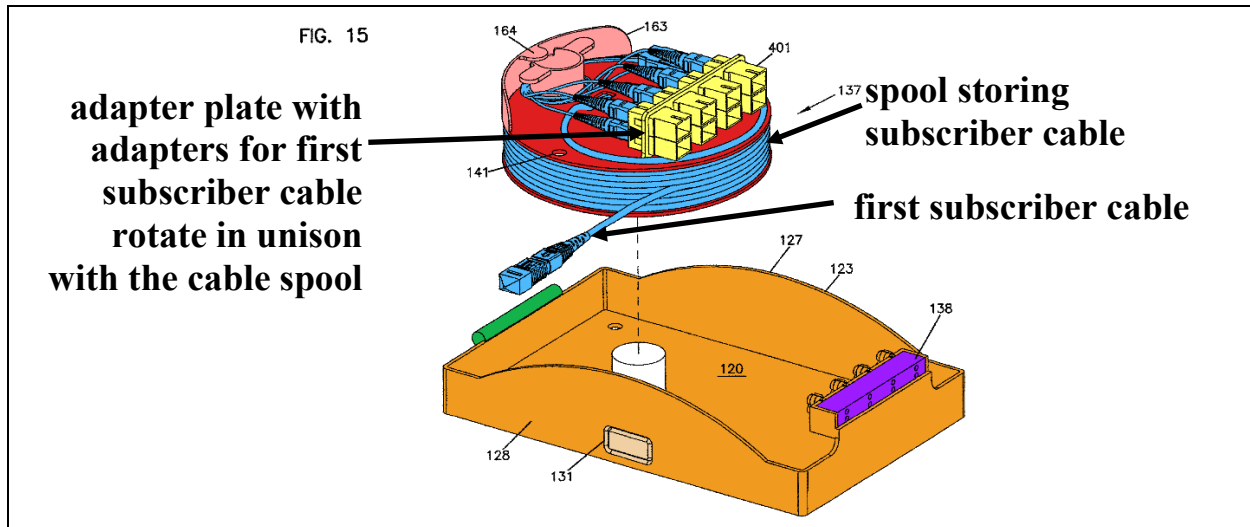
Becton, Dickinson factors (a), (b), and (d) relate to whether the same or substantially the same art or arguments were previously presented to the Office (*i.e.*, *Advanced Bionics* Part One). *Advanced Bionics*, Paper 6 at 10. *Becton, Dickinson* factor (a) requires an analysis of the similarities and ***material differences*** between the asserted art (*i.e.*, *Hogan*) and the prior art involved during examination (*i.e.*, *Napiorkowski, Hoke, Blankenship, and Kowalczyk*), and factor (b) requires an analysis of the alleged cumulative nature of *Hogan* and the prior art references.

In its Request, Patent Owner only focused on the alleged ***similarities*** between *Hogan* and the prior art references, namely conventional features of a fiber optic enclosure (*e.g.*, wall mountable, hinged/pivoting cover, sidewalls, fiber optic connections, cable guides, cable openings, *etc.*). Request, 2-16. Patent Owner’s failure to consider or address any of the ***material differences*** in *Hogan* that demonstrate that it is not cumulative is fatal to its Request for discretionary denial. *See, e.g., Wolfspeed, Inc. v. The Trustees of Purdue University*, IPR2022-00761, Paper 13 at 7-8 (Mar. 30, 2023) (Vidal) (vacating discretionary denial because the “Board’s analysis of the first part of the *Advanced Bionics* framework did not consider sufficiently the material differences between” the prior art asserted in the

Petition that “includes certain disclosures that are not present in” the prior art considered during prosecution, when those “disclosures [] were found to be highly relevant when assessing the obviousness grounds presented in the” petition.”).

A. Adapters/Connectors Located On A Spool Is A Material Aspect Of The Invention In The ‘417 Patent.

As explained in the Petition (Paper 1, 1, 6-7), a key feature of the fiber optic enclosure disclosed and claimed in the ’417 Patent is a termination module with adapters located on the rotating spool for receiving the connectors of the spooled incoming cable such that the connectors and adapters rotate in unison with the spool when the subscriber fiber cable is paid out. ’417 Patent Abstract (“A termination module disposed on the cable spool so that the termination module rotates in unison with the cable spool.”), 1:60-62, 3:63-66, 5:56-64 (“Since the termination module 45 rotates unitarily with or in unison with the cable spool 37, the second end of the subscriber cable 22 can be paid out without the first end of the subscriber cable 22 being pulled out of the termination module 45”), 7:33-41, FIGS. 13-15, 17.



Given the importance of this key feature, several of the Challenged Claims, including both independent claims, require connectors and/or adaptors located on and/or rotating in unison with the cable spool. *See, e.g.*, Independent Claim 1 (“the fiber optic connector rotates in concert with the spool as the second fiber optic cable is paid out from the spool”), Claim 3 (“the fiber optic connector is supported on the spool when the fiber optic cable is paid out from the spool”), Claim 4 (“the fiber optic adapter rotates in concert with the spool as the fiber optic cable is paid out from the spool”), Claim 5 (“the fiber optic connectors rotate in concert with the spool as the fiber optic cable is paid out from the spool”); Independent Claim 22 (“the fiber optic connector rotating in unison with the cable spool when the cable spool rotates about the rotation axis”), Claim 35. Accordingly, evaluating the teachings of a prior art reference to determine whether “those teachings impact patentability of the challenged claims,” *Advanced Bionics*, Paper 6 at 8 n.9, must assess whether the

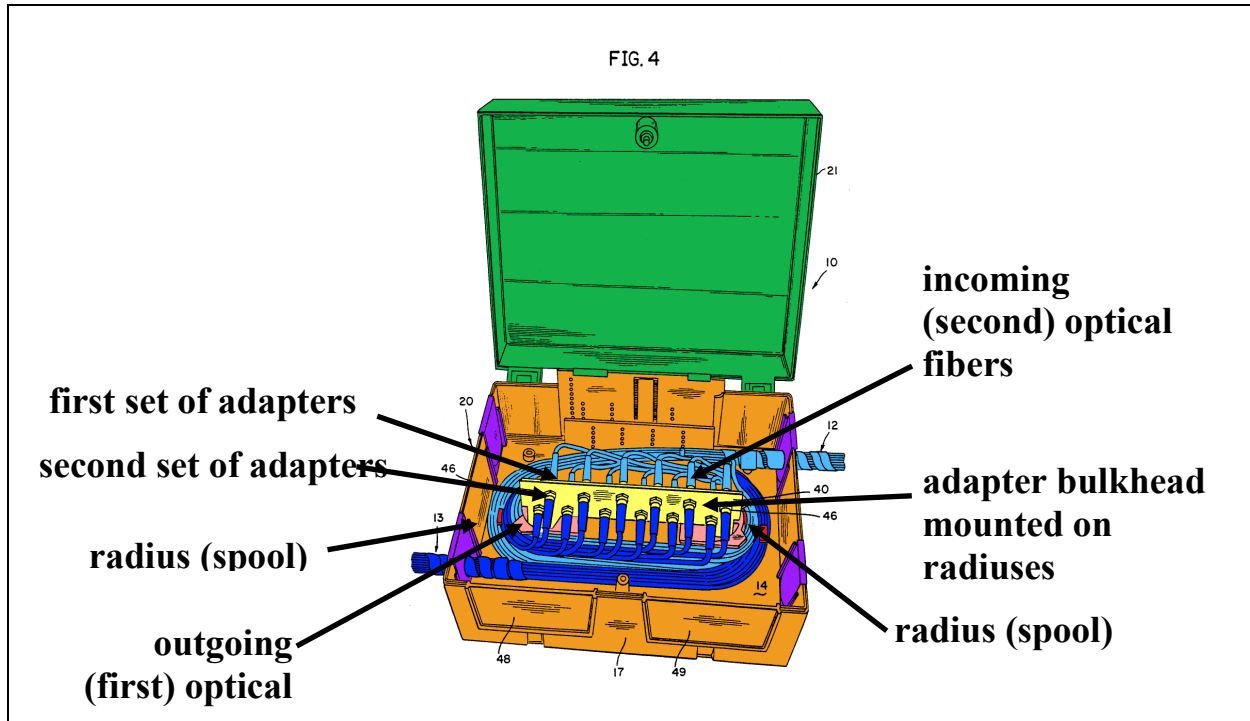
prior art teaches adapters and/or connectors located on a spool storing a fiber cable. As explained below, because none of *Napiorkowski*, *Hoke*, *Blankenship*, and *Kowalczyk* include any such teaching like this and instead teach away from this configuration, that material difference confirms that the references are neither substantially the same as, nor cumulative of, *Hogan*.

B. *Hogan's* Material Disclosure Of Adapters/Connectors Located On A Fixed Spool Provides A Motivation To Modify Based On *Walter's* Disclosure Of The Same Configuration On A Rotating Spool.

As explained in the Petition (pp. 38-39, 42-43), *Hogan's* interconnect cabinet 10 includes a fixed spool (radiuses 28 (left) and 30 (right)) for storing the incoming fibers 12 and outgoing fibers 13. *Hogan*, Abstract, 3:10-27 (“As shown in FIG. 4, the incoming telephone company optical fibers 12 and the outgoing customer optical fibers 13 are shown wrapped around the radiuses 28 and 30 and stored in the upper and lower storage levels 32 and 34”), 4:3-9, FIGS. 2-4.

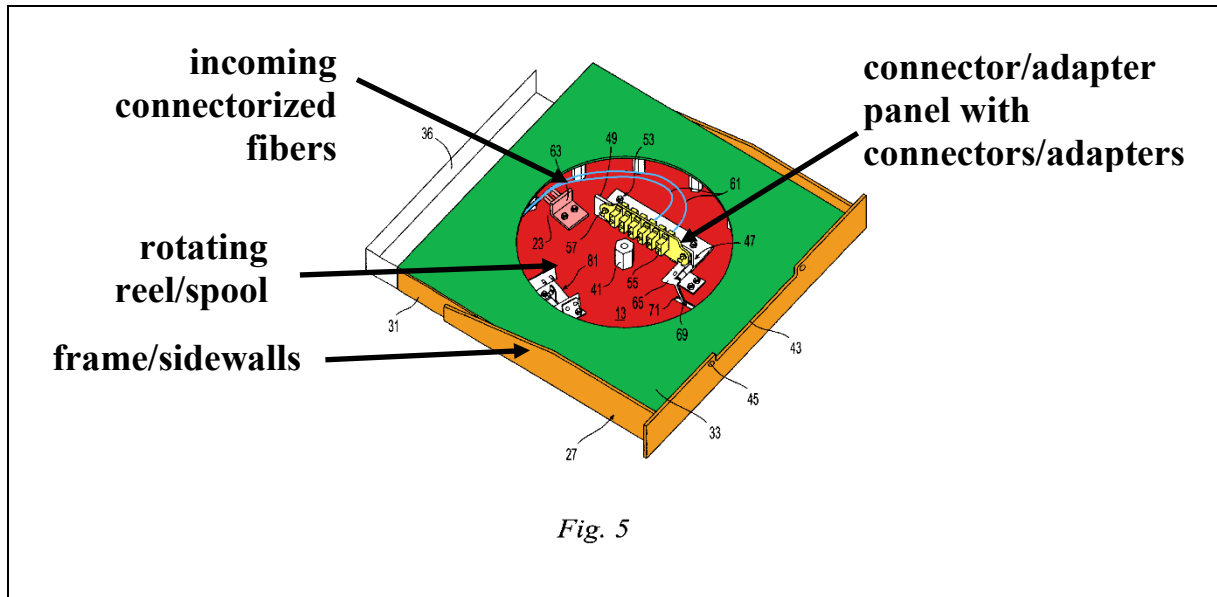
As also explained in the Petition (pp. 45-49, 59-60), *Hogan* discloses that the incoming optical fibers 12 and the outgoing optical fibers 13 are connectorized and attached to adapters 45 mounted on an internal adapter plate (bulkhead 40) that is mounted on the spool (radiuses 28 and 30) for interconnecting the optical fibers. *Hogan*, Abstract, 1:6-10, 1:61-2:3, 2:36-44, 3:28-40 (“an internal bulkhead 40 for being removably received in a pair of opposed slots 41 and 42 provided respectively in the radiuses 28 and 30 may be provided with a plurality of adapters 45 for

interconnecting the incoming telephone company optical fibers with the outgoing customer optical fibers”), 4:3-12, FIGS. 3-4.



Accordingly, *Hogan* teaches that (i) the fiber optic connectors coupled to the ends of the fibers of incoming optical fibers 12 and the outgoing optical fibers 13 and (ii) the fiber optic adapters 45 to which the connectors connect are all fixed to the spool (radiuses 28, 30) inside of a fiber optic wall-mounted enclosure.

This design in *Hogan* is similar to the design in *Walters* of fiber optic adapters 55 on connector panel 53 mounted to the rotating reel 11 using a reel docking station 47 and connected to the fiber optic connectors. *Walters*, Abstract, 1:22-30, 2:23-28, 2:52-61, 2:66-3:11, 3:17-24, 4:34-37, FIGS. 1, 5-6.



Because the connector panel 53, mounted adapters 55, and connected connectors of cable 23 are mounted to the rotating reel 11, *Walters* expressly teaches that the fiber optic connectors on the end of the fibers 61 of the incoming fiber optic cable 23 rotate in concert (or in unison) with the reel 61 as the fiber optic cable 23 is paid out from the spool. *Walters*, Abstract, 1:22-30 (“A reel docking station is located on the reel for rotation with it. When mounted to the reel docking station ... the connector panel will rotate with the reel.”), 2:52-56, 2:57-61, 2:66-3:11, 3:17-24, 4:34-37, 4:39-43, FIGS. 1, 5.

As explained in the Petition (pp. 62-63), in the modified interconnect cabinet 10 in *Hogan* with the rotating spool, a POSITA would have found it obvious based on the express *similar teachings* of *Hogan* (i.e., coupled adapters and fiber optic cable connectors supported on a fixed spool in a wall-mounted enclosure) and *Walters* (i.e., coupled adapters and fiber optic cable connectors supported on a

rotating spool in a rack-mounted enclosure) to have fiber optic connectors on the ends of the incoming fibers on the paid-out fiber optic cable and the adapters rotate in concert/unison with the spool as the fiber optic cable is paid out. Accordingly, *Hogan*'s teaching of adapters and connectors located on a spool is material to and impacts the patentability of the Challenged Claims.

C. *Hogan* Is Not Cumulative To Petitioner's Four Cherry-Picked Prior Art References That Are Materially Different Because They Do Not Disclose Adapters/Connectors Located On A Spool.

In its Request, Patent Owner only focused on the alleged similarities between *Hogan* and *Napiorkowski*, *Hoke*, *Blankenship*, and *Kowalczyk*, namely conventional features of a wall-mounted fiber optic enclosure. Request 2-16. For example, on page 6 of the Request, Patent Owner annotates a single figure from each prior art reference, labelling the pivoting covers, hinges, cover pivot axes, cable openings, and cable guides in those enclosures. Patent Owner's attempt to perform a "high-level" comparison of the references" to show "high-level similarity is not sufficient" to show that *Hogan* is cumulative to the prior art references. *PLR Worldwide Sales Ltd. v. Flip Phone Games Inc.*, IPR2024-00133, Paper 14 at 25 (Nov. 29, 2024); *Nokia of Am. Corp. v. Alexander Soto*, IPR2023-00680, Paper 18 at 6-7 (Mar. 28, 2024) (Vidal) ("Simply discussing one figure in one reference cited in the Petition, and then comparing it to a figure in a prior reference . . . is insufficient here."). Furthermore, for *Napiorkowski* and *Kowalczyk*, Patent Owner does not label any

adapters, connectors, or spools. Request, 6. And for *Blankenship* and *Hoke*, while Patent Owner does label adapters/connectors and cable guides (Request, 6), those labels confirm that the adapters/connectors are completely separate from the cable guides—a ***material difference*** from *Hogan*.

Later in the Request (pp. 7-16), Patent Owner provides additional details regarding the conventional features of the fiber optic enclosures disclosed in those prior art references. But once again, Patent Owner never addresses the prior art’s ***material differences*** with *Hogan*, namely, that all of the references teach away from locating adapters or connectors on a spool.

For example, *Napiorskowski* (EX2001) discloses an enclosure where the connections area 58 (including adapters) is in an outer compartment 28 and the storage area is in a ***separate*** inner compartment 70 that employs retaining members 72 instead of spools such that the adapters/connectors could not be located on a spool. *Napiorskowski*, Abstract (“The NID includes a base and a movable panel defining a connections area and a components area. In one embodiment, a first base defines a first compartment for housing the panel and a second base defining a second compartment for storing drop cable slack . . .”), [0008], [0028], [0035], [0038]-[0043], FIGS. 1-2.

Hoke (EX2002) discloses a fiber organizer that serves as an optical receiver node with printed circuit boards for converting optical signals to electrical signals

(*i.e.*, not an enclosure like *Hogan*, which is used for connecting incoming fibers to outgoing fibers) where the connectors 38/adapters 36 are located in a connector portion 28 that is *separate* from the intermediate portion 26 where the slack loop 30 is located. *Hoke*, Title, Abstract (“The fiber organizer includes a tray for supporting at least one optical fiber within a housing, such as an optical receiver node.”), 1:4-27, 2:25-28, 4:66-5:6 (“the fiber organizer 12 includes a tray having a fiber entry portion 24, an intermediate portion 26 and a connector portion 28. The intermediate portion defines a slack loop 30”), 5:18-35, 7:20-23, FIGS. 1-4.

Blankenship (EX2003) discloses an enclosure where a slack length 72 of the incoming feeder cable 70 is stored on retaining flanges 36 (*i.e.*, not spools) in a first fiber management area 40, a slack length 82 of a distribution cable 80 is stored on retaining flanges 36 in a *separate* second fiber management area 50, and adapters 66 for connecting the connectors 67 of the pigtails 76, 86 spliced to the fibers of the cables 70, 80 are located in another *separate* fiber connecting area 60. *Blankenship*, Abstract (“A backplate shaped, sized, and configured to be positioned within the internal cavity defines a first fiber management area, a second fiber management area, and a fiber connecting area.”), 3:42-49, 4:7-19, 4:26-45, 4:55-5:8, 5:15-32, 5:46-54, 5:64-6:8, 6:18-34, 6:44-53, 6:57-7:2-16, 7:27-8:6, FIGS. 2-6.

Finally, *Kowalczyk* (EX2004) discloses an enclosure with a base storage module 13 for storing a multi-fiber feeder cable 19 and a termination module 15 that

is *separate* from the base module 13 and includes adapters 401 in a termination bank 33 for connecting the connectorized ends 27 of the pigtails 25 from the base storage module 13. *Kowalczyk*, Abstract (“A modular fiber optic enclosure for enclosing optical fiber connections that includes a base housing module [and] also includes a termination module”), 1:38-47, 3:3-44 (“the feeder cable 19 is directed to a splice tray 23, where one or more of the fibers of the feeder cable 19 are individually connected to pigtails 25, each having a connectorized end 27. . . . The pigtails 25 are routed from the base housing module 13 to the termination module 15”), 3:61-4:38, 5:3-9, 5:42-6:8, 10:28-34. FIGS. 1-5, 10.

Because none of the prior art references disclose the material teaching of adapters and connectors located on a spool, *Hogan* is not substantially similar or cumulative and *Becton, Dickinson* factors (a) and (b) counsel against discretionary denial. And because none of the arguments made during examination (which did not include any rejections based on *Napiorkowski, Hoke, Blankenship, or Kowalczyk*) overlap with Petitioner’s use of *Hogan* in this proceeding (*i.e.*, *Becton, Dickinson* factor (d)), Patent Owner has not satisfied *Advanced Bionics* Part One and the Director should deny Patent Owner’s request for discretionary denial.

IV. PETITIONER’S REQUEST ALSO DOES NOT SATISFY *ADVANCED BIONICS* PART TWO BECAUSE THE OFFICE ERRED IN A MATERIAL MANNER.

Because the same or substantially the same art or arguments were not

previously presented to the Office (*Advanced Bionics* Part One), the Director should deny Patent Owner’s request for discretionary denial without having to consider whether the petitioner demonstrated that the Office erred in a manner material to the patentability of the claims (Part Two). *Advanced Bionics*, Paper 6 at 8–11. In any event, the second part of *Advanced Bionics* also confirms that discretionary denial is not warranted.¹ See *Ecto World, LLC v. Rai Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 5 (May 19, 2025) (Stewart) (precedential) (“In that analysis, a petitioner must explain, with reference to *Becton Dickinson* factors (c), (e), and (f), how the Examiner erred in overlooking the prior art.”).

A. None Of *Hogan*, *Abel*, Or Any Of The Newly Identified And Allegedly Cumulative Prior Art References Were Ever The Basis For A Rejection Of The Challenged Claims.

Becton, Dickinson factor (c) addresses the “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection.” Petitioner relies upon the combination of *Hogan* and *Walters* for

¹ Patent Owner criticizes the Petition for “completely fail[ing] to address 35 U.S.C. § 325(d)” and “fail[ing] to explain how the Examiner erred in overlooking the prior art.” Request, 16, 18. But Office guidelines (<https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>) specify that the “petitioner . . . should not present discretionary considerations in the petition.”

Ground 1, and the combination of *Hogan*, *Walters*, and *Abel* for Ground 2 in the Petition. Pet.,24-88. Neither *Hogan*, which was never considered during prosecution, nor *Abel* (EX1007), which was only considered in an IDS (EX1005, 246), were the basis of a rejection during prosecution.

In its Request, Petitioner asserts that *Hogan* is cumulative of *Napiorkowski*, *Hoke*, *Blankenship*, or *Kowalczyk* that were disclosed in voluminous IDS's and considered by an Examiner. Request, 2-16. But none of those prior art references were the basis of a rejection during prosecution.

Furthermore, Petitioner (Pet., 31, 55-58, 63-64, 80-81) identified six other prior art references in support of its obviousness grounds (*i.e.*, *Bhatt* (EX1012), and *Noble* (EX1013), which were never considered during prosecution, and *Frtiz* (EX1014), *Kline* (EX1015), *Kewitsch* (EX1016), and *Hendrickson* (EX1017), which were only considered in an IDS). But none of those six prior art references were the basis of a rejection during prosecution either.

As explained in the Petition (pp. 9-16) and Patent Owner's Request (pp. 2-4), *Walters* and *Fuller* (EX1011) were the only two prior art references that were the basis of a rejection during prosecution. In gaining allowance of the Challenged Claims, Patent Owner distinguished the rack-mounted enclosures of *Walters* and *Fuller* for allegedly failing to disclose (i) an enclosure with a cover that would cover the adapters when closed (EX1005, 145) as originally claimed, and (ii) a wall

mountable enclosure with sidewalls, cable openings, and a pivoting cover added by amendment (EX1005, 91). But as explained in the Petition (pp. 29-34, 64-67), *Hogan* discloses each of those claim elements that were allegedly missing from *Walters* and *Fuller*, and is therefore not cumulative of those references.

Becton, Dickinson factor (e) considers “whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art.” *Becton, Dickinson*, Paper 8 at 18. By failing to identify *Hogan* in a prior art search and reject the claims based on *Hogan*’s teachings of these missing enclosure elements (as well as its teachings of several other elements including adapters/connectors located on a spool in such an enclosure), Petitioner has shown that the Examiner erred in evaluating the prior art in a manner material to the patentability of the Challenged Claims.

Furthermore, the Examiner’s immediate allowance of the Challenged Claims based on the amendment that introduced conventional enclosure features to distinguish the rack-mounted enclosures of *Walters* and *Fuller* (*i.e.*, wall mountable, hinged/pivoting cover, sidewalls, fiber optic connections, cable guides, cable openings, etc.)—***features that Patent Owner now admits were disclosed in at least Napiorkowski, Hoke, Blankenship, or Kowalczyk*** (Request, 5 (“The enclosures taught by *Napiorkowski, Hoke, Blankenship, and Kowalczyk* are compared with that of *Hogan* [], showing that the pivoting cover, the cover pivot axis, the hinges,

adapters, non-rotating cable guides, and the cable openings are all present in references considered during prosecution”))—without any further rejections confirms that the Office “erred in misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.” *Advanced Bionics*, Paper 6 at 8 n.9; *see also Ecto World*, Paper 13 at 5-6 (“A petitioner also may point to the fact that even though the asserted prior art is listed on an IDS, the Examiner did not issue any prior art rejections during examination, so the Examiner materially erred by overlooking certain teachings in the prior art on the IDS.”); *BioNTech SE v. ModernaTX, Inc.*, IPR2023-01359, Paper 20 at 16 (Mar. 19, 2024) (“Even if [the asserted prior art references] were before the Office (as having been cited in IDSs, but not applied in any rejection), we find that the Office erred in overlooking those references’ relevant teachings.”); *Therabody, Inc. v. Hyperspace IP Subco, LLC*, PGR2024-00053, Paper 8 at 9-10 (Apr. 21, 2025) (“We agree with Petitioner that the Examiner did not identify the pertinence of [the asserted prior art reference’s] disclosure and did not issue a rejection based on such disclosure or combined teachings, and that this constitutes Examiner error” under “*Becton, Dickinson* factor (e)”).

That the Examiner did not use these allegedly cumulative references (or *Hogan* or *Abel*) “in any rejection,” “[u]nder *Becton, Dickinson* factor (c), [] does not weigh in favor of denying the Petition under § 325(d).” *Amazon.com, Inc. et al v.*

Nokia Techs Oy, IPR2024-01140, Paper 9 at 16 (Feb. 12, 2025); *see also fuboTV Media Inc. v. Dish Techs. L.L.C.*, IPR2024-00918, Paper 14 at 33 (Nov. 21, 2024) (“Because the Office’s evaluation of [the allegedly cumulative prior art] was minimal, we find that factor (c) weighs against exercising discretion to deny institution.”).

B. The Four Allegedly Cumulative References Were Buried In Voluminous Information Disclosure Statements And Not Necessarily Considered By The Examiner That Allowed The Claims.

During prosecution, the Examiners considered a total of five voluminous IDS’s submitted by the Patent Owner disclosing almost 450 patents and patent publications and almost ninety non-patent literature documents from co-pending litigations and foreign prosecution. EX1005, 241-257 (IDS #1), 261-264 (IDS #2), 180-185 (IDS #3), 126-129 (IDS #4), 77-81 (IDS #5). Examiner Akm E. Ullah indicated on each page of the first four IDS’s for the hundreds of references disclosed that “ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /A.E.J/,” which included *Napiorkowski* (EX1005, 191) *Hoke* (EX1005, 246), *Blankenship* (EX1005, 182), and *Kowalczyk* (EX1005, 181). Examiner Ullah provided these first four considered IDS’s when he issued two office actions, rejecting claims based on *Walters* and *Fuller*. EX1005, 159-171, 108-123.

After the second (final) rejection, as discussed above, Patent Owner filed a Request for Continued Examination (“RCE”) and introduced several conventional

enclosure limitations by amendment attempting to distinguish the rack-mounted enclosures of *Walters* and *Fuller*. EX1005, 87-98. Patent Owner filed its fifth IDS (EX1005, 82-86) along with the RCE.

After this RCE and Amendment, **a new Examiner**, Jennifer Doan, replaced Examiner Ullah and (i) indicated that she considered the references in the fifth IDS (EX1005, 56, 77-81), and (ii) issued a Notice of Allowance (EX1005, 51-61) that provided reasons for allowance that merely repeated verbatim all of the limitations of the independent claims. Accordingly, while the **first** Examiner (Ullah) indicated on the IDS's that he considered *Napiorkowski* (EX1005, 191) *Hoke* (EX1005, 246), *Blankenship* (EX1005, 182), and *Kowalczyk* (EX1005, 181), it was a **different second** Examiner (Doan) who allowed the amended claims.

Moreover, even if second Examiner Doan actually considered the prior art, the fact that there were hundreds of references identified in the IDS's supports Petitioner's position that the Examiners erred by overlooking the material information concerning the conventional enclosure features. *See, e.g., Ecto World*, Paper 13 at 6-7 (“[U]nder *Becton, Dickinson* factor (f) . . . the Board should consider a petitioner's argument based on the volume of the references submitted to the Office during examination”); *fuboTV Media*, Paper 14 at 33 (“Leaning US was only cited on a twenty-five-page Information Disclosure Statement (IDS) along with 237 other references. . . . Given the volume of the applicants' disclosure, it would not be

surprising if the examiner overlooked material information in it.”); *Samsung Elecs. Co. Ltd. v. Headwater Research LLC*, IPR2023-01336, Paper 9 at 6 (Mar. 25, 2024) (“[T]he record developed by the Office is sparse because Rao was one of well over a thousand references identified in information disclosure sheets but never discussed substantively during prosecution.”)

C. Patent Owner’s Refusal In A Parallel Application With The Same Voluminous IDS’s To Respond To The Examiner’s Request To Explain The Relevance Of The References Demonstrates That Discretionary Denial Is Not Warranted.

On January 10, 2018, Patent Owner filed the application that eventually issued as the ’417 Patent as well as a sister application with the same priority claim that eventually issued the same day as the ’417 Patent as U.S. Patent No. 10,996,418 (“’418 Patent”). (EX1024). During prosecution of the ’418 Patent, the same Examiner Ullah was presented with and considered almost identical IDS’s as were presented during the simultaneous prosecution of the ’417 Patent. *Compare* EX1023, 213-229 (disclosing *Hoke* at 218), 234-237 (disclosing *Blankenship* at 235), 151-156 (disclosing *Napiorkowski* at 153), 96-99, to EX1005, 241-257 (IDS #1), 261-264 (IDS #2), 180-185 (IDS #3), 126-129 (IDS #4).

Given that the “Applicant provided numerous prior art[]” references in the prosecution of both the ’417 Patent and the ’418 Patent, Examiner Ullah twice requested that Patent Owner “explain each reference and how it is distinct form [sic] the instant application.” EX1023, 77-78, 135. On both occasions, Patent Owner

refused to provide the requested information, stating that “Applicant notes that no such detailed analysis is required under 37 CFR 1.56.” EX1023, 61, 118.

The Interim Director recently confirmed in a precedential decision that discretionary denial is not “appropriate in view of the [high quantity]-reference IDS and the applicant’s tacit refusal to identify references in response to the Examiner’s request.” *Ecto World, LLC*, Paper 13 at 7. Accordingly, discretionary denial in this proceeding is not warranted.

D. Petitioner’s Expert’s Declaration Provides Additional Evidence Warranting Reconsideration Of The Prior Art.

Becton, Dickinson factor (f) considers “the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.” *Becton, Dickinson*, Paper 8 at 18. In support of the Petition, Dr. Charles Eldering submitted a detailed declaration explaining why combinations of *Hogan, Walters, and Abel* rendered obvious the Challenged Claims. EX1021. Patent Owner did not dispute that the Eldering Declaration constitutes new evidence. “Accordingly, *Becton, Dickinson* factor (f) weighs against exercising discretion to deny institution under § 325(d).” *Therabody*, Paper 8 at 10-11; *see also BioNTech*, Paper 20 at 16-17 (“We also have expert testimony from Drs. Griffin and Moon on Ground 2 that is presently un rebutted . . . [that] further undermines the case for discretionary denial.”)

Date: October 1, 2025

Respectfully submitted,

/Denis J. Sullivan/
Denis J. Sullivan (Reg. No. 47,980)

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** was served pursuant to 37 C.F.R. § 42.6(e) via electronic mail on October 1, 2025 on the following:

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