

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BABY GENERATION, INC., d/b/a MOCKINGBIRD;  
EVENFLO COMPANY, INC.; and  
MONAHAN PRODUCTS, LLC, d/b/a UPPABABY,  
Petitioner,

v.

BABY JOGGER, LLC,  
Patent Owner.

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IPR2025-01120  
U.S. Patent No. 11,878,729

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**PETITIONER'S OPPOSITION TO PATENT OWNER'S  
DISCRETIONARY DENIAL BRIEF**

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EX1049	U.S. Provisional Application No. 60/988,635 File History
EX1050	U.S. Patent Application Publication No. 2007/0194545 (“Van Dijk”)
EX1051	U.S. Patent No. D593,459 (“Liao”)
EX1052	U.S. Patent Application Publication No. 2007/0126206
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## I. INTRODUCTION

PO presents an incomplete account of the parallel litigations and relies on a flawed theory of “settled expectations.”

First, “Petitioner” consists of *three separate parties*—UPPABaby, Evenflo, and Mockingbird. PO sued these parties in three separate lawsuits in *two different jurisdictions*. (EX1074-1076.) PO also asserted a different variation of *seven different patents* against the three parties. Given multiple trials exist in separate jurisdictions with little to no commonality among the asserted patents, efficiency favors resolving the disputes at the PTAB. *See Berkshire Hathaway Energy Co. v. Birchtech*, IPR2025-00274, Paper 23 p.2 (P.T.A.B. July 2, 2025).

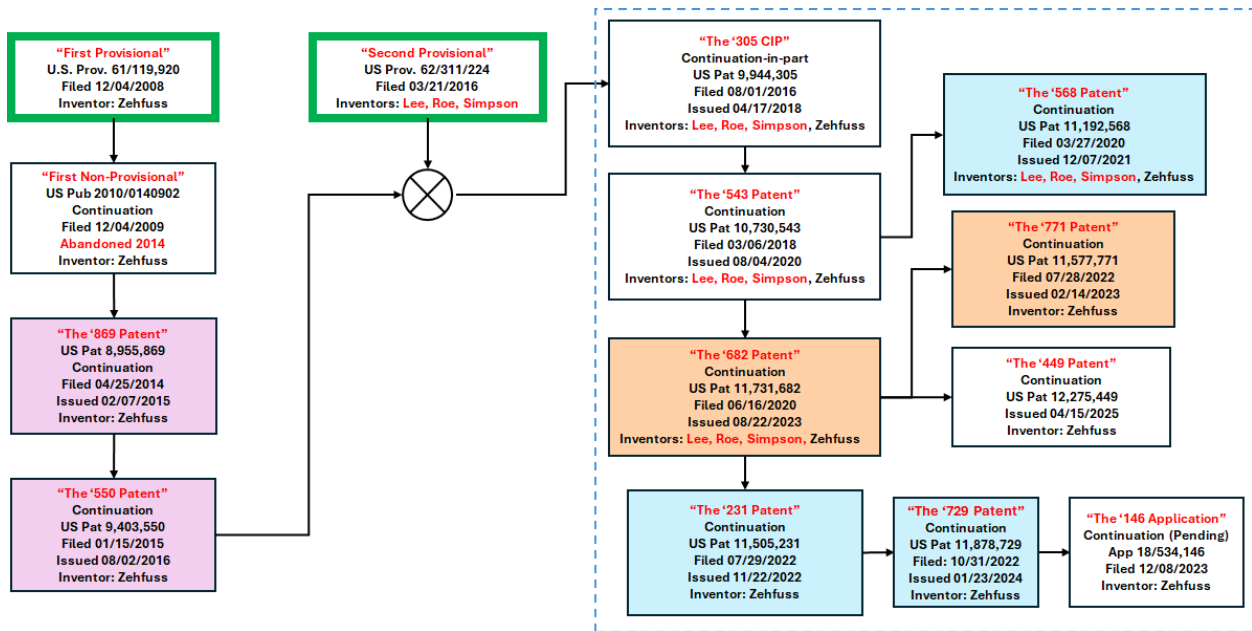
Second, the Delaware court cases against two parties—Evenflo and Mockingbird—have been dormant for over a year. Mockingbird has filed a motion to dismiss that remains pending and has still not answered PO’s complaint. Evenflo has yet to have a Rule 26 conference, and no case schedule has been entered. While UPPABaby’s case in Massachusetts has proceeded to Markman, no further case dates (including a trial date) have been calendared. A final written decision would occur before trial in two, and quite possibly, all three district court cases.

Third, the Board is the best equipped to resolve a dispositive priority issue that pervades this patent family. Denying institution would force three defendants to litigate a complex priority issue in *three separate trials in two jurisdictions*, leading

to duplicative discovery and potentially inconsistent rulings. Board review is the most efficient and just path forward, and PO’s request should be denied.

## II. THE BOARD IS BEST-EQUIPPED TO RESOLVE THE UNDERLYING PRIORITY ISSUES

PO’s patent portfolio began with a 2008 provisional application naming a single inventor, Mark Zehfuss. (EX1001, ¶¶96-102).



Prosecution of the First Non-Provisional began in 2009 and stretched over five years before being abandoned in June 2014. (EX1001, ¶¶103-112). PO then pursued what became the '869 Patent (EX1001, ¶¶113-117), followed by a continuation in January 2015 that later issued as the '550 Patent. (EX1005).

PO’s patent family fundamentally shifted in 2016 with the filing of a second provisional application introducing *new subject matter* and naming *three new inventors*—Jon Lee, Megan Roe, and Noel Simpson. (EX1006, p.1; EX1001,

¶¶118–128.) Only months later, PO filed a continuation-in-part (the '305 CIP) containing a rewritten specification that bore little resemblance to the pre-2016 disclosure. (EX1001, ¶¶130–139.) Petitioner's redline comparison of the '305 CIP and the '869 Patent demonstrates the extensive rewriting and new subject matter. (EX1046.)

The ensuing post-CIP prosecution illustrates why the Board is best-suited to address Petitioner's priority claims. For the '543, '568, and '682 Patents—filed before 2022—PO listed Mr. Zehfuss (the 2008 inventor) and the three additional 2016 inventors, effectively acknowledging that the claims relied on subject matter first introduced in 2016. (*See* EX1008; EX1009; EX1010.) But beginning in 2022, PO abruptly reversed strategy. For the '231 and '729 Patents, PO dropped the 2016 inventors and listed only Mr. Zehfuss, as if to erase the earlier concession that later subject matter was essential to the claims. This maneuver appears like a designed plan for recapturing the 2008 priority date. The parties<sup>1</sup> have challenged PO's improper attempt to rely on the 2008 priority date in *five of the seven pending IPRs*. (Paper 1, p.8-12; IPR2025-01122, Paper 1, p.17-25; IPR2025-01140, Paper 1, p.13-21; IPR2025-01100, Paper 1, p.16-24; IPR2025-01095, Paper 1, p.9-14.)

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<sup>1</sup> Seven IPRs are pending against this patent family. The “Petitioner” for each petition varies depending on the parties against which each patent is asserted.

The extensive additions of new matter in 2016, coupled with PO’s shifting treatment of inventorship, raise serious and complex priority issues which are outlined *in great detail within the ’100 Petition*. (See IPR2025-01100 Pet. at pp.16-24.) The Board has recognized that resolving such defects is “an appropriate use of Office resources to review” in determining whether a “potential error” during prosecution has occurred. *Padagis LLC, v. Neurelis*, IPR2025-00464, Paper 12, p.3 (P.T.A.B., July 16, 2025).

**III. NO “SETTLED EXPECTATIONS” FOR RECENTLY ISSUED PATENTS**

As shown below, PO has asserted seven patents against three different parties with varying overlap. (EX1074, ¶2; EX1075 ¶2; EX1076, ¶2).

	<b>'869 Patent Pre-CIP</b>	<b>'550 Patent Pre-CIP</b>	<b>'568 Patent Post-CIP</b>	<b>'682 Patent Post-CIP</b>	<b>'771 Patent Post-CIP</b>	<b>'231 Patent Post-CIP</b>	<b>'729 Patent Post-CIP</b>
	<b>ISSUED: 2/7/2015</b>	<b>ISSUED: 1/15/2015</b>	<b>ISSUED: 12/7/2021</b>	<b>ISSUED: 8/22/2023</b>	<b>ISSUED: 2/14/2023</b>	<b>ISSUED: 11/22/2022</b>	<b>ISSUED: 1/23/2024</b>
<b>Evenflo</b>	<b>Not Asserted</b>	<b>Not Asserted</b>	1, 7-9	1, 8-13, 15	1-4, 13-15	1-3, 15-17, 19-20	1-3, 15-22
<b>UPPAbaby</b>	1-5, 24- 29	1-7	1, 7-9	<b>Not Asserted</b>	<b>Not Asserted</b>	1-5, 15-17, 19-22	1-5,15-22
<b>Mockingbird</b>	1-5, 24- 29	1-7	1, 7-9	<b>Not Asserted</b>	<b>Not Asserted</b>	1-5, 15-17, 19-22	1-5,15-22

PO’s attempt to portray the three district court cases as simple “parallel proceedings” masks a deliberately fragmented litigation strategy that makes a centralized review at the PTAB essential. A review of the complaints reveals that the overlap is far from complete:

**Non-Identical Patent Assertions:** Only three patents—the ’568, ’231, and ’729 patents—are common to all three lawsuits. Evenflo is defending against two additional post-CIP patents (the ’682 and ’771 Patents) that have not been asserted against UPPAbaby or Mockingbird. Similarly, UPPAbaby and Mockingbird are defending against two pre-CIP Patents (the ’869 and ’550 Patents) not asserted against Evenflo. (Paper 1, §XIII.B).

**Non-Identical Claim Assertions:** Even for the commonly asserted ’231/’729 Patents, PO has asserted claims against UPPAbaby/Mockingbird (blue above) but not against Evenflo (green above). (EX1074, ¶206; EX1075, ¶168; EX1076, ¶200.)

This “mix-and-match” approach across three lawsuits in two different jurisdictions is a recipe for inefficiency and conflicting outcomes. Different judges and juries will likely reach different conclusions on priority, claim construction, and validity for patents of the same family. The pending IPRs offer a powerful antidote to this problem. By providing a single, expert validity ruling on seven asserted patents, asserted against three different parties, the Board can create consistency and dramatically simplify all three disparate court actions. *See Berkshire Hathaway Energy*, IPR2025-00274, Paper 23 at \*2 (“Because the litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient.”); *Harbor Freight Tools USA v. Champion Power Equip.*, IPR2025-00805, Paper 20, p.2 (P.T.A.B.

Sep. 19, 2025) (same).

**A. No “Settled Expectations” Exist for the ’729 Patent**

PO’s central argument for denial rests on a claim of “strong settled expectations” that it manufactures by pointing to the age of the pre-CIP ’869 and ’550 Patents. (Paper 10, p.7). But the ’729 Patent challenged in this Petition has only been in force since **January 23, 2024**. (EX1013). More importantly, the ’729 Patent is an indirect continuation of the ’305 CIP and incorporates the subject matter from the 2016 Second Provisional. PO should not be allowed to impute the age of one invention onto a different, later-developed invention to create settled expectations where none exist. This is even more the case given the ***Petitioner in this proceeding***<sup>2</sup> has challenged whether the ***issued and claimed subject matter*** is entitled to a priority date before 2016. (Paper 1, pp.8-12).

PO’s reliance on *Samsung Elecs. Co. v. iCashe, Inc.* and *Amazon.com, Inc. v. Audio Pod IP, LLC* is misplaced and, when properly analyzed, supports denying PO’s request. In both of those cases, when a **majority** of the challenged patents had been in force for many years (five of seven patents in *Samsung*; five of six patents

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<sup>2</sup> Again, “Petitioner” is three parties: Mockingbird, UPPAbaby, and Evenflo. For the petitions challenging the ’869/’550 Patents, “Petitioner” is Mockingbird and UPPAbaby. For the ’682/’771 Patents, “Petitioner” is Evenflo.

in *Amazon*), both cases held it was an “inefficient use of Board resources” to determine institution on just a few asserted patents. *Samsung*, IPR2025-00639, Paper 11 at 2-3; *Amazon*, IPR2025-00757, Paper 15 at 2-3. The Board’s logic was to avoid a piecemeal review where the focal point of both disputes lay with older patents.

Here, the facts are the opposite. The dispute against all three parties in all three district court litigations focuses on the *newly issued* post-CIP patents. ***Five of the seven total patents*** asserted across the three litigations have no settled expectations, as they have been in force for less than four years. Only the ’869 and ’550 patents are older, and these patents are not even asserted against one party—Evenflo. It would be improper to impute the age and alleged “settled expectations” of ***non-asserted patents*** onto Petitioner, Evenflo, when these pre-CIP patents bear little resemblance to the asserted post-CIP patents. (*see* EX1046.)

Applying the logic from *Samsung* and *Amazon* to these facts compels the conclusion that discretionary denial is inappropriate. Here it would be an inefficient use of resources to deny review of the five recently-issued patents—which form the core of PO’s multi-front litigation campaign—simply because two older, non-commonly asserted patents exist in the family. The majority of the asserted patents have not developed settled expectations, so efficiency dictates that the Board should review and determine the validity challenges raised across all seven IPR proceedings to provide a comprehensive and consistent resolution for the parties and the public.

**B. PO Incorrectly Attempts to Age Recently Issued Patents**

Fully aware that five of the seven patents asserted have been in force for less than four years, PO attempts to create the appearance of age by arguing that Petitioner had “constructive notice” of these recently issued patents since their applications were published. (Paper 10, p.7). This argument improperly conflates the public notice function of a published application with the legal and equitable concept of “settled expectations,” and it should be rejected.

The “settled expectations” analysis is not a free-floating inquiry into what a competitor might have known and when. It is a specific, equitable consideration tied directly to the existence of an enforceable patent right, and the analysis focuses on how long a patent “*has been in force.*” *Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3.<sup>3</sup> The six-year timeframe is generally used as it “aligns with other approaches ... for example, for filing infringement lawsuits.” *Id.*

But a published patent application is not “in force.” It grants no right to exclude, and it triggers no statute of limitations for damages. Further, the claims of the ’729 Patent were amended during prosecution. PO’s “constructive notice” theory would create an untenable situation where accused infringers would be forced to monitor and potentially challenge thousands of pending applications, the vast

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<sup>3</sup> All emphases added herein, unless indicated otherwise.

majority of which will never issue with claims that pose a threat.

**C. PO’s Eight-Year Delay in Enforcement Negates Any Claim of Settled Expectations and Instead Creates an Expectation of Non-Enforcement**

PO’s history with the parties demonstrates a profound lack of urgency that completely undermines any claim of “settled expectations” with regard to the ’869 and ’550 Patents. In fact, PO’s decision to remain silent *for nearly a decade* creates a reasonable expectation not of enforcement, but of acquiescence. PO’s recent litigation campaign is not the act of a patentee whose settled rights have been disturbed; it is a “lying-in-wait” strategy, as confirmed by the PO’s own counsel.

**1. No “settled expectations” exist as to UPPAbaby**

PO identifies a December 2015, letter where its counsel alleged UPPAbaby’s “Vista stroller ... may be covered by one or more claims in the ’869 patent.” (EX2001; EX1078, p.2). PO omits, however, that UPPAbaby responded on December 30, 2015, unequivocally denying infringement and informing PO: (1) the accused Vista stroller had been sold since 2006; and (2) the “Rumble Seat” adapter for converting its single-seat Vista stroller to a dual seat was publicly disclosed “before the earliest application filed by Baby Jogger.” (EX1078, p.4). UPPAbaby stated the ’869 Patent may be invalid based on the Vista+Rumble Seat products Baby Jogger was accusing. (*Id.*). PO’s final letter, dated March 15, 2016, acknowledged UPPAbaby sold an earlier version of the Vista+RumbleSeat, and that a version of

the RumbleSeat “launched in 2015” may be covered. (EX1078, p.7). PO has even admitted in response to UPPABaby’s counterclaims that it “took no action against UPPAbaby following the 03/15/2016 Letter until filing the complaint in this action on June 18, 2024.” (See EX1063, p.28 and ¶23; EX1064, p.3, ¶23-answering “Admitted”). Thus, for eight-years PO declined to pursue asserting the ’869 Patent, and instead built its expanded post-CIP portfolio, even though it had full “knowledge of” the accused products as “early as December 2015.” (Ex. 1065, p.14–15.)

Finally, Judge Burroughs pointedly questioned PO about “the amount of time” between determining a “potential patent violation” against UPPABaby and “the time the lawsuit got filed.” (EX1066, 4:10–12.) PO’s counsel answered bluntly that litigation was “on the radar” but it wanted to wait until it could “acquire [additional] patents and build up the patent portfolio” before filing suit. (EX1066, 4:24–5:2, 5:20–23.) PO’s admission confirms a “lying-in-wait” strategy—choosing to let potential damages accrue while amassing a larger and vastly different portfolio. Such conduct does not create “settled expectations;” it confirms a lengthy delay of non-enforcement counseling against discretionary denial. *See, e.g., Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 at 3 (P.T.A.B. Sep. 5, 2025). (Eleven-year delay counsels against discretionary denial).

**2. No “settled expectations” exist as to Evenflo & Mockingbird**

PO admits the accused Evenflo products have been publicly sold since

“around 2018.” (Paper 10, p.5.) PO also concedes the oldest patent asserted against Evenflo—the ’568 Patent—issued on December 7, 2021, while the most recent—the ’729 Patent—issued on January 23, 2024, just five months before the June 18, 2024 complaint. (EX1067, p.9). PO’s attempt to impute knowledge to Evenflo via an IDS citing the *pre-CIP ’869 patent* is misplaced, as it has a different disclosure and different inventive entity than the *five post-CIP patents* asserted against Evenflo. Instead, PO chose to wait six years after Evenflo introduced its product into the market before asserting its newer, *post-CIP patents*. A six-year delay in enforcement is fundamentally incompatible with a claim of “settled expectations,” especially when the “oldest” asserted patent issued less than four years ago.

PO’s “settled expectations” argument against Mockingbird is also flawed, given the earliest accused product was released in late 2020, just a few years before PO filed suit. (EX1075, ¶3.) PO also waited to acquire post-CIP patents that it then asserted against Mockingbird. This includes the post-CIP ’729 Patent that issued just *five months* prior to PO filing its lawsuit.

#### **D. PO’s Reliance on *Ericsson* Is Misplaced**

PO cites *Ericsson v. Procomm*, IPR2024-01455 (PTAB May 16 2025) to imply that Petitioners somehow delayed in filing these petitions, but this argument collapses under scrutiny of both the facts and the law. (Paper 10, p.8). The denial in *Ericsson* was a straightforward application of *Fintiv*, based on a single, overriding

fact: the district court trial was scheduled to conclude a full trial nine months before the PTAB's projected final written decision. *Ericsson*, IPR2024-01455, Paper 15, p.2. *Ericsson* was concerned with the inefficiency of an IPR decision that would issue long after the parallel case had been tried. *Id.*

Again, the circumstances here are polar opposite. In all three litigations ***no trial dates have been set.*** (*see* EX1080; EX1070-1071). The Evenflo and Mockingbird cases have also been dormant for over a year, with no scheduling order and no discovery conducted. (EX1070-1073). Both have also filed motions to stay. (EX1068, EX1069.) Unlike *Ericsson*, a final written decision in these IPRs will issue long before any potential trial, thus simplifying the issues for the courts, not duplicating them.

Furthermore, there was no undue delay in filing the petitions as PO alleges. (Paper 10, p.8). The challenged patents are part of a deeply complex and convoluted family, involving an abandoned application, the insertion of drawings that never appeared in the original application, the addition of new matter via a CIP, and questionable inventorship changes. Untangling this procedural history and developing the robust, evidence-based priority challenges required a diligent and thorough investigation. Petitioners acted promptly to analyze these complex issues and filed these petitions well within the statutory one-year bar.

#### IV. THE *FINTIV* FACTORS STRONGLY FAVOR INSTITUTION

When viewed correctly—as three separate litigations against three distinct parties—the *Fintiv* factors also weigh heavily against discretionary denial.

**Factor 1 (Existence of a Stay)**: PO’s statement that “none of the petitioners has moved for a stay” is inaccurate. Both Evenflo and Mockingbird have filed motions to stay in the Delaware District Court. (EX1068; EX0169.) Before PO filed its discretionary denial briefs, Mockingbird had filed its motion and PO knew, through a joint letter filed to the court, that Evenflo intended to file its motion. (EX1070.) This factor is at best neutral.

**Factor 2 (Proximity to Trial Date)**: No trial date has been set in any of the three litigations. The cases against Evenflo and Mockingbird have been dormant for over a year. PO attempts to use the median time to trial based on when both cases were filed in arguing trial will “begin around February 2027.” (Paper 10, p.11.) This is inaccurate given that no scheduling order has been entered in two cases. (EX1070; EX1071; EX1072; EX1073.) Even if a scheduling order was entered before the end of 2025, the median time to trial (based on PO’s stats) in Delaware is over two years, resulting in a trial occurring in late 2027 or 2028. This is well after any final written decision will be issued and therefore heavily favors institution.

The UPPAbaby case is in the claim construction phase, but no trial date is scheduled in that proceeding. (EX1080). Judge Burroughs’ minimum time to claim

construction is 15 months, and her single jury verdict took *over 4 years* (49.3 months). (EX1077.) Based on these stats, UPPAbaby will likely not go to trial for nearly 3 more years (*i.e.*, 34.3 months). As such, it is very likely the UPPAbaby case will not have a trial date before the PTAB’s Final Written Decisions will issue.

**Factor 3 (Investment in Parallel Proceeding)**: For Evenflo, no scheduling order has been entered, and discovery has not even commenced. (EX1070; EX1072). For Mockingbird, a motion to dismiss remains pending. (EX1071; EX1073). The investment in both these Delaware cases is *de minimis*, favoring institution.

Although the UPPAbaby case had a Markman hearing in July (EX1066), the most costly phases of litigation—fact and expert discovery, dispositive motions, and trial—remain ahead. *Arthrex, Inc. v. Medshape, Inc.*, IPR2025-00053, Paper 11, p.11 (P.T.A.B., April 25, 2025). Thus, the PTAB’s decision will issue well before discovery concludes, preventing massive duplication.

**Factor 4 (Overlap of Issues)**: PO attempts to diminish *all three parties’ Sotera* Stipulations claiming they do not result in the IPRs being a “true alternative” to the *three separate* court proceedings. (Paper 10, p.15). But, Evenflo and Mockingbird have not served invalidity contentions, making PO’s argument speculative. While UPPAbaby’s invalidity contentions reference Liao and system art, PO overlooks that the litigation has seen minimal investment in invalidity issues and that a stay is likely if IPR is instituted. Given none of the *three district court*

*cases* “involve ‘substantial investment,’” then “even discounting the weight of Petitioner’s *Sotera* stipulation[,] ... the *Fintiv* factors as a whole indicate that the efficiency and integrity of the patent system are best served by instituting review.” *Liberty Energy, Inc. v. U.S. Well Svcs. LLC*, IPR2025-00031, Paper 9 at 18-19 (P.T.A.B. Apr. 29, 2025). Moreover, to the extent any claims survive, the Board’s analysis will streamline invalidity issues in the district court for *non-system based art*. See *Nikon Corp. v. Optimum Imaging Techs. LLC*, IPR2025-01374, Paper 19 at 20-22 (P.T.A.B. Apr. 29, 2025) (holding that where system art is present, a *Sotera* stipulation still substantially reduces overlap between district court litigation and the IPR).

**Factor 5 (Same Party)**: PO alleges in the singular that “*Petitioner* is the *defendant* in the parallel *proceeding*.” (Paper 10, p.14) (emphasis added). This is incorrect, and PO is fully aware it initiated *three* separate district-court *proceedings*, in *two* different jurisdictions, against *three* unrelated *defendants*. Denying institution would create a threefold duplication of efforts and risk inconsistent rulings. See *Berkshire Hathaway Energy*, IPR2025-00274, Paper 23 at \*2.

**Factor 6 (Other Circumstances)**: As discussed in the ’100 Petition, PO did not indicate on its Statement under CFR 1.55/1.278 ADS that the ’568 Patent (and all post-CIP patents) was a transitional application governed by post-AIA law. (IPR2025-01100 Pet. at 17-18; EX1019, p.37). Had PO correctly identified the ’568

Patent as a transitional application, the Examiner may have challenged the priority claim of all the post-CIP patents. *Id.* PO’s failure to inform the examiner of the correct priority date is a “material error” that warrants review. As in *Padagis*, a potential error regarding the priority date of an asserted patent is an “appropriate use of Office resources to review the potential error.” (IPR2025-00464, Decision at 3.) This procedural history, combined with the significant efficiencies of resolving validity in a single forum for three separate lawsuits, presents a compelling reason to institute review.

Additionally, PO does not deny that each of the Petitions presents compelling grounds for unpatentability. ***PO also failed to file Preliminary Responses*** in the ’095 and ’100 IPRs, further indicating an inability to raise a substantive argument for denial on the merits.

## **V. PETITIONER PROPERLY USED EXPERT TESTIMONY**

Citing only *iRhythm Tech’s, Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10, 2-3 (P.T.A.B. June 6, 2025), PO argues denial is warranted because the Petition is over-reliant on “voluminous” expert testimony. (Paper 10 at 10). However, PO fails to identify even a single instance of the Petition relying upon testimony to fill in gaps in the prior art. PO ignores that, besides relying upon expert testimony to address the teachings in the asserted prior art, the Petition relies upon the expert testimony to explain the background knowledge of a POSITA and that the expert

provides citations to the prior art in support of his opinions, as required under 37 C.F.R. § 42.65(a). As the Board correctly found in *iRhythm*—the very case PO cites—“[t]his also weighs against discretionary denial.” IPR2025-00363, Paper 10, p. 2-3.

## **VI. DENIAL UNDER § 325(d) IS NOT WARRANTED**

As a preliminary issue, PO is wrong to claim Petitioner had to address the *Becton Dickinson* factors in the Petition. The USPTO’s Interim Guidance makes clear that discretionary issues, including § 325(d), should be raised in opposition to a discretionary denial brief—not in the petition itself. *See* <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (“A petitioner should raise any discretionary issues *in its opposition to a patent owner’s discretionary denial brief*[.]”)

### **A. It Is Undisputed that Grounds 1 and 2 Rely on New, Non-Cumulative Prior Art**

PO’s argument that denial under § 325(d) is appropriate fails under scrutiny. PO completely ignores that two of the three grounds in the ’120 Petition rely on new, non-cumulative prior art.

The three prior art references relied upon in Ground 1 (Dotsey, Zehfuss, and Britton) were not previously considered by the Office. Similarly, the primary prior art reference relied upon in Ground 2 (Van Dijk) was not previously considered by the Office. PO does not—and cannot—dispute that these references are non-

cumulative to art and arguments considered during prosecution. (*See* Paper 10 at p.18-20.) Dotsey, Zehfuss, and Britton are asserted to show that the challenged claims are invalid if they are not entitled to their claimed effective filing date, which is an issue that the Examiner overlooked. (*See* Paper 1 at 1, 3.) Van Dijk is asserted to show that the Examiner further erred when he concluded that the prior art existing before 2008 “does not teach or fairly suggest” several claim limitations. (EX1023, p.19-21.) Accordingly, the first prong of *Advanced Bionics* is not satisfied, and denial under § 325(d) is inappropriate for this reason alone.

**B. PO Failed to Inform the Examiner of Liao’s Materiality**

PO’s argument that the Board should defer to the Examiner’s consideration of Liao, which is the primary reference in Ground 3, is unpersuasive. The Examiner’s view of Liao changed over time. In 2019, the Examiner first cited Liao as a secondary reference of *the ’543 Patent*. (EX1018, pp. 545–546.) In 2020, the Examiner continued to rely on the Liao Patent as a secondary reference during examination of *the ’568 Patent*. (EX1019, p.557-559.) It was only *after the ’729 Patent issued* when the Examiner in the non-asserted ’449 Patent (*see* Chart, §II *infra*) recognized Liao’s significance and relied on it as an anticipatory reference. (EX1024, pp. 1203–1206.) To overcome the Liao Patent, PO was forced to amend the claims to include limitations not found in any of the seven asserted patents. (EX1023, p. 1389, 1393-1394.) These events show that, until 2024, the Examiner

did not fully appreciate the Liao Patent’s teachings. The 2024 anticipatory rejection based on Liao indicates under *Becton Dickinson* factors (c) and (f) that the Examiner previously erred in his understanding of Liao.

As the ’100 Petition demonstrates, the Liao patent and the invention disclosed in the ’729 Patent are nearly identical. (IPR2025-01100 Pet. at p.26-28.) The Examiner’s failure to recognize the similarity and the Liao Patent’s significance before 2024 may stem from PO’s failure to inform him of certain relevant facts.<sup>4</sup> Specifically, in a separate, non-related—and now abandoned—application (13/418,101), PO admitted to a *different examiner* that PO had a professional working relationship with Mr. Liao on “stroller designs” and that PO knew Mr. Liao had invented “approximately one hundred” U.S. patents. (EX1079, p. 40.) Yet, PO has never shared the same information *with the Examiner of the challenged patents*. Thus, under *Becton Dickinson* factor (f), PO was aware that the Liao Patent may be materially relevant prior art but failed to properly inform the Examiner of the ’729 Patent, thereby warranting reconsideration by the Board.

## VII. PRIORITY AND INDEFINITENESS CHALLENGES

PO argues Petitioner has created an inefficiency by raising an “indefiniteness

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<sup>4</sup> For simplicity, “PO” herein refers to PO and individuals associated with PO who had a duty to disclose under 37 C.F.R. § 1.56.

challenge cloaked as a priority dispute.” (Paper 10, p.11). This conflates two distinct legal issues that have been properly raised in their respective forums.

**Priority is a § 112(a) Inquiry for the PTAB:** The challenge in this IPR is to the claimed priority date, arguing that key limitations like “housing,” “adapter,” and “substantially parallel” lack written description support prior to 2016. (IPR2025-01100 Pet. at 19-23). This is a threshold question for determining the universe of applicable prior art and is squarely within the PTAB’s expertise.

**Indefiniteness is a § 112(b) Inquiry for the District Court:** As PO notes, indefiniteness cannot be raised in an IPR. For this reason, UPPAbaby properly raised its indefiniteness arguments in the District of Massachusetts. Thus, the present IPRs are highly distinguishable from *Innolux Corp. v. Phenix Lonhorn LLC*, IPR 2025-00044, Paper 11, p. 23 (P.T.A.B. June 9, 2025), where the petitioner requested an advisory opinion of indefiniteness from the Board. Petitioner has made no such request.

## VIII. CONCLUSION

The Board should deny PO’s request for discretionary denial. These IPRs present a compelling unpatentability case based on a fundamental priority flaw overlooked by the Examiner, and institution will promote efficiency by resolving this core issue in a single forum while streamlining three parallel litigations.

Respectfully,

Date: October 3, 2025

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**CERTIFICATE OF COMPLIANCE**

This paper complies with the page limits for Opposition Briefs responding to a Patent Owner’s Discretionary Denial Brief filed after September 1, 2025. *See* <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>, § III.C (“Page Limits”).

This paper also complies with the format and type style requirements of 37 C.F.R. § 42.6(a).

Respectfully,

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e)(4), I hereby certify that on October 3, 2025, I caused a copy of the foregoing Petitioner’s Opposition to Patent Owner’s Discretionary Denial Brief , and any supporting exhibits filed therewith, to be served via electronic mail to the following counsel pursuant to agreement by the parties:

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