

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

BABY JOGGER, LLC,
Patent Owner.

IPR2025-01120
Patent 11,878,729

PATENT OWNER'S
DISCRETIONARY DENIAL BRIEF

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Baby Jogger Letter to UPPAbaby dated December 4, 2015
2002	Excerpt of File History of Application No. 12/631,375, Applicant's Response to Office Action, Remarks and Attachments (Nov. 4, 2013)
2003	United States District Courts—National Judicial Caseload Profile for 12-month period ending December 31, 2024; <i>available at</i> https://www.uscourts.gov/sites/default/files/2025-02/fems_na_distprofile1231.2024.pdf
2004	U.S. Patent No. 10,449,987, Information Disclosure Statement dated February 28, 2018
2005	Docket Sheet (as of Sept. 1, 2025) for <i>Baby Jogger, LLC v. Monahan Products, LLC d/b/a UPPAbaby</i> , No. 1:24-cv-11582 (D. Mass. filed June 18, 2024)
2006	Docket Sheet (as of Sept. 1, 2025) for <i>Baby Jogger, LLC v. Baby Generation, Inc. d/b/a Mockingbird</i> , No. 1:24-cv-00725 (D. Del. filed June 18, 2024)
2007	Docket Sheet (as of Sept. 1, 2025) for <i>Baby Jogger, LLC v. Evenflo Company, Inc.</i> , No. 1:24-cv-00723 (D. Del. filed June 18, 2024)
2008	UPPAbaby's Invalidation Contentions in <i>Baby Jogger, LLC v. Monahan Products, LLC d/b/a UPPAbaby</i> , No. 1:24-cv-11582 (D. Mass. served Feb. 14, 2025)
2009	Scheduling Order, <i>Baby Jogger, LLC v. Monahan Products, LLC d/b/a UPPAbaby</i> , No. 1:24-cv-11582 (D. Mass. Dec. 2, 2024), ECF No. 37
2010	UPPAbaby's Opening Claim Construction Brief, <i>Baby Jogger, LLC v. Monahan Products, LLC d/b/a UPPAbaby</i> , No. 1:24-cv-11582 (D. Mass. Mar. 28, 2025), ECF No. 58

I. INTRODUCTION

Patent Owner Baby Jogger, LLC (“Baby Jogger”) requests that the Director exercise discretion and deny institution in three *inter partes* review proceedings: IPR2025-01100 (“the 100 IPR”), IPR2025-01095 (“the 095 IPR”), and IPR2025-01120 (“the 120 IPR”), challenging Patents 11,192,568 (“the ’568 Patent”), 11,505,231 (“the ’231 Patent”), and 11,878,729 (“the ’729 Patent”), respectively (collectively, “the Patents”).¹ The Petitions challenge patents with years of accrued settled expectations, rely on unmanageably voluminous “expert” testimony and references the Examiner already considered, and theories that are better and more efficiently addressed in the parallel district court proceedings, which the parties have already meaningfully invested in. The Director should grant this request for discretionary denial.

¹ This brief addresses all three proceedings and is identically filed in each (other than case style/headers). Non-identical Papers and exhibits in each IPR are referenced by the IPR number followed by the document, while duplicated exhibits are referenced by number only. E.g., “100 IPR Ex-1015” or “095 IPR Ex-1015” versus “Ex-1014.”

II. FACTUAL BACKGROUND

A. Origin of the invention

The origins of the Patents began around 2008, when Baby Jogger—a leading innovator of baby strollers since 1984—developed and introduced the first true convertible single-to-double stroller. Before this invention, parents with multiple children were limited to either using two separate strollers or buying existing double strollers that suffered from significant drawbacks. Some existing double strollers were too large, making them difficult to maneuver. Ex-1031, 65.² Others included a second seat tucked beneath the first seat that was small, cramped, and reduced the stroller’s storage capacity. *Id.* at 75. Still other models had components that were permanently affixed and did not permit reversibility or interchangeability of the seat. *Id.* at 65.

Baby Jogger overcame these limitations by developing a novel modular stroller system capable of seamlessly alternating between single- and double-seat configurations without expanding the stroller’s overall footprint. One aspect of the patented Baby Jogger stroller system, known commercially as the “City Select,” was its seat attachments, which allowed a second seat to be added directly to the

² Petitioners uniquely numbered this exhibit’s pages 1–75 in the 095 and 120 IPRs, but, oddly, not the 100 IPR.

frame of the single stroller, converting it into a double stroller while preserving both its stability and maneuverability. Ex-1004, Abstract, 1:14-23. Within months of its introduction in 2009, the City Select won numerous awards for its innovative design, which Baby Jogger was actively seeking to protect through our patent system. 095 IPR Ex-1014, 327 (response to office action noting awards supported secondary considerations); 120 IPR Ex-1014, 327 (same); *see also generally* Ex-2002 (providing copies of NPL awards not included in Petitioners' exhibits).

B. Prosecution of the Patents

Baby Jogger filed its initial provisional application related to the City Select in 2008. Ex-1002. Since that time, this patent family has undergone years of intensive review, examination, and negotiation between Baby Jogger and the Patent Office. Notably, the entire patent family (all of which claim priority to the first provisional application) was examined by the same Examiner, who was familiar with the state of the art and repeatedly allowed claims this patent family.

The earliest granted patent in this family, No. 8,955,869 (“the ’869 Patent”), issued on February 17, 2015. Ex-1004. It was filed as a continuation of Application No. 12/631,375 (“the ’375 Application”). During prosecution of the ’375 Application, the Examiner rejected the claims as anticipated and obvious over multiple prior art references—many of which mirror those now cited by Petitioners, including one of the very same references. *See* Ex-1014, 94–115, 180–

99, 268–93; see also 100 Pet. 24–29; 095 Pet. Ex-1001, 109–27; 120 Pet Ex-1001, 109-130. The Examiner ultimately allowed the claims, though the applicant later withdrew the '375 Application from issue. Ex-1014, 333–43, 520–27. The application for the '869 Patent was then filed with a preliminary amendment aligning its claims with those already allowed in the '375 Application. Ex-1015, 52–58. Unsurprisingly, the Examiner allowed the '869 claims following a telephonic interview and minor amendments.

Patent 9,403,550 (“the '550 Patent”), which issued in August 2016, is a continuation of the '869 Patent. During prosecution, it was also subject to multiple office actions, including anticipation and obviousness rejections based on references similar to those cited here. Ex-1016, 49–56, 117–24, 172–76. Notably, the Examiner also cited prior art that Petitioners now rely upon in these petitions. Ex-1016, 57 (Rolicki), 260 (Schaaf); 100 Pet. 8 (Ground 1 citing Rolicki); 095 Pet. 3 (Grounds 2 and 3 citing Schaaf); 120 Pet. 3 (Grounds 2 and 3 citing Schaaf).³

The '568 Patent (subject of the 100 IPR) claims priority to the '869 and '550 Patents and was also subjected to a rigorous prosecution. The Examiner issued multiple rejections, including relying on some of the art cited in the Petition, as

³ The '869 and '550 Patents are also subjects of related petitions and Patent Owner’s Requests for Discretionary Denial in IPR2025-01105 and -01106.

detailed in Section IV below. *See, e.g.*, 100 IPR Ex-1001 ¶¶ 144–53 (Petitioners’ declarant describing the Examiner’s rejections and ultimate allowance). The ’568 Patent issued on December 7, 2021. Ex-1009.

The ’231 Patent and the ’729 Patent (subject of the 095 and 120 IPRs, respectively) issued after applicant-initiated interviews and amendments, with the Examiner again citing art that Petitioners now rely upon. Ex-1022 (Part 1), 255; Ex-1023, 25. The ’231 Patent issued on November 22, 2022, and the ’729 Patent issued on January 23, 2024. Ex-1012; Ex-1013.

C. Petitioners Follow Baby Jogger’s Lead with Notice of the Patents

Around 2015, Petitioner UPPAbaby released its “RumbleSeat,” a product that enabled its Vista stroller to convert into a double stroller. In or around 2018, Petitioner Evenflo followed with its Pivot Xpand Travel System and its Pivot Xpand Second Seat, which likewise permitted its strollers to be converted into a double stroller. Finally, Petitioner Mockingbird introduced its Single-to-Double Stroller (2023 model) and 2nd Seat Kit, which similarly converted its stroller into a double stroller. Each of these single-to-double products introduced by Petitioners falls within the scope of claims of the Patents.

What is more, at least two Petitioners developed and sold their products for up to a decade with actual knowledge of the Baby Jogger patent family. In December 2015, Baby Jogger sent a letter to Petitioner UPPAbaby providing notice

that it was infringing the '869 Patent, a common parent of the three Patents here (and subject of co-pending IPR2025-01105). *See* Ex-2001. And Petitioner Evenflo has been aware of the patent family for almost as long—citing both the '869 and '550 Patents in an IDS on February 28, 2018. Ex-2004.

In the years since Baby Jogger first introduced its stroller system, it has continued to refine, protect, and commercialize its inventions. On June 18, 2024, Baby Jogger decided to put an end to Petitioners' willful infringement of the Patents and filed patent infringement actions against each Petitioner, asserting the Patents and those in the related IPRs. Ex-2005; Ex-2006; Ex-2007.

III. *FINTIV*-BASED AND PTAB WORKLOAD MANAGEMENT MEMO DISCRETIONARY DENIAL FACTORS

Institution should be denied under § 314(a). Taking a holistic view of these proceedings, the settled expectations of the patent owner, the *Fintiv* factors, and the heavy, unmanageable burden imposed on the Office (and Baby Jogger) by the extraordinarily voluminous petitions and expert declarations weigh in favor of discretionary denial.⁴ Taken together, these factors support a single conclusion: institution would be unjustified and an inefficient use of the Office's resources.

⁴ The expert's doorstopper declarations in these 3 IPRs alone (not including the other 4 related IPRs) have 320 pages and 525 paragraphs *each* (Ex-1001 in the 110 IPR alone has 622 numbered paragraphs).

A. The Settled Expectations of the Parties Weigh in Favor of Discretionary Denial

The Patents are part of a larger family of patents that have been commercialized in a core Baby Jogger product for 15 years. The '550 and '869 patents have been in force for 9–10 years, developing strong settled expectations. *Dabico Airport Solutions Inc v. HydraFacial LLC*, IPR2025-00408, Paper 21, 3 (June 18, 2025). And Petitioners were aware of those patents and related family members through actual notice and by virtue of the stroller system being lauded in the same technology space in which the Petitioners operate. *See supra* Section II.C (citing Ex-2001, Ex-2004). Thus, Baby Jogger has strong settled expectations in this family of patents, including the ones challenged here. *See Samsung Elecs. Co. v. iCashe, Inc.*, IPR2025-00639, Paper 12, 3 (Aug. 14, 2025) (inefficient use of Board resources to consider validity of 2 newer patents when validity of 5 older patents would be considered by the district court); *Amazon.com, Inc., v. Audio Pod IP, LLC*, IPR2025-00757, Paper 15, 3 (Aug. 14, 2025) (inefficient use of Board resources to consider validity of 1 newer patent when validity of older patents would be considered by the district court).

The first of the patents related to the City Select stroller system—the '869 Patent—issued in 2015. Ex-1004. Two of the Petitioners in these proceedings had actual notice of that patent: (1) Baby Jogger sent a notice letter regarding that patent to Petitioner UPPAbaby on December 4, 2015, and (2) Petitioner Evenflo

cited that patent and the '550 Patent on an IDS on February 28, 2018. *See* Ex-2001; Ex-2004. In the years since, Baby Jogger has pursued continuations to protect various embodiments of its inventions, including those that issued as the challenged patents. The application that led to the '568 Patent published in July 2020, the '231 Patent application published in November 2022, and the '729 Patent application published in March 2023. Ex-1009, code (65); Ex-1022, 422; Ex-1013, code (65). So Petitioners have also had constructive notice since then.

Despite these ten years of actual and constructive notice of the common parent '869 Patent covering aspects of Baby Jogger's widely praised and successful City Select strollers, Petitioners made no challenge to the Patents. Baby Jogger's settled expectations grew over the years, with no challenge to the Office's allowance of multiple additional patents. Had any of the Petitioners raised a challenge earlier, instead of watching Baby Jogger's family grow, any purported issues could have been addressed much earlier. As it is, Baby Jogger has gained settled expectations in its entire family, including the Patents issued in the last several years. And even after Baby Jogger served its infringement complaints on all three Petitioners by June 24, 2024 (*see* Ex-2005; Ex-2006; Ex-2007), the Petitioners still waited until the last minute to file their Petitions on June 6 and 13, 2025—within days of the one-year bar. This factor favors discretionary denial. *See Ericsson Inc., et al. v. Procomm Int'l PTE. LTD.*, IPR2024-01455, Paper 15, 2

(May 16, 2025) (finding delay in filing petition negatively impacted timing of the final written decision with respect to the trial date).

The products covered by the Patents—the City Select stroller system first introduced in 2009—have been commercially successful and recognized with innovation awards since at least 2010, including the Juvenile Products Manufacturers Association Innovation Award and National Parenting Publications Award, Ex-2002, and repeatedly recognized as patentable by the Office for 15 years. Baby Jogger’s patent marking began in early 2023, and the notoriety of the products coupled with Petitioners’ awareness of the growing Baby Jogger portfolio while they failed to challenge the Patents means that Baby Jogger has strong settled expectations favoring discretionary denial.

B. Petitioners’ Extensive Reliance On Voluminous Expert Testimony Favors Denial

In its non-exhaustive list of considerations that may be raised in discretionary briefing, the Board includes the extent of the petition’s reliance on expert testimony.⁵ Here, Petitioners rely extensively on expert argument and inferences to fill in the gaps of the prior art and to rationalize how that art could allegedly be modified or combined to allegedly arrive at the challenged claims. *Cf.*

⁵ <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>

iRhythm Technologies, Inc. v. Welch Allyn, Inc., IPR2025-00363, Paper 10, 2–3 (June 6, 2025) (suggesting that reliance on expert testimony to fill gaps in the prior art weighs in favor of denial) (“*iRhythm*”). In effect, Petitioners use sprawling, backward-looking declarations as a mouthpiece to relitigate the Examiner’s prior assessments of the art and patentability of the claims—despite the Examiner already considering many of the same references. *See infra* Section IV.

Rather than offering a focused declaration limited to points where expert input is indispensable, Petitioners cite their expert for *every* claim limitation and every ground—over 220 times in each Petition. *See generally* 100 IPR Pet. 29–127, 095 IPR Pet. 14–120, 120 IPR Pet. 12–120. They also extensively rely on expert testimony for their priority/written description arguments. *See* 100 IPR Pet. 20–21; 095 Pet. 10–13, 120 IPR Pet. 9–11.

The scale of the “expert” declarations is striking. Across just *these three* IPRs (not to mention the other related IPRs), the declarations total nearly 1,000 pages, each containing between 525–622 numbered paragraphs and 40,000 (in 095 IPR Ex-1001) to over 47,000 words (in the 100 and 120 IPR declarations), by Baby Jogger’s estimate—roughly *triple* the word count permitted for petitions under 37 C.F.R. § 42.24. This volume betrays Petitioners’ strategy: evade the word

limits,⁶ fill gaps in and rewrite the prior art, and bury the Board in expert testimony rather than rely on the art itself.

And if this witness testimony truly was as essential as Petitioners imply, that fact alone counsels against institution. Live testimony subject to direct and cross-examination in a district court—on the stand in front of a judge or jury—is the superior forum. And district courts can better manage the scope and presentation of such evidence before a factfinder than can the Board. Here, institution would force the Board (and Baby Jogger) to parse through thousands of pages of declarations and transcripts.

Petitioners’ overreliance on expert testimony—used to expand their arguments rather than aid the Board’s understanding—thus weighs strongly in favor of denial.

C. Inefficiencies from Petitioners’ Parallel Indefiniteness Challenge Cloaked as a Priority Dispute

In the Petitions, the Petitioners alleged dispute regarding a priority issue is, in reality, an indefiniteness argument. Each of the three challenged Patents’ claims includes the term “substantially parallel” (’568 and ’231 Patents) or “parallel”

⁶ As one example, one petition includes a 6-page “Prior Art Overview” section. 100 Pet. 24–29. But that section is *missing* from the other petitions; it’s only found in the expert declarations. See 095 Pet. Ex-1001, 109–27; 120 Pet. Ex-1001, 109–30.

(’729 Patent). In certain Grounds, Petitioners contend the challenged claims are not entitled to a priority date earlier than March 2016 because those terms supposedly lack support in the priority applications (so that Petitioners can rely on intervening prior art). *See* 095 IPR Pet. 8–13; 100 IPR Pet. 20–23; 120 IPR Pet. 8–11.

But in the district court, Petitioner UPPAbaby contends that “substantially parallel” in the ’231 and ’568 Patents (challenged in the 095 and 100 IPRs, respectively) is *indefinite* under § 112. Ex-2008, 21–22. And UPPAbaby specifically asked the Court to hold the claims invalid at the claim construction phase, arguing that there is no support in *any* application for these terms.; Ex-2010, 26–30. The proper forum for determining whether “substantially parallel” is indefinite *is* the district court. *See Innolux Corp. v. Phenix Longhorn LLC*, IPR2025-00044, Paper 11, 23 (June 9, 2025) (“The scope of an inter partes review is limited to grounds that could be raised under 35 U.S.C. §§ 102 and 103. ... Indefiniteness is not one of those grounds.”). Further, the claim construction briefing and hearing addressing UPPAbaby’s indefiniteness argument (among others) are complete, so the Court may rule at any time. Ex-2005, 7 (ECF 72–73). Thus, the potential for conflicting results before the Board and the district courts is an inefficient use of Board resources and weighs in favor of discretionary denial for the 095 and 100 IPRs. *See Arthrex, Inc. v. Medshape, Inc.*, IPR2025-00053, Paper 11, 14–15 (Apr. 25, 2025) (finding that issues of indefiniteness in claim

construction presented in a parallel proceeding would be more efficiently addressed in the parallel proceeding and weigh in favor of discretionary denial).

D. The *Fintiv* Factors favor discretionary denial

Factor 1 concerns “whether a stay exists or is likely to be granted if a proceeding is instituted.” *Fintiv* at 6. None of the Petitioners has moved for a stay pending the IPRs in any of the district courts.⁷ Thus, this factor favors discretionary denial (because no stay has been requested) or is neutral. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 12 (May 13, 2020) (informative) (cautioning against speculating whether the district court will grant stay).

Factor 2 concerns “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Fintiv* at 6. While a trial date has not been set in any of the parallel cases, the median time to trial in the District of Massachusetts indicates the trial against Petitioner UPPAbaby is expected to begin in March 2027 (*see* Ex-2003) and the expected statutory deadline for the Board’s Final Written Decisions is only a few months earlier, December 20, 2026. With only three months between these dates, essentially all the parties’ investments would be duplicated, leading to significant inefficiencies.

⁷ In parallel district court litigation in Delaware, Petitioner Mockingbird has moved for a stay pending its Motion to Dismiss.

Factor 3 considers the “investment in the parallel proceeding by the court and the parties.” *Fintiv* at 6. The Massachusetts action against Petitioner UPPAbaby has already seen substantial investment. Discovery is well underway: the parties have completed initial document productions and written discovery; exchanged preliminary infringement, non-infringement, and invalidity contentions (Ex-2009, 1); and briefed and argued a motion for summary judgment, which the court denied (Ex-2005, 7 (ECF 71)). Claim construction briefing is also complete—including UPPAbaby’s expert report and deposition testimony—and the Court held a *Markman* hearing on July 17. *Id.* (ECF 72–73). The only step remaining is for the Court to issue its ruling. Petitioner UPPAbaby has not moved for a stay, ensuring that investment in this proceeding will only grow.

Although the Delaware actions are less advanced, Petitioner Mockingbird filed a motion to dismiss its case, and briefing is completed.⁸ Without a stay, those cases will continue to move forward as well. Institution under all these circumstances would undermine the policy of promoting efficient resolution of patent disputes. *See Arthrex, Inc. v. Medshape, Inc.*, IPR2025-00053, Paper 11, 15 (Apr. 25, 2025) (finding that where discovery and dispositive motions would

⁸ There is little progress in Evenflo’s case, but that is irrelevant as the three parties have jointly filed the Petitions.

conclude before the deadline for the final written decision, there was a risk of duplicated efforts).

Factor 4 concerns “overlap between issues raised in the petition and in the parallel proceeding.” *Fintiv* at 6. In the Massachusetts case, Petitioner UPPAbaby served invalidity contentions citing 6 of the 18 Petition references and contending several claims among the patents are indefinite.⁹ With regard to the district court litigations in Delaware, this factor is uncertain because Petitioners have not served invalidity contentions. But there is likely to be substantial overlap.

While all Petitioners filed a *Sotera* stipulation, they fall short of ensuring that the IPR proceedings would be a “true alternative” to the district court prior art challenges. Petitioner UPPAbaby’s invalidity arguments in the district court are more expansive than in their Petitions and include combinations of art asserted in these proceedings with unpublished systems, which Petitioner’s stipulation does *not* moot. *Compare* 095 IPR Pet. 85 (Ground 3), 100 IPR Pet. 56 (Ground 2), and 120 IPR Pet. 85 (Ground 3), with Ex-2008, 14, 18 (asserting Liao combined with

⁹ As noted in Section III.CIII.C, Petitioner UPPAbaby couches some arguments here in terms of “priority” while simultaneously framing them as “indefinite” before the district court. The district court’s forthcoming claim construction order adds to the duplication of effort between the proceedings.

system art). The Office’s Interim Discretionary Process website itself confirms that a Sotera stipulation under these circumstances is not “particularly meaningful” and there is only “limited” efficiency.¹⁰ See also *Shenzen Tuozhu Tech. Co. v. Stratasy, Inc.*, IPR2025-00354, Paper 11, 2–3 (June 12, 2025) (Sotera stipulation “not likely to moot” district court invalidity arguments, so it may “reduce[], but does not eliminate, the inefficiencies” of parallel proceedings); *Motorola Sols. v. Stellar, LLC*, IPR2024-01205, Paper 19, 3–4 (Mar. 28, 2025) (same).

Petitioners filed their stipulations on August 1, 2025, well after the Director’s decision in *Tesla, Inc. v. Intellectual Ventures II, LLC*, IPR2025-00217, Paper 9 (June 13, 2025). Unlike a typical Sotera stipulation, Tesla’s “broad stipulation” had an additional provision in which it promised not to raise “any ground based on a combination of *system prior art* and the references asserted as part of a ground raised.” *Tesla, Inc. v. Intellectual Ventures II, LLC*, IPR2025-00217, Paper 8, Exhibit 1067, 2–5 (June 13, 2025). The Director stated that this counseled against discretionary denial. *Tesla*, Paper 9 at 2. Thus, Petitioners were aware they could have filed a stipulation that would have presented a “true alternative” but opted not to do so. Allowing the IPRs here to move forward would not resolve the question of the validity of the patents at issue and therefore would

¹⁰ <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>.

not reduce the burdens on the parties to maintain two parallel proceedings.

Furthermore, it would be an inefficient use of Board resources to address the challenged patent without being able to resolve it completely.

Factor 5: The Petitioners and the defendants in the parallel proceedings are the same, so this factor favors discretionary denial. See *Arashi Vision (U.S.) LLC d/b/a/ Insta360 v. GoPro, Inc.*, IPR2025-0017, Paper 11, 13–14 (Apr. 28, 2025).

Last, the issues discussed in Sections A–C above all bear on *Factor 6*. They are other “relevant circumstances” considered as part of the “holistic analysis.”

E. Balancing all Factors Favors Denial

In sum, the § 314(a) considerations weigh strongly in favor of discretionary denial. The settled expectations of the Patent Owner in its family of Patents strongly favor discretionary denial. See *iRhythm* at 2 (the settled expectations factor “outweighs” the other considerations that weighed against denial). So do the overreliance on expert testimony and Petitioner’s attempt to frame an indefiniteness dispute from one forum into a priority dispute in this one. *Factor 2* also weighs in favor of exercising discretion because of the proximity of the expected trial date against Petitioner UPPAbaby and the final written decision.

The Board’s resources are better spent allowing the district courts to resolve the validity (including indefiniteness) issues presented here, along with the many *other* patent issues it must address. Because the district court is poised to resolve

all relevant disputes, and these IPRs will not resolve Petitioners' indefiniteness claims, the Board's time and attention are better spent elsewhere.

IV. SECTION 325(d) ALSO FAVORS DISCRETIONARY DENIAL

The Petition should also be denied institution because the same or substantially the same prior art or arguments were previously presented to the Office, and Petitioners did not even attempt to show material error.

The Office uses a two-pronged test to determine whether it will deny institution under 35 U.S.C. § 325(d): (1) whether the same or substantially the same art or arguments were previously presented; and (2) if so, whether the Office erred in a manner material to patentability. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 7–8 (Feb. 13, 2020) (precedential) (“*Advanced Bionics*”). Where a Petition challenges claims using art that was previously presented on an IDS, that alone “is sufficient to satisfy” the first prong of *Advanced Bionics*. *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13, 4 (May 19, 2025) (precedential) (“*Ecto World*”).

Here, both prongs support discretionary denial. First, each IPR contains a Ground that relies on D593,459 to Liao. But Liao was extensively considered and cited by the Patent Office during prosecution. For example, the Examiner rejected the pending claims over Liao during prosecution of the application that issued as the '568 Patent, and the applicant cited Liao on an IDS that was considered by that

same Examiner during prosecution of the applications that issued as the '231 and '729 Patents. Ex-1019 (Part 2), 557, Ex-1022 (Part 1), 255; Ex-1023, 25. Liao was also relied on by this same Examiner during prosecution of several other applications that issued as members of this patent family. *See, e.g.*, Ex-1018 (Part 2), 545–52; Ex-1020 (Part 1), 340–44, 492–94, Ex-1020 (Part 2), 684–86; Ex-1024 (Part 4), 1203–06. Thus, *Advanced Bionics* step 1 is satisfied.

Under *Ecto World*, the petitioner **bears the burden** to explain, **with reference to** *Becton Dickinson* factors (c), (e), and (f), how the Examiner erred in overlooking the prior art—even as to art presented on an IDS. *Ecto World* at 5–6 (“[A] petitioner *must provide an analysis* even when the asserted prior art is on an IDS, but the Examiner did not apply the reference.” (emphasis added)). But the Petitions do not reference these factors at all, much less explain how the Examiner erred in a manner material to patentability to satisfy the second prong of *Advanced Bionics*. Petitioners’ failure here is inexcusable because the Petitions were filed after *Ecto World* was designated as precedential on May 19.

At best, the 100 Petition makes only cursory allegations of error. *See* 100 IPR Pet. 8 (“Examiner appears to have erred in not finding the Challenged Claims unpatentable in view of Liao as a primary reference.”), 28 (“The Examiner’s July 2024 rejection in the ‘417 Application, and the opinion from Petitioner’s experts,

indicates an error occurred during prosecution ... in not fully considering and appreciating Liao's disclosed design.”).

Other references present similar § 325(d) issues. Ground 1 of the 100 IPR asserts obviousness over Rolicki (Patent 8,882,134), which was disclosed in an IDS by the Patentee and signed off by the Examiner. Ex-1019 (Part 2), 582. Ground 3 of the 100 IPR asserts obviousness over Hsia (Patent 6,702,316). A divisional of Hsia with identical drawings and specification was disclosed by the Patentee on an IDS signed by the Examiner. Ex-1019 (Part 2), 579. And Grounds 2 and 3 of each of the 095 IPR and 120 IPR assert the claims are obvious over Schaaf (Patent 6,209,892) in combination with another reference—one of which is Liao—which was likewise cited to the Examiner. Ex-1022 (Part 1), 255; Ex-1023, 25. Neither the 095 IPR nor the 120 IPR makes any allegation or showing of material error; Petitioners only note that those references were cited but not relied on. 095 IPR Pet. 52, 88; 120 IPR Pet. 53, 88. Consequently, the grounds assert prior art that has already been considered and cited during prosecution.

V. CONCLUSION

For the reasons set forth above, the Office should exercise its discretion to deny institution under 35 U.S.C. § 314(a) or § 325(d).

Respectfully submitted,

/Warren Thomas/

Warren J. Thomas (Reg. No. 70,581)

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and agreement of the parties, I certify that on September 2, 2025, a copy of this paper and all accompanying exhibits were served on counsel for the Petitioner by email to:

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