UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AERIN MEDICAL INC.
Petitioner

v.

NEURENT MEDICAL LTD.
Patent Owner.

Case IPR2025-01126
Patent No. 12,096,973

PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

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I. INTRODUCTION

The Director should deny the Request for Discretionary Denial (Paper 6) ("Request") by Neurent Medical Ltd. ("Neurent" or Patent Owner") and refer the Petition to the merits panel. Here, a lack of settled expectations—a factor on which the Director has placed significant emphasis—strongly favors referral to the merits panel as U.S. Patent No. 12,096,973 ("the '973 patent") issued less than 10 months before the Petition was filed. Significantly, all four related patents challenged by Aerin Medical Inc. ("Aerin" or "Petitioner") in IPRs issued in 2024. More specifically, Petitioner filed IPRs against three other related patents asserted by Patent Owner, one that issued a little more than a year before the IPR petition was filed and the two other related patents that issued less than 10 months before the IPR petitions were filed. Furthermore, the Board's Final Written Decision will be released on or before January 8, 2027, and the jury trial in the co-pending litigation is currently scheduled for August 23, 2027, more than seven months later.

Additionally, the Office materially erred in allowing the '973 patent. The '973 patent received no substantive examination despite the fact that its claims were significantly broader than its parent patent, U.S. Patent No. 11,833,091 ("'091 patent"). The examiner failed to consider, much less apply, the teachings of the prior art with respect to the broadened claims of the '973 patent.

Discretionary denial is unwarranted as the considerations identified by the Director for analysis do not favor a discretionary denial, and the Petition presents a strong challenge to the ’973 patent.

II. SETTLED EXPECTATIONS STRONGLY WEIGH AGAINST DENIAL

The ’973 patent and each of the three related patents challenged in IPRs claim priority to a parent patent, the ’091 patent, filed on April 8, 2021. Each of the four challenged patents were all recently issued, as detailed below:

1. US Patent No. 11,998,262 (“the ’262 patent”) issued on Jun. 4, 2024 (IPR2025-01124)
2. U.S. Patent No. 12,089,889 patent issued on Sept. 17, 2024 (IPR2025-01125)
3. The ’973 patent issued on Sept. 24, 2024 (IPR2025-01126)
4. U.S. Patent No. 12,096,974 patent issued on Sept. 24, 2024 (IPR2025-01127)

Given the very recent 2024 issuance of each of these four patents, Patent Owner lacks any settled expectations with respect to the patents. *See Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 12 at 2 (Director June 27, 2025) (“[M]ost of the challenged patents have not been in force for a significant period of time (issued in 2020, 2019, and 2019), and, accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial as to at least those patents.”). Many discretionary denial requests have been denied based at least in part on the patent owner’s lack of “settled expectations”

because the petition challenged a patent that issued in 2024, like the four patents challenged in these related IPRs. *See, e.g.*, *MIM Software Inc. v. 3 Progenics Pharms., Inc.*, IPR2025-00630, Paper 13 at 2 (Director July 24, 2025); *Shenzen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 at 2 (Director July 17, 2025); *RØDE Microphones, LLC v. Zaxcom, Inc.*, IPR2025- 00557, Paper 11 at 2 (Director July 17, 2025); *ResMed Corp. v. Cleveland Med. Devices, Inc.*, IPR2025-00246, Paper 10 at 2 (Director June 12, 2025); *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11 at 3 (Director June 12, 2025).

Lack of settled expectations is further underscored by Patent Owner's lack of contention that the '973 patent has ever been "commercialized, asserted, []licensed, or otherwise applied in [Petitioner's] particular technology space." *Shenzen Tuozhu Technology Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10 (Director July 17, 2025). Furthermore, the challenged patents were never asserted in any lawsuit until the assertion against Petitioner. Nor does Patent Owner contend it has ever sent a demand letter to anyone else. It is therefore abundantly clear that only recently (2024) has Patent Owner attempted to enforce its patents.

Furthermore, Patent Owner (Neurent) should have reasonably expected that the '973 patent (and its related family members) would be the subject of an IPR given that Patent Owner (Neurent) filed IPRs against Petitioner's (Aerin's) patents in the same litigation at issue between the parties. It would be inequitable and unjust

to allow Neurent to benefit from patentability adjudications by the Board with respect to Aerin's patents while denying Aerin the benefit of the same adjudication with respect to Neurent's later asserted patents.

III. THE OFFICE ERRED IN A MATERIAL MANNER DURING THE EXAMINATION OF THE '973 PATENT

Referral to the Board is also warranted because the Office committed material errors in allowing the '973 patent. *Anthony Inc. v. ControlTec LLC*, IPR2025-00559, Paper 12 at 2 (Director July 16, 2025). Even if the Director finds that other factors may favor discretionary denial, "it is an appropriate use of Office resources to review the[se] potential error[s]." *Taiwan Semiconductor. Manufacturing Co. v. Marlin Semiconductor Ltd.*, IPR2025-00847 et al, Paper 11 (Director Sept. 3, 2025) (referring IPR2025-00847 to the Board even though the ITC hearing on the challenged patent is scheduled 9 months before the projected final written decision due date). This remains true even if the Director finds the examiner's errors are applicable to only a subset of patents challenged by Petitioner, since instituting IPRs on the other related, overlapping patents will be an "efficient use of Board resources." *Embody, Inc. et al. v. Lifenet Health*, IPR2025-00248, Paper 13 at 3.

The '973 patent is an expedited (Track One) continuation application of the '091 patent and the '262 patent. Prosecution of the '973 patent was minimal. Track One status was granted, and a first action allowance was issued approximately three months after the '973 patent was filed. Ex-1002, 15. The Notice of Allowance states

"the prior art does not teach" the entirety of claim 1, reproduced verbatim, (*Id*., 20-21), and further states that the "most pertinent piece of prior art, [the '262 patent], is no longer considered prior art given the [filed] terminal disclaimer," and "[t]herefore, it is the Examiner's position that the application is now in condition for allowance." *Id*., 21.

The Notice of Allowance shows the Examiner did not meaningfully consider the prior art. Had the Examiner meaningfully considered the prior art, including how the claims of the '973 patent had been broadened relative to the claims of the '091 patent, the '973 patent would not have been allowed.

Specifically, the '091 patent was allowed in view of ***numerous*** limitations that are ***not*** present in the '973 patent. Ex-1009, 20. The Notice of Allowance explains that the allowance is due to, *inter alia*, "flexible support elements," and a second array of electrodes that (a) extend "substantially opposite the first outward direction," and (b) "are positioned within a second half of the first segment and cooperatively form an inwardly extending second concave shape opposing the first concave shape when the first segment is in the expanded deployed configuration." Ex-1009, 20; Ex-1003-Weide, ¶37-38. The '973 patent also changed, *inter alia*, the language "multi-***segment*** end effector" (as per the '091 patent) to "multi-***electrode*** end effector." *Compare* Ex-1008, claim 1 *to* Ex-1001, claim 1.

Patent Owner's purpose in filing a Track One (expedited) application seeking broader claims was (apparently) to allow Patent Owner to file a patent infringement counterclaim in the co-pending litigation ("Litigation") relative to Petitioner's highly successful RhinAer® device, even though the RhinAer® device had been sold, and was in public use, prior to the '973 patent. Ex-1023, 6-11. The broadened claims, however, read on multiple prior art devices, including the inventor's own device he described in 2016 (Ex-1004-Townley), and the devices described by Petitioner in patents and publications that predate the '973 patent (Exs. 1005-1007).

Patent Owner argues that it "submitted two of the same references Petitioner relies on in the grounds of this IPR (Wolf-003 and Townley)" in and IDS. Request, 4 (citing Ex. 1002, 202 and 203). Yet, these references were just two of *348 total references* submitted by Patent Owner in this IDS alone. *See* Ex-1002, 180-198. A few weeks after the submission of this IDS, the Examiner issued a Notice of Allowance without analysis or explanation of the disclosure of the any of the two references relied upon in this IPR. *See* Ex-1002, 15-22.

IV. DENIAL UNDER § 325(d) IS UNWARRANTED

Patent Owner bears the burden of proof with respect to the request for exercising discretionary denial. *Geotab USA, Inc. v. Omega Patents, LLC*, IPR2023-00504, Paper 11, at *16 (P.T.A.B. July 25, 2023) (citing 37 C.F.R. § 42.20(c)). The Board uses the *Advanced Bionics* two-part framework to determine whether

discretionary denial is merited under 35 U.S.C. § 325(d): "(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims." *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019- 01469, Paper 6, at *8 (P.T.A.B. Feb. 13, 2020) (precedential). To determine whether a previously presented reference is "substantially the same" as a reference applied in a Petition under part one of *Advanced Bionics*, the Board weighs *Becton, Dickinson* factors (a), (b), and (d), which include: "(a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; … (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art." *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, at *17-18 (P.T.A.B. Dec. 15, 2017) (precedential); *Advanced Bionics*, Paper 6, at *10.

A. Becton, Dickinson Factors (a), (b), and (d).

Discretionary denial of institution is inappropriate as Patent Owner incorrectly analyzes the *Becton, Dickinson* factors (a), (b), and (d). The whole premise of

Becton, Dickinson factors (a), (b), and (d) is to discuss the overlap between the art used in the Petition and the art considered during prosecution. Patent Owner includes no such argument in its Request, nor could it. The Office failed to provide *any consideration* of references during prosecution despite the fact that the claims of the '973 patent had been significantly broadened over those of its parent, the '091 patent. Similarly, Patent Owner fails to establish any overlap between arguments made during prosecution and arguments made in the IPR petition, as no arguments were presented or considered during prosecution. Thus, Patent Owner fails to carry its burden with respect to denial under § 325(d) and part 1 of *Advanced Bionics*.

B. Becton, Dickinson Factors (c), (e), and (f).

The Director need not consider part 2 of the *Advanced Bionics* framework as part 1 was not satisfied. Nonetheless, if the Director were to consider part 2, the *Becton, Dickinson* factors (c), (e), and (f) are used to analyze whether the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics*, Paper 6, at *10. Those factors include: "(c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments." *Id*. at *9; *Becton, Dickinson*, Paper 8, at *17-18. These factors favor

institution because the Office erred in a manner material to the patentability of the challenged claims by failing to appreciate the persuasive teachings of the prior art, including the prior art cited in the Petition. *Advanced Bionics*, Paper 6, at *10 ("[I]f the record of the Office's previous consideration of the art is not well developed or silent, then a petitioner may show the Office erred by overlooking something persuasive under factors (e) and (f).").

Although Wolf-003 and, Townley are cited on the face of the '973 patent, the Examiner did not issue a rejection in view of these references even though the references expressly teach the subject matter of the challenged claims, as demonstrated in the Petition. *Becton, Dickinson* Factor (c) supports institution. *Mylan Pharm. Inc. v. Merck Sharp & Dohme Corp.*, IPR2020-00040, Paper 21, at *18 (P.T.A.B May 12, 2020) ("The Examiner never discussed WO '498 or made a rejection based on it. Indeed, the Examiner entered no prior art rejection against the claims of the '708 patent. Because the Examiner gave no reasons for allowance, we are left to guess at why the Examiner regarded the '708 patent's claims as novel and nonobvious."); *Ecto World Director Review*, IPR2024-01280, Paper 16, at *13, *15 (P.T.A.B. June 25, 2025) ("Other than initials on a lengthy IDS, nothing in the record indicates that the Examiner substantively considered [the prior art in question]. . . . Accordingly, . . . the Office erred by not substantively considering [the prior art] during prosecution . . . .").

As to Factor (e), Petitioner has sufficiently demonstrated that the Examiner erred by failing to reject the challenged claims over Wolf-003 and Townley. In particular, the Petition shows, through detailed analysis, how Townley renders obvious each and every limitation of the challenged claims, how Wolf-003 in view of Wolf-290 renders obvious claim 1-2 and 16-17. Petition, 11-67. Accordingly, the Petition explains in detail how prior art that was not considered during prosecution invalidates the challenged claims—confirming that the Examiner committed a material error by allowing the claims. *Hamilton Techs. LLC v. Fleur Tehrani*, IPR2020-01199, Paper 6, 21 (P.T.A.B. Jan. 6, 2021).

As to Factor (f), for the reasons discussed above, the disclosures of Wolf-003, and Townley warrant consideration. Further, Dr. van der Weide's expert declaration in support of the Grounds—that was not available to the Examiner during prosecution—additionally warrants consideration of the prior art. *See Therabody, Inc. v. Hyperice IP Subco, LLC*, PGR2024-00053, Paper 8, at *10-11 (P.T.A.B. Apr. 21, 2025) (existence of a probative expert declaration resulted in "factor (f) weigh[ing] against exercising discretion to deny institution under § 325(d)"); *Safran Cabin Inc. v. B/E Aerospace, Inc.*, IPR2020-00749, Paper 10, at *12 (P.T.A.B. Oct. 21, 2022). On this record, Becton, Dickinson factors (c), (e), and (f) all weigh against denying institution under §325(d).

V. THE *FINTIV* FACTORS DO NOT SUPPORT DISCRETIONARY DENIAL

The Litigation is at its earliest stages.[1] Although the Litigation began in July 2023, the Litigation was stayed in August 2024 after IPRs Neurent filed against Aerin's patent were instituted. Ex-2004 at 1, 6.[2] Neurent did not have any patents to assert at the outset of the litigation so it (apparently) sought expedited (Track One) examination of four applications that inappropriately broadened the scope of its claims—claims so broad that they cover the inventor's own prior art that predates the earliest possible priority date of the subject patent by more than four years. Petition, 7-8. Neurent added the '262 patent to the Litigation in July 2024, when it filed its First Amended Counterclaims. Ex-2004 at 5. Neurent later filed a new lawsuit against Aerin asserting three additional Track One expedited patents, including the '973 patent. The cases were then consolidated. Ex-2008 at 2. Petitioner Aerin has filed IPRs against all four of Neurent's newly issued patents: IPR2025-01124 through IPR2025-01127 ("the IPRs").

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[1] The Litigation is *Aerin Medical Inc. et al. v. Neurent Medical Inc. et al.*, Case No. 23-cv-756 (D. Del.). Petition, 1.

[2] Aerin filed suit against Neurent relative to eight patents, all of which were the subject of IPRs brought by Neurent. The IPRs are 2024-00276 through IPR2024-280, IPR2024-00282, and IPR2024-00669.

On March 18, 2025, District Court Judge Hall lifted the stay only as to the '262 patent, and all indications are Judge Hall will, as is equitable, again stay the Litigation with respect to at least these four patents if IPR trials against Neurent's patents are instituted. Nonetheless, even if the Litigation were to move forward as scheduled, a jury trial in the Litigation would not occur until *August 23, 2027*, more than seven months *after* the FWDs are due in the IPRs.[3] (Ex-2007 at 5.) As shown below, these facts show that discretionary denial under *Fintiv* is inappropriate.

A. Factor 1 (Stay): Petitioner Will Seek a Stay if the Board Institutes IPR and the Court Has Previously Granted Stays in the Co-Pending Litigation

Under *Fintiv*, this factor weighs against discretionary denial in cases where there is no stay but "the district court has denied a motion for stay without prejudice and indicated to the parties that it will consider a renewed motion . . . to stay if a PTAB trial is instituted." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6-7 (P.T.A.B. Mar. 20, 2020) (precedential).

Upon a joint request by both Petitioner and Patent Owner, Judge Hall previously granted a stay of the co-pending litigation in view of the Board's institution of Petitioner's eight IPRs. *See* Ex-2004 at 6, Dkt. No. 93, 1-2. Obviously, Patent Owner believed a stay of the co-pending litigation to be prudent and

[3] Institution Decisions are due in the IPRs by January 8, 2026.

appropriate when the Board instituted *inter partes* review of Petitioner's patents, and, likewise, a stay of the co-pending litigation will also be prudent and appropriate when the Board institutes *inter partes* review of Patent Owner's patents.

Petitioner will seek a stay of the co-pending litigation at least with respect to this patent if the Board institutes this IPR. Furthermore, similar to the previous stay granted in the case, and as is equitable, it is likely that Judge Hall will likely grant a stay at least with respect to this patent based on the Board's institution. *See iRhythm Technologies v. Welch Allyn Inc.*, IPR2025-00363, Paper 10 at 2 (P.T.A.B. June 6, 2025) (finding a high likelihood of a stay where the Petitioner cited specific, recent cases from its Judge regularly granting stays under similar circumstances).

Additionally, Petitioner notes that the statutory deadline for the Board's institution decision is January 8, 2026. The *Markman* hearing on claim construction is currently scheduled for May 28, 2026. Ex-2007, 5. Thus, the Board's institution decision will be released well in advance of the *Markman* hearing.

B. Factor 2 (Trial Date): The District Court's Trial Will Be More Than Seven Months After the Final Written Decision

Fintiv Factor 2 looks to "proximity of the court's trial date to the Board's projected statutory deadline for a final written decision." *Id*. Here, Factor 2 heavily favors institution because, at best, the trial will occur more than seven months after the Board's Final Written Decision. Specifically, the Board's Final Written Decision

will be released on or before January 8, 2027, and the jury trial is currently scheduled for August 23, 2027, more than seven months later.

Board decisions hold that where the projected final written decision precedes the scheduled trial date, this weighs in favor of institution. *See, e.g.*, *Amazon.com, Inc., Amazon.com Svcs. LLC, Amazon Web Svcs., Inc., and Twitch Interactive, Inc. v. NL Giken Inc.*, No. IPR2025-00407, Paper 14 at 2-3 (P.T.A.B. May 16, 2025) ("discretionary denial of institution is not appropriate" where "it is likely that a final written decision in this proceeding will issue before the district court trial occurs"); *Twitch Interactive, Inc. v. Razdog Holdings LLC*, No. IPR2025-00307, Paper 18 at 2-3 (P.T.A.B. May 16, 2025) ("discretionary denial of institution is not appropriate in this proceeding" where no trial date was set but "even if a trial were to be scheduled" it would occur 6 to 7 months after the projected final written decision).

Patent Owner argues that "while trial is expected to occur after the expected Final Written Decision date," the District Court may decide Petitioner's motion to dismiss before the Final Written Decision date. Request, 13. Yet, Petitioner fails to address how the motion to dismiss impacts the *Fintiv* analysis. Furthermore, Patent Owner fails to cite any precedent in which the Director or the Board denied institution in deference to a pending motion to dismiss in a district court. A motion to dismiss is decided upon a different evidentiary standard and on different issues than those presented in the IPR. Contrary to Patent Owner's attempt to frame the

Motion to Dismiss as duplicating the invalidity arguments in the IPR, Petitioner's Motion to Dismiss actually argues that Patent Owner "failed to adequately plead infringement, and its Complaint should be dismissed." Ex-2001, 6. Specifically, Petitioner's Motion to Dismiss argues: "[t]aking Neurent's allegations that use of the RhinAer® infringes the Asserted Patents as true defeats Neurent's claims because the RhinAer® has been on sale, sold, and otherwise available to the public since before the earliest priority date of the Asserted Patents, and that which infringes if later, anticipates if earlier." *Id*. Patent Owner fails to establish how a decision on this Motion to Dismiss would overlap with the patentability determinations to be made by the Board in the IPR.

This factor strongly favors institution.

C. Factor 3 (Parallel Proceeding): The majority of the significant deadlines will occur after the expected institution decision date

Factor 3 weighs against discretionary denial. The district court case is in relatively early stages given the stay of the proceeding and the relatively recent assertion of the challenged patents by Patent Owner. As noted above, the *Markman* hearing is scheduled for May 28, 2026. Ex-2007, 5. Fact discovery is currently scheduled to close August 31, 2026. Opening expert reports are not due until November 2, 2026. Ex-2007, 5. Where, as here, "the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution." *Fintiv*, at *10.

D. Factor 4 (Issue Overlap): *Sotera* Stipulation Will Minimize Any Potential Overlap

Factor 4 weighs strongly against discretionary denial. In its Petition, Petitioner stipulated that, if the IPR is instituted, Petitioner will "not to pursue any grounds raised in this petition, or any grounds Aerin could have reasonably raised in this petition, in the Litigation or any parallel proceeding." Petition, 3-4 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-01019, at *19 (finding "stipulation here mitigates any concerns of duplicative efforts…as well as concerns of potentially conflicting decisions" and "ensures that an inter partes review is a 'true alternative' to the district court proceeding"); *Lego*, 2021 WL 606917, at *6 ("[F]actor weighs strongly against discretionary denial" where Petitioner makes *Sotera* stipulation); *Verizon Business Network Servs, Inc. v. Huawei Techs. Co.*, IPR2020-01141, Paper 12 (Jan. 14, 2021) ("Instituting trial here serves overall system efficiency and integrity goals by not duplicating efforts and by resolving materially different patentability issues.")).

Patent Owner argues that Petitioner's "district court invalidity contentions include substantively the same art and arguments as the Petition." Request, 3. Yet, Patent Owner fails to acknowledge that Petitioner has stipulated if the IPR is instituted, Petitioner will "not to pursue any grounds raised in this petition, or any grounds Aerin could have reasonably raised in this petition, in the Litigation or any

parallel." Petition, 3-4. In view of the stipulation, factor 4 weighs strongly against discretionary denial.

E. Factor 5 (Same Party): Does Not Support Discretionary Denial

When the Petitioner is the same as the named defendants and counter-claim plaintiffs in the litigation, the Board has found that this factor adds "little if anything to the discretionary denial analysis." *See Aylo Freesites Ltd. f/k/a MG Freesites Ltd. v. WellcomeMat, LLC*, IPR2024-00710, Paper 13 at 17-18 (P.T.A.B. Sep. 05, 2024) ("We make the unremarkable observation that an IPR petitioner and patent owner are very often named parties in parallel district court litigation regarding the same patent. In our view, this factor adds little if anything to the discretionary denial analysis unless the petitioner is not named as a defendant (or declaratory judgment plaintiff) in parallel district court patent litigation."). As in *Aylo*, the fact that there is overlap between the Petitioner and the defendant in litigation adds little to the discretionary denial analysis here.

F. Factor 6 (Other Considerations): The Strong Merits of the Petition Strongly Favor Institution

As described above in Section III, the Office materially erred in examining the '973 patent. Thus, the strong challenge to the '973 patent presented in the Petition weighs against a discretionary denial.

Patent Owner argues that the IPRs should be denied because Petitioner failed to file PGRs against the patents. Request, 5, 16. Yet, Patent Owner's proposal

obviates the clear congressional intent of having two avenues of patent challenges available: PGRs and IPRs. If a petitioner chooses, they may file a PGR within 9 months of grant, or petitioner may wait and file an IPR after the 9-month period expires. 35 U.S.C. §§ 311, 321. Congress would not have created IPRs if it wanted petitioners to only challenge patents within 9 months of grant. If PGRs were to be the only option, Congress would only have created the PGR process. Yet, that is not what Congress did. Instead, Congress created two alternative options and allowed a petitioner to select which one to use. Petitioner selected the second option and filed the IPRs very soon after the patents were IPR eligible.

Patent Owner argues the Petition's motivation to combine and reasonable expectation of success analyses are conclusory and insufficient. Request, 18. Not so. The primary reference of Townley is the inventor's own prior work and shows a reasonable expectation of successfully treating the same medical conditions as described in the '973 patent. Petition, 9-10 (citing Ex-1004-Townley and supporting prior art (Exs. 1019-20, 1024) in addition to expert testimony).

Patent Owner argues different figures in Townley are being used. Request, 18. This argument misses the mark because Townley's disclosure builds upon itself and actually allows for its different embodiments to include the same features. Ex-1004-Townley at [0066] (FIG. 4 building on FIGS. 2-3E), [0075] (explaining the devices of FIGS 5A-5G include features generally similar to the features of the

therapeutic neuromodulation device 402 of FIG. 4.), [0105] (explaining the device 1102 of FIG. 11A-11C include various features generally similar to the features of those described in FIGS. 4-5G).

For Ground 2, Patent Owner argues Petitioner fails to articulate why or how a POSITA would have been motivated to modify Wolf-003's device specifically or why or how it would be expected to achieve the claimed results. Request, 18-19. Again, Patent Owner misrepresents the Petition to distract. The Ground 2 arguments are supported by Wolf-003, as confirmed by Wolf-290 and many other prior art references, as shown across all limitations of the claims of Ground 2. Petition, 46-67.

Patent Owner argues the Petition relies on expert testimony to gap-fill the prior art with merely conclusory statements, citing pages 11-12 and 29 of the Petition. Request, 19. Again, this is false. Petitioner's expert's analysis is corroborated in every instance by prior art, including the inventor's own prior art and its statements. Patent Owner's analysis also ignores the disclosures on pages 8-9, which explain the background knowledge of a POSITA as supported by Ex-1004-Townley, Ex1005-Wolf-003, Ex-1006-Wolf-290. Page 29 of the Petition relates to "improved breathability," which clearly happens when an obstruction is removed from the nose. Petition, 29.

Patent Owner argues Ground 1 does not identify how electrodes "extend" from the axis of the shaft. Request, 19. Not true. Numerous pictures are provided across pages 18-24 of the Petition showing electrode extension. The '973 patent's figures confirm that its electrodes and Townley's electrodes "extend" in the same manner. *Compare, e.g.*, FIGS. 5A-5D of the '973 patent, *with* FIGS. 4, 5A-5G of Ex-1004-Townley.

Finally, Neurent argues that access to medical devices favors denial. Yet, Neurent's counterclaims seek to exclude Aerin's already existing products from the market—products that have been used for years to assist patients. Ex-1023, 2-5 (explaining Aerin's products and use in the market before the '973 patent was filed).

VI. CONCLUSION

As shown above, the Director should not discretionarily deny this Petition.

Respectfully submitted,
GREENBERG TRAURIG, LLP

Date: October 8, 2025

By: / Trenton A. Ward/
Trenton A. Ward (Reg No. 59,157)
3333 Piedmont Road NE, Suite 2500
Atlanta, GA 30305
trenton.ward@gtlaw.com
Office: 678.553.2470

Counsel for Petitioner

CERTIFICATION UNDER 37 C.F.R. § 42.24(d)

This Request complies with the requirements of 37 C.F.R. § 42.24(d), as PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION is 20 pages.

Respectfully submitted,
GREENBERG TRAURIG, LLP

Date: October 8, 2025

By: / Trenton A. Ward/

Trenton A. Ward (Reg No. 59,157)
3333 Piedmont Road NE, Suite 2500
Atlanta, GA 30305
trenton.ward@gtlaw.com
Office: 678.553.2470

Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION were served on the following counsel via electronic mail:

David.Cavanaugh@wilmerhale.com
Gregory.Lantier@wilmerhale.com
Alexis.Cohen@wilmerhale.com
Joshua.Stern@wilmerhale.com
Alex.Nemtzow@wilmerhale.com
Gilbert.Smolenski@wilmerhale.com
Bobby.Hampton@wilmerhale.com
WHNeurentIPRService@wilmerhale.com

Wilmer Cutler Pickering Hale and Dorr LLP
2100 Pennsylvania Avenue NW
Washington, DC 20037

GREENBERG TRAURIG, LLP

Date: October 8, 2025

By: / Trenton A. Ward/
Trenton A. Ward (Reg No. 59,157)
3333 Piedmont Road NE, Suite 2500
Atlanta, GA 30305
trenton.ward@gtlaw.com
Office: 678.553.2470

Counsel for Petitioner