UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAIHONG DISPLAY DEVICES CO., LTD.,
Petitioner

v.

CORNING INCORPORATED,
Patent Owner

Case IPR2025-01137
U.S. Patent No. 8,627,684

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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TABLE OF AUTHORITIES

Cases

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	ITC Scheduling Order (ITC-337-TA-1433)
2002	2007 Display Component of the Year, accessed Apr. 9, 2025 at: https://www.sid.org/Awards/Display-Industry-Awards/DIAAwardsArchive
2003	Corning wins awards for EAGLE XG(TM), May 23, 2007, accessed Apr. 9, 2025 at: https://www.glassonline.com/corning-wins-awards-for-eagle-xgtm/
2004	In Handbook of Visual Display Technology, chapter 5.1.1 "Glass Substrates for AMLCD, OLED and Emerging Display Platforms," Peter L. Bocko, pp. 599-623 (2012)
2005	File History of U.S. Patent No. 8,627,684

I. INTRODUCTION

U.S. Patent No. 8,627,684 ("the '684 patent") claims an innovative apparatus and "pull roll" process for manufacturing glass sheets for flat-screen electronic displays. The '684 patent is related to four other patents that have been challenged in IPRs and are asserted in the ITC. *See Certain Glass Substrates for Liquid Crystal Displays, Products Containing the Same, and Methods for Manufacturing the Same (I) and (II)*, Inv. Nos. 337-TA-1433; 337-TA-1441. Those related patents (and IPRs) are U.S. Patent Nos. 7,851,394 ("the '394 patent") (challenged in IPR2025-00439), 8,640,498 (challenged in IPR2025-00937), 8,642,491 (challenged in IPR2025-01017), and 9,512,025 (challenged in IPR2025-01040). Based on the ITC investigation and settled expectations of the parties, related proceeding IPR2025-00439 was discretionarily denied. *See Caihong Display Devices Co. Ltd. v. Corning Inc.*, IPR2025-00439, Paper 18 (P.T.A.B. July 10, 2025). The other IPRs are pending discretionary denial decisions. This IPR has the same procedural issues identified in denying the '394 patent IPR, as well as additional deficiencies. It should be denied for at least the same reasons.

Foremost, the *Fintiv* Factors and recent Acting Director guidance on discretionary denial weigh strongly in favor of denial. The parallel ITC litigation between the same parties and involving the challenged patent cannot be stayed, and will be completed several months before a Final Written Decision in this

proceeding. The '684 patent issued over eleven years ago and relates to a process for manufacturing a well-known and critically acclaimed commercial product. Settled expectations, economic and public-interest considerations, and judicial economy all favor denial here, just as they did in IPR2025-00439.

Additionally, the Petition fails to identify its challenge with particularity. Ground 1 alleges obviousness based on "JP '826 in view of one or more of Butts, JP '027, KR '349, Ferngren and Smids." Pet., 3, 8. Petitioner discusses these six references collectively and interchangeably throughout the argument sections of the Petition. *E.g.*, Pet., 16-22. Ground 1 thus does not identify a particular combination of references, instead presenting 31 possible combinations. Ground 2 similarly presents seven different combinations of "KR '349 in view of one or more of Bogdahn, Ferngren and Fredholm." Pet., 3, 8. This alone is a basis to discretionarily deny institution under 35 U.S.C. § 312(a). *See Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 at 15 (P.T.A.B. Mar. 6, 2019).

Compounding this deficiency, five of the cited references were considered by the Examiner during prosecution, with three being cited in rejections and overcome. Pet., 6. Petitioner's failure to commit to particular combinations in its analysis indicates that the majority of the art and arguments on which it relies are the same as, or at least cumulative of, those already considered during prosecution. Taking the Grounds at face value, 35 of the 38 total obviousness combinations

across both Grounds recycle art and arguments that were already overcome, without Petitioner identifying a material error in the examination. That supports discretionary denial under 35 U.S.C. § 325(d).

II. FACTUAL BACKGROUND

The ’684 patent is directed to manufacturing equipment and processes for making glasses that can be used for displays, such as LCDs. EX1001, Abstract, 1:12-2:21. The process allows for the production of high-quality glass that is more efficient and easier to maintain than prior-art technology. The claimed apparatus and process recites a fusion process that uses downward pulling rollers and cooling rollers to create tension in the molten glass in both transverse and longitudinal directions. EX1001, claims 1, 7. The process allows for tightly controlled and reproducible glass dimensions, and produces sheets that are flat, smooth, defect-free, and thermally and mechanically durable. EX1001, 4:24-41, 13:65-15:29.

The application that resulted in the ’684 patent went through an extensive and substantive examination at the Office. A total of four office actions were issued. The Examiner cited Smids, Fengren, and Butts in obviousness rejections that the Applicant overcame. JP ’826 was also cited in an IDS on April 7, 2009 and considered by the Examiner on May 6, 2010. EX2005, 0083, 0131. In allowing the claims over the prior art, the Examiner noted “[t]he closest prior art of record, Butts, … is silent with regard to any second pair of rollers that are above or below

a first pair of rolls and is silent with regard to any splitting or apportioning of the torque in different roll pairs that are located in." *See* EX1011, 4.

Petitioner has not found any art closer than Butts, and instead relies upon largely the same references for the same limitations that the Office already found to be lacking. For instance, none of the cited prior art discloses the specific roller configuration or the claimed apportionment of the torque in different roll pairs.

III. PERSON OF ORDINARY SKILL IN THE ART ("POSA")

Only for purposes of this Discretionary Denial Brief, Patent Owner does not dispute Petitioner's defined person of ordinary skill in the art.

IV. CLAIM CONSTRUCTION

While Patent Owner does not agree with Petitioner's constructions, the Board need not construe any term to determine that institution should be discretionarily denied.

V. REASONS THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION

The facts and circumstances here warrant denying review under at least one of 35 U.S.C. §§ 325(d), 312(a)(3), and 314(a). The Petition contains several procedural defects that make its success on the merits unlikely, and various facial flaws that make institution an inefficient use of the Board's limited resources.

A. The Director should use discretion under 35 U.S.C. § 314(a) to deny the Petition.

The *Fintiv* factors weigh in favor of discretionary denial, as do the settled expectations of the parties, economic and public health interests, and the weakness of the Petition's arguments on the merits.

1. All six *Fintiv* factors weigh in favor of Patent Owner and denial in view of parallel ITC investigation.

The ITC's trial is scheduled to commence over eleven months before a FWD in this IPR (expected January 2027), with the ITC's initial determination expected on March 24, 2026, and the trial expected to conclude on July 24, 2026 (over five months before FWD). EX2001, 5. Institution would lead to unnecessary duplication and the potential for inconsistent results. Based on these facts and Petitioner's weak, unsupported unpatentability arguments, the Director should exercise discretion to deny the Petition. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) ("*Fintiv*"). As discussed further below, all six *Fintiv* factors weigh in favor of denial under 35 U.S.C. § 314(a).

***Fintiv* factor 1**: The ITC is under a congressional mandate to conclude its investigations and make determinations "at the earliest practicable time." 19 U.S.C. § 1337(b)(1). It does not stay its proceedings based on a pending IPR.

***Fintiv* factor 2**: The projected statutory deadline for issuing a FWD in this IPR is in January 2027. Trial in the co-pending ITC litigation is scheduled to be

completed the week of July 24, 2026—*over five months* before FWD. EX2001, 5. Further, an initial determination in the co-pending ITC litigation is scheduled to issue on March 24, 2026 (over nine months before FWD) and the target date for completion of the ITC investigation is July 24, 2026 (over five months before FWD). EX2001, 5. The ITC's trial schedule weighs in favor of denial. *Fintiv* Guidance[1], 2 ("[I]nstituting an IPR or a PGR where the ITC has set a target date for completing its investigation (i.e., the full Commission's final determination) to occur earlier than the Board's deadline to issue a final written decision in a challenge involving the same patent claims means that multiple tribunals may be adjudicating validity at the same time, which may increase duplication and expenses for the parties and the tribunals.").

***Fintiv* factor 3**: "[T]he amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision" favors denial. *Fintiv*, 9. The deadline for issuing a Decision on Institution (DI) in this IPR is January 2, 2026. By that time, the parties will have completed fact discovery (August 8, 2025), exchanged expert reports on all issues, including any invalidity defenses (August 18, 2025 and September 8, 2025), and exchanged trial

[1]https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf

exhibits (October 3, 2025 through October 17, 2025). EX2001, 3-4. Because the parties and the ITC will have expended significant resources by the January 2, 2026 DI deadline, factor 3 weighs in favor of denying institution.

***Fintiv* factor 4**: There is no *Sotera* stipulation stopping Petitioner from asserting obviousness combinations of system prior art in the ITC together with prior-art references relied on in its Petition, and other invalidity theories. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (P.T.A.B. Dec. 1, 2020) (precedential as to § II.A). As the Acting Director recently recognized, such duplicative arguments do not ensure that the IPR proceedings would be a "true alternative" to litigation. *See Motorola Sol'ns, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3–4 (P.T.A.B. Mar. 28, 2025) (finding that a *Sotera* stipulation was unlikely to moot the petitioner's combination of IPR art with unpublished system prior art in district court proceedings, and therefore could not outweigh other factors favoring denial).

All 14 claims of the patent are challenged in this IPR, while only five dependent claims (claims 2, 4, and 10-12) are currently at issue in the ITC litigation. That the claims at issue between the two proceedings are not identical, without more, does not warrant institution. It is common in ITC investigations that the patent owner will (and often must) reduce the number of claims that are ultimately adjudicated. *See Certain Glass Substrates for Liquid Crystal Displays,*

Products Containing the Same, and Methods for Manufacturing the Same, No. 337-TA-1433, Order 2, Ground Rule 3. As a practical result, there will never be substantial correspondence between the claims that the ITC adjudicates and the claims challenged in a co-pending IPR. Accordingly, if differing claim sets between an IPR and an ITC investigation presented a valid reason for granting institution, then co-pending ITC investigations could never weigh in favor of discretionary denial. That untenable result would undermine the Board's *Fintiv* Guidance. Accordingly, on balance, factor 4 favors denial.

***Fintiv* factor 5**: Petitioner, Caihong Display Devices Co., Ltd., is the first-named respondent in the co-pending ITC litigation. Factor 5 thus weighs in favor of denying institution.

***Fintiv* factor 6**: Factor 6 weighs in favor of denying institution. There are numerous weaknesses in the merits of the Petition. For example, the Petition's "Motivation to Combine" analysis consists of a single paragraph that merely repeats the legal standard and then block cites to over 150 paragraphs of its expert declaration. *See* Pet., 15-16 (citing EX1003, ¶¶75-232). While the Petition says that motivation to combine and reasonable expectation of success will be "set forth below in more detail," it never does. Pet., 15. Additionally, both Grounds 1 and 2 have clearly missing claim limitations that Petitioner tries (and fails) to fill with mischaracterizations of the prior art and conjecture from the expert declaration.

For instance, despite citing six references in Ground 1, Petitioner cannot point to a single reference (or combination of references) that discloses controlling the torque of one roller to be a predetermined percentage of the torque of another roller, as recited in the independent claims. *See, e.g.*, Pet., 21. Much less does the cited art disclose the claimed configuration of rollers such that a torque of at least one of the stub rolls in each of the first and second stub roll pairs is a predetermined percentage of the torque of a pull roll. *See* EX1001, claim 1. Even worse, the Petition's purported quote of Butts (EX1004) for this limitation appears to be fabricated:

> Butts teaches that "controlling torque rather than speed can allow for a speed difference between the rolls, enabling the surface speed of the glass sheet to match the speed of the rolls, thereby preventing the rolls from slipping relative to the glass plate." [EX1004], ¶ [0021].

Pet., 21. Butts contains no such quotation in paragraph 21 or elsewhere. *See generally* EX1004. Indeed, as the Office has already found, "Butts is silent with regard to any second pair of rollers that are above or below a first pair of rolls and is silent with regard to any splitting or apportioning of the torque in different roll pairs that are located in." *See* EX1011, 4.

Ground 2 similarly has missing claim limitations. It acknowledges that the primary reference, KR '349, does not teach (1) monitoring and controlling the torque of each roll, or (2) the ratio of the torque of the short roll to the long roll is a

preset value. Pet., 49. Petitioner appears to rely on Bogdahn alone for teaching these limitations. Pet., 48-49 (stating Bogdahn teaches "reduc[ing] or prevent[ing] gearing differences between the individual rolling bodies [and the resulting damage to the glass surface] by coordinating the torques" (citing EX1008, ¶¶[0021], [0037])).

But Bogdahn teaches the benefits of coordinating torques among entirely differently situated rollers in forming cylindrical glass—not flat glass sheets. EX1008, Abstract, ¶[0001], FIG. 1, claims 1, 12, 19. The entire apparatus and relative positions and motions of the rollers are configured differently. *Id.* The purpose of the torque control in the '684 patent is to coordinate the rollers pulling on the perpendicular edges of the glass sheet. *See* EX1001, 7:66-8:35. Cylindrical glass tubes do not have perpendicular edges. No disclosure in Bogdahn teaches how or why one would coordinate the torque ratios of the kind of rollers claimed in the '684 patent.

The Petition states in conclusory fashion that a POSA "would understand" how to implement extensive modifications to KR '349 to control the torque of its rollers. Pet., 48. It cites nothing in the prior art for that proposition. Pet., 48; *see also Personal Web Techs., LLC v. Apple, Inc*., 848 F.3d 987, 994 (Fed. Cir. 2017) ("[A] clear, evidence-supported account of the contemplated workings of the combination is a prerequisite to adequately explaining and supporting a conclusion

that a relevant skilled artisan would have been motivated to make the combination … ."); 37 C.F.R. § 42.104(b)(4) (requiring that evidence essential to disclose a claim limitation be found in the prior art, as opposed to expert conjecture or alleged knowledge of a POSA).

2. The settled expectations of the parties weigh against institution.

The '684 patent issued January 14, 2014 (over 11 years ago). The Office has indicated that it is not a good use of resources and upsets the settled expectations of patent owners and the marketplace to review patentability challenges for patents that have been in force for many years. *See, e.g.*, *Dabico Airport Sol'ns Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2 (P.T.A.B. June 18, 2025) (discretionarily denying review of a patent that had been in force for "almost eight years"). The '684 patent has been in force even longer.

Corning has been practicing this patent to make its EAGLE XG Glass since the technology recited therein was developed. *See* Section V.A.3 (discussing economic and public health considerations). The manufacturing processes claimed in the '684 patent are critical to Corning's ability to produce EAGLE XG Glass with the stringent quality attributes that have made it the industry standard. With the capabilities of its patented manufacturing processes, Corning has produced more than 25 billion square feet of EAGLE XG Glass—enough to pave the Great Wall of China 25 times or cover nearly 390,000 football fields.

Petitioner Caihong has been competing with Corning's EAGLE XG Glass for years. Competitors and customers alike have been well aware of both Corning's and Caihong's products, and the market reflects Corning's established superiority. The challenged patent has been in force for over a decade and the market has evolved around it. Supply chains are established and stable. After using a different glass that the market recognized as inferior, Caihong copied Corning's EAGLE XG Glass and began using Corning's patented processes. That Corning then enforced its patent was no surprise. The settled expectations of the parties (and the industry) are that Corning's '684 patent protects Corning's proprietary process.

3. Compelling economic interests weigh against institution.

Corning has spent decades and invested approximately one billion dollars in developing the fusion-draw glassmaking process discussed in the '684 patent (and other Corning patents). Corning has also spent decades developing glass compositions designed to be manufactured using the fusion-draw process recited in the '684 patent. Corning has facilities and employees in the United States where it makes the machinery, develops the technologies, and provides support for the production of EAGLE XG Glass. For example, Corning produces, manufactures, and assembles components for its fusion manufacturing systems that make EAGLE XG Glass at a manufacturing facility in Erwin, New York, near its headquarters in Corning, New York.

Corning continues to reinvest the proceeds from EAGLE XG Glass made by the processes recited in the '684 patent in significant research and development, including composition-related work, attribute improvements, equipment manufacturing, cost-reduction programs, and process improvements for its next generation of LCD fusion-draw glass. Its efforts in this regard have won multiple awards. *See, e.g.*, EX2002, 14 (2007 Display Component of the Year; Gold Award: Corning Inc. Eagle XG™ Glass Substrate); EX2003 (Advanced Display of the Year (ADY) award). Those investments are threatened by Caihong's importation of infringing glass from China and its retaliatory challenges to Corning's patents (like the present Petition).

Corning also worked extensively to develop a cleaner, more efficient process for producing defect-free glass suitable for use in LCD panels. The manufacturing equipment and processes covered by the '684 patent overcame the shortcomings of the prior art. But they did not come cheap. It took years of diligent work, hundreds of experiments, and a cost of about $3 million every six months (not including raw material costs). The only way to recoup that kind of investment is through patent protection. It is also the only way Corning can continue to fund research into the next generation of fusion-draw glass that remains free of toxic chemicals.

Accordingly, instituting review of the '684 patent will not serve the fundamental purpose of the IPR process in eliminating counterproductive patents

that stifle innovation. *See* 37 C.F.R. § 42.100 (2017) (observing the purpose of IPR as streamlining the patent system, improving patent quality, and thereby promoting innovation). Corning is a leading American innovator, and the '684 patent reflects its contributions to research and development. The Director should exercise discretion to deny institution.

4. The Petition relies heavily and incorrectly on its expert declaration to fill gaps in the prior art and the Petition's obviousness analysis.

Petitioner's obviousness arguments are largely conclusory and rely heavily on the say-so of Petitioner's supporting expert declaration. For instance, the Petition's "Motivation to Combine" analysis consists of a single paragraph that merely repeats the legal standard and then improperly incorporates by reference over 150 paragraphs of its expert declaration. *See* Pet., 15-16 (citing EX1003, ¶¶75-232). The Petition never provides a more fulsome discussion or evidence.

Furthermore, the Petition uses the expert declaration to fill gaps in the prior art disclosure. *Cf. iRhythym Techs. Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 2-3 (P.T.A.B. June 6, 2025) (suggesting that identifying portions of expert testimony to fill gaps in the prior art weighs in favor of denial). For instance, Petitioner cannot point to a combination of references that discloses controlling the torque of one roller to be a percentage of the torque of another roller. *See, e.g.*, Pet., 21. Instead Petitioner uses a purported combination of JP

’826 and Butts—neither of which discloses controlling a torque differential. Petitioner reasons that Butts teaches setting the rollers to different rolling speeds—even though speed is different than torque—and cites nothing but its expert opinion that one of skill in the art would encounter no technical barrier in modifying Butts and JP ’826 to arrive at the claim limitation. Pet., 21 (citing EX1003, ¶¶96-98). This is improper under 37 C.F.R. § 42.104(b)(4).

The Petition also attributes technical discussion to the expert declaration that is not there. *See, e.g.*, Pet., 33 (citing EX1003, ¶¶136-139 for the proposition that “the torque control in Butts offers more benefits than speed control” and would have therefore motivated a POSA to modify the rollers in JP ’826). Paragraphs 136-139 of Exhibit 1003 do not characterize Butts as providing torque control. *Contra id*. Accordingly, not only does the Petition use expert testimony to fill gaps in contravention of 37 C.F.R. § 42.104(b)(4), it does not even do so in a way that accurately cites the expert declaration or cited prior art. The Petition’s improper and unreliable use of its expert declaration weighs in favor of discretionary denial.

B. The Director should use discretion under § 312(a)(3) to deny the Petition.

A petition must identify “with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). “It is of the utmost importance that petitioners in the IPR proceedings adhere to the

requirement that the initial petition identify with particularity the evidence that supports the grounds for the challenge to each claim." *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd*., 821 F.3d 1359, 1369 (Fed. Cir. 2016) (internal quotes omitted). That is because "the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute." *Id.*

The Petition here does not satisfy the particularity requirement because its use of "one or more of" multiple alternative secondary references results in an excessive, voluminous, and ambiguous number of obviousness combinations. *Compare* Pet., 3, 8, *with Adaptics*, IPR2018-01596, Paper 20 at 15-17 (informative) (citing § 312(a)(3)). Specifically, Ground 1 alleges obviousness based on "JP '826 in view of one or more of Butts, JP '027, KR '349, Ferngren and Smids." Pet., 3, 8. Petitioner discusses these one primary and five secondary references collectively and interchangeably throughout the argument sections of the Petition. *E.g.*, Pet., 16-72.

As a result, Ground 1 does not identify a particular combination of references, instead presenting 31 possible combinations. Such excessive alternative grounds thwarts "the interests of efficient administration of the Office" and "procedural fairness to Patent Owner." *Adaptics*, IPR2018-01596, Paper 20 at 24 (citing 35 U.S.C. § 316(b)). *Adaptics* is highly instructive here. In *Adaptics*, the Board denied institution because the petition included "voluminous and excessive

grounds" based on the use of "and/or," yielding "hundreds of possible combinations." *Adaptics*, IPR2018-01596, Paper 20 at 18-19. The Board characterized the petitioner's grounds as "not reasonably bounded in scope and unduly burdensome for both Patent Owner and the Board to address." *Id.* at 21. Even under a "conservative interpretation" that limited the petition's grounds to "a total of seventeen possible combinations," the Board determined that this number of grounds "yields an unduly burdensome number of combinations." *Id.* at 19. The Petition here presents the exact same situation.

Not only does Ground 1 present 31 possible combinations, but Ground 2 uses the same tactic, presenting an additional seven possible combinations of "KR '349 in view of one or more of Bogdahn, Ferngren and Fredholm." Pet., 3, 8. Petitioner's resulting 38 different prior-art combinations presented in a choose-your-own-adventure style discussion is even less bounded in scope than the 17 combinations that were found to be unduly burdensome for both Patent Owner and the Board in *Adaptics*. That alone is a basis to discretionarily deny the Petition.

C. The Director should use discretion under § 325(d) to deny the Petition.

The facts here support denial under § 325(d) because Petitioner relies on art that was expressly considered during prosecution. The Board has discretion to deny review where "the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d); *Advanced Bionics,*

LLC v. Med-El Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential March 24, 2020). The Board considers the *Becton, Dickinson* factors when applying the framework. *Advanced Bionics*, IPR2019-01469, Paper 6 at 9; *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (P.T.A.B. Dec. 15, 2017) (informative). Under the first part of the *Advanced Bionics* framework, the majority of the 38 prior-art reference combinations presented across the two Grounds were before the Examiner.

Specifically, five of the cited references were considered by the Examiner during prosecution, with three being cited in rejections. JP '826 (JP10-291826) (the primary reference for Ground 1) was cited in an IDS and considered by the Examiner on May 6, 2010. EX2005, 0131. Petitioner wrongly contends that this reference was not cited to the Office during prosecution. *See* Pet., 6. Butts (EX1004), Ferngren (EX1007), and Smids (EX1010) were cited in multiple rejections. EX1011, 102-109 (Butts and Smids), 76-87 (Smids, Butts, and Ferngren), 54-64 (Smids, Butts, and Ferngren), 35-44 (Smids, Butts, and Ferngren). The vast majority of the "one or more" combinations presented in Ground 1 were, accordingly, already considered by the Office.

Under the second part of the *Advanced Bionics* framework, Petitioner carries the burden of demonstrating material error: "If a condition in the first part of the

framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review." *Advanced Bionics*, IPR2019-01469, Paper 6 at 8–9; *see also Becton, Dickinson*, IPR2017-01586, Paper 8 at 17–18 (explaining that factor (e) asks "whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art"); *Microsoft Corp. v. AlmondNet, Inc.*, IPR2022-01319, Paper 9 at 11 (P.T.A.B. Jan. 30, 2023) (denying institution under § 325(d)). "At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown." *Advanced Bionics*, IPR2019-01469, Paper 6 at 9.

Petitioner attempts to avoid § 325(d) by stating generally that some of the cited references were not considered during prosecution, particularly not as part of the combinations presented in the Grounds. Pet., 6. But Petitioner's failure to commit to particular combinations of references in its analysis, *see* Section V.B. above, means that it cannot dispute that the vast majority of art and arguments presented are the same as (or cumulative of) those already considered and overcome during prosecution. Taking the Grounds at face value, and correcting Petitioner's errors about which references were before the Examiner, 34 of the 38 total obviousness combinations across both Grounds recycle art and arguments that

were considered during prosecution, without Petitioner ever identifying any error material to patentability. Pet., 6-7.

That warrants denial under §325(d) in the present case. *See Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 10 at 11–12 (P.T.A.B. Mar. 6, 2025) (denying institution where the Board found that Petitioner "failed to address the second prong of *Advanced Bionics*, much less show that the Examiner erred in a manner material to patentability"); *see also Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper 7 at 19–20 (P.T.A.B. July 11, 2023) (denying institution where Petitioner's "relied-upon references (or their substantially identical disclosures), were before the Office during examination"). Specifically, it would be an inefficient use of the Board's limited resources to parse through Petitioner's 38 potential obviousness combinations, determine which ones were not meaningfully considered during prosecution, and then revisit patentability of the '684 patent on that basis.

VI. CONCLUSION

The Director should exercise discretion to deny institution of *inter partes* review of the '684 patent.

Respectfully submitted,

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CERTIFICATE OF PAGE LIMIT

1. This Discretionary Denial Brief complies with the type-volume limitation of 20 pages excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

2. This Discretionary Denial Brief complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word 2016 in 14-point Times New Roman font.

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** and associated Exhibits 2001-2005 were served in their entireties on August 29, 2025, upon the following parties via electronic mail:

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