

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIVEINTENT, INC.,
Petitioner

v.

INTENT IQ, LLC and ALMONDNET, INC.,
Patent Owner

Case No. IPR2025-01317
Patent No. 8,677,398

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF
INSTITUTION**

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35 U.S.C. § 3143

35 U.S.C. § 31510

37 C.F.R. § 42.1073

Patent Owner's Exhibit List for IPR2025-01317

Pursuant to 37 C.F.R. § 42.63(e), Patent Owner Intent IQ, LLC hereby submits its exhibit list associated with the above-captioned *inter partes* review of U.S. Patent No. 8,677,398.

Exhibit No.	Description
2001	Nisha Shetty, IAM, <i>The invention story of a small ad company that won \$122 million verdict from Amazon</i> , https://www.iam-media.com/article/the-invention-story-of-small-ad-company-won-122-million-verdict-amazon (Aug. 15, 2024)

I. INTRODUCTION

Pursuant to the Director’s March 26, 2025 memorandum regarding Interim Processes for PTAB Workload Management (“March 26, 2025 Memo”), Patent Owner Intent IQ, LLC requests that the Director exercise discretion under 35 U.S.C. § 314(a) and issue a decision denying institution of the Petition.

As discussed further below, the settled expectations of the parties weigh heavily against institution because the challenged U.S. Patent No. 8,677,398 (“’398 Patent”) was issued over *eleven years ago*. And many of the traditional *Fintiv* factors additionally weigh in favor of discretionary denial.

Patent Owner thus respectfully requests discretionary denial of the Petition.¹

II. DENIAL OF INSTITUTION UNDER §314 IS WARRANTED.

A. Settled expectations and other factors favor denial of institution.

35 U.S.C. § 314(a) gives the Director discretion to deny institution of IPR due to the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19-21 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”).

¹ Patent Owner reserves the right to file a Preliminary Response addressing the merits of the Petition pursuant to 37 C.F.R. § 42.107(a) on the schedule set forth by regulation and consistent with the March 26, 2025, Memorandum. *See* 37 C.F.R. § 42.107(b).

The March 26, 2025 Memorandum regarding Interim Processes for PTAB

Workload Management sets forth various relevant considerations may weigh in favor of discretionary denial, including:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

Here, the '398 Patent issued on March 18, 2014, and has been in effect for over *eleven years*. See Ex. 1001. Accordingly, the settled expectations of Patent Owner of being able to adjudicate its patent claims before an Article III Court weigh against institution.

These settled expectations are bolstered by the fact that the '398 Patent's family (and thus the '398 Patent itself) is subject to significant licensing activity.²

² The terms of these licenses (and in most cases, even their existence) are subject to confidentiality provisions. While Patent Owner has not obtained the necessary authorizations from the licensed parties to disclose the terms of these licenses, there are several portfolio licenses that date back as early as 2013 that license the

Additionally, no changes in the law support reconsideration of the validity of the '398 Patent claims, and Petitioner does not identify any such change.

Furthermore, the Petition relies extensively on expert testimony (Ex. 1003) to explain the relevance of the prior art, even though witness credibility is better evaluated by a District Court than the PTAB (which typically does not consider live witness testimony). And the fact that Petitioner requires this extensive expert testimony, coupled with the fact that the Petition does not even allege any anticipatory prior art, shows that the unpatentability challenge here is not strong.

Additionally, the Patent Office has already “adjudicated the validity or patentability of the challenged patent claims” when it evaluated an *ex parte* review challenge brought against claims 1 and 2 of the '398 Patent in Application No. 90,015,284. There, the Patent Office considered the patentability of claims 1–2 over three separate grounds of unpatentability, and confirmed the validity of the claims. *See* App No. 90,015,284, Notice of Intent to Issue Ex Parte Reexamination Certificate, at 4 (USPTO, June 27, 2024) (“Claims 1 and 2 are confirmed.”).

'445 Patent's family as part of a portfolio including other Datonics, AlmondNet, and Intent IQ patents. For example, as detailed in an article published by IAM (Intellectual Asset Management), in 2013 AlmondNet, Intent IQ, and Datonics entered into “a less-than-perfect licensing deal with Google” that covered the '398 Patent family. *See* Ex. 2001 at 2. More recently, portfolio licenses including the '398 Patent and its family were granted to Microsoft and LinkedIn in June of 2024 and Roku and Samsung in June of 2025, all under confidential terms.

Accordingly, these considerations weigh heavily in favor of discretionary denial of institution. And as discussed in the following section, many of the *Fintiv* factors additionally weigh against institution.

B. *Fintiv* factors also weigh against institution.

In addition to the factors discussed above, the Board has set forth six factors for determining whether discretionary denial in light of parallel litigation is appropriate:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party;
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv I*”). In evaluating these factors, the Board “takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7-17 (PTAB May 13, 2020) (informative) (“*Fintiv II*”). As explained below, many of the *Fintiv* factors weigh in favor of discretionary denial in light of the related district

court litigation of *AlmondNet, Inc. et al. v. LiveIntent Inc.*, Case No. 24-cv-831-MN (D. Del.).

1. *Fintiv* Factor 1: The likelihood of a stay is neutral.

Fintiv Factor 1 looks to “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Fintiv I* at 5-6.

The Board ordinarily “will not attempt to predict” how a district court will proceed if a stay has not been granted (*see Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (Jun.16, 2020) (informative)). Here, not only has a stay not been granted, but LiveIntent has not even *requested* a stay. Therefore, this factor is neutral, if not weighing in favor of discretionary denial.

2. *Fintiv* Factors 2-3: Time to trial and amount of work already completed are outweighed by other factors.

Fintiv Factor 2 looks to “proximity of the court's trial date to the Board's projected statutory deadline for a final written decision.” *Fintiv I* at 5-6. *Fintiv* Factor 3 looks to “amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv I* at 9.

Here, the district court litigation in *AlmondNet Inc. et al. v. LiveIntent, Inc.*, No. 24-cv-831-MN (D. Del.) would normally have seen significant progress, given that it was originally filed on July 18, 2024. However, due to a failed motion to dismiss filed by *LiveIntent* as well as a failed counterclaim brought by LiveIntent

(which AlmondNet successfully moved to dismiss), the district court litigation in has been delayed, such that trial is not set until October 4, 2027. And in any event, even to the extent these factors do not weigh in favor of discretionary denial, numerous other factors discussed above and below do weigh in favor of discretionary denial.

3. *Fintiv* Factor 4: There is likely to be substantial overlap between this IPR and the district court proceeding.

Fintiv Factor 4 evaluates “concerns of inefficiency and the possibility of conflicting decisions” when substantially identical prior art is submitted in both the district court and the IPR proceeding. *Fintiv I* at 12. Here, all but two claims of the ’398 Patent (claims 5 and 19) are challenged such that to the extent that only two claims could even possibly be asserted in district court that are not challenged here. And in any event, to the extent Patent Owner does assert either claim 5 or 19 in the district court proceeding, this proceeding will not operate as a true alternative to the district court litigation because it will not resolve the validity of those two claims, thus reducing the potential for simplification and efficiency that *inter partes* reviews are intended to provide.

Furthermore, while Petitioner filed a stipulation asserting that “LiveIntent will not pursue in [the] related District Court Case [] (i) the specific grounds raised in IPR2025-01317, (ii) any other grounds that could have reasonably been raised before the PTAB in that instituted proceeding (i.e., any ground that could have reasonably

been raised under §§ 102 or 103 on the basis of prior art patents or printed publications), or (iii) any ground based on a combination of system prior art and the references asserted as part of a ground raised in IPR2025-01317” (Ex. 1020 at 1), the scope of Petitioner’s stipulation is not sufficient to ensure that IPR proceedings would be a “true alternative” to the District Court litigation. *See Motorola v. Stellar*, IPR2024-01205, -01206, -01297, -01208, Paper 19 at 3–4 (March 28, 2025) (Director vacating decision granting institution where the petitioner’s “stipulation does not ensure that these [inter partes review] proceedings would be a ‘true alternative’ to the district court proceeding”).

Here, Petitioner’s stipulation only warrants that it will not pursue the same grounds as those raised in this IPR proceeding (or that could have been reasonably raised in this IPR proceeding), along with combinations of unpublished system art with any of the *specific* art asserted in its petitions. Thus, the stipulation does not cover any combinations of system prior art with prior art *not* asserted in these proceedings, rendering Petitioner’s stipulation insufficient to ensure the IPR proceedings are a “true alternative” to the District Court proceedings.³

³ To be clear, Patent Owner is not suggesting that Petitioners must give up *every* validity defense in the parallel District Court proceedings in order for a *Sotera*-type stipulation to be sufficient. But here, Petitioners’ *Sotera*-type stipulation does not even cover the full scope of prior art that can be asserted during the IPR process, as their stipulation only covers combinations of the prior art *asserted in this IPR* with system prior art. Ex. 1020 at 1. Petitioners’ stipulation thus omits all other analogous art that *could* have been raised, so long as Petitioners combine them in *any* way with

Additionally, Petitioner’s stipulation still permits subsequent *ex parte* reexamination petitions on grounds that could have been raised in the Petition. Thus, Petitioner’s stipulation still allows for repeated challenges to the same patent by the same defendant in multiple venues, obviating the very purpose of the IPR process to streamline the patent system and reduce litigation costs. *See, e.g.*, H.R. Rep. No. 112-98, at 39–40 (2011) (“The legislation is designed to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.”). While the Director’s concerns in *Motorola v. Stellar* focused on concerns over the duplication between the PTAB and district court proceedings, expecting the Patent Office (through the PTAB and the Central Reexamination Unit) to hear two serial challenges to the same patent is little better.⁴

system prior art. Petitioners’ *Sotera*-type stipulation thus provides no meaningful protection against multiple validity challenges across multiple tribunals involving art that could have been raised in this proceeding.

⁴ While 35 U.S.C. § 315(e) does preclude a petitioner from filing an *ex parte* re-examination based on any invalidity grounds “which petitioner raised or reasonably could have raised,” this language does not fully protect patent owners from serial validity attacks using substantially the same prior art. As the Federal Circuit has explained, if a petitioner seeks to serially challenge a patent (i.e., by filing an *ex parte* re-examination right after conclusion of an IPR proceeding against the same patent), “[t]he burden of proving, by a preponderance of the evidence, that a skilled searcher exercising reasonable diligence would have identified an invalidity ground rests on the **patent holder**.” *See Ironburg Inventions Ltd. v. Valve Corp.*, 64 F.4th 1274, 1298-99 (Fed. Cir. 2023). Thus, petitioners may still abuse the system by withholding certain prior art during the initial IPR challenge, then filing an *ex parte* proceeding if the IPR challenge fails, forcing the patent owner to then carry the burden of proving that the petitioner could have found the additional references with reasonable diligence.

In short, if the Board were to grant institution in this proceeding, it would be considering the same claims of the '398 Patent that will be considered by the district court, and the same claims of the '398 Patent whose validity may subsequently be challenged again during any potential *ex parte* reexamination process. This is the opposite of efficiency and contravenes the very purpose of the IPR process.

Thus, *Fintiv* Factor 4 weighs in favor of discretionary denial.

4. *Fintiv* Factor 5: Petitioner is a defendant in the district court litigation.

Fintiv Factor 5 looks to “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv I* at 5-6. Specifically, when “the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Fintiv II* at 15. Here, the Petitioner is a defendant in the parallel litigation.

Thus, *Fintiv* Factor 5 weighs in favor of discretionary denial.

5. *Fintiv* Factor 6: Other considerations support discretionary denial.

Fintiv Factor 6 looks to “other circumstances that impact the Board's exercise of discretion, including the merits.” *Fintiv I* at 5-6. This factor also weighs heavily against institution for at least two reasons.

First, contrary to Petitioner’s assertions, the Petition fails to present any compelling merits of unpatentability. The Petition does not present anticipatory prior

art under §102. Instead, the Petition relies solely on obviousness §103. *See generally* Petition. Patent Owner reserves the right to highlight specific deficiencies in its POPR merit-based briefing.

Second, as discussed above, the factors discussed in the Director's March 26, 2025 Memorandum regarding Interim Processes for PTAB Workload Management weigh *strongly* in favor of discretionary denial, including the length of time the challenged claims have been in effect as well (over eleven years).

III. CONCLUSION

Patent Owner respectfully requests that the Director exercise discretion under Section 314(a) to deny institution.

Date: September 30, 2025

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CERTIFICATION REGARDING WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), Patent Owner certifies that there are 2,401 words in the paper excluding the portions exempted under 37 C.F.R. §42.24(a)(1).

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

The undersigned hereby certifies that the above document was served on September 30, 2025 by filing this document through the Patent Trial and Appeal Case Tracking System (PTACTS) as well as delivering a copy via electronic mail upon the following attorneys of record for Petitioner:

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