UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

BOE TECHNOLOGY GROUP CO., LTD.

Petitioner

v.

BISHOP DISPLAY TECH LLC

Patent Owner

Case No. IPR2025-01331
Patent No. 8,093,830

PETITIONER'S OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL REQUEST

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Other than the prosecution history, Ex. 1002, all citations to exhibits reference original page numbers found in the underlying document. Unless noted, all emphases are added.

I. INTRODUCTION

Discretionary denial is not warranted. The Petition demonstrates (and Patent Owner ("PO") has not provided any contrary argument) that each element of every claim is found in the prior art. The '830 patent never should have issued.

First, the Examiner erred by failing to identify that Nishimura (Ex. 1005) discloses the exact limitations the Examiner believed was missing to allow the '830 patent. Before allowing the '830's claims in a first action, the Examiner considered the disclosure of only six references in total—four Japanese references supplied by the Applicant and two United States references he found through his own searching. A proper search would have yielded the Nishimura reference that discloses the very limitations the Examiner mistakenly believed to be novel. These material errors outweigh any settled expectations PO has in the '830.

Second, the *Fintiv* factors do not support discretionary denial. Upon institution, BOE intends to seek to sever and stay the '830 patent from the Texas Litigation, which Judge Gilstrap has done in previous cases. There is still much work to be done in the district court, as the case is at a very preliminary stage with no case milestones occurring until after an institution decision is expected in this IPR by February 5, 2026. Indeed, a claim construction hearing is scheduled for July 20, 2026, and district court trial is scheduled for January 11, 2027. While the trial is currently scheduled the month before a final written decision is expected in this

IPR (February 5, 2027), it is unlikely the trial date will hold. Time-to-trial statistics and the fact that eight other trials are scheduled for the same day before Judge Gilstrap strongly support that the district court trial date will be pushed several months beyond the expected final written decision date. Further, this IPR challenges all claims of the '830 patent that will necessarily not be addressed by the district court in the Texas Litigation where PO asserted only claim 1. The Petition also has compelling merits that PO does not meaningfully dispute in its request.

When holistically assessing the facts, evidence, circumstances, and other considerations (detailed below), discretionary denial is not appropriate.

II. INSTITUTION IS WARRANTED IN VIEW OF THE EXAMINER'S MATERIAL ERRORS AND THE PETITION'S STRONG MERITS

Petitioner's requested *inter partes* review is a reasonable use of Board resources because it provides an opportunity to correct the erroneous allowance of the '830 patent due to the Examiner's failure to identify relevant prior art. *See Microsoft Corp. v. Partec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9 at 3 (PTAB June 12, 2025) ("Petitioner appears to show a material error by the Office and it is an appropriate use of Office resources to review the potential error."); *Oticon Medical AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15 at 19 (PTAB Oct. 16, 2019) (precedential in relevant part) (finding "error in the prosecution" where examiner failed to locate and consider relevant prior art relied on in petition). The '830 resulted from a first action allowance based on the Examiner's consideration

of only four Japanese references in applicant's information disclosure statement and two other references from his own searches over the span of an hour-and-a-half. Ex. 1002, 155-162. A proper search would have yielded prior art disclosing the limitations that the Examiner found were novel. It is in the Office's and the public's interest to correct the Examiner's failure to find this art in the first instance.

The prosecution of the '830 was minimal, and the Examiner should have found references that teach the allegedly novel limitations of the claims. The Examiner issued no rejections during prosecution and, before allowing the claims, considered only six references in total. Ex. 1002, 155-162. In the reasons for allowance, the Examiner noted that the prior art did not teach "an impedance detecting section that detects an impedance of the semiconductor light source, wherein the output voltage controlling section controls the output voltage of the voltage source based on an output of the current comparing section and an output of the impedance detecting section." Ex. 1002, 155.

However, a reasonable search shows otherwise and would have yielded the Nishimura reference (Ex. 1005) discussed in the Petition, which discloses these allegedly novel limitations. Indeed, the U.S. classification listed on the cover of Nishimura overlaps with the field of classification search listed on the cover of the '830. *Compare* Ex. 1005, code (52) (identifying classifications of 315/307), *with* Ex. 1001, code (58) (identifying the field of classification search of 315/307).

Failure to find Nishimura constitutes Examiner error that the Board should now correct. *See Oticon Medical AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15 at 19 (PTAB Oct. 16, 2019) (precedential in relevant part) (finding "error in the prosecution" where examiner failed to locate and consider relevant prior art relied on in petition).

The Examiner's searches were too narrow and therefore did not yield prior art references, like Nishimura, that teach the impedance detection concept. For example, when searching for art, the Examiner's searches always combined this concept with the other claimed concepts, including comparing detected current with a current command. Ex. 1002, 158-161 (searching in-part "(current adj command) and (current adj compar$3) and (impedance adj detect$3)" and variants thereof). These searches would have yielded references that combine these claimed features in, for example, an anticipatory reference. But the Examiner did not once search for the impedance detection concept separate from the other claimed concepts to, for example, find references that could be used in an obviousness rejection like Nishimura. This error is particularly egregious because the '830 admits that all of the concepts of the claims were known in the art except for the impedance detection concept. Pet. 12-14.

After finding the "best prior art of record" in the Suzuki reference that teaches the concepts the '830 admits were known (Ex. 1002, 155), the Examiner should have

focused his searches on a reference that teaches the impedance detection concept that he could have, for example, combined with Suzuki in an obviousness rejection. As discussed in the Petition, Nishimura discloses this concept. Pet. 30-31, 48-50, 56. For example, Nishimura discloses "**control circuitry 506**" that "estimate[s] a dynamic impedance of the LED[s]" using "acquired readings from…**current and voltage sensors**," such as by dividing voltage by current. Nishimura, 2:12-15, 2:64-3:5, 4:48-58, Claims 18, 24. The estimated impedance is then used by the control circuitry to "set the desired light intensities of the LEDs." Nishimura, Claims 18, 24.

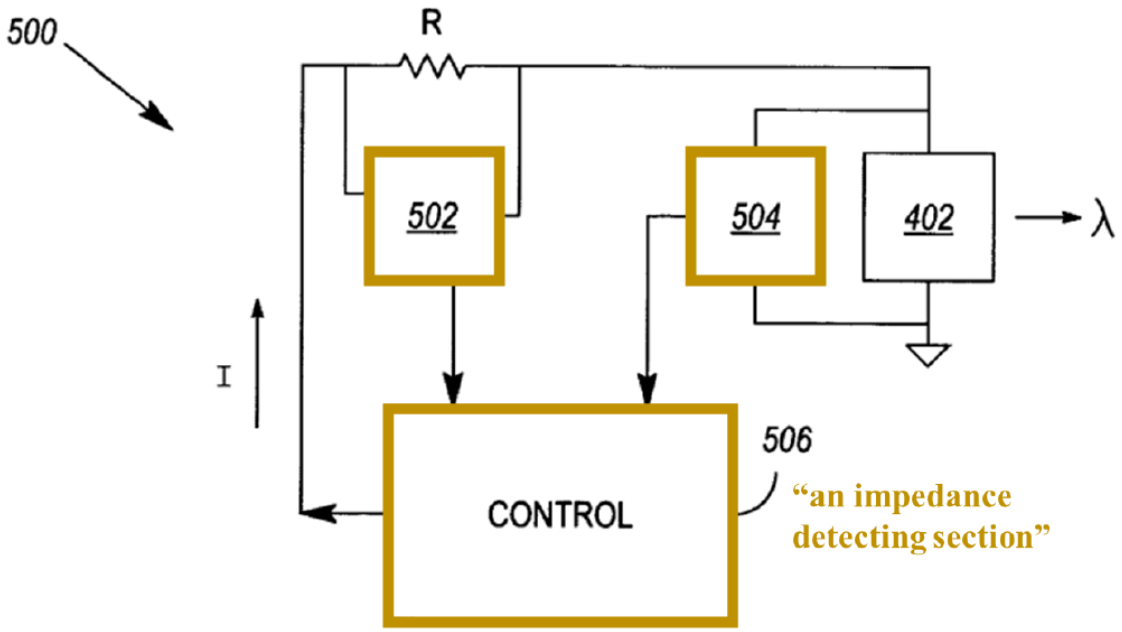

FIG. 5

Nishimura, Figure 5 (annotated). PO does not dispute these points in its Discretionary Denial Brief. The Examiner's narrow searches prevented him finding the relevant art that he could have used in an obviousness rejection.

The Examiner erred by failing to do a proper search and identify the prior art used in the Petition, and by allowing the claims based on an impedance detection limitation that was known in the art. Discretionary denial is not warranted in view of these Examiner errors. *See, e.g.*, *Carbyne, Inc. v. Tritech Software Sys.*, IPR2025-00959, Paper 11 at 2 (Director Oct. 3, 2025) (finding examiner error warrants review where a reference disclosed the limitations identified by the Examiner as novel in the reasons for allowance); *Taiwan Semiconductor Manufacturing Co. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11, at 3-4 (Director Sept. 3, 2025) (referring to the panel because "Petitioner appears to show a material error by the Office"); *Anthony Inc. v. ControlTec, Inc.*, IPR2025-00559, Paper 12, at 2 (Director July 16, 2025) (finding that petitioner's showing of material error favored referring to panel).

III. ANY SETTLED EXPECTATIONS ARE OUTWEIGHED BY THE EXAMINER'S MATERIAL ERRORS DURING PROSECUTION

PO's alleged settled expectations in the '830, which has been in force for 13 years, are not a bar to referring the Petition to the Board for a merits decision, particularly in view of the Examiner's material errors. Indeed, the Director has referred petitions to the Board where similar Examiner errors were present and the

patents had settled expectations. *See, e.g.*, *Taiwan Semiconductor*, IPR2025-00847, Paper 11, at 3-4 (Director Sept. 3, 2025) (referring to the panel because "Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error," despite a later IPR trial date reviewing a 15-year old patent); *Anthony*, IPR2025-00559, Paper 12, at 2 (Director July 16, 2025) (referring to the panel and finding that petitioner's showing of material error favored referring to panel for 17- and 18-year-old patents). The Examiner errors committed during prosecution outweigh any alleged settled expectations, and the discretionary denial request should be rejected.

Further, Petitioner disputes that it was on notice of the '830 patent since July 29, 2020 (*see* DD Req. at 18), as Petitioner no longer employed one of the recipients when the letter was received, and BOE has been unable to confirm that the other recipient, a salesperson, ever received the letter.

IV. *FINTIV* DOES NOT SUPPORT DISCRETIONARY DENIAL

A. Factor 1 (Likelihood of a Stay)

This factor is neutral given that no litigation stay has been requested and no evidence establishes how the district court would resolve such a request even if a stay were requested upon institution. As a starting point, neither party has requested a stay of the litigation. PO starts by citing various cases from the Eastern District of Texas where a motion to stay was filed in the co-pending litigation prior to institution

in the IPR and the motion was denied. DD Req. at 4-5 (citing cases). However, the critical inquiry under this factor is whether "evidence exists" regarding whether a stay will be "granted if a proceeding is instituted." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential).

PO cites no case that precludes the possibility of a stay being granted in the Eastern District of Texas after institution. On the contrary, PO acknowledges, as it must, that the Eastern District of Texas does not automatically deny stays after institution. *See* DD Req. at 5-8. Among decisions made in the Eastern District of Texas last year on motions to stay that were brought after institution, 28 percent of these motions were granted (i.e., 7 of 25 cases). Ex. 1015. To date in 2025, Eastern District of Texas has granted 33 percent of post-institution motions to stay (i.e., 7 of 21 cases). *Id*.

As stated in the Petition, BOE intends to seek to sever the '830 patent from the Texas Litigation and stay that litigation as Judge Gilstrap has done in a past case. For example, in *SEVEN Networks, LLC v. Apple Inc.*, Judge Gilstrap severed patents into "a new, separate cause of action" where IPRs were instituted for a subset of asserted patents and then stayed the severed action pending resolution of the IPRs. *See, e.g.*, Ex. 1016, Case No. 2:19-cv-115-JRG, Dkt. 313 (E.D. Tex. Sept. 22, 2020).

PO relies on inapposite trial-ready cases when arguing Judge Gilstrap routinely denies such motions. DD Req. at 8. In *Polaris Powerled Techs., LLC v.*

Samsung Elecs. Am., Inc., Judge Gilstrap denied defendant's motion to stay the case pending appeals of IPRs for a subset of patents because the case was "at a very advanced stage" with a claim construction order issued, discovery closed, summary judgment and *Daubert* motions fully briefed, a pretrial conference occurring in three weeks, and trial in two months. Case No. 2:22-cv-00469-JRG, 2024 U.S. Dist. LEXIS 218301 (E.D. Tex. Dec. 3, 2024). Similarly, in *RFCyber Corp. v. Google LLC*, Judge Gilstrap denied defendant's motion to stay pending completion of IPRs for a subset of the patents because the "case ha[d] already completed claim construction and [was] set for trial" in two months. Case No. 2:20-cv-00274-JRG, 2022 U.S. Dist. LEXIS 250095 (E.D. Tex. Jan. 4, 2022). None of these case milestones in the Texas Litigation has occurred or are even close to occurring before an institution decision is expected in early February 2026. Indeed, the claim construction hearing is set for July 30, 2026—almost six months after an institution decision is expected. Ex. 1017, 4-5.

B. Factor 2 (Parallel Trial Date)

This factor is neutral. Assuming the Board institutes, a final written decision will issue in this proceeding by February 5, 2027. Trial is tentatively scheduled to occur in the parallel district court action on January 11, 2027, less than one month before the expected final written decision date. *See* Ex. 1017 at 1. PO wrongly contends that this weighs "in favor of denying institution." DD Req. at 8. The Board

has explained that "median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides" must also be considered. USPTO March 24, 2025 Guidance on Its Recission of the "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation," at 3, https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf. This is because certain district courts—including the Eastern District of Texas where the parallel action in this case is pending—routinely schedule early trial dates that are then pushed back and delayed as the schedule progresses. Typically, it takes 26 months to reach trial in the Eastern District of Texas. *See* Ex. 1018. The complaint in the district court action was filed in March 2025. *See* Ex. 1019. Thus, it is entirely possible that the district court trial will occur as late as May 2027. This is well after the expected date of a final written decision. The Director has found that "these considerations" involving the time-to-trial statistics "neither favor nor counsel against discretionary denial." *Volkswagen Grp. Of Am., Inc. v. Longhorn Automotive Grp. LLC*, IPR2025-01064, Paper 9 at 2 (Director Oct. 10, 2025) (finding this factor as neutral where the scheduled district court trial date preceded the expected final written decision date, but the time-to-trial statistics suggested the district court trial would begin after the final written decision date); *see also Carbyne*, IPR2025-00959, Paper 11 at 2 (time-to-trial statistics

suggested a district court trial date 9 months after the expected final written decision date).

The prospect of the currently scheduled trial date being delayed is significant given that Judge Gilstrap currently has at least ***eight*** trials simultaneously scheduled to start jury selection on January 11, 2027, only one of which is the PO's litigation involving the '830 patent. *See* Ex. 1020. By advocating for discretionary denial based on the scheduled jury selection date, PO assumes without basis that Judge Gilstrap will prioritize its litigation over the other cases scheduled to begin jury selection on the same day. Even if no one of the eight cases were favored over the others, the likelihood that PO's litigation would be the one selected to start jury selection on January 11, 2027, is small—just one in ***eight***.

PO's cited cases regarding factor 2 are inapposite. DD Req. at 9-10. In *Linkplay Technology Inc. v. Sonos Inc.*, the parties agreed to a trial date before the final written decision date, and the "district court judge ha[d] indicated an intention to maintain the current trial schedule and only delay the trial schedule under extraordinary circumstances." IPR2025-00509, Paper 10 at 2 (July 31, 2025). No such indication exists here. In *NVIDIA Corp. v. Neural AI, LLC*, the time-to-trial statistics confirmed that the scheduled district court trial would precede the final written decision due date by over one month, unlike here where the statistics show the district court trial will likely happen after the final written decision due date.

IPR2025-00606, Paper 18 at 2 (Director July 31, 2025). In *Zhuhai Cosmix Battery Co. v. Ningde Amperez Technology Ltd.*, where the Director referred the petitions to the Board, there was no indication that the time-to-trial statistics would push the expected district court trial date past the final written decision due date, unlike here. IPR2025-00385, Paper 9 at 2 (Director July 2, 2025). In *Google LLC v. Cerence Operating Co.*, there was "nothing in the record indicat[ing] a trial in the District Court Litigation would not take place months before our deadline to reach a final decision," unlike here where the time-to-trial statistics show the final written decision is likely to issue first. IPR2024-01465, Paper 15 at 8-9 (Director April 23, 2025). And the Board in *EClinicalWorks, LLC v. Decapolis LLC* and *Fintiv* did not consider the median time-to-trial statistics when denying institution based on §314(a). IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022); IPR2020-00019, Paper 15 at 13.

C. Factor 3 (Investment in Parallel Proceeding)

This factor favors institution. As of the Petition's filing, PO had only served infringement contentions. As of the filing of this paper, the case has not otherwise advanced much other than Petitioner serving invalidity contentions. The parties have served and responded to a few discovery requests and disclosures, but no depositions have been scheduled or have occurred. The parties will not begin claim construction proceedings (by exchanging proposed claim terms for construction)

until late March 2026 after an institution decision is expected in early February 2026, and a claim construction order is not expected until after the claim construction hearing scheduled for July 30, 2026. Ex. 1017.

PO's assertions that there will be "substantial" investment in the Texas Litigation as of the institution decision due date (February 5, 2027) is misleading. For example, PO expects "that document production should be substantially complete by the time of the institution decision," but the case schedule sets that date for June 18, 2026, which is over four months after the institution decision due date. Ex. 1017. Indeed, as discussed, the parties will not have even commenced claim construction as of the institution decision due date, and there is not a single deadline in the court's schedule between now and the institution decision due date. Ex. 1017.

By the time an institution decision is entered in this proceeding, far more investment will remain in the litigation. This further counsels against discretionary denial. *See, e.g.*, *Am. Airlines, Inc. v. Intellectual Ventures I LLC*, IPR2025-00785, Paper 11 at 2-3 (Director Aug. 29, 2025) (finding Petitioner's "evidence that there has been little investment in the district court proceedings" as "weigh[ing] against discretionary denial"); *Nintendo Co. v. Resonant Sys., Inc.*, IPR2025-00680, Paper 18 at 2 (Director Aug. 14, 2025) (finding "there has not been significant investment by the parties in the parallel proceeding" where claim construction proceedings would not start before the institution decision due date and other case milestones

were far off). PO's only cited case supports Petitioner's position, as the parties there had already "served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs [and had a claim construction hearing], and conducted several depositions," none of which is the case here. *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3 (Director March 28, 2025).

D. Factor 4 (Overlap Between Petition and Parallel Proceeding)

This factor favors institution, which would avoid the presentation at trial of issues better decided by the Board. For example, as noted above, institution of an IPR could result in a stay of the district court case, preventing any overlap. Even without a stay, the IPR proceeding will likely conclude before trial, triggering IPR estoppel for those issues addressable in an IPR. In *Tanklogix v. Sitepro*, IPR2025-00650, Paper 10 at 2 (Director July 31, 2025), this factor weighed in favor of institution when trial was scheduled a mere 10 days after the due date for a final written decision in the related IPR. Moreover, in the unlikely event IPR estoppel does not apply because, e.g., the trial is not continued, Petitioner's *Sotera* stipulation would eliminate any risk of relitigating IPR issues in district court.

Further, this IPR challenges all claims of the '830 patent, whereas PO has asserted only claim 1 in the Texas Litigation. Thus, this IPR presents compelling

invalidity arguments that will necessarily not be addressed by the district court in the Texas Litigation, which weighs against discretionary denial.

E. Factor 5 (Whether the Parties Are the Same)

This factor does not weigh in favor of denial. Because the parties are the same, the combination of estoppel and Petitioner's *Sotera* stipulation eliminates the risk that the same invalidity theories will be raised in the IPR and in district court.

F. Factor 6 (Other Considerations)

Considerations under this factor weigh heavily against discretionary denial. As discussed above, the Petition is particularly strong because all the grounds explicitly include the element relied on by the Examiner for the reason for allowance, citing references the Examiner should have located after a reasonable search (or recognized was disclosed by the art relied upon during prosecution)—a fact that PO has not even contested substantively. *Supra* Section II.

PO argues the merits of the Petition are weak but fails to elaborate and makes no attempt to argue the merits as part of the discretionary denial process—demonstrating that PO's arguments are weak. *See Samsung Electronics Co., Ltd., v. SiONyx, LLC*, IPR2024-01431, Paper 21, at 17 (PTAB Apr. 10, 2025) ("On the present record, the merits of the Petition are strong….We emphasize that Patent Owner provides very little argument, on the merits, with regard to the Haddad138 reference."). Instead, PO attempts only to incorporate by reference its preliminary

response, which does not accord with the principles of due process as this preliminary response will not be filed until Petitioner's responsive brief is due.

Under the USPTO's guidance, PO should have at least previewed what its merits arguments might be. The Interim Director Discretionary Process states that the patent owner "should briefly explain why the merits are relevant" and "[n]otwithstanding the prohibition on incorporation by reference in 37 C.F.R. § 42.6(a)(3), when filing a brief for discretionary denial, a patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits." Interim Director Discretionary Process, §II.C.i, https://www.uspto.gov/patents/ptab/interim-director-discretionary-process. Taken together, this does not allow wholesale incorporation by reference, as PO did here. Rather, a patent owner must direct attention to what the argument and evidence will be. A contrary rule would have serious due process implications, with petitioners unable to respond to the patent owner's arguments. Therefore, any argument PO makes here regarding the merits in its potential POPR should be ignored for discretionary denial purposes.

V. THOROUGH AND FOCUSED EXPERT TESTIMONY PROPERLY SUPPORTS THE PETITION

Proper use of expert testimony here does not support discretionary denial. PO argues that Petitioner over-relies on the expert testimony of Dr. Alex Kattamis (Ex. 1003), DD Req. at 15-17, but it fails to "identify any portions of the expert testimony that suggest Petitioner is using its expert to fill gaps in the prior art." *Cambridge*

Indus. USA, Inc. v. Applied Optoelectronics, Inc., IPR2025-00434, Paper 11 at 2 (Director June 26, 2025) (referring the petition to the Board where the patent owner failed specifically identify issues with the expert testimony). There are no gaps in the prior art, and Dr. Kattamis' technical analysis discloses facts in support of his conclusions, including that the challenged claims are obvious. PO fails to identify a single limitation for which Dr. Kattamis purportedly gap-filled, and this failure dooms its argument.

Petitioners' reliance on expert evidence is entirely compliant with Federal Circuit precedent. Both *Phillips* and *KSR*, which form the foundation for claim construction and obviousness, require one to evaluate a patent and prior art from the perspective of a POSITA. Moreover, the Federal Circuit has made clear that attorney argument alone is insufficient. As such, PO's criticism of the Petition vis-à-vis Dr. Kattamis' expert declaration (Ex. 1003) is misplaced. This consideration weighs against discretionary denial.

It is well established that patent claims are construed based on the understanding of a POSITA. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) ("We have made clear, moreover, that the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art[.]"). In accordance with Federal Circuit precedent, Dr. Kattamis provides his perspective on how the prior art meets the claim terms of the '830 patent as he

understands them, with testimony supported by the required disclosure of references in accordance with 37 CFR § 42.65(a) and *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (Aug. 24, 2022) (precedential).

Furthermore, obviousness grounds are likewise evaluated from the perspective of a POSITA. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) ("If ***a person of ordinary skill*** can implement a predictable variation, §103 likely bars its patentability."), 418 ("[I]t can be important to identify a reason that would have prompted a ***person of ordinary skill*** in the relevant field to combine the elements in the way the claimed new invention does."). Here, again in accordance with Federal Circuit precedent, Dr. Kattamis provides his perspective on the obviousness of certain features claimed by the '830 patent and the obviousness of the combination of certain references, with testimony supported by the required disclosure of references in accordance with 37 CFR § 42.65(a) and *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (Aug. 24, 2022) (precedential). PO's assertion that the Petition somehow detrimentally "relies upon [Dr. Kattamis'] testimony, including attempting to plug holes by arguing that certain features not disclosed in the relied-on references would have been obvious" does not comport. DD Req. at 16.

Contrary to PO's argument that the Petition is somehow flawed because "Mr. Kattamis' [sic] declaration contains much of the same language as the Petition," DD

Req. at 16-17, the Board does "***not*** accord [expert] testimony little or no weight simply because it is verbatim to what Petitioner states in the Petition. The *Xerox* case…does not require or indicate otherwise." *Unified Patents, LLC v. Togail Techs., Ltd.*, IPR2023-00338, Paper 7, at 11 (PTAB Aug. 18, 2023); *see also Amazon.com, Inc. v. Nokia Techs. OY*, IPR2024-00691, Paper 10 at 65-66 (PTAB Sept. 24, 2024). "Rather, the critical inquiry is whether a declaration discloses underlying facts or data on which the opinion is based." *Bizlink Tech., Inc. v. Anderson Power Prods., Inc.*, IPR2024-00687, Paper 7, at 27-28 (PTAB Nov. 22, 2024). As explained above, this is exactly what the Kattamis Declaration does. The Kattamis Declaration discloses, in detail, the underlying facts (e.g., the disclosures in references, the expert's knowledge and experience, etc.) on which his opinions are based. It is unsurprising that there is overlap between the Petition and Kattamis Declaration, particularly where the Petition relies on the Kattamis Declaration and both quote and rely on specific disclosures from the references. Thus, the Kattamis Declaration is entitled to its full weight. *See Hum Indus. Tech., Inc. v. Amstead Rail Co.*, IPR2023-00540, Paper 10, at 37 (PTAB Aug. 11, 2023) ("If declaration testimony is supported sufficiently and, in turn, supports contentions in the Petition, we do not give it little to no weight simply because it is repeated in the Petition[.]").

Indeed, the cases that PO cites do not support its argument. In *Kinetic Techs., Inc. v. Skyworks Solutions, Inc.*, the Board cited the relevant law that "[E]xpert

testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight. 37 C.F.R. § 42.65(a)" and denied institution after finding that "Dr. Mohapatra's Declaration does not provide any factual basis for its assertions." IPR2014-00529, Paper 8, 14-15 (PTAB Sept. 23, 2014). Likewise, in *Xerox Corp. v. Bytemark, Inc.*, the Board found that "[w]e have reviewed this excerpt from Dr. Jones' declaration and note that it merely repeats, verbatim, the conclusory assertion for which it is offered to support" and therefore denied institution because "Dr. Jones does not cite to any additional supporting evidence or provide any technical reasoning to support his statement." IPR2022-00624, Paper 9, at 15. (PTAB Aug. 24, 2022). Here, PO does not assert that Dr. Kattamis' opinions are conclusory or not factually supported, nor can it due to the extensive citations to evidentiary support for his declaration.

VI. CONCLUSION

For the reasons set forth in the Petition and herein, *inter partes* review of the '830 patent would be an appropriate use of Board resources. Petitioner respectfully requests that the Director deny PO's discretionary denial request.

Respectfully submitted,

Dated: November 5, 2025

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Counsel for Petitioner

CERTIFICATE OF COMPLIANCE

Pursuant to §42.24(d), the undersigned certifies that the foregoing Petitioner's Opposition to Patent Owner's Discretionary Denial Request contains, as measured by the word-processing system used to prepare this paper, 4680 words and 20 pages. This word count does not include the items excluded by §42.24 as not counting towards the word limit.

Dated: November 5, 2025

/James L. Davis, Jr./
Name: James L. Davis, Jr.
Registration No. 57,325
Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on November 5, 2025, I caused a true and correct copy of the foregoing Petitioner's Opposition to Patent Owner's Discretionary Denial Request and supporting exhibits to be served via electronic mail to Patent Owner's counsel listed below:

Justin B. Kimble, justin@nelbum.com
David T. DeZern, david@nelbum.com

Dated: November 5, 2025

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