

Paper No. _____
Filed: March 11, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOLEON INC.,
Petitioner,

v.

TURTL SURF & IMMERSE LIMITED,
Patent Owner.

Case No. IPR2025-01525
Patent No. 12,118,290

**PATENT OWNER'S AUTHORIZED RESPONSE TO
REQUEST FOR DIRECTOR REVIEW**

I. INTRODUCTION

Pursuant to the Director’s email authorization dated March 4, 2026 (EX3100), Patent Owner Turtl Surf and Immerse Limited submits this response to Petitioner’s request for Director review of the institution decision (“Request,” Paper 8). The Request should be denied as procedurally improper, contrary to the Office’s practice and policy, and without merit.

II. PETITIONER FAILS TO JUSTIFY MODIFICATION OF THE INSTITUTION DECISION

Petitioner requests that the Director “modify or amend the Decision to include an entry of adverse judgment” against Turtl. Request, 1. As an initial matter, adverse judgment was not properly raised prior to the institution decision such that Petitioner preserved the issue for consideration on review. Petitioner sought authorization from the PTAB to file a motion for adverse judgment (EX3001) but overlooks that the petition was never referred to the PTAB. As the petition remained at all times under the consideration of the Director, yet Petitioner did not raise its request with the Director, the issue is not ripe for review. *See* Director Review Process 3.E. (“The Director will not consider new evidence or new arguments not part of the official record.”).¹

¹ <https://www.uspto.gov/patents/ptab/decisions/director-review-process>

Beyond that, Petitioner has not identified which of the permissible bases for review it contends apply here. *See id.*, 2.B. (Requests for Director Review ... shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.”). Director review exists to provide “a mechanism to correct errors,” but the Request does not allege an error in the institution decision. *Id.*

More substantively, Petitioner identifies no reason to apply adverse judgment under the circumstances. The cited *Arthrex* decision, at best, merely stands for the proposition that the Board or Director has discretion to enter adverse judgment, not that it is mandated. *Seaspine Holdings Corp. v. Jackson*, IPR2025-00773, Paper 8 at 2 (PTAB, Aug. 7, 2025) (“[N]either *Arthrex* or Rule 42.73(b) require the entry of adverse judgment.”). Rather, the overwhelming majority of decisions follow the approach of the precedential *General Electric* decision in denying institution without adverse judgment following pre-institution disclaimer. *General Electric Co. v. United Tech’s Corp.*, IPR2017-00491, Paper 9 at 2-3 (PTAB, July 6, 2017) (precedential); *see also, e.g., Western Digital Tech’s, Inc. v. Godo Kaisha IP Bridge 1*, IPR2024-01448, Paper 11 at 4 (PTAB, March 26, 2025) (citing *General Electric* and five other cases declining to enter adverse judgment); *Pfizer, Inc. v. Uniqure BioPharma B.V.*, IPR2020-00388, Paper 52 at 3-4 (noting “disclaimed claims are treated as if they never existed” and therefore are not

subject to adverse judgment). Indeed, “the efficient administration of the Office weighs against entering adverse judgment,” otherwise patent owners would be encouraged to litigate every AIA trial proceeding through final written decision. *Bestway (USA), Inc. v. Intex Marketing Ltd.*, PGR2024-00036, Paper 9 at 8 (PTAB, Oct. 28, 2024).

Petitioner cites *Amgen v. Bristol-Meyers* but that case only highlights why the present circumstances to not justify deviating from the typical approach. Request, 3, 6-8 (citing IPR 2025-00603, Paper 14 (PTAB, Oct. 1, 2025)). In *Amgen*, the patent owner did not dispute that it was pursuing at least one “patentably indistinct” claim through a pending continuation, of the “same or broader scope” as a disclaimed claim. *Amgen* at 3-4. Here, Petitioner can only muster an assertion that a pending continuation application is directed to “substantially the same features.” Request, 4. Comparing the tables in the Request and *Amgen*, the difference is plain. *Compare* Request, 4 *with Amgen*, 5. The best continuation claim Petitioner could identify to attack recites numerous limitations not found in disclaimed claim 10 including, for example, “setting, via a first graphical user interface (GUI), a rule associated with a first modular item of a master document,” “wherein the rule defines a condition to meet to display or hide the first modular item,” “a second GUI,” “a determination of a value of the one or more personalization parameters meeting the condition of the rule,” and “wherein

the personalized document is accessible from a uniform resource location (URL).”
Request, 4.

Even if Petitioner’s request to modify the institution decision was procedurally proper, Petitioner fails to identify a basis to deviate from the established practice. Adverse judgment is not appropriate under the circumstances of this case.

III. THE BOARD DID NOT ERR IN FINDING PETITIONER’S MOTION REQUEST MOOT

Petitioner argues the issue of adverse judgment was not moot because neither the Board nor the Director reached a decision on the issue. Request, 7. But Petitioner never raised the issue with the Director and the petition had not been referred to the Board. Petitioner’s misdirected request to the Board was thus moot at the time it was submitted via email because the Board was in no position to grant it. And it became doubly moot once the Director issued the discretionary denial decision, because the IPR was terminated at that point.

Further, even if the request for authorization to file a motion had been properly before the Board, there would have been no error in denying it on the merits, for the reasons discussed above. Neither Petitioner’s email to the Board (EX3001) nor the present request for Director review identifies any valid basis for applying a different approach than in *General Electric*, *Western Digital*, *Pfizer*,

Bestway, and ample other decisions recognizing that pre-institution disclaimer does not result in adverse judgment.

IV. CONCLUSION

Accordingly, for at least the reasons set forth above, Petitioner's request for Director review should be denied.

Respectfully submitted,

Date: March 11, 2026

/ Matthew A. Argenti /
Matthew A. Argenti, Lead Counsel
Reg. No. 61,836

V. APPENDIX -- EXHIBIT LIST

| Exhibit No. | Description |
|--------------------|--|
| 2001 | Turtl Surf & Immerse Limited, Disclaimer in a Patent under 37 C.F.R. § 1.321(a), filed January 15, 2026, with the U.S. Patent and Trademark Office regarding U.S. Patent No. 12,118,290 including Acknowledgement of Receipt |

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Patent Owner's response to Petitioner's request for Director review was served on March 11, 2026, on the Petitioner at the electronic correspondence address of the Petitioner as follows:

Ryan N. Miller
Chetan Chandra
FOX ROTHSCHILD LLP
rmiller@foxrothschild.com
cchandra@foxrothschild.com
ipdocket@foxrothschild.com

Dated: March 11, 2026

/ Matthew A. Argenti / _____
Matthew A. Argenti, Lead Counsel
Reg. No. 61,836