UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHUTTLESLIDE, LLC,
Petitioner,

v.

SEA SWIVEL INC.,
Patent Owner.

PGR2025-00089
Patent 12,258,111

PETITONER'S OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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Petitioner ShuttleSlide LLC ("Petitioner" or "ShuttleSlide") respectfully requests that the Director decline to exercise the discretionary denial requested by Patent Owner Sea Swivel Inc. ("Patent Owner" or "Sea Swivel") and institute Post-Grant Review ("PGR") of claims 1-18 ("challenged claims") of U.S. Patent No. 12,258,111 ("the '111 Patent") (Paper 1001).

I. INTRODUCTION

On September 25, 2025, Petitioner filed a petition in the Patent Trial and Appeal Board ("PTAB" or "Board") under 35 U.S.C. § 321 requesting post grant review ("PGR") of the '111 Patent (the "Petition"). (Paper 1). The Petition meets the threshold requirement of 35 U.S.C. § 324(a) and "demonstrate[s] that it is more likely than not that at least 1 of the claims challenged in the Petition is unpatentable" while no discretionary consideration weighs in favor of denying institution. Petitioner requests that the Board decline discretionary denial and institute PGR of the '111 Patent because institution will promote efficiency and resolve patentability questions uniquely suited for the Board.

II. FACTUAL AND PROCEDURAL BACKGROUND

On September 26, 2024, Patent Owner filed a patent application claiming priority to a provisional application dated September 26, 2023. Claims 1-8 and 17-20 of the patent application were directed to "a swivel mount," while claims 9-16 were directed to "a boat." (Paper 1002 at 41-46). On December 6, 2024, a

restriction/election requirement was issued, which was responded to on December 12, 2024. (Paper 1002 at 78-83 & 85-95). On January 15, 2025, pending claims 1-3 & 5-8 were allowed while pending claim 10 was found to have allowable subject matter. (Paper 1002 at 108-114). Upon incorporating the allowable subject matter of claim 10 into pending claim 9, the Patent Examiner issued a Notice of Allowability allowing pending claims 1-3, 5-9, & 11-20. (Paper 1002 at 143). The '111 Patent issued on March 25, 2025. (Paper 1001 at 1).

On August 8, 2025, a complaint was filed in the Southern District of Florida, which alleges infringement of claim 1 of the '111 Patent[1]. (Paper 2002). Expeditiously, on September 25, 2025, the Petitioner filed the Petition requesting Post Grant Review of the '111 Patent. (Paper 1). No scheduling order has been entered in the parallel proceeding and no trial date has been set. (Paper 2012 at 3). The Board's decision on whether to institute post grant review is due by April 8, 2026, which means that, absent any extensions, a final written decision in the proceeding will be due no later than April 8, 2027.

On October 24, 2025, only two and a half months after the complaint was filed, an Order Granting Petitioner's Motion to Stay the Parallel Proceeding was entered by the District Court. (Paper 2012). In support of granting the stay, the District Court found that:

[1] This complaint forms the basis of case no. 25-cv-23581-ALTMAN, currently pending and stayed in the Southern District of Florida and referred to as the "Parallel Proceeding."

- "[I]f the PTAB grants the petition, then the parties and the Court will have saved the considerable amounts of time and money that would have gone into unnecessary discovery and motions practice here in civil court." (Paper 2012 at 3).
- "[T]he IPR[2] review *could* dispose of our entire case." (Paper 2012 at 3).
- "But '[e]ven if only some of the claims are canceled [by the PTAB], those claims will not need to be litigated in this action, which will save the parties from spending more time conducting discover, researching, and briefing the issues." (Paper 2012 at 3, citing *Targus Int'l LLC v. Grp. III Int'l, Inc.*, 2021 WL 542675, at *2 (S.D. Fla. Jan. 8, 2021)).
- "[A] stay is appropriate here in view of the early stages of this litigation." (Paper 2012 at 3).
- "[D]iscovery *hasn't even begun*, and no trial date has been set." (Paper 2012 at 3, emphasis in the original).
- "In fact, we haven't even entered a scheduling order." (Paper 2012 at 3).

III. DISCRETIONARY DENIAL CONSIDERATIONS

The March 26, 2025 Interim Processes for PTAB Workload Management

[2] While the District Court refers to an IPR review, it appears from context that the Court is actually discussing the Post-Grant Review proceeding.

memorandum provides guidelines for discretionary denial of institution of AIA proceedings under 35 U.S.C. §§ 314(a) and 324(a). (Paper 2011). "[D]iscretionary considerations are enumerated in existing board precedent (including *Fintiv, General Plastic*, and *Advanced Bionic*) and the Consolidated Trial Practice Guide." (Paper 2011 at 2). "The parties are permitted to address all relevant considerations." (Paper 2011 at 2). "[I]n evaluating the 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.*, Case IPR2020-00019, Paper 11 at 6). In the present case, there are no allegations that the institution of the review will be detrimental to the integrity of the system and no factor weighs in favor of exercising discretionary denial of institution to support efficiency of the system.

A. Related Litigation

In the present case, as in *Polycom, Inc. v. DirectPacket Research, Inc.*, "[b]ecause the district court will have the opportunity to consider whether to grant a stay pending resolution of the IPR[3] while the district court litigation is still in a relatively early stage, institution here would be consistent with the AIA's objective "to provide an effective and efficient alternative to district court litigation." (*Polycom, Inc. v. Directpacket Research, Inc.*, Case IPR2019-01233, Paper 21 at 13; See *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, Case IPR2018-00752, Paper 8 at 20 (citing

[3] In fact, the district court has already granted a stay in the present parallel proceeding "until the PTAB rules on the Defendant's petition." (Paper 2012 at 4).

General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha, Case IPR2016-01357 (Paper 19) (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i))). In the Parallel Proceeding, discovery has not begun, a scheduling order has not been entered, and the proceeding is currently stayed pending the outcome of the PTAB proceeding. (Paper 2012). This contrasts with the facts of *Apple Inc., v. Fintiv, Inc*, in which trial was set for a date less than nine months from the date the order denying institution of the IPR was entered.[4] (*Apple Inc. v. Fintiv, Inc.*, Case IPR2020-00019, Paper 11 at 2). The denial of institution in *Fintiv* is easily distinguishable from the present case because the parallel proceeding in *Fintiv* was in an "advanced state" and the same issues had already been presented in that litigation prior to seeking PTAB review. (IPR 2020-00019, Paper 11 at 2.) That is not the posture in the current proceeding, which is in its infancy. In fact, due to the Parallel Proceeding being in its early stages, no *Fintiv* factor favors exercising discretionary denial of institution in the present case.

i. *Fintiv* Factor 1 – Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

"A district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplications of efforts. This fact has strongly weighed against exercising the authority to deny institution under *NHK*." (*Apple Inc.*

[4]The *Fintiv* trial was set for November 16, 2020, the order denying institution of an IPR was entered on March 20, 2020.

v. Fintiv, Inc., Case IPR 2020-00019, Paper 11 at 6). In the present case, the district court in the Parallel Proceeding has been "stayed until the PTAB rules on the Defendant's petition." (Paper 2012 at 4). In granting the stay of the Parallel Proceeding, the Court found that "if the PTAB grants the petition, then the parties and the Court will have saved the considerable amounts of time and money that would have gone into unnecessary discovery and motions practice here in civil court." (Paper 2012 at 3). Therefore, there are no concerns about creating inefficiencies or duplicating efforts by proceeding with institution because the district court proceeding has already been stayed awaiting outcome of the PTAB proceeding. This factor, as in the *NHK* case, weighs strongly against exercising discretionary denial.

ii. *Fintiv* Factor 2 - Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision

Patent Owner argues that "the district court trial date would likely be prior to the anticipated date for the [final written decision]." (Paper 6 at 3). Patent Owner's arguments related to the timing of a trial in the Parallel Proceeding are, at best, mere speculation and, at worst, intentionally misleading. In the Parallel Proceeding, "no trial date has been set," "discovery hasn't begun," the Court hasn't "even entered a scheduling order," and the proceeding is "stayed until the PTAB rules on the Defendant's petition,". (Paper 1012 at 3-4).

"If the court's trial date is at or around the same time as the projected statutory

deadline or even significantly after the projected statutory deadline, the decision whether to institute will likely implicate other factors discussed herein, such as the resource that have been invested in the parallel proceeding." (*Apple Inc. v. Fintiv, Inc.*, Case IPR2020-00019, Paper 11 at 9). In this case, due to the Parallel Proceeding being in its early stages and the fact that the proceeding is stayed, the court's trial date necessarily must be significantly after the projected statutory deadline. Therefore, this factor cannot weigh in favor of exercising discretionary denial.

iii. *Fintiv* Factor 3 - Investment in the parallel proceeding by the court and the parties

Patent Owner argues that it "has invested significantly in the parallel patent litigation" because it has prepared "multiple claim infringement charts" and "prepared and submitted a motion for preliminary injunction." (Paper 6 at 10). However, this is not the level of investment that rises to the level of weighing in favor of discretionary denial. Patent Owner's investments are necessarily minimal given the "early stage of litigation" noted by the Court in entering the stay. (Paper 2012 at 3). This *Fintiv* factor does not consider this type of rudimentary investment in litigation to weigh in favor or exercising discretionary denial. Instead, this *Fintiv* factor is directed more to the examination of investment that creates inefficiencies or duplicative efforts between the proceedings. "This investment factor is related to the trial date factor, in that more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more

advanced, a stay may be less likely, and instituting would lead to duplicative costs." (*Apple Inc. v. Fintiv, Inc.*, Case IPR2020-00019, Paper 11 at 10).

The investment cited by Patent Owner is not the type that will be duplicated by institution of the review proceeding. The *Fintiv* factor looks to what "orders related to the patent at issue in the petition" have been issued by the court. *Id.* As well as to whether "the petitioner filed the petition expeditiously." (*Apple Inc. v. Fintiv, Inc.*, Case IPR2020-00019, Paper 11 at 11). "If, at the time of the institution decision, 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 under *NHK*." (*Apple Inc. v. Fintiv, Inc.*, IPR 2020-00019, Paper 11 at 10). Because the district court has issued no orders related to the '111 Patent and the Petition was filed expeditiously, within two months of the complaint being filed, this factor weighs strongly against discretionary denial.

iv. *Fintiv* Factor 4 - Overlap between issues raised in the petition and in the parallel proceeding

Patent Owner asserts that "there is substantial overlap between the Petition and the parallel litigation, which is accentuated by Petitioner's failure to submit a *Sotera* stipulation." (Paper 6 at 11). However, Patent Owner does not provide a single example of an alleged overlap never mind "substantial" overlaps. Due to the early stage of the Parallel Proceeding, no issues related to validity of the

patents have yet been raised. Because validity arguments have not been presented in the Parallel Proceeding, it is impossible for an overlap in issues to exist. There is no concern of conflicting decisions and no need to make a *Sotera* stipulation because no arguments or evidence related to validity is present in the Parallel Proceeding. With no issues having yet been raised in the Parallel Proceeding, no overlap can exist and this factor must weigh against exercising discretionary denial.

v. *Fintiv* Factor 5 - Whether the petitioner and the defendant in the parallel proceeding are the same party

Petitioner is one of three defendants in the Parallel Proceeding. While Petitioner recognizes that if it were not a Defendant to the proceeding, this factor would weigh against exercising discretionary denial, given the early stages of the Parallel Proceeding, unity between the Petitioner and Defendant does not result in any inefficiency to the proceeding. Given that the Parallel Proceeding is in its infancy, the mere fact that the Petitioner and the Defendant are the same party does not create any inefficiency that weighs in favor of exercising discretionary denial and remains neutral.

vi. *Fintiv* Factor 6 - Other circumstances that impact the Board's exercise of discretion, including the merits

Patent Owner argues that "there are compelling interests regarding irreparable harm to Patent Owner that weight [sic] in favor of discretionary denial." (Paper 6 at 12). The district court has not found irreparable harm. The court denied the Patent

Owner's Motion for Preliminary Injunction as moot in light of the stay. (Paper 2012 at 4). No judicial finding of irreparable harm exists, and any claimed harm is speculative pending adjudication. Even if such harm did exist, it would not weigh in favor of the Board exercising is discretion to deny institution. When parties rely on "other facts and circumstances" they should explain "the impact of those facts and circumstances on efficiency and integrity of the patent system." (*Apple Inc. v. Fintiv, Inc.*, Case IPR2020-00019, Paper 11 at 16). Economic harm to the Patent Owner, which is related to the alleged underlying cause of action and not the proceeding itself, does not affect the efficiency and integrity of the patent system and is irrelevant to the Board's exercise of discretionary denial. Patent Owner provides no legal support for this alleged economic damage to a patent owner to factor in the Board's decision of whether to exercise discretionary denial. For this reason, even if such harm were to exist, it would not weigh in favor of exercising discretionary denial.

B. Real Parties-in-Interest

Patent Owner speculates, without offering any evidence, that Petitioner has not identified the real parties in interest. (Paper 6 at 13). Patent Owner speculates that a third party "would understandably 'desire review of the patent'" and posits third-party financial support without providing any evidence. (Paper 6 at 13). Such conjecture is insufficient to show nondisclosure of real parties-in-interest. Patent Owner goes on to demand "greater disclosure" from Petitioner, without citing any

legal authority for making such a demand. (Paper 6 at 13). The Petition satisfies the statutory requirement to identify real parties-in-interest. Pure unsubstantiated speculation by Patent Owner is not a basis to deny institution or compel additional disclosures.

C. Expert Testimony is Adequate

Patent Owner attacks Petitioner's expert as an "interested" witness but identifies no rule disqualifying such testimony at institution. (Paper 6 at 14). Patent Owner makes no arguments that Petitioner's expert has offered any unreliable information. Patent Owner's conclusory allegation that the testimony is flawed, is made without providing any support whatsoever. (Paper 6 at 14). Patent Owner goes on to refer to the "rule of reason" and demand that the expert testimony requires corroboration. (Paper 6 at 14). "But there are no hard and fast rules as to what constitutes sufficient corroboration, and each case must be decided on its own facts." *TransWeb, LLC v. 3M Innovative Props. Co*., 812 F.3d 1295, 1302 (Fed. Cir. 2016). The Petitioner's expert analysis cites record evidence and prior art materials. Patent Owner's generalized challenge does not demonstrate deficiency in the expert's methodology or failure to support opinions with objective exhibits. Petitioner's expert has provided strong evidence to support the merits of the Petition. In this case, reliance on an expert strengthens the merits of the Petition and weighs against exercising discretionary denial.

D. Merits of the Petition

The Petition contains invalidity arguments for every claim of the '111 Patent. In its Discretionary Denial Brief, Patent Owner makes generalized arguments that some evidence in the Petition is "weak" or non-analogous. (Paper 6 at 14-15). However, tellingly, Patent Owner does not provide arguments to refute the Petition's invalidity contentions of a single claim in the '111 Patent.

Patent Owner's criticisms of date verification and authentication are not well founded. Furthermore, the Petition presents multiple arguments for invalidity, which Patent Owner has not even argued against because it cannot.

Patent Owner's assertions about photos, timing, and alleged bias go to weight, and do not negate the references' relevance. The declarations, bill of sale, and imagery are part of a corroborative package that supports the Petition's positions.

The Petition thoroughly explains why a person of ordinary skill would look to the cited art and how combinations of presented prior art address the claim elements. Patent Owner's arguments do not rebut the substantive teachings identified in the Petition.

Patent Owner's assertion of "weakness" relies on speculative attacks rather than substantive rebuttal. Patent Owner's conclusory remarks about the insufficiency of the Petition do not weigh in favor of exercising discretionary denial. The cited references and expert analysis present at least a reasonable likelihood that one or more

challenged claims are unpatentable, favoring institution.

IV. Conclusion

Congress intended AIA proceedings to be an efficient alternative to district court litigation. This is exactly the situation where PGR is an efficient alternative to district court litigation. A PTAB decision in this case will provide a focused, expert determination on validity that can streamline the stayed district case, avoiding the very inefficiencies Patent Owner posits. Institution of this PGR would be a complete substitute for district court litigation related to validity of the patent and it would certainly narrow the issues for the district court.

The Parallel Proceeding has been stayed in deference to the PTAB's expertise on patentability. Timing and scope considerations of the Parallel Proceeding favor a PTAB merits decision. Patent Owner's economic-harm narrative is speculative and better served by clarity on validity. The real-parties challenge is also merely speculative. The expert testimony included in the Petition is proper and supported by competent admissible evidence. The prior art challenges in the Petition are substantial and reliable. For all these reasons, efficiencies gained by allowing the PTAB proceeding to be instituted weigh in favor of declining to exercise discretion to deny institution of the PGR.

Accordingly, Petitioner respectfully requests that the Director deny discretionary denial and institute PGR.

Respectfully submitted,

Date: January 8, 2026

/s/ Kelly G. Swartz

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CERTIFICATE OF SERVICE

I certify that the above-captioned **PETITIONER'S OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** was served in its entirety on January 8, 2026, upon the following parties via electronic mail:

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CERTIFICATION OF PAGE COUNT

The page count of the foregoing petition is 20 pages or less, not including the case caption/heading, Table of Contents, Table of Authorities, Certificate of Service, Certificate of Page Count, and List of Exhibits, which does not exceed the page count limit.

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