

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 No. 12,258,111

**PETITIONER'S SUR-REPLY TO PATENT OWNER'S REPLY TO
PETITIONER'S RESPONSE TO PATENT OWNER'S DISCRETIONARY
DENIAL BRIEF**

Mail Stop: PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
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Petitioner ShuttleSlide LLC hereby replies to Patent Owner's Reply to Petitioner's Response to Patent Owner's Discretionary Denial Brief. (Paper No. 9).

Patent Owner's arguments in support of denying institution of post grant review ("PGR") misrepresent the weight to be given to a *Sotera* type stipulation in the determination of whether or not to institute review. "This determination is based on the totality of the evidence and arguments the parties have presented." *Phison Electronics Corp., v. Vervain, LLC*, Case No. PGR2025-00010, Paper 14 at 2 (July 10, 2025).

Patent Owner argues that "[t]he 'absence of such a stipulation tips the balance in favor of discretionary denial.'" (Paper No. 9 at 2, quoting *Phison*, Paper No. 14 at 3). Patent Owner's choice to omit a key portion of the language of *Phison* creates a misleading interpretation. The full language from the relevant portion of *Phison*, in reference to the fact that "the challenged patents have not been in force for a significant period of time," states:

Ordinarily this might favor referral to the Board; however, Petitioner has not offered a stipulation *to address concerns of duplicative efforts and potentially conflicting decisions in view of a significantly earlier trial date in a co-pending case that is unlikely to be stayed*. The absence of such a stipulation tips the balance on favor of discretionary denial.

Phison, Paper No. 14 at 3, emphasis added. *Phison* goes on to state "the determination to exercise discretion to deny institution is based on a holistic assessment of all the evidence and arguments presented." *Id.*

It is only because there was “a significantly earlier trial date in a co-pending case that is unlikely to be stayed” that there were “concerns of duplicative efforts and potentially conflicting decisions” in *Phison*, which created a need for the stipulation. *Id.* The parallel litigation in the present case was stayed at a very early stage, eliminating the concerns that were present in *Phison* and, thereby, the need for any stipulation. Furthermore, the ‘111 Patent has been in force less time than the patents at issue in *Phison*¹, weighing in favor of institution. *Id.* Contrary to Patent Owner’s arguments, *Phison* supports instituting review of the ‘111 Patent.

Patent Owner goes on to cite an October 17, 2025 Notice of Proposed Rulemaking directed to institution of inter partes review (“IPR”) and urges applying the proposed IPR rule to this PGR proceeding. Patent Owner’s reliance on proposed rulemaking is misplaced. Proposed rules do not bind the Board and cannot retroactively impose a dispositive stipulation requirement. The Board should continue to apply the established totality-of-the-circumstances framework.

The Board should reject Patent Owner’s attempt to convert a helpful mitigation tool into a categorical threshold for institution. Existing precedent confirms that stipulations may mitigate overlap concerns; it does not transform the absence of a stipulation into a per se bar. The totality of circumstances supports institution.

¹ The ‘111 Patent was issued on March 25, 2025, less than ten months ago. The patents at issue in *Phison* were all issued more than fourteen months prior to the decision denying institution of review.

Respectfully submitted,

Date: January 16, 2026

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CERTIFICATE OF SERVICE

I certify that the above-captioned **PETITIONER'S SUR-REPLY TO PATENT OWNER'S REPLY TO PETITIONER'S RESPONSE TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** was served in its entirety on January 16, 2026, upon the following parties via electronic mail:

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CERTIFICATION OF PAGE COUNT

The page count of the foregoing Sur-reply is 2 pages or less, not including the case caption/heading, Certificate of Service, and Certificate of Page Count, which does not exceed the page count limit.

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