

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TERUMO BCT INC.,

Petitioner

v.

HAEMONETICS CORP.,

Patent Owner

IPR2026-00045
U.S. Patent No. 10,980,934

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

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EXHIBIT LIST

Exhibit Number	Description
1001	U.S. Patent No. 10,792,934 (“’934 patent”)
1002	File History of the ’934 patent
1003	Declaration of Dr. Gary D. Fletcher in Support of Petition
1004	U.S. Patent No. 4,898,675 (“Lavender”)
1005	“Calculations in Apheresis” (“Neyrinck”)
1006	U.S. Patent No. 7,072,769 (“Fletcher-Haynes”)
1007	U.S. Patent Publication No. 2011/0097344 (“Darashkevich”)
1008	“Membrane versus centrifuge-based therapeutic plasma exchange: a randomized prospective crossover study,” Carsten Hafer et al., <i>Int. Urol. Nephrol</i> (2016) 48:133-138; Springer Science+Business Media Dordrecht 2015.
1009	“Volume Limits – Automated Collection of Source Plasma,” November 4, 1992, Memorandum issued by the FDA Center for Biologics Evaluation and Research, Docket Number FDA-2013-S-0613.
1010	Bruce C. McLeod, MD, et al., “Apheresis: Principles and Practice,” 3rd Edition, AABB Press 2010.
1011	Sergent SR, Ashurst JV. Plasmapheresis. [Updated 2023 Jul 10]. In: StatPearls [Internet]. Treasure Island (FL): StatPearls Publishing; 2025 Jan-. Available from: https://www.ncbi.nlm.nih.gov/books/NBK560566/?report=printable
1012	Japanese Patent Publication No. JP 2002-282352 A and certified Japanese to English translation (“Takagi”)
1013	Curriculum Vitae (“CV”) of Dr. Gary D. Fletcher
1014	Search Disclosure Declaration (Filing Party and Board Only)
1015	Redacted Search Disclosure Declaration
1016	U.S. Patent No. 10,758,652 (“’652 patent”)
1017	PTAB Notice of Decisions on Institution, Dec. 11, 2025
1018	PTAB Notice of Decisions on Institution, Jan. 9, 2026

I. INTRODUCTION

Discretionary denial of Terumo BCT, Inc.'s ("Terumo") Petition for *inter partes* review ("IPR") of U.S. Patent No. 10,980,934 ("the '934 patent") is not warranted for at least three reasons.

First, Haemonetics Corporation ("Haemonetics" or "Patent Owner") could not have developed settled expectations in the '934 patent, as it issued less than five years ago. This is confirmed by the fact that U.S. Patent No. 10,758,652 ("the '652 patent"), which issued only five years ago, survived discretionary denial consideration. EX1016; EX1017. Further, three other patents in the '934 patent's family that are also at issue in the parallel district court case—*Haemonetics Corp. v. Terumo BCT, Inc.*, Case No. 1:25-cv-01409-RMR-SBP (D. Colo. filed May 5, 2025) (the "District Court Litigation") survived discretionary denial. EX1017; EX1018. Moreover, Patent Owner's ongoing efforts to file additional patent applications within the '934 patent's family and Patent Owner's filing of not one, but two, amended complaints in District Court Litigation establish that there are no settled expectations in the '934 patent.

Second, every factor outlined in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) ("*Fintiv*") weighs strongly against discretionary denial or is neutral. Significantly, as Patent Owner concedes, any district court trial is unlikely to occur until well over a year after a final written decision ("FWD").

Third, Petitioner's submission of a compliant Search Disclosure Declaration (SDD) provides for a non-exclusive, non-dispositive favorable discretionary factor supporting institution.

Accordingly, Terumo respectfully submits that the Director deny Patent Owner's request for discretionary denial.

II. LITIGATION BACKGROUND

A. The District Court Litigation

On May 5, 2025, Patent Owner initiated the District Court Litigation, asserting that Terumo's Rika System infringed seven of its patents, including the '934 patent. Since then, Patent Owner has filed two amended complaints, bringing the total number of asserted patents to nine (collectively, "the Asserted Patents"). No significant docket activity occurred before Patent Owner filed the Second Amended Complaint.

To date, the district court has not invested significant resources in the case, and the case is far from reaching substantive milestones. Discovery began a month after the Second Amended Complaint was filed. While initial infringement and invalidity contentions have been served, the Parties have not yet engaged in significant discovery, with Patent Owner producing only 395 documents, many of which are duplicates. *See* EX2009 at 9. Claim construction briefing will not begin until March 2026, and the claim construction hearing will not occur until at least

May 2026. *Id.* Given that the claim construction order will set the deadlines for the close of fact and expert discovery, it is not expected that discovery will close before early 2027. *See id.* Further, and as Patent Owner recognizes, trial is unlikely to occur before mid-2028, at the earliest. Paper 9 at 7.

On November 7, 2025, Terumo moved to stay the District Court Litigation until all *inter partes* review (“IPRs”) and PGRs are resolved—a request that is likely to succeed and push the trial date back even further. *See* District Court Litigation, Dkt. 65. Even if not stayed, however, the case remains in the early stages.

B. This IPR Proceeding

Terumo also acted diligently in filing this IPR. Patent Owner did not allege that Terumo infringed the ’934 patent until October 2024. Seven months later, Patent Owner initiated the District Court Litigation. On October 24, 2025, about a year after first learning of any potential infringement of the ’934 patent and less than 6 months of the District Court Litigation being filed—and approximately a month after infringement contentions were served in the District Court Litigation—Terumo timely and diligently filed IPR2026-00045 among eight other post-grant procedures challenging 238 total claims, four of which have already survived discretionary denial considerations. *See Cellco P’ship v. Huawei Device Co., Ltd.*, IPR2020-01117, Paper 10 at 22 (P.T.A.B. Feb. 3, 2021) (crediting Petitioner’s diligence in

filing the Petition less than three months after being served infringement contentions in the parallel case); EX1017; EX1018.

III. DISCRETIONARY DENIAL IS INAPPROPRIATE UNDER 35 U.S.C. § 314(a)

A. Patent Owner Has Not Established Settled Expectations

Patent Owner argues that it had settled expectations in the '934 patent and that these expectations weigh in favor of discretionary denial. Paper 9 at 2-5. It does not, and they do not. Not only is neither claim true, but the Board has already considered the very arguments Patent Owner raises here when assessing whether discretionary denial was warranted in an IPR challenging the '652 patent. *See Terumo BCT, Inc. v. Haemonetics Corp.*, IPR2025-01391, Paper 7 at 4–7, 9 (P.T.A.B. Oct. 24, 2025); EX1017. After reviewing Patent Owner's arguments there, the Board reached the correct conclusion that discretionary denial was not warranted. The Board should reach the same conclusion here.

Settled expectations are based on how long a patent has been in force and whether that length of time provides expectations that the patent's validity will not be challenged. Here, the '934 patent has only been in force for less than five years, which is too short a time for Patent Owner to have developed settled expectations. EX1001, cover; *See Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11 at 2-3 (P.T.A.B. June 26, 2025) (finding no settled expectations on three patents that were in force for six years or less); *Berkshire*

Hathaway Energy Co. v. Birchtech Corp., IPR2025-00274, Paper 23 at 3 (P.T.A.B. July 2, 2025) (same). Moreover, the '934 patent's family remains active with continuing applications still pending. This activity is evidenced by Patent Owner's filing of multiple amended complaints in the District Court Litigation to add two newly issued patents. Patent Owner cannot credibly assert settled expectations when the contours of the patent family are still evolving. Accordingly, the Board should find that Patent Owner has no settled expectations in the '934 patent.

In arguing otherwise, Patent Owner raises three main points: (1) that Patent Owner had settled expectations based on the '934 patent's 2021 issuance; (2) that Terumo was allegedly aware of the '934 patent since 2020 when Patent Owner began marking its commercialized product; and (3) that Terumo was put on notice a year before the Petition was filed. Paper 9 at 2-5. As the Board already found, these arguments lack merit and fail to establish settled expectations.

First, Patent Owner relies on inapposite cases to argue that the '934 patent's 2021 issuance creates settled expectations. For example, while the Board in *WebGroup Czech Republic, A.S. v. DISH Techs. LLC*, IPR2025-00467, Paper 14 (P.T.A.B. July 16, 2025) denied instituting an IPR challenging a patent issued in 2023, that patent was one of four being challenged in concurrent IPRs, some of which had "already been the subject of multiple proceedings," which weighed in favor of discretionary denial. *Id.* at 2-3. Likewise, Patent Owner's reliance on

Milwaukee Elec. Tool Corp. v. Klein Tools, Inc., IPR2025-00724, Paper 14 (P.T.A.B. Sept. 12, 2025) is also unfounded. There, the Board expressly found that Patent Owner “ha[d] not developed strong settled expectations that favor discretionary denial” in patents that issued in 2022, 2023, and 2025 and relied on the patents’ involvement in an investigation before the U.S. International Trade Commission as a reason for discretionary denial. *Id.* at 2-3. Lastly, in *Samsung Elecs. Co. v. Genghiscomm Holdings LLC*, IPR2025-00793, Paper 12 (P.T.A.B. Aug. 22, 2025), the Board issued a discretionary denial because the challenged patents were also involved in a district court case scheduled for trial six months before any final written decision would issue. That is not the case here, where any district court trial would be over a year after any final written decision.

Second, Patent Owner’s argument relying on commercialization and marking of Patent Owner’s products merely amount to simple, unsupported, conjecture. Paper 9 at 3-4. That Patent Owner marked its product with U.S. 10,792,416 (“the ’416 patent”) does not give notice of a different patent—the ’934 patent. This is especially true because the ’934 Patent did not issue until 2021, after the ’416 patent.¹ Patent Owner’s suggestion that it had settled expectations in the ’934 patent

¹ If Patent Owner meant to suggest that it marks its products with the ’934 patent, it does not. EX2003 only references the ’416 patent.

before it issued borders on the absurd, and similar settled expectations arguments made with respect to other, newer patents in the '934 patent family have been rejected. *See* EX1018. In addition, Patent Owner's high-level identification of expenses and investment in commercializing its technology is wholly untethered to the claims of the '934 patent. Nowhere in its brief does Patent Owner establish that any of the cited expenditures directly relate to the '934 patent. Without any nexus to the challenged patent, Patent Owner has failed to establish how its investments establish settled expectations in its less-than five-year old patent. Moreover, Patent Owner cites *Empower Clinic Servs., L.L.C. v. Eli Lilly & Co.*, which is inapposite to this proceeding because, while the Board found that continued investments in drugs embodying the claimed technology supported settled expectations, the challenged patent had issued nearly *nine years* prior. *Empower Clinic Servs., L.L.C. v. Eli Lilly & Co.*, IPR2025-01024, Paper 15, at 2 (P.T.A.B. Oct. 10, 2025). The '934 patent has only been in force for less than five years and, thus, Patent Owner's arguments are unavailing. As established in Patent Owner's own cited case, discretionary denial for settled expectations was only warranted for IPRs challenging patents issued six and seven years earlier, not for IPRs challenging newer patents. *See Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9 at 2-3 (P.T.A.B. July 24, 2025).

Patent Owner's argument that it has settled expectations because Terumo knew it was entering an industry protected by patents (Paper 9 at 4) also fails because

not only is there no evidence that Terumo knew of the '934 patent when it entered the industry, but its knowledge of Patent Owner's commercial system does not establish that Terumo should have challenged Patent Owner's patents sooner. As Patent Owner recognizes, Terumo's FDA 510(k) statements refer to the NexSys PCS® Plasma Collection System with Persona® (EX2004; EX2005) as a "Reference" device, which may be different from the submitted product. *See, e.g.*, EX2004 at 2. Patent Owner also cites *Dabico Airport Sols. Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (P.T.A.B. June 18, 2025) to support its argument that Terumo should have been aware of the '934 patent when it entered the industry in 2022. Paper 9 at 4. But while *Dabico* noted that actual notice is not required to create settled expectations, there the patent had been in force for almost eight years, not the less than five at issue here, and the Petitioner was faulted for not explaining why an IPR would be an appropriate use of resources. *Id.* at 3. That is not the case here, where the challenged patent has been in force for less than five years, and where an IPR would be an appropriate use of Board resources as Patent Owner asserts nine patents in the District Court Litigation, all of which are challenged in IPRs or PGRs pending before the Board.

Third, Terumo's awareness of the '934 patent in October 2024 (EX2007) does not establish settled expectations as Terumo filed its Petition about a year later and less than six months of the litigation being filed. Patent Owner's reliance on *Geotab*

Inc. v. Fractus, S.A., IPR2025-00928, Paper 11 (P.T.A.B. Sep. 12, 2025) is also misplaced. There, the patent owner had raised the patent at issue with petitioner **four years** earlier and had been in discussions with petitioner about the challenged patent during the four-year period before the IPR was filed. *Id.* at 2-3. That is not the case here.

Accordingly, for all the above reasons, Patent Owner has no settled expectations in the '934 patent, and discretionary denial is not warranted.

B. The *Fintiv* Factors Do Not Support Discretionary Denial

1. The District Court Will Likely Grant a Stay

The first *Fintiv* factor asks “whether evidence exists that [a stay] may be granted if a proceeding is instituted.” *Fintiv, Inc.*, IPR2020-00019, Paper 11 at 12. Patent Owner acknowledges that Terumo moved to stay the District Court Litigation but ignores that case law and statistics overwhelmingly support a stay. *See* Paper 9 at 5-7. Before issuing a stay, district courts consider (1) whether a stay will simplify the issues in question and streamline the trial; (2) whether discovery is complete and whether a trial date has been set; (3) whether a stay would unduly prejudice the nonmoving party or present a clear tactical advantage for the moving party; and (4) whether a stay will reduce the burden of litigation on the parties and on the court. *See eSoft, Inc. v. Blue Coat Sys., Inc.*, 505 F. Supp. 2d 784, 787 (D. Colo. 2007).

Here, invalidity proceedings before the PTAB would simplify the issues in

the District Court Litigation. While Patent Owner laments the volume of Terumo's invalidity contentions in the District Court Litigation, *see* Paper 9 at 8, any burden is of Patent Owner's own doing, as it decided to bring a nine-patent case with over 230 asserted claims despite knowing that the litigation is too large and will need to be narrowed. *See* District Court Litigation, Dkt. 67, at 2. Accordingly, the district court will likely grant a stay for the Board to narrow the scope of the dispute.

Further, discovery in the District Court Litigation is at its infancy and a trial date has not been set. The parties have just begun fact discovery, there is no fact or expert discovery deadline, and no depositions have been noticed or scheduled. The court has not expended any resources on discovery because the parties have not raised any disputes with the court. Additionally, the parties have only exchanged preliminary terms for construction. *See* EX2009. Further, and contrary to Patent Owner's characterization of the timing of the claim construction hearing, the Board will have issued institution decisions in eight of the nine IPR and PGR proceedings prior to the hearing. With respect to the remaining PGR proceeding, the PTAB's institution decision is scheduled for May 13, 2026, which may occur before the claim construction hearing occurs as no date for the hearing has been set.

Despite all this, Patent Owner asserts "[t]here is no reason to believe the district court will stay the litigation pre-institution" because the District of Colorado grants stays "in only 69% of cases." Paper 9 at 5–6. But Patent Owner's statistic is

“persuasive evidence that a stay will be granted”—not a “speculative” or “remote” possibility. *Twitch Interactive, Inc. v. RazDog Holdings LLC*, IPR2025-00307, Paper 18 at 2 (P.T.A.B. May 16, 2025); *Imperative Care, Inc. v. Inari Med., Inc.*, IPR2025-00289, Paper 9 at 2 (P.T.A.B. June 12, 2025) (citing *id.*, Paper 8 at 7-9).

Further, while Patent Owner may not be convinced by District of Colorado’s 69% grant rate, that probability increases when looking at the judges presiding over the District Court Litigation. Magistrate Judge Prose, who will hear the Motion, has granted a motion to stay pending post-grant proceedings, at least in part, in 100% of the cases where the question was presented.² See *Downing Wellhead Equip., LLC, v. Intelligent Wellhead Sys., Inc.*, No. 1:23-cv-01180-RMR-SBP (D. Colo. Feb. 14, 2024). This includes when the proceedings had not yet been instituted. See *id.* Judge Rodriguez adopted the magistrate’s recommendation and stayed a case pending IPR in the one instance where the request was raised. See *Downing Wellhead Equip., LLC v. Intelligent Wellhead Sys., Inc.*, No. 1:23-cv-01180-RMR-SBP (D. Colo. Oct. 21, 2024).

² In the one case where it was granted in part, some third-party discovery was allowed to continue. *Downing Wellhead Equipment, LLC v. Intelligent Wellhead Sys., Inc.*, No. 1:23-cv-01180-RMR-SBP, Dkt. 65, at 22 (D. Colo. Feb. 14, 2024). Here, no party has begun third-party discovery.

Accordingly, and contrary to Patent Owner's assertions and cited cases (Paper 9 at 5–6), there is sufficient evidence that the Court is likely to stay the District Court Litigation, the risk of this proceeding and the District Court Litigation proceeding in parallel is minimal, and thus this factor weighs against discretionary denial.

2. The 2028 Trial Date Weighs Against Denial

The second *Fintiv* factor assesses the “proximity of the court’s trial date to the Board’s projected statutory deadline for a written decision.” *Fintiv, Inc.*, IPR2020-00019, Paper 11 at 12.

Patent Owner concedes that the final written decision for this proceeding is projected to issue in April 2027, and no trial date has been set in the parallel District Court Litigation. *See Twitch Interactive, Inc.*, IPR2025-00307, Paper 18 at 2-3 (denying request for discretionary denial where there was no scheduled trial date); *Imperative Care, Inc.*, IPR2025-00289, Paper 9 at 2 (same). As Patent Owner acknowledges, the median time-to-trial statistics in the District of Colorado indicate trial is unlikely to occur before June 2028, which is over a year after the FWD would issue. Paper 9 at 7–8.

Because *Fintiv* Factor Two weighs strongly in favor of Terumo, Patent Owner points to *Murata* and *Hisense* to argue that this factor is not dispositive. Paper 9 at 7–8. But both *Murata* and *Hisense* are inapposite. In both *Murata* and *Hisense*, the Board recognized that the likelihood that a FWD would issue before the district court

trial occurred counseled against discretionary denial. *Murata Mfg. Co. v. Georgia Tech Rsch. Corp.*, IPR2025-00383, Paper 14 at 2 (P.T.A.B. July 29, 2025); *See Hisense USA Corp. v. VideoLabs, Inc.*, IPR2025-00880, Paper 11 at 2 (P.T.A.B. Oct. 10, 2025). Despite that, in both cases, the Board relied on settled expectations in patents that had issued *sixteen* years (*Murata*) and *eleven and twelve* years (*Hisense*) prior to support discretionary denial. *See Murata Mfg. Co.*, IPR2025-00383, Paper 14 at 2; *Hisense USA Corp.*, IPR2025-00880, Paper 11 at 2. Here, however, Patent Owner has failed to establish settled expectations in the '934 patent. Thus, there is no countervailing factor to offset the fact that this proceeding's FWD date strongly supports institution.

Moreover, as Terumo has challenged all nine of the Asserted Patents, the Board is uniquely positioned to best resolve these disputes due to the complexity and numerosity of the Asserted Patents and invalidity grounds. *See Samsung Elecs. Co. Ltd. v. Wilus Inst. of Standards & Tech. Inc.*, IPR2025-00933, Paper 11 at 3 (P.T.A.B. October 10, 2025).

In sum, the projected timing of trial well after the Board's decision weighs strongly against discretionary denial and support institution.

3. Minimal Investment in the District Court Favors Institution

The third *Fintiv* factor assesses the "investment in the parallel proceedings by the court and the parties." *Fintiv, Inc.*, IPR2020-00019, Paper 11 at 13. "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.” *Id.* at 9-10 (emphasis added).

Here, the District Court has not issued any orders specifically related to the '934 patent. In fact, despite the fact that the District Court Litigation has been pending for eight months, the parties and Court have not significantly invested in it. While Terumo has filed a Partial Motion to Dismiss in the District Court Litigation, Terumo has not yet answered the Second Amended Complaint, discovery has just begun, and the District Court's resources have been focused primarily on rote case-management issues.

Patent Owner's argument that the case is far along enough to warrant discretionary denial is not supported by Board precedent. Initial invalidity contentions were just served and responded to, the parties exchanged claim construction terms less than three weeks ago, and the parties will not have completed the claim construction process by this institution deadline. EX2000 at 8–9. Moreover, while Patent Owner alleges that the parties will have completed all *Markman* briefing in May of 2026, *see* Paper 9 at 8–9, no *Markman* hearing has been scheduled and there are no set deadlines for the close of fact or expert discovery, and both will likely be ongoing when any FWD issues. *See Cambridge Indus. USA, Inc.*, IPR2025-00434, Paper 11 at 1, 3 (denying discretionary denial with respect to three patents

because parallel litigation that did not have a trial date or even a *Markman* hearing scheduled). This factor favors institution.

Despite Patent Owner's arguments to the contrary, in similar situations where the most burdensome parts of the case lie ahead, the Board has found that this factor weighs against discretionary denial. For example, the Board has found parallel proceedings still in early stages when there has been no order on the patents in the petition. *See Fintiv*, IPR2020-00019, Paper 11 at 10 n.18 (first citing *Facebook, Inc. v. Search and Social Media Partners, LLC*, IPR2018-01620, Paper 8, at 24-25 (P.T.A.B. Mar. 1, 2019) and then citing *Amazon.com, Inc. v. CustomPlay, LLC*, IPR2018-01496, Paper 12, at 8-9 (P.T.A.B. Mar. 7, 2019)). In fact, the Board recently denied a discretionary denial request on a petition filed after the parties had exchanged infringement and invalidity contentions, and when claim construction was in its preliminary phase. *See e.g., Samsung Elecs. Co. Ltd., v. Wilus Inst. of Standards and Tech. Inc.*, IPR2025-01164, Paper 7, at 16 (P.T.A.B. October 14, 2025); *id.*, Paper 11 at 5.

Additionally, while Patent Owner laments the volume of Terumo's invalidity contentions in the District Court Litigation, any burden is Patent Owner's own doing as Patent Owner decided to bring a nine-patent case with over 230 asserted claims despite knowing that its assertions would need to be narrowed. Paper 9 at 8; District Court Litigation Dkt. 67, at 2. Furthermore, the court will not be responsible for

evaluating invalidity contentions until such time as the contentions have been finalized. To that end, invalidity proceedings before the PTAB would undoubtedly simplify the issues in the parallel litigation because the PTAB would narrow the vast assertions before they reached the District Court.

At base, the litigation remains in early procedural stages and the most burdensome parts of the case lie ahead. Accordingly, this factor favors institution.

4. Terumo's *Sotera* Stipulation Eliminates Overlap and Supports Institution

The fourth *Fintiv* factor assesses the “overlap between the issues raised in the petition and in the parallel proceeding.” *Fintiv, Inc.*, IPR2020-00019, Paper 11 at 12. While Patent Owner asserts that Terumo's *Sotera* stipulation is not dispositive, the Board has consistently found that a broad stipulation weighs strongly against discretionary denial when considered alongside other factors. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (P.T.A.B. Dec. 1, 2020) (precedential); *Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00217, Paper 9 at 2–3 (P.T.A.B. June 13, 2025); *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc. et al*, IPR2025-00531, Paper 10 at 3 (P.T.A.B. July 17, 2025).

Patent Owner's cited cases do not establish otherwise. Paper 9 at 9 (citing *Ericsson Inc. v. Procomm Int'l Pte. Ltd.*, Paper 15, IPR2024-01455 (P.T.A.B. May 16, 2025), and *ARM Ltd. v. Daedalus Prime LLC*, Paper 14, IPR2025-00207 (P.T.A.B. Aug. 6, 2025)). In those cases, the Board found other factors—like

advanced litigation posture or lack of strong merits—tipped the balance. Here, Terumo’s stipulation is accompanied by strong merits, minimal district court investment, and no scheduled trial date. In this context, the stipulation strongly supports institution.

5. Identical Parties

The fifth *Fintiv* factor assesses the “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv, Inc.*, IPR2020-00019, Paper 11 at 13. Patent Owner notes that the parties are the same. Paper 9 at 9. This factor is neutral and expected in parallel proceedings. It does not weigh against institution.

6. The Petition Presents Strong Merits

The sixth and final *Fintiv* factor assesses “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv, Inc.*, IPR2020-00019, Paper 11 at 13. Discretionary denial is unwarranted considering the strong merits of the unpatentability grounds set forth in the Petition, consistent with the Director’s *Interim Processes for PTAB Workload Management*. EX2001 at 2. Here, the Petition’s merits are not only strong—they are compelling. The challenged claims recite well-known techniques, and the prior art references teach or suggest each limitation. While Patent Owner attempts to argue otherwise, its arguments fall short.

Patent Owner’s Request for Discretionary Denial provides no substantive arguments attacking the grounds or prior art in the Petition, despite having done so

in its Requests for Discretionary Denial in related IPRs and PGRs. Indeed, while Patent Owner's brief duplicates its brief challenging the '416 petition, which contains similar prior art grounds attacking similar claim limitations, Patent Owner stripped out the bulk of its merits arguments under the sixth *Fintiv* Factor. *Compare* Paper 9 with IPR2025-01420, Paper 11. The result is that Patent Owner's arguments hinge on purported deficiencies in Dr. Fletcher's declaration, its primary contention being that it is duplicative of the Petition. Paper 9 at 10–11. But while the Petition and the declaration cite the same specific disclosures that prove the '934 patent is invalid, and thus have textual overlap, this overlap is neither improper nor conclusory. Patent Owner's failure to substantively engage with the asserted prior art combinations weighs in favor of institution.

IV. PETITIONER'S SDD MERITS FAVORABLE CREDIT SUPPORTING INSTITUTION

Patent Owner's argument that petitions must not rely upon patents or patent publications to earn favorable discretionary credit is not found in the Director's SDD memorandum. *Compare* Paper 9 at 11–12 *with* EX2012 at 1-2. Petitioner's SDD merits favorable credit supporting institution, as it discloses the databases and repositories in which the prior art was located, the general search approach, other analytics or publicly accessible resources consulted, the amount of time spent on the search, and the amount of time reviewing search results. *Compare* EX2012 *with* EX1014 *and* EX1015. Nevertheless, the paper art Petitioner used in its Petition is

the result of a search strategy that differs from the USPTO's search methods and thus merits additional credit for revealing "new or underutilized pathways relevant to Office search practice." *See* EX2012; EX1014; EX1015.

V. CONCLUSION

For the above reasons, Terumo submits discretionary denial is not warranted.

Date: January 29, 2026

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL was served on January 29, 2026 by filing this document through the P-TACTS platform as well as by delivering a copy via the delivery method indicated to the attorneys of record for the Patent Owner as follows:

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