

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORP.
and
KIA CORPORATION,

Petitioners,

v.

EMERGING AUTOMOTIVE LLC,
Patent Owner.

Case PGR2026-00008
U.S. Patent No. 12,337,715

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

TABLE OF CONTENTS

I. INTRODUCTION 1

II. BACKGROUND 2

 A. Innovations of U.S. Patent No. 12,337,715..... 2

 B. Related and Parallel Litigation Proceedings 3

III. THE DIRECTOR SHOULD DENY INSTITUTION..... 4

 A. Petitioners’ Inconsistent Claim Construction Positions—
 Disavowing District Court Constructions for “e-Key”
 and “Privileges”—Demonstrate Discretionary Denial is
 Warranted. 4

 B. Denial is Warranted Because the Petition Fails to Present
 Any Compelling Challenge to the Claims. 8

 1. The Petition Fails to Comply with 37 C.F.R. §
 42.204(b)(4). 9

 2. The Petition’s Apparent Deficiencies for
 Independent Claim 1[a]..... 10

 3. Petitioners’ 35 U.S.C. § 112(a) Attacks are
 Baseless. 11

 C. Judge Gilstrap is Unlikely to Grant a Stay of the District
 Court Proceeding..... 14

 D. The Stage of Discovery Favors Denial. 14

 E. The Parties and Issues of the Parallel Proceedings
 Overlap. 15

IV. Discretionary Considerations under Section 325(d) Strongly
 Favor Denial. 16

 A. Each of the Petition’s Four References Was Known to,
 and Already Considered by, the Patent Office. 17

PGR2026-00008 Patent Owner’s Request for Discretionary Denial

B. Each of the Petition’s References Were Repeatedly Considered, and Specific Combinations Identified in Related Patent IPRs/EPR Were Known to the Examiner.....19

C. The Examiner Determined the Claims were Patentable, Notwithstanding the Examiner’s Consideration of the Petition’s Four References.19

D. The Petition Has Not Shown Any Material Error.....20

E. No Additional Evidence or Facts Presented in the Petition Warrant Reconsideration of the Prior Art or Arguments.20

V. CONCLUSION.....20

TABLE OF AUTHORITIES

Cases

Ascentcare Dental Products, Inc. v. Solmetex, LLC,
PGR2025-00058, Paper 10 (Director, Oct. 17, 2025)16

Becton, Dickinson & Co. v. B. Braun Melsungen AG,
IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) *passim*

Chevron Oronite Company LLC v. Infineum USA L.P.,
IPR2018-00923, Paper 9 (PTAB Nov. 7, 2018).....9

Deeper, UAB v. Vexilar, Inc.,
IPR2018-01310, Paper 7 (PTAB Jan. 24, 2019)9

Evergreen Theragnostics, Inc. v. Advanced Accelerator Applications SA,
PGR2021-00003, Paper 10 (PTAB Apr. 14, 2021).....16

Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.,
IPR2025-00632, Paper 20 (Director, Nov. 3, 2025).....8

Shenzen Tuozhu Tech. Co. v. Stratasys, Inc.,
IPR2025-00354, Paper 11 (Director June 12, 2025)15

TankLogix, LLC v. SitePro, Inc.,
IPR2025-00761, Paper 10 (Director, Sept. 3, 2025)20

Tesla, Inc. v. Intellectual Ventures II LLC,
IPR2025-00340, Paper 18 (Director, Nov. 5, 2025).....8

Statutes

35 U.S.C. § 325(d) *passim*

35 U.S.C. § 314.....*passim*

35 U.S.C. § 112.....*passim*

Rules

37 C.F.R. § 42.204(b)(4).....1, 9

PATENT OWNER’S EXHIBIT LIST

Exhibit No.	Description
2001	Reserved
2002	Civil Docket Report for <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG (lead case)
2003	U.S. Patent 8,737,913 to Xiao
2004	Final Written Decision, IPR2024-00981
2005	Claim Construction Order for <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG (lead case)
2006	Discovery Order, <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:25-cv-0782-JRG (lead case)
2007	Defendants’ Claim Construction Brief, <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:23-cv-0437-JRG (lead case)
2008	Order Denying Motion to Stay, <i>DigitalDoors, Inc. v. International Business Machines Corporation</i> , Case No. 2:22-cv-457-JRG-RSP (E.D. Tex. July 24, 2023)
2009	Civil Docket Report for <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:23-cv-0434-JRG (member case)
2010	Civil Docket Report for <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:25-cv-0782-JRG (lead case)
2011	Civil Docket Report for <i>Emerging Automotive LLC v. Toyota Motor Corp. et al.</i> , No. 2:25-cv-0799-JRG (member case)

Pursuant to the Interim Processes Memorandum, issued March 26, 2025, Patent Owner Emerging Automotive LLC (“Emerging Auto” or “Patent Owner”) respectfully submits this request and brief on discretionary denial, setting forth reasons why the Petition for post-grant review (“PGR”) of all claims of U.S. Patent 12,337,715 (the “715 patent”), as requested by Kia Corporation and Toyota Motor Corporation (“Petitioners”), should be denied pursuant to the Director’s discretion.

I. INTRODUCTION

Discretionary denial is warranted here for several reasons:

(1) Petitioners’ inconsistent claim construction positions—withholding from the Board the district court’s constructions of terms directly at issue in the challenged claims—not only risk inconsistent decisions across the two proceedings and undermine the Office’s goals of predictability and certainty—but also invite mere advisory opinions by the Board;

(2) the weak Petition is an inefficient use of the Board’s resources, as (a) the Petition did not even bother to specify prior art for each claim element, as required by 37 C.F.R. § 42.204(b)(4), (b) even though four different references are relied upon for the Petition’s obviousness challenge to claim 1, a cursory review shows the Petition’s failure to meet even the required threshold for claim limitation 1[a], and (c) the specification easily refutes the Petition’s § 112(a) challenges;

(3) all four of the Petition’s references were already known to and evaluated

by the Office during prosecution, yet the Petition fails to show any error, let alone material error, warranting another basis for denial under 35 U.S.C. § 325(d);

(4) the parallel district court case in the Eastern District of Texas is not likely to be stayed, such that any institution would result in duplicative workload and risk inconsistent outcomes, especially where Petitioners advance inconsistent claim construction positions for each of the two proceedings;

(5) substantial discovery has already been completed in the parties' first litigation, and all parties will rely on this already-completed discovery in the second district court litigation; and

(6) the parties of the parallel proceedings are identical.

II. BACKGROUND

A. Innovations of U.S. Patent No. 12,337,715

The '715 Patent issued on June 24, 2025. EX1001, Face Page. The '715 patent, titled "Methods and Systems for Sharing e-Keys to Access Vehicles," "relates to systems and methods for generating and sharing electronic keys (e-Keys) with users and cloud-based processing systems." *Id.* at 1:1-2, 2:7-9.

The claims of the '715 Patent allow a vehicle owner to easily and securely share an e-key for their vehicle with a friend or guest user. *Id.*, 5:11-14, 21-26, 45:62-67, 7:57-62.

B. Related and Parallel Litigation Proceedings

In July 2025, Patent Owner asserted infringement of the '715 Patent against Petitioners in the Eastern District of Texas. EX2010; EX2011. Patent Owner also asserted two other Emerging Automotive patents, U.S. Patent Nos. 11,104,245 and 12,337,716 against Petitioner Toyota, and asserted the 11,104,245 Patent against Petitioner Kia. *Id.* Discovery is underway in these two consolidated district court proceedings (“*Emerging Automotive v. Toyota/Kia, II*”). *Id.*

Previously, in September 2023, Patent Owner filed two prior patent infringement lawsuits against Petitioner Toyota and Petitioner Kia, asserting infringement of U.S. Patent No. 10,407,026, U.S. Patent No. 11,738,659, U.S. Patent No. 9,365,188, and U.S. Patent No. 9,171,268 (against Petitioner Toyota only). EX2002; EX2009. These 2023 proceedings were consolidated (“*Emerging Automotive v. Toyota/Kia, I*”) and, on the eve of trial, *Emerging Automotive v. Toyota/Kia, I* was stayed, following the district court's summary judgment order on a non-instituted asserted patent. EX2002. In *Emerging Automotive v. Toyota/Kia, I*, fact discovery, expert discovery, claim construction proceedings and the submission of a pretrial order had been completed. *Id.* The district court issued a Markman Order on May 14, 2025. EX2005.

For the *Emerging Automotive v. Toyota/Kia, II* district court proceedings, the parties have agreed to utilize the discovery completed in the *Emerging Automotive*

v. Toyota/Kia, I district court matters. EX2006, ¶¶ 5, 12(g)-(h).

Regarding the IPR/EPR proceedings on related patents, the Board did not institute IPR2024-00785, which challenged claims of U.S. Patent No. 10,407,026. Pet. 11-12. The Board instituted proceedings in IPR2024-00981 and issued a Final Written Decision finding that all challenged claims of U.S. Patent No. 9,365,188 were shown to be unpatentable. EX2004. Regarding U.S. Patent No. 11,738,659, the Board instituted proceedings in IPR2024-01167, and that matter is pending; additionally, the Office issued a final rejection in Reexamination No. 90/019,456, for which an appeal is pending. Pet. 11-12.

III. THE DIRECTOR SHOULD DENY INSTITUTION

The Director can and should deny this Petition, by exercising its discretion under 35 U.S.C. § 314(a) based on Petitioners’ inconsistent claim construction positions, which highlight the meritless challenges, risk incongruent decisions, and undermine the Office’s goals of promoting predictability and certainty.

A. Petitioners’ Inconsistent Claim Construction Positions—Disavowing District Court Constructions for “e-Key” and “Privileges”—Demonstrate Discretionary Denial is Warranted.

Petitioners have taken inconsistent positions in district court and in the IPR Petition concerning the “e-key,” “privileges” and “conditions of use” terms recited in the challenged claims of the ’715 Patent, directly bearing on the Board’s ability to weigh the merits of the Petition. As detailed further below in Section III.B., the

Petition relies on four different references for alleged obviousness of five or fewer claim limitations (e.g., claim 1), but still fails to show any disclosure of the specific “e-key” limitations recited by all claims. To weigh the merits of the Petition, therefore, the Board should have been informed of the district court’s construction of the “e-key” term, and Petitioners should have explained the reason for their inconsistent positions across the two proceedings. Petitioners did neither.

Additionally, no fewer than eight dependent claims recite “privileges” and/or “conditions of use” terms, but again, Petitioners did not even advise the Board that these terms had already been construed. Likewise, Petitioners offered no alternative theory of invalidity based on the district court’s construction of those terms, which is materially narrower than the construction presented in the Petition. Again, the Board’s ability to assess the Petition’s merits is compromised by this lack of disclosure.

Petitioners are not simply advancing inconsistent positions; Petitioners disregard altogether the district court’s construction of either the “e-key” term or the “privileges” / “conditions of use” terms, asking the Board to apply plain and ordinary meaning to all of them. Pet. 20:

VI. CLAIM CONSTRUCTION

The claim terms should be given their plain and ordinary meaning under *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005). EX1003, ¶¶88-89.

PGR2026-00008 Patent Owner’s Request for Discretionary Denial

Petitioners did not even provide the Board with the district court’s Claim Construction Order, even though Petitioners asked the court for narrowing constructions of the “e-key” and “privileges” / “conditions of use” terms, which were ultimately narrowed by the district court. *Id.*; EX2005, at 32, 12-13. As shown in the district court’s Order, the “e-key” term has already been construed as “electronic data that enables one or more functions of the vehicle”:

Term	Disputed Term	The Court’s Construction
1	“electronic key”/ “eKey”/ “e-key” (’026 patent, Claims 1, 2, 6, 13, 15; ’659 Patent, Claims 1, 3, 4, 12, 13, 20; ’188 Patent, Claims 1, 11, 16, 17; ’268 Patent, Claims 10, 18)	“electronic data that enables one or more functions of the vehicle”

EX2005, at 32.

Additionally, Petitioners’ position in this PGR proceeding—failing to advise of or apply the already-construed terms—is inconsistent and irreconcilable with their proposed construction of “privileges” and “conditions of use” terms in district court. Pet. 20. In district court, Petitioners advanced a narrower construction of “privileges” and “conditions of use” to exclude “unfettered access”—and Petitioners’ narrower construction was in fact adopted by the district court. EX2005, at 12-13. Specifically, Petitioners’ proposed construction in district court was based on Patent Owner’s alleged disclaimer of the Zaid reference—e.g., that Zaid could not disclose the recited privileges limitations in light of Zaid’s “unfettered access”

to the vehicle. *Id.*

Id. (internal citations omitted). Plaintiff then emphasized its prosecution remarks that Zaid did not disclose “a unique access code that includes privilege settings set for additionally limiting types of use of the vehicle.” *Id.* at 17. In other words, Plaintiff equated “unfettered access” with the absence, not presence, of “privileges.” Given that, the Court agrees with Defendants that “privileges for use of the vehicle” cannot simply be “unfettered access” to the vehicle, which is the “plain and ordinary meaning” of these phrases on this record.

Id., at 13; *see also* Defendants’ Claim Construction Brief, EX2007, at 6:

limits, geographic restrictions, amount of time, etc.” Ex. G (“‘026 POPR”), 3–4. EA argued that cited prior art did not disclose the claimed “privileges” because it provided “unfettered” vehicle access. *Id.*, 10. Therefore, the claimed “privileges for use” and “conditions of use” do not define whether “unfettered” access to the vehicle is permitted. Instead, they define permitted uses that restrict *how* the vehicle can be used with the e-key, such as speed restrictions, geographic limits, or the like, and not merely *whether* the vehicle can be accessed.

Defendants’ construction makes clear that “privileges for use” are permitted uses of the vehicle when using the e-key, such as what type of access, speed limits, geographic restrictions, or the amount of time the e-keys will be valid.” There can be no dispute that “privileges” modify

Because many of the dependent claims challenged by the Petition recite these “privilege” and/or “conditions of use” terms, Petitioners should have advised the Board that these terms had already been construed. EX1001, claims 2, 3, 11, 13, 16, 18, 22, and 24. They did not. Also, to allow the Board to properly review the merits of the Petition’s challenge, the Petition also should have provided a justification for the inconsistent positions and proposed invalidity arguments premised on both constructions. Petitioners did neither.

Accordingly, this is not merely a case in which Petitioners made inconsistent claim construction arguments in two different proceedings—facts which alone “detract[] from the Office’s goal of providing greater predictability and certainty in the patent system”—but instead amounts to a withholding of district court claim constructions that have direct bearing on the merits of the Petition. *See Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (Director, Nov. 5, 2025) (informative) (granting Director Review, vacating Decision granting institution, and denying Petition that advanced inconsistent claim construction positions) (quoting *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 3-5 (Director, Nov. 3, 2025) (precedential) (requiring petitioner to justify different claim construction positions in different proceedings)).

Because the Petition did not either advise the Board of the narrower constructions, nor include any alternative invalidity arguments based on any narrower claim constructions of the “e-key” or “privileges” / “conditions of use” claim terms found in the challenged claims of the ’715 Patent, the Board’s application of the terms would be merely advisory, resulting in a waste of the Board’s already limited resources.

B. Denial is Warranted Because the Petition Fails to Present Any Compelling Challenge to the Claims.

A strong petition does not rely on four different references when trying to

satisfy claims with only five or fewer limitations. A strong petition does not present excuses when a collection of references still fails to satisfy the claim limitations by offering unsupported § 112 attacks. Bearing this out, the Petition’s challenges are, in fact, weak. The numerous deficiencies, outlined below and which will be described more fully in the Patent Owner’s Preliminary Response, demonstrate that the merits of the Petition are far from compelling; institution is not “an efficient use of the Board’s time and resources.” *See, e.g., ,Chevron Oronite Company LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10-11 (PTAB Nov. 7, 2018), and *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 at 42-43 (PTAB Jan. 24, 2019).

1. The Petition Fails to Comply with 37 C.F.R. § 42.204(b)(4).

As an initial matter, the Petition flouts 37 C.F.R. § 42.204(b)(4)’s requirement to specify exactly where each element of the challenged patent claim is found in the prior art and instead hopes the Board will backfill the Petition’s procedural holes and ignore glaring evidentiary gaps. 37 C.F.R. § 42.204(b)(4) (requiring PGR to precisely identify prior art for each claim element). For example, for claim limitation 17[a], the Petition merely points to “limitation 1[a],”—though, at a minimum, claim 1[a] does not have the “receiving confirmation” language that claim 17[a] recites.

(b) 17[a] – receiving confirmation of a sharing request being sent for an electronic key (e-key) for use of the vehicle by a recipient device, the sharing request originates responsive to a message transferred by an owner device to the recipient device;

See limitation 1[a]; EX1003, ¶186.

Pet. 68; *but see* Pet. 39 (“1[a]”):

(b) 1[a] – “processing a request to share an electronic key (e-key) of a vehicle with a recipient device, the request to share the e-key being received responsive to a message being sent to the recipient device from a sharing device;”

2. The Petition’s Apparent Deficiencies for Independent Claim 1[a].

Upon a cursory review of the relied-upon disclosures for independent method claim 1[a], the requisite evidence is sorely lacking. To start, the Petition creates a mash-up of Kleve and Sekiyama for the first clause of limitation 1[a], relies on Kleve for the second clause, then returns to Sekiyama for the alleged “downstream mechanics.” Pet. 39-43. Despite this strained combination, the Petition fails to point to any reference that discloses the recited “the request to share the e-key being *received responsive to a message being sent to the recipient device from a sharing device.*” EX1001, claim 1[a].

Instead, the Petition merely suggests that Kleve’s “owner can deliver to the recipient a [form].” Pet. 43, *citing* 1004, ¶ 38. But at paragraph 38, Kleve never discloses any sharing device that “deliver[s]” any form to the recipient’s device—

and certainly not any disclosure about delivering the form by the recited “*message being sent to the recipient device from a sharing device.*” EX1004, ¶ 38. The Petition relies upon an alleged “recipient-facing message(s)” in Kleve—(Pet. 43, citing EX1004, ¶¶ 38, 62), but this is Petitioners’ concoction—Kleve does not disclose a sharing device sending a “recipient-facing message(s)” to the recipient device. EX1004, ¶¶ 38, 62, More fundamentally, Petitioners point to no disclosure of the recited request “received *responsive to a message being sent to the recipient device from a sharing device*[.]” EX1001, claim 1[a].

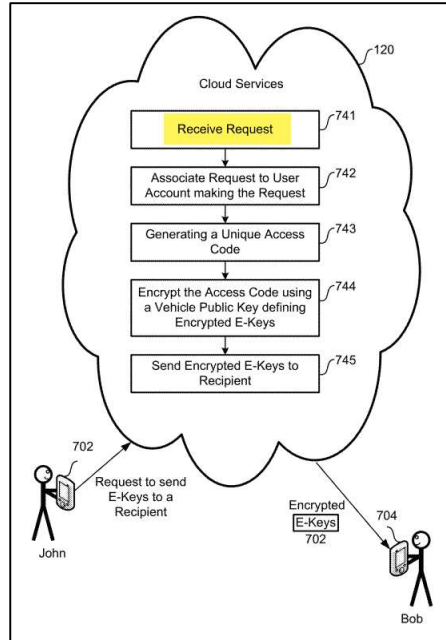
3. Petitioners’ 35 U.S.C. § 112(a) Attacks are Baseless.

Given the references’ lack of disclosure on these limitations alone, it is unsurprising that the Petition attempts to attack the limitations from claim 1[a], 17[a]-[b] and 23[b] as allegedly failing to comply with 35 U.S.C. § 112(a). Pet. 77-79. But the specification readily refutes those hollow attacks, providing written description to support and enable the “responsive to a message” (claim 1[a]) / “initiated using a message” (claim 23[b]) limitations. EX1001, claims 1, 23.

First, the Abstract describes “the request to share the e-key is *initiated* by sending a message to the recipient device using a sharing device.” *Id.*, Abstract. Additionally, the specification goes on to describe specific examples to support and enable the claim limitations. In one example, an owner, John, wishes to share an e-key of his vehicle with Bob, the recipient, so that Bob can use his smartphone

(recipient device) as an e-key for John's vehicle. *Id.*, 45:51-54, 37-41. John can use an app on his smartphone (sharing device) to request that a message is sent to Bob's smartphone (recipient device), so that Bob can receive the e-keys and be granted access to John's vehicle. *Id.*, 45:51-54. The specification describes examples of such a message. In one example, the message sent to Bob's smartphone can have a link to an application that can be launched from Bob's smartphone and used to complete the activation and access the vehicle. *Id.*, 45:62-64. In another example, the message to Bob's smartphone can include a simple link, and when Bob selects that link, it will link his recipient device to a webpage, which then provides Bob with instructions for activating the access for the e-keys. *Id.*, 5:21-26, 45:62-67.

Equally unfounded is the 35 U.S.C. § 112(a) challenge to claim 17[a]'s "receiving confirmation of a sharing request being sent[.]" The specification describes an example where cloud services **120** receives confirmation of a user having sent a sharing request **741**, as shown in Figure 31B below. *Id.*, Fig. 31B:



John, using device **702** (e.g., sharing device), can send a request to a server, which may be operated by cloud services **120**, to send e-keys to Bob on Bob’s smartphone **704** (e.g., recipient device). *Id.*, 44:34-40, 43:47-51. Cloud services confirms receipt of that request, for example, shown in Figure 31B above as **741**. *Id.*, Fig. 31B.

The specification also describes “receiving confirmation of the sharing request from the recipient device,” as recited by claim limitation 17[b]. For example, after receiving a message with a link, the recipient can use their device to select the link that was sent, which in turn will link the user to a webpage. *Id.*, 45:64-67. Here, it is after *receiving confirmation of the sharing request from the recipient device* that the webpage provides instructions for activating the access for the e-keys. *Id.*

Accordingly, the specification readily refutes the Petition’s baseless §112(a) attacks of claims 1-11 and claims 17-24.

C. Judge Gilstrap is Unlikely to Grant a Stay of the District Court Proceeding.

Petitioners have not sought a stay, and under the facts here, a stay would not be granted. Patent Owner has asserted three different patents in the parallel district court proceeding, including all twenty-four claims of the ’715 Patent, all thirteen claims of U.S. Patent No. 12,337,716, and eleven claims of U.S. Patent No. 11,104,245 Patent. EX2010. The Eastern District trial court has publicly stated that it will not even consider a stay unless the defendant shows “that every asserted claim has a reasonable likelihood of being invalidated by the PTAB.” EX2008 (Order Denying Motion to Stay, *Digital Doors, Inc. v. IBM*, No. 2:22-cv-00457-JRG-RSP (E.D. Tex. July 24, 2023)), at 5. Accordingly, this factor favors discretionary denial.

D. The Stage of Discovery Favors Denial.

The district court has already spent substantial time and resources conducting the Markman hearing and issuing a Claim Construction Order that undisputedly bears on the claim terms of the challenged ’715 Patent. EX2002; EX2005. Additionally, the parties have already spent substantial resources conducting discovery in *Emerging Automotive v. Toyota/Kia, I*—discovery which all sides have agreed to utilize in the present district court matters. EX2006, ¶¶ 5, 12(g)-(h). This already-completed discovery includes: twenty-three fact depositions, thirteen expert depositions, over seventy-seven interrogatories propounded, over 230,000

documents produced, and nine third-party subpoenas issued. EX2002. Finally, the parties submitted a pretrial order and participated in a pretrial conference. *Id.*

Discretionary denial is favored in light of the investment by the Court and the parties in the Markman hearing, the pretrial conference, numerous already-resolved discovery and substantive motions, and the substantial discovery that has already been completed to date. *Id.*

E. The Parties and Issues of the Parallel Proceedings Overlap.

The Petitioners are also defendants in the parallel district court litigation, which favors discretionary denial. Moreover, all challenged claims are also at issue in the district court proceeding. Petitioners’ “*Sotera*” stipulation does not fully resolve concerns about overlap, duplicative efforts, and conflicting decisions, since Petitioners may still raise invalidity arguments in district court that are more expansive and could further include combinations with unpublished system art. *See, e.g., Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00354, Paper 11, at 2 (Director, June 12, 2025) (denying institution as *Sotera* stipulation would not prohibit Petitioner from raising prior art combinations with unpublished system art in parallel district court proceedings).

And, as shown in Section III.A. above, the risk of conflicting decisions is of particular concern where, as here, Petitioners advance inconsistent and irreconcilable claim construction positions in the two proceedings. In any event, a

holistic assessment of the discretionary factors here warrants denial, regardless of Petitioners’ Sotera stipulation. *See Ascentcare Dental Products, Inc. v. Solmetex, LLC*, PGR2025-00058, Paper 10 at 2-3 (Director, Oct. 17, 2025) (denying institution under §§ 314(a) and 325(d)), Paper 1 (§ 112 grounds), EX1025 (Sotera stipulation).

IV. DISCRETIONARY CONSIDERATIONS UNDER SECTION 325(d) STRONGLY FAVOR DENIAL.

The Board should exercise its discretion to deny the Petition under 35 U.S.C. § 325(d) because, as shown below, most, if not all, of the *Becton Dickinson* factors weigh in favor of discretionary denial here. *Becton, Dickinson & Co. v. B. Braun Melsungen AG* (“*Becton*”), IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph). Not only were all of the Petition’s references already considered by the Office, but the Examiner also knew of related patent IPR/EPR proceedings which identified the specific art combinations used in the Petition. Moreover, the Petition has not even argued, let alone demonstrated, any material error. And the fact that Petitioners added § 112 grounds to the Petition does nothing to change the analysis under § 325(d). *See, e.g., Evergreen Theragnostics, Inc. v. Advanced Accelerator Applications SA*, PGR2021-00003, Paper 10 at 19 (PTAB Apr. 14, 2021) (finding § 325 “sufficiently implicated [such] that instituting on the remainder of the Petition would undermine the statutory purpose”); *see also Ascentcare*, Paper 10 at 2-3 (finding discretionary denial

appropriate under §§ 314(a) and 325(d), notwithstanding § 112 grounds (Paper 1 at 3)). In any event, as shown in Section III.B., Petitioners' § 112 grounds lack merit.

A. Each of the Petition's Four References Was Known to, and Already Considered by, the Patent Office.

The first *Becton* factor—the similarities and material differences between the asserted art and the prior art involved during examination—strongly favors Patent Owner, as there is complete overlap between the Petition's references and the prior art involved during examination. Moreover, given this complete overlap, the second *Becton* factor—the cumulative nature of the asserted art and the prior art evaluated during examination—likewise strongly favors Patent Owner. The Petition's use of these same four references is clearly cumulative over the prior examination.

Sekiyama was submitted in an IDS, considered by the Examiner, and the full translated document was submitted for the Examiner's review. EX1002, at 282 (initialed as considered by Examiner), 59 (IDS), 109 (translated document). Additionally, the Examiner was aware of IPR2024-00981, which presented the same art combination, Kleve/Sekiyama, relied upon in this Petition. *Id.*, at 375.

Kleve was submitted in an IDS, considered by the Examiner, and included in two Examiner searches. *Id.*, at 281, 396, and 566 (initialed as considered by Examiner), 58 and 217 (IDS), 481 (December 2019 EAST search), 540 (February 2025 EAST search). Additionally, the Examiner knew of proceedings involving

PGR2026-00008 Patent Owner's Request for Discretionary Denial

related patents, which had relied on Kleve as well: (1) IPR2024-00785, (2) IPR2024-00981, which relied on the Kleve/Sekiyama combination relied upon in this Petition, (3) IPR2024-01167, which used the Kleve/Hatton combination also relied used in this Petition, and (4) EPR90/019,456, which also relies upon Kleve. *Id.*, at 375.

The Hatton reference was submitted in an IDS and considered by the Examiner. *Id.*, at 396 (initialed as considered by the Examiner), 317 (IDS). The Examiner was also aware of IPR2024-01167, which had presented the same Kleve/Hatton combination used in this Petition. *Id.*, at 375.

The Xiao reference, U.S. Patent No. 8,737,913 (EX1010), issued from Pat. App. Pub. No. 2012/0164989 (EX2003), and that patent application publication includes the same disclosures from the Xiao patent relied upon by the Petition. EX2003. The Examiner considered both the Xiao patent (EX1002, initialed as considered by Examiner at 281 and 565), as well as the Xiao patent application publication (*id.*, at 397 and 565). *See also id.*, at 58 (IDS identifying Xiao Patent), 318 (IDS identifying Xiao patent application publication). Additionally, the Examiner was aware of IPR2024-00786, which had relied on the Xiao patent application publication. *Id.*, at 375.

Accordingly, all four of the Petition's references were already considered during the prosecution of the '715 Patent.

B. Each of the Petition's References Were Repeatedly Considered, and Specific Combinations Identified in Related Patent IPRs/EPR Were Known to the Examiner.

The third *Becton* factor concerns the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection. While the only bases for rejection of claims during the prosecution of the '715 Patent were non-statutory double-patenting rejections (EX1002, at 284-87), the prosecution history provides a clear indication that the Examiner evaluated each of the references and knew of the specific art combinations relied upon in the Petition. As shown above, the Examiner knew of and considered Sekiyama, Kleve, Hatton, and Xiao, and was aware of the specific Kleve/Sekiyama and Kleve/Hatton combinations. *See* Section IV.A., *supra*.

Accordingly, this factor favors Patent Owner, as the prosecution history provides a clear indication that the Examiner evaluated each of the prior art references used in the Petition.

C. The Examiner Determined the Claims were Patentable, Notwithstanding the Examiner's Consideration of the Petition's Four References.

The fourth *Becton* factor—the extent of the overlap between the examination arguments and the manner in which Petitioner relies on the prior art—is neutral or favors Patent Owner because there were no arguments made during examination regarding the Petition's four references, despite the Examiner knowing of and having

considered those four references. *See* Sections IV.A., *supra*.

D. The Petition Has Not Shown Any Material Error.

The fifth *Becton* factor—whether the Petition has shown material error by the Examiner—strongly favors Patent Owner, as the Petition has not set forth any discussion of whether or how the Examiner erred, let alone any material error.

E. No Additional Evidence or Facts Presented in the Petition Warrant Reconsideration of the Prior Art or Arguments.

This final *Becton* factor strongly favors Patent Owner because, as explained in Section III.B., *supra*, the proposed invalidity grounds are weak—the § 103 ground is patently contradicted by the references and the § 112(a) ground is belied by the specification of the ’715 Patent.

The Patent Office’s prior consideration of the Petition’s references warrants denial of institution under § 325(d), alone, and is yet another consideration among the totality of factors that further warrant discretionary denial. *See, e.g., TankLogix, LLC v. SitePro, Inc.*, IPR2025-00761, Paper 10 (Director, Sept. 3, 2025) (denying institution because the same prior art was previously presented to the Office, though trial could be 10 months after FWD, and no finding of settled expectations).

V. CONCLUSION

For the reasons presented above, the Petition should be discretionarily denied, and no post-grant review should be instituted.

PGR2026-00008 Patent Owner's Request for Discretionary Denial

Dated: December 23, 2025

/Brenda Entzminger/

Brenda Entzminger, Reg. No. 76,896

CERTIFICATE OF SERVICE

Petitioners have consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that, on the date indicated below, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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