UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EOPTOLINK TECHNOLOGY USA INC.,

Petitioner,

v.

APPLIED OPTOELECTRONICS, INC.,

Patent Owner.

Case IPR2026-00094
Patent No. 10,578,818

PATENT OWNER'S REQUEST TO DIRECTOR FOR DISCRETIONARY DENIAL OF PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT 10,578,818

(Pursuant to Acting Director's Memorandum of March 26, 2025 and Director's Memorandum of October 17, 2025)

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EXHIBITS

Exhibit No.	Description
2001	Acting Director Stewart's March 26, 2025 Memorandum entitled "Interim Processes for PTAB Workload Management"
2002	Director Squires' October 17, 2025 Memorandum entitled "Director Institution of AIA Trial Proceedings"
2003	Petitioner Eoptolink's Invalidity Contentions in *Applied Optoelectronics, Inc. v. Eoptolink Technology USA Inc.*, case no. 5-24-cv-08165-NW (N.D. CA) served on August 18, 2025
2004	District Court's Case Management and Trial-Setting Order in *Applied Optoelectronics, Inc. v. Eoptolink Technology USA Inc.*, case no. 5-24-cv-08165-NW (N.D. CA) filed September 8, 2025
2005	Director Squires' November 17, 2025 Memorandum entitled "Voluntary Search Disclosure Declarations as a Favorable Factor in Institution Decisions"

I. INTRODUCTION

This request is submitted by Patent Owner Applied Optoelectronics, Inc. ("AOI") to the Director of the United States Patent and Trademark Office ("USPTO") pursuant to the Acting Director's March 26, 2025 Memorandum "Interim Processes for PTAB Workload Management" and the Director's October 17, 2025 Memorandum "Director Institution of AIA Trial Proceedings" (collectively the "Memoranda," Exhibits 2001 and 2002).

This is AOI's separate brief, pursuant to the Memoranda, requesting a discretionary denial of the petition (the "Petition") of Eoptolink Technology USA Inc. ("Petitioner") for an *inter partes* review ("IPR") of U.S. Patent No. 10,578,818 (the "'818 Patent", Exhibit 1001) entitled "Optical Transceiver".

The Director should exercise his discretion and deny the Petition for IPR in this case because there are settled expectations in this patent that is almost six years old as well as for the other reasons set forth below.

II. FACTUAL BACKGROUND

A. The '818 Patent

Application no. 16/153,685 for the '818 Patent was filed on October 15, 2018. *See* "'818 Patent File History," Exhibit 1002. (Please see Exhibit 1002 for the full prosecution history.) The '818 Patent issued on March 3, 2020 with 12

claims, including three independent claims.

B. Prior and Pending Petitions for IPR Filed Against AOI Patents

In addition to this petition for IPR of the ’818 Patent, Petitioner has also filed petitions for IPR of three other AOI patents, U.S. Patent No. 9,448,367 (“’367 Patent”) (filed jointly with another party); U.S. Patent No. 10,714,890 (“’890 Patent”); and U.S. Patent No. 11,177,887 (“’887 Patent”). AOI has filed a Request to Director for Discretionary Denial of Petitioner’s petition for IPR of the ’367 Patent, and will be filing Requests to Director for Discretionary Denial of Petitioner’s petitions for IPR of the ’890 and ’887 Patents, all on grounds similar to those asserted in this Request.

C. The Litigation Between AOI and Eoptolink

On November 19, 2024, AOI filed a lawsuit against Petitioner for patent infringement entitled *Applied Optoelectronics, Inc. v. Eoptolink Technology USA Inc.*, case no. 5:24-cv-08165-NW (N.D. CA) (the “Litigation”). The complaint alleges that Petitioner infringes six of AOI’s patents, including the ’818 Patent. In the Litigation, Petitioner alleges that each of the six patents-in-suit is invalid. Petitioner has filed petitions for IPR of four of the six patents.

On June 13, 2025, AOI served its infringement contentions, stating that Petitioner infringes claims 1–7 and 9–10 of the ’818 Patent. On August 18, 2025,

Petitioner served its invalidity contentions. *See* Exhibit 2003. Petitioner contends that claims 1–7 and 9–10 are invalid under either 35 U.S.C. § 102 or § 103 on four grounds based on three different references. The following grounds asserted in the Litigation by Petitioner are relevant here: (1) Claims 1–7 and 9–10 are anticipated by or obvious over Wang (U.S. Patent Publication No. 2015/0263453, Ex. 1003); (2) Claims 1–7 and 9–10 are anticipated by or obvious over Koutrokois (U.S. Patent Publication No. 2014/0104808, Ex. 1004); (3) Claims 1–7 and 9–10 are obvious over another reference in view of Koutrokois. *See* Exhibit 2003, p. 9.

Between June 2025 and December 2025, AOI and Petitioner exchanged initial disclosures, and infringement and invalidity contentions. On December 5, 2025, AOI and Petitioner filed a Joint Administrative Motion to Stay Pending IPR Institution Decisions based on Petitioner's petitions for IPR.

D. The Petition for *Inter Partes* Review

On November 5, 2025, almost one year after AOI filed its complaint in the Litigation, Petitioner filed its Petition for IPR of the '818 Patent.

In the Petition, Petitioner challenges claims 1–12 of the '818 Patent. Petitioner asserts six grounds of invalidity: (1) Claims 1–3, 5, 7, and 10 are anticipated by Wang (U.S. Patent Publication No. 2015/0263453, Ex. 1003); (2) Claims 4, 6, and 9 are obvious over Wang; (3) Claims 8, 11, and 12 are obvious

over Wang in view of Tsai (U.S. Patent No. 9,523,826, Ex. 1005); (4) Claims 1-3, 5, 7, and 10 are anticipated by or obvious over Koutrokois (U.S. Patent Publication No. 2014/0104808, Ex. 1004); (5) Claims 4, 6, and 9 are obvious over Koutrokois; and (6) Claims 8, 11, and 12 are obvious over Koutrokois in view of Tsai.

Pursuant to the Notice of Filing Date, Patent Owner's Preliminary Response is due by February 13, 2026. Pursuant to the PTAB's "Consolidated Trial Practice Guide – November 2019" and the Director's October 17, 2025 Memorandum (Exhibit 2002), the Director will determine whether to institute an IPR within three months of the date Patent Owner's Preliminary Response was filed or was due, by about May 13, 2026. If IPR is instituted, pursuant to 35 U.S.C. § 316(a)(11), the PTAB will set the trial date within one year of the notice of institution, no later than about May 13, 2027.

III. INSTITUTION OF *INTER PARTES* REVIEW SHOULD BE DENIED PURSUANT TO THE DIRECTOR'S DISCRETION.

The Director should exercise his discretion pursuant to the Memoranda (Exhibits 2001 and 2002) and deny institution of IPR on the '818 Patent. The following factors support a discretionary denial:

- There is significant overlap between the issues in the Petition and in the Litigation. The claims, grounds, and art are the same or substantially the same.
- There has been significant investment in the Litigation in that substantive

issues have already been addressed by the parties.

- There are settled expectations in the enforcement of the ’818 Patent as the patent has been in force for almost six years.
- Petitioner and the defendant in the Litigation are the same party.
- There are no relevant changes in the law that affect patentability.
- Any Search Disclosure Declaration (“SDD”) filed by Petitioner pursuant to Director’s November 17, 2025 Memorandum is at a most a neutral, rather than favorable, factor with respect to this Petition because Petitioner relies solely on patents and published patent applications, and Petitioner does not rely on any prior art stemming from currently unknown search pathways.

Each of these factors is discussed separately below in sections A through F.

A. The Issues in the Petition Significantly Overlap the Issues in the Litigation.

There is significant overlap between the issues (claims, art, arguments, and evidence) asserted in the Petition and in the Litigation. See *Apple Inc. v. Fintiv, Inc*., IPR2020-00019, Paper 11, p. 6 (March 20, 2020) (precedential). “[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.”

First, almost all of the claims challenged in the Petition (claims 1–12) are

challenged in the Litigation (claims 1–7 and 9–10).

Second, the two primary references relied upon in the Petition (Wang and Koutrokois) which form the basis of all six grounds asserted in the Petition are also relied upon by Petitioner in two of the four invalidity grounds asserted in the Litigation. *See* Ex. 2003, p. 9.

Third, all of the grounds for invalidity asserted in the Petition are the same or substantially the same as three of the four grounds asserted in the Litigation. In Ground 1 of the Petition, Petitioner argues that Claims 1–3, 5, 7, and 10 are anticipated by Wang; in the Litigation, Petitioner argues that claims 1–7 and 9–10 are anticipated by Wang. In Ground 2 of the Petition, Petitioner argues that claims 4, 6, and 9 are obvious over Wang; in the Litigation, Petitioner argues that claims 1–7 and 9–10 are obvious over Wang. In Ground 3 of the Petition, Petitioner argues that claims 8, 11, and 12 are obvious over Wang in view of Tsai; in the Litigation, Petitioner argues that claims 1–7 and 9–10 are obvious over Wang. In Ground 4 of the Petition, Petitioner argues that Claims 1–3, 5, 7, and 10 are anticipated by Koutrokois; in the Litigation, Petitioner argues that claims 1–7 and 9–10 are anticipated by Koutrokois. In Ground 5 of the Petition, Petitioner argues that Claims 4, 6, and 9 are obvious over Koutrokois; in the Litigation, Petitioner argues that claims 1–7 and 9–10 are obvious over Koutrokois. In Ground 6 of the

Petition, Petitioner argues that claims 8, 11, and 12 are obvious over Koutrokois in view of Tsai; in the Litigation, Petitioner argues that claims 1–7 and 9–10 are obvious over another reference in view of Koutrokois. *See* Exhibit 2003, p. 9.

Moreover, Petitioner's challenges to the '818 Patent in the Litigation involve two other references and two other grounds that are not asserted in the Petition. And the Litigation also involves five other patents. The fact that the Litigation involves additional challenges to the '818 Patent weighs in favor of a denial. *See Next Caller Inc. v. Trustid, Inc*., IPR 2019-00963, Paper 8, p. 12 (October 28, 2019) (informative).

B. The Parties Have Invested in the Litigation by Addressing Substantive Issues.

The Litigation has progressed substantively. The parties have exchanged initial disclosures, infringement contentions, and invalidity contentions.

C. There Are Settled Expectations in the '818 Patent.

The '818 Patent was issued on March 3, 2020. The patent has been in force for almost six years. Thus, there are settled expectations that the '818 Patent is valid and enforceable. For this reason alone, the Director should exercise his discretion and deny Petitioner's request for IPR of the '818 Patent.

D. Petitioner and the Defendant are the Same Parties.

Here, the fact that Petitioner and the defendant in the Litigation are the same

party, weighs in favor of denial of institution. *See Apple Inc. v. Fintiv, Inc*., *supra,* pp. 13-14.

E. There are No Relevant Changes in the Law that Affect Patentability.

There have been no changes in the law or judicial precedent regarding patentability since the ’818 Patent issued. Accordingly, this factor weighs in favor of denial of institution. *See* Memorandum, Exhibit 2001, p. 2.

F. Any Search Disclosure Declaration filed by Petitioner Does Not Favor Institution.

Any Search Disclosure Declaration (“SDD”) filed by Petitioner pursuant to the Director’s SDD Memo is at most a neutral, rather than favorable, factor with respect to this Petition because Petitioner relies solely on U.S. patents and published patent applications for its invalidity arguments. *See, e.g.*, Exhibits 1003-1005. Specifically, the Director’s SDD Memo states that “[t]he voluntary submission of an SDD will be considered as a non-exclusive, nondispositive favorable discretionary factor supporting institution, *particularly where the SDD reveals new or underutilized pathways relevant to Office search practice*.” *See* Exhibit 2005 at p. 2 (emphasis added).

Given that Petitioner relies solely on U.S. patents and applications in its Grounds for alleging invalidity, finding these alleged prior art references neither

requires, nor reveals, "*new or underutilized pathways relevant to Office search practice.*" *Id.*

Thus, to the extent that Petitioner may argue that other references located via its search were found using new or underutilized pathways, that would not relate to this Petition because Petitioner did not rely upon them here. Therefore, the filing of an SDD with respect to this Petition should not favor institution.

IV. CONCLUSION

For the reasons set forth above, the Director should exercise his discretion and deny institution of IPR on the '818 Patent.

Dated: January 13, 2026

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CERTIFICATE OF SERVICE

The undersigned hereby certifies service on the Petitioner, pursuant to 37 C.F.R. § 42.6(e) and by agreement of counsel, by electronic (e-mail) delivery of a true copy of the foregoing **PATENT OWNER'S REQUEST TO DIRECTOR FOR DISCRETIONARY DENIAL OF PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT 10,578,818 (Pursuant to Acting Director's Memorandum of March 26, 2025 and Director's Memorandum of October 17, 2025)**, which was served on January 13, 2026 to the following Counsel for Petitioner via e-mail:

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