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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOLDEN EYE TECHNOLOGIES LLC

Petitioner

v.

CISCO SYSTEMS, INC.

Patent Owner

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Case IPR2026-00186  
U.S. Patent No. 10,051,556

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**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF  
INSTITUTION**

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<b>No.</b>	<b>Description</b>
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Ex. 2002	Median Time From Filings to Trial For Civil Cases in Which Trials Were Completed, Table T-3, <a href="https://www.uscourts.gov/data-news/reports/statistical-reports/federal-judicial-caseload-statistics/federal-judicial-caseload-statistics-2025-tables">https://www.uscourts.gov/data-news/reports/statistical-reports/federal-judicial-caseload-statistics/federal-judicial-caseload-statistics-2025-tables</a>
Ex. 2003	Petitioner Cisco's Cover Pleading of its Invalidity Contentions in the Eastern District of Texas Litigation
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## I. INTRODUCTION

Pursuant to the Director’s March 26, 2025 Memorandum regarding Interim Processes for PTAB Workload Management (“March 2025 Memo”), Patent Owner Golden Eye Technologies LLC (“Patent Owner”) respectfully requests that the Director exercise discretion to deny institution of Cisco System, Inc.’s (“Petitioner”) petition for inter partes review (the “Petition”) of U.S. Patent No. 10,051,556 (the “556 patent”). A holistic assessment of the relevant facts and circumstances of this case warrants discretionary denial under 35 U.S.C. § 314(a) to preserve Office resources and honor the settled expectations of the Patent Owner.

Discretionary denial is particularly appropriate here because the parallel litigation in the Eastern District of Texas (“EDTX”) has reached an advanced stage. *Golden Eye Technologies LLC v. Cisco Systems, Inc.*, No. 2:25-cv-00898-JRG (EDTX). The parties have exchanged infringement and invalidity contentions and are currently engaged in fact discovery. With the Final Written Decision (“FWD”) not expected until July 2027—a mere five weeks before the August 16, 2027 trial date—the Board’s determination would arrive after the parties and court have completed most of their work. This trial schedule is consistent with the EDTX’s median time-to-trial of approximately 25 months, making it likely that the court will reach a verdict concurrently with the issuance of the Final Written Decision.

Furthermore, a stay of the EDTX proceedings is highly unlikely. That case

includes the assertion of four other patents, some not subject to an IPR. Thus, the institution of this review, would not provide a valid basis for staying the district court litigation because, regardless of the outcome of this proceeding, other disputes involving additional patents must be litigated. Thus, this proceeding does not provide the “efficient alternative to litigation” intended by the AIA. Instead, institution would force the parties to litigate the same validity issues in two forums simultaneously, unnecessarily duplicating efforts and expense. Because a final district court verdict is expected to arrive at or near the same time as any Board determination, maintaining this IPR would serve only as a wasteful redundancy and create a substantial risk of inconsistent decisions between the two tribunals.

Finally, the Director should consider the Patent Owner’s strong settled expectations. Since issuance on August 14, 2018, the ’556 patent has been in force for nearly eight years and will have been in force for nine years before any FWD. As recognized by *Samsung v. Mobile Data Tech.*, such longevity “creates strong settled expectations for Patent Owner[s]” that should not be disturbed by the inefficiencies of parallel, late-stage proceedings. In view of these and other considerations addressed below, discretionary denial of the Petition is warranted.

## **II. DISCRETIONARY DENIAL IS WARRANTED UNDER §314(a)**

Under 35 U.S.C. § 314(a), the Board has discretion to deny institution of Cisco’s petition for *inter partes* review. *See also Cuozzo Speed Techs., LLC v. Lee*,

579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). Where a parallel district court litigation involving the same issues as the petition for IPR has reached such an advanced state that trial would conclude prior to or even close to the deadline for the Board’s final written decision, denial of institution is warranted under § 314(a). *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19-20 (PTAB Sept. 12, 2018) (precedential). The Director has reiterated that the “existing Board precedent” established under *Fintiv* (among other relevant precedent also discussed herein) requires analysis of “discretionary considerations” under § 314(a). *See* March 2025 Memo at 2. The Board has set forth six ***Fintiv* factors** for determining whether discretionary denial in light of parallel litigation is appropriate: **(1)** whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted; **(2)** proximity of the court's trial date to the Board's projected statutory deadline for a final written decision; **(3)** investment in the parallel proceeding by the court and the parties; **(4)** overlap between issues raised in the petition and in the parallel proceeding; **(5)** whether the petitioner and the defendant in the parallel proceeding are the same party; **(6)** other circumstances that impact the Board's exercise of discretion. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential). The Board “takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting

review.” *Id.*, Paper 15 at 7-17 (PTAB May 13, 2020) (informative).

**A. *Fintiv* Factor 1: The court has not granted a stay and no evidence exists that one may be granted if a proceeding is instituted.**

Factor 1 heavily favors discretionary denial as the court in the Eastern District of Texas (“EDTX”) has not granted a stay, Petitioner has not moved for one, and a stay is unlikely. EDTX courts regularly deny stay motions when the PTAB has not issued a decision to institute. As noted in *Barkan Wireless IP Holdings v. Samsung Elecs.*, EDTX judges maintain a “consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.” 2019 WL 8647996, at \*2 (E.D. Tex. Mar. 15, 2019). Similarly, the court in *Trover Group v. Dedicated Micros USA* held that when the PTAB has not acted, EDTX courts have “uniformly denied motions for a stay.” 2015 WL 1069179, at \*6 (E.D. Tex. Mar. 11, 2015).

Furthermore, Petitioner neither presents evidence to support a stay nor voices intent to seek one. *See* Pet. at 14 (relying solely on its insufficient *Sotera* stipulation to negate a discretionary denial). Indeed, where a “Petitioner present[ed] no evidence that it has requested a stay [] or that a stay is likely,” the Board has found Factor 1 to favor discretionary denial. *Luxshare Precision Industry v. Amphenol Corp.*, IPR2022-00132, Paper 10 at 9 (PTAB May 3, 2022). This aligns with the Board’s reasoning in *Samsung v. Mobile Data Tech.*, where institution was denied in part for “insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial.” *See* IPR2025-00537, Paper 15 at 2.

The complexity of parallel litigation makes a stay even less likely. Here, the EDTX case involves five asserted patents, some not subject to IPR, and none subject to an instituted IPR. *See SB IP Holdings, LLC v. Vivint, Inc.*, No. 4:21-cv-00912, Doc. 59 (E.D. Tex. April 6, 2023) (denying motion to stay when not all patents were subject to an instituted IPR). Because an IPR of the '556 patent cannot resolve the entire controversy, a stay would cause “piecemeal” litigation. Without any stay likely, institution would ensure “significant duplication of effort” and “additional expense for the parties.” Factor 1, therefore, favors denial.

**B. *Fintiv* Factor 2: The EDTX trial will occur at or near the same time as any final written decision.**

The second *Fintiv* factor weighs heavily in favor of discretionary denial because the district court trial is scheduled to begin nearly simultaneously with the Board’s projected statutory deadline for issuing a final written decision. The Eastern District of Texas has set a firm date for jury selection and trial to commence on August 16, 2027, and median time-to-trial statistics for this venue suggest that trial will occur at approximately 25.9 months from filing—aligning with the scheduled date. *Compare* Ex. 2001 (Doc. 37) at 1 *with* Ex. 2002. Based on the filing date of the Petition, in comparison, the Board’s Final Written Decision is not expected until July 7, 2027—just one month prior to the trial date and *after* significant deadlines in the parallel litigation such as the deadline for filing motions for summary judgment.

As demonstrated in *Shenzhen Tuozhu Technology Co. v. Stratasy, Inc.*, the

Board generally denies institution when a trial date is close to the projected FWD deadline because such proximity ensures that the district court will have already addressed the Petitioner's invalidity challenges by the time the Board reaches a conclusion. *See* IPR2025-00354, Paper 11 at 2 (PTAB June 12, 2025) (granting discretionary denial when the projected FWD was within approximately one month of the trial date). For example, even before reaching trial, Petitioner will have had the opportunity to seek summary judgment on invalidity of the '556 patent *before* the issuance of the Board's final written decision. *See* Ex. 2001 (May 10, 2027 – deadline to file Dispositive Motions). Thus, trial date (and other relevant deadlines) in the parallel litigation is sufficiently close to the issuance of the FWD in this proceeding to eliminate any benefits from proceeding with this IPR.

**C. *Fintiv* Factor 3: Investment of significant resources before an institution decision and Petitioner's lack of diligence favor denial.**

The Board utilizes a two-prong test to assess *Fintiv* Factor 3. The first prong relates to the “amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9 (PTAB Mar. 20, 2020). Under the second prong, the petitioner must explain any lack of diligence. If it cannot do so, this factor favors denial. *Id.* at 11-12. Because the first prong is, at best, neutral and the second prong weighs in favor of discretionary denial, this factor weighs in favor of discretionary denial. *See, e.g., Samsung Electronics Co. v. SiOnyx, LLC*, IPR2025-

00065, Paper 16, 11-12 (PTAB June 6, 2025) (determining that the first prong is neutral even when “the claim construction phase has not even begun yet”).

Importantly, the parties passed the critical milestone of exchanging infringement and invalidity contentions, including eligibility contentions on November 10, 2025 and January 19, 2026, respectively. *See* Ex. 2001 (Doc. 37) at 5. This means Petitioner has already committed to its primary invalidity theories and prior art searches in district court.

Moreover, the parties are currently engaged in active fact discovery, having already exchanged a significant volume of documents, including Petitioner producing over 125,000 pages of documents. By the time the Board issues its institution decision in July 2026, the parties will have continued significantly on this trajectory toward a March 2027 completion of discovery. Ex. 2001 at 2.

Also, because the EDTX litigation involves additional patents (at least U.S. Pat. Nos. 9,344,978 and 9,918,236) that are not subject to any petition for IPR, the district court must proceed with discovery, claim construction, and trial as to all other non-IPR patents, regardless of the Board’s decision on the ’556 patent. The EDTX court’s investment therefore is fixed and will not change. Institution here would only force the Court and the parties to manage a bifurcated and “piecemeal” validity analysis, thereby undermining the efficiency goals of the AIA.

Turning to the second prong, Petitioner was not diligent in filing its Petition.

Petitioner was on notice of the '556 patent as early as 2023, when the parties first began discussions regarding Petitioner's infringement. *See* Ex. 2007 (Complaint) at ¶ 98; Ex. 2008 (Answer) at ¶ 98. Despite its knowledge, Petitioner waited nearly three years—until the litigation was in an advanced stage and the patent was nearing its ninth anniversary—to file its Petition. Petitioner's three year delay in filing its Petition demonstrates a lack of diligence and tips this factor in favor of denial. Thus, the district court's and the parties' substantial investment in the parallel EDTX litigation further warrants discretionary denial under *Fintiv's* Factor 3.

**D. *Fintiv* Factor 4: The issues raised in the Petition substantially overlap with those raised in the EDTX case.**

The fourth *Fintiv* factor heavily favors denial because the Petition presents issues that overlap with litigation in district court. Under this factor, the Board weighs whether the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as a parallel court case. The efficiency and integrity of the system are best served when an IPR provides a meaningful alternative to litigation, not a “significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions.” *See Samsung v. Mobile Data Tech.* at 2; *see also Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-0109, Paper 12, 19 (PTAB Dec. 1, 2020). Here, the challenged claims include the two claims 9 and 11, which are asserted in litigation. Petitioner's *Sotera* stipulation will not remedy the redundancy of invalidity theories presented nor does it address the countless

additional invalidity theories Petitioner presents in the district court litigation.

Significantly, Petitioner relies on the same prior art in this IPR proceeding as it does in the district court litigation. *Compare* Pet. at 15 (identifying Choudhary, Hasty, and Chen as allegedly invalidating prior art) *with* Ex. 2003 at 14 (Invalidity Contentions). For example, in its district court disclosures, Petitioner list Choudhary and Hasty as primary prior art sources to challenge the “probe request frame including information on a signal strength” limitation of claim 9—the same references presented in Ground 1 of the Petition. *Compare* Ex. 2004 (Ex. A-4) at 11–18 and Ex. 2005 (Ex. A-1) at 6–10 *with* Pet. at 31–35, 49-53. Similarly, Petitioner’s reliance on Chen to address the “station waiting period” feature is common to both forums. *Compare* Ex. 2006 (Ex. A-3) at 18-23 *with* Pet. at 58-61.

Conspicuously, Petitioner’s district court contentions lack the Petition’s specificity, taking a scattershot approach by listing 13 patents/publications and 12 systems as primary sources and then adding 8 more secondary references without explicitly detailing the combinations later developed for this IPR. More egregiously, Petitioner attempts to preserve nearly infinite number of combinations in district court via the vague assertion that “these primary references may be combined with each other or with the secondary references . . . to render this [’556] patent obvious.” Ex. 2003 at 14-16. This blanket statement obscures any specificity in Petitioner’s invalidity positions and highlights that Petitioner has no intention of giving

meaningful effect to its *Sotera* stipulation. By refusing to commit to specific combinations in district court while moving forward on the same art here in just one specific combination, Petitioner is seeking a “trial run” of its theories at the PTAB while keeping its options open for trial. Such duplicative and tactical maneuvering is exactly what the *Fintiv* factors are designed to prevent. *See, e.g., Shenzhen*, Paper 11 at 2 (finding Petitioner’s invalidity arguments to be “more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot”).

Though Petitioner purports to mitigate the overlap of its Petition grounds by offering a *Sotera* stipulation (Pet. at 14), this gesture is rendered hollow by Petitioner’s district court invalidity contentions. By broadly asserting twenty-five prior art references while also contending that any of these “may be combined with each other” (Ex. 2003 at 16), Petitioner has obscured any restriction on what “reasonably could have been raised” in this IPR. This tactical ambiguity ensures Petitioner’s stipulation provides no real safeguard against duplication, leaving open an improper avenue to relitigate these same references in the district court under the guise of “new” combinations not specifically detailed in the Petition.

Indeed, the recent Federal Circuit precedential decision in *Ingenico Inc. v. IOENGINE, LLC* expressly states that a petitioner is not precluded from “relying on the same patents and printed publications as evidence in asserting a ground that could

not be raised during the IPR.” 136 F.4th 1354, 1366 (Fed. Cir. 2025). In other words, Petitioner’s *Sotera* stipulation is ineffective in preventing Petitioner from using the same prior art references in the EDTX court not only as “evidence” but also as grounds that were purportedly “not raised” in this IPR—such as the vast array of combinations involving the dozens of other references buried in its contentions. Because Petitioner seeks a “trial run” of its theories at the PTAB while maintaining an amorphous “all-of-the-above” defense in the EDTX court, this factor weighs heavily in favor of discretionary denial.

**E. *Fintiv* Factor 5: Petitioner is defendant in parallel EDTX lawsuit.**

The fifth *Fintiv* factor weighs in favor of exercising discretionary denial because the Petitioner and the Defendant Cisco Systems, Inc. are the same party.

**F. *Fintiv* Factor 6: Other circumstances that impact the Board’s exercise of discretion, including the merits, favor denial.**

As discussed in detail in Section III below, the consideration of all other relevant factors also weighs against institution.

**III. OTHER HOLISTIC CONSIDERATIONS COMPEL DENIAL**

Beyond the procedural overlap of parallel proceedings, a holistic assessment of factors supporting the “efficiency and integrity of the system” warrants denial. *See Fintiv*, Paper 11 at 6. Under the March 2025 Memo at 2, “the parties are permitted to address *all* relevant considerations”, including: (1) settled expectations of the parties, such as the length of time the claims have been in force; (2) strength

of the unpatentability challenge; and (3) extent of the petition's reliance on expert testimony. Here, consideration of these and other factors demonstrate that institution would reward tactical delay and undermine the stability of the patent system.

**A. The '556 patent's near eight-year history, including industry licensing, creates strong settled expectations that warrant denial.**

The “settled expectations” doctrine promotes stability by protecting long-standing patents under a heightened presumption of validity. *See Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21, at 2-3 (PTAB June 18, 2025) (informative) (denying institution where “the challenged patent has been in force almost eight years, creating settled expectations”); *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 11 at 3 (PTAB June 26, 2025) (denying institution where “strong settled expectations” existed for seven- and nine-year-old patents) *aff'd In re Cambridge*, 2025 WL 3526129 (Fed. Cir. Dec. 9, 2025); *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9 (July 24, 2025) (informative) (denying institution where “the challenged patents have been in force for seven and six years, respectively, creating strong settled expectations for Patent Owner”). Recently designated informative decisions emphasize that the longer a patent has been in force, the more settled the expectations of the patent owner. *See Precedential and informative decisions*, USPTO, <https://www.uspto.gov/patents/ptab/precedential-informative-decisions> (designating in 2025 as informative each of *Dabico*, IPR2025-00408, Paper 21;

*Amgen*, IPR2025-00601, Paper 9; *Alliance Laundry Sys., LLC v. PayRange LLC*, IPR2025-00950, Paper 11 (PTAB Sept. 19, 2025)). The Federal Circuit has repeatedly rejected challenges to the use of “settled expectations” as a denial factor. *See In re Google LLC*, 2026 WL 204945, at \*1 (Fed. Cir. Jan. 27, 2026) (citing *In re Sandisk Techs.*, 2025 WL 3526507 (Fed. Cir. Dec. 9, 2025)).

Critically, the ’556 patent was issued on August 14, 2018 and has been in force for nearly ***eight years***. By the time the Board issues a Final Written Decision in July 2027, the ’556 patent will have been in force for ***more than nine years***. The Board has increasingly adopted a “six-year guideline” for this factor, noting that once a patent surpasses the six-year statute of limitations for past damages found in 35 U.S.C. § 286, expectations regarding its validity become significantly more established. *See Dabico*, IPR2025-00408, Paper 21 at 3 (stating this approach “aligns with other approaches to settled expectations and incentives, for example, for filing infringement lawsuits”). The ’556 patent has now far exceeded this six-year threshold. As such, Patent Owner should be afforded “strong settled expectations” to heavily favor a discretionary denial in this proceeding.

Furthermore, these settled expectations are reinforced by Petitioner’s own conduct. As alleged in the parallel litigation, Petitioner was on notice of the ’556 patent as early as 2023. *Compare* Ex. 2007 (Complaint) at ¶ 113 with Ex. 2008 (Answer) at ¶ 113. Despite this knowledge, Petitioner waited nearly three years—

until the litigation was in an advanced stage and the patent was nearing its eighth anniversary—to file its Petition. In *iRhythm Tech., Inc. v. Welch Allyn, Inc.*, the Director found a petitioner’s long-standing awareness of a patent, combined with a decade-long period of enforceability, created “settled expectations” justifying discretionary denial even when other factors favored institution. IPR2025-00363, Paper 10 at 3 (PTAB June 6, 2025); *see also Ericsson Inc. v. Procomm International PTE. Ltd.*, IPR2024-01452, Paper 16, at 2-3 (PTAB June 25, 2025) (the patent’s long enforcement period and Petitioner’s prior awareness of the patent tipped the balance of the holistic assessment in favor of discretionary denial).

Also, the ’556 patent has been licensed since 2021, a fact that reinforces Patent Owner’s settled expectations in the patent’s validity. *See* Ex. 2009 (Golden Eye’s Chief Licensing Officer, Mr. Curtis Dodd, explaining that the ’556 patent is licensed to “multiple third parties, including Fortune 500 companies and leaders in the wireless networking industry”); Ex. 2010 (licensing webpage proving public notice of Patent Owner’s licensing program); *see also Alliance*, IPR2025-00950, Paper 11 at 3 (finding settled expectations from licensing, even for a relatively young patent).

Allowing Petitioner’s challenge to proceed now would disturb Patent Owner’s settled expectations and reward Petitioner’s tactical delay. The ’556 patent has enjoyed over seven and a half years of undisturbed validity without Petitioner seeking an earlier review. This consideration which weighs heavily in favor of

discretionary denial.

**B. The Petition’s lack of merit warrants denial.**

The Board considers assessment of the merits of the Petition in its holistic approach to the *Fintiv* factors. Here, the merits of the Petition suffer from a number of fatal flaws. As an initial sign of weakness, the Petition fails to identify any single anticipatory reference that discloses each and every element of any challenged claim. As a result, Petitioner must overcome a substantial hurdle in showing that a person of ordinary skill in the art would have combined the disparate teachings of the cited references, Choudhary and Hasty, to arrive at the claimed invention. Crucially, the Petition fails to bridge the material gap between Hasty’s mesh-routing logic and the ’556 patent’s specific requirements for receiving a probe request and selectively transmitting a probe response. Because Choudhary and Hasty operate in fundamentally different network topologies and seek to address different problems, the Petition fails to demonstrate that a person of ordinary skill in the art would have looked to Hasty’s mesh-layer path loss calculation to solve the active scanning challenges addressed by the ’556 patent.

The Petition fails to comply with 37 C.F.R. § 42.104(b) by not identifying the specific structural requirement of at least claim elements [1.1], [9.1], [10.1], and [11.1]. “a probe request frame *including information on a signal strength.*” This deficiency cascades to other elements, such as the “probe response” which is

expressly conditioned upon receiving the request. Petitioner concedes that the reference Choudhary lacks a probe request frame including such information on a signal strength (Pet. at 32-35) and attempts to bridge this gap by importing Hasty's transmit power level (TPL) value. Pet. at 19-24. However, because Hasty's solution is directed to routing optimization, not access point discovery, it fails to disclose or even suggest that a TPL value should be "included" in a probe request frame during an active scan.

The Petition does not explain why a person of ordinary skill in the art would combine Hasty's routing logic with Choudhary's scanning method to disclose the claimed probe request. Hasty relates to Layer II *routing* where established nodes evaluate multiple transmission paths to other nodes to determine the most efficient link. Ex. 1006 at 2:1-14; 4:55-64; Figs 3-5. Notably, the nodes in Hasty have already joined the same ad hoc network. Ex. 1006 at 1:23-34. In contrast, Choudhary discloses RSSI filtering for stations seeking to join an infrastructure-based wireless network where only one direct communication path exists between the station and an AP. Ex. 1005 at 7:4-35. The objectives of each reference are very different. Petitioner fails to address these substantial differences and thus fails to establish why the teachings of Hasty would be applicable to the network of Choudhary.

Furthermore, the Petition fails to address that grafting Hasty's use of a TPL value to calculate "path loss" of different paths, for purposes of making routing

decisions, onto Choudhary approach to responding to probe requests, would fundamentally alter Choudhary's mode of operation. Choudhary's filtering mechanism is designed to identify and respond only to probe requests whose RSSI exceeds a threshold to ensure proximity. Ex. 1005 at 8:42-57. In contrast, Hasty utilizes path loss to evaluate the efficiency of multi-hop links within an established mesh network—a context where multiple routes to a destination exist. Ex. 1006 at 4:55-64. In Choudhary's infrastructure-based discovery, there is only a *single direct path* between a station and an AP—calculating path loss provides no comparative benefit. Importing Hasty would undermine Choudhary's core logic since an AP could be forced to ignore a station with a sufficiently high RSSI simply because its calculated path loss (relative to its internal transmit power) was high. This would cause Choudhary to fail its primary purpose of proximity-based discovery based on RSSI, creating a technical conflict that the Petition's speculation fails to resolve.

Hasty's peer-to-peer context differs materially from the '556 patent, which utilizes "information on a signal strength" specifically for *network discovery using a probe request*. Unlike the challenged claims, Hasty's nodes do not utilize a probe-based exchange to [9.1] "receiv[e], from a station, a probe request," [9.2] "transmit[], to the station, a probe response," and [9.3] "access" to the network. The Petition's failure to identify a combination that discloses these integrated discovery steps renders its challenge to the claims deficient and unlikely to meet the threshold for

institution. Other deficiencies of the Petition are discussed in Patent Owner's forthcoming Preliminary Response. As will be demonstrated, the Petition's lack of merit heavily favors a discretionary denial.

**C. Petitioner's excessive reliance on expert testimony to fill gaps in the prior art favors denial.**

The Petition cites Dr. Hansen's 92-page declaration (Ex. 1003) at least 50 times to justify features absent in the cited references. For example, Petitioner argues that "a POSITA would have found it obvious for Choudhary's probe request to include a power transmit level to allow the access point to use path loss as a quality metric derived from RSSI." Pet. at 19-24. Petitioner relies heavily on Dr. Hansen to assert that path loss is a "known, suitable option." *See* Pet. at 22-24 (citing Ex. 1003, ¶¶54-58). But Dr. Hansen's testimony is relied on to stretch Choudhary's statement regarding "RSSI filtering . . . based on RSSI or *some metric derived from RSSI*" (*see* Pet. at 19-22, emphasis is Petitioner's, citing Ex. 1003, ¶¶46-53). In attempting to fill the gap in the prior art, Dr. Hansen inaccurately interprets Hasty's path loss formula based on a TPL value as a "known metric[] derived from RSSI" to satisfy the "information on a signal strength" in elements [9.1], [1.1], [10.1], and [11.1].

Dr. Hansen's leap to Hasty's path loss formula improperly conflates Choudhary's MAC-layer filtering of probe requests with Hasty's routing-layer metrics. Path loss is not an "RSSI-derived metric," as suggested. It *cannot* be calculated from RSSI alone, but requires the station's TPL value, which Choudhary

does not disclose and has no reason to include in a probe request. Without information on a signal strength included in the probe request, the AP cannot perform the calculation Dr. Hansen proposes. This is merely hindsight reconstruction by Petitioner and is supported only by its reliance on Dr. Hansen.

Moreover, Dr. Hansen ignores how his modification would fundamentally subvert Choudhary's mode of operation. As explained above, applying Hasty's path-loss logic could force the rejection of a nearby station that otherwise satisfies Choudhary's RSSI threshold, which would undermine the core proximity-discovery goal of the reference. By ignoring this technical conflict in the references and the absence of a required TPL value, Dr. Hansen's testimony serves as improper gap-filling that overlooks the basic incompatibilities between Choudhary and Hasty.

Other instances of Dr. Hansen's overreach include offering vague contentions that certain teachings are "consistent with" claimed language as a substitute for evidence. For example, Dr. Hansen claims that Hasty's use of path loss as a quality metric is "consistent with" Choudhary's goal of "only responding to probe requests for mobile stations that are close enough for a quality connection" *See* Pet. at 21-22 (citing Ex. 1003, ¶51). He similarly equates Hasty's routing-path assessment with Choudhary's goal to test "if the client is close enough to the AP to benefit from associating with the AP." *Id.* (citing Ex. 1003, ¶52).

However, high-level observations of general intent from the references cannot

substitute for the disclosure of the claimed requirements of the '556 patent. Dr. Hansen fails to explain how Hasty's path-loss logic would have been beneficially applied to Choudhary's infrastructure environment, where only a single direct path exists between station and AP. In this context, Hasty's focus on avoiding high path-loss routes would actively contradict Choudhary's goal. An AP, for example, might erroneously ignore a proximal station with a sufficient RSSI simply because its path loss was deemed too high. Thus, Dr. Hansen's "consistency" arguments are merely conclusory and fail to establish a *prima facie* case of obviousness.

The Petition attempts to plug these gaps with Dr. Hansen's conclusory opinions. In actuality, Dr. Hansen uses the claims as his roadmap to reconstruct the '556 patent's scanning architecture via impermissible hindsight. The Petition's over-reliance on expert testimony highlights Petitioner's failure to establish that the prior art discloses all claim elements or provides a viable rationale for their combination.

#### **IV. CONCLUSION**

On balance, the evidence of record favors exercising discretion to deny institution of the Petition on *Fintiv* grounds, the strong settled expectations of the Patent Owner, the weakness of the merits, and the over reliance on expert testimony.

Case IPR2026-00186  
Patent 10,051,556

Dated: March 13, 2026

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**CERTIFICATION REGARDING PAGE COUNT**

Pursuant to 37 C.F.R. §42.24(d) and the Interim Director Discretionary Process web page at II.C.ii, Patent Owner certifies that its Brief Requesting Discretionary Denial is limited to 20 pages and that there are 4912 words in the paper, each count excluding the portions exempted under 37 C.F.R. §42.24(a)(1).

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that document has been served via electronic mail on March 13, 2026, to Petitioner at the email address Theodore M. Foster at ipr.theo.foster@haynesboone.com; David L. McCombs at david.mccombs.ipr@haynesboone.com, Gregory P. Huh at gregory.huh.ipr@haynesboone.com and Calmann J. Clements at calmann.clements.ipr@haynesboone.com, pursuant to Petitioner's consent in its Petition at p. 66.

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