UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZAK DESIGNS, INC.,

Petitioner

v.

CAMELBAK PRODUCTS, LLC.

Patent Owner.

Case: IPR2022-00803

Patent 9,782,028

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBIT LIST

Exhibit	Description
Ex. 2001	*CamelBak Products, LLC v. Zak Designs, Inc.*, No. 5:21-cv-05109, Dkt. 2 (W.D. Ark. June 11, 2021) ("Parallel Litigation Complaint")
Ex. 2002	*CamelBak Products, LLC v. Zak Designs, Inc.*, No. 5:21-cv-05109, Dkt. 51 (W.D. Ark. June 29, 2022) ("Parallel Litigation Scheduling Order")
Ex. 2003	*CamelBak Products, LLC v. Zak Designs, Inc.*, No. 5:21-cv-05109, Dkt. 50 (W.D. Ark. June 29, 2022) ("Parallel Litigation Order Denying Motion To Stay")
Ex. 2004	*CamelBak Products, LLC v. Zak Designs, Inc.*, No. 5:21-cv-05109, Dkt. 40 (W.D. Ark. Mar. 7, 2022) ("Parallel Litigation Order Denying Motion To Transfer")
Ex. 2005	November 7, 2018 Letter from CamelBak to Zak providing notice of infringement of the '028 patent
Ex. 2006	*CamelBak Products, LLC v. Zak Designs, Inc.*, No. 5:21-cv-05109, Dkt. 14 (W.D. Ark. June 28, 2021) (proof of service of summons)

I. INTRODUCTION

Patent Owner CamelBak Products, LLC ("Patent Owner") respectfully requests that the Board exercise its discretion to deny institution under 35 U.S.C. § 314(a) in view of the parallel district court litigation between the parties: *CamelBak Products, LLC v. Zak Designs, Inc.*, No. 5:21-cv-05109 (W.D. Ark. June 11, 2021) ("Parallel Litigation"). There, the challenged '028 patent was asserted in a complaint filed over thirteen months ago. Ex. 2001 (Complaint), 10-13. Trial is scheduled in less than a year on June 26, 2023, four months before any final written decision would be due. Ex. 2002 (Parallel Litigation Scheduling Order), 1. The district court already denied Petitioner's motion to stay the Parallel Litigation and provided no indication that the court would consider a renewed motion to stay if a PTAB trial is instituted. Ex. 2003 (Parallel Litigation Order Denying Motion To Stay), 1, 8-9. Moreover, despite the readily-apparent inefficiencies and duplication of effort that would occur if the same invalidity theories were to be adjudicated against the same challenged claims of the '028 patent several months prior to any final written decision in this proceeding, Petitioner considered, but declined to include, any stipulation not to pursue the same invalidity theories in the Parallel Litigation. Pet. at 97.

Accordingly, the Board should deny institution of this IPR to avoid the inefficient and unnecessary duplication of efforts. *See NHK Spring Co. v. Intri-*

Plex Techs., Inc., IPR2018-00752, Paper 8 at 19-20 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 2-3 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020) ("*Fintiv Order*").[1]

II. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 314(A)

Under § 314(a), the Director has discretion to deny institution of an *inter partes* review. *See* 37 C.F.R. § 42.4(a) ("The Board institutes the trial on behalf of the Director."); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) ("[T]he agency's decision to deny a petition is a matter committed to the Patent Office's discretion."); *SAS Inst., v. Iancu*, 138 S. Ct. 1348, 1356 (2018) ("[Section] 314(a) invests the Director with discretion on the question whether to institute review . . . ." (emphasis omitted)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.").

[1] For the purposes of this Patent Owner Preliminary Response, *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 will be referred to as "*Fintiv Order*" and *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (PTAB May 13, 2020) (order denying institution) (informative, designated July 13, 2020) will be referred to as "*Fintiv I.D.*".

In *NHK Spring*, the Board denied institution relying in part on § 314(a) because the parallel district court proceeding was scheduled to finish before the Board reached a final decision. IPR2018-00752, Paper 8 at 20-21. Following *NHK Spring*, the Board articulated the following factors for consideration when determining whether to exercise discretion to deny institution in view of a parallel district court proceeding:

> 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; and
>
> 6. other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv Order at 5–6. "These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial

date in the parallel proceeding." *Id.* at 6. These factors properly apply to the situation, as here, of an advanced-stage parallel district court litigation.

As discussed below, all six *Fintiv* factors favor denial of institution here.

A. The Denial Of Petitioner's Stay Motion In The Parallel Litigation Favors Denial Of Institution

Factor 1 concerns whether the district court granted a stay or evidence exists that one may be granted if a proceeding is instituted. *Fintiv Order* at 6; *Fintiv I.D.* at 12. This factor weighs against institution.

Petitioner already sought, and the district court already denied, Petitioner's motion to stay. Ex. 2003, 1; *id.*, 4 ("After weighing the relevant factors, the Court finds a stay pending resolution of the PTO proceedings is not warranted.").

This factor also considers whether the district court provided any indication that the court would reconsider a renewed motion for stay if a PTAB trial is instituted. See *Fintiv Order* at 6-7 (guidance from a "district court [that] has denied a motion for stay without prejudice and indicated to the parties that it will consider a renewed motion or reconsider a motion to stay if a PTAB trial is instituted" would, "if made of record, suggest[] the district court may be willing to avoid duplicative efforts and await the PTAB's final resolution of the patentability issues raised in the petition before proceeding with the parallel litigation"). Here, the district court did not provide any indication that the court would consider a renewed motion to stay if a PTAB trial is instituted. Ex. 2003, 5-8; *Fintiv Order* at

7-8 ("If a court has denied a defendant's motion for a stay pending resolution of a PTAB proceeding, and has not indicated to the parties that it will consider a renewed motion or reconsider a motion to stay if a PTAB trial is instituted, this fact has sometimes weighed in favor of exercising authority to deny institution under *NHK*.").

Not only did the district court decline to provide any indication that it would consider a renewed motion to stay, its reasoning makes clear that whether this IPR proceeding is instituted would have no impact on its analysis. Ex. 2003, 5-8. In particular, the order denying stay acknowledges that "the PTO has not decided whether either of Zak's challenges have sufficient merit to proceed," but rather than find it important to wait for such a decision, the order found it "[m]ore important to the simplification analysis [] that the PTO proceedings have the potential to resolve only a minority of the issues in this case." Ex. 2003, 5. Furthermore, the district court observed that even if Petitioner succeeded in this IPR, it would not eliminate any of the accused products from the Parallel Litigation. *Id.*, 5-6. In addition, given that Patent Owner and Petitioner "are direct competitors in the marketplace," the district court found that "[i]f this case were stayed for a lengthy period of time, [Patent Owner] could lose considerable ground in the marketplace as a result of the allegedly infringing products." *Id.*, 7. Lastly, district court expressed "concern for the efficient management of its docket" given its "obligation under Federal Rule of

Civil Procedure 1 'to secure the just, speedy, and inexpensive determination of every action and proceeding.'" *Id.*, 8 ("This case has already been delayed and could languish for years if a stay were granted. Given this loss in efficiency, the marginal simplification attainable by waiting for the PTO's decisions, and the undue prejudice to CamelBak, the Court finds a stay is not warranted in this case.").

Accordingly, the denial of Petitioner's motion to stay the Parallel Litigation favors exercising discretion to deny institution. *F5 Networks, Inc. v. WSOU Investments, LLC*, IPR2022-00238, Paper 11 at 6-7 (PTAB May 19, 2022) ("Patent Owner notes that the court in the underlying litigation recently denied Petitioner's motion to stay that case pending this and another *inter partes* review proceeding…We find that the court's denial of the motion to stay weighs in favor of exercising authority to deny institution."); *see also Canadian Solar Inc. v. The Solaria Corp.*, IPR2021-00095, Paper 12 at 9 (PTAB May 26, 2021) ("[T]he parties agree that the ITC will not stay its investigation… Accordingly, we weigh this factor in favor of exercising our discretion to deny institution.").

B. The Trial Date In The Parallel Litigation Favors Denial Of Institution

The second *Fintiv* factor—the proximity of the court's trial date to the Board's projected statutory deadline for a FWD—weighs in favor of denial. *Fintiv Order* at 9. The statutory deadline for the final written decision (FWD) for this IPR

Proceeding, if instituted, would be no later than October 27, 2023. Meanwhile, trial in the Parallel Litigation is set to begin June 26, 2023, which is four months before the Final Written Decision would be due in this IPR proceeding (should it be instituted). *See* Ex. 2002, 1.

Under Factor 2, the earlier trial date in the Parallel Litigation weighs against institution. *See Fintiv Order* at 9 ("If the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*."). As *NHK Spring* explained, one of the primary objectives of the AIA was "to provide an effective and efficient ***alternative***" to parallel litigation. *NHK Spring* at 19–20 (quoting *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha,* IPR2016-01357, Paper 19, 15-19 (PTAB. Sept. 6, 2017) (precedential, designated Oct. 18, 2017) (emphasis added).

In evaluating the proximity of a court's trial date to the projected statutory deadline for a FWD, the Board "generally take courts' trial schedules at face value absent some strong evidence to the contrary." *Fintiv I.D.* at 13. Here, there is no evidence, must less strong evidence, that the district court in the Parallel Litigation intends to move the scheduled trial date. To the contrary, the district court already expressed "concern for the efficient management of its docket" if the Parallel Litigation were stayed and its respect for its "obligation under Federal Rule of

Civil Procedure 1 'to secure the just, ***speedy***, and inexpensive determination of every action and proceeding.'" Ex. 2003, 8 (emphasis added).

Accordingly, when considering a parallel proceeding set for trial four months prior to the projected statutory deadline for a FWD, the Board routinely has found the second *Fintiv* factor to favor exercising discretion to deny institution. *Immersion Systems LLC v. Midas Green Techs., LLC*, PGR2021-00104, Paper 15 at 11 (PTAB Jan. 31, 2022) (finding Factor 2 "weigh[s] in favor of exercising discretion to deny institution" where "a jury trial is scheduled to occur in the related district court litigation approximately four months prior to when a final written decision would be statutorily due"); *Daiichi Sankyo, Inc. v. Seagen Inc.*, PGR2021-00042, Paper 12 at 15 (PTAB June 24, 2021) ("[W]here trial in the parallel proceeding is scheduled to occur nearly four months prior to our Final Written Decision, we determine that the facts underlying this factor weigh toward denying institution."); *Allergan, Inc. v. BTL Healthcare Techs. A.S.*, PGR2021-00015, Paper 16 at 13 (PTAB June 17, 2021) ("The Final Determination is more than four months before a final written decision would be due if we did institute a post-grant review. Thus, this *Fintiv* factor favors the exercise of discretion to deny institution of post-grant review."); *Canadian Solar Inc. v. The Solaria Corp.*, IPR2021-00095, Paper 12 at 10 (PTAB May 26, 2021) ("Because the ITC is scheduled to complete its investigation approximately three months before the due

date for the final written decision, this factor weighs in favor of exercising our discretion to deny institution").

Thus, the second *Fintiv* factor favors denial of institution.

C. The Investment By The Parties In The Parallel Litigation And Petitioner's Unexplained Delay In Filing The Petition Favor Denial Of Institution

The third *Fintiv* factor "is related to the trial date factor, in that more work completed by the parties and court in the parallel proceeding tends to support the argument that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs." *Fintiv Order* at 9–10. The third *Fintiv* factor also considers whether "the petitioner did not file the petition expeditiously," and "if the petitioner cannot explain the delay in filing its petition, these facts have favored denial." *Id.* at 11.

Investment by the parties and court is judged from the date of the institution decision, which is expected to be by October 27, 2022. *See Fintiv Order* at 9 (considering "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") (emphasis added). Here, the court has already ruled on two dilatory motions, denying Petitioner's motion to transfer and motion to stay. Ex. 2004; Ex. 2003. In addition, Patent Owner served its infringement contentions, both parties served discovery requests and responses, and, by the time of an institution decision,

Petitioner will have served invalidity contentions, Patent Owner will have served damages contentions, and the parties will have completed claim construction discovery, with claim construction briefing and a hearing following soon thereafter. Ex. 2002, 2-3. Moreover, opening expert reports (including Petitioner's expert report on invalidity) are due Jan. 24, 2023, rebuttal expert reports are due Feb. 24, 2023, the discover cutoff is Mar. 17, 2023, and dispositive motions are due Mar. 24, 2023. Ex. 2002, 3-4.

The *Apple v. Fintiv* case was in a similar procedural posture, except the FWD deadline was only two months after that trial, whereas the FWD deadline here is four months after the trial set in the district court case. In that case, the Board noted with respect to Factor 3 that "this factor weighs somewhat in favor of discretionary denial in this case." *Fintiv I.D.* at 14. Here, Factor 3 weighs even more heavily against institution due to the instant district court case being even closer to trial. *See Intel Corp. v. VLSI Tech. LLC*, IPR2020-00106, Paper 17 at 9 (PTAB May 5, 2020) (denying institution where final infringement and invalidity contentions had been served and fact and expert discovery were set to close within two months).

In addition, where "the evidence shows that the petitioner did not file the petition expeditiously," such evidence also favors denial. *Fintiv Order* at 11-12. Here, Patent Owner and Petitioner engaged in extensive pre-suit communications,

and Petitioner had actual notice of Patent Owner's allegations of infringement regarding the '028 patent since at least Nov. 7, 2018. Ex. 2005, 1-2 (identifying as infringed at least claims 1-2, 5-10, 14, 16, and 21 of the '028 patent). In addition, Patent Owner filed its complaint in the Parallel Litigation on June 11, 2021 and served Petitioner with the complaint on June 24, 2021. Ex. 2001; Ex. 2006, 2.

Petitioner has no excuse for delaying filing its petition until April 19, 2022, over three years after it became aware of asserted claims of the '028 patent, and 10 months in to the Parallel Litigation. Pet. at 97. Petitioner's unexplained delay further favors denial of institution.[2] *See F5 Networks*, IPR2022-00238, Paper 11 at 10 (finding "factor [3] weighs in favor of discretionary denial" when Petitioner waited "nearly a year" to file IPR petitioner and "Petitioner does not attempt to justify the time frame in which it chose to file the Petition."); *Hewlett Packard Enterprise Co. v. Q3 Networking LLC*, IPR2021-00754, Paper 9 at 11 (PTAB Oct. 8, 2021) ("Petitioner, however, has not argued that it was diligent in filing its Petition … [T]his factor favors the exercise of discretion to deny institution of inter

[2] Even the district court remarked on Petitioner's delay in filing its IPR petition. Ex. 2003, 8 ("Zak itself waited months into this litigation after the Court had denied Zak's Motion to Transfer-to file its requests with the PTO and move for a stay.").

partes review."); *Cisco Systems, Inc. v. Estech Systems, Inc.*, IPR2021-00333, Paper 12 at 11 (PTAB July 7, 2021) ("We cannot say that Petitioner was diligent in filing the Petition, as Petitioner does not adequately explain its delay in filing the Petition. *See Fintiv*, Paper 11 at 11–12. Given the foregoing, we find that the trial date and investment in the Texas Litigations ***strongly favor exercising our discretion to deny institution***") (emphasis added).

Thus, *Fintiv* Factor 3 strongly favors denial of institution.

D. The Likely Overlap Of Issues Raised In The Petition And The Parallel Litigation Favors Denial Of Institution

The fourth *Fintiv* factor addresses "concerns of inefficiency and the possibility of conflicting decisions" presented by the overlap of issues raised in the petition and the parallel proceeding. *Fintiv Order* at 12 ("[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"). The fourth Fintiv factor also considers "whether all or some of the claims challenged in the petition are also at issue in district court." *Id.* at 13.

There is a high risk of overlap of issues raised in the petition and the Parallel Litigation that presents concerns of inefficiency and the possibility of conflicting decisions. In particular, Petitioner's invalidity contentions in the Parallel Litigation are due Aug. 12, 2022. Ex. 2002, 2. Despite the foreseeable overlap in invalidity issues between its petition and the invalidity issues presented in the Parallel

Litigation, Petitioner considered, yet refused, to include a stipulation in its petition to address such concerns, instead seeking to delay any decision on a stipulation until after institution. Pet. at 97 ("***If*** IPR is instituted and overlap somehow becomes an issue, Petitioner ***is amenable*** to stipulating …") (emphasis added). At the time Petitioner filed its petition, the Board's informative and precedential decisions regarding a Petitioner stipulation to mitigate the concern presented by this factor were well known. *See Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 11-12 (PTAB June 16, 2020) (informative, designated July 13, 2020); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020) (precedential, designated Dec. 17, 2020). Accordingly, Petitioner's awareness of such stipulations, yet refusal to include any such stipulation with its petition, only heightens the concern of overlap in issues between this proceeding and the Parallel Litigation.

In addition, to the extent conditions are met and P.O. later seeks to offer a stipulation, the Board should prohibit such gamesmanship by disregarding the stipulation. *See Global Tel*Link Corp. v. HLFIP Holding, Inc.*, IPR2021-00444, Paper 24 at 3, 5-6 (PTAB Jan. 14, 2022) (maintaining discretionary denial of institution and disregarding Petitioner's belated submission of "new evidence, in the form of an email stipulation" that Petitioner could have submitted earlier); *id.*

at 7 ("Petitioner should not be given a second bite at the apple … doing so [] would encourage litigants adverse to patent owners to delay making stipulations until after the Board has rendered a decision on whether to institute.").

In addition, the substantial overlap between the claims challenged in this proceeding and the claims asserted in the Parallel Litigation only heightens the risk of overlap of issues. In particular, Patent Owner asserted claims 1-3, 5-6, 8-10, 13, 16, 21 of the '028 patent against Petitioner in the Parallel Litigation, whereas Petitioner challenged claims 1-2, 5-10, 14, 16, and 21. Pet. at 1. Accordingly, there is substantial overlap in the challenged claims and the claims at issue in the Parallel Litigation, with only two challenged claims (7 and 14) not at issue in the Parallel Litigation, and two asserted claims in the Parallel Litigation (3 and 13) not challenged in this proceeding. This minimal number of non-overlapping claims does not support institution, particularly where, as here, Petitioner did not argue that the non-overlapping claims differ significantly in some way or that it would be harmed by non-institution. *See Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00961, Paper 10 at 14 (P.T.A.B. Oct. 16, 2019) (denying institution despite zero claim overlap because petitioner did "not argue that the non-overlapping claims differ significantly in some way or that it "would be harmed if [the Board did] not institute"); *VIZIO, Inc. v. Polaris PowerLED Technologies, LLC*, IPR2020-00043, Paper 30 at 11 (P.T.A.B. May 4, 2020) ("Petitioner has not provided argument as

to why the additional challenges to the dependent claims in the Petition provide a meaningful distinction between the two proceedings.").

Thus, the fourth *Fintiv* factor favors denial of institution.

E. The Identity Of The Parties Favors Denial Of Institution

The fifth *Fintiv* factor considers "whether the petitioner and the defendant in the parallel proceeding are the same party." *Fintiv Order* at 13−14. Here, Petitioner and the defendant in the Parallel Litigation are the same party—Zak Designs, Inc. Pet. at 97 ("Petitioner is a defendant in the related litigation"). Accordingly, this factor weighs in favor of discretionary denial. *Fintiv I.D.* at 15 ("Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial."); *F5 Networks*, IPR2022-00238, Paper 11 at 12 ("We determine that the fifth *Fintiv* factor favors exercising our discretion to deny institution because Petitioner [] is a defendant in the underlying litigation."); *Hillman Group, Inc. v. Hy-Ko Prods. Co. LLC*, IPR2022-00174, Paper 8 at 14 (PTAB May 9, 2022) ("Petitioner here is the same party as the defendant in the Texas Litigation…. This factor weighs in favor of discretionary denial.").

F. Other Factors Favor Denial Of Institution

The sixth *Fintiv* factor considers other facts and circumstances that may impact the Board's exercise of discretion, which may include consideration of the

merits. *Fintiv Order* at 14; *Fintiv I.D.* at 15. For example, "if the merits of a ground raised in the petition seem particularly strong on the preliminary record, this fact has favored institution," whereas "if the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present." *Fintiv Order* at 14-15. "A full merits analysis is not necessary as part of deciding whether to exercise discretion not to institute …." *Fintiv I.D.* at 15.

Here, although Petitioner states that "[t]he merits are strong" (Pet. at 97), this conclusory assertion is belied by Petitioner's assertion of **fourteen grounds**, presenting numerous and burdensome alternative combinations of the Yamashita, Paczonay, Dall'Agnese, Manganiello, and Anderson references. Pet. at 3. *See Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 at 19 (Mar. 6, 2019) (informative, designated Aug. 2, 2019) (exercising discretion to deny institution, taking into account the large number of prior art combinations encompassed by Petitioner's grounds: "Petitioner's contention encompasses nine combinations with Bendel and another eight distinct combinations with Sartorius, for a total of seventeen possible combinations. Even that conservative interpretation of Petitioner's contention yields an unduly burdensome number of combinations.").

Lastly, if instituted, Patent Owner will address the lack of merits of these grounds in its Response. Patent Owner's decision to focus this Preliminary

Response on the *Fintiv* factors that, on balance, strongly weigh in favor of exercising discretion to deny institution should not impact the analysis of these factors. *See Hewlett Packard Enterprise Co. v. Q3 Networking LLC*, IPR2021-00754, Paper 8 (P.O. preliminary response arguing only discretionary denial); IPR2021-00754, Paper 9 (PTAB Oct. 8, 2021) (exercising discretion to deny institution); *3Shape Trios A/S v. Densys Ltd.*, IPR2021-00236, Paper 7 (P.O. preliminary response arguing only discretionary denial); IPR2021-00236, Paper 12 (PTAB May 20, 2021) (exercising discretion to deny institution); *Canadian Solar Inc. v. The Solaria Corp.*, IPR2021-00095, Paper 7 (P.O. preliminary response arguing only discretionary denial); IPR2021-00095, Paper 12 (PTAB May 26, 2021) (exercising discretion to deny institution).

Accordingly, the sixth *Fintiv* factor favors denial of institution.

III. CONCLUSION

Trial in the Parallel Litigation is set to occur beginning June 26, 2023—four months before the statutory deadline for a Final Written Decision in this IPR. The district court already denied Petitioner's motion to stay, and Petitioner did not stipulate not to pursue the same invalidity theories in the Parallel Litigation. Under the facts of this case, all six *Fintiv* factors support discretionary denial under 35 U.S.C. § 314(a).

Dated: July 27, 2022

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24 et seq., the undersigned certifies that this document complies with the type-volume limitations. This document contains 3,888 words as calculated by the "Word Count" feature of Microsoft Word 2016, the word processing program used to create it.

Dated: July 27, 2022

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4) and 42.25(b), the undersigned certifies that on July 27, 2022, a complete copy of Patent Owner's Preliminary Response and accompanying exhibits was filed electronically through the Patent Trial and Appeal Board's PTABE2E System and provided, via electronic service, to the Petitioner.

Dated: July 27, 2022

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