

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BOE TECHNOLOGY GROUP CO., LTD.,

Petitioner,

v.

OPTRONIC SCIENCES LLC,

Patent Owner.

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Case IPR2025-00239  
U.S. Patent No. 8,502,757

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

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**PATENT OWNER'S EXHIBIT LIST**

<b>No.</b>	<b>Description</b>
2001	Docket Navigator Stay Statistics
2002	February 14, 2025, DCO
2003	BOE's April 1, 2025 Invalidity Contentions
2004	Exhibit C-9 to BOE's April 1, 2025 Invalidity Contentions
2005	Exhibit C-5 to BOE's April 1, 2025 Invalidity Contentions
2006	Exhibit 2026 of IPR2024-01133, Dr. Bretschneider's Declaration
2007	Exhibit 2020 of IPR2024-01130, Dr. Bretschneider's Declaration
2008	Exhibit C-6 to BOE's April 1, 2025, Invalidity Contentions
2009	Docket Navigator Median Time-to-Trial Statistics for the Eastern District of Texas

## I. INTRODUCTION

Pursuant to the Director’s March 26, 2025 memorandum regarding Interim Processes for PTAB Workload Management (“March 26, 2025, Memo”), Patent Owner Optronic Sciences LLC requests that the Director exercise discretion under 35 U.S.C. § 314(a) and issue a decision denying institution of the Petition.

As discussed further below, each of the six *Fintiv* factors weigh in favor of discretionary denial. For Factor 1, the District Court has not entered a stay and a stay is unlikely. For Factor 2, trial in the District Court litigation will occur *several months prior* to a Final Written Decision in these proceedings, all but ensuring that the District Court will decide the validity of the challenged patent claims prior to any Final Written Decision. For Factor 3, by the time a decision on institution is granted, the parties will have already invested a significant amount of resources in the District Court litigation, including having already completed opening claim construction briefing. For Factor 4, the challenged claims in the Petition cover all asserted claims in the District Court, and Petitioner’s District Court invalidity contentions are even more expansive than the invalidity grounds asserted in the Petition. For Factor 5, Petitioner is the defendant in the District Court litigation. And for Factor 6, additional considerations favor discretionary denial, including the weakness of the merits of the Petition.

Moreover, additional relevant considerations weigh in favor of discretionary denial, including the Petition's over-reliance on unreliable expert testimony to gap-fill holes in the prior art, as well as the length of time the claims have been in force.

Patent Owner thus respectfully requests discretionary denial of the Petition.<sup>1</sup>

## **II. DENIAL OF INSTITUTION UNDER §314 IS WARRANTED.**

35 U.S.C. § 314(a) gives the Director discretion to deny institution of IPR due to the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19-21 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”). The Board has set forth six factors for determining whether discretionary denial in light of such 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;

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<sup>1</sup> Patent Owner will file a Preliminary Response addressing the merits of the Petition pursuant to 37 C.F.R. § 42.107(a) on the schedule set forth by regulation and consistent with the March 26, 2025, Memorandum. *See* 37 C.F.R. § 42.107(b).

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

*Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv I*”). In evaluating these factors, the Board “takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7-17 (PTAB May 13, 2020) (informative) (“*Fintiv II*”).

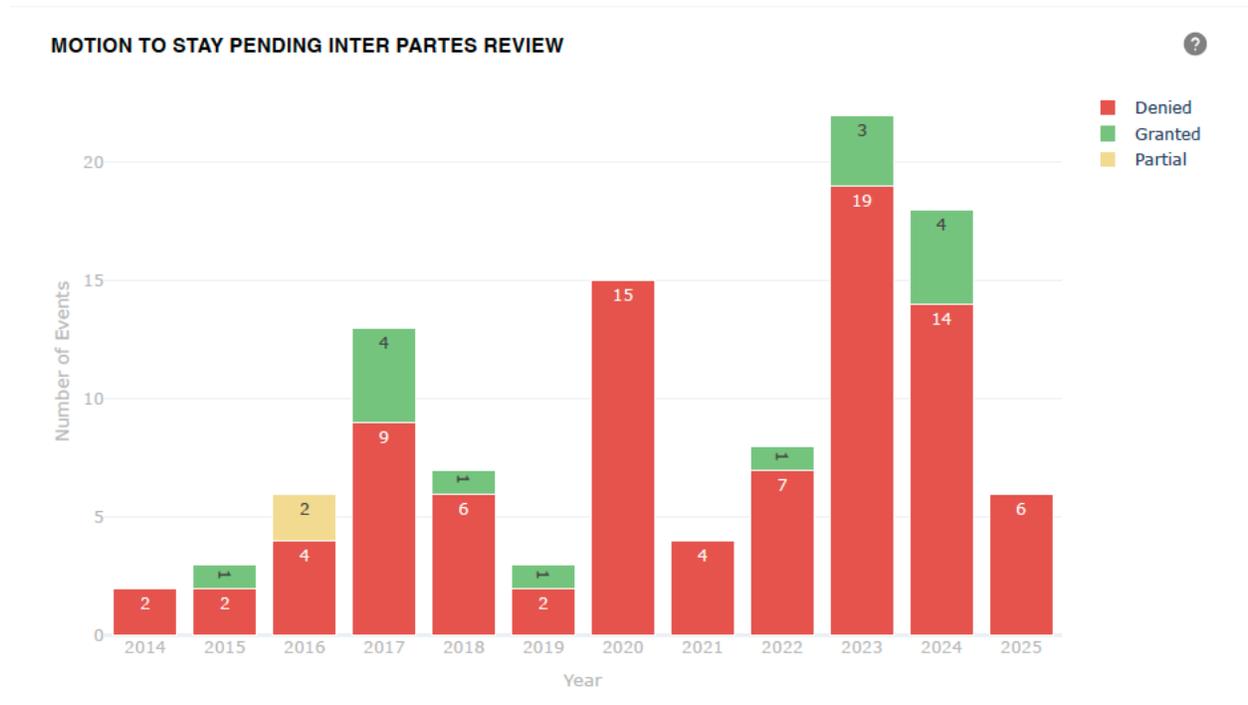
**A. *Fintiv* Factor 1: The District Court is Unlikely to Grant a Stay**

*Fintiv* Factor 1 looks to “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Fintiv I* at 5-6.

Here, the District Court has not granted a stay, and a stay is statistically unlikely. For example, while Petitioner has not yet filed a motion to stay pending IPR in the District Court proceedings, the presiding judge, Judge Rodney Gilstrap, as well as other judges in the Eastern District, have consistently explained that it is the practice of the Eastern District to deny motions to stay where, as here, IPRs have not been instituted. *See, e.g., Luminati Networks Ltd. v. Teso LT, UAB*, No. 2:19-CV-00395-JRG, 2020 WL 6803255, at \*1 (E.D. Tex. Oct. 30, 2020) (“this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.”); *see also Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV-1047-WCB, 2015 WL 1069179, at \*6 (E.D. Tex. Mar. 11, 2015) (Bryson, J.) (“it is the universal practice” in this District to deny pre-institution motions to

stay); *Viavi Sols. Inc. v. Zhejiang Crystal-Optech Co.*, No. 2:21-CV-00378-JRG, 2022 WL 16856099, at \*5 (E.D. Tex. Nov. 10, 2022) (“It is the Court’s established practice to consider that motions to stay pending IPR proceedings which have not been instituted are inherently premature and should be denied as such.”).

Moreover, even if the Board institutes IPR proceedings, it is statistically unlikely that the District Court would grant a stay. For example, an analysis of the outcomes for motions to stay pending IPR before Judge Gilstrap demonstrates that the *vast majority* of these motions have been denied; indeed, in the last five years, only *eight (8)* such motions have been granted, while *sixty-five (65)* have been denied:



See Ex. 2001 (Docket Navigator Stay Statistics).

Thus, while Patent Owner recognizes that the Board ordinarily “will not attempt to predict” how a district court will proceed if a stay has not been granted (*see Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (Jun.16, 2020) (informative)), the present facts indicate that it is unlikely that Judge Gilstrap will grant a stay.

*Fintiv* Factor 1 thus weighs in favor of discretionary denial.

**B. *Fintiv* Factor 2: The District Court Trial Will Occur Five (5) Months Before the Deadline for a Final Written Decision**

*Fintiv* Factor 2 looks to “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Fintiv I* at 5-6. “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*.” *Id.* at 9.

Here, the deadline for a final written decision is October 11, 2026, which may be extended into 2027 for good cause or in the case of joinder. 37 C.F.R. § 42.100(c). Meanwhile, the District Court trial is scheduled for May 4, 2026, which is more than five months before the statutory deadline for a Final Written Decision. *See* Ex. 2002 (Feb. 14, 2025 DCO). Moreover, while Patent Owner recognizes that trial dates may change, the median time-to-trial for the Eastern District of Texas is twenty-three (23) months. *See* Ex. 2009 (Docket Navigator Median Time-to-Trial Statistics). Because the parallel District Court

action was filed on July 23, 2024, this indicates that the District Court trial is still likely to occur at least three months prior to the statutory deadline for a Final Written Decision.

Thus, *Fintiv* Factor 2 weighs in favor of discretionary denial. *See, e.g., Samsung Elecs. Co. v. Mojo Mobility Inc.*, IPR2023-01094, Paper 11 at 8-9 (PTAB Feb. 9, 2024) (“*Mojo*”) (denying institution when trial was set before the final written decision would issue); *BOE Tech. Grp. Co. v. Element Capital Commercial Co.*, IPR2023-00808, Paper 9 at 21-22 (PTAB Nov. 15, 2023) (“*BOE*”) (same); *Vector Flow, Inc. v. HID Global Corp.*, IPR2023-00353, Paper 8 at 19-20 (PTAB July 17, 2023) (“*Vector Flow*”) (same); *Roku, Inc. v. IOEngine, LLC*, IPR2022-01551, Paper 11 at 10-11 (PTAB May 5, 2023) (“*Roku*”) (same).

Indeed, the Board has denied institution on account of even smaller gaps between the final written decision and trial. *See, e.g., EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (“*EClinicalWorks*”) (finding this factor weighed in favor of discretionary denial and denying institution where “the beginning of the jury trial in the WDTX Cases is roughly ***one or two months*** before any final decision would have been due had *inter partes* review been instituted”) (emphasis added); *Fintiv II* at 13 (finding this factor weighed in favor of discretionary denial and denying institution where the district court trial was scheduled to occur ***two months*** before the deadline for the Board to

reach a final written decision) (emphasis added); *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 20 at 5-6 (PTAB August 25, 2022) (“NXP”) (same).

Petitioner argues that there are 11 other trials scheduled for that date without citing the source for this information. Petitioner fails to account for the fact that most, if not all, of these trial will likely be resolved prior to trial, and it does not demonstrate that the underlying litigation is not likely to be the first (or among the first) in line to go to trial on the scheduled date. In light of the time to trial statistics for the District Court discussed above, even if the scheduled trial date were in conflict with another trial, the resulting delay would likely be relatively minimal and the jury verdict is still likely to be rendered months before the earliest likely date for a Final Written Decision here.

Accordingly, this factor weighs heavily against institution because trial is currently set *five months* before the statutory deadline for final written decision in this IPR and, even assuming the current trial date will change, trial is likely to occur three months before the deadline. *Fintiv II* at 13.

**C. *Fintiv* Factor 3: The Parties Will Have Invested Substantially in the District Court Case Before Any Institution Decision**

*Fintiv* Factor 3 looks to “amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision.*” *Fintiv I* at 9 (emphasis added). For example, “if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue

in the petition,” this factor favors denial. *Id.* at 9-10. “Likewise, district court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.” *Id.* at 10.

An institution decision would be due by October 11, 2025. *See* AIA § 6 (codifying 35 U.S.C. § 314(b)); *contra* Petition at 91 (stating the institution decision would be rendered “August 2025,” prior to *Markman* briefing). Prior to the deadline for an institution decision, the parties will have invested a significant amount of resources in the parallel District Court case. For example, the parties will have: 1) served extensive infringement and invalidity contentions; 2) completed claim construction discovery; 3) substantially completed document production; and 4) submitted opening Claim Construction briefing. *See* Ex. 2002 (February 14, 2025 DCO).

Thus, *Fintiv* Factor 3 weighs in favor of discretionary denial.

**D. *Fintiv* Factor 4: There is Substantial Overlap Between this IPR and the District Court Proceeding**

*Fintiv* Factor 4 looks to “whether all or some of the claims challenged in the petition are also at issue in district court” and whether the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as the parallel district court case. *Fintiv I* at 12-13. In short, this factor evaluates “concerns of inefficiency and the possibility of conflicting decisions” when substantially identical prior art is submitted in both the district court and IPR proceeding. *Id.* at 12. Here,

the challenged claims cover all asserted claims, and the prior art relied upon in the Petition and in the District Court is substantially overlapping (with the prior art relied upon in the District Court being far more expansive than the prior art relied upon in the Petition).

First, the Petition challenges claims 1-21, covering all claims that are asserted in the District Court litigation (*i.e.*, claims 1 and 16). Of the claims that are not asserted in the litigation, only claim 17 is independent and most of the limitations of claim 17 purportedly overlap with claim 1. *See* Petition at 34–42 (citing claim 1 analysis for the majority of the limitations of claim 17).

Second, all of the references relied upon by the Petition are also relied upon by Petitioner at the District Court. For example, Petitioner’s invalidity contentions in the District Court litigation assert that the ***same references and combination of references*** (Kim406, Kim730, and Senda) relied upon in the Petition anticipate or render obvious claims of the ’757 patent. *Compare* Petition at 1 *with* Ex. 2003 at 21–22 (BOE’s April 1, 2025, Invalidity Contentions); Ex. 2005 (Exhibit C-5 of BOE’s April 1, 2025, Invalidity Contentions), Ex. 2008 (Exhibit C-6 of BOE’s April 1, 2025, Invalidity Contentions). Not only are the same references included in the invalidity contentions, but the District Court invalidity contentions are far more expansive than the invalidity arguments set forth in the petition. For example, the District Court invalidity contentions include fourteen (9) total prior art patents and

applications, one (1) printed publication, and one (1) prior art system. Ex. 2003 at 28–31.

This raises “concerns of inefficiency and the possibility of conflicting decisions” (*Fintiv I* at 12), as the District Court will decide the validity of the ’757 patent claims months prior to any Final Written Decision, based on the same or substantially the same (and, indeed, far more expansive) invalidity arguments.

Additionally, while Petitioner served and filed a *Sotera*-type stipulation stating that “Petitioner will not pursue any ground that was raised or reasonably could have been raised in IPR2025-00239 in the related district court proceeding,” such a stipulation is not sufficient to ensure that IPR proceedings would be a “true alternative” to the District Court litigation. *See Sotera*, Paper 12 at 19; *see also Motorola v. Stellar*, IPR2024-01205, -01206, -01297, -01208, Paper 19 at 3–4 (March 28, 2025) (Director vacating decision granting institution where the petitioner’s “stipulation does not ensure that these [inter partes review] proceedings would be a ‘true alternative’ to the district court proceeding”).

The Board has no ability to enforce such a stipulation before the district court. Previously, this inability to enforce led to inconsistent decisions, but now the Federal Circuit has weighed in to explain “IPR estoppel does not preclude a petitioner from relying on the same patents and printed publications as evidence in asserting a ground that could not be raised during the IPR, such that the claimed invention was

known or used by others, on sale, or in public use.” *Ingenico Inc. v. IOENGINE, LLC*, No. 2023-1367, 2025 WL 1318188, at \*7 (Fed. Cir. May 7, 2025). The Director has already found, in *Motorola v. Stellar*, that a standard *Sotera* stipulation is **no longer sufficient** to determine that *Fintiv* Factor 4 weighs in favor of institution where the district court invalidity contentions “are 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.” *Motorola v. Stellar*, Paper 19 at 4 (March 28, 2025) (“although Petitioner’s *Sotera* stipulation may mitigate some concern of duplication between the parallel proceeding and this proceeding, the stipulation does not outweigh the substantial investment in the district court proceeding or *Fintiv* factors 1, 2, and 5...”). With the Federal Circuit’s narrow interpretation of IPR estoppel, a *Sotera* stipulation, on its own, has nearly no value in preventing overlap between an IPR and district court actions.

Here, Petitioner’s stipulation does not provide any assurance that there will be no substantial overlap between the District Court proceedings and the proposed IPR proceedings. Indeed, Petitioner’s stipulation does **not** cover combinations of any art (including the art asserted in this IPR) with unpublished system art, rendering Petitioner’s stipulation insufficient to ensure that the IPR proceedings are a “true alternative” to the District Court proceedings. This is particularly salient in view of Petitioner’s other, far more expansive invalidity contentions in the District Court

proceedings.<sup>2</sup> *See, e.g.*, Ex. 2004 (Exhibit C-9 of BOE’s April 1, 2025, Invalidity Contentions) (combining prior art system with all the references in this IPR as well as additional references).

Additionally, Petitioner’s stipulation still permits subsequent *ex parte reexamination* petitions on grounds that could have been raised in the Petition, should Petitioner not receive its preferred outcome here. Thus, Petitioner’s stipulation still allows for repeated challenges to the same patent by the same defendant in multiple venues, obviating the very purpose of the IPR process to streamline the patent system and reduce litigation costs. *See, e.g.*, H.R. Rep. No. 112-98, at 39–40 (2011) (“The legislation is designed to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.”). While the Director’s concerns in *Motorola v. Stellar* focused on concerns over the duplication between the PTAB and District Court proceedings, expecting the Patent Office (through the PTAB and the Central Reexamination Unit) to hear two serial challenges to the same patent is similarly problematic.

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<sup>2</sup> *See also* FAQs for Interim Processes for PTAB Workload Management, <https://www.uspto.gov/patents/ptab/faqs> (“Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited.”).

In short, if the Board was to grant institution in this proceeding, it would be issuing an opinion on the same claims of the '757 patent whose validity would have been previously tried before the District Court several months prior, and the same claims of the '757 patent whose validity may subsequently be challenged again during any potential *ex parte reexamination* process. This is the opposite of efficiency and contravenes the very purpose of the IPR process.

Thus, *Fintiv* Factor 4 weighs in favor of discretionary denial.

**E. *Fintiv* Factor 5: Petitioner is the Defendant in the District Court Litigation.**

*Fintiv* Factor 5 looks to “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv I* at 5-6. Specifically, when “the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Fintiv II* at 15. Here, the Petitioner is the defendant in the parallel litigation.

Thus, *Fintiv* Factor 5 weighs in favor of discretionary denial.

**F. *Fintiv* Factor 6: Other Considerations Weigh Against Institution**

*Fintiv* Factor 6 looks to “other circumstances that impact the Board's exercise of discretion, including the merits.” *Fintiv I* at 5-6. This factor also weighs heavily against institution for at least two reasons.

First, contrary to Petitioner’s assertions, the Petition fails to present any compelling merits of unpatentability. The art presented in the Petition fails to

anticipate or render the challenged claims obvious for reasons that Patent Owner will highlight in its POPR merit-based briefing.

Second, as discussed further below, “additional considerations” (as outlined in the Director’s March 26, 2025 Memo) weigh in favor of discretionary denial, including the Petition’s over-reliance on expert testimony to gap-fill holes in the prior art, as well as the length of time the challenged claims have been in effect.

### **III. ADDITIONAL CONSIDERATIONS WEIGH IN FAVOR OF DISCRETIONARY DENIAL**

In addition to the above factors, as explained in the March 26, 2025 Memo, additional relevant considerations may weigh in favor of discretionary denial, including:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

Here, as discussed further below: 1) no changes in the law support reconsideration of validity of the '757 patent claims; 2) the Petition is particularly weak and is overly reliant on unreliable expert testimony to gap-fill holes in the prior art; and 3) the challenged claims have been in force for more than eleven (11) years.

**A. No Changes in the Law Support Reconsideration of Validity**

First, no changes in the law support reconsideration of the validity of the '757 patent claims, and Petitioner does not identify any such change.

**B. The Petition is Particularly Weak and Overly Reliant on Unreliable Expert Testimony**

The third and fourth considerations test the “strength of the unpatentability challenge” and the “extent of the petition’s reliance on expert testimony.” Here, the Petition is particularly weak and overly reliant on unreliable expert testimony to gap-fill holes in the prior art. For example, as discussed in the FAQs for Interim Processes for PTAB Workload Management, “[w]hile the Board may consider expert testimony, as a matter of efficiency, extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court.”

[https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management?utm\\_campaign=subscriptioncenter&utm\\_content=&utm\\_medium=email&utm\\_name=&utm\\_source=govdelivery&utm\\_term=](https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term=) (last visited Friday,

April 25). Thus, a “failure to provide focused expert testimony may weigh against institution.” *Id.*

Here, the Petition relies so heavily on the opinion of the expert that the expert’s declaration is over **120 pages** and shares large sections of identical text with the Petition. *See, e.g.,* Petition at *passim*; Ex. 1002 (Baker Decl.). This makes the credibility of the expert a key issue in resolving Petitioner’s invalidity arguments, and the District Court is better equipped a dispute that revolves around such factors. Additionally, here, the qualifications and experience of Petitioner’s expert has been questioned in other IPR petitions filed by Petitioner, and Patent Owner expects such issues will similarly arise here. *See, e.g.,* Ex. 2006 at ¶¶63–67 (asserting Petitioner’s expert lacked requisite qualifications); Ex. 2007 at ¶¶88–90 (same).

The Grounds presented in the Petition are also weak and rely heavily on expert opinion that will be strongly disputed by Patent Owner. As will be explained further in Patent Owner’s Preliminary response, all of the prior art relied upon by Petitioner is directed towards *static* solutions—the references aim to make pixels in a display appear more uniform despite imperfections in each pixel *in a given frame*. *See* Ex. 1004, ¶¶ [0010]–[0011] (describing the problem pixels have different brightnesses “due to deviations introduced during the fabrication processes” and that “the present invention provides a pixel for displaying an image with uniform brightness”); Ex. 1006, ¶[0029] (“An object of the present invention is therefor to provide a display

device that properly compensates for variations in the threshold voltage of a drive element . . .”). The ’757 Patent, by contrast, addresses a *dynamic* problem with a dynamic solution—such as to prevent “ghosting” *between frames* (i.e., pixels do not switch fast enough from frame to frame, creating “ghosting” effect). *See* Ex. 1001, 1:40–57 (“ . . . the voltage/current hysteresis effect of the driving transistor 152 is likely to incur image retention phenomenon . . . the driving currents  $I_d$  of the two pixel units 150 are then different . . . which results in edge residual phenomenon”). The ’757 Patent claims, *inter alia*, first and second reset units that reset the driving/control voltages. *See* Ex. 1001, Claims 1, 17. These reset units serve to reset the pixels between frames, thereby wiping one frame before creating the next frame—like shaking an “etch-a-sketch” before drawing a new image. This is a fundamentally different approach than the prior art relied on in the Petition, which focuses on per-frame, static compensation methods rather than on frame-to-frame transitions. The Petition relies heavily on expert testimony in an attempt to stretch the teachings of the references to the claims. The Grounds presented in the Petition are weak and will require a battle of the experts on dispositive issues, and Petitioner’s expert testimony will have to be weighed against Patent Owner’s testimony (which will have the support of the intrinsic evidence, Petitioner’s own cited reference, and other extrinsic evidence). These issues will be resolved by a jury prior to any Final Written Decision and are better addressed in the District Court than here.

Thus, over-reliance on expert testimony to gap-fill holes in the prior art is an additional relevant consideration weighing against institution.

**C. The Patent Has Been in Force for More Than Eleven (11) Years**

This consideration looks to the “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Here, the ’757 Patent has been in force since 2013 and was filed in 2011. Ex. 1001 at 1. Not only has the ’757 Patent has been in force for more than eleven (11) years, but its filing predates the America Invents Act and the IPR regime itself. The considerable length of time that the claims have been in force has built a foundation of settled expectations by the Patent Owner, providing a reasonable expectation that the presumptively valid patent claims—*which already passed thorough examination by the Office*—may be relied upon to defend Patent Owner’s intellectual property rights. Thus, settled expectations of the parties is an additional relevant consideration weighing against institution.

**IV. THE BALANCE OF EVIDENCE FAVORS DENIAL**

In sum, all six *Fintiv* Factors weigh in favor of discretionary denial, including the additional relevant considerations that further weigh in favor of discretionary denial. Thus, considered as a whole, the relevant facts all weigh in favor of exercising discretionary denial.

**V. CONCLUSION**

Patent Owner respectfully requests that the Director exercise discretion under Section 314(a) to deny institution.

Date: June 11, 2025

Respectfully submitted,

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**CERTIFICATE OF WORD COUNT**

I certify that there are 4,210 words in this paper, excluding the portions exempted under 37 C.F.R. § 42.24(a)(1), according to the word count tool in Microsoft Word.

*/Jefferson Cummings/*  
Jefferson Cummings (Reg. No. 81,926)

**CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))**

The undersigned hereby certifies that the above document was served on June 11, 2025, by filing this document through the P-TACTS system as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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